

DENNIS JACOBS, Circuit Judge, concurring:

I concur in the opinion of the Court as well as Judge Sullivan's concurrence. I write briefly to make a single point: the holding does not consider, let alone decide, whether the infringement encumbers the original Prince Series works that are in the hands of collectors or museums.

It is very easy for opinions in this area (however expertly crafted) to have undirected ramifications. A sound holding may suggest an unsound result in related contexts.

The sixteen original works have been acquired by various galleries, art dealers, and the Andy Warhol Museum. This case does not decide their rights to use and dispose of those works because Goldsmith does not seek relief as to them. She seeks only damages and royalties for licensed reproductions of the Prince Series.

Although the Andy Warhol Foundation initiated this suit with a request for broader declaratory relief that would cover the original works, Goldsmith did not expressly join issue. The Declaratory Judgment Act is reserved for disputes that are percolating over parties' rights and obligations while harm threatens to accrue. See United States v. Doherty, 786 F.2d 491, 498–99 (2d Cir. 1986)

(Friendly, L); see also Broadview Chem. Corp. v. Loctite Corp., 417 F.2d 998, 1001 (2d Cir. 1969) (articulating the criteria for deciding whether to entertain a declaratory judgment action). But Goldsmith does not claim that the original works infringe and expresses no intention to encumber them; the opinion of the Court does not necessarily decide that issue.

The issue, however, still looms, and our holding may alarm or alert possessors of other artistic works. Warhol's works are among many pieces that incorporate, appropriate, or borrow from protected material. Risk of a copyright suit or uncertainty about an artwork's status can inhibit the creativity that is a goal of copyright.

A key consideration in this case is the effect of the Prince Series on the market for Goldsmith's photograph. Our decision depends heavily on the commercial competition between the photograph and the reproduced versions of the Prince Series.

As the opinion observes, the market for the photograph and the market for the original Prince Series works are distinct. See Majority Op. at 45. An original work of art is marked by the hand or signature of the artist, which is a preponderating factor in its value. When the work is reproduced, it loses that

mystique, as anyone who has browsed a gift shop can appreciate. In a word, the original works and Goldsmith's photograph are not "substitutes." Castle Rock Ent., Inc. v. Carol Publ'g Grp., 150 F.3d 132, 145 (2d Cir. 1998).

But when represented on a magazine cover, the Prince Series functions as a portrait of the musician Prince--as does Goldsmith's photograph. The Prince Series retains the photograph's expressive capacity for Prince portraiture and is sought for that purpose. It may well compete for magazine covers, posters, coffee mugs, and other media featuring the late musician. If the Foundation had refuted the evidence of such market displacement, the weight of the analytical considerations would have changed.