

Chapter 3

Tests for Substantial Similarity

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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.

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

(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.

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.

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 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 noncopyrightable 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

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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.
 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).

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 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

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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.”).
 14. *Knitwaves, Inc. v. Lollytogs Ltd., Inc.*, 71 F.3d 996, 1002 (2d Cir. 1995) (citing *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 766 (2d Cir. 1991)); *Laureysens*, 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.
 16. *Hamil Am.*, 193 F.3d at 102.
 17. *Arnstein*, 154 F.2d at 468, 473. See our discussion of expert testimony in section 16:1 for explanation of exceptions to the general rule.
 18. *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001).

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 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

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19. *Knitwaves*, 71 F.3d at 1002; *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 *City Merchandise Inc.* are illustrated in Appendix A.I.F.
 20. *Knitwaves*, 71 F.3d at 1002.
 21. *Id.* at 1003; *Folio Impressions*, 937 F.2d at 765–66; *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. *Hallford v. Fox Entm’t Grp. Inc.*, 2013 WL 2124524 (S.D.N.Y. Feb. 13, 2013); see cases cited in note 22, *supra*.
 24. *Boisson v. Banian, Ltd.*, 273 F.3d 262 (2d Cir. 2001).
 25. *Id.* at 273.

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 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:

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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.

“given that access has been conceded, the level of probative 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}

[D] Summary Judgment, Motions 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, 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 That principle is at odds with the Ninth Circuit approach. As we discuss in section 3:2, the Ninth Circuit seems to require a trial if plaintiff prevails in the extrinsic portion of the extrinsic/intrinsic test; courts in the Ninth Circuit cannot make a

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- 26.4. *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).
 - 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.*
 - 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., Inc. 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); *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).

substantial similarity determination based on the fact that no reasonable juror could find otherwise when the plaintiff passes the extrinsic test.

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 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}

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

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- 28.1. *Vargas 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). *See also* *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. 2009); *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).
- 28.3. *Peter F. Gaito Architecture*, 2010 WL 1337225, at *6. *See also* *Blakeman*, 613 F. Supp. 2d at 298.
29. *Laureyssens v. Idea Grp., Inc.*, 964 F.2d 131, 139-43 (2d Cir. 1992).

Ninth Circuit cases frequently. As in the Second Circuit, courts in the First Circuit determine whether there has been copying first.³⁰ Copying 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

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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 (3d 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.), *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 Props., 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. *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; *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.

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 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}

Like the Seventh Circuit, the First Circuit evaluates infringement on a sliding scale.⁴⁰ When there is only one way to express

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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)); *Arvelo*, 875 F. Supp. at 100; *Little Souls*, 789 F. Supp. at 58.
 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.
 - 39.2. *Id.* at 179 n.6.
 40. *Concrete Mach.*, 843 F.2d at 607. We discuss the Seventh Circuit’s sliding scale in section 3:1.5.

an idea, merger bars any claim of infringement.⁴¹ “When the idea and its expression are not 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 and Preliminary Injunction

Courts in the First Circuit apply the ordinary observer test to determine substantial similarity in both the summary judgment 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 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

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41. *Concrete Mach.*, 843 F.2d at 606.
 42. *Id.* at 606–07; *Yankee Candle*, 99 F. Supp. 2d at 150.
 43. *Concrete Mach.*, 843 F.2d at 607.
 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); *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; *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.
 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).
 48. See *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).

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 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

As in the Second Circuit, substantial similarity that proves copying means that there is sufficient similarity between the two works in question to conclude that the accused infringer used the copyrighted work in making his work.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

Substantial similarity to prove copying is 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

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*.

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; *CMM Cable Rep.*, 870 F. Supp. at 637.

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 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

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 Grp.*, 800 F. Supp. at 1233.

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.

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).

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 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

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).

69. *See Dam Things from Denmark v. Russ Berrie & Co.*, 290 F.3d 548, 562 (3d Cir. 2002). 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).

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

When deciding a motion for summary judgment, the court evaluates substantial similarity by making a side-by-side comparison of the works through the eyes of the layman.⁷² Similarly, 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 One district court declined to review the works themselves on a motion to dismiss, evaluating only the allegations in the complaint at that stage.^{73.1}

[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.

