Summary Judgment on Substantial Similarity in Copyright Actions

Julie J. Bisceglia

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Summary Judgment on Substantial Similarity in Copyright Actions

by

JULIE J. BISCEGLIA*

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Introduction

Rule 56 of the Federal Rules of Civil Procedure permits a court to grant summary judgment to a plaintiff or a defendant if the pleadings, depositions, affidavits, and other papers show that "there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." The rule further allows the court to render summary judgment on liability alone, leaving the amount of damages for determination at trial.\(^2\)

The summary judgment rule was first adopted in 1938.\(^3\) The rule was amended in the late 1940s, and amended again in 1963.\(^4\) Not all courts have been enthusiastic about summary judgment.\(^5\) This aversion stems from a deeply felt belief that all parties are entitled to their day in court\(^6\) and from a fear that judges might use the rule to clear their dockets with unseemly speed.\(^7\) The amendments, especially the present subsection (e), were designed to strengthen the rule and counter this hostility.\(^8\)

Within the last several years, the United States Supreme Court has lent its efforts to promote summary judgment. In a trio of cases, Celotex Corp. v. Catrett,\(^9\) Anderson v. Liberty Lobby,\(^10\) and Matsushita Electrical Industrial Co. v. Zenith Radio Corp.,\(^11\) all decided in the same term, the Court in essence lightened the task of moving defendants. In Celotex, the Court held that a moving party need not negate an opposing party's claim in order to be granted summary judgment.\(^12\) If a non-moving party would bear the burden of proof at trial, that party must present enough evidence to create a genuine issue of material fact on that point; in the absence of such evidence, summary judg-

1. FED. R. CIV. P. 56(c).
2. Id.
4. Id.
5. See id. at 466.
7. See, e.g., California Apparel Creators v. Weider of California, 162 F.2d 893, 903 (2d Cir. 1947) (Hand, J., dissenting); Schwarzer, supra note 3, at 466.
8. See subdivision (a), which states that "an adverse party may not rest upon the new allegations or denials of his pleading, but his response . . . must set forth specific facts showing that there is a genuine issue for trial." See also FED. R. CIV. P. 56(e) advisory committee's note to 1963 amendment.
12. 477 U.S. at 323.
ment is properly granted. In Anderson, the Court held that a court considering a summary judgment motion must consider the standard of proof needed to establish a claim or defense. If the standard is higher than a mere preponderance of the evidence, the court must take this higher standard into account when deciding whether the non-moving party has presented evidence that creates a genuine issue of material fact. In Matsushita, the Court stated, “[I]f the factual context renders respondents' claim implausible—if the claim is one that simply makes no economic sense—respondents must come forward with more persuasive evidence to support their claim than would otherwise be necessary.” The “implausible” claim in Matsushita was an alleged predatory pricing conspiracy, but this useful quotation may have a far wider application.

Much ink has been spilled in cases and commentaries defining “genuine issues” and “material facts.” A complete discussion of these terms is beyond the scope of this article. Generally, an issue of “material fact” is one that must be resolved to determine the outcome of the suit. If the trier of fact must make a decision about a fact in order to determine the outcome, the fact is material. For example, in a copyright infringement action, a factual dispute involving access is not material if there is no substantial similarity between the two works being compared. A “genuine issue” is one about which reasonable persons could disagree. If the evidence would lead reasonable persons to only one conclusion, there is no “genuine issue” and no need for trial. Courts have also articulated this test by inquiring whether the moving party's evidence would require a court to enter a directed verdict or a judgment notwithstanding the verdict in the moving party's favor. If so, summary judgment is properly granted.

To obtain a summary judgment, the moving party must produce admissible evidence showing that it is entitled to judgment as a matter of law. The party opposing summary judgment must then show by its own evidence the existence of a genuine issue of “material” fact

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13. Id. at 322-23.
14. 477 U.S. at 252.
15. Id.
16. 475 U.S. at 587.
19. Id. at 481-89.
20. Id. at 481.
21. Id.
22. FED. R. CIV. P. 56(c).
that must be resolved by trial and may not simply rest on the plead-
ings and attack the credibility of an affidavit.\textsuperscript{23} If the non-moving party does not respond adequately, summary judgment may be granted.\textsuperscript{24}

At the appellate level, the standard of review is generally de-
ovo, since the complete record is before the panel and judgment was rendered as a matter of law.\textsuperscript{25} If the lower court’s judgment appears to rest on a substantial factual record or in some way involves a trial court’s special expertise, the appellate court might use the clearly er-
roneous standard.\textsuperscript{26}

This Article focuses on reported copyright infringement cases in
which one party moves for summary judgment on the issue of substan-
tial similarity. This is a small but extremely problematic subclass of
copyright summary judgment cases.\textsuperscript{27} The Article attempts two tasks. First, it synthesizes many holdings in order to discern in general what
each party must do to obtain or resist a summary judgment.\textsuperscript{28} The Article attempts to survey all reported copyright cases involving sum-
mary judgment, regardless of the nature of property involved. The
second task is narrower. It proposes a method of inquiry that might
profitably be used in cases dealing with literary properties.\textsuperscript{29}

\textsuperscript{23} See Schwarzer, supra note 3, at 485.
\textsuperscript{24} FED. R. CIV. P. 56(e). As the Supreme Court held in Celotex Corp. v. Catrett,
"Rule 56(c) mandates the entry of summary judgment . . . against a party who fails to make
a showing sufficient to establish the existence of an element essential to that party’s case,
and on which that party will bear the burden of proof at trial." 477 U.S. at 322. The Court
further held that there was no “express or implied requirement in Rule 56 that the moving
party support its motion with affidavits or other similar materials negating the opponent’s
claim.” Id. at 323 (emphasis in original).

\textsuperscript{25} Schwarzer, supra note 3, at 489.
\textsuperscript{26} Id.

\textsuperscript{27} The paper thus excludes cases dealing with (1) the ownership or validity of a copy-
right, see, e.g., Kennyvonne Music Inc. v. CBS, 150 U.S.P.Q. (BNA) 785 (S.D.N.Y. 1966);
Siewek Tool Co. v. Morton, 128 F. Supp. 71 (E.D. Mich. 1954); (2) the nature of a copy-
righted work (e.g., whether it is art or a useful article), see, e.g., Norris Indus. v. Interna-
tional Tel. & Tel. Corp., 696 F.2d 918 (11th Cir. 1983); (3) unauthorized performance, see,
e.g., Bernstein v. Adams Getschall Broadcasting Co., 176 U.S.P.Q. (BNA) 286 (E.D.N.Y.
1972); (4) originality, see, e.g., Trowler v. Phillips, 260 F.2d 924 (9th Cir. 1958); and (5)
cases dealing with demurrers and injunctions, see, e.g., Universal City Studios, Inc. v.

The author originally intended to also include fair use cases in the survey. But, the
issues differ so greatly from those of substantial similarity that any attempt to incorporate
them would be impractical. Fair use is so often a question of fact that summary judgment
on that issue is rare, though not impossible. See, e.g., Hustler Magazine, Inc. v. Moral
Majority, Inc., 796 F.2d 1148 (9th Cir. 1986); Fisher v. Dees, 794 F.2d 432 (9th Cir. 1986).

\textsuperscript{28} See infra part I.
\textsuperscript{29} See infra notes 202-05 and accompanying text.
Summary judgment based on the issue of substantial similarity creates tension between legal theory and practice. On one hand, the standard test for substantial similarity requires the response of the ordinary lay observer. Thus, this issue would seem to be the archetypal jury question, for which summary judgment would never be appropriate. The economics of litigation, however, requires that summary judgment be available in copyright infringement cases to carry out the overriding purpose of the Federal Rules: “to secure the just, speedy, and inexpensive determination of every action.”

The availability of summary judgment becomes especially critical when the disputed property is a television show or film. As the financial stakes are high, the rights of both plaintiffs and defendants can be seriously compromised. It is safe to say that the owner of a hit movie or television show and its cohorts will soon thereafter be defendants in at least one lawsuit. And successful properties are easily imitated or exploited without authorization. If non-meritorious suits or suits involving obviously dissimilar properties must be fully litigated, rights become too expensive to enforce. Summary judgment, while not exactly bargain-basement, offers plaintiffs and defendants a way of protecting their rights that may not require them to bankrupt themselves in the process.

