

THE FILTRATION PROBLEM IN COPYRIGHT'S "SUBSTANTIAL SIMILARITY" INFRINGEMENT TEST

by

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Copyright protects original artistic and literary expression. It does not protect ideas, facts, or other elements that may be found in artistic and literary works but which Section 102(b) of the Copyright Act, or the judge-made merger and scènes à faire doctrines, place outside the scope of copyright protection. The principle that copyright protects expression but not ideas is easy enough to articulate, but actually implementing it in copyright infringement litigation is considerably more difficult.

This Article focuses not on the theory of idea/expression boundary-setting, but on the mechanics. In particular, how can we make sure that the distinction between protectable expression and unprotectable ideas is faithfully reflected in infringement verdicts? To implement the copyright infringement standard, judges typically engage in a process of "filtration," by which they separate out ideas and other unprotectable elements of a work. But this procedure does not, by itself, ensure that the idea/expression distinction plays its intended role in the ultimate decision regarding infringement, especially when that decision is made by a jury. If the court's initial filtration is to have any role in ensuring that infringement is found only on the basis of similarity of protected elements, the jury must be instructed regarding the elements of the works at issue that are protected by copyright and those that are not. But in some cases, instructions may not be enough. To ensure that the idea/expression distinction is reflected faithfully, the jury must be able to replicate and apply the court's filtration in reaching its verdict. As it stands today, the ways courts have formulated the infringement standard in copyright litigation actively undermines this critical obligation of the jury, encouraging jurors to consider unprotectable elements in their ultimate determinations.

Part III sets out some measures that courts could take to more effectively communicate to juries the boundary between protected and unprotected elements in particular infringement cases. We will caution up front that it is unlikely

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that our recommendations, either singly or if implemented together, will eliminate a problem that seems endemic to our current copyright law, and a more dramatic change to the infringement standard may be required. The idea/expression distinction is likely to be systematically underenforced so long as juries are encouraged to use intuition rather than discernment in deciding about infringement—even if courts do a better job than they do now of providing juries with the instructions and other resources necessary for them to implement the idea/expression distinction.

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INTRODUCTION

“That a particular leg of mutton is mine is capable of easy proof or disproof, but how much of my book is mine is a nice question.”

—Augustine Burrell, *Copyright in Books* (1899)

Copyright protects original artistic and literary expression. It does not protect ideas, facts, or any of the other elements that may be found in artistic and literary works but which Section 102(b) of the Copyright Act,¹ or the judge-made merger²

¹ 17 U.S.C. § 102(b) (2012) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work”); *see also* Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 556 (1985) (explaining that “copyright’s idea/expression dichotomy strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author’s expression.”) (internal citation omitted).

² Particular expression that represents the only—or one of only a few ways—to express an underlying idea is said to have “merged” with that idea and is excluded from protection. *See, e.g.,* Morrissey v. Procter & Gamble Co., 379 F.2d 675, 678–79 (1st Cir. 1967) (“When the uncopyrightable subject matter is very narrow, so that ‘the topic necessarily requires’ . . . if not only one form of expression, at best only a limited number, to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance. In such circumstances it does not seem accurate to say that any particular form of

and *scènes à faire*³ doctrines, place outside the scope of copyright protection. Regardless of whether the exclusion is based in Section 102(b) or in the judge-made doctrines, similarities in elements of a work that are outside the scope of copyright protection cannot be the basis for copyright infringement liability.

That principle is easy enough to articulate, but actually implementing it in copyright infringement litigation is considerably more difficult. Protected expression and unprotected elements (ideas, facts, etc.) are mixed in every copyrighted work. As a consequence, judging copyright infringement requires that lines be drawn. As Judge Hand famously noted of the enterprise of partitioning unprotectable ideas and protected expression, “[n]obody has ever been able to fix that boundary, and nobody ever can.”⁴ And yet someone *must* fix the boundary in particular infringement cases.

This Article focuses not on the theory of idea/expression boundary-setting, but on the mechanics. In particular, how can we make sure that someone actually does the job of setting the idea/expression boundary in particular infringement cases and that the distinction between protectable expression and unprotectable ideas is faithfully reflected in infringement verdicts? How, in other words, can we make sure that juries—for it is juries that decide most copyright cases—make findings of infringement that reflect similarities in protected expression, and not similarity of ideas, facts, or other elements excluded from copyright protection?

This is a pressing concern for two reasons. The first has to do with the way in which courts have articulated the standard by which copyright infringement is ultimately assessed. Juries (and judges in bench trials) assess infringement according to a *lay listener/lay observer* standard.⁵ According to this approach to copyright infringement claims, the ultimate decision as to whether a defendant has infringed is made

expression comes from the subject matter. However, it is necessary to say that the subject matter would be appropriated by permitting the copyrighting of its expression. We cannot recognize copyright as a game of chess in which the public can be checkmated.” (internal quotations and citations omitted).

³ Particular expression that is stock or usual in covering a certain theme—for example, depicting a superhero as wearing a cape—is excluded as *scènes à faire* (i.e., as “scenes that must be done”). See, e.g., *Gates Rubber Co. v. Bando Chemical Indus., Ltd.*, 9 F.3d 823, 838 (10th Cir. 1993) (hardware standards and mechanical specifications, software standards and compatibility requirements, computer manufacturer design standards, target industry practices and demands, and computer industry programming practices held unprotectable *scènes à faire* for computer program); *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50 (2d Cir. 1986) (scenery including drunks, stripped cars, prostitutes, and rats held unprotectable *scènes à faire* in film about police in the South Bronx).

⁴ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

⁵ See, e.g., *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (describing the standard as involving whether an ordinary observer, “unless he set out to detect the disparities [between the works], would be disposed to overlook them, and regard their aesthetic

by reference to the holistic impression of an ordinary, non-expert listener (in the case of music) or observer (for visual works).⁶ The question is whether such a lay listener or observer would conclude that the defendant has taken too much from the plaintiff's work.⁷ But relying on the holistic impression of an ordinary listener or observer is precisely the sort of approach least likely to respect the boundary between unprotectable ideas and protected expression. Most ordinary people experience most works without making fine distinctions. The lay listener or lay observer will notice similarities or differences but is unlikely to take the further step of separating the similarities into those that are legally relevant to infringement and those that are not.

The second cause for concern arises from the fact that most copyright infringement trials are *jury* trials.⁸ This means that for the idea/expression distinction to play a role in verdicts, juries must somehow be made aware of the lines—often difficult to draw or even articulate—between protected expression and ideas, facts, and other elements that copyright law does not protect.

To implement the copyright infringement standard, courts have developed several variants of a procedure, described in Part II of this Article, for ensuring that some consideration is given to separating ideas and other unprotectable matter from protectable expression. Judges typically engage in a process of “filtration,” by which they separate out ideas and other unprotectable elements of a work.⁹ Undertaken most often at the summary judgment stage of copyright infringement litigation, the filtration process starts by identifying the unprotectable elements of the plaintiff's and defendant's works.¹⁰ The court then asks whether a reasonable factfinder could find infringement based on similarities in the protectable material that remains.¹¹ If the answer is no, the court will grant summary judgment to the defendant. But if the answer is yes—if enough similarities in protected material remain to allow a reasonable jury to find infringement—the court will turn the case over to the jury.

This procedure is useful as a way to efficiently dispose of obviously losing copyright claims that are based entirely (or nearly entirely) on unprotected elements.

appeal as the same”); *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946) (describing the standard as involving “whether defendant took from plaintiff's works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff”).

⁶ *Peter Pan Fabrics, Inc.*, 274 F.2d at 489.

⁷ *Id.*

⁸ The Sixth Amendment of the Constitution guarantees a right to trial by jury for civil matters. U.S. CONST. amend. VI; *see also* William Patry, *The Right to a Jury in Copyright Cases*, 29 J. COPYRIGHT SOC'Y U.S.A. 139, 145 (1981).

⁹ *Gates Rubber Co. v. Bando Chemical Indus., Ltd.*, 9 F.3d 823, 834 (10th Cir. 1993).

¹⁰ *Id.* at 836.

¹¹ *Id.* at 833.

