

GENERAL CIVIL CASES

COPYRIGHT INFRINGEMENT

§ 160.24

disputed elements
as.

NOTES

In General

Original works of authorship are protected by the Copyright Act. See 17 U.S.C.A. § 101. "Original" means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. *Feist Publications, Inc. v. Rural Tel. Service Co.*, 499 U.S. 340, 344-45, 111 S.Ct. 1282, 1287, 113 L.Ed.2d 358 (1991) (sine qua non of copyright is originality; raw data in telephone book was not copyrightable facts because they existed before telephone company reported them; alphabetical listing of telephone numbers was not original); *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 547-49, 105 S.Ct. 2218, 2223-24, 85 L.Ed.2d 588 (1985) (same). Cf. *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1076 (9th Cir.2000) (in light of minimal standard of originality required for photographic works, even slightest artistic touch will meet originality test for photograph). Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.

Although facts are not copyrightable, compilations of facts may be copyrightable based on the selection, coordination, and arrangement of the factual material. See 17 U.S.C.A. § 101. See, e.g., *Feist Publications, Inc. v. Rural Tel. Service Co.*, 499 U.S. 340, 344, 111 S.Ct. 1282, 1289, 113 L.Ed.2d 358 (1991).

This instruction is adapted from district court's instructions in *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir.1984), cert. denied, 469 U.S. 982, 105 S.Ct. 387, 83 L.Ed.2d 321 (1984), overruled on other grounds, *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 736 n.2, 109 S.Ct. 2166, 2171 n.2, 104 L.Ed.2d 811 (1989).

§ 160.24 Authorship and Work Made-for-Hire

NO

The next issue concerns whether plaintiff _____ is allowed to claim copyright as the author of the work. Plaintiff _____ itself did not create the work. [*Plaintiff _____ is a corporation, but is nonetheless a "person that can claim the legal rights of an author."*]

The copyright law allows a corporation or a person to claim a copyright ownership of a work that was made by employees or independent contractors in what is called a "for-hire" relationship. If the work was made-for-hire for plaintiff _____, then the law considers plaintiff _____ the copyright owner of the work.

Work-for-Hire not claimed. Defendants will propose an instruction on authorship/assignment after hearing plaintiff's case.

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A work made-for-hire is a work prepared by what the law calls an employee working within the scope of the employee's employment. What that means is, a person acting under the direction and supervision of the hiring author, at the hiring author's instance and expense.

[A work made-for-hire is a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audio visual work as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made-for-hire.]

[For the purpose of this instruction, a supplementary work is a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrating, explaining, revising, commenting upon, or assisting in the use of the other work, such as the forewords, afterwards, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes. As used in this instruction, an "instructional text" is a literary, pictorial, or graphic work prepared for publication and with the purpose of use in systematic instructional activities.]

NOTES*In General*

The "author" is the party who actually creates the work, that is, the person who translates the idea into a fixed, tangible expression entitled to copyright protection. 17 U.S.C.A. §§ 102. See *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 737, 109 S.Ct. 2166, 2171, 104 L.Ed.2d 811 (1989). Cf. 17 U.S.C.A. § 201(a).

Under the doctrine of "works made-for-hire," the employer or other person for whom the work was prepared is considered the author for purposes of the Act, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all the rights comprised in the copyright. 17 U.S.C.A. § 201(b). Although the hiring party is not the actual creator of the work, the hiring party is considered the "author" and is entitled to all of the rights of an author. Halpern,

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Nard & Port, Fundamentals of United States Intellectual Property Law: Copyright, Patent, and Trademark 57.

ly ordered or collective work, usual work as a compilation, as material for a test, in a written be considered

A work prepared by an employee within the scope of the employee's employment is considered a work-for-hire and the employer is considered the "author of the work unless the parties have signed an agreement providing otherwise." *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 109 S.Ct. 2166, 104 L.Ed.2d 811 (1989). According to the Supreme Court, the test of whether the creator of the work is considered an employee is determined under the master-servant definition of the general common law of agency. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 739-40, 109 S.Ct. 2166, 2172-73, 104 L.Ed.2d 811 (1989).

