# **4 Nimmer on Copyright § 13.03**

***Nimmer on Copyright* > *CHAPTER 13 Infringement Actions— Substantive Aspects***

**§ 13.03 Substantial Similarity**

1. **The General Nature of Substantial Similarity**

Just as copying is an essential element of copyright infringement,[[1]](#footnote-2)1 so substantial similarity[[2]](#footnote-3)1.1 between the plaintiff’s and defendant’s works is an essential element of actionable copying.[[3]](#footnote-4)2 “This means that even where the fact of copying is conceded, no legal consequences will follow from that fact unless the copying is substantial.”[[4]](#footnote-5)2.1 Even when there is no dispute about (a) the validity of plaintiff’s copyright, (b) defendant’s access to the work, and (c) “very strong resemblances between them,” the result is only to show *probative* *similarity*[[5]](#footnote-6)2.1a—but the court may still grant summary judgment to defendant, to the extent that *substantial* *similarity* is lacking, as when defendant “took only the unprotected elements of Plaintiff’s work.”[[6]](#footnote-7)2.2

The determination of the extent of similarity that will constitute a *substantial*, and hence infringing, similarity presents one of the most difficult questions in copyright law,[[7]](#footnote-8)2.3 and one that is the least susceptible of helpful generalizations.[[8]](#footnote-9)3 It bears repeating, moreover, that the inquiry in this section is into improper appropriation, *i.e.,* actionable copying as a legal proposition.[[9]](#footnote-10)3.1 Although the term “substantial similarity” often is invoked as a proxy to prove copying as a factual proposition, we have seen that the term “probative similiarity” is to be preferred in that context and the question of “substantial similarity” arises analytically only thereafter.[[10]](#footnote-11)3.2 Moreover, the entire exercise delves into judge-made law, as Congress has never legislated the appropriate standard—and the Supreme Court itself has not weighed in to give definition to the field, so all the decisions on point emanate from the inferior courts.[[11]](#footnote-12)3.3

It is clear that slight or trivial similarities are not substantial and are therefore noninfringing.[[12]](#footnote-13)4 A given feature may betoken probative similarity[[13]](#footnote-14)4.1 but not rise to the level of substantial similarity.[[14]](#footnote-15)4.2 But it is equally clear that two works may not be literally identical[[15]](#footnote-16)5 and yet, for purposes of copyright infringement, may be found to be substantially similar.[[16]](#footnote-17)6 (The standards for originality and for substantial similarity should not be confused.[[17]](#footnote-18)6.1 While a mere “distinguishable variation” will constitute a sufficient quantum of originality so as to support a copyright in such variation,[[18]](#footnote-19)6.2 that same “distinguishable variation” in the work may not sufficiently alter its substantial similarity to another so as to negate infringement.)[[19]](#footnote-20)6.3

The problem, then, is one of line drawing.[[20]](#footnote-21)6.4 Somewhere between the one extreme of no similarity[[21]](#footnote-22)6.5 and the other of complete and literal similarity lies the line marking off the boundaries of “substantial similarity.” Judge Learned Hand has said that this line “wherever it is drawn will seem arbitrary”[[22]](#footnote-23)7 and that “the test for infringement of a copyright is of necessity vague.”[[23]](#footnote-24)8

In attempting to understand, and if possible to find, some usable guidelines in determining the manner in which courts have drawn the line of substantial similarity, it is helpful to distinguish between two quite different forms of similarity. This distinction has received almost no express judicial recognition,[[24]](#footnote-25)9 so that it is necessary to invent our own terminology in contrasting the two such forms. These may be called, respectively, comprehensive nonliteral similarity and fragmented literal similarity. The manner in which these forms differ, and the basis for determining substantial similarity in each, is considered in the following subsections.

1. **Comprehensive Nonliteral Similarity.**

We may first examine the situation where there is a comprehensive similarity between the two works in issue. By this is meant a similarity not just as to a particular line or paragraph or other minor segment,[[25]](#footnote-26)10 but where the fundamental essence or structure of one work is duplicated in another.[[26]](#footnote-27)11 If such duplication is literal or verbatim, then clearly substantial similarity results.[[27]](#footnote-28)11a The problem here under scrutiny is the situation where there is comprehensive similarity but no word-for-word or other literal similarity—what the Second Circuit terms “inexact-copy infringement.”[[28]](#footnote-29)11.1 The mere fact that the defendant has paraphrased rather than literally copied will not preclude a finding of substantial similarity.[[29]](#footnote-30)12 As Judge Learned Hand noted in words often quoted,[[30]](#footnote-31)12.1 copyright “cannot be limited literally to the text, else a plagiarist would escape by immaterial variations.”[[31]](#footnote-32)13

Balanced against this principle is the countervailing consideration that copyright does not protect against the borrowing of abstract ideas contained in the copyrighted work.[[32]](#footnote-33)14 Therefore, if the only similarity between plaintiff’s and defendant’s works is that of the abstract idea,[[33]](#footnote-34)14.1 there is an absence of *substantial* similarity and hence, no infringement results.[[34]](#footnote-35)15

If copyright protection is not limited to literal reproduction but does not prevent the borrowing of ideas, what sort of similarity short of the verbatim will constitute substantial similarity? The courts have answered this inquiry with the vague formula that if the defendant’s work copies not merely the idea, but “the expression of the idea” contained in plaintiff’s work, then the two works are substantially similar and infringement may be found.[[35]](#footnote-36)16 The House Report expressly endorses and perpetuates, under the current Act,[[36]](#footnote-37)17 this “idea-expression” dichotomy,[[37]](#footnote-38)17.1 so that it is now statutorily codified.[[38]](#footnote-39)18 This, however, is but a reformulation not a solution of the problem.[[39]](#footnote-40)19

1. ***Abstractions Test.***

In one of his last copyright cases, Judge Learned Hand said, “Obviously, no principle can be stated as to when an imitator has gone beyond the ‘idea,’ and has borrowed its ‘expression.’ Decisions must therefore inevitably be *ad hoc*.”[[40]](#footnote-41)20 But some thirty years earlier, Judge Hand did suggest not an immutable principle, but a helpful approach to the problem in his famous “abstractions test”:

Upon any work and especially upon a play a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about and at times consist of only its title,[[41]](#footnote-42)20.1 but there is a point in this series of abstractions where they are no longer protected since otherwise the playwright could prevent the use of his ideas to which apart from their expression his property is never extended.[[42]](#footnote-43)21

The abstractions test is helpful in that it vividly describes the nature of the quest for “the expression of an idea.”[[43]](#footnote-44)21a It does not, of course, tell us where in any given work the level of abstraction is such as to cross the line from expression to idea.[[44]](#footnote-45)21.1

1. ***Pattern Test.***

Professor Zechariah Chafee made some attempt to answer this most difficult question:

No doubt the line does lie somewhere between the author’s idea and the precise form in which he wrote it down. I like to say that the protection covers the “pattern” of the work … the sequence of events, and the development of the interplay of characters.[[45]](#footnote-46)22

The problem is probably susceptible of no more precise principle than that of the Chafee “pattern” test.[[46]](#footnote-47)23 Hand’s suggestion that a number of different patterns at different levels of abstraction will fit any work must be combined with Chafee’s suggestion that the operative pattern for purposes of determining substantial similarity is one that is in some degree abstract (omitting dialogue, minor incidents, possibly setting,[[47]](#footnote-48)24 etc.), but is nevertheless sufficiently concrete so as to contain an expression of the sequence of events and the interplay of the major characters.[[48]](#footnote-49)25

The pattern test, if correctly applied, offers a guide to decision that avoids the abandonment of reasoned analysis implicit in the conclusion that nothing more can be said than that each case turns on its own facts. “Romeo and Juliet” may be used to illustrate. Assuming Shakespeare’s works were not in the public domain, it is clear that no one could copy his drama concerning the star-crossed lovers of Verona merely by paraphrasing the dialogue with new (and no doubt less inspired) phrases. It is likewise clear that anyone could borrow the “idea” of a romance between members of two hostile families.[[49]](#footnote-50)26 Countless stories and plays have been based upon this abstract idea. Among the most famous of these in the twentieth century was “Abie’s Irish Rose.”[[50]](#footnote-51)27 No more of “Romeo and Juliet” is contained in “Abie’s Irish Rose” than the above idea and hence, under the pattern test, there is no substantial similarity.[[51]](#footnote-52)27.1 Contrast this with the musical play and motion picture, “West Side Story.”[[52]](#footnote-53)27.2 Because it involved a romance between members of two warring juvenile gangs in contemporary New York City, at first glance it might appear that this would no more constitute an infringement of “Romeo and Juliet” than does “Abie’s Irish Rose.” Certainly, the dialogue and setting, and even much of the characterization, story line and action, are far removed from the Shakespeare play. Yet, applying the pattern test, it will be seen that not merely the basic idea, but the essential sequence of events, as well as the interplay of the characters, are straight out of “Romeo and Juliet.”[[53]](#footnote-54)28 Thus, the following elements (among others) are found in both works:

1. The boy and girl are members of hostile groups.
2. They meet at a dance.
3. They acknowledge their love in a nocturnal balcony (fire escape) scene.
4. The girl is betrothed to another.
5. The boy and girl assume the marriage vows.
6. In an encounter between the hostile groups, the girl’s cousin (brother) kills the boy’s best friend.
7. This occurs because the boy attempts to stay the hand of his best friend in order to avoid violence.
8. In retaliation, the boy kills the girl’s cousin (brother).
9. As a result, the boy goes into exile (hiding).
10. A message is sent to the boy at his retreat, explaining a plan for him to meet the girl.
11. The message never reaches the boy.
12. The boy receives erroneous information that the girl is dead.
13. In grief, the boy kills himself (or permits himself to be killed).

The 13 points enumerated above constitute a description that is, in some degree, abstract in that many dissimilar details and some important story points in one or the other of the two works under comparison have been omitted. Still, this description is far from the highest possible level of abstraction, wherein only the basic idea (common to “Abie’s Irish Rose” as well) could be stated. These 13 points are sufficiently concrete to state the essential sequence of events and character interplay in each of the two works.[[54]](#footnote-55)29 Because this pattern is common to both works, it may be concluded that they are substantially similar.[[55]](#footnote-56)29.1

It must be said that not all courts would accept the above pattern as a sufficiently concrete expression of an idea so as to warrant a finding of substantial similarity.[[56]](#footnote-57)30 Indeed, some courts have said that a plot as such is not protectible,[[57]](#footnote-58)31 and that “an author’s exclusive rights are largely confined to the details in the manner and method of his own presentation. …”[[58]](#footnote-59)32 In most instances, however, those courts that have denied protection to a “plot” have so defined it as to be the equivalent of an abstract idea.[[59]](#footnote-60)33 Where plot is more properly defined[[60]](#footnote-61)33.1 as “the ‘sequence of events’ by which the author expresses his ‘theme’ or ‘idea,’ ”[[61]](#footnote-62)34 it constitutes a pattern that is sufficiently concrete so as to warrant a finding of substantial similarity if it is common to both plaintiff’s and defendant’s works.[[62]](#footnote-63)35 Thus, one decision[[63]](#footnote-64)36 expressly held that the copyright in a novel includes not “only the form of communication or the mechanism employed” but also “the pattern of the story,” adding: “The essence of a novel or any other story for that matter, is the plot, plan, arrangement, characters and dialogue therein contained and not simply its form of articulation.”[[64]](#footnote-65)37 Another case found substantial similarity based on identically named characters whose interactions and costumes were also almost identical.[[65]](#footnote-66)37.1

1. ***Total Concept and Feel.***

In 1970, the Ninth Circuit considered a case alleging infringement of plaintiff’s greeting cards.[[66]](#footnote-67)38 Given the “remarkable resemblance” between both plaintiff’s and defendant’s cards, the court had little trouble in finding infringement.[[67]](#footnote-68)39 The case is generally unremarkable, except for its having coined the phrase “total concept and feel” as applied to the graphic works at issue.[[68]](#footnote-69)40

“Total concept and feel” appeared again in a 1976 Second Circuit case involving two juvenile books.[[69]](#footnote-70)41 “We must first note that both stories, intended for children, are necessarily less complex than some other works submitted to pattern analysis.[[70]](#footnote-71)42 Therefore, in addition to the essential sequence of events, we might properly consider the ‘total concept and feel’ of the works in questions.”[[71]](#footnote-72)43

The following year, the Ninth Circuit breathed new life into the phrase. In *Sid & Marty Krofft Television Productions v. McDonald’s Corp.*,[[72]](#footnote-73)44 the court confronted another juvenile theme—the world of H. R. Pufnstuf, with fanciful sets, costumes, and funny voices.[[73]](#footnote-74)45 *Krofft* established a two-part test to determine substantial similarity—an “extrinsic test” to determine similarity in general ideas, and an “intrinsic test” to compare the particular expression used.[[74]](#footnote-75)46 Although “analytic dissection and expert testimony are appropriate” for the former test, the latter test scrupulously avoids such expert testimony; instead, the intrinsic test depends “on the response of the ordinary reasonable person.”[[75]](#footnote-76)47 With the bifurcated test in mind, the *Krofft* court’s citation to the 1970 formula is understandable:

The present case demands an even more intrinsic determination because both plaintiff’s and defendant’s works are directed to an audience of children. [The court then disapproves of dissection such as pointing out that plaintiff’s mayor wore a cummerbund while defendant’s mayor wore a diplomatic sash.] It is clear to us that defendant’s works are substantially similar to plaintiff’s. They have captured the “total concept and feel” of the Pufnstuf show.[[76]](#footnote-77)48

As of 1977, in light of the three cases in which it had been invoked, the “total concept and feel” rubric could have rested largely stagnant in a backwater of copyright law limited to juvenile works. Juvenile works themselves progressed, however, with the advent of the computer age. Thus, in *Atari, Inc. v. Amusement World, Inc.*,[[77]](#footnote-78)49 plaintiff claimed infringement of its audiovisual work,[[78]](#footnote-79)50 the arcade game “Asteroids,” by defendant’s rival “Meteors” game. The *Atari* court used the phrase “total concept and feel” in denying relief, relying on *Krofft.*[[79]](#footnote-80)51 More video game infringement suits followed,[[80]](#footnote-81)52 and in *Broderbund Software v. Unison World, Inc.*,[[81]](#footnote-82)53 the court invoked the phrase “total concept and feel” in a case involving a different type of computer-generated audiovisual work: the menus of a program for printing stationery, greeting cards, and other personalized paper goods.[[82]](#footnote-83)54

Although the foregoing genealogy explains the circumstances that gave rise to *Broderbund*’s invocation of the “total concept and feel” language in the computer context, such usage is unfortunate.[[83]](#footnote-84)55 It may, conceivably, make sense to refer to the “total concept and feel” of a greeting card or game or anthropomorphic fantasy world;[[84]](#footnote-85)55.1 the words utterly lose their meaning, however, as applied to source or object[[85]](#footnote-86)56 code.[[86]](#footnote-87)57 The phrase is geared towards simplistic works that require only a highly “intrinsic” (*i.e.,* unanalytic) evaluation;[[87]](#footnote-88)57.1 it serves no purpose in the realm of computers, where analytic dissection and expert testimony emphatically are needed.[[88]](#footnote-89)58

More broadly, the touchstone of “total concept and feel” threatens to subvert the very essence[[89]](#footnote-90)58.1 of copyright, namely the protection of original *expression*.[[90]](#footnote-91)59 “Concepts” are statutorily ineligible for copyright protection;[[91]](#footnote-92)60 for courts to advert to a work’s “total concept” as the essence of its protectible character seems ill-advised in the extreme. Further, the addition of “feel” to the judicial inquiry, being a wholly amorphous referent, merely invites an abdication of analysis.[[92]](#footnote-93)60.1 In addition, “total concept and feel” should not be viewed as a *sine qua non* for infringement[[93]](#footnote-94)61—similarity that is otherwise actionable cannot be rendered defensible simply because of a different “concept and feel.”[[94]](#footnote-95)62 In sum, therefore, the frequent invocations of this standard[[95]](#footnote-96)62.1 do little to bring order to the inquiry into what constitutes substantial similarity, and would be better abandoned.[[96]](#footnote-97)62.2

Of course, the failure of a court to invoke the mantra of “total concept and feel” does not guarantee that it will produce correct results, or even that it will avoid the pitfalls to which this approach is heir.[[97]](#footnote-98)62.3

The Ninth Circuit, which originally authored this formulation in 1970, appears to be moving towards its abandonment. For example, *Apple Computer, Inc. v. Microsoft Corp.*[[98]](#footnote-99)63 rejected application of that granddaddy 1970 case,[[99]](#footnote-100)63.1 notwithstanding that the dispute revolved around a graphical user interface rather than abstruse matters of computer code.[[100]](#footnote-101)63.2 Still, the standard crops up sporadically,[[101]](#footnote-102)63.3 such as the five-fold reiteration of “overall look and feel”[[102]](#footnote-103)63.4 in an architecture case.[[103]](#footnote-104)63.5 It has remained persistent particularly in the Second Circuit.[[104]](#footnote-105)63.6 That court ultimately defended the standard against this treatise’s critique:

Some commentators have worried that the “total concept and feel” standard may “invite[] an abdication of analysis,” because “feel” can seem a “wholly amorphous referent.” \* \* \* But our caselaw is not so incautious. Where we have described possible infringement in terms of whether two designs have or do not have a substantially similar “total concept and feel,” we generally have taken care to identify precisely the particular aesthetic decisions—original to the plaintiff and copied by the defendant—that might be thought to make the designs similar in the aggregate.[[105]](#footnote-106)63.7

It then rehabilitated the test by making it congruent, after all, with the filtering test[[106]](#footnote-107)63.8 urged below.[[107]](#footnote-108)63.9 Thus reformulated, the problems with this standard that are noted above fade into a matter of mere terminology.[[108]](#footnote-109)63.10 As one court summarizes the matter, “copyright infringement requires substantial similarity between protectable aspects of the allegedly infringing and infringed works.”[[109]](#footnote-110)63.11

Happily, that terminology seems to be fading away. In terms of published opinions, one finds only sporadic mention of “total concept and feel” in recent years. Even when it is mentioned,[[110]](#footnote-111)63.12 it usually does not constitute the crux of the court’s holding[[111]](#footnote-112)63.13—albeit with some exceptions.[[112]](#footnote-113)63.14

1. ***Other Tests.***

In the field of software infringement, some courts have viewed the foregoing tests as inadequate,[[113]](#footnote-114)64 and have formulated new approaches to determining substantial similarity.[[114]](#footnote-115)65 For instance, in *E.F. Johnson Co. v. Uniden Corp.*,[[115]](#footnote-116)66 the court applied an “iterative test” to determine whether infringement existed on the facts before it.[[116]](#footnote-117)67 Under this test, a *prima facie* case of infringement is established by showing:

(1) that the defendant “used” the copyrighted work in preparing the alleged copy, which may be established by proof of access and similarity sufficient to reasonably infer use of the copyright work; and (2) that the defendant’s work is an iterative reproduction, that is, one produced by iterative or exact duplication of substantial portions of the copyrighted work.[[117]](#footnote-118)68

This test appears to complicate, rather than simplify, the comparison of two computer programs. The first prong, “use” of defendant’s program, amounts to little more than a variation of the traditional substantial similarity analysis. Under this formulation, in addition to ascertaining whether there has been access, the trier of fact still must decide if there is similarity sufficient to infer “use,” without any guidance as to how this determination relates to traditional notions of substantial similarity. The second prong, “iterative reproduction,” does not clarify what level of similarity between two programs is required to find infringement, but merely requires that the source of the similarity be literal copying or direct translation of the plaintiff’s program.

This test’s focus on “use,” even when coupled with proof of literal copying, misses the mark as a criterion for determining whether copyright infringement has occurred. If the defendant “used” plaintiff’s program only to extract its ideas, or to borrow elements that plaintiff had taken from the public domain, no infringement should be found regardless of the quantum of literal copying.[[118]](#footnote-119)69 Furthermore, this test does not protect plaintiffs from copying that does not involve literal copying of code or direct translation. If protection is to be afforded to nonliteral elements of a program, such as its sequence of operations, the “iterative” test seems completely unworkable.[[119]](#footnote-120)70

Nevertheless, one salutary aspect of the *Uniden* test is its recognition that expert testimony is essential to any analysis of the similarities between computer programs.[[120]](#footnote-121)71 A shift away from the ordinary observer and toward an informed analysis, guided by experts, of the similarities between two programs moves infringement analysis a step in the proper direction.[[121]](#footnote-122)72

At the opposite pole from the constrained type of copying examined by the “iterative test” is providing protection to the “structure, sequence, and organization” of a computer program. In *Whelan Associates v. Jaslow Dental Laboratory*,[[122]](#footnote-123)73 the Third Circuit extended copyright protection to a computer program’s “structure,” “sequence,” and “organization.”[[123]](#footnote-124)74 *Whelan* involved two programs to automate the business aspects of operating a dental laboratory. Both programs performed the same functions, produced similar outputs, and had similar menus, screen displays and input formats for the operator to use. However, the programs were written in different programming languages, and the parties acknowledged that there was no literal copying of the program code. Rather, the *Whelan* court affirmed the district court’s finding of infringement based on the substantial similarity of the organization and structure of both computer programs.[[124]](#footnote-125)75

Although *Whelan* reached the correct result given the facts of that case,[[125]](#footnote-126)76 its sweeping rule and broad language extend copyright protection too far.[[126]](#footnote-127)76.1 Providing protection for such amorphous concepts as the “overall structure”[[127]](#footnote-128)77 of a program, without considering whether such a structure is protectible under traditional copyright theories, increases the risk of granting copyright holders protection on a par with that provided to patent holders.[[128]](#footnote-129)78 Such a result could be disastrous, given that neither the safeguard of patent examination[[129]](#footnote-130)79 nor the *quid pro* *quo* of disclosure[[130]](#footnote-131)80 is required to receive copyright protection.[[131]](#footnote-132)81 Creative development in the software industry may well be stifled by overly broad copyright protection afforded to programs that represent the basic building blocks of a particular field.

Furthermore, the uncertainty created by the *ad hoc* nature of the software cases, such as those canvassed above, hampers development and progress in the computer software field. Software developers have no adequate guidelines regarding what level of independent development is required to avoid copyright infringement.[[132]](#footnote-133)82 As a result, many developers may forsake expansions or improvements of existing types of programs for fear of lawsuits based on apparent similarities between their product and an existing product.[[133]](#footnote-134)83

Nonetheless, like the *Uniden* case treated above, *Whelan* also has the virtue of allowing expert testimony to determine substantial similarity of computer programs, rather than relying simply on the illusory reaction of a lay audience to an array of source code or object code.[[134]](#footnote-135)84 Although several courts have now declined to follow *Whelan*’s lead in software infringement analysis,[[135]](#footnote-136)84.1 that particular aspect of the opinion is likely to remain an enduring advancement.[[136]](#footnote-137)84.2

The dominant test for determining substantial similarity between computer programs has now become the Second Circuit’s approach in *Computer Associates International, Inc. v. Altai, Inc.*[[137]](#footnote-138)84.3 That case relies on a filtration approach in making its analysis.[[138]](#footnote-139)84.4 After setting forth in detail the nature of that audience test as it has developed through the case law,[[139]](#footnote-140)85 a subsequent section of this treatise returns to the complexity of issues posed by evaluating substantial similarity in the context of computer software, and discusses *Altai*’s filtration approach in depth.[[140]](#footnote-141)86

1. ***Similarity of Limited Segments.***

Up to now in this Section, we have considered the determination of substantial similarity where there is comprehensive nonliteral similarity with respect to the entire structure of plaintiff’s work. Suppose there is nonliteral similarity only with respect to a particular episode, incident, or segment of plaintiff’s work? If the segment that finds a similar counterpart in defendant’s works is a copyrightable portion[[141]](#footnote-142)87 of a collective work,[[142]](#footnote-143)88 then the requirement that the similarity be “substantial,” in the sense that it represents a substantial portion of the plaintiff’s entire work,[[143]](#footnote-144)89 may not be applicable.[[144]](#footnote-145)90 Apart from this consideration, it has been held that similarity with respect to only one sequence of plaintiff’s motion picture (representing 20 percent of the entire film) was sufficient to constitute substantial similarity.[[145]](#footnote-146)91 However, a particular incident not constituting a major portion of plaintiff’s work has been held insufficient in itself to constitute substantial similarity.[[146]](#footnote-147)92

1. **Fragmented Literal Similarity.**

Where there is literal similarity (virtually, though not necessarily, completely word for word)[[147]](#footnote-148)92.1 between plaintiff’s and defendant’s works, the difficult problem discussed in the preceding subsection does not arise.[[148]](#footnote-149)92.2 That is, it is not necessary to determine the level of abstraction at which similarity ceases to consist of an “expression of ideas,” because literal similarity by definition is always a similarity as to the expression of ideas.[[149]](#footnote-150)92.3 But suppose the similarity, although literal, is not comprehensive—that is, the fundamental substance, or skeleton or overall scheme, of the plaintiff’s work has not been copied; no more than a line, or a paragraph, or a page or chapter of the copyrighted work has been appropriated.[[150]](#footnote-151)92.4 At what point does such fragmented similarity become substantial so as to constitute the borrowing an infringement?[[151]](#footnote-152)92.5

1. ***In General.***

In any given case, this question cannot be answered without a consideration of the purpose for which the defendant’s work will be used.[[152]](#footnote-153)93 This aspect of the matter is considered in an ensuing section, dealing with the doctrine of fair use.[[153]](#footnote-154)94 However, the defense of fair use is often invoked without reference to the particular use employed by the defendant, and merely as an alternative label for similarity that is not infringing because it is not substantial.[[154]](#footnote-155)95 This terminology is unfortunate: the meaning of “fair use” is thereby rendered confusingly ambiguous.[[155]](#footnote-156)95.1 It may simply mean an insubstantial similarity regardless of defendant’s use, or it may mean substantial similarity that would constitute an infringement but for the particular purpose and use of the resulting work by the defendant. Hence, we will here consider certain cases that purport to turn on the doctrine of fair use, but actually simply determine whether, in the given instance, there is substantial similarity between the two works.

No easy rule of thumb can be stated as to the quantum of fragmented literal similarity permitted without crossing the line of substantial similarity.[[156]](#footnote-157)96 This issue is said to present “a classic jury question.”[[157]](#footnote-158)96.1 The question in each case is whether the similarity relates to matter that constitutes a substantial portion of plaintiff’s work—not whether such material constitutes a substantial portion of defendant’s work.[[158]](#footnote-159)97 Thus, for example, the fact that the sampled material is played throughout *defendants’* song cannot establish liability, if that snippet constitutes an insubstantial portion of *plaintiff’s* composition.[[159]](#footnote-160)97.1 The quantitative relation of the similar material to the total material contained in plaintiff’s work is certainly of importance.[[160]](#footnote-161)98 However, even if the similar material is quantitatively small, if it is qualitatively important, the trier of fact may properly find substantial similarity.[[161]](#footnote-162)99 Thus, in one oft-cited case, the court held infringing defendant’s broadcast of one 12-second segment and one two-and-a-half-minute segment from plaintiff’s film.[[162]](#footnote-163)99.1 In general under such circumstances, the defendant may not claim immunity on the grounds that the infringement “is such a little one.”[[163]](#footnote-164)100 If, however, the similarity is only as to nonessential matters, then a finding of no substantial similarity should result.[[164]](#footnote-165)101 That scenario could unfold to the extent that defendant copied a small amount of plaintiff’s text[[165]](#footnote-166)101.1 or of entries from plaintiff’s[[166]](#footnote-167)101.2 compilation,[[167]](#footnote-168)101.3 or briefly sampled plaintiff’s sound recording,[[168]](#footnote-169)101.4 or to the extent that the subject reproduction is fleeting and out-of-focus.[[169]](#footnote-170)101.5

It follows, then, that the determination of substantial similarity with respect to fragmented literal similarity, just as with comprehensive nonliteral similarity, in the last analysis requires a value judgment.[[170]](#footnote-171)101.6 Long ago, Justice Story stated the guiding principle:[[171]](#footnote-172)101.7

If so much is taken that the value of the original is sensibly diminished, or the labors of the original author are substantially to an injurious extent appropriated by another, that is sufficient in point of law to constitute a piracy *pro tanto.*[[172]](#footnote-173)102

But this oft-repeated principle[[173]](#footnote-174)103 does not tell the trier of fact when in any given instance the value of the original is sensibly diminished or injuriously appropriated. The trier must ultimately determine the importance of that material that is common to both parties’ works. The procedure for such determination is discussed in a subsequent subsection.[[174]](#footnote-175)104 It may here be noted, however, that the qualitative importance for a given quantity of similar material may well vary according to the type of work in question. With respect to commercial documents, for example, the similarity probably must be more extensive than in the case of more artistic works in order to justify a finding of substantial similarity.[[175]](#footnote-176)105 Even in a musical composition, ordinarily, similarity must be found in more than a brief and commonplace musical sequence,[[176]](#footnote-177)106 or merely in motif.[[177]](#footnote-178)107 However, similarity in the accompaniment, but not in the melody, has been held sufficient to constitute an infringement.[[178]](#footnote-179)108

Is there any minimum quantitative measure, so that if the fragmented literal similarity is less than such measure as a matter of law, there may not be a finding of substantial similarity? Although it could be safely said that a similarity limited to a single note never suffices,[[179]](#footnote-180)108.1 the superstition among many musicians that the copying of three bars from a musical work can never constitute an infringement is, of course, without foundation.[[180]](#footnote-181)108.2 Likewise mythical is the manufacturer’s defense of making seven changes to a garment.[[181]](#footnote-182)108.3 Rather, the evaluation must occur in the context of each case, both qualitatively and quantitatively.[[182]](#footnote-183)108.3a

In one case, the alleged similarity consisted of a seven-note rising and cascading lyrical melody.[[183]](#footnote-184)108.4 The court properly distinguished between the subject sound recording and musical composition.[[184]](#footnote-185)108.4a As to plaintiff’s sound recording copyright,[[185]](#footnote-186)108.5 the similarity was non-actionable, inasmuch as it did not result from sound recapture.[[186]](#footnote-187)108.6 As to plaintiff’s musical composition copyright,[[187]](#footnote-188)109 defendant failed to address the conclusion of plaintiff’s expert that those seven notes represented a common public domain motif, dating back to Seventeenth Century German folk songs and found in Bach, Beethoven, and the Beatles.[[188]](#footnote-189)109.1 The liability case thereupon collapsed.

Turning to the literary realm, when the literal similarity consists of a passage[[189]](#footnote-190)109.2 that runs as much as three or four hundred words, it is clear that the trier may properly conclude that such similarity is substantial.[[190]](#footnote-191)110 But what if the similarity is only as to a single sentence? Ordinarily, the importance of but one line in plaintiff’s work would be regarded as *de minimis*,[[191]](#footnote-192)111 not justifying a finding of substantial similarity.[[192]](#footnote-193)112 In at least one case, however, it was held that the copying of but a single sentence constituted a “substantial taking,” at least for the purpose of issuing a preliminary injunction.[[193]](#footnote-194)113 In another opinion, Judge Jerome Frank stated: “There may be wrongful copying, though small quantitatively; so if someone were to copy the words, ‘Euclid alone has looked on Beauty bare,’ or ‘Twas brillig and the slithy toves.’ ”[[194]](#footnote-195)113.1 Still, it is most unusual for infringement to be found on the basis of similarity of a single line,[[195]](#footnote-196)113.2 and generally, the likelihood of copying but a single line of such importance, as to warrant a finding of substantial similarity, is remote.

1. ***A Special Rule for Sampling?***

On general principles, it would seem that the practice of digitally sampling[[196]](#footnote-197)114 prior music[[197]](#footnote-198)114.1 to use in a new composition should not be subject to any special analysis:[[198]](#footnote-199)114.2 to the extent that the resulting product is substantially similar to the sampled original, liability should result.[[199]](#footnote-200)114.3 Yet against that conclusion comes an unprecedented trio of opinions in *Bridgeport Music, Inc. v. Dimension Films*.[[200]](#footnote-201)114.4 At issue was a two-second sample of a guitar solo, in which the pitch was lowered and then extended to sixteen beats.[[201]](#footnote-202)114.5 The district court in that case, unswayed by “the fact of blatant copying,” held nonactionable defendant’s activity of looping that sample repeatedly, given no possibility of recognizing the derivation of defendant’s work from plaintiff’s.[[202]](#footnote-203)114.6 The Sixth Circuit reversed. In so ruling, it adopted a bright-line rule at odds with the balance of jurisprudence canvassed throughout this section, by adopting appellant’s argument that “no substantial similarity or *de minimis* inquiry should be undertaken at all when the defendant has not disputed that it digitally sampled a copyrighted sound recording.”[[203]](#footnote-204)114.7

The linchpin for the court’s conclusion lies in its interpretation of Section 114(b) of the Copyright Act. It reasons from the 1976 Act’s addition of the word “entirely” into the following sentence:[[204]](#footnote-205)114.8

The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording.[[205]](#footnote-206)114.9

That sentence immunizes the maker of a sound-alike recording; if *no* sounds are recaptured, the newcomer is categorically exempt from liability to the owner of the sound recording.[[206]](#footnote-207)114.10 From that proposition, the panel summarily reasons that if *some* sounds are recaptured, the newcomer’s liability is complete.[[207]](#footnote-208)114.11 But it is submitted that that conclusion[[208]](#footnote-209)114.12 rests on a logical fallacy.[[209]](#footnote-210)114.13 By validating entire sound-alike recordings, the quoted sentence contains no implication that partial sound duplications are to be treated any differently from what is required by the traditional standards of copyright law—which, for decades prior to adoption of the 1976 Act and unceasingly in the decades since, has included the requirement of substantial similarity.[[210]](#footnote-211)114.14

Indeed, had *Bridgeport Music* consulted Section 114’s legislative history instead of dismissing that history as irrelevant,[[211]](#footnote-212)114.15 it would have discovered that Congress explicitly noted in that context that “infringement takes place whenever all or any *substantial portion* of the actual sounds that go to make up a copyrighted sound recording are reproduced in phonorecords by repressing, transcribing, recapturing off the air, or any other method … .”[[212]](#footnote-213)114.16 That excerpt[[213]](#footnote-214)114.17 debunks the court’s imputation that Congress, when adopting Section 114, intended to dispense with traditional notions of substantial similarity.[[214]](#footnote-215)114.18

Further, even if Congress had not spoken plainly in 1976, the Supreme Court outlined the elements of copyright infringement in 1991 to include “copying of constituent elements of the work that are original.”[[215]](#footnote-216)114.19 *Bridgeport Music* neither cites that 1991 authority[[216]](#footnote-217)114.20 nor explains how the copied two seconds amount to an original composition.[[217]](#footnote-218)114.21

Moreover, the very process by which *Bridgeport Music* expands the rights of copyright owners through construing Section 114 rests on a misapprehension of the statutory structure.[[218]](#footnote-219)114.22 The Copyright Act sets forth in Section 106 the rights of copyright owners;[[219]](#footnote-220)114.23 in the following Sections 107 through the end of its Chapter 1, the Act then enumerates limitations on those rights.[[220]](#footnote-221)114.24 Given that every right granted by Section 106 has always been subject to a substantial similarity analysis,[[221]](#footnote-222)114.25 it defies precedent for *Bridgeport Music* to blithely discard that requirement. When one reflects that Section 114 imposes a *limitation* on the rights granted copyright holders by Section 106,[[222]](#footnote-223)114.26 it becomes even less comprehensible how the court could interpret Section 114 to *expand* the rights enjoyed by proprietors, such that they do not need to demonstrate substantial similarity between defendant’s purportedly infringing production and their own copyrighted works.

Perhaps the court was led into error by secondary sources that refer to sound-recapture in the language that “the sampler physically copied the copyrighted sound recording of another.”[[223]](#footnote-224)114.27 Yet it is no more (or less) accurate to posit that “physical” copying occurs in sound recapture than in the paradigmatic example invoked below of absence of substantial similarity: for a defendant to handwrite on a piece of paper the words “The End” from a favorite poem used as an inspiration, the balance of the new work being entirely of defendant’s creation.[[224]](#footnote-225)114.28 Whether the conduct at issue is sound duplication or sound imitation, the defendant who would create a new work must fix materials into a tangible medium of expression;[[225]](#footnote-226)114.29 a distinction based on “physical copying”[[226]](#footnote-227)114.30 versus something else thus seems to be built on air.[[227]](#footnote-228)114.31 It is therefore difficult to subscribe to the court’s conclusion that sampling represents “a physical taking rather than an intellectual one.”[[228]](#footnote-229)114.32

One of the Sixth Circuit’s early opinions in the *Bridgeport Music* series left no room for defendant to prevail.[[229]](#footnote-230)114.33 By the time the final pronouncement came, however, the panel retreated from that conclusion. Accordingly, notwithstanding its rule that any digital sampling obviates plaintiff’s burden to prove substantial similarity, *Bridgeport Music* still allows defendant to prevail if it can establish fair use.[[230]](#footnote-231)114.34 It seems that no matter how fervently the Sixth Circuit wanted to paint sampling in black and white,[[231]](#footnote-232)114.35 a thousand shades of grey ineluctably remain[[232]](#footnote-233)114.36 to cloud the issue.[[233]](#footnote-234)114.37

Notwithstanding the three sequential panel decisions in *Bridgeport Music*,[[234]](#footnote-235)114.38 it is respectfully submitted that sampling is simply one method by which to commit copyright infringement. Accordingly, for courts not bound by that ruling, the inquiry should remain whether the sampled portions are substantially similar to plaintiff’s work.[[235]](#footnote-236)114.39 If so—but only if so—then liability should result.[[236]](#footnote-237)115

Indicative of just that approach is an opinion from the Southern District of New York. The court analyzed sampling[[237]](#footnote-238)115.1 by applying traditional strictures of fragmented literal similarity,[[238]](#footnote-239)115.2 without even citing to the *Bridgeport* trio.[[239]](#footnote-240)115.3 At issue were various sound recordings[[240]](#footnote-241)115.4 from the musical group Trouble Funk, which the Beastie Boys[[241]](#footnote-242)115.5 sampled[[242]](#footnote-243)115.6 in segments ranging from one to six seconds.[[243]](#footnote-244)115.7 The opinion dismissed various claims—it found a three-second drum sequence to be neither qualitatively nor quantitatively significant to the original work,[[244]](#footnote-245)115.8 reached the same conclusion about three seconds of “punchy guitar chords backed by percussion under the distinctive shouted lyrics, ‘Now I want y’all to break this down,’ ”[[245]](#footnote-246)115.9 and denied plaintiff’s originality to a common sound effect called *Drop the Bomb* that often accompanies falling objects in cartoons.[[246]](#footnote-247)115.10 On the other hand, Judge Nathan refused to dismiss two other counts of the complaint. One involved a three-second “distinctive orchestra sequence” consisting of “a series of five punchy ascending chords.”[[247]](#footnote-248)115.11 She concluded that this sample was the most significant to the original work of all the matters at issue.[[248]](#footnote-249)115.12 Somewhat surprisingly, the other involved only a one-second sample—its “distinctive vocal sequence” of shouting the song’s title *Say What*[[249]](#footnote-250)115.13 passed the court’s threshold such that it could not conclude as a matter of law that the sample was substantively insignificant to the original.[[250]](#footnote-251)115.14 In sum, this mixed decision therefore does not categorically negate the pro-plaintiff result under *Bridgeport*; it simply refuses to abdicate analysis of substantial similarity in the face of admitted sampling.

That case does not stand alone. Another district court opinion,[[251]](#footnote-252)115.14a in which the sample was one second long,[[252]](#footnote-253)115.14b adopted this treatise’s criticism of *Bridgeport Music*.[[253]](#footnote-254)115.14c The affirmance of that case went off on other grounds.[[254]](#footnote-255)115.14d

Nonetheless, the Sixth Circuit’s ruling has not emerged unscathed at the circuit court level. The issue returned to the fore in the context of Madonna’s hit song “Vogue.” In *VMG Salsoul, LLC v. Ciccone*, the copyright owner of the song “Love Break” claimed that defendant Madonna Louise Ciccone sampled “a 0.23-segment of horns” from that earlier song.[[255]](#footnote-256)115.14e Rather than appearing exactly as in the original, however, the evidence (in the light most favorable to plaintiff) showed that the horns were isolated by filtering out other instruments; the product was transposed to a different key; it was truncated; and different sounds and other effects were added to it.[[256]](#footnote-257)115.14f As a result, “[e]ven if one grants the dubious proposition that a listener recognized some similarities between the horn hits in the two songs, it is hard to imagine that he or she would conclude that sampling had occurred.”[[257]](#footnote-258)115.14g

Based on the ruling in *Bridgeport*, plaintiff sought summary judgment. The Ninth Circuit parted company with that Sixth Circuit ruling, based on this treatise’s analysis set forth above.[[258]](#footnote-259)115.14h Although loath to create a circuit split, the majority’s “careful reflection” in this case caused it to adhere to the clear congressional intent not to allow any special exception for sampling[[259]](#footnote-260)115.14i to the general rules on proving substantial similarity.[[260]](#footnote-261)115.14j Nonetheless, the opinion allowed that plaintiff’s reliance on *Bridgeport* was not so objectively unreasonable as to warrant an award of fees against it.[[261]](#footnote-262)115.14k

1. **Alternate Formulations.**

As noted at the outset of this section, the terms “comprehensive nonliteral similarity” and “fragmented literal similarity”[[262]](#footnote-263)115.15 emerge from this treatise. Although not the product of previous judicial articulation, they have in the interim won widescale judicial acceptance.[[263]](#footnote-264)115.16

Nonetheless, particularly in circuits that follow the “audience test,”[[264]](#footnote-265)115.17 those categories do not necessarily represent an exhaustive enumeration of the means by which substantial similarity can be shown.[[265]](#footnote-266)115.18 In *Castle Rock Enter. v. Carol Publishing Group, Inc,*[[266]](#footnote-267)115.19 the Second Circuit sustained a finding that the defendant’s quiz book was substantially similar to plaintiff’s *Seinfeld* TV show, notwithstanding that the absence of direct quotation or close paraphrasing meant that there was no fragmented literal similarity and the absence as well of duplication of structure or fundamental essence meant that there was no comprehensive nonliteral similarity.[[267]](#footnote-268)115.20 Another oddity about *Castle Rock. v. Carol Publishing* is that the 643 fragments comprising defendant’s work were culled from 84 separately registered *Seinfeld* episodes.[[268]](#footnote-269)115.21 The question thus arises whether the analysis should proceed no differently than if 84 different plaintiffs were aggrieved about the trespass on their individual works. Militating in favor of that stance is the Act itself.[[269]](#footnote-270)115.22 But the court nonetheless ruled that such a construction elevates form over substance, at least in the case of a continuous television series.[[270]](#footnote-271)115.23 Perhaps the resolution in this case is due to the fact that it arose at the intersection of several unusual features.[[271]](#footnote-272)115.24 In any event, the court did not purport to offer an alternative general formulation[[272]](#footnote-273)115.25 beyond scrutinizing substantiality of similarity from both quantitative and qualitative[[273]](#footnote-274)115.26 perspectives.[[274]](#footnote-275)115.27

(It should be added that not even the author of the *Seinfeld* case adhered to its logic in subsequent rulings.[[275]](#footnote-276)115.28 Likewise another case rejected plaintiff’s “aggregation” theory of infringement, attempting to place the style of her entire *oeuvre* at issue.[[276]](#footnote-277)115.29 From the opposite perspective of plaintiff’s aggregation of her own works, another plaintiff tried to prevail against popular novelist Clive Cussler not because any of his individual novels resembled plaintiff’s manuscript, but alleging that his output as a whole did so. The court roundly rejected that manner of proceeding.)[[277]](#footnote-278)115.30

The *Seinfeld* case raises to the fore how to treat similarity relating to multiple works—what happens if (1) plaintiff owns the copyright in a series of works, (2) no substantial similarity exists between defendant’s work and any one of plaintiff’s works, but (3) there is substantial similarity between plaintiff’s series as a whole and defendant’s work? One could posit, as did the Second Circuit in that case (as well as in an earlier one),[[278]](#footnote-279)115.31 that defendant should not be able to avoid liability by the fact that plaintiff’s claim is predicated upon several different copyrights rather than a single one.[[279]](#footnote-280)115.32 But a danger exists here—the broader the series, the more all-encompassing plaintiff’s copyright becomes, thereby squelching new expression in direct defiance to copyright’s mandate of stimulating the production of new works.[[280]](#footnote-281)115.33 Together with the statutory language noted above that favors a focus on each individual work,[[281]](#footnote-282)115.34 great caution is required before adopting any rule that plaintiff may aggregate the works of a series into a single claim.

In a case brought by J.K. Rowling against an unauthorized lexicon of her series of novels, the court quoted the warning set forth above and then distinguished its own facts:[[282]](#footnote-283)115.35 “In this case, however, because the *Harry Potter* novels tell one coherent narrative in a series, rather than tell discrete tales, the danger identified by *Nimmer* is less likely to exist.”[[283]](#footnote-284)115.36 But even without reaching those considerations, on the facts presented in the *Harry Potter* case, unlike those in the *Seinfeld case*, defendants closely paraphrased the copyrighted work in numerous instances.[[284]](#footnote-285)115.37 Some of that paraphrasing could have escaped liability had plaintiff’s work itself been non-fiction; but given that the copyrighted works consisted of a set of novels, defendants had much less latitude to slavishly ape plaintiff’s descriptions.[[285]](#footnote-286)115.38

1. **“Thin” Copyrights and “Supersubstantial” Similarity.**

The measure of how substantial a “substantial similarity” must be may vary according to circumstances. Many copyrights represent significant creative effort, and are therefore reasonably robust, whereas others reflect only scant creativity.[[286]](#footnote-287)115.39 The Supreme Court labels protection of the latter “thin.”[[287]](#footnote-288)115.40 More similarity is required when less protectible matter is at issue.[[288]](#footnote-289)115.41 Thus, if substantial similarity is the normal measure required to demonstrate infringement, “supersubstantial” similarity[[289]](#footnote-290)115.42 must pertain[[290]](#footnote-291)115.43 when dealing with works subject to only “thin” protection.[[291]](#footnote-292)115.44

At the limiting case of “the thinnest of copyright protection,” entire duplication would be required.[[292]](#footnote-293)115.45 In line with that approach, the Ninth Circuit has held, “When the range of protectable and unauthorized expression is narrow, the appropriate standard for illicit copying is virtual identity.”[[293]](#footnote-294)115.46 As an example, when plaintiff registered for copyright a logo containing a milk crate and sleeved record album, defendant did not infringe by placing on its tennis shoe a milk crate and unsleeved record album with different coloring, shading, angle, and accompanying words.[[294]](#footnote-295)115.46a Of course, such virtual identity is not the same as absolute identity. In the words of the Second Circuit, even a thin copyright is not “anorexic.”[[295]](#footnote-296)115.47 Thus, tiny variations fail to detract from supersubstantial similarity,[[296]](#footnote-297)115.48 albeit greater distinctions do indeed negate liability.[[297]](#footnote-298)115.49

The foregoing reference to “thin” copyright protection has inspired one court to formulate a taxonomy of creativity, and the corresponding protection afforded each type:

There are three types of work that are entitled to copyright protection—creative, derivative, and compiled. Copyrights in these three distinct works are known as creative, derivative, and compilation copyrights. An example of a creative work is a novel. An example of a derivative work is a screenplay based on a novel; it is called “derivative” because it is based on a preexisting work that has been recast, transformed, or adapted. An example of a compilation is Warren’s Factbook. The Act has created a hierarchy in terms of the protection afforded to these different types of copyrights. A creative work is entitled to the most protection, followed by a derivative work, and finally by a compilation. This is why the *Feist* Court emphasized that the copyright protection in a factual compilation is “thin.”[[298]](#footnote-299)115.50

The Eleventh Circuit later quoted that language from its earlier opinion; *Intervest Construction Inc. v. Canterbury Estate Homes, Inc.* deemed an architectural work to be essentially a compilation of unprotectible elements protected by a thin copyright.[[299]](#footnote-300)115.51

Though agreeing with *Intervest*’s result, the Second Circuit in *Zalewski v. Cicero Builder Development, Inc.*, disagreed with its reasoning:[[300]](#footnote-301)115.52 “ ‘Creative,’ ‘derivative,’ and ‘compiled’ may be useful concepts in some cases, but we reject the idea that works always fall neatly into one of these categories.”[[301]](#footnote-302)115.53 Rather than singling out architecture for special copyright treatment, every “work of art will have some standard elements, which taken in isolation are uncopyrightable,” meaning that the “challenge in adjudicating copyright cases is … to determine what in it originated with the author and what did not.”[[302]](#footnote-303)115.54 Instead of the categories just posited, this opinion looked to traditional copyright doctrines, such as merger, scenes a faire, and the public domain.[[303]](#footnote-304)115.55 Under the facts presented, those aspects negated substantial similarity.[[304]](#footnote-305)115.56 Notwithstanding the hours that plaintiff expended in admittedly imbuing some of his own expression into the subject designs, his resulting copyright was “very thin”—and not so closely copied as to lead to liability.[[305]](#footnote-306)115.57 Courts within the Second Circuit follow *Zalewski*[[306]](#footnote-307)115.57a and the Seventh Circuit also agrees with it.[[307]](#footnote-308)115.57b

Later, the Eleventh Circuit reformulated *Intervest*. A jury awarded plaintiff $127,000 in actual damages for defendant’s copying of its plans with only the “slight modification” of adding “a ‘his and hers’ closet.”[[308]](#footnote-309)115.58 But the other pervasive “modest dissimilarities” throughout moved the district court to throw out the jury verdict on the strength of *Intervest*.[[309]](#footnote-310)115.59 In affirming, the Court of Appeals noted *Zalewski*’s criticism[[310]](#footnote-311)115.60 and agreed with “both the reasoning and outcome” of that Second Circuit case.[[311]](#footnote-312)115.61 It characterized its earlier *Intervest* case as “best couched as holding that there was no copyright infringement because the floor plans at issue were similar only with respect to their noncopyrightable elements,”[[312]](#footnote-313)115.62 and then turned ecumenical: both “*Intervest* and *Zalewski* control this case.”[[313]](#footnote-314)115.63 Given that the features of plaintiff’s design were “not unusual but humdrum,”[[314]](#footnote-315)115.64 the verdict could not stand.[[315]](#footnote-316)115.65

One case applied the standards of supersubstantiality[[316]](#footnote-317)115.66 in the “novel situation” of architectural works in which “nearly every design element of the two houses at issue” were dictated by external constraints.[[317]](#footnote-318)115.67 In particular, the homes were located in Colonial Williamsburg, a development subject to a 102-page handbook precisely mandating stylistic requirements for the traditional[[318]](#footnote-319)115.68 Georgian architecture required throughout.[[319]](#footnote-320)115.69 The court therefore denied liability under copyright law.[[320]](#footnote-321)115.70 The Fourth Circuit vacated that ruling and remanded for determination under the traditional test for substantial similarity, not the variant that demands “supersubtantiality.”[[321]](#footnote-322)115.71 On remand, the trial court again ruled in defendant’s favor based on absence of substantial similarity.[[322]](#footnote-323)115.72

Other architecture cases have likewise recognized only “thin” protection to plaintiffs’ works[[323]](#footnote-324)115.73 and have been unimpressed by the congruence of common features.[[324]](#footnote-325)115.74 Of course, not all decisions rule in favor of architecture defendants.[[325]](#footnote-326)115.75

The all-American girl makes her own distinctive contribution here. Mattel’s iconic Barbie, far from being flattered by the imitation she perceived in MGA’s Bratz dolls (“The Girls With a Passion for Fashion!”), filed suit for copyright infringement.[[326]](#footnote-327)115.76 After Mattel prevailed at trial, the Ninth Circuit reversed.[[327]](#footnote-328)115.77 It analyzed Mattel’s two theories: protection in the preliminary sculpt (“a mannequin-like plastic doll body without skin coloring, face paint, hair or clothing”)[[328]](#footnote-329)115.78 and protection in sketches of the dolls to be manufactured. Given that protection inheres in expression rather than ideas,[[329]](#footnote-330)115.79 “MGA was free to look at Bryant’s[[330]](#footnote-331)115.80 sketches and say, ‘Good idea! We want to create bratty dolls too.’ ”[[331]](#footnote-332)115.81 The freedom to copy ideas leads directly to the matter under investigation.

If there’s a wide range of expression (for example, there are gazillions of ways to make an aliens-attack movie), then copyright protection is “broad” and a work will infringe if it’s “substantially similar” to the copyrighted work. If there’s only a narrow range of expression (for example, there are only so many ways to paint a red bouncy ball on blank canvas), then copyright protection is “thin” and a work must be “virtually identical” to infringe.[[332]](#footnote-333)116

Applying those considerations to the doll sculpts at issue, Chief Judge Kozinski concluded that MGA deserved “only thin protection against virtually identical works.”[[333]](#footnote-334)116.1 The opinion elaborated:

Producing small plastic dolls that resemble young females is a staple of the fashion doll market. To this basic concept, the Bratz dolls add exaggerated features, such as an oversized head and feet. But many fashion dolls have exaggerated features—take the oversized heads of the Blythe dolls and My Scene Barbies as examples. Moreover, women have often been depicted with exaggerated proportions similar to those of the Bratz dolls—from Betty Boop to characters in Japanese anime and Steve Madden ads. The concept of depicting a young, fashion-forward female with exaggerated features, including an oversized head and feet, is therefore unoriginal as well as an unprotectable idea.[[334]](#footnote-335)116.2

Of course, MGA had the option instead to protect itself from even colorable liability by producing dolls with large noses and potbellies. But Mattel could not force its competitors into such an unpalatable market niche. For Mattel owned no monopoly on producing attractive young, female fashion dolls with exaggerated proportions.[[335]](#footnote-336)116.3 Once any rival adopted the permissible expedient of manufacturing its own attractive young, female fashion doll with exaggerated proportions, its product would inevitably resemble Mattel’s to a significant extent. Mattel could legitimately complain only when competitors adopted virtually identical forms.[[336]](#footnote-337)116.4 Because Bratz dolls failed to meet that elevated standard of virtual identity, the district court erred in applying the normal standard of “substantial similarity.”[[337]](#footnote-338)116.5

Turning to the sketches, different considerations pertained. The Ninth Circuit determined that “there’s a wide range of expression for complete young, hip female fashion dolls with exaggerated features.”[[338]](#footnote-339)116.6 Accordingly, the trial court properly afforded those sketches broad copyright protection against substantially similar works. Nonetheless, the fact that two works are similar in the layman’s sense of the term is plainly not enough.[[339]](#footnote-340)116.7 The court below erred in applying substantial similarity by failing to filter out[[340]](#footnote-341)116.8 the sketch’s unprotected elements,[[341]](#footnote-342)116.9 effectively allowing Mattel to “claim a monopoly over fashion dolls with a bratty look or attitude, or dolls sporting trendy clothing.”[[342]](#footnote-343)116.10

The opinion concluded, “America thrives on competition; Barbie, the all-American girl, will too.”[[343]](#footnote-344)116.11 Whatever the merits of that prediction for the economic future of Mattel’s signature item, the legal standard underlying that sentiment shows when it is appropriate to require supersubtantial similarity based on thinness of copyrightable expression.[[344]](#footnote-345)116.12

1. **Impermissibility of Dispensing with Substantial Similarity.**

A 2005 circuit court decision held that substantial similarity always exists via sampling, even when only a tiny fragment is at issue.[[345]](#footnote-346)116.13 The discussion above respectfully suggests that such a holding stretches “substantial similarity” too far. In 2012, a different circuit court leaned in the opposite direction: “ ‘Substantial similarity’ is not an element of a claim of copyright infringement.”[[346]](#footnote-347)116.14 That remarkable holding, seemingly flying in the face of the thousands of opinions cited throughout this section, wants explication.

The case in question was an enforcement action against a restaurant chain that failed to take out a public performance license,[[347]](#footnote-348)116.15 a posture routinely pursued by ASCAP.[[348]](#footnote-349)116.16 The typical result in those cases is a modest award of statutory damages and attorney’s fees.[[349]](#footnote-350)116.17 In this case, true to precedent,[[350]](#footnote-351)116.18 the district court made eight awards of $4,500 each.[[351]](#footnote-352)116.19 It then broke new ground by awarding plaintiffs almost $163,000 in attorneys’ fees.[[352]](#footnote-353)116.20 The Ninth Circuit upheld the award in all respects, including the fees occasioned by defendant’s obfuscation of its corporate structure.[[353]](#footnote-354)116.21

In so ruling, it rejected defendant’s argument that ASCAP’s investigator failed to prove substantial similarity.[[354]](#footnote-355)116.22 The evidence below showed that Scott Greene visited defendant’s facilities and surreptitiously noted all musical compositions played, both by the live band and via CD over the lounge’s sound system.[[355]](#footnote-356)116.23 Based on that witness’ expertise,[[356]](#footnote-357)116.24 the panel could have held, unremarkably, that plaintiff’s evidence demonstrated that the songs played by the band and those performed over its sound system were substantially similar[[357]](#footnote-358)116.25 to the works owned by plaintiffs.[[358]](#footnote-359)116.26

Instead, however, the court enunciated the revolutionary standard quoted above, gilding it with the observation that any “showing of ‘substantial similarity’ is irrelevant in a case like this one, in which the Music Companies produced evidence that the public performances entailed direct copying of copyrighted works.”[[359]](#footnote-360)116.27 It then dismissed substantial similarity as a “red herring,” instead characterizing the proper question as “whether infringing performances occurred *vel non*.”[[360]](#footnote-361)116.28

Try as hard as it would like to dismiss the doctrine as a herring, the chowder of a successful copyright case can never dispense with the ingredient of substantial similarity. It is certainly true that, when the facts show copying of a complete work of authorship, plaintiff has no burden to establish substantial similarity; instead, *exact* copying subsumes *substantial* copying, so the broth already includes the necessary proof. The panel is likewise on solid ground in observing that the appropriate question could be summarized as “whether infringing performances occurred” in the case at bar. But the very definition of *infringing* in that context necessitates an inquiry into *substantiality*.

Let us start at one side of the spectrum. Greene testified that performances at defendant’s restaurant included a live rendition of the entirety of John Coltrane’s “My Favorite Things”[[361]](#footnote-362)116.29 and of all of Hiroshima’s “Once Before I Love” on the CD player.[[362]](#footnote-363)116.30 For the reasons just stated, plaintiffs thereupon succeeded in proving substantial similarity. Far from rendering the doctrine a red herring, the proof in that case showed it to be safely caught in the net.

At the other end of the spectrum, let us imagine that the band introduced its next selection by stating, “We now want to play for you our own ‘Favorite Things’ in tribute to John Coltrane” and then proceeded to jam—but at the second note, the trombonist choked on a fishbone and fell over, at which point the entire band rushed to his aid. By the same token, imagine that the DJ proudly intoned that “We will now hear a rare vinyl recording of ‘Once Before I Love’ from jazz-fusion great Hiroshima,” only to have the record skip and become unplayable after the second note. Under both of those scenarios, the plaintiff could produce “evidence that the public performances entailed direct copying of copyrighted works.” But the quantum would fall painfully short of establishing liability. In other words, there would be a *performance* of a work protected by copyright, but not an *infringing* performance.

Now, let us move to the middle of the spectrum. Imagine that the band was able to play two minutes of the Coltrane song before choking, and the DJ got through 55 seconds of the record before it skipped. Do those instances count as “infringing performances”? Under the logic of *fragmented literal similarity*, the plaintiffs’ case would appear complete.[[363]](#footnote-364)116.31 But if each had lasted only 21 or even 7 seconds, the question would be much closer.[[364]](#footnote-365)116.32

(Many other points may equally be selected in mid-spectrum. For instance, imagine that the band-members are replaced by fleeing convicts who cannot play music. After the leader introduces “My Favorite Things,” the assembled “musicians” produce only white noise for five minutes. Under those circumstances, no infringement of John Coltrane’s rights has transpired. Or consider, by contrast, a talented performer who places her own imprint on all numbers. The Van Morrison hit “Gloria” clocks in at 2:37; Patti Smith’s cover of that song on the *Horses* album lasts 5:53. It is not until 3:05 that her version starts its own imitation of the original;[[365]](#footnote-366)116.33 therefore, if she were to simply perform the first two minutes[[366]](#footnote-367)116.34 of her song before a fire alarm interrupted the concert, no infringement of Van Morrison’s rights would occur.[[367]](#footnote-368)116.35 Unless a Scott Greene could testify that he heard a substantial performance of “My Favorite Things” or of “Gloria,”[[368]](#footnote-369)116.36 plaintiffs’ cases would fail.)

The cleaver that cuts between infringement *vel non* is precisely the metric of *substantial similarity*. Thus, when the panel thought that it was restricting its focus on “whether *infringing* performances occurred” and thereby avoiding any inquiry into a red herring, it was mistaken. In every copyright infringement case, a successful plaintiff must swim through the shoals of substantial similarity. In cases in which the copying is 100%, the exercise may be so easy as to evade notice; there is no live dispute whether enough was copied to rise to the barrier of being “substantial.”

Indeed, the panel expresses some recognition for that proposition, albeit obliquely. Immediately after dismissing substantial similarity as “not an element of a claim of copyright infringement,” the opinion calls it rather “a doctrine that helps courts adjudicate whether copying of the ‘constituent elements of the work that are original’ actually occurred when an allegedly infringing work appropriates elements of an original without reproducing it *in toto*.”[[369]](#footnote-370)116.37 That reference to “reproducing” seems to imply that, in cases other than the instant one (involving rival book publications, for instance), courts have to invoke the doctrine of “substantial similarity”; but in the instant case of *performing* musical works,[[370]](#footnote-371)116.38 there is no occasion to float considerations of “substantial similarity” to the surface. But that implication is entirely erroneous. In copyright actions alleging infringing *performance* no less than infringing *reproduction*, the element of “substantial similarity” is essential.[[371]](#footnote-372)116.39 Reproducing the totality of a work establishes that doctrine so clearly that there is no need to focus on it; by the same token, performing the totality of a work renders the doctrine non-remarkable.[[372]](#footnote-373)116.40

As has been remarked previously, the word *copying* is a code in the law that embraces each of the enumerated rights belonging to a copyright proprietor.[[373]](#footnote-374)116.41 By the same token, the only way to understand the Ninth Circuit’s characterization of substantial similarity as “a doctrine that helps courts adjudicate whether copying of the ‘constituent elements of the work that are original’ actually occurred when an allegedly infringing work appropriates elements of an original without reproducing it *in toto*” is to understand the gerund *reproducing* as encompassing each of the enumerated rights belonging to a copyright proprietor. In the instant case, the act of *publicly performing* the works in question appropriated their elements *in toto*. For that reason, plaintiffs easily established substantial similarity. In the hypotheticals of partial performance sketched above, plaintiffs will likewise have to prove substantial similarity—but the lines may be much more difficult to draw.

In sum, it is impossible to accept the blanket proposition of this case,[[374]](#footnote-375)116.42 “ ‘Substantial similarity’ is not an element of a claim of copyright infringement.” In this case and every case, substantial similarity remains a necessary element of the plaintiff’s *prima facie* case.[[375]](#footnote-376)116.43

1. **Negating Substantial Similarity**

Having set forth above the tests for determining substantial similarity, the question remains how the defendant may challenge such a legal conclusion. Most obviously, the defendant may deny that such similarity exists.[[376]](#footnote-377)116.44 Alternatively, the defendant may concede that some matters are similar, but maintain that they concern unprotected elements,[[377]](#footnote-378)117 or are otherwise nonactionable.[[378]](#footnote-379)118

1. **The Relevance of Dissimilar Material in Defendant’s Work**

1. ***Partial Dissimilarity.***

It is sometimes said that in determining substantial similarity, consideration should be given not only to the value or importance of the similar material as it appears in the plaintiff’s work, but also to its relative value and importance as it appears in the defendant’s work.[[379]](#footnote-380)119 Insofar as this suggests that liability may turn, in some degree, on the importance of the original material that defendant adds to the copied material, this is an erroneous statement of the law.[[380]](#footnote-381)120 It is entirely immaterial that, in many respects, plaintiff’s and defendant’s works are dissimilar, if in other respects, similarity as to a substantial element of plaintiff’s work can be shown.[[381]](#footnote-382)121 “No plagiarist can excuse the wrong by showing how much of his work he did not pirate.”[[382]](#footnote-383)122 If substantial similarity is found, the defendant will not be immunized from liability by reason of the addition in his work of different characters or additional and varied incidents,[[383]](#footnote-384)123 nor generally by reason of his work proving more attractive or saleable than the plaintiff’s.[[384]](#footnote-385)124

The admission of evidence of differences as between plaintiff’s and defendant’s works is not, however, improper.[[385]](#footnote-386)125 If the points of dissimilarity not only exceed the points of similarity, but indicate that the remaining points of similarity are, within the context of plaintiff’s work,[[386]](#footnote-387)125.1 of minimal importance, either quantitatively or qualitatively, then no infringement results.[[387]](#footnote-388)126

1. ***Intentional Dissimilarity.***

What if the evidence shows that defendant’s work is dissimilar from plaintiff’s, and that such dissimilarity results from design? Such “deliberate non-copying” can be a double-edged sword. On the one hand, items or elements of dissimilarity are sometimes evidence of copying as a factual matter.[[388]](#footnote-389)126.1 Thus, where the language used in two works is the same, but for the inversion of certain words, or the substitution of one word for another, it has been held that “this crude effort to give the appearance of dissimilarity is itself evidence of copying.”[[389]](#footnote-390)127 Although slight changes generally cannot avoid infringement liability, to the extent that plaintiff’s own creativity was slight a different result may emerge.[[390]](#footnote-391)127.1

On the other hand, in what may be regarded as the more common situation,[[391]](#footnote-392)127.2 a defendant may legitimately avoid infringement by intentionally making sufficient changes in a work that would otherwise be regarded as substantially similar to plaintiff’s.[[392]](#footnote-393)128 In a case involving rival teddy bear pacifiers, plaintiff sent its subcontractor a note, “I need a new animal design. The buyer likes this bear but I do not want to produce the same exact thing. Can you please work on a similar design?”[[393]](#footnote-394)128.1 The resulting product was sufficiently different to warrant affirmance of summary judgment on behalf of defendant.[[394]](#footnote-395)128.2 To cite another example, even after one court found that defendant “intentionally copied” plaintiff’s copyrighted designs resulting in “remarkably similar” architectural plans,[[395]](#footnote-396)128.3 it concluded in a bench trial that the number of differences outweighed the common points (particularly given the limited ways that one can juxtapose rooms in a house)[[396]](#footnote-397)128.4 to the extent that substantial similarity was lacking.[[397]](#footnote-398)128.5

Given the proposition that deliberate changes avoid infringement, courts “have routinely[[398]](#footnote-399)128.6 rejected requests to consider earlier drafts of the screenplay.”[[399]](#footnote-400)128.7 A case illustrating that proposition arose when plaintiff claimed that Pixar and Disney had recast her one-page poem to make their movie, *Monsters, Inc*., notwithstanding “that no similarities are readily apparent” between the expression of the two.[[400]](#footnote-401)128.8

As an additional thought experiment,[[401]](#footnote-402)128.9 imagine a defendant who buys plaintiff’s poetry anthology to use as an inspiration, ultimately producing her own work by focusing on a poem written by plaintiff, crossing out every word except “The End,” and producing a poem original in every other regard.[[402]](#footnote-403)129 It can hardly be doubted that defendant in this scenario[[403]](#footnote-404)130 has not infringed,[[404]](#footnote-405)131 notwithstanding proof of (1) copying[[405]](#footnote-406)131.1 of the foregoing trifle[[406]](#footnote-407)132 and (2) access, which are nominally the two elements of infringement.[[407]](#footnote-408)132.1 Of course, the key distinction between the fictitious poet and an infringer lies in the fact that, notwithstanding her copying from the plaintiff’s work, she has not copied “constituent elements of the work that are original;”[[408]](#footnote-409)132.2 in other words, her copying as a factual matter does not render her culpable of actionable copying, given the absence of substantial similarity.[[409]](#footnote-410)132.3 Alternatively, from a more high-tech perspective, imagine a computer user who purchases an on-line dictionary or thesaurus, and occasionally inserts words into his own essay not by retyping them but rather by copying via appropriate keyboard commands.[[410]](#footnote-411)133 Again, although access and copying as a factual matter are incontrovertible, liability must be denied because the dictionary/thesaurus compiler owns a copyright only in the selection and arrangement of words contained in its program,[[411]](#footnote-412)133.1 which our computer user has not copied.

Nonetheless, a 1990 Seventh Circuit opinion held liability in a scenario not far removed from the above hypothetical.[[412]](#footnote-413)133.2 In that case, plaintiff owned a compilation copyright in a telephone directory; defendant produced its own directory in a wholly different ordering, *i.e.,* by street rather than by name.[[413]](#footnote-414)133.3 The court rejected defendant’s argument that “it merely copied facts which contain no elements of expression and are uncopyrightable,”[[414]](#footnote-415)133.4 holding that defendant “infringed on Illinois Bell’s copyright when it copied Illinois Bell’s information.”[[415]](#footnote-416)133.5 The error in the court’s reasoning lies precisely in the fact that information is uncopyrightable, and hence, copying information should be nonactionable.[[416]](#footnote-417)133.6 Even more egregious is the court’s dispensing with the whole requirement of substantial similarity: “Establishing substantial similarity is necessary only when direct evidence of copying is unavailable.”[[417]](#footnote-418)133.7 Such a ruling deviates even from applicable Seventh Circuit doctrine.[[418]](#footnote-419)133.8 Under its logic, the hypothetical computer user who copies even one word out of the on-line dictionary is an infringer,[[419]](#footnote-420)133.9 absent an applicable defense.[[420]](#footnote-421)133.10

The damage from that ruling proved short-lived. In 1991, the Supreme Court decided for the defendant in another telephone directory dispute.[[421]](#footnote-422)133.11 In the process, the Court made clear that copying information does not, by itself, give rise to liability.[[422]](#footnote-423)133.12 On the strength of its telephone directory opinion, the Supreme Court vacated the foregoing Seventh Circuit decision.[[423]](#footnote-424)133.13

1. **Similarity of Unprotected Matters.**

Even when extended similarity exists between plaintiff’s and defendant’s works when taken as a whole,[[424]](#footnote-425)134 the analysis is not finished. To the extent that this similarity inheres in ideas, which are by definition unprotected,[[425]](#footnote-426)135 or in expression that is not proprietary to plaintiff,[[426]](#footnote-427)136 then an essential ingredient is lacking from plaintiff’s *prima facie* case.[[427]](#footnote-428)136a As set forth above,[[428]](#footnote-429)136.1 an element of an infringement case is that “plaintiff must show that defendants’ works are substantially similar to elements of plaintiff’s work that are *copyrightable* or *protected* by the copyright.”[[429]](#footnote-430)136.2 When similar works resemble each other only in those unprotected aspects, then defendant prevails.[[430]](#footnote-431)136.3 By contrast, when the similarity goes to protected elements,[[431]](#footnote-432)136.4 plaintiff prevails.[[432]](#footnote-433)136.5

1. ***Ideas.***

A previous section has delineated the statutory disqualification of ideas from copyright protection.[[433]](#footnote-434)137 Even before its codification, the courts long recognized this principle of nonprotectibility.[[434]](#footnote-435)138 In short, when only plaintiff’s idea has been appropriated, protection must be found, if at all, on a theory[[435]](#footnote-436)139 other than copyright infringement.[[436]](#footnote-437)140 This conclusion follows not only as a matter of statutory law but also of constitutional necessity—in *Golan v. Holder*,[[437]](#footnote-438)141 the Supreme Court recognized that the idea/expression dichotomy constitutes a First Amendment safeguard. Since that 2012 ruling, Congress would therefore seem obligated to continue to maintain this dichotomy as part and parcel of the “traditional contours” of copyright law.[[438]](#footnote-439)142

Merely stating the rule, however, does not make any easier the task of drawing the line between where idea ends and expression begins.[[439]](#footnote-440)143 Indeed, this problem of defining the boundaries of “idea” can be as vexing as any other aspect of substantial similarity.[[440]](#footnote-441)144 One case illustrating this principle includes both photographs of the works in question[[441]](#footnote-442)144.1 and a description in words why “the (very different) Pegasus-like figures … juxtaposed with the roofs of the (very different) vehicles in each work” failed to infringe, given that “the similarities in presentation end there.”[[442]](#footnote-443)144.2 A circuit court opinion likewise appends the photos to conclude that substantial similarity is lacking as a matter of law between two depictions of Michael Jordan in a ballet pose, leaping toward a hoop with the ball in his left hand over his head, taken outdoors from a similar angle by which the viewer looks up to him silhouetted against the sky.[[443]](#footnote-444)144.2a

Consider a case[[444]](#footnote-445)144.3 involving a plush doll named Pull My Finger Fred—the court initially defined the idea underlying the subject 3-D sculpture/sound recording as simply a “farting doll.”[[445]](#footnote-446)145 Defendant objected that a more appropriate formulation of the non-protectible idea at issue would be “a plush doll of a typical man wearing jeans and a T-shirt in a chair doing the ‘pull my finger’ joke.”[[446]](#footnote-447)146 The court rejected that proposal as simply a self-serving method of avoiding liability in this particular case,[[447]](#footnote-448)147 but refined its prior definition into “a plush doll that makes a farting sound and articulates jokes when its finger is activated.”[[448]](#footnote-449)148 It was therefore able to enter summary judgment against defendant for substantially copying Fred, plaintiff’s expression of that idea. The Seventh Circuit affirmed that later result.[[449]](#footnote-450)149

Sometimes courts deny summary judgment to allow the matter to proceed to trial.[[450]](#footnote-451)150 At other times, portions of plaintiff’s work are held uncopyrightable as ideas,[[451]](#footnote-452)151 but other portions contain protected expression,[[452]](#footnote-453)151.1 as to which a jury trial is indicated.[[453]](#footnote-454)151.2

The policy rationale underlying the Act’s exclusion of ideas from copyright protection is clear:[[454]](#footnote-455)151.3 To grant property status to a mere idea would permit withdrawing the idea from the stock of materials open to other authors, thereby narrowing the field of thought open for development and exploitation.[[455]](#footnote-456)151.3a This effect, it is reasoned, would hinder, rather than promote, the professed purpose of the copyright laws, *i.e.*, “the progress of science and useful arts.”[[456]](#footnote-457)151.4 Thus, the fact that defendant has copied from plaintiff “powerful, dynamic ideas of immense value” does not confer any ownership over them.[[457]](#footnote-458)151.5 The Ninth Circuit warns that “we must be careful in copyright cases not to cheat the public domain. Only by vigorously policing the line between idea and expression can we ensure both that artists receive due reward for their original creations and that proper latitude is granted other artists to make use of ideas that properly belong to us all.”[[458]](#footnote-459)151.6

Indeed, a court posited long ago that copyright protection is granted for the very reason that it may persuade authors to make their ideas freely accessible to the public so that they may be used for the intellectual advancement of mankind.[[459]](#footnote-460)151.7 Even earlier, Lord Mansfield cogently expressed the problem of reconciling two socially useful, but antithetical, interests: “We must take care to guard against two extremes equally prejudicial; the one that men of ability, who have employed their time for the service of the community may not be deprived of their just merits and reward for their ingenuity and labor; the other that the world may not be deprived of improvements nor the progress of the arts be retarded.”[[460]](#footnote-461)152

1. ***Unprotected Expression.***

Frequently, particularly in functional and nonfiction works, a plaintiff’s work consists of some original material and some uncopyrightable material. For example, a defendant’s work could be based partially on early works that have entered the public domain, and partially on later derivative works still protected by copyright.[[461]](#footnote-462)152.1 Liability cannot rest on use of the public domain elements alone. As the Second Circuit recognizes, “all creative works draw on the common wellspring that is the public domain,” and this pool contains “not only elemental ‘raw materials,’ like colors, letters, descriptive facts, and the catalogue of standard geometric forms, but also earlier works of art that, due to the passage of time or for other reasons, are no longer copyright protected.”[[462]](#footnote-463)152.2 Nonetheless, if the plaintiff has modified the public domain work and the defendant copies plaintiff’s modifications, liability may ensue.[[463]](#footnote-464)152.3 (Although Judge Posner correctly noted just two months earlier that substantial similarity typically cannot inhere in nonexistent content,[[464]](#footnote-465)152.4 Judge Calabresi’s opinion also correctly pointed out that plaintiff’s judicious deletions from a public domain work, if copied by defendant, might give rise to liability.)[[465]](#footnote-466)152.5

Liability likewise cannot arise to the extent that the similarity between plaintiff’s and defendant’s work is that both graphically reproduce an object exactly as it occurs[[466]](#footnote-467)152.6 in nature.[[467]](#footnote-468)152.7 In such instances, any protection would be “thin.”[[468]](#footnote-469)152.8 limiting liability to almost exact copying.[[469]](#footnote-470)152.9 Even if a work does not occur in nature—a dragon, for instance—there is no liability if the only similarity between the two works is that they each portray the same item, but in a different form.[[470]](#footnote-471)153 Of course, liability may result when the copyrighted work was changed from its natural appearance for aesthetic reasons.[[471]](#footnote-472)153.1

The Ninth Circuit limits the amount of protection accorded jellyfish sculptures in glass, holding that plaintiff

may not prevent others from depicting jellyfish with tendril-like tentacles or rounded bells, because many jellyfish possess those body parts. He may not prevent others from depicting jellyfish in bright colors, because many jellyfish are brightly colored. He may not prevent others from depicting jellyfish swimming vertically, because jellyfish swim vertically in nature and often are depicted swimming vertically.[[472]](#footnote-473)153.2

To illustrate the legal consequences of such factual circumstances, consider a factual work. Because no copyright may exist in facts *per se*,[[473]](#footnote-474)154 the copyright in a book dealing with factual matters cannot be infringed by a work that copies such facts, but in a manner in which the particular verbal description of such facts is not copied.[[474]](#footnote-475)154.1 *Harper & Row, Publishers, Inc. v. Nation Enterprises*[[475]](#footnote-476)155 illustrates the point.[[476]](#footnote-477)156 In that case, the defendant obtained a copy of the manuscript of former President Ford’s then-unpublished memoirs, the copyright in which had been conveyed to the plaintiffs. Insofar as the defendant published only the facts contained in the manuscript, but not President Ford’s “expression” of those facts, the Court held that no copyright infringement occurred.[[477]](#footnote-478)157 However, because the factual reportage there at issue occurred only in the midst of verbatim copying of expression that the Court determined to be beyond the scope of fair use,[[478]](#footnote-479)158 liability ensued.[[479]](#footnote-480)159

One may copy raw facts out of another’s works with impunity (so long as the selection and arrangement of those facts is not purloined), such as historical circumstances surrounding the explosion of the dirigible “Hindenburg.”[[480]](#footnote-481)159.1 One may also report factual circumstances relating to another’s copyrighted work, so long as those facts do not poach on the earlier author’s protectible expression.[[481]](#footnote-482)159.2 However, liability plainly cannot be avoided when copying another’s original expression by pleading that the defendant is simply recounting *facts* about a prior work of authorship.[[482]](#footnote-483)159.3

A plaintiff can claim no protection in the abstract expression of his work, if the work, on such abstract level, is not the product of his original authorship. Thus, if the only original aspect of a work lies in its literal expression, then only a very close similarity, verging on the identical, will suffice to constitute an infringing copy.[[483]](#footnote-484)160

Consider *Feist Publications, Inc. v. Rural Telephone Service Co.*,[[484]](#footnote-485)160.1 in which plaintiff Rural complained that defendant Feist had infringed the copyright in an alphabetical phone book by purloining information for a rival directory.[[485]](#footnote-486)160.2 Although Feist hired personnel to verify listings out of Rural’s phone book, it did not deny that its final product reproduced 1,309 of the 46,878 listings in Rural’s directory.[[486]](#footnote-487)160.3 Even more tellingly, “[f]our of these were fictitious listings that Rural had inserted into its directory to detect copying.”[[487]](#footnote-488)160.4 Rural argued that its industrious collection[[488]](#footnote-489)160.5 was entitled to protection, and “that Feist’s employees were obliged to travel door-to-door or conduct a telephone survey to discover the same information for themselves.”[[489]](#footnote-490)160.6 Feist replied that, beyond the impracticality of Rural’s suggestion, such efforts were “unnecessary because the information copied was beyond the scope of copyright protection.”[[490]](#footnote-491)160.7 The Court agreed with Feist. “The mere fact that a work is copyrighted does not mean that every element of the work may be protected. Originality remains the *sine qua non* of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author.”[[491]](#footnote-492)160.8 Given that facts are inherently unprotectible, the Court concluded that “[o]thers may copy the underlying facts from the publication, but not the precise words used to present them.”[[492]](#footnote-493)160.9 But, even that small degree of protection[[493]](#footnote-494)160.10 will be denied when the precise words themselves reflect an utter absence of originality, as did Rural’s banal listing of names, towns, and numbers in alphabetical order. Thus, *Feist* stands for the proposition that even admitted literal copying is not actionable when limited to unoriginal expression.[[494]](#footnote-495)160.10a

1. ***Licensed Expression.***

When the plaintiff and defendant have previously entered into a licensing agreement or assignment,[[495]](#footnote-496)160.11 and plaintiff subsequently alleges that defendant’s activity constitutes infringement, a defense exists to the extent that the defendant’s conduct falls within the licensed terms.[[496]](#footnote-497)160.12 Accordingly, even if similarity be conceded, there can be no liability to the extent that such elements are immunized by an appropriate license agreement;[[497]](#footnote-498)160.13 as stated by the Ninth Circuit, “Infringement cannot be founded on a licensed similarity.”[[498]](#footnote-499)160.14 To the extent that the defendant exceeds the contractual terms, however, and incorporates unlicensed elements, liability may be premised on those elements,[[499]](#footnote-500)160.14a should they (considered in isolation from the licensed elements and other unprotected matters) rise to the level of substantial similarity.[[500]](#footnote-501)160.15

Conversely, there is no liability for copyright infringement, even if defendant exceeds the contractual terms, if the unlicensed expression does not itself amount to substantial similarity or, more generally, if the subject conduct falls outside the copyright owner’s rights.

As an example, consider a license in which the copyright owner grants a person the right to make one and only one copy of a book with the caveat that the licensee may not read the last ten pages. Obviously, a licensee who made a hundred copies of the book would be liable for copyright infringement because the copying would violate the Copyright Act’s prohibition on reproduction and would exceed the scope of the license. Alternatively, if the licensee made a single copy of the book, but read the last ten pages, the only cause of action would be for breach of contract, because reading a work does not violate any right protected by copyright law.[[501]](#footnote-502)160.15a

Loose language in previous cases implied that a “licensee infringes the owner’s copyright if its use exceeds the scope of its license” in any way.[[502]](#footnote-503)160.15b But the more accurate formulation is that “uses that violate a license agreement constitute copyright infringement only when those uses would infringe in the absence of any license agreement at all.”[[503]](#footnote-504)160.15c

Of course, any inquiry into copyright licenses implicates the full panoply of issues involved in transfers of copyrightable material.[[504]](#footnote-505)160.16 At times, infringement may therefore hinge on weaving through an elaborate web of successive grants.[[505]](#footnote-506)160.17

The flip side of this doctrine means that unlicensed expression is actionable, even if the defendant is himself the author of the plaintiff’s work. In other words, if a songwriter[[506]](#footnote-507)160.18 or photographer[[507]](#footnote-508)160.19 assigns his work to plaintiff, and thereafter creates a new product substantially similar to his previous work, he can be deemed an infringer to the extent that the similarity between the two inheres not simply in style, but crosses over the line to become substantial similarity.[[508]](#footnote-509)160.20

1. ***Synesthesia.***

In 1874, Modest Mussorgsky produced his famous suite in ten movements, *Pictures at an Exhibition*, inspired by the artwork of Viktor Hartman. It should be immediately apparent that, no matter how lilting the musical elements of the composition, they are not substantially similar to the figures that Hartman depicted in “Ballet of the Unhatched Chicks” or “Two Jews: Rich and Poor.” There is, in short, no overlap in expression from the artistic to the musical domain.

The same considerations apply in reverse. When *Fantasia* animates the sequences from Ravel’s *Bolero*, use of the music on the soundtrack itself requires a synchronization license; but, absent use of the music, no claim could lie that the visual elements replicate the musical figures. There can be no correspondence in protected expression between music and other modalities of communication.

These considerations lie afield from judicial opinions. However, one case that comes close to alleging such a theory involved plaintiff’s “love anthem” to the Boston Red Sox, which he claimed to be infringed by TBS’s promo featuring a Bon Jovi song and footage from major league ballparks.[[509]](#footnote-510)160.20a Given no musical or lyrical similarity between plaintiff’s and Bon Jovi’s songs,[[510]](#footnote-511)160.20b plaintiff was relegated to aligning his song with the promo, alleging “temp tracking” such that the visual events depicted on film corresponded to the second to the descriptions of his lyrics.[[511]](#footnote-512)160.20c The court rejected the bulk of the alleged similarities as scene a faire.[[512]](#footnote-513)160.20d Still, it remains conceivable, if barely, that a given poem (or song lyrics) could describe in words a sequence of images, which could be infringed through slavish creation of those images visually, in the exact order described. But this case does not embody that fact pattern.

1. **Merger**

1. ***Introduction*.**

We have seen above the venerable principle that copyright protects expression, but that ideas are statutorily free to all.[[513]](#footnote-514)161 In exceptional circumstances, however, the idea “merges” with the expression, such that a given idea is inseparably tied to a particular expression.[[514]](#footnote-515)162 In those instances, rigorously protecting the expression would confer a monopoly over the idea itself, in contravention of the statutory command.[[515]](#footnote-516)162.1

To prevent that consequence, courts have invoked the doctrine of *merger*. Given the dilemma either of protecting original expression, even when that protection can be leveraged to grant an effective monopoly over the idea thus expressed, or of making the idea free to all, with the concomitant result that plaintiff loses effective copyright protection even over the precise original expression used, copyright law chooses the latter course.[[516]](#footnote-517)162.2 Therefore, when expression *merges* with idea, the former may be freely copied.

