threatened even greater disarray in the field, until corrected prior to publication.[198.4] Part of the confusion here may stem from the overlapping usages of the terms "copying" and "substantial similarity", as previously noted.[198.5] Proof of access can logically aid in showing copying as a factual matter — added to the probative similarity that exists between two works, it can bolster the proof that one was in fact derived from the other. But access logically exerts no impact on copying as a legal matter; no matter how steeped in plaintiff's work defendant may have been, if the resulting product is non-actionable as a matter of law, then the absence of substantial similarity that must underlie every successful claim still dooms the infringement suit.[198.6]

[E]—Dissection and the Audience Test in Determining Substantial Similarity

[1]—Judicial Formulations. Although it is clear that the determination of substantial similarity presents an issue of fact,[199] the correct procedure for that determination remains clouded. For over a century, the courts in general have purported to apply what is called the ordinary observer or audience test.[200] That

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198.4 For instance, in *Baxter v. MCA* (see N. 197 *supra*), the slip opinion originally commented:

> As in *Krofft*, this case presents ample evidence of access Defendant Williams had personal knowledge of [plaintiff's music] and participated as the pianist in the orchestra for a public performance of [it] in the Hollywood Bowl. In a trial, such evidence of access is relevant to substantial similarity, and merits submission to a jury.

Following petition for rehearing, that language was fortunately stricken from the published opinion.

198.5 See §§ 13.01[B], 13.03[A] *supra*.

198.6 Lou Petrich underlines the point: "Ironically, for a decision with so much wrong with it, much about *Krofft*'s structure of analysis was right on. By analyzing unlawful appropriation first and derivation last, it made an improvement on *Arnstein v. Porter*, anticipated 'successive filtration,' and thus employs a methodology that would avoid improper application of the Inverse Ratio Rule." See N. 198.1 *supra*.

199 Malkin v. Dubinsky, 146 F. Supp. 111 (S.D.N.Y. 1956). See § 12.10[A] *supra*.

200 *E.g.*, Walker v. Time Life Films, Inc., 784 F.2d 44, 51 (2d Cir.), *cert. denied*, 476 U.S. 1159 (1986) (Treatise cited); Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., 509 F.2d 64 (2d Cir. 1974); Williams v. Kaag Mfrs., Inc., 338 F.2d 949 (9th Cir. 1964); Key West Hand Print Fabrics, Inc. v. Serbin, Inc., 244 F. Supp. 287 (S.D. Fla. 1965); Manes Fabrics Co. v. Miss Celebrity, Inc., 246 F. Supp. 975 (S.D.N.Y. 1965); United Merchants & Mfrs. v. Sutton, 282 F. Supp. 588 (S.D.N.Y. 1967) ("whether an ordinary observer, who is not attempting to discover disparities 'would be disposed to overlook them and regard their aesthetic appeal as the same' "); Gray v. Eskimo Pie Corp., 244 F. Supp. 785 (D. Del. 1965); Ideal Toy Corp. v. Fab-Lu Ltd., 360 F.2d 1021 (2d Cir. 1966); Ideal Toy Corp. v. Fab-Lu, Ltd., 261 F. Supp. 238 (S.D.N.Y. 1966) ("average lay observer" held to include children where the work in question, such as a doll, appeals particularly to children); Marcal Paper Mills, Inc. v. Scott Paper Co., 290 F. Supp. 43 (D.N.J. 1968) (ordinary observer test applied to labels); United Merchants & Mfrs., Inc., v. K. Gimbel Accessories, Inc., 294 F. Supp. 151 (S.D.N.Y. 1968) (fabric designs); Herbert Rosenthal Jewelry

test is the subject of the lengthy discussion in this section.[200.1] Yet, the authority for the audience test emanates exclusively from the inferior courts, and may not be in harmony with the views of the nation's highest tribunal.[200.2] Accordingly, this discussion must be placed into a type of mental "suspense account." It must inevitably be taken into account, and may indeed prove dispositive. But until the Supreme Court validates or negates the audience test, the copyright bar will be left in suspense as to its ultimate validity.

[*a*]—*The Audience Test.* The traditional test has been stated as follows:

> The question really involved in such comparison is to ascertain the effect of the alleged infringing play upon the public,[201] that is, upon the average reasonable man. If an ordinary person[201.1] who has recently read the story sits through the presentation of the picture, if there had been literary piracy of the story, he should detect that fact *without any aid or suggestion or critical*

Corp. v. Zale Corp., 323 F. Supp. 1234 (S.D.N.Y. 1971) (jewelry); Loomskill, Inc. v. Stein & Fishman Fabrics, Inc., 332 F. Supp. 1288 (S.D.N.Y. 1971) (fabric designs); Kustoff v. Chaplin, 120 F.2d 551 (9th Cir. 1941); Burtis v. Universal Pictures Co., 40 Cal. 2d 823, 256 P.2d 933 (1953); Funkhouser v. Loew's, Inc., 208 F.2d 185 (8th Cir.), *cert. denied*, 348 U.S. 843, *reh'g denied*, 348 U.S. 890 (1954); Cain v. Universal Pictures Co., 47 F. Supp. 1013 (S.D. Cal. 1942); Harold Lloyd Corp. v. Witwer, 65 F.2d 1 (9th Cir.), *dismissed*, 296 U.S. 669 (1933); Peter Pan Fabrics v. Acadia Co., 173 F. Supp. 292 (S.D.N.Y. 1959), *aff'd sub nom.* Peter Pan Fabrics v. Martin Weiner Corp., 274 F.2d 487 (2d Cir. 1960); Costello v. Loew's, Inc., 159 F. Supp. 782 (D.D.C. 1958); Gordon v. Weir, 111 F. Supp. 117 (E.D. Mich. 1953), *aff'd*, 216 F.2d 508 (6th Cir. 1954); Barton Candy Corp. v. Tell Chocolate Novelties Corp., 178 F. Supp. 577 (E.D.N.Y. 1959); King Features Syndicate v. Fleischer, 299 F. 533 (2d Cir. 1924); Twentieth Century-Fox Film Corp. v. Stonesifer, 140 F.2d 579 (9th Cir. 1944); Arnstein v. BMI, 46 F. Supp. 379 (S.D.N.Y. 1942), *aff'd*, 137 F.2d 410 (2d Cir. 1943); Cortley Fabrics Co. v. Slifka, 138 U.S.P.Q. 110 (S.D.N.Y. 1963), *aff'd*, 317 F.2d 924 (2d Cir. 1963). See Educational Testing Serv. v. Katzman, 793 F.2d 533, 541 (3d Cir. 1986).

200.1 The traditional audience test is the focus of this entire § 13.03[E], with the exception of § 13.03[E][1][b] *infra*, and also plays a role in § 13.03[F] *infra*.

200.2 See § 13.03[E][1][b] *infra*.

201 As to the relevance of public opinion polls on this issue, the court in Ideal Toy Corp. v. Kenner Prods., 443 F. Supp. 291 (S.D.N.Y. 1977), commented upon "the dangerous precedent of allowing trial by the court to be replaced by trial by public opinion poll." See also Warner Bros. v. American Broadcasting Cos., 720 F.2d 231 (2d Cir. 1983), which expressly declined to rule on whether survey evidence is admissible to aid a jury in determining substantial similarity, but held that a trial judge's grant of summary judgment to the defendant for lack of substantial similarity cannot be found erroneous because of the availability of survey evidence indicating a public belief of similarity.

