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RESTATEMENT OF THE LAW
COPYRIGHT

Tentative Draft No. 4

(March 2023)

SUBJECTS COVERED

- CHAPTER 4** Copyright Formalities (§ 40 (for reference only); §§ 42-45)
- CHAPTER 5** Duration of Copyright (§§ 49 and 52)
- CHAPTER 6** Copyright Rights and Limitations (§ 55 (for reference only); §§ 6.05, 6.07, 6.08, 6.11)
- CHAPTER 7** Copyright Infringement (§§ 7.01-7.04, 7.07)
- APPENDIX A** Statutory Appendix
- APPENDIX B** Black Letter of Tentative Draft No. 4
- APPENDIX C** Black Letter of Sections Approved by Membership

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1 **§ 7.04. Improper Appropriation**

2 As stated in § 7.01(a), proving infringement of any of a copyright owner's exclusive
3 rights requires a plaintiff to prove ownership of a valid copyright and copying of protected
4 expression from the copyrighted work. Proving copying of protected expression requires the
5 plaintiff to prove both copying in fact, as discussed in § 7.03, and that the copying amounted
6 to improper appropriation. Proving improper appropriation requires the plaintiff to prove
7 that sufficient protected expression was copied from the copyrighted work such that there is
8 a substantial similarity between the alleged infringing use and the copyrighted work.

9 **Source Note:**

10 17 U.S.C. § 501; Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991).

11 **Comment:**

12 *a. Generally.* The Copyright Act does not contain a statement of the elements of a prima
13 facie case of infringement, and the required proof may vary based on which of the copyright
14 owner's exclusive rights (i.e., the rights set out in 17 U.S.C. § 106) the copyright owner asserts the
15 defendant has infringed. Courts have created a framework for the infringement analysis, see § 7.01,
16 and that analysis requires a copyright owner to prove not only that there was copying *from* the
17 copyrighted work (that is, copying in fact, which is discussed in § 7.03 of this Restatement) but
18 also that the copying constituted improper appropriation, in that the copier appropriated a sufficient
19 amount of protected expression from the copyrighted work. This is often referred to by courts as
20 requiring a showing of improper appropriation, although other labels are sometimes used, such as
21 "actionable copying," "unlawful copying," and sometimes simply "substantial similarity." The use
22 of "substantial similarity" as a label for this element of the prima facie case is problematic as it
23 can confuse the two instances in which the similarities between the copyrighted work and the
24 defendant's allegedly infringing use are relevant: first, in the context of proving copying in fact
25 through circumstantial evidence of access and similarity, see § 7.02 of this Restatement, and
26 second, in the context of proving whether enough of the protected expression from the plaintiff's
27 copyrighted work has been copied to constitute infringement. This Restatement uses the label
28 "improper appropriation" to signal the purpose behind the inquiry into substantial similarity in this
29 second context.

1 The black letter of this Section uses the phrase “infringing use” rather than “infringing
2 work” or “infringing copy” because while some infringement claims are based on assertions that
3 defendants have reproduced or distributed copies or phonorecords of the copyrighted work, other
4 claims of infringement are based on claims that defendants have prepared derivative works,
5 publicly performed or displayed plaintiffs’ copyrighted works, or engaged in copying in a context
6 that does not otherwise create a new work. As made clear in the articulation of the *prima facie* case
7 of infringement, to be an “infringing use,” the use that the defendant has engaged in must be
8 encompassed within one of the exclusive rights granted to a copyright owner. See § 7.01(a)(1) of
9 this Restatement.

10 As with the other elements of a *prima facie* case of infringement, the requirement to
11 demonstrate improper appropriation through a showing of substantial similarity between the
12 defendant’s allegedly infringing use and the plaintiff’s copyrighted work is not contained in the
13 text of the Copyright Act. Instead, courts have developed the improper appropriation element and
14 its varying articulations. Under any of the various articulations of this element that the federal
15 courts have applied, a plaintiff need not show that the defendant created an exact duplicate of the
16 copyrighted work, although such a showing likely satisfies the improper appropriation element of
17 the *prima facie* case. See Comment *b*. Instead, the plaintiff need only show that enough protected
18 expression contained in the copyrighted work was copied to render the defendant’s use
19 “substantially similar.” As courts and commentators have recognized, “[t]he determination of the
20 extent of similarity which will constitute a *substantial* and hence infringing similarity presents one
21 of the most difficult questions in copyright law, and one which is the least susceptible of helpful
22 generalizations.” *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 683 F.2d 610, 623 (2d Cir. 1982)
23 (quoting Nimmer on Copyright § 13.03(A)) (emphasis in original). Courts have employed a variety
24 of different articulations for the inquiry into the required substantial similarity that the improper
25 appropriation element involves. This Section explores the principles that underlie the improper
26 appropriation element of a *prima facie* case of infringement. In the end, it is often not a particular
27 label or phrasing of the test that decides the outcome in any particular case but rather the close,
28 detailed analysis of the works in light of the underlying principles.

29 To prove improper appropriation, a plaintiff must demonstrate the required substantial
30 similarity based on copying of protected expression. See Comments *c* through *e*. As discussed in
31 § 13, Comment *d*, of this Restatement, protected expression can include nonliteral elements of a

1 copyrighted work. Consideration of nonliteral elements in the context of evaluating improper
2 appropriation is discussed in Comment *d* of this Section. If only a de minimis amount of protected
3 expression is copied, there can be no substantial similarity. See Comment *g*. However, simply
4 copying more than a de minimis amount is not itself sufficient—the alleged infringing use must
5 also meet the test of substantial similarity; if the allegedly infringing use is not substantially similar
6 to protected expression in the plaintiff's copyrighted work, there is no improper appropriation, and
7 thus there is no infringement. See Comments *i* through *l*.

8 *b. Complete duplication of the entire copyrighted work.* If the alleged infringing use is a
9 wholesale duplication of the plaintiff's entire copyrighted work, without more, there is almost
10 certainly the required substantial similarity to support a finding of improper appropriation. See
11 Illustration 1. However, if the alleged infringing use has replicated the entire copyrighted work in
12 a context that adds more expression and/or has sufficiently altered the copied protected expression
13 (for example, by sufficiently altering the work's quality or clarity), a determination of whether the
14 relevant audience will perceive substantial similarity will depend on the particular facts of the case.
15 See Illustration 2; see also Comment *k* (discussing de minimis copying). Such additions and
16 alterations may also be relevant to an analysis of fair use, discussed in § ____ of this Restatement.

17 **Illustrations:**

18 1. Computer Manufacturer A created a complex, copyrighted operating system for
19 A's computers. In a suit against Computer Manufacturer B for infringing the copyright in
20 A's operating system, A introduces evidence showing that B reproduced the entire
21 operating system for use in B's computers. A has met its burden to establish the element
22 of improper appropriation.

23 2. Photographer creates a copyrighted photograph. Movie Studio creates a full-
24 length feature film in which Photographer's photograph appears, and Photographer sues
25 Movie Studio for infringement. In the infringement suit, Photographer introduces evidence
26 that the photograph appears in only one scene of the film, lasting 35 seconds. In that scene,
27 the photograph appears in the background, hanging on the wall of an apartment where the
28 scene is taking place. The photograph is in the distant background and is not in focus during
29 much of the scene. In two shots during the scene, one lasting four seconds and the other
30 lasting two seconds, the photograph is in focus but remains barely discernible. In the shot
31 lasting four seconds, after one and a half seconds, the photograph is completely obstructed

1 by a prop in the scene. Photographer has not met its burden of showing the element of
2 improper appropriation.

3 c. *Improper appropriation requires copying of protected expression.* “Not all copying . . .
4 is copyright infringement.” *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).
5 As the U.S. Supreme Court has explained, “[t]he mere fact that a work is copyrighted does not
6 mean that every element of the work may be protected.” *Id.* at 348. The plaintiff must establish
7 that elements that the defendant copied from the plaintiff’s work were elements that are protected
8 by copyright.

9 The Supreme Court has used the phrase “constituent elements of the work that are
10 original,” *id.* at 361, to describe what must be copied in order for there to be infringement. As the
11 Supreme Court made clear in *Feist*, originality is the *sine qua non* of copyright and is required by
12 the U.S. Constitution’s Copyright Clause. For a work to be protected by copyright, it must contain
13 originality. See §§ 5 to 8 of this Restatement (discussing the requirements of originality and
14 fixation). For a copyrighted work to be infringed, the infringing use must copy original elements
15 from the copyrighted work, i.e., elements of the copyrighted work that copyright protects. For a
16 discussion of the scope of copyright protection generally, see Chapter 2 of this Restatement. As
17 articulated by the Second Circuit, the plaintiff must demonstrate that “the copying is illegal
18 because a substantial similarity exists between the defendant’s work and the protectible elements
19 of plaintiff’s.” *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 63 (2d Cir.
20 2010). Recognizing the Supreme Court’s holding that originality is constitutionally required for
21 copyright protection, and integrating it into the infringement analysis, the Sixth Circuit has held
22 “it is a constitutional requirement that a plaintiff bringing an infringement claim must prove
23 ‘copying of constituent elements of the work *that are original.*’” *Kohus v. Mariol*, 328 F.3d 848,
24 853 (6th Cir. 2003) (quoting *Feist*, 499 U.S. at 361) (emphasis in original).

25 In addition to protecting only original elements of a copyrighted work, the Copyright Act
26 does not extend protection to “any idea, procedure, process, system, method of operation, concept,
27 principle, or discovery, regardless of the form in which it is described, explained, illustrated, or
28 embodied,” 17 U.S.C. § 102(b). In copyright law, the label “expression” is used to identify
29 protected elements of a work and to distinguish them from unprotected elements, which are given
30 the general label “ideas.” For a summary, and a division of the general category of “ideas” into the
31 three subcategories of “ideas,” “methods,” and “facts,” see §§ 12 and 14 to 16 of this Restatement.

1 Copyright law also excludes additional elements of works from copyright protection, such as
2 pictorial, graphic, or sculptural elements contained in a useful article when those elements cannot
3 be separated from the utilitarian aspects of the article, and elements of a work that constitute an
4 edict of law. See §§ 10 and 19 of this Restatement. As a result, courts sometimes describe the
5 improper appropriation element of the plaintiff's *prima facie* case as requiring that the plaintiff
6 demonstrate the defendant copied "protected" or "protectable" expression. As articulated by the
7 Seventh Circuit, "[i]f the copied parts are not, on their own, protectable expression, then there can
8 be no claim for infringement." *Peters v. West*, 692 F.3d 629, 632 (7th Cir. 2012) (citing *Peter F.*
9 *Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 61 (2d Cir. 2010)); see also *Gottlieb*
10 *Dev. LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625, 631 (S.D.N.Y. 2008) ("When similar
11 works resemble each other only in unprotected aspects—for example, when similarities inhere in
12 ideas, which are by definition unprotected, or in expression that is not proprietary to plaintiff—the
13 defendant prevails." (citing *Bill Diodato Photography, LLC v. Kate Spade, LLC*, 388 F. Supp. 2d
14 382, 390 (S.D.N.Y. 2005))). In some instances, the "copied parts" of the plaintiff's work might be
15 the selection, arrangement, or coordination of unprotectable material, because copyright in a
16 compilation protects an original selection, arrangement, or coordination, even if the material
17 compiled is not protectable. See § 4 of this Restatement.

18 As discussed in § 17 of this Restatement, when protecting particular expression in a work
19 of authorship would have the effect of extending protection to an unprotectable element of that
20 work, such as an idea or method, then the scope of copyright does not extend to that particular
21 expression under the doctrine of merger. Merger applies when there is only one way, or very few
22 ways, of expressing an unprotectable element; the key inquiry is not exactly how many alternatives
23 there are, but rather whether the range of viable alternatives is so constrained that granting
24 copyright would effectively bar others from expressing the unprotected element. In such a case,
25 that expression is said to have merged with the unprotectable element to which it is linked. Because
26 a plaintiff must demonstrate that the defendant copied protectable expression from the plaintiff's
27 copyrighted work, the doctrine of merger can be relevant to the improper appropriation element of
28 the *prima facie* case if expression that would otherwise be protectable is not protected because of
29 merger. See § 17 of this Restatement.

30 As discussed in § 18 of this Restatement, the scope of copyright protection for a work of
31 authorship does not extend to any element of expression in that work that: (a) is standard, stock,

1 customary, stereotypical, or common in the treatment of a particular subject or given topic;
2 (b) flows naturally from unprotectable elements in the work; or (c) is dictated by external factors.
3 These unprotected elements within a work are referred to as *scènes à faire*. Because a plaintiff
4 must demonstrate that the defendant copied protectable expression from the plaintiff's copyrighted
5 work, the *scènes à faire* doctrine can be relevant to the determination of improper appropriation as
6 those copied elements that are *scènes à faire* should be filtered out prior to evaluating the
7 similarities. If, however, the defendant has copied the way in which the plaintiff has expressed the
8 same *scènes à faire* element (e.g., copying word for word the dialog between two entirely
9 stereotypical superheroes), the similarity of that expression is relevant to the determination of
10 improper appropriation. See § 18 of this Restatement.

11 If the only similarities between a plaintiff's copyrighted work and a defendant's allegedly
12 infringing use are the presence of the same unprotected elements in both works (including facts,
13 ideas, expression that has merged with unprotected elements, *scènes à faire* elements, etc.), then
14 the defendant has not copied any protectable expression from the plaintiff's work and there is no
15 improper appropriation. However, if the plaintiff's selection or arrangement of particular
16 unprotected elements is original, then the defendant could be liable for infringement if the defendant
17 has copied the plaintiff's original selection or arrangement of those unprotected elements.

18 *d. Levels of abstractions in the context of evaluating claims of infringement of nonliteral
elements of a work.* Copyright protection extends beyond the literal elements of a copyrighted
19 work. Describing the boundary between protectable expression and unprotectable idea is often
20 done using the concept of levels of abstractions contained within a work. The source of the
21 “abstractions test” is a decision involving alleged infringement of a play by a motion picture. Judge
22 Learned Hand authored the decision for the court:

24 Upon any work . . . a great number of patterns of increasing generality will fit
25 equally well, as more and more of the incident is left out. The last may perhaps be
26 no more than the most general statement of what the play is about, and at times
27 might consist only of its title; but there is a point in this series of abstractions where
28 they are no longer protected, since otherwise the playwright could prevent the use
29 of his “ideas,” to which, apart from their expression, his property is never extended.