This discussion begins with a survey of reported cases dealing with substantial similarity, categorized by moving and opposing party, summarizing arguments that have proven successful in each

30. See, e.g., Sid & Marty Krofft Television Prods. v. McDonald's Corp., 562 F.2d 1157, 1164-65 (9th Cir. 1977); Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904, 907 (3d Cir.), cert. denied, 423 U.S. 863 (1975); 3 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[E] [hereinafter NIMMER].

31. FED. R. CIV. P. 1.

32. See Ronald S. Rosen, Current Trends in Entertainment Litigation: The Insurance Empire Strikes Back, 1 ENT. & SPORTS L. 1, 5-8 (1982), for the origin of these suits.

33. Because Rule 56 permits extensive discovery, it is still possible to run up enormous legal bills without ever getting to trial. Some defendants have solved this problem by moving for dismissal under Rule 12(b)(6) of the Federal Rules of Civil Procedure, attaching the disputed properties to the motion, and asking the judge to convert the motion to a Rule 56 summary judgment motion, as permitted by Rule 12(b)(6). See Stillman v. Leo Burnett Co., 720 F. Supp. 1353, 1355 (N.D. Ill. 1989). This procedure seems risky, but it has worked in other cases as well. See Midwood v. Paramount Pictures Corp., Copyright L. Rep. (CCH) ¶ 25,292 (S.D.N.Y. Aug. 19, 1981) (film Posse not substantially similar to short story Sheriff); Mount v. The Viking Press, Inc., No. 75 Civ. 550 (JMC), slip op. (S.D.N.Y. Dec. 22, 1977) (art books not substantially similar).

In one case, defendants moved for summary judgment before answering. Even at this early stage, they were able to eliminate three of the four allegedly infringed properties from the case. Novak v. NBC, 716 F. Supp. 745, 747 (S.D.N.Y. 1989) (Saturday Night Live TV skits).

34. See infra part I.
category. The high percentage of successful defendant motions for summary judgment and their recognizable pattern suggest that many non-meritorious suits are being brought, owing, at least in part, to the inadequacy of existing “tests” for substantial similarity. In an effort to make the inquiry more principled and less ad hoc, a method is suggested that more accurately reflects the mental processes of readers or viewers comparing two literary works for their similarities. If a reasonable method for comparing two works emerges, it may reduce the number of marginal suits, by eliminating those prepared by conscientious counsel who simply cannot tell, given the present state of the law, whether their clients have meritorious claims.

I

Survey Results

A. Plaintiff-Moving Party

A plaintiff seeking summary judgment for substantial similarity will have to show, in most cases, that the defendant's work is nearly identical to his or that some unusual circumstance conclusively demonstrates copying. Summary judgment is infrequently granted to plaintiffs on this issue. Most cases involve non-literary works: toys, cartoon characters, wall plaques, video games, maps, fabrics.

35. See infra part I.D.
36. See infra notes 166-201 and accompanying text.
37. See infra notes 202-05 and accompanying text.
38. It is also helpful to show some kind of intent, such as the deliberate attempt to capitalize on the success of an already-established product or deceptive behavior. In SAS Inst., Inc. v. S&H Computer Sys., Inc., 605 F. Supp. 816, 827 (M.D. Tenn. 1985), a computer software manufacturer obtained a partial summary judgment against another computer company, subject to the plaintiff's copyright being found valid. When, at trial, the court found a valid copyright, it incorporated the summary judgment findings into the final judgment. In this case, not only was the copying obvious, but the defendants also had entered into a licensing agreement with the plaintiffs to use the plaintiffs' software, deliberately intending to steal the source code and use it to make their own software package.
39. For the purposes of this Article, non-literary work is defined by exception to the definition of literary work found at 17 U.S.C. § 101 (1988).
41. Walt Disney Prods. v. Air Pirates, 581 F.2d 751 (9th Cir.) (summary judgment granted in unreported opinion; Disney characters used in underground comics), cert. den.
designs on clothing,\textsuperscript{46} magazine covers,\textsuperscript{47} auto parts containers,\textsuperscript{48} photographs,\textsuperscript{49} and computer software.\textsuperscript{50} In each instance, the defendant had either substantially appropriated the plaintiff's work or had reproduced it with minor alterations, such as the removal of the plaintiff's name and copyright notice.\textsuperscript{51}

Printed materials that have been the subject of summary judgment motions include a construction trade directory,\textsuperscript{52} an engineering training manual,\textsuperscript{53} a cake decorating booklet,\textsuperscript{54} an instruction package for data processing,\textsuperscript{55} a book about the television show "Twin Peaks" that contained detailed plot summaries of the TV episodes as well as numerous lines of dialogue,\textsuperscript{56} and excerpts from a book of memoirs written by the Shah of Iran's last ambassador to Great Britain, published in the London \textit{Sunday Times}.\textsuperscript{57} Sections of the cake-decorating booklet\textsuperscript{58} and sections of the engineering manual\textsuperscript{59} were incorporated into the defendant's work.


54. Marcus v. Rowley, 695 F.2d 1171 (9th Cir. 1983).


57. Radji v. Khakbaz, 607 F. Supp. 1296 (D.D.C. 1985). In this case, defendants were under the erroneous impression that if they only copied most of the portion of plaintiff's book that appeared in the \textit{Sunday Times} (about 10% of the total book) and translated the English text into Farsi, they could escape liability for copyright infringement. They told the judge that because the judge did not read or understand Farsi, he could not rule on the substantial similarity of their translation to the original. The judge dismissed these arguments.

58. \textit{See Marcus v. Rowley}, 695 F.2d at 1173.
verbatim into the defendant's materials. The appropriation in the other cases was not quite so breathtaking. In these cases, the courts were impressed not only by the "copious amounts" of verbatim copying, but also by the identity of format, layout, classification structure and, in the directories, color and lettering. Moreover, the defendants often reproduced the plaintiffs' typographical errors and other peculiarities. Such strong evidence of piracy justified granting summary judgments to the plaintiffs.

A plaintiff, or a party occupying a position similar to a plaintiff, has been granted summary judgment in three cases involving works of fiction. The circumstances surrounding the cases were quite unusual. In Anderson v. Stallone, plaintiff wrote a thirty-one-page treatment for a proposed Rocky IV film, after viewing the first three Rocky films, and submitted it to MGM. The inevitable lawsuit followed when Rocky IV appeared and plaintiff received no compensation for his treatment. Stallone, owner of the Rocky copyrights, counterclaimed for copyright infringement. Defendants moved for summary judgment.

The court found that plaintiff's treatment was not substantially similar to Rocky IV. The court went further, however, and found that plaintiff's treatment was itself an infringing work, since he had appropriated the central group of Rocky characters from the first three Rocky movies into an unauthorized derivative work. Although Stallone had not moved for summary judgment on his counterclaim, the success of such a motion, if he had chosen to make it, would have been assured.

64. Id. at 1162.
65. Id.
66. Id. at 1164.
67. Id. at 1169.
68. Id. at 1166-67.
Another unusual case is *Burgess v. Chase-Riboud*. Plaintiff, the author of a play about a reputed mistress of Thomas Jefferson, filed a declaratory relief action for a declaration that his play did not infringe a prior book written by defendant on the same subject. On defendant’s summary judgment motion, the court held that the play *did* infringe upon the book’s copyright, as certain invented scenes from the book had been incorporated into the play.

The final case of summary judgment regarding a work of fiction, *Childress v. Taylor*, involved two plays about Moms Mabley, in which the defendant actress had appeared. The court found numerous examples of verbatim copying in the second play. In fact, the defendant considered herself (erroneously as it turned out) to be one of the authors of the first play and therefore entitled to help herself to its dialogue in fashioning the second play. This argument was unavailing, however, and the plaintiff author of the first play obtained summary judgment.

To summarize, plaintiffs have generally been granted summary judgments in the past only in the face of egregious copying or some other unusually compelling circumstance. Although this conclusion will probably not dim the ardor of aggrieved plaintiffs, an attorney counselling a client about a potential infringement suit should be aware of this high threshold for plaintiffs’ summary judgment.

