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NEW YORKERS HAVE GOT IT RIGHT: A CALL FOR A UNIFORM STANDARD TO COPYRIGHT INFRINGEMENT ANALYSIS

I. INTRODUCTION

Digital technology has established a new paradigm for easy access to ideas. As a result, copyright law should be reexamined and further clarified so an infringer cannot unlawfully appropriate protected expressions of ideas without legal consequences. On the other hand, the law should be crafted to encourage proliferation of and investment in creative expression.¹

Currently, the Second and Ninth Circuits—the two major copyright courts—are sharply divided on how to approach a copyright infringement claim.² When compared to the Second Circuit’s approach, the Ninth Circuit’s copyright infringement test unduly complicates the process by not “bother[ing] to first determine [whether] the accused text was derived from the plaintiff’s [work].”³ Conversely, the Second Circuit’s test permits the trier of fact to first determine whether the accused infringer’s work derived protected elements from the plaintiff’s work, “separate from the far more tedious and complicated task of determining whether what was borrowed qualifies for protection by copyright.”⁴ Other circuits are seemingly “unaware of this fissure, as evidenced by the fact that several of them apply both tests interchangeably.”⁵ By consensus, the Ninth Circuit’s approach is “a complicated, time-consuming, multi-pronged test, containing vague and

1. See Douglas Y’Barbo, *The Origin of the Contemporary Standard for Copyright Infringement*, 6 J. Intell. Prop. L. 285 (1999) (“Literature, film, music, sculpture, architecture, and software all rely primarily upon federal copyright law for protection against unauthorized copying, which if left unrestrained, would unquestionably squelch the incentive to create or to invest in such creation.”).

2. *See id.*

3. *Id.* at 313.

4. *Id.* at 314.

5. *Id.* at 285.

redundant nomenclature. . . .”⁶

This Comment examines the critical issue of whether courts should consider adopting a uniform approach to copyright infringement, thereby safeguarding the expression of ideas and promoting the advancement of creativity. Part II presents a general overview and reviews the development of copyright law. Part III investigates case law in both the Ninth and Second Circuits, because major copyright issues have traditionally been—and will likely continue to be—debated and decided primarily in these two courts.⁷ Part IV critiques the current state of copyright infringement analysis. Finally, this Comment urges courts to adopt a uniform copyright infringement standard based upon a formulation by the Second Circuit. The standard should include a final filtration step to separate works with a narrow range of protectable elements from works with a wide range.

The new standard should clarify—in clear language and with a defined procedural structure—the approach a court should take when analyzing a copyright infringement claim. First, such an approach should require proof of ownership of a valid copyright. Second, the plaintiff should prove that the defendant actually copied protected elements of the plaintiff’s work. This should be an objective analysis proven by both access and similarities probative of copying. The purpose of this objective analysis is to distinguish between protected and unprotected elements. Third, works with a narrow range of protectable expression should be divided from works with a wide range, using an additional filtration mechanism.⁸ This separation should establish whether the test for determining subjective misappropriation is *virtual identity* or *substantial similarity*. “When the range of protectable and unauthorized expression is narrow, the appropriate standard for illicit copying is virtual identity.”⁹ On the other hand, if the range of protectable elements is wide, then the court

6. *Id.*

7. Y’Barbo, *supra* note 1.

8. For further discussion, see generally Jeannette Rene Busek, *Copyright Infringement: A Proposal for a New Standard for Substantial Similarity Based on the Degree of Possible Expressive Variation*, 45 UCLA L. REV. 1777, 1802–03 (1998) (arguing that “the degree of possible variation of expression is the driving factor in determining substantial similarity.” As such, “courts would be better off . . . articulating their decisions based on the amount of expressive variation available to a particular type of work.”). However, this Comment advocates an initial division of a claim into two categories, a narrow range of protectable expression and a broad range of protectable expression of protectable ideas. For further explication on this proposal, see the discussion in Part IV of this Comment.

9. *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1439 (9th Cir. 1994).

should apply the “ordinary reasonable observer” test to determine whether the defendant’s work is substantially similar to the protectable elements of the plaintiff’s work.¹⁰ An affirmative answer to either test would constitute improper appropriation. Lastly, the court should apply any pertinent limiting doctrines. This approach ensures that highly similar ideas (which the law does *not* protect) are quickly distinguished from highly similar *expressions of ideas* (which *are* protected) before the court must make the difficult determination of whether actual copying of protected expressions amounts to improper appropriation.

II. HISTORICAL DEVELOPMENT OF THE LAW

A. Framework of a Copyright Infringement Action

The Constitution provides that “[t]he Congress shall have Power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings. . . .”¹¹ Such writings are protected under the United States Code as “original works of authorship,”¹² which the Code defines as literary, musical, dramatic, motion pictures and other audiovisual works, sound recordings, and other particular types of intellectual creations.¹³ In contrast, copyright law does not protect any “idea, procedure, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”¹⁴

The underlying rationale for copyright protection is to protect “the general benefits derived by the public from the labors of authors.”¹⁵ Stated differently, the immediate reward of copyright protection serves as “a fair return for an ‘author’s’ creative labor. But the *ultimate aim* is, by this incentive, to stimulate artistic creativity for the general public good.”¹⁶

10. *Id.* at 1442 (describing this general copyright test).

11. U.S. CONST. art. I, § 8.

12. 17 U.S.C. § 102(a) (2000).

13. *See id.*

14. *Id.* at § 102(b).

15. 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.03[A] (Matthew Bender & Co. 2006) (quoting *New York Times v. Tasini*, 533 U.S. 483, 519 (2001) (Stevens, J., dissenting)).

16. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (emphasis added).

Thus, the Copyright Act recognizes, through its fair use doctrine, the value inherent in public access to creative endeavors for purposes such as education or criticism.¹⁷

With the long-term purpose of copyright protection in mind, copyright law should not become overprotective of creative works. Doing so would render copyright law useless and leave little in the public sphere. Moreover, an originator would likely lose incentive to create, since such a strict standard would nearly eliminate any practical way to avoid infringing on another's creative labor.

B. *Prima Facie Case of Copyright Infringement*

In *Feist Publications, Inc. v. Rural Telephone Service Co.*,¹⁸ the United States Supreme Court held that a plaintiff establishes a prima facie case of copyright infringement by showing "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original."¹⁹ Thus, copyright protection can only extend to original elements of an author's work: "[o]riginality remains the *sine qua non* of copyright. . . ."²⁰

In *Feist*, the defendant admitted to copying names and telephone numbers from the plaintiff's white pages telephone directory.²¹ Despite the defendant's admission to copying, the Court held that while factual compilations may be protected, each factual element—in this case, each name and telephone number—cannot be protected because each constitutes a fact that can be *freely discovered*.²²

Therefore, "a plaintiff [claiming copyright infringement] must first show that his work was actually copied . . . [and] then must show that the copying amounts to an improper or unlawful appropriation."²³ "[A]lthough the Second and Ninth Circuits currently apply different standards for copyright infringement, the two circuits actually applied the same test

17. See 17 U.S.C. § 107 (2000) ("[T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . . scholarship, or research, is not an infringement of copyright.").

