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# Substantial Similarity in Literary Infringement Cases: A Chart for Turbid Waters

Robert F. Helfing\*

*As home to that fictional piece of real estate known as Hollywood, the Ninth Circuit has dealt with the copyright law issue of substantial similarity more than any other jurisdiction, yet it has not developed useful principles for analyzing it. This article examines the history of the Ninth Circuit's two-step test for substantial similarity in literary infringement cases, showing how a quirk in the evolution of the test has created a confusing and ineffectual body of law on the subject. The article argues that the courts have underestimated the complexity of the issue and have given too much credit to their own judgment, unaided by expert input. The absence of a genuine understanding of the issue has led courts to look for substantial similarity where it cannot be found: in the individual elements of literary works. The article presents a proposed rule to re-direct the court's inquiry from the individual elements of the work, where copyright protection cannot be found, to the artistic structure of the work, where it must be found if it exists at all.*

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## I. INTRODUCTION

“We delve once again,” wrote Ninth Circuit Judge Alex Kozinski in 2002, “into the turbid waters of the ‘extrinsic test’ for substantial similarity under the Copyright Act.”<sup>1</sup> Judge Kozinski had before him a claim of screenplay infringement, where the waters of substantial similarity are especially cloudy. A common sequel to the latest hit motion picture or television series is a lawsuit asserting copyright infringement, almost invariably ending with a pretrial ruling that the plaintiff failed to show substantial similarity as matter of law. In the Ninth Circuit, no type of claim is dismissed with greater regularity or dispatch than those asserting that a popular work of entertainment has infringed a literary copyright: in the past 35 years, Ninth Circuit courts have allowed only three such cases to avoid summary dismissal, and no case has avoided it since 2002.<sup>2</sup> How, then, to explain the unending parade of cases asserting a type of claim that is essentially dead on arrival at the courthouse?

For the plaintiffs, the answer lies in “that obsessive conviction, so frequent among authors and composers, that all similarities between their works and any others which appear later must inevitably be as-

<sup>1</sup> *Metcalf v. Bochco*, 294 F.3d 1070, 1071 (9th Cir. 2002).

<sup>2</sup> *Id.*; *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327, 1328 (9th Cir. 1983); *Shaw v. Lindheim*, 919 F.2d 1353, 1355 (9th Cir. 1990).

cribed to plagiarism.”<sup>3</sup> For the attorneys who take these cases, only part of the answer lies in dreams of headlines and financial reward. The rest can be attributed to the sad fact that the law on the subject is confusing and self-contradictory, lacking clear principles to help lawyers evaluate the merits of the claims presented to them. The same messy precedent that prevents lawyers from effectively evaluating the claims brought to them empowers judges to resolve these claims as a matter of law. Judicial zeal in extinguishing the usually frivolous literary infringement cases has undoubtedly resulted in the elimination of well-grounded ones as well. Without effective guidance, lawyers will continue to file frivolous cases, and judges will continue to dismiss valid ones.

As home to that fictional piece of real estate known as Hollywood, the Ninth Circuit has dealt with the issue more than any other jurisdiction, yet it has not developed useful principles for analyzing it.<sup>4</sup> This article examines the history of the Ninth Circuit’s two-step test for substantial similarity in literary infringement cases, showing how a quirk in the evolution of the test has created a confusing and ineffectual body of law on the subject. The article argues that the courts have underestimated the complexity of the issue and have given too much credit to their own judgment, unaided by expert input. The absence of a genuine understanding of the issue has led courts to look for substantial similarity where it cannot be found: in the individual elements of literary works. The article presents a proposed rule to re-direct the court’s inquiry from the individual elements of the work, where copyright protection cannot be found, to the artistic structure of the work, where it must be found if it exists at all.

## II. THE PROBLEM: WHEN DOES COPYING BECOME INFRINGEMENT?

A copyright is the exclusive right to copy an artistic work; it is infringed when someone who does not possess the copyright copies the work protected by it.<sup>5</sup> This proposition is clear in the utterance but often unclear in the application. The confusion begins with the elusiveness of the definition of copying.

The issue would be simple if, in the dialect of copyright law, the verb “copy” meant what it means most everywhere else: to duplicate an original. But copyright infringement does not require literal dupli-

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<sup>3</sup> *Dellar v. Samuel Goldwyn, Inc.*, 150 F.2d 612, 613 (2d Cir. 1945).

<sup>4</sup> *See Murray Hill Pubs. v. Twentieth Century Fox*, 361 F.3d 312, 317 (6th Cir. 2004).

<sup>5</sup> 17 U.S.C. § 501(a) (2002).

cation; the creation of something equivalent or even similar might do.<sup>6</sup> With literary works,<sup>7</sup> the vagueness of the issue is particularly acute because they consist entirely of language, the most elastic of human creations. A literary work can be effectively reproduced without duplicating a single word of the original.<sup>8</sup> Further, a finding of infringement does not require the “copying” of an entire work: the unauthorized reproduction of only a part of the work, or even of a single element, might be enough.<sup>9</sup> On the other hand, one might duplicate a literary work verbatim, in its entirety, and not infringe.<sup>10</sup>

Where the defendant copies an entire protected work, and the copying is verbatim, a finding of infringement is indisputable. But if the defendant copies less than the entire work, how much copying is needed for there to be infringement? Even more perplexing, what sort of likeness is required if the copying is not verbatim? It is in addressing these questions that the courts have stumbled into uncertainty. They tell us that there must be similarity and that the similarity must be substantial. What sort of similarity is substantial? The answer appears to be likeness in *protected* content.<sup>11</sup> But what is protected?

### III. THE “ABSTRACTIONS TEST”

To be protected, an artistic work must be original, meaning that it is not copied from something else and that it is sufficiently creative.<sup>12</sup> In evaluating creativity, the courts refer to a conceptual dichotomy: ide-

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<sup>6</sup> “[A]n infringement is not confined to literal and exact repetition or reproduction; it includes also the various modes in which the matter of any work may be adopted, imitated, transferred, or reproduced, with more or less colorable alterations to disguise the piracy.” *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F. 2d 354, 360 (9th Cir. 1947) (quoting 18 C.J.S. COPYRIGHT AND LITERARY PROPERTY § 34); *see also* *Sid & Marty Krofft Television v. McDonald’s Corp.*, 562 F.2d 1157, 1167 (9th Cir. 1977) (“Duplication or near identity is not necessary to establish infringement.”).

<sup>7</sup> In this article, “literary works,” will not be used to refer to all works falling within the term as specifically limited by 17 U.S.C. § 102(1), but, rather, more specifically to books, screenplays, plays, motion pictures, television programs, and videogames, i.e., works that are “based on the elements of theme, plot, characters, sequence of events, dialogue, mood, setting, and pace.” *See Gable v. Nat’l Broad. Co.*, 727 F. Supp. 2d 815, 834 n.14 (C.D. Cal. 2010).

<sup>8</sup> *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

<sup>9</sup> *See Harper Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 548-549 (1985) (verbatim copying of 300 to 400 words of book held to infringe); *Situation Mgmt. Sys., Inc. v. Asp. Consulting LLC*, 560 F.3d 53, 59 (1st Cir. 2009).

<sup>10</sup> *See Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 490 U.S. 340, 361 (1991); *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir. 1985) (“It is well established that, as a matter of law, certain forms of literary expression are not protected against copying.”).

<sup>11</sup> *See Cavalier v. Random House*, 297 F.3d 815, 822 (9th Cir. 2002).

<sup>12</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 490 U.S. 340, 345 (1991).

as—in this context, usually described as “mere” ideas—are not protected, while the *expression* of ideas is protected.<sup>13</sup> So, when there are similarities between works, how do we tell whether the similarity is in an idea or in the expression of an idea? In addressing this question in 1930, Judge Learned Hand wrote:

Upon any work . . . a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the [work] is about, and at times might consist of only its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his “ideas,” to which, apart from their expression, his property is never extended.<sup>14</sup>

This language has been called the “abstractions test,”<sup>15</sup> but it describes no test at all. Judge Hand showed us the path that leads from idea to expression, but he proposed no means to identify when the destination is reached. Two decades later, he was equally unspecific in stating the converse—“[N]o one infringes unless he descends so far into what is concrete [in a work] as to invade . . . [its] expression.”<sup>16</sup> Another decade later, he acknowledged the impossibility of specificity, stating:

The test for infringement of a copyright is of necessity vague . . . Obviously, 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>17</sup>

In the five decades since Judge Hand threw up his hands and assigned the issue to the realm of *ad hoc*, no court has attempted to define the point at which idea becomes expression. In 1977, however,

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<sup>13</sup> 17 U.S.C. § 102 (1990) (“[I]n no case does copyright protection for an original work of authorship extend to any idea . . .”); *see also* *Mazer v. Stein*, 347 U.S. 201, 217-18 (1954); *Baker v. Selden*, 101 U.S. 99, 102 (1879).

<sup>14</sup> *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

<sup>15</sup> *Sid & Marty Krofft Television v. McDonald’s Corp.*, 562 F.2d 1157, 1163 (9th Cir. 1977).

<sup>16</sup> *Nat’l Comics Publ’ns v. Fawcett Publ’ns*, 191 F.2d 594, 600 (2d Cir. 1951).

<sup>17</sup> *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

the Ninth Circuit established a framework to analyze the question.

#### IV. THE *KROFFT* TEST OF SUBSTANTIAL SIMILARITY

The history of literary infringement in the Ninth Circuit effectively began in 1977. In *Sid and Marty Krofft Television v. McDonald's Corp.*,<sup>18</sup> the producers of “H. R. Pufnstuff” sued McDonald’s, the restaurant chain, for copyright infringement, claiming that the anthropomorphic hamburgers and other features of its “McDonaldland” television commercials were copied from their animated fantasy program.<sup>19</sup> In reviewing the judgment against defendant McDonald’s, the Ninth Circuit established an analytic framework for evaluating substantial similarity.

