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Substantial Similarity and Junk Science: Reconstructing the Test of Copyright Infringement

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Cover Page Footnote

Robert F. Helfing is an associate adjunct professor of copyright law at Southwestern Law School. He previously practiced copyright law and served as chair of the Intellectual Property Department at Sedgwick LLP. As a practicing attorney, Prof. Helfing authored and argued the appeals in *Metcalf v. Bochco*, 294 F.3d 1069 (9th Cir. 2002) and *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072 (9th Cir. 2006), cases frequently cited for their application of the test for copyright infringement. Mr. Helfing has authored amicus briefs to the U.S. Supreme Court and the Ninth Circuit Court of Appeals regarding the infringement test. Among other articles, he wrote *Substantial Similarity in Literary Infringement Cases: A Chart for Turbid Waters*, 21 *UCLA L. REV.* 1 (2014), examining the courts' application of the test as applied specifically in literary infringement cases.

Substantial Similarity and Junk Science: Reconstructing the Test of Copyright Infringement

Robert F. Helfing*

As the standard of copyright infringement, “substantial similarity” is an ambiguous concept that produces unpredictable decisions often inimical to the purposes of copyright law. This Article explains the deficiencies of infringement tests based upon that standard. It also provides an innovative interpretation of copyright protection and presents a new test of infringement designed to directly determine whether that protection has been violated.

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INTRODUCTION

The development of copyright law has been a benighted effort to translate metaphysics into manageable legal principles. Confusion in the law is most evident in the tests of infringement. The violation can be simply defined: infringement is the unauthorized copying of protected artistic content. But case law provides only blurry and inconsistent explanations of protection and ineffective systems for evaluating illicit copying. The courts have settled for finding infringement in “substantial similarity,”¹ a legal chameleon that assumes a different appearance for each of three determinations made by the current tests and is clearly seen in none of them. The elusive standard frustrates the effective evaluation of claims by lawyers, generating unnecessary litigation. It also produces legal decisions that defeat the purposes of copyright law more often than should be tolerated.

This Article identifies the flaws of the current tests of the Second and Ninth Circuit Courts of Appeals—the circuits with the most experience in copyright law and the most influence on the others. It describes the kind of artistic creativity that justifies protection and demonstrates how that protection is violated. Finally, it proposes a new test that more effectively assesses infringement claims.

I. FLAWS OF THE CURRENT TESTS

A. Terminology

Confusing terminology is a pervasive flaw of the infringement tests. The term “substantial similarity” itself is particularly problematic. As the standard for three separate requirements of infringement, “substantial similarity” is a conclusory term that, for each one, simply means *enough* similarity.² Each of those requirements, however, addresses a different quality measured by different criteria.

¹ See, e.g., *Laureyssens v. Idea Grp., Inc.*, 964 F.2d 131, 139–40 (2d Cir. 1992); *Shaw v. Lindheim*, 919 F.2d 1353, 1356 (9th Cir. 1990).

² See *Peters v. West*, 692 F.3d 629, 633–34 (7th Cir. 2012). The “confusing nomenclature” in applying substantial similarity and related standards means simply that “works share enough unique features” to justify a finding of infringement. *Id.*

To prove infringement, a plaintiff must show copying.³ If copying cannot be proven with direct evidence, it may be established circumstantially with proof that the defendant had access to the copyrighted work, and that the works are substantially similar.⁴ For this determination, “substantial similarity” signifies that the works are so much alike that their similarity is more likely than not the result of copying.⁵

Not all copying, however, is infringement; to infringe, the copied content must be protected.⁶ Courts in the Ninth Circuit evaluate the protectability of similar content, in part, in its “extrinsic test.”⁷ Second Circuit courts use the “more discerning ordinary observer test” to make the same determination.⁸ As with the test for copying, the standard for this requirement is called, “substantial similarity”; but here, the term signifies that the similarity between the works at issue meets the “objective” criteria of protection.⁹

³ Without copying, there is no infringement, even if the accused work is an identical reproduction. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991); *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 765 (2d Cir. 1991); *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936).

⁴ See *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946); see also *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 482 (9th Cir. 1994).

⁵ See *Laureyssens*, 964 F.2d at 140; Alan Latman, “*Probative Similarity*” as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement, 90 COLUM. L. REV. 1187, 1214 (1990).

⁶ See *Feist*, 499 U.S. at 361 (requiring copying of “original elements”); see also *Laureyssens*, 964 F.2d at 140 (“protected material”); *Narell v. Freeman*, 872 F.2d 907, 910 (9th Cir. 1989) (“protected elements”); *Baxter v. MCA*, 812 F.2d 421, 423 (9th Cir. 1987) (“protectable expression”).

⁷ See, e.g., *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1118 (9th Cir. 2018); *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822–23 (9th Cir. 2002).

⁸ See, e.g., *Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp.*, 25 F.3d 119, 123–24 (2d Cir. 1994); *Laureyssens*, 964 F.2d at 141–42; *Folio Impressions, Inc.*, 937 F.2d at 765–66; *Effie Film, LLC v. Pomerance*, 909 F. Supp. 2d 273, 291 (S.D.N.Y. 2012). The Second Circuit has “disavowed” the need to evaluate the analytic protectability of similar content in a separate test. *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 66 (2d Cir. 2010) (quoting *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995)). As reflected by the authorities cited in this Article, however, the Second Circuit routinely dismisses claims based upon an analytically determined lack of protectable similarity. For a discussion of the “apparent tension” in the Second Circuit’s treatment of the requirement, see *Ward v. Andrews McMeel Publ'g, LLC*, 963 F. Supp. 2d 222, 231 (S.D.N.Y. 2013).

⁹ See, e.g., *Swirsky v. Carey*, 376 F.3d 841, 845 (9th Cir. 2004); *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1475 (9th Cir. 1992).

The plaintiff must also show that the works at issue are alike in “total concept and feel.”¹⁰ The standard applied for this determination is once again called “substantial similarity”; but here, the standard is applied through an explicitly subjective method: the presentation of the works at issue to determine whether they evoke a sufficiently similar emotional response in those who see, read, or hear them.¹¹

The use of the term “substantial similarity” to identify three different legal standards undermines clarity and consistency in the infringement analysis.¹² However, as discussed in the next Section, the current tests of infringement would not effectively evaluate infringement even if the courts applied the appropriate meaning of substantial similarity at each step of the process.

B. Methodology

1. Identification of Potentially Infringing Content

The current tests of infringement are fundamentally flawed because they fail to effectively identify the similarities evaluated for protectability. Under each test, the courts make this identification through “analytic dissection,” a method that breaks down the works at issue into structural categories.¹³ They then compare the corresponding categories of the respective works to derive the similarities between them.¹⁴ Pursuant to the principle that infringement must be

¹⁰ *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 133–34 (2d Cir. 2003); *see also* *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 1994); *Sid & Marty Krofft Television Prods. v. McDonald’s Corp.*, 562 F.2d 1157, 1165 (9th Cir. 1977) (citing *Arnstein v. Porter*, 154 F.2d 464, 468, 472–73 (2d Cir. 1946)).

¹¹ *See* *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001); *Shaw v. Lindheim*, 919 F.2d 1353, 1356–57 (9th Cir. 1990); *Krofft*, 562 F.2d at 1164.

¹² *See* *Repp v. Webber*, 132 F.3d 882, 889 n.1 (2d Cir. 1997) (differing meanings of the term result in “considerable confusion”).

¹³ *Comput. Assocs. Int’l v. Altai*, 982 F.2d 693, 707 (2d Cir. 1992); *see also* *Krofft*, 562 F.2d at 1164. In a claim involving literary works, for instance, the court dissects the works into plot, theme, dialogue, mood, setting, pace, characters, and sequence of events. *Berkic v. Crichton*, 761 F.2d 1289, 1292 (9th Cir. 1985); *see also* *Swirsky v. Carey*, 376 F.3d 841, 849 (9th Cir. 2004) (analyzing categories of musical works).