But it does not, by itself, ensure that the idea/expression distinction plays its intended role in the jury's ultimate decision regarding infringement. If the court's initial filtration is to have any role in ensuring that infringement is found only on the basis of similarity of *protected* elements, that information must somehow be communicated to the jury. In other words, the jury must be instructed regarding the elements of the works at issue that are protected by copyright and those that are not. But in some cases, instructions may not be enough. To ensure that the idea/expression distinction is reflected faithfully, the jury must be able to replicate and apply the court's filtration in reaching its verdict.

This second concern—the difficulty of communicating to the jury the results of the court's filtration analysis—arises in copyright cases across all types of copyrightable subject matter. This problem may be more tractable for some categories of works and less for others. For example, in cases involving textual works, similarities in elements such as theme, setting, and stock characters may be subject to filtration. And at least in the case of textual works, separating out those elements, once identified, is often (although not always) relatively straightforward. For example, once a character in a plaintiff's textual work is found to be “stock,” the court can instruct the jury to ignore similarities between the plaintiff's and defendant's works that relate to that stock character. Consider, however, the special difficulties of implementing the idea/expression distinction in infringement cases involving musical compositions. Virtually all jurors lack formal musical training and are therefore likely to have a particularly hard time identifying and separating out unprotected elements of a composition's melody, harmony, genre, chord structure, or rhythm, even if presented with instructions that list the elements of the works at issue that are unprotected by copyright.

To give an example, imagine a case involving a musical composition in the blues genre. The defendant's composition shares with plaintiff's composition both the same musical key and a similar “walking” bass line. The bass line may well be *scènes à faire*, as walking bass lines are very common in the blues genre, and compositions in the same key are likely to feature similar walking bass lines because many blues songs are based on the same “1/4/5” chord structure.¹² But for jurors to appreciate this, they first need to have some sense of the common musical elements in the genre. Then the jurors must be able to pick out the bass line from other elements in the plaintiff's and defendant's compositions. Further, the jury must be able to make its ultimate infringement determination while setting aside the similarities in the bass lines. They must, in a sense, “un-hear” that similarity. All of this is likely to be very difficult for a lay jury to accomplish.

¹² *How to Play the Blues: Chords, Patterns and Fills for Major and Minor Blues*, GUITARPLAYER MAG. (Aug. 23, 2018), <https://www.guitarplayer.com/technique/how-to-play-the-blues-chords-patterns-and-fills-for-major-and-minor-blues>.

At the very least, for the jury to consider and implement the idea/expression distinction in its verdict, it must have access to the results of the court's filtration analysis—i.e., it must understand the court's account of which elements of copyrighted expression count in the infringement analysis and which elements (ideas, facts, methods, merged and *scènes à faire* material, elements drawn from the public domain, etc.) don't count. But access to instructions that include lists of excluded elements may, in some cases, not be enough for the jury to actually implement the court's analysis in reaching its verdict. The jury may require further help if it is to understand and execute the court's instructions.

Part II of this Article assays the various closely-related procedures for assessing infringement that are in use today in federal courts and assesses the degree to which their application may result in condemnation as infringement copying that involves, in whole or in principal part, unprotected material. Part III sets out some corrective measures that courts could take to reduce the likelihood that a jury will impose infringement liability based on similarity of unprotected elements. We will caution up front that it is unlikely that our recommendations, either singly or if implemented together, will eliminate a problem that seems endemic to our current copyright law. The idea/expression distinction is likely to be systematically underenforced so long as juries are encouraged to use intuition rather than discernment in deciding about infringement—even if courts do a better job than they do now of providing juries with the instructions and other resources necessary for them to implement the idea/expression distinction. With those limited ambitions in mind, let us proceed.

I. COPYRIGHT INFRINGEMENT TESTS IN FEDERAL COURTS

The Copyright Act is oracular on what counts as infringement. Section 501 of the statute sets up a tautology, providing that “[a]nyone who violates any of the exclusive rights of the copyright owner . . . is an infringer of the copyright”¹³ What it means to “violate[]” an exclusive right of a copyright owner—in particular, the amount of copying necessary before someone is judged an infringer—is left undefined.

In the absence of statutory guidance, courts have done the work of specifying the elements of the *prima facie* case that a plaintiff alleging copyright infringement must prove: (1) ownership of the copyright in the work at issue, that the defendant (2) actually copied from the plaintiff's work, and that the defendant (3) copied

¹³ 17 U.S.C. § 501 (2012).

enough of the protected elements of the plaintiff's work such that there is "substantial similarity" between the two works.¹⁴

Of these elements of the plaintiff's prima facie case, it is only the third that interests us here. Proving ownership is usually straightforward; the Copyright Act requires U.S. authors to register their copyright claim prior to bringing an infringement action,¹⁵ and proof of ownership ordinarily requires nothing more arduous than production of the registration certificate showing plaintiff as owner.¹⁶ In contrast, the question of how factfinders should assess whether a defendant actually copied from a plaintiff, as opposed to independently creating similar material, is rich with complexities. We shall nonetheless leave it aside. Our focus here is on the mechanics of the third element of the plaintiff's prima facie case—i.e., whether, assuming that actual copying is proven, the copying is of elements of the plaintiff's work that are protected by copyright and thus relevant to the factfinder's determination of whether the copying rises to the level of "substantial similarity" that triggers liability for copyright infringement.

A. *The "Ordinary Observer" Test*

In its basic formulation, the test for substantial similarity asks, as Judge Hand put it in a formulation still frequently invoked, whether "the ordinary observer, unless he set out to detect the disparities [in the two works], would be disposed to overlook them, and regard their aesthetic appeal as the same."¹⁷ Thus, substantial similarity is, at its essence, a test that relies on the impression of an ordinary observer, and that observer, as the summation supposes, is a person who does not "set out to detect . . . disparities."¹⁸ The test models the ordinary observer, or ordinary listener, as forming a holistic impression of the works at issue, and judging similarity on that ground. But to align with the Copyright Act, the test cannot rely *entirely* on holistic impressions. In instances where a work involves a mix of protected and unprotected elements, as is true in virtually every case, the test must guard against false positives that may occur if an ordinary observer perceives a similarity that is largely or wholly due to the presence in the defendant's work of *unprotected* elements similar to those in the plaintiff's work.

For that reason, the ultimate test for copyright infringement is sometimes reformulated to ask "whether a 'lay-observer' would believe that the copying was of

¹⁴ See, e.g., *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991); *Rentmeester v. Nike, Inc.*, 888 F.3d 1111, 1116–17 (9th Cir. 2018); *Positive Black Talk, Inc. v. Cash Money Records, Inc.*, 394 F.3d 357, 367 (5th Cir. 2004).

¹⁵ See 17 U.S.C. § 411 (2008).

¹⁶ See 4 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 13.01[A] (Matthew Bender rev. ed. 2018).

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

¹⁸ *Id.*

protectable aspects of the copyrighted work.”¹⁹ The Seventh Circuit has offered perhaps the best formulation of this refined lay observer test: “Specifically, the test is whether the accused work is so similar to the plaintiff’s work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff’s *protectable expression* by taking material of substance and value.”²⁰

But the reformulation, while helpful, does not itself implement the idea/expression distinction. Even where the infringement standard focuses on similarity that arises from the defendant’s replication of the plaintiff’s protected expression, the jury must be able to understand that distinction and execute the mandate. The false positives problem will persist unless the jury is able to apply the “lay observer” test in a way that identifies the elements of the plaintiff’s work that are protected and assess similarity between the plaintiff’s and defendant’s works only with reference to those protected elements. Accomplishing that in copyright litigation requires not simply the correct words; it requires the correct process.

B. *The Process of Determining Substantial Similarity*

The “Extrinsic/Intrinsic” Approach. There are three major approaches in use in federal courts to determine substantial similarity. The most extensively developed is the extrinsic/intrinsic approach, pioneered in the Ninth Circuit²¹ and later adopted by the Fourth and Eighth Circuits.²² The extrinsic/intrinsic approach structures the substantial similarity inquiry into two segments. The first implements a so-called “extrinsic” test, in which the court, typically in the context of a motion for summary judgment by the defendant (and perhaps a cross-motion for summary judgment by the plaintiff) identifies elements that are protectable or unprotectable and decides whether there is sufficient similarity among protectable elements to proceed with the trial.

