



# COLUMBIA LAW REVIEW

VOL. 90

JUNE 1990

NO. 5

*Copyright © 1990 by Directors of The Columbia Law Review Association, Inc. All rights reserved.*

## CONTENTS

### TRIBUTE—PROFESSOR ROBERT E. HELLAWELL

<i>Statement of the Faculty</i>	1181
Curtis J. Berger	1183
Richard E. Andersen	1185

## ARTICLES

### "PROBATIVE SIMILARITY" AS PROOF OF COPYING: TOWARD DISPELLING SOME MYTHS IN COPYRIGHT INFRINGEMENT

*Alan Latman* 1187

### THE ORIGINAL MEANING OF THE NINTH AMENDMENT

*Thomas B. McAfee* 1215

### CONTRACTARIANISM WITHOUT CONTRACTS: A RESPONSE TO PROFESSOR MCCHESENEY

*Melvin Aron Eisenberg* 1321

### CONTRACTARIANISM WITHOUT CONTRACTS? YET ANOTHER CRITIQUE OF EISENBERG

*Fred S. McChesney* 1332

## NOTES

### THE USE OF CIVIL RICO AGAINST ANTIABORTION PROTESTERS AND THE ECONOMIC MOTIVE REQUIREMENT

*Adam D. Gale* 1341

### AVOIDANCE RECOVERIES IN BANKRUPTCY: FOR THE BENEFIT OF THE ESTATE OR THE SECURED CREDITOR?

*Nancy L. Sanborn* 1376

### Trial Participant Speech Restrictions: Gagging First Amendment Rights

*Michael E. Swartz* 1411

## BOOK NOTES

1445

## “PROBATIVE SIMILARITY” AS PROOF OF COPYING: TOWARD DISPELLING SOME MYTHS IN COPYRIGHT INFRINGEMENT

*Alan Latman\**

*On the 200th anniversary of our first copyright statute, the Columbia Law Review is especially pleased to publish the late Professor Alan Latman’s illuminating article clarifying the elements of proof in copyright infringement cases and urging the adoption of the new term “probative similarity” in the infringement lexicon. Professor Latman’s close friends and professional colleagues knew of his efforts to complete his study of infringement in the last year of his life and found his unfinished manuscript among his papers after his death in 1984. Though without footnotes, the article’s text was already well formulated and near completion, bearing the hallmark of Professor Latman’s eloquence, insight and erudition. Using their knowledge of Professor Latman’s favorite cases and other authorities, his colleagues proceeded to construct and add the footnotes. This effort was further assisted by the Columbia*

---

\* Alan Latman’s untimely death in 1984 was mourned by the Copyright Society of the U.S.A., which he served for many years as Executive Director, as the passing of “the Renaissance man of copyright.”

Alan Latman was born in 1930 in New York City, attended Erasmus Hall High School in Brooklyn and received his A.B. summa cum laude in 1950 from New York University. He received his L.L.B. from the Harvard Law School in 1953, where he was a member of the Board of Editors of the *Harvard Law Review*.

After serving in the United States Army’s Judge Advocate General’s Corps, he went to work at the Copyright Office. As Special Consultant to the Register of Copyrights (1957–58), he became involved in the early efforts to revise the Copyright Act of 1909. This led to the Register’s invitation to prepare his seminal 1958 study on “Fair Use of Copyrighted Works,” subsequently cited at length in the Supreme Court’s leading fair use cases.

In 1960, Alan Latman became a founding partner in the New York City firm of Cowan, Liebowitz & Latman, P.C. There he specialized in copyright litigation, arguing many important cases in federal courts, including the Supreme Court. He also performed substantial pro bono work throughout his career.

In 1976, Alan Latman joined the New York University Law School as a full Professor of Law. As a professor, with characteristic devotion to his students and work, he continued to teach, chair the law school’s Admissions Committee, and serve on its Personnel Committee throughout the period of his illness. Shortly before he died, he was named the New York University Law School’s first Walter J. Derenberg Professor of Copyright and Trademark Law.

In addition to his numerous articles on the subject of copyright, Professor Latman authored the revised (fourth) edition of *Howell’s Copyright Law* (1962) and its successor, *Latman’s The Copyright Law* (5th ed. 1979), as well as his case book *Copyright for the Eighties* (1981), coauthored by Robert Gorman. He also served as editor and supervisor of *The Kaminstein Legislative History Project: A Compendium and Analytical Index of Materials Leading to the Copyright Act of 1976* (1981) and wrote the chapter on United States law in *Copinger & Shone James on Copyright* (12th ed. 1980).

Law Review... *Throughout, the original expression was maintained to preserve the work's authenticity.*

*Because of the validity of Professor Latman's thesis and the quality of his analysis, the significance and usefulness of the article has been unaffected by the passage of time. There has therefore been no need for modification of its substantive content and little necessity to supplement 1984 decisional law with subsequent developments. However, in a few instances, newer cases providing further examples and support for Professor Latman's argument have been included. As a result, the article stands as a kind of "unfinished symphony," of historical interest as the last written work of one of the nation's foremost copyright scholars, and of continuing importance as a work of practical legal scholarship.*

"In order to prove infringement a plaintiff must show ownership of a valid copyright and copying by the defendant. . . . Since direct evidence of copying is rarely, if ever, available, a plaintiff may prove copying by showing access and 'substantial similarity' . . . ."<sup>1</sup>

This kind of litany, laced with respectable authorities, is intoned fairly early in the legal analyses of many thoughtful judicial opinions addressing issues of copyright infringement. Sometimes the opinions go on to explain or modify the ambiguity,<sup>2</sup> overstatement<sup>3</sup> and oversimplification<sup>4</sup> lurking in this compressed statement. Sometimes they do not.<sup>5</sup> But rarely does a court correct its statement that similarity, to be probative of copying, must be "substantial."

It is the thesis of this Article that such probative similarity need not be "substantial." This is not to say that it *may* not be. Nor would the statement need correction if the word "substantial," as used in a copyright context, did not, as it does, connote an appreciable amount of qualitatively significant material. But a correct perception of the nature of similarity in this context will at the very least clarify the elements of proof required in copyright infringement cases, the variety of methods available to establish those elements and the proper standards for appellate review of infringement issues.

## I. THE SOURCE OF THE PROBLEM

Copyright infringement does indeed require a showing of "copying by defendant" as set forth in the quotation being examined. But

---

1. Novelty Textile Mills v. Joan Fabrics Corp., 558 F.2d 1090, 1092 (2d Cir. 1977).

2. See, e.g., Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904, 907 (3d Cir.), cert. denied, 423 U.S. 863 (1975).

3. See, e.g., Sid & Marty Krofft Television Prods. v. McDonald's Corp., 562 F.2d 1157, 1162-63 (9th Cir. 1977).

4. See Walker v. Time Life Films, Inc., 784 F.2d 44, 48 (2d Cir.), cert. denied, 476 U.S. 1159 (1986); Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607, 614 (7th Cir.), cert. denied, 459 U.S. 880 (1982).

5. See, e.g., Kamar Int'l, Inc. v. Russ Berrie & Co., 657 F.2d 1059, 1062 (9th Cir. 1981).

copying, in order to be *prima facie* actionable,<sup>6</sup> must include three elements:

(1) The defendant must have seen or heard the plaintiff's work at some time prior to creating his or her own work *and* have used plaintiff's work in some fashion as a model. Thus, "copying" in the first instance is the obverse of independent creation.<sup>7</sup>

(2) The material copied by defendant from plaintiff's work must be such as enjoys protection under copyright. Thus, if all defendant copied from plaintiff's work was a report originally issued by the Department of Defense, such material is excluded by the statute from copyright protection,<sup>8</sup> and defendant will not be held to have infringed. This requirement illustrates the correlation between questions of copyrightability and infringement: defendant's taking of uncopyrightable material from plaintiff's work does not infringe.<sup>9</sup>

(3) Not only must defendant copy, rather than independently create, and not only must he or she copy protected material, but also such protected material must be "substantial."<sup>10</sup> Thus, to satisfy this requirement, plaintiff would have to show a substantial degree or order of similarity or "substantial similarity" between the works of plaintiff and defendant.

The foregoing demonstrates that the term "substantial similarity" is properly used to describe only the third requirement we have examined. Yet as our opening litany demonstrates, courts frequently use the term to describe the first requirement. We have now reached the source of the confusion—the borrowing from one requirement for use in another. "Substantial similarity," while said to be required for indirect proof of copying, is actually required only after copying has been

---

6. See *White v. Abrams*, 495 F.2d 724, 729 (9th Cir. 1974) ("A *prima facie* case . . . consists of sufficient evidence in that type of case to get plaintiff past a motion for a directed verdict in a jury case or motion to dismiss pursuant to Fed. R. Civ. P. 41(b) in a non-jury case."); *H.C. Wainwright & Co. v. Wall St. Transcript Corp.*, 418 F. Supp. 620, 627 (S.D.N.Y. 1976) (plaintiff entitled to preliminary injunction without detailed showing of irreparable harm upon making *prima facie* case of copyright infringement), aff'd sub nom. *Wainwright Securities Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91 (2d Cir. 1977), cert. denied, 434 U.S. 1014 (1978).

7. See *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir.) ("Borrowed the work must indeed not be, for a plagiarist is not himself pro tanto an 'author' . . . ."), cert. denied, 298 U.S. 669 (1936); *Fred Fisher, Inc. v. Dillingham*, 298 F. 145, 147 (S.D.N.Y. 1924).

