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Intellectual Property

Fair Use or Foul? Second Circuit Examines Play's Use of 'Who's on First?'

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The purpose of copyright law, according to the U.S. Constitution, is to "promote the Progress of Science and useful Arts," by granting authors the exclusive right to control their works "for limited Times." Over the years, with successive amendments of the Copyright Act, that "limited time" has grown longer and longer, and the scope of exclusive control has increased. But the Copyright Act has also evolved certain exceptions that permit courts to avoid applying it rigidly when doing so would stifle the creativity it is designed to foster. The best known of these is the "fair use" doctrine, which first arose at common law and is now codified in §107 of the Copyright Act. But although the fair use doctrine is certainly well known, it is not always well understood—not even by the courts that have to interpret it.

Fair Use Fundamentals

Section 107 is a curious statute. It does not really define fair use; it merely states that the "fair use" of a work "for purposes such as criticism, comment, news reporting, teaching ... scholarship or research, is not an infringement of copyright." It then lays out four non-exclusive factors that courts should look at to determine whether a particular use is protected by the exception: "(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work."

The analysis of these factors is highly fact specific, and the language of §107 gives little guidance as to how they should be evaluated or weighted. Many courts, faced with this complex task, have turned to the concept of "transformative use" as the touchstone for protection, at least under the "purpose and character" factor. The concept of transformative use was first suggested by Judge Pierre Leval (now of the Second Circuit) in a 1990 article [Harvard Law Review](#) article, and subsequently adopted by the U.S. Supreme Court in [Campbell v. Acuff-Rose](#). It asks whether a potentially infringing work "merely supersedes the

objects of the original creation" or whether it "instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message."¹

In recent years, courts have increasingly (and in some cases improperly) treated transformative use as a *proxy* for fair use, rather than just a single element of a complex, context-driven test. As a result, some commentators (including David Nimmer, likely the world's most cited copyright treatise author) have suggested publicly that the expanded definition of "transformative use" has gone too far, and some correction in the law may be needed. After all, if *any* alteration of a protected work is a "transformation" that grants fair use protection, what is left of the author's statutory right to make and control derivative works?

'TCA TV v. McCollum'

With that background firmly in mind, the Second Circuit recently drew upon principles of copyright law and dramatic expression to determine whether fair use should protect the unaltered, unauthorized use of more than a minute of Abbott and Costello's famous comedy routine, *Who's on First?* in the contemporary Broadway play *Hand to God*. The District Court had found the use protected, largely because *Hand to God* is a far darker comedy than anything Bud Abbott and Lou Costello could ever have imagined. The Second Circuit disagreed. The decision provides an important discussion and analysis of the outside limits of transformative use and fair use from what is probably the most important copyright court in the country, outside of the Supreme Court.

In *TCA TV v. McCollum*,² plaintiffs were successors-in-interest to the estates of William "Bud" Abbott and Lou Costello. They sued the author and producers of the play "Hand to God," for a scene that incorporated part of the Abbott and Costello' classic comedy routine *Who's on First?* Although the routine is instantly recognizable,³ the court dutifully explained it: "The Routine's humor derives from misunderstandings that arise when Abbott announces the roster of a baseball team filled with such oddly named players as 'Who,' 'What,' and 'I Don't Know.' A rapid-fire exchange reveals that 'who's on first' need not be a question. It can be a statement of fact." Abbot and Costello began performing the routine in the 1930s. It was first published as a matter of copyright law when they performed it in the movie *One Night in the Tropics*, which was released in 1940.

More than 60 years later, *Hand to God* opened on Broadway. Plaintiffs' suit was based on a single scene of the play, in which the protagonist, "Jason," tries to woo his love interest, "Jessica." Jason and Jessica emerge from a church basement after a Christian puppet workshop. Jason tries to impress Jessica by performing, verbatim, about a minute of the *Who's on First?* routine, with himself as Abbott and his sock puppet, "Tyrone," taking the part of Costello. After finishing the routine, Jason soaks up praise from Jessica, and when she asks "Did you come up with that all by yourself[?]" Jason answers, "Yes," arousing laughter from the audience, which recognizes the brazen lie.

