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## Substantial Similarity: *Kohus* Got it Right

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# SUBSTANTIAL SIMILARITY: KOHUS GOT IT RIGHT

*Gabriel Godoy-Dalmau\**

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## INTRODUCTION

Good artists copy; great artists steal.<sup>1</sup>

Copying is the basis for new expression.<sup>2</sup> In order to create original expression, authors enter the copy-expression cycle.<sup>3</sup> First, an author ex-

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1. *Triumph of the Nerds: The Television Program Transcripts: Part III*, PBS, <http://www.pbs.org/nerds/part3.html> (last visited Oct. 9, 2015) (Steve Jobs stating “I mean Picasso had a saying he said good artists copy great artists steal.”).

2. See Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 966-67 (1990) (“[T]he very act of authorship in any medium is more akin to translation and recombination than it is to creating Aphrodite from the foam of the sea . . . This is not parasitism: it is the essence of authorship.”).

3. See Reynaldo Sanchez, *Unfair? The Unique Status of Sound Recordings Under U.S. Copyright Law and its Impact on the Progress of Sample-Based Music*, 12 J. MUSIC &

periences the expression of another author.<sup>4</sup> Second, the author—either intentionally or coincidentally—reproduces that expression.<sup>5</sup> Third, the author transforms that reproduction into a derivative product.<sup>6</sup> Finally, the author expresses themselves based on that derivative product.<sup>7</sup> This last step of expression is what consumers identify as a new work.

But this practice of creation raises questions that run to the heart of copyright law. How much copying is too much copying? Is this just a quantitative inquiry or is it also qualitative? Is this a subjective or objective standard? From whose perspective do we ask such questions? Do we only consider expression or do we also consider ideas? Does the order we ask these questions matter? Are these questions for the judge or for the jury to decide?

Since the inception of federal copyright law, courts have developed the doctrine of substantial similarity to address these questions. The substantial similarity inquiry asks whether the works at issue are, as the name implies, substantially similar—whether the defendant appropriated a material amount of the plaintiff’s original expression.<sup>8</sup> However, the exact threshold between a substantial and an insubstantial similarity is difficult, if not impossible, to express.<sup>9</sup> This threshold becomes even more difficult to define when the alleged infringement involves abstract, non-literal similarities as compared to literal similarities.<sup>10</sup>

Scholars have identified three discrete tests for substantial similarity, each with jurisdiction-specific exceptions.<sup>11</sup> Some jurisdictions employ more than one of these tests.<sup>12</sup> Scholars argue that the “plethora of [sub-

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ENT. INDUSTRY EDUCATORS ASS’N 13, 24-26 (2012) (describing cycle of copying that culminates in original expression).

4. *See id.*

5. *See id.*

6. *See id.*

7. *See id.*

8. *See Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

9. *See Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (“Nobody has ever been able to fix that boundary, and nobody ever can.”).

10. Take the example of a defendant-songwriter that copies aspects of a plaintiff’s pre-existing song. Whether the defendant copied “too much” is an easy question to answer if the defendant copied all of the plaintiff’s song’s melody and lyrics. This question is at least somewhat more difficult to answer if the defendant only copied the hook of the plaintiff’s song. The defendant would have literally copied aspects of a work: the work’s actual melody, lyric, or text. Whether the defendant copied “too much” is the most difficult to answer if the defendant only copied the song’s feel. The defendant would have non-literally copied aspects of a work: the work’s general structure, theme, plot, characters, and groove.

11. *See, e.g.*, Katherine Lippman, *The Beginning of the End: Preliminary Results of an Empirical Study of Copyright Substantial Similarity Opinions in the U.S. Circuit Courts*, 2013 MICH. ST. L. REV. 513, 525 (2013) (categorizing the tests into three groups: the ordinary observer test, the extrinsic/intrinsic test, and the abstraction-filtration-comparison test).

12. The Second Circuit, for example, applies one test, the ordinary observer test, to the majority of copyrighted works. *See Arnstein*, 154 F.2d at 468-69. However, the Second Circuit also applies another test, the abstraction-filtration-comparison test, in the context of

stantial similarity] tests and the lack of clear guidelines has led to confusion in the courts”<sup>13</sup> and that, given the federal nature and broad scope of U.S. copyright law, a uniform test is needed.<sup>14</sup>

Consistency and clarity is a goal of any legal system.<sup>15</sup> People and businesses cannot conform their behaviors to laws that are unpredictable. To the extent that copyright law attempts to regulate behavior, it needs to reflect some degree of predictability. In this respect, U.S. copyright law is frustrating. Although the Copyright Act is comprehensive in scope, it is silent on the basic elements of copyright infringement. The basic question of “how much copying is too much” is no exception—the Copyright Act offers no real substantive guidance on the point. This ambiguity is made worse, scholars argue, by the substantial similarity circuit split.<sup>16</sup>

There is, however, a difference between an unnecessarily unpredictable rule that elicits conflicting behavior and a necessarily open-ended standard that refines behavior. The question “how much copying is too much” is open-ended. This is not a flaw in the substantial similarity inquiry. The substantial similarity inquiry’s open-ended nature<sup>17</sup> allows for flexibility in evolving social norms; it injects community morals into a copyright infringement suit<sup>18</sup> Further, beyond theoretical arguments, empiri-

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computer programs. See *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706 (2d Cir. 1992).

13. Jaime Walsh, *No Justice for Johnson? A Proposal for Determining Substantial Similarity in Pop Music*, 16 DEPAUL-LCA J. ART & ENT. L. 261, 306 (2006); see also Alan Korn, *Issues Facing Legal Practitioners in Measuring Substantiality of Contemporary Musical Expression*, 6 J. MARSHALL REV. INTELL. PROP. L. 489, 494-98 (2007) (discussing the “continuing split between the circuit courts regarding which legal standard to use when measuring the substantiality of innovative or challenging artistic works”); Lippman, *supra* note 11, at 515 (“[D]ifficulty results from the lack of a single substantial similarity test employed throughout the circuits”); Nicole K. Roodhuyzen, *Do We Even Need a Test? A Reevaluation of Assessing Substantial Similarity in a Copyright Infringement Case*, 15 J.L. & POL’Y 1375, 1385 (2008) (“Currently, there is a split in the circuit courts regarding which test is proper for assessing whether protectible elements in a work are substantially similar in a copyright infringement claim.”); but see Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 J. COPYRIGHT SOC’Y U.S.A. 719, 740 (2010) (“[T]he fact that almost every circuit has adopted some version of the Arnstein-Krofft test means that it would be difficult to persuade courts to do exactly the opposite. While the Supreme Court presumably could do so, the absence of a circuit split makes it unlikely the Court will take the issue.”) [collectively, hereinafter, *Substantial Similarity Circuit Split Analysis Materials*].

14. See *Substantial Similarity Circuit Split Analysis Materials*, *supra* note 13.

15. See David S. Welkowitz, *The Virtues and Vices of Clarity in Trademark Law*, 81 TENN. L. REV. 145, 184 (2013) (arguing for the importance of predictability in trademark law).

16. See *Substantial Similarity Circuit Split Analysis Materials*, *supra* note 13.

17. See *Nichols*, 45 F.2d at 121 (noting that nobody has been able to fix the boundary between a taking of expression and a taking of idea, and “nobody ever can”).

18. See Jason Solomon & Paula Hannaford-Agor, *Introduction the Civil Jury As A Political Institution*, 55 WM. & MARY L. REV. 715, 723, 727 (2014) (describing Jeffrey Abramson’s argument for juries, specifically that when “the [civil] jury fairly reflects the diversity of the community . . . [the jury can] fulfill both an adjudicative and a political role-adjudicative insofar as the collective decision of the jury in fact resolves the case, and political insofar as

cal data suggests that the different tests for substantial similarity do not even lead to different outcomes.<sup>19</sup>

This Note is organized as follows. Part I discusses the historical development of the substantial similarity inquiry and its role in a Plaintiff's prima facie case of copyright infringement. Part II evaluates more recent developments in the substantial similarity inquiry. Part III argues that the various standards that lower courts have developed are themselves substantially similar to each other. This analysis is in line with the Sixth Circuit's decision in *Kohus*.<sup>20</sup> Although largely ignored by the scholarly community, the Sixth Circuit's decision in *Kohus* got it right.

## I. RISE OF THE SUBSTANTIAL SIMILARITY INQUIRY

This part of the Note follows the development of the substantial similarity inquiry in the United States. The historical progress of the substantial similarity inquiry highlights the evolving nature of copyright law relative to developments in society and, in specific, technology. With the advent of new consumer technologies like radio, television, movies, sound recordings, and, ultimately, computers, courts faced novel issues that tested the limits of what exactly "substantially similar" meant.<sup>21</sup> One aspect of the substantial similar inquiry, however, remained constant: the primary goal of filtering out unoriginal, unprotected material.<sup>22</sup>

### A. Historical Development

This section of the Note provides an overview of how the substantial similarity inquiry developed. Although the substantial similarity inquiry

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the jurors' deliberations across demographic and attitudinal boundaries to reach a common consensus on a just outcome is itself political," and Heather Gerken and Valerie Hans' argument for juries as "performing an appropriate and useful function in injecting community values"); see also Hans Zeisel, *The Debate over the Civil Jury in Historical Perspective*, 1990 U. CHI. LEGAL F. 25 (1990) ("[T]he primary contribution of the jury is to inject into the decision process the community's sense of justice. We found that in some 20 percent of civil jury trials, judge and jury come to a different decision on liability; in the majority of these cases, the jury reached a different decision precisely because its own 'sense of justice' differed from that of the judge."); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."); THE FEDERALIST NO. 83 (Alexander Hamilton) (noting supporters of the convention viewed trial by jury as a "valuable safeguard to liberty").

19. See Lippman, *supra* note 11, at 545 ("Remarkably, however, when collapsing the six substantial similarity tests into the three main tests—the ordinary observer test, the extrinsic/intrinsic test, and the abstraction-filtration-comparison test—their substantial similarity win rates become closely aligned.").

20. See *Kohus v. Mariol*, 328 F.3d 848, 853-57 (6th Cir. 2003).

21. See, e.g., *Nichols*, 45 F.2d at 120 (movie); *Computer Assocs. Int'l, Inc.*, 982 F.2d at 706 (computer).

22. See, e.g., *Harper & Row v. Nation Enterprise*, 471 U.S. 539, 581 n.2 (1985) (Brennan, J., dissenting) (noting that substantial similarity, along with Section 102(b) and fair use, serves to separate protected from unprotected material).

progressed slowly under the initial 1790 Copyright Act,<sup>23</sup> courts ultimately developed aspects of the inquiry—like the materiality requirement<sup>24</sup>—that are still fundamental today.