18. *Feist Publ'ns, Inc. v. Rural Tele. Serv.*, 499 U.S. 340 (1991).

19. *Id.* at 361.

20. *Id.* at 348.

21. See *id.* at 361.

22. See *id.* at 348 ("Others may copy the underlying facts from the publication, but not the precise words used to present them.").

23. Y'Barbo, *supra* note 1, at 288 (citations omitted).

many years ago.”²⁴ How the two circuits apply the actual copying and improper appropriation requirements articulated in *Feist* will be examined below.

III. COMPARE AND CONTRAST: THE NINTH CIRCUIT APPROACH VERSUS THE SECOND CIRCUIT APPROACH

A. *The Second Circuit Approach*

The Second Circuit’s approach to copyright infringement analysis consists of three essential elements: (1) ownership of a valid copyright; (2) evidence of actual copying as proven by (i) access and (ii) probative similarity that substantiates actual copying of protectable elements; and (3) substantial similarity as determined by the ordinary observer (improper appropriation).²⁵

This framework for analyzing copyright infringement claims is based on the Second Circuit’s 1946 decision in *Arnstein v. Porter*.²⁶ The *Arnstein* test provides that “[c]opyright infringement is established when the owner of a valid copyright demonstrates unauthorized copying.”²⁷ To determine unauthorized copying with the *Arnstein* test, the trier of fact may rely on objective evidence, including dissection or expert testimony.²⁸ Next, the trier of fact must answer the key subjective question of what constitutes substantial similarity.²⁹ For example, substantial similarity was found in a contested musical composition when “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.”³⁰ If copying is established, then the issue of improper appropriation arises.³¹ In

24. *Id.* at 286.

25. *See id.* at 291. Professor Y’Barbo argues that there are essentially four elements to the Second Circuit’s copyright infringement analysis: (1) ownership of a valid copyright; (2) access; (3) “similarity that is probative of derivation”; and (4) substantial similarity under the ordinary observer test. This Comment disagrees with breaking the Second Circuit’s test into four elements since steps two and three (access and probative similarity) constitute actual copying.

26. *See Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946); *see also* Y’Barbo, *supra* note 1, at 287 n.8.

27. *Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc.* 150 F.3d 132, 137 (2d Cir. 1998) (quoting *Repp v. Webber*, 132 F.3d 882, 889 (2d Cir. 1997)).

28. *See Arnstein*, 154 F.2d at 468.

29. *See id.* at 473.

30. *Id.*

31. *See id.* at 468.

this final element, the trier of fact may not rely on objective evidence to determine whether improper appropriation of protected elements occurred in violation of copyright law.³²

1. Ownership of a Valid Copyright

The Copyright Act of 1976 gives an illustrative list of the works that may be protected by copyright law.³³ Generally, a plaintiff makes a prima facie showing of a valid copyright ownership with a copyright registration certificate.³⁴

2. Actual Copying Proven by Access Plus “Probative Similarity”³⁵

After proving ownership of a valid copyright, a plaintiff must show the defendant “*actually copied*” his or her work.³⁶ A distinguishing factor between the actual copying prong and the improper appropriation prong lies in the use of expert testimony; expert testimony may be used to prove actual copying.³⁷ In contrast, expert testimony may not be used to prove

32. *See id.*

33. *See* 17 U.S.C. § 102(a) (2000). Protected works of authorship include literary works, musical works, dramatic works, choreographic works, motion pictures and other audiovisual works, among others.

34. *See id.* § 410(c). (“In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.”).

35. *See generally* Alan Latman, “*Probative Similarity*” as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement, 90 COLUM. L. REV. 1187 (1990). The Columbia Law Review published Professor Latman’s article six years after his untimely death. Professor Latman’s professional colleagues and close friends knew of his attempts to complete his study of copyright infringement in the last year of his life and found his unfinished manuscript after his death in 1984. The article’s text was nearly complete, though without footnotes. Therefore, using their knowledge of Professor Latman’s favorite cases and other leading authorities’ works, his colleagues constructed and added the footnotes, assisted by the staff of the Columbia Law Review. There was no substantive modification to Professor Latman’s analysis (minimally supplemented with post-1984 developments). This article not only clarifies the elements that must be proven to claim copyright infringement, but also urges courts to adopt the term “probative similarity” in the copyright infringement dictionary.

36. *Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc.* 150 F.3d 132, 137 (2d Cir. 1998) (quoting *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 139–40 (2d Cir. 1992)) (emphasis added).

37. *See id.* (“[A]ctual copying may be established ‘either by direct evidence of copying or by indirect evidence. . . .’” (quoting *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 140 (2d Cir. 1992))).

“improper appropriation.”³⁸

A plaintiff can prove the actual copying requirement either by direct or circumstantial evidence whereby the trier of fact can reasonably infer copying.³⁹ In copyright infringement claims, “collaborators, coworkers and others who have in fact observed the producer of defendant’s material at work” could provide direct evidence.⁴⁰ Alternatively, “situation[s] in which defendant’s ‘author’ had earlier studied or worked with plaintiff’s material in the course of aborted negotiations” could be another source of express proof of actual copying.⁴¹

If direct evidence of copying is unavailable, a plaintiff can prove actual copying with indirect evidence by showing the defendant had access to the plaintiff’s work and by proving probative similarity between the two works.⁴² To show “access,” evidence will generally be circumstantial,⁴³ based on general knowledge,⁴⁴ or a sequence of events.⁴⁵ Essentially, “courts have been satisfied with a showing that the defendant had a ‘reasonable opportunity to view’ the original work.”⁴⁶ Even the plaintiff who provides clear and convincing evidence of access must then prove “probative similarity.”⁴⁷

A similarity is probative of copying if, “it is one that under all the circumstances justifies an inference of copying.”⁴⁸ The late Professor Alan Latman, who coined the term “probative similarity” and urged courts to adopt it,⁴⁹ emphasized “that proof of copying may have nothing to do with the substantiality of the protected material taken.”⁵⁰ For instance, it is possible that a plaintiff’s unique expression of an idea embodied in a

38. Y’Barbo, *supra* note 1, at 290.

39. *See* Latman, *supra* note 35, at 1192 (quoting *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946)).

40. *Id.* at 1194.

41. *Id.*

42. *See* *Shaw v. Lindheim*, 919 F.2d 1353, 1356 (9th Cir. 1990).

43. *See, e.g.*, *Toksvig v. Bruce Publ’g Co.*, 181 F.2d 664 (7th Cir. 1950).

44. *See, e.g.*, *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 944 F.2d 971 (2d Cir. 1991).

