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DO WE EVEN NEED A TEST? A REEVALUATION OF ASSESSING SUBSTANTIAL SIMILARITY IN A COPYRIGHT INFRINGEMENT CASE

*Nicole K. Roodhuyzen**

INTRODUCTION

The task of proving that one creative work is similar enough to another creative work so as to constitute copyright infringement may be even more difficult than creating the work in the first place. The improper appropriation¹ analysis, for both courts and litigants, is one of the most contentious and least precisely defined inquires in copyright law.² There are multiple

* Brooklyn Law School Class of 2008; B.A. Georgetown University, 2003. The author wishes to thank her parents, David and Lori Roodhuyzen; sisters, Erin Roodhuyzen and Jasmine Wright; Grandma, Wigay Wix and Nancy Wright for their constant love and support. She would also like to thank Mark O'Sullivan and her friends who provided support and encouragement throughout this process. She would also like to express gratitude to Professor Beryl Jones-Woodin, Professor Aliza Kaplan, David Kaye, Heather Maly and the members of the *Journal of Law and Policy* for all their help and hard work in creating this final product.

¹ "Improper appropriation" in this context refers to copying prohibited by §§ 106(1) and 106(2) of the Copyright Act. Courts often use this terminology when assessing claims for infringement of the reproduction right, § 106(1) and the derivative work right, § 106(2). In a two-part inquiry, courts will first consider whether the defendant copied-in-fact or "copied" the plaintiff's work. They will then assess whether the defendant also engaged in "improper appropriation" or "infringing copying" in violation of, for example, § 106(1). See JULIE E. COHEN ET AL., *COPYRIGHT IN A GLOBAL INFORMATION ECONOMY* 323 (2nd ed. 2006).

² CRAIG JOYCE, MARSHALL LEAFFER, PETER JASZI & TYLER T. OCHOA,

tests for copyright infringement and the analysis is often complicated and elusive.³ Nevertheless, plaintiffs continue to file suits claiming that their creative works have been infringed and courts must establish effective ways to determine whether the works are similar enough to rise to the level of improper appropriation.

A plaintiff who feels that her work has been infringed upon by a similar work must demonstrate to the court that the similarity constitutes infringement under federal copyright law.⁴ If a court decides that the works are similar, it is often difficult to determine whether the court applied a test to reach its conclusion or rather utilized a test to explain the perceived similarity.⁵ At times, it may seem like courts are going by an “I know it when I see it” means to determine similarity.⁶

There is a great amount of confusion among courts and commentators as to what the proper test is for determining whether two works are “substantially similar” so as to constitute copyright infringement. The various tests currently available are ultimately supposed to further the underlying goal of copyright law, which is to “promote the Progress of Science and useful

COPYRIGHT LAW 692 (6th ed. 2003).

³ Robert Bernstein & Robert W. Clarida, ‘*Ay There’s the Rug*,’ N.Y.L.J., Sept. 19, 2003, at 3.

⁴ See B. MacPaul Stanfield, Note, *Finding the Fact of Familiarity: Assessing Judicial Similarity Tests in Copyright Infringement Actions*, 49 DRAKE L. REV. 489, 492 (2001).

⁵ *Id.* It is possible that the tests currently articulated by the Circuits are not a means to determine similarity, but rather a means to explain a finding of similarity that is determined in such a way that defies clear explanation The confusing array of tests is not merely a means to prove similarity; it provides a lexicon to explain what is similar, the extent of similarity, and whether the similarity constitutes copyright infringement.

Id. at 512.

⁶ *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) (Stewart, J., concurring) (stating with regard to a definition of pornography and obscenity: “I shall not today attempt further to define the kinds of material I understand to be embraced within that shorthand description; and perhaps I could never succeed in intelligibly doing so. But I know it when I see it . . .”).

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Arts.”⁷ Thus, courts are ultimately supposed to establish incentives for the creation of artistic works.

However, despite the uniform policy underlying copyright law, courts have created a variety of conflicting and often times confusing tests. Currently, there are two main tests that most courts follow: (1) the ordinary observer test associated with the Second Circuit and (2) the Ninth Circuit’s extrinsic/intrinsic test. Some courts utilize the abstraction/filtration/comparison test, while others use variations or a combination of each of these tests.

In addition to the confusion about what test should be used, the tests that have been articulated by the circuits are complicated and vague.⁸ Compounding the problem, courts frequently apply the tests inconsistently and incorrectly.⁹ As a result, decisions in copyright infringement cases are unpredictable and often seem ad hoc.¹⁰ As the tests become increasingly elusive for both courts and litigants, it is important to consider whether there should be one single test articulated by the Supreme Court, or rather, whether there should be a test at all.

It is therefore important to examine and critique the myriad of tests currently available to determine whether two works are substantially similar, and to articulate an approach more aligned with the underlying policies of copyright law.

Part I of this Note will briefly review the history and purpose of copyright law. Part II will present an overview of the origin of substantial similarity in copyright infringement cases. Part III examines the different approaches articulated by the circuits to assess substantial similarity. While this examination is lengthy, it is necessary to effectuate the solution proffered by

⁷ U.S. CONST. art. I, § 8, cl. 8.

⁸ Jarrod M. Mohler, Comment, *Toward a Better Understanding of Substantial Similarity in Copyright Infringement Cases*, 68 U. CIN. L. REV. 971, 972 (2000).

⁹ *Id.*

¹⁰ Jeannette R. Busek, Comment, *Copyright Infringement: A Proposal for a New Standard for Substantial Similarity Based on the Degree of Possible Expressive Variation*, 45 UCLA L. REV. 1777, 1778 (1998).

this Note. Finally, Part IV proposes that courts should cease attempting to create a single test for substantial similarity. Proving similarity and infringement is not amenable to a one-size-fits-all test, especially given the many categories of expressions and types of media that are protected by copyright.¹¹ Instead of trying to wade through the confusing array of tests available or attempting to articulate a single test, courts should articulate a standard that goes to the ultimate purpose of copyright law. Thus, in order to determine if there has been copyright infringement, a court should determine whether or not providing relief for the owner of the copyright will enhance the policy goals of copyright law and the objectives of Congress.

I. COPYRIGHT LAW IN GENERAL

The following sections will discuss the policy considerations underlying federal copyright law and the elements that are required in order for a plaintiff to bring an action for copyright infringement.

A. *General Policy Considerations Behind Copyright Law*

The United States Constitution empowered Congress to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”¹² The current governing statute enacted by Congress is the Copyright Act of 1976.¹³ Copyright protection is extended to “authors”¹⁴ for any

¹¹ Stanfield, *supra* note 4, at 512.

¹² U.S. CONST. art. I, § 8, cl. 8.

¹³ Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541. The first copyright law, enacted by Congress in 1790, provided for two 14-year terms of protection and was entitled: “An act for the encouragement of learning.” COHEN, ET AL., *supra* note 1, at 22 (quoting Copyright Act of 1790, 1st Cong., 2d Sess., ch. 15, 1 Stat. 124 (1790)). In 1909, the Copyright Act underwent an overhaul, including revisions to the categories of works protected by the law and an extension of the term of copyright protection.

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“original works of authorship fixed in any tangible medium of expression”¹⁵ for a given period of time.¹⁶ Works that come within the scope of the Copyright Act are afforded strong protections, for example “the Act specifies in detail the kinds of works that are protected and for how long; creates protection even without registration or notice; assigns exclusive rights and allows for transfer and division of ownership and rights; and creates various remedies including damages and fines.”¹⁷

While Congress provided a benefit to a copyright holder in granting specific exclusive rights to uses pertaining to reproduction, preparation of derivative works, distribution, and public performances and displays of the work,¹⁸ the primary

COHEN ET AL., *supra* note 1, at 24-26. The 1976 Copyright was enacted as a result of the emergence of new technologies and the perceived inadequacies of the 1909 Act. *Id.* at 27. While the 1976 Act has undergone changes since it took effect on January 1, 1978, it provides the basic structure for copyright law in the United States today. *Id.*

¹⁴ 17 U.S.C. § 201(a) (“Copyright in a work protected under this title vests initially in the author or authors of the work.”).

¹⁵ 17 U.S.C. § 102(a).

¹⁶ *Id.* Jason Mazzone has also opined:

To the benefit of authors, Congress has taken a liberal view of its constitutional power to afford protection for ‘limited Times.’ In the very first copyright statute, the period of copyright lasted just fourteen years, renewable for an additional fourteen years. As a result of the amendments to the 1976 Act made by the Copyright Term Extension Act of 1998, copyright in works created on or after January 1, 1978 now lasts for the life of the author plus seventy years.

Jason Mazzone, *Copyfraud*, 81 N.Y.U. L. REV. 1026 (2006) (citations omitted).

¹⁷ Mazzone, *supra* note 16.

¹⁸ 17 U.S.C. § 106. The exclusive rights of a copyright owner are set forth in § 106 of the Copyright Act:

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted

purpose of copyright law is to benefit the public.¹⁹ As a result, courts are forced to deal with two conflicting public policy factors. On one side “the law seeks to encourage new authors by protecting their works” and on the other “the law does not want to give any one author a monopoly over an idea so as to foreclose future authors from building on that idea.”²⁰ Thus, courts are left with the difficult task of encouraging creativity by affording authors the opportunity to reap the benefits of their creative works, while simultaneously permitting future authors to create new works by expanding upon the ideas of others.²¹

In order to effect the constitutional goal of “promot[ing] the Progress of Science and useful Arts,”²² copyright legislation “assures authors the right to their original expression, but encourages others to build freely upon the ideas and information

work;

(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly and;

(6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission. *Id.*

¹⁹ Stanfield, *supra* note 4, at 493.

²⁰ Busek, *supra* note 10, at 1777-78.

²¹ Mohler, *supra* note 8, at 974; *see also* Warner Bros. Inc. v. American Broadcasting Companies, 720 F.2d 231, 240 (2d Cir. 1983) (stating that “[i]t is a fundamental objective of copyright law to foster creativity. However, that law has the capacity both to augment and diminish the prospects for creativity. By assuring the author of an original work the exclusive benefits of whatever commercial success his or her work enjoys, the law obviously promotes creativity. At the same time, it can deter the creation of new works if authors are fearful that their creations will too readily be found to be substantially similar to preexisting works.”).

²² U.S. CONST. art. I, § 8, cl. 8.

