

# 20-3104

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In The  
*United States Court of Appeals*

FOR THE SECOND CIRCUIT



LAWRENCE MARANO,

*Plaintiff-Appellant,*

v.

THE METROPOLITAN MUSEUM OF ART,

*Defendant-Appellee.*

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ON APPEAL FROM THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK (FOLEY SQUARE)  
NO. 1:19-cv-08606 (VEC), HON. VALERIE E. CAPRONI (U.S.D.J.)

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## **Brief for Plaintiff-Appellant**

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**CORPORATE DISCLOSURE STATEMENT**

N/A

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## **PRELIMINARY STATEMENT**

This appeal involves The Metropolitan Museum of Art (the “Met” or “Defendant”)’s unlicensed expropriation of an iconic photograph of the legendary Rock musician Eddie Van Halen (the “Photograph”), which was used as part of a museum exhibition in 2019, both on the Met’s website and at its Fifth Avenue “brick-and-mortar” location.

Notably, the Met did not provide any attribution to the photographer Lawrence Marano (“Marano” or “Plaintiff”) and the photograph itself was not the *object* of the exhibition, but merely used as an illustrative device to spotlight Van Halen’s eccentric “Frankenstein” guitar.

The District Court, Hon. Valerie E. Caproni, issued an Order to Show Cause two days after the complaint was filed, asking Marano to show cause why the action should not be dismissed on grounds of fair use. Accordingly, the presumption at the outset of this case was that museums are cultural institutions dedicated to enriching the public sphere and should therefore be immunized to infringement liability (unless Plaintiff showed otherwise).

It was the status of the Defendant, not the specific use in question, that appeared to shield Defendant from liability. Ultimately, the District Court did assess the facts of the case within the four corners of the pleading (and Defendant’s declarations), but as demonstrated below, the decision rests

primarily on the status and identity of the Defendant as a nonprofit museum which, by its very nature, functions to display historical artifacts or other works deemed of cultural significance.

The District Court identified “three dimensions” of transformativeness: (1) the Met used the Photograph as an “historical artifact” to represent the Frankenstein guitar in action; (2) the Met used the Photograph in a scholarly context, i.e. a museum; and (3) the Photograph was published on-line along with hundreds, if not thousands of other photographs.

But all three dimensions identified by the Court could be applied to virtually any secondary use of any photograph by a museum such as the Met. As to the first dimension, in every case where a photograph has, through the passage of time, acquired historical significance, a court could simply determine transformativeness as a matter of law, thereby stripping a vintage photograph of copyright protection.

The second dimension also operates generically, as such finding would apply to any work of art displayed in a museum, because museums serve a scholarly function (at least in part).

As to the third dimension, this factor can also be applied generically to any photograph on the Met’s on-line catalogue. It would always be the

case that a single photograph shown on the Met's on-line catalogue would co-exist with hundreds, maybe thousands, of other images.

Notably, Defendant's use of the Photograph here was not "reduced size". Rather, Defendant expropriated a full scale, full-color reproduction of the Photograph and placed it on prominent display on its website as a means to advertise its "brick and mortar" exhibition of the Frankenstein guitar. Even though the Photograph was used to explain to the public why the Frankenstein guitar embodied any significance at all, the Court described the Defendant's use of the Photograph as "almost an afterthought."

In short, all three dimensions identified by the District Court are geared towards the identical concept: that museums have an unfettered right to display photographs as a means to illustrate the historical significance of exhibits on showcase, without permission from the copyright holder. Not just this case – but in every case.

There is no question that Plaintiff's photograph has historical value. The same can be said for any photograph of any Rock n' Roll icon: Janis Joplin, Jimi Hendrix, Jim Morrison, etc. But that's all the more reason why museums such as the Met need to obtain the Artist's permission to exhibit their work: because the work appreciates over time. Certainly, museums must pay exorbitant amounts of money to exhibit historical relics from the

ancient Egyptian civilization, precisely because they are of immense value given their historical nature. Why then, should museums not have to pay to display historical pieces from modern American civilization?

The logic is not adding up. The older something is, the more historical, the more value. Plaintiff has a right to be compensated for creating an iconic image that a prestigious museum wants to display for its paying clientele. The Museum is abdicating its responsibility to the Artistic community by even arguing fair use in this proceeding. It should pay the fair price, credit the Artist and establish a protocol moving forward for seeking permission from Artists to display their work to its patrons.

In sum, the District Court's overly broad application of the fair use doctrine should be rejected, and the Court should reverse the District Court's ruling and remand this case for further proceedings.

#### **STATEMENT OF JURISDICTION**

The District Court, Hon. Valerie E. Caproni, had jurisdiction over the underlying copyright action pursuant to 28 U.S.C. § 1331 and 28 U.S.C. § 1338(a). On July 13, 2020, the District Court entered an Order dismissing the Complaint for failure to state a claim under the fair use doctrine, 17 U.S.C. § 107. [JA-98]

On August 14, 2020, The District Court entered an order denying Marano’s motion for reconsideration and/or reargument under Local Rule 6.3 and to vacate under Fed.R.Civi.P. 60(b)(1). [JA-115] On September 14, 2020, Marano timely filed his Notice of Appeal of both orders. [JA-118] This Court has jurisdiction pursuant to 28 U.S.C. § 1291.

### **ISSUES PRESENTED**

1. Whether The Met’s commercial use of the Photograph on its Website to sell tickets to its museum exhibition, as well as in the “brick-and-mortar” exhibition itself, was sufficiently transformative to warrant a finding in favor of fair use on the first statutory factor, 17 U.S.C 107(1).
2. Whether The Met’s use of the Photograph across multiple media platforms without any attribution or credit to the Plaintiff-photographer constituted bad faith so as to weigh against a finding fair use.
3. Whether the District Court properly analyzed the remaining statutory factors in light of its finding of transformative use.

## **STATEMENT OF THE CASE**

- On September 16, 2019, Marano filed a one-count action for copyright infringement against The Met, alleging that The Met used the Photograph on its Website without Marano's authorization. [JA-8] The Complaint attached two exhibits: the Photograph (Exhibit A) [JA-14] and various screenshots of The Met's Website where the Photograph was displayed without any attribution to Marano (Exhibit B). [JA-14-20]
- On September 18, 2019, the District Court entered an Order to Show Cause, ordering Marano to show cause why "the action should not be dismissed under the Fair Use exception of the Copyright Act, see 17 U.S.C. § 107." [JA-23]
- On October 9, 2019, Marano filed his memorandum of law in response to the Order to Show Cause. [JA-24]
- On October 11, 2019, upon citing The Met's notice of appearance via counsel, the District Court entered a second Order to Show Cause, setting a briefing schedule. [JA-34]
- On October 23, 2019, The Met filed its memorandum of law in response to Marano's response to the District Court's Order to Show Cause. [JA-25] In addition, The Met's defense counsel, Linda Steinman, filed a

four-page declaration [JA-65] which attached twenty-three pages of exhibits consisting of various screenshots from The Met's Website. [JA-69-97]

- On October 30, 2019, Marano filed a reply brief. [JA-4]
- On July 13, 2020, the District Court entered an Order dismissing the Complaint for failure to state a claim under the fair use doctrine, 17 U.S.C. § 107. [JA-98]

- On July 27, 2020, Marano filed his motion for reconsideration and/or reargument under Local Rule 6.3 and to vacate under Fed.R.Civi.P. 60(b)(1). [JA-113]

- On August 6, 2020, The Met filed its opposition brief to Marano's motion for reconsideration and/or reargument. [JA-5]

- On August 11, 2020, Marano filed his reply brief in further support of his motion for reconsideration and/or reargument. [JA-6]

- On August 14, 2020, the District Court entered an order denying Marano's motion for reconsideration and/or reargument under Local Rule 6.3 and to vacate under Fed.R.Civi.P. 60(b)(1). [JA-115]

- On September 14, 2020, Marano timely filed his Notice of Appeal of the Order entered on July 13, 2020 which dismissed Plaintiff's claim and the Order entered on August 14, 2020 which denied Plaintiff's motion for



reconsideration under L.R. 6.3 and motion to vacate under Fed.R.Civ. 60(b).