8. 17 U.S.C. § 105 (1988) ("Copyright protection . . . is not available for any work of the United States Government."); see *Scherr v. Universal Match Corp.*, 297 F. Supp. 107, 110-11 (S.D.N.Y. 1967), aff'd on other grounds, 417 F.2d 497 (2d Cir. 1969), cert. denied, 397 U.S. 936 (1970); *Public Affairs Assocs. v. Rickover*, 284 F.2d 262, 267-69 (D.C. Cir. 1960), vacated for further proceedings, 369 U.S. 111 (1962) (per curiam).

9. See *Hoehling v. Universal City Studios*, 618 F.2d 972, 977-79 (2d Cir.), cert. denied, 449 U.S. 841 (1980).

10. *R.L. Polk & Co. v. Musser*, 196 F.2d 1020, 1021 (3d Cir. 1952) (per curiam); *Mathews Conveyer Co. v. Palmer-Bee Co.*, 135 F.2d 73 (6th Cir. 1943); *Wilson v. Haber Bros.*, 275 F. 346 (2d Cir. 1921).

established to show that *enough* copying has taken place. A similarity, which may or may not be substantial, is probative of copying if, by definition, it is one that under all the circumstances justifies an inference of copying. In order to emphasize the function of such similarity and avoid the confusion of double usage, this Article suggests use of the term "probative similarity" in place of "substantial similarity" in this context.

One would have thought that the double usage of "substantial similarity" and the disservice it performs would have dissipated upon its exposure in 1975 by the Court of Appeals for the Third Circuit. In *Universal Athletic Sales Co. v. Salkeld*,<sup>11</sup> the trial court had granted summary judgment for plaintiff, finding that whether defendant had physically traced plaintiff's weight-lifting chart or had merely imitated it by freehand, he had copied. This result had apparently been based on the propositions contained in our opening litany, with the trial court reaching its finding of "substantial similarity" by means of dissection of the two works. Thus, the court found "substantial similarity" by "pinpointing similarities in a search to establish the facts of copying."<sup>12</sup>

The court of appeals took issue with this approach and reversed. The district court had found copying through its search for "substantial similarity," but had not found that "such a quantum of substantial similarity existed as to constitute infringement."<sup>13</sup> In other words, the copying may not have been truly substantial. In the course of its reversal, the appellate court highlighted the ambiguity as follows: "But, substantial similarity to show that the original work has been copied is not the same as substantial similarity to prove infringement. . . . While '[r]ose is a rose is a rose is a rose,' substantial similarity is not always substantial similarity."<sup>14</sup>

Although *Universal Athletic Sales* has been respectfully cited in general,<sup>15</sup> and within the Third Circuit for this perception in particular,<sup>16</sup> there seems to be little concern in the courts with the phenomenon of two distinct forms of usage for a key term in the copyright infringement lexicon.<sup>17</sup> Yet, double usage of terms in a narrow field of law creates

---

11. 511 F.2d 904 (3d Cir.), cert. denied, 423 U.S. 863 (1975).

12. Id. at 907 (discussing opinion below, 340 F. Supp. 899 (W.D. Pa. 1972)).

13. Id. at 907.

14. Id.

15. See, e.g., *Linden v. Dial Press*, Copyright L. Rep. (CCH) ¶ 25,007 (S.D.N.Y. 1978).

16. See, e.g., *Franklin Mint Corp. v. National Wildlife Art Exch.*, 575 F.2d 62, 65-66 (3d Cir.), cert. denied, 439 U.S. 880 (1978); *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F. Supp. 125, 138-39 (D.N.J. 1982); *Klitzner Indus. v. H.K. James & Co.*, 535 F. Supp. 1249, 1253-54 (E.D. Pa. 1982).

17. A notable exception is the recent decision in *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353 (N.D. Ill. 1989). The district court in *Stillman* explicitly recognized that "difficulties arise out of the dual usages of [the] term . . . substantial similarity," id. at 1358, and attempted to resolve those difficulties by distinguishing "substantial similarity" for

risks of confusion. This risk is aggravated when one of the uses may be inaccurate. The inaccurate use of "substantial similarity" as a step in the proof of copying leads to a number of evils. These will be examined after an excursion into the modern development of rules for proving infringement.

## II. PROVING INFRINGEMENT: *ARNSTEIN* AND ITS PROGENY

One may, in tracing the history of the proof of infringement, justifiably start with the legendary *Arnstein v. Porter*.<sup>18</sup> The clearly articulated copyright approach of the majority in this case, when properly understood, remains the most instructive guide to proving infringement. If this view seems to be stated somewhat defensively, it is because of the *Arnstein* critics who have offered "exaggerated" reports of its demise.<sup>19</sup>

*Arnstein* was one of a series of ultimately unsuccessful infringement actions brought by a composer against a number of different alleged plagiarists. In this action against Cole Porter, Ira Arnstein claimed infringement of copyright in songs with varying degrees of alleged exposure. These ranged from the sale of a million copies to a copy kept in plaintiff's room that had been ransacked on several occasions in "burglaries" with which defendant "could have" had something to do.<sup>20</sup> Despite the absence of any direct evidence that defendant had seen or heard plaintiff's compositions and defendant's categorical denials of having done so, the majority reversed the grant of summary judgment to defendant. Applying the standard of denying summary judgment when "'there is the slightest doubt as to the facts'"<sup>21</sup> and stressing the importance of in-court cross-examination, Judge Frank, speaking for himself and Judge Learned Hand, found genuine issues of fact for the

---

the purpose of establishing copying from "substantial similarity as a matter of law," to which it would refer simply as "unlawful appropriation." *Id.*

18. 154 F.2d 464 (2d Cir. 1946). On remand, judgment was entered on the verdict of a jury dismissing the complaint. This judgment was affirmed. *Arnstein v. Porter*, 158 F.2d 795 (2d Cir. 1946), cert. denied, 330 U.S. 851 (1947).

19. See, e.g., *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1023 n.2 (2d Cir. 1966); *Hoebling v. Universal City Studios*, 618 F.2d 972, 977 (2d Cir.), cert. denied, 449 U.S. 841 (1980); *Sid & Marty Krofft Television Prods. v. McDonald's Corp.*, 562 F.2d 1157, 1165 n.7 (9th Cir. 1977); see also *infra* notes 56-71 (discussing *Fab-Lu*). For evaluations of *Arnstein*'s diminished viability on the issue of summary judgment, see *Roberts v. Dahl*, 168 U.S.P.Q. (BNA) 428, 434-35 (Ill. Cir. Ct. 1971) (granting defendant's summary judgment motion in common-law copyright action, and calling *Arnstein* "an aberration of the law . . . virtually destroyed . . . as a meaningful precedent"), aff'd, 6 Ill. App. 3d 395, 286 N.E.2d 51 (Ill. App. Ct. 1972); *Hartnick, Summary Judgment In Copyright: From Cole Porter to Superman*, 3 Cardozo Arts & Ent. L.J. 53, 70 (1984) (concluding that "*Arnstein* is dead but not buried" on issue of summary judgment).

20. 154 F.2d at 467.

21. *Id.* at 468 (quoting *Doehler Metal Furniture Co. v. United States*, 149 F.2d 130, 135 (2d Cir. 1945)).

jury.<sup>22</sup> In a sharp dissent, Judge Clark found no such issues, emphasizing that plagiarism suits are not excepted from summary judgment and that the majority was creating "chaos, judicial as well as musical."<sup>23</sup>

Whether the majority applied the correct summary judgment standard in *Arnstein* has been the subject of much debate, and it is in this context that some discrediting of the decision has taken place.<sup>24</sup> But the majority opinion (notwithstanding Judge Clark's disagreement on copyright as well as procedural issues) has served as the analytical bedrock of infringement cases for almost forty years. Accordingly, it is worthwhile to examine Judge Frank's analysis in some detail.

The key contribution of *Arnstein*, set forth at the outset, is the clear articulation of the two prongs of infringement—copying and what Judge Frank called "improper appropriation."<sup>25</sup> The latter represents the "substantial" taking of protected material that results in "substantial similarity" between the works of plaintiff and defendant. The language of the court is instructive:

[I]t is important to avoid confusing two separate elements essential to a plaintiff's case in such a suit: (a) that defendant copied from plaintiff's copyrighted work and (b) that the copying (assuming it to be proved) went so far as to constitute improper appropriation.

As to the first—copying—the evidence may consist (a) of defendant's admission that he copied or (b) of circumstantial evidence—usually evidence of access—from which the trier of the facts may reasonably infer copying. Of course, if there are no similarities, no amount of evidence of access will suffice to prove copying. If there is evidence of access and similarities exist, then the trier of the facts must determine whether the similarities are sufficient to prove copying. On this issue, analysis ("dissection") is relevant, and the testimony of experts may be received to aid the trier of the facts. If evidence of access is absent, the similarities must be so striking as to preclude the possibility that plaintiff and defendant independently arrived at the same result.

If copying is established, then only does there arise the second issue, that of illicit copying (unlawful appropriation). On that issue . . . the test is the response of the ordinary lay hearer; accordingly, on that issue, "dissection" and expert testimony are irrelevant.

In some cases, the similarities between the plaintiff's and defendant's work are so extensive and striking as, without more, both to justify an inference of copying and to prove im-

---

22. *Id.* at 468-70.

23. 154 F.2d at 480 (Clark, J., dissenting).

24. See, e.g., *Hoehling*, 618 F.2d at 977; *Krofft*, 562 F.2d at 1165; *Luecke v. G.P. Putnam's Sons*, 10 Media L. Rep. (BNA) 1250, 1252 (S.D.N.Y. 1983); *Hartnick*, *supra* note 19, at 55-61.