201.1 One court proposes substituting the "intended audience" for the "ordinary observer" as the appropriate label. Dawson v. Hinshaw Music, Inc., 905 F.2d 731, 737 (4th Cir.), *cert. denied*, 498 U.S. 981 (1990). See the discussion of this case in § 13.03[E][4] *infra*

analysis by others. The reaction of the public to the matter should be spontaneous and immediate.[202]

[*b*]—*The New Learning?* In recent decades, the Supreme Court has confronted numerous copyright issues; yet none of those cases posed the line-drawing issue of how far a defendant can go without committing *prima facie* infringement.[202.1] In fact, in none of those cases did the Supreme Court lay down the governing law as to what constitutes the elements of a copyright case. Rather, in the annals of Supreme Court jurisprudence, the elements spring forth full-grown in a 1991 decision regarding telephone book compilations.

Specifically, in *Feist Publications, Inc. v. Rural Telephone Service Co.*,[202.2] the Supreme Court defined the essential element of an infringement claim (along with ownership of a valid copyright) as follows: "copying of constituent elements of the work that are original."[202.3] That definition purports to apply across the

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[202] Harold Lloyd Corp. v. Witwer, 65 F.2d 1, 18 (9th Cir. 1933) (emphasis added). If the works in issue are directed to a particular audience, then the "spontaneous and immediate" reaction of that audience is determinative. Dawson v. Hinshaw Music, Inc., 905 F.2d 731, 736 (4th Cir.), *cert. denied*, 498 U.S. 981 (1990) (Treatise quoted). Thus, if the works are directed to an audience of children, "this raises the particular factual issue of the impact of the respective works upon the minds and imaginations of young people," who may not be as bent as their elders upon " 'detecting disparities.' " Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157 (9th Cir. 1977). See § 13.03[A][1][c] *supra*.

[202.1] Prior to 1991, the most recent Court opinion addressed the scope of rights in underlying works when incorporated into derivative works; no argument was advanced there that defendant's movie did not infringe on plaintiff's short story absent reliance on the "new property right" theory (and, in the court below, indivisibility and fair use.) Stewart v. Abend, 495 U.S. 207 (1990). See § 3.07[A][3] *supra*. In the 1980's, the Court confronted the work-for-hire doctrine (Community for Creative Non-Violence v. Reid, 490 U.S. 730 (1989), see § 5.03[B][1][a][iii] *supra*), the scope of fair use (Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539 (1985), see § 13.05[A][5] *infra*), termination of transfers (Mills Music, Inc. v. Snyder, 469 U.S. 153 (1985), see § 11.02[B][3] *supra*), criminal aspects relating to copyright (Dowling v. United States, 473 U.S. 207 (1985), see § 15.05 *infra*), and home taping as it relates to contributory infringement and fair use (Sony Corp. v. Universal City Studios, Inc. 464 U.S. 417 (1984), see § 12.04[A][2][b] *supra*).

[202.2] 499 U.S. 340 (1991). See further discussion of this case in § 3.04[B][2] *supra*.

[202.3] The entire quote is:

> Not all copying, however, is copyright infringement. To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original. See Harper & Row, 471 U.S., at 548, 105 S.Ct., at 2224.

See § 13.01[B] *supra*. Notwithstanding the citation to Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 548 (1985), that earlier case does not set forth the elements of an infringement case, nor does it define the level of culpable copying. The cited page does state: "[C]opyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not original . . . as long as such use does not unfairly appropriate the author's

board, not merely to the type of factual compilation at issue in *Feist*.[202.4] The prepositional phrase following "copying" furnished the linchpin for the Court's analysis. Notwithstanding the validity of the copyright in plaintiff's work as a whole, notwithstanding defendant's exact copying from plaintiff's work — even to the extent that defendant reproduced some fictitious listings composed by plaintiff to detect copying — and notwithstanding the decision by both lower courts in plaintiff's favor, a unanimous Supreme Court[202.5] held defendant's conduct noninfringing as a matter of law, given that the constituent elements that defendant appropriated were not themselves original.[202.6]

At least in the context of the factual compilations at issue in *Feist*, there was no hint that the Court deemed relevant the effect "upon the public," any "spontaneous and immediate" impression, or reactions reached "without any aid or suggestion or critical analysis."[202.7] Indeed, to focus on the precise scope of defendant's admitted copying and to detail how said copying was limited to unprotected expression, it would seem that critical analysis is essential. The Court's approach in *Feist*, on the facts there presented, is therefore inhospitable to an unadorned audience test.

Nonetheless, *Feist* did not in express terms reject the test. Accordingly, the inquiry into the doctrine's current viability must be posed as follows: Does the audience test give content to the Court's definition of infringing conduct as "copying of constituent elements of the work that are original?" In the context of the *Feist* decision itself, it would seem that the audience test can play no useful role. But more broadly, to the extent that application of the audience test results in liability across the spectrum of copyrightable compositions, when such copying has occurred, and denies liability when there is either no copying or copying only of unoriginal constituents, then it may be concluded that that test fulfills

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original contribution." *Id.* at 548 (Treatise cited). Nonetheless, the Court there continues: "We need not reach those issues, however, as The Nation has admitted to lifting verbatim quotes of the author's original language . . . constituting some 13% of The Nation article." *Id.* The case then turns on fair use. See § 13.05[A][5] *infra*.

202.4 Apart from the circumstance that the Court stated that this element exists "[t]o prove infringement" without limiting its statement to the context of factual works, the Court's citation to *Harper & Row* — a case about President Ford's memoirs, a more traditional type of literary work (albeit one which contained some facts) —would have been inapposite had the Court meant thus to limit itself.

202.5 Justice O'Connor authored the opinion, which won the accord of a spectrum running from Justice Marshall to Justice Scalia, and included the Court's then-newest member, Justice Souter. Justice Blackmun merely concurred in the judgment.

202.6 The elements at issue were facts, which lie beyond copyright protection. See the further discussion of *Feist* in §§ 13.01[B] & 13.03[B][2][b] *supra*.

202.7 See § 13.03[E][1][a] *supra*.

the goals of copyright law as detailed by the Court. By contrast, to the extent that the audience test frustrates that goal, it must be discarded, limited, or tailored to meet the Supreme Court's formulation.

It is submitted in the discussion that follows that the audience test does not, at its core, serve the goal set forth above.[202.8] No doubt, it is possible to limit and tailor that core, as well as to accrete special exceptions to it[202.9] — the courts can contort and distend the audience test such that it will not fall directly afoul of *Feist*.[202.10] But the mere fact that the exercise is possible hardly proves it to be desirable. Defenders of Ptolemy's geocentric universe could explain each new celestial *datum* with exceptions and riders; eventually, however, the weight of the gerrymandering brought the whole model

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202.8 See § 13.03[E][2] *infra*. But see refinements that courts have imposed on the audience test in § 13.03[E][3] *infra*.