The court began by stating the traditional dual elements of infringement: ownership of copyright by the plaintiff and copying by the defendant.<sup>20</sup> It said that the second element, copying, could be established by proof of the defendant’s access to the copyrighted work and substantial similarity between that work and the defendant’s work.<sup>21</sup> In examining prior cases, the Ninth Circuit found that courts had stated those principles as mere “boilerplate” in their opinions.<sup>22</sup> Literally applied, proof of mere access and substantial similarity would produce “untenable results.”<sup>23</sup> As an example, the court noted that the copyright owner of a cheap plaster statue of a nude could readily establish infringement against subsequent manufacturers who had access to it “since most statues of nudes would in probability be substantially similar to the cheaply manufactured plaster one.”<sup>24</sup> “A limiting principle,” stated the court, “is needed.”<sup>25</sup> The court found that limiting principle in the “classic distinction between an ‘idea’ and the ‘expression’ of that idea.”<sup>26</sup> The purpose of this distinction is to reward individual creativity and cultural growth without diminishing the collective right to exploit a copyright owner’s source—the world of ideas. The “real task” in copyright litigation, therefore, is to determine whether the defendant copied the copyrighted work’s expression of an idea or just the idea it-

<sup>18</sup> 562 F.2d 1157 (9th Cir. 1977).

<sup>19</sup> *Id.* at 1161.

<sup>20</sup> *Id.* at 1162.

<sup>21</sup> *Id.*

<sup>22</sup> *Id.*

<sup>23</sup> *Id.*

<sup>24</sup> *Sid and Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1162-63 (9th Cir. 1977).

<sup>25</sup> *Id.* at 1163.

<sup>26</sup> *Id.*

self.<sup>27</sup>

To accomplish that purpose, the *Krofft* court prescribed a two-step test. First, the copyright owner must prove substantial similarity in the ideas of the respective works.<sup>28</sup> The *Krofft* court dubbed this initial step the “extrinsic test.”<sup>29</sup> The test is extrinsic, said the court, “because it depends not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed.”<sup>30</sup> Due to the nature of the test, it was appropriate for courts to dissect the works and to consider expert testimony on the issue.<sup>31</sup> The court stated that the determination was often a simple one, and because the determination was factual, the issue “may often be decided as a matter of law.”<sup>32</sup>

If there is no protection for ideas, why test their similarity at all? The *Krofft* court specifically explained the purpose of its extrinsic test: infringement requires copying in the broad literal sense of the word, that is, that the defendant created the infringing work, at least in part, by duplicating the plaintiff’s copyrighted work. Substantial similarity between the ideas of the works shows copying in that sense.<sup>33</sup>

A showing of literal copying, however, is only part of the proof required for a finding of infringement. In addition, the copying must be unlawful in the sense that it extends to *protected* content—in other words, there must be substantial similarity “not only of general ideas but of the expressions of those ideas as well.”<sup>34</sup> For that determination, the court prescribed an “intrinsic test.”<sup>35</sup> This second step was to be a subjective determination of whether the defendant had “captured the total concept and feel” of the plaintiff’s work, determined by the “response of the ordinary reasonable person.”<sup>36</sup> Similarity of expression is “more subtle and complex” than similarity of ideas,<sup>37</sup> and presents “an issue of fact which a jury is peculiarly fitted to determine.”<sup>38</sup> The court

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<sup>27</sup> *Id.*

<sup>28</sup> *Id.* at 1164.

<sup>29</sup> *Id.*

<sup>30</sup> *Sid and Marty Krofft Television v. McDonald’s Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

<sup>31</sup> *Id.*

<sup>32</sup> *Id.*

<sup>33</sup> *Id.* at 1164-65 (citing *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946)).

<sup>34</sup> *Id.*

<sup>35</sup> *Id.*

<sup>36</sup> *Sid and Marty Krofft Television v. McDonald’s Corp.*, 562 F.2d 1157, 1164-67 (9th Cir. 1977).

<sup>37</sup> *Id.* at 1164.

<sup>38</sup> *Id.* at 1165 (quoting *Arnstein v. Porter*, 154 F.2d 464, 472-473 (2d Cir. 1946)).



also noted that “analytic dissection and expert testimony are not appropriate” to the determination of protected similarity by the intrinsic test.<sup>39</sup>

In *Krofft*, there was no need to consider similarity of ideas under the extrinsic test because defendant McDonald’s conceded that it had copied the idea of the *H. R. Pufnstuf* series.<sup>40</sup> McDonald’s argued, however, that it did not copy protected expression. It attempted to support its position by dissecting the copyrighted series into its constituent parts—specifically, the characters, setting, and plot of its commercials—and by attempting to demonstrate that the corresponding parts of its television commercials were not similar.<sup>41</sup> The Ninth Circuit rejected that approach, stating that it was improper to apply an extrinsic test to determine whether the defendant had copied protected expression of the plaintiff’s work.<sup>42</sup> The court affirmed the finding of infringement, deferring to the jury’s subjective determination that the defendant had copied protected content. As stated by the court, “[t]he more vague the test, the less inclined we are to intervene” with the jury’s determination of this exceedingly vague test.<sup>43</sup>

The purposes and methods of the two-step *Krofft* test, painstakingly described and explained by the Ninth Circuit, would shortly be turned on their collective head.

## V. THE *KROFFT* TEST IGNORED, MISAPPLIED AND TRANSFORMED

### A. *A District Court Shall (Mis)Lead Them . . .*

In the first ruling on a literary infringement claim in the Ninth Circuit after *Krofft*, *Miller v. CBS*, the plaintiff claimed that his three-page treatment was infringed by the television series *Kaz*.<sup>44</sup> The district court dismissed the claim on summary judgment, finding that the common element between the two works consisted of an unprotected element, “the idea of an ex-convict studying law while in prison.”<sup>45</sup> In reaching its decision, the court followed pre-*Krofft* precedent in which district courts in the Ninth and Second Circuits had dismissed claims

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<sup>39</sup> *Id.*

<sup>40</sup> *Id.*

<sup>41</sup> *Id.*

<sup>42</sup> *Sid and Marty Krofft Television v. McDonald’s Corp.*, 562 F.2d 1157, 1165 (9th Cir. 1977).

<sup>43</sup> *Id.* at 1166 (quoting *Williams v. Kaag Mfrs., Inc.*, 338 F.2d 949, 951 (9th Cir. 1964)).

<sup>44</sup> *Miller v. Columbia Broad. Sys., Inc.*, No. CV 78-4291-RMT(Sx), 1980 WL 1179, at \*1 (C.D. Cal. June 5, 1980).

<sup>45</sup> *Id.* at \*3.

based upon the finding that the similarities between the works were limited to ideas.<sup>46</sup> That conclusion directly contradicted the binding precedent of *Krofft*, under which similarity of ideas was precisely what the plaintiff needed to prove in order to *avoid* summary judgment under the extrinsic test. The *Miller* court also dissected the parties' works and analyzed whether there was similarity in protected elements.<sup>47</sup> As we have seen, the district court's means of reaching that determination had been specifically rejected by the Ninth Circuit in *Krofft*, which stated that the issue was for subjective determination by the jury and that analytic dissection was inappropriate.<sup>48</sup> Though issued nearly three years later, the *Miller* opinion makes no reference to *Krofft*.

The next district court to consider a literary infringement claim acknowledged *Krofft* but dismissed the case with an analysis no less contradictory than the one applied in *Miller*. At issue in *Jason v. Fonda*<sup>49</sup> was a claim that the motion picture, *Coming Home*, infringed the copyright in a book written by the plaintiff. Both of the parties' works dealt with "subjects such as morality and the effects of war on women, injured veterans and soldiers."<sup>50</sup> Quoting liberally from the *Krofft* opinion, the court carefully set forth the essential attributes of the test,<sup>51</sup> then it deviated from them. It acknowledged that the determination of substantial similarity involved a two-step inquiry, each fundamentally different in its purpose. Then it analyzed the issue in a single passage without differentiating the two tests.<sup>52</sup> It expressly recognized that the extrinsic test looked for similarity in ideas and not in protected expression. Then it found that the plaintiff had failed to meet the test because the similarities consisted only of ideas and other unprotectable elements.<sup>53</sup> It stated that the intrinsic test was applied, not through analysis of specific objective criteria, but by the subjective response of the ordinary reasonable person. Then it applied the test by dissecting the works into their specific objective criteria.<sup>54</sup> It stated that the intrinsic

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<sup>46</sup> *Id.* at \*4-5. The two cases were *Midas Prods., Inc. v. Baer*, 437 F. Supp. 1388 (C.D. Cal. 1977) and *Bevan v. Columbia Broad. Sys., Inc.*, 329 F. Supp. 601 (S.D.N.Y. 1971).

<sup>47</sup> *Id.* at 506-07.

<sup>48</sup> *Sid and Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1165 (9th Cir. 1977).

<sup>49</sup> 526 F. Supp. 774 (C.D. Cal. 1981).

<sup>50</sup> *Id.* at 777.

<sup>51</sup> *Id.*

<sup>52</sup> *Id.*

<sup>53</sup> *Id.*

<sup>54</sup> *Id.*

test was “uniquely suited for determination by the trier of fact.”<sup>55</sup> Then it dismissed the case, ruling upon the issue as a matter of law.<sup>56</sup>

In only one published opinion would a district court in the Ninth Circuit ever apply the *Krofft* test as set forth in *Krofft*.<sup>57</sup> The approach of the district court in *Jason v. Fonda*—fundamentally different from *Krofft* in almost every respect—would soon become the law of the land.

### B. . . . *And the Ninth Circuit Shall Follow*

The Ninth Circuit would follow the precepts of its own *Krofft* test in only one case. In *Twentieth Century-Fox Film Corp. v. MCA, Inc.*,<sup>58</sup> the court reversed a summary judgment against the plaintiff, who claimed that defendant’s outer space television series, *Battlestar Galactica*, had infringed its copyright in *Star Wars*. With passing mention to *Krofft* (but no analysis), the Ninth Circuit found that reasonable minds could differ on whether thirty four cited similarities between the works were “substantially similar in either idea or expression” and left the issue to the jury.<sup>59</sup> The court added unhelpfully that summary judgment was appropriate only where the parties’ works were “so dissimilar that a claim of infringement is without merit.”<sup>60</sup>

In its decisions published after the *Star Wars* case, the Ninth Circuit would invariably cite *Krofft* and correctly describe the *Krofft* court’s conception of the extrinsic and intrinsic tests, but it would apply the contradictory approach of the district court in *Jason v. Fonda*. Under that framework, seven years would pass before the Ninth Circuit allowed another literary infringement claim to escape summary judgment.