25. 154 F.2d at 468.

proper appropriation. But such double-purpose evidence is not required; that is, if copying is otherwise shown, proof of improper appropriation need not consist of similarities which, standing alone, would support an inference of copying.<sup>26</sup>

This passage sets forth a primer for analysis of copyright infringement by way of the following propositions:

(1) Two distinct elements, "copying" and "unlawful appropriation," are involved and should not be confused. We will note later whether this judicial warning has been heeded.<sup>27</sup> We may note now, however, that in describing the second element, Judge Frank does not actually use the phrase "substantial similarity" even though later cases citing *Arnstein* generally suggest that he did.<sup>28</sup>

(2) Copying may be proven directly, e.g., by defendant's admission.

(3) Copying may alternatively be proven by indirect evidence. This indirect proof or circumstantial evidence consists of "similarities . . . sufficient to prove copying," which are "usually" accompanied by proof of "access." It is observed that these similarities are not qualified by the adjective "substantial." In addition, Judge Frank's usage of the term "access" straddles its two meanings—defendant's contact with plaintiff's work or simply his or her *potential* contact, i.e., opportunity to have seen or heard plaintiff's work.

(4) Under either interpretation of "access," copying may be shown simply on the basis of similarities (without a direct showing of access) if the similarities are "so striking as to preclude the possibility that plaintiff and defendant independently arrived at the same result."<sup>29</sup>

(5) Normally, two different standards and modes of proof are respectively applicable to the two prongs, copying and unlawful appropriation. The dissection and analysis of the expert are appropriate for the issue of copying, and the response of the ordinary lay hearer is appropriate for the issue of unlawful appropriation.

(6) Notwithstanding this normal dichotomy of proof, "[i]n some cases, the similarities between the plaintiff's and defendant's work are so extensive and striking as, without more, both to justify an inference of copying and to prove improper appropriation."<sup>30</sup>

Judge Frank's reminder in (1) that copying may be proven directly

---

26. *Id.* at 468-69 (footnotes omitted).

27. See *infra* notes 61-79 and accompanying text.

28. See, e.g., *Novelty Textile Mills v. Joan Fabrics Corp.*, 558 F.2d 1090, 1092 (2d Cir. 1977).

29. *Arnstein*, 154 F.2d at 468; see *Gaste v. Kaiserman*, 863 F.2d 1061, 1068 (2d Cir. 1988); *Ferguson v. National Broadcasting Co.*, 584 F.2d 111, 113 (5th Cir. 1978); 3 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 13.02[B] (1989). But see *Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir. 1984) (arguing that even with striking similarity there must be "some other evidence" establishing "a reasonable possibility that the complaining work was *available* to the alleged infringer").

30. *Arnstein*, 154 F.2d at 468-69.

is significant for a number of reasons. First, one will recall the pious warning of the opening litany that "direct evidence of copying is rarely, if ever, available."<sup>31</sup> This proposition is regularly recited by the courts and has been unanimously endorsed, in varying forms, by the commentators (including the present writer).<sup>32</sup> Yet, let plaintiffs' counsel neither despair nor overlook the possibility of proving copying directly. This exhortation will be but the first iteration of an important message to litigators carried by the present piece: prove (or disprove) every element of copyright infringement with the same ingenuity you would employ for any other tort. For example, there may be collaborators, coworkers and others who have in fact observed the producer of defendant's material at work. A little less "direct" is the not infrequent situation in which defendant's "author" had earlier studied or worked with plaintiff's material in the course of aborted negotiations.<sup>33</sup>

The "direct" route suggested by Judge Frank, namely defendant's admissions, is particularly fruitful as discovery has been liberalized.<sup>34</sup> Its corollary is that defendant's denial of copying is also significant. Indeed, Judge Frank concluded that this significance requires "the invaluable privilege of cross-examining the defendant—the 'crucial test of credibility'—in the presence of the jury" rather than by deposition, which he characterized as a "‘substitute, a second best.’"<sup>35</sup> Accordingly, on the issue of copying, the credibility of the defendant had to be tested in open court, rather than on summary judgment.

Judge Frank's analysis of direct proof is also instructive. It suggests that "access" and "similarities" are but two possible pillars in constructing a case of copying. It carries forward in somewhat muted form the suggestion of a commentator two years earlier that "[t]he rules of evidence in copyright cases are the same as in other cases."<sup>36</sup> Once again "access and similarities," while useful and worth seeking by a plaintiff, may be complemented and even replaced, in some cases, by other kinds of clues to copying—e.g., admissions.

The ultimate fact of copying does require actual contact between the defendant and the plaintiff's work. But this can be proven in a number of ways. At least three have been generally identified: (1) direct proof of such contact, e.g., by defendant's admission; (2) indirect proof of such contact by proof of an opportunity for contact; and (3) similarities which by their nature belie coincidence. Whether (1) or (2) is labeled "access" and whether the similarities identified in (3) are de-

---

31. *Novelty Textile*, 558 F.2d at 1092; see supra notes 1-5 and accompanying text.

32. See A. Latman, *The Copyright Law* 161 (5th ed. 1979); 3 M. Nimmer & D. Nimmer, *supra* note 29, § 13.01[B].

33. See, e.g., *Sid & Marty Krofft Television Prods. v. McDonald's Corp.*, 562 F.2d 1157, 1161 n.2 (9th Cir. 1977).

34. See Fed. R. Civ. P. 26 & advisory committee's note; Fed. R. Evid. 801(d)(2).

35. *Arnstein*, 154 F.2d at 469-70 (footnotes omitted).

36. H. Ball, *The Law of Copyright and Literary Property* § 259, at 594 (1944).

scribed as "striking" should not becloud the simple fact that a chain of circumstantial evidence is being fashioned to prove copying. Anything that can lay the basis for an inference of copying can be used properly as part of that chain. A link in the chain can, of course, be furnished by the analysis of an expert identifying a clue to copying. A qualified expert's opinion on whether copying or coincidence accounts for similarities can be helpful in view of the expert's experience with the repertory of music, literature, art or other subject matter concerned.

Clues to copying may or may not pertain to copyrighted subject matter. The fact of *any* copying is what is at issue, at the first stage, because the copying of uncopyrighted components of a work clearly has some probative value in establishing the copying of other, copyrighted, components of the same work.

Unlawful appropriation (Judge Frank's second prong) depends not only on what is protected in plaintiff's work, but also on the impression of the public to whose taste the work is addressed and for whose primary benefit copyright was created in the first place.<sup>37</sup> Thus, whereas the credibility issues on the first prong required cross-examination in open court, the second prong also was deemed to lay special claim to trial by the jury plaintiff had demanded. A jury was said to be "peculiarly fitted to determine" the response of the ordinary lay hearer.<sup>38</sup>

Judge Frank furnishes a rare policy justification for using as a test the ordinary lay listener, reader or observer who dominates copyright law:

The proper criterion on that issue is not an analytic or other comparison of the respective musical compositions as they appear on paper or in the judgment of trained musicians. The plaintiff's legally protected interest is not, as such, his reputation as a musician but his interest in the potential financial returns from his compositions which derive from the lay public's approbation of his efforts. The question, therefore, is whether defendant took from plaintiff's works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff.<sup>39</sup>

Judge Frank speculates as to how the reaction of the ordinary observer may be established at a trial.<sup>40</sup> These scenarios, drawing undoubtedly justified derision from the dissent,<sup>41</sup> are directed toward the second prong of infringement, unlawful appropriation, and will not be

37. See *Arnstein*, 154 F.2d at 473; *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

38. *Arnstein*, 154 F.2d at 473.

39. Id. (footnotes omitted); see also id. at 473 n.21 (collecting cases).

40. Id. at 473.

41. Id. at 478-79 (Clark, J., dissenting).

dwelled upon in this Article. The focus of this Article is on the first prong, copying, which seems to have been less widely treated than questions of unlawful appropriation, "substantial similarity" (properly used) and the ordinary observer, which have been the subject of a number of excellent analyses.<sup>42</sup>

The two-step procedure suggested by the majority was condemned by the dissenting Judge Clark, who, after reviewing earlier decisions, explained his reasoning as follows:

I find nowhere any suggestion of two steps in adjudication of this issue, one of finding copying which may be approached with musical intelligence and assistance of experts, and another that of illicit copying which must be approached with complete ignorance; nor do I see how rationally there can be any such difference, even if a jury—the now chosen instrument of musical detection—could be expected to separate those issues and the evidence accordingly. If there is actual copying, it is actionable, and there are no degrees; what we are dealing with is the claim of similarities sufficient to justify the inference of copying. This is a single deduction to be made intelligently, not two with the dominating one to be made blindly.<sup>43</sup>

Accordingly, Judge Clark labels the majority opinion as "anti-intellectual" and "book-burning."<sup>44</sup> He found the works in question sufficiently dissimilar to warrant summary judgment for defendant.<sup>45</sup>

The sharp disagreement on infringement issues between Judges Frank and Learned Hand, on the one side, and Judge Clark, on the other, surfaced again five days after the *Arnstein* decision in *Heim v. Universal Pictures Co.*<sup>46</sup> *Heim* is often cited for its dictum, which would, under law then in effect, have excused publication abroad without a proper copyright notice.<sup>47</sup> The notice point was dictum because the majority held that there was no proof of copying.<sup>48</sup> Judge Clark found sufficient proof of copying, but concurred because he thought the publication abroad divested copyright.<sup>49</sup> Both the majority and concurrence throw a bit more light on *Arnstein*.

