

Chapter 3

Tests for Substantial Similarity

- § 3:1 Ordinary Observer and More Discerning Ordinary Observer
 - § 3:1.1 Second Circuit
 - [A] Ordinary Observer Test
 - [B] More Discerning Ordinary Observer Test
 - [C] The Sliding Scale of Access and Probative Similarity
 - [D] Summary Judgment, Motion to Dismiss, and Preliminary Injunction
 - § 3:1.2 First Circuit
 - [A] Summary Judgment, Motion to Dismiss, and Preliminary Injunction
 - § 3:1.3 Third Circuit
 - [A] Summary Judgment, Motion to Dismiss, and Preliminary Injunction
 - [B] Special Test for Complex Subjects Including Computer Programs
 - § 3:1.4 Fifth Circuit
 - [A] Summary Judgment, Motion to Dismiss, and Preliminary Injunction
 - § 3:1.5 Seventh Circuit
 - [A] The Role of Access and the Inverse Ratio Rule
 - [B] Summary Judgment, Motion to Dismiss, and Preliminary Injunction
- § 3:2 Extrinsic/Intrinsic Test
 - § 3:2.1 Ninth Circuit
 - [A] Origin of the Extrinsic/Intrinsic Test
 - [B] Evolution of the Extrinsic/Intrinsic Test
 - [C] Analytic Dissection As Part of the Extrinsic Test
 - [D] Intermediate Steps Between *Krofft* and *Shaw*

SUBSTANTIAL SIMILARITY IN COPYRIGHT LAW

- [E] **The Role of Access and the Inverse Ratio Rule**
- [F] **Summary Judgment Under the Extrinsic/
Intrinsic Test**
- [G] **Preliminary Injunctions Under the Ninth
Circuit Test**
- [H] **Difficulties in Applying the Extrinsic/Intrinsic
Test**
- [I] **Motion to Dismiss**
- § 3:2.2 **Fourth Circuit**
 - [A] **Intended Audience Test**
 - [B] **Intended Audience in Computer Cases**
 - [C] **Intended Audience for Works Marketed to
Children**
 - [D] **Intended Audience Versus Ordinary Observer**
 - [E] **Advantages and Disadvantages of the
Intended Audience Test**
 - [F] **Summary Judgment, Motion to Dismiss, and
Preliminary Injunction**
- § 3:2.3 **Eighth Circuit**
 - [A] **Summary Judgment, Motion to Dismiss, and
Preliminary Injunction**
- § 3:3 **Abstraction/Filtration/Comparison**
 - § 3:3.1 **Tenth Circuit**
 - [A] **Summary Judgment, Motion to Dismiss, and
Preliminary Injunction**
 - § 3:3.2 **Sixth Circuit**
 - [A] **Summary Judgment, Motion to Dismiss, and
Preliminary Injunction**
 - § 3:3.3 **D.C. Circuit**
 - [A] **Summary Judgment, Motion to Dismiss, and
Preliminary Injunction**
- § 3:4 **Eleventh Circuit**
 - § 3:4.1 **Summary Judgment, Motion to Dismiss, and
Preliminary Injunction**
- § 3:5 **Federal Circuit**
- § 3:6 **Preliminary Injunction Standards**

There are differences in how courts in the twelve federal circuits compare works in copyright infringement cases. Most courts use one of two tests: the copying/unlawful appropriation test associated with the Second Circuit or the extrinsic/intrinsic test associated with

the Ninth Circuit.¹ The Tenth Circuit, however, uses the abstraction/filtration/comparison test, which most circuits reserve for cases involving computer programs, in all cases. The Sixth Circuit uses a variation of the Tenth Circuit test, which we have labeled filtration/comparison by intended audience. The Eleventh Circuit uses a test that harks back to the days before the Second and Ninth Circuit approaches diverged.

Even within the major schools of thought there are differences. For instance, the Fourth Circuit, which uses the Ninth Circuit approach, seeks in each instance to evaluate the works at issue through the eyes of the work's intended audience, not necessarily those of the "ordinary observer." The Sixth Circuit also has adopted that approach.

Although there are a number of differences in the analysis of substantial similarity among the circuits, a common procedural approach has emerged. A number of earlier opinions expressed the view that substantial similarity was not an issue that should be determined on a pretrial motion such as summary judgment. That reluctance has all but disappeared. Courts now readily consider the issue on motions for summary judgment, motions to dismiss, and motions for judgment on the pleadings. The Third Circuit explained the evolution in *Tanksley v. Daniels*:

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1. Those interested in the sources of the dichotomy of approach taken by the two most influential circuits, the Second and the Ninth, would be well-served to review two cases: *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946) and *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977).

As we explain in section 3:1.1, the Second Circuit in *Arnstein* required that plaintiffs prove both (1) copying and (2) illicit copying (unlawful appropriation) to establish infringement. The Second Circuit still adheres to that approach. As we discuss in section 3:2.1, the Ninth Circuit in *Krofft* reasoned that "when the court in *Arnstein* refers to copying which is not itself an infringement, it must be suggesting copying merely of the work's idea, which is not protected by copyright. To constitute an infringement the copying must reach the point of 'unlawful appropriation' or the copying of protected expression itself." The Second Circuit itself has not read *Arnstein* that way. It is the differing interpretations of *Arnstein* that are the root of the differences between the Ninth Circuit test and the Second Circuit test.

SUBSTANTIAL SIMILARITY IN COPYRIGHT LAW

For present purposes, it is enough to observe that substantial similarity “is usually an extremely close question of fact,” which is why even “summary judgment has traditionally been disfavored in copyright litigation.” *Twentieth Century–Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327, 1330 n.6 (9th Cir. 1983). Nevertheless, if “no reasonable jury” could find that two works are substantially similar, then “summary judgment for a copyright defendant” has been considered “appropriate.” *Sturza v. United Arab Emirates*, 281 F.3d 1287, 1296–97 (D.C. Cir. 2002). And in recent years, several Courts of Appeals have taken the next step by affirming dismissals under Federal Rule of Civil Procedure 12(b)(6) after finding no substantial similarity as a matter of law. See 3 William F. Patry, *Patry on Copyright* § 9:86.50 (Mar. 2018 update) (citing published opinions from the Second, Seventh, Eighth, Ninth, and Tenth Circuits). Such dismissals, which were formerly rare (but not unprecedented, e.g., *Christianson v. W. Pub. Co.*, 149 F.2d 202, 203 (9th Cir. 1945)), are now more common.

In justifying dismissals of copyright in infringement claims, courts follow a now-familiar logical progression. First, in evaluating a motion to dismiss, courts are not limited to the four corners of the complaint, but may also consider evidence “integral to or explicitly relied upon” therein. *In re Rockefeller Ctr. Props., Inc. Sec. Litig.*, 184 F.3d 280, 287 (3d Cir. 1999) (emphasis omitted) (quoting *In re Burlington Coat Factory Sec. Litig.*, 114 F.3d 1410, 1426 (3d Cir. 1997)). The copyrighted and allegedly infringing works will necessarily be integral to an infringement complaint and are therefore properly considered under Rule 12(b)(6). Next, courts have justified consideration of substantial similarity at the pleading stage by noting that “no discovery or fact-finding is typically necessary, because ‘what is required is only a visual comparison of the works.’” *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 64 (2d Cir. 2010) (quoting *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 766 (2d Cir. 1991)). Finally, having limited the focus to the works themselves, courts will dismiss an infringement action if they conclude that “no trier of fact could rationally determine the two [works] to be substantially similar.”

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[W]here no reasonable juror could find substantial similarity, justice is best served by putting “a swift end to meritless litigation.”^{1.1}

In this chapter, we examine and compare how courts in each of the twelve circuits compare works. We reference some of the most significant cases in each circuit and we highlight any unique aspects of each circuit’s jurisprudence.

§ 3:1 Ordinary Observer and More Discerning Ordinary Observer

§ 3:1.1 Second Circuit

The copyright infringement test in the Second Circuit is a step-by-step process.² First, the court determines whether defendant copied from plaintiff.³ In cases where the defendant denies copying, the court tests to see whether the defendant had access to plaintiff’s work at the time defendant prepared his work, and whether there is sufficient similarity between the works to prove copying.⁴ The Second Circuit has clarified that the correct term for this threshold determination of similarity is “probative similarity” rather than “substantial similarity.”⁵ On the probative similarity issue, “analytic dissection” is appropriate and the testimony of experts may be received to aid the trier of the facts.⁶ If the evidence of access is absent, plaintiff can prevail only by showing that the similarities

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- 1.1. *Tanksley v. Daniels*, 902 F.3d 165, 171–72 (3d Cir. 2018) (footnotes and some citations omitted), *cert. denied*, 2019 WL 659816 (U.S. Feb. 19, 2019) (No. 18-701). See our discussion of pretrial motions in the various circuits throughout this chapter.
 2. *Hamil Am., Inc. v. GFI, Inc.*, 193 F.3d 92, 99 (2d Cir. 1999), *cert. denied*, 528 U.S. 1160 (2000); *Laureyssens v. Idea Grp., Inc.*, 964 F.2d 131, 140 (2d Cir. 1992).
 3. *Laureyssens*, 964 F.2d at 140; *Arnstein*, 154 F.2d at 468.
 4. See cases cited in note 3, *supra*.
 5. *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132, 137 (2d Cir. 1998); *Repp v. Webber*, 132 F.3d 882, 889 n.1 (2d Cir. 1997). See also *Laureyssens*, 964 F.2d at 139–40; *Denker v. Uhry*, 820 F. Supp. 722 (S.D.N.Y. 1992), *aff’d*, 996 F.2d 301 (2d Cir. 1993). We discuss probative similarity in section 1:2.
 6. *Arnstein*, 154 F.2d at 468.

between the two works are so striking that they preclude the possibility that the defendant created his work independently.⁷

If the court determines that there has been copying, “then only does there arise the second issue, that of illicit copying (unlawful appropriation).”⁸ The court must then determine whether defendant’s taking is sufficient to constitute infringement. It is that part of the inquiry that is the “substantial similarity” test.⁹ When testing substantial similarity, the court compares the works in final form, as they are presented to the public; drafts and earlier private versions are ignored.¹⁰

[A] Ordinary Observer Test

In cases where the plaintiff’s work is wholly original, that is, where the work does not incorporate public domain or other non-copyrightable material, courts in the Second Circuit test for substantial similarity using the “ordinary observer test.”¹¹ The ordinary observer test is no more than an attempt to gauge the reaction of the ordinary “man on the street” to the two works.¹² “Of course, the ordinary observer does not actually decide the issue; the trier of fact determines the issue in light of the impressions reasonably expected to be made upon the hypothetical ordinary observer.”¹³

7. *Repp*, 132 F.3d at 889; *Arnstein*, 154 F.2d at 468.

8. *Arnstein*, 154 F.2d at 468; *Laureyssens*, 964 F.2d at 140; *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 765–66 (2d Cir. 1991).

9. *Castle Rock Entm’t*, 150 F.3d at 137.

10. *Walker v. Time Life Films, Inc.*, 615 F. Supp. 430, 434 n.2 (S.D.N.Y. 1985), *aff’d*, 784 F.2d 44 (2d Cir.), *cert. denied*, 476 U.S. 1159 (1986).

11. *Boisson v. Banian, Ltd.*, 273 F.3d 262, 271–72 (2d Cir. 2001); *Laureyssens*, 964 F.2d at 140. *See also Shine v. Childs*, 382 F. Supp. 2d 602, 614 (S.D.N.Y. 2005) (declining to accept expert testimony concerning similarity of architectural works).

12. *See Hamil Am., Inc. v. GFI, Inc.*, 193 F.3d 92, 102 (2d Cir. 1999) (“good eyes and common sense may be as useful as deep study of reported and unreported cases, which themselves are tied to highly particularized facts”) (quoting *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1093 (2d Cir. 1974)).

13. *Carol Barnhart, Inc. v. Econ. Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting). *Accord La Resolana Architects, PA v. Reno, Inc.*, 555 F.3d 1171, 1180 (10th Cir. 2009) (“[T]he ‘ordinary observer,’ like the ‘reasonable person’ in tort law, is a legal fiction; it is the measure by which the trier of fact judges the similarity of two works.”).

The fact finder decides whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.¹⁴ In other words, would the ordinary observer, unless he set out to detect the disparities, be disposed to overlook those disparities and regard the aesthetic appeal of the two works as the same?¹⁵ To make that determination, the court must give the works the same degree of scrutiny that the ordinary observer would give them: consumer scrutiny as opposed to courtroom scrutiny.¹⁶ “Dissection” (the piece-by-piece examination of the works’ constituent parts) and expert testimony generally are not considered in connection with the ordinary observer test.¹⁷

[B] More Discerning Ordinary Observer Test

Where what the defendant copied from the plaintiff involves both protectable and unprotectable elements, the ordinary observer test is refined.¹⁸ The court applies the “more discerning ordinary observer test.”¹⁹ In the more discerning ordinary observer test, the fact finder attempts to extract the unprotectable elements from consideration and determine whether the protectable elements as a whole are substantially similar.²⁰ Expressed another way, the fact finder must determine whether that same ordinary person, putting aside those portions of plaintiff’s work that are unprotectable, would

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14. *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995) (citing *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 766 (2d Cir. 1991)); *Laureyssens*, 964 F.2d at 141; *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 1093 (2d Cir. 1977); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).
 15. *Horgan v. MacMillan, Inc.*, 789 F.2d 157, 162 (2d Cir. 1986); *Peter Pan Fabrics*, 274 F.2d at 489; *see also* *Effie Film, LLC v. Murphy*, 564 F. App’x 631, 632 (2d Cir. 2014).
 16. *Hamil Am.*, 193 F.3d at 102.
 17. *Arnstein*, 154 F.2d at 468, 473. See our discussion of expert testimony in section 17:1 for explanation of exceptions to the general rule.
 18. *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001).
 19. *Knitwaves*, 71 F.3d at 1002; *Horizon Comics Prod., Inc. v. Marvel Entm’t, LLC*, 246 F. Supp. 3d 937 (S.D.N.Y. 2017); *Ranieri v. Adirondack Dev. Grp., LLC*, 164 F. Supp. 3d 305, 331 (N.D.N.Y. 2016); *City Merch. Inc. v. Broadway Gifts, Inc.*, 2009 U.S. Dist. LEXIS 5629, at *4–5 (S.D.N.Y. Jan. 27, 2009). The ceramic designs at issue in the case are reproduced in Appendix A.1.F.
 20. *Knitwaves*, 71 F.3d at 1002.

think that defendant’s work was taken from plaintiff’s when comparing the two as a whole.²¹ If so, then there is substantial similarity.

The more discerning ordinary observer test is not a dissection exercise. The fact finder should not dissect the works and then compare only individual elements.²² The fact finder still must consider the works’ overall look and feel.²³ For example, in *Boisson v. Banian, Ltd.*,²⁴ the court compared two quilts that featured designs incorporating letters of the alphabet and various icons. The court explained:

While use of the alphabet may not provide the basis for infringement, we must compare defendants’ quilts and plaintiffs’ quilts on the basis of the arrangement and shapes of the letters, the colors chosen to represent the letters and other parts of the quilts, the quilting patterns, the particular icons chosen and their placement . . . It is at this juncture that we part from the district court, which never considered the arrangement of the whole when comparing plaintiffs’ works with defendants’.²⁵

It may be easiest to explain the more discerning ordinary observer test using a hypothetical. Suppose plaintiff claims defendant infringed the copyright in plaintiff’s blues song. Defendant denies he copied the song, but it turns out plaintiff can prove that defendant was in a blues club when plaintiff sang the song, so defendant had access to the song. To prove copying, however, plaintiff still must

21. *Id.* at 1003; *Folio Impressions*, 937 F.2d at 765–66; *Wolstenholme v. Hirst*, No. 16 Civ. 4385 (JGK), 2017 WL 4277691 (S.D.N.Y. Sept. 25, 2017) (the test “does not change the similarity required, only what elements of the works are being compared”); *I.C. ex rel. Solovsky v. Delta Galil USA*, No. 1:14-cv-7289, 2015 WL 5724812 (S.D.N.Y. Sept. 29, 2015); *M.H. Segan L.P. v. Hasbro, Inc.*, 924 F. Supp. 512, 520–21 (S.D.N.Y. 1996).

22. *Boisson*, 273 F.3d at 272; *Knitwaves*, 71 F.3d at 1003. *City Merchandise Inc.*, 2009 U.S. Dist. LEXIS 5629, at *5.

23. *Horizon Comics*, 246 F. Supp. 3d at 941; *Buttner v. RD Palmer Enters., Inc.*, No. 5:13-CV-0342, 2015 WL 1472084 (N.D.N.Y. Mar. 31, 2015); *Hallford v. Fox Entm’t Grp. Inc.*, 2013 WL 541370 (S.D.N.Y. Feb. 13, 2013), *aff’d*, 556 F. App’x 48 (2d Cir. 2014); *Effie Film, LLC v. Murphy*, 564 F. App’x 631, 632–33 (2d Cir. 2014); *see* cases cited in note 22, *supra*.

24. *Boisson v. Banian, Ltd.*, 273 F.3d 262 (2d Cir. 2001).

25. *Id.* at 273.

show probative similarity between the two works.²⁶ Plaintiff will likely do that by means of expert testimony. Musicologists are likely to testify concerning the similarities or differences in the works and to give their opinion as to the likelihood that one was copied from the other. If the fact finder believes plaintiff's musicologist, then the fact finder must determine whether the two songs sound alike to the ordinary ear. But one must remember that the songs are both blues songs. They share certain characteristics with all blues songs, such as use of a twelve-bar phrase. The fact finder must not consider similarities common to all blues songs to determine whether the works are substantially similar. Rather, the fact finder must apply the more discerning ordinary observer test to decide whether, apart from the fact that the two songs are both blues songs, the songs sound alike.

[C] The Sliding Scale of Access and Probative Similarity

In *Jorgensen v. Epic/Sony Records*, the Second Circuit explained, “[t]here is an inverse ratio between access and probative similarity such that ‘the stronger the proof of similarity, the less the proof of access is required.’”^{26.1} At the far end of the spectrum is striking similarity.^{26.2} “[W]here the works in question are so strikingly similar as to preclude the possibility of independent creation, copying may be proven without a showing of access.”^{26.3}

A district court case goes further, suggesting that the converse also would apply. In *Tienshan, Inc. v. C.C.A. Int'l, Inc.*, the court wrote: “given that access has been conceded, the level of probative

26. As we discuss in section 1:2, courts often call probative similarity “substantial similarity,” causing confusion between the probative similarity inquiry and the inquiry as to whether the ordinary person will think that one work is like the other in its copyrightable aspects.

26.1. *Jorgensen v. Epic/Sony Records*, 351 F.3d 46, 56 (2d Cir. 2003) (quoting 4 M.&D. NIMMER, NIMMER ON COPYRIGHT § 13.03[D]). *Accord* *Glover v. Austin*, 289 F. App'x 430, 432 (2d Cir. 2008); *Gal v. Viacom Int'l, Inc.*, 518 F. Supp. 2d 526, 537 (S.D.N.Y. 2007); *A Slice of Pie Prods., LLC v. Wayans Bros. Entm't*, 487 F. Supp. 2d 41, 47 n.2 (S.D.N.Y. 2007); *Nicholls v. Tufenkian Imp./Exp. Ventures, Inc.*, 367 F. Supp. 2d 514, 522 (S.D.N.Y. 2005). *See also* *Positive Black Talk, Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 371–72 (5th Cir. 2004).

26.2. Discussed in section 1:3, *supra*.

26.3. *Jorgensen*, 351 F.3d at 56.

similarity necessary to show probative copying is diminished.”^{26.4} The Second Circuit rule concerning the sliding scale of access and probative similarity is in some ways similar to the Ninth Circuit’s inverse ratio rule, but differs as a result of the different infringement tests employed by the two circuits.^{26.5} In particular, in the Second Circuit strong evidence of access may weigh in favor of *probative* similarity but it is not relevant to proving *substantial* similarity.^{26.6} In the Ninth Circuit, the rule is not as clear.^{26.7}

[D] Summary Judgment, Motion to Dismiss, and Preliminary Injunction

In the Second Circuit, both the issue of copying and the issue of unlawful appropriation are fact issues for the jury.²⁷ Nevertheless, courts in the Second Circuit may determine those issues as a matter of law on a motion for summary judgment if the similarities between the two works are limited to noncopyrightable elements so that a finding of noninfringement is required,^{27.1} or if the evidence is so clear as to fall outside the range of reasonably disputed fact questions so that a reasonable juror, properly instructed, could find only one way.²⁸

26.4. *New Old Music Grp., Inc. v. Gottwald*, No. 13-CV-9013, 2015 WL 4719864 (S.D.N.Y. Aug. 7, 2015) (substantial similarity is generally a question of fact for a jury); *Tienshan, Inc. v. C.C.A. Int’l, Inc.*, 895 F. Supp. 651, 656 (S.D.N.Y. 1995).

26.5. See section 3:2.1[E], *infra*, for discussion of the inverse ratio rule in the Ninth Circuit.

26.6. *A Slice of Pie Prods., LLC v. Wayans Bros. Entm’t*, 487 F. Supp. 2d 41, 47 n.4 (S.D.N.Y. 2007).

26.7. See section 3:2.1[E].

27. *Arnstein v. Porter*, 154 F.2d 464, 469 (2d Cir. 1946). The question of whether defendant had access to plaintiff’s work also is a fact issue for the jury. *Id.*

27.1. *McDonald v. K-2 Indus., Inc.*, 108 F. Supp. 3d 135 (W.D.N.Y. 2015).

28. See *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132 (2d Cir. 1998) (summary judgment for plaintiff affirmed); *Warner Bros. v. Am. Broad. Cos.*, 720 F.2d 231, 245 (2d Cir. 1983) (court can determine noninfringement as a matter of law when no reasonable juror properly instructed could find the two works substantially similar); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 918 (2d Cir. 1980); *Klauber Bros. v. Target Corp.*, No. 14 Civ. 2125, 2015 WL 4393091 (S.D.N.Y. July 16, 2015); *Ward v. Barnes & Noble, Inc.*, 93 F. Supp. 3d 193 (S.D.N.Y. 2015); *New Old Music Grp.*, 2015 WL 4719864, at *11;

Courts must be wary of granting summary judgment when conflicting expert reports are presented, but parties cannot avoid summary judgment simply by submitting expert evidence, particularly when that evidence is both internally and externally inconsistent.^{28.1}

When the works are attached to the complaint or incorporated by reference, the rule in the Second Circuit is that a court may grant a Rule 12(b)(6) motion to dismiss based on comparison of the works at issue.^{28.2} The reasoning is that where the court's evaluation

Leary v. Manstan, 118 F. Supp. 3d 460 (D. Conn. 2015); Blakeman v. Walt Disney Co., 613 F. Supp. 2d 288, 305 n.4 (E.D.N.Y. 2009); Flaherty v. Filardi, 388 F. Supp. 2d 274, 286 (quoting *Warner Bros.*); Peker v. Masters Collection, 96 F. Supp. 2d 216 (E.D.N.Y. 2000) (summary judgment for plaintiff where no reasonable fact finder could find that defendant did not copy or that the works were not substantially similar); United Features Syndicate, Inc. v. Koons, 817 F. Supp. 370 (S.D.N.Y. 1993) (same).