In *Litchfield v. Spielberg*,<sup>61</sup> for instance, the plaintiff claimed that the motion picture, *E.T. the Extra-Terrestrial*, infringed her copyright in *Lokey from Maldemar*, a one-act “musical play” that also involved

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<sup>55</sup> *Jason v. Fonda*, 526 F. Supp. 774, 777 (C.D. Cal. 1981).

<sup>56</sup> The Ninth Circuit affirmed the ruling without analysis. *Jason v. Fonda*, 698 F.2d 966 (9th Cir. 1982).

<sup>57</sup> In *Universal City Studios, Inc. v. Film Ventures Int’l, Inc.*, 543 F. Supp. 1134 (C.D. Cal. 1982), the court issued a preliminary injunction in favor of the producers of the blockbuster movie, *Jaws*, against an alleged knock-off called *Great White*. The court found that the extrinsic test was satisfied by the parties’ stipulation that the underlying ideas of the two movies were the same: “a terror fish attacking a coastal town on the Atlantic seaboard.” *Id.* at 1140.

<sup>58</sup> 715 F.2d 1327 (9th Cir. 1983).

<sup>59</sup> *Id.* at 1329.

<sup>60</sup> *Id.* at 1330.

<sup>61</sup> 736 F.2d 1352 (9th Cir. 1984).

an alien stranded on Earth. The Ninth Circuit affirmed the grant of summary judgment to defendants, finding that the plaintiff had failed to satisfy the extrinsic test as a matter of law. “Viewed in the light most favorable to the plaintiffs,” the court found similarities in what “may be more than stock scenes.”<sup>62</sup> Nonetheless, it found that there was no substantial similarity in the specific criteria examined as part of the extrinsic test. It did not elaborate upon this broad conclusion, except in stating that the similarities of plot “exist only at the general level for which plaintiff cannot claim copyright protection,” citing *Jason v. Fonda* for authority.<sup>63</sup> The court followed *Jason* (though it did not cite it) in ruling that the plaintiff had also failed to satisfy the intrinsic test as a matter of law, finding that “[t]he concept and feel of the works here are completely different.”<sup>64</sup> Passing unmentioned was the fact that, under the *Krofft* formulation of the two-step test, the court was not meant to rule upon the protectability of similarities under the extrinsic test and did not apply the intrinsic test at all. The opinion, however, repeatedly cites *Krofft* and makes no suggestion that it is applying an inconsistent analysis.

The deviation from the *Krofft* test continued without acknowledgment, but grew even more apparent in *Berkic v. Crichton*.<sup>65</sup> Again purporting to follow the *Krofft* formulation, the court found similarities in “general plot ideas” but held that the plaintiff failed to meet the test as a matter of law because “[g]eneral plot ideas are not protected by copyright law . . . .”<sup>66</sup> The court punctuated its inconsistency with the *Krofft* formulation by criticizing the plaintiff’s attorney for arguing that the extrinsic test was satisfied by the similarity of ideas, the very function of the test espoused in *Krofft*.<sup>67</sup>

In the two literary infringement decisions following *Litchfield* and *Berkic*, the Ninth Circuit continued to characterize the extrinsic test as a test of substantial similarity of ideas, but it dismissed literary infringement claims because the plaintiffs failed to show similarity in protected content—in the “concrete elements” of the works.<sup>68</sup> It was only in the next case that the Ninth Circuit recognized—and notified

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<sup>62</sup> *Id.* at 1356.

<sup>63</sup> *Id.* at 1357.

<sup>64</sup> *Id.*

<sup>65</sup> 761 F.2d 1289 (9th Cir. 1985).

<sup>66</sup> *Id.* at 1293.

<sup>67</sup> *Id.* at 1293-94.

<sup>68</sup> *Narell v. Freeman*, 872 F.2d 907, 912 (9th Cir. 1989); *Olson v. Nat’l Broad. Co., Inc.*, 855 F.2d at 1446, 1450 (9th Cir. 1988).

the public—that it had long since departed from *Krofft*.

#### VI. THE CHANGE ACKNOWLEDGED

In *Shaw v. Lindheim*,<sup>69</sup> the Ninth Circuit abandoned any pretense of consistency with *Krofft*. In that case, the plaintiff, a professional television writer and producer, claimed that the television series, *The Equalizer*, infringed the copyright in his script. In applying the extrinsic test, the court specifically acknowledged that it was not the extrinsic test prescribed by *Krofft*, stating, “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.”<sup>70</sup> Instead, said the court, the extrinsic and intrinsic tests “are more sensibly described as objective and subjective analyses of *expression*, having strayed from *Krofft*’s division between expression and ideas.”<sup>71</sup>

The *Shaw* court’s explanation for the deviation from *Krofft* was unsatisfying. The mere fact that the extrinsic test examined the specific, concrete elements of a literary work did not call for a change in its function. Indeed, *Krofft* expressly called for the examination of such elements—or, as the *Krofft* court had called them, “specific criteria”—as the method for examining similarity of ideas.<sup>72</sup> Whatever the reason for the change from *Krofft*’s extrinsic test, however, the deviation was salutary. An inquiry limited solely to similarity of unprotected content—the function of the extrinsic test as conceived by *Krofft*—is unnecessary, as demonstrated by the fact that the courts’ longstanding failure to apply it had not raised even a ripple of attention. It is, however, essential to a finding of copyright infringement that the defendant has copied *protected* content. The original two-part *Krofft* test did not provide a reliable method for reaching that determination. Under *Krofft*, copying of protected content was to be determined through the intrinsic test, based upon the subjective impression of a jury. In applying their subjective impression, however, jurors do not distinguish be-

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<sup>69</sup> 919 F.2d 1353 (9th Cir. 1990).

<sup>70</sup> *Id.* at 1357.

<sup>71</sup> *Id.* (emphasis in original). The court’s language suggests that the deviation from the *Krofft* framework is particular to analyses of literary works. In this context, however, there is no reason to distinguish literary works from other works of art. Indeed, in developing its analysis, the *Shaw* court found it necessary to harmonize its ruling with earlier cases involving plush animals and videogames. *Id.* at 1359-60.

<sup>72</sup> 562 F.2d at 1164. The *Jason v. Fonda* court had, in fact, specifically relied upon that language in identifying plot, theme, dialogue and other components as the concrete elements to be examined. 526 F. Supp. 774, 777 (C.D. Cal. 1981) (quoting *Krofft*’s call for the examination of “specific criteria which can be listed and analyzed”).

tween protected and unprotected matter. *Krofft's* two-step process, therefore, allowed for a finding of infringement even where the defendant had copied nothing but ideas and other unprotectable matter.<sup>73</sup> To avoid that untenable result, a threshold evaluation was needed to assure that the jury is responding at least in part to works that are substantially similar in *protected* content. That assurance is provided by an extrinsic test that dissects and analyzes the points of similarity.

Thus, whether or not the courts that initially evaluated substantial similarity after *Krofft* were aware that they were not faithfully applying that precedent, the change wrought by *Jason v. Fonda* was necessary to correct a serious flaw in *Krofft's* two-step framework. The courts' failure to acknowledge that change, however, created an evolutionary quirk that would install judges as the first, last and only arbiters of substantial similarity in literary infringement cases, a fact that has led to almost unvarying results.

#### VII. LOOKING FOR PROTECTED SIMILARITY IN THE WRONG PLACES

The *Krofft* court expressed its expectation that judges would play a primary role in resolving the extrinsic test by stating that the test "may often be decided as a matter of law."<sup>74</sup> The *Krofft* court, however, was referring to an extrinsic test that addressed only whether there was substantial similarity in ideas and other unprotected content. As we have seen, the test was almost never applied to that purpose but rather has been used by the courts to resolve the more "subtle and complex" issue of whether the works were substantially similar in protected content. Because, however, the transformation of the test was not initially acknowledged, the courts continued to apply the transformed test under some of the procedural directions of *Krofft*. Most notably, the courts continued to rely upon *Krofft* for authority to rule upon substantial similarity in protected content as a matter of law.<sup>75</sup> The result has been a line of cases notable for the consistency of their results: dismissal.

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<sup>73</sup> See *Olson v. Nat'l Broad. Co., Inc.*, 855 F.2d 1446, 1453 (9th Cir. 1988) (quoting *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987)) (stating that, even if a reasonable jury were to find substantial similarity in total concept and feel, there is no infringement "where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas").

<sup>74</sup> *Sid and Marty Krofft Television v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

<sup>75</sup> See, e.g., *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072, 1076 (9th Cir. 2006); *Berkic v. Crichton*, 761 F.2d 1289, 1292 (9th Cir. 1985); *Wild v. NBC Universal, Inc.*, 788 F. Supp. 2d 1083, 1098 (C.D. Cal. 2011); *Bernal v. Paradigm Talent and Literary Agency*, 788 F. Supp. 2d 1043, 1060 (C.D. Cal. 2010).

In evaluating substantial similarity under the extrinsic test, the courts are enjoined to consider only “protectable elements, standing alone.”<sup>76</sup> They must “filter out and disregard the non-protectable elements in making [the] substantial similarity determination.”<sup>77</sup> As applied by most of the courts that have considered the issue, these guidelines leave no chance for a literary infringement claim to satisfy the extrinsic test. Whether described as “specific criteria,”<sup>78</sup> “specific expressive elements,”<sup>79</sup> “actual concrete elements,”<sup>80</sup> or “objective details,”<sup>81</sup> almost none of the components examined under the extrinsic test are, by themselves, entitled to protection. There is no protection for a theme, a setting, a mood, or the pace of a literary work.<sup>82</sup> As to dialogue, protection exists only where it is sufficiently developed or distinctive.<sup>83</sup> Essentially, substantial similarity can be found in dialogue only where the defendant has copied verbatim one or more extended passages.<sup>84</sup>

Absent verbatim copying, character and plot are the only concrete elements that individually present even a potential for protection. As to literary characters, however, the courts tell us that they are “ordinarily” not protected; protection applies only where the bundle of personal attributes that comprise a character is “especially distinctive” or consti-

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<sup>76</sup> *Cavalier v. Random House*, 297 F.3d 815, 822 (9th Cir. 2002) (quoting *Williams v. Crichton*, 84 F.3d 581, 588 (2d Cir. 1985); see also *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1174 (9th Cir. 2003) (“[A] party claiming infringement may place ‘no reliance upon any similarity in expression resulting from unprotectable elements.’” (quoting *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994))).