[JA-118]

### **STATEMENT OF FACTS**

#### **A. Plaintiff-Appellant Lawrence Marano**

Plaintiff Lawrence Marano (“Plaintiff” or “Marano”) is a Florida - based professional photographer with decades of experience as a “Rock n Roll” photographer. [JA-25] Plaintiff is in the business of licensing his photographs for a fee. [JA-26; JA-9 (¶ 5); JA-93 (citing “Getty Images”)]

#### **B. Defendant-Appellee The Metropolitan Museum of Art**

The Metropolitan Museum of Art (“The Met” or “Defendant”) is a sophisticated purveyor of copyrighted works which operates a website at the URL [www.metmuseum.org](http://www.metmuseum.org) (the “Website”) and a brick-and-mortar museum at The Met Fifth Avenue, 1000 5th Ave, New York, New York 10028 (the “Museum”). [JA-25; JA-44] According to The Met, it is “the largest art museum in the United States and one of the foremost cultural institutions in the world.” [JA-43]

The Met is a registered 501(c)(3) nonprofit organization. [JA-49] However, according to The Met’s website, The Met charges admission to visit the galleries on Fifth Avenue: \$25 for adults; \$17 for seniors; \$12 for

students. [JA-25] This general admission fee is only charged to out of town visitors and not New York State residents, local students, or Museum members. [JA-50]

Access to The Met's Website, which it calls the Online Exhibition Catalogue, is available to the public at no charge. [JA-50] However, the Website contains hyperlinks which invites its virtual visitors to "Buy Tickets" for admission to the Museum and to "Make a Donation." [JA-16-17; JA-93]

**C. Marano's Photograph of Eddie Van Halen and the "Frankenstein Guitar"**

On or about October 8, 1982, Plaintiff created a Photograph depicting Eddie Van Halen of the rock group *Van Halen* as he performed on stage at Madison Square Garden in New York City (the "Photograph") [JA-9] At the time the Photograph was taken, Van Halen was playing a custom-made guitar called the "Frankenstein" guitar (the "Guitar").

During all times relevant to this action, the Photograph was made available for licensing on the leading stock photograph agency, Getty Images.com, and continues to be available. [JA-93 (citing "Getty Images" as the source of the Photograph); *see also* URL <https://www.gettyimages.com/detail/news-photo/eddie-van-halen-of-van-halen-performs-on-the-hide-your-news-photo/136658761>]

**D. The *Play it Loud* Exhibition – At The Met Fifth Avenue (April 8-October 1, 2019)**

According to the evidence produced by The Met, from April 8 to October, 2019, The Met featured an exhibition at its Fifth Avenue location in New York City entitled *Play it Loud: Instruments of Rock & Roll* (the “Exhibition” or “*Play it Loud*”). The Exhibition was designed to showcase “the instruments of rock and roll.” [JA-73] The Met stated that “[t]he Instruments used in rock and roll had a profound impact on this art form and forever changed music.” [JA-73]

The Met promoted and sold tickets to the Exhibition through an Online Exhibition Catalogue. [JA-16-17; JA-45] In both the Exhibition’s galleries on Fifth Avenue and the Online Exhibition Catalogue, The Met “provided interpretative text, photographs, and multimedia presentations showing many of the instruments on display being played by musicians such as Chuck Berry, The Beatles, Joan Jett, and The Rolling Stones.” [JA-45]

The museum exhibition was co-organized by The Met and the Rock & Roll Hall of Fame (in Cleveland, Ohio) and presented “approximately 130 instruments alongside posters and costumes.” [JA-173] Admission to the Exhibition also included a print catalogue. [JA-73]

In order to view the Exhibition in person, out-of-state patrons would need to “Buy Tickets.” [JA 16-17; JA-73] According to The Met’s Website,

“Exhibitions are free with Museum admission.” [JA-73] The Exhibition was made possible by the “John Pritzker Family Fund, the Estate of Ralph L. Riehle, the William Randolph Hearst Foundation, Diane Carol Brandt, the Paul L. Wattis Foundation, Kenneth and Anna Zankel, and the National Endowment of the Arts.” [JA-73]

**E. The Met’s Unauthorized Display of the Photograph on its Website**

The evidence attached to the Complaint shows that The Met displayed the Photograph on its Website, without providing any attribution to Marano. [JA-16-17]<sup>1</sup> The Met used the entire Photograph, in full scale and full color, without any cropping or other aesthetic modification. [*Compare* JA-14 (the original Photograph) with JA-16-17; JA-93 (the Met’s reproduction)]

Directly above the display of the Photograph on the Website, The Met invited its virtual users to “Buy Tickets” or “Make a Donation”. [JA-16-17; JA-93]

Directly below the display of the Photograph, the Website provides the “Object Details” about the Frankenstein electric guitar, including the

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<sup>1</sup> The Met added Marano’s attribution to the Photograph, as displayed on the Website, in response to this lawsuit [JA-93] As this lawsuit was filed on September 16, 2019, just two weeks before The Met discontinued the Exhibition at the Museum on October 1, 2019, it is presumed that The Met failed to include proper attribution to Marano at The Museum.

<sup>2</sup> Although these additional uses were not identified in the initial complaint,

name and birth year of the “Artist” (Eddie Van Halen -1955), the “Date” the Guitar was created (1975), the “Medium” (ash, maple, nickel, chrome, plastic, spray paint), the “Dimensions”, the “Classification” (Chordophone-Lute-plucked-fretted) and the “Credit Line” (Courtesy of Eddie Van Halen).

[JA-16] The sole reference included is to the Smithsonian magazine’s website (URL: <https://www.smithsonianmag.com/arts-culture/q-and-a-with-eddie-van-halen-159357298/>)

The text which accompanies the Met’s display of the Photograph on the Website reads as follows:

“Frankenstein,” composite electric guitar, 1975 - Edward Lodewijk  
“Eddie” Van Halen

Aptly nicknamed “Frankenstein,” this guitar was pieced together by Eddie Van Halen from modified factory seconds and mismatched odd-lot parts, then spray-painted. It represents an effort to combine some of the most desirable elements of Gibson and Fender guitars into a single instrument that was not commercially available at the time. Van Halen was continually striving to achieve the ultimate guitar for tone, playability, dependability, and functionality. The unique guitar embodies not only his groundbreaking and unorthodox playing style but also his ingenuity in design and engineering. One of the most recognizable guitars of all time, it spawned legions of copies from other manufacturers and inspired generations of fans to design their own instruments.

[JA-16]

Prior to the filing of this lawsuit, the text provided on the Website makes no reference to the Photograph itself, nor to the Photograph’s author,

its source, its date of creation nor its history [JA-16-17] In other words, Marano's Photograph is not the object of the Met's exhibition of the Guitar; but is instead being used as an illustrative aid to show the Guitar in musical performance by Van Halen. [JA-16]

At the bottom of the webpage which displays the Photograph on The Met's Website, a copyright notice is provided as follows: "© 2000-2019 The Metropolitan Museum of Art. All rights reserved." [JA-20]

**F. The Met's Unauthorized Display of the Photograph at the Museum's Fifth Avenue Exhibition**

In addition to using the Photograph on its Website to promote the Exhibition, The Met also used the Photograph as part of the "brick-and-mortar" Exhibition where the Guitar was on physical display. [JA-25; JA-41, fn. 3] Although the Complaint does not allege use of the Photograph by The Met in the Museum's physical location, Marano's initial brief in response to the District Court's order to show cause does allege that The Met used the Photograph in the physical exhibition on Fifth Avenue [JA-25]

Moreover, The Met admits that it used the Photograph as part of the physical Exhibition, as well as in a separate video on the Website. [JA-41, fn. 3]<sup>2</sup>

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<sup>2</sup> Although these additional uses were not identified in the initial complaint, the District Court determined that its "decision would be the same even if

**G. The Met’s Display of the Photograph Through Other Media**

As a result of the District Court’s dismissal of the case based on the initial pleading, Marano was not accorded the opportunity to amend his complaint as of right pursuant to Fed.R.Civ. 15(a)(1), nor was he able to conduct discovery with respect to other uses the Met may have plausibly employed to display the Photograph as part of the Exhibition, including mobile web applications, promotional flyers or print brochures, mailers, posters, other in-museum displays (such as on digital light boards), or even merchandise.

Indeed, the documentary evidence produced as part of the Steinman Declaration reveals that the Met, via The Met Store, sold a *Play it Loud* “exhibition catalogue” and “picture album” which featured “[p]hotographs and essays [which] explore iconic guitars, pianos and more . . .” [JA-75] Given the Met’s multiple uses of the Photograph across several media platforms, it is plausible at the pleading stage that The Met also displayed the Photograph as part of the *Play it Loud* “exhibition catalogue” and “picture album.” Marano simply does not know because he was deprived of the opportunity to take any discovery. Exclusive possession of such

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the Complaint alleged misuse of the Photo in the physical exhibition also.” [JA-99, fn. 3] Accordingly, since this additional claim has been adjudicated on the merits in the court below (and would therefore serve as *res judicata*), it is properly before this Court on appeal.

information resides with The Met. This fact alone warrants reversal of the District Court's premature decision.

### **SUMMARY OF ARGUMENT**

*First*, the District Court improperly determined as a matter of law that the Met's secondary use was transformative because the Photograph was used in the context of scholarship to spotlight an historical artifact. Among other reasons, because the Photograph was not the object of the Met's exhibition, the secondary use should not be deemed transformative *per se*.

*Second*, the District Court prematurely determined that the Met's use was for non-commercial reasons, given that the exhibition was a tourist attraction which charged admission to out-of-state residents and marketed ancillary products through The Met Store.

*Third*, the Met's failure to properly credit Marano as part of the Exhibition during the relevant timeframe should weigh against a finding of fair use.

*Fourth*, the District Court improperly determined that the second and third factors weighed in favor of fair use because the use was deemed transformative. The creative nature of the Photograph, along with the Met's wholesale use of a full-scale unaltered image across multiple media platforms, should weigh against fair use.