- 28.1. Vargus v. Pfizer, Inc., No. 07-4085-CV, 2009 U.S. App. LEXIS 24263, at *3–4, Copyright L. Rep. (CCH) ¶ 29,831 (2d Cir. Nov. 5, 2009).
- 28.2. Peter F. Gaito Architecture, LLC v. Simone Dev. Corp., 602 F.3d 57, 63–64 (2d Cir. 2010); Klauber Bros. v. Bon-Ton Stores, Inc., 557 F. App'x 77, 78 (2d Cir. 2014); Gayle v. Home Box Office, Inc., No. 17-cv-5867, 2018 WL 2059657 (S.D.N.Y. May 1, 2018); Hayuk v. Starbucks Corp., 157 F. Supp. 3d 285 (S.D.N.Y. 2016), *reconsideration denied*, 2016 WL 5719785 (S.D.N.Y. Sept. 30, 2016), *appeal filed*, No. 16-3680 (2d Cir. Oct. 31, 2016); FC Online Mktg., Inc. v. Burke's Martial Arts, LLC, No. 14-CV-3685, 2015 WL 4162757 (E.D.N.Y. July 8, 2015) (noting that there is no requirement under Rule 8(a) of the Federal Rules of Procedure, or elsewhere, that the plaintiff attach the works in question to state an infringement claim). *See also* Dean v. Cameron, 53 F. Supp. 3d 641 (S.D.N.Y. 2014); Castorina v. Spike Cable Networks, Inc., 784 F. Supp. 2d 107 (E.D.N.Y. 2011); Canal+ Image UK Ltd. v. Lutvak, 773 F. Supp. 2d 419, 427 (S.D.N.Y. 2011); Telebrands Corp. v. Del Labs., Inc., 719 F. Supp. 2d 283, 295 (S.D.N.Y. 2010); Gottlieb Dev. LLC v. Paramount Pictures Corp., 590 F. Supp. 2d 625, 630 (S.D.N.Y. 2008); Le Book Publ'g, Inc. v. Black Book Photography, Inc., 418 F. Supp. 2d 305, 308–10 (S.D.N.Y. 2005); Gal v. Viacom Int'l, Inc., 403 F. Supp. 2d 294, 305 (S.D.N.Y. 2005); Bell v. Blaze Magazine, No. 99 Civ. 12342 (RCC), 2001 WL 262718 (S.D.N.Y. Mar. 16, 2001); Boyle v. Stephens, No. 97 Civ. 1351, 1998 WL 80175, at *4 (S.D.N.Y. Feb. 25, 1998); Buckman v. Citicorp, No. 95 Civ. 0773 (MBM), 1996 WL 34158, at *3 (S.D.N.Y. Jan. 30, 1996), *aff'd*, 101 F.3d 1393 (2d Cir. 1996); *accord* Nelson v. PRN Prods., Inc., 873 F.2d 1141, 1143–44 (8th Cir. 1989); Sweet v. City of Chicago, 953 F. Supp. 225, 230 (N.D. Ill. 1996); Cory Van Rijn, Inc. v. Cal. Raisin Advisory Bd., 697 F. Supp. 1136, 1138–39 (E.D. Cal. 1987).

of the works at issue reveals that no fact finder could conclude that the works are substantially similar, plaintiff cannot under any set of circumstances state a claim for copyright infringement.^{28.3} A motion to dismiss is likely to be granted when the claimant does not provide the court with the opportunity to compare the works at issue.^{28.4}

On a motion for a preliminary injunction, courts in the Second Circuit conduct the entirety of the inquiry discussed above to determine the movant’s likelihood of success, including by applying the ordinary or more discerning ordinary observer test to determine the likelihood that the works will be found substantially similar.²⁹

§ 3:1.2 First Circuit

First Circuit analysis of copyright infringement seems most like that of the Second Circuit, although First Circuit judges cite Ninth Circuit cases frequently. As in the Second Circuit, courts in the First Circuit determine whether there has been copying first.³⁰ Copying

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- 28.3. *Peter F. Gaito Architecture*, 602 F.3d at 64; *Rose v. Hewson*, No. 17-cv-1471, 2018 WL 626350 (S.D.N.Y. Jan. 30, 2018); *Perry v. Mary Ann Liebert, Inc.*, No. 17-cv-5600, 2018 WL 2561029 (S.D.N.Y. June 4, 2018) (comparison of flow charts illustrating a scientific discovery); *Green v. Harbach*, No. 17 Civ. 6984, 2018 WL 3350329 (S.D.N.Y. July 9, 2018); *McDonald v. West*, No. 14-cv-8794, 2015 WL 5751197 (S.D.N.Y. Sept. 30, 2015). *See also Blakeman*, 613 F. Supp. 2d at 298. *Cf. Solid Oak Sketches, LLC v. 2K Games, Inc.*, No. 16-cv-724, 2018 WL 1626145 (S.D.N.Y. Mar. 30, 2018) (denying motion for judgment on the pleadings).
- 28.4. *Diamond Collection, LLC v. Underwraps Costume Corp.*, No. 2:17-cv-00061, 2018 WL 1832928 (E.D.N.Y. Apr. 16, 2018).
29. *Laureyssens v. Idea Grp., Inc.*, 964 F.2d 131, 139–43 (2d Cir. 1992).
30. *Soc’y of the Holy Transfiguration Monastery, Inc. v. Gregory*, 689 F.3d 29, 48–49 (1st Cir. 2012), *cert. denied*, 133 S. Ct. 1315 (2013); *Coquico, Inc. v. Rodriguez-Miranda*, 562 F.3d 62, 66 (1st Cir. 2009); *T-Peg, Inc. v. Vt. Timber Works, Inc.*, 459 F.3d 97, 108 (1st Cir. 2006); *Johnson v. Gordon*, 409 F.3d 12, 18–24 (1st Cir. 2005); *Lotus Dev. Corp. v. Borland Int’l*, 49 F.3d 807, 813 (1st Cir. 1995), *aff’d*, 516 U.S. 233 (1996); *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 608 (1st Cir. 1988); *Nat’l Nonwovens, Inc. v. Consumer Prods. Enters., Inc.*, 397 F. Supp. 2d 245, 255 (D. Mass. 2005); *Yankee Candle Co. v. Bridgewater Candle Co.*, 99 F. Supp. 2d 140, 144 (D. Mass. 2000), *aff’d*, 259 F.3d 25 (1st Cir. 2001); *Skinder-Strauss Assocs. v. Mass. Continuing Legal Educ., Inc.*, 914 F. Supp. 665, 670–71 (D. Mass. 1995); *Flomerics Ltd. v. Fluid Dynamics Int’l, Inc.*, 880 F. Supp. 60, 62 (D. Mass. 1995); *Arvelo v. Am. Int’l Ins. Co.*, 875 F. Supp. 95, 99 (D.P.R.),

is shown, if not by direct evidence, by proof of access and probative (sometimes referred to as substantial) similarity.³¹ In assessing probative similarity, dissection and expert analysis are permitted.³² Once copying has been shown, the court then determines whether there has been actionable copying (unlawful appropriation) by determining whether the copying was extensive enough to make the works “substantially similar.”³³

The court makes the substantial similarity inquiry using the ordinary observer test.³⁴ As in the Second Circuit, to apply the ordinary observer test, the court asks whether the ordinary observer, unless he set out to detect the disparities between the works, would be disposed to overlook them and regard their aesthetic appeal as the same.³⁵ Or, phrased another way, “[t]he test is whether the accused

aff’d, 66 F.3d 306 (1st Cir.), *cert. denied*, 516 U.S. 1117 (1995); *Little Souls, Inc. v. Les Petits*, 789 F. Supp. 56, 57 (D. Mass. 1992). *See also* *TMTV, Corp. v. Mass Prods., Inc.*, 645 F.3d 464, 470 (1st Cir. 2011).

31. *Soc’y of the Holy Transfiguration*, 689 F.3d at 49; *T-Peg*, 459 F.3d at 111; *CMM Cable Rep, Inc. v. Ocean Coast Prods., Inc.*, 97 F.3d 1504, 1513 (1st Cir. 1996); *Lotus Dev. Corp.*, 49 F.3d at 813; *Concrete Mach.*, 843 F.2d at 606; *Flomerics Ltd.*, 880 F. Supp. at 62; *Arvelo*, 875 F. Supp. at 99; *Little Souls*, 789 F. Supp. at 57.
32. *Segrets, Inc. v. Gillman Knitwear Co.*, 207 F.3d 56, 66 n.11 (1st Cir. 2000); *Concrete Mach.*, 843 F.2d at 608; *Little Souls*, 789 F. Supp. at 58.
33. *Soc’y of the Holy Transfiguration*, 689 F.3d at 48–49; *Coquico*, 562 F.3d at 66; *T-Peg*, 459 F.3d at 108; *CMM Cable Rep*, 97 F.3d at 1513; *Lotus Dev. Corp.*, 49 F.3d at 813; *Concrete Mach.*, 843 F.2d at 608; *Nat’l Nonwovens*, 397 F. Supp. 2d at 255; *Yankee Candle*, 99 F. Supp. 2d at 144; *Skinder-Strauss Assocs.*, 914 F. Supp. at 670–71; *Flomerics*, 880 F. Supp. at 62; *Arvelo*, 875 F. Supp. at 99; *Little Souls*, 789 F. Supp. at 58. *See also* *TMTV*, 645 F.3d at 470.
34. *Greene v. Ablon*, 794 F.3d 133 (1st Cir. 2015); *Coquico*, 562 F.3d at 67; *Johnson*, 409 F.3d at 18; *Segrets*, 207 F.3d at 62; *Concrete Mach.*, 843 F.2d at 607; *Bos. Copyright Assocs., Ltd. v. U-Haul Int’l, Inc.*, No. 13-cv-12826, 2015 WL 666952 (D. Mass. Feb. 17, 2015); *Nat’l Nonwovens*, 397 F. Supp. 2d at 255; *Yankee Candle*, 99 F. Supp. 2d at 147; *Skinder-Strauss Assocs.*, 914 F. Supp. at 670–71; *Flomerics*, 880 F. Supp. at 62; *Little Souls*, 789 F. Supp. at 58.
35. *Johnson*, 409 F.3d at 18; *Concrete Mach.*, 843 F.2d at 607 (quoting *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960)); *K&M Int’l Inc. v. R.I. Novelty, Inc.*, No. 032017 RIDC, CA14-428S, 2017 WL 1052571 (D.R.I. Mar. 20, 2017); *Arvelo*, 875 F. Supp. at 100; *Little Souls*, 789 F. Supp. at 58.

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.”³⁶ The First Circuit generally does not permit expert testimony in connection with the ordinary observer test.³⁷

The First Circuit cautions that the sine qua non of the ordinary observer test is the overall similarities rather than the minute differences between two works; slight variations between works will not preclude a finding of infringement.³⁸ Although the First Circuit does not expressly refer to the “more discerning ordinary observer test,” where there is copying of both protectable and unprotectable expression, courts in the First Circuit filter out the unprotectable elements and evaluate only similarities between protected expression.³⁹ The dissection analysis is performed by the court as a matter of law.^{39.1} The jury is to be instructed on the unprotectable elements of plaintiff’s work and told that it cannot consider those elements in evaluating substantial similarity.^{39.2}

The First Circuit evaluates infringement on a sliding scale.⁴⁰ When there is only one way to express an idea, merger bars any claim of infringement.⁴¹ “When the idea and its expression are not

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- 36. *Segrets*, 207 F.3d at 62; *CMM Cable Rep.*, 97 F.3d at 1513; *Yankee Candle*, 99 F. Supp. 2d at 147; *Skinder-Strauss Assocs.*, 914 F. Supp. at 670–71; *Little Souls*, 789 F. Supp. at 58.
 - 37. *Segrets*, 207 F.3d at 66 n.11; *Concrete Mach.*, 843 F.2d at 608; *Little Souls*, 789 F. Supp. at 58.
 - 38. *Concrete Mach.*, 843 F.2d at 608.
 - 39. *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 179 (1st Cir. 2013); *Soc’y of the Holy Transfiguration Monastery, Inc. v. Gregory*, 689 F.3d 29, 50 (1st Cir. 2012), *cert. denied*, 133 S. Ct. 1315 (2013); *Coquico*, 562 F.3d at 68; *Yankee Candle*, 99 F. Supp. 2d at 147 (“It is important to recall that the substantial similarity and ordinary observer tests only apply to those elements in the copyrighted work that are protectible.”). *See also CMM Cable Rep.*, 97 F.3d at 1515; *Concrete Mach.*, 843 F.2d at 608, 611.
 - 39.1. *Harney*, 704 F.3d at 179; *Bos. Copyright Assocs., Ltd. v. U-Haul Int’l, Inc.*, No. 13-cv-12826, 2015 WL 666952 (D. Mass. Feb. 17, 2015) (dissection performed on motion to dismiss).
 - 39.2. *Harney*, 704 F.3d at 179 n.6.
 - 40. *Concrete Mach.*, 843 F.2d at 607. *LovePop, Inc. v. PaperPopCards, Inc.*, 286 F. Supp. 3d 283 (D. Mass. 2018).
 - 41. *Concrete Mach.*, 843 F.2d at 606; *LovePop, Inc.*, 286 F. Supp. 3d at 290 (The works at issue in the case are reproduced in Appendix A.2.J.).

completely inseparable, there may still be only a limited number of ways of expressing the idea. In such a case, the burden of proof is heavy on the plaintiff who may need to show ‘near identity’ between the works at issue.⁴² Where the work embodies only one of an infinite variety of ways of expressing an idea, broader protection is given and the plaintiff need not show duplication or near identity to establish infringement.⁴³

[A] Summary Judgment, Motion to Dismiss, and Preliminary Injunction

Courts in the First Circuit apply the ordinary observer test to determine substantial similarity in the summary judgment, motion to dismiss,^{43.1} and preliminary injunction contexts.⁴⁴ Courts grant summary judgment for the defendant “only where the only finding that could be reached by a fact finder, correctly applying the applicable legal standard, is that there is no substantial similarity between the two works.”⁴⁵ The dissimilarity of the works at issue must be “readily apparent” for the court to grant summary judgment for the defendant.⁴⁶ “When there is no possibility that a reasonable person

42. *Concrete Mach.*, 843 F.2d at 606–07; *Yankee Candle*, 99 F. Supp. 2d at 150; *LovePop Inc.*, 286 F. Supp. 3d at 290.

43. *Concrete Mach.*, 843 F.2d at 607; *LovePop, Inc.*, 286 F. Supp. 3d at 289.

43.1. *Lorenzana v. S. Am. Rest. Corp.*, 799 F.3d 31, 34 (1st Cir. 2015) (“For a claim alleging a violation of the Copyright Act to proceed past infancy, the ‘complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.’”); *LovePop, Inc.*, 286 F. Supp. 3d at 287.

44. *See T-Peg, Inc. v. Vt. Timber Works, Inc.*, 459 F.3d 97, 112 (1st Cir. 2006); *Segrets*, 207 F.3d at 62; *Concrete Mach.*, 843 F.2d at 611; *O’Neill v. Dell Publ’g Co.*, 630 F.2d 685, 687 (1st Cir. 1980); *Bos. Copyright Assocs., Ltd. v. U-Haul Int’l, Inc.*, No. 13-cv-12826, 2015 WL 666952, at *3 (D. Mass. Feb. 17, 2015); *Flomerics Ltd. v. Fluid Dynamics Int’l, Inc.*, 880 F. Supp. 60, 62 (D. Mass. 1995).

45. *T-Peg*, 459 F.3d at 112; *O’Neill*, 630 F.2d at 687; *Ivy Media Corp. v. ILIKEBUS, Inc.*, 252 F. Supp. 3d 34, 38–41 (D. Mass. 2017) (granting defendant’s motion addressed to one copyright and denying it with respect to another); *Skinder-Strauss Assocs. v. Mass. Continuing Legal Educ., Inc.*, 914 F. Supp. 665, 678 (D. Mass. 1995).

46. *Skinder-Strauss Assocs.*, 914 F. Supp. at 679. *See also Well-Made Toy Mfg. Corp. v. Flowers, Inc.*, No. 16-CV-1380, 2016 WL 6537673 (E.D.N.Y. Nov. 3, 2016) (photographs of 3D dolls at issue insufficient

could find any similarity between the two works, summary judgment is appropriate.”⁴⁷

§ 3:1.3 Third Circuit

Generally, the Third Circuit evaluates substantial similarity as the Second Circuit does.⁴⁸ The plaintiff must prove both that the defendant copied the protected work and that there is substantial similarity between the two works.⁴⁹ If there is no direct evidence of copying, copying may be shown by proving access and substantial similarity.⁵⁰ Thus, as in some other courts, the term “substantial similarity” has had two meanings in the Third Circuit.⁵¹ “[S]ubstantial similarity to show that the original work has been copied is not the same as substantial similarity to prove infringement [unlawful appropriation].”⁵² Now the circuit has expressed a preference for the term “probative similarity” in addressing the issue of copying.^{52.1}

to permit a conclusive determination of substantial similarity on motion to dismiss).

47. *Arvelo v. Am. Int’l Ins. Co.*, 875 F. Supp. 95, 100 (D.P.R.), *aff’d*, 66 F.3d 306 (1st Cir.), *cert. denied*, 516 U.S. 1117 (1995). *See also* *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 180, 183 (1st Cir. 2013); *LovePop, Inc.*, 286 F. Supp. 3d at 290 (motion to dismiss granted).
48. *See* *Tanksley v. Daniels*, 902 F.3d 164 (3d Cir. 2018), *cert. denied*, 2019 WL 659816 (U.S. Feb. 19, 2019) (No. 18-701); *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 207–08 (3d Cir. 2005); *Dam Things from Denmark v. Russ Berrie & Co.*, 290 F.3d 548, 562 (3d Cir. 2002).
49. *Kay Berry*, 421 F.3d at 207–08; *Dam Things from Denmark*, 290 F.3d at 562; *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975); *Schiffer Publ’g Ltd. v. Chronicle Books, LLC*, 73 U.S.P.Q.2d 1090, 1098 (E.D. Pa. 2004).
50. *Kay Berry*, 421 F.3d at 208; *Dam Things from Denmark*, 290 F.3d at 562; *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 290 (3d Cir.), *cert. denied*, 502 U.S. 939 (1991); *Franklin Mint Corp. v. Nat’l Wildlife Art Exch., Inc.*, 575 F.2d 62, 64 (3d Cir.), *cert. denied*, 439 U.S. 880 (1978); *CMM Cable Rep, Inc. v. Keymarket Commc’ns, Inc.*, 870 F. Supp. 631, 637 (M.D. Pa. 1994).
51. *Kay Berry*, 421 F.3d at 208; *Dam Things from Denmark*, 290 F.3d at 562; *Universal Athletic Sales*, 511 F.2d at 907. *See* our discussion of the distinction between similarities probative of copying and similarities probative of unlawful appropriation in section 1:2.
52. *See* cases cited in note 51, *supra*.
- 52.1. *Tanksley*, 902 F.3d at 173 (“[W]e prefer the term ‘probative similarity’ in the copying context while reserving ‘substantial similarity’ for the question of material appropriation.”).

As in the Second Circuit, substantial similarity that proves copying (probative similarity) means that there is sufficient similarity between the two works in question to conclude that the accused infringer used the copyrighted work in making his work.⁵³ Substantial similarity that proves unlawful appropriation means that the accused infringer took a significant portion of the independent work of the copyright owner that is entitled to the statutory protection.⁵⁴

Probative similarity to prove copying may be shown by expert testimony, dissection, and analysis of the works' parts.⁵⁵ Substantial similarity to prove unlawful appropriation is determined strictly by the reaction of the ordinary lay observer; the fact finder decides whether an ordinary lay observer would detect substantial similarity between the works.⁵⁶ At least one district court has held that the proper way for the court to conduct the ordinary observer comparison is by viewing the works side by side.⁵⁷ Both substantial similarity tests must be satisfied for there to be infringement.⁵⁸ In *Universal Athletic Sales Co. v. Salkeld*,⁵⁹ the Third Circuit vacated and reversed the district court award of summary judgment to the plaintiff because the district court applied only the first test, the test for copying, and failed to apply the test for unlawful appropriation.⁶⁰

To evaluate unlawful appropriation the court must concentrate on the gross features of the works rather than the minutiae, because the ordinary observer is unlikely to study such minutiae.⁶¹ The court

53. *Dam Things from Denmark*, 290 F.3d at 562; *Ford Motor Co.*, 930 F.2d at 290.

54. See cases cited in note 53, *supra*.

55. *Dam Things from Denmark*, 290 F.3d at 562; *Universal Athletic Sales*, 511 F.2d at 907.

56. *Dam Things from Denmark*, 290 F.3d at 562; *Syngy, Inc. v. ZS Assocs., Inc.*, No. 07-3536, 2015 WL 899408 (E.D. Pa. Mar. 3, 2015); *CMM Cable Rep.*, 870 F. Supp. at 637.

57. *Value Grp., Inc. v. Mendham Lake Estates, L.P.*, 800 F. Supp. 1228, 1233 (D.N.J. 1992).

58. *Dam Things from Denmark*, 290 F.3d at 562.

59. *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975).

60. *Id.*

61. See *id.* (the more the court is led into the finer points, the less likely it is to stand upon the firmer, if more naïve, ground of its considered impressions after its own perusal); *Value Group*, 800 F. Supp. at 1233.

must also consider both the amount of creativity and originality involved in plaintiff's work and the nature of the protected material and the setting in which it appears.⁶² The Third Circuit uses a sliding scale. If the quantum of originality in plaintiff's work is very modest, more substantial similarity is required for there to be infringement.⁶³

Generally, more similarity is required to prove infringement of commercial documents than to prove infringement of artistic works.⁶⁴ In *Ford Motor Co. v. Summit Motor Products, Inc.*, however, the court held that a Ford advertising graphic of a "ghosted" GT was entitled to be treated as an artistic work, as opposed to a purely commercial work, because it was highly creative and because it was a graphic design created by a graphic design company rather than a photograph.⁶⁵

Even with respect to artistic works there are degrees of protection. The copyright in an impressionist painting is "stronger" than that in a painting intended to portray a bird precisely as it appears in nature.⁶⁶

The fact that there are dissimilarities between the works does not mean there cannot be infringement. "[I]nfringement may be found where the similarity relates to a matter which constitutes a substantial portion of plaintiff's work—i.e., a matter which is of value to plaintiffs."⁶⁷ On the other hand, "the existence of some common features in the face of overwhelming differences between the works is insufficient to show substantial similarity."⁶⁸

Although sometimes Third Circuit courts use the terms "extrinsic" and "intrinsic" rather than "probative similarity" and "unlawful

62. *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 290 (3d Cir.), *cert. denied*, 502 U.S. 939 (1991); *Universal Athletic Sales*, 511 F.2d at 907; *CMM Cable Rep*, 870 F. Supp. at 636.