<sup>77</sup> *Cavalier v. Random House*, 297 F.3d at 822-823.

<sup>78</sup> *Sid and Marty Krofft Television v. McDonald’s Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

<sup>79</sup> *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994).

<sup>80</sup> *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir. 1985).

<sup>81</sup> *Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir. 1984).

<sup>82</sup> See *Reyher v. Children’s Television Workshop*, 533 F.2d 87, 91 (2d Cir. 1976), *cert. denied*, 429 U.S. 980 (1976) (no individual protection for theme); *Williams v. Crichton*, 84 F.3d 581, 589 (2d Cir. 1986) (same regarding pace); *Doody v. Penguin Grp. (USA) Inc.*, 673 F. Supp. 2d 1144, 1159 (D. Haw. 2009); *Anderson v. Stallone*, No. 87-0592 WDKGX, 1989 WL 206431 (C.D. Cal. Apr. 25, 1989) (same regarding theme and mood); *McMahon v. Prentice-Hall, Inc.*, 486 F. Supp. 1296, 1302 (E.D. Mo. 1980) (same regarding “style”); *Alexander v. Haley*, 460 F. Supp. 40, 46 (S.D.N.Y. 1978) (same regarding theme and setting).

<sup>83</sup> 37 C.F.R. § 202.1(a) (2013) (words and short phrases not subject to copyright); *Kitchens of Sara Lee, Inc. v. Nifty Foods Corp.*, 266 F.2d 541 (2d Cir. 1959) (same); *Wild v. NBC Universal, Inc.*, 788 F. Supp. 2d 1083, 1106 (C.D. Cal. 2011) (ordinary words and phrases not protected); *but see Narell v. Freeman*, 872 F.2d 907, 911 (9th Cir. 1989) (same as to “ordinary” phrases, but “original” phrase may be protected).

<sup>84</sup> See *Olson v. Nat’l Broad. Co., Inc.*, 855 F.2d 1446, 1450 (9th Cir. 1988).

tutes the “story being told.”<sup>85</sup> In fact, even those stringent conditions do not fully describe the difficulty of securing protection for literary characters; as a practical matter, protection is given only where a character is not only highly developed and distinctive, but also is the central feature of an extended series of literary works.<sup>86</sup> Even then, protection may be denied.<sup>87</sup>

No Ninth Circuit court applying the extrinsic test has found substantial similarity in the element of plot, though it is here that protection would most likely be found. In this context, plot means more than the general idea of the work. There is no protection for boy-meets-girl, or big-ape-from-forbidden-island-comes-to-New York-and-gets-shot-off-skyscraper-by-biplanes. These are “mere plot ideas,” and, as the courts often remind us, there is no protection for a plot idea.<sup>88</sup> Protection for plot may be provided only to “the ‘sequence of events by which the author expresses his theme or idea’ in sufficiently concrete terms . . . .”<sup>89</sup> In examining plot, however, the courts generally do not make a meaningful analysis of the “sequence of events.” Instead, they dissect the sequence of events into its own individual elements, then filter out each one as an unprotectable idea or scenes à faire—that is, stock scenes that “flow naturally” from the premise of the work.<sup>90</sup>

This process of reduction leaves nothing to satisfy the extrinsic test. “Lest ‘every song [be] merely a collection of basic notes, every painting a derivative work of color and stroke, and every novel merely an unprotected jumble of words,’ a court cannot assess the originality of a work solely from the originality of the individual component parts.”<sup>91</sup>

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<sup>85</sup> *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1175 (9th Cir. 2003); *Olson v. Nat’l Broad. Co., Inc.*, 855 F.2d at 1446, 1452 (9th Cir. 1988).

<sup>86</sup> *See Metro-Goldwyn-Mayer v. Am. Honda Motor Co.*, 900 F. Supp. 1287 (C.D. Cal. 1995) (*James Bond*); *Anderson v. Stallone*, No. 87-0592 WDKGX, 1989 WL 206431 (C.D. Cal. Apr. 25, 1989) (*Rocky Balboa*); *Toho Co. v. William Morrow & Co.* 33 F. Supp. 2d 1206 (C.D. Cal. 1998) (*Godzilla*).

<sup>87</sup> *See Warner Bros. Pictures Inc. v. Columbia Broad. Sys.*, 216 F.2d 945, 950 (9th Cir. 1954) (*Sam Spade*).

<sup>88</sup> *See Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir. 1985); *Bernal v. Paradigm Talent and Literary Agency*, 788 F. Supp. 2d 1043, 1066 (C.D. Cal. 2010).

<sup>89</sup> *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124, 1135 (C.D. Cal. 2007).

<sup>90</sup> *See, e.g., Cavalier v. Random House*, 297 F.3d 815, 824 (9th Cir. 2002); *Berkic*, 761 F.2d at 1293.

<sup>91</sup> *Diamond Direct, LLC v. Star Diamond Grp., Inc.*, 116 F. Supp. 2d 525, 528 (S.D.N.Y. 2000) (quoting *Yurman Design Inc., v. PAJ, Inc.*, 93 F. Supp. 2d 449, 457 (S.D.N.Y. 2000)); *see also Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003 (2d Cir. 1995) (“[I]f we took this argument to its logical conclusion, we might have to decide that ‘there can be no originality in painting, because all colors of paint have been used somewhere in the past.’”).



When the courts carve literary works down to their molecules, they are looking for protected similarity where it does not exist. What, then, is the appropriate object of inquiry under the extrinsic test? The answer was provided at the very beginning of the substantial similarity saga.

#### VIII. PROTECTION IN THE UNPROTECTED

In *Krofft*, the Ninth Circuit rejected the use of analytic dissection in determining the existence of protected similarity. The Court explained:

Lest we fall prey to defendants' invitation to dissect the works, however, we should remember that it is the combination of many different elements which may command copyright protection because of its particular subjective quality. "While any one similarity taken by itself seems trivial, I cannot say at this time that it would be improper for a jury to find that the overall impact and effect indicate substantial appropriation."<sup>92</sup>

This critical principle was promptly disregarded, the extrinsic test was transformed and, applying the *Jason v. Fonda* analysis, Ninth Circuit courts proceeded to dissect literary works, looking for protected similarity in their elemental units. For more than 12 years following *Krofft*, the Ninth Circuit applied that divergent analysis in every case but one, *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, the *Star Wars* case.<sup>93</sup> It is no coincidence that the *Star Wars* case was also the only case during that period in which the court reversed the summary judgment of a literary infringement claim. The court did not disclose the method it applied, stating only that reasonable minds could differ upon whether there was substantial similarity in a list of thirty-four similarities cited by the plaintiff.<sup>94</sup> There is every reason to believe, however, that had the court done nothing more examine each of the thirty-four similarities for individual protectability, the dismissal would have been affirmed.

The next time the Ninth Circuit would restore a literary infringement claim from dismissal, the court left no doubt that its holding was based upon the potential protectability, not of any individual element,

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<sup>92</sup> Sid and Marty Krofft Television v. McDonald's Corp., 562 F.2d 1157, 1169 (9th Cir. 1977) (citations omitted) (quoting Malkin v. Dubinsky, 146 F. Supp. 111, 114 (S.D.N.Y. 1956)).

<sup>93</sup> 715 F.2d 1327 (9th Cir. 1983) (the *Star Wars* case, discussed *supra*).

<sup>94</sup> *Id.* at 1329.

but of a combination of elements. The case was *Shaw v. Lindheim*,<sup>95</sup> involving *The Equalizer* series. In applying the extrinsic test, the Ninth Circuit stated that, although no similar plot element in the works at issue was “remarkably unusual in and of itself, the fact that both scripts contain all of these similar events gives rise to a triable question of substantial similarity of protected expression.”<sup>96</sup> Quoting a treatise and a 50-year-old Second Circuit case, the court stated, “Where plot is . . . properly defined as the sequence of events by which the author expresses his ‘theme’ or ‘idea,’ it constitutes a pattern which is sufficiently concrete so as to warrant a finding of substantial similarity if it is common to both plaintiff’s and defendant’s works.”<sup>97</sup>

One year later, the Supreme Court recognized the principle. In *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*,<sup>98</sup> the court stated that copyright protection applied to an original “selection and arrangement” of the decidedly unprotectable individual elements of a telephone directory. The Ninth Circuit adopted the *Feist* language, first applying it in a case involving the alleged infringement of a computer display.<sup>99</sup> By the year 2000, the principle was so entrenched that, without even citing *Feist* or any case applying its language, the Ninth Circuit declined to reverse a jury’s determination of musical infringement because it was “well settled that a jury may find a combination of unprotectable elements to be protectable under the extrinsic test . . . .”<sup>100</sup> The Ninth Circuit, however, did *not* apply the principle in either of the two literary infringement cases presented to it in the twelve years following *Feist*.<sup>101</sup> The omission was particularly conspicuous in the second of those cases, where the court expressly considered the “selection and arrangement” of similar elements in analyzing whether the defendant had infringed the graphic content of the plaintiff’s work but not in analyzing the literary content.<sup>102</sup>

Then came *Metcalf v. Bochco*.<sup>103</sup>

<sup>95</sup> 919 F.2d 1353 (9th Cir. 1990).

<sup>96</sup> *Id.* at 1363.

<sup>97</sup> *Id.* (internal quotes omitted) (quoting MELVILLE NIMMER, NIMMER ON COPYRIGHT § 1303[A], at 13-31 (1989) and *Shipman v. RKO Pictures, Inc.*, 100 F.2d 533, 537 (2d Cir. 1938)).