*Fifth*, the District Court erred by granting the motion to dismiss without providing Plaintiff the opportunity to conduct discovery relating to the actual and/or potential market harm caused by the Met’s secondary use of the Photograph.

### **STANDARD OF REVIEW**

This Court reviews *de novo* a district court’s dismissal for failure to state a claim, “accepting all factual allegations in the [ ]complaint and its incorporated exhibits as true and drawing all reasonable inferences in plaintiff[’]s favor.” *TCA Television Corp. v. McCollum*, 839 F.3d 168, 177 (2d Cir. 2016) (applying *de novo* standard to district court’s dismissal of amended complaint based on fair use doctrine and finding that dismissal was not properly based on fair use.)

To survive a motion to dismiss under Rule 12(b)(6), a complaint must plead “enough facts to state a claim to relief that is plausible on its face.” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). “A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009).

In considering a motion to dismiss, a district court must “accept[ ] all factual claims in the complaint as true, and draw[ ] all reasonable inferences in the plaintiff’s favor.” *Lotes Co. v. Hon Hai Precision Indus. Co.*, 753 F.3d 395, 403 (2d Cir. 2014) (quoting *Famous Horse Inc. v. 5th Ave. Photo Inc.*, 624 F.3d 106, 108 (2d Cir. 2010) (internal quotation marks omitted)). “[T]he complaint’s [f]actual allegations must be enough to raise a right to relief above the speculative level, i.e., enough to make the claim plausible.” *Arista Records, LLC v. Doe 3*, 604 F.3d 110, 120 (2d Cir. 2010) (quoting *Twombly*, 550 U.S. at 555, 570) (internal quotation marks omitted).

“The determination of fair use is a mixed question of fact and law.” *Swatch Grp. Mgmt. Servs. Ltd. V. Bloomberg L.P.*, 756 F.3d 73, 81 (2d Cir. 2014). It is an “open-ended and context-sensitive inquiry” that is “fact-driven[ ]” *LaChapelle v. Fenty*, 812 F. Supp. 2d 434, 442 (S.D.N.Y. 2011); *see also Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994) (“the [fair use] statute, like the doctrine it recognizes, calls for case-by-case analysis”). In rebutting a defendant’s fair use argument on a Rule 12(b)(6) motion, a plaintiff is “held only to the usual burden of a motion to dismiss . . . which is to say [he] must plead sufficient facts to

plausibly suggest that they are entitled to relief.” *Kelly-Brown v. Winfrey*, 717 F.3d 295, 308 (2d Cir. 2013).

“Because fair use is an affirmative defense, it often requires consideration of facts outside of the complaint and thus is inappropriate to resolve on a motion to dismiss.” *Kelly-Brown*, 717 F.3d at 308; *see also Coleman v. Home Box Office, Inc.*, No. 18-CV-3510 (MKB), 2019 WL 8645387, at \*6 (E.D.N.Y. Aug. 6, 2019) (“Further development of the record is needed to clarify where Defendants obtained Plaintiff’s work and to identify the intended purpose behind the Film’s use of the Work and what, if any, new insights and understandings are created by Defendants’ use.”); *Hirsch v. CBS Broad. Inc.*, No. 17 CIV. 1860 (PAE), 2017 WL 3393845, at \*6 (S.D.N.Y. Aug. 4, 2017) (denying the defendant’s motion to dismiss because further development of the record was needed to clarify whether the defendant’s use of a copyrighted photograph in a video created new insights and understandings); *A.V.E.L.A., Inc. v. Estate of Marilyn Monroe*, 131 F. Supp. 3d 196, 210 (S.D.N.Y. Sept. 18, 2015) (“the invocation of the fair use doctrine necessarily raises questions of fact that cannot be resolved on a motion to dismiss”).

Nevertheless, this court has acknowledged the possibility of fair use being so clearly established by a complaint as to support dismissal of a

copyright infringement claim. *See Cariou v. Prince*, 714 F.3d 694, 707 (2d Cir. 2013) (granting defendant partial summary judgment on fair use and citing approvingly to *Brownmark Films, LLC v. Comedy Partners*, 682 F.3d 687 (7th Cir. 2012) (rejecting argument that fair use could not be decided on motion to dismiss)).

On *de novo* review here, Marano respectfully submits that the Court should conclude that Defendant's entitlement to a fair use defense was not so clearly established on the face of the complaint and its incorporated exhibits as to support dismissal. *See TCA Television Corp.*, 839 F.3d at 178.

### **ARGUMENT**

In the preamble to 17 U.S.C. § 107, Congress states that “the 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.” *TCA Television Corp.*, 839 F.3d at 178.

Section 107 of the Copyright Act sets out four non-exclusive factors to consider in determining whether a defendant's use of a copyrighted work is a fair use. These are “(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.” 17 U.S.C. § 107.

In reviewing the challenged determination of fair use in this case, the Court is to address these factors individually, while at the same time heeding the Supreme Court’s instruction that the factors must be viewed collectively, with their results “weighed together, in light of the purposes of copyright.” *TCA Television Corp.*, 839 F.3d at 179 (citing *Campbell*, 510 U.S. at 578)

As set forth below, examination of these factors demonstrates that the Met’s use of the Photograph does not constitute fair use (or at the very least, the District Court prematurely decided the issue in the absence of a properly developed factual record).

**POINT I: THE MET’S USE OF THE PHOTOGRAPH WAS NOT SUFFICIENTLY TRANSFORMATIVE, WAS COMMERCIAL AND WAS NOT IN GOOD FAITH (FACTOR #1)**

The first factor under 17 U.S.C. § 107(1), which addresses the purpose and character of the secondary use, is the “heart of the fair use inquiry.” *Blanch v. Koons*, 467 F.3d 244, 251 (2d Cir. 2006).

Courts within the Second Circuit examine three sub-factors to determine the purpose and character of use, including whether the secondary use is: (1) transformative; (2) for commercial purposes; and (3) in bad faith. *See, e.g., NXIVM Corp. v. Ross Inst.*, 364 F.3d 471, 478 (2d Cir. 2004). As per below, all three sub-factors weigh against a finding fair use.

**A. THE MET’S SECONDARY USE IS EITHER NOT TRANSFORMATIVE (OR ONLY MINIMALLY TRANSFORMATIVE )**

The fair use doctrine “allows for new transformative works that further the public discourse and the free exchange of ideas in order to promote science and the arts.” *See Campbell*, 510 U.S. at 579. The central purpose of the inquiry is to determine whether “the new work merely supersedes 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.” *Ringgold v. Black Entertainment Television, Inc.*, 126 F.3d 70, 79 (2d Cir. 1997) (citations omitted). The Court should also inquire as to “whether the new work uses the copyrighted material itself for a purpose, or imbues it with a character, different from that for which it was created.” *TCA Television Corp.*, 839 F.3d at 180.

The District Court determined that The Met’s use of the Photograph on the Website was transformative for three reasons: (a) “the Met used

Plaintiff's Photo as an historical artifact and a 'recognizable representation' of the 'Frankenstein' guitar in action" [JA-105]; (b) "the Met used Plaintiff's Photo in a scholarly context" because "museum exhibitions often incorporate other source material for 'optimum treatment of their subjects;" [JA-105-106]; and (c) "the Photo constitutes an 'inconsequential portion' of the Met's online catalogue." [JA-106]

For the reasons set forth below, Marano respectfully submits that none of these reasons provide sufficient justification for determining that the Met's secondary use was transformative as a matter of law.

**1. The Met's Alleged Use of the Photograph for "Scholarship" is Not Dispositive of the First Fair Use Factor**

"[T]he uses identified by Congress in the preamble to § 107 -- criticism, comment, news reporting, teaching, scholarship, and research -- might be deemed 'most appropriate' for a purpose or character finding indicative of fair use." *TCA Television Corp.*, 839 F.3d at 179 (citing Nimmer § 13.05[A][1][a], at 13-162.

However, as the Supreme Court emphasized in *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 561 (1985), the preamble to Section 107 was intended to "give some idea of the sort of

activities the courts might regard as fair use under the circumstances.”

(*citing* Senate Report, at 61.). As noted by the High Court:

[t]his listing was not intended to be exhaustive, see *ibid.*; § 101 (definition of “including” and “such as”), or to single out any particular use as presumptively a “fair” use. The drafters resisted pressures from special interest groups to create presumptive categories of fair use, but structured the provision as an affirmative defense requiring a case-by-case analysis. See H.R.Rep. No. 83, 90th Cong., 1st Sess., 37 (1967); Patry 477, n. 4. “[W]hether a use referred to in the first sentence of section 107 is a fair use in a particular case will depend upon the application of the determinative factors, including those mentioned in the second sentence.” Senate Report, at 62. The fact that an article arguably is “news” and therefore a productive use is simply one factor in a fair use analysis.

*Harper & Row*, 471 U.S. at 561.

