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## ARTICLES

The Territorial Discrepancy Between Intellectual Property Rights Infringement Claims and Remedies

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When in *Equustek v. Google* a Canadian court ordered that Google de-list the pages of a defendant that infringed intellectual property (“IP”) rights under Canadian law, some commentators were surprised not only by the Canadian court’s assertion of personal jurisdiction over Google (a U.S. third party who was not a party to the original Canadian IP rights infringement litigation), but also by the court’s issuance of a remedy with global effects. However, global and other extraterritorial remedies are not unknown in IP rights infringement cases: U.S. courts have granted extraterritorial remedies in a number of such cases. This Article reviews the various types of “extraterritorial remedies”—which the Article defines as remedies that reach beyond the territorial scope of the underlying claim—and points out the problems caused by the resulting territorial discrepancy between the territorial scope of claims and the territorial scope of the remedies. The existing literature and international treaty negotiations have not focused on these remedies, which are typically discussed as part of the category of cross-border remedies. The Article explores the phenomenon of the territorial discrepancy and considers the ways in which the problems generated by the territorial discrepancy might be addressed.

Equitable Estoppel and Information Costs in Contemporary Copyright

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The failure of the contemporary copyright system to provide clear notice of the existence of copyrights and the identity of copyright owners leaves even the most well-meaning actors vulnerable to infringement actions and dire remedies. This Article describes how the doctrine of equitable estoppel has sometimes been deployed to address these information cost problems by requiring the actor in the best position to communicate about the existence of rights to do so. Renewed focus on equitable estoppel in the wake of the Supreme Court’s decision in *Petrella v. Metro-Goldwyn-Mayer, Inc.*, may present new opportunities to apply the doctrine in this useful way.

The Filtration Problem in Copyright’s “Substantial Similarity” Infringement Test

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Copyright protects original artistic and literary expression. It does not protect ideas, facts, or other elements that may be found in artistic and literary works but which Section 102(b) of the Copyright Act, or the judge-made merger and scènes

PROVING INFRINGEMENT:  
BURDENS OF PROOF IN COPYRIGHT INFRINGEMENT  
LITIGATION

*by*

*Lydia Pallas Loren & R. Anthony Reese\**

*The Copyright Act says very little about the plaintiff's burden of proof in establishing liability in an infringement case, although courts have, to varying degrees, allocated burdens of proof, including identifying certain defense arguments as affirmative defenses. The Article seeks to provide greater analytical clarity to the complicated area of the burdens of proof in copyright infringement litigation. In particular, the Article identifies many "defenses" to a copyright infringement claim as not being true affirmative defenses but rather being rebuttals to a plaintiff's efforts to satisfy the burden of persuasion. Careful understanding of the burdens of persuasion, the different types of defense arguments, and the potential shifting of the burden of coming forward with additional evidence will aid attorneys and courts in a more accurate and thorough analysis of both the procedural and substantive issues raised in any particular infringement case.*

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## INTRODUCTION

What, exactly, must a plaintiff who alleges copyright infringement prove in order to prevail? When an author sues, alleging that a Harry Potter novel is an infringement of the author’s manuscript, what *precisely* will the author need to show in order to win that lawsuit?<sup>1</sup> What about the photographer who asserts that another photographer’s image infringes her image—what evidence will be sufficient to establish a *prima facie* case?<sup>2</sup> Which arguments, if raised by the defendants in these cases, will require the plaintiff to offer additional proof in order to prevail and which defense arguments are affirmative defenses for which the burden of proof rests ultimately on the defendant?

Defining the *prima facie* case and assigning certain defense arguments the status of “affirmative defenses” translates into assigning the burden of proof. What is generally called the burden of proof is more accurately labeled the burden of persuasion, i.e. convincing the trier of fact that the evidence produced supports the claim under the applicable evidentiary standard. Assigning the burden of proof is fundamentally important. The Copyright Act itself says very little about the plaintiff’s burden of proof in establishing liability in an infringement case,<sup>3</sup> which is not surprising, since the Act says essentially nothing about the elements a plaintiff must prove to establish infringement.<sup>4</sup> Despite this lack of statutory guidance, courts have both articulated the elements of a claim for infringement and, to varying degrees,

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<sup>1</sup> See, e.g., *Allen v. Scholastic Inc.*, 739 F. Supp. 2d 642, 645 (S.D.N.Y. 2011) (rejecting plaintiff’s assertion that J.K. Rowling’s *Harry Potter and the Goblet of Fire* infringed on an earlier book titled *The Adventures of Willy the Wizard—No 1 Livid Land*).

<sup>2</sup> See, e.g., *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1122 (9th Cir. 2018) (rejecting photographer’s copyright infringement claim).

<sup>3</sup> The statute does specify the burden of proof for at least one defense to liability, as discussed in Part V.C, *infra*. In addition, while this Article examines the burden of proof as applied in determining liability for copyright infringement, burden of proof issues also arise in the determination of remedies for infringement. With respect to remedies, the statute does specify certain burdens of proof. See, e.g., 17 U.S.C. § 504(b) (2012) (specifying burdens of proof when plaintiff seeks recovery of the alleged infringer’s profits); § 504(c) (2012) (specifying burdens of proof concerning willful or innocent infringement when plaintiff seeks recovery of statutory damages); and § 1203(c)(4)–(5) (2012) (specifying burdens of proof with respect to enhancements and limitations of statutory damages available for violations of §§ 1201 and 1202 regarding technological protection measures and copyright management information).

<sup>4</sup> 17 U.S.C. § 501 (2012) defines an infringer to include “[a]nyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 122 . . .”

allocated burdens of proof, including identifying certain defense arguments as affirmative defenses.

In this Article, we seek to explore the burden of proof that a plaintiff must shoulder in order to prove a *prima facie* case of copyright infringement.<sup>5</sup> We also consider which defense arguments are affirmative defenses with the burden of persuasion resting on the defendant and which defense arguments are more accurately seen as countering or rebutting elements of the plaintiff's *prima facie* case. Some of the defense arguments in this latter category may involve the defendant producing further evidence on a disputed factual issue, either because without that additional evidence the plaintiff is entitled to judgment as a matter of law or because additional evidence from the defendant, while not required, will weaken the strength of the plaintiff's evidence. Other defense arguments in this category are not concerned with the defendant producing additional evidence but rather are arguments addressed to questions of law that, if accepted, defeat the plaintiff's claim. Careful understanding of the burdens of persuasion, the different types of defense arguments, and the potential shifting of the burden of coming forward with additional evidence will aid attorneys and courts in a more accurate and thorough analysis of the issues raised in any particular infringement case.

The aim of this Article is to provide greater analytical clarity to the complicated area of the burdens of proof in copyright infringement litigation. In Part I, we set out the basis of the general operation of burdens of proof in civil litigation. In Part II, we review the elements of a *prima facie* claim for copyright infringement, explaining what a plaintiff must prove for a court to conclude that copyright infringement has occurred. In Part III, we examine the plaintiff's burden of proof to establish each of the elements of an infringement claim and consider ways in which the plaintiff can satisfy that burden. In Part IV, we consider ways in which an infringement defendant can rebut the plaintiff's *prima facie* case and how those rebuttals interact with the plaintiff's burden of proof. In Part V, we examine affirmative defenses that an infringement defendant might raise to a claim of infringement.

## I. BURDENS OF PROOF GENERALLY

### A. *The Basics*

#### 1. *Standard of Proof*

Before exploring the basics of burdens of proof, it is important to clarify the separate issue of the standard of proof. The general standard for civil litigation is that the party asserting a claim must introduce evidence that supports the elements

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<sup>5</sup> We do not address the extent to which the issues involved in any particular case are issues for a jury to decide. That topic, while also of fundamental importance, is beyond the scope of this Article.

of the claim by a preponderance of the evidence.<sup>6</sup> If the party asserting the claim can show it is more likely than not that the necessary facts it asserts are true, then that party has satisfied the standard of proof and should prevail on that claim. As in civil litigation generally, the party asserting a claim of copyright infringement must demonstrate facts that support all of the elements of the claim by a preponderance of the evidence.<sup>7</sup>

## *2. Burden of Persuasion and Burden of Production*

Separate from the standard of proof is the burden of proof. The phrase “burden of proof” should be distinguished from the burden of production.<sup>8</sup> As the Supreme Court has explained, since 1923 “our opinions consistently distinguished between burden of proof, which we defined as burden of persuasion, and an alternative concept, which we increasingly referred to as the burden of production or the burden of going forward with the evidence.”<sup>9</sup>

Following the Supreme Court’s terminology, generally the party that is said to have the burden of proof on a particular element of a claim or defense will have the burden of persuasion on that element throughout the litigation, while the burden of production on that element may shift to the opposing party. The burden of persuasion identifies which party must convince the trier of fact at trial that the evidence that party has presented shows the necessary facts under the applicable standard of proof.<sup>10</sup> In contrast, “the production burden focuses on whether a party possesses sufficient evidence to go to trial in the first place.”<sup>11</sup>

When a party has the burden of persuasion on a particular issue, that party has an initial burden of production: that party must produce evidence from which a

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<sup>6</sup> Neil Orloff & Jerry Stedinger, *A Framework for Evaluating the Preponderance-of-the-Evidence Standard*, 131 U. PA. L. REV. 1159, 1159 (1983) (“In most civil cases, the requisite degree of persuasion is ‘by a preponderance of the evidence.’”).

<sup>7</sup> In some situations, the standard of proof is higher, typically articulated as requiring “clear and convincing evidence.” For example, in the patent infringement context, if a defendant raises the affirmative defense of patent invalidity, the defendant bears the burden of proving that the patent, issued by the United States Patent Office, is invalid by clear and convincing evidence. Microsoft Corp. v. i4i Ltd. P’ship, 564 U.S. 91, 95 (2011).

<sup>8</sup> See Fleming James, Jr., *Burdens of Proof*, 47 VA. L. REV. 51, 51 (1961) (“The term ‘burden of proof’ is used in our law to refer to two separate and quite different concepts. . . . The two distinct concepts may be referred to as (1) the risk of non-persuasion, or the burden of persuasion or simply persuasion burden; (2) the duty of producing evidence, the burden of going forward with the evidence, or simply the production burden or the burden of evidence.”).

<sup>9</sup> Dir., Office of Workers’ Comp. Programs, Dep’t of Labor v. Greenwich Collieries, 512 U.S. 267, 274 (1994) (citing Hill v. Smith, 260 U.S. 592 (1923) and discussing the evolution of the meaning of the term “burden of proof”).

<sup>10</sup> EDWARD BRUNET ET AL., SUMMARY JUDGMENT: FEDERAL LAW AND PRACTICE § 5.1, at 152 (2019).

<sup>11</sup> *Id.*

fact-finder could conclude in favor of that party on that issue.<sup>12</sup> If that party fails to come forward with sufficient evidence, it will lose on that issue if the opposing party makes a dispositive motion. For example, if a plaintiff asserting copyright infringement fails to present evidence that it owns the copyright in the work allegedly infringed, a required element of a claim of copyright infringement,<sup>13</sup> a defense motion for summary judgment should be granted. If a party meets its burden of production, a judge should deny any motion for a peremptory ruling seeking to resolve that issue against that party. In other words, satisfying the burden of production means that, as to that issue, the party meeting the burden is entitled to have the case resolved by the fact-finder (based on whether the standard of proof has been met); that issue should not be decided through a peremptory ruling (such as a motion for summary judgment) based on a failure of that party to satisfy the burden of production.<sup>14</sup>

### *3. Shifting the Burden of Production*

When a party that bears the burden of persuasion on an issue has introduced sufficient evidence to satisfy the subsidiary initial burden of production on that issue, the burden of production does not then automatically shift to the opposing party. For example, when a plaintiff meets its burden of production on an issue, the defendant might not offer any additional evidence on the issue but might instead simply argue that the plaintiff's evidence does not meet the standard of proof and that therefore the plaintiff has failed to sustain its burden of persuasion. The fact-finder would then need to make a determination as to whether the plaintiff has actually met its burden of persuasion.

If, on the other hand, a party that bears the initial burden of production has introduced evidence that is not merely sufficient to satisfy the initial burden of production but rather has "presented sufficient evidence that a rational finder of fact must find for him or her," then in effect, the burden of production has shifted to the opposing party.<sup>15</sup> If the opposing party fails to come forward with evidence on that issue, the party who has the burden of proof and who bore the initial burden of production is entitled to a peremptory ruling on that issue.<sup>16</sup>

## *B. Allocating Burdens*

In any civil case, a variety of considerations go into determining which party bears the burden of proof on which issue. A general baseline assumption is "he who asserts must prove," so that the burden of proof tracks the burdens of pleading.<sup>17</sup>

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<sup>12</sup> *Id.* § 5.2, at 153.

<sup>13</sup> See *infra* Part II.

<sup>14</sup> BRUNET ET AL., *supra* note 10, § 5.2, at 153.

<sup>15</sup> *Id.*

<sup>16</sup> *Id.* § 5.8(b), at 185.

<sup>17</sup> William Baude & Stephen E. Sachs, *The Law of Interpretation*, 130 HARV. L. REV. 1079,

That general rule, however, is augmented and sometimes altered by other considerations. When the cause of action is statutory, the statute may indicate the appropriate allocation of the burdens of proof.<sup>18</sup> Policy considerations such as “handicapping a disfavored contention” may come into play.<sup>19</sup> Also, “the judicial estimate of the probabilities of the situation” can be a significant consideration in assigning the burden of proof.<sup>20</sup> Another justification often relied upon for placement of the burden of proof is that where the facts tending to support an element are more likely to lie within the knowledge of one party, that party should have the burden of proving those facts.<sup>21</sup> And “[c]onvenience in following the natural order of storytelling may account for calling on the defendant to plead and prove those matters which arise after a cause of action has matured . . . .”<sup>22</sup>

### C. Defense Arguments

Generally, the plaintiff will have the burden of proof on the essential elements of the plaintiff’s claim. If the plaintiff can meet that burden, then the defendant generally has the opportunity to oppose the plaintiff’s showing. We can classify arguments by the defendant against the plaintiff’s claim into three categories: affirmative defenses, *prima facie* factual rebuttals, and *prima facie* legal rebuttals. Defenses

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1111–12 (2017) (quoting Gary Lawson, *Legal Indeterminacy: Its Cause and Cure*, 19 HARV. J.L. & PUB. POL’Y 411, 425 (1996)).

<sup>18</sup> “In allocating the burdens, courts consistently attempt to distinguish between the constituent elements . . . of a statutory command, which must be proved by the party who relies on the . . . statute, and matters of exception, which must be proved by its adversary.” KENNETH S. BROUN ET AL., MCCORMICK ON EVIDENCE § 337, at 717 (7th ed. 2014).

<sup>19</sup> *Id.*

Presumptions and allocations of proof burdens ordinarily conform to probabilities about the likely state of facts or about the party in a better position to prove a fact. Nonetheless, justifications for presumptions and allocations of the risk of nonpersuasion usually involve substantive preferences in addition to assessments of probability. Thus presumptions and burdens of proof often allocate the risk of uncertainty in a way that favors a substantive interest.

Scott M. Matheson, Jr., *Procedure in Public Person Defamation Cases: The Impact of the First Amendment*, 66 TEX. L. REV. 215, 240 (1987) (citations omitted).

<sup>20</sup> BROUN ET AL., *supra* note 18, § 337, at 717.

<sup>21</sup> See Marc S. Friedman & Andrew J. Siegel, *From Flour Barrel to Computer Systems: The Applicability of Theories of Alternative Liability to Shift the Burdens of Proof in Cases of Intermingled Causation and Damages Within a Modern Computer Scenario*, 14 RUTGERS COMPUTER & TECH. L.J. 289, 294 (1988). Caution should be exercised, however, when relying on this consideration. Many allegations made by plaintiffs concern matters that lie within the knowledge of the defendant and yet it is entirely appropriate for the plaintiff to shoulder the burden of proving her allegations. Robust pre-trial discovery is designed to aid parties in obtaining evidence that is in the control of the opposing party.

<sup>22</sup> BROUN ET AL., *supra* note 18, § 337, at 717.

to a plaintiff's claim that constitute affirmative defenses<sup>23</sup> require the defendant to carry both the burden of production and the burden of persuasion as to the defense.<sup>24</sup>

The two other categories of defense arguments, while sometimes referred to as "defenses," are not technically affirmative defenses. Instead, these arguments are responses to the plaintiff having demonstrated a *prima facie* case of infringement, i.e., having met the plaintiff's burden of production. We label the first category of these arguments *prima facie factual rebuttals*. With these arguments, the defendant is seeking to present evidence that, if credible, could defeat the plaintiff's *prima facie* case. This is because the fact-finder, evaluating both the plaintiff's and the defendant's evidence, could determine that the plaintiff has not met its burden of persuasion, i.e., the plaintiff has not shown, by a preponderance of the evidence, all of the required elements of its claim. In some instances, the defendant will need to produce additional evidence in order to try to rebut the plaintiff's claim because the plaintiff has fulfilled its burden of production in a manner that shifts the burden of production to the defendant as described in the preceding section. Even though the burden of production has shifted to the defendant, the burden of persuasion remains with the plaintiff. However, because the plaintiff's evidence is such that no reasonable jury could conclude against the plaintiff on that issue, if the defendant has failed to offer any additional evidence, the court may appropriately rule in favor of the plaintiff on that issue without needing a determination by a fact-finder.

The final category of defense arguments addresses the proper application of the law to the facts supported by the plaintiff's evidence or the proper legal test or standard to apply to that evidence. These defense arguments do not necessarily require, and indeed often do not involve, the presentation by the defendant of any additional evidence.<sup>25</sup> We label these *prima facie legal rebuttals*. This final category of defenses

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<sup>23</sup> Federal Rules of Civil Procedure (FRCP) Rule 8(c) lists a number of "affirmative defenses" for which the defendant has a duty to plead in its responsive pleading:

In responding to a pleading, a party must affirmatively state any avoidance or affirmative defense, including: accord and satisfaction; arbitration and award; assumption of risk; contributory negligence; duress; estoppel; failure of consideration; fraud; illegality; injury by fellow servant; laches; license; payment; release; res judicata; statute of frauds; statute of limitations; and waiver.

FED. R. CIV. P. 8(c).

<sup>24</sup> Included in FRCP Rule 8(c)'s list is the affirmative defense of "license." At least one court has looked to this rule to assign to the defendant the burden of proving that the use of the copyrighted work was "authorized," as opposed to requiring the plaintiff to demonstrate that the use asserted to be infringement was unauthorized. *Muhammad-Ali v. Final Call, Inc.*, 832 F.3d 755, 760–61 (7th Cir. 2016); *see also infra* Part V.A.

<sup>25</sup> For example, the plaintiff makes out a *prima facie* case of copyright infringement but then the defendant argues that any copying of expression by the defendant is de minimis and therefore does not amount to improper appropriation. Assuming that the plaintiff's and defendant's works are already in the record, the defendant would just be arguing that comparing the works (and

is generally aimed at questions of law, and, in some instances, issues of mixed questions of law and fact, and is discussed in more detail below.<sup>26</sup>

The labels *prima facie factual rebuttal* and *prima facie legal rebuttal* are not intended to identify mutually exclusive categories of defense arguments. In many instances, a defendant's response to a plaintiff's *prima facie* showing on an element of the plaintiff's claim will involve a rebuttal that has both a factual component (as to which the defendant will introduce evidence that supports the defendant's assertion that the plaintiff has not met its burden of persuasion) and a legal component (as to which the defendant will argue that the proper legal standard or its application supports the defendant's assertion that the plaintiff has not met its burden of persuasion).

#### D. Presumptions

Presumptions can play an important role in satisfying a party's burden of proof. “[A] presumption is a standardized practice, under which certain facts are held to call for uniform treatment with respect to their effect as proof of other facts.”<sup>27</sup> For example, the Copyright Act articulates an important presumption concerning the plaintiff's burden of demonstrating ownership and validity of the copyright allegedly infringed. If the plaintiff presents a certificate of registration from the Copyright Office showing that the registration was made “before or within five years after first publication of the work,” then the certificate constitutes *prima facie* evidence of the validity of the copyright and of the facts stated in the certificate.<sup>28</sup>

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perhaps analogizing to prior cases that found copying to be *de minimis*) demonstrates that the plaintiff cannot prevail on the improper appropriation element of the *prima facie* case.