The first U.S. copyright case to expressly address any sort of substantiality inquiry was *Blunt v Patten*.<sup>25</sup> While comparing the two works at issue, the Court took into account the process by which the defendant copied aspects of the plaintiff's copyrighted chart.<sup>26</sup> The Court held that the amount of the defendant's appropriation had risen to "substantial" copying.<sup>27</sup>

Courts continued to recognize "that the whole of a work" need not be copied to constitute copyright infringement.<sup>28</sup> The quantitative measure of a copy was not the only factor to consider. Courts recognized that qualitative measures, such as the "value of the materials taken," also played a role in the substantiality inquiry.<sup>29</sup> In 1878, the Supreme Court solidified these perspectives in *Perris v. Hexamer*.<sup>30</sup> The Court held that the substantiality inquiry advances a materiality requirement.<sup>31</sup> If the amount copied was quantitatively and qualitatively immaterial—and thus *de minimis*<sup>32</sup>—the defendant would not have infringed the plaintiff's copyright.<sup>33</sup>

For more than 100 years after the first copyright act, however, the substantial similarity inquiry appeared to be more so a "you know it when you see it" form of analysis than a principled one. It was not until the 20th century that courts began to articulate workable tests. It was during this period that Congress altered the procedural rules of litigation.<sup>34</sup> These

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23. The 1790 Copyright Act, for example, only protected against verbatim reproduction. 17 U.S.C. § 1 (1790) (copyright owners "shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books"). The 1790 Copyright Act did not recognize an exclusive right of derivation. *See id.* Although, as this section points out, some sort of substantial similarity inquiry was not necessarily irrelevant under the 1790 Copyright Act, the statute inherently restricted much of the early substantial similarity inquiry's development.

24. *See Perris v. Hexamer*, 99 U.S. 674, 675-76 (1878).

25. 3 F. Cas. 762, 762 (C.C.S.D.N.Y. 1828).

26. *Id.*

27. *Id.*

28. *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841).

29. *Id.*

30. *See Perris*, 99 U.S. at 675-76 (1878) (addressing copyright infringement of plaintiff's New York City maps); *see also Folsom*, 9 F. Cas. at 348.

31. *Perris*, 99 U.S. at 675-76.

32. *See Webb v. Powers*, 29 F. Cas. 511, 520 (C.C.D. Mass. 1847)

33. *See Perris*, 99 U.S. at 675-76 ("A copyright gives the author . . . the exclusive right of multiplying copies of what he has written or printed. If [sic] follows that to infringe this right a substantial copy of the whole or of a material part must be produced.")

34. 17 U.S.C. § 27 (1909) ("the proceedings for an injunction, damages, and profits, and those for the seizure of infringing copies, plates, molds, matrices, and so forth, aforementioned, may be united in one action"); *see also* WILLIAM F. PATRY, 3 PATRY ON COPYRIGHT § 9:114 (Westlaw 2016) ("Procedural rules also had an important impact. Although the 1909

procedural amendments allowed for increased dispositive pre-trial motions, such as summary judgment.<sup>35</sup> Further, by this point, Congress had given copyright owners a right that was not recognized under the original 1790 Copyright Act: the right to create adaptations.<sup>36</sup> Courts during this period attempted to use the substantial similarity inquiry together with summary judgment as a mechanism to dismiss disputes before trials.<sup>37</sup>

Under the 1909 Copyright Act, courts expressed the view that substantial similarity is a question asked from a lay spectator.<sup>38</sup> The court in *Dymow* described the threshold for when copying passes from lawful to unlawful as when “ordinary observation would cause [the copy] to be recognized as having been taken from the work of another.”<sup>39</sup> In support of its test, the court reasoned that copyrights are “made for plain people.”<sup>40</sup> Twenty years later, the Second Circuit in *Arnstein* further clarified this point with the ordinary observer test.<sup>41</sup> The court evaluated the issue of “unlawful appropriation.”<sup>42</sup> Under *Arnstein*, the issue of unlawful appropriation—also known as substantial similarity—was a test that was based on “the response of the ordinary lay hearer.”<sup>43</sup>

As the scope of copyright protection expanded beyond mere verbatim copying, courts faced the issue of how to identify actionable non-literal

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Copyright Act abolished the distinction between law and equity in copyright cases, it was not until 1938, when the Federal Rules of Civil Procedure were adopted, that the distinction was abolished for other forms of litigation. After that date, the circumstances under which summary judgment could be granted . . . received a great deal of attention” (FED. R. CIV. P. (1938)); James R. Maxeiner, *Pleading and Access to Civil Procedure: Historical and Comparative Reflections on Iqbal, A Day in Court and A Decision According to Law*, 114 PENN ST. L. REV. 1257, 1277 (2010) (noting the 1938 rules “essentially eliminated” the need for notice pleading).

35. See PATRY, *supra* note 34.

36. 17 U.S.C. §1(b) (1909) (exclusive right to translate literary works, dramatize non-dramatic works, convert dramatic works into nondramatic works, adapt musical works, and execute models of works of art); see also Jessica Litman, *Silent Similarity*, 14 CHI.-KENT J. INTELL. PROP. 11, 17-18 (arguing that courts expanded the reproduction right’s scope to include substantially similar copies in “response to the narrow wording of the adaptation and public performance rights”).

37. See, e.g., *Arnstein v. Porter*, 154 F.2d 464, 475 (2d Cir. 1946) (reversing lower court’s grant of summary judgment).

38. See *Dymow v. Bolton*, 11 F.2d 690, 692 (2d Cir. 1926) (copyright infringement case involving copying of a play’s plot); see also *Daly v. Palmer*, 6 F. Cas. 1132, 1138 (C.C.S.D.N.Y. 1868) (“it is a piracy, if the appropriated series of events, when represented on the stage, although performed by new and different characters, using different language, is recognized by the spectator, through any of the senses to which the representation is addressed, as conveying substantially the same impressions to, and exciting the same emotions in, the mind, in the same sequence or order.”).

39. *Dymow*, 11 F.2d at 692.

40. *Id.*

41. See *Arnstein*, 154 F.2d at 468 (involving alleged infringement of a song’s melody).

42. *Id.*

43. *Id.*

similarities. The Second Circuit in *Nichols*<sup>44</sup> noted that, when describing a work in its “increasing generality,” there is “a point in this series of abstractions where [non-literal similarities] 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.”<sup>45</sup> The court in *Nichols* did not define the exact point where non-literal similarities become so abstract that they are no longer actionable, and “nobody ever can.”<sup>46</sup> However, the court in *Nichols* did, importantly, recognize the *possibility* of actionable non-literal similarities. Although not a literal, exact copy of a play, copying aspects like a play’s plot could still rise to the level of unlawful appropriation.<sup>47</sup>

Although a strong first step, the court in *Nichols* did not address the issue of *how* to distinguish protected from unprotected elements. In response to this void, the Ninth Circuit developed an extrinsic/intrinsic test.<sup>48</sup> In *Krofft*, the court first asked whether there was substantial similarity in ideas: the extrinsic step.<sup>49</sup> This extrinsic step allowed the court to evaluate works with a high degree of similarity in unprotected elements.<sup>50</sup> Further, if the plaintiff succeeded in establishing the extrinsic step, the court required that the trier of fact decide whether there was “substantial similarity in the expressions of the ideas:” the intrinsic step.<sup>51</sup> Thus, the extrinsic step lowered the bar on plaintiffs to survive dispositive pre-trial motions.

Courts interpreting the 1909 Copyright Act responded to the advent of advancing legal technologies (notably, summary judgment)<sup>52</sup> and consumer technologies (such as radio, television, film, and phonograph records).<sup>53</sup> This practice continued under the 1976 Copyright Act. In

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44. *Nichols*, 45 F.2d at 121 (the plaintiff claimed that the defendant copied a material amount of the plaintiff’s play, specifically the play’s plot, characters, and theme).

45. *Id.* *But see* *Nash v. CBS, Inc.*, 899 F.2d 1537, 1540 (7th Cir. 1990) (Judge Easterbrook noting that “[s]ometimes called the ‘abstractions test,’ Hand’s insight [in *Nichols*] is not a ‘test’ at all. It is a clever way to pose the difficulties that require courts to avoid either extreme of the continuum of generality.”).

46. *See Nichols*, 45 F.2d at 121.

47. *See id.* at 121-23.

48. The Second Circuit would also go on to develop its own refinement of the ordinary observer test: the more discerning observer test. *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 766 (2d Cir. 1991). This test is discussed in further detail below.

49. *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1162-63 (9th Cir. 1977).

50. In *Krofft*, the plaintiff was the creator of H.R. Pufnstuf, a children’s TV show. *Id.* at 1161. The defendant was McDonald’s, a hamburger restaurant chain. *Id.* at 1161-2. After establishing the new extrinsic/intrinsic test, the court held that the defendant’s advertisement campaign was substantially similar to the plaintiff’s work and, thus, infringed the plaintiff’s copyright. *Id.* at 1167.

51. *Id.* at 1164.

52. *See* FED. R. CIV. P. (1938) (unifying suits in equity and at law as well as replacing demurrer with motion to dismiss).

53. *See* Litman, *supra* note 36, at 13-14.



1980, two years after the 1976 Copyright Act took effect, Congress amended the statute to expressly protect computer programs.<sup>54</sup> Congress' choice to protect computer programs was not—and to some extent, still is not—an obvious one.<sup>55</sup> Computer programs are utilitarian by nature.<sup>56</sup> The issues that the courts in *Nichols* and *Krofft* addressed became even more vivid when courts had to figure out how to protect seemingly unprotected material in computer programs. In *Altai*<sup>57</sup>, the court adopted a three-part abstraction-filtration-comparison test.<sup>58</sup> Largely a refinement on how the court in *Nichols* conceptualized non-literal similarities, the test in *Altai* allowed the court to separate protected from unprotected material in a computer program.

### B. *Prima Facie Case of Copyright Infringement*

The substantial similarity inquiry is but one part of a larger test. In order to survive dispositive pre-trial motions, such as summary judgment, a Plaintiff must establish a prima facie case of copyright infringement.<sup>59</sup> To establish a prima facie case of copyright infringement, a plaintiff must prove “(1) protected subject matter; (2) ownership by plaintiff of the right alleged to have been infringed at the time it was infringed;” (3) actual copying; and (4) copying “of a material amount of expression.”<sup>60</sup> The

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54. Act of Dec. 12, 1980, Pub. L. No. 96-517, 94 Stat. 3015, 3028; *see also* *Apple Computer v. Franklin Computer*, 714 F.2d 1240 (3rd Cir. 1983) (recognizing computer programs as protected subject matter); FINAL REPORT OF THE NAT'L COMM'N ON NEW TECH. USES OF COPYRIGHTED WORKS 32 (1978) [hereinafter cited as “CONTU”], <http://files.eric.ed.gov/fulltext/ED160122.pdf>.

55. *See* CONTU, *supra* note 54 (Commissioner John Hersey dissent).

56. *Computer Associates Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 704 (2d Cir. 1992) (citing *SAS Inst., Inc. v. S & H Computer Sys., Inc.*, 605 F.Supp. 816, 829 (M.D.Tenn.1985)) (“The essentially utilitarian nature of a computer program further complicates the task of distilling its idea from its expression.”).