Here, the District Court determined that the challenged use fits within the statutory category of “scholarship”, which is listed as one of the favored examples under the preamble to section 107. [JA-105 (“the Met used Plaintiff’s Photo in a scholarly context.”)] The District Court also determined that the secondary use was transformative because the Met used the Photograph as an “historical artifact” [JA-106] These reasons are essentially identical, because one of the functions of a museum is to display historical artifacts. *See* <https://en.wikipedia.org/wiki/Museum> (“A museum is an institution that cares for (conserves) a collection of artifacts and other objects of artistic, cultural, historical, or scientific importance”).



The crux of the District Court’s transformative inquiry rests primarily on the concept that museums are entitled to display photographs in a scholarly context. But such finding contradicts the holding of *Harper & Row*, which instructs courts not to make fair use determinations solely based on the examples listed in the preamble to section 107. At bottom, the District Court determined that because the Photograph was used in a scholarly context as an historical artifact, it is transformative *per se*. This is reversible error in light of *Harper & Row*; accord *Coleman*, 2019 WL 8645387, at \*5 (“the mere fact that [the defendant’s work] is a documentary . . . is not enough to satisfy the first statutory fair use factor of the fair use inquiry.”)

Indeed, in the context of news reporting, another example listed under the section 107 preamble, the Supreme Court noted that “[t]he promise of copyright would be an empty one if it could be avoided merely by dubbing the infringement a fair use ‘news report’ of the [work].” *Harper & Row*, 471 U.S. at 557 . Courts have consistently adopted *Harper & Row* by finding that “newsworthiness itself does not lead to transformation.” *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1175 (9th Cir. 2012); *Swatch Group Management*, 756 F.3d at 85 (“A news organization thus may not freely copy creative expression solely because the expression itself is

newsworthy.”); *Murphy v. Millennium Radio Grp. LLC*, 650 F.3d 295, 307 (3d Cir. 2011) (“[N]ews reporting does not enjoy a blanket exemption from copyright. News organizations are not free to use any and all copyrighted works without the permission of the creator simply because they wish to report on the same events a work depicts.”).

Here, although *Harper & Row Publishers* addressed secondary uses in the context of news reporting, its rationale should apply with equal force to “scholarship”, which is just another example listed in the preamble to section 107. The fact that a photograph is displayed in the context of scholarship, or as an historical artifact, does not in and of itself render the secondary use transformative *per se*. After all, the copyright protection accorded to photographs cannot be suspended every time a museum seeks to stage an exhibition, especially where tickets are being sold and donations are being solicited.<sup>3</sup>

The District Court’s holding stands for the overly broad proposition that because museums are engaged in scholarship, they enjoy a blanket license under the color of fair use to display photographs as historical artifacts (or to reference other historical artifacts depicted in the

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<sup>3</sup> If the substantial money from ticket sales and donations is not being used to compensate the artists whose work is on the display in the museum, then where is the money going?

photograph). Marano respectfully avers that the Met's status as a nonprofit museum, in and of itself, is not sufficient to strip his Photograph of copyright protection.

**2. The Question As to Whether the Met's Use of the Photograph Falls Within the Meaning of "Scholarship" Under the Section 107 Preamble Should be Reserved for the Fact-Finder**

The District Court determined that the challenged use fits within the statutory category of "scholarship", which is listed as one of the favored examples under the preamble to section 107. [JA-105 ("the Met used Plaintiff's Photo in a scholarly context.")]

While the Met's use of the Photograph was made *in part* within the context of scholarship, Marano respectfully avers that the District Court erred by presupposing that the Photograph was only used (or predominantly used) for the purpose of scholarship.

In its brief below, the Met claims that its use was for a "clear nonprofit educational purpose" [JA-49] and compares such use to unlicensed distribution of academic materials to students enrolled at a state university. [JA-49 (citing *Cambridge Univ. Press v. Patton*, 769 F.3d 1232, 1263, 1267 (11th Cir. 2014); *Campbell*, 510 U.S. at 579 n.11 (nonprofit educational use such as straight reproduction of multiple copies for classroom distribution may weigh in favor of fair use under first factor))].

But public museums are not like state universities. Museums provide more than scholarship, they also provide entertainment. While it is tempting to conclude, as the District Court did, that secondary uses by the largest and most prestigious fine arts museum in the United States automatically qualifies for a statutorily favored use under the scholarship rubric, such conclusion does not necessarily reflect the reality of the Met, which serves as a major tourist destination and charges \$25 admission to out-of-state tourists (which undoubtedly comprise a large segment of the Met's visitors).

Indeed, museums are much like zoos, in the sense that they serve an educational purpose while simultaneously providing entertainment value. It would therefore be inappropriate to compare a massive tourist attraction such as the Met, with its substantial advertising budget and merchandise offerings, to a college classroom where scholarly texts are disseminated to a small group of enrolled students.

In this case, the question as to whether the Met's secondary use of the Photograph predominantly qualifies as nonprofit scholarship (as opposed to commercial entertainment) should be reserved for the fact-finder based on the development of a factual record. A reasonable jury could conclude that the *Play it Loud* Exhibition, with its focus on American popular culture, was a tourist attraction predominately staged to provide entertainment value to

museum patrons, and that its scholarly purpose (although legitimate) was ancillary to its primary function as a commercial exhibition.

Under such circumstances, the District Court's summary conclusion that the Met used the Photograph for the sole purpose of scholarship is premature and not well-founded given the Met's hybrid function as a tourist destination and commercial entertainment venue which also seeks to educate and inform.

**3. The Met's Secondary Use is Not Transformative Because The Photograph Itself is Not the Object of Scholarly Exhibition**

Even if the Met's secondary use predominantly qualifies as scholarship, that does not end the transformative inquiry. *Harper & Row*, 471 U.S. at 557. The Court should ask whether the copyrighted work itself (i.e., the Photograph) was used as the object of scholarship; or whether it was merely used as an illustrative device to highlight some other work of scholarship. The case at bar plainly involves the latter scenario and, thus, the Court should find the Met's secondary use was not transformative

In *Barcroft Media, Ltd. v. Coed Media Group, LLC*, No. 16-cv-7634 (JMF), 2017 WL 5032993 (S.D.N.Y. 2017), the court explained that the preferential treatment accorded to "news reporting" under the preamble to Section 107 only applies to news reporting about the copyrighted work

itself; not to news reporting about the subject matter depicted in the image. *Barcroft* at \*6; *see also BWP Media USA, Inc. v. Gossip Cop Mediam, Inc.*, 196 F. Supp. 3d 495, 406 n.6 (S.D.N.Y. 2016) (“Defendant confuses the situation in which the photograph is the story . . . and the scenario present here, in which the contents of the photograph are of some public interest . . .”).

Thus, in cases where news organizations use photographs as illustrative devices to comment on the content depicted in the image, district courts in this Circuit have consistently determined that such use is not transformative. *See, e.g., Cruz v. Cox Media Grp., LLC*, 444 F. Supp. 3d 457 (E.D.N.Y. 2020) (secondary use of a photograph of a terrorist suspect held not transformative where news organization published a descriptive report of the arrest); *Otto v. Hearst Commc'ns, Inc.*, 345 F. Supp. 3d 412 (S.D.N.Y. 2018) (photograph of President Trump crashing a wedding held not transformative because the photograph itself was not the object of any controversy); *Hirsch v. Complex Media, Inc.*, No. 18-cv-5488 (CM), 2018 WL 6985227, at \*6 (S.D.N.Y., December 10, 2018) (“Complex has not established that its Video did anything more than merely describe the subject of Hirsch’s Photograph, newsworthy or not. That conduct alone does not suffice as transformative.”); *Psihoyos v. Nat'l Exam'r*, No. 97 CIV. 7624

(JSM), 1998 WL 336655, at \*3 (S.D.N.Y. June 22, 1998) (where photograph of an art car was republished in a news article, publisher’s “use is not transformative, because its piece uses the photo to show what it depicts.”); *see also Monge*, 688 F.3d at 1175 (rejecting fair use defense where “the controversy here has little to do with photos; instead, the photos here depict the couple’s clandestine wedding.”).<sup>4</sup>

The same rationale adopted by *Barcroft* and its progeny in the context of news reporting should apply with equal force to the preferential treatment accorded to scholarship under the preamble to section 107. Namely, in order to find the Met’s use to be transformative under the guise of scholarship, the original Photograph itself must be the *object* of the Museum’s Exhibition.

In this case, had the Met used the Photograph itself as the object of a museum exhibition, for example, to spotlight the “Top Ten Iconic Images of Rock Stars,” or to comment on the artistic merits of the Photograph, or historical significance of Rock n Roll imagery in general, or to highlight the professional lives of Rock n Roll photographers, then maybe the Met would have a colorable claim of transformative use of the Photograph.

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<sup>4</sup> The Met has attempted to distinguish this line of cases by arguing that different rules should be established for uses involving scholarship, as opposed to news reporting. But since both “news reporting” and “scholarship” are expressly provided for by Congress as preferential uses in Section 107’s preamble, Marano respectfully submits that the same underlying rules and legal principles should govern such uses.