<sup>26</sup> See *infra* Part I.D.

<sup>27</sup> BROUN ET AL., *supra* note 18, § 342, at 726. “Evidentiary presumptions in law act as shortcuts to rigorous proof. By means of an evidentiary presumption, a difficult-to-prove critical fact may be established by proving some other more easily provable subsidiary fact from which the critical fact may be presumed.” Paul F. Rothstein, *Demystifying Burdens of Proof and the Effect of Rebuttable Evidentiary Presumptions in Civil and Criminal Trials*, GEO. L. CTR. 1, 3 (2017), <http://scholarship.law.georgetown.edu/facpub/2001> (follow “Download” hyperlink).

<sup>28</sup> 17 U.S.C. § 410(c) (2012). The statute creates at least two other presumptions potentially relevant to copyright infringement claims. See 17 U.S.C. § 113 (2012) (presumption of diligent, good faith attempt by building owner to notify author of a work of visual art of removal of work of visual art incorporated into building in order to defeat author's rights under § 106A); 17 U.S.C. § 201(c) (presumption, in absence of express transfer of rights in a contribution to a collective work, that copyright owner in collective work acquires only a limited privilege to reproduce and distribute the contribution). Also, the statute contains at least one presumption related to infringement remedies. 17 U.S.C. § 504(c)(3)(A) (creating rebuttable presumption of willfulness where infringer, *inter alia*, knowingly provided materially false contact information to a domain name registrar).

Like most presumptions, this presumption has the effect of shifting the burden of production but not the burden of persuasion.<sup>29</sup> This treatment of a presumption makes the presumption “rebuttable”—i.e., the defendant is given the opportunity to present evidence demonstrating that the ultimate fact to be proven is not accurately or appropriately “presumed” from the plaintiff’s proof of the other fact that gave rise to the presumption. If, however, the defendant does not produce additional evidence to rebut the presumption, the plaintiff is entitled to prevail on that issue.<sup>30</sup>

Where a plaintiff must establish an evidentiary basis in order for a presumption to apply, a defendant might present evidence not to rebut the presumption but rather to show that the plaintiff is not entitled to the benefit of that presumption, by demonstrating that the plaintiff has not actually shown by a preponderance of the evidence the evidentiary fact triggering the presumption. For example, in the context of the presumption arising from a certificate of registration, a defendant might introduce evidence showing that the work was, in fact, published more than five years prior to the registration. If the defendant’s evidence is accepted by the fact-finder as true, then the plaintiff is no longer entitled to the benefit of the presumption and would instead need to produce other evidence demonstrating the fact or facts that the plaintiff had sought to establish through the presumption.<sup>31</sup>

#### *E. Questions of Fact Versus Questions of Law*

Who carries the burden of proof is relevant to the factual questions at issue in a lawsuit. Questions of law do not have burdens of persuasion or burdens of production. If a factual matter must be proven to support a claim or a defense, one party will be identified as carrying the burden of proof, which, as discussed above, means that party has the burden of introducing evidence and convincing the finder of fact that the evidence demonstrates that it is more likely than not that a particular fact is true. When, instead, a matter is classified as a question of law, no party has a

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<sup>29</sup> This treatment of presumptions is articulated in Federal Rule of Evidence 301: “In a civil case, unless a federal statute or these rules provide otherwise, the party against whom a presumption is directed has the burden of producing evidence to rebut the presumption. But this rule does not shift the burden of persuasion, which remains on the party who had it originally.” 28 U.S.C. § 301 (2012).

<sup>30</sup> See Rothstein, *supra* note 27, at 17.

<sup>31</sup> In the case of copyright infringement claims, the certificate might still be relevant evidence as to the element of the plaintiff’s ownership of a valid copyright even without its status as *prima facie* evidence; the statute provides that “[t]he evidentiary weight to be accorded the certificate of a registration made [more than five years after a work’s first publication] shall be within the discretion of the court.” 17 U.S.C. § 410(c).

burden to produce evidence to establish any particular facts on that question.<sup>32</sup> Indeed, as one court has put it, “the concept of ‘burden of proof’ has no relevance where a dispute is solely on a question of law.”<sup>33</sup>

A complication arises when an issue is identified as a mixed question of law and fact. Is there a burden of proof on those issues, and if there is, on whom does that burden rest? A mixed question asks whether “the historical facts . . . satisfy the [legal] standard, or to put it another way, whether the rule of law as applied to the established facts is or is not violated.”<sup>34</sup> In this context, a party may bear a burden of proof on the historical facts, but the real issue to be decided by the court is whether the legal rule has been violated or not.

To complicate matters even further:

Mixed questions are not all alike. . . . [S]ome require courts to expound on the law, particularly by amplifying or elaborating on a broad legal standard. . . . [O]ther mixed questions immerse courts in case-specific factual issues—compelling them to marshal and weigh evidence, make credibility judgments, and otherwise address what we have (emphatically if a tad redundantly) called “multifarious, fleeting, special, narrow facts that utterly resist generalization.”<sup>35</sup>

While the Supreme Court has not addressed the application of burdens of proof in the different categories of mixed law/fact questions, it has ruled on the appellate standard of review to be employed.<sup>36</sup> When the mixed question falls more in the category that requires elaboration of the legal standard, a *de novo* review is appropriate,<sup>37</sup> thus treating the question more in the nature of a legal question. If that treatment were carried through to the question of burdens of proof, those types

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<sup>32</sup> Of course, “facts” certainly may be introduced to help the court decide the particular question of law. For example, a party may point to statements in legislative history or even dictionaries to aid a court in a legal question that involves a debated matter of statutory interpretation.

<sup>33</sup> *Sequa Corp. & Affiliates v. United States*, 350 F. Supp. 2d 447, 449 (S.D.N.Y. 2004), *aff'd*, 437 F.3d 236 (2d Cir. 2006); *see also Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91, 114 (2011) (Breyer, J., concurring) (“[T]he evidentiary standard of proof applies to questions of fact and not to questions of law.”); *United States v. Wood*, 459 F. Supp. 2d 451, 457 n.2 (E.D. Va. 2006) (noting that a party’s position presented “a question of law, to which standards of proof for factual issues do not apply.”); *Level One Comm., Inc. v. Seeq Tech., Inc.*, 987 F. Supp. 1191, 1196 (N.D. Cal. 1997) (quoting *N. Telecom Ltd. v. Samsung Elecs. Co.*, No. C-95-449 (MHP), 1996 WL 532122, at \*9 n.11 (N.D. Cal. Sept. 16, 1996)) (“[M]atters of law generally are not subject to traditional burdens of proof.”).

<sup>34</sup> *Pullman-Standard v. Swint*, 456 U.S. 273, 289 n.19 (1982).

<sup>35</sup> *U.S. Bank Nat'l Ass'n v. Village at Lakeridge*, 138 S. Ct. 960, 967 (2018) (quoting *Pierce v. Underwood*, 487 U.S. 552, 561–62 (1988)).

<sup>36</sup> *Id.*

<sup>37</sup> *Id.*

of mixed questions would not have a burden of proof associated with them (other than the burden that accompanies proof of the relevant historical facts).

The mixed questions of law and fact that instead “immerse courts in case-specific factual issues” and involve the court’s weighing evidence and making credibility judgments should be reviewed, according to the Supreme Court, with deference to the trial court’s determination.<sup>38</sup> Deferential review is appropriate for factual determinations, and factual determinations involve considerations of the burden of proof. Whether the reasoning behind the Court’s holding for a deferential standard of appellate review applies with equal force when considering the questions of burdens of proof is not without doubt. When considering the burden of proof in the context of a mixed law/fact question, the party with the burden must demonstrate the historical facts sufficient to satisfy the standard of proof that those facts are more likely true than not. But the final question in a mixed law/fact question is “whether the rule of law as applied to the established facts is or is not violated.”<sup>39</sup> That question does not seem to lend itself to a burden of proof, but rather is fundamentally a legal conclusion to be drawn from the established facts. Even if the conclusion should be reviewed on appeal with deference, it may not be appropriate to impose a burden of proof requirement on either party (again, other than the burden applicable to establishing the relevant historical facts).

## II. THE PRIMA FACIE CASE OF COPYRIGHT INFRINGEMENT

Exploring how burdens of proof operate in copyright infringement litigation requires understanding the elements of a prima facie case of copyright infringement. The Supreme Court has stated these elements succinctly: “To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”<sup>40</sup> These two fundamental elements are not clearly articulated anywhere in the Copyright Act. Instead, the Act states that “[a]nyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 122 . . . is an infringer of the copyright or right of the author, as the case may be.”<sup>41</sup> Referencing a violation of “any of the exclusive rights of the copyright owner” that are articulated in no fewer than 19 separate sections of the Copyright Act hardly provides a clear articulation of the elements of a prima facie case.

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<sup>38</sup> *Id.*

<sup>39</sup> *Pullman-Standard*, 456 U.S. at 289 n.19.

<sup>40</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 548 (1985)). Despite the Court’s use of the passive voice, the context makes clear that it is the party asserting infringement that must prove these two elements.

<sup>41</sup> 17 U.S.C. § 501(a) (2012). Note that encompassed within the statutory sections between sections 106 and 122 are sections 106A and 121A, making that a total of 19 separate sections.

While the Supreme Court's articulation of infringement as a two-element test is a helpful expansion of the statute's very minimal statement of what constitutes infringement, even that articulation is not really a complete statement of the elements of an infringement claim. The Court's articulation of the first element requires some unpacking, as that element actually involves proving two distinct factual assertions: (1a) that the person asserting the claim is the owner of the copyright, and (1b) that the copyright is valid. These two components of the first element of a *prima facie* case are discussed in more detail below.

More significantly, the second element in the Court's articulation is an incomplete statement of the actual test that courts apply in infringement cases. The element is incomplete because, as generally applied by the courts, the requirement of proof of "copying of constituent elements of the [copyrighted] work that are original" requires proof of three distinct assertions. First, it requires (2a) that the defendant, as a factual matter, copied from the plaintiff's copyrighted work (rather than, for example, merely independently creating a similar work). Next, the defendant's copying must amount to improper appropriation, which requires two generally distinct conclusions: (2b) that the defendant copied some elements from the plaintiff's copyrighted work that are protected by the work's copyright (rather than, for example, merely copying unprotected ideas)<sup>42</sup> and (2c) that the defendant's actual copying of protected elements from the plaintiff's copyrighted work produced substantial similarity between the copied elements in the defendant's work and the protected expression in the plaintiff's work.<sup>43</sup>

In addition, the Court's articulation of the second element ("copying of constituent elements of the work that are original") is potentially misleading because it employs an imprecise word in the context of the rights that the statute grants to a copyright owner: "copying." This "copying" component of the *prima facie* case of infringement requires not just unpacking of the type of material that is copied (i.e., the copied material must include elements that are copyrightable, i.e., original to the copyrighted work) and the quantum of material that is sufficient to constitute an actionable appropriation; it also requires understanding the different types of rights that the Copyright Act grants to a copyright owner.

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<sup>42</sup> See, e.g., *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1117 (9th Cir. 2018) ("Proof of unlawful appropriation—that is, *illicit* copying—is necessary because copyright law does not forbid all copying. The Copyright Act provides that copyright protection does not 'extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in [the copyrighted] work.' 17 U.S.C. § 102(b). Thus, a defendant incurs no liability if he copies only the 'ideas' or 'concepts' used in the plaintiff's work.") (alteration in original).

<sup>43</sup> See, e.g., *id.* ("To infringe, the defendant must also copy enough of the plaintiff's expression of those ideas or concepts to render the two works 'substantially similar.'") (citing *Mattel, Inc. v. MGA Entm't, Inc.*, 616 F.3d 904, 913–14 (9th Cir. 2010)).

The statutory section that specifies the rights of a copyright owner does not speak in terms of “copying.” Instead, that section grants five different rights: (1) the right to reproduce the work in copies,<sup>44</sup> (2) the right to prepare derivative works based upon the copyrighted work,<sup>45</sup> (3) the right to distribute copies of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending,<sup>46</sup> (4) the right to perform the copyrighted work publicly,<sup>47</sup> and (5) the right to display the copyrighted work publicly.<sup>48</sup> Two of those rights—reproduction and distribution—expressly involve “copies,” which the statute defines as “material objects . . . in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”<sup>49</sup>

It might therefore be tempting to equate the “copying” required to prove infringement with the reproduction of the work in a material object that constitutes a copy. But while reproducing a work is certainly one way to “copy” a work of authorship, the other rights granted to copyright owners do not necessarily involve reproduction. Those rights can be infringed even if the defendant never produces any “copies” of the plaintiff’s work. Nonetheless, the Court’s statement that proving infringement requires “copying constituent elements of the work that are original” is also appropriately relevant even if the plaintiff asserts a violation of one of the other rights granted to a copyright owner. As the Ninth Circuit has explained, “[t]he word ‘copying’ is shorthand for the infringing of any of the copyright owner’s . . . exclusive rights, described at 17 U.S.C. § 106.”<sup>50</sup>

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<sup>44</sup> 17 U.S.C. § 106(1) (2012). The statute specifies that the copyright owner has the right to reproduce the work in both “copies” and “phonorecords.” *Id.* The statute defines “phonorecords” as “material objects in which sounds . . . are fixed,” such as CDs, vinyl records, and digital files. *Id.* § 101.

<sup>45</sup> *Id.* § 106(2).

<sup>46</sup> *Id.* § 106(3). As with the reproduction right, the distribution right also includes distribution of “phonorecords.” *Id.*

<sup>47</sup> *Id.* § 106(4). While the reproduction, derivative work, and distribution rights are granted to copyright owners of all categories of works of authorship, the public performance right is more limited. Only copyright owners of “literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works” are granted the general public performance right. *Id.* Sound recordings are granted a more limited public performance right that only applies to public performances by means of a digital audio transmission. *Id.* § 106(6).

<sup>48</sup> *Id.* § 106(5). As with the public performance right, owners of copyrights in only certain categories of works are granted a public display right. Specifically, the statute grants a public display right only for “literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work.” *Id.*

<sup>49</sup> *Id.* § 101 (definition of “copies”).

<sup>50</sup> S.O.S., Inc. v. Payday, Inc., 886 F.2d 1081, 1085 n.3 (9th Cir. 1989). The Ninth Circuit also has articulated the test for infringement as requiring the plaintiff “establish ‘ownership of the

For example, imagine a singer who performs a song in concert but never records it. And imagine that the owner of the copyright in a similar song sues for copyright infringement and alleges that the singer, by publicly performing her song, has infringed on the public performance right in the plaintiff's copyrighted song. To prevail on the infringement claim, not only must it be shown that the singer's performance was public (and therefore within the scope of the copyright owner's exclusive rights),<sup>51</sup> but also it must be shown that the song the singer performed contained elements that were copied from the plaintiff's copyrighted song, that those copied elements are original, and that the magnitude of the copying amounted to improper appropriation.<sup>52</sup> It would not be enough that the singer's song sounded similar to the plaintiff's song; the singer must have heard or seen the plaintiff's song and replicated some original elements from the plaintiff's song in the singer's performance.

Similarly, if a copyright owner sues a retailer alleging that the retailer is selling copies in violation of the exclusive right to distribute copies of the plaintiff's copyrighted work, the retailer could be liable for infringement even if it had not produced the copies being sold. Instead, the retailer could be liable if it were shown that the copies distributed by the retailer contain material that replicated a sufficient amount of "constituent elements of the [plaintiff's copyrighted] work that are original."

Copyright infringement is identified as a strict liability offense; the alleged infringer's mental state is not relevant for purposes of determining liability.<sup>53</sup> In the context of assertions of direct liability,<sup>54</sup> in certain contexts, the courts have imposed

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allegedly infringed material' and that [defendant] 'violate[d] at least one exclusive right granted to' [the copyright owner] under 17 U.S.C. § 106." *VHT, Inc. v. Zillow Grp., Inc.*, 918 F.3d 723, 731 (9th Cir. 2019) (quoting *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1013 (9th Cir. 2001)). Curiously, the cases in which the Ninth Circuit has used that articulation of the test for infringement have involved copying of the entire copyrighted work.

<sup>51</sup> The definition of what constitutes a public performance (*see* 17 U.S.C. § 101) also has spawned significant litigation. *See, e.g.*, *Am. Broad. Cos., v. Aereo, Inc.*, 134 S. Ct. 2498, 2506 (2014).

<sup>52</sup> This is also true if, for example, the plaintiff alleges that a play being performed by a theater company is an infringement of the plaintiff's literary or dramatic work.

<sup>53</sup> 4 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT*, § 13.08 [C][1] (Matthew Bender rev. ed. 2016). *See also*, R. Anthony Reese, *Innocent Infringement in U.S. Copyright Law: A History*, 30 COLUM. J. L. & ARTS 133, 175–183 (2007). Mental state can be relevant in determining remedies once liability has been established. *See id.* at 179–83.

<sup>54</sup> Generally, there are two types of liability for copyright infringement: direct and secondary. *Am. Broad. Companies, Inc. v. Aereo, Inc.*, 573 U.S. 431, 452 (2014) (Scalia dissenting). Direct liability "applies when an actor personally engages in infringing conduct." *Id.* In contrast, secondary liability, "is a means of holding defendants responsible for infringement by third parties, even when the defendants 'have not themselves engaged in the infringing activity.'" *Id.* (quoting *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 435 (1984)). The additional elements of a *prima facie* case alleging secondary liability for copyright infringement are beyond the scope of this Article.

an additional causation element as part of the plaintiff's *prima facie* case. Also referred to as proving "volitional conduct,"<sup>55</sup> this is not an "element of intent or knowledge; it is a basic requirement of causation."<sup>56</sup> In most cases of copyright infringement the volitional-conduct requirement is not at issue.<sup>57</sup> The volitional-conduct requirement is applied when the "direct-infringement claim is lodged against a defendant who does nothing more than operate an automated, user-controlled system."<sup>58</sup> Because our focus is on the basic elements required for proving copyright infringement, we do not address the volitional-conduct element further.<sup>59</sup>

### III. THE PLAINTIFF'S BURDEN OF PROOF IN COPYRIGHT INFRINGEMENT

With the background of burdens of persuasion and production, the three categories of defense arguments, the use of presumptions, the potential for mixed fact/law questions to complicate matters, and the elements of a copyright infringement claim, we now turn to the application of these principles in the context of copyright infringement litigation.

Starting with the plaintiff's *prima facie* case, the Supreme Court has made clear that "a copyright plaintiff bears the burden of proving infringement."<sup>60</sup> Lower courts expressly require the plaintiff to prove all the elements of a *prima facie* infringement claim: that the plaintiff owns a valid copyright and that the defendant copied from the plaintiff's work in a manner that constitutes improper appropriation.<sup>61</sup>

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<sup>55</sup> Perfect 10, Inc. v. Giganews, Inc., 847 F.3d 657, 666 (9th Cir. 2017), *cert. denied*, 138 S. Ct. 504 (2017).

<sup>56</sup> *Id.*; see also Fox Broad. Co. v. Dish Network L.L.C., 747 F.3d 1060, 1067 (9th Cir. 2014) (holding that infringement "requires 'copying by the defendant,' which comprises a requirement that the defendant cause the copying").

<sup>57</sup> Am. Broad. Companies, Inc. v. Aereo, Inc., 573 U.S. 431, 454 (2014) (Scalia, J. dissenting) (noting that "volitional-conduct requirement is not at issue in most direct-infringement cases").

<sup>58</sup> VHT, Inc. v. Zillow Grp., Inc., 918 F.3d 723, 732 (9th Cir. 2019).

<sup>59</sup> For an exploration of the topic of causation in infringement litigation, see Mark Bartholomew & Patrick F. McArdle, *Causing Infringement*, 64 VAND. L. REV. 675, 676 (2011).

