

# The Search for a Suitable Standard of Substantial Similarity: The Ninth Circuit's Application of the *Krofft* Test

## TABLE OF CONTENTS

INTRODUCTION .....	229
I. BACKGROUND .....	232
A. <i>Copyrightability</i> .....	232
B. <i>The Merger Doctrine</i> .....	234
C. <i>Scenes a Faire</i> .....	235
D. <i>The Role of Substantial Similarity</i> .....	236
E. <i>The Krofft Test for Substantial Similarity</i> .....	237
II. THE NINTH CIRCUIT'S APPLICATION OF <i>KROFFT</i> .....	239
A. <i>Cases Faithful to Krofft</i> .....	241
B. <i>Intrinsic Dissection of Expression</i> .....	243
C. <i>Merger or Scenes a Faire Analysis Applied</i> .....	245
D. <i>Ad Hoc Decisions</i> .....	248
E. <i>Extrinsic Dissection of Expression</i> .....	249
F. <i>Cases Badly Misapplying Krofft</i> .....	252
III. PROPOSAL: A FOUR-PART TEST FOR SUBSTANTIAL SIMILARITY .....	254
A. <i>Olson Revisited</i> .....	254
B. <i>A Modest Proposal</i> .....	257
CONCLUSION .....	261

## INTRODUCTION

“Substantial similarity,” a phrase of art in copyright law,<sup>1</sup> refers to the amount of similarity between two works that is required for a court to hold that a defendant’s work has infringed the copy-

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<sup>1</sup> The Copyright Act of 1976, 17 U.S.C. §§ 101-914 (1988), governs copyright law, but the Act makes no reference to substantial similarity. Rather, courts have developed the concept of substantial similarity. *See infra* notes 40-50 and accompanying text.

right of a plaintiff's work.<sup>2</sup> To establish copyright infringement,<sup>3</sup> a plaintiff must prove ownership of the copyright and "copying"<sup>4</sup> by the defendant.<sup>5</sup> A plaintiff may prove copying either by direct evidence or by circumstantial evidence of access to the copyrighted work and substantial similarity between the copyrighted work and the defendant's work.<sup>6</sup>

The Ninth Circuit Court of Appeals announced its two-part test for substantial similarity in *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*<sup>7</sup> The first part of the *Krofft* test is an

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<sup>2</sup> [T]he determination of the extent of similarity which will constitute a *substantial* and hence infringing similarity presents one of the most difficult questions in copyright law, and one which is the least susceptible of helpful generalizations. It is clear that slight or trivial similarities are not substantial and are therefore non-infringing. But it is equally clear that the two works may not be literally identical and yet, for purposes of copyright infringement, may be found to be substantially similar.

<sup>3</sup> MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A], at 13-23 (1991).

<sup>4</sup> Infringement is the violation of a copyright holder's exclusive right to reproduce her work. 17 U.S.C. § 501(a); *see infra* note 14 (discussing the exclusive rights that copyright law gives to copyright holders).

<sup>5</sup> "Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which one may perceive, reproduce, or otherwise communicate the work, either directly or with the aid of a machine or device. 17 U.S.C. § 101. "The term 'copies' includes the material object, other than a phonorecord, in which the work is first fixed." *Id.*

<sup>6</sup> *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1162 (9th Cir. 1977).

<sup>7</sup> *Id.*; 3 NIMMER, *supra* note 2, § 13.01[B], at 13-7 to 13-8 ("It is generally not possible to establish copying by direct evidence as it is rare that the plaintiff has available a witness to the act of copying. . . . Therefore copying is ordinarily established indirectly by the plaintiff's proof of access and substantial similarity.") (footnotes omitted).

<sup>8</sup> *See Krofft*, 562 F.2d at 1162; *Olson v. National Broadcasting Co., Inc.*, 855 F.2d 1446, 1448 (9th Cir. 1988) ("*Krofft* sets forth a two-part test for determining whether one work is substantially similar to another."); *Kamer Int'l, Inc. v. Russ Berrie & Co.*, 657 F.2d 1059, 1062 (9th Cir. 1981) ("The test in this circuit for substantial similarity is the two-part test propounded in *Sid and Marty Krofft Television*."); *Overman v. Universal City Studios, Inc.*, 605 F. Supp. 350, 352 (C.D. Cal. 1984) ("In *Sid and Marty Krofft* . . . the Ninth Circuit articulated a bifurcated test for infringement according to which substantial similarity in ideas is analyzed . . .").

The *Krofft* facts are as follows: Needham, Harper & Steers, Inc., an advertising agency that was not a party to the suit, had communicated with the plaintiff, *Krofft*. *Krofft*, 562 F.2d at 1161. Needham wanted the right to use the plaintiff's copyrighted "H. R. Pufnstuf" characters in television

extrinsic test for similarity of ideas.<sup>8</sup> The extrinsic test is objective and based upon specific criteria that a court may list and analyze. The second part of the test is an intrinsic test for similarity of expression.<sup>9</sup> The intrinsic test is based upon the trier of fact's impressions.

Ninth Circuit courts<sup>10</sup> apply the *Krofft* test for substantial similarity inconsistently because strict application of the test sometimes conflicts with the policy goals of copyright law.<sup>11</sup> Because of this inconsistency, copyright owners, attorneys, and legal scholars alike are unable to predict the outcome of many copyright cases.<sup>12</sup> Thus, Ninth Circuit substantial similarity jurisprudence fails to achieve the judicial goals of predictability in

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commercials. *Id.* "H. R. Pufnstuf" was a successful children's television show that included "several fanciful costumed characters . . . who lived in a fantasy land." *Id.*

Needham told the plaintiff that he was attempting to get the advertising account of the defendant, the McDonald's restaurant chain, and wanted to propose to McDonald's a plan of advertising based on the plaintiff's characters. *Id.* After several communications regarding the use of the plaintiff's characters, the plaintiff telephoned Needham, and Needham told the plaintiff that Needham had cancelled the advertising campaign. *Id.* In fact, however, McDonald's had already awarded Needham the advertising contract, and Needham was proceeding with the McDonaldland project. *Id.* Needham hired the plaintiff's former employees to construct the sets and costumes and to provide the voices for the McDonaldland project. *Id.*

The plaintiff claimed that McDonald's characters infringed plaintiff's copyright. *Id.* at 1162. The district court awarded the plaintiff \$50,000 in damages, and both parties appealed. *Id.* The Ninth Circuit affirmed the district court's finding of infringement and formulated the bifurcated test that is the subject of this Comment. *Id.* at 1179. The Ninth Circuit also reversed in part and remanded in part on issues not pertinent to this Comment. *Id.*

<sup>8</sup> *Id.* at 1164; *see infra* notes 44-45 and accompanying text.

<sup>9</sup> *Krofft*, 562 F.2d at 1164; *see infra* notes 46-50 and accompanying text.

<sup>10</sup> This Comment analyzes the application of the *Krofft* test by both the Ninth Circuit Court of Appeals itself and the district courts within the Ninth Circuit. Thus, the terms "Ninth Circuit courts" and "Ninth Circuit cases," as used in this Comment, refer to both the Ninth Circuit itself and the district courts within the circuit.

<sup>11</sup> *See infra* notes 16-19 and accompanying text (discussing the policy goals of copyright law); *infra* notes 132-44 and accompanying text (discussing how strict application of *Krofft* may conflict with the public policy behind copyright law).

<sup>12</sup> *See infra* notes 52, 53 and 57 (discussing the unpredictability of cases applying the *Krofft* test).

adjudication and uniform application of the law.<sup>13</sup>

This Comment discusses the various ways that Ninth Circuit courts have applied and misapplied the *Krofft* test and proposes a new test for substantial similarity that the courts can apply consistently. Part I provides a necessary background in copyright law and considers the principles and policies behind copyright law. Part I also explains the *Krofft* test and demonstrates how *Krofft* sought to further the policy goals discussed. Part II focuses on the Ninth Circuit's application of the *Krofft* test and shows the inconsistency with which the courts have applied this test. Part III proposes a new, four-part test that reconciles what *Krofft* sought to do, what the courts have done since *Krofft*, and what the courts can do in the future to further the policy considerations underlying copyright law.

## I. BACKGROUND

### A. Copyrightability

In analyzing substantial similarity, an understanding of copyright law is important.<sup>14</sup> Copyright law will not protect an idea,

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<sup>13</sup> Courts often express a desire for predictability in adjudication. See, e.g., *American Trucking Ass'ns v. Smith*, 110 S. Ct. 2323, 2345 (1990) (Scalia, J., concurring) (noting that “*stare decisis*—that is to say, a respect for the needs of stability in our legal system—would normally cause me to adhere to a decision this Court already rendered”); *Liddell v. Missouri*, 731 F.2d 1294, 1305 (8th Cir. 1984) (referring to important considerations of judicial economy and “our interest in protecting the settled expectations of parties who have conformed their conduct to our guidelines”); *Carmania Corp., N.V. v. Hambrecht Terrell Int'l*, 705 F. Supp. 936, 939 n.5 (S.D.N.Y. 1989) (stating that it is desirable to “protect settled expectations and thereby reduce the parties’ costs of doing business”). The *Krofft* test for substantial similarity, as applied by Ninth Circuit courts, fails to serve these goals.

<sup>14</sup> Subject to limitations imposed by 17 U.S.C. §§ 107-118, a copyright holder (or someone authorized by the copyright holder) has exclusive rights to reproduce and distribute the copyrighted work, prepare derivative works based on the copyright, and, where applicable, perform or display the copyrighted work publicly. 17 U.S.C. § 106.

A “derivative work” is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations,

but will protect the expression of an idea.<sup>15</sup> This principle reconciles two competing social interests:<sup>16</sup> it rewards the individual's creative efforts, yet affords the public the benefit of subsequent individuals' improvements on the same subject matter.<sup>17</sup>

Were copyright protection extended to ideas, the first individual to copyright a particular idea would have a monopoly on it, foreclosing other individuals from subsequently expressing the

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elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work."

*Id.* § 101.

For works created after January 1, 1978, the copyright extends for the life of the copyright holder plus fifty years after death. *Id.* § 302(a). Copyright law will protect works copyrighted before January 1, 1978, for no less than 75 years from the date the copyright was originally secured. *Id.* § 304(a)-(b); see also *id.* §§ 302-04 (detailing the scope of copyright protection in particular situations).

Anyone who violates an exclusive right of a copyright holder has infringed the copyright. *Id.* § 501(a). A copyright holder's remedy for infringement may include injunctive relief. *Id.* § 502. Additionally, the plaintiff may be entitled to damages. *Id.* § 504. The plaintiff may choose between actual damages and profits or statutory damages. *Id.* § 504(a). The court has discretion to award the plaintiff between \$250 and \$10,000 as statutory damages. *Id.* § 504(c)(1). If the plaintiff can prove that the defendant willfully infringed the plaintiff's work, the court has discretion to increase the award of statutory damages to \$100,000. *Id.* § 504(c)(2).

As part of a final judgment a court may order the impounding or destruction of the infringing copies. *Id.* § 503. Lastly, a court may award the copyright holder attorney's fees and costs. *Id.* § 505.