But neither the Website’s display of the Photograph nor the *Play It Loud* Exhibition say anything whatsoever about the Photograph. Indeed, prior to the filing of this lawsuit, the Website contained no information about the photographer, the date when the Photograph was taken, where the Photograph was taken, or information about how the Photograph was captured. [JA-16-17]

Even after the lawsuit was filed, the Website now only contains an attribution to Marano and Getty Images, but offers no commentary or scholarly insight directed at Marano’s copyrighted work. [JA-93] To the extent the Met’s Exhibition qualifies as scholarship under the section 107 preamble, the Photograph itself is not the object of scholarship, commentary or criticism.

Indeed, the District Court consistently recognized that the Exhibition was all about the Guitar, which it described as the “exhibition object.” [JA-105 (“the Met spotlights the ‘*Frankenstein*’ guitar — using the Photo to reference and contextualize the exhibition object”); JA-106 (“Plaintiff’s Photo is displayed on the biographical page for the exhibition object—the very instrument depicted in the Photo—in order to “document and represent the [use of the guitar]”); JA-99 (recognizing that the “interpretive text, photographs, and multimedia presentations about the instruments that were



in the exhibition) (underline added); JA-99 (recognizing that the Exhibition “examine[d] the instruments of rock and roll”); JA-100 (“Beneath the historical text and the photos, the page includes another section of text devoted to ‘Object Details’; that section provides basic information about the guitar, including, *inter alia*, the materials it was made of and its dimensions.”) (underline added)

Conversely, the District Court acknowledged that the Met’s use of the Photograph on the Website was “almost an afterthought” [JA-106], which confirms that the Met’s scholarship was not about the copyrighted work at issue (i.e., the Photograph), but about the Guitar.

Under these circumstances, the District Court erred in finding that the Met’s use was transformative based on scholarship, as the Met was not seeking to educate or inform its visitors about the Photograph itself.

**4. Wholesale Reproduction of an Entire Photograph is Not Transformative Where the Commentary or Criticism Fails to Address the Merits or Appropriateness of the Photograph**

The District Court rejected Marano’s argument that the Met was required to comment on or critique the Photograph as part of the Exhibition [JA-106] (“What is relevant is not whether the exhibition comments on the Photo *per se*, such as the photographer’s choice of lighting or focus, but whether it uses the Photo to help illustrate the historical and artistic

significance of the guitar — a separate and distinct purpose from the Photo’s original expressive purpose.”)

The District Court relies on the analysis in *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 610 (2d Cir. 2006), which found that seven thumbnail images of Grateful Dead concert posters used in a 480-page coffee table book “serve as historical artifacts graphically representing the fact of significant Grateful Dead concert events selected by the *Illustrated Trip*’s author for inclusion in the book’s timeline.” The seven images were “displayed in significantly reduced form and are accompanied by captions describing the concerts they represent.” *Bill Graham Archives*, 448 F.3d at 607 .

But the key distinction is that the Grateful Dead posters in *Bill Graham Archives* were themselves the object of exhibition and historical scholarship. The reduced-size posters and concert tickets were not used by the defendant-publisher to reference, explain or authenticate some *other* work of scholarship, as was the case here. Instead, the publisher merely provided a textual description of the concerts to explain the thumbnail images.

In the present matter, the District Court acknowledged that the Met’s

“secondary use shifts that focus to the ‘Frankenstein’ guitar to visually contextualize *its* significance.” [JA-105, fn. 9] So this case is the opposite of *Bill Graham Archives*. The publisher in *Bill Graham* provided textual descriptions to explain and highlight the significance of the plaintiff’s copyrighted works. Here, in contrast, the Met displayed Marano’s copyrighted work to explain the significance of some other copyrighted work: the Guitar. So where the reduced size Grateful Dead posters were themselves presented as the historical artifacts, i.e., the object of scholarship, the Photograph here was merely employed by the Met as an illustrative device to spotlight some *other* historical artifact.

Furthermore, to the extent that *Bill Graham Archives* stands for the broad proposition that copyrighted photographs may be used without authorization to help illustrate historic or biographical events, the Court should take this opportunity to narrow that holding, consistent with the rationale adopted by *Barcroft Media*, 297 F. Supp. 3d at 352 (“a depiction of a controversial photograph might fairly accompany a work of commentary or criticism about the artistic merit or appropriateness of the photograph.”) (underline added).

Plaintiff respectfully avers that, in the context of scholarship, the Court should establish a clearly delineated rule that unless the merits or

appropriateness of the photograph itself is the object of scholarship, commentary or criticism, the secondary use cannot be deemed transformative.

Defendant may cite to the Court's decision in *Cariou*, 714 F.3d at 706 for the proposition that “[t]law imposes no requirement that a work comment on the original or its author in order to be considered transformative, and a secondary work may constitute a fair use even if it serves some purpose other than those (criticism, comment, news reporting, teaching, scholarship, and research) identified in the preamble to the statute.”

But *Cariou* did not involve one of the preferential uses identified in the preamble to section 107. Instead, *Cariou* addressed a case of “art appropriation,” where the secondary use involved substantial aesthetic alterations to the original image. But in cases such as the present involving literal, wholesale reproductions of the entire original work, without any aesthetic alteration of any kind, the Court should require that the photograph itself be made the object of the comment, criticism or scholarship to qualify for a finding of transformativeness.

If the rule were otherwise, then virtually any documentary filmmaker, book publisher, museum or news organization would be granted a blanket license to use copyrighted photographs or videos as illustrative devices to

narrate historical events. As a result, copyright protection for vintage photographs would be swallowed whole by the fair use doctrine.

**5. The Met’s Exhibition Did Not Provide Any Novel Insight or New Meaning Concerning the Original Photograph**

“[U]se of copyrighted material that ‘merely repackages or republishes the original is unlikely to be deemed a fair use’ and a ‘change of format, though useful’ is not transformative.” *Associated Press v. Meltwater U.S. Holdings*, 931 F.Supp.2d 537, 551 (S.D.N.Y. 2013) (quoting *Infinity Broadcast Corp. v. Kirkwood*, 150 F.3d 104, 108 & n. 2 (2d Cir. 1998) (citation omitted)). “Even an infringer’s separate purpose, by itself, does not necessarily create new aesthetics or a new work that alter[s] the first [work] with new expression, meaning or message.” *Monge* at 1176.

Indeed, this Court recognized in *Cariou*, that “a derivative work that merely presents the same material but in a new form, such as a book of synopses of television shows, is not transformative. 714 F.3d at 708 (citing *Castle Rock Entm’t, Inc. v. Carol Publ. Group, Inc.*, 150 F.3d 132, 143 (2d Cir. 1998); *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1378 (2d Cir.1993).

Here, the District Court determined that because the Met used the Photograph to “help illustrate the historical and artistic significance of the

guitar”, that its use is “separate and distinct” from the original purpose of the Photograph, which was to depict Eddie Van Halen in performance. [JA-106] But this conclusion tends to overlook the purpose of photographs.

By their very nature, photographs are intended to capture a moment in human history. As such, every photograph has the potential to become an historical artifact over time. The crux of the District Court’s decision is that the Met used the Photograph either as an historical artifact, or to provide context to an historical artifact in the form of the Guitar, a purpose which is distinct from the original intended use of showing Van Halen in performance. But this holding is not only erroneous, it threatens to swallow whole the copyright protection accorded to photographs that have acquired historical significance over time.

Indeed, since the development of photographic technology in the mid-1820’s, photographs have served the important function of instantaneously capturing visual depictions of people, places and events at a given moment in recorded human history. Every photograph of a human being is a contemporaneous record which, to varying degrees, acquires historical significance through the passage of time.

To be sure, the passage of time has the power to transform just about anything, including the shape and geographical location of the Earth’s

continents. But in the legal context of fair use, the passage of time alone should not be the basis to find a transformative effect. A secondary user's wholesale reproduction of a Photograph to show the historical significance of objects depicted in the Photograph should not be considered transformative as a matter of law. Such standard threatens to strip virtually every photograph of its copyright protection because no photograph is immune to the passage of time. This is particularly true concerning photographs of human beings, which record such person's appearance at a particular moment in history.

Thus, the District Court erred by concluding that the Met's use was transformative merely because the Photograph, or the subject matter depicted in the Photograph, had become an historical artifact. This holding sets a dangerous precedent that would allow virtually any secondary user to expropriate a vintage photograph for the purpose of visually representing an historical event or object depicted in the image. Registered photographs of world wars, natural disasters, famous performances, or other iconic moments in history would all be deprived of copyright protection.

At bottom, the Met used the Photograph to show what it depicts: Van Halen playing his eccentric guitar. The fact that the subject matter of the Photograph has acquired historical significance over time should be of no

legal import in the transformative inquiry, as the same could be said for virtually any photograph.