<sup>98</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 490 U.S. 340, 349 (1991).

<sup>99</sup> *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994).

<sup>100</sup> *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 2000).

<sup>101</sup> *Cavalier v. Random House*, 297 F.3d 815, 824 (9th Cir. 2002); *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1043, 1043 (9th Cir. 1994).

<sup>102</sup> *Cavalier*, 297 F.3d at 825-826.

<sup>103</sup> *Metcalf v. Bochco*, 294 F.3d 1070, 1071 (9th Cir. 2002).

## IX. THE COURT GETS IT RIGHT

In 2000, a novice husband-and-wife screenwriting team named Jerome and Laurie Metcalf asserted that famed television producer/writer Steven Bochco had infringed their unsold television scripts with his short-lived television series, *City of Angels*. The district court dismissed their claim for lack of substantial similarity, but, for only the third time since the adoption of the two-part test in 1977, the Ninth Circuit reversed.

On appeal, the Metcalfs relied upon similarities in setting (an overburdened county hospital in Los Angeles with a mostly black staff), characters (a young, handsome black surgeon, raised in the hospital community, and romantically involved with a thirtyish, formerly married, childless, career-oriented hospital administrator), theme (the surgeon's struggle between the emotional rewards of a county hospital position and a more lucrative private practice) and plot (a pivotal kiss; an equally consequential incident of seeming infidelity between the surgeon and his former love interest, witnessed by the current love interest; a challenge to the hospital's accreditation by a Hispanic politician).<sup>104</sup> The court acknowledged that none of these similarities were protectable "when considered individually."<sup>105</sup> They were "either too generic or constitute 'scenes à faire'."<sup>106</sup> The court nonetheless found a genuine issue of substantial similarity, stating that "the presence of so many generic similarities and the common patterns in which they arise do help the Metcalfs satisfy the extrinsic test."<sup>107</sup> The court noted that an original selection and arrangement of elements may itself be protectable, even where protection did not exist for any of those elements individually.<sup>108</sup> In justifying its ruling, the court quoted *Shaw v. Lindheim* in finding that "the totality of the similarities . . . goes beyond the necessities of the . . . theme and belies any claim of literary accident."<sup>109</sup>

In reaching its conclusion, the *Metcalf* court had inquired past the point where almost all previous courts had prematurely stopped, applying an extrinsic test based upon *Feist* and illuminated by *Krofft* and *Shaw*. *Metcalf* offered an analytic corrective to the benighted body of precedent, presenting an approach appropriately directed to the struc-

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<sup>104</sup> *Id.* at 1073-74.

<sup>105</sup> *Id.* at 1074.

<sup>106</sup> *Id.*

<sup>107</sup> *Id.*

<sup>108</sup> *Metcalf v. Bochco*, 294 F.3d 1070, 1071 (9th Cir. 2002).

<sup>109</sup> *Id.*

ture of the works rather than to their individual elements.

In the twelve years following its publication, the case has been all but rejected outright.

#### X. THE NEGATION OF *METCALF V. BOCHCO*

Since *Metcalf v. Bochco*, courts in the Ninth Circuit have applied the extrinsic test to literary infringement claims in nearly thirty cases.<sup>110</sup> In every one, at each level, the courts have found that the plaintiff failed to meet the test as a matter of law. In the opinions supporting these dismissals, the *Metcalf* decision has been mischaracterized, distinguished or simply ignored.

In *Rice v. Fox Broadcasting Co.*,<sup>111</sup> the first such case considered by the Ninth Circuit, the court distinguished *Metcalf* in its finding that the result in *Metcalf* had depended upon application of the “inverse-ratio rule.”<sup>112</sup> The *Metcalf* opinion does not support that reading. Un-

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<sup>110</sup> See *Mandeville-Anthony v. Walt Disney Co.*, 474 F. App'x. 651, 652 (9th Cir. 2012); *Radin v. Hunt*, 499 F. App'x. 684, 685 (9th Cir. 2012); *Benay v. Warner Bros. Entm't, Inc.*, 607 F.3d 620, 624 (9th Cir. 2009); *Mestre v. Vivendi Universal U.S. Holding Co.*, 273 F. App'x. 631, 632 (9th Cir. 2008); *Lassiter v. Twentieth Century Fox Film Corp.*, 238 F. App'x. 194, 195 n.3 (9th Cir. 2007); *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072, 1077 (9th Cir. 2006); *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1174 (9th Cir. 2003); *Quirk v. Sony Pictures Entm't*, No. C 11-3773 RS, 2013 WL 1345075, at \*4 (N.D. Cal. Apr. 2, 2013); *Kennedy v. Paramount Pictures Corp.*, Civil No. 12cv372-WQH-WMc, 2013 WL 1285109, at \*4 (S.D. Cal. Mar. 27, 2013); *Schkeiban v. Cameron*, No. CV 12-0636-R (MANx), 2012 WL 5636281 at \*2 (C.D. Cal. Oct. 4, 2012); *Coble v. Renfroe*, No. C11-0498 RSM, 2012 WL 503860, at \*3 (W.D. Wa. Feb. 15, 2012); *Goldberg v. Cameron*, 787 F. Supp. 2d 1013, 1019 (N.D. Cal. 2011); *Wild v. NBC Universal, Inc.*, 788 F. Supp. 2d 1083, 1098 (C.D. Cal. 2011); *Buggs v. Dreamworks, Inc.*, No. CV 09-07070 SJO (AGRx), 2010 WL 5790251, at \*4 (C.D. Cal. Dec. 28, 2010); *Clements v. Screen Gems, Inc.*, No. CV10-220-R (JEMx), 2010 WL 5174376, at \*3 (C.D. Cal. Dec. 13, 2010); *Bissoo-Dath v. Sony Computer Entm't Am., Inc.*, 694 F. Supp. 2d 1071, 1079 (N.D. Cal. 2010); *Bernal v. Paradigm Talent and Literary Agency*, 788 F. Supp. 2d 1043, 1059 (C.D. Cal. 2010); *Gable v. Nat'l Broad. Co.*, 727 F. Supp. 2d 815, 831 (C.D. Cal. 2010), *aff'd*, 438 F.App'x. 587, 588 (9th Cir. 2011); *Doody v. Penguin Grp. (USA) Inc.*, 673 F. Supp. 2d 1144, 1154 (D. Haw. 2009); *Gilbert v. New Line Prods., Inc.*, No. CV 09-02231 RGK (RZx), 2009 WL 7422458, at \*2 (C.D. Cal. Nov. 16, 2009); *Rosenfeld v. Twentieth Century Fox*, No. CV 07-7040 AHM (FFMx), 2009 WL 212958, at \*2 (C.D. Cal. Jan. 28, 2009); *Capcom Co. v. MKR Grp., Inc.*, No. C 08-0904 RS, 2008 WL 4661479, at \*5 (N.D. Cal. Oct. 20, 2008); *Walker v. Viacom Int'l, Inc.*, No. C 06-4931 SI, 2008 WL 2050964, at \*5 (N.D. Cal. May 13, 2008); *Milano v. NBC Universal, Inc.*, 584 F. Supp. 2d 1288, 1294 (C.D. Cal. 2008); *Thomas v. Walt Disney Co.*, No. C-07-4392 CW, 2008 WL 425647, at \*2 (N.D. Cal. Feb. 14, 2008); *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124, 1138 (C.D. Cal. 2007); *Benjamin v. Walt Disney Co.*, No. CV 05-2280GPS, 2007 WL 1655783, at \*4 (C.D. Cal. Jun. 5, 2007); *Identity Arts v. Best Buy Enter. Serv. Inc.*, Nos. C 05-4656 PJH, C 06-1631 PJH, 2007 WL 1149155, at \*8 (N.D. Cal. Apr. 18, 2007); *Bethea v. Burnett*, No. CV04-7690JFWPLAX, 2005 WL 1720631, at \*2 (C.D. Cal. June 28, 2005).

<sup>111</sup> *Rice*, 330 F.3d 1170 (9th Cir. 2003).

<sup>112</sup> *Id.* at 1179; *see also Bethea*, 2005 WL 1720631 at \*15.

der the inverse-ratio rule, the degree of similarity required to establish infringement stands in inverse proportion to the degree of access shown—the more access shown, the less similarity required.<sup>113</sup> In *Metcalf*, the court did state that the plaintiff's case was "strengthened considerably" by Bochco's concession of access.<sup>114</sup> The court did not suggest, however, that its reversal of summary judgment depended upon the concession of access, let alone that protection for a combination of unprotected elements depended upon that concession. To the contrary, by that point in the opinion, the court had already found that the "totality" of the similarities confirmed that they were attributable to copying and that their "cumulative weight" allowed the Metcalfs to survive summary judgment.<sup>115</sup> The court's comment that the plaintiffs' case was strengthened by Bochco's concession of access appears as an afterthought, representing the court's reflection on how the trier of fact might ultimately decide the ultimate issue of substantial similarity after remand to the district court.<sup>116</sup> It will be recalled that the ruling in *Metcalf* was grounded upon *Feist*'s "selection and arrangement" principle. Although the defendant in that case undoubtedly had access to the plaintiff's work,<sup>117</sup> the Supreme Court said nothing in *Feist* to suggest that the application of its principle depended upon heightened proof of access, let alone an express concession. If an original selection and arrangement of unprotected elements is entitled to protection at all, no reason appears that a plaintiff must satisfy the element of access with proof anything more than the standard level of evidence.<sup>118</sup>

In distinguishing *Metcalf v. Bochco*, the *Rice* court did not rely solely upon the inverse-ratio rule. It also noted that the works at issue did not present "the same pattern of generic similarities as in *Metcalf*."<sup>119</sup> The court, however, did not explain what pattern that might be. In two subsequent unpublished decisions, the Ninth Circuit again attributed a sort of self-evident significance to the similarities re-

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<sup>113</sup> See, e.g., *Shaw v. Lindheim*, 919 F.2d 1353, 1361 (9th Cir. 1990).