Initially, the Ninth Circuit defined the extrinsic test as a “test for similarity of ideas” under which “analytic dissection and expert testimony are appropriate.”²³ That is, of course, an error—§ 102(b) of the Copyright Act makes clear that “similarity of ideas” is not grounds for copyright infringement liability.²⁴ The Ninth Circuit clarified its approach in *Shaw v. Lindheim*, holding that the extrinsic test “can

¹⁹ *Dam Things from Den. v. Russ Berrie & Co.*, 290 F.3d 548, 562 (3d Cir. 2002) (emphasis added).

²⁰ *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982) (emphasis added).

²¹ *Sid & Marty Krofft TV Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

²² *Towler v. Sayles*, 76 F.3d 579, 583–84 (4th Cir. 1996); *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120 (8th Cir. 1987).

²³ *Krofft TV Prods., Inc.*, 562 F.2d at 1164.

²⁴ See 17 U.S.C. § 102(b) (2012) (“In no case does copyright protection for an original work

no longer be seen as a test for mere similarity of ideas,” but rather is “more sensibly described as objective . . . analys[is] of *expression*.”²⁵

Following the Ninth Circuit’s self-correction, the question that the court addresses in the extrinsic analysis is whether there is enough similarity in *protected elements* of the plaintiff’s and defendant’s works that a reasonable jury could find that the defendant’s work is substantially similar to the plaintiff’s. For example, in *Cavalier v. Random House, Inc.*, the Ninth Circuit directed that “a court must take care to inquire only whether the *protectable elements, standing alone*, are substantially similar. Therefore, when applying the extrinsic test, a court must filter out and disregard the non-protectable elements in making its substantial similarity determination.”²⁶

That said, it is important to note that the extrinsic test, even in its corrected form, is a very rough filter. The extrinsic test ends an infringement case only when the similarities between the plaintiff’s and defendant’s works are either wholly due to unprotected elements, or where the amount of similar protected expression is *de minimis* as a matter of law. Weak copyright claims can readily pass through the permeable membrane of the extrinsic test. It may be that the judge believes, after identifying and disregarding similarities in unprotected elements, that a jury should find for the defendant. But the question isn’t what the jury *should* find. The question is whether a reasonable jury *must* find for the defendant. If the court believes that a reasonable jury *could* find for the plaintiff based only on similarities in protected elements, then the extrinsic analysis concludes, and the case is sent to the jury to perform its “intrinsic” analysis.

In the intrinsic test, members of the jury decide as lay observers whether there is substantial similarity in the “total concept and feel” of the works in question.²⁷ In *Shaw*, the Ninth Circuit made clear that the intrinsic test should measure “substantial similarity in expressions . . . depending on the response of the ordinary reasonable person. . . . [I]t does not depend on the type of external criteria and analysis which marks the extrinsic test.”²⁸ Accordingly, in decisions under the intrinsic test, “analytic dissection and expert testimony are not appropriate.”²⁹ Indeed, the ultimate liability determination under the intrinsic test, as the Ninth Circuit stated in

of authorship extend to any idea . . .”).

²⁵ *Shaw v. Lindheim*, 919 F.2d 1353, 1357 (9th Cir. 1990) (emphasis added).

²⁶ *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822–23 (9th Cir. 2002) (internal citations omitted).

²⁷ *See id.* at 822 (citation omitted); *see also Krofft TV Prods., Inc.*, 562 F.2d at 1164–1165; *Roth Greeting Cards Co. v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970).

²⁸ *Shaw*, 919 F.2d at 1356 (quoting *Krofft TV Prods., Inc.*, 562 F.2d at 1164).

²⁹ *Id.*

Shaw, is “now virtually devoid of analysis, for the intrinsic test has become a mere subjective judgment as to whether two . . . works are or are not similar.”³⁰

At this point, it should be plain that the extrinsic/intrinsic approach is not designed to ensure that the jury applies the idea/expression distinction in reaching its ultimate infringement verdict. The extrinsic test gives the distinction only minimal consideration; if there is any prospect that a reasonable jury could find infringement based on protected elements, then the court will deny a defendant’s summary judgment motion. The jury is left to use its subjective judgment, often (as we shall see) without instructions designed to steer that judgment away from finding infringement based, in whole or in part, on similarity of elements of the plaintiff’s and defendant’s works that are unprotected by copyright. And the Ninth Circuit’s particular formulation of the intrinsic test—i.e., that the jury should inquire whether there is substantial similarity in the “total concept and feel” of the works in question—makes matters worse. The formulation quite palpably invites the jury, in exercising its subjective judgment, to include similarities in ideas and other elements of works that the idea/expression distinction places outside the scope of copyright. Indeed, the test specifically directs the factfinder to look for similarities in the works’ “total concept,” although “concept” is one of the elements that § 102(b) of the Copyright Act explicitly identifies as unprotectable by copyright.³¹ And a work’s “feel” (the term is intractably imprecise) can arise from any element, including from unprotectable ideas, general styles and themes, and even common elements in the plaintiff’s and defendant’s works that are *scènes à faire* or taken from the public domain.

Can these problems be addressed? We will consider that question more fully in Part III of this Article. For the moment, we can note two things. First, the structure of the extrinsic/intrinsic approach encourages precisely what the idea/expression distinction prohibits. Second, while the infirmities of the approach may be mitigated by providing the jury with guidance that encourages and enables them to apply their subjective judgment in the intrinsic test only to similarities in protectable elements, there is nothing in the courts’ articulation of the extrinsic/intrinsic approach that requires or even suggests that such guidance must be provided to the jury.

³⁰ *Id.*; see also *Olson v. Nat’l Broad. Co., Inc.*, 855 F.2d 1446, 1443 (9th Cir. 1988) (reaching a result under the intrinsic test in one paragraph); *Berkic v. Chrichton*, 761 F.2d 1289, 1294 (9th Cir. 1985) (same).

³¹ 17 U.S.C. § 102(b) (2012) (“In no case does copyright protection for an original work of authorship extend to any . . . concept . . .”).

The Unified Ordinary Observer Approach. The Second Circuit’s “unified ordinary observer” approach,³² which has also been adopted by the First,³³ Third,³⁴ Fifth,³⁵ Seventh,³⁶ and (inconsistently) Eleventh³⁷ Circuits, combines the two prongs of the extrinsic/intrinsic approach into a single inquiry. One benefit of this format is that there is (for the most part) a single party—either the judge or the jury—performing all of the analysis, which makes it easier for information to flow from one part of the analysis to the next. That said, the standard by which the factfinder is instructed to reach its verdict is virtually identical to that employed in the Ninth Circuit’s intrinsic approach. The test to prove infringement of another’s copyright asks whether “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.”³⁸ In undertaking that analysis, the factfinder is invited to assess the similarities between the plaintiff’s and defendant’s works according to the works’ “overall look and feel.”³⁹

As with the Ninth Circuit’s extrinsic/intrinsic test, this formulation invites the jury to consider unprotectable elements in its infringement analysis. Both “look” and “feel” are imprecise terms, at least when used to describe artistic and literary works. But it’s clear enough that both terms can embrace elements of a work that are not protected by copyright. For example, a painting’s “look” might be determined in part by the work’s genre; many abstract geometric works look at least somewhat alike. Similarly, a song’s “feel” may be genre-related; all meringue songs mesh with the same dance moves. But “genre” is too abstract a quality to be copy-

³² *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946). Note that the “unified ordinary observer” approach label is ours. We use it to distinguish the procedures that the Second Circuit employs for judging infringement from the “ordinary observer” criterion for proving substantial similarity—which is itself a part of the unified ordinary observer approach, but only a part.

³³ *O’Neill v. Dell Pub. Co.*, 630 F.2d 685, 687 (1st Cir. 1980).

³⁴ *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975).

³⁵ *Peel & Co., Inc. v. The Rug Mkt.*, 238 F.3d 391, 398 (5th Cir. 2001).

³⁶ *Wildlife Express Corp. v. Carol Wright Sales, Inc.*, 18 F.3d 502, 508–09 (7th Cir. 1994) (citing *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982)).