1. ***Early History*.**

We revert at this juncture to the lead case of *Baker v. Selden*,[[517]](#footnote-518)162.3 which ruled that copyright law could not be used to obtain a monopoly on a system or method for performing commercial or scientific functions.[[518]](#footnote-519)162.4 It is a given that copyright may not be claimed in a system or method *per se*.[[519]](#footnote-520)162.5 From that premise, some courts have reasoned that, if the only manner of performing the system or method is by copying a written expression, then copyright protection must be denied to the writing itself, as otherwise the system or method itself would be monopolized.[[520]](#footnote-521)162.6

The flaw in that reasoning inheres in its assumption that a given system or method can be performed by the use of only one particular form of written expression.[[521]](#footnote-522)162.7 In *Baker v. Selden* itself, the Supreme Court determined that defendant’s forms substantially differed from plaintiff’s.[[522]](#footnote-523)162.8 Other cases, notwithstanding their professed concern over monopolization of a noncopyrightable system or method, have likewise concluded[[523]](#footnote-524)162.9 that the writings at issue were themselves not substantially similar.[[524]](#footnote-525)163 The facts underlying these cases, regardless of their stated rationale, thus illustrate that, as a general matter, a particular scientific or commercial system or method no more requires any particular form of expression than does a particular subject matter for a painting permit but one image[[525]](#footnote-526)163.1 or a particular subject matter for a dramatization permit but one sequence of events and interplay of characters.[[526]](#footnote-527)163.2

Nonetheless, the First Circuit in 1967 relied on *Baker v. Selden* to find nonactionable word-for-word copying of contest instructions. Although *Morrissey v. Procter & Gamble Co.*[[527]](#footnote-528)163.3 acknowledged that more than one form of expression was possible for the contest in question,[[528]](#footnote-529)163.4 it nonetheless concluded that, because the subject matter is “very narrow … at best only a limited number” of forms of expression would be possible.”[[529]](#footnote-530)163.5 This ruling holds that, in these circumstances, “copyright does not extend to the subject matter at all, and plaintiff cannot complain even if his particular expression was deliberately adopted.”[[530]](#footnote-531)163.6 Some pre-1976 Act cases largely followed *Morrissey*’s lead,[[531]](#footnote-532)163.7 albeit not without dissenting voices.[[532]](#footnote-533)163.8 It has also been followed at times under the current Act.[[533]](#footnote-534)163.9

When are the above-mentioned exceptional circumstances present, such that a particular use does indeed collapse into one possible manner of expression?[[534]](#footnote-535)164 The most famous instance is a jewelry pin taking the form of a jewel-encrusted bee. The Ninth Circuit in *Herbert Rosenthal Jewelry Corporation v. Kalpakian*[[535]](#footnote-536)165 denied protection to the pin.[[536]](#footnote-537)166 The most telling aspect of its opinion concerns the concession by plaintiff’s own counsel who,

repeatedly pressed by the district judge, was unable to suggest how jewels might be placed on the back of a pin in the shape of a bee without infringing plaintiff’s copyright. He eventually conceded, “not being a jeweler, I can’t conceive of how he might rearrange the design so it is dissimilar.”[[537]](#footnote-538)167

The court of appeals thereupon noted that, if “plaintiff’s understanding of its rights were correct, its copyright would effectively prevent others from engaging in the business of manufacturing and selling jeweled bees.”[[538]](#footnote-539)167.1 Like *Morrissey* before it, this case similarly concluded that “protecting the ‘expression’ in such circumstances would confer a monopoly of the ‘idea’ upon the copyright owner free of the conditions and limitations imposed by the patent law” in a manner that *Baker v. Selden* forbids.[[539]](#footnote-540)167.2 Beyond its own distinct facts arising out of counsel’s concession, it is unclear how far that ruling extended.[[540]](#footnote-541)167.3

1. ***Current Application*.**

Cases under the current Act similarly apply the merger doctrine, albeit with some differences (explored below) from how *Morrissey* and *Kalpakian* originated it.[[541]](#footnote-542)167.4 Basically stated, merger under the current Act means that similarity of expression, whether literal or nonliteral, which necessarily results from the fact that the common idea is only capable of expression in more or less stereotyped form, precludes a finding of actionable similarity.[[542]](#footnote-543)167.5 That formulation continues governing strictures under former law.[[543]](#footnote-544)167.6 A converse way to state the principles is as follows: When a work is capable of being expressed in numerous ways, then merger is inapplicable.[[544]](#footnote-545)168 It should not be inferred “that, because original copyrighted features are, or may be described as, standard or commonplace, they maybe [sic] freely copied.”[[545]](#footnote-546)168.1 Rather, permissible copying is limited to “that similarity which necessarily results from the replication of an idea.”[[546]](#footnote-547)168.2

To revert to the differences between the merger doctrine as applied under the current Act and its previous recognition in such cases as *Morrissey* and *Kalpakian*, one distinction is that those cases grounded their ruling directly in *Baker v. Selden.*[[547]](#footnote-548)168.3 By contrast, merger has become a stand-alone feature of modern copyright law, on a par with its coordinate doctrine of scenes a faire.[[548]](#footnote-549)168.4 It is thus no longer necessary to go back to first principles to articulate a rationale for excluding merged expression from protection.[[549]](#footnote-550)168.5

Another difference is that *Morrissey*[[550]](#footnote-551)168.6 allowed copying despite its recognition that “there was more than one way of expressing even this simple substance.”[[551]](#footnote-552)168.7 That aspect renders the case’s holding questionable[[552]](#footnote-553)168.8—normally, the existence of multiple avenues of expression dooms the merger defense.[[553]](#footnote-554)168.9 As the Eleventh Circuit explains,

The merger doctrine operates as an exception to the normal idea-expression dichotomy. The doctrine holds that, when there are so few ways of expressing an idea, not even the expression is protected by copyright. To illustrate this point, imagine the symbol often used on public signs displaying a circle with a diagonal line crossed through it. When, for example, an image of a cigarette is centered in the middle of the circle with the line through it, this visual sign expresses the idea that smoking is not allowed. This same symbol is used in a wide variety of contexts to express that something is prohibited, e.g., no swimming, no food or drink, no cell phone. Since there are effectively only a few ways of visually presenting the idea that an activity is not permitted, copyright law would not protect the expression in this case, i.e., the circle with the line through it.[[554]](#footnote-555)168.10

Under the facts of that case, because the evidence showed that there was no uniformity of how to organize information about yachts prior to the advent of plaintiff’s organizational headings, the merger defense did not preclude protection for plaintiff’s compilation.[[555]](#footnote-556)168.11 The same result inured regarding multiple ways to express the superiority of ammunition.[[556]](#footnote-557)168.12

As the above quote highlights, it is only “when there are so few ways of expressing an idea [that] not even the expression is protected[[557]](#footnote-558)168.13 by copyright.”[[558]](#footnote-559)168.14 In another case, plaintiff claimed protection over her diagram depicting “vision + capabilities + incentives + resources + action plan” in six different configurations, depending on which components were present or absent.[[559]](#footnote-560)168.15 Defendant’s replication of almost every entry of the chart[[560]](#footnote-561)168.16 failed to win immunity under the merger doctrine. The court noted many alternative devices that defendant could have adopted, which would have avoided infringement.[[561]](#footnote-562)168.17 Another case held that there were many ways to express the caution label on a caffeinated beverage.[[562]](#footnote-563)168.17a

A third difference is that *Morrissey* and *Kalpakian* allowed an entire work to be copied (respectively, the whole contest instructions and the whole jewelry pin). By contrast, the typical stance in modern cases is to allow a portion of the subject work to be copied; of course, if defendant’s copying is limited to that particular portion, then plaintiff’s entire case collapses. Nonetheless, outside of narrow circumstances (such as the pipeline case discussed below), plaintiff may still retain some residual protection in the entirety of its work.

For instance, consider plaintiff’s suit complaining of infringement of his *Pi Symphony* by defendant’s musical composition *What Pi Sounds Like*; both works assigned a note to each numeral, then played them in the order of the digits of pi.[[563]](#footnote-564)168.18 Although plaintiff enjoyed a valid copyright in his cadences, flourishes, harmonies, and structure, those aspects of the two works were dissimilar,[[564]](#footnote-565)168.19 leaving residual similarity only in ideas, which are unprotectable.[[565]](#footnote-566)168.20 The court therefore properly dismissed the case.

In another case, the court concluded that plaintiff’s manual was copyrightable but denied infringement based on the identical headings on a Washing Instructions Chart[[566]](#footnote-567)168.21 By the same token, one court concluded that plaintiff enjoyed copyright protection in the banners it designed, but not in the general activity of hanging oversize banners printed with super-wide inkjet technology off a distinctively shaped exhibition center.[[567]](#footnote-568)168.22 A similar result inured with respect to showing cinnamon or apples on a copyrighted label for a housewarming candle.[[568]](#footnote-569)168.23 Computer software is another domain in which the merger doctrine has been invoked to allow copying of discrete segments of code.[[569]](#footnote-570)168.24

Unlike the ruling of *Kalpakian* that only one method existed to produce a jewel-encrusted bee,[[570]](#footnote-571)168.25 it more commonly develops[[571]](#footnote-572)168.26 that a variety of expressions are available to jewelry designers.[[572]](#footnote-573)168.27 Nonetheless, a district court in 2013 relied on *Kalpakian* to hold that a Mardi Gras “bead dog” made by twisting broken strands of plastic could be executed in only one fashion.[[573]](#footnote-574)168.28 It therefore reached the same result of that earlier case, allowing the work to be copied *in toto*.[[574]](#footnote-575)168.29 The Fifth Circuit affirmed on other grounds, specifically recognizing copyright protection in plaintiff’s product as a whole,[[575]](#footnote-576)168.30 but determining that defendant’s copied elements were not substantially similar to that work.[[576]](#footnote-577)168.31

Despite that 2015 ruling, an earlier Fifth Circuit opinion followed *Kalpakian* to validate copying the totality of plaintiff’s work. Plaintiff ***Kern*** River Gas Transmission Company compiled an original map showing where it proposed to locate a natural gas pipeline.[[577]](#footnote-578)168.32 After defendant Coastal Corporation copied that entire copyrighted map,[[578]](#footnote-579)169 it ultimately prevailed in the competition for government approval of pipeline construction based on its plans; plaintiff’s resulting copyright claim was “no more than a harassing skirmish … in the larger fight for domination of this [lucrative] market.”[[579]](#footnote-580)169.1 Given that plaintiff merely took United States Geographical Survey topographical maps and added to those its own lines and mile markings,[[580]](#footnote-581)169.2 and given further that the only effective manner of presenting the idea of where to locate the pipeline was through that expression, ***Kern*** *River* properly invoked the merger doctrine to conclude that “the idea of the location of the pipeline and its expression embodied in the 1:250,000 maps are inseparable and not subject to protection.”[[581]](#footnote-582)169.3 Precisely to avoid such absurd results as conferring on the first planner of a pipeline a monopoly denominated “copyright” over its proposed location in a given corridor, the merger doctrine is an indispensable fixture of copyright doctrine.

It will be recalled that *Kalpakian* reached its ruling in part based on counsel’s concession that there was no other way of encrusting jewels to yield a bee.[[582]](#footnote-583)169.4 To similar effect in ***Kern*** *River*, plaintiff’s “principal planning engineer testified that he could think of no other way to portray the idea of the pipeline’s proposed location.”[[583]](#footnote-584)169.5 Under those circumstances, “To extend copyright protection to the quad maps would grant [plaintiff] a monopoly over the only approved pipeline route.”[[584]](#footnote-585)169.6 By contrast, a later Fifth Circuit case distinguished ***Kern*** *River* to deny application of the merger doctrine when the ideas contained in the subject maps could have been expressed in a variety of ways.[[585]](#footnote-586)169.7 The Federal Circuit likewise denied a merger defense in the computer software context, given the evidence that plaintiff had “unlimited options as to the selection and arrangement of the 7000 lines” of code that defendant copied.[[586]](#footnote-587)169.8

As absurd as was plaintiff’s claim in ***Kern*** *River* to own a copyright in the pipeline route would be granting someone a copyright in the idea of taking a given residential subdivision and incorporating into it 68 lots for individual homes (as opposed to 67 or 72). Yet one case reached essentially that result when it withheld the merger doctrine on the basis that another entity could have chosen to incorporate “more or less lots” into an alternative design.[[587]](#footnote-588)169.9 Just as the copyright owner in ***Kern*** *River* would have had defendants pursue a different pipeline route, the copyright owner in this case would have had defendants design a different number of individual homes into the subdivision, as the price of avoiding infringement. Copyright laws are designed to vindicate particular expressive choices, not to dictate construction results, as ***Kern*** *River* exemplifies (and this case ignores).[[588]](#footnote-589)169.10

Another case distinguished ***Kern*** *River*, holding that a restrictive covenant on developing certain property expresses “just one of many possible detailed and complex visions for developing the site.”[[589]](#footnote-590)169.11 Does that ruling replicate the same error of protecting creativity in land use, not of copyrightable expression? The issue is clouded, as the opinion’s merger discussion is highly truncated.

Here, the restrictive covenant made one method of developing the site legally easier and cheaper than others, but it did not transform the covenant drawings into the only physically possible means to express ideas for such development. WCP’s pursuit of several alternative designs demonstrates the availability of alternatives here—as does an expert report proffered by WCP on damages issues, wherein WCP’s expert says an appropriate layout for the site “can be achieved in many different ways.”[[590]](#footnote-591)169.12

To the extent that the intent is to convey that alternative blueprints and plans could have been drafted to show the exact same projected development, then the ruling is correct. But if, as seems more likely from that excerpt,[[591]](#footnote-592)169.13 the court was holding that defendant could have chosen a different methodology to develop the property in question, then it erred in withholding the merger doctrine here.[[592]](#footnote-593)169.14

One case invoked neither merger nor ***Kern*** *River*—but under circumstances which would seem to make those matters pertinent. Plaintiff claimed protection over *seismic lines*—lines that reflect information about the rock layers beneath the earth’s crust, based on sound waves reflected from off-shore technological equipment, which is “useful to the ***oil*** and gas industry in locating hydrocarbons.”[[593]](#footnote-594)169.15 The opinion notes in passing that those lines reflect a “professional interpretation of the information gathered” that results in “a copyright-protected geological ‘picture’ of the subterranean structure in the area surveyed”[[594]](#footnote-595)169.16 before considering the parties’ arguments over extraterritoriality and the Act of State doctrine.[[595]](#footnote-596)169.17 Unaddressed is whether that characterization of copyright protection was accurate.[[596]](#footnote-597)169.18 To the extent that defendant exploited plaintiff’s contributions reflecting its artistic or aesthetic choices of how to map underwater ***oil***, the statement may be accurate. But if, as seems far more likely, plaintiff’s only concern in that case was over the unprotected aspects of where on earth hydrocarbons were physically located, then its complaint should have capsized based on ***Kern*** *River*, without the need to reach those other esoteric doctrines relating to extraterritoriality.[[597]](#footnote-598)169.19

1. ***Collateral Aspects*.**

As we have seen previously, when there exists similarity of expression (whether literal or nonliteral) that necessarily results from the fact that the common idea is only capable of expression in more or less stereotyped form, the merger doctrine precludes a finding of actionable similarity.[[598]](#footnote-599)169.20 Because that formulation includes “literal copying,” it is no longer accurate to state categorically that a “copyright holder whose ideas and expression thereof have merged is still protected from slavish, identical copying.”[[599]](#footnote-600)169.21 Particularly in the case of functional works,[[600]](#footnote-601)169.22 it may be necessary to embody near, or even word-for-word, identity.[[601]](#footnote-602)169.23 The less protection there is in a work, the stronger the similarities must be to render defendant’s copying actionable.[[602]](#footnote-603)169.24

One court held the merger doctrine inapplicable “in instances where the infringing work is virtually identical to the copyrighted work or when the coordination of facts provided in the work are a result of independent testing.”[[603]](#footnote-604)169.25 There is no warrant for either of those exclusions. Copying that is virtually or actually identical may fall within the merger doctrine, as illustrated by the ***Kern*** *River* case explicated above.[[604]](#footnote-605)169.26 Furthermore, a compilation based on “independent testing” would seem to represent a fact, which as such stands outside copyright protection altogether (so that no merger defense need even arise).[[605]](#footnote-606)170

It has also been suggested that, when the objective is to report an evaluation made by another, “copying the exact words may be the only valid way precisely to report the evaluation.”[[606]](#footnote-607)171 Thus, for instance, although there may be many ways to express the idea that President Nixon is worthy of a pardon and therefore the merger doctrine would appear inapplicable, nonetheless, there may be only one way of adequately conveying President Ford’s evaluation of the subject, which is itself an object of historical inquiry—namely, by quoting from President Ford verbatim.[[607]](#footnote-608)172 This exception to the ban on copying must be narrowly construed,[[608]](#footnote-609)172.1 lest the merger doctrine be transmogrified into a free-standing defense to all copying on the grounds that plaintiff “needed” to reproduce the copyrighted expression in order to convey its “flavor.”[[609]](#footnote-610)172.2

The foregoing reference to “only one way of adequately conveying” sometimes finds its way into the case law.[[610]](#footnote-611)173 That statement should not be taken as a limitation that merger applies only when there is literally but a single possible formulation—merger may apply “when there is a limited number[[611]](#footnote-612)173.1 of expressions of the idea, albeit greater than one.”[[612]](#footnote-613)173.2 The test is improper monopolization of the subject idea, which may occur even if several alternative locutions are conceivable.[[613]](#footnote-614)173.3

A previous section has rehearsed arguments on both sides of the issue whether a municipal regulation that holds the force of law may secure copyright protection.[[614]](#footnote-615)173.4 Though the answer would seem to revolve over the distinctive considerations that apply to monopolization of governing law, one decision also invoked the merger doctrine to support its conclusion. Specifically, it ruled that a municipal code constitutes a “fact” falling within the scope of the merger doctrine.[[615]](#footnote-616)173.5

Veeck copied the building code of the towns of Anna and Savoy, Texas, based on their adoption of a version of the SBCCI model code. The codes are “facts” under copyright law. They are the unique, unalterable expression of the “idea” that constitutes local law. Courts routinely emphasize the significance of the precise wording of laws presented for interpretation.[[616]](#footnote-617)173.6

The *en banc* opinion concluded that “the merger doctrine is especially appropriate because other methods of expressing the idea are foreclosed. An individual wishing to publish the text of a law cannot develop his own, unique version and still publish an authoritative copy.”[[617]](#footnote-618)173.7 But the six dissenting judges resolutely denied that merger applied.[[618]](#footnote-619)173.8 Merger in that case therefore seems to have been a side issue that fails to resolve the primary dispute between the two points of view relating to the copyrightability of legal enactments.[[619]](#footnote-620)173.9

Unfortunately, as with the idea/expression dichotomy that pervades this area,[[620]](#footnote-621)173.10 application of the merger doctrine depends on the level of abstraction[[621]](#footnote-622)173.11 at which one defines the “idea” that merges with the subject expression.[[622]](#footnote-623)173.12 The Second Circuit, in *Kregos v. Associated Press*,[[623]](#footnote-624)173.13 though confessing to some unease in the distinction it was promulgating, posited that one must define the idea broadly to facilitate the public domain when predictive analysis is at issue (*e.g.*, a doctor’s compilation of symptoms for a disease), and more narrowly in favor of copyright protection in instances involving subjective matters of opinion.[[624]](#footnote-625)173.14 Surprisingly, that same court later fit a compendium of used car values into the latter category of subjective opinion, based on prediction, and upheld copyright protection for the *Red Book* over a merger defense.[[625]](#footnote-626)173.15 Later still, the Second Circuit retreated from that view,[[626]](#footnote-627)173.16 holding settlement prices for futures contracts in crude ***oil*** to be within the scope of the merger doctrine.[[627]](#footnote-628)173.17 Plaintiff lost its case by failing to demonstrate “a range of possible variations” on the number reflecting that price.[[628]](#footnote-629)173.18 The court also gave heavy weight to the policy consideration that the incentives on which copyright protection relies were absent.[[629]](#footnote-630)173.19

1. ***Defense to Infringement Rather Than Bar to Protection*.**

Besides the aspects canvassed above about how cases under the current Act apply the merger doctrine differently[[630]](#footnote-631)173.20 from the way it developed under *Morrissey* and *Kalpakian*,[[631]](#footnote-632)173.21 another distinction bears emphasis. Those two early cases treated the merger doctrine as an aspect of copyright subject matter,[[632]](#footnote-633)173.22 which is the *first* of two elements that plaintiff must prove to demonstrate copyright infringement.[[633]](#footnote-634)173.23 They held that merger, when it applies, prevents the work in question from securing the necessary protection.[[634]](#footnote-635)173.24 That interpretation corresponds to an early view of how *Baker v. Selden* should be applied.[[635]](#footnote-636)173.25

But there is an alternative way to construe the merger doctrine—as an aspect of the *second* element of an infringement case, namely to show that defendant unlawfully appropriated plaintiff’s expression.[[636]](#footnote-637)173.26

Confusion has arisen in the case law whether the merger doctrine should serve as a bar to copyright protection itself (element one)[[637]](#footnote-638)173.27 or, alternatively, as a negation of infringement via absence of actionable similarity (element two).[[638]](#footnote-639)173.28 Some cases set forth internally contradictory statements on the subject.[[639]](#footnote-640)173.29 The meticulous analysis of *Baker v. Selden* set forth above concludes that both methods seem to be inherent in that case.[[640]](#footnote-641)173.30 Given the more nuanced results that can emerge from treating a copyrighted composition in the context of a particular work that has copied it rather than in the abstract,[[641]](#footnote-642)173.31 it is the opinion of this treatise that the better view is to treat the merger doctrine under the rubric of substantial similarity,[[642]](#footnote-643)173.32 evaluating the inseparability of idea and expression in the context of a particular dispute, rather than attempting to disqualify certain expressions from protection *per se*.[[643]](#footnote-644)173.33 As encapsulated in one case,

The Register of Copyrights will not know about the presence or absence of constraints that limit ways to express an idea. The burden of showing such constraints should be left to the alleged infringer. Accordingly, … the relationship between “idea” and “expression” will not be considered on the issue of copyrightability, but will be deferred to the discussion of infringement.[[644]](#footnote-645)173.34

The matter proved contentious in one Second Circuit case. *Kregos v. Associated Press* involved a dispute over plaintiff’s baseball pitching form “that displays information concerning the past performances of the opposing pitchers scheduled to start each day’s baseball games.”[[645]](#footnote-646)173.35 The majority quoted this treatise’s formulation of the “better view” and proceeded to follow that recommendation:[[646]](#footnote-647)173.36 “Assessing merger in the context of alleged infringement will normally provide a more detailed and realistic basis for evaluating the claim that protection of expression would inevitably accord protection to an idea.”[[647]](#footnote-648)173.37

The *Kregos* dissent condemned this approach, whereby two works may be held not “substantially similar,” even when they may in fact be identical, as “a not useful variety of doublespeak.”[[648]](#footnote-649)173.38 Without wishing to appear facile, the response is that this usage, in fact, reflects a “useful variety of doublespeak,” given the multiple usages of the term “substantial similarity.”[[649]](#footnote-650)173.39 In the instant context, that term connotes a legal conclusion that enough copying has taken place to warrant finding infringement.[[650]](#footnote-651)173.40 Therefore, even if defendant exactly copied plaintiff’s work, “substantial similarity” in the sense of actionable infringement is negated, to the extent that all similarity subsists in matters as to which the merger doctrine applies, no less than if the similarity subsists solely in unprotected expression, which is also an area of copyright non-subsistence.[[651]](#footnote-652)173.41 Accordingly, the dissent’s fear that “Nimmer’s method lends itself much more readily to the erroneous conclusion that merger is only available where the defendant has independently created an expression which happens coincidentally to be similar to the plaintiff’s work” can be laid to rest.[[652]](#footnote-653)173.42 Instead, as both majority and dissent agreed in this case,[[653]](#footnote-654)173.43 it is typically preferable (as quoted at the end of the preceding paragraph) to assess merger “in the context of alleged infringement … .”[[654]](#footnote-655)173.44

The Ninth Circuit has adopted this approach as well. Citing this treatise, it held that merger (along with its sister doctrine of scenes a faire)[[655]](#footnote-656)173.45 should be treated as defenses to infringement rather than as relating strictly to copyrightability.[[656]](#footnote-657)173.46 Other cases likewise follow suit, such that this perspective has now become recognized as the better view of merger.[[657]](#footnote-658)173.47

1. **Scenes a Faire.**

Bearing in mind the hoary wisdom of Ecclesiastes that there is nothing new under the sun, certain patterns and situations are bound to recur. The claim (and variations thereon) is often advanced that “the entire dramatic literature of the world can be reduced to some three dozen situations.”[[658]](#footnote-659)174 So, for example, if two scenarios wish to treat the unprotected idea[[659]](#footnote-660)175 of police life in the South Bronx, one court has determined it would only be natural to depict “drunks, prostitutes, vermin and derelict cars,”[[660]](#footnote-661)175.1 juxtaposed against hard drinking Irish cops chasing fleeing criminals.[[661]](#footnote-662)175.2 Other thematic similarities in film have occasioned similar results.[[662]](#footnote-663)175.3

Turning to music, another case comments, “Having chosen the familiar theme of a broken-hearted lover seeking solace in country music, the choice of a barroom with a jukebox as the setting in which to unfold this idea simply cannot be attributed to any unique creativity on the part of the songwriter.”[[663]](#footnote-664)176 Judge Leon Yankwich has called such incidents “scènes à faire”[[664]](#footnote-665)176.1—*i.e.*, “scenes which ‘must’ be done.”[[665]](#footnote-666)177 It is sometimes said that scenes a faire refer to “incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.”[[666]](#footnote-667)177.1 To give a practical illustration, one court commented that “the public domain would have a scant selection if stock settings such as the movie theatre, the kitchen, Las Vegas, a church picnic or a club were subject to copyright protection.”[[667]](#footnote-668)177.2 The same applies to superheroes and their “capes, leotards, masks, chest emblems, boots, belts, and flared gloves.”[[668]](#footnote-669)177.3 But a medical caution statement has escaped that fate,[[669]](#footnote-670)177.4 when copied identically.[[670]](#footnote-671)177.5

In any event, the doctrine is often invoked to immunize from liability similarity of incidents or plot that necessarily follows from a common theme or setting.[[671]](#footnote-672)178 For example, the choice of writing about vampires[[672]](#footnote-673)178.1 leads to treating killings, macabre settings, and choices between good and evil.[[673]](#footnote-674)178.2 Photographing a fossil lends itself naturally to an aerial shot portraying it in the sand.[[674]](#footnote-675)178.3 Moreover, beyond mere “plot” incidents applicable to works of fiction, the scene a faire doctrine can be invoked throughout other copyright contexts as well,[[675]](#footnote-676)178.4 from guidebooks[[676]](#footnote-677)178.5 to infomercials[[677]](#footnote-678)179 to Frequently Asked Questions web pages[[678]](#footnote-679)179.1 and beyond. In two works dramatizing the trial of Judas Iscariot, for example,[[679]](#footnote-680)179.2 it was only natural to feature Satan as a character, dressed formally, ridiculing the examining lawyer.[[680]](#footnote-681)179.3

Particularly in the context of song lyrics, there would seem to be standard ingredients that go into a romantic ballad or a country lament. Accordingly, it makes sense to give wide berth to the scenes a faire doctrine. Nonetheless, it should not act as a license to appropriate limitless expression. As with all value judgments, a subjective element is at play here—consider the following list, which one court found insufficient to make defendant’s “Heaven” substantially similar to plaintiff’s “One of God’s Angels is AWOL”:

(1) God’s angel is with me, referring to the singer; (2) the angel had unfinished business; (3) an angel ran away from heaven; (4) the singer is elated; (5) the angel is amazing; (6) heaven has a “big problem” presumably because the angel left; (7) the singer knows something; and (8) the singer talked to someone about the angel.[[681]](#footnote-682)179.4

Those details would seem to cross the line into protected expression, as one could imagine many other manners of expressing the idea of a truant angel. Therefore, although one may sympathize with the court’s grant of summary judgment to megastar Jamie Foxx when sued by a *pro se* litigant who lacked any documentary support for his claim to have mailed his own song to Foxx’s record company via certified mail,[[682]](#footnote-683)179.5 the better course would have been to base the ruling on lack of any proof of access.[[683]](#footnote-684)179.6

As was remarked above concerning merger,[[684]](#footnote-685)180 this doctrine does not limit the subject matter of copyright; instead, it defines the contours of infringing conduct.[[685]](#footnote-686)180.1 Labeling certain stock elements as “scenes a faire” does not imply that they are uncopyrightable;[[686]](#footnote-687)181 it merely states that similarity between plaintiff’s and defendant’s works that are limited to hackneyed elements cannot furnish the basis for finding substantial similarity.[[687]](#footnote-688)182 But similarity beyond that measure can still attract liability.[[688]](#footnote-689)182.1

Of course, many cases pose questions of scenes a faire along with merger and other related doctrines. In one case, plaintiff sued after its fantastically successful coin-operated video golf game in a “dedicated cabinet” inspired defendant to offer a rival product—with the twist that only defendant’s game enjoyed PGA Tour endorsement.[[689]](#footnote-690)182.2 Because both games featured similar control panels, nearly identical placement of trackball and buttons, and the ability to simulate the same repertory of shots (fade, slice, hook, *etc.*) with both forward and backward movement,[[690]](#footnote-691)182.3 an ordinary observer might consider the two substantially similar.[[691]](#footnote-692)182.4 Nonetheless, after excluding ideas and methods of operation, layout decisions dictated by functional considerations,[[692]](#footnote-693)182.5 expression merged with ideas, and scenes a faire that arise naturally from playing the game of golf,[[693]](#footnote-694)182.6 no actionable similarity remained.[[694]](#footnote-695)182.7 This case therefore also demonstrates the limitations of the ordinary observer test.[[695]](#footnote-696)182.8

In another case, defendant put out a stained glass of a hula dancer that was “remarkably similar in both her position toward the viewer and in her bodily proportions” to plaintiff’s photograph of a dancer undertaking the same ‘ike movement.[[696]](#footnote-697)182.9 But, after excluding the scenes a faire, the court concluded that substantial similarity was lacking.[[697]](#footnote-698)182.10

1. **The Relevance of Common Errors in Establishing that Substantial Similarity Is Due to Copying**

Some copyright proprietors intentionally insert errors into their works in order to verify that the substantial similarity of the work of another is the result of copying from his work.[[698]](#footnote-699)183 Whether or not such errors are intentionally placed in the plaintiff’s work,[[699]](#footnote-700)183.1 the courts have regarded the existence of common errors in two similar works as the strongest evidence of copying as a factual matter,[[700]](#footnote-701)184 sometimes creating at least a *prima facie* case of copying.[[701]](#footnote-702)185 Reverting to the terminology set forth above, such common errors evince *probative similarity*.[[702]](#footnote-703)185.1 Nonetheless, because “[n]ot all copying … is copyright infringement,”[[703]](#footnote-704)185.2 they do not necessarily suffice to demonstrate the *substantial similarity* that underlies actionable copying.[[704]](#footnote-705)185.3 Frequently, common errors are often so minimal as to be insubstantial;[[705]](#footnote-706)186 alternatively, the common errors may consist solely of unprotectible facts[[706]](#footnote-707)186.1 (albeit “erroneous facts”).[[707]](#footnote-708)186.2 For these reasons, the existence of common errors does not avoid the necessity of establishing that the similarity of expression[[708]](#footnote-709)186.3 between the two works in issue is substantial.[[709]](#footnote-710)187 They may, however, constitute similarity sufficiently striking so as to avoid the requirement of proving access.[[710]](#footnote-711)188

The trier of fact may reject as incredible the plaintiff’s unsupported testimony as to the existence of common errors.[[711]](#footnote-712)189 Moreover, even if proven, the defendant may offer a satisfactory explanation of such common errors,[[712]](#footnote-713)190 as for example the fact that the industry or profession as a whole was in error on a particular point,[[713]](#footnote-714)191 or that the misstatement was copied not from the plaintiff,[[714]](#footnote-715)192 but from a common source.[[715]](#footnote-716)193[[716]](#footnote-717)194-198

1. **Effect of Access on Substantial Similarity—The Inverse Ratio Rule**

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| **Editor’s Note:**  The material that was formerly located in the present subsection has been replaced. The revised treatment of this issue is set forth in § 13D.08 *infra*. To consult the prior version of this section, see Online Appendix 106. |

1. **Dissection and the Audience Test in Determining Substantial Similarity**

1. **Judicial Formulations.**

Although it is clear that the determination of substantial similarity presents an issue of fact,[[717]](#footnote-718)199 the correct procedure for that determination remains clouded. For over a century, the courts in general have purported to apply what is called the ordinary observer or audience test.[[718]](#footnote-719)200 That test is the subject of the lengthy discussion in this section.[[719]](#footnote-720)200.1 Yet, the authority for the audience test emanates exclusively from the inferior courts, and may not be in harmony with the views of the nation’s highest tribunal.[[720]](#footnote-721)200.2 Accordingly, this discussion must be placed into a type of mental “suspense account.” It must inevitably be taken into account, and may indeed prove dispositive. But until the Supreme Court validates or negates the audience test, the copyright bar will be left in suspense as to its ultimate validity.[[721]](#footnote-722)200.3

1. ***The Audience Test.***

*Harold Lloyd Corp. v. Witwer*[[722]](#footnote-723)200.4 states the traditional test:

The question really involved in such comparison is to ascertain the effect of the alleged infringing play upon the public,[[723]](#footnote-724)201 that is, upon the average reasonable man. If an ordinary person[[724]](#footnote-725)201.1 who has recently read the story sits through the presentation of the picture, if there had been literary piracy of the story, he should detect that fact *without any aid or suggestion or critical analysis by others. The reaction of the public to the matter should be spontaneous and immediate.*[[725]](#footnote-726)202

If the works in issue are directed to a particular audience, then the “spontaneous and immediate” reaction of that audience is determinative.[[726]](#footnote-727)202a Thus, when the works are directed to an audience of children, “this raises the particular factual issue of the impact of the respective works upon the minds and imaginations of young people,” who may not be as bent as their elders upon “detecting disparities.”[[727]](#footnote-728)202b Moreover, it has been held that a work may be directed at an audience of children even if the purchasing decision is made by adults outside the presence of children.[[728]](#footnote-729)202c

1. ***The New Learning?***

In recent decades, the Supreme Court has confronted numerous copyright issues; yet none of those cases posed the line-drawing issue of how far a defendant can go without committing *prima facie* infringement.[[729]](#footnote-730)202.1 In fact, in none of those cases did the Supreme Court lay down the governing law as to what constitutes the elements of a copyright case. Rather, in the annals of Supreme Court jurisprudence, the elements spring forth full-grown in a 1991 decision regarding telephone book compilations.

Specifically, in *Feist Publications, Inc. v. Rural Telephone Service Co.*,[[730]](#footnote-731)202.2 the Supreme Court defined the essential element of an infringement claim (along with ownership of a valid copyright) as follows: “copying of constituent elements of the work that are original.”[[731]](#footnote-732)202.3 That definition purports to apply across the board, not merely to the type of factual compilation at issue in *Feist*.[[732]](#footnote-733)202.4 The prepositional phrase following “copying” furnished the linchpin for the Court’s analysis. Notwithstanding the validity of the copyright in plaintiff’s work as a whole, notwithstanding defendant’s exact copying from plaintiff’s work—even to the extent that defendant reproduced some fictitious listings composed by plaintiff to detect copying—and notwithstanding the decision by both lower courts in plaintiff’s favor, a unanimous Supreme Court[[733]](#footnote-734)202.5 held defendant’s conduct noninfringing as a matter of law, given that the constituent elements that defendant appropriated were not themselves original.[[734]](#footnote-735)202.6

At least in the context of the factual compilations at issue in *Feist*, there was no hint that the Court deemed relevant the effect “upon the public,” any “spontaneous and immediate” impression, or reactions reached “without any aid or suggestion or critical analysis.”[[735]](#footnote-736)202.7 Indeed, to focus on the precise scope of defendant’s admitted copying and to detail how said copying was limited to unprotected expression, it would seem that critical analysis is essential. The Court’s approach in *Feist*, on the facts there presented, is therefore inhospitable to an unadorned audience test.

Nonetheless, *Feist* did not in express terms reject the test. Accordingly, the inquiry into the doctrine’s current viability must be posed as follows: Does the audience test give content to the Court’s definition of infringing conduct as “copying of constituent elements of the work that are original?”[[736]](#footnote-737)202.7a In the context of the *Feist* decision itself, it would seem that the audience test can play no useful role. But more broadly, to the extent that application of the audience test results in liability across the spectrum of copyrightable compositions, when such copying has occurred, and denies liability when there is either no copying or copying only of unoriginal constituents, then it may be concluded that that test fulfills the goals of copyright law as detailed by the Court. By contrast, to the extent that the audience test frustrates that goal, it must be discarded, limited, or tailored to meet the Supreme Court’s formulation.[[737]](#footnote-738)202.7b

It is submitted in the discussion that follows that the audience test does not, at its core, serve the goal set forth above.[[738]](#footnote-739)202.8 No doubt, it is possible to limit and tailor that core, as well as to accrete special exceptions to it[[739]](#footnote-740)202.9—the courts can contort and distend the audience test such that it will not fall directly afoul of *Feist*.[[740]](#footnote-741)202.10 But the mere fact that the exercise is possible hardly proves it to be desirable. Defenders of Ptolemy’s geocentric universe could explain each new celestial *datum* with exceptions and riders; eventually, however, the weight of the gerrymandering brought the whole model crashing down.[[741]](#footnote-742)202.11 Given the questionable doctrinal footing for the audience test,[[742]](#footnote-743)202.12 the fact that, in practice, it “has had an artificial and disappointingly inaccurate application”[[743]](#footnote-744)202.13 and increasingly has become a verbal formula to explain results otherwise reached,[[744]](#footnote-745)202.14 the myriad exceptions in the way it is applied,[[745]](#footnote-746)202.15 its total incongruence with the tools needed to evaluate those works of technology that increasingly dominate[[746]](#footnote-747)202.15a copyright jurisprudence,[[747]](#footnote-748)202.16 its hostility in practice to sound judicial management[[748]](#footnote-749)202.17 through eliminating meritless claims via summary judgment,[[749]](#footnote-750)202.18 and finally the fact that it is inadequate to explain the result in the most important Supreme Court case posing the question of how to determine infringement, perhaps a paradigm shift of Copernican proportions is needed in the law of copyright.[[750]](#footnote-751)202.19 It would seem preferable, in short, to discard the audience test.[[751]](#footnote-752)202.20

But what to offer in its stead? In *Feist*, the Court took a copyrighted work and eliminated from the substantial similarity calculus all material therein not subject to copyright. The result was to appreciate that the defendant copied only uncopyrightable elements from plaintiff’s work, and therefore to deny liability.[[752]](#footnote-753)202.21 This writer elsewhere has proposed such a test for works of high technology under the rubric “successive filtering.”[[753]](#footnote-754)202.22 Whatever the label, the method is sound and has been applied, at least *sub silentio*, by courts in a variety of contexts.[[754]](#footnote-755)202.23 In the wake of *Feist*, it should be considered not only for factual compilations[[755]](#footnote-756)202.23a and computer programs, but across the gamut of copyright law:[[756]](#footnote-757)202.23b to determine whether the similarity between plaintiff’s and defendant’s work is substantial, the comparison should not include unoriginal elements of plaintiff’s work;[[757]](#footnote-758)202.23c rather, the comparison should take place after filtering out[[758]](#footnote-759)202.24 of the analysis elements of plaintiff’s work that are not protectible[[759]](#footnote-760)202.25 or are otherwise non-actionable,[[760]](#footnote-761)202.25a such as those that can be proven to have been independently created.[[761]](#footnote-762)202.25b The result of that test may or may not match the outcomes of the various cases applying the so-called audience test and its innumerable variants.[[762]](#footnote-763)202.26

1. **Criticism of the Audience Test.**

Reverting to the formulation describing the role of the ordinary observer,[[763]](#footnote-764)202.27 the italicized portion of *Harold Lloyd Corp. v. Witwer* quoted above[[764]](#footnote-765)202.28 represents the very heart of the audience test and, it is suggested, its weakness.[[765]](#footnote-766)202.29 The trier of fact is not to examine “hypercritically or with meticulous scrutiny,”[[766]](#footnote-767)203 but is to determine similarity solely on the basis of his “net impression,”[[767]](#footnote-768)204 ignoring any particular impressions of similarity found by dissecting and examining elements of the two works.[[768]](#footnote-769)205 In comparing a book and a motion picture, the public must be “deceived” into believing “that the films are a picturization of plaintiff’s literary work” in order for there to be a finding of infringement.[[769]](#footnote-770)206

Before examining the implications of this doctrine, it would be well to note its origin. This “audience test” is commonly said[[770]](#footnote-771)207 to be based on the opinion rendered in the leading case *Daly v. Palmer*.[[771]](#footnote-772)208 In that case, both parties’ works involved a scene on a railroad track wherein someone tied to the track is released just in time to avert a tragic demise. The scenes were not similar in dialogue but were almost identical in action. In answer to the argument that copyright does not protect pantomime and other nonverbal action, the court said:

[A] composition when represented excites emotion and imparts impressions not merely through the medium of the ear as music does but through the medium of the eye as well as the ear. Movement, gesture and facial expression, which address the eye only, are as much a part of the dramatic composition as is the spoken language which addresses the ear only; and that part of the written composition which gives direction for the movement and gesture is as much a part of the composition and protected by copyright as is the language prescribed to be uttered by the characters. …[[772]](#footnote-773)209

Then, within the above context, the court went on to say that the standard for determining similarity is whether the two works are:

[1] recognized by the spectator; [2] through any of senses to which the representation is addressed; [3] as conveying substantially the same impressions to and exciting the same emotions in the mind in the same sequence or order.[[773]](#footnote-774)210

The “audience test” derives from the phrase numbered 1 above. Yet there is nothing in this passage to indicate that there must be no dissection or analysis in considering the significance of sensory impressions. Furthermore, within the above-stated context, it is at least perfectly arguable that phrase 2, not phrase 1, deserves the emphasis. That is, it may be that the court in this passage—from which so much has been extracted—intended merely to point up the principle that elements appealing to any of the senses might command copyright protection.

Certainly, there can be no dispute that the “spontaneous and immediate”[[774]](#footnote-775)211 reactions of the ordinary observer are relevant evidence in determining the existence of copying.[[775]](#footnote-776)212 There is, however, reason to dispute the doctrine insofar as it makes the visceral reactions of the trier *the* ultimate test of copying (assuming access). The Copyright Act is intended to protect writers from the theft of the fruits of their labor,[[776]](#footnote-777)213 not to protect against the general public’s “spontaneous and immediate” *impression* that the fruits have been stolen. To be sure, the ordinary observer’s impression that there has been a theft is important evidence in establishing that, in fact, there was a theft, but the two are not the same. There are reasons why the spontaneous impressions of an ordinary observer—or reasonable person in comparing two literary works—may not always prove an accurate guide to ferreting out the existence of literary theft. These reasons we now propose to examine.

The “audience test” is an attempt at applying the “reasonable person” doctrine as found in other areas of the law to copyright.[[777]](#footnote-778)214 But in those other areas (*e.g.*, torts, trusts, corporations, criminal law), the trier is asked to compare the defendant’s actions with what the trier’s own (presumably reasonably prudent) actions would be under the same circumstances. Thus, in a negligence case, the trier puts himself into the defendant’s shoes, not the shoes of an “ordinary observer” of the accident. Contrast this with the “audience test” where the essential question is: did the defendant copy from plaintiff? Here the trier is not equipped to put himself into the defendant’s shoes. He cannot meaningfully answer whether, if he were in the defendant’s shoes, he would have been constrained to copy from the plaintiff in order to achieve the given result. Therefore, the trier is directed to answer the only question he can answer—does the result of the defendant’s work give appearances of having been copied from the plaintiff? But this leads us back to the dead end of audience impression of theft, not to the theft itself. Can there be literary theft without an immediate and spontaneous detection by the ordinary observer? If this question can be answered in the affirmative, then, obviously, the audience test is inadequate.

Consider the not infrequent situation where the defendant’s work is adapted for use in a medium different from that intended for the plaintiff’s. In comparing a play and a motion picture, it has been recognized that:

dissimilarities result … principally from the film’s enlarged means to express in a wider latitude incidents necessarily requiring a wider range of settings than a play restricted to the narrow confines of a theatrical stage is able to present.[[778]](#footnote-779)215

In copying a movie from a play, one court has suggested that:

it may be most effectively pirated by leaving out the speech, for which a substitute can be found, which keeps the whole dramatic meaning.[[779]](#footnote-780)216

Similarly, where a motion picture or play is based on a novel, the courts have recognized that “dramatization of a novel frequently differs from the story on which it is founded,”[[780]](#footnote-781)217 and that “the form of expressing ideas is not by repeating the words and form of expression contained in the story.”[[781]](#footnote-782)218 Often, a novel will be composed largely of introspective thoughts and emotions that, when dramatized, will of necessity be expressed in a quite different manner. “It seems hardly possible that any amount of effort to ‘register’ emotions could produce it on film.”[[782]](#footnote-783)219 In *Dam v. Kirke La Shelle*,[[783]](#footnote-784)220 where it was claimed that a play infringed a short story, the court stated well the problem of transformation into a different medium:

It is, of course, true that the play has many additional incidents. It is likewise true that none of the language of the story is used in the play and that the characters have different names. But the right given to the author to dramatize his work includes the right to adapt it for representation upon the stage which must necessarily involve changes, additions and omissions. *It is impossible to make a play out of a story to represent a narrative by dialogue and action without making changes …* Few short stories could be transformed into dramatic compositions without the addition of many new incidents.[[784]](#footnote-785)221

Yet, despite this recognition of a great variance in presentation between two media, most courts have not been persuaded to, in any way, modify the “audience test.” Certainly, if in spite of the difference in medium, the ordinary observer spontaneously and immediately notes a substantial similarity, there should be a finding of infringement.[[785]](#footnote-786)222 But if because of the camouflage of a different medium, the lay audience loses sight of the similarity, the fact remains that the plaintiff may have suffered a substantial appropriation of the fruits of his labor. In fact, the writer’s loss is even greater when the appropriation is into a different medium, for here his work is made available to a new, untapped market, whereas if the infringing work were limited to the original medium, it would only attract the same people who already had had an opportunity to purchase the plaintiff’s work. Thus, in this important area, the immediate and spontaneous observations of a person untrained in the special requirements and techniques of the play, the novel, the short story, the motion picture, and most especially, the computer,[[786]](#footnote-787)223 may fail to note similarities that, if analyzed and dissected, would be only too apparent.[[787]](#footnote-788)224

Furthermore, quite apart from the additional complication of transformation into a different medium, there will still be numerous instances when the “ordinary observer” is simply not capable of detecting very real appropriation. The court, in *Harold Lloyd Corp. v. Witwer*,[[788]](#footnote-789)225 denied liability, formulating the test as being if the ordinary observer were:

*given an interval of two or three weeks* between a casual reading of [plaintiff’s] story and a similar *uncritical* view of [defendant’s work] it would not occur to such a spectator *in the absence of a suggestion to that effect* that he was seeing in motion picture form the story or any part of the story of [plaintiff’s work].[[789]](#footnote-790)226

If what is to be protected is literary theft, and not the impression of literary theft *per se*, why, we may wonder, must the view be “uncritical,” and why must there be no suggestion and pointing to similarity, if that suggestion would prove helpful to the trier in seeing that all or a part of plaintiff’s work formed the basis for all or a part of defendant’s work? Finally, why allow for an interval of two or three weeks, if we are interested in the theft, not the impression of theft? The court, in *McConnor v. Kaufman*,[[790]](#footnote-791)227 suggested by implication that where a “play doctor” is employed to make the transformation, an ordinary observer would not observe that the one work was copied from the other, but a keen critic might. If the play doctor’s literary surgery consists merely of clever juxtaposition and alteration of unessential details in the plaintiff’s work, plus the addition of a substantial amount of new material so that the resulting product is unrecognizable by the untutored observer in his immediate and spontaneous impression, should it be said, as a matter of law, that no piracy has occurred? Such a principle renders the fruits of a writer’s labor safe from all but the clever thieves.[[791]](#footnote-792)228 In hewing to the requirement that the ordinary observer is to be guided by his spontaneous and immediate net impression, the courts do not indicate that similarities between the two works will necessarily be recognized in this manner. Indeed, *Harold Lloyd Corp. v. Witwer* further stated:

Such similarities as exist between the play and the story, *and there are many*, are such as require analysis and critical comparison in order to manifest themselves.[[792]](#footnote-793)229

The court therefore concluded that the plaintiff could not recover. This case seems to present an excellent example of the unreasonable use to which the reasonable person standard has been put. The court admits that there are similarities (that for present purposes may be presumed to have been copied from the plaintiff’s original expression), and yet because an ordinary observer could not note these similarities without a “critical” comparison, the plaintiff is rendered remediless.

1. **Judicial Modification of the Audience Test.**

As the criticisms voiced in the preceding subsection adumbrate, the audience test is rife with difficulties as a matter of self-definition.[[793]](#footnote-794)230 It is further unclear whether the doctrine serves any useful purpose, given the Supreme Court’s formulation in *Feist*.[[794]](#footnote-795)231 Nonetheless, to date, outright rejection of the audience test has been judicially frowned upon.[[795]](#footnote-796)232 The Second Circuit long ago reversed a district judge who attempted to reject the audience test as follows:

I must, as the trier of the facts, have a more Olympian viewpoint than the average playgoer. I must look at the two opposing productions, the Play and the Picture, not only comparatively, but, as it were, genealogically.[[796]](#footnote-797)233

Nonetheless, one suspects that courts continue to adopt an Olympian viewpoint.[[797]](#footnote-798)234 Moreover, before delving into the elaborate (and sometimes conflicting) structures that the jurisprudence constructs, it is useful to bear in mind one court’s trenchant observation that “good eyes and common sense may be as useful as deep study of reported and unreported cases, which themselves are tied to highly particularized facts.”[[798]](#footnote-799)235 The Supreme Court’s later quotation of that language[[799]](#footnote-800)235.1 in a different context only adds luster to this sensibility.[[800]](#footnote-801)235.2

1. ***Second Circuit Law***

1. ***Arnstein.***

An important modification of the audience test was formulated in *Arnstein v. Porter*,[[801]](#footnote-802)236 wherein the court divided the issue of substantial similarity into two separate elements: First comes the question whether defendant copied from plaintiff’s work. Assuming such copying, the second question inquires whether that copying went so far as to constitute an improper appropriation.[[802]](#footnote-803)237 On the first question, it has been suggested that the two works are to be compared in their entirety, including both protectible and nonprotectible material.[[803]](#footnote-804)238 Under the *Arnstein* doctrine,[[804]](#footnote-805)239 in making such comparison, resort may properly be made to expert analysis[[805]](#footnote-806)240 and dissection[[806]](#footnote-807)241 and not merely to the spontaneous and immediate impression of the ordinary observer.[[807]](#footnote-808)242

It has been held not an abuse of discretion to permit the plaintiff to offer his opinion as to the similarities between his and the defendant’s works.[[808]](#footnote-809)243 Substantial similarity may not be shown, however, by an analysis that alters the actual sequence or construction of plaintiff’s work in order to achieve a juxtaposition that makes for greater similarity with defendant’s work.[[809]](#footnote-810)244 Examples of prohibited devices here would include compiling “widely scattered passages”[[810]](#footnote-811)245 or allowing plaintiff to introduce his own “voiceover” version of defendant’s movie[[811]](#footnote-812)246—not to mention the ever-popular list[[812]](#footnote-813)246.1 of “random similarities scattered throughout the work.”[[813]](#footnote-814)247 Acknowledging that cherry-picked[[814]](#footnote-815)247.1 lists of similarities are sometimes used for “illustrative purposes,”[[815]](#footnote-816)248 many courts are of the opinion they are “inherently subjective and unreliable.”[[816]](#footnote-817)249 Layered on top is the additional endemic problem of exaggerating (or even inventing) supposed similarities.[[817]](#footnote-818)249a

Once copying is established by an overall comparison, on the second question (the issue of unlawful appropriation) *Arnstein* would strictly apply the audience test and preclude dissection and expert analysis.[[818]](#footnote-819)249.1 This for the reason that, once having established copying, the issue of *unlawful* appropriation amounts to a question “whether defendant took from plaintiff’s works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff.”[[819]](#footnote-820)250 This, the *Arnstein* court concluded, is “an issue of fact which a jury is peculiarly fitted to determine.”[[820]](#footnote-821)251

The issue of improper or unlawful appropriation posited in *Arnstein* was thereafter characterized by the same court as “merely an alternative way of formulating the issue of substantial similarity.”[[821]](#footnote-822)252 In any event, the cases are legion in the Second Circuit that attempt to vindicate its application of the audience test.[[822]](#footnote-823)253

In determining the issue of unlawful appropriation under the *Arnstein* formulation, the trier of fact is of necessity making a judgment whether the similarity relates to material of substance and value in plaintiff’s work.[[823]](#footnote-824)253.1 In the case of comprehensive non-literal similarity,[[824]](#footnote-825)254 this determination involves a judgment whether the borrowed “pattern” is of a sufficiently concrete nature.[[825]](#footnote-826)255 In the case of fragmented literal similarity,[[826]](#footnote-827)256 a value judgment must likewise be made, but in this instance, without the necessity of drawing a line between the unprotected abstract and the protected concrete. It is difficult to reconcile *Arnstein*’s position that no dissection is to be permitted with the statement in a number of other decisions that such comparison is to be made only with respect to the protectible portions of plaintiff’s work.[[827]](#footnote-828)257 If the comparison is thus limited, it is hardly reasonable to expect laymen to attempt it without dissection, at least to delineate that portion of the plaintiff’s work that is protectible.[[828]](#footnote-829)258 It may be that the *Arnstein* opinion is not intended to preclude dissection on the second question for this limited purpose.[[829]](#footnote-830)259 Indeed, to cabin *Arnstein*’s audience test within the *Feist* framework,[[830]](#footnote-831)260 such an interpretation would seem essential.[[831]](#footnote-832)261 Whether it is desirable to retain even that much of *Arnstein* is a separate matter.[[832]](#footnote-833)262

1. ***The “More Discerning” Observer.***

As noted repeatedly above, the essence of the audience test is its focus on viewers’ spontaneous reaction, unschooled by dissection and expert guidance. It therefore appears oxymoronic, at first blush, to refer, as has the Second Circuit on more than one occasion, to a “more discerning ‘ordinary observer’ test.”[[833]](#footnote-834)262.1

Nonetheless, the salutary result of such discernment may be the successive filtering test advocated herein.[[834]](#footnote-835)262.2 Illustrative is a district court case about carpets that sold for thousands of dollars each (whose consumers were therefore sophisticated).[[835]](#footnote-836)262.3 Even though both rugs incorporated many of the same patterns, no liability followed to the extent that those patterns emanated from the public domain.[[836]](#footnote-837)262.4 As further dissection revealed, “No reasonably discerning observer would find that the [defendants’] Mahogany design has a ‘floraseque’ appearance like the classic design in the [plaintiff’s] Japanese-inspired Takyu III.”[[837]](#footnote-838)262.5 In this manner, the extra discernment required by this variation of the ordinary observer test focuses the factfinder on similarities that “relate to protectible material,”[[838]](#footnote-839)262.6 thereby mandating analysis that goes well beyond the spontaneous reaction of the audience.[[839]](#footnote-840)262.7

1. ***The Ninth Circuit’s Metaphysical Palaces.***

The most elaborate metaphysics of the audience test have been developed in the Ninth Circuit.

1. ***The* Krofft *Dichotomy.***

In *Sid & Marty Krofft Television Productions, Inc. v. McDonald’s Corp.*,[[840]](#footnote-841)263 the Ninth Circuit, building on *Arnstein*, articulated a bifurcated test for infringement that, in some ways, appears to go farther than that in *Arnstein*.[[841]](#footnote-842)264 Under *Krofft*, there are again two steps in the analytic process.[[842]](#footnote-843)264.1

First, there is the issue of whether there is substantial similarity as to the “general ideas” contained in the two works. This is to be resolved by what the *Krofft* court labels the “extrinsic test,” in that this determination turns “not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed.”[[843]](#footnote-844)264.2 These criteria are said to include not only “the subject matter, and the setting for the subject,” which do go to the issue of idea similarity, but also (more questionably) “the type of artwork involved, [and] the materials used.”[[844]](#footnote-845)264.3

In applying the extrinsic test, the *Krofft* court concluded that “analytic dissection and expert testimony are appropriate.”[[845]](#footnote-846)264.4 Having found such idea similarity, the second step in the analytic process requires that the trier of fact then decide “whether there is substantial similarity in the expressions of the ideas so as to constitute infringement.”[[846]](#footnote-847)264.5 This is to be determined by what *Krofft* labels the “intrinsic test,” in that it depends “on the response of the ordinary reasonable person.”[[847]](#footnote-848)264.6 In applying the intrinsic test, “analytic dissection and expert testimony” are said to be “not appropriate.”[[848]](#footnote-849)264.7

The effect of the *Krofft* bifurcated test is to expand the domain of the trier of fact, and greatly to contract the role of the court, at least in its power to rule for the defendant as a matter of law. It is true that *Krofft* concludes that the extrinsic test “may often be decided as a matter of law”;[[849]](#footnote-850)264.8 however, because the only issue under this test is that of idea similarity, and because, in almost all copyright litigation, the plaintiff will not file an action unless there is, at a minimum, a colorable claim as to substantial similarity of ideas,[[850]](#footnote-851)264.9 a court will rarely have the power under a strict interpretation of *Krofft* either to rule for defendant in advance of trial or to reverse on appeal a jury determination for plaintiff. On the issue of substantial similarity of expression, *Krofft* concludes that the intrinsic test “is uniquely suited for determination by the trier of fact”[[851]](#footnote-852)264.10 so that an appellate court “must be reluctant to reverse.”[[852]](#footnote-853)264.11 Although the “clearly erroneous” standard for overturning findings of fact applies, *Krofft* observes that “this court will be less likely to find clear error when the subjective [intrinsic] test for copying of expression has been applied.”[[853]](#footnote-854)264.12

In invoking the extrinsic test, *Krofft* referred to it as a test to determine “similarity in ideas.”[[854]](#footnote-855)264.13 Yet ideas themselves lie beyond copyright protection![[855]](#footnote-856)264.13a Even putting aside that anomaly, some courts have erroneously interpreted *Krofft*’s standard to require a comparison of *the* idea in each work, as if each work carries but a single core idea—a sort of Platonic essence.[[856]](#footnote-857)264.14[[857]](#footnote-858)264.15-264.19 Under *Krofft*, any idea that is found in both plaintiff’s and defendant’s works is sufficient to satisfy the extrinsic test. Of course, this will not constitute infringement, unless it is further found that there is substantial similarity in the expression of that idea, under the intrinsic test.

It is submitted that *Krofft* unnecessarily limits the scope of the court’s determination under the preliminary, extrinsic, test. Even if there is marked similarity between the *ideas* in plaintiff’s and defendant’s works, a court should be able to rule for the defendant, either on motion prior to trial or by reversal on appeal, if the dissimilarity of *expression*[[858]](#footnote-859)264.20 between the two works is sufficiently great.[[859]](#footnote-860)264.21 Under the *Arnstein* bifurcated test, the court is first to determine whether there has been any copying, including “permissible copying.”[[860]](#footnote-861)264.22 *Krofft* interpreted this to mean that the court should determine only whether there has been a copying of ideas, without reference to whether there has also been a copying of expression. This is probably an incorrect reading of *Arnstein*,[[861]](#footnote-862)264.23 in view of *Arnstein*’s citation of authorities elucidating the phrase “permissible copying.”[[862]](#footnote-863)264.24 Although not without ambiguity on the point, the *Arnstein* version of the preliminary—extrinsic—test probably calls for a determination of whether there is substantial similarity of expression (not merely of idea), but this is to be made regardless of the protectibility of such expression, while the second—intrinsic—test of substantial similarity is confined to that expression that is protectible by the plaintiff. It is true that *Krofft* is careful to state that its articulation of the rule is not dependent upon whether it has correctly read *Arnstein*.[[863]](#footnote-864)264.25 Still, in the interest of justice, and of avoiding nuisance litigation,[[864]](#footnote-865)264.26 the hope arose that future decisions would view the scope of the extrinsic test as that suggested by *Arnstein*, rather than that adopted in *Krofft*.

1. ***Complying with* Feist.**

Shortly before the U.S. Supreme Court’s *Feist* decision,[[865]](#footnote-866)264.27 the Ninth Circuit modified *Krofft*’s two-step analysis. In *Shaw v. Lindheim*,[[866]](#footnote-867)264.28 the court reformulated the extrinsic and intrinsic tests as “objective and subjective analyses of expression, having strayed from *Krofft*’s division between expression and ideas.”[[867]](#footnote-868)264.29 The court announced a rule that any plaintiff who can “satisf[y] the extrinsic test creates a triable issue of fact in a copyright action involving a literary work.”[[868]](#footnote-869)264.30 Because the plaintiff at bar met that test, the Ninth Circuit reversed the district judge’s entry of summary judgment on behalf of the defendant.[[869]](#footnote-870)264.31

Because we have seen that plaintiffs can almost always satisfy *Krofft*’s extrinsic test, *Shaw*’s guarantee of a trial, in those circumstances, could have been viewed as the death knell in the Ninth Circuit for defense summary judgments based on purported absence of substantial similarity.[[870]](#footnote-871)264.32 Yet, given *Shaw*’s reformulation of the extrinsic test, the decision is better viewed[[871]](#footnote-872)264.33 as standing for the unremarkable proposition that when, objectively speaking, a triable case of expressive similarity exists,[[872]](#footnote-873)264.34 the case must be sent to the trier of fact; but, when no such objective argument is possible, summary judgment will lie.[[873]](#footnote-874)264.35 Thus viewed, *Shaw* works an improvement. By quoting verbatim much of this paragraph in affirming a defense summary judgment based on absence of substantial similarity, it would appear that a subsequent Ninth Circuit decision adopts the immediately preceding understanding of *Shaw*.[[874]](#footnote-875)264.36 This subsequent decision, moreover, concedes that Ninth Circuit law “appears to be moving toward the test favored in the [concurring opinion] in which lay and expert testimony are uniformly admissible.”[[875]](#footnote-876)264.37

Yet, if that much of *Shaw* (at least understood as postulated above) is progressive, other aspects of the opinion are more problematic. First, the opinion announces a rule for literary works that stands in contrast to a different rule (the contours of which have yet to be defined) for representational objects.[[876]](#footnote-877)264.38 That distinction creates yet another unfortunate bifurcation in the Ninth Circuit doctrine for determining substantial similarity. Yet perhaps that standard too was short-lived; in *Apple Computer, Inc. v. Microsoft Corp.*,[[877]](#footnote-878)264.39 the Ninth Circuit enunciated standards for determining substantial similarity of a computer program’s artistic features, stating that it is “subject to the same process of analytical dissection as are other works.”[[878]](#footnote-879)264.40 That holding not only posits a uniform standard, but also embraces the type of filtration that stands in opposition to the audience test;[[879]](#footnote-880)264.41 yet the Ninth Circuit refused to jettison the audience test, instead citing *Shaw* and *Krofft* and discussing their extrinsic/intrinsic distinctions.[[880]](#footnote-881)264.42

In addition, *Shaw*’s very formulation of the issue to be decided is suspect in light of the Supreme Court decision in *Feist*, handed down several months later. In *Shaw*, the Ninth Circuit begins by stating that “Shaw must show that he owns the copyright and that defendant copied *protected elements of the work*.”[[881]](#footnote-882)264.43 That quotation is in exact harmony with *Feist*.[[882]](#footnote-883)264.44 Yet, later in the same paragraph, the Ninth Circuit, in reversing the district court, ignores the above italicized language to conclude that “the only issue before the district court on the copyright claim was whether defendants’ version of the Equalizer is substantially similar to Shaw’s original script.”[[883]](#footnote-884)264.45 That statement is wrong as a matter of law, as its application to the facts of the later Supreme Court case proves: The district court in *Feist* concluded that defendant’s telephone directory was substantially similar to Rural’s compilation;[[884]](#footnote-885)264.46 yet the absence of similarity as to *original protected expression* proved nonetheless fatal to plaintiff’s claim.[[885]](#footnote-886)264.47 Reverting to the posture in which *Shaw* reached the circuit court, the district judge had concluded that “plaintiffs have failed to establish that enough protected *expression* is infringed to warrant denial of defendants’ Motion for Summary Judgment.”[[886]](#footnote-887)264.48 Given that both the district court and Ninth Circuit opinions predated *Feist*, it is unclear whether the appellate court would have been obligated to accept that finding under the regnant standard.[[887]](#footnote-888)264.49 But given its inconsistency with Supreme Court doctrine, the Ninth Circuit’s second formulation quoted above cannot survive *Feist*.[[888]](#footnote-889)264.50

It should be added that *Shaw* also introduced a distinction between the analysis for two types of artistic works, the literary and the representational.[[889]](#footnote-890)264.51 Although *Shaw* itself arose in the context of television scripts, the Ninth Circuit later applied *Shaw* to musical motives and to motion picture screenplays, but reserved the question whether it should apply to art works.[[890]](#footnote-891)264.52

1. ***Anticipating the Filtration Test.***

The text below offers an alternative to the audience test based on filtration, especially geared to the realm of computer software.[[891]](#footnote-892)264.53 In an opinion handed down before that alternative test was formulated, involving alleged infringement of a radiator parts catalog, the Ninth Circuit adopted a filtration-like approach, stating that “what is important is not whether there is substantial similarity in the total concept and feel of the works, but whether the very small amount of protectible expression in [plaintiff]’s catalog is substantially similar to the equivalent portions of [defendant]’s catalog.”[[892]](#footnote-893)264.54 A later ruling retreated from that holding with respect to artistic works;[[893]](#footnote-894)264.55 nonetheless, it remains applicable to functional works, such as the parts catalog at issue in that case and the computer programs that later gave rise to the filtration test.

Moreover, even as to artistic works, in the extreme case when all of a plaintiff’s work is found ineligible for protection, the Ninth Circuit follows the analytic approach undergirding the filtration test: “Although even unprotectible material should be considered when determining if there is substantial similarity of expression, no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas.”[[894]](#footnote-895)264.56 But the Ninth Circuit itself may not be following that limitation[[895]](#footnote-896)264.57 in cases other than the extreme in which all of the plaintiff’s work is ineligible for protection.[[896]](#footnote-897)264.58 In *Olson v. National Broadcasting Company*,[[897]](#footnote-898)264.59 the court affirmed a j.n.o.v. in favor of defendant in a case involving artistic works, despite its acknowledgment that the jury acted reasonably in finding substantial similarity in the total concept and feel of the two works.[[898]](#footnote-899)264.60 *Olson*’s holding seems to apply the radiator parts case to artistic works, in opposition to the attempt described above to limit it to functional works.

As an example of a Ninth Circuit case essentially applying the successive filtering test, consider a case dealing with two superficially similar video games embodying a karate competition.[[899]](#footnote-900)264.61 Once the court had eliminated similarities resulting from idea, merger, and scenes a faire, the remaining similarities were insufficiently substantial to warrant the district court’s finding of infringement.[[900]](#footnote-901)264.62 Holding that the only proper approach is to limit plaintiff’s “copyright protection to the author’s contribution,” the Court of Appeals reversed.[[901]](#footnote-902)264.63 Later, the Ninth Circuit reversed a plaintiff’s verdict based on jury instructions that invited scrutiny of works as a whole rather than of the small amount of protectible material.[[902]](#footnote-903)264.64 It subsequently approved jury instructions that appropriately identified the unprotectible elements of plaintiff’s work, while allowing the jury to inspect the work as a whole.[[903]](#footnote-904)264.64a

1. ***Summary Judgment.***

With all these refinements, where does Ninth Circuit law stand on the question, confronted above, whether there can be defense summary judgments based on purported absence of substantial similarity?[[904]](#footnote-905)264.65 Starting with *Krofft*,[[905]](#footnote-906)264.66 it seemed that such efforts were doomed.[[906]](#footnote-907)264.67 But in later upholding summary judgment for a defendant, the Ninth Circuit held that *Krofft* did not hold that “summary judgment is always inappropriate on the issue of substantial similarity of expression if there is a substantial similarity of ideas. … Summary judgment is proper if reasonable minds could not differ as to the presence or absence of substantial similarity of expression.”[[907]](#footnote-908)264.68

Next, as has already been noted, *Shaw v. Lindheim*, seemed to be the death knell in the Ninth Circuit for defense summary judgments based on purported absence of substantial similarity.[[908]](#footnote-909)264.69 But that risk was averted. In *Olson v. National Broadcasting Company*,[[909]](#footnote-910)264.70 for instance, the Ninth Circuit denied that any similarity existed under the extrinsic test, notwithstanding that both plaintiff’s and defendant’s works dealt with a trio of Vietnam veterans practicing scams and having adventures in the present upon their return to civilian life, that some plot similarities existed between the two, and that a jury found in plaintiff’s favor.[[910]](#footnote-911)264.71 Subsequent to *Shaw*, courts in the Ninth Circuit frequently have approved defense summary judgments.[[911]](#footnote-912)264.72 Indeed, *Shaw* itself on remand is illustrative—the district court rejected the jury’s verdict and ruled for defendant as a matter of law.[[912]](#footnote-913)264.73 Accordingly, it seemed that defense summary judgments for lack of substantial similarity remained alive and well in the Ninth Circuit.[[913]](#footnote-914)264.74

Based on that state of affairs, the district court in *Swirsky v. Carey* held that copying a few inconsequential measures of music could not give rise to infringement liability.[[914]](#footnote-915)264.75 Then the Ninth Circuit reversed:[[915]](#footnote-916)264.76

So long as the plaintiff can demonstrate, through expert testimony that addresses some or all of [the musically copyrightable] elements[[916]](#footnote-917)264.77 and supports its employment of them, that the similarity was “substantial” and to “protected elements” of the copyrighted work, the extrinsic test is satisfied. Swirsky has met that standard here.[[917]](#footnote-918)264.78

Taking that finding at face value, any plaintiff who can retain a testifying expert[[918]](#footnote-919)264.79 will avoid an adverse summary judgment.[[919]](#footnote-920)264.80 But if the history of Ninth Circuit jurisprudence under the audience test is any guide, face value will not prevail, and yet a new exegesis will arise here, too, validating defense summary judgments even in the face of expert support.[[920]](#footnote-921)264.81 Certainly, the Ninth Circuit continues to affirm defense summary judgments based on absence of substantial similarity.[[921]](#footnote-922)264.82 That phenomenon, of course, continues to co-exist, on other occasions, with reversals in that posture.[[922]](#footnote-923)264.83

In one case, plaintiff claimed protection over scented wax warmers featuring the Hopi fertility deity Kokopelli.[[923]](#footnote-924)264.84 Apart from their similar overall color and leathered look, the rival warmers were different; they also portrayed the humpbacked flute player differently. The district court denied liability.[[924]](#footnote-925)264.85 The Ninth Circuit reversed in an unpublished opinion, remanding the question of substantial similarity for jury consideration.[[925]](#footnote-926)265

1. ***Theme, Mood, Setting, Pace* … .**

The Ninth Circuit later modified its application of *Krofft*’s extrinsic test. *Litchfield v. Spielberg*[[926]](#footnote-927)265.1 held that the analysis “requires a comparison of plot, theme, dialogue, mood, setting, pace and sequence.”[[927]](#footnote-928)265.2 At least in its reference to plot, dialogue, and sequence, this articulation would appear to go beyond a comparison of mere ideas and enter the sphere of expression.[[928]](#footnote-929)265.3 It may be that *Litchfield* intended a preliminary comparison of both protectible and nonprotectible material as required under *Arnstein*.[[929]](#footnote-930)265.4 But, if *Litchfield* correctly modified the *Krofft* extrinsic test, it would appear to have improperly applied its intrinsic test: “To constitute infringement of expression, the total concept and feel of the works must be substantially similar.”[[930]](#footnote-931)265.5

Many courts now follow *Litchfield*’s lead—notably the Ninth Circuit itself and district courts within its domain,[[931]](#footnote-932)265.6 but also other circuits as well.[[932]](#footnote-933)265.7 These authorities analyze the plot, theme, characters, dialogue, mood, setting, pace, and sequence of the works in question—sometimes to rule that plaintiff’s case survives summary judgment,[[933]](#footnote-934)265.8 but more typically to rule for the defense.[[934]](#footnote-935)265.9 For instance, both works in one case featured as protagonist an embittered “American war veteran who travels to Japan where he meets the Emperor, trains the Imperial Army in modern warfare, fights against the samurai, and in the end is spiritually restored. Both works are set at the time of the Satsuma Rebellion of 1877; both works rely heavily on the historical figure Saigo Takamori; and both works share the same title,” *The Last Samurai*.[[935]](#footnote-936)265.10 The Ninth Circuit nonetheless canvassed the differences in plot and sequence, characters, theme, setting, mood, pace, and dialogue to hold that dissimilarities predominated, and thereupon to affirm summary judgment for the defense on the charge of copyright infringement.[[936]](#footnote-937)265.11 (Nonetheless, the same opinion ruled those similarities substantial for purposes of an implied contract claim under California law.)[[937]](#footnote-938)265.12

A district court within the Ninth Circuit used this test to determine *Black-ish* non-infringing of plaintiff’s script, even though both dealt with “African-American families living in predominantly white areas,”[[938]](#footnote-939)265.12a given the only similarity in theme being “acting black”[[939]](#footnote-940)265.12b and vast differences in characters between the rival properties.[[940]](#footnote-941)265.12c The same result emerged in a case decided across the country at the same time, denying that *Power* infringed plaintiff’s script, even though both dealt with “an African-American protagonist who deals drugs and engages in violence,” given that this “story line is extremely common in television and movies.”[[941]](#footnote-942)265.12d The latter case, however, did not need to run through the Ninth Circuit’s recitation of “theme, mood,” and the rest, instead rooting its determination in the works’ different “total concept and feel.”[[942]](#footnote-943)265.12e

One can take a further step backward and question the basis on which *Litchfield* and its progeny single out the specific elements of plot, theme, characters, dialogue, mood, setting, pace, and sequence of the works.[[943]](#footnote-944)265.12f Obviously, the test is designed for novels and movies (which feature plot, characters, dialogue, pace, *etc*.) but almost completely inapplicable to paintings (which have very few of the listed elements) and musical works (which have sequence and mood). Thus, this particular formulation applies only to a subset of copyrightable works.

Moreover, even as limited to novels and movies, the enumeration of elements is questionable. Characters can themselves be copyrightable, as can dialog. But mood, setting, and pace would not seem able, standing alone, to attract protection. Of course, plot is the essence of a literary work, and sequence of events would seem to be subsumed within plot. In many instances, plot justly forms the essence of the inquiry. Thus, the discussion above concludes that *West Side Story* is substantially similar to *Romeo and Juliet*, based on their similar plot points (which can be phrased as their sequence as well).[[944]](#footnote-945)265.13 The characters are also, of necessity, comparable in those two works. But the dialogue differs vastly, as does the setting. Even if the two had different moods and pacings, the plot similarity alone could lead to liability. From the opposite perspective, absent similarity in plot line (the sequence of the works), the fact that their mood, setting,[[945]](#footnote-946)265.13a and pace were comparable typically should not lead to liability.[[946]](#footnote-947)265.14 One case made the point explicit by holding general themes, although the same in plaintiff’s and defendant’s works, not copyrightable.[[947]](#footnote-948)265.15 The same applies to an identical setting, when that setting naturally arise from the common subject matter of both plaintiff’s and defendant’s works—as one case ruled,[[948]](#footnote-949)265.15a nobody has “an exclusive right to make a ‘docu-fiction’[[949]](#footnote-950)265.15b about dirt-bike riding”[[950]](#footnote-951)265.15c and to place the story at the same intersection in Baltimore where the sport actually developed.[[951]](#footnote-952)265.15d Even an identical theme to plaintiff’s work should not cause defendant to lose its case.[[952]](#footnote-953)265.16 In sum, the *Litchfield* enumeration would seem of only limited utility in determining the existence of substantial similarity—notwithstanding that opinions defer to it as if it formed part of the Copyright Act itself.

1. ***The Triumph of Illogic.***

Notwithstanding the hope expressed above that the Ninth Circuit would turn away from the more unfortunate aspects of *Krofft*,[[953]](#footnote-954)265.17 a 2016 case beatified that case’s worst aspects—with full knowledge of their weak footing and deleterious results. In *Antonick v. Electronic Arts, Inc.*, the programmer of the computer code for *John Madden Football* filed suit against the company that produced this “incredibly lucrative” video game.[[954]](#footnote-955)265.18 Although the diversity action sounded in breach of contract, the parties’ agreement defined their obligations by reference to derivative works[[955]](#footnote-956)265.19 “within the meaning of the United States copyright law,” meaning plaintiff effectively had to prove violations of his rights under the Copyright Act.[[956]](#footnote-957)265.20 A jury ruled in his favor that EA sold derivative works based on Antonick’s code.[[957]](#footnote-958)265.21 But the district judge threw out the verdict, holding that he “had not provided sufficient evidence of copyright infringement,” based on the absence in the record of the *source code* for the two works in question.[[958]](#footnote-959)265.22

On appeal, Antonick relied principally on the expert testimony of Michael Barr, an experienced computer programmer who laboriously compared the implicated binary code and source code of the two underlying works in order to present these complex issues intelligibly to a lay jury.[[959]](#footnote-960)265.23 At oral argument, the Ninth Circuit judges focused on whether that expert testimony is admissible. Although the pre-computer age *Krofft* opinion expressed hostility to expert testimony, the law across the circuits is uniformly to the contrary in the context of computer copyright infringement.[[960]](#footnote-961)265.24 Judge Hurwitz explicitly recognized how inapposite that 1909 Act case is to the current situation, stating that “I think that’s a nutty rule.”[[961]](#footnote-962)265.25 Yet, when it came time to craft the opinion, Judge Hurwitz adopted the view he had disparaged, relegating the whole issue to a footnote:

Antonick is not alone in contending that experts should be allowed to help juries assess the holistic similarity of technical works such as computer programs. But, given our precedents, that argument must be addressed to an en banc court.[[962]](#footnote-963)265.26

The Ninth Circuit accordingly affirmed rejection of the jury verdict. When it came time for *en banc* review, Judge Hurwitz and the other members of the panel voted in opposition, and the Supreme Court declined to resolve the circuit split. Thus did the admitted “nutty rule” become enshrined as circuit precedent.[[963]](#footnote-964)265.26a

The question thus arises whether it is justifiable to require (as did the panel in this case) that the jury be given rival source code for two highly complex pieces of computer code, in order to compare them pursuant to the traditional “audience test” or whether, by contrast, the rule should be that expert testimony along those lines suffices. For reasons of logic, statutory structure, and precedent, it is respectfully submitted that the panel erred.

Starting from the perspective of common sense, let us imagine that someone translated *Harry Potter and the Philosopher’s Stone* into Japanese without authorization, to which the publisher responded by suing for copyright infringement.[[964]](#footnote-965)265.27 Under the rule of *Antonick* woodenly following *Krofft*, the two works must be introduced into evidence for the jury to compare them—notwithstanding the absence of any overlap whatsoever, given the dissimilarities of Kanji and English characters.[[965]](#footnote-966)265.28 The holding of this case is that the proprietor would not be able to call a bilingual translator to testify about that overlap. Given that there would be no basis for a jury to assess substantial similarity, that result fully deserves the epithet “nutty” that the authoring judge recognized. Of course, the task is even more absurd in the actual case than in this hypothetical—conceivably, a member of the jury might read Japanese. But it is essentially impossible that a member of the 2013 jury[[966]](#footnote-967)265.29 would be able to decipher archaic source code that Antonick used in 1989 to code *John Madden Football* and also be able to decipher a different archaic source code used in 1996 when EA revised it,[[967]](#footnote-968)265.30 so as to perform the requisite filtration, abstraction, and comparison of the two works to determine substantial similarity.[[968]](#footnote-969)265.31 Illogic permeates this result.

The structure of the Act further debunks the holding that the works themselves must be in evidence in order to permit appellate review of the jury’s verdict.[[969]](#footnote-970)265.32 At passage of the 1976 Act, camcorders were not yet in use—yet the Act made actionable unauthorized public performance of a play[[970]](#footnote-971)265.33 or public display of a photograph.[[971]](#footnote-972)265.34 Obviously, Congress could not have expected that copyright owners whose rights were violated would have to await the invention of those camcorders to prove their cases—instead, testimony suffices about the content of an evanescent performance or display that is putatively infringing. In other words, the copyright owner of a play can bring witnesses to testify about the content of a rival play that was staged in X theater on Y date, or the copyright owner of a photograph can testify that it was placed on display in W gallery on Z date. Those actions of necessity would have to proceed to verdict without the two rival works being in evidence. Instead, the appellate court reviews the evidence presented to the jury to determine whether it is adequate to sustain an infringement verdict. The factfinder can rely on the full panoply of admissible evidence to prove infringement—no pre-existing rule demands that both plaintiff’s and defendant’s work inexorably have to be introduced into evidence.[[972]](#footnote-973)265.35

Precedent is to the same effect—including that of the Ninth Circuit. As pointed out to the *Antonick* panel,[[973]](#footnote-974)265.36 that court, only a few years earlier, sustained a judgment of copyright infringement in plaintiff’s favor based only on *testimony* about the content of defendant’s public performance—without the subject work itself being tendered into evidence.[[974]](#footnote-975)265.37 For all these reasons, *Antonick*’s doubling-down on *Krofft* represents an unnecessary and unfortunate elevation of the “audience test” in Ninth Circuit jurisprudence.

Happily, other courts are not so rigid.[[975]](#footnote-976)265.38 The Eighth Circuit distinguished *Antonick* in sustaining an award of over $11 million to a plaintiff who failed to place into evidence the entirety of the protected work.[[976]](#footnote-977)265.39 It ruled that defendant’s spoliation[[977]](#footnote-978)265.40 in destroying its own rival work obviated any need for side-by-side comparison.[[978]](#footnote-979)265.41 That logic is impeccable—there is no basis to require a plaintiff to submit the entirety of a massive work that would not benefit the factfinder.[[979]](#footnote-980)265.42 Of course, that consideration is congruent with the critique set forth above, namely that plaintiff Antonick should not have been required to put into evidence archaic source code that the factfinder would have been unable to decipher.

1. ***The Eleventh Circuit’s Move Towards Unity.***

In *Herzog v. Castle Rock Entertainment*,[[980]](#footnote-981)266 the Eleventh Circuit aligned itself with *Krofft’s* two-pronged test.[[981]](#footnote-982)267 A decade later, that court returned to the issue in the context of an architectural case involving two high-rise condominium projects. *Oravec v. Sunny Isles Luxury Ventures, L.C.*[[982]](#footnote-983)268 termed that aspect of *Herzog* “something of an anomaly in our copyright jurisprudence” and further pronounced the *Herzog* formulation “not useful in this case because the two tests ultimately merge into a single inquiry: whether a reasonable jury could find the competing designs substantially similar at the level of protected expression.”[[983]](#footnote-984)268.1

*Oravec’s* formulation comports with *Feist*,[[984]](#footnote-985)268.2 at the same time that it dispenses with the type of pre-*Feist* dichotomies previously developed in the Second[[985]](#footnote-986)268.3 and Ninth[[986]](#footnote-987)268.4 Circuits. It has the virtue of focusing the fact-finder on the true elements of copyright infringement, rather than on how the situation might strike an untutored viewer.

Another Eleventh Circuit architectural case, arising several months later, pushed the matter even further.[[987]](#footnote-988)268.5 In comparing floorplans, the court built on its *Oravec* ruling to note that

in examining compilations wherein only the arrangement and coordination of elements which by the nature of the work (here architectural floor plans) are sure to be common to each of the works and are not copyrightable themselves (spacial [sic] depictions of rooms, doors, windows, walls, etc.), the already difficult tasks may become even more nuanced. Because a judge will more readily understand that all copying is not infringement, particularly in the context of works that are compilations, the “substantial-similarity” test is more often correctly administered by a judge rather than a jury—even one provided proper instruction. The reason for this is plain—the ability to separate protectable expression from non-protectable expression is, in reality, a question of law or, at the very least, a mixed question of law and fact. It is difficult for a juror, even properly instructed, to conclude, after looking at two works, that there is no infringement where, say, 90% of one is a copy of the other, but only 15% of the work is protectable expression that has not been copied.[[988]](#footnote-989)268.6

That formulation occurred in the context of approving the district court’s entry of summary judgment for defendant, the same posture as in *Oravec*.[[989]](#footnote-990)268.7 Thus, this pair of cases not only rejects any categorical refusal to grant defense summary judgment on the basis of lack of substantial similarity,[[990]](#footnote-991)268.8 but goes further to cast doubt on the audience formulation generally—and even on submission to the jury in a close case.[[991]](#footnote-992)268.9 Whether subsequent cases will actually so rule remains to be seen.