<sup>60</sup> Petrella v. Metro-Goldwyn-Mayer, Inc., 134 S. Ct. 1962, 1976 (2014).

<sup>61</sup> See, e.g., 9TH CIR. JURY INSTR. 3.1 § 17.0 (2007) ("The plaintiff has the burden of proving by a preponderance of the evidence that the plaintiff is the owner of the copyright and that the defendant copied original elements of the copyrighted work."); *Id.* § 17.5 ("On the plaintiff's copyright infringement claim, the plaintiff has the burden of proving both of the following by a preponderance of the evidence: 1. the plaintiff is the owner of a valid copyright; and 2. the defendant copied original elements from the copyrighted work."). The plaintiff alleging copyright infringement will need to carry its burden of proving the *prima facie* elements of infringement whether the plaintiff is alleging direct infringement or is alleging that the defendant is secondarily liable for infringement. When the plaintiff pursues a secondary liability theory against a defendant, the plaintiff must prove all of the elements of the vicarious liability or contributory infringement

#### A. Plaintiff Owns a Valid Copyright

The first element of a plaintiff's *prima facie* infringement claim is showing that the plaintiff owns a copyright in the work (or owns the particular exclusive right that is allegedly infringed) and that the copyright is valid. This section first explains the *prima facie* evidentiary value of a timely certificate of registration in proving this element, and then looks more closely at proving ownership and proving validity. Arguments that a defendant can make to rebut the plaintiff's *prima facie* claim to own a valid copyright are considered in Part IV.A, below.

##### 1. Registration Certificate as Prima Facie Evidence of Ownership of a Valid Copyright

Proving the first element of an infringement claim—ownership of a valid copyright—is often done, at least initially, by introducing into evidence a certificate of copyright registration. The Copyright Act provides that a certificate of registration made “before or within five years after first publication of work shall constitute *prima facie* evidence of the validity of the copyright and of the facts stated in the certificate.”<sup>62</sup> The certificate of registration will identify the work’s author and copyright owner.<sup>63</sup> In the vast majority of infringement actions, the copyright owner will have a certificate of registration to offer into evidence because to institute an infringement action a copyright owner generally must have registered a claim of copyright in the work.<sup>64</sup> However, not all registration certificates will be made

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claim in addition to proving that the direct infringer has infringed. *See, e.g., id.* § 17.20; *id.* § 17.21.

<sup>62</sup> 17 U.S.C. § 410(c) (2012).

<sup>63</sup> While the registration certificate will generally identify the owner of the copyright at the time of the registration, that owner may be a different person or entity from the plaintiff bringing the infringement claim because the owner listed in the registration certificate may have transferred the copyright to the plaintiff. In that scenario, while the registration certificate constitutes *prima facie* evidence of the *validity* of the copyright at issue, the certificate will not make out a *prima facie* case of the *plaintiff's ownership* of the copyright, because the facts stated in the certificate will not indicate that the plaintiff owns the copyright. Instead, the plaintiff will need to offer additional evidence beyond the certificate to prove ownership.

<sup>64</sup> 17 U.S.C. § 411. A plaintiff can also sue when the Copyright Office has refused to register the claim, as long as the plaintiff serves the Register of Copyrights with a copy of the complaint. *Id.* While the statute makes clear that registration or refusal of registration is a precondition to suit, the Supreme Court has clarified that the requirement is not jurisdictional in nature. *Reed Elsevier, Inc. v. Muchnick*, 559 U.S. 154 (2010). The Supreme Court also recently made clear that a plaintiff must obtain the certificate of registration (or a refusal) before filing suit. *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881 (2019). The requirement that registration be made or refused as a prerequisite to instituting an infringement action applies to claims of infringement of copyright “in any United States work.” 17 U.S.C. § 411. Whether a work is a “United States work” turns principally on the place of the work’s publication or the nationality of the work’s authors. *Id.* § 101 (defining “United States work”). Most of the reported copyright infringement litigation in U.S. courts appears to involve United States works to which

within the period required for the certificate to constitute *prima facie* evidence. Those later registrations may still be used as evidence, although they lack presumptive value. Instead, the statute indicates that “[t]he evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.”<sup>65</sup>

### *2. Copyright Ownership*

As identified above, one component of the first element of the *prima facie* case of infringement is ownership. Courts have made clear that plaintiffs alleging copyright infringement bear the burden of proving that they own the copyrights at issue.<sup>66</sup> The plaintiff must provide evidence that supports the conclusion that the plaintiff owns the copyright (or the particular exclusive right) that the defendant is alleged to have infringed. As just noted, introduction of a timely registration certificate showing the plaintiff’s ownership can satisfy the plaintiff’s burden. In many instances, however, a registration certificate (timely or not) will not be evidence of the plaintiff’s ownership because the certificate does not list the plaintiff as owner (if, for example, the plaintiff acquired copyright ownership through a post-registration transfer of ownership). In such a situation, the plaintiff will need to introduce evidence beyond the registration certificate demonstrating plaintiff’s ownership (such as, for example, documentation of the transfer of ownership from the author or through a longer chain of title). Once the plaintiff has come forward with sufficient evidence of ownership (whether in the form of a timely registration certificate or other evidence), the defendant may come forward with evidence of its own to rebut the plaintiff’s showing. But because showing ownership is part of the *prima facie* case of infringement, the burden of persuasion on the element of ownership of the copyright in the work allegedly infringed remains with the plaintiff.<sup>67</sup>

### *3. Copyright Validity*

The second component of the first element of the *prima facie* case of copyright infringement requires the plaintiff to demonstrate that the copyright alleged to have

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the registration prerequisite applies.

<sup>65</sup> 17 U.S.C. § 410(c). Congress limited the *prima facie* evidentiary value of a certificate of registration to situations where registration was made within five years after the work’s first publication “based on a recognition that the longer the lapse of time between publication and registration the less likely to be reliable are the facts stated in the certificate.” H.R. REP. NO. 94-1476, at 156 (1976).

<sup>66</sup> See, e.g., *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958, 962 (9th Cir. 2011) (“Fleischer bears the burden of proving copyright ownership.”); *Litchfield v. Spielberg*, 736 F.2d 1352, 1355 (9th Cir. 1984) (“To prove copyright infringement, the plaintiff must show . . . ownership of the copyright . . . .”); see also 7TH CIR. JURY INSTR. § 12.2.1 (2017); 9TH CIR. JURY INSTR. § 17.1 (2017); 11TH CIR. JURY INSTR. § 9.12 (2018).

<sup>67</sup> See *supra* Part I.A discussing shifting the burden of production but not the burden of persuasion.

been infringed is valid. When the plaintiff uses a timely certificate of registration to trigger the statutory presumption of validity, the burden of producing evidence regarding validity shifts to the defendant to rebut the presumption.<sup>68</sup> Without a certificate of registration, the plaintiff will need to offer other evidence in order to demonstrate the fundamental requirements of copyright validity: that the work is fixed and that it qualifies as “an original work of authorship.”<sup>69</sup> Often plaintiffs seek to establish these key elements by introducing a copy of the work itself.

Courts are divided about whether the copyrightability of a plaintiff’s work is a question of law or fact.<sup>70</sup> The Supreme Court has not weighed in on the question.<sup>71</sup> The Ninth Circuit has held that “[w]hether a particular [work] is protected by copyright law is a mixed question of law and fact.”<sup>72</sup> In many cases, this is likely the correct way to view the issue of copyrightability. If the question is whether the work is an original work of authorship fixed in a tangible medium of expression, then the historical facts necessary for deciding that question may be contained entirely within a copy of the work itself, with the question whether the work meets the minimal creativity threshold for originality being a legal one.

Depending on the case, however, there may be factual issues regarding validity that must be resolved by the finder of fact. For example, prior to March 1, 1989, every published copy of a work of authorship had to bear a proper copyright notice in order to obtain or maintain a copyright in the work (or, in some circumstances, the omission of, or errors in, a copyright notice had to be cured in a timely manner).<sup>73</sup> In many instances, factual evidence will be necessary to determine whether these formalities were properly complied with such that the copyright in the work is valid.

Even as to a work’s originality, proving the validity of the work’s copyright may require evidence. For example, the validity of the copyright may turn on the circumstances of creation of the work. Because the originality required for copyrightability involves not just that the work is minimally creative but also that the work was independently created and not copied from some other work, a factual dispute concerning whether the plaintiff copied some other work must be addressed by a

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<sup>68</sup> See, e.g., *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 109 (2d Cir. 2001) (defendant “bears the burden of proving the invalidity of a registered copyright” (citing *Hamil Am., Inc. v. GFI, Inc.*, 193 F.3d 92, 98 (2d Cir. 1999))).

<sup>69</sup> 17 U.S.C. § 102(a) (2012).

<sup>70</sup> *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 480 (6th Cir. 2015) (noting courts are divided as to whether copyrightability is a question of law or fact); *Gaiman v. McFarlane*, 360 F.3d 644, 648–49 (7th Cir. 2004) (same).

<sup>71</sup> *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1353 n.3 (Fed. Cir. 2014).

<sup>72</sup> *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1073 (9th Cir. 2000).

<sup>73</sup> NIMMER & NIMMER, *supra* note 53, § 7.13.

finder of fact.<sup>74</sup> Courts have also acknowledged that in the context of the complicated area of “useful articles,” there may be cases where “[t]he determination whether a [work] is a pictorial, graphic, or sculptural work, and not an uncopyrightable [design of a] ‘useful article’ is a fact-intensive one . . .”<sup>75</sup>

#### B. Defendant Copied the Plaintiff’s Copyrighted Work (*Copying in Fact*)

The Supreme Court has specified that the plaintiff must prove “copying of constituent elements of the work that are original.”<sup>76</sup> Lower courts have unpacked that crisp statement of this aspect of *prima facie* infringement. For example, the Tenth Circuit has described analyzing whether the defendant “unlawfully appropriated protected portions of the copyrighted work” as involving

two separate inquiries: 1) whether the defendant, as a factual matter, copied portions of the plaintiff’s [copyrighted work]; and 2) whether, as a mixed issue of fact and law, those elements of the [copyrighted work] that have been copied are protected expression and of such importance to the copied work that the appropriation is actionable.<sup>77</sup>

Thus, as with the first element of a *prima facie* case, the second element actually involves proving several sub-elements. These two sub-elements are often labeled “copying in fact” and “improper appropriation” with the improper appropriation element involving inquiry into both whether the parts of the plaintiff’s work copied by the defendant are copyrightable and the importance of those copied portions of the work. This Section discusses the copying-in-fact element, and Part III.C discusses improper appropriation.

To prevail on a copyright infringement claim, a plaintiff must prove as a factual matter that the defendant copied from the plaintiff’s copyrighted work. That involves proving that copying occurred and it was the defendant that did the copying.<sup>78</sup> As one court explained,

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<sup>74</sup> See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346–47 (1991).

<sup>75</sup> *Lanard Toys Ltd. v. Novelty, Inc.*, 375 F. App’x 705, 710 (9th Cir. 2010).

<sup>76</sup> *Feist Publ’ns, Inc.*, 499 U.S. at 361.

<sup>77</sup> *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 832 (10th Cir. 1993); see also *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1117 (9th Cir. 2018) (“Although our cases have not always made this point explicit, the second element [announced in *Feist*] has two distinct components: ‘copying’ and ‘unlawful appropriation.’” (citing *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1164–65 (9th Cir. 1977))).

<sup>78</sup> In some instances, the dispute does not concern whether the defendant copied from the plaintiff’s copyrighted work, but rather whether it was the defendant or some other party that engaged in the copying. In these cases, an instance of copying has occurred and the plaintiff has alleged that it was the defendant that engaged in the copying. Unless the copyright owner is asserting a theory of secondary liability, the copyright owner has the burden of proving that the defendant was the one whose actions caused the copy to be created. See *Cobbler Nev., LLC v. Gonzales*, 901 F.3d 1142, 1146 (9th Cir. 2018) (noting difficulty in identifying who made an

[p]roof of copying by the defendant is necessary because independent creation is a complete defense to copyright infringement. No matter how similar the plaintiff's and the defendant's works are, if the defendant created his independently, without knowledge of or exposure to the plaintiff's work, the defendant is not liable for infringement.<sup>79</sup>

"Copying" by a defendant can take different forms. Most obviously, a defendant can manually, mechanically, or digitally produce a new copy of some or all of a copyrighted work. For example, a defendant could write out in longhand an extract of the words printed in the hardcover edition of the plaintiff's novel, or could photocopy some or all of the pages of that novel, or could take a digital photograph of the plaintiff's painting, or could use an audio recorder to record a singer singing the plaintiff's musical work. While the content of these copies might differ somewhat from the plaintiff's work (depending, for example, on the lighting of the digital photograph or the sound quality of the audio recorder), the new material object produced by the defendant (the longhand notes, the photocopies, the photograph, and the audio recording) all embody the plaintiff's work in essentially identical form. In other cases, a defendant copies from the plaintiff's work (even if she does not have a copy of that work in front of her or close at hand) when the defendant creates her own work of authorship and repeats in her own work some elements that she previously encountered in the plaintiff's work.

Whichever type of copying is involved, a plaintiff can, of course, prove the fact of the defendant's copying by direct evidence. Such evidence, though, is usually difficult to find, especially in situations where the defendant has created her own work and the plaintiff alleges that the defendant's work is infringing. As a result, plaintiffs commonly prove copying through circumstantial evidence. Courts have articulated two generally accepted types of circumstantial proof of copying in fact.

The first type involves access and similarity. "When the plaintiff lacks direct evidence of copying, he can attempt to prove it circumstantially by showing that the defendant had access to the plaintiff's work and that the two works share similarities probative of copying."<sup>80</sup> When a plaintiff attempts to prove copying by showing

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infringing copy over the internet when "numerous people live in and visit a facility that uses the same internet service.").

<sup>79</sup> *Rentmeester*, 833 F.3d at 1117 (citing *Feist Publ'n, Inc.*, 499 U.S. at 345–46).

<sup>80</sup> *Id.* (citing *Baxter v. MCA, Inc.*, 812 F.2d 421, 423 (9th Cir. 1987)). Many courts state that the plaintiff must show access and "substantial similarity." *E.g.*, *Peters v. West*, 692 F.3d 629, 633 (7th Cir. 2012) (discussing this terminology issues). That phrasing can cause confusion, however, as courts generally describe the improper appropriation element of a copyright infringement claim as requiring that the plaintiff show that audiences will perceive "substantial similarity" between the protected elements of the plaintiff's work and elements of the defendant's work. *Id.* Professor Alan Latman suggested using the term "probative similarity" to describe the similarity required (together with access) for circumstantial proof of the fact the defendant copied. Alan Latman, "*Probative Similarity*" as Proof of Copying: Toward Dispelling Some Myths in

access and probative similarity, some courts follow an “inverse ratio rule.”<sup>81</sup> Under this rule, the relationship between the degree of proof required to establish each of the two facts is inversely proportional: the court will “require a lower standard of proof on substantial similarity when a high degree of access is shown,”<sup>82</sup> and vice-versa.<sup>83</sup> Not all courts, however, accept this approach.<sup>84</sup>

The second possibility is for the plaintiff simply to show similarities between the plaintiff’s work and the defendant’s work that are “so striking as to preclude the possibility that plaintiff and defendant independently arrived at the same result.”<sup>85</sup> Some courts appear to regard such striking similarities as circumstantial evidence of copying,<sup>86</sup> while other courts appear to regard them as simultaneous evidence of both the access and probative similarities required to prove factual copying circumstantially under the first route,<sup>87</sup> but either view leads to the conclusion that proof of such striking similarity can, standing alone, meet the plaintiff’s burden to show copying.

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*Copyright Infringement*, 90 COLUM. L. REV. 1187, 1190 (1990). Some courts have adopted that terminology, which we use in this Article. *E.g.*, Guzman v. Hacienda Records & Recording Studio, Inc., 808 F.3d 1031, 1037 (5th Cir. 2015); Zalewski v. Cicero Builder Dev., Inc., 754 F.3d 95, 101 (2d Cir. 2014); Peter Letterese & Assocs., Inc. v. World Inst. of Scientology Enters., Int’l, 533 F.3d 1287, 1301 (11th Cir. 2008).

<sup>81</sup> Skidmore v. Zeppelin, 905 F.3d 1116, 1130 (9th Cir. 2018).

<sup>82</sup> Smith v. Jackson, 84 F.3d 1213, 1218 (9th Cir. 1996) (citing Shaw v. Lindheim, 919 F.2d 1353, 1361–62 (9th Cir. 1990)).

<sup>83</sup> Three Boys Music Corp. v. Bolton, 212 F.3d 477, 485 (9th Cir. 2000) (“[I]n the absence of any proof of access, a copyright plaintiff can still make out a case of infringement by showing that the songs were ‘strikingly similar.’”).

<sup>84</sup> *E.g.*, Arc Music Corp. v. Lee, 296 F.2d 186, 187 (2d Cir. 1961) (finding no such principle in federal copyright law). Professor Goldstein argues that in fact the Second Circuit implicitly follows the rule in at least some copyright cases. PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 9.2.1 (3d ed. 2014).

<sup>85</sup> Arnstein v. Porter, 154 F.2d 464, 468 (2d Cir. 1946).

<sup>86</sup> See, e.g., *Three Boys Music Corp.*, 212 F.3d at 485 (“[I]n the absence of any proof of access, a copyright plaintiff can still make out a case of infringement by showing that the songs were ‘strikingly similar.’”).

<sup>87</sup> See, e.g., Ty, Inc. v. GMA Accessories, Inc., 132 F.3d 1167, 1170 (7th Cir. 1997) (“[A] similarity that is so close as to be highly unlikely to have been an accident of independent creation is evidence of access.”); Baxter v. MCA, Inc., 812 F.2d 421, 423 (9th Cir. 1987); Selle v. Gibb, 741 F.2d 896, 901 (7th Cir. 1984) (“If, however, the plaintiff does not have direct evidence of access, then an inference of access may still be established circumstantially by proof of similarity which is so striking that the possibilities of independent creation, coincidence and prior common source are, as a practical matter, precluded. If the plaintiff presents evidence of striking similarity sufficient to raise an inference of access, then copying is presumably proved simultaneously . . . .”).

No matter which route the plaintiff chooses to prove the fact of the defendant's copying, the plaintiff bears the burden of persuasion as to that fact.<sup>88</sup> If the plaintiff offers sufficient evidence to meet its burden of production to show that the defendant did copy from the plaintiff's work, the finder of fact may conclude in the plaintiff's favor on this element. The defendant may counter the plaintiff's contentions with various defense arguments. Part IV.B considers the defendant's burden in such scenarios.

### C. Defendant's Copying Constituted Improper Appropriation

As the Supreme Court has acknowledged, “[n]ot all copying . . . is copyright infringement.”<sup>89</sup> Copyright in a work of authorship does not protect absolutely every element of that work of authorship, and copyright law does not bar anyone from copying any material in a copyrighted work that is not protected by copyright. As a result, an infringement plaintiff must prove not only that the defendant in fact copied from the plaintiff's work, but also as the Court stated in *Feist*, that the defendant copied “constituent elements of the work that are original.”<sup>90</sup> As discussed in Part II.A, the Court's terse statement of this element of an infringement claim actually involves at least two sub-elements: that at least some of the material copied by the defendant from the plaintiff's work was material that is protected by copyright, and that audiences will perceive the copied elements in the defendant's work as substantially similar to the plaintiff's work.

Different circuits employ different tests to determine whether the defendant has engaged in improper appropriation, i.e., (1) that the defendant has copied protected elements from the work<sup>91</sup> and (2) that audiences will perceive substantial similarity between the defendant's work and the protected elements of the plaintiff's

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<sup>88</sup> See, e.g., *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1116 (9th Cir. 2018); *Gen. Universal Sys., Inc. v. Lee*, 379 F.3d 131, 146 (5th Cir. 2004); *Three Boys Music Corp.*, 212 F.3d at 485; *Homan v. Clinton*, No. 98-3844, 1999 WL 430446 (6th Cir. June 14, 1999).