³⁷ *See, e.g., Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 829 (11th Cir. 1982). While the Eleventh Circuit has used the Second Circuit’s unified ordinary observer approach, it has also approved, in one case, of a district court’s use of the Ninth Circuit’s extrinsic/intrinsic approach. *See Herzog v. Castle Rock Entm’t*, 193 F.3d 1241, 1257 (11th Cir. 1999).

³⁸ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960); *see also Walker v. Time Life Films, Inc.*, 784 F.2d 44, 51 (2d Cir. 1986).

³⁹ *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003 (2d Cir. 1995) (“It is commonplace that in comparing works for infringement purposes—whether we employ the traditional ‘ordinary observer’ test or the *Folio Impressions* ‘more discerning’ inquiry—we examine the works’ ‘total concept and feel.’” (quoting *Eden Toys, Inc. v. Marshall Field & Co.*, 675 F.2d 498, 500 (2d Cir. 1982))).

righted. For these reasons, the Second Circuit's formulation, like the Ninth Circuit's, undermines the statutory mandate to base infringement only on protectable elements.⁴⁰

It is important to note that the Second Circuit has attempted, inconsistently, to give the idea/expression distinction a greater role in the infringement analysis in cases where the works at issue contain a substantial amount of material taken from the public domain. In such cases, the Second Circuit has sometimes diverted to a "more discerning observer test," one in which the judge or jury making an infringement decision removes unprotectable elements first and then looks for similarity in the overall look and feel.⁴¹ For example, in *Folio Impressions, Inc. v. Byer California*—a case involving a fabric pattern consisting, in part, of a repeated, linear pattern copied from a public domain source—the Court of Appeals held that the infringement decision must be based only on protectable elements, after factoring out unprotectable elements.⁴² Shortly after the decision in *Folio Impressions*, the Second Circuit reiterated in *Key Publ'ns, Inc. v. Chinatown Today Publ'g Enters., Inc.* (a case involving alleged infringement of a compilation—specifically, a yellow pages directory) that a "more refined analysis" is required where a plaintiff's work incorporates elements from the public domain.⁴³ In these instances, the Second Circuit stated, "[w]hat must be shown is substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation."⁴⁴

There are two limitations, however, that constrain the Second Circuit's use of the "more discerning observer" test. First, it is framed explicitly as a test applicable

⁴⁰ The Second Circuit has been inconsistent with its statement of the unified ordinary observer test's standard. For example, in *Boisson v. Banian*, one of the Second Circuit cases most frequently cited for the formulation of the test, the court in fact uses three different variations: "overall look and feel," "total concept and overall feel," and "total concept and feel." 273 F.3d 262, 266, 272–73 (2d Cir. 2001). All of these formulations present the same difficulties.

⁴¹ District courts in the Fifth Circuit have also begun to adopt the "more discerning observer" test. See *Batiste v. Najm*, 28 F. Supp. 3d 595, 605 (E.D. La. 2014) ("Although the *Altai* test has not been extensively employed in its pure form outside the realm of computer programming and other highly technical subject matters, courts throughout the country have borrowed from its structure to add a threshold 'filtering' step to the traditional lay 'ordinary observer' test in cases where the plaintiff's work contains both protected and unprotectable elements. The Second Circuit refers to this filtering approach as a 'more discerning ordinary observer' test.") (internal citations omitted); see also *R. Ready Prods., Inc. v. Cantrell*, 85 F. Supp. 2d 672, 683 (S.D. Tex. 2000) (adopting the more discerning observer test); *Galiano v. Harrah's Operating Co.*, 2000 U.S. Dist. LEXIS 17258, at *10 (E.D. La. Nov. 21, 2000) (adopting the more discerning observer test).

⁴² See *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 765–66 (2d Cir. 1991).

⁴³ *Key Publications, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991).

⁴⁴ *Id.*

only when the plaintiff's work contains substantial material *taken from the public domain*.⁴⁵ The Second Circuit conceives of the test, in other words, as applying in a limited number of special cases, rather than as a generally-applicable method for ensuring that the idea/expression distinction is faithfully applied in reaching infringement verdicts.

Second, and relatedly, it is notable how reluctant the Second Circuit has been to apply the test. In *Knitwaves, Inc. v. Lollytogs, Ltd.*, the Second Circuit appeared to retreat from the test, describing *Folio Impressions* as involving “rather specialized facts,” and echoing a concern first expressed by the district court in that case that too much discernment in the infringement analysis (i.e., looking only at elements of the work that would themselves be copyrightable) would lead to the absurd result that “there can be no originality in a painting because all colors of paint have been used somewhere in the past.”⁴⁶ This is a particularly weak use of *reductio ad absurdum*, and also a basic misunderstanding of the protectable element of expression that may be found in a painting, but whatever the merits of the argument, the Second Circuit does appear to have backed away from the “more discerning observer” test.

The Second Circuit continued to diminish the scope of the more discerning test in *Boisson v. Banian*, blurring, in that case, the distinction between that test and the “total concept and feel” (or “overall look and feel”) test.⁴⁷ In *Boisson*, the Second Circuit reversed a district court's ruling, in a bench trial, that defendant's “alphabet quilts” did not infringe plaintiff's quilt design.⁴⁸ “Although the ‘more discerning’ test has not always been identified by name in our case law,” the *Boisson* court stated,

[W]e have nevertheless always recognized that the test is guided by comparing the “total concept and feel” of the contested works. . . . Likewise, when evaluating claims of infringement involving literary works, we have noted that while liability would result only if the protectible elements were substantially similar, our examination would encompass “the similarities in such aspects as the total concept and feel, theme, characters, plot, sequence, pace, and setting of the [plaintiff's] books and the [defendants'] works.”⁴⁹

Having subordinated discernment to “total concept and feel,” the Second Circuit overturned a lower court verdict of non-infringement, which had been based on a

⁴⁵ *Id.*

⁴⁶ *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003 (2d Cir. 1995).

⁴⁷ *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001).

⁴⁸ *Id.* at 266.

⁴⁹ *Id.* at 272–73 (citing *Williams v. Crichton*, 84 F.3d 581, 588 (2d Cir. 1996)); *see also Williams*, 84 F.3d at 590 (“[A] scattershot approach cannot support a finding of substantial similarity because it fails to address the underlying issue: whether a lay observer would consider the works as a whole substantially similar to one another.”).

finding that the similarities in the works stemmed primarily from unprotectable elements.⁵⁰

In the present case, [the appeals court held that] while use of the alphabet may not provide a basis for infringement, we must compare defendants' quilts and plaintiffs' quilts on the basis of the arrangement and shapes of the letters, the colors chosen to represent the letters and other parts of the quilts, the quilting patterns, the particular icons chosen and their placement. Our analysis of the "total concept and feel" of these works should be instructed by common sense. . . . It is at this juncture that we part from the district court, which never considered the arrangement of the whole when comparing plaintiffs' works with defendants'.⁵¹

Finally, in *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*,⁵² the Second Circuit retreated further. The trial court, ruling on a motion for summary judgment, stated that it was applying the "more discerning observer" test, but nonetheless compared the "total concept and feel" of the carpet designs at issue in the case.⁵³ In making its own comparison, the Court of Appeals did not mention the "more discerning observer" test and it again expressed concern that overly aggressive dissection would dilute the infringement analysis:

[T]he total-concept-and-feel locution functions as a reminder that, while the infringement analysis must *begin* by dissecting the copyrighted work into its component parts in order to clarify precisely what is not original, infringement analysis is not *simply* a matter of ascertaining similarity between components viewed in isolation.⁵⁴

The bottom line is that the Second Circuit's "unified ordinary observer" approach has mostly failed to fulfill its potential to vindicate the idea/expression distinction in the infringement analysis.

Abstraction-Filtration-Comparison Approach. Finally, there is a third approach to the infringement analysis, one which, rather than combining the extrinsic and intrinsic tests, instead splits the extrinsic test into two separate steps. This abstraction-filtration-comparison ("AFC") approach, developed initially by the Second Circuit in *Computer Associates International, Inc. v. Altai* in 1992,⁵⁵ has been applied by that court only to infringement claims involving computer software. The first step, abstraction, requires the court to separate the work into discrete elements and sort those elements by level of abstraction, from the most specific and tangible to

⁵⁰ *Boisson*, 273 F.3d at 276.