<sup>15</sup> *Mazer v. Stein*, 347 U.S. 201, 217 (1954).

<sup>16</sup> *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1163 (9th Cir. 1977).

<sup>17</sup> *Id.* Professor Nimmer has addressed the policy considerations of copyright law as follows:

The policy rationale underlying the Act's exclusion of ideas from copyright expression is clear. To grant property status to a mere idea would permit withdrawing the idea from the stock of materials which would otherwise be open to other authors, thereby narrowing the field of thought open for development and exploitation. This effect, it is reasoned, would hinder rather than promote the professed purpose of the copyright laws, *i.e.*, "the progress of science and useful arts." Indeed, it has been said that copyright protection is granted for the very reason that it may persuade authors to make their ideas freely accessible to the public so that they may be used for the intellectual advancement of mankind.

3 NIMMER, *supra* note 2, § 13.03[B], at 13-56 to 13-58 (footnotes omitted).

same idea their own way.<sup>18</sup> Such a result would be contrary to the public policy in favor of keeping all areas of thought open so that individuals may develop the arts and sciences for the benefit of humankind.<sup>19</sup>

The challenge for the courts is in determining whether a particular work is an unprotected idea or a protected expression of an idea.<sup>20</sup> Under certain circumstances, however, when there are only a limited number of ways of expressing an idea, even the expression of an idea may not be protected.

### B. *The Merger Doctrine*

Courts will not extend copyright protection to an expression when the idea and its expression are inseparable.<sup>21</sup> This concept is known as a merger<sup>22</sup> of idea and expression.<sup>23</sup> In such

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<sup>18</sup> See *Krofft*, 562 F.2d at 1162-63. In *Krofft*, the court hypothesized a situation in which a person obtained a copyright for a "cheaply manufactured plaster statue of a nude." *Id.* at 1162. The court noted that if copyright protection were extended to ideas, "subsequent manufacturers of statues of nudes would face the grave risk of being found to be infringers if their statues were substantially similar and access were shown. The burden of proof on plaintiff would be minimal . . ." *Id.* at 1162-63.

<sup>19</sup> See *supra* note 17; *Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 208 (9th Cir. 1988) (stating that there is strong public policy favoring free use of ideas contained in a copyrightable work so long as protectable expression is not appropriated).

<sup>20</sup> *Krofft*, 562 F.2d at 1163.

<sup>21</sup> An idea and its expression are deemed inseparable when the line between them has blurred and the expression of the idea cannot be separated from the idea itself. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971). "The critical distinction between 'idea' and 'expression' is difficult to draw. . . . In our view, the difference is really one of degree. . . . The guiding consideration in drawing the line is the preservation of the balance between competition and protection reflected in the patent and copyright laws." *Id.*

<sup>22</sup> The Copyright Act does not address the merger doctrine. See 17 U.S.C. §§ 101-914. The doctrine is purely a judicial creation.

Professor Nimmer notes that when idea and expression have merged, "rigorously protecting the expression would confer a monopoly over the idea itself, in contravention of the statutory command. To prevent that consequence, courts have invoked the merger doctrine." 3 NIMMER, *supra* note 2, § 13.03[B], at 13-60 (footnote omitted).

<sup>23</sup> *Krofft*, 562 F.2d at 1167-68; *Johnson Controls, Inc. v. Phoenix Control Systems, Inc.*, 886 F.2d 1173, 1175 (9th Cir. 1989) ("Where an idea and the expression 'merge,' or are 'inseparable,' the expression is not given copyright protection.").

instances, copyright law does not protect the copyright holder because doing so would give the individual a monopoly on the idea.<sup>24</sup>

An example of the merger doctrine was presented in the famous *Herbert Rosenthal Jewelry Corp. v. Kalpakian* case, in which the plaintiff jeweler brought suit against another jeweler for infringing the plaintiff's design of a jewel-encrusted pin in the shape of a bee.<sup>25</sup> The *Herbert Rosenthal* court noted that there were only a limited number of ways in which one could design a jewel-encrusted bee pin<sup>26</sup> and that, accordingly, the idea and its expression appeared to be indistinguishable.<sup>27</sup> Thus, substantial similarity of the two expressions of the same idea was inevitable.<sup>28</sup> The *Herbert Rosenthal* court held for the defendant because extending copyright protection to the plaintiff manufacturer would have conferred a monopoly upon the plaintiff.<sup>29</sup>

### C. Scenes a Faire

For the same reasons that a court will not protect a plaintiff's copyright if the idea and expression have merged, a court will not protect a plaintiff's copyright if the plaintiff's expression constitutes a *scenes a faire*.<sup>30</sup> Under the *scenes a faire* doctrine, if the copyright holder's expression is a scene that necessarily flows from

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<sup>24</sup> *Herbert Rosenthal*, 446 F.2d at 742.

<sup>25</sup> *Id.* at 739.

<sup>26</sup> *Id.* at 740 ("Plaintiff's counsel, repeatedly pressed by the district judge, was unable to suggest how jewels might be placed on the back of a pin in the shape of a bee without infringing plaintiff's copyright.").

<sup>27</sup> *Id.* at 742.

<sup>28</sup> *Id.* ("There is no greater similarity between the pins of plaintiff and defendant than is inevitable from the use of jewel-encrusted bee forms in both.").

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

<sup>30</sup> "In 1942, Judge Yankwich, a California federal district court judge, introduced the phrase 'scenes a faire' into United States copyright law." Leslie A. Kurtz, *Copyright: The Scenes a Faire Doctrine*, 41 FLA. L. REV. 79, 80 (1989). "[W]hen you are dealing with a common idea . . . similarities may appear which are inherent in the situation. The French refer to them as *scenes a faire*, — that is, scenes which *must* follow a certain situation." Leon R. Yankwich, *Originality in the Law of Intellectual Property*, 11 F.R.D. 457, 462 (1951).

The Copyright Act does not refer to *scenes a faire*. See 17 U.S.C. §§ 101-914. The doctrine is wholly a judicial creation: "Judge Leon Yankwich has called such incidents 'scènes à faire' *i.e.*, 'scenes which "must" be done.'" 3 NIMMER, *supra* note 2, § 13.03[B], at 13-62.2. See generally Kurtz, *supra*.

common ideas, a second person does not infringe even if she reproduces the copyright holder's expression verbatim.<sup>31</sup> The rationale of the *scenes a faire* doctrine, like that of the merger doctrine, is that holding otherwise would confer a monopoly on the commonplace ideas behind the *scenes a faire*.<sup>32</sup>

When accused of copyright infringement, defendants often offer a defense of merger or *scenes a faire*,<sup>33</sup> yet the two doctrines are not identical. The merger doctrine applies when the idea and expression are inseparable.<sup>34</sup> The *scenes a faire* doctrine applies when the similarity of expression results from stock scenes that necessarily flow from a common idea.<sup>35</sup>

#### D. *The Role of Substantial Similarity*

Even if a plaintiff can establish that merger and *scenes a faire* do not apply, the plaintiff still has the burden of proving substantial similarity between the two works in question.<sup>36</sup> That is, substantial similarity is part of the plaintiff's prima facie case, and failure to meet that burden will result in summary judgment in the

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<sup>31</sup> *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 489 (9th Cir. 1984).

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

<sup>33</sup> See *Frybarger v. International Business Machs. Corp.*, 812 F.2d 525, 530 (9th Cir. 1987) (accepting defendant's merger defense and finding that "to the extent each feature is expressive . . . the expression is . . . 'indispensable, or at least standard, in the treatment of a given [idea]'") (alteration in original) (quoting *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 616 (7th Cir. 1982), which quoted *Alexander v. Haley*, 460 F. Supp. 40, 45 (S.D.N.Y. 1978)); *National Theme Prod., Inc. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348, 1354 (S.D. Cal. 1988) (rejecting defendant's *scenes a faire* defense and finding that plaintiff's expression "does not necessarily flow from the 'idea' of the costumes").

<sup>34</sup> *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987) ("No substantial similarity will be found when 'the idea and its expression are . . . inseparable . . .'" (quoting *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971)); *Broderbund Software, Inc. v. Unison World, Inc.*, 648 F. Supp. 1127, 1131 (N.D. Cal. 1986) (noting that if an idea is indistinguishable from its expression, the idea has merged into its expression).

<sup>35</sup> *Landsberg*, 736 F.2d at 489.

<sup>36</sup> See *Litchfield v. Spielberg*, 736 F.2d 1352, 1355 (9th Cir. 1984). "Obviously, the plaintiff bears the burden of proof in the prima facie case, and the defendant bears the burden as to defenses." 3 NIMMER, *supra* note 2, § 12.11[A], at 12-81. "It is clear that plaintiff has the burden of proving both access and substantial similarity." *Id.* § 12.11[D], at 12-92.5.

defendant's favor.<sup>37</sup> As a general rule, courts do not favor summary judgment on questions of substantial similarity.<sup>38</sup> However, when no reasonable jury could find substantial similarity, summary judgment is appropriate.<sup>39</sup>

### E. The Krofft Test for Substantial Similarity

Perhaps because of the important role substantial similarity plays in copyright law, courts have modified the original test for substantial similarity.<sup>40</sup> The Ninth Circuit has adopted the two-

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<sup>37</sup> *Litchfield*, 736 F.2d at 1355-56 (stating that summary judgment is appropriate if no reasonable jury could find substantial similarity).

<sup>38</sup> *Id.* at 1355; *Berkic v. Crichton*, 761 F.2d 1289, 1292 (9th Cir.), *cert. denied*, 474 U.S. 826 (1985). Substantial similarity "is a question of fact uniquely suited for determination by the trier of fact." *Jason v. Fonda*, 526 F. Supp. 774, 777 (C.D. Cal. 1981), *aff'd and incorporated by reference*, 698 F.2d 966 (9th Cir. 1982).

<sup>39</sup> *Litchfield*, 736 F.2d at 1355-56. The court should grant a defendant's motion for summary judgment when the plaintiff "fails to make a showing sufficient to establish the existence of an element essential to [plaintiff's] case." *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). "In such a situation there can be 'no genuine issue of material fact,' since a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial." *Id.* at 322-23.

<sup>40</sup> In developing the *Krofft* test, the Ninth Circuit "buil[t] upon the *Arnstein* doctrine, [and] articulated a bifurcated test for infringement which in some ways appears to go farther than that in *Arnstein*." 3 NIMMER, *supra* note 2, § 13.03[E], at 13-62.18 (footnote omitted) (referring to *Arnstein v. Porter*, 154 F.2d 464 (2d. Cir. 1946)).