<sup>89</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

<sup>90</sup> *Id.*

<sup>91</sup> As the First Circuit explained:

[A] work that is sufficiently “original” to be copyrighted may nonetheless contain unoriginal elements. *Feist Publ'ns*, 499 U.S. at 348; *see also*, e.g., *Johnson*, 409 F.3d at 18–19. The Supreme Court recently confirmed that “every idea, theory, and fact in a copyrighted work becomes instantly available for public exploitation at the moment of publication.” *Golan v. Holder*, 132 S. Ct. 873, 890 (2012) (quoting *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003)) (internal quotation mark omitted); *see also* *Johnson*, 409 F.3d at 19 (“[C]opyright law protects original expressions of ideas but it does not safeguard either the ideas themselves or banal expressions of them.”). Hence, assessing substantial similarity requires close consideration of which aspects of the plaintiff's work are protectible and whether the defendant's copying substantially appropriated those protected elements. *Johnson*, 409 F.3d at 18–19; *see also* *Soc. of Holy Transfiguration Monastery, Inc. v. Gregory*, 689 F.3d 29, 51 (1st Cir. 2012) (“ ‘No infringement claim

work. Several circuits articulate a clear two-step test: “the first step ‘requires identifying which aspects of the artist’s work, if any, are protectible by copyright,’ [and] the second ‘involves determining whether the allegedly infringing work is “substantially similar” to protectible elements of the artist’s work.’”<sup>92</sup> The Sixth Circuit, which has adopted this approach, describes it as “really just a refinement of the ordinary observer test that, as its initial step, parses from the work the elements neither afforded copyright protection nor properly considered in the ordinary observer test.”<sup>93</sup>

The Ninth Circuit has employed an “intrinsic” and an “extrinsic” test to determine improper appropriation.<sup>94</sup> (The Fourth and Eighth Circuits have also, at times, employed the “intrinsic” and “extrinsic” tests.<sup>95</sup>) To prevail under this approach, a plaintiff must prove substantial similarity under both tests,<sup>96</sup> in addition to proving copying in fact. The extrinsic test assesses the objective similarities of the two works, focusing only on the protectable elements of the plaintiff’s expression.<sup>97</sup> In the extrinsic test, the court first filters out the unprotectable elements of the plaintiff’s work.<sup>98</sup> The court then compares the remaining protectable elements to corresponding elements of the defendant’s work in assessing similarities “in the objective details of the works.”<sup>99</sup> The Ninth Circuit has identified the extrinsic test as one that can be decided by the court as a matter of law.<sup>100</sup> In contrast, “[t]he intrinsic test

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lies if the similarity between two works rests necessarily on non-copyrightable aspects of the original. . . .” (quoting *TMTV Corp. v. Mass Prods., Inc.*, 645 F.3d 464, 470 (1st Cir. 2011)).

*Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 178–79 (1st Cir. 2013) (footnote omitted).

<sup>92</sup> *Kohus v. Mariol*, 328 F.3d 848, 855 (6th Cir. 2003) (quoting *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1295 (D.C. Cir. 2002)); *see also* *Boisson v. Banian, Ltd.*, 273 F.3d 262, 267–68 (2d Cir. 2001); *Concrete Mach. Co., v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606 (1st Cir. 1988).

<sup>93</sup> *Stromback v. New Line Cinema*, 384 F.3d 283, 294 (6th Cir. 2004).

<sup>94</sup> *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 2000).

<sup>95</sup> *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)).

<sup>96</sup> *Funky Films, Inc. v. Time Warner Entm’t Co.*, 462 F.3d 1072, 1077 (9th Cir. 2006).

<sup>97</sup> *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002).

<sup>98</sup> *Id.* at 822–23 (noting the unprotected elements include ideas and concepts, material in the public domain, and *scènes à faire* elements).

<sup>99</sup> *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1118 (9th Cir. 2018).

<sup>100</sup> *McCulloch v. Albert E. Price, Inc.*, 823 F.2d 316, 319 (9th Cir. 1987). It may be that even the extrinsic test is a mixed question of law and fact. *See Rentmeester*, 833 F.3d at 1121 (discussing the application of the extrinsic test to the facts at bar and indicating that, if the facts were different, it would be appropriate to permit the jury to find unlawful appropriation).

requires a more holistic, subjective comparison of the works to determine whether they are substantially similar in ‘total concept and feel.’”<sup>101</sup>

The Ninth Circuit also has articulated the two elements of improper appropriation in a way that more closely aligns to the approach employed in other circuits:

Proof of unlawful appropriation—that is, *illicit* copying—is necessary because copyright law does not forbid all copying. The Copyright Act provides that copyright protection does not “extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in [the copyrighted] work.” 17 U.S.C. § 102(b). Thus, a defendant incurs no liability if he copies only the “ideas” or “concepts” used in the plaintiff’s work. To infringe, the defendant must also copy enough of the plaintiff’s expression of those ideas or concepts to render the two works “substantially similar.”<sup>102</sup>

This Section turns to examining how a plaintiff can prove these elements. Part IV.C addresses defense arguments that a defendant might make to counter the plaintiff’s showing.

### *1. Defendant Copied Protected Expression*

Even if a plaintiff establishes that its work is copyrighted and that the defendant copied from the work, infringement also requires showing that the defendant copied elements protected by the plaintiff’s copyright. As the Supreme Court has explained, “[t]he mere fact that a work is copyrighted does not mean that every element of the work may be protected.”<sup>103</sup> The plaintiff will therefore have to establish that at least some of the elements that the defendant copied were protected. Because copyright law uses the label “expression” to identify protected elements of a work and to distinguish them from unprotected elements which are labeled as “ideas,”<sup>104</sup> this element of the plaintiff’s *prima facie* case is often identified as showing that the defendant copied protected expression. As one court put it, “[i]f the copied parts are not, on their own, protectable expression, then there can be no claim for infringement.”<sup>105</sup>

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<sup>101</sup> *Rentmeester*, 833 F.3d at 1118 (quoting *Cavalier*, 297 F.3d at 822).

<sup>102</sup> *Id.* at 1117 (alteration in original) (quoting *Mattel, Inc. v. MGA Ent’mt, Inc.*, 616 F.3d 904, 913–14 (9th Cir. 2010)).

<sup>103</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991).

<sup>104</sup> See, e.g., *GOLDSTEIN*, *supra* note 84, § 2.3.1.

<sup>105</sup> *Peters v. West*, 692 F.3d 629, 632 (7th Cir. 2012) (citing *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 61 (2d Cir. 2010)); see also *Gottlieb Dev. LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625, 631 (S.D.N.Y. 2008) (“When similar works resemble each other only in unprotected aspects—for example, when similarities inhere in ideas, which are by definition unprotected, or in expression that is not proprietary to plaintiff—the defendant prevails.” (citing *Bill Diodato Photography, LLC v. Kate Spade, LLC*, 388 F. Supp. 2d 382, 390 (S.D.N.Y. 2005))). The Sixth Circuit has held “it is a constitutional requirement that a

The plaintiff generally meets its burden on this element by introducing into evidence the plaintiff's and the defendant's works, identifying the similarities between them, and identifying which of those similarities are similarities of protected expression.<sup>106</sup> This element "will sometimes require the plaintiff to dissect the two works—separating protected, original expression from unprotectible ideas—to show that the defendant took more than just unprotectible elements."<sup>107</sup>

## 2. Substantial Similarity

The inquiry into substantial similarity is, in some ways, the heart of many infringement cases.<sup>108</sup> While using the similarity between the plaintiff's and defendant's works as circumstantial evidence to prove copying in fact usually also requires considering whether the defendant had access to the plaintiff's work, in the improper appropriation prong of the *prima facie* case, the issue of access is irrelevant. Even courts that follow the inverse-ratio rule to evaluate similarity in deciding whether the plaintiff has proven copying in fact will not, in the improper appropriation analysis, allow the plaintiff to show a lesser degree of similarity when the plaintiff has offered very strong evidence of access.<sup>109</sup>

Substantial similarity is a question of fact.<sup>110</sup> The plaintiff generally meets its burden to prove the substantial similarity aspect of the improper appropriation element of a *prima facie* case of copyright infringement by introducing into evidence

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plaintiff bringing an infringement claim must prove 'copying of constituent elements of the work that are original.'" *Kohus v. Mariol*, 328 F.3d 848, 853 (6th Cir. 2003) (quoting *Feist*, 499 U.S. at 361) (emphasis in original).

<sup>106</sup> Significantly, this differs from identifying the similarities that the plaintiff claims are probative of the fact that the defendant copied from the plaintiff's works, since those probative similarities can be similarities of either protected or unprotectible elements (or both).

<sup>107</sup> GOLDSTEIN, *supra* note 84, § 9.3.1.

<sup>108</sup> A full exploration of the various articulations of the tests for substantial similarity is beyond the scope of this Article. Others have examined, and critiqued various approaches to the substantial similarity question. See, e.g., Christopher Jon Sprigman, *Reforming Copyright's Infringement Standard*, 25 LEWIS & CLARK L. REV. 571 (2019); Pamela Samuelson, *A Fresh Look at Tests for Nonliteral Copyright Infringement*, 107 NORTHWESTERN U. L. REV. 1821 (2013); Shyamkrishna Balganesh, *The Normativity of Copying in Copyright Law*, 62 DUKE L.J. 203 (2012); Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright*, 125 HARV. L. REV. 683, 751–52 (2012); Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 J. COPYR. L. SOC'Y 719 (2010).

<sup>109</sup> See, e.g., *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1124 (9th Cir. 2018) ("The showing of substantial similarity necessary to prove unlawful appropriation does not vary with the degree of access the plaintiff has shown." (citing *Peters*, 692 F.3d at 635)); *Positive Black Talk, Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 372 n.11 (5th Cir. 2004); 3 PATRY ON COPYRIGHT § 9:91.

<sup>110</sup> *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1296 (D.C. Cir. 2002); *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210, 1213 (11th Cir. 2000); *Hochling v. Universal City Studios, Inc.*, 618 F.2d 972, 977 (2d Cir. 1980).

a copy of the plaintiff's copyrighted work and a copy of the defendant's allegedly infringing work and identifying what the plaintiff alleges are the substantial similarities of protected expression between the two works.

Many statements of the standard simply repeat the requirement of substantial similarity.<sup>111</sup> Other opinions indicate that the copying must be both "quantitatively and qualitatively sufficient to support the legal conclusion that infringement . . . has occurred."<sup>112</sup> The varying ways that courts articulate the test for substantial similarity raise different aspects of what the plaintiff must demonstrate.

First, the quantity of original expression copied must be sufficient. When discussing the quantity of copying, courts set the threshold at "more than de minimis."<sup>113</sup> This threshold stems from the legal maxim *de minimis non curat lex*—"the law does not concern itself with trifles."<sup>114</sup> Applying the requirement that the defendant's copying be more than de minimis will vary from case to case. For example, if the defendant's allegedly infringing work is a motion picture, the analysis could involve an examination of the length of time the plaintiff's copyrighted work is observable in the film, as well as factors such as focus, lighting, camera angles, and prominence.<sup>115</sup> Because the law will permit some literal copying of small and insignificant portions of the plaintiff's work, part of what a plaintiff must demonstrate is that the copying engaged in by the defendant is more than de minimis.<sup>116</sup>

In addition to demonstrating that the copying of copyrightable elements was more than de minimis, courts have also held that substantial similarity is judged through the eyes (or ears) of an ordinary observer. Most cases determine whether audiences will perceive substantial similarity between the protected elements of the plaintiff's work and copied elements in the defendant's work by looking to the reactions of an ordinary observer of the work and by viewing the finder of fact as a proxy for the work's audience.<sup>117</sup> However, several circuit courts have indicated that

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<sup>111</sup> See, e.g., *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 178 (1st Cir. 2013) ("The copying must be sufficiently 'extensive that it render[s] the infringing and copyrighted works 'substantially similar.' (alteration in original) (quoting *Johnson v. Gordon*, 409 F.3d 12, 18 (1st Cir. 2005))).

<sup>112</sup> *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70, 75 (2d Cir. 1997).

<sup>113</sup> E.g., *Tufenkian Import/Export Ventures, Inc. v. Einstein Moonjy, Inc.*, 338 F.3d 127, 131 (2d Cir. 2003) (quoting *Castle Rock Entm't, Inc. v. Carol Publ'g Group, Inc.*, 150 F.3d 132, 137–38 (2d Cir. 1998)); *Gottlieb Dev. LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625, 631 (S.D.N.Y. 2008).

<sup>114</sup> *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2004).

<sup>115</sup> *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 217 (2d Cir. 1998).

<sup>116</sup> See *Warner Bros. Inc. v. Am. Broad. Cos., Inc.*, 720 F.2d 231, 242 (2d Cir. 1983); see also *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).

<sup>117</sup> See, e.g., *Murray Hill Publ'n, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312,

where the intended audience for the plaintiff's work is not the general public but a specialized audience, the issue of substantial similarity should be determined from the perspective of that specialized audience.<sup>118</sup> For example, where the work is primarily intended for an audience of young children, the ultimate question should be whether such children would view the similarities of expression in the parties' works as substantial.<sup>119</sup> In such cases, it may be necessary for the parties to introduce evidence (often in the form of expert testimony) regarding the actual or likely reactions of members of the work's intended audience, given that the judge or the jury is not a good proxy for that audience.

#### IV. COUNTERING THE PRIMA FACIE CASE WITH PRIMA FACIE REBUTTALS

Once the plaintiff has introduced evidence that it believes satisfies its burden of proof on all of the elements of its infringement claim, the defendant can respond to the case that the plaintiff has put forward. In some instances, the response will take the form of a true affirmative defense, on which the defendant bears the burdens of production and persuasion. An affirmative defense can be understood as an assertion by the defendant that, even if the plaintiff has successfully met its burden of proof on every element of its infringement claim, the plaintiff nonetheless is not entitled to prevail because the defendant can meet its burden to establish the defense. Part V discusses affirmative defenses.

In many instances, however, the defendant's response to the plaintiff's case will not be an affirmative defense, but rather arguments that rebut the plaintiff's prima facie case. These arguments can best be understood as assertions by the defendant that the plaintiff has not successfully met its burden of proof on some element or elements of its infringement claim and therefore is not entitled to prevail. Courts sometimes label some of these arguments as "affirmative defenses," but this label is not technically correct: the defendant is not asserting a defense that shields it from liability even if the plaintiff successfully establishes a prima facie claim, but rather is demonstrating that the plaintiff has not actually satisfied the *plaintiff's* own burden of proof. This part discusses those types of defense arguments, which we have labelled "rebuttals" to distinguish them from true affirmative defenses.

As discussed above, such rebuttals can be classified as prima facie factual rebuttals or prima facie legal rebuttals. A prima facie factual rebuttal counters the facts

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321 (6th Cir. 2003).

<sup>118</sup> E.g., *Kohus v. Mariol*, 328 F.3d 848, 857 (6th Cir. 2003); *Lyons P'ship, L.P. v. Morris Costumes, Inc.*, 243 F.3d 789, 801 (4th Cir. 2001); *Dawson v. Hinshaw Music Inc.*, 905 F.2d 731, 733 (4th Cir. 1990); *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1166 (9th Cir. 1977).

<sup>119</sup> See, e.g., *Lyons P'ship, L.P.*, 243 F.3d at 801; *Sid & Marty Krofft Television Prods., Inc.*, 562 F.2d at 1166.

that the plaintiff has asserted are established by the plaintiff's evidence. Essentially, the defendant is arguing that the facts asserted by the plaintiff are inaccurate or incomplete. To make a *prima facie* factual rebuttal, the defendant generally needs to introduce evidence that supports the defendant's asserted version of the facts. If the defendant makes a *prima facie* factual rebuttal, then the fact-finder will have to evaluate both parties' evidence to determine whether, in light of all the evidence, the plaintiff has established, by a preponderance of the evidence, the facts necessary to the elements of the plaintiff's claim. The burden of persuasion for making this determination remains on the plaintiff.

A *prima facie* legal rebuttal counters the legal conclusion to be drawn from the facts that the plaintiff has asserted are established by the plaintiff's evidence. Unlike *prima facie* factual rebuttals, a *prima facie* legal rebuttal in many instances will not involve introducing any additional evidence beyond that introduced by the plaintiff, but rather will involve arguing how and why the plaintiff's evidence does not satisfy the legal standard for establishing an element of the plaintiff's *prima facie* claim.

This Part discusses defense rebuttals to each of the elements of the plaintiff's *prima facie* infringement claim.

#### *A. Rebutting the Plaintiff's Ownership of a Valid Copyright*

##### *1. Rebutting the Presumption Created by a Timely Registration Certificate*

As noted above, courts have interpreted the statutory provision giving a timely registration certificate *prima facie* evidentiary value as creating a rebuttable presumption.<sup>120</sup> As a result, when the plaintiff introduces such a certificate into evidence, the burden of production formally shifts to the defendant<sup>121</sup> to come forward with evidence that either casts doubt on the validity of the registration itself or puts the plaintiff's *prima facie* proof of either component of the first element of the in-

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<sup>120</sup> See, e.g., *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989); see also *Hi-Tech Video Prods., Inc. v. Capital Cities/ABC, Inc.*, 58 F.3d 1093, 1095 (6th Cir. 1995); *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 668 (3d Cir. 1990); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 908 (2d Cir. 1980) ("[A] certificate of registration creates no irrebuttable presumption of copyright validity. Where other evidence in the record casts doubt on the question, validity will not be assumed."). Unlike an issued patent, where the statutory presumption of validity requires clear and convincing evidence to overcome, *Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91, 95 (2011), courts have only required a preponderance of the evidence to rebut the *prima facie* validity of a copyright registration certificate.

<sup>121</sup> *Code Revision Commission v. Public.Resource.org*, 906 F.3d 1229, 1236 (11th Cir. 2018) (identifying that "[o]nce the plaintiff has produced a valid copyright registration, the burden shifts to the defendant to establish that the copyright is invalid").

fringement claim into question. This reading is consistent with Federal Rule of Evidence 301<sup>122</sup> and with the Copyright Act's legislative history, which states that "endowing a copyright claimant who has obtained a certificate with a rebuttable presumption of the validity of the copyright does not deprive the defendant in an infringement suit of any rights; it merely orders the burdens of proof. The plaintiff should not ordinarily be forced in the first instance to prove all of the multitude of facts that underline the validity of the copyright unless the defendant, by effectively challenging them, shifts the burden of doing so to the plaintiff."<sup>123</sup>

If the plaintiff introduces a timely registration certificate, the defendant may nevertheless be able to defeat the presumption the certificate creates. Several courts have explained this presumption as based upon an initial deference to the expertise of the Copyright Office in having determined, based on the facts stated in the application for registration, that the work sought to be registered was copyrightable.<sup>124</sup> Consequently, one way to attack the validity of the certificate of registration is to assert that the copyright owner knowingly misled the Copyright Office in order to obtain the registration certificate.<sup>125</sup> A defense argument that seeks to invalidate the registration certificate technically would not rebut the presumption which a valid and timely registration certificate creates. Rather, invalidating the registration certificate removes the presumption completely, forcing the plaintiff to prove ownership and validity without the aid of any *prima facie* evidentiary value provided by the certificate.<sup>126</sup>

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<sup>122</sup> See *supra* note 30; see also *St. Mary's Honor Ctr. v. Hicks*, 509 U.S. 502, 511 (1993).

<sup>123</sup> H.R. REP. NO. 94-1476, at 157 (1976).

<sup>124</sup> See, e.g., *Garcia v. Google, Inc.*, 786 F.3d 733, 741 (9th Cir. 2015); *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 286 n.5 (3d Cir. 2004); see also 2 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 7.16[B][3][b][vi] (Matthew Bender rev. ed. 2017). But see H.R. Rep. No. 94-1476 at 157 ("It is true that, unlike a patent claim, a claim to copyright is not examined for basic validity before a certificate is issued.").