63. *Ford Motor Co.*, 930 F.2d at 290; *Universal Athletic Sales*, 511 F.2d at 907; *TD Bank, N.A. v. Hill*, No. 12-7188, 2015 WL 4523570 (D.N.J. July 27, 2015).

64. See cases cited in note 63, *supra*; *Nat'l Risk Mgmt., Inc. v. Bramwell*, 819 F. Supp. 417, 427 (E.D. Pa. 1993).

65. *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 294 (3d Cir.), *cert. denied*, 502 U.S. 939 (1991).

66. *Franklin Mint Corp. v. Nat'l Wildlife Art Exch., Inc.*, 575 F.2d 62, 65 (3d Cir.), *cert. denied*, 439 U.S. 880 (1978).

67. *CMM Cable Rep*, 870 F. Supp. at 638.

68. *Segal v. Paramount Pictures*, 841 F. Supp. 146 (E.D. Pa. 1993), *aff'd*, 37 F.3d 1488 (3d Cir. 1994).

appropriation,” the Third Circuit does not apply the extrinsic/intrinsic tests used by the Ninth Circuit.⁶⁹ When the Third Circuit uses the term “extrinsic,” it means “copying,” and when it uses “intrinsic,” it means unlawful appropriation.⁷⁰ In *Ford Motor Co. v. Summit Motor Products, Inc.*, the court explained that, in the Third Circuit,

“[s]ubstantial similarity” can be broken down into two tests, both of which must be met. The first, termed the “extrinsic test,” is “whether there is sufficient similarity between the two works in question to conclude that the alleged infringer used the copyrighted work in making his own.” In making this determination, expert testimony and a visual comparison between the copyrighted work and the allegedly infringing work are frequently utilized. A second test of “substantial similarity,” called the “intrinsic test,” is whether, from a lay perspective, the copying was an unlawful appropriation of the copyrighted work. “Unlawful appropriation” has been defined as “a taking of the independent work of the copyright owner which is entitled to the statutory protection.”⁷¹

[A] Summary Judgment, Motion to Dismiss, and Preliminary Injunction

When deciding a motion to dismiss or for summary judgment, the court evaluates substantial similarity by making a side-by-side comparison of the works through the eyes of a layman.⁷² Similarly,

69. See *Dam Things from Denmark*, 290 F.3d at 562. We discuss the Ninth Circuit test in section 3:2.1.

70. *Id.*

71. *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 291 (3d Cir.) (citations omitted), *cert. denied*, 502 U.S. 939 (1991).

72. *Tanksley v. Daniels*, 902 F.3d 164, 165 (3d Cir. 2018), *cert. denied*, 2019 WL 659816 (U.S. Feb. 19, 2019) (No. 18-701); *Universal Athletic Sales*, 511 F.2d at 908 (summary judgment); *Winstead v. Jackson*, 509 F. App'x 139 (3d Cir. 2013) (motion to dismiss); *Nicassio v. Viacom Int'l, Inc.*, 309 F. Supp. 3d 381 (W.D. Pa. 2018) (motion to dismiss granted), *appeal docketed*, No. 18-2085 (3d Cir. May 16, 2018); *Maule v. Anheuser Busch, LLC*, No. 17-00461, 2018 WL 3608934 (E.D. Pa. July 27, 2018) (motion to dismiss); *Tanikumi v. Walt Disney Co.*, No. 14-5877, 2015 WL 716429 (D.N.J. Feb. 19, 2015) (motion to dismiss), *aff'd*, 616 F. App'x 515 (3d Cir. 2015). *But see Mainard v. Prudential Ins. Co.*, Civil Action No. 08-3605, 2009 U.S. Dist. LEXIS 6935, at *13–17 (E.D. Pa. Jan. 30, 2009) (declining to compare works on motion to dismiss).

on a motion for a preliminary injunction, the court considers similarities between the works as part of its evaluation of the movant's likelihood of success and makes the comparison by examining the works as they would appear to the layman viewing them side by side.⁷³

[B] Special Test for Complex Subjects Including Computer Programs

In *Whelan Assocs. v. Jaslow Dental Laboratory*,⁷⁴ the Third Circuit held that the ordinary observer test should not be applied in cases where the subjects of copyright are particularly complex, such as computer programs. The court reasoned that “[t]he ordinary observer test, which was developed in cases involving novels, plays, and paintings, and which does not permit expert testimony, is of doubtful value in cases involving computer programs on account of the programs’ complexity and unfamiliarity to most members of the public.”⁷⁵ Instead, in cases where the material at issue is difficult to understand, the Third Circuit permits a single substantial similarity inquiry. Both lay and expert testimony are admissible in connection with that inquiry, and the court makes only one finding of substantial similarity based on the totality of the evidence.⁷⁶ We have not seen a case other than a computer case in which a court in the Third Circuit has used that special test.

§ 3:1.4 Fifth Circuit

Courts in the Fifth Circuit use a substantial similarity inquiry similar to that used by courts in the Second Circuit.⁷⁷ Fifth Circuit courts make the same distinction between probative and substantial similarity: access plus probative similarity leads to the inference of

73. *Value Grp., Inc. v. Mendham Lake Estates, L.P.*, 800 F. Supp. 1228, 1233 (D.N.J. 1992).

74. *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1231–32 (3d Cir. 1986).

75. *Id.* at 1232.

76. *Id.* at 1233.

77. *See Positive Black Talk, Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 367–68 (5th Cir. 2004); *Gen. Universal Sys., Inc. v. Lee*, 379 F.3d 131, 141–42 (5th Cir. 2004); *Bridgmon v. Array Sys. Corp.*, 325 F.3d 572, 576–77 (5th Cir. 2003).

copying; copying plus substantial similarity equals infringement.⁷⁸ Courts in the Fifth Circuit have not, however, expressly adopted the Second Circuit's sliding scale of access and probative similarity.^{78.1} In the Fifth Circuit, "[t]o determine whether an instance of copying is legally actionable, a side by side comparison must be made between the original and the copy to determine whether a layman would view the two works as 'substantially similar.'"⁷⁹ The Fifth Circuit mandates a side-by-side comparison of the works. If a plaintiff cannot or does not produce the works for side-by-side comparison, he cannot prevail.⁸⁰ Lower courts in other circuits frequently use that procedure^{80.1} but it is mandated by only two other circuit courts, the Eleventh and Seventh.⁸¹

Whether the layman would find such substantial similarity is judged by the same standard used in the Second Circuit, namely whether the ordinary observer, unless he set out to detect the differences between the two works, would be disposed to overlook them and regard their aesthetic appeal as the same.⁸² Under the Fifth

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78. *Positive Black Talk*, 394 F.3d at 367–68; *Gen. Universal Sys., Inc.*, 379 F.3d at 142; *Peel & Co. v. Rug Mkt.*, 238 F.3d 391, 395 (5th Cir. 2001); *Comput. Mgmt. Assistance Co. v. Robert F. DeCastro, Inc.*, 220 F.3d 396 (5th Cir. 2000); *Eng'g Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1341 (5th Cir. 1994). Striking similarity also allows the inference without evidence of access. *Ferguson v. Nat'l Broad. Co.*, 584 F.2d 111, 113–14 (5th Cir. 1978).
- 78.1. *Guzman v. Hacienda Records & Recording Studio, Inc.*, 808 F.3d 1031 (5th Cir. 2015) (citing *Positive Black Talk*, *supra*). The sliding scale is discussed in section 3:1.1[C], *supra*.
79. *Aspen Tech., Inc. v. M3 Tech., Inc.*, 569 F. App'x 259, 269 (5th Cir. 2014); *Gen. Universal Sys.*, 379 F.3d at 142; *Peel & Co.*, 238 F.3d at 395; *Creations Unlimited, Inc. v. McCain*, 112 F.3d 814, 816 (5th Cir. 1997).
80. *Gen. Universal Sys.*, 379 F.3d at 146–47; *Bridgmon*, 325 F.3d at 577; *King v. Ames*, 179 F.3d 370, 376 (5th Cir. 1999); *cf.* *Parker v. Outdoor Channel Holdings*, No. 2-11-CV-00159-J, 2012 U.S. Dist. LEXIS 175879 (N.D. Tex. Dec. 12, 2012) (not necessary to view all episodes of television programs when overall format is at issue).
- 80.1. *E.g.*, *Gal v. Viacom Int'l, Inc.*, 518 F. Supp. 2d 526, 543 (S.D.N.Y. 2007).
81. *See* sections 3:1.5 and 3:4, *infra*.
82. *Gen. Universal Sys.*, 379 F.3d at 142; *Peel & Co.*, 1999 U.S. Dist. LEXIS 14632 (E.D. La. 1999), *aff'd*, 238 F.3d 391 (5th Cir. 2001). *But see Positive Black Talk*, 394 F.3d at 373–74 (approving jury instruction requiring jury to evaluate works from perspective of intended audience).

Circuit test, “the layman must detect the piracy without any aid or suggestion or critical analysis by others. The reaction of the public to the matter should be spontaneous and immediate.”⁸³

Where the plaintiff’s work contains protectable and unprotectable elements, courts in the Fifth Circuit, like courts in the Second Circuit, have used the more discerning ordinary observer test.⁸⁴ However, the Fifth Circuit has described its approach as a filtration test, similar to the approach of the test it adopted for computer program analysis: “abstraction-filtration-comparison.”^{84.1}

[A] Summary Judgment, Motion to Dismiss, and Preliminary Injunction

In the Fifth Circuit, as in the Second, a motion for summary judgment should be denied and the substantial similarity inquiry should be made by the fact finder so long as reasonable minds could differ as to whether the works are similar,^{84.2} but the court may enter summary judgment if no reasonable juror could find the works substantially similar or there is substantial similarity as a matter of law.⁸⁵ District courts in the Fifth Circuit have ruled that a court may make that analysis on a motion to dismiss.^{85.1} On a motion for a

83. *Peel & Co.*, 238 F.3d at 395.

84. *Galiano v. Harrah’s Operating Co.*, 2000 U.S. Dist. LEXIS 17258 (E.D. La. Nov. 21, 2000); *R. Ready Prods., Inc. v. Cantrell*, 85 F. Supp. 2d 672 (S.D. Tex. 2000).

84.1. *Nola Spice Designs, LLC v. Haydel Enters., Inc.*, 783 F.3d 527, 550 (5th Cir. 2015); *DaVinci Editrice S.R.L. v. ZiKo Games, LLC*, 183 F. Supp. 3d 820, 829 (S.D. Tex. 2016).

84.2. *CSI Litig. Psychology, LLC v. DecisionQuest, Inc.*, No. 3:16-cv3255, 2018 WL 488728 (N.D. Tex. Jan. 19, 2018).

85. *Nola Spice Designs*, 783 F.3d at 553; *Gen. Universal Sys.*, 379 F.3d at 142; *Peel & Co.*, 238 F.3d at 395; *Creations Unlimited*, 112 F.3d at 816; *S. Credentialing Support Servs., LLC v. Hammond Surgical Hosp. LLC*, No. 15-7013, 2018 WL 1287493 (E.D. La. Mar. 13, 2018) (granting summary judgment of infringement); *Schurr v. Molacek*, No. 15-7135, 2016 WL 6680287 (E.D. La. Nov. 14, 2016), *appeal filed*, No. 16-31231 (5th Cir. Dec. 14, 2016); *R. Ready Prods.*, 85 F. Supp. 2d 672.

85.1. *Schumacher Homes of La., Inc. v. R.E. Washington Constr. LLC*, No. 2:16-CV-00423, 2016 WL 5415083 (W.D. La. Sept. 27, 2016); *Randolph v. Dimension Films*, 630 F. Supp. 2d 741, 746, and 634 F. Supp. 2d 779, 788 (S.D. Tex. 2009) (granting defendant’s motion to dismiss and stating that “substantial similarity may often be decided as a matter of law, on a motion to dismiss or on summary judgment”),

preliminary injunction, in order to determine likelihood of success, the court seeks to determine whether the ordinary observer would be likely to find the works substantially similar.⁸⁶

§ 3:1.5 Seventh Circuit

Seventh Circuit substantial similarity doctrine is similar to that of the Second Circuit and the Fifth Circuit.⁸⁷ Like courts in those circuits, courts in the Seventh Circuit make a distinction between probative similarity, similarity that proves copying, and substantial similarity, similarity that proves unlawful appropriation.⁸⁸ To test for infringement, Seventh Circuit courts use the formula that access plus probative similarity equals copying, while copying plus substantial similarity equals infringement.⁸⁹

aff'd, 381 F. App'x 449 (5th Cir.), *cert. denied*, 562 U.S. 1062 (2010); *Vallery v. Am. Girl Dolls*, 2015 WL 1539253, at *2 (E.D. La. Apr. 6, 2015) (denying motion to amend complaint) (“In copyright cases, the asserted and accused works are ‘central’ to the infringement claim and thus may be considered.”). *But see* *Batiste v. Lewis*, No. 17-4435, 2018 WL 2268173 (E.D. La. May 17, 2018) (refusing to compare works and denying motion because a court is not a fact finder).

86. *Morgan Fabrics Corp. v. Acacia Design, Inc.*, No. 1:14-CV-234, 2015 WL 5918069, at *4 (N.D. Miss. Oct. 9, 2015) (“[T]wo works are substantially similar if a layman would detect piracy ‘without any aid or critical analysis by others. The reaction of the public to the matters should be spontaneous and immediate.’”); *Worlds of Wonder, Inc. v. Veritel Learning Sys.*, 658 F. Supp. 351, 355 (N.D. Tex. 1986).
87. *See* *Wildlife Express Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502 (7th Cir. 1994); *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614–15 (7th Cir.), 459 U.S. 880 (1982). *But see* *Franciscatti v. Germanotta*, 111 U.S.P.Q.2d 1360 (N.D. Ill. June 17, 2014) (concluding that there is confusion about the proper test in the circuit and applying Ninth Circuit extrinsic-intrinsic analysis aided by expert testimony because the accused song was computer-generated); *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1358–61 (N.D. Ill. 1989) (applying modified version of Ninth Circuit extrinsic/intrinsic test).
88. *Wildlife Express Corp.*, 18 F.3d at 508; *Atari*, 672 F.2d at 614; *Duncanson v. Wine & Canvas IP Holdings LLC*, No. 1:16-cv-00788, 2018 WL 4699888, at *10 (S.D. Ind. Sept. 30, 2018); *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 284 F. Supp. 2d 1069, 1080 (N.D. Ill. 2003); *S.A.M. Elecs., Inc. v. Osarapasop*, 39 F. Supp. 2d 1074, 1081–82 (N.D. Ill. 1999); *FASA Corp. v. Playmates Toys, Inc.*, 912 F. Supp. 1124, 1127–29 (N.D. Ill. 1996).
89. *See* cases cited in note 88, *supra*.

Courts in the Seventh Circuit test for substantial similarity by means of the ordinary observer test. “[T]he test is whether the accused work is so similar to the plaintiff’s work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff’s protectible expression by taking material of substance and value.”⁹⁰

Seventh Circuit courts conduct the ordinary observer test by making a side-by-side comparison of the works.⁹¹ Expert testimony ordinarily is not admissible with respect to that inquiry, but the court may consider expert testimony, in accordance with Rule 702 of the Federal Rules of Evidence, where the expert’s technical expertise will aid the fact finder.⁹²

“Although numerous differences may influence the impressions of the ordinary observer, slight differences between a protected work and an accused work will not preclude a finding of infringement where the works are substantially similar in other respects.”⁹³ The court of appeals has explained that the sine qua non of the ordinary observer test is the overall similarities rather than the minute differences between the two works.⁹⁴ On the other hand, Seventh Circuit courts can consider dissimilarities in comparing the two works; “numerous differences tend to undercut the likelihood of substantial similarity and are thus relevant considerations.”⁹⁵

Where the plaintiff’s work involves both protectable and unprotectable elements, courts in the Seventh Circuit, like courts in the Second Circuit, must determine whether the similarities between the works involve plaintiff’s protected expression as opposed to

90. *Atari*, 672 F.2d at 614; *Wildlife Express Corp.*, 18 F.3d at 508–09. *See also* *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 939 (7th Cir. 1989), *cert. denied*, 493 U.S. 1075 (1990) (quoting *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960)).

91. *Wildlife Express Corp.*, 18 F.3d at 506 n.1, 510; *Silver Streak Indus., LLC v. Squire Boone Caverns, Inc.*, No. 4:13-cv-00173, 2015 WL 3884605, at *2 (S.D. Ind. June 24, 2015).

92. *See Francescatti*, 111 U.S.P.Q.2d 1360; *Ty, Inc. v. GMA Accessories, Inc.*, 959 F. Supp. 936, 942 (N.D. Ill. 1997).

93. *Atari*, 672 F.2d at 618.

94. *Id.*

95. *Sanford v. CBS, Inc.*, 594 F. Supp. 711, 717 (N.D. Ill. 1984). *See also* *Culver Franchising Sys., Inc. v. Steak N Shake, Inc.*, No. 16C72, 2016 WL 4158957, at *4 (N.D. Ill. Aug. 5, 2016); *Scott v. WKJG, Inc.*, 376 F.2d 467, 469 (7th Cir.), *cert. denied*, 389 U.S. 832 (1967).

unprotectable elements.⁹⁶ Although we have not seen a Seventh Circuit case calling this the “more discerning ordinary observer test” as it is named in the Second Circuit, the comparison seems to be the same as in the Second Circuit: an ordinary observer’s view of the similarity between the two works without considering the elements that are not protected by copyright.⁹⁷

Seventh Circuit case law differs from that of many other circuits in that the Seventh Circuit has held that there is a range of protection for copyrighted works similar to the range of protection for trademarks in trademark law. Where idea and expression are indistinguishable in plaintiff’s work, plaintiff’s work is weak and protected only from identical copying or very close paraphrasing. As the work embodies more in the way of particularized expression, it becomes stronger and receives broader copyright protection.⁹⁸ The other circuits that have sanctioned this trademark-law-type range of protection are the First and Third Circuits.⁹⁹

The Seventh Circuit has hinted that it might accept the Fourth Circuit’s intended audience test.¹⁰⁰ In *Atari, Inc. v. North American Philips Consumer Electronics Corp.*, the court held that

[t]o assess the impact of certain differences, one factor to consider is the nature of the protected material and the setting in which it appears. Video games, unlike an artist’s painting or even other audiovisual works, appeal to an audience that is fairly indiscriminating insofar as their concern about more subtle differences in artistic expression A person who is entranced by the play of the game “would be disposed to overlook” many of the [two games’] minor differences in detail and regard their aesthetic appeal as the same.¹⁰¹

96. *Pampered Chef, Ltd. v. Magic Kitchen, Inc.*, 12 F. Supp. 2d 785, 791–92 (N.D. Ill. 1998); *Theotokatos v. Sara Lee Pers. Prods.*, 971 F. Supp. 332, 341 (N.D. Ill. 1997).

97. See cases cited in note 96, *supra*.

98. *Atari*, 672 F.2d at 616–17; *Pampered Chef*, 12 F. Supp. 2d at 791–92; *N. Am. Bear Co. v. Carson Pirie Scott & Co.*, 1991 U.S. Dist. LEXIS 17350 (N.D. Ill. Nov. 26, 1991).

99. We discuss the First Circuit test for substantial similarity in section 3:1.2. We discuss the Third Circuit test in section 3:1.3.

100. Discussed in section 3:2.2, *infra*.

101. *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 619 (7th Cir. 1982).

[A] The Role of Access and the Inverse Ratio Rule

The Seventh Circuit has not completely endorsed the inverse ratio rule that is employed in the Ninth Circuit.^{101.1} In *Peters v. West*,^{101.2} the court explained that it had “occasionally endorsed something that comes close to this inverse approach . . . in both *Selle* and *GMA Accessories*, we noted that evidence that two works are very similar can suggest that the alleged infringer had access to the original.”^{101.3} But, the court added, it has “never endorsed the other side of the inverse relation: the idea that a ‘high degree of access’ justifies a ‘lower standard of proof’ for similarity.”^{101.4} The reason, the court explained, is that access merely establishes an opportunity to copy and that is different from a showing of similarity sufficient to establish actual copying.

[B] Summary Judgment, Motion to Dismiss, and Preliminary Injunction

Courts in the Seventh Circuit may enter summary judgment for the defendant or dismiss a complaint when no reasonable juror using the criteria discussed above could find that the two works are substantially similar,¹⁰² and for the plaintiff when no reasonable

101.1. See section 3:2.1[E].

101.2. *Peters v. West*, 692 F.3d 629, 634 (7th Cir. 2012).

101.3. *Id.* (citing *Selle v. Gibb*, 741 F.2d 896, 903 n.4 (7th Cir. 1984) and *Ty, Inc. v. GMA Accessories, Inc.*, 132 F.3d 1167, 1170 (7th Cir. 1997)).

101.4. *Id.* at 635.

102. See *Weller v. Flynn*, 312 F. Supp. 3d 706 (N.D. Ill. 2018) (motion to dismiss granted); *ABRO Indus., Inc. v. NEW Trade, Inc.*, No.14-cv-1984-TLS, 2017 WL 4954698 (N.D. Ind. Oct. 30, 2017) (granting summary judgment dismissing claims); *Am. Med. Assoc. v. 3Lions Publ'g, Inc.*, No. 14 C 5280, 2015 WL 6701773 (N.D. Ill. Nov. 2, 2015) (judgment on the pleadings); *Silver Streak Indus., LLC v. Squire Boone Caverns, Inc.*, No. 4:13-cv-00173, 2015 WL 3884605 (S.D. Ind. June 24, 2015) (summary judgment denied); *Design Basics LLC v. J & V Roberts Invs., Inc.*, No. 14-CV-1083, 2015 WL 5315680 (E.D. Wis. Sept. 11, 2015) (summary judgment denied); *Sissom v. Snow*, 110 U.S.P.Q.2d 1673 (S.D. Ind. 2014); see also *Brownmark Films, LLC v. Comedy Partners*, 682 F.3d 687 (7th Cir. 2012) (comparing works to determine fair use); *Kolody v. Simon Mktg., Inc.*, 1998 U.S. Dist. LEXIS 14229, at *30 (N.D. Ill. Sept. 2, 1998); *N. Am. Bear*, 1991 U.S. Dist. LEXIS 17350.

juror could find that they are not.¹⁰³ On a motion for a preliminary injunction, the court undertakes the entirety of the analysis discussed above and compares the works through the eyes of the ordinary observer to determine likelihood of success.¹⁰⁴ Courts in the Seventh Circuit have held that a court may examine the works on a motion to dismiss.^{104.1}

§ 3:2 Extrinsic/Intrinsic Test

§ 3:2.1 Ninth Circuit

[A] Origin of the Extrinsic/Intrinsic Test

The Ninth Circuit created a two-part substantial similarity test in *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*¹⁰⁵ In *Krofft*, the court affirmed a judgment that McDonald's McDonaldland commercials infringed Sid & Marty Krofft Television Productions' *H.R. Pufnstuf* children's television show. As explained in *Krofft*, the first part of the substantial similarity test is called the extrinsic test.¹⁰⁶ "It is extrinsic because it depends not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed."¹⁰⁷ For works of visual art, for example, "[s]uch criteria include the type of artwork involved, the materials used, the subject matter and the setting for the subject."¹⁰⁸ In the extrinsic test, the court lists and compares the ideas involved in each work to

103. *Duncanson v. Wine & Canvas IP Holdings LLC*, No. 1:16-cv-00788, 2018 WL 4699888 (S.D. Ind. Sept. 30, 2018) (summary judgment of substantial similarity granted between certain paintings and denied between others); *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 50 F. Supp. 2d 863, 870–71 (W.D. Wis. 1998).