One observer compares the two tests as follows:

Two leading cases, [*Arnstein* and *Krofft*], modified the original statement of the [ordinary observer] test by recognizing that expert testimony and "dissection" may be appropriate for some limited purposes. In *Arnstein*, the Second Circuit separated the question of copying from the question of infringement. The court held that when "there is evidence of access and similarities exist," "analysis (dissection) is relevant, and the testimony of experts may be received," to aid the trier of fact in determining whether "the similarities are sufficient to prove copying." The court held, however, that once copying is established, the issue of "unlawful appropriation" must be decided by "the response of the ordinary lay [observer]; accordingly, on that issue 'dissection' and expert testimony are irrelevant." In *Krofft*, the Ninth Circuit appeared to lump together the questions of copying and infringement (applying the ordinary observer test to both), but allowed expert testimony and dissection for the limited purpose of determining whether there was substantial similarity as to the "general idea" contained in the two works.

part test announced in *Krofft*.<sup>41</sup> To establish a claim for copyright infringement under *Krofft*, a plaintiff must show not only that the defendant's idea is substantially similar to the plaintiff's, but that the expression of the idea is substantially similar as well.<sup>42</sup> The *Krofft* test includes an extrinsic test for similarity of ideas and an intrinsic test for similarity of expression.<sup>43</sup>

The extrinsic test for similarity of ideas is not dependent upon the reactions of the trier of fact.<sup>44</sup> Rather, the extrinsic test scrutinizes specific criteria, such as the type of artwork involved and the subject matter of the artwork, which the trier of fact can list and analyze.<sup>45</sup> If substantial similarity of ideas exists, then the trier of fact determines whether sufficient similarity of expression exists to constitute infringement.<sup>46</sup> This test is called the intrinsic test and is based upon the response of the ordinary reasonable person.<sup>47</sup> The *Krofft* court made clear that the intrinsic test was not designed to employ the same type of external criteria and analysis that mark the extrinsic test.<sup>48</sup> Accordingly, the *Krofft* court stated

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Thomas M.S. Hemnes, *The Adaptation of Copyright Law to Video Games*, 131 U. PA. L. REV. 171, 223 (1982) (footnotes omitted).

For a discussion of the history of substantial similarity, see 3 NIMMER, *supra* note 2, § 13.03[E], at 13-62.6 to 13-62.24, and Steven G. McKnight, *Substantial Similarity Between Video Games: An Old Copyright Problem in a New Medium*, 36 VAND. L. REV. 1277, 1285-92 (1983). See generally Henry V. Barry, *Toward a Model for Copyright Infringement*, 33 COPYRIGHT L. SYM. (ASCAP) 1 (1987); Steven Knowles & Ronald J. Palmieri, *Dissecting Krofft: An Expression of New Ideas in Copyright*, 8 SAN FERN. V. L. REV. 109 (1980).

<sup>41</sup> See *supra* note 7.

<sup>42</sup> Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1164 (9th Cir. 1977).

<sup>43</sup> *Id.*

<sup>44</sup> *Id.* "We shall call this the 'extrinsic test.' It is extrinsic because it depends not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed." *Id.*

<sup>45</sup> *Id.* "Such criteria include the type of artwork involved, the materials used, the subject matter, and the setting for the subject. Since it is an extrinsic test, analytic dissection and expert testimony are appropriate. Moreover, this question may often be decided as a matter of law." *Id.*

<sup>46</sup> *Id.*

<sup>47</sup> *Id.* "The test to be applied in determining whether there is substantial similarity in expressions shall be labeled an intrinsic one—depending on the response of the ordinary reasonable person." *Id.*

<sup>48</sup> *Id.* The *Krofft* court stated that "[t]he determination of when there is substantial similarity between the forms of expression is necessarily more subtle and complex" than the determination of similarity of ideas. *Id.* The former depends upon the "response of the ordinary reasonable person,"

that analytic "dissection"<sup>49</sup> and expert testimony were inappropriate for the intrinsic test.<sup>50</sup>

## II. THE NINTH CIRCUIT'S APPLICATION OF *KROFFT*

While the *Krofft* test may have significantly contributed to substantial similarity jurisprudence,<sup>51</sup> the Ninth Circuit should replace the *Krofft* test because it is proving unworkable.<sup>52</sup> An analysis of post-*Krofft* Ninth Circuit cases that turned on the issue of substantial similarity underscores the need for a workable test. This analysis reveals that Ninth Circuit courts apply the bifurcated test inconsistently.<sup>53</sup> Some decisions faithfully apply the

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whereas the latter involves "specific criteria which can be listed and analyzed." *Id.* In the determination of similarity of ideas, "analytic dissection and expert testimony are appropriate." *Id.*

<sup>49</sup> Analytic dissection, as contemplated by *Krofft*, refers to the detailed analysis of a work, such as "dissect[ing] further to analyze the clothing, colors, features, and mannerisms of each character." *Id.* at 1166-67.

<sup>50</sup> *Id.* at 1164. "It is intrinsic because it does not depend on the type of external criteria and analysis which marks the extrinsic test. . . . Because this is an intrinsic test, analytic dissection and expert testimony are not appropriate." *Id.*

<sup>51</sup> See *supra* note 40.

<sup>52</sup> "Although the Ninth Circuit has not repudiated *Krofft*, it has made it more workable by distorting it. This is accomplished by enormously expanding the meaning of idea . . . ." Kurtz, *supra* note 30, at 112 n.176.

In a 1990 Ninth Circuit opinion, Judge Alarcon remarked: "Indeed, a judicial determination under the intrinsic test is now virtually devoid of analysis, for the intrinsic test has become a mere subjective judgment as to whether two literary works are or are not similar." *Shaw v. Lindheim*, 908 F.2d 531, 535 (9th Cir. 1990); see *infra* note 156 (discussing *Shaw*).

<sup>53</sup> Professor Nimmer criticizes cases following *Krofft* for their "unevenness in application of this rule [disfavoring summary judgment]." 3 NIMMER, *supra* note 2, § 13.03[E], at 13-62.20 n.253. "[S]ubsequent to *Krofft*, the Ninth Circuit, although sporadically disapproving of the practice, has nonetheless affirmed many summary judgments in favor of defendants for lack of substantial similarity . . . ." *Id.*

Professor Nimmer traces a series of cases in which the Ninth Circuit seems to have reversed itself. *Id.* § 13.03[E], at 13-62.20 n.235. Professor Nimmer cites one case in which the Ninth Circuit denied summary judgment because "reasonable minds could differ as to whether [plaintiff's] Joy and [defendant's] Theme from E.T. are substantially similar." *Id.* (alteration in original) (quoting *Baxter v. MCA, Inc.*, 812 F.2d 421, 425 (9th Cir. 1987)). Professor Nimmer then notes that "[f]ive days after enunciating [the *Baxter*] rule, the Ninth Circuit reverted to approval of summary judgment for the defendant as a matter of law." *Id.* at 13-62.20-21 n.253 (referring to

*Krofft* test,<sup>54</sup> while others misapply it,<sup>55</sup> and others seemingly abandon it.<sup>56</sup> Accordingly, copyright holders, practicing attorneys, and legal scholars are unable to predict how a court will decide any given case.<sup>57</sup>

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Frybarger v. International Business Machs. Corp., 812 F.2d 525, 529 (9th Cir. 1987)).

After discussing several other cases, Professor Nimmer concludes that “[t]he lesson to be drawn from this progression is, at best, opaque.” *Id.* at 13-62.21 n.253.

<sup>54</sup> See *infra* notes 58-76 and accompanying text.

<sup>55</sup> See *infra* notes 77-96, 103-14 and accompanying text.

<sup>56</sup> See *infra* notes 97-102, 115-29 and accompanying text.

<sup>57</sup> In analyzing the approach of the court in *Broderbund Software, Inc. v. Unison World, Inc.*, 648 F. Supp. 1127 (N.D. Cal. 1986), one commentator noted that “the court’s very general definition of the idea underlying the interface would compel a finding of infringement by any greeting card printing program duplicating any of the other interface design choices embodied in [plaintiff’s work].” Alan S. Middleton, *A Thousand Clones: The Scope of Copyright Protection in the “Look and Feel” of Computer Programs*, 63 WASH. L. REV. 195, 212 (1988); see *infra* notes 80-83 and accompanying text (discussing *Broderbund* in greater detail). Middleton complains of the “elasticity—and therefore unpredictability—of the *Broderbund* approach.” Middleton, *supra*, at 212 n.134.

One observer has argued that “[r]esort to phrases such as ‘total concept and feel’ and use of the idea/expression distinction give . . . absolutely no guidance to authors about the extent of appropriation that is permissible and merely provide courts with a linguistic cloak for ad hoc decision making.” Barry, *supra* note 40, at 28.

Further, “courts have been unable, for the most part, to give authors much meaningful guidance on what constitutes infringement. It would have been very difficult, I imagine, for the lawyer for Film Ventures International to tell his client whether his movie infringed ‘Jaws’ prior to the district court’s determination that it did.” *Id.* at 29 (referring to *Universal City Studios, Inc. v. Film Ventures Int’l*, 543 F. Supp 1134 (C.D. Cal. 1982)); see *infra* note 83 (discussing *Universal*).

Others have noted that the courts have failed to apply the substantial similarity test uniformly:

Under one view, the fact-finder judges substantial similarity with respect to the whole of the copied portions of the plaintiff’s work, including portions that viewed in isolation might not be eligible for copyright. Under another view, the fact-finder first removes from consideration the uncopyrightable elements of the copied material. Such elements include facts, ideas, and “scenes a faire”. . . . The application of one or the other approach will frequently affect the outcome of the case, for any copyrighted literary work is likely to contain some, if not all, of the individually unprotectible elements.

ALAN LATMAN ET AL., COPYRIGHT FOR THE EIGHTIES: CASES AND MATERIALS

A. Cases Faithful to *Krofft*

In some cases, courts have applied the *Krofft* test straightforwardly and come up with reasonable and predictable results. One such case was *JBJ Fabrics, Inc. v. Mark Industries, Inc.*<sup>58</sup> The case involved two fabrics that had similar patterns.<sup>59</sup> The *JBJ Fabrics* court first applied the extrinsic test from *Krofft* and stated that the two ideas were unquestionably similar.<sup>60</sup> The court based its determination upon a review of subject matter, the material used, and the type of art involved.<sup>61</sup> The experts who testified all agreed that the ideas were essentially the same.<sup>62</sup> Thus, the *JBJ Fabrics* court's use of dissection and expert testimony were in accord with the extrinsic test as announced in *Krofft*.<sup>63</sup> The court then turned to the intrinsic test and noted that the test is based upon the responses of the average person.<sup>64</sup> The court concluded that the defendant had captured the very essence of the plaintiff's expression, and, since there were many ways to express the underlying idea, the defendant had infringed the plaintiff's copyright.<sup>65</sup>

Another opinion faithful to the *Krofft* test was *Religious Technology Center v. Scott*.<sup>66</sup> In this case, the plaintiff church claimed that the defendants had infringed the plaintiff's copyrighted documents.<sup>67</sup> The defendants' access to the plaintiff's work was

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476 (2d ed. 1985), quoted in Edward Samuels, *The Idea-Expression Dichotomy in Copyright Law*, 56 TENN. L. REV. 321, 419 n.444 (1989); see *supra* note 13 (demonstrating the judiciary's desire to have predictability in adjudication).

<sup>58</sup> 1987-88 Copyright L. Dec. (CCH) ¶ 26,233 (C.D. Cal. 1987).