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conveyed by a work.”²³ Thus, it is a fundamental precept of copyright law that ideas and facts are not protected—only the expression of an idea can be protected.²⁴ This distinction has the purpose of defining the line between what can be protected by copyright law and what should remain in the public domain.²⁵

But, making the distinction between idea and expression is often difficult.²⁶ In *Nichols v. Universal Pictures Corp.*, Judge Learned Hand provided the following guidance:

Upon a work . . . a great number of patterns increasingly 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 [work] is about, and at times consist only of its title; but there is a point in this series of abstraction where they are no longer protected, since otherwise the [author] could prevent the use of his “ideas” to which, apart from their expression, his property is never extended.²⁷

²³ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349-50 (1991).

²⁴ *Mazer v. Stein*, 347 U.S. 201, 207 (1954); *see also* 17 U.S.C. § 102(b) (asserting that “[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”).

²⁵ COHEN ET AL., *supra* note 1, at 72.

²⁶ *See id.* at 74, 80.

²⁷ 45 F.2d 119, 121 (2d Cir. 1930). This is what many commentators and courts call the “abstractions test.” While this test has

received continuous use by courts in copyright infringement cases, it has also been criticized by courts and commentators as not being at “test” at all The abstractions test, in reality, is just a restatement of general policy that copyright law protects the expression of ideas but not the ideas themselves. The test provides no further guidance or insight into which works should be protected. Thus, although courts often cite the test as reasoning for their decisions, such citations ultimately fail to explain the underlying reason why courts decide copyright cases as they do.

Busek, *supra* note 10, at 1789 (internal quotation marks omitted) (quoting

In *Nichols*, Hand articulated a standard that is not so much a way for courts to perceive similarity but rather a means to separate ideas from the expression of those ideas.²⁸

This idea-expression dichotomy plays an important role in ultimately determining whether a copyrighted work has been infringed. Federal copyright law endeavors to strike the proper balance between protecting an author's expression of an idea and encouraging the idea itself.²⁹ As a result, courts must address what is similar about two works and if the only similarity shared is similar ideas, then there has been no infringement.³⁰ The court must determine whether there are similarities in expression between two works, and if similarities in expression do exist, whether they cross a threshold of similarity that constitutes copyright infringement.

The distinction between ideas and expression is a source of great confusion for courts and litigants. Unfortunately, there is no bright line rule as to what constitutes an idea and what constitutes an expression of that idea. As such, courts must engage in a delicate balancing between idea and expression when assessing whether two works are substantially similar so as to constitute copyright infringement.

A major concern with courts providing too much protection when making distinctions between idea and expression is that eventually nothing would be left in the public domain and incentives to create new works would vanish because an author would find it difficult not to infringe upon previous authors' works.³¹ Unfortunately, the tests currently available to assess substantial similarity do not provide courts with adequate guidance on making these difficult distinctions between what is protectible and what is unprotectible.

Nash v. CBS, Inc., 899 F.2d 1537, 1540 (7th Cir. 1990)).

²⁸ Stanfield, *supra* note 4, at 500.

²⁹ Busek, *supra* note 10, at 1778.

³⁰ Warner Bros. Inc. v. Am. Broad. Cos., 720 F.2d 231, 239 (2d Cir. 1983) (stating that "[t]he similarity to be assessed must concern the expression of ideas, not the ideas themselves.").

³¹ Mohler, *supra* note 8, at 974.

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B. Elements of a Copyright Infringement Claim

A plaintiff bringing a claim for copyright infringement must prove two elements: (1) ownership of a valid copyright and (2) that defendant violated one of the exclusive rights under section 106 of the Copyright Act (e.g., the right to reproduce the copyrighted work in copies or phonorecords, §106(1), or the right to prepare derivative works, §106(2)).³² In general, with respect to the first element, the copyright registration certificate serves as *prima facie* evidence for the plaintiff that a valid copyright exists.³³ With respect to the second element, for claims of violations of the right to reproduce the work, §106(1), the plaintiff must prove “copying of the constituent elements of the work that are original.”³⁴

Proof of copying consists of two separate components.³⁵ First, there is the issue of whether copying occurred.³⁶ Next, there is the issue of whether such copying is actionable (i.e.

³² COHEN ET AL., *supra* note 1, at 314. “Notably absent from this formulation of the *prima facie* case is damage or any harm to plaintiff resulting from the infringement.” Nimmer on Copyright § 13.01, 4-13 [hereinafter Nimmer].

³³ See Nimmer § 13.01[A].

³⁴ Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991).

³⁵ See Nimmer § 13.01[B].

³⁶ *Id.* (stating that “[i]t is generally not possible to establish copying as a factual matter by direct evidence, as it is rare that the plaintiff has available a witness to the physical act of copying Therefore, copying is ordinarily established indirectly by the plaintiff’s proof of access and substantial similarity [I]n the previous formulation, the term ‘substantial similarity’ [should] be discarded in favor of ‘probative similarity.’ In other words, when the question is copying as a factual matter, then similarities that, in the normal course of events, would not be expected to arise independently if the two works are probative of defendant’s having copied as a factual matter from plaintiff’s work [D]espite proof of access and probative similarity, the trier of fact may be upheld in finding no copying if such trier believes the defendant’s evidence is an independent creation, except where the similarity between the two works is such that no explanation other than copying is reasonably possible.”).

whether there was too much copying).³⁷ A plaintiff must demonstrate both copying and too much copying in order to prevail.³⁸ Therefore, even where a defendant concedes copying, no legal consequences will follow unless the court determines that the copying is substantial.³⁹ In order to establish that there has been too much copying, or improper appropriation, a plaintiff must show that there is substantial similarity between the plaintiff's work and defendant's work.⁴⁰

II. SUBSTANTIAL SIMILARITY: AN OVERVIEW

Substantial similarity is a concept that is mystifying for both courts and litigants.⁴¹ In order for an appropriation to be actionable, a plaintiff must demonstrate that defendant's work is substantially similar to plaintiff's work such that defendant is liable for copyright infringement.⁴² Substantial similarity is a conclusion; it is not a formula or a test.⁴³

It is the task of the court to determine whether the defendant's copying is sufficient to constitute infringement. The scope of works that copyright law protects is very broad: from literary works, including books, movies and poems, to sculptures, paintings and photographs, to musical works and computer programs.⁴⁴ In attempting to cover such a variety of

³⁷ *See id.*

³⁸ *See id.* (explaining that "copying as a factual matter is insufficient if improper appropriation is lacking. Conversely, even when two works are substantially similar with respect to protectible expression, if the defendant did not copy as a factual matter, but instead independently created the work at issue, then infringement liability must be denied.").

³⁹ *See id.* § 13.03[A].

⁴⁰ *See id.*

⁴¹ *See* Eric C. Osterberg, *The Meaning and Significance of Substantial Similarity*, 863 PLI/PAT 23, 28 (2006).

⁴² *See* Nimmer § 13.01[B].

⁴³ Osterberg, *supra* note 41, at 29.

⁴⁴ The statutory coverage of copyright law provides that:

[w]orks of authorship include the following categories: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music;

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works, the current standards for assessing substantial similarity adopted by courts are unclear, with results that are “inevitably ad hoc.”⁴⁵

Currently, there is a split in the circuit courts regarding which test is proper for assessing whether protectible elements in a work are substantially similar in a copyright infringement claim.⁴⁶ Courts continually attempt to fashion and re-work tests in an effort to reduce the amount of confusion and clarify the notion of substantial similarity. However, these efforts have ultimately led to more confusion and ambiguity about the appropriate standard for determining whether two works are substantially similar.⁴⁷

There are two primary tests that most courts follow: the “ordinary observer” test associated with the Second Circuit or the two-part “extrinsic/intrinsic” test associated with the Ninth Circuit.⁴⁸ The “ordinary observer” test adopted by the Second Circuit asks “whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.”⁴⁹ In contrast, the Ninth Circuit has adopted an alternative two-part test that includes an objective extrinsic test and a subjective intrinsic test.⁵⁰ On the extrinsic prong the court engages in an objective comparison of specific expressive elements whereas on the subjective intrinsic prong the court

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- (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and audiovisual works; (7) sound recordings; (8) architectural works.

17 U.S.C. § 102(a).

⁴⁵ Busek, *supra* note 10, at 1778-79 (quoting *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960)).

⁴⁶ ROBERT C. OSTERBERG AND ERIC C. OSTERBERG, *SUBSTANTIAL SIMILARITY IN COPYRIGHT LAW* § 3, at 3-2 (Practicing Law Institute 2003) [hereinafter, OSTERBERG & OSTERBERG].

⁴⁷ See Busek, *supra* note 10, at 1779.

⁴⁸ *Murray Hill Publ'n, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312 (6th Cir. 2004); see also *Nimmer* § 13.03(E)(3).

⁴⁹ *Knitwaves, Inc v Lollytogs, Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995) (quoting *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 766 (2d Cir. 1991)) (internal quotation marks omitted).

⁵⁰ See *Swirsky v. Carey*, 376 F.3d 841, 845 (9th Cir. 2004).

focuses on the total concept and feel of the two works.⁵¹

While most courts use either the Second Circuit's "ordinary observer test"⁵² or the Ninth Circuit's "extrinsic/intrinsic test"⁵³ there are some variations. For example, the Tenth Circuit uses the abstraction/filtration/comparison test and the Sixth Circuit and the D.C. Circuit use a variation of this test.⁵⁴ The Eleventh Circuit uses a test that is similar to the tests used by the Second and Ninth Circuit before they diverged.⁵⁵

All of these tests have their merits and their faults. While they seem sound in theory, in reality, courts inconsistently apply them.⁵⁶ This inconsistency has led to confusion and unpredictability for courts and litigants as to where to draw the line between protectible and unprotectible material. None of the tests currently available provide a clear analytical framework. Additionally, none of the existing tests provide hard and fast rules for courts and litigants to follow.⁵⁷ The following sections attempt to bring clarity to this confusion by conducting a thorough examination of the various tests available for assessing substantial similarity.

⁵¹ See *Cavalier v. Random House*, 297 F.3d 815, 822 (9th Cir. 2002).

⁵² The circuits that follow the ordinary observer test are the First Circuit, the Third Circuit, the Fifth Circuit, and the Seventh Circuit. OSTERBERG & OSTERBERG, *supra* note 46, § 3, at 3-2.

⁵³ The circuits that follow the extrinsic/intrinsic test model are the Fourth Circuit and the Eighth Circuit. *See id.*

⁵⁴ OSTERBERG & OSTERBERG, *supra* note 46, § 3, at 3-2.

⁵⁵ *Id.*

⁵⁶ See Mohler, *supra* note 8, at 972.

