

SUBSTANTIAL SIMILARITY IN COPYRIGHT LAW

BY ROBERT C. OSTERBERG AND ERIC C. OSTERBERG

REVIEWED BY DAVID APPLGATE*

Copyright law, like the law of contracts, is deceptively complex. What appear on the surface as straightforward propositions often prove, in practice, full of subtle nuance and deeper meaning, often difficult to discern. Just as the familiar contract formation principles of offer, acceptance, consideration, and a legal object can lead to months, if not years, of frustrating litigation to determine if a valid contract even exists, so too can even the most seemingly basic precepts of copyright law befuddle the inexperienced practitioner or confuse the court.

Take, for example, the basic test of copyright infringement: ownership of a valid copyright plus copying, which may in turn be proved either by direct evidence of copying or by proof of access and substantial similarity. Access may be difficult or easy to show, depending on the facts, but how does one decide "substantial similarity?" Despite its importance in copyright infringement litigation, as the authors of this new book on the topic point out in their Preface, substantial similarity "remains one of the most elusive concepts in copyright law."

Why, for example, does the 1985 movie *Pale Rider* not infringe 1953's classic *Shane*? (Why, for that matter, doesn't *Terminator 2*?) Both feature local small farmers or miners struggling against powerful local interests, encouraged in their resistance by a stranger who rides into town, stays with a local family, becomes idolized by the family's child, and triumphs in a showdown with an evil gunslinger hired by the powerful interests before riding away, leaving grateful townsfolk and a very sad child. Why, on the other hand, was "Wonderman" found to infringe the copyright on "Superman"? Now copyright litigators have a book that not only tells us, but also shows us, the answer to such questions.

The first work to focus exclusively on the topic, Robert C. and Eric C. Osterberg's *Substantial Similarity in Copyright Law* (PLI 2003) bridges the gap between academic treatise and practitioner's handbook. Bound in loose-leaf format for easy updating, it features a comprehensive summary of legal principles, Circuit-by-Circuit analysis of their application in practice, topical discussions by subject matter, and, most helpfully, an appendix of photographs and illustrations that show just what counted as substantial similarity in over a dozen and a half reported cases.

The authors organize *Substantial Similarity* into three major sections and seventeen chapters, followed by appendices, a table of cases, and an index. The first section focuses on defining legal standards.

In Chapter 1, the authors take on the legal definition of "substantial similarity" and two related concepts,

"probative" similarity and "striking" similarity. Coined by the late Alan Latman in a Columbia Law Review article, "probative similarity" is the kind of similarity that helps prove a defendant in fact copied material from a plaintiff, and need not involve copyrighted portions of the material at all. As the Osterbergs point out, a persuasive way of proving that a defendant has copied a computer program is often to show that the defendant has replicated portions of plaintiff's code that are inefficient, superfluous, or just plain erroneous. "Striking" similarity, on the other hand, is similarity "of the most impressive kind:" similarity that can be explained only by copying, rather than by independent creation, coincidence, or common prior source.

In Chapter 2, the authors discuss the principles of substantial similarity, including the *de minimus* threshold for copyright infringement, the many categories of unprotected material, qualitative and quantitative requirements, dissimilarities, and the two kinds of similarities: verbatim (including paraphrases) and total concept and "feel." "Quantitative" copying refers solely to the amount of copyrighted material that a plaintiff has copied; "qualitative" to the value of the copied material to the plaintiff's work. (If you don't copy much of the work, but only its heart and soul, you can still be found liable for infringement.)

Chapter 3 is a Circuit-by-Circuit survey of "substantial similarity" standards applied around the country, with special attention to the requirement for obtaining a preliminary injunction. In the Second Circuit, for example, the court applies the "ordinary observer" test where the work allegedly copied is wholly original, and the "more discerning ordinary observer" test where the work involves both protectible and unprotectible elements. Under the former, giving the works the same degree of scrutiny that a hypothetical ordinary observer would give them, the trier of fact must determine whether an ordinary lay person would recognize the accused copy as having been appropriated from the copyrighted work. Under the latter, the finder of fact must attempt to extract the unprotectible elements (ideas, facts, *scenes a faire*, clichés, titles, quotations from others, and uncopyrighted material), then determine whether the protectible elements, as a whole, are substantially similar. These are questions of fact, except when no reasonable person could find more than one way on the undisputed material facts, in which case the court will grant summary judgment.

In the Ninth Circuit, on the other hand, courts apply the "extrinsic/intrinsic test." First, applying the "extrinsic" part of the test, the court determines if the alleged infringing work is even of a type that could possi-

bly be "substantially similar" to the copyrighted work, based on specific analytical criteria and, if appropriate, expert testimony. In the case of a copyrighted sculpture of a nude human figure, for example, according to the Ninth Circuit, neither a statue of a horse nor a painting of nude human figure could infringe under the "extrinsic" part of the test. But if the extrinsic portion of the test is met, then the court applies the intrinsic portion: whether, depending on the response of the ordinary reasonable observer, the total concept and the feel of the two works are substantially similar. Here, however, the test is subjective, and no expert testimony is permitted. Other Circuits follow one or both of these approaches to greater or lesser degrees.

Turning to the second section, a topical analysis of specific subject matters consumes the bulk of the book, with chapters devoted to fictional literary and dramatic works, characters, nonfiction, audiovisual works, computer programs, musical works and sound recordings, works of visual art, architectural works, choreography, compilations and collective works, works in different media and formats, and derivative works. Readers will be unsurprised to learn that each of these is decided on a case-by-case basis or, as one court has put it, that the analysis is "inevitably *ad hoc*." The authors nonetheless struggle mightily to discern governing principles from diverse cases involving such colorful facts or properties as Sam Spade, Star Wars toys, Lone Wolf McQuade, Sylvester Stallone, and a famous x-rated underground comic book featuring easily recognizable Walt Disney characters.

In the third section of the book, the authors deal with selected trial and appellate issues, including the proper role and scope of expert testimony, lay opinion and audience reaction, and surveys, each topic treated succinctly but clearly, with ample citations.

But the heart and soul of this book resides in Appendix A, which illustrates in color and in black and white what courts have found to be substantially similar (or not) in nineteen cases involving drawings, photographs, sculpture, scripts, song lyrics, forms, architecture, insignia and fabric designs, and useful articles such as belt buckles, wristwatches, and furniture. Here the reader can experience firsthand the "look and feel" of copyrighted and infringing articles and begin to discern viscerally what some of the tests discussed in the text actually mean in practice.

Jury instructions, a table of cases, and a topical index follow. Rather than attempt to provide a comprehensive model instruction distilled from their own analysis, the authors present instead sample instructions from six reported cases in five different Circuits for consideration by the reader. Although one wishes for something more definitive, that is probably not possible given the differing tests in different courts. The index and the table of cases are unremarkable but useful.

In a complicated and confusing area, this is an eminently useful book. From the standpoint of a practitioner, there can be no higher praise.

*David Applegate is a partner at Williams Montgomery & John, Ltd., in Chicago, IL.