Ninth Circuit

supplementary a secondary the purpose of ing, revising, the other work, illustrations, arrangements, indexes, and "optional text" is for publication instructional

COPYRIGHT INTERESTS—WORK MADE FOR HIRE
(17 U.S.C. § 201(b))

An owner of copyright is entitled to exclude others from copying a work made for hire. A work made for hire is one which is prepared by an employee in carrying out the employer's business. The employer owns the copyright [unless the employer and employee have agreed otherwise in writing].

An owner of copyright in a work made for hire may enforce the right to exclude others in an action for copyright infringement.

Comment

17 U.S.C. §§ 101, 106, 501.

Community for Creative Non-Violence v. Reid, 490 U.S. 730, 739-740 (1989) (Congress used the words "employee" and "employment" in 17 U.S.C. § 101 to describe the conventional relationship of employer and employee.).

Manual of Model Civil Jury Instructions for the District Courts of the Ninth Circuit, Instruction No. 17.1.5 (1997).

work, that is, the expression entitled to copyright for Creative 2166, 2171, 104

§ 160.25 Notice of Copyright

The next issue is whether plaintiff S complied with the formalities required by the copyright law. That is the element of proper notice.

The copyright law requires a copyright owner to place a notice of copyright on all authorized publicly distributed copies of the work. A proper notice includes:

employer or other than the author for expressly agreed to assume all the rights through the hiring party is considered author. Halpern,

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First: The letter C in a circle, or the word "copyright," or a proper abbreviation like "copr.;"

Second: The year of first publication; and

Third: The name of the copyright owner.

A proper notice must be affixed to the copies so as to give reasonable notice of the owner's contention that this is a copyrighted work. Failure to include a proper notice on authorized publicly distributed copies may invalidate the copyright.

Failure to include a proper notice does not invalidate the copyright if the notice has been omitted from no more than a relatively small number of such copies. Even if the notice is missing from all such copies, there is no invalidation of copyright if registration for the work has been made before or within five years after its publication, and if a reasonable effort is made by the owner to add the notice to all copies that are distributed to the public after the omission has been discovered.

You must decide whether plaintiff _____ has persuaded you that a notice of copyright was properly placed on the authorized publicly distributed copies or, if not, that the plaintiff's conduct comes within one of the exceptions that were just explained to you.

NOTES

In General

If a notice of copyright in the form and position specified in 17 U.S.C.A. § 401 appears on the published copy or copies to which a defendant in a copyright infringement suit had access, then no weight may be given to such a defendant's interposition of a defense of innocent infringement in mitigation of actual or statutory damages, except as provided in the last sentence of 17 U.S.C.A. § 504(c)(2). 17 U.S.C.A. § 401(d). Notice of copyright "may" be placed on publicly distributed copies of a work. 17 U.S.C.A. § 401(a).

Specific forms of notice are contained in 17 U.S.C.A. §§ 401-403.

§ 160.26 Copying

In addition to establishing that plaintiff _____ is the copyright owner of the work in question, plaintiff _____

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must also prove that defendant _____ infringed plaintiff
_____’s rights in that work.

In order to establish infringement, plaintiff _____
must prove that defendant’s work was copied or taken from
plaintiff’s work. No matter how similar the two works are,
plaintiff _____ may not recover against defendant _____
unless that similarity is the result of the copying or taking of
plaintiff’s work, directly or indirectly, intentionally or unin-
tentionally.

Furthermore, there is no liability unless it is the origi-
nal aspects of the plaintiff’s work that are copied or taken. If
defendant _____ copies or takes only those portions of
plaintiff’s work which were not original with plaintiff, that
is, portions which plaintiff _____ had in turn copied or
taken from somebody else, then defendant _____ is not
liable for copyright infringement.

Defendant _____ is liable only if defendant _____
copies or takes aspects of plaintiff’s work that were original
with plaintiff _____. This does not mean that you have to
find that the defendant _____ copied or took plaintiff’s
work.

If the work was copied or taken from plaintiff _____,
but not by defendant _____ but rather by the defendant’s
supplier, that does not protect defendant _____ from liabil-
ity. Liability attaches to the sale of an unauthorized copy of
a copyrighted work, regardless of whether the seller is the
one who made that copy, and regardless of whether the
seller is aware that the work is an unauthorized copy.