30 Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930). As a later Second Circuit
31 opinion described, “takings from a protected source . . . can occur at varying levels of abstraction

1 from the concrete realization of the original, . . . the more remote in abstraction the taking is from
2 the original, the less likely that it will constitute a taking of protected expression.” CCC Info.
3 Servs., Inc. v. Maclean Hunter Mkt. Reps., Inc., 44 F.3d 61, 69 (2d Cir. 1994). Defining the precise
4 line between copyrighted expression and uncopyrightable idea is not the point of the abstractions
5 test, rather the concept of a series of levels of abstractions helps to conceptualize the point along a
6 continuum at which the alleged infringing use is similar to the copyrighted work. A court must
7 then decide whether that particular point on the continuum is on the protectable side of the line
8 and can thus support a finding of improper appropriation. See generally Nash v. CBS, 899 F.2d
9 1537, 1540 (7th Cir. 1990) (“Sometimes called the ‘abstractions test,’ Hand’s insight is not a ‘test’
10 at all. It is a clever way to pose the difficulties that require courts to avoid either extreme of the
11 continuum of generality.”).

12 Initially articulated in a case involving a play (*Nichols*), courts have employed the
13 abstractions test as part of the analysis of the improper-appropriation element of the *prima facie*
14 case of infringement in cases involving other types of works. In the computer-software context, in
15 which cases often involve allegations of infringement based on nonliteral elements of the work, in
16 many circuits, that abstractions test is part of a three-step analysis, referred to as “abstraction-
17 filtration-comparison.” Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 706 (2d Cir. 1992)
18 (holding that “district courts would be well-advised to undertake a three-step procedure”). Courts
19 have indicated that “[t]he abstractions test is especially well suited to the dissection of computer
20 programs because the test breaks down a program in a way that parallels the typical development
21 of a program.” Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 834 (10th Cir. 1993)
22 (adopting the abstraction-filtration-comparison test). The abstraction-filtration-comparison test
23 labels the second step “filtration,” as discussed in Comment e.

24 *e. Filtering out unprotected elements.* The need to compare only protectable elements
25 common to the plaintiff’s work and the defendant’s use results in courts filtering out unprotected
26 elements and comparing the remaining protected elements from the copyrighted work with the
27 material that was included in the defendant’s allegedly infringing use to determine whether the
28 required substantial similarity is present. As the Ninth Circuit has described, “[t]o conduct a
29 copyright infringement analysis, the factfinders ask ‘whether “the *protectible elements, standing
30 alone*, are substantially similar”’ and ‘disregard the non-protectible elements.’” Skidmore v. Led
31 Zeppelin, 952 F.3d 1051, 1070 (9th Cir. 2020) (citations omitted) (emphasis in original). Courts

1 also sometimes refer to this step in the analysis as “dissecting” the elements alleged to have been
2 copied to exclude those that are not protected by copyright. See, e.g., *Brown Bag Software v.*
3 *Symantec Corp.*, 960 F.2d 1465, 1476-1477 (9th Cir. 1992) (discussing “dissection” in the context
4 of the substantial similarity inquiry and for “the purpose of defining the scope of plaintiff’s
5 copyright”).

6 Filtering out unprotected elements prior to the similarity comparison is prominent in cases
7 involving computer software. See, e.g., *Computer Assocs. Int’l v. Altai Inc.*, 982 F.2d 693 (2d Cir.
8 1992); *Kepner-Tregoe, Inc. v. Leadership Software, Inc.*, 12 F.3d 527 (5th Cir. 1994). It is the
9 second step in the abstraction-filtration-comparison test often employed in cases involving
10 allegations of nonliteral infringement of computer software. But the step of filtering out
11 unprotected elements is employed not just in cases involving computer software; courts
12 appropriately engage in filtering prior to comparing the alleged similarities in cases involving
13 various types of copyrighted works. See, e.g., *Rentmeester v. Nike, Inc.*, 883 F.3d 1111 (9th Cir.
14 2018) (photographs); *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002) (literary
15 works); *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173 (1st Cir. 2013) (photographs);
16 *Coquico, Inc. v. Rodriguez-Miranda*, 562 F.3d 62, 68 (1st Cir. 2009) (plush toys).

17 In engaging in the filtering out of unprotected elements, care must be taken to not take that
18 dissection to the extreme, as this “would result in almost nothing being copyrightable because
19 original works broken down into their composite parts would usually be little more than basic
20 unprotectible elements like letters, colors and symbols.” *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272
21 (2d Cir. 2001). In cases involving assertions of copyright in the compilation of unprotected
22 elements, such as facts or expression that are in the public domain, originality in the selection,
23 coordination, or arrangement of those unprotected elements is protected expression. See § 4 of this
24 Restatement. Thus, while copying the unprotected elements in a compilation—i.e., the facts or other
25 public-domain material—cannot be the basis of a finding of improper appropriation, copying the
26 protected elements—i.e., the original selection, coordination, or arrangement of the unprotected
27 elements—can satisfy this element of the *prima facie* case of infringement. As the Second Circuit
28 has described, “while the infringement analysis must begin by dissecting the copyrighted work into
29 its component parts in order to clarify precisely what is not original, infringement analysis is not
30 simply a matter of ascertaining similarity between components viewed in isolation.” *Tufenkian*
31 *Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 134 (2d Cir. 2003).

1 In evaluating whether the plaintiff has shown improper appropriation, it does not matter
2 which step is done first, the identification of what is protectable (for example, the step of filtering
3 discussed in Comment *e* or the step of identifying levels of abstraction discussed in Comment *d*),
4 or the identification of similarities between the plaintiff's copyrighted work and the defendant's
5 alleged infringing use. What matters is that to the extent the alleged infringing use and the
6 copyrighted work share similarities, those similarities must be of protected elements. Compare
7 *Tufenkian*, 338 F.3d at 134-135 ("The court, confronted with an allegedly infringing work, must
8 analyze the two works closely to figure out in what respects, if any, they are similar, and *then*
9 determine whether these similarities are due to protected aesthetic expressions original to the
10 allegedly infringed work, or whether the similarity is to something in the original that is free for
11 the taking.") (emphasis added), with *id.* at 134 ("while the infringement analysis must *begin* by
12 dissecting the copyrighted work into its component parts in order to clarify precisely what is not
13 original, infringement analysis is not *simply* a matter of ascertaining similarity between
14 components viewed in isolation").

15 *f. Burden of proof and defense arguments concerning protectability of copied elements.* To
16 make out a prima facie case of infringement, the plaintiff must demonstrate that the work allegedly
17 infringed is protected by a valid copyright, see § 7.02 of this Restatement. The plaintiff must also
18 demonstrate that the defendant's copying from that copyrighted work constituted improper
19 appropriation, which includes demonstrating that the particular elements of the copyrighted work
20 that were copied in the infringing use are protected by the work's valid copyright. For example, if
21 the work is an original compilation of unprotected facts, the plaintiff must show that the copied
22 elements contained in the infringing use were original selection, coordination, or arrangement of
23 those facts. See § 4 of this Restatement.

24 The defendant may assert that even though the plaintiff's work is protected by a valid
25 copyright, the particular material that was copied from the plaintiff's copyrighted work is not
26 subject to copyright protection. The basis for that lack of copyright protection can vary based on
27 the facts of the case. For example, a defendant may assert that the copied material was only
28 unprotected ideas, and not protected expression. Alternatively, a defendant may assert that the
29 copied material is not protected because of the merger doctrine or because the material was *scènes
à faire*. See Comments *g* and *h*. It is appropriate to require the defendant to identify its arguments
30 concerning the lack of protectability of the copied elements, as it may highlight a deficiency in the
31

1 plaintiff's prima facie case, but requiring the defendant to specify the grounds for its claim that the
2 copied material is unprotected does not translate into an assignment of the burden of proof on the
3 element of improper appropriation to the defendant. At the same time, a defendant cannot simply
4 assert that the material is unprotected. The defendant must explain the basis for such assertion and
5 provide additional evidence when appropriate. Once the defendant effectively challenges the
6 protectability of the copied elements, the question to be decided is a legal one: if the copied
7 material is not protected by copyright, that copying cannot form the basis for a finding of improper
8 appropriation necessary to satisfy the plaintiff's burden of proof on that element. See also § 7.01,
9 Comment *f.*

10 *g. Merger in the context of the prima facie case of infringement.* The argument that particular
11 expression the defendant copied from the plaintiff is unprotected due to merger is best understood
12 as a legal argument, countering the plaintiff's showing of improper appropriation. See Comment *f.*
13 A plaintiff can defeat a defendant's assertion of merger by demonstrating that there are sufficient
14 ways to express the same idea or other unprotected elements such that protection of the expression
15 at issue would not have the effect of protecting unprotectable material. See N.Y. Mercantile Exch.,
16 Inc. v. Intercontinental Exch., Inc., 497 F.3d 109, 117 n.9 (2d Cir. 2007) ("We need not determine
17 how many expressions would be too many for application of the merger doctrine. The appropriate
18 inquiry focuses not on the exact quantity of possible expressions but on the effect of granting
19 copyright protection; we ask whether 'protection of expression would inevitably accord protection
20 to an idea.'" (internal citations omitted)); Lexmark Int'l, Inc. v. Static Control Components, Inc.,
21 387 F.3d 522, 536 (6th Cir. 2004) ("The question . . . is not whether *any* alternatives theoretically
22 exist; it is whether other options practically exist under the circumstances.").

23 In some decisions, courts consider merger arguments in the context of determining whether
24 the plaintiff's copyright is valid, which is the first element of the prima facie case. See § 7.02 of
25 this Restatement. In other decisions, courts analyze the merger doctrine in the context of the
26 improper appropriation element of the prima facie case—i.e., whether the defendant has copied a
27 sufficient amount of protected expression from the plaintiff's copyrighted work. If considered as
28 part of the first element of the prima facie case, and if merger is found as to all potentially
29 protectable elements, the result is that the plaintiff lacks a valid copyright and there can be no
30 infringement. This type of total invalidation on the basis of merger is rare. More commonly, if the
31 court has concluded that the plaintiff's proof of a valid copyright is sufficient, the court may still

1 consider an argument of merger as relevant to the improper appropriation element of the prima
2 facie case because particular expression in the copyrighted work that is found to have “merged”
3 with unprotected elements would not be considered when evaluating whether a sufficient amount
4 of protectable expression was copied. Such merged elements would be filtered out prior to
5 comparing the alleged infringing use. See Comment *d*.

6 As the Second Circuit has noted, considering merger in the context of analyzing whether
7 there is improper appropriation (rather than in the context of whether there is a valid copyright)
8 “will normally provide a more detailed and realistic basis for evaluating the claim that protection
9 of expression would inevitably accord protection to an idea.” *Kregos v. Associated Press*, 937 F.2d
10 700, 705 (2d Cir. 1991). Other courts have cited the importance of having the factual setting of at
11 least two works (the copyrighted work and the alleged infringing use) for comparison and decision
12 of the difficult line-drawing between idea and expression, and the closely related question of
13 whether the two have merged. See, e.g., *Hart v. Dan Chase Taxidermy Supply Co., Inc.*, 86 F.3d
14 320, 322 (2d Cir. 1996) (expressing a preference for evaluating merger at the infringement stage
15 when the court has “all the contested forms of expression before it”).

16 In some cases, courts have held that the effect of finding merger is a requirement of a
17 heightened proof by the plaintiff of the level of similarity, insisting that the defendant’s work be
18 nearly or virtually identical to the plaintiff’s work. See, e.g., *Yankee Candle Co. v. Bridgewater*
19 *Candle Co.*, 259 F.3d 25, 36 (1st Cir. 2001) (“[T]he plaintiff has the heavy burden of showing
20 ‘near identity’ between the works at issue.”). These cases are problematic, given the Copyright
21 Act’s command that “in no case” should copyright protection extend to unprotected elements. 17
22 U.S.C. § 102(b). Permitting expression that has merged with unprotected elements to be the basis
23 of an infringement finding could result in copyright protecting elements of a work that the statute
24 mandates remain unprotected. *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 679 (1st Cir.
25 1967).

26 In other cases, courts have been more discerning, finding that some copied elements have
27 merged and are therefore unprotected but that other copied elements remain protected by
28 copyright, leading the court to conclude that the protection for the plaintiff’s work is “thin” and,
29 as a result, the plaintiff is required to show virtual identity between the alleged infringing use and
30 the copyrighted work in order to find improper appropriation. See, e.g., *Design Basics, LLC v.*
31 *Kerstiens Homes & Designs, Inc.*, 1 F.4th 502, 503 (7th Cir. 2021) (copyrighted architectural plans

1 with many *scènes à faire* and merged elements leading court to require virtual identity). See
2 Comment *l*, discussing the virtual-identity standard.

3 **Illustration:**

4 3. Plaintiff asserts Defendant infringed its copyrighted quilting pattern consisting
5 of squares and triangles arranged into the shape of a wreath. Defendant asserts that there
6 was merger of expression and there were unprotected elements in the way that the quilting
7 pattern arranged public-domain shapes (squares and triangles). Plaintiff introduces into
8 evidence multiple patterns with different expressions, all arranging squares and triangles
9 in the shape of a wreath, showing that the copyrighted pattern is only one of many ways to
10 express a quilted wreath design using triangles and squares, and that protection of
11 Plaintiff's arrangement would not have the effect of protecting the idea of a wreath quilt
12 using triangles and squares. Plaintiff has carried its burden to demonstrate the copying of
13 protectable elements in its copyrighted work.

14 *h. The scènes à faire doctrine in the context of the prima facie case of infringement.* When
15 a plaintiff has put forth a prima facie case for infringement, the defendant might attempt to rebut
16 the plaintiff's proof of improper appropriation by asserting that the elements copied from the
17 plaintiff's work were only unprotected *scènes à faire* elements. For example, whether an element
18 of a particular type of work or the treatment of a particular topic is common, customary, stock,
19 standard, or stereotypical would seem to be a question subject to proof through the introduction of
20 evidence. A defendant could introduce into evidence multiple earlier works of the same type or on
21 the same topic to demonstrate that many or all of the elements in common between the plaintiff's
22 copyrighted work and the defendant's alleged infringing use are also present in those earlier
23 examples, meaning that they should be deemed unprotectable *scènes à faire* and there is no
24 improper appropriation even if the defendant copied those *scènes à faire* elements from the
25 plaintiff's work, rather than from the earlier examples. Similarly, the assertion that an element of
26 a work is dictated by external factors could be supported either by evidence regarding what those
27 external factors are for the works at issue, or how those external factors dictate the element that is
28 asserted to be *scènes à faire*. See § 18, Comment *f*, of this Restatement.

29 However, many cases decide the *scènes à faire* question without reference to any factual
30 evidence. This appears particularly true with respect to familiar genres and topics (for example,
31 stories about detectives, spies, superheroes, war, action movies, and so forth), for which courts are

1 comfortable in many cases deciding, without consulting any evidence from the parties, whether
 2 certain elements of a work are sufficiently common or standard and thus are *scènes à faire*.
 3 Conversely, in cases involving more complicated works, such as computer software, expert
 4 testimony introduced by the parties is often relied upon in making the determination whether
 5 elements are *scènes à faire*. Use of expert testimony on this issue is also common in cases involving
 6 musical works. See, e.g., *Skidmore*, 952 F.3d at 1070-1071; *New Old Music Grp., Inc. v. Gottwald*,
 7 122 F. Supp. 3d 78, 95 (S.D.N.Y. 2015).