45. *See, e.g.*, *Moore v. Columbia Pictures Indus., Inc.*, 972 F.2d 939 (8th Cir. 1992).

46. Busek, *supra* note 8, at 1786 (citing 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.02(A) (1997) (citations omitted)).

47. *See id.* (citing *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1172 (9th Cir. 1977) (Ninth Circuit court held that clear evidence of access—that defendants had visited the plaintiff’s headquarters to discuss “engineering and design work”—justified a lower degree of similarity)).

48. Latman, *supra* note 35, at 1190.

49. *See id.* at 1187.

50. *Id.* at 1206.

sculpture of a thumbnail could be protected under copyright law.⁵¹ “In one instance of applied art involving ‘GI Joe,’ a somewhat realistic doll of a male military figure with . . . a small anatomical error was emphasized by the court to establish copying.”⁵² Like the defendant’s doll, “[t]he right thumbnail of plaintiff’s fighting figure was misplaced, i.e., it was on the side, rather than the back, of the end of the thumb.”⁵³ As Professor Latman argued, consumers did not purchase plaintiff’s “GI Joe” doll “because of its right [misplaced] thumbnail.”⁵⁴ However, the similarity between a plaintiff’s mere idea and the accused infringer’s idea of a sculpture of a thumbnail cannot be considered “substantial.”⁵⁵

Another purpose of using the term “probative similarity” is to emphasize that there may be facts other than similarity that are probative of copying.⁵⁶ A common scenario occurs when a defendant heard or saw a plaintiff’s work and essentially decided to use it as a model.⁵⁷ In *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, the court found a clear example of this scenario.⁵⁸ There, a customer gave a sample of plaintiff’s lace fabric embodying a copyrighted design to the defendant’s vice president and suggested that the “defendant produce a lace ‘which would have the look’ of plaintiff’s design.”⁵⁹ The court held that there was “clear evidence of copying.”⁶⁰

3. Ordinary Observer Standard to Determine “Substantial Similarity”

Once the court determines actual copying by access and probative similarity, a plaintiff must then prove that such copying amounted to unlawful or improper appropriation.⁶¹ In order to determine whether works

51. *See id.*

52. *Id.* at 1205 (citing *Hassenfield Bros. v. Mego Corp.*, 150 U.S.P.Q. (BNA) at 786 (S.D.N.Y. 1966)).

53. *Id.* (citing *Hassenfield Bros.*, 150 U.S.P.Q. (BNA) at 788).

54. *See* Latman, *supra* note 35, at 1206.

55. *Id.*

56. *See id.*

57. *See id.* at 1207 (citing *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 433 F.2d 409, 410 (2d Cir. 1970); *Iris Arc v. S.S. Sarna, Inc.*, 6221 F. Supp. 916, 923 (E.D.N.Y. 1985)).

58. *Thomas Wilson & Co.*, 433 F.2d at 415.

59. Latman, *supra* note 35, at 1208 (quoting *Thomas Wilson & Co.*, 433 F.2d at 410 (internal quotations omitted)).

60. *Thomas Wilson & Co.*, 433 F.2d at 415.

61. *See, e.g.,* *Mattel, Inc. v. Goldberger Doll Mfg. Co.*, 365 F.3d 133, 136 (2d Cir. 2004) (stating that “Mattel’s copyright in a doll visage with an upturned nose, bow lips, and widely spaced eyes will not prevent a competitor from making dolls with upturned noses, bow lips, and

by the plaintiff and the defendant are “substantially similar,” the Second Circuit uses the “ordinary observer” standard and asks whether “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.”⁶²

i. Learned Hand’s Abstractions Test

“In 1930, Judge Learned Hand made one of the earliest attempts at defining the meaning of substantial similarity.”⁶³ The case of *Nichols v. Universal Pictures Corp.*⁶⁴ concerned a motion picture and a play with a similar theme involving an Irish family and a Jewish family whose children married one another.⁶⁵ The court held that the copying of the underlying premise was not unlawful, and Judge Hand explained that “[u]pon any work . . . a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out.”⁶⁶ While the first pattern may be virtually exact copying, “[t]he last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title. . . .”⁶⁷ Judge Hand further explained “there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his ‘ideas,’ to which, apart from their expression, his property is never extended.”⁶⁸

The fact finder must then decide whether the defendant’s copying is an unlawful appropriation so as to establish copyright infringement.⁶⁹ In essence, Judge Hand’s abstractions test is merely “a restatement of the idea/expression dichotomy that a trier of fact must bear in mind when conducting the analysis.”⁷⁰

widely spaced eyes, even if the competitor has taken the idea from Mattel’s example, so long as the competitor has not copied Mattel’s particularized expression”).

62. *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 765 (2d Cir. 1991) (quoting *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960)).

63. See Busek, *supra* note 8, at 1788 (citing *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930)).

64. *Nichols*, 45 F.2d at 119.

65. See Busek, *supra* note 8, at 1788 (citing *Nichols*, 45 F.2d at 120).

66. *Nichols*, 45 F.2d at 121.

67. *Id.*

68. *Id.*

69. See Jarrod M. Mohler, *Toward A Better Understanding of Substantial Similarity in Copyright Infringement Cases*, 68 U. CIN. L. REV. 971, 982 (2000) (citing Aaron M. Broaddus, *Eliminating the Confusion: A Restatement of the Test for Copyright Infringement*, 5 DEPAUL-LCA J. ART & ENT. L. & POLICY 43, 56 (1994–95)).

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

Although some courts and commentators have criticized Judge Hand's test as "not [being] a test at all,"⁷¹ Judge Hand stated that it is impossible to state an exact principle defining the line between merely copying an idea (which is lawful)⁷² and when an imitator "has borrowed its 'expression.'"⁷³ Therefore, "[d]ecisions must . . . inevitably be *ad hoc*."⁷⁴

4. Summary: A Filtering Mechanism

From the outset, this filtering mechanism mandates that a plaintiff provide an actual link between his or her work and the defendant's work, and ensures that the court will only engage in further substantive analysis if "the material borrowed from the plaintiff [is] copyrightable."⁷⁵ Furthermore, it is important to note that the actual copying and the unlawful appropriation prongs are not distinct requirements; rather, actual copying "is actually subsumed within . . . 'improper appropriation.'"⁷⁶ The actual copying prong, or derivation, could be "disposed of entirely [and] one would arrive at the same result."⁷⁷

B. *The Ninth Circuit Approach*

The Ninth Circuit's current standard was recited in a 2002 decision, *Metcalf v. Bochco*.⁷⁸ In that decision, authors of a screenplay for a television show about an inner city hospital brought a copyright infringement claim against competitors.⁷⁹ The plaintiffs had submitted their idea and script for a movie to the defendants.⁸⁰ The defendants rejected the plaintiffs' idea and script but produced a television series dealing with very similar subjects.⁸¹ These similarities included an overburdened county hospital in inner city Los Angeles with mostly African-American staff members.⁸² Both works addressed issues dealing

71. *Nash*, 899 F.2d at 1540 (internal quotations omitted).

