



Substantial similarity in copyright: It matters where you sue

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By:

A copyright plaintiff has the option of suing an infringer in two federal courts: California or New York. Does it matter which one is chosen? The answer appears to be yes: a complaint filed in California is often more likely to survive a pre-discovery motion to dismiss than one filed in New York.

The Second and Ninth Circuit Courts of Appeals are inarguably the most important circuits for copyright law developments. This is not surprising, since the industries that generate the most copyright disputes are located in New York (publishing, media) and California (entertainment, software/gaming). The two circuits do not always interpret copyright law the same way, however.

To prove copyright infringement, the plaintiff must show (1) that the defendant had access to the plaintiff's work and (2) that the defendant's work is substantially similar to protected aspects of the plaintiff's work.¹ Where "literary works" are concerned – a broad term that encompasses books, movies, television shows and the audiovisual aspects of videogames – courts in the Second Circuit analyze substantial similarity by (1) first filtering out similarities that result from unprotectible

aspects of the original work, such as facts, public domain material, and stock plot elements, and (2) examining the “total concept and feel, theme, characters, plot, sequence, pace and setting” of the similarities that remain to determine whether similarities rise to the level of “substantial.”²

The Ninth Circuit divides substantial similarity analysis into separate “extrinsic” and “intrinsic” tests. The extrinsic test assesses the similarities of the two works, focusing only on the protectible elements of the plaintiff’s expression.³ The extrinsic test also requires filtration of the unprotectible aspects of the plaintiff’s works. What remains after filtering out is compared to the corresponding elements of the defendant’s work to assess similarities in the objective details of the works.⁴

The intrinsic test is viewed by the Ninth Circuit as “subjective” and “holistic.” It involves comparing the protectible aspects of the plaintiff’s work to the defendant’s work, and determining whether both are substantially similar in “total concept and feel.”⁵ It looks to the “ordinary person’s subjective impressions of the similarities between the works.”⁶ To succeed, the plaintiff must prove that there is substantial similarity under both extrinsic and intrinsic tests.⁷

While the differences in the two circuits’ analyses may appear semantic, they have practical consequences when a copyright defendant seeks to dismiss a complaint before discovery.

In the Second Circuit, a copyright infringement defendant may move to dismiss under Rule 12(b)(6) where the plaintiff’s and defendant’s works are referenced in a copyright infringement complaint. The district court may compare the two works, filter out unprotectible similarities, review whatever similarities remain in light of literary dimensions and overall concept and feel, and dismiss on the basis that, as a matter of law, the two works are not substantially similar.⁸ Every aspect of substantial similarity, including the subjective question of whether there is a shared total concept and feel, can be decided by a court.⁹ Dismissals of copyright claims for lack of substantial similarity are now so common in the New York federal courts that the Second Circuit frequently affirms by summary order rather than full appellate opinions.

Ninth Circuit precedent, however, has substantially restricted the opportunity for defendants to obtain dismissals of copyright claims. The Ninth Circuit has affirmed dismissals where, after the district court filters out unprotectible material from the plaintiff’s work, it concludes that the complaint does not satisfy the extrinsic test for substantial similarity. However, where similarities remain after filtration, the court’s precedents hold that pre-discovery dismissal (and indeed summary judgment) for lack of substantial similarity is improper. The subjective intrinsic test “is uniquely suited for determination by the trier of fact”¹⁰ and is “exclusively the province of the jury.”¹¹ The Ninth Circuit has often held that it is reversible error for a district court to decide the intrinsic test on a Rule 12(b) motion.¹²

The two circuits also disagree on whether expert testimony is needed to determine presence or absence of substantial similarity. The Second Circuit has found expert testimony irrelevant except where the works are highly technical, such as computer software,¹³ and has held that the “good eyes and common sense” of a judge is enough to make determinations on substantial similarity at the motion to dismiss stage.¹⁴ In contrast, Ninth Circuit decisions hold that expert testimony is admissible and often essential in extrinsic similarity analysis to determine whether similarities in two works relate to unprotectible material.¹⁵

Thus, forums make a difference. A plaintiff having the option may prefer to litigate a literary copyright infringement claim in California or another Ninth Circuit district court. If a motion to dismiss is made for lack of summary judgment, the plaintiff can seek conversion to a summary judgment motion under FRCP 12(d). After conversion, the plaintiff can present expert testimony supporting its position that similarities between works relate to protectible material and argue that the intrinsic test for substantial similarity cannot be resolved until trial. Conversely, a defendant threatened with a copyright suit and having a choice of venues may want to sue in New York for a declaratory judgment of non-infringement and, once an answer is filed, move for judgment on the pleadings based on lack of substantial similarity between the works.

To learn more about the implications of this for your business, please contact the author or your DLA Piper relationship attorney.

[1] *Feist Publications, Inc. v. Rural Tel. Serv. Co. Inc.*, 499 U.S. 340, 361 (1991).

[2] *Williams v. Crichton*, 84 F.3d 581, 588 (2d Cir. 1996).

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

[4] *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1118 (9th Cir. 2018), *overruled on other grounds, Skidmore as Trustee for Randy Craig Wolfe Trust v. Led Zeppelin*, 952 F.3d 1051 (9th Cir. 2020).

[5] *Cavalier*, 297 F.3d at 822.

[6] *Funky Films, Inc. v. Time Warner Entertainment Co.*, 462 F.3d 1072, 1077 (9th Cir. 2006).

[7] *Id.*

[8] *Peter F. Gaito Architecture, LLC v. Simone Development Corp.*, 602 F.3d 57, 64-65 (2d Cir. 2010).

[9] *Abdin v. CBS Broadcasting Inc.*, 971 F.3d 51, 73 (2d Cir. 2020).

[10] *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1166 (9th Cir. 1977).

[11] *Funky Films*, 462 F.3d at 1077.

[12] *Rentmeester*, 883 F.3d at 1118; *Zindel as Trustee for David Zindel Trust v. Fox Searchlight Pictures, Inc.*, 815 F. Appx. 158 (9th Cir. 2020) (Mem.); *Shaw v. Lindheim*, 919 F.2d 1353, 1358 (9th Cir. 1990).

[13] *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 713 (2d Cir. 1992).

[14] *Peter F. Gaito*, 602 F.3d at 66 (quoting *Hamil Am. Inc. v. GFI*, 193 F.3d 92, 102 (2d Cir. 1999)).

[15] *Sid and Marty Krofft*, 562 F.2d at 1164, *Shaw v. Lindheim*, 919 F.2d 1353, 1358 (9th Cir. 1990); *see also Zindel*, 815 F. Appx. at 160. Notwithstanding the precedential decisions, occasional Ninth Circuit memorandum decisions have suggested that a district court can sometimes decide the extrinsic test without the aid of expert testimony. *See Masterson v. Walt Disney Co.*, 821 F. Appx. 779, 781 (9th Cir. 2020) (Mem.), *Shame on You Productions, Inc. v. Banks*, 120 F. Supp. 1123, 1147 (C.D. Cal. 2015), *aff'd on basis of district court opinion*, 690 F. Appx. 519 (9th Cir. 2017) (Mem.).