¹⁴ *See, e.g., Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1118 (9th Cir. 2018); *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822–23 (9th Cir. 2002); *Comput. Assocs. Int’l, Inc.*, 982 F.2d at 710–11.

based upon “protectible elements, standing alone,” the courts filter out—or, to make it doubly dismissive, “filter out and disregard”—similarities consisting of “unprotectable elements.”¹⁵ The excluded elements consist of *scènes à faire*, material in the public domain, or other components individually disqualified from protection.¹⁶ The courts then make the final determination by evaluating the remaining similarities for their collective protectability.¹⁷ Carried far enough, however, analytic dissection leaves nothing to evaluate because any “protectable element” of a work can be further dissected until nothing remains but its own unprotectable parts. As stated by the Second Circuit, “[I]f we took [analytic dissection] to its logical conclusion, we might have to decide that there can be no originality in a painting because all colors of paint have been used somewhere in the past.”¹⁸

To rescue this analysis from futility, the courts abandon the process of reduction before they reach the molecular particles of similar content.¹⁹ But case law provides no guidance for choosing the proper place to stop. Indeed, most courts engaged in this process appear unaware that they are cutting it short at all.

By considering only elements deemed protectable at an arbitrary level of dissection, courts fail to reliably identify the similar content that they evaluate for protectability.

¹⁵ *Cavalier*, 297 F.3d at 822–23.

¹⁶ *See Rentmeester*, 883 F.3d at 1118.

¹⁷ *See, e.g., Benay v. Warner Bros. Entm’t*, 607 F.3d 620, 624 (9th Cir. 2010); *Cavalier*, 297 F.3d at 822–23; *Hamil Am. Inc. v. GFI*, 193 F.3d 92, 100 (2d Cir. 1999); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995).

¹⁸ *Knitwaves, Inc.*, 71 F.3d at 1003 (internal quotation marks, citation omitted); *see also Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001); *Rentmeester*, 883 F.3d at 1119 (finding that when viewed in isolation, no element of a photograph qualifies for protection).

¹⁹ *See Diamond Direct, LLC v. Star Diamond Grp., Inc.*, 116 F. Supp. 2d 525, 528 (S.D.N.Y. 2000) (“Lest ‘every song [be] merely a collection of basic notes, every painting a derivative work of color and stroke, and every novel merely an unprotected jumble of words,’ a court cannot assess the originality of a work solely from the originality of the individual component parts” (quoting *Yurman Design Inc. v. PAJ, Inc.*, 93 F. Supp. 2d 449, 457 (S.D.N.Y. 2000))).

2. Copying of Protected Content

The current tests of infringement are flawed in another essential way. The tests require proof of copying, but they do not require proof that the copied content is protected: once the plaintiff establishes any copying at all of the copyrighted work, the requirement of copying is satisfied. The courts do undertake a separate inquiry into whether the works are “substantially similar” in protected content.²⁰ However, as previously noted, this version of substantial similarity is not the same as the one used to establish copying²¹; in this part of the test, the standard can be met by a level of similarity insufficient to establish copying.²² The result is that the plaintiff can establish infringement without showing that the particular content copied by the defendant is protected.

Certainly, proof that the defendant copied anything at all from the copyrighted work makes it more likely that the similar protected content was also copied. However, in failing to require a specific showing that protected content was copied, the courts take what should be only a factor and elevate it to an irrebuttable presumption.

3. Appropriation of Aesthetic Effect

The tests are also flawed in failing to assure that the copied content creates a sufficiently similar effect in the accused work as it does in the copyrighted work. The Second Circuit discussed this requirement in the seminal case, *Arnstein v. Porter*.²³ In analyzing the alleged infringement of a musical composition, the Court explained:

The plaintiff’s legally protected interest is not, as such, his reputation as a musician but his interest in

²⁰ See *Boisson*, 273 F.3d at 268; see also *Laureyssens v. Idea Grp., Inc.*, 964 F.2d 131, 140 (2d Cir. 1992); *Shaw v. Lindheim*, 919 F.2d 1353, 1356 (9th Cir. 1990).

²¹ See *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975) (“[S]ubstantial similarity to show that the original work has been copied is not the same as substantial similarity to prove infringement.”); see also *Laureyssens*, 964 F.2d at 140–41 (citing *Latman*, *supra* note 5, at 1193).

²² See *Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp.*, 25 F.3d 119, 123 (2d Cir. 1994); see also *Arnstein v. Porter*, 154 F.2d 464, 469 (2d Cir. 1946) (“[I]f copying is otherwise shown, proof of improper appropriation need not consist of similarities which, standing alone, would support an inference of copying.”).

²³ *Arnstein*, 154 F.2d 464.

the potential financial returns from his compositions which derive from the lay public's approbation of his efforts. The question, therefore, is whether defendant took from plaintiff's works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff.²⁴

Courts in both the Second and Ninth Circuits make this determination by comparing the "total concept and feel" of the works, measuring that quality by the aesthetic response of an ordinary person.²⁵ Because the test is subjective, the courts usually leave it for juries to apply.²⁶ But in responding to "what is pleasing" in works of authorship, juries do not distinguish protected content from unprotected content, nor do they distinguish copied content from uncopied content.²⁷ Thus, a jury may find that works are substantially similar where their primary aesthetic effect is attributable to their common use of public domain material or other freely available content.²⁸ Conversely, a jury may find that works lack substantial similarity where the effect of differences between

²⁴ *Id.* at 472–73.

²⁵ *See, e.g.*, *Hamil Am. Inc. v. GFI*, 193 F.3d 92, 102 (2d Cir. 1999); *Shaw v. Lindheim*, 909 F.2d 1353, 1360 (9th Cir. 1990); *Sid & Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1167 (9th Cir. 1977); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

²⁶ The Ninth Circuit has stated that the test is "exclusively the province of the jury." *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072, 1077 (9th Cir. 2006). Second Circuit courts "frequently" leave the issue for resolution by the jury. *See Warner Bros. Inc. v. Am. Broad. Cos.*, 720 F.2d 231, 239–40 (2d Cir. 1983); *see also Hogan v. DC Comics*, 48 F. Supp. 2d 298, 310 (S.D.N.Y. 1999); *Arnstein*, 154 F.2d at 473 ("[A] jury is peculiarly fitted to determine [the issue].").

²⁷ The Ninth Circuit has specifically rejected the use of analytic dissection, the only means of making that distinction, to evaluate substantial similarity in aesthetic effect. *Krofft*, 562 F.2d at 1165–66; *see also Shaw*, 919 F.2d at 1357 (intrinsic test is "virtually devoid of analysis"). The Second Circuit has stated that analytic dissection is unnecessary for that purpose. *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 66 (2d Cir. 2010).

²⁸ *See Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 207 (9th Cir. 1989) (reversing the jury decision on the basis that it erred by finding substantial similarity in applying the intrinsic test); *see also Olson v. Nat'l Broad. Co., Inc.*, 855 F.2d 1446 (9th Cir. 1988) (affirming judgment notwithstanding the verdict where jury found infringement).

the two works muffles the effect of protected similarity in the overall impression made by the accused work.²⁹ In the first instance, the jury finds infringement due to the similarity of unprotected content; in the second, it finds no infringement despite the similarity of protected content. In both instances, the test fails to fulfill its purpose—to determine whether the defendant’s use of protected content in the accused work produces a sufficiently similar aesthetic effect as it does in the copyrighted work.³⁰

II. THE SUBJECT OF THE INFRINGEMENT TEST

If the similarity between works is an ineffective measure of the copying of protected content, where should the courts look to evaluate infringement?

Infringement is copying, and copying is duplication. Similarity contains duplication but it also contains differences.³¹ To evaluate infringement by similarity, therefore, is to divert the analysis from its true subject, diluting it with elements that were not copied. It is the duplication in the works at issue that provides a direct, undiluted look at the only content that can provide a basis for a finding of infringement.