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

73. *Id.*

74. *Id.*

75. *Y'Barbo*, *supra* note 1, at 288.

76. *Id.*

77. *Id.* at 289.

78. *Metcalf v. Bochco*, 294 F.3d 1069 (9th Cir. 2002).

79. *See id.* at 1071-72.

80. *See id.* at 1071.

81. *See id.*

82. *See id.*

with poverty and urban afflictions.⁸³ Both featured very similar characters and developments in plot.⁸⁴

In order to prevail on their infringement claim, the court required the plaintiffs to prove that (1) they owned the works in question, and (2) the defendants copied them.⁸⁵ Once the plaintiffs proved valid ownership of copyright, the plaintiffs had to prove copying by showing that defendants had access to the works in question.⁸⁶ Once the plaintiffs proved access, they had to prove unlawful copying by showing that the two works were substantially similar with respect to protected elements.⁸⁷

The Ninth Circuit held that the authors only owned the portions of the screenplay they wrote. That is, they did not own those portions of the screenplay that were written by writers hired by their corporation; those portions constituted works for hire.⁸⁸ The *Metcalf* court further held that “the presence of so many generic similarities and the common patterns in which they [arose]” raised a material question of fact as to whether the two works were substantially similar.⁸⁹ Thus, summary judgment for the authors was precluded.⁹⁰

In both the Second Circuit and the Ninth Circuit, the plaintiff must prove ownership of a valid copyright.⁹¹ However, the Ninth Circuit then employs a different approach to analyze what constitutes unlawful copying.⁹² A plaintiff establishes unlawful copying by showing that (1) the questioned works are “substantially similar in their protected elements” and (2) the alleged infringer “‘had access’ to the copyrighted work.”⁹³ Note that the Ninth Circuit assesses the substantial similarity of two works under an extrinsic-intrinsic test (discussed below) *before* evaluating the “degree of access” a defendant had to the plaintiff’s work.⁹⁴ To determine whether two works are substantially similar, the court will look at the “cumulative

83. *See id.* at 1073.

84. *See Metcalf*, 294 F.3d at 1073–74.

85. *See id.* at 1072 (citing *Shaw v. Lindheim*, 919 F.2d 1353, 1356 (9th Cir. 1990)).

86. *See id.*

87. *See id.*

88. *See id.* at 1072.

89. *Id.* at 1074.

90. *Metcalf*, 294 F.3d at 1073–74 (explaining that the extrinsic test can raise a genuine issue of material fact and therefore avoid summary judgment).

91. *See Y’Barbo*, *supra* note 1, at 291–92.

92. *See id.* at 292.

93. *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1174 (9th Cir. 2003) (quoting *Metcalf*, 294 F.3d at 1072).

94. *See id.* at 1178.

weight of these similarities.”⁹⁵

In *Satava v. Lowry*,⁹⁶ the Ninth Circuit attempted to clarify its position: “it is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection.”⁹⁷ The *Satava* court held that “a combination of unprotectable elements is eligible for copyright protection *only if* those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.”⁹⁸

“To determine whether two works are substantially similar,” the Ninth Circuit uses a “two-part analysis—an extrinsic test and an intrinsic test.”⁹⁹

1. The Extrinsic Test

The “extrinsic” test objectively evaluates the “articulable similarities between the plot, themes, dialogue, mood, setting, pace, characters, and sequence of events.”¹⁰⁰ Additionally, application of the extrinsic test requires that the court “distinguish between the protectable and unprotectable material because a party claiming infringement may place ‘no reliance upon any similarity in expression resulting from unprotectable elements.’”¹⁰¹

To determine the scope of copyright protection, the Ninth Circuit emphasizes the “idea/expression dichotomy.”¹⁰² The Ninth Circuit has held that “ideas generally do not receive protection, only the *expression* of such ideas do.”¹⁰³ The idea/expression dichotomy may be harder to define “when the idea and expression are ‘merged’ or practically indistinguishable.”¹⁰⁴ Nonetheless, the Ninth Circuit has held that “‘similarities derived from the use of common ideas cannot be protected;

95. *Metcalf*, 294 F.3d at 1074.

96. *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003).

97. *Id.* at 811.

98. *Id.* (emphasis added); see also *Metcalf*, 294 F.3d at 1074; *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994); *Feist Publ’ns, Inc. v. Rural Tele. Serv.*, 499 U.S. 340, 358 (1991) (“[T]he principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection.”).

99. *Rice*, 330 F.3d at 1174 (citing *Metcalf*, 294 F.3d at 1073).

100. *Id.* (quoting *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994)).

101. *Id.* at 1174 (quoting *Apple Computer*, 35 F.3d at 1446).

102. See *Y’Barbo*, *supra* note 1, at 302–03.

103. *Rice*, 330 F.3d at 1174.

104. *Id.*

otherwise, the first to come up with an idea will corner the market.”¹⁰⁵

2. The Intrinsic Test

Next, the Ninth Circuit moves to the subjective “intrinsic” test,¹⁰⁶ whereby the “ordinary observer” reviews the “*overall* similarity of the two texts.”¹⁰⁷ Under the intrinsic test, the Ninth Circuit—similar to the Second Circuit—allows the accused party “who borrowed substantial protectable expression to exculpate himself if the casual observer would not recognize the accused text as having been derived from the plaintiff’s text.”¹⁰⁸

3. Illustrative List of Limiting Doctrines

Several limiting doctrines are recognized by the Ninth Circuit: the “merger” and related “*scenes a faire*” doctrines,¹⁰⁹ and the “independent creation” defense.¹¹⁰ Under the merger doctrine, courts have recognized that some ideas are capable of intelligible expression in only one way.¹¹¹ Thus, the expression under these circumstances is not protected because the expression is thought to be inextricably merged with the idea.¹¹² Under the *scenes a faire* doctrine, “courts will not protect a copyrighted work from infringement if the expression embodied in the work necessarily flows from a commonplace idea.”¹¹³ Independent creation is an affirmative defense in which “[a]ny evidence produced by the defendant which explains or accounts to the satisfaction of the jury for such similarity or

105. *Id.* at 1175 (quoting *Apple Computer*, 35 F.3d at 1443).

106. The Ninth Circuit has recognized that, for summary judgment purposes, “only the extrinsic test is important.” *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994).

107. Y’Barbo, *supra* note 1, at 293.

108. *Id.* at 294.

109. *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1175 (9th Cir. 2003).

110. *See Bethea v. Burnett*, No. CV04-7690, 2005 WL 1720631, at *15-16 (C.D. Cal. June 28, 2005) (holding that Mark Burnett committed no copyright violation when he “independently created” “The Apprentice”).