Judge Frank, again writing for the majority, relies on *Arnstein* for the following proposition:

In a suit like this, plaintiff, to make out his case, must establish

42. See, e.g., *Peter Pan*, 274 F.2d at 489 (L. Hand, J.); *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 53-56 (2d Cir.) (L. Hand, J.), cert. denied, 298 U.S. 669 (1936); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121-23 (2d Cir. 1930) (L. Hand, J.), cert. denied, 282 U.S. 902 (1931); 3 M. Nimmer & D. Nimmer, *supra* note 29, § 13.03.

43. 154 F.2d at 476 n.1 (Clark, J., dissenting).

44. *Id.* at 478.

45. *Id.* at 477-78.

46. 154 F.2d 480 (2d Cir. 1946).

47. See *id.* at 486.

48. *Id.* at 487-88.

49. See *id.* at 488-91 (Clark, J., concurring).

two separate facts: (a) that the alleged infringer copied from plaintiff's work, and (b) that, if copying is proved, it was so "material" or "substantial" as to constitute unlawful appropriation.<sup>50</sup>

Judge Frank found that the plaintiff had failed on the first prong. More significantly, however, Judge Frank fleshed out the meaning of his second prong, "unlawful appropriation," by introducing the terms "material" and "substantial."<sup>51</sup> He incidentally offered the view that unlawful appropriation could be "small quantitatively," as in someone's copying "'Euclid alone has looked on Beauty bare,' or 'Twas brillig and slithy toves.'"<sup>52</sup> Not everyone would agree that these examples would result in infringement. They do suggest a usage of the word "substantial" in a sense that includes what is "small quantitatively." But the examples clearly contemplate that the material is important to the ordinary observer. Such a usage of "substantial similarity" would still not be appropriate for probative similarity, since the latter may embrace features that are not of importance to the lay audience.<sup>53</sup>

The *Heim* case also contains one of the clearest statements of the nature of similarity probative of copying in contrast to similarity amounting to unlawful appropriation. The statement shows that at least Judge Frank, five days after the *Arnstein* decision, did not consider that similarity probative of copying had to be "substantial." He stated:

In an appropriate case, copying might be demonstrated, with no proof or weak proof of access, by showing that a single brief phrase, contained in both pieces, was so idiosyncratic in its treatment as to preclude coincidence.<sup>54</sup>

It is assumed that such a phrase would not ordinarily be "substantial." At least, it need not be.

It was twenty years before the Court of Appeals for the Second Circuit again focused directly on the *Arnstein* formula. The late 1950s and 1960s witnessed an explosion of copyright infringement actions

---

50. *Id.* at 487.

51. *Id.* at 487 & n.7.

52. *Id.* at 487 n.7.

53. Judge Clark, still fighting the result in *Arnstein*, complained as follows:  
Surely, if the *Arnstein* case teaches us anything, it must be that banality is no bar to a claim for plagiarism. That results at once so divergent and so musically astonishing as the decisions in these two cases can occur simultaneously I can attribute only to the novel conceptions of legal plagiarism first announced in the *Arnstein* case and now repeated here. By these the issue is no longer one of musical similarity or identity to justify the conclusion of copying—an issue to be decided with all the intelligence, musical as well as legal, we can bring to bear upon it—but is one, first, of copying, to be decided more or less intelligently, and, second, of illicit copying, to be decided blindly on a mere cacophony of sounds. Just at which stage decision here has occurred, I am not sure.

*Id.* at 491 (Clark, J., concurring).

54. *Id.* at 488.

within the circuit involving textile fabrics, dolls and jewelry. Most of these were concerned with the second prong—substantial similarity to the ordinary observer. In *Ideal Toy Corp. v. Fab-Lu Ltd.*,<sup>55</sup> a preliminary injunction was denied because of a finding of lack of substantial similarity.<sup>56</sup> The court of appeals affirmed but had occasion to examine the requirement in *Arnstein* that “‘copying (assuming it to be proved) went so far as to constitute improper appropriation.’”<sup>57</sup> The *Fab-Lu* court found this statement “merely an alternative way of formulating the issue of substantial similarity” and asserted that “the use of the term ‘improper appropriation’ somewhat obscures the issue,”<sup>58</sup> relying for the latter proposition on Professor Nimmer.

Although “improper appropriation” is perhaps a little too vague to be helpful, it should be noted that its refinement, “substantial similarity,” brings its own problems. First, it requires immediate explanation to the novice that “substantial” is not being used in the sense of “colorable” (i.e., the quality of *almost* reaching similarity) as used in the concept of “substantial compliance.” As indicated earlier, it means “to a substantial degree.”

Second, the phrase implies that “substantial similarity” between two works may exist without distinguishing between protected and unprotected elements. For example, two works about an historical incident may be substantially similar only because of their common theme.<sup>59</sup> This kind of “substantial similarity” is not in fact actionable—a result that is more apparent from an “unlawful appropriation” formulation. The latter helpfully suggests that appropriation *per se* is not unlawful; liability attaches only from appropriating what is protected and beyond permissible quantitative limits.<sup>60</sup>

Finally, the term “substantial similarity,” because it contains the word “similarity,” has, rightly or wrongly, been regularly transplanted to the first prong of the *Arnstein* test and has thus produced the double usage this Article treats.

While complaining that “‘improper appropriation’ somewhat obscures the issue,” the *Fab-Lu* court obscured the issue more severely.

---

55. 266 F. Supp. 755 (S.D.N.Y. 1965), aff'd, 360 F.2d 1021 (2d Cir. 1966).

56. Id. at 756, 758. Plaintiff was granted partial injunctive relief on its Lanham Act claim. Id. at 757.

57. 360 F.2d at 1023 n.2 (quoting *Arnstein*, 154 F.2d at 468).

58. Id. (quoting M. Nimmer, Copyright § 143.53 (1964)).

59. See, e.g., *Bachman v. Belasco*, 224 F. 817, 818 (2d Cir. 1915) (denying injunction of defendant's play where similarities with plaintiff's play were “readily accounted for by reference to the common source”). Additional incidents of similarity not attributable to the common source may be sufficient to establish infringement. See *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir.) (play and motion picture), cert. denied, 298 U.S. 669 (1936); *Simonton v. Gordon*, 12 F.2d 116, 124 (S.D.N.Y. 1925) (novel and play).

60. See *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 912 (2d Cir. 1980).

In its examination of the second prong issue of "substantial similarity," the court declared:

[T]he appropriate test for determining whether substantial similarity is present is whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.<sup>61</sup>

This formulation makes it sound as if the average lay observer is to determine whether copying—the *Arnstein* first prong—has taken place, rather than determining whether enough has been taken. But such an observer may detect, though perhaps less frequently than the expert, a clue to copying, e.g., the "single brief [idiosyncratic] phrase" identified in the *Heim* case,<sup>62</sup> which may not be "substantial."

None of the three cases relied upon in *Fab-Lu* for its "recognition of appropriation" test<sup>63</sup> uses this approach. Indeed the first case cited, *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*,<sup>64</sup> which involved fabric designs, sets forth a much more helpful standard. Judge Learned Hand there observed that:

[C]opyright extends beyond a photographic reproduction of the design, but one cannot say how far an imitator must depart from an undeviating reproduction to escape infringement. In deciding that question one should consider the uses for which the design is intended, especially the scrutiny that observers will give to it as used.<sup>65</sup>

After noting generally the similarities between the two designs in question, he remarked that they were "not identical."<sup>66</sup> He then expressed a standard for "substantial similarity" as follows: "However, the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and *regard their aesthetic appeal as the same.*"<sup>67</sup>

It is suggested that the ordinary observer's regarding the aesthetic appeal of two works as the same is consistent with the policy justification of using the ordinary observer in the first instance. Much less consistent is the detective work inherent in the observer's simply "recognizing appropriation" as propounded by the *Fab-Lu* court. The observer might note the derivation of defendant's work from plaintiff's work but consider the aesthetic appeal of the two works to be different.<sup>68</sup> It is such appeal, as addressed to the ordinary audience, that

---

61. 360 F.2d at 1022 (emphasis added).

62. *Heim v. Universal Pictures Co.*, 154 F.2d 480, 488 (2d Cir. 1946).

63. See *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487 (2d Cir. 1960); *Arnstein v. Broadcast Music, Inc.*, 137 F.2d 410 (2d Cir. 1943); *Life Music, Inc. v. Wonderland Music Co.*, 241 F. Supp. 653 (S.D.N.Y. 1965).

64. 274 F.2d 487.

65. *Id.* at 489.

66. *Id.*

67. *Id.* (emphasis added).

68. See, e.g., *Warner Bros. v. American Broadcasting Cos.*, 720 F.2d 231, 242 (2d

should be the focus of infringement.

The mischief of *Fab-Lu* does not end with its inexpert refashioning of the *Peter Pan* test. A few district courts, perhaps reading more the mood of the *Fab-Lu* court toward *Arnstein* than its words, have struggled to interpret *Fab-Lu* as the most authoritative (because the most recent) of these four Second Circuit opinions. One unsuccessful attempt was a declaratory judgment action brought once again by Ideal Toy Corporation, this time in connection with dolls alleged to infringe copyrights relating to the film "Star Wars."<sup>69</sup> The court there announced that as a result of *Fab-Lu*, the "two steps of [the *Arnstein* test] seem to have been merged into the single lay-observer test for substantial similarity."<sup>70</sup> Similarly, another district judge found that the lay-observer test it divined from *Fab-Lu* (presumably a single test) was perhaps appropriate for simple items such as fabric designs, but more generally had "the weakness of avoiding the serious analysis virtually required under *Arnstein*."<sup>71</sup>

These two interpretations overstate *Fab-Lu*. That decision was not concerned with the first prong of the *Arnstein* test; its quarrel with the "unlawful appropriation" formulation was confined to the second prong. There was thus no "merger" in *Fab-Lu* of the two prongs of *Arnstein*.