57. In *Altai*, the plaintiff alleged unlawful appropriation over the plaintiff's computer program's structure. *Altai, Inc.*, 982 F.2d, at 700. The court held that the non-literal similarities were not substantially similar. *Id.* at 715.

58. *Id.* at 706; *see also* *Whelan Associates, Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1248 (3d Cir. 1986) (“We hold that (1) copyright protection of computer programs may extend beyond the programs' literal code to their structure, sequence, and organization.”).

59. Plaintiffs always carry the burden of proving copyright infringement. *Keeler Brass Co. v. Cont'l Brass Co.*, 862 F.2d 1063, 1065-66 (4th Cir. 1988) (holding that only the burden of production shifts to defendants once plaintiffs establish their prima facie case of copyright infringement).

60. PATRY, *supra* note 34, § 9:4; *see also* *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) (citing *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 548 (1985)) (“[t]o establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”). William Patry's four elements are subdivisions of the elements articulated in *Feist*. *See id.* Patry divides “ownership of a valid copyright” into “protected subject matter” and “ownership of a right.” *See* PATRY, *supra* note 34, § 9:4. Further, Patry divides “copying of constituent elements of the work that are original” into “actual copying” and copying “of a

fourth element, copying a material amount of expression, is the substantial similarity inquiry.

The first element—protected subject matter—is purely legal. The first element ensures that copyright law actually protects the material that the plaintiff is claiming the defendant infringed. Without this element, a plaintiff could claim copyright infringement of anything, including ideas. This is not a trivial result; ideas are often the “building blocks of creativity.”<sup>61</sup> An author that has the power to exclude others from using ideas would be able to block subsequent original works beyond those that unlawfully incorporate the author’s protected expression.<sup>62</sup> This would be at odds with copyright law’s goal of fostering social progress via dissemination of new works.<sup>63</sup>

Similarly, the second element—ownership by plaintiff of the right alleged to have been infringed at the time it was infringed—is procedural in nature. The second element ensures that the person claiming to have been harmed was actually capable of being harmed. This is a standing requirement baked into a plaintiff’s prima facie case.<sup>64</sup> Without this requirement, anyone could bring a copyright claim for anyone else’s copyright.<sup>65</sup> Thus, the standing requirement protects “an alleged infringer from a multiplicity of law suits” while safeguarding the “rights of the other owners of the copyright.”<sup>66</sup>

The third element—actual copying—is pragmatic. The actual copying requirement filters out material that was independently created.<sup>67</sup> With-

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material amount of expression.” *See id.* Each element achieves different legal and policy objectives, which I describe in more detail below.

61. *See* N. Coast Indus. v. Jason Maxwell, Inc., 972 F.2d 1031, 1034 (9th Cir. 1992) (“This court there grappled with the long-standing problem of how to reward creativity without inhibiting the free use of the ideas that are the building blocks of creativity.”).

62. *See id.*

63. *See* U.S. Const. art. I, § 8, cl. 8 (“*To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries*”) (emphasis added).

64. *See* 17 U.S.C. § 501(b) (“the legal or beneficial owner of an exclusive right under a copyright is entitled . . . to institute an action for any infringement of that particular right while he or she is the owner of it”).

65. *See* Eden Toys, Inc. v. Florelee Undergarment Co., 697 F.2d 27, 32 n.3 (2d Cir. 1982) (“[w]e do not believe that the Copyright Act permits holders of rights under copyrights to choose third parties to bring suits on their behalf”).

66. Wenjie Li, *Standing to Sue in Another’s Shoes: Can an Assignee of an Accrued Copyright Infringement Claim with No Other Interest in the Copyright Itself Sue for the Infringement?*, 28 PACE L. REV. 73, 78 (2007); *see also* H.R. REP. NO. 94-1476, at 159 (1976) (noting that the standing requirement “enables the owner of a particular right to bring an infringement action in that owner’s name alone, while at the same time insuring to the extent possible that the other owners whose rights may be affected are notified and given a chance to join the action”).

67. *See* Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345, (1991) (emphasis added) (citing Melville Nimmer & David Nimmer, 1 COPYRIGHT §§ 2.01[A], [B] (1990)) (“Original, as the term is used in copyright, means only that the work was *independ-*

out actual copying, copyright law would require authors to conduct a prior art search before they gain copyright protection.<sup>68</sup> A prior art search is not a foreign concept to intellectual property law.<sup>69</sup> Before an inventor gains patent protection, the patent office conducts a prior art search to ensure, among other things, that the inventor's claimed invention is novel.<sup>70</sup> A prior art search, however, would not be practicable for creative works.<sup>71</sup> Not only are more copyrights registered with the copyright office than patent claims with the patent office,<sup>72</sup> but also the very nature of a creative work restricts any truly practicable means of a prior art search.<sup>73</sup> If it is infeasible for the copyright office to conduct a prior art search, Professor Landes and Judge Posner argue, it is infeasible for authors to do so.<sup>74</sup> As a result, requiring authors to do the grunt work of a prior art search would be economically wasteful and thus inefficient.<sup>75</sup> Therefore, copyright law does not impose liability for creating a work that, no matter how similar it is to a prior work, is independently created. Given that the plaintiff bears the burden of proving infringement, the plaintiff must prove that the defendant actually copied the copyrighted work.

The fourth element—copying of a material amount of expression—is a mixture of law and fact. Within the context of the other elements, it is much more apparent that this element (substantial similarity) is at the heart of copyright law. Substantial similarity ensures that a defendant's copying passed the line from lawful to unlawful copying.<sup>76</sup> Substantial similarity thus recognizes that not all copying amounts to copyright in-

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*dently created* by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.”).

68. See WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 86–88 (2003).

69. See 35 U.S.C. § 102 (2015) (patent law's novelty requirement).

70. See *id.*

71. See LANDES & POSNER, *supra* note 68.

72. The patent office processes over 500,000 patent claims per year. U.S. Patent and Trademark Office, *General Information Concerning Patents*, USPTO (Oct. 2014), <http://www.uspto.gov/patents-getting-started/general-information-concerning-patents> (“Patent applications are received at the rate of over 500,000 per year.”). The copyright office processed over 700,000 copyright registrations in 2011. U.S. Copyright Office, *Overview of the Copyright Office*, COPYRIGHT (last visited April 21, 2016), <http://copyright.gov/about/> (“In fiscal year 2011, the Office processed more than 700,000 registration claims.”). However, unlike patents, registration is not a prerequisite for copyright protection. Compare 17 U.S.C. § 408(a) (2005) (“registration is not a condition of copyright protection”), with 35 U.S.C. § 131 (2002) (“The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.”). If the copyright office had to conduct a prior art search before authors gained copyright protection, the copyright office would need to process much more than 700,000 copyright registrations per year.

73. See LANDES & POSNER, *supra* note 68.

74. *Id.*

75. See *id.*

76. See *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) (“unlawful appropriation”).

fringement.<sup>77</sup> Some copying is inevitable, if not socially valuable and encouraged.<sup>78</sup> Take the example of a songwriter who wants to write a blues. Given the relatively uniform structure of blues songs, the songwriter will almost certainly *actually copy* harmonic, instrumental, rhythmic, and lyrical expression from other blues song.<sup>79</sup> Without the substantial similarity inquiry, only the first person to create a blues song would be able to claim protection in a blues song. This person would be able to exclude others from writing such songs. Thus, absent the fourth element, copyright law would impose a novelty requirement akin to patent law.<sup>80</sup>

## II. RECENT DEVELOPMENTS IN SUBSTANTIAL SIMILARITY

In Part I, this Note evaluated the role of the substantial similarity inquiry in a plaintiff's prima facie case for copyright infringement and the historical development of that inquiry. This part of the Note evaluates more recent developments in the substantial similarity inquiry. Because Congress and the Supreme Court have been silent on the matter, lower courts have largely been alone in developing tests for substantial similarity. Given the federal nature of copyright law and the normative import of predictability, scholars have argued for a more uniform test.<sup>81</sup>

### A. An Unresponsive Congress. A Silent Supreme Court.

The most direct way to resolve a circuit split is for new binding law to direct courts to a specific answer. In the United States, this is most commonly done either at the Congressional or Supreme Court level. Neither Congress nor the Supreme Court, however, have offered any real substantive guidance on substantial similarity.

Although the Copyright Act does not expressly reference the substantial similarity inquiry, Congress is aware that courts engage in the inquiry. Much of the legislative discussion, however, is limited to just that—recognizing that there is such a thing as the substantial similarity inquiry.<sup>82</sup> Congress has expressly deferred to courts to continue developing the sub-

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77. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) (“Not all copying, however, is copyright infringement”).

78. *See id.*

79. Blues songs follow a common twelve-bar blues progression (harmonic) with common instruments, such as guitars, (instrumental) that play a common shuffle groove (rhythmic) under a common lyrical structure of stating a line, repeating it, varying it, and repeating the initial variation again (non-literal copying of lyrical expression).

80. *See* 35 U.S.C. § 102 (2015).

81. *See Substantial Similarity Circuit Split Analysis Materials*, *supra* note 13.

82. For example, Congress has proposed amendments to the Copyright Act to clarify the scope of the substantial similarity inquiry for vessel hull designs. 151 CONG. REC. S10596, S10600 (daily ed. Sept. 28, 2005) (statement of Sen. Cornyn) (purpose of proposed 2005 vessel hull design amendment was “to provide guidance for assessments of substantial similarity, and for other purposes”).

stantial similarity inquiry.<sup>83</sup> Congress has deferred in part out of a belief that “no black letter rule of law can be formulated to draw a precise boundary between substantial similarity and insubstantial similarity.”<sup>84</sup>

Although the Supreme Court has recognized the need for a substantial similarity inquiry,<sup>85</sup> it has yet to offer much in terms of guidance on the matter. The Court in *Harper & Row* offered the most insight into the substantial similarity inquiry.<sup>86</sup> The Court noted that the substantial similarity inquiry separates protected from unprotected material.<sup>87</sup> In separating protected from unprotected material, the substantial similarity inquiry helps “strike the difficult balance between the interests of authors and inventors in the control and exploitation of their writings and discoveries on

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83. See H.R. REP. 98-781, at 26 (1984), reprinted in 1984 U.S.C.C.A.N. 5750, 5775 (with respect to the substantial similarity inquiry as applied to semiconductor chips, “the committee . . . intends that the courts should have sufficient flexibility to develop a new body of law” similar to fact-based works).