⁵⁷ It is certainly debatable whether it is better to have clear rules or, rather, concepts and principles that people can use to regulate their lives. The difficulty with clear rules is they are often over or under inclusive; whereas, the difficulty with concepts and principles is that they are often unclear and it is difficult for people to regulate their lives with certainty.

III. CIRCUIT SPLITS: THE DIFFERENT APPROACHES FOR ASSESSING SUBSTANTIAL SIMILARITY

This section will examine the numerous tests available for assessing substantial similarity. First, this section will examine the “ordinary observer” test articulated by the Second Circuit followed by an analysis of the courts that follow the Second Circuit. Next, the “extrinsic/intrinsic” test associated with the Ninth Circuit will be analyzed followed by an assessment of the courts that follow the Ninth Circuit. Finally, this section will address the tests utilized by the remaining circuits, including the Abstraction/Filtration/Comparison test.

A. *The Second Circuit’s Ordinary Observer Test*

The Second Circuit’s test for assessing substantial similarity in a copyright infringement case is the “ordinary observer” test.⁵⁸ In *Peter Pan Fabrics, Inc. v. Martin Weinder Corp.*, a

⁵⁸ *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) (holding that in order to establish infringement, a plaintiff must prove both “(a) that defendant copied from plaintiff’s copyrighted work and (b) that the copying (assuming it to be proved) went too far as to constitute improper appropriation.”). Further,

The copyright infringement test in the Second Circuit is a step-by-step process. First, the court determines whether the defendant copied from the plaintiff. In cases where the defendant denies copying, the court tests to see whether the defendant had access to plaintiff’s work at the time defendant prepared his work, and whether there is sufficient similarity between the works to prove copying. The Second Circuit has clarified that the correct term for this threshold determination of similarity is “probative similarity” rather than “substantial similarity.” On the probative similarity issue, “analytic dissection” is appropriate and the testimony of experts may be received to aid the trier of facts If the court determines that there has been copying, then only does there arise the second issue, that of illicit copying “unlawful appropriation.” The court must then determine whether defendant’s taking is sufficient to constitute infringement. It is that part of the inquiry that is the “substantial

case involving the alleged infringement of a design printed on cloth, used to make women's dresses, Judge Learned Hand articulated that there is substantial similarity where "the ordinary observer, unless set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same."⁵⁹

More recently, in *Knitwaves, Inc. v. Lollytogs*, a case involving the infringement of plaintiff's copyrighted squirrel and leaf children's sweater designs, the Second Circuit stated that the ordinary observer test asks whether "an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work."⁶⁰ In making this assessment, courts examine the works' "total concept and feel."⁶¹

The Second Circuit allows the use of expert testimony on the issue of whether there was copying, but does not allow the use of expert testimony on the issue of whether there was too much copying (utilizing a substantial similarity analysis).⁶² In *Arnstein v. Porter*, the plaintiff, Ira B. Arnstein, brought an action

similarity" test.

OSTERBERG & OSTERBERG, *supra* note 46, § 3:1.1, at 3-3.

⁵⁹ *Peter Pan Fabrics, Inc. v. Martin Weinder Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

⁶⁰ *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995).

⁶¹ *Knitwaves, Inc.*, 71 F.3d at 1003.

The total concept and feel test has . . . been strongly criticized. Rather than clarifying what substantial similarity means, total concept and feel actually makes the inquiry even murkier. [N]o one knows what concept and feel means, and no court that uses the test has attempted to define the terms. Moreover, the test is problematic because it is contrary to the specific language of section 102(b) of the Copyright Act which clearly states that [i]n no case does copyright protection . . . extend to any . . . concept.

Busek, *supra* note 10, at 1803 (1998) (internal quotation marks omitted) (citing Matthew M. Fortnow, Note, *Why the "Look and Feel" of Computer Software Should Not Receive Copyright Protection*, 14 *CARDOZO L. REV.* 421, 425 (1992); 17 U.S.C. § 102(b)).

⁶² Further discussion of the Circuit's split regarding the use of expert testimony in assessing substantial similarity follows later in this Note at Section III.D.

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against Cole Porter for infringement of the copyright to his musical compositions.⁶³ The court in *Arnstein* justified the ordinary observer test being applied on the issue of assessing substantial similarity without any analytic dissection or expert opinion.⁶⁴ The judge rationalized that “[t]he plaintiff’s legally protected interest is not, as such, his reputation as a musician but his interest in the potential financial returns from his compositions which derive from the lay public’s approbation of his efforts.”⁶⁵ The question, therefore, is “whether defendant took from plaintiff’s work 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.”⁶⁶

Since its creation, the ordinary observer test has been criticized and as will be discussed later in this Note, this test has become a source of confusion and frustration as courts struggle to determine whether works should be evaluated from the viewpoint of the ordinary observer or as the above quote from *Arnstein* suggests, from the viewpoint of the intended audience.⁶⁷

One important concern with regard to courts in the Second Circuit allowing expert testimony on the issue of copying but not on the issue of too much copying is whether it is possible for courts to do this in reality.⁶⁸ As one court noted:

[T]he distinction between the two parts of the *Arnstein* test may be of doubtful value when the

⁶³ 154 F.2d at 468.

⁶⁴ *Id.* (finding that on the issue of “illicit copying (unlawful appropriation) . . . the test is the response of the ordinary lay hearer; accordingly, on that issue, ‘dissection’ and expert testimony are irrelevant”).

⁶⁵ *Id.* at 473.

⁶⁶ *Id.*

⁶⁷ Osterberg, *supra* note 41, at 29.

⁶⁸ It is possible that when courts describe similarities, they are getting that information from expert testimony that was allowed on the question of copying but then prohibited on the question of whether the two works were substantially similar. See *Whelan Assoc., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1232-33 (3d Cir. 1986).

finder of fact is the same person for each step: that person has been exposed to expert evidence in the first step, yet she or he is supposed to ignore or “forget” that evidence in analyzing the problem under the second step. Especially in complex cases, we doubt that the forgetting can be effective when the expert testimony is essential to even the most fundamental understanding of the objects in question.⁶⁹

Thus, the *Arnstein* limitation may be more theoretical than practical.⁷⁰ The other circuit courts have conflicting views on whether expert testimony may be utilized in assisting the fact finder with the substantial similarity analysis. The allowance or prohibition of expert testimony is one more confusing and controversial aspects of the current state of the circuit courts’ analyses of substantial similarity.

In the Second Circuit, both the issue of whether there was copying and the issue of whether there was too much copying (unlawful appropriation) are issues of fact for the jury.⁷¹ However, a court may determine “noninfringement as a matter of law on a motion for summary judgment either when the similarity concerns only noncopyrightable elements⁷² of plaintiff’s work, or when no reasonable trier of fact could find the works substantially similar.”⁷³

⁶⁹ *Id.*

⁷⁰ Michael Der Manuelian, Note, *The Role of the Expert Witness in the Music Copyright Infringement Cases*, 57 *FORDHAM L. REV.* 127, 145 (1988).

⁷¹ *Arnstein*, 154 F.2d at 469.

⁷² Alexandra DeNeve argues that:

Uncopyrightable elements include but are not limited to: (a) Ideas (copyright protects expression not ideas) (b) Systems or methods of operation ‘regardless of the form in which it is described explained, illustrated or embodied’ (see § 102) (c) Historical facts . . . (d) General facts . . . (e) Concepts (f) Character names (protected by trademark) (g) Undeveloped characters described in words (h) Scenes a faire.

Alexandra N. DeNeve, *Copyright Infringement Litigation*, 871 *PLI/PAT* 89 (July 2006).

⁷³ *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48 (2d Cir. 1986)

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A common criticism of the ordinary observer test is that “it assumes the reaction of an ordinary observer, when asked whether two works strike him or her as substantially similar, is an accurate guide to determining if the protected expression of a work has been copied rather than its ideas.”⁷⁴ Other critics have argued “that the ordinary observer test creates an overly naïve and unsophisticated standard that is inappropriate for deciding the often subtle question of distinguishing similarity of ideas from similarity of expression.”⁷⁵ Additionally, when the works at issue are particularly complex such as computer programs or musical works, the ordinary observer test does not work and is a source of confusion and frustration for courts and litigants alike.⁷⁶

B. Circuits That Follow that Second Circuit’s Ordinary Observer Test

1. The First Circuit

The First Circuit follows the Second Circuit and uses the ordinary observer test to assess substantial similarity but its treatment of the substantial similarity issue does little to clarify the confusion.⁷⁷ In *Segrets, Inc. v. Gillman Knitwear Co.*, a

(citing *Warner Bros. v. Am. Broad. Co.*, 720 F.2d 231, 240 (2d Cir. 1983).

⁷⁴ Howard B. Abrams, *Copying of Protected Expression—The Second Circuit and the “Ordinary Lay Observer” test*, 2 THE LAW OF COPYRIGHT § 14:23 (Database updated October 2006).

⁷⁵ *Id.*

⁷⁶ See *Whelan v. Assocs., Inc. v. Jaslow Dental Laboratory, Inc.* 797 F.2d 1222, 1232-33 (3d Cir. 1986); see also Abrams, *supra* note 74.

⁷⁷ OSTERBERG & OSTERBERG, *supra* note 46, § 3:1.2, at 3-9; see also *Segrets, Inc. v. Gillman Knitware Co.*, 207 F.3d 56 (1st Cir. 2000); *Concrete Mach. Co., v. Classic Lawn Ornaments, Inc.* 843 F.2d 600 (1st Cir. 1988); *O’Neill v. Dell Pub. Co.*, 630 F.2d 685 (1st Cir. 1980)). The First Circuit requires courts to first determine whether there was copying. Once copying is shown, by direct evidence, proof of access and probative (or substantial) similarity, the court then determines whether there has been unlawful appropriation of the original work by determining whether the

clothier successfully sued a competitor for infringement of the clothier's copyrighted designs for women's sweaters.⁷⁸ In determining that the competitor's design for women's sweater was substantially similar to the plaintiff's design, the court stated that the inquiry is "whether the accused work is so similar to the plaintiff's work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff's protectible expression by taking material of substance and value."⁷⁹

Generally, expert testimony is not permitted to aid in the substantial similarity inquiry.⁸⁰ On summary judgment, courts in the First Circuit utilize the ordinary observer test to determine substantial similarity.⁸¹ Courts may grant summary judgment to a defendant when "the only finding that could be reached by a fact finder, correctly applying the applicable legal standard, is that there is no 'substantial similarity' between the two works."⁸²

The First Circuit's analysis generally is consistent with that of the Second Circuit and as such has the same difficulties discussed earlier in this Note.⁸³ Additionally, as evidenced in *Segrets*, the ordinary observer test is subject to arbitrary line drawing by the court when asked to determine how many variations or alterations of the plaintiff's work by the defendant are sufficient to preclude a finding of substantial similarity.⁸⁴

copying was enough to establish substantial similarity of the two works. OSTERBERG & OSTERBERG, *supra* note 46, § 3:1.2, at 3-9.