8 Section 18, Comment *c*, of this Restatement discusses the nature and scope of the *scènes à*
 9 *faire* exclusion from copyright protection, including the caution against applying the doctrine too
 10 broadly so as to inappropriately exclude the particular way in which an author expresses a *scènes*
 11 *à faire* element.

12 *i. Substantial similarity.* All circuits require a plaintiff to show substantial similarity
 13 between the alleged infringing use and the plaintiff's protected expression as part of the *prima facie*
 14 case of infringement, although courts vary in their articulation of what that showing entails. Courts
 15 acknowledge the difficulty in defining with any specificity the standard for assessing when
 16 similarity becomes "substantial" because the "determinations will necessarily turn on the unique
 17 facts of each case." *Rentmeester*, 883 F.3d at 1121. See also *Peter Pan Fabrics, Inc. v. Martin Weiner*
 18 Corp.

19 , 274 F.2d 487, 489 (2d Cir. 1960) (noting that "[t]he test for infringement of a copyright is
 20 of necessity vague."). How much similarity is required to constitute improper appropriation varies
 with the nature of the copyrighted work and the defendant's alleged infringing use.

21 Courts often invoke a standard that employs an observer of the two works, asking whether
 22 that hypothetical observer would consider the works to be substantially similar. The characteristics
 23 of that observer are described with varying formulations based on the facts of the case. In many
 24 instances, courts identify the observer as the average layperson, sometimes using the shorthand
 25 label "ordinary observer test" for that formulation of the substantial similarity inquiry. See, e.g.,
 26 *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 66 (2d Cir. 2010) (quoting
 27 *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995)) ("In applying the so-called
 28 'ordinary observer test,' we ask whether 'an average lay observer would recognize the alleged copy
 29 as having been appropriated from the copyrighted work.'"). In other instances, courts make clear
 30 that the relevant observer is not the average layperson, because fundamentally the perspective by
 31 which to judge similarity should be "the perspective of the works' intended audience." *Dawson v.*

1 Hinshaw Music Inc., 905 F.2d 731, 735 (4th Cir. 1990). Using the perspective of the intended
2 audience as a lens through which to evaluate whether the similarity is substantial comports with
3 protecting the copyright owner from the economic harm that comes from copying: if the average
4 member of the intended audience would consider the defendant's work a substitute for the plaintiff's
5 copyrighted work, this is the type of harm that copyright is designed to protect the copyright owner
6 against. For example, cases consider the appeal to children relevant to the question of substantial
7 similarity for works whose primary audience is children. See, e.g., *Sid & Marty Krofft Television*
8 v. *McDonald's Corp.*, 562 F.2d 1157, 1166 (9th Cir. 1977); *Aliotti v. R. Dakin & Co.*, 831 F.2d
9 898, 902 (9th Cir. 1987); *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 619
10 (7th Cir. 1982); *Lyons P'ship, L.P. v. Morris Costumes, Inc.*, 243 F.3d 789 (4th Cir. 2001).

11 In some cases, courts articulate a test that involves asking ““whether an “ordinary observer,
12 unless he set out to detect the disparities, would be disposed to overlook them, and regard [the]
13 aesthetic appeal as the same.””” *Peter Gaito*, 602 F.3d at 66 (citations omitted). However, such a
14 formulation risks improperly permitting the copying of protectable elements in a new context in
15 which the aesthetic appeal is different, yet a finding of improper appropriation would be
16 appropriate. For example, consider the case of a copyrighted story that is made into a full-length
17 motion picture, using the same characters, detailed plot, and dialogue, without the authorization of
18 the copyright owner. That motion picture may have quite a different aesthetic appeal from the short
19 story, but nonetheless, the creation of the motion picture would constitute improper appropriation
20 because it copied protected elements from the short story, making the movie substantially similar
21 to the story. Even though watching the movie may not be a substitute for reading the story for the
22 average target audience member, nor have the same aesthetic appeal as the story, a finding of
23 improper appropriation in that context would be supported by the facts.

24 Courts also find a substantial similarity exists on the basis of literal or verbatim copying of
25 protected expression, whether or not the defendant's entire work was substantially similar to the
26 plaintiff's entire work. As the Second Circuit has noted, “[t]he concept of similarity embraces not
27 only global similarities in structure and sequence, but localized similarity in language. In both
28 cases, the trier of fact must determine whether the similarities are sufficient to qualify as
29 substantial.” *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1372 (2d Cir. 1993).

30 In conducting the “substantial similarity” analysis, however, it remains important to
31 distinguish between the protectable expression copied from the copyrighted work, which can form

1 the basis of a finding of improper appropriation, and ideas, themes, or other unprotectable elements
2 copied from the copyrighted work, which cannot form the basis of a finding of improper
3 appropriation regardless of their audience appeal. In cases involving copyrighted works with
4 significant unprotectable elements, the Second Circuit has invoked a standard of a “more
5 discerning observer,” or required that the application of the test be “more discerning,” in order to
6 guard against an inappropriate finding of substantial similarity based on unprotected elements.

7 Courts have held that substantial similarity can be determined as a matter of law, and
8 sometimes even at the pleading stage, particularly when both a complete copy of the plaintiff’s
9 copyrighted work and the alleged infringing use are before the court. See, e.g., *Peter Gaito*, 602
10 F.3d at 63 (granting defendant’s motion to dismiss, noting that “it is entirely appropriate for a
11 district court to resolve [the question of substantial similarity] as a matter of law, ‘either because
12 the similarity between two works concerns only non-copyrightable elements of the plaintiff’s
13 work, or because no reasonable jury, properly instructed, could find that the two works are
14 substantially similar.’ Warner Bros. Inc. v. Am. Broad. Cos., 720 F.2d 231, 240 (2d Cir. 1983).”).

15 *j. The intrinsic and extrinsic tests developed by the Ninth Circuit.* The Ninth Circuit has
16 broken down the improper appropriation inquiry into a “two-part analysis consisting of the
17 ‘intrinsic test’ and ‘extrinsic test.’” *Rentmeester*, 883 F.3d at 1118. The Fourth and Eighth Circuits
18 have also, at times, employed the dual intrinsic and extrinsic tests. To prevail under this approach,
19 a plaintiff must prove substantial similarity under both tests, in addition to proving copying in fact,
20 *id.*, and the other elements of a *prima facie* case of infringement. See § 7.01 of this Restatement.

21 Over the decades, the Ninth Circuit has refined the nature of each of these two similarity
22 inquiries. Today, “[t]he extrinsic test assesses the objective similarities of the two works, focusing
23 only on the protectable elements of the plaintiff’s expression.” *Rentmeester*, 883 F.3d at 1118. In
24 the extrinsic test, the court first filters out the unprotectable elements of the plaintiff’s work. See,
25 e.g., *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822-823 (9th Cir. 2002) (noting the
26 unprotected elements include ideas and concepts, material in the public domain, and *scènes à faire*
27 elements). The court then compares the remaining protectable elements to corresponding elements
28 of the defendant’s work in assessing whether there are sufficient similarities “in the objective
29 details of the works.” *Rentmeester*, 883 F.3d at 1118. The Ninth Circuit has identified the extrinsic
30 test as one that can be decided by the court as a matter of law. *Id.*

1 In contrast to the extrinsic component, the Ninth Circuit’s test also requires “intrinsic
2 similarity,” which the court describes as requiring “similarity of expression from the standpoint of
3 the ordinary reasonable observer, with no expert assistance.” *Jada Toys, Inc. v. Mattel, Inc.*, 518
4 F.3d 628, 637 (9th Cir. 2008). The Ninth Circuit has articulated the intrinsic test as involving “a
5 more holistic, subjective comparison of the works to determine whether they are substantially
6 similar in ‘total concept and feel.’” *Rentmeester*, 883 F.3d at 1118 (quoting *Cavalier*, 297 F.3d at
7 822). The reference to “concept” should not be misunderstood as translating into protecting the
8 concept of a work, or concepts contained in a work, as the Copyright Act expressly prohibits
9 protection for “any idea, procedure, process, system, method of operation, *concept*, principle, or
10 discovery, regardless of the form in which it is described, explained, illustrated, or embodied in
11 [the copyrighted] work.” 17 U.S.C. § 102(b) (emphasis added); see § 14 of this Restatement.
12 Similarly, the reference to “feel” should not be misunderstood as translating into protection of the
13 style or general feel of a work, as such components are at a level of abstraction that is too far
14 removed from expression to be protected by the work’s copyright. See Comment *d*, discussing
15 abstractions. Rather, the attention to “total concept and feel” can best be understood as
16 acknowledging that copying of an original combination of elements can be actionable even if
17 copying of those elements in isolation would not be. See *Tufenkian*, 338 F.3d at 134 (noting that
18 “the total-concept-and-feel locution functions as a reminder that, while the infringement analysis
19 must *begin* by dissecting the copyrighted work into its component parts in order to clarify precisely
20 what is not original, infringement analysis is not *simply* a matter of ascertaining similarity between
21 components viewed in isolation.”) (emphasis in original).

22 The extrinsic and intrinsic tests as refined and employed by the Ninth Circuit today align
23 with other circuits’ approaches to analyzing improper appropriation by ensuring that only
24 protectable elements are considered as a basis for finding substantial similarity (encompassed
25 within the objective orientation of the extrinsic test), and engaging in a comparison of the
26 copyrighted work and the infringing use in context with careful consideration of protectable
27 elements that might exist in the selection and arrangement of unprotected elements (the more
28 holistic subjective comparison within the intrinsic test). Care should be taken with language from
29 earlier Ninth Circuit opinions concerning the nature of the extrinsic and intrinsic tests, as it may
30 not reflect the court’s current application of those tests.

1 Courts employing the dual extrinsic and intrinsic similarity tests may use them as a way to
2 dismiss the plaintiff's claim either at the pleading stage or at summary judgment, finding that the
3 works lack extrinsic similarity and the case must be decided against the plaintiff. See, e.g.,
4 *Rentmeester*, 883 F.3d 1111 (affirming the grant of defendant's motion to dismiss under Federal
5 Rule of Civil Procedure 12(b)(6) because of a lack of extrinsic similarity).

6 *k. Improper appropriation requires copying of substantial, non-de minimis protectable*
7 *expression.* Copyright law permits some copying of insignificant portions of protectable
8 expression from the plaintiff's work. "Even where the fact of copying is conceded, no legal
9 consequences will follow from that fact unless the copying is substantial." *Newton v. Diamond*,
10 388 F.3d 1189, 1193 (9th Cir. 2004). If the protected expression copied is de minimis, there cannot
11 be, as a matter of law, the substantial similarity necessary to establish improper appropriation. See
12 *Bell v. Wilmott Storage Servs., LLC*, 12 F.4th 1065 (9th Cir. 2021) ("'[A] taking is considered de
13 minimis only if it is so *meager* and *fragmentary* that the average audience member would not
14 recognize the appropriation,' i.e., the works could not be said to be substantially similar." (quoting
15 *Fisher v. Dees*, 794 F.2d 432, 434 n.2 (9th Cir. 1986) (emphasis in *Bell*)).

16 In determining whether copying of protected expression is de minimis, courts examine the
17 amount of the copyrighted work that is copied and the observability of the copied content in the
18 defendant's alleged infringing use. The Second Circuit has referred to a "quantitative threshold"
19 when considering whether the copying was de minimis. *Ringgold v. Black Ent. Television, Inc.*,
20 126 F.3d 70, 74 (2d Cir. 1997) ("de minimis can mean that copying has occurred to such a trivial
21 extent as to fall below the quantitative threshold of substantial similarity, which is always a
22 required element of actionable copying"). However, even if the quantity of protected expression
23 copied is small, if that expression is material and observable, the copying is not de minimis. *Dun
& Bradstreet Software Servs., Inc. v. Grace Consulting, Inc.*, 307 F.3d 197, 208 (3d Cir. 2002)
25 (discussing both the quantitative and qualitative materiality of the amount copied). See also *Harper
& Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985) (infringement affirmed based on
27 copying approximately 300 to 400 words from a 200,000-word book). Determining whether the
28 defendant's copying was de minimis will depend on the facts of the particular case. For example,
29 if the defendant's allegedly infringing use is in a motion picture, the analysis could involve
30 examining the length of time the plaintiff's copyrighted work is observable in the film, as well as
31 factors such as focus, lighting, camera angles, and prominence. See *Sandoval v. New Line Cinema*

1 Corp., 147 F.3d 215, 217 (2d Cir. 1998) (finding copying in movie of entire copyrighted
2 photographs to be de minimis; photographs “appear fleetingly and are obscured, severely out of
3 focus, and virtually unidentifiable”); see also Solid Oak Sketches, LLC v. 2K Games, Inc., 449 F.
4 Supp. 3d 333 (S.D.N.Y. 2020) (finding copying in video games of copyrighted tattoos on athletes’
5 arms to be de minimis; tattoos depicted were significantly reduced in size and image quality).

6 Demonstrating improper appropriation is a component of the *prima facie* case of
7 infringement applicable to all categories of protected works and all of the exclusive rights granted
8 to a copyright owner. Because the de minimis doctrine is typically considered in the context of
9 assessing whether a sufficient amount of protectable expression has been copied in order to
10 determine whether the plaintiff has proven improper appropriation, the doctrine is applicable to all
11 infringement cases. As discussed in § 56, Comment *g*, of this Restatement, this includes assertions
12 of infringement of sound-recording copyrights in a practice commonly known as “sampling.” See,
13 e.g., VMG Salsoul, LLC v. Ciccone, 824 F.3d 871, 884 (9th Cir. 2016). But see Bridgeport Music,
14 Inc. v. Dimension Films, 410 F.3d 792 (6th Cir. 2005).

15 Courts sometimes refer to the de minimis doctrine as a “defense.” See, e.g., Dun &
16 Bradstreet Software Servs., Inc. v. Grace Consulting, Inc., 307 F.3d 197, 208 (3d Cir. 2002). Given
17 that the doctrine is a component of analyzing whether the required substantial similarity has been
18 shown, the doctrine is best viewed as a legal rebuttal raised by the defendant to the plaintiff’s
19 required showing of substantial similarity, on which the plaintiff bears the burden of proof as part
20 of the *prima facie* case even when the defendant asserts that the copying was de minimis. See
21 Comment *f*. See also *Bell*, 12 F.4th at 1074 (“Our circuit and the majority of our sister circuits do
22 not view the de minimis doctrine as a defense to infringement, but rather as an answer to the
23 question of whether the infringing work and the copyrighted work are substantially similar so as
24 to make the copying actionable.”).