202.9 See the various approaches canvassed in § 13.03[E][3] *infra*.

202.10 Exceptions within exceptions have become a standard feature in audience test jurisprudence. In Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 493 (9th Cir. 1985), the Ninth Circuit stated, "What is important is not whether there is substantial similarity in the total concept and feel of the works, [citation] but whether the very small amount of protectible expression in [plaintiff]'s catalog is substantially similar to the equivalent portions of [defendant]'s catalog." Two years after that decision, the same court held *Cooling Systems* inapplicable to artistic works, ruling that even uncopyrightable material could be considered in evaluating substantial similarity. McCulloch v. Albert E. Price, Inc., 823 F.2d 316, 321 (9th Cir. 1987). Shortly thereafter, however, the Ninth Circuit limited its limitation of *Cooling Systems*: "Although even unprotectible material should be considered when determining if there is substantial similarity of expression, see *McCulloch*, 823 F.2d at 320–21, no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise form the use of common ideas." Aliotti v. R. Dakin & Co., 831 F.2d 898, 901 (9th Cir. 1987). It would seem that *Feist* demands, at a minimum, *Aliotti*'s limitation of *McCulloch*.

crashing down.[202.11] Given the questionable doctrinal footing for the audience test,[202.12] the fact that, in practice, it "has had an artificial and disappointingly inaccurate application"[202.13] and increasingly has become a verbal formula to explain results otherwise reached,[202.14] the myriad exceptions in the way it is applied,[202.15] its total incongruence with the tools needed to evaluate those works of technology that increasingly dominate[202.15a] copyright jurisprudence,[202.16] its hostility in practice to sound judicial management[202.17] through eliminating meritless claims via summary judgment,[202.18] and finally the fact that

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202.11 See generally T. Kuhn, *The Structure of Scientific Revolutions* (1970).

202.12 See § 13.03[E][2] *infra*.

202.13 Shipman v. RKO, 100 F.2d 533 (2d Cir. 1938).

202.14 Without expressly discussing the audience test, its underlying rationale was brought into question in Warner Bros. v. American Broadcasting Cos., 720 F.2d 231 (2d Cir. 1983). Judge Newman, speaking for the court, stated: "The 'substantial similarity' that supports an inference of copying sufficient to establish an infringement of copyright is not a concept familiar to the public at large . . . [W]hen a trial judge has correctly ruled that two works are not substantially similar as a matter of law, that conclusion is not to be altered by the availability of survey evidence indicating that some people applying some standard of their own were reminded by one work of the other . . . If a case lies beyond those limits, the contrary view of a properly drawn sample of the population, or even of a particular jury, cannot be permitted to enlarge (or diminish) the scope of statutory protection enjoyed by a copyright proprietor." *Id.* at 245.

202.15 See § 13.03[E][3] *infra*. Indeed, given the disagreement among the circuits about how to apply the audience test, Supreme Court review is ripe on this basis alone. See *id.* Ns. 243, 253.1 *infra*.

202.15a See Katsh & Rifkin, *The New Media and a New Model of Conflict Resolution: Copying, Copyright, and Creating*, 6 Notre Dame J.L. Ethics & Pub. Pol'y 49, 60–63 (1992) (showing explosive growth in litigation of copyright cases, with marked increase in cases of computer variety).

202.16 See § 13.03[E][4] *infra*.

202.17 Celotex Corp. v. Catrett, 477 U.S. 317 (1986) ("Summary judgment procedure is properly regarded not as a disfavored procedural shortcut, but rather as an integral part of the Federal Rules as a whole, which are designed 'to secure the just, speedy and inexpensive determination of every action.' ") See Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986). Various copyright cases have cited these Supreme Court precedents in granting summary judgment, both to plaintiffs and defendants. *E.g.*, Steinberg v. Columbia Pictures Indus., Inc., 663 F. Supp. 706 (S.D.N.Y. 1987); Sandwiches, Inc. v. Wendy's Int'l, Inc., 654 F. Supp 1066, 1070 (E.D. Wis. 1987); Marshall v. Miles Lab., Inc., 647 F. Supp. 1326, 1329 (M.D. Ind. 1986).

202.18 For the sake of illustration, consider developments in the Ninth Circuit. *Krofft*, that circuit's seminal 1977 case, arguably precludes summary judgment in almost all

it is inadequate to explain the result in the most important Supreme Court case posing the question of how to determine infringement, perhaps a paradigm shift of Copernican proportions is needed in the

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cases in which the defendant maintains that no jury could find its work substantially similar to plaintiff's. See § 13.03[E][3] *infra*. Yet, subsequent to *Krofft*, the Ninth Circuit, although sporadically disapproving of the practice, nonetheless affirmed many summary judgments in favor of defendants for lack of substantial similarity as a matter of law. See *Berkic, See, Litchfield*, and *Cooling Systems*, cited in *id.* N. 250 *infra*.

A decade after *Krofft*, the unevenness in application of its rule emerges most clearly from Baxter v. MCA, Inc., 812 F.2d 421 (9th Cir. 1987). The district judge made a finding that "[t]he Court cannot hear any substantial similarity between defendant's [musical composition] and plaintiff's. Until Professor Bacal's tapes were listened to, the Court could not even tell what the complaint was about." *Id.* at 423. In reversing, the Ninth Circuit stated: "We do not suggest that our ears are any more sophisticated than those of the district court. Nevertheless, based on our review of the record, we are persuaded that reasonable minds could differ as to whether [plaintiff's] Joy and [defendant's] Theme from E.T. are substantially similar." *Id.* at 425. Five days after enunciating that rule, the Ninth Circuit reverted to approval of summary judgment for the defendant as a matter of law. Frybarger v. International Business Machs. Corp., 812 F.2d 525, 529 (9th Cir. 1987) (although there are numerous similar features in plaintiff's and defendant's work, no reasonable jury could find the two works substantially similar). *Accord* Worth v. Selchow & Righter Co., 827 F.2d 569 (9th Cir. 1987), *cert. denied*, 485 U.S. 977 (1988) (decided six months after *Baxter*); Aliotti v. R. Dakin & Co., 831 F.2d 898 (9th Cir. 1987) (decided eight months after *Baxter*); Rachel v. Banana Republic, Inc., 831 F.2d 1503 (9th Cir. 1987) (same).

The next year, the Ninth Circuit seemed actively to approve summary judgment in order to weed out meritless infringement claims. In Olson v. National Broadcasting Co., 855 F.2d 1446 (9th Cir. 1988), following a jury verdict in favor of plaintiff, the district judge granted a j.n.o.v. In affirming, the court concluded that such similarities as do exist result from unprotectible scenes a faire and concluded that no substantial similarity of protectible expression remained. A momentum seemed to be building; indeed if not in word, *Olson* and later cases came close to abandoning the audience test. See Narell v. Freeman, 872 F.2d 907, 910 (9th Cir. 1989) ("We frequently have affirmed summary judgment in favor of copyright defendants on the issue of substantial similarity.")