In practice, merger of the two *Arnstein* prongs may take place subtly, by reason of confusion in use of the term "substantial similarity." This occurred in 1977 in *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*,<sup>72</sup> the source of our opening litany. Indeed, in the space of three short sentences, the *Novelty Textile* opinion demonstrates not only that "substantial similarity" is not always "substantial similarity," but that "copying" is not always "copying."<sup>73</sup>

It will be recalled that the court began its analysis by announcing that "to prove infringement a plaintiff must show ownership of a valid copyright and copying by the defendant."<sup>74</sup> Since such proof would itself establish infringement, the court, by "copying," apparently meant the kind of substantial and material copying that would satisfy both prongs of *Arnstein*. The court noted that since the validity of the plaintiff's copyright was not in dispute, this "leaves the issue of whether

---

Cir. 1983) ("Stirring one's memory of a copyrighted character is not the same as appearing to be substantially similar to that character, and only the latter is infringement."); *Eden Toys, Inc. v. Marshall Field & Co.*, 675 F.2d 498, 501 (2d Cir. 1982).

69. *Ideal Toy Corp. v. Kenner Prods. Div. of Gen. Mills Fun Group*, 443 F. Supp. 291 (S.D.N.Y. 1977).

70. *Id.* at 303 n.11.

71. *Bevan v. Columbia Broadcasting Sys.*, 329 F. Supp. 601, 604 n.3 (S.D.N.Y. 1971).

72. 558 F.2d 1090 (2d Cir. 1977).

73. *Id.* at 1092.

74. *Id.*

Joan copied Novelty's design."<sup>75</sup> If this is the only issue for resolution, then "copy" must still mean the kind of appropriation that would satisfy both prongs of *Arnstein*. But the next sentence, citing *Arnstein*, continues: "Since direct evidence of copying is rarely, if ever, available, a plaintiff may prove copying by showing access and 'substantial similarity' of the two works."<sup>76</sup> Here "copying" must mean not the ultimate act of infringement, as it did in the previous sentence, but the act that will satisfy the first prong of *Arnstein*. This is necessarily so, since access is part of the proof under that element of the *Arnstein* test<sup>77</sup> and has no relevance to the substantiality and materiality of the taking—both second prong concerns. Also, as noted at the outset, "substantial similarity" appears to be used to indicate the kind of similarity that will satisfy the first prong of *Arnstein*. The district court had found "no substantial similarity because certain differences in the works 'would be apparent'" to those professionals familiar with the goods.<sup>78</sup> *Arnstein* clearly permits expert testimony on the first prong issue of copying. But the Second Circuit continued its litany with the statement that "'substantial similarity' is to be determined by the 'ordinary observer' test."<sup>79</sup> Thus, rather than being concerned with the first prong, the court apparently here used "substantial similarity" to mean the appropriation considered under the second prong of *Arnstein*.

The confusion reflected in the foregoing developments should not obscure the fact that *Arnstein*'s copyright infringement analysis survives in the Second Circuit. This is illustrated by a discussion in 1980 in *Hoehling v. Universal City Studios, Inc.*<sup>80</sup> Judge Kaufman there began his legal analysis by setting forth, with attribution, the two-pronged *Arnstein* test. He noted that "*Arnstein*'s influence in other areas of law has been diminished," but also found in *Arnstein* evidence of the traditional disfavor toward summary judgment in copyright cases "[b]ecause substantial similarity is customarily an extremely close question of fact."<sup>81</sup> He suggests, however, that such disfavor is misplaced "when all alleged similarity relates to non-copyrightable elements of the plaintiff's work."<sup>82</sup>

---

75. *Id.*

76. *Id.*

77. The court found: "Here Joan not only admits access, but also the actual viewing by its designers of Novelty's Style 253 before its own designs were produced." *Id.* Thus, the court used "access" as *potential* contact, as well as direct proof of actual contact.

78. *Id.* at 1093 (quoting opinion below, 426 F. Supp. 1008, 1012 (S.D.N.Y. 1977)). The district court had added that the differences would also be apparent "to a consumer seriously contemplating purchase" of the goods. *Id.* (quoting 426 F. Supp. at 1012).

79. *Id.*

80. 618 F.2d 972 (2d Cir.), cert. denied, 449 U.S. 841 (1980).

81. *Id.* at 977.

82. *Id.*

Thus, the reference to *Arnstein* in *Hoehling*, as in *Fab-Lu*, is to *Arnstein's* second prong. *Hoehling* therefore in no way impairs *Arnstein's* two-prong approach and indeed appears to cite it with approval.

*Arnstein's* infringement analysis still survives in other circuits as well. The Court of Appeals for the Ninth Circuit took a close look at *Arnstein* in *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*<sup>83</sup> The opinion in *Krofft*, while ambitious and analytical, has been subject to justifiable criticism.<sup>84</sup> *Krofft* begins auspiciously by labeling maxims of the kind contained in our opening litany as mere "boilerplate to copyright opinions."<sup>85</sup> The court's main concern seemed to be that "copying" and "substantial similarity" might result in liability when only nonprotected ideas were taken.<sup>86</sup> The court then suggested a new two-step procedure: first, determine whether ideas were in fact taken—a test called "extrinsic because it depends not on the trier of fact, but on specific criteria which can be listed and analyzed" by experts if necessary;<sup>87</sup> second, determine whether there is substantial similarity between the forms of expression—a test labeled "intrinsic" because it depends "on the response of the ordinary reasonable person" and not on "the type of external criteria and analysis which marks the extrinsic test."<sup>88</sup>

The Ninth Circuit expended some effort in comparing and contrasting *Arnstein* with its own "extrinsic-intrinsic" approach, proclaimed rather self-consciously in *Krofft*. On the one hand, the court found that "[t]his same type of bifurcated test was announced" in *Arnstein* and that the "unlawful appropriation" in *Arnstein's* second prong meant simply taking protected expression rather than unprotected ideas.<sup>89</sup> The *Krofft* court numbered Judge Moore, who wrote the *Fab-Lu* opinion, as one of *Arnstein's* "detractors,"<sup>90</sup> but went on to indicate that *Arnstein's* parallel in the role of the ordinary audience is found in the second step of *Krofft*, the latter, somewhat questionably, being deemed a clarification of the issues. The Ninth Circuit stated:

We do not resurrect the *Arnstein* approach today. Rather we formulate an extrinsic-intrinsic test for infringement based on the idea-expression dichotomy. We believe the *Arnstein* court was doing nearly the same thing. But the fact that it may not does not subtract from our analysis.<sup>91</sup>

It is plausible to argue that the *Arnstein* second prong—unlawful appropriation—is approximated by the *Krofft* second prong—the intrin-

83. 562 F.2d 1157 (9th Cir. 1977).

84. See, e.g., 3 M. Nimmer & D. Nimmer, *supra* note 29, § 13.03[E].

85. 562 F.2d at 1162.

86. *Id.* at 1162-63.

87. *Id.* at 1164.

88. *Id.*

89. *Id.*

90. *Id.* at 1165 n.7.

91. *Id.*

sic test for substantial similarity in protected expression. But the respective first prongs pass each other in the night, even though each speaks of dissection by experts. *Arnstein* focuses on copying versus independent production, *Krofft* on copying of ideas rather than copying of expression. They slice the infringement apple from different angles. *Krofft* virtually assumes copying and therefore is much less helpful.

The *Krofft* court's unsuccessful correlation of the two approaches is accompanied by the following rather explicit and accurate statement bearing on whether *Arnstein* is in need of being "resurrected":

Defendants contest the continued viability of *Arnstein*. It is true that *Arnstein*'s alternative holding that summary judgment may not be granted when there is the slightest doubt as to the facts has been disapproved. But the case's tests for infringement have consistently been approved by this court. They have also been accepted by other courts. We believe *Arnstein* is still good law.<sup>92</sup>

*Krofft*'s survey of the acceptance of *Arnstein* by other circuits included *Scott v. WKJG, Inc.*,<sup>93</sup> which found that defendant's television play had not been copied from plaintiff's unpublished radio play. The Court of Appeals for the Seventh Circuit helpfully elaborated on *Arnstein*'s second prong by describing it as requiring proof "that the author of the accused work unlawfully appropriated *protected material* from the copyrighted work."<sup>94</sup> The same court in a 1982 video-game case identified *Scott* and *Arnstein* as having "expressed the test of substantial similarity in two parts" and *Krofft* as representing a variant.<sup>95</sup> While this bifurcation of "substantial similarity" is supported by Professor Nimmer,<sup>96</sup> *Scott* and *Arnstein* are mischaracterized. Neither used "substantial similarity" in their first step; rather, they tested for the kind of similarity here described as "probative." Acceptance of a bifurcated "substantial similarity" test perpetuates risks of confusion. Nevertheless, the video-game case demonstrates that as of 1982, *Arnstein* was still alive and well in the Seventh Circuit.<sup>97</sup>

As noted above, the Court of Appeals for the Third Circuit has been particularly sensitive to the two-step requirement of *Arnstein* and the confusion spawned by its progeny.<sup>98</sup> We will note shortly further developments within that circuit that carry this approach further. For analytical consistency among the circuits, one must cite with approval

---

92. *Id.* at 1165 (citations omitted).

93. 376 F.2d 467 (7th Cir.), cert. denied, 389 U.S. 832 (1967).

94. *Id.* at 469 (emphasis added).

95. *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir.), cert. denied, 459 U.S. 880 (1982).

96. 3 M. Nimmer & D. Nimmer, *supra* note 29, § 13.03[E], at 13-62.13-14.