111. *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 765 (9th Cir. 2003).

112. *See id.*

113. *Id.*; *see also Apple Computer, Inc.*, 35 F.3d at 1444 (stating that *scenes a faire* are forms of expression which are “as a practical matter indispensable, or at least standard, in the treatment of a given [idea]”); *Rice v. Fox Broad. Co.*, 148 F. Supp. 2d 1029, 1053 (C.D. Cal. 2001) (“Though what may constitute *scenes a faire* will vary depending on the medium and the subject matter of the particular copyrighted work at issue, the question is whether that particular expression is so typical of the genre (e.g., a car chase in an action film) as to be ‘indispensable.’”).

identity, rebuts [the] presumption [of copying by the defendant].”¹¹⁴

*C. Comparison Between the Second Circuit and the Ninth Circuit’s
Copyright Infringement Standards*

The critical difference between the Second Circuit and the Ninth Circuit approaches to analyzing copyright infringement claims is “a procedural distinction, with significant consequences.”¹¹⁵

Facially, the Second Circuit’s test differs from that of the Ninth Circuit’s in two ways. First, the Second Circuit allows a plaintiff to indirectly prove unlawful copying under a “probative similarity” standard, while the Ninth Circuit blends “derivation and copying copyrightable material . . . into a single inquiry, ‘substantial similarity.’”¹¹⁶ In addition, the Second Circuit’s substantial similarity inquiry has only one component, whereas the Ninth Circuit’s substantial similarity inquiry consists of two parts—an objective and subjective test.¹¹⁷

On the surface, the two legal standards have identical requirements: “ownership, access, an analytical test . . . , and a subjective test.”¹¹⁸ Indeed, “[t]he ownership and access requirements are not discernibly different,” leaving the latter two requirements for further analysis.¹¹⁹

1. The *Krofft* Standard: Origin of the Different Approaches Taken by the
Second Circuit and the Ninth Circuit

In *Sid & Marty Krofft Television Productions, Inc. v. McDonald’s Corp.*, the Ninth Circuit created the extrinsic test and the intrinsic test in making its substantial similarity inquiry.¹²⁰ The *Krofft* court created this new approach “to restrict the scope of a plaintiff’s copyright from extending to (unprotectable) ideas.”¹²¹ The following section will explore whether the *Krofft* court met its stated objective.

114. *Granite Music Corp. v. United Artists Corp.*, 532 F.2d 718, 721 (9th Cir. 1976).

115. Y’Barbo, *supra* note 1, at 294 (stating that both standards are substantively similar while difference mostly relates to structure).

116. *Id.* at 295.

117. *See id.*

118. *Id.*

119. *Id.*

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

121. Y’Barbo, *supra* note 1, at 302.

i. Facts of the Case

In 1968, “the puppeteer team of Sid and Marty Krofft created the world of H.R. Pufnstuf for NBC for use on its Saturday morning children’s television.”¹²² In the show, there were several costumed characters and a boy named Jimmy, who lived in a fantasyland that was populated by moving trees and talking books.¹²³ Because of the show’s great success, endorsements and a line of products soon followed.¹²⁴

Two years later, an advertising agency that was trying to secure a contract with McDonald’s approached Marty Krofft.¹²⁵ The advertising agency proposed to base McDonald’s television advertisements on the H.R. Pufnstuf characters.¹²⁶ However, after a series of telephone conversations, the advertising agency untruthfully informed Marty Krofft that McDonald’s had canceled the advertising campaign.¹²⁷ In fact, the advertising agency had won the McDonald’s contract and proceeded to make the advertisements based on the H.R. Pufnstuf characters.¹²⁸ Additionally, the agency hired former Krofft employees to “design the sets and used the same voice expert to create the characters’ voices.”¹²⁹ The agency’s advertising campaign was successful, resulting in the Kroffts’ loss of many licensing arrangements to the new McDonald’s characters.¹³⁰ Based on the evidence presented, the plaintiffs won a verdict in a jury trial and the defendants appealed.¹³¹

On appeal, the Ninth Circuit affirmed the lower court’s judgment for the plaintiffs.¹³² Because the defendants admitted copying the idea of “a fantasyland filled with diverse and fanciful characters” from the plaintiff’s television show,¹³³ under the reformulated *Arnstein* test, the Ninth Circuit Court only had to decide the question of substantial similarity of expression.¹³⁴

122. Busek, *supra* note 8, at 1800.

123. *Krofft*, 562 F.2d at 1161.

124. *Id.*

125. *See id.*

126. *Id.*

127. *See id.*

128. *Id.*

129. Busek, *supra* note 8, at 1801.

130. *See Krofft*, 562 F.2d at 1162.

131. *Id.*

132. *Id.* at 1175.

133. *Id.* at 1165.

134. *See id.* n.7 (clarifying that the court “formulate[d] an extrinsic-intrinsic test for

The *Krofft* court held that the defendants unlawfully “copied the plaintiff’s own expression: characters with large heads and small bodies, talking trees, and so on.”¹³⁵ By its nature, the idea of a fantasy island can be expressed in an infinite number of ways.¹³⁶ Nonetheless, the defendants “chose to cash in on the parts of the plaintiff’s expression that had already proven successful.”¹³⁷

ii. Extrinsic-Intrinsic Test

According to the *Krofft* court, a determination made under the extrinsic test depends on specific criteria, such as “the type of artwork involved, the materials used, the subject matter, and the setting for the subject.”¹³⁸ The intrinsic test attempts to establish whether two works are substantially similar in their expression of ideas.¹³⁹ In contrast to the extrinsic test, the intrinsic test relies on the ordinary observer to measure any similarities between the two works based on informal reviews.¹⁴⁰

As Professor Douglas Y’Barbo argued, “[i]t is not clear why one needs an entire test (the extrinsic test) merely to determine similarity with respect to (unprotectable) ideas.”¹⁴¹ Further, since ideas are unprotected by definition, the fact “that an accused infringer has copied *ideas* from the plaintiff’s work is irrelevant for purposes of determining infringement.”¹⁴²

The *Krofft* court began its analysis stating that infringement would be established upon “proof of ownership, access, and substantial similarity.”¹⁴³ This is a misunderstanding of the test formulated by the *Arnstein* court.¹⁴⁴ In *Arnstein*, the court held that a plaintiff establishes copyright infringement by proving the following: (1) ownership of a valid copyright; (2) actual copying from the plaintiff’s work by the accused party, which must be shown by access and probative similarity; and (3) “unlawful appropriation.”¹⁴⁵ In contrast to *Krofft*, the *Arnstein* test used the term

infringement based on the idea-expression dichotomy”).

135. Busek, *supra* note 8, at 1802 (citing *Krofft*, 562 F.2d at 1161).

136. *Id.*

137. *Id.*

138. *Krofft*, 562 F.2d at 1164.