104. *Hobbs v. John*, 722 F.3d 1089, 1094 (7th Cir. 2013); *Atari*, 672 F.2d at 614–20; *Culver Franchising Sys., Inc. v. Steak N Shake, Inc.*, No. 16C72, 2016 WL 4158957, at *8 (N.D. Ill. Aug. 5, 2016).

104.1. *Weller*, 312 F. Supp. 3d at 712; *Sissom*, 110 U.S.P.Q.2d 1673; *see also TopstepTrader, LLC v. OneUp Trader, LLC*, No. 17-cv-4412, 2018 WL 1859040 (N.D. Ill. Apr. 18, 2018); *Skyline Design, Inc. v. McGrory Glass, Inc.*, No. 1:12-cv-10198, 2014 WL 258564 (N.D. Ill. Jan. 23, 2014).

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

106. *Id.* at 1164.

107. *Id.*

108. *Id.*

determine if the ideas are substantially similar.¹⁰⁹ Expert testimony is admissible to assist in this listing and comparison.¹¹⁰

To illustrate the way one should compare ideas using the extrinsic test, the *Krofft* court gave the example of a statue of a nude. The idea of a nude statue as defined by the court was “a plaster recreation of the nude human figure.” According to the *Krofft* court, “a statue of a horse or a painting of a nude would not embody this idea and therefore could not infringe [under the extrinsic test].”¹¹¹ Applying the extrinsic test to the works at issue in *Krofft*, the Ninth Circuit found that “[d]efendants do not dispute the fact that they copied the idea of plaintiffs’ Pufnstuf television series—basically a fantasyland filled with diverse and fanciful characters in action. . . .” Thus the court found that the extrinsic test favored the plaintiff.¹¹²

Under *Krofft*, if the extrinsic test reveals similarities in ideas, the court proceeds to the second half of the analysis, the intrinsic test.¹¹³ The intrinsic test involves a purely subjective evaluation of whether the total concept and feel of the two works are substantially similar—depending on the response of the ordinary reasonable person.¹¹⁴ Expert evidence is not considered in applying the intrinsic test.¹¹⁵ The fact finder simply reviews the works and makes a subjective decision as to whether they seem to be substantially similar overall.

The *Krofft* court cited the Second Circuit’s decision in *Arnstein v. Porter*¹¹⁶ as the source of the extrinsic/intrinsic test.¹¹⁷ In *Arnstein*, the Second Circuit required that plaintiffs prove both (1) copying and (2) illicit copying (that is, unlawful appropriation) to establish infringement.¹¹⁸ The Ninth Circuit reasoned that “when the court in *Arnstein* refers to copying which is not itself an infringement, it must be suggesting copying merely of the work’s idea, which is

109. *Id.*

110. *Id.* See also *Antonick v. Elec. Arts, Inc.*, 841 F.3d 1062, 1067 (9th Cir. 2016); *Swirsky v. Carey*, 376 F.3d 841 (9th Cir. 2004).

111. *Sid & Marty Krofft Television Prods.*, 562 F.2d at 1165.

112. *Id.*

113. *Id.* at 1164.

114. *Id.*

115. *Id.* Accord *Antonick*, 841 F.3d at 1067.

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

117. *Sid & Marty Krofft Television Prods.*, 562 F.2d at 1164–65.

118. The Second Circuit continues to adhere to that test. We discuss the Second Circuit test in section 3:1.

not protected by copyright. To constitute an infringement the copying must reach the point of ‘unlawful appropriation’ or the copying of protected expression itself.”¹¹⁹ As we discuss in section 3:1, the Second Circuit itself has not read *Arnstein* quite that way. It is the different interpretations of *Arnstein* that are the root of the differences between the Ninth Circuit test and the Second Circuit test.

[B] Evolution of the Extrinsic/Intrinsic Test

Thirteen years after *Krofft*, the Ninth Circuit sanctioned a modification of the extrinsic/intrinsic test in *Shaw v. Lindheim*.¹²⁰ Recognizing that district courts within the Ninth Circuit were not limiting the extrinsic test inquiry strictly to a comparison of ideas, the *Shaw* court held that the extrinsic part of the test could properly be described as an “objective analysis of expression.”¹²¹ According to *Shaw*, rather than striving to compare the ideas of the two works, courts must list the elements of the works and determine whether there is any similarity in the expression of those elements.¹²² For example, with respect to literary works, the elements are plot, themes, dialogue, mood, setting, pace, sequence of events, and characters.¹²³ For works of visual art, the criteria include shapes, colors, and arrangements of the representations in addition to the type of artwork involved, the materials used, the subject matter, and the setting for the subject.¹²⁴ “In analyzing musical compositions under the extrinsic test, there is no uniform set of factors to be used; music is composed of a large array of elements, including idea, lyrics, rhythm, pitch, tempo, melody, harmony, structure, chord progressions, dissonance, and new technological sounds, and some combination of those elements is protectable by copyright.”^{124.1}

Shaw also clarified that the intrinsic test is really “subjective analysis of expression.” The court recognized that the subjective

119. *Sid & Marty Krofft Television Prods.*, 562 F.2d at 1165.

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

121. *Id.* at 1357. *See also* *Antonick v. Elec. Arts, Inc.*, 841 F.3d 1062, 1065–66 (9th Cir. 2016); *Benay v. Warner Bros. Entm’t*, 607 F.3d 620, 624 (9th Cir. 2010); *Swirsky v. Carey*, 376 F.3d 841, 845 (9th Cir. 2004).

122. *Shaw*, 919 F.2d at 1362.

123. *Id.* *Accord* *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1174, 1176–77 (9th Cir. 2003).

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

124.1. *Goldberg v. Cameron*, 787 F. Supp. 2d 1013, 1021 (N.D. Cal. 2011) (citing *Swirsky v. Carey*, 376 F.2d 841, 845 (9th Cir. 2004)).

analysis of expression is no more than the visceral reaction of the lay observer, and as such is “virtually devoid of analysis.”¹²⁵

[C] Analytic Dissection As Part of the Extrinsic Test

As part of the extrinsic test, the court engages in “analytic dissection” for purposes of determining the scope of plaintiff’s copyright, that is, what is protected and what is not.¹²⁶ Analytic dissection involves breaking down works into their constituent parts to determine whether similarities between the works are attributable to unprotectable elements (such as idea/expression merger, public domain, *scènes à faire*, etc.).¹²⁷ Analytic dissection is similar to the abstraction/filtration portion of the abstraction/filtration/comparison analysis conducted in computer cases.¹²⁸ Because similarities in elements that are not protectable cannot count in plaintiff’s favor in the infringement analysis, they are filtered out in the extrinsic analysis and not considered as part of the intrinsic analysis.¹²⁹

In *Rentmeester v. Nike, Inc.*,^{129.1} the Ninth Circuit explained it this way:

The extrinsic test assesses the objective similarities of the two works, focusing only on the protectable elements of the

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- 125. *Shaw*, 919 F.2d at 1357. See *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1118 (9th Cir. Feb. 27, 2018) (intrinsic test requires a more holistic, subjective comparison of the works to determine whether they are substantially similar in “total concept and feel”).
 - 126. *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 636 n.6 (9th Cir. 2008); *Swirsky v. Carey*, 376 F.3d 841, 845 (9th Cir. 2004); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1398 (9th Cir.), *cert. dismissed*, 521 U.S. 1146 (1997); *Smith v. Jackson*, 84 F.3d 1213, 1218 (9th Cir. 1996); *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1475–76 (9th Cir.), *cert. denied*, 506 U.S. 869 (1992); *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987); *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1165 (9th Cir. 1977).
 - 127. *Mattel, Inc. v. MGA Entm’t, Inc.*, 616 F.3d 904, 913 (9th Cir. 2010). See also cases cited in note 126, *supra*.
 - 128. See our discussion of computer cases in chapter 8.
 - 129. *Dr. Seuss Enters., L.P.*, 109 F.3d at 1398; *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184 (1995); *Rentmeester v. Nike, Inc.*, No. 3:15-cv-00113, 2015 WL 3766546, at *3 (D. Or. June 15, 2015); *Chase-Riboud v. Dreamworks, Inc.*, 987 F. Supp. 1222, 1226 (C.D. Cal. 1997). See also the authorities cited in note 159.1, *infra*.
 - 129.1. *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1118 (9th Cir. 2018).

plaintiff's expression. *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002). Before that comparison can be made, the court must “filter out” the unprotectable elements of the plaintiff's work—primarily ideas and concepts, material in the public domain, and *scènes à faire* (stock or standard features that are commonly associated with the treatment of a given subject). *Id.* at 822–23. The protectable elements that remain are then compared to corresponding elements of the defendant's work to assess similarities in the objective details of the works.

One must remember, however, that as we discuss in chapter 13, the selection, coordination and arrangement of individually unprotected items may be copyrightable. Thus, even if individual elements are unprotected, a plaintiff may satisfy the extrinsic test if the court finds the combination of those elements sufficiently creative. For example, in *Metcalf v. Bochco*,¹³⁰ the court held that even though the elements common to both plaintiff's screenplay and defendant's television series were not individually copyrightable, Metcalf passed the extrinsic test because his combination of unprotectable items was copyrightable.

[D] Intermediate Steps Between *Krofft* and *Shaw*

The evolution of the Ninth Circuit test from its original form in *Krofft* (1977) to its modification in *Shaw* (1990) caused confusion in the Ninth Circuit and other circuits that look to the Ninth Circuit for guidance on copyright matters, and still is the source of uncertainty. In the 1980s, two widely cited Ninth Circuit decisions anticipated *Shaw* without abandoning *Krofft*. In *Litchfield v. Spielberg* (1984),¹³¹ the Ninth Circuit described the extrinsic test as follows: “Similarity of ideas may be shown by an extrinsic test which focuses on the alleged similarities in the objective details of the works.”¹³² That definition is a hybrid of *Krofft* and *Shaw*. It adheres

130. *Metcalf v. Bochco*, 294 F.3d 1069 (9th Cir. 2002); *cf.* *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124, 1137–38 (C.D. Cal. 2007) (“Many courts have been reluctant to expand this concept beyond the clear-cut case presented in *Metcalf*.”). See our discussion of unscripted works in chapter 6.

131. *Litchfield v. Spielberg*, 736 F.2d 1352 (9th Cir. 1984), *cert. denied*, 470 U.S. 1052 (1985).

132. *Id.* at 1356.

to the *Krofft* mandate to compare ideas in the extrinsic test, but suggests that the court compare not the works' ideas themselves, but rather their "objective details" as later required by *Shaw*. The Ninth Circuit repeated that explanation of the extrinsic test in 1987 in *McCulloch v. Albert E. Price, Inc.*¹³³ As we discuss later in this chapter, several other circuits, including the Fourth and the Eighth, read those 1980s cases and adopted that transitional statement of the test, rather than the full *Shaw* revision.¹³⁴

[E] The Role of Access and the Inverse Ratio Rule

Courts in the Ninth Circuit weigh plaintiff's proof of access in order to assess how similar the works need to be for them to be substantially similar.¹³⁵ The greater the proof of access, the less similar the works need be.¹³⁶ This is the so-called Inverse Ratio Rule.¹³⁷ To obtain the benefit of the Inverse Ratio Rule, plaintiff must offer proof of access greater than, or more compelling than that offered in the typical case.^{137.1} Courts have not precisely defined, however, how much less the showing of similarity need be.^{137.2}

133. *McCulloch v. Albert E. Price, Inc.*, 823 F.2d 316, 319 (9th Cir. 1987). The Ninth Circuit repeated the mantra once after *Shaw*, in *Pasillas v. McDonald's Corp.*, 927 F.2d 440, 441 (9th Cir. 1991).

134. See sections 3:2.2 and 3:2.3.

135. *Swirsky v. Carey*, 376 F.3d 841, 844–45 (9th Cir. 2004); *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1178 (9th Cir. 2003); *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 2000); *Smith v. Jackson*, 84 F.3d 1213, 1218 (9th Cir. 1996); *Shaw v. Lindheim*, 919 F.2d 1353, 1362 (9th Cir. 1990); *Bernal v. Paradigm Talent & Literary Agency*, 788 F. Supp. 2d 1043, 1052–53 (C.D. Cal. 2010).

136. See cases cited in note 135, *supra*. See also *Metcalf v. Bochco*, 294 F.3d 1069, 1075 (9th Cir. 2002) (plaintiff's case strengthened by defendant's admission of access).

137. *Benay v. Warner Bros. Entm't*, 607 F.3d 620, 625 (9th Cir. 2010); *Swirsky*, 376 F.3d at 844–45 (9th Cir. 2004); *Rice*, 330 F.2d at 1178; *Three Boys Music*, 212 F.3d at 485; *Smith*, 84 F.3d at 1218 n.5; *Shaw*, 919 F.2d at 1361. Courts in the Second Circuit apply a sliding scale requirement with respect to access and probative similarity that is similar to the Ninth Circuit's inverse ratio rule. See section 3:1.1.

137.1. *Gable v. NBC*, 727 F. Supp. 2d 815, 823 (C.D. Cal. 2010) (quoting *Idema v. Dreamworks, Inc.*, 162 F. Supp. 2d 1129, 1176 (C.D. Cal. 2001)), *aff'd*, 438 F. App'x 587 (9th Cir. 2011).

137.2. *Id.* at 824 n.3.

The converse, however, may not apply: The Ninth Circuit has not held that a weak showing of access requires a stronger showing of substantial similarity.¹³⁸ Access is considered as part of the extrinsic test.¹³⁹ The Inverse Ratio Rule also is part of the extrinsic test.^{139.1} The Inverse Ratio Rule will not save an infringement claim where there are no similarities; “no amount of proof of access will suffice to show copying if there are no similarities.”^{139.2}

Cases in the Ninth Circuit historically have identified the inverse ratio rule as applying in the context of determining “substantial similarity,” without specifying whether the rule only affects a plaintiff’s burden of proving copying or to the ultimate burden of proving “unlawful appropriation,” that is, copying a sufficient amount of copyright-protected elements.^{139.3} It seems that in some cases, the Ninth Circuit has applied it to both.^{139.4}

In *Rentmeester v. Nike, Inc.*,^{139.5} the Ninth Circuit stated that the inverse ratio rule applies only to proof of copying, and not to proof of unlawful appropriation. The court explained:

138. *Three Boys Music*, 212 F.3d at 486; *Bernal*, 788 F. Supp. 2d at 1053 n.4; *Gable*, 727 F. Supp. 2d at 823 n.2. *But see* *Rentmeester v. Nike, Inc.*, 883 F. 3d 1111, 1124 (9th Cir. 2018) (“The more compelling the similarities supporting an inference of copying, the less compelling the evidence of access need be.”).

139. *Smith*, 84 F.3d at 1220; *Shaw*, 919 F.2d at 1361.

139.1. *Bensbargains.Net, LLC v. Xpbargains.Com*, No. 06cv1445 BTM, 2007 WL 2385092, at *3 (S.D. Cal. Aug. 16, 2007) (“The inverse ratio rule applies to the issue of copying as a factual matter. . .”).

139.2. *Funky Films, Inc. v. Time Warner Entm’t Co.*, 462 F.3d 1072, 1081 (9th Cir. 2006) (quoting *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1172 (9th Cir. 1977)); *Shame on You Prods., Inc. v. Banks*, No. CV 14-03512, 2015 WL 4885221, at *16 (C.D. Cal. Aug. 14, 2015).

139.3. See David Aronoff, *Exploding the “Inverse Ratio Rule,”* 55 J. COPYRIGHT SOC’Y U.S.A. 125, 136 (2008) and cases cited in this section. This may be a function of the fact that “[u]nfortunately, we have used the same term—“substantial similarity”—to describe both the degree of similarity relevant to proof of copying and the degree of similarity necessary to establish unlawful appropriation.” *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1117 (9th Cir. 2018). See our discussion of this problem in section 1:2.

139.4. Aronoff, *supra* note 139.3.

139.5. *Rentmeester v. Nike, Inc.*, 883 F.3d 1111 (9th Cir. 2018).

Under the inverse ratio rule, we require a lower standard of proof of substantial similarity when a high degree of access is shown. That rule does not help *Rentmeester* because it assists only in proving copying, not in proving unlawful appropriation, the only element at issue in this case. Recall from our earlier discussion that a plaintiff who lacks direct evidence of copying can attempt to prove that fact circumstantially by showing that the defendant had access to the plaintiff's work and that the two works share similarities probative of copying. The inverse ratio rule provides that the stronger the evidence of access, the less compelling the similarities between the two works need be in order to give rise to an inference of copying. On the flip side, the more compelling the similarities supporting an inference of copying, the less compelling the evidence of access need be. Indeed, if the similarities are "striking" enough—that is, highly unlikely to have been the product of independent creation—such similarities can be sufficient on their own to establish that the defendant must have had access to the plaintiff's work. But again, after proving that the defendant's work is the product of copying rather than independent creation, the plaintiff must still show copying of protected expression that amounts to unlawful appropriation. The showing of substantial similarity necessary to prove unlawful appropriation does not vary with the degree of access the plaintiff has shown. The substantial similarity standard represents copyright law's attempt "to strike a delicate balance between the protection to which authors are entitled under an act of Congress and the freedom that exists for all others to create their works outside the area protected against infringement." That balance does not shift depending on how strong the plaintiff's proof of access may be.^{139.6}

The *Rentmeester* analysis represents the better view,^{139.7} is closer to the Second Circuit's sliding scale rule,^{139.8} and might have clarified the rule for future cases. Unfortunately, the court seems to

139.6. *Id.* at 1124–25 (citation omitted). *Accord* *Skidmore v. Led Zeppelin*, 905 F.3d 1116, 1130 (9th Cir. 2018); *Cline v. Reetz-Laiolo*, 329 F. Supp. 3d 1000, 1037 (N.D. Cal. 2018); *Zindel v. Fox Searchlight Pictures, Inc.*, No. cv18-1435, 2018 WL 3601842 (C.D. Cal. Jul. 23, 2018), *appeal docketed*, No. 18-56087 (9th Cir. Aug. 13, 2018).

139.7. *See Skidmore*, 905 F. 3d at 1130.

139.8. *See* our discussion of the Second Circuit's sliding scale of probative similarity and access in section 3:1.1[C].

have backslid less than a month later in *Williams v. Gaye*.^{139.9} In *Williams*, the court (a different panel) wrote:

Absent direct evidence of copying, proof of infringement involves fact-based showings that the defendant had access to the plaintiff's work and that the two works are substantially similar. Access and substantial similarity are inextricably linked. We adhere to the "inverse ratio rule," which operates like a sliding scale: The greater the showing of access, the lesser the showing of substantial similarity is required. *Williams* and *Thicke* readily admitted at trial that they had a high degree of access to "Got To Give It Up." The *Gayes'* burden of proof of substantial similarity is lowered accordingly.^{139.10}

[F] Summary Judgment Under the Extrinsic/ Intrinsic Test

Although a number of Ninth Circuit opinions state that summary judgment is not favored on the issue of substantial similarity,^{139.11} it has been granted when the court concludes that no reasonable juror could find otherwise.^{139.12} However, the proper Ninth Circuit approach has not always been clear.

In *Shaw*, the Ninth Circuit held that the outcome of the extrinsic test may be decided on summary judgment but the outcome of the intrinsic test is a question of fact to be determined by the trier of fact, and not by the court on summary judgment.¹⁴⁰ Thus, according

139.9. *Williams v. Gaye*, No. 15-56880, 2018 WL 1403577 (9th Cir. Mar. 21, 2018).

139.10. *Id.*, 2018 WL 1403577, at *5. *But see Cline*, 329 F. Supp. 3d at 10037 (following the *Rentmeester* analysis).

139.11. *E.g.*, *Unicolors, Inc. v. Urban Outfitters, Inc.*, 833 F. 3d 980, 985 (9th Cir. 2017) ("Because 'substantial similarity' is usually an extremely close issue of fact . . . summary judgment has been disfavored in cases involving intellectual property.") (quoting *Litchfield*, 736 F.2d at 1365); *Standard Fabrics Int'l Inc. v. Dress Barn Inc.*, No. 2:15-cv-08437-ODW(PJW), 2017 WL 240072, at *4 (C.D. Cal. Jan. 19, 2017); *Amusement Art LLC v. Life is Beautiful, LLC*, No. 2-14-CV-08290, 2016 WL 6998566, at *10 (C.D. Cal. Nov. 29, 2016) (citing authorities).

139.12. *E.g.*, *Experian Info. Sols., Inc. v. Nationwide Mktg. Servs., Inc.*, 893 F.3d 1176 (9th Cir. 2018).