97. *Arnstein* lives on, too, in the First Circuit. See *Concrete Machinery Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 608 (1st Cir. 1988) ("[The *Arnstein*] test provides a workable, flexible framework for copyright infringement analysis.").

98. See *supra* notes 11-14 and accompanying text.

the preference expressed on W.C. Fields' tombstone: "On the whole, I'd rather be in Philadelphia."

### III. SUBSTITUTING "PROBATIVE" FOR "SUBSTANTIAL" SIMILARITY

We have thus far noted that "substantial similarity" is a confusing description of an element used to satisfy the first prong of the still-viable *ArneStein* test. This is because the similarity probative of copying may or may not be "substantial." This Article suggests that a functional description of such similarity might simply be "probative similarity." In addition to avoiding the confusion inherent in double usage of the term "substantial similarity," probative similarity reminds us that there may be other facts probative of copying. As a result, a substitution of descriptions will serve more than a semantic purpose. Let us now examine some of these benefits.

#### A. *Elements of Proof*

It has now been sufficiently emphasized that copying of a substantial amount of protected material is required to establish infringement and that this burden may be divided into proof of copying and substantiality. Copying may be inferred from certain similarities between the two works. Such similarities will often be accompanied by proof that defendant had the opportunity for exposure to plaintiff's work, i.e., defendant had "access" thereto. Some courts have stated that the similarities may be such as to belie coincidence and thereby dispense with the need to show access. More properly, such similarities, sometimes called "striking," themselves provide indirect proof of access which in turn combines to provide indirect proof of copying. Let us examine the nature of such similarities, bearing in mind that they may or may not be "substantial" or "striking"; they must simply be such that under normal rules of evidence, they permit an inference of copying.<sup>99</sup>

A clear case of probative similarity is established when defendant's work contains plaintiff's signature or even his or her copyright notice. It should be noted, however, that this "smoking gun" does not represent the taking of copyrighted material at all, let alone a substantial quantum of such material. The similarity is probative of copying because of the virtual certainty that the plaintiff's name or notice did not appear on defendant's work as a result of coincidence. Indeed, the extreme unlikelihood that defendant would create an independent work and then intentionally, negligently or fortuitously credit plaintiff or claim a copyright in his or her behalf compels the inference that plaintiff's name or notice was copied along with the material to which it orig-

---

99. See *Alexander v. Haley*, 460 F. Supp. 40, 43 (S.D.N.Y. 1978); cf. *Testa v. Jaussen*, 492 F. Supp. 198, 203 (W.D. Pa. 1980) (striking similarity required to establish copying without proof of access).

inally pertained.<sup>100</sup>

A closely related feature of similarity is the appearance of common errors in the works of plaintiff and defendant. This kind of similarity has been labeled by the United States Supreme Court as "one of the most significant evidences of infringement."<sup>101</sup> It should be noted, however, that common errors may be traced back to a common source or be otherwise justified. Moreover, some kinds of works do not permit the identification of "errors" or, at least, agreement as to what errors are. Music, fiction, poetry and art would often fall in this category.

In one instance of applied art involving "GI Joe," a somewhat realistic doll of a male military figure with articulated joints, a small anatomical error was emphasized by the court to establish copying.<sup>102</sup> The right thumbnail of plaintiff's fighting figure was misplaced, i.e., it was on the side, rather than the back, of the end of the thumb. Defendant's doll contained the same error.<sup>103</sup>

Some creators of copyrightable works, particularly those consisting of directories and other compilations, purposely create their own "errors" as a "trap" in which to snare copyists. For example, a fictitious name or other entry may be included in a factual work.<sup>104</sup> Without too much concern for the interest of the using public against such deliberate falsification, the courts have generally found such trap items to be as persuasive as honest errors.

But at least one court, somewhat surprisingly, refused to make the leap from the inference that the trap items were copied to the inference that other items were copied, rather than having been independently compiled. In a 1980 case involving organic chemistry texts, plaintiff claimed that the existence of approximately twenty common errors was "powerful evidence" of defendant's copying.<sup>105</sup> The court conceded that "[a]t first blush it is natural to assume that an error appearing in both texts must have been copied by the defendant from the plaintiffs."<sup>106</sup> In rejecting such a conclusion, the court noted the wide-

---

100. See *American Charm Corp. v. Omega Casting Corp.*, 211 U.S.P.Q. (BNA) 635 (S.D.N.Y. 1979).

101. *Callaghan v. Myers*, 128 U.S. 617, 662 (1888); see *Adventures in Good Eating, Inc. v. Best Places to Eat, Inc.*, 131 F.2d 809, 811-12 (7th Cir. 1942); *College Entrance Book Co. v. Amsco Book Co.*, 119 F.2d 874, 875 (2d Cir. 1941); *Camaro Headquarters, Inc. v. Banks*, 621 F. Supp. 39, 40 (E.D. Pa. 1985).

102. *Hassenfeld Bros. v. Mego Corp.*, 150 U.S.P.Q. (BNA) 786 (S.D.N.Y. 1966).

103. *Id.* at 788.

104. See, e.g., *Rockford Map Publishers v. Directory Serv. Co.*, 768 F.2d 145, 147 (7th Cir. 1985), cert. denied, 474 U.S. 1061 (1986); *No-Leak-O Piston Ring Co. v. Norris*, 277 F. 951, 952-53 (4th Cir. 1921). In *R.L. Polk & Co. v. Musser*, 105 F. Supp. 351 (E.D. Pa.), aff'd, 196 F.2d 1020 (3d Cir. 1952) (per curiam), the district court held that the appearance of trap listings in defendant's directory "create[d] a prima facie case of copying," *id.* at 353, but entered judgment for defendant because it found the extent of copying to be "trivial and inconsequential." *Id.*

105. *Morrison v. Solomons*, 494 F. Supp. 218, 223 (S.D.N.Y. 1980).

106. *Id.*

spread nature of the errors throughout the literature in the field and defendant's satisfactory identification of noninfringing sources.<sup>107</sup> But the court also utilized authorities vindicating the use of underlying information—even if incorrect—to vitiate the effect of common errors in the chemistry texts.<sup>108</sup> Here, regrettably, the court seems to have been slipping into analysis of the *Arnstein* second prong. This occurred despite the fact that the court had earlier explicitly based its dismissal on the ground of noncopying rather than lack of "substantial similarity."<sup>109</sup> It was thus an overstatement for the court to suggest, on the basis of the nonprotectability of information or "facts" (even if in error), that "[t]he law of this Circuit casts considerable doubt on the probative value of copied items as evidence of copyright violation."<sup>110</sup> Copied errors of fact can be probative of copying.

All of the foregoing examples demonstrate that proof of copying may have nothing to do with the substantiality of the protected material taken. In the case last discussed, the factual material at issue was, in the court's view, completely unprotected. The same would be true of the plaintiff's name or copyright notice. It is conceivable that a signature in the form of a design or logo could be copyrightable, as could, one supposes, the sculpture of a thumbnail. Correspondence of these features in two works, however, could hardly be deemed "substantial" similarity. Even if quality as well as quantity must be considered in determining substantiality, plaintiff's "GI Joe" doll was hardly purchased by consumers because of its right thumbnail.

Whether the similarities being discussed should be labeled "striking" is more a matter of style. In any event, their probative value (subject, of course, to rebuttal as in the chemistry text case) would seem clear. They are therefore examples of probative similarity.

#### B. Alternative Means of Proving Copying

One objective of using the description "probative similarity" is to suggest that facts other than similarity, or more accurately, similarities, may be probative of copying. Most probative of all, of course, is defendant's admission or other variants of direct proof. As noted earlier, this is a route whose promise has been unjustifiably minimized by courts and commentators.<sup>111</sup> Indeed, it may well be that cases in which direct evidence of copying is shown are often settled or otherwise unreported. Moreover, one notes a number of cases in which access or copying is admitted or assumed in order to get on to the real battleground, which may be substantial similarity of protected matter or its cognate, the protectibility of appropriated matter, or defenses such as

---

107. *Id.* at 223-24.

108. *Id.*

109. *Id.* at 221-22.

110. *Id.* at 224.

111. See *supra* notes 31-36 and accompanying text.

fair use.<sup>112</sup> In any event, emphasis on direct evidence of copying can restrict questions of similarity to the "substantial similarity" issue reflected in *Arnstein's* second prong and determinable by the ordinary observer. This will in turn limit the role of experts and the frequently lengthy, uniformly conflicting and sometimes confusing testimony they produce. Direct evidence on the copying issue may also color a court's assessment as to the degree of culpability of an infringing defendant. This is particularly true if denials of copying are ultimately belied. Such evidence may even affect a court's analysis of what constitutes "substantial similarity."<sup>113</sup>

Another somewhat common situation occurs when plaintiff's work at the very least "inspires" defendant's product. In other words, defendant's author either saw or heard plaintiff's work and either decided to or was instructed to use it as a model in some sense.<sup>114</sup> Typically, defendant's author will try to avoid copying so much expression as to infringe. These are the cases referred to earlier, in which the action will probably be defended not on the ground of noncopying but on the ground that what was copied was an uncopyrightable idea.

An interesting example is found in *Ideal Toy Corp. v. Kenner Products*,<sup>115</sup> the declaratory judgment action mentioned earlier in which Ideal was marketing a set of dolls called "Star Team," which it had decided to reactivate and modify after the motion picture "Star Wars" appeared. There was direct evidence that the acclaim of "Star Wars" was one of several reasons motivating Ideal to develop further and market its line of space toys, and that it was seeking to make use of the theme and characters involved in "Star Wars."