**B. Plaintiff-Responding Party**

A plaintiff opposing a motion for summary judgment must convince the court that a genuine issue of material fact exists. Plaintiffs have relied on several techniques to accomplish this task, some related to the issues and others not.

In the past, plaintiffs sometimes relied on latent or patent judicial hostility to summary judgment to tip the scales in their favor. This hostility grew out of the “day in court” philosophy alluded to previously. The leading case for plaintiffs opposing summary judgments,
Arnstein v. Porter, 78 held that there should be a trial on the merits if there was the "slightest doubt as to the facts." 79 The doubt in Arnstein was very slight indeed: the plaintiff alleged that some of Cole Porter's most popular songs, including "Begin the Beguine," "Night and Day," and "You'd Be So Nice To Come Home To," were plagiarized from plaintiff's "The Lord Is My Shepherd," "A Mother's Prayer," "I Love You Madly," and "Sadness Overwhelms My Soul." 80 The plaintiff further accused Porter of planting "stooges" around him and implied that Porter was somehow involved in several burglaries during which songs were stolen. 81 Porter denied any contact with the plaintiff's compositions, some of which were unpublished. The trial judge characterized the plaintiff's accusations as "fantastic." 82 Nevertheless, the appellate court required a jury trial on both the access and substantial similarity issues. 83

Plaintiffs opposing summary judgments cite Arnstein to support the proposition that "generally there should be trials in plagiarism suits." 84 Although several early cases so hold, 85 judges are much less likely to agree as court calendars become more crowded and workloads increase. Only two cases in the 1970s, and none since 1975, have cited Arnstein on this point with approval. 86 Although plaintiffs will no doubt continue to advance it, Arnstein's "slightest doubt" argument does not seem to carry much weight with modern courts.

78. 154 F.2d 464 (2d Cir. 1946).
79. Id. at 468.
80. Id. at 467. "A Mother's Prayer" seems to have been a particularly fertile source; "Begin the Beguine" and "My Heart Belongs to Daddy" were both alleged to have been copied from it.
81. Id.
82. Id. at 469.
83. Id. For a description of this plaintiff's previous adventures in court, see Alexander Lindey, Plagiarism and Originality 193-98 (1952).
85. MacDonald v. DuMaurier, 144 F.2d 696 (2d Cir. 1944) (plaintiff alleged defendant's Rebecca copied from her story); Dezendorf v. Twentieth Century-Fox Film Corp., 99 F.2d 850 (9th Cir. 1938) (unpublished play alleged to be source for film); Solomon v. R.K.O. Pictures, 40 F. Supp. 625 (S.D.N.Y. 1941) (plaintiff alleged defendant's film Radio City Revels infringed on plaintiff's play It Goes Through Here).

The Ninth Circuit's original opinion in Baxter v. MCA, Inc., 812 F.2d 421 (9th Cir. 1987), cited Arnstein on this point. When MCA's counsel protested and asked for a rehearing on the grounds that the opinion revived the "slightest doubt" test, the court deleted the reference in its amended opinion.
Plaintiffs have the best chance of success if they pursue two issue-oriented lines of attack: raising questions of fact about access and raising questions about substantial similarity itself. Copyright protection precludes only copying. A plaintiff must thus prove that the defendant had access to his work in order to copy it. If the defendant arrived at the same place without having seen (or heard) the plaintiff's work, the plaintiff cannot recover, even if the two works are virtually identical.

As access is usually a question of fact, defendants often concede it in their motions for summary judgment in order to clear the way for a judgment as a matter of law. This decision—whether to concede access—is a difficult one for defendants, because summary judgment can occasionally be obtained on this issue alone. When defendants do not concede access, plaintiffs have sometimes successfully resisted motions for summary judgment. The Arnstein court based its reversal in part on this issue, emphasizing the importance of witness credibility in determining access. Other courts have likewise refused to grant summary judgments because witness credibility weighed so heavily.

Of course, if the plaintiff can convince a court that the similarities and differences between the two works are too close to decide as a matter of law, the court will deny the defendant's motion or will reverse the granting of a motion on appeal. Since it is now de rigueur

87. 3 NIMMER, supra note 30, § 13.02.
88. If the plaintiff cannot show access, his burden on the similarity issue becomes heavier. He must show "striking similarity" instead of merely "substantial similarity." See, e.g., Selle v. Gibb, 741 F.2d 896, 903 (7th Cir. 1984). Nonetheless, one court refused to grant summary judgment even in the face of this heavier burden. See Testa v. Janson, 492 F. Supp. 198 (W.D. Pa. 1980) (even though no proof of access, defendant's motion for summary judgment denied).
89. See, e.g., Litchfield v. Spielberg, 736 F.2d 1352 (9th Cir. 1984); Risdon v. Walt Disney Prods., No. 83 Civ. 6595 (S.D.N.Y. Nov. 2, 1984).
91. 154 F.2d at 469-70 (2d Cir. 1946).
93. See, e.g., Shaw v. Lindheim, 919 F.2d 1353, 1355 (9th Cir. 1990) (Equalizer script and pilot script for television show Equalizer could be substantially similar); Baxter v. MCA, Inc., 812 F.2d 421, 425 (9th Cir. 1987) (reasonable minds could differ as to whether the theme from E.T. copied plaintiff's song "Joy": no "bright line" determines how much similarity is permissible); Twentieth Century-Fox Film Corp. v. MCA, Inc., 715 F.2d 1327 (9th Cir. 1983) (Star Wars and Battlestar Galactica too similar for summary judgment); Blumcraft of Pittsburg v. Newman Bros., 373 F.2d 905 (6th Cir. 1967) (ornamental hand railings); Morgan Creek Prods., Inc. v. Capital Cities/ABC, Inc., 22 U.S.P.Q.2d (BNA) 1881 (C.D. Cal. 1991) (similarities between the movie Young Guns and the TV show Young Riders triable); Trousseau Monogram Corp. v. Saturday Knight, Ltd., 16 U.S.P.Q.2d
to submit the properties at issue to the court in conjunction with the motion, the court has its own opportunity to compare them. To assist the court in its determination, plaintiffs have relied on two instructional aids, both of which can backfire if used imprudently: expert testimony and list of similarities.

Expert testimony will be discussed in more detail subsequently. It is only necessary to note here one advantage and one disadvantage of its use. Regardless of its substance, expert testimony may be used successfully if the moving party's papers included such testimony. If the opposing party produces experts with contrary opinions, the court may deny a motion for summary judgment, believing that differences of opinion between experts must be resolved by a jury. Expert testimony can work against the non-moving plaintiff, however, if the court uses the *Krofft* test for substantial similarity. Several courts have expressed more than a little irritation at long-winded and arcane analyses, and the *Krofft* court held this kind of advice inappropriate in

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94. See infra note 194 and accompanying text.

95. See, e.g., Levine v. McDonald's Corp., 735 F. Supp. 92 (S.D.N.Y. 1990), in which a summary judgment motion regarding the similarity between plaintiff's "patter" technique song and a McDonald's commercial became a battle of the experts. Defendants' summary judgment motion was denied.

In at least one case, however, defendants' experts so outshone plaintiff's expert that the court granted defendants' motion for summary judgment largely on the strength of their declarations. Moore v. Columbia Pictures Indus., 972 F.2d 939 (8th Cir. 1992).

96. Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157 (9th Cir. 1977). See infra notes 183-92 and accompanying text.
applying the "intrinsic" test for infringement.\footnote{Id. at 1164. See also Nichols v. Universal Picture Corp., 45 F.2d 119, 123 (2d Cir. 1930) (Judge Learned Hand criticized expert witness used in trial court and expert testimony in general).} A judge faced with reams of expert prose may conclude that his time is being wasted and perhaps that he is being patronized.