⁷⁸ 207 F.3d at 62.

⁷⁹ *Id.*

⁸⁰ *Id.* at 66 n.11.

⁸¹ *See id.* at 62; *see also Concrete Mach. Co.*, 843 F.2d at 611.

⁸² *O'Neill v. Dell Pub. Co., Inc.*, 630 F.2d 685 (1st Cir. 1980).

⁸³ *See* section III.A of this Note.

⁸⁴ *See* 207 F.3d at 65-66 (stating that "[s]light or trivial variations between works will not preclude a finding of infringement under the ordinary observer test At times, the existence of only minor differences may itself suggest copying, indicating that the infringer attempted to avoid liability by contributing only trivial variations. This is not to suggest that an artist cannot avoid infringement by intentionally making substantial alterations in the design of a copyrighted work so as to provide a substantially different

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2. The Third Circuit

The Third Circuit also follows the Second Circuit in their evaluation of substantial similarity.⁸⁵ In *Dam Things From Denmark v. Russ Berrie & Co.*, a Danish owner of copyrights in troll dolls sought to preliminarily enjoin a United States competitor from infringing its copyrights.⁸⁶ Although the court did not consider the infringement analysis because the defendant conceded infringement, the court stated that in order to prove substantial similarity or unlawful appropriation, the fact finder determines whether an ordinary lay observer would decide that the works were substantially similar.⁸⁷

expression of the idea embodied in the copyrighted work.”); *see also Concrete Mach. Co.*, 843 F.2d at 608 (quoting *Nimmer on Copyright* § 13.03[B], at 13-43) (citations omitted) (holding that only when “the points of dissimilarity not only exceed the points of similarity, but indicate that the remaining points of similarity are (within the context of plaintiff’s work) of minimal importance either quantitatively or qualitatively, [that] no infringement results.”).

⁸⁵ OSTERBERG & OSTERBERG, *supra* note 46, § 3:1.1, at 3-3; *see also R. Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 207-208 (3d Cir. 2005); *Dam Things From Denmark v. Russ Berrie & Co.*, 290 F.3d 548, 562 (3d Cir. 2002). Further,

[t]he plaintiff must prove both that the defendant copied the protected work and that there is substantial similarity between the two works. If there is no direct evidence of copying, copying must be shown by proving access and substantial similarity. Thus, as in some other courts, the term “substantial similarity” has two meanings in the Third Circuit As in the Second Circuit, substantial similarity that proves copying means that there is sufficient similarity between the two works in question to conclude that the accused infringer used the copyrighted work in making his work. Substantial similarity that proves unlawful appropriation means that the accused infringer took a significant portion of the independent work of the copyright owner that is entitled to the statutory protection.

OSTERBERG & OSTERBERG, *supra* note 46, § 3:1.1, at 3-3.

⁸⁶ *Dam Things*, 290 F.3d at 552.

⁸⁷ *See Dam Things*, 290 F.3d at 562 (stating that the fact-finder from the perspective of the lay observer must determine whether the copying was an unlawful appropriation of the copyrighted work); *see also* *Universal Athletic*

In *Universal Athletic Sales Co. v. Salkeld*, the Third Circuit evaluated substantial similarity by recording the court's "impressions as they would appear to a layman viewing the two [works] side by side . . . concentrat[ing] upon the gross features rather than an examination of the minutiae."⁸⁸ The court examined the plaintiff's wall chart for use with plaintiff's weight lifting machine and the allegedly infringing chart of the defendant's and discussed the most obvious differences (including color and arrangement) and similarities (including the use of stick figures and their corresponding positions of the figures for each exercise).⁸⁹ The court ultimately reached the conclusion that a lay observer could not find substantial similarity between the two charts because while the ideas were similar, the expressions were not substantially so.⁹⁰

The Third Circuit, employs a special test for computer programs, which has not been extended beyond computer related cases.⁹¹ This modified test permits a single substantial similarity inquiry whereby both the ordinary lay observer analysis and expert testimony are considered.⁹² In allowing this contravention of previously articulated law of the circuit, the court reasoned that the "ordinary observer test, which was developed in case involving novels, plays, and paintings, and which does not permit expert testimony, is of doubtful value involving computer programs on account of the programs' complexity and unfamiliarity to most members of the public."⁹³

Sales Co. v. Salkeld, 511 F.2d 904, 907 (3d Cir. 1975) (articulating that "it must be shown that copying went so far as to constitute improper appropriation, the test being the response of the ordinary lay person.").

⁸⁸ *Id.* at 908.

⁸⁹ *Id.* at 909.

⁹⁰ *Id.*

⁹¹ OSTERBERG & OSTERBERG, *supra* note 46, § 3:1.3, at 3-16.

⁹² *Whelan Assocs. v. Jaslow Dental Lab.*, 797 F.2d 1222, 1232-33 (3d Cir. 1986) (holding that the court joins "the growing number of courts which do not apply the ordinary observer test in copyright cases involving exceptionally difficult materials, like computer programs, but instead adopt a single substantial similarity inquiry according to which both lay and expert testimony would be admissible.").

⁹³ *Id.* at 1232 (citing Howard Root, Note, *Copyright Infringement of*

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The Third Circuit's approach highlights the inconsistencies with the substantial similarity doctrine and its application to different types of works. In addition to the problems articulated by the Third Circuit with applying the ordinary observer test to computer programs, this test is difficult to apply in other complex subject matters, for example where the lay public may not possess the specialized expertise to compare two similar musical arrangements.⁹⁴

3. The Fifth Circuit

The Fifth Circuit follows the Second Circuit's use of the ordinary observer test.⁹⁵ The Fifth Circuit in *Gen. Universal Sys., Inc. v. Lee*, dismissed plaintiff's copyright action against a defendant for infringement of plaintiff's freight packaging software system.⁹⁶ The court stated that in determining whether "the allegedly infringing work is substantially similar to protectible elements of the infringed work . . . [a] side-by-side comparison [is] made between the original and the copy to

Computer Programs: A Modification of the Substantial Similarity Test, 68 MINN. L. REV. 1264, 1285-88 (1984); Note, *Copyright Infringement Actions: The Proper Role for Audience Reactions in Determining Substantial Similarity*, 54 S. CAL. L. REV. 385 (1981) ("criticizing lay observer standard when objects in question are intended for particular, identifiable audiences").

⁹⁴ *Abrams*, *supra* note 74; *see also* *Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731, 737 (4th Cir. 1990) (stating that in order to "warrant departure from the lay characterization of the ordinary observer test, 'specialized expertise' must go beyond mere differences in taste and instead must rise to the level of the possession of knowledge that the lay public lacks.").

⁹⁵ OSTERBERG & OSTERBERG, *supra* note 46, § 3:1.4, at 3-6. *See also* *Positive Black Talk, Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 367-68 (5th Cir. 2004); *Gen. Universal Sys., Inc. v. Lee*, 379 F.3d 131, 141-42 (5th Cir. 2004); *Bridgmon v. Array Sys. Corp.*, 325 F.3d 572, 576-77 (5th Cir. 2003). The Fifth Circuit's substantial similarity inquiry follows the Second Circuit: "Fifth Circuit courts make the same distinction between probative and substantial similarity: access plus probative similarity leads to the inference of copying; copying plus substantial similarity equals infringement." OSTERBERG & OSTERBERG, *supra* note 46, § 3:1.4, at 3-6.

⁹⁶ *Gen. Universal Sys.*, 379 F.3d at 145-46.

determine whether a layman would view the two works as ‘substantially similar.’”⁹⁷ Additionally, the court upheld the lower court’s granting of defendant’s summary judgment where the plaintiff “failed to attach any of its own source code to its summary judgment motion Without providing its own source code for comparison, [Plaintiff] did not satisfy the requirement that the infringed and infringing work be compared side-by-side.”⁹⁸ Thus, a side-by-side comparison of the two works is mandatory; a plaintiff who does not or cannot produce the works to do this comparison, cannot prevail.⁹⁹

As evidenced in *Gen. Universal Sys.*, the side-by-side approach articulated by the Fifth Circuit has the potential to throw out of court possibly meritorious claims on the basis that the party cannot provide the alleged infringing work to do a side-by-side comparison.¹⁰⁰ This seems an unduly unfair approach.

4. *The Seventh Circuit*

The Seventh Circuit’s substantial similarity inquiry is similar to that of the Second Circuit (and the Fifth Circuit).¹⁰¹ The Seventh Circuit also uses the ordinary observer test to assess substantial similarity. The fact finder must determine “whether the accused work is so similar to the plaintiff’s work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff’s protectible expression by

⁹⁷ *Id.* at 142 (quoting *Creations Unlimited v. McCain*, 112 F.3d 814, 816 (5th Cir. 1997) (per curiam)) (internal quotation marks omitted).

⁹⁸ *Id.* at 146.

⁹⁹ *Id.*

¹⁰⁰ *Id.*

¹⁰¹ OSTERBERG & OSTERBERG, *supra* note 46, § 3:1.5, at 3-18; *see also* *Wildlife Express Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502 (7th Cir. 1994); *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614-615 (7th Cir. 1982). “Courts in the Seventh Circuit make a distinction between probative similarity, similarity that proves copying, and substantial similarity, similarity that proves unlawful appropriation.” OSTERBERG & OSTERBERG, *supra* note 46, § 3:1.5, at 3-18.

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taking material of substance and value.”¹⁰² The Seventh Circuit in *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, after conducting an “ocular comparison” found that defendant’s K.C. Munchkin audiovisual game captured the total concept and feel of plaintiff’s copyrighted PAC-MAN audiovisual game.¹⁰³

Additionally, like the Fifth Circuit, courts in the Seventh Circuit conduct a side-by-side comparison of the two works.¹⁰⁴ Unlike the Fifth Circuit, a side-by-side comparison is permitted but is not mandatory.¹⁰⁵ In *Wildlife Express Corp. v. Carol Wright Sales, Inc.* the Seventh Circuit upheld the district court’s determination that there was substantial similarity between defendant’s Precious Pet Duffle bags and plaintiff’s Wildlife Critters bags to constitute infringement.¹⁰⁶ The court, in addition to reviewing the findings of the district court, conducted a side-by-side comparison of the plaintiff’s and the defendant’s bags, which both had animal heads and tails attached to the ends of the bags. The court concluded that the total concept and feel of the two works were substantially similar so as to constitute unlawful appropriation.¹⁰⁷

¹⁰² *Atari*, 672 F.2d at 614.

