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### Saving Substantial Similarity, 73 Fla. L. Rev. 591 (2021)

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## SAVING SUBSTANTIAL SIMILARITY

*Daryl Lim*\*

### Abstract

Substantial similarity, an analysis of the similarity between two works, is the fulcrum of copyright infringement. Recent cases involving Led Zeppelin’s signature song “Stairway to Heaven,” the award-winning movie “The Shape of Water,” and Google and Oracle’s dispute over computer code all required courts to grapple with this fundamental analysis. This Article reveals that today’s copyright plaintiffs have only a one-in-ten chance of winning—the worst in a century—and also discusses the cause of this trend—defendants’ devastatingly effective use of pretrial motions and the rise of lawsuits against nonrival defendants. Scholarly debates on substantial similarity typically revolve around the works of authorship at issue, circuit splits, and leading cases. These discussions entirely miss the unprecedented and unreported demise of substantial similarity.

Rehabilitating the doctrine will require a fresh look at how to judge substantial similarity. Judging when defendants appropriated too much can be an inherently opaque and subjective enterprise. To many courts and scholars, substantial similarity is “bizarre,” “ad hoc,” and “a virtual black hole in copyright jurisprudence.” Every creative work borrows some inspiration from other works, whether copyrighted or not. If left theoretically unaddressed, the law will continue adrift without compass or rudder, inhibiting the growth of creative industries. Helping plaintiffs win fairly and viably will be critical in fostering diverse, innovative ecosystems like architecture, literature, movies, and software flourish. For this to happen, three things must change.

First, courts must judge works holistically from the vantage of an ordinary observer and, once plaintiffs prove facial similarity, defendants should then explain why they are not infringing. Avoiding elemental dissections of the copyrighted work makes substantial similarity easier for fact finders to administer, which makes them less likely to penalize plaintiffs whose works invariably incorporate some unprotectable

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elements. Second, jurors must be the default arbiters of substantial similarity. Laypeople, and not experts, are copyright's principal audience. Third, courts must require copyright registrants to identify the expressive elements of the works in their registrations, which will help clarify what they seek to protect and provide better notice to defendants. Beyond copyright, the observations and insights in this Article map to broader scholarly debates on rules versus standards, the centrality of jury trials, and structural biases within the American justice system.

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INTRODUCTION

Substantial similarity, an analysis of the similarity between two works, is the fulcrum of copyright law.<sup>1</sup> Recent cases involving Led Zeppelin’s signature song “Stairway to Heaven,” the award-winning movie “The Shape of Water,” and Google and Oracle’s dispute over their computer code all required courts to grapple with this fundamental analysis.<sup>2</sup> After establishing that defendants copied plaintiffs’ works, the substantial similarity doctrine requires courts to determine whether defendants took “enough” from plaintiffs by seeing if the copy was a misappropriated, colorable variation of the original.<sup>3</sup> Its complexity rivals copyright law’s fair-use defense.<sup>4</sup> Judges and scholars have called the court-developed tests to assess substantial similarity “ad hoc,”<sup>5</sup> “bizarre,”<sup>6</sup> and “a virtual black hole in copyright jurisprudence.”<sup>7</sup> The

1. See Lydia Pallas Loren & R. Anthony Reese, *Proving Infringement: Burdens of Proof in Copyright Infringement Litigation*, 23 LEWIS & CLARK L. REV. 621, 646 (2019) (“The inquiry into substantial similarity is, in some ways, the heart of many infringement cases.”).

2. See *Skidmore v. Led Zeppelin*, 952 F.3d 1051, 1056, 1065, 1067 (9th Cir. 2020) (en banc), cert. denied sub nom. *Skidmore v. Zeppelin*, No. 20-142, 2020 WL 5883816 (U.S. Oct. 5, 2020); *Zindel v. Fox Searchlight Pictures, Inc.*, 815 F. App’x 158, 159–60 (9th Cir. 2020); *Oracle Am., Inc. v. Google LLC*, 886 F.3d 1179, 1185, 1205 (Fed. Cir. 2018), cert. granted, 140 S. Ct. 520 (2019).

3. See Shyamkrishna Balganesch et al., Essay, *Judging Similarity*, 100 IOWA L. REV. 267, 268, 288–89 (2014) (describing substantial similarity as “an essential component of almost all copyright infringement actions that do not involve outright copying by a defendant”).

4. Shyamkrishna Balganesch, *The Questionable Origins of the Copyright Infringement Analysis*, 68 STAN. L. REV. 791, 794 (2016) (“The complexity of the modern copyright infringement analysis cannot be overstated. Often referred to as the ‘substantial similarity’ requirement, its structure, scope, and purpose continue to confound courts and scholars—perhaps even more so (and more routinely) than the infamous fair use doctrine.”); see also 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A], Lexis+ (database updated Aug. 2020) (recognizing the substantial similarity doctrine as “one of the most difficult questions in copyright law”); Pamela Samuelson, Essay, *A Fresh Look at Tests for Nonliteral Copyright Infringement*, 107 NW. U. L. REV. 1821, 1822 (2013) (describing substantial similarity as “[a] central puzzle for U.S. copyright law in the twentieth and twenty-first centuries”).

5. *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (opinion of Judge Learned Hand).

6. Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 J. COPYRIGHT SOC’Y U.S.A. 719, 719 (2010) (referring to the substantial similarity doctrine in the title).

7. Balganesch, *supra* note 4, at 794; see also Samuelson, *supra* note 4, at 1823 (arguing each of these tests is flawed and that courts have generally failed to provide clear guidance about which test to apply in which kinds of cases); Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright*, 125 HARV. L. REV. 683, 716–38 (2012) (critiquing the tests).

debate has gone on for decades, with no end in sight.<sup>8</sup> To make matters worse, courts must apply these tests across a diverse set of industries and creative products.<sup>9</sup>

As a result, lawyers cannot adequately evaluate claims of copyright infringement that they receive.<sup>10</sup> Unlike patent law, where courts can rely on claims to delineate the boundaries of their plaintiff's property rights (even if claim construction methodologies are underdetermined and the results of applying them may vary), substantial similarity's indefiniteness gives rise to no more than "the right to hire a lawyer."<sup>11</sup> Despite circuit court divisions over tests for substantial similarity, the U.S. Supreme Court has remained silent.<sup>12</sup>

The problem is that judging substantial similarity demands courts to apply subjective, value-based judgments to the facts without clear guidance on how to do so. The result is a patchwork of rhetoric resting on confusing generalizations that ultimately translate into "I'll know it

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8. See, e.g., Shyamkrishna Balganesh, *The Normativity of Copying in Copyright Law*, 62 DUKE L.J. 203, 214 (2012) (viewing substantial similarity as a mechanism of conceptually sequencing values in copyright law and informing a more coherent framework for the fair-use doctrine); Kevin J. Hickey, *Reframing Similarity Analysis in Copyright*, 93 WASH. U. L. REV. 681, 718–19 (2016) (arguing courts should adopt a flexible, contextual approach to framing); Daniel Gervais, *Improper Appropriation*, 23 LEWIS & CLARK L. REV. 599, 600 (2019) (suggesting that propriety should play an enhanced role in cases of reuse of preexisting copyrighted works); Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 1005 (1990) ("The determination of substantial similarity is largely subjective, thus permitting the finder of fact to give effect to its intuitive judgment of the perceived equities in a case."); Katherine Lippman, Comment, *The Beginning of the End: Preliminary Results of an Empirical Study of Copyright Substantial Similarity Opinions in the U.S. Circuit Courts*, 2013 MICH. ST. L. REV. 513, 541 ("[T]here can be no doubt that the substantial similarity doctrine has perplexed students, scholars, and courts for decades.").

9. See Michael L. Sharb, *Getting A "Total Concept and Feel" of Copyright Infringement*, 64 U. COLO. L. REV. 903, 904 (1993) (arguing that "the ad hoc nature of copyright infringement" requires a flexible test, and "[y]et, there must be a common structure in order for the courts, as in other areas of the law, to build an underlying body of substantive common law"); see also Samuelson, *supra* note 4, at 1821 (arguing for courts "to tailor infringement analysis based on the nature of the works at issue"); Nicole Lieberman, Note, *Un-Blurring Substantial Similarity: Aesthetic Judgments and Romantic Authorship in Music Copyright Law*, 6 NYU J. INTELL. PROP. & ENT. L. 91, 93 (2016) ("[C]ourts have crafted an impressionistic doctrine that has drifted far from copyright's original economic purpose of incentivizing creation.").

10. Robert F. Helfing, *Substantial Similarity and Junk Science: Reconstructing the Test of Copyright Infringement*, 30 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 735, 737 (2020) ("The elusive standard frustrates the effective evaluation of claims by lawyers, generating unnecessary litigation."); see also Nicole K. Roodhuyzen, Note, *Do We Even Need A Test? A Reevaluation of Assessing Substantial Similarity in a Copyright Infringement Case*, 15 J.L. & POL'Y 1375, 1375 (2007) ("The improper appropriation analysis, for both courts and litigants, is one of the most contentious and least precisely defined inquires in copyright law." (footnote omitted)).

11. LAWRENCE LESSIG, FREE CULTURE 187 (2004) (referring to fair use).

12. See *infra* notes 165–166 and accompanying text.

when I see it” determinations.<sup>13</sup> This indeterminacy is troubling. Blindly navigating the morass of caselaw on substantial similarity without understanding its contours risks defeating the purpose of copyright law itself.<sup>14</sup>

It is worth noting at this early stage that there are two problems: variability (because of the different tests applied in different circuits) and uncertainty (given that none of the tests have determinate content). The variability leads to different results concerning the uncertainty of when courts apply a given test to a large sample of cases. Failing to understand how substantial similarity works prevents courts and scholars from clearly outlining the necessary components of plaintiffs’ evidence in infringement cases and obscures the standards courts should identify in the cases before them.<sup>15</sup> This state of affairs may result in false positives and chill efforts by rivals, as well as those in ancillary markets, from developing noninfringing works, and it may even cause them to abandon their efforts if they cannot afford to face those unnecessarily heightened risks.<sup>16</sup> Unaddressed, copyright law will continue adrift without compass or rudder, inhibiting the growth of creative industries.

The American economy rests at a transcendent and transformative inflection point in its history, and the vitality of the substantial similarity doctrine forms an essential part of it. The stakes for getting the law on substantial similarity right are high. In 2017, copyright industries in the United States contributed over \$1 trillion to the gross domestic product, accounted for almost 7% of the U.S. economy, and employed about 6 million workers, comprising close to 4% of the entire workforce in the

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13. See NIMMER & NIMMER, *supra* note 4, § 13.03[A] (“The determination of the extent of similarity [which] will constitute a *substantial*, and hence infringing, similarity presents one of the most difficult questions in copyright law, and one which is the least susceptible of helpful generalizations.” (footnote omitted)); Hickey, *supra* note 8, at 682 (“[S]ubstantial similarity, copyright law’s core infringement inquiry, is a mess. Once the law allows that non-exact copies are actionable, courts need some method to determine when two works are so alike that one should be deemed an actionable infringement of the other.”); Jarrod M. Mohler, Comment, *Toward a Better Understanding of Substantial Similarity in Copyright Infringement Cases*, 68 U. CIN. L. REV. 971, 972 (2000) (describing the “indeterminacy and misapplication of tests for copyright infringement”).

14. See *Helfing*, *supra* note 10, at 737 (“It also produces legal decisions that defeat the purposes of copyright law more often than should be tolerated.”).

15. See Alan Latman, “*Probative Similarity*” as Proof of Copying: *Toward Dispelling Some Myths in Copyright Infringement*, 90 COLUM. L. REV. 1187, 1188 (1990) (arguing that a correct perception of the nature of similarity is necessary to “clarify the elements of proof required in copyright infringement cases, the variety of methods available to establish those elements and the proper standards for appellate review of infringement issues”).

16. See Joseph P. Fishman, *Creating Around Copyright*, 128 HARV. L. REV. 1333, 1387 (2015) (describing the “added layer of perniciousness” of overclaiming stemming from uncertain copyright scope for downstream creators and concluding that clarity “may not only decrease constraint’s costs but also increase its benefits”).

United States.<sup>17</sup> In 2018, litigants filed nearly 6,000 copyright infringement cases, a threefold increase from the number of cases filed a decade ago.<sup>18</sup> On average, copyright cases cost between \$200,000 and \$1 million to litigate.<sup>19</sup>

The most important and immediate benefit of reforming substantial similarity is that plaintiffs will once again have a viable means of enforcing their copyrights when they *should* be able to prove improper, actionable infringement. Today, copyright plaintiffs have only a one-in-ten chance of winning—the worst in a century.<sup>20</sup> Giving copyright plaintiffs a reasonable opportunity to win meritorious lawsuits benefits the flourishing of diverse, creative ecosystems like architecture, literature, movies, and software.<sup>21</sup>

Scholarly debates on substantial similarity typically revolve around the works of authorship at issue, circuit splits, and leading cases; they have entirely missed the unprecedented and unreported demise in copyright plaintiffs' ability to prove substantial similarity.<sup>22</sup> This Article reveals that defendants' devastatingly effective use of pretrial motions and the courts' focus on market effect as a heuristic are the two key culprits to substantial similarity's demise, and it argues that rehabilitating the doctrine to permit plaintiffs to win when they should do so will require a fresh look at how to judge substantial similarity.<sup>23</sup> For this to happen, three things must change.

First, courts must judge works holistically from the vantage of an ordinary observer and, once plaintiffs prove facial similarity, defendants should then explain why their works are not infringing.<sup>24</sup> Nevertheless, courts must still determine what the protected expressive elements of the allegedly infringed works are and how those compare *as a whole* to the allegedly infringing works.<sup>25</sup> Avoiding elemental dissection of the copyrighted work initially will make substantial similarity easier for fact finders to administer, which makes them less likely to penalize plaintiffs

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17. See STEPHEN E. SIWEK, COPYRIGHT INDUSTRIES IN THE U.S. ECONOMY 3 (2018), <https://iipa.org/files/uploads/2018/12/2018CpyrtRptFull.pdf> [<https://perma.cc/LVR3-ZDCT>].

18. See *Just the Facts: Intellectual Property Cases—Patent, Copyright, and Trademark*, U.S. COURTS (Feb. 13, 2020), [https://www.uscourts.gov/news/2020/02/13/just-facts-intellectual-property-cases-patent-copyright-and-trademark#figures\\_map](https://www.uscourts.gov/news/2020/02/13/just-facts-intellectual-property-cases-patent-copyright-and-trademark#figures_map) [<https://perma.cc/X9YU-L28V>] (condensing relevant statistics to a line graph in Figure 1).

19. See ASS'N RSCH., INC., AM. INTELL. PROP. L. ASS'N, REPORT OF THE ECONOMIC SURVEY 2017, at 41, 44 (2017); TOD I. ZUCKERMAN ET AL., ASSETS & FINANCE: INSURANCE COVERAGE FOR INTELLECTUAL PROPERTY AND CYBER CLAIMS § 1:6 (2011) (noting that the average cost of litigating a copyright case was \$440,000, according to a 2005 report).

20. See *infra* Section II.A.2.

21. See *infra* Section II.A.3.

22. See *infra* Section II.A.

23. See *infra* Sections II.B–C.

24. See *infra* Section III.B.

25. See *infra* Section III.B.1.

whose works invariably incorporate some unprotectable elements. Of course, one still needs to assess unprotectable elements and determine, “as a whole,” what the creative advance is that defines the “creative work” that is then compared to the allegedly infringing work for substantial similarity. However, that task should fall on defendants, who, as courts have noted, are the parties best positioned to do so.<sup>26</sup>

Second, jurors should be restored as the default arbiters of substantial similarity.<sup>27</sup> Laypeople, and not experts, are copyright’s principal audience.<sup>28</sup> The need to clarify the jury’s role in copyright litigation has become more relevant than ever due to the U.S. Supreme Court’s ordering of Google and Oracle to file supplemental briefs concerning the appropriate standard of review for the jury’s fair use verdict in favor of Google in their copyright litigation.<sup>29</sup>

Design law successfully undertook similar corrective measures over a decade ago.<sup>30</sup> Those corrective measures hold valuable lessons to reforming substantial similarity and improving both its administrability and predictability.<sup>31</sup>

Third, courts must require copyright registrants to identify the expressive elements of the works in their registrations, which will help clarify what they seek to protect and provide notice to defendants. Unlike with patents, copyright registrants need not know the prior art to state that they think something is copyrightable expression. Nor does the fact that copyrights are registered but not examined matter since courts expert judgments about whether the claimed expressive elements (by themselves or in combination) or protectable expression are either copyrightable are not always needed.

Courts can then properly focus on both technical and economic aspects of substantial similarity. Currently, it appears courts use rivalry as a heuristic for operationalizing substantial similarity because technical analysis is too complicated.<sup>32</sup> What is substantially similar needs a greater definition of how much time, money, and effort is needed for protection and avoidance, mainly where the alleged infringer builds off of or partially incorporates the idea, as in the case of satires and parodies. Simplifying substantial similarity will help courts properly consider both technical and economic aspects of the inquiry.

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26. See *infra* notes 350–51, 371–74 and accompanying text.

27. See *infra* Section III.B.2.

28. See *infra* Section III.C.2.

29. Jan Wolfe, *SCOTUS Asks for More Briefing in Oracle v. Google Copyright Case*, REUTERS (May 4, 2020, 9:37 PM), <https://www.reuters.com/article/ip-copyright-oracle/scotus-asks-for-more-briefing-in-oracle-v-google-copyright-case-idUSL1N2CN01G> [<https://perma.cc/58SJ-JWGS>].

30. See *infra* Section III.B.1–2.

31. See *infra* Section III.B.

32. See *infra* Section II.C.



Part I describes the confusing patchwork of substantial similarity law, as well as the challenging task fact finders undertake in every case. It also sketches the empirical aspects of this Article and their limits.<sup>33</sup> Part II then reports on substantial similarity's silent death.<sup>34</sup> It looks beyond the clamor of scholarly debate over the confusing tests and circuit variations to reveal a surprising partnership between judges and defendants. Part II also highlights the impact suing nonrivals has on case outcomes. Finally, Part III presents the playbook for revitalizing substantial similarity. Beyond copyright, the discussion here contributes directly to broader scholarly debates on rules versus standards, the centrality of jury trials, and structural biases within the American justice system.<sup>35</sup>

### I. COPYRIGHT INFRINGEMENT'S BLACK BOX

Congress has the constitutional mandate to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries” to benefit the public.<sup>36</sup> Through the Copyright Act of 1976,<sup>37</sup> authors of “original works of authorship fixed in any tangible medium of expression” may obtain protection for a limited duration.<sup>38</sup>

These “works of authorship” encompass literary, architectural, pictorial, sculptural, and graphic works.<sup>39</sup> They must contain “at least some minimal degree of creativity,” but “even a slight amount will suffice.”<sup>40</sup> Most make the grade “as they possess some creative spark, ‘no matter how crude, humble or obvious’ it might be.”<sup>41</sup> In doing so, copyright protects works that might be similar to those in the public domain or to other copyrightable works.<sup>42</sup> Moreover, this makes infringement rather than validity the principal means of regulating the scope of those rights.<sup>43</sup>

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33. Adapted from findings in an extensive empirical study on substantial similarity in Daryl Lim, *Substantial Similarity's Silent Death*, PEPP. L. REV. (forthcoming 2021).

34. *Id.*

35. See *infra* Section III.C.

36. U.S. CONST. art. I, § 8, cl. 8.

37. Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified as amended at 17 U.S.C.).

38. 17 U.S.C. § 102(a); see also Roodhuyzen, *supra* note 10, at 1379 (“[T]he Act specifies in detail the kinds of works that are protected and for how long; creates protection even without registration or notice; assigns exclusive rights and allows for transfer and division of ownership and rights; and creates various remedies including damages and fines.” (quoting Jason Mazzone, *Copyfraud*, 81 N.Y.U. L. REV. 1026, 1037–38 (2006))).

39. 17 U.S.C. § 101.

40. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

41. *Id.* (quoting 1 M. NIMMER & D. NIMMER, COPYRIGHT § 1.08[C][1] (1990)).

42. See Mark A. Lemley & Mark P. McKenna, *Scope*, 57 WM. & MARY L. REV. 2197, 2226 (2016).

43. See *id.*

Authors enjoy a bundle of rights to reproduce, distribute, and display their works, prepare derivative works, and publicly perform.<sup>44</sup> To enforce these rights, the Copyright Act empowers copyright owners to sue for infringement.<sup>45</sup> Unfortunately, neither the Act nor its legislative history explains what plaintiffs must show to claim infringement. Courts, therefore, devised the rule that plaintiffs must prove both that they have a valid copyright in the work and that the defendant wrongfully copied from the plaintiff's copyrighted work.<sup>46</sup> Substantial similarity's foundation as an ad hoc doctrine originates here.<sup>47</sup> Judging substantial similarity can be daunting because the fact finder must distinguish copyrightable expression from unprotected factual descriptions without linguistic aids like those found in patent claims.<sup>48</sup> The doctrinal patchwork of rules juxtaposed on a factually intensive inquiry produces a morass of unclear precedent almost by default.

This Part establishes the substantial similarity doctrine's place within an otherwise intricately crafted statutory framework that is the Copyright Act.<sup>49</sup> After Section I.A lays out the elements of infringement, Section I.B reviews the various tests circuit courts have devised to answer the substantial similarity inquiry. It concludes with the limit courts placed on substantial similarity to protect defendants and the public's right to enjoy uncopyrightable material.<sup>50</sup>

### A. Actual Copying

In copyright infringement cases, the plaintiff must show the defendant copied material from the plaintiff's copyrighted work rather than creating it or copying it from another source, and that the defendant copied enough copyrighted material from the plaintiff's work.<sup>51</sup> The plaintiff's first task is to prove actual copying and to do so using either direct or indirect evidence.<sup>52</sup> While showing that the defendant directly copied the work verbatim seems like the most obvious method of doing this, direct proof

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44. 17 U.S.C. § 106.

45. *See id.* § 501(a) ("Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 122 . . . is an infringer of the copyright . . ."); *id.* § 501(b) ("The legal or beneficial owner of an exclusive right under a copyright is entitled . . . to institute an action for any infringement . . .").

46. *See Feist*, 499 U.S. at 361.

47. *See id.* at 345, 361.

48. *See infra* Section III.B.3.

49. *See infra* Section I.A.

50. *See infra* Section I.B.

51. Eric Osterberg, *Copyright Litigation: Analyzing Substantial Similarity*, PRACTICAL LAW, <https://us.practicallaw.thomsonreuters.com/5-524-1501>.

52. *See id.* (noting that direct proof of actual copying includes admissions, eyewitness testimony, and "[t]he presence of watermarks or other features in the defendant's work conclusively identifying the plaintiff's work as the source").

of actual copying is scarce.<sup>53</sup> Eyewitnesses are hard to come by, and it is even harder to find infringers who voluntarily confess.<sup>54</sup> Most allegedly infringing works are not identical, which explains why substantial similarity plays such an outsized role in copyright infringement.<sup>55</sup>

Without evidence of direct copying, “striking similarity” is the first way for owners to show actual copying through indirect evidence.<sup>56</sup> Striking similarity is a likeness between works so exact it cannot be explained other than by copying, thereby creating an inference of actual copying or access to the plaintiff’s work.<sup>57</sup> The second way plaintiffs can prove actual copying by indirect evidence is through circumstantial evidence of access paired with “probative similarity.”<sup>58</sup> This requires plaintiffs to show the defendant had a reasonable possibility of accessing their work and that similarities between the works are probative of actual copying.<sup>59</sup> Courts sometimes confuse probative similarity (which looks to the defendant’s actions for evidence of copying) with substantial similarity (which looks to the works themselves to see if the amount copied was permissible).<sup>60</sup>

A plaintiff might also prove the defendant had access through widespread dissemination of the plaintiff’s work,<sup>61</sup> or that the plaintiff

53. See Howard Root, Note, *Copyright Infringement of Computer Programs: A Modification of the Substantial Similarity Test*, 68 MINN. L. REV. 1264, 1275–76 (1984) (“Because pirates are unlikely to be obvious about their copying, proof of the direct use of the copyrighted work in preparing a copy is virtually impossible.” (footnote omitted)).

54. See ALAN LATMAN, *THE COPYRIGHT LAW* 161 (5th ed. 1979) (discussing the importance of circumstantial evidence in copyright litigation).