140. *Shaw*, 919 F.2d at 1359; *see also Act Grp., Inc. v. Hamlin*, No. CV-12-567-PHX, 2014 WL 1285857 (D. Ariz. Mar. 28, 2014). *Contra See v. Durang*, 711 F.2d 141, 142–43 (9th Cir. 1983).

to *Shaw*, if the extrinsic test favors the defendant, summary judgment should be entered in defendant’s favor.¹⁴¹ But if the extrinsic test favors the plaintiff, there must be a trial on the intrinsic test.¹⁴²

Since *Shaw*, courts in the Ninth Circuit have struggled with *Shaw*’s summary judgment dogma. The Ninth Circuit itself remains unclear as to whether *Shaw*’s teaching that only the extrinsic test should be considered on a motion for summary judgment applies only to literary works, or to all works.¹⁴³ In *Pasillas v. McDonald’s Corp.*,¹⁴⁴ for example, the Ninth Circuit affirmed summary judgment that the mask on the McDonald’s Mac Tonight “man-in-the-moon” character did not infringe plaintiff’s man-in-the-moon mask. The court held that *Shaw*’s proscription against granting summary judgment on the intrinsic test was limited to literary works, and that summary judgment is properly granted on the intrinsic test where the similarities between the two works relate solely to expression that is not protected by copyright.¹⁴⁵

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141. *Id.*; *Rice*, 330 F.3d at 1180; *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994); *Kreative Power, LLC v. Monoprice, Inc.*, No. 14-cv-02991, 2015 WL 971387, at *11 (N.D. Cal. Mar. 3, 2015).
142. *Smith*, 84 F.3d at 1218; *Kouf*, 16 F.3d at 1045; *Shaw*, 919 F.2d at 1358; *Corbello v. Devito*, No. 2:08-cv-00867, 2015 WL 5768531, at *9 (D. Nev. Sept. 30, 2015); *Reno-Tahoe Specialty, Inc. v. Mungchi, Inc.*, No. 2:12-cv-01051, 2014 WL 553181, at *8 (D. Nev. Feb. 10, 2014) (“summary judgment in favor of a copyright plaintiff is not available on the substantial similarity issue”). *But see* *Teller v. Dogge*, 8 F. Supp. 3d 1228 (D. Nev. 2014) (granting summary judgment in favor of plaintiff without discussion of the Ninth Circuit rule).
143. *See Cavalier v. Random House, Inc.*, 297 F.3d 815, 826 (9th Cir. 2002) (comparing cases and concluding that it is unclear whether the *Shaw* rule applies in cases involving illustrations).
144. *Pasillas v. McDonald’s Corp.*, 927 F.2d 440 (9th Cir. 1991).
145. *Id.* at 442. For the latter proposition, the *Pasillas* court relied on *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987), a pre-*Shaw* case involving alleged infringement of dinosaur stuffed animals, in which the Ninth Circuit held that “[a]lthough even unprotectable material should be considered when determining if there is substantial similarity of expression . . . no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas.” The *Aliotti* court affirmed summary judgment on the basis that although the works were similar under the extrinsic test, analytic dissection of the elements common to both stuffed dinosaurs revealed that the similarities

Applying the *Krofft* test rather than the *Shaw* revision of that test, the *Pasillas* court held that McDonald's conceded that plaintiff satisfied the extrinsic test when McDonald's admitted that "its mask and the *Pasillas* mask share the same idea, that of a mask depicting the man on the moon." Accordingly, the court reviewed only the district court's intrinsic test analysis.¹⁴⁶

The Ninth Circuit approved the district court's intrinsic analysis, ruling that the district court properly identified four basic similarities between the works: the crescent moon shape, the depiction of a human face in the center of the crescent, the white or off-white color, and the design enabling the mask to be worn over the person's head; that the district court properly used analytic dissection as part of the intrinsic test and correctly held that *Pasillas* could not rely on the aforementioned standard elements to satisfy the intrinsic test; and that apart from the standard elements the masks looked different overall. The Ninth Circuit affirmed summary judgment because "no reasonable jury could conclude that the two masks are substantially similar in protectable expression."¹⁴⁷ Thus, the *Pasillas* court affirmed just the type of decision seemingly prohibited by *Shaw*.¹⁴⁸

The Ninth Circuit reversed course a year later in a computer software case, *Brown Bag Software v. Symantec Corp.*¹⁴⁹ In that case, the court

- (1) declined to limit *Shaw* to literary works;
- (2) ruled that analytic dissection to determine the scope of plaintiff's copyright was properly considered as part of the extrinsic test, not the intrinsic test as the *Pasillas* court had done; and

involved only elements that were common either to dinosaurs or to stuffed animals, and therefore the parties' stuffed dinosaurs were not similar under the intrinsic test. The earlier decided *Aliotti* is at odds both with the *Shaw* mandate that summary judgment not be granted on the intrinsic test, and with the *Shaw* court's holding that analytic dissection is not appropriate under the intrinsic test. In fact, the *Aliotti* opinion states that "it is appropriate under *Krofft*'s intrinsic test to perform analytic dissection of similarities."

146. *Id.*

147. *Id.* at 443.

148. *Accord Aliotti*, 831 F.2d at 901 (analytic dissection part of intrinsic analysis).

149. *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465 (9th Cir.), *cert. denied*, 506 U.S. 869 (1992).

- (3) held that if analytic dissection undertaken as part of the extrinsic test revealed an absence of copyrightable elements, summary judgment was appropriate.¹⁵⁰

By moving analytic dissection to the extrinsic test, *Brown Bag* seems to reconcile *Pasillas* and *Aliotti* with *Shaw*.

Next, in *Kouf v. Walt Disney Pictures & Television*, a case in which plaintiff claimed that Disney’s *Honey I Shrunk the Kids* infringed his screenplay, the Ninth Circuit once again flatly stated: “For summary judgment, only the extrinsic test is important. A plaintiff avoids summary judgment by satisfying the extrinsic test which makes similarity of the works a triable issue of fact. . . . In contrast, a plaintiff who cannot satisfy the extrinsic test necessarily loses on summary judgment, because a jury may not find substantial similarity without evidence on both the extrinsic and intrinsic tests.”¹⁵¹

The Ninth Circuit appears to have settled on the standard articulated in *Kouf*. The court repeated the *Kouf* statement of the summary judgment rule two years later in a music case, *Smith v. Jackson*,¹⁵² and again in 2002 in a case involving alleged infringement of a screenplay by a television series, *Metcalf v. Bochco*.¹⁵³ The court repeated the *Kouf* statement in another music case, *Swirsky v. Carey*,¹⁵⁴ and then in two more screenplay cases, *Funky Films, Inc. v. Time Warner Entertainment Co.*^{154.1} in 2006, and *Benay v.*

150. *Id.* at 1475–77.

151. *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994); *see also* *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 584 F. App’x 653, 656 (9th Cir. 2014) (extrinsic test “is required by our precedent”).

152. *Smith v. Jackson*, 84 F.3d 1213, 1218 (9th Cir. 1996).

153. *Metcalf v. Bochco*, 294 F.3d 1069, 1073 (9th Cir. 2002). *Accord* *Scott-Blanton v. Universal City Studios Prods., LLLP*, 539 F. Supp. 2d 191 (D.D.C. 2008), *aff’d*, 308 F. App’x 452 (D.C. Cir. 2009) (motion picture *Brokeback Mountain* not substantially similar to novel *My Husband Is on the Down Low and I Know About It*).

154. *Swirsky v. Carey*, 376 F.3d 841 (9th Cir. 2004). *See also* *Fabric Selection, Inc. v. NNW Imp., Inc.*, No. 2:16-cv-06558, 2018 WL 1116529 (C.D. Cal. Feb. 26, 2018) (relying on *Swirsky* in concluding that the extrinsic test requires both analytical dissection and expert testimony); *Hoffman v. Impact Confections, Inc.*, 544 F. Supp. 2d 1121 (S.D. Cal. 2008) (citing and applying *Swirsky* in a packaging artwork case).

154.1. *Funky Films, Inc. v. Time Warner Entm’t Co.*, 462 F.3d 1072 (9th Cir. 2006). *See also* *Bach v. Forever Living Prods. U.S., Inc.*, 473 F. Supp. 2d 1127, 1138 (W.D. Wash. 2007).

Warner Bros. Entertainment, Inc.^{154.2} in 2010. In 2008, a district court proceeded with intrinsic analysis and denied summary judgment for the copyright owner only after evaluating the total concept and feel of the similarities.^{154.3} The Ninth Circuit has since ruled that on a summary judgment motion it is error for a court to apply the subjective, fact-oriented test.^{154.4} Nevertheless, at least one later district court case applied the intrinsic test and granted summary judgment for the plaintiff.^{154.5} The Ninth Circuit has carved out an exception when the copying involves copying of the entire copyrighted work. In that instance, a two-part test to determine substantial similarity becomes unnecessary.^{154.6}

The Ninth Circuit summarized the current rule and the exception governing motions for summary judgment as follows in *Unicolors v. Urban Outfitters*:

[I]f the court concludes that there are sufficient articulable objective similarities between the two works for plaintiffs to meet the extrinsic test, it is inappropriate for the court to then make a subjective determination that the works, nevertheless, are not substantially similar in their total concept and feel. In other words, once the objective threshold is met, it is the role of the jury to make a nuanced subjective determination under the intrinsic test . . .

However, . . . w]here the extrinsic similarity is so strong that the works are near duplicates save for superficial differences, the court may properly conclude that no reasonable jury could find that the works are not substantially similar in their overall concept and feel. In such a case, the court need not delve into

154.2. *Benay v. Warner Bros. Entm't, Inc.*, 607 F.3d 620, 624 (9th Cir. 2010).

154.3. *HIT Entm't, Inc. v. Nat'l Disc. Costume Co.*, 552 F. Supp. 2d 1099 (S.D. Cal. 2008). The costumes at issue in the case are reproduced in Appendix A.12.B.

154.4. *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 852 (9th Cir. 2012); *Scentsy, Inc. v. Harmony Brands LLC*, 585 F. App'x 621 (9th Cir. 2014); *see also Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1370 (Fed. Cir. 2006) (applying Ninth Circuit law); *8th Wonder Entm't, LLC v. Viacom Int'l, Inc.*, No. 2:14-CV-01748, 2016 WL 6882832, at *4 (C.D. Cal. Nov. 22, 2016).

154.5. *Standard Fabrics Int'l Inc. v. Dress Barn Inc.*, No. 2:15-cv-08437, 2017 WL 240072 (C.D. Cal. Jan. 19, 2017). Photographs of the fabrics at issue in the case are reproduced in Appendix A.9.Q.

154.6. *DC Comics v. Towle*, 802 F.3d 1012, 1026 (9th Cir. 2015).

a complex subjective analysis of the works to assess substantial similarity and does not risk supplanting the jury’s subjective interpretation with its own

We conclude that a district court may grant summary judgment for plaintiffs on the issue of copying when the works are so overwhelmingly similar that the possibility of independent creation is precluded.^{154.7}

[G] Preliminary Injunctions Under the Ninth Circuit Test

Courts in the Ninth Circuit do consider the intrinsic test on a motion for a preliminary injunction.¹⁵⁵ To evaluate substantial similarity on a preliminary injunction motion, the court proceeds just as it would at trial (without the jury). The court applies the extrinsic test, and then, if plaintiff passes that test, considers whether an ordinary person would be likely to consider the works substantially similar.¹⁵⁶

154.7. *Unicolors, Inc. v. Urban Outfitters, Inc.*, 853 F.3d 980, 986–87 (9th Cir. 2017) (finding striking similarity). The fabrics at issue in the case are reproduced in Appendix A.9.N. *See also* *Gray v. Perry*, No. 2:15-cv-05642, 2018 WL 3954008 (C.D. Cal. Aug. 13, 2018) (summary judgment denied); *Gracing, Inc. v. E.K. Blue, Inc.*, CV 16-5107, 2017 WL 5640516 (C.D. Cal. June 28, 2017) (finding striking similarity) (The fabrics at issue in the case are reproduced in Appendix A.9.P.); *Standard Fabrics Int’l, Inc. v. Dress Barn, Inc.*, No 2:15-cv-08437, 2017 WL 240072 (C.D. Cal. Jan. 19, 2017) (finding striking similarity) (The fabrics at issue in the case are reproduced in Appendix A.9.Q.); *Origami Owl, LLC v. Mayo*, No. CV-15-00110, 2017 WL 413075 (D. Ariz. Jan. 31, 2017).

155. *Columbia Pictures Indus., Inc. v. Miramax Films Corp.*, 11 F. Supp. 2d 1179, 1184 n.3 (C.D. Cal. 1998).

156. *Id.* at 1185; *Television Educ. Inc. v. Contractors Intelligence Sch., Inc.*, No. 2:16-cv-1433, 2017 WL 2958729 (E.D. Cal. July 11, 2017); *Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co.*, 900 F. Supp. 1287, 1299 (C.D. Cal. 1995). *See also* *Kimbell v. Rock*, Case No. CV09-7249 DSF (Ex), 2009 U.S. Dist. LEXIS 97052, at *7 n.2 (C.D. Cal. Oct. 8, 2009) (on motion for temporary restraining order) (“Because the Court finds Plaintiff failed to establish the requisite likelihood of success on the extrinsic component, it need not address the intrinsic component, which ultimately must be decided by a jury.”). The storylines at issue in the case are reproduced in Appendix A.3.B.

[H] Difficulties in Applying the Extrinsic/Intrinsic Test

The Ninth Circuit explains the current mechanics of the extrinsic/intrinsic test as follows:

As originally adopted in [*Krofft*], the extrinsic prong was a test for similarity of ideas based on external criteria; analytic dissection and expert testimony could be used, if helpful. The intrinsic prong was a test for similarity of expression from the standpoint of the ordinary reasonable observer, with no expert assistance. . . . As it has evolved, however, the extrinsic test now objectively considers whether there are substantial similarities in *both* ideas and expression, whereas the intrinsic test continues to measure expression subjectively.^{156.1}

The test is not always easy to understand and may be difficult to apply. The Ninth Circuit concedes as much. The court itself has described the extrinsic test as “turbid waters.”¹⁵⁷ In *Swirsky v. Carey*, the court wrote:

The application of the extrinsic test, which assesses substantial similarity of ideas and expression, to musical compositions is a somewhat unnatural task, guided by relatively little precedent . . . The extrinsic test provides an awkward framework to apply to copyrighted works like music or art objects, which lack distinct elements of ideas and expression.¹⁵⁸

“Nevertheless,” the court continued, “the test is our law and we must apply it.”¹⁵⁹

156.1. *Jada Toys, Inc.*, 518 F.3d at 637 (citing and quoting *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994)); *Go Pro, Inc. v. 360Heroes, Inc.*, No. 16-cv-01944-SI, 2017 WL 5751325 (N.D. Cal. Nov. 28, 2017) (citing *Unicolors*); *Desire, LLC v. Manna Textiles, Inc.*, No. CV 16-4295-DMG (JEMx), 2017 WL 5635009 (C.D. Cal. Aug. 18, 2017).

157. *Metcalf v. Bochco*, 294 F.3d 1069, 1071 (9th Cir. 2002).

158. *Swirsky v. Carey*, 376 F.3d 841, 848 (9th Cir. 2004).

159. *Id.*

[I] Motion to Dismiss

Courts in the Ninth Circuit may determine substantial similarity on motions to dismiss by application of the extrinsic test only.^{159.1}

§ 3:2.2 Fourth Circuit

The Fourth Circuit, like the Ninth, uses a version of the extrinsic/intrinsic test to compare works.¹⁶⁰ To satisfy the Fourth

159.1. Segal v. Rogue Pictures, 544 F. App'x 769 (9th Cir. 2013) (judgment on the pleadings); Edwards v. Cinelou Films, 696 F. App'x 270 (9th Cir. 2017); Heusy v. Emmerich, 692 F. App'x 928 (9th Cir. 2017); Basile v. Sony Pictures Entm't Inc., 678 F. App'x 473 (9th Cir. 2017); Cline v. Reetz-Laiolo, 329 F. Supp. 3d 1000, 1038 (N.D. Cal. 2018); Zindel v. Fox Searchlight Pictures, Inc., No. 18-1435, 2018 WL 3601842 (C.D. Cal. July 23, 2018), *appeal docketed*, No. 18-56087 (9th Cir. Aug. 13, 2018); Shaheed-Edwards v. Syco Entm't, Inc., CV 17-06579SJO(SS), 2017 WL 6403091 (C.D. Cal. Dec. 14, 2017); Cabell v. Zorro Prods., Inc., No. 5:15-cv-00771-EJD, 2017 WL 2335597 (N.D. Cal. May 30, 2017) (allegations in complaint control when contested works are not before the court); Muromura v. Rubin Postaer & Assocs., No. CV 12-09263, 2015 WL 1728324, at *2 (C.D. Cal. Apr. 15, 2015); Wilson v. Walt Disney Co., 111 U.S.P.Q.2d 1737 (N.D. Cal. 2014) (The snowmen at issue in the case are reproduced in Appendix A.3.E.); *see also* Christianson v. West Publ'g Co., 149 F.2d 202, 203 (9th Cir. 1945); Gadh v. Spiegel, No. CV 14-855, 2014 WL 1778950 (C.D. Cal. Apr. 2, 2014); Zella v. E.W. Scripps Co., 529 F. Supp. 2d 1124, 1130–31 (C.D. Cal. 2007); Lake v. Columbia Broad. Sys., Inc., 140 F. Supp. 707 (S.D. Cal. 1956); Wild v. NBC Universal, Inc., 788 F. Supp. 2d 1083 (C.D. Cal. 2011).

160. *See* Humphreys & Partners Architects, L.P. v. Lessard Design, Inc., 790 F.3d 532, 537–38 (4th Cir. 2015); Copeland v. Bieber, 789 F.3d 484, 489 (4th Cir. 2015); Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc., 618 F.3d 417, 435–36 (4th Cir. 2010); Lyons P'ship, L.P. v. Morris Costumes, Inc., 243 F.3d 789, 801 (4th Cir. 2001); Towler v. Sayles, 76 F.3d 579, 583 (4th Cir. 1996); Dawson v. Hinshaw Music, Inc., 905 F.2d 731, 732–33 (4th Cir.), *cert. denied*, 498 U.S. 981 (1990); Eaton v. Nat'l Broad. Co., 972 F. Supp. 1019 (E.D. Va. 1997), *aff'd*, 1998 U.S. Dist. LEXIS 10288 (4th Cir. May 21, 1998); Baldine v. Furniture Comfort Corp., 956 F. Supp. 580, 586 (M.D.N.C. 1996). *See also* Charles W. Ross Builder, Inc. v. Olsen Fine Home Bldg., LLC, No. 11-2206, 2012 U.S. App. LEXIS 23224 (4th Cir. Sept. 19, 2012) (error to apply Second Circuit's more discerning ordinary observer test rather than extrinsic/intrinsic test in case involving architectural works).

Circuit’s extrinsic test, a plaintiff must show—typically with the aid of expert testimony—that the works in question are extrinsically similar because they contain substantially similar elements that are subject to copyright protection.¹⁶¹ To make the analysis the court must list and compare the elements of the works. To compare two screenplays, for example, “a court must analyze both screenplays and the record, searching for extrinsic similarities such as those found in plot, theme, dialogue, mood, setting, pace, or sequence.”¹⁶²

The Fourth Circuit’s explanation of the extrinsic test borrows from the Ninth Circuit’s explanation of the test in *Litchfield v. Spielberg*,¹⁶³ a case decided in 1984, after the Ninth Circuit’s creation of the test in *Sid & Marty Krofft Television Productions, Inc. v. McDonald’s Corp.*¹⁶⁴ but before the Ninth Circuit’s revision of the test in *Shaw v. Lindheim*.¹⁶⁵ Thus, the Fourth Circuit remains in that middle ground between *Krofft* and *Shaw*.

The second part of the Fourth Circuit’s test is similar, but not identical, to the second part of the Ninth Circuit test. Like the Ninth Circuit, the Fourth Circuit requires plaintiff to satisfy the subjective or intrinsic portion of the test by showing substantial similarity in how the two works’ elements are expressed.¹⁶⁶ In the second part of the test, the Fourth Circuit, like the Ninth and Eighth, compares

161. *Towler*, 76 F.3d at 583. *Accord* *Devil’s Advocate, LLC v. Zurich Am. Ins. Co.*, 666 F. App’x 256, 263 (4th Cir. 2016) (“We evaluate extrinsic similarity objectively, looking at ‘external criteria’ to determine whether the alleged copy is substantially similar to the ‘protected elements of the copyrighted work.’”) (citation omitted); *Lyons*, 243 F.3d at 801; *Levi v. Twentieth Century Fox Film Corp.*, No. 3:16-cv-129, 2018 WL 1542239 (E.D. Va. Mar. 29, 2018).

162. *Towler*, 76 F.3d at 583; *Levi*, 2018 WL 1542239, at *9; *Innovative Legal Mktg., LLC v. Mkt. Masters-Legal*, 852 F. Supp. 2d 688 (E.D. Va. 2012).

163. *Litchfield v. Spielberg*, 736 F.2d 1352 (9th Cir. 1984).

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

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

166. *Devil’s Advocate*, 666 F. App’x at 264; *Towler*, 76 F.3d at 583; *Lyons*, 243 F.3d at 801.

the “total concept and feel” of the two works,¹⁶⁷ and does not engage in analytic dissection.^{167.1}

The significant difference between the Fourth Circuit test and the Ninth Circuit test is that the Fourth Circuit tests intrinsic similarity by means of the “intended audience” test.¹⁶⁸

[A] Intended Audience Test

In the intrinsic portion of the substantial similarity test, in which the fact finder compares the total concept and feel of the two works, the Fourth Circuit employs a test it calls the “intended audience” test, seeking to gauge the reaction of the intended audience of the works.¹⁶⁹ Under the intended audience test, the court determines the subjective similarity between the two works not necessarily through the eyes of the “ordinary lay observer” but rather from the perspective of the group that is the market for the work, that is, the work’s intended audience.¹⁷⁰

When conducting the second prong of the substantial similarity inquiry [the intrinsic or subjective test], the court must consider the nature of the intended audience for the plaintiff’s work. If, as will most often be the case, the lay public fairly represents the intended audience, the court should apply the lay observer formulation of the ordinary observer test.¹⁷¹ However, if the intended audience is more narrow in that it possesses specialized expertise, relevant to the purchasing decision, that lay people would lack, the court’s inquiry should focus on whether a member of the intended audience would find the two works to be substantially similar.¹⁷²

167. See cases cited in notes 162 and 166, *supra*; *Dawson*, 905 F.2d at 732–33; *Levi*, 2018 WL 1542239, at *9; *Robinson v. New Line Cinema Corp.*, 42 F. Supp. 2d 578 (D. Md. 1999); *Eaton v. Nat’l Broad. Co.*, 972 F. Supp. 1019 (E.D. Va. 1997), *aff’d*, 1998 U.S. Dist. LEXIS 10288 (4th Cir. May 21, 1998); *Baldine*, 956 F. Supp. at 586.

167.1. *Devil’s Advocate*, 666 F. App’x at 264; *Copeland v. Bieber*, 789 F.3d 484, 494 (4th Cir. 2015) (works considered in their entirety).

168. *Towler*, 76 F.3d at 579; *Dawson*, 905 F.2d at 731.

169. *Dawson*, 905 F.2d at 737.

170. *Id.* at 736–37.

171. *Copeland*, 789 F.3d at 490–91; *Lyons*, 243 F.3d at 801; *Comins v. Discovery Commc’ns, Inc.*, 200 F. Supp. 2d 512, 517 (D. Md. 2002) (court applied ordinary observer test when neither party asserted that intended audience was specialized).

172. *Lyons*, 243 F.3d at 801; *Dawson*, 905 F.2d at 736.

Departure from the ordinary lay observer standard is not warranted in all cases, but only where the intended audience possesses “specialized expertise” that the ordinary layman does not.¹⁷³ The Fourth Circuit defines “specialized expertise” to be expertise going “beyond mere differences in taste and instead [rising] to the level of possession of knowledge that the lay public lacks.”¹⁷⁴ In a case involving alleged infringement of a motion picture, for example, the Fourth Circuit held that the intended audience for the works had no specialized expertise and so the intended audience and the ordinary lay observer were the same.¹⁷⁵

In *Dawson*, however, the Fourth Circuit remanded for a determination of whether the audience to which gospel music arrangements are marketed is one that possesses specialized expertise. The court suggested that

[i]t is quite possible that spiritual arrangements are purchased primarily by choral directors who possess specialized expertise relevant to their selection of one arrangement instead of another. Whereas a lay person’s reaction may be an accurate indicator of the extent to which those in the market for a popular recording will perceive another recording to be substantially similar, a lay person’s reaction might not be an accurate indicator of how expert choral directors would compare two spiritual arrangements.¹⁷⁶

Critical to the Fourth Circuit’s rationale for using the intended audience test is the court’s reading of *Arnstein v. Porter*, which the court found “provides the source of modern theory regarding the ordinary observer test.”¹⁷⁷ In *Arnstein*, plaintiff accused Cole Porter, a well-known composer of jazz and popular music, of infringing several of plaintiff’s compositions that, from their titles, appear to have been church hymns. The *Arnstein* court held that “the question . . . is whether defendant took from plaintiff’s works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such popular music is composed, that defendant

173. *Dawson*, 905 F.2d at 736.