¹⁰³ 672 F.2d at 619-20.

¹⁰⁴ *Wildlife Express*, 18 F.3d at 507 n.1. The Seventh Circuit’s substantial similarity doctrine

differs from that of many other circuits in that the Seventh Circuit has held that there is a range of protection for copyrighted works similar to the range of protection for trademarks in trademark law. Where idea and expression are indistinguishable in plaintiff’s work, plaintiff’s work is weak and protected only from identical copying or very close paraphrasing. As the work embodies more in the way of particularized expression, it becomes stronger and receives broader copyright protection. The other circuits that have sanctioned this trademark-law type range of protection are the First and Third Circuits.

OSTERBERG & OSTERBERG, *supra* note 46, § 3:1.5, at 3-20.

¹⁰⁵ *Wildlife Express*, 18 F.3d at 507 n. 1.

¹⁰⁶ *Id.* at 511.

¹⁰⁷ *Id.* at 510-11.

C. The Ninth Circuit's Extrinsic/Intrinsic Test

The substantial similarity test in the Ninth Circuit is a two part analysis containing an extrinsic and an intrinsic component.¹⁰⁸ First, courts examine the two works under the extrinsic test, which is objective in nature.¹⁰⁹ The extrinsic analysis “depends not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed.”¹¹⁰ In *Shaw v. Lindheim*, a writer of a television pilot script brought a copyright infringement action against another writer.¹¹¹ The court articulated that rather than comparing the ideas contained in the two works, courts list the elements of the works and analyze whether there are similarities in the expression of those elements.¹¹²

When applying the extrinsic test, a court in the Ninth Circuit is instructed to “filter out and disregard the non-protectible elements in making its substantial similarity determination.”¹¹³ This process is referred to as “analytical dissection”¹¹⁴ which

¹⁰⁸ See *Swirsky v. Carey*, 376 F.3d 841, 845 (9th Cir. 2004).

¹⁰⁹ See *Shaw v. Lindheim*, 919 F.2d 1353, 1357 (9th Cir. 1990) (holding that the extrinsic part of the test is an objective analysis of expression).

¹¹⁰ *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977). When applying the extrinsic test, when looking at literary works, district courts in the Ninth Circuit are instructed to compare “not the basic plot ideas for stories, but the actual concrete elements that make up the total sequence of events and the relationships between the major characters.” *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir. 1985).

¹¹¹ 919 F.2d at 1353.

¹¹² *Id.* at 1362. The elements that courts list and analyze are:

[f]or example, with respect to literary works, the elements are plot, themes, dialogue, mood, setting, pace, sequence of events, and characters. For works of visual art, the criterion includes shapes, colors, and arrangements of the representations in addition to the type of artwork involved, the materials used, the subject matter, and the setting for the subject.

OSTERBERG & OSTERBERG, *supra* note 46, § 3:2.1, at 3-23.

¹¹³ *Cavalier v. Random House Inc.*, 297 F.3d 815, 822 (9th Cir. 2002) (citing *Shaw*, 919 F.2d at 1361).

¹¹⁴ *Swirsky*, 376 F.3d at 845.

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involves breaking works down into their constituent elements and comparing those elements to determine whether the similarities that exist are in the unprotectible elements (for example ideas or *scenes a faire*¹¹⁵).¹¹⁶

It is important to note that while individual elements may not be protectible, a court can still find that the combination of those elements (selection, coordination, and arrangement), can be protectible.¹¹⁷ In *Shaw*, the court compared “the individual features of the works to find specific similarities between the plot, theme, dialogue, mood, setting, pace, characters, and sequence of events.”¹¹⁸ Ultimately, the court found that the objective similarities in protected expression under the extrinsic test were present and concluded that the plaintiff presented a triable issue of fact regarding the substantial similarity of the two works.¹¹⁹

The intrinsic test, which examines an ordinary person’s subjective impressions of the similarities between two works, is exclusively a question that is left to the jury.¹²⁰ Once the court in *Shaw* made the determination that extrinsic similarities were present, the court reversed the district court’s granting of summary judgment to allow the fact finder to determine whether intrinsic similarities existed between the two works.¹²¹

¹¹⁵ See *Cavalier*, 297 F.3d at 815 (defining *scenes a faire* as “situations and incidents that flow necessarily or naturally from a basic plot premise.”).

¹¹⁶ See OSTERBERG & OSTERBERG, *supra* note 46, § 3:2.1, 3-23 (stating that “[b]ecause similarities in elements that are not protectible cannot count in the plaintiff’s favor in the infringement analysis, they are filtered out in the extrinsic analysis and not considered as part of the intrinsic analysis.”).

¹¹⁷ *Id.* at 3-24 (citing *Metcalf v. Bochco*, 294 F.3d 1069 (9th Cir. 2002)) (noting that the court in *Metcalf* “held that even though the elements common to both plaintiff’s screenplay and defendant’s television series were not individually copyrightable, *Metcalf* passed the extrinsic test because his combination of unprotectible items was copyrightable.”).

¹¹⁸ 919 F.2d at 1362 (citing *Narell v. Freeman*, 872 F.2d 907, 912 (9th Cir. 1989); *Berkic v. Crichton*, 761 F.2d 1289, 1292 (9th Cir. 1985)) (internal quotation marks omitted).

¹¹⁹ *Shaw*, 919 F.2d at 1362-64.

¹²⁰ See *id.* at 1360-61.

¹²¹ *Id.* at 1364.

The intrinsic test is a subjective evaluation of whether there is substantial similarity in expressions depending on the response of the ordinary reasonable observer.¹²² Expert testimony is not permitted in the analysis on the intrinsic portion of the test.¹²³ This structure presents challenges for the fact finder because the fact finder is permitted to consider expert testimony when evaluating extrinsic similarities but, having been exposed to that testimony, is required to disregard it when evaluating similarities on the intrinsic portion of the test.¹²⁴

The use of experts on the substantial similarity analysis is one point in particular where the circuits are divergent and thus potentially provide disparate results depending on the plaintiff's forum choice. For example, in contrast to the Second Circuit, the Ninth Circuit allows the use of expert testimony in assessing substantial similarity (on the extrinsic portion of the test). Under the "ordinary observer" test adopted by the Second Circuit, the determination of "illicit copying (unlawful appropriation) . . . is the response of the ordinary lay [observer]; accordingly, on that issue, dissection and expert testimony are irrelevant."¹²⁵

It has been argued that expert witnesses can provide information that the judge, or the "ordinary observer, who may not be entirely familiar with literary works or how to identify *scenes a faire* cannot."¹²⁶ According to Nimmer:

[T]here will . . . be numerous instances when the "ordinary observer" is simply not capable of detecting very real appropriation . . . if the [defendant's work] consists merely of clever juxtaposition and alteration of unessential details in the plaintiff's work, plus the addition of a substantial

¹²² See *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

¹²³ See *id.*

¹²⁴ OSTERBERG & OSTERBERG, *supra* note 46, § 16.1 at 16-4.

¹²⁵ *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) (internal quotation marks omitted).

¹²⁶ Nimmer § 13.03[E][3][a] (stating that "it is hardly reasonable to expect laymen . . . to delineate the portion of the plaintiff's work that it is protectible" on their own).

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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.¹²⁷

Arguably, expert testimony should apply in these contexts where courts must consider whether, for example, the character traits in a movie are drawn from a specific work or are instead part of a stock type, or whether a particular plot twist is scenes-a-faire or evidence of copying.¹²⁸ These determinations are difficult for non-experts to make without knowledge of the context that surrounds the two works—experts could supply these answers.¹²⁹ Accordingly, the use of expert testimony in this context could aid in a more consistent determination of similarities of expression.

The extrinsic/intrinsic test has been widely criticized even by the very court that created it.¹³⁰ The major criticism of the test is that it is hard to understand and not easy to apply.¹³¹ The Ninth Circuit has recognized the difficulties of applying the test and in *Metcalfe v. Bochco*, described the extrinsic test as “turbid waters.”¹³² Moreover, in *Swirsky v. Carey*, the court noted that “[t]he application of the extrinsic test, which assesses substantial similarity of ideas and expression, to musical compositions is a somewhat unnatural task, guided by relatively little precedent The extrinsic test provides an awkward framework to apply to copyrighted works like music or art objects, which lack distinct element of ideas and expression.”¹³³ But, the court went

¹²⁷ Nimmer § 13.03 [E][2].

¹²⁸ See *Shaw v. Lindheim*, 919 F.2d 1353, 1356 (9th Cir. 1990) (allowing expert testimony on plot); *Swirsky v. Carey*, 376 F.3d 841, 848 (9th Cir. 2004) (reversing defendant's summary judgment motion because expert affidavit created issue of material fact on stock elements).

¹²⁹ See Nimmer § 13.03[E][3][a].

¹³⁰ See *Swirsky*, 376 F.3d at 848.

¹³¹ OSTERBERG & OSTERBERG, *supra* note 46, § 3:2.1 at 3-29.

¹³² 294 F.3d 1069, 1071 (9th Cir. 2002).

¹³³ 376 F.3d at 848.

on to conclude: "the test is our law and we must apply it."¹³⁴

In addition to the problems discussed by the Ninth Circuit itself, the extrinsic/intrinsic test clouds the distinction between ideas and expression and makes it difficult to apply to certain types of works. For example, it may be very difficult to separate out ideas from expressions when comparing two paintings or other visual art works. Similarly, this test does easily translate to complex, technical subject matter as may be found in computer or music cases.

Additionally, it should be noted that even though the Ninth Circuit purports to break the issue up into an objective and subjective analysis, in reality, it is possible that judges even in the Ninth Circuit continue to make subjective decisions on summary judgment, and thus on a portion of the test that is supposed to be purely objective. For instance, if on summary judgment the judge is determining whether extrinsic similarities exist between the two works, the obvious question becomes: how many similarities have to be present to send it to the jury? The jurisprudence in the Ninth Circuit does not provide a bright line rule to answer this question. Thus, a judge looking at two works will at some level be making a subjective determination of how many extrinsic similarities are too many. Would one similarity be enough? Two? Ten? Where does a judge draw the line? This flaw presents a major difficulty for courts and has the potential to produce unreliable and unpredictable precedent.