Yet, news of the audience test's death was greatly exaggerated. Shaw v. Lindheim, 919 F.2d 1353 (9th Cir. 1990), decided several months before *Feist*, stated that any time the plaintiff can satisfy *Krofft*'s extrinsic text, a triable issue of fact exists. That ruling arguably returned the Ninth Circuit to the high-water mark of the anti-summary judgment tide. See § 13.03[E][3] & N. 259 *infra*. See also § 13.03[F][5] N. 345 *infra*. Thereafter, the Ninth Circuit would seem to have drastically limited *Shaw*. See Brown Bag Software v. Symantec Corp., 960 F.2d 1465 (9th Cir.), *cert. denied*, 506 U.S. 869 (1992).

law of copyright.[202.19] It would seem preferable, in short, to discard the audience test.[202.20]

But what to offer in its stead? In *Feist*, the Court took a copyrighted work and eliminated from the substantial similarity calculus all material therein not subject to copyright. The result was to appreciate that the defendant copied only uncopyrightable elements from plaintiff's work, and therefore to deny liability.[202.21] This writer elsewhere has proposed such a test for works of high technology under the rubric "successive filtering."[202.22] Whatever the label, the method is sound and has been applied, at least *sub silentio*, by courts in a variety of contexts.[202.23] In the wake of *Feist*, it should be considered not only

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[202.19] See Kuhn, *op. cit.* N. 202.11 *supra*. Although the Grand Unified Theory of Copyright may continue to elude our grasp, solace can be derived from the continual striving for such a theory even in the much older discipline of physics. See Ferris, *Frand Unification Theories: Faith in Ultimate Simplicity*, Next: The Coming Era in Science (H. Noble, ed.) (1988).

[202.20] Partially underlying this conclusion, lises, to borrow from the physicists, a "Faith in Ultimate Simplicity." See *id.* Rather than a specific rule tailored to every fact situation, in which carved-out exceptions and counterprinciples dominate each decision, this writer submits that consistent rules of general application furnish a far more elegant framework for decisionmaking. See Tribe, *Taking Text and Structure Seriously: Reflections on Free-Form Method in Constitutional Interpretation*, 108 Harv. L. Rev. 1221, 1287 & n.217 (1995).

[202.21] "The mere fact that a work is copyrighted does not mean that every element of the work may be protected." *Feist*, 499 U.S. at 348.

[202.22] See Nimmer, Bernacchi & Frischling, *A Structured Approach to Analyzing the Substantial Similarity of Computer Software in Copyright Infringement Cases*, 20 Ariz. St. L.J. 625, 655–56 (1988), which forms the basis for § 13.03[F] *infra*.

[202.23] For some examples of cases applying the *Feist* standard *avant la lettre*, see Novak v. National Broadcasting Co., 716 F. Supp. 745, 752 (S.D.N.Y. 1989), *later opinion*, 724 F. Supp. 141 (S.D.N.Y. 1989) ("after the court 'distills out' the unprotectible ideas and *scenes a faire*," summary judgment for defendant granted on some counts, denied on another); Feder v. Videotrip Corp., 697 F. Supp. 1165 (D. Colo. 1988) (Treatise cited) (denying liability notwithstanding plaintiff's refusal of defendant's request for a license and defendant nonetheless copied some facts, scenes a faire, and tiny amount of protected expression from plaintiff's copyrighted work). After *Feist*, see Laureyssens v. Idea Group, Inc., 768 F. Supp. 1036, 1053–55 (S.D.N.Y. 1991) (although defendant consciously copied plaintiff's work, which would look similar to ordinary observer, liability denied as similarities did not relate to those aspects that were original to plaintiff), *aff'd (but rev'd on other grounds)*, 964 F.2d 131 (2d Cir. 1992). The *Laureyssens* Second Circuit opinion effectively filtered out unprotected elements from plaintiff's admittedly copyrighted work to conclude that the remaining appropriation was not actionable. 964 F.2d at 141. Under those circumstances, the court conceded that a "more discerning ordinary observer test for substantial similarity" is appropriate. *Id.* See N. 205 *infra*.

for factual compilations[202.23a] and computer programs, but across the gamut of copyright law:[202.23b] to determine whether the similarity between plaintiff's and defendant's work is substantial, the comparison should not include unoriginal elements of plaintiff's work;[202.23c] rather, the comparison should take place after filtering out[202.24] of the analysis elements of plaintiff's work that are not protectible.[202.25] The result of that test may or may not match the outcomes of the various cases applying the so-called audience test and its innumerable variants.[202.26]

202.23a "What must be shown is substantial similarity between those elements, *and only those elements*, that provide copyrightability to the allegedly infringed compilation." Key Publications, Inc. v. Chinatown Today Pub. Enters., Inc., 945 F.2d 509, 514 (2d Cir. 1991) (emphasis added).

202.23b Country Kids 'N City Slicks, Inc. v. Sheen, 77 F.3d 1280, 1284 n.5 (10th Cir. 1996) (Treatise quoted).

202.23c See Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp., 25 F.3d 119, 123 (2d Cir. 1994) (children's toys); Jarvis v. A & M Records, 827 F. Supp. 282, 290–91 (D.N.J. 1993) (song); Coates-Freeman Assocs., Inc. v. Polaroid Corp., 792 F. Supp. 879, 885 (D. Mass. 1992).

202.24 As set forth below, the successive filtering should winnow out, for instance, elements of the plaintiff's work that are copied from prior works, that contain raw facts, that constitute scenes a faire, and that result from the merger of idea and expression. See § 13.03[F] *infra*.

202.25 If attention is paid to how courts have actually proceeded in past infringement analyses, rather than their nomenclature, *Feist* does not represent a radical shift. *E.g.*, Flag Fables, Inc. v. Jean Ann's Country Flags & Crafts, Inc., 730 F. Supp. 1165, 1179 (D. Mass. 1989) ("the only 'substantial similarity' which is legally significant is that existing between protected aspects of the plaintiff's work and the conflicting elements of the defendant's design"), *citing* Concrete Mach. Co., v. Classic Lawn Ornaments, Inc., 843 F.2d 600 (1st Cir. 1988). The point is that such past infringement analyses have departed from the strict perspective of the ordinary observer, thus *pro tanto* abandoning the core of the audience test, notwithstanding their rote invocation of the ordinary observer as a step in the analytic process. *E.g.*, *id.* at 1178 ("an 'ordinary observer' comparison of each party's artistic expression").

202.26 For instance, in Collins & Aikman Corp. v. Carpostan Indus., Inc., 720 F. Supp. 561, 565 (D.S.C. 1989), *aff'd mem.*, 905 F.2d 1529 (4th Cir. 1990) (Treatise cited), there were "substantial differences in the construction of these two fabric designs and slight differences in visual impression." Under the audience test, the judge was constrained to send the case to the trier of fact. Given that the parties consented to trial on the merits being consolidated with the preliminary injunction motion, the trier of fact in that case was also the judge, who ruled in defendant's favor. *Id.* at 566. Query whether the same verdict would have been returned by a jury instructed according to the "ordinary observer" test.