84. *Id.* at 27. Congress has also heard testimony with respect to how businesses conform their behavior to the substantial similarity inquiry. See, e.g., *Design Piracy Prohibition Act: Before the Subcomm. on Courts, the Internet, and Intellectual Property of the Committee on House Judiciary*, 109th Cong., 2006 WL 2127241 (statement of David Wolfe, Creative Director, The Doneger Group) (fashion industry); *Database and Collections of Information Misappropriation Act: Subcomm. on Commerce, Trade, and Consumer Protection of the Committee on House Energy and Commerce*, 108th Cong., 2003 WL 22206880 (statement of Keith Kupferschmid, Vice President Intellectual Property Policy & Enforcement, Software & Information Industry Association) (“the usual standard for determining copyright infringement is whether there is ‘substantial similarity’ between the allegedly infringing work and the copyrighted work. However, where databases are involved, the standard is heightened to a ‘virtually identical’ standard.”); *Copyright Protection of Information on the Internet: Before the Subcomm. on Telecommunications, Trade and Consumer Protection of the Committee on Commerce*, 106th Cong., 1999 WL 395046 (statement of Frank Politano, Trademark and Copyright Counsel, AT&T Corp.) (AT&T requesting clarification that the phrase “substantially the same” used in a proposed securities act’s definition does not mean “substantial similarity” as used in copyright law so as to “avoid confusion and ambiguity by ensuring that a copyright law concept is not applied to this statute.”); *Copyright Protection on the Internet: Before the Subcomm. on Courts and Intellectual Property of the Committee on the Judiciary*, 104th Cong., 1996 WL 50053 (statement of Stephen M. Heaton, General Counsel and Secretary, CompuServe Incorporated) (internet-based companies). Similarly, Congress has heard testimony describing the manner in which broadly defined subject matter can impact copyright liability via substantial similarity. *Fashion Design Protection: Hearing on H.R. 5055 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the Judiciary Committee*, 109th Cong., 2006 WL 2265233 (statement of Christopher Sprigman, Associate Professor, University of Virginia School of Law) (“the substantial similarity standard that is in the bill now . . . would reach designs that are inspired as well as those that are copied. I think it would be better if the bill were clearly limited only to those garments that are point-by-point copies of existing garments.”).

85. *Harper & Row v. Nation Enterprise*, 471 U.S. 539, 581 (1985) (J. Brennan dissenting) (noting that substantial similarity, along with Section 102(b) and fair use, serves to separate protected from unprotected material).

86. See *id.*

87. *Id.*

the one hand, and society's competing interest in the free flow of ideas, information, and commerce on the other hand."<sup>88</sup>

Although the Court did not expressly engage in a formal substantial similarity inquiry, the Court in *Feist* did follow in *Harper & Row's* footsteps.<sup>89</sup> The Court filtered out the unprotected, unoriginal elements of a phonebook directory before comparing the two works at issue.<sup>90</sup> When the Court did compare the two works, it recognized that, although the defendant took a "substantial amount of factual information," because that information was unprotected, the copying did not amount to copyright infringement.<sup>91</sup>

Two things are clear. First, both Congress and the Supreme Court recognize that lower courts are engaging in a substantial similarity inquiry. Second, neither Congress nor the Supreme Court have offered much in the way of substantive guidance.

### B. Lower Courts in the Vanguard

Scholars have identified three discrete tests for substantial similarity in the U.S.: the ordinary observer test, the extrinsic/intrinsic test, and the abstraction-filtration-comparison test.<sup>92</sup> Each circuit has used one or more of these tests and promulgated its own take on it.

#### 1. Ordinary Observer

The First, Second, Third, Fifth, and Seventh Circuits each follow the ordinary observer test. The question is whether the defendant took enough of the plaintiff's work such that an ordinary observer's response<sup>93</sup> to the work is to recognize that the defendant "appropriated something which belongs to the plaintiff."<sup>94</sup>

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88. *Id.* at 580 (citing *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984)) (internal quotations omitted).

89. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361-62 (1991). *Harper & Row*, 471 U.S. at 581.

90. *Id.*

91. *Id.*

92. *See, e.g.*, Lippman, *supra* note 11.

93. The ordinary observer's subjective response is key to the ordinary observer test. The ordinary observer test is not asked from the perspective of a lay spectator purposefully trying to detect similarity. *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (emphasis added) (finding that the ordinary observer "would be disposed to" overlook any similarities in the works "unless he set out to *detect* the disparities"). Further, the ordinary observer test is not asked from the perspective of a lay spectator that has had the benefit of expert analysis—commonly referred to as analytic dissection. *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946) (emphasis added) ("The proper criterion on that issue is not an *analytic* or other comparison of the respective musical compositions as they appear on paper or in the judgment of trained musicians"). Here, the ordinary observer test is asked purely from a lay spectator's subjective response to the works at issue. *See id.*

94. *Arnstein*, 154 F.2d at 473 (2d Cir. 1946); *see also* *Peel & Co. v. The Rug Mkt.*, 238 F.3d 391, 398 (5th Cir. 2001); *Wildlife Exp. Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 509

The Second Circuit has refined the ordinary observer test to include a “more discerning observer” test for works that have significant similarity in unprotected material.<sup>95</sup> The inquiry is first to expressly separate the unprotected from the protected material before engaging in an ordinary observer inquiry.<sup>96</sup> That said, using a “total look and feel” analysis, the trier of fact must still consider the work as a whole.<sup>97</sup> The Fifth Circuit Court of Appeals has yet to expressly address the issue of limiting the scope of the ordinary observer test to protected expression.<sup>98</sup> When presented with relevant cases, however, district courts in the Fifth Circuit have begun to adopt the Second Circuit’s more discerning observer test as a means of filtering out unprotected material from the substantial similarity inquiry.<sup>99</sup>

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(7th Cir. 1994) (citing *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607 (7th Cir. 1982)); *O’Neill v. Dell Pub. Co.*, 630 F.2d 685, 687 (1st Cir. 1980); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975).

95. *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 766 (2d Cir. 1991). Patry notes that the more discerning observer test articulated in *Folio* is important in the context of the Second Circuit’s prior decisions. PATRY, *supra* note 34. In *Ideal Toy Corp. v. Fab-Lu Limited (Inc.)*, the court articulated the ordinary observer test in such a way that implied that the ordinary observer test was not limited to similarity of protected expression. 360 F.2d 1021, 1022-23 (2d Cir. 1966) (focusing substantial similarity analysis first on unprotected similarities and then on the work’s differences). Thus, the more discerning observer test narrows the ordinary observer test to comparing protected expression. This distinction is discussed in further detail below.

96. *See Folio Impressions* 937 F.2d at 766.

97. *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003 (2d Cir. 1995) (“It is commonplace that in comparing works for infringement purposes—whether we employ the traditional “ordinary observer” test or the *Folio Impressions* “more discerning” inquiry—we examine the works’ ‘total concept and feel.’”) (citing *Eden Toys, Inc. v. Marshall Field & Co.*, 675 F.2d 498, 500 (2d Cir.1982)). Or, as Patry puts it, in focusing on the forest and not the trees, the ordinary observer should still ignore “public domain trees.” PATRY, *supra* note 34, § 9:137.

98. *But see Eng’g Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1347 (5th Cir. 1994) (quoting *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 710 (2d Cir.1992)) (“To determine substantial similarity, the court should ‘focus on whether the defendant copied any aspect of this protected expression.’”). In *Engineering Dynamics*, the Fifth Circuit did limit the substantial similarity inquiry to protected expression. *Id.* However, the court was applying the *Altai* abstraction-filtration-comparison test in the context of a computer program. *Id.* The Fifth Circuit has yet to apply this narrowed substantial similarity inquiry to the ordinary observer test for cases involving works other than computer programs.

99. *Batiste v. Najm*, 28 F. Supp. 3d 595, 605 (E.D. La. 2014) (“Although the *Altai* test has not been extensively employed in its pure form outside the realm of computer programming and other highly technical subject matters, courts throughout the country have borrowed from its structure to add a threshold ‘filtering’ step to the traditional lay ‘ordinary observer’ test in cases where the plaintiff’s work contains both protected and unprotectable elements. The Second Circuit refers to this filtering approach as a ‘more discerning ordinary observer’ test.”); *see also R. Ready Prods., Inc. v. Cantrell*, 85 F. Supp. 2d 672 (S.D. Tex. 2000) (adopting the more discerning observer test); *Galiano v. Harrah’s Operating Co.*, 2000 U.S. Dist. LEXIS 17258 (E.D. La. Nov. 21, 2000) (adopting the more discerning observer test).

Although the First, Third, and Seventh Circuits have not expressly adopted a separate more discerning observer test, the courts have narrowed the Second Circuit's ordinary observer inquiry to only evaluate similarity of *protected expression*. The First Circuit presents the ordinary observer test as one where the "ordinary reasonable person would conclude that the defendant unlawfully appropriated the *plaintiff's protectible expression* by taking material of substance and value."<sup>100</sup> When conducting the ordinary observer test, the Third Circuit requires the factfinder to "determine whether the later work is similar because it appropriates the *unique expressions* of the original author, or merely because it contains elements that would be expected when two works express the same idea or explore the same theme."<sup>101</sup> The Seventh Circuit has similarly framed the ordinary observer test as "whether the accused work is so similar to the plaintiff's work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff's *protectible expression* by taking material of substance and value."<sup>102</sup>

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100. *Segrets, Inc. v. Gillman Knitwear Co.*, 207 F.3d 56, 62 (1st Cir. 2000) (quoting *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 608 (1st Cir.1988)) (emphasis added).

101. *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 208 (3d Cir. 2005) (emphasis added).

102. *Wildlife Exp. Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 50-09 (7th Cir. 1994) (quoting *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982)). (emphasis added). An indicative example of the Seventh Circuit separating protected from unprotected material while still engaging in a kind of "total look and feel" analysis is seen in *JCW Investments, Inc. v. Novelty, Inc.*:

The pictures show that the similarities between Fred and Fartman go far beyond the fact that both are plush dolls of middle-aged men sitting in armchairs that fart and tell jokes. Both have crooked smiles that show their teeth, balding heads with a fringe of black hair, a rather large protruding nose, blue pants that are identical colors, and white tank tops. On the other hand, Fartman has his name emblazoned in red across his chest, his shoes are a different color from Fred's, as is his chair, and Fartman wears a hat. In the end, despite the small cosmetic differences, the two dolls give off more than a similar air. The problem is not that both Fred and Fartman have black hair or white tank tops or any other single detail; the problem is that the execution and combination of features on both dolls would lead an objective observer to think they were the same.