139. *See id.*

140. *See id.*

141. Y’Barbo, *supra* note 1, at 301.

142. *Id.* at 301–02 (emphasis added).

143. *Krofft*, 562 F.2d at 1162.

144. *See* Y’Barbo, *supra* note 1, at 303.

145. *See id.*

“unlawful appropriation” (or improper appropriation) instead of the term “substantial similarity.”¹⁴⁶ Also, the *Arnstein* test “never included similarity with respect to unprotectable portions of the work at issue.”¹⁴⁷

Furthermore, the *Krofft* court’s concern about overprotecting merely ideas has been addressed in several subsequent Second Circuit Court decisions that follow the *Arnstein* test.¹⁴⁸ For instance, in 1998, the Second Circuit clarified that “‘substantial similarity’ requires that the copying [be] quantitatively and qualitatively sufficient to support the legal conclusion that infringement (actionable copying) has occurred. The qualitative component concerns the copying of expression, rather than ideas.”¹⁴⁹ Once actual copying has been established, a plaintiff claiming infringement must prove such copying was unlawful because the alleged infringer’s work shows “substantial similarity” to the plaintiff’s protected expressions of ideas.¹⁵⁰

2. Analytical Test: Second Circuit’s Probative Similarity and Ninth Circuit’s Extrinsic Test

The Second Circuit’s “probative similarity” test, along with the access requirement, seeks to determine whether the accused infringer’s text is derived from the plaintiff’s work.¹⁵¹ On the other hand, the Ninth Circuit’s objective analysis is part of the “substantial similarity” test.¹⁵² The Ninth Circuit attempts to determine whether “each element that appears in both texts” is copyrightable.¹⁵³ In contrast, the Second Circuit’s “probative similarity” test only focuses on “identifying whether the accused text is derived from the plaintiff’s . . . [making] copyrightability . . . virtually irrelevant.”¹⁵⁴

146. *See id.* at 304.

147. *Id.*

148. *See id.* at 305.

149. *Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc.*, 150 F.3d 132, 138 (2d Cir. 1998) (emphasis omitted) (quoting *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70, 75 (2d Cir. 1997)).

150. *Id.* at 137 (citing *Repp v. Webber*, 132 F.3d 882, 889 (2d Cir. 1997)).

151. *See Y’Barbo*, *supra* note 1, at 296.

152. *See id.*

153. *Id.*

154. *Id.*

3. Ordinary Observer Test: The Second Circuit's Substantial Similarity Test Versus the Ninth Circuit's Intrinsic Test

In the Second Circuit, the ordinary observer differentiates copying from unlawful derivation (improper appropriation).¹⁵⁵ This subjective inquiry does not occur unless and until the protectable elements have been separated from unprotectable elements.¹⁵⁶ Such dissemination ensures that only protectable elements similar to both works are then scrutinized by the trier of fact to “determine whether the two are—according to the casual observer—‘substantially similar.’”¹⁵⁷ In the Ninth Circuit's subjective inquiry, the intrinsic test does not analyze *both* protectable as well as unprotectable material.¹⁵⁸

IV. ANALYSIS AND CRITIQUE: A CALL FOR A UNIFORM STANDARD

A. *Why the Second Circuit's Legal Standard Is Better*

In an age of frivolous lawsuits and overburdened judicial systems, the Second Circuit's approach is more efficient at resolving many copyright infringement disputes.¹⁵⁹ The Second Circuit has created a procedural shortcut to its analysis by “dividing the ‘unlawful copying’ inquiry into derivation [access plus probative similarity] and improper appropriation”¹⁶⁰ This approach reduces the error rate.¹⁶¹

In essence, the Second Circuit's copyright infringement standard is structured to avoid, where possible, the difficult determination of what the law protects.¹⁶² Before the trier of fact determines whether actual copying of protected elements was improper, the parties “know that at least one

155. *See id.*

156. *See id.*

157. Y'Barbo, *supra* note 1, at 296.

158. *See id.* at 296–97.

159. *See id.* at 314 (claiming that the Second Circuit's approach “is also procedurally superior since it allows the court to truncate the dispute if the plaintiff is unable to prove derivation, and thus avoids becoming mired in the [unlawful appropriation] part of the test”).

160. *Id.* at 298.

161. *Id.*

162. *See* Douglas Y'Barbo, *The Heart of the Matter: The Property Right Conferred by Copyright*, 49 MERCER L. REV. 643, 643–44 (1998) (“[C]opyright’ is not an enforceable property right *In relation* to a particular work of authorship or the expression embodied in it . . . [Rather,] it is a far more qualified property right *In relation* to a legally structured market position.”).

element in the plaintiff's text is copyrightable (a presumption triggered by proffering the copyright registration), and that the accused text was derived from the plaintiff's text."¹⁶³ Only after the plaintiff has identified his or her work as the source of the actual copying does the Second Circuit's test then focus on whether a particular element is more than just an idea, and instead a protectable expression.¹⁶⁴ However, this approach tends to be a very time-consuming and highly subjective (and therefore error-prone) inquiry.¹⁶⁵

By contrast, the primary focus of the Ninth Circuit's copyright infringement analysis is determining whether the copying of all elements in its "totality of the similarities . . . goes beyond the necessities of the . . . theme and belies any claim of . . . accident."¹⁶⁶ The Ninth Circuit's "total concept and feel" test¹⁶⁷ is a subjective standard that determines "how the intended audience would view the [two] works. . . ."¹⁶⁸ This standard is based on "the combination of many different elements which may command copyright protection because of [the work's] particular subjective quality. . . ."¹⁶⁹ Moreover, this test uses the subjective quality aimed at the intended audience; for example, the children who may watch a Saturday morning children's television show.¹⁷⁰

While the total concept and feel test has been applauded by some for explicitly recognizing "from whose *perspective* such an inquiry should be made,"¹⁷¹ many have criticized the test for undermining the crucial distinction between merely ideas and the protected expression of ideas.¹⁷² According to Nimmer's treatise on copyright, "for courts to advert to a

163. Y'Barbo, *supra* note 1, at 299.

164. *Id.* at 300 (citing *Reyher v. Children's Television Workshop*, 533 F.2d 87, 91 (2d Cir. 1976)).

165. *Id.*

166. *See Shaw v. Lindheim*, 919 F.2d 1353, 1363 (9th Cir. 1990).

167. *See Busek, supra* note 8, at 1790 (stating that the Ninth Circuit first introduced the "total concept and feel" test in its 1970 decision in *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970)).

168. *See id.*

169. *See id.* at 1790–91 (quoting *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1169 (9th Cir. 1977)).

170. *See id.* (infringement action of children's television show).

171. Michael L. Sharb, *Getting a "Total Concept and Feel" of Copyright Infringement*, 64 U. COLO. L. REV. 903, 915 (1993) (arguing that the "total concept and feel" test should be uniformly adopted to determine substantial similarity).