<sup>114</sup> *Rice*, 330 F.3d at 1179. In moving for summary judgment, Bochco and the other defendants had not, in fact, conceded access; they merely stated that they were not disputing it for purposes of their motion.

<sup>115</sup> *Metcalf v. Bochco*, 294 F.3d 1070, 1074 (9th Cir. 2002).

<sup>116</sup> *Id.* at 1075.

<sup>117</sup> See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 490 U.S. 340, 361 (1991).

<sup>118</sup> Cases applying the selection and arrangement rule in non-literary infringement claims have not referred to any such requirement. See, e.g., *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, 345 F.3d 1140, 1146-47 (9th Cir. 2003) (sculpture); *Satava v. Lowry*, 323 F.3d 805, 811-12 (9th Cir. 2003) (sculpture); *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994) (computer graphical user interface).

<sup>119</sup> *Rice*, 330 F.3d at 1179.

cited in *Metcalf*, avoiding meaningful analysis to support the conclusion that the unprotected similarities in the works before them did not attain that level.<sup>120</sup>

A few opinions have added the comment that the similarities did not constitute a protectable selection and arrangement because they were “random.”<sup>121</sup> There was, however, no want of significant similarities between the works at issue in the next published Ninth Circuit opinion to analyze a literary infringement claim, and they were anything but random.

The plaintiff in *Funky Films v. Time Warner Entertainment Co.*<sup>122</sup> was another industry outsider who asserted that acclaimed television series *Six Feet Under* infringed the copyright in her screenplay, *The Funk Parlor*. The similarities cited by the court were extensive. Both works centered upon a small funeral home and the lives of the family members who operated it. Both were set in motion by the sudden death of the father, who had run the funeral home for decades. In both works, the older son, decidedly heterosexual, has long ago moved out of town and maintained no involvement in the family business, while the younger son, homosexual, has remained behind to assist his father in running it. After the father’s death, the two sons inherit the business, which is deeply in debt and operating from a deteriorating facility with obsolete equipment, including a malfunctioning hearse. Initially, the older brother wants no part of the business and announces his intention to sell it. He changes his mind, however, after the overbearing female head of a rival funeral home attempts to force the brothers to accept a low-ball offer to purchase given at the father’s funeral. The brothers manage to fend off the competitor and keep the business afloat, in part by the unconventional methods of the older brother.<sup>123</sup>

Describing these similarities as merely “apparent,” the Court stated that there were few “real” similarities.<sup>124</sup> In the analysis that followed,

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<sup>120</sup> *Gable v. Nat’l Broad. Co.*, 727 F. Supp. 2d 815, 831 (C.D. Cal. 2010); *Mestre v. Vivendi Universal U.S. Holding Co.*, 273 F. App’x 631, 632 (9th Cir. 2008). Some district courts have taken the same tack. *See Buggs v. Dreamworks, Inc.*, No. CV 09-07070 SJO (AGR), 2010 WL 5790251, at \*4 (C.D. Cal. Dec. 28, 2010); *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124, 1138 (C.D. Cal. 2007) (“[M]any courts have been reluctant to expand [the *Metcalf* rule] beyond the clear-cut case in *Metcalf*.”).

<sup>121</sup> *Buggs*, 2010 WL 5790251 at \*7; *Bernal v. Paradigm Talent and Literary Agency*, 788 F. Supp. 2d 1043, 1067 (C.D. Cal. 2010); *Zella*, 529 F. Supp. 2d at 1138; *Bethea v. Burnett*, No. CV04-7690JFWPLAX, 2005 WL 1720631, at \*14 (C.D. Cal. June 28, 2005).

<sup>122</sup> *Funky Films, Inc. v. Time Warner Entm’t Co.*, 462 F.3d 1072, 1075 (9th Cir. 2006).

<sup>123</sup> *See id.* at 1075-78.

<sup>124</sup> *Id.* at 1078.

however, the court did not deny that the cited similarities were elements of setting, plot, sequence of events, character, and theme that formed a “selection and arrangement” at least as numerous and structurally related as those of *Metcalfe*. Further, the court did not deny that the “totality” of those similarities went “beyond the necessities of defendant’s theme” or that it “belied any claim of literary accident,” factors that the *Metcalfe* court found significant.<sup>125</sup> The court simply avoided any discussion at all of the similarity in the selection and arrangement of unprotected elements between the parties’ works. Although the court cited *Metcalfe* for unrelated points,<sup>126</sup> it made no reference to the central concept of that case, despite the fact that the plaintiffs had relied upon it as the basis of their appeal. The next Ninth Circuit case to apply the extrinsic test to a literary infringement claim did not refer to *Metcalfe* at all, let alone address the selection and arrangement principle.<sup>127</sup>

Following the example set by the Ninth Circuit, approximately half of the district courts applying the extrinsic test have cited *Metcalfe* only for principles other than the protectability of a combination of unprotected elements, or have ignored the case altogether.<sup>128</sup> No case following *Metcalfe* has found protection in the selection and arrangement of unprotectable similarities. Indeed, after the single interruption of *Metcalfe*, the courts have continued the virtually automatic rejection of literary infringement claims under extrinsic test scrutiny. They do so, in part, by doggedly dissecting works to reach the continually renewing

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<sup>125</sup> *Metcalfe v. Bochco*, 294 F.3d 1070, 1070 (9th Cir. 2002).

<sup>126</sup> The published opinion in *Funky Films* cites *Metcalfe* only in support of the court’s reference to an unrelated rule and in rejecting the plaintiffs’ invocation of the inverse-ratio rule. 462 F.3d at 1077, 1081 n.4.

<sup>127</sup> *Benay v. Warner Bros. Entm’t, Inc.*, 607 F.3d 620, 624 (9th Cir. 2009).

<sup>128</sup> See *Mandeville-Anthony v. Walt Disney Co.*, 474 F. App’x 651, 652 (9th Cir. 2012); *Radin v. Hunt*, 499 F. App’x 684, 684 (9th Cir. 2012); *Lassiter v. Twentieth Century Fox Film Corp.*, 238 F. App’x 194, 195 (9th Cir. 2007); *Quirk v. Sony Pictures Entm’t*, No. C 11-3773 RS, 2013 WL 1345075, at \*4 (N.D. Cal. Apr. 2, 2013); *Kennedy v. Paramount Pictures Corp.*, Civil No. 12cv372-WQH-WMc, 2013 WL 1285109, at \*4 (S.D. Cal. Mar. 27, 2013); *Schkeiban v. Cameron*, No. CV 12-0636-R (MANx), 2012 WL 5636281 at \*2 (C.D. Cal. Oct. 4, 2012); *Coble v. Renfro*, No. C11-0498 RSM, 2012 WL 503860, at \*3 (W.D. Wa. Feb. 15, 2012); *Wild v. NBC Universal, Inc.*, 788 F. Supp. 2d 1083, 1098 (C.D. Cal. 2011); *Goldberg v. Cameron*, 787 F. Supp. 2d 1013, 1019 (N.D. Cal. 2011); *Clements v. Screen Gems, Inc.*, No. CV10-220-R (JEMx), 2010 WL 5174376, at \*3 (C.D. Cal. Dec. 13, 2010); *Bissoon-Dath v. Sony Computer Entm’t Am., Inc.*, 694 F. Supp. 2d 1071, 1079 (N.D. Cal. 2010); *Rosenfeld v. Twentieth Century Fox*, No. CV 07-7040 AHM (FFMx), 2009 WL 212958, at \*2 (C.D. Cal. Jan. 28, 2009); *Walker v. Viacom Int’l, Inc.*, No. C 06-4931 SI, 2008 WL 2050964, at \*5 (N.D. Cal. May 13, 2008); *Thomas v. Walt Disney Co.*, No. C-07-4392 CW, 2008 WL 425647, at \*2 (N.D. Cal. Feb. 14, 2008); *Benjamin v. Walt Disney Co.*, No. CV 05-2280GPS, 2007 WL 1655783, at \*4 (C.D. Cal. Jun. 5, 2007); *Identity Arts v. Best Buy Enter. Serv. Inc.*, Nos. C 05-4656 PJH, C 06-1631 PJH, 2007 WL 1149155, at \*8 (N.D. Cal. Apr. 18, 2007).

discovery that the individual elements of similarity are not entitled to protection. Following *Funky Films*, however, they have increasingly come to justify the dismissals upon grounds having no place in the extrinsic test analysis.

#### XI. THE WEIGHT OF DIFFERENCES

In *Funky Films*, the court recited at length the similarities between the parties' works.<sup>129</sup> It then observed that, while "at first blush" they appeared significant, "an actual reading of the two works reveals greater, more significant differences . . . ."<sup>130</sup> Unmistakably, the court's finding that the works lacked substantial similarity was based principally upon that determination.<sup>131</sup> Usually supported by reference to *Funky Films*, subsequent courts have adopted that rationale in dismissing literary infringement claims.<sup>132</sup> Differences between the works, however, carry no weight in the extrinsic test analysis.

With literary infringement claims, it is often the case that the defendant has developed the allegedly infringing work far beyond the scope of the plaintiff's copyrighted work.<sup>133</sup> As a result, there will necessarily be numerous differences between the works at issue. But just as unprotected similarities are filtered out of the extrinsic test analysis, the same rule should apply to differences. The role of the extrinsic test is solely to determine whether there is substantial similarity in protected content; where it exists, the test is satisfied, irrespective of the number or relative weight of differences. As noted by the Second Circuit,

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<sup>129</sup> 462 F.3d at 1077-78.

<sup>130</sup> *Id.* at 1078.

<sup>131</sup> Most of the court's analysis of substantial similarity was devoted to describing those differences. *Id.* at 1078-81.

<sup>132</sup> See *Benay*, 607 F.3d at 625 ("many more differences than similarities"); *Lassiter*, 238 F. App'x. at 195 ("significant differences and few real similarities"); *Coble*, 2012 WL 503860, at \*3 ("greater, more significant differences"); *Wild*, 788 F. Supp. 2d at 1109 ("[o]ne cannot imagine how two works could be substantially similar without a story that focuses on the actions of similar characters"); *Goldberg*, 787 F. Supp. 2d at 1021 (the works "tell fundamentally different stories"); *Clements*, 2010 WL 5174376, at \*3 ("many more differences than similarities"); *Bernal*, 788 F. Supp. 2d at 1068 (the differences "are vastly more substantial than the similarities"); *Gable*, 727 F. Supp. 2d at 842 (the "similarities pale in comparison" to differences); *Gilbert*, 2009 WL 7422458, at \*3 (the similarities "pale in comparison to vast differences" between the works).