25 The Ninth Circuit has held that the de minimis doctrine can only be raised in the context
26 of substantial similarity and at no other time. *Bell*, 12 F.4th at 1068 (9th Cir. 2021) (“once
27 infringement is established, . . . de minimis use of the infringing work is not a defense to an
28 infringement action.”). However, the doctrine of *de minimis non curat lex* (the law cares not for
29 trifles), which denies a plaintiff relief for technical but trivial violations of the plaintiff’s rights, “is
30 part of the established background of legal principles,” *Wis. Dep’t. of Revenue v. William
31 Wrigley, Jr., Co.*, 505 U.S. 214, 231 (1992). The Second Circuit has recognized that in copyright

1 law, the de minimis doctrine can excuse trivial, everyday activities that might otherwise technically
 2 constitute infringement, and is an “important aspect of the law of copyright.” On Davis v. The
 3 Gap, Inc., 246 F.3d 152, 173 (2d Cir. 2001) (noting that “[m]ost honest citizens in the modern
 4 world frequently engage, without hesitation, in trivial copying that, but for the de minimis doctrine,
 5 would technically constitute a violation of law.”).

6 *l. Approaches to similarity when plaintiff’s work contains a significant proportion of
 7 unprotected elements.* When a work contains a significant proportion of public-domain or other
 8 unprotected elements, courts employ a variety of tools to ensure that a finding of improper
 9 appropriation is based upon only protected elements. One such tool, discussed in Comment *e*, is
 10 rigorous filtering or dissection. Another tool is use of the perspective of the “more discerning
 11 observer” to assess whether there is substantial similarity when the copyrighted work contains
 12 significant public-domain or other unprotected elements. See Comment *i*. The concern is that a
 13 mere “average” observer may be misled into finding similarities based on those unprotected
 14 elements when what is required is substantial similarity of protected expression.

15 Courts may also decide that the copyright in the plaintiff’s work is so “thin” that the standard
 16 to be employed in evaluating improper appropriation should be that of “virtual identity” rather than
 17 merely “substantial similarity.” When only a narrow range of original expression is possible,
 18 copyright protection is said to be “thin” because the copyrighted work contains few protectable
 19 features. Conversely, “the greater the range of creative choices that may be made, the broader the
 20 level of protection that will be afforded to the resulting” work. *Rentmeester*, 883 F.3d at 1120. Thin
 21 protection is common in works that have only a small amount of originality, including some
 22 compilations of facts or data, *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349 (1991);
 23 are depictions of the natural world, *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003); or are infused
 24 with unprotectable elements, such as architectural plans and computer programs. See, e.g., *Design*
 25 *Basics, LLC v. Kerstiens Homes & Designs, Inc.*, 1 F.4th 502, 503 (7th Cir. 2021) (architectural
 26 plans with many *scènes à faire* and merged elements); *Apple Computer, Inc. v. Microsoft Corp.*,
 27 35 F.3d 1435, 1439 (9th Cir. 1994) (computer software). Cf., e.g., *BUC Int’l Corp. v. Int’l Yacht*
 28 *Council Ltd.*, 489 F.3d 1129, 1148 (11th Cir. 2007) (noting that “[v]irtual identicity,” as adopted
 29 in this circuit, applies to ‘claims of compilation copyright infringement of nonliteral elements of a
 30 computer program.’” (quoting *Mitek Holdings, Inc. v. Arce Eng’g Co.*, 89 F.3d 1548, 1558 (11th
 31 Cir. 1996), but holding that the standard for compilations, generally, is substantial similarity).

1 All of these approaches reflect that the plaintiff's burden to demonstrate substantial
2 similarity is more difficult to carry when the copyrighted work contains only a minimal amount of
3 original expression. See, e.g., *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600,
4 606-607 (1st Cir. 1988) (quoting *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d
5 1157, 1167 (9th Cir. 1977) (explaining that when there are only a limited number of ways to
6 express an idea, "the burden of proof is heavy on the plaintiff who may have to show 'near identity'
7 between the works at issue.").

8 *m. Use of expert testimony in proving or disproving improper appropriation.* Courts have
9 permitted the use of expert witnesses on some aspects of the inquiry into improper appropriation
10 and have, in general, been more willing to allow the use of experts in cases involving works, such
11 as computer software, for which lay factfinders may struggle to assess whether the similarity in
12 elements protected by copyright crosses the line into improper appropriation. Courts have
13 expressed concern, however, that expert testimony could usurp the factfinder's role in the
14 determination of substantial similarity; this concern animates the approach used by courts in
15 determining for what purposes expert testimony is permissible.

16 The Second Circuit considered the use of experts in the copyright-infringement analysis in
17 *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946), a case involving alleged infringement of a musical
18 work in which the court articulated that the plaintiff had to prove "(a) that defendant copied from
19 plaintiff's copyrighted work and (b) that the copying (assuming it to be proved) went to [sic] far
20 as to constitute improper appropriation." Id. at 468. On the initial inquiry—i.e., proof that
21 defendant copied in fact from plaintiff's work—the *Arnstein* court permitted expert testimony:
22 "On this issue, analysis ('dissection') is relevant, and the testimony of experts may be received to
23 aid the trier of the facts." Id. See § 7.03, Comment 1, discussing the use of expert testimony in
24 proving copying in fact. On the second prong—i.e., proof that the copying is improper, the *Arnstein*
25 court held that "the test is the response of the ordinary lay hearer; accordingly, on that issue,
26 'dissection' and expert testimony are irrelevant." Id. While the Second Circuit held that expert
27 testimony concerning "dissection" was "irrelevant," the court nonetheless held that expert
28 testimony could play a narrow role in helping the factfinder understand how a lay audience would
29 perceive the similarities and differences between the plaintiff's and the defendant's works. The
30 *Arnstein* court stated that "[e]xpert testimony of musicians may also be received, but it will in no

1 way be controlling on the issue of illicit copying, and should be utilized only to assist in
2 determining the reactions of lay auditors.” Id. at 473.

3 When the work is addressed to a particular audience that could perceive the work
4 differently than an “ordinary observer” (for example, because that audience possesses specialized
5 expertise or because that audience is young children), courts have acknowledged that lay
6 factfinders may be aided in their evaluation of whether the relevant audience will perceive the
7 defendant’s use as substantially similar to the plaintiff’s copyrighted work by expert testimony on
8 “the tastes and perceptions of the intended audience.” Dawson v. Hinshaw Music Inc., 905 F.2d
9 731, 736 (4th Cir. 1990) (cautioning that “a court should be hesitant to find that the lay public does
10 not fairly represent a work’s intended audience”). See also T-Peg, Inc. v. Vt. Timber Works, Inc.,
11 459 F.3d 97, 116 (1st Cir. 2006) (recognizing that “the need for expert testimony may be greater
12 in cases involving complex subject matters where an ordinary observer may find it difficult to
13 properly evaluate the similarity of two works without the aid of expert testimony”).

14 Cases involving computer software are an example of when the courts have broadened the
15 role that experts may play in the improper-appropriation inquiry in light of the intended audience’s
16 specialized expertise. The court in Computer Associates International, Inc. v. Altai, Inc., 982 F.2d
17 693 (2d Cir. 1992), noted that the ordinary-observer standard “may well have served its purpose
18 when the material under scrutiny was limited to art forms readily comprehensible and generally
19 familiar to the average lay person,” but as to computer programs, district courts must have
20 “discretion . . . to decide to what extent, if any, expert opinion, regarding the highly technical
21 nature of computer programs, is warranted in a given case.” Id. at 713. In cases involving computer
22 programs, the Second Circuit held that “the trier of fact need not be limited by the strictures of its
23 own lay perspective.” Id. Other circuits have also allowed expert testimony concerning different
24 aspects of the improper-appropriation inquiry in cases involving computer software. See, e.g.,
25 Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 834-835 (10th Cir. 1993) (noting that
26 in most cases involving computer programs, expert testimony will be helpful to the court in
27 applying an abstractions test); Whelan Assocs., Inc. v. Jaslow Dental Lab’y, Inc., 797 F.2d 1222,
28 1233 (3d Cir. 1986) (holding that in “copyright cases involving exceptionally difficult materials,
29 like computer programs,” expert testimony would be admissible).

30 The Ninth Circuit and other circuits that have required proof of both extrinsic and intrinsic
31 similarity, see Comment *j*, allow expert evidence on the extrinsic part of that dual inquiry. Those

1 circuits explain that acceptance of expert evidence is appropriate because the extrinsic test requires
 2 “analytical dissection of a work,” *Williams v. Gaye*, 895 F.3d 1106, 1119 (9th Cir. 2018), and
 3 depends on objective criteria such as “the type of artwork involved, the materials used, the subject
 4 matter, and the setting for the subject,” *Rottlund Co. v. Pinnacle Corp.*, 452 F.3d 726, 731 (8th Cir.
 5 2006). The Ninth Circuit has gone so far as to suggest that expert testimony may be *necessary* in
 6 some cases for the plaintiff to carry its burden on the extrinsic test. *Williams*, 895 F.3d at 1137
 7 (stating that “we require parties to present expert testimony in musical infringement cases for a
 8 reason” after noting that it is “unrealistic to expect district courts to possess even a baseline fluency
 9 in musicology”). See also *Swirsky v. Carey*, 376 F.3d 841, 849 (9th Cir. 2004) (noting that the
 10 extrinsic test is met, “[s]o long as the plaintiff can demonstrate, through expert testimony that
 11 addresses some or all of [the constituent elements of a musical work] and supports its employment
 12 of them, that the similarity was ‘substantial’ and to ‘protected elements’ of the copyrighted work.”).

13 Courts that require proof of intrinsic similarity have declined to permit expert testimony,
 14 however, on the question of intrinsic similarity, because intrinsic similarity does not depend on the
 15 “type of external criteria and analysis which marks the extrinsic test.” *Rottlund*, 452 F.3d at 731.
 16 See also *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1164
 17 (9th Cir. 1977) (in intrinsic test, “analytic dissection and expert testimony are not appropriate.”).
 18 As discussed in Comment *j*, the intrinsic similarity requirement is focused, instead, on “similarity
 19 of expression from the standpoint of the ordinary reasonable observer, with no expert assistance.”
 20 *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 637 (9th Cir. 2008). Unlike circuits that do not use
 21 the dual requirement of extrinsic and intrinsic similarity, the Ninth Circuit has not yet clearly held
 22 that expert evidence can be used to aid the ordinary-observer analysis when a case involves
 23 computer software.

REPORTERS’ NOTES

24 *a. Generally.* The Second Circuit has long used the label “improper appropriation” for this
 25 element of the *prima facie* case of infringement. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir.
 26 1946) (cautioning not to confuse the “two separate elements essential to a plaintiff’s case . . . :
 27 (a) that defendant copied from plaintiff’s copyrighted work and (b) that the copying (assuming it
 28 to be proved) went too far as to constitute improper appropriation.”). The Third and Seventh
 29 Circuits also have adopted that label. See, e.g., *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 400
 30 F.3d 1007, 1011 (7th Cir. 2005); *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 208 (3d Cir.
 31 2005). At times, the Ninth Circuit has also discussed the need for the plaintiff to show “improper

1 appropriation,” albeit quoting Second Circuit case law. See, e.g., *Three Boys Music Corp. v.*
 2 *Bolton*, 212 F.3d 477, 482 (9th Cir. 2000) (quoting *Arnstein*).

3 Determining whether copying is “improper” could be aided by a fuller evaluation of the
 4 context of the use and the type of copyrighted work allegedly infringed. Instead, this fuller
 5 contextual consideration often takes place in the analysis of a fair-use defense. Prior to the
 6 solidification of fair use as an affirmative defense, fair use was considered to be a doctrine relevant
 7 to a determination of whether the plaintiff had established a *prima facie* case of infringement.
 8 Indeed, in the *Nichols* case itself, the case that is the source of the “abstractions test” discussed in
 9 Comment *d*, the court states that in the context of less than full copying of the verbatim of an entire
 10 work “[t]he question is whether the part so taken is ‘substantial,’ and therefore not a ‘fair use’ of
 11 the copyrighted work” *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

12 Courts have identified the problematic labeling of the different uses of “similarities” in the
 13 various articulations of the infringement test. See, e.g., *Laureyssens v. Idea Grp., Inc.*, 964 F.2d
 14 131, 140 (2d Cir. 1992) (“The presence of a ‘substantial similarity’ requirement in both prongs of
 15 the analysis—actual copying and whether the copying constitutes an improper appropriation—
 16 creates the potential for unnecessary confusion”).

17 Several circuits articulate a clear two-step test for evaluating substantial similarity: “the
 18 first step ‘requires identifying which aspects of the artist’s work, if any, are protectible by
 19 copyright,’ [and] the second ‘involves determining whether the allegedly infringing work is
 20 ‘substantially similar’ to protectible elements of the artist’s work.’” *Kohus v. Mariol*, 328 F.3d
 21 848, 855 (6th Cir. 2003) (quoting *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1295 (D.C.
 22 Cir. 2002)); see also *Boisson v. Banian, Ltd.*, 273 F.3d 262, 267-268 (2d Cir. 2001); *Concrete
 23 Mach. Co., v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606 (1st Cir. 1988). The Sixth Circuit,
 24 which has adopted this approach, describes it as “really just a refinement of the ordinary observer
 25 test that, as its initial step, parses from the work the elements neither afforded copyright protection
 26 nor properly considered in the ordinary observer test.” *Stromback v. New Line Cinema*, 384 F.3d
 27 283, 294 (6th Cir. 2004).

28 Other cases noting the difficulty of determining when the similarities are substantial include
 29 *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 63 (2d Cir. 2010) and *Warner
 30 Bros, Inc. v. Am. Broad. Cos.*, 654 F.2d 204, 208 (2d Cir. 1981). See generally Clark Asay, *An
 31 Empirical Study of Copyright’s Substantial Similarity Test*, 13 U.C. IRVINE L. REV. 35 (2022).

32 *b. Complete duplication of the entire copyrighted work.* As one commentator has put it,
 33 “[i]f such duplication is literal or verbatim, then clearly substantial similarity exists.” MELVILLE
 34 B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 13.03[A][1]. Interestingly, cases in
 35 which copying of an entire copyrighted work may not be sufficient involve claims that the
 36 appearance of the copyrighted work in the infringing use was merely *de minimis*. See, e.g., image
 37 quality issue: *Gottlieb Dev. LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625, 631 (S.D.N.Y.
 38 2008) (duplication in motion picture of copyrighted images on pinball machine found *de minimis*);
 39 *Ringgold v. Black Ent. Television, Inc.*, 126 F.3d 70, 75 (2d Cir. 1997) (duplication in audiovisual
 40 work of copyrighted image found to not be *de minimis*).