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In General

If the defendant had access to the plaintiff’s copyrighted work and
there are substantial similarities between the defendant’s work and
original elements of the copyrighted work and the defendant’s work was
not independently created, the defendant is liable for copying. See 17
U.S.C.A. § 501. See also *North Coast Indus. v. Jason Maxwell, Inc.*, 972
F.2d 1031, 1033 (9th Cir.1992) (to establish copyright infringement,
copyright holder must prove both valid ownership of copyright and that
there was infringement of copyright by alleged infringer; if ownership of
valid copyright is established, plaintiff must establish infringement by

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showing both access and substantial similarity between copyrighted work and alleged infringing work). A showing of access and substantial similarity creates a presumption of copying; the defendant then has the burden to rebut or meet the presumption with evidence of independent creation. See *Grubb v. KMS Patriots, L.P.* 88 F.3d 1, 3 (1st Cir.1996); *O'Neill v. Dell Publishing Co.*, 630 F.2d 685, 686 (1st Cir.1980); *Twin Peaks Productions, Inc. v. Publications, Int'l, Ltd.*, 996 F.2d 1366, 1372 (2d Cir.1993); *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48 (2d Cir.), cert. denied, 476 U.S. 1159, 106 S.Ct. 2278, 90 L.Ed.2d 721 (1986); *Ford Motor Co. v. Summit Motor Products, Inc.*, 930 F.2d 277, 294 (3d Cir.1991); *Keeler Brass Co. v. Continental Brass Co.*, 862 F.2d 1063, 1065-66 (4th Cir.1988); *Hustler Magazine Inc. v. Moral Majority Inc.*, 796 F.2d 1148, 1151 (9th Cir.1986); *Walker v. University Books, Inc.*, 602 F.2d 859, 864 (9th Cir.1979); *Benson v. Coca-Cola Co.*, 795 F.2d 973, 974 (11th Cir.1986).

In the absence of direct evidence of copying, a determination of infringement requires not only that there be substantial similarity between the copyrighted work and the allegedly infringing work, as well as evidence that the alleged infringer had access to the copyrighted work. See *Granite Music Corp. v. United Artists Corp.*, 532 F.2d 718, 720-21 (9th Cir.1976) (showing of access and showing of similarity permits inference of copying); *Ty, Inc. v. GMA Accessories, Inc.*, *Benson v. Coca-Cola Co.*, 795 F.2d 973 (11th Cir.1986). Access can be shown circumstantially by showing of a reasonable possibility of access. See *Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir.1984).

This instruction is adapted from the district court's instructions in *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir.), cert. denied, 469 U.S. 982, 105 S.Ct. 387, 83 L.Ed.2d 321 (1984), overruled on other grounds, *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 736 n. 2, 109 S.Ct. 2166, 2171 n. 2, 104 L.Ed.2d 811 (1989).

See *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1073 (2d Cir.1992); *Eden Toys, Inc. v. Marshall Field & Co.*, 675 F.2d 498, 501 (2d Cir.1982); *Ford Motor Co. v. Summit Motor Products, Inc.*, 930 F.2d 277, 290 (3d Cir.), cert. denied, 502 U.S. 939, 112 S.Ct. 373, 116 L.Ed.2d 324 (1991); *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir.1977); *Howard v. Sterchi*, 974 F.2d 1272 (11th Cir.1992).

When similarity concerns non-copyrightable elements of an author's work, the question should not be submitted to the jury. *Kregos v. Associated Press*, 3 F.3d 656, 662, (2d Cir.1993), cert. denied, 510 U.S. 1112, 114 S.Ct. 1056, 127 L.Ed.2d 376 (1994).