55. See NIMMER & NIMMER, *supra* note 4, § 13.01[B] (“It is generally not possible to establish copying as a factual matter by direct evidence, as it is rare that the plaintiff has available a witness to the physical act of copying. . . . Therefore, copying is ordinarily established indirectly by the plaintiff’s proof of access and ‘substantial’ similarity.” (footnotes omitted)).

56. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) (introducing the idea of “striking similarity” by holding that “the similarities [between the two works] must be so striking as to preclude the possibility that plaintiff and defendant” created the work independently), *abrogated on other grounds by* *Heyman v. Com. & Indus. Ins. Co.*, 524 F.2d 1317 (2d Cir. 1975). Courts consider the similarities’ quirks, including mistakes or idiosyncrasies attributed to copying. See, e.g., *Ty, Inc. v. GMA Accessories, Inc.*, 132 F.3d 1167, 1170–71 (7th Cir. 1997); *Lipton v. Nature Co.*, 71 F.3d 464, 471–72 (2d Cir. 1995).

57. See *Gaste v. Kaiserman*, 863 F.2d 1061, 1068 (2d Cir. 1988) (citing *Arnstein*, 154 F.2d at 468); *Malibu Textiles, Inc. v. Label Lane Int’l, Inc.*, 922 F.3d 946, 952 (9th Cir.), *cert denied sub nom.* *H&M Hennes & Mauritz, LP v. Malibu Textiles, Inc.*, 140 S. Ct. 456 (2019).

58. *Tanksley v. Daniels*, 902 F.3d 165, 173 (3d Cir. 2018), *cert. denied*, 139 S. Ct. 1175 (2019), *reh’g denied*, 139 S. Ct. 1596 (2019).

59. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 482, 485 (9th Cir. 2000) (holding that speculative possibility of access was insufficient to establish probative similarity), *overruled in part by* *Skidmore v. Led Zeppelin*, 952 F.3d 1051 (9th Cir. 2020) (en banc).

60. See *Tanksley*, 902 F.3d at 173.

61. See *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 722 F.2d 988, 998 (2d Cir. 1983) (finding that the defendant may have had access to a song because of its widespread popularity on music charts).

sent the work to the defendant to review.<sup>62</sup> As with striking similarity, the plaintiff can show similar uses of public domain material, similar details, or errors in the plaintiff's work that would be unexpected without copying.<sup>63</sup> Some courts endorse a sliding scale approach, called the "inverse ratio rule," where more substantial evidence of access requires less evidence of probative similarity. In *Skidmore v. Led Zeppelin*,<sup>64</sup> the U.S. Court of Appeals for the Ninth Circuit Court recently joined other circuits in clarifying the inverse ratio rule did not apply to substantial similarity.<sup>65</sup> Specifically, the court noted that the majority of other circuits that considered the rule (the Second, Fifth, Seventh, and Eleventh Circuits) declined to adopt it.<sup>66</sup> *Skidmore* criticized the law as illogical because complete access should not preclude the need for plaintiffs to show similarity as it provides an unfair advantage to those with more accessible works.<sup>67</sup>

Post-*Skidmore*, however, it remains uncertain whether and to what extent the inverse ratio rule lives on in the actual copying limb of the copyright infringement inquiry. The Ninth Circuit noted that "[b]y rejecting the inverse ratio rule, we are not suggesting that access cannot serve as circumstantial evidence of actual copying in all cases."<sup>68</sup> Thus, access and probative similarity can still prove that actual copying occurred. *Skidmore* appears to leave intact the line of cases holding that striking similarity can constitute actual copying even with limited evidence of access.

In any case, not all copying amounts to infringement. The accused work and copyrightable elements of the plaintiff's work must also be sufficiently substantial to amount to an unlawful appropriation. Plaintiffs must prove substantial similarity—a challenge courts have described as "vague" and "arbitrary."<sup>69</sup>

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62. See *Bouchat v. Balt. Ravens, Inc.*, 241 F.3d 350, 354 (4th Cir. 2001).

63. See, e.g., *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991); *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 851 (9th Cir. 2012), *abrogated in part by Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 959 F.3d 1194 (9th Cir. 2020).

64. 952 F.3d 1051 (9th Cir. 2020) (en banc), *cert. denied sub nom. Skidmore v. Zeppelin*, No. 20-142, 2020 WL 5883816 (U.S. Oct. 5, 2020).

65. See *id.* at 1069; see also *Peters v. West*, 692 F.3d 629, 635 (7th Cir. 2012) (criticizing and declining to apply the inverse ratio rule).

66. *Skidmore*, 952 F.3d at 1066.

67. *Id.* at 1068 ("[T]he inverse ratio rule unfairly advantages those whose work is most accessible by lowering the standard of proof for [probative] similarity."); see also *id.* (noting that access can be established readily in cases when the plaintiff's work is available on YouTube, Netflix, Spotify, and other platforms).

68. *Id.* at 1069.

69. *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) ("The test for infringement of a copyright is of necessity vague."); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122 (2d Cir. 1930) (explaining that drawing the line between what is protected and

## B. *Substantial Similarity*

The substantial similarity inquiry seeks to determine whether two works share such a similar copyrightable expression that one infringes upon the other, making the copying wrongful.<sup>70</sup> The inquiry rests on the nature of the alleged infringement, the court's substantial similarity test, and the limits to substantial similarity—whether the defendant copied unprotectable content, as well as the amount and importance of the material that the defendant copied from the plaintiff's work.<sup>71</sup> The problem, however, is that the protectable elements of any work can be dissected to a point where almost nothing remains but its unprotectable parts, and caselaw provides little indication of where to stop in the reductionist analysis.<sup>72</sup> The U.S. Court of Appeals for the Second Circuit once noted that, if dissection is taken too far, “there can be no originality in a painting because all colors of paint have been used somewhere in the past.”<sup>73</sup> It follows that just as originality can be found in every allegedly unoriginal work, unoriginality can be found in almost every unoriginal work. How much originality will convince a court is inherently uncertain, so what constitutes infringement becomes a crapshoot as well.<sup>74</sup> The difficulty of this task may help explain why judges, believing in their expertise and efficiency, ultimately decided to wrest the substantial similarity inquiry from jurors, as Section II.B discusses.

Courts employ three main tests or some combination thereof: the ordinary observer test, the extrinsic/intrinsic test, and the

what is not “will seem arbitrary, [but] that is no excuse for not drawing it”); *see also* *Murray Hill Publ'ns, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 318 (6th Cir. 2004) (describing part of the substantial similarity inquiry as “complex”).

70. *See* Gervais, *supra* note 8, at 600 (“The second prong is satisfied when (i) protected expression in the earlier work was copied and (ii) the ‘amount of the copyrighted work that is copied . . . must be more than “*de minimis*.”’” (alteration in original) (quoting *Castle Rock Ent., Inc. v. Carol Publ'g Grp. Inc.*, 150 F.3d 132, 138 (2d Cir. 1998))).

71. *See, e.g., Nichols*, 45 F.2d at 120–21 (discussing allegations of copying plot elements and characters from a play into a motion picture). This could also include copying computer code from the plaintiff's copyrighted software or a sample of musical recording.

72. *See* *Helfing*, *supra* note 10, at 740 (“By considering only elements deemed protectable at an arbitrary level of dissection, courts fail to reliably identify the similar content that they evaluate for protectability.”). It should be noted that it is the combination (or particular organization of expressive elements) that may be original and novel, so dissection does not actually reduce to nothing. *See* *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994).

73. *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003 (2d Cir. 1995).

74. *See* *NIMMER & NIMMER*, *supra* note 4, § 13.03[A] (“[T]he test for infringement of a copyright is of necessity vague.” (quoting *Peter Pan Fabrics*, 274 F.2d at 489)); *see also* *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 839 (10th Cir. 1993) (“This is primarily a qualitative rather than a purely quantitative analysis and must be performed on a case-by-case basis.” (citation omitted)).

abstraction/filtration/comparison test.<sup>75</sup> Most either adopt the Second Circuit's ordinary observer test or the Ninth Circuit's extrinsic/intrinsic test.<sup>76</sup> A few adopt the "abstraction/filtration/comparison" test or variations of these tests.<sup>77</sup> All three tests attempt to compare protectable elements in the copyrighted work.<sup>78</sup>

### 1. The Ordinary Observer Test

The Second Circuit's ordinary observer test has the longest vintage of the three tests and finds its roots in *Arnstein v. Porter*.<sup>79</sup> In his seminal article, Professor Alan Latman observed that the ordinary observer test, "when properly understood, remains the most instructive guide to proving infringement."<sup>80</sup> Sadly, modern courts would depart from *Arnstein* with devastating consequences for plaintiffs and the vitality of the substantial similarity doctrine.

In *Arnstein*, composer Ira Arnstein sued Cole Porter for infringing copies of his songs, including unpublished ones.<sup>81</sup> These songs ranged from a million copies sold to a copy kept in Arnstein's room that had been ransacked on several occasions in "burglaries" that the defendant "could have" had something to do with.<sup>82</sup> There was no direct evidence Porter had ever seen or heard Arnstein's compositions.<sup>83</sup> Porter moved for summary judgment, claiming to have never heard Arnstein's songs.<sup>84</sup>

#### a. How to Judge Substantial Similarity?

*Arnstein* made three key contributions. Its initial and most important contribution was *how* the standard for "improper appropriation," which courts eventually renamed "substantial similarity," should be judged.<sup>85</sup> In this regard, the court held:

Assuming that adequate proof is made of copying, that is not enough; for there can be "permissible copying," copying which is not illicit. Whether (if he copied) defendant

75. Hickey, *supra* note 8, at 690, 692, 694, 699 ("A better (though still imperfect) comparison looks to the results under the three main tests: the observer, extrinsic/intrinsic, and A/F/C tests.").

76. *See infra* Section II.A.1 and Figure 1.

77. *See infra* Section II.A.1 and Figure 1.

78. *See* Helfing, *supra* note 10, at 739.

79. 154 F.2d 464 (2d Cir. 1946), *abrogated on other grounds by* Heyman v. Com. & Indus. Ins. Co., 524 F.2d 1317 (2d Cir. 1975); *see* Latman, *supra* note 15, at 1191 ("One may, in tracing the history of the proof of infringement, justifiably start with the legendary *Arnstein v. Porter*.").

80. Latman, *supra* note 15, at 1191.

81. *Arnstein*, 154 F.2d at 467.

82. *Id.*

83. *Id.*

84. *Id.*

85. *See* Latman, *supra* note 15, at 1192 (quoting *Arnstein*, 154 F.2d at 468).

unlawfully appropriated presents, too, *an issue of fact. The proper criterion on that issue is not an analytic or other comparison of the respective musical compositions as they appear on paper or in the judgment of trained musicians.* The plaintiff's legally protected interest is not, as such, his reputation as a musician but his interest in the potential financial returns from his compositions which derive from the lay public's approbation of his efforts. The question, therefore, is whether [the] defendant took from plaintiff's works so much of what is pleasing to the ears of *lay listeners, who comprise the audience for whom such popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff.*<sup>86</sup>

There are several important takeaways here. First, when a court looks at substantial similarity, it is already satisfied that the defendant copied the plaintiff's work. Second, the plaintiff must nonetheless convince the adjudicator that the defendant misappropriated the plaintiff's work by showing it took "so much of what is pleasing to" the audience of the plaintiff's work. The ordinary observer test attempts to compare the two works from the perspective of a hypothetical lay observer and focuses on similarities between the works rather than their differences. Similarities suggest defendants saw and copied the works instead of independently creating them.<sup>87</sup>

The author's original contribution informs the qualitative and quantitative taking needed. Some copyrighted work represents significant creative effort and enjoys robust protection, whereas others reflect only scant creativity.<sup>88</sup> Dissimilarities may be substantial if a defendant's work takes on a different overall concept and feel than the plaintiff's work or has unprotectable elements allegedly taken from the plaintiff.<sup>89</sup> The more differences that exist between the two works, the less likely that the defendant misappropriated the plaintiff's work.<sup>90</sup> However, trivial dissimilarities may be insignificant, due to elements similar to those in

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86. *Arnstein*, 154 F.2d at 472–73 (emphasis added) (footnotes omitted) (quoting *Dymow v. Bolton*, 11 F.2d 690, 692 (2d Cir. 1926)).

87. See *Latman*, *supra* note 15, at 1189.

88. See *Eng'g Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1348 (5th Cir. 1994) ("[T]he scope of copyright protection [is] a sliding scale that changes with the availability of expressions for a given idea . . ."); *NIMMER & NIMMER*, *supra* note 4, § 13.03[A][4] ("More similarity is required when less protectible matter is at issue.").

89. See *Attia v. Soc'y of N.Y. Hosp.*, 201 F.3d 50, 57–58 (2d Cir. 1999).

90. See, e.g., *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 913 (2d Cir. 1980).

the plaintiff's work that the defendant did not copy from the plaintiff or merely added to the material copied from the plaintiff.<sup>91</sup>

Third, substantial similarity is a standard, not a structured rule that requires dissection of copyrightable and uncopyrightable elements subject to expert evidence. As one treatise observed, "The ordinary observer test is no more than an attempt to gauge the reaction of the ordinary 'man on the street' to the two works . . . . The fact finder decides whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work."<sup>92</sup>

*Arnstein* made clear that expert testimony and dissections of the works are "irrelevant" to this determination and that the final judgment should be made based on a lay listener's impression about the impropriety of the appropriation.<sup>93</sup> The court saw the jury as being more representative of the audience for the copyrighted work, indicating that it would "be proper to exclude tone-deaf persons from the jury," as they would no longer be typical consumers.<sup>94</sup> A judge would not likely consume popular music and, therefore, ought to employ an advisory jury.<sup>95</sup>

The ordinary observer does not need to decompose the works into their constituent elements or filter out unprotectable parts, and for a good reason. Real-world audiences of copyrighted works consume them based on a holistic reception of the work, and they do not conduct an element-by-element analysis of their copyrightable features. Courts could allow expert testimony to help the jury determine the reaction of lay listeners.<sup>96</sup> *Arnstein* gave courts a malleable and yet predictable standard for assessing substantial similarity.

Courts in other circuits regarded *Arnstein* as defective. The First, Third, Fifth, and Seventh Circuits all apply some form of a "more discerning" ordinary observer test.<sup>97</sup> The reformulated test, dubbed the "more discerning ordinary observer test," requires plaintiffs to prove copying of expressive elements; fact finders then must filter unprotectable elements out and determine—only based on the remaining

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91. See *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 608 (1st Cir. 1988). This may depend on the amount of material not copied from the plaintiff or perhaps the elements in the defendant's work that the defendant did not copy from the plaintiff. See, e.g., *id.*; *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936) ("[N]o plagiarist can excuse the wrong by showing how much of his work he did not pirate.").

92. ROBERT C. OSTERBERG & ERIC C. OSTERBERG, *SUBSTANTIAL SIMILARITY IN COPYRIGHT LAW* § 3:1.1[A] (2020) (footnote omitted).

93. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946), *abrogated on other grounds by Heyman v. Com. & Indus. Ins. Co.*, 524 F.2d 1317 (2d Cir. 1975).

94. *Id.* at 473 & n.22.

95. See *id.* at 473.

96. See *id.*

97. Nicole K. Roodhuyzen, *Do We Even Need a Test? A Reevaluation of Assessing Substantial Similarity in a Copyright Infringement Case*, 15 J.L. & POL'Y 1375, 1391–97 (2007).



protectable elements—whether the overall look and feel of the works are substantially similar.<sup>98</sup> As Part II shows, the modified test has become the nation’s *de facto* test for substantial similarity.<sup>99</sup>

The fuzzy limits between protectable and unprotectable elements have made substantial similarity a treacherous terrain to navigate. Substantial similarity excludes ideas,<sup>100</sup> *scènes à faire*,<sup>101</sup> and ideas that have limited means of expression, otherwise known as the merger doctrine.<sup>102</sup> Other limitations, such as the uncopyrightability of colors, letters, and geometric forms, overlap with or are contained within these three main categories.<sup>103</sup> Interwoven within the idea/expression dichotomy, *scènes à faire*, and the merger doctrine, modern courts must also consider both the quantitative significance of the copied material and the importance of the content copied in the plaintiff’s work.<sup>104</sup> According to Judge Learned Hand, “no principle can be stated as to when an imitator has gone beyond copying the ‘idea,’ and has borrowed its ‘expression.’ Decisions must therefore inevitably be *ad hoc*.”<sup>105</sup>

As far back as 1987, Professor Amy Cohen warned that the concept of substantial similarity itself has become more, rather than less, ambiguous as it has been subjected to judicial interpretation over the years.<sup>106</sup> Tests like the more discerning ordinary observer test require courts to dissect a work for comparison without providing an adequately theorized means of doing so. This necessarily makes every case the decision maker’s value judgment, rendering cases unmoored in

98. *Boisson v. Banian, Ltd.*, 273 F.3d 262, 265, 268–69, 272–73 (2d Cir. 2001) (considering elements of a copyrighted quilt taken from the public domain).

99. The Fourth Circuit compares the works through the eyes of their “intended audience.” *Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731, 733 (4th Cir. 1990). Since copyrighted works are usually intended for the public at large, the intended audience and the ordinary observer are therefore typically the same. *See id.* at 734.

100. *See Rogers v. Koons*, 960 F.2d 301, 308 (2d Cir. 1992) (“[I]deas, concepts, and the like found in the common domain are the inheritance of everyone.”).

101. *Zaleski v. Cicero Builder Dev., Inc.*, 754 F.3d 95, 102 (2d Cir. 2014) (“[E]lements of a work that are ‘indispensable, or at least standard, in the treatment of a given topic’—like cowboys, bank robbers, and shootouts in stories of the American West—get no protection.” (quoting *Hoehling v. Univeral City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980))).

102. *Kepner-Tregoe, Inc. v. Leadership Software, Inc.*, 12 F.3d 527, 533 (5th Cir. 1994) (“[W]hen an idea can be expressed in very few ways, copyright law does not protect that expression, because doing so would confer a *de facto* monopoly over the idea. In such cases idea and expression are said to be merged.”).

103. *See Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 132 (2d Cir. 2003).

104. *See Peter Letterese & Assocs., Inc. v. World Inst. of Scientology Enters., Int’l*, 533 F.3d 1287, 1307 (11th Cir. 2008).

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

106. Amy B. Cohen, *Masking Copyright Decisionmaking: The Meaninglessness of Substantial Similarity*, 20 U.C. DAVIS L. REV. 719, 722–23 (1987).

standardless precedents and difficult for attorneys to evaluate.<sup>107</sup> It is also difficult for juries to determine infringement.<sup>108</sup>

Far from being a defect, the genius of *Arnstein* lay in its requirement for holistic comparisons. *Arnstein* simply required a comprehensive side-by-side comparison of the works to see if enough was misappropriated, a task simple enough that the court was satisfied jurors could do.<sup>109</sup> *Arnstein*'s jury-centered inquiry also grounds the technical inquiry in a lay audience's perception rather than the technical sensibilities of an expert blended with the rarified tastes of judges imbibing the works from their chambers. Defendants could then argue that what they copied was unprotectable—a finding courts are well accustomed to making.<sup>110</sup>

### b. Who Should Judge Substantial Similarity?

*Arnstein*'s second crucial contribution was about *who* should judge substantial similarity. The court stated “[s]urely, then, we have an issue of fact which a jury is peculiarly fitted to determine.”<sup>111</sup> The court noted:

The impression made on the refined ears of musical experts or their views as to the musical excellence of plaintiff's or defendant's works are utterly immaterial on the issue of misappropriation; for the views of such persons are caviar to the general [public]—and plaintiff's and defendant's compositions are not caviar.<sup>112</sup>

Since judges are unlikely to listen to popular music, they should rely on a jury.<sup>113</sup> Similarly, it would “be proper to exclude tone-deaf persons from the jury,” as they would not be typical consumers of musical works.<sup>114</sup> The opinion also noted the appropriateness of denying summary judgment when “there is the slightest doubt as to the facts,” and it stressed the importance of in-court cross-examination.<sup>115</sup>

Judge Clark wrote a sharp dissent arguing that the majority was creating “chaos, judicial as well as musical,” and defending the propriety

107. See Irina D. Manta, *Reasonable Copyright*, 53 B.C. L. REV. 1303, 1338 (2012) (“[S]ubstantial similarity can become confusing for even experienced attorneys and judges . . .”).

108. *Id.* (“The empirical research casts concerns as to how judges and juries may adjudicate such situations of artistic uncertainty.”).

109. See *Arnstein v. Porter*, 154 F.2d 464, 468, 473 (2d Cir. 1946), *abrogated on other grounds by Heyman v. Com. & Indus. Ins. Co.*, 524 F.2d 1317 (2d Cir. 1975).

110. See, e.g., *Baker v. Selden*, 101 U.S. 99, 102 (1879) (noting that the idea of bookkeeping would not be copyrightable).

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

112. *Id.* (footnote omitted).

113. See *id.*

114. *Id.* at 473 n.22.

115. *Id.* at 468–70 (quoting *Doehler Metal Furniture Co. v. United States*, 149 F.2d 130, 135 (2d Cir. 1945)).

of judges deciding the issue on summary judgment.<sup>116</sup> He was skeptical about the jury's ability to identify improper appropriation:

I should not have thought it pre-eminently fitted to decide questions of musical values, certainly not so much so that an advisory jury should be brought in if no other is available. And I should myself hesitate to utter so clear an invitation to exploitation of slight musical analogies by clever musical tricks in the hope of getting juries hereafter in this circuit to divide the wealth of Tin Pan Alley.<sup>117</sup>

Judge Clark would also have allowed dissection and expert testimony, since “[m]usic is a matter of the intellect as well as the emotions; that is why eminent musical scholars insist upon the employment of the intellectual faculties for a just appreciation of music.”<sup>118</sup> As Section II.B shows, Judge Clark's dissenting view took root and likewise had disastrous consequences for plaintiffs in the decades to come.<sup>119</sup>

Pretrial motions are a particularly inappropriate means to dispose of a substantial similarity argument. The underlying facts and the weight of inferences are likely to be in dispute. The mixed question should be treated as more like a question of fact (and thus for the jury) than one of law (and thus for the judge, including at summary or final judgment once the jury has provided its fact-finding). One judge's opinion on inference in the substantial similarity analysis may not reflect the consensus opinion of a jury.<sup>120</sup> Pretrial motions may foreclose plaintiffs from realizing an otherwise meritorious cause of action. A judge who disposes of a substantial similarity argument on a pretrial motion runs a real risk of ignoring the wide disparity of opinion that arises in the fact-finding process in understanding of lay juror perceptions of similarity.

c. How Broadly Should a Plaintiff's Economic Interests Extend?

*Arnstein's* third crucial contribution is *what* substantial similarity would cover. *Arnstein* was a composer but sought relief against Porter's phonorecords and public performances of his plagiarized works.<sup>121</sup> They were not direct rivals. In other words, the *Arnstein* test looked at both the economic and technical aspects of the similarities.<sup>122</sup> In contrast to the technical aspects discussed above, the economic aspects focus more on whether the parties are rivals. Where the defendant used the entire work

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116. *Id.* at 480 (Clark, J., dissenting).

117. *Id.* at 479.

118. *Id.* at 476.

119. *See infra* Section II.B.

120. *See infra* Section III.C.2.

121. *Arnstein*, 154 F.2d at 467.

122. *See id.* at 469, 473.

or made an identical copy, there is no need to compare the parties' works in a substantial similarity analysis.<sup>123</sup> Where the works have similar expressive elements, this general similarity in "total concept and feel" could include defendants who copied plot elements and characters from a play into a motion picture.<sup>124</sup>

The amount and substantiality of the defendant's copying are the third factor in the fair-use analysis, and courts sometimes avoid a substantial similarity analysis by finding that what the defendant copied was fair use.<sup>125</sup> In this regard, fair use is simply another way of defining what conduct is not infringing. Copyright law gives authors temporary market exclusivity to recoup their investments and profit from their creativity.<sup>126</sup> This encourages further creativity both from those authors and from others enticed by the promise of a reward.<sup>127</sup> The copyright system therefore enables copyright owners to reallocate those rights in two ways: through licenses and by allowing others to use the work through consuming the work or by building on it.<sup>128</sup> The Copyright Act thus includes the right "to prepare derivative works based [on] the copyrighted work."<sup>129</sup> Indeed, since derivative work rights and substantial similarity both focus on nonliteral infringement, they are two ways of asking the same critical question about the point at which copying becomes inappropriate. As this Article shows in Section II.C, later courts, perhaps confounded with the difficulty of applying the convoluted technical tests

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123. *E.g.*, *Range Rd. Music, Inc. v. E. Coast Foods, Inc.*, 668 F.3d 1148, 1154 (9th Cir. 2012).