One more case from the Eleventh Circuit likewise warrants mention. In *Corwin v. Walt Disney Co.*,[[992]](#footnote-993)268.10 plaintiff sought to introduce four expert reports purporting to show that Disney purloined its design for Epcot Center from plaintiff’s testator. Because those experts relied on uncopyrightable ideas or scenes a faire,[[993]](#footnote-994)268.11 Judge Birch[[994]](#footnote-995)268.12 affirmed the district court’s exclusion of each report.[[995]](#footnote-996)268.13

1. ***Other Circuits.***

Even after *Feist*, the audience test continues to be characterized across the various circuits as the governing standard to determine[[996]](#footnote-997)268.14 substantial similarity.[[997]](#footnote-998)268.15 Some courts prefer the *Arnstein* formulation of the Second Circuit,[[998]](#footnote-999)268.16 others the variant proposed in the Ninth Circuit.[[999]](#footnote-1000)268.17 The Eighth Circuit, for example, has allied itself with the latter point of view.[[1000]](#footnote-1001)268.18 Yet even so, a case there accepted expert testimony to affirm summary judgment in favor of a defendant accused of copying a motion picture theme song,[[1001]](#footnote-1002)268.19 notwithstanding the dissent’s objection that that expert testimony related solely to the intrinsic test.[[1002]](#footnote-1003)268.20 But it has also reversed a jury verdict in favor of defendant, tainted by an architectural expert’s opinion that substantial similarity was lacking.[[1003]](#footnote-1004)268.21 The Fourth Circuit has clarified that the same extrinsic/intrinsic text determines substantial similarity for architectural works as applies to other works generally.[[1004]](#footnote-1005)268.21a

Some circuits seem to prefer a mélange of the two approaches.[[1005]](#footnote-1006)268.22 The Sixth Circuit,[[1006]](#footnote-1007)268.23 following the D.C. Circuit,[[1007]](#footnote-1008)268.24 calls its modified approach “more similar to the Ninth Circuit[[1008]](#footnote-1009)268.25 test than it is to the Second Circuit test.”[[1009]](#footnote-1010)268.26 The First Circuit, although maintaining nominal fidelity to the “ordinary listener” in the case of a musical infringement claim,[[1010]](#footnote-1011)268.27 simultaneously approves the routine use of experts in those circumstances.[[1011]](#footnote-1012)268.28

The Fourth Circuit, also in the context of a music case, declined to rule whether, in accordance with the Ninth Circuit’s ruling in *Shaw v. Lindheim*,[[1012]](#footnote-1013)268.28a “intrinsic similarity is a question reserved for the trier of fact, and only the extrinsic similarity prong can be grounds for dismissal at the summary judgment and pleading stages.”[[1013]](#footnote-1014)268.28b It clarified that, under its view, analytic dissection is inapplicable to the intrinsic analysis.[[1014]](#footnote-1015)268.28c Although plaintiff in that case had lost below,[[1015]](#footnote-1016)268.28d the court of appeals reversed.[[1016]](#footnote-1017)268.28e Listening to the two songs from start to finish,[[1017]](#footnote-1018)268.28f it refused to accept the conclusion below that they were significantly different in “aesthetic appeal.”[[1018]](#footnote-1019)268.28g Granted, two features favored defendants—(a) one song was in the rhythm and blues genre whereas the other was electronica[[1019]](#footnote-1020)268.28h—but that difference was deemed not dispositive.[[1020]](#footnote-1021)268.28i In addition, (b) the songs were, for the most part, dissimilar.[[1021]](#footnote-1022)268.28j But those features could not overweigh the points of commonality that did exist in the chorus or “hook.”[[1022]](#footnote-1023)268.28k

We hear the kind of meaningful overlap on which a reasonable jury could rest a finding of substantial similarity. It is not simply that both choruses contain the lyric “somebody to love”; it is that the lyric is delivered in what seems to be an almost identical rhythm and a strikingly similar melody. To us, it sounds as though there are a couple of points in the respective chorus melodies where the [defendants’] songs go up a note and the [plaintiff’s] song goes down a note, or vice versa. In our view, however, a reasonable jury could find that these small variations would not prevent a member of the general public from hearing substantial similarity.[[1023]](#footnote-1024)268.28l

The opinion further concluded that the choruses of the two songs were sufficiently important to their overall effect as to constitute a valid basis for finding intrinsic similarity.[[1024]](#footnote-1025)268.28m On that basis, it vacated the judgment for defendants and remanded the case for a jury to consider.[[1025]](#footnote-1026)268.28n

Given the profusion of potential formulations, the question arises as to their operative differences. One case effectively offers a “test suite” by articulating a whole variety of standards and then applying each.[[1026]](#footnote-1027)268.28o Its comprehensive opinion confronts plaintiff’s claim that 63 songs by dozens of defendants infringed his rights in 45 musical compositions.[[1027]](#footnote-1028)268.28p Using “every possible analysis,”[[1028]](#footnote-1029)268.28q it reached the same conclusion under any of the multiples tests.[[1029]](#footnote-1030)268.28r Specifically, it found substantial similarity lacking as to almost all plaintiff’s work, but present in three instances.[[1030]](#footnote-1031)268.28s In only a single specific did any of the variant tests produce an inconsistent finding.[[1031]](#footnote-1032)268.28t That ruling may intimate that the diverse formulations in this field are more cosmetic than substantive, in terms of actual results. Indeed, one empirical investigation reaches exactly that conclusion: “Despite the confusion engendered by the tests and the criticism launched against them, this study suggests that their differences are inconsequential. No test is superior.”[[1032]](#footnote-1033)268.28u

It has been noted above that “it is hardly reasonable to expect laymen to attempt … without dissection, at least to delineate that portion of the plaintiff’s work that is protectible.”[[1033]](#footnote-1034)268.29 Many opinions, relying on that sensibility, twist *Krofft* into a posture compatible with the following finding of absence of similarity as a matter of law.

An alleged infringing work taken as a whole may seem “substantially similar” to the copyrighted work taken as whole, but the impression of similarity may rest heavily upon similarities in the two works as to elements that are not copyrightable—because those elements are the underlying ideas, or expressions that are not original with the plaintiff, or for some like reason.[[1034]](#footnote-1035)268.30

1. **The Challenge of Technology.**

A special challenge[[1035]](#footnote-1036)268.30a is posed in adjusting the traditional categories of substantial similarity to the burgeoning areas of technology protected by copyright.[[1036]](#footnote-1037)268.31 For instance, the previous subsection has demonstrated the weaknesses of the audience test as applied generally to copyrighted works; as applied to computer programs,[[1037]](#footnote-1038)268.32 that test is not only weak, but facially inapplicable. For plainly, it is meaningless to attempt to isolate the “spontaneous and immediate” reaction of the lay observer to two sets of object code.[[1038]](#footnote-1039)268.33

Some courts, acknowledging the charade inherent in applying the audience test to such works of high technology, have forthrightly abandoned the pretense of applying the two-step analysis envisioned by the audience test.[[1039]](#footnote-1040)268.34 These courts do not hesitate to admit expert testimony[[1040]](#footnote-1041)268.35 on the key issue of similarity[[1041]](#footnote-1042)268.36 between computer programs.[[1042]](#footnote-1043)269 Other courts have felt constrained to apply the audience test to computer programs, notwithstanding its admitted limitations in that field.[[1043]](#footnote-1044)270

The Second Circuit, noting that *Arnstein* “may well have served its purpose when the material under scrutiny was limited to art forms readily comprehensible and generally familiar to the average lay person,” declined to extend it to a case involving computer programs.[[1044]](#footnote-1045)270.1 Instead, the court granted discretion to the district courts “to decide to what extent, if any, expert opinion, regarding the highly technical nature of computer programs, is warranted in a given case.”[[1045]](#footnote-1046)270.2 Nonetheless, the court took pains to note that its holding was not intended “to disturb the traditional role of lay observers in judging substantial similarity in copyright cases that involve the aesthetic arts, such as music, visual works or literature.”[[1046]](#footnote-1047)270.3

One court, acutely conscious of the difficulties inherent in seeking the “ordinary observer’s” reaction to computer software, has resolved the dilemma not by discarding the audience test, but by refocusing it.[[1047]](#footnote-1048)270.4 Retaining the two-step approach discussed above,[[1048]](#footnote-1049)270.5 this case holds that “the second prong of the substantial similarity inquiry … must consider the intended audience of the plaintiff’s work.”[[1049]](#footnote-1050)270.6 Therefore, the court discussed the utility of having children’s toys judged by a juvenile standard, software by the computer literate, and musical arrangements by choral directors. Nonetheless, the court recognized that the exception could swallow the rule, if the second prong disallowed expert testimony only to be geared at a narrow audience of experts in the subject category into which the work at issue fell. Therefore, the court concluded that “in our opinion, departure from the lay characterization is warranted only where the intended audience possesses ‘specialized expertise.’ ”[[1050]](#footnote-1051)270.7 Given that this case actually arose in a dispute over the traditional copyright category of musical works,[[1051]](#footnote-1052)270.8 rather than the newer species of technology, it is unclear that its reformulation is anything more than *dictum*.[[1052]](#footnote-1053)270.9

Often, courts hold tutorials on technological works, to ground the judge (and clerks) in the essence of the case. Typically, those tutorials are informal and off the record, “which is understandable, as a principal benefit of a tutorial is the opportunity for informal exchange.”[[1053]](#footnote-1054)270.10 Nonetheless, in the context of a dispute over mask works,[[1054]](#footnote-1055)270.11 Judge Rymer has urged “judges and litigants to consider the possibility of videotaping the tutorial for whatever assistance it may be to the court of appeals.”[[1055]](#footnote-1056)270.12

1. **The Successive Filtering Method to Determine Substantial Similarity of Computer Programs**

1. **Initial Considerations**

1. ***Difficulties in Proof.***

In many software infringement cases, access is either conceded or easily proved, or perhaps even copying itself is conceded,[[1056]](#footnote-1057)270.13 so that a finding of infringement turns entirely on whether the works are substantially (*i.e.,* “actionably”)[[1057]](#footnote-1058)270.14 similar.[[1058]](#footnote-1059)270.15 This situation applies particularly to the area of popular microcomputer software packages: Copies of most such programs are readily available in retail stores, and techniques exist for analyzing such programs to ascertain their underlying structure and possibly to reconstruct some of their original code.[[1059]](#footnote-1060)271 Moreover, because innovations in the microcomputer software industry typically consist of extensions of, or variations on, existing ideas, developers of most software packages are generally familiar with the function, and possibly the design, of their competitor’s programs.[[1060]](#footnote-1061)272 Given such obvious access, computer software infringement actions almost invariably collapse into an inquiry into substantial similarity.

Unfortunately, because computer programs tend to be incomprehensible to a lay judge or jury, evaluating the similarity between two computer programs is often exceedingly difficult.[[1061]](#footnote-1062)273 Such difficulties are particularly applicable when the allegations of infringement go beyond mere literal copying of the program code[[1062]](#footnote-1063)274 to claims that the organization and structure of plaintiff’s program have been copied, thereby forcing the trier of fact to understand the design, structure, and function of both programs.[[1063]](#footnote-1064)275

The difficulties in applying the traditional substantial similarity test to computer programs are exacerbated by the fact that computer programming is as much a science as an art. Authors of computer programs do not always have the broad range of choices of expression available to authors of traditional literary works. External factors, such as the computer on which the program is to run, the other software with which the program must interact, and the nature of the problem to be solved dictate many aspects of a program’s design, structure, or actual code. In addition, an extensive body of computer science literature, rather than the individual programmers’ creativity, provides numerous common programming techniques found in a wide variety of programs.

The nature of the software industry itself also may contribute to the difficulty of assessing whether one program infringes another. In many areas of the computer software market, programs are intended to compete directly with each other and perform the same task in much the same way.[[1064]](#footnote-1065)276 Thus, even two programs that have been created independently may appear similar in many respects.[[1065]](#footnote-1066)277 Accordingly, analyzing the substantial similarity of computer programs is especially challenging. The following considerations, geared particularly to the software context,[[1066]](#footnote-1067)278 are offered as a tool for that analysis.[[1067]](#footnote-1068)279

1. ***Focus on Protectable Expression.***

The crucial consideration in the analysis that follows is that copyright law protects only an author’s original expression, not ideas or elements taken from pre-existing works.[[1068]](#footnote-1069)280 Infringement is shown by a substantial similarity of *protectible expression*,[[1069]](#footnote-1070)280.1 not just an overall similarity between the works.[[1070]](#footnote-1071)281 Thus, before evaluating substantial similarity, it is necessary to eliminate from consideration those elements of a program[[1071]](#footnote-1072)282 that are not protected by copyright.[[1072]](#footnote-1073)283

1. **Altai *and Golden Nuggets.***

To accomplish this task, an allegedly infringed program should be analyzed on several different levels.[[1073]](#footnote-1074)283.1 A different copyright doctrine is applied at each level, and material that is unprotected under that doctrine is excluded from further consideration in analyzing substantial similarity. By successively filtering out unprotected material, a core of protected material remains, against which the court can compare the allegedly infringing program.

In *Computer Associates International, Inc. v. Altai, Inc.*,[[1074]](#footnote-1075)283.2 the Second Circuit adopted essentially the successive filtration approach proposed herein.[[1075]](#footnote-1076)283.3 More specifically, *Altai* divides the process into three steps: abstraction of the plaintiff’s program, filtration out of nonprotectible elements found therein, and comparison between the remaining “golden nugget”[[1076]](#footnote-1077)283.4 and defendant’s work.[[1077]](#footnote-1078)283.5 Other courts have “subsequently”[[1078]](#footnote-1079)283.6 followed[[1079]](#footnote-1080)283.7 *Altai*’s lead,[[1080]](#footnote-1081)283.8 so that this filtra-tion test may now be regarded as the dominant,[[1081]](#footnote-1082)283.9 albeit not universal, standard.[[1082]](#footnote-1083)283.10 It bears noting, moreover, that those courts have reached rulings both in favor of plaintiffs[[1083]](#footnote-1084)283.11 and for the defense,[[1084]](#footnote-1085)283.11a demonstrating that the successive filtering analysis is designed as a neutral test, favoring neither copyright owners nor alleged infringers.

1. ***Scope of Application.***

Even when applicable, the entire test need not be applied in every instance; the Tenth Circuit has recognized that full-blown analysis may not be indicated for a case involving “the admitted literal copying of a discrete, easily-conceptualized portion of a work.”[[1085]](#footnote-1086)283.12 But it later distinguished that holding to require full abstraction/filtration/comparison absent admitted copying of a literal portion that is easy to grasp.[[1086]](#footnote-1087)283.13 In the interim, that court also characterized a post-*Feist* telephone directory case from the Second Circuit as articulating “a distillation into fewer words of the abstraction-filtration-comparison text.”[[1087]](#footnote-1088)283.14 More recently, it approved filtration in the context of a dispute over rival architectural plans.[[1088]](#footnote-1089)283.15

For a brief moment, the matter seemed poised for adjudication before the Supreme Court.[[1089]](#footnote-1090)283.16 The moment passed, however, with no guidance from that tribunal.[[1090]](#footnote-1091)283.17 The final word on this standard accordingly still remains to be pronounced.

Although the discussion in this subsection illustrates application of the filtration test solely in the context of computer software, there is no reason to limit[[1091]](#footnote-1092)283.18 it to that realm.[[1092]](#footnote-1093)283.19 Indeed, given its congruence with the approach followed by the United States Supreme Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*,[[1093]](#footnote-1094)283.20 a previous subsection offers this approach as a general alternative to the audience test.[[1094]](#footnote-1095)283.21 Cases have applied it to allegations of both literal[[1095]](#footnote-1096)283.22 and non-literal copying.[[1096]](#footnote-1097)284 Indeed, the Ninth Circuit even applied it to juvenile imagery,[[1097]](#footnote-1098)284.1 the precise realm where that court had previously invented the most unanalytic of standards.[[1098]](#footnote-1099)284.2

1. ***General Inapplicability to Output.***

One more preliminary observation: The discussion that follows deals with comparison of rival computer programs. Sometimes, by contrast, the question arises whether the defendant’s usage of output from plaintiff’s computer program constitutes infringement of the copyright in that program.[[1099]](#footnote-1100)284.3 The question in turn arises whether that output is itself copyrightable.[[1100]](#footnote-1101)284.4 If the defendant, as the user of the program, must add primarily her own creativity to produce the output, it may be doubted whether an infringement action would lie—witness “computer art programs, which permit an end-user to create an original work of art in an electronic medium.”[[1101]](#footnote-1102)284.5 But if, by contrast, the software itself “does the lion’s share of the work” and defendant’s role is “marginal,”[[1102]](#footnote-1103)284.6 then the output might reflect the contents of the program.[[1103]](#footnote-1104)284.7 In that instance, the test proposed below should be applicable.[[1104]](#footnote-1105)284.8

In one case, plaintiff filed for both patent and copyright infringement arising out of its program “for capturing the motion of the human face to create images used in motion pictures.”[[1105]](#footnote-1106)284.9 Invoking the above language, defendants maintained with respect to their major motion pictures (*Terminator* and *Deadpool* among them) that “the actors’ Human contribution to the expressive components of the output file is substantial and performs the ‘lion’s share of the creativity’ in the facial motion capture … .”[[1106]](#footnote-1107)284.10 Agreeing, the court dismissed the copyright claim.[[1107]](#footnote-1108)284.11

1. **Excluding Program Elements at a High Level**

1. ***Those that Constitute Only Abstract Ideas.***

We have already seen that only expressions of ideas, and not the ideas themselves, are entitled to copyright protection.[[1108]](#footnote-1109)285 Thus, one step in the analysis is to separate unprotectible ideas from protectible expression. This distinction is particularly important in the field of computer science, where growth and development depend on free access to existing ideas.[[1109]](#footnote-1110)286 Computer programmers’ authorship is constrained by the limitations of the machines on which their programs are to run and the formalities of the programming language they have chosen. These limitations, combined with the complex tasks of data management and control flow inherent in computer programming, have led many programmers to adopt a “structured” or “top-down” approach to computer programming. A programmer starts with very general ideas of what the program is to accomplish, and moves in steps toward the ultimate goal of producing specific code that can operate the computer correctly.[[1110]](#footnote-1111)287

In practice, a programmer usually will start with a general description of the function that the program is to perform. Then, a specific outline of the approach to this problem is developed, usually by studying the needs of the end user. Next, the programmer begins to develop the outlines of the program itself, and the data structures[[1111]](#footnote-1112)288 and algorithms[[1112]](#footnote-1113)289 to be used. At this stage, flowcharts,[[1113]](#footnote-1114)289.1 pseudo-code,[[1114]](#footnote-1115)290 and other symbolic representations often are used to help the programmer organize the program’s structure. The programmer will then break down the problem into modules or subroutines, each of which addresses a particular element of the overall programming problem, and that itself may be broken down into further modules and subroutines. Finally, the programmer writes specific source code to perform the function of each module or subroutine, as well as to coordinate the interaction between modules or subroutines.[[1115]](#footnote-1116)291 That source code could, in some instances, implement a distinctive user interface.[[1116]](#footnote-1117)291.1

In many ways, the process capsulized above mirrors the analysis used in Judge Hand’s famous abstractions test.[[1117]](#footnote-1118)292 Although the abstractions test was created for use with literary works, it is readily adaptable to analyzing computer software.[[1118]](#footnote-1119)292.1 At the start of the process, the programmer has only a general notion of what the program is supposed to do and of possibly which algorithms would be desirable—material that falls within the realm of unprotectible ideas. When the program is completed, the programmer will have produced code that will likely constitute protectible expression. At some point between these extremes, the level of specificity is sufficient to cross the line between idea and expression.[[1119]](#footnote-1120)292.2 It may be useful alternatively to define the boundaries as representing, respectively, process and expression.[[1120]](#footnote-1121)292.3

The systematic method used to develop computer programs makes the abstractions test facially more applicable to computer software than to other types of works. Traditional literary works are not created in such a consistently organized and orderly fashion. In many cases, an author may produce portions of a work in nearly final form at one sitting, without extensive preparation or development. Thus, a court applying the abstractions test to a literary work needs to break the work down into decreasing levels of complexity, a task that can be difficult when the only material available is the finished piece itself. In contrast, the development process of computer programs often provides natural divisions, that may correspond to the various levels of abstraction that the court seeks to identify and analyze.[[1121]](#footnote-1122)293

Unfortunately, even in the realm of computer software, the abstractions test is not easy to apply.[[1122]](#footnote-1123)294 Nonetheless, applying this test conscientiously and systematically[[1123]](#footnote-1124)294.1 can help a court separate ideas from expression and eliminate from the substantial similarity analysis those portions of a work that are not eligible for copyright protection.[[1124]](#footnote-1125)295

The pitfalls of abandoning the abstractions test emerge in sharp focus from the Third Circuit’s opinion in *Whelan Associates v. Jaslow Dental Laboratory*.[[1125]](#footnote-1126)296 The *Whelan* court eschewed Judge Hand’s advice,[[1126]](#footnote-1127)297 and adopted a simplistic test for separating idea from expression in cases involving computer programs. According to the court, “the purpose or function of a utilitarian work would be the work’s idea, and everything that is not necessary to that purpose or function would be part of the expression of the idea.”[[1127]](#footnote-1128)298 Under this reasoning, the purpose and thus the “idea” of the program at issue in *Whelan* was “to aid in the business operations of a dental laboratory;” anything more specific was considered expression.[[1128]](#footnote-1129)299

The crucial flaw in this reasoning is that it assumes that only one “idea,” in copyright law terms, underlies any computer program, and that once a separable idea can be identified, everything else must be expression.[[1129]](#footnote-1130)300 All computer programs are intended to cause the computer to perform some function. The broad purpose that the program serves, be it managing a dental laboratory, automating a factory, or dispensing cash at a bank teller machine, is *an* idea. Other elements of the program’s structure and design, however, may also constitute ideas for copyright purposes.[[1130]](#footnote-1131)300.1

Judge Hand’s abstractions test implicitly recognizes that any given work may consist of a mixture of numerous ideas and expressions,[[1131]](#footnote-1132)300.2 ranging from the most general statement of “what the [work] is about,”[[1132]](#footnote-1133)301 to specific choices of words or program code. The intellectual exercise required by the abstractions test forces a court to consider all of the ideas that might underlie a computer program, and to ascertain the point at which they become sufficiently delineated to warrant copyright protection. This line is a pragmatic one, drawn not on the basis of some metaphysical property of “ideas,” but by balancing the need to protect the labors of authors with the desire to assure free access to ideas.[[1133]](#footnote-1134)301.1

Judicial acceptance of *Whelan*’s reasoning is shrinking, although at least one district court has embraced *Whelan* and rejected, without any substantial analysis, arguments that some elements of an alleged infringed program were unprotectible ideas.[[1134]](#footnote-1135)302 Another has tried to reformulate it, in a vain effort to save it from what it views as the “rather extreme alternative” of the *Altai* test, discussed below.[[1135]](#footnote-1136)302.1 On the other hand, the Third Circuit has declined to jettison it.[[1136]](#footnote-1137)302.2 By contrast, the Fifth Circuit has apparently rejected the test used in *Whelan*.[[1137]](#footnote-1138)303 Other courts have followed the Fifth Circuit’s lead.

In particular, the Second Circuit’s landmark decision in *Computer Associates International, Inc. v. Altai, Inc.*[[1138]](#footnote-1139)303.1 labels *Whelan*’s rationale suspect because it is so closely tied to what can now be seen—with the passage of time—as the opinion’s somewhat outdated appreciation of computer science.[[1139]](#footnote-1140)303.2 In *Altai,* plaintiff produced a resident server program that scheduled jobs in conjunction with a user’s operating system software.[[1140]](#footnote-1141)303.3 One component of that program, called Adapter, allowed both the program as a whole and other applications to be run on any one of three different operating systems used with IBM mainframe computers. Thus, invisible to the user, that software performed such chores as allocating processing time among several applications programs running simultaneously in a DOS/VSE environment, or providing memory blocks to an application program in a CMS environment.[[1141]](#footnote-1142)303.4

Defendant hired away one of plaintiff’s employees[[1142]](#footnote-1143)303.5 to develop a rival job scheduling program for mainframe computers. In violation of his signed agreement with plaintiff (but without defendant’s knowledge), that employee took with him the source code for Adapter, which he used to develop a common system interface component, called Oscar 3.4, for defendant’s rival software product.[[1143]](#footnote-1144)303.6 Approximately 30 percent of Oscar 3.4 was copied directly from Adapter.[[1144]](#footnote-1145)303.7 Upon learning of its wrongful provenance, defendant locked away the Adapter code; using untainted employees, defendant rewrote the 30 percent of copied code, and salvaged the rest of Oscar 3.4. The resulting product, Oscar 3.5, replaced its forbear and was shipped as a “free upgrade” to existing customers.[[1145]](#footnote-1146)303.8

The court readily found infringement as to Oscar 3.4, from which judgment defendant did not pursue an appeal.[[1146]](#footnote-1147)303.9 As to Oscar 3.5, the district court attributed such similarities as existed between it and Adapter to external factors, such as the programs’ functionality, and accordingly denied liability.[[1147]](#footnote-1148)303.10 The court of appeals agreed. After a disquisition on the idea-expression dichotomy, the court filtered out from plaintiff’s Adapter elements dictated by efficiency, by external factors, and taken from the public domain.[[1148]](#footnote-1149)303.11 The remaining core not being substantially similar to Oscar 3.5, the Second Circuit affirmed the defense judgment.[[1149]](#footnote-1150)303.12

The approach used in *Altai* is not a radical departure from previous jurisprudence.[[1150]](#footnote-1151)303.13 Moreover, inasmuch as other cases are now following *Altai*’s lead,[[1151]](#footnote-1152)303.14 this standard should at least be considered whenever analyzing substantial similarity between computer programs.

1. ***Those Dictated by Logic and Efficiency.***

Under the merger doctrine, when an idea can be expressed in only one fashion, that expression is not protected by copyright, as the result would be to provide a monopoly over the idea itself.[[1152]](#footnote-1153)304 In the realm of computer programs, merger issues may arise in somewhat unusual ways. Although, theoretically, many ways may exist to implement a particular idea, efficiency concerns can make one or two choices[[1153]](#footnote-1154)304.1 so compelling as to virtually eliminate any other form of expression.[[1154]](#footnote-1155)304.2 In such a case, applying the merger doctrine may dictate the conclusion that a particular way to implement an idea is unprotectible, and thus, should not be considered evidence of substantial similarity of protected expressions.[[1155]](#footnote-1156)305

Computer searching and sorting algorithms provide good examples of this phenomenon.[[1156]](#footnote-1157)305.1 Any computer system that deals with significant quantities of data will spend much of its operating time engaged in sorting and searching through that data. Because the amount of time spent on sorting and searching operations can significantly influence a program’s operating speed, efficient methods of sorting are highly desirable. A great deal of computer science research has been devoted to developing methods of sorting or searching through data, and to analyzing the relative efficiency of various methods. As a result of such research, it is now recognized that some methods of sorting or searching are significantly more efficient than others in handling particular types of data, even though any of numerous methods will work.[[1157]](#footnote-1158)306

Where the efficiency trade-offs between methods are substantial, as is often the case, common sense would dictate that a programmer choose the most efficient method. Although other methods of implementing a search are available, such availability is theoretical only—the practicalities of the task effectively limit the number of choices of expression available to the programmer.[[1158]](#footnote-1159)307

In such cases, the merger doctrine should be applied to deny protection to those elements of a program dictated purely by efficiency concerns.[[1159]](#footnote-1160)307.1 Excluding such elements[[1160]](#footnote-1161)307.2 from consideration as evidence of substantial similarity should result in minimizing erroneous findings of infringement. The fact that two programs both use the most efficient sorting or searching method available supports an inference of independent creation as readily as it supports one of copying, and thus, is not reliable evidence that copying actually occurred.[[1161]](#footnote-1162)308

1. **Excluding Program Elements Dictated by External Considerations.**[[1162]](#footnote-1163)308.1

As we have seen, the doctrine of scenes a faire denies copyright protection to those elements that follow naturally from the work’s theme, rather than from the author’s creativity.[[1163]](#footnote-1164)309 This doctrine frequently applies to factual or historical works, where the underlying facts dictate much of the work’s form.[[1164]](#footnote-1165)310 More broadly, whenever originality is lacking from a factual or other work, copyright protection is denied.[[1165]](#footnote-1166)311

These doctrines of scenes a faire and lack of originality apply particularly to computer programs, because in many instances, it is virtually impossible to write a program to perform particular functions in a specific computing environment without employing standard techniques.[[1166]](#footnote-1167)312 Thus, as another step in its analysis,[[1167]](#footnote-1168)312.1 a court should examine the allegedly infringed computer program after eliminating from consideration elements that are not original, or that flow naturally from considerations external to the author’s creativity.[[1168]](#footnote-1169)313 Such external considerations arise from a number of constraints.[[1169]](#footnote-1170)314

The locution in the previous paragraph (“a court should examine”) has led to the argument that courts bear a *sua sponte* obligation to ferret out the evidence. The Second Circuit has properly rejected that position.[[1170]](#footnote-1171)314.1 The further question arises as to who bears the burden of proof: Does it lie on plaintiff to prove as part of its *prima facie* case that the elements which it claims to be original fall outside the merger and scenes a faire doctrine? Or, conversely, must defendant demonstrate the applicability of those doctrines as affirmative defenses? Although plaintiff’s failure to present proof about those issues could defeat a plaintiff’s application for a preliminary injunction,[[1171]](#footnote-1172)314.2 it would seem that defendant must go forward at trial with appropriate evidence as to those doctrines.[[1172]](#footnote-1173)314.3

A plaintiff with a registration certificate, who failed to address defendant’s showing that some material within the copyrighted software was within the public domain, suffered dismissal with prejudice of its claim.[[1173]](#footnote-1174)314.4 The dissent advanced a different view of how to apply the burden of proof to that situation.[[1174]](#footnote-1175)314.5

1. ***Hardware Standards.***

The computer on which the program is intended to run may dictate many elements of a computer program. To make a program compatible with a particular machine, a programmer must tailor the program to meet the machine’s design standards. These standards create the same type of common elements found in scenes a faire cases dealing with literary works. As a result, two programs intended to run on the same computer may contain a number of similarities that are not the product of the programmer’s independent creativity, but are simply necessary for the program to function properly on the machine.

For example, a program issues standard instructions to gain access to the computer’s internal functions. No other instructions will suffice. On the IBM PC, for instance, the hardware that generates the video display on the computer monitor is designed to accept for display on the screen characters and graphics only in a precise format.[[1175]](#footnote-1176)315 Any program that is to run on the IBM PC must contain these specific instructions if it is to generate a display on the monitor screen. The similarities between programs that result from this hardware standardization should be excluded from consideration as evidence of substantial similarity.

Further, the constraints imposed by computer hardware extend beyond the specific code required to access certain functions. Many higher level elements of a program’s design that might appear to be a product of programmer choice also are in fact dictated by the computer’s features or limitations. For instance, the IBM PC contains ten or twelve function keys that can be programmed to perform numerous functions within a particular program. In many programs, these keys are used in lieu of a menu[[1176]](#footnote-1177)316 to permit the user to select among various program functions or options. At first blush, the programmer’s choice between use of menus or function keys would seem to embody the sort of choice in designing the program’s user interface that some courts have found protectible by copyright.[[1177]](#footnote-1178)317 However, the purpose of function keys is to provide a useful feature upon which programmers may build; therefore, the fact that two programs use a function key interface is hardly convincing evidence that one was copied from the other.

What if the similarity goes further, such that plaintiff’s programmer arbitrarily chooses *F4* for technical function *A* and *F7* for technical function *B,* for example, and defendant’s program also assigns function *A* to *F4* and *B* to *F7*? In the absence of any explanation for the identity (*e.g.,* software standard, industry practice), the inference of copying *as a factual matter* is powerful.[[1178]](#footnote-1179)318 Just as small common errors may evidence copying, even minor key-punching sequences that are both arbitrary and identical may be probative that defendant in fact copied from plaintiff.[[1179]](#footnote-1180)318.1 Nonetheless, the inquiry remains whether defendant has crossed the line to actionable infringement via such copying.[[1180]](#footnote-1181)318.2 To the extent that the only similarity between two computer programs lies in those key-punching sequences,[[1181]](#footnote-1182)318.3 *substantial* similarity will probably be lacking, just as it would be in two wholly dissimilar works whose sole point of commonality is several slight common errors.[[1182]](#footnote-1183)318.4 In evaluating similarity involving key strokes, as with all other matters in performing the infringement analysis,[[1183]](#footnote-1184)318.5 this basic distinction between factual and legal copying must be borne in mind.[[1184]](#footnote-1185)318.6 In the context of programming practices, the question of similarity in keystroke sequence is addressed below.[[1185]](#footnote-1186)318.7

These hardware-imposed constraints may extend to numerous aspects of the program’s design. Thus, the court, with the aid of expert testimony,[[1186]](#footnote-1187)318.8 should exclude from substantial similarity analysis those similarities between programs that result from the requirements or features of the machine on which the programs run.[[1187]](#footnote-1188)319

1. ***Software Standards.***

Just as certain elements of a program are dictated by the requirements of the hardware on which the program is to run, the software environment in which the program is developed or operates may also govern elements of the program’s design. Any end user program, such as a word processor or spreadsheet, must communicate and cooperate with the computer’s operating system.[[1188]](#footnote-1189)320 Compatibility with the operating system will dictate numerous aspects of program design, such as the way in which the program accesses data files on disk,[[1189]](#footnote-1190)321 or the way in which it is initially called up by the user,[[1190]](#footnote-1191)322 and thus, will result in similarities between programs that may not be attributable to copying.[[1191]](#footnote-1192)323

In addition to operating system constraints, the programming language in which the program is written may control some aspects of the program’s design. For instance, the types of data structures available to a programmer will depend on the programming language chosen, as will the mechanisms for controlling the flow of data and the ordering of subroutines in the program. These limitations or features can also account for similarities not resulting from copying.

1. ***Computer Manufacturers’ Design Standards.***

In many instances, computer manufacturers establish standards for third party programmers to follow in designing software to run on their machines. These standards often govern matters that are not essential to the program’s correct operation, such as the nature of the user interface and the style of screen displays. They are established so the manufacturer can assure users of its machines of a consistent, familiar interface regardless of whether they purchased software written by the manufacturer or by third-party developers. Although compliance with these standards is not always necessary to develop functional programs, manufacturers often encourage compliance by providing development support and assistance to software developers who follow its standards. Furthermore, if users expect a certain pattern in software for a particular machine, the commercial risks of independent creativity can be substantial.[[1192]](#footnote-1193)324

For example, IBM has released its *Common User Access SAA Manual* for the programs designed to be compatible with IBM’s Systems Application Architecture (SAA), a standard established by IBM to ensure compatibility between IBM PS/2 personal computers, minicomputers and mainframes.[[1193]](#footnote-1194)325 This manual specifies for program developers how the user interface should look in programs running under IBM’s SAA. The definitions include such details as how specific information is arranged and displayed on a screen, the fact that the F1 function key will always mean “help,” what colors should be used for different types of user messages, and how to select the proper one-letter mnemonic code for a user action.[[1194]](#footnote-1195)326 As a result, many of the aesthetic elements of any software designed to run under IBM’s SAA will appear nearly identical.

Similarities between two programs that result from compliance with manufacturers’ standards should not be considered evidence of illegal copying. Although some courts would protect the “total concept and feel” of the user interface in computer programs,[[1195]](#footnote-1196)327 the decisions of these courts assume that this “concept and feel” is the product of the programmer’s original creativity.[[1196]](#footnote-1197)328 Where the programmer is merely following guidelines set down by the computer’s manufacturer, however, the “concept and feel” of the resulting program does not constitute original expression entitled to copyright protection.[[1197]](#footnote-1198)329 Given such standards, the fact that two programs share a similar “concept and feel” is not reliable evidence of copying.[[1198]](#footnote-1199)330

1. ***Target Industry Practices.***

Perhaps the most significant external factors influencing program design are the business practices and technical requirements of the end user.[[1199]](#footnote-1200)330.1 For example, programs intended to trade stock on the New York Stock Exchange necessarily must be designed to comply with the rules and practices of the Exchange. One would thus expect to find a significant degree of similarity between any two such programs.[[1200]](#footnote-1201)331

Similarities resulting from such factors should play no role in determining whether the structure and organization of two programs are substantially similar.[[1201]](#footnote-1202)332 Recognizing this principle, the Fifth Circuit upheld denial of a preliminary injunction, based on a showing by defendant that the similarity between the two cotton marketing programs in question was in part “dictated by the externalities of the cotton market.”[[1202]](#footnote-1203)333 But one should not automatically conclude that “functional compatibility with a copyrighted work is a ‘market factor’ that makes those elements required for compatibility unprotected.”[[1203]](#footnote-1204)333.1

Consider *Ross, Brovins & Oehmke, P.C. v. Lexis Nexis Group*.[[1204]](#footnote-1205)333.2 Plaintiff compiled a series of automated Michigan legal forms into a user-friendly software program, under agreement with defendant.[[1205]](#footnote-1206)333.3 After their contract lapsed, defendant offered its own set of forms. The case rejected plaintiff’s claim of infringement in the compilation copyright,[[1206]](#footnote-1207)333.4 noting that defendant undertook its own original selection and arrangement, based on judgment and creativity.[[1207]](#footnote-1208)333.5 Such similarities as existed resulted mainly from both copying public domain items,[[1208]](#footnote-1209)333.6 such as the Michigan legal forms index.[[1209]](#footnote-1210)333.7 In terms of the software, admittedly the two products’ dialog boxes looked so similar that a user would have a hard time distinguishing them.[[1210]](#footnote-1211)333.8 But that similarity resulted from use of a default setting in HotDocs Pro, proprietary software used in both products.[[1211]](#footnote-1212)333.9 Plaintiff’s decision to use the default setting was not entitled to protection.[[1212]](#footnote-1213)333.10 Turning to interactivity, the Sixth Circuit noted, “A software designer might have copyrightable creative expression in the way that variables interact, particularly where the interrelationship of variables communicates information to the user that is not contained within the express terms of the form.”[[1213]](#footnote-1214)333.11 On the facts presented, however, the “target industry” (namely, court filings) dictated the various choices embodied into plaintiff’s program, thus eliminating liability.[[1214]](#footnote-1215)333.12

1. ***Computer Industry Programming Practices.***

A fifth source of consistency between programs arises out of programming practices and techniques that have become widely used and accepted in the computer software industry.

1. ***In General.***

Most programmers rely on a number of traditional solutions to recurring problems in their programming. For instance, when faced with the problem of sorting and retrieving a large quantity of data, where the maximum amount of data is not known in advance, programmers have developed a data structure known as a linked-list.[[1215]](#footnote-1216)334 A linked-list allows data to be added, deleted or retrieved anywhere in the list, and permits the size of the list to grow indefinitely, limited only by the computer’s memory.[[1216]](#footnote-1217)335 The ability to alter the size of the list, and thus, the amount of memory space it occupies, makes a linked-list more desirable, in many cases, than other data structures that must be allocated a fixed amount of memory space. As a result, the use of linked-lists is a popular programming technique, which will appear in numerous independently created programs.

The mere fact that similar practices or techniques are employed in two programs is tenuous evidence at best of copying. Standard programming techniques are as much the “stock” elements of computer programming as are the common themes, incidents and plot elements referred to in the literary scenes a faire cases.[[1217]](#footnote-1218)336

Nevertheless, a court should apply this factor cautiously. Computer programming is a highly creative and individualistic endeavor. A court should not be led by defense counsel to believe that complex programs consist only of commonly known techniques and materials strung together without significant originality or skill. A court likewise should be unpersuaded by plaintiff’s counsel’s focus on the sheer number of similar bits and pieces in the two programs, without an adequate explanation of the significance of those similar components and how they might have come about.

1. **Lotus v. Borland.**

What if a program has become so popular as to set a *de facto* standard, such that users come to expect its keystrokes and command structures to be present in any program designed to accomplish the same functionality? Under that circumstance, the defendant could argue that its replication of those elements from plaintiff’s work simply reflects industry standards and should not be taken as evidence of wrongful appropriation. To the extent that plaintiff itself derived those elements from external constraints, such as from hardware standards, from the software environment in which the program is to run, from computer manufacturers’ design standards, from the structure and constraints of the industry at which the software is aimed, or based on programming tactics that were previously common to the computer industry, then the previous discussion indicates that the defense should be accepted.[[1218]](#footnote-1219)336.1

But what if, by contrast, those elements of the plaintiff’s program that have won widespread acceptance derive from none of those external factors, but rather originate in the plaintiff’s individual choices? In the first of many published decisions addressing infringement claims in the Lotus 1–2–3 spreadsheet program,[[1219]](#footnote-1220)336.2 one court held that the mere fact that such features have gained currency in the marketplace does not thereby render them into unprotected “standards.”[[1220]](#footnote-1221)336.3 According to Judge Keeton, the argument that a particular program “was so innovative that it occupied the field and set a *de facto* industry standard, and that therefore, defendants were free to copy plaintiff’s expression [would flip] copyright on its head. Copyright protection would be perverse if it only protected mundane increments while leaving unprotected” the most successful innovations.[[1221]](#footnote-1222)336.4 Nonetheless, the question remains whether the keystroke sequence and command structure can themselves be subject to protection, or whether by contrast those features should be filtered out of the analysis.

In subsequent Lotus 1–2–3 opinions, the district court held that, even absent similarity in coding, or in the graphical appearance presented to the user on the computer screen, infringement would lie, based on offering users an emulation mode, in which they could call up the same commands in the same nested structure as contained in Lotus’ copyright work.[[1222]](#footnote-1223)336.5 Further, the court held defendant’s “key reader” function infringing.[[1223]](#footnote-1224)336.6 That device allowed a user who had composed her own macros for use on 1–2–3 to access a file in defendant’s program that would allow those macros to run, invisible to the user. Thus, even after defendant had expunged the emulation mode from its product,[[1224]](#footnote-1225)336.7 it was held liable for offering the ability to translate a third party’s recordation of keystrokes “rfc [Enter twice]” into their intended function, *viz.* entry of a currency transaction.[[1225]](#footnote-1226)336.8 Granted that, in the abstract, one could imagine a wealth of alternative devices to enter a currency transaction, it still does not follow that the keystroke sequence itself should be deemed worthy of copyright protection;[[1226]](#footnote-1227)336.9 one could equally imagine many different knobs, buttons, and panels on an automatic teller machine to dispense cash, but it does not follow that the first bank to select a given mode can thereby forestall its competitors, via copyright protection, from choosing the same design.[[1227]](#footnote-1228)336.10 This case would seem to stretch protection too far.[[1228]](#footnote-1229)336.11

On appeal, the First Circuit reversed.[[1229]](#footnote-1230)336.12 Addressing the question of first impression of whether a computer menu hierarchy can constitute copyrightable subject matter,[[1230]](#footnote-1231)336.13 the court concluded that Lotus had simply articulated a method of operation,[[1231]](#footnote-1232)336.14 which by definition lies beyond statutory protection.[[1232]](#footnote-1233)336.15 The mere fact that Lotus included some expression cannot relieve its method, according to the court, of its ineligibility for protection.[[1233]](#footnote-1234)336.16 This opinion therefore safeguards interoperability between computer programs,[[1234]](#footnote-1235)336.17 and allows users to port macros, which they themselves have composed,[[1235]](#footnote-1236)336.17a to competitive environments.[[1236]](#footnote-1237)336.18 Judge Boudin’s concurrence in this case concedes that “[a]pplying copyright law to computer programs is like assembling a jigsaw puzzle whose pieces do not quite fit.”[[1237]](#footnote-1238)336.19

The Supreme Court’s grant of *certiorari* brought that puzzle to the ultimate authority. *Amici* across the spectrum outdid each other to insert their point of view into the “software case of the century.” Yet a scant one week following oral argument, the Supreme Court announced that Justice Stevens had recused himself, and that the other justices were equally divided.[[1238]](#footnote-1239)336.20 Without comment, the Court left the First Circuit’s decision undisturbed.[[1239]](#footnote-1240)336.21 At the end of the day, therefore, all we know is that the justices at one point considered the case worthy of Supreme Court review, but that when the time arrived to stand and be counted, they ducked.[[1240]](#footnote-1241)336.22

Various courts have applied the First Circuit’s *Lotus* ruling to severely limit protection of constrained expression.[[1241]](#footnote-1242)336.23 Defendant raised that same position in *Oracle America, Inc. v. Google Inc*., but the Federal Circuit rejected it, concluding that Ninth Circuit law conflicted with *Lotus*.[[1242]](#footnote-1243)336.24 The Supreme Court invited the Solicitor General to file a brief expressing the views of the United States, so the stars seemed aligned to produce a new ventilation of this issue.[[1243]](#footnote-1244)336.25 But that brief opposed review[[1244]](#footnote-1245)336.26 and the Court thereupon denied *certiorari*.[[1245]](#footnote-1246)336.27 But when the same case arose again, the Supreme Court accepted review and this time reversed the Federal Circuit[[1246]](#footnote-1247)336.27a—albeit on the issue of fair use.[[1247]](#footnote-1248)336.27b

1. ***More on Interoperability.***

A later case posed the issue of whether the manufacturer of computer printer cartridges could prevent a competitor from offering lower cost substitute cartridges. In *Lexmark Int’l, Inc. v. Static Control Components, Inc.,*[[1248]](#footnote-1249)336.28 plaintiff Lexmark sold discount cartridges armed with an “authentication sequence” that performed a “secret handshake” before printing.[[1249]](#footnote-1250)336.29 Defendant SCC sold its own microchip containing code that mimicked Lexmark’s authentication sequence, thereby affording consumers “a low-cost alternative to new Lexmark toner cartridges.”[[1250]](#footnote-1251)336.30 The Sixth Circuit invoked the merger and scenes a faire doctrine to deny copyright status to the Toner Loading Program[[1251]](#footnote-1252)336.31 that Lexmark used to exclude rival cartridges from operating its printers.

Generally speaking, “lock-out” codes fall on the functional-idea rather than the original-expression side of the copyright line. Manufacturers of interoperable devices such as computers and software, game consoles and video games, printers and toner cartridges, or automobiles and replacement parts may employ a security system to bar the use of unauthorized components. To “unlock” and permit operation of the primary device (*i.e*., the computer, the game console, the printer, the car), the component must contain either a certain code sequence or be able to respond appropriately to an authentication process. To the extent compatibility requires that a particular code sequence be included in the component device to permit its use, the merger and scenes a faire doctrines generally preclude the code sequence from obtaining copyright protection.[[1252]](#footnote-1253)336.32

In so holding, *Lexmark v. SCC* rejected the district court’s reasoning. In particular, the lower court had found that the Toner Loading Program could have been written in a great many ways. But that accurate observation overlooked the fact that, once that program was written, it served as a method of operation. That circumstance alone doomed its protection.[[1253]](#footnote-1254)336.33 More generally, alternative possibilities cannot, by themselves, vouchsafe copyrightability.[[1254]](#footnote-1255)336.34

From a broader perspective, the majority rejected the district court’s conclusion that alternative approaches were available.[[1255]](#footnote-1256)336.35 It relied on the concession from plaintiff’s expert that “functionality and efficiency considerations precluded any material changes to the Toner Loading Program.”[[1256]](#footnote-1257)336.36

More broadly still, *Lexmark v. SCC* premised its denial of infringement on the fact that the subject routine functioned as a lock-out code.[[1257]](#footnote-1258)336.37 “If any single byte of the Toner Loading Program is altered, the checksum value will not match the checksum calculation result. Only if the checksum value is correspondingly changed to accommodate any alterations in the data bytes will the printer function.”[[1258]](#footnote-1259)336.38 Because it would have been “computationally impossible” for SCC to interoperate with Lexmark’s product absent complete copying, the court held such wholesale copying justified.[[1259]](#footnote-1260)336.39 For that matter, even an otherwise copyrightable poem, when used as a lock-out code, would lose its protected status.[[1260]](#footnote-1261)336.40 Under the dissent’s competing view, by contrast, the poem would retain its copyright protection in the abstract—but anyone could copy it verbatim for the sole purpose of replicating its functionality as a password.[[1261]](#footnote-1262)336.41 A later case discussed interoperability as bearing on a potential fair use defense, not on copyrightability.[[1262]](#footnote-1263)336.42

1. **Excluding Program Elements Taken from the Public Domain.**

It is axiomatic that material in the public domain is not protected by copyright, even when incorporated into a copyrighted work.[[1263]](#footnote-1264)337 In addition, as previously noted, material that is licensed should be assimilated, for substantial similarity purposes, to material that lies in the public domain.[[1264]](#footnote-1265)337.1 To the extent that two programs largely resemble each other, but the similarity results from elements that plaintiff duly licensed to defendant, no liability should be found.[[1265]](#footnote-1266)337.2 In thoroughly and systematically analyzing the similarity of two programs, the implications for the computer software industry of this basic rule must be borne in mind.[[1266]](#footnote-1267)337.3

An enormous amount of public domain software exists in the computer industry, perhaps to a much greater extent than is true of other fields. Nationwide computer “bulletin boards” permit users to share and distribute programs.[[1267]](#footnote-1268)338 In addition, computer programming texts may contain examples of actual code that programmers are encouraged to copy.[[1268]](#footnote-1269)339

Programmers often will build existing public domain software into their works. The courts thus must be careful to limit protection only to those elements of the program that represent the author’s original work.[[1269]](#footnote-1270)340

1. **Analysis of any Remaining Similarities.**

After applying the doctrines set forth above, a core of protectible material may remain. If so, this material must be compared with material from the defendant’s program to ascertain if there is a sufficient degree of similarity to justify a finding of infringement. The analytic process set forth above successively filters out unprotected elements.[[1270]](#footnote-1271)341 Only the remaining core of protectible material[[1271]](#footnote-1272)342 is pertinent for the finder of fact to compare against defendant’s work in order to determine whether infringing substantial similarity exists.[[1272]](#footnote-1273)343 This approach parallels the Second Circuit’s reasoning in *Arnstein v. Porter*.[[1273]](#footnote-1274)344 In addition, it is congruent with the approach followed in at least some Ninth Circuit cases.[[1274]](#footnote-1275)345

In performing the filtering, the court should be sensitive to the myriad ways in which copyrightable creativity can manifest itself; the analysis should not proceed mechanically simply by isolating physical elements out of the copyrightable work.[[1275]](#footnote-1276)345a

Suppose defendant copied plaintiff’s abstract painting composed entirely of geometric forms arranged in an original pattern. The alleged infringer could argue that each expressive element (i.e., the geometric forms) is unprotectible under the functionality, merger, scènes à faire, and unoriginality theories and, thus, all elements should be excluded prior to the substantial similarity of expression analysis. In this example, elimination of “unprotectible” elements would result in a finding of no copyright infringement, which would be clearly inconsistent with the copyright law’s purpose of providing incentives to authors of original works.[[1276]](#footnote-1277)345.1

Accepting the conclusion that the purpose of copyright law requires a finding of infringement in the above hypothetical, the flaw in the alleged infringer’s argument is that the structure and arrangement of geometric forms may evidence plaintiff’s originality,[[1277]](#footnote-1278)345.2 in which case such elements may not be eliminated from the analysis. Although each geometric form in isolation might be subject to exclusion from the court’s calculus, the conceptual interrelationship of shapes should remain present for the court’s analysis even after filtering out particular concrete objects, thus subjecting the defendant to potential liability should copying of those elements be proven.[[1278]](#footnote-1279)345.3

Once plaintiff’s work has been filtered down to its protectible core, comparing those protected elements against defendant’s program poses essentially a value judgment, involving an assessment of the importance of the material that was copied.[[1279]](#footnote-1280)345.4 In some cases, the amount of material copied will be so small as to be *de minimis,*[[1280]](#footnote-1281)345.5 and will not justify a finding of substantial similarity.[[1281]](#footnote-1282)346

In other cases, however, even a quantitatively small amount of copied material may be sufficiently important to the operation of plaintiff’s program to justify a finding of substantial similarity.[[1282]](#footnote-1283)347 For instance, a small portion of the structure or code of a program may nonetheless give it distinctive features or may make the program especially creative or desirable.[[1283]](#footnote-1284)348 In such a case, a finding of substantial similarity would be appropriate.[[1284]](#footnote-1285)349

Even if the similar material is not *de minimis,* the question of copying remains. Evidence of independent creation can rebut the inference of copying that arises when access and substantial similarity are demonstrated.[[1285]](#footnote-1286)350 Independent creation is a question for the trier of fact.[[1286]](#footnote-1287)351 Courts view such evidence skeptically, however, and impose a high standard of proof on a defendant asserting independent creation if plaintiff has offered adequate evidence of access and substantial similarity. Nevertheless, given the highly structured nature of computer programming, and the fact that computer programs are designed to fit the common needs of end users rather than the artistic desires of the programmer, such arguments should not automatically be dismissed in the context of computer software. Where the similarities between the two programs are not overwhelming, and the subject matter of the program naturally limits the variety of available approaches, claims of independent creation may have merit and warrant serious consideration.

Finally, computer cases no less than more traditional copyright actions may invoke the full panoply of defenses to infringement.[[1287]](#footnote-1288)352 Thus, even given access and substantial similarity between defendant’s program and protectible elements of plaintiff’s program, the court should consider whether fair use[[1288]](#footnote-1289)353 or any other defense applies.

1. **Conclusion.**

Applying the “successive filtering” test set forth above merely involves examining the works in controversy in light of each of the doctrines canvassed in the preceding subsections. After the analysis at each level, those elements of the plaintiff’s work that are unprotectible because of the particular doctrine in question should be excluded from further consideration. Of course, not all of the doctrines explored above will apply to the programs involved in any given case,[[1289]](#footnote-1290)354 and only those doctrines supported by the facts and evidence of a particular case should be considered.[[1290]](#footnote-1291)355 As with any new legal rule or test, there is a danger that the analytical method proposed herein will be difficult to apply. Because this proposed method is merely a thorough and rigorous application of traditional copyright rules to cases involving computer software, however, the danger in this instance is minimal.[[1291]](#footnote-1292)356 This approach, it is hoped, will help to focus courts’ inquiries and bring some clarity to cases wherein the subject matter of the suit is already confusing.

Nimmer on Copyright

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1. 1See §§ 8.01 and 13.01 *supra*. Given the frequent joining of Lanham Act causes of action to copyright claims, absence of substantial similarity in the copyright sense can also doom a Lanham Act Section 43(a) claim alleging confusion as to origin. Conan Properties, Inc. v. Mattel, Inc., 712 F. Supp. 353, 362 (S.D.N.Y. 1989). See § 1.19[B] *supra*. [↑](#footnote-ref-2)
2. 1.1Even in the field of psychology, the definition of “similarity” is contested. See Amos Twersky, *Features of Similarity*, 84 Psych. Rev. 327 (1977). [↑](#footnote-ref-3)
3. 2Lumetrics, Inc. v. Blalock, 23 F. Supp. 3d 138, 146 (W.D.N.Y. 2014) (Treatise quoted); Novak v. National Broadcasting Co., 716 F. Supp. 745, 750 (S.D.N.Y. 1989) (Treatise quoted); Alexander v. Irving Trust Co., 132 F. Supp. 364 (S.D.N.Y. 1955), *aff’d,* 228 F.2d 221 (2d Cir. 1955); Kustoff v. Chaplin, 120 F.2d 551 (9th Cir. 1941); Ideal Toy Corp. v. Fab-Lu, Ltd., 360 F.2d 1021 (2d Cir. 1966). Cf. United States v. Taxe, 380 F. Supp. 1010 (C.D. Cal. 1974), *modified*, 540 F.2d 961 (1976). [↑](#footnote-ref-4)
4. 2.1Newton v. Diamond, 388 F.3d 1189, 1193 (9th Cir. 2004), *cert. denied*, 545 U.S. 1114 (2005) (Treatise cited). [↑](#footnote-ref-5)
5. 2.1aGolden Star Wholesale, Inc. v. ZB Importing, Inc., 531 F. Supp. 3d 1231, 1250 n.2 (E.D. Mich. 2021) (Treatise quoted). [↑](#footnote-ref-6)
6. 2.2Zalewski v. Cicero Builder Dev., Inc., 754 F.3d 95, 101–02 (2d Cir. 2014) (affirming grant of summary judgment to defendant under those circumstances). In this case, plaintiff was “correct that the designs are, in many respects, quite close, but this is not enough. It proves at most copying, not wrongful copying.” *Id.* at 106. [↑](#footnote-ref-7)
7. 2.3Outside copyright law, in the cognate field of trademarks, the benchmark is not substantial similarity, but consumer confusion. Note the inapposite references to works being “confusingly similar” and inducing a “mistaken belief” as to what a consumer was purchasing, set forth in Mulberry Thai Silks v. K & K Neckwear, 897 F. Supp. 789, 791 (S.D.N.Y. 1995). [↑](#footnote-ref-8)
8. 3Peter F. Gaito Architecture, LLC v. Simone Dev. Corp., 602 F.3d 57, 63 (2d Cir. 2010) (Treatise quoted); Warner Bros, Inc. v. American Broadcasting Cos., 654 F.2d 204 (2d Cir. 1981) (Treatise quoted); E.F. Johnson Co. v. Uniden Corp. of Am., 623 F. Supp. 1485, 1492 (D. Minn. 1985) (Treatise quoted). [↑](#footnote-ref-9)
9. 3.1See § 13.01[B] *supra*. Despite all the “confusing nomenclature” enunciated by various courts on this score, one opinion dismisses the divergences as a “pseudo-conflict.” Peters v. West, 692 F.3d 629, 633 (7th Cir. 2012). [↑](#footnote-ref-10)
10. 3.2Society of the Holy Transfiguration Monastery, Inc. v. Gregory, 689 F.3d 29, 49 (1st Cir. 2012) (Treatise quoted), *cert. denied*, 568 U.S. 1167 (2013); Johnson v. Gordon, 409 F.3d 12, 18 (1st Cir. 2005) (Treatise quoted); Dam Things from Denmark v. Russ Berrie & Co., 290 F.3d 548, 562 (3d Cir. 2002) (previous two sentences of Treatise quoted); Bridgmon v. Array Sys. Corp., 325 F.3d 572, 576 n.7 (5th Cir. 2003) (Treatise quoted); Horizon Comics Prods., Inc. v. Marvel Entm’t, LLC, 246 F. Supp. 3d 937, 940 (S.D.N.Y. 2017) (Treatise quoted). “ ‘Substantial similarity,’ while said to be required for indirect proof of copying [as a factual matter], is actually required only after copying has been established to show that *enough* copying has taken place.” Latman, *“Probative Similarity” As Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement*, 90 Colum. L. Rev. 1187, 1190 (1990) (emphasis original). See Laureyssens v. Idea Group, Inc., 964 F.2d 131, 140 (2d Cir. 1992) (Treatise quoted); Jarvis v. A&M Records, 827 F. Supp. 282, 288 n.2 (D.N.J. 1993) (Treatise quoted); Beal v. Paramount Pictures Corp., 20 F.3d 454, 459 n.4 (11th Cir. 1994) (Treatise cited), *cert. denied,* 513 U.S. 1062 (1994). [↑](#footnote-ref-11)
11. 3.3Of course, even with high Court guideposts, the exercise would not automatically become easy. In the analogous field of patent law, Congress used the term “substantial” in one context:

    Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

    35 U.S.C. § 271(f)(1). When the Supreme Court construed that language, it concluded that “a substantial portion” was ambiguous. See Life Techs Corp. v. Promega Corp., 137 S. Ct. 734, 739 (2017). Ultimately, Justice Sotomayor’s majority opinion gave the term “a quantitative, not a qualitative, meaning.” *Id.* at 743. [↑](#footnote-ref-12)
12. 4Ringgold v. Black Entertainment Television, Inc., 126 F.3d 70, 74 (2d Cir. 1997) (Treatise cited); Sandoval v. New Line Cinema Corp., 147 F.3d 215, 218 (2d Cir. 1998) (Treatise cited) (fleeting, obscured, out of focus “virtually unidentifiable” snippets of plaintiff’s photographs); LMNOPI v. XYZ Films, LLC, 449 F. Supp. 3d 86 (E.D.N.Y. 2020) (same); Prunté v. Universal Music Group, Inc., 699 F. Supp. 2d 15, 25, 26 (D.D.C. 2010) (Treatise quoted) (holding “Fire in the Hole” non-infringing of “Fire in Da Hole”), *aff’d unpub.*, 425 Fed. Appx. 1 (D.C. Cir. 2011). See Caddy-Imler Creations, Inc. v. Caddy, 299 F.2d 79 (9th Cir. 1962); L & L White Metal Casting Corp. v. Joseph, 387 F. Supp. 1349 (E.D.N.Y. 1975). [↑](#footnote-ref-13)
13. 4.1See § 13.01[B] *supra*. [↑](#footnote-ref-14)
14. 4.2New Old Music Grp., Inc. v. Gottwald, 122 F. Supp. 3d 78, 94 (S.D.N.Y. 2015) (Treatise quoted). See Parker v. Dufresne, 781 F. Supp. 2d 379 (W.D. La. 2011). In that case, both works dramatized actual murders, using for that purpose the vehicle of crumb-carrying ants in the dumpster where the bodies were stashed. The court determined the similarity to be probative, *id.* at 384, but not to rise to the level of substantiality, *id.* at 385. [↑](#footnote-ref-15)
15. 5In George Simon, Inc. v. Spatz, 492 F. Supp. 836, 838 (W.D. Wis. 1980), the court properly rejected defendants’ contention that the subject musical works had to be performed “exactly” as plaintiff wrote them for liability to ensue. Nonetheless, the court’s language—“The degree of similarity to the original is irrelevant if the work is held out to be a performance of the copyrighted composition”—led a subsequent court to conclude, erroneously, that substantial similarity can be dispensed with as an essential ingredient to a copyright infringement action. Major Bob Music v. Stubbs, 851 F. Supp. 475, 479 (S.D. Ga. 1994). [↑](#footnote-ref-16)
16. 6Novelty Textile Mills, Inc. v. Joan Fabrics Corp., 558 F.2d 1090 (2d Cir. 1977); Williams v. Kaag Mfrs., Inc., 338 F.2d 949 (9th Cir. 1964); Comptone Co. v. Rayex Corp., 251 F.2d 487 (2d Cir. 1958); Gordon v. Weir, 111 F. Supp. 117 (E.D. Mich. 1953), *aff’d*, 216 F.2d 508 (6th Cir. 1954); Trifari, Krussman & Fishel v. B. Steinberg-Kaslo Co., 144 F. Supp. 577 (S.D.N.Y. 1956); Robbins Music Corp. v. Weinstock, 107 F. Supp. 102 (S.D.N.Y. 1952); MacMillan Co. v. King, 223 F. 862 (D. Mass. 1914). [↑](#footnote-ref-17)
17. 6.1“It is pertinent to remember that the test for copyright protection is not the same as the test for infringement avoidance.” L & L White Metal Casting Corp. v. Joseph, 387 F. Supp. 1349, 1353 (E.D.N.Y. 1975). See Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp., 562 F.2d 1157 (9th Cir. 1977); Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980); Eden Toys, Inc. v. Florelee Undergarment Co., 697 F.2d 27 (2d Cir. 1982). [↑](#footnote-ref-18)
18. 6.2See § 2.01[B][1] *supra*. [↑](#footnote-ref-19)
19. 6.3Dam Things from Denmark v. Russ Berrie & Co., 290 F.3d 548, 565 n.25 (3rd Cir. 2002) (Treatise quoted). [↑](#footnote-ref-20)
20. 6.4Blehm v. Jacobs, 702 F.3d 1193, 1208 (10th Cir. 2012) (Treatise quoted) (“Truer words could not have been spoken about this case.”). [↑](#footnote-ref-21)
21. 6.5“Because there is no similarity—substantial or otherwise—between the two works at issue in this case, defendants’ motion for summary judgment must be granted.” Starobin v. King, 137 F. Supp. 2d 93, 98 (N.D.N.Y. 2001). In that case, plaintiff claimed her novel about “vampires who operate a car service in the suburbs of New Jersey” was infringed by Stephen King’s work “about an ancient spirit released from a mine in the Nevada desert.” *Id*. at 95. See Palmer v. Braun, 155 F. Supp. 2d 1327, 1333–1334 (M.D. Fla. 2001). [↑](#footnote-ref-22)
22. 7Nichols v. Universal Pictures Co., 45 F.2d 119, 122 (2d Cir. 1930). [↑](#footnote-ref-23)
23. 8Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960). See Financial Control Assoc., Inc. v. Equity Builders, Inc., 799 F. Supp. 1103, 1115 (D. Kan. 1992) (Treatise quoted). [↑](#footnote-ref-24)
24. 9The treatise terminology, however, is endorsed in Ringgold v. Black Entertainment Television, Inc., 126 F.3d 70, 75 n.3 (2d Cir. 1997); Twin Peaks Prods., Inc. v. Publications Int’l, Ltd., 996 F.2d 1366, 1372 n.1 (2d Cir. 1993); Walker v. Time Life Films, Inc., 784 F.2d 44 (2d Cir.), *cert. denied*, 476 U.S. 1159, 106 S. Ct. 2278, 90 L. Ed. 2d 721 (1986); Warner Bros. v. American Broadcasting Cos., 720 F.2d 231 (2d Cir. 1983); S & H Computer Sys., Inc. v. SAS Inst., Inc., 568 F. Supp. 416 (M.D. Tenn. 1983); Fink v. Goodson-Todman Enters., Ltd., 9 Cal. App. 3d 996, 88 Cal. Rptr. 679 (1970); United States v. Taxe, 380 F. Supp. 1010 (C.D. Cal. 1974), *modified*, 540 F.2d 961 (1976); Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904 (3d Cir. 1975), *cert. denied*, 423 U.S. 863, 96 S. Ct. 122, 46 L. Ed. 2d 92 (1975); Werlin v. Reader’s Digest Ass’n, Inc., 528 F. Supp. 451 (S.D.N.Y. 1981); Smith v. Weinstein, 578 F. Supp. 1297 (S.D.N.Y. 1984)*, aff’d,* 738 F.2d 419 (2d Cir. 1984). [↑](#footnote-ref-25)
25. 10Loomis v. Cornish, 836 F.3d 991, 995 (9th Cir. 2016) (Treatise quoted). Cf. § 13.03[A][1][e] *infra*. [↑](#footnote-ref-26)
26. 11Palmer v. Braun, 287 F.3d 1325, 1330 (11th Cir. 2002) (Treatise quoted); Castle Rock Enter. v. Carol Pub. Group, Inc., 150 F.3d 132, 140 (2d Cir. 1998) (Treatise quoted); Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 701 (2d Cir. 1992) (Treatise quoted); Historical Truth Prods. v. Sony Pictures Entertainment, 39 U.S.P.Q.2d (BNA) 1807, 1816 (S.D.N.Y. 1995) (Treatise quoted); Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc., 797 F.2d 1222, 1234 n.26 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031 (1987) (Treatise quoted). See Arica Inst., Inc. v. Palmer, 970 F.2d 1067, 1073 (2d Cir. 1992) (Treatise cited). [↑](#footnote-ref-27)
27. 11aBell v. Wilmott Storage Servs., LLC, 12 F.4th 1065, 1074 (9th Cir. 2021) (Treatise quoted). [↑](#footnote-ref-28)
28. 11.1Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc., 338 F.3d 127, 133 & n.5 (2d Cir. 2003) (Treatise cited); Silver Ring Splint Co. v. Digisplint, Inc., 543 F. Supp. 2d 509, 517 n.12 (W.D. Va. 2008) (Treatise quoted). [↑](#footnote-ref-29)
29. 12Costello, Erdlen & Co. v. Winslow, King, Richards & Co., 797 F. Supp. 1054, 1064 (D. Mass. 1992) (Treatise cited) (magistrate opinion); Meredith Corp. v. Harper & Row, Publishers, Inc., 378 F. Supp. 686 (S.D.N.Y. 1974), *aff’d*, 500 F.2d 1221 (2d Cir. 1974) (“It is hardly an inducement to [an author] to do the years of research and scholarship needed to produce an authoritative text if an untrained … writer … may paraphrase major portions and make a competing text out of it”); Donald v. Zack Meyer’s T.V. Sales & Serv., 426 F.2d 1027, 1030 (5th Cir. 1970) (“in copyright law paraphrasing is equivalent to outright copying”), *cert. denied*, 400 U.S. 992, 91 S. Ct. 459, 27 L. Ed. 2d 441 (1971); Salinger v. Random House, Inc., 811 F.2d 90, 97 (2d Cir. 1987) (Treatise cited), *cert. denied*, 484 U.S. 890, 108 S. Ct. 213, 98 L. Ed. 2d 177 (1987); Nutt v. National Inst., 31 F.2d 236 (2d Cir. 1929); Meccano, Ltd. v. Wagner, 234 F. 912 (S.D. Ohio 1916), *modified*, 246 F. 603 (6th Cir. 1918); West Publishing Co. v. Lawyers Coop. Publishing Co., 79 F. 756 (2d Cir. 1897); Nikanov v. Simon & Schuster, 246 F.2d 501 (2d Cir. 1957); see Eisenschiml v. Fawcett Publications, Inc., 246 F.2d 598 (7th Cir. 1957). For a particularly interesting example of differences between two works that were nevertheless found substantially similar, see Daly v. Palmer, 6 F. Cas. 1132, No. 3552 (S.D.N.Y. 1868). [↑](#footnote-ref-30)
30. 12.1Warner Bros. Entm’t Inc. v. RDR Books, 575 F. Supp. 2d 513, 537 (S.D.N.Y. 2008) (Treatise quoted). [↑](#footnote-ref-31)
31. 13Nichols v. Universal Pictures Co., 45 F.2d 119, 121 (2d Cir. 1930). “Duplication or near identity is not necessary to establish infringement.” Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp., 562 F.2d 1157 (9th Cir. 1977). In Davis v. E.I. du Pont de Nemours & Co., 240 F. Supp. 612 (S.D.N.Y. 1965), the court, in holding for the plaintiff, stated that the defendants’ “ ‘changes’ amounted to mere paraphrasing, inversion of dialogue, or substitution of one insignificant object for another. But paraphrasing is tantamount to copying in copyright law.” See G.R.I. Corp. v. Golden Fifty Pharmaceutical Co., 185 U.S.P.Q. 674 (N.D. Ill. 1975). [↑](#footnote-ref-32)
32. 14See § 13.03[B][2][a] *infra*. [↑](#footnote-ref-33)
33. 14.1An example of an abstract idea is “that scrapbook pages have titles, borders, and instructions.” Close to My Heart, Inc. v. Enthusiast Media LLC, 508 F. Supp. 2d 963, 968–969 (D. Utah 2007) (Treatise cited). [↑](#footnote-ref-34)
34. 15Frybarger v. International Business Machs. Corp., 812 F.2d 525, 529, 530 (9th Cir. 1987) (Treatise quoted), *cert. denied*, 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 133 (1982). Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607 (7th Cir. 1982) (Treatise quoted). See Mihalek Corp. v. Michigan, 814 F.2d 290, 294–295 (6th Cir. 1987)*, remanded,* 821 F.2d 327 (1987); Becker v. Loew’s, Inc., 133 F.2d 889 (7th Cir. 1943); Shipman v. RKO, 100 F.2d 533 (2d Cir. 1938). [↑](#footnote-ref-35)
35. 16See, *e.g.,* Mazer v. Stein, 347 U.S. 201, 74 S. Ct. 460, 98 L. Ed. 2d 630 (1954); Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487 (2d Cir. 1960); Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp., 562 F.2d 1157 (9th Cir. 1977). [↑](#footnote-ref-36)
36. 17H. Rep., p. 61. See also Reg. Supp. Rep., p. 17. It has been held that the rules for the determination of substantial similarity are the same under both the 1976 and 1909 Acts. Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980). [↑](#footnote-ref-37)
37. 17.1“[T]he idea/expression or fact/expression dichotomy, applies to all works of authorship.” Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 350, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). In the computer context, this dichotomy has also been called the “process-expression, method-expression, and useful-expression distinctions.” Lotus Dev. Corp. v. Paperback Software Int’l, 740 F. Supp. 37, 53 (D. Mass. 1990). [↑](#footnote-ref-38)
38. 1817 U.S.C. § 102(b). See Warner Bros, Inc. v. American Broadcasting Cos., 654 F.2d 204 (2d Cir. 1981); Miller v. Universal City Studios, Inc., 650 F.2d 1365 (5th Cir. 1981). [↑](#footnote-ref-39)
39. 19Canal+ Image UK Ltd. v. Lutvak, 773 F. Supp. 2d 419, 432 (S.D.N.Y. 2011) (Treatise quoted); Chuck Blore & Don Richman, Inc. v. 20/20 Advertising, Inc., 674 F. Supp. 671, 676 (D. Minn. 1987) (Treatise cited). [↑](#footnote-ref-40)
40. 20Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960). [↑](#footnote-ref-41)
41. 20.1At that level of abstraction substantial similarity is clearly lacking. “If it were not for the fact that the book and movies bear the same title [*Predator*], it is hard to believe that any claim of infringement could ever have been filed here.” Littel v. Twentieth Century-Fox Film Corp., 37 U.S.P.Q.2d (BNA) 1353, 1361–1362 (S.D.N.Y. 1995) (“no reasonable trier of fact could find the two works substantially similar”), *aff’d,* 100 F.3d 943 (2d Cir. 1996). [↑](#footnote-ref-42)
42. 21Nichols v. Universal Pictures Co., 45 F.2d 119, 121 (2d Cir. 1930). See the criticism of this test by Judge Manton in Shipman v. R. K. O. Radio Pictures, Inc., 100 F.2d 533 (2d Cir. 1938), and note Judge Hand’s defense of the test in his concurring opinion. More recently it has been said: “No court or commentator … has been able to improve upon Judge Learned Hand’s famous ‘abstractions test’ …” Sid & Marty Krofft Television, Inc. v. McDonald’s Corp., 562 F.2d 1157, 1163 (9th Cir. 1977). See also the reference to the Hand test by Judge Kearse in her highly perceptive comparison of various versions of the Tarzan story in Burroughs v. Metro-Goldwyn-Mayer, Inc., 683 F.2d 610 (2d Cir. 1982). See Burnett v. Lambino, 204 F. Supp. 327 (S.D.N.Y. 1962). [↑](#footnote-ref-43)
43. 21aRunstadler Studios, Inc. v. MCM Ltd. Partnership, 768 F. Supp. 1292, 1297 (N.D. Ill. 1991) (Treatise quoted). See Ringgold v. Black Entertainment Television, Inc., 126 F.3d 70, 75 (2d Cir. 1997) (Treatise cited). [↑](#footnote-ref-44)
44. 21.1“Hand’s insight is not a ‘test’ at all. It is a clever way to pose the difficulties that require courts to avoid either extreme of the continuum of generality.” Nash v. CBS, Inc., 899 F.2d 1537, 1540 (7th Cir. 1990). The opinion below, 704 Supp. 823, 827 n.2 (N.D. Ill. 1989), maintains that, paradoxically, moving down the levels of abstractions does not produce greater liability in the case of historical nonfiction. See § 2.11[B] *supra*. [↑](#footnote-ref-45)
45. 22Chafee, *Reflections on the Law of Copyright,* 45 Colum. L. Rev. 503, 513 (1945). [↑](#footnote-ref-46)
46. 23In Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738 (9th Cir. 1971), after referring to Judge Hand’s “ ‘abstraction’ formulation,” Judge Browning concludes: “The guiding consideration in drawing the line is the preservation of the balance between competition and protection reflected in the patent and copyright laws.” In Stratchborneo v. Arc Music Corp., 357 F. Supp. 1393 (S.D.N.Y. 1973), Judge Brieant characterized copying of the “expression” of an idea as proof that the adverse party “in a material way tracked [the plaintiff’s] … treatment of [the] idea.” For other suggested approaches to the determination of substantial similarity, see Sorenson & Sorenson, *Re-examining the Traditional Legal Test of Literary Similarity: A Proposal for Content Analysis,* 37 Cornell L. Q. 638 (1952); Malevinsky, *The Science of Playwriting* (Brentano, New York, 1925). The Malevinsky “algebraic formula” for the determination of substantial similarity is discussed in Nimmer, *Inroads on Copyright Protection*, Fourth Copyright Law Symposium (ASCAP), 39–43. [↑](#footnote-ref-47)
47. 24Fink v. Goodson-Todman Enters., Ltd., 9 Cal. App. 3d 996, 88 Cal. Rptr. 679 (1970) (Treatise cited). [↑](#footnote-ref-48)
48. 25Situation Mgmt. Sys. v. ASP Consulting Group, 535 F. Supp. 2d 231, 240 (D. Mass. 2008), *vacated on other grounds*, 560 F.3d 53 (1st Cir. 2009) (Treatise quoted); Fleener v. Trinity Broad. Network, 203 F. Supp. 2d 1142, 1149 (C.D. Cal. 2001) (Treatise quoted). “[T]he essence of infringement lies in taking not a general theme but its particular expression through similarities of treatment, details, scenes, events and characterization.” Reyher v. Children’s Television Workshop, 533 F.2d 87, 91 (2d Cir. 1976), *cert. denied*, 429 U.S. 980 (1976). Even in the absence of a similar sequence of events, it has been held that a *combination* of many different elements of similarity may be sufficient to constitute infringement even if any one such element taken by itself would be trivial. Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp., 562 F.2d 1157 (9th Cir. 1977). On the same point, see See v. Durang, 711 F.2d 141 (9th Cir. 1983); Warner Bros. v. American Broadcasting Cos., 720 F.2d 231 (2d Cir. 1983). [↑](#footnote-ref-49)
49. 26See § 13.03[B][2][a] *infra*. [↑](#footnote-ref-50)
50. 27Nichols v. Universal Pictures Co., 45 F.2d 119 (2d Cir. 1930), in which Judge Hand’s abstractions test was first stated, happened to involve an action by Anne Nichols, author of “Abie’s Irish Rose” claiming that her play had been infringed by the defendant’s motion picture, “The Cohens and The Kellys.” In holding for the defendant, the court found that no more than plaintiff’s idea had been borrowed, not its expression. Specifically, the court found “the only matter common to the two is a quarrel between a Jewish and an Irish father, the marriage of their children, the birth of grandchildren, and a reconciliation.” An updated example of a similar pro-defendant holding, involving a play deriding an Italian wedding, is found in Franklin v. Ciroli, 865 F. Supp. 940 (D. Mass. 1994); 865 F. Supp. 947 (D. Mass. 1994). [↑](#footnote-ref-51)
51. 27.1See § 2.01[B][1] N. 4 *supra*. [↑](#footnote-ref-52)
52. 27.2See Nash v. CBS, Inc., 899 F.2d 1537, 1540 (7th Cir. 1990); Reed-Union Corp. v. Turtle Wax, Inc., 77 F.3d 909, 914 (7th Cir. 1996). [↑](#footnote-ref-53)
53. 28This borrowing was obviously intentional upon the part of the authors of “West Side Story.” Because “Romeo and Juliet” is in the public domain, it was not only permissible but indeed an inspired idea to adapt the classic Veronese tale to the situation facing Puerto Rican immigrants to New York City. [↑](#footnote-ref-54)
54. 29See the six points of similarity in Dr. Pepper Co. v. Sambo’s Restaurants, Inc., 517 F. Supp. 1202, 1207 (N.D. Tex. 1981), which were held to constitute substantial similarity of expression as between plaintiff’s and defendant’s respective television commercials. See also the 13 points of similarity as between the motion pictures “Star Wars” and “Battlestar: Galactica,” which the court of appeals noted in reversing the summary judgment for defendant in Twentieth Century-Fox Film Corp. v. MCA, Inc., 715 F.2d 1327, 1329 (9th Cir. 1983). The court of appeals held that “at a minimum, [the issue of substantial similarity] is a close enough question that it should be resolved by way of a trial.” *Id*. It should be disclosed that this writer was attorney for Twentieth Century-Fox on the appeal in this case. See the similarities listed in Charell v. Quicksilver Prods., Inc., 1984 Copyright L. Dec. (CCH) ¶ 25,640 (N.Y. Sup. Ct. 1983), which were held to require denial of defendant’s motion for summary judgment in a common law copyright action. Compare the seven points of similarity enumerated in Bevan v. Columbia Broadcasting Sys., Inc., 329 F. Supp. 601, 605 (S.D.N.Y. 1971), which correctly were held not to constitute substantial similarity. Note the difference in the level of abstraction between the *Bevan* seven points and the “West Side Story” 13 points; see Universal City Studios, Inc. v. Film Ventures Int’l, Inc., 543 F. Supp. 1134 (C.D. Cal. 1982); Manes Fabrics Co. v. Miss Celebrity, Inc., 246 F. Supp. 975 (S.D.N.Y. 1965). [↑](#footnote-ref-55)
55. 29.1For a parallel exercise involving *The Shop Around the Corner* and *You’ve Got Mail*, see Bucklew v. Hawkins, Ash, Baptie & Co., 329 F.3d 923, 929 (7th Cir. 2003). [↑](#footnote-ref-56)
56. 30See the enumerated similarities in Midas Prods., Inc. v. Baer, 437 F. Supp. 1388 (C.D. Cal. 1977), which the court quite questionably regarded as similarities of “idea” rather than of “expression.” A more borderline case, but also arguably questionable, was the treatment of the similarities in Musto v. Meyer, 434 F. Supp. 32 (S.D.N.Y. 1977), *aff’d*, 598 F.2d 609 (2d Cir. 1979) (involving the Sherlock Holmes story “The Seven Per Cent Solution”), as similarities of “idea” rather than of “expression.” Both *Musto* and Rokeach v. Avco Embassy Pictures Corp., 197 U.S.P.Q. 155 (S.D.N.Y. 1978), were cases in which defendant’s fictional work was to some extent based upon the plaintiff’s scientific study. In each case, the court concluded that the defendant copied only the plaintiff’s “idea” and not his “expression.” See § 13.03[B][2][a] *infra*. When the similarities in *Musto* are compared with those in *Rokeach*, the qualitative and quantitative difference suggests that the similarities in *Musto* should have been found to be on the “expression” side of the line. See also Ornstein v. Paramount Prods., 9 F. Supp. 896 (S.D.N.Y. 1935), in which both works told of a wife who, because of her husband’s illness, sacrifices her virtue in order to raise money for essential medical care. The husband goes away for treatment, and when he returns cured, finds his wife the mistress of his indirect benefactor and thereupon leaves his wife. The court held for the defendant, finding insufficient similarity. In West v. Hatch, 49 F. Supp. 307 (S.D.N.Y. 1943), the court in effect held no substantial similarity, although both works told the story of a cultured and formerly wealthy man (in one a Harvard man, in the other from an old Boston family) who lives in one of the New York makeshift shelters prevalent during the depression, and who becomes a butler in a wealthy household working under a scatterbrained mistress who does not know his true identity. See also Fendler v. Morosco, 253 N.Y. 281, 171 N.E. 56 (1930); Scott v. WKJG, Inc., 376 F.2d 467 (7th Cir. 1967), *cert. denied*, 389 U.S. 832 (1967); Harold Lloyd Corp. v. Witwer, 65 F.2d 1 (9th Cir. 1933), *cert. denied*, 296 U.S. 669 (1933). But cf. the analysis of similarities in Desny v. Wilder, 46 Cal. 2d 715, 748–749, 299 P.2d 257, 276 (1956); although this was a contract action, the similarities areas to plaintiff’s “synopsis,” *i.e.*, literary property. See also the listing of similarities in a design copyright infringement in John Wolf Textiles, Inc. v. Andris Fabrics, Inc. 139 U.S.P.Q. 365 (S.D.N.Y. 1962). But cf. Condotti, Inc. v. Slifka, 223 F. Supp. 412 (S.D.N.Y. 1963). [↑](#footnote-ref-57)
57. 31Miller Brewing Co. v. Carling O’Keefe Breweries of Canada, Ltd., 452 F. Supp. 429 (W.D.N.Y. 1978); Midas Prods., Inc. v. Baer, 437 F. Supp. 1388 (C.D. Cal. 1977); Musto v. Meyer, 434 F. Supp. 32 (S.D.N.Y. 1977) (“ideas and basic plots, or even isolated incidents” not protected by copyright), *aff’d*, 598 F.2d 609 (1979); Tralins v. Kaiser Aluminum & Chem. Corp., 160 F. Supp. 511 (D. Md. 1958); Schwarz v. Universal Pictures Co., 85 F. Supp. 270 (S.D. Cal. 1949). Compare also the similarities in Reyher v. Children’s Television Workshop, 533 F.2d 87 (2d Cir. 1976), *cert. denied*, 429 U.S. 980 (1976), which were sufficiently concrete but quantitatively insufficient. [↑](#footnote-ref-58)
58. 32Ornstein v. Paramount Prods., 9 F. Supp. 896 (S.D.N.Y. 1936). [↑](#footnote-ref-59)
59. 33Dymow v. Bolton, 11 F.2d 690 (2d Cir. 1926) (see explanation of *Dymow* in Nichols v. Universal Pictures Co., 45 F.2d 119 (2d Cir. 1930)); Wiren v. Shubert Theatre Corp., 5 F. Supp. 358 (S.D.N.Y. 1933) (“A plot or the mere concept of a situation” held not protectible), *aff’d,* 70 F.2d 1023 (1934) (*per curiam*); Gropper v. Warner Bros., 38 F. Supp. 329 (S.D.N.Y. 1941) (“fundamental plot” not protected). See § 13.03[B][2][a] *infra*. [↑](#footnote-ref-60)
60. 33.1Zella v. E.W. Scripps Co., 529 F. Supp. 2d 1124, 1135 (C.D. Cal. 2007) (Treatise quoted). [↑](#footnote-ref-61)
61. 34Shipman v. RKO, 100 F.2d 533, 537 (2d Cir. 1938); Reyher v. Children’s Television Workshop, 387 F. Supp. 869 (S.D.N.Y. 1975), *aff’d*, 533 F.2d 87 (2d Cir. 1976), *cert. denied*, 429 U.S. 980, 97 S. Ct. 492, 50 L. Ed. 2d 588 (1976); see Frankel v. Irwin, 34 F.2d 142 (S.D.N.Y. 1918). [↑](#footnote-ref-62)
62. 35Shaw v. Lindheim, 919 F.2d 1353, 1363 (9th Cir. 1990) (Treatise quoted). *E.g.*, Twentieth Century-Fox Film Corp. v. MCA, Inc., 715 F.2d 1327 (9th Cir. 1983); Twentieth Century-Fox Film Corp. v. Stonesifer, 140 F.2d 579 (9th Cir. 1944); Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49 (2d Cir. 1936); Smith v. Little, Brown & Co., 245 F. Supp. 451 (S.D.N.Y. 1965), *aff’d*, 360 F.2d 928 (2d Cir. 1966); International Film Serv. Co. v. Affiliated Distribs., 283 F. 229 (S.D.N.Y. 1922); see Nichols v. Universal Pictures Corp., 45 F.2d 119 (2d Cir. 1930); Dam v. Kirke La Shelle Co., 175 F. 902 (2d Cir. 1910); Reyher v. Children’s Television Workshop, 387 F. Supp. 869 (S.D.N.Y. 1975), *aff’d*, 533 F.2d 87 (2d Cir. 1976), *cert. denied*, 429 U.S. 98097 S. Ct. 492, 50 L. Ed. 2d 588 (1976). In Breffort v. I Had a Ball Co., 271 F. Supp. 623 (S.D.N.Y. 1967), it is stated that copyright protects “plaintiff’s development of the plot, of characters, of sequences of scenes and incidents, and of the interplay of characters … .” See also Fink v. Goodson-Todman Enters., Ltd., 9 Cal. App. 3d 996, 88 Cal. Rptr. 679 (1970) (Treatise cited). [↑](#footnote-ref-63)
63. 36Grove Press, Inc. v. Greenleaf Publishing Co., 247 F. Supp. 518 (E.D.N.Y. 1965). See also Bevan v. Columbia Broadcasting Sys., Inc., 329 F. Supp. 601 (S.D.N.Y. 1971) (“the dramatic mood, the details and interplay of the characters, and the dynamic of events”). [↑](#footnote-ref-64)
64. 37The Court of Appeals for the Second Circuit has accepted a definition of “story” in its “broadest sense” as “any account of actions in a time sequence, any narrative of events in a sequential arrangement; … the collection of things that happen in the work.” Burroughs v. Metro-Goldwyn-Mayer, Inc., 683 F.2d 610, 628 (2d Cir. 1982), *quoting from* C. Holman, *A Handbook to Literature* 428 (4th ed. 1980). See also Smith v. Weinstein, 578 F. Supp. 1297 (S.D.N.Y. 1984)*, aff’d,* 738 F.2d 419 (2d Cir. 1984) (“[Plaintiff] must show that they took more than his general theme; he must prove ‘similarities of treatment, details, scenes, events, and characterization.’ ”). [↑](#footnote-ref-65)
65. 37.1TMTV, Corp. v. Mass Prods., Inc., 345 F. Supp. 2d 196, 213 (D.P.R. 2004)*, aff’d,* 645 F.3d 464 (1st Cir. 2011). [↑](#footnote-ref-66)
66. 38Roth Greeting Cards v. United Card Co., 429 F.2d 1106 (9th Cir. 1970). For an image of the rival greeting cards at issue in this case, see Margot E. Kaminsky & Guy Rub, *Copyright’s Framing Problem*, 64 UCLA L. Rev. 1102, 1123 (2017). [↑](#footnote-ref-67)
67. 39*Id*. at 1110. (“[T]he characters depicted in the art work, the mood they portrayed, the combination of art work conveying a particular mood with a particular message, and the arrangement of the works on the greeting card are substantially the same as in Roth’s cards … . With the exception of minor variations in color and style, defendant’s card is identical.”). [↑](#footnote-ref-68)
68. 40*Id*. [↑](#footnote-ref-69)
69. 41Reyher v. Children’s Television Workshop, 533 F.2d 87 (2d Cir.), *cert. denied*, 429 U.S. 980, 97 S. Ct. 492, 50 L. Ed. 2d 588 (1976). See Green v. Lindsey, 885 F. Supp. 469, 481 (S.D.N.Y. 1992) (two high-tech bodice-rippers)*, aff’d mem.,* 9 F.3d 1537 (2d Cir. 1993), *cert. denied*, 510 U.S. 1202, 114 S. Ct. 1318, 127 L. Ed. 2d 667 (1994). [↑](#footnote-ref-70)
70. 42See § 13.03[A][1][b] *supra*. [↑](#footnote-ref-71)
71. 43533 F.2d at 91 (citations omitted), *quoting Roth Greeting Cards.* [↑](#footnote-ref-72)
72. 44562 F.2d 1157 (9th Cir. 1977). [↑](#footnote-ref-73)
73. 45*Id*. at 1161; see *id*. at 1167 n.9 (“imaginary worlds inhabited by anthromorphic [sic] plants and animals and other fanciful creatures”). [↑](#footnote-ref-74)
74. 46See § 13.03[E][3][b] *infra*. [↑](#footnote-ref-75)
75. 47562 F.2d at 1164. [↑](#footnote-ref-76)
76. 48*Id.* at 1166–1167, quoting *Roth Greeting Cards.* [↑](#footnote-ref-77)
77. 49547 F. Supp. 222 (D. Md. 1981). Cf. Warner Bros v. American Broadcasting Cos., 720 F.2d 231 (2d Cir. 1983), which, in rejecting plaintiff’s argument that differences between plaintiff’s and defendant’s works would likely be overlooked by an audience of children, stated that if plaintiff’s work were “aired on Saturday mornings among the cartoon programs, we would have greater concern for [this] risk …” *Id.* at 244. [↑](#footnote-ref-78)
78. 50The plaintiff in *Atari* registered its copyright only by depositing a video tape of the audiovisual work. The computer program itself was not registered. See 547 F. Supp. at 226. [↑](#footnote-ref-79)
79. 51*Id*. at 228. [↑](#footnote-ref-80)
80. 52*E.g.*, Atari, Inc. v. North Am. Philips Consumer Elec. Corp., 672 F.2d 607 (7th Cir. 1982), *cert. denied*, 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 145 (1982). “Video games, unlike an artist’s painting or even other audiovisual works, appeal to an audience that is fairly undiscriminating insofar as their concern about more subtle differences in artistic expression. The main attraction of a game such as PAC-MAN lies in the stimulation provided by the intensity of the competition. A person who is entranced by the play of the game ‘would be disposed to overlook’ many of the minor differences in detail and ‘regard their aesthetic appeal as the same.’ ” *Id*. at 619 (defendant’s video game held to capture the “total concept and feel” of plaintiff’s game). [↑](#footnote-ref-81)
81. 53648 F. Supp. 1127 (N.D. Cal. 1986). [↑](#footnote-ref-82)
82. 54*Id*. at 1136–37. *Accord* Digital Communications Assoc. v. Softklone Distrib. Corp., 659 F. Supp. 449, 465 (N.D. Ga. 1987). [↑](#footnote-ref-83)
83. 55E.F. Johnson Co. v. Uniden Corp., 623 F. Supp. 1485, 1492–93, 1501 n.16 (D. Minn. 1985) (addressing inadequacies of this test in the computer context). [↑](#footnote-ref-84)
84. 55.1See National Theme Prods., Inc. v. Jerry B. Beck, Inc., 696 F. Supp. 1348 (S.D. Cal. 1988) (invoking this standard for masquerade costumes); Jones v. CBS, Inc., 733 F. Supp. 748 (S.D.N.Y. 1990) (finding different “feels” in two television format ideas); Recycled Paper Prods., Inc. v. Pat Fashions Indus., Inc., 731 F. Supp. 624, 626 (S.D.N.Y. 1990) (finding substantial similarity in “look and feel” of two teddy bears); Whitehead v. CBS/Viacom, Inc., 315 F. Supp. 2d 1, 9 (D.D.C. 2004) (two plays about Marilyn Monroe “very different in total concept and feel”); Little Souls, Inc. v. Les Petits, 789 F. Supp. 56, 59 (D. Mass. 1992) (defendant’s “dolls do not share the look and feel [of plaintiff’s] dolls even though the look and feel of [defendant’s] dolls was achieved by Mrs. Gray by using construction techniques and materials which she copied from” plaintiff); Mistretta v. Curole, 22 U.S.P.Q.2d 1707, 1708 (E.D. La. 1992) (protecting “look and feel” of poster); Soloflex Inc. v. Nordictrack Inc., 31 U.S.P.Q.2d 1721, 1727 (D. Or. 1994) (television commercial). See also Cartier v. Jackson, 59 F.3d 1046, 1050 (10th Cir. 1995). Cf. Branch v. Ogilvy & Mather, Inc., 765 F. Supp. 819 (S.D.N.Y. 1990) (“the ‘total concept and feel’ of plaintiff’s cookbook is protected by copyright law”); Cosgrove v. Warner Bros., Inc., 13 U.S.P.Q.2d 1555, 1558 (E.D.N.Y. 1989) (“one cannot even ascertain what the … total concept and feel of Cosgrove’s knight and princess are”). [↑](#footnote-ref-85)
85. 56See § 13.03[F] N. 271 *infra* (defining source and object code). [↑](#footnote-ref-86)
86. 57Kepner-Tregoe, Inc. v. Carabio, 1979 Copyright L. Dec., (CCH) ¶ 25,107 at 15,638–39 (E.D. Mich. 1979) (“total concept and feel” applicable to artistic works, not to useful arts). In the course of evaluating the similarity of two management training programs for problem-solving techniques, the *Kepner-Tregoe* court stated an admonition well directed at courts deciding computer copyright cases: “In cases like this one, more penetrating analysis is called for. Instinct alone will not serve. Unthinking application of the ‘substantial similarity’ test may produce the wrong result.” *Id*. at 15,637. See Lotus Dev. Corp. v. Paperback Software Int’l, 740 F. Supp. 37, 62 (D. Mass. 1990) (“I have not found the ‘look and feel’ concept, standing alone, to be significantly helpful in distinguishing between nonliteral elements of a computer program that are copyrightable and those that are not.”). But see Lotus Dev. Corp. v. Borland Int’l, Inc., 799 F. Supp. 203, 220 (D. Mass. 1992) (follow-up case to previous cite) (defendant appropriated to a great extent the “feel,” and to lesser extent the “look” of plaintiff’s work), *rev’d*, 49 F.3d 807 (1st Cir.)*, aff’d,* 516 U.S. 233 (1996). [↑](#footnote-ref-87)
87. 57.1An example might be “fall patterns” on a sweater. Knitwaves, Inc., v. Lollytogs Ltd., 71 F.3d 996, 1003–05 (2d Cir. 1995). Although the reproductions appended to the court’s opinion do not strike this writer as substantially similar, the discerning judge who authored the opinion that held them to be infringing warned that the color scheme, distinctive stitching of leaves partially hanging off the fabric, and other such matters were not captured in the black-and-white appendix. *Id*. at 1004 & n.4. [↑](#footnote-ref-88)
88. 58See § 13.03[E][4] *infra.* Johnson Controls, Inc. v. Phoenix Control Sys., Inc., 886 F.2d 1173, 1174, 1176 (9th Cir. 1989), affirms the special master’s conclusion that defendant’s program captures the “total concept and feel” of plaintiff’s “system of computer programs to control wastewater treatment plants.” No basis is furnished for that surprising conclusion. By contrast, Harper House, Inc. v. Thomas Nelson, Inc., 889 F.2d 197, 206–07 (9th Cir. 1989), reverses the trial court’s jury instructions framed in terms of “total impact and effect” of defendant’s product, given the potential of that language for having the jury focus on unprotectible elements. [↑](#footnote-ref-89)
89. 58.1Attia v. Society of N.Y. Hosp., 201 F.3d 50, 54 (2d Cir. 1999) (Treatise quoted), *cert. denied*, 531 U.S. 843, 121 S. Ct. 109, 148 L. Ed. 2d 67 (2000). Cf. Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991), a case denying protection not geared at original expression, which refers to originality as “[t]he sine qua non of copyright,” “the touchstone of copyright protection,” and the “bedrock principle of copyright.” *Id*. at 345, 347. [↑](#footnote-ref-90)
90. 59For a discussion of the idea-expression dichotomy, see § 2A.06[A][3][a] *supra*. [↑](#footnote-ref-91)
91. 60See 17 U.S.C. § 102(b), explicated in § 2A.06[A][3][a] *supra*. See also § 19E.03[B] *infra* (constitutional grounds for protecting ideas). [↑](#footnote-ref-92)
92. 60.1Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc., 338 F.3d 127, 134 (2d Cir. 2003) (Treatise quoted, as discussed below in the text accompanying Ns. 63.8–63.10); Leigh v. Warner Bros., Inc., 212 F.3d 1210, 1215 (11th Cir. 2000) (Treatise quoted); Shine v. Childs, 382 F. Supp. 2d 602, 613 (S.D.N.Y. 2005) (Treatise quoted); Well-Made Toy Mfg. Corp. v. Goffa Int’l Corp., 210 F. Supp. 2d 147, 162 (E.D.N.Y. 2002) (Treatise quoted), *aff’d*, 354 F.3d 112 (2d Cir. 2003); Micro Consulting, Inc. v. Zubeldia, 813 F. Supp. 1514, 1527 (W.D. Okla. 1990) (Treatise quoted), *aff’d mem.,* 959 F.2d 245 (10th Cir. 1992); Autoskill, Inc. v. National Educ. Support Sys., Inc., 793 F. Supp. 1557, 1570 (D.N.M. 1992) (Treatise cited), *aff’d,* 994 F.2d 1476 (10th Cir.), *cert. denied*, 510 U.S. 916, 114 S. Ct. 307, 126 L. Ed. 2d 254 (1993). [↑](#footnote-ref-93)
93. 61It is submitted that the court in Litchfield v. Spielberg, 736 F.2d 1352, 1357 (9th Cir. 1984), *cert. denied*, 470 U.S. 1052, 105 S. Ct. 1753, 84 L. Ed. 2d 817 (1985), was incorrect in concluding that “[t]o constitute infringement of expression, the total concept and feel of the works must be substantially similar.” Cf. Cooling Sys., & Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 493 (9th Cir. 1985) (“total concept and feel of the works” unimportant in context of infringement alleged in that case). [↑](#footnote-ref-94)
94. 62Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc., 338 F.3d 127, 134–135 (2d Cir. 2003) (Treatise quoted). Cf. Worth v. Selchow & Righter Co., 827 F.2d 569, 574 n.7 (9th Cir. 1987) (Treatise cited). See also Landsberg v. Scrabble Crossword Game Players, Inc., 736 F.2d 485, 488 (9th Cir. 1984) (“A resemblance in details of setting incident, or characterization that falls short of close paraphrase may be enough to establish substantial similarity and infringement.”)*, cert. denied,* 469 U.S. 1037, 105 S. Ct. 513, 83 L. Ed. 2d 403 (1984). [↑](#footnote-ref-95)
95. 62.1A case against the *Harry Potter* novels labeled this standard “the most important factor” for works created primarily for children. Allen v. Scholastic Inc., 739 F. Supp. 2d 642, 656 (S.D.N.Y. 2011). It rejected substantial similarity based on no overlap in total concept and feel, *id.* at 657–659, but then reached the same result under a more analytic framework, *id.* at 659–665. [↑](#footnote-ref-96)
96. 62.2Some courts nominally pay deference to it, but decide on other bases. See, *e.g.*, Olson v. National Broadcasting Co., 855 F.2d 1446, 1453 (9th Cir. 1988) (affirming j.n.o.v. in defendants’ favor based on similarity in idea and scenes a faire); Narell v. Freeman, 872 F.2d 907, 913 (9th Cir. 1989) (invoking this standard in *dictum*, after having already concluded that defendant should not be held liable); see *id*. at 915 (Hall, J., specially concurring). [↑](#footnote-ref-97)
97. 62.3Consider the treatment of juvenile art works in Cavalier v. Random House, Inc., 297 F.3d 815 (9th Cir. 2002). Although the court nominally engages in filtering, *id*. at 826, and disclaims protection for “the concept of a built-in night light” appearing in a children’s book, *id*. at 827, it held that “the choice of a smiling moon or star face with pinkish cheeks surrounded by stars in a specific configuration, and situated above an encircled star ‘on’ button, constitutes protectible expression,” *id*. at 827. Given that the two drawings described thereby do not strike this observer as particularly similar, see *id*. at 830, the change in terminology does not necessarily produce the correct result. [↑](#footnote-ref-98)
98. 6335 F.3d 1435, 1445 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995). [↑](#footnote-ref-99)
99. 63.1See N. 38 *supra*. [↑](#footnote-ref-100)
100. 63.2The opinion below (which this case affirmed) noted that stubbornly sticking to buzz words such as “look and feel” or “gestalt theory” cannot automatically preclude summary judgment. 799 F. Supp. 1006, 1016, 1020 n.11, 1026 (N.D. Cal. 1992) (Treatise cited). [↑](#footnote-ref-101)
101. 63.3Sony Pictures Entm’t, Inc. v. Fireworks Entm’t Group, Inc., 137 F. Supp. 2d 1177, 1195 (C.D. Cal. 2001). [↑](#footnote-ref-102)
102. 63.4Note the case in which plaintiff alleged violation of the trade dress in the “look and feel” of its website. See Blue Nile, Inc. v. Ice.com, Inc., 478 F. Supp. 2d 1240 (W.D. Wash. 2007). Given its further concession that that subject matter fell “outside the purview of the Copyright Act,” it claimed that its trade dress complaint was immune from pre-emption under the Copyright Act. *Id*. at 1244–1245 & n.5 (Treatise cited). See § 1.15[E][3] *supra*. Because no factual record had yet been developed, the court declined to dismiss the complaint at the pleading stage. 478 F. Supp. 2d at 1247. [↑](#footnote-ref-103)
103. 63.5Sturdza v. United Arab Emirates, 281 F.3d 1287, 1297–1299 (D.C. Cir. 2002). See also Cornerstone Home Builders, Inc. v. McAllister, 303 F. Supp. 2d 1317, 1320, 1321 (M.D. Fla. 2004). [↑](#footnote-ref-104)
104. 63.6See Boisson v. Banian, Ltd, 273 F.3d 262, 266, 275 (2d Cir. 2001); Hamil Am. Inc. v. GFI, 193 F.3d 92, 102, 103 (2d Cir. 1999), *cert. denied*, 528 U.S. 1160, 120 S. Ct. 1171, 145 L. Ed. 2d 1080 (2000); Streetwise Maps, Inc. v. Vandam, Inc., 159 F.3d 739, 748 (2d Cir. 1998); Kerr v. New Yorker Magazine, Inc., 63 F. Supp. 2d 320, 325 (S.D.N.Y. 1999). [↑](#footnote-ref-105)
105. 63.7Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc., 338 F.3d 127, 134 (2d Cir. 2003) (Treatise quoted). For an image of the work at issue there, at various levels of “zooming,” see Margot E. Kaminsky & Guy Rub, *Copyright’s Framing Problem*, 64 UCLA L. Rev. 1102, 1122 (2017). The authors compare the zooming in this case to that at issue in other cases, thereby drawing interesting conclusions throughout the law of copyright. [↑](#footnote-ref-106)
106. 63.8“The court, confronted with an allegedly infringing work, must analyze the two works closely to figure out in what respects, if any, they are similar, and then determine whether these similarities are due to protected aesthetic expressions original to the allegedly infringed work, or whether the similarity is to something in the original that is free for the taking.” *Id*. at 134–135. [↑](#footnote-ref-107)
107. 63.9See § 13.03[F] *infra*. [↑](#footnote-ref-108)
108. 63.10The court below granted summary judgment for defendant on the basis that the similarity between its rugs and plaintiff’s inhered in their public domain elements. 237 F. Supp. 2d 376 (S.D.N.Y. 2002). The Second Circuit reversed, performing detailed analysis of the similarities: “There is one substantial respect in which the creator of the Heriz made distinctly idiosyncratic and particular design decisions—decisions whose effect permeates the entire field of the Heriz—and in this respect the Bromley is a virtually exact copy of the Heriz. The plaintiff not only cropped and elongated the Battillossi half-field, he also *selectively eliminated* numerous design motifs, creating a more open, less busy aesthetic.” 338 F.3d at 136 (emphasis original). The appellate court reached its result based on “close visual inspection of the two rugs” in their complex details, rather than based on their “total feel.” *Id*. Indeed, it refused to give decisive weight to a difference between the two rugs that purportedly altered the “overall feel” at issue. *Id*. at 137. [↑](#footnote-ref-109)
109. 63.11Canal+ Image UK Ltd. v. Lutvak, 773 F. Supp. 2d 419, 440 (S.D.N.Y. 2011). This decision contains a sophisticated analysis, focusing *Tufenkian* on its context of a rug presenting holistic visual elements, as contrasted with a film or literary work that can be more easily divided into levels of abstraction. *Id.* at 437–439 (Treatise cited). See § 3.04[A] *supra* (discussing facts of this case). [↑](#footnote-ref-110)
110. 63.12One case invokes the phrase in adverting to plaintiff’s creative choices in its instruction manuals to operate computer software, see Logical Operations Inc. v. 30 Bird Media, LLC, 354 F. Supp. 3d 286, 293, 300 (W.D.N.Y. 2018), only to conclude that plaintiff failed to raise a material issue that its protectable expression had been appropriated, *id.* at 302–04. [↑](#footnote-ref-111)
111. 63.13For example, in the context of analytic dissection (see § 13.03[E] *supra*), the Second Circuit commented, “we are principally guided by comparing the contested design’s total concept and overall feel with that of the allegedly infringed work.” Peter F. Gaito Architecture, LLC v. Simone Dev. Corp., 602 F.3d 57, 66 (2d Cir. 2010) (internal quotation marks omitted). [↑](#footnote-ref-112)
112. 63.14See HIT Entm’t, Inc. v. National Discount Costume Co., Inc., 552 F. Supp. 2d 1099, 1107 (S.D. Cal. 2008) (denying summary judgment insofar as triable issues existed whether total concept and feel of costumes were similar). [↑](#footnote-ref-113)
113. 64See § 13.03[E][4] *infra*. [↑](#footnote-ref-114)
114. 65This same field is plowed more deeply in § 13.03[F] *infra*. Nonetheless, the discussion herein completes the treatment of the various tests applied to determine comprehensive nonliteral similarity. [↑](#footnote-ref-115)
115. 66623 F. Supp. 1485 (D. Minn. 1985). [↑](#footnote-ref-116)
116. 67*Id*. at 1493. The test is derived from Note, *Copyright Infringement of Computer Programs: A Modification of the Substantial Similarity Test,* 68 Minn. L. Rev. 1264, 1294–1300 (1984). [↑](#footnote-ref-117)
117. 68623 F. Supp. at 1493. [↑](#footnote-ref-118)
118. 69See §§ 13.03[B][2], 13.03[F] *infra*. [↑](#footnote-ref-119)
119. 70See Whelan Assocs. v. Jaslow Dental Lab., 797 F.2d 1222 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031 (1987). See § 13.03[F] *infra*. [↑](#footnote-ref-120)
120. 71623 F. Supp. at 1493. [↑](#footnote-ref-121)
121. 72*Id*. (“Under the iterative approach, … the factfinder’s focus shifts from the hypothetical ordinary observer’s impressions of the “total concept and feel” of the copyrighted and allegedly infringing works to an analysis of the ‘quantitative and qualitative evidence of similarities’ as gauged by the Court’s evaluation of expert testimony. The fiction of the lay observer is thus abandoned in favor of an analysis of similarities and differences in the copyrighted and allegedly offending computer programs.”) See § 13.03[E][3] *infra.* [↑](#footnote-ref-122)
122. 73797 F.2d 1222 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031, 107 S. Ct. 877, 93 L. Ed. 2d 831 (1987). [↑](#footnote-ref-123)
123. 74*Id*. at 1233–1242. The court used those three synonymous terms interchangeably. *Id*. at 1224 n.1. In Computer Assoc. Int’l v. Altai, Inc., 775 F. Supp. 544, 559–560 (E.D.N.Y. 1991)*, aff’d in part, rev’d in part on other grounds,* 982 F.2d 693 (2d Cir. 1992), the expert witness appointed by the court described a computer program as both “text” and “behavior.” Analyzing each, he concluded that *Whelan*’s definition of these terms as interchangeable is “exactly wrong technically; it is precisely because a program is not only text, but also behaves, that these terms (in all their meanings) are not synonymous.” See *id.* at 558 (*Whelan* “now seems to be a simplistic test for similarity between computer programs”). Further discussion of this case appears in the text *infra.* In Gates Rubber Co. v. Bando Am., Inc., 798 F. Supp. 1499, 1514 (D. Colo. 1992), the same expert witness testified for plaintiff; although ruling for plaintiff, the district court nonetheless rejected *Altai* and preferred *Whelan*; the appellate court vacated and followed *Altai.* 9 F.3d 823 (10th Cir. 1993). [↑](#footnote-ref-124)
124. 75797 F.2d at 1229. See Johnson Controls, Inc. v. Phoenix Control Sys., Inc., 886 F.2d 1173, 1175 (9th Cir. 1989) (affirming district court’s finding that “the structure, sequence and organization of the [program] was expression, and thus subject to protection”). In United States v. Hux, 940 F.2d 314, 319 (8th Cir. 1991), the court sustained a criminal copyright conviction over defendant’s protest that only 205 bytes were similar to the copyright claimant’s 16,384 bytes. [↑](#footnote-ref-125)
125. 76There was ample evidence of copying of protected expression to support the district court’s decision in *Whelan* without the excursion into uncharted waters taken by the court of appeals. For instance, the invoicing routines in both plaintiff’s and defendant’s programs performed exactly the same functions with the same dates, line by line and field by field. *Id*. at 1247. Both programs performed their end-of-month clerical functions in virtually the same order. *Id*. at 1248. For further analysis as to why this case reached the appropriate result, see Nimmer, Bernacchi & Frischling, *A Structured Approach to Analyzing the Substantial Similarity of Computer Software in Copyright Infringement Cases,* 20 Ariz. St. L.J. 625, 655–656 (1988). [↑](#footnote-ref-126)
126. 76.1See § 13.03[F][1][a] & N. 300.1 *infra*, discussing Healthcare Affiliated Servs., Inc. v. Lippany, 701 F. Supp. 1142 (W.D. Pa. 1988). [↑](#footnote-ref-127)
127. 77797 F.2d at 1233. [↑](#footnote-ref-128)
128. 78A patent owner is granted a monopoly on the making, use, or sale of his invention; unlike copyright law, this protection extends to an inventor’s idea, as long as it is embodied in a process or product. 35 U.S.C. § 154 (term lasting 17 to 20 years). Moreover, under patent law, even independent creation of the patented invention is not a defense to infringement charges. See Chisum, *Patents* §§ 1.01–1.06, 16.04. Note the following statement from the court that enjoys exclusive jurisdiction over all patent appeals: “An author cannot acquire patent-like protection by putting an idea, process, or method of operation in an unintelligible format and asserting copyright infringement against those who try to understand that idea, process, or method of operation.” Atari Games Corp. v. Nintendo of Am. Inc., 975 F.2d 832, 842 (Fed. Cir. 1992). [↑](#footnote-ref-129)
129. 79In order to receive a patent, an applicant must demonstrate, to the satisfaction of an examiner in the U.S. Patent and Trademark Office, that, among other things, the subject invention is novel and nonobvious. 35 U.S.C. §§ 102 and 103 (1981). An applicant is thus prevented from securing a monopoly on ideas that the public already has, and only those that add to the total body of society’s knowledge are rewarded. See Graham v. John Deere Co., 383 U.S. 1, 6, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966). [↑](#footnote-ref-130)
130. 80In return for the monopoly protection of a patent, a patentee must disclose to the public how to make and use his invention, which all will be free to do when the patent expires. See 35 U.S.C. § 112 (1981). By contrast, copyrights are accorded protection automatically upon creation, without any disclosure. See § 7.16[A][1]. Indeed, even those who choose to register their software with the Copyright Office need only deposit a small fraction of the total source code. See 37 C.F.R. § 202.20(c)(2)(vii)(A)(1) (only first and last 25 pages of source code reproduced on paper need be deposited); 37 C.F.R. § 202.20(c)(2)(vii)(A)(2) (of foregoing fifty pages, up to half of source code consisting of trade secrets may be blocked-out when deposited). [↑](#footnote-ref-131)
131. 81Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 712 (2d Cir. 1992) (“we think that copyright registration—with its indiscriminating availability—is not ideally suited to deal with the highly dynamic technology of computer science”). See Baker v. Selden, 101 U.S. 99, 102, 25 L. Ed. 841 (1879) (“To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has been officially made, would be a surprise and a fraud upon the public. That is the province of letters-patent, not of copyright. The claim to an invention … must be subject to the examination of the Patent Office before an exclusive right therein can be obtained …”). [↑](#footnote-ref-132)
132. 82See Rosch, *The Copyright Law On Trial,* PC Magazine, May 26, 1987, at 157. [↑](#footnote-ref-133)
133. 83The very purpose of copyright protection is to serve the public interest by fostering creativity through securing a just recompense to authors such as computer programmers. *Whelan*, 797 F.2d at 1238; *Uniden*, 623 F. Supp. at 1504. See § 1.03[A][1] *supra*. [↑](#footnote-ref-134)
134. 84797 F.2d at 1232. [↑](#footnote-ref-135)
135. 84.1See, *e.g.,* CMAX/Cleveland, Inc. v. UCR, Inc., 804 F. Supp. 337, 352 (M.D. Ga. 1992); Autoskill, Inc. v. National Educ. Support Sys., Inc., 793 F. Supp. 1557, 1566 (D.N.M. 1992), *aff’d,* 994 F.2d 1476, 1490–1491 (10th Cir.), *cert. denied*, 510 U.S. 916, 114 S. Ct. 307, 126 L. Ed. 2d 254 (1993) (for “this preliminary injunction appeal we need not decide which is precisely the correct method of analysis for a final copyright judgment”); Computer Assoc. Int’l v. Altai, Inc., 775 F. Supp. 544 (E.D.N.Y. 1991)*, aff’d in part, rev’d in part on other grounds,* 982 F.2d 693 (2d Cir. 1992). [↑](#footnote-ref-136)
136. 84.2See 982 F.2d at 712–714. [↑](#footnote-ref-137)
137. 84.3982 F.2d 693 (2d Cir. 1992). [↑](#footnote-ref-138)
138. 84.4The court does not intend to carve that approach in stone. Because “computer technology is a dynamic field which can quickly outpace judicial decisionmaking,” the court stated that “our opinion should not be read to foreclose the district courts of our circuit from utilizing a modified version.” *Id.* at 706. [↑](#footnote-ref-139)
139. 85See § 13.03[E] *infra*. [↑](#footnote-ref-140)
140. 86See § 13.03[F] *infra*. [↑](#footnote-ref-141)
141. 87If the similarity is as to a noncopyrightable portion, *e.g.,* to the facts contained in that type of collective work known as a compilation, then substantial similarity is lacking as a matter of law. See Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). [↑](#footnote-ref-142)
142. 88Pic Design Corp. v. Sterling Precision Corp., 231 F. Supp. 106 (S.D.N.Y. 1964). See § 3.02 *supra*. [↑](#footnote-ref-143)
143. 89See § 13.03[A][2] *infra*. [↑](#footnote-ref-144)
144. 90See Markham v. Borden, 206 F.2d 199 (1st Cir. 1953); Metro Associated Servs., Inc. v. Webster City Graphic, Inc., 117 F. Supp. 224 (N.D. Iowa 1953). But cf. Dow Jones & Co. v. Board of Trade, 546 F. Supp. 113 (S.D.N.Y. 1982) (Treatise cited); Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc., 626 F.2d 1171 (5th Cir. 1980); International Biotical Corp. v. Associated Mills, Inc., 239 F. Supp. 511 (N.D. Ill. 1964). [↑](#footnote-ref-145)
145. 91Universal Pictures Co. v. Harold Lloyd Corp., 162 F.2d 354 (9th Cir. 1947); see also Chappell & Co. v. Fields, 210 F. 864 (2d Cir. 1914); Malin v. Dubinsky, 203 N.Y.S.2d 501 (Sup. Ct. N.Y. County 1960); Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49 (2d Cir. 1936). Cf. Cain v. Universal Pictures Corp., 47 F. Supp. 1013 (S.D. Cal. 1942); Brady v. Daly, 175 U.S. 148, 20 S. Ct. 62, 44 L. Ed. 109 (1899); Dymow v. Bolton, 11 F.2d 690 (2d Cir. 1926). [↑](#footnote-ref-146)
146. 92Caruthers v. R. K. O. Radio Pictures, Inc., 20 F. Supp. 906 (S.D.N.Y. 1937) (little boy fanning the table to keep flies away with resulting comic effect); McConnor v. Kaufman, 49 F. Supp. 738 (S.D.N.Y. 1943) (character breaks or apparently breaks his leg and is thus forced to broadcast by remote control), *aff’d,* 139 F.2d 116 (1943); Rush v. Oursler, 39 F.2d 468 (S.D.N.Y. 1930) (“gimmick” whereby an actual murder apparently occurs in audience at stage play). [↑](#footnote-ref-147)
147. 92.1Best Cellars Inc. v. Grape Finds at Dupont, Inc., 90 F. Supp. 2d 431, 443, 460 (S.D.N.Y. 2000) (Treatise quoted). [↑](#footnote-ref-148)
148. 92.2“[T]he more exact a duplication of constituent pieces of a work the less overall similarity that may be required.” Engineering Dynamics, Inc. v. Structural Software, Inc., 46 F.3d 408, 410 (5th Cir. 1995). [↑](#footnote-ref-149)
149. 92.3Silver Ring Splint Co. v. Digisplint, Inc., 543 F. Supp. 2d 509, 517 (W.D. Va. 2008) (Treatise quoted). [↑](#footnote-ref-150)
150. 92.4Situation Mgmt. Sys., Inc. v. ASP. Consulting LLC, 560 F.3d 53, 59 n.2 (1st Cir. 2009) (Treatise quoted); Silver Ring Splint Co. v. Digisplint, Inc., 543 F. Supp. 2d 509, 517 n.12 (W.D. Va. 2008) (Treatise quoted). [↑](#footnote-ref-151)
151. 92.5Ringgold v. Black Entertainment Television, Inc., 126 F.3d 70, 75 (2d Cir. 1997) (Treatise cited); TufAmerica, Inc. v. Diamond, 968 F. Supp. 2d 588, 598 (S.D.N.Y. 2013) (Treatise quoted); Feder v. Videotrip Corp., 697 F. Supp. 1165 (D. Colo. 1988) (Treatise quoted). [↑](#footnote-ref-152)
152. 93Thus, in Rosemont Enters., Inc. v. Random House, Inc., 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009, 87 S. Ct. 714, 17 L. Ed. 2d 546 (1967), where the defendant concededly copied verbatim some 31 lines (about 256 words) and paraphrased some 8 lines (about 80 words), the court of appeals nevertheless reversed the district court’s granting of a preliminary injunction on the ground that there was “considerable doubt” whether the copied material was “a material and substantial portion” of the plaintiff’s work. But the court added to this expression of doubt the further consideration that because the two works in issue were both biographies, the defense of fair use might be established at trial. See § 13.05[A][1] *infra*. [↑](#footnote-ref-153)
153. 94See § 13.05 *infra.* [↑](#footnote-ref-154)
154. 95See Mathews Conveyer Co. v. Palmer-Bee Co., 135 F.2d 73 (6th Cir. 1943); Twentieth Century-Fox Film Corp. v. Stonesifer, 140 F.2d 579 (9th Cir. 1944); Nichols v. Universal Pictures Corp., 45 F.2d 119 (2d Cir. 1930); Toulmin v. Rike-Kumler Co. 137 U.S.P.Q. 533 (S.D. Ohio 1962), *aff’d*, 316 F.2d 232 (6th Cir. 1963). But cf. Elsmere Music, Inc. v. National Broadcasting Co., 482 F. Supp. 741 (S.D.N.Y. 1980), *aff’d*, 623 F.2d 252 (2d Cir. 1980), explicitly distinguishing between a “de minimis” defense, that the court finds inapplicable, and a fair use defense, that it accepts. [↑](#footnote-ref-155)
155. 95.1See Nelson v. PRN Prods., Inc., 873 F.2d 1141, 1143 (8th Cir. 1989) (rejecting plaintiff’s attempt to conflate fair use and substantial similarity)*, cert. denied,* 493 U.S. 994, 110 S. Ct. 544, 107 L. Ed. 2d 541 (1982). [↑](#footnote-ref-156)
156. 96Jacobsen v. Deseret Book Co., 287 F.3d 936, 943 (10th Cir.) (Treatise quoted), *cert. denied*, 537 U.S. 1066 (2002); Baxter v. MCA, Inc., 812 F.2d 421, 425 (9th Cir. 1987) (Treatise cited), *cert. denied*, 484 U.S. 954 (1987); Civility Experts Worldwide v. Molly Manners, LLC, 167 F. Supp. 3d 1179, 1215 (D. Colo. 2016) (Treatise quoted). [↑](#footnote-ref-157)
157. 96.1Roy Export Co. Establishment v. Columbia Broadcasting Sys., Inc., 503 F. Supp. 1137, 1145 (S.D.N.Y. 1980), *aff’d*, 672 F.2d 1095 (2d Cir. 1982), *cert. denied*, 459 U.S. 826 (1982). [↑](#footnote-ref-158)
158. 97Jacobsen v. Deseret Book Co., 287 F.3d 936, 945 (10th Cir.)*, cert. denied,* 537 U.S. 1066, 123 S. Ct. 623, 154 L. Ed. 2d 555 (2002) (Treatise quoted); Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607 (7th Cir. 1982) (Treatise cited), *cert. denied*, 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 145 (1982); Worth v. Selchow & Righter Co., 827 F.2d 569, 570 n.1 (9th Cir. 1987) (Treatise cited), *cert. denied*, 485 U.S. 977, 108 S. Ct. 1271, 99 L. Ed. 2d 482 (1988); Estate of Smith v. Cash Money Records, Inc., 253 F. Supp. 3d 737, 747 (S.D.N.Y. 2017) (Treatise quoted); Green Bullion Fin. Servs., LLC v. Money4Gold Holdings, Inc., 639 F. Supp. 2d 1356, 1362 (S.D. Fla. 2009) (Treatise quoted); Bach v. Forever Living Prods. U.S., Inc., 473 F. Supp. 2d 1127, 1137 (W.D. Wash. 2007) (Treatise quoted); Nikanov v. Simon & Schuster, 246 F.2d 501 (2d Cir. 1957); Malkin v. Dubinsky, 146 F. Supp. 111 (S.D.N.Y. 1956); Smith v. Little, Brown & Co., 245 F. Supp. 451 (S.D.N.Y. 1965) (Treatise cited), *aff’d*, 360 F.2d 928 (2d Cir. 1966); Werlin v. Reader’s Digest Ass’n, Inc., 528 F. Supp. 451 (S.D.N.Y. 1981) (Treatise cited). See the confused application of this principle in Turner v. Century House Publishing Co., 56 Misc. 2d 1071, 290 N.Y.S.2d 637 (Sup. Ct. Schuyler County 1968), in which the court acknowledges the test to be whether “the copied material was a substantial part of the plaintiff’s work,” but then finds for defendant on the ground that such material was not “a substantial part of the defendant’s book.” See § 13.03[B][1][a] *infra*. [↑](#footnote-ref-159)
159. 97.1Positive Black Talk Inc. v. Cash Money Records, Inc., 394 F.3d 357, 373 n.12 (5th Cir. 2004) (Treatise quoted), *disapproved on other grounds*, Reed Elsevier, Inc. v. Muchnick, 559 U.S. 154, 130 S. Ct. 1237, 1243 n.2, 176 L. Ed. 2d 18 (2010); TufAmerica, Inc. v. WB Music Corp., 67 F. Supp. 3d 590, 597 n.44 (S.D.N.Y. 2014) (Treatise cited as discussed in § 2.05[B] N. 23.1 *supra*); Newton v. Diamond, 204 F. Supp. 2d 1244, 1257 (C.D. Cal. 2002) (Treatise cited), *aff’d*, 388 F.3d 1189, 1195 (9th Cir. 2004), *cert. denied*, 545 U.S. 1114, 125 S. Ct. 2905, 162 L. Ed. 2d 294 (2005) (Treatise cited). [↑](#footnote-ref-160)
160. 98Toulmin v. Rike-Kumler Co., 137 U.S.P.Q. 533 (S.D. Ohio 1962), *aff’d*, 316 F.2d 232 (6th Cir. 1963) (copying of a sentence and a half from a book of 142 pages held *de minimis*); Vault Corp. v. Quaid Software Ltd., 847 F.2d 255, 267 (5th Cir. 1988) (30 characters out of 50 pages of source code held *de minimis*); Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985) (300 words out of 200,000 clearly substantial, and also too great to justify fair use defense, see § 13.05[A] *infra*). A shocking result was reached in Turner v. Century House Publishing Co., 56 Misc. 2d 1071 290 N.Y.S.2d 637 (Sup. Ct. Schuyler County 1968), holding that substantial copying of an entire chapter from plaintiff’s book into defendant’s otherwise independently created work does not constitute infringement. [↑](#footnote-ref-161)
161. 99Situation Mgmt. Sys., Inc. v. ASP. Consulting LLC, 560 F.3d 53, 59 (1st Cir. 2009) (Treatise quoted); Country Kids’ N City Slicks, Inc. v. Sheen, 77 F.3d 1280, 1287 (10th Cir. 1996) (Treatise quoted); Lyons v. American Coll. of Veterinary Sports Med. & Rehab., Inc., 997 F. Supp. 2d 92, 112 (D. Mass. 2014) (Treatise quoted); TufAmerica, Inc. v. Diamond, 968 F. Supp. 2d 588, 599 (S.D.N.Y. 2013) (Treatise quoted); Engenium Solutions, Inc. v. Symphonic Techs., Inc., 924 F. Supp. 2d 757, 785 (S.D. Tex. 2013) (Treatise quoted); Walker v. Time Life Films, Inc., 615 F. Supp. 430, 439 (S.D.N.Y. 1985) (Treatise cited), *aff’d*, 784 F.2d 44 (2d Cir. 1986), *cert. denied*, 476 U.S. 1159, 106 S. Ct. 2278, 90 L. Ed. 2d 721 (1986); Fink v. Goodson-Todman Enters., Ltd., 9 Cal. App. 3d 996, 88 Cal. Rptr. 679 (1970) (Treatise quoted). See Eisenschiml v. Fawcett Publications, Inc., 246 F.2d 598 (7th Cir. 1957); Malkin v. Dubinsky, 146 F. Supp. 111 (S.D.N.Y. 1956). [↑](#footnote-ref-162)
162. 99.1Iowa State Univ. Research Found., Inc. v. American Broadcasting Cos., 463 F. Supp. 902 (S.D.N.Y. 1978), *aff’d*, 621 F.2d 57 (2d Cir. 1980). See Monster Communications, Inc. v. Turner Broadcasting Sys., Inc., 935 F. Supp. 490, 496 (S.D.N.Y. 1996) (film clips aggregating 2 minutes infringing, but defensible as fair use, see § 13.05 *infra*). [↑](#footnote-ref-163)
163. 100Chicago Record-Herald Co. v. Tribune Ass’n, 275 F. 797 (7th Cir. 1921). See Educational Testing Serv. v. Katzman, 793 F.2d 533, 542 (3d Cir. 1986) (defendant claimed it copied at most “a handful of [test] questions out of thousands”; court finds qualitative significance to materials copied, given plaintiff’s need to generate a new test). [↑](#footnote-ref-164)
164. 101Newton v. Diamond, 388 F.3d 1189, 1194–1195 (9th Cir. 2004), *cert. denied*, 545 U.S. 1114, 125 S. Ct. 2905, 162 L. Ed. 2d 294 (2005) (Treatise quoted); TufAmerica, Inc. v. Diamond, 968 F. Supp. 2d 588, 605 (S.D.N.Y. 2013) (Treatise quoted); Bridgeport Music, Inc. v. Dimension Films, 230 F. Supp. 2d 830, 841 (M.D. Tenn. 2002), *aff’d in part, rev’d in part*, 410 F.3d 792 (6th Cir. 2005) (paragraph of Treatise quoted); Narell v. Freeman, 872 F.2d 907 (9th Cir. 1989); Caddy-Imler Creations, Inc. v. Caddy, 299 F.2d 79 (9th Cir. 1962); MacDonald v. Du Maurier, 75 F. Supp. 655 (S.D.N.Y. 1948). [↑](#footnote-ref-165)
165. 101.1Lyons v. American Coll. of Veterinary Sports Med. & Rehab., Inc., 997 F. Supp. 2d 92, 112 (D. Mass. 2014) (identical fragmented phrases along the lines of “The Credential Committee shall be composed of”); Suid v. Newsweek Magazine, 503 F. Supp. 146 (D.D.C. 1980) (16-word quotation); Werlin v. Reader’s Digest Ass’n, Inc., 528 F. Supp. 451 (S.D.N.Y. 1981) (copying two sentences). [↑](#footnote-ref-166)
166. 101.2Note that some cases erroneously look to the amount of *defendant’s* work that is copied. See Polk & Co. v. Musser, 105 F. Supp. 351 (E.D. Pa. 1952), *aff’d*, 196 F.2d 1020 (3d Cir. 1952). [↑](#footnote-ref-167)
167. 101.3G.R. Leonard & Co. v. Stack, 386 F.2d 38 (7th Cir. 1967) (copying of 5 town names out of 90,000 entries in defendant’s directory); Rokeach v. Avco Embassay Pictures Corp., 197 U.S.P.Q. 155 (S.D.N.Y. 1978) (copying 100 words out of 70,000). [↑](#footnote-ref-168)
168. 101.4But for a variant rule on sampling, see § 13.03[A][2][b] *infra*. [↑](#footnote-ref-169)
169. 101.5Gordon v. Nextel Communs., 345 F.3d 922, 924–925 (6th Cir. 2003). [↑](#footnote-ref-170)
170. 101.6See Fristot v. First Am. Natural Ferns Co., 251 F. Supp. 886, 888 (S.D.N.Y. 1966) (upholding liability even though differences between two works in issue may be greater than were found to exist in another case in which defendant escaped liability because, “There are differences and differences.”); Amana Refrigeration, Inc. v. Consumers Union of U.S., Inc., 431 F. Supp. 324 (N.D. Iowa 1977) (copying of one paragraph, consisting of three sentences, held to infringe); Higgins v. Baker, 309 F. Supp. 635 (S.D.N.Y. 1969) (Treatise cited) (liability may exist if qualitatively important, even though quantitatively it consists of less than 1% of plaintiff’s work). [↑](#footnote-ref-171)
171. 101.7VMG Salsoul, LLC v. Ciccone, 824 F.3d 871, 880 (9th Cir. 2016) (Treatise cited). [↑](#footnote-ref-172)
172. 102Folsom v. Marsh, 9 F. Cas. 342, No. 4901 (C.C. Mass. 1841). [↑](#footnote-ref-173)
173. 103See, *e.g.*, Bradbury v. Columbia Broadcasting Sys., Inc., 287 F.2d 478 (9th Cir. 1961)*, cert. denied,* 368 U.S. 801 (1961); West Publishing Co. v. Edward Thompson Co., 169 F. 833 (E.D.N.Y. 1909), *modified*, 176 F. 833 (2d Cir. 1910); Universal Pictures v. Harold Lloyd Corp., 162 F.2d 354 (9th Cir. 1949); Malkin v. Dubinsky, 146 F. Supp. 111 (S.D.N.Y. 1956); Perkins Marine Lamp & Hardware Co. v. Goodwin Stanley Co., 86 F. Supp. 630 (S.D.N.Y. 1949); M. Witmark & Sons v. Pastime Amusement Co., 298 F. 470 (E.D.S.C. 1924), *aff’d*, 1 F.2d 851 (1924). [↑](#footnote-ref-174)
174. 104See § 13.03[E] *infra*. [↑](#footnote-ref-175)
175. 105Cf. Continental Cas. Co. v. Beardsley, 253 F.2d 702 (2d Cir. 1958) (comprehensive nonliteral similarity). If the quantum of originality is very modest, it may be that “more than ‘substantial similarity’ should be necessary for a finding of infringement.” Thomas Wilson & Co. v. Irving J. Dorfman Co., 268 F. Supp. 711 (S.D.N.Y. 1967) (protection for lace design). The sentence in the text that precedes this footnote, and the immediately preceding sentence in this footnote, are both quoted in Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904 (3d Cir. 1975), *cert. denied*, 423 U.S. 863, 96 S. Ct. 122, 46 L. Ed. 2d 92 (1975). [↑](#footnote-ref-176)
176. 106See Brodsky v. Universal Pictures Co., 149 F.2d 600 (2d Cir. 1945); Gingg v. Twentieth Century-Fox Film Corp., 56 F. Supp. 701 (S.D. Cal. 1944). But cf. Bright Tunes Music Corp. v. Harrisongs Music, Ltd., 420 F. Supp. 177 (S.D.N.Y. 1976), *aff’d sub nom.* Abkco Music, Inc. v. Harrisongs Music, Ltd., 722 F.2d 988 (2d Cir. 1983). [↑](#footnote-ref-177)
177. 107Carew v. RKO, 43 F. Supp. 199 (S.D. Cal. 1942). [↑](#footnote-ref-178)
178. 108Fisher v. Dillingham, 298 F. 145 (S.D.N.Y. 1924). See § 2.05[B] *supra*. [↑](#footnote-ref-179)
179. 108.1McDonald v. Multimedia Entertainment, Inc., 20 U.S.P.Q.2d (BNA) 1372 (S.D.N.Y. 1991). [↑](#footnote-ref-180)
180. 108.2Baxter v. MCA, Inc., 812 F.2d 421, 425 (9th Cir. 1987) (Treatise cited in *dictum*)*, cert. denied,* 484 U.S. 954, 108 S. Ct. 346, 98 L. Ed. 2d 372 (1987); TufAmerica, Inc. v. Diamond, 968 F. Supp. 2d 588, 603 (S.D.N.Y. 2013) (Treatise cited). See Robertson v. Batten, Barton, Durstine & Osborn, Inc., 146 F. Supp. 795 (S.D. Cal. 1956) (copying of two identical bars held an infringement). See also Elsmere Music, Inc. v. National Broadcasting Co., 482 F. Supp. 741 (S.D.N.Y. 1980), *aff’d*, 623 F.2d 252 (2d Cir. 1980) (copying and repetition of four notes, and two words, held a sufficient quantum to constitute infringement, as these represented “the heart of the [plaintiff’s] composition,” but defendant’s parodying use held to constitute fair use); Associated Music Publishers, Inc. v. Debs Memorial Radio Fund, Inc., 141 F.2d 852 (2d Cir. 1944); Bright Tunes Music Corp. v. Harrisongs Music, Ltd., 420 F. Supp. 177 (S.D.N.Y. 1976), *aff’d sub nom.* Abkco Music, Inc. v. Harrisongs Music, Ltd., 722 F. 2d 988 (2d Cir. 1983); Boosey v. Empire Music Co., 224 F. 646 (S.D.N.Y. 1915). Cf. Marks v. Leo Feist, Inc., 290 F. 959 (2d Cir. 1923) (copying of six bars held not actionable); Anheuser-Busch, Inc. v. Elsmere Music, Inc., 633 F. Supp. 487 (S.D.N.Y. 1986) (copying of rhythm and similar notes in final bar of advertising jingle held not actionable). [↑](#footnote-ref-181)
181. 108.3Segrets, Inc. v. Gillman Knitwear Co., Inc., 207 F.3d 56, 65 n.9 (1st Cir.), *cert. denied*, 531 U.S. 827 (2000). [↑](#footnote-ref-182)
182. 108.3aThus, one court dismissed as “without merit” Google’s argument that it could not be held liable, inasmuch as the nine lines that it copied “represented an infinitesimal percentage of the 2.8 million lines of code in the 166 Java packages … .” Oracle Am., Inc. v. Google Inc., 750 F.3d 1339, 1379 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 2887 (2015). Nonetheless, one court questionably validated verbatim copying of 14 out of over 1,000 questions from a standardized test on the basis that it constituted a smaller percentage of copying than was validated in prior music rulings. See Louisiana Contrs. Licensing Serv., Inc. v. Am. Contrs. Exam Servs., Inc., 13 F. Supp. 3d 547, 553–54 (M.D. La. 2014), *aff’d unpub.*, 594 Fed. Appx. 243 (5th Cir. 2015). [↑](#footnote-ref-183)
183. 108.4Griffin v. J-Records, 398 F. Supp. 2d 1137, 1139 (E.D. Wash. 2005). [↑](#footnote-ref-184)
184. 108.4aAnother court denied substantial similarity based on differences in choruses, but then questionably added divergences in pronunciation of the word “hey,” thereby seemingly conflating composition with recording. See Brainard v. Vassar, 625 F. Supp. 2d 608, 620–621 (M.D. Tenn. 2009). The same conflation shows up in another case involving disputed claims about joint authorship of two musical compositions, which references the use of “various musical instruments to play the music … .” Sebastian Music Group, Inc. v. Ayala-Rodriguez, 594 F. Supp. 2d 176, 178, 180 (D.P.R. 2008). [↑](#footnote-ref-185)
185. 108.5See § 2.10 *supra*. [↑](#footnote-ref-186)
186. 108.6*Griffin v. J-Records*, 398 F. Supp. 2d at 1143. See § 8.05[A] *supra*. See also § 13.03[A][2][b] *infra*. [↑](#footnote-ref-187)
187. 109See § 2.05 *supra*. [↑](#footnote-ref-188)
188. 109.1398 F. Supp. 2d at 1141, 1143. [↑](#footnote-ref-189)
189. 109.2But if the similarity, by contrast, is of isolated words, no such conclusion follows. See Neal Publ’ns v. F&W Publ’ns, Inc., 307 F. Supp. 2d 928 (N.D. Ohio 2004) (140 copied or paraphrased topic headings of a few words each). [↑](#footnote-ref-190)
190. 110Warren v. White & Wyckoff Mfg. Co., 39 F.2d 922 (S.D.N.Y. 1930). [↑](#footnote-ref-191)
191. 111Warner Bros. v. American Broadcasting Cos., 720 F.2d 231 (2d Cir. 1983). [↑](#footnote-ref-192)
192. 112Alexandria Drafting Co. v. Amsterdam, 43 U.S.P.Q.2d 1247, 1254 (E.D. Pa. 1997) (Treatise cited). See, *e.g.*, Jackson v. Washington Monthly Co., 481 F. Supp. 647 (D.D.C. 1979) (copying of two sentences held noninfringing)*, aff’d mem.,* 675 F.2d 1340 (1982), *cert. denied*, 459 U.S. 909 (1982). [↑](#footnote-ref-193)
193. 113Dawn Associates v. Links, 203 U.S.P.Q. (BNA) 831 (N.D. Ill. 1978) (the sentence, a part of promotional advertising material for a motion picture, read: “When there is no room in hell … the dead will walk the earth”). See also Universal City Studios Inc. v. Kamar Industries Inc., 217 U.S.P.Q. (BNA) 1162 (S.D. Tex. 1982) (“I love you E.T.” and “E.T. Phone Home”). [↑](#footnote-ref-194)
194. 113.1Heim v. Universal Pictures Co., 154 F.2d 480 n.8 (2d Cir. 1946). See also Exxon Corp. v. Exxon Ins. Consultants Int’l, Ltd.,[1981] 2 All E.R. 495, suggesting that the copying of the “invented words” from Lewis Carroll’s “Through the Looking-Glass” might constitute copyright infringement, if the work were still in copyright. [↑](#footnote-ref-195)
195. 113.2But see Whitney v. Ross Jungnickel, Inc., 179 F. Supp. 751 (S.D.N.Y. 1960); Hartfield v. Peterson, 91 F.2d 998 (2d Cir. 1937); Life Music, Inc. v. Wonderland Music Co., 241 F. Supp. 653 (S.D.N.Y. 1965) (protection for a single word suggested as a possibility); Narell v. Freeman, 872 F.2d 907, 912 (9th Cir. 1989) (suggesting in *dictum* that quoting first two lines of poem would infringe); see *id*. at 911 (ordinary phrases accorded less protection than a “sequence of creative expression”); Alberto-Culver Co. v. Andrea Dumon, Inc., 466 F.2d 705 (7th Cir. 1972) (protection denied to the phrase “most personal sort of deodorant”); Tree Pub. Co. v. Warner Bros. Records, 785 F. Supp. 1272, 1275 (M.D. Tenn. 1991) (Treatise cited) (protection denied for “better class of losers”); Norman v. Columbia Broadcasting Sys., Inc., 333 F. Supp. 788 (S.D.N.Y. 1971) (protection denied to several “descriptive words”); Stratchborneo v. Arc Music Corp., 357 F. Supp. 1393 (S.D.N.Y. 1973) (unless it is “especially unique or qualitatively important, there is no basis for inferring copying” of a “small common phrase”); Gardner v. Nizer, 391 F. Supp. 940 (S.D.N.Y. 1975) (three passages held to constitute “insufficient similarity”). See Leeds Music, Ltd. v. Robin, 358 F. Supp. 650 (S.D. Ohio 1973) (“a claim of piracy cannot be based upon the use of common words and phrases, ripped untimely from their original contexts”). But see Harcourt, Brace & World, Inc. v. Graphic Controls Corp., 329 F. Supp. 517 (S.D.N.Y. 1971) (“A given word in Keats’ *Ode* is not perhaps copyrightable, but its use in a poetic line would be.”); American Greetings Corp. v. Kleinfab Corp., 400 F. Supp. 228 (S.D.N. Y. 1975) (phrase “Put on a Happy Face” held copyrightable). Cf. O’Brien v. Chappel & Co., 159 F. Supp. 58 (S.D.N.Y. 1958); Gingg v. Twentieth Century-Fox Film Corp., 56 F. Supp. 701 (S.D. Cal. 1944). See also Funkhouser v. Loew’s, Inc., 208 F.2d 185 (8th Cir. 1954); Kepner-Tregoe, Inc. v. Carabio, 203 U.S.P.Q. (BNA) 124 (E.D. Mich. 1979); Exxon Corp. v. Exxon Ins. Consultants Int’l, Ltd., [1981] 2 All E.R. 495; Signo Trading Int’l Ltd. v. Gordon, 535 F. Supp. 362 (N.D. Cal. 1981), denying protection to particular words. *Signo* opined: “It is inconceivable that anyone could copyright a single word or a commonly used short phrase, in any language.” [↑](#footnote-ref-196)
196. 114The activity of digital sampling stands in contrast to “sampling” in the sense of “trial listening.” For that latter usage in the context of Napster’s fair use defense, see § 13.05[G] *infra*. The type of sampling under discussion underlies mash-ups. See Madhavi Sunder, *IP3*, 59 Stan. L. Rev. 257, 303 (2006) (discussing D.J. Danger Mouse taking The Beatles’ *White Album* and mixing it with hip-hop artist Jay-Z’s *Black Album* to create *The Grey Album*). [↑](#footnote-ref-197)
197. 114.1See Henry Self, *Digital Sampling: A Cultural Perspective*, 9 UCLA Ent. L. Rev. 347 (2002) (tracing development of sampling from “riddims” through calypso to present). See generally Form 31-3 *infra*. [↑](#footnote-ref-198)
198. 114.2Sampling probably occurred in Acuff-Rose Music, Inc. v. Campbell, 972 F.2d 1429, 1433, 1438 (6th Cir. 1992), although it formed no basis for the Supreme Court’s reversal, Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994). [↑](#footnote-ref-199)
199. 114.3See Jarvis v. A & M Records, 827 F. Supp. 282, 289 (D.N.J. 1993) (Treatise cited); Tin Pan Apple, Inc. v. Miller Brewing Co., 30 U.S.P.Q.2d (BNA) 1791, 1795 (S.D.N.Y. 1994); Frost Belt Int’l Recording Enters., Inc. v. Cold Chillin’ Records, 758 F. Supp. 131 (S.D.N.Y. 1990). One case ridiculed defendants’ suggestion that sampling should be deemed nonactionable “because others in the ‘rap music’ business are also engaged in illegal activity … .” Grand Upright Music Ltd. v. Warner Bros. Records, Inc., 780 F. Supp. 182, 185 n.2 (S.D.N.Y. 1991). [↑](#footnote-ref-200)
200. 114.4383 F.3d 390 (6th Cir. 2004), *superseded*, 401 F.3d 647 (6th Cir. 2005), *superseded*, 410 F.3d 792 (6th Cir. 2005). No other case comes to mind in which the same appellate panel issued three rulings, each published in the *Federal Reporter*, absent intervening action from the District Court, the Supreme Court, or the Court of Appeals *en banc*. All three opinions affirmed in part and reversed in part the decision below, 230 F. Supp. 2d 830 (M.D. Tenn. 2002). [↑](#footnote-ref-201)
201. 114.5410 F.3d at 796. [↑](#footnote-ref-202)
202. 114.6230 F. Supp. 2d at 841 (looped 15 times, appearing at 5 separate points, each looped segment being about 7 seconds long).

     After listening to the copied segment, the sample, and both songs, the district court found that no reasonable juror, even one familiar with the works of George Clinton, would recognize the source of the sample without having been told of its source. This finding, coupled with findings concerning the quantitatively small amount of copying involved and the lack of qualitative similarity between the works, led the district court to conclude that Westbound could not prevail on its claims for copyright infringement of the sound recording.

     410 F.3d at 798. [↑](#footnote-ref-203)
203. 114.7*Id*. at 798. [↑](#footnote-ref-204)
204. 114.8410 F.3d at 800–01. [↑](#footnote-ref-205)
205. 114.917 U.S.C. § 114(b). [↑](#footnote-ref-206)
206. 114.10See § 8.05[A] *supra*. [↑](#footnote-ref-207)
207. 114.11“In other words, a sound recording owner has the exclusive right to ‘sample’ his own recording.” 410 F.3d at 801. [↑](#footnote-ref-208)
208. 114.12Moving from Section 114, consider a parallel provision limiting the rights of copyright holders against libraries:

     The rights of reproduction and distribution under this section apply to the *entire work, or to a substantial part of it*, made from the collection of a library or archives where the user makes his or her request or from that of another library or archives, if the library or archives has first determined, on the basis of a reasonable investigation, that a copy or phonorecord of the copyrighted work cannot be obtained at a fair price … .

     17 U.S.C. § 108(e) (emphasis added). Let us imagine a library that makes a copy of a single sentence from a book in its collection. Having failed to copy “the entire work, or … a substantial part of it,” that usage falls outside of the protection of Section 108(e). But the conclusion scarcely follows that its activity is automatically infringing. If copying that single sentence fails to cross the threshold of substantial similarity, it cannot be held liable. See § 13.03[A][2][a] *supra*.

     Parallel reasoning should apply to sampling. If a newcomer merely *imitates* some or all of a sound recording, it is categorically immune under Section 114(b). If it actually *duplicates* some of that sound recording, then it loses its defense under Section 114(b). But the conclusion scarcely follows that its activity is thereby rendered automatically infringing. Instead, the issue of substantial similarity again rises to the fore. [↑](#footnote-ref-209)
209. 114.13Batiste v. Lewis, 976 F.3d 493, 506 (5th Cir. 2020) (Treatise quoted); VMG Salsoul, LLC v. Ciccone, 824 F.3d 871, 884 (9th Cir. 2016) (Treatise quoted). [↑](#footnote-ref-210)
210. 114.14See, *e.g*., MacMillan Co. v. King, 223 F. 862, 866 (D. Mass. 1914) (“the copyright protects every substantial component part of the book”). [↑](#footnote-ref-211)
211. 114.15“The legislative history is of little help because digital sampling wasn’t being done in 1971.” 410 F.3d at 805. Although the panel was obviously correct that digital sampling was not practiced in the 1970s, it overlooked the fact there was no bar under contemporaneous technology from choosing either to recapture an entire sound recording or only a portion. VMG Salsoul, LLC v. Ciccone, 824 F.3d 871, 884 (9th Cir. 2016) (Treatise cited). Accordingly, it is eminently sensible to consult the legislative history—which, as the next footnote demonstrates, actually speaks to the issue. [↑](#footnote-ref-212)
212. 114.16H. Rep., p.106 (emphasis added). Congress evidently conceptualized the possibility of recapturing only a portion of a sound recording (see previous footnote) and decided to retain the universally applicable notion of substantial similarity under those circumstances. [↑](#footnote-ref-213)
213. 114.17Failure to advert to that same excerpt led the district court into error in Agee v. Paramount Communications, Inc., 853 F. Supp. 778, 786 (S.D.N.Y. 1994), *rev’d*, 59 F.3d 317 (2d Cir. 1995). See § 8.05[A] *supra*. [↑](#footnote-ref-214)
214. 114.18Another indicative excerpt from the legislative history is as follows: “The approach of the bill is to set forth the copyright owner’s exclusive rights in broad terms in section 106, and then to provide various limitations, qualifications, or exemptions in the 12 sections that follow. Thus, everything in section 106 is made ‘subject to sections 107 through 118,’ and must be read in conjunction with those provisions.” H. Rep., p. 61. Far from allowing courts to impose liability by reference solely to Section 114, the House Report teaches that Section 114 is designed to *limit* liability. (Of course, subsequent amendments have added more than the 12 sections that existed then in Chapter 1 of Title 17; but the basic point remains unchanged.). [↑](#footnote-ref-215)
215. 114.19Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). [↑](#footnote-ref-216)
216. 114.20Acknowledging that its holding “arguably sets forth a new rule,” the court avers that “we did not pull this interpretation out of thin air” by citing various law reviews. 410 F.3d at 802–803. Those sources cannot substitute for following the governing law. [↑](#footnote-ref-217)
217. 114.21Although unaddressed on appeal, the two-second guitar solo at issue in this case may be sufficiently original to qualify for copyright protection standing alone. See 230 F. Supp. 2d at 839 (“The rapidity of the notes and the way they are played produce a high-pitched, whirling sound that captures the listener’s attention and creates anticipation of what is to follow.”). Nonetheless, many two-second samples will undoubtedly fail that test. The vice of the appellate resolution in *Bridgeport Music* is that it fails to undertake that exposition for the snippet at bar, instead adopting a categorical rule that all two-second snippets, if sampled, lead to liability. Indeed, it holds that even shorter samples automatically infringe, potentially down to a single note. See 410 F.3d at 800 n.9 (“A question arises as to whether the copying of a single note would be actionable. Since that is not the fact situation in this case, we need not provide a definitive answer.”). [↑](#footnote-ref-218)
218. 114.22It is notable that the panel invented this manner of proceeding: “We do not set forth the arguments made by Westbound since our analysis differs somewhat from that offered by the plaintiff.” 383 F.3d at 397. In crafting its result, the panel admitted, “we followed no existing judicial precedents.” *Id*. at 400. [↑](#footnote-ref-219)
219. 114.23See Chap. 8 *supra*. Note that Section 106A enumerates special moral rights, as well. See Chap. 8D *supra*. [↑](#footnote-ref-220)
220. 114.24The first several headings are instructive:

     § 107. Limitations on exclusive rights: Fair use

     § 108. Limitations on exclusive rights: Reproduction by libraries and archives

     § 109. Limitations on exclusive rights: Effect of transfer of particular copy or phonorecord

     § 110. Limitations on exclusive rights: Exemption of certain performances and displays

     § 111. Limitations on exclusive rights: Secondary transmissions

     Title 17, United States Code. [↑](#footnote-ref-221)
221. 114.25See §§ 13.03[A][1][a]–13.03[A][2][a] *supra* [↑](#footnote-ref-222)
222. 114.26Its language states at the outset, “The exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), (3) and (6) of section 106 … .” 17 U.S.C. § 114(a). *Bridgeport Music* focuses primarily on the next paragraph; but it too is phrased to emphasize that “[t]he exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 *is limited* to the right to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality.” 17 U.S.C. § 114(b) (emphasis added). That language of limitation connotes no intent to expand copyright owners’ rights, contrary to the panel’s ruling. [↑](#footnote-ref-223)
223. 114.27410 F.3d at 803 n.18. The first opinion in the *Bridgeport Music* series is even more mired in like concerns: “Only an actual physical copy of a master recording will be exactly the same as the copyrighted sound recording.” 383 F.3d at 396. That language drops out of the later opinions. [↑](#footnote-ref-224)
224. 114.28See § 13.03[B][1][b] *infra*. The policy of *Bridgeport Music* is, “Get a license or do not sample.” 410 F.3d at 801. The case further posits that “when a small part of a sound recording is sampled, the part taken is something of value. No further proof of that is necessary than the fact that the producer of the record or the artist on the record intentionally sampled … .” *Id*. at 802 (footnote omitted). Those same policies would doom the second poet who copied “The End”—no further proof is necessary that the phrase is of value than that it was intentionally copied, so liability should result under the Sixth Circuit’s logic. Of course, the law is to the contrary. See, *e.g*., Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991) (copying of fictitious listings held non-actionable). [↑](#footnote-ref-225)
225. 114.29Indeed, the same applies to writing a new poem on a computer screen—the result is fixed in RAM. See § 8.08[A][5][a] *supra*. [↑](#footnote-ref-226)
226. 114.30Any violation of the reproduction right—whether sampling of sound recordings, producing unlicensed sheet music of a musical composition, or shooting a film based on a novel—constitutes “physical copying.” See §§ 8.02–8.08 *supra*. One could draw a distinction invoking that term by positing that any violation of the performance right—whether playing a sound recording over the radio, singing a cantata at a concert hall, or screening a film at a theater—fails to constitute “physical copying.” See §§ 8.14–8.19 *supra*. But the law of copyright uses the phrase “copying” as a shorthand to encompass both reproduction and public performance, as well as trespass on the other exclusive rights belonging to the copyright owner. See § 8.02[A] *supra*. Thus, copyright doctrine has never concerned itself with “physical copying.” [↑](#footnote-ref-227)
227. 114.31VMG Salsoul, LLC v. Ciccone, 824 F.3d 871, 885 (9th Cir. 2016) (Treatise quoted). [↑](#footnote-ref-228)
228. 114.32410 F.3d at 802. A similar conflation began the court’s statutory analysis:

     If one were to analogize to a book, it is not the book, *i.e*., the paper and binding, that is copyrightable, but its contents. There are probably any number of reasons why the decision was made by Congress to treat a sound recording differently from a book even though both are the medium in which an original work is fixed rather than the creation itself.

     410 F.3d at 800. That reasoning contrasts *books* with *sound recordings*. But in fact, the Copyright Act treats both *literary works* and *sound recordings* as idealized types that can be stored in a variety of physical media. See 17 U.S.C. §§ 102(a)(1), 102(a)(7). The former can be materialized in a book or another type of *copy*, the latter in vinyl or another type of *phonorecord*. 17 U.S.C. § 101 (definitions of “copies” and “phonorecords”). *Bridgeport Music*’s treatment of books and sound recordings as both being “the medium in which an original work is fixed rather than the creation itself” therefore transgresses the Act’s categorical distinctions. See § 2.03[C] *supra*. [↑](#footnote-ref-229)
229. 114.33383 F.3d at 402. That opinion also noted that “there is a large body of pre-1971 sound recordings that is not protected and is up for grabs as far as sampling is concerned.” *Id*. at 401. Later, that language was toned down. See 401 F.3d at 660–661; 410 F.3d at 804. It is doubtful that state law would allow unlimited sampling. See § 8C.03 *supra*. [↑](#footnote-ref-230)
230. 114.34410 F.3d at 805. The intermediate ruling introduced that language. See 401 F.3d at 661. [↑](#footnote-ref-231)
231. 114.35When the first opinion stated, “Get a license or do not sample,” the admonition had bite. 383 F.3d at 398. By the time the third opinion replicated that phrase, its coupling with a fair use defense undermined its force. 410 F.3d at 801. See N. 114.28 *supra*. [↑](#footnote-ref-232)
232. 114.36The Sixth Circuit never explains how Congress could have intended to avoid “the kind of mental, musicological, and technological gymnastics” that attend an analysis of sampling along the plane of substantial similarity, 410 F.3d at 802, at the same time that it intended to validate the parallel gymnastics of analyzing sampling along the fair use plane. [↑](#footnote-ref-233)
233. 114.37The third fair use factor is the amount and substantiality of the portion used. See § 13.05[A][3] *infra*. Before *Bridgeport Music*, given that the issue of fair use arose only after plaintiff had demonstrated substantial similarity, there always must have been at least enough material copied to get above the substantiality threshold before confronting the question of fair use. See Castle Rock Enter. v. Carol Pub. Group, Inc., 150 F.3d 132, 144 (2d Cir. 1998) (“secondary users need invoke the fair use defense only where there is substantial similarity between the original and allegedly infringing works”). But given its innovation of allowing suit to proceed based on *insubstantial* copying, *Bridgeport Music* promises to pose unprecedented applications of fair use; at a minimum, sampling defendants will be able to make a stronger showing under the third factor than has ever been made before. Thus does the court’s distension of one area of copyright law lead to dislocations reverberating elsewhere. [↑](#footnote-ref-234)
234. 114.38Yet another Sixth Circuit *Bridgeport Music* case conflates the domains of musical compositions with sound recordings. See § 2.05[A][2][B] *supra*, discussing Bridgeport Music, Inc. v. UMG Recordings, Inc., 585 F.3d 267 (6th Cir. 2009). [↑](#footnote-ref-235)
235. 114.39To the extent that the allegation of infringement inheres in more than sampling, then the question becomes whether defendant’s work—in both its sampled portions and otherwise—is substantially similar to plaintiff’s. [↑](#footnote-ref-236)
236. 115The district court in *Bridgeport Music* found an absence of substantial similarity. Absent the new rule that it promulgated in the sampling context, the panel would agree with that result. See 410 F.3d at 798 n.4. [↑](#footnote-ref-237)
237. 115.1See TufAmerica, Inc. v. Diamond, 968 F. Supp. 2d 588 (S.D.N.Y. 2013). [↑](#footnote-ref-238)
238. 115.2Indeed, the opinion pointedly notes that “substantial similarity is always a required element of actionable copying,” adding “That this case involves the practice of sampling prior music into a new composition does not alter this analysis.” *Id.* at 595. (Those segments quote an unpublished opinion from Judge Mukasey, who in turn cites § 13.03[A][2][a] *supra* of this Treatise in that portion and throughout.) [↑](#footnote-ref-239)
239. 115.3The opinion set forth a half-dozen citations to § 13.03[A][2][a] *supra*, none to the instant subsection. [↑](#footnote-ref-240)
240. 115.4The case actually alleged infringement of both musical compositions and sound recordings. *Id.* at 602. [↑](#footnote-ref-241)
241. 115.5The opinion identified that American hip-hop group as having been founded by three MCs—in this context meaning a Microphone Controller “considered a master of the art of rap.” 968 F. Supp. 2d at 593 & n.1. [↑](#footnote-ref-242)
242. 115.6There appears to be no dispute that defendants sampled the work, although the original complaint labeled that copying “effectively concealed to the average listener” and therefore apparent only from “a careful audio analysis.” *Id.* at 599. From those statements, defendants argued that plaintiff effectively “plead his way out of court” even with respect to the amended complaint. *Id.* at 600. The court rejected that tactic, holding “the focus of the relevant inquiry is on whether the samples taken from the Trouble Funk songs constitute a substantial portion of the original song; it is not on the audibility or import of the Trouble Funk samples in the corresponding Beastie Boys’ songs.” *Id.* at 602. [↑](#footnote-ref-243)
243. 115.7*Id.* at 594. [↑](#footnote-ref-244)
244. 115.8*Id.* at 605. [↑](#footnote-ref-245)
245. 115.9*Id.* at 607 [↑](#footnote-ref-246)
246. 115.10*Id.* at 604–05. [↑](#footnote-ref-247)
247. 115.11*Id.* at 606. [↑](#footnote-ref-248)
248. 115.12*Id.* at 607 (“the sampling at issue here goes well beyond the use of a single note,” which would itself not be actionable). Moreover, the sample’s repetition for 51 seconds of defendant’s song contributed to her decision to accord trial on the merits. [↑](#footnote-ref-249)
249. 115.13Defendants used this lyric only once, although it occurred nine times in the original version. *Id.* at 603. [↑](#footnote-ref-250)
250. 115.14*Id.* at 604. Moreover, even if *Say What* has become a common phrase, that status was not evident at the time the recording was made. *Id*. [↑](#footnote-ref-251)
251. 115.14aSee Saregama India Ltd. v. Mosley, 687 F. Supp. 2d 1325 (S.D. Fla. 2009). [↑](#footnote-ref-252)
252. 115.14b*Id.* at 1330. [↑](#footnote-ref-253)
253. 115.14c*Id*. at 1341 n.11 (Treatise quoted). Judge Seitz addresses the issue at length, usefully embroidering on many of the considerations adduced herein. *Id*. at 1338–1341. The following footnote encapsulates many of the issues:

     For example, if Timothy Mosely performed a live rendition of BMBH [plaintiff’s work, Bagor Mein Bahar Hai] using a background sample of the BMBH sound recording in which Saregama indeed held copyrights, then fixed his performance in a sound recording called PYOG [defendant’s work was Put You on the Game], Mosely’s sound recording would infringe on Saregama’s sound recording copyright because his PYOG sound recording both: (1) does not “consist entirely of an independent fixation of other sounds”; and (2) it “imitates or simulates those sounds in the copyrighted sound recording.” 17 U.S.C. § 114(b). By contrast, if Mosely performed a live rendition of BMBH without a background sample of Saregama’s BMBH sound recording, then fixed his performance in a sound recording called PYOG, then, despite the fact that PYOG “imitates or simulates” BMBH, Mosley does not infringe on Saregama’s purported copyright because he has not sampled any sound from the BMBH sound recording. Id. In neither case, however, does the similar-sounding work provision govern where Mosley samples a snippet of the BMBH sound recording in a work that is not substantially similar. Therefore, if Mosley samples a one-second snippet of BMBH in PYOG, the Court must still inquire into whether PYOG and BMBH are substantially similar before it can hold that Mosley infringed on any BMBH copyright.

     *Id.* at 1340 n.10 (court’s bracket marks omitted). See also May v. Sony Music Entm’t, 399 F. Supp. 3d 169, 185 n.42 (S.D.N.Y. 2019) (Treatise cited). [↑](#footnote-ref-254)
254. 115.14d635 F.3d 1284 (11th Cir. 2011). The affirmance related solely to standing as a matter of applying Indian law regarding copyright ownership, meaning that the matter currently under consideration occupied solely the district court opinion. [↑](#footnote-ref-255)
255. 115.14e824 F.3d 871, 874–75 (9th Cir. 2016). [↑](#footnote-ref-256)
256. 115.14f*Id.* at 879–80. [↑](#footnote-ref-257)
257. 115.14g*Id.* at 880. [↑](#footnote-ref-258)
258. 115.14h*Id.* at 874 (“like the leading copyright treatise and several district courts—we find *Bridgeport*’s reasoning unpersuasive”); at 884 (Treatise quoted three times); at 885 (Treatise quoted). [↑](#footnote-ref-259)
259. 115.14iThe dissent, by contrast, wished to follow the Sixth Circuit in enforcing a special rule for sampling: “*Get a license or do not sample*.” *Id.* at 890 (Silverman, J., dissenting) (emphasis original). He lamented the choice “to follow the views of a popular treatise instead of an on-point decision of the Sixth Circuit, a decision that has governed the music industry in Nashville—‘Music City’—and elsewhere for over a decade without causing either the sky to fall in, or Congress to step in.” *Id.* at 888 (footnote omitted). According to him, “defendants wanted horns to punctuate their song, so they took the plaintiff’s copyrighted recording of horns. The horn hit is brief, but clearly perceptible and does its job.” *Id.* at 889. In terms of congressional inaction, though conceding that “congressional inaction in the face of judicial interpretation is not ironclad evidence of Congressional approval,” he labeled it “not chopped liver either.” *Id.* [↑](#footnote-ref-260)
260. 115.14jPreviously, the Ninth Circuit stated that “the creation of a circuit split would be particularly troublesome in the realm of copyright.” Seven Arts Filmed Entertainment Ltd. v. Content Media Corp., 733 F.3d 1251, 1256 (9th Cir. 2013). In the instant case, it concluded, by contrast, that

     other considerations suggest that the “troublesome” consequences ordinarily attendant to the creation of a circuit split are diminished here. In declining to create a circuit split in *Seven Arts*, we noted that “the leading copyright treatise,” Nimmer, agreed with the view of our sister circuits. As to the issue before us, by contrast, Nimmer devotes many pages to explaining why the Sixth Circuit’s opinion is, in no uncertain terms, wrong.

     824 F.3d at 886 (Treatise cited) (citations omitted). [↑](#footnote-ref-261)
261. 115.14k“It plainly is reasonable to bring a claim founded on the only circuit-court precedent to have considered the legal issue, whether or not our circuit ultimately agrees with that precedent.” *Id.* at 887. See § 14.10[D][5][a][i] *infra*. [↑](#footnote-ref-262)
262. 115.15See § 13.03[A] *supra.* [↑](#footnote-ref-263)
263. 115.16See § 13.03[A] N. 9 *supra.* An online search for the treatise terminology reveals dozens of hits in the reported cases. [↑](#footnote-ref-264)
264. 115.17See § 13.03[E] *infra.* [↑](#footnote-ref-265)
265. 115.18Dr. Seuss Enters., L.P. v. Penguin Book USA, Inc., 924 F. Supp. 1559, 1566 (S.D. Cal. 1996). In affirming, the court acknowledged criticism of its audience test by “certain leading commentators,” but nonetheless approved the district court’s formulation, “In the Ninth Circuit, the issue is whether the works are substantially similar, [which] may be found whenever the works share significant similarity in protected expression both on an objective, analytical level and a subjective, audience-response level.” 109 F.3d 1394, 1398 & n.4 (9th Cir.), *cert dismissed,* 521 U.S. 1146, 118 S. Ct. 27, 138 L. Ed. 2d 1057 (1997) (Treatise cited). [↑](#footnote-ref-266)
266. 115.19150 F.3d 132 (2d Cir. 1998). [↑](#footnote-ref-267)
267. 115.20*Id.* at 140. [↑](#footnote-ref-268)
268. 115.21150 F.3d at 138. Cf. § 14.04[E][1][a] *infra*. [↑](#footnote-ref-269)
269. 115.22The rights accorded to copyright owners under 17 U.S.C. § 106 all refer to the “work” in the singular. 150 F.3d at 138 (“thus bolstering an individual-episode analysis”). [↑](#footnote-ref-270)
270. 115.23*Id.* at 138. [↑](#footnote-ref-271)
271. 115.24Also admitted in the case was actual copying. *Id.* at 137. See § 13.01[B] *supra.* [↑](#footnote-ref-272)
272. 115.25The opinion labels “total concept and feel” unhelpful. *Id.* at 140. See § 13.03[A][1][c] *supra.* It also did not affirm summary judgment based on the “ordinary observer test.” *Id.* at 139–140. See § 13.03[E] *infra.* [↑](#footnote-ref-273)
273. 115.26Both those inquiries likewise underlie the third factor for fair use. See § 13.05[A][3] *infra.* [↑](#footnote-ref-274)
274. 115.27150 F.3d at 138–139. [↑](#footnote-ref-275)
275. 115.28A few months after authoring *Castle Rock*, Judge Walker likewise produced Nihon Keizai Shimbun, Inc. v. Comline Business Data, Inc., 166 F.3d 65 (2d Cir. 1999). The latter held defendant’s summaries of plaintiff’s news stories infringing, except for two examples: One avoided liability based on lack of quantitative similarity, the other qualitatively because of its different organization. *Id*. at 71. In contrast to Castle Rock’s aggregating of all *Seinfeld* episodes, the later case did not look at all of plaintiff’s 90,000 news stories as a unit; instead, it held that “Nikkei is entitled to the separate legal protection of each of its articles.” *Id*. at 71. [↑](#footnote-ref-276)
276. 115.29See Hayuk v. Starbucks Corp., 157 F. Supp. 3d 285, 291–93 (S.D.N.Y. 2016); Kroencke v. General Motors Corp., 270 F. Supp. 2d 441, 444 (S.D.N.Y. 2003), *aff’d unpub*., 99 Fed. Appx. 339 (2d Cir. 2004). [↑](#footnote-ref-277)
277. 115.30See Doody v. Penguin Group (USA) Inc., 673 F. Supp. 2d 1144, 1154–1156 (D. Haw. 2009). [↑](#footnote-ref-278)
278. 115.31See Warner Bros., Inc. v. American Broadcasting Cos., 530 F. Supp. 1187 (S.D.N.Y. 1982), *aff’d*, 720 F.2d 231 (2d Cir. 1983). [↑](#footnote-ref-279)
279. 115.32Team Play, Inc. v. Boyer, 391 F. Supp. 2d 695, 701–702 (N.D. Ill. 2005) (Treatise quoted) (distinguishing works in issue as separate, unlike episodes of *Seinfeld*). [↑](#footnote-ref-280)
280. 115.33Illustrative is Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co., 900 F. Supp. 1287 (C.D. Cal. 1995), in which plaintiff owned the copyright to a host of *James Bond* movies. Given enough installments in that series, the danger arises that plaintiff could monopolize every scenario involving a suave spy who uses fancy gadgets while fraternizing with beautiful women—with the concomitant claim that every new spy flick that any defendant could develop would be substantially similar to elements of that earlier oeuvre. [↑](#footnote-ref-281)
281. 115.34See N. 115.22 *supra*. [↑](#footnote-ref-282)
282. 115.35Warner Bros. Entm’t Inc. v. RDR Books, 575 F. Supp. 2d 513, 535 n.145 (S.D.N.Y. 2008) (Treatise quoted). [↑](#footnote-ref-283)
283. 115.36*Id*. at 535 n.145. [↑](#footnote-ref-284)
284. 115.37To cite an example, the novel described Professor Marchbanks as a “witch with a face so lined it looked as though it had been draped in cobwebs”; defendants’ lexicon entry for that individual described “her face [as] so lined it appeared draped in cobwebs.” *Id*. at 530. See *id*. at 537 (Treatise quoted). [↑](#footnote-ref-285)
285. 115.38The following example is illustrative:

     A number of Lexicon entries copy Rowling’s artistic literary devices that contribute to her distinctive craft as a writer. For example, the Lexicon entry for “brain room,” uses Rowling’s evocative literary device in a very close paraphrase. The original language from *Harry Potter and the Order of the Phoenix* reads:

     For a moment it seemed suspended in midair, then it soared toward Ron, spinning as it came, and what looked like ribbons of moving images flew from it, unraveling like rolls of film.