[2]—Criticism of the Audience Test. Reverting to the formulation set forth above describing the role of the ordinary observer,[202.27] the italicized portion represents the very heart of the audience test and, it is suggested, its weakness. The trier of fact is not to examine "hypercritically or with meticulous scrutiny,"[203] but is to determine similarity solely on the basis of his "net impression,"[204] ignoring any particular impressions of similarity found by dissecting and examining elements of the two works.[205] In comparing a book and a motion picture, the public must be "deceived" into believing "that the films are a picturization of plaintiff's literary work" in order for there to be a finding of infringement.[206]

Before examining the implications of this doctrine, it would be well to note its origin. This "audience test" is commonly said[207] to be based on the opinion rendered in the leading case *Daly v. Palmer*.[208] In that

(Text continued on page 13–93)

[202.27] See § 13.03[E][1][a] *supra*.

[203] Twentieth Century-Fox Film Corp. v. Stonesifer, 140 F.2d 579, 582 (9th Cir. 1944).

[204] Solomon v. RKO Radio Pictures, 44 F. Supp. 780, 782 (S.D.N.Y. 1942).

[205] *Id.* It is therefore oxymoronic to refer, as did one court, to a "more discerning 'ordinary observer' test." See Folio Impressions, Inc. v. Byer Cal., 937 F.2d 759, 767 (2d Cir. 1991). Nonetheless, the salutary result of such "discernment" may be the successive filtering advocated above. See *id.* at 765 (test to prove infringement "demands that the similarities relate to protectible material"). See the decision below, 752 F. Supp. 583, 591–92 (S.D.N.Y. 1990). On the other hand, a later decision applying *Folio Impressions* declined to engage in dissection, and went to the opposite extreme of invoking the unhelpful standard of "total concept and feel." Knitwaves, Inc., v. Lollytogs Ltd., 71 F.3d 996, 1003 (2d Cir. 1995). See § 13.03[A][1][c] *supra*.

[206] Roe-Lawton v. Hal E. Roach Studios, 18 F.2d 126, 128 (S.D. Cal. 1927).

[207] Shipman v. RKO Radio Pictures, 100 F.2d 533 (2d Cir. 1938).

[208] 6 F. Cas. 1132, No. 3,552 (C.C. S.D.N.Y. 1868).

case, both parties' works involved a scene on a railroad track wherein someone tied to the track is released just in time to avert a tragic demise. The scenes were not similar in dialogue but were almost identical in action. In answer to the argument that copyright does not protect pantomime and other nonverbal action, the court said:

> [A] composition when represented excites emotion and imparts impressions not merely through the medium of the ear as music does but through the medium of the eye as well as the ear. Movement, gesture and facial expression, which address the eye only, are as much a part of the dramatic composition as is the spoken language which addresses the ear only; and that part of the written composition which gives direction for the movement and gesture is as much a part of the composition and protected by copyright as is the language prescribed to be uttered by the characters. . . .[209]

Then, within the above context, the court went on to say that the standard for determining similarity is whether the two works are:

> [1] recognized by the spectator; [2] through any of senses to which the representation is addressed; [3] as conveying substantially the same impressions to and exciting the same emotions in the mind in the same sequence or order.[210]

The "audience test" derives from the phrase numbered 1 above. Yet there is nothing in this passage to indicate that there must be no dissection or analysis in considering the significance of sensory impressions. Furthermore, within the above-stated context, it is at least perfectly arguable that phrase 2, not phrase 1, deserves the emphasis. That is, it may be that the court in this passage — from which so much has been extracted — intended merely to point up the principle that elements appealing to any of the senses might command copyright protection.

Certainly, there can be no dispute that the "spontaneous and immediate"[211] reactions of the ordinary observer are relevant evidence in determining the existence of copying.[212] There is, however, reason

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[209] *Id.* at 1137.

[210] *Id.* at 1138.

[211] Harold Lloyd Corp. v. Witwer, 65 F.2d 1, 18 (9th Cir. 1933), *cert. dismissed*, 87 L. Ed. 1507 (1934).

[212] MCA, Inc. v. Wilson, 425 F. Supp. 443 (S.D.N.Y. 1976) (Treatise quoted), *modified*, 677 F.2d 180 (2d Cir. 1981). After quoting the foregoing sentence, the *MCA*

to dispute the doctrine insofar as it makes the visceral reactions of the trier *the* ultimate test of copying (assuming access). The Copyright Act is intended to protect writers from the theft of the fruits of their labor,[213] not to protect against the general public's "spontaneous and immediate" *impression* that the fruits have been stolen. To be sure, the ordinary observer's impression that there has been a theft is important evidence in establishing that, in fact, there was a theft, but the two are not the same. There are reasons why the spontaneous impressions of an ordinary observer — or reasonable person in comparing two literary works — may not always prove an accurate guide to ferreting out the existence of literary theft. These reasons we now propose to examine.

The "audience test" is an attempt at applying the "reasonable person" doctrine as found in other areas of the law to copyright.[214] But in those other areas (*e.g.*, torts, trusts, corporations, criminal law), the trier is asked to compare the defendant's actions with what the trier's own (presumably reasonably prudent) actions would be under the same circumstances. Thus, in a negligence case, the trier puts himself into the defendant's shoes, not the shoes of an "ordinary observer" of the accident. Contrast this with the "audience test" where the essential question is: did the defendant copy from plaintiff? Here the trier is not equipped to put himself into the defendant's shoes. He cannot meaningfully answer whether, if he were in the defendant's shoes, he would have been constrained to copy from the plaintiff in order to achieve the given result. Therefore, the trier is directed to answer the only question he can answer — does the result of the defendant's work give appearances of having been copied from the plaintiff? But this leads us back to the dead end of audience impression of theft, not to the theft itself. Can there be literary theft without an immediate and spontaneous detection by the ordinary observer? If this question can be answered in the affirmative, then, obviously, the audience test is inadequate.

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court held that evidence of the reactions of members of the cast and audience at a play were relevant on the issue of similarity, and further that a third party may testify as to what cast and audience members told him in this regard, despite the hearsay rule, under the "present sense impressions" exception. See Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607 (7th Cir. 1982), *cert. denied*, 459 U.S. 880 (1982) (extrinsic evidence of reactions of sales clerks and retailers held relevant).

[213] See Echevarria v. Warner Bros. Pictures, 12 F. Supp. 632, 634 (S.D. Cal. 1935).

[214] Sheldon v. Metro-Goldwyn Pictures Corp., 7 F. Supp. 837 (S.D.N.Y. 1934), *rev'd*, 81 F.2d 49 (2d Cir. 1936).