72. *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 908 (3d Cir. 1975).

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

73.1. *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).

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.

§ 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 copying; copying plus substantial similarity equals infringement.⁷⁸ 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 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

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).

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); *Computer 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).

79. *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*.

overlook them and regard their aesthetic appeal as the same.⁸² Under the Fifth 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, use the more discerning ordinary observer test.⁸⁴

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

In the Fifth Circuit, as in the Second, 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, but the court may enter summary judgment if no reasonable juror could find the works substantially similar.⁸⁵ One district court in the Fifth Circuit has ruled that a court may make that analysis on a motion to dismiss,^{85.1} and the Fifth Circuit upheld such a dismissal on an alternative basis in an unpublished opinion.^{85.2} On a motion for a 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

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).

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).

85. *Gen. Universal Sys.*, 379 F.3d at 142; *Peel & Co.*, 238 F.3d at 395; *Creations Unlimited*, 112 F.3d at 816; *R. Ready Prods.*, 85 F. Supp. 2d 672.

85.1. *Randolph v. Dimension Films*, 630 F. Supp. 2d 741, 746 (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”), *aff’d*, 381 F. App’x 449 (5th Cir.), *cert. denied*, 2010 WL 3617171, 79 U.S.L.W. 3149 (2010).

85.2. *Taylor v. IBM*, 54 F. App’x 794 (5th Cir. 2002).

86. *Worlds of Wonder, Inc. v. Veritel Learning Sys.*, 658 F. Supp. 351, 355 (N.D. Tex. 1986).

§ 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

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

Like courts in the Fifth and Eleventh Circuits, 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

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* *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; *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 284 F. Supp. 2d 1069, 1080 (N.D. Ill. 2003); *S.A.M. Elecs., Inc. v. Osaraprasop*, 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*.

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.

92. See *Ty, Inc. v. GMA Accessories, Inc.*, 959 F. Supp. 936, 942 (N.D. Ill. 1997).

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 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

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 Scott v. WKJG, Inc.*, 376 F.2d 467, 469 (7th Cir.), *cert. denied*, 389 U.S. 832 (1967).

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.

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

[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 and Preliminary Injunction

Courts in the Seventh Circuit may enter summary judgment for the defendant when no reasonable juror using the criteria discussed above could find that the two works are substantially

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).

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.

similar,¹⁰² and for the plaintiff when no reasonable 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

§ 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 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

102. See *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.

103. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 50 F. Supp. 2d 863, 870–71 (W.D. Wis. 1998).

104. *Atari*, 672 F.2d at 614–20.

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.*

109. *Id.*

110. *Id.* See also *Swirsky v. Carey*, 376 F.3d 841 (9th Cir. 2004).

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 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.

111. *Id.* at 1165.

112. *Id.*

113. *Id.* at 1164.

114. *Id.*

115. *Id.*

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.

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

[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 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

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

121. *Id.* at 1357. *See also* *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)).

125. *Shaw*, 919 F.2d at 1357.

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

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.

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 Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184 (1995); *Chase-Riboud v. Dreamworks, Inc.*, 987 F. Supp. 1222, 1226 (C.D. Cal. 1997).

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.

[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 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

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

132. *Id.* at 1356.

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).

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}

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}

[F] Summary Judgment Under the Extrinsic/ Intrinsic Test

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 to *Shaw*, if the extrinsic test favors the defendant, summary judgment should be entered in defendant’s favor.¹⁴¹ But

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.

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.

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

139.1. *Bensbargains.Net, LLC v. Xpbargains.Com*, 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)).

140. *Shaw*, 919 F.2d at 1359. *Contra See v. Durang*, 711 F.2d 141, 142–43 (9th Cir. 1983).

141. *Id.*; *Rice*, 330 F.3d at 1180; *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994).

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

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

142. *Smith*, 84 F.3d at 1218; *Kouf*, 16 F.3d at 1045; *Shaw*, 919 F.2d at 1358.

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 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."

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
- (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*

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).

150. *Id.* at 1475–77.