<sup>133</sup> In *Metcalfe v. Bochco*, the plaintiffs claimed that the copyrights in their film treatment and two screenplays were infringed by the defendants' television series consisting of 21 hour-long episodes. 294 F.3d 1070, 1071-72 (9th Cir. 2002). In *Funky Films*, the plaintiffs asserted that their single screenplay was infringed by a sixty-one-episode series. 462 F.3d 1072, 1075-76 (9th Cir. 2006).



“No plagiarist can excuse the wrong by showing how much of his work he did not pirate.”<sup>134</sup> Thus, if, for instance, the defendant copied verbatim a chapter of plaintiff’s 40-chapter book, it would not matter that the other 39 chapters show no similarity at all, or that the similarities of that single chapter are outweighed by the differences of the others, either in number or in significance. The only question necessary to address in this scenario is whether the copied chapter is entitled to protection; if it is, then the extrinsic test is satisfied. Differences are relevant only where the plaintiff mischaracterizes elements of the works to create an illusion of similarity; in that circumstance, an objective analysis should point out the differences in those elements to demonstrate that the claimed similarity is not similarity at all. In themselves, however, differences between the works are irrelevant to the extrinsic test.

Differences do play a role in the *intrinsic* test, probably a determinative one. If differences overwhelm the impression of copying created by protected similarity, then the infringement claim will fail at the second step of the substantial similarity analysis because the defendant’s work has not “captured the total concept and feel” of the copyrighted work.<sup>135</sup> Indeed, the courts’ current emphasis upon differences appears to be the legacy of early decisions in which they mistakenly ruled upon the intrinsic test as a matter of law.<sup>136</sup> It was, here again, the *Shaw v. Lindheim* court that pointed out that the courts had taken a detour, reminding us that, because intrinsic similarity was measured by the response of the ordinary reasonable person, the test was not to be

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<sup>134</sup> *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936); *see also* *Bethea v. Burnett*, No. CV04-7690JFWPLAX, 2005 WL 1720631, at \*11 n.2 (C.D. Cal. June 28, 2005) (“The court recognizes that it cannot rely on an analysis or comparison of the dissimilarities between the two works in reaching its conclusion with respect to the extrinsic test.”); *see also* 4 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 13.03[B][1][a] at 13-67-13-68 (“It is entirely immaterial that, in many respects, plaintiff’s and defendant’s works are dissimilar, if in other respects, similarity as to a substantial element of plaintiff’s work can be shown.”).

<sup>135</sup> *See* *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 913 (2d Cir. 1980) (“As a matter of logic as well as law, the more numerous the differences between two works, the less likely it is that they will create the same aesthetic impact so that one will appear to have been appropriated from the other.”).

<sup>136</sup> *See, e.g.,* *Narell v. Freeman*, 872 F.2d 907, 913 (9th Cir. 1989) (“Because of the fundamental differences between the works and the insubstantial nature of the copied passages, no reasonable reader could conclude that the works are substantially similar.”); *Berkic v. Crichton*, 761 F.2d 1289, 1294 (9th Cir. 1985) (“Our own, independent review of the works satisfies us that they are substantially dissimilar in ‘the mood evoked . . . as a whole . . . .’”); *Litchfield v. Spielberg*, 736 F.2d 1352, 1357 (9th Cir. 1984) (“The concept and feel of the works here are completely different.”); *Jason v. Fonda*, 526 F.Supp.774, 777 (C.D. Cal. 1981) (finding that the works being “substantially dissimilar” was a basis for finding against plaintiff on both tests).

decided as a matter of law but “must be left to the trier of fact.”<sup>137</sup> Later courts accepted that correction, leaving the intrinsic test to the jury. The courts should likewise have left behind consideration of differences as relevant only to that test. Again, however, due to confusion caused by the insufficiently examined deviation from the original *Krofft* framework, the courts adopted the analysis of differences as part of the extrinsic test.<sup>138</sup>

A meaningful extrinsic test to determine substantial similarity of protected content in literary infringement cases does not consider differences. It identifies and examines individual elements of similarity, but not simply to produce the finding that they are individually unprotectable. Rather, if none of the customarily examined elements of similarity are entitled to protection, as is almost invariably the case, then the test evaluates whether the selection and arrangement of those elements is itself a protectable element.

As to this last inquiry, a new standard is needed. As Judge Hand said more than fifty years ago, any standard for determining protectability must of necessity be vague, and decisions should be *ad hoc*.<sup>139</sup> But to retrieve this active area of law from the muddle of its precedent, more specific guidance is needed.

## XII. THE PROPOSED RULE

The *Metcalf* court applied an appropriate analysis, but it only hinted at a useful standard. The court stated:

The particular sequence in which an author strings a significant number of unprotectable elements can itself be a protectable element. Each note in a scale, for example, is not protectable, but a pattern of notes in a tune may earn copyright protection. A common “pattern” [that] is sufficiently concrete . . . warrants a finding of substantial similarity.<sup>140</sup>

In applying a similar analysis twelve years earlier, the *Shaw* court

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<sup>137</sup> *Shaw v. Lindheim*, 919 F.2d 1353, 1361 (9th Cir. 1990).

<sup>138</sup> One court went so far off the mark as to analyze “total concept and feel”—the object of the intrinsic test—as an extrinsic test factor. See *Capcom Co. v. MKR Grp., Inc.*, No. C 08-0904 RS, 2008 WL 4661479, at \*10 (N.D. Cal. Oct. 20, 2008).

<sup>139</sup> *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

<sup>140</sup> *Metcalf v. Bochco*, 294 F.3d 1070, 1074 (9th Cir. 2002) (quoting *Shaw*, 919 F.2d at 1363).

also found protection for a pattern of similarities because it was “sufficiently concrete.”<sup>141</sup> In fact, the courts have often stated the requirement that similarities be “concrete,” whatever form their analysis might take.<sup>142</sup> But if the only requirement were that the similarities are “concrete,” then the word must mean more than its definition conveys: one can readily conceive a list of shared elements that are specific, real and tangible, but so loosely connected as to fall short of the barest requirements of creativity.

Perhaps the closest that the Ninth Circuit has come to articulating a useful standard was in *Satava v. Lowry*,<sup>143</sup> a case involving sculptures. There, the Ninth Circuit stated that “a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.”<sup>144</sup> As to the first factor, the *Metcalf* court, too, found the volume of similarities an important factor.<sup>145</sup> An extensive list of similarities, however, can be strained out of virtually any two literary works, no matter how dissimilar they are overall. The number of potential similarities is limited only by the resolve of plaintiff’s counsel to find them. Indeed, in *Shaw*, the court noted that defendants had provided “a list of similarities between ‘The Wizard of Oz’ and ‘Star Wars’ that is virtually as compelling as the [plaintiff’s list].”<sup>146</sup> What matters in the analysis, therefore, is not the number of similarities, but the number of meaningful similarities. In this context, the number of similarities is meaningful only if, in combination, the similarities form a protectable selection and arrangement. So in addition to requiring that the similarities be numerous enough, the *Satava* court properly required that they also be original enough. This additional requirement means that the work was not copied from something else and that it is sufficiently creative.<sup>147</sup> As has already been discussed, the question of whether the plaintiff

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<sup>141</sup> *Shaw*, 919 F.2d at 1363.

<sup>142</sup> See, e.g., *Funky Films, Inc. v. Time Warner Entm’t Co.*, 462 F.3d 1072, 1081 (9th Cir. 2006); *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir. 1985); *Sid and Marty Krofft Television v. McDonald’s Corp.*, 562 F.2d 1157, 1163 (9th Cir. 1977).

<sup>143</sup> *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003)

<sup>144</sup> *Id.* (citing *Metcalf*, 294 F.3d at 1074; *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994); and *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 490 U.S. 340, 358 (1991) (“[T]he principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection.”)).

<sup>145</sup> “The presence of so many generic similarities . . . help[s] the Metcalfs satisfy the extrinsic test.” *Metcalf*, 294 F.3d at 1074.

<sup>146</sup> *Shaw*, 919 F.2d at 1363.

<sup>147</sup> *Feist*, 499 U.S. at 345.

copied from another source is no longer directly addressed by the extrinsic test. Whether a similar selection and arrangement of unprotectable elements is sufficiently creative to warrant protection, however, lies at the heart of the test, and it is here that guidance is needed.

The courts have developed a clear standard for determining whether artistic works are sufficiently creative: “To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. 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.”<sup>148</sup> That forgiving standard, however, is the one applied when courts consider the protectability of an artistic work. The justification for setting the bar nearly at ground level in weighing protectability was stated by Justice Holmes at the turn of the last century. In reversing a lower court’s snub of circus posters as a subject worthy of copyright protection, he wrote, “It would be a dangerous undertaking for persons trained only to the law to constitute themselves judges of the worth of pictorial illustration outside of the narrowest and most obvious limits.”<sup>149</sup>

It is not suggested that the mysteries of artistic creation warrant the same degree of deference in determining whether a list of similarities is entitled to protection under the extrinsic test. The adoption of a standard that grants protection to a selection and arrangement of similarities only one notch more expressive than a “mere idea” would dial the extrinsic test almost all the way back to the original *Krofft* formulation. A higher level of originality is required for the extrinsic test because the courts are not simply attempting to determine protectability: they are looking for similarity that is substantial enough to warrant a finding of infringement. Where the selection and arrangement of shared elements barely registers on the scale of creativity, that finding is not justified.<sup>150</sup>

What standard of creativity should apply? Courts that have rejected “lists” of unprotected similarities as a basis to satisfying the extrin-

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<sup>148</sup> *Id.* (quoting 1 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §1.08[C][1] (1990)).