Consider the not infrequent situation where the defendant's work is adapted for use in a medium different from that intended for the plaintiff's. In comparing a play and a motion picture, it has been recognized that:

> dissimilarities result . . . principally from the film's enlarged means to express in a wider latitude incidents necessarily requiring a wider range of settings than a play restricted to the narrow confines of a theatrical stage is able to present.[215]

In copying a movie from a play, one court has suggested that:

> it may be most effectively pirated by leaving out the speech, for which a substitute can be found, which keeps the whole dramatic meaning.[216]

Similarly, where a motion picture or play is based on a novel, the courts have recognized that "dramatization of a novel frequently differs from the story on which it is founded,"[217] and that "the form of expressing ideas is not by repeating the words and form of expression contained in the story."[218] Often, a novel will be composed largely of introspective thoughts and emotions that, when dramatized, will of necessity be expressed in a quite different manner. "It seems hardly possible that any amount of effort to 'register' emotions could produce it on film."[219] In *Dam v. Kirke La Shelle*,[220] where it was claimed that a play infringed a short story, the court stated well the problem of transformation into a different medium:

> It is, of course, true that the play has many additional incidents. It is likewise true that none of the language of the story is used in the play and that the characters have different names. But the right given to the author to dramatize his work includes the right to adapt it for representation upon the stage which must necessarily involve changes, additions and omissions. *It is impossible to make*

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[215] Twentieth Century-Fox Film Corp. v. Stonesifer, 140 F.2d 579, 583 (9th Cir. 1944). See Computer Assocs. Int'l, Inc. v. Altai, Inc., 982 F.2d 693, 713 (2d Cir. 1992) (Treatise cited); Bevan v. Columbia Broadcasting Sys., Inc., 329 F. Supp. 601 (S.D.N.Y. 1971) (Treatise cited).

[216] Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 56 (2d Cir. 1936).

[217] Simonton v. Gordon, 12 F.2d 116, 120 (S.D.N.Y. 1925).

[218] Harold Lloyd Corp. v. Witwer, 65 F.2d 1 (9th Cir. 1933), *cert. dismissed*, 87 L. Ed. 1507 (1934).

[219] London v. Biograph Co., 231 F. 696, 698 (2d Cir. 1916).

[220] 175 F. 902 (2d Cir. 1910).

> *a play out of a story to represent a narrative by dialogue and action without making changes* . . . . Few short stories could be transformed into dramatic compositions without the addition of many new incidents.[221]

Yet, despite this recognition of a great variance in presentation between two media, most courts have not been persuaded to, in any way, modify the "audience test." Certainly, if in spite of the difference in medium, the ordinary observer spontaneously and immediately notes a substantial similarity, there should be a finding of infringement.[222] But if because of the camouflage of a different medium, the lay audience loses sight of the similarity, the fact remains that the plaintiff may have suffered a substantial appropriation of the fruits of his labor. In fact, the writer's loss is even greater when the appropriation is into a different medium, for here his work is made available to a new, untapped market, whereas if the infringing work were limited to the original medium, it would only attract the same people who already had had an opportunity to purchase the plaintiff's work. Thus, in this important area, the immediate and spontaneous observations of a person untrained in the special requirements and techniques of the play, the novel, the short story, the motion picture, and most especially, the computer,[223] may fail to note similarities that, if analyzed and dissected, would be only too apparent.[224]

Furthermore, quite apart from the additional complication of transformation into a different medium, there will still be numerous instances when the "ordinary observer" is simply not capable of detecting very real appropriation. The court, in *Harold Lloyd Corp.*

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221 *Id.* at 907 (emphasis added). See also Filmvideo Releasing Corp. v. Hastings, 509 F. Supp. 60 (S.D.N.Y. 1981), *aff'd*, 668 F.2d 91 (2d Cir. 1981).

222 Stonesifer v. Twentieth Century-Fox Film Corp., 48 F. Supp. 196 (S.D. Cal. 1942), *aff'd*, 140 F.2d 579 (9th Cir. 1944).

223 See § 13.03[E][4] *infra*.

224 "Although dissection and expert testimony is not favored, the judicially created ordinary observer test should not deprive authors of this significant statutory grant merely because the technical requirements of a different medium *dictate* certain differences in expression. Without deciding the question, we note that in some cases it may be important to educate the trier of fact as to such considerations in order to preserve the author's rights under the Copyright Act." Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607, 618 n.12 (7th Cir. 1982) (Treatise cited) (emphasis original), *cert. denied*, 459 U.S. 880 (1982). See also Atari, Inc. v. Amusement World, Inc., 547 F. Supp. 222 (D. Md. 1981); Midway Mfg. Co. v. Bandai-Am., Inc., 546 F. Supp. 125 (D.N.J. 1982).

v. Witwer,[225] denied liability, formulating the test as being if the ordinary observer were:

> *given an interval of two or three weeks* between a casual reading of [plaintiff's] story and a similar *uncritical* view of [defendant's work] it would not occur to such a spectator *in the absence of a suggestion to that effect* that he was seeing in motion picture form the story or any part of the story of [plaintiff's work].[226]

If what is to be protected is literary theft, and not the impression of literary theft *per se*, why, we may wonder, must the view be "uncritical," and why must there be no suggestion and pointing to similarity, if that suggestion would prove helpful to the trier in seeing that all or a part of plaintiff's work formed the basis for all or a part of defendant's work? Finally, why allow for an interval of two or three weeks, if we are interested in the theft, not the impression of theft? The court, in *McConnor v. Kaufman*,[227] suggested by implication that where a "play doctor" is employed to make the transformation, an ordinary observer would not observe that the one work was copied from the other, but a keen critic might. If the play doctor's literary surgery consists merely of clever juxtaposition and alteration of unessential details in the plaintiff's work, plus the addition of a substantial amount of new material so that the resulting product is unrecognizable by the untutored observer in his immediate and spontaneous impression, should it be said, as a matter of law, that no piracy has occurred? Such a principle renders the fruits of a writer's labor safe from all but the clever thieves.[228] In hewing to the requirement that the ordinary observer is to be guided by his spontaneous and immediate net impression, the courts do not indicate that similarities between the two works will necessarily be recognized in this manner. Indeed, *Harold Lloyd Corp. v. Witwer* further stated:

> Such similarities as exist between the play and the story, *and there are many*, are such as require analysis and critical comparison in

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[225] 65 F.2d 1 (9th Cir. 1933), *cert. dismissed*, 78 L. Ed. 1507 (1934).

[226] *Id.* at 27 (emphasis added).

[227] 49 F. Supp. 738, 745 (S.D.N.Y. 1943), *aff'd*, 139 F.2d 116 (2d Cir. 1943).

[228] Cf. Baxter v. MCA, Inc., 812 F.2d 421, 422 n.2 (9th Cir. 1987) (declining to consider plaintiff's argument that the "lay audience" test is unsatisfactory "in technical fields such as music because an infringer can easily deceive the unsophisticated by immaterial variations in the copyrighted work"), *cert. denied*, 484 U.S. 954 (1987).

order to manifest themselves.[229]

The court therefore concluded that the plaintiff could not recover. This case seems to present an excellent example of the unreasonable use to which the reasonable person standard has been put. The court admits that there are similarities (that for present purposes may be presumed to have been copied from the plaintiff's original expression), and yet because an ordinary observer could not note these similarities without a "critical" comparison, the plaintiff is rendered remediless.