The list of similarities that plaintiffs inevitably submit to direct the court's attention to bases of infringement must be compiled with extreme caution. A bad list is worse than no list at all. A bad list compares widely scattered details, rearranges the components of the works to give a false sense of sequence, and isolates insignificant resemblances, elevating them into major factors.\footnote{See, e.g., Litchfield v. Spielberg, 736 F.2d 1352, 1356 (9th Cir. 1984); Nash v. CBS, Inc., 704 F. Supp. 823, 829 (N.D. Ill. 1989); Silva v. MacLaine, 697 F. Supp. 1423, 1428 (E.D. Mich. 1988); Overman v. Universal City Studios, 605 F. Supp. 350, 353 (C.D. Cal. 1984).} Few documents in a copyright suit provoke more judicial ire than a list of similarities that, in effect, insults the court's intelligence.\footnote{See, e.g., Costello v. Loew's, Inc., 159 F. Supp. 782, 788 (D.D.C. 1958).}

One defensive tactic that, although successful, cannot be recommended is reported in Allen v. Suskind.\footnote{Copyright L. Rep. (CCH) ¶ 25,471 (S.D.N.Y. Nov. 18, 1982).} In that case, the judge denied a motion for summary judgment because of discrepancies between the plaintiff's affidavit and his deposition. Although expressing his strong disapproval of this state of affairs, the judge nonetheless perceived an issue of fact about whether the plaintiff had invented certain passages or quoted them. It is not likely that this situation will be imitated, especially because it required a determination of which of plaintiff's sworn statements was false.

In another unusual case, the defendant moved for summary judgment on the issue of the validity of plaintiff's copyright of a design on women's clothing, claiming that the copyright was invalid because plaintiff had copied its design from another designer.\footnote{North Coast Indus. v. Jason-Maxwell, Inc., 972 F.2d 1031, 1034 (9th Cir. 1992).} This tactic placed plaintiff in the position usually reserved for a defendant—trying to prove that its design was not substantially similar to another's design. The district court ruled that plaintiff did not have a valid copyright in the design because it had been copied from another source.\footnote{Id. at 1031.} The Ninth Circuit reversed, holding that the issue of plaintiff's originality, and therefore the validity of its copyright, must be tried.\footnote{Id.}
C. Defendant-Responding Party

The defendant trying to resist a motion for summary judgment faces the same task as the plaintiff. He must convince the court that a trial is required to resolve a genuine issue of material fact. Thus, defendants have tried to raise the same factual issues that opposing plaintiffs raise, particularly those such as access, which call for a trier of fact to evaluate witness credibility.

Defendants have also successfully resisted summary judgments at the appeals level. In each case, the appellate court held that the trial court had not properly distinguished between different kinds of works. As Morrissey v. Procter & Gamble Co. established, if an idea can be expressed in only a few ways, then allowing the expression to be copyrighted would be tantamount to permitting the copyrighting of an idea. Two courts reversed summary judgments granted to plaintiffs on this principle. One case involved wall charts showing how to use weight-lifting equipment; the other a book on how to win at Scrabble. In both instances, the courts found that ways of expressing the ideas were so limited that greater similarity would have to be tolerated to avoid copyrighting the idea.

D. Defendant-Moving Party

An attorney who likes to have the odds in his or her favor will move for summary judgment on behalf of a defendant. Of the cases reviewed, victories for moving defendants constitute more than all other victories combined.

104. Sometimes the plaintiff and the defendant make cross-motions for summary judgment, only to have them both denied on the same grounds—triable issues of fact. See, e.g., Heyman v. Salle, 743 F. Supp. 190, 194 (S.D.N.Y. 1989).


106. 379 F.2d 675 (1st Cir. 1967).


1. Idea/Expression Dichotomy

When a defendant moves for summary judgment, similar elements usually appear somewhere in both works. Defendants nevertheless often prevail. The theories employed in a successful defendant’s motion are but variations on one theme: copyright protection extends only to protectable expression.¹⁰⁹

a. Ideas Not Protectable

The desire to keep ideas free of copyright monopoly has been expressed in several ways. The court may flatly find, as it did in Musto v. Meyer,¹¹⁰ that the defendant copied the plaintiff’s ideas, not his expression. In Musto, the plaintiff had published an article in a medical journal on Sherlock Holmes, Sigmund Freud, and cocaine. The paper gave the history of nineteenth-century cocaine use and speculated, tongue in cheek, that Sherlock Holmes’ mysterious disappearance could be due to his being treated for cocaine addiction. No less a personage than Freud, himself fascinated by cocaine, would have been his therapist. Six years later, defendants published a book, The 7% Solution, and released a movie by the same name shortly thereafter. Drawing heavily on Sir Arthur Conan Doyle’s stories, the book purported to be a newly discovered Watson manuscript. It told of Holmes’s overuse of cocaine, his resulting paranoia about Professor Moriarity, and a ruse whereby Watson induces Holmes to travel to Vienna. In Vienna, Freud cures Holmes of his addiction, and Holmes suggests to Freud deductive techniques that Freud might profitably employ in psychoanalysis. Together Freud and Holmes solve a mystery, using a combination of detective ability and psychoanalytic insight. The court held that the defendants had copied only the plaintiff’s idea, not his expression.¹¹¹

[T]he similarity between the article and the book is limited to the idea that Sir Arthur Conan Doyle misled the reading public in The Final Problem as to the real activities of Sherlock Holmes in Central Europe, that Holmes was really addicted to cocaine at the time, and that Holmes’ friend, Watson, tricked Holmes into following Professor Moriarity to Vienna so that he could be cured of his habit by Sigmund Freud.¹¹²

¹⁰⁹. The other theme in these cases is the burden on the plaintiff to make some showing of access. See infra notes 145-55 and accompanying text.
¹¹¹. The court also appeared to be influenced by the heavy use both works had made of a common source, Sir Arthur Conan Doyle’s stories, the pertinent parts of which were by then in the public domain. Id.
¹¹². Id. at 36-37. The plaintiff isolated eight elements common to his article and the book. The court conceded that “certain elements” appeared in both (without saying which
b. Similarities Only in Factual Expression

A court may also find that the similarities involve information that is non-protectable. These include historical or biographical


113. A recent United States Supreme Court opinion has reaffirmed the non-protectable nature of facts, although not in the context of substantial similarity of copyrightable expression. “The mere fact that a work is copyrighted does not mean that every element of the work may be protected. Originality remains the sine qua non of copyright; accordingly, copyright protection may extend only to those components of a work that are original to the author.” Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340, 348 (1991). Noting that “copyright requires originality, . . . [and] facts are never original,” id. at 360, the Court explained that “facts do not owe their origin to an act of authorship. The distinction is one between creation and discovery: the first person to find and report a fact has not created the fact; he or she has merely discovered its existence.” Id. at 347.
facts and events. In *Fuld v. National Broadcasting Co.*, the court compared the plaintiff's unpublished script on the life of gangster Bugsy Siegel with the defendant's television movie, *The Virginia Hill Story*. The plaintiff listed eighteen points of similarity which the court cut down to eleven, because the remaining seven occurred only in the script, not in the movie as it was broadcast. The defendant countered with a list of biographical sources for Siegel's life. The court held, "[I]t is impossible to copyright historical facts or fictional material previously published by others."\(^\text{115}\)

Similarly, the court in *Alexander v. Haley*\(^\text{116}\) held that similarities between the plaintiff's book *Jubilee* and the defendant's famous *Roots*, both about American slaves, derived in part from historical fact. "No claim of copyright protection can arise from the fact that plaintiff has written about such historical and factual items, even if we are to assume that Haley was alerted to the facts in question by reading *Jubilee*."\(^\text{117}\) The court also held that "material traceable to common sources, the public domain or folk custom" is not protectable.\(^\text{118}\)


\(^{115}\) Id. at 882. See also Norman v. CBS, Inc., 333 F. Supp. 788, 796-97 (S.D.N.Y. 1971).


\(^{117}\) Id. at 45.

c. Scène à Faire

Scène à faire as a term of copyright art was adopted by Judge Yankwich in Schwartz v. Universal Pictures as "a very expressive [French] phrase in dramatic literature." He defined it as a "scene that 'must' be done" and gave as an example a play in which Adolphe Menjou spilled some red ink and wiped it off with a handkerchief. The scène à faire involving the red spot on the handkerchief then became inevitable.

This principle of economy, which allows an author to convey an idea with little explanation, extends beyond plays, of course, and is usually expected as part of a work's unity. That is, although life itself abounds with dead and loose ends, art is more tidily fashioned, and each detail is purposely chosen to contribute to the whole. Deviations from this principle receive either praise or blame, depending on whether critics think the author deviated intentionally, to imitate life more closely, or absentmindedly, because he forgot.