Imagine that someone steals a can of red paint from a hardware store. The police identify a suspect but when arrested, he only has purple paint, a mixture of red and blue, in his possession. The prosecutor attempts to prove the suspect’s guilt by showing that the shade of red in the purple paint matches the shade of red in the cans

²⁹ While this anomaly undoubtedly occurs, it does not appear that any published decision confirms it. The absence of definitive authority is likely attributable to the courts’ policy of deferring to jury decisions on this issue.

³⁰ The Second Circuit relies upon jury instructions to avoid these false outcomes. *See Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 134 (2d Cir. 2003) (In the case of graphic designs, the courts “generally have taken care to identify precisely the particular aesthetic decisions—original to the plaintiff and copied by the defendant—that might be thought to make the designs similar in the aggregate.”). However, any expectation that the jury will limit its determination to protectable similarity is undermined by the precept that the trier of fact be “principally guided” by the works’ total concept and overall feel. *Peter F. Gaito Architecture, LLC*, 602 F.3d at 66.

³¹ If there were no differences the works would not be merely similar, they would be identical, and there would be no need for a “substantial similarity” analysis.

at the store that were not stolen. He proposes to make that proof with expert testimony assessing the similarity of the purple mixture to the red paint that was not stolen. The judge disallows the testimony, rejecting the method as junk science. Substantial similarity is the junk science of copyright law. Where the reproduction is less than whole and verbatim, a work accused of infringement is like the purple paint of the hypothetical: a blend of elements, some which might have been taken from the copyrighted work, some which by definition could not have been. Determining infringement by the similarity between two such works is like determining the theft of the red paint by its similarity to the purple mixture.

While our prosecutor could not extract the red paint from the mixture for comparison, the parties to an infringement case *can* extract the duplicate content from an accused work. Why then blur the infringement inquiry by evaluating it by the similarity between the works? In the watershed opinion on copyright infringement, *Nichols v. Universal Pictures Corp.*,³² Judge Learned Hand stated directly that the infringement inquiry should focus upon duplication. In criticizing the overuse of expert opinion in the case, he expressed the hope that testimony in future cases be “confined to the actual issues; that is, whether the defendant copied [the plaintiff’s work], *so far as the supposed infringement is identical.*”³³ Consistent with that framing principle, he analyzed the claim by evaluating what the defendant “took” from the copyrighted work, i.e., what was “common” to both works.³⁴ The word “similarity” appears nowhere in the opinion. Indeed, the term “substantial similarity” is not found in any opinion written by Judge Hand. But in another notable case, he described the standard of infringement as “substantial *identity.*”³⁵ Hand understood that duplication is the stuff of infringement, and that the proper subject of the infringement test is the identifiable elements of duplication in the works at issue, not the disputable elements of similarity between them.

³² 45 F.2d 119 (2d Cir. 1930).

³³ *Id.* at 123 (emphasis added).

³⁴ *Id.* at 121–22.

³⁵ *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 52 (2d Cir. 1936) (emphasis added).

It is sometimes said that infringement does not require duplication.³⁶ This statement is true in the sense that infringement does not require duplication of the literal content of a copyrighted work.³⁷ A work, however, is more than its literal content. As stated by the Ninth Circuit in *Universal Pictures Co. v. Harold Lloyd Corp.*:

[I]nfringement is not confined to literal and exact repetition or reproduction; it includes also the various modes in which the matter of any work may be adopted, imitated, transferred, or reproduced, with more or less colorable alterations to disguise the piracy.³⁸

The rendering of a work in these “modes” is duplication, a duplication of something contained in the copyrighted work. The only difference to verbatim reproduction in this sort of copying is that the duplicated content exists below the literal surface of that work.³⁹ A writer might, for instance, copy from *Moby Dick* in creating a novel about a Los Angeles bus driver’s obsessive search for the neon green Ferrari whose reckless left turn cost the bus driver his job. There is duplication in such works: both tell the story of a person in charge of a transport, obsessed with finding an unusually pigmented nemesis. It is that duplication which should be evaluated for infringement, not the similarity between sea captains and bus drivers, the ocean and L.A. traffic, or sperm whales and sports cars.

³⁶ See, e.g., *Sid & Marty Krofft Television Prods. v. McDonald’s Corp.*, 562 F.2d 1157, 1167 (9th Cir. 1977) (“Duplication or near identity is not necessary to establish infringement.”).

³⁷ See *Nichols*, 45 F.2d at 121 (copyright protection “cannot be limited literally to the text”).

³⁸ *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 360 (9th Cir. 1947) (quoting 18 C.J.S. *Copyright and Literary Property* § 34); see also *King Features Syndicate v. Fleischer*, 299 F. 533, 535 (2d Cir. 1924).

³⁹ See *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 134 (2d Cir. 2003) (“[T]he defendant may infringe on the plaintiff’s work . . . by parroting properties that are apparent only when numerous aesthetic decisions embodied in the plaintiff’s work of art . . . are considered in relation to one another.”).

III. THE ANATOMY OF COPYRIGHT PROTECTION

For what do we examine the body of duplication? Two things: copying and protection. Copying is a physical act and, while its determination may involve some legal subtlety, the act itself is well understood. Protection, however, is an intangible quality, dimly realized, and described by legal authorities mostly in generalities. To develop a better method to evaluate the protectability of copied content, we need a better understanding of protection—its form, nature, and scope.

A. *The Form of Protection*

Protectability resides in the structure of a work, that is, the way its individual elements are put together. This fundamental principle was expressed no later than 1854 when Justice Erle of the British House of Lords wrote, “The subject of [copyrighted] property is the order of words in the author’s composition; not the words themselves, they being analogous to the elements of matter, which are not appropriated unless combined”⁴⁰ Erle likened a copyright to the property interest in a river, an interest found “not in any of the atoms of the water, but only in the flow of the stream.”⁴¹ Forty years later in *Holmes v. Hurst*, the U.S. Supreme Court wrote that Erle’s words “perhaps best defined” the nature of copyright.⁴² But the *Holmes* court defined it better, describing a copyright in a literary work as the exclusive right to exploit “that arrangement of words which the author has selected to express his ideas.”⁴³

Historically, the courts have given only intermittent recognition of the principle that copyright protection is a product of the selection and arrangement of elements.⁴⁴ In the 1976 Copyright Act, Congress

⁴⁰ *Jefferys v. Boosey*, 4 H. L. C. 815, 867 (1854).

⁴¹ *Id.* at 869.

⁴² *See Holmes v. Hurst*, 174 U.S. 82, 86 (1899).

⁴³ *Id.*

⁴⁴ *See, e.g., Warner Bros. v. Am. Broad. Cos.*, 720 F.2d 231, 243 (2d Cir. 1983) (“A character is an aggregation of the particular talents and traits his creator selected for him. That each one may be an idea does not diminish the expressive aspect of the combination.”); *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1169 (9th Cir. 1977) (“Lest we fall prey to defendants’ invitation to dissect the works, however, we should remember that it is the *combination* of many different elements which may command copyright protection because of its particular subjective quality.”)

adopted the principle for a particular kind of work, defining a “compilation” as a combination of preexisting materials that are “selected, coordinated, or arranged” in an original way.⁴⁵ In 1991, the Supreme Court applied the definition in *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, acknowledging that protection applies to a compilation of the names, addresses and numbers of a telephone directory if those individually unprotectable elements are arranged in an original way.⁴⁶ Later courts have used that principle in evaluating protection for works other than compilations, but only in limited circumstances—specifically, where the individual elements of the plaintiff’s work were conspicuously unprotectable, as in a popular musical composition or a simple ceiling lamp or a lifelike animal sculpture.⁴⁷ But the principle necessarily applies to *all* works because, as we have seen, all can be broken down to unprotectable elements.⁴⁸ The form of protection, therefore, is the way the individual elements of a work are arranged.