**6. The District Court’s Conclusion That Display of the Photograph Was “Inconsequential” Relative to the Met’s Entire Online Catalogue Has No Bearing on the Transformative Inquiry**

In an effort to align its secondary use with the holding in *Bill Graham Archives*, which involved seven tiny thumbnail images used in a collage format within the context of a 480-page coffee table book, the Met’s opposition brief below goes to great lengths to minimize its use of the Photograph on the Website. The District Court adopted this strained analysis to support its finding of transformativeness. [JA-106 (“Plaintiff’s Photo is a single image surrounded by pages of navigable textual, visual, and audio content.”)]

But the same argument could be made for virtually any website. Major news organizations, for example, publish tens of thousands of photographs on their websites every month. But the question is whether how that Photograph is displayed on the URL in question [JA 16-17; JA-93] not how the photograph is displayed relative to every other single webpage operated by the same publisher.

Moreover, the attempt to compare the layout of a website to a coffee table book is not sound. While the layout of a book is static, the layout of a



website is flexible and may change depending on whether the user employs a desktop computer versus a mobile device. It may also change depending on the web browser employed.

Further, there is no record evidence that visitors to the Met's website would necessarily click through each page before landing on the allegedly infringing use. The Photograph is displayed in full-scale on a unique, identifiable URL [JA-16-17; JA-93] and it entirely plausible that a website visitor could land directly on that URL through keyword searches, without having to pace through the Met's described website layout.

If the Court were to adopt such a strained analysis, then every photograph published on every website could be deemed transformative merely because thousands of other photographs have also been published on the same website, albeit on different URL.

Finally, the District Court acknowledged that the Met's use of the Photograph would be transformative even if it was displayed next to the Guitar at the Museum's physical Exhibition. [JA-99, fn. 3] *A fortiori*, the Website's layout has no bearing on the District Court's reasoning, which ultimately holds that museums can use whatever photographs they please, in any manner or through any medium, under the guise of "scholarship."

**7. As a Matter of Law, Incidental or Fungible Uses of Photographs Should Not Be Deemed Transformative**

This Court has recognized that the fair use doctrine serves as a vehicle to protect the secondary user’s First Amendment rights. *See, e.g., Eldred v. Ashcroft*, 537 U.S. 186, 190 (2003) (holding that the codified fair use doctrine under section 107 “contains built in First Amendment accommodations.”); *Roy Export Co. Establishment v. Columbia Broadcasting System, Inc.*, 672 F.2d 1095, 1099 (2d Cir.), *cert. denied*, 459 U.S. 826, (1982) (“[n]o Circuit that has considered the question . . . has ever held that the First Amendment provides a privilege in the copyright field distinct from the accommodation embodied in the ‘fair use’ doctrine.”); *Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65, 74–75 (2d Cir. 1999) (“First Amendment concerns are protected by and coextensive with the fair use doctrine.”).

Consistent with this jurisprudence, secondary uses which are merely incidental to the defendant’s communicative expression should not qualify for fair use protection. Thus, the Met’s privilege to override a photographer’s exclusive rights should only apply to secondary uses that are fundamental or integral to the Met’s First Amendment right to inform the public about works of historical significance.

Here, the Met's use of the Photograph was merely incidental to the Exhibition of the Guitar. Indeed, the District Court described the secondary use of the Photograph on the Website as "almost an afterthought." [JA-106] But if the Court does not find that the Photograph was integral to the Met's First Amendment right to educate the public about the Guitar, then there is no reason why the Met should be able to use the Photograph without a license.

The suspension of a copyright holder's exclusive rights under the fair use doctrine should be reserved for those cases where the secondary user is unable to exercise its First Amendment right in the absence of the protected copyrighted work, as was the case in *Campbell*. Indeed, the Met's use of the Photograph here was fungible, in the sense that the Met could have used other photographs of Van Halen to convey the same message about the historical significance of the Guitar.

In short, the use of photographs that are merely incidental to the secondary user's message, or which can be readily interchanged for other images to the convey an identical message, should be disqualified from claiming fair use.

**8. The District Court's Binary Analysis of the Transformative Inquiry is Premature and Improper**

Finally, Marano respectfully avers that the District Court’s analysis of the transformative inquiry was premature. The Court’s inquiry into whether a secondary use is transformative is not a “black or white” or binary issue but is a question of *degree*. Some uses, such as parody, may be considered highly transformative and therefore determined as a matter of law at the pleading stage. *See, e.g., Adjmi v. DLT Entm't Ltd.*, 97 F. Supp. 3d 512 (S.D.N.Y. 2015) (finding that off-Broadway play which mocked the television series “Three’s Company” was transformative); *see also Brownmark Films*, 682 F.3d at 687.

Courts may also determine as a matter of law that secondary uses are only “minimally transformative” and therefore dismiss the fair use defense. *See Monge*, 688 F.3d at 1176 (rejecting fair use defense as a matter of law where “wholesale copying sprinkled with written commentary . . . was at best minimally transformative”)

Marano respectfully avers that at the pleading stage, district courts should only resolve the crucial transformative inquiry in defendant’s favor if the secondary use is shown to be *highly* transformative. But in cases involving “close calls” where there may be some degree of transformative effect (or maybe not), the District Court should properly reserve judgment until after the development of a factual record.

Judge Brodie’s recent decision in *Coleman* provides useful guidance. There, the court denied a Rule 12(b)(6) motion to dismiss where defendant Home Box Office (“HBO”) invoked the fair use defense. HBO had used the plaintiff’s painting without permission in a documentary film about a crime saga. Judge Brodie denied the motion, finding that plaintiff had “plausibly alleged that Defendants’ use is not transformative.” *Coleman*, 2019 WL 8645387, at \*5.

Specifically, the *Coleman* court recognized that a reasonable person could ultimately find that HBO’s use of the painting added something new that alters the purpose or character of the painting. But the court also observed that “while Defendants’ stated purpose for the use of the Work is plausible, it is not the only plausible explanation . . . . It is plausible that Defendants used the Work in the Film solely as an illustrative aid depicting the subjects of the film, A.W., M.G., and Slenderman. This use would not be transformative.”). *Id.* at \*6.

Here, based on *Coleman*, if the Court determines that it is plausible that the Met’s use was not transformative (or only minimally transformative), then the District Court’s ruling should be reversed. *Id.* at \*6.

**B. IT IS PLAUSIBLE THAT THE MET’S USE WAS COMMERCIAL RATHER THAN NON-PROFIT**

“The first statutory factor specifically instructs courts to consider whether copyrighted materials are used for a commercial purpose or for a nonprofit educational purpose, the former tending to weigh against a finding of fair use.” *TCA Television Corp.*, 839 F.3d at 183 (citing *Campbell*, 510 U.S. at 585 (internal quotation marks omitted)).

The “crux of the profit/nonprofit distinction is . . . whether the user stands to profit from the exploitation of the copyrighted material without paying the customary price.” *Harper & Row*, 471 U.S. at 562. Thus, “when the copier directly and exclusively acquires conspicuous financial rewards from its use of the copyrighted material” a finding of fair use is less likely. *Associated Press*, 931 F.Supp.2d at 551 (quoting *Blanch*, 467 F.3d at 253).

Here, the Met is a not-for-profit entity, but that doesn’t mean it hasn’t acquired conspicuous financial reward from the *Play it Loud* Exhibition. The record shows that the Met invited web users to “Buy Tickets” or “Make a Donation” directly above display of the Photograph [JA-16-17; JA-93] As such, the Photograph was being used to solicit visitor interest and generate income for the Met. Such use could be deemed commercial. *See, e.g., American Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 922 (2d Cir. 1994) (stating that fair use claim will not be sustained when secondary use can fairly be characterized as “commercial exploitation” (internal quotation

marks omitted)); *Consumers Union of U.S., Inc. v. Gen. Signal Corp.*, 724 F.2d 1044, 1049 (2d Cir. 1983) (observing that some infringement actions involve copying of creative expression for “purpose of having that precise form of expression advance someone else’s commercial interests -- for example, using well-known copyrighted lines to attract attention to an advertisement”); *see also Richard Feiner & Co., Inc. v. H.R. Industries, Inc.*, 10 F.Supp.2d 310, 314 (S.D.N.Y. 1998) (finding that commercial advertisements appearing alongside the unauthorized use of photographs demonstrated a defendant’s commercial purpose).

In addition to using the Photograph to advertise and sell tickets to its Exhibition, the Met arguably used the Photograph to promote ancillary commercial products, such as a picture album available at The Met Store. [JA-75]. *See Campbell*, 510 U.S. at 585 (The use “of a copyrighted work to advertise a product, even in a parody, will be entitled to less indulgence under the first factor of the fair use enquiry than the sale of a parody for its own sake.”).

In short, it is plausible that the Met used the Photograph for commercial purposes. Defendant argues that it did not receive significant revenues as a result of exploiting Plaintiff’s work. But that issue cannot possibly be determined on the face of the pleadings. Plaintiff is entitled to

discovery on the issue of how many people paid to see Plaintiff's work, how much money was generated, and what the attendance rates were relative to other exhibitions.