124. *E.g.*, *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1167 (9th Cir. 1977) (quoting *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970)), *overruled by* *Skidmore v. Led Zeppelin*, 952 F.3d 1051 (9th Cir. 2020) (en banc); *see* *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

125. *See, e.g.*, *SOFA Ent., Inc. v. Dodger Prods., Inc.*, 709 F.3d 1273, 1278–80 (9th Cir. 2013). Courts also may find that the use was minimal, and therefore noninfringing. *See, e.g.*, *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 880, 887 (9th Cir. 2016).

126. *See supra* notes 36–38 and accompanying text.

127. *See* Thomas B. Nachbar, *Judicial Review and the Quest to Keep Copyright Pure*, 2 J. ON TELECOMMS. & HIGH TECH. L. 33, 35–36 (2003).

128. *See* Thomas B. Nachbar, *Rules and Standards in Copyright*, 52 HOUS. L. REV. 583, 590 (2014) (identifying the consumptive and productive uses of a copyrighted work); *see also* Christopher Sprigman, *Copyright and the Rule of Reason*, 7 J. ON TELECOMMS. & HIGH TECH. L. 317, 335 (2009) (defining "'consumptive' infringement" as "infringement involving the reproduction and distribution of copies that are either exact or near enough so that they are almost certain to compete with the original work for patronage" (emphasis omitted)).

129. 17 U.S.C. § 106(2); *id.* § 101 ("A 'derivative work' is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work.'").

of their own making, focused instead on the more accessible economic aspects, leading to plaintiffs' win rates plummeting.<sup>130</sup>

While the Second Circuit significantly altered *Arnstein's* ordinary observer test, it mostly heeded *Arnstein's* warning against employing expert evidence in the court's substantial similarity test.<sup>131</sup> The Ninth Circuit had no such qualms; in *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*,<sup>132</sup> it further pushed substantial similarity from being a standard to being a structured rule.<sup>133</sup>

## 2. The Extrinsic/Intrinsic Test

Ostensibly, the judges in *Sid & Marty* were concerned that "copying" and "substantial similarity" might result in liability when defendants only took nonprotected ideas.<sup>134</sup> It decided to introduce a two-step procedure that would first determine whether defendants took only ideas—a test it called "extrinsic because it depends not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed" by experts if necessary.<sup>135</sup> Second, it would determine whether substantial similarity existed between the expressions—a test labeled "intrinsic" because it "depend[s] on the response of the ordinary reasonable person" rather than "the type of external criteria and analysis which marks the extrinsic test."<sup>136</sup> Plaintiffs would win if they satisfied both the extrinsic and intrinsic tests, so if either favored the defendant there would be no infringement.<sup>137</sup> The Ninth Circuit uses this "total concept and feel"<sup>138</sup> test "to restrict the scope of a plaintiff's copyright from extending to (unprotectable) ideas."<sup>139</sup> In a nod to *Arnstein*, it targets the subjective quality of the work as its "intended audience" perceives.<sup>140</sup>

According to *Sid & Marty*, "This same type of bifurcated test was announced" in *Arnstein*, and the "unlawful appropriation" in *Arnstein's* second prong meant only taking protected expression rather than

130. See *infra* Section II.C.

131. See Gervais, *supra* note 8, at 608–10 (contrasting the Second Circuit where expert testimony is occasionally used with the Ninth Circuit where expert testimony is "frequently utilized").

132. 562 F.2d 1157 (9th Cir. 1977), *overruled by* *Skidmore v. Led Zeppelin*, 952 F.3d 1051 (9th Cir. 2020) (en banc).

133. *Id.* at 1164.

134. See *id.* at 1162–63.

135. *Id.* at 1164.

136. *Id.*

137. See *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045–46 (9th Cir. 1994).

138. Jeannette Rene Busek, Comment, *Copyright Infringement: A Proposal for a New Standard for Substantial Similarity Based on the Degree of Possible Expressive Variation*, 45 UCLA L. REV. 1777, 1790 (1998).

139. Douglas Y'Barbo, *The Origin of the Contemporary Standard for Copyright Infringement*, 6 J. INTELL. PROP. L. 285, 302 (1999).

140. Busek, *supra* note 138, at 1790–91.

unprotected ideas.<sup>141</sup> At the same time, the opinion declared: “We do not resurrect the *Arnstein* approach today. Rather, we formulate an extrinsic-intrinsic test for infringement based on the idea-expression dichotomy. We believe that the *Arnstein* court was doing nearly the same thing. But the fact that it may not have been does not subtract from our analysis.”<sup>142</sup>

Scholars noted a substantial difference between the Second and Ninth Circuit tests.<sup>143</sup> Whereas under *Arnstein* misappropriation takes place in one step, the Ninth Circuit’s “extrinsic/intrinsic” test splits *Arnstein* into two.<sup>144</sup> Plaintiffs must prove substantial similarity under both prongs: first, the “extrinsic . . . filtering” of uncopyrightable elements and comparison of copyrightable features, and second, “intrinsic” requirement that an ordinary, reasonable observer viewing the works as a whole would perceive the allegedly infringing work to be substantially similar to the plaintiff’s work in “total concept and feel.”<sup>145</sup> It has proven difficult for courts to apply.<sup>146</sup> The extrinsic step’s focus on similarity in ideas is also odd, given that copyright does not protect ideas.<sup>147</sup> The Fourth and Eighth Circuits adopted the Ninth Circuit’s extrinsic/intrinsic test, with the Fourth Circuit refining the second step further by assuming the perspective of the “intended audience” of the work as opposed to the general public—language that seems similar to the refined ordinary observer test and therefore similarly problematic for the plaintiff.<sup>148</sup>

### 3. The Abstraction/Filtration/Comparison Test

The third test for substantial similarity is the “abstraction/filtration/comparison” test, which the Second Circuit

141. *Sid & Marty Krofft*, 562 F.2d at 1164–65.

142. *Id.* at 1165 n.7.

143. *See, e.g.*, Gervais, *supra* note 8, at 610 (“The Second and Ninth Circuits differ substantially.”).

144. *See id.* (comparing *Arnstein*’s single “improper appropriation” step to the Ninth Circuit’s “‘extrinsic’ test aimed at determining whether there exists a substantial similarity in underlying ideas” and “‘intrinsic’ test to ascertain whether there exists a substantial similarity in the expression of the underlying idea” (quoting *Broderbund Software, Inc. v. Unison World, Inc.*, 648 F. Supp. 1127, 1136 (N.D. Cal. 1986))); *see also id.* (“The first step, under the Ninth Circuit’s *Krofft* test, ‘is focused on a dissective analysis of similarities and differences in expression in the works at issue.’” (quoting Samuelson, *supra* note 4, at 1830)).

145. *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1118 (9th Cir. 2018) (quoting *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002)), *overruled in part by* *Skidmore v. Led Zeppelin*, 952 F.3d 1051 (9th Cir. 2020) (en banc).

146. *OSTERBERG & OSTERBERG, supra* note 92, § 3:2.1[H] (“The application of the extrinsic test . . . is a somewhat unnatural task, guided by relatively little precedent . . .” (quoting *Swirsky v. Carey*, 376 F.3d 841, 848 (9th Cir. 2004))).

147. *See* 17 U.S.C. § 102(b) (“In no case does copyright protection for an original work of authorship extend to any idea . . .”).

148. *See Dawson v. Hinshaw Music Inc.*, 905 F.2d 731, 733–36 (4th Cir. 1990); *OSTERBERG & OSTERBERG, supra* note 92, §§ 3:2.1–2.3.

devised to evaluate cases involving computer software.<sup>149</sup> Decades after *Arnstein*, in *Computer Associates International, Inc. v. Altai, Inc.*,<sup>150</sup> the Second Circuit noted that while *Arnstein* is useful “when the material under scrutiny [is] limited to art forms readily comprehensible and generally familiar to the average lay person,” the “highly complicated and technical subject matter at the heart of [nonliteral software] claims” called for a different approach because the internal designs of computer programs were “likely to be somewhat impenetrable by lay observers.”<sup>151</sup>

The test first identifies elements copyright does not protect, using an abstraction step—from the general idea to the precise words, images, or sounds used in the work.<sup>152</sup> The second step filters out these elements, and the third step compares protected aspects of both works.<sup>153</sup> Each step requires the fact finder to dissect what is protectable and what is not, and expert testimony may be relevant in all three steps.<sup>154</sup>

In *Altai*, a dispute arose out of two functionally similar computer programs developed by different companies.<sup>155</sup> The Second Circuit parsed the software into its parts: source and object code, parameter lists, services required, and outlines.<sup>156</sup> It then removed nonprotected parts, those either in the public domain or that constituted an idea rather than an expression of an idea, such as the link set in the desktop taskbar.<sup>157</sup> Finally, the court compared the remaining expressive elements of the plaintiff’s program and found no copying of protectable elements.<sup>158</sup>

William Patry criticized the abstraction/filtration/comparison test as “the most complicated copyright ‘test’ ever conceived” that misses essential holistic elements of artistic works by the “ravage[s]” of element-by-element analysis.<sup>159</sup> Others questioned its usefulness when applied to other works of authorship.<sup>160</sup> While most circuits reserve this test for

149. See *Comput. Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706–11 (2d Cir. 1992).

150. 982 F.2d 693 (2d Cir. 1992).

151. *Id.* at 713.

152. See *id.* at 706–07.

153. *Country Kids ‘N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1285 (10th Cir. 1996); *Altai*, 982 F.2d at 710 (“Once a court has sifted out all the elements of the allegedly infringed program which are ‘ideas’ or are dictated by efficiency or external factors, or taken from the public domain, there may remain a core protectable expression. In terms of a work’s copyright value, this is the golden nugget.”).

154. Samuelson, *supra* note 4, at 1838.

155. *Altai*, 982 F.2d at 698–700.

156. See *id.* at 714.

157. See *id.* at 707, 715.

158. *Id.* at 715, 721.

159. 3 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 9:94, Westlaw (database updated Sept. 2020).

160. See, e.g., Jon O. Newman, *New Lyrics for an Old Melody: The Idea/Expression Dichotomy in the Computer Age*, 17 CARDOZO ARTS & ENT. L.J. 691, 698 (1999) (“[O]ne cannot

computer software cases, the Sixth and Tenth Circuits reportedly apply it to all copyright works.<sup>161</sup>

In sum, unlike in typical circuit splits, circuits appear divided less by the proper policy goals of substantial similarity and more by the mechanics of operationalizing those goals. According to the modern substantial similarity tests, courts are correct to filter out unprotected elements of the plaintiff's work since defendants can only infringe on "protected expression."<sup>162</sup> In doing so, courts must take care to allow copyrightable combinations of otherwise unprotectable elements.<sup>163</sup> Only then do defendants need to show they independently created the allegedly infringing work, or that the amount of the protectable material used was so trivial that the law should regard it as a noninfringing *de minimis* use.<sup>164</sup> Plaintiffs are forced to use this morass of unclear precedent to convince courts that defendants have taken only copyrightable content, which, as Section II.B shows, would combine with pretrial motion practice to create a structural bias against them.

Circuit courts disagree on how to apply these tests.<sup>165</sup> If courts struggle to implement their tests, and if both creators and users cannot predictably judge their legal positions, the time may now be ripe for the Supreme Court to step in and finally introduce a nationwide test.<sup>166</sup> In the meantime, judges, scholars, and practitioners continue to lack the knowledge to meaningfully reform substantial similarity because many of its most important facets are hidden and are revealed only empirically. Every case is fact-specific, eliding rote application of formulaic or mechanistic rules; stepping back to see how the pieces from many cases fit together reveals significant trends and truths.

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divide a visual work into neat layers of abstraction in precisely the same manner one could with a text.”).

161. See OSTERBERG & OSTERBERG, *supra* note 92, §§ 3:3.1–3.2.

162. See *supra* notes 70–73 and accompanying text.

163. See, e.g., *Design Basics, LLC v. Lexington Homes, Inc.*, 858 F.3d 1093, 1099, 1101–02 (7th Cir. 2017).

164. See, e.g., *VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 874 (9th Cir. 2016).

165. See, e.g., *Hickey*, *supra* note 8, at 688–89 (“[E]ven within a single circuit, courts sometimes vary the test used depending on the type of work at issue (e.g., software vs. visual art).”).

166. *Roodhuyzen*, *supra* note 10, at 1418–19; see also *id.* at 1377 (“As the tests become increasingly elusive for both courts and litigants, it is important to consider whether there should be one single test articulated by the Supreme Court, or rather, whether there should be a test at all.”).



### C. Looking Under the Hood

In trademark infringement cases, judges routinely rely on a remarkably limited number of factors in reaching their conclusions.<sup>167</sup> They employ heuristics—such as the three substantial similarity tests—to cut through what would otherwise be a morass of information that could paralyze decision-making entirely.<sup>168</sup> This, however, makes it difficult to draw broader conclusions that inform future cases coherently.<sup>169</sup> To address this, scholars employ case content analysis to parse through court decisions and study how judges and juries apply rules to facts in practice.<sup>170</sup>

This Article employs case content analysis, relying on an expansive pool of cases based on a Westlaw search for all intellectual property law cases discussing substantial similarity between 2010 and 2019.<sup>171</sup> The search returned 285 unfiltered decisions. After filtering out trademark or patent cases, as well as copyright cases mentioning but not discussing substantial similarity, the final pool comprised 242 cases.<sup>172</sup> The dataset of hand-coded cases include the decision's date; the judicial circuit; whether the case repeated; its procedural posture; the type of work of authorship; substantial similarity tests and their limitations; whether a district or appellate court decided the case; case outcomes; the identity of

167. See, e.g., Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1602 (2006) (“The data collected for this study support both the general hypothesis that decision makers, even when making complex decisions, consider only a small number of factors and the more specific hypothesis that, in doing so, decision makers use a core attributes heuristic.”).

168. See, e.g., Daryl Lim, *Retooling the Patent-Antitrust Intersection: Insights from Behavioral Economics*, 69 BAYLOR L. REV. 124, 175 (2017).

169. See, e.g., Daryl Lim, *The (Unnoticed) Revitalization of The Doctrine of Equivalents*, ST. JOHN'S LAW REV. (forthcoming 2021).

170. See, e.g., Lee Petherbridge, *On the Decline of the Doctrine of Equivalents*, 31 CARDOZO L. REV. 1371, 1380 (2010) (“Content analysis is capable of helping scholars verify, analyze, or refute empirical claims about case law, and it is to that purpose the approach is put in this study.”). For earlier studies where others and I employed a similar methodology, see DARYL LIM, *PATENT MISUSE AND ANTITRUST LAW* 10 (2013); Mark A. Hall & Ronald F. Wright, *Systematic Content Analysis of Judicial Opinions*, 96 CALIF. L. REV. 63, 77–79 (2008); Daryl Lim, *Judging Equivalents*, 36 SANTA CLARA HIGH TECH. L.J. 223, 230 (2020); Lee Petherbridge et al., *The Federal Circuit and Inequitable Conduct: An Empirical Assessment*, 84 S. CAL. L. REV. 1293, 1303–04 (2011).

171. See WESTLAW, next.westlaw.com (search the following terms: “adv: SY,DI (substantial /3 similarity)”); then narrow search results to cases between 2010 and 2019; then narrow search results to the “Intellectual Property” practice area). For other studies employing a similar methodology, see, for example, John R. Allison & Mark A. Lemley, *The (Unnoticed) Demise of the Doctrine of Equivalents*, 59 STAN. L. REV. 955, 963 (2007) (“[W]e collected every district court and court of appeals decision on the doctrine of equivalents that appeared in Westlaw . . .”).

172. If the opinion discussed the relevant law and facts, it was included in the database, even absent a specific heading.

appellate judges and district courts; and the parties' relationship as rivals (or not).

In 2013, Katherine Lippman published a student comment reporting on a more limited set of variables in substantial similarity caselaw.<sup>173</sup> The Lippman study reported on appellate cases between 1923 and 2011 and district court opinions that resulted in reported appeals.<sup>174</sup> This had the unfortunate consequence of omitting a significant number of district court opinions which were not appealed—between 80%–90% of all district court cases are never appealed.<sup>175</sup> Nonetheless, a large number of cases in the Lippman study (234) provides a useful basis for comparison,<sup>176</sup> and leading copyright scholars have cited the study's results with approval.<sup>177</sup>

This Article builds on the Lippman study and significantly refines it. Using an original hand-coded dataset, in addition to all appellate cases between 2010 and 2019, this Article reports on all district court opinions during that period, regardless of whether parties appealed. This Article also introduces other vital refinements, including distinguishing between procedural wins (for instance, defeating a motion for summary judgment) and substantive wins (which result in a finding of infringement or noninfringement) based on substantial similarity. Other refinements are the interactions between similarity, rivalry and fair use, and interactions between outcomes and the circuit standards employed (and their limitations).<sup>178</sup>

Substantial similarity—like patent law's doctrine of equivalents and trademark law's multifactor likelihood of confusion test—uses nonliteral analysis to determine infringement in the sense that the offending article need not be identical to the plaintiff's work of authorship, invention, or sign.<sup>179</sup> The three types of intellectual property rights are, of course, also

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173. Lippman, *supra* note 8, at 516.

174. *Id.* at 535. Lippman picked the year 1923 because of *Marks v. Leo Feist, Inc.*, 290 F. 959 (2d Cir. 1923), which she regarded as “the oldest case” the substantial similarity test traced its roots to. *Id.* at 549; see also Eric Rogers, Comment, *Substantially Unfair: An Empirical Examination of Copyright Substantial Similarity Analysis Among the Federal Circuits*, 2013 MICH. ST. L. REV. 893, 896 (“This Note builds upon Lippman’s work by assigning ‘hard numbers’ to the results of substantial similarity cases at the appellate level, while determining how selected variables influence case outcomes.”).

175. Theodore Eisenberg, *Appeal Rates and Outcomes in Tried and Nontried Cases: Further Exploration of Anti-Plaintiff Appellate Outcomes*, 1 J. EMPIRICAL LEGAL STUD. 659, 659–60 (2004).

176. See Lippman, *supra* note 8, at 535.

177. See, e.g., Matthew Sag, *IP Litigation in U.S. District Courts: 1994–2014*, 101 IOWA L. REV. 1065, 1070 n.13 (2016); Zahr K. Said, *A Transactional Theory of the Reader in Copyright Law*, 102 IOWA L. REV. 605, 621 nn.70, 72 (2017); Avani Mehta Sood, *Attempted Justice: Misunderstanding and Bias in Psychological Constructions of Criminal Attempt*, 71 STAN. L. REV. 593, 673 n.302 (2019).

178. See *infra* Part II.

179. See *infra* notes 214, 297 and accompanying text. Professor Sarnoff provided this insight.

different in significant ways. With substantial similarity, courts determine what is copyrighted and what is copied jointly. In contrast, patent law's doctrine of equivalents helps ensure the patent scope is commensurate with what patentees ought to receive in their claims. And trademark law focuses on the similarity of plaintiffs' and defendants' marks and on defendants' willful infringement in determining the likelihood of confusion.<sup>180</sup> Nonetheless, like in zoology, knowing how a member of an animal species behaves and why it has resisted the decline seen in other species in the same genus can help broaden one's understanding of the law beyond niche areas and promote cross-fertilization of insights. This Article discusses these insights in Part III.

For this Article, Excel was initially used to hand-code the data before converting it to IBM SPSS Statistics to generate the graphs and crosstabs. Like all empirical studies, this one has its caveats. There are several well-recognized limitations to case content study databases. First, coding may result in incomplete or inaccurate coding, despite cross-coding and verification using a population sample.<sup>181</sup> Given, however, that the focus is on features of written decisions, the data remain valid as long as they are recognized to refer to a specific population rather than a sample of all cases in all possible worlds.<sup>182</sup> Second, legal databases such as Westlaw are known to underreport jury decisions.<sup>183</sup> To some degree, comparing this study to others that employ similar methods to control for that feature can mitigate it.

Like earlier empirical studies employing the case content analysis method, this study avoids regression analysis because "invariance produces enormous regression coefficients and standard errors that severely limit the utility of the regression results."<sup>184</sup> Instead, this Article employs the Fisher Exact Test for contingency tables to test the null hypothesis that a case attribute is independent of case outcome.<sup>185</sup> This contingency table approach is more appropriate than regression because

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180. See *infra* Section III.A–B; Beebe, *supra* note 167, at 1582 (stating that in trademark law, a finding that the similarity of the marks factor that does not result in a likelihood of confusion is dispositive).

181. See, e.g., Lim, *supra* note 169.

182. *Id.*

183. Allison & Lemley, *supra* note 171, at 963–64 (“The universe of all decisions is of course different from the universe of those reported in Westlaw, and in particular our study underreports jury decisions. But our focus on written decisions (both reported and unreported) allows us to parse the grounds for decision and the reasoning of the opinions.”).

184. See, e.g., Beebe, *supra* note 167, at 1600 & n.85 (noting “[r]egression analysis is inappropriate” for these studies, raising “the problem of ‘zero cell count’ in which the dependent variable, here, the outcome of the multifactor test, is invariant for one or more values of an independent variable”).

185. See Appendix (June 2020), [https://bit.ly/SPSSdataset\\_June2020](https://bit.ly/SPSSdataset_June2020) [<https://perma.cc/7TMF-QT7K>].

the outcomes and attributes are all categorical variables. Furthermore, the Fisher Exact Test is more relevant than a chi-squared test because many of the cells have expected counts less than five.<sup>186</sup> This study calculates Monte Carlo p-values with 50,000 samples. Finally, the reported data are kept to whole numbers without decimal places, following the convention in other empirical studies.<sup>187</sup>

Analysis of judicial opinions has well-known limitations.<sup>188</sup> Statistics fail to account for extralegal factors influencing judging, such as summary affirmances, the state of the record on appeal, and judicial deliberations discussed in the opinion.<sup>189</sup> Litigants may consider the expertise and reputation of the district court judge in deciding whether to appeal, introducing selection bias effects into the appellate data.<sup>190</sup> Moreover, most cases settle, so decided cases are a nonrandom subset of all cases.<sup>191</sup>

The complexity of copyright litigation also makes it difficult to generalize, even from a study covering hundreds of cases.<sup>192</sup> Parties are not randomly distributed throughout the judicial districts.<sup>193</sup> Some district courts may hear more cases that eventually settle or were filed based on

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186. See G.H. Freeman & J.H. Halton, *Note on an Exact Treatment of Contingency, Goodness of Fit and Other Problems of Significance*, 38 *BIOMETRIKA* 141, 142, 149 (1951); Sture Holm, *A Simple Sequentially Rejective Multiple Test Procedure*, 6 *SCANDINAVIAN J. STAT.* 65, 65 (1979).

187. See, e.g., Ted Sichelman, *Myths of (Un)certainty at the Federal Circuit*, 43 *LOY. L.A. L. REV.* 1161, 1180–82 (2010) (utilizing only whole percentages to reflect data); Ryan T. Holte & Ted Sichelman, *Cycles of Obviousness*, 105 *IOWA L. REV.* 107, 158 tbl.4 (2019) (same); see also TJ Cole, *Too Many Digits: The Presentation of Numerical Data*, 100 *ARCHIVES DISEASE CHILDHOOD* 608, 609 (2015) (“The general principle is to use two or three significant digits for effect sizes, and one or two significant digits for measures of variability.”).

188. See R. Polk Wagner & Lee Petherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 *U. PA. L. REV.* 1105, 1128–29 (2004) (discussing unobserved reasoning, strategic behavior, and selection bias).

189. See Harry T. Edwards & Michael A. Livermore, *Pitfalls of Empirical Studies that Attempt to Understand the Factors Affecting Appellate Decisionmaking*, 58 *DUKE L.J.* 1895, 1899 (2009).

190. David L. Schwartz, *Practice Makes Perfect? An Empirical Study of Claim Construction Reversal Rates in Patent Cases*, 107 *MICH. L. REV.* 223, 243 (2008).

191. See Jay P. Kesam & Gwendolyn G. Ball, *How Are Patent Cases Resolved? An Empirical Examination of the Adjudication and Settlement of Patent Disputes*, 84 *WASH. U. L. REV.* 237, 273 tbls.4 & 5, 274 tbl.6 (2006) (finding that between 65%–68% of all patent cases filed in three particular years were resolved via settlement or probable settlement).