<sup>125</sup> See *Eckes v. Card Prices Update*, 736 F.2d 859, 861–62 (2d Cir. 1984) ("[T]he knowing failure to advise the Copyright Office of facts which might have occasioned a rejection of the application constitute[s] reason for holding the registration invalid and thus incapable of supporting an infringement action . . . ." (quoting *Russ Berrie & Co., Inc. v. Jerry Elsner Co.*, 482 F. Supp. 980, 988 (S.D.N.Y. 1980)) (alteration in original)). Section 411(b) of the Copyright Act, added to the statute in 2008, P.L. 110-403, 122 Stat. 4257 (2008), requires a court to request the views of the Register of Copyrights when it is alleged that a registrant knowingly provided inaccurate information in an application for registration and that the Register would have refused registration if the inaccuracy of the registration were known. It is unclear from the statute's language whether the requirements of § 411(b) apply when a defendant challenges the *prima facie* evidentiary value of a registration certificate rather than challenging the registration as a prerequisite for instituting the infringement suit (or for the availability of certain remedies under § 412).

<sup>126</sup> *Durham Indus., Inc.*, 630 F.2d at 908. Presumably if the registration is invalidated, the certificate no longer offers any evidentiary value as an official document, since § 410(c)'s provision giving the court discretion to determine the evidentiary value of a registration that does not have

When a plaintiff seeks to rely on the presumption created by the registration certificate, a defendant might instead attempt to attack the certificate's presumptive effect by demonstrating that the certificate is untimely. A registration certificate is *prima facie* evidence of ownership and validity only if registration is made "before or within five years after first publication of the work."<sup>127</sup> Although the certificate itself may indicate that first publication occurred less than five years before registration was made, the defendant might introduce evidence showing that first publication actually occurred more than five years before registration was made. Unlike evidence that the applicant knowingly misled the Copyright Office in order to obtain the registration, evidence that the registration was untimely might not invalidate the registration certificate,<sup>128</sup> but it would deprive the certificate of the *prima facie* evidentiary value accorded to a timely certificate and thus deprive the plaintiff of the presumption that a timely certificate automatically triggers. In some instances, a claim of untimeliness would be a *prima facie* factual rebuttal that would turn only on the resolution of a dispute of historical fact as to the date on which first publication occurred. In other instances, an untimeliness claim could involve a mixed question of law and fact, since it might require statutory interpretation to determine what constitutes "first publication" as that term is used in the Copyright Act before applying that interpretation to the historical facts.<sup>129</sup>

Even if a defendant does not seek to invalidate the plaintiff's timely registration certificate, the defendant may still seek to rebut the presumption the certificate creates that the plaintiff owns the copyright and that the copyright is valid. Similarly, if the plaintiff has sought to demonstrate its ownership of a valid copyright through evidence other than a certificate of registration, the defendant may seek to counter that evidence. In the former situation, the presumption arising from the plaintiff's timely registration certificate will shift the burden of production to the defendant,

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*prima facie* evidentiary significance appears only to apply to a valid certificate of a registration made more than five years after the work's first publication. Additionally, without a valid registration, the plaintiff fails the prerequisite for instituting a copyright infringement lawsuit involving United States works. 17 U.S.C. § 411 (2012). For a definition of which works are "United States works," see *id.* § 101.

<sup>127</sup> 17 U.S.C. § 410(c).

<sup>128</sup> Any inaccuracy in the first publication date listed in the application might not have been included knowingly, and even a knowing inaccuracy might not have caused the Copyright Office to refuse registration. *See Roberts v. Gordy*, 877 F.3d 1024, 1029 (11th Cir. 2017) (discussing the effect of errors in an application and the scienter necessary for invalidating a registration).

<sup>129</sup> *See* 17 U.S.C. § 101 (2012) (defining "publication"). Courts have had difficulty with the legal standards for what constitutes publication; *see, e.g.*, *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*, 194 F.3d 1211, 1214 (11th Cir. 1999) (interpreting whether the "I Have a Dream" speech delivered by Martin Luther King on the mall in Washington D.C. constituted publication).

so that the defendant will need to come forward with evidence supporting its rebuttal.<sup>130</sup> In the latter situation, while the burden of production may not have formally shifted to the defendant, the defendant may still want to introduce evidence to support a *prima facie* factual rebuttal of the plaintiff's proof. The next two sections address the types of arguments a defendant may assert in seeking to rebut the plaintiff's evidence as to ownership and validity.

## *2. Rebutting Plaintiff's Copyright Ownership*

As noted above, a copyright infringement plaintiff bears the burden of proving that it owns the copyright at issue, meaning that the plaintiff must initially offer evidence of its ownership and that the burden of persuasion on the issue of ownership always remains with the plaintiff. But once the plaintiff has come forward with sufficient evidence of ownership to satisfy its burden, the defendant may come forward with arguments or evidence of its own to challenge the plaintiff's showing.

Attempts to demonstrate that the copyright in the work is not owned by the plaintiff, despite what the certificate of registration says or what plaintiff's evidence may indicate, can take many forms. For example, the registration certificate might identify the plaintiff as the owner of the work by virtue of being one of the work's co-authors under the joint work provisions of the Copyright Act, but the defendant may have evidence that the plaintiff did not, in fact, contribute any authorship to the work and therefore did not qualify as a co-author (and co-owner) of the work.<sup>131</sup> Defendant's introduction of evidence seeking to establish the plaintiff's lack of contribution to the authorship of the work is a *prima facie* factual rebuttal because authorship is generally viewed as a question of fact.<sup>132</sup>

Other examples of *prima facie* factual rebuttals to the plaintiff's showing of copyright ownership involve transfers of ownership. For example, the defendant might assert that, while the plaintiff may have owned the copyright at the time the registration was made (or at a later time as demonstrated by the plaintiff's other evidence), the plaintiff later transferred ownership to someone else and thus the plaintiff is no longer the copyright owner. Evidence introduced by the defendant may put the question of plaintiff's current ownership in doubt. With evidence from both parties, the fact-finder would then need to determine whether the plaintiff has met its burden of proof on the element of ownership. If the plaintiff is not the

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<sup>130</sup> *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 668 (3d Cir. 1990) ("The burden on the defendant to rebut the presumption varies depending on the issue bearing on the validity of the copyright.").

<sup>131</sup> 17 U.S.C. § 201(a) ("The authors of a joint work are coowners of copyright in the work"); *id.* § 101 (defining "joint work"). Several circuit courts have held that being an "author" of a joint work requires contributing copyrightable expression. *See, e.g.*, *Aalmuhammed v. Lee*, 202 F.3d 1227, 1228 (9th Cir. 2000); *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1062 (7th Cir. 1994); *Childress v. Taylor*, 945 F.2d 500, 501 (2d Cir. 1991).

<sup>132</sup> *See S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1086 (9th Cir. 1989).

copyright owner named on the registration certificate but has introduced evidence that the plaintiff acquired ownership of the work's copyright via a written transfer agreement from the work's author, the defendant may offer evidence that the purported transfer was invalid<sup>133</sup> or that the agreement has been terminated by the author.<sup>134</sup> All of these arguments would be *prima facie* factual rebuttals, necessitating that the defendant introduce evidence, but with the burden of persuasion on the element of copyright ownership remaining with the plaintiff.

It is also possible for the issue of ownership to turn on a mixed question of law and fact. For example, one way a party can own a copyright is through the work-made-for-hire doctrine. The statute provides that if the work is a "work made for hire," then the "employer or other person for whom the work was prepared is considered the author . . . and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright."<sup>135</sup> The statute provides two mutually exclusive ways by which a work can be a work made for hire.<sup>136</sup> First, a work prepared by an employee within the scope of that person's employment is a work made for hire.<sup>137</sup> Second, if the person preparing the work is not an employee but rather an independent contractor, then the work is a work made for hire if it fits within one of nine categories of works specified in the statute and if a writing signed by the parties expressly states that the work is a work made for hire.<sup>138</sup> In rebutting a plaintiff's claim that it owns a copyright through the work-made-for-hire doctrine, the defendant may argue that the work allegedly infringed does not fall within any of the statutory categories eligible to be works made for hire when created by an independent contractor. This argument may not require any additional evidence. The copyrighted work will be in the record. The court will have to decide what the statutory language listing the categories means and whether the work comes within one of the enumerated categories. Similarly, if claiming ownership of a work created by an independent contractor as a work made for hire, the plaintiff will have introduced what it asserts is the required signed writing. But if, for example, that signed writing is the independent contractor's endorsement of a check from the hiring party in payment for the creation of the work after that creation has occurred, and the defendant challenges the sufficiency of that writing to

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<sup>133</sup> See, e.g., 17 U.S.C. § 204 (requiring "an instrument of conveyance, or a note or memorandum of the transfer . . . in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent" for a transfer of copyright ownership to be valid); *id.* § 205(d) (establishing rules governing priority between conflicting transfers).

<sup>134</sup> That termination may have occurred pursuant to a termination option in the agreement itself or pursuant the statutory termination right contained in the Copyright Act, even if the agreement did not contemplate any ability to terminate the transfer or license. *Id.* §§ 203, 304(c).

<sup>135</sup> *Id.* § 201(b).

<sup>136</sup> *Id.* § 101 (2012) (defining "work made for hire").

<sup>137</sup> *Id.*

<sup>138</sup> *Id.*

satisfy the statute, then the only issue will be whether that writing meets the statutory requirement that the parties “expressly agree in a written instrument signed by them” that the work will be a work made for hire.<sup>139</sup> These are examples of *prima facie* legal rebuttals that do not require the defendant to introduce any evidence, and they do not change the plaintiff’s burden of persuasion. There is no dispute between the parties as to any facts; the only dispute concerns the interpretation of the statute and the application of the law to the facts. In one sense the outcome on that particular issue does not turn on who bears the burden of proof. However, a court could characterize its ruling as resting on a failure of the plaintiff to carry its burden of proof in the sense that the court has determined that the writing the plaintiff has introduced as evidence of its ownership fails to meet the legal requirement.

### *3. Rebutting the Validity of Plaintiff’s Copyright*

If the plaintiff presents *prima facie* evidence of the validity of the allegedly infringed work’s copyright, then the defendant can seek to demonstrate that the copyright is not valid, either to rebut the presumption arising from a registration certificate or to counter evidence other than the certificate that the plaintiff has introduced when the presumption is unavailable to the plaintiff.<sup>140</sup> The defendant’s challenge to the plaintiff’s evidence of validity could be based on a wide variety of facts or legal arguments.

Some of the arguments that a defendant might make challenging the validity of a plaintiff’s copyright are *prima facie* factual rebuttals that will require the defendant to introduce evidence to support the challenge. For example, the defendant might argue that the plaintiff’s work lacks originality because it was copied from some prior work of authorship.<sup>141</sup> The defendant will generally have to offer some evidence that the plaintiff in fact copied from the prior work, since the originality of a copyrighted work is not negated merely because it is quite similar to a preexisting work.<sup>142</sup> Another possible *prima facie* factual rebuttal is that the work’s copyright

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<sup>139</sup> Compare *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 413 (7th Cir. 1992) (writing must precede creation of work to satisfy statutory requirement), with *Playboy Enters., Inc. v. Dumas*, 53 F.3d 549, 559 (2d Cir. 1995) (if parties agree before work is created that it will be made for hire, the written document manifesting that agreement may be executed after the creation has begun or been completed).

<sup>140</sup> See, e.g., *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 109 (2d Cir. 2001) (“[The defendant] bears the burden of proving the invalidity of a registered copyright . . . .”); *Hamil Am., Inc. v. GFI, Inc.*, 193 F.3d 92, 98 (2d Cir. 1999).

<sup>141</sup> *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 668–69 (3d Cir. 1990) (noting that to overcome the presumption of validity that arises from a certificate of registration, the defendant must “offer[] proof that the plaintiff’s product was copied from other works or similarly probative evidence as to originality.”).

<sup>142</sup> See, e.g., *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936) (“Borrowed the work must indeed not be, for a plagiarist is not himself pro tanto an ‘author’; but

has expired.<sup>143</sup> Some copyright terms run for a fixed period of years from the date of the work's first publication,<sup>144</sup> while other copyright terms run until 70 years after the death of the work's author.<sup>145</sup> If the defendant asserts that the plaintiff's copyright has expired, the defendant will need to introduce evidence to establish the date on which the work was first published or the date on which the author died. Another potential factual rebuttal is that the work is a work of the United States Government because the circumstances of the work's creation demonstrate that it was created by an employee of the United States Government within the scope of that person's official duties.<sup>146</sup>

Other challenges that a defendant might make to the validity of the plaintiff's copyright are *prima facie* legal rebuttals. An assertion by the defendant that the plaintiff's work does not constitute copyrightable subject matter can be purely a legal defense.<sup>147</sup> With purely legal rebuttals, in fact, the presumption that arises from

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if by some magic a man who had never known it were to compose anew Keats's Ode on a Grecian Urn, he would be an 'author,' and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's."). It is unclear whether a defendant asserting that a plaintiff's copyrighted work was not independently created could prove the fact that the plaintiff copied a prior work using the same circumstantial evidence that plaintiffs can use to prove a defendant's factual copying. If so, then a defendant might introduce into evidence a copy of a prior work bearing striking similarities to the plaintiff's work and argue that the similarities are sufficiently striking that they cannot be explained except by concluding that the plaintiff copied from the prior work.

<sup>143</sup> While copyrights do last a long time, they do eventually expire. *See* 17 U.S.C. §§ 302, 303. Additionally, for works published or copyrighted prior to 1964, a renewal registration was required. Failure to timely file the renewal registration caused the copyright in those pre-1964 works to expire after 28 years.

<sup>144</sup> *See id.* § 302(c) (providing that for works created on or after January 1, 1978, "[i]n the case of an anonymous work, a pseudonymous work, or a work made for hire, the copyright endures for a term of 95 years from the year of its first publication, or a term of 120 years from the year of its creation, whichever expires first."); *id.* § 304(a)–(b) (generally providing, for works copyrighted before January 1, 1978, a total copyright term of 95 years from the date copyright was first secured).

<sup>145</sup> *Id.* § 302(a). For joint works, the term runs for 70 years after the death of the last surviving author. *Id.* § 302(b).

<sup>146</sup> *Id.* § 105; *see, e.g.*, Pub. Affairs Assocs., Inc. v. Rickover, 268 F. Supp. 444, 450 (D.C. Cir. 1967) (evaluating whether government official's speeches were created as part of official duties).

<sup>147</sup> *See, e.g.*, Masquerade Novelty, Inc. v. Unique Indus., Inc., 912 F.2d 663, 669 (3d Cir. 1990) ("Where . . . the issue is whether particular articles with certain undisputed characteristics are copyrightable, the defendant need not introduce evidence but instead must show that the Copyright Office erroneously applied the copyright laws in registering plaintiff's articles." (citing Williams Elecs. v. Artic Int'l, Inc., 685 F.2d 870, 871–72 (3d Cir. 1982))); *see also* MANUAL OF MODEL CIVIL JURY INSTRUCTIONS FOR THE DISTRICT COURTS OF THE NINTH CIRCUIT 375 (2017) ("Generally, whether a subject matter is copyrightable is a question of law to be determined by the court.").

a timely certificate of registration may be of little value.<sup>148</sup> Other legal rebuttals might include arguments that the work is an edict of law not subject to copyright protection;<sup>149</sup> that the work is published but doesn't meet the national origin eligibility requirements;<sup>150</sup> that the work is the design of a useful article with no separable pictorial, graphic, or sculptural features; or that copyright in the work has been forfeited.<sup>151</sup> These arguments do not necessarily require the defendant to introduce any evidence. The resolution of these types of defense arguments will turn on how the court applies the law to the established facts, and thus ultimately whether the plaintiff has met its burden of proof.

Certain arguments seeking to invalidate a work's copyright arise specifically in the context of derivative works. A defendant might assert that the plaintiff's allegedly infringed work is a derivative work and might assert at least two reasons why the copyright in that derivative work is invalid. The defendant could assert that the creator of the plaintiff's derivative work did not lawfully use the underlying work on which the derivative work is based.<sup>152</sup> The statute is clear that copyright in a

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<sup>148</sup> Carol Barnhart Inc. v. Econ. Cover Corp., 773 F.2d 411, 414 (2d Cir. 1985) (noting that where the only question is whether certain articles are copyrightable, a court is in as good a position as the Copyright Office to consider this question).

<sup>149</sup> See, e.g., Code Revision Commission v. Public.Resource.org, 906 F.3d 1229 (11th Cir. 2018); Veeck v. S. Bldg. Code Cong. Int'l, Inc., 293 F.3d 791, 799–800 (5th Cir. 2002) (en banc).

<sup>150</sup> This disqualification is rare and could potentially turn on the legal question of whether the United States has copyright relations with the country of the author's domicile or of the work's publication. The Copyright Office circular U.S. COPYRIGHTS OFFICE, INTERNATIONAL COPYRIGHT RELATIONS OF THE UNITED STATES, CIRCULAR 38A, 3 (2019) lists a number of countries as having "unclear" relations. If the Copyright Office, the expert agency charged with administering significant portions of federal copyright law, is unable to determine the status of U.S. copyright relations with a particular country, the court will have to make that determination if it is relevant to deciding the validity of the plaintiff's copyright. See, e.g., N.Y. Chinese TV Programs, Inc. v. U.E. Enters., Inc., 954 F.2d 847, 854 (2d Cir. 1992) (holding that the treaty of friendship, commerce, and navigation with Taiwan is a copyright treaty for purposes of title 17). Or this disqualification could turn instead on fact questions as to where and when a work was published or where author is domiciled.

<sup>151</sup> Until 1989, the Copyright Act required that published copies needed to contain a proper copyright notice. Without the copyright notice (or without a timely cure for the omission of or error in such notice), the publication caused the work to lose copyright protection or to "fall into the public domain." N.Y. Times Co. v. Tasini, 533 U.S. 483, 494 (2001); see, e.g., Estate of Martin Luther King, Jr., Inc. v. CBS, Inc., 194 F.3d 1211, 1214 (11th Cir. 1999) (describing publication without compliance with statutory notice formalities forfeiting the work to the public domain).

<sup>152</sup> Or the defendant might assert that the creator of the plaintiff's derivative work did not have permission from the copyright owner in that underlying work to obtain a copyright on the derivative work. While the existence of authorization from the copyright owner in the underlying work may be proven factually, this argument also involves a purely legal question: is permission from the owner of the copyright in the underlying work needed in order to copyright the derivative

derivative work “does not extend to any part of the work in which such material has been used unlawfully.”<sup>153</sup> Whether that provision invalidates the copyright in the plaintiff’s derivative work could depend on purely factual issues (for example, did the author of the plaintiff’s work in fact have permission from the copyright owner of the underlying work to create the derivative work?) or on legal issues (is the plaintiff’s derivative work a fair use of the copyrighted underlying work so that the plaintiff’s work does not use the underlying work “unlawfully”?).

### B. *Rebutting Copying In Fact*

As noted above, plaintiffs most often seek to prove the fact that the defendant copied from the plaintiff’s work inferentially, through circumstantial evidence showing either (a) access and probative similarity or (b) striking similarity. Once the plaintiff has offered evidence to support its assertion of copying, the defendant can attempt to rebut the plaintiff’s showing.

A defendant might counter the plaintiff’s *prima facie* showing that the defendant copied the plaintiff’s work with a *prima facie* legal rebuttal. For example, the defendant might argue that the plaintiff’s evidence shows only a “bare” or “slight” possibility that the defendant had access to the plaintiff’s work, whereas the law requires the plaintiff to establish a “reasonable possibility” of access.<sup>154</sup> That rebuttal would likely not require the defendant to introduce any further evidence but rather to make a legal argument to the court that the plaintiff’s own evidence—even if it proves the facts asserted by the plaintiff—does not satisfy the legal standard that the

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work? At least one circuit court has held that express permission for obtaining a copyright in the derivative work is not required; it is sufficient that the creator of the derivative work was authorized to create the work (either by the copyright owner of the underlying work or by a statutory provision that would allow the creation of a derivative work). *Shrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 515 (7th Cir. 2009). A provision in the statute concerning musical works is relevant to this question. Section 115 permits the creation of sound recordings of musical works upon payment of a statutory license fee, allowing for a new arrangement of the musical work to be made in the process. But that section expressly prohibits copyright protection for that new arrangement as a derivative work unless “the express consent of the copyright owner” is obtained. 17 U.S.C. § 115(a)(2) (2012). This might be read as supporting the position that express authorization is required to obtain a copyright in a derivative work that has been authorized by the copyright owner in the underlying work, or it might be read as supporting the position that such authorization is not generally required and therefore this provision is imposing a requirement specific to the circumstances it addresses.