<sup>59</sup> *Id.* at 21,643.

<sup>60</sup> *Id.* at 21,644.

<sup>61</sup> *Id.*

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

<sup>63</sup> See *supra* notes 44-45 and accompanying text (discussing the extrinsic test).

<sup>64</sup> *JBJ Fabrics*, 1987-88 Copyright L. Dec. (CCH) ¶ 26,233, at 21,644. "[The] intrinsic test of similarity . . . does not depend upon some hypercritical scrutiny of the works. It depends on the response of the ordinary reasonable person." *Id.*

<sup>65</sup> *Id.* at 21,645.

<sup>66</sup> 660 F. Supp. 515 (C.D. Cal. 1987).

<sup>67</sup> *Id.* at 518. The contested documents belonged to the plaintiff Church of Scientology. *Id.* at 517. The defendants "regard[ed] these documents as religious scriptures, embodying part of the advanced technology practiced by Scientologists." *Id.* at 516. The documents included a series of bulletins describing a procedure known as "New Era Dianetics for Operating Thetans." *Id.*

uncontested.<sup>68</sup> Because the defendants conceded the similarity of ideas between their documents and the plaintiff's, the *Religious Technology* court needed to apply only the intrinsic test for similarity of expression.<sup>69</sup> In holding for the defendant, the court stated that it could not conclude that an ordinary reasonable person would find the two works substantially similar in expression.<sup>70</sup>

In reaching its decision, the *Religious Technology* court refused to consider the comparison presented by the defendants.<sup>71</sup> The defendants' sought to have the court compare the number of headings in the two works and the order and sequence of the two works.<sup>72</sup> The court rejected the comparison, noting that such analysis resembles the extrinsic test, whereas the proper standard for the intrinsic test is the response of the ordinary reasonable person.<sup>73</sup>

The *Religious Technology* court scrupulously applied the *Krofft* standard. The court noted that nobody could have created the defendants' work without having a copy of the plaintiff's work at hand.<sup>74</sup> The court stated, however, that such a conclusion does not necessarily imply a finding of substantial similarity of expression.<sup>75</sup> Thus, both the *JBj Fabrics* and *Religious Technology* courts were faithful to *Krofft* in refraining from using an extrinsic test to analyze expression.<sup>76</sup>

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<sup>68</sup> *Id.* at 518.

<sup>69</sup> *Id.* at 520.

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

<sup>71</sup> *Id.*

<sup>72</sup> *Id.*

<sup>73</sup> *Id.*

<sup>74</sup> *Id.*

<sup>75</sup> *Id.* This was so because the bulk of the defendants' work consisted of text not found in the plaintiff's work. *Id.* at 521.

<sup>76</sup> See *supra* notes 46-50 and accompanying text (discussing the appropriate *Krofft* standards for analyzing expression).

Other cases have faithfully applied the *Krofft* bifurcated test as well. *Eisenman Chemical Co. v. NL Industries, Inc.*, 595 F. Supp. 141 (D. Nev. 1984) involved a dispute over a training manual. In the pertinent part of the case, the defendant counterclaimed for copyright infringement. *Id.*

In applying the intrinsic test, the *Eisenman* court noted that the defendant had copied more than half of the plaintiff's manual verbatim or virtually verbatim, including the typographical errors in the plaintiff's work. *Id.* at 146. The *Eisenman* court found infringement, stating that an ordinary observer would recognize that the defendant's manual had taken a substantial portion of the plaintiff's manual. *Id.*

In *Kamar International, Inc. v. Russ Berrie & Co.*, 657 F.2d 1059 (9th Cir.

B. *Intrinsic Dissection of Expression*

Not all courts have been as faithful in applying the *Krofft* test as the courts in *JBj Fabrics* and *Religious Technology*. In another group of cases, the courts were fairly faithful to *Krofft*, but they all made one common error: they improperly dissected expression while applying the intrinsic test.<sup>77</sup> The intrinsic test is supposed to be based on the reactions of the ordinary reasonable person.<sup>78</sup> Dissection should be reserved for ideas, which are considered under the extrinsic test.<sup>79</sup>

One such case was *Broderbund Software, Inc. v. Unison World, Inc.*,<sup>80</sup> which involved computer software programs for making personalized cards, signs, and banners. In holding for the plaintiff, the *Broderbund* court noted that the total concept and feel of the two programs was virtually identical: no ordinary observer could reasonably conclude that the expressions of the ideas were not substantially similar.<sup>81</sup> The court, however, engaged in analytic dissection by analyzing discrete portions of the programs and thus misapplied the *Krofft* test.<sup>82</sup> The *JBj Fabrics* court's reli-

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1981), the suit involved stuffed toy animals. The *Kamar* court used strong language in remanding the case to the district court for proper application of the *Krofft* test:

The court below made no mention of *Krofft* and nowhere does it employ the two-part test *Krofft* mandates. No finding of fact can be so construed. The only finding the court made on similarity indicates that the court used the analytic dissection method condemned by *Krofft*, or rather permitted by *Krofft* for the "extrinsic" test only.

*Id.*

<sup>77</sup> See *supra* notes 46-50 and accompanying text (discussing the *Krofft* standards for the intrinsic test).

<sup>78</sup> *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1162 (9th Cir. 1977).

<sup>79</sup> *Id.*

<sup>80</sup> 648 F. Supp. 1127 (N.D. Cal. 1986).

<sup>81</sup> *Id.* at 1137.

<sup>82</sup> See *id.* The *Broderbund* court used the following language in applying the intrinsic test:

In general, the sequence of the screens and the choices presented, the layout of the screens, and the method of feedback to the user are all substantially similar. Specifically, the following similarities exist *inter alia*: the structures of the "Main Menu" screens; the "staggered" layout of 3-2-3-2-3, totaling thirteen graphics; the "tiled" layout of 5 x 7 in both programs; the second screen in the "Custom Layout" function, in which the word "place" is highlighted and the word "remove" is inversely

ance upon the average consumer's reaction to a visual comparison of two fabrics was a more faithful application of the test announced in *Krofft*.<sup>83</sup>

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highlighted in both programs; the fact that the "tiled" option disappears in both programs in the medium-size graphic mode; the use of only left and right arrow keys on both keyboards, despite the fact that the IBM keyboard has up and down arrow capability . . . .

*Id.*

Professor Nimmer notes that after *Broderbund* "the Ninth Circuit has started to retreat from its disallowance of dissection under the intrinsic test of *Krofft*." 3 NIMMER, *supra* note 2, § 13.03[F], at 13-62.25 n.270; *see infra* notes 132-44 and accompanying text (discussing this trend); *supra* note 57 (presenting one observer's thoughts on *Broderbund*).

<sup>83</sup> *See supra* notes 46-50 and accompanying text (discussing the intrinsic test announced in *Krofft*).

Another case that falls within this category is *Spectravest, Inc. v. Mervyn's Inc.*, 673 F. Supp. 1486 (N. D. Cal. 1987), in which the contested work was a teddy bear fabric design. In applying the intrinsic test, the court stated that analytic dissection was inappropriate. *Id.* at 1492.

The *Spectravest* court, however, went on to analyze the use of strong primary colors, background colors, and types of garments involved. *Id.* The court noted that the only difference between the two designs was that some of the interconnecting lines in the defendant's pattern were attached to outlined hearts. *Id.* In concluding that the impressions were virtually indistinguishable to the viewer, the court seems to have applied analytic dissection inappropriately.

Other cases follow this same pattern. In *National Theme Productions, Inc. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348 (S.D. Cal. 1988), the court found that the defendant infringed the plaintiff's masquerade costumes. *Id.* at 1356. The *National Theme* court concluded that the overall impressions of the disputed costumes were the same, but inappropriately dissected the fabric content, use of fur, and color selection of the two works within the intrinsic test. *Id.*

In *Worth v. Selchow & Righter Co.*, 827 F.2d 569 (9th Cir. 1987), the court had before it the question of whether the defendant's board game "Trivial Pursuit" infringed the plaintiff's copyrighted encyclopedias of trivia. *Id.* at 569. The defendant acknowledged using the plaintiff's books. *Id.* at 571. In holding for the defendant, the trial court did not apply the extrinsic test. *Id.* at 572. Rather, the *Worth* trial court applied the intrinsic test and found that there was not substantial similarity of expression. *Id.* at 572, 574.

The *Worth* appellate court affirmed and was largely faithful to *Krofft*, in that the court based its holding on a lack of similarity of total concept and feel between the two works. *Id.* at 574. Yet, like the courts in *Broderbund*, *Spectravest*, and *National Theme*, the court in *Worth* dissected expression. *Id.* at 573. The *Worth* court discussed the arrangement of the plaintiff's book (alphabetical) in relation to the defendant's board game (color coded). *Id.*

C. *Merger or Scenes a Faire Analysis Applied*

In a third group of cases, the courts were again reasonably faithful to *Krofft*, but in these cases the courts used merger or *scenes a faire* language, which arguably circumvents a true *Krofft* analysis. Typical of these cases is *Aliotti v. R. Dakin & Co.*,<sup>84</sup> a case involving stuffed dinosaur dolls. The *Aliotti* court held that there is no substantial similarity of expression when the idea and expression are inseparable.<sup>85</sup>

*Data East USA, Inc. v. Epyx, Inc.*,<sup>86</sup> which followed *Aliotti*, involved a home computer karate game. The *Data East* court specifically quoted *Aliotti* and adopted the *Aliotti* court's reasoning.<sup>87</sup> The *Data East* court proclaimed that if all similarities in expression arise from the use of common ideas, the court cannot find substantial similarity.<sup>88</sup>

Several other cases share this approach.<sup>89</sup> The result of this

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Under *Krofft*, this discussion is inappropriate for determining whether substantial similarity of expression exists between two works. *See supra* notes 46-50 and accompanying text (discussing the appropriate standard for determining substantial similarity of expression).

Lastly, there is *Universal City Studios, Inc. v. Film Ventures Int'l, Inc.*, 543 F. Supp. 1134 (C.D. Cal. 1982). At issue was whether the defendant's motion picture "Great White" infringed the plaintiff's motion picture "Jaws." *Id.* at 1136. The *Universal* court granted the plaintiff's request for a preliminary injunction because it found that there was a significant likelihood that a jury, applying the intrinsic ordinary observer test, would find the expression of the ideas substantially similar. *Id.* at 1141.

The defendant had stipulated to a similarity of ideas, rendering analytic dissection unnecessary. *Id.* at 1137. Thus, the only issue was similarity of expression. *Id.* Nevertheless, the *Universal* court went into a lengthy finding of fact section in which it dissected the similarities. *Id.* at 1136-39. This application of the law leads to the conclusion that the court inappropriately relied upon such detailed analysis in determining that there was similarity of expression. *See supra* note 57 (presenting one commentator's thoughts on *Universal*).

<sup>84</sup> 831 F.2d 898 (9th Cir. 1987).

<sup>85</sup> *Id.* at 901. "No substantial similarity of expression will be found when 'the idea and its expression are . . . inseparable,' given that 'protecting the expression in such circumstances would confer a monopoly of the idea upon the copyright owner.'" *Id.* (quoting *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971)).