     The Lexicon entry reads in part:

     … When Summoned, the brains fly out of the tank, unspooling ribbons of thought like strips of film, which wrap themselves around the Summoner and cause quite a bit of damage.

     *Id*. at 529. If the former excerpt were a journalist’s description of a real-life event, then a defendant who copied it in the latter excerpt may not have crossed the line of substantial similarity. But, given that the “brain room” is strictly a product of Rowling’s mind, that same latitude does not exist under the actual facts of this case. *Id*. at 536 (“each ‘fact’ reported by the Lexicon is actually expression invented by Rowling”). See § 13.03[B][2][a] *infra*. [↑](#footnote-ref-286)
286. 115.39Well-Made Toy Mfg. Corp. v. Goffa Int’l Corp., 210 F. Supp. 2d 147, 163 (E.D.N.Y. 2002) (Treatise quoted), *aff’d*, 354 F.3d 112 (2d Cir. 2003). (Note that the Supreme Court later disapproved the Second Circuit’s reference in that affirmance to copyright registration as “jurisdictional.” See § 7.16[B][2][c] N. 145 *supra*.) [↑](#footnote-ref-287)
287. 115.40Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 349, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). [↑](#footnote-ref-288)
288. 115.41Lennar Homes of Tex. Sales & Mktg., Ltd. v. Perry Homes, LLC, 117 F. Supp. 3d 913, 935 (S.D. Tex. 2015) (Treatise quoted); Zalewski v. T.P. Builders, Inc., 875 F. Supp. 2d 135, 148 (N.D.N.Y. 2012) (Treatise quoted), *aff’d (vacated as to fees)*, 754 F.3d 95 (2d Cir. 2014). [↑](#footnote-ref-289)
289. 115.42After quoting most of the preceding paragraph, Jacobsen v. Deseret Book Co., 287 F.3d 936, 943 (10th Cir.), *cert. denied*, 537 U.S. 1066, 123 S. Ct. 623, 154 L. Ed. 2d 555 (2002) (Treatise quoted), concluded that a fact-based work is more akin to a novel than to a phone directory, and hence that supersubstantial similarity is not required, *id.* at 944–945 & n.6 (World War II memoirs). For a similarly thorny application, see Palmer v. Braun, 287 F.3d 1325 (11th Cir. 2002). [↑](#footnote-ref-290)
290. 115.43For a case quoting most of the foregoing paragraph and determining not to apply the supersubstantial similarity test, see Kindergartners Count, Inc. v. Demoulin, 249 F. Supp. 2d 1214, 1228–1229 & nn.73–76 (D. Kan. 2003) (Treatise quoted). [↑](#footnote-ref-291)
291. 115.44TransWestern Pub. Co. LP v. Multimedia Marketing Assocs., Inc., 133 F.3d 773, 776 (10th Cir. 1998) (preceding two sentences of Treatise quoted); Trek Leasing, Inc. v. United States, 66 Fed. Cl. 8, 19 (2005) (Treatise quoted). See Wilson v. Brennan, 666 F. Supp. 2d 1242, 1258 (D.N.M. 2009), *aff’d unpub.*, 390 Fed. Appx. 780 (10th Cir. 2010). An example comes in an exhaustive opinion comparing two similar sets of architectural elevations, denying liability based on numerous differences. See Dream Custom Homes, Inc. v. Modern Day Constr., Inc., 773 F. Supp. 2d 1288, 1309 (M.D. Fla. 2011), *aff’d unpub.*, 476 Fed. Appx. 190 (11th Cir. 2012). [↑](#footnote-ref-292)
292. 115.45Trek Leasing, Inc. v. United States, 66 Fed. Cl. 8 (2005) (Treatise quoted). See Francorp, Inc. v. Siebert, 210 F. Supp. 2d 961, 966 (N.D. Ill. 2001). [↑](#footnote-ref-293)
293. 115.46Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435, 1439, 1442 (9th Cir. 1994) (“we conclude that only ‘thin’ protection, against virtually identical copying, is appropriate”), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176; 130 L. Ed. 2d 1129 (1995); MiTek Holdings, Inc. v. Arce Eng’g Co., 89 F.3d 1548, 1558 (11th Cir. 1996). See Pampered Chef, Ltd. v. Magic Kitchen, Inc., 12 F. Supp. 2d 785, 792–793 (N.D. Ill. 1998) (rival catalogs displaying photographs of mundane kitchen items). See also § 13.03[B][2][b] & N. 160 *infra*. [↑](#footnote-ref-294)
294. 115.46aSee Milkcrate Athletics, Inc. v. Adidas Am., Inc., 619 F. Supp. 3d 1009, 1018–21 (C.D. Cal. 2022). Because the two exemplars were not “entirely devoid of similarities,” the court held plaintiff’s claim non-frivolous and therefore denied attorney’s fees to defendant. *Id.* at 1023. See § 14.10 *infra*. [↑](#footnote-ref-295)
295. 115.47Key Publications, Inc. v. Chinatown Today Pub. Enters., Inc., 945 F.2d 509, 514 (2d Cir. 1991). It therefore precludes copying of substantially the same selection or arrangement, rather than precluding only an exact replica of the copyrighted work. *Id.* (“We have not read *Feist* in such a broad and self-defeating fashion.”). See Nester’s Map & Guide Corp. v. Hagstrom Map Co., 796 F. Supp. 729, 732–734 (E.D.N.Y. 1992); Budish v. Gordon, 784 F. Supp. 1320, 1333–1334 (N.D. Ohio 1992). [↑](#footnote-ref-296)
296. 115.48See Express, LLC v. Fetish Group, Inc., 424 F. Supp. 2d 1211, 1227–1228 (C.D. Cal. 2006). [↑](#footnote-ref-297)
297. 115.49See Cosmos Jewelry Ltd. v. Po Sun Hon Co., 470 F. Supp. 2d 1072, 1084 (C.D. Cal. 2006); Amini Innovation Corp. v. McFerran Home Furnishings, Inc., 68 F. Supp. 3d 1170, 1177 (C.D. Cal. 2014) (material dispute of facts precluded summary judgment on this issue). [↑](#footnote-ref-298)
298. 115.50Warren Publ. v. Microdos Data Corp., 115 F.3d 1509, 1515 n.16 (11th Cir.) *(en banc)*, *cert. denied*, 522 U.S. 963, 118 S. Ct. 397, 139 L. Ed. 2d 311 (1997). [↑](#footnote-ref-299)
299. 115.51554 F.3d 914, 919 n.3 (11th Cir. 2008). See § 2A.09[B][2][g] *supra*. [↑](#footnote-ref-300)
300. 115.52754 F.3d 95, 103 (2d Cir. 2014). [↑](#footnote-ref-301)
301. 115.53*Id.* at 103. It added, “we see little support in the statute for *Intervest*’s use of categories.” *Id.* at 104. [↑](#footnote-ref-302)
302. 115.54*Id.* at 104. [↑](#footnote-ref-303)
303. 115.55*Id.* at 105. As applied to the architectural context, “Efficiency is an important architectural concern. Any design elements attributable to building codes, topography, structures that already exist on the construction site, or engineering necessity should therefore get no protection.” *Id.* [↑](#footnote-ref-304)
304. 115.56For instance,

     Plaintiff can get no credit for putting a closet in every bedroom, a fireplace in the middle of an exterior wall, and kitchen counters against the kitchen walls. Furthermore, the overall footprint of the house and the size of the rooms are “design parameters” dictated by consumer preferences and the lot the house will occupy, not the architect.

     *Id.* at 106. The similarities noted by plaintiff flowed from the fact that both were colonial homes. *Id.* Moreover, there were subtle differences as well, which were significant in the context of all the constraints. *Id.* at 107 (“There are only so many ways to arrange four bedrooms upstairs and a kitchen, dining room, living room, and study downstairs.”). [↑](#footnote-ref-305)
305. 115.57*Id.* at 107. Another case promulgates its own terminology of “specific protection.”

     Architectural works, and other compilations, have “specific copyright protection” in that the copyright protects the exact work itself; only subsequent works which copy the work’s specific expressions and designs will infringe upon that protection.

     Sieger Suarez Architectural P’ship v. Arquitectonica Int’l Corp., 998 F. Supp. 2d 1340, 1346 (S.D. Fla. 2014). It equally concludes that the “average observer” who performs the substantial similarity comparison “is one who is fully aware of the law, trained to understand the elements of infringement and protectable features, with knowledge of architectural designs, and with experience to decide the facts of a given case.” *Id.* at 1347 (“Such a person is neither average nor ordinary.”). [↑](#footnote-ref-306)
306. 115.57aSee Fortgang v. Pereiras Architects Ubiquitous LLC, 230 F. Supp. 3d 77, 86–87 (E.D.N.Y. 2017) (though “the similarities in the two homes may appear at first glance to be numerous and substantial,” nonetheless “they are overshadowed by differences that, in the final analysis, are far more consequential”). [↑](#footnote-ref-307)
307. 115.57bSee Design Basics, LLC v. Lexington Homes, Inc., 858 F.3d 1093, 1101 (7th Cir. 2017); Design Basics, LLC v. Kerstiens Homes & Designs, Inc., 341 F. Supp. 3d 920, 932 (S.D. Ind. 2018) (following *Lexington*), *aff’d*, 1 F.4th 502 (7th Cir. 2021). Later, the Seventh Circuit clarified that its standards were congruent with T-Peg, Inc. v. Vermont Timber Works, Inc., 459 F.3d 97, 112 (1st Cir. 2006). See Design Basics, LLC v. Signature Constr., Inc., 994 F.3d 879, 890 n.6 (7th Cir. 2021). [↑](#footnote-ref-308)
308. 115.58Home Design Servs., Inc. v. Turner Heritage Homes, Inc., 101 F. Supp. 3d 1201, 1205–06 (N.D. Fla. 2015). [↑](#footnote-ref-309)
309. 115.59*Id.* at 1215. Had the jury verdict been reinstated, the district judge wished to uphold its award of only a small part of the $2.4 million in defendants’ receipts. *Id.* at 1205, 1216–19. For instance, defendants failed to “earn any profit on the sale of its homes.” *Id.* at 1218. See § 14.03[C] *infra*. But the affirmance prevented those aspects from reaching fruition. [↑](#footnote-ref-310)
310. 115.60825 F.3d 1314, 1322 (11th Cir. 2016), *cert. denied*, 137 S. Ct. 1335 (2017). [↑](#footnote-ref-311)
311. 115.61*Id.* at 1324. [↑](#footnote-ref-312)
312. 115.62*Id.* at 1324. [↑](#footnote-ref-313)
313. 115.63*Id.* at 1325. A footnote added,

     It is important to frame *Intervest* as holding only that there is no copyright infringement when floor plans with the same noncopyrightable layouts also boast modest differences such as those in *Intervest*. A more expansive reading would nearly eliminate copyright protection for architectural works. Specifically, if *Intervest* is read as holding that modest differences between floor plans always preclude copyright infringement, then even a plan with an entirely original layout would receive no copyright protection so long as the copying plan bore some superficial differences. That is not the correct result.

     *Id.* at 1324 n.7. [↑](#footnote-ref-314)
314. 115.64*Id.* at 1325. [↑](#footnote-ref-315)
315. 115.65Within the Eleventh Circuit panel, there was discord whether *Intervest* properly held this matter to be determined by the court, not the jury. That aspect is primarily discussed in § 12.10[B][3] *supra*. One judge stated, “I think we lost our way in *Intervest*.” 825 F.3d at 1330 (Rosenbaum, J., concurring). She took special aim at that case’s

     notion that judges have a special grasp on “the concept of the idea/expression dichotomy and how it should be applied in the context of the works before them.” No degree of mastery of the “concept of the idea/expression dichotomy” renders a judge better able to determine whether an average lay observer would recognize an alleged copy as having been appropriated from a copyrighted work.

     *Id.* at 1332 (citations omitted). By her lights, the jury should have been allowed to determine that parties’ blueprints, being “virtually line for line” copies, were infringing—and therefore would have reinstated the verdict, but for *Intervest*. *Id.* at 1333. [↑](#footnote-ref-316)
316. 115.66Charles W. Ross Builder, Inc. v. Olsen Fine Home Bldg., LLC, 827 F. Supp. 2d 607, 620 (E.D. Va. 2011) (Treatise cited). [↑](#footnote-ref-317)
317. 115.67*Id.* at 611–612. Another case followed this ruling. See Zalewski v. T.P. Builders, Inc., 875 F. Supp. 2d 135, 153 (N.D.N.Y. 2012), *aff’d (vacated as to fees)*, 754 F.3d 95 (2d Cir. 2014). [↑](#footnote-ref-318)
318. 115.68Had the case been brought in 1750, the court allowed that plaintiff might have prevailed. 827 F. Supp. 2d at 622. [↑](#footnote-ref-319)
319. 115.69*Id.* at 612. For a recitation of the common elements, see *id*. at 621. [↑](#footnote-ref-320)
320. 115.70It also denied a parallel count alleging removal of copyright management information. See § 12A.08 *supra*. The fact of similarities between plaintiff’s and defendant’s plans failed to support the inference that the latter consisted of the former “with the copyright information removed.” 827 F. Supp. 2d at 624. [↑](#footnote-ref-321)
321. 115.71496 Fed. Appx. 314 (4th Cir. 2012). [↑](#footnote-ref-322)
322. 115.72Charles W. Ross Builder, Inc. v. Olsen Fine Home Bldg., LLC, 977 F. Supp. 2d 567 (E.D. Va. 2013). Query how different its approach was on remand:

     Use of standard, Georgian-style architectural features does not render the copyrighted work unoriginal but, because it borrows heavily from the public domain, the Bainbridge is entitled to narrower copyright protection than a work composed of wholly original elements.

     *Id.* at 594. It relied in part on 86 substantive differences between the residences in question, many of which pertained to “the very areas on which Plaintiff’s claims of substantial similarity rest.” *Id.* at 597. [↑](#footnote-ref-323)
323. 115.73An example comes in one exhaustive opinion denying liability based on numerous differences between the two sets of architectural elevations. See Dream Custom Homes, Inc. v. Modern Day Constr., Inc., 773 F. Supp. 2d 1288, 1309 (M.D. Fla. 2011), *aff’d unpub.*, 476 Fed. Appx. 190 (11th Cir. 2012). [↑](#footnote-ref-324)
324. 115.74After defendants’ expert testified “there are only so many ways those individual elements can be arranged in a cost-effective square design” one court concluded

     It would be unduly restrictive—and would cut against the policy favoring the free flow of ideas and information—to grant plaintiff a monopoly on the design of a roughly 3,000 square-foot home plan using a square box design; open floor plan; three bedrooms separated from a master bedroom by a kitchen, great room, and breakfast area; formal living room and dining room flanking a front entry foyer; laundry room; garage; and terrace, even if all of those elements are arranged in the same general configuration.

     Jeff Benton Homes v. Alabama Heritage Homes, Inc., 929 F. Supp. 2d 1231, 1254. (N.D. Ala. 2013). [↑](#footnote-ref-325)
325. 115.75See Design Basics LLC v. J & V Roberts Invs., Inc., 130 F. Supp. 3d 1266, 1280 (E.D. Wis. 2015) (distinguishing *Zalewski* when “the arrangement of every single room in the defendants’ plan is nearly identical to the plaintiffs’ design” and “the placement of countertops, wet bars, and closets appears identical as well”); Ranieri v. Adirondack Dev. Grp., LLC, 164 F. Supp. 3d 305, 332–34 (N.D.N.Y. 2016) (distinguishing *Zalewski*); Monterey Bay Homes, LLC v. Chambers, 11 F. Supp. 3d 570, 580 (D.S.C. 2014) (denying summary judgment despite “thin” protection for plaintiff’s work). One case allowed plaintiff’s case to proceed based on copying a home exterior, even though the interiors were wholly different. See Axelrod & Cherveny, Architects, P.C. v. T. & S. Builders Inc., 943 F. Supp. 2d 357, 362 (E.D.N.Y. 2013). It also allowed the case to proceed based on copying of a brochure depicting the exterior. *Id.* at 364. [↑](#footnote-ref-326)
326. 115.76Mattel, Inc. v. MGA Entm’t, Inc., 616 F.3d 904, 907 (9th Cir. 2010). A welter of opinions have resulted from this dispute, some of them outside the copyright ambit. See §§ 12.01[A][1][d][i] N. 104 *supra*; 15.05[B] N. 59.1a *infra*. [↑](#footnote-ref-327)
327. 115.77The first part of the copyright portion of this opinion rejected the jury verdict and district court’s resulting injunction, premised on an employment agreement. *Id.* at 911–913. See § 5.03[B][1][b][ii] *supra*. Although that basis sufficed to vacate the copyright injunction, the possibility remained that Mattel would prevail again after retrial with proper instructions—leading the appellate court to “believe it prudent to address MGA’s appeal of the district court’s copyright rulings.” 616 F.3d at 913. See also N. 116.1 *infra* (rejecting holding below regarding constructive trust over trademark). [↑](#footnote-ref-328)
328. 115.78*Id.* at 908. [↑](#footnote-ref-329)
329. 115.79See § 13.03[B][2][a] *infra*. [↑](#footnote-ref-330)
330. 115.80Carter Bryant began in Mattel’s employ, and later developed the Bratz line for MGA. His status underlay the work for hire dispute noted above. See N. 115.77 *supra*. [↑](#footnote-ref-331)
331. 115.81616 F.3d at 913. [↑](#footnote-ref-332)
332. 116*Id.* at 913–914 (citation omitted). [↑](#footnote-ref-333)
333. 116.1*Id.* at 915. [↑](#footnote-ref-334)
334. 116.2*Id.* at 915. [↑](#footnote-ref-335)
335. 116.3

     [F]ashion dolls that look like Patty and Selma Bouvier don’t express the idea behind Bratz. Dolls depicting young, fashion-forward females have to have somewhat idealized proportions—which means slightly larger heads, eyes and lips; slightly smaller noses and waists; and slightly longer limbs than those that appear routinely in nature. But these features can be exaggerated only so much: Make the head too large or the waist too small and the doll becomes freakish, not idealized.

     *Id.* at 915. [↑](#footnote-ref-336)
336. 116.4*Id.* at 915. [↑](#footnote-ref-337)
337. 116.5The further question remains if a jury properly instructed could return a verdict in Mattel’s favor. The opinion fails to address that aspect, given its somewhat *dictum*-like status. See N. 115.77 *supra*. [↑](#footnote-ref-338)
338. 116.6616 F.3d at 916.

     Designers may vary the face paint, hair color and style, and the clothing and accessories, on top of making minor variations to the sculpt. One doll might have brown eyes with bronze eyeshadow, wavy auburn hair, leather boots, a blue plaid mini matched with a black button-down, silver knot earrings and a barrel bag. Another might have green eyes with pink eyeshadow, brown hair in a messy bun, gold wedges, dark skinny jeans matched with a purple halter, a turquoise cuff and a clutch, along with a slightly different body and facial structure.

     *Id.* [↑](#footnote-ref-339)
339. 116.7*Id.* at 916; Belair v. MGA Entm’t, Inc., 503 Fed. Appx. 65, 67 (2d Cir. 2012) (Treatise quoted). [↑](#footnote-ref-340)
340. 116.8See § 13.03[F] *infra*. [↑](#footnote-ref-341)
341. 116.9“MGA’s Bratz dolls can’t be considered substantially similar to Bryant’s preliminary sketches simply because the dolls and sketches depict young, stylish girls with big heads and an attitude. Yet this appears to be how the district court reasoned.” 616 F.3d at 917. [↑](#footnote-ref-342)
342. 116.10*Id.* at 916. [↑](#footnote-ref-343)
343. 116.11*Id.* at 918. The Ninth Circuit evinced fundamental disagreement with the economic approach followed below. Even before analyzing the work for hire issues, see N. 115.77 *supra*, the opinion reversed the district court’s imposition of a constructive trust over all trademarks, based on MGA’s appropriation of the names “Bratz” and “Jade.”

     It is not equitable to transfer this billion dollar brand—the value of which is overwhelmingly the result of MGA’s legitimate efforts—because it may have started with two misappropriated names. The district court’s imposition of a constructive trust forcing MGA to hand over its sweat equity was an abuse of discretion and must be vacated.

     616 F.3d at 911. [↑](#footnote-ref-344)
344. 116.12For the sequel to the Bratz case on remand, see § 20.04[A][1] *infra*. [↑](#footnote-ref-345)
345. 116.13See Bridgeport Music, Inc. v. Dimension Films, 410 F.3d 792 (6th Cir. 2005). [↑](#footnote-ref-346)
346. 116.14Range Rd. Music, Inc. v. East Coast Foods, Inc., 668 F.3d 1148, 1154 (9th Cir.), *cert. denied*, 568 U.S. 824 (2012). [↑](#footnote-ref-347)
347. 116.15East Coast operated five outlets, in Southern California, of Roscoe’s House of Chicken and Waffles. *Id.* at 1151. Only after defendant ignored ASCAP’s requests did it send an investigator out to the facility. *Id.* [↑](#footnote-ref-348)
348. 116.16See § 8.19[B] *supra*. As detailed therein, ASCAP typically offers miscreants multiple opportunities to clean up their licensing deficiencies. *Id*. [↑](#footnote-ref-349)
349. 116.17*Id.* [↑](#footnote-ref-350)
350. 116.18*Id.* [↑](#footnote-ref-351)
351. 116.19668 F.3d at 1152. [↑](#footnote-ref-352)
352. 116.20*Id.* at 1152. [↑](#footnote-ref-353)
353. 116.21*Id.* at 1155. See § 14.10[D][5][a][i] *infra*. [↑](#footnote-ref-354)
354. 116.22668 F.3d at 1153. [↑](#footnote-ref-355)
355. 116.23*Id.* at 1151. [↑](#footnote-ref-356)
356. 116.24Greene had conducted over 300 ASCAP investigations, and considered himself knowledgeable about every genre “except heavy metal and explicit rap.” *Id.* [↑](#footnote-ref-357)
357. 116.25As will be explicated below, they were *exactly* similar, which subsumes the lesser proof of being *substantially* similar. [↑](#footnote-ref-358)
358. 116.26Indeed, the panel’s recitation already tacitly contains that proposition:

     Greene’s declaration, detailed investigative report, and deposition testimony were sufficient to establish that the works were publicly performed. He declared that the live band he saw perform at the Long Beach Roscoe’s introduced the songs they were playing as Coltrane standards and proceeded to play them. He further declared that he saw a disc jockey play four tracks from a CD of Hiroshima songs, the titles of which he obtained from the jewel case lying next to the CD player. All of this evidence was completely uncontradicted by East Coast and Hudson, who proffered no evidence tending to contradict Greene’s testimony that the eight copyrighted compositions at issue were publicly performed at the Long Beach Roscoe’s on the night he visited the venue.

     *Id.* at 1154. [↑](#footnote-ref-359)
359. 116.27*Id.* at 1154 (footnote omitted). [↑](#footnote-ref-360)
360. 116.28*Id.* at 1154. [↑](#footnote-ref-361)
361. 116.29*Id.* at 1152. That song actually emanates from *The Sound of Music*, but has been associated with the jazz legend by virtue of his virtuosic rendition. [↑](#footnote-ref-362)
362. 116.30*Id.* at 1152. In fact, Greene transcribed the title of the song right from the CD jewel case as it was playing. *Id.* [↑](#footnote-ref-363)
363. 116.31See § 13.03[A][2] *supra*. [↑](#footnote-ref-364)
364. 116.32*Id.* [↑](#footnote-ref-365)
365. 116.33At that point, the singer first utters the title lyrics “G-L-O-R-I-A, Gloria.” (Her cover begins on a plane wholly divorced from the original: “Jesus died for somebody’s sins—but not mine.”) Nonetheless, at 2:39, the Patti Smith version reverts to the lines, “Oh, she was so good/ Oh, she was so fine,” its first point of (mild) intersection with Van Morrison’s original, which features, “She make me feel so good/she make me feel all right. [↑](#footnote-ref-366)
366. 116.34See previous footnote. [↑](#footnote-ref-367)
367. 116.35There would equally be no infringement of Van Morrison’s rights if Patti Smith announced during a Christmas eve concert that she was going to sing “Gloria” and then proceeded to belt out the whole tune—but puckishly switched to “Gloria, in Excelsis Deo!” instead of Van Morrison’s composition. [↑](#footnote-ref-368)
368. 116.36As the previous footnote demonstrates, Mr. Greene would need to testify that he heard Van Morrison’s song, rather than the classic Christmas carol. [↑](#footnote-ref-369)
369. 116.37668 F.3d at 1154. [↑](#footnote-ref-370)
370. 116.38*Compare* § 8.02 *with* § 8.14 *supra*. [↑](#footnote-ref-371)
371. 116.39See § 13.01[B] *supra*. [↑](#footnote-ref-372)
372. 116.40Of course, that is a far cry from rendering it non-existent as part of the *prima facie* case. See § 13.01[B] *supra*. When a plaintiff authors a 400-page novel from scratch, the ingredient of *originality* becomes non-remarkable. See § 2.01[A] *supra*. By contrast, originality certainly does not thereby become non-existent as an element of the *prima facie* case. See § 13.01[A] *supra*. [↑](#footnote-ref-373)
373. 116.41See § 8.02[A] *supra*. [↑](#footnote-ref-374)
374. 116.42One case loosely comments that “Plaintiffs only need to show a substantial similarity when there is no evidence of actual direct copying.” Jackson v. Odenat, 9 F. Supp. 3d 342, 352 (S.D.N.Y. 2014). On rehearing, the court stepped back from that objectionable formulation. *Id.* at 368–69 (“Even if a substantial similarity analysis is still required when actual direct copying is already established, that would not affect Defendants’ liability because the Court went on to engage in this analysis.”). [↑](#footnote-ref-375)
375. 116.43Perhaps the best solution is to reject that sentence from the opinion as mere *obiter dictum*. Given that the public performances in that case consisted of entire songs, plaintiffs handily proved *entire* similarity, and therefore, of necessity, the lesser quantum of *substantial* similarity. The notion of dispensing with substantial similarity never became live in that case; any statements about its general applicability in the law of copyright are therefore unnecessary to the decision, and accordingly non-binding, even within the Ninth Circuit. [↑](#footnote-ref-376)
376. 116.44See § 13.03[A] *supra.* See also § 13.03[B][1] *infra*. [↑](#footnote-ref-377)
377. 117See § 13.03[B][2] *infra*. [↑](#footnote-ref-378)
378. 118See § 13.03[B][3]–[4] *infra*. Once a *prima facie* case has been established, the defendant can nonetheless urge various affirmative defenses. See § 13.04 *infra*. In a roughly analogous fashion, once overall similarity has been shown, the defendant can deny that such amounts to the legal requirement of substantial similarity by reference to the doctrines discussed below. [↑](#footnote-ref-379)
379. 119See, *e.g.*, Greenbie v. Noble, 151 F. Supp. 45 (S.D.N.Y. 1957). Cf. Walt Disney Prods. v. Air Pirates, 345 F. Supp. 108 (N.D. Cal. 1972)*, aff’d in part, rev’d in part,* 581 F.2d 751 (9th Cir. 1978), *cert. denied*, 439 U.S. 1132, 99 S. Ct. 1054, 59 L. Ed. 2d 94 (1979), which states that “a claim of infringement is made out when it is shown that the defendants copied the substantial part of the protected work *and* that the part so copied was a substantial part of the defendant’s work” (emphasis added). On appeal, the Ninth Circuit rejected as “much-criticized and abandoned” an asserted defense that “the part copied was not a substantial part of the defendant’s work.” Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 756 (9th Cir. 1978) (Treatise cited), *cert. denied*, 439 U.S. 1132, 99 S. Ct. 1054, 59 L. Ed. 2d 94 (1979). But see Polk & Co. v. Musser, 105 F. Supp. 351 (E.D. Pa. 1952), *aff’d*, 196 F.2d 1020 (3d Cir. 1952). [↑](#footnote-ref-380)
380. 120See § 13.03[A][2] *supra*. “The tests for eligibility for copyright and avoidance of infringement are not the same.” Puddu v. Buonamici Statuary, Inc., 450 F.2d 401, 402 (2d Cir. 1971); Fink v. Goodson-Todman Enters., Ltd., 9 Cal. App. 3d 996, 88 Cal. Rptr. 679 (1970) (Treatise quoted); Douglas Int’l Corp. v. Baker, 335 F. Supp. 282 (S.D.N.Y. 1971) (derivative work held to infringe underlying work); Nucor Corp. v. Tennessee Forging Steel Serv., Inc., 476 F.2d 386 (8th Cir. 1973). [↑](#footnote-ref-381)
381. 121L.A. Printex Indus., Inc. v. Aeropostale, Inc., 676 F.3d 841, 851 (9th Cir. 2012) (Treatise quoted); Attia v. Society of N.Y. Hosp., 201 F.3d 50, 57–58 (2d Cir. 1999) (Treatise quoted), *cert. denied*, 531 U.S. 843, 121 S. Ct. 109, 148 L. Ed. 2d 67 (2000); Trek Leasing, Inc. v. United States, 66 Fed. Cl. 8, 18–19 (2005) (Treatise quoted); Churchill Livingstone, Inc. v. Williams & Wilkins, 949 F. Supp. 1045, 1055 (S.D.N.Y. 1996) (Treatise quoted); United Feature Syndicate, Inc. v. Koons, 817 F. Supp. 370, 377 (S.D.N.Y. 1993) (Treatise quoted); WPOW, Inc. v. MRLJ Enterprises, 584 F. Supp. 132 (D.D.C. 1984) (Treatise cited); In Design v. Lauren Knitwear Corp., 782 F. Supp. 824, 830 (S.D.N.Y. 1991) (Treatise cited). In Warner Bros. v. American Broadcasting Cos., 720 F.2d 231 (2d Cir. 1983), Judge Newman concluded that the proposition stated in the text must be modified, at least in the case of graphic and three-dimensional works, as distinguished from literary works. “A story has a linear dimension: it begins, continues, and ends. If a defendant copies substantial portions of a plaintiff’s sequence of events, he does not escape infringement by adding original episodes somewhere along the line. A graphic or three-dimensional work is created to be perceived as an entirety. Significant dissimilarities between two works of this sort inevitably lessen the similarity that would exist between the total perceptions of the two works.” *Id.* at 241. See Universal City Studios, Inc. v. Casey & Casey, Inc., 622 F. Supp. 201 (S.D. Fla. 1985), *aff’d mem.*, 792 F.2d 1125 (11th Cir. 1986). But cf. Novelty Textile Mills, Inc. v. Joan Fabrics Corp., 558 F.2d 1090 (2d Cir. 1977) (dissimilarity of colors used does not in itself negate substantial similarity). [↑](#footnote-ref-382)
382. 122Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49 (2d Cir. 1936); Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904 (3d Cir. 1975)*, cert. denied,* 423 U.S. 863, 96 S. Ct. 122, 46 L. Ed. 2d 92 (1975). See Shaw v. Lindheim, 919 F.2d 1353, 1362 (9th Cir. 1990) (Treatise cited). See also Universal Athletic Sales Co. v. Salkeld, 340 F. Supp. 899 (W.D. Pa. 1972). But cf. Harold Lloyd Corp. v. Witwer, 65 F.2d 1 (9th Cir. 1933), *dismissed,* 296 U.S. 669, 54 S. Ct. 94, 78 L. Ed. 2d 1507 (1933). [↑](#footnote-ref-383)
383. 123Dam v. Kirk La Shelle Co., 175 F. 902 (2d Cir. 1910); Bradbury v. Columbia Broadcasting Sys., Inc., 287 F.2d 478 (9th Cir. 1961), *dismissed*, 368 U.S. 801, 82 S. Ct. 19, 7 L. Ed. 2d 15 (1961); Cortley Fabrics Co. v. Slifka, 138 U.S.P.Q. 110 (S.D.N.Y. 1963), *aff’d*, 317 F.2d 924 (2d Cir. 1963); Davis v. E.I. du Pont de Nemours & Co., 240 F. Supp. 612 (S.D.N.Y. 1965); Trebonik v. Grossman Music Corp., 305 F. Supp. 339 (N.D. Ohio 1969) (principle applied to work categorizing guitar chords); Tennessee Fabricating Co. v. Moultrie Mfg. Co., 421 F.2d 279 (5th Cir. 1970) (principle applied to defendant’s adding “additional intercepting straight lines to the [plaintiff’s] filigree pattern”), *cert. denied*, 398 U.S. 928, 90 S. Ct. 1819, 26 L. Ed. 2d 91 (1970); Baldwin Cooke Co. v. Keith Clark, Inc., 383 F. Supp. 650 (N.D. Ill. 1974)*, aff’d,* 505 F.2d 1250 (7th Cir. 1974); Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607 (7th Cir. 1982) (“The *sine qua non* of the ordinary observer test … is the overall similarities rather than the minute differences between the two works.”), *cert. denied*, 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 145 (1982). Cf. Warner Bros, Inc. v. American Broadcasting Cos., 654 F.2d 204 (2d Cir. 1981). In Walt Disney Prods. v. Air Pirates, 581 F.2d 751 (9th Cir. 1978), *cert. denied*, 439 U.S. 1132, 99 S. Ct. 1054, 59 L. Ed. 2d 94 (1979), the copying of plaintiff’s cartoon characters was held to constitute an infringement, even though the story line in defendant’s works entirely differed from that in plaintiff’s works. [↑](#footnote-ref-384)
384. 124American Visuals Corp. v. Holland, 261 F.2d 652 (2d Cir. 1958). See United Feature Syndicate, Inc. v. Koons, 817 F. Supp. 370, 377 (S.D.N.Y. 1993) (Treatise quoted); Keeler Brass Co. v. Continental Brass Co., 678 F. Supp. 1185, 1189 (M.D.N.C. 1987) (Treatise quoted). Cf. Affiliated Hosp. Prods., Inc. v. Merdel Game Mfg. Co., 513 F.2d 1183 (2d Cir. 1975) (defendant’s noninfringing work held to be “a good faith attempt to improve upon, and to clarify” plaintiff’s work). Similarly, the fact that plaintiff’s work is more appealing or better constructed will not initself derogate from a finding of substantial similarity. Ideal Toy Corp. v. Fab-Lu, Ltd., 261 F. Supp. 238 (S.D.N.Y. 1966). [↑](#footnote-ref-385)
385. 125Sanford v. CBS, Inc., 594 F. Supp. 713 (N.D. Ill. 1984) (plaintiff’s motion *in limine* denied). [↑](#footnote-ref-386)
386. 125.1When plaintiff’s work is an architectural plan that admits of only slight variations, “modest dissimilarities are more significant than they may be in other types of art works.” Howard v. Sterchi, 974 F.2d 1272, 1276 (11th Cir. 1992). See Lifetime Homes, Inc. v. Walker Homes, Inc., 485 F. Supp. 2d 1314, 1325 (M.D. Fla. 2007) (quoting *Sterchi*). [↑](#footnote-ref-387)
387. 126T-Peg, Inc. v. Vermont Timber Works, Inc., 459 F.3d 97, 112 (1st Cir. 2006) (Treatise quoted); Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904 (3d Cir. 1975) (Treatise quoted), *cert. denied*, 423 U.S. 863, 96 S. Ct. 122, 46 L. Ed. 2d 92 (1975); Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980) (Treatise quoted); Concrete Machinery Co. v. Classic Lawn Ornaments, Inc., 843 F.2d 600, 608 (1st Cir. 1988) (Treatise quoted); New Old Music Grp., Inc. v. Gottwald, 122 F. Supp. 3d 78, 85 n.4 (S.D.N.Y. 2015) (Treatise quoted); Greenspan v. Random House, Inc., 859 F. Supp. 2d 206, 218 (D. Mass. 2012) (Treatise quoted); Belair v. MGA Entm’t, Inc., 831 F. Supp. 2d 687, 697 (S.D.N.Y. 2011) (Treatise quoted), *aff’d unpub.*, 503 Fed. Appx. 65 (2d Cir. 2012); American Century Home Fabrics, Inc. v. Ashley Furniture Indus., Inc., 473 F. Supp. 2d 168, 172–173 (D. Mass. 2007) (Treatise quoted); Trek Leasing, Inc. v. United States, 66 Fed. Cl. 8, 19 (2005) (paragraph of Treatise quoted); Weygand v. CBS Inc., 43 U.S.P.Q.2d 1120, 1127 n.22 (C.D. Cal. 1997) (Treatise quoted); Williams v. Crichton, 84 F.3d 581, 588 (2d Cir. 1996) (Treatise cited); Rogers v. Koons, 960 F.2d 301, 308 (2d Cir. 1992) (Treatise cited); Chuck Blore & Don Richman, Inc. v. 20/20 Advertising, Inc., 674 F. Supp. 671, 680 (D. Minn. 1987) (Treatise cited); Sanford v. CBS, Inc., 594 F. Supp. 713 (N.D. Ill. 1984) (Treatise cited). See Esquire, Inc. v. Varga Enters., Inc., 81 F. Supp. 306 (N.D. Ill. 1948), *aff’d in part, rev’d in part,* 185 F.2d 14 (7th Cir. 1950). [↑](#footnote-ref-388)
388. 126.1As previously noted, factual copying does not equate to culpability; the additional ingredient of substantial similarity is required to render the copying actionable. See § 13.01[B] *supra*. [↑](#footnote-ref-389)
389. 127Meier Co. v. Albany Novelty Mfg. Co., 236 F.2d 144 (2d Cir. 1956); Business Trends Analysts, Inc. v. Freedonia Group, Inc., 887 F.2d 399, 403 (2d Cir. 1989); Concord Fabrics, Inc. v. Marcus Bros. Textile Corp., 409 F.2d 1315 (2d Cir. 1969) (“While the trial court placed great emphasis on the minor differences between the two design patterns, we feel that the very nature of these differences only tends to emphasize the extent to which the defendant has deliberately copied from the plaintiff.”); Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607 (7th Cir. 1982) (“superficial changes” seen as “an attempt to disguise an intentional appropriation”), *cert. denied,* 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 145 (1982); M. Kramer Mfg. Co. v. Andrews, 783 F.2d 421, 446 (4th Cir. 1986); Thimbleberries, Inc. v. C & F Enters., Inc., 142 F. Supp. 2d 1132, 1140–1141 (D. Minn. 2001); Iris Arc v. S.S. Sarna, Inc., 621 F. Supp. 916, 923 & n.9 (E.D.N.Y. 1985); Couleur Int’l, Ltd. v. Opulent Fabrics, Inc., 330 F. Supp. 152 (S.D.N.Y. 1971). See Selle v. Gibb, 741 F.2d 896 (7th Cir. 1984); Scarves by Vera, Inc. v. United Merchants & Mfrs., Inc., 173 F. Supp. 625 (S.D.N.Y. 1959); Fabrex Corp. v. Scarves by Vera, Inc., 129 U.S.P.Q. 392 (S.D.N.Y. 1961). Cf. Pic Design Corp. v. Sterling Precision Corp., 231 F. Supp. 106 (S.D.N.Y. 1964) (dissimilarity as evidence of copying termed a “specious argument”); Fristot v. First Am. Natural Ferns Co., 251 F. Supp. 886 (S.D.N.Y. 1966); Fisher-Price Toys, Div. of Quaker Oats Co. v. My-Toy Co., 385 F. Supp. 218 (S.D.N.Y. 1974). [↑](#footnote-ref-390)
390. 127.1Cantor v. NYP Holdings, Inc., 51 F. Supp. 2d 309, 314 n.9 (S.D.N.Y. 1999). The court ruled in favor of defendant, notwithstanding that it admittedly used plaintiffs work as a “short-cut” in preparing its own. *Id.* at 313. [↑](#footnote-ref-391)
391. 127.2Both scenarios are discussed in *dictum* in Concrete Mach. Co. v. Classic Lawn Ornaments, Inc., 843 F.2d 600, 608 (1st Cir. 1988). [↑](#footnote-ref-392)
392. 128Harney v. Sony Pictures Television, Inc., 704 F.3d 173, 188 (1st Cir. 2013) (Treatise quoted); Eden Toys, Inc. v. Marshall Field & Co., 675 F.2d 498 (2d Cir. 1982) (Treatise quoted); Warner Bros., Inc. v. American Broadcasting Cos., 654 F.2d 204 (2d Cir. 1981) (Treatise quoted); 720 F.2d 231 (2d Cir. 1983) (Treatise quoted); Silver Ring Splint Co. v. Digisplint, Inc., 543 F. Supp. 2d 509, 519 (W.D. Va. 2008) (Treatise quoted); Madrid v. Chronicle Books, 209 F. Supp. 2d 1227, 1243 (D. Wyo. 2002) (Treatise cited); Sinicola v. Warner Bros., Inc., 948 F. Supp. 1176, 1190 (E.D.N.Y. 1996) (Treatise quoted); Quaker Oats Co. v. Mel Appel Enters., Inc., 703 F. Supp. 1054, 1059 (S.D.N.Y. 1989) (Treatise quoted); Cory Van Rijn, Inc. v. California Raisin Advisory Bd., 697 F. Supp. 1136, 1145 (E.D. Cal. 1987) (Treatise quoted); Ronald Mayotte & Assocs. v. MGC Building Co., 36 U.S.P.Q.2d 1793, 1795 (E.D. Mich. 1995) (Treatise quoted); Kisch v. Ammirati & Puris, Inc., 657 F. Supp. 380, 383 (S.D.N.Y. 1987) (Treatise cited); Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980) (Treatise quoted); Cofre, Inc. v. Lollytogs, Ltd., 20 U.S.P.Q.2d (BNA) 1546, 1549 (S.D.N.Y. 1991) (Treatise quoted); Original Appalachian Artworks, Inc. v. Blue Box Factory, 577 F. Supp. 625 (S.D.N.Y. 1983) (Treatise quoted); Ty, Inc. v. Le Clair, 103 F. Supp. 2d 1047, 1050 (N.D. Ill. 2000); NEC Corp. v. Intel Corp., 1989 Copyright L. Dec. (CCH) ¶ 26,379 (N.D. Cal. 1989); L & L White Metal Casting Corp. v. Joseph, 387 F. Supp. 1349 (E.D.N.Y. 1975). In See v. Durang, 711 F.2d 141 (9th Cir. 1983), the plaintiff argued that the trial court’s granting of summary judgment for defendant had precluded plaintiff from discovery as to earlier drafts of defendant’s work, which plaintiff argued might have reflected copying from plaintiff’s work that was disguised or deleted in later drafts. In upholding the summary judgment, the court of appeals ruled that “copying deleted or so disguised as to be unrecognizable is not copying.” [↑](#footnote-ref-393)
393. 128.1Baby Buddies, Inc. v. Toys R Us, Inc., 611 F.3d 1308, 1312 (11th Cir. 2010). [↑](#footnote-ref-394)
394. 128.2The court of appeals undertook its own investigation of the rival works, photos of which are appended to the opinion. *Id.* at 1322–1323. It concluded that “there are almost no similarities between the two pacifier holders beyond the general ideas of including a teddy bear (with the requisite ears, eyes, nose, mouth, arms, and legs), a ribbon bow, and a pastel-based color scheme on a baby’s pacifier holder. Any reasonable jury, properly instructed, would pick up on these differences and their cumulative effect on the noticeably different aesthetics embodied in the two pacifier holders.” *Id.* at 1320. [↑](#footnote-ref-395)
395. 128.3Lifetime Homes, Inc. v. Walker Homes, Inc., 485 F. Supp. 2d 1314, 1320, 1323 (M.D. Fla. 2007). In a previous ruling denying summary judgment, the court stated that “the floor plans of the two designs are ‘strikingly similar.’ ” Lifetime Homes, Inc. v. Residential Dev. Corp., 510 F. Supp. 2d 794, 805 (M.D. Fla. 2007). [↑](#footnote-ref-396)
396. 128.4Only a finite number of ways existed for either plaintiff or defendant to arrange three bedrooms, two baths, a kitchen, living room, and garage. 485 F. Supp. 2d at 1325. Notwithstanding those circumstances, plaintiff requested damages exceeding $92 million. See 510 F. Supp. 2d at 802. [↑](#footnote-ref-397)
397. 128.5485 F. Supp. 2d at 1325. The court noted that it was “constrained to conclude, reluctantly,” that no infringement exists. *Id*. at 1325. Given the consonance of the court’s ultimate conclusion with governing legal standards, there is no cause to object to that coloration. It is of interest, nonetheless, as a window into its writer’s background mind-frame that “copying is bad.” With equal justification, a different jurist might have the background mind-frame that “copying is good for the public weal” and thus be “constrained to conclude, reluctantly,” that infringement exists in a different case evincing substantial similarity. [↑](#footnote-ref-398)
398. 128.6Silas v. Home Box Office, Inc., 201 F. Supp. 3d 1158, 1169 (C.D. Cal. 2016) (Treatise quoted). [↑](#footnote-ref-399)
399. 128.7Stromback v. New Line Cinema, 384 F.3d 283, 299 (6th Cir. 2004). [↑](#footnote-ref-400)
400. 128.8Madrid v. Chronicle Books, 209 F. Supp. 2d 1227, 1235 (D. Wyo. 2002). The only similarities were “a big fat, furry monster with horns on its head, a small thin child, monsters in children’s closets and vice versa at night, a mother-child relationship.” *Id*. at 1241. [↑](#footnote-ref-401)
401. 128.9See Situation Mgmt. Sys. v. ASP Consulting Group, 535 F. Supp. 2d 231, 248–249 & n.11 (D. Mass. 2008), *vacated on other grounds*, 560 F.3d 53 (1st Cir. 2009) (Treatise cited). [↑](#footnote-ref-402)
402. 129See § 13.03[B][2][b] *infra*. [↑](#footnote-ref-403)
403. 130On the other hand, if defendant reproduces plaintiff’s anthology (*e.g.,* by photocopying), even for her own use, rather than buying an authorized copy for herself (see § 8.12[B] *supra*), liability might ensue. See Walt Disney Productions v. Filmation Associates, 628 F. Supp. 871, 876 (C.D. Cal. 1986) (material prepared for defendant’s animators to use in preparing movie held actionable copies). Cf. See v. Durang, 711 F.2d 141 (9th Cir. 1983). [↑](#footnote-ref-404)
404. 131See § 13.03[E][3][a][i] text accompanying N. 237 *infra*. See also Bucklew v. Hawkins, Ash, Baptie & Co., 329 F.3d 923, 930 (7th Cir. 2003) (“The fact that the paraphrase had been ‘derived’ in a genetic sense from a copyrighted original would not make it infringing.”). Cf. Religious Technology Ctr. v. Scott, 660 F. Supp. 515, 520 (C.D. Cal. 1987) (“The court further concluded, and remains convinced, that nobody could have created [defendant’s work] without having a copy of [plaintiff’s work] at hand. Such a conclusion does not necessarily imply a finding of substantial similarity of *expression* … .”). [↑](#footnote-ref-405)
405. 131.1In Narell v. Freeman, 872 F.2d 907, 910 (9th Cir. 1989), the defendant admitted consulting and “taking language from” plaintiff’s copyrighted history of the Jews of San Francisco; nonetheless, summary judgment for defendant was upheld on the basis that defendant did not thereby appropriate protected expression. *Id*. at 912. Likewise, in Nash v. CBS, Inc., 899 F.2d 1537 (7th Cir. 1990), the court affirmed summary judgment in favor of a defendant who conceded “copying of the book’s factual material.” Further, in Nelson v. PRN Prods., Inc., 873 F.2d 1141, 1144 (8th Cir. 1989), the court held irrelevant taking defendant’s deposition to ascertain whether he “copied,” given the determination as a matter of law that substantial similarity was lacking. See Green v. Proctor & Gamble, Inc., 709 F. Supp. 418, 421 (S.D.N.Y. 1989) (“nothing that could be found by the plaintiff in discovery would change this Court’s findings with regard to the extrinsic dissimilarities”). The lesson of these cases is that simple genealogical extraction is insufficient to prove substantial similarity. See also S.O.S., Inc. v. Payday, Inc., 886 F.2d 1081, 1089 n.10 (9th Cir. 1989); Harper House, Inc. v. Thomas Nelson, Inc., 889 F.2d 197 (9th Cir. 1989) (“[G]iven the negative connotations to copying,’ there was an obvious risk of an improper verdict for plaintiffs, and a need for further instructions to protect legitimate activity and avoid the suffocation of competition.”). See § 13.03[E][3][b][iii] *infra*. But see N.133.8 *infra*. [↑](#footnote-ref-406)
406. 132See § 13.03[A][2] regarding copying of a *de minimis* fragment. See also § 13.03[C] text accompanying N. 187 *infra.* [↑](#footnote-ref-407)
407. 132.1Dahlen v. Michigan Licensed Beverage Ass’n, 132 F. Supp. 2d 574, 582–83 (E.D. Mich. 2001). See the cases cited in § 13.01[B] N. 33 *supra*. [↑](#footnote-ref-408)
408. 132.2Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). [↑](#footnote-ref-409)
409. 132.3See the discussion of *Feist* in § 13.01[B] *supra*. [↑](#footnote-ref-410)
410. 133The defendant could claim that purchase of the program automatically conveys an implied license to copy via the appropriate keyboard commands. See § 10.03[A] *supra*. But such a defense is not guaranteed to prevail. See, *e.g.,* Red Baron-Franklin Park, Inc. v. Taito Corp., 883 F.2d 275 (4th Cir. 1989), reversed by statute as set forth in § 8.15[I] *supra*. Depending on the circumstances, the defendant could also rely on the various sanctioned uses of computer programs. See § 8.08 *supra*. [↑](#footnote-ref-411)
411. 133.1See § 3.04 *supra*. [↑](#footnote-ref-412)
412. 133.2Illinois Bell Tel. Co. v. Haines & Co., 905 F.2d 1081 (7th Cir. 1990). Note that this case was later vacated, based on the Supreme Court’s *Feist* decision. 932 F.2d 610 (7th Cir. 1991). See N. 133.13 *infra*. [↑](#footnote-ref-413)
413. 133.3See § 3.04[B][1] *supra* (discussing the parallel facts of Leon v. Pacific Tel. & Tel. Co.). [↑](#footnote-ref-414)
414. 133.4905 F.2d at 1085. [↑](#footnote-ref-415)
415. 133.5*Id*. at 1086. [↑](#footnote-ref-416)
416. 133.6See § 13.03[B][2][b] *infra*. [↑](#footnote-ref-417)
417. 133.7905 F.2d at 1086. [↑](#footnote-ref-418)
418. 133.8Under Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607, 614 (7th Cir.), *cert. denied*, 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 145 (1982), a two-part test applies: (1) whether the defendant copied from the plaintiff’s work and (2) whether the copying, if proven, went so far as to constitute an improper appropriation. *Illinois Bell* dispenses with the second prong. In another Seventh Circuit case that arose two months before *Illinois Bell*, the defendant conceded copying but maintained, as did the defendant in *Illinois Bell*, that only facts were appropriated and hence, no infringement occurred. Nash v. CBS, Inc., 899 F.2d 1537, 1539 (7th Cir. 1990). In *Nash* (in which the *Illinois* *Bell* opinion writer concurred), the Seventh Circuit panel unanimously denied liability, using language that undercuts the “sweat of the brow” rationale of *Illinois Bell*: “Copyright law does not protect hard work (divorced from expression) …” *Id*. at 1542. Further, the decision below in *Nash* reveals that the defendant there used photographs out of plaintiff’s book, but did not thereby impinge on the selection and arrangement of the plaintiff’s photo compilation. 704 F. Supp. 823, 830 (N.D. Ill. 1989), *aff’d*, 899 F.2d 1537 (7th Cir. 1990). Parallel reasoning should have led to no liability in *Illinois Bell* as well. [↑](#footnote-ref-419)
419. 133.9As previously noted, the defense of “de minimis” copying applies in copyright law only through the doctrine of substantial similarity. See § 8.01[G] *supra*. Having dispensed with substantial similarity and predicated liability solely upon “copying,” the *Illinois Bell* court must analytically hold even the one-word copier culpable. [↑](#footnote-ref-420)
420. 133.10See N. 133 *supra*. [↑](#footnote-ref-421)
421. 133.11Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). The defendant in *Feist* copied not only plaintiff’s information, but its alphabetical ordering as well. Thus, liability under the reasoning of *Illinois Bell* should have applied *a fortiori* in *Feist*. [↑](#footnote-ref-422)
422. 133.12See § 13.03[B][2][b] *infra*. [↑](#footnote-ref-423)
423. 133.13See 932 F.2d 610 (7th Cir. 1991). [↑](#footnote-ref-424)
424. 134Such similarity can be either comprehensive nonliteral or fragmented literal similarity. See §§ 13.03[A][1]–13.03[A][2] *supra*. [↑](#footnote-ref-425)
425. 135See § 2A.06[A][3][a] *supra*. [↑](#footnote-ref-426)
426. 136See § 13.03[B][2][b]–[c] *infra*. [↑](#footnote-ref-427)
427. 136aAndy Warhol Found. for Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 53 (2d Cir. 2021) (Treatise cited), *aff’d*, 143 S. Ct. 1258 (2023). R&B, Inc. v. Needa Parts Mfg., Inc., 50 F. App’x 519, 524 (3d Cir. 2002) (Treatise quoted). [↑](#footnote-ref-428)
428. 136.1See § 13.01 *supra*. [↑](#footnote-ref-429)
429. 136.2Whitehead v. Paramount Pictures Corp., 53 F. Supp. 2d 38, 46 (D.D.C. 1999) (emphasis original) (Treatise cited). [↑](#footnote-ref-430)
430. 136.3Milano v. NBC Universal, Inc., 584 F. Supp. 2d 1288, 1294–1295 (C.D. Cal. 2008) (Treatise quoted) (no infringement by “The Loser” of plaintiff’s proposed format for a TV show, “From Fat to Phat”). See LaJoie v. Pavcon, Inc., 146 F. Supp. 2d 1240, 1248 (M.D. Fla. 2000). [↑](#footnote-ref-431)
431. 136.4An example is Johnson Worldwide Assocs., Inc. v. Zebco Corp., 50 F. Supp. 2d 863, 870 (W.D. Wis. 1998) (in rival advertisements for fish trolling units, defendant appropriated creative elements), *aff’d on other grounds*, 175 F.3d 985 (Fed. Cir. 1999). [↑](#footnote-ref-432)
432. 136.5Rice v. Fox Broad. Co., 148 F. Supp. 2d 1029, 1053 (C.D. Cal. 2001) (Treatise quoted), *aff’d on copyright, rev’d on other grounds*, 330 F.3d 1170 (9th Cir. 2003). [↑](#footnote-ref-433)
433. 137See § 2A.06[A][3][a] *supra*. [↑](#footnote-ref-434)
434. 138Sparaco v. Lawler, Matusky, Skelly, Eng’rs LLP, 303 F.3d 460, 468 (2d Cir. 2002) (Treatise cited), *cert. denied*, 538 U.S. 945, 123 S. Ct. 1632, 155 L. Ed. 2d 485 (2003); Attia v. Society of N.Y. Hosp., 201 F.3d 50, 54 (2d Cir. 1999) (Treatise quoted), *cert. denied*, 531 U.S. 843, 121 S. Ct. 109, 148 L. Ed. 2d 67 (2000). See Alexander v. Irving Trust Co., 132 F. Supp. 364 (S.D.N.Y. 1955), *aff’d*, 228 F.2d 221 (2d Cir. 1955), *cert. denied,* 350 U.S. 996, 76 S. Ct. 545, 100 L. Ed. 860 (1956); Dave Grossman Designs, Inc. v. Bortin, 177 U.S.P.Q. 627 (N.D. Ill. 1973) (similarity of ideas but not of expression between statues); Reyher v. Children’s Television Workshop, 387 F. Supp. 869 (S.D.N.Y. 1975), *aff’d*, 533 F.2d 87 (2d Cir. 1976) (similarity of ideas but not of expression between illustrations); Burtis v. Universal Pictures Co., 40 Cal. 2d 823, 256 P.2d 933 (1953). [↑](#footnote-ref-435)
435. 139On the protection of ideas under state law, see Chap. 19D *infra*. In addition, of course, the entire corpus of patent law is available to protect inventions embodying novel methods and ideas. Demetriades v. Kaufmann, 680 F. Supp. 658, 662 (S.D.N.Y. 1988). See § 13.03[A][1][d] Ns. 78–80 *supra*. Of course, a vague allegation of “misappropriation of knowledge” fails. CogniTest Corp. v. Riverside Publishing Co., 36 U.S.P.Q.2d 1363, 1366 n.2 (N.D. Ill. 1995). [↑](#footnote-ref-436)
436. 140See Olson v. National Broadcasting Co., 855 F.2d 1446, 1453 (9th Cir. 1988); Data East USA, Inc. v. Epyx, Inc., 862 F.2d 204 (9th Cir. 1988); Aliotti v. R. Dakin & Co., 831 F.2d 898, 901 (9th Cir. 1987); Concrete Mach. Co. v. Classic Lawn Ornaments, Inc., 843 F.2d 600, 606 (1st Cir. 1988); Pazienza v. Saint Barnabas Medical Ctr., 921 F. Supp. 1274, 1276 (D.N.J. 1995); McCall v. Johnson Pub. Co., 680 F. Supp. 46, 49 (D.D.C. 1988). [↑](#footnote-ref-437)
437. 141565 U.S. 302, 132 S. Ct. 873, 181 L. Ed. 2d 835 (2012). [↑](#footnote-ref-438)
438. 142See § 19E.06[C][2][b] *infra*. [↑](#footnote-ref-439)
439. 143Veeck v. Southern Bldg. Code Cong. Int’l Inc., 293 F.3d 791, 819 n.31 (5th Cir. 2002) (Wiener, J., dissenting on behalf of six judges) (Treatise quoted), *cert. denied*, 539 U.S. 969, 123 S. Ct. 2636, 156 L. Ed. 2d 674 (2003) . See, *e.g.,* Direct Marketing of Va., Inc. v. E. Mishan & Sons, Inc., 753 F. Supp. 100 (S.D.N.Y. 1990) (designing watch face to show full-bodied cat looking at mouse circling cat in manner of a second hand is idea, whereas portraying Tabby cat facing left and stylized mouse is expression). [↑](#footnote-ref-440)
440. 144Croak v. Saatchi & Saatchi, N. Am., Inc., 174 F. Supp. 3d 829 (S.D.N.Y. 2016) (Treatise quoted). [↑](#footnote-ref-441)
441. 144.1*Id.* at 832, 833. [↑](#footnote-ref-442)
442. 144.2*Id.* at 837. [↑](#footnote-ref-443)
443. 144.2aSee Rentmeester v. Nike, Inc., 883 F.3d 1111, 1118–23 (9th Cir. 2018) (Treatise cited). On the surface, those similarities seem significant—and one judge dissented, believing that substantial similarity posed a jury issue. *Id.* at 1127–28 (Owens, J., concurring in part and dissenting in part). The majority disagreed on the basis that

     differences in selection and arrangement of elements, as reflected in the photos’ objective details, preclude as a matter of law a finding of infringement. Nike’s photographer made choices regarding selection and arrangement that produced an image unmistakably different from Rentmeester’s photo in material details—disparities that no ordinary observer of the two works would be disposed to overlook. What Rentmeester’s photo and the Nike photo share are similarities in general ideas or concepts: Michael Jordan attempting to dunk in a pose inspired by ballet’s *grand jeté*; an outdoor setting stripped of most of the traditional trappings of basketball; a camera angle that captures the subject silhouetted against the sky. Rentmeester cannot claim an exclusive right to ideas or concepts at that level of generality, even in combination.

     *Id.* at 1122–23. [↑](#footnote-ref-444)
444. 144.3Before reaching that example, a much more questionable ruling afforded protection to a “visual pun,” namely a foam wing nut that conveyed the idea of being “nuts” about the Detroit Red Wings. See Kellman v. Coca-Cola Co., 280 F. Supp. 2d 670, 676 (E.D. Mich. 2003). [↑](#footnote-ref-445)
445. 145JCW Invs., Inc. v. Novelty, Inc., 222 F. Supp. 2d 1030, 1035 (N.D. Ill. 2002). “Indeed, the concept of a farting doll certainly does not dictate a balding male, reclining in an armchair, wearing blue pants and a white tank top, whose flatulence sounds are activated by squeezing his right finger and always followed by some sort of commentary.” *Id*. The affirmance of a subsequent ruling in this case is to the same effect. 482 F.3d 910, 916 (7th Cir. 2007). [↑](#footnote-ref-446)
446. 146JCW Invs., Inc. v. Novelty, Inc., 289 F. Supp. 2d 1023, 1036 (N.D. Ill. 2003). [↑](#footnote-ref-447)
447. 147“A copyright defendant could always avoid liability merely by describing a plaintiff’s toy in great detail and then labeling that description the ‘idea’ of plaintiff’s toy.” *Id*. at 1036, *quoting* Midway Mfg. Co. v. Bandai-America, Inc., 546 F. Supp. 125, 148 (D.N.J. 1982). [↑](#footnote-ref-448)
448. 148289 F. Supp. 2d at 1036. A later opinion deals with the award of attorney’s fees. See § 14.10[E][3] *infra*. [↑](#footnote-ref-449)
449. 149482 F.3d 910 (7th Cir. 2007). [↑](#footnote-ref-450)
450. 150See Billco Int’l, Inc. v. Charles Prods., Inc., 776 F. Supp. 2d 105, 116 (D. Md. 2011) (concerning rival shot glasses with protruding three-dimensional animals). [↑](#footnote-ref-451)
451. 151The following excerpt from a child-rearing guide entitled *The Explosive Child* failed to reach copyright protection: “explosions are actually highly predictable.” Greene v. Ablon, 914 F. Supp. 2d 110, 116 (D. Mass. 2012). [↑](#footnote-ref-452)
452. 151.1On the other hand, the following except met the grade: “In other words, *your explanation guides your intervention*.” *Id.* at 120 (emphasis original). [↑](#footnote-ref-453)
453. 151.2*Id.* at 125. The First Circuit affirmed the ruling to emerge from the subsequent trial, in which the jury awarded plaintiff $19,000. 794 F.3d 133 (1st Cir. 2015). Its ruling most notably addresses an accounting by joint authors. See § 6.12[C][3] *supra*. [↑](#footnote-ref-454)
454. 151.3As a matter of constitutionally delegated powers, the Copyright Clause probably allows Congress to extend the copyright monopoly to ideas. See § 1.08[D] *supra*. Nonetheless, even as a matter of constitutional law, the First Amendment may command otherwise. See § 19E.04[B][2] *infra*. [↑](#footnote-ref-455)
455. 151.3aRentmeester v. Nike, Inc., 883 F.3d 1111, 1123 (9th Cir. 2018) (Treatise quoted). [↑](#footnote-ref-456)
456. 151.4Attia v. Society of N.Y. Hosp., 201 F.3d 50, 54 (2d Cir. 1999) (paragraph of Treatise quoted), *cert. denied*, 531 U.S. 843, 121 S. Ct. 109, 148 L. Ed. 2d 67 (2000); CCC Info Servs., Inc. v. Maclean Hunter Market Reports, Inc., 44 F.3d 61, 69 & n.11 (2d Cir. 1994) (paragraph of Treatise quoted); Arden v. Columbia Pictures Indus., Inc., 908 F. Supp. 1248, 1258 n.3 (S.D.N.Y. 1995) (Treatise quoted). See Becker v. Loew’s, Inc., 133 F.2d 889 (7th Cir. 1943); Eichel v. Marcin, 241 F. 404 (S.D.N.Y. 1917). [↑](#footnote-ref-457)
457. 151.5Attia v. Society of N.Y. Hosp., 201 F.3d 50, 56 (2d Cir. 1999), *cert. denied*, 531 U.S. 843, 121 S. Ct. 109, 148 L. Ed. 2d 67 (2000). *Attia* formed the template for a later case that, like it, arose in the domain of architecture. See Peter F. Gaito Architecture, LLC v. Simone Dev. Corp., 602 F.3d 57, 68 (2d Cir. 2010) For more discussion of these cases, see § 2A.06[A][3][a] *supra*. [↑](#footnote-ref-458)
458. 151.6Satava v. Lowry, 323 F.3d 805, 813 (9th Cir.), *cert. denied*, 540 U.S. 983, 124 S. Ct. 472, 157 L. Ed. 2d 374 (2003), discussed in § 3.04[B][2][b] *supra*. [↑](#footnote-ref-459)
459. 151.7Eichel v. Marcin, 241 F. 404, 410 (S.D.N.Y. 1917). [↑](#footnote-ref-460)
460. 152Sayre v. Moore, 102 Eng. Rep. 139, 140 (1785). For a more modern statement to the same effect, see the discussion of the “delicate equilibrium” in Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 696 (2d Cir. 1992). [↑](#footnote-ref-461)
461. 152.1See § 3.04 & N. 6 *supra*. Of course, that example presupposes that the public domain work will remain unprotected; if restored to copyright, the entire work may become protectible. See Chap. 9A *supra*. [↑](#footnote-ref-462)
462. 152.2Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc., 338 F.3d 127, 132 (2d Cir. 2003). [↑](#footnote-ref-463)
463. 152.3Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc., 338 F.3d 127 (2d Cir. 2003); C & F Enters. Inc. v. Barringtons Inc., 43 U.S.P.Q.2d 1607, 1610 (E.D. Va. 1997). [↑](#footnote-ref-464)
464. 152.4See Bucklew v. Hawkins, Ash, Baptie & Co., 329 F.3d 923, 930 (7th Cir. 2003) (“a nonexistent line has no expressive content, except possibly in the most advanced modern art. Cf. Georges Perec, *La Disparation* (1969)—a 300-page novel written without the letter e.”). [↑](#footnote-ref-465)
465. 152.5Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc., 338 F.3d 127, 136 (2d Cir. 2003). [↑](#footnote-ref-466)
466. 152.6Psihoyos v. National Geographic Soc’y, 409 F. Supp. 2d 268, 275 (S.D.N.Y. 2005) (Treatise quoted). In Shaw v. Lindheim, 919 F.2d 1353, 1360 (9th Cir. 1990), the court commented that the scope of copyright protection for “representational objects” is “necessarily narrow.” However, such “representational objects” include not only forms of nature but a karate video game as well. [↑](#footnote-ref-467)
467. 152.7Sahuc v. Tucker, 300 F. Supp. 2d 461, 465 n.5 (E.D. La. 2004) (Treatise cited). In Hart v. Dan Chase Taxidermy Supply Co., 884 F. Supp. 71, 76 (N.D.N.Y. 1995), the court denied protection to the form of mannequins “commanded by the idea of a realistic fish.” Reversing on appeal, the court noted that “[w]hether the fish is shown as resting, jumping, wiggling its tail, or preparing to munch on some plankton” reflects expression. 86 F.3d 320, 323 (2d Cir. 1996). But on remand, the court determined that “the only arguable expressive choices for the carvers that are visibly manifested in any significant way in the finished fish is the cant, or ‘swish’ of the tail.” 967 F. Supp. 70 (N.D.N.Y. 1997) (dismissing plaintiff’s case).

     See Sportsmans Warehouse, Inc. v. Fair, 576 F. Supp. 2d 1175, 1179, 1186 (D. Colo. 2008) (no protection for physiology and attitude of elk in flehman, which is a sniffing pose adopted by ungulates during mating season); First Am. Artificial Flowers v. Joseph Markovits, Inc., 342 F. Supp. 178 (S.D.N.Y. 1972) (artificial flowers based on “pattern” taken from nature). *Compare* Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., 378 F. Supp. 485 (S.D.N.Y. 1974), *aff’d*, 509 F.2d 64 (2d Cir. 1974) (where the only similarity was physical likeness of a turtle, “each designer was merely representing nature”) *with* Samet & Wells, Inc. v. Shalom Toy Co., 185 U.S.P.Q. 36 (E.D.N.Y. 1975) (defendant’s turtle held to infringe plaintiff’s original contribution to its turtle). Imperial Toy Corp. v. Goffa Int’l Corp., 988 F. Supp. 617, 621 (E.D.N.Y. 1997) (copying bizarre interpretations of stuffed animals actionable); Cf. PPS, Inc. v. Jewelry Sales Representatives, Inc., 392 F. Supp. 375 (S.D.N.Y. 1975) (similarity between apples held to be of protectible expression, not merely of idea); Concrete Mach. Co. v. Classic Lawn Ornaments, Inc., 843 F.2d 600 (1st Cir. 1988) (minor differences in concrete statues of deer not dispositive); Designer’s View, Inc. v. Publix Super Markets, Inc., 764 F. Supp. 1473 (S.D. Fla. 1991) (vegetables portrayed differently on stained glass); Gund, Inc. v. Smile Int’l, Inc., 691 F. Supp. 642 (E.D.N.Y. 1988), *aff’d mem*., 872 F.2d 1021 (2d Cir. 1989) (denying preliminary injunction for floppy dog toy); Jungle Rags Inc. v. Rainbow Graphics Inc., 29 U.S.P.Q.2d 1704, 1710 (M.D. Fla. 1993) (differences in portrayal of orca whale); Gund, Inc. v. Applause, Inc., 809 F. Supp. 304 (S.D.N.Y. 1993); Streeter v. Rolfe, 491 F. Supp. 416 (W.D. La. 1980); Franklin Mint v. National Wildlife Art Exch., 575 F.2d 62 (3d Cir.), *cert. denied*, 439 U.S. 880, 99 S. Ct. 217, 58 L. Ed. 2d 193 (1978). [↑](#footnote-ref-468)
468. 152.8See § 13.03[A][4] *supra*. [↑](#footnote-ref-469)
469. 152.9An example is a case limiting protection for sculptures portraying a polar bear on its hind legs and other like poses. See Enchant Christmas Light Maze & Mkt. Ltd. v. Glowco, LLC, 958 F.3d 532, 538 (6th Cir. 2020). Given that most alleged similarities with defendant’s products flowed simply from depicting animals in naturally occurring poses, plaintiff could not obtain a preliminary injunction. *Id.* at 539. [↑](#footnote-ref-470)
470. 153See Maharishi Hardy Blechman Ltd. v. Abercrombie & Fitch Co., 292 F. Supp. 2d 535, 553 (S.D.N.Y. 2003). [↑](#footnote-ref-471)
471. 153.1Coquico, Inc. v. Rodríguez-Miranda, 562 F.3d 62, 65, 70 (1st Cir. 2009) (finding infringement of plaintiff’s plush toy of coquí, “a small brown tree frog much beloved in Puerto Rico,” based on similarities in stitching, color, posture, size, and sewn-on flag in the same location of defendant’s work); Lucky Break Wishbone Corp. v. Sears, Roebuck & Co., 528 F. Supp. 2d 1106, 1115, 1121 (W.D. Wash. 2007) (according protection to wishbone, which plaintiff’s avian expert described as embodying non-standard elements of furcula). [↑](#footnote-ref-472)
472. 153.2Satava v. Lowry, 323 F.3d 805, 811 (9th Cir.), *cert. denied*, 540 U.S. 983 (2003). [↑](#footnote-ref-473)
473. 154Attia v. Society of N.Y. Hosp., 201 F.3d 50, 58 (2d Cir. 1999) (Treatise cited), *cert. denied*, 531 U.S. 843, 121 S. Ct. 109, 148 L. Ed. 2d 67 (2000); Feder v. Videotrip Corp., 697 F. Supp. 1165, 1169 (D. Colo. 1988) (Treatise quoted). See § 2.11 *supra*. [↑](#footnote-ref-474)
474. 154.1Nash v. CBS, Inc., 899 F.2d 1537 (7th Cir. 1990) (“CBS did no more than § 102(b) permits”). In Narell v. Freeman, 872 F.2d 907 (9th Cir. 1989), summary judgment for defendant was granted, notwithstanding that she admitted taking some language from plaintiff’s factual work, *e.g.,* “beach was strewn with boxes, bales.” *Id*. at 911. Plaintiff’s allegation in that case that the total copying amounted to 300 words, *id*. at 909, was presumably rejected by both trial and appellate courts holding in defendant’s favor. [↑](#footnote-ref-475)
475. 155471 U.S. 539, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985). The Court declined overtly to reach the “currently unsettled” question as to “the ways in which uncopyrightable elements combine with the author’s original contributions to form protected expression.” *Id*. at 548. [↑](#footnote-ref-476)
476. 156See also McMahon v. Prentice-Hall, Inc., 486 F. Supp. 1296 (E.D. Mo. 1980). [↑](#footnote-ref-477)
477. 157471 U.S. at 556 (“No author may copyright his ideas or the facts he narrates.”). By contrast, in United Tel. Co. of Mo. v. Johnson Pub. Co., 855 F.2d 604 (8th Cir. 1988), although the court started by enunciating the appropriate test that plaintiff must show that defendant appropriated “protected expression,” *id*. at 608, later, on the same page, the court called plaintiff’s phone book “protected expression of the preexisting names, addresses, and telephone numbers of its subscribers. By taking this *information* … [defendant] has copied ‘material *contributed by the author*.’ ” *Id*. (emphasis added). The italicized excerpts are mutually contradictory. Given that plaintiff presumably authored neither the information nor its organization (“alphabetical lists of residents and businesses, with last names first, followed by first names, and addresses,” *id*. at 609), it is difficult to imagine what protectible material defendant may have appropriated. [↑](#footnote-ref-478)
478. 158See § 13.05[B], for a discussion of the fair use aspect of the case. [↑](#footnote-ref-479)
479. 159See also Meredith Corp. v. Harper & Row, Publishers, Inc., 378 F. Supp. 686 (S.D.N.Y. 1974), *aff’d*, 500 F.2d 1221 (2d Cir. 1974) (infringement found where there was “an extensive taking of the entire structure and topical sequence” of nonfiction text); Marcus v. Rowley, 695 F.2d 1171, 1177 (9th Cir. 1983) (“Even if it were true that plaintiff’s book contained only facts, this argument fails because defendant engaged in virtually verbatim copying.”); Consolidated Music Publications, Inc. v. Hansen Publications, Inc., 339 F. Supp. 1161 (S.D.N.Y. 1972) (infringing paraphrased similarities of text between two nonfiction works). [↑](#footnote-ref-480)
480. 159.1Hoehling v. Universal City Studios, Inc., 618 F.2d 972 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980). [↑](#footnote-ref-481)
481. 159.2An example could be reporting the happenstance of the page number on which, by the will of the printer, a public domain judicial opinion happened to fall in a judicial reporter that, as a whole (as opposed to pagination), may be subject to copyright. See § 3.03[B][2] *supra*. [↑](#footnote-ref-482)
482. 159.3Castle Rock Ent. v. Carol Pub. Group, Inc., 150 F.3d 132 (2d Cir. 1998), demonstrates this proposition. The producers of the *Seinfeld* TV show sued the compiler of a quiz book entitled the Seinfeld Aptitude Test. “*The SAT* does not quiz such true facts as the identity of the actors in *Seinfeld,* the number of days it takes to shoot an episode, the biographies of the actors, the location of the *Seinfeld* set, etc. Rather, *The SAT* tests whether the reader knows that the character Jerry places a Pez dispenser on Elaine’s leg during a piano recital, that Kramer enjoys going to the airport because he’s hypnotized by the baggage carousels, and that Jerry, opining on how to identify a virgin, said ‘It’s not like spotting a toupee.’ ” *Id.* at 139. [↑](#footnote-ref-483)
483. 160Calhoun v. Lillenas Publ’g, 298 F.3d 1228, 1233 n.11 (11th Cir. 2002) (Treatise quoted); Engineering Dynamics, Inc. v. Structural Software, Inc., 26 F.3d 1335, 1348 (5th Cir. 1994) (Treatise quoted); Landsberg v. Scrabble Crossword Game Players, Inc., 736 F.2d 485 (9th Cir. 1984) (Treatise cited), *cert. denied*, 469 U.S. 1037 (1984); Queenie, Ltd. v. Casual Corner Group, Inc., 79 F. Supp. 2d 328, 329 (S.D.N.Y. 1999) (Treatise quoted); Queenie, Ltd. v. Hot Stuff, Inc., 102 F. Supp. 2d 512, 514 (S.D.N.Y. 2000) (Treatise quoted); Queenie, Ltd. v. Sears, Roebuck & Co., 124 F. Supp. 2d 178, 181 (S.D.N.Y. 2000) (Treatise quoted); Kepner-Tregoe, Inc. v. Executive Dev., Inc., 79 F. Supp. 2d 474, 485 n.10 (D.N.J. 1999) (Treatise quoted); Berkla v. Corel Corp., 66 F. Supp. 2d 1129, 1143 (E.D. Cal. 1999) (Treatise quoted); Deering Milliken, Inc. v. Quaker Fabric Corp., 187 U.S.P.Q. 288 (S.D.N.Y. 1975) (Treatise quoted); Kepner-Tregoe, Inc. v. Carabio, 203 U.S.P.Q. (BNA) 124 (E.D. Mich. 1979) (Treatise cited). See Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 491 (9th Cir. 1985); Concord Fabrics, Inc. v. Generation Mills, Inc., 328 F. Supp. 1030 (S.D.N.Y. 1971); National Presto Industries, Inc. v. Hamilton Beach, Inc., 18 U.S.P.Q.2d (BNA) 1993, 1997 (N.D. Ill. 1990); Lauratex Textile Corp. v. Citation Fabrics Corp., 328 F. Supp. 554 (S.D.N.Y. 1971). Likewise, near identity is required if the idea of a work and its expression are indistinguishable. Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp., 562 F.2d 1157 (9th Cir. 1977). [↑](#footnote-ref-484)
484. 160.1499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). [↑](#footnote-ref-485)
485. 160.2The case is discussed in more detail in § 3.04[B][2][a] *supra*. [↑](#footnote-ref-486)
486. 160.3499 U.S. at 344. See Key Publications, Inc. v. Chinatown Today Pub. Enters., Inc., 945 F.2d 509, 516 (2d Cir. 1991) (“the fact that [defendants] may have copied the names and addresses it selected from the [plaintiff’s directory does not] support a finding of infringement so long as the principles guiding that selection differ from those of the copied work”). [↑](#footnote-ref-487)
487. 160.4499 U.S. at 344. See § 13.03[C] *infra*. [↑](#footnote-ref-488)
488. 160.5See § 13.04[B] *supra*. [↑](#footnote-ref-489)
489. 160.6499 U.S. at 344. [↑](#footnote-ref-490)
490. 160.7*Id.* at 344. [↑](#footnote-ref-491)
491. 160.8*Id.* at 348. [↑](#footnote-ref-492)
492. 160.9*Id.* at 348. See Corsearch, Inc. v. Thomson & Thomson, 792 F. Supp. 305, 322 (S.D.N.Y. 1992) (others free to copy out of copyrighted compendium those materials—to the extent identifiable—that were obtained from governmental agencies). [↑](#footnote-ref-493)
493. 160.10See § 13.03[A][4] *supra*. [↑](#footnote-ref-494)
494. 160.10aCivility Experts Worldwide v. Molly Manners, LLC, 167 F. Supp. 3d 1179, 1215 (D. Colo. 2016) (Treatise quoted); Abarca Health, LLC v. PharmPix Corp., 806 F. Supp. 2d 483, 490, 491 (D.P.R. 2011) (Treatise quoted); Maddog Software, Inc. v. Sklader, 382 F. Supp. 2d 268, 277 (D.N.H. 2005) (Treatise quoted). “Though [plaintiff] establishes access to [its] enneagram labels, and indeed substantial similarity from which copying may be inferred, it is unable to demonstrate similarity of *copyrightable* elements.” Arica Inst., Inc. v. Palmer, 970 F.2d 1067, 1074 (2d Cir. 1992) (emphasis original). [↑](#footnote-ref-495)
495. 160.11See Chap. 10 *supra*. [↑](#footnote-ref-496)
496. 160.12See 17 U.S.C. § 201(d). [↑](#footnote-ref-497)
497. 160.13Eiben v. A. Epstein & Sons Int’l, 57 F. Supp. 2d 607, 612 (N.D. Ill. 1999); Alentino Ltd. v. Chenson Enters. Inc., 938 F.2d 26 (2d Cir. 1991) (elements of accord and satisfaction not satisfied), *rev’d in part*, 968 F.2d 250 (2d Cir. 1992). See Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1473 (9th Cir.), *cert. denied*, 506 U.S. 869, 113 S. Ct. 198, 121 L. Ed. 2d 141 (1992) (citing opinion below). See also § 13.03[B][2][b] *supra*. [↑](#footnote-ref-498)
498. 160.14Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435, 1439 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995). Given its finding that “[a]uthorized copying accounts for more than 90% of the allegedly infringing features,” plaintiff’s inability to demonstrate virtual identity as to the balance doomed its case. *Id*. at 1442. See Newton v. Diamond, 388 F.3d 1189, 1197 (9th Cir. 2004), *cert. denied*, 545 U.S. 1114, 125 S. Ct. 2905, 162 L. Ed. 2d 294 (2005) (“we must ‘filter out’ the licensed elements”). [↑](#footnote-ref-499)
499. 160.14aBroadcast Music, Inc. v. 84–88 Broadway, Inc., 942 F. Supp. 225, 231 (D.N.J. 1996) (Treatise quoted). [↑](#footnote-ref-500)
500. 160.15See § 13.03[F][4] N. 337.2 *infra*. [↑](#footnote-ref-501)
501. 160.15aStorage Tech. Corp. v. Custom Hardware Eng’g & Consulting, Inc., 421 F.3d 1307, 1316 (Fed. Cir. 2005). [↑](#footnote-ref-502)
502. 160.15bS.O.S., Inc. v. Payday, Inc., 886 F.2d 1081, 1087 (9th Cir. 1989). [↑](#footnote-ref-503)
503. 160.15cStorage Tech. Corp. v. Custom Hardware Eng’g & Consulting, Inc., 421 F.3d 1307, 1316 (Fed. Cir. 2005). [↑](#footnote-ref-504)
504. 160.16See Chap. 10 *infra.* [↑](#footnote-ref-505)
505. 160.17For instance, in Cafferty v. Scotti Bros. Records, Inc., 969 F. Supp. 193, 198 (S.D.N.Y. 1997), defendants distributed records after a purported termination authorized by contract. Standing alone, that conduct would constitute infringement. See § 10.15[B] *infra.* But because that termination provision was set forth in a contract issued subsequent to prior grants, which were themselves irrevocable and moreover authorized the subject activity, the infringement claim failed. *Id.* at 198–199. [↑](#footnote-ref-506)
506. 160.18See Fogerty v. Fantasy, Inc., 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 455 (1994), discussed in § 14.10[D][3] *infra*. [↑](#footnote-ref-507)
507. 160.19See Gross v. Seligman, 212 F. 930 (2d Cir. 1914), discussed in § 2A.08[E][3][b][ii] *supra*. [↑](#footnote-ref-508)
508. 160.20One lively article explores what goes into an artist’s style, and suggests altering copyright doctrine by importing the “shop right” doctrine from patent law to give authors a type of “moral shop right” to draw upon their past works. See Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 Cardozo Arts & Ent. L.J. 81, 125–138 (1998). [↑](#footnote-ref-509)
509. 160.20aSee Steele v. Turner Broad. Sys., Inc., 646 F. Supp. 2d 185, 188, 192 (D. Mass. 2009). [↑](#footnote-ref-510)
510. 160.20b*Id*. at 190–192. [↑](#footnote-ref-511)
511. 160.20cThe opinion lists four allegations, such as that plaintiff’s song exhorted fans to “Get up off your seats,” corresponding exactly to the promo showing fans standing and cheering. *Id*. at 192. [↑](#footnote-ref-512)
512. 160.20d*Id*. at 192. See § 13.03[B][4] *infra*. Undeterred, plaintiff continued to litigate away. See Steele v. Turner Broad. Sys., Inc., 746 F. Supp. 2d 231 (D. Mass. 2010). See also 789 F. Supp. 2d 245 (D. Mass. 2011); 784 F. Supp. 2d 94 (D. Mass. 2011). [↑](#footnote-ref-513)
513. 161See § 13.03[B][2][a] *supra*. [↑](#footnote-ref-514)
514. 162Ross, Brovins & Oehmke, P.C. v. Lexis/Nexis, 348 F. Supp. 2d 845, 854 (E.D. Mich. 2004) (Treatise quoted)*, aff’d (as to copyright), rev’d (as to contract)*, 463 F.3d 478 (6th Cir. 2006). [↑](#footnote-ref-515)
515. 162.1Design Basics, LLC v. Signature Constr., Inc., 994 F.3d 879, 889 (7th Cir. 2021) (Treatise cited); R.W. Beck, Inc. v. E3 Consulting, LLC, 577 F.3d 1133, 1144–1145 (10th Cir. 2009) (Treatise quoted as “leading treatise”); New York Mercantile Exch., Inc. v. IntercontinentalExchange, Inc., 497 F.3d 109, 117 (2d Cir. 2007) (Treatise quoted), *cert. denied*, 552 U.S. 1259, 128 S. Ct. 1669, 170 L. Ed. 2d 357 (2008); Marshall & Swift v. BS & A Software, 871 F. Supp. 952, 961 (W.D. Mich. 1994) (Treatise quoted); Bevan v. Columbia Broadcasting Sys., Inc., 329 F. Supp. 601 (S.D.N.Y. 1971) (Treatise cited). Register of Copyrights, *Copyright Protections for Press Publishers* 33 n.173 (June 2022) (Treatise quoted). See Data East USA, Inc. v. Epyx, Inc., 862 F.2d 204, 208 (9th Cir. 1988); Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485 (9th Cir. 1985); Monogram Models, Inc. v. Industro Motive Corp., 448 F.2d 284 (6th Cir. 1971); McGraw-Hill, Inc. v. Worth Publishers, Inc., 335 F. Supp. 415 (S.D.N.Y. 1971). [↑](#footnote-ref-516)
516. 162.2Financial Control Assoc., Inc. v. Equity Builders, Inc., 799 F. Supp. 1103, 1118 (D. Kan. 1992) (Treatise quoted), *reconsideration denied*, 812 F. Supp. 198, 202 (D. Kan. 1993). See Lexmark Int’l, Inc. v. Static Control Components, Inc., 387 F.3d 522, 535 (6th Cir. 2004) (Treatise cited); Autoskill, Inc. v. National Educ. Sup. Sys., Inc., 994 F.2d 1476, 1494 (10th Cir.) (Treatise cited), *cert. denied*, 510 U.S. 916, 114 S. Ct. 307, 126 L. Ed. 2d 254 (1993). [↑](#footnote-ref-517)
517. 162.3101 U.S. 99, 25 L. Ed. 841 (1879). [↑](#footnote-ref-518)
518. 162.4See §§ 2A.05-2A.06 *supra*. [↑](#footnote-ref-519)
519. 162.5“In no case does copyright protection … extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery … .” 17 U.S.C. § 102(b). See § 2A.06[A] *supra*. [↑](#footnote-ref-520)
520. 162.6Crume v. Pacific Mut. Life Ins. Co., 140 F.2d 182, 184 (7th Cir. 1944). See § 2A.06[B][1][b] *supra*. [↑](#footnote-ref-521)
521. 162.7Educational Testing Serv. v. Katzman, 793 F.2d 533, 539 (3d Cir. 1986) (Treatise cited). See, Toro Co. v. R & R Products Co., 787 F.2d 1208 (8th Cir. 1986), *aff’g* 600 F. Supp. 400 (D. Minn. 1984) (“We do not believe that the idea of a parts numbering system is susceptible of only a very limited number of expressions.”). [↑](#footnote-ref-522)
522. 162.8“The defendant uses a similar plan so far as results are concerned; but makes a different arrangement of the columns, and uses different headings.” 101 U.S. at 100. [↑](#footnote-ref-523)
523. 162.9See Crume v. Pacific Mut. Ins. Co., 140 F.2d 182 (7th Cir.), *cert. denied*, 322 U.S. 755, 64 S. Ct. 1265, 88 L. Ed. 1584 (1944); Long v. Jordan, 29 F. Supp. 287 (N.D. Cal. 1939); Dorsey v. Old Sur. Life Ins. Co., 98 F.2d 872 (10th Cir, 1938). [↑](#footnote-ref-524)
524. 163See § 13.03[A] *supra*. [↑](#footnote-ref-525)
525. 163.1One case agrees that “in theory there are numerous ways to place this information in chart form,” but from a practical standpoint rules against plaintiff apparently based on the “blank form” doctrine. Matthew Bender & Co. v. Kluwer Law Book Pubs., Inc., 672 F. Supp. 107 (S.D.N.Y. 1987). See § 2A.08[D][2] *supra*. [↑](#footnote-ref-526)
526. 163.2See Higgins v. Baker, 309 F. Supp. 635 (S.D.N.Y. 1970) (“it must initially be determined whether the material allegedly infringed was in fact subject to severely limited means of expression”). [↑](#footnote-ref-527)
527. 163.3379 F.2d 675 (1st Cir.), *aff’g* 262 F. Supp. 737 (D. Mass. 1967). [↑](#footnote-ref-528)
528. 163.4*Id.* at 678 (“there was more than one way of expressing even this simple substance”). [↑](#footnote-ref-529)
529. 163.5*Id.* at 678. [↑](#footnote-ref-530)
530. 163.6*Id.* at 679. At the other end of the spectrum, when there are “an infinite number of ways of stating [plaintiff’s] theory,” then a *verbatim* copying of plaintiff’s expression should properly be held infringing. See Rubin v. Boston Magazine Co., 645 F.2d 80, 83 (1st Cir. 1981). [↑](#footnote-ref-531)
531. 163.7One example is a case regarding plaintiff’s rulebook for the game of Caroms. Affiliated Hosp. Prods., Inc. v. Merdel Game Mfg. Co., 513 F.2d 1183, 1188, 1189 n.11 (2d Cir. 1975) (“the simplicity of the games makes the subject matter extremely narrow, and the distinction between substance and arrangement blurs.”). See Freedman v. Grolier Enters., Inc., 179 U.S.P.Q. 476 (S.D.N.Y. 1973). [↑](#footnote-ref-532)
532. 163.8One case limited *Morrissey* to situations in which there is “de minimis copying and availability of only limited number of forms of expression … .” Telex Corp. v. International Business Mach. Corp., 367 F. Supp. 258 (N.D. Okla. 1973)*, aff’d in part, rev’d in part*, 510 F.2d 894 (10th Cir.), *cert. dismissed*, 423 U.S. 802, 96 S. Ct. 8, 46 L. Ed. 2d 244 (1975). Another refused to apply *Morrissey* to deny copyright protection to a motion picture film of the Kennedy assassination. See Time, Inc. v. Bernard Geis Associates, 293 F. Supp. 130 (S.D.N.Y. 1968). The court nonetheless concluded that the “public interest in having the fullest information available on the murder of President Kennedy” plus the nature of the defendant’s work, entitled defendant to assert the defense of fair use. See § 13.05[B][5] *infra*. [↑](#footnote-ref-533)
533. 163.9See Decorative Aides Corp. v. Staple Sewing Aides Corp., 497 F. Supp. 154 (S.D.N.Y. 1980), *aff’d*, 657 F.2d 262 (2d Cir. 1981); John H. Harland Co. v. Clarke Checks, Inc., 207 U.S.P.Q. 664 (N.D. Ga. 1980), *aff’d*, 711 F.2d 966 (11th Cir. 1983); [↑](#footnote-ref-534)
534. 164See Black & Decker (U.S.) Inc. v. Pro-Tech Power Inc., 26 F. Supp. 2d 834, 860-61 (E.D. Va. 1998) (diagram of miter saw in instruction manual). One case found an issue of fact posed whether the concept expressed in plaintiff’s bond offering documents is capable of varied expression. Merritt Forbes & Co. v. Newman Inv. Sec., Inc., 604 F. Supp. 943, 951 (S.D.N.Y. 1985) (Treatise quoted). [↑](#footnote-ref-535)
535. 165446 F.2d 738 (9th Cir. 1971). [↑](#footnote-ref-536)
536. 166*Id.* at 742. [↑](#footnote-ref-537)
537. 167*Id.* at 740. [↑](#footnote-ref-538)
538. 167.1*Id.* at 740. [↑](#footnote-ref-539)
539. 167.2*Id.* at 742. [↑](#footnote-ref-540)
540. 167.3The same plaintiff was successful in another suit involving the identical bee. See Herbert Rosenthal Jewelry Corp. v. Grossbardt, 436 F.2d 315 (2d Cir. 1970). But it failed to extend that ruling via collateral estoppel to yet another defendant. See Herbert Rosenthal Jewelry Corp. v. Zale Corp., 323 F. Supp. 1234 (S.D.N.Y. 1971). It is to be added that neither of those latter opinions cited *Baker v. Selden*. [↑](#footnote-ref-541)
541. 167.4See § 13.03[B][3][b] *supra*. [↑](#footnote-ref-542)
542. 167.5Oracle Am., Inc. v. Google Inc., 750 F.3d 1339, 1364 (Fed. Cir. 2014) (Treatise quoted), *cert. denied*, 135 S. Ct. 2887 (2015); Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607 (7th Cir.) (Treatise quoted), *cert. denied*, 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 145 (1982); Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980) (Treatise quoted); Gibson Tex, Inc. v. Sears Roebuck & Co., 11 F. Supp. 2d 439, 444 (S.D.N.Y. 1998) (Treatise quoted); Hennon v. Kirklands, Inc., 870 F. Supp. 118, 121 (W.D. Va. 1994) (Treatise quoted), *aff’d mem*., 64 F.3d 657 (4th Cir. 1995); Past Pluto Prods. Corp. v. Dana, 627 F. Supp. 1435, 1444 (S.D.N.Y. 1986) (Treatise quoted in *dictum*); Harvey Cartoons v. Columbia Pictures Indus., Inc., 645 F. Supp. 1564, 1571 n.9 (S.D.N.Y. 1986) (Treatise quoted in *dictum*); E.F. Johnson Co. v. Uniden Corp. of Am., 623 F. Supp. 1485, 1500 (D. Minn. 1985) (Treatise quoted); Iris Arc v. S.S. Sarna, Inc., 621 F. Supp. 916, 924 (E.D.N.Y. 1985) (Treatise quoted); Pendleton v. Acuff-Rose Publications, Inc., 605 F. Supp. 477, 486 (M.D. Tenn. 1984) (Treatise quoted); Atari, Inc. v. Amusement World, Inc., 547 F. Supp. 222 (D. Md. 1981) (Treatise cited). [↑](#footnote-ref-543)
543. 167.6Reyher v. Children’s Television Workshop, 533 F.2d 87 (2d Cir.) (Treatise quoted), *cert. denied*, 429 U.S. 980, 97 S. Ct. 492, 50 L. Ed. 2d 588 (1976). See Ricker v. General Elec. Co., 162 F.2d 141 (2d Cir. 1947); Gaye v. Gillis, 167 F. Supp. 416 (D. Mass. 1958); Caddy-Imler Creations, Inc. v. Caddy, 299 F.2d 79 (9th Cir. 1962); Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904 (3d Cir. 1975), *cert. denied*, 423 U.S. 863, 96 S. Ct. 122, 46 L. Ed. 2d 92 (1975); Lapsley v. American Inst. of Certified Pub. Accountants, 246 F. Supp. 389 (D.D.C. 1965); Miller Brewing Co. v. Carling O’Keefe Breweries of Canada, Ltd., 452 F. Supp. 429 (W.D.N.Y. 1978); Alexander v. Haley, 460 F. Supp. 40 (S.D.N.Y. 1978); Iowa State Univ. Research Found., Inc. v. American Broadcasting Cos., 463 F. Supp. 902 (S.D.N.Y. 1978), *aff’d*, 621 F.2d 57 (2d Cir. 1980); Mattell, Inc. v. S. Rosenberg Co., 296 F. Supp. 1024 (S.D.N.Y. 1968); MacMillan Co. v. King, 223 F. 862 (D. Mass. 1914); Ideal Toy Corp. v. Adanta Novelties Corp., 223 F. Supp. 866 (S.D.N.Y. 1963). [↑](#footnote-ref-544)
544. 168See Arica Inst., Inc. v. Palmer, 970 F.2d 1067, 1076 (2d Cir. 1992) (human ego fixations capable of being diagrammed in ways other than using Gurdjieff’s enneagram, rendering merger defense inapplicable). [↑](#footnote-ref-545)
545. 168.1Mattel, Inc. v. Goldberger Doll Mfg. Co., 365 F.3d 133, 136 n.3 (2d Cir. 2004) (Treatise cited). [↑](#footnote-ref-546)
546. 168.2*Id.* Judge Rakoff denied Mattel’s later effort to vacate that judgment following a post-verdict settlement. See Mattel, Inc. v. Goldberger Doll Mfg. Co., 236 F.R.D. 175, 176–77 (S.D.N.Y. 2006). For that proposition, he quoted from U.S. Bancorp Mortg. Co. v. Bonner Mall Pshp., 513 U.S. 18, 26, 115 S. Ct. 386, 130 L. Ed. 2d 233 (1994):