⁵¹ *Id.* at 273.

⁵² *Tufenkian Import/Export Ventures, Inc. v. Moomjy*, 338 F.3d 127 (2d Cir. 2003).

⁵³ *Id.* at 130.

⁵⁴ *Id.* at 134.

⁵⁵ *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706 (2d Cir. 1992).

the broadest and most theoretical.⁵⁶ In the second step, the court filters out those elements that are unprotectable, leaving only protectable expression.⁵⁷ Finally, that remaining protectable expression is compared for substantial similarity, either by a jury or by the court in a bench trial.⁵⁸

The AFC approach has been applied widely to infringement claims involving computer software.⁵⁹ Moreover, three federal appellate courts—the Sixth Circuit, the Tenth Circuit, and the D.C. Circuit—apply it more widely. The Tenth Circuit has applied AFC to all copyright infringement claims since 1996.⁶⁰ The Sixth Circuit also uses the AFC test as its exclusive test for substantial similarity.⁶¹ However, some district courts in the Sixth Circuit have suggested that the approach should be applied only in cases involving nonliteral copying and that it is less helpful to judge claims of literal copying.⁶² The D.C. Circuit adds the abstraction and filtration steps of AFC to the ordinary observer test only when the works at issue share significant similarities in unprotected material.⁶³

The AFC approach is promising, in large part because of its emphasis on identifying and removing unprotected elements of the plaintiff's and defendant's works. That said, the ability of the AFC approach to implement the idea/expression distinction depends, as with the extrinsic/intrinsic and unified ordinary observer tests, on the effective communication of the judge's filtering to the ultimate factfinder. In a jury trial, this means that information about filtration must be communicated to the jury in a way that jurors can both understand and practically implement the information in their verdict. That is the difficulty to which we now turn.

II. POTENTIAL REFORMS

As we've seen, the current approaches to assessing substantial similarity attempt to accomplish two things that are difficult to do at the same time. Juries are directed to judge infringement according to their holistic impressions as lay observers—yet

⁵⁶ *Id.* at 706–07.

⁵⁷ *Id.* at 707–10.

⁵⁸ *Id.* at 710–11.

⁵⁹ *See, e.g.,* Eng'g Dynamics, Inc. v. Structural Software, Inc., 26 F.3d 1335, 1342 (5th Cir. 1994) (adopting the *Altai* abstraction-filtration-comparison test).

⁶⁰ *See, e.g.,* Country Kids 'N City Slicks, Inc. v. Sheen, 77 F.3d 1280, 1284–85 n.5 (10th Cir. 1996).

⁶¹ *Kohus v. Mariol*, 328 F.3d 848, 854 (6th Cir. 2003).

⁶² *See, e.g.,* Goldman v. Healthcare Mgmt. Sys., Inc., 628 F. Supp. 2d 748, 753 n.4 (W.D. Mich. 2008).

⁶³ *See Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1297 (D.C. Cir. 2002); *see also* *Atkins v. Fischer*, 331 F.3d 988, 993 (D.C. Cir. 2003) (applying ordinary observer test in case where there was not an issue of similarity in unprotected material).

they must also somehow channel and discipline those holistic impressions. In particular, juries (and judges in bench trials) must take care not to find infringement based on similarities of elements of the plaintiff's and defendant's works that are unprotected by copyright.

Relying on a jury's subjective, holistic intuition, while simultaneously seeking to constrain and focus it, is a poor approach to judging copyright infringement. It is an approach in which intuitions are likely to prevail over analysis. So, what to do?

Perhaps we should consider deep reform—jettison the “ordinary observer” test altogether and replace it with a different and more analytically tractable criterion for judging infringement. This may sound radical, but it's worth reflecting on the way in which the current approaches to judging infringement may fail to adhere to what the law requires. The Copyright Act makes clear that copyright protection does not extend to facts, to ideas, or to the other unprotectable elements listed in Section 102(b). Thus, it is the Copyright Act itself that commands that infringement verdicts not be based on similarities that arise from elements that copyright does not protect—a decision that the Supreme Court has recognized as “neither unfair nor unfortunate,” and as “the means by which copyright advances the progress of science and art.”⁶⁴ In contrast, nothing in the Copyright Act commands that infringement be assessed according to the subjective intuition of an ordinary observer. The ordinary observer test is judge-made law—and what judges invented, judges can revise.

At this point, we might well begin to ask whether there is any good reason to rely on an ordinary person's rough and unguided intuitions about copying. Ordinary people are unlikely to be familiar with the careful balance between incentives and access that copyright law has been developed, over many decades, to reflect. So why do we feel that “ordinary observers” are likely to be good proxies for what copyright law should regard as “infringement?”⁶⁵ *Copying is not inherently wrongful*. It can be wrongful for instrumental reasons; the copying of artistic and literary works may, for example, be wrongful when it seems likely to interfere with authors' incentives to create new works.⁶⁶ Our understanding of when that interference is likely

⁶⁴ Feist Publ'ns., Inc. v. Rural Telephone Serv. Co., Inc., 499 U.S. 340, 350 (10th Cir. 1991).

⁶⁵ See Jamie Lund, *An Empirical Examination of the Lay Listener Test in Music Composition Copyright Infringement*, 11 VA. SPORTS & ENT. L.J. 137, 175 (2011) (reporting the results of an “experiment suggesting that the Lay Listener Test is poorly suited to weighing the ‘substantial similarity’ of musical compositions”).

⁶⁶ Copyright is sometimes justified as the appropriate reward for an author's creative labor. For a description and critique of the labor justification for copyright, see Seana Valentine Shiffrin, *Lockean Arguments for Private Intellectual Property*, in NEW ESSAYS IN THE LEGAL AND POLITICAL THEORY OF PROPERTY 138 (Steven R. Munzer ed., 2001). Copyright is also sometimes justified as a way that we acknowledge an author's strong interest in a creation that reflects and embodies his or her personality. See, e.g., Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J.

to occur, and when it isn't, remains (surprisingly) incomplete.⁶⁷ But there is a deeper problem – many laypeople do not share the instrumentalist instincts that underlie the copyright “balance,” but instead tend to react to copying as categorically wrongful.⁶⁸ And some people focus on factors—such as the intent of the copier, or whether the copier benefited from the copying—that are, strictly speaking, not relevant to the initial liability determination (although they may be relevant to damages and/or fair use).⁶⁹ So the question is worth asking: Can we do better than the unguided intuition of an ordinary observer?⁷⁰

The answer to that question is beyond the scope of this Article. Suffice it to say, for now, that a deep reform might replace the ordinary observer test with an inquiry that is tailored to the grounding justification of copyright law—the maintenance of adequate incentives to engage in the production of new artistic and literary works. One of us has sketched out an approach to doing just that.⁷¹ The aim is to distinguish between conduct we know will harm author incentives over the run of cases and conduct with more ambiguous effects. Creation and distribution of exact copies of a work should be treated differently than creation and distribution of a derivative work. We know the first will almost always be harmful; the second depends on the facts of a particular case.

To implement this distinction, we could restructure copyright's burdens of proof to better filter harmful from harmless uses. For cases involving infringing conduct that is very likely to cause harm—i.e., for cases involving copying of entire or nearly entire works—we should preserve copyright's current approach to assessing

287 (1988) (describing, critiquing, and providing arguments that seek to bolster Hegelian personality justification for copyright). But the dominant justification for copyright, at least in the United States, is explicitly utilitarian. Congress's power to create patent and copyright law is provided for explicitly in our Constitution, and—uniquely among the provisions describing Congress's powers—the grant contains a purpose clause that sets out an explicitly utilitarian rationale. Congress is given the power to pass patent and copyright laws “[t]o promote the Progress of Science and useful Arts . . .” U.S. CONST. art. I, § 8, cl. 8.

⁶⁷ For a review of selected recent scholarship on the relationship between copyright and creative incentives, see Christopher Jon Sprigman, *Copyright and Creative Incentives: What We Know (And Don't)*, 55 HOUSTON L. REV. 451 (2017).

⁶⁸ Christopher Buccafusco & David Fagundes, *The Moral Psychology of Copyright Infringement*, 100 MINN. L. REV. 2433, 2436 (2016).