D. Circuits That Follow the Ninth Circuit's Extrinsic/Intrinsic Test

1. The Fourth Circuit

The Fourth Circuit uses a version of the Ninth Circuit's extrinsic/intrinsic test to compare works.¹³⁵ In *Towler v. Sayles*,

¹³⁴ *Id.*

¹³⁵ OSTERBERG & OSTERBERG, *supra* note 46, § 3:2.2, at 3-29; *see also* Lyons P'ship, L.P. v. Morris Costumes, Inc., 243 F.3d 789, 801 (4th Cir. 2001); *Towler v. Sayles*, 76 F.3d 579, 583 (4th Cir. 1996); *Dawson v.*

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the Fourth Circuit affirmed the district court's finding that defendant's screenplay was not substantially similar to plaintiff's copyrighted screenplay.¹³⁶ The court articulated that proving substantial similarity requires a two part analysis.¹³⁷ On the extrinsic portion of the Fourth Circuit's test, "a plaintiff must show—typically with the aid of expert testimony—that the works in question are extrinsically similar because they contain substantially similar ideas that are subject to copyright protection."¹³⁸ The court analyzed the similarities in plot, theme, mood, dialogue, setting, and pace between the two screenplays and determined that the works were not extrinsically similar because the only extrinsic similarity was that they both had a black female character and white female character who were friends.¹³⁹

To satisfy the intrinsic portion of the Fourth Circuit's test, a plaintiff must "[show] substantial similarity in how those ideas are expressed" by considering whether the intended audience would consider the works substantially similar.¹⁴⁰ Expert testimony is usually not permissible on the intrinsic portion which compares the "total concept and feel" of the two works and considers "whether the intended audience could determine that the works are substantially similar."¹⁴¹ In *Towler*, the court determined that the intended audience was the movie-going public and that the works were not intrinsically similar because the total concept and feel of the two works was completely

Hinshaw Music, Inc., 905 F.2d 731, 732-33 (4th Cir. 1990), *cert. denied*, 498 U.S. 981 (1990); *Eaton v. Nat'l Broad. Co.*, 972 F.Supp. 1019 (E.D. Va. 1997), *aff'd*, 1998 U.S. Dist. LEXIS 10288 (4th Cir. May 21, 1998).

¹³⁶ 76 F.3d at 583.

¹³⁷ *Id.* at 583-84.

¹³⁸ *Id.* (For example, in comparing two screenplays, a court "must analyze both screenplays and the record, searching for extrinsic similarities such as those found in plot, theme, dialogue, mood, setting, pace, or sequence.").

¹³⁹ *Id.* at 584.

¹⁴⁰ *Id.* at 583-84.

¹⁴¹ *Id.* at 584.

different.¹⁴²

The major difference between the Ninth Circuit and the Fourth Circuit tests is that the Fourth Circuit utilizes the “intended audience” test rather than an ordinary observer test to determine whether the works are intrinsically similar.¹⁴³ This was demonstrated in *Dawson v. Hinshaw Music, Inc.*, where the Fourth Circuit held that

[I]f, as will most often be the case, the lay public fairly represents the intended audience, the court should apply the lay observer formulation However, if the intended audience is more narrow in that it possesses specialized expertise, relevant to the purchasing decision, that lay people would lack, the court’s inquiry should focus on whether a member of the intended audience would find that two works to be substantially similar.¹⁴⁴

The Fourth Circuit includes in this inquiry the “admission of testimony from members of the intended audience, or, possibly, from those who possess expertise with reference to the tastes and perceptions of the intended audience.”¹⁴⁵

Two prominent copyright scholars, Robert C. Osterberg and Eric C. Osterberg noted the following advantages and disadvantages of the intended audience test:

The intended audience test offers the obvious

¹⁴² *Towler v. Sayles*, 76 F.3d 579, 584 (4th Cir. 1996)

¹⁴³ OSTERBERG & OSTERBERG, *supra* note 46, § 3:2.2, at 3-30. Osterberg and Osterberg noted that currently, “the Fourth Circuit’s intended audience test is the minority approach. Other than . . . exceptions . . . with respect to children’s works and computer programs, most courts seem to require that works be compared by the ordinary observer, that is, jurors with no specialized training or expertise, in all instances.” *Id.* at 3-36.

¹⁴⁴ *Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731, 736 (4th Cir. 1990), cert. denied, 498 U.S. 981.

¹⁴⁵ *Id.* Nevertheless, the court in *Dawson* cautioned that “a court should be hesitant to find that the lay public does not fairly represent a work’s intended audience . . . departure from the lay characterization is warranted only where the intended audience possesses ‘specialized expertise.’” *Id.* at 737.

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advantage of evaluation of the works through the eyes of those who understand them best. On the other hand, to apply the intended audience test, the court must both identify the intended audience and either select only members of that audience for its jury or accept expert testimony concerning the intended audience's reaction, potentially yielding the fact-finding function to the expert.¹⁴⁶

Thus, while the intended audience test attempts to address the root purposes of copyright law it does not provide a suitable framework that would be applicable to all cases where the issue is whether two works are substantially similar. For example, this test would be problematic where a work has many intended audiences or if the intended audience could not be identified.¹⁴⁷

Additionally, as discussed later in this Note, providing authors with the economic incentive to create work is not the only factor that must be considered. One must consider the alternative that an increase in the number of works that can be protected causes a shrinking of the public domain which has the potential to stifle creativity.¹⁴⁸ If protection is afforded to a work because the allegedly infringing work could have an effect on the original author's market, there is the potential that people will be less inclined to building upon and use other's works for fear of being held liable.¹⁴⁹ This would be bad for society because, potentially, less works would be created.¹⁵⁰

2. The Eighth Circuit

The Eighth Circuit also uses a version of the extrinsic/intrinsic test of the Ninth Circuit.¹⁵¹ The Eighth

¹⁴⁶ OSTERBERG & OSTERBERG, *supra* note 46, § 3:2.2, at 3-36.

¹⁴⁷ *See id.*

¹⁴⁸ *See Mohler, supra* note 8, at 974.

¹⁴⁹ *Id.*

¹⁵⁰ *Id.*

¹⁵¹ OSTERBERG & OSTERBERG, *supra* note 46, § 3:2.3, at 3-37; *see also* Taylor Corp. v. Four Seasons Greetings, LLC, 403 F.3d 958 (8th Cir. 2005); Moore v. Columbia Pictures Indus., Inc., 972 F.2d 939, 945 (8th Cir.

Circuit's test is described by the court in *Hartman v. Hallmark Cards, Inc.* as follows: "First, similarity of ideas is analyzed extrinsically, focusing on objective similarities in the details of the works. Second, if there is substantial similarity in ideas, similarity of expression is evaluated using an intrinsic test depending on the response of the ordinary, reasonable person as to the forms of expression."¹⁵² On the intrinsic portion of the test, the question is whether the ordinary, reasonable observer would find substantial similarity of expression.¹⁵³ Accordingly, expert testimony is permitted only on the extrinsic portion of the test, and may not be utilized for the intrinsic test.¹⁵⁴

In *Hartman*, the plaintiff asserted that defendants Hallmark and Mattel used plaintiff's graphics and script entitled "The Adventures of Rainbow Island" as the basis for their "Rainbow Brite" character and products.¹⁵⁵ The Eighth Circuit upheld the district court's grant of summary judgment which found, when it analyzed the two works extrinsically and focused on the objective similarities in the works, that the plaintiff's work consisted almost completely of uncopyrightable ideas or general themes.¹⁵⁶ On the intrinsic portion of the test, the court examined the district court's comparison of the total concept and feel of the two works and concluded that the two creations were not substantially similar in expression.¹⁵⁷

1992); *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120 (8th Cir. 1987). Both the Eighth Circuit and the Fourth Circuit, use a version of the Ninth Circuit's extrinsic/intrinsic test that comes from Ninth Circuit cases that were decided in the years between *Krofft* and the re-articulated objective/subjective test from *Shaw*. OSTERBERG & OSTERBERG, *supra* note 46, § 3:2.3, at 3-37.

¹⁵² *Hartman*, 833 F.2d at 120.

¹⁵³ *Id.*

¹⁵⁴ *Id.*

¹⁵⁵ *Id.* at 119.

¹⁵⁶ *Id.* at 121.

¹⁵⁷ *Id.* at 120-21.

E. The Remaining Circuits

The remaining circuits utilize a variety of tests to assess substantial similarity. The Tenth Circuit, Sixth Circuit, and the D.C. Circuit, use the abstraction-filtration-comparison test, or a version thereof.¹⁵⁸ The Eleventh Circuit primarily uses the ordinary observer test, but occasionally uses the extrinsic/intrinsic test.¹⁵⁹

1. The Tenth Circuit

The Tenth Circuit uses the abstraction-filtration-comparison test for various types of infringement cases, including computer cases.¹⁶⁰ The Tenth Circuit, in *Country Kids 'N City Slicks, Inc. v. Sheen*, applied the abstraction-filtration-comparison test to determine whether allegedly infringing wooden dolls were substantially similar to the protectible elements of the plaintiff's copyrighted dolls.¹⁶¹

The court described the test as follows:

At the abstraction step, we separate the ideas (and basic utilitarian functions) which are not protectible, from the particular expression of the work. Then, we filter out the nonprotectible components of the product from the original expression. Finally, we compare the remaining protected elements to the allegedly copied work to determine if the two works

¹⁵⁸ OSTERBERG & OSTERBERG, *supra* note 46, § 3, at 3-2; *see also* Hartman, 833 F.2d at 120-21.

¹⁵⁹ OSTERBERG & OSTERBERG, *supra* note 46, § 3, at 3-2.

¹⁶⁰ *Id.* at § 3:3.1, at 3-39; *see also* Country Kids 'N City Slicks, Inc. v. Sheen, 77 F.3d 1280, 1284 (10th Cir. 1996); Kindergartners Count, Inc. v. DeMoulin, 249 F.Supp. 2d 1214 (D. Kan. 2003); Madrid Chronicle Books, 209 F.Supp. 2d 1227 (D.Wyo. 2002); Fisher v. United Feature Syndicate, Inc., 37 F. Supp. 2d 1213 (D. Colo. 1999), *aff'd*, 203 F.3d 834 (10th Cir. 2000), cert. denied, 531 U.S. 992 (2000).