<sup>153</sup> 17 U.S.C. § 103(a).

<sup>154</sup> See, e.g., *Jorgensen v. Epic/Sony Records*, 351 F.3d 46, 51 (2d Cir. 2003) (referencing a “reasonable possibility”) (quoting *Gaste v. Kaiserman*, 863 F.2d 1061, 1066 (2d Cir. 1988)); *Martinez v. McGraw*, 581 F. App’x 512, 514 (6th Cir. 2014) (referencing a “reasonable opportunity”); *Ale House Mgmt., Inc. v. Raleigh Ale House, Inc.*, 205 F.3d 137, 144 (4th Cir. 2000); 11TH CIR. CIV. JURY INSTR. § 9.18 (2018) (stating that a “slight possibility” is not enough).

plaintiff must meet in order to prove the fact of copying. On that question, the burden of persuasion remains with the plaintiff.

Most commonly, though, the defendant who attempts to rebut the plaintiff's showing of copying will do so through a *prima facie* factual rebuttal. That rebuttal often takes the form of an assertion that the defendant did not copy from the plaintiff's work, but rather independently created her own work. While copying in fact is a component of the *prima facie* case of infringement, courts often say "independent creation is a *complete defense* to copyright infringement."<sup>155</sup> In this context the reference to independent creation as a "defense" does not mean that the defendant now has the burden of persuasion.<sup>156</sup> Rather, once the plaintiff has produced sufficient evidence from which a finder of fact could conclude that the defendant copied from the plaintiff's copyrighted work, the defendant seeks to show an alternative explanation for the circumstances of creation of the work and potentially why there are similarities in the two works.<sup>157</sup> This will often require the defendant to introduce additional evidence.

Consider five possible scenarios where a defendant, after the plaintiff has made a *prima facie* showing of access plus probative similarity, attempts to rebut the plaintiff's showing that the defendant in fact copied from the plaintiff's work by offering a *prima facie* factual rebuttal:

(1) The defendant offers evidence showing that the defendant was in a distant city on the day that the plaintiff claims that the defendant had access to the plaintiff's work by allegedly attending a performance of the work. Here the defendant is rebutting the plaintiff's *prima facie* showing of access. The plaintiff would likely need to offer some other evidence of access in order to prevail on the issue of copying.

(2) The defendant offers into evidence a dated certificate of registration and the copy deposited with the Copyright Office in the registration process showing that the defendant completed the creation of her work before the date on which the

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<sup>155</sup> E.g., *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1117 (9th Cir. 2018) (emphasis added).

<sup>156</sup> *Collins & Aikman Corp. v. Carpostan Indus., Inc.*, 720 F. Supp. 561, 566 (D.S.C. 1989), *aff'd*, 905 F.2d 1529 (4th Cir. 1990).

<sup>157</sup> *Id.* Some courts use the language of presumption to describe this showing:

When the plaintiff lacks direct evidence of copying, he can attempt to prove it circumstantially by showing that the defendant had access to the plaintiff's work and that the two works share similarities probative of copying. Such proof creates a presumption of copying, which the defendant can then attempt to rebut by proving independent creation.

*Rentmeester*, 833 F.3d at 1117 (internal citations omitted). If indeed there is a presumption, the burden of production has shifted. However, it may be the case that all that the plaintiff has demonstrated is the possibility of copying; a reasonable jury could still rule against the plaintiff. If that is the state of the evidence then the burden of production has not shifted. While the defendant need not introduce additional evidence, the defendant may, nonetheless, introduce evidence supporting a different rationale for why the works are similar.

plaintiff alleges the defendant had access to the plaintiff's work. Again, the defendant is rebutting the showing of access, putting the ball back in the plaintiff's court perhaps to offer other evidence that the defendant had earlier access to the plaintiff's work.

(3) The defendant offers into evidence a third party's work of authorship that existed before the plaintiff or the defendant created their works and that contains the same elements that the plaintiff has identified in the plaintiff's and defendant's works as probatively similar. Such evidence shows that the similarities pointed to by the plaintiff may not be the result of the defendant copying from the plaintiff's work but rather (a) both the plaintiff and the defendant copied from a prior common source<sup>158</sup> or (b) that at least the defendant copied not from the plaintiff but from some other author's work. The defendant is factually rebutting the plaintiff's proof that the similarities between the plaintiff's work and the defendants work are actually probative of whether the defendant copied from the plaintiff's work, or whether some other fact explains those similarities.

(4) The defendant offers evidence to show that the similarities between the parties' works are similarities that are present in most other works in the same genre or the same medium. Such evidence shows that the similarities pointed to by the plaintiff may not be the result of the defendant copying from the plaintiff's work but rather the result of both works following the conventions of the genre or the characteristics and limitations of the medium. Again, the defendant is factually rebutting the plaintiff's proof that the similarities between the plaintiff's work and the defendant's work are actually probative of whether the defendant copied from the plaintiff's work, or whether some other fact explains those similarities.

(5) The defendant offers into evidence a dated certificate of registration and the copy deposited with the Copyright Office in the registration process showing that the defendant had completely created her work before the date on which the plaintiff began creating the plaintiff's work. Here the defendant is offering evidence of genuine independent creation, not just a rebuttal of access or of probative similarity. This evidence may call into question the credibility of the plaintiff's circumstantial evidence of copying. Given that it is the plaintiff's burden to demonstrate copying by a preponderance of the evidence, the fact-finder may rule for the defendant with this evidence in the record.

In each of these scenarios, with the defendant's additional evidence, the fact-finder must make a determination. If the evidence is in equipoise—that is, if it is equally likely that the defendant copied or the defendant independently created the alleged infringing work—then the plaintiff should lose. This is because the plaintiff

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<sup>158</sup> In that situation, even if the defendant had copied the similar elements from the plaintiff's work, the defendant's copying would not amount to improper appropriation, because the elements that the defendant copied would not be elements original to the plaintiff and therefore protected by the plaintiff's copyright, as discussed in Part III.A.3., *supra*.

bears the burden of persuasion on the key issue of copying-in-fact.<sup>159</sup> In that sense, the defense of independent creation is a *prima facie* factual rebuttal, rather than a true affirmative defense.

### C. *Rebutting Improper Appropriation*

Defendants may counter the second element of a plaintiff's *prima facie* case of copyright infringement in a variety of ways. Some of these defenses are purely legal arguments, seeking to highlight the ways in which the plaintiff's evidence is insufficient to meet the legal requirements. Other defenses may involve the introduction of evidence seeking to disprove plaintiff's *prima facie* case. It is important to remember, however, that only if the plaintiff has introduced evidence that is overwhelming, such that no reasonable jury could rule against the plaintiff, has the burden of production shifted to the defendant such that the defendant *must* introduce additional evidence to prevail on its rebuttal.

#### 1. *The Copied Elements Are Unprotected by Copyright*

##### a. *The Copied Elements Were Not Original Expression*

Copyright protects the expression in the work that is original to the author who created the work that the defendant is alleged to have infringed. The Supreme Court's articulation of the second element of the *prima facie* case, embeds this important concept: the plaintiff must demonstrate that what the defendant copied were "constituent elements of the work that are original."<sup>160</sup>

This means that even if a defendant copied material from the plaintiff's copyrighted work, the defendant has not infringed the plaintiff's copyright if the defendant copied only material unprotected by the plaintiff's copyright. Copyright protects some but not all elements of a copyrighted work. Copyright protects the original expression embodied in a work of authorship. Importantly, copyright does not protect "any idea, procedure, process, system, method of operation, concept, principle, or discovery" embodied in a work.<sup>161</sup> So, for example, if a defendant has copied only the "procedure, process, system, [or] method of operation" explained in the plaintiff's work, then the defendant's copying does not constitute improper appropriation.<sup>162</sup> Similarly, because the exclusion from protection of any "discovery" is understood to mean that copyright does not protect facts, if a defendant has copied only facts from the plaintiff's work, then again the defendant's copying is not improper appropriation.

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<sup>159</sup> See, e.g., *Collins & Aikman Corp.*, 720 F. Supp at 565–66 (citing *Keeler Brass Co. v. Cont'l Brass Co.*, 862 F.2d 1063, 1066 (4th Cir. 1988)).

<sup>160</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

<sup>161</sup> 17 U.S.C. § 102(b) (2012).

<sup>162</sup> See, e.g., *Baker v. Selden*, 101 U.S. 99, 103 (1879).

Thus, a defendant faced with a plaintiff's *prima facie* case for copyright infringement might seek to rebut the plaintiff's showing that the defendant copied protected expression from the plaintiff's work. A defense that the copied elements were not protected because the copied elements were not original expression but rather were unprotected ideas or facts is best viewed as a *prima facie* legal rebuttal.

An example of such a rebuttal might be the defendant's assertion that the copied material was represented by the work's author to be factual. Copyright protection not only does not extend to facts, it does not extend to material that an author holds out to be factual.<sup>163</sup> An infringement defendant might therefore assert that all of the material it has copied from the plaintiff's work was material held out as factual by the work's author. In many instances, the evidence to support the defendant's rebuttal will be present in the copy of the plaintiff's work already in evidence as part of the plaintiff's *prima facie* case. In some circumstances, though, a defendant might need to introduce additional factual evidence—such as the text on the cover or book jacket of a copy of an earlier edition of the plaintiff's work. Either way, such a rebuttal will likely involve a mixed question of fact and law, requiring a determination of what representations the author made as to the factual nature of the work and whether those representations meet the legal standard for holding material out as factual such that the material is uncopyrightable.

*b. The Copied Elements Were Expression that Merged With Unprotected Elements of the Work*

Another way that actual copying may not constitute infringement is through the doctrine of merger. The Copyright Act provides that “[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”<sup>164</sup> Where an unprotectable element in a work of authorship can be expressed in so few ways that protecting a particular expression of that element would, as a practical matter, extend protection to the unprotectable element itself, copyright

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<sup>163</sup> *Oliver v. Saint Germain Found.*, 41 F. Supp. 296, 299 (S.D. Cal. 1941) (“[E]quity and good morals will not permit one who asserts something as a fact which he insists his readers believe as the real foundation for its appeal to those who may buy and read his work, to change that position for profit in a law suit.”). In some cases, this principle operates as an estoppel: once the author has held material out to the public as being factual (and perhaps thereby induced others to copy that material freely on the belief that they are only copying unprotectable facts), the author is subsequently estopped from denying that the material is factual and instead claiming it as copyrightable expression. *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1075 (2d Cir. 1992) (holding that because the plaintiff had “expressly represented to the world” that the work’s theories were factual, fact estoppel barred the plaintiff from making “an inconsistent claim so as to better serve its position in litigation”); *Houts v. Universal City Studios, Inc.*, 603 F. Supp. 26, 29–31 (C.D. Cal. 1984) (applying exclusion to absurd stories presented as “true”).

<sup>164</sup> 17 U.S.C. § 102(b).

does not protect that particular expression, which is said to have “merged” with the unprotected element.<sup>165</sup> Thus, to the extent that a defendant has copied merged expression, that copying cannot be the basis of infringement liability.

Whether disproving merger is part of the plaintiff’s *prima facie* case or, instead, is something on which the defendant carries some burden (either of both persuasion and production or just production) is neither answered by the statute nor made clear by extant caselaw.

The circuits are split on whether the argument of merger should be considered in the context of the first element of the *prima facie* case—whether the copyright is valid—or should instead be considered in the context of the second element when considering whether the defendant has copied protected expression. If considered as part of the first element of the *prima facie* case, a successful reliance on the merger doctrine could result in the plaintiff lacking a valid copyright. If considered in the second element of the *prima facie* case, expression that is found to have “merged” with unprotected elements would not be considered when evaluating the expression that the defendant copied.

Caselaw in the First and Fifth Circuits indicates that merger can be considered in the copyrightability component of the analysis.<sup>166</sup> That caselaw, 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.<sup>167</sup> In some of those cases, the effect of finding merger is a requirement of a heightened proof by the plaintiff of the level of substantial similarity, insisting that the defendant’s work be nearly identical to the plaintiff’s work.<sup>168</sup> These cases are problematic, given the command of the

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<sup>165</sup> See *Zalewski v. Cicero Builder Dev., Inc.*, 754 F.3d 95, 103 (2d Cir. 2014) (“Expressions merged with ideas cannot be protected, lest one author own the idea itself.”).

<sup>166</sup> 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).

<sup>167</sup> 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).

<sup>168</sup> See, e.g., *Yankee Candle Co.*, 259 F.3d at 36 (“[T]he plaintiff has the heavy burden of showing ‘near identity’ between the works at issue.”).

Copyright Act that “in no case” should copyright protection extend to those unprotected elements. Permitting expression that has merged with unprotected elements to be the basis of an infringement finding could result in copyright protecting elements of a work that the statute mandates remain unprotected.<sup>169</sup>

Whether there is merger and the effect of finding merger does not, however, answer the question of the burden of proof. The Ninth Circuit is the only circuit to have labeled merger a “defense” to infringement.<sup>170</sup> The Ninth Circuit concluded merger was a defense after setting up a false dichotomy between: (1) merger being considered when analyzing copyrightability or (2) merger being more properly treated as a defense to infringement.<sup>171</sup> The court then cited as support for the treatment of merger as a defense, caselaw that considered merger in the context of the second “copying” prong of the *prima facie* case, rather than the first “copyrightability” prong.<sup>172</sup> 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 *prima facie* legal rebuttals.

The Ninth Circuit cites a Second Circuit opinion as supporting the treatment of merger as a defense.<sup>173</sup> In that case, the Second Circuit considered merger in the context of “determining whether actionable infringement ha[d] occurred.”<sup>174</sup> That

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<sup>169</sup> *Morrissey*, 379 F.2d at 679 (“We cannot recognize copyright as a game of chess in which the public can be checkmated.”).

<sup>170</sup> See *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000). There are other circuit court opinions that discuss the defendant’s arguments concerning merger in the section of the opinion labeled “defenses.” See, e.g., *John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26, 42–43 (1st Cir. 2003). Those opinions do not contain any analysis or reflection on whether merger is a defense or who bears the burden of proof on the issue of merger.

<sup>171</sup> The full paragraph from the Ninth Circuit’s opinion reads:

Although there is some disagreement among courts as to whether these two doctrines figure into the issue of copyrightability or are more properly defenses to infringement, see *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 138 n. 5 (5th Cir.1992) (noting a split as to the doctrine of merger); 4 NIMMER § 13.03[B][3], at 13–69—13–70 & nn.164, 165 (same); *id.* at § 13.03[B][4], at 13–73 n.182 (noting a split as to the doctrine of scènes à faire), we hold that they are defenses to infringement. *Accord Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir.1991) (holding that the merger doctrine relates to infringement, not copyrightability); *Reed-Union Corp. v. Turtle Wax, Inc.*, 77 F.3d 909, 914 (7th Cir.1996) (explaining why the doctrine of scènes à faire is separate from the validity of a copyright); see also 4 NIMMER §§ 13.03[B][3], at 13–69—13–70, 13.03[B][4], at 13–73.

*Ets-Hokin*, 225 F.3d at 1082.

<sup>172</sup> *Id.*

<sup>173</sup> The court uses the signal “accord” to introduce this citation. *Id.*

<sup>174</sup> *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991). The Second Circuit did not label merger as a “defense.”

context is the second element of the *prima facie* case, the comparison of the expression that the defendant is alleged to have copied with the expression contained in the copyrighted work. As the Second Circuit noted, that context “will normally provide a more detailed and realistic basis for evaluating the claim that protection of expression would inevitably accord protection to an idea.”<sup>175</sup> Other courts have cited the importance of having the factual setting of at least two works (the copyrighted work and the alleged infringing work) for comparison and discussion of the difficult line-drawing between idea and expression and the closely related question of whether the two have merged.<sup>176</sup> The Second Circuit also noted that a leading treatise on copyright law viewed treating merger in the context of whether actionable infringement has occurred as “the better view.”<sup>177</sup> Considering the arguments related to merger in the context of analyzing whether the defendant has copied protected expression makes sense, but importantly, labeling merger a defense should not be understood as assigning the defendant a burden of persuasion or even a burden of production.

The argument that the expression that the defendant copied from the plaintiff is merged is best understood as a *prima facie* legal rebuttal. Neither the burden of persuasion nor the burden of production has shifted from its original placement on the plaintiff; rather, the doctrine of merger really is just a way to highlight a deficiency in the plaintiff’s *prima facie* case of showing either a valid copyrighted or copying of copyrightable elements of the work.

Consider the types of evidence that could be introduced either to support a claim of merger or to demonstrate that there is no merger. A plaintiff can deflect a claim of merger by demonstrating other ways in which they or others have expressed the same idea. For example, in a case involving quilting patterns in the shape of a wreath, the defendant argued that there was merger in the way that the plaintiff’s work had arranged public domain shapes (squares and triangles) in plaintiff’s pattern.<sup>178</sup> The court rejected the merger argument because the plaintiff introduced multiple patterns with different expression, all arranging squares and triangles in the shape of a wreath.<sup>179</sup> For the defendant to support a claim of merger, she would

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<sup>175</sup> *Id.*

<sup>176</sup> *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 836 (10th Cir. 1993).

<sup>177</sup> *Kregos*, 937 F.2d at 705 (citing 3 NIMMER ON COPYRIGHT § 13.03[B][3], at 13–58 (1990)).

<sup>178</sup> *Thimbleberries, Inc. v. C & F Enters., Inc.*, 142 F. Supp. 2d 1132, 1138 (D. Minn. 2001).

<sup>179</sup> *Id.* (“[A]s Thimbleberries easily demonstrates, the pattern which it seeks to protect represents only one of many ways to express a quilted wreath design. Thimbleberries’ counsel presents by affidavit at least nine other wreath patterns for quilters, all of which markedly differ from the Countryside Wreath not only in their arrangement of squares and triangles (and in other instances, octagons and rectangular bars), but also in the shape and design of the center opening and the presence, design and positioning of the bow and other decorative additions.”).

need to prove essentially a negative—that there are no, or few, other ways to express the idea. While that can happen, it typically does not involve the introduction of additional evidence.<sup>180</sup>

Thus, while the argument of merger is one that it is appropriate for the defendant to have to raise, it is not appropriate to require the defendant to carry a burden of production related to the merger argument. Instead, a plaintiff, as part of demonstrating actionable copying, will need to show that the expression it asserts is part of the actionable copying engaged in by the defendant is protected expression and not excluded from protection as a result of merger with unprotected elements of the work.<sup>181</sup>

### c. *The Copied Elements Were Scènes à Faire*

Under the *scènes à faire* doctrine, copyright in a work of authorship does not protect elements of the work if those elements are standard, stock, customary, stereotypical, or common in the treatment of the subject or topic of the work.<sup>182</sup> The doctrine also denies copyright protection to any element that flows naturally from unprotectable elements of the work or that is dictated by external factors.<sup>183</sup> As a

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<sup>180</sup> See *Ellison Educ. Equip., Inc. v. Tekservices, Inc.*, 903 F. Supp. 1350, 1360 (D. Neb. 1995) (“There are extremely limited ways in which to depict a candy cane and still be able to express the idea. Therefore, an attempt to copyright the expression of a candy cane is essentially an attempt to copyright the idea. Because plaintiff cannot appropriate the idea of a candy cane, the Court concludes that defendant has not engaged in copyright infringement of plaintiff’s design.”).