1 Illustration 1 is based on *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240
 2 (3d Cir. 1983). Illustration 2 is based on *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215 (2d
 3 Cir. 1998).

4 *c. Improper appropriation requires copying of protected expression.* In addition to the
 5 Sixth Circuit, the Eighth Circuit has also expressly noted that the proof of copying of protected
 6 expression is required by the U.S. Constitution. *Frye v. YMCA Camp Kitaki*, 617 F.3d 1005, 1008
 7 (8th Cir. 2010).

8 *d. Levels of abstractions in the context of evaluating claims of infringement of nonliteral
 9 elements of a work.* The Tenth Circuit has further noted that “the abstraction test does not identify
 10 the protectable elements of a program. Rather, it is merely one tool that can be utilized to
 11 accomplish this task. Abstraction is particularly useful in enabling a court to filter out ideas and
 12 processes from protectable expression.” *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d
 13 823, 834 (10th Cir. 1993).

14 *e. Filtering out unprotected elements.* In *Brown Bag Software v. Symantec Corp.*, 960 F.2d
 15 1465, 1475-1476 (9th Cir. 1992), the Ninth Circuit described the dual role that dissection can play,
 16 first noting its role in “comparing similarities and identifying infringement” but also “for the
 17 purpose of defining the scope of plaintiff’s copyright.” It is important to note that courts sometimes
 18 invoke the concept of “dissection” in different and confusing ways. For example, in *Arnstein*, the
 19 Second Circuit indicated that “dissection” was appropriate in the context of analyzing what has
 20 come to be referred to as “copying in fact.” *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946). In that
 21 context, the Second Circuit used “dissection” to indicate the permissible use of experts. But in the
 22 context of improper appropriation, the court stated that “the test is the response of the ordinary lay
 23 hearer; accordingly, on that issue, ‘dissection’ and expert testimony are irrelevant.” *Id.* at 468.

24 *g. Merger in the context of the prima facie case of infringement.* For an example of a case
 25 analyzing merger in the context of deciding whether there is a valid copyright, and concluding that
 26 the asserted copyright was not valid, see *Pyrotechnics Mgmt., Inc. v. fireTEK*, 2022 WL 138060
 27 (W.D. Pa. Jan. 14, 2022).

28 The Second Circuit also has noted that a leading treatise on copyright law viewed treating
 29 merger in the context of whether actionable infringement has occurred as “the better view.” *Kregos
 30 v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991) (citing NIMMER ON COPYRIGHT
 31 § 13.03[B][3], at 13–58 (1990)).

32 Labeling the merger argument a “defense,” however, does not mean that the defendant
 33 carries the burden of proof. The defendant must effectively present the merger argument, but the
 34 nature of that defense is a rebuttal to the evidence offered by the plaintiff to prove the required
 35 element in the *prima facie* case that the defendant has copied protected expression from the
 36 copyrighted work. If the court concludes that the defendant’s merger argument is correct, then the
 37 plaintiff has failed to carry the plaintiff’s burden of proving copying of protected expression, at
 38 least as to the material that the court concludes has merged with unprotected elements of the work.
 39 See § 7.01, Comment *f*, of this Restatement.

The Ninth Circuit has used the label “defense” to apply to the merger doctrine as a way to define the argument as one appropriately considered in the context of the “copying” component of an infringement action. *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000). The Ninth Circuit set up a dichotomy between: (1) merger being considered when analyzing copyrightability or (2) merger being more properly treated as a defense to infringement. *Ets-Hokin*, 225 F.3d at 1082. The court then cited, as support for the treatment of merger as a defense, case law that considered merger in the context of the second “copying” component of the *prima facie* case, rather than the first component that requires a valid, copyrighted work. *Id.* One case that the Ninth Circuit cites as supporting the treatment of merger as a defense is *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991). *Ets-Hokin*, 225 F.3d at 1082 (using “accord” as a signal for the citation and noting, parenthetically, that the case held “that the merger doctrine relates to infringement, not copyrightability”). The Second Circuit did not label merger as a defense, but, as noted by the Ninth Circuit, considered merger in the context of “determining whether actionable infringement ha[d] occurred.” *Kregos*, 937 F.2d at 705. That context is the improper-appropriation element of the *prima facie* case, and specifically the comparison of the expression that the defendant is alleged to have copied with the expression contained in the copyrighted work. Because the plaintiff bears the burden of proof of establishing both copyrightability and copying, the defendant can raise defense arguments as to either of those elements. If the defendant asserts the merger argument in the context of copyrightability, that would also be a defense. Thus, considering merger in either prong of the *prima facie* case (copyrightability or copying) are defense arguments, both would be examples of the defendant rebutting plaintiff’s *prima facie* case. See § 7.01, Comment e, of this Restatement.

Decisions in the First and Fifth Circuits indicate that merger can be considered in the copyrightability component of the analysis. In 1992, the Fifth Circuit noted that it had applied merger at least once before to determine that the plaintiff’s work did not have a valid copyright. *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 138 n.5 (5th Cir. 1992) (“[B]ecause the idea and its expression embodied in plaintiff’s maps are inseparable, ‘the maps at issue are not copyrightable.’”) (citing *Kern River Gas Transmission Co. v. Coastal Corp.*, 899 F.2d 1458, 1460 (5th Cir. 1990)); see also *Veeck v. S. Bldg. Code Cong. Int’l Inc.*, 241 F.3d 398, 407 (5th Cir. 2001) (“In this circuit, the merger doctrine has been applied to the question whether a work was copyrightable at the time of its creation, preventing a copyright from attaching in the first place, rather than as an infringement defense focusing on merger at the time of copying.”); *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 35 (1st Cir. 2001); *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678 (1st Cir. 1967). That case law, however, does not definitely hold that merger is not also an appropriate consideration in the context of the “copying” prong of the *prima facie* case.

Many cases, including ones from both the First and Fifth Circuits, analyze merger arguments in the context of the “copying” prong of the infringement analysis. See, e.g., *Yankee Candle Co.*, 259 F.3d at 36; *Eng’g Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1345 (5th Cir. 1994), opinion supplemented on denial of reh’g, 46 F.3d 408 (5th Cir. 1995). See also *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 836 (10th Cir. 1993) (applying merger

1 in the context of the “filtering” step in the “abstraction-filtration-comparison” procedure often
 2 employed in cases involving alleged infringement of nonliteral elements of computer software).

3 There are also other circuit-court opinions that discuss the defendant’s arguments
 4 concerning merger in the section of the opinion labeled “defenses.” See, e.g., John G. Danielson,
 5 Inc. v. Winchester-Conant Props., Inc., 322 F.3d 26, 42-43 (1st Cir. 2003). Those opinions do not
 6 contain any analysis or reflection on whether merger is a defense or who bears the burden of proof
 7 on the issue of merger.

8 Sometimes, courts are not specific on why merger results in a rejection of the plaintiff’s
 9 infringement claim: a failure to have a copyrighted work or a failure to demonstrate copying of
 10 protected expression. See Ellison Educ. Equip., Inc. v. Tekservices, Inc., 903 F. Supp. 1350, 1360
 11 (D. Neb. 1995) (“There are extremely limited ways in which to depict a candy cane and still be able
 12 to express the idea. Therefore, an attempt to copyright the expression of a candy cane is essentially
 13 an attempt to copyright the idea. Because plaintiff cannot appropriate the idea of a candy cane, the
 14 Court concludes that defendant has not engaged in copyright infringement of plaintiff’s design.”).

15 In *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 209 (3d Cir. 2005), the court
 16 articulated a burden-shifting component related to a defense argument concerning merger, stating
 17 that the plaintiff was “entitled to the opportunity to demonstrate” that the work at issue was not
 18 “the unavoidable expression of a common idea.”

19 In addition to the First Circuit case cited in Comment g, *Yankee Candle Co. v. Bridgewater*
 20 *Candle Co.*, 259 F.3d 25, 34 n.5 (1st Cir. 2001), cases that have indicated that expression that has
 21 merged with unprotectable elements can be the basis for a finding of infringement if there is
 22 identical copying can be found in the Ninth and Seventh Circuits. See, e.g., *Sid & Marty Krofft*
 23 *Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1168 (9th Cir. 1977) (“[w]hen idea
 24 and expression coincide, there will be protection against nothing other than identical copying of the
 25 work.”); see also *Frybarger v. IBM Corp.*, 812 F.2d 525, 530 (9th Cir. 1987); *Atari, Inc. v. N. Am.*
 26 *Philips Consumer Elecs. Corp.*, 672 F.2d 607, 616 (7th Cir. 1982) (“where idea and expression are
 27 indistinguishable, the copyright will protect against only identical copying”); *Reed-Union Corp. v.*
 28 *Turtle Wax, Inc.*, 77 F.3d 909, 914 (7th Cir. 1996); *Incredible Techs. v. Virtual Techs.*, 400 F.3d
 29 1007, 1014 (7th Cir. 2005). As noted in Comment g, those cases are problematic, given the
 30 Copyright Act’s command that “in no case” should copyright protection extend to unprotected
 31 elements. 17 U.S.C. § 102(b). However, more recent opinions in the First and Seventh Circuits
 32 reject comparison in the substantial-similarity analysis of elements of the copyrighted work that
 33 have merged with unprotectable elements, and instead require copying of protected elements, see
 34 *Design Basics, LLC v. Kerstiens Homes & Designs, Inc.*, 1 F.4th 502, 503 (7th Cir. 2021), or have
 35 expressly stated that “the merger doctrine will, where applicable, prevent copyright protection to a
 36 work.” *Soc’y of Holy Transfiguration Monastery, Inc. v. Gregory*, 689 F.3d 29, 53 (1st Cir. 2012).

37 Illustration 3 is based on *Thimbleberries, Inc. v. C & F Enterprises, Inc.*, 142 F. Supp. 2d
 38 1132, 1138 (D. Minn. 2001). “[A]s Thimbleberries easily demonstrates, the pattern which it seeks
 39 to protect represents only one of many ways to express a quilted wreath design. Thimbleberries’
 40 counsel presents by affidavit at least nine other wreath patterns for quilters, all of which markedly

1 differ from the Countryside Wreath not only in their arrangement of squares and triangles (and in
 2 other instances, octagons and rectangular bars), but also in the shape and design of the center
 3 opening and the presence, design and positioning of the bow and other decorative additions.”).

4 An example of a court analyzing whether there was any original expression in the selection,
 5 coordination, or arrangement of elements that had merged with unprotectable elements (and
 6 finding none) is *BellSouth Advertising and Publishing Corporation v. Donnelley Information
 7 Publishing, Inc.*, 999 F.2d 1436, 1444 (11th Cir. 1993) (“the elements of selection, coordination
 8 and arrangement identified by the district court, and purportedly copied by Donnelley, as a matter
 9 of law, do not display the originality required to merit copyright protection.”).

10 *h. The scènes à faire doctrine in the context of the prima facie case of infringement.* For
 11 examples of courts deciding that elements in a work were *scènes à faire* without additional
 12 evidence, see *Frye v. YMCA Camp Kitaki*, 617 F.3d 1005, 1008 (8th Cir. 2010) (referring to the
 13 elements as “required or at least standard to the plays’ shared hero-on-a-quest plot, medieval
 14 theme, and summer campfire setting” without reference to any specific examples); *Stromback v.
 15 New Line Cinema*, 384 F.3d 283, 296 (6th Cir. 2004) (referring to the elements of the work as
 16 “common themes and ideas throughout literature” without considering any specific evidence or
 17 examples in which those common themes and ideas occur); *Cavalier v. Random House, Inc.*, 297
 18 F.3d 815, 824 (9th Cir. 2002) (referring to the “general premise of a child, invited by a moon-type
 19 character, who takes a journey through the night sky and returns safely to bed to fall asleep” as a
 20 “basic plot idea” without consulting additional evidence from the parties); *Hoehling v. Universal
 21 City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980) (concluding that the “claimed similarities
 22 relate to random duplications of phrases and sequences of events” and are “merely scenes a faire”
 23 because it is “virtually impossible to write about a particular historical era or fictional theme
 24 without employing certain ‘stock’ or standard literary devices,” but not considering examples of
 25 those claimed similarities that occur elsewhere); *Warner Bros. Inc. v. Am. Broad. Cos., Inc.*, 654
 26 F.2d 204, 207 (2d Cir. 1981) (superheroes); *Whitehead v. Paramount Pictures Corp.*, 53 F. Supp.
 27 2d 38, 46-47 (D.D.C. 1999) (police-car chase scenes in action movies).

28 *i. Substantial similarity.* The articulation of the observer varies in the case law. See, e.g.,
 29 *Kay Berry, Inc. v. Taylor Gifts, Inc.* 421 F.3d 199, 208 (3d Cir. 2005) (“the fact-finder must
 30 decide . . . with the perspective of the ‘lay observer,’ whether the copying was ‘illicit,’ or ‘an
 31 unlawful appropriation’ of the copyrighted work”) (internal citation omitted); *Universal Athletic
 32 Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975) (discussing the response of “the ordinary lay
 33 person.”). Both the Second Circuit and the Eleventh Circuit commonly use the articulation of an
 34 “average lay observer.” See, e.g., *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d
 35 57, 66 (2d Cir. 2010) (quoting *Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F.3d 996, 1002 (2d Cir.
 36 1995)); *Oravec v. Sunny Isles Luxury Ventures, L.C.*, 527 F.3d 1218, 1224 (11th Cir. 2008)
 37 (quoting *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 829 (11th Cir. 1982)).

38 The average observer sometimes is described as the target audience for the works at issue.
 39 See, e.g., *Knitwaves*, 71 F.3d at 1005 (describing the view of the differences and similarities in
 40 fabric designs on sweaters as concerning “the average observer—or, more specifically, to the

average consumer of these sweaters"). Employing the perspective of the audience for the work can also be seen in cases that do not, necessarily, have specific characteristics. See, e.g., VMG SalSoul, LLC v. Ciccone, 824 F.3d 871, 874 (9th Cir. 2016) (gauging whether the "average audience" would recognize the appropriation, quoting Newton v. Diamond, 388 F.3d 1189, 1192 (9th Cir. 2004)). The idea of focusing on the lay audience because of the economic consequences can be seen in the seminal case of Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946), in which the court observed that even if there had been proof of copying in fact:

[T]hat is not enough; for there can be "permissible copying," copying which is not illicit. . . . The plaintiff's legally protected interest is . . . 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.

Id. at 472.

Cases using a more discerning observer test include *Boisson v. Banian, Ltd.*, 273 F.3d 262, 271 (2d Cir. 2001); *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 130 (2d Cir. 2003); *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 766 (2d Cir. 1991) ("since only some of the design enjoys copyright protection, the observer's inspection must be more discerning"). The Ninth Circuit has also noted that although "the Second Circuit's 'ordinary observer' and 'more discerning ordinary observer' tests differ somewhat from our two-part extrinsic/intrinsic test for substantial similarity, its reasoning, at least in the context of fabric designs, is persuasive, and it guides our comparison of the designs in this case." *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 850 (9th Cir. 2012). For a discussion of the extrinsic/intrinsic test, see Comment *j*.