(emphasis added) (citing *Reyher v. Children’s Television Workshop, Inc.*, 533 F.2d 87, 91–92 (2d Cir. 1976)); *Ideal Toy Corp. v. Sayco Doll Corp.*, 302 F.2d 623, 624 (2d Cir. 1962); *Jeweler’s Circular Publ’g. Co. v. Keystone Publ’g. Co.*, 281 F. 83, 87–88 (2d Cir. 1922) (suggesting that originality sufficient for copyright protection could be found in the “collocation and concatenation” of a directory of trademarks) (quoting *Lamb v. Evans* [1893] 1 Ch 218 (Eng.)).

⁴⁵ 17 U.S.C. § 101 (2018); see also *United States v. Hamilton*, 583 F.2d 448, 452 (9th Cir. 1978); *Schroeder v. William Morrow & Co.*, 566 F.2d 3, 5 (7th Cir. 1977) (“An original compilation of names and addresses is copyrightable even though the individual names and addresses are in the public domain and not copyrightable.”).

⁴⁶ See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348–51 (1991).

⁴⁷ *Swirsky v. Carey*, 376 F.3d 841, 848 (9th Cir. 2004) (musical composition); *Lamps Plus v. Seattle Lighting Fixture Co.*, 345 F.3d 1140, 1146–47 (9th Cir. 2003) (ceiling lamp); *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) (jellyfish sculpture); see also *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 849 (9th Cir. 2012) (fabric designs); *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 136 (2d Cir. 2003) (carpet designs); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003–04 (2d Cir. 1995); *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994) (computer display).

⁴⁸ See *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 66 (2d Cir. 2010) (“[I]n the end, our inquiry necessarily focuses on whether the alleged infringer has misappropriated the original way in which the author has selected, coordinated, and arranged the elements of his or her work.”).

B. The Nature of Protection

What, then, is the nature of this “originality” that the selection and arrangement of elements must show? The Supreme Court tells us that originality has two separate components: independent creation and sufficient creativity.⁴⁹

1. Independent Creation

Originality means that the author independently created the work.⁵⁰ The Copyright Clause of the Constitution implies this requirement by empowering Congress to grant authors exclusive ownership in their creations “[t]o promote the Progress of Science and useful Arts.”⁵¹ That grant carries with it the potential for personal enrichment of an author, “[b]ut the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.”⁵² The copying of an existing work is unnecessary to fulfill that purpose because the creative activity needed to produce the work has already occurred. The copyright statute, therefore, provides for protection only to independently created works, that is, to content created without copying.

2. Sufficient Creativity

The Supreme Court stated in *Feist* that originality also means that a protected work shows sufficient creativity.⁵³ The yoking together of independent creation and sufficient creativity under the single term “originality” has dubious justification in precedent. The nineteenth-century cases cited by the *Feist* Court to support this interpretation suggest rather that the early Supreme Court understood the term to mean independent creation only, regarding creativity as an additional unconnected, requirement.⁵⁴ Whether or

⁴⁹ See *infra* Sections III.B.i–ii.

⁵⁰ See *Feist*, 499 U.S. at 345–47.

⁵¹ U.S. CONST. art. I, § 8, cl. 8.

⁵² *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975); see also *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932) (explaining that the “sole interest” of the government in granting the private monopoly lay in the “general benefits derived by the public from the labors of authors”).

⁵³ *Feist*, 499 U.S. at 358.

⁵⁴ See *Burrow-Giles Lithographic Co. v. Sardony*, 111 U.S. 53, 58–59 (1884); see also *John Muller & Co. v. N.Y. Arrows Soccer Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986)

not originality should be understood to comprise both independent creation and sufficient creativity, it is clear that the latter is required for protection.

The courts have never directly defined “creativity” as the term is applied in copyright law. However, the opinions that have addressed this aspect of originality show that the courts understand it to encompass two distinct attributes. The first attribute is inventiveness. This element must be carefully distinguished from novelty, that is, the quality of being new or entirely different from anything that has existed before. As stated long ago by the Supreme Court in *Baker v. Selden*, “[Novelty] is the province of letters-patent, not of copyright.”⁵⁵ Notwithstanding occasional high-profile waffling in the interim,⁵⁶ the Court affirmed twice in *Feist* that novelty is not required for protection.⁵⁷ Elsewhere in the opinion, however, the Court stated that, while artistic content need not be “surprising or innovative” to qualify for protection, it “cannot be so mechanical or routine as to require no creativity whatsoever.”⁵⁸ This language describes the requirement imposed by the “inventiveness” attribute of creativity.

The second attribute of creativity is expressive development.⁵⁹ The courts have addressed this attribute more directly than they have

(“[T]he issue here is creativity, not originality, although appellant’s argument tends to confuse the two.”); *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 102 (2d Cir. 1951) (“‘Original’ in reference to a copyrighted work means that the particular work ‘owes its origin’ to the ‘author.’”).

⁵⁵ *Baker v. Selden*, 101 U.S. 99, 102 (1879).

⁵⁶ See *Nichols v. Universal Pictures Co.*, 45 F.2d 119, 122 (2d Cir. 1930) (“[a]ssuming” that novelty is not required for protection); see also *Alfred Bell & Co.*, 191 F.2d at 102 (protection does not require a “large measure of novelty”).

⁵⁷ *Feist*, 499 U.S. at 345–46, 358.

⁵⁸ *Id.* at 362 (referring to protection for a selection and arrangement of facts). This was the apparent meaning attached to the term “novelty” by the Second Circuit in *Alfred Bell & Co.*, 191 F.2d at 102 (“No large measure of novelty is necessary” for copyright protection.).

⁵⁹ See *Nichols*, 45 F.2d at 121 (“[T]he less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.”); see also Hon. Leon R. Yankwich, *Originality in the Law of Intellectual Property (Its Meaning from A Legal and Literary Standpoint)*, 11 F.R.D. 457, 458 (1952) (originality requires the “distinctive unfoldment” of ideas).

inventiveness. They expressly attribute the need for an expressiveness requirement to friction between the Copyright Clause and the First Amendment⁶⁰: the former empowers the government to prohibit the general use of artistic creations,⁶¹ while the latter prohibits the government from restricting the communication of intellectual content.⁶² To harmonize these two conflicting methods of achieving cultural growth, the courts in copyright cases developed what has become known as the “idea/expression dichotomy.” As stated by the Second Circuit, “This principle attempts to reconcile two competing societal interests: rewarding an individual’s ingenuity and effort while at the same time permitting the nation to benefit from further improvements or progress resulting from others’ use of the same subject matter.”⁶³ Under the dichotomy, a copyright protects “expression”—the way ideas are expressed—but leaves the ideas themselves free for common use.⁶⁴

The division of artistic content into “ideas” and “expression” is another instance of loose terminology. Rightly understood, “expression” is the rendering of an artistic conception in externally perceptible form.⁶⁵ Under that definition, the thing that copyright law dismisses as a “mere idea” is in fact expression, i.e., a physical representation of an artistic conception; what it elevates as “expression” is simply an idea developed in sufficient detail. The distinction is not between idea and expression: it is between sufficient and insufficient development of an artistic premise.

The creativity requirement demands satisfaction of both attributes. Inventiveness alone does not satisfy it. To illustrate, some

⁶⁰ See *Reyher v. Children’s Television Workshop*, 533 F.2d 87, 90 (2d Cir. 1976); see also *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985).

⁶¹ U.S. CONST. art. I, § 8, cl. 8; see also *Mazer v. Stein*, 347 U.S. 201, 207–08 (1954).

⁶² U.S. CONST. amend. I; see also *Red Lion Broad. Co. v. F.C.C.*, 395 U.S. 367, 390 (1969); *Associated Press v. United States*, 326 U.S. 1, 20, 65 (1945).