<sup>181</sup> For example, in *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 209 (3rd Cir. 2005), the court clearly articulated the plaintiff’s burden related to a defense argument concerning merger: the plaintiff was “entitled to the opportunity to demonstrate” that the work at issue was not “the unavoidable expression of a common idea.” Interestingly, the court was focused on the plaintiff’s burden to demonstrate that the defendant’s work was not the “unavoidable expression of a common idea,” and did not focus on the work belonging to the plaintiff that the defendant had allegedly copied. *Id.* By demonstrating that the defendant’s work was not the unavoidable expression of a common idea, the plaintiff would have shown that the defendant had, therefore, infringed by impermissibly copying original expression from the plaintiff’s work. *Id.*

<sup>182</sup> *Taylor Corp. v. Four Seasons Greetings, LLC*, 315 F.3d 1039, 1042 (8th Cir. 2003) (identifying *scènes à faire* as “incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.”) (quoting *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 616 (7th Cir. 1982)), cert. denied, 459 U.S. 880 (1982)).

<sup>183</sup> See, e.g., *Thompson v. Looney’s Tavern Prods, Inc.*, 204 F. App’x 844, 853 (11th Cir. 2006) (denying protection to a “scene that naturally flows from the historical fact of an election campaign”); *MyWebGrocer, LLC v. Hometown Info, Inc.*, 375 F.3d 190, 194 (2d Cir. 2004) (“Scenes à faire are unprotectible elements that follow naturally from a work’s theme rather than from an author’s creativity.”); *Dun & Bradstreet Software Servs., Inc. v. Grace Consulting, Inc.*, 307 F.3d 197, 215 (3d Cir. 2002) (“Because those external factors dictated the creation of the allegedly infringed work, ‘it is lacking the originality that is the *sine qua non* for copyright protection.’” (quoting *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 838 (10th

result, if the only similarity between a plaintiff's copyrighted work and a defendant's allegedly infringing work is the presence of the same *scènes à faire* elements in both works, then the defendant has not infringed on the plaintiff's copyright.<sup>184</sup>

In the face of a plaintiff's *prima facie* case for infringement, the defendant might attempt to rebut that case by asserting that any elements copied from the plaintiff's work were only unprotected *scènes à faire* elements.<sup>185</sup> Conceptually, this rebuttal could be either a *prima facie* factual rebuttal or a *prima facie* legal rebuttal.

Whether an element of a particular type of work or the treatment of a particular topic is common, customary, stock, standard, or stereotypical would seem to be a question subject to proof through the introduction of evidence. A defendant could presumably introduce into evidence multiple earlier works of the same type or on the same topic to demonstrate that many or all of the elements in common between the plaintiff's and the defendant's works are also present in those earlier examples. Similarly, the assertion that an element of a work is dictated by external factors could be supported either by evidence regarding what those external factors are for the works at issue or how those external factors dictate the element that is asserted to be *scènes à faire*.

However, many cases decide the *scènes à faire* question without reference to any factual evidence. With respect to familiar genres and topics (for example, stories about detectives, spies, superheroes, war, and so forth),<sup>186</sup> courts appear comfortable in many cases concluding, without consulting any evidence from the parties, that

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Cir. 1993)); *Beal v. Paramount Pictures Corp.*, 20 F.3d 454, 459 (11th Cir. 1994) (“In addition to broad ideas, noncopyrightable material includes ‘scènes à faire’—stock scenes that naturally flow from a common theme.”).

<sup>184</sup> See, e.g., *Frye v. YMCA Camp Kitaki*, 617 F.3d 1005, 1008 (8th Cir. 2010). If the plaintiff's selection and arrangement of which particular *scènes à faire* elements to include in its work is original, then the defendant could be liable for infringement if the defendant has copied the plaintiff's particular selection or arrangement of *scènes à faire* elements.

<sup>185</sup> An assertion that the only similarities between the plaintiff's and defendant's works are similarities of *scènes à faire* elements might also be viewed as a *prima facie* rebuttal to the plaintiff's *prima facie* case on the copying-in-fact element. If the only similarities between the works are *scènes à faire* elements, then those similarities are likely neither striking nor probative of copying, since one would expect works on similar topics to contain elements that are customary or common, that flow naturally from unprotected elements, or that are dictated by external convention. Most cases in which similarities are found to be entirely of *scènes à faire* elements, though, appear to view that finding as rebutting the plaintiff's claim that protected expression was copied, rather than that any copying in fact occurred.

<sup>186</sup> See, e.g., *Warner Bros. Inc. v. Am. Broadcasting Cos., Inc.*, 654 F.2d 204, 207 (2d Cir. 1981) (superheroes); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980) (German involvement in Hindenberg disaster); *Whitehead v. Paramount Pictures Corp.*, 53 F. Supp. 2d 38, 46–47 (D.D.C. 1999) (police car chase scenes in action movies).

certain elements of a work are sufficiently common or standard that those elements are *scènes à faire*.<sup>187</sup>

## 2. *The Copying of the Protected Elements Was Not Improper*

In many instances, the factual determination of substantial similarity will turn on the fact-finder's comparison of the plaintiff's and the defendant's works to determine whether the ordinary observer (whom the fact-finder often is seen as representing)<sup>188</sup> would perceive the elements of protected expression copied from the plaintiff's work into the defendant's work as substantially similar. The fact-finder can generally make that determination simply by comparing the two works as introduced into evidence by the plaintiff. In this context, a defense argument that the works are not substantially similar is a *prima facie* legal rebuttal. A defense argument that any copying of protected work was merely *de minimis* would, similarly, be a *prima facie* legal rebuttal: an assertion that the facts fail to prove copying sufficient to amount to improper appropriation.<sup>189</sup>

In some instances, however, the defendant may respond to the plaintiff's *prima facie* showing of substantial similarity with a *prima facie* factual rebuttal. This seems particularly likely in cases where the intended audience for the plaintiff's work is not the ordinary observer (i.e., the general public), but rather a specialized audience. For example, the plaintiff's work may be directed to children aged three to five years of age. In that case, because the fact-finder must evaluate the audience perception of substantial similarity from the perspective of a very young child, the plaintiff may have introduced evidence as to the actual or likely response of children to the defendant's work. The defendant in such a case may attempt to rebut the plaintiff's showing by introducing its own evidence of how very young children actually perceive, or are likely to perceive, the defendant's work. In that event, the fact-finder should review all of the evidence to determine whether the plaintiff has established,

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<sup>187</sup> See, e.g., Stromback v. New Line Cinema, 384 F.3d 283, 296 (6th Cir. 2004) (referring to the elements of the work as "common themes and ideas throughout literature" without considering any specific evidence or examples where these common themes and ideas occur); Cavalier v. Random House, Inc., 297 F.3d 815, 824 (9th Cir. 2002) (referring to the "general premise of a child, invited by a moon-type character, who takes a journey through the night sky and returns safely to bed to fall asleep" as a "basic plot idea" without consulting additional evidence from the parties); *Hoehling*, 618 F.2 at 979 (concluding that the "claimed similarities relate to random duplications of phrases and sequences of events" are "merely *scènes à faire*" because it is "virtually impossible to write about a particular historical era or fictional theme without employing certain 'stock' or standard literary devices," but not considering examples of these claimed similarities that occur elsewhere).

<sup>188</sup> "A jury deciding the issue of substantial similarity not only makes findings of historical fact, but usually also serves as a proxy for the works' intended audience." *Murray Hill Publ'ns, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 321 (6th Cir. 2004).

<sup>189</sup> See *supra* notes 113–16 and accompanying text, discussing the requirement that the copying be more than *de minimis*.

by a preponderance of the evidence, that the intended audience of the plaintiff's work would likely perceive substantial similarity between the relevant portions of the parties' works.

## V. AFFIRMATIVE DEFENSES

If a plaintiff meets its burden of proof on each element of its prima facie copyright infringement claim, the defendant can still prevail if the defendant can establish an affirmative defense. An affirmative defense differs from the kinds of defense arguments discussed in Part IV. Those arguments, which we have labeled rebuttals, challenge whether the plaintiff has met its burden to establish a prima facie claim of copyright infringement. If a rebuttal by the defendant succeeds, then the defendant is entitled to prevail against the plaintiff's infringement claim because the plaintiff has not been able to establish a necessary element of its copyright infringement claim. By contrast, when the defendant asserts an affirmative defense, the defendant is arguing that *even if* the plaintiff can meet its burden of persuasion on each element of the copyright infringement claim, the defendant is nonetheless not liable for copyright infringement for some other reason outside of the elements of the plaintiff's claim.<sup>190</sup>

A true affirmative defense places the burden of persuasion on the defendant to establish the elements required to make out the defense. Similar to what we see with the prima facie case of infringement, the burden of production concerning an affirmative defense may shift from the defendant, where it is initially placed, to the plaintiff. Even in these instances when the burden of production shifts, because these are affirmative defenses, the burden of persuasion remains on the defendant.

The variety of potential affirmative defenses to a copyright infringement claim is very large, and the elements of each potential defense differ, so a complete examination of all affirmative defenses is beyond the scope of this Article. Instead, this Part considers three different categories of defense arguments that might be identified as affirmative defenses and considers a number of examples in each category. First, Part V.A examines affirmative defenses that are not specific to copyright infringement claims but that might arise in most kinds of civil litigation. Next, Part

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<sup>190</sup> See, e.g., 5 CHARLES ALAN WRIGHT & ARTHUR R. MILLER, FEDERAL PRACTICE & PROCEDURE: FEDERAL RULES OF CIVIL PROCEDURE § 1270, at 558 (3d ed. 2004) ("Rule 8(c) [enumerating affirmative defenses] is a lineal descendant of the common law plea by way of 'confession and avoidance,' which permitted a defendant who was willing to admit that the plaintiff's declaration demonstrated a prima facie case to then go on and allege additional new material that would defeat the plaintiff's otherwise valid cause of action."); *see also* 7th CIR. JURY INSTR. § 12.2.1 ("If . . . you find that Plaintiff has proved each of these [elements of an infringement claim] by a preponderance of the evidence, you must then consider Defendant's claim that [describe affirmative defense(s)]. If you find that Defendant has proved this by a preponderance of the evidence, then you must find for Defendant.").

V.B. looks at a defense specifically identified as such in the Copyright Act. Finally, Part V.C. looks at whether some or all of the Copyright Act's express limitations on the scope of copyright owners' exclusive rights constitute affirmative defenses.

#### A. Generally Applicable Affirmative Defenses

A number of possible affirmative defenses to a copyright infringement claim are defenses that could be raised in most types of civil litigation. Several such defenses are identified in Rule 8(c) of the Federal Rules of Civil Procedure, which contains a nonexhaustive list of affirmative defenses for which the defendant bears the burden of pleading.<sup>191</sup>

Many of those listed affirmative defenses address general procedural obstacles to a plaintiff's claim (whether for copyright infringement or otherwise). Some—such as arbitration and award<sup>192</sup> and res judicata<sup>193</sup>—involve assertions that the plaintiff's claim already has been (or should have been) resolved and cannot be relitigated. Others—such as laches<sup>194</sup> and statute of limitations<sup>195</sup>—involve assertions that the plaintiff's claim is untimely. Still others—such as estoppel,<sup>196</sup> license,<sup>197</sup> and waiver—involve assertions that some act by the plaintiff bars recovery on the infringement claim.<sup>198</sup> In this Section we consider, first, the treatment of the timeliness of a copyright owner's claim as an affirmative defense through an assertion of a

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<sup>191</sup> FED. R. CIV. P. 8(c). The rule states that a responsive pleading "must affirmatively state any avoidance or affirmative defense, including" those listed. The use of "including" indicates that the list is nonexhaustive.

<sup>192</sup> Courts have held that the "arbitration and award" defense is a defense that the dispute has already been arbitrated. *E.g.*, *Mapes v. Chevron USA Prods. Co.*, 237 F. Supp. 2d 739, 745 (S.D. Tex. 2002) (noting that "arbitration and award" applies only when dispute has already been arbitrated and award obtained); *see also* *Greene v. Am. Cast Iron Pipe Co.*, 871 F. Supp. 1427, 1431 (N.D. Ala. 1994) (referring to a completed arbitration process); *Lee v. Grandcor Med. Sys., Inc.*, 702 F. Supp. 252, 254 (D. Colo. 1988) (same). A plaintiff and defendant in a copyright infringement suit could previously have engaged in arbitration to resolve the particular infringement claims at issue.

<sup>193</sup> *See, e.g.*, *Bell v. Taylor*, 827 F.3d 699, 706 (7th Cir. 2016); *see also* GOLDSTEIN, *supra* note 84, § 11.2.

<sup>194</sup> *But see Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 685 (2014) (holding that in light of the Copyright Act's 3-year statute of limitation, laches does not act to limit the timeliness of a copyright owner's claim, and that only in "extraordinary circumstances" would laches justify a "curtailment of the relief equitably awardable"); *see also* GOLDSTEIN, *supra* note 84, § 11.5.1.

<sup>195</sup> *See infra* Part V.A.1.

<sup>196</sup> *See, e.g.*, *Hampton v. Paramount Pictures Corp.*, 279 F.2d 100, 104 (9th Cir. 1960) (identifying elements of an estoppel defense to a copyright claim); *see also* GOLDSTEIN, *supra* note 84, § 11.5.2.

<sup>197</sup> *See infra* Part V.A.2.

<sup>198</sup> Other defenses listed in FRCP Rule 8 seem unlikely to be relevant to many (if any)

failure to meet the Copyright Act's three-year statute of limitations. Second, this Section considers the assertion of licensed use as an affirmative defense.

### *1. Statute of Limitations*

Several courts have expressly identified the statute of limitations as an affirmative defense on which the defendant bears the burden of proof.<sup>199</sup> Thus, the defendant bears the burden of producing sufficient evidence to persuade the factfinder by a preponderance of the evidence that the statute of limitations bars the plaintiff's copyright infringement claim.

The burden of production on the affirmative defense may, however, shift during the course of infringement litigation, as it can on elements of the plaintiff's *prima facie* claim as discussed above.<sup>200</sup> For example, a number of courts have stated that for the defendant to prevail on a statute-of-limitations defense, the defendant must prove that the statute of limitations has run. If the defendant fails to meet that burden, the plaintiff need not "proffer any additional evidence in order to rebut the statute of limitations defense."<sup>201</sup> But if the defendant does meet its burden, some courts say that "then the burden shifts to the plaintiff to establish an exception to the statute of limitations."<sup>202</sup>

As with elements of the plaintiff's *prima facie* case, an affirmative defense may also involve purely legal questions on which neither party bears a burden of proof. For example, the Copyright Act provides that "[n]o civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued."<sup>203</sup> Some uncertainty remains, however, as to whether a claim "accrues" when the allegedly infringing act occurs or when the plaintiff discovers (or with due diligence should have discovered) the infringing act.<sup>204</sup> The answer to that

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copyright infringement claims. These include several defenses specific to contract or debt claims (accord and satisfaction, duress, failure of consideration, illegality, payment, release) or tort claims (assumption of risk, contributory negligence, injury by fellow servant).

<sup>199</sup> See, e.g., *Faessler v. U.S. Playing Card Co.*, 2007 WL 490171, at \*3 (S.D. Ohio Feb. 9, 2007); *Perry v. Herd*, 2006 WL 335522, at \*5 (E.D. Tenn. Feb. 14, 2006) (noting that because statute of limitations claim is an affirmative defense, "[d]efendants bear the burden of proof"); see also 11th Cir. JURY INSTR. § 9.29 (2018) ("To establish that the statute of limitations bars [plaintiff's] copyright claim, [the defendant] must prove by a preponderance of the evidence" that plaintiff failed to file the claim within three years.").

<sup>200</sup> See *supra* Part I.A.3.

<sup>201</sup> *Fonseca v. Consol. R.R. Corp.*, 246 F.3d 585, 591 (6th Cir. 2001); see also *Perry*, 2006 WL 335522, at \*5. (applying this to copyright claim).

<sup>202</sup> *Campbell v. Grand Trunk Western R. Co.*, 238 F.3d 772, 775 (6th Cir. 2001); see also *Faessler*, 2007 WL 490171, at \*3 (applying this concept to a copyright claim); *Perry*, 2006 WL 335522, at \*5 (same).

<sup>203</sup> 17 U.S.C. § 507(b) (2012).

<sup>204</sup> See *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1969 n.4 (2014); see also NIMMER & NIMMER, *supra* note 124, § 12.05[B][2]. Professor Goldstein characterizes the

question may be dispositive as to whether a particular defendant's statute-of-limitation defense succeeds, but the answer is a purely legal question of how to interpret the language of the statute and neither party bears any burden of proof on that issue.

## 2. Licensed Use

The Supreme Court's articulation of the *prima facie* case does not use the word "unauthorized" before copying.<sup>205</sup> Many Circuit courts have clearly held that in order to prove a *prima facie* case "a plaintiff is *not* required to prove that the defendant's copying was unauthorized."<sup>206</sup> Instead, the defendant must carry the burden of demonstrating that the use at issue was authorized.<sup>207</sup> Some courts cite the inclusion of "license" in the list of affirmative defenses found in FRCP 8(c) to support the conclusion that the defendant must prove the use was authorized rather than requiring the plaintiff demonstrate that the use was unauthorized.<sup>208</sup> Other courts have pointed to the reality that typically if the defendant asserts they had a license, there will be evidence of that license that will be available to the licensee and therefore it is "sensible to place upon that party the burden of coming forward with evidence of a license."<sup>209</sup>

However, when the issue is not whether the defendant possessed a license or authorization but rather whether the use engaged in by the defendant is within the scope of that license, courts have held that the copyright owner bears the burden of proving that the defendant's copying was unauthorized.<sup>210</sup> As one court has noted,

[c]opyright disputes involving only the scope of the alleged infringer's license present the court with a question that essentially is one of contract: whether

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distinction as whether a court will toll the statute of limitations for the period before the plaintiff could have learned of the claim by reasonable diligence. GOLDSTEIN, *supra* note 84, § 11.1.2. Either characterization poses a question of law rather than fact.

<sup>205</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991); *see also* *Muhammad-Ali v. Final Call, Inc.*, 832 F.3d 755, 760 (7th Cir. 2016).

<sup>206</sup> *E.g., Muhammad-Ali*, 832 F.3d at 760.

<sup>207</sup> *Id.* at 760–61; *John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26, 40 (1st Cir. 2003); *Tasini v. N.Y. Times Co.*, 206 F.3d 161, 171 (2d Cir. 2000); *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775 (7th Cir. 1996) ("[T]he existence of a license, exclusive or nonexclusive, creates an affirmative defense to a claim of copyright infringement."); *Bourne v. Walt Disney Co.*, 68 F.3d 621, 631 (2d Cir. 1995) ("[P]ossession of a license by an accused infringer traditionally has been characterized as a matter of affirmative defense.").

<sup>208</sup> *Muhammad-Ali*, 832 F.3d at 761.

<sup>209</sup> *Bourne*, 68 F.3d at 631.

<sup>210</sup> *E.g., Tasini*, 206 F.3d at 171; *Bourne*, 68 F.3d at 631; *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 517 (9th Cir. 1993) ("To prevail on a claim of copyright infringement, a plaintiff must prove ownership of a copyright and a 'copying' of protectable expression beyond the scope of a license."); *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1085 (9th Cir. 1989) (same); *see also* *NLFC, Inc. v. Devcom Mid-Am., Inc.*, 45 F.3d 231, 235 n.5 (7th Cir. 1995) (noting, in dicta, that "plaintiff must prove ownership of a copyright and a copying of protectable expression 'beyond the scope of a license.'").

the parties' license agreement encompasses the defendant's activities. Just as in an ordinary contract action, the party claiming a breach carries the burden of persuasion.<sup>211</sup>

This splitting of the "defense" of authorized use into components on which the defendant bears the burden of persuasion (the existence of a license) and components on which the plaintiff bears the burden of persuasion (that defendant's activities are outside the scope of the license) may be likened to a shifting of the burden of proof to the plaintiff. The defendant shows the existence of a license as a reason why the defendant is not infringing and the plaintiff then attempts to show that the terms of the license do not encompass the activity in which the defendant engaged.

### B. Statutorily Identified Defense to Liability

The text of the Copyright Act currently identifies at least one express defense to an infringement claim.<sup>212</sup> The express statutory defense to liability for direct copyright infringement arises in the context of the term of copyright protection. Since January 1, 1978, many works have been protected for a term that lasts for 70 years after the death of the author.<sup>213</sup> Determining when the copyright in such work expires thus requires knowing the date (or at least the year) in which the author died.<sup>214</sup> Of course, it can be difficult to determine that date, particularly for less well-known authors, after many decades have passed.