Courts have acknowledged that what makes similarities sufficiently "substantial" varies from one case to the next. "We do not have a well-defined standard for assessing when similarity in selection and arrangement becomes 'substantial,' and in truth no hard-and-fast rule could be devised to guide determinations that will necessarily turn on the unique facts of each case." *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1121 (9th Cir. 2018). The First Circuit provided an interesting summary of potential considerations:

Slight or trivial variations between works will not preclude a finding of infringement under the ordinary observer test. The sine qua non of the ordinary observer test is the overall similarities rather than the minute differences between the two works. At times, the existence of only minor differences may itself suggest copying, indicating that the infringer attempted to avoid liability by contributing only trivial variations. This is not to suggest that an artist cannot avoid infringement by intentionally making substantial alterations in the design of a copyrighted work so as to provide a substantially different expression of the idea embodied in the copyrighted work. Yet, it is only when the points of dissimilarity not only exceed

the points of similarity, but indicate that the remaining points of similarity are (within the context of plaintiff's work) of minimal importance either quantitatively or qualitatively, that no infringement results.

Concrete Mach. Co. v. Classic Lawn Ornaments, Inc., 843 F.2d 600, 608 (1st Cir. 1988) (internal quotations, citations, and alterations omitted).

Comment *i* identifies that a substantial similarity may be found even if the defendant's work, as a whole, is not substantially similar to the plaintiff's copyrighted work, as a whole, if there has been sufficient verbatim or literal copying of parts of the plaintiff's work. The Nimmer treatise labels this "fragmented literal" similarity (for example, some but not all lines of dialogue copied from a play and used in a movie), as distinguished from another type of similarity, which it labels "comprehensive nonliteral" similarity (for example, detailed plot and characters copied from a book and used in a movie, without any copying of any of the actual text of the book). MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 13.03[A]. Some courts have quoted the Nimmer treatise for those labels. See, e.g., *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1372 (2d Cir. 1993); *Jacobsen v. Deseret Book Co.*, 287 F.3d 936, 943 (10th Cir. 2002) (noting that "[b]ecause '[n]o easy rule of thumb can be stated as to the quantum of fragmented literal similarity permitted without crossing the line of substantial similarity,' whether works are substantially similar is 'a classic jury question.'") (quoting *NIMMER ON COPYRIGHT* § 13.03[A][2]).

j. The intrinsic and extrinsic tests developed by the Ninth Circuit. The Fourth and Eighth Circuits have also, at times, employed the "intrinsic" and "extrinsic" tests. *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 435 (4th Cir. 2010) (citing *Lyons P'ship, L.P. v. Morris Costumes, Inc.*, 243 F.3d 789, 801 (4th Cir. 2001)); *Frye v. YMCA Camp Kitaki*, 617 F.3d 1005, 1008 (8th Cir. 2010) (citing *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120 (8th Cir. 1987)).

In *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1118 (9th Cir. 2018), Ninth Circuit stated that "only" the extrinsic test can be decided as a matter of law, and thus it is the only test relevant in ruling on a motion to dismiss for lack of improper appropriation. However, the case cited for that proposition, *McCulloch v. Albert E. Price, Inc.*, 823 F.2d 316, 319 (9th Cir. 1987), states that extrinsic similarity "may often be decided as a matter of law," and that "the intrinsic test 'is uniquely suited for determination by the trier of fact. . . .' (quoting *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1166 (9th Cir. 1977)))." *McCulloch* does not say that there can never be a case in which intrinsic similarity can be decided as a matter of law. *McCulloch*, 823 F.2d at 319. Additionally, the case that is the genesis of the extrinsic and intrinsic similarity tests states that the extrinsic test "may often be decided as a matter of law." *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977) (emphasis added).

Comment *j* cautions against reliance on earlier Ninth Circuit cases because those cases described the intrinsic test as examining similarity in the ideas of the two works, and the extrinsic test as examining similarity in their expression. See, e.g., *McCulloch v. Albert E. Price, Inc.*, 823 F.2d 316, 319 (9th Cir. 1987). A similarity in the idea of the copyrighted work and the idea of the

1 alleged infringing use is not, however, required for there to be improper appropriation. What is
 2 required is a similarity between the defendant's infringing use and the protected *expression* in the
 3 plaintiff's copyrighted work. The articulation of the extrinsic test as focused on the similarity of
 4 "ideas" stems from the case that birthed the extrinsic and intrinsic similarity tests, *Sid & Marty*
 5 *Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977). In that
 6 case, the court provided as an example of when there would not be a "similarity of ideas"—which
 7 it calls the objective test—a nude statue, which the court stated embodies the simple idea of "a
 8 plaster recreation of a nude human figure." *Id.* It then compared that to "[a] statue of a horse or a
 9 painting of a nude," which the court stated "would not embody this idea and therefore could not
 10 infringe." *Id.* While subsequent decisions initially repeated the description of the extrinsic test as
 11 involving an inquiry into the similarity of "ideas," see, e.g., *Litchfield v. Spielberg*, 736 F.2d 1352,
 12 1356 (9th Cir. 1984), later decisions dropped that language in favor of other language from the *Sid*
 13 & *Marty Krofft Television Prods.* decision that focused on the objective details of the works. That
 14 language explains the extrinsic test as focusing on "specific criteria which can be listed and
 15 analyzed. Such criteria include the type of artwork involved, the materials used, the subject matter,
 16 and the setting for the subject." *Sid & Marty Krofft Television Prods.*, 562 F.2d at 1164. See also
 17 *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 852 (9th Cir. 2012) (noting that as the
 18 court's "precedent has evolved, the extrinsic test considers the objective expressive similarities").
 19 Thus, the earlier articulations of the extrinsic test are confusing, potentially unhelpful, and not
 20 consistent with modern copyright-infringement analysis.

21 k. *Improper appropriation requires copying of substantial, non-de minimis amount of*
 22 *protectable expression.* The de minimis doctrine stems from the legal maxim *de minimis non curat*
 23 *lex*—"the law does not concern itself with trifles." *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th
 24 Cir. 2004). See also *Castle Rock Ent., Inc. v. Carol Publ'g Grp., Inc.*, 150 F.3d 132, 138 (2d Cir.
 25 1998) (citing *Ringgold v. Black Ent. Television, Inc.*, 126 F.3d 70, 75 (2d Cir. 1997)); *Tufenkian*
 26 *Import/Export Ventures, Inc. v. Einstein Moonjy, Inc.*, 338 F.3d 127, 131 (2d Cir. 2003) (quoting
 27 *Castle Rock Ent., Inc. v. Carol Publ'g Grp., Inc.*, 150 F.3d 132, 137-138 (2d Cir. 1998)); *Gottlieb*
 28 *Dev. LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625, 631 (S.D.N.Y. 2008). See *Warner*
 29 *Bros. Inc. v. Am. Broad. Cos., Inc.*, 720 F.2d 231, 242 (2d Cir. 1983).

30 The Ninth Circuit has discussed the application of the de minimis concept and has
 31 concluded that it "is properly used to analyze whether so little of a copyrighted work has been
 32 copied that the allegedly infringing work is not substantially similar to the copyrighted work and
 33 is thus non-infringing." *Bell*, 12 F.4th at 1068. The First Circuit has termed de minimis copying as
 34 "the converse of substantial similarity." *Mgmt. Sys., Inc. v. ASP. Consulting LLC*, 560 F.3d 53,
 35 59 (1st Cir. 2009). This description of de minimis copying as the "converse" of substantial
 36 similarity could lead one to believe that so long as the copying is more than de minimis, the
 37 copying must be sufficiently substantial. This, however, is not correct. Copying that is more than
 38 de minimis can, nonetheless, not be enough for there to be substantial similarity.

39 In describing the standard for determining what amount of copying qualifies as de minimis,
 40 in *Bell v. Wilmott Storage Services*, the Ninth Circuit quoted from *Fisher v. Dees*, 794 F.2d 432

(9th Cir. 1986): “a taking is considered de minimis only if it is so *meager* and *fragmentary* that the average audience member would not recognize the appropriation.” *Bell*, 12 F.4th 1074-1075 (emphasis in *Bell*). Then it added its own interpretation: “i.e., the works could not be said to be substantially similar.” Id. Other courts have not used the standard of “recognizable” to test for de minimis, and have found uses to qualify as de minimis even when the plaintiff’s work is clearly, albeit fleetingly, recognizable. See, e.g., *Gottlieb Dev. LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625, 631 (S.D.N.Y. 2008). Additionally, what is required to satisfy the improper-appropriation element of the *prima facie* case of infringement is “a substantial similarity,” articulated in subsection (a) of the black letter of this Section. While that substantial similarity can be between the defendant’s work and the plaintiff’s copyrighted work as a whole, as noted in Comment *i*, a substantial similarity can also be shown on the basis of literal or verbatim copying of a substantial amount of protected material, but of less than the whole work.

In order to meet the required substantial similarity, the Second Circuit has also stated that there must be copying that is both quantitatively and qualitatively sufficient to support the legal conclusion of actionable copying. See *Castle Rock Ent., Inc. v. Carol Pub. Grp., Inc.*, 150 F.3d 132, 138 (2d Cir. 1998) (quoting *Ringgold v. Black Ent. Television, Inc.*, 126 F.3d 70, 75 (2d Cir. 1997)). This articulation can be viewed as a different way to state that the copying must be of protectable expression (the qualitative component) and the copying must involve more than de minimis amount of material (the quantitative component). See *id.* The Second Circuit often uses the quantitative/qualitative formulation in the context of discussing a claim of de minimis copying. It should not be taken to mean that copying of protected expression of more than a de minimis amount is sufficiently substantial to constitute improper appropriation.

For cases discussing the de minimis doctrine in the context of allegations of infringement of copyrighted computer software, see *Situation Mgmt. Sys., Inc. v. ASP. Consulting LLC*, 560 F.3d 53, 59 (1st Cir. 2009) (noting that “de minimis copying is best viewed not as a separate defense to copyright infringement but rather as a statement regarding the strength of the plaintiff’s proof of substantial similarity.”); *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 715 (2d Cir. 1992) (affirming the district court’s ruling that copied, copyrightable elements of a computer program were de minimis).

In the *Sandoval* case, the Second Circuit stated that: “To establish that the infringement of a copyright is de minimis, and therefore not actionable, the alleged infringer must demonstrate that the copying of the protected material is so trivial ‘as to fall below the quantitative threshold of substantial similarity, which is always a required element of actionable copying.’” *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 217 (2d Cir. 1998) (quoting *Ringgold*, 126 F.3d at 74). While this appears to place the burden of proof on the defendant, the case involved an appeal from the grant of the defendant’s motion for summary judgment. In that context, the defendant was seeking to negate the plaintiff’s infringement case.

There are many examples of courts applying the de minimis doctrine in the context of analyzing whether there is the required substantial similarity to support a finding of infringement, and often using the phrase “de minimis copying.” See, e.g., *id.*; *Situation Mgmt. Sys., Inc.*, 560

1 F.3d at 59. Comment *k* notes that while in *Bell* the Ninth Circuit expressly confined the de minimis
 2 doctrine in copyright law to the context of the substantial-similarity inquiry, the general legal
 3 principle of *de minimis non curat lex* (“the law cares not for trifles”) may be applicable in other
 4 contexts. In reaching its conclusion in *Bell*, the Ninth Circuit discussed several opinions from other
 5 circuits in which those courts analyzed assertions that the copying was de minimis in the context
 6 of determining whether a substantial similarity had been shown. *Bell*, 12 F.4th at 1076-1077.
 7 However, none of those cases exclude the possibility that the general legal principle of *de minimis*
 8 *non curat lex*, as opposed to a doctrine of “de minimis copying,” could be applicable to other types
 9 of trivial copying, and the Second Circuit has endorsed that possibility:

10 The de minimis doctrine is rarely discussed in copyright opinions because
 11 suits are rarely brought over trivial instances of copying. Nonetheless, it is an
 12 important aspect of the law of copyright. Trivial copying is a significant part of
 13 modern life. Most honest citizens in the modern world frequently engage, without
 14 hesitation, in trivial copying that, but for the de minimis doctrine, would technically
 15 constitute a violation of law. We do not hesitate to make a photocopy of a letter
 16 from a friend to show to another friend, or of a favorite cartoon to post on the
 17 refrigerator. Parents in Central Park photograph their children perched on José de
 18 Creeft’s Alice in Wonderland sculpture. We record television programs aired while
 19 we are out, so as to watch them at a more convenient hour. Waiters at a restaurant
 20 sing “Happy Birthday” at a patron’s table. When we do such things, it is not that
 21 we are breaking the law but unlikely to be sued given the high cost of litigation.
 22 Because of the de minimis doctrine, in trivial instances of copying, we are in fact
 23 not breaking the law. If a copyright owner were to sue the makers of trivial copies,
 24 judgment would be for the defendants. The case would be dismissed because trivial
 25 copying is not an infringement.

26 On *Davis v. The Gap, Inc.*, 246 F.3d 152, 173 (2d Cir. 2001). See also *Ringgold v. Black Ent.*
 27 *Television, Inc.*, 126 F.3d 70, 74 (2d Cir. 1997) (acknowledging that “de minimis in the copyright
 28 context can mean what it means in most legal contexts: a technical violation of a right so trivial
 29 that the law will not impose legal consequences”); *Knickerbocker Toy Co. v. Azrak–Hamway*
 30 *Int’l, Inc.*, 668 F.2d 699, 703 (2d Cir. 1982) (denying relief under de minimis doctrine when
 31 defendant had made a copy of plaintiff’s work, but copy was never used).

32 The *Wisconsin Department of Revenue* decision, quoted in Comment *k*, did not involve a
 33 claim of copyright infringement, but rather involved a state taxing statute, which, like the
 34 Copyright Act, did not have a statutory exception for de minimis violations. *Wisconsin Dep’t of*
 35 *Revenue v. William Wrigley, Jr., Co.*, 505 U.S. 214, 231 (1992). In that case, the U.S. Supreme
 36 Court rejected the argument that the general de minimis principle cannot be applied when a statute
 37 does not contain an express, de minimis exception.

38 *I. Approaches to similarity when plaintiff’s work contains a significant proportion of*
 39 *unprotected elements.* See *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 908 (3d Cir.

1 1975) (“[B]etween the extremes of conceded creativity and independent efforts amounting to no
 2 more than the trivial, the test of appropriation necessarily varies.”).