Tyrone, the sock puppet on Jason's own hand, then calls Jason a liar and explains that the performance is "a famous routine from the [F]ifties." Jason corrects him, saying it's from the "Forties." The puppet then insults Jessica, who Jason is trying to woo, by saying she would know the routine's origin if she "weren't so stupid." Jason and Jessica tell Tyrone to "shut

up," but he doesn't and instead vulgarly divulges Jason's desire for Jessica. After a physical struggle, Jason removes Tyrone, the sock puppet, from his hand and tries to apologize, but Jessica quickly exits. The scene is pivotal to *Hand to God* and was used (along with the *Who's on First?* routine) in its advertising and promotion.

Plaintiffs sued for infringement based on the use of *Who's on First?*, and defendants filed a motion to dismiss. The District Court granted the motion on the grounds that defendants' use of the routine was "highly transformative" and protected under the doctrine of fair use.⁴ Plaintiffs appealed to the Second Circuit. The appeal was heard by Judges Dennis Jacobs, Guido Calabresi and Reena Raggi.

Second Circuit's Fair Use Analysis

In a unanimous decision, the court rejected the District Court's ruling on fair use. Although the court ultimately affirmed dismissal of the infringement claim on another ground (plaintiffs failed to establish that they actually owned the copyright in the routine) the fair use analysis is highly instructive.

The court begins by laying out the four statutory fair use factors and discussing the state of fair use law; but the opinion focuses on the first factor and specifically the question of transformative use. The opinion notes that defendants' use of *Who's on First?* does not fit within any of the enumerated statutory examples of fair use: criticism, comment, news reporting, teaching, scholarship, or research. It therefore looks to the questions of whether defendants' use was transformative and whether it had a "commercial purpose."

The District Court concluded that defendants' use of the routine was transformative based on what the Second Circuit called "the general artistic and critical purpose and character of *the Play*." That is, the routine was used in a different artistic context—one far darker and more cynical than any of Abbott and Costello's work—even if the routine itself was unchanged and used for the same purpose of provoking audience laughter. But the Circuit rejected that analysis: The "critical inquiry" is not whether *Hand to God* "serves a purpose or conveys an overall expression, meaning, or message different from" *Who's on First?* The inquiry is whether *Hand to God* "uses the copyrighted material itself [*Who's on First?*] for a purpose, or imbues it with a character, different from that for which it was created."⁵ In particular, the court cited *Cariou v. Prince*, another case that addressed an artist's incorporation of another artist's work in his own, for the rule that "the new work 'generally must alter the original with new expression, meaning, or message.'"⁶ It is not enough to use the work, unaltered, in a new context—the work itself must be transformed.

The court acknowledged that in close cases there might be a dispute about whether the alteration of the original was sufficient. But not in this case: The routine was used unchanged, as it had to be for the play's reveal. Nor could defendants argue that the routine's dramatic purpose in the play (as opposed to its comedic one) justified a finding of transformative use. The court noted that the play could easily have used some other familiar cultural landmark (perhaps one in the public domain) rather than *Who's on First?* to achieve the same theatrical effect. When coupled with defendants' commercial use of the routine in both the play and its marketing material, the court concluded that there could be no finding of transformative fair use.

Conclusion

Fair use analysis is complicated and fact specific, and intellectual property lawyers know that if your client is relying on a fair use defense, it's never a slam dunk. After *Cariou*, though, there was an argument that the definition of transformative use was expanding into areas of artistic appropriation that would previously have been well over the line into infringement. Several notable commentators looked at that case as a substantial expansion, and some suggested that a re-examination might be appropriate. *TCA TV* can certainly be read as the court's response to that criticism: A pulling back from the expansion of transformative use that still maintains the fundamentals established by Judge Leval and the Supreme Court. Practitioners should examine the opinion and keep an eye out, as this area continues to evolve rapidly, even after 20 years of development.

Endnotes:

1. Pierre N. Leval, "Toward a Fair Use Standard," 103 Harv. L. Rev. 1105, 1111 (1990); [Campbell v. Acuff-Rose Music, 510 U.S. 569, 579 \(1994\)](#) (internal quotations omitted).
2. *TCA TV v. McCollum*, 16-134-CV, 2016 WL 5899174, at *1 (2d Cir. Oct. 11, 2016).
3. See <https://www.youtube.com/watch?v=kTcRRaXV-fg>.
4. [TCA TV v. McCollum, 151 F. Supp. 3d 419, 434 \(S.D.N.Y. 2015\) \(Daniels, J.\)](#).
5. Id.
6. [Cariou v. Prince, 714 F.3d 694, 706 \(2d Cir. 2013\)](#).

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