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<sup>211</sup> *Bourne*, 68 F.3d at 631 (citing *Gordon v. Leonetti*, 324 F.2d 491, 492 (2d Cir. 1963)).

<sup>212</sup> Prior to 2010, the Copyright Act also contained a defense related to the so-called "manufacturing clause," a provision that required English language nondramatic works to be printed in the United States or Canada. 17 U.S.C. § 601 (1988), *repealed by* Copyright Cleanup, Clarification, and Corrections Act of 2010, Pub. L. 111-295, § 4(a), 124 Stat. 3180, 3180 (2010). The statute provided a "complete defense" to a civil or criminal action "if the infringer prove[d]" the three elements set out in the statute, thus expressly placing the burden of proof for the defense on the defendant. 17 U.S.C. § 601(d) (1988), *repealed by* Copyright Cleanup, Clarification, and Corrections Act of 2010, Pub. L. 111-295, § 4(a), 124 Stat. 3180, 3180. The Copyright Act also contains a partial defense that shields a defendant from a monetary award if a defendant can demonstrate that they relied on the absence of a copyright notice on authorized copies and phonorecords that were "publicly distributed by authority of the copyright owner before the effective date of the Berne Convention Implementation Act of 1988," 17 U.S.C. § 405(b) (2012), which was effective on March 1, 1989. While the copyright owner remains eligible to obtain injunctive relief, successfully proving a defense under 405(b) also provides statutory authorization for a court to refuse to award injunctive relief and instead require payment of a royalty in the amount of a "reasonable license fee." *Id.* The statute provides that a person who innocently infringes in reliance on an omitted notice is entitled to the defense only "if such person proves that he or she was misled by the omission of notice," and thus expressly assigns the burden of proof for this defense to the defendant. *Id.*

<sup>213</sup> *Id.* § 302(a), (b); *id.* § 303.

<sup>214</sup> Because copyright terms run to the end of the year in which they would otherwise expire, a work's copyright will expire on midnight of December 31 of the last year of the term, regardless

To address this problem, the statute directs the Copyright Office to maintain records of the deaths of authors (and of filed statements indicating that an author is still living on a certain date). Once 95 years have passed since a work's first publication (or 120 years from its creation), anyone who obtains a certified report that the Copyright Office's records do not indicate that the author is living or died less than 70 years earlier "is entitled to the benefit of a presumption that the author has been dead for at least 70 years."<sup>215</sup> The statute provides that "[r]eliance in good faith upon this presumption shall be a complete defense to any action for infringement under this title."<sup>216</sup>

Imagine, for example, that a historian wants to print in a forthcoming book a letter written in 1895 that has never before been published.<sup>217</sup> The letter is signed, so the historian knows the name of the letter's author, but the historian has not been able to find any information about when the author died. Because the copyright in the letter will expire 70 years after the author's death, the historian is unable to calculate when the copyright will expire. The historian could request a search of the Copyright Office records regarding the deaths of authors. If the Copyright Office report shows no indication that the letter's author died less than 70 years earlier, the historian would be entitled to a presumption that the author has been dead for at least 70 years (because 120 years have passed since the unpublished letter's creation). The historian could rely on that presumption in publishing the letter.

It may turn out, however, that the letter's author has not been dead for at least 70 years. The letter may have been written during the youth of a long-lived author, who may have died only in 1960. As a result, the copyright in the letter will not expire until 70 years after that, in 2030. If the author's ownership of copyright in the letter passed to the author's child and that child is still alive, the author's child might sue the historian for infringing the copyright in the letter and might well be able to establish all of the elements of a *prima facie* infringement claim. But as long as the historian relied in good faith on the presumption created by the results of the search of the Copyright Office's records, the infringement claim should fail because such reliance is a "complete defense" to an infringement action.

Although the statute does not expressly use the term "affirmative defense" in describing the effect of reliance on the presumption, treating this defense as an affirmative defense makes sense. If proven, this defense means that even when the plaintiff has successfully met its burden of persuasion on all of the elements of its

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of the actual date of the author's death.

<sup>215</sup> 17 U.S.C. § 302(e).

<sup>216</sup> *Id.*

<sup>217</sup> Those letters would have acquired federal copyright protection on January 1, 1978. 17 U.S.C. § 303. The term of that copyright protection would generally be the life of the author plus 70 years. *Id.* §§ 303, 302(a); see also R. Anthony Reese, *Public but Private: Copyright's New Unpublished Public Domain*, 85 TEX. L. REV. 585, 588–91 (2007).

prima facie claim and the defendant does not rebut any of those elements, nonetheless the defendant is not liable for infringement because of the defense. This is the general structural posture of affirmative defenses, rather than of defense rebuttals. And the defendant can prove the defense without rebutting any element of the plaintiff's claim: the plaintiff's copyright may well still be valid (because the work's author died less than 70 years earlier), but the defendant would still be entitled to the defense as long as the Copyright Office records did not indicate that the author had died less than 70 years earlier. It also makes sense to place the burden of production for this defense on the defendant, since the facts relevant to establishing the defense are likely to be uniquely known to the defendant. And to the extent that the defense turns in part on the defendant's good faith, assigning the defendant the burden of persuasion on the issue of her own good faith is consistent with other provisions of the Copyright Act.<sup>218</sup>

### C. *Statutory Limitations on Copyright Owner's Exclusive Rights*

A final category of defense arguments that includes at least some affirmative defenses relates to the scope of the copyright owner's exclusive rights in the copyrighted work.<sup>219</sup> Section 106, which enumerates those rights, expressly states that the rights it sets forth are "[s]ubject to sections 107 through 122."<sup>220</sup> Each of those sections contains limitations on some or all of the section 106 rights.<sup>221</sup> Courts have held that at least two of those limitations, fair use and the first-sale doctrine, constitute affirmative defenses to infringement claims.

#### 1. *Fair Use*

The language of the Copyright Act does not expressly indicate that fair use should be treated as an affirmative defense. Not only does the language of section 106 that enumerates the rights granted to copyright owners expressly make those

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<sup>218</sup> See, e.g., 17 U.S.C. § 504(c)(2) (placing the burden on an infringer to establish that he or she "was not aware and had no reason to believe that his or her acts constituted an infringement of copyright").

<sup>219</sup> The statute also provides certain limitations on liability even when a defendant has engaged in activity within the scope of the copyright owner's exclusive rights under section 106, as limited by sections 107 to 122. For example, the statute contains a number of "safe harbors" that shield defendants from most remedies for certain kinds of online activities under certain circumstances. *Id.* § 512 (2012). Because those provisions are more akin to remedial relief than to the question of whether actionable infringement has occurred, a discussion of the burden of proof issues associated with those limitations is beyond the scope of this Article.

<sup>220</sup> *Id.* § 106 (2012).

<sup>221</sup> *Id.* §§ 106–122. As originally enacted, all of those sections bear titles that begin either with the words "limitations on exclusive rights" or "scope of exclusive rights." (Later amendment revised the title of section 116 from "Scope of exclusive rights in nondramatic musical works: Public performances by means of coin-operated phonorecord players" to "Negotiated licenses for public performances by means of coin-operated phonorecord players.").

rights “subject to” section 107, section 107 of the Act states that a fair use “is not an infringement of copyright,” indicating that fair use is part of the inquiry into what constitutes infringement.<sup>222</sup> Further, the legislative history of the 1976 Act does not support treating fair use as an affirmative defense.<sup>223</sup>

The Supreme Court, however, has clearly stated that fair use is an affirmative defense. In *Campbell v. Acuff-Rose Music, Inc.*, the Supreme Court not only repeated its declaration, first made nine years earlier,<sup>224</sup> that fair use is an affirmative defense,<sup>225</sup> it also commented on the burden that follows from that categorization. Specifically, in addressing the fourth statutory factor of a fair use analysis—the effect of the putative fair use on “the potential market for or value of the copyrighted work”<sup>226</sup>—the Court stated: “Since fair use is an affirmative defense, its proponent would have difficulty carrying the burden of demonstrating fair use without favorable evidence about relevant markets.”<sup>227</sup> This statement appears to not only cement the label “affirmative defense,” it also clearly states that the defendant carries the “burden of demonstrating fair use.”<sup>228</sup>

As with the *prima facie* case of infringement, even if the burden of persuasion is assigned to one party, the burden of production may shift to the opposing party. The same is true in the context of the affirmative defense of fair use. A defendant may raise the defense and satisfy its initial burden of production, but a court may then shift the burden of production to the plaintiff on particular aspects of the fair use inquiry. For example, if the defendant introduces evidence showing that the

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<sup>222</sup> One of us has argued elsewhere that fair use should not be treated as an affirmative defense. *See generally* Lydia Pallas Loren, *Fair Use: An Affirmative Defense?*, 90 WASH. L. REV. 685 (2015).

<sup>223</sup> An early House Report expressly characterizes fair use as not an affirmative defense: “The committee believes that any special statutory provision placing the burden of proving fair use on one side or the other would be unfair and undesirable.” H.R. REP. NO. 90-83, at 37 (1967). For a fuller discussion of this issue, see Loren, *supra* note 222, at 699–703 and Ned Snow, *The Forgotten Right of Fair Use*, 62 CASE W. RES. L. REV. 135, 160–61, n. 146 (2011).

<sup>224</sup> Harper & Row was the first time the Supreme Court used the label “affirmative defense.” *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 561 (1985). A few lower courts had used the label prior to the Supreme Court’s use of the term. *See* Snow, *supra* note 223, at 161 n.145 (citing cases).

<sup>225</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994).

<sup>226</sup> 17 U.S.C. § 107(4). Section 107 provides four factors courts may consider in evaluating whether a use is a fair use:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

<sup>227</sup> *Campbell*, 510 U.S. at 590.

<sup>228</sup> *Id.*

defendant's use causes minimal harm to the market for the plaintiff's work, the focus of the fourth fair-use factor, the plaintiff may seek to rebut that showing by asserting that the use harms the plaintiff's market for a particular type of license, and to do so the plaintiff may need to produce evidence showing that it offered that type of license at the time the defendant's use occurred. This would be a *prima facie* factual rebuttal. As the Eleventh Circuit noted in one case, "Plaintiffs—as publishers—can reasonably be expected to have the evidence as to availability of licenses for their own works. It is therefore reasonable to place on Plaintiffs the burden of going forward with evidence on this question."<sup>229</sup> The court was clear, however, that this was a shift of the burden of production only. The burden of persuasion remained on the defendant as the proponent of the defense.<sup>230</sup>

Often in fair use claims, though, the parties do not dispute the facts relevant to the claim. Rather they disagree on how to characterize those facts in light of the four fair-use factors that the Copyright Act directs courts to consider, and on whether those facts lead to a conclusion that the defendant's use is a fair use or not. For example, the parties may agree that the defendant earned no money from the allegedly infringing use, but disagree on whether that fact means that the defendant's use was "non-commercial," a characterization that would favor finding the use to be fair.<sup>231</sup> Arguments by the plaintiff addressed to these types of disagreements are what we label *prima facie* legal rebuttals:<sup>232</sup> the plaintiff has introduced no new evidence to try to establish facts contrary to the facts established by the evidence introduced by the defendant, but is instead arguing about the proper application of the law to the established facts.

As noted above,<sup>233</sup> when a question is categorized as a mixed question of law and fact, determining the proper allocation of the burdens of proof can be even more complicated. The Supreme Court has categorized the question of fair use as a mixed question of law and fact.<sup>234</sup> If the parties do not dispute the historical facts

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<sup>229</sup> Cambridge Univ. Press v. Patton, 769 F.3d 1232, 1279 (11th Cir. 2014).

<sup>230</sup> *Id.* Interestingly, the Eleventh Circuit uses the language of "presumptions" to explain the effect of placing the burden on the plaintiff:

In effect, this creates a presumption that no market for digital permissions exists for a particular work . . . . This is reasonable, because if a license was available during the relevant time period, Plaintiffs can rebut the presumption of no market by going forward with evidence of license availability. . . . Then, Defendants—retaining the overall burden of persuasion on the fourth factor—must demonstrate that their use does not materially impair the existing or potential market in order to prevail.

*Id.* at 1279–80.

<sup>231</sup> See, e.g., A&M Records, Inc. v. Napster, Inc., 239 F.3d 1004, 1051 (9th Cir. 2001).

<sup>232</sup> See *supra* Part I.C.

<sup>233</sup> See *supra* Part I.D.

<sup>234</sup> Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 560 (1985) (citing Pac. & S. Co., Inc. v. Duncan, 744 F.2d 1490, 1495 n.8 (11th Cir. 1984)). Lower courts have followed the Supreme Court's lead in the characterization of fair use as a mixed question of law and fact.

but disagree on whether the defendant's activities meet the legal standard to be a fair use, it would be inappropriate for a court to rule against the defendant on the grounds that the defendant has failed to carry the defendant's burden of persuasion. Instead, the court should resolve the issue on the legal question (on which neither party bears the burden of persuasion): the facts do not support characterizing the defendant's use as a fair use.<sup>235</sup>

## *2. First-Sale*

When the plaintiff has asserted that the defendant has infringed by distributing copies of plaintiff's copyrighted work to the public, the statute provides a defense often referred to as "first sale." Once the copyright owner has parted with title to a "copy" (a material object in which the copyrighted work is embodied), the copyright owner cannot restrict the subsequent transfer of that copy. Specifically, § 109(a) provides:

Notwithstanding the provisions of section 106(3), the owner of a particular copy or phonorecord lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord.<sup>236</sup>

The first-sale doctrine permits everything from sales of used DVDs at garage sales and church rummage sales, to the longstanding tradition of used book stores. Section 109 makes these activities clearly lawful.<sup>237</sup>

First-sale is treated as an affirmative defense, with the burden of persuasion on the defendant. While the statute is silent on who bears the burden, the legislative history clearly indicates congressional intent. The 1976 House Report refers to a 1975 court decision that placed the burden on the plaintiff to establish that the copies involved in the suit were not lawfully made or acquired.<sup>238</sup> The Committee expressed the view that the decision was inconsistent with the "established legal principle that the burden of proof should not be placed upon a litigant to establish facts particularly within the knowledge of his adversary."<sup>239</sup> As a result, the Committee stated its intent that in litigation over the application of the first-sale doctrine,

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*E.g.*, Oracle Am., Inc. v. Google LLC, 886 F.3d 1179, 1192–93 (Fed. Cir. 2018); SOFA Entm't, Inc. v. Dodger Prods., Inc., 709 F.3d 1273, 1277 (9th Cir. 2013).

<sup>235</sup> The characterization of the fair-use inquiry as a mixed question of law and fact has the potential to interfere with the right to a jury trial on the claim of infringement. *See* Ned Snow, *Who Decides Fair Use—Judge Or Jury?*, U. WASH. L. REV. (forthcoming).

<sup>236</sup> 17 U.S.C. § 109(a) (2012).

<sup>237</sup> *See generally* Kirtsaeng v. John Wiley & Sons, Inc., 133 S. Ct. 1351 (2013) (discussing the longstanding, fundamental nature of the first-sale doctrine).

<sup>238</sup> H.R. REP. NO. 94-1476, at 80–81 (1976).

<sup>239</sup> *Id.* at 81.

"the burden o[f] proving whether a particular copy was lawfully made or acquired should rest on the defendant."<sup>240</sup>

While the defendant bears the burden of proof, the burden of production may shift to the copyright owner once the defendant has presented "evidence sufficient for a jury to find lawful acquisition of title, through purchase or otherwise, to genuine copies of the copyrighted [work]."<sup>241</sup> The copyright owner may then seek to establish that no authorized copies of the work had ever been sold (but perhaps only licensed), making the defense of first-sale unavailable.<sup>242</sup> The Ninth Circuit has noted that this shifting of the burden of production "accords with . . . our general precedent that fairness dictates that a litigant ought not have the burden of proof with respect to facts particularly within the knowledge of the opposing party."<sup>243</sup>

Whether the defendant should bear the burden of proving both that she lawfully acquired title to the copies at issue and also that the copies were lawfully made (e.g., "genuine" or "authorized") is not as clear. The legislative history includes a statement of Congress's intent that a defendant should have "the burden o[f] proving whether a particular copy was lawfully made or acquired."<sup>244</sup> The use of the conjunctive "or" leads to ambiguity. The basis on which Congress thought assigning this burden to the defendant is stated as, "[t]he defendant in such actions clearly has the particular knowledge of how possession of the particular copy was acquired, and should have the burden of providing this evidence to the court."<sup>245</sup> Thus, it seems, the defendant should bear the burden of proving lawful acquisition. And, as the Ninth Circuit has held, the burden of production would then shift to the plaintiff to show that the copies acquired were not authorized copies. Requiring the plaintiff to make that showing is consistent with the underlying requirement in the plaintiff's case to demonstrate "copying." If the copy is an *authorized* copy of the copyrighted work, then there is no improper appropriation.

### 3. Other Statutory Limitations

Given the number of statutory limitations in sections 107 to 122 of the Copyright Act, a comprehensive examination of which of them constitute affirmative defenses is beyond the scope of this Article.

None of the statutory provisions in sections 107 to 122 expressly state who bears the burden of proof. The first-sale limitation in section 109 is the only limitation for which the legislative history indicates any Congressional intent as to the burden of proof.

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<sup>240</sup> *Id.*

<sup>241</sup> *Adobe Sys. Inc. v. Christenson*, 809 F.3d 1071, 1079 (9th Cir. 2015).

<sup>242</sup> *Friedman v. Live Nation Merch., Inc.*, 833 F.3d 1180, 1189 (9th Cir. 2016).

<sup>243</sup> *Id.* (quoting *Adobe Sys. Inc.*, 809 F.3d at 1079).

<sup>244</sup> H.R. REP. NO. 94-1476, at 81.

<sup>245</sup> *Id.*

It seems difficult to conclude that Congress intended all of the express limitations to constitute affirmative defenses. If that had been the intent, there would have been no need for Congress specifically to have expressed its intent as to the burden of proof as to the lawfulness of a defendant's copy in determining whether the first-sale doctrine applies to the defendant's conduct, or to have justified that view on the particular contours of the first-sale doctrine. Instead, Congress could simply have said that all of the limitations on the copyright owner's rights, including the first-sale doctrine, were affirmative defenses for which the defendant bore the burden of proof.

Similarly, the fact that Congress did express its intent to place the burden of proof on the defendant as to elements of the first-sale doctrine indicates that Congress did not intend for the limitations in sections 107 to 122 to be understood as always placing the burden of proof on the plaintiff to establish that the defendant's conduct was within the scope of one or more of the copyright owner's exclusive rights *as limited by sections 107 to 122*. The Congressional intent expressed regarding the first-sale doctrine shows that it can be consistent with the statute to treat a limitation on an exclusive right as an affirmative defense.

It seems, therefore, that courts will need to decide for each of the statutory limitations in sections 107 to 122 whether that limitation constitutes an affirmative defense, such that the defendant bears the burden of persuasion that its conduct was within the limitation and therefore outside the scope of the copyright owner's exclusive right and not infringing, or whether that limitation means that the plaintiff, in order to show that the defendant's conduct in fact infringed on one of the copyright owner's exclusive rights, bears the burden of persuasion to establish that the conduct was within the scope of a right under section 106 as limited by sections 107 to 122.

## CONCLUSION

Understanding the implications of burdens of persuasion and burdens of production in copyright infringement litigation will provide greater analytical clarity to the complicated area of the burdens of proof in such litigation. In this Article we have attempted to advance that understanding through a clear articulation of the plaintiff's *prima facie* burden and the proper treatment of different defense arguments. Some of these defense arguments are properly understood as factual or legal rebuttals of the plaintiff's *prima facie* case while others are true affirmative defenses for which the defendant bears the burden of persuasion. Careful understanding of the burdens of persuasion, the different types of defense arguments, and the potential shifting of the burden of coming forward with additional evidence will aid

attorneys and courts in a more careful and thorough analysis of the facts and issues raised in any particular infringement case.