<sup>86</sup> 862 F.2d 204 (9th Cir. 1988).

<sup>87</sup> *Id.* at 208.

<sup>88</sup> *Id.*

<sup>89</sup> *Olson v. National Broadcasting Co., Inc.*, 855 F.2d 1446, 1453 (9th Cir. 1988) (stating that no substantial similarity may be found when all

line of reasoning is sound: a court should not afford a plaintiff copyright protection when there are only a limited number of ways of expressing an idea because doing so would create a monopoly in the idea.<sup>90</sup> The reasoning employed by the courts in these cases, however, is questionable.

The problem with the *Aliotti* and *Data East* approach is that when a court finds that no similarity of expression exists due to merger or *scenes a faire*, the court sidesteps the *Krofft* question of whether the expressions are or are not similar.<sup>91</sup> A court engages in legal fiction when it says that there is no substantial similarity of expression when there is substantial similarity of expression.<sup>92</sup> An alternate approach could be to say either that no substantial similarity of *protectable* expression exists or that because no protectable expression exists, the court does not reach the question of substantial similarity.<sup>93</sup>

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similarities arise from the use of common ideas); *Berkic v. Crichton*, 761 F.2d 1289, 1294 (9th Cir.) (holding that defendant's use of familiar scenes and staples does not raise a triable issue of fact), *cert. denied*, 474 U.S. 826 (1985); *Cory Van Rijn, Inc. v. California Raisin Advisory Bd.*, 697 F. Supp. 1136, 1140 (E.D. Cal. 1987) (rejecting defendant's assertion that substantial similarity can be analyzed only by comparing the works after unprotectable features are separated out).

<sup>90</sup> *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 740 (9th Cir. 1971).

<sup>91</sup> See *supra* notes 46-50 and accompanying text (discussing proper *Krofft* analysis).

<sup>92</sup> A legal fiction is a "situation contrived by the law to permit a court to dispose of a matter." BLACK'S LAW DICTIONARY 894 (6th ed. 1990). Such a situation exists when a court deems something to be other than what it is. For example, a "fiction of lost grant as basis for title by adverse possession." *Id.*

<sup>93</sup> Professor Nimmer seems to support this approach. See 3 NIMMER, *supra* note 2, § 13.03[F], at 13-62.21 to 13-77. He has posited a "successive filtering" test for computer programs. See *id.* Professor Nimmer suggests that a court, when considering a suit alleging copyright infringement of a computer program, should first "separate unprotectible ideas from protectible expression." *Id.* at 13-62.25. He suggests that the court should next exclude program elements dictated by logic and efficiency. *Id.* at 13-63. In this way, Professor Nimmer applies the merger doctrine to computer programs. "In the realm of computer programs, merger issues may arise in somewhat unusual ways." *Id.*

The next level of filtering is accomplished by excluding program elements dictated by external considerations. *Id.* at 13-65. Here, Professor Nimmer discusses the doctrine of *scenes a faire*, which "denies copyright protection to those elements that follow naturally from the work's theme rather than from the author's creativity." *Id.* "Thus, as another step in its analysis, a court

*Cooling Systems and Flexibles, Inc. v. Stuart Radiator, Inc.*<sup>94</sup> offers an example of this approach. In a case involving radiator catalogues, the *Cooling Systems* court rejected the plaintiff's argument that the reasonable observer would find the catalogues indistinguishable.<sup>95</sup> The *Cooling Systems* court held for the defendant, as did the courts in *Aliotti* and *Data East*, but the *Cooling Systems* court's analysis was more straightforward because it focused on the small amount of protectable expression involved.<sup>96</sup>

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should examine the allegedly infringed computer program after eliminating from consideration elements that are not original, or that flow naturally from considerations external to the author's creativity." *Id.*

Finally, "a core of protectible material may remain. If so, this material must be compared with material from the defendant's program to ascertain if there is a sufficient degree of similarity to justify a finding of infringement." *Id.* at 13-72.

<sup>94</sup> 777 F.2d 485 (9th Cir. 1985).

<sup>95</sup> *Id.* at 493.

<sup>96</sup> The *Cooling Systems* court acknowledged that because there were a limited number of ways of expressing the idea, the works were similar. *Id.* at 491. The court, however, did not use merger or *scenes a faire* language. Instead, the *Cooling Systems* court focused on the limited amount of protectable material. *Id.* "What is important is not whether there is substantial similarity in the total concept and feel of the works . . . but whether *the very small amount of protectible expression* in [plaintiff's] catalog is substantially similar to the equivalent portions of the [defendant's] catalog." *Id.* at 493 (emphasis added).

Professor Nimmer notes with approval that the approach the Ninth Circuit adopted in *Cooling Systems* is congruent with his proposed analysis for determining substantial similarity of computer programs. 3 NIMMER, *supra* note 2, § 13.03[F], at 13-73 & n.345; see *supra* note 93 (presenting Professor Nimmer's proposal).

One commentator suggests that *Cooling Systems* may mark the beginning of a trend to abandon the type of merger and *scenes a faire* analysis that this Comment criticizes:

One interpretation of *Roth* is that nonprotectable matter need not be factored out before application of the ordinary observer test. A subsequent Ninth Circuit decision, however, rejected this application of *Roth*. It held that, in the context of a compilation of otherwise nonprotectable elements, "[w]hat is important is not whether there is substantial similarity in the total concept and feel of the works . . . but whether the very small amount of protectible expression in *Cooling Systems*' catalog is substantially similar to the equivalent portions of the *Stuart's* catalog."

Middleton, *supra* note 57, at 203-04 n.66 (quoting *Cooling Systems*, 777 F.2d

D. *Ad Hoc Decisions*

While some courts have applied the *Krofft* test with varying degrees of faithfulness,<sup>97</sup> in other cases courts have not endeavored to use the *Krofft* test at all. One such case was *Landsberg v. Scrabble Crossword Game Players, Inc.*,<sup>98</sup> in which the plaintiff claimed that the defendant's handbook on strategy for a board game infringed the plaintiff's handbook. The *Landsberg* court applied a merger analysis, noting that a factual work such as the plaintiff's could be expressed in only a limited number of ways.<sup>99</sup> Accordingly, the plaintiff could have prevailed only upon a showing of verbatim copying or very close paraphrasing.<sup>100</sup>

The *Landsberg* court also referred to the *scenes a faire* doctrine, under which an author does not infringe even if she reproduces verbatim the second author's expression if that expression constitutes stock scenes that flow necessarily from common unprotectable ideas.<sup>101</sup> *Landsberg* is distinguishable from all the cases previously discussed in this Comment in that the *Landsberg* court did not attempt to apply the *Krofft* bifurcated test at all.<sup>102</sup>

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at 493, and referring to *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106 (9th Cir. 1970)).

Middleton's suggestion that *Cooling Systems* has rejected *Roth* may be premature. The majority of the cases discussed in this section were decided after *Cooling Systems* was decided in 1985 and did not follow *Cooling System's* lead. See *Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d 204 (9th Cir. 1988); *Olson v. National Broadcasting Co., Inc.*, 855 F.2d 1446 (9th Cir. 1988); *Aliotti v. R. Dakin & Co.*, 831 F.2d 898 (9th Cir. 1987); *Cory Van Rijn, Inc. v. California Raisin Advisory Bd.*, 697 F. Supp. 1136 (E.D. Cal. 1987).

Knowles and Palmieri propose a model in which "[o]nce this *unprotectable* 'quantum of expression' is identified, . . . it is *subtracted* from the *total* 'quantum of expression' contained in the work. Only this *remaining* 'quantum of expression' may be *protected*, and only it may be *infringed*." Knowles & Palmieri, *supra* note 40, at 129.

<sup>97</sup> See *supra* notes 58-96 and accompanying text.

<sup>98</sup> 736 F.2d 485 (9th Cir. 1984).

<sup>99</sup> *Id.* at 488.

<sup>100</sup> *Id.*

<sup>101</sup> *Id.* at 489; see *supra* notes 30-35 (discussing the *scenes a faire* doctrine).

<sup>102</sup> See *Landsberg*, 736 F.2d at 489. In simply announcing that "the substantial similarity inquiry will vary according to the context in which it is applied," the *Landsberg* court discussed neither similarity of ideas nor the reactions of a reasonable observer. *Id.*

Similarly, in *Johnson Controls, Inc. v. Phoenix Control Systems, Inc.*, 886 F.2d 1173 (9th Cir. 1989), the court failed to bifurcate the test for substantial similarity. At issue was a computer program to control wastewater treatment plants. *Id.* at 1174. The appellate court affirmed the

*E. Extrinsic Dissection of Expression*

While in some cases courts have erred by mistakenly dissecting expression within the context of the intrinsic test,<sup>103</sup> in other cases court have misapplied the *Krofft* test by dissecting expression within the context of the extrinsic test.<sup>104</sup> Instead of using the ordinary observer test and total look and feel, these courts have resorted to analytic dissection in determining if substantial similarity of expression exists. The decisions of the courts in these cases have expanded the extrinsic test to include expression.<sup>105</sup>

*Jason v. Fonda*<sup>106</sup> seems to be the first case to misapply *Krofft* in this particular way. In setting out the criteria for applying the extrinsic test, *Krofft* was quite explicit.<sup>107</sup> The purpose of the

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trial court's grant of a preliminary injunction for the plaintiff. *Id.* at 1174, 1177.

In reaching its decision, the *Johnson Controls* court relied upon a special master's report that set forth in detailed form the various similarities between the programs. *Id.* at 1176. A "master's report" is the "formal report or statement made by a master in chancery of his decision on any question referred to him, or of any facts or action he has been directed to ascertain or take." BLACK'S LAW DICTIONARY 976 (6th ed. 1990). Referring to the master's report, the *Johnson Controls* court wrote: "These similarities, both in idea and expression, would permit a reasonable person to find an unlawful appropriation, a capture by the infringing work of the 'total concept and feel' of Johnson's work." *Johnson Controls*, 886 F.2d at 1176.

It appears that the *Johnson Controls* court was content to apply a simple ad hoc test rather than faithfully apply the *Krofft* test. *See id.* The court erred twice in applying the *Krofft* test. First, the *Johnson Controls* court applied "total concept and feel" in determining that there was a similarity of ideas. *Id.* Second, the court inappropriately used detailed analysis in determining whether there was a similarity of expression. *See id.* Further, the *Johnson Controls* court made no mention at all of the bifurcated intrinsic and extrinsic tests. *Id.* at 1173-77.

<sup>103</sup> *See supra* notes 77-83 and accompanying text.

<sup>104</sup> The cases that fall within this category are even less faithful to the *Krofft* test than those in which the courts abandoned the *Krofft* test in favor of an ad hoc test. *See supra* notes 97-102 and accompanying text. At least the ad hoc cases left the *Krofft* test undisturbed. In contrast, the cases discussed in this section have radically altered the *Krofft* test and are thus less faithful to *Krofft* than the cases in which the courts ignored *Krofft*.