     Judicial precedents are presumptively correct and valuable to the community as a whole. They are not merely the property of private litigants and should stand unless a court concludes that the public interest would be served by a vacatur. [↑](#footnote-ref-547)
547. 168.3In addition to the differences to be catalogued immediately, another difference concerns whether merger belongs to the first element of plaintiff’s infringement claim (ownership of a valid copyright) or to the second (unlawful copying by defendant). See § 13.03[B][3][e] *infra*. [↑](#footnote-ref-548)
548. 168.4See § 13.03[B][4] *infra*. [↑](#footnote-ref-549)
549. 168.5This is not to deny that some cases still trace back the roots of prior precedent, in that context citing to *Baker v. Selden*. The point is that modern cases feel free to discuss the merger doctrine at great length without once citing back to that 1879 ruling. Illustrative are the majority and multiple dissents in Veeck v. Southern Bldg. Code Cong. Int’l Inc., 293 F.3d 791, 801 (5th Cir. 2002) (*en banc*), *cert denied*, 539 U.S. 969, 123 S. Ct. 2636, 156 L. Ed. 2d 674 (2003). [↑](#footnote-ref-550)
550. 168.6The case concluded with colorful language: “We cannot recognize copyright as a game of chess in which the public can be checkmated.” 379 F.2d at 679. Other cases have continued to follow *Morrissey* as to game rules. Allen v. Academic Games League of Am., Inc., 89 F.3d 614, 617-618 (9th Cir. 1996). See Apple Computer, Inc. v. Microsoft Corp., 799 F. Supp. 1006, 1034 (N.D. Cal. 1992) (“one author cannot appropriate for himself the exclusive right to one of [nine possible forms of expression] without the most pernicious consequences on the opportunity for creative expression”), *aff’d* (*rev’d as to fees*), 35 F.3d 1435 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995). But other cases deny application of the merger principle to games. See Tetris Holding, LLC v. Xio Interactive, Inc., 863 F. Supp. 2d 394 (D.N.J. 2012) (video game “Tetris”), discussed in N. 168.9 *infra*. On protection in general for games, see § 2A.14[C] *supra*. [↑](#footnote-ref-551)
551. 168.7See § 13.03[B][3][b] N. 163.4 *supra*. [↑](#footnote-ref-552)
552. 168.8The First Circuit has noted this treatise’s questioning of *Morrissey*. See CMM Cable Rep, Inc. v. Ocean Coast Properties, Inc., 97 F.3d 1504, 1522 (1st Cir. 1996) (Treatise cited). Separately, it has declined to invoke merger vis-a-vis animal statuary. See Concrete Mach. Co. v. Classic Lawn Ornaments, Inc., 843 F.2d 600, 607 (1st Cir. 1988). [↑](#footnote-ref-553)
553. 168.9One case encapsulates this principle when rejecting defendant’s contention that

     “where a feature of a videogame is dictated by functional considerations, regardless of whether there may be a number of different ways to implement that feature’s functionality, copyright does not protect that feature.” This is incorrect as a matter of law and fails as a matter of logic. If an expressive feature is dictated by functional considerations then there cannot be a number of ways to implement it. Rather, one’s original expression is protected by copyright—even if that expression concerns an idea, rule, function, or something similar—unless it is so inseparable from the underlying idea that there are no or very few other ways of expressing it. “If other methods of expressing that idea are not foreclosed as a practical matter, then there is no merger.”

     Tetris Holding, LLC v. Xio Interactive, Inc., 863 F. Supp. 2d 394, 408 (D.N.J. 2012) (citations omitted). [↑](#footnote-ref-554)
554. 168.10BUC Int’l Corp. v. International Yacht Council Ltd., 489 F.3d 1129, 1143 (11th Cir. 2007). [↑](#footnote-ref-555)
555. 168.11*Id.* at 1144. See § 3.04 *supra*. [↑](#footnote-ref-556)
556. 168.12Predator Int’l, Inc. v. Gamo Outdoor USA, Inc., 863 F. Supp. 2d 1055, 1063–1064 (D. Colo. 2012) (Treatise cited). [↑](#footnote-ref-557)
557. 168.13Later, we will refine the point from being “protected by copyright” instead to “freely subject to copying.” See § 13.03[B][3][e] *infra*. [↑](#footnote-ref-558)
558. 168.14The First Circuit in *Morrissey* neglected to inquire whether there were actually very few expressions capable of embodying the contest rules. It simply observed that “there was more than one way of expressing even this simple substance.” See § 13.03[B][3][b] N. 163.4 *supra*. [↑](#footnote-ref-559)
559. 168.15See Enterprise Mgmt. Ltd. v. Warrick, 717 F.3d 1112, 1115 (10th Cir. 2013). The presence of all leads to “success”; the absence of *vision* leads to “confusion”; the absence of *capabilities* leads to “anxiety”; and so on down the line, until the absence of an *action plan* leads to “false starts.” *Id.* [↑](#footnote-ref-560)
560. 168.16*Id.* at 1116. Although he substituted “skills” for “capabilities” and “gradual change” for “resistance,” the charts were essentially the same. [↑](#footnote-ref-561)
561. 168.17

     He might have organized the components in a pie-chart-style format to show how each is a component of a larger whole. He could have approached the concept in a two-column format, listing each defect in the left column and the missing component in the right column. He could have simply described the concepts in prose, as he did in his motion for summary judgment. He could have used his own words to describe the components. He might have broken down or combined the components in a different way. He could have expressed the absence of one of the components with an “X” over the component, as did another writer’s sample diagram … .

     *Id.* at 1118. [↑](#footnote-ref-562)
562. 168.17aSee Innovation Ventures, LLC v. Ultimate One Distrib. Corp., 176 F. Supp. 3d 137, 156–57 (E.D.N.Y. 2016). [↑](#footnote-ref-563)
563. 168.18See Erickson v. Blake, 839 F. Supp. 2d 1132, 1134 (D. Or. 2012). [↑](#footnote-ref-564)
564. 168.19*Id.* at 1140. [↑](#footnote-ref-565)
565. 168.20*Id.* at 1141 (Treatise cited as to § 13.03[B][2] *supra*). [↑](#footnote-ref-566)
566. 168.21Portionpac Chem. Corp. v. Sanitech Sys., Inc., 217 F. Supp. 2d 1238, 1247 (M.D. Fla. 2002) (“The Court is at a loss in trying to invent any other instructions, words, or phrases to instruct an observer in washing a pot” other than plaintiff’s *scrape/wash/rinse/sanitize*). [↑](#footnote-ref-567)
567. 168.22Small v. Exhibit Enters., Inc., 364 F. Supp. 2d 648, 653 (E.D. Mich. 2005). [↑](#footnote-ref-568)
568. 168.23Yankee Candle Co., Inc. v. Bridgewater Candle Co., Inc., 99 F. Supp. 2d 140, 145 (D. Mass. 2000), *aff’d*, 259 F.3d 25, 35–36 (1st Cir. 2001). [↑](#footnote-ref-569)
569. 168.24See § 13.03[F][2][b] *infra*. [↑](#footnote-ref-570)
570. 168.25See § 13.03[B][3][b] *supra*. [↑](#footnote-ref-571)
571. 168.26Even in the context of copyright protection for a jewelry pin, one later case distinguished *Kalpakian*. See Maggio v. Liztech Jewelry, 912 F. Supp. 216, 223 & n.5 (E.D. La. 1996). [↑](#footnote-ref-572)
572. 168.27See Yurman Design, Inc. v. PAJ, Inc., 93 F. Supp. 2d 449, 456 (S.D.N.Y. 2000) (Treatise cited)*, aff’d in part, rev’d in part on other grounds*, 262 F.3d 101 (2d Cir. 2001). [↑](#footnote-ref-573)
573. 168.28Nola Spice Designs, LLC v. Haydel Enters. Inc., 969 F. Supp. 2d 688, 691, 702 (E.D. La. 2013). [↑](#footnote-ref-574)
574. 168.29On occasion, other rulings also conclude that the entirety of plaintiff’s work may be copied. See Ellison Educ. Equip., Inc. v. Tekservices, Inc., 903 F. Supp. 1350, 1360 (D. Neb. 1995) (candy cane stamped out of bond and construction paper). [↑](#footnote-ref-575)
575. 168.30783 F.3d 527, 549 (5th Cir. 2015). [↑](#footnote-ref-576)
576. 168.31*Id.* at 551. See § 13.03[A] *supra*. [↑](#footnote-ref-577)
577. 168.32***Kern*** River Gas Transmission Co. v. Coastal Corp., 899 F.2d 1458 (5th Cir.), *cert. denied*, 498 U.S. 952, 111 S. Ct. 374, 112 L. Ed. 2d 336 (1990). A case raising similar issues is Project Dev. Group, Inc. v. O.H. Materials Corp., 766 F. Supp. 1348 (W.D. Pa. 1991). See Sumner Mfg. Co. v. Midco Mfg. Co., 29 U.S.P.Q.2d 1230, 1232 (S.D. Tex. 1993). [↑](#footnote-ref-578)
578. 169For more about this case in the context of the copyrightability of maps, see § 2.08[A][3][b] *supra*. [↑](#footnote-ref-579)
579. 169.1899 F.2d at 1462. Plaintiff did not place a notice on its map, and did not register it for protection except as a prerequisite for filing suit. *Id.* at 1461. [↑](#footnote-ref-580)
580. 169.2*Id.* at 1460. Note that lines and markings by themselves do not evince sufficient originality for copyright protection; the case would have been different had plaintiff developed an original map from scratch, and defendant copied wholesale such original elements contributed by plaintiff as shading, scale, choice of features present, etc. See § 2.08[A] *supra*. [↑](#footnote-ref-581)
581. 169.3899 F.2d at 1463–1464. [↑](#footnote-ref-582)
582. 169.4See § 13.03[B][3][b] *supra.* [↑](#footnote-ref-583)
583. 169.5899 F.2d at 1464. [↑](#footnote-ref-584)
584. 169.6899 F.2d at 1464-1465. See *id.* at 1464 (“foreclosure of competition that Congress could not have intended to sanction through copyright law”). [↑](#footnote-ref-585)
585. 169.7Mason v. Montgomery Data, Inc., 967 F.2d 135, 139-140 (5th Cir. 1992), reversing lower court decision to the contrary, 765 F. Supp. 353 (S.D. Tex. 1991). *Accord*, Guillot-Vogt Assocs., Inc. v. Holly & Smith, 848 F. Supp. 682, 689 (E.D. La. 1994); CSM Investors, Inc. v. Everest Dev., Ltd., 840 F. Supp. 1304, 1310 (D. Minn. 1994). [↑](#footnote-ref-586)
586. 169.8Oracle Am., Inc. v. Google Inc., 750 F.3d 1339, 1361 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 2887 (2015). See the discussion of this case in §§ 2A.06[A][3][b], 2A.10[B][4] *supra*, § 13.05[I] *infra*. [↑](#footnote-ref-587)
587. 169.9See McIntosh v. Northern Cal. Universal Enters. Co., 670 F. Supp. 2d 1069, 1096 (E.D. Cal. 2009). This case fails to cite ***Kern*** *River*. [↑](#footnote-ref-588)
588. 169.10In some sense, the decision where to locate 67 parcels amidst rolling hills in an irregular parcel might have been highly creative. But that form of creativity is an aspect of land use, not of copyrightable expression. For that reason, it should not be recognized as protected expression under Title 17 of the United States Code. [↑](#footnote-ref-589)
589. 169.11John G. Danielson, Inc. v. Winchester-Conant Props., Inc., 322 F.3d 26, 43 (1st Cir. 2003). [↑](#footnote-ref-590)
590. 169.12*Id.* at 43. [↑](#footnote-ref-591)
591. 169.13The reference to defendant’s “pursuit of several alternative designs” indicates that, at one point, it contemplated a different method of land development. But the question is whether copyright law mandates those alternatives, forbidding a rival from adopting the methodology of land development that plaintiff has previously advocated. [↑](#footnote-ref-592)
592. 169.14In other words, plaintiff’s plans convey rights in only in the expressive features of those plans, not in the divisions in the physical world that they represent. The test is not whether those plans represent “the only physically possible means” of developing the property. Even if plaintiff chose one out of a hundred expedients that are all physically possible means of developing the property, plaintiff has no right to monopolize that technique. Others should be equally free to adopt the same expedient—meaning that they should also be permitted to draft plans showing the same projected development, even to the extent that the plans in question are the only means to portray the contemplated construction (as in ***Kern*** *River*). [↑](#footnote-ref-593)
593. 169.15Geophysical Serv., Inc. v. TGS-NOPEC Geophysical Co., 850 F.3d 785, 789 (5th Cir. 2017). [↑](#footnote-ref-594)
594. 169.16*Id.* at 789. [↑](#footnote-ref-595)
595. 169.17See § 8.13[B][3][c][v][I] *supra*. [↑](#footnote-ref-596)
596. 169.18To belabor the matter, the unaddressed issue is whether professional interpretation of information actually results in a copyright-protected geological “picture.” [↑](#footnote-ref-597)
597. 169.19Perhaps the fly in the ointment from defendant’s perspective was that the Canadian government made a copy of plaintiff’s entire map—esthetic features and information together—which plaintiff later imported into the United States. See § 8.13[B][3][c][v][I] *supra*. Even under that supposition, however, the only purpose for which plaintiff wished to consult the imported map was for its informational quality, not its esthetic features—thereby raising at lease a fair use defense. See § 13.05[B][6] *infra*. [↑](#footnote-ref-598)
598. 169.20See § 13.03[B][3][c] *supra*. [↑](#footnote-ref-599)
599. 169.21Highland Tank & Mfg. Co. v. PS Int’l, Inc., 393 F. Supp. 2d 348, 361 (W.D. Pa. 2005). [↑](#footnote-ref-600)
600. 169.22See §§ 2A.05, 2A.06, 2A.08 *supra*. [↑](#footnote-ref-601)
601. 169.23Conversely, the more differences there are between plaintiff’s and defendant’s works, the less likely is infringement to be found. Thus, one case validates defendant’s usage of “Remove as much water as possible by squeezing” as non-infringing of plaintiff’s “Squeeze by hand to remove as much water as possible.” National Nonwovens, Inc. v. Consumer Prods. Enters., Inc., 397 F. Supp. 2d 245, 257 (D. Mass. 2005). [↑](#footnote-ref-602)
602. 169.24“Thus, where a plaintiff closely models its work after a design in the public domain, the showing of imitation must be stronger than usual and even small variations may protect a subsequent designer from infringement.” Gibson Tex, Inc. v. Sears Roebuck & Co., 11 F. Supp. 2d 439, 444 (S.D.N.Y. 1998). [↑](#footnote-ref-603)
603. 169.25C.B. Fleet Co., Inc. v. Unico Holdings, Inc., 510 F. Supp. 2d 1078, 1082 (S.D. Fla. 2007). [↑](#footnote-ref-604)
604. 169.26See § 13.03[B][3][c] *supra*. [↑](#footnote-ref-605)
605. 170See § 13.03[B][2][b] *supra*. It is unclear what the court meant, as the case which it cited for the proposition does not support it. 510 F. Supp. 2d at 1082, citing Epic Metals Corp. v. Condec, Inc., 867 F. Supp. 1009, 1013-1014 (M.D. Fla. 1994) (making a copy of plaintiff’s photograph constitutes infringement). In *Fleet*, the products at issue were instructions for competing bowel cleansing kits. 510 F. Supp. 2d at 1080. Even if plaintiff engaged in independent testing to produce the optimal instructions, then to the extent that there was no effective way to convey those instructions without replicating them, the merger doctrine should apply robustly. [↑](#footnote-ref-606)
606. 171Consumers Union of U.S., Inc. v. General Signal Corp., 724 F.2d 1044, 1049–1050 (2d Cir. 1983), *cert. denied*, 469 U.S. 823, 105 S. Ct. 100, 83 L. Ed. 2d 45 (1984) (but see later opinion, 664 F. Supp. 753 (S.D.N.Y. 1987)). [↑](#footnote-ref-607)
607. 172In Harper & Row, Publishers, Inc. v. Nation Enters., 557 F. Supp. 1067, 1073 (S.D.N.Y. 1983), the district court held that President Ford’s “revelations as to his state of mind while involved in governmental affairs” were themselves entitled to copyright. The court of appeals reversed and, without squarely deciding the issue, opined that “it seems to defy common sense to declare that the ‘states of mind’ which play a role in the crucial political decisions of public officials are any less ‘fact’ than any act which such an official may choose or not choose to undertake.” 723 F.2d 195, 205 (2d Cir. 1983), *aff’d mem.*, 779 F.2d 35 (2d Cir. 1985). In this, the court of appeals would appear to be correct. When the Supreme Court in turn reversed the Second Circuit, it added that “[s]ome of the briefer quotes from the memoirs are arguably necessary to convey the facts.” 471 U.S. 539, 563, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985). See the further discussion of this issue at § 2.11[A] *supra*. [↑](#footnote-ref-608)
608. 172.1As set forth in the previous footnote, the Supreme Court limited its approval to “the briefer quotes.” Further, given the Court’s reference to these remarks as “facts,” this case bridges the merger and fact categories. See § 13.03[B][2][b] *supra*. [↑](#footnote-ref-609)
609. 172.2See Love v. Kwitny, 706 F. Supp. 1123 (S.D.N.Y. 1989) (rejecting defendant’s contention that he needed to quote plaintiff’s unpublished manuscript verbatim to give its flavor and to insulate himself against libel suit). [↑](#footnote-ref-610)
610. 173See Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101, 111 (2d Cir. 2001) (“if there is just one way to express an idea, the idea and expression are said to merge”). [↑](#footnote-ref-611)
611. 173.1On the other hand, we have already observed that the open-ended number of alternatives invoked in *Morrissey* is to too broad, absent appropriate cabining, to warrant application of the merger doctrine. See § 13.03[B][3][c] *supra*. [↑](#footnote-ref-612)
612. 173.2New York Mercantile Exch., Inc. v. IntercontinentalExchange, Inc., 497 F.3d 109, 117 n.9 (2d Cir. 2007), *cert. denied*, 552 U.S. 1259, 128 S. Ct. 1669, 170 L. Ed. 2d 357 (2008). [↑](#footnote-ref-613)
613. 173.3“We need not determine how many expressions would be too many for application of the merger doctrine. *Id.* at 117 n.9. [↑](#footnote-ref-614)
614. 173.4See § 5.12[A] *supra*. [↑](#footnote-ref-615)
615. 173.5Veeck v. Southern Bldg. Code Cong. Int’l Inc., 293 F.3d 791, 801 (5th Cir. 2002) (*en banc*), *cert denied*, 539 U.S. 969, 123 S. Ct. 2636, 156 L. Ed. 2d 674 (2003). [↑](#footnote-ref-616)
616. 173.6*Id.* at 801. [↑](#footnote-ref-617)
617. 173.7*Id.*, citing dissent from earlier panel opinion. [↑](#footnote-ref-618)
618. 173.8*Id.*, at 820 n.57 (Wiener, J., dissenting) (Treatise cited). [↑](#footnote-ref-619)
619. 173.9See § 5.12[A] *supra*. [↑](#footnote-ref-620)
620. 173.10See § 13.03[A][1] *supra*. [↑](#footnote-ref-621)
621. 173.11See § 13.03[A][1][a] *supra*. [↑](#footnote-ref-622)
622. 173.12Skinder-Strauss Assocs. v. Massachusetts Continuing Legal Educ., Inc., 914 F. Supp. 665, 673 (D. Mass. 1995) (Treatise quoted). See Kregos v. Associated Press, 937 F.2d 700, 707 (2d Cir. 1991). [↑](#footnote-ref-623)
623. 173.13937 F.2d 700 (2d Cir. 1991). The case held a baseball pitching form subject to copyright protection. The discussion below reverts to its merger holding. See § 13.03[B][3][e] *infra*. For more on *Kregos*, see § 2.04[B] N. 15 *supra*. [↑](#footnote-ref-624)
624. 173.14937 F.2d at 707. “As long as selections of facts involve matters of taste and personal opinion, there is no serious risk that withholding the merger doctrine will extend protection to an idea.” *Id.* See Coates-Freeman Assoc., Inc. v. Polaroid Corp., 792 F. Supp. 879, 884-85 (D. Mass. 1992). [↑](#footnote-ref-625)
625. 173.15See CCC Info Servs., Inc. v. Maclean Hunter Market Reports, Inc., 44 F.3d 61, 73 (2d Cir. 1994). [↑](#footnote-ref-626)
626. 173.16See New York Mercantile Exch., Inc. v. IntercontinentalExchange, Inc., 497 F.3d 109, 115 n.5 (2d Cir. 2007), *cert. denied*, 552 U.S. 1259, 128 S. Ct. 1669, 170 L. Ed. 2d 357 (2008) (although that footnote was joined by only two judges, all three panel members agreed on the court’s merger holding). [↑](#footnote-ref-627)
627. 173.17For more on the background of this case, see § 3.04[B][2][c] *supra*. [↑](#footnote-ref-628)
628. 173.18497 F.3d at 118. [↑](#footnote-ref-629)
629. 173.19“In order to establish a functioning commodities market [plaintiff] must have a price at which to settle open positions. Furthermore, NYMEX is required by law to record settlement prices, and it does not challenge the legality of that rule.” *Id.* at 118. On the last point about being required by law to compile the subject work, see § 2.17[B] *supra*. [↑](#footnote-ref-630)
630. 173.20See § 13.03[B][3][c] *supra*. [↑](#footnote-ref-631)
631. 173.21See § 13.03[B][3][b] *supra*. [↑](#footnote-ref-632)
632. 173.22The First Circuit case is explicit that its holding rejects the result “that the subject matter would be appropriated by permitting the copyrighting of its expression.” Morrissey v. Procter & Gamble Co., 379 F.2d 675, 679 (1st Cir. 1967). It concomitantly rejected the construction allowing defendant to “invoke the principle of a stringent standard for showing infringement which some courts apply when the subject matter involved admits of little variation in form of expression.” *Id.* That rejected construction corresponds to the second element of plaintiff’s *prima facie* case of copyright infringement, as discussed below. [↑](#footnote-ref-633)
633. 173.23See § 13.01[A] *infra*. Plaintiff must show that it owns the work in question, which falls into copyright subject matter. *Id*. [↑](#footnote-ref-634)
634. 173.24The Ninth Circuit case is to the same effect, albeit more obliquely. It concluded that “the production of jeweled bee pins is a larger private preserve than Congress intended to be set aside in the public market without a patent.” Herbert Rosenthal Jewelry Corp, v. Kalpakian, 446 F.2d 738, 742 (9th Cir. 1971). In reaching that conclusion, the court cites, *inter alia*, to two salient authorities. *Id.* at 742. One is *Morrissey*, the other is Crume v. Pacific Mut. Life Ins. Co., 140 F.2d 182, 184 (7th Cir. 1944). [↑](#footnote-ref-635)
635. 173.25The avatar of that viewpoint is the *Crume* case just cited. See § 2A.06[B][1][b] *supra*. [↑](#footnote-ref-636)
636. 173.26See § 13.01[B] *infra*. Plaintiff must show that defendant copied the work both as a matter of fact and as a matter of law. The former has been labeled *probative similarity*, the latter *substantial similarity*. *Id.* We thus reach the overarching theme of the instant section—which explains why the merger doctrine is treated here. [↑](#footnote-ref-637)
637. 173.27See Uneeda Doll Co. v. P & M Doll Co., 241 F. Supp. 675 (S.D.N.Y. 1965), *aff’d*, 353 F.2d 788 (2d Cir. 1965) (red and white striped pole fixed vertically in display box held nonprotectable *per se*). [↑](#footnote-ref-638)
638. 173.28See Mason v. Montgomery Data, Inc., 967 F.2d 135, 138 n.5 (5th Cir. 1992) (noting argument over how to apply merger, but not resolving it, as doctrine held inapplicable in this case). [↑](#footnote-ref-639)
639. 173.29See Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607, 616 (7th Cir. 1982), *cert. denied*, 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 145 (1982). [↑](#footnote-ref-640)
640. 173.30See § 2A.05[A][2][b] *supra*. [↑](#footnote-ref-641)
641. 173.31See § 2A.06[B][1][a] *supra*. [↑](#footnote-ref-642)
642. 173.32Ets-Hokin v. Skyy Spirits, Inc., 225 F.3d 1068, 1081 (9th Cir. 2000) (Treatise cited); Kregos v. Associated Press, 937 F.2d 700, 705 (2d Cir. 1991) (Treatise quoted); CCC Info Servs., Inc. v. Maclean Hunter Market Reports, Inc., 44 F.3d 61, 72 nn. 25-26 (2d Cir. 1994) (Treatise quoted); Thimbleberries, Inc. v. C & F Enters., Inc., 142 F. Supp. 2d 1132, 1137-38 (D. Minn. 2001) (Treatise cited); Taylor Corp. v. Four Seasons Greetings LLC, 171 F. Supp. 2d 970, 973 (D. Minn. 2001) (Treatise cited), *aff’d*, 315 F.3d 1039, 1042 (8th Cir. 2003) (Treatise cited); Lexmark Int’l, Inc. v. Static Control Components, Inc., 387 F.3d 522, 557 & n.6 (6th Cir. 2004) (Feikens, J., concurring in part and dissenting in part) (Treatise cited), discussed in § 13.03[F][3][e][iii] *infra*. [↑](#footnote-ref-643)
643. 173.33Nonetheless, a one-size-fits-all approach is not being advocated. As noted above, the choice need not always be binary; wisdom can emerge by treating merger as a “potentially cumulative examination, when a work that survives the copyrightability analysis despite its useful purpose (because the risk of creating a monopoly is reduced) might nonetheless be accorded potentially less protection during the scrutiny of infringement.” See § 2A.06[B][1][a] *supra.* [↑](#footnote-ref-644)
644. 173.34NEC Corp. v. Intel Corp., 10 U.S.P.Q.2d 1177 (N.D. Cal. 1989) (Treatise cited). See Apple Computer, Inc. v. Microsoft Corp., 759 F. Supp. 1444, 1456 (N.D. Cal. 1991) (Treatise cited), *amended*, 779 F. Supp. 133 (N.D. Cal. 1991), *aff’d (rev’d as to fees)*, 35 F.3d 1435, 1444 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995). [↑](#footnote-ref-645)
645. 173.35937 F.2d 700, 702 (2d Cir. 1991). [↑](#footnote-ref-646)
646. 173.36*Id.* at 705 (Treatise quoted). [↑](#footnote-ref-647)
647. 173.37*Id.* at 705. [↑](#footnote-ref-648)
648. 173.38*Id.* at 715 (Sweet, J., dissenting in part) (Treatise cited). [↑](#footnote-ref-649)
649. 173.39See § 13.01[B] *supra*. [↑](#footnote-ref-650)
650. 173.40See § 13.03[A] N. 3.2 *supra*. [↑](#footnote-ref-651)
651. 173.41See § 13.03[B][2][b] *supra*. [↑](#footnote-ref-652)
652. 173.42See 937 F.2d at 716. [↑](#footnote-ref-653)
653. 173.43Other cases are also in accord. See Hart v. Dan Chase Taxidermy Supply Co., 86 F.3d 320, 322-23 (2d Cir. 1996) (vacating merger judgment reached before consideration of substantial similarity), *on remand*, 967 F. Supp. 70, 73 (N.D.N.Y. 1997) (reaching same merger conclusion, inasmuch as “affording copyright protection to the Plaintiffs’ fish forms would necessarily afford protection to the idea of replicating a realistic looking fish itself”). [↑](#footnote-ref-654)
654. 173.44See *Kregos*, 937 F.2d at 705 (majority).

     As a final note, I have no quarrel with the majority’s statement that “assessing merger in the context of alleged infringement will normally provide a more detailed and realistic basis for evaluating” a claim of merger: the analysis is greatly simplified by the example of the defendant’s work and by the defendant’s argument as to how the plaintiff’s idea has merged with its expression.

     *Id.* at 716 (dissent). [↑](#footnote-ref-655)
655. 173.45See § 13.03[B][4] *infra*. [↑](#footnote-ref-656)
656. 173.46See Ets-Hokin v. Skyy Spirits, Inc., 225 F.3d 1068, 1082 (9th Cir. 2000) (Treatise cited). [↑](#footnote-ref-657)
657. 173.47See the cases approving this treatise’s formulation of “the better view” cited in N. 173.32 *supra*. [↑](#footnote-ref-658)
658. 174Schwarz v. Universal Pictures Co., 85 F. Supp. 270 (S.D. Cal. 1949). [↑](#footnote-ref-659)
659. 175See § 13.03[B][2][a] *supra*. [↑](#footnote-ref-660)
660. 175.1Walker v. Time Life Films, Inc., 784 F.2d 44, 50 (2d Cir. 1986), *cert. denied*, 476 U.S. 1159, 106 S. Ct. 2278, 90 L. Ed. 2d 721 (1986). See Olson v. National Broadcasting Co., 855 F.2d 1446, 1450 n.3, 1451 (9th Cir. 1988) (television shows may be similar “in terms of theme, mood, and pace,” but “these similarities are common to the genre of action-adventure television series and movies and therefore do not demonstrate substantial similarity”); Montwillo v. Tull, 632 F. Supp. 2d 917, 923 (N.D. Cal. 2008) (Treatise quoted). [↑](#footnote-ref-661)
661. 175.2Kindergartners Count, Inc. v. Demoulin, 249 F. Supp. 2d 1214, 1226 & n.61 (D. Kan. 2003) (Treatise quoted); Sinicola v. Warner Bros., Inc., 948 F. Supp. 1176, 1185, 1187 (E.D.N.Y. 1996) (Treatise cited); Evans v. Wallace Berrie & Co., 681 F. Supp. 813, 817 (S.D. Fla. 1988) (Treatise cited). [↑](#footnote-ref-662)
662. 175.3“Getting drunk, spending a ‘one-nighter’ with someone you just met, waking up disoriented the next morning at the individual’s house or apartment, and putting on the clothes worn the night before are also plot devices that are necessary to a walk of shame.” Shame on You Prods., Inc. v. Banks, 120 F. Supp. 3d 1123, 1151 (C.D. Cal. 2015), *aff’d unpub*., 690 Fed. Appx. 519 (9th Cir.), *cert. denied*, 138 S. Ct. 323 (2017). This case also ruled that “a loud-mouthed best friend in a comedy film is a stock character” that cannot sustain a finding of infringement. *Id.* at 1167–68. [↑](#footnote-ref-663)
663. 176Black v. Gosdin, 740 F. Supp. 1288, 1293 (M.D. Tenn. 1990). [↑](#footnote-ref-664)
664. 176.1Printing atrocities often attend efforts to insert the grave accents. See, *e.g*., Satava v. Lowry, 323 F.3d 805, 810 n.3 (9th Cir.), *cert. denied*, 540 U.S. 983, 124 S. Ct. 472, 157 L. Ed. 2d 374 (2003). It is therefore suggested that Anglophones omit those diacritical marks in common usage. [↑](#footnote-ref-665)
665. 177Schwarz v. Universal Pictures Co., 85 F. Supp. 270 (S.D. Cal. 1949). The dictionary definition (“the most important scene in a play or opera, made inevitable by the action which leads up to it”) is “not the legal doctrine at all.” Bucklew v. Hawkins, Ash, Baptie & Co., 329 F.3d 923, 929, 930 (7th Cir. 2003) (holding captions “input range” and “criteria range” qualify as scenes a faire). [↑](#footnote-ref-666)
666. 177.1Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607, 616 (7th Cir. 1982), *cert. denied*, 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 145 (1982). See Frybarger v. International Business Machs. Corp., 812 F.2d 525, 530 (9th Cir. 1987) (“indispensable” expression of idea protected solely against virtually identical copying); Ring v. Estee Lauder, Inc., 874 F.2d 109, 110 (2d Cir. 1989) (citing *Frybarger*). [↑](#footnote-ref-667)
667. 177.2Scott-Blanton v. Universal City Studios Prods. LLLP, 539 F. Supp. 2d 191, 201 (D.D.C. 2008), *aff’d*, 308 Fed. Appx. 452 (D.C. Cir. 2009). Another opinion discounted stock elements of the thriller genre, thereby rejecting an infringement claim when both works involved: a corporate meeting held at the Grand Hyatt; a female journalist protagonist; the development of a miracle drug; an inventor of a drug who disappears; an affair between the inventor’s wife and another corporate executive; competing pharmaceutical companies; a murder; a hit-and-run accident; and the names “DeCarlo,” “Lynn,” and “Greene.” Gal v. Viacom Int’l, Inc., 518 F. Supp. 2d 526, 546–547 (S.D.N.Y. 2007). [↑](#footnote-ref-668)
668. 177.3Davis v. Walt Disney Co., 393 F. Supp. 2d 839, 847 (D. Minn. 2005), *aff’d on other grounds*, 430 F.3d 901 (8th Cir. 2005), *cert. denied*, 547 U.S. 1159, 126 S. Ct. 2203, 164 L. Ed. 2d 834 (2006). [↑](#footnote-ref-669)
669. 177.4The following statement accompanied plaintiff’s “5 Hour Energy”:

     Contains about as much caffeine as a cup of coffee. Limit caffeine products to avoid nervousness, sleeplessness, and occasionally rapid heartbeat. You may experience a Niacin Flush (hot feeling, skin redness) that lasts a few minutes. This is caused by Niacin (Vitamin B3) increasing blood flow near the skin.

     Innovation Ventures, LLC v. N2G Distrib, Inc., 635 F. Supp. 2d 632, 638 n.2 (E.D. Mich. 2008). The court later reaffirmed its ruling that there was no excuse for defendants’ cautionary statement to be exactly the same as plaintiff’s. 779 F. Supp. 2d 671, 679 (E.D. Mich. 2011). [↑](#footnote-ref-670)
670. 177.5*Id*. at 639–640. [↑](#footnote-ref-671)
671. 178Lexmark Int’l, Inc. v. Static Control Components, Inc., 387 F.3d 522, 535 (6th Cir. 2004) (Treatise cited); Sony Pictures Entm’t, Inc. v. Fireworks Entm’t Group, Inc., 156 F. Supp. 2d 1148, 1158 n.10 (C.D. Cal. 2001) (Treatise quoted); Smart Inventions, Inc. v. Allied Communications Corp., 94 F. Supp. 2d 1060, 1067 (C.D. Cal. 2000) (Treatise quoted). See, *e.g.,* See v. Durang, 711 F.2d 141 (9th Cir. 1983) (scenes a faire defined as “stock scenes or scenes that flowed necessarily from common unprotectible ideas”); Landsberg v. Scrabble Crossword Game Players, Inc., 736 F.2d 485 (9th Cir. 1984) (same), *cert. denied*, 469 U.S. 1037, 105 S. Ct. 513, 83 L. Ed. 2d 403 (1984); Berkic v. Crichton, 761 F.2d 1289 (9th Cir.) (Treatise cited) (same), *cert. denied*, 474 U.S. 826, 106 S. Ct. 85, 88 L. Ed. 2d 69 (1985); Arden v. Columbia Pictures Indus., Inc., 908 F. Supp. 1248, 1259 (S.D.N.Y. 1995) (Treatise cited); Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co., 900 F. Supp. 1287, 1294 n.5 (C.D. Cal. 1995) (Treatise cited); Beal v. Paramount Pictures, 806 F. Supp. 963, 966–967 (N.D. Ga. 1992) (Treatise cited), *aff’d,* 20 F.3d 454, 460 (11th Cir. 1994), *cert. denied,* 513 U.S. 1062, 115 S. Ct. 675, 130 L. Ed. 2d 607 (1994); Denker v. Uhry, 820 F. Supp. 722, 733 (S.D.N.Y. 1992) (Treatise cited), *aff’d mem.,* 996 F.2d 301 (2d Cir. 1993); Zambito v. Paramount Pictures Corp., 613 F. Supp. 1107 (E.D.N.Y. 1985), *aff’d*, 788 F.2d 2 (1985); Williams v. Crichton, 860 F. Supp. 158, 167 (S.D.N.Y. 1994) (Treatise cited), *aff’d*, 84 F.3d 581, 588–589 (2d Cir. 1996); Sharpshooters, Inc. v. Retirement Living Publ. Co., 932 F. Supp. 286, 289 (S.D. Fla. 1996) (photograph); American Direct Marketing, Inc. v. Azad Int’l, Inc., 783 F. Supp. 84, 95 (E.D.N.Y. 1992) (television commercials); Anderson v. Paramount Pictures Corp., 617 F. Supp. 1 (C.D. Cal. 1985); Reyher v. Children’s Television Workshop, 533 F.2d 87 (2d Cir. 1976), *cert. denied*, 429 U.S. 980 (1976); Gibson v. Columbia Broad. Sys., Inc., 491 F. Supp. 583 (S.D.N.Y. 1980); Alexander v. Haley, 460 F. Supp. 40 (S.D.N.Y. 1978); Davis v. United Artists, Inc., 547 F. Supp. 722 (S.D.N.Y. 1982). Cf. Davis v. E. I. du Pont de Nemours & Co., 240 F. Supp. 612 (S.D.N.Y. 1965). See Scott v. WKJG, Inc., 149 U.S.P.Q. 413 (N.D. Ind. 1966), *aff’d*, 376 F.2d 467 (7th Cir. 1967); Ornstein v. Paramount Prods., Inc., 9 F. Supp. 896 (S.D.N.Y. 1935). [↑](#footnote-ref-672)
672. 178.1Stephen King avoided liability for the half-vampire he depicted, as the events it experienced were scenes a faire flowing from the idea of “a character using her psychic abilities to triumph over evil.” Acker v. King, 46 F. Supp. 3d 168, 175 (D. Conn. 2014). Disney similarly avoided liability for *Pirates of the Caribbean* based on stock elements of undead, skeletons, sea monsters and the like. See Alfred v. Walt Disney Co., 388 F. Supp. 3d 1174, 1183 (C.D. Cal. 2019). [↑](#footnote-ref-673)
673. 178.2Feldman v. Twentieth Century Fox Film Corp., 723 F. Supp. 2d 357, 366–367 (D. Mass. 2010) (Treatise quoted); Dunn v. Brown, 517 F. Supp. 2d 541, 545 (D. Mass. 2007) (Treatise quoted). In Hogan v. DC Comics, 983 F. Supp. 82 (N.D.N.Y. 1997) (Treatise cited), the court refused to dismiss a case involving competing vampire comics, in both of which the protagonist was named “Nicholas Gaunt.” Later, after meticulously reviewing both works, the court concluded that substantial similarity was lacking—notwithstanding the identity in names. 48 F. Supp. 2d 298 (S.D.N.Y. 1999) (Treatise cited). See DuBay v. King, 366 F. Supp. 3d 1330, 1347 (M.D. Fla. 2019). [↑](#footnote-ref-674)
674. 178.3See Psihoyos v. National Geographic Soc’y, 409 F. Supp. 2d 268, 275–276 (S.D.N.Y. 2005). [↑](#footnote-ref-675)
675. 178.4Ets-Hokin v. Skyy Spirits, Inc., 225 F.3d 1068, 1081 n.17 (9th Cir. 2000) (previous paragraph of Treatise quoted). See § 13.03[F][3] Ns. 310, 312 *infra*. [↑](#footnote-ref-676)
676. 178.5“Floor plans, phone numbers, price range, information about nearby amenities and the like are obvious elements of a real estate agent’s guide.” Sabin v. Regardie, Regardie & Bartow, 770 F. Supp. 5, 8 (D.D.C. 1991). [↑](#footnote-ref-677)
677. 179See Miracle Blade, LLC. v. Ebrands Commerce Group, LLC., 207 F. Supp. 2d 1136, 1150 (D. Nev. 2002). [↑](#footnote-ref-678)
678. 179.1See Mist-On Systems, Inc. v. Gilley’s European Tan Spa, 303 F. Supp. 2d 974, 978 (W.D. Wis. 2002) (Treatise cited). [↑](#footnote-ref-679)
679. 179.2See Porto v. Guirgis, 659 F. Supp. 2d 597, 606, 611 (S.D.N.Y. 2009) (holding “Judas standing trial” to be unprotectible idea). [↑](#footnote-ref-680)
680. 179.3*Id*. at 606, 612. [↑](#footnote-ref-681)
681. 179.4Johnson v. Foxx, 502 F. Supp. 2d 620, 624 (E.D. Mich. 2007). [↑](#footnote-ref-682)
682. 179.5In addition, that company had a policy of returning all unsolicited mail. *Id*. at 623. [↑](#footnote-ref-683)
683. 179.6*Id*. at 623 (Treatise cited). See § 13.02[A] *supra*. [↑](#footnote-ref-684)
684. 180See § 13.03[B][3][e] *supra*. [↑](#footnote-ref-685)
685. 180.1Ets-Hokin v. Skyy Spirits, Inc., 225 F.3d 1068, 1081 (9th Cir. 2000) (“we hold that [merger and scenes a faire] are defenses to infringement”) (Treatise cited). A later opinion in this case made scenes a faire decisive to the ultimate result. See 323 F.3d 763, 765–766 (9th Cir. 2003). [↑](#footnote-ref-686)
686. 181On the copyrightability of such standard elements, see § 2.01[B][3] *supra*. An earlier view stated that “scenes a faire are not copyrightable as a matter of law.” Hoehling v. Universal City Studios, Inc., 618 F.2d 972 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980). [↑](#footnote-ref-687)
687. 182Taylor Corp. v. Four Seasons Greetings LLC, 315 F.3d 1039, 1042–1043 (8th Cir. 2003) (Treatise quoted); Frye v. YMCA Camp Kitaki, 617 F.3d 1005, 1008 (8th Cir. 2010) (Treatise quoted) (no infringement when both plaintiff’s and defendant’s works were interactive plays employing medieval themes at YMCA summer camps); Fulks v. Knowles-Carter, 207 F. Supp. 3d 274, 279, 289 (S.D.N.Y. 2016) (Treatise quoted) (dismissing case against Beyoncé based on such features as “obscuring a subject’s face”). [↑](#footnote-ref-688)
688. 182.1See Innovative Legal Mktg., LLC v. Market Masters-Legal, 852 F. Supp. 2d 688, 703–704 (E.D. Va. 2012) (allowing plaintiff to proceed based on its email script for advertisement of legal services, even though most lines derived from prior work, when plaintiff combined use of celebrity spokesperson against dark background with text flashing in foreground, pointing to admonition “You deserve justice,” with beeping tone and other elements combined). [↑](#footnote-ref-689)
689. 182.2Incredible Techs., Inc. v. Virtual Techs., Inc., 284 F. Supp. 2d 1069, 1076 (N.D. Ill. 2003), *aff’d*, 400 F.3d 1007, 1009 (7th Cir. 2005). [↑](#footnote-ref-690)
690. 182.3400 F.3d at 1010. [↑](#footnote-ref-691)
691. 182.4*Id*. at 1011. Note that defendant designed its product so that a player of plaintiff’s game could step up to defendant’s console “with no learning curve.” 284 F. Supp. 2d at 1072. [↑](#footnote-ref-692)
692. 182.5As to unpatented technologies, it “makes no difference that [plaintiff] ‘invented’ the Golden Tee trackball system, or was the first to describe it.” *Id*. at 1081. [↑](#footnote-ref-693)
693. 182.6

     For instance, the wind meter and club selection features were found to account for variables in real golf and so were indispensable to an accurate video representation of the game. Furthermore, … the game selection features, such as the menu screens which indicate the number of players and other variables of the game, are common to the videogame format.

     400 F.3d at 1014. [↑](#footnote-ref-694)
694. 182.7*Id*. at 1012–1014. [↑](#footnote-ref-695)
695. 182.8See § 13.03[E] *infra*. Plaintiff complained that the district court “did not take into account what happens in the marketplace,” where “Bar and tavern patrons, often in dimly lit spaces, typically approach and play these video games while consuming alcohol; they are not consumers using high degrees of care in selecting, identifying, or differentiating the Golden Tee and PGA Tour games.” The Seventh Circuit dismissed that objection with the sardonic observation, “One wonders how different the control panels would have to be to avoid confusing such users.” 400 F.3d at 1016. [↑](#footnote-ref-696)
696. 182.9Reece v. Island Treasures Art Gallery, Inc., 468 F. Supp. 2d 1197, 1209 (D. Haw. 2006). [↑](#footnote-ref-697)
697. 182.10For instance, “although the lei are worn in the same position around the neck and down the bare torso, the lei around ‘Nohe’s’ neck is thinner and composed of maile interwoven with colorful ilima.” *Id*. at 1208. [↑](#footnote-ref-698)
698. 183Bucklew v. Hawkins, Ash, Baptie & Co., 329 F.3d 923, 926, 928 (7th Cir. 2003) (Treatise cited). [↑](#footnote-ref-699)
699. 183.1In one case involving jewelry pendants, plaintiff’s president mistakenly pressed her fingerprint into the back of the mold during the manufacturing process; when defendant’s pendants were discovered to contain “the same inadvertent fingerprint in the same spot,” copying was patent. Metal Morphosis, Inc. v. Acorn Media Publ’g, Inc., 639 F. Supp. 2d 1367, 1371, 1375 (N.D. Ga. 2009). [↑](#footnote-ref-700)
700. 184Eckes v. Card Prices Update, 736 F.2d 859 (2d Cir. 1984) (Treatise quoted); Central Tel. Co. of Va. v. Johnson Pub. Co., 526 F. Supp. 838 (D. Colo. 1981) (Treatise cited); Sub-Contractors Register, Inc. v. McGovern’s Contractors & Builders Manual, Inc., 69 F. Supp. 507 (S.D.N.Y. 1946); Tradescape.com v. Shivaram, 77 F. Supp. 2d 408, 418 (S.D.N.Y. 1999); College Entrance Book Co. v. Amsco Book Co., 119 F.2d 874 (2d Cir. 1941); Rexnord, Inc. v. Modern Handling Sys., Inc., 379 F. Supp. 1190 (D. Del. 1974); Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 492 (9th Cir. 1985) (Treatise quoted); Camaro Headquarters, Inc. v. Banks, 621 F. Supp. 39 (E.D. Pa. 1985). See Selle v. Gibb, 741 F.2d 896 (7th Cir. 1984); Pic Design Corp. v. Sterling Precision Corp., 231 F. Supp. 106 (S.D.N.Y. 1964); Colonial Book Co. v. Amsco School Publishers, Inc., 41 F. Supp. 156 (S.D.N.Y. 1941); Anderson Co. v. Baldwin Law Publishing Co., 27 F.2d 82 (6th Cir. 1928); Financial Info., Inc. v. Moody’s Investors Serv., Inc., 751 F.2d 501 (2d Cir. 1984) (mathematician testified that copying eight out of eight errors in one year proved copying to a statistical certainty), *later opinion*, 808 F.2d 204, 206–207 & n.1 (2d Cir. 1986), *cert. denied*, 484 U.S. 820, 108 S. Ct. 79, 98 L. Ed. 2d 42 (1987). [↑](#footnote-ref-701)
701. 185M. Kramer Mfg. Co. v. Andrews, 783 F.2d 421, 446 (4th Cir. 1986); Southwestern Bell Tel. Co. v. Nationwide Indep. Directory Serv., Inc., 371 F. Supp. 900 (W.D. Ark. 1974); Lakedale Tel. Co. v. Fronteer Directory Co. of Minn., Inc., 1986 Copyright L. Dec. (CCH) ¶ 26,015 (D. Minn. 1986); Polk & Co. v. Musser, 105 F. Supp. 351 (E.D. Pa. 1952), *aff’d*, 196 F.2d 1020 (3d Cir. 1952); Robbins Music Corp. v. Weinstock, 107 F. Supp. 102 (S.D.N.Y. 1952); Investment Serv. Co. v. Fitch Publishing Co., 291 F. 1010 (7th Cir. 1923). See Flomerics Ltd. v. Fluid Dynamics Int’l, Inc., 880 F. Supp. 60, 62 (D. Mass. 1995). [↑](#footnote-ref-702)
702. 185.1See § 13.01[B] *supra*. Because probative similarity evidences common genealogy (see text accompanying § 13.03[E][2] N. 223 *infra*), consider the parallel of common errors in that discipline: “In evolutionary theory, such traits are called *homologies*: traits that are similar not because they have to be for functional reasons, but because of copying. \* \* \* That is how it is in the biosphere, and also how it is in the cultural sphere of plagiarism … .” D. Dennett, *Darwin’s Dangerous Idea* 136 (1995). [↑](#footnote-ref-703)
703. 185.2Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). [↑](#footnote-ref-704)
704. 185.3Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 845 (10th Cir. 1993). See § 13.01[B] *supra*. [↑](#footnote-ref-705)
705. 186As already noted, fragmented literal similarity—such as may exist in the case of common errors—must be more than *de minimis* for liability to ensue. See § 13.03[A][2] *supra*. [↑](#footnote-ref-706)
706. 186.1In Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 344, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991), the defendant copied numerous unoriginal listings out of plaintiff’s copyrighted telephone directory, including four “fictitious listings that Rural had inserted into its directory to detect copying.” The Supreme Court nonetheless held defendant’s conduct noninfringing as a matter of law. *Accord* BellSouth Advertising & Publishing Corp. v. Donnelley Info. Pub., Inc., 999 F.2d 1436, 1446 n.23 (11th Cir. 1993) *(en banc), cert. denied*, 510 U.S. 1101 (1993). [↑](#footnote-ref-707)
707. 186.2“To treat ‘false’ facts interspersed among actual facts and represented as actual facts as fiction would mean that no one could ever reproduce or copy actual facts without risk of reproducing a false fact and thereby violating a copyright.” Nester’s Map & Guide Corp. v. Hagstrom Map Co., 796 F. Supp. 729, 733 (E.D.N.Y. 1992). See § 2.11[C] *supra.* [↑](#footnote-ref-708)
708. 186.3Sometimes the telltale linkage back to plaintiff’s work is that something is missing. See Bucklew v. Hawkins, Ash, Baptie & Co., 329 F.3d 923, 930 (7th Cir. 2003). Typically, similarity in nonexistent content cannot give rise to infringement liability. *Id*. But see § 13.03[B][2][b] & text accompanying N. 152.5 *supra*. [↑](#footnote-ref-709)
709. 187Morrison v. Solomons, 494 F. Supp. 218 (S.D.N.Y. 1980); Polk & Co. v. Musser, 105 F. Supp. 351 (E.D. Pa. 1952); Alexandria Drafting Co. v. Amsterdam, 43 U.S.P.Q.2d 1247, 1253 (E.D. Pa. 1997) (Treatise cited). See § 13.03[B][1][b] *supra*; G.R. Leonard & Co. v. Stack, 386 F.2d 38 (7th Cir. 1967), in which the court acknowledged that defendant had copied from plaintiff’s directory five fictitious entries inserted by plaintiff as “trap towns,” but nevertheless concluded that the extensive remaining similarity was due to defendant’s independent efforts and not to copying. Note the dissenting opinion by Judge Cummings. See also J.R. O’Dwyer Co., Inc. v. Media Mktg. Int’l, Inc., 755 F. Supp. 599, 603 (S.D.N.Y. 1991). [↑](#footnote-ref-710)
710. 188But cf. Knickerbocker Toy Co. v. Buddy L Corp., 547 F. Supp. 35 (S.D.N.Y. 1982) (a common error plus substantial similarity insufficient to find access upon summary judgement). See § 13.02[B] *supra*. [↑](#footnote-ref-711)
711. 189Hayden v. Chalfant Press, Inc., 281 F.2d 543 (9th Cir. 1960). [↑](#footnote-ref-712)
712. 190Official Aviation Guide Co. v. American Aviation Associates, 150 F.2d 173 (7th Cir.), *cert. denied*, 326 U.S. 776 (1945), *reh’g denied*, 326 U.S. 811 (1946). [↑](#footnote-ref-713)
713. 191If only “facts” are copied, this is noninfringing (see § 13.03[B][2][b] *supra*), even if such “facts” prove to be erroneous. Hoehling v. Universal City Studios, Inc., 618 F.2d 972 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980); Morrison v. Solomons, 494 F. Supp. 218 (S.D.N.Y. 1980) (widespread mistake of this “fact” in profession as a whole). See Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 492 (9th Cir. 1985) (quoting previous sentence of this footnote). It is difficult to determine from the *Cooling Systems* opinion whether it dealt with a situation like *Morrison*, in which “facts” are erroneously accepted by an entire profession, or whether conversely the existence of common errors in *Cooling Systems* actually demonstrated that defendant did copy from plaintiff. Only on the former supposition does *Cooling Systems* harmonize with the cited authorities. Cf. Gem Prods., Inc. v. Robertshaw Control Co., 1986 Copyright L. Dec. (CCH) ¶ 25,975 (C.D. Cal. 1986). [↑](#footnote-ref-714)
714. 192See § 13.01[B] *supra* (defendant’s purported infringement of third party’s copyright irrelevant to plaintiff’s claim). [↑](#footnote-ref-715)
715. 193Morrison v. Solomons, 494 F. Supp. 218 (S.D.N.Y. 1980); Turner v. Century House Publishing Co., 56 Misc. 2d 1071, 290 N.Y.S.2d 637 (Sup. Ct. Schuyler County 1968). See Adventures in Good Eating v. Best Places to Eat, 131 F.2d 809 (7th Cir. 1942). In Farmers Indep. Tel. Co. v. Thorman, 648 F. Supp. 457, 461 (W.D. Wis. 1986), the fact of common errors did not help plaintiff, given that it failed to prove that defendant copied such errors from its copyrighted work, rather than from an earlier version of the work that had fallen into the public domain. [↑](#footnote-ref-716)
716. 194-198[Reserved] [↑](#footnote-ref-717)
717. 199Malkin v. Dubinsky, 146 F. Supp. 111 (S.D.N.Y. 1956). See § 12.10[B] *supra*. [↑](#footnote-ref-718)
718. 200See, *e.g.,* Walker v. Time Life Films, Inc., 784 F.2d 44, 51 (2d Cir.), *cert. denied,* 476 U.S. 1159 (1986) (Treatise cited); Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., 509 F.2d 64 (2d Cir. 1974); Williams v. Kaag Mfrs., Inc., 338 F.2d 949 (9th Cir. 1964); Key West Hand Print Fabrics, Inc. v. Serbin, Inc., 244 F. Supp. 287 (S.D. Fla. 1965); Manes Fabrics Co. v. Miss Celebrity, Inc., 246 F. Supp. 975 (S.D.N.Y. 1965); United Merchants & Mfrs. v. Sutton, 282 F. Supp. 588 (S.D.N.Y. 1967) (“whether an ordinary observer, who is not attempting to discover disparities ‘would be disposed to overlook them and regard their aesthetic appeal as the same’ ”); Gray v. Eskimo Pie Corp., 244 F. Supp. 785 (D. Del. 1965); Ideal Toy Corp. v. Fab-Lu Ltd., 360 F.2d 1021 (2d Cir. 1966); Ideal Toy Corp. v. Fab-Lu, Ltd., 261 F. Supp. 238 (S.D.N.Y. 1966) (“average lay observer” held to include children where the work in question, such as a doll, appeals particularly to children); Marcal Paper Mills, Inc. v. Scott Paper Co., 290 F. Supp. 43 (D.N.J. 1968) (ordinary observer test applied to labels); United Merchants & Mfrs., Inc., v. K. Gimbel Accessories, Inc., 294 F. Supp. 151 (S.D.N.Y. 1968) (fabric designs); Herbert Rosenthal Jewelry Corp. v. Zale Corp., 323 F. Supp. 1234 (S.D.N.Y. 1971) (jewelry); Loomskill, Inc. v. Stein & Fishman Fabrics, Inc., 332 F. Supp. 1288 (S.D.N.Y. 1971) (fabric designs); Kustoff v. Chaplin, 120 F.2d 551 (9th Cir. 1941); Burtis v. Universal Pictures Co., 40 Cal. 2d 823, 256 P.2d 933 (1953); Funkhouser v. Loew’s, Inc., 208 F.2d 185 (8th Cir.), *cert. denied*, 348 U.S. 843, *reh’g denied*, 348 U.S. 890 (1954); Cain v. Universal Pictures Co., 47 F. Supp. 1013 (S.D. Cal. 1942); Harold Lloyd Corp. v. Witwer, 65 F.2d 1 (9th Cir.), *dismissed*, 296 U.S. 669 (1933); Peter Pan Fabrics v. Acadia Co., 173 F. Supp. 292 (S.D.N.Y. 1959), *aff’d sub nom.* Peter Pan Fabrics v. Martin Weiner Corp., 274 F.2d 487 (2d Cir. 1960); Costello v. Loew’s, Inc., 159 F. Supp. 782 (D.D.C. 1958); Gordon v. Weir, 111 F. Supp. 117 (E.D. Mich. 1953), *aff’d,* 216 F.2d 508 (6th Cir. 1954); Barton Candy Corp. v. Tell Chocolate Novelties Corp., 178 F. Supp. 577 (E.D.N.Y. 1959); King Features Syndicate v. Fleischer, 299 F. 533 (2d Cir. 1924); Twentieth Century-Fox Film Corp. v. Stonesifer, 140 F.2d 579 (9th Cir. 1944); Arnstein v. BMI, 46 F. Supp. 379 (S.D.N.Y. 1942), *aff’d*, 137 F.2d 410 (2d Cir. 1943); Cortley Fabrics Co. v. Slifka, 138 U.S.P.Q. 110 (S.D.N.Y. 1963), *aff’d,* 317 F.2d 924 (2d Cir. 1963). See Educational Testing Serv. v. Katzman, 793 F.2d 533, 541 (3d Cir. 1986). [↑](#footnote-ref-719)
719. 200.1The traditional audience test is the focus of this entire § 13.03[E], with the exception of § 13.03[E][1][b] *infra*, and also plays a role in § 13.03[F] *infra*. [↑](#footnote-ref-720)
720. 200.2See § 13.03[E][1][b] *infra*. It is to be added that other areas of intellectual property embody their own distinctive audience tests. See Jeanne C. Fromer and Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 Mich. L. Rev. 1251, 1273 (2014) (positing that copyright law’s “hybrid test, drawing on both the perspective of the expert and that of a nonexpert observer” may be the best among the various fields of law). [↑](#footnote-ref-721)
721. 200.3Ellis v. Diffie, 177 F.3d 503, 506 n.2 (6th Cir. 1999) (Treatise quoted). [↑](#footnote-ref-722)
722. 200.465 F.2d 1 (9th Cir. 1933). [↑](#footnote-ref-723)
723. 201As to the relevance of public opinion polls on this issue, the court in Ideal Toy Corp. v. Kenner Prods., 443 F. Supp. 291 (S.D.N.Y. 1977), commented upon “the dangerous precedent of allowing trial by the court to be replaced by trial by public opinion poll.” See also Warner Bros. v. American Broadcasting Cos., 720 F.2d 231 (2d Cir. 1983), which expressly declined to rule on whether survey evidence is admissible to aid a jury in determining substantial similarity, but held that a trial judge’s grant of summary judgment to the defendant for lack of substantial similarity cannot be found erroneous because of the availability of survey evidence indicating a public belief of similarity. [↑](#footnote-ref-724)
724. 201.1One court proposes substituting the “intended audience” for the “ordinary observer” as the appropriate label. Dawson v. Hinshaw Music, Inc., 905 F.2d 731, 737 (4th Cir.), *cert. denied*, 498 U.S. 981 (1990). See the discussion of this case in § 13.03[E][4] *infra* [↑](#footnote-ref-725)
725. 20265 F.2d at 18 (emphasis added). See Kohus v. Mariol, 328 F.3d 848, 854 (6th Cir. 2003) (Treatise cited); Peel & Co. v. Rug Market, 238 F.3d 391, 398 n.35 (5th Cir. 2001) (Treatise cited). [↑](#footnote-ref-726)
726. 202aDawson v. Hinshaw Music, Inc., 905 F.2d 731, 736 (4th Cir.), *cert. denied*, 498 U.S. 981 (1990) (Treatise quoted); Randolph v. Dimension Films, 634 F. Supp. 2d 779, 788, 792 (S.D. Tex. 2009) (Treatise quoted). [↑](#footnote-ref-727)
727. 202bSid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp., 562 F.2d 1157 (9th Cir. 1977). See § 13.03[A][1][c] *supra*. [↑](#footnote-ref-728)
728. 202cLyons Partnership, L.P. v. Morris Costumes, Inc., 243 F.3d 789, 801–803 (4th Cir. 2001). Although adults could readily distinguish defendant’s Duffy the Dinosaur full-body costume from plaintiff’s copyrighted Barney the Dinosaur, those adults rented the costume in the apparently legitimate belief that the 2–5 year olds whom they wished to entertain would not be so discerning. *Id.* at 803. [↑](#footnote-ref-729)
729. 202.1Prior to 1991, the most recent Court opinion addressed the scope of rights in underlying works when incorporated into derivative works; no argument was advanced there that defendant’s movie did not infringe on plaintiff’s short story absent reliance on the “new property right” theory (and, in the court below, indivisibility and fair use.) Stewart v. Abend, 495 U.S. 207, 110 S. Ct. 1750, 109 L. Ed. 2d 184 (1990). See § 3.07[A][3] *supra*. In the 1980’s, the Court confronted the work-for-hire doctrine (Community for Creative Non-Violence v. Reid, 490 U.S. 730 (1989), see § 5.03[B][1][a][iii] *supra*), the scope of fair use (Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985), see § 13.05[A][5] *infra*), termination of transfers (Mills Music, Inc. v. Snyder, 469 U.S. 153 (1985), see § 11.02[B][3] *supra*), criminal aspects relating to copyright (Dowling v. United States, 473 U.S. 207 (1985), see § 15.05 *infra*), and home taping as it relates to contributory infringement and fair use (Sony Corp. v. Universal City Studios, Inc. 464 U.S. 417, 104 S. Ct. 774, 78 L. Ed. 2d 574 (1984), see § 12.04[A][3][b][i] *supra*). [↑](#footnote-ref-730)
730. 202.2499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). See further discussion of this case in § 3.04[B][2][a] *supra*. [↑](#footnote-ref-731)
731. 202.3The entire quote is:

     Not all copying, however, is copyright infringement. 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. See Harper & Row, 471 U.S., at 548.

     499 U.S. at 361. See § 13.01[B] *supra*. Notwithstanding the citation to Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 548, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985), that earlier case does not set forth the elements of an infringement case, nor does it define the level of culpable copying. The cited page does state: “[C]opyright does not prevent subsequent users from copying from a prior author’s work those constituent elements that are not original … as long as such use does not unfairly appropriate the author’s original contribution.” *Id*. at 548 (Treatise cited). Nonetheless, the Court there continues: “We need not reach those issues, however, as The Nation has admitted to lifting verbatim quotes of the author’s original language … constituting some 13% of The Nation article.” *Id*. The case then turns on fair use. See § 13.05[A][5] *infra*. [↑](#footnote-ref-732)
732. 202.4Apart from the circumstance that the Court stated that this element exists “[t]o prove infringement” without limiting its statement to the context of factual works, the Court’s citation to *Harper & Row*—a case about President Ford’s memoirs, a more traditional type of literary work (albeit one which contained some facts)—would have been inapposite had the Court meant thus to limit itself. [↑](#footnote-ref-733)
733. 202.5Justice O’Connor authored the opinion, which won the accord of a spectrum running from Justice Marshall to Justice Scalia, and included the Court’s then-newest member, Justice Souter. Justice Blackmun merely concurred in the judgment. [↑](#footnote-ref-734)
734. 202.6The elements at issue were facts, which lie beyond copyright protection. See the further discussion of *Feist* in §§ 13.01[B] & 13.03[B][2][b] *supra*. [↑](#footnote-ref-735)
735. 202.7See § 13.03[E][1][a] *supra*. [↑](#footnote-ref-736)
736. 202.7aKohus v. Mariol, 328 F.3d 848, 854 (6th Cir. 2003) (Treatise quoted). [↑](#footnote-ref-737)
737. 202.7b*Id.* [↑](#footnote-ref-738)
738. 202.8See § 13.03[E][2] *infra*. [↑](#footnote-ref-739)
739. 202.9See the various approaches canvassed in § 13.03[E][3] *infra*. [↑](#footnote-ref-740)
740. 202.10Exceptions within exceptions have become a standard feature in audience test jurisprudence. In Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 493 (9th Cir. 1985), the Ninth Circuit stated, “What is important is not whether there is substantial similarity in the total concept and feel of the works, [citation] but whether the very small amount of protectible expression in [plaintiff]’s catalog is substantially similar to the equivalent portions of [defendant]’s catalog.” Two years after that decision, the same court held *Cooling Systems* inapplicable to artistic works, ruling that even uncopyrightable material could be considered in evaluating substantial similarity. McCulloch v. Albert E. Price, Inc., 823 F.2d 316, 321 (9th Cir. 1987). Shortly thereafter, however, the Ninth Circuit limited its limitation of *Cooling Systems*: “Although even unprotectible material should be considered when determining if there is substantial similarity of expression, see *McCulloch*, 823 F.2d at 320–21, no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise form the use of common ideas.” Aliotti v. R. Dakin & Co., 831 F.2d 898, 901 (9th Cir. 1987). It would seem that *Feist* demands, at a minimum, *Aliotti*’s limitation of *McCulloch*. [↑](#footnote-ref-741)
741. 202.11See generally T. Kuhn, *The Structure of Scientific Revolutions* (1970). [↑](#footnote-ref-742)
742. 202.12Ellis v. Diffie, 177 F.3d 503, 506 n.2 (6th Cir. 1999) (Treatise quoted). See § 13.03[E][2] *infra*. [↑](#footnote-ref-743)
743. 202.13Shipman v. RKO, 100 F.2d 533 (2d Cir. 1938). [↑](#footnote-ref-744)
744. 202.14Without expressly discussing the audience test, its underlying rationale was brought into question in Warner Bros. v. American Broadcasting Cos., 720 F.2d 231 (2d Cir. 1983). Judge Newman, speaking for the court, stated: “The ‘substantial similarity’ that supports an inference of copying sufficient to establish an infringement of copyright is not a concept familiar to the public at large … [W]hen a trial judge has correctly ruled that two works are not substantially similar as a matter of law, that conclusion is not to be altered by the availability of survey evidence indicating that some people applying some standard of their own were reminded by one work of the other … If a case lies beyond those limits, the contrary view of a properly drawn sample of the population, or even of a particular jury, cannot be permitted to enlarge (or diminish) the scope of statutory protection enjoyed by a copyright proprietor.” *Id.* at 245. [↑](#footnote-ref-745)
745. 202.15Indeed, given the disagreement among the circuits about how to apply the audience test, Supreme Court review is ripe on this basis alone. See § 13.03[E][3] *infra*. [↑](#footnote-ref-746)
746. 202.15aSee Katsh & Rifkin, *The New Media and a New Model of Conflict Resolution: Copying, Copyright, and Creating*, 6 Notre Dame J.L. Ethics & Pub. Pol’y 49, 60–63 (1992) (showing explosive growth in litigation of copyright cases, with marked increase in cases of computer variety). [↑](#footnote-ref-747)
747. 202.16See § 13.03[E][4] *infra*. [↑](#footnote-ref-748)
748. 202.17Celotex Corp. v. Catrett, 477 U.S. 317 (1986) (“Summary judgment procedure is properly regarded not as a disfavored procedural shortcut, but rather as an integral part of the Federal Rules as a whole, which are designed ‘to secure the just, speedy and inexpensive determination of every action.’ ”) See Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986). Various copyright cases have cited these Supreme Court precedents in granting summary judgment, both to plaintiffs and defendants. See, *e.g.,* Steinberg v. Columbia Pictures Indus., Inc., 663 F. Supp. 706 (S.D.N.Y. 1987); Sandwiches, Inc. v. Wendy’s Int’l, Inc., 654 F. Supp 1066, 1070 (E.D. Wis. 1987); Marshall v. Miles Lab., Inc., 647 F. Supp. 1326, 1329 (M.D. Ind. 1986). [↑](#footnote-ref-749)
749. 202.18See § 12.10[B][3] *supra.* [↑](#footnote-ref-750)
750. 202.19See Kuhn, *op. cit.* N. 202.11 *supra*. Although the Grand Unified Theory of Copyright may continue to elude our grasp, solace can be derived from the continual striving for such a theory even in the much older discipline of physics. See Ferris, “Grand Unification Theories: Faith in Ultimate Simplicity,” in *The Coming Era in Science* (H. Noble, ed.) (1988). [↑](#footnote-ref-751)
751. 202.20This conclusion arises out of the physicists’ “Faith in Ultimate Simplicity.” See *id.* Rather than a specific rule tailored to every fact situation, in which carved-out exceptions and counterprinciples dominate each decision, this writer submits that consistent rules of general application furnish a far more elegant framework for decisionmaking. See Tribe, *Taking Text and Structure Seriously: Reflections on Free-Form Method in Constitutional Interpretation*, 108 Harv. L. Rev. 1221, 1287 & n.217 (1995). [↑](#footnote-ref-752)
752. 202.21“The mere fact that a work is copyrighted does not mean that every element of the work may be protected.” *Feist*, 499 U.S. at 348. [↑](#footnote-ref-753)
753. 202.22See Nimmer, Bernacchi & Frischling, *A Structured Approach to Analyzing the Substantial Similarity of Computer Software in Copyright Infringement Cases,* 20 Ariz. St. L.J. 625, 655–56 (1988), which forms the basis for § 13.03[F] *infra*. [↑](#footnote-ref-754)
754. 202.23For some examples of cases applying the *Feist* standard *avant la lettre*, see Novak v. National Broadcasting Co., 716 F. Supp. 745, 752 (S.D.N.Y. 1989), *later opinion*, 724 F. Supp. 141 (S.D.N.Y. 1989) (“after the court ‘distills out’ the unprotectible ideas and *scenes a faire*,” summary judgment for defendant granted on some counts, denied on another); Feder v. Videotrip Corp., 697 F. Supp. 1165 (D. Colo. 1988) (Treatise cited) (denying liability notwithstanding plaintiff’s refusal of defendant’s request for a license and defendant nonetheless copied some facts, scenes a faire, and tiny amount of protected expression from plaintiff’s copyrighted work). After *Feist*, see Laureyssens v. Idea Group, Inc., 768 F. Supp. 1036, 1053–55 (S.D.N.Y. 1991) (although defendant consciously copied plaintiff’s work, which would look similar to ordinary observer, liability denied as similarities did not relate to those aspects that were original to plaintiff), *aff’d (but rev’d on other grounds)*, 964 F.2d 131 (2d Cir. 1992). The *Laureyssens* Second Circuit opinion effectively filtered out unprotected elements from plaintiff’s admittedly copyrighted work to conclude that the remaining appropriation was not actionable. 964 F.2d at 141. Under those circumstances, the court conceded that a “more discerning ordinary observer test for substantial similarity” is appropriate. *Id*. See § 13.03[E][3][a][ii] *infra*. [↑](#footnote-ref-755)
755. 202.23aKohus v. Mariol, 328 F.3d 848, 855 n.1 (6th Cir. 2003) (Treatise cited); Tiseo Architects, Inc. v. B & B Pools Serv. & Supply Co., 495 F.3d 344, 348 (6th Cir. 2007) (following *Kohus* and filtering out unprotectible elements of architectural work). “What must be shown is substantial similarity between those elements, *and only those elements*, that provide copyrightability to the allegedly infringed compilation.” Key Publications, Inc. v. Chinatown Today Pub. Enters., Inc., 945 F.2d 509, 514 (2d Cir. 1991) (emphasis added). [↑](#footnote-ref-756)
756. 202.23bCountry Kids ‘N City Slicks, Inc. v. Sheen, 77 F.3d 1280, 1284 n.5 (10th Cir. 1996) (Treatise quoted). [↑](#footnote-ref-757)
757. 202.23cSee Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp., 25 F.3d 119, 123 (2d Cir. 1994) (children’s toys); Jarvis v. A & M Records, 827 F. Supp. 282, 290–91 (D.N.J. 1993) (song); Coates-Freeman Assoc., Inc. v. Polaroid Corp., 792 F. Supp. 879, 885 (D. Mass. 1992). [↑](#footnote-ref-758)
758. 202.24As set forth below, the successive filtering should winnow out, for instance, elements of the plaintiff’s work that are copied from prior works, that contain raw facts, that constitute scenes a faire, and that result from the merger of idea and expression. See § 13.03[F] *infra*. [↑](#footnote-ref-759)
759. 202.25If attention is paid to how courts have actually proceeded in past infringement analyses, rather than their nomenclature, *Feist* does not represent a radical shift. See, *e.g.,* Flag Fables, Inc. v. Jean Ann’s Country Flags & Crafts, Inc., 730 F. Supp. 1165, 1179 (D. Mass. 1989) (“the only ‘substantial similarity’ which is legally significant is that existing between protected aspects of the plaintiff’s work and the conflicting elements of the defendant’s design”), *citing* Concrete Mach. Co., v. Classic Lawn Ornaments, Inc., 843 F.2d 600 (1st Cir. 1988). The point is that such past infringement analyses have departed from the strict perspective of the ordinary observer, thus *pro tanto* abandoning the core of the audience test, notwithstanding their rote invocation of the ordinary observer as a step in the analytic process. See, *e.g.,* *id*. at 1178 (“an ‘ordinary observer’ comparison of each party’s artistic expression”). [↑](#footnote-ref-760)
760. 202.25aSee Newton v. Diamond, 388 F.3d 1189, 1194 (9th Cir. 2004), *cert. denied*, 545 U.S. 1114, 125 S. Ct. 2905, 162 L. Ed. 2d 294 (2005) (“we must ‘filter out’ the licensed elements”). [↑](#footnote-ref-761)
761. 202.25bMurray Hill Publ’ns, Inc. v. Twentieth Century-Fox Film Corp., 361 F.3d 312, 325–26 (6th Cir.), *cert. denied*, 543 U.S. 959 (2004) (when plaintiff alleged that its screenplay was infringed by defendant’s movie based on 24 similarities, and defendant proved that it earlier registered its own screenplay containing 18 of those elements, they would be filtered out, leaving only the 6 remaining points). [↑](#footnote-ref-762)
762. 202.26For instance, in Collins & Aikman Corp. v. Carpostan Indus., Inc., 720 F. Supp. 561, 565 (D.S.C. 1989), *aff’d mem.*, 905 F.2d 1529 (4th Cir. 1990) (Treatise cited), there were “substantial differences in the construction of these two fabric designs and slight differences in visual impression.” Under the audience test, the judge was constrained to send the case to the trier of fact. Given that the parties consented to trial on the merits being consolidated with the preliminary injunction motion, the trier of fact in that case was also the judge, who ruled in defendant’s favor. *Id*. at 566. Query whether the same verdict would have been returned by a jury instructed according to the “ordinary observer” test. [↑](#footnote-ref-763)
763. 202.27See § 13.03[E][1][a] *supra*. [↑](#footnote-ref-764)
764. 202.28See quote in text accompanying § 13.03[E][1][a] N. 202 *supra*. [↑](#footnote-ref-765)
765. 202.29See Kohus v. Mariol, 328 F.3d 848, 854 (6th Cir. 2003) (Treatise cited). [↑](#footnote-ref-766)
766. 203Twentieth Century-Fox Film Corp. v. Stonesifer, 140 F.2d 579, 582 (9th Cir. 1944). [↑](#footnote-ref-767)
767. 204Solomon v. RKO Radio Pictures, 44 F. Supp. 780, 782 (S.D.N.Y. 1942). [↑](#footnote-ref-768)
768. 205*Id*. [↑](#footnote-ref-769)
769. 206Roe-Lawton v. Hal E. Roach Studios, 18 F.2d 126, 128 (S.D. Cal. 1927). [↑](#footnote-ref-770)
770. 207Shipman v. RKO Radio Pictures, 100 F.2d 533 (2d Cir. 1938). [↑](#footnote-ref-771)
771. 2086 F. Cas. 1132, No. 3,552 (C.C. S.D.N.Y. 1868). [↑](#footnote-ref-772)
772. 209*Id.* at 1137. [↑](#footnote-ref-773)
773. 210*Id.* at 1138. [↑](#footnote-ref-774)
774. 211Harold Lloyd Corp. v. Witwer, 65 F.2d 1, 18 (9th Cir. 1933)*, cert. denied,* 296 U.S. 669 (1933). [↑](#footnote-ref-775)
775. 212MCA, Inc. v. Wilson, 425 F. Supp. 443 (S.D.N.Y. 1976) (Treatise quoted), *modified*, 677 F.2d 180 (2d Cir. 1981). After quoting the foregoing sentence, the *MCA* court held that evidence of the reactions of members of the cast and audience at a play were relevant on the issue of similarity, and further that a third party may testify as to what cast and audience members told him in this regard, despite the hearsay rule, under the “present sense impressions” exception. See Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607 (7th Cir. 1982), *cert. denied,* 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 145 (1982) (extrinsic evidence of reactions of sales clerks and retailers held relevant). [↑](#footnote-ref-776)
776. 213See Echevarria v. Warner Bros. Pictures, 12 F. Supp. 632, 634 (S.D. Cal. 1935). [↑](#footnote-ref-777)
777. 214Sheldon v. Metro-Goldwyn Pictures Corp., 7 F. Supp. 837 (S.D.N.Y. 1934), *rev’d*, 81 F.2d 49 (2d Cir. 1936). [↑](#footnote-ref-778)
778. 215Twentieth Century-Fox Film Corp. v. Stonesifer, 140 F.2d 579, 583 (9th Cir. 1944). See Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 713 (2d Cir. 1992) (Treatise cited); Bevan v. Columbia Broadcasting Sys., Inc., 329 F. Supp. 601 (S.D.N.Y. 1971) (Treatise cited). [↑](#footnote-ref-779)
779. 216Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 56 (2d Cir. 1936). [↑](#footnote-ref-780)
780. 217Simonton v. Gordon, 12 F.2d 116, 120 (S.D.N.Y. 1925). [↑](#footnote-ref-781)
781. 218Harold Lloyd Corp. v. Witwer, 65 F.2d 1 (9th Cir. 1933)*, cert. denied,* 78 L. Ed. 1507 (1934). [↑](#footnote-ref-782)
782. 219London v. Biograph Co., 231 F. 696, 698 (2d Cir. 1916). [↑](#footnote-ref-783)
783. 220175 F. 902 (2d Cir. 1910). [↑](#footnote-ref-784)
784. 221*Id.* at 907 (emphasis added). See also Filmvideo Releasing Corp. v. Hastings, 509 F. Supp. 60 (S.D.N.Y. 1981), *aff’d*, 668 F.2d 91 (2d Cir. 1981). [↑](#footnote-ref-785)
785. 222Stonesifer v. Twentieth Century-Fox Film Corp., 48 F. Supp. 196 (S.D. Cal. 1942), *aff’d*, 140 F.2d 579 (9th Cir. 1944). [↑](#footnote-ref-786)
786. 223See § 13.03[E][4] *infra*. [↑](#footnote-ref-787)
787. 224“Although dissection and expert testimony is not favored, the judicially created ordinary observer test should not deprive authors of this significant statutory grant merely because the technical requirements of a different medium *dictate* certain differences in expression. Without deciding the question, we note that in some cases it may be important to educate the trier of fact as to such considerations in order to preserve the author’s rights under the Copyright Act.” Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607, 618 n.12 (7th Cir. 1982) (Treatise cited) (emphasis original), *cert. denied,* 459 U.S. 880, 103 S. Ct. 176, 74 L. Ed. 2d 145 (1982). See also Atari, Inc. v. Amusement World, Inc., 547 F. Supp. 222 (D. Md. 1981); Midway Mfg. Co. v. Bandai-Am., Inc., 546 F. Supp. 125 (D.N.J. 1982). [↑](#footnote-ref-788)
788. 22565 F.2d 1 (9th Cir. 1933)*, cert. denied,* 78 L. Ed. 1507 (1934). [↑](#footnote-ref-789)
789. 226*Id*. at 27 (emphasis added). [↑](#footnote-ref-790)
790. 22749 F. Supp. 738, 745 (S.D.N.Y. 1943), *aff’d,* 139 F.2d 116 (2d Cir. 1943). [↑](#footnote-ref-791)
791. 228Cf. Baxter v. MCA, Inc., 812 F.2d 421, 422 n.2 (9th Cir. 1987) (declining to consider plaintiff’s argument that the “lay audience” test is unsatisfactory “in technical fields such as music because an infringer can easily deceive the unsophisticated by immaterial variations in the copyrighted work”), *cert. denied,* 484 U.S. 954, 108 S. Ct. 346, 98 L. Ed. 2d 372 (1987). [↑](#footnote-ref-792)
792. 22965 F.2d 1, 28 (9th Cir. 1933) (emphasis added), *cert. dismissed,* 78 L. Ed. 1507 (1934). [↑](#footnote-ref-793)
793. 230See § 13.03[E][2] *supra*. [↑](#footnote-ref-794)
794. 231See § 13.03[E][1][b] *supra*. [↑](#footnote-ref-795)
795. 232A dissenter takes the majority to task for failing to apply the “ordinary observer” test. Eden Toys, Inc. v. Marshall Field & Co., 675 F.2d 498, 501 (2d Cir. 1982) (Lumbard, J., dissenting). Indeed, even in the realm of computer software, for which the audience test is peculiarly ill-suited, courts have begun to abandon the test only with reluctance. See § 13.03[E][4] *infra*. [↑](#footnote-ref-796)
796. 233Sheldon v. Metro-Goldwyn Pictures Corp., 7 F. Supp. 837, 842 (S.D.N.Y. 1934), *rev’d*, 81 F.2d 49 (2d Cir. 1936). [↑](#footnote-ref-797)
797. 234In Ann Howard Designs, L.P. v. Southern Frills, Inc., 992 F. Supp. 688, 690 (S.D.N.Y. 1998), the court concluded that two substantially similar picture frames, each decorated with miniature items (*e.g.*, sailboat, anchor, sailor’s hat), when “one takes a closer look,” share similarity from “the nature of the industry from which both parties profit” rather than from infringement. [↑](#footnote-ref-798)
798. 235Gund, Inc. v. Russ Berrie & Co., 701 F. Supp. 1013, 1021 (S.D.N.Y. 1988). See Peter F. Gaito Architecture, LLC v. Simone Dev. Corp., 602 F.3d 57, 66 (2d Cir. 2010). Another court quoted that standard to deny that the “concededly similar” photographs used in defendant’s packaging sufficed to create liability as to plaintiff’s packaging of a comparable product (the uncopyrightable “Ped Egg”). See Telebrands Corp. v. Del Labs., Inc., 719 F. Supp. 2d 283, 295–296 (S.D.N.Y. 2010). [↑](#footnote-ref-799)
799. 235.1Petrella v. Metro-Goldwyn-Mayer, Inc., 188 L. Ed. 2d 979, 996 (2014). [↑](#footnote-ref-800)
800. 235.2The case arose in the context of laches. See § 12.06[A][2][a] *supra*. Discounting evidentiary harm from the passage of decades, the Court commented in that context:

     Key evidence in the litigation, then, will be the certificate, the original work, and the allegedly infringing work. And the adjudication will often turn on the factfinder’s direct comparison of the original and the infringing works, *i.e.*, on the factfinder’s “good eyes and common sense” in comparing the two works’ “total concept and overall feel.”