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. Warner Bros. Entm’t, Inc.*^{154.2} in 2010. In another 2006 case, the Federal Circuit, applying Ninth Circuit copyright jurisprudence, held that it was error for the district judge to engage in intrinsic analysis on a motion for summary judgment.^{154.3} In *Hit Entertainment, Inc. v. National Costume Co.*,^{154.4} the district court proceeded with intrinsic analysis and denied summary judgment for the copyright owner only after evaluating the total concept and feel

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

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.*, 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* *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).

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

154.3. *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1370 (Fed. Cir. 2006).

154.4. *Hit Entm’t, Inc. v. Nat’l Costume Co.*, 552 F. Supp. 2d 1099 (S.D. Cal. 2008). Photographs of the costumes at issue in the *Hit Entertainment* case appear in Appendix A.12.B.

of the similarities.^{154.5} That case appears to be an aberration. In *L.A. Printex Indus., Inc. v. Aeropostale*,^{154.6} the Ninth Circuit reiterated that on a summary judgment motion it is not correct for a court to apply the subjective, fact-oriented intrinsic test.

[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

[H] Difficulties in Applying the Extrinsic/Intrinsic Test

In summary, 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}

154.5. *Id.* at 1107.

154.6. *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 852 (9th Cir. 2012).

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; *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.”).

156.1. *Jada Toys, Inc.*, 518 F.3d at 637 (citing and quoting *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994)).

The test is not easy to understand and often 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

[I] Motions to Dismiss

The court granted defendants’ Rule 12(b)(6) motion to dismiss based on a lack of substantial similarity in *Wild v. NBC Universal, Inc.*^{159.1} The court applied the extrinsic test only, and concluded that plaintiff could not pass it. We are not aware of any Ninth Circuit Court of Appeals case addressing whether it is permissible to adjudicate substantial similarity on a motion to dismiss.

§ 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 Circuit’s extrinsic test, “a plaintiff must show—typically with the aid of expert testimony—that the works in question are

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.*

159.1. *Wild v. NBC Universal, Inc.*, 788 F. Supp. 2d 1083 (C.D. Cal. 2011).

160. *See 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).

extrinsically similar because they contain substantially similar ideas 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’] ideas are expressed.”¹⁶⁶ In the second part of the test, the Fourth Circuit, like the Ninth, compares the “total concept and feel” of the two works.¹⁶⁷

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

161. *Towler*, 76 F.3d at 583; *Accord Lyons*, 243 F.3d at 801.

162. *Towler*, 76 F.3d at 583; *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. *Lyons*, 243 F.3d at 801; *Towler*, 76 F.3d at 583.

167. See cases cited in notes 162 and 166, *supra*; *Dawson*, 905 F.2d at 732–33; *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.

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

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

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

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

170. *Id.* at 736–37.

171. *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.

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

174. *Id.*

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

[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 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

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

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

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.

[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 cases.¹⁸⁵ In *Computer Associates Int'l, 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

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.

185. *E.g.*, *Johnson Controls, Inc. v. Phoenix 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. *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 713–14 (2d Cir. 1992).

187. *Id.*

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 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

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).

191. *Id.* at 802–83.

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 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

192. *Id.*

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

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).

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).

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. Other than the exceptions noted above 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

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).

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); Segrets, Inc. v. Gillman Knitwear Co., 207 F.3d 56, 62 (1st Cir. 2000); 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* Kohus v. Mariol, 328 F.3d 848, 857 (6th Cir. 2003) (adopting the intended audience test); 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

the intended audience test may be further complicated if one party's work is marketed to a different group.

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

Courts in the Fourth Circuit 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 One district court has held that a court may evaluate the similarity of the works 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 decided after *Krofft* and before the objective/subjective test of *Shaw*.²⁰¹ In *Moore v. Columbia Pictures Industries, Inc.*, the Eighth Circuit

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).

- 199. *See Towler v. Sayles*, 76 F.3d 579 (4th Cir. 1996); *Hennon v. Kirklands, Inc.*, 870 F. Supp. 118 (W.D. Va. 1994); *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); *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. *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).
- 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).

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 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

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); *Monarch Prods., LLC v. Zephyr Grafex, Inc.*, No. 4:09-CV-02049, 2010 WL 3782040, at *2 (E.D. Mo. Sept. 22, 2010).