<sup>105</sup> *See supra* notes 44-50 and accompanying text (discussing the role of the extrinsic test in analyzing ideas and the proper test for analyzing substantial similarity of expression).

<sup>106</sup> 526 F. Supp. 774 (C.D. Cal. 1981), *aff'd and incorporated by reference*, 698 F.2d 966 (9th Cir. 1982).

<sup>107</sup> *See Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*,

extrinsic test is to determine if substantial similarity of ideas exists between two works.<sup>108</sup> Nevertheless, the *Jason* court placed original language between two *Krofft* quotes and, under the guise of faithfully applying the *Krofft* test, misapplied and altered the test.<sup>109</sup> The *Jason* court mentioned that specific criteria may be analyzed, but expanded the *Krofft* criteria to include characteristics such as plot, themes, dialogue, mood, pace, and sequence.<sup>110</sup> By doing so, the *Jason* court gravely misapplied *Krofft*, and subsequent cases expanded upon this misapplication.<sup>111</sup>

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562 F.2d 1157, 1164 (9th Cir. 1977) (“Such criteria include the type of artwork involved, the materials used, the subject matter, and the setting for the subject.”).

<sup>108</sup> *Id.* The *Krofft* court stated:

The determination of whether there is substantial similarity in ideas may often be a simple one. Returning to the example of a nude statue, the idea there embodied is a simple one—a plaster recreation of a nude human figure. A statue of a horse or a painting of a nude would not embody this idea and therefore could not infringe.

*Id.*

<sup>109</sup> The *Jason* court wrote:

According to the *Krofft* court, this step is an “extrinsic test” because “it depends not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed.” *The criteria in this case might include such characteristics of a written work as plot, themes, dialogue, mood, setting, pace and sequence.* Since the extrinsic test focuses on a comparison of these abstracted criteria, “analytic dissection and expert testimony are appropriate.”

*Jason*, 526 F. Supp. at 777 (quoting *Krofft*, 562 F.2d at 1164) (emphasis added) (citation omitted).

The italicized language represents a departure from *Krofft*, which specifically enumerated the factors that a court may properly consider. *See, e.g., supra* note 107 (quoting *Krofft* in regard to the criteria a court should consider).

<sup>110</sup> *Jason*, 526 F. Supp. at 777; *see supra* notes 108-09.

<sup>111</sup> Specifically, the italicized sentence quoted *supra* in note 109 opened up the proverbial Pandora’s box. In 1984, one of the first cases to adopt the language of *Jason* was *Litchfield v. Spielberg*, 736 F.2d 1352 (9th Cir. 1984), where the court declared that “[t]he extrinsic test requires a comparison of plot, theme, dialogue, mood, setting, pace and sequence.” *Id.* at 1356. In 1985, *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir.), *cert. denied*, 474 U.S. 826 (1985), quoted directly the *Litchfield* quote above. In 1988, *Olson v. National Broadcasting Co., Inc.*, 855 F.2d 1446, 1450 (9th Cir. 1988) quoted this language from *Berkic*, which was quoting *Litchfield*, and directed the reader to see *Jason*.

Thus, four generations have followed *Jason*’s misreading of *Krofft*. *See Shaw v. Lindheim*, 908 F.2d 531, 534-35 (9th Cir. 1990) (tracing this same

Plots and themes are what ideas are made of, but dialogue, mood, pace, and sequence are the very essence of expression.<sup>112</sup>

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chain of cases and making the same point); *infra* notes 117-23 and accompanying text (illustrating how the court in *Olson* was misguided even further by following *Berkic's* lead); *infra* note 156 (discussing *Shaw*).

Professor Nimmer has addressed this same issue:

*Litchfield v. Spielberg*, 736 F.2d 1352 (9th Cir. 1984) . . . held that the *Krofft* extrinsic test "requires a comparison of plot, theme, dialogue, mood, setting, pace and sequence." At least in its reference to plot, dialogue and sequence this would appear to go beyond a comparison of mere ideas, and enter the sphere of expression. . . . [*Litchfield*] would appear to have improperly applied the intrinsic test. Citing *Krofft*, *Litchfield* stated: "To constitute infringement of expression, the total concept and feel of the works must be substantially similar."

3 NIMMER, *supra* note 2, § 13.03[E], at 13-62.22-23 n.259 (quoting *Litchfield*, 736 F.2d at 1357).

Another observer has also addressed this issue:

It is rather curious that the Ninth Circuit in *Berkic* attributes to the idea part of the analysis the comparison of "plot, themes, dialogue, mood, setting, pace, characters, and sequence of events." *Berkic*, 761 F.2d at 1292. At least some of the aspects, if substantially similar enough, would seem to go to similarity of expression. *Cf. Reyher v. Children's Television Workshop*, 553 F.2d 87, 91 (2d Cir.) ("the essence of infringement lies in taking not a general theme but its particular expression through similarities of treatment, details, scenes, events and characterization"), *cert. denied*, 429 U.S. 980 (1976); *Universal City Studios, Inc. v. Film Ventures Int'l, Inc.*, 543 F. Supp. 1134, 1141 (C.D. Cal. 1982) (attributing "the basic story points, the major characters, the sequence of incident, and the development and interplay of the major characters and story points" to expression, not idea).

*Samuels*, *supra* note 57, at 425 n.471.

<sup>112</sup> While the *Krofft* case is not completely analogous to *Jason* because *Jason* involved a movie and *Krofft* involved television characters geared toward children, an excerpt from *Krofft* may be illustrative here. In holding that the defendant's "McDonaldland" characters infringed plaintiff's "H. R. Pufnstuf" characters, the *Krofft* court wrote: "[D]efendants . . . dissect further to analyze the clothing, colors, features, and mannerisms of each character. We do not believe that the ordinary reasonable person, let alone a child, viewing these works will even notice that Pufnstuf is wearing a cummerbund while Mayor McCheese is wearing a diplomat's sash." *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1166-67 (9th Cir. 1977).

The point here is that the intrinsic, ordinary observer test is supposed to be devoid of the dissection and analysis provided for by *Jason*. See *supra* notes 46-50 and accompanying text.

Dissection of expression is inappropriate under the extrinsic test.<sup>113</sup> *Jason* ignored *Krofft*'s admonition that analysis of ideas is simple and thus paved the way for *Jason*'s progeny to travel down the same wrong path.<sup>114</sup>

#### F. Cases Badly Misapplying *Krofft*

In the majority of cases discussed so far, the courts have applied the *Krofft* test with varying degrees of faithfulness.<sup>115</sup> In other cases, the courts have abandoned the *Krofft* test in favor of an ad hoc test.<sup>116</sup> In a final group of cases, the courts have not abandoned the test altogether, but have badly misapplied it.

For example, in *Olson v. National Broadcasting Co., Inc.*<sup>117</sup> the plaintiff complained that the defendant's television show "The A-Team" infringed the plaintiff's television series pilot "Cargo." The Ninth Circuit affirmed the district court's grant of judgment notwithstanding the verdict for the defendant, ruling that the works were not substantially similar.<sup>118</sup> The *Olson* court stated that both works "share a common idea: Both are action-adventure series designed to show Vietnam veterans in a positive light."<sup>119</sup> The *Olson* court proclaimed, however, that "[t]his idea, standing alone, is not protectable."<sup>120</sup>

While it is true that an idea is not protectable, the court is not supposed to determine if an idea is protectable under the *Krofft* test.<sup>121</sup> The *Olson* court erred because under *Krofft*'s extrinsic test the court's only job is to determine whether a similarity of ideas exists.<sup>122</sup> *Krofft* made it clear that ideas need not be protectable for a court to determine that the ideas are similar.<sup>123</sup>

Another case in which a court badly misapplied *Krofft* was *Cory*

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<sup>113</sup> *Krofft*, 562 F.2d at 1164.

<sup>114</sup> See *supra* note 111.

<sup>115</sup> See *supra* notes 58-96, 103-14 and accompanying text.

<sup>116</sup> See *supra* notes 97-102 and accompanying text.

<sup>117</sup> 855 F.2d 1446 (9th Cir. 1988).

<sup>118</sup> *Id.* at 1453.

<sup>119</sup> *Id.* at 1450.

<sup>120</sup> *Id.*

<sup>121</sup> Nowhere does the *Krofft* opinion suggest that a court should determine whether an idea is protectable. See *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977).

<sup>122</sup> *Id.* at 1164 ("We shall call [the test for similarity of ideas] the extrinsic test.").

<sup>123</sup> *Id.* at 1163. "It is an axiom of copyright law that the protection granted to a copyrighted work extends only to the particular expression of

*Van Rijn, Inc. v. California Raisin Advisory Board*,<sup>124</sup> which involved animated raisin figures. The *Cory Van Rijn* court found no similarity of ideas because, “other than the common idea of an anthropomorphic raisin . . . [there were] no extrinsic similarities between the two works.”<sup>125</sup> A finding that both works had the similar idea of an anthropomorphic raisin, however, should have ended the extrinsic inquiry.<sup>126</sup> This is so because once the trier of fact determines that a substantial similarity of ideas exists, the trier of fact’s attention should turn to the issue of similarity of expression.<sup>127</sup>

Instead, the *Cory Van Rijn* court went into a detailed analysis of similarities, which appears to be an analytic dissection of expression.<sup>128</sup> An alternative analysis was available: The court could have held that even though the ideas were similar, the defendant did not infringe the plaintiff’s work because the expressions were not similar. The court could have predicated this holding on its finding that an ordinary observer, after seeing how differently the parties expressed the common idea, could not have confused the two works.<sup>129</sup>

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the idea and never to the idea itself.” *Id.* (citations omitted). This quote impliedly asserts that in every work there is an unprotectable idea.

It is unclear why the *Olson* court thought it should determine whether the idea was protectable. Such an inquiry is not relevant to the *Krofft* test. It is clear, however, that this was not an original idea of the *Olson* court. Here, *Olson* follows *Berkic* and *Jason*, as discussed *supra* in note 111.

<sup>124</sup> 697 F. Supp. 1136 (E.D. Cal. 1987).

<sup>125</sup> *Id.* at 1144.

<sup>126</sup> The *Krofft* test mandates that after the trier of fact determines that there is a similarity of ideas, the extrinsic inquiry ends. *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977) (“If there is substantial similarity in ideas, then the trier of fact must decide whether there is substantial similarity in the expressions of the ideas so as to constitute infringement.”).

<sup>127</sup> *Id.*

<sup>128</sup> *Cory Van Rijn*, 697 F. Supp at 1142-43. The *Cory Van Rijn* court’s analytic dissection of the characters’ eyes, mouths, arms, hands, legs, feet, etc., is a dissection of expression rather than an analysis of the idea. *See id.* The *Cory Van Rijn* court’s detailed analysis led the court to conclude that “there are no extrinsic similarities . . . other than the common idea.” *Id.* at 1144.

Professor Nimmer lends support to the notion that the *Cory Van Rijn* court was misguided in searching for other ideas: “Under *Krofft* any idea which is found in both plaintiff’s and defendant’s works is sufficient to satisfy the extrinsic test.” 3 NIMMER, *supra* note 2, § 13.03[E], at 13-62.19 n.248.