⁶³ *Reyher*, 533 F.2d at 90; see also *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349–50 (1991); *Harper & Row*, 471 U.S. at 556 (idea/expression dichotomy “strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts [and ideas] while still protecting an author’s expression”).

⁶⁴ *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 67 (2d Cir. 2010); see also 17 U.S.C. § 102(b) (protection does not extend to ideas embodied in work).

⁶⁵ Cf. *Goldstein v. California*, 412 U.S. 546, 561 (1973) (defining a “writing,” the constitutionally prescribed subject matter of copyright, as “any physical rendering of the fruits of the author’s creativity”).

scholars credit Jules Verne's novel, *From the Earth to the Moon*, as the first literary work about human beings leaving the earth in a spaceship.⁶⁶ The idea/expression dichotomy denies Verne an exclusive right to create works about vehicular space travel, even if he independently created a work expressing that premise, indeed, even if he was the first to independently create one.⁶⁷ The reason is that artistic progress would be impaired by limiting the expression of that broad premise to the imagination of a single person.⁶⁸ The idea/expression dichotomy, however, allows for a monopoly in the exploitation of the novel as a whole because cultural growth is enhanced, not hindered, by the award of exclusive rights in the detailed development that Verne gave to that concept in the pages of his book.⁶⁹

Likewise, sufficient expressiveness alone does not satisfy the creativity requirement. A screenwriter might, for instance, create a prison script featuring a wrongly convicted inmate, a feud between prisoners, abuse by sadistic guards, a riot in the dining hall, an escape through a concrete cell wall, and a chase through the woods by police with shotguns and bloodhounds. That selection and arrangement of elements may be sufficiently expressive, but the work is nonetheless unworthy of protection because it lacks sufficient inventiveness.

C. *The Scope of Protection*

If a work is protected, to what does the protection extend? The Copyright Act states that "protection subsists . . . in original works of authorship . . ."⁷⁰ The Act does not define the term "original

⁶⁶ In that book published in 1865, characters propose to travel to the moon in a bullet-shaped projectile fired from a cannon.

⁶⁷ See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122 (2d Cir. 1930) (Though plaintiff "discovered the vein" of a creative theme that made her work popular, it was too general to warrant protection.).

⁶⁸ See *Feist*, 499 U.S. at 349–50 (noting that the general right to use "ideas" embodied in copyrighted works promotes the advancement of art).

⁶⁹ See *Mazer v. Stein*, 347 U.S. 201, 219 (1954) ("The 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 useful Arts.'"); see also *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985).

⁷⁰ 17 U.S.C. § 102 (2018).

work of authorship,” but the definitions provided by the Act for particular kinds of “works of authorship” suggest that it means the entire creation, as fixed by the author in tangible form.⁷¹ A copyright, therefore, protects the covered work against full, verbatim copying. The protection, however, is broader than that: it extends also to parts of the work that independently satisfy the requirements of inventiveness and creativity.⁷² There are two types of potentially protected parts: verbatim segments,⁷³ and non-verbatim renderings of the entire work⁷⁴ or of any verbatim segment.⁷⁵

Works of authorship may be divided into verbatim segments, such as the movements of a symphony, the stanzas of a poem, the chapters of a book, or the sections of a painting.⁷⁶ They may also be divided into discrete parts consisting of verbatim elements interwoven throughout the work, such as characters whose attributes are disclosed piecemeal in the course of a novel.⁷⁷ Considered in isolation, each kind of these verbatim parts is itself a work or, to put a finer point on it, a work-within-a-work.

Works of authorship also include an unlimited number of alternate versions that express the same artistic principle, but with

⁷¹ For instance, the definition of “literary works” refers to “books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards,” but not to their parts. *Id.* § 101.

⁷² *Feist*, 499 U.S. at 351 (independent originality “determine[s] which component parts of a work [a]re copyrightable and which were not”) (citing 17 U.S.C. § 3 (1909) (repealed 1976)); see also *Walt Disney Prods. v. Air Pirates*, 345 F. Supp. 108, 111 (N.D. Cal. 1972) (“[P]roTECTIBILITY as to a component part depends . . . strictly upon the status of the questioned part within the protected whole, and the characteristics and quality of that part, considered by itself.”).

⁷³ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (affirming that a work is protected against verbatim copying of a “substantial” part).

⁷⁴ *Comput. Assocs. Int’l v. Altai*, 982 F.2d 693, 701 (2d Cir. 1992) (affirming that a work is protected against copying of its “fundamental essence or structure”) (quoting 3 MELVILLE NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 13.03[A][1] (1991)).

⁷⁵ *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 361 (9th Cir. 1947) (affirming that copyright in motion picture may be infringed by non-verbatim copying of scene); see also *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 55–56 (2d Cir. 1936) (finding infringement in non-verbatim copying of individual scenes of play); *Chappell & Co. v. Fields*, 210 F. 864, 865 (2d Cir. 1914) (finding infringement in non-verbatim copying of single scene of musical comedy).

⁷⁶ See *Nichols*, 45 F.2d at 121 (referring to the potential protectability of the scenes of a play or parts of dialogue).

⁷⁷ See *Warner Bros. v. Am. Broad. Cos.*, 720 F.2d 231, 241–42 (2d Cir. 1983) (character revealed “episodically”).

less detailed development than their verbatim content. Although these non-verbatim renderings do not replicate the literal expression of the work, they are nonetheless contained by it. In *Nichols v. Universal Pictures*, Judge Learned Hand described these forms and the limit of their protectability. In a passage that has come to be known as the “abstractions test,” Hand wrote:

Upon any work . . . a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the [work] is about, and at times might consist of only its title; but there is a point in this series of abstractions 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.⁷⁸

In this passage, Hand was addressing only the expressiveness needed to satisfy the creativity standard.⁷⁹ As more and more detail is left out, however, an “abstraction” may also lose the inventiveness required for protection.⁸⁰ As with any other artistic content, the abstraction must satisfy both requirements of inventiveness and creativity.⁸¹ To qualify for protection, however, an abstraction must satisfy a requirement not imposed upon verbatim parts: it must convey the same artistic idea as the protected work, or the protected part of the work, from which it derives.⁸²

This requirement, too, was recognized no later than the nineteenth century when a British court defined a “copy” as a work so like the original that it gives “to every person seeing it the idea created by the original.”⁸³ In the language following his abstractions test, Judge Hand addresses this requirement by stating that the copying of an abstraction is not analogous to simply “lifting a

⁷⁸ See *Nichols*, 45 F.2d at 121.

⁷⁹ See *id.*

⁸⁰ *Silver Ring Splint Co. v. Digisplint, Inc.*, 543 F. Supp. 2d 509, 517 (W.D. Va. 2008).

⁸¹ See *id.*

⁸² See *id.*

⁸³ *White-Smith Music Publ’g v. Apollo*, 28 S. Ct. 319, 323 (1908) (quoting *West v. Francis*, in 5 BARN. & ALD. 1, 742–43 (1822) (Bailey, J., concurring)).

portion out of the copyrighted work.”⁸⁴ The copyright in a work provides protection only for an abstraction that forms a “skeleton” of the work, a structure that “pervades and supports the whole.”⁸⁵ The concern here, wrote Hand, is not with how elements are expressed, but with *what* they express—specifically, whether the copied elements render the same artistic premise as the protected work.⁸⁶ Indeed, a combination of elements that expresses a different premise is not an “abstraction” of the protected work at all.

Let us consider this principle in the context of musical works. The melodic structure of a complex musical composition may serve as its skeleton, an abstracted part that pervades and supports it. However, individual notes can be taken from a copyrighted composition to form a melody that sounds entirely different from the composition. That different melody might by itself be sufficiently developed to warrant protection, but in that combination, its notes are not protected by the copyright in the composition; others are free to copy those notes from the protected composition just as they might take them from the public domain. To warrant protection, the combination of copied notes must form an independently protectable work that conveys the same tune or other musical premise; in other words, it must form a musical work that *sounds like* the copyrighted composition.