<sup>149</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903); *see also* *Pivot Point Int’l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 924 (7th Cir. 2004) (stating that artistic analysis is “a function for which judicial office is hardly a qualifier”).

<sup>150</sup> Indeed, the Second Circuit has stated that “[o]riginality in this context ‘means little more than a prohibition of actual copying.’ No matter how poor artistically the author’s addition, it is enough if it be his own.” *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 (2d Cir. 1951) (citations omitted). This humble standard has no value for the extrinsic test analysis, whose very purpose is to determine whether there has been copying.

sic test provide the most useful guidance on the matter. The Ninth Circuit addressed such a list in *Litchfield*, dispensing it with the oft-quoted statement that the court is “particularly cautious where . . . the list emphasizes random similarities scattered throughout the works.”<sup>151</sup> Since then, Ninth Circuit courts have routinely dismissed a list of individual similarities invariably proffered by plaintiffs to avoid summary judgment, stating that the list is random, or that it consists of “disconnected facts,” with no “concrete” or “common” pattern or “qualitative significance.”<sup>152</sup> The unstated but clearly implied corollary is that, where the list of similarities is *not* random or disconnected—where the similarities in the list are related in a way essential to the work—they form a combination that is potentially entitled to protection. This is what the *Metcalfe* court meant when it illustrated its rule by stating that, while the individual notes of a scale are not protectable, “a pattern of notes in a tune may earn copyright protection.”<sup>153</sup> In the world of literary infringement, a cohesive, sufficiently delineated artistic structure is the equivalent of a tune.

Taking into account what the courts have said, or have failed to say, or have failed to say clearly, the following rule is proposed for evaluating substantial similarity of non-verbatim copying under the extrinsic test:

*The extrinsic test is satisfied where a combination of unprotected elements shared by the works constitutes a cohesive artistic structure sufficiently delineated and distinct from those of other works of its type to warrant protection.*

Why the focus upon structure? Because it is structure—that is, how the similar elements relate to each other—that stamps a list of

<sup>151</sup> *Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir. 1984).

<sup>152</sup> *Cavalier v. Random House*, 297 F.3d 815, 825 (9th Cir. 2002); *Lane v. Universal City Studios, Inc.*, No. 93-56093, 1994 WL 465834, at \*2 (9th Cir. Aug. 29, 1994); *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1043, 1045-46 (9th Cir. 1994); *Olson v. Nat'l Broad. Co.*, 855 F.2d 1446, 1450 (9th Cir. 1988); *Buggs v. Dreamworks, Inc.*, No. CV 09-07070 SJO (AGRx), 2010 WL 5790251, at \*7 (C.D. Cal. Dec. 28, 2010); *Bernal v. Paradigm Talent and Literary Agency*, 788 F. Supp. 2d 1043, 1063 (C.D. Cal. 2010); *Gable v. Nat'l Broad. Co.*, 727 F. Supp. 2d 815, 841 (C.D. Cal. 2010); *Doody v. Penguin Grp. (USA) Inc.*, 673 F. Supp. 2d 1144, 1159 (D. Haw. 2009); *Capcom Co. v. MKR Grp., Inc.*, No. C 08-0904 RS, 2008 WL 4661479, at \*8 (N.D. Cal. Oct. 20, 2008); *Gilbert v. New Line Prods., Inc.*, No. CV 09-02231 RGK (RZx), 2009 WL 7422458, at \*5 (C.D. Cal. Nov. 16, 2009); *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124, 1138 (C.D. Cal. 2007); *Bethea v. Burnett*, No. CV04-7690JFWPLAX, 2005 WL 1720631, at \*14 (C.D. Cal. June 28, 2005).

<sup>153</sup> *Metcalfe v. Bochco*, 294 F.3d 1070, 1074 (9th Cir. 2002) (quoting *Shaw v. Lindheim*, 919 F.2d 1353, 1363 (9th Cir. 1990)).

similarities as something more than random. Where the combination of similarities forms an artistic framework, it is a defining element of the literary work, the very opposite of a random list. Such a creation is not a “mere idea,” but rather it is the blueprint for the expression of an idea, protectable in its own right. It is a thing of genuine value, warranting protection not only due to theoretic principles of copyright law, but also due to the realities of the literary marketplace.<sup>154</sup>

The proposed rule assures that the test focuses upon the only literary component where non-verbatim infringement may be found—in the selection and arrangement of similar elements. It also addresses the concerns that have properly been raised by the courts. The requirement that the structure be sufficiently delineated and distinct from other works assures that protection will be given only where the combination is original to the claimed author and that protection will be withheld where it is too broad or insufficient in creativity or in the number of its parts. The requirement of cohesiveness eliminates any potential for protection of random similarities. The rule provides that as more detailed similarities comprising an artistic structure are found in the defendant’s work, the closer the defendant’s work comes to substantial similarity.<sup>155</sup> While absolute specificity is neither possible nor even desirable for an inquiry whose method is essentially subjective, it is specific about the object of the inquiry.

### XIII. THE COURTS SHOULD NOT GO IT ALONE

Though often presented under its alias, the “objective test,” the extrinsic test is objective only in its method. It requires the trier of fact to dissect the works to identify similarity, while the intrinsic test calls only for an emotional response to the undifferentiated whole of the works. In determining whether the similarity is “substantial,” however, the extrinsic test is no less subjective than the intrinsic test.

Until now, Ninth Circuit courts have made little if any use of expert testimony in applying the extrinsic test. Two district courts have even referred to authority outside the Ninth Circuit that “cast doubt on whether expert testimony regarding substantial similarity is *ever* help-

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<sup>154</sup> For validation of that fact, it need only be observed that, in Hollywood, a project usually depends upon a successful pitch for its funding—a presentation describing the structure of the proposed work.

<sup>155</sup> The proposed rule adopts language used in evaluating the protectability of characters. *See, e.g.,* Rice v. Fox Broad. Co., 330 F.3d 1170, 1175 (9th Cir. 2003) (characters must be “sufficiently delineated”).

ful in a case involving the comparison of two literary works.”<sup>156</sup> The rationale is that, unlike a patent involving technical devices or a copyright involving software or music, movies and television series “are targeted at a general audience and deal with subject matter readily understandable by any ordinary persons, including the Court.”<sup>157</sup> The rejection of expert assistance should be reconsidered.

Historically, the courts’ rejection of expert assistance in this area has largely been justified. When plaintiffs have used experts at all, they have used them only to identify similarities in the works. There is no need for that type of expert testimony. Similarities are objective facts, and, as one court has stated, a list of similarities is something that the plaintiff can directly present to the court without an expert acting as an intermediary.<sup>158</sup> That same court suggested, however, that expert testimony would be useful to explain “why such alleged similarities are qualitatively important to the two works.”<sup>159</sup> Precisely. Movies and other literary works are not necessarily less complex or nuanced than, say, music, painting, or sculpture, which themselves are often works of popular entertainment. Judges are no better qualified to evaluate the originality or the significance of similarities in a literary work than they are to write a play, edit an anthology of literary criticism, or teach a film class. The proof is that few courts have gone further in their analyses than to simply identify similarities and differences. The few courts that have attempted to go further have not supplied meaningful support for their conclusions.

The Ninth Circuit’s opinion, *Kouf v. Walt Disney Pictures & Television*,<sup>160</sup> typifies the superficial treatment generally given to the issue. In that case, the plaintiff claimed that the motion picture, *Honey, I Shrunk The Kids*, infringed his screenplay. The court found that the “idea” of the works in question consisted of the shrinking of young children to miniscule size and their struggle against resultant life-threatening dangers. To support its claim of substantial similarity, the

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<sup>156</sup> *Bernal*, 788 F. Supp. 2d at 1062 (emphasis in original) (citing *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 123 (2d Cir.1930); *Stromback v. New Line Cinema*, 384 F.3d 283, 295 (6th Cir. 2004); *Kindergartners Count Inc. v. Demoulin*, 249 F. Supp. 2d 1214, 1232 (D. Kan. 2003)); *Gable*, 727 F. Supp. 2d at 836 n.18 (emphasis in original) (citing *Nichols*, 45 F.2d at 123; *Stromback*, 384 F.3d at 295; *Demoulin*, 249 F. Supp. 2d at 1232); see also *Capcom*, 2008 WL 4661479, at \*6 n.4 (justifying a grant of motion to dismiss despite plaintiff’s lack of opportunity to present expert testimony, stating that it did not “see how [expert] testimony would be either necessary or useful”).

<sup>157</sup> *Bernal*, 788 F. Supp. 2d at 1062; *Gable*, 727 F. Supp.2d at 836 n.18.

<sup>158</sup> *Bernal*, 788 F. Supp. 2d at 1063.

<sup>159</sup> *Id.*

<sup>160</sup> *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1043, 1045 (9th Cir. 1994).

plaintiff identified a list of similarities including “a lawnmower scene, a sprinkler scene, the presence of an attic, danger scenes, concerned parents and kids sleeping outside overnight.” In finding that the list failed to satisfy the extrinsic test, the court stated simply that the similarities were random.<sup>161</sup> As may readily be seen, however, the similarities were by no means random. Each one related directly to the “idea” of the work, and in combination formed a cohesive selection and arrangement expressing that idea. If these were the only similarities between the works, the court might have been justified in rejecting them as insufficient in number and in creative distinction from other narratives involving imperiled children. The court’s language, however, reflected that these were *not* the only similarities, and there is no way to confirm that either of the grounds for rejection was justified.

Certainly, expert testimony is not always required to apply the test. Some works present an “artistic structure” requiring no great depth of analysis or specialized knowledge to divine, such as an instructional video for magic tricks,<sup>162</sup> treatments for a reality show,<sup>163</sup> or a cooking show.<sup>164</sup> Even a structurally humble work, however, may require expert testimony to explain how it differs from those that preceded it—to show how original it is.

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<sup>161</sup> *Id.* at 1045-46.

<sup>162</sup> *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1173 (9th Cir. 2003).

<sup>163</sup> *Milano v. NBC Universal, Inc.*, 584 F. Supp. 2d 1288, 1290 (C.D. Cal. 2008).

<sup>164</sup> *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124, 1125 (C.D. Cal. 2007).