¹⁶¹ 77 F.3d at 1284.

are substantially similar.¹⁶²

The court utilized this test to determine that the size, shape, and medium of the plaintiff's dolls were unprotectible elements and thus must be filtered out.¹⁶³ Nevertheless, the court remanded the case to the district court to conduct a comparison analysis.¹⁶⁴ The court further articulated that the ordinary observer test is the appropriate method for courts to use on the comparison analysis.¹⁶⁵

Like both the extrinsic/intrinsic test and the ordinary observer test, this test is problematic for many of the same reasons. The process that this test requires is very similar to the extrinsic/intrinsic test and the ordinary observer test that asks courts to separate out ideas from expressions.¹⁶⁶ Similar to those tests, this test does not provide much guidance on how to do so and offers little direction to answer the ultimate question of whether a work has been improperly appropriated.

2. *The Sixth Circuit*

The Sixth Circuit, in *Kohus v. Mariol*,¹⁶⁷ recently adopted a test for assessing substantial similarity that appears to be a version of the abstraction-filtration-comparison test.¹⁶⁸ Previous to *Kohus*, the Sixth Circuit had not adopted a specific test for assessing substantial similarity in a copyright infringement case.¹⁶⁹ *Kohus* involved the alleged infringement of plaintiff's

¹⁶² *Id.* at 1284-85.

¹⁶³ *Id.* at 1287.

¹⁶⁴ *Id.* at 1288.

¹⁶⁵ *Id.*

¹⁶⁶ *See id.* at 1285.

¹⁶⁷ 328 F.3d 848 (6th Cir. 2003).

¹⁶⁸ OSTERBERG & OSTERBERG, *supra* note 46, § 3:3.2, at 3-43.

¹⁶⁹ OSTERBERG & OSTERBERG, *supra* note 46, § 3:3.2, at 3-42; *see also Kohus*, 328 F.3d at 854 (6th Cir. 2003); *Stromback v. New Line Cinema*, 384 F.3d 283 (6th Cir. 2004); *Ellis v. Diffie*, 177 F.3d 503, 506 (6th Cir. 1999) (court utilized the ordinary observer test without the aid of expert testimony); *Bird Brain, Inc. v. Menard, Inc.*, 2000 U.S. Dist. LEXIS 11668 (W.D. Mich. Aug. 4, 2000) (utilizing the ordinary observer test in assessing

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copyrighted drawing of a portable children's playyard latch by defendant's patent drawings for a collapsible playyard.¹⁷⁰

The court in *Kohus*, adopted a two part test.¹⁷¹ In the first step, courts are supposed to "filter out the unoriginal, unprotectible elements—elements that were not independently created by the inventor, and that possess no minimal degree of creativity—through a variety of analyses."¹⁷² Expert testimony is permissible on the first step.¹⁷³ Next, "[o]nce the unprotectible elements have been filtered out, the second step is to determine whether the allegedly infringing work is substantially similar to the protectible elements of the original."¹⁷⁴ The court looked to the Fourth Circuit case, *Dawson v. Hinshaw Music, Inc.*, to hold that "the inquiry in the second prong of the substantial similarity test should focus on the *intended audience*."¹⁷⁵

substantial similarity without the use of experts); *Marigold Foods, Inc. v. Purity Dairies, Inc.*, 1992 U.S. App. LEXIS 14044 (6th Cir. June 10, 1992) (district court used the extrinsic/intrinsic test and the court of appeals used the same test).

¹⁷⁰ 328 F.3d at 851-52.

¹⁷¹ *Id.* at 855.

¹⁷² *Id.* (citations omitted). "The court specifically identified ideas, elements dictated by efficiency, and *scenes a faire* as elements to be filtered out before comparing works. In a later case . . . the court added another item to the list of elements to be filtered—*independently-created elements*." OSTERBERG & OSTERBERG, *supra* note 46, § 3:3.2, at 3-43 – 3-44.

¹⁷³ *See Kohus*, 328 F.3d at 856 (The court stated that on the first step, "[i]n the present case expert testimony will likely be required to establish what elements, if any, are necessary to the function of any latch designed for the upper arm of a collapsible playyard.").

¹⁷⁴ *Id.*

¹⁷⁵ *Id.* at 856-57 (citing *Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731, 736 (4th Cir. 1990) (emphasis in original) (holding that [i]n cases where the target audience possesses specialized expertise, however, the specialist's perception of similarity may be much different from the lay observer's, and it is appropriate in such cases to consider similarity from the specialist's perspective [T]he intended audience . . . will ordinarily be the lay public, in which case the finder of fact's judgment should be from the perspective of the lay observer or . . . the ordinary reasonable person. But in cases where the audience for the work possesses specialized expertise that is relevant to the purchasing decision and lacking in the lay observer, the trier of fact should make the substantial similarity determination from the

The court remanded the case to permit expert testimony on the first prong, because the drawings were “technical in nature and a lay person is unlikely to understand what constitutes creativity in this area, which elements are standard for the industry, and which elements are dictated by efficiency or by external standards.”¹⁷⁶ Additionally, the court directed that in examining the second prong of the test, substantial similarity should be analyzed from the viewpoint of the intended audience, noting that in this case the intended audience may not be the lay public, but rather trained engineers.¹⁷⁷

This test varies from the abstraction/filtration/comparison test because it at least provides some guidance with regards to from whose viewpoint the comparison should be done. Here, the comparison is done from the intended audience’s viewpoint. While this test clarifies that point, it does not solve any of the previously articulated problems. Additionally, conducting the comparison from the intended audience perspective has the positives and negatives previously discussed (e.g. what happens when the intended audiences are not the same?).¹⁷⁸

3. *The District of Columbia Circuit*

The District of Columbia Circuit uses the ordinary observer test in some cases and the filtration/comparison inquiry in other cases.¹⁷⁹ In cases where the defendant does not claim that the plaintiff’s work is composed of non-copyrightable elements, the

perspective of the intended audience.).

¹⁷⁶ *Id.* at 857-58.

¹⁷⁷ *Id.* at 858.

¹⁷⁸ See OSTERBERG & OSTERBERG, *supra* note 46, § 3:2.2, at 3-36; see also Section III.D.1 of this Note.

¹⁷⁹ OSTERBERG & OSTERBERG, *supra* note 46, § 3:3.3, at 3-46; see also *Atkins v. Fischer*, 331 F.3d 988, 993 (D.C. Cir. 2003) (utilizing the ordinary observer test for assessing substantial similarity); *Whitehead v. CBS/Viacom, Inc.*, 315 F. Supp. 2d 1, 8-9 (D.D.C. 2004) (utilizing the ordinary observer test); *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1297 (D.C. Cir. 2002) (utilizing a two-step filtration/comparison inquiry).

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D.C. Circuit applies the ordinary observer test.¹⁸⁰ But, in cases where the defendant argues that plaintiff's work contains portions that are not protected by copyright, the D.C. Circuit conducts a two-step filtration/comparison inquiry.¹⁸¹ First, the court identifies "which aspects of the artist's work, if any are protectible by copyright,"¹⁸² filtering out "unprotectible elements such as ideas and *scenes a faire*."¹⁸³ Next, the court uses the ordinary observer test to determine "whether the allegedly infringing work is substantially similar to the protectible elements of the artist's work."¹⁸⁴

4. The Eleventh Circuit

Finally, the Eleventh Circuit, primarily uses the ordinary observer test to assess substantial similarity, but has occasionally used the extrinsic/intrinsic test as well.¹⁸⁵ In *Suntrust Bank v. Houghton Mifflin Co.*, the Eleventh Circuit held that in order to show substantial similarity, plaintiff was required to show that "an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work."¹⁸⁶

Suntrust Bank involved an attempt by owners of copyright in the novel "Gone with the Wind" to obtain a temporary restraining order and preliminary injunction to prevent the

¹⁸⁰ See *Atkins*, 331 F.3d 988; *Whitehead*, 315 F. Supp. 2d 1.

¹⁸¹ See e.g., *Sturdza*, 281 F.3d at 1295.

¹⁸² *Id.*

¹⁸³ *Id.* at 1296.

¹⁸⁴ *Id.* (holding that in using the ordinary observer test the determination "requires comparison not only of the two works' individual elements in isolation, but also of their overall look and feel.") (internal quotation marks omitted).

¹⁸⁵ OSTERBERG & OSTERBERG, *supra* note 46, § 3:4, at 3-48; see also *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1266 (11th Cir. 2001) (utilizing the ordinary observer test to assess substantial similarity); *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210, 1214 (11th Cir. 2000) (utilizing the ordinary observer test to assess substantial similarity); *Herzog v. Castle Rock Entm't*, 193 F.3d 1241, 1248 (11th Cir. 1999) (the Eleventh Circuit utilized the extrinsic/intrinsic test of the Ninth Circuit).

¹⁸⁶ 268 F.3d at 1266.

publication and distribution of the allegedly infringing book “The Wind Done Gone.” After conducting a comparison of the two works, the Court affirmed the district court’s finding that the defendant copied much more of plaintiff’s work than just unprotectible scenes-a-faire including the characters and their complex relationships with each other, plot, fictional locales, and settings.¹⁸⁷

In contrast, in *Herzog v. Castle Rock, Entm’t* the Eleventh Circuit utilized a two-part test for establishing substantial similarity.¹⁸⁸ The court articulated that the plaintiff must satisfy both the extrinsic, or objective test and the intrinsic, or subjective test. *Herzog* involved a claim by the plaintiff that defendant’s motion picture entitled “Loan Star” infringed plaintiff’s copyrighted screenplay entitled “Concealed.”¹⁸⁹ The court conducted an analysis of the two works and held that the similarities that existed between the two works consisted of noncopyrightable elements and that no reasonable juror could find that the two works were substantially similar in expression.¹⁹⁰

IV. RECOMMENDATION FOR THE FUTURE OF COPYRIGHT LAW

The attempts by courts to articulate and redefine tests in hopes of eliminating confusion have in fact resulted in more confusion and ambiguity about what the test for substantial similarity should be.¹⁹¹ Instead of trying to wade through the confusing array of tests available or attempting to articulate a single test, courts should articulate a standard that goes to the ultimate purpose of copyright. In order to determine if there has been copyright infringement a court should determine whether or not providing relief for the owner of the copyright will enhance the policy goals of copyright and the objectives of Congress.

¹⁸⁷ *Id.* at 1266-67.

¹⁸⁸ 193 F.3d at 1257.

¹⁸⁹ *Id.* at 1243.

¹⁹⁰ *Id.* at 1262.

¹⁹¹ Mohler, *supra* note 8, at 990.