174. *Id.*

175. *Towler v. Sayles*, 76 F.3d 579, 583 (4th Cir. 1996).

176. *Dawson*, 905 F.2d at 737.

177. *Id.* at 733 (citing *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946)).

wrongfully appropriated something which belongs to plaintiff.”¹⁷⁸ The Fourth Circuit in *Dawson* focused on the fact that in *Arnstein* the Second Circuit found that lay listeners “comprise the audience for whom such popular music is composed.” The Fourth Circuit reads *Arnstein* to require that the court “gauge the effect of the defendant’s work on the plaintiff’s market.”¹⁷⁹ Therefore the Fourth Circuit evaluates copyright infringement cases through the eyes of the consumers that make up that market, the intended audience.¹⁸⁰ The layman is the relevant audience only where the audience for whom the work is intended is the layman.¹⁸¹

[B] Intended Audience in Computer Cases

Although *Dawson* was not a computer case, the intended audience test announced in *Dawson* finds support in computer cases and courts’ struggles to compare computer programs with which layman are unfamiliar.¹⁸² In particular, the *Dawson* court cited *Whelan Associates v. Jaslow Dental Laboratory*¹⁸³ as an example of the type of case in which the intended audience generally will have more expertise than the general public, and for which the special knowledge of the intended audience must be considered.¹⁸⁴ Although most other circuits have not adopted the intended audience test for use in all cases, several courts have, sometimes without expressly saying so, applied the intended audience test in computer

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

179. *Dawson*, 905 F.2d at 734.

180. *Id.*; *Silver Ring Splint Co. v. Digisplint, Inc.*, 543 F. Supp. 2d 509, 517 (W.D. Va. 2008) (“intended audience of medical professionals and persons in need of finger splints”).

181. *Dawson*, 905 F.2d at 734.

182. *See id.* at 735.

183. *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031 (1987). In *Whelan*, the Third Circuit announced that in copyright cases involving exceptionally difficult materials that are unfamiliar to most members of the general public, like computer programs, the court would not apply a bifurcated extrinsic/intrinsic test but instead would combine the two tests into a single inquiry in which both lay and expert testimony would be admitted. 797 F.2d at 1233. We discuss the Third Circuit substantial similarity test in section 3:1.3.

184. *Dawson*, 905 F.2d at 735–36.

cases.¹⁸⁵ In *Computer Associates International, Inc. v. Altai, Inc.*,¹⁸⁶ the Second Circuit cited *Dawson* with approval and held that the district court could use its discretion to determine to what extent expert opinion evidence concerning the similarity of computer programs should be considered in a given case. The court stressed, however, that the district judge remained, in the final analysis, the trier of fact.¹⁸⁷

In the context of computer programs, courts sometimes have tried to assess the reaction of computer programmers, rather than laymen, to the computer programs at issue.¹⁸⁸ With respect to computer games, the intended audience is the group that plays the game.¹⁸⁹

[C] Intended Audience for Works Marketed to Children

Works intended for children must be judged through children's eyes in the Fourth Circuit. In *Lyons Partnership, L.P. v. Morris Costumes, Inc.*, the Fourth Circuit reversed the district court's order granting summary judgment for the defendant because the court failed to evaluate the works from a child's perspective.¹⁹⁰ At issue in the case was defendant's Duffy purple dinosaur costume, alleged to infringe plaintiff's copyright in the popular children's character Barney. The district court granted summary judgment based on its ruling that the relevant market for defendant's Duffy costume was adults who rented the costume for children's parties and its

185. *E.g.*, *Johnson Controls, Inc. v. Phx. Control Sys.*, 886 F.2d 1173, 1176 n.4 (9th Cir. 1989); *Data E. USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 210 (9th Cir. 1988) (karate computer games compared through the eyes of "a discerning 17.5 year old boy"); *Whelan*, 797 F.2d at 122; *Consul Tec, Inc. v. Interface Sys., Inc.*, 22 U.S.P.Q.2d 1538, 1540 (E.D. Mich. 1991) ("In the case of a computer program, substantial similarity must be determined from the perspective of the intended users of the program."). *But see* *Liu v. Price Waterhouse, LLP*, 1999 WL 47025 (slip op.) (N.D. Ill. Jan. 25, 1999) (ordinary observer test used).

186. *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 713–14 (2d Cir. 1992).

187. *Id.*

188. *Atari Games Corp. v. Nintendo of Am., Inc.*, 975 F.2d 832, 844 n.6 (Fed. Cir. 1992).

189. *Data E. USA*, 862 F.2d at 210.

190. *Lyons P'ship, L.P. v. Morris Costumes, Inc.*, 243 F.3d 789 (4th Cir. 2001).

certainty that the average adult would not confuse Duffy with Barney. The court of appeals held that similarity of child-oriented works must be viewed from the perspective of the child audience.¹⁹¹ The court seemed particularly impressed with evidence in the record that adults rented the Duffy costume hoping that their children would believe it was Barney and that children did in fact confuse the two. The court explained:

[E]ven though children were not present during any of the purchases or rentals testified to at trial, their impressions and views were the primary influence on the purchase decision. As the district court explicitly found “many of the adults rented these costumes with the intent of confusing their young children.” Thus, the fact that the adults were the nominal purchasers of the costumes is irrelevant for the purposes of the substantial similarity inquiry; the adults’ actions only confirm that children are the intended audience with respect to both the Barney character and the Duffy costume. . . .

We recognize the risk that by considering the perspectives of young children in the substantial similarity analysis, the potential liability for infringement might tend to broaden, given the reduced ability of young children to distinguish between objectively different items and concepts. But this concern is largely ameliorated by the first, objective prong of the substantial similarity inquiry, which requires the court to find, as a matter of law, that the works are extrinsically similar. Moreover, to the extent that liability is broadened, it represents the reality of the confusion and actual economic loss to the copyright owner.¹⁹²

In *Sid & Marty Krofft Television Productions, Inc. v. McDonald’s Corp.*, the Ninth Circuit held that because the two works at issue were marketed to children, the impact of the works on the minds and imaginations of young people was at issue.¹⁹³ In a case involving copyright infringement of dolls, the Ninth Circuit held that “[b]ecause children are the intended market for the dolls, we must filter

191. *Id.* at 802–83.

192. *Id.*

193. *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1166 (9th Cir. 1977).

the intrinsic inquiry through the perception of children.”¹⁹⁴ But in a case involving musical works, the Ninth Circuit declined to allow consideration of a specialized audience and cited *Krofft* for the proposition that the court was required to gauge the reaction of the ordinary lay listener in all instances.¹⁹⁵

The Second Circuit twice has ruled out adopting the intended audience test for works marketed to children. In *CK Co. v. Burger King Corp.*, in which the appellant alleged that the district court erred in refusing to evaluate the similarity between the cartoon characters at issue through the eyes of a child, the court declined to reach the question.¹⁹⁶ In *Williams v. Crichton*, the court explained that it ruled based on the “degree of similarity” rather than the distinction between children’s books and adult books.^{196.1} It emphasized, however, that consideration of the total concept and feel is “especially appropriate” in an infringement action involving children’s works “because children’s works are often less complex than those aimed at an adult audience.”^{196.2} In *Lewinson v. Henry Holt & Co.*, however, the district judge ruled that where literary works are created for children, “greater consideration of the total concept and feel of a work, rather than specific inquiry into plot and character development is particularly appropriate because children’s works are often less complex than those aimed at an adult audience.”

[D] Intended Audience Versus Ordinary Observer

At present, the Fourth Circuit’s intended audience test is the minority approach.^{196.3} Other than the exceptions noted above

194. *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 902 (9th Cir. 1987).

195. *Baxter v. MCA, Inc.*, 812 F.2d 421, 424 n.2 (9th Cir.), *cert. denied*, 484 U.S. 954 (1987). *See* *Copeland v. Bieber*, No. 2:13cv246 (E.D. Va. Mar. 28, 2014).

196. *CK Co. v. Burger King Corp.*, 122 F.3d 1055 (2d Cir. 1995) (unpublished opinion available at 1995 WL 595526).

196.1. *Williams v. Crichton*, 84 F.3d 581, 591 (2d Cir. 1996).

196.2. *Id.* at 589; *accord* *DiTocco v. Riordan*, 815 F. Supp. 2d 655 (S.D.N.Y. 2011); *Allen v. Scholastic Inc.*, 739 F. Supp. 2d 642 (S.D.N.Y. 2011); *Lewinson v. Henry Holt & Co.*, 659 F. Supp. 2d 547, 565 (S.D.N.Y. 2009).

196.3. The courts in the First Circuit have “yet to directly address the test.” *Airframe Sys., Inc. v. L-3 Commc’ns Corp.*, 658 F.3d 100, 106 n.7 (1st Cir. 2011); *Puerto Rico v. OPG Tech., Inc.*, No. 15-3125, 2016 WL 5724807, at *21 n.15 (D.P.R. Sept. 6, 2016).

with respect to children’s works and computer programs, most courts seem to require that works be compared by the ordinary observer, that is, jurors with no specialized training or expertise, in all instances.¹⁹⁷

[E] Advantages and Disadvantages of the Intended Audience Test

The intended audience test offers the obvious advantage of evaluation of the works through the eyes of those who understand them best. On the other hand, to apply the intended audience test, the court must both identify the intended audience, and either select only members of that audience for its jury or accept expert testimony concerning the intended audience’s reaction, potentially yielding the fact-finding function to the expert.¹⁹⁸ Application of the intended audience test may be further complicated if one party’s work is marketed to a different group.

197. See, e.g., *Jacobsen v. Deseret Book Co.*, 287 F.3d 936, 943 (10th Cir.), cert. denied, 537 U.S. 1066 (2002); *Peel & Co. v. Rug Mkt.*, 238 F.3d 391, 395 (5th Cir. 2001); *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1398 (9th Cir.), cert. dismissed, 521 U.S. 1146 (1997); *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120 (8th Cir. 1987); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 908 (3d Cir.), cert. denied, 423 U.S. 863 (1975). But see *Airframe Sys., Inc. v. L-3 Commc’ns Corp.*, 658 F.3d 100, 106 n.7 (1st Cir. 2011) (First Circuit has yet to address the issue); *Kohus v. Mariol*, 328 F.3d 848, 857 (6th Cir. 2003) (adopting the intended audience test); *Commonwealth of Puerto Rico v. OPG Tech., Inc.*, No. 15-3125, 2016 WL 5724807, at *14 n.15 (D.P.R. Sept. 6, 2016) (First Circuit has yet to address the issue); *Odegard, Inc. v. Safavieh Carpets, Inc.*, 398 F. Supp. 2d 275, 281 (S.D.N.Y. 2005) (evaluating works through the eyes of a consumer who would spend thousands of dollars on a carpet).

198. See *Kohus v. Mariol*, 328 F.3d 848, 857 (6th Cir. 2003) (“Expert testimony will usually be necessary to educate the trier of fact in those elements for which the specialist will look.”); *Dawson*, 905 F.2d at 736 (4th Cir.), cert. denied, 498 U.S. 981 (1990) (“Such an inquiry will include, and no doubt in many cases will require, admission of testimony from members of the intended audience or, possibly, from those who possess expertise with reference to the tastes and perceptions of the intended audience.”); *King Records, Inc. v. Bennett*, 438 F. Supp. 2d 812, 849 (M.D. Tenn. 2006) (expert testimony is permitted to educate the trier of fact about the specialty).

[F] Summary Judgment, Motion to Dismiss, and Preliminary Injunction

Although the Fourth Circuit has not squarely addressed the issue, courts in the Fourth Circuit (unlike those in the Ninth) consider both the extrinsic and intrinsic tests on motions for summary judgment and preliminary injunction motions.¹⁹⁹ Even if the plaintiff satisfies the extrinsic test, the court may grant summary judgment for the defendant if (1) the only similarities between the works concern unprotected elements, or (2) no reasonable juror, properly instructed, could find the two works substantially similar under the intrinsic test.²⁰⁰ The similarity of the works may also be evaluated on a Rule 12(b)(6) motion to dismiss.^{200.1}

§ 3:2.3 Eighth Circuit

The Eighth Circuit, like the Fourth Circuit, uses a version of the extrinsic/intrinsic test borrowed from a Ninth Circuit case

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199. See *Copeland v. Bieber*, 789 F.3d 484, 489 (4th Cir. 2015); *Towler v. Sayles*, 76 F.3d 579 (4th Cir. 1996); *Sedgewick Homes LLC v. Stillwater Homes Inc.*, No. 5:16-CV 0049-RLV-DCK, 2017 WL 3221488, at *10 (W.D.N.C. July 28, 2017); *Hennon v. Kirklands, Inc.*, 870 F. Supp. 118 (W.D. Va. 1994); *Moore v. Lightstorm Entm't*, 992 F. Supp. 2d 543 (D. Md. 2014); *Logan Developers, Inc. v. Heritage Bldgs., Inc.*, No. 7:12-CV-323, 2014 WL 2547085 (E.D.N.C. June 4, 2014); *Innovative Legal Mktg., LLC v. Mkt. Masters-Legal*, 852 F. Supp. 2d 688 (E.D. Va. 2012).
200. *Towler*, 76 F.3d at 584 (holding that two works were intrinsically dissimilar because no member of the viewing public reading or viewing the screenplays could reasonably decide that the two works were substantially similar); *Sedgewick Homes*, 2017 WL 3221488, at *7 (reviewing summary judgment principles in copyright cases); *Comins v. Discovery Commc'ns, Inc.*, 200 F. Supp. 2d 512, 517 (D. Md. 2002); *Baldine v. Furniture Comfort Corp.*, 956 F. Supp. 580, 586 (M.D.N.C. 1996) (summary judgment denied because plaintiff passed the extrinsic test and reasonable jury could find substantial similarity).
- 200.1. *Devil's Advocate, LLC v. Zurich Am. Ins. Co.*, 666 F. App'x 256, 264 (4th Cir. 2016); *Levi v. Twentieth Century Fox Film Corp.*, No. 3:16-cv-129, 2018 WL 1542239 (E.D. Va. Mar. 29, 2018) (motion to dismiss granted); *Shalom Baranes Assocs., P.C. v. Lauren Condos, LLC*, No. TDC-15-1980, 2016 WL 4939296 (D. Md. Sept. 14, 2016) (motions to dismiss denied); *Tessler v. NBC Universal*, Civil Action No. 2:08 CV 234, 2009 U.S. Dist. LEXIS 27345 (E.D. Va. Mar. 31, 2009), *aff'd*, No. 09-1495, 2010 U.S. App. LEXIS 2397 (4th Cir. 2009); *Copeland v. Bieber*, No. 2:13cv246 (E.D. Va. Mar. 28, 2014).

decided after *Krofft* and before the objective/subjective test of *Shaw*.²⁰¹ In *Moore v. Columbia Pictures Industries, Inc.*, the Eighth Circuit explained the two-part test by quoting from the decision in *Hartman v. Hallmark Cards*, a 1987 Eighth Circuit decision that, like the leading cases in the Fourth Circuit, adopted the intermediate statement of the test in Ninth Circuit cases decided in the years between *Krofft* and *Shaw*.²⁰²

The Eighth Circuit in *Hartman* described the test as follows: “First, similarity of ideas is analyzed extrinsically, focusing on objective similarities in the details of the works. Second, if there is substantial similarity in ideas, similarity of expression is evaluated using an intrinsic test depending on the response of the ordinary, reasonable person as to the forms of expression.”²⁰³ As in the Ninth Circuit, expert testimony is permitted in connection with the extrinsic portion of the test, but not in connection with the intrinsic portion.²⁰⁴ Likewise, “filtering” or “analytic dissection” is permitted only in the extrinsic phase and not in the intrinsic.^{204.1} The question in the intrinsic phase is only whether the ordinary, reasonable

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201. *Moore v. Columbia Pictures Indus., Inc.*, 972 F.2d 939, 945 (8th Cir. 1992); *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120 (8th Cir. 1987).
202. *Hartman* cited *McCulloch v. Albert E. Price, Inc.*, 823 F.2d 316 (9th Cir. 1987), and *Baxter v. MCA, Inc.*, 812 F.2d 421 (9th Cir.), *cert. denied*, 484 U.S. 954 (1987).
203. *Hartman*, 833 F.2d at 120. *Accord* *Rottlund Co. v. Pinnacle Corp.*, 452 F.3d 726, 731–32 (8th Cir. 2006); *Taylor Corp. v. Four Seasons Greetings, LLC*, 403 F.3d 958, 966 (8th Cir. 2005); *Schoolhouse, Inc. v. Anderson*, 275 F.3d 726, 729 (8th Cir. 2002); *Titlecraft, Inc. v. Nat’l Football League*, Civ. No. 10-758, 2010 WL 5209293, at *2–3, 97 U.S.P.Q.2d 1315 (D. Minn. Dec. 20, 2010) (The trophies at issue in the case are reproduced in Appendix A.2.E.); *Monarch Prods., LLC v. Zephyr Grafic, Inc.*, No. 4:09-CV-02049, 2010 WL 3782040, at *2 (E.D. Mo. Sept. 22, 2010) (The patterns at issue in the ease are reproduced in Appendix A.9.G.).
204. *Rottlund Co.*, 452 F.3d at 731–32; *Honeywell Int’l Inc. v. ICM Controls Corp.*, 45 F. Supp. 3d 969 (D. Minn. 2014), *later opinion*, No. 11-cv-569 (JNE/TNL), 2017 WL 374907 (D. Minn. Jan. 26, 2017). See also cases cited in note 203, *supra*.
- 204.1. *Taylor Corp. v. Four Seasons Greetings, LLC*, 403 F.3d 958, 966 (8th Cir. 2005); *Honeywell Int’l*, 2017 WL 374907, at *3; *Sun Media Sys., Inc. v. KDSM, LLC*, 576 F. Supp. 2d 1018, 1022 (S.D. Iowa 2008).

observer would find the works, taken as a whole, to be substantially similar.^{204.2}

[A] Summary Judgment, Motion to Dismiss, and Preliminary Injunction

In the Eighth Circuit, as in the Ninth, the court may grant summary judgment in favor of the defendant if plaintiff fails the extrinsic test.²⁰⁵ But the Eighth Circuit also allows for summary judgment even if plaintiff passes the extrinsic test. In the Eighth Circuit, “[s]ummary judgment is not favored, but when substantial similarity is the sole issue it is appropriate if the works are so dissimilar that ‘reasonable minds could not differ as to the absence of substantial similarity of expression.’”²⁰⁶ Similarly, a court may grant summary judgment for the plaintiff if it finds that reasonable minds could not differ as to the presence of substantial similarity.²⁰⁷ The Eighth Circuit also permits courts to grant 12(b)(6) motions to dismiss based on comparison of the works at issue.^{207.1}

To evaluate the likelihood of success on a motion for a preliminary injunction, courts in the Eighth Circuit examine the works using both the extrinsic and intrinsic tests.²⁰⁸

204.2. *Taylor Corp.*, 403 F.3d at 966.

205. *Moore*, 972 F.2d at 946.

206. *Id.* (quoting *Litchfield v. Spielberg*, 736 F.2d 1352, 1355–56 (9th Cir. 1984), *cert. denied*, 470 U.S. 1052 (1985)). *Accord Schoolhouse*, 275 F.3d at 729; *Nelson v. PRN Prods., Inc.*, 873 F.2d 1141, 1143–44 (8th Cir.), *cert. denied*, 493 U.S. 994 (1989); *Titlecraft*, 2010 WL 5209293, at *3.

207. *CSM Inv’rs, Inc. v. Everest Dev., Ltd.*, 840 F. Supp. 1304, 1311–12 (D. Minn. 1994).

207.1. *Nelson v. PRN Prods., Inc.*, 873 F.2d 1141, 1143–44 (8th Cir. 1989); *GMES, LLC v. Line of Sight Commc’ns, Inc.*, No 2:16-CV-04085, 2016 WL 3566254 (W.D. Mo. June 27, 2016); *McDonald Constr., Inc. v. Oborn*, No. 15-CV-3126, 2016 WL 3232899 (D. Minn. May 19, 2016) (judgment on the pleadings).

208. *Taylor Corp. v. Four Seasons Greetings, LLC*, 171 F. Supp. 2d 970, 972 (D. Minn. 2001), *aff’d*, 315 F.3d 1039 (8th Cir. 2003); *DF Inst., Inc. v. Marketshare EDS*, 2007 WL 1589525, at *5, *7 (D. Minn. June 1, 2007); *Janel Russell Designs, Inc. v. Mendelson & Assocs.*, 114 F. Supp. 2d 856, 864–65 (D. Minn. 2000).

§ 3:3 Abstraction/Filtration/Comparison

§ 3:3.1 Tenth Circuit

Courts in the Tenth Circuit have used the abstraction/filtration/comparison test for various types of cases, not just computer cases.²¹⁰ The Tenth Circuit authorized use of the test for cases other than computer cases in *Country Kids 'N City Slicks, Inc. v. Sheen*, a case decided in 1996. Although the Tenth Circuit has written that a thorough abstraction/filtration/comparison test may not need to be applied to every type of infringement case,²¹¹ courts in the Tenth Circuit frequently have used the abstraction/filtration/comparison test in published decisions issued since *Country Kids 'N City Slicks, Inc. v. Sheen*.²¹²

Like courts in the Second Circuit, courts in the Tenth Circuit begin by separating the infringement analysis into two distinct inquiries: (1) whether there is sufficient evidence of access and probative similarity to prove that defendant copied, and (2) whether defendant took enough of plaintiff's protected material to be guilty

209. [Reserved.]