From this humble and restricted beginning, scène à faire has grown into a formidable barrier to copyright infringement actions. It now has two definitions, neither of which exactly parallels Judge Yankwich's original formulation. Scène à faire now refers to (1) standard or "stock" characters, episodes, and incidents, or (2) elements that inevitably arise in the treatment of a certain theme, situation, or setting. Thus, no Western would be complete without a black-hatted villain, a tall-in-the-saddle good guy, a shootout, and a ride off into the sunset. A "spring break" movie will reliably feature hordes of scantily clad bathing beauties, beer-guzzling college boys, and such well-worn plot devices as the couple who manages to find true love

For a detailed list of cases:


120. Id.
121. See, e.g., See v. Durang, 711 F.2d 141, 143 (9th Cir. 1983); Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 979 (2d Cir.), cert. denied, 449 U.S. 841 (1980).
amid the general frenzy. This is not exactly what Judge Yankwich, or the French, had in mind.

The similarities between the two works involved in *Alexander v. Haley* were held non-infringing as *scènes à faire*.\(^{123}\) As that court defined it, *scènes à faire* means "incidents, characters, or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic."\(^{124}\) The court identified "[a]ttempted escapes, flights through the woods pursued by baying dogs, the sorrowful or happy singing of slaves, the atrocity of the buying and selling of human beings,"\(^{125}\) as well as "scenes portraying sex between male slaveowners and female slaves and the resentment of the female slaveowners . . . ; the sale of a slave child away from her family . . . ; punitive mutilation . . . ; and slaveowners complaining about the high price of slaves"\(^{126}\) as *scènes à faire* connected with the American slave experience.

In *Davis v. United Artists Inc.*,\(^{127}\) the author of the book *Coming Home* sued the makers of a film by the same name. In granting a summary judgment to the defendants, the court ruled that those similarities not "strained" or "insignificant" flowed from "a sequence of events which necessarily follow from a common theme, in this instance, elements that are common in any story about the Vietnam War."\(^{128}\) The court gave as an example the "stock" figure of a patriotic soldier whose war experience confuses his values.\(^{129}\)

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124. Id.
125. Id. at 45.
126. Id. at 45 n.7.
128. Id. at 727.
Defendant's counsel will thus often try to show that the similarities between two properties arise not from copying, but from the fact that the two works belong to the same genre or that they both treat the same theme. To permit copyright protection of elements belonging to the genre or theme would effectively deliver them into one person's hands. This defense has proven very successful.

d. Limited Way to Formulate Statement

Defendants have also prevailed in cases involving factual statements if they can show that the forms of expression for an idea are so limited that allowing the plaintiff to copyright the expression effectively allows him to copyright the idea. In *Morrissey v. Procter & Gamble Co.*, the plaintiff claimed the defendant's contest rules infringed his rules for a sale promotion contest. Although the two sets of rules were nearly identical, the appeals court upheld defendant's summary judgment because "to permit copyrighting would mean that a party . . . by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance." The court in *Consumer's Union v. Hobart Mfg. Co.* granted the defendant's summary judgment motion on copyright infringement even though the defendant copied part of the magazine article about its dishwasher and distributed it in a sales bulletin. This court reasoned that such purely factual statements could not be otherwise expressed.

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130. One notable exception involved the suit between the makers of *Star Wars* and *Battlestar Galactica*. Twentieth Century-Fox Film Corp. v. MCA, Inc., 715 F.2d 1327 (9th Cir. 1983). Counsel for defendants prepared a short videotape of clips from other science fiction films in an effort to show that the similarities between the disputed works had their origins in the science fiction genre to which both belonged. The defendants won a summary judgment in the trial court, but the Ninth Circuit, after viewing the same videotape, reversed.

131. 379 F.2d 675 (1st Cir. 1967).

132. *Id.* at 678.


e. Idea Equivalent to Expression

Close imitation will also be permitted when the idea and the expression of the idea are virtually indistinguishable. The cases in this category deal uniformly with physical objects: jewelry and toys are the most popular subjects for these motions. For example, a court will refuse to permit a case to go to the jury if the plaintiff's only complaint is that the defendant is marketing a teddy bear that is similar to plaintiff's in the way that all teddy bears resemble each other. Again, the rationale behind such rulings is to prevent a manufacturer from monopolizing the marketplace by claiming rights to elements of expression that are not original.135

f. No-Reasonable-Jury Test

In some cases, courts have granted and affirmed defendants' summary judgment motions because "no reasonable jury, properly instructed, could find the two works are substantially similar."136 This is an extremely vague formulation, and in most cases a court will refer to some concrete elements of the two works to indicate the basis of the opinion.

In Warner Brothers v. ABC,137 the court compared the Superman character from movies, television, and comic books with Ralph Hinkley, the main character of the television sitcom, The Greatest American Hero.138 The court did not focus on any particular variant of the idea/expression dichotomy. Instead, it concentrated on the difference in tone between the two characters.

Superman looks and acts like a brave, proud hero, who has dedicated his life to combating the forces of evil. Hinkley looks and acts like a timid, reluctant hero, who accepts his missions grudgingly and prefers to get on with his normal life. Superman performs his superhuman feats with skill, verve, and dash, clearly master of his own destiny. Hinkley is perplexed by the superhuman powers his costume confers and uses them in a bumbling, comical fashion.139

137. Id.
138. Id. at 231.
139. Id. at 243.
Thus, even though the television show clearly linked Hinkley with Superman through the use of familiar phrases, superhuman abilities, and a costume similar in style, though not in color, to Superman's, the court found that no reasonable jury could find substantial similarity between the characters.140

In another case, an appellate court affirmed the defendant's summary judgment, holding that two plays, *Fear of Acting* and *The Actor's Nightmare*, were not substantially similar.141 The court referred briefly to scène à faire but concentrated mainly on the individual similarities identified by the plaintiff. Both the trial and the appellate courts concluded that "no reasonable trier of fact could find the two plays to be substantially similar."142

140. The Warner Bros. court also ruled that survey results submitted by the plaintiff to show general audience reaction to the two characters not admissible evidence. This seems to cast doubt on the "ordinary observer" test, see supra note 30 and accompanying text, if a court will not admit "survey evidence indicating that some people applying some standard of their own were reminded of one work by the other." Id. at 245. It is difficult to imagine what standard ordinary observers could have applied, other than their reactions.

141. See v. Durang, 711 F.2d 141 (9th Cir. 1983).

g. De Minimis Copying

Courts will also grant summary judgment if the similarities between plaintiff's and defendant's works consist only of an insignificant number of words or phrases, especially if the words and phrases are commonplace expressions. Thus, in Narell v. Freeman, the court found that the coincidence of a few phrases, such as a riverbank "crawling with alligators," was so unremarkable that copying could not be inferred from it.

143. 872 F.2d 907 (9th Cir. 1989).
145. See supra text accompanying notes 87-92.
Although defendants will often concede access to remove what may be a question of fact from a summary judgment motion, defendants have occasionally won summary judgments on this issue. Access has been defined in two ways: actual viewing of plaintiff's work or, now more widely accepted, a "reasonable opportunity" to view it. Proof of access frequently turns on credibility, since defendants usually deny ever having seen the infringed work. If credibility is an important factor, summary judgment cannot be obtained.

Plaintiffs must show more than the "bare possibility" of access and failure to produce some evidence on this point may lead to a summary judgment for defendants. In *Jason v. Fonda*, the plaintiff's book, from which she alleged the movie *Coming Home* was taken, was printed in 1974 and had an extremely limited circulation. She had submitted it to United Artists in 1977, after the film was nearly completed. The court concluded that "the level of availability creates no more than a 'bare possibility' that defendants may have had access to plaintiff's book. In and of itself, such a bare possibility is insufficient to create a genuine issue of whether defendants copied plaintiff's book." In another case, the only evidence plaintiff could offer on defendant's access was the defendant's presence in Washington, D.C. when a copy of the plaintiff's song reposed in the Library of Congress. This was held to be insufficient.

Thus, defendant's counsel should consider carefully before conceding access. If plaintiff contests this issue, an adverse ruling may preclude summary judgment altogether. If, however, the plaintiff's work is sufficiently obscure, a defendant may obtain summary judg-

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150. See supra note 92 and accompanying text.
152. 526 F. Supp. 774.
153. Id. at 776-77.
ment on this issue alone, without reaching the much trickier question of substantial similarity.