3 Many Circuits have noted that when the copyrighted work involves only a minimal amount
 4 of protected expression, the plaintiff’s burden of proving improper appropriation is a heavy one.
 5 For example, in *Kay Berry, Inc. v. Taylor Gifts, Inc.* 421 F.3d 199, 209 (3d Cir. 2005), the Third
 6 Circuit articulated that heavy burden, quoting from a First Circuit opinion (*Concrete Mach. Co. v.*
 7 *Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606-607 (1st Cir. 1988)) that, in turn, quoted from a
 8 Ninth Circuit opinion (*Sid & Marty Krofft Television v. McDonald’s Corp.*, 562 F.2d 1157, 1167
 9 (9th Cir. 1977)). See also *First Am. Artificial Flowers, Inc. v. Joseph Markovits, Inc.*, 342 F. Supp.
 10 178, 186 (S.D.N.Y. 1972) (“[A] copyright on a work which bears practically a photographic
 11 likeness to the natural article . . . is likely to prove a relatively weak copyright. This is not to say
 12 that, as a matter of law, infringement of such a copyright cannot be inferred from mere similarity
 13 of appearance, but only that the plaintiff’s burden will be that much more difficult to sustain
 14 because of the intrinsic similarities of the copyrighted and accused works.”).

15 In a concurring opinion, Judge Watford went so far as to state that the “substantial-
 16 similarity framework applies only to works with broad copyright protection, while the virtual-
 17 identity standard governs thin copyrights.” *Skidmore*, 952 F.3d at 1080 (Watford, J., concurring).

18 *m. Use of expert testimony in proving or disproving improper appropriation.* In the *Dawson*
 19 case cited in Comment *m*, the Fourth Circuit explained the need for experts in certain cases:

20 [A] district court must consider the nature of the intended audience of the plaintiff’s
 21 work. If, as will most often be the case, the lay public fairly represents the intended
 22 audience, the court should apply the lay observer formulation of the ordinary
 23 observer test. However, if the intended audience is more narrow in that it possesses
 24 specialized expertise, relevant to the purchasing decision, that lay people would
 25 lack, the court’s inquiry should focus on whether a member of the intended
 26 audience would find the two works to be substantially similar. Such an inquiry may
 27 include, and no doubt in many cases will require, admission of testimony from
 28 members of the intended audience or, possibly, from those who possess expertise
 29 with reference to the tastes and perceptions of the intended audience.

30 *Dawson v. Hinshaw Music Inc.*, 905 F.2d 731, 736 (4th Cir. 1990). In addition to the Ninth Circuit,
 31 the First Circuit has noted the routine use of experts in cases involving musical works. *Johnson v.*
 32 *Gordon*, 409 F.3d 12, 18 (1st Cir. 2005).

33 The D.C. Circuit has also noted “[a] growing number of courts now permit expert
 34 testimony regarding substantial similarity in cases involving computer programs, reasoning that
 35 such testimony is needed due to the complexity and unfamiliarity of computer programs to most
 36 members of the public” *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1300-1301 (D.C.
 37 Cir. 2002).

38 Additional opinions articulating the prohibition on using expert testimony on the intrinsic-
 39 similarity analysis because the intrinsic test examines the works for similarity of expression from
 40 the standpoint of the ordinary, reasonable observer, with no expert assistance, include *Skidmore*

1 as Tr. for Randy Craig Wolfe Tr. v. Led Zeppelin, 952 F.3d 1051, 1064 (9th Cir. 2020); Jada Toys,
2 Inc. v. Mattel, Inc., 518 F.3d 628, 637 (9th Cir. 2008); Apple Comput., Inc. v. Microsoft Corp., 35
3 F.3d 1435, 1442 (9th Cir. 1994); Funky Films, Inc. v. Time Warner Ent. Co., L.P. 462 F.3d 1072,] 1077
4 (9th Cir. 2006); Olson v. Nat'l Broad. Co., Inc., 855 F.2d 1446, 1448-1449 (9th Cir. 1988).

5 In an early Ninth Circuit case involving computer software, Judge Snead suggested that
6 expert testimony should be allowed to aid juries in assessing intrinsic similarities in computer
7 programs. Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1478 (9th Cir. 1992) (Sneed,
8 J., concurring). The Ninth Circuit has also permitted the use of a court-appointed expert special
9 master in a case involving computer software. See Johnson Controls, Inc. v. Phoenix Control Sys.,
10 Inc., 886 F.2d 1173, 1176 (9th Cir. 1989). The Ninth Circuit more recently has held in a computer-
11 software case that expert opinion alone cannot be used to satisfy the “burden of proof production
12 under the intrinsic test.” Antonick v. Elec. Arts, Inc., 841 F.3d 1062, 1067 (9th Cir. 2016). In
13 *Antonick*, the court distinguished the case at bar from another Ninth Circuit opinion “holding
14 expert testimony admissible in a case in which the relevant works themselves were in
15 evidence” Id. at n.4 (citing Lucky Break Wishbone Corp. v. Sears Roebuck & Co., 373 F.
16 App’x 752, 755-756 (9th Cir. 2010)). In a footnote in *Antonick*, the Ninth Circuit also noted the
17 plaintiff’s argument that “experts should be allowed to help juries assess the holistic similarity of
18 technical works such as computer programs,” but the court concluded that, given circuit precedent
19 barring expert testimony to aid in the intrinsic analysis, the defendant’s argument “must be
20 addressed to an en banc court.” *Antonick*, 841 F.3d 1062, 1067 n.4.

1 **§ 7.07. Violation of the Attribution and Integrity Rights Granted to Author of a Statutory
2 Work of Visual Art**

3 **(a) To prove a claim of a violation of any of the author's rights of attribution or rights
4 of integrity, a plaintiff must demonstrate that:**

5 **(1) he or she is an author of the work, and**

6 **(2) the work is a “work of visual art.”**

7 **Depending on the nature of the claim, the plaintiff must also prove the elements set
8 forth in subsection (b), (c), or (d).**

9 **(b) To prove a claim of violation of an author's right of attribution, the author of a
10 “work of visual art” must demonstrate that the defendant:**

11 **(1) prevented the author from claiming authorship of a “work of visual art”;**

12 **(2) used the author's name as the author of a “work of visual art” that the
13 author did not create; or**

14 **(3) used the author's name as the author of a “work of visual art” when the
15 work has been distorted, mutilated, or otherwise modified in a manner that is
16 prejudicial to the author's honor or reputation.**

17 **(c) To prove a claim of violation of an author's integrity right against modification of
18 a “work of visual art,” the author of the work must demonstrate that the defendant
19 (1) intentionally (2) distorted, mutilated, or otherwise modified the work (3) in a way that is
20 prejudicial to the author's honor or reputation.**

21 **(d) An author seeking an injunction to prevent destruction of a “work of visual art”
22 must prove that the work is of recognized stature. An author seeking damages for an act of
23 destruction that has already occurred must further show that the defendant (1) destroyed
24 such a work (2) intentionally or through gross negligence.**

25 **Source Note:**

26 17 U.S.C. §§ 101, 106A, 113(d), 411, 412, 501, 502, 504, and 505.

27 **Comment:**

28 *a. Generally.* Section 6.11 of this Restatement discusses the five distinct rights protected
29 under 17 U.S.C. § 106A, the first three of which are commonly grouped under the label “right of
30 attribution,” and the last two under the label “right of integrity.” Because these rights are only

1 granted to authors, and extend only to works that meet the statutory definition of a “work of visual
2 art,” 17 U.S.C. §§ 101 and 106A, subsection (a) of the black letter of this Section states that to
3 prevail on a claim that any of those rights were violated, the plaintiff must first establish that (1) he
4 or she is the author (2) of a “work of visual art.” See H.R. Rep. No. 101-514 (1990), reprinted as
5 1990 U.S.C.C.A.N. 6915, 6923 (“Consistent with the general rule that the plaintiff has the burden
6 of establishing the basic elements of a cause of action, the author ordinarily has the burden of
7 showing that the particular work falls within the definition set forth in the bill.”).

8 The statutory definition of what constitutes a “work of visual art” is discussed in § 6.11,
9 Comment *b*, of this Restatement. Because the definition of “work of visual art” excludes works
10 made for hire, subsection (a) of the black letter of this Section uses “he or she” to signal that the
11 author must be a human individual. See also § 6, Comment *c*, of this Restatement (discussing the
12 exclusion of nonhumans from authorship status under the Copyright Act).

13 As in § 6.11, this Section uses the term “statutory work of visual art” to signal that only a
14 subset of the items that might ordinarily be labeled as works of visual art are protected under the
15 Visual Artists Rights Act of 1990, Pub. L. No. 101-650, 104 Stat. 5089, 5128 (VARA). As
16 indicated in § 6.11(b), and discussed in § 6.11, Comment *g*, of this Restatement, the rights granted
17 to authors of statutory works of visual art are not transferable (although they may be waived). 17
18 U.S.C. § 106A(e). Thus, generally only authors can be in a position to assert violations of 17
19 U.S.C. § 106A.

20 Subsection (b) of the black letter of this Section sets out the additional elements that a
21 plaintiff must demonstrate to prevail on a claim for violation of one of the three distinct rights of
22 attribution granted in 17 U.S.C. § 106A(a)(1)(A), (a)(1)(B), and (a)(2). “Prevented the author from
23 claiming authorship of a ‘work of visual art’” in subsection (b)(1) of the black letter reflects the
24 statutory provision that grants the right “to claim authorship of that work,” 17 U.S.C.
25 § 106A(a)(1)(A). For example, removing the name of an author who has claimed authorship of a
26 statutory work of visual art by putting their name on such a work would amount to preventing the
27 author from claiming authorship. The formulation “used the author’s name as the author of a ‘work
28 of visual art’ that the author did not create” in subsection (b)(2) of the black letter reflects the
29 statutory provision contained in 17 U.S.C. § 106A(a)(1)(B). The formulation “used the author’s
30 name as the author of a ‘work of visual art’ when the work has been distorted, mutilated, or

1 otherwise modified in a manner that is prejudicial to the author's honor or reputation" in subsection
2 (b)(3) of the black letter reflects the statutory provision contained in 17 U.S.C. § 106A(a)(2).

3 Subsections (c) and (d) of the black letter of this Section set out the additional elements
4 that a plaintiff must demonstrate to prevail on a claim for violation of one of the two distinct rights
5 of integrity. Specifically, subsection (c) of the black letter reflects the statutory provision granting
6 integrity rights against intentional distortion, mutilation, or modification of a statutory work of
7 visual art, 17 U.S.C. § 106A(a)(3)(A), and explains that the plaintiff must establish that the
8 defendant (1) intentionally (2) distorted, mutilated, or otherwise modified the work (3) in a way
9 that is prejudicial to the author's honor or reputation.

10 Subsection (d) of the black letter reflects the statutory provision granting integrity rights
11 against destruction of works of recognized stature, 17 U.S.C. § 106A(a)(3)(B), and explains that a
12 plaintiff bringing a claim to prevent a destruction from occurring must establish that the statutory
13 work of visual art is of recognized stature, as discussed in § 6.11, Comment *e*, of this Restatement.
14 Subsection (d) of the black letter also reflects the statute's further requirements (in addition to
15 recognized stature) for a claim based on an alleged destruction that has already occurred that the
16 plaintiff must show that the defendant (1) destroyed the work (2) intentionally or through gross
17 negligence.

18 *b. Burdens of proof.* Although the statute sets forth the elements required to establish a
19 violation of any of the rights granted in 17 U.S.C. § 106A, it does not expressly identify the burden
20 of proof on those elements. The legislative history indicates that Congress intended for the plaintiff
21 to bear the burden of establishing those elements: "Consistent with the general rule that the plaintiff
22 has the burden of establishing the basic elements of a cause of action, the author ordinarily has the
23 burden of showing that the particular work falls within the definition set forth in the bill." H.R.
24 Rep. No. 101-54, at 13. With respect to establishing, for example, that the work involved in the
25 case is a "work of visual art," Congress explained that "a photographer will have the burden of
26 showing that a photographic image is produced for exhibition purposes," as required by the
27 statutory definition, and "a printmaker who creates a limited edition must show that the edition
28 consists of 200 or fewer copies," as statutorily required. *Id.*

29 *c. Prejudice to honor or reputation.* Prejudice to honor and reputation is relevant to claims
30 under both the rights of attribution and integrity. To prevail on a claim for a violation of the right
31 described in subsection (b)(3) of the black letter of this Section, a plaintiff must demonstrate that

1 the defendant used the author's name as the author of a statutory work of visual art when the work
2 has been distorted, mutilated, or otherwise modified in a manner that is prejudicial to the author's
3 honor or reputation. To prevail on a claim of violation of the right described in subsection (c) of
4 the black letter, the plaintiff must demonstrate that the defendant intentionally distorted, mutilated,
5 or otherwise modified the work in a manner that is prejudicial to the author's honor or reputation.
6 17 U.S.C. § 106A(a).

7 There are two potential ambiguities in the statutory text as to exactly when the need for the
8 plaintiff to demonstrate prejudice to his or her honor or reputation arises. The first is that the
9 statutory language "distortion, mutilation, or other modification" of the work "which would be
10 prejudicial to [the author's] honor or reputation" is arguably grammatically unclear as to whether
11 the requisite prejudice applies only to a "modification" or also to any "distortion" or "mutilation."
12 After considering the legislative history, the First Circuit concluded that the "prejudice" requisite
13 applied to all three acts, so that distortion or mutilation of a work of visual art would be actionable
14 only if it would cause such prejudice. *Mass. Museum of Contemp. Art Found., Inc. v. Büchel*, 593
15 F.3d 38, 53 (1st Cir. 2010). The court found that this interpretation was in keeping with the
16 language of the Berne Convention for the Protection of Literary and Artistic Works, the text of
17 which informed the adoption of 17 U.S.C. § 106A. See § 6.11, Comment *a*, of this Restatement.

18 The second ambiguity in the statutory text concerns 17 U.S.C. § 106A(a)(3)(A)—stating
19 that "any intentional distortion, mutilation, or modification of th[e] work is a violation" does not
20 "explicitly require a showing of prejudice when the alteration already has occurred and damages,
21 rather than injunctive relief, would be the appropriate remedy." *Mass. Museum*, 593 F.3d at 53.
22 The First Circuit concluded that the prejudice requirement applied to both injunctive relief and
23 claims for damages. See *Mass. Museum*, 593 F.3d at 54 ("Given the stated purpose of the
24 legislation and the similar depiction of the integrity right in the Berne Convention, we conclude
25 that Congress intended the prejudice requirement to apply to the right of integrity whether the
26 remedy sought is injunctive relief or damages.").