Further, the District Court erred by discounting the commercial nature of its secondary use [JA-107] because the District Court's analysis of the transformative effect is fundamentally flawed, as per Point I.A, *supra*. See *United States v. Am. Soc. of Composers Authors & Publishers*, 599 F.Supp.2d 415, 429 (S.D.N.Y. 2009) (“[A]pplicant's use of previews is not transformative, and, thus, the significance of its commercial use is not reduced, but instead takes on greater importance.”).

**C. THE MET'S USE WAS NOT IN GOOD FAITH BECAUSE IT FAILED TO PROPERLY CREDIT MARANO**

“Also relevant to the ‘character’ of the use is ‘the propriety of the defendant's conduct.’ *Harper & Row Publishers*, 471 U.S. at 562–63 (citing 3 Nimmer § 13.05[A], at 13–72).

“As the term itself suggests, ‘[f]air use presupposes good faith and fair dealing.’ *Associated Press*, 931 F.Supp.2d at 552 (citing *Harper & Row*, 471 U.S. at 562 (quoting Schulman, Fair Use and the Revision of the Copyright Act, 53 Iowa L.Rev. 832 (1968))). Thus, in weighing the first factor, the Court may also consider “the propriety of a defendant's conduct.”



*NXIVM Corp.*, 364 F.3d at 478 (citations omitted); see also *Oracle Am., Inc. v. Google LLC*, 886 F.3d 1179, 1203 (Fed. Cir. 2018), *cert. granted*, 140 S. Ct. 520, 205 L. Ed. 2d 332 (2019) (“bad faith may weigh against fair use”)

Here, the absence of good faith is evidenced by the fact that the Met failed to provide Marano’s attribution in connection with its display of the Photograph over multiple media platforms (even though it knew or should have known that Marano was the copyright holder). [JA-16-19]<sup>5</sup>

The Met’s omission of any credit to Marano demonstrates the Met’s absence of good faith and fair dealing in its use of the Photograph. *See Hirsch v. Complex Media, Inc.*, No. 18 CIV. 5488 (CM), 2018 WL 6985227, at \*6 (S.D.N.Y. Dec. 10, 2018) (rejecting fair use defense and finding that news organization’s omission of photographer’s authorship credit provided an inference of bad faith); *Marcus v. Rowley*, 695 F.2d 1171, 1175–76 (9th Cir.1983) (no attempt to credit copyright owner weighs against fair use); *accord Rogers v. Koons*, 960 F.2d 301, 309 (2d Cir. 1992) (finding that defendant’s “action [in tearing the copyright mark off of the original work]

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<sup>5</sup> The Met corrected this omission in response to this lawsuit. [JA-93] However, the propriety of The Met’s conduct should be measured as of the time of the alleged infringement, not after this lawsuit was filed. Also, The Met did not produce any evidence that it provided attribution to Marano as part of the physical Exhibition at the Museum between April and October 2019, when the Photograph was on display.

suggests bad faith in defendant's use of plaintiff's work, and militates against a finding of fair use.").

The Met claims that it "has the utmost respect for artists, including photographers, and their need to protect their rights." [JA-40] However, the fact that The Met holds itself out as a champion of photographers' rights, but then brazenly failed to credit Marano as the author of the Photograph during the relevant timeframe, is inexcusable and should disqualify the Met from availing itself of the fair use privilege, which itself is an "equitable doctrine", *Rogers*, 960 F.2d at 309 that "presupposes good faith and fair dealing." *Associated Press*, 931 F.Supp.2d at 552

Finally, there are questions of material fact as to the *degree* of bad faith involved in the Met's decision to omit Marano's attribution from the Photograph. For example, discovery could reveal that the Met's organizers deliberately omitted Marano's attribution to conceal its own infringement. Or maybe the Met believed that crediting photographers was simply unnecessary, which would indicate a reckless disregard for photographers' rights. Either way, additional evidence obtained from discovery could help inform the overall analysis of the first fair use factor, which was prematurely decided by the District Court.

**POINT II: MARANO’S PHOTOGRAPH IS CREATIVE AND SHOULD BE ACCORDED APPROPRIATE WEIGHT (FACTOR #2)**

The second statutory factor examines the “nature of the copyrighted work.” 17 U.S.C. § 107(2). As the Supreme Court has observed, certain “works are closer to the core of intended copyright protection than others, with the consequence that fair use is more difficult to establish when the former works are copied.” *TCA Television Corp.*, 839 F.3d at 184.

In analyzing the second factor, the Court considers “(1) whether the work is expressive or creative, with a greater leeway being allowed a claim of fair use where the work is factual or information, and (2) whether the work is published or unpublished.” *Blanch*, 467 F.3d at 256.

“The mere fact that the original is a factual work . . . should not imply that others may freely copy it,” as “authors of factual works, like authors of fiction, should be entitled to copyright protection of their protected expression.” *Authors Guild v. Google, Inc.*, 804 F.3d 202, 220 (2d Cir. 2015), *cert. denied*, 136 S. Ct. 1658 (2016). “Photographic images of actual people, places and events may be as creative and deserving of protection as purely fanciful creations.” *Monster Communications, Inc. v. Turner Broadcasting*, 935 F.Supp. 490, 494 (S.D.N.Y. 1996); *see also Baraban v. Time Warner*, No. 99-cv-1569 (JSM), 2000 WL 358375 at \*4 (S.D.N.Y.

April 6, 2000) (“Although photographs are often ‘factual or informational in nature,’ the art of photography has generally been deemed sufficiently creative to make the second fair use factor weigh in favor of photographer-plaintiffs.”); *Monge*, 688 F.3d at 1177 (“Photos that we now regard as iconic often document an event -- whether the flight of the Wright Brothers’ airplane, the sailor’s kiss in Times Square on V–J Day, the first landing on the moon, or the fall of the Berlin Wall.”).

Here, the District Court found that the Photograph is creative. [JA-108] Yet, it discounted weight given to the second factor because the Met’s use was found to be transformative in nature. [*Id.* citing *Blanch*, 467 F.3d at 257 (“[T]he second factor may be of limited usefulness where the creative work of art is being used for a transformative purpose.”)]

But since the District Court’s transformative inquiry is flawed, see Point I.A, *supra*, it erred by discounting the second factor in the overall analysis.

### **POINT III: THE MET USED MORE OF THE PHOTOGRAPH THAN WAS NECESSARY (FACTOR #3)**

The third factor bearing on fair use asks whether “the amount and substantiality of the portion used in relation to the copyrighted work as a whole . . . are reasonable in relation to the purpose of the copying.”

*Campbell*, 510 U.S. at 586 (quoting 17 U.S.C. § 107(3)). In assessing this factor, the Court considers not only “the quantity of the materials used” but also “their quality and importance.” *Id.* at 587.

The Court should also consider whether the portion taken is “essentially the heart” of the copyrighted expression. *NXIVM Corp.*, 364 F.3d at 480 (citation omitted). The “most relevant” question for this factor is whether the infringer has taken “no more” than is necessary. *Infinity Broadcast Corp.*, 150 F.3d at 110. “[T]he more of a copyrighted work that is taken, the less likely the use is to be fair.” *Id.* at 109.

Here, the District Court determined that even though the Met used the entire Photograph, such use was reasonable in light of the purpose and character of use. [JA-109] The District Court again relied on *Bill Graham Archives*, which involved tiny thumbnail images incorporated into a collage format. [*Id.*] See *Bill Graham*, 448 F.3d at 613 (“We conclude that such use by [the defendant] is tailored to further its transformative purpose because [defendant's] reduced size reproductions of [the plaintiff's] images in their entirety displayed the minimal image size and quality necessary to ensure the reader's recognition of the images as historical artifacts of Grateful Dead concert events.”)

In the case at bar, unlike *Bill Graham Archives*, the Met did not use

“reduced size reproductions” or the “minimal image size and quality necessary” for the Met’s visitors to recognize the images as historical artifacts. Quite to the contrary, the Met used full-scale reproductions of the Photograph [JA-116-17; JA-93] across multiple media platforms in multiple locations, including the brick-and-mortar Exhibition on Fifth Avenue. [JA-41, fn. 3]

Moreover, the District Court’s analysis of the third factor is not sustainable because its finding with respect to the first factor is flawed, see Point I.A., *supra*. Indeed, it was premature for the District Court to assess this factor in light of the factual disputes concerning the Met’s purpose for using the Photograph. *See, e.g., N. Jersey Media Grp. Inc. v. Pirro*, 74 F. Supp. 3d 605, 621 n.18 (S.D.N.Y. 2015) (stating that the third factor of the fair use analysis is dependent on the purported purpose of the copyrighted work’s use, and declining to assess the third factor because an issue of fact existed as to the first factor); *May v. Sony Music Entm’t*, No. 18-CV-2238, 2019 WL 2450973, at \*14 (S.D.N.Y. Feb. 13, 2019) (declining to assess the third factor “without further development of the record examining what [the d]efendants sought to accomplish and how they did so”).

**POINT IV: THE MET'S UNAUTHORIZED USE PLAUSIBLY CAUSED ACTUAL MARKET HARM AS WELL AS HARM TO THE POTENTIAL MARKET**

The final fair use factor considers “the effect of the use upon the potential market for or value of the copyrighted work.” 17 U.S.C. § 107(4).