II

A Suggested Analytical Method to Determine Substantial Similarity

What may be concluded from this survey? The most obvious conclusion is that the pious intonation that frequently opens the discussion of the law in many summary judgment opinions—that summary judgment is not favored in copyright actions on the issue of substantial similarity—is flatly wrong. On the contrary, summary judgment is overwhelmingly favored on this issue, at least in the reported decisions, and especially where defendants are moving parties. Any hesitation that a party might feel in bringing such a motion, or that a court might feel in granting it on this account, therefore, should be immediately disregarded.

The large percentage of cases granting summary judgments to defendants reveals a distinct factual pattern: an unknown author sues a studio, a famous writer, or a famous star (or all three) for "copying" his work in a well-known movie, television show, or book claiming, "I wrote . . . ." The dismissal of these suits accounts not only for the vast majority of the summary judgment motions granted to defendants but also for the vast majority of summary judgment motions granted to any party on the issue of substantial similarity.

The prevalence of this pattern in the reported opinions suggests that something is out of kilter. Either defense counsel choose the cases that they subject to this test with extreme care and supernatural good fortune, or the law in its present state permits and even encourages the filing of non-meritorious suits. Summary judgment may to some extent stand guard at the threshold, since it obviates the need for a full-dress trial. But because Rule 56 permits, and almost requires, extensive discovery, even a successful motion remains a very expensive proposition.


158. FED. R. CIV. P. 56(c), (e), (f).
Given the vigor with which insurance companies now defend the major studios and publishing houses, the genuine, cold-blooded strike suit probably represents a minority of cases. The typical plaintiff whose infringement action is dismissed on summary judgment is instead someone whom success has eluded, who has poured not only time and energy but considerable self-worth into his work, and who consequently suffers from "that obsessive conviction, so frequent among authors and composers, that all similarities between their works and any others which appear later must invariably be ascribed to plagiarism."160

One fundamental problem may be the connotation of the word "copying" when used in ordinary conversation. To those unfamiliar with copyright law—a group that includes many attorneys—"copying" is an action that is offensive in itself, regardless of what is copied. "Copying" is what happened in school when the student next to you leaned over during a test to look at your answers, then put them down as his answers. The offense was not that he appropriated your original expression; it was that you, presumably, studied for the test while he did not, yet both received the same grade.161

This concept of copying appears to animate both plaintiffs and, sometimes, juries. That is, if a jury can be convinced that a defendant peeked at plaintiff's work, it may find liability even if the only similarities between the two works are non-protectable ideas, scènes à faire, or facts.162 Many plaintiffs base their suits on the premise that if the defendants had some access to their works, liability for copyright infringement is virtually guaranteed. Often such plaintiffs simply cannot understand the difference between an idea and its expression,

159. Rosen, supra note 32, at 1.
161. One way to remedy this confusion between ordinary and legal "copying" among attorneys might be to require a short course in copyright law, perhaps incorporated into a traditional first-year course like torts or property. Although students are often thoroughly instructed in the niceties of such subjects as jurisdiction and conflicts of law in law school, they receive no training in intellectual property unless they take a special class. Most lawyers in civil practice will encounter at least one copyright issue in the course of their careers; they could be instructed in the basic principles in a half-dozen sessions.
162. See, e.g., Olson v. NBC, 855 F.2d 1446 (9th Cir. 1988) (disagreed with by Shaw v. Lindheim, 919 F.2d 1353 (9th Cir. 1990)), in which a judgment notwithstanding the verdict for defendant NBC was affirmed after the jury found that NBC had "copied" plaintiff's work.

This understanding of "copying" probably also accounts for the long life of the "sweat of the brow" theory of copyright infringement, put to rest by the Supreme Court in Feist Publications v. Rural Tel. Serv. Co., 499 U.S. 340 (1991). Under this theory, labor in compiling information was rewarded with copyright protection, regardless of the originality involved in assembling the admittedly uncopyrightable information that went into the compilation.
between trivial detail and central feature. To them it's all of a piece, and it's all theirs.

Obviously the courts would benefit from some means of stopping such plaintiffs from bringing essentially the same suit over and over again. Given, however, the typical plaintiff's idée fixe, nothing any judge says from the bench will otherwise persuade an author who, having written a novel or a script about a torrid romance in Brazil, now believes that torrid romances, and even Brazil, belong to him. The way to stop suits that have no business being filed is to shift the burden of defending them onto the plaintiff and perhaps onto their attorneys, who presumably can read the opinions and the properties more objectively.¹⁶³

Before any burden-shifting can fairly take place, however, clearer outlines of the criteria for determining substantial similarity of protectable expression must be developed. The main problem with summary judgment decisions in this area is their ad hoc character. Of course, as Learned Hand pointed out long ago, to some extent this comes with the territory.¹⁶⁴ Courts have, however, simply resigned themselves to repeating the same formulae about ideas and expression, without seeking to refine the inquiry.

Another vexing problem with summary judgments for literary properties is that one work, usually the defendant's, will often have

¹⁶³. The obvious way to accomplish this objective is a more liberal use of 17 U.S.C. § 505 (1988), which permits the award of attorneys' fees to a prevailing party. In the Ninth Circuit, however, a prevailing defendant can be awarded fees only if it can show that the action was frivolous or brought in bad faith. Jartech, Inc. v. Clancy, 666 F.2d 403, 407 (9th Cir. 1982), cert. denied, 459 U.S. 879 (1983). Prevailing plaintiffs need make no such showing; they may be awarded fees simply because they prevailed. Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc., 886 F.2d 1545, 1556 (9th Cir. 1989), cert. denied, 494 U.S. 1017 (1990).

This is illogical and poor policy; moreover, it grafts a condition onto the statute that Congress could have placed there but did not. Other circuits have refused to restrict defendants' opportunity to obtain their fees. See, e.g., Lieb v. Topstone Indus., Inc., 788 F.2d 151, 154-56 (3d Cir. 1986); Diamond v. Am-Law Pub. Corp., 745 F.2d 142, 148 (2d Cir. 1984); Original Appalachian Artworks, Inc., v. Toy Loft, Inc., 684 F.2d 821, 832 (11th Cir. 1982).

The Ninth Circuit bases this discrimination on the policy of encouraging private enforcement and deterring infringement. Frank Music Corp., 886 F.2d at 1556. While these are worthy policy goals, encouraging vigorous defense and deterring non-meritorious suits are at least equally worthy.

A plaintiff who can find a lawyer willing to work on contingency risks very little by starting an infringement action. Defense counsel, however, must be paid, regardless of the action's merit. A routine award of attorneys' fees under 17 U.S.C. § 505 to prevailing defendants would go far to even the odds. If an attorney was required to counsel a client that he might be liable for defendants' fees if he loses, perhaps fewer "I wrote . . ." suits would appear on district court dockets.

had wide exposure, while the other will be obscure or completely un-
known.\footnote{165} Therefore, even conscientious counsel may have difficulty applying precedents when the “facts” consist of brief plot synopses plus a few general observations about other elements. Without more detailed and specific comparisons, a plaintiff’s lawyer can only guess whether his client’s work resembles those that were shown the door on summary judgment.

Courts have attempted, without much success, to devise “tests” for substantial similarity. But these tests, even when they do not actually increase confusion and muddle the inquiry, have not provided the guidance necessary to separate the sheep from the goats prospectively. Nevertheless, these tests are repeatedly applied, for want of anything else.