204. *Rottlund Co.*, 452 F.3d at 731–32. Also see cases cited in note 203, *supra*.

204.1. *Taylor Corp. v. Four Seasons Greetings, LLC*, 403 F.3d 958, 966 (8th Cir. 2005); *Sun Media Sys., Inc. v. KDSM, LLC*, 576 F. Supp. 2d 1018, 1022 (S.D. Iowa 2008).

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

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

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

§ 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

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 Investors, 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).

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).

209. [Reserved.]

210. *See Country Kids ’N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1284 (10th Cir. 1996); *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.

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 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

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. LP 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*.

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. See cases cited in note 215, *supra*. See also *Vasquez v. Ybarra*, 150 F. Supp. 2d 1157 (D. Kan. 2001). But see *Blehm*, 702 F.2d at 1200–03.

217. *Madrid v. Chronicle Books*, 209 F. Supp. 2d 1227, 1234–36 (D. Wyo. 2002).

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

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

218. *Country Kids 'N City Slicks v. Sheen*, 77 F.3d 1280, 1285 (10th Cir. 1996).

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.

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 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}

222. In addition to the cases discussed in the text, see *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).

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). Images 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)).

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*.”

[A] Summary Judgment 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 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

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).

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

227. *See 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, Inc. v. Sheen*, 77 F.3d 1280, 1288 (10th Cir. 1996); *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.

test.²³¹ In general, courts in the Sixth Circuit did not make distinctions 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 independently created by the inventor [sic], and that possess no minimal degree of creativity—through a

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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).
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. *Bridgeport Music, Inc. v. UMG Recordings, Inc.*, 585 F.3d 267, 274 (6th Cir. 2009); *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.
- 234.3. *R.C. Olmstead*, 606 F.3d at 275; *Bridgeport*, 585 F.3d at 274.
- 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).

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 Publ'ns, 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 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

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. Foxx*, 502 F. Supp. 2d 620, 623 (E.D. Mich. 2007).

236. *Kohus*, 328 F.3d at 855–56.

237. *Id.*

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. ¶ 29,012 (W.D. Ky. 2005).

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 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}

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.

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).

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

[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}

One district court has held that a court may grant a motion to dismiss if it determines that the works at issue are not substantially similar.^{249.2}

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.^{249.3} 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

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); *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. *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 illustrated in Appendix A.11.E).

249.3. 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).

similarity) and the need to show substantial similarity (that the copying is actionable because defendant copied protected portions of plaintiff's 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 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

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.

protectible elements that no reasonable jury could find for the plaintiff on the question of substantial similarity.”^{250.8} Courts in the D.C. Circuit do, however, grant summary judgment 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 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

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

250.9. *See Whitehead v. CBS/Viacom, Inc.*, 315 F. Supp. 2d 1 (D.D.C. 2004); *Nelson*, 942 F. Supp. at 656.

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., Inc.*, 212 F.3d 1210, 1214 (11th Cir. 2000).

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.

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)).

“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}

In testing for substantial similarity, courts in the Eleventh Circuit consider both similarities and dissimilarities, particularly

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.

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 an objective matter, the works are substantially similar in protected expression.²⁶⁷ Part of that test includes determining whether the

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 illustrated 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., Inc.*, 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. *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).

267. *Id.*

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 has not been referenced in subsequent published decisions.^{271.1}

§ 3:4.1 Summary Judgment and Preliminary Injunction

In the Eleventh Circuit, “[c]opyright infringement is generally a question of fact for the jury to decide.”²⁷² Courts may grant summary judgment only 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 two works are substantially similar.²⁷⁴

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

268. *Id.*

269. *Id.*

270. *Id.*

271. *Leigh v. Warner Bros., Inc.*, 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).

272. *Oravec*, 527 F.3d at 1213.

273. *Id.* at 1216.

274. *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.

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).

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 application 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*:

276. *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.

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 & Associates LLC v. Galloway*, 492 F.3d 532 (4th Cir. 2007).

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

It now seems clear that the traditional showing must be made on an application for injunctive relief in a copyright case, and the applicant must show:

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

In addition, the applicant must show 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.

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

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

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