⁶⁹ *Id.*

⁷⁰ For an interesting alternative approach, see Yvette Joy Liebesman, *Using Innovative Technologies to Analyze for Similarity Between Musical Works in Copyright Infringement Disputes*, 35 AIPLA Q. J. 331, 334–35, 346–47 (2007) (arguing courts should use technology, such as the database maintained by the music genome project (an effort to capture the essence of music at the most fundamental level using over 450 attributes to describe songs and a complex mathematical algorithm to organize them), to determine unlawful appropriation).

⁷¹ See generally Christopher Jon Sprigman, *Copyright and the Rule of Reason*, 7 J. TELECOMM. & HIGH TECH L. 317 (2009).

infringement. These are precisely the cases where subjective intuition is likely to work adequately. If similarities between the plaintiff's and defendant's works are due entirely or largely to uncopyrightable elements, then the defendant should be able to prevail on summary judgment. But if the plaintiff makes it past summary judgment, it is likely—at least in cases where the works are identical or virtually so—that the defendant has taken substantial protected material and is an infringer.

On the other hand, for all copyright infringement claims that do not involve copying that is either identical or nearly so, and where the likely effect of the potentially infringing conduct on creative incentives is therefore ambiguous, we could require plaintiffs to prove that they have been *harmed* in some substantial way. There are two principal benefits of such a strategy. First, by requiring that plaintiffs show substantial (actual or likely) harm in this second category of copyright infringement cases, we will encourage plaintiffs who have suffered substantial harm to come forward, while discouraging suits by rightsholders who suffer no harm, or only speculative harm. The harms that would meet this bar are far-ranging—any harms that decrease incentives for creation would suffice. While pecuniary and market harms would certainly qualify, it is also possible that certain types of dignitary harms could meet this bar as well, to the extent that they decrease incentives for creation and to the extent that they are able to co-exist with First Amendment freedom of expression.⁷²

Second (and perhaps most importantly), altering the plaintiff's *prima facie* case in this way will produce information about harms and benefits of different uses of copyrighted works. To do this effectively, the law needs to place the burden on the party most likely to have information about the harm, and in virtually all cases, that is likely to be the plaintiff. The law as structured now does not reliably produce this information, with the result that copyright litigation does not help us to know more about how incentives to create are or are not harmed. If we hope to improve our understanding over time, we should restructure the law so that litigation produces the information about harm that we currently lack.

A deeper reform is, we believe, worth considering. But, for the moment, we'll push that prospect aside and focus the balance of this Article on a set of more superficial adjustments to the current approaches that may help mitigate the tendency, which we noted in Part II, of the current approaches to minimize or even ignore the idea/expression distinction in rendering copyright infringement verdicts. There are various changes that could be made to bolster the chances that the idea/expression distinction is understood by the jury and enforced both in the decision-making process and after the fact. In the remainder of Part III, we'll review a number of possible reforms and consider how they might have operated in the context of a prominent

⁷² See, e.g., Jeanne C. Fromer, *Expressive Incentives in Intellectual Property*, 98 VA. L. REV. 1744 (2012).

recent case: the copyright litigation involving infringement allegations against songwriters Robin Thicke and Pharrell Williams and their composition, *Blurred Lines*.

A. *Pre-Verdict Strategies*

Markman Hearings. The first category of possible pre-verdict reforms is directed both toward pushing the jury to consider the idea/expression distinction in its verdict and providing it with the tools to do so. One strategy would be to import the patent law *Markman* hearing⁷³ into copyright infringement litigation. In *Markman* hearings, courts hear arguments on the meaning and scope of patent claims and then delineate the scope of those claims. *Markman* hearings help to fix the meaning of the claims at issue and define what is covered by the claims at issue and what is not. And that early fixation of the boundaries of the patent claim disciplines the evidence presented later in the trial. The parties, and ultimately the jury, are (ideally) focused on a particular understanding of the boundaries of the patent and are, as a consequence, better positioned to assess whether the defendant has infringed.

Markman-type hearings in copyright infringement lawsuits could perform the same function. First, courts should, where possible, encourage parties to stipulate to elements of the plaintiff's work that are protectable and unprotectable. To the extent that parties cannot agree, courts should focus on the scope of the plaintiff's claim.⁷⁴ They should do so by partitioning and carefully describing the protected and unprotected material in the plaintiff's and defendant's works. Doing so would build on the filtration processes that courts already employ in copyright infringement litigation. But the copyright implementation of *Markman* would serve a broader purpose than filtration does now. It would not simply be a prelude to a decision on a summary judgment motion. Rather, it would be a means for delineating protected and unprotected elements, and thereby facilitating a variety of trial management strategies aimed at ensuring that the jury's ultimate infringement decision focuses on similarities in the former and not the latter. Those trial management strategies (which could also be implemented as standalone measures) include the following:

Lists of Protected and Unprotected Elements. The Fourth Circuit, in its implementation of the Ninth Circuit's extrinsic/intrinsic approach, directs courts to create an explicit list of elements and to categorize them as being either protectable or

⁷³ *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996) (interpretation of patent claims is a matter of law to be resolved by the judge). For a more detailed exploration of potential wider use of *Markman* hearings, and for other helpful suggestions regarding how to discipline infringement analysis across various branches of IP law, see Mark A. Lemley & Mark P. McKenna, *Scope*, 57 WILLIAM & MARY L. REV. 2197, 2268 (2016).

⁷⁴ For a very helpful exploration of how courts could be more active in exploring the ambit of copyright claims, see generally Jeanne C. Fromer, *Claiming Intellectual Property*, 76 U. CHI. L. REV. 719 (2009).

unprotectable.⁷⁵ If the circuits adopted this approach, and district courts superintending infringement cases involving significant unprotected material were to regularly provide such a list to the jury as guidance on what to include and what to exclude in their infringement assessment, that could be very helpful in ensuring that the idea/expression distinction plays its proper role in shaping infringement verdicts.

As part of this process, of course, some elements that are excluded would be obvious and virtually uncontested by the parties, and others would be fiercely challenged. Since what is or is not protectable is a question of law, the court would make these decisions, and the final list of elements that are and are not protectable could then be shared with the jury. The list could take the form of either a standalone document or part of the formal jury instructions.

This approach is incomplete for the same reason the current judicial approaches are incomplete—i.e., even if a jury member knows she should exclude an element (e.g., the bass line in a musical composition), how does she actually do so in practice, especially as an untrained lay observer? That said, lists of protected and unprotected elements are more likely to be effective when used in combination with demonstratives and jury instructions, both of which are discussed briefly below. In combination with one or both of these tools, the lists could help shape the jury's inquiry and raise the likelihood that their infringement verdict will be based on consideration of similarities in protected, rather than unprotected, elements.

Demonstratives. In many cases, perhaps the most important use of the list of protected and unprotected elements in the plaintiff's and defendant's works will be as an aid in preparing demonstratives that help the jury identify the protected elements that can serve as the basis for its infringement determination. For example, courts can order the creation of a version of the work with the unprotectable elements filtered out (e.g., removing the bass line from a recording of the plaintiff's musical composition if that bass line has been determined by the court to be unprotectable, perhaps because it is *scènes à faire* for the particular musical genre at issue). These sorts of demonstratives are crafted to prevent the jury from inappropriately considering unprotectable elements (consciously or accidentally) by preventing unprotectable elements from being presented to the jury in the first place.⁷⁶

However, creating demonstratives of this sort will sometimes be extremely difficult in practice, both in the execution (actually separating those elements from the

⁷⁵ See *Charles W. Ross Builder, Inc. v. Olsen Fine Home Bldg., LLC*, 977 F. Supp. 2d 567, 592–98 (E.D. Va. 2013).

⁷⁶ Another option would be to present the jury with examples of other works in the same genre as the work at issue in order to help identify those elements that are not protectable (e.g., genre constraints and *scènes à faire*). However, it would still be very difficult for an untrained lay observer on the jury to separate out those elements, especially for types of works (e.g., music) that require technical knowledge and experience to even be able to identify some elements of the overall expression.

rest of the work) and in deciding what and how much should be removed (a central battle of an infringement suit). It is also far from clear that demonstratives would truly be helpful to the jury in all cases. In cases involving filtration of very significant unprotectable content, what would be left might be difficult for the jury to decipher—imagine a recording of a musical composition with so many of the elements removed that what remains sounds like disconnected tones. This approach is also likely to be more helpful for some kinds of works than for others. For example, removing the track that contains the bass line from a musical recording would be far easier than trying to somehow remove plot elements from a book.