A. The Arnstein Test

The court in \textit{Arnstein v. Porter}\footnote{166} developed a three-step, two-prong test for substantial similarity that has been cited often, probably because it alone occupied the field for many years. According to the \textit{Arnstein} method, a trier of fact must determine if there are any similarities.\footnote{167} If there are none, the inquiry ends.\footnote{168} If there are some similarities, and evidence of access, then the trier of fact determines if these “similarities are sufficient to prove copying.”\footnote{169} At this point in the process, “dissection” (analysis of the works’ elements) and expert testimony are appropriate aids.\footnote{170} If copying is established, the trier of fact applies the second prong of the test, the ordinary lay observer test, to determine whether the copying is illicit.\footnote{171} “Dissection and expert testimony are irrelevant [here].”\footnote{172} If the defendant “took from the plaintiff’s works so much of what is pleasing to [the public] that defendant wrongfully appropriated something which belongs to the plaintiff,” then copyright infringement has occurred.\footnote{173}

\footnote{165} There are, however, a few exceptions to this rule, notably the \textit{Star Wars} dispute. Twentieth Century-Fox Film Corp. v. MCA, Inc., 715 F.2d 1327 (9th Cir. 1983) (both \textit{Battlestar Galactica} and \textit{Star Wars} had wide exposure). One court solved this problem by printing the entire texts of the works in controversy in its opinion. Pendleton v. Acuff-Rose Publications, Inc., 605 F. Supp. 477 (D. Tenn. 1984). This effort proved very helpful, though it obviously makes for thicker reporters. However, it is impractical for anything other than brief songs—the works involved here.

\footnote{166} 154 F.2d 464 (2d Cir. 1946). \textit{See supra} notes 78-83 and accompanying text.

\footnote{167} \textit{Arnstein}, 154 F.2d at 468.

\footnote{168} \textit{Id}.

\footnote{169} \textit{Id}.

\footnote{170} \textit{Id}.

\footnote{171} \textit{Id}.

\footnote{172} \textit{Id}.

\footnote{173} \textit{Id} at 473.
This “test” does not lend itself to easy application. The Arnstein court listened to both the plaintiff’s and the defendant’s musical compositions and found similarities.174

But we hold that unquestionably, standing alone, they do not compel the conclusion, or permit the inference, that defendant copied. The similarities, however, are sufficient so that, if there is enough evidence of access to permit the case to go to the jury, the jury may properly infer that the similarities did not result from coincidence.175

According to its own test, enunciated a few paragraphs earlier, “the trier of the facts must determine whether the similarities are sufficient to prove copying.”176 If the appellate court can make that determination based on the record before it, why must there be a trial? Because, says the Arnstein majority, access is a question of fact.177 If the defendant had access to the plaintiff’s compositions, then these similarities, which now are insufficient to prove copying, may be transformed into sufficient similarities.178

This prestidigitation with similarities—now they’re insufficient, now they’re not—and the two-part test were sharply criticized by Judge Clark, the dissenter in Arnstein and a champion of summary judgment.179 Warning that the court’s holding represented “an invitation to the strike suit par excellence,”180 Judge Clark attacked the “anti-intellectual and book-burning nature of [this] decision,”181 which exalted the uninstructed intuition of juries over an informed decision as a matter of law.

I find nowhere any suggestion of two steps in adjudication of this issue, one of finding copying which may be approached with . . . intelligence and assistance of experts, and another that of illicit copying which must be approached with complete ignorance; nor do I see how rationally there can be any such difference, even if a jury . . . could be expected to separate those issues and the evidence accordingly. If there is actual copying, it is actionable, and there are no degrees; what we are dealing with is the claim of similarities sufficient to justify the inference of copying. This is a single deduction to be made intelligently, not two with the dominating one to be made blindly.182

174. Id. at 469.
175. Id.
176. Id. at 468.
177. Id. at 469.
178. Id.
180. Arnstein, 154 F.2d at 479 (Clark, J., dissenting).
181. Id. at 478.
182. Id. at 476 n.1.
B. The Krofft Test

In 1977, Sid and Marty Krofft, puppeteers and producers of children’s television shows, won an appeal upholding a judgment received in a suit against McDonald’s Corporation for using some of the Kroffts’ characters in McDonald’s commercials. In the course of this opinion, the Ninth Circuit enunciated a test, now known as the Krofft test, for substantial similarity. Claiming to build on Arnstein, the Krofft court tried to distinguish between the uncopyrightable “idea” and the copyrightable “expression,” a distinction nowhere mentioned in Arnstein. The Krofft court grafted the two-part Arnstein test onto the idea/expression dichotomy and emerged with the “extrinsic/intrinsic” test.

Briefly stated, the court or trier of fact looks first for similarity of ideas. The Krofft court regarded this as an often simple determination which depends on “specific criteria which can be listed and analyzed.” Analysis and expert testimony are appropriate, as they are in the first step of the Arnstein test. This is the “extrinsic” test.

If the court determines that there is similarity of ideas, it then applies the “intrinsic test.” This test, to determine if expression is similar, depends on the response of the ordinary reasonable person. The court finds this a “more subtle and complex” determination, while forbidding analysis and expert testimony at this point.

Regardless of whether the Ninth Circuit correctly interpreted Arnstein, the test spelled out in Krofft has been criticized for limiting the opportunities for summary judgment. If only similarity of ideas can be decided as a matter of law, then most suits must go to trial.

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183. Sid & Marty Krofft Television Prod. Inc. v. McDonald’s Corp., 562 F.2d 1157 (9th Cir. 1977).
184. Id. at 1165.
185. Id.
186. Id. at 1164.
187. Id.
188. Id.
189. Id.
190. Id.
191. Id.
192. Id. This stricture appears to run afoul of Federal Rule of Evidence 704, which permits expert testimony on “an ultimate issue to be decided by the trier of fact.”

Professor Nimmer objects to this formulation from the opposite viewpoint, that of a plaintiff whose work has been copied. If the theft is clever enough to deceive an ordinary observer, whose ignorance the court carefully cultivates, then a plaintiff whose work is actually appropriated will find himself without remedy. 3 NIMMER, supra note 30, § 13.03[E]. From whatever viewpoint one approaches the ordinary observer test, the premium placed on ignorance is wholly inexplicable.
193. 3 NIMMER, supra note 30, 13.03[E].
because there is usually some similarity of expression between the two works involved.

The most glaring flaw in the Krofft test is its treatment of analysis and expert testimony. The court's formulation seems exactly backwards. Taking the test as the court sets it out, it is clear that neither a court deciding a summary judgment motion nor a trier of fact needs much expert assistance to determine similarity of ideas at the level enunciated in Nichols v. Universal Pictures Corp. Even someone who has spent all his free time watching Oprah and Wheel of Fortune or playing video games can tell if two works are both about the Vietnam War, or if they are both set in outer space, or if both plots involve love triangles. It is with similarity of expression that non-experts need help. How is the court or trier of fact to know, for example, if the traits of a movie character are drawn from a specific novel or are instead part of a stock type? Unless the jury is composed of mystery buffs, how can it tell whether a certain plot twist common to two works is evidence of copying or a moss-covered device? Is a metaphor original or a cliché? Are episodes in a historical novel facts or inventions? Copyright liability turns on such questions, which non-experts cannot answer without a sense of the context that surrounds the two works. This context is what expert testimony should supply; this is what the Krofft test cuts off when it is most needed.

Krofft involved visual figures, and there is a strong argument to be made that it should be limited to its facts: cartoon characters drawn from puppets and used to advertise fast food. It has generated only confusion when applied in other contexts. Courts that have had to deal with these properties after Krofft have, for the most part, tried to modify it, if not completely overhaul it, to arrive at a sensible decision. The court in Berkic v. Crichton, for example, struggled valiantly to apply the test to literary works that were the subject of a summary judgment motion before it:

The test for "substantial similarity of ideas" compares, not basic plot ideas for stories, but the actual concrete elements that make up the total sequence of events and the relationships between the major characters. The extrinsic test for similarity of ideas looks beyond the vague, abstracted idea of a general plot and instead "focuses on . . . the objective details of the work . . . The extrinsic test requires

194. "[T]here is a point in this series of abstractions where they are no longer protected, since otherwise a playwright could prevent the use of his 'ideas,' to which, apart from their expression, his property is never extended." Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930), cert. denied, 282 U.S. 902 (1931), quoted in Sid & Marty Krofft Television Prod. Inc. v. McDonald's Corp., 562 F.2d 1157, 1163 (9th Cir. 1977).