[3]—Judicial Modification of the Audience Test. As the criticisms voiced in the preceding subsection adumbrate, the audience test is rife with difficulties as a matter of self-definition.[230] It is further unclear whether the doctrine serves any useful purpose, given the Supreme Court's formulation in *Feist*.[231] Nonetheless, to date, outright rejection of the audience test has been judicially frowned upon.[232] One federal district judge was reversed when he attempted the following such rejection:

> I must, as the trier of the facts, have a more Olympian viewpoint than the average playgoer. I must look at the two opposing productions, the Play and the Picture, not only comparatively, but, as it were, genealogically.[233]

Even some years after *Feist*, the audience test continues to be characterized as the governing standard across the various circuits.[233.1]

Nonetheless, an important modification of the audience test was formulated in *Arnstein v. Porter*,[234] wherein the court divided the issue

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[229] 65 F.2d 1, 28 (9th Cir. 1933) (emphasis added), *cert. dismissed*, 78 L. Ed. 1507 (1934).

[230] See § 13.03[E][2] *supra*.

[231] See § 13.03[E][1][b] *supra*.

[232] See Judge Lumbard's dissenting opinion, which takes the majority to task for failing to apply the "ordinary observer" test. Eden Toys, Inc. v. Marshall Field & Co., 675 F.2d 498, 501 (2d Cir. 1982) (Lumbard, J., dissenting). Indeed, even in the realm of computer software, for which the audience test is peculiarly ill-suited, courts have begun to abandon the test only with reluctance. See § 13.03[E][4] *infra*.

[233] Sheldon v. Metro-Goldwyn Pictures Corp., 7 F. Supp. 837, 842 (S.D.N.Y. 1934), *rev'd*, 81 F.2d 49 (2d Cir. 1936).

[233.1] Wildlife Express Corp. v. Carol Wright Sales, Inc., 18 F.3d 502, 508–09 & n.6 (7th Cir. 1994).

[234] 154 F.2d 464 (2d Cir. 1946). See also Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904 (3d Cir. 1975) (Treatise cited); Smith v. Little, Brown & Co., 245 F.

of substantial similarity into two separate elements. There is first the question of whether the defendant copied from the plaintiff's work. Assuming such copying is proven, there is then the second question of whether such copying went so far as to constitute an improper appropriation.[235] On the first question, it has been suggested that the two works are to be compared in their entirety, including both protectible and nonprotectible material.[236] Under the *Arnstein* doctrine,[236.1] in making such comparison, resort may properly be made to expert analysis[237] and dissection,[238] and not merely to the

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Supp. 451 (S.D.N.Y. 1965), *aff'd*, 360 F.2d 928 (2d Cir. 1966); Scott v. WKJG, Inc., 149 U.S.P.Q. 413 (N.D. Ind. 1966), *aff'd*, 376 F.2d 467 (7th Cir. 1967); Bevan v. Columbia Broadcasting Sys., Inc., 329 F. Supp. 601 (S.D.N.Y. 1971) ("In the areas of movies, plays, teleplays and written works, [the audience] 'test' has the weakness of avoiding the serious analysis virtually required under *Arnstein.*") (Treatise cited); McGraw-Hill, Inc. v. Worth Publishers, Inc., 335 F. Supp. 415 (S.D.N.Y. 1971); In Design v. Lynch Knitting Mills, Inc., 689 F. Supp. 176 (S.D.N.Y.), *aff'd mem.*, 863 F.2d 45 (2d Cir. 1988) ("I am unable to conclude that the ordinary observer would overlook the differences if they were not pointed out to her"); Uneeda Doll Co. v. Regent Baby Prods. Corp., 355 F. Supp. 438 (E.D.N.Y. 1972) (infringement may be found, although the differences between the two works are such that "one would not be mistaken for the other," as long as an observer would be convinced "that one depends on the other, that one has drawn from the other, not merely unimportant features but the purposive combination of features that . . . comprises a considerable part of its character and appeal").

235 See § 13.03[B] *supra.*

236 See Morse v. Fields, 127 F. Supp. 63 (S.D.N.Y. 1954); Weitzenkorn v. Lesser, 40 Cal. 2d 778, 256 P.2d 947 (1953). But cf. Golding v. R.K.O., 35 Cal. 2d 690, 221 P.2d 95 (1950); Consumers Union of U.S. v. Hobart, 199 F. Supp. 860 (S.D.N.Y. 1961).

236.1 Note that Computer Assocs. Int'l, Inc. v. Altai, Inc., 982 F.2d 693, 713 (2d Cir. 1992) (Treatise cited), beyond quoting the above text, significantly reformulates the Second Circuit's test for the admissibility of expert testimony in the context of analyzing substantial similarity between two computer programs. See §§ 13.03[E][4], 13.03[F] *infra.*

237 Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946); Scott v. WKJG, Inc., 376 F.2d 467 (7th Cir. 1967); Mattel, Inc. v. S. Rosenberg Co., 296 F. Supp. 1024 (S.D.N.Y. 1968) (expert evidence of general question of similarity admissible but only advisory); Stratchborneo v. Arc Music Corp., 357 F. Supp. 1393 (S.D.N.Y. 1973) (expert testimony admissible on issue of striking similarity such as to dispense with proof of access); Monogram Models, Inc. v. Industro Motive Corp., 492 F.2d 1281 (6th Cir. 1974) (admission of expert testimony does not usurp the function of the jury in determining similarity); Walker v. Time Life Films, Inc., 784 F.2d 44, 51-52 (2d Cir.), *cert. denied*, 476 U.S. 1159 (1986) (affirming summary judgment for defendant in which district judge considered affidavit of literary expert analyzing "the plot,

spontaneous and immediate impression of the ordinary observer. Similarity may not be shown however by an analysis that alters the actual sequence or construction of plaintiff's work in order to achieve a juxtaposition that makes for greater similarity with defendant's work.[239]

Once copying is established by such an overall comparison, then, on the issue of unlawful appropriation, the *Arnstein* doctrine would strictly apply the audience test and preclude dissection and expert analysis. This for the reason that once having established copying, the issue of *unlawful* appropriation amounts to a question "whether defendant took from plaintiff's works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such

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themes, structure, characters, and pace of both works"). See Original Appalachian Artworks, Inc. v. McCall Pattern Co., 649 F. Supp. 832, 836 (N.D. Ga. 1986), *aff'd*, 825 F.2d 355 (11th Cir. 1987); West Publishing Co. v. Lawyers Coop. Publishing Co., 79 F. 756 (2d Cir. 1897). It has been held that it is not an abuse of discretion to permit the plaintiff to offer his opinion as to the similarities that exist as between his and the defendant's works. Miller v. Universal City Studios, Inc., 650 F.2d 1365 (5th Cir. 1981).

238 Walker v. Time Life Films, Inc., 784 F.2d 44, 52 (2d Cir.), *cert. denied*, 476 U.S. 1159 (1986) ("it might be an abuse of discretion to bar a plaintiff from using [a list of similarities] in arguing on a summary judgment motion"), which is also discussed further in N. 239 *infra*. Litchfield v. Spielberg, 736 F.2d 1352, 1356 (9th Cir. 1984), while acknowledging that lists of similarities are sometimes used for "illustrative purposes", voiced the opinion that such lists are "inherently subjective and unreliable", particularly where "the list emphasizes random similarities scattered throughout the works." For the thesis that literary analysis "may be an inadequate tool, at best, when applied in a case involving motion pictures and television programs," and the suggestion of a supplemental standard in such cases, see Berman and Boxer, *Copyright Infringement of Audiovisual Works and Characters*, 52 S. Cal. L. Rev. 315 (1979).