210. *Savant Homes, Inc. v. Collins*, 809 F.3d 1133, 1144–45 (10th Cir. 2016); *see also Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1284 (10th Cir. 1996); *Cy Wakeman, Inc. v. Nicole Price Consulting, LLC*, 284 F. Supp. 3d 985 (D. Neb. 2018); *Close to My Heart, Inc. v. Enthusiast Media LLC*, 508 F. Supp. 2d 963 (D. Utah 2007); *Kindergartners Count, Inc. v. DeMoulin*, 249 F. Supp. 2d 1214 (D. Kan. 2003) (personalized children's books); *Madrid v. Chronicle Books*, 209 F. Supp. 2d 1227 (D. Wyo. 2002) (comparison of poem to motion picture); *Fisher v. United Feature Syndicate, Inc.*, 37 F. Supp. 2d 1213 (D. Colo. 1999), *aff'd mem.*, 203 F.3d 834 (10th Cir.) (unpublished opinion available at 2000 U.S. App. LEXIS 1749), *cert. denied*, 531 U.S. 992 (2000) (characters); *Sportsmans Warehouse, Inc. v. Fair*, 576 F. Supp. 2d 1175 (D. Colo. 2008) (elk sculptures), *appeal dismissed*, 311 F. App'x 136 (10th Cir. 2009); *McRae v. Smith*, 968 F. Supp. 559 (D. Colo. 1997) (songs). We discuss application of the abstraction/filtration/comparison test in computer cases in chapter 8.

211. *Jacobson v. Deseret Book Co.*, 287 F.3d 936, 943 n.5 (10th Cir.), *cert. denied*, 537 U.S. 1066 (2002); *Transwestern Publ'g Co. v. Multimedia Mktg. Assocs., Inc.*, 133 F.3d 773, 777 (10th Cir. 1998). *See also Blehm v. Jacobs*, 702 F.2d 1193 (10th Cir. 2012) (omitting discussion of abstraction-filtration-comparison in case involving stick figures).

212. *See cases cited in note 210, supra.*

of infringement.²¹³ The Tenth Circuit, like the Second Circuit, tests probative similarity by comparing all elements of the works, not just the protected elements, to see whether there are similarities probative of copying.²¹⁴ Like the Ninth Circuit, the Tenth Circuit applies the so-called Inverse Ratio Rule, weighing access and probative similarity on a sliding scale, and requiring less evidence of access when there is more evidence of similarity, and no evidence of access when there is striking similarity.²¹⁵ If the court determines there is sufficient evidence of copying, the court then tests whether there has been infringement of the protected elements of plaintiff's work by applying the abstraction-filtration-comparison test.²¹⁶ The court compares the works in the form in which they are presented to the public.²¹⁷

In *Country Kids 'N City Slicks, Inc. v. Sheen*, the Tenth Circuit described the abstraction-filtration-comparison test as follows:

At the abstraction step, we separate the ideas (and basic utilitarian functions) which are not protectable, from the particular expression of the work. Then, we filter out the nonprotectable components of the product from the original expression. Finally, we compare the remaining protected elements to the allegedly copied work to determine if the two works are substantially similar.²¹⁸

213. *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1370 (10th Cir. 1997); *Country Kids 'N City Slicks*, 77 F.3d at 1284; *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 833, 841 (10th Cir. 1993). We discuss the Second Circuit probative and substantial similarity tests in section 3:1.1.

214. *Gates Rubber*, 9 F.3d at 841.

215. *Country Kids 'N City Slicks*, 77 F.3d at 1284; *McRae v. Smith*, 968 F. Supp. 559, 565 (D. Colo. 1997). We discuss the Ninth Circuit's use of the Inverse Ratio Rule in section 3:2.1.

216. *Israel v. Univ. of Utah*, No. 2:15-cv-741 TS, 2017 WL 1383694 (D. Utah Apr. 18, 2017). See cases cited in note 215, *supra*. See also *Paycom Payroll, LLC v. Richison*, 758 F.3d 1198 (10th Cir. 2014) (vacating determination of infringement based on expedited analysis that skipped the abstraction test); *Vasquez v. Ybarra*, 150 F. Supp. 2d 1157 (D. Kan. 2001). *But see Blehm*, 702 F.2d at 1200–03.

217. *Teller v. Dogge*, 8 F. Supp. 3d 1228, 1236 (D. Nev. 2014) (“court compares only the *observable* elements”); *Madrid v. Chronicle Books*, 209 F. Supp. 2d 1227, 1234–36 (D. Wyo. 2002).

218. *Country Kids 'N City Slicks*, 77 F.3d at 1285.

Country Kids 'N City Slicks, Inc. v. Sheen involved alleged infringement of plaintiff's copyrighted wooden dolls by defendant's wooden dolls. Plaintiff claimed that defendant had copied the size, shape, and medium of its dolls. The Tenth Circuit affirmed the district court's ruling that each of those elements was unprotectable and must be filtered out. The Tenth Circuit nevertheless remanded the case to the district court for proper comparison analysis. It held that the district court was wrong to require that defendant's doll be a "virtual copy" of plaintiff's to be infringing.²¹⁹ Rather, the Tenth Circuit clarified that the comparison portion of the inquiry is to be conducted using the ordinary observer test, "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 protectable expression by taking material of substance and value."²²⁰ The court stressed that the ordinary observer test is a qualitative test rather than a quantitative test, so that even if the amount of protected material taken is quantitatively small, if it is qualitatively important, there can be infringement.²²¹

There are several other reported Tenth Circuit decisions demonstrating application of the abstraction/filtration/comparison test to works other than computer programs.²²² In *McRae v. Smith*,²²³ for example, the court applied the abstraction/filtration/comparison analysis to two country music songs. The court filtered out each of the elements plaintiff claimed were copied: the two-step

219. The district court may not have been wrong to set a high standard in that case. Having filtered out each individual element plaintiff claimed was infringed, the district court may correctly have found that plaintiff's only viable claim was that defendant had copied the compilation of features. If the district court was applying compilation analysis, it was correct to require a high degree of similarity. We discuss compilations in chapter 13.

220. *La Resolana Architects, PA v. Reno, Inc.*, 555 F.3d 1171 (10th Cir. 2009); *Country Kids 'N City Slicks*, 77 F.3d at 1288. *Accord* *Jacobsen v. Deseret Book Co.*, 287 F.3d 936, 943 n.5 (10th Cir.), *cert. denied*, 537 U.S. 1066 (2002).

221. *Country Kids 'N City Slicks*, 77 F.3d at 1287.

222. In addition to the cases discussed in the text, see *Lumos, Inc. v. LifeStrength, LLC*, No. 2:12-cv-1196, 2014 WL 4355451 (D. Utah Sept. 3, 2014); *Kindergartners Count, Inc. v. DeMoulin*, 249 F. Supp. 2d 1214 (D. Kan. 2003); *Madrid*, 209 F. Supp. 2d 1227.

223. *McRae v. Smith*, 968 F. Supp. 559 (D. Colo. 1997).

rhythm; the love song theme; common chord progression; descending melodic lines; the mood; and the verse-chorus-verse form, and the defendant prevailed. In another case, *Fisher v. United Feature Syndicate, Inc.*, the court applied the filtration test in comparing two dog cartoon characters (defendant's character was Snoopy). The court filtered out the concept of a Sherlock Holmes-type detective, the only real similarity between the cartoons, and entered judgment for the defendant.²²⁴ Similarly, in *Medias & Co. v. Ty, Inc.*,²²⁵ the court filtered the ideas of plush ducks and plush chameleons before comparing the parties' stuffed duck and chameleon toys.

In *Blehm v. Jacobs*,^{225.1} a case concerning stick figure drawings, the Tenth Circuit employed a two-part test consisting of first identifying the protectable expression in the plaintiff's work and then comparing the protectable expression to the accused work to evaluate substantial similarity. The court explained that "not every case requires extensive analysis, and the appropriate test may vary depending upon the claims involved, the procedural posture of the suit, and the nature of the works at issue."^{225.2}

Following *Blehm*, in *Whitaker v. Stanwood Imports*,^{225.3} a case involving windmills, the court found the works at issue "relatively simple." The court wrote: "For substantially the same reasons stated by the Tenth Circuit in *Blehm*, the Court finds it unnecessary to use the 'abstraction-filtration-comparison' test here. Rather, the Court will apply the simplified two-part test discussed in *Blehm*."

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224. *Fisher v. United Feature Syndicate, Inc.*, 37 F. Supp. 2d 1213 (D. Colo. 1997), *aff'd*, 203 F.3d 834 (10th Cir.), *cert. denied*, 531 U.S. 992 (2000).
225. *Medias & Co. v. Ty, Inc.*, 106 F. Supp. 2d 1132 (D. Colo. 2000). *Accord Sportsmans Warehouse, Inc. v. Fair*, 576 F. Supp. 2d 1175 (D. Colo. 2008) (nonprotectable components filtered out before comparing elk sculptures).
- 225.1. *Blehm v. Jacobs*, 702 F.3d 1193 (10th Cir. 2012). The drawings at issue in the case are reproduced in Appendix A.1.H.
- 225.2. *Id.* at 1200 n.4 (quoting *Jacobsen v. Desert Book Co.*, 287 F.3d 936, 943 n.5 (10th Cir. 2002), *cert. denied*, 537 U.S. 1066 (2002)); *Mitel, Inc.*, 124 F.3d at 1373; *McNeese v. Access Midstream Partners, L.P.*, No. civ-14-503-D, 2017 WL 972156 (W.D. Okla. Mar. 10, 2017), *adhered to on reconsideration*, 2017 WL 1843307 (W.D. Okla. May 5, 2017).
- 225.3. *Whitaker v. Stanwood Imps.*, Case No. 2:10-CV-539 TS, 2013 U.S. Dist. LEXIS 7612, at *13 (D. Utah Jan. 17, 2013).

[A] Summary Judgment, Motion to Dismiss, and Preliminary Injunction

Courts in the Tenth Circuit grant summary judgment motions only if there is insufficient evidence for a trier of fact reasonably to find for the nonmoving party.²²⁶ They grant summary judgment and motions to dismiss for the defendant based on a lack of substantial similarity if they find that the similarities between the works concern only noncopyrightable elements or that no reasonable jury could find the works substantially similar.²²⁷

On preliminary injunction motions, Tenth Circuit courts apply the abstraction/filtration/comparison test, using the ordinary observer test in the comparison stage, to evaluate plaintiff's likelihood of success on the issue of substantial similarity.²²⁸

§ 3:3.2 Sixth Circuit

Until 2003, the Sixth Circuit had not adopted a specific test for analyzing substantial similarity in copyright cases.²²⁹ District courts did not consistently apply a single test. Most evaluated substantial similarity by means of the ordinary observer test, without expert testimony.²³⁰ Some used the Ninth Circuit extrinsic/intrinsic test.²³¹ In general, courts in the Sixth Circuit did not make distinctions

226. *Vasquez v. Ybarra*, 150 F. Supp. 2d 1157, 1161 (D. Kan. 2001); *Kindergarten Count*, 249 F. Supp. 3d at 1229–30.

227. *See Savant Homes v. Collins*, 809 F.3d 1133, 1143 (10th Cir. 2016); *Israel v. Univ. of Utah*, No. 2:15-cv-741, 2018 WL 4290394 (D. Utah Sept. 7, 2018); *Civility Experts Worldwide v. Molly Manners, LLC*, 167 F. Supp. 3d 1179 (D. Colo. 2016); *Clark v. Dashner*, No. 14-00965, 2016 WL 4169223 (D.N.M. June 30, 2016) (motion to dismiss); *Sportsmans Warehouse, Inc.*, 576 F. Supp. 2d at 1200; *Fisher*, 37 F. Supp. 2d at 1224. *See also McRae*, 986 F. Supp. 559 (granting summary judgment for defendant because there was insufficient evidence for a jury to find striking similarity).

228. *Country Kids 'N City Slicks*, 77 F.3d at 1288; *Medias & Co. v. Ty, Inc.*, 106 F. Supp. 2d 1132 (D. Colo. 2000).

229. *Kohus v. Mariol*, 328 F.3d 848, 854 (6th Cir. 2003); *Ellis v. Diffie*, 177 F.3d 503, 506 (6th Cir. 1999); *Bird Brain, Inc. v. Menard, Inc.*, 2000 U.S. Dist. LEXIS 11668 (W.D. Mich. Aug. 4, 2000).

230. *Ellis*, 177 F.3d at 506; *Bird Brain*, 2000 U.S. Dist. LEXIS 11668, at *24.

231. *See Benton v. Decotex, Inc.*, 2000 U.S. App. LEXIS 26779 (6th Cir. Oct. 18, 2000); *Marigold Foods, Inc. v. Purity Dairies, Inc.*, 1992 U.S. App. LEXIS 14044 (6th Cir. June 10, 1992) (district court applied extrinsic/intrinsic test and court of appeals used the same analysis).

between probative similarity and substantial similarity, or between intrinsic and extrinsic similarities.²³²

In 2003, the Sixth Circuit adopted a standard that seems to be a variation on abstraction/filtration comparison. One might call it filtration/comparison by intended audience.²³³ The case in which the Sixth Circuit announced its new standard is *Kohus v. Mariol*.²³⁴

In *Kohus*, the Sixth Circuit mandated a two-part test.^{234.1} The court views the test as a “refinement of the ordinary observer test that, as its initial step, parses from the work the elements neither afforded copyright protection nor properly considered in the ordinary observer test.”^{234.2} In the first part of the test, the court must identify which aspects of the plaintiff’s work are protected by copyright.^{234.3} The plaintiff bears the burden of identifying the protected elements; failure to do so can lead to summary judgment in favor of the defendant.^{234.4} “The essence of the first step is to filter out the unoriginal, unprotectible elements—elements that were not

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232. See *Ellis*, 177 F.3d at 506; *Wickham v. Knoxville Int’l Energy Exposition, Inc.*, 739 F.2d 1094, 1096–97 (6th Cir. 1984). *Contra* *Dahlen v. Mich. Licensed Beverage Ass’n*, 132 F. Supp. 2d 574, 584 (E.D. Mich. 2001) (distinguishing between copying and unlawful appropriation).
233. The Sixth Circuit test is similar to the test employed by the D.C. Circuit. *Stromback v. New Line Cinema*, 384 F.3d 283, 294 (6th Cir. 2004); *Murray Hill Publ’ns, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 318 (6th Cir. 2004).
234. *Kohus v. Mariol*, 328 F.3d 848 (6th Cir. 2003). *Accord* *R.C. Olmstead, Inc. v. CU Interface, LLC*, 606 F.3d 262 (6th Cir. 2010); *Murray Hill Publ’ns*, 361 F.3d at 312 (6th Cir. 2004).
- 234.1. See *Automated Sols. Corp. v. Paragon Data Sys., Inc.*, 756 F.3d 504, 518 (6th Cir. 2014); *Bridgeport Music, Inc. v. UMG Recordings, Inc.*, 585 F.3d 267, 274 (6th Cir. 2009); *Nason Homes, LLC v. Billy’s Constr., Inc.*, No. 3:14-cv-566, 2015 WL 6812705, at *4 (M.D. Tenn. Nov. 5, 2015); *Jedsen Eng’g, Inc. v. Spirit Constr. Servs., Inc.*, 720 F. Supp. 904, 920 (S.D. Ohio 2010).
- 234.2. *Stromback*, 384 F.3d at 283, 294; *Stark Enters., Inc. v. Neptune Design Grp., LLC*, No 1:16 CV 264, 2017 WL 1345195 (N.D. Ohio Apr. 12, 2017).
- 234.3. *R.C. Olmstead*, 606 F.3d at 275; *Bridgeport*, 585 F.3d at 274; *Ducks Unlimited, Inc. v. Boondux, LLC*, No. 2:14-cv-02885, 2017 WL 3579215 (W.D. Tenn. Aug. 18, 2017) (the filtration step is to be performed by the court, not a witness).
- 234.4. See *R.C. Olmstead*, 606 F.3d at 275 (plaintiff failed to create an issue of fact in opposition to summary judgment by failing to adequately identify protected elements allegedly copied by defendant).

independently created by the inventor [sic], and that possess no minimal degree of creativity—through a variety of analyses.”²³⁵ The court seemed to suggest that courts perform abstraction in connection with this first part of the test.²³⁶ The court specifically identified ideas, elements dictated by efficiency, and *scènes à faire* as elements to be filtered out before comparing the works.²³⁷

In a later case, *Murray Hill Publications, Inc. v. Twentieth Century Fox Film Corp.*,²³⁸ the court added another item to the list of elements to be filtered—*independently created elements*. The court ruled that elements that appeared in one of the defendant’s earlier works, a work that preceded plaintiff’s, should be excluded from the analysis. The reason for that rule, the court explained, is that an author is more likely to have copied items he used before from himself rather than from another.

In the first part of the test, expert testimony may be admitted,²³⁹ although the Sixth Circuit has cautioned that it applies a “more stringent standard regarding when to allow expert testimony.”²⁴⁰

After the court filters out the unprotectable elements, the second step is to compare the two works.²⁴¹ Borrowing from the Fourth Circuit, the *Kohus* court held that the works should be compared from the perspective of the intended audience.²⁴² The court explained that often the intended audience is the lay public, “in which case the fact finder’s judgment should be from the perspective of the lay observer or . . . the ordinary reasonable person.”²⁴³ In

235. *Kohus*, 328 F.3d at 855 (citation omitted). *Accord* Tiseo Architects, Inc. v. B&B Pools Serv. & Supply Co., 495 F.3d 344, 348 (6th Cir. 2007); *Brainard v. Vassar*, 625 F. Supp. 2d 608, 616-17 (M.D. Tenn. 2009); *Johnson v. Fox*, 502 F. Supp. 2d 620, 623 (E.D. Mich. 2007).

236. *Kohus*, 328 F.3d at 855-56; *but see Ducks Unlimited*, 2017 WL 3579215, at *16.

237. *Kohus*, *supra* note 236.

238. *Murray Hill Publ’ns, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 325-26 (6th Cir. 2004).

239. *Kohus*, 328 F.3d at 856.

240. *Stromback v. New Line Cinema*, 384 F.3d 283, 294 (6th Cir. 2004); *Murray Hill*, 361 F.3d at 318.

241. *Bridgeport*, 585 F.3d at 275; *Tiseo Architects*, 495 F.3d at 348; *Kohus*, 328 F.3d at 857; *Brainard*, 625 F. Supp. 2d at 617.

242. *Kohus*, 328 F.3d at 857. We discuss the Fourth Circuit intended audience test in section 3:2.2[A].

243. *Kohus*, 328 F.3d at 857. *See also* *Bandana Co. v. Tjx Cos.*, 2005 Copyright L. Dec. (CCH) ¶ 29,012 (W.D. Ky. 2005).

cases where the audience for the work possesses specialized expertise “that is relevant to the purchasing decision and lacking in the lay observer,” however, the trier of fact should make the substantial similarity inquiry from the perspective of that more knowledgeable audience. The court suggested that “[e]xpert testimony will usually be necessary to educate the trier of fact in those elements for which the specialist will look.”²⁴⁴

Adopting the Fourth Circuit’s admonishment in *Dawson v. Hinshaw Music, Inc.*,²⁴⁵ the Sixth Circuit cautioned in *Kohus* that courts should hesitate to rule that something other than the lay public represents a work’s intended audience.²⁴⁶ At the same time, however, the Sixth Circuit suggested that the audience for the works at issue in *Kohus*, design drawings, might be a specialized one because:

the drawings are technical and are appropriate for patent treatment; interpretational guidance is needed for the lay viewer to imagine the structure and function of the device that the drawings depict; and the initial purchasers of the device would probably be trained engineers, capable of discerning technical niceties that the ordinary person would not detect and likely to base their purchasing decision on such details.²⁴⁷

On the other hand, where a work, such as an advertisement, is intended for the general adult population, the lay public is the appropriate audience.^{247.1}

As in the Second and Tenth Circuits, courts in the Sixth Circuit compare works as they are made available to the public; drafts or intermediate versions of the works that have not been presented to the public are not considered.²⁴⁸ The Sixth Circuit also applies the inverse ratio rule to the relationship between the degree of proof

244. *Kohus*, 328 F.3d at 857.

245. *Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731, 737 (4th Cir. 1990).

246. *Kohus*, 328 F.3d at 857.

247. *Id.* at 858. *Cf.* *Schenck v. Orosz*, No. 3:13-CV-00294, 2016 WL 912281, at *6 (M.D. Tenn. Mar. 10, 2016) (lay public is standard used to determine substantial similarity in commercial graphic designs).

247.1. *JB Oxford & Co. v. First Tenn. Bank Nat’l Ass’n*, 427 F. Supp. 2d 784, 799 (M.D. Tenn. 2006). *Accord* *Brainard v. Vassar*, 625 F. Supp. 2d 608, 617 (M.D. Tenn. 2009) (granting summary judgment).

248. *Stromback v. New Line Cinema*, 384 F.3d 283, 299–300 (6th Cir. 2004).

required for similarity and access such that a lower standard of proof of similarity is required where a high degree of access is shown.^{248.1}

[A] Summary Judgment, Motion to Dismiss, and Preliminary Injunction

Although the Sixth Circuit has cautioned that summary judgment is to be granted sparingly in copyright cases, courts in the Sixth Circuit may grant summary judgment, for the plaintiff or the defendant, when there is no genuine issue of fact as to the substantial similarity or lack of substantial similarity between the works.²⁴⁹ Courts consider both parts of the filtration/comparison test when making those summary judgment determinations.^{249.1}

A special pleading test unique to claims for copyright infringement is employed in the Sixth Circuit: “copyright infringement claims require greater particularly in pleading through showing plausible grounds for infringement.”^{249.2} Beyond that test, a court

248.1. *Id.* at 293; *Bowen v. Paisley*, 2013 U.S. Dist. LEXIS 170337 (M.D. Tenn. Dec. 3, 2013).

249. *Jones v. Blige*, 558 F.3d 485, 490 (6th Cir. 2009); *Murray Hill*, 361 F.3d at 320–21. *Kohus*, 328 F.3d at 853; *Mihalek Corp. v. State of Michigan*, 814 F.2d 290 (6th Cir. 1987) (affirming summary judgment for defendant where examination of materials clearly showed that works were not substantially similar); *Wickham v. Knoxville Int’l Energy Exposition, Inc.*, 739 F.2d 1094, 1096–97 (6th Cir. 1984) (affirming summary judgment for defendant); *Design Basics, LLC v. Ashford Homes, LLC*, No. 1:17-cv-273, 2018 WL 6620438 (S.D. Ohio Dec. 18, 2018) (question of fact for the jury) (The works at issue in the case are reproduced in Appendix A.7.K.); *Robert L. Stark Enters., Inc. v. Neptune Design Grp., LLC*, No. 1:16 CV 264, 2017 WL 1345195 (N.D. Ohio Apr. 12, 2017); *Eggleston v. Daniels*, No. 15-11893, 2016 WL 4363013, at *13 n.5 (E.D. Mich. Aug. 16, 2016); *Connor Bowen v. Paisley*, No. 3:13-CV-0414, 2016 WL 4480165, at *10 (M.D. Tenn. Aug. 25, 2016) (The lyrics at issue in the case are reproduced in Appendix A.5.F.); *Brainard*, 625 F. Supp. 2d at 616; *Dahlen v. Mich. Licensed Beverage Ass’n*, 132 F. Supp. 2d 574, 584 (E.D. Mich. 2001) (refusing to grant summary judgment for either party).

249.1. *Stromback*, 384 F.3d at 294.