192. See Petherbridge, *supra* note 170, at 1380 (noting biases inherent in this approach, such as “unobserved reasoning, selection bias, and strategic behavior”); David L. Schwartz, *Explaining the Demise of the Doctrine of Equivalents*, 26 *BERKELEY TECH. L.J.* 1157, 1188 (2011) (“Because patent litigation as a whole is so complex, it is incredibly complicated to develop and test empirical models.”).

193. See Kimberly A. Moore, *Forum Shopping in Patent Cases: Does Geographic Choice Affect Innovation?*, 79 *N.C. L. REV.* 889, 924–26, 930 (2001).

domicile.<sup>194</sup> Therefore, “district court judges are not assigned a random sample . . . of patent lawsuits, because district court judges are assigned cases from the judicial district in which they sit.”<sup>195</sup> A particular judge or jury may cause a case to settle, while the same case before a different judge or jury could end up on appeal.<sup>196</sup> This Article focuses on how appellate and lower courts interpret precedent. Indeed, those interpretations are not uniform and cannot ever be.<sup>197</sup>

Another limitation concerns case outcomes. The Priest-Klein “selection hypothesis” predicts that, given various conditions, plaintiff win rates at trials should approach 50%, because only close cases survive settlement or summary adjudication.<sup>198</sup> To be true, the hypothesis assumes parties have equal stakes in the litigation.<sup>199</sup> More recent studies, including those dealing specifically with intellectual property law, cast the 50% hypothesis in doubt.<sup>200</sup> Professors Ryan Holte and Ted Sichelman note that “changes in litigation budgets, attorney quality, and other unobservable factors” may have changed the behavior of parties rather than judicial decision-making.<sup>201</sup> Moreover, technological quirks

194. See Schwartz, *supra* note 190, at 241–42.

195. *Id.* at 242.

196. See *id.* at 242 n.119 (“[I]f [judges] have a really tough case, they can put tremendous pressure on the parties to settle so there won’t be an appealable order.” (alterations in original) (quoting Eric Herman, *Charting the Yays and Nays in Federal Court*, CHI. LAW., Mar. 1996, at 1, 10)).

197. See Jeffrey J. Rachlinski, *Does Empirical Evidence on the Civil Justice System Produce or Resolve Conflict?*, 65 DEPAUL L. REV. 635, 636 (2016) (“[E]ven when the empirical scholars completely agree on the underlying facts, interpretation of the results can dramatically differ. Empirical legal scholarship is still worth conducting, but the hope that it will resolve partisan debates in law is unrealistic.”).

198. See George L. Priest & Benjamin Klein, *The Selection of Disputes for Litigation*, 13 J. LEGAL STUD. 1, 4–6, 17–18 (1984). Priest-Klein’s 50% has been modified when there are different stakes involved, for example, if the plaintiff has more to win than the defendant has to lose. See Yoon-Ho Alex Lee & Daniel Klerman, *Updating Priest and Klein 20–22* (USC Ctr. for L. & Soc. Sci., Research Paper No. 15-21, 2015), [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2619856](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2619856) [<https://perma.cc/LBV2-UB2H>].

199. Priest & Klein, *supra* note 198, at 24.

200. See, e.g., Theodore Eisenberg, *Testing the Selection Effect: A New Theoretical Framework with Empirical Tests*, 19 J. LEGAL STUD. 337, 339 (1990) (testing the 50% hypothesis and rejecting it as a description of all civil litigation); see also Mark A. Lemley & Colleen V. Chien, *Are the U.S. Patent Priority Rules Really Necessary?*, 54 HASTINGS L.J. 1299, 1310–12 (2003) (arguing that the Priest-Klein hypothesis is not borne out by the data in patent cases); Jason Rantanen, *Why Priest-Klein Cannot Apply to Individual Issues in Patent Cases 5* (Univ. of Iowa Legal Stud., Research Paper No. 12-15, 2013), [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2132810](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2132810) [<https://perma.cc/Q38A-SNAK>] (“At best, the Priest-Klein hypothesis only applies to the selection of disputes, not the selection of individual issues. Due to the presence of multiple issues in patent cases, there is axiomatically no basis for inferring that a patentee would expect a fifty-percent chance of winning on each one.”).

201. See Holte & Sichelman, *supra* note 187, at 161.

and the nature of the parties result in fact-specific outcomes,<sup>202</sup> as might many interrelated legal doctrines.<sup>203</sup> With these caveats in mind, the discussion turns to the theory underlying substantial similarity and to the points of departure from conventional wisdom in practice.

## II. A SILENT DEATH

Substantial similarity is in unprecedented decline. This Part describes how and why.<sup>204</sup> In the 1970s, plaintiffs enjoyed remarkable success, winning 63% of cases, blowing through even the generous 50% mark.<sup>205</sup> By the 1980s, plaintiffs won 36% of the time.<sup>206</sup> The figure fell to 22% between 1995 and 2000.<sup>207</sup> Like the proverbial canary in a coalmine, substantial similarity's decline might have mirrored a shift in copyright law against owners, as the Supreme Court ruled against them on an array of issues ranging from copyrightability to fair use.<sup>208</sup> Supreme Court decisions over the last twenty years have favored plaintiffs in nine out of the twelve copyright cases (although the Court did not address the substantial similarity doctrine directly),<sup>209</sup> with only three decisions

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202. Schwartz, *supra* note 192, at 1187 (“For example, patent litigation between branded and generic drug manufacturers differs from patent litigation over a business method patent held by a non-practicing entity.”).

203. *See id.* at 1188 (“Changes in precedent can alter lawyers’ behavior in drafting patents. Furthermore, changes in precedent can also influence party behavior in litigation.”).

204. This abbreviated presentation draws on the extensive analysis in Lim, *supra* note 33.

205. Lippman, *supra* note 8, at 537; *see also supra* Section I.C (noting that the Lippman dataset only reports on appellate cases and district court cases with appellate opinions).

206. Lippman, *supra* note 8, at 538.

207. *Id.* at 539.

208. *See id.* at 540–41. Out of the five copyright decisions between 1970 and 2010, three ruled against the plaintiff. *See* Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 363 (1991) (holding data compiled in telephone directory uncopyrightable); Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 454–55 (1984) (holding that time-shifting was fair use); Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 588 (1994) (holding appropriation of song elements in commercialized parody could be fair use); *see also* Lippman, *supra* note 8, at 541 (“[Campbell] may have induced a trend in substantial similarity decisions to construe the boundaries of infringement more liberally, absolving more alleged infringers from liability and impacting the decline in substantial similarity win rates through the mid-1990s.”); *cf.* Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 569 (1985) (holding that unauthorized publication of verbatim excerpts from unpublished memoirs were not fair use); Stewart v. Abend, 495 U.S. 207, 235–36 (1990) (holding that statutory successors were entitled to renewal rights, though the author previously assigned them to another party).

209. *See* N.Y. Times Co. v. Tasini, 533 U.S. 483, 487–88 (2001) (preventing publishers of periodicals from relicensing individual articles to databases absent transfer of copyright or any rights thereunder from authors of individual articles); Eldred v. Ashcroft, 537 U.S. 186, 194 (2003) (holding Copyright Term Extension Act of 1998 constitutional); Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd., 545 U.S. 913, 919 (2005) (holding distributors of device promoting infringement liable for third parties’ infringing acts); Reed Elsevier, Inc. v. Muchnick, 559 U.S.

favoring defendants.<sup>210</sup> This should have been a boom time for plaintiffs; it was anything but.

Plaintiffs won a trifling 11% of cases in the district courts between 2010 and 2019 (compared to 24% between 1923 and 2011) and 0% on appeal between 2010 and 2019 (compared to 32% between 1923 and 2011).<sup>211</sup> Plaintiff win rates on procedure were higher—23% (in district court), but only for successfully fending off a defendant’s motion to dismiss or summary judgment motion.<sup>212</sup> Procedural wins on appeal in favor of plaintiffs were at 3%.<sup>213</sup> Plaintiff win rates in recent substantial similarity cases are meager compared to plaintiff nonliteral infringement win rates of 24% in doctrine of equivalence cases (in district court) and 22% (on appeal).<sup>214</sup> They are even lower compared to plaintiff win rates in civil litigation, recently around 30%.<sup>215</sup>

### A. *Three Red Herrings*

Currently, plaintiffs struggle to prove copyright infringement in a way never before seen. Neither the tests courts apply, the circuits they reside in, nor the works at issue adequately account for this startling finding.

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154, 157 (2010) (holding that registration requirement does not restrict federal court’s subject-matter jurisdiction for infringement suits involving unregistered works); *Golan v. Holder*, 565 U.S. 302, 306–08 (2012) (holding that protection for preexisting works of Berne member countries in country of origin, but not in the United States, is constitutional); *Am. Broad. Cos. v. Aereo, Inc.*, 573 U.S. 431, 436 (2014) (holding that provider that sold subscribers broadcast television programming streamed over the Internet from small antennas infringed copyright); *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 667 (2014) (denying a defense of laches for damages claims brought within the Copyright Act’s three-year statute of limitations); *Kirtsaeng v. John Wiley & Sons, Inc.*, 136 S. Ct. 1979, 1983 (2016) (holding that a district court awarding attorney’s fees to prevailing party should give substantial weight to reasonableness of losing party’s position); *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017) (holding that a feature in a useful article is eligible for copyright protection and setting out the test for eligibility).

210. See *Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 525 (2013) (“We hold that the ‘first sale’ doctrine applies to copies of a copyrighted work lawfully made abroad.”); *Rimini St., Inc. v. Oracle USA, Inc.*, 139 S. Ct. 873, 876 (2019) (holding that federal district courts can award “full costs” to party in copyright litigation only in six categories of costs specified by Congress); *Fourth Est. Pub. Benefit Corp. v. Wall-Street.com, LLC*, 139 S. Ct. 881, 886–87 (2019) (holding that a copyright claimant may commence an infringement suit when the Copyright Office registers a copyright, not when an owner submits application, materials, and registration fee to the Office).

211. See Appendix, *supra* note 185; see also Lippman, *supra* note 8, at 555 (noting the decrease in plaintiff-favorable holdings, especially on appeal).

212. See Appendix, *supra* note 185.

213. See Appendix, *supra* note 185.

214. See Lim, *supra* note 169.

215. See Alexandra D. Lahav & Peter Siegelman, *The Curious Incident of the Falling Win Rate: Individual vs System-Level Justification and the Rule of Law*, 52 U.C. DAVIS L. REV. 1371, 1373 (2019) (tracking plaintiff win rates in civil litigation).

Instead, this Article identifies two factors contributing to this trend: pretrial motions and nonrival defendants.

### 1. Variances Between Existing Tests?

Given the controversy surrounding the existing tests one might expect stark variances in plaintiff win rates between them.<sup>216</sup> After all, courts have shown that they have no consistent way to compare two works, and there are other points of disagreement, including whether the baseline to assess similarity should be the original work or the accused work.<sup>217</sup>

Figure 1 (below) shows test variations across circuits (both at the district and appellate levels), clearly establishing the ordinary observer test's dominance in Second Circuit courts, and the extrinsic/intrinsic test's dominance in Ninth Circuit courts. Most circuits track one or the other, with the Sixth and Tenth Circuits employing both interchangeably. Few courts used the abstraction/filtration/comparison test, and none applied more than one test. Surprisingly, the chosen test generally made little difference to the outcome.<sup>218</sup> Plaintiffs were decimated regardless of the tests courts used (see Figure 2 below), even if differences in win rates among the application of the tests remain.

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216. See Lippman, *supra* note 8, at 539 (“Such a significant downturn may reflect the impact of then-recent decisions that either outlined a new test or applied an old test in a new way.”); see also Hickey, *supra* note 8, at 684 (“Much commentary on substantial similarity defends one of the existing tests as superior or proposes to replace the confused doctrine with a new standard.”).

217. See, e.g., *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 564–66 (1985) (using multiple baselines in noting that amount copied was a quantitatively “insubstantial” part of the original work but also “13% of the infringing article”); see also *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936) (rejecting defendants’ work as the baseline to prevent plagiarists from “excus[ing] the wrong by showing how much of his work he did not pirate”); cf. *Narell v. Freeman*, 872 F.2d 907, 913 (9th Cir. 1989) (“[I]nsignificant infringement may be substantial only if the material is qualitatively important to either [the accused] or [the original] work.”).

218. Lippman, *supra*, note 8, at 544. Between 1923 and 2011, the breakdown of how often each test was used is as follows: ordinary observer test (55%), followed by the extrinsic/intrinsic test (28%) and the abstraction/filtration/comparison test (7%). *Id.*; see also *id.* at 546 (finding that plaintiffs succeeded within a consistent range—the ordinary observer test (33%), the extrinsic/intrinsic test (25%), and the abstraction/filtration/comparison test (24%)). Between 2010 and 2019, the breakdown of success rates is as follows: ordinary observer test (5%); extrinsic/intrinsic test (2%). See *infra* Figure 2.



Figure 1: Circuits and Test Applied (2010–2019)

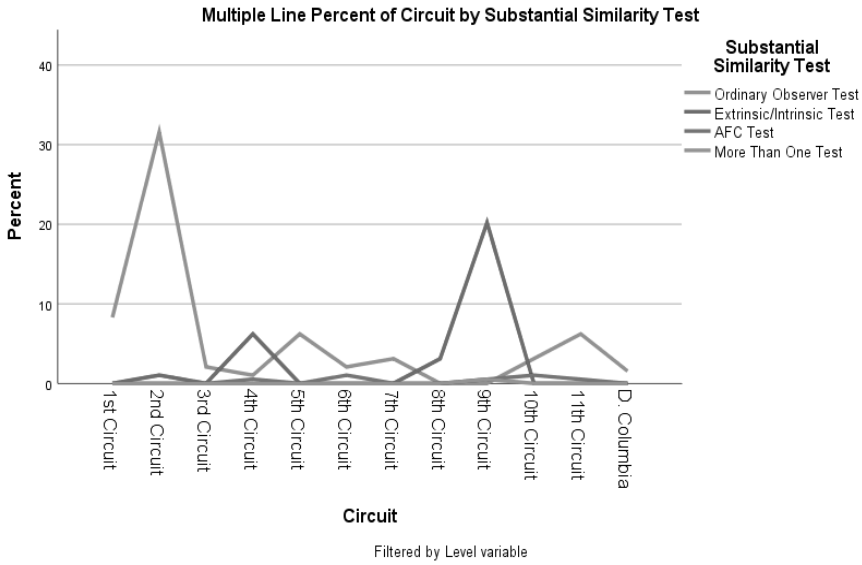
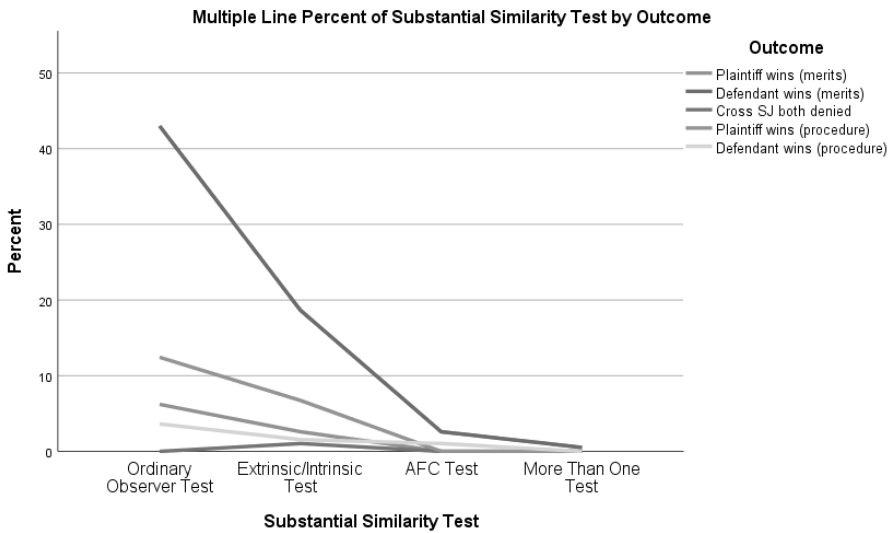


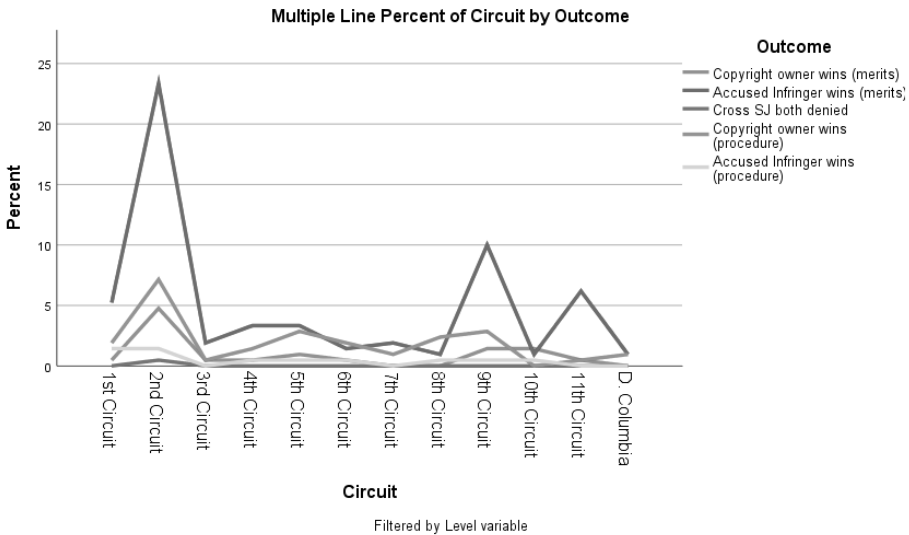
Figure 2: Tests and Outcomes (District Court) (2010–2019)



### 2. Variances Between Circuits?

While a few circuits have made significant modifications to their central approach, the more discerning observer test is the “dominant approach to copyright infringement analysis today.”<sup>219</sup> Could the fact that the Second Circuit hears most substantial similarity cases be the reason for the test’s demise? Intriguingly, outcomes based on circuit variations have been remarkably consistent. Between 1923 and 2011, the Second Circuit and Ninth Circuit reported comparable win rates at both the trial (24% compared to 22%) and appellate levels (33% compared to 34%).<sup>220</sup> Between 2010 and 2019, Second Circuit district courts found for plaintiffs in 4.8% of cases, and there were no appellate cases. In the Ninth Circuit, plaintiff win rates were 1.4% (in district court) and 8% (on appeal), again reflecting a consistently low win rate.<sup>221</sup>

Figure 3: Outcomes by Circuit (District Courts) (2010–2019)



### 3. Variances Between Works of Authorship?

With copyright law covering such diverse media types and forms of expression, substantial similarity strains at being a one-size-fits-all test. Unsurprisingly, the literature is rich with calls for courts to better map

219. Balganes, *supra* note 4, at 794, 796.

220. See Lippman, *supra* note 8, at 545 fig.4; see also *id.* at 535 (reporting that over 80% of the appellate opinions “were issued from 1980 to 2011”).

221. See Appendix, *supra* note 185.

substantial similarity tests to the type of work at issue.<sup>222</sup> The Copyright Act protects “original works of authorship fixed in any tangible medium of expression.”<sup>223</sup> The Act lists eight categories of protected works: literary; musical; dramatic; pantomime and choreographic; pictorial, graphic, and sculptural; motion picture and other audiovisual; sound recording; and architectural.<sup>224</sup>

These categories are neither rigid nor closed. For instance, the Copyright Act of 1790<sup>225</sup> protected only maps, charts, and books.<sup>226</sup> Musical compositions were routinely registered as “books” until the Copyright Act was amended in 1831.<sup>227</sup> When the computer industry’s growth and profitability of mass-marketed software made illicit copying of computer programs inexpensive, easy, and prevalent, copyright law provided a ready solution.<sup>228</sup> Some studies use as few as two categories, while others use up to six categories.<sup>229</sup> This study uses eight categories that best reflect the types of works in the dataset: literary; musical; pictorial, graphical, and sculptural; computer programs; factual; architectural; dramatic; and cinematographic.

A seasoned observer of copyright cases would guess that works with rich, expressive content, such as literary and musical works, would receive more significant protection than databases, computer programs, or architectural works, which are factual or functional and, therefore, lie closer to the edge of the unprotectable ideas, *scènes à faire*, or the merger doctrine discussed in Section I.B.<sup>230</sup> Surprisingly, the data show that this is not the case.

222. See Samuelson, *supra* note 4, at 1823 (“[C]ourts [should] tailor infringement tests based on characteristics of the works at issue.”); Lieberman, *supra* note 9, at 93–96; Jennifer Understahl, Note, *Copyright Infringement and Poetry: When Is a Red Wheelbarrow The Red Wheelbarrow?*, 58 VAND. L. REV. 915, 944 (2005); Busek, *supra* note 138, at 1781; David Nimmer et al., *A Structured Approach to Analyzing the Substantial Similarity of Computer Software in Copyright Infringement Cases*, 20 ARIZ. ST. L.J. 625, 638 (1988).

223. 17 U.S.C. § 102(a).

224. *Id.* § 102(a)(1)–(8).

225. Ch. 15, 1 Stat. 124.

226. See *id.* § 1, 1 Stat. at 124. See generally Peter K. Yu, *The Copy in Copyright*, in INTELLECTUAL PROPERTY AND ACCESS TO IM/MATERIAL GOODS 65 (Jessica C. Lai & Antoinette Maget Dominicé eds., 2016) (discussing the historical development of American copyright law).

227. WILLIAM F. PATRY, COPYRIGHT LAW AND PRACTICE 30 n.91 (2000), as reprinted in DIGIT. L. ONLINE, <http://digital-law-online.info/patry/patry5.html> [<https://perma.cc/7CAM-E38T>].

228. Root, *supra* note 53, at 1291–92.

229. See, e.g., Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549, 572 (2008) (looking at “new media” and “traditional two-dimensional nonvirtual print media”); Rogers, *supra* note 174, at 926 (dividing six types of subject matter into “high-tech subject matter” and “low-tech subject matter”).

230. See, e.g., Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 563 (1985) (“The law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy.”).

Figure 4 (below) shows plaintiffs had a higher percentage of wins in literary as well as in pictorial, graphic, and sculptural works than in the other categories of works. However, a closer look reveals that there were many more cases in these two categories of works than in the other ones. What is more telling, therefore, is the gap between defendant and plaintiff win rates. As Figure 5 (below) indicates, the win rates in both of those categories are approximately the same as those in computer programs, factual, and architectural works. Overall, plaintiffs fared abysmally with dramatic works and did surprisingly well with cinematographic works.