<sup>129</sup> The *Cory Van Rijn* court found that “the two works do not in any way

## III. PROPOSAL: A FOUR-PART TEST FOR SUBSTANTIAL SIMILARITY

## A. Olson Revisited

As demonstrated by the preceding discussion, Ninth Circuit courts have applied the *Krofft* test with varying degrees of faithful-

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look alike beyond the raisin bodies, and the images projected are completely different.” *Cory Van Rijn*, 697 F. Supp. at 1145. The court would have been more faithful to *Krofft* had it based its holding on the finding that the expressions were completely different.

*Krofft* was also badly misapplied in *Overman v. Universal City Studios, Inc.*, 605 F. Supp. 350 (C.D. Cal. 1984), in which the plaintiff claimed that the defendant’s movie “Bustin’ Loose” infringed the plaintiff’s screenplay “Easy Money.” In the *Overman* court’s discussion of similarity of *ideas*, the court considered factors that are appropriate only to an intrinsic analysis of *expression*: “The *basic tone and feel* of ‘Bustin’ Loose’ is a light-hearted and sentimental comedy. . . . The *basic impression* of ‘Easy Money’ is an earthy and sometimes violent comedy . . . .” *Id.* at 353 (emphasis added).

Similarly, the *Overman* court erred in applying the intrinsic test. After considering the total concept and feel as perceived by the ordinary observer, the court launched into a point-by-point analysis of the 19 similarities that the plaintiff alleged. *Id.* at 353-54. Properly, such dissection should be reserved for the extrinsic test. *See supra* notes 44-45 and accompanying text (discussing proper standards for the extrinsic test). Thus, the *Overman* court misapplied *Krofft* badly.

The *Overman* court concluded its analysis of similarity of expression by announcing that “the basic ‘lesson’ of the works is completely different.” *Overman*, 605 F. Supp. at 354. The “lesson” of a movie or screenplay, however, is akin to its idea, and thus should not be considered in determining if there is similarity of expression.

Another case presenting analytic problems is *McCulloch v. Albert E. Price, Inc.*, 823 F.2d 316 (9th Cir. 1987), in which plates bearing the logo “You Are Special Today” were the disputed works. The appellate court noted that paragraph 17 of the district court’s Findings of Fact stated that defendant’s plate “is confusingly similar in appearance to Plaintiff’s plate.” *Id.* at 319. The appellate court concluded that such a finding is “tantamount to finding substantial similarities in the objective details of the plates.” *Id.* Accordingly, in holding for the plaintiff over defense arguments to the contrary, the *McCullough* appellate court determined that the *ideas* of the two works were substantially similar. *Id.*

This reasoning is unsound. Noting a confusing similarity between two works is *not* tantamount to dissecting the works for similarity of ideas. Rather, it is tantamount to a finding of similarity of total concept and feel. The defendant was correct in claiming that the extrinsic prong of the test was “short circuited” because neither the appellate nor the district court ever examined similarity of ideas. The appellate court acknowledged that “the district court did not expressly state that it was applying the two-part test,” but concluded that “it is clear from the record that the [district] court found a similarity of ideas and expression.” *Id.*

ness. Although the test is not wholly unworkable,<sup>130</sup> the majority of cases have either applied the *Krofft* test in a contrary fashion or abandoned it altogether.<sup>131</sup> Specifically, most of the courts seem to want to subject expression to the type of analytic dissection that *Krofft* said was reserved for ideas alone. The courts that employed these seemingly anomalous approaches may have done so because in some circumstances the bifurcated test does not yield results that are in accordance with the policy goals of copyright law.<sup>132</sup>

Consider *Olson v. National Broadcasting Co., Inc.*,<sup>133</sup> which involved the defendant's television show "The A-Team."<sup>134</sup> Had the court been faithful to *Krofft*, the plaintiff would have prevailed, because a plaintiff can establish infringement under the *Krofft* test by establishing access to the copyrighted work and similarity of both idea and expression.<sup>135</sup> The *Olson* court found that the works shared a common idea.<sup>136</sup> The *Olson* court also found that "a reasonable jury might have found substantial similarity of expression in the 'total concept and feel of the works.'"<sup>137</sup> Given these two findings, absent a defense of merger or *scenes a faire*, a court applying the *Krofft* test may well have held for the plaintiff.

The *Olson* court, however, held for the defendant.<sup>138</sup> In affirming the district court's grant of judgment notwithstanding the verdict, the *Olson* court analyzed plot, theme, dialogue, mood, setting, pace, and sequence as part of its extrinsic test for similarity of ideas.<sup>139</sup> The *Olson* court found that the two works were dissimilar in plot, sequence, dialogue, and setting.<sup>140</sup> Apparently, the *Olson* court believed that such factors merit consideration in determining if there is infringement, even though the *Krofft* opin-

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<sup>130</sup> See *supra* notes 58-76 and accompanying text (citing several cases that faithfully applied the test with reasonable results).

<sup>131</sup> See *supra* notes 77-129 and accompanying text.

<sup>132</sup> See *supra* notes 16-19 and accompanying text (discussing the policy goals of copyright law).

<sup>133</sup> 855 F.2d 1446 (9th Cir. 1988)

<sup>134</sup> See *supra* notes 117-23 and accompanying text (discussing *Olson*).

<sup>135</sup> See *supra* notes 40-50 and accompanying text (discussing the *Krofft* test for substantial similarity).

<sup>136</sup> *Olson*, 855 F.2d at 1450 ("Both are action-adventure series designed to show Vietnam veterans in a positive light.").

<sup>137</sup> *Id.* at 1453.

<sup>138</sup> *Id.* at 1454.

<sup>139</sup> *Id.* at 1450.

<sup>140</sup> *Id.*

ion makes no reference to plot, sequence, and dialogue.<sup>141</sup>

It may have been "right," however, for the *Olson* court to hold for the defendant, even though doing so required the court to misapply the test established in *Krofft*. It may have been "right" because such a holding is in accordance with the policy goals of copyright law: society does not want to give a plaintiff a monopoly and foreclose a defendant's artistic endeavors.<sup>142</sup>

If one were to analyze the plot, theme, dialogue, mood, setting, pace, and sequence of the works in *Olson*, one would probably find that the expressions were not substantially similar.<sup>143</sup> Thus, arguably, the defendant should have prevailed, as the defendant did.<sup>144</sup> If the *Olson* court had restricted itself to a strict application of the *Krofft* test, however, the *Olson* court would have been

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<sup>141</sup> See *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1162 (9th Cir. 1977); *supra* note 111 (demonstrating the desire of several courts to expand the scope of factors that a court may consider in determining if there is substantial similarity).

Regarding *Olson*, Professor Nimmer has written:

[T]he court conceded that the jury acted reasonably in finding "substantial similarity in the 'total concept and feel of the works'" and that "deference is due to a jury's finding of substantial similarity . . ." . . . It remains to be seen whether other courts will discard "total concept and feel" in other contexts as well.

3 NIMMER, *supra* note 2, § 13.03[A], at 13-36 n.63. Nimmer has also stated that "[i]n deed if not in word, *Olson* comes close to abandoning the audience test, perhaps portending *Krofft's* demise." *Id.* § 13.03[E], at 13-62.16.

It is beyond peradventure that in the 14 years since the *Krofft* court rendered its decision, the trend has been to allow dissection of expression. See *supra* note 111 (discussing four generations of cases beginning with *Jason*). Professor Kurtz has written:

Although the Ninth Circuit has not repudiated *Krofft*, it has made it more workable by distorting it. This is accomplished by enormously expanding the meaning of idea, saying that the test for substantial similarity of ideas compares "not the basic plot ideas for stories, but the actual concrete elements that make up the total sequence of events and the relationships between the major characters. . . . It 'requires a comparison of plot, theme, dialogue, mood, setting, pace and sequence.'"

Kurtz, *supra* note 30, at 112 n.176 (quoting *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir.), *cert. denied*, 474 U.S. 826 (1985), which quoted *Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir. 1984)).

<sup>142</sup> See *supra* notes 16-19 and accompanying text (discussing copyright law's policy goals).

<sup>143</sup> See *Olson*, 855 F.2d at 1450.

<sup>144</sup> See *id.* at 1454.

forced to hold for the plaintiff. This is because both a similarity of ideas and a similarity of expression (using the total concept and feel test) were present.

Thus, Ninth Circuit courts have modified *Krofft* by analyzing and dissecting expression. The courts have done so because they believe that strict application of the *Krofft* text will obtain results that are unjust, or in opposition to copyright law's policy goals, or both.

### B. A Modest Proposal

This Comment proposes a test designed with two premises and policy goals in mind. First, judicial resources are scarce, and courts need to dispose of cases as easily as possible.<sup>145</sup> Second, it is desirable to have the state of the law settled enough for parties to be able to predict how a court will apply the law to the facts of their particular case.<sup>146</sup>

The problem with the treatment of substantial similarity in the wake of *Krofft* is that Ninth Circuit courts have been inconsistent: some cases are faithful to *Krofft*, while others abandon and misapply it.<sup>147</sup> This unpredictability runs counter to the judiciary's commitment to protecting settled expectations and following precedent.<sup>148</sup> Thus, the proposal this Comment suggests includes a step for dissecting expression. In essence, this Comment incor-

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<sup>145</sup> "Summary judgment procedure is properly regarded not as a disfavored procedural shortcut, but rather as an integral part of the Federal Rules as a whole, which are designed 'to secure the just, speedy and inexpensive determination of every action.'" *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986) (quoting FED. R. CIV. P. 1).

[A] series of copyright cases in the Southern District of New York have granted defendants summary judgment when all alleged similarity related to *non*-copyrightable elements of the plaintiff's work. These cases signal an important development in the law of copyright, permitting courts to put a "swift end to meritless litigation" and to avoid lengthy and costly trials.

*Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 977 (2d Cir. 1980) (quoting *Quinn v. Syracuse Model Neighborhood Corp.*, 613 F.2d 438, 445 (2d Cir.), *cert. denied*, 499 U.S. 841 (1980)).

<sup>146</sup> See *supra* note 13 (demonstrating the judiciary's desire to have predictability in adjudication); *supra* note 53 (discussing how inconsistently the Ninth Circuit has applied the *Krofft* test); *supra* note 57 (discussing how unpredictable the law of substantial similarity is in the Ninth Circuit).

<sup>147</sup> See *supra* notes 58-129 and accompanying text.

<sup>148</sup> See *supra* note 13 (discussing the desirability of predictability in adjudication).

porates what Ninth Circuit courts have been doing de facto since *Krofft*. The advantage of the proposed approach is that it will add predictability to an otherwise unsettled area of the law.

Accordingly, this Comment offers a four-part test. A plaintiff must pass each part of the test to have a viable cause of action. In the first part, when faced with a defendant's summary judgment motion, the court should ask if there is substantial similarity of ideas. This is the same test that *Krofft* promulgated in its extrinsic prong<sup>149</sup> and is a simple inquiry.<sup>150</sup> If no such similarity exists as a matter of law, the court should grant the defendant's motion for summary judgment. If the court needs to find facts to determine if a substantial similarity of ideas exists, or if the court concludes that the ideas are substantially similar, the inquiry should continue.<sup>151</sup>

In the second part of the test, the court should determine whether the plaintiff's work contains protectable material.<sup>152</sup> It is

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<sup>149</sup> See *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977); *supra* notes 44-45 and accompanying text.