482 F.3d 910, 916 (7th Cir. 2007); *see also Pampered Chef, Ltd. v. Magic Kitchen, Inc.*, 12 F. Supp. 2d 785, 791-92 (N.D. Ill. 1998) (quoting *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982)) ("While dissection is generally disfavored, the ordinary observer test, in application, must take into account that the copyright laws preclude appropriation of only those elements of the work that are protected by the copyright."); *Theotokatos v. Sara Lee Pers. Prods.*, 971 F. Supp. 332, 341 (N.D. Ill. 1997) (quoting *Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp.*, 25 F.3d 119, 123 (2d Cir.1994)) (noting that, in the context of a derivative work, "the court must find a substantial similarity between the protectable elements of the two works. That is, the plaintiff must show that the defendant appropriated the plaintiff's particular means of expressing an idea, not merely that he expressed the same idea."); *FASA Corp. v. Playmates Toys, Inc.*, 912 F. Supp. 1124, 1147 (N.D. Ill. 1996) (citing *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 141 (2nd Cir.1992) (more discerning ordinary observer test)) ("Where, as here, the Court is comparing products that have both protectible and unprotectible elements, we must exclude comparison of the unprotectible elements from the application of the ordinary observer test.") vacated in part, 108 F.3d 140 (7th Cir. 1997) (vacated for purpose of attorney's fees); *but see Francescatti v.*



## 2. Extrinsic/Intrinsic

The Fourth, Eighth, and Ninth Circuits each follow some form of the extrinsic/intrinsic test.<sup>103</sup> The Ninth Circuit initially established this test in *Krofft*.<sup>104</sup> The court applied a two-step extrinsic and intrinsic test.<sup>105</sup> The extrinsic test, the court described, was a test for substantial similarity in ideas.<sup>106</sup> The intrinsic test was a test for substantial similarity in expression as determined by an ordinary observer.<sup>107</sup> The fundamental effect, the court reasoned, was a more thorough analysis that would protect works with a high degree of similarity in unprotected elements.<sup>108</sup>

Ultimately, due to inconsistent application of the traditional *Krofft* test, the Ninth Circuit in *Shaw* revised the extrinsic/intrinsic test.<sup>109</sup> Now, under *Shaw*, the *Krofft* test's first step is no longer framed as a comparison of ideas.<sup>110</sup> The first step is instead a comparison of objective aspects of the plaintiff's expression.<sup>111</sup> Further, the *Krofft* test's second step is no longer framed as a comparison of expression of ideas.<sup>112</sup> Under *Shaw*, the second step is a comparison of subjective aspects of the plaintiff's expression.<sup>113</sup>

The Eighth Circuit follows the Ninth Circuit's framing of the extrinsic/intrinsic test. Although the Eighth Circuit adopted the *Krofft* test before the Ninth Circuit's refinement of the extrinsic/intrinsic test in *Shaw*, the Eighth Circuit requires that courts focus the extrinsic step "on objective

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Germanotta, No. 11 CV 5270, 2014 WL 2767231, at \*11 (N.D. Ill. June 17, 2014) (although the court purported to reject the more discerning observer test, the court's reasoning indicates that it actually rejected the intended audience test).

103. Hartman v. Hallmark Cards, Inc., 833 F.2d 117, 120 (8th Cir. 1987)

104. Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1162-63 (9th Cir. 1977).

105. *Id.* at 1162-63.

106. *Id.*

107. *Id.*

108. *Id.*

109. Shaw v. Lindheim, 919 F.2d 1353, 1357 (9th Cir. 1990) ("Because the criteria incorporated into the extrinsic test encompass all objective manifestations of creativity, the two tests are more sensibly described as objective and subjective analyses of *expression*, having strayed from *Krofft's* division between expression and ideas."). In *Shaw*, the plaintiff, "a well-known writer and producer in the entertainment industry," claimed that the defendant, a former NBC Television executive, infringed the plaintiff's copyright in the plaintiff's script. *Id.* at 1355. The court remanded after holding that the plaintiff satisfied the extrinsic test and thus had "presented a triable issue of fact." *Id.* at 1363-64.

110. *See id.*

111. *Id.* Objective expression includes aspects like theme, plot, and characters, *id.* (literary works), as well as a work's "subject matter, shapes, colors, materials, and arrangement." Cavalier v. Random House, Inc., 297 F.3d 815, 826 (9th Cir. 2002) (works of visual art).

112. *See Shaw*, 919 F.2d at 1357.

113. *Id.*

similarities in the details of the works.”<sup>114</sup> Thus, whatever distinction there is between the Eighth and Ninth’s Circuit’s framing of the extrinsic/intrinsic test, it is likely one without a difference.

The Fourth Circuit follows the extrinsic/intrinsic test with two notable nuances. First, the Fourth Circuit, like the Eighth Circuit, adopted the *Krofft* test before the Ninth Circuit’s refinement in *Shaw*.<sup>115</sup> Instead of comparing a random list of factual similarities, the Fourth Circuit searches “for extrinsic similarities such as those found in plot, theme, dialogue, mood, setting, pace, or sequence.”<sup>116</sup> Thus, like the Eighth Circuit, whatever distinction there is between the Fourth and Ninth’s Circuit’s framing of the extrinsic step, it is likely one without a difference.

Second, and more importantly, the Fourth Circuit asks the intrinsic test from the perspective of the work’s intended audience, which is not necessarily the ordinary observer.<sup>117</sup> In *Dawson v. Hinshaw Music*, the Fourth Circuit clarified that works are created for a specific audience.<sup>118</sup> Usually, that audience is the general public.<sup>119</sup> In that case, the ordinary observer test is rightly applied. In some situations, however, the intended audience is much more specialized, as is the case with children’s music.<sup>120</sup> In that case, the observer must be viewed from the perspective of an ordinary child (i.e. the intended audience).<sup>121</sup>

### 3. Abstraction-Filtration-Comparison

The Sixth, Tenth, and D.C. Circuits each follow the abstraction-filtration-comparison test.<sup>122</sup> As described in section I.A. of this Note, the abstraction-filtration-comparison test was first developed in the context of

114. *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120 (8th Cir. 1987) (citing *McCulloch v. Albert E. Price, Inc.*, 823 F.2d 316, 319 (9th Cir. 1987)).

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

116. *Id.*

117. *Charles W. Ross Builder, Inc. v. Olsen Fine Home Bldg., LLC*, 496 F. App’x 314, 318 (4th Cir. 2012).

118. 905 F.2d 731, 735 (4th Cir. 1990) (noting works like computer programs and children’s products are not intended for the general public). In *Dawson*, the plaintiff owned the copyright in “an arrangement of the spiritual ‘Ezekiel Saw De Wheel.’ ” *Id.* at 732. The plaintiff claimed that the defendant’s arrangement of the same spiritual infringed the plaintiff’s copyright. *Id.* The court remanded after holding that, before the district court applies the ordinary observer test, it must first determine “whether the audience of [the plaintiff’s] work possessed specialized expertise that the lay public lacks.” *Id.* at 737.

119. *Id.* at 735 (“in most fact scenarios, the general lay public fairly represents the works’ intended audience”).

120. *Id.*

121. *Id.*

122. *Kohus v. Mariol*, 328 F.3d 848, 854 (6th Cir. 2003); *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1297-1300 (D.C. Cir. 2002) (although the Court did not expressly adopt the abstraction test, it did approve of the district court’s use of the three steps in its reasoning); *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 834 (10th Cir. 1993) (citing *Autoskill Inc. v. Nat’l Educ. Support Sys., Inc.*, 994 F.2d 1476, 1487 (10th Cir. 1993)).

evaluating computer programs for actionable non-literal similarity.<sup>123</sup> Although the *Altai* test has been widely adopted,<sup>124</sup> only the Sixth, Tenth, and D.C. Circuits have extended it beyond computer programs.

The abstraction-filtration-comparison test breaks the substantial similarity inquiry into three steps. First, in the abstraction step, the court must arrange a work in its different levels of generality.<sup>125</sup> Second, in the filtration step, the court must separate protected from unprotected elements in each level of abstraction.<sup>126</sup> Third, in the comparison step, the finder of fact must compare the protected elements of each level of abstraction for similarity, which is generally asked from the perspective of the ordinary observer.<sup>127</sup>

The D.C. Circuit only applies the extended abstraction-filtration steps to the ordinary observer test when the works at issue share significant similarities in unprotected material.<sup>128</sup> By contrast, the Tenth Circuit has used the abstraction-filtration-comparison test in all substantial similarity inquiries since 1996.<sup>129</sup> The Sixth Circuit also uses the abstraction-filtration-comparison test as its exclusive test for substantial similarity, however, the Sixth Circuit has one nuance. The Sixth Circuit asks the final comparison question from the perspective of the intended audience, which, as noted above, is generally, but not always, the ordinary observer.<sup>130</sup>

#### 4. Undefined

The Eleventh Circuit has refused to hold itself to any one of the three primary tests.<sup>131</sup> The Eleventh Circuit first used the ordinary observer test

123. *Computer Associates Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 696 (2d Cir. 1992) (“Among other things, this case deals with the challenging question of whether and to what extent the ‘non-literal’ aspects of a computer program, that is, those aspects that are not reduced to written code, are protected by copyright.”).

124. *See, e.g., Eng’g Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1342 (5th Cir. 1994) (adopting the *Altai* abstraction-filtration-comparison test).

125. *Altai*, 982 F.2d at 706 (“In ascertaining substantial similarity under this approach, a court would first break down the allegedly infringed program into its constituent structural parts.”).

126. *Id.* (“Then, by examining each of these parts for such things as incorporated ideas, expression that is necessarily incidental to those ideas, and elements that are taken from the public domain, a court would then be able to sift out all non-protectable material.”).

127. *Id.* (“Left with a kernel, or possible kernels, of creative expression after following this process of elimination, the court’s last step would be to compare this material with the structure of an allegedly infringing program.”).

128. *See Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1297-1300 (D.C. Cir. 2002); *see also Atkins v. Fischer*, 331 F.3d 988, 993 (D.C. Cir. 2003) (applying ordinary observer test in case where there was not an issue of similarity in unprotected material).

129. *See, e.g., Country Kids ‘N City Slicks v. Sheen*, 77 F.3d 1280, 1285 (10th Cir. 1996).

130. *Kohus v. Mariol*, 328 F.3d 848, 854 (6th Cir. 2003).

131. Similarly, the Federal Circuit follows the jurisprudence of the circuit from which the case is taken. *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1574-75 (Fed. Cir. 1984) (“the Federal Circuit shall review procedural matters, that are not unique to patent

in a case involving dolls.<sup>132</sup> However, at least in the case of computer programs, the Eleventh Circuit has also used the abstraction-filtration-comparison test.<sup>133</sup> The Eleventh Circuit's stance on the extrinsic/intrinsic test is currently unclear. Although the court approved of a district court's use of the extrinsic/intrinsic test in a case involving a motion-picture,<sup>134</sup> the court did not recognize the efficacy of the test in a case involving an architectural design<sup>135</sup>

### C. Scholars Debate

Scholars have addressed various issues with the substantial similarity tests. Some scholars have argued for significant procedural overhauls while others have argued for more focused substantive fixes.

Professors Michael Landau and Donald Biederman addressed the “epidemic of intercircuit splits” with a procedural overhaul.<sup>136</sup> The authors distinguished the different tests for substantial similarity on one key aspect: whether the fact-finder had the benefit of expert testimony—of analytic dissection.<sup>137</sup> Tests like the Fourth Circuit's intended audience test were exemplary of “lack of judicial expertise . . . and familiarity with copyright issues on the part of federal” judges.<sup>138</sup> The author's answer to the circuit split was for the “creation of a national copyright court.”<sup>139</sup> Thus, instead of a substantive fix, this procedural overhaul would allow for legal uniformity in the substantial similarity inquiry.<sup>140</sup>

This proposal is not necessarily bad. Assuming, however, that there are actually competing substantial similarity tests that lead to different results, Landau and Biederman's proposal of a national copyright court still does not answer the question: specifically, what is the test for substantial similarity?