Figure 4: Type of Work by Outcome (District Courts) (2010–2019)

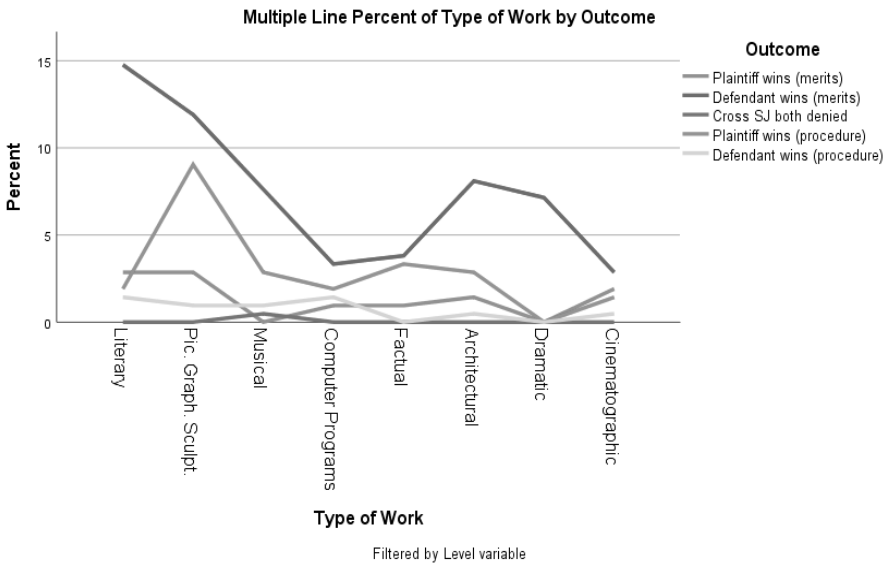


Figure 5: Table Comparing Plaintiff Win Rates by Type of Work (1923–2019)

Type of Work	1923–2011 Plaintiff Win Rate (%)	2010–2019 Plaintiff Win Rate (%)
Literary	20.5	13.6
Pic., Graph., Sculpt.	52.9	11.5
Musical	21.4	0.0
Computer Programs	30.0	12.5
Factual	39.1	11.8
Architectural	8.3	11.1
Dramatic	Not reported	0.0
Cinematographic	Not reported	28.6

Given the demise of substantial similarity, the odds are generally stacked against plaintiffs.<sup>231</sup> The truth behind the high percentage of plaintiff wins in cinematographic work is less dramatic than it appears at first glance. The dataset reported only fourteen cases (out of 210 district court opinions). The four cases finding in favor of plaintiffs skew the actual likelihood of plaintiff wins. It is worth noting that, in 2010, a leading entertainment litigator observed that copyright infringement “claims against motion picture studios and television networks, for all intents and purposes, are dead.”<sup>232</sup>

Putting to rest three common reasons for case outcomes merely begs the question—what killed substantial similarity? The Lippman study provides a critical clue. According to it, 55% of cases where the plaintiff won were bench and jury trials.<sup>233</sup> In contrast, it observed that only 14% of such trials ended up favoring alleged infringers.<sup>234</sup> Summary judgment motions flip the picture, making up only 3% of plaintiff wins, but a whopping 51% of defendant wins.<sup>235</sup> The Lippman study concluded that “a defendant-favorable district court decision finding that the works are not substantially similar is less likely to be overturned on appeal because, in most cases, that decision was made at the summary judgment stage; and, presumably, the case is weak or frivolous.”<sup>236</sup>

While plausible, concluding that pretrial motion dismissals equate to plaintiffs bringing weak or frivolous cases is unsatisfying. The fact is, at least as a matter of litigation burden, defendants have it easier. They need only show that plaintiffs failed to make out their case on the pleadings, specifically a lack of substantial similarity, for instance, through the copying of unprotected elements. By contrast, plaintiffs must satisfy a gamut of factual and legal issues to prevail. Moreover, the evidentiary requirements under summary judgment are lower than at trial. A more robust answer therefore needs to consider how courts make substantial similarity determinations.

Over the years, courts and commentators continued to praise the centrality of juries.<sup>237</sup> In theory, this would safeguard plaintiffs against

231. Lippman, *supra* note 8, at 522 (observing a “concern that case law is sharply skewed in favor of the defendants”).

232. Steven T. Lowe, *Death of Copyright*, L.A. LAW., Nov. 2010, at 32, 32; *see also* Lippman, *supra* note 8, at 520–21 (“In the last twenty years, all forty-eight copyright infringement lawsuits against motion picture studios and television networks within the Second and Ninth Circuits and their district courts resulted in defendant victories.”).

233. *See* Lippman, *supra* note 8, at 556.

234. *Id.*

235. *Id.*

236. *Id.* at 557 (footnote omitted).

237. *See* Loren & Reese, *supra* note 1, at 646 (“Substantial similarity is a question of fact.”); Ben Depoorter & Robert Kirk Walker, *Copyright False Positives*, 89 NOTRE DAME L. REV. 319,

defendants seeking quick disposal of the case on a motion to dismiss or summary judgment motion.<sup>238</sup> This Article reveals a surprising partnership in practice between judges and defendants formed to usurp the jury's role.

### B. *Judicial Usurpers*

Unlawful appropriation rests on the plaintiff's protectable expression and the relevant public's impression—for whose benefit copyright exists in the first place.<sup>239</sup> For this reason, *Arnstein* placed juries at the center of its test for substantial similarity.<sup>240</sup> Part I emphasizes that a jury is “peculiarly fitted to determine” the response of the lay hearer.<sup>241</sup>

At the same time, defendants may bring motions for summary judgment, inviting judges to make favorable and expedient determinations.<sup>242</sup> When this happens, judges may rule on substantial similarity as a matter of law if defendants offer sufficient evidence in their pleadings that no reasonable jury could find unlawful appropriation.<sup>243</sup> Courts have also extended this practice to defendants' motions to

351 (2013) (“[A] showing of substantial similarity is a question of fact . . . .”); *see also* *Shaw v. Lindheim*, 919 F.2d 1353, 1355 (9th Cir. 1990) (stating that summary judgment is “not highly favored” on questions of substantial similarity in copyright cases (quoting *Narell v. Freeman*, 872 F.2d 907, 909–10 (9th Cir. 1989))), *overruled by* *Skidmore v. Led Zeppelin*, 952 F.3d 1051 (9th Cir. 2020) (en banc); Oren Bracha & John M. Golden, *Redundancy and Anti-Redundancy in Copyright*, 51 CONN. L. REV. 247, 275 (2019) (“[T]he substantial similarity standard . . . is applied case by case and often by juries . . . .”); *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 63 (2d Cir. 2010) (“[Q]uestions of non-infringement have traditionally been reserved for the trier of fact.”).

238. *See, e.g.*, *TufAmerica, Inc. v. Diamond*, 968 F. Supp. 2d 588, 604 (S.D.N.Y. 2013) (denying motion to dismiss copyright claim against defendant who used the lyrical phrase and recording “say what” sampled from plaintiff's song); *Herzog v. Castle Rock Ent.*, 193 F.3d 1241, 1247 (11th Cir. 1999) (noting that courts historically have been reluctant to make subjective determinations in copyright cases regarding the similarity between two works on summary judgment); *Osterberg*, *supra* note 51.

239. *See* *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946), *abrogated on other grounds by* *Heyman v. Com. & Indus. Ins. Co.*, 524 F.2d 1317 (2d Cir. 1975); *see also* *Balganesh*, *supra* note 4, at 794 (“[C]ourts around the country take their guidance on the copyright infringement analysis from a landmark decision of the Second Circuit that is believed to have defined the structure of the infringement inquiry and the jury's role in it . . . .”).

240. *See supra* Section I.B.

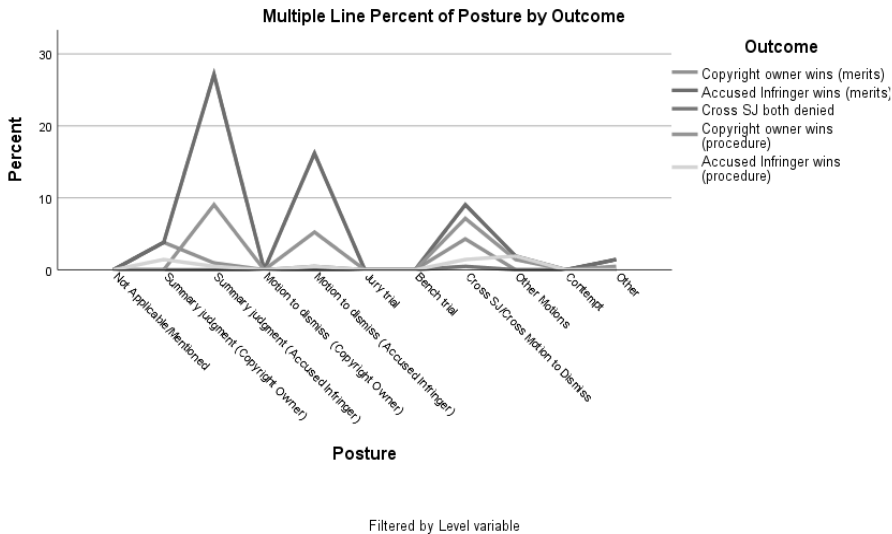
241. *Arnstein*, 154 F.2d at 473.

242. *See, e.g.*, *Boone v. Jackson*, 206 F. App'x 30, 31–32 (2d Cir. 2006) (affirming summary judgment in favor of defendant for the use of lyrical phrase “Holla Back” and noting deposition testimony that contradicted plaintiff's prior assertions).

243. *See, e.g.*, *Litchfield v. Spielberg*, 736 F.2d 1352, 1354, 1357 (9th Cir. 1984) (upholding summary judgment on the ground that no reasonable jury could find substantial similarity).

dismiss.<sup>244</sup> In an astonishing 62% of cases, judges readily accepted a defendant’s invitation to rule on substantial similarity on one motion or the other without an iota of jury input.<sup>245</sup>

Figure 6: Posture by Outcome (2010–2019)



This finding eviscerates conventional wisdom that juries command the outcome of infringement cases.<sup>246</sup> Figure 7 (below) shows the devastating impact of defendant pretrial motions on plaintiff win rates. Plaintiffs prevail about 40% of the time when they bring a pretrial motion, compared to 74% when defendants bring a summary judgment motion, and 76% on a motion to dismiss.<sup>247</sup> In the mid-1980s, plaintiff win rates fell as the practice became comparatively more prevalent.<sup>248</sup> Surely,

[t]his result raises the possibility that summary judgment on the substantial similarity issue may actually decrease the

244. See *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 64 (2d Cir. 2010) (noting that, when evaluating substantial similarity on a motion to dismiss, “no discovery or fact-finding is typically necessary, because ‘what is required is only a visual [or aural] comparison of the works’” (quoting *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 766 (2d Cir. 1991))).

245. See Appendix, *supra* note 185.

246. See, e.g., *Balganesh*, *supra* note 4, at 796–97 (describing *Arnstein* as giving “juries complete control over the question of improper appropriation in the infringement analysis”).

247. See Appendix, *supra* note 185.

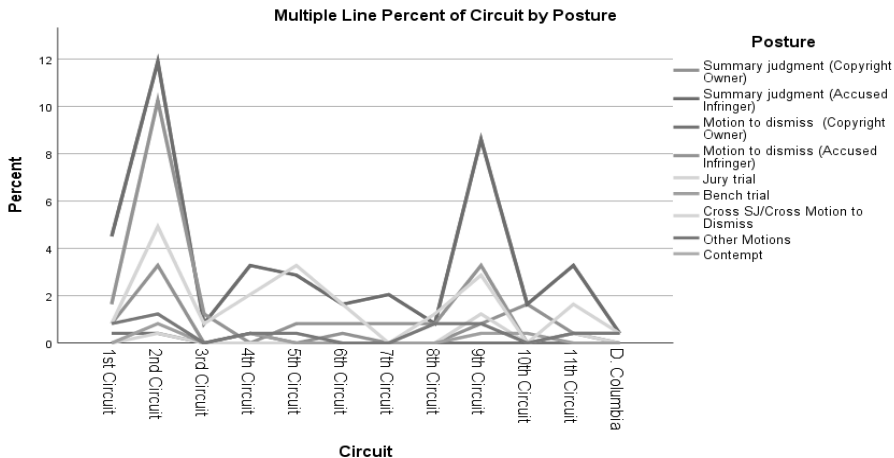
248. See *Lippman*, *supra* note 8, at 554; see also *id.* at 557 (“[A]n increase in summary adjudications coincides with a decline in the frequency of trials, but it also corresponds to a decrease in substantial similarity win rates.”).

likelihood that a copyright holder will prevail due to the fact that the proper test for substantial similarity—which “requires the response of the ordinary lay observer,” not the judge—is not applied.<sup>249</sup>

In theory, the move from cases based on the earlier Copyright Act of 1909<sup>250</sup> may have influenced case outcomes. However, nothing in scholarly commentary indicates a material difference in the test courts applied. For instance, contemporary cases continued to apply *Arnstein*, decided in 1946, without distinguishing between the relevant Acts.<sup>251</sup>

An important related question is whether there are circuit variances in this trend. Professor Robert Helfing anecdotally observes this practice in the context of the Second and Ninth Circuits. Professor Helfing notes that the Second Circuit “has loosened the reins and expressly authorized the summary resolution of claims on the basis of a judge’s emotional response to works of authorship.”<sup>252</sup> In contrast, “The Ninth Circuit has been mostly faithful to this judicial restraint.”<sup>253</sup> Figure 8 (below) shows that Professor Helfing is only partially correct. The Second Circuit granted defendants’ summary judgments and motions to dismiss in 67% of its caseload.<sup>254</sup> In comparison, the Ninth Circuit did so in 66% of its caseload.<sup>255</sup>

Figure 7: Circuit by Posture (2010–2019)



249. See Lippman, *supra* note 8, at 557 (quoting Julie J. Bisceglia, *Summary Judgment on Substantial Similarity in Copyright Actions*, 16 HASTINGS COMM’NS & ENT. L.J. 51, 55–56 (1993)).

250. Ch. 320, 35 Stat. 1075.

251. See *supra* Section I.B.

252. Helfing, *supra* note 10, at 764.

253. *Id.*

254. See Appendix, *supra* note 185.

255. See Appendix, *supra* note 185.



It is unlikely that judges intend to impede plaintiffs' right of access to jury trials, but a finding of evidentiary insufficiency blocks the route nonetheless. Judges engaging in this practice usually begin with the mantra that "a court may make a finding of non-infringement as a matter of law on summary judgment if the similarity between the works concerns only non-copyrightable elements, or if no reasonable jury, properly instructed, would find as to the protectable elements that the two works are substantially similar,"<sup>256</sup> and then summarily proceed to do so.<sup>257</sup> Courts themselves have framed this practice as proper as long as a court has before it all that is necessary to make such an evaluation.<sup>258</sup>

To justify this usurpation of substantial similarity cases, some judges touted their expertise. As one judge put it, substantial similarity "is often more reliably and accurately resolved in a summary judgment proceeding. This is so because a judge is better able to separate original expression from the non-original elements of a work where the copying of the latter is not protectable and the copying of the former is protectable."<sup>259</sup> Another judge declared that "the 'substantial-similarity'

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256. *Architects Collective v. Pucciano & English, Inc.*, 247 F. Supp. 3d 1322, 1343 (N.D. Ga. 2017).

257. *See, e.g., Peel & Co. v. Rug Mkt.*, 238 F.3d 391, 395 (5th Cir. 2001) ("Although this question typically should be left to the factfinder, summary judgment may be appropriate if the court can conclude, after viewing the evidence and drawing inferences in a manner most favorable to the nonmoving party, that no reasonable juror could find substantial similarity . . . ." (footnote omitted)); *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327, 1330 (9th Cir. 1983) ("[S]ummary judgment for defendant is appropriate where works are so dissimilar that a claim of infringement is without merit."); *Home Design Servs., Inc. v. Turner Heritage Homes Inc.*, 825 F.3d 1314, 1326 (11th Cir. 2016) ("[W]e stand by the core premise that judges can, in certain cases, remove the question of substantial similarity from jury consideration.").

258. *See Lombardo v. Dr. Seuss Enters., L.P.*, 279 F. Supp. 3d 497, 504 (S.D.N.Y. 2017) ("Numerous courts in this district have resolved the issue of fair use on a motion for judgment on the pleadings by conducting a side-by-side comparison of the works at issue."), *aff'd*, 729 F. App'x 131 (2d Cir. 2018); *Klauber Bros. v. Bon-Ton Stores, Inc.*, 557 F. App'x 77, 80 (2d Cir. 2014) (observing how courts routinely decide the issue of substantial similarity as a matter of law); *see also Wager v. Littell*, 549 F. App'x 32, 34 (2d Cir. 2014) (recognizing that though the issue of substantial similarity is frequently a fact issue for jury resolution, "the issue can be decided as a matter of law, even at the pleading stage, by examining the four corners of the complaint together with the works themselves when 'no reasonable jury, properly instructed, could find that the two works' are strikingly similar." (quoting *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 63–64 (2d Cir. 2010))); *Peter F. Gaito*, 602 F.3d at 63 ("[I]t is entirely appropriate for a district court to resolve that question as a matter of law, 'either because the similarity between two works concerns only non-copyrightable elements of the plaintiff's work, or because no reasonable jury, properly instructed, could find that the two works are substantially similar.'" (quoting *Warner Bros. v. Am. Broad. Co.*, 720 F.2d 231, 240 (2d Cir. 1983))).

259. *Intervest Constr., Inc. v. Canterbury Est. Homes, Inc.*, 554 F.3d 914, 920 (11th Cir. 2008); *see also Lieberman, supra* note 9, at 94 ("[J]urors are not likely to understand such an ephemeral distinction between ideas and expression, especially when applied to areas in which

test is more often correctly administered by a judge rather than a jury—even one provided proper instruction.”<sup>260</sup>

What is the basis of that conclusion? Perhaps judges hear copyright infringement cases with some regularity and develop an expertise. The Supreme Court approved this line of reasoning in patent claim construction by giving judges, rather than juries, the benefit of determining the scope of rights.<sup>261</sup> Another reason may be that judges rendering opinions and setting out their reasoning allow for more substantive accountability than a binary jury verdict finding for one party or the other.<sup>262</sup> In the context of patent infringement cases, the Supreme Court expressed concerns “over unreviewability due to black-box jury verdicts.”<sup>263</sup> As a form of “procedural improvement[ ],” it encouraged district courts to grant summary judgment for the defendant where “no reasonable jury could determine two elements to be equivalent,” or where “legal limitations on the application of the doctrine of equivalents are to be determined by the court, either on a pretrial motion for partial summary judgment or on a motion for judgment as a matter of law.”<sup>264</sup> Unfortunately, this Article reveals that these justifications are generally unsubstantiated.

### 1. The Mirage of Accountability

On the issue of accountability, scholars have criticized judges for using an “I know it when I see it” means to determine substantial similarity and have argued that judges should set out for the record their reasoning in detail.<sup>265</sup> Some courts have defended this practice. One judge recently expressed that “[t]he Court need not explain in its analysis every alleged similarity in a copyright infringement case and may properly disregard alleged similarities that are not protectable.”<sup>266</sup>

Substantial similarity turns on inherently subjective appreciation of a work’s tone and feel. Resolving it as a matter of law risks one judge’s subjective opinion trumping the evidence. Courts may even conclude

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they lack expertise, as is often the case with copyright. Because the issue of misappropriation is so dependent on the interpretation of these underlying principles of copyright law, classifying the issue as purely a question of fact for the jury requires reconsideration.” (footnote omitted)).

260. *Intervest Constr., Inc.*, 554 F.3d at 920.

261. *See* *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388, 391 (1996) (describing how precedent would not undercut the deciding Justice’s authority).

262. *See* *Lim*, *supra* note 169.

263. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39 n.8 (1997).

264. *Id.* On the doctrine of equivalents, see Joshua D. Sarnoff, *Abolishing the Doctrine of Equivalents and Claiming the Future After Festo*, 19 BERKELEY TECH. L.J. 1157, 1162 (2004).

265. *E.g.*, Roodhuyzen, *supra* note 10, at 1376–77.

266. *Alfred v. Walt Disney Co.*, 388 F. Supp. 3d 1174, 1181 (C.D. Cal. 2019), *rev’d*, 821 F. App’x 727 (9th Cir. 2020).

substantial similarity when comparing two works and use the formalistic tests to support their decisions *ex post*.<sup>267</sup>

A recent study on substantial similarity employing a behavioral economics framework shows that courts are sensitive to information about the two works and their creators in a way that “actively distorts” their “assessments of the similarity between the two works, calling into question the purported objectivity of the substantial similarity requirement as a whole.”<sup>268</sup> Even within a single circuit, courts employing the same test can reach vastly different conclusions, as the two examples below illustrate.

First, in *Copeland v. Bieber*,<sup>269</sup> the Fourth Circuit had to determine if Justin Bieber and Usher’s song “Somebody to Love” was substantially similar to the plaintiff’s song with the same name.<sup>270</sup> The district court concluded that while Bieber and Usher’s song had “some elements in common” with the plaintiff’s song, there was a significant difference in the overall “aesthetic appeal” of the respective songs.<sup>271</sup> The appellate court disagreed because “that analysis attaches too much weight to what the district court termed a difference in ‘mood’ and ‘tone,’ and too little to similarities between the ‘element’ of the songs—their choruses—that is most important.”<sup>272</sup>

According to the appellate court, by allowing genre differences to preclude intrinsic similarity, defendants could profit from unlicensed adaptations solely because the work had a different “concept and feel” than the original, with a different “aesthetic appeal.”<sup>273</sup> This would deprive plaintiffs of the full return on their creative efforts in light of what the statute prohibits as infringing conduct that is not fair use.<sup>274</sup> The appellate court also faulted the district court for failing to account for qualitatively significant similarities, declaring “it is clear that when it comes to popular music, a song’s chorus may be the kind of key sequence that can give rise to intrinsic similarity, even when works differ in other respects.”<sup>275</sup> It proceeded to “conclude that their choruses are similar enough and also significant enough that a reasonable jury could find the songs intrinsically similar.”<sup>276</sup> The problem with this conclusion,

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267. See Zahr K. Said, *Reforming Copyright Interpretation*, 28 HARV. J.L. & TECH. 469, 473–75, 522 (2015) (noting a “great divergence in outcomes and reasoning . . . in infringement analysis” and criticizing judges’ “intuitive” approach).

268. See Balganesch et al., *supra* note 3, at 267.

269. 789 F.3d 484 (4th Cir. 2015).

270. *Id.* at 487.

271. *Id.* at 492.

272. *Id.*

273. *Id.* at 493.

274. See *id.* at 493.

275. *Id.* at 493–94.

276. *Id.* at 494.

however, is that juries, not judges, most closely approximate pop music's typical audience.

Second, in *Oracle America, Inc. v. Google Inc.*,<sup>277</sup> both the district and appellate courts applied Ninth Circuit precedent for substantial similarity to computer code.<sup>278</sup> Google copied the thirty-seven Java application protocol interfaces (APIs), which Java programmers are required to use as a standard requirement for interoperability.<sup>279</sup> The district court ruled that, since the code was a functional standard the merger doctrine barred at the time Google copied the code, there was no infringement.<sup>280</sup> It also emphasized that Google copied very little code in the context of the original work.<sup>281</sup>

The U.S. Court of Appeals for the Federal Circuit reversed the district court's decision because the code involved creative choices when it was written.<sup>282</sup> The Federal Circuit also emphasized the total amount copied as an absolute matter, referring to the "7,000 lines" of code Google copied.<sup>283</sup> The view one takes on the issue matters. Critics of the Federal Circuit's approach warn that it "threatens the public's right to the free flow of ideas, the balance at the core of copyright."<sup>284</sup> The view is neither that of the original creator nor the alleged infringer but rather the objective observer (under any of the three substantial similarity tests or under additional tests that would not be based on ordinary observers). Indeed, the questionable perspective that the district court and court of appeals took only serves to underscore how treacherous this inquiry is.

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277. 750 F.3d 1339 (Fed. Cir. 2014).

278. *Id.* at 1357–58. The district court discussed the principles of the filtration step of the abstraction/filtration/comparison test but did not reach the infringement issue directly. *See id.* at 1358, 1377.

279. *Id.* at 1350.

280. *See Oracle Am., Inc. v. Google Inc.*, 872 F. Supp. 2d 974, 978, 998 (N.D. Cal. 2012) ("All agree that Google was and remains free to use the Java language itself."), *rev'd*, 750 F.3d 1339.

281. *Id.* at 1001; *see also* Hickey, *supra* note 8, at 713 ("In fact, 3% was a generous estimate: as both Android and the Java platform writ large contain millions of lines of code, the amount copied is quantitatively infinitesimal regardless of which work is used as the measure.")

282. *See Oracle*, 750 F.3d at 1361 ("We further find that the district court erred in focusing its merger analysis on the options available to Google at the time of copying. It is well-established that copyrightability and the scope of protectable activity are to be evaluated at the time of creation . . . . The focus is, therefore, on the options that were available to Sun/Oracle at the time it created the API packages."); *see also* Hickey, *supra* note 8, at 704 ("[T]he Federal Circuit's approach to the timing problem essentially determined the outcome in *Oracle*.")

283. *See Oracle*, 750 F.3d at 1356, 1359, 1363.

284. Hickey, *supra* note 8, at 724 ("It goes against the core constitutional purpose of 'promot[ing] . . . [p]rogress' for copyright to lock up something as general as an idea, regardless of *when* it attained that status." (alterations in original) (footnote omitted) (quoting U.S. CONST. art. I, § 8, cl. 8)).

## 2. Efficiency vs. Effectiveness

The second reason judges encourage pretrial motions is efficiency. Resources are scarce, and courts justify the need to dispose of cases quickly and effectively.<sup>285</sup> This way, a trial judge can intercept an issue before it gets to the jury.<sup>286</sup> As one court put it, a court “not only has the discretion, but is in fact required to grant summary adjudication in any case where no reasonable fact finder could find equivalence even if equivalence is a factual matter normally reserved for the jury.”<sup>287</sup> With judges intermingling patent and copyright jurisprudence over the years, it would be unsurprising that copyright judges have also adopted the practice of patent judges in embracing pretrial motions.<sup>288</sup>

However, efficiency may come at a dire cost to effectiveness because it is impossible for judges to ever see substantial similarity through the eyes of a jury. The jury’s factual determination is a safety valve to guard against judges cloistered in their courtrooms, becoming arbiters of public perception. This judicial usurpation breeds precisely the sort of arbitrariness that both courts and copyright scholars complain of.