<sup>150</sup> See *supra* note 108.

<sup>151</sup> If a court finds that a substantial similarity of ideas exists or even if a court cannot rule dispositively on the similarity of ideas, a jury trial will not necessarily be required. This is because a court, by applying the second and third steps of the test, may still be able to hold for the defendant as a matter of law based upon the pleadings alone.

In some instances, however, the court may determine that a trial is required. At the conclusion of the trial, the judge would have an opportunity to rule as a matter of law on whether the ideas are substantially similar.

<sup>152</sup> This test is not unlike the successive filtering test Professor Nimmer proposed in the context of computer programs. See *supra* note 93. This Comment, however, proposes to apply the filtering test to all copyrightable material. In addition to incorporating the changes in the *Krofft* test that Ninth Circuit courts have adopted de facto, this Comment proposes that courts eliminate unprotectable material when determining if substantial similarity exists between two works. Unprotectable expression refers to *scenes a faire* and expressions that have merged with the ideas expressed. See *supra* notes 21-35, 84-96 and accompanying text. Unprotectable expression also includes factual material. See 3 NIMMER, *supra* note 2, § 13.03[B], at 13-58.

By eliminating unprotectable material in the second part of the test, the court will be able, in some cases, to determine early in its analysis that the plaintiff has no protectable material at all. See 3 NIMMER, *supra* note 2, § 13.03[F], at 13-74. One of the advantages of the successive filtering test is that it enables a court to decide a case as a matter of law, thus conserving judicial resources. See *supra* note 145. One of Professor Nimmer's criticisms

at this stage that the defendant may assert the equivalent of a merger or *scenes a faire* defense under present *Krofft* jurisprudence.<sup>153</sup> The defendant will have an opportunity to show either that the plaintiff's work contains no protectable material or, in the alternative, that certain portions of the plaintiff's work are not protectable because the expressions in those parts are inseparable from the ideas or necessarily flow from common ideas.<sup>154</sup> If the defendant can show that the plaintiff's work contains no protectable expression, the court should grant the defendant's motion for summary judgment. If, on the other hand, the plaintiff's work contains some protectable expression, the court should proceed to the third part of the test.

In the third part of the test, the court should limit its inquiry to similarities between the defendant's work and *only* the protectable portion of the plaintiff's work. In this part, the court should use an objective test for similarity of expression.<sup>155</sup> Ninth Circuit courts appear willing to continue applying the law in this way.<sup>156</sup> Moreover, there appears to be some wisdom in following this

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of *Krofft* is that the *Krofft* test makes it difficult for a court to dispose of a case as a matter of law. 3 NIMMER, *supra* note 2, § 13.03[E], at 13-62.18-19; *see supra* notes 84-96 and accompanying text (demonstrating that some courts have eliminated unprotectable material as part of the intrinsic test, rather than as a separate part of an overall test for substantial similarity).

<sup>153</sup> *See supra* notes 84-96 and accompanying text (discussing the difficulty surrounding and confusion resulting from the current application of the merger and *scenes a faire* doctrines in substantial similarity analysis). By incorporating the doctrines as suggested, the use of legal fiction will be rendered unnecessary. *See supra* note 92 and accompanying text. Further, by introducing the issue early in the analysis, the court may dispose of some cases easily, prior to an inquiry into similarity of expression.

<sup>154</sup> This parallels the defenses of merger and *scenes a faire* asserted in the cases discussed *supra* at notes 84-96 and accompanying text.

<sup>155</sup> *See supra* notes 103-14, 133-44 and accompanying text (demonstrating that some Ninth Circuit courts have adopted an objective test for similarity of expression).

<sup>156</sup> *See, e.g., Shaw v. Lindheim*, 908 F.2d 531 (9th Cir. 1990). In *Shaw*, the contested work was a television pilot script. *Id.* at 553. The appellate court reversed the trial court's summary judgment for the defendant because the plaintiff had presented a triable issue of fact regarding substantial similarity. *Id.* at 541. In its review of the scope of the *Krofft* test, the *Shaw* court noted that *Jason* and its progeny expanded the *Krofft* criteria for determining similarity of ideas. *Id.* at 534 (referring to *Jason v. Fonda*, 526 F. Supp. 774 (C.D. Cal. 1981), *aff'd and incorporated by reference*, 698 F.2d 966 (9th Cir.

approach.<sup>157</sup> If the Ninth Circuit incorporates this prong into its test for substantial similarity, the Ninth Circuit will increase the stability and predictability of the judicial system with respect to copyright cases.<sup>158</sup> If the court finds that objective similarity of expression does not exist, the court should grant the defendant's motion for summary judgment. If, on the other hand, objective similarity of expression does exist, the court should proceed to the fourth part of the test.

Under the fourth part of the test, the court should consider the subjective analysis of expression, the look and feel. This is the second prong of the original *Krofft* test and requires a finding of

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1982)); *see supra* notes 103-14 and accompanying text (discussing this point in detail).

The *Shaw* appellate court complained that the absence of legal analysis frustrates appellate review of the intrinsic test:

Now that it includes virtually every element that may be considered concrete in a literary work, the extrinsic test as applied to books, scripts, plays, and motion pictures *can no longer be seen as a test for mere similarity of ideas*. Because the criteria incorporated into the extrinsic test encompass all objective manifestations of creativity, the two tests are more sensibly described as objective and subjective analyses of *expression*, having strayed from *Krofft's* division between expression and ideas. *See Narell*, 872 F.2d at 912 (referring to an *objective*, extrinsic test and a *subjective*, intrinsic test). Indeed, a judicial determination under the intrinsic test is now virtually devoid of analysis, for the intrinsic test has become a mere subjective judgment as to whether two literary works are or are not similar.

*Shaw*, 908 F.2d at 535 (first emphasis added) (citations omitted) (referring to *Narell v. Freeman*, 872 F.2d 907 (9th Cir. 1989)).

*Shaw* was decided in July 1990. It is especially pertinent because it shows the direction the courts have moved in and it underscores the need for a workable standard.

<sup>157</sup> *See supra* notes 133-44 and accompanying text (discussing *Olson*).

<sup>158</sup> A party to a copyright suit will know whether, in a particular suit, the court will analytically dissect expression because analytic dissection of expression will be the rule in all copyright suits if the proposed model is adopted by the Ninth Circuit. Under the current state of the law a party to a copyright suit can only guess whether or not the court will choose either to follow *Krofft* strictly, *see supra* notes 58-76 and accompanying text, to analytically dissect expression, *see supra* notes 77-83, 103-14 and accompanying text, to use an ad hoc test, *see supra* notes 97-102 and accompanying text, or to use some different standard altogether, *see supra* notes 115-29 and accompanying text.

fact.<sup>159</sup> If the court reaches this fourth step, it must deny the defendant's motion for summary judgment and proceed with a trial to obtain the finding of fact.<sup>160</sup> If the plaintiff passes the first three parts of the test and the trier of fact determines that subjective similarity of expression exists, the plaintiff will have established copyright infringement.<sup>161</sup>

### CONCLUSION

Ninth Circuit courts have applied the *Krofft* test for substantial similarity inconsistently. This inconsistency has resulted in an unpredictability that runs counter to jurisprudential principles.<sup>162</sup> Attorneys are unable to tell clients whether a particular action will or will not infringe another's copyright. The test proposed by this Comment addresses and eliminates this problem.<sup>163</sup> Additionally, the proposed test saves judicial resources by allowing courts to dispose of many cases on summary judgment.<sup>164</sup>

While the *Krofft* test is not wholly unworkable,<sup>165</sup> many Ninth Circuit courts have modified the *Krofft* test de facto, without

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<sup>159</sup> See *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

<sup>160</sup> A court should deny a summary judgment motion when there is a genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986); see also note 39 (discussing summary judgment). If a plaintiff reaches the fourth part of the proposed test, a genuine issue of material fact will exist: whether the defendant's work has the same look and feel as the plaintiff's work.

<sup>161</sup> The plaintiff will establish copyright infringement only if the plaintiff can also prove that the plaintiff copyrighted the work and that the defendant had access to the plaintiff's work. See *supra* notes 3-6 and accompanying text.

<sup>162</sup> See *supra* note 13 and accompanying text.

<sup>163</sup> If Ninth Circuit courts apply the third step of the proposed test in all infringement actions, attorneys will know exactly what they need to do to establish or defend a copyright suit. Under the *Krofft* test attorneys lack this certainty. See *supra* notes 52-57 and accompanying text.

<sup>164</sup> Under the proposed test, the court may grant the defendant's motion for summary judgment at the conclusion of the first, second, or third steps of the test. See *supra* notes 145-61 and accompanying text. Under the *Krofft* test, the court had only one opportunity to rule on a summary judgment motion: at the conclusion of the first part of the test. See *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

<sup>165</sup> Indeed, this Comment's proposal incorporates both parts of the test as announced in *Krofft*. See *supra* notes 42-50 and accompanying text; *supra* notes 58-76 and accompanying text (demonstrating that some courts have applied the *Krofft* test successfully).

acknowledging that they have so done. Thus, some observers have questioned whether the *Krofft* test is or will continue to be the Ninth Circuit's test for substantial similarity.<sup>166</sup>

Some of the changes that post-*Krofft* courts have made appear to be reasonable. Specifically, it may be reasonable to extrinsically dissect expression.<sup>167</sup> Put another way, it may be best to employ both an objective and subjective test for similarity of expression, as suggested by *Shaw v. Lindheim*.<sup>168</sup> This Comment's proposal reflects this approach.

In sum, this Comment incorporates *Krofft*'s extrinsic test as part one of the proposed test. The second part of the proposed test is added to the *Krofft* test because it filters out the unprotectable elements of a plaintiff's work and, in doing so, allows the court to rule as a matter of law, thus saving judicial resources. The third part of the proposed test incorporates an objective, analytic dissection test for expression<sup>169</sup> because including an objective test for similarity of expression furthers the policy goal of having courts apply the test for substantial similarity uniformly and predictably.<sup>170</sup> Finally, the fourth part of the proposed test incorporates *Krofft*'s intrinsic test. This new, four-part test is preferable to the *Krofft* test because it will save judicial resources and give the Ninth Circuit a workable test that the courts can apply uniformly in determining whether two works are substantially similar.

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<sup>166</sup> See *supra* note 141.

<sup>167</sup> See *supra* notes 132-44 and accompanying text.

<sup>168</sup> 908 F.2d 531, 535 (9th Cir. 1990); see *supra* note 156 (discussing *Shaw*).

<sup>169</sup> Courts have been using an objective, analytic dissection test for expression de facto, with seemingly reasonable results. See *supra* notes 133-44 and accompanying text.

<sup>170</sup> See *supra* note 13 (discussing the desirability of predictability in adjudication).