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issues, under the law of the particular regional circuit court where appeals from the district court would normally lie”); *see also* *Atari Games Corp. v. Nintendo of Am., Inc.*, 897 F.2d 1572, 1575 (Fed. Cir. 1990) (citing *Panduit Corp.*, 744 F.2d at 1575) (“When the questions on appeal involve law and precedent on subjects not exclusively assigned to the Federal Circuit, the court applies the law which would be applied by the regional circuit.”).

132. *Original Appalachian Artworks v. Toy Loft, Inc.*, 684 F.2d 821, 829-30 (11th Cir. 1982).

133. *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1543-44 (11th Cir. 1996).

134. *Herzog v. Castle Rock Entm't*, 193 F.3d 1241, 1257 (11th Cir. 1999).

135. *Oravec v. Sunny Isles Luxury Ventures, L.C.*, 527 F.3d 1218, 1224 (11th Cir. 2008).

136. Michael Landau & Donald E. Biederman, *The Case for A Specialized Copyright Court: Eliminating the Jurisdictional Advantage*, 21 *HASTINGS COMM. & ENT. L.J.* 717, 737, 784 (1999).

137. *Id.* at 732-33.

138. *Id.* at 736-38.

139. *Id.* at 736.

140. *See id.* at 738.

Another common approach scholars have advocated for are substantive fixes to specific substantial similarity tests.<sup>141</sup> For example, depending on how confident we are with a fact finder's ability to recognize similarity, the ordinary observer test will have the risk of either being over-inclusive or under-inclusive. If fact finders have behavioral biases that cause them to incorrectly find material similarities, then the ordinary observer test will be over-inclusive.<sup>142</sup> By contrast, if fact finders are oblivious to material similarities, then the ordinary observer test will be under-inclusive. Thus, one response to this issue is to educate the fact finder as to how a learned ordinary observer would identify similarity.<sup>143</sup>

There are two issues with the “educate-the-fact-finder” argument. First, it presupposes that the person educating the fact finder (the “educator”) knows what substantial similarity is. If only the fact finder knew as much about music, visual art, and novels as the educator did, the reasoning goes, the fact finder would rightly identify substantial similarity. But this rhetoric does nothing more than shift the definition of substantial similarity. Currently, the ordinary observer test defines substantial similarity as being enough similarity such that a reasonable, lay spectator would recognize the subsequent work as having appropriated expression from the prior work.<sup>144</sup> Educating the fact finder would instead define substantial similarity as having enough similarity such that the educator—or, more specifically, the most believable expert at trial—would recognize the subsequent work as having appropriated expression from the prior work.<sup>145</sup>

Second, the “educate-the-ordinary-observer” argument presupposes that substantial similarity is an objective inquiry. Substantial similarity is not an objective, binary inquiry; there is no hard threshold that, once passed, the defendant can be said to have copied too much.<sup>146</sup> Substantial similarity is a subjective standard. This is not a flaw in the inquiry. The

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141. See, e.g., Jamie Lund, *Fixing Music Copyright*, 79 BROOK. L. REV. 61, 104-06 (2013) (arguing juries should use surveys of how “fluent musicians” evaluate the similarity of the music at issue); Yvette Joy Liebesman, *Using Innovative Technologies to Analyze for Similarity Between Musical Works in Copyright Infringement Disputes*, 35 AIPLA Q. J. 331, 334-35 (2007) (arguing courts should use technology, such as the music genome project, to determine unlawful appropriation); Stephanie J. Jones, *Music Copyright in Theory and Practice: An Improved Approach for Determining Substantial Similarity*, 31 DUQ. L. REV. 277, 303 (1993) (proposing to reverse the order of the *Krofft* test from extrinsic/intrinsic to intrinsic/extrinsic).

142. See, e.g., Jamie Lund, *An Empirical Examination of the Lay Listener Test in Music Composition Copyright Infringement*, 11 VA. SPORTS & ENT. L.J. 137, 175 (2011) (arguing author’s “experiment suggest[s] that the Lay Listener Test is poorly suited to weighing the ‘substantial similarity’ of musical compositions”).

143. See Lund, *supra* note 141.

144. See *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946).

145. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”).

146. See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

open-ended nature of the substantial similarity inquiry accommodates for developing social norms while injecting community morals into a copyright infringement suit.<sup>147</sup> Thus, at least in cases that solely involve literal copying, educating the ordinary observer would hamper the fact-finder's normative role in a copyright infringement suit.

### III. THE VARIOUS SUBSTANTIAL SIMILARITY TESTS ARE SUBSTANTIALLY SIMILAR

Part I described the context and role of the substantial similarity inquiry in a copyright infringement suit. Part II argued that appellate courts have largely been alone in developing tests for determining when an appropriation passes from lawful to unlawful. Currently, courts have developed three tests to answer this question: the ordinary observer test, the extrinsic/intrinsic test, and the abstraction-filtration-comparison test.<sup>148</sup> Scholars have argued that these competing tests have caused a circuit split that should be resolved.<sup>149</sup>

This part of the Note argues that the substantial similarity's circuit split does not need to be "resolved." Although each substantial similarity test is framed using different language, each test engages in substantially the same, and at times exactly the same, analysis. The substantial similarity inquiry identifies similarities in its various degrees of generality (literal and non-literal similarity), separates unprotected from protected material, and compares the remaining protected expression for quantitatively and qualitatively meaningful similarity.<sup>150</sup> Therefore, although each test is textually different, the actual substantive inquiry is substantially the same. This insight into the current state of the substantial similarity inquiry is not

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147. See Solomon & Hannaford-Agor, *supra*, note 18; see also Zeisel, *supra* note 18; *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903); *THE FEDERALIST* No. 83, *supra* note 18.

148. See, e.g., *Kohus v. Mariol*, 328 F.3d 848, 854–56 (6th Cir. 2003) (abstraction-filtration-comparison test); *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1162–63 (9th Cir. 1977) (extrinsic/intrinsic test); *Arnstein*, 154 F.2d at 473 (ordinary observer test).

149. See *Substantial Similarity Circuit Split Analysis Materials*, *supra* note 13.

150. See, e.g., *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361–62 (1991). Although the Court in *Feist* did not expressly follow any particular test for substantial similarity, the Court effectively applied the abstraction-filtration-comparison analysis. First, the Court separated expression into its different levels of generality. See *id.* The Court differentiated the copied text and numbers from the copied organization of the text and numbers. *Id.* Second, the Court filtered out protected from unprotected expression. *Id.* With respect to the literal copying of expression, the Court held that all of the Plaintiff's text and numbers were unprotected facts. *Id.* at 361. With respect to the non-literal copying of expression, the Court held that the plaintiff's organization of the text and numbers was unprotected because it was not sufficiently original. *Id.* at 362. Finally, the Court did not engage in a comparison analysis because, after the Court's filtration analysis, there was nothing left to compare. See *id.* Thus, although the defendant copied a "substantial amount of factual information," the defendant's "use of the listings [did not] constitute infringement." *Id.* at 364.

a novel one; this insight is what the Sixth Circuit attempted to argue in *Kohus*.<sup>151</sup>

### A. *The Continuum of Generality*

The various tests for substantial similarity can be viewed as addressing issues that arise on a continuum of generality.<sup>152</sup> This continuum of generality refers to the relative abstraction of expression. On one end of the continuum are cases that involve literal copying of expression. The plaintiff claims that the defendant copied aspects like the plaintiff's actual, exact words. If the literal copying is so comprehensive that the defendant created an exact, or virtually exact, copy, then the substantial similarity inquiry is short circuited—there is no genuine dispute as to actionable similarity.<sup>153</sup> On this end of generality, the substantial similarity inquiry plays a much more important role when the literal copying is only of fragmented portions of the plaintiff's expression.<sup>154</sup>

On the opposite end of the continuum are cases that involve copying only of ideas. On this end of generality, the comparison step in the substantial similarity inquiry is not required because copyright does not pro-

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151. See *Kohus*, 328 F.3d at 854-57 (6th Cir. 2003) (unifying all tests under one abstraction-filtration-comparison test).

152. See *Nash v. CBS, Inc.*, 899 F.2d 1537, 1540 (7th Cir. 1990). In *Nichols*, Judge Hand noted that, on the continuum of generality, there is a point where protected expression becomes unprotected idea:

But when the plagiarist does not take out a block in suit, but an abstract of the whole, decision is more troublesome. Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his 'ideas,' to which, apart from their expression, his property is never extended. Nobody has ever been able to fix that boundary, and nobody ever can. In some cases the question has been treated as though it were analogous to lifting a portion out of the copyrighted work; but the analogy is not a good one, because, though the skeleton is a part of the body, it pervades and supports the whole. In such cases we are rather concerned with the line between expression and what is expressed. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (citations omitted). In *Nash*, Judge Easterbrook clarified the scope of Judge Hand's *Nichols* "abstraction test." *Nash*, 899 F.2d at 1540. Judge Easterbrook noted that "[s]ometimes called the 'abstractions test,' Hand's insight [in *Nichols*] is not a 'test' at all. It is a clever way to pose the difficulties that require courts to avoid either extreme of the *continuum of generality*." *Id.* (emphasis added).

153. See JULIE E. COHEN ET AL., *COPYRIGHT IN A GLOBAL INFORMATION ECONOMY* 248 (4th ed. 2015) (noting that, with respect to exact copying, "[a]bsent some defense, the defendant will be liable for" infringement). Comprehensive literal copying includes conduct like pirating. See *id.* at 248-49 (noting two kinds of conduct: piracy and allegedly "privileged activities").

154. Fragmented literal similarity results from conduct like copying only small segments of a work's expression. MELVILLE B. NIMMER & DAVID NIMMER, 4 *NIMMER ON COPYRIGHT* § 13:03(A)(2) (LexisNexis 2016). A song that copies a short lyrical phrase from a prior song is an example of fragmented literal similarity.

test ideas.<sup>155</sup> Somewhere in between either end of the continuum of generality are the more “troublesome” cases that involve non-literal copying of expression.<sup>156</sup> The plaintiff claims that the defendant copied aspects like the plaintiff’s structure and organization.<sup>157</sup>

When actually applied, each of the three discrete tests offers significantly similar analysis. With respect to literal copying of expression, the three tests effectively apply the ordinary observer test. With respect to non-literal copying of expression, the three tests effectively apply the abstraction-filtration-comparison test.

### 1. Literal Copying of Expression

This section evaluates how courts apply the various substantial similarity tests in disputes over literal copying of expression. The plaintiff is not arguing that the defendant copied elements like the plaintiff’s work’s structure. The plaintiff is arguing that the defendant copied elements like the actual text of a novel or the actual melody of a song.