For a visual illustration, we turn to the *Mona Lisa*:



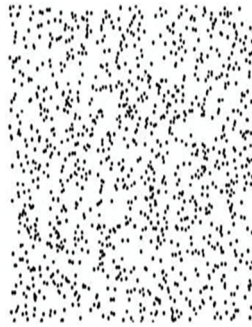
⁸⁴ *Nichols*, 45 F.2d at 121.

⁸⁵ *Id.*

⁸⁶ *See id.*; *see also* *Warner Bros. Inc. v. Am. Broad. Cos.*, 720 F.2d 231, 243 (2d Cir. 1983) (“[J]ust as similarity cannot be rejected by isolating as an idea each characteristic the characters have in common, it cannot be found when the total perception of all the ideas as expressed in each character is fundamentally different.”).

The image on the left is a fully rendered segment of the *Mona Lisa*, sufficiently expressive to qualify for protection. The one on the right duplicates numerous elements found in the fully rendered segment; it omits many others but still expresses the visual form of the segment with enough detailed development to qualify for protection. If the *Mona Lisa* were protected by copyright, the image on the right is clearly developed with enough expressive detail to be an infringing abstraction. Now imagine that a verbatim copy of the *Mona Lisa* is chopped into confetti and the pieces are mixed in a hopper and randomly glued together. The new work would consist of copies of each and every element of the *Mona Lisa*, but in that arrangement the copyright does not protect them. The reason is that the rendering does not express the “idea,” or visual premise, of that work.

Similarly, one might copy less than all of the elements of the *Mona Lisa* in exactly the same position as they appear in that work to create the following work:



This new work consists entirely of elements copied from the *Mona Lisa*, arranged in exactly the same way. Further, it can be argued that this image is sufficiently developed to qualify for protection. Again, however, in this particular selection and arrangement, the copied elements do not express the visual premise, or “idea,” of the *Mona Lisa*—that is, they do not form an image that *looks like* it. Therefore, the copying does not infringe the copyright in that work.

In short, the copyright in a work of authorship protects the verbatim content of the entire work. It also protects any verbatim or non-verbatim rendering of the entire work or of a part, where the

rendering is independently conceived and both sufficiently inventive and sufficiently expressive of the same artistic premise.

IV. A RECONSTRUCTED TEST

Consistent with the foregoing principles, I propose a new test for infringement with the following framework.

A. Establish the Protectability of the Foundational Work

The plaintiff must first establish a foundation for the claim by showing that the alleged copying involves protected content. In many cases, the protectability of the copyrighted work as a whole will provide that foundation. However, where the alleged unlawful copying touches only a part, then the plaintiff must show that the part independently meets the requirements of protection.⁸⁷ To expedite and focus the analysis, the “foundational work” should be identified as narrowly as possible.⁸⁸

B. Identify Relevant Duplication

Next, the plaintiff must identify the elements of relevant duplication between the foundational work and the work accused of infringement. The plaintiff makes this identification just as courts identify similarities under the current tests: by analytic dissection—that is, a comparison of the corresponding structural categories of the works at issue.⁸⁹ Under the proposed test, however, we dissect the works solely to simplify and organize the process of identifying duplication. We do *not* dissect to determine the protectability of duplication in any “element” or individual structural category: if there is significant duplication in a particular category, the content falling within that category would be isolated as a part of the

⁸⁷ See *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1476 (9th Cir. 1992) (approving the use of analytic dissection to determine the scope of protection because “the source of the similarity must be identified and a determination made as to whether this source is covered by plaintiff’s copyright”).

⁸⁸ We speak here of a substantive basis for the claim, not of the registration requirement imposed by 17 U.S.C. § 412. Since the copyright in an entire work provides protection for its independently protectable parts, the registration of that copyright resolves the procedural issue addressed by the statute.

⁸⁹ See *supra* Section I.B.

work and would by itself serve as the foundational work for an infringement claim.

Thus, where the plaintiff claims infringement of a musical work, the court would dissect the works into such categories as melody, harmony, pitch, rhythm, and lyrics. It then identifies the duplication between them, and the collective body of duplication is analyzed for infringement of the entire musical work. Where the content of any of the musical categories in the copyrighted work—say, its rhythm—is independently entitled to protection and there is enough duplication of rhythmic elements to justify the analysis, the rhythm of each of the two works is dissected into its own structural categories: tempo, note values, accents, beats per measure, etc.⁹⁰ The court then identifies the specific elements of duplication within those categories as part of a separate infringement analysis.

The method we propose is objective. An element is either found in both works or it is not, even if the duplication lies beneath the literal surface of the works. In one work, for example, a man commits an armed robbery of a bank; in the other, a woman blows a hole in the basement wall of a check-cashing store to gain access to a safe. Devoid of literal reproduction, the scenes nonetheless contain objectively derived duplication: the burglary of a financial establishment.

The proposed method also has a subjective component: how far to dig beneath the literal surface for material duplication? This determination is a matter of legal instinct. Generally, the more abstraction required to reveal duplication, the weaker the claim. Where the elements of a work's expressive detail are few, or their variation slight, protection for the work lies close to the surface.⁹¹ Thus, protection for a limerick, for instance, goes little beyond its fully rendered form. Conversely, for a work dense with varied detail, however, the levels of protection run deep. A list of one-sentence summaries of each of the 361 chapters of *War and Peace* forms a selection and arrangement protected by the copyright.

⁹⁰ See *New Old Music Grp., Inc. v. Gottwald*, 122 F. Supp. 3d 78, 86 (S.D.N.Y. 2015).

⁹¹ *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1439 (9th Cir. 1994) (where range of protectable expression is narrow, protection exists only for “virtually identical” copying of entire work).

No matter the level of abstraction, the test we propose does not automatically cast aside the duplication in “unprotectable elements.” The reason is that, by indiscriminately filtering out and discarding unprotectable elements from the infringement analysis, a court may eliminate parts that in some cases are necessary to determine that the copied content is protected.⁹² The only duplicate elements excluded from the analysis are those that, given the nature of the works, do not foreseeably contribute to the formation of an original selection and arrangement.

C. Evaluate the Originality of Duplicate Content

1. Creativity

Having identified the relevant elements of duplication, the courts must next determine whether that body of potentially copied content is entitled to protection. There are a thousand-and-one conditions of copyright protection that might need to be addressed in a particular case, but the fundamental requirements of creativity—that is, the inventiveness and expressiveness of a work—must be addressed in all cases.

An evaluation of inventiveness occupies a place in the traditional tests of infringement through the doctrine of *scènes à faire*. Under that doctrine, infringement cannot be based upon the copying of content that is commonplace, facile or unavoidable in expressing a particular artistic conception.⁹³ The same analysis is applied in our proposed test to determine whether the duplicate content meets the requirements of this aspect of creativity.

⁹² *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979–80 (2d Cir. 1980) (“By factoring out similarities based on non-copyrightable elements, a court runs the risk of overlooking wholesale usurpation of a prior author’s expression.”).

⁹³ *See, e.g.*, *Frybarger v. Int’l Bus. Machs. Corp.*, 812 F.2d 525, 530 (9th Cir. 1987); *Alexander v. Haley*, 460 F. Supp. 40, 45 (S.D.N.Y. 1978) (applies to elements that are “indispensable, or at least standard” in treating premise of work) (quoting *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980)); *see also Swirsky v. Carey*, 376 F.3d 841, 850 (9th Cir. 2004); *Cavalier v. Random House, Inc.*, 297 F.3d 815, 823 (9th Cir. 2002) (“[f]amiliar stock scenes and themes”); *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir. 1985) (“flow naturally from a basic plot premise”); *Reyher v. Children’s Television Workshop*, 533 F.2d 87, 91 (2d Cir. 1976) (features that “necessarily follow from a common theme” (emphasis added)).