249.2. *Nat’l Bus. Dev. Servs., Inc. v. Am. Credit Educ. & Consulting, Inc.*, 299 F. App’x 509 (6th Cir. 2018); *Liva v. Sly, Inc.*, No. 1:17 CV 2235, 2017 WL 484401 (N.D. Ohio Jan. 17, 2018); *Ford Motor Co. v. Autel US Inc.*, No. 14-13760, 2015 WL 5729067, at *3 (E.D. Mich. Sept. 30, 2015); *Eggleston*, 2016 WL 4363013, at *6, *9; *Best v. AT&T Mobility, LLC*, No. 1:12-CV-564, 2015 WL 1125539, at *4 (S.D. Ohio Mar. 12,

may determine on a motion to dismiss whether the works at issue could be substantially similar.^{249.3}

On motions for preliminary injunctions, before *Kohus*, courts in the Sixth Circuit sought to evaluate substantial similarity using the ordinary observer test in order to determine whether plaintiff was likely to succeed on the merits.^{249.4} After *Kohus*, presumably courts will make a similar inquiry using the filtration/comparison by intended audience test.²⁵⁰

§ 3:3.3 D.C. Circuit

The District of Columbia Circuit, like the Second Circuit, recognizes a distinction in copyright infringement cases between the need to prove copying (usually through access and probative similarity) and the need to show substantial similarity (that the copying is actionable because defendant copied protected portions of plaintiff's

2015). *But cf.* Gen. Motors, LLC v. Dorman Prods., Inc., No. 15-1291, 2016 WL 5661578, at *3 (E.D. Mich. Sept. 30, 2016) (there is no higher pleading standard in the Sixth Circuit), and 2017 WL 783469 (E.D. Mich. Mar. 1, 2017) (plausibility standard is satisfied by sufficient facts to raise a reasonable inference of copying); McDonald v. K-2 Indus., Inc., 108 F. Supp. 3d 135, 139 (W.D.N.Y. 2015) (“There is no heightened pleading requirement applied to copyright infringement claims . . .”).

249.3. Halper v. Sony/ATV Music Publ'g, LLC No. 3:16-cv-00567, 2018 WL 3954340 (M.D. Tenn. Aug. 17, 2018); Brown v. Twentieth Century Fox Home Entm't, No. 6:14-cv-147, 2015 WL 5081125, at *8–12 (E.D. Ky. Aug. 27, 2015); Lyles v. Capital-EMI Music Inc., No. 2:12-cv-00751, 2013 WL 6000991 (S.D. Ohio Nov. 12, 2013); Hua-Cheng Pan v. Kohl's Dep't Stores, Inc., No. 2:12-CV-01063, 2013 WL 5181144 (S.D. Ohio Sept. 12, 2013) (The Santas at issue in the case are reproduced in Appendix A.2.G.); Davis v. ABC, No. 1:10-CV-167, 2010 WL 2998476, at *5 (W.D. Mich. July 28, 2010). *See also* Pollick v. Kimberly-Clark Corp., 817 F. Supp. 2d 1005 (E.D. Mich. 2011) (dismissing case on 12(b)(6) motion to dismiss based on lack of similarity in protectable elements) (The diaper jeans at issue in the case are reproduced in Appendix A.11.E.).

249.4. *See* Bird Brain, Inc. v. Menard, Inc., 2000 U.S. Dist. LEXIS 11668, at *23 (W.D. Mich. Aug. 4, 2000); Ronald Mayotte & Assocs. v. MGC Bldg. Co., 885 F. Supp. 148, 152–53 (E.D. Mich. 1994).

250. Kendall Holdings, Ltd. v. Eden Cryogenics LLC, 2008 U.S. Dist. LEXIS 106363 (S.D. Ohio June 20, 2008) (following *Kohus* but not referring to intended audience in evaluating catalog identities).

work).^{250.1} To determine whether the works are substantially similar in cases where the defendant makes no claim that plaintiff’s work consists of uncopyrightable elements, the D.C. Circuit applies the ordinary observer test.^{250.2} “The question is whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.”^{250.3}

In cases where the defendant contends that certain portions of plaintiff’s work are not copyright protected, however, the D.C. Circuit mandates a two-step filtration/comparison inquiry. “The first requires identifying which aspects of the artist’s work, if any, are protectible by copyright.”^{250.4} In that first step, the court filters out unprotectable elements such as ideas, facts, and *scènes à faire*. After completing filtration, the court next determines whether the allegedly infringing work is “substantially similar to the protectible elements of the artist’s work.”^{250.5} To make that comparison of filtered elements, the court uses the ordinary observer test to evaluate both individual elements and overall look and feel.^{250.6}

[A] Summary Judgment, Motion to Dismiss, and Preliminary Injunction

Summary judgment in copyright cases is “traditionally frowned on” in the D.C. Circuit.^{250.7} Courts should enter summary judgment for the defendant “only if the works are so dissimilar as to protectible elements that no reasonable jury could find for the plaintiff on the

250.1. See *Atkins v. Fischer*, 331 F.3d 988 (D.C. Cir. 2003); *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1297 (D.C. Cir. 2002); *Nelson v. Grisham*, 942 F. Supp. 649, 652 (D.D.C. 1996), *aff’d*, 132 F.3d 1481 (D.C. Cir. 1997), *cert. denied*, 522 U.S. 1148 (1998); *Prunté v. Universal Music Grp.*, 484 F. Supp. 2d 32, 41 (D.D.C. 2007) (on motion to dismiss) and 563 F. Supp. 2d 41, 43 (D.D.C. 2008) (on proposed motion for summary judgment). *But see* *Murray Hill Publ’ns, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 318 (6th Cir. 2004) (describing D.C. Circuit test as being closer to the Ninth Circuit).

250.2. See *Atkins*, 331 F.3d at 988; *Whitehead v. CBS/Viacom, Inc.*, 315 F. Supp. 2d 1 (D.D.C. 2004).

250.3. *Atkins*, 331 F.3d at 993 (quoting *Hamil Am., Inc. v. GFI, Inc.*, 193 F.3d 92, 100 (2d Cir. 1999), *cert. denied*, 528 U.S. 1160 (2000)); *Prunté*, 563 F. Supp. 2d at 43.

250.4. *Sturdza*, 281 F.3d at 1295.

250.5. *Id.* at 1296.

250.6. *Id.*; *Nelson*, 942 F. Supp. at 653–54.

250.7. *Atkins*, 331 F.3d at 994.

question of substantial similarity.”^{250.8} Courts in the D.C. Circuit do, however, grant summary judgment and motions to dismiss where no reasonable jury could find substantial similarity.^{250.9}

Courts in the D.C. Circuit evaluate motions for preliminary injunctions as they do in other types of cases: by means of a four-factor test employed on a sliding scale under which a particularly strong showing in one area can compensate for a weak showing in another.^{250.10}

§ 3:4 Eleventh Circuit

In the Eleventh Circuit, to establish a claim of copyright infringement, a plaintiff must prove, first, that he owns a valid copyright in a work and, second, that the defendant copied original elements of that work.²⁵¹ As in the Second Circuit, if he lacks direct evidence, plaintiff may prove actual copying by showing access and probative similarity.²⁵²

Substantial similarity exists where an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.²⁵³ “An ‘average lay observer’ presumably is an individual who, without any vested interest in the governing issue, is sufficiently informed and alert to identify precisely the differences

250.8. *Id.* (quoting *Sturdza*, 281 F.3d at 1297).

250.9. *See Prunty v. Vivendi*, 130 F. Supp. 3d 385, 390 (D.D.C. 2015) (no protectable elements); *Whitehead v. CBS/Viacom, Inc.*, 315 F. Supp. 2d 1 (D.D.C. 2004); *Nelson*, 942 F. Supp. at 656. *But see Nichols v. Club for Growth Action*, No. 16-220, 2017 WL 420111, at *6 (D.D.C. Jan. 31, 2017) (refusing to decide substantial similarity because not an “appropriate question on a motion to dismiss”).

250.10. *Health Ins. Ass’n of Am. v. Goddard Claussen Porter Novelli*, 211 F. Supp. 2d 23, 28 (D.D.C. 2002).

251. *Baby Buddies, Inc. v. Toys “R” Us, Inc.*, 611 F.3d 1308, 1315 (11th Cir. 2010); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1266 (11th Cir. 2001); *Leigh v. Warner Bros.*, 212 F.3d 1210, 1214 (11th Cir. 2000); *EarthCam, Inc. v. Oxblue Corp.*, 49 F. Supp. 3d 1210 (N.D. Ga. 2014).

252. *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1541–42 (11th Cir. 1996). *But see Baby Buddies*, 611 F.3d at 1315 (not distinguishing between probative similarity and substantial similarity).

253. *Baby Buddies*, 611 F.3d at 1315; *Suntrust Bank*, 268 F.3d at 1266; *Leigh*, 212 F.3d at 1214; *Fey v. Panacea Mgmt. Grp., LLC*, 261 F. Supp. 3d 1297 (N.D. Ga. 2017).

in the competing designs, yet sufficiently informed and independent to fairly identify and assess the similarities; that is, at a minimum, neither an engaged expert nor an oblivious passerby.”²⁵⁴

“No matter how the copying is proved, the plaintiff also must establish specifically that the allegedly infringing work is substantially similar to the plaintiff’s work *with regard to its protected elements*.”²⁵⁵ Expressed another way, “it must be determined both whether the similarities between the works are substantial from the point of view of the lay [observer] and whether those similarities involve copyrightable material.”²⁵⁶ Substantial similarity may come in the form of literal similarity, that is, verbatim copying, or nonliteral similarity, where the fundamental essence of structure of one work is duplicated in another.²⁵⁷ The works need not be similar overall; the court may find infringement when there is similarity with respect to material that is a substantial portion of the copyrighted work, that is, material that is of value to the copyright owner.²⁵⁸

The Eleventh Circuit has adopted a more stringent standard of “virtual identicality” to be used in evaluating similarity in the context of claims of compilation copyright infringement involving the nonliteral elements of a computer program.²⁵⁹ The standard calls for a greater similarity than substantial similarity. The court has made clear that use of the “virtual identicality” standard is to be limited to such computer compilation claims and is not to be used when the claims involve factual compilations.^{259.1} The “appropriate standard to resolve claims for the infringement of the selection, order and arrangement of a factual compilation is ‘substantial similarity.’”^{259.2}

254. *John Alden Homes*, 142 F. Supp. 2d at 1344 (quoting *Arthur Rutenberg Homes, Inc. v. Maloney*, 891 F. Supp. 1560, 1567 (M.D. Fla. 1995)).

255. *Leigh*, 212 F.3d at 1214 (emphasis in original). *Accord Baby Buddies*, 611 F.3d at 1315; *Bateman*, 79 F.3d 1532, 1541–42; *John Alden Homes*, 142 F. Supp. 2d at 1344.

256. *Herzog v. Castle Rock Entm’t*, 193 F.3d 1241, 1248 (11th Cir. 1999). *See also Bateman*, 79 F.3d at 1541–42.

257. *Bateman*, 79 F.3d at 1544.

258. *United States v. O’Reilly*, 794 F.2d 613, 615 (11th Cir. 1986).

259. *Mitek Holdings, Inc. v. Arce Eng’g Co.*, 89 F.3d 1548, 1558–59 (11th Cir. 1996).

259.1. *BUC Int’l Corp. v. Int’l Yacht Council Ltd.*, 489 F.3d 1129, 1148–49 (11th Cir. 2007); *Peter Letterese & Assocs. v. World Inst. of Scientology*, 533 F.3d 1287 (11th Cir. 2008).

259.2. *Peter Letterese*, 533 F.3d at 1301–02 n.17.

In testing for substantial similarity, courts in the Eleventh Circuit consider both similarities and dissimilarities, particularly with respect to architectural works.²⁶⁰ But the court of appeals has counseled that “lists of similarities between works are inherently subjective and unreliable, and the same can be true of lists of distinguishing characteristics.”²⁶¹ The Eleventh Circuit, like the Fifth Circuit, mandates side-by-side comparison of the protected elements of the plaintiff’s work and the alleged infringing work.²⁶²

In the Eleventh Circuit, a plaintiff who demonstrates that a defendant’s work is “strikingly similar” to his or her copyrighted work need not produce other evidence that the defendant had access to the copyrighted work in order to prove copying.²⁶³ “Striking similarity” is similarity that is “so great it precludes the possibility of coincidence, independent creation or common source.”²⁶⁴ Courts in the Eleventh Circuit, however, do *not* follow the Ninth Circuit’s “inverse-ratio rule,” which permits a lesser showing of similarity when there is more “convincing proof of access.”²⁶⁵

In one case only, *Herzog v. Castle Rock Entertainment*, the Eleventh Circuit borrowed from the Ninth Circuit and referred to an “extrinsic” test and an “intrinsic” test.²⁶⁶ The court explained that the extrinsic test is objective; it seeks to determine whether, as

260. See *Miller’s Ale House, Inc. v. Boynton Carolina Ale House, LLC*, 702 F.3d 1312 (11th Cir. 2012); *Oravec v. Sunny Isles Luxury Ventures, L.C.*, 527 F.3d 1218 (11th Cir. 2008) (The architectural works at issue in the case are reproduced in Appendix A.7.E.); *Howard v. Sterchi*, 974 F.2d 1272, 1275–76 (11th Cir. 1992); *John Alden Homes*, 142 F. Supp. 2d at 1345.

261. *Leigh*, 212 F.3d at 1215; *Herzog*, 193 F.3d at 1257. *Accord* *Baby Buddies, Inc. v. Toys “R” Us, Inc.*, 611 F.3d 1308, 1316 (11th Cir. 2010).

262. *Leigh v. Warner Bros.*, 10 F. Supp. 2d 1371, 1375 (S.D. Ga. 1998), *aff’d in part, rev’d in part and remanded*, 212 F.3d 1210 (11th Cir. 2000).

263. *Olem Shoe Corp. v. Wash. Shoe Corp.*, 591 F. App’x 873 (11th Cir. 2015) (The rain boots at issue in the case are reproduced in Appendix A.9.L.); *Herzog*, 193 F.3d at 1248.

264. *Benson v. Coca-Cola Co.*, 795 F.2d 973, 975 (11th Cir. 1986) (citing *Selle v. Gibb*, 741 F.2d 896 (7th Cir. 1984)).

265. *Dream Custom Homes, Inc. v. Modern Day Constr., Inc.*, 476 F. App’x 190, 192 (11th Cir. 2012); *Beal v. Paramount Pictures Corp.*, 20 F.3d 454, 460 (11th Cir.), *cert. denied*, 513 U.S. 1062 (1994); *Latele Television C.A. v. Telemundo Commc’ns Grp., LLC*, 2013 WL 1296314, at *8 n.5 (S.D. Fla. Mar. 26, 2013).

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

an objective matter, the works are substantially similar in protected expression.²⁶⁷ Part of that test includes determining whether the elements plaintiff seeks to protect are copyrightable.²⁶⁸ Expert testimony and analytic dissection are permitted in the extrinsic test.²⁶⁹ The intrinsic test is subjective; it seeks to “determine whether, upon proper instruction, a reasonable jury would find that the works are substantially similar.”²⁷⁰ The *Herzog* case appears to be an aberration. The subsequent *Leigh* case does not mention the extrinsic/intrinsic test.²⁷¹ Moreover, the court has stated that *Herzog* is “something of an anomaly” because the test had not previously been recognized in the circuit and had not been referenced in subsequent published decisions.^{271.1}

§ 3:4.1 Summary Judgment, Motion to Dismiss, and Preliminary Injunction

In the Eleventh Circuit, earlier cases have said that “[c]opyright infringement is generally a question of fact for the jury to decide.”²⁷² The more recent cases recognize that summary judgment is appropriate for a resolution of infringement issues, including substantial similarity, when “no reasonable jury could differ in weighing the evidence.”²⁷³ The court may grant summary judgment for a defendant if the similarity between the two works concerns only noncopyrightable elements or if no reasonable jury would find that the

267. *Id.*

268. *Id.*

269. *Id.*

270. *Id.*

271. *Leigh v. Warner Bros.*, 10 F. Supp. 2d 1371 (S.D. Ga. 1998), *aff'd in part, rev'd in part and remanded*, 212 F.3d 1210 (11th Cir. 2000).

271.1. *Oravec v. Sunny Isles Luxury Ventures, L.C.*, 527 F.3d 1218, 1224 n.5 (11th Cir. 2008). *See* *Latele Television C.A. v. Telemundo Commc'ns Grp., LLC*, 2013 WL 1296314, at *11 (S.D. Fla. Mar. 26, 2013). *But see* *Latele Television, C.A. v. Telemundo Commc'ns Grp., LLC*, 2014 WL 7150626 (S.D. Fla. Dec. 15, 2014) (following *Herzog*).

272. *Oravec*, 527 F.3d at 1213; *cf.* *White v. Alcon Film Fund*, 53 F. Supp. 3d 1308, 1315–16 (N.D. Ga. 2014).

273. *Oravec*, 527 F.3d at 1216; *Arthur Rutenberg Homes, Inc. v. Jewel Homes, LLC*, 655 F. App'x 807, 811–12 (11th Cir. 2016); *Fey v. Panacea Mgmt. Grp., LLC*, 261 F. Supp. 3d 1297, 1312–13 (N.D. Ga. 2017).

two works are substantially similar.²⁷⁴ For the same reason, the court may grant a motion to dismiss.^{274.1}

On a motion for a preliminary injunction, courts in the Eleventh Circuit seek to determine whether the average lay observer would find the works substantially similar as part of their evaluation of plaintiff's likelihood of success.²⁷⁵

§ 3:5 Federal Circuit

The Federal Circuit decides copyright infringement claims according to the law of the regional circuit of the district court from which the appeal is taken.²⁷⁶ Thus, for example, when hearing an appeal of a copyright infringement decision from the District of Massachusetts, the Federal Circuit applies the standards used by the First Circuit.²⁷⁷ Application of the law of the regional circuit with respect to copyright infringement claims includes appli-

274. Home Design Servs., Inc. v. Turner Heritage Homes, Inc., 825 F.3d 1314, 1326–27 (11th Cir. 2016) (affirming grant of JNOV motion finding lack of substantial similarity as a matter of law); Miller's Ale House, Inc. v. Boynton Carolina Ale House, LLC, 702 F.3d 1312 (11th Cir. 2012); Baby Buddies, Inc. v. Toys “R” Us, Inc., 611 F.3d 1308, 1314 (11th Cir. 2010); *Herzog*, 193 F.3d at 1257. *See also* EarthCam, Inc. v. Oxblue Corp., 49 F. Supp. 3d 1210 (N.D. Ga. 2014).

274.1. Tolbert v. High Noon Prods., LLC No. 4:18-cv-00680, 2019 WL 127363 (N.D. Ala. Jan. 8, 2018) (denying motion and refusing to consider merits of complaint without submission of complete works); Sieger Suarez Architectural P'ship, Inc. v. Arquitectonica Int'l Corp., 998 F. Supp. 2d 1340 (S.D. Fla. 2014). *But see* Stripteaser, Inc. v. Strike Point Tackle, LLC, No. 13-62742-CIV, 2014 WL 866396, at *4 (S.D. Fla. Mar. 5, 2014) (motion to dismiss not the “proper vehicle” to challenge the substance of an infringement claim).

275. Palmer v. Braun, 287 F.3d 1325, 1330–31 (11th Cir. 2002); Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1266 (11th Cir. 2001).

276. Oracle Am., Inc. v. Google, Inc., 750 F.3d 1339, 1353 (Fed. Cir. 2014); Hutchins v. Zoll Med. Corp., 492 F.3d 1377, 1383 (Fed. Cir. 2007); PODS, Inc. v. Porta Stor, Inc., 484 F.3d 1359, 1368–69 (Fed. Cir.), *cert. denied*, 128 S. Ct. 618 (2007); Amini Innovation Corp. v. Anthony Cal., Inc., 439 F.3d 1365, 1368 (Fed. Cir. 2006); Chamberlain Grp., Inc. v. Skylink Techs., Inc., 381 F.3d 1178, 1191 (Fed. Cir. 2004), *cert. denied*, 544 U.S. 923 (2005).

277. *Hutchins*, 492 F.3d at 1383.

cation of the regional circuit's standards with respect to summary judgment.²⁷⁸

§ 3:6 Preliminary Injunction Standards

For many years, the prevailing view among the circuits was that a copyright claimant need only make a *prima facie* showing of likelihood of success on the merits to be entitled to a preliminary injunction.²⁷⁹ The courts based a presumption of irreparable harm in considering an application for a preliminary injunction on the nature of a copyright interest and the notorious difficulty in proving loss of sales due to infringement.²⁸⁰ A similar presumption was used in the consideration of an application for a preliminary injunction in patent and trademark cases.

The Supreme Court in *eBay Inc. v. MercExchange, LLC* prohibited the use of such a presumption in patent cases, stating that it “cannot be squared with the principles of equity adopted by Congress.”²⁸¹ Since *eBay*, the circuits that have considered the issue have concluded that the reasoning in *eBay* prohibits presuming irreparable harm in copyright cases.²⁸² The Ninth Circuit wrote in *Flexible Lifeline*:

Thus our long-standing precedent finding a plaintiff entitled to a presumption of irreparable harm on a showing of likelihood of success on the merits on a copyright infringement case, as stated in *Elvis Presley* and relied on by the district court, has been effectively overruled. In other words, “*Elvis* has left the building.” Accordingly, we hold that even in a copyright infringement case, the plaintiff must demonstrate a likelihood of irreparable harm as a prerequisite for injunctive relief, whether preliminary or permanent.²⁸³

278. *Chamberlain Grp.*, 381 F.3d at 1191; *see also Amini Innovation*, 439 F.3d at 1368.

279. *See Flexible Lifeline Sys., Inc. v. Precision Lift, Inc.*, 654 F.3d 989, 1001 n.3 (9th Cir. 2011) (per curiam).

280. *Salinger v. Colting*, 607 F.3d 68, 81 (2d Cir. 2010).

281. *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388, 393–94 (2008).

282. *Flava Works, Inc. v. Gunter*, 689 F.3d 754, 755 (7th Cir. 2012); *Flexible Lifeline Sys.*, 654 F.3d at 996; *Perfect 10, Inc. v. Google, Inc.*, 653 F.3d 976 (9th Cir. 2011); *Salinger*, 607 F.3d at 82; *Christopher Phelps & Assocs. LLC v. Galloway*, 492 F.3d 532 (4th Cir. 2007).

283. *Flexible Lifeline Sys.*, 654 F.3d at 998.

The traditional equitable showing must be made on an application for injunctive relief in a copyright case. Therefore, the applicant's showing must include that:

1. Failure to issue an injunction will actually cause irreparable harm;
2. Remedies available at law, such as monetary damages, are inadequate to compensate for that injury;
3. The balance of hardships between the parties favors the applicant; and
4. Issuance of the injunction is not contrary to the public interest.²⁸⁴

As before, the applicant's showing must include a likelihood of success on the merits.²⁸⁵ The tests used in the circuits to determine likelihood of success on the merits are discussed above in sections 3:1 through 3:5.

284. *eBay*, 547 U.S. at 393.

285. *Salinger*, 607 F.3d at 80.