In *Runge v. Lee*, 441 F.2d 579 (9th Cir.), cert. denied, 404 U.S. 887, 92 S.Ct. 197, 30 L.Ed.2d 169 (1971), the court approved the following instruction:

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between copyrighted access and substantial defendant then has the evidence of independent 3d 1, 3 (1st Cir.1996); 3 (1st Cir.1980); Twin 996 F.2d 1366, 1372 F.2d 44, 48 (2d Cir.), 2d.2d 721 (1986); Ford 0 F.2d 277, 294 (3d Co., 862 F.2d 1063, Moral Majority Inc., niversity Books, Inc., ola Co., 795 F.2d 973,

a determination of substantial similarity infringing work, as well the copyrighted work. 532 F.2d 718, 720-21 of similarity permits Inc., Benson v. Coca- be shown circumstan- ss. See Selle v. Gibb,

ourt's instructions in 548 (2d Cir.), cert. (1984), overruled on ce v. Reid, 490 U.S. L.Ed.2d 811 (1989).

1073 (2d Cir.1992); 8, 501 (2d Cir.1982); 0 F.2d 277, 290 (3d L.Ed.2d 324 (1991); McDonald's Corp., 74 F.2d 1272 (11th

ments of an author's he jury. Kregos v. t. denied, 510 U.S.

denied, 404 U.S. 887, roved the following

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The law allows anyone the right to publish and copyright a new treatment of a subject; and a similarity of form or impression between the two different writers which necessarily follows due to the nature of the subject matter or idea being conveyed is allowable and permissible. A new treatment of a subject matter that demonstrates its independent production, or using a prior work, as a model, is allowable and not an unlawful copy. If you find that a subsequent writer used her own labors, skills and common sources of knowledge open to all men, and that the resemblances are accidental, or arise from the nature of the subject matter, this does not amount to a wrongful copying. . . .

441 F.2d at 582.

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SUBSTANTIAL SIMILARITY—EXTRINSIC TEST;
INTRINSIC TEST

Works are substantially similar if:

1. the ideas in plaintiff's copyrighted work and the defendant's work are substantially similar; and
2. the expression of ideas in plaintiff's copyrighted work and the expression of ideas in defendant's work are substantially similar.

The test for expression of ideas is whether an ordinary reasonable person would find the total concept and feel to be substantially similar.

Comment

There is no bright-line rule regarding substantial similarity. Baxter v. MCA, Inc., 812 F.2d 421, 425 (9th Cir.), cert. denied, 484 U.S. 954 (1987).

The plaintiff must show that the plaintiff's and the defendant's works are substantially similar in both the ideas and the expression of those ideas. Berkic v. Crichton, 761 F.2d 1289, 1291-92 (9th Cir.), cert. denied, 474 U.S. 826, 106 S.Ct. 85, 88 L.Ed.2d 69 (1985).

Paragraph 1 of the instruction is known as the extrinsic test. Paragraph 2 is known as the intrinsic test.

The extrinsic test does not depend on the responses of the trier of fact, but on specific criteria which can be listed and analyzed. Sid & Marty Krofft Television Productions v. McDonald's Corp., 562 F.2d 1157, 1164 (9th Cir.1977). For the extrinsic test, "analytic dissection and expert testimony are appropriate." Id. "[T]his question may often be decided as a

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matter of law." Id. See also North Coast Indus. v. Jason Maxwell, Inc., 972 F.2d 1031 (9th Cir.1992); Pasillas v. McDonald's Corp., 927 F.2d 440 (9th Cir.1991); Shaw v. Lindheim, 919 F.2d 1353 (9th Cir.1990).

The extrinsic test for computer programs requires analytic dissection of various standard components such as screens, menus, and keystrokes. Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1475 (9th Cir.), cert. denied, 506 U.S. 869 (1992).

The intrinsic test must be applied cautiously where there is a very small amount of protectible work in the product. Cooling Sys. & Flexibles v. Stuart Radiator, 777 F.2d 485, 492-93 (9th Cir.1985). In such a case, the jury should be instructed to limit its review to protectible material and the instructions should adequately explain which material is protectible in determining substantial similarity. Harper House, Inc. v. Thomas Nelson, Inc., 889 F.2d 197, 207 (9th Cir.1989).

Manual of Model Civil Jury Instructions for the District Courts of the Ninth Circuit, Instruction No. 17.3.6 (1997).