172. *See, e.g., Elliot M. Abramson, How Much Copying Under Copyright? Contradictions, Paradoxes, Inconsistencies*, 61 TEMPLE L. REV. 133, 148 (1988) ("Constructs such as 'total concept and feel' . . . seem less germane when precise verbal description of similarity is possible.").

work's 'total concept' as the essence of its protectable character seems ill-advised in the extreme."¹⁷³

B. *Why the Second Circuit's Infringement Standard Is Not Enough*

Rather than introducing a new test, the solution lies in clarifying the Second Circuit's approach to copyright infringement. Specifically, this proposed solution adds a new filtering part to the analysis: separating those works with a narrow range of protectable expression from other works with a wider range before the subjective test is performed under the ordinary observer test.

Under this proposal, a plaintiff alleging that a defendant infringed the plaintiff's copyrighted work must prove several elements. First, the plaintiff must prove ownership of a valid copyright. Second, the court must conduct an objective analysis to distinguish between merely ideas and protected expressions of ideas. This objective analysis seeks to prove actual copying, which must be shown by access and similarity probative of actual copying.

Next, this Comment proposes that courts should determine the range of protectable expression in order to separate those works whose range is narrow from those that are not. This separation is a procedural shortcut and is designed to assist the trier of fact in its subjective analysis to determine whether actual copying has crossed the line into unlawful or improper appropriation. Hence, if the range of protectable expression is narrow, then the court should require "virtual identity"¹⁷⁴ in order to prove misappropriation. To illustrate what is meant by virtual identity, an examination of the facts of the *Satava* case may be helpful. An artist alleging that a competitor has infringed on the artist's "life-like glass-in-glass sculptures of jellyfish"¹⁷⁵ should recognize that such a work "possesses a thin copyright that protects against only virtually identical copying."¹⁷⁶ The *Satava* court explained that "[n]ature gives us ideas of animals in their natural surroundings . . ."¹⁷⁷ The *Satava* court held that since "[t]hese ideas [are] first expressed by nature . . . no artist may use

173. 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A][1][c], at 13-46 (1997).

174. See *Satava v. Lowry*, 323 F.3d 805, 812 (9th Cir. 2003) (quoting *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1439 (9th Cir. 1994)).

175. *Id.* at 805.

176. *Id.* at 812 (citing *Ets-Hokin v. Sky Spirits, Inc.*, 323 F.3d 763, 766 (9th Cir. 2003)).

177. *Id.* at 813.

copyright law to prevent others from depicting them.”¹⁷⁸ Hence, virtual identity, in such an instance, should mean that “[a]n artist may vary the pose, attitude, gesture, muscle structure, facial expression, coat, or texture of [an] animal . . . [or] the background, lighting, or perspective.”¹⁷⁹

On the other hand, if the range of protectable expression is wide, then the court should allow the trier of fact to conduct the ordinary observer test to decide whether the defendant’s work is substantially similar to the protectable elements of the plaintiff’s work.

1. Narrow Range of Protectable Elements: “Virtual Identity” Test

In one instance, Robert Rice created a home video (“The Mystery Magician”) that revealed how to perform several well-known magic tricks and illusions.¹⁸⁰ In 1986, Rice produced and registered the script for “The Mystery Magician,” then signed an agreement with International Creative Management (“ICM”) to commercially exploit his video.¹⁸¹ ICM then negotiated a ten-year exclusive video distribution contract with CBS/Fox Video Westinghouse on Rice’s behalf.¹⁸² At the end of the ten-year deal, Rice entered into agreements with other entities and continued to distribute “The Mystery Magician.”¹⁸³ Through the various distribution contracts, Rice sold approximately 17,000 copies of the video worldwide between 1986 and 1999.¹⁸⁴

At some point between 1995 and 1997, Fox Broadcasting Company (“Fox”) began to develop a series of television specials (“Specials”) about magic.¹⁸⁵ Similar to “The Mystery Magician,” the idea behind Fox’s programming was to reveal the secrets of famous magic tricks.¹⁸⁶ Between November 1997 and October 1998, Fox aired the Specials four times and encouraged viewers to purchase copies of the show using a toll-free number displayed on the television screen.¹⁸⁷

178. *Id.*

179. *Id.*

180. *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1173 (9th Cir. 2003).

181. *Id.*

182. *Id.*

183. *Id.*

184. *Id.*

185. *Id.*

186. *Rice*, 330 F.3d at 1173.

187. *Id.*

Rice thought that the individuals and entities associated with the production of the Specials stole his expressions revealing the tricks behind well-known illusions, prompting him to bring (among other claims) a copyright infringement claim against Fox.¹⁸⁸

In finding for the defendants, the court stated that “there are only a *discrete* number of ways to express a magician revealing the secrets behind magic tricks and illusions while disguising his identity.”¹⁸⁹ “[U]nder the limiting doctrines of merger and *scenes a faire*, the mere fact that both [video productions] feature a masked magician revealing magic tricks cannot constitute copyright infringement.”¹⁹⁰ The court held that, although there may arguably be similarities between the magicians’ characters, dialogues and settings, any similarity is too generic and thus constitutes *scenes a faire*.¹⁹¹ These “generic and inconsequential” similarities merged with the concept of showing secrets behind famous magic tricks.¹⁹²

In essence, by rejecting all of the plaintiff’s arguments, the court seemed to require near (or virtual) identity. Among the plaintiff’s arguments was that the defendant’s work was substantially similar to his work in plot and sequence of events.¹⁹³ “Because disclosure of the secrets behind magic tricks does not receive copyright protection, and the perform and reveal sequence is also unprotectable,” the court found “no substantial similarity in plot and sequence of events between the two works.”¹⁹⁴

Compare the number of ways one can create an advertising photograph of a blue vodka bottle.¹⁹⁵ “In 1993, photographer Joshua Ets-Hokin took a series of photographs of Skyy’s iconic blue vodka bottle for

188. *See id.* at 1174.

189. *Id.* at 1176 (emphasis added).

190. *Id.*

191. *See id.* at 1176–77.

192. *Rice*, 330 F.3d, at 1177.

193. *Id.*

194. *Id.* Note that the Ninth Circuit court in *Rice* mentioned that an objective analysis revealed several notable differences. For example, the actual magic tricks and sequence of revealing them in the two works were different; of the four installments of the defendant’s television broadcasts (Specials), only the first installment shares any tricks in common with the plaintiff’s work. Further examination shows that, of the eleven magic tricks shown in the defendant’s first installment, only five tricks are in common with the plaintiff’s work (and even these five common tricks are performed in a completely different sequence). Furthermore, the *Rice* court noted that there are undisputable differences in the value of the production. The Specials installments contain more special effects, consist of a larger cast, and are generally more interesting. *Id.* at 1177 n.3.