195. 761 F.2d 1289 (9th Cir. 1985).
a comparison of plot, theme, dialogue, mood, setting, pace, and sequence."\(^{196}\)

More recently, in *Shaw v. Lindheim*,\(^{197}\) the court pointed out that now that it includes virtually every element that may be considered concrete in a literary work, the extrinsic test as applied to books, scripts, plays and motion pictures can no longer be seen as a test for mere similarity of ideas. Because the criteria incorporated into the extrinsic test encompass all objective manifestation of creativity, the two tests are more sensibly described as objective and subjective analyses of expression, having strayed from *Krofft*’s division between expression and ideas.\(^{198}\)

One can characterize this state of affairs as “straying” if so inclined, or it can be seen as an effort to be “sensible” while lying in *Krofft*’s Procrustean bed. So much straying or so much effort, however, strongly suggests that something in the opinion was radically flawed in the first place.\(^{199}\)

Both the *Krofft* test and the *Arnstein* test are probably psychologically impossible to apply. Judge Clark alluded to the difficulty juries would have in keeping the issues and the evidence separated as the *Arnstein* majority required.\(^{200}\) Contrary to the representations made in the opinions, both tests require a most extraordinary observer: a total amnesiac. After dissecting the works and listening to expert testimony to determine if there has been copying (*Arnstein*) or similarity of ideas (*Krofft*), the observer must forget what he has discovered or learned in order to apply the part of the test that determines liability, either illicit copying (*Arnstein*) or similarity of expression (*Krofft*).\(^{201}\)

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196. *Id.* at 1293.
197. 919 F.2d 1353 (9th Cir. 1990).
198. *Id.* at 1357.
199. See the discussion of *Krofft*, *Shaw*, and *Feist* in 3 Nimmer, supra note 30, § 13.03[E].
200. 154 F.2d 464, 476 n.1 (2d Cir. 1946) (Clark, J., dissenting).
201. The court in *Midway Mfg. Co. v. Bandai-America, Inc.*, 546 F. Supp. 125 (D.N.J. 1982), also noticed the psychological difficulty involved here. Attempting to apply the teaching of *Universal Athletic Sales v. Salkeld*, 511 F.2d 904 (3d Cir.), *cert. denied*, 423 U.S. 863 (1975), it found itself in the very delicate position of having to identify sufficiently similarities between two works to justify a finding of appropriation without simultaneously making the identification impermissibly detailed so as to constitute forbidden “dissection.” . . . This court . . . will attempt to walk the fine line between the permissible and impermissible in its comparison of the works before it.


The Third Circuit “test,” also purporting to build on *Arnstein*, demonstrates the amazing muddle that results from actually trying to go through this process. After an impenetrable discussion of the *Arnstein* procedure, the *Universal Athletic Sales* court whimsically notes that “[w]hile ‘rose is a rose is a rose is a rose,’ substantial similarity is not always substantial similarity.” 511 F.2d at 907. It is a sad state of affairs if Gertrude Stein is more straightforward than legal analysis.
If these tests were taken seriously, every substantial similarity suit would require two trials, each with different juries.

Although the tests purport to defer to the experience of an "ordinary observer," they, and the opinions that use them, misrepresent the mental processes that a reader or viewer would actually use to arrive at a decision about the similarity of two works. The tests assume that a reader or viewer dissects or analyzes first to see if there are similarities of ideas, then checks the "total concept and feel" for similarity of expression. It is unlikely that anyone's mind in fact works that way. First, the reader or viewer gets an impression of similarity or difference, then, if called upon to do so, analyzes the two works to explain what gave him such an impression.

What actually happens in a summary judgment motion in a copyright infringement suit? First, the judge receives the moving papers. With the moving papers she may also get the two properties, unless she has already received them as exhibits to the complaint. Next, the judge either reads the parties' papers or her clerk's memo about them and, if she has not done so, reads or views the properties. If she reads the papers first, she is already alerted about what to look for in the properties.

The judge reviews the properties one right after the other, or perhaps, with some time intervening between them. But, she does this review in the context of a lawsuit for infringement, not as the last thing before dropping off to sleep or for recreation on the weekend. Consciously or unconsciously, she is therefore looking for similarities. Not surprisingly, she usually finds them. Where it might not occur to her to hold the television show she saw last night in her mind with the novel she read on vacation two years ago, this context compels her to compare them. It is not the context in which the elusive ordinary observer would encounter the two works.203

Both Krofft and Arnstein are psychologically unrealistic because they expect a reader or viewer to hold off making an immediate overall assessment of the two works. Most people asked to compare two works will form an initial impression about them as a whole immediately; they will simply appear similar or dissimilar, without regard to what is protectable and what is not. Only after forming an initial im-

203. It could be argued that a courtroom is never the context in which an ordinary observer would encounter two works. To expect anyone—judge or jury member—to conduct himself or herself as an ordinary observer in such a highly artificial and contrived environment is expecting a great deal.
pression will a reader or viewer look at individual elements and details.

The second step of the analysis is a close study of its major elements. In most fictional works, a few standard elements should be discussed routinely: plot, tone, character, setting, genre, and theme. Depending on the nature of the properties to be compared, other elements might also require analysis. To compare two works, the reader or viewer breaks down each work into these elements and analyzes comparable categories for similarities in protectable expression. This is the obvious place for expert testimony, properly directed. The reader or viewer checks his own analysis against the information provided by experts to be sure that he is not crediting the plaintiff with originating something that actually has its origin elsewhere. At this point, the differences between protectable and non-protectable expression also need emphasis, so the reader or viewer can distinguish between the two.

The final stage requires checking the initial impression against the information gleaned from analysis. Here the reader must put the two processes—one intuitive and the other analytical—together. The previous analysis has necessarily narrowed the focus; now it broadens out to allow him to see the work with each element related to each other and to the whole, with the added caveat that only protectable expression may be considered in determining whether substantial similarity exists. The last step guards against the tendency to pounce on some insignificant detail and find similarity based solely on it.\textsuperscript{204} The reader now checks, and if necessary modifies, his initial "gut" reaction against a reasoned, disciplined investigation of the works' elements and the principles of copyright law.\textsuperscript{205}

This method of analyzing literary properties is much more helpful to both parties and counsel than the present random analysis usually encountered. A lawyer counseling a prospective plaintiff would know what to compare in his client's and the alleged infringer's works. Expert witnesses would know how to structure their testimony. And counsel would have a way of assessing a client's chances of resisting a summary judgment and prevailing at trial or of obtaining a summary judgment.

\textsuperscript{204} This is a tendency much feared, but not often encountered, in summary judgment cases.

\textsuperscript{205} Actually, these neat stages probably falsify the process as much as do Arrstein and Krofft. A constant oscillation between analysis and intuition is more realistic. The reader registers his initial impression, then checks it as he looks at individual elements, modifying both analysis and impression as he proceeds. Opinions that reflected this process, however, would be interminable and, finally, not worth the effort of recording and reading.
The outcomes of such an analysis for summary judgment purposes under the law as it is at present would be variations on a few themes: “When I first looked at these works, I thought they were substantially similar/dissimilar, and now that I have studied them more closely, I still think they are substantially similar/dissimilar in protectable expression.” “When I first looked at these works, I thought they were substantially similar/dissimilar, but now that I have studied them more closely, I realize that they are actually substantially dissimilar/similar in protectable expression.” And finally, “When I first looked at these works, I thought they were similar/dissimilar, but now that I have studied them more closely, I can’t tell whether they are substantially similar/dissimilar in protectable expression or not, so a jury will have to decide.” Structuring a test this way acknowledges that the reviewer will have an initial reaction and builds that reaction into the analysis, so that it operates in the open. The Krofft test forces the initial reaction underground, where it can influence decisions unacknowledged.

Considering the pattern of reported summary judgment decisions, a court would be infrequently called upon to grant a summary judgment to a plaintiff with a literary property. Most of the time, the question before the court is whether the case should be tried or whether the defendant’s motion should be granted. If the court finds substantial similarities in protectable expression in some elements but not others, it probably should deny summary judgment.

III
Conclusion

This Article surveys reported decisions on summary judgment motions that turn on the issue of substantial similarity. It categorizes these decisions by moving and responding party and summarizes the arguments that have proven successful in each category.

The survey reveals that the overwhelming majority of summary judgment cases are decided in favor of moving defendants and that these cases follow a highly predictable pattern. One reason proposed for this imbalance is the inadequacy of substantial similarity tests currently in use, which are so difficult to apply that opinions do not provide the guidance necessary to parties and counsel contemplating a lawsuit for copyright infringement. A different method of comparing literary properties is proposed, one that more accurately reflects the mental processes of a reader or viewer comparing two works.