Professor Suja Thomas’s work shows divisions between courts will be frequent whenever courts substitute their judgment of the facts for a jury verdict.<sup>289</sup> Judges look at what a single juror would find and thus fail to replicate the hive mind of an actual jury; they are unable to account for the group decision-making dynamics.<sup>290</sup> Professor Thomas concluded that judges who attempt to decide dispositive motions based on their preconception of what a reasonable jury would find fail and instead splinter legal certainty.<sup>291</sup>

The need for accountability becomes even more evident when one realizes that almost every judge approaches substantial similarity as a

285. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986) (“Summary judgment procedure is properly regarded not as a disfavored procedural shortcut, but rather as an integral part of the Federal Rules as a whole, which are designed ‘to secure the just, speedy and inexpensive determination of every action.’” (quoting FED. R. CIV. P. 1)); *see also Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 977 (2d Cir. 1980) (“[C]ases . . . permit[] courts to put ‘a swift end to meritless litigation’ and to avoid lengthy and costly trials.” (quoting *Quinn v. Syracuse Model Neighborhood Corp.*, 613 F.2d 438, 445 (2d Cir. 1980))).

286. *PrinterOn Inc. v. BreezyPrint Corp.*, 93 F. Supp. 3d 658, 691 (S.D. Tex. 2015) (“Although infringement under the doctrine of equivalents is a fact question, a court may determine as a matter of law that the ‘all limitations’ rule, the prior art, or prosecution history estoppel preclude the claim.”).

287. *Dahl v. Swift Distribs., Inc.*, 757 F. Supp. 2d 976, 982 (C.D. Cal. 2010).

288. *See, e.g., Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 932 (2005) (adopting patent law’s contributory infringement jurisprudence).

289. *See Suja A. Thomas, The Fallacy of Dispositive Procedure*, 50 B.C. L. REV. 759, 760 (2009).

290. *Id.* at 770–73.

291. *See id.* at 784.

matter of first impression. This Article's original dataset revealed that each judge heard an average of one case per *decade*.<sup>292</sup> District court numbers are only marginally better. The U.S. District Court for the Southern District of New York has the most significant level of expertise in substantial similarity. It heard 31% of all district court cases.<sup>293</sup> The next highest figure, at a distant 7%, came from the U.S. District Court for the District of Massachusetts, and not from any district court in the Ninth Circuit.<sup>294</sup> However, even in the Southern District of New York, each judge heard less than two cases per decade.<sup>295</sup>

The nation's *de facto* test is *Arnstein's* ordinary observer test.<sup>296</sup> Regardless of judge or jury, substantial similarity needs reform to allow both lay juries and judges, who likely will encounter it as a matter of first impression, to operate effectively. The urgent need for reform only increases when one considers that judges, probably overwhelmed by the difficulty of applying the tests, alarmingly rely on economic similarities rather than technical similarities to dispose of the cases before them. Section II.C discusses this issue.

### C. *The Hidden Impact of Fair Use*

The Supreme Court described fair use—a defense to infringement—as providing a guarantee of “breathing space within the confines of copyright,” and it acts as a policy lever for courts to avoid the harshness of finding infringement when the circumstances demand it.<sup>297</sup> Substantial similarity and fair use have much in common.<sup>298</sup> Both operate as common law doctrines even though Congress provided a statutory basis for fair use in the Copyright Act.<sup>299</sup> Both present courts with the challenge of

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292. See Appendix, *supra* note 185.

293. See Appendix, *supra* note 185.

294. See Appendix, *supra* note 185.

295. See Appendix, *supra* note 185.

296. See *supra* Section II.A.

297. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994); see also Ann Bartow, *A Restatement of Copyright Law as More Independent and Stable Treatise*, 79 BROOK. L. REV. 457, 471 (2014) (describing how *Campbell* is the Court's “most important nonliteral copying fair use case” and how it “dial[ed] back the importance of commercial use in a fair use evaluation”).

298. See, e.g., Edward Lee, *Warming Up to User-Generated Content*, 2008 U. ILL. L. REV. 1459, 1480 (“The basic test of substantial similarity for infringement—which is vital for the public to evaluate whether its conduct is permissible—is, unfortunately, ‘largely subjective, thus permitting the finder of fact to give effect to its intuitive judgment of the perceived equities in a case.’ And, of course, the fair use doctrine is notoriously fact-specific, leaving little guidance for users of copyrighted works on whether a particular use is fair.” (footnote omitted) (quoting Litman, *supra* note 8, at 1005)).

299. See 17 U.S.C. §§ 106–07 (stipulating exclusive rights are granted “[s]ubject to” fair use); Balganes, *supra* note 8, at 215 (“Unlike fair use, which today finds mention in the Copyright Act of 1976, substantial similarity continues to remain a doctrine that is policed,

applying a single standard across a wide array of works, from software to architectural designs.<sup>300</sup> Under both analyses, courts consider the purpose the defendant seeks to achieve, the harm its copying causes the plaintiff, and whether the defendant's copying amounts to misappropriation.<sup>301</sup> Both fair use and substantial similarity are arbitrary, anecdotal, and misunderstood.<sup>302</sup>

Most relevant for this Article, however, is the fact that both are entrenched in utilitarianism.<sup>303</sup> The second fair use factor requires courts to examine the "nature of the copyrighted work."<sup>304</sup> In contrast, the third factor asks them to consider "the amount and substantiality of the portion used in relation to the copyrighted work as a whole."<sup>305</sup> These are the

enforced, and molded entirely by courts. In this respect it is perhaps more common-law-like than fair use, with courts often finding themselves completely free to adapt the doctrine to new contexts and technological developments." (footnotes omitted)).

300. See, e.g., *Campbell*, 510 U.S. at 577 (stating that fair use cannot "be simplified with bright-line rules, for the [copyright] statute, like the doctrine it recognizes, calls for case-by-case analysis"); Frank H. Easterbrook, *Cyberspace and the Law of the Horse*, 1996 U. CHI. LEGAL F. 207, 209 ("[T]he fair-use criteria are so ambulatory that no one can give a general answer."); Lloyd L. Weinreb, Lecture, *Fair Use*, 67 FORDHAM L. REV. 1291, 1291 (1999) ("For all its exposure, our understanding of fair use has not progressed much beyond Justice Story's observation [that the fair use doctrine] . . . was 'one of those intricate and embarrassing questions . . . in which it is not . . . easy to arrive at any satisfactory conclusion, or to lay down any general principles applicable to all cases.'" (third and fourth alterations in original) (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 344 (C.C.D. Mass. 1841) (No. 4901))); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (recognizing that not all works can be compared in the same way); see also Christina Bohannon, *Taming the Derivative Works Right: A Modest Proposal for Reducing Overbreadth and Vagueness in Copyright*, 12 VAND. J. ENT. & TECH. L. 669, 683 (2010) ("[T]he test for infringement of copyright is vague and determinations must be made 'ad hoc.'" (quoting *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960))).

301. See Balganesch, *supra* note 8, at 272 ("[T]he fair-use determination—at least as codified today—makes use of factors and variables that are legitimately examined as part of the substantial-similarity determination.").

302. See Beebe, *supra* note 229, at 551 ("This affirmative defense represents the most important—and amorphous—limitation on the otherwise extraordinarily broad rights granted to copyright owners under section 106 of the Act."); *id.* at 554 ("[M]uch of our conventional wisdom about our fair use case law, deduced as it has been from the leading cases, is wrong."); see also Lippman, *supra* note 8, at 519 ("[I]t's unclear whether these opinions are representative of the substantial similarity doctrine as it is practiced in courts today . . .").

303. For a discussion of the overlap, see Bracha & Golden, *supra* note 237, at 275–76. For a discussion on utilitarianism in copyright law, see Jane C. Ginsburg, *A Tale of Two Copyrights: Literary Property in Revolutionary France and America*, 64 TUL. L. REV. 991, 992 (1990). For a discussion on how U.S. copyright law rejects "[p]ersonhood-based or analogous deontic theories . . . as incapable of coexisting with the institution's utilitarian focus," see Balganesch, *supra* note 8, at 21.

304. 17 U.S.C. § 107(2).

305. *Id.* § 107(3).

same questions a court faces in a substantial similarity inquiry.<sup>306</sup> Indeed, for some, the extent of the overlap between substantial similarity and fair use begs the question of whether one or the other is redundant.<sup>307</sup> In focusing on the second and third factors, commentators miss the story that the other two factors tell about substantial similarity.

The first fair use factor requires examination of “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes.”<sup>308</sup> The fourth fair use factor weighs “the effect of the use upon the potential market for or value of the copyrighted work.”<sup>309</sup> Collectively, these factors reference the economic impact that the defendant’s work would likely have on the plaintiff, and they are the most influential on courts.<sup>310</sup> This should not be a part of the substantial similarity test, but may have become part of it already. To the extent that it has, it suggests that fair use is only the negative of substantial similarity and thus noninfringing conduct.

Fair use regards kindly defendants who reuse the plaintiff’s work in a transformative manner. One area is the categories of works courts have tended to view as “fair,” such as parodies, other works that infuse the original work with new meaning, and the use of the plaintiff’s work in news reports, historical research, and comparative advertising.<sup>311</sup> These classes of works do not compete with copyrighted work but promote culture and knowledge.<sup>312</sup> Here, scholars can help courts and litigants develop substantial similarity jurisprudence using fair use concepts.<sup>313</sup> When rivals copy, they may infringe due to improper appropriation. In contrast, nonrivals are more likely to fulfill the constitutional direction and be proper.

Similarly, with regards to infringement, the Second Circuit, in formulating the ordinary observer test, reasoned that since a plaintiff’s

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306. Cohen, *supra* note 106, at 728 (“The degree of similarity between the two works was also one of several factors considered in determining the broader equitable defense of fair use. The fair use doctrine also considered the type of work involved and the way that the defendant had used that work.”).

307. *See id.* at 745 (“A final problem with the traditional approach to copyright infringement is the confusing overlap it creates with the fair use doctrine.”); Balganes, *supra* note 8, at 272 (“[H]aving courts reconsider some of the same issues that they did under their preliminary analysis of the entitlement seems highly redundant and palpably illogical.”).

308. 17 U.S.C. § 107(1).

309. *Id.* § 107(4).

310. Lydia Pallas Loren, *Law, Visual Art, and Money*, 22 LEWIS & CLARK L. REV. 1331, 1349 (2018) (“[T]hose two factors turn out to be the most important . . .”).

311. *See* Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537, 2544–46 (2009).

312. Jeanne C. Fromer & Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 MICH. L. REV. 1251, 1300–01 (2014).

313. *See id.* at 1301 (“Copyright’s hybrid audience, then, is intimately related not only to its infringement analysis but also to the fair-use doctrine.”).



legally protected interest lies in its potential financial returns from its work, the work's audience should make the substantial similarity determination.<sup>314</sup> The problem is that the modern courts rely too much on market effects and too little on the visual or aural similarities between the works at issue.

In *Bell Atlantic Corp. v. Twombly*<sup>315</sup> and *Ashcroft v. Iqbal*,<sup>316</sup> the Supreme Court set out when judges should accept, infer, or presume causality.<sup>317</sup> The touchstone is plausibility.<sup>318</sup> Judges relying on utilitarianism may lean on the lack of market effects to find against plaintiffs rather than have to wrangle with complex tests the circuit courts use to determine technical similarities. As discussed earlier, that skew would be symptomatic of the difficulty of applying any of the substantial similarity tests as they exist today. It would also evidence courts' desperate latching onto market effects as a heuristic that both conveniently comports with copyright's utilitarian policy stance and is simple enough to employ across diverse industries by judges inexperienced in dealing with substantial similarity.

To some degree, every creator uses preexisting material that others created. An emphasis on utilitarianism may lead courts to side with plaintiffs only as far as it is necessary to advance knowledge and learning.<sup>319</sup> While plagiarists might be condemned on ethical grounds, courts employing both fair use and substantial similarity have been much more forgiving to nonrivals who use copyrighted work to produce their work the same way.<sup>320</sup> When rivals copy, they may infringe due to improper appropriation. In contrast, nonrivals are more likely to fulfill

314. See *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946), *abrogated on other grounds* by *Heyman v. Com. & Indus. Ins. Co.*, 524 F.2d 1317 (2d Cir. 1975).

315. 550 U.S. 544 (2007).

316. 556 U.S. 662 (2009).

317. See *Iqbal*, 556 U.S. at 678; *Twombly*, 550 U.S. at 556.

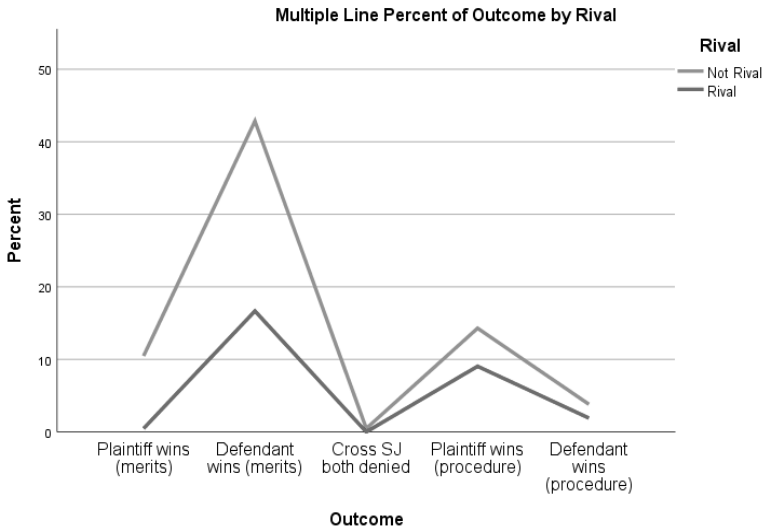
318. See *Iqbal*, 556 U.S. at 679 ("Determining whether a complaint states a plausible claim for relief will . . . be a context-specific task that requires the reviewing court to draw on its judicial experience and common sense.")

319. See Jeanne C. Fromer, *An Information Theory of Copyright Law*, 64 EMORY L.J. 71, 76 (2014) ("[E]xclusive rights in intellectual property can prevent competition in protected works, thereby allowing the rightsholder to charge a premium for access and ultimately limiting these valuable works' diffusion to society at large. For another, given that knowledge is frequently cumulative, society benefits when subsequent creators are not prevented from building on previous artistic creations to generate new works." (footnote omitted)); see also Loren, *supra* note 310, at 1352 ("[A]s a law that is designed to provide an incentive for artists to invest their time and talent in the creation of new works, and as a law that exists in a capitalistic economy, a focus in copyright on monetary effects of the use of another's expression is understandable.")

320. See *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 696 (2d Cir. 1992) (discussing the importance of limits on the extent of protection "so as to avoid the effects of monopolistic stagnation"); Loren, *supra* note 310, at 1348 ("The genesis of fair use is in the recognition by courts of a need to allow for some copying of the expressive content of copyrighted works, lest copyright lead to monopolistic stagnation in expression.")

the constitutional direction, and their use of the copyrighted work is therefore more likely to be “proper.” Figure 8 (below) confirms this: when the plaintiff and the defendant were nonrivals, defendants won on the merits a stunning 42.9% of the time, compared to 16.7% of the time when the parties were rivals.<sup>321</sup>

Figure 8: Relationship Between Outcomes and Whether Parties Were Rivals



In sum, judges usurped plaintiffs’ access to juries and turned substantial similarity from a standard by which to make holistic comparisons of the works at issue into a convoluted rule. Further, courts likely relied on economic substitution rather than technical substitution as the yardstick for judging substantial similarity. These practices have combined to erode plaintiffs’ ability to effectively control uses of their works, with consequences for both copyright law and the civil justice system generally.

Copyright law endows owners with the right to control the terms of access through exclusive rights because they likely have the best information about the value of their works; they are therefore entrusted with the means to corral potential users to negotiate with authors and obtain licenses or assignment of rights.<sup>322</sup> In a healthy legal system, the

321. See Appendix, *supra* note 185.

322. See Nachbar, *supra* note 128, at 610 (“The best information about the value of a particular work is more likely to be held by the work’s author . . . than anyone else . . .”).

specter of litigation is usually sufficient to protect those rights and deter would-be infringers.<sup>323</sup>

The architecture of substantial similarity as conceived by today's courts, however, inherently favors defendants. Shielding defendants could allow large defendants to prevent meaningful competition—as seen with digital news publishing businesses—who are trying to ensure compensation for the distribution of their content by outlets such as Google.<sup>324</sup> Or, a company might embrace a rival's work, such as software code, make minor tweaks, and make significant enough changes to render the original code obsolete. Both harm competition and hurt incentives for content producers. Copyright protection, even if narrow, limits this foul play and provides incentives for original works of authorship to flourish.

### III. THE ARCHITECTURE OF LIABILITY

The integrity of civil litigation depends on giving plaintiffs a reasonable chance to succeed. To prove substantial similarity, plaintiffs should only have to show that the works are holistically similar. Defendants could then show they copied noncopyrightable rather than copyrightable elements and should, therefore, be exonerated. Finally, requiring plaintiffs to identify the expressive aspects of the works in their copyright registrations will help clarify what they seek to protect and provide notice to defendants. These key themes inform broader scholarly debates on rules versus standards, doctrinal biases in civil litigation, and the centrality of jury trials in the American justice system.

#### A. Rules and Standards

*Arnstein* formulated substantial similarity as a standard that courts could more easily apply to the varied facts before them.<sup>325</sup> Professor Thomas Nachbar's work reveals, however, that contrary to this, substantial similarity today has ossified into a set of technocratic rules.<sup>326</sup> Apart from their unwieldiness, outcomes under the extrinsic/intrinsic test and other formal rules (like the more discerning ordinary observer test) are inferior when they cause courts not to assign liability when the harm from the defendants' conduct exceeds its benefit in copying the plaintiffs'

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323. See Gideon Parchomovsky & Alex Stein, *Empowering Individual Plaintiffs*, 102 CORNELL L. REV. 1319, 1320–21 (2017).

324. Sara Fischer & Margaret Harding McGill, *The Future of Owning Content Online*, AXIOS (Dec. 17, 2019), <https://www.axios.com/copyright-laws-digital-distributors-775bc197-79f5-4cb2-bba0-5c36735b43bc.html> [<https://perma.cc/5CCE-PLMP>].

325. See *supra* Section I.B.

326. See Nachbar, *supra* note 128, at 596 (“Other aspects of the copyright system look more like standards, such as the ‘substantial similarity’ test for infringement (which has been clarified to the point of near-rule-dom through decades of precedent) . . . .” (footnote omitted)).

work. These structured tests also require courts to compare thresholds of copyrightability even though balancing would be easier.

To see why rules are an inferior means of determining substantial similarity, consider how modern substantial similarity tests attempt to do two difficult things. First, the tests must be able to metaphysically cleave what is copyrightable in the plaintiff's work from what is not. This assumes courts have in their minds a threshold ( $C^*$ ) beyond which the plaintiff's work ( $C$ ) becomes worthy of protection (i.e.,  $C > C^*$ ).<sup>327</sup> Second, courts attempt to compare what is copyrightable with the defendant's work and, in so doing, determine if the defendant's work ( $H$ ) crosses some impermissible threshold ( $H^*$ ) that causes harm to the plaintiff, making it worthy of disapproval (i.e.,  $H > H^*$ ).

Finally, courts must still engage in some form of balancing. When one consideration favors finding similarity (say appropriating copyrightable content) and another opposes it (say because it involves an unprotectable idea), the court must balance the competing forces while taking into account the weight of the evidence and the importance of each factor, finding for the plaintiff when  $C < H$ . Antitrust law's rule of reason uses a similar approach, as do Title VII and disparate impact determinations in anti-discrimination law, strict scrutiny and proportionality analysis in constitutional law,<sup>328</sup> and personal jurisdiction analysis in civil procedure.

Presented in a stylized fashion, substantial similarity occurs when three conditions are satisfied: (1)  $C > C^*$ ; (2)  $H > H^*$ ; and (3)  $C < H$ . In practice, structured rules are prone to generate capricious and wrong results. These errors are possible even when courts are fully informed of the facts required for balancing. Rules can trip courts up in two ways.<sup>329</sup> First, they may require courts to dismiss the case even though  $C < H$  if  $H < H^*$ , regardless of the magnitude of  $C$ .<sup>330</sup> The only way to eliminate this possibility is to regard all harm as consequential, guaranteeing that  $H^*$  never matters.<sup>331</sup> Second, structured decisions can result in infringement even though  $C > H$  where  $C < C^*$ .<sup>332</sup> The solution is to set  $C^*$  the same as  $H$  by converting it into a balancing test; that is, in fact, what the *Arnstein* court did.

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327. This discussion draws on the framework developed in Professor Kaplow's article. See Louis Kaplow, *Balancing Versus Structured Decision Procedures: Antitrust, Title VII Disparate Impact, and Constitutional Law Strict Scrutiny*, 167 U. PA. L. REV. 1375, 1381–84 (2019).

328. See *id.* at 1376, 1384.

329. See *id.* at 1382.

330. See *id.*

331. *Id.*

332. See *id.*

Setting  $H^*$  and  $C^*$  modestly above zero helps filter out low-merit cases and saves administrative costs.<sup>333</sup> This means that courts can consider if the party bringing the motion has stated a plausible claim at the pretrial motion stage. Requiring plaintiffs to show a holistic similarity between the works accomplishes that. The defendant's rebuttal then helps the court to fine-tune the values of  $C$  and  $H$ , while requiring plaintiffs to provide claim-like details in their copyright registrations helps courts define the values of  $H^*$  and  $C^*$ . Design law's ordinary observer test also contains all these elements.

Design patents protect an ornamental design for an article of manufacture, and its infringement test parallels substantial similarity.<sup>334</sup> Both tests ask if an adjudicator taking into account protectable elements (and filtering out unprotectable elements) would find the works or appearances at issue substantially alike.<sup>335</sup> Both tests are also concerned about the technical aspect: "[T]he appeal of the subject matter to the audience's aesthetic perception is what defines the nature of the subject matter and, presumably, motivates its creation."<sup>336</sup> And, unlike in trademark law, neither is concerned about the consumer's understanding as to the source of the goods.<sup>337</sup>

333. See Louis Kaplow, *On the Design of Legal Rules: Balancing Versus Structured Decision Procedures*, 132 HARV. L. REV. 992, 1044–46 (2019).

334. See Rebecca Tushnet, *The Eye Alone Is the Judge: Images and Design Patents*, 19 J. INTELL. PROP. L. 409, 409 (2012). Design patent looks at whether the designs are substantially the same. See, e.g., *id.* at 410–12 ("The same problem comes up in copyright, where similarities in unprotectable ideas or standard tropes should not suffice for liability, yet the gestalt substantial similarity test risks holding defendants liable because of such commonalities."); Sylvia Ngo, Note, *Egyptian Goddess v. Swisa: Patently Obvious? Reconciling the Ordinary Observer and Point of Novelty Tests*, 10 Hous. BUS. & TAX L.J. 110, 128 (2010) ("Courts may later want to restore [ordinary observer] uniformity between designs and copyrights.").

335. *Compare Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871) ("We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other."); and *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc) (holding that the test for design patent infringement is whether the ordinary observer would find the two designs to be substantially the same, in light of the prior art), *with Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 179 (1st Cir. 2013) ("We have explained that two works are substantially similar [for purposes of a copyright infringement analysis] if [the] 'ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.'" (quoting *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 607 (1st Cir. 1988))).

336. Laura A. Heymann, *Overlapping Intellectual Property Doctrines: Election of Rights Versus Selection of Remedies*, 17 STAN. TECH. L. REV. 239, 248 (2013).

337. *Id.* at 247–48 ("That is, one commits copyright or design patent infringement simply by copying the protected subject matter, regardless of whether that subject matter is recognizable to consumers as the work of the rights holder or whether it is presented as the work of the copier.").