Next, there must be an evaluation of the sufficiency of expressive development. To infringe, duplicate content need not reach the same level of development as the foundational work.⁹⁴ How much expressiveness is required to warrant protection for the copied parts of protected works? There is no objective measure to apply in making that determination; as Judge Hand wrote in describing the line between idea and expression, “[n]obody has been able to fix that boundary, and nobody ever can.”⁹⁵ An applicable standard, however, does exist. As an attribute of creativity, expressiveness must be weighed by the benchmark set forth in *Feist*:

To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, “no matter how crude, humble or obvious” it might be.⁹⁶

In evaluating the protectability of works of authorship, the courts do require only minimal creativity. In evaluating the protectability of copied content to determine infringement, however, courts generally require a higher level of creativity.⁹⁷

This heightened standard is understandable where the subject of the infringement analysis is similarity: since they are evaluating content that contains only partial duplication, courts instinctively require a more stringent level of creativity to impose liability. On the other hand, where the subject of the analysis is duplication—where, that is, *all* of the content evaluated for infringement is found in the copyrighted work—there is no justification for applying a higher standard. Imagine that the author of a copyrighted work had instead created a narrower work which the defendant copied whole

⁹⁴ See *supra* Section III.C.

⁹⁵ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930); see also *Shaw v. Lindheim*, 919 F.2d 1353, 1356 (9th Cir. 1990) (“It is . . . impossible to articulate a definitive demarcation that measures when the similarity between works involves copying of protected expression . . .”).

⁹⁶ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991) (quoting 1 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.08[C][1] (1990)).

⁹⁷ Cf. *Funky Films, Inc. v. Time Warner Entm’t Co.*, 462 F.3d 1072, 1081 (9th Cir. 2006) (rejecting an infringement claim because the similarity in elements of screenplay were held unprotected); *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1077 (9th Cir. 2000) (holding a commercial photograph of vodka bottle protected).

and verbatim. If that narrower work meets the requirements of protection, no one would dispute that it is infringement to make an unauthorized copy of its content. It is likewise infringement to copy that same protectable content when it is contained in a broader work. A standard of protection is no standard at all where it does not prohibit the unauthorized copying of the parts of a work that independently meet it.

The undemanding measure of creativity required for protection does not argue against its application in the infringement determination: if there is good reason to apply a low standard in the one case, then there is that same good reason to apply it in the other. What is that reason? The Supreme Court did not explain in *Feist* why the creativity threshold is set so low. The Court did, however, provide an answer ninety years earlier. In *Bleistein v. Donaldson*⁹⁸ the Court found protection for circus posters, an art form held in limited regard by the Court.⁹⁹ In justifying the holding, Justice Holmes explained that even “a very modest grade of art has in it something irreducible, which is one man’s alone.”¹⁰⁰ That irreducible something, wrote Holmes, is entitled to protection, and it is not for the courts to pass judgment on its artistic merit:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [artistic works], outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge.¹⁰¹

⁹⁸ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

⁹⁹ *See id.*

¹⁰⁰ *Id.* at 250.

¹⁰¹ *Id.* at 251. The *Feist* Court was more than merely aware of this language when it confirmed that protection requires only minimum creativity. The Court quoted from it to affirm that there is only “a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.” *Feist*, 499 U.S. at 358–59.

The leniency of the creativity threshold seemingly undermines the balance struck between copyright law and the First Amendment through the idea-expression dichotomy: if a work shows only minimal inventiveness and expressive development, why exclude it from the public domain by granting exclusive rights to the author? There is no fully satisfying answer. But there *is* room within the standard to allow courts to enforce constitutional concerns. As the *Feist* court noted, “The standard . . . is low, but it does exist.”¹⁰² Some courts may still balk at the prospect of holding a copyist responsible for taking a part of a copyrighted work that shows only a minimal level of creativity. To them, we refer to Justice Holmes’s response to an argument that the plaintiff’s works were too pedestrian to merit protection: “That [the works] had their worth . . . is sufficiently shown by the [defendants’] desire to reproduce them without regard to the plaintiffs’ rights.”¹⁰³

Courts in the Ninth Circuit determine the sufficiency of expressive development in the extrinsic test which they characterize as “objective.”¹⁰⁴ It is true that there is no objective measure but, as we have noted, there are objective signs that signal the level of creativity.¹⁰⁵ The volume of elements comprising a work is an important factor in evaluating the degree of inventiveness and expressive development of that work. However, a high number of elements signifies creativity only to the extent such elements vary in nature. A telephone directory, for example, may contain thousands of separate entries, but if each one is merely the name, place of residence, or telephone number of phone service subscribers

¹⁰² *Feist*, 499 U.S. at 362 (citing L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. REV. 719, 760 n.144 (1989) (stating that the threshold is “not without effect”).

¹⁰³ *Bleistein*, 188 U.S. at 250–52 (citing *Henderson v. Tomkins*, 60 F. 758, 765 (C.C.D. Mass. 1894)).

¹⁰⁴ *Berkic v. Crichton*, 761 F.2d 1289, 1292 (9th Cir. 1985); *see also* *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1174 (9th Cir. 2003) (“objective measure”); *Shaw v. Lindheim*, 919 F.2d 1353, 1357 (9th Cir. 1990) (extrinsic test is an “objective analys[is]” of expressiveness); *Bernal v. Paradigm Talent & Literary Agency*, 788 F. Supp. 2d 1043, 1059 (C.D. Cal. 2010) (“objective evaluation”).

¹⁰⁵ *See supra* Section IV.B.i.

arranged in alphabetical order, their selection and arrangement is not sufficiently developed for protection.¹⁰⁶

2. Corresponding Expression

The courts do not acknowledge the requirement that, for infringement to be found, the copied content must express the same artistic premise as the protected work. They may not even realize that any such requirement exists. However, by testing for substantial similarity in the “total concept and feel” of the works at issue, they enforce that requirement. The traditional tests determine that aspect of substantial similarity by the emotional response of the jury.¹⁰⁷ The method works: where works express the same premise, they feel similar; where they express a different premise, they feel different. Our proposed test applies the same method but to a more focused subject matter. As discussed above, a comparison of the works in their entireties permits the outcome to be determined by analytic noise—that is, the influence of unprotected content in the copyrighted work or uncopied content in the allegedly infringing work. The proposed test eliminates that noise by specifically comparing the effect of the duplicate content to that of the foundational work: duplicate content is protected only where they evoke the same kind of aesthetic response.

The Ninth Circuit’s intrinsic test requires “substantial similarity” in the effect of the respective works;¹⁰⁸ the Second Circuit’s ordinary observer test requires their effect to be “the same.”¹⁰⁹ Our test asks whether the duplicate content produces the “same kind” of effect. Where the duplication expresses the premise of the foundational work, it evokes a response that might differ in degree but will be identical in kind.

Earlier in this Article, we showed how the duplication in a protected part of the *Mona Lisa* might be presented to allow an ordinary observer to compare its effect with that of the protected part

¹⁰⁶ See *Feist*, 499 U.S. at 363.

¹⁰⁷ See *supra* Section I.A.

¹⁰⁸ *Sid & Marty Krofft Television Prods. v. McDonald’s Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

¹⁰⁹ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

itself.¹¹⁰ In some cases, the means to allow such a comparison will be more difficult to devise. The challenge, however, is no greater than many faced regularly by litigators in presenting a case for determination.

D. Copying

If it is shown that any duplicate content is entitled to protection, only one additional element must be proven to establish infringement: the protected duplication must result from copying.¹¹¹

As with the current tests, the fact of copying can be established with direct evidence, such as an admission of the copyist or the testimony of a witness. As also permitted by the current tests, copying can be proven circumstantially with evidence that the alleged copyist had access to the copyrighted work and that the duplication is of a type more likely to result from copying than from coincidence.¹¹² The question of the defendant's access—that is, a reasonable opportunity to copy the foundational work—requires a straightforward factual determination that juries are routinely required to make in less nuanced areas of law. The likelihood that artistic content was copied from another work, however, is a subjective determination particular to copyright law.