The Supreme Court declared in *Harper & Row* that “[t]his last factor is undoubtedly the single most important element of fair use.” 471 U.S. at 566 (footnote and citation omitted).

The fourth factor “requires courts to consider not only the extent 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.” *Ringgold*, 126 F.3d at 80-81 (citing *Campbell*, 510 U.S. at 590 (quotation omitted)).

A copyright owner is not required to show that actual harm has come to her, *Sony Corp.*, 464 U.S. at 451, but must show merely a “potential” effect on the market for the copyrighted work. *Harper & Row*, 471 U.S. at 568–69. The Court therefore properly considers the challenged use’s “impact on potential licensing revenues for traditional, reasonable, or likely to be developed markets.” *American Geophysical Union*, 60 F.3d at 930; accord *Swatch Grp. Mgmt. Servs.*, 756 F.3d at 91. Accordingly, “to

negate fair use one need only show that if the challenged use should become widespread, it would adversely affect the *potential* market for the copyrighted work.” *Id.*

Here, not unlike the case in *TCA Television*, the District Court “disregarded the possibility of defendants’ use adversely affecting the licensing market for the” Photograph. *TCA Television Corp.*, 839 F.3d at 186 (citing *Cariou*, 714 F.3d at 708 (stating that fourth factor “does not focus principally on the question of damage to [a] derivative market”)).

As a threshold matter, the Court may presume market harm because the Met’s secondary use was not transformative and constituted a wholesale reproduction of Marano’s original photograph. *See Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 450 (1984) (holding that “every commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright”). “A presumption of market harm “makes common sense[ ] when a commercial use amounts to mere duplication of the entirety of an original.” *Campbell*, 510 U.S. at 591.

Even if *Sony*’s presumption does not apply, the Met’s secondary use impairs the actual market for the Photograph because, as the Met’s own evidence shows [JA-93], there was a fully functioning market demand for



the Photograph as it was available for license through Getty Images. *See Associated Press*, 931 F.Supp.2d at 559 (“Where there is a fully functioning market for the infringer’s use of the copyrighted material, it will be difficult for the infringing party to show that it made fair use without paying a licensing fee”) (citing *Harper & Row*, 471 U.S. at 566 n. 9).

Defendant’s unauthorized use clearly supplanted the market in which Plaintiff had a reasonable expectation to earn licensing revenue. *See, e.g., Fitzgerald v. CBS Broadcasting*, 491 F.Supp.2d 177, 189 (D. Mass. 2007) (“CBS’s use of the photographs is paradigmatic of the only market the photographs could reasonably have: licensing to media outfits . . . . If the Court finds that CBS’s use was fair use, then all of these media uses—and uses like them in the future—would also be fair use, destroying the only potential market that exists for the photographs”); *Otto*, 345 F. Supp. 3d at 432–33 (“Publishing the Photograph without permission essentially destroys the primary market for its use . . . . The fact that the Photograph was reported on so widely indicates that there was indeed a market for it . . . . Thus, the publication can reasonably be expected to harm Plaintiff’s ability to license the work for publication and use in derivative works.”).

The District Court’s analysis of the fourth factor is based on raw speculation rather than on any record evidence. [JA-110-111 (summarily

defining the traditional market as “collectors of photographs of rock legends or other persons seeking to showcase Van Halen.”)] The Court also reasoned that museums necessarily occupy a transformative market and that it is therefore “unlikely that markets for the Photo’s original expressive purpose would be affected in any way.” [JA-111] But, again, these conclusions are merely presumptive and not supported by any evidence.

In *Debra Rothenberg v. The Museum of Fine Arts, Houston*, 4:19-cv-03026-GCH (S.D. Texas – Houston Div.), the plaintiff-photographer asserted a copyright infringement claim against the Museum of Fine Arts, Houston (“MFAH”) for displaying on its public-facing website an historic photograph of the World Trade Center during 9/11 terrorist attack. MFAH filed a motion to dismiss the amended complaint on grounds of fair use. [See *Rothenberg*, Dkt. #30] The district court denied the Rule 12(b)(6) motion as premature, finding that it was preferable to develop a factual record of the fair use defense for purpose of summary judgment. [See *Rothenberg*, Dkt. #37; accord *Browne v. McCain*, 612 F.Supp. 2d 1125, 1130 (C.D. Cal. 2009) (“[G]iven the early stage of this case, undeveloped factual record, limited factual allegations in the Complaint, existence of potentially disputed material facts, and nature of the Court’s inquiry on a 12(b)(6) motion, the

Court declines RNC's invitation to undertake the fair use analysis at this time."').

Similar to *Rothenberg*, Marano should be accorded the opportunity to develop a factual record on the critical issue of market harm. For example, Plaintiff may discover information related to the Met's policies and practices concerning the licensing and display of photographic content on the Met's public-facing website and at the Museum, invoices showing the number of photographs that were licensed in connection with the *Play it Loud* Exhibition, any internal correspondence relating to the Photograph, documents showing the number of visitors to the Met's Website during the time period in question, documents showing the number of tickets that were purchased to the Exhibition through use of the Website.

Indeed, it is plausible that the same audience who would be interested in seeing a classic photograph of Eddie Van Halen in performance would also be interested in viewing his iconic guitar on physical display at a museum. At the pleading stage, it is entirely plausible that fans of Van Halen (the very same people who would likely be interesting in viewing Van Halen's guitar on display on Met) would also want to license the Photograph for vintage T-shirts or memorabilia. It is also plausible that competing museums, such as the Rock 'n Roll Hall of Fame in Cleveland, would be

interesting in licensing photographs for historical exhibitions. Discovery is needed to determine what markets actually or potentially exist for the Photograph and how the Met's secondary use impacts those markets.

In the end, Plaintiff is entitled to collect licensing fees in whatever reasonably expected potential markets may exist. *See Michael Grecco Prods., Inc. v. Valuwalk, LLC*, 345 F. Supp. 3d 482, 508–09 (S.D.N.Y. 2018) (“the inquiry [of the fourth factor] looks to whether infringement will affect the *potential* market for the copyrighted work in “traditional, reasonable, or *likely to be developed* markets.” (citing *Bill Graham Archives*, 448 F.3d at 614 (emphasis added)).

At this stage of the proceeding, it is unclear whether the Met licenses photographic content for use in its on-line catalogue. If the Met has an ordinary practice of licensing photographs for use on its website, then it certainly can be found that a potential market exists for the Photograph.

Finally, it should be emphasized that *Bill Graham Archives* was decided on summary judgment based on a fully developed factual record, not at the pleading stage as was the case here.

**POINT V: THE DISTRICT COURT DID NOT PROPERLY WEIGH THE FOUR STATUTORY FACTORS**

In the wake of this Court's ruling in *Cariou*, the leading copyright treatise, Nimmer, warned that the intense focus on the transformative inquiry threatened to swallow whole the fair use doctrine. See *TCA Television Corp.*, 839 F.3d at 181 (citing Nimmer § 13.05[B][6], at 13.224.20) (stating with respect to *Cariou*: "It would seem that the pendulum has swung too far in the direction of recognizing any alteration as transformative, such that this doctrine now threatens to swallow fair use. It is respectfully submitted that a correction is needed in the law.")

That's precisely what happened in this case. The District Court determined that the Met's use was transformative *per se* on grounds of scholarship, and then quickly dispatched of every other statutory factor, holding that such factors could not weigh against fair use because the use was transformative.

Plaintiff respectfully submits the Court should take this opportunity to correct the District Court (and other district courts within this Circuit) which have permitted the transformative inquiry to swallow the entire fair use analysis. What is particularly troubling about this trend is the binary nature of the inquiry, meaning that a district court declares a secondary use as either transformative or not transformative – and then all of the other factors get subsumed into the binary analysis.

But the Court should recognize that the transformative inquiry is a matter of degree. District courts should be required to measure the transformativeness of a secondary work through a series of gradations, e.g., not transformative, minimally (or marginally) transformative, moderately transformative, or highly transformative, so as to provide this Court the opportunity to conduct a meaningful review. By recognizing the various gradations, the Court will then have a better idea of which uses can be declared transformative as a matter of law (or not), versus which uses should be reserved for the fact-finder. *See Ferdman v. CBS Interactive Inc.*, 342 F. Supp. 3d 515, 535 (S.D.N.Y. 2018) (denying summary judgment on fair use, and stating “[w]hile the Court concludes that Defendant's use of the Holland Photograph is somewhat transformative, it is not so transformative as to entitle Defendant to a fair use defense as a matter of law.”).

### **CONCLUSION**

Based on the foregoing, Plaintiff Lawrence Marano respectfully submits that the District Court’s overly broad application of the fair use doctrine should be rejected, and the Court should reverse the District Court’s ruling and remand this case for further proceedings.

Dated: November 9, 2020  
Valley Stream, New York

Respectfully submitted,

**/s/jameshfreeman/**

James H. Freeman

*Counsel for Plaintiff-Appellant*

**CERTIFICATE OF COMPLIANCE**

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