The court appeared to minimize this direct evidence of at least inspiration and preferred to rely on the "access and substantial similarity" indirect route to show copying. In so doing, the court found that "the similarities which exist are not substantial and are sufficiently explained and justified by the evidence concerning the development of the Ideal toys."<sup>116</sup>

This passage suggests that the "Star Wars" court, dealing with first prong copying, was, as a victim of the double usage of "substantial sim-

112. See, e.g., *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48 (2d Cir.), cert. denied, 476 U.S. 1159 (1986); *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir.), cert. denied, 459 U.S. 880 (1982); *Davis v. United Artists, Inc.*, 547 F. Supp. 722, 723 (S.D.N.Y. 1982); *Alexander v. Haley*, 460 F. Supp. 40, 43 (S.D.N.Y. 1978).

113. See, e.g., *Harper & Row, Publishers v. Nation Enters.*, 557 F. Supp. 1067 (S.D.N.Y. 1983), rev'd, 723 F.2d 195 (2d Cir.), rev'd, 471 U.S. 539 (1985); *Meredith Corp. v. Harper & Row, Publishers*, 413 F. Supp. 385 (S.D.N.Y. 1975).

114. See, e.g., *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 410 (2d Cir. 1970), cert. denied, 401 U.S. 977 (1971); *Iris Arc v. S.S. Sarna, Inc.*, 621 F. Supp. 916, 923 (E.D.N.Y. 1985).

115. 443 F. Supp. 291 (S.D.N.Y. 1977); supra notes 69-70 and accompanying text.

116. Id. at 303.

ilarity," seeking "substantiality" of similarity instead of direct clues to copying. But the court's description of similarities and differences seemed to be more an excursion into the second prong of similarity. This merger of the two prongs is not surprising in a court that read *Ideal Toy Co. v. Fab-Lu Ltd.*<sup>117</sup> as indeed effecting such a merger.<sup>118</sup>

A clearer example of direct evidence of copying is found in *Thomas Wilson & Co. v. Irving J. Dorfman Co.*,<sup>119</sup> in which a customer of plaintiff's lace fabric, which embodied a copyrighted design, gave a sample of the fabric to defendant's vice president suggesting that defendant produce a lace "which would have the look' of plaintiff's design."<sup>120</sup> In affirming a finding of liability, the Court of Appeals for the Second Circuit found "the fact of copying . . . clear,"<sup>121</sup> accepting plaintiff's counsel's characterization of the customer's instruction as "'make it for me the same but different.'"<sup>122</sup>

A closer question arises when a request for the production of a particular type of work is unaccompanied by a copy of plaintiff's work. Of course where the request is of a high order of generality such as a "talking blues song," a "formula teenage romance" or a "bright floral pattern," it is clear that only an idea is being transmitted. But suppose the specification is indeed detailed and is, of course, patterned on the plaintiff's work. It may be that in most cases one is still simply conveying an idea or set of ideas, the execution of which would produce an independent set of expressions.<sup>123</sup> This situation might have been lurking in *Malden Mills, Inc. v. Regency Mills, Inc.*,<sup>124</sup> a reversal of the denial of a preliminary injunction in a textile design case. Defendants' design was called "Rustic Road," and defendants included one Sanford Levine, who left plaintiff's employ to found the defendant corporation. The court stated:

There was no testimony at trial as to how Rustic Road was designed, although Sanford Levine did testify that he had told his brother Ronald that he "wanted a tree-type pattern." The district court found that the principals of Regency knew of [plaintiff's] design . . . and of its success.<sup>125</sup>

The reversal in *Malden Mills* clearly inferred copying from these facts and considered the sole issue to be substantial similarity, as to which the appellate court's de novo review resulted in an affirmative finding.<sup>126</sup>

---

117. 360 F.2d 1021 (2d Cir. 1966); *supra* notes 55-62 and accompanying text.

118. See *supra* note 70 and accompanying text.

119. 433 F.2d 409 (2d Cir. 1970), cert. denied, 401 U.S. 977 (1971).

120. *Id.* at 410.

121. *Id.*

122. *Id.* at 415 n.13.

123. See, e.g., *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 912 (2d Cir. 1980).

124. 626 F.2d 1112 (2d Cir. 1980).

125. *Id.* at 1113.

126. See *id.*

When we turn to indirect proof of copying, an open-minded approach will lead to a wide variety of facts probative of copying, over and above tell-tale similarities between the works. The most accurate judicial articulation of this proposition was in *Alexander v. Haley*.<sup>127</sup> Before holding that Mr. Haley's *Roots* did not infringe, Judge Frankel, relying on *Arnstein*, stated: "Actual copying may be established by direct proof or by proof of access plus a demonstration of similarities or other factors circumstantially evidencing copying."<sup>128</sup> It has already been noted that although a showing of access will in the usual case be required in order to infer copying, access itself may in some cases be indirectly established by "similarities or other factors." What are the other factors? Let us note a few examples.

Defendant's prior record of copying, or conversely, of independent production should be relevant.<sup>129</sup> Where defendant has copied previously from the very work in question, the trier of fact can certainly determine that the copying persists in a later edition.<sup>130</sup> But even a method of doing business consisting of piracy should be admissible and relevant to show that in the instance under consideration the defendant was following that method.

Conversely, defendant's record for creativity, while not conclusive, should be probative of independent creation. Thus, where an internationally known rock group had independently created numerous hit songs, this factor, together with denials of copying from plaintiff's obscure song and proof of the independent creation of the accused song, led the court to set aside a jury verdict in favor of plaintiff.<sup>131</sup>

In *National Research Bureau v. Kucker*,<sup>132</sup> involving the ambitious undertaking to compile a national directory, the court mentioned defendant's saving of costs and labor, suggesting that this might be a factor probative of copying along with the more direct evidence of copying available in that case.<sup>133</sup>

### C. Method of Proof

We have been examining examples of probative similarities as well as other evidence, direct or indirect, probative of copying. We have also been attempting to distinguish between probative similarities and the "substantial similarity" of copying bespeaking unlawful appropriation.

---

127. 460 F. Supp. 40 (S.D.N.Y. 1978).

128. Id. at 43 (emphasis added).

129. See, e.g., *Lauratex Textile Corp. v. Allton Knitting Mills*, 517 F. Supp. 900, 903-04 (S.D.N.Y. 1981).

130. See, e.g., *National Research Bureau v. Kucker*, 481 F. Supp. 612, 614 (S.D.N.Y. 1979).

131. See *Selle v. Gibb*, 567 F. Supp. 1173 (N.D. Ill. 1983), aff'd, 741 F.2d 896 (7th Cir. 1984).

132. 481 F. Supp. 612.

133. See id. at 615.

tion. Observing such a distinction permits utilization of the technique of proof appropriate to the issue at hand. *Arnstein*, it will be recalled, considered that on the issue of copying "analysis ('dissection') is relevant, and the testimony of experts may be received to aid the trier of the facts" but that on the issue of unlawful appropriation "the test is the response of the ordinary lay hearer; accordingly, on that issue, 'dissection' and expert testimony are irrelevant."<sup>134</sup>

If the *Arnstein* approach is followed, it becomes important for a court to know which issue it is deciding so that it can determine whether or not dissection or expert testimony are relevant. The courts have not always kept in mind the need for such focus.

Our old friend *Universal Athletic Sales Co. v. Salkeld*,<sup>135</sup> which first alerted us to the double usage of "substantial similarity," actually inferred from the way the district court went about its task which type of substantial similarity had been found and which had not. Since the district court seemed to be dissecting, this signaled to the Court of Appeals that the district court must have been deciding the copying issue. Conversely, since there was no indication that the lower court had applied the ordinary observer test, the Third Circuit concluded that the unlawful appropriation issue had not been reached. Rather than remand, the appellate court applied the ordinary observer test itself, noted gross dissimilarities between the works and concluded that only ideas and minimal creative expressions had been copied.<sup>136</sup>

Inappropriate use of dissection was one reason for the reversal by the Court of Appeals for the Ninth Circuit in *Kamar International, Inc. v. Russ Berrie & Co.*<sup>137</sup> Since *Krofft* and not *Arnstein* controlled, the reversal was based in part on the following:

The court below made no mention of *Krofft*, and nowhere does it employ the two-part test *Krofft* mandates. No findings of fact can be so construed. The only finding the court made on similarity indicates that the court used the analytic dissection method condemned by *Krofft*, or rather permitted by *Krofft* for the "extrinsic" test part only.<sup>138</sup>

It may be recalled that the *Krofft* court (but not this writer) felt more comfortable approximating its two-part test with that of *Arnstein*. If such approximation is permitted, then the district court in *Kamar* is being appropriately chided for using dissection on the second test—that of substantial similarity of expression. The court of appeals does not help matters by repeating the maxim this Article seeks to discredit, namely that copying may be indirectly proven when "plaintiff demon-

---

134. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

135. 511 F.2d 904 (3d Cir.), cert. denied, 423 U.S. 863 (1975); see supra notes 11-14 and accompanying text.

136. See *id.* at 908-09.

137. 657 F.2d 1059 (9th Cir. 1981).