It is important to note, moreover, that the reasoning behind this approach was recently rejected by the Ninth Circuit in its reversal of the jury verdict in *Skidmore v. Led Zeppelin*.⁷⁷ There, the Ninth Circuit found that the district court abused its discretion when it prohibited the plaintiff from playing the plaintiff's work in front of the jury for the purpose of demonstrating access.⁷⁸ The district court feared that it would be prejudicial for the jury to hear the full work (including unprotectable elements) and that it would undermine the jury's ability to evaluate the works based on substantial similarity of *protected* expression.⁷⁹ The Ninth Circuit, in reversing the verdict and remanding for a new trial, suggested that the court could simply have instructed the jury to ignore what they heard with respect to substantial similarity.⁸⁰ The Ninth Circuit's decision in this regard is a step in the wrong direction. In many cases, simply instructing the jury to ignore unprotected elements—in effect, to “un-hear” or “un-see” them—is unlikely to be effective in practice. The district court was correct to respond to this concern in the *Skidmore* litigation, and the Ninth Circuit erred in intruding into a case management decision that should have been left to the district court's sound discretion.

Expert Testimony on the Ideal/Expression Distinction. During the trial itself, expert testimony could be used as a tool to enhance the jury's understanding of what is and is not protected (including assisting with separability analysis in complicated situations) and to educate the jury about what should be included and excluded in its comparison. Although the attorneys on both sides are presumably also trying to do that throughout the course of the trial, expert testimony might lend additional precision and focus to the perspective each side is trying to advance. However, expert testimony would likely be polarized (since each side would present dueling experts)

⁷⁷ *Skidmore v. Led Zeppelin*, 905 F.3d 1116, 1131 (9th Cir. 2018). The plaintiff requested to play the song in order to show access, but the court's concern was with how the jury would be influenced with respect to substantial similarity.

⁷⁸ *Id.*

⁷⁹ *Id.* at 1135. The district court prohibited the plaintiff from playing the work in the presence of the jury but did allow the song to be played for the defendant outside of the courtroom and then permitted the plaintiff to fully question the defendant in the presence of the jury.

⁸⁰ *Id.*

and potentially confusing, so courts should take steps—such as close review of expert reports—to ensure that experts provide a benefit to the jury beyond the normal discourse of the attorneys and the jury instructions.

It is also worth noting that, if access to expert testimony is viewed as being a helpful tool for the jury, that would represent a material difference among the circuits, as the Second and Ninth Circuit approaches do differ with respect to whether, to what extent, and at what stage of the decision-making process expert testimony is permitted. The Ninth Circuit permits expert testimony during the extrinsic analysis,⁸¹ but bars it during the intrinsic analysis.⁸² The Second Circuit is considerably more wary, adhering, for the most part, to its holding in *Arnstein v. Porter* that expert testimony on the “impression made on the refined ears of musical experts” was “utterly immaterial,” and stating that expert testimony is permitted for the limited purpose of “assist[ing] in determining the reactions of lay auditors.”⁸³

Jury Instructions. The final pre-verdict strategy is to supply the jury with carefully constructed jury instructions that contain or supplement lists, demonstratives, and expert testimony on the separation of protected and unprotected elements. Juries require substantive guidance on what should be excluded from their considerations, as well as how to actually exclude them in practice. This is especially true for works such as music, where separability of the elements is much more difficult for many lay observers. For example, simply telling a jury to ignore the bass line of a song would not be a particularly helpful command for a jury member who is unfamiliar with musical instrumentation or terminology.

Jury instructions could be particularly helpful in clarifying what the legal standards actually are in an infringement suit, and what they mean. For example, guidance on what is meant by “total concept and feel” or “overall look and feel” and how those standards interact with the idea of excluding a work’s unprotectable elements would be especially helpful in ensuring that the jury is able to effectively apply the infringement test with proper consideration of the idea/expression distinction.

It’s important not to oversell these strategies. We don’t know if juries, even if they were well instructed and supplied with the aids we have discussed, would be up to the task of enforcing the distinction between unprotectable ideas and protectable expression. But, in general, juries are hardly given a fair chance. In particular, juries may fail to enforce the distinction because they usually are not well instructed on which elements they should disregard in discharging their function as lay observers. Courts’ instructions to juries, though they may reinforce the basic rule that infringement cannot be based on the similarity of unprotectable ideas, usually do little to

⁸¹ See *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002).

⁸² See *id.*

⁸³ *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946).

help juries implement the idea/expression distinction as a part of forming their intuition as “ordinary observers” regarding whether the defendant’s copying amounts to infringement.

B. Post-Verdict Strategies

We’ve outlined steps that courts can take to discipline the jury’s intrinsic analysis in copyright infringement cases. But there are also steps that courts can take to facilitate a post-verdict look-back to ensure that the jury’s verdict is not tainted by reliance on similarity of unprotectable elements. This can be done through the use of special verdict forms and, where appropriate, JNOV rulings.

One option for *ex post* “quality control” of jury decisions would be the use of special verdict forms. This would enable juries to identify those elements that were most probative of substantial similarity, or the lack thereof. Enforcing this sort of specification would allow the court to police, *ex post*, the idea/expression distinction in the jury’s decision-making process. If, for example, the jury identifies several unprotectable elements as being the most important points of similarity, the judge could decide to overturn that verdict after the fact, or such findings could support a challenge on appeal (for example, a challenge to flaws in the jury instructions that allowed the decision to be based on unprotectable factors).

However, there are a number of practical difficulties with implementing this approach. First and foremost, this approach assumes that the jury is capable of accurately identifying the elements it found most significant to its decision regarding similarity. There is always a question about whether the jury will accurately report the bases for its decision. The questions would also have to be carefully drafted to help the jury pinpoint those factors that were most important, without influencing that answer. Even assuming the jury does, in fact, identify specific elements as being the most significant to its decision, that doesn’t necessarily mean that they were the *only* points of similarity (or difference) that influenced the decision, or that the decision would have been different without those elements. For example, if the jury identified the bass line as being a primary point of similarity between two musical works, it may still have found substantial similarity in the other elements of the works even if it had not considered the bass line at all. This could lead to extended arguments about whether the jury’s inclusion of unprotectable elements in its verdict form should undermine the validity of the verdict, and how much consideration of unprotectable elements tips the balance.

C. Applying the Strategies to a Case: Blurred Lines

There is no straightforward solution to the problem this Article addresses, but the strategy for solving it should build on the filtration that courts already perform by buttressing it to identify unprotectable elements, to facilitate summary judgment when the defendant’s work replicates only unprotectable elements, and, in cases

where the extrinsic analysis reveals that some of the defendant's copying involves protected elements, taking steps to encourage factfinders to focus on these and to leave unprotected elements aside when undertaking their lay observer analysis.

The difficulty of executing this is illustrated clearly in *Williams v. Bridgeport Music, Inc.*, commonly referred to as the "Blurred Lines" case, in which the plaintiffs claimed that the defendants' sound recording of the song *Blurred Lines* infringed their copyright in the musical composition for the late-70s Marvin Gaye hit, *Got to Give it Up*.⁸⁴ In that case, the district court (a court within the jurisdiction of the Ninth Circuit) conducted an extrinsic analysis.⁸⁵ After performing its analytical dissection, the district court identified certain similarities as unprotectable, including the use of a cowbell, hand percussion, drum set parts, background vocals, and keyboard parts.⁸⁶ The court concluded, however, that disputes remained regarding the similarity to certain protectable elements of the plaintiffs' musical composition, including the song's signature phrases, hooks, bass lines, keyboard chords, harmonic structures, and vocal melodies.⁸⁷ Concluding that genuine issues of material fact existed, the district court denied defendants' motion for summary judgment.⁸⁸

So far, the extrinsic test was working as intended, but that began to fall apart as the trial proceeded. The court did not permit the recorded version of the plaintiffs' song to be introduced at trial; the court permitted instead a version that expurgated the elements of the recorded version that did not appear in the deposit copy of the musical composition.⁸⁹ But the court did not eliminate from the recording played at trial the other elements that it had earlier held to be unprotectable, nor did the court intervene when the plaintiffs' expert provided evidence about elements of the song found only in the recording and not in the deposit copy of the musical composition.⁹⁰ And, far worse, the court provided the jury with instructions that directed it to undertake both extrinsic and intrinsic analysis. The jury, in other words, was to determine for itself whether or not to consider in its lay observer analysis elements that the court had earlier held to be unprotectable. Here is the instruction:

INSTRUCTION NO. 43

In order for the Gaye Parties to meet their burden of proof to show by a preponderance of the evidence that there is substantial similarity between one of the Gaye Parties' works and one of the Thicke Parties' works, the Gaye

⁸⁴ For an account of the facts before the district court, see *Williams v. Gaye*, 895 F.3d 1106, 1107 (9th Cir. 2018).