### B. *Three Lessons from Egyptian Goddess*

To determine if accused designs are “substantially the same” to patented designs, courts employ an “ordinary observer” standard.<sup>338</sup> The Supreme Court established this standard in *Gorham Co. v. White*.<sup>339</sup> There, the Court held that if a person is deceived by one design into thinking it is another after “giving such attention as a purchaser usually gives,” the defendant infringes the patented design.<sup>340</sup> In making that determination, fact finders holistically compare the allegedly infringing product along with the figures of the design patent before them.<sup>341</sup>

Over the years, courts, while paying lip service to *Gorham*, have burdened plaintiffs with an additional “points of novelty” requirement.<sup>342</sup> Courts examined the patented design’s innovative aspects individually, and plaintiffs had to show their patented designs departed sufficiently from the prior art.<sup>343</sup> Much like modern substantial similarity tests, the “point of novelty” requirement confined plaintiffs to only the dissected elements that were new. Again, courts ostensibly did this to protect defendants from infringement when the accused device did not contain novel design features that justified awarding patentees their design patents in the first place.<sup>344</sup> Whatever the reason, the points of novelty test, like substantial similarity, overemphasized subtle differences that did not affect the protected overall design, allowing defendants to avoid infringement by omitting one or more “points of novelty.”<sup>345</sup>

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The holistic comparison is limited to the claimed design. *See id.* If the design patent claim is only on the handle of the frying pan, the comparison is to the overall appearance of the handle of the accused product, not the overall appearance of the entire accused product.

338. *Gorham Co.*, 81 U.S. (14 Wall.) at 528.

339. 81 U.S. (14 Wall.) 511 (1871); *see id.* at 528 (describing how a patent is infringed “if, in the eye of an ordinary observer . . . two designs are substantially the same,” which thereby would “deceive such an observer,” and “induc[e] him to purchase one supposing it to be the other”).

340. *Id.* (noting how an ordinary observer would be “giving such attention as a purchaser usually gives” to the overall visual impression of the design as a whole).

341. Bruce A. Kugler & Craig W. Mueller, *A Fresh Perspective on Design Patents*, COLO. LAW., July 2009, at 71, 71.

342. *See, e.g.*, *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1372 (Fed. Cir. 2006) (describing how the plaintiff has not met the points of novelty test).

343. *See Goodyear Tire & Rubber Co. v. Hercules Tire & Rubber Co.*, 162 F.3d 1113, 1118 (Fed. Cir. 1998), *abrogated by Egyptian Goddess, Inc. v. Swisa Inc.*, 543 F.3d 665 (Fed. Cir. 2008) (en banc).

344. *See Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1444 (Fed. Cir. 1984) (inserting a novelty requirement into previous infringement tests), *abrogated in part on other grounds by Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

345. *Egyptian Goddess*, 543 F.3d at 677.

To address this, the Federal Circuit issued a unanimous en banc decision in *Egyptian Goddess, Inc. v. Swisa, Inc.*<sup>346</sup> The court reaffirmed *Gorham*'s standard for infringement—the test was whether an ordinary observer familiar with the prior art would think the accused infringing design and the patented design were substantially similar when compared holistically.<sup>347</sup> In doing so, the court recognized that plaintiffs' protection under design law was whittled to a husk when defendants could copy the overall appearance of an original work save for a few lines noticeable only by experts.<sup>348</sup> Moreover, the court did not want “the point of novelty” to trip up fact finders, notably when the protected design combined existing features.<sup>349</sup>

Novelty still mattered but was to be assessed separately.<sup>350</sup> Placing this burden on defendants made sense because they had the “motivation to point out close prior art, and in particular to call to the court's attention the prior art that an ordinary observer [was] most likely to regard as highlighting the differences between the claimed and accused design.”<sup>351</sup>

Scholars widely agree *Egyptian Goddess* revitalized the “ordinary observer” test and significantly boosted plaintiff success rates because patentees no longer had to prove that the allegedly infringing device includes all of the points of novelty found in the patented design.<sup>352</sup>

346. 543 F.3d 665 (Fed. Cir. 2008) (en banc); *id.* at 677 (holding that the “proper inquiry” is “whether the accused design has appropriated the claimed design as a whole”); *see also id.* at 683 (“[A] purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs . . .”).

347. *See id.*

348. *See id.* at 670, 677 (“[The] sameness of appearance, and mere difference of lines in the drawing or sketch . . . or slight variances in configuration . . . will not destroy the substantial identity.” (second and third alterations in original) (quoting *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 526–27 (1871))).

349. *See id.* at 677; *see also* Sarah Burnick, Note, *The Importance of the Design Patent to Modern Day Technology: The Supreme Court's Decision to Narrow the Damages Clause in Samsung v. Apple*, 18 N.C. J.L. & TECH. 283, 297–98 (2017) (describing how the reformed “ordinary observer” test under *Egyptian Goddess* makes it far easier to demonstrate infringement in court because the jury is able to look at the whole picture of the design, allowing the design patent to serve as a strong tool against infringement).

350. *See Egyptian Goddess*, 543 F.3d at 678–79.

351. *See id.*

352. Jason J. Du Mont, *A Non-Obvious Design: Reexamining the Origins of the Design Patent Standard*, 45 GONZ. L. REV. 531, 532 (2009/10) (“Many commentators heralded this decision as ushering in a new era for design protection in the United States. . . . [I]ts holding should make it easier to enforce design patents . . .” (footnote omitted)); *see* Perry J. Saidman, *Egyptian Goddess Exposed! But Not in the Buff(er)*..., 90 J. PAT. & TRADEMARK OFF. SOC'Y 859, 884–85 (2008) (stating that eliminating the points of novelty test in *Egyptian Goddess* is a “significant boost to design patentees”); LOIS F. HERZECA & HOWARD S. HOGAN, *FASHION LAW AND BUSINESS* 180 (2013) (noting that designers have a “*de facto* increase in scope of protection” (quoting Christopher V. Carani, *Design Law & Footwear: Landmark Case Fundamentally Alters Design Patent Enforcement*, SHOE RETAILING TODAY, July–Aug. 2009, at 26)).

*Egyptian Goddess* also increased the value of design patents.<sup>353</sup> It is worth underscoring the causal link between shifting the burden of production to defendants and the increase in the value of the intellectual property right,<sup>354</sup> as well as the inquiry being a factual and not a legal one.<sup>355</sup> In these aspects, the success of *Egyptian Goddess* provides an essential roadmap for reforming substantial similarity.

### 1. Compare the Works as Wholes

In design law, holistic comparisons maintain the “focus on those aspects of a design which render the design different from prior art designs,” while at the same time avoiding “the risk of assigning exaggerated importance to small differences between the claimed and accused designs relating to an insignificant feature simply because that feature can be characterized as a point of novelty.”<sup>356</sup> Like *Egyptian Goddess*, *Arnstein* gave courts a tool that allowed them to simply look at two works as a first step and determine if they were similar without engaging in complicated mental dissections of copyrightable content.<sup>357</sup> As Christopher Carani and Dunstan Barnes noted:

[E]xclusivity rights conferred by a design patent are for the overall appearance of the design as set forth in the design patent. For example, for a design patent directed to a hinge, it does not protect how the hinge swivels. Rather, the design patent only protects the appearance of the hinge. Faithful

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353. Susan Scafidi, *Towards A Jurisprudence of Fashion*, 29 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 429, 430 (2019) (“In *Egyptian Goddess v. Swisa*, the Federal Circuit’s abandonment of a five-point novelty test for design patent infringement made design patents a far more attractive means of protection for all sorts of fashion-related products, not just the nail buffers at issue in that case.”); Kugler & Mueller, *supra* note 341, at 73; *see also* Susanna Monseau, *European Design Rights: A Model for the Protection of All Designers from Piracy*, 48 AM. BUS. L.J. 27, 43 (2011) (“[T]he simplified test might encourage more use of design patents by fashion and other designers . . .”).

354. *See* Kugler & Mueller, *supra* note 341, at 71 (describing “how the burden of proof has shifted to now favor the patent holder”); *id.* at 73 (describing how the holding in *Egyptian Goddess* “broadened the protection afforded by issued design patents and the potential protection afforded by pending design patent applications”).

355. *See* David Leason, *Design Patent Protection for Animated Computer-Generated Icons*, 91 J. PAT. & TRADEMARK OFF. SOC’Y 580, 592 (2009) (“[T]here will be an increased chance of a trier of fact finding infringement under the guidelines set forth by the Federal Circuit in *Egyptian Goddess*.”).

356. *Egyptian Goddess*, 543 F.3d at 677 (quoting *Sun Hill Indus., Inc. v. Easter Unlimited, Inc.*, 48 F.3d 1193, 1197 (Fed. Cir. 1995)).

357. *See* Du Mont, *supra* note 352, at 532 (“[T]he Federal Circuit . . . advised district courts [that] they need not provide detailed verbal descriptions for design patents during claim construction.”); Ngo, *supra* note 334, at 130 (“There are fewer technical points for a fact-finder to review . . .”); *see also id.* at 131 (reporting “the view of many that this test is a lowered standard of finding infringement”).



adherence to the basic principle that design patents only protect the appearance of a product, and not its underlying function, should address most, if not all, concerns about design patents being misused as backdoor utility patents.<sup>358</sup>

The problem is that modern copyright courts too quickly conclude that accused works do not infringe copyrighted works because of their similarity to what is in the public domain.<sup>359</sup> An overemphasis on different features that are uncopyrightable departs from how real-world consumers perceive the work. This results in works being found noninfringing due to differences that would have been irrelevant to a real-world observer.<sup>360</sup> Professor Helfing observed:

As to similarity in total concept and feel, the courts initially disfavored summary disposition because that quality is measured by the subjective response of an ordinary person. The Ninth Circuit has been mostly faithful to this judicial restraint. The Second Circuit, however, has loosened the reins and expressly authorized the summary resolution of claims on the basis of a judge's emotional response to works of authorship.<sup>361</sup>

Copyright law itself supports the principle of judging works holistically. While the Copyright Act gives little guidance on infringement, it does guide the nature of a work. The definition of "created" in the Copyright Act makes clear that works are unitary wholes.<sup>362</sup> With multiple versions, each is a separate work.<sup>363</sup> The scope of copyright and exclusive rights in turn map to these definitions. Copyright subsists in complete works, and this holistic focus on the "work" extends to infringement analysis. Seen in this light, the ordinary observer should evaluate the works' overall effect and compare them in a single process without dissecting them into individual elements.

Furthermore, holistic comparisons go beyond exact reproduction to encompass "various modes in which the matter of any work may be

358. Christopher V. Carani & Dunstan H. Barnes, *United States*, in *DESIGN RIGHTS* 9, 38 (Christopher V. Carani ed., 2017).

359. *See* Tushnet, *supra* note 334, at 420 ("They all look alike to me" is a cliché for a reason."); *see also* Helfing, *supra* note 10, at 764 ("Courts in the Second and Ninth Circuits have not hesitated to summarily reject infringement claims based upon a judicial determination that the similarity between works fails to meet the 'objective criteria' of protection.")

360. *See supra* Sections I.B, II.B.

361. Helfing, *supra* note 10, at 764 (footnotes omitted).

362. *See* 17 U.S.C. § 101 (noting that works are created when fixed, and when works are fixed in pieces over time, the then-existing fixation constitutes the work).

363. *Id.* "Joint work[s]" are created when the works of two or more authors are intertwined into a single, inseparable whole. *Id.* "Copies" are the tangible mediums in which an (entire) work is fixed. *Id.*

adopted, imitated, transferred, or reproduced, with more or less colorable alterations to disguise the piracy.”<sup>364</sup> Every substantial similarity case involves nonidentical work.<sup>365</sup> A defendant’s copied work is like purple paint—a mix of the plaintiff’s red paint and blue paint from the public domain. Plaintiffs try to convince courts that the shade of red in the purple paint matches the shade of red in the cans at their stores.<sup>366</sup> If the accused work, seen as a whole, gives rise to a similar reaction as the protected work, and if, as a result, the fact finder cannot differentiate between the two, then there is a colorable case of infringement. Of course, there is a difference between holistic comparison of an ordinary observer and holistic comparison in light of understanding what differentiates the claimed design (or copyrighted expression) from the prior art (and other unprotected elements, like ideas and *scènes à faire*). Conversely, if the works are sufficiently distinct to the ordinary informed observer, the plaintiff has not met its burden of proving substantial similarity between the two works.<sup>367</sup> This sets a presumptive scope of the copyrighted work, which defendants can then rebut.<sup>368</sup>

Once the fact finder has determined both copying and facial similarity, a presumption provides a useful means of adding clarity and predictability to the analysis.<sup>369</sup> The burden-shifting approach is well established as a means of correcting the imbalance between plaintiffs and defendants.<sup>370</sup> For instance, the Federal Rules of Evidence shift the burden of producing evidence contradicting the presumed fact of copying to the defendant, while retaining the burden of persuasion with the plaintiff.<sup>371</sup> Similarly, trademark plaintiffs must show that defendants’ use of their trademarks leads consumers to think defendants’ goods belong to plaintiffs, that plaintiffs endorse defendants’ goods, or that

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364. See *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 360 (9th Cir. 1947).

365. See *supra* Part I.

366. See Helfing, *supra* note 10, at 743–44.

367. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 678 (Fed. Cir. 2008) (en banc) (“In some instances, the claimed design and the accused design will be sufficiently distinct that it will be clear without more that the patentee has not met its burden of proving the two designs would appear ‘substantially the same’ to the ordinary observer, as required by *Gorham*.”).

368. See Sarah Burstein, *Intelligent Design & Egyptian Goddess: A Response to Professors Buccafusco, Lemley & Masur*, 68 DUKE L.J. ONLINE 94, 98 (2019) (describing presumptive scope in the context of design patents).

369. See David S. Welkowitz, *The Virtues and Vices of Clarity in Trademark Law*, 81 TENN. L. REV. 145, 167 (2013) (advocating for presumptions as a means of improving “predictability and ease of determination”).

370. See, e.g., Parchomovsky & Stein, *supra* note 323, at 1357 (advocating for shifting the burden of proof in all cases “involving hidden interest and fees, so that the bank will lose the case when it fails to prove by a preponderance of the evidence that the disputed charges are reasonable and fair”).

371. FED. R. EVID. 301.

plaintiffs and defendants are legally related entities.<sup>372</sup> Once plaintiffs establish a facial likelihood of confusion, the law usually presumes harm.<sup>373</sup> Likewise, antitrust law applies a quick look approach when even an observer with a rudimentary understanding of economics would conclude that the defendant's arrangement would be anticompetitive.<sup>374</sup> Notably, the fact that the Supreme Court did not confine the analysis to a *judge* with a rudimentary understanding of economics but rather an *observer* with a rudimentary understanding of the field is instructive.<sup>375</sup> After defendants make their cases on uncopyrightability, fact finders can determine if they have carried the burden of production.

## 2. Restore the Ordinary Observer

*Egyptian Goddess* was careful to point out that the differences between the claimed design and prior art designs could be “an important component” of the analysis, but it was satisfied with applying the “ordinary observer test through the eyes of an observer familiar with the prior art.”<sup>376</sup> The ordinary observer knows the market for the claimed and accused designs.<sup>377</sup> Indeed, the ordinary observer may know what an expert does in a sophisticated market if that is the typical consumer, but the default viewpoint is never that of an “expert.”<sup>378</sup> This allows a meaningful comparison of the accused devices with the patented claim that could be made while keeping the inquiry predictable.<sup>379</sup>

It is easy to make much ado about whether the ordinary observer is really “ordinary,” especially if the consumer is capable of juxtaposing prior art with both patentee's and defendant's designs.<sup>380</sup> However, there

372. David J. Franklyn & David A. Hyman, *Trademarks as Search Engine Keywords: Much Ado About Something?*, 26 HARV. J.L. & TECH. 481, 497–98 (2013).

373. *Id.* at 498.

374. Cal. Dental Ass'n v. FTC, 526 U.S. 756, 770 (1999).

375. Garry A. Gabison, *Juries Can Quick Look Too*, 10 SETON HALL CIR. REV. 271, 298 (2014) (“[I]t would be improper to assume the Court intended to restrict quick look to judges or the FTC because if the Court wanted such restriction, it could have simply written so.”).

376. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 677–78 (Fed. Cir. 2008) (en banc); see Daniel J. Sherwinter, *Top Intellectual Property Cases of 2008—Part I*, COLO. LAW., Mar. 2009, at 49, 55.

377. See *Columbia Sportswear N. Am., Inc. v. Seirus Innovative Accessories, Inc.*, 942 F.3d 1119, 1129 (Fed. Cir. 2019).

378. *Gorham Co. v. White*, 81 U.S. (14 Wall.) 511, 528 (1871); see also *Cardiac Pacemakers, Inc. v. Coratomic, Inc.*, 535 F. Supp. 280, 286 (D. Minn. 1982) (noting that knowledge of prior art is elevated because pacemakers are expensive and the consumer is usually a specialized physician), *aff'd*, 702 F.2d 671 (8th Cir. 1983) (per curiam).

379. See *Egyptian Goddess*, 543 F.3d at 674, 677.

380. See *Ngo*, *supra* note 334, at 125 (“The issue now is whether *EGP*'s observer is, in fact, ordinary.”); see also Christopher V. Carani, *The New “Extra-Ordinary” Observer Test for Design Patent Infringement—On a Crash Course with the Supreme Court's Precedent in Gorham v.*

is nothing novel about judging similarity through the lens of an informed ordinary observer when appropriate. As early as 1933, design law recognized that ordinary observers could be knowledgeable about the field in question.<sup>381</sup> At the same time, fact finders need not put their everyday sensibilities and perceptions aside to judge if someone else would find that the defendant had infringed the copyrighted work.

*Arnstein*, too, had faith that fact finders could visually or aurally compare most, if not all, the diverse range of copyrighted works from architecture to music.<sup>382</sup> If case features like technology require expert testimony to educate the jury, *Arnstein* allows it.<sup>383</sup> Patent law relies on a skilled person in the art, and trademark law relies on the perception of consumers.<sup>384</sup> Copyright law's substantial similarity test uses a hybrid standard, drawing both on expert and nonexpert observers; post-*Arnstein*, however, the expert/judicial assessment has subsumed the lay assessment, which is a question of fact.<sup>385</sup>

Jurors routinely get the task of filtering the copyrightable from the uncopyrightable. In *Bateman v. Mnemonics, Inc.*,<sup>386</sup> the court ruled that the jury should have been instructed to filter out any use of the command interface necessary for compatibility, even if the interface was copyrightable.<sup>387</sup> When courts use experts, "the experts cannot tell a jury whether two products are similar; however, the experts may educate a jury on some subtests and the function of each element of the product."<sup>388</sup>

White, 8 J. MARSHALL REV. INTELL. PROP. L. 354, 357, 370 (2009) (warning that the observer in *Egyptian Goddess* may be in conflict with the ordinary observer in *Gorham Co. v. White*).

381. See *Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1322 (Fed. Cir. 2007) ("The ordinary observer is not any observer, but one who, with less than the trained facilities of the expert, is 'a purchaser of things of similar design,' or 'one interested in the subject' . . . one who, though not an expert, has reasonable familiarity with such objects . . . ." (first omission in original) (quoting *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 430 (6th Cir. 1933))), *abrogated by Egyptian Goddess*, 543 F.3d 665 (Fed. Cir. 2008) (en banc).

382. See discussion *supra* Section I.B.

383. See *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) (allowing expert testimony under the substantial similarity test), *abrogated on other grounds by Heyman v. Com. & Indus. Ins. Co.*, 524 F.2d 1317 (2d Cir. 1975).

384. *Fromer & Lemley*, *supra* note 312, at 1273; see also *id.* at 1299 ("Unlike trademark and patent law, copyright does assess infringement using a hybrid of technical similarity and market substitution from the vantage point of both the consumer and the expert.").

385. See *id.*

386. 79 F.3d 1532 (11th Cir. 1996).

387. *Id.* at 1547 ("It is an incorrect statement of the law that interface specifications are not copyrightable as a matter of law. [Defendant] is correct, however, in arguing that the district court erred in not instructing the jury on the legal consequences of copying dictated by compatibility requirements." (footnote omitted)).

388. *Gabison*, *supra* note 375, at 302.

The fact finder then makes the final decision on the question of infringement.<sup>389</sup>

Keeping the inquiry grounded in real-world perceptions of the intended audience will make the infringement decisions more consistent because the fact finders need not elevate the ordinary observer at a whim, based on the consumer's knowledge, while automatically tailoring the ordinary observer to the specific work of authorship at issue. According to Professor Helfing, judges pose a greater risk in reaching biased outcomes compared to juries since "[a] judge is more likely to make the decision based upon a comparison of an emotional response to relevant—that is, *protected*—content; a jury, however, provides better representation of that fictitious ordinary person whose emotions are meant to be the measure of that response."<sup>390</sup>

Reasonable minds may disagree on normative questions that concern the permissibility of similar use. However, it is the public, as represented by the jury, instead of the judge, for whom copyright and its fruits exist. A heterogeneous jury offers a more diversified perspective that informs the meaning and implications of judging similarity. It is time to return to the original conception of substantial similarity as a fact-intensive inquiry most appropriate for the jury.

### 3. Include a Claim-Like Requirement in Copyright Registrations

Copyright plaintiffs have exclusive rights in their works. Unlike other types of intellectual property rights, however, those rights are only defined at the point of infringement. Requiring copyright owners to provide a simple description of what they claim to be copyrightable in the work (and therefore protected by copyright law) will help stakeholders have a better idea of its scope before infringement. During litigation, that description will help focus the fact finder's attention on the copyrightable aspects of the plaintiff's work in making the infringement determination.

While copyright ownership exists without registration, copyright law requires plaintiffs to register their work as a precondition to a civil action for copyright infringement.<sup>391</sup> To register, the copyright owner delivers

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389. See, e.g., *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946), *abrogated on other grounds by Heyman v. Com. & Indus. Ins. Co.*, 524 F.2d 1317 (2d Cir. 1975).

390. Helfing, *supra* note 10, at 765.

391. 17 U.S.C. § 411(a); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) (noting that infringement depends only on plaintiffs' establishing ownership of a valid copyright and on defendants' copying original elements in those works); see also *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 684 (2014) ("Although registration is 'permissive,' both the certificate and the original work must be on file with the Copyright Office before a copyright owner can sue for infringement." (quoting 17 U.S.C. § 408)); *Olan Mills, Inc. v. Linn Photo Co.*, 23 F.3d 1345, 1349 (8th Cir. 1994) ("While registration is required under section 411 of the Copyright Act in order to bring a suit for infringement, infringement itself is not conditioned upon

to the U.S. Copyright Office an application, a fee, and a deposit of one or more copies of the work.<sup>392</sup> Since the bar to copyrightability is extremely low, this stage is largely pro forma.<sup>393</sup> A registration specialist then examines the materials to determine whether the work constitutes copyrightable subject matter and if the applicant has met the other legal and formal requirements.<sup>394</sup> Prior to 2019, circuits disagreed over whether copyright is registered when the U.S. Copyright Office receives the copyright holder's application or when the Office acts on the application.<sup>395</sup> In any case, neither plaintiffs nor defendants know the scope of the copyright for the work before a court's determination.

To patent and trademark scholars, that indeterminacy is astounding. Patent and trademark registrations provide notice to third parties of both the existing right and its potential scope.<sup>396</sup> For example, patents generally contain three parts: the specification, the drawings, and the claims.<sup>397</sup> The specification and the drawings provide a complete description of the new invention, including how to make and use it.<sup>398</sup> A patent must also contain one or more claims that precisely define the invention.<sup>399</sup>

Once the U.S. Patent and Trademark Office issues the patent, the information contained in the patent gives the public notice of what constitutes the "patented invention."<sup>400</sup> The patent claims define the legal

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registration of the copyright. Thus, a copyright holder can register a copyright and file suit after infringement occurs." (citation omitted)).

392. 17 U.S.C. § 408(a); *see also id.* § 408(b) (listing what shall be included in the material deposited for registration).

393. *See Feist*, 499 U.S. at 345 ("The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be." (quoting NIMMER & NIMMER, *supra* note 41, § 1.08[C][1])). Since most works are not registered unless or until litigation, this leads to a lack of knowledge of what is out there. *Cf.* 2 NIMMER & NIMMER, *supra* note 4, § 7.16[B][3] (stating that only sometimes do copyright owners register their works long before infringement and discussing many cases in which copyright owners did not register their works before wanting to sue).

394. U.S. COPYRIGHT OFF., COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 602.4(B) (3d ed. 2017), <https://www.copyright.gov/comp3/docs/compendium.pdf> [<https://perma.cc/T2UA-6J6E>].