§ 160.27 Accessibility

Plaintiff _____ cannot win unless plaintiff _____ can prove that plaintiff's work was infringed by defendant _____. Infringement can be proved by direct or circumstantial evidence.

An example of direct evidence would be an admission by an employee of defendant _____ that the work was copied, or the testimony of someone who saw the work being copied. But most frequently proof of that nature is not available in copyright cases. *There is no direct evidence of copying in this case.*

Circumstantial evidence is often resorted to in copyright cases, in an effort to show that infringement has occurred. Circumstantial evidence means the proof of facts that would support a logical inference that copying must have taken place. Among the significant circumstances for you to consider are these issues:

First: Did defendant _____ have access to the plaintiff's work?

Second: Are there similarities between the defendant's work and the plaintiff's?

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Third: If there are similarities, are they of such a nature that they probably could not have occurred without copying, or are there other apparent explanations for the similarities?

These are not the only questions that might arise on this issue. You may consider any relevant circumstance, that is, any circumstances from which you may draw an inference either that copying has taken place or that copying has not taken place.

If, after considering all the proof in the case, you found yourselves unable to draw a logical inference one way or the other, then the plaintiff would have failed in its burden of proof on this issue.

If you find, however, considering all the circumstances, that more likely than not that copying has taken place, then plaintiff _____ has sustained plaintiff's burden on this issue.

On the subject of access, access means proof sufficient to show that the defendant or whoever created the defendant's work had a reasonable opportunity to view the plaintiff's work. Plaintiff _____ is not required to show that whoever produced the defendant's work actually saw the plaintiff's work. In addition, plaintiff _____ is not required to show that some particular channel of communication existed through which the work was seen.

It is sufficient for plaintiff _____ to show that defendant _____ had reasonable opportunity to copy the plaintiff's work. That would be a showing that defendant _____ had access to the plaintiff's work.

On the subject of similarity, if you find similarities between the works, you must ask yourselves whether the similarities are or are not of the kind that would be likely to occur without copying. Similarity can result from copying, but there are other possible explanations for similarity.

On the other hand, certain similarities may be very convincing proof of copying. The more original, the more unusual or imaginative or arbitrary is the material that you find to be similar in both works, the less likely that similari-

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ty is a coincidence. The more extensive the similarity and the more it extends to small arbitrary details, the more likely as a matter of common sense that it is due to copying, rather than to coincidence, or the suggestiveness of the subject matter.

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This instruction is adapted from district court's instructions in *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir.1984), cert. denied 469 U.S. 982, 105 S.Ct. 387, 83 L.Ed.2d 321 (1984), overruled on other grounds, *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 736 n. 2, 109 S.Ct. 2166, 2171 n. 2, 104 L.Ed.2d 811 (1989).

The plaintiff must show that the plaintiff's and the defendant's works are substantially similar in both the ideas and the expression of those ideas. *Berkic v. Crichton*, 761 F.2d 1289, 1291-92 (9th Cir.), cert. denied, 474 U.S. 826, 106 S.Ct. 85, 88 L.Ed.2d 69 (1985). There is no bright-line rule regarding substantial similarity. *Baxter v. MCA, Inc.*, 812 F.2d 421, 425 (9th Cir.), cert. denied, 484 U.S. 954, 108 S.Ct. 346, 98 L.Ed.2d 372 (1987). When a work contains both protectible and unprotectible elements, inquire must be made as to whether the protectible elements standing alone, are substantially similar. *Williams v. Crichton*, 84 F.3d 581, 588 (2d Cir.1996).

Under one method of determining substantial similarity, suggested by Judge Learned Hand, the allegedly taken non-literal elements must be positioned on a spectrum ranging from "idea" to "expression," the position varying with the degree of "abstraction" or "concreteness" of the material. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121-22 (2d Cir.1930), cert. denied, 282 U.S. 902, 51 S.Ct. 216, 75 L.Ed. 795 (1931). This approach is sometimes referred to as the "abstractions test." See Halpern, Nard & Port, *Fundamentals of United States Intellectual Property: Copyright, Patent, and Trademark* 148. See also *Twin Peaks Productions, Inc. v. Publications Int'l Ltd.*, 996 F.2d 1366, 1372 (2d Cir.1993) (substantial similarity can take form of "fragmented literal similarity" or "comprehensive nonliteral similarity"); *Bateman v. Mne-monics, Inc.*, 79 F.3d 1532, 1543-44 (11th Cir.1996) (in action for infringement of copyrighted computer program, district court committed reversible error by instructing jury to filter out only nonliteral similarities in applying "abstraction-filtration-comparison" test for substantial similarity without eliminating unprotectable elements of program from comparison).