Courts almost always apply the ordinary observer test to disputes over literal copying of expression.<sup>158</sup> Certainly, courts that follow the ordinary observer test will apply it here. These courts ask whether a lay spectator’s response to the defendant’s work is such that they would recognize the defendant’s work as appropriating “something which belongs to the plaintiff.”<sup>159</sup> Some jurisdictions filter out unprotected material before the ordinary observer inquiry;<sup>160</sup> other jurisdictions include this step in the ordinary observer inquiry itself.<sup>161</sup> In either jurisdiction, the end result is the same: courts separate protected from unprotected material in the substantial similarity inquiry.<sup>162</sup>

Jurisdictions that follow the extrinsic/intrinsic and abstraction-filtration-comparison tests will also apply the ordinary observer test to disputes over literal copying of expression. As currently defined, the extrinsic/intrinsic test requires courts to, first, evaluate objective similarities and, second, evaluate subjective similarities.<sup>163</sup> First, the objective step requires

155. See *Feist*, 499 U.S. at 361-62 (1991) (not engaging in a comparison analysis because the defendant only copied unoriginal, noncopyrightable elements).

156. See *Nichols*, 45 F.2d at 121 (“when the plagiarist does not take out a block in suit, but an abstract of the whole, decision is more troublesome”).

157. Nimmer only discusses “comprehensive” non-literal similarities. NIMMER & NIMMER, *supra* note 154, § 13:03(A)(1). This includes conduct like copying a computer program’s structure. See *id.*

158. The one exception is the intended audience test, which has extremely limited application. See *Dawson*, 905 F.2d at 737.

159. *Arnstein*, 154 F.2d at 473.

160. See *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 766 (2d Cir. 1991).

161. See, e.g., *Wildlife Exp. Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 509 (7th Cir. 1994) (citing *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607 (7th Cir. 1982)).

162. See, e.g., *Folio Impressions*, 937 F.2d at 766; *Wildlife Exp.*, 18 F.3d at 509–11.

163. *Shaw v. Lindheim*, 919 F.2d 1353, 1357 (9th Cir. 1990).



courts to compare non-literal similarities.<sup>164</sup> By definition, the first step of the extrinsic/intrinsic test is not concerned with literal similarities. The objective step is thus effectively bypassed in disputes over literal similarities. Second, the subjective step requires courts to ask whether a lay spectator's subjective response to the defendant's work is such that they would recognize the defendant's work as appropriating "something which belongs to the plaintiff."<sup>165</sup> The subjective step is thus effectively the ordinary observer test. Therefore, in the context of literal copying of expression, the overall effect of the extrinsic/intrinsic test is the application of the ordinary observer test.

The abstraction-filtration-comparison test requires courts to, as the name implies, identify a work's various levels of abstraction, filter out any unprotected material from each level of abstraction, and then compare the works at issue for substantial similarity.<sup>166</sup> When the dispute is only over literal copying of expression, the abstraction step ends with the first level of generality.<sup>167</sup> The court will have no need to analyze similarity in higher levels of generality (non-literal similarity) because there is no dispute over it.<sup>168</sup> The court will thus move directly to the filtration step and filter out unprotected material.<sup>169</sup> This step is akin to the more discerning observer test. Finally, from the remaining protected material, the court will ask whether a lay spectator's response to the defendant's work is such that they would recognize the defendant's work as appropriating "something which belongs to the plaintiff."<sup>170</sup> Thus, in the context of literal copying of expression, the overall effect of the abstraction-filtration-comparison test is the application of the ordinary observer test.

The key take-away here is that courts throughout the U.S. are applying the ordinary observer test to disputes over literal similarities. The analysis

164. *Cavalier v. Random House, Inc.*, 297 F.3d 815, 826 (9th Cir. 2002) (including similarities in "subject matter, shapes, colors, materials, and arrangement.").

165. *Arnstein*, 154 F.2d at 473; *Cavalier*, 297 F.3d at 822 (explaining that the "intrinsic test" is a subjective comparison that focuses on "whether the ordinary, reasonable audience" would find the works substantially similar in the "total concept and feel of the works").

166. *Altai*, 982 F.2d at 706.

167. *See, e.g., Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1373 (10th Cir. 1997) ("[w]here, as here, the alleged infringement constitutes the admitted literal copying of a discrete, easily-conceptualized portion of a work, we need not perform complete abstraction-filtration-comparison analysis."); *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1357 n.4 (Fed. Cir. 2014) ("this full [abstraction] analysis only applies where a copyright owner alleges infringement of the non-literal aspects of its work").

168. *See Mitel*, 124 F.3d at 1373 ("Where, as here, the alleged infringement constitutes the admitted literal copying of a discrete, easily-conceptualized portion of a work, we need not perform complete abstraction-filtration-comparison analysis").

169. *Oracle*, 750 F.3d at 1357 n.4 (when literal copying admitted, a court "may focus the protectability analysis on the filtration stage, with attendant reference to standard copyright principles").

170. *Arnstein*, 154 F.2d at 473; *Country Kids*, 77 F.3d at 1288 ("In this context, we believe the 'ordinary observer' test is an appropriate method for the court to use in its comparison analysis").

in the extrinsic/intrinsic test and abstraction-filtration-comparison test collapses into the final subjective comparison of literal similarities, which is the ordinary observer test.

## 2. Non-Literal Copying of Expression

This section evaluates how courts have both developed and applied the various substantial similarity tests in disputes over non-literal copying of expression. The copying at issue is not over the actual text of a novel or the actual melody of a song. Instead, the copying at issue is over the relatively more abstract aspects of a work, such as plot, themes, and structure.

Although the ordinary observer test works remarkably well when comparing literal similarities, the ordinary observer test is not without fault. Its efficacy starts to break down when the plaintiff claims non-literal copying of expression, particularly when the works at issue have significant similarities in unprotected expression.<sup>171</sup> How would a lay, reasonable spectator identify similarity in the general structure of computer code? As traditionally framed (without the more discerning observer test), the ordinary observer test has the risk of protecting unprotected material.<sup>172</sup> Thus, the fundamental issue here is how to distinguish idea from expression and ensure that the court only protects the latter.

Courts in their analysis do not always speak in terms of *Altai*'s abstraction-filtration-comparison test. Courts, however, effectively apply the three steps in the context of disputes over non-literal copying of expression.<sup>173</sup> Certainly, courts in jurisdictions that follow the abstraction-filtration-comparison test apply it here. As the name implies, courts first identify expression in its different levels of generality.<sup>174</sup> Courts then filter out elements that are not protected.<sup>175</sup> Finally, courts compare the remaining protected expression from the perspective of an ordinary observer.<sup>176</sup> In the context of select works with highly specialized audiences, such as a computer program, some courts refine the perspective of comparison to the intended audience.<sup>177</sup>

Jurisdictions that follow the ordinary observer and extrinsic/intrinsic tests in effect apply the abstraction-filtration-comparison test to disputes over non-literal copying of expression. Depending on the jurisdiction, courts that follow the ordinary observer test will either filter out unpro-

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171. See *Nichols*, 45 F.2d at 121 (describing that the determination of a copying of "an abstract of the whole" is "more troublesome").

172. See PATRY, *supra* note 34 (arguing the more discerning observer test narrows the ordinary observer test to only comparing protected expression).

173. See *generally* *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)

174. *Altai*, 982 F.2d at 706–07.

175. *Id.* at 707–10.

176. *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1288 ("In this context, we believe the 'ordinary observer' test is an appropriate method for the court to use in its comparison analysis").

177. See, e.g., *Kohus v. Mariol*, 328 F.3d 848, 857 (6th Cir. 2003).

tected material before the ordinary observer inquiry<sup>178</sup> or during the ordinary observer inquiry itself<sup>179</sup>. Courts then apply the ordinary observer test using a “total look and feel” analysis.<sup>180</sup> The trier of fact must still consider the work as a whole when evaluating whether a lay spectator’s response to the defendant’s work is such that they would recognize the defendant’s work as appropriating “something which belongs to the plaintiff.”<sup>181</sup> Albeit messy, the ultimate effect of the ordinary observer test is to identify expression in higher levels of abstraction (aided by the added “total look and feel” analysis), filter out unprotected material (aided by the more discerning observer test), and compare the remaining expression for similarity.

As currently defined, the extrinsic/intrinsic test requires courts to, first, evaluate objective similarities and, second, evaluate subjective similarities.<sup>182</sup> First, the objective step requires courts to compare non-literal similarities.<sup>183</sup> Courts evaluate similarities in aspects like a work’s shape, color, material, and general arrangement.<sup>184</sup> Courts engage in analytic dissection to separate protected from unprotected material.<sup>185</sup> This allows the court to determine whether or not the abstract level of expression is itself protected. If it is, the court will move on to the subjective step. Second, the subjective step requires courts to ask whether a lay spectator’s subjective response to the defendant’s work is such that they would recognize the defendant’s work as appropriating “something which belongs to the plaintiff.”<sup>186</sup> The overall effect of the extrinsic/intrinsic test is thus to identify expression in higher levels of abstraction, filter out unprotected material, and compare the remaining expression for similarity.

*Feist* is a prominent example of a court applying the abstraction-filtration-comparison test without expressly stating that it was adopting any sort of substantial similarity test. In *Feist*, the works at issue were telephone directories.<sup>187</sup> The plaintiff claimed that the defendant had copied the plaintiff’s selection and arrangement of telephone numbers.<sup>188</sup> This or-

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178. See, e.g., *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 766 (2d Cir. 1991).

179. See, e.g., *Wildlife Exp. Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 50-09 (7th Cir. 1994) (quoting *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982)).

180. See, e.g., *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003 (2d Cir. 1995).

181. *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946).

182. *Shaw v. Lindheim*, 919 F.2d 1353, 1357 (9th Cir. 1990).

183. *Cavalier v. Random House, Inc.*, 297 F.3d 815, 826 (9th Cir. 2002)

184. *Id.*

185. *Id.*

186. *Arnstein*, 154 F.2d at 473; *Cavalier*, 297 F.3d at 822 (“The ‘intrinsic test’ is a subjective comparison that focuses on ‘whether the ordinary, reasonable audience’ would find the works substantially similar in the ‘total concept and feel of the works.’ ”).

187. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 342-43(1991).

188. *Id.* Or, as Nimmer calls it, “comprehensive non-literal similarity.” NIMMER & NIMMER, *supra* note 154, § 13:03(A)(1).

ganization was the work's second level of abstraction.<sup>189</sup> The Court in *Feist* filtered out unprotected material in this higher level of abstraction.<sup>190</sup> The Court held that, because the organization was not sufficiently original, it was ineligible for copyright protection.<sup>191</sup> Because there was no further expression left to compare, the Court held that, although the defendant appropriated a "substantial amount of factual information," the defendant was not liable for copyright infringement.<sup>192</sup> Thus, the Court had no need to apply the ordinary observer test in the final comparison step.