27 Turning to the nature of the prejudice that a plaintiff must demonstrate, the legislative
28 history suggests that the inquiry should "focus on the artistic or professional honor or reputation
29 of the individual as embodied in the work that is protected," and "examine the way in which a
30 work has been modified and the professional reputation of the author of the work." H.R. Rep. No.
31 101-514, at 15, as reprinted in 1990 U.S.C.C.A.N. at 6925-6926 (footnotes omitted). In practice,

1 this means determining “whether such alteration would cause injury or damage to plaintiffs’ good
 2 name, public esteem, or reputation in the artistic community.” *Carter v. Helmsley-Spear, Inc.*, 861
 3 F. Supp. 303, 323 (S.D.N.Y. 1994), aff’d in part, vacated in part, rev’d in part, 71 F.3d 77 (2d Cir.
 4 1995). The plaintiff need not be well known or have preexisting standing in the community to
 5 claim harm to his or her reputation. See *id.* See also § 6.11, Comment *f*, of this Restatement,
 6 discussing the meaning of “prejudice to honor or reputation.”

7 *d. Intentional distortion, mutilation, or modification, and intentional or grossly negligent
 8 destruction.* The author has the right to “to prevent any intentional distortion, mutilation, or other
 9 modification of that work which would be prejudicial to his or her honor or reputation, and any
 10 intentional distortion, mutilation, or modification of that work.” 17 U.S.C. § 106A(a)(3)(A).
 11 Congress explained in the legislative history that:

12 [T]he right of integrity extends only to [. . .] acts or omissions [. . .] committed with
 13 respect to the work at issue. Thus, for example, while an author may assert the right
 14 where his or her work is destroyed in a fire caused for the purpose of collecting
 15 insurance on the work, the author may not assert the right where the fire is caused
 16 by someone accidentally forgetting to turn off a coffee pot.

17 H.R. Rep. No. 101-514, at 6926. Because the defendant’s state of mind is a statutory requirement,
 18 establishing the required mental state is an element of the plaintiff’s *prima facie* case.

19 In contrast to the statutory language of 17 U.S.C. § 106A(a)(3)(A), the language of 17
 20 U.S.C. § 106A(a)(3)(B) states that an author has the right “to prevent any destruction of a work of
 21 recognized stature, and any intentional or grossly negligent destruction” of such a work “is a
 22 violation of that right.” Because the language of 17 U.S.C. § 106A(a)(3)(B) states that the author
 23 has the right to “prevent any destruction of a work of recognized stature,” but then states that only
 24 an “intentional or grossly negligent destruction” is a “violation” of that right, the First Circuit has
 25 interpreted that provision to mean that while an author can sue for damages for the destruction of
 26 a work of recognized stature only if the destruction was intentional or grossly negligent, the author
 27 could sue for an injunction to prevent the threatened destruction of the work regardless of the
 28 mental state with which that destruction would occur. *Mass. Museum*, 593 F.3d at 55-56. As a
 29 result, a plaintiff seeking damages for a destruction that has already occurred would have to
 30 establish that the destruction was intentional or grossly negligent, while a plaintiff seeking to
 31 enjoin a proposed destruction would not need to establish the mental state with which the

1 destruction might occur. See Comment *e*. No other court appears to have disagreed with that
2 interpretation, and subsection (d) of the black letter of this Section follows that approach.

3 *e. Available remedies.* Section 501(a) of the Copyright Act provides, in part, that:

4 Anyone who violates any of the exclusive rights of the copyright owner as provided
5 by sections 106 through 122 [of the Copyright Act] or of the author as provided in
6 section 106A(a), . . . is an infringer of the copyright or right of the author, as the
7 case may be.

8 17 U.S.C. § 501(a). That section also provides that “for purposes of this chapter (other than section
9 506), any reference to copyright shall be deemed to include the rights conferred by section
10 106A(a).” As a result, the provisions of 17 U.S.C. § 502 governing preliminary and permanent
11 injunctions in copyright-infringement cases, of 17 U.S.C. § 503 governing impoundment and
12 disposition of infringing articles in copyright-infringement cases, and of 17 U.S.C. § 504 governing
13 damages and profits remedies in copyright-infringement cases all apply by their terms to claims for
14 violations of 17 U.S.C. § 106A rights. See Chapter 9 of this Restatement, discussing remedies.

15 Copyright registration is not required to bring an action for a violation of the rights granted
16 under VARA, or to be eligible for an award of statutory damages and attorney’s fees. 17 U.S.C.
17 §§ 411(a) (imposing registration prerequisite on instituting civil actions for copyright infringement
18 “[e]xcept for an action brought for a violation of the rights of the author under section 106A(a)”);
19 412 (tying availability of statutory damages and attorney’s fees to timing of registration in action
20 “other than an action brought for a violation of the rights of the author under section 106A(a”).
21 See also *Carter*, 71 F.3d at 83.

22 The First Circuit has interpreted the statute as not providing a claim for damages for an
23 attribution violation. See *Mass. Museum*, 593 F.3d at 55 (“VARA does not provide a damages
24 remedy for an attribution violation. Where the statutory language is framed as a right ‘to prevent’
25 conduct, it does not necessarily follow that a plaintiff is entitled to damages once the conduct
26 occurs.”). The court did not, however, exclude the availability of damages from other sources. See
27 id. at 56 (“In failing to provide a damages remedy for any type of violation of the moral right of
28 attribution, Congress may have concluded that artists could obtain adequate relief for the harms of
29 false attribution by resorting to the Copyright Act and other traditional claims.”). This means that
30 the only remedy available *under VARA* for a violation of the rights identified under the label “right
31 of attribution” is an injunction “to, inter alia, assert or disclaim authorship of a work.” Id. at 55.

1 In the case of a violation of either of the rights identified in subsections (c) and (d), an
2 author is eligible for an award of damages as provided by the Copyright Act. Those damages could
3 be actual damages or statutory damages. See §§ 9.03 and 9.04 of this Restatement. See also *Mass.*
4 *Museum*, 593 F.3d at 55. While actual damages and statutory damages may compensate for
5 different types of harms, see *Narkiewicz-Laine v. Doyle*, 930 F.3d 897, 904 (7th Cir. 2019) (noting
6 that statutory damages are “unrelated to the artist’s pecuniary interests” and that actual damages
7 compensate for actual financial harm), § 504 of the Copyright Act makes it clear that an author
8 who prevails on a claim under the rights identified in subsections (c) and (d) of the black letter
9 of this Section must elect either actual damages or statutory damages, as that author is precluded
10 from recovering for *both* actual and statutory damages for the same work. 17 U.S.C. § 504
11 (defendant is “liable for *either* . . . actual damages . . . or . . . statutory damages”) (emphasis
12 added). Courts have noted that statutory damages may be particularly appropriate in cases
13 involving violations of VARA, “when no actual damages are proven or they are difficult to
14 calculate.” *Cohen v. G & M Realty L.P.*, 320 F. Supp. 3d 421, 443 (E.D.N.Y. 2018), aff’d sub
15 nom. *Castillo v. G&M Realty L.P.*, 950 F.3d 155 (2d Cir. 2020). The Seventh Circuit noted that
16 statutory damages comport with “the statute’s purpose to protect the ‘moral rights’ of artists—
17 rights ‘unrelated to the artist’s pecuniary interests.’” *Narkiewicz-Laine v. Doyle*, 930 F.3d 897,
18 904 (7th Cir. 2019) (citing *Kelley v. Chi. Park Dist.*, 635 F.3d 290, 296 (7th Cir. 2011)). Statutory
19 damages can be awarded in an amount of not less than \$750 or more than \$30,000, as the court
20 considers just. 17 U.S.C. § 504. A court in its discretion may also assess statutory damages of not
21 more than \$150,000 if the destruction was willful. 17 U.S.C. § 504(c)(2). See *Hanrahan v.*
22 *Ramirez*, 1998 WL 34369997, at *3 (C.D. Cal. June 3, 1998). See §§ 9.02 (discussing rules
23 applicable to injunctive relief) and 9.04, Comment e (discussing willfulness and the relationship
24 between statutory damages and actual damages and profits) of this Restatement.

25 The right to claim damages for a violation of the right against destruction of a work of
26 recognized stature “is narrower than the right to prevent destruction of such works. While an artist
27 may ‘prevent *any* destruction of a work of recognized stature,’ [(emphasis in original)] only an
28 ‘*intentional or grossly negligent destruction* of that work’” gives rise to a claim for damages. *Mass.*
29 *Museum*, 593 F.3d at 55-56 (emphasis added). This also means that injunctive relief may be
30 available prior to the destruction. A plaintiff would need to present evidence suggesting a
31 likelihood of destruction. See also § 9.02 of this Restatement. This may also explain why the

1 statute imposes an obligation on the owner of the building to try to give the author advance notice.
2 See § 6.11, Comment *h*, of this Restatement. Destruction by natural factors such as rain, and the
3 case of works that can be removed from a building, are treated specially by the statute. See 17
4 U.S.C. § 106A(c); § 6.11, Comments *d* and *e*, of this Restatement.

5 *f. Sovereign immunity.* Section 501 of the Copyright Act provides that:

6 Anyone who violates any of the exclusive rights . . . of the author as provided in
7 section 106A(a) . . . is an infringer of the . . . right of the author . . . As used in this
8 subsection, the term “anyone” includes any State, any instrumentality of a State,
9 and any officer or employee of a State or instrumentality of a State acting in his or
10 her official capacity. Any State, and any such instrumentality, officer, or employee,
11 shall be subject to the provisions of this title in the same manner and to the same
12 extent as any nongovernmental entity.

13 17 U.S.C. § 501. That provision makes clear that states can violate 17 U.S.C. § 106A rights, and
14 § 511 of the Act embodies Congress’s intent to subject states to suits in federal court for such
15 violations. 17 U.S.C. § 511 (providing that “[a]ny State . . . shall not be immune, under the
16 Eleventh Amendment of the Constitution of the United States or under any other doctrine of
17 sovereign immunity, from suit in Federal court by any person . . . for a violation of any of the
18 exclusive rights of a copyright owner provided by sections 106 through 122.”); see also 17 U.S.C.
19 § 501 (“For purposes of this chapter (other than section 506), any reference to copyright shall be
20 deemed to include the rights conferred by section 106A(a).”).

21 The U.S. Supreme Court has limited the effect of Congress’s attempt to abrogate state
22 sovereign immunity for copyright-infringement claims. Although Congress provided in the
23 Copyright Act that a state or instrumentality thereof is subject to the provisions of the Act “in the
24 same manner and to the same extent as any nongovernmental entity,” 17 U.S.C. § 501(a), the
25 Supreme Court held in *Allen v. Cooper*, 140 S. Ct. 994 (2020), that Congress lacks power under
26 Article I of the U.S. Constitution to abrogate states’ sovereign immunity from copyright-
27 infringement lawsuits, *id.* at 1002, and found no evidence in the legislative record of a pattern of
28 state infringement of copyright sufficient to support abrogation of state sovereign immunity under
29 Section 5 of the Fourteenth Amendment, *id.* at 1006-1007. The logic of that decision would appear
30 to apply equally to claims for violations of 17 U.S.C. § 106A.

With respect to the federal government, the Second Circuit has held that VARA does not apply to the United States because the language in 17 U.S.C. § 501 defining “anyone” to include states and their instrumentalities, officers, and employees does not mention federal entities. Thompson v. United States, 795 Fed. App’x 15, 18 (2d Cir. 2019) (unpublished) (“The Government (including the USPS specifically) is not liable under VARA.”). See also § 9.01 of this Restatement.

REPORTERS’ NOTES

a. Generally. While the rights granted under 17 U.S.C. § 106A endure, generally, only for the life of the author, as described in § 6.11 Comment *i*, there are scenarios in which the rights granted by § 106A are “coextensive with the rights conferred by section 106,” 17 U.S.C. § 106A(d)(2), and thus last after the author’s death. In addition, because all of the rights granted in 17 U.S.C. § 106A run until the end of the calendar year, a claim might be brought after the author’s death but later in that calendar year. The statute is not clear on who would be in the position to assert those rights, but that person would need to prove an appropriate connection to the author, which would presumably be done under the terms of the author’s will or by the applicable rules of intestate succession. Cf. 17 U.S.C. § 201(d)(1) (expressing rule for post-mortem succession of copyright ownership).

c. Prejudice to honor or reputation. According to the legislative history, in the case of a work of recognized stature, modification of the work “will generally establish harm to honor or reputation.” H.R. Rep. 101-514, reprinted as 1990 U.S.C.C.A.N. 6915, 6926.

Professor Nimmer discusses the first ambiguity described in Comment *c* in Nimmer on Copyright. See MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8D.06[C][1].

e. Available remedies. The First Circuit’s conclusion that the Visual Artists Rights Act of 1990, Pub. L. No. 101-650, 104 Stat. 5089, 5128 (VARA), does not provide a damages remedy for an attribution violation relies on what it terms Professor Nimmer’s “surmise” and “speculation” (Mass. Museum of Contemp. Art Found., Inc. v. Büchel, 593 F.3d 38, 55 (1st Cir. 2010), citing NIMMER ON COPYRIGHT § 8D.06[B][1]) and on a reading of the Berne Convention for the Protection of Literary and Artistic Works, which admittedly provides latitude on remedies for violations of moral rights to Berne Convention member States. Professor Nimmer’s conclusion was tentative. He wrote: “Perhaps the implication is that whereas an integrity violation could give rise to a monetary recovery, failure to attribute is remediable solely through injunction. If that conclusion were intended, Congress certainly could have expressed its intent less obliquely.” This reading of the statute as not allowing an author to claim damages under VARA for an attribution violation limits Congress’s intent in protecting attribution. Moreover, it is far from obvious that an injunction is always the best option. What if a work has already been distributed in several copies to different buyers, for example? Though the statute could certainly have been written in clearer terms, there are many fact patterns in which the payment of damages would seem adequate. The statute need not be read as prohibiting the award of damages for violations of the right of attribution.

1 As discussed in § 6.11, Reporters' Note to Comment *h*, of this Restatement, 17 U.S.C.
2 § 113(d)(3) provides that the "Register of Copyrights shall establish a system of records whereby
3 any author of a work of visual art that has been incorporated in or made part of a building may
4 record his or her identity and address with the Copyright Office."

5 *f. Sovereign immunity.* On the application of the Eleventh Amendment in this context, see
6 also Scott v. Cal. African Am. Museum, 2015 WL 12806471, at *3 (C.D. Cal. July 24, 2015). For
7 a parallel case in the patent context, see Seminole Tribe of Fla. v. Florida, 517 U.S. 44, 58 (1996).
8 The path available to a plaintiff relying on *Ex parte Young*, 209 U.S. 123 (1908), is similarly
9 limited in scope. See Whole Woman's Health v. Jackson, 142 S. Ct. 522, 525 (2021) (explaining
10 that the "narrow" exception in *Ex parte Young* "does not normally permit federal courts to issue
11 injunctions against state-court judges or clerks.").