Circumstantial proof of copying overlaps with proof of sufficient creativity: the more inventive or expressive the duplicated content, the more likely the duplication resulted from copying.¹¹³ The degree required to establish copying in many cases, however, is more stringent; to prove protectability, creativity need only be minimal; to prove copying, however, the creativity of duplicate content must outweigh the evidence supporting independent creation.¹¹⁴ Duplication showing an exceptionally high degree of inventiveness or expressiveness stamps the accused work as

¹¹⁰ See *supra* Section III.C.

¹¹¹ See *supra* Section I.A.

¹¹² See *supra* Section I.A.

¹¹³ See *Metcalf v. Bochco*, 294 F.3d 1069, 1074 (9th Cir. 2002) (citing *Shaw v. Lindheim*, 919 F.2d 1353, 1363 (9th Cir. 1990)) (“[T]he totality of the similarities . . . goes beyond the necessities of the . . . theme and belies any claim of literary accident.”).

¹¹⁴ See *supra* Section I.A.

“strikingly similar.” As with the current tests, striking similarity can eliminate the need to show access in proving copying.¹¹⁵

V. THE ROLES OF JUDGE, JURY AND EXPERT

Courts in the Second and Ninth Circuits have not hesitated to summarily reject infringement claims based upon a judicial determination that the similarity between works fails to meet the “objective criteria” of protection.¹¹⁶ As to similarity in total concept and feel, the courts initially disfavored summary disposition because that quality is measured by the subjective response of an ordinary person.¹¹⁷ The Ninth Circuit has been mostly faithful to this judicial restraint.¹¹⁸ The Second Circuit, however, has loosened the reins and expressly authorized the summary resolution of claims on the basis of a judge’s emotional response to works of authorship.¹¹⁹ In either

¹¹⁵ *Baxter v. MCA, Inc.*, 412 F.2d 421, 423–24 (9th Cir. 1987); *Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir. 1984); *Ferguson v. Nat’l Broad. Co.*, 584 F.2d 111, 113 (5th Cir. 1978); *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

¹¹⁶ *See, e.g., Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir. 1984); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 977 (2d Cir. 1980).

¹¹⁷ *See, e.g., Sid & Marty Krofft Television Prods. v. McDonald’s Corp.*, 562 F.2d 1157, 1165 (9th Cir. 1977); *Arnstein*, 154 F.2d at 468. Indeed, in *Arnstein*, Judge Frank suggested that summary judgment was appropriate only in cases of manifest dissimilarity, giving as an example a hypothetical claim that Ravel’s *Bolero* or Shostakovich’s *Fifth Symphony* infringes *When Irish Eyes Are Smiling*. *Id.* at 473.

¹¹⁸ It is perhaps more accurate to say that they have been mostly faithful to it in word. *See, e.g., Swirsky v. Carey*, 376 F.3d 841, 845 (9th Cir. 2004); *Shaw*, 909 F.2d at 1360 (“It is not the district court’s role, in ruling on a motion for a summary judgment, to limit the interpretive judgment of each work to that produced by its own experience.”). They have not, however, been faithful to it in deed. Ninth Circuit courts summarily dismiss claims in applying the extrinsic test, finding that the similarities between works are “random.” *See, e.g., Cavalier v. Random House, Inc.*, 297 F.3d 815, 825 (9th Cir. 2002); *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994); *Litchfield*, 736 F.2d at 1356. Ninth Circuit courts also dismiss claims in applying the extrinsic test, finding that the differences between the works “outweigh” the similarities. *See Benay v. Warner Bros. Entm’t*, 607 F.3d 620, 625 (9th Cir. 2010); *Bernal v. Paradigm Talent & Literary Agency*, 788 F. Supp. 2d 1043, 1068–69 (C.D. Cal. 2010). Although the extrinsic test is meant to be controlled by objective analysis, those findings are in fact subjective determinations that the works do not render the same idea—that is, that despite the similarities, they *feel* different.

¹¹⁹ *See Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 66 (2d Cir. 2010) (“The question of substantial similarity is by no means exclusively reserved for resolution by a jury, however, and we have repeatedly recognized that, in certain

circuit, however, it is a flip of the coin whether the issue is more suited to resolution by a judge or a jury in any particular case. A judge is more likely to make the decision based upon a comparison of an emotional response to relevant—that is, *protected*—content; a jury, however, provides better representation of that fictitious ordinary person whose emotions are meant to be the measure of that response.¹²⁰

Our proposed test provides greater clarity than do the traditional tests of the roles played by judge and jury in determining infringement. A determination of sufficient creativity necessarily involves subjective judgment; under the proposed test, there is no pretense that the sufficiency of inventiveness or expressive development is determined by cold objective analysis. Judges may nonetheless make that determination as a matter of law, and may even summarily decide the additional determination, traditionally reserved to juries, that the foundational work and the duplicate content evoke the same kind of emotional response in ordinary people. The proposed test allows judges to make those determinations as a matter of law, but the more precise focus and greater clarity of the standards of the test provide a better basis than do the current tests to decide whether the issues should truly be decided by summary resolution.

No matter who decides the ultimate question, the courts should be more receptive to the assistance of expert testimony, particularly in evaluating whether duplicate content is sufficiently creative. The degree of both inventiveness and expressiveness often requires the judgment of those professionally schooled in the conventions of the art form and the practices of the industry at issue in particular cases.

circumstances, it is entirely appropriate for a district court to resolve that question as a matter of law, ‘either because the similarity between two works concerns only non-copyrightable elements of the plaintiff’s work, or because no reasonable jury, properly instructed, could find that the two works are substantially similar.’”).

¹²⁰ See *Anderson v. Stallone*, No. 87–0592 WDKGX, 1989 WL 206431, at *12 (C.D. Cal. Apr. 25, 1989) (Summary adjudication of substantial similarity is most problematic “when the Court puts itself in the place of the reasonable audience and evaluates the total look and feel of a work under the intrinsic test.”).

CONCLUSION

In deciding a literary infringement claim eight years after *Nichols v. Universal Pictures*, two members of a Second Circuit panel shrugged off Learned Hand's abstractions test stating, "[the] use of the device of 'abstractions' seems but a new name for comparing 'similarity of sequences of incident'. It is naturally difficult to compare literary works by using the terminology of metaphysics, and the rule thus provided does not seem to have been used since its suggestion."¹²¹

The majority in that case was wrong in dismissing the abstractions test as simply a new name for determining infringement by similarity: the test in fact described an entirely different method for determining infringement, one that does not consider similarity at all.¹²² However, the majority was right in observing that it is difficult to decide copyright issues framed in metaphysical terms. It is an inconvenient fact, however, that copyright law is a metaphysical creature.¹²³ In confronting its inherent uncertainty, the courts have developed tests based upon the nebulous and misdirected standard of "substantial similarity." This Article provides a new test that is not only more definite, focused, and predictive of outcome, it is truer to the constitutional premises of copyright law.

¹²¹ *Shipman v. R.K.O. Radio Pictures*, 100 F.2d 533, 537 (2d Cir. 1938).

¹²² As a member of the panel that decided the *Shipman* case, Judge Hand took pains to write a concurrence that disavowed the majority opinion to the extent that it departed from his conception of layered protection. *Id.* at 538.

¹²³ See *Folsom v. Marsh*, 9 F. Cas. 342, 344 (C.C.D. Mass. 1841) (No. 4901) (Copyright and patent law "approach...nearer than any other class of cases...to what may be called the metaphysics of the law, where the distinctions are, or at least may be, very subtle and refined, and sometimes, almost evanescent.").