Finally, empirical data suggests that whatever distinction there is between circuits, it is one without a difference.<sup>193</sup> In an exhaustive study of all appellate court cases between 1970 and 2010, Katherine Lippman found that "the three main tests—the ordinary observer test, the extrinsic/intrinsic test, and the abstraction-filtration-comparison test—their substantial similarity win rates become closely aligned."<sup>194</sup> In other words, whether substantial similarity is evaluated in the Sixth Circuit, the Second Circuit, or the Ninth Circuit, the end result will very likely be the same.<sup>195</sup>

### B. *Kohus Got It Right*

This section of the Note argues that the court in *Kohus* got it right. In adopting a "new" substantial similarity test, the Sixth Circuit unified *Feist* with prior case law in a single, clean form of analysis.

The plaintiff in *Kohus* alleged that the defendant had infringed the plaintiff's technical drawings of a collapsible playyard.<sup>196</sup> After rejecting both the plaintiff's and the defendant's expert witnesses' testimony, the trial court "concluded that no reasonable trier of fact could find that the Defendants' drawings were substantially similar to the [Plaintiff's] drawing, and held that since Kohus's substantial similarity argument failed, his derivative copying argument should also fail."<sup>197</sup> Thus, the trial court merely applied the ordinary observer test.

Prior to *Kohus*, the Sixth Circuit had yet to adopt a specific test for substantial similarity.<sup>198</sup> The Sixth Circuit changed that in *Kohus*. The court noted that its "criteria in establishing a test" for substantial similarity

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189. On the first level of abstraction (the literal similarities), the plaintiff's telephone directory was a listing of telephone numbers. *Feist*, 499 U.S. at 361. The phone numbers were ineligible for copyright protection because they "existed before Rural reported them and would have continued to exist if Rural had never published a telephone directory." *Id.*

190. *Id.* at 362.

191. *Id.* at 362-63.

192. *Id.* at 361, 363-64.

193. See Lippman, *supra* note 11, at 545 ("win rates" between circuits are "closely aligned").

194. *Id.*

195. *Id.*

196. *Kohus v. Mariol*, 328 F.3d 848, 852 (6th Cir. 2003).

197. *Id.* at 853.

198. *Id.* at 854 (quoting *Ellis v. Diffie*, 177 F.3d 503, 506 n.2 (6th Cir.1999)).

was “faithfulness to the law—to *Feist*, and to [its] prior caselaw insofar as it [was] consistent with *Feist*—and workability.”<sup>199</sup> The court read *Feist* as acknowledging an initial step in the substantial similarity inquiry: filtering out unprotected, unoriginal material.<sup>200</sup> From this, the court held that the first step in its test for substantial similarity was to filter out unprotected material from each level of abstraction.<sup>201</sup>

The court listed various kinds of elements that a court needs to filter out, including “elements that were not independently created . . . , and that possess no minimal degree of creativity.”<sup>202</sup> Elements that were “dictated by efficiency” or had otherwise merged with idea should be filtered out.<sup>203</sup> Similarly, the court required courts to filter out “scenes a faire,” which the court defined as elements that flow naturally from external factors, such as business practices.<sup>204</sup>

The court noted that, once unprotected expression is filtered out from the various levels of abstraction, a court must compare the remaining original expression for substantial similarity.<sup>205</sup> With regard to the comparison step, the Court held as follows:

[T]he substantial similarity test should focus on the *intended audience*. This will ordinarily be the lay public, in which case the finder of fact’s judgment should be from the perspective of the lay observer or, as *Monogram Models* put it, the ordinary reasonable person. But in cases where the audience for the work possesses specialized expertise that is relevant to the purchasing decision and lacking in the lay observer, the trier of fact should make the substantial similarity determination from the perspective of the intended audience. Expert testimony will usually be necessary to educate the trier of fact in those elements for which the specialist will look.<sup>206</sup>

That said, the court heavily limited the departure from the traditional ordinary observer test. The court held that in order to depart from the perspective of the lay observer, the intended audience’s specialized expertise “must go beyond mere differences in taste and instead must rise to the level of the possession of knowledge that the lay public lacks.”<sup>207</sup>

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199. *Id.*

200. *Id.* at 855

201. *Id.* at 855-56.

202. *Id.* at 855.

203. *Id.* at 856.

204. *Id.*

205. *Id.*

206. *Id.* at 857.

207. *Id.* (citing *Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731, 737 (4th Cir.1990)). Such limited application of the intended audience test makes doctrinal sense in the context of the ordinary observer test’s genesis. The ordinary observer test was initially created on the assumption that copyrights are “made for plain people.” *Dymow v. Bolton*, 11 F.2d 690, 692 (2d Cir. 1926). Here, the Sixth Circuit replaced the ordinary observer test with the intended audience test. However, as the Sixth Circuit made clear, this departure only actually applies in situations where the copyright was not made for plain people, such as in the context of computer programs. See *Kohus*, 328 F.3d at 857. In other words, the ordinary observer test has always been the intended audience test, but prior to the technological innovation of com-

Scholars have largely ignored the *Kohus* test. Most scholars have only referenced the *Kohus* test in passing, noting that the Sixth Circuit follows some form of the abstraction-filtration-comparison test.<sup>208</sup> Willaim Patry has offered one of the few substantive critiques against *Kohus*.<sup>209</sup> Patry argues that the abstraction-filtration-comparison test is unnecessary.<sup>210</sup> Anything past the traditional ordinary observer test, Patry argues, is superfluous, or, as Patry puts it, by fixating “on the pine cones of the trees, [*Kohus*] misses the forest.”<sup>211</sup> Moreover, Patry argues that *Kohus* “does violence to basic principles of copyright law hitherto simply expressed and well-understood, while imposing inflated costs on the litigants and the district courts (in time), all toward a result that is sure to be further away from the truth of the matter at hand.”<sup>212</sup>

Patry raises valid points. First, Patry argues that the *Kohus* abstraction-filtration-comparison test is more expensive than the ordinary observer test.<sup>213</sup> It is important to note, however, that courts, including the Sixth Circuit, that apply the abstraction-filtration-comparison test do not always engage in a full abstraction analysis.<sup>214</sup> If the dispute is merely over simple literal copying, the abstraction analysis will end with the first level of generality.<sup>215</sup> An abstraction analysis is not needed past that first level of generality because there is no dispute over non-literal similarities. The court will then engage in an analysis extremely similar to the modern ordinary observer test. Thus, to the extent that the *Kohus* test is more expensive than the ordinary observer test, it is only more expensive in disputes over complex non-literal copying of expression. Further, even there, it is unlikely that the *Kohus* test is actually more expensive than the ordinary observer test. As noted above, the ordinary observer test also

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puters and the recognition of programming’s copyrightability, Courts have never needed to speak in terms of the “intended audience.”

208. See Lemley, *supra* note 13, at 26; *but see* PATRY, *supra* note 34, § 9:193 (engaging in extensive discussion of *Kohus*); William A. Hall, *Copyright-Kohus v. Mariol: The Sixth Circuit Adopts Two-Step Test for Substantial Similarity in Copyright Infringement*, 34 U. Mem. L. Rev. 995, 1007 (2004).

209. PATRY, *supra* note 34, § 9:193.

210. *Id.* (“In 2003, the circuit took a giant step toward incomprehensibility, with its ‘big opinion’ in *Kohus v. Mariol*, an opinion that not only created a conflict between a Supreme Court opinion (Feist) and a fundamental concept of copyright law (the ordinary-observer-test) where none existed, but then ‘solved’ the conflict by creating a test that cobbles together disparate elements that are not related to each other and which, not surprisingly, will not work together.”).

211. *Id.* § 9:70.

212. *Id.* § 9:203.

213. *Id.*

214. *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1357 n.4 (Fed. Cir. 2014) (“this full [abstraction] analysis only applies where a copyright owner alleges infringement of the non-literal aspects of its work”).

215. *Id.*

engages in a sort of abstraction-filtration analysis in the form of the more discerning observer test.<sup>216</sup>

Second, Patry argues that the abstraction-filtration-comparison test is much more involved than merely asking whether a lay spectator's response to the allegedly infringing work is such that they recognize the defendant's work as appropriating something from the plaintiff's work.<sup>217</sup> Aside from simple literal copying, however, no court—not even the Second Circuit—merely applies the traditional ordinary observer test. In a dispute over works that have significant similarities in unprotected material, the Second Circuit will engage in the more discerning observer test to filter out that unoriginal, unprotected material. In this regard, the *Kohus* test has an advantage over the modern ordinary observer test. Relative to the *Kohus* test, the modern ordinary observer test is messy. *Kohus* corrects this messiness with a clean method.

Finally, Patry argues that the *Kohus* abstraction-filtration-comparison test will lead to results that are “sure to be further away from the truth of the matter at hand.”<sup>218</sup> Empirical data, however, suggests the opposite.<sup>219</sup> Whether the substantial similarity inquiry is presented to the Sixth Circuit or the Second Circuit, the end result will very likely be the same.<sup>220</sup> Overall, the Sixth Circuit's *Kohus* test does not call for a different substantive analysis than other circuits. To the contrary, the *Kohus* test embraces the similarity in the various substantial similarity tests.

#### CONCLUSION

Copying is the basis for new expression.<sup>221</sup> But how much copying is too much copying? Since copyright law's inception, courts have developed the doctrine of substantial similarity to answer that question. Tracking the technological advancement of radio, movies, television, sound recordings, and computers, courts have continuously molded the substantial similarity inquiry to match the social norms of the times. From this historical progress, courts have identified that substantial similarity embraces both quantitative and qualitative aspects.<sup>222</sup>

However, because Congress and the Supreme Court have been silent on the matter, lower courts have largely been alone in developing tests to determine exactly when a work is sufficiently quantitatively or qualitatively similar. Thus far, courts have established three discrete tests for substantial similarity in the U.S.: the ordinary observer test, the extrinsic/

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216. See *Folio Impressions* 937 F.2d at 766.

217. PATRY, *supra* note 34, § 9:203.

218. *Id.*

219. See Lippmann, *supra* note 11.

220. *Id.*

221. See Sanchez, *supra* note 3.

222. See *Perris v. Hexamer*, 99 U.S. 674, 675-76 (1878) (holding the substantiality inquiry includes a materiality requirement)

intrinsic test, and the abstraction-filtration-comparison test.<sup>223</sup> Scholars have argued that this circuit split should be resolved with a uniform test.<sup>224</sup> Each substantial similarity test, however, engages in substantially the same, and at times exactly the same, analysis. Moreover, empirical data suggests that the different tests for substantial similarity do not even lead to different outcomes.<sup>225</sup> What copyright commentators have identified as a circuit split in need of resolving is in fact a variety of formulations of a common test. The Sixth Circuit recognized this when it embraced the similarity in the various substantial similarity tests.<sup>226</sup> In this respect, the Sixth Circuit in *Kohus* got it right.

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223. See, e.g., Lippmann, *supra* note 11.

224. *Id.* at 515.

225. See *id.* at 545 (“Remarkably, however, when collapsing the six substantial similarity tests into the three main tests—the ordinary observer test, the extrinsic/intrinsic test, and the abstraction-filtration-comparison test—their substantial similarity win rates become closely aligned.”).

226. See *Kohus v. Mariol*, 328 F.3d 848, 853-57 (6th Cir. 2003).