239 Warner Bros., Inc. v. American Broadcasting Cos., 654 F.2d 204 (2d Cir. 1981) (Treatise quoted); Walker v. Time Life Films, Inc., 784 F.2d 44, 52 (2d Cir.), *cert. denied*, 476 U.S. 1159 (1986) (upholding district court's refusal to view a "voiceover" version of defendant's movie, compiled by plaintiff for the litigation); Arnstein v. Twentieth Century-Fox Film Corp., 52 F. Supp. 115 (S.D.N.Y. 1943); McMahon v. Prentice-Hall, Inc., 486 F. Supp. 1296 (E.D. Mo. 1980) (compiling "widely scattered passages" does not establish substantial similarity); Olson v. National Broadcasting Co., 855 F.2d 1446, 1450 (9th Cir. 1988) (condemning use of "random similarities scattered throughout the work"). See also Gund, Inc. v. Russ Berrie & Co., 701 F. Supp. 1013, 1021 (S.D.N.Y. 1988) ("good eyes and common sense may be as useful as deep study of reported and unreported cases, which themselves are tied to highly particularized facts"); Trousseau Monogram Corp. v. Saturday Knight Ltd., 16 U.S.P.Q.2d 1079, 1080 (S.D.N.Y. 1990).

popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff." This, the *Arnstein* court concluded, is "an issue of fact which a jury is peculiarly fitted to determine."[240] The issue of improper or unlawful appropriation posited in *Arnstein* was thereafter characterized by the same court as "merely an alternative way of formulating the issue of substantial similarity."[241]

In *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*,[242] the Court of Appeals for the Ninth Circuit, building upon the *Arnstein* doctrine,[243] articulated a bifurcated test for infringement that, in some ways, appears to go farther than that in *Arnstein.*[244] Under *Krofft*, there are again two steps in the analytic process.[245]

First, there is the issue of whether there is substantial similarity as to the "general ideas" contained in the two works. This is to be resolved by what the *Krofft* court labels the "extrinsic test," in that this determination turns "not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed." These criteria are said to include not only "the subject matter, and the setting for the subject," which do go to the issue of idea similarity, but also (more questionably) "the type of artwork involved, [and] the materials

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[240] But cf. Atari, Inc. v. North Am. Philips Consumer Elecs. Corp., 672 F.2d 607 (7th Cir. 1982), which, in considering this second *Arnstein* issue, reversed the district court on the ground that the appellate court is in as good a position as the trial court to decide issues of substantial similarity.

[241] Ideal Toy Corp. v. Fab-Lu, Ltd., 360 F.2d 1021 (2d Cir. 1966). It has been said that "the [*Arnstein*] two steps . . . seem to have been merged into the single lay-observer test for substantial similarity." Ideal Toy Corp. v. Kenner Prods., 443 F. Supp. 291, 303 (S.D.N.Y. 1977).

[242] 562 F.2d 1157 (9th Cir. 1977).

[243] The *Krofft* opinion states: "We do not resurrect the *Arnstein* approach today. Rather, we formulate an extrinsic-intrinsic test for infringement based on the idea-expression dichotomy. We believe that the *Arnstein* court was doing nearly the same thing. But the fact that it may not have been does not subtract from our analysis." 562 F.2d at 1165 n.7.

[244] In the briefs on appeal, the Kroffts cited *Arnstein* for the proposition that where, as in the instant case, copying is not disputed, on the issue of improper appropriation, dissection and analysis are improper. This writer was attorney for the Kroffts on appeal.

[245] In Kamar Int'l, Inc. v. Russ Berrie & Co., 657 F.2d 1059 (9th Cir. 1981), the paragraph that follows is quoted in substantial part, and is said correctly to state the *Krofft* test. See also Berkic v. Crichton, 761 F.2d 1289 (9th Cir. 1985).

used."[246] In applying the extrinsic test, the *Krofft* court concluded that "analytic dissection and expert testimony are appropriate." Having found such idea similarity, the second step in the analytic process requires that the trier of fact then decide "whether there is substantial similarity[246.1] in the expressions of the ideas so as to constitute infringement."[246.2] This is to be determined by what *Krofft* labels the "intrinsic test," in that it depends "on the response of the ordinary reasonable person." In applying the intrinsic test, "analytic dissection and expert testimony" are said to be "not appropriate."[247]

The effect of the *Krofft* bifurcated test is to expand the domain of the trier of fact, and greatly to contract the role of the court, at least in its power to rule for the defendant as a matter of law. It is true that *Krofft* concludes that the extrinsic test "may often be decided as a matter of law;" however, because the only issue under this test is that of idea similarity, and because in almost all copyright litigation, the plaintiff will not file an action unless there is, at a minimum, some similarity of ideas,[248] under *Krofft*, a court will rarely[249] have the

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[246] Contrary to the court's formulation, it seems clear that two works may embody the same idea, and even the same expression, although executed in different media. See § 8.01[B] *supra*.

[246.1] When the issue is determining the scope of copyright protection rather than substantial similarity, *Krofft* has been held inapplicable. FASA Corp. v. Playmates Toys, Inc., 869 F. Supp. 1334, 1347 n.19, 1352–53 (N.D. Ill. 1994) (Treatise cited).

[246.2] Shaw v. Lindheim, 919 F.2d 1353, 1358 (9th Cir. 1990) (Treatise quoted).

[247] *Krofft* was followed in this regard outside the Ninth Circuit in Hartman v. Hallmark Cards, Inc., 833 F.2d 117, 120 (8th Cir. 1987); Davis v. United Artists, Inc., 547 F. Supp. 722 (S.D.N.Y. 1982). By contrast, the Ninth Circuit has begun to retreat from the audience test, as set forth below. And even applying *Hartman*, one court dismissed because "reasonable minds could not differ as to the absence of substantial similarity . . . ." Banker's Promotional Marketing Group, Inc. v. Orange, 926 F.2d 704, 705 (8th Cir. 1991).

[248] Idea similarity *simpliciter* is inadequate to show substantial similarity. See § 13.03[B][2][a] *supra*. It is to be noted that *Krofft*, in invoking the extrinsic test, referred to it as a test to determine "similarity in ideas." Some courts have erroneously interpreted this to require a comparison of *the* idea in each work, as if each work carries but a single core idea—a sort of Platonic essence. See, *e.g.*, Twentieth Century-Fox Film Corp. v. MCA, Inc., 209 U.S.P.Q. 200 (C.D. Cal. 1980), *rev'd*, 715 F.2d 1327 (9th Cir. 1983); Columbia Pictures Indus., Inc. v. Embassy Pictures, 218 U.S.P.Q. 497 (C.D. Cal. 1982). See § 13.03[F][1] *infra*. Under *Krofft*, any idea that is found in both plaintiff's and defendant's works is sufficient to satisfy the extrinsic test. Of course, this will not constitute infringement, unless it is further found that there is substantial similarity in the expression of that idea, under the intrinsic test.