     188 L. Ed. 2d at 996. [↑](#footnote-ref-801)
801. 236154 F.2d 464 (2d Cir. 1946). [↑](#footnote-ref-802)
802. 237See § 13.03[B] *supra*. [↑](#footnote-ref-803)
803. 238See Morse v. Fields, 127 F. Supp. 63 (S.D.N.Y. 1954); Weitzenkorn v. Lesser, 40 Cal. 2d 778, 256 P.2d 947 (1953). But cf. Golding v. R.K.O., 35 Cal. 2d 690, 221 P.2d 95 (1950); Consumers Union of U.S. v. Hobart, 199 F. Supp. 860 (S.D.N.Y. 1961). [↑](#footnote-ref-804)
804. 239Note that Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 713 (2d Cir. 1992) (Treatise cited), beyond quoting the above text, significantly reformulates the Second Circuit’s test for the admissibility of expert testimony in the context of analyzing substantial similarity between two computer programs. See §§ 13.03[E][4], 13.03[F] *infra*. [↑](#footnote-ref-805)
805. 240Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946); Scott v. WKJG, Inc., 376 F.2d 467 (7th Cir. 1967); Mattell, Inc. v. S. Rosenberg Co., 296 F. Supp. 1024 (S.D.N.Y. 1968); Stratchborneo v. Arc Music Corp., 357 F. Supp. 1393 (S.D.N.Y. 1973); Monogram Models, Inc. v. Industro Motive Corp., 492 F.2d 1281 (6th Cir. 1974); Walker v. Time Life Films, Inc., 784 F.2d 44, 51–52 (2d Cir.), *cert. denied*, 476 U.S. 1159, 106 S. Ct. 2278, 90 L. Ed. 2d 721 (1986). See Original Appalachian Artworks, Inc. v. McCall Pattern Co., 649 F. Supp. 832, 836 (N.D. Ga. 1986), *aff’d*, 825 F.2d 355 (11th Cir. 1987); West Publ’g Co. v. Lawyers Coop. Publ’g Co., 79 F. 756 (2d Cir. 1897). [↑](#footnote-ref-806)
806. 241See Berman & Boxer, *Copyright Infringement of Audiovisual Works and Characters*, 52 S. Cal. L. Rev. 315 (1979) (arguing that literary analysis “may be an inadequate tool, at best, when applied in a case involving motion pictures and television programs”). [↑](#footnote-ref-807)
807. 242Kohus v. Mariol, 328 F.3d 848, 855 (6th Cir. 2003) (Treatise quoted); A Slice of Pie Prods., LLC v. Wayans Bros. Entm’t, 487 F. Supp. 2d 33, 40 (D. Conn. 2007) (Treatise quoted). [↑](#footnote-ref-808)
808. 243Miller v. Universal City Studios, Inc., 650 F.2d 1365 (5th Cir. 1981). [↑](#footnote-ref-809)
809. 244Warner Bros., Inc. v. American Broad. Cos., 654 F.2d 204 (2d Cir. 1981) (Treatise quoted); Arnstein v. Twentieth Century-Fox Film Corp., 52 F. Supp. 114 (S.D.N.Y. 1943). See Trousseau Monogram Corp. v. Saturday Knight Ltd., 16 U.S.P.Q.2d 1079, 1080 (S.D.N.Y. 1990). [↑](#footnote-ref-810)
810. 245McMahon v. Prentice-Hall, Inc., 486 F. Supp. 1296 (E.D. Mo. 1980). [↑](#footnote-ref-811)
811. 246Walker v. Time Life Films, Inc., 784 F.2d 44, 52 (2d Cir.), *cert. denied*, 476 U.S. 1159, 106 S. Ct. 2278, 90 L. Ed. 2d 721 (1986). [↑](#footnote-ref-812)
812. 246.1For a particularly egregious list of single words, see Sherman v. Jones, 457 F. Supp. 2d 793, 795 (E.D. Mich. 2006) (rejecting plaintiff’s prayer for $100 million in damages plus reimbursement of medical expenses, *id.* at 797). One case, lamenting that “plaintiff’s submission has frustrated the Court and has obfuscated the issues,” denied her case *in toto* (and appended two dozen pages of detailed charts to show why). McDonald v. K-2 Indus., Inc., 108 F. Supp. 3d 135, 142–42, 148–71 (W.D.N.Y. 2015). [↑](#footnote-ref-813)
813. 247Olson v. National Broad. Co., 855 F.2d 1446, 1450 (9th Cir. 1988); Litchfield v. Spielberg, 736 F.2d 1352, 1356 (9th Cir. 1984); Cavalier v. Random House, Inc., 297 F.3d 815, 825 (9th Cir. 2002); Leigh v. Warner Bros., Inc., 212 F.3d 1210, 1215 (11th Cir. 2000); Comins v. Discovery Comms., Inc., 200 F. Supp. 2d 512, 518 (D. Md. 2002). See Nicassio v. Viacom Int’l, Inc., 309 F. Supp. 3d 381, 395 (W.D. Pa. 2018), *aff’d unpub*., 776 Fed. Appx. 761 (3d Cir.), *cert. denied*, 140 S. Ct. 630 (2019); Nobile v. Watts, 289 F. Supp. 3d 527, 534 (S.D.N.Y. 2017); Dickerson v. WB Studio Enters., Inc., 276 F. Supp. 3d 167, 173 (S.D.N.Y. 2017). [↑](#footnote-ref-814)
814. 247.1See Cy Wakeman, Inc. v. Nicole Price Consulting, LLC, 284 F. Supp. 3d 985, 991 (D. Neb. 2018). [↑](#footnote-ref-815)
815. 248See Walker v. Time Life Films, Inc., 784 F.2d 44, 52 (2d Cir.), *cert. denied*, 476 U.S. 1159, 106 S. Ct. 2278, 90 L. Ed. 2d 721 (1986) (“it might be an abuse of discretion to bar a plaintiff from using [a list of similarities] in arguing on a summary judgment motion”). [↑](#footnote-ref-816)
816. 249The full passage, which is widely quoted, see cases collected in N. 247 *supra*, is the following:

     While we have relied on such lists of similarities in the past for “illustrative purposes,” they are inherently subjective and unreliable. We are particularly cautious where, as here, the list emphasizes random similarities scattered throughout the works.

     Litchfield v. Spielberg, 736 F.2d 1352, 1356 (9th Cir. 1984) (citation omitted). [↑](#footnote-ref-817)
817. 249aAn example is Hajim v. Endemol Shine Uk, 545 F. Supp. 3d 643, 650 (N.D. Ill. 2021). [↑](#footnote-ref-818)
818. 249.1Interestingly, the trial after remand resulted in the same determination as the trial court initially made—plaintiff Arnstein lost. This time, the same panel of the Second Circuit affirmed in a single brief paragraph. See Arnstein v. Porter, 158 F.2d 795 (2d Cir. 1946) (*per curiam*). [↑](#footnote-ref-819)
819. 250154 F.2d at 473. [↑](#footnote-ref-820)
820. 251*Id*. But outside the Second Circuit, another court reversed the district court in considering this second *Arnstein* issue, on the ground that the appellate court is in as good a position as the trial court to decide issues of substantial similarity. Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607 (7th Cir. 1982). [↑](#footnote-ref-821)
821. 252Ideal Toy Corp. v. Fab-Lu, Ltd., 360 F.2d 1021 (2d Cir. 1966). It has been said that “the [*Arnstein*] two steps … seem to have been merged into the single lay-observer test for substantial similarity.” Ideal Toy Corp. v. Kenner Prods., 443 F. Supp. 291, 303 (S.D.N.Y. 1977). [↑](#footnote-ref-822)
822. 253Smith v. Little, Brown & Co., 245 F. Supp. 451 (S.D.N.Y. 1965), *aff’d*, 360 F.2d 928 (2d Cir. 1966); Bevan v. Columbia Broad. Sys., Inc., 329 F. Supp. 601 (S.D.N.Y. 1971) (Treatise cited); McGraw-Hill, Inc. v. Worth Publishers, Inc., 335 F. Supp. 415 (S.D.N.Y. 1971); In Design v. Lynch Knitting Mills, Inc., 689 F. Supp. 176 (S.D.N.Y.), *aff’d mem.*, 863 F.2d 45 (2d Cir. 1988); Uneeda Doll Co. v. Regent Baby Prods. Corp., 355 F. Supp. 438 (E.D.N.Y. 1972) (infringement may be found, although the differences between the two works are such that “one would not be mistaken for the other,” as long as an observer would be convinced “that one depends on the other, that one has drawn from the other, not merely unimportant features but the purposive combination of features that … comprises a considerable part of its character and appeal”). [↑](#footnote-ref-823)
823. 253.1For a fascinating retrospective on the three judges’ views in *Arnstein*, see Shyamkrishna Balganesh, *The Questionable Origins of the Copyright Infringement Analysis*, 68 Stan. L. Rev. 791 (2016). He concludes that both copyright “law and policy were silent participants in the judges’ formulation of their views in the case,” which instead were dictated by their general legal philosophies. *Id*. at 387. The article further demonstrates that almost all the assumptions underlying that case have subsequently “come to be openly repudiated,” on which basis he counsels its formal abandonment. *Id*. at 863. [↑](#footnote-ref-824)
824. 254See § 13.03[A][1] *supra*. [↑](#footnote-ref-825)
825. 255This is in the first instance an issue of fact; but, as with all factual issues, it may become a determination of law when the facts lie at one end or the other of the continuum. [↑](#footnote-ref-826)
826. 256See § 13.03[A][2] *supra*. [↑](#footnote-ref-827)
827. 257Morse v. Fields, 127 F. Supp. 63 (S.D.N.Y. 1954); Stanley v. Columbia Broad. Sys., Inc., 35 Cal. 2d 653, 221 P.2d 73 (1950). See Millworth Converting Corp. v. Slifka, 276 F.2d 443 (2d Cir. 1960); Prestige Floral Société Anonyme v. Zunino-Altman, Inc., 203 F. Supp. 649 (S.D.N.Y. 1962), *aff’d*, 301 F.2d 286 (2d Cir. 1962). See § 12.10[B][3] *supra*. Note the further discussion of exceptions within exceptions in § 13.03[E][1][b] N. 202 *supra*. [↑](#footnote-ref-828)
828. 258For an elaboration, see § 13.03[E][3][a][i] *infra*. [↑](#footnote-ref-829)
829. 259See Ideal Toy Corp. v. Kenner Prods., 443 F. Supp. 291 (S.D.N.Y. 1977) (“While such a test does not involve a critical dissection of the objects being compared, it does allow a certain summary of the similarities and differences which exist.”). [↑](#footnote-ref-830)
830. 260Feist Pub’lns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). [↑](#footnote-ref-831)
831. 261On the necessity of dissection to delineate the protectible portion of the plaintiff’s work, see § 13.03[E][1][b] *supra*. [↑](#footnote-ref-832)
832. 262See § 13.03[E][1][b] *supra*. [↑](#footnote-ref-833)
833. 262.1Folio Impressions, Inc. v. Byer Cal., 937 F.2d 759, 767 (2d Cir. 1991); Laureyssens v. Idea Group, Inc., 964 F.2d 131, 141 (2d Cir. 1992); Boisson v. Banian, Ltd, 273 F.3d 262, 272 (2d Cir. 2001). [↑](#footnote-ref-834)
834. 262.2See §§ 13.03[E][1][b] *supra*; 13.03[F] *infra*. [↑](#footnote-ref-835)
835. 262.3Odegard Inc. v. Safavieh Carpets, Inc., 398 F. Supp. 2d 275, 281 (S.D.N.Y. 2005). [↑](#footnote-ref-836)
836. 262.4*Id*. at 280. [↑](#footnote-ref-837)
837. 262.5*Id*. at 281. [↑](#footnote-ref-838)
838. 262.6Folio Impressions, Inc. v. Byer Cal., 937 F.2d 759, 765 (2d Cir. 1991). See the decision below, 752 F. Supp. 583, 591–592 (S.D.N.Y. 1990). [↑](#footnote-ref-839)
839. 262.7On the other hand, a later decision applying *Folio Impressions* declined to engage in dissection, and went to the opposite extreme of invoking the unhelpful standard of “total concept and feel.” Knitwaves, Inc., v. Lollytogs Ltd., 71 F.3d 996, 1003 (2d Cir. 1995). See § 13.03[A][1][c] *supra*. It has been further held, however, that “the copyrighted sweaters in *Knitwaves* were original creations in their entirety,” thereby making *Knitwaves* inapposite to a case involving the admixture of original ingredients to public domain elements. Odegard Inc. v. Safavieh Carpets, Inc., 398 F. Supp. 2d 275, 280 (S.D.N.Y. 2005). [↑](#footnote-ref-840)
840. 263562 F.2d 1157 (9th Cir. 1977). [↑](#footnote-ref-841)
841. 264Disclosure should be made that this writer represented the Kroffts on appeal. [↑](#footnote-ref-842)
842. 264.1In Kamar Int’l, Inc. v. Russ Berrie & Co., 657 F.2d 1059 (9th Cir. 1981), the paragraph that follows, quoted in substantial part, is said correctly to state the *Krofft* test. See also Berkic v. Crichton, 761 F.2d 1289 (9th Cir. 1985). [↑](#footnote-ref-843)
843. 264.2562 F.2d at 1164. [↑](#footnote-ref-844)
844. 264.3*Id*. Contrary to the court’s formulation, it seems clear that two works may embody the same idea, and even the same expression, although executed in different media. See § 8.01[B] *supra*. [↑](#footnote-ref-845)
845. 264.4562 F.2d at 1164. [↑](#footnote-ref-846)
846. 264.5*Id*. at 1164. See Shaw v. Lindheim, 919 F.2d 1353, 1358 (9th Cir. 1990) (Treatise quoted). [↑](#footnote-ref-847)
847. 264.6562 F.2d at 1164. [↑](#footnote-ref-848)
848. 264.7*Id*. [↑](#footnote-ref-849)
849. 264.8*Id*. [↑](#footnote-ref-850)
850. 264.9Idea similarity *simpliciter* is inadequate to show substantial similarity. See § 13.03[B][2][a] *supra*. [↑](#footnote-ref-851)
851. 264.10562 F.2d at 1166. In applying *Krofft*, the district court must make its own determination of the intrinsic test upon plaintiff’s motion for a preliminary injunction (see § 14.06[A] *infra*) for the purpose of determining whether a trier of fact would be likely to find substantial similarity of expression. Universal City Studios, Inc. v. Film Ventures Int’l, Inc., 543 F. Supp. 1134 (C.D. Cal. 1982). [↑](#footnote-ref-852)
852. 264.11562 F.2d at 1166. [↑](#footnote-ref-853)
853. 264.12*Id*. [↑](#footnote-ref-854)
854. 264.13*Id*. at 1164. [↑](#footnote-ref-855)
855. 264.13aSee § 2A.06[A][3][a] *supra*. One court notes the view that the Ninth Circuit’s approach runs afoul of the statute. See Batiste v. Najm, 28 F. Supp. 3d 595, 602 n.13 (E.D. La. 2014), citing Pamela Samuelson, *A Fresh Look at Tests for Nonliteral Copyright Infringement*, 107 Nw. U. L. Rev. 1821, 1830, 1832 (2013). [↑](#footnote-ref-856)
856. 264.14See, *e.g.*, Twentieth Century-Fox Film Corp. v. MCA, Inc., 209 U.S.P.Q. 200 (C.D. Cal. 1980), *rev’d*, 715 F.2d 1327 (9th Cir. 1983); Columbia Pictures Indus., Inc. v. Embassy Pictures, 218 U.S.P.Q. 497 (C.D. Cal. 1982). See § 13.03[F][2][a] *infra*. [↑](#footnote-ref-857)
857. 264.15-264.19[Reserved] [↑](#footnote-ref-858)
858. 264.20As to what is meant by “expression,” see § 13.03[A][1] *supra*. [↑](#footnote-ref-859)
859. 264.21See v. Durang, 711 F.2d 141 (9th Cir. 1983). As previously noted, mere similarity in idea is nonactionable and cannot alone sustain a claim for infringement. See § 13.03[B][2][a] *supra*. [↑](#footnote-ref-860)
860. 264.22154 F.2d at 472. [↑](#footnote-ref-861)
861. 264.23One commentator states that the second prongs of *Krofft* and *Arnstein* are approximately equivalent, but that “the respective first prongs pass each other in the night, even though each speaks of dissection by experts. *Arnstein* focuses on copying versus independent production, *Krofft* on copying of ideas rather than copying of expression. They slice the infringement apple from different angles. *Krofft* virtually assumes copying and therefore is much less helpful.” Latman, “*Probative Similarity” As Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement*, 90 Colum. L. Rev. 1187, 1203 (1990). [↑](#footnote-ref-862)
862. 264.24Three of the four cases that *Arnstein* cites to illustrate “permissible copying” are examples of similarity of expression, not merely of idea. See 154 F.2d at 472 n.18, citing Oxford Book Co. v. College Entrance Book Co., 98 F.2d 688 (2d Cir. 1938) (similarity of concepts and of order of presentation amounting to a similarity of expression, excused because such concepts and order were factual); Eggers v. Sun Sales Corp., 263 F. 373 (2d Cir. 1920) (verbatim similarity of expression excused because such expression taken by plaintiff from a “public document”—see § 5.12 *supra*); Mathews Conveyer Co. v. Palmer-Bee Co., 135 F.2d 73 (6th Cir. 1943) (similarity of expression excused because the articles depicted were in the public domain and because the quantum of such similarity of expression was so small as to amount to a fair use). See § 13.03[B][2][b] *supra*. The remaining case that *Arnstein* cites, see 154 F.2d at 472 n.18, citing Dymow v. Bolton, 11 F.2d 690 (2d Cir. 1926), does appear to hold copying permissible because the similarity was only of idea and not of expression. [↑](#footnote-ref-863)
863. 264.25“We do not resurrect the *Arnstein* approach today. Rather, we formulate an extrinsic-intrinsic test for infringement based on the idea-expression dichotomy. We believe that the *Arnstein* court was doing nearly the same thing. But the fact that it may not have been does not subtract from our analysis.” 562 F.2d at 1165 n.7. [↑](#footnote-ref-864)
864. 264.26See § 13.03[E][1][b] N. 202.1 *supra*. [↑](#footnote-ref-865)
865. 264.27See § 13.03[E][1][b] *supra*. [↑](#footnote-ref-866)
866. 264.28919 F.2d 1353 (9th Cir. 1990) (Treatise cited). The opinion superseded an earlier published version by making minor corrections. See 908 F.2d 531 (9th Cir. 1990). The later *Shaw* opinion precedes *Feist* by four months. [↑](#footnote-ref-867)
867. 264.29919 F.2d at 1357. [↑](#footnote-ref-868)
868. 264.30*Id.* at 1359. [↑](#footnote-ref-869)
869. 264.31Of interest is the Ninth Circuit’s conclusion:

     Once a court has established that a triable question of objective similarity of expression exists, by analysis of each element of the extrinsic test, its inquiry should proceed no further. What remains is a subjective assessment of the concept “look and feel” of two works of literature—a task no more suitable for a judge than for a jury. This subjective assessment is not a legal conclusion; rather it involves the audience in an interactive process with the author of the work in question, and calls on us to transfer from our inward nature a human interest and a semblance of truth sufficient to procure for these shadows of imagination that willing suspension of disbelief for the moment, which constitutes poetic faith. S.T. Coleridge, *Biographia Literaria*, ch. 14. This interactive assessment is by nature an individualized one that will provoke a varied response in each juror, “for what makes the unskillful laugh, cannot but make the judicious grieve.” W. Shakespeare, *Hamlet*, Act III, scene ii, 11. 27–28.

     *Id.* at 1360. [↑](#footnote-ref-870)
870. 264.32Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1476 (9th Cir.), *cert. denied*, 513 U.S. 1044 (1992) (Treatise quoted). An example of this phenomenon predating *Brown Bag* is Morgan Creek Prods. Inc. v. Capital Cities/ABC Inc., 22 U.S.P.Q.2d 1881, 1890–92 (C.D. Cal. 1991). [↑](#footnote-ref-871)
871. 264.33In favor of that interpretation is the court’s express acknowledgement that “[w]e have frequently affirmed summary judgment in favor of copyright defendants on the issue of substantial similarity.” *Id.* at 1355. Nonetheless, the converse interpretation of *Shaw* is also arguable. The Ninth Circuit differentiated between literature and representational objects, commenting that the latter can often be well-suited to judicial analysis. *Id.* at 1360–61. As to the former, by contrast: “Because each of us differs, to some degree, in our capability to reason, imagine, and react emotionally, subjective comparisons of literary works that are objectively similar in their expression of ideas must be left to the trier of fact.” *Id.* at 1361.

     Summary judgment proponents may take comfort from the first quotation, opponents from the second. Proponents may respond that that second quote is operative only when the literary works at issue are already “objectively similar,” meaning that no subjective reaction from the trier of fact is warranted when the judge deems the two works to share no objective similarity. Opponents may then retort that *Shaw* adopted this treatise’s description of *Krofft* requiring a determination by the trier of fact. Proponents may respond that this treatise criticizes *Krofft* on that basis. And thus the argument may proceed.

     How did the Ninth Circuit itself view its reformulation of *Krofft*? The court stated that “[t]he rule we announce today … is in harmony with our prior decisions.” *Id.* at 1359. Given how cacophonous those past decisions are, it is difficult to be certain what sort of harmony is intended. See § 12.10[B][3] *supra*. [↑](#footnote-ref-872)
872. 264.34In other words, to the extent that the judge determines that a rational trier of fact could view the works as substantially similar and a different but rational trier of fact could view the works as not substantially similar, then the matter must be left to the subjective reaction of the fact-finder and cannot be resolved on summary judgment. [↑](#footnote-ref-873)
873. 264.35Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1477 (9th Cir.), *cert. denied*, 513 U.S. 1044 (1992) (Treatise quoted). [↑](#footnote-ref-874)
874. 264.36Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1475–77 (9th Cir.), *cert. denied*, 513 U.S. 1044 (1992). See Kouf v. Walt Disney Pictures & Television, 16 F.3d 1042, 1045 n.3 (9th Cir. 1994) (rejecting “contention that *Shaw* either prohibits summary judgment in copyright cases or creates a heightened standard”). [↑](#footnote-ref-875)
875. 264.37960 F.2d at 1474 n.3. See *id.* at 1478 (Sneed, J., concurring) (*Shaw* “provides a poor analytic structure by which to determine the substantial similarity of an allegedly infringing computer program”). [↑](#footnote-ref-876)
876. 264.38919 F.2d at 1360–1361. The court states that “the scope of the copyright protection afforded such works is necessarily narrow.” *Id.* at 1360. But, given that *Shaw* itself dealt with a literary work, the court did not flesh out the requisite analysis to accord narrow protection to such works depicting representational objects. By contrast, when the Supreme Court called the protection for a factual compilation “thin” in Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 349, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991), the delineation was clear, given that *Feist* itself confronted the scope of protection in such a factual compilation. See § 13.03[A][4] *supra*. [↑](#footnote-ref-877)
877. 264.3935 F.3d 1435, 1439 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995). [↑](#footnote-ref-878)
878. 264.40*Id.* at 1445. [↑](#footnote-ref-879)
879. 264.41See § 13.03[F] *infra*. [↑](#footnote-ref-880)
880. 264.4235 F.3d at 1442–1443. In that 1994 case, the Ninth Circuit proposed three steps “we find helpful to follow,” involving analytic dissection and refusing plaintiff’s repeated request that the comparison take place between the works as a whole. *Id*. [↑](#footnote-ref-881)
881. 264.43919 F.2d at 1356 (emphasis added). [↑](#footnote-ref-882)
882. 264.44See § 13.03[E][1][b] *supra*. [↑](#footnote-ref-883)
883. 264.45919 F.2d at 1356. [↑](#footnote-ref-884)
884. 264.46See § 3.04[B][1] & N. 32 *supra*. [↑](#footnote-ref-885)
885. 264.47See §§ 13.01[B], 13.03[B][2][b] *supra*. [↑](#footnote-ref-886)
886. 264.48919 F.2d at 1358, *quoting* district court order (emphasis original). [↑](#footnote-ref-887)
887. 264.49The Ninth Circuit notes that much of the similarity between the two works is the result of idea and scenes a faire. 919 F.2d at 1362–1363. Those matters can no more form the basis for liability than could similarity of facts in *Feist*. On the other hand, the circuit also notes similarity in non-stereotypic events. *Id.* at 1363. That similarity could give rise to liability under the correct standard. Further, in the context of that discussion, the court adds the following: “We find that defendants’ copying of the Equalizer character and other characters extends to elements of protected expression.” *Id*. That language, indicating an intent to hold liability, even under the appropriate legal standard, is all the more noteworthy because the Ninth Circuit—perhaps anticipating *Feist*—amended its earlier published opinion to add it. 908 F.2d 531 (9th Cir. 1990), *superseded*, 919 F.2d 1353 (9th Cir. 1990). Query whether that added language is strong enough, not only to justify the Ninth Circuit’s reversal of the district judge’s summary judgment in favor of defendants, but also to mandate entry of summary judgment against defendants. [↑](#footnote-ref-888)
888. 264.50Note that, on remand, the district court rejected the Ninth Circuit opinion as “law of the case,” cited *Feist*, and rejected plaintiff’s claim as a matter of law. Shaw v. Lindheim, 809 F. Supp. 1393, 1403 (C.D. Cal. 1992). [↑](#footnote-ref-889)
889. 264.51919 F.2d at 1360–1361. *E.g.*, Pasillas v. McDonald’s Corp., 927 F.2d 440 (9th Cir. 1991) (distinguishing *Shaw* in case involving representational object). See § 13.03[E][1][b] N. 202.19 *supra*. [↑](#footnote-ref-890)
890. 264.52Cavalier v. Random House, Inc., 297 F.3d 815, 826 (9th Cir. 2002). [↑](#footnote-ref-891)
891. 264.53See § 13.03[F] *infra*. [↑](#footnote-ref-892)
892. 264.54Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 493 (9th Cir. 1985) (citation omitted). See Haan Crafts Corp. v. Craft Masters, Inc., 683 F. Supp. 1234, 1243 (N.D. Ind. 1988) (following *Cooling Systems*). [↑](#footnote-ref-893)
893. 264.55McCulloch v. Albert E. Price, Inc., 823 F.2d 316, 321 (9th Cir. 1987) (holding *Cooling Systems* inapplicable to artistic works, and that even uncopyrightable material could be considered in evaluating substantial similarity). [↑](#footnote-ref-894)
894. 264.56Aliotti v. R. Dakin & Co., 831 F.2d 898, 901 (9th Cir. 1987), citing *McCulloch*, 823 F.2d at 320–321. [↑](#footnote-ref-895)
895. 264.57For those following the case names, the reference is to *McCulloch*’s limitation on *Cooling Systems*, both cases being cited in full above. [↑](#footnote-ref-896)
896. 264.58This view may be seen as an expansion of *Aliotti*, cited above. [↑](#footnote-ref-897)
897. 264.59855 F.2d 1446 (9th Cir. 1988). [↑](#footnote-ref-898)
898. 264.60In *Olson*, after elimination of unprotectible scenes a faire (see § 13.03[B][4] *supra*), the court did not find that no similarity remained, as in *Aliotti*, but rather that “no *substantial* similarity of protectible expression” was left. *Id*. at 1453 (emphasis added). [↑](#footnote-ref-899)
899. 264.61Data East USA, Inc., v. Epyx, Inc., 862 F.2d 204 (9th Cir. 1988). [↑](#footnote-ref-900)
900. 264.62*Id*. at 208–209. [↑](#footnote-ref-901)
901. 264.63*Id*. at 209. Also worth mention is Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995), wherein the Ninth Circuit essentially adopted the filtering test, rejecting plaintiff’s repeated requests that comparison take place between the works as a whole, rather than with an analytically dissected distillation of its work. Nonetheless, that case still does not fully discard the audience test. See § 13.03[E][3] & N. 259.9d *supra*. [↑](#footnote-ref-902)
902. 264.64Harper House, Inc. v. Thomas Nelson, Inc., 889 F.2d 197 (9th Cir. 1989). See Olson v. National Broadcasting Co., 855 F.2d 1446 (9th Cir. 1988). But cf. Cory Van Rijn, Inc., v. California Raisin Advisory Board, 697 F. Supp. 1136, 1140 (E.D. Cal. 1987) (court “not persuaded” by defendant’s filtering argument, but rules for defendant anyway under *Krofft*). [↑](#footnote-ref-903)
903. 264.64aDream Games of Ariz., Inc. v. PC Onsite, 561 F.3d 983, 988–989 (9th Cir. 2009). [↑](#footnote-ref-904)
904. 264.65See § 13.03[E][3][b][ii] *supra*. [↑](#footnote-ref-905)
905. 264.66See § 13.03[E][3][b][i] *supra*. [↑](#footnote-ref-906)
906. 264.67Overman v. Universal City Studios, 605 F. Supp. 350 (C.D. Cal. 1984), ascribes to this writer—and disagrees with—the view that *Krofft* should be read as “precluding” summary judgment on the issue of expression similarity. It is the writer’s view not that *Krofft* precludes summary judgment, but that it does limit the circumstances in which summary judgment is appropriate; nonetheless, circumstances have evolved greatly in the interim. (Note that this footnote was the subject of later-discarded discussion in an earlier version of Shaw v. Lindheim, 908 F.2d 531, 539 n.2 (9th Cir. 1990), *superseded*, 919 F.2d 1353 (9th Cir. 1990)). Later citing to the superseded *Shaw* opinion, the Ninth Circuit conceded that “[o]ur circuit has expressed a certain disfavor for summary judgment,” but nonetheless affirmed a defense summary judgment. Pasillas v. McDonald’s Corp., 927 F.2d 440, 442 (9th Cir. 1991). [↑](#footnote-ref-907)
907. 264.68See v. Durang, 711 F.2d 141, 143 (9th Cir. 1983). Similar holdings emerged in Litchfield v. Spielberg, 736 F.2d 1352 (9th Cir. 1984); Berkic v. Crichton, 761 F.2d 1289, 1292 (9th Cir. 1985) (“we have frequently affirmed summary judgments in favor of copyright defendants on the substantial similarity issue”). Note that the procedural posture applicable here is usually summary judgment for the defense; but at times the court may simply dismiss the complaint. See § 12.10[B][3] *supra*. [↑](#footnote-ref-908)
908. 264.69See § 13.03[E][3][b][ii] *supra*. [↑](#footnote-ref-909)
909. 264.70855 F.2d 1446 (9th Cir. 1988). [↑](#footnote-ref-910)
910. 264.71*Id*. at 1453. [↑](#footnote-ref-911)
911. 264.72Pasillas v. McDonald’s Corp., 927 F.2d 440 (9th Cir. 1991). See Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995); Interactive Network v. NTN Communications, 875 F. Supp. 1398, 1403 (N.D. Cal. 1995) (stating that “summary judgment is not favored on the issue of substantial similarity in copyright cases” but partially granting it anyway). [↑](#footnote-ref-912)
912. 264.73809 F. Supp. 1393, 1400, 1403 (C.D. Cal. 1992). [↑](#footnote-ref-913)
913. 264.74An example is Newton v. Diamond, 204 F. Supp. 2d 1244 (C.D. Cal. 2002), the alternative holdings of which were affirmed solely on the basis of no substantial similarity, 388 F.3d 1189 (9th Cir. 2004), *cert. denied*, 545 U.S. 1114, 125 S. Ct. 2905, 162 L. Ed. 2d 294 (2005). At issue there was a three-note segment from a longer musical composition. One judge, however, maintained that it should have been up to a jury to determine whether those notes (which, played over a lower octave, could be deemed “a total of four separate tones”) could be viewed as qualitatively significant, in the manner of the opening of Beethoven’s Fifth. *Id*. at 1198–1199 (Graber, J., dissenting). [↑](#footnote-ref-914)
914. 264.75226 F. Supp. 2d 1224 (C.D. Cal. 2002). [↑](#footnote-ref-915)
915. 264.76376 F.3d 841 (9th Cir. 2004). [↑](#footnote-ref-916)
916. 264.77The court declined to enunciate, in focusing on those elements, “a uniform set of factors to be used.” *Id*. at 849. [↑](#footnote-ref-917)
917. 264.78*Id*. at 849. [↑](#footnote-ref-918)
918. 264.79The nub of the testimony in that case was as follows:

     The expert testimony on which Swirsky relied was that of Dr. Robert Walser, chair of the Musicology Department at the University of California at Los Angeles. On the basis of his aural assessment of *One* and *Thank God*, Dr. Walser opined that the two songs had substantially similar choruses. [¶ ] Dr. Walser admitted that the lyrics and verse melodies of the two songs differed “clearly and significantly,” but stated that the two songs’ choruses shared a “basic shape and pitch emphasis” in their melodies, which were played over “highly similar basslines and chord changes, at very nearly the same tempo and in the same generic style.” Dr. Walser also noted that it was a “suspicious coincidence” that the two songs’ choruses were both sung in B-flat. Dr. Walser further testified that the choruses in both *One* and *Thank God* shared a similar structure in that measures five through seven of each chorus were “almost exactly” the same as the first three measures of each chorus.

     *Id*. at 847 (footnotes omitted). The subject comparison was based on “aural assessment” inasmuch as neither of the subject songs was “composed using sheet music.” *Id*. at 845. [↑](#footnote-ref-919)
919. 264.80This was not a technical case involving the interpretation of matter such as source code or sheet music. Instead, the district court listened to the two compositions and found them lacking substantial similarity. But plaintiff hired an expert to listen to the songs and testify otherwise. The Ninth Circuit concluded that “the plaintiff’s expert’s evidence was sufficient to present a triable issue of the extrinisic similarity of the two songs … .” *Id*. at 843. [↑](#footnote-ref-920)
920. 264.81At face value, it should not be hard for any plaintiff who has survived Rule 11 to find someone to testify, if not about the “basic shape and pitch emphasis” or “very nearly the same tempo and in the same generic style,” then at least about other comparable qualities at the same level of generality as Dr. Walser’s testimony. [↑](#footnote-ref-921)
921. 264.82Illustrative here is Funky Films, Inc. v. Time Warner Entm’t Co., 462 F.3d 1072 (9th Cir. 2006), a case involving similarity of screenplays under the extrinsic test, with no indication whether experts testified. The court engaged in its own comparison to determine that defendant’s “Six Feet Under” did not infringe plaintiff’s “The Funk Parlor.”

     Appellants equate Sophie Zemlaskas with Brenda Chenowith, both of whom are romantically involved with the older brother in each story. However, the two have little in common. Sophie, a devout and obsessive Catholic who plans to enter the convent, is a psychopathic killer. Unlike Sophie, Brenda is not homicidal. Brenda, a massage therapist, is psychologically astute and expresses no interest in religion. While Sophie expresses deep conflict over her sexuality, Brenda engages in an apparently conflict-free sexual life with Nate (and others).

     *Id*. at 1079. [↑](#footnote-ref-922)
922. 264.83Applying Ninth Circuit law, the Federal Circuit reversed a district court’s determination that the total concept and feel of defendant’s carved ornamental woodwork furniture differed from plaintiff’s. See Amini Innovation Corp. v. Anthony Cal., Inc., 439 F.3d 1365, 1370 (Fed. Cir. 2006) (“For instance, the protected design uses a unique lion’s paw with five toes; the accused design incorporates a near-copy of this whimsical device, including the anatomically incorrect presentation of the toes”). [↑](#footnote-ref-923)
923. 264.84See Scentsy, Inc. v. B.R. Chase, LLC., 942 F. Supp. 2d 1045, 1055 (D. Idaho 2013). [↑](#footnote-ref-924)
924. 264.85*Id.* at 1055. [↑](#footnote-ref-925)
925. 265Scentsy, Inc. v. Harmony Brands, LLC, 585 Fed. Appx. 621 (9th Cir. 2014). [↑](#footnote-ref-926)
926. 265.1736 F.2d 1352 (9th Cir. 1984), *cert. denied*, 470 U.S. 1052, 105 S. Ct. 1753, 84 L. Ed. 2d 817 (1985). [↑](#footnote-ref-927)
927. 265.2*Id*. at 1356. [↑](#footnote-ref-928)
928. 265.3See § 13.03[A] *supra*. [↑](#footnote-ref-929)
929. 265.4See § 13.03[E][3][a][i] *supra*. [↑](#footnote-ref-930)
930. 265.5736 F.2d at 1357. See § 13.03[A][1][c] *supra*, criticizing this test. [↑](#footnote-ref-931)
931. 265.6See, *e.g*., Porto v. Guirgis, 659 F. Supp. 2d 597 (S.D.N.Y. 2009) (rejecting claim of substantial similarity). [↑](#footnote-ref-932)
932. 265.7See, *e.g*., Stromback v. New Line Cinema, 384 F.3d 283 (6th Cir. 2004) (rejecting claim of substantial similarity); Towler v. Sayles, 76 F.3d 579 (4th Cir. 1996) (same); Muller v. Twentieth Century Fox Film Corp., 794 F. Supp. 2d 429, 444–448 (S.D.N.Y. 2011) (same). [↑](#footnote-ref-933)
933. 265.8See, *e.g*., Metcalf v. Bochco, 294 F.3d 1069 (9th Cir. 2002). [↑](#footnote-ref-934)
934. 265.9See, *e.g*., Funky Films, Inc. v. Time Warner Entm’t Co., 462 F.3d 1072 (9th Cir. 2006); Murray Hill Publ’ns, Inc. v. Twentieth Century-Fox Film Corp., 361 F.3d 312 (6th Cir.), *cert. denied*, 543 U.S. 959, 125 S. Ct. 432, 160 L. Ed. 2d 323 (2004); Cavalier v. Random House, Inc., 297 F.3d 815 (9th Cir. 2002); Kouf v. Walt Disney Pictures & Television, 16 F.3d 1042 (9th Cir. 1994); Montgomery v. Holland, 408 F. Supp. 3d 353, 375–78 (S.D.N.Y. 2019); Campbell v. Walt Disney Co., 718 F. Supp. 2d 1108, 1112–1116 (N.D. Cal. 2010); Gable v. National Broad. Co., 727 F. Supp. 2d 815, 838–848 (C.D. Cal. 2010), *aff’d unpub.*, 438 Fed. Appx. 587 (9th Cir. 2011). [↑](#footnote-ref-935)
935. 265.10Benay v. Warner Bros. Entm’t, Inc., 607 F.3d 620, 632 (9th Cir. 2010). [↑](#footnote-ref-936)
936. 265.11*Id*. at 625–629. The identify of titles was of little moment in this case, given that Saigo Takamori, the real historical figure on which both works are based, is referred to independently as “The Last Samurai.” *Id*. at 628–629. Another case ran through lack of similarity in plot, theme, mood, etc., and then thoroughly discounted *Treasure of Khan* as having been copied from *Gold of the Khan*. See Doody v. Penguin Group (USA) Inc., 673 F. Supp. 2d 1144, 1162 (D. Haw. 2009) (Treatise cited). [↑](#footnote-ref-937)
937. 265.12607 F.3d at 632. See § 19D.08[A] *infra*. [↑](#footnote-ref-938)
938. 265.12aMarcus v. ABC Signature Studios, Inc., 279 F. Supp. 3d 1056, 1066 (C.D. Cal. 2017). [↑](#footnote-ref-939)
939. 265.12b*Id.* at 1068. [↑](#footnote-ref-940)
940. 265.12c*Id.* at 1069 (teenage daughter being too busy on cell phones held “too abstract to warrant copyright protection”). [↑](#footnote-ref-941)
941. 265.12dHord v. Jackson, 281 F. Supp. 3d 417, 425 (S.D.N.Y. 2017). [↑](#footnote-ref-942)
942. 265.12e*Id.* at 427. See § 13.03[A][1][c] *supra*. [↑](#footnote-ref-943)
943. 265.12fJust because two movies share the setting of the same city, for instance, scarcely affords a basis to hold them similar. See Ricketts v. CBS Corps., 439 F. Supp. 3d 1199, 1217 (C.D. Cal. 2020). [↑](#footnote-ref-944)
944. 265.13See § 13.03[A][1][b] *supra*. [↑](#footnote-ref-945)
945. 265.13aSee Kaye v. Cartoon Network Inc., 297 F. Supp. 3d 362, 370 (S.D.N.Y. 2017). [↑](#footnote-ref-946)
946. 265.14Illustrative is a case in which the authors of screenplays dramatizing attacks by Spartans on Athenians alleged infringement by defendant’s video games that allowed players to enact wars in ancient Greece. See Bissoon-Dath v. Sony Computer Entm’t Am., Inc., 694 F. Supp. 2d 1071, 1075–1077 (N.D. Cal. 2010). The court ruled for defendant based on its holding that, after filtering out unprotected elements, “the stories’ plots are similar only at a level of abstraction that is barely meaningful, if at all.” *Id.* at 1082. Running through the *Litchfield* ingredients, though, the shared settings of Mount Olympus, Sparta, and the Underworld did establish that element for plaintiffs. *Id.* at 1086. But that circumstance did not detract from the court’s conclusion that no reasonable trier of fact could conclude that defendant’s video game was substantially similar to any of plaintiffs’ screenplays. *Id.* at 1091–1092. [↑](#footnote-ref-947)
947. 265.15See DiTocco v. Riordan, 815 F. Supp. 2d 655, 669 (S.D.N.Y. 2011), *aff’d unpub.*, 496 Fed. Appx. 126 (2d Cir. 2012) (two works showing effects of Greek mythology in modern world). Another case labeled the idea of “an African-American male who rises up from a disadvantaged past to achieve success” in the music industry “a compelling theme which has been played out both in real life and which has been prominent in many forms of artistic expression” (such as *Straight Outta Compton*). Tanksley v. Daniels, 259 F. Supp. 3d 271, 293 (E.D. Pa. 2017) *aff’d*, 902 F.3d 165, 175–77 (3d Cir. 2018), *cert. denied*, 139 S. Ct. 1175 (2019). That reasoning overlaps with scenes a faire. See § 13.03[B][4] *supra*. [↑](#footnote-ref-948)
948. 265.15aMonbo v. Nathan, 623 F. Supp. 3d 56, 89, 97–98 (E.D.N.Y. 2022) (Treatise cited as to § 13.03[A][2][a] *supra*). [↑](#footnote-ref-949)
949. 265.15b*Id.* at 94 n.18 (defining that term). [↑](#footnote-ref-950)
950. 265.15c*Id.* at 93. [↑](#footnote-ref-951)
951. 265.15d*Id.* at 90–91. [↑](#footnote-ref-952)
952. 265.16Consider a case in which both works took place in the setting of a bizarre and threatening carnival. See Wild v. NBC Universal, Inc., 788 F. Supp. 2d 1083, 1099 (C.D. Cal. 2011). The court conceded that the device of a murder suspect being saved by a disappearing carnival could favor plaintiff—except that he could not prove that both works actually contained that feature. *Id.* at 1103. [↑](#footnote-ref-953)
953. 265.17See § 13.03[E][3][b][i] *supra*. [↑](#footnote-ref-954)
954. 265.18841 F.3d 1062, 1064 (9th Cir. 2016), *cert. denied*, 138 S. Ct. 422 (2017). Disclosure should be made that this writer represented Mr. Antonick in the appellate phase of his case. [↑](#footnote-ref-955)
955. 265.19See § 8.09 *supra*. [↑](#footnote-ref-956)
956. 265.20841 F.3d at 1065. [↑](#footnote-ref-957)
957. 265.21*Id.* at 1065. Given how successful the *John Madden Football* had proved to be across the decades, those royalties amounted to millions of dollars. [↑](#footnote-ref-958)
958. 265.22*Id.* at 1065. [↑](#footnote-ref-959)
959. 265.23See Appellant’s Brief at 18–19, 45–51, *Antonick v. Electronic Arts, Inc.*, United States Court of Appeals for the Ninth Circuit, No. 14-15298 (Aug. 1, 2014). [↑](#footnote-ref-960)
960. 265.24See § 13.03[F] *infra*. [↑](#footnote-ref-961)
961. 265.25Brief *Amici Curiae* of Intellectual Property Law Professors in Support of Petitioner at 33, *Antonick v. Electronic Arts, Inc.*, Supreme Court of the United States, No. 17-168 (Sept. 1, 2017) (quoting transcript). He further embroidered, “we may have been nutty all these years.” *Id*. [↑](#footnote-ref-962)
962. 265.26841 F.3d at 1067 n.4 (citations omitted). The opinion here cites to *Altai*, in which the Second Circuit accepts expert testimony to compare computer codes—a decision in which a plurality of the circuits concur. See § 13.03[F][1][a] *infra*. [↑](#footnote-ref-963)
963. 265.26aSee Shyamkrishna Balganesh\* & Peter S. Menell, *The Use of Technical Experts in Software Copyright Cases: Rectifying the Ninth Circuit’s ‘Nutty’ Rule*, 35 Berkeley Tech. L.J. 663 (2020). Another circuit properly reversed a district court for resolving comparably technical issues without expert guidance. See RJ Control Consultants, Inc. v. Multiject, LLC, 981 F.3d 446, 458 (6th Cir. 2020) (“the assistance of an expert is desirable, if not required”). [↑](#footnote-ref-964)
964. 265.27The Copyright Act expressly grants authors the exclusive right to prepare derivative works, which includes “translation[s]” into foreign languages. 17 U.S.C § 101 (definition of “derivative work”). See § 8.09 *supra*. [↑](#footnote-ref-965)
965. 265.28Given that U.S. copyright law protects works written in any language, another cause of action could arise over the translation of a Japanese novel into Persian. Requiring both originals to be in evidence asks an American jury to compare one work composed in Kanji with another in Arabic characters—without benefit of any expert testimony. In this way, the absurdities only multiply. [↑](#footnote-ref-966)
966. 265.29The jury reached its verdict on July 23, 2013. It determined that Antonick proved substantial similarities between the Sega Madden games and Apple II Madden with respect to plays and formations, but not with respect to field width. Its special verdict also determined that Antonick proved each Sega Madden game to be virtually identical to Apple II Madden when considered as a whole. Appellant’s Brief at 19–20. It is impossible to imagine a jury reaching those determinations absent guidance of the sort afforded by the expert witness who actually testified. [↑](#footnote-ref-967)
967. 265.30841 F.3d at 1064–65. [↑](#footnote-ref-968)
968. 265.31See § 13.03[F][5] *infra*. [↑](#footnote-ref-969)
969. 265.32841 F.3d at 1066. [↑](#footnote-ref-970)
970. 265.33See § 8.14 *supra*. [↑](#footnote-ref-971)
971. 265.34See § 8.20 *supra*. [↑](#footnote-ref-972)
972. 265.35Of course, if both are available and comprehensible to a jury, there is every reason for them to be introduced. But when the works consist of binary code and source code instructions that are gibberish to a lay jury, any rationale for mandating that introduction evaporates. [↑](#footnote-ref-973)
973. 265.36See Appellant’s Reply Brief at 26–27, *Antonick v. Electronic Arts, Inc.*, United States Court of Appeals for the Ninth Circuit, No. 14-15298 (Mar. 6, 2015). [↑](#footnote-ref-974)
974. 265.37See Range Rd. Music, Inc. v. East Coast Foods, Inc., 668 F.3d 1148, 1154 (9th Cir.), *cert. denied*, 568 U.S. 824 (2012). Other aspects of that ruling are criticized below—but nothing related to the acceptance of testimony in lieu of the actual works themselves. See § 13.03[A][5] *supra*. [↑](#footnote-ref-975)
975. 265.38See UMG Recordings, Inc. v. Grande Communications Networks, LLC, 384 F. Supp. 3d 743, 761 (W.D. Tex. 2019) (rejecting argument that “to prove its case Plaintiffs would have to play every song at issue for the jury, alongside the allegedly identical copy or copies found on Grande’s customers’ computers”). [↑](#footnote-ref-976)
976. 265.39See Infogroup, Inc. v. DatabaseLLC, 956 F.3d 1063, 1067 (8th Cir. 2020) (affirming district court’s award, trimmed from jury’s award of almost $40 million). [↑](#footnote-ref-977)
977. 265.40See § 12.09[C][3] *supra.* [↑](#footnote-ref-978)
978. 265.41956 F.3d at 1067. [↑](#footnote-ref-979)
979. 265.42At issue in *Infogroup* were databases of business information. *Id.* at 1065. [↑](#footnote-ref-980)
980. 266193 F.3d 1241, 1257 (11th Cir. 1999). [↑](#footnote-ref-981)
981. 267See § 13.03[E][3][b][i] *supra*. [↑](#footnote-ref-982)
982. 268527 F.3d 1218 (11th Cir. 2008). [↑](#footnote-ref-983)
983. 268.1*Id*. at 1224 n.5. [↑](#footnote-ref-984)
984. 268.2See § 13.03[E][1][b] *supra*. [↑](#footnote-ref-985)
985. 268.3See § 13.03[E][3][a] *supra*. [↑](#footnote-ref-986)
986. 268.4See § 13.03[E][3][b] *supra*. [↑](#footnote-ref-987)
987. 268.5Intervest Constr., Inc. v. Canterbury Estate Homes, Inc., 554 F.3d 914 (11th Cir. [↑](#footnote-ref-988)
988. 268.6*Id*. at 920. [↑](#footnote-ref-989)
989. 268.7*Intervest* makes the point when characterizing that earlier case:

     Here the district court carefully compared the protectable aspects of the two floor-plans at issue, thus focusing only on the narrow arrangement and coordination of otherwise standard architectural features. At the conclusion of its analysis identifying many dissimilarities or differences in the two floor plans, the court made essentially the same ruling that we approved of in *Oravec*: “At the level of protected expression, the differences between the designs are so significant that no reasonable, properly instructed jury could find the works substantially similar.” *Oravec*, 527 F.3d at 1227.

     554 F.3d at 921. [↑](#footnote-ref-990)
990. 268.8See § 13.03[E][3][b][iv] *supra*. [↑](#footnote-ref-991)
991. 268.9See § 12.10[B][3] *supra*. [↑](#footnote-ref-992)
992. 268.10475 F.3d 1239 (11th Cir. 2007). [↑](#footnote-ref-993)
993. 268.11See §§ 13.03[B][2][a], 13.03[B][4] *supra*. [↑](#footnote-ref-994)
994. 268.12Judge Birch likewise authored the *Intervest* opinion, treated above. [↑](#footnote-ref-995)
995. 268.13475 F.3d at 1250–1251. [↑](#footnote-ref-996)
996. 268.14When the issue, by contrast, is to determine the scope of copyright protection rather than substantial similarity, *Krofft* has been held inapplicable. FASA Corp. v. Playmates Toys, Inc., 869 F. Supp. 1334, 1347 n.19, 1352–53 (N.D. Ill. 1994) (Treatise cited). [↑](#footnote-ref-997)
997. 268.15Wildlife Express Corp. v. Carol Wright Sales, Inc., 18 F.3d 502, 508–09 & n.6 (7th Cir. 1994). [↑](#footnote-ref-998)
998. 268.16See Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904 (3d Cir. 1975) (Treatise cited); Scott v. WKJG, Inc., 149 U.S.P.Q. 413 (N.D. Ind. 1966), *aff’d*, 376 F.2d 467 (7th Cir. 1967). One case recognized substantial similarity as typically reserved for the trier of fact, but granted defendant’s motion to dismiss (which it converted to summary judgment out of an abundance of caution). See Blakeman v. Walt Disney Co., 613 F. Supp. 2d 288, 305 & n.4 (E.D.N.Y. 2009) (Treatise cited). The court concluded that *all* the similarities between plaintiff’s treatment and *Swing Vote* arose out of uncopyrightable elements. *Id*. at 314–315. [↑](#footnote-ref-999)
999. 268.17See Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Coop. Prods., Inc., 479 F. Supp. 351 (N.D. Ga. 1979). [↑](#footnote-ref-1000)
1000. 268.18Hartman v. Hallmark Cards, Inc., 833 F.2d 117, 120 (8th Cir. 1987), follows *Krofft*’s rule that in applying the intrinsic test, “analytic dissection and expert testimony” are “not appropriate. Yet even applying *Hartman*, one court dismissed a complaint because “reasonable minds could not differ as to the absence of substantial similarity … .” Banker’s Promotional Mktg. Group, Inc. v. Orange, 926 F.2d 704, 705 (8th Cir. 1991). [↑](#footnote-ref-1001)
1001. 268.19Moore v. Columbia Pictures Indus., Inc., 972 F.2d 939, 945–946 (8th Cir. 1992). [↑](#footnote-ref-1002)
1002. 268.20*Id.* at 947 (Lay, J., dissenting in part) (noting that trial court did not even reach question of substantial similarity). [↑](#footnote-ref-1003)
1003. 268.21Rottlund Co. v. Pinnacle Corp., 452 F.3d 726 (8th Cir. 2006).

      Scherer distinguished the layout of Appellees’ plans from Rottlund’s plans, explaining how those differences would affect life in each unit. He engaged in comparative analysis, couched in terms of “copying.” Scherer’s testimony and accompanying demonstrative exhibits may well have been appropriate to determine whether there existed substantial similarities of ideas, but that question was not before the jury, having been earlier decided by the district court as a matter of law. Instead, Scherer’s testimony went to the substantial similarity of expression.

      *Id*. at 731. [↑](#footnote-ref-1004)
1004. 268.21aSee Humphreys & Partners Architects, L.P. v. Lessard Design, Inc., 790 F.3d 532, 538 (4th Cir. 2015). [↑](#footnote-ref-1005)
1005. 268.22Dawson v. Hinshaw Music, Inc., 905 F.2d 731 (4th Cir.), *cert. denied*, 498 U.S. 981, 111 S. Ct. 511, 112 L. Ed. 2d 523 (1990), adopted the extrinsic test from *Krofft*, albeit modifying the intrinsic test. See § 13.04[E][4] *infra*. Franklin Mint Corp. v. National Wildlife Art Exch., Inc., 575 F.2d 62 (3d Cir.), *cert. denied*, 439 U.S. 880, 99 S. Ct. 217, 58 L. Ed. 2d 193 (1978), indicated that the first issue of copying (including permissible copying) poses a question of fact that turns upon the credibility of witnesses, and therefore the finding of the trier of fact should not be disturbed unless clearly erroneous. On the second issue of impermissible copying (or “appropriation”), the appellate court was said to be “in as good a position to make a judgment as the trial court.” On that issue, *Franklin* concluded that there had been a copying only of ideas and not of expression. See § 2A.06[A][3][a] *supra*. [↑](#footnote-ref-1006)
1006. 268.23Kohus v. Mariol, 328 F.3d 848, 855 (6th Cir. 2003). See Stromback v. New Line Cinema, 384 F.3d 283, 295 (6th Cir. 2004) (when subject matter “involves a literary work aimed at a general audience, expert testimony will seldom be *necessary* to determine substantial similarity”) (emphasis original). This approach leads to the seemingly contradictory admonitions to filter out unprotectible elements and to apply the ordinary reasonable observer test. *Id*. at 297. [↑](#footnote-ref-1007)
1007. 268.24Sturdza v. United Arab Emirates, 281 F.3d 1287, 1295–1296 (D.C. Cir. 2002). [↑](#footnote-ref-1008)
1008. 268.25“The Ninth Circuit, the court of appeals with the largest case load and experience in the area of movie industry copyright infringement, has adopted an alternative two-part test.” Murray Hill Publ’ns, Inc. v. Twentieth Century-Fox Film Corp., 361 F.3d 312, 318 (6th Cir.), *cert. denied*, 543 U.S. 959, 125 S. Ct. 432, 160 L. Ed. 2d 323 (2004). [↑](#footnote-ref-1009)
1009. 268.26*Id*. Its summary is as follows:

      In this test the first step requires identifying which aspects of the artist’s work, if any, are protectible by copyright, the second involves determining whether the allegedly infringing work is substantially similar to protectible elements of the artist’s work. This test is more similar to the Ninth Circuit test than it is to the Second Circuit test. The second part of our test, and the Ninth Circuit’s intrinsic test, both address the question of whether the two works are, taken as a whole, substantially similar in look and feel to a jury. The first part of our test, and the Ninth Circuit’s extrinsic test, both require a determination of what elements of the copyrighted work are protected by the law and an exclusion of consideration of all elements that are not. [¶] However, significant differences remain in both parts. In particular, we apply a more stringent standard regarding when to allow expert testimony on the first part of the test. Also, not having adopted the eight *Kouf* factors, the first part of our test remains more free in form than the Ninth Circuit’s extrinsic test. The essence of the first step is to filter out the unoriginal, unprotectible elements through a variety of analyses.

      *Id*. at 318 (citations and quotations omitted). [↑](#footnote-ref-1010)
1010. 268.27Johnson v. Gordon, 409 F.3d 12, 18 (1st Cir. 2005). [↑](#footnote-ref-1011)
1011. 268.28*Id*. at 19 (“As is often true in musical copyright actions, each side relied heavily on its own expert.”). The court did not disapprove of the institution of experts, but noted its dissatisfaction with the over-the-top techniques employed by plaintiff’s expert “in his herculean effort to assimilate the two melodies” by combining transposition, inversion, retrograde, *etc*. *Id*. at 21. Notwithstanding the expert’s transformations to map defendant’s melody on top of plaintiff’s, the subject “two-bar segments are not identical twins or even sisters under the skin; their relationship is something more akin to that of second cousins, twice removed.” *Id*. at 22. Yet one wonders why any of that analysis was necessary, given that it was “undisputed that the two musical segments, as written, do not sound alike and would not sound alike to an ordinary listener.” *Id*. at 22 n.6 (“does not bear any audible likeness”). A pure application of the audience test would consider that last consideration dispositive, disallowing expert testimony accordingly. [↑](#footnote-ref-1012)
1012. 268.28a919 F.2d 1353 (9th Cir. 1990). See § 13.03[E][3][b][ii] *supra*. [↑](#footnote-ref-1013)
1013. 268.28bCopeland v. Bieber, 789 F.3d 484, 489 (4th Cir. 2015). [↑](#footnote-ref-1014)
1014. 268.28c*Id.* at 489, citing Universal Furniture Int’l, Inc. v. Collezione Europa USA, Inc., 618 F.3d 417 (4th Cir. 2010) (*per curiam*). Although the losing plaintiff in the later case urged that comparison under the intrinsic test be limited to original elements preceded by analytic dissection, defendants in that case pointed out that “allowing for comparison of entire works under the intrinsic prong, generally advantages rather than disadvantages copyright plaintiffs … , by broadening the grounds upon which a court may find intrinsic similarity.” 789 F.3d at 489. [↑](#footnote-ref-1015)
1015. 268.28dThe district court had dismissed the complaint on the basis that no reasonable jury could find two songs sufficiently similar to give rise to liability. *Id.* at 487. [↑](#footnote-ref-1016)
1016. 268.28eNonetheless, en route it rejected another of plaintiff’s arguments: In most cases, the Fourth Circuit gauges audience reaction as that of the general public; plaintiff urged that his was the exceptional case in which his demo should be gauged instead by the metric of “industry professionals.” *Id.* at 490. But those music industry insiders took their cue from how they thought the general public would hear the songs in question. *Id.* at 491 (there “is a reason that the [governing] formulation uses the word ‘audience,’ rather than ‘buyer’ or ‘recipient’ ”). His appeal on that basis therefore failed. [↑](#footnote-ref-1017)
1017. 268.28f*Id.* at 491–92. [↑](#footnote-ref-1018)
1018. 268.28g*Id.* at 492. [↑](#footnote-ref-1019)
1019. 268.28h*Id.* at 492. [↑](#footnote-ref-1020)
1020. 268.28iThe court noted that

      if a difference in genre were enough by itself to preclude intrinsic similarity, then nothing would prevent someone from translating, say, the Beatles’ songbook into a different genre, and then profiting from an unlicensed reggae or heavy metal version of “Hey Jude” on the ground that it is different in “concept and feel” than the original.

      *Id.* at 493. [↑](#footnote-ref-1021)
1021. 268.28jA summary is set forth in the opinion, culminating with the observation:

      the songs’ verses feature different vocal melodies and beats as well as different lyrical content, with the Copeland verses lamenting the end of a relationship gone sour and the Bieber and Usher verses conveying the hope and optimism of the start of a relationship with an unidentified love interest.

      *Id.* at 493 (footnote omitted). [↑](#footnote-ref-1022)
1022. 268.28k*Id.* at 494.

      It is the chorus—often termed the “hook,” in recognition of its power to keep a listener coming back for more—that many listeners will recognize immediately or hear in their minds when a song title is mentioned. As the part of a song that is most often repeated and remembered, a chorus hook is important not only aesthetically but also commercially, where it may be central to a song’s economic success.

      *Id.* [↑](#footnote-ref-1023)
1023. 268.28l*Id.* at 494. The case thus concluded, “After listening to the Copeland song and the Bieber and Usher songs as wholes, we conclude that their choruses are similar enough and also significant enough that a reasonable jury could find the songs intrinsically similar.” *Id.* [↑](#footnote-ref-1024)
1024. 268.28m*Id.* at 495. [↑](#footnote-ref-1025)
1025. 268.28n*Id.* at 495. Another case, also against Usher, fared more poorly—the court determined that there was no similarity at all in the music and insufficient similarity of lyrics to qualify as substantial. See Edwards v. Raymond, 22 F. Supp. 3d 293, 300–01 (S.D.N.Y. 2014). Along with his success, Usher Raymond has become a lightning rod for copyright litigation. See Marino v. Usher, 22 F. Supp. 3d 437 (E.D. Pa. 2014). [↑](#footnote-ref-1026)
1026. 268.28oSee Batiste v. Najm, 28 F. Supp. 3d 595 (E.D. La. 2014). It characterizes the “total concept and feel” line of cases (see § 13.03[A][1][c] *supra*) by positing that, in nearly all, “the reader can sense a strong conviction that the plaintiff’s creative work was flagrantly pirated.” *Id.* at 608. [↑](#footnote-ref-1027)
1027. 268.28p*Id.* at 597–98. [↑](#footnote-ref-1028)
1028. 268.28qThe opinion’s preferred way to proceed was: “a dissection and ‘filtering’ of unprotectable constituent elements … followed by a side-by-side comparison using the ‘layperson’ standard … .” *Id.* at 610. [↑](#footnote-ref-1029)
1029. 268.28r*Id.* at 612. [↑](#footnote-ref-1030)
1030. 268.28sIn summary form,

      the Court has conducted a side-by-side listening comparison of each of the plaintiff’s songs and the song that allegedly infringes it. In doing so, the Court compared each pair of songs (the allegedly infringed song vs. the allegedly infringing song) by assessing both (1) whether there is similarity between any protectable element allegedly infringed and the element of the Defendant’s song that allegedly infringed it; and (2) whether there is any similarity between the “total concept and feel” of the plaintiff’s song (or part thereof) and the “total concept and feel” of the allegedly infringing song, including any similarity that might be enhanced or derived from an unprotectable element. These approaches produced identical results except as to “Blues Man” (allegedly infringed by T-Pain’s “Reggae Night”), which discrepancy the Court resolved in the plaintiff’s favor.

      *Id.* at 612. [↑](#footnote-ref-1031)
1031. 268.28t*Id.* at 612. As just quoted, the sole exception was “Blues Man.” As to that composition,

      the “total concept and feel” of “Blues Man” and “Reggae Night” are not at all similar. However, a reasonable juror might be able to find a substantial similarity under a “dissection” approach. Thus, given … that substantial similarity necessitates only that parts of a work be similar (provided the similar parts are sufficiently qualitatively and/or quantitatively important), the Court will nonetheless deny summary judgment at this juncture as to the “Blues Man” claim, as well.

      *Id.* at 612. [↑](#footnote-ref-1032)
1032. 268.28uKatherine Lippman, *The Beginning of the End: Preliminary Results of an Empirical Study of Copyright Substantial Similarity Opinions in the U.S. Circuit Courts*, 2013 Mich. St. L. Rev. 513, 563 (2013) (footnotes omitted). [↑](#footnote-ref-1033)
1033. 268.29See § 13.03[E][3][a][i] *supra*. [↑](#footnote-ref-1034)
1034. 268.30Matthews v. Freedman, 157 F.3d 25, 27 & n.1 (1st Cir. 1998) (Treatise cited). See Atari, Inc. v. Amusement World, Inc., 547 F. Supp. 222 (D. Md. 1981) (“even [*Krofft*] implicitly recognized the reality that the finder of fact must in effect make a detailed comparison of the two works in order to reach a general, subjective conclusion regarding substantial similarity.”); Midway Mfg. Co. v. Bandai-Am., Inc., 546 F. Supp. 125 (D.N.J. 1982) (expert testimony admissible for this purpose); Davis v. United Artists, Inc., 547 F. Supp. 722 (S.D.N.Y. 1982) (expert testimony excluded for this purpose, but comparison by dissection permitted). [↑](#footnote-ref-1035)
1035. 268.30aReal View, LLC v. 20-20 Techs, Inc., 683 F. Supp. 2d 147, 151 (D. Mass. 2010) (Treatise quoted). [↑](#footnote-ref-1036)
1036. 268.31T-Peg, Inc. v. Vermont Timber Works, Inc., 459 F.3d 97, 116 (1st Cir. 2006) (Treatise quoted) (leaving to district court whether expert testimony would be helpful on this issue). Cf. National Broadcasting Co. v. Sonneborn, 630 F. Supp. 524, 528 (D. Conn. 1985) (“This case demonstrates how technology has made some traditional categories of copyright law anachronistic. It also demonstrates that occasionally it is still necessary to apply those categories to cases brought under the new copyright laws, laws that were designed to rehabilitate those time-worn categories.”) [↑](#footnote-ref-1037)
1037. 268.32On the protectability of computer programs, see § 2A.10[B][1] *supra*. On limitation of reproduction right for computer programs, see § 8.08 *supra*. [↑](#footnote-ref-1038)
1038. 268.33See Pinheiro & Lacroix, *Protecting the “Look and Feel” of* *Computer Software,* 1 High Tech. L.J. 411, 442–443 (1986); Note, *Defining the Scope of Copyright Protection for Computer Software,* 38 Stan. L. Rev. 497, 514 (1986). On the definition of object code, see § 13.03[F] N.271 *infra*. See also Note, *Copyright Infringement Actions: The Proper Role for Audience Reactions in Determining Substantial Similarity,* 54 S. Cal. L. Rev. 385 (1981). [↑](#footnote-ref-1039)
1039. 268.34Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc., 797 F.2d 1222, 1232 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031, 107 S. Ct. 877, 93 L. Ed. 2d 831 (1987). See Clapes, Lynch & Steinberg, *Silicon Epics and Binary Bards: Determining the Proper Scope of Copyright Protection for Computer Programs*, 34 UCLA L. Rev. 1493, 1571 (Nimmer Symposium, 1987). [↑](#footnote-ref-1040)
1040. 268.35One court, after granting defendant’s motion to strike the testimony of plaintiff’s lone designated expert witness (for failure to submit a timely report), granted summary judgment against plaintiff on the grounds that he could no longer possibly prove his case. See Pepper v. International Gaming Sys., LLC, 312 F. Supp. 2d 853, 861 (N.D. Miss. 2004). [↑](#footnote-ref-1041)
1041. 268.36To perform such a comparison, access to the plaintiff’s source code can be most valuable. See Dynamic Microprocessor Assocs. v. EKD Computer Sales, 919 F. Supp. 101 (E.D.N.Y. 1996) (order to turn over source code subject to protective order). [↑](#footnote-ref-1042)
1042. 269See Plains Cotton Coop. Assoc. v. Goodpasture Computer Serv., Inc., 807 F.2d 1256, 1259 (5th Cir. 1987)*, reh’g denied,* 813 F.2d 407 (5th Cir. 1987) (*en banc*), *cert. denied,* 484 U.S. 821, 108 S. Ct. 80, 98 L. Ed. 2d 42 (1987); Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 835 (10th Cir. 1993); E.F. Johnson Co. v. Uniden Corp. of Am., 623 F. Supp. 1485, 1493 (D. Minn. 1985); Q-Co Indus., Inc. v. Hoffman, 625 F. Supp. 608, 610, 613 (S.D.N.Y. 1985); Pearl Sys., Inc., v. Competition Elecs., Inc., 1988 Copyright L. Dec. (CCH) ¶ 26,338, 8 U.S.P.Q. 2d 1520 (S.D. Fla. 1988); NEC Corp., v. Intel Corp., 1989 Copyright L. Dec. (CCH) ¶ 26,379, 10 U.S.P.Q. 2d 1177 (N.D. Cal. 1989); Williams v. Arndt, 626 F. Supp. 571, 580–581 (D. Mass. 1985). Cf. Baxter v. MCA, Inc., 812 F.2d 421, 423 n.2 (9th Cir.), *cert. denied,* 484 U.S. 954, 108 S. Ct. 346, 98 L. Ed. 2d 372 (1987) (declining to consider plaintiff’s argument that “lay audience” test is inapplicable to the technical field of music). See also § 13.03[E][2] N. 224 *supra*. [↑](#footnote-ref-1043)
1043. 270Broderbund Software, Inc. v. Unison World, Inc., 648 F. Supp. 1127, 1136–1137 (N.D. Cal. 1986), questions the applicability of the audience test to computer programs, but feels constrained to follow *Krofft*. Nonetheless, after *Broderbund*, the Ninth Circuit has started to retreat from its disallowance of dissection under the intrinsic test of *Krofft*. See § 12.10[B][3] *supra.* In particular, Brown Bag Software v. Symantec Corp., 960 F.2d 1465 (9th Cir.), *cert. denied*, 506 U.S. 869, 113 S. Ct. 198, 121 L. Ed. 2d 141 (1992), signals potential abandonment of the audience test. *Id*. at 1476 n.4 (Ninth Circuit law moving toward uniform admissibility of lay and expert testimony). See *Id*. at 1478 (Sneed, J., concurring), *citing Broderbund*. [↑](#footnote-ref-1044)
1044. 270.1Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 713 (2d Cir. 1992). [↑](#footnote-ref-1045)
1045. 270.2*Id.* (Treatise cited). See § 12.10[B][3] N. 86 *supra* (filtration issue for judge, not jury). [↑](#footnote-ref-1046)
1046. 270.3Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 713–714 (2d Cir. 1992). [↑](#footnote-ref-1047)
1047. 270.4Dawson v. Hinshaw Music, Inc., 905 F.2d 731, 735 (4th Cir.), *cert. denied*, 498 U.S. 981, 107 S. Ct. 877, 93 L. Ed. 2d 831 (1990) (“As *Whelan* reveals, only a reckless indifference to common sense would lead a court to embrace a doctrine that requires a copyright case to turn on the opinion of someone who is ignorant of the relevant differences and similarities between two works.”) See Gates Rubber Co. v. Bando Am., Inc., 798 F. Supp. 1499, 1513 (D. Colo. 1992) (following *Dawson*), *vacated in part,* 9 F.3d 823 (10th Cir. 1993). [↑](#footnote-ref-1048)
1048. 270.5See § 13.03[E][3] *supra*. [↑](#footnote-ref-1049)
1049. 270.6905 F.2d at 736. See *id*. at 737 (“We believe that, especially given the explicitness of our holding, ‘intended audience’ should supplant ‘ordinary observer’ as the label for the appropriate test.”) [↑](#footnote-ref-1050)
1050. 270.7*Id*. at 737. [↑](#footnote-ref-1051)
1051. 270.8In *Dawson*, plaintiff’s copyright covered the arrangement of a spiritual. At a bench trial, plaintiff’s expert convincingly demonstrated substantial similarity between plaintiff’s work and defendant’s arrangement of the same song. However, plaintiff did not offer any basis for applying the second prong, geared at “the ordinary *lay* observer,” *id*. at 733 (emphasis original), inasmuch as plaintiff submitted only sheet music into evidence, not recordings, *id*. Given that the judge was unable to read sheet music, he held for defendant on the lay observer standard; thus, the whole substantial similarity discussion might have been avoided had either of the parties brought a cassette tape and recorder to the courthouse. But another court rejected testimony by a musical expert, because it lacked “material that might have helped to gauge the response of the *lay* listener” to the songs at issue. Repp v. Lloyd Webber, 892 F. Supp. 552, 558 (S.D.N.Y. 1995) (emphasis added). The Second Circuit had a different perspective on musicologists in a later appeal arising out of this case. 132 F.3d 882 (2d Cir. 1997), *cert. denied,* 525 U.S. 815, 119 S. Ct. 52, 142 L. Ed. 2d 40 (1999), discussed in § 12.10[B][2][a] *supra.* [↑](#footnote-ref-1052)
1052. 270.9The court remanded for factfinding, given its speculation that “[i]t is quite possible that spiritual arrangements are purchased primarily by choral directors who possess specialized expertise relevant to their selection of one arrangement instead of another.” 905 F.2d at 737. [↑](#footnote-ref-1053)
1053. 270.10Altera Corp. v. Clear Logic, Inc., 424 F.3d 1079, 1093 (9th Cir. 2005) (Rymer, J., concurring) (“I salute the district court and the parties for having held a tutorial on the technology. It was undoubtedly valuable to the district judge.”). [↑](#footnote-ref-1054)
1054. 270.11See Chap. 8A *supra*. [↑](#footnote-ref-1055)
1055. 270.12*Id*. (“The only problem is, it was unreported … and thus, it was unavailable to assist us.”) [↑](#footnote-ref-1056)
1056. 270.13See, *e.g.*, Lotus Dev. Corp. v. Paperback Software Int’l, 740 F. Supp. 37, 68 (D. Mass. 1990); Lotus Dev. Corp. v. Borland Int’l, Inc., 49 F.3d 807, 812 (1st Cir. 1995)*, aff’d,* 516 U.S. 233, 116 S. Ct. 804, 133 L. Ed. 2d 610 (1996). See Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1472 (9th Cir.), *cert. denied*, 506 U.S. 869, 113 S. Ct. 198, 121 L. Ed. 2d 141 (1992). [↑](#footnote-ref-1057)
1057. 270.14See § 13.01[B] *supra*. [↑](#footnote-ref-1058)
1058. 270.15Indyne, Inc. v. Abacus Tech. Corp., 876 F. Supp. 2d 1278, 1285 (M.D. Fla. 2012) (Treatise quoted), *aff’d unpub.*, 513 Fed. Appx. 858 (11th Cir. 2013). [↑](#footnote-ref-1059)
1059. 271Computer programs are initially written in a “source code,” which is a symbolic language, often using English words and common mathematical symbols, that humans can read. The source code is then translated, through a mechanical process known as compilation or assembly, into “object code,” which is a concatenation of 1s and 0s readable by computer. Although a skilled programmer can read and understand small sections of object code, it is virtually impossible to develop a working understanding of a program by examining only its object code. As a result, most commercial programs are sold only in object code form, and can be run only “as is” by the ordinary user. Bateman v. Mnemonics, Inc., 79 F.3d 1532, 1539 n.17 (11th Cir. 1996) (Treatise quoted). See E.F. Johnson Co. v. Uniden Corp., 623 F. Supp. 1485, 1488 (D. Minn. 1985).