⁸⁵ *Id.* at 1117.

⁸⁶ *Id.*

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.* at 1118.

Parties must show that there is both substantial “extrinsic similarity” and substantial “intrinsic similarity” as to that pair of works.

Extrinsic similarity is shown when two works have a similarity of ideas and expression as measured by external, objective criteria. To make this determination, you must consider the elements of each of the works and decide if they are substantially similar. This is not the same as “identical.” There has been testimony and evidence presented by both sides on this issue, including by expert witnesses, as to such matters as: (a) for “Got to Give It Up” and “Blurred Lines,” the so-called “Signature Phrase,” hook, “Theme X,” bass melodies, keyboard parts, word painting, lyrics, rap v. parlando; and (b) for “After the Dance” and “Love After War,” the chorus vocal melody and chords. The Gaye Parties do not have to show that each of these individual elements is substantially similar, but rather that there is enough similarity between a work of the Gaye Parties and an allegedly infringing work of the Thicke Parties to comprise a substantial amount.

Intrinsic similarity is shown if an ordinary, reasonable listener would conclude that the total concept and feel of the Gaye Parties’ work and the Thicke Parties’ work are substantially similar.

In considering whether extrinsic or intrinsic similarities are substantial, you may consider whether portions allegedly copied are either qualitatively or quantitatively important to either of the Gaye Parties’ works. A portion of a work is qualitatively important if, regardless of its size, it is shown to be very important to that work. The copying of a qualitatively important portion of a work may support a finding of substantial similarity even if that portion is very short. A portion of a work is quantitatively important if it comprises a significant portion of the work.⁹¹

There is a lot that is troubling in this instruction. The court’s misinterpretation of the extrinsic test as being about “similarity of *ideas* and expression” is one thing. As described earlier, that formulation, based in the Ninth Circuit’s misstatement in the *Sid & Marty Krofft* case,⁹² was later corrected by the Ninth Circuit in *Cavalier*.⁹³ The *Blurred Lines* district court used the uncorrected version of the formulation, an error which could lead the jury to think that similarity in unprotected ideas is a basis for an infringement finding. Another problem arises from the court’s use of the “total concept and feel” language to describe the intrinsic inquiry. This language is unhelpful in the extreme. As we noted earlier, asking the jury to assess similarity of

⁹¹ Jury Instructions at 46, *Williams v. Bridgeport Music, Inc.*, No. LA CV13-06004 JAK (AGRx), 2015 WL 12914367 (C.D. Cal. 2015).

⁹² *Sid & Marty Krofft TV Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

⁹³ *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002).

“concept” suggests that similarity of ideas, style or genre counts toward infringement, when, of course, none of these similarities should count. Asking the jury to assess similarity in “feel” invites it to find infringement based on mere similarity in musical style or “vibe”—both of which are unprotectable elements of musical composition. That was a special danger in this case, where the defendants admitted that they were inspired by the plaintiffs’ song and were attempting to achieve some of the same general “feel.”

The instruction presents another overwhelming problem; namely, the court is assigning to the jury a task that it should have shouldered itself. The court should have determined, on a motion for summary judgment and as a matter of law, which elements of the plaintiff’s work were excluded by Section 102(b) or by other limiting doctrines such as merger and *scènes à faire*, and which were protectable elements that the jurors could consider as lay observers. The court should have instructed the jury specifically on which elements were in and which were out. And the court should have instructed the jury that it should consider only the protectable elements when undertaking its lay observer analysis.

This would have required substantial effort. As we’ve suggested, the court could have made the process work better by asking the parties to stipulate to lists of elements of the plaintiffs’ and defendants’ works that were protected and unprotected. Where the parties disagreed, the proper procedure was for the court to test the parties’ contentions in the extrinsic analysis. The court should have heard expert testimony and decided, as a matter of law, which elements were protectable. Ideally, the expert testimony relevant to the extrinsic analysis should have been heard without the jury present. The court should have determined with finality the proper separation of protected from unprotected material.

The court should then have assessed the degree of similarity in protected material between the two works. If the similarity in protected material was overwhelming, the court should have granted summary judgment in favor of the plaintiffs. If the similarity in protected material was so scant that no reasonable jury could find infringement, the court should have granted summary judgment for the defendants. The court should have turned the case over to the jury only if it found that there was a degree of similarity in protected material between the two works such that a reasonable jury could rule either way.

By undertaking a robust extrinsic analysis, the court would have substantially streamlined both the evidence presented to the jury and the jury’s decision. The jury would have heard evidence on whether the defendants actually copied from the plaintiffs’ work. In the *Williams* case, that evidence could have been presented quickly, for the defendants admitted that they were inspired by the plaintiffs’ work and the case proceeded on the basis that whatever copying of protected elements occurred was likely unconscious (and the court specifically instructed the jury that

copying need not be conscious in order to lead to liability).⁹⁴ The jury could then have been instructed on the standard that governed its intrinsic “lay observer” role. It also could have been instructed on which elements of the plaintiffs’ and defendants’ works it should compare in its analysis, and which elements of similarity should be ignored because they related to unprotected elements. To make this comparison more accurate, the court could have ordered the preparation of sound recordings of the plaintiffs’ and defendants’ works that included only protected elements. Recall that the district court in *Williams* did order the production of a sound recording limited to elements it had ruled could be found in the deposit copy of the musical composition.⁹⁵ But it did not follow through on its extrinsic analysis to exclude other elements that were unprotectable.⁹⁶

If the *Williams* court had done the work to define in advance the protectable and unprotectable elements of the plaintiffs’ work, it could have disciplined the jury’s analysis. Instead, the court left it to the jury to discriminate between protected and unprotected elements. That is a poor allocation of responsibility, whether one agrees with the ultimate result in the *Williams* case or not.

CONCLUSION

We have offered a number of proposals designed to encourage juries to give due regard to the idea/expression distinction in reaching their verdicts. These proposals are useful as standalone remedies, but many are likely to work best when used in tandem. For example, if the court creates lists of unprotectable elements, there must still be a mechanism for passing those determinations through to the jury, and jury instructions might be the perfect vehicle for doing so. Similarly, *Markman*-style hearings might assist the court in creating those lists of unprotectable elements in the first place. As discussed above, the formulation of the standard itself (in particular, the “total concept and feel” description) undermines many other attempts to ensure that the jury bases its decision only on similarity among the protectable expression of the works. Finally, special verdict forms can assist the court in determining whether the other tools for enforcing the idea/expression distinction (including our suggested approaches above) have been effective.

All of this said, what we’ve offered is likely to be palliative, at best. A real cure lies much deeper. A real cure would require us to jettison the ordinary observer standard in favor of some external criterion that would yield more consistent, predictable, and substantively defensible copyright infringement verdicts. We believe that criterion is *harm to authors’ creative incentives*. Under this criterion, copying that is likely to harm incentives would be punished as infringement. Copying that

⁹⁴ Jury Instructions, *supra* note 91.

⁹⁵ *Williams v. Gaye*, 895 F.3d 1106, 1117 (9th Cir. 2018).

⁹⁶ *Id.*

is not likely to harm incentives would not. Nothing in the Copyright Act commands our current, wholly intuitional “ordinary observer” standard. And nothing in the Copyright Act would prevent us from moving to the more objective and externally verifiable criterion that we have identified. But that is a hope for the future, not the present.