395. *See* Thomas M. Landrigan, Note, *Application or Registration?: Confusion Regarding the Copyright Act's Prerequisite to Copyright Infringement Lawsuits*, 44 IND. L. REV. 581, 585 (2011). In 2019, the U.S. Supreme Court resolved the circuit split. *See* Fourth Estate Pub. Benefit Corp. v. Wall-Street.com, LLC, 139 S. Ct. 881, 886 (2019) (holding that registration occurs when the Copyright Office acts on the application and officially registers the copyright).

396. In the case of trademarks, the notice provides a representation of the mark, as well as the goods and services the mark covers. In the case of patents, the notice informs the claimed scope of the invention.

397. *See* 35 U.S.C. § 111(a)(2).

398. *Id.* § 112(a).

399. *Id.* § 112(b).

400. *Id.* § 271(a).

boundaries of the invention and the owner's corresponding right to exclude.<sup>401</sup> *Egyptian Goddess* instructed that designs “‘typically are claimed as shown in drawings,’ and that claim construction ‘is adapted accordingly.’”<sup>402</sup> While claim construction has its share of problems, it helps resolve the structural uncertainties in copyright scope related to substantial similarity.<sup>403</sup>

Judging substantial similarity can be daunting, precisely because the fact finder must distinguish copyrightable expression from unprotected factual description without the linguistic aids like those found in patent claims.<sup>404</sup> A brief description setting out the expressive elements in the work would go a long way in helping to clarify the claimed copyright scope of the work ahead of litigation. Requiring a claim-like requirement, together with restoring the ordinary observer and comparing works holistically, will help courts apply both technical and market-based approaches to substantial similarity.

The obstacle to successful implementation may be one of cost-effective design. The copyright system deals with a staggering number of works—over 38 million in fiscal year 2018 alone.<sup>405</sup> Each patent application costs about \$15,000–\$20,000 to draft and prosecute.<sup>406</sup> Further, unless the U.S. Copyright Office examines the claims’ substantive validity, including protectable elements, it is easy to dismiss the claims as less valuable than those examined under the patent system.

However, these objections rest on two fundamental errors. First, copyright claims need not be crafted by experts, particularly if substantial similarity is ultimately a question for the ordinary observer and not the person having ordinary skill in the art (as is the case in patent law). Indeed, much ink has been spilled in this Article in arguing precisely that the law has become too technocratic in its reliance on pretrial motions and expert evidence. Jurors, looking through the lens of the ordinary observer, seek to determine if the works are holistically similar and

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401. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (“It is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude.’” (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004))).

402. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 679 (Fed. Cir. 2008) (en banc) (quoting *Arminak & Assocs., Inc. v. Saint-Gobain Calmar, Inc.*, 501 F.3d 1314, 1319 (Fed. Cir. 2007)).

403. See Lemley & McKenna, *supra* note 42, at 2203 (advocating that nonpatent regimes look into modified forms of *Markman* proceedings).

404. See *supra* notes 10–11 and accompanying text.

405. U.S. COPYRIGHT OFF., ANNUAL REPORT FOR FISCAL 2018, at 6 (2018), <https://www.copyright.gov/reports/annual/2018/ar2018.pdf> [<https://perma.cc/8MBF-8Z69>].

406. Tysver Beck Evans, *Patent Application Cost*, BITLAW GUIDANCE, <https://www.bitlaw.com/guidance/patent/what-does-a-patent-application-cost.html> [<https://perma.cc/GGL8-JF2G>].

account for whatever defendants claim to be unprotectable in their analysis. Like the ordinary observer test itself, the copyright registration provides a lay reference point, not an expert reference point as to what is protectible. Second, the perfect is the enemy of the good. At the current baseline, courts do not consider copyright registrations in assessing substantial similarity. The goal is not the technical precision of patent claims but simply requiring copyright registrants to state what it is they think is copyrightable. Systemic costs and lawyering fees are obstacles if one seeks to replicate the patent system, but that is not the goal here. Even simple linguistic aids would be an improvement over the status quo.

Technology is making registration simpler for authors. Starting in August 2020, “social media influencers and other authors of online content can take advantage of a new group copyright registration option for short online works such as blog entries, social media posts and web articles.”<sup>407</sup> “Authors could even register their own comments to a social [media] post as separate copyrightable works in certain situations.”<sup>408</sup> Developments like these are promising, and they illustrate why one should never assume things cannot be done differently simply because they have never been done before.

### C. Broader Implications

Beyond copyright, insights on reforming substantial similarity contribute directly to broader scholarly debates on rules versus standards, doctrinal biases in civil litigation, and the centrality of jury trials in the American justice system.

#### 1. Rules and Standards

Scholars have long debated whether rules or standards best translate policy into law.<sup>409</sup> People frequently interact with some areas of the law, such as healthcare, safety regulations, and the vesting of intellectual property rights. For this reason, the requirement that original works be fixed in a tangible medium of expression to enjoy protection is a rule.<sup>410</sup> It determines whether copyright exists—a determination that occurs

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407. Jason Mueller & Robert Hough II, *United States: Easier Copyright Registration Coming for Blogs and Social Media Posts*, MONDAQ (Aug. 11, 2020), [https://www.mondaq.com/unitedstates/copyright/975216/easier-copyright-registration-coming-for-blogs-and-social-media-posts?email\\_access=on](https://www.mondaq.com/unitedstates/copyright/975216/easier-copyright-registration-coming-for-blogs-and-social-media-posts?email_access=on) [<https://perma.cc/K8TC-LLLC>].

408. *Id.*

409. See, e.g., Colin S. Diver, *The Optimal Precision of Administrative Rules*, 93 YALE L.J. 65, 65 (1983).

410. See 17 U.S.C. § 102(a) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”).



much more frequently than whether a defendant has infringed on that copyright. People interact less often with other laws, such as those relating to negligence and substantial similarity. When they do, factual permutations can materially differ, or they cannot foresee all potential abuses of the law and how best to address them.<sup>411</sup> Since designing a rule for every contingency is counterproductive, the law prefers to use standards to balance different factors because they are easier to craft and tend to better track policy goals.<sup>412</sup>

To properly apply substantial similarity, one must identify the threshold of substantiality and the kinds of copying public policy favors. Substantial similarity jurisprudence currently does not have much theoretical depth. Courts need to provide that content through better theorized precedent. Standards, therefore, shift that cost *ex post* to attorneys and courts who apply them on a case-by-case basis.<sup>413</sup>

Judges may have little incentive to spend the time and effort to master the literature sufficiently to contribute to that depth, and the court's precedent may not be sufficiently similar to future fact patterns to predict how the law would apply. This may also have something to do with the fact that, as this Article shows, judges today approach substantial similarity as a matter of first impression.<sup>414</sup> Like muddy footprints, substantial similarity shows the imprint of judges forced to apply complex rules rather than the everyday wisdom of the ordinary observer.<sup>415</sup>

As seen in Section III.B, infringement determinations are made after the fact and only during litigation. Some parties may therefore not bother to consult the law before acting. The ones who do must seek expert advice in ordering their affairs since even judges and scholars cannot correctly understand the standard's technocratic contours. This feeds back into a loop between the courts and those they serve—one that obfuscates the law more and more over time.

Fact-specific standards can be disadvantageous, but they do fare better than strict rules in changing circumstances.<sup>416</sup> A decades-old standard can be applied to conduct using present understandings. In contrast, rules

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411. Legal scholar Roscoe Pound stated that “no two cases of negligence have been alike or ever will be alike.” ROSCOE POUND, AN INTRODUCTION TO THE PHILOSOPHY OF LAW 142 (1922).

412. See Nachbar, *supra* note 128, at 599 (“Generally, reallocations involving consumptive uses tend to look more like rules and those regarding productive uses tend to look more like standards, which makes sense if the effect of productive uses on the underlying work is more highly variable than the effect of consumptive uses.”).

413. See, e.g., Louis Kaplow, *Rules Versus Standards: An Economic Analysis*, 42 DUKE L.J. 557, 563 (1992).

414. See *supra* Section II.B.2.

415. See, e.g., RICHARD A. POSNER, THE PROBLEMS OF JURISPRUDENCE 47–48 (1990).

416. See, e.g., RICHARD A. POSNER, ECONOMIC ANALYSIS OF LAW § 20.3, at 556 (6th ed. 2003).

must be tweaked continuously, which requires more effort. When laws cover disparate works of authorship, most relevant scenarios are likely to be more idiosyncratic. Section III.A makes a case for returning to standards-based adjudication of substantial similarity, and Section III.B sets out how to do so with reference to *Egyptian Goddess*. At the same time, clarity depends on more than formal enactments, precedents, and the results of past cases.

Perfect clarity would be unrealistic. Instead, courts should keep an eye on the marginal cost and benefit of the level of clarity sufficient for their precedential decisions to identify factors that influence the determination.<sup>417</sup> Compared to the overly technocratic rules-based formulations of substantial similarity, parties who know peers would judge their actions can more easily adjust their actions to societal norms based on what they think a lay jury would find appropriate. Individuals' common knowledge will allow confident prediction in some contexts, even when precise official pronouncements are either not consulted or do not exist.

## 2. Judges and Juries

The widespread practice of treating substantial similarity as a de facto question of law for a judge to decide should be a matter of constitutional concern.<sup>418</sup> Substantial similarity remains an issue of fact, despite most judges deeming it appropriate to decide on behalf of the jury when “no reasonable jury” would disagree with them.<sup>419</sup> When courts do not follow the rules of summary judgment, such as when courts declare that no issues exist for a jury to determine when such issues do exist, judges, in fact, rob plaintiffs of the right to trial by jury.<sup>420</sup>

That right to a trial by jury stretches back to 1791, when the new United States of America ratified the Bill of Rights, the first ten amendments to the U.S. Constitution, confirming the fundamental rights

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417. Kaplow, *supra* note 413, at 582 (“[T]he value of a more accurate *ex post* adjudication lies in its *ex ante* effect on behavior.”).

418. See *Associated Press v. NLRB*, 301 U.S. 103, 135–36 (1937) (Sutherland, J., dissenting) (“[I]llegitimate and unconstitutional practices get their first footing . . . by silent approaches and slight deviations from legal modes of procedure.’ . . . A little water, trickling here and there through a dam, is a small matter in itself, but it may be a sinister menace to the security of the dam, which those living in the valley below will do well to heed.” (quoting *Boyd v. United States*, 116 U.S. 616, 635 (1886))).

419. See *supra* Section II.B.

420. See Arthur R. Miller, *The Pretrial Rush to Judgment: Are the “Litigation Explosion,” “Liability Crisis,” and Efficiency Clichés Eroding Our Day in Court and Jury Trial Commitments?*, 78 N.Y.U. L. REV. 982, 1075 (2003) (acknowledging constitutional problems in summary judgment that arise in certain circumstances and declaring that “if no ‘genuine issue of material fact’ exists and the movant is entitled to judgment ‘as a matter of law,’ pretrial disposition does not raise questions of constitutional dimensions”).

of its citizens.<sup>421</sup> The Founders considered the guarantee of a jury trial “essential in every free country,”<sup>422</sup> reflecting the trust in citizens to decide a matter requiring discretionary judgment more than a single aristocratic judge.<sup>423</sup> The rationale was that juries were the best available means to “rein in corrupt or overactive judges.”<sup>424</sup>

The Supreme Court first introduced the reasonable observer standard in *Lynch v. Donnelly*,<sup>425</sup> and it “gradually became a part of the Court’s Establishment Clause doctrine as a means for evaluating the constitutionality of a government action’s effect.”<sup>426</sup> In *Salazar v. Buono*,<sup>427</sup> the Court acknowledged that the reasonable observer standard is a fact-sensitive inquiry.<sup>428</sup> Professor Garry Gabison observed that “[i]t seems almost natural that a jury of our peers would be more adept to express this average opinion than a bench of well-educated judges.”<sup>429</sup> He also noted that “the reasonable observer standard has evolved into a mixed question of law and fact and with *Salazar*, seems to [be] moving closer to a question of fact.”<sup>430</sup> Whether judges’ experience or familiarity with the doctrine provides them with an advantage in drawing the inferences is open to question as a general matter.<sup>431</sup> The data in Section II.B show most judges encounter substantial similarity cases as a matter of first impression, and they have failed to bring clarity to the doctrine despite having decades to do so.

Some might argue that the pendulum has swung too far. Many jurors lack higher educational backgrounds and, therefore, the legal sophistication to draw and weigh inferences in complex or high-stakes

421. See Stephan Landsman, *The History and Objectives of the Civil Jury System*, in VERDICT: ASSESSING THE CIVIL JURY SYSTEM 22, 22 (Robert E. Litan ed., 1993); see also LEONARD W. LEVY, ORIGINS OF THE BILL OF RIGHTS 212 (1999) (“By the time of Magna Carta the inquest in civil cases was becoming fairly well established as the trial jury, although not in criminal cases.”).

422. *Federal Farmer IV: Oct. 12, 1787*, INFOPLEASE (Feb. 28, 2017), <https://www.infoplease.com/primary-sources/government/anti-federalist-papers/federal-farmer-iv> [<https://perma.cc/84VG-YKRR>].

423. See *From Thomas Jefferson to the Abbé Arnoux, 19 July 1789*, FOUNDERS ONLINE, <https://founders.archives.gov/documents/Jefferson/01-15-02-0275> [<https://perma.cc/T766-M62J>] (observing that the jury system “is the only way to ensure a long-continued and honest administration of its powers”).

424. Landsman, *supra* note 421, at 38.

425. 465 U.S. 668 (1984); *id.* at 688, 692–93 (O’Connor, J., concurring).

426. Kristi L. Bowman, *Seeing Government Purpose Through the Objective Observer’s Eyes: The Evolution-Intelligent Design Debates*, 29 HARV. J.L. & PUB. POL’Y 417, 445 (2006).

427. 559 U.S. 700 (2010).

428. *Id.* at 721.

429. Gabison, *supra* note 375, at 300.

430. *Id.* (footnote omitted). The legal standard is so underspecified that it is easy for it to be treated more like a question of law—and thus for the judge.

431. Ned Snow, *Judges Playing Jury: Constitutional Conflicts in Deciding Fair Use on Summary Judgment*, 44 U.C. DAVIS L. REV. 483, 517 (2010).

copyright infringement cases.<sup>432</sup> The dispute between Oracle and Google contains both features.<sup>433</sup> However, this overstates the factual issues before jurors, which are usually straightforward judgments, and which are made even simpler by this Article's proposed reforms.<sup>434</sup> In any case, juries regularly consider complex factual issues. Antitrust cases require juries to consider complex economic arguments, such as the impact of anticompetitive activities on the competitive market.<sup>435</sup> Products liability cases require juries to weigh the safety benefits of an omitted design feature against the costs of including it, accounting for any reduction in the utility of the product.<sup>436</sup>

Those distrustful of juries' ability to judge similarity can impose rules to guide them.<sup>437</sup> To develop meaningful guidance, jurors could be asked to offer opinions or identify salient factors. Federal criminal sentencing guidelines reflect such an approach.<sup>438</sup> Government action outside the formal lawmaking processes can also provide meaningful guidance for future behavior through Copyright Office Manuals or guidelines as the federal antitrust agencies issue to shape standards for compliance in intellectual property licensing.<sup>439</sup> These may have a substantial impact of soft law, even if the results are not embodied in a regulation or formally binding in a negligence suit or other legal proceeding.

Professors Harry Kalven and Hans Zeisel's seminal work for the University of Chicago Jury Project showed juries were superior in mediating disputes involving complex societal values.<sup>440</sup> Several scholars

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432. See David Nimmer, *Juries and the Development of Fair Use Standards*, 31 HARV. J.L. & TECH. (SPECIAL ISSUE) 563, 587–89 (2018) (recognizing the belief that “laymen were not fit to discharge the duties [of deciding the fair use issue] that were challenging even to specialists in the field,” and arguing against that belief).

433. See Susan Decker, *Google Could Owe Oracle \$8.8 Billion in Android Fight*, BLOOMBERG (Mar. 27, 2018, 2:33 PM), <https://www.bloomberg.com/news/articles/2018-03-27/oracle-wins-revival-of-billion-dollar-case-against-google> [<https://perma.cc/M5HQ-WQZ4>].

434. See *supra* Section III.B.

435. See, e.g., *Allied Tube & Conduit Corp. v. Indian Head, Inc.*, 486 U.S. 492, 497–98 (1988).

436. See, e.g., *Casey v. Toyota Motor Eng'g Mfg. N. Am., Inc.*, 770 F.3d 322, 333–34 (5th Cir. 2014).

437. Kaplow, *supra* note 333, at 1057 (“[W]hen decisionmakers are not entirely reliable, rules that constrain balancing—and thereby sometimes result in decisions contrary to what a properly performed balance would prescribe—can be desirable.”).

438. See U.S. SENT'G GUIDELINES MANUAL § 1A1.3 (U.S. SENT'G COMM'N 2018).

439. See generally U.S. COPYRIGHT OFF., *supra* note 394 (providing guidance to agency personnel, the courts, and the public on copyright law and registration); U.S. DEP'T OF JUST. & FED. TRADE COMM'N, ANTITRUST GUIDELINES FOR THE LICENSING OF INTELLECTUAL PROPERTY (2017), <https://www.justice.gov/atr/IPguidelines/download> [<https://perma.cc/GB4R-8NKF>] (publishing the government's antitrust enforcement policy regarding intellectual property).

440. HARRY KALVEN, JR. & HANS ZEISEL, *THE AMERICAN JURY* 3 (1971).

made a similar argument in the context of determining fair use of copyrighted works.<sup>441</sup> Notably, Professor Ned Snow argued:

The established practices and understandings of a community define whether a use's purpose is socially beneficial, whether the content of the original work merits strong protection, whether the defendant used a significant quantity or a qualitatively substantial amount of the original work, and whether the use could plausibly cause harm to a potential market of the copyrighted work.<sup>442</sup>

Each case potentially deprives individual members of the public of their property rights. Diversity brings a divergence of cultural understandings, practices, and norms that may be central to deciding how far those rights should reach.

### 3. Plaintiffs and Defendants

Rights and duties form the foundation of the American legal system.<sup>443</sup> These include freedom, bodily integrity, and property interests and, concomitantly, obligations that third parties must adhere to.<sup>444</sup> Rights, however, are not self-enforcing, and right holders must have a credible legal means of vindicating them if they are to have any meaning. Professors Gideon Parchomovsky and Alex Stein's work shows that the best way to realize the goals of compensation and deterrence is to enable victims to pursue individual justice against those who wronged them.<sup>445</sup> Class actions can deter wrongdoing but provide limited compensation for the individual class members.<sup>446</sup> Compensation funds also recompense victims but do little to prevent future wrongs.<sup>447</sup>

441. See, e.g., Ned Snow, *Who Decides Fair Use—Judge or Jury?*, 94 WASH. L. REV. 275, 325 (2019) (“This characteristic of diversity is especially relevant in deciding whether a use is fair, for an assessment of fairness demands an understanding of cultural norms and social values.”); see also Lloyd L. Weinreb, Commentary, *Fair’s Fair: A Comment on the Fair Use Doctrine*, 103 HARV. L. REV. 1137, 1161 (1990) (“The reference to fairness in the doctrine of fair use imparts to the copyright scheme a bounded normative element that . . . gives effect to the community’s established practices and understandings . . .”).

442. Snow, *supra* note 441, at 325–26 (“The institution of a judge, by contrast, lacks such a heterogeneous perspective.”).

443. See Wesley Newcomb Hohfeld, *Some Fundamental Legal Conceptions as Applied in Judicial Reasoning*, 23 YALE L.J. 16, 28 (1913).

444. *Id.* at 20–25, 28–32, 41 (distinguishing legal and nonlegal interests).

445. Parchomovsky & Stein, *supra* note 323, at 1325 (“Lawsuits by individual victims are unique in that they constitute the only litigation form that simultaneously advances the twin goals of deterring wrongdoers and compensating victims.”).

446. *Id.* at 1325, 1352 (“[C]lass actions systematically fail to compensate individual plaintiffs for their losses.”).

447. *Id.* at 1325.

Like copyright plaintiffs, plaintiffs elsewhere face systemic bias. In a breach of contract suit, the plaintiff must cumulatively show a valid contract that imposes a duty on the defendant to act or refrain from acting, and that the defendant breached the duty in a way that harmed the plaintiff.<sup>448</sup> In contrast, the defendant can rebut each element in multiple ways.<sup>449</sup> The procedural asymmetry between plaintiffs and defendants translates into plaintiffs expending resources to establish each element of their cause of action, while defendants focus on a single ground to defend. It is essential that plaintiffs face rigorous scrutiny in their attempt to vindicate their rights. Still, when the numbers show steep declines in their win rates in areas such as substantial similarity not seen elsewhere, the civil justice system must be alert in examining and addressing the causes.

### CONCLUSION

In 2018, David Zindel lost in a California federal district court on claims that Fox Searchlight's Academy Award-winning film "The Shape of Water" copied his father's 1969 play.<sup>450</sup> The court dismissed the case, concluding that any extrinsic similarities between the works were "too general to be protected," and that, as a matter of law, the works were not substantially similar.<sup>451</sup> Before the Ninth Circuit, Zindel argued it was wrong to dismiss copyright infringement suits on a pretrial motion, calling it "not only unwise, but even a denial of due process."<sup>452</sup> The Ninth Circuit agreed.<sup>453</sup> Victories like these make the news, but they also hide the worst decline in the viability of substantial similarity claims over the past century—something this Article reveals.

Substantial similarity requires courts to determine if copyrightable aspects of the original work are present in the accused work. If so, fact finders must decide if the accused work has sufficiently misappropriated the protected elements to find infringement. The means for judging similarity must strike a balance between providing ardent protection for copyrightable works while allowing those who create innovative new designs to use them fairly.

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448. *E.g.*, *Oasis W. Realty, LLC v. Goldman*, 250 P.3d 1115, 1121 (Cal. 2011).

449. *See generally* E. ALLAN FARNSWORTH ET AL., *CONTRACTS* (8th ed. 2013) (explaining elements and defenses of contract actions).

450. Blake Brittain, *Ex-Judge Kozinski Wins IP Ruling After Scandal-Marred Retirement*, BLOOMBERG L. (June 23, 2020, 9:40 AM), <https://news.bloomberglaw.com/ip-law/kozinski-gets-shape-of-water-case-reinstated-by-ninth-circuit> [<https://perma.cc/7X7M-WRFX>].

451. *Zindel v. Fox Searchlight Pictures, Inc.*, No. CV18-1435, 2018 WL 3601842, at \*7 (C.D. Cal. July 23, 2018), *rev'd*, 815 F. App'x 158, 159–60 (9th Cir. 2020).

452. Blake Brittain & Melissa Heelan Stanzione, *Kozinski Argues Case at 9th Circuit After Sex Misconduct Claims*, BLOOMBERG L. (Dec. 9, 2019, 4:35 PM), <https://news.bloomberglaw.com/us-law-week/kozinski-returns-to-9th-cir-to-argue-shape-of-water-case> [<https://perma.cc/RB4S-BYQF>].

453. *Zindel v. Fox Searchlight Pictures, Inc.*, 815 F. App'x 158, 159–60 (9th Cir. 2020).

Reform should focus on three aspects. First, courts should judge works holistically from the vantage of an informed ordinary observer. Avoiding elemental dissections of the copyrighted work makes substantial similarity easier for fact finders to administer, which makes them less likely to penalize plaintiffs whose works invariably incorporate some unprotectable elements. Second, instead of indulgently granting pretrial motions to defendants, courts should restore to the jurors their proper role. The determinations about what appears similar to the work's intended audience is one the jury is well-positioned to make (with expert advice, when appropriate). Third, plaintiffs' identifying expressive elements in copyright registrations will help clarify what they seek to protect and provide notice to defendants.

Plaintiffs are indispensable to our legal system. They play a pivotal role in exposing misconduct, and they help the copyright system achieve its policy goals. Like predators in any ecological system, plaintiffs are easy to vilify because their success necessarily means the demise of their prey; in the case of copyright, making defendants pay royalties or having them enjoined from their intended use. Erase any meaningful chance of success, however, and the engine for producing creative new works will splutter and collapse. The most important and immediate benefit of reforming substantial similarity would be plaintiffs' restored ability to prove improper, actionable infringement. Restoring a reasonable chance of succeeding in litigation to plaintiffs helps preserve public trust in the law, and it is the right thing to do.