      The skilled programmer, however, may reverse engineer the program by using the techniques of “decompilation” and “disassembly” to work backwards from object code and to produce a facsimile of the original source code. Although decompilation techniques generally will not yield a perfect copy of the original source code, decompilation can afford an understanding of much of the structure and operation of a program. Bateman v. Mnemonics, Inc., 79 F.3d 1532, 1539 n.18 (11th Cir. 1996) (Treatise quoted). On the propriety of such reverse engineering, see § 13.05[D][4] *infra.* [↑](#footnote-ref-1060)
1060. 272When a particular program becomes popular, users become accustomed to a certain structure and set of features and may expect similar features and nomenclature from newer programs designed to perform the same function. User attachment to the particular way a popular program functions has spawned a segment of the software industry devoted almost exclusively to “cloning” existing programs—independently producing less expensive look-alike and work-alike versions of popular programs. See, *e.g.,* Digital Communications Assocs. v. Softklone Distrib. Corp., 659 F. Supp. 449, 452–453 (N.D. Ga. 1987); Lotus Dev. Corp. v. Paperback Software Int’l, 740 F. Supp. 37, 69 (D. Mass. 1990). [↑](#footnote-ref-1061)
1061. 273Real View, LLC v. 20-20 Techs, Inc., 683 F. Supp. 2d 147, 151 (D. Mass. 2010) (Treatise quoted). See Q-Co Indus., Inc. v. Hoffman, 625 F. Supp. 608, 610 (S.D.N.Y. 1985) (“The challenge to counsel to make comprehensible for the court the esoterica of bytes and modules is daunting.”) [↑](#footnote-ref-1062)
1062. 274See Apple Computer v. Franklin Computer Corp., 714 F.2d 1240 (3d Cir. 1983)*, cert. denied,* 464 U.S. 1033, 104 S. Ct. 690, 79 L. Ed. 2d 158 (1984) (literal copying of object code in ROMs is infringement). [↑](#footnote-ref-1063)
1063. 275See § 13.03[A][1][d] *supra*, discussing structure, sequence, and organization as tests to determine substantial similarity. The problem is heightened by the fact that computer programs can span various categories of protectible works. See Chap. 2 *supra*. For example, in Digital Communications Assoc., Inc. v. Softklone Distrib. Corp., 659 F. Supp. 449 (N.D. Ga. 1987), the subject computer work was protected as a literary work, an audiovisual work, and a compilation. [↑](#footnote-ref-1064)
1064. 276See N. 272 *supra*. Computer programs run the gamut from operating systems understandable only to computer experts to simple applications designed for the layman. See § 2A.10[B] *supra*. [↑](#footnote-ref-1065)
1065. 277Similarities in user interface are frequently categorized under the rubric “look and feel.” See, *e.g.*, Lotus Dev. Corp. v. Paperback Software Int’l, 740 F. Supp. 37, 62 (D. Mass. 1990); Pinheiro & Lacroix, *Protecting the “Look and Feel” of* *Computer Software,* 1 High Tech. L.J. 411, 430–439 (1986). That formula is a bastardization of the copyright label of “total concept and feel.” See § 13.03[A][1][c] *supra*. [↑](#footnote-ref-1066)
1066. 278The considerations that follow draw in large part from the jurisprudence of substantial similarity that has arisen from nontechnical applications. See §§ 13.03[A]–13.03[E] *supra*. Therefore, the following considerations are by no means automatically *in* applicable to infringement cases involving the traditional categories of copyrighted works, such as books, music, art, etc. [↑](#footnote-ref-1067)
1067. 279The balance of this section is drawn largely from Nimmer, Bernacchi, & Frischling, *A Structured Approach to Analyzing the Substantial Similarity of Computer Software in Copyright Infringement Cases,* 20 Ariz. St. L.J. 625 (1988). [↑](#footnote-ref-1068)
1068. 280Indyne, Inc. v. Abacus Tech. Corp., 876 F. Supp. 2d 1278, 1285–1286 (M.D. Fla. 2012) (Treatise quoted), *aff’d unpub.*, 513 Fed. Appx. 858 (11th Cir. 2013). See Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 103 (2d Cir. 1951). See generally § 13.03[B][2] *supra*. [↑](#footnote-ref-1069)
1069. 280.1Because, as stated at the outset, copying itself is often conceded in software infringement actions, the matter at issue here is actionable similarity, rather than copying as a factual matter. See § 13.01[B] *supra.* To the extent that the factual issue is presented, filtration may not be the optimal method of determining probative similarity. “We suggest that a court will often be assisted in determining the factual issue of copying if both programs are first compared in their entirety without filtering out the unprotected elements. [A]n initial holistic comparison may reveal a pattern of copying that is not obvious when only certain components are examined.” Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 832 n.7, 841 (10th Cir. 1993). See N. 318.6 *infra.* [↑](#footnote-ref-1070)
1070. 281ABC Corp. I v. P’ship & Unincorporated Ass’ns Identified on Schedule A, 52 F.4th 934, 942 (Fed. Cir. 2022) (Treatise quoted); CMM Cable Rep, Inc. v. Ocean Coast Properties, Inc., 97 F.3d 1504, 1514 (1st Cir. 1996) (Treatise quoted); Autoskill Inc. v. National Educ. Support Sys., Inc., 994 F.2d 1476, 1491 (10th Cir.), *cert. denied*, 510 U.S. 916, 114 S. Ct. 307, 126 L. Ed. 2d 254 (1993) (Treatise quoted); Vasquez v. Ybarra, 150 F. Supp. 2d 1157, 1167–1168 (D. Kan. 2001) (Treatise quoted); Hoehling v. Universal City Studios, 618 F.2d 972, 977 (2d Cir. 1980) (“Ordinarily, wrongful appropriation is shown by proving a ‘substantial similarity’ of *copyrightable* expression”) (emphasis original); Narell v. Freeman, 872 F.2d 907, 910 (9th Cir. 1989) (“The underlying question is whether *protected* elements of Narell’s book were copied.”) (emphasis original). [↑](#footnote-ref-1071)
1071. 282The evidentiary point arises: Can a computer program’s contents be inferred from the screen output that it generates. As a matter of passing the low threshold of relevance under the federal rules, perhaps screen outputs should be admissible. See Whelan Assocs. v. Jaslow Dental Lab., 797 F.2d 1222, 1244 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031, 107 S. Ct. 877, 93 L. Ed. 2d 831 (1987) (“Insofar as everything that a computer does, including its screen outputs, is related to the program that creates it, there is necessarily a causal relationship between the program and the screen outputs.”). Nonetheless, as a matter of demonstrating substantial similarity of the programs themselves, screen output alone is insufficiently probative. Two wholly different programs can generate the same screen output, just as two wholly different motion pictures may each synchronize the same song. And just as song similarity alone cannot demonstrate similarity of the audiovisual work as a whole, so like screen output cannot prove two sets of source code alike. Therefore, in terms of the issue here under discussion—similarity of two computer programs—demonstrating similar screen output is inadequate. See Manufacturers Technologies, Inc., v. Cams, Inc., 706 F. Supp. 984, 993 (D. Conn. 1989) (demonstrating similarity in program elements rather than screens termed “difficult, if not insurmountable” task).

      Still, to the extent that the defendant has copied the plaintiff’s screens, relief does lie in a cause of action other than the one here under discussion. In those instances, the owner of the program, as owner of all elements contained therein, may file suit for infringement of the graphic or audiovisual elements contained in the screen display, just as a motion picture producer who owns the song synchronized on the film’s soundtrack could file suit for a musical infringement in appropriate circumstances. See Manufacturers Technologies, Inc. v. Cams, Inc., 706 F. Supp. 984 (D. Conn. 1989). However, to the extent that the software proprietor has merely a nonexclusive license in the screen output, like a movie producer who does not own the subject song, then such an action will not lie. See § 7.18[C][3] *supra*. [↑](#footnote-ref-1072)
1072. 283SAS Inst., Inc. v. World Programming Ltd., 64 F.4th 1319, 1331 (Fed. Cir. 2023) (Treatise quoted). See Farmers Indep. Tel. Co. v. Thorman, 648 F. Supp. 457, 460 (W.D. Wis. 1986) (“only the elements of a work that are protected by copyright cannot be appropriated”). [↑](#footnote-ref-1073)
1073. 283.1The sequence of steps set forth below is flexible; those tests may be applied in any order. After each is completed, remaining similarities should be compared and evaluated. [↑](#footnote-ref-1074)
1074. 283.2982 F.2d 693 (2d Cir. 1992). The fact pattern of this case is discussed in § 13.03[F][1][c] *infra.* Note that this approach is not intended as a straight-jacket despite future technological developments. See § 13.03[A][1][d] N. 84.4 *supra.* [↑](#footnote-ref-1075)
1075. 283.3“Professor Nimmer suggests, and we endorse, a ‘successive filtering method’ for separating protectible expression from non-protectible material.” *Id.* at 707. That opinion affirms the decision below, which similarly held: “Professor Nimmer’s suggestion is helpful. The abstractions test not only has the endorsement of one of the most distinguished judicial writers on copyright law; it is also the law of this circuit.” 775 F. Supp. 544, 560 (E.D.N.Y. 1991). [↑](#footnote-ref-1076)
1076. 283.4“Once a court has sifted out all elements of the allegedly infringed program that are ‘ideas’ or are dictated by efficiency or external factors, or taken from the public domain, there may remain a core of protectible expression. In terms of a work’s copyright value, this is the golden nugget.” 982 F.2d at 710. [↑](#footnote-ref-1077)
1077. 283.5*Id.* at 706–712. [↑](#footnote-ref-1078)
1078. 283.6“Subsequent” is a relative term, given the unusual publication sequence of the *Altai* opinion. Several of the cases that cite it (see N. 283.8 *infra*) appear many volumes earlier in the official reports than does *Altai* itself. The reason is that on June 22, 1992, the Second Circuit initially released its complete affirmance of the district court decision. Thereafter, plaintiff petitioned for reconsideration. On December 22, 1992, the Court of Appeals reaffirmed its decision of the substantial similarity matters discussed herein. 982 F.2d 693 (2d Cir. 1992). Other decisions handed down during the latter half of 1992 accordingly cite to the earlier version of the *Altai* opinion.

      When the Second Circuit issued its amended opinion, it altered its conclusion regarding the other issue on appeal, copyright pre-emption of plaintiff’s trade secret claim. Initially, the district court denied the pre-emption defense. Following reassignment to a new judge, the district court dismissed the trade secret claim as pre-empted. 982 F.2d at 715–716. The Second Circuit initially affirmed on all bases; its amended opinion, by contrast, reverses dismissal of the trade secret count. *Id.* at 717–721. One judge would have adhered to the panel’s initial pre-emption determination. *Id.* at 721 (Altimari, J., concurring in part and dissenting in part).

      Subsequent litigation mushroomed between the parties—the Second Circuit certified a question of trade secret law to the Supreme Court of Texas; the plaintiff filed a separate suit against the defendant in France; and the case traveled back up to the circuit several more times. Computer Assocs. Int’l v. Altai, Inc., 126 F.3d 365 (2d Cir. 1997), *cert. denied,* 523 U.S. 1106 (1998). [↑](#footnote-ref-1079)
1079. 283.7In addition, some decisions predating *Altai* pursued the same approach. See, *e.g.,* Autoskill, Inc. v. National Educ. Support Sys., Inc., 793 F. Supp. 1557, 1565–1571 (D.N.M. 1992), *aff’d,* 994 F.2d 1476 (10th Cir.), *cert. denied*, 510 U.S. 916 (1993). See also Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1475–1476 & n.4 (9th Cir.), *cert. denied*, 506 U.S. 869 (1992). [↑](#footnote-ref-1080)
1080. 283.8See, *e.g.,* Atari Games Corp. v. Nintendo of Am. Inc., 975 F.2d 832, 839 (Fed. Cir. 1992) (citing *Altai,* “the court must next filter the unprotectible components from the protectible expression”); Sega Enters. Ltd. v. Accolade, Inc., 977 F.2d 1510, 1525 (9th Cir. 1992) (“the Second Circuit’s approach is an appropriate one”); Altera Corp. v. Clear Logic, Inc., 424 F.3d 1079, 1085 (9th Cir. 2005) (Treatise cited in context of determining infringement of mask works, see Chap. 8A *supra*); Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 834 (10th Cir. 1993); Engineering Dynamics, Inc. v. Structural Software, Inc., 26 F.3d 1335, 1342, 1343 (5th Cir. 1994) (Treatise cited) (with *caveat* about case-specific adjudication, “we adopt the *Gates Rubber*/*Altai*/Nimmer method”), *reh’g denied*, 46 F.3d 408, 409 (5th Cir. 1995); Bateman v. Mnemonics, Inc., 79 F.3d 1532, 1543 n.24, 1544 (11th Cir. 1996) (“any reference in this opinion to the “Nimmer test” is to be understood as a reference to the *Altai* version of the Nimmer test”); Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435, 1445 (9th Cir. 1994) (“same process of analytical dissection” albeit “articulated differently” from *Altai*), *cert. denied*, 513 U.S. 1184 (1995); CMAX/Cleveland, Inc. v. UCR, Inc., 804 F. Supp. 337, 353 (M.D. Ga. 1992). See ILOG, Inc. v. Bell Logic, LLC, 181 F. Supp. 2d 3, 10 (D. Mass. 2002) (Treatise cited); Comprehensive Technologies Int’l, Inc. v. Software Artisans, Inc., 3 F.3d 730, 734–735 (4th Cir. 1993) (plaintiff failed to show liability under *Altai, Whelan,* or other theories).

      In addition, the Federal Circuit, applying Ninth Circuit law, has applied this test. See Oracle Am., Inc. v. Google Inc., 750 F.3d 1339, 1357 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 2887 (2015). That opinion cryptically adds that the “distinction between literal and non-literal aspects of a computer program is separate from the distinction between literal and non-literal copying.” *Id.* at 1356. [↑](#footnote-ref-1081)
1081. 283.9The Third Circuit, for instance, has not disavowed its *Whalen* decision. See § 13.03[E][A][1][d] *supra*. But see § 13.03[F][1][a] N. 300.1 *infra*. [↑](#footnote-ref-1082)
1082. 283.10See Maddog Software, Inc. v. Sklader, 382 F. Supp. 2d 268, 278 (D.N.H. 2005) (Treatise cited), following the filtration test, even though the First Circuit’s *Lotus* decision (see N. 283.11 *infra*) does not ineluctably mandate it. [↑](#footnote-ref-1083)
1083. 283.11See *Autoskill*, N. 283.7 *supra*. [↑](#footnote-ref-1084)
1084. 283.11aSee CSS, Inc. v. Herrington, 306 F. Supp. 3d 857, 870–75 (S.D.W. Va. 2018); *Altai*, § 13.03[F][5] N. 347 *infra*. [↑](#footnote-ref-1085)
1085. 283.12Mitel, Inc. v. Iqtel, Inc., 124 F.3d 1366, 1373 (10th Cir. 1997). [↑](#footnote-ref-1086)
1086. 283.13See Paycom Payroll, LLC v. Richison, 758 F.3d 1198, 1206 (10th Cir. 2014). [↑](#footnote-ref-1087)
1087. 283.14TransWestern Pub. Co. LP v. Multimedia Marketing Assocs., Inc., 133 F.3d 773, 777 (10th Cir. 1998). [↑](#footnote-ref-1088)
1088. 283.15See Savant Homes, Inc. v. Collins, 809 F.3d 1133, 1144–45 (10th Cir. 2016). [↑](#footnote-ref-1089)
1089. 283.16Lotus Dev. Corp. v. Borland Int’l, Inc., 799 F. Supp. 203, 211–13 (D. Mass. 1992), compared its approach to *Altai*’s, and characterized it as “compatible substantively though different in methodology.” Reversing on appeal, the court stated that “[w]hile the *Altai* test may provide a useful framework for assessing the alleged nonliteral copying of computer code, we find it to be of little help in assessing whether the literal copying of a menu command hierarchy constitutes copyright infringement.” 49 F.3d 807, 814–15 (1st Cir. 1995) (Treatise cited)*, aff’d,* 516 U.S. 233 (1995). See MiTek Holdings, Inc. v. Arce Eng’g Co., 89 F.3d 1548, 1555 n.16 (11th Cir. 1996) (distinguishing between nonliteral copying and nonliteral elements that may be subject of copying). [↑](#footnote-ref-1090)
1090. 283.17The Supreme Court’s grant of *certiorari* in Lotus v. Borland (see N. 283.11 *supra*) raised hopes that we would receive definitive guidance in this arena. But its summary resolution, one week after oral argument, dashed those hopes. [↑](#footnote-ref-1091)
1091. 283.18Nola Spice Designs, L.L.C. v. Haydel Enters., Inc., 783 F.3d 527, 550 n.6, 552 (5th Cir. 2015) (Treatise quoted) (no reasonable jury could find substantial similarity to plaintiff’s Mardi Gras Bead Dog based on defendant’s expression of the dog’s collar). [↑](#footnote-ref-1092)
1092. 283.19“One prominent copyright scholar has called for the application of this test to all copyright cases.” Churchill Livingstone, Inc. v. Williams & Wilkins, 949 F. Supp. 1045, 1050 & n.4 (S.D.N.Y. 1996) (Treatise cited) (performing test on rival embryology textbooks proves “a tedious but not a particularly complex task”); R. Ready Prods., Inc. v. Cantrell, 85 F. Supp. 2d 672, 683 n.10 (S.D. Tex. 2000) (Treatise cited). See Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435, 1439, 1446 (9th Cir. 1994) (“the unprotectable elements have to be … filtered, before the works can be considered as a whole” even when dealing with “a claim of copying a computer program’s artistic look as an audiovisual work instead of program codes registered as a literary work”), *cert. denied*, 513 U.S. 1184 (1995). [↑](#footnote-ref-1093)
1093. 283.20499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). [↑](#footnote-ref-1094)
1094. 283.21See § 13.03[E][1][b] *supra*. See also N. 278 *supra*. [↑](#footnote-ref-1095)
1095. 283.22Some courts have reserved decision on whether the *Altai* test applies to allegations of literal copying of source or object code. See General Universal Sys., Inc. v. Lee, 379 F.3d 131, 143 (5th Cir. 2004) (*per curiam*); Data Gen. Corp. v. Grumman Sys. Support Corp., 803 F. Supp. 487, 491 (D. Mass. 1992). [↑](#footnote-ref-1096)
1096. 284Tradescape.com v. Shivaram, 77 F. Supp. 2d 408, 416–17 (S.D.N.Y. 1999) (Treatise cited). [↑](#footnote-ref-1097)
1097. 284.1Cavalier v. Random House, Inc., 297 F.3d 815, 822, 826 (9th Cir. 2002) (“a court must filter out and disregard the non-protectable elements in making its substantial similarity determination”). [↑](#footnote-ref-1098)
1098. 284.2See § 13.03[A][1][c] *supra* (total concept and feel); *id*. N. 63.4 and accompanying text (discussing this case). [↑](#footnote-ref-1099)
1099. 284.3Torah Soft Ltd. v. Drosnin, 136 F. Supp. 2d 276, 285 (S.D.N.Y. 2001). [↑](#footnote-ref-1100)
1100. 284.4See Ralph D. Clifford, *Intellectual Property in the Era of the Creative Computer Program: Will the True Creator Please Stand Up?*, 71 Tul. L. Rev. 1675 (1997); David Nimmer, *Copyright in the Dead Sea Scrolls: Authorship and Originality*, 38 Hous. L. Rev. 1, 31–32 (2001). [↑](#footnote-ref-1101)
1101. 284.5Torah Soft Ltd. v. Drosnin, 136 F. Supp. 2d 276, 283 (S.D.N.Y. 2001). [↑](#footnote-ref-1102)
1102. 284.6*Id*. [↑](#footnote-ref-1103)
1103. 284.7Design Data Corp. v. Unigate Enter., Inc., 847 F.3d 1169 (9th Cir. 2017) (Treatise quoted). This case affirmed the district court’s dismissal, given the absence of evidence that plaintiff’s program did “the lion’s share of the work” in creating the output. [↑](#footnote-ref-1104)
1104. 284.8*Id*. at 284–292 (substantial similarity lacking between matrix output from plaintiff’s program and program itself, after abstraction, filtration, and comparison). [↑](#footnote-ref-1105)
1105. 284.9Rearden LLC v. Walt Disney Co., 293 F. Supp. 3d 963, 967 (N.D. Cal. 2018). [↑](#footnote-ref-1106)
1106. 284.10*Id.* at 970. [↑](#footnote-ref-1107)
1107. 284.11In capturing and modifying such features as “Brad Pitt’s 44-year old face,” it concluded that defendants’ “role in creating the end-product is not so ‘marginal’ that the output reflects the program’s contents.” *Id.* at 971. See Rearden LLC v. Crystal Dynamics, Inc., 286 F. Supp. 3d 1076, 1079 (N.D. Cal. 2018) (same). [↑](#footnote-ref-1108)
1108. 285See § 2A.06[A][3][a] *supra*. The familiar proposition that ideas are as “free as air” has been recognized by computer copyright cases no less than in other types of copyright litigation. See, *e.g.,* Q-Co Indus. v. Hoffman, 625 F. Supp. 608, 615 (S.D.N.Y. 1985). See 1 R. Bernacchi, P. Frank & N. Stratland, *Bernacchi on* *Computer Law* § 3.10.1 (1986). [↑](#footnote-ref-1109)
1109. 286See Note, *Copyright Infringement of Computer Programs: A Modification of the Substantial Similarity Test,* 68 Minn. L. Rev. 1264, 1291 (1984) (“The computer software industry progresses by a stepping-stone improvement process, with each innovation building on past innovations to produce an improved product”). [↑](#footnote-ref-1110)
1110. 287See, *e.g., Structured Programming* (O. Dahl, E. Dijkstra, C. Hoare, F. Genuys, eds. 1972); N. Wirth, Program Development by Stepwise Refinement, Comm. ACM 14, No. 4 (1971); G. Schneider & S. Bruell, *Advanced Programming and Problem Solving with Pascal* 164–88 (1981); Whelan Assocs. v. Jaslow Dental Lab., 797 F.2d 1222, 1229 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031, 107 S. Ct. 877, 93 L. Ed. 2d 831 (1987). [↑](#footnote-ref-1111)
1111. 288“Data structures” are constructs that allow a programmer to combine a variety of different types of data into manageable units. For example, an employee record consisting of the employee’s name, address, social security number and salary rate could be combined into a data structure that the program could manipulate as a single unit. A significant part of the effort involved in virtually any programming project is spent in specifying adequate data structures and the means for manipulating them. See 1 D. Knuth, *The Art of Computer Programming* (1973); N. Wirth, *Algorithms & Data Structures* 9–12 (1986). In some cases, where a data structure is sufficiently unique and contains original material, it may even constitute protectible expression. On the other hand, data structures determined by external factors do not warrant copyright protection. Baystate Technologies, Inc. v. Bentley Systems, Inc., 946 F. Supp. 1079, 1088 (D. Mass. 1996). *Contra*, Positive Software Solutions Inc. v. New Century Mortgage Corp., 259 F. Supp. 2d 531, 535 n.5 (N.D. Tex. 2003). [↑](#footnote-ref-1112)
1112. 289An “algorithm” is a “finite sequence of instructions, each of which has a clear meaning and can be performed with a finite amount of effort in a finite length of time.” A. Aho, J. Hopcraft & D. Ullman, *Data Structures and Algorithms* 2 (1983). Algorithms usually, though not necessarily, involve mathematical representations of the problem to be solved.

      When viewed from the highest level, algorithms represent the very essence of abstract ideas; as such, algorithms are ineligible for copyright or patent protection. Baker v. Selden, 101 U.S. 99, 25 L. Ed. 841 (1879) (bookkeeping system, which is a nonmathematical algorithm, held to be uncopyrightable idea); Gottschalk v. Benson, 409 U.S. 63 (1973) (algorithm for converting binary code decimal numbers into equivalent pure binary numbers held unpatentable). Such ideas remain always in the public domain. See 1 *Bernacchi on Computer Law*, § 3.6.2, at 3–24. [↑](#footnote-ref-1113)
1113. 289.1See Lotus Dev. Corp. v. Paperback Software Int’l, 740 F. Supp. 37, 45 (D. Mass. 1990) (“flowcharts, if sufficiently detailed and original, are entitled to copyright protection”). [↑](#footnote-ref-1114)
1114. 290See Siebersma v. Vande Berg, 64 F.3d 448, 449 (8th Cir. 1995). “Pseudo-code” is a representation of program structure consisting of written statements that resemble actual source code. Pseudo-code, however, omits much of the detail of actual code, and is not restricted to any particular computer language. Thus, for example, a programmer writing pseudo-code might label a function “OUTPUT” that, when actually coded, would require commands to format, open files, and print. [↑](#footnote-ref-1115)
1115. 291For purposes of this discussion, debugging—one of the most difficult and labor-intensive steps in producing a working computer program—is omitted, as are the processes of program documentation and maintenance. See D. Bender, *Computer Law—Software Protection* § 2.06[3][e] (1988) (discussing debugging); Whelan Assocs. v. Jaslow Dental Lab., 797 F.2d 1222, 1231 n.21 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031, 107 S. Ct. 877, 93 L. Ed. 2d 831 (1987) (discussing debugging, program documentation, and maintenance). See the discussion of how computer programs are created in Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 697–98 (2d Cir. 1992). [↑](#footnote-ref-1116)
1116. 291.1“I credit the testimony of expert witnesses that the bulk of the creative work is in the conceptualization of a computer program and its user interface, rather than in its encoding, and that creating a suitable user interface is a more difficult intellectual task, requiring greater creativity originality, and insight, than conceiving the user interface design into instructions to the machine.” Lotus Dev. Corp. v. Paperback Software Int’l, 740 F. Supp. 37, 56 (D. Mass. 1990). The district court in Engineering Dynamics, Inc. v. Structural Software, Inc., 785 F. Supp. 576, 582 (E.D. La. 1991), called *Lotus* “persuasive,” but felt constrained by Plains Cotton Coop. Ass’n v. Goodpasture Computer Serv., Inc., 807 F.2d 1256 (5th Cir. 1987), not to follow it. The Fifth Circuit reversed in part, citing *Lotus.* 26 F.3d 1335, 1344 (5th Cir. 1994) (user interface can range from unprotectible “blank form” to high expression such as in video game). Note that the copyrighted work in *Engineering Dynamics* consisted of user manuals, as plaintiff maintained the program itself as a trade secret. *Id.* at 1339. [↑](#footnote-ref-1117)
1117. 292Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 834 (10th Cir. 1993) (Treatise cited). See § 13.03[A][1][a] *supra*. [↑](#footnote-ref-1118)
1118. 292.1Autoskill Inc. v. National Educ. Support Sys., Inc., 994 F.2d 1476, 1491–92 (10th Cir.), *cert. denied*, 510 U.S. 916, 114 S. Ct. 307, 126 L. Ed. 2d 254 (1993) (Treatise cited). [↑](#footnote-ref-1119)
1119. 292.2The preceding three paragraphs (in their predecessor law review article format) are quoted in Micro Consulting, Inc. v. Zubeldia, 813 F. Supp. 1514, 1528–29 (W.D. Okla. 1990), *aff’d mem.,* 959 F.2d 245 (10th Cir. 1992). [↑](#footnote-ref-1120)
1120. 292.317 U.S.C. § 102(b). See Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 836 (10th Cir. 1993). [↑](#footnote-ref-1121)
1121. 293See Pearl Sys., Inc. v. Competition Elecs., Inc., 1988 Copyright L. Dec. (CCH) ¶ 26,338, 8 U.S.P.Q.2d 1520 (S.D. Fla. 1988) (expert testified to five levels of abstraction, the most creative of which would yield different flow charts if differently implemented in two computer programs). [↑](#footnote-ref-1122)
1122. 294See *Whelan*, 797 F.2d at 1235 (abandoning the abstractions test when evaluating computer programs). [↑](#footnote-ref-1123)
1123. 294.1Paycom Payroll, LLC v. Richison, 758 F.3d 1198, 1205 (10th Cir. 2014) (Treatise quoted). A special master’s failure to detail his application of the full abstraction/filtration/comparison led to reversal of the district court order adopting his report. *Id.* at 1206 (Treatise quoted). The court of appeals acknowledge that he may possibly have done an exemplary job of applying the full test before drafting his report; but it vacated and remanded, as “with only the meager support included in his report, we cannot know for sure.” *Id.* at 1208. [↑](#footnote-ref-1124)
1124. 295Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 834 (10th Cir. 1993) (Treatise quoted); Engineering Dynamics, Inc. v. Structural Software, Inc., 26 F.3d 1335, 1343 (5th Cir. 1994) (Treatise quoted); Compaq Computer Corp, v. Ergonome, Inc., 137 F. Supp. 2d 768, 773 n.2 (S.D. Tex. 2001) (Treatise quoted); MiTek Holdings v. Arce Eng’g Co., 864 F. Supp. 1568, 1577 (S.D. Fla. 1994) (Treatise quoted), *aff’d*, 89 F.3d 1548, 1555–57 (11th Cir. 1996). See § 13.03[B][2] *supra*. [↑](#footnote-ref-1125)
1125. 296797 F.2d 1222 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031 (1987). See the discussion of this case in § 13.03[A][1][d] *supra*. [↑](#footnote-ref-1126)
1126. 297797 F.2d at 1235. [↑](#footnote-ref-1127)
1127. 298*Id*. at 1236 (emphasis omitted). [↑](#footnote-ref-1128)
1128. 299*Id*. at 1238–39. [↑](#footnote-ref-1129)
1129. 300Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 705 (2d Cir. 1992) (Treatise quoted). See the opinion below, 775 F. Supp. 544, 559 (E.D.N.Y. 1991) (Treatise quoted). See § 13.03[E][3][b][i] *supra*. [↑](#footnote-ref-1130)
1130. 300.1In Healthcare Affiliated Servs., Inc. v. Lippany, 701 F. Supp. 1142 (W.D. Pa. 1988), a court nominally bound by the Third Circuit’s opinion in *Whelan* confronted a situation in which the plaintiffs “as in *Whelan*, have presented evidence documenting that there exist other programs in the marketplace which perform the same functions, services and purposes as do plaintiffs’ programs. Plaintiffs also have documented that these programs do not employ the same methodologies as do the programs developed by plaintiffs (and defendant’s comparable programs).” *Id*. at 1151. Nonetheless, the court denied copyright liability, finding that the “methodologies” there at issue fell on the “idea” rather than the “expression” side of the line. See § 13.03[B][2][a] *supra*. [↑](#footnote-ref-1131)
1131. 300.2Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 707 (2d Cir. 1992) (Treatise quoted). [↑](#footnote-ref-1132)
1132. 301Nichols v. Universal Pictures, 45 F.2d 119, 121 (2d Cir. 1930). [↑](#footnote-ref-1133)
1133. 301.1CCC Info Servs., Inc. v. Maclean Hunter Market Reports, Inc., 44 F.3d 61, 72 n.24 (2d Cir. 1994) (Treatise quoted); Health Grades, Inc. v. Robert Wood Johnson Univ. Hosp., Inc., 634 F. Supp. 2d 1226, 1236 (D. Colo. 2009) (Treatise quoted). [↑](#footnote-ref-1134)
1134. 302Broderbund Software v. Unison World, Inc., 648 F. Supp. 1127, 1133 (N.D. Cal. 1986). *Broderbund* involved a program designed to print signs, banners and greeting cards on a personal computer. As in *Whelan*, the *Broderbund* court concluded that the fact that other programs exist that print such signs and banners means that the organization and structure of any particular program must always represent expression, not ideas. This view goes too far, however, as many basic elements of a printing program—such as the idea of storing the text to be printed to a disk file before printing it—properly should be considered unprotectible ideas. [↑](#footnote-ref-1135)
1135. 302.1Gates Rubber Co. v. Bando Am., Inc., 798 F. Supp. 1499, 1513 (D. Colo. 1992), *vacated,* 9 F.3d 823 (10th Cir. 1993). Rejecting the district court’s approach, the Tenth Circuit called criticisms of *Whelan* valid and adopted, in substantial part, the “Abstraction-Filtration-Comparison” test proposed herein. *Id.* at 834, 840 n.17 (Treatise cited). [↑](#footnote-ref-1136)
1136. 302.2It had the opportunity to retreat from *Whelan* in a later copyright case. But instead, it denied any tension with that earlier ruling. See Southco, Inc. v. Kanebridge Corp., 390 F.3d 276, 285 n.4 (3d Cir. 2004) (*en banc*), *cert. denied*, 546 U.S. 813, 126 S. Ct. 336, 163 L. Ed. 2d 48 (2005). [↑](#footnote-ref-1137)
1137. 303Plains Cotton Coop. Ass’n v. Goodpasture Computer Serv., Inc., 807 F.2d 1256, 1262 (5th Cir.), *cert. denied*, 484 U.S. 821, 108 S. Ct. 80, 98 L. Ed. 2d 42 (1987). Because the *Goodpasture* case involved only an appeal from denial of a preliminary injunction, however, the analysis does not clearly indicate how the Fifth Circuit would treat allegations of infringement of program structure and organization after a full trial. In Kepner-Tregoe, Inc. v. Leadership Software, Inc., 12 F.3d 527 (5th Cir. 1994), the Fifth Circuit relied liberally on *Altai,* but also favorably cited *Whelan,* to accord protection to the nonliteral elements of a copyrightable work—a training manual. Calling its ruling not inconsistent with *Plains Cotton,* the court merely purported to “embrace the general, non-controversial proposition that non-literal aspects of copyrighted works—like structure, sequence, and organization—*may* be protected under copyright law.” *Id.* at 536 n.20 (emphasis original). The Fifth Circuit later formally aligned itself with *Altai.* Engineering Dynamics, Inc. v. Structural Software, Inc., 26 F.3d 1335 (5th Cir. 1994), *reh’g denied*, Engineering Dynamics, Inc. v. Structural Software, Inc., 46 F.3d 408, 409 (5th Cir. 1995). [↑](#footnote-ref-1138)
1138. 303.1982 F.2d 693 (2d Cir. 1992). The court affirmed the trial court’s conclusion that *Whelan* is “inadequate and inaccurate.” 775 F. Supp. 544, 559 (E.D.N.Y. 1991). Note the reversal of other portions of the district court opinion. See § 13.03[F] N. 283.6 *supra.* [↑](#footnote-ref-1139)
1139. 303.2982 F.2d at 706. Following *Altai,* see Sega Enters. Ltd. v. Accolade, Inc., 977 F.2d 1510 (9th Cir. 1992) (*Whelan* has been widely—and soundly—criticized as simplistic and overbroad); Apple Computer, Inc. v. Microsoft Corp., 799 F. Supp. 1006, 1024–1025 (N.D. Cal. 1992) (embodying “too facile a distinction … the *Whalen* rule distends copyright protection”), *aff’d (rev’d as to fees),* 35 F.3d 1435 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995); Lotus Dev. Corp. v. Borland Int’l, Inc., 799 F. Supp. 203, 217 (D. Mass. 1992) (partially rejecting *Whelan*). [↑](#footnote-ref-1140)
1140. 303.3See 775 F. Supp. at 549. [↑](#footnote-ref-1141)
1141. 303.4*Id.* at 550. [↑](#footnote-ref-1142)
1142. 303.5This case, like so many of the other seminal software computer cases, arose in a pattern in which defendant’s program was created by ex-employees who had access to plaintiff’s original. See, *e.g.,* Gates Rubber Co. v. Bando-Am., Inc., 9 F.3d 823 (10th Cir. 1993). In many of these cases the genealogical circumstances also gave rise to a trade secrets claim. See § 13.03[F] N. 283.6 *supra.* [↑](#footnote-ref-1143)
1143. 303.6775 F. Supp. at 553. [↑](#footnote-ref-1144)
1144. 303.7*Id.* at 554. [↑](#footnote-ref-1145)
1145. 303.8982 F.2d at 700. [↑](#footnote-ref-1146)
1146. 303.9*Id.* at 701. [↑](#footnote-ref-1147)
1147. 303.10775 F. Supp. at 561–562. [↑](#footnote-ref-1148)
1148. 303.11The Second Circuit’s discussion is geared at substantial similarity in the nonliteral elements of computer software. It does not treat distinct aspects of software, such as screen displays that computer programs may generate. See 982 F.2d at 702–703. [↑](#footnote-ref-1149)
1149. 303.12One minor point of disagreement between the appellate and trial courts is that the latter filtered out noncopyrightable aspects from defendant’s product rather than from plaintiff’s. The Second Circuit concluded that “our approach—*i.e.,* filtering out the unprotected aspects of an allegedly infringed program and then comparing the end product to the structure of the suspect program—is preferable, and [we] therefore believe that district courts should proceed in this manner in future cases.” 982 F.2d at 714. [↑](#footnote-ref-1150)
1150. 303.13See Atari Games Corp. v. Nintendo of Am., Inc., 975 F.2d 832, 839–840 (Fed. Cir. 1992), *later opinion,* 799 F. Supp. 203, 216–219 (D. Mass. 1992). [↑](#footnote-ref-1151)
1151. 303.14See § 13.03[F] N. 283.8 *supra.* [↑](#footnote-ref-1152)
1152. 304See § 13.03[B][3][c] *supra.* [↑](#footnote-ref-1153)
1153. 304.1An example of two obvious choices is a menu bar that can logically be placed only at the top or bottom of the screen. Productivity Software Int’l Inc. v. Healthcare Technologies Inc., 37 U.S.P.Q.2d 1036, 1040–1041 (S.D.N.Y. 1995) (Treatise cited) (applying *Altai* test). [↑](#footnote-ref-1154)
1154. 304.2Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 708 (2d Cir. 1992) (Treatise cited); Maddog Software, Inc. v. Sklader, 382 F. Supp. 2d 268, 281 (D.N.H. 2005) (Treatise quoted); Torah Soft Ltd. v. Drosnin, 136 F. Supp. 2d 276, 285 (S.D.N.Y. 2001) (Treatise quoted). In Kepner-Tregoe, Inc. v. Leadership Software, Inc., 12 F.3d 527, 534 & n.12 (5th Cir. 1994), a suit over management training materials, rather than software, but nonetheless favorably disposed towards the test proposed herein, the defendant negated its own merger defense by composing an amended work phrased in alternative expression, which nonetheless failed adequately to purge copyright infringement. [↑](#footnote-ref-1155)
1155. 305Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 709 (2d Cir. 1992) (Treatise cited). The merger doctrine has been recognized in the computer context. See Whelan Assocs. v. Jaslow Dental Lab., 797 F.2d 1222, 1236 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031, 107 S. Ct. 877, 93 L. Ed. 2d 831 (1987); Broderbund Software v. Unison World, Inc., 648 F. Supp. 1127, 1131–1133 (N.D. Cal. 1986); E.F. Johnson Co. v. Uniden Corp., 623 F. Supp. 1485, 1500–1502 (D. Minn. 1985). See also Atari Games Corp. v. Nintendo of Am., Inc., 975 F.2d 832, 839–840 (Fed. Cir. 1992). In Secure Services Technology, Inc. v. Time & Space Processing, Inc., 722 F. Supp. 1354, 1363 (E.D. Va. 1989), the court denied protection to variations in a handshake protocol, given that the plaintiff’s modifications “are dictated largely by the requirements of the” standard protocol, of which plaintiff was not the proprietor. [↑](#footnote-ref-1156)
1156. 305.1Goldman v. Healthcare Mgmt. Sys., 628 F. Supp. 2d 748, 754 (W.D. Mich. 2008) (Treatise cited). [↑](#footnote-ref-1157)
1157. 306For example, compare two well-known sorting techniques, the bubble sort and the quicksort, each to be used to sort into alphabetical order a list of 1,000 randomly arranged names. The number of comparisons that the computer must make with a bubble sort is a function of the square of the number of names. In contrast, the number of comparisons required by a quicksort is a function of (N)ln(N), where N is the number of names, and “ln” is the natural log (base *e*) function. The bubble sort thus will require on the order of 1,000,000 comparisons while the quicksort will require only on the order of 7,000. See S. Baase, *Computer Algorithms* 51–60 (1978). [↑](#footnote-ref-1158)
1158. 307Other factors, such as hardware or software compatibility requirements, may also limit the programmer’s range of choices, thereby calling the merger doctrine into play. See 1 *Bernacchi on Computer Law* § 3.10.2. See § 13.03[F][3] *infra*. [↑](#footnote-ref-1159)
1159. 307.1Torah Soft Ltd. v. Drosnin, 136 F. Supp. 2d 276, 291–292 (S.D.N.Y. 2001) (excerpts of previous paragraphs of Treatise quoted). [↑](#footnote-ref-1160)
1160. 307.2If, by contrast, a subjective business judgment is implicated, then the merger defense is inapplicable. Compaq Computer Corp. v. Procom Technology, Inc., 908 F. Supp. 1409, 1419 & n.13 (S.D. Tex. 1995). [↑](#footnote-ref-1161)
1161. 308Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 708 (2d Cir. 1992) (Treatise cited). See § 13.01[B] *supra.* [↑](#footnote-ref-1162)
1162. 308.1One court cites the various subheadings that follow as setting forth the proper approach for courts to follow. Real View, LLC v. 20-20 Techs, Inc., 683 F. Supp. 2d 147, 155 (D. Mass. 2010) (Treatise cited as “the leading commentator”). [↑](#footnote-ref-1163)
1163. 309Kohus v. Mariol, 328 F.3d 848, 856 (6th Cir. 2003) (Treatise quoted); Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 715 (2d Cir. 1992) (Treatise quoted); Engineering Dynamics, Inc. v. Structural Software, Inc., 26 F.3d 1335, 1347 & ns.12–13 (5th Cir. 1994) (Treatise cited). See § 13.03[B][4] *supra*. [↑](#footnote-ref-1164)
1164. 310See Hoehling v. Universal City Studios, 618 F.2d 972, 979 (2d Cir. 1980); Landsberg v. Scrabble Crossword Game Players, Inc., 736 F.2d 485, 488–489 (9th Cir. 1984). [↑](#footnote-ref-1165)
1165. 311See § 2.11[A] *supra*. [↑](#footnote-ref-1166)
1166. 312Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 709 (2d Cir. 1992) (Treatise quoted); Bateman v. Mnemonics, Inc., 79 F.3d 1532, 1547 (11th Cir. 1996) (Treatise quoted); Kid Stuff Mktg., Inc. v. Creative Consumer Concepts, Inc., 223 F. Supp. 3d 1168, 1188 n.15 (D. Kan. 2016) (Treatise quoted); Real View, LLC v. 20-20 Techs, Inc., 683 F. Supp. 2d 147, 152 (D. Mass. 2010) (Treatise quoted); The scenes a faire doctrine has been recognized in the computer context. See Q-Co Indus. v. Hoffman, 625 F. Supp. 608, 616 (S.D.N.Y. 1985); Plains Cotton Coop. Ass’n v. Goodpasture Computer Serv., Inc., 807 F.2d 1256, 1262 (5th Cir.), *cert. denied*, 484 U.S. 821, 108 S. Ct. 80, 98 L. Ed. 2d 42 (1987). See also Atari Games Corp. v. Oman, 888 F.2d 878, 886 (D.C. Cir. 1989) (doctrine as applied to video games “limits only the scope of a given material’s protection, not its copyrightability”); Apple Computer, Inc. v. Microsoft Corp., 799 F. Supp. 1006, 1027 (N.D. Cal. 1992) (defendant’s scenes a faire argument regarding screen displays “supported by an exhibit showing overlapping rectangular windows to have been utilized in twenty-six other commercial systems over the past decade”), *aff’d (rev’d as to fees)*, 35 F.3d 1435, 1444 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995). [↑](#footnote-ref-1167)
1167. 312.1The five subheadings that follow are listed, as extrinsic considerations that often circumscribe a programmer’s freedom of design choice, in Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 709–710 (2d Cir. 1992) (Treatise cited). [↑](#footnote-ref-1168)
1168. 313Oracle Am., Inc. v. Google Inc., 750 F.3d 1339, 1364 (Fed. Cir. 2014) (Treatise quoted), *cert. denied*, 135 S. Ct. 2887 (2015); Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 838 (10th Cir. 1993) (Treatise cited); Computer Mgmt. Assistance Co. v. Robert F. DeCastro, Inc., 220 F.3d 396, 402 (5th Cir. 2000); Oriental Art Printing, Inc. v. Goldstar Printing Corp., 175 F. Supp. 2d 542, 547 n.3 (S.D.N.Y. 2001) (Treatise quoted), *aff’d unpub*., 34 Fed. Appx. 401 (2d Cir. 2002). See § 13.02[B] text accompanying N. 24 *supra*. [↑](#footnote-ref-1169)
1169. 314See, *e.g.*, NEC Corp. v. Intel Corp., 1989 Copyright L. Dec. (CCH) ¶ 26,379, 10 U.S.P.Q.2d 1177 (N.D. Cal. 1989) (constraints from hardware, architecture and other specifications; some similarities resulted from similar “visions” of the programs); Manufacture Technologies, Inc. v. Cams, Inc., 706 F. Supp. 984, 995, 998 (D. Conn. 1989) (constraints from hardware package, needs of target buyers of cost estimating program, in case alleging screen infringement). It should be noted that the latter case found infringement, the former did not. [↑](#footnote-ref-1170)
1170. 314.1Statements “referring to the court’s role in analyzing non-literal infringement claims [along the lines of] ‘*a court* should dissect the allegedly copied program’s structure and isolate each level of abstraction contained within it,’ should be taken only as statements as to what the court should do to analyze evidence properly brought before it by a party.” Softel, Inc. v. Dragon Medical and Scientific Communications, Inc., 118 F.3d 955, 965 n.9 (2d Cir. 1997) (citations omitted, emphasis added by the court). See General Universal Sys., Inc. v. Lee, 379 F.3d 131, 146 (5th Cir. 2004) (*per curiam*) (district court not obliged to waddle through the record). [↑](#footnote-ref-1171)
1171. 314.2See Liberty Am. Ins. Group, Inc. v. WestPoint Underwriters, L.L.C., 199 F. Supp. 2d 1271, 1290 (M.D. Fla. 2001). [↑](#footnote-ref-1172)
1172. 314.3Compulife Software Inc. v. Newman, 959 F.3d 1288, 1305 (11th Cir. 2020) (Treatise quoted). [↑](#footnote-ref-1173)
1173. 314.4See SAS Inst. Inc. v. World Programming Ltd., 64 F.4th 1319, 1331 (Fed. Cir. 2023) (Treatise quoted), *aff’g* 46 F. Supp. 3d 1019, 1026–29 (E.D. Tex. 2020) (Treatise cited). [↑](#footnote-ref-1174)
1174. 314.5*Id.* at 1334 (Newman, J., dissenting). [↑](#footnote-ref-1175)
1175. 315More precisely, the addresses of video display control registers and video RAM in the IBM PC are standardized, and must be accessed in a particular fashion in order to generate a display. See L. Scanlon, *IBM PC & XT Assembly Language: A Guide for Programmers* 245–265 (1983). [↑](#footnote-ref-1176)
1176. 316A “menu,” in computer terminology, is a listing on the display screen of several user options. To select an option, the user ordinarily chooses a number or letter corresponding to the desired option. [↑](#footnote-ref-1177)
1177. 317See Whelan Assocs. v. Jaslow Dental Lab., 797 F.2d 1222 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031, 107 S. Ct. 877, 93 L. Ed. 2d 831 (1987); Broderbund Software v. Unison World, Inc., 648 F. Supp. 1127 (N.D. Cal. 1986). But see Engineering Dynamics, Inc. v. Structural Software, Inc., 785 F. Supp. 576, 582 (E.D. La. 1991), *rev’d in part,* 26 F.3d 1335 (5th Cir. 1994). [↑](#footnote-ref-1178)
1178. 318See § 13.01[B] *supra,* discussing probative similarity. [↑](#footnote-ref-1179)
1179. 318.1Cf. Pearl Sys., Inc. v. Competition Elecs., Inc., 1988 Copyright L. Dec. (CCH) ¶ 26,338, 8 U.S.P.Q.2d 1520 (S.D. Fla. 1988). [↑](#footnote-ref-1180)
1180. 318.2See § 13.01[B] *supra*, discussing actionable substantial similarity. [↑](#footnote-ref-1181)
1181. 318.3The point in the previous paragraph of the text is that both plaintiff’s and defendant’s choice to assign technical functions *A* and *B* to one or another of function keys *F1* through *F10* is merely an application of the hardware standard, not probative of copying even as a factual matter. But the correspondence of *A* to *F4* and *B* to *F7* does evidence probative similarity, *i.e.,* copying as a factual matter. [↑](#footnote-ref-1182)
1182. 318.4See § 13.03[C] *supra.* [↑](#footnote-ref-1183)
1183. 318.5In Kepner-Tregoe, Inc. v. Leadership Software, Inc., 12 F.3d 527 (5th Cir. 1994), the defendant’s initial program concededly infringed plaintiff’s copyright; the further question remained whether its second redacted product likewise infringed. The court noted that the five processes of plaintiff’s model were called AI, AII, CI, CII, and GII, and that defendant’s redacted model used the identical terminology. “Are these designations fundamental constants supplied by nature, like π for a circle or Planck’s constant in quantum physics?,” asked the court. *Id.* at 537. Given a negative answer to that question, the identity in terminology proves copying in genealogy; yet that species of copying was conceded from the outset, given the redaction that produced this product. The court went further: “These features of the [plaintiff’s] model are thus original, protectible expression, not fundamental constants of nature; and [defendant’s] copying of these features—and other related features—is thus infringing.” That reasoning appears to conflate probative with actionable similarity. See § 13.01[B] *supra* (later cited by the same court in Engineering Dynamics, Inc. v. Structural Software, Inc., 26 F.3d 1335, 1340 n.4 (5th Cir. 1994)). For, putting aside the “other related features,” if, following redaction, the sole remaining similarity between the two works consisted of the thirteen letters noted above (“AI,” “AII” etc.), infringement should not have been found. See *Id.* at 538 (question of infringement is “a fairly close one”). [↑](#footnote-ref-1184)
1184. 318.6In Autoskill, Inc. v. National Educ. Sup. Sys., Inc., 994 F.2d 1476, 1495 n.23 (10th Cir. 1993), the court held that it was not error for the district judge to protect plaintiff’s keying procedure (“a student selects a response by pressing the 1, 2, or 3 keys.”). Affirming the grant of a preliminary injunction, the appeals court concluded that “for the purposes of the preliminary injunction, that the record showed that the keying procedure reflected at least a minimal degree of creation. Further, NESS has not pointed to substantial evidence in the record that this procedure was such a common practice, or that it was dictated by efficiency considerations, so that it should have been filtered out of the analysis.” *Id.* See N. 318.5 *supra.* Nonetheless, when the same court confronted the test for determining software infringement based on a full record rather than on appeal from a preliminary injunction, it meticulously distinguished probative from actionable similarity. Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 832 n.7, 841 (10th Cir. 1993) (see N. 280.1 *supra*). Likewise in opposition to the *Autoskill* footnote is Lotus Dev. Corp. v. Borland Int’l, Inc., 49 F.3d 807, 813 (1st Cir. 1995)*, aff’d,* 516 U.S. 233, 116 S. Ct. 804, 133 L. Ed. 2d 610 (1996). [↑](#footnote-ref-1185)
1185. 318.7See § 13.03[F][3][e] *infra.* [↑](#footnote-ref-1186)
1186. 318.8Note the new receptivity of courts to expert testimony, at least *vis-à-vis* software infringement allegations. See § 13.03[E][4] *supra.* [↑](#footnote-ref-1187)
1187. 319See, *e.g.,* Data East USA, Inc. v. Epyx, Inc., 862 F.2d 204, 209 (9th Cir. 1988) (“constraints inherent in use of” Commodore computer include use of sprites and limited access to color). See Hoehling v. Universal City Studios, 618 F.2d 972, 977 (2d Cir. 1980) (“Ordinarily, wrongful appropriation is shown by proving a ‘substantial similarity’ of *copyrightable* expression.”) (emphasis in original). [↑](#footnote-ref-1188)
1188. 320An “operating system” is a program that provides an interface between the computer hardware and the end user. The operating system controls access to system hardware and provides an environment in which a user can execute programs. J. Peterson & A. Silberschatz, *Operating System Concepts* 1–4 (1983). On the IBM PC, the operating system provides the user with a number of built-in utilities, such as file copying and deletion, in addition to controlling the way in which user programs access the computer. See, *e.g., IBM PC DOS User’s Manual,* Version 2.10 (1983). [↑](#footnote-ref-1189)
1189. 321On the IBM PC, access to disk files is obtained by causing the user program to request the operating system to perform the necessary functions. See L. Scanlon, *IBM PC & XT Assembly Language: A Guide for Programmers* 2.10 (1983). [↑](#footnote-ref-1190)
1190. 322Under PC-DOS, for instance, program files must be located in certain areas of the disk, and must be called in a particular way, to access user programs. See, *e.g., IBM PC-DOS User’s Manual, Version* 2.10 (1985). [↑](#footnote-ref-1191)
1191. 323Cf. McGraw-Hill, Inc. v. Worth Publishers, Inc., 335 F. Supp. 415, 421 (S.D.N.Y. 1971) (range of expression in economics textbook limited by terminology associated with subject). [↑](#footnote-ref-1192)
1192. 324Numerous so-called “standards” exist in the computer industry for everything from communications protocols to keystroke sequences to file formats. Most such standards result not from any formal agreement, but from the commercial success of a particular product. See Seymour, *Who Owns the Standards,* PC Magazine, May 26, 1987, at 174. See, *e.g.,* Secure Servs. Technology, Inc. v. Time & Space Processing, Inc., 722 F. Supp. 1354, 1357 (E.D. Va. 1989) (fax machine handshake protocol). See the discussion of standards in § 13.03[F][3][e] *infra*, treating Lotus Dev. Corp. v. Paperback Software Int’l, 740 F. Supp. 37 (D. Mass. 1990). [↑](#footnote-ref-1193)
1193. 325Fisher, *IBM Manual Explains How SAA User Interface Should Look,* Infoworld, Nov. 9, 1987, at 6. [↑](#footnote-ref-1194)
1194. 326*Id.* [↑](#footnote-ref-1195)
1195. 327See, *e.g.*, Broderbund Software v. Unison World, Inc., 648 F. Supp. 1127, 1137 (N.D. Cal. 1986). [↑](#footnote-ref-1196)
1196. 328See *id*. at 1134 (decision to use particular text and graphic displays in a printing program were based on “aesthetic and artistic preferences”). [↑](#footnote-ref-1197)
1197. 329Cf. Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102 (2d Cir. 1951). [↑](#footnote-ref-1198)
1198. 330See § 13.03[A][1][c] *supra*. On the other hand, a distinctive user interface not constrained by manufacturer’s guidelines may be protected. See § 13.03[F][1][a] & N. 291.1 *supra.* [↑](#footnote-ref-1199)
1199. 330.1Torah Soft Ltd. v. Drosnin, 136 F. Supp. 2d 276, 285, 287 (S.D.N.Y. 2001) (Treatise quoted) (*sheimot* changes whereby Orthodox Jewish users of software would be able to turn off Bible program without committing sacrilege of erasing the divine name). See Autoskill, Inc. v. National Educ. Support Sys. Inc., 793 F. Supp. 1557, 1568 (D.N.M. 1992) (Treatise cited), *aff’d,* 994 F.2d 1476 (10th Cir.), *cert. denied*, 510 U.S. 916, 114 S. Ct. 307, 126 L. Ed. 2d 254 (1993). [↑](#footnote-ref-1200)
1200. 331See § 2A.06[A][3][b] *supra* (criticizing Williams v. Arndt, 626 F. Supp. 571 (D. Mass. 1985)). [↑](#footnote-ref-1201)
1201. 332Maddog Software, Inc. v. Sklader, 382 F. Supp. 2d 268, 281 (D.N.H. 2005) (Treatise quoted). Cf. Business Trends Analysts v. Freedonia Group, Inc., 650 F. Supp. 1452, 1460 (S.D.N.Y. 1987) (denying injunction for industry analysis reports, apparently accepting defendant’s argument that “similarities result from common parlance in the field of robotics or can be accounted for by the definitional or factual nature of the subjects of the passages”); McGraw-Hill, Inc. v. Worth Publishers, Inc., 335 F. Supp. 415 (S.D.N.Y. 1971) (holding that the structure of an introductory economics textbook was not protected, because all such textbooks had to conform to a certain structure in order to be saleable). [↑](#footnote-ref-1202)
1202. 333Plains Cotton Coop. Ass’n v. Goodpasture Computer Serv., Inc., 807 F.2d 1256, 1262 & n.4 (5th Cir.), *cert. denied*, 484 U.S. 821 (1987). [↑](#footnote-ref-1203)
1203. 333.1Positive Software Solutions Inc. v. New Century Mortgage Corp., 259 F. Supp. 2d 531, 536 n.9 (N.D. Tex. 2003). In traditional areas of protection, one would not argue that copyrighted designs need to be copied because market factors—the popularity of Pokemon cards, for example—so required. *Id*. [↑](#footnote-ref-1204)
1204. 333.2463 F.3d 478 (6th Cir. 2006). [↑](#footnote-ref-1205)
1205. 333.3*Id*. at 480. [↑](#footnote-ref-1206)
1206. 333.4See § 3.04 *supra*. [↑](#footnote-ref-1207)
1207. 333.5463 F.3d at 482–483. [↑](#footnote-ref-1208)
1208. 333.6See § 13.03[F][4] *infra*. [↑](#footnote-ref-1209)
1209. 333.7463 F.3d at 484. [↑](#footnote-ref-1210)
1210. 333.8*Id*. at 485. [↑](#footnote-ref-1211)
1211. 333.9See *id*. at 480. [↑](#footnote-ref-1212)
1212. 333.10*Id*. at 485 [↑](#footnote-ref-1213)
1213. 333.11*Id*. at 486. [↑](#footnote-ref-1214)
1214. 333.12

      For example, if a user indicates that the user will be filing in a district court, the drop down box containing specific courts is activated so that the user can select the specific court. Correspondingly, the fields related to circuit courts are deactivated such that the user is not prompted to enter a specific circuit court. This makes sense because a case cannot be simultaneously filed both in a district court and in a circuit court.

      *Id*. at 486. [↑](#footnote-ref-1215)
1215. 334See Schneifer & Bruell, *Advanced Programming and Problem Solving with Pascal* 309–334 (1981). [↑](#footnote-ref-1216)
1216. 335*Id.* [↑](#footnote-ref-1217)
1217. 336Engenium Solutions, Inc. v. Symphonic Techs., Inc., 924 F. Supp. 2d 757, 781 (S.D. Tex. 2013) (Treatise cited). In this case the court ultimately granted summary judgment to plaintiff based on substantial similarity. *Id.* at 788. Cf. See v. Durang, 711 F.2d 141, 143 (9th Cir. 1983). See § 13.03[B][4] *supra*. [↑](#footnote-ref-1218)
1218. 336.1See §§ 13.03[F][3][a]–13.03[F][3][e] *supra*. [↑](#footnote-ref-1219)
1219. 336.2Lotus Dev. Corp. v. Paperback Software Int’l, 740 F. Supp. 37, 63, 67 (D. Mass. 1990), prior to reaching the issue of infringement, holds that copyright protection of a computer program is not limited to the literal code, but extends to such nonliteral elements as the user interface and the structure, sequence and organization of the menu command system. The court stated that the use of certain keys was obvious, and of others less so, in any event, not precluding copyright protection for a key-driven command structure taken as a whole. *Id.* at 66, 67. See Lotus Dev. Corp. v. Borland Int’l, Inc., 788 F. Supp. 78, 92 (D. Mass. 1992). In a later opinion, the court implied that a keystroke sequence could be protectible. Lotus Dev. Corp. v. Borland Int’l, Inc., 799 F. Supp. 203, 213 (D. Mass. 1992). [↑](#footnote-ref-1220)
1220. 336.3740 F. Supp. at 57–58 (“To hold otherwise … would offer incentives to market only the second, or third, or tenth best, and hold back the best for fear that it is too good for copyrightability.”) See Consul Tec Inc. v. Interface Sys. Inc., 22 U.S.P.Q.2d 1538, 1541 (E.D. Mich. 1991). [↑](#footnote-ref-1221)
1221. 336.4740 F. Supp. at 79. [↑](#footnote-ref-1222)
1222. 336.5Lotus Dev. Corp. v. Borland Int’l, Inc., 831 F. Supp. 202 (D. Mass. 1993). Analogizing the menu structure, or hierarchy of menus and submenus, to an inverted decision tree, the court rejected arguments that that structure was functionally constrained. *Id.* at 209–15. [↑](#footnote-ref-1223)
1223. 336.6Lotus Dev. Corp. v. Borland Int’l, 831 F. Supp. 223 (D. Mass. 1993). [↑](#footnote-ref-1224)
1224. 336.7*Id.* at 227. [↑](#footnote-ref-1225)
1225. 336.8*Id.* at 226–31. [↑](#footnote-ref-1226)
1226. 336.9The court held that defendant’s file containing the “phantom menu structure” of 1–2–3 replicated the copyrightable structure of Lotus’ menus. *Id.* at 232. But, even if that menu structure itself is copyrightable, the functional purpose underlying the software means that use of those particular letters represented nothing more than a “ ‘marker’ of the Lotus menu tree structure.” *Id.* at 233. Forbidding use of such markers approaches granting copyright protection over ergonomic movements on a keyboard (*i.e.,* granting copyright protection over moving the left index finger up, down, and down again to type “rfc”). [↑](#footnote-ref-1227)
1227. 336.10In the first 1–2–3 opinion, the court noted that “VP-Planner could have provided for a translation device that could read 1–2–3 macros and convert them, automatically, into macros that could be run on VP-Planner.” 740 F. Supp. at 78. In fact, Borland’s key reader function performed exactly that function. Although the court took pains to deny that that statement represented its earlier “holding,” 831 F. Supp. at 233, the fact remains that its ultimate holding would render infringing any conceivable macro translation device, *id.* at 230. [↑](#footnote-ref-1228)
1228. 336.11“This opinion cannot properly be read to extend … to the practice employed by users of programs of analyzing application programs to ‘read’ the file formats of other programs.” Engineering Dynamics, Inc. v. Structural Software, Inc., 46 F.3d 408, 410 (5th Cir. 1995). See ILOG, Inc. v. Bell Logic, LLC, 181 F. Supp. 2d 3, 13 (D. Mass. 2002) (applying *Lotus* to deny protection to context-dependent pop-up menus). [↑](#footnote-ref-1229)
1229. 336.1249 F.3d 807 (1st Cir. 1995). [↑](#footnote-ref-1230)
1230. 336.13*Id*. at 813. [↑](#footnote-ref-1231)
1231. 336.14*Id*. at 815–19. See Mitel, Inc. v. Iqtel, Inc., 896 F. Supp. 1050 (D. Colo. 1995) (industry standard command codes in telephone call controller are method of operation). The affirmance in *Mitel* holds that any copyrightable expression contained in four-digit numeric command codes used in the long distance carrier industry “was dictated by the proclivities of technicians and limited by significant hardware, compatibility, and industry requirements.” 124 F.3d 1366, 1375 (10th Cir. 1997) (Treatise cited). Differing from the First Circuit’s approach in *Lotus,* however, that court would hold that a method of operation may nonetheless contain expression eligible for copyright protection. *Id.* at 1372. [↑](#footnote-ref-1232)
1232. 336.1517 U.S.C. § 102(b). Another court likewise holds a menu and submenu command structure beyond copyright protection under the facts there presented. MiTek Holdings, Inc. v. Arce Eng’g Co., 89 F.3d 1548, 1557 (11th Cir. 1996). [↑](#footnote-ref-1233)
1233. 336.1649 F.3d at 816. See Compaq Computer Corp. v. Procom Technology, Inc., 908 F. Supp. 1409, 1420, 1422 (S.D. Tex. 1995) (denying fair use defense of party who copied precise parameters, even though such copying not required for interoperability). [↑](#footnote-ref-1234)
1234. 336.1749 F.3d at 817–818. Analogous to the automatic teller machine conjured up in the text above, the court invokes a video cassette recorder, whose operation requires an array of buttons that lie outside copyright protection. *Id*. at 817. [↑](#footnote-ref-1235)
1235. 336.17a

      Under the district court’s holding, if the user wrote a macro to shorten the time needed to perform a certain operation in Lotus 1-2-3, the user would be unable to use that macro to shorten the time needed to perform that same operation in another program. Rather, the user would have to rewrite his or her macro using that other program’s menu command hierarchy. This is despite the fact that the macro is clearly the user’s own work product. We think that forcing the user to cause the computer to perform the same operation in a different way ignores Congress’s direction in Section 102(b) that “methods of operation” are not copyrightable.

      *Id*. at 818. See *id*. at 821 (Boudin, J., concurring). [↑](#footnote-ref-1236)
1236. 336.18In a later case, the manufacturer of the “Duke Nukem” computer game encouraged players to create new levels of play and to “pass them on to your friends, or upload to other Dukers on-line.” Microstar v. Formgen, Inc., 942 F. Supp. 1312, 1314 (S.D. Cal. 1996). When a rival downloaded 300 of those new levels off the Internet and sold the product, the district court rejected the manufacturer’s claim to copyright ownership of those files, which were generated by third party players rather than by the copyright owner. *Id.* at 1315–1316. But the Ninth Circuit reversed. 154 F.3d 1107 (9th Cir. 1998). It held that the works that the third parties created were themselves derivative of Duke Nukem, and were licensed to the public only when distributed without charge. *Id.* at 1112–1113. The rival’s sale of those products was thus held infringing. [↑](#footnote-ref-1237)
1237. 336.1949 F.3d at 820 (Boudin, J., concurring). [↑](#footnote-ref-1238)
1238. 336.20516 U.S. 233, 116 S. Ct. 804, 133 L. Ed. 2d 610 (1996). [↑](#footnote-ref-1239)
1239. 336.21As is customary in this posture, the *per curiam* order does not reveal which justices stood on which side. [↑](#footnote-ref-1240)
1240. 336.22Two other copyright cases had previously reached the Supreme Court, only to receive the identical resolution. Williams & Wilkins Co. v. United States, 487 F.2d 1345 (Ct. Cl. 1973)*, aff’d,* 420 U.S. 376, 95 S. Ct. 1344, 43 L. Ed. 2d 264 (1975); Benny v. Loew’s, Inc., 239 F.2d 532 (9th Cir. 1956)*, aff’d,* 356 U.S. 43, 78 S. Ct. 667, 2 L. Ed. 2d 583 (1958). See § 13.05[E] Ns. 577–588. [↑](#footnote-ref-1241)
1241. 336.23See, *e.g.*, Real View, LLC v. 20-20 Techs, Inc., 683 F. Supp. 2d 147, 154–168 (D. Mass. 2010). [↑](#footnote-ref-1242)
1242. 336.24750 F.3d 1339, 1366 (Fed. Cir. 2014). [↑](#footnote-ref-1243)
1243. 336.25135 S. Ct. 1021 (2015). [↑](#footnote-ref-1244)
1244. 336.26See *Brief of the United States as Amicus Curiae*, Case No. 14-410 (May 2015). The government disagreed with the Federal Circuit’s construction of Ninth Circuit law. *Id.* at 21. See § 2A.06[A][3][b] *supra*. [↑](#footnote-ref-1245)
1245. 336.27135 S. Ct. 2887 (2015). [↑](#footnote-ref-1246)
1246. 336.27aSee Google LLC v. Oracle America, Inc., 141 S. Ct. 1183 (2021). [↑](#footnote-ref-1247)
1247. 336.27bSee § 13.05[I] *infra*. [↑](#footnote-ref-1248)
1248. 336.28387 F.3d 522 (6th Cir. 2004). See § 12A.06[C][2][b] *supra*. It is to be added that a later Supreme Court opinion resulted from “the parties’ sprawling litigation.” Lexmark Int’l, Inc. v. Static Control Components, Inc., 134 S. Ct. 1377, 1385 n.2 (2014). See § 8D.05[C][2] *supra*. [↑](#footnote-ref-1249)
1249. 336.29387 F.3d at 530. [↑](#footnote-ref-1250)
1250. 336.30*Id*. at 530. [↑](#footnote-ref-1251)
1251. 336.31That program was extremely short. See § 12A.06[C][2][b] N. 185 *supra*.

      Lexmark claims copyright protection in, and infringement of, the code that composes its Toner LoadingProgram. It has not alleged that SCC copied any other portion of its chip, including any of the data on which the SHA-1 algorithm—the authentication sequence or “secret handshake”—appear. Presumably that is because SCC replaced Lexmark’s SHA-1 function with a different publicly available encryption program to enable interoperability of its chip with Lexmark’s printers.

      *Id*. at 537. [↑](#footnote-ref-1252)
1252. 336.32*Id*. at 536. In so ruling, the court quoted from an unpublished decision in the *Atari v. Nintendo* series of cases: “Program code that is strictly necessary to achieve current compatibility presents a merger problem, almost by definition, and is thus excluded from the scope of any copyright.” *Id*. See N. 336.33 *infra*. [↑](#footnote-ref-1253)
1253. 336.33

      When a work itself constitutes merely an idea, process or method of operation, or when any discernible expression is inseparable from the idea itself, or when external factors dictate the form of expression, copyright protection does not extend to the work.

      387 F.3d at 538. [↑](#footnote-ref-1254)
1254. 336.34“Just as it failed to suffice in *Feist* that the author of the competing telephone book could have organized the listings in some manner other than the individual’s last name, so it does not suffice here that SCC could have written the Toner Loading Program in some other way. As in *Feist*, the court must ask whether the alternative ways of putting together the competing work are feasible in that setting.” *Id*. at 538. On the *Feist* case, see § 13.03[E][1][b] *supra*. [↑](#footnote-ref-1255)
1255. 336.35On this issue, one judge disagreed. See 387 F.3d at 553–565 (Feikens, J., concurring in part and dissenting in part). [↑](#footnote-ref-1256)
1256. 336.36*Id*. at 539. [↑](#footnote-ref-1257)
1257. 336.37Note that even the dissenter agreed with the majority that the district court “erred in its factual findings supporting the conclusion that the TLP was not functioning as a lock-out code.” *Id*. at 554 (Feikens, J., concurring in part and dissenting in part). The difference between the views of District Judge Feikens and the two other circuit judges who comprised the panel revolved around competing notions of the merger doctrine. According to the majority, the Toner Loading Program’s status as a lock-out code deprived it of copyright protection at the outset, as expression merged with function; under the dissent’s view, by contrast, the TLP remained protected by copyright but a defense to infringement lies in the context of copying the TLP for purposes of interoperability. *Id*. at 557–558 (Treatise cited). [↑](#footnote-ref-1258)
1258. 336.38*Id*. at 541. The opinion contrasts its facts with those pertaining under Atari Games Corp. v. Nintendo of Am. Inc., 975 F.2d 832 (Fed. Cir. 1992), in which a data stream to achieve compatibility could have been produced through a variety of alternative means. See 387 F.3d at 543. [↑](#footnote-ref-1259)
1259. 336.39*Id*. at 542. [↑](#footnote-ref-1260)
1260. 336.40*Id*. at 544. [↑](#footnote-ref-1261)
1261. 336.41See N. 336.32 *supra*. [↑](#footnote-ref-1262)
1262. 336.42Oracle Am., Inc. v. Google Inc., 750 F.3d 1339, 1368–72 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 2887 (2015). See § 2A.10[B][4] *supra*. [↑](#footnote-ref-1263)
1263. 337Autoskill Inc. v. National Educ. Support Sys., Inc., 994 F.2d 1476, 1494 (10th Cir.), *cert. denied*, 510 U.S. 916, 114 S. Ct. 307, 126 L. Ed. 2d 254 (1993) (Treatise quoted); Micro Consulting, Inc. v. Zubeldia, 813 F. Supp. 1514, 1526 n.12 (W.D. Okla. 1990) (Treatise quoted), *aff’d mem.,* 959 F.2d 245 (10th Cir. 1992). “Such material is free for the taking. …” Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 710 (2d Cir. 1992) (Treatise cited). See Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 54 (2d Cir. 1936), *aff’d*, 309 U.S. 390, 60 S. Ct. 681, 84 L. Ed. 825 (1940). [↑](#footnote-ref-1264)
1264. 337.1See § 13.03[B][2][c] *supra*. [↑](#footnote-ref-1265)
1265. 337.2For instance, in Apple Computer, Inc. v. Microsoft Corp., 717 F. Supp. 1428 (N.D. Cal. 1989), Apple had entered into a 1985 settlement agreement with Microsoft, with respect to Windows 1.0. Microsoft urged that agreement as a defense to Apple’s later infringement claim against Windows 2.03. In particular, defendants Microsoft and Hewlett-Packard claimed that 178 of the 189 contested features were covered by the subject license agreement. The court agreed in large part with defendants, granting them summary adjudication with respect to licensed elements. The court further ruled that Apple could go to trial with respect to the unlicensed features. *Id*. at 1435. In a later opinion, the court also removed from the calculus similarities solely in idea, again congruent with the filtering approach described herein. See 759 F. Supp. 1444, 1452 (N.D. Cal. 1991)*, amended,* 779 F. Supp. 133 (N.D. Cal. 1991). The Ninth Circuit affirmed. 35 F.3d 1435 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995). See the discussion of this case in § 13.03[F][5] *infra*. [↑](#footnote-ref-1266)
1266. 337.3See Assessment Techs. of WI, LLC v. WIREdata, Inc., 361 F.3d 434, 436 (7th Cir. 2004) (Treatise cited) (noting “restrictions with which copyright is hedged about, of which the most pertinent is that … once work enters the public domain it cannot be appropriated as private (intellectual) property”). Note the later decision following the fair use holding in that case. See Madison River Mgmt. Co. v. Business Mgmt. Software Corp., 387 F. Supp. 2d 521, 539 (M.D.N.C. 2005), *reh. denied*, 402 F. Supp. 2d 617, 621–622 (M.D.N.C. 2005). [↑](#footnote-ref-1267)
1267. 338A computer bulletin board consists of a host computer system, telephone modem, and appropriate software. Users of such a system can dial the host computer and copy programs from the host system to their own systems and *vice versa*. In addition, users of such systems may exchange electronic mail. Many of these systems are open to any member of the public with a personal computer and modem, and the volume of software available through such systems is enormous. See, *e.g.,* A. Glossbrenner, *The Complete Handbook of Personal Computer Communications* 478–500 (1985). [↑](#footnote-ref-1268)
1268. 339See, *e.g.,* B. Kernighan & P. Plauger, *Software Tools,* at preface (1976) (“[P]rofessional programmers will find [this text] a guide to good programming techniques and a source of proven, useful programs”). [↑](#footnote-ref-1269)
1269. 340See 17 U.S.C. § 102(a) (1978); Lauratex Textile Corp. v. Citation Fabrics Corp., 328 F. Supp. 554, 556 (S.D.N.Y. 1971) (refusal to find that defendant’s fabric design infringed plaintiff’s copyrighted design when both designs were nothing more than slight variations on an idea in the public domain). In Qad. Inc. v. ALN Assocs., Inc., 770 F. Supp. 1261 (N.D. Ill. 1991), *aff’d,* 974 F.2d 834 (7th Cir. 1992), plaintiff obtained a preliminary injunction against defendant based on numerous similarities in their respective programs; when subsequent evidence revealed that plaintiff had not originated those common features, but instead had derived them from a prior work, the court sanctioned plaintiff by dismissing its suit altogether. [↑](#footnote-ref-1270)
1270. 341To belabor the point, a plaintiff’s program may be exceedingly similar to a defendant’s. On that basis, an unschooled factfinder could conclude immediately that infringement exists. However, once the scenes a faire and the public domain elements, for instance, have been eliminated from plaintiff’s program, it is possible that only 10% of the program will remain. At that point, the remaining similarity may present a much more difficult question of infringement. [↑](#footnote-ref-1271)
1271. 342Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 707 (2d Cir. 1992) (Treatise quoted). As previously noted (see N. 283.4 *supra*), *Altai* labels this core the “golden nugget.” See Farmers Indep. Tel. Co. v. Thorman, 648 F. Supp. 457, 460 (W.D. Wis. 1986) (“only the elements of a work that are protected by copyright cannot be appropriated”). This rule must not obscure the general proposition that copyright may inhere, under appropriate circumstances, in the selection and arrangement of unprotected components. Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1476 n.4 (9th Cir.), *cert. denied*, 506 U.S. 869, 113 S. Ct. 198, 113 L. Ed. 2d 141 (1992) (Treatise quoted). See Roulo v. Russ Berrie & Co., 886 F.2d 931, 939 (7th Cir. 1989) (jury allowed to consider similarities in greeting cards such as color, paper, ink, stripes, borders, that are not themselves copyrightable). [↑](#footnote-ref-1272)
1272. 343For example, in Manufacturers Technologies, Inc. v. Cams, Inc., 706 F. Supp. 984 (D. Conn. 1989), after filtering out unprotected elements in plaintiff’s screen displays—such as those dictated by functional requirements, *id*. at 993, those that lacked originality, *id*. at 996, and those that were drawn from “a very narrow range of possibilities,” *id*. at 995—the court concluded that some of the remaining similarities did not rise to the level of being substantial. *Id*. at 1002. However, the court also concluded that some alleged functional constraints in plaintiff’s programs were in fact protectible, *id.* at 994, and that some similarities (that did not serve functional purposes and in fact confused the user) were probative of copying, *id.* at 1001. In sum, after filtering out unprotected elements, the court concluded that the remaining similarities were substantial, thus warranting a judgment of infringement. Cf. Levine v. McDonald’s Corp., 735 F. Supp. 92, 95–96 (S.D.N.Y. 1990) (court rejects defendant’s claim that patter section of song, similar to plaintiff’s song, is uncopyrightable). [↑](#footnote-ref-1273)
1273. 344See § 13.03[E][3][a][i] *supra*. As noted therein, the first question that *Arnstein* poses is whether defendant has copied from plaintiff; the second question is whether such copying goes so far as to constitute *improper* appropriation. See *id*. [↑](#footnote-ref-1274)
1274. 345Brown Bag Software v. Symantec Corp, 960 F.2d 1465, 1476 n.4 (9th Cir.), *cert. denied*, 506 U.S. 869, 113 S. Ct. 198, 121 L. Ed. 2d 141 (1992) (Treatise cited). See § 13.03[E][3][b][iii] *supra*. Thus, returning to the example of N. 341 *supra*, eliminating scenes a faire and public domain elements—which elimination the Ninth Circuit permits given that computer programs are functional works—may leave only 10% of plaintiff’s program available for comparison with defendant’s program. The result could be a ruling in favor of either plaintiff or defendant, depending on the evaluation of the significance of that appropriated 10%. [↑](#footnote-ref-1275)
1275. 345aReal View, LLC v. 20-20 Techs, Inc., 683 F. Supp. 2d 147, 157 (D. Mass. 2010) (Treatise quoted); Softel, Inc. v. Dragon Medical and Scientific Communications, Inc., 118 F.3d 955, 964 (2d Cir. 1997) (Treatise quoted). [↑](#footnote-ref-1276)
1276. 345.1Apple Computer, Inc. v. Microsoft Corp., 779 F. Supp. 133, 136 (N.D. Cal. 1991), *aff’d (rev’d as to fees),* 35 F.3d 1435, 1444 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995). By the same token, one could mechanically go through Hamlet’s soliloquy, determining that each individual word (“to,” “be,” “or,” “not,” etc.) is uncopyrightable, and thereupon draw the erroneous conclusion that Shakespeare lacked originality in the copyright sense. Softel, Inc. v. Dragon Medical and Scientific Communications, Inc., 118 F.3d 955, 964 (2d Cir. 1997) (Treatise cited). See Baldine v. Furniture Comfort Corp., 956 F. Supp. 580, 587 (M.D.N.C. 1996) (“one can not copyright a word but can copyright many words grouped into a poem”). [↑](#footnote-ref-1277)
1277. 345.2As noted above, the court’s hypothetical characterizes the geometric forms as being “arranged in an original pattern.” Such an arrangement is entitled to copyright protection, albeit thin. See § 13.03[A][4] *supra*. [↑](#footnote-ref-1278)
1278. 345.3Real View, LLC v. 20-20 Techs, Inc., 683 F. Supp. 2d 147 (D. Mass. 2010) (Treatise quoted); Trek Leasing, Inc. v. United States, 66 Fed. Cl. 8, 22–23 (2005) (Treatise quoted). In *Apple Computer, Inc. v. Microsoft Corp.,* the court reasoned that if “the works are deemed substantially similar, then copyright infringement will be established even though the copyrighted work is composed of unprotectible elements.” 779 F. Supp at 136. In reality, even if two works are substantially similar to the point of being identical, copyright infringement will *not* be established to the extent that the copyrighted work is composed entirely of unprotectible elements. See the discussion of Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991), in § 13.03[B][2][b] *supra*. [↑](#footnote-ref-1279)
1279. 345.4Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 710 (2d Cir. 1992) (Treatise cited); Autoskill Inc. v. National Educ. Support Sys., Inc., 994 F.2d 1476, 1496 (10th Cir.), *cert. denied*, 510 U.S. 916, 114 S. Ct. 307, 126 L. Ed. 2d 254 (1993) (Treatise quoted); Apple Computer, Inc. v. Microsoft Corp., 821 F. Supp. 616, 623 (N.D. Cal. 1993) (Treatise quoted), *aff’d (rev’d as to fees),* 35 F.3d 1435, 1444 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995). [↑](#footnote-ref-1280)
1280. 345.5For instance, one case held that clicking a mouse instead of a key pad to enter zeroes, together with four other similarities, was too minimal to constitute infringement. MiTek Holdings v. Arce Eng’g Co., 864 F. Supp. 1568, 1584 (S.D. Fla. 1994) (Treatise cited), *aff’d*, 89 F.3d 1548, 1560 (11th Cir. 1996) (Treatise quoted). Another likewise concluded that a “series of mouse-clicks, however original and idiosyncratic, is not entitled to copyright protection.” Real View, LLC v. 20-20 Techs, Inc., 683 F. Supp. 2d 147, 162 (D. Mass. 2010). [↑](#footnote-ref-1281)
1281. 346Computer Assocs. Int’l, Inc. v. Altai, Inc., 982 F.2d 693, 715 (2d Cir. 1992) (Treatise cited); Apple Computer, Inc. v. Microsoft Corp., 821 F. Supp. 616, 623 (N.D. Cal. 1993) (Treatise quoted), *aff’d (rev’d as to fees),* 35 F.3d 1435, 1444 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184, 115 S. Ct. 1176, 130 L. Ed. 2d 1129 (1995). See § 13.03[A][2] *supra*. See also E.F. Johnson Co. v. Uniden Corp., 623 F. Supp. 1485, 1498–1500 (D. Minn. 1985) (more than trivial contribution required to sustain computer software copyright). [↑](#footnote-ref-1282)
1282. 347MiTek Holdings, Inc. v. Arce Eng’g Co., 89 F.3d 1548, 1560 (11th Cir. 1996) (Treatise quoted). The method proposed herein is designed neither to favor plaintiffs nor defendants. At times, following the successive filtering, no protectible elements remain and judgment should issue for defendant. See, *e.g.,* Micro Consulting, Inc. v. Zubeldia, 813 F. Supp. 1514 (W.D. Okla. 1990), *aff’d mem.,* 959 F.2d 245 (10th Cir. 1992); Data East USA, Inc., v. Epyx, Inc., 862 F.2d 204 (9th Cir. 1988); NEC Corp. v. Intel Corp., 1989 Copyright L. Dec. (CCH) ¶ 26,379, 10 U.S.P.Q.2d 1177 (N.D. Cal. 1989). At other times, the amount of protectible material remaining is sufficient to constitute infringement and judgment should issue for plaintiff. See, *e.g.,* CMAX/Cleveland, Inc. v. UCR, Inc., 804 F. Supp. 337, 352 n.14, 356 (M.D. Ga. 1992) (same result as *Whelan* would yield); Autoskill Inc. v. National Educ. Support Sys., Inc., 994 F.2d 1476 (10th Cir.), *cert. denied*, 510 U.S. 916, 114 S. Ct. 307, 126 L. Ed. 2d 254 (1993) (preliminary injunction); Lotus Dev. Corp. v. Paperback Software Int’l, 740 F. Supp. 37 (D. Mass. 1990); Atari Games Corp. v. Nintendo of Am., 30 U.S.P.Q.2d (BNA) 1401 (N.D. Cal. 1993) (Treatise cited); Manufacturers Technologies, Inc. v. Cams, Inc., 706 F. Supp. 984 (D. Conn. 1989); Pearl Sys., Inc., Competition Elecs., Inc., 1988 Copyright L. Dec. (CCH) ¶ 26,338 (S.D. Fla. 1988) (“These similarities were not constrained by product function.”). See § 13.03[F] N. 283.2 *et seq. supra*. [↑](#footnote-ref-1283)
1283. 348Compulife Software Inc. v. Newman, 959 F.3d 1288, 1302 (11th Cir. 2020) (Treatise quoted); Gates Rubber Co. v. Bando Am., Inc., 798 F. Supp. 1499, 1518 (D. Colo. 1992) (Treatise cited), *aff’d in part, vacated in part,* 9 F.3d 823 (10th Cir. 1993). The perils facing software developers should not be discounted. Losses from software piracy in 1986 alone were estimated at $800 million. Vault Corp. v. Quaid Software Ltd., 847 F.2d 255, 261 n.13 (5th Cir. 1988). [↑](#footnote-ref-1284)
1284. 349The more creative plaintiff’s work, the broader the protection that should be conferred on it. See Landsberg v. Scrabble Crossword Game Players, Inc., 736 F.2d 485, 488–489 (9th Cir. 1984). [↑](#footnote-ref-1285)
1285. 350See § 13.01[B] *supra*. [↑](#footnote-ref-1286)
1286. 351See Novelty Textile Mills, Inc. v. Joan Fabrics Corp., 558 F.2d 1090 (2d Cir. 1977). [↑](#footnote-ref-1287)
1287. 352See § 13.04–13.09 *infra*. [↑](#footnote-ref-1288)
1288. 353See § 13.05 *infra*. For part of the fair use analysis, it is appropriate to look only to the appropriation of protectible expression, not of unprotectible facts. Salinger v. Random House, Inc., 811 F.2d 90, 97 (2d Cir. 1987). That method obviously comports with the analysis set forth above. [↑](#footnote-ref-1289)
1289. 354For an application of this analysis to the facts of *Whelan*, see Nimmer, Bernacchi, & Frischling, *A Structured Approach to Analyzing the Substantial Similarity of Computer Software in Copyright Infringement Cases,* 20 Ariz. St. L.J. 625, 651–656 (1988). [↑](#footnote-ref-1290)
1290. 355See, *e.g.,* Hartman v. Hallmark Cards, Inc., 833 F.2d 117 (8th Cir. 1987) (discarding similarities of “either noncopyrightable ideas, scenes a faire, or of an insubstantial nature”). [↑](#footnote-ref-1291)
1291. 356Interestingly, the *Whelan* court recognized the logic of rooting its analysis in existing copyright doctrines, so as to avoid radical discontinuities in the law. Whelan Assocs. v. Jaslow Dental Lab., 797 F.2d 1222, 1234, 1240, 1246 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031, 107 S. Ct. 877, 93 L. Ed. 2d 831 (1987). Nonetheless, the Third Circuit’s opinion in *Whelan* departs substantially from those traditional copyright principles. See § 13.03[A][1][d] *supra*. [↑](#footnote-ref-1292)