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The tests that have been discussed throughout this Note are looking at the issue in the wrong way. The majority of circuit courts discussed incorporate some form of ordinary observer test into their substantial similarity formula. Making the important decision of substantial similarity based on the perception of the ordinary observer is looking at the issue from not only an unclear and ambiguous perspective, but is also misguided. Rather, courts should be considering the issue in order to determine how much copying is too much based on the policy and aims of the Copyright statute.

In *Mazer v. Stein*, the Supreme Court stated that

[t]he economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in “Science and the useful Arts.” Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.¹⁹²

The main problem with this theory is that it does not adequately address the potential effect that looking at the issue from an economic perspective would have on creativity. The opposite side to this economic perspective is the notion that granting an author a monopoly for a period also prevents people from expanding and creating new works based on old works.¹⁹³ Thus, findings of infringement should be limited in an effort to promote the production of creative works and to promote a robust public domain.

Many legal scholars have weighed in on the various tests for assessing substantial similarity in a copyright infringement action and have attempted to bring clarity to this confusing and unpredictable area of the law by articulating new tests and ways to view copyright infringement cases.¹⁹⁴

¹⁹² 347 U.S. 201, 219 (1954)

¹⁹³ See Busek, *supra* note 10, at 1777-78; see also Mohler, *supra* note 8, at 974.

¹⁹⁴ Stanfield, *supra* note 4, at 510-11.

Michael Sharb suggested a redefined total concept and feel test that consisted of five steps.¹⁹⁵ Sharb's redefined test proposed an adoption of the total concept and feel test as "the uniform test of substantial similarity of expression" and "the intended audience test as the uniform test of perspective in the total concept and feel inquiry."¹⁹⁶

The argument against Sharb's redefined test is that it "relies upon other tests to determine the line between idea and expression, and the ordinary observer test to assess whether similarity is substantial."¹⁹⁷ Thus, the same problems articulated above that arise with the idea/expression dichotomy and the ordinary observer test, especially when it comes to technical and complex works will inevitably be problematic in this redefined test.

Jarrod Mohler suggested that one "over-arching and flexible test" does not exist.¹⁹⁸ He concluded that "the 'abstractions' framework from *Nichols v. Universal Picture Corp.* is sufficient to assist the trier of fact, and that the use of other tests for substantial similarity is unnecessary and positively harmful."¹⁹⁹ Mohler suggests that the use of these other tests is harmful because they are often inconsistently and misapplied, thus leading to a great amount of confusion for courts and

¹⁹⁵ Michael L. Sharb, Comment, *Getting a "Total Concept and Feel" of Copyright Infringement*, 64 U. COLO. L. REV. 903, 929 (1993). The five part test requires:

- 1) does the plaintiff have a valid copyright?
- 2) did the defendant copy from the plaintiff?
- 3) is what the defendant copied from the plaintiff an unprotectible idea or protectible expression?
- 4) if expression was copied, does it constitute improper appropriation, or, in other words, are the works substantially similar (the original source of the [total concept and feel] test) and
- 5) from whose perspective should the substantial similarity inquiry be made.

Id. at 920.

¹⁹⁶ *Id.* at 923.

¹⁹⁷ Stanfield, *supra* note 4, at 510.

¹⁹⁸ Mohler, *supra* note 8, at 989.

¹⁹⁹ *Id.* at 972, citing 45 F.2d 119 (2d Cir. 1930).

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commentators.²⁰⁰ While it is apparent that one single test does not exist, the ‘abstractions’ framework that requires line drawing between ideas and expressions still provides little guidance and is problematic for courts.²⁰¹

Jeannette Rene Busek addressed the difficulties that courts have in applying the current tests to a variety of works when she suggested that courts should “consider the type of work in question, using it as a base for the standard of substantial similarity.”²⁰² Busek argued that

[i]nstead of trying to fit all copyright infringement cases into neat tests that are independent of the amount of expressive variation possible, courts would be better off recognizing the vast differences between the types of works covered by copyright law and articulating their decisions based on the amount of expressive variation available to the particular type of work.²⁰³

This approach addresses the problems associated with the current tests in dealing with a variety of types of works. The difficulty with this proposal is that it also requires courts to make difficult determinations between what constitutes an idea and what constitutes an expression of an idea. Courts are asked to determine whether in a particular type of work there are many expressive variations. This seems similar to how a court would be required to distinguish between ideas and expressions under the abstractions test analysis.

A few commentators and courts have suggested a test or approach that looks at the market for which the original work was intended. For example, Edward Wilde proposed that courts replace the idea/expression dichotomy with a market-based analysis.²⁰⁴ Wilde argued that the idea/expression terminology

²⁰⁰ Mohler, *supra* note 8, at 971.

²⁰¹ COHEN ET AL., *supra* note 1, at 80.

²⁰² Busek, *supra* note 10, at 1778.

²⁰³ *Id.* at 1803.

²⁰⁴ Edward C. Wilde, *Replacing the Idea/Expression Metaphor with a Market-Based Analysis in Copyright Infringement Actions*, 16 WHITTIER L.

traditionally used by courts “does not work well and it does not address the root purpose of copyright law.”²⁰⁵ Instead, Wilde suggested that the courts should analyze the market for each work and “determine whether the copied similarities in the second work are such that the second work can substitute for the first work or otherwise usurp the proper market position of the first work. If the two works will compete as separate products, then there is no wrongful infringement.”²⁰⁶

Additionally, Michael Der Manuelian in criticizing the ordinary observer test, articulated that “[i]f, as *Arnstein* suggested, copyright law should protect the plaintiff’s interest in potential financial returns, the ultimate test for infringement should consider specifically the response of the market from which those returns would derive.”²⁰⁷ Similarly, Professor Nimmer has argued that copyright is intended “to protect writers from the theft of the fruits of their labor, not to protect against the general public’s “spontaneous and immediate” impression that the fruits have been stolen.”²⁰⁸ In his criticism of the ordinary observer or average lay hearer test, Der Manuelian continued: “an average lay hearer may not be qualified to determine the responses of the particular audience for whom the music has been composed Finally, the ‘lay-hearer test’ may promote findings of infringement based on overall similarities which, in fact, may be attributable, not to copying, but to common sources or genuine coincidence.”²⁰⁹

While a market based analysis is less confusing than the tests currently available and attempts to address the underlying purpose of copyright law, courts must be conscious of the shrinking public domain and the effect that this has on the proliferation of new creations.²¹⁰ The Framers of the

REV. 793 (1995).

²⁰⁵ *Id.* at 794.

²⁰⁶ *Id.* at 841.

²⁰⁷ Der Manuelian, *supra* note 70, at 144-45 (citing *Arnstein v. Porter*, 154 F.2d 464, 486 (2d Cir. 1946)).

²⁰⁸ Nimmer at § 13.03[E], at 13-49.

²⁰⁹ Der Manuelian, *supra* note 70, at 144-45 (internal citations omitted).

²¹⁰ Mohler, *supra* note 8, at 974.

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Constitution authorized the creation of Federal Copyright Law in order to “promote the Progress of Science and useful Arts.”²¹¹ Thus, the purpose of copyright law is to promote, not restrain, creativity in the arts.

It is clearly the case that courts have expanded the scope of the protection of the reproduction right.²¹² Authors increasingly get the right to prevent people from copying their works in more and more ways.²¹³

In recent years . . . an increasing number of trivial copyright violations have made it to court This increase in litigation of trivial copyright violations is problematic . . . [because] strict enforcement of copyright for trivial violations rarely furthers, and often contravenes, the purpose of copyright: promotion of creativity . . . [and] courts have not taken a consistent approach to adjudicating trivial violations: a few hold that liability extends even to the most innocuous violations, while most find a way to privilege trivial violations using one of several doctrinal tools. Unfortunately, these tools, most notably . . . substantial similarity, [have] at times been stretched beyond recognition to achieve the courts’ desired results.²¹⁴

It is important to consider whether as copyright protection gets more and more protective, there is the potential to stifle creativity.

After conducting an examination of the myriad of confusing tests and recommendations for new tests, this Note asks the question: Do we really need a test at all?

Ultimately, courts should not employ any of the articulated tests and instead should engage in a weighing of the goals of copyright to determine whether a finding of infringement would

²¹¹ U.S. CONST. art. I, § 8, cl. 8.

²¹² Andrew Inesi, Article, *A Theory of De Minimus and a Proposal for its Application in Copyright*, 21 BERKELEY TECH. L.J. 945, 946 (2006).

²¹³ *Id.*

²¹⁴ *Id.* at 946.

“strike the optimal balance between providing authors with incentives to create and encouraging dissemination of works and information to the public.”²¹⁵ In order to achieve this goal, courts must ultimately attempt “to balance the needs of existing authors for protection with needs of future authors to use the ideas and other raw materials need to create.”²¹⁶

CONCLUSION

Due to the present state of uncertainty and confusion surrounding substantial similarity in a copyright infringement action, we are moving further and further away from a uniform copyright law. The Supreme Court needs to articulate a standard that would resolve this split in the circuits.

The conflict within the Circuits has lasted for many years and does not seem to show any signs of diminishing. The outcome of many copyright infringement cases comes down to whether or not two works are substantially similar. Under the current state of affairs, there is a great chance that litigants will forum shop for a Circuit that is friendly to plaintiffs in copyright infringement suits. There should be a single uniform standard articulated by the Supreme Court because copyright is a federal law. Thus, it is critical that the Supreme Court resolve this issue so that the outcome of each case dealing with substantial similarity under the Federal Copyright Act does not come down to where the case was filed.

This Note argues that when courts analyze substantial similarity, they are looking at the issue in the wrong way. When making the determination of whether someone ought to be able to bring a copyright infringement claim, it is necessary to look at why the Constitution affords copyright protection. Currently, the tests do not adequately look at impact on creativity of industry. It is important to remember that “the purpose of copyright is to create incentives for creative effort”²¹⁷ Instead of

²¹⁵ COHEN ET AL., *supra* note 1, at 561.

²¹⁶ *Id.*

²¹⁷ Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417,

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focusing on the impact of creativity, court focus more on the potential harm to the plaintiff's market, without considering need for the incentive. Courts should abandon the current tests and make their determinations of copyright infringement based on whether or not providing relief for the owner of the copyright will enhance the objectives that congress had in mind when they created a federal copyright law. Under such as approach, while the outcome of a particular case may be less predictable, litigants will be able to focus on the merits of the case rather than advocating for a particular test to be applied to the merits. Courts and advocates will no longer have to deliberate over ambiguous terms such as ordinary lay observer, intended audience, and extrinsic or intrinsic.²¹⁸

450 (1984).

²¹⁸ Sharb, *supra* note 195, at 929.