195. *See Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 764 (9th Cir. 2003).

use in a marketing campaign.”¹⁹⁶ Subsequently, Skyy “hired two other photographers to photograph the bottle and used these photographs in advertising and other marketing materials.”¹⁹⁷ Three years later, Ets-Hokin filed a copyright infringement action against Skyy claiming infringement of his copyrights in the photographs.¹⁹⁸

The *Ets-Hokin* court concluded that “[t]hough the Ets-Hokin and Skyy photographs are indeed similar, their similarity is inevitable, given the shared concept, or idea, of photographing the Skyy bottle.”¹⁹⁹ Therefore, the appellate court “affirm[ed] the district court’s summary judgment because the [defendant’s] allegedly infringing photographs [were] not ‘virtually identical’”²⁰⁰ However, the *Ets-Hokin* court stated that the higher “virtual identity” standard is only triggered when the defendant asserts the affirmative defenses of merger and *scenes a faire*.²⁰¹

Copyright law has long recognized the concept of virtual identity, also known as “substantial similarity.”²⁰² In *Nichols v. Universal Pictures Corp.*,²⁰³ Judge Learned Hand remarked that “the less developed the characters, the less they can be copyrighted.”²⁰⁴ The *Ets-Hokin* court was quick to emphasize that the narrow range of protectable expression is restrained by the idea of the photograph (*e.g.*, the distinct blue Skyy vodka bottle).²⁰⁵

A court should require a virtual identity standard if the range of protectable elements is narrow regardless of whether or not the defendant asserts the limiting doctrines of merger or *scenes a faire*.²⁰⁶ The rationale behind this approach is two-fold: (1) to assist the trier of fact in the highly subjective analysis of improper appropriation; and (2) to make efficient use of all involved parties’ time and efforts by making this procedural distinction.

196. *Id.* at 765.

197. *Id.*

198. *Id.*

199. *Id.* at 766.

200. *Id.* at 764.

201. *See Ets-Hokin*, 323 F.3d at 764–65.

202. *See id.* at 764; Busek, *supra* note 8, at 1787.

203. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930).

204. *Id.* at 121.

205. *See Ets-Hokin*, 323 F.3d at 766.

206. *See Apple Computer Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1439 (9th Cir. 1994).

2. Wide Range of Protectable Elements: “Substantial Similarity” Test

The *Krofft* court noted that the ways in which the idea of a fantasy island can be expressed are virtually limitless.²⁰⁷ Nonetheless, the defendants “chose to cash in on the parts of the plaintiff’s expression that had already proven successful.”²⁰⁸ Using the “total concept and feel test,”²⁰⁹ the *Krofft* court highlighted the point that although a large number of expressions were available to them, the defendants unlawfully chose to copy important portions of plaintiff’s fantasy island idea.²¹⁰

The 1990 case of *Shaw v. Lindheim*²¹¹ exemplifies another work with a large number of possible variations in expression.²¹² Lou Shaw, a famous television writer and producer, created a television pilot script called “The Equalizer.”²¹³ Shaw entered into an option contract with the defendant, Richard Lindheim, an executive at the National Broadcasting Company (“NBC”), to produce the series.²¹⁴ After Lindheim finished reading Shaw’s script, NBC chose not to produce the pilot, with “all rights in the script revert[ing] back to Shaw.”²¹⁵ Lindheim later moved from NBC to Universal Television, where he developed a script also entitled “The Equalizer.”²¹⁶ The pilot was broadcast on CBS, which to air “The Equalizer” series.²¹⁷ In response, Shaw filed a claim against Lindheim for copyright infringement.²¹⁸

The Ninth Circuit in *Shaw* held that a reasonable trier of fact supported finding sufficient similarity between the two scripts to deny the defendant’s motion for summary judgment.²¹⁹ Further, as in the *Krofft* case, the defendant had available to him a wide range of available expressions he could have used.²²⁰ However, Lindheim used a similar title,

207. See Busek, *supra* note 8, at 1801–02.

208. *Id.* at 1802.

209. *Id.* at 1802 n.128.

210. See *id.* at 1802.

211. *Shaw v. Lindheim*, 919 F.2d 1353, 1353 (9th Cir. 1990).

212. Busek, *supra* note 8, at 1798.

213. See *Shaw*, 919 F.2d at 1355.

214. *Id.*

215. *Id.*

216. *Id.*

217. *Id.*

218. *Id.*

219. See *Shaw*, 919 F.2d at 1363–64.

220. See *id.* at 1357–58.

plot, theme, characters, and sequence of events.²²¹ Therefore, the *Shaw* court held that Shaw had presented sufficient evidence to meet “the extrinsic test for literary works and thus ha[d] presented a triable issue of fact regarding substantial similarity of protected expression.”²²²

Where the work in question has a wide range of protectable expression, the court should require the lesser standard of substantial similarity.²²³ If the objective analysis (actual copying proven by access and probative similarity) has been correctly performed, the subjective analysis under the substantial similarity standard makes sense given the “great expressive freedom.”²²⁴

C. Constitutional Call for Protecting Expressions, Not Ideas

The proposed solution is not meant to “short-change the legitimate need of creative artists to protect their original works.”²²⁵ Indeed, one of the main purposes of copyright law is to “enrich[] our culture by giving artists a financial incentive to create.”²²⁶ Equally important is the competing principle that copyright law should not “cheat the public domain” such that “other artists [can] make use of ideas that properly belong to us all.”²²⁷

V. CONCLUSION

How should courts treat copyright cases with these competing interests in mind? This Comment has been an attempt to answer this question by advocating simplicity and efficiency. The Second Circuit’s approach to analyzing copyright infringement claims is preferable because it offers manageable and procedurally useful tools. Substantively, the Second Circuit’s approach “allows the fact finder to stop and assess [actual copying of protectable elements] separate from the far more tedious and complicated task of determining whether what was borrowed qualifies for protection by copyright.”²²⁸ Procedurally, this approach permits the court to shorten the analysis where the plaintiff fails to prove that the accused

221. *See id.* at 1362–63.

222. *Id.* at 1363.

223. *See Busek, supra* note 8, at 1799–1800.

224. *See id.* at 1800.

225. *Satava v. Lowry*, 323 F.3d 805, 813 (9th Cir. 2003).

226. *Id.*

227. *Id.*

228. *Y’Barbo, supra* note 1, at 314.

infringer actually copied *protectable* elements of the plaintiff's work.²²⁹

The additional filtration step proposed in this Comment—which serves to separate works with a narrow range of protectable expression from works whose range is wide—is designed to assist the trier of fact in making its subjective determination of whether the actual copying of protected elements constitutes unlawful appropriation. Ninth Circuit cases such as *Satava v. Lowry* expressly recognize this concept.²³⁰ More courts should make use of this underlying rationale in “vigorously policing the line between idea and expression. . . .”²³¹

*Claudia Hong**

229. *See id.*

230. *See Satava*, 323 F.3d at 813.

231. *Id.*

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