138. *Id.* at 1063.

strates that the defendant had access to the copyrighted items, and that the defendant's product is substantially similar to plaintiff's work."<sup>139</sup>

As noted above, some courts may prefer to dispose of infringement suits by addressing the substantial similarity issue first. If a finding for defendant is made on that issue, the court can avoid credibility issues arising from defendant's denial of copying and the battle of the experts. This is precisely the course taken by Judge Weinfeld in *Davis v. United Artists, Inc.*,<sup>140</sup> in which summary judgment for defendant was granted. Following closely the *Arnstein* approach, the court expressly excluded from consideration an expert's opinion on similarities as well as defendant's denials and affirmative evidence of independent creation.<sup>141</sup>

#### D. Scope of Review and Summary Judgment

The credibility issues Judge Weinfeld avoided in *Davis* could well block summary judgment in a case in any way close. Indeed, it will be recalled that even when some of the plaintiff's evidence of access contradicting defendant's denial of access and copying was considered "fantastic,"<sup>142</sup> the perceived need for in-court cross-examination was one basis for denying summary judgment. Furthermore, appellate review of credibility issues is sharply limited. On the other hand, similarity issues can often be determined by simply comparing the two works and attempting to apply the ordinary audience test.<sup>143</sup> And some circuit courts of appeals have explicitly decided that on the latter issue an appellate court is in as good a position as the trial court to make a determination.<sup>144</sup> It thus becomes crucial for a court to understand which issue it is deciding—copying, with possible credibility questions, or

---

139. *Id.* at 1062.

140. 547 F. Supp. 722 (S.D.N.Y. 1982).

141. *Id.* at 724 & n.8.

142. *Arnstein*, 154 F.2d at 469 (quoting district judge below, 66 U.S.P.Q (BNA) 281, 282 (S.D.N.Y. 1945)).

143. See, e.g., *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48-49 (2d Cir.), cert. denied, 476 U.S. 1159 (1986); *Warner Bros. v. American Broadcasting Cos.*, 720 F.2d 231, 239-40 (2d Cir. 1983); *Malden Mills v. Regency Mills*, 626 F.2d 1112, 1113 (2d Cir. 1980).

144. See, e.g., *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir.), cert. denied, 459 U.S. 880 (1982); *Novelty Textile Mills v. Joan Fabrics Corp.*, 558 F.2d 1090, 1093 (2d Cir. 1977).

Federal Rule of Civil Procedure 52(a) was amended in 1985 to curtail de novo review of trial court findings based solely on documentary evidence. Fed. R. Civ. P. 52(a) ("Findings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous . . . .") (emphasis added). Nonetheless, at least one subsequent copyright decision suggests that the old approach to appellate review of similarity issues may continue to apply if the comparison involves no issues of credibility. See *Weissmann v. Freeman*, 868 F.2d 1313, 1322 (2d Cir.) ("[T]he trial judge cannot insulate his findings on originality from appellate review by calling them credibility determinations."), cert. denied, 110 S. Ct. 219 (1989).

substantial similarity, with the record undisputed as to the content of the two works.

A case illustrating this distinction was decided by the Court of Appeals for the Third Circuit a year after *Universal Athletic Sales*. In *Franklin Mint Corp. v. National Wildlife Art Exchange, Inc.*,<sup>145</sup> the court affirmed a judgment for defendant when a nationally recognized wildlife artist, who had transferred to plaintiff his copyright in the painting "Cardinals on Apple Blossoms," subsequently painted a series of pictures including one of cardinals. Judge Weis took the occasion to distinguish this situation from *Universal Athletic Sales*, for which he had also written the opinion of the court. In *Franklin Mint*, the appellate court deemed itself bound by the "clearly erroneous" rule because of the precise issue involved, stating:

It is well settled that credibility determinations are uniquely the province of the fact-finder. Although evidence of access and similarity between the paintings constitute strong circumstantial evidence of copying, they are not conclusive. The trial court's finding of no copying, based as it is on the testimony of the artist and other evidence of creativity, may be overturned only if it is clearly erroneous.<sup>146</sup>

The *Franklin Mint* court distinguished *Universal Athletic Sales* in the following language:

This situation is different from that in *Universal Athletic Sales Co. v. Salkeld* . . . where we passed on the question of similarity between the copyrighted and accused work *after* copying had been established to determine if there had been appropriation. There, we were in as good a position to make a judgment as the trial court. Here, however, we have not had the opportunity to hear and see the witnesses and, thus, are not in the position to judge credibility as was the district judge.<sup>147</sup>

A curious twist caused by the credibility concerns implicated in copying issues was furnished in the "*Roots*" case mentioned earlier.<sup>148</sup> Defendants in that case were willing to concede copying for the purposes of a summary judgment motion they had made.<sup>149</sup> The court stated that this proffer was made by defendants, "[r]ecognizing that the question of actual copying is not susceptible of resolution on papers."<sup>150</sup> Judge Frankel declined the proffer because of his fear that the issue of substantial similarity might not be "sealed off hermetically

---

145. 575 F.2d 62 (3d Cir.), cert. denied, 439 U.S. 880 (1978).

146. Id. at 66 (citations omitted).

147. Id.; see also *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F. Supp. 125, 138 (D.N.J. 1982) (discussing *Universal Athletic Sales*), aff'd, 775 F.2d 70 (3d Cir. 1985), cert. denied, 475 U.S. 1047 (1986).

148. *Alexander v. Haley*, 460 F. Supp. 40 (S.D.N.Y. 1978); see supra notes 127-128 and accompanying text.

149. See 460 F. Supp. at 43; see supra note 112 and accompanying text.

150. 460 F. Supp. at 43.

from the question of copying.<sup>151</sup> Citing *Arnstein*, he noted that “[l]ooking at things from the opposite direction, it is commonplace that similarity may be probative of copying.”<sup>152</sup> The court then referred the charge of actual copying to a magistrate for an evidentiary hearing at which only “*direct* proof of access and copying” was to be considered.<sup>153</sup> The magistrate found that Alex Haley had had access to one of plaintiff’s works, but the record led the court to find no copying and no possible “spillover” between the issues of copying and substantial similarity.<sup>154</sup> The court then proceeded to find no substantial similarity of protected matter, and granted summary judgment for defendant.<sup>155</sup> This unusual procedure to make a complete record was followed “[p]erhaps out of excessive caution . . . believing at any rate that the case should be as ripe as possible for decision here and on appeal.”<sup>156</sup>

Another district court, writing a most instructive opinion on the matters treated in this Article, carefully separated the two infringement issues in deciding a summary judgment motion concerning two sets of video games.<sup>157</sup> As to each set, the judge found such similarities as to justify summary judgment for plaintiff on the issue of copying.<sup>158</sup> He also found a “high degree of similarity” as to the second set which presumably would have satisfied him as a trier of fact and did in fact lead him to grant a preliminary injunction.<sup>159</sup> Nevertheless, he declined to grant plaintiff full summary judgment as to either set since the trier of fact had to determine “whether an ordinary lay observer would detect such a substantial similarity between the two works as to show the copying went so far as to constitute improper appropriation.”<sup>160</sup> In so doing, the court observed:

[T]he Third Circuit draws a distinction between substantial similarity for purposes of copying and for purposes of appropriation. The inquiry as to each is different. Thus, there is no inconsistency in this court’s granting summary judgment on the substantial similarity question for copying purposes while simultaneously denying it for appropriation purposes.<sup>161</sup>

These cases show the possibility of separating issues. Avoidance of

---

151. *Id.*

152. *Id.* at 43 n.1.

153. *Id.* at 43 (emphasis added).

154. See *id.* at 43-44.

155. See *id.* at 44-46.

156. *Id.* at 43.

157. See *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F. Supp. 125 (D.N.J. 1982).

158. See *id.* at 149, 154.

159. See *id.* at 153-54. The court did not enter a preliminary injunction as to the first set “only because it appear[ed] to be unnecessary” since defendant had ceased sales, but indicated that a preliminary injunction would “issue as a matter of course” if sales recommenced. *Id.* at 149 n.26.

160. *Id.* at 149; see *id.* at 154.

161. *Id.* at 149 n.26.

the double usage of "substantial similarity" would assist other courts to do so.

### CONCLUSION

The purpose of this Article has been to place proof of copying in its proper perspective. As a necessary ingredient of copyright infringement, it must be established before liability can be found. But it can be established in a variety of ways, just as any ultimate fact can, without necessary reliance on maxims or formulae.

A few myths have gotten in the way of this straightforward approach. One is that direct evidence of copying is "rarely, if ever, available."<sup>162</sup> Others flow from dual usages of terms such as "copying" and "access." But the most persistent concerns the kind of internal similarities between the protected and accused works necessary to show copying. This is the myth that such similarity is necessarily akin to the nature and amount of similarity necessary to fulfill the second prong of infringement. This myth is perpetuated, or at any rate encouraged, by use of the term "substantial similarity" to describe both the similarities probative of copying and the similarity amounting to an unlawful appropriation. It has been suggested that abandonment of this adjective in the former setting would encourage closer analysis of copyright issues. The term could then properly become "probative similarity."

If this approach were followed, the following might serve as an expanded substitute for the opening litany:

"In order to prove infringement a plaintiff must show ownership of a valid copyright and copying by defendant of a substantial portion of protected material from plaintiff's work. Such copying would, by definition, result in a substantial order of similarity, i.e., 'substantial similarity' between the works of plaintiff and defendant.

"Copying in the first instance may be established by direct or indirect proof. Though direct proof may not be routinely available, its potential should not be overlooked.

"A common form of indirect proof of copying—but far from the only form—is a showing of defendant's opportunity to come into contact with plaintiff's work and such similarities between the works which, under all the circumstances, make independent creation unlikely. Such similarities may or may not be substantial. They are not, however, offered for their own sake in satisfaction of the requirement that defendant has taken a substantial amount of protected material from plaintiff's work. Rather, they are offered as probative of the act of copying and may accordingly for the sake of clarity conveniently be called 'probative similarity.' "

---

<sup>162</sup> Novelty Textile Mills v. Joan Fabrics Corp., 558 F.2d 1090, 1092 (2d Cir. 1977); see *supra* notes 31-33 and accompanying text.