According to the Second Circuit, the plaintiff must first show that the plaintiff's work was actually copied and then show that the copying amounts to an "improper" or "unlawful" appropriation. *Arnstein v.*

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he similarity and details, the more is due to copying, estiveness of the

urt's instructions in 8 (2d Cir.1984), cert. (1984), overruled on nce v. Reid, 490 U.S. L.Ed.2d 811 (1989). and the defendant's nd the expression of 1-92 (9th Cir.), cert. (1985). There is no Baxter v. MCA, Inc., 54, 108 S.Ct. 346, 98 otectible and unpro- ether the protectible Williams v. Crichton,

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must first show that ow that the copying riation. Arnstein v.

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Porter, 154 F.2d 464, 468 (2d Cir.1946), cert. denied, 330 U.S. 851, 67 S.Ct. 1096, 91 L.Ed. 1294 (1947). Before the copyrighted work is compared with the allegedly infringing work for purposes of determining unlawful appropriation, the protectable subject matter in the copyrighted work must be separated from the nonprotectable subject matter. *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996, 1002 (2d Cir.1995). A general impression of similarity is not sufficient to make out a case of infringement. *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 912 (2d Cir.1980).

Some circuits have taken the position that infringement occurs only when the total concept and feel of the works in question are substantially similar. See *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120-21 (8th Cir.1987) (infringement occurs only when total concept and feel of works in question are substantially similar); *Litchfield v. Spielberg*, 736 F.2d 1352, 1356-57 (9th Cir.1984), cert. denied, 470 U.S. 1052, 105 S.Ct. 1753, 84 L.Ed.2d 817 (1985) (to constitute infringement of expression, the total concept and feel of the works must be substantially similar). Cf. *Cartier v. Jackson*, 59 F.3d 1046, 1050 (10th Cir.1995) (because total concept and feel test is accepted law in other circuits, it was not a substantial and obvious error for district court to include it in the jury instructions). The Second Circuit has rejected "the total concept and feel" test. *Castle Rock Entertainment, Inc. v. Carol Publishing Group, Inc.*, 150 F.3d 132, 137 (2d Cir.1998) (rejecting total concept and feel test under some circumstances).

The extrinsic test of substantial similarity does not depend on the responses of the trier of fact, but on specific criteria that can be listed and analyzed. *Sid & Marty Krofft Television Productions v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir.1977). But see criticism in *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1398 (9th Cir.1997). Such criteria include the type of artwork involved, the materials used, the subject matter, and the setting for the subject. *Sid & Marty Krofft Television Productions v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir.1977). For the extrinsic test, analytic dissection and expert testimony are appropriate. *Sid & Marty Krofft Television Productions v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir.1977). This question may often be decided as a matter of law. *Sid & Marty Krofft Television Productions v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir.1977). The extrinsic test for computer programs requires analytic dissection of various standard components such as screens, menus, and keystrokes. *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1475 (9th Cir.), cert. denied, 506 U.S. 869, 113 S.Ct. 198, 121 L.Ed.2d 141 (1992).

Under the intrinsic test, the expression of ideas in the plaintiff's copyrighted work and the expression of ideas in the defendant's work are substantially similar. *Sid & Marty Krofft Television Productions v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir.1977). The intrinsic test must be applied cautiously where there is a very small amount of

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protectible work in the product. See *Williams v. Crichton*, 84 F.3d 581, 588 (2d Cir.1996); *Cooling Systems & Flexibles, Inc. v. Stuart Radiator, Inc.*, 777 F.2d 485, 492-93 (9th Cir.1985). In such a case, the jury should be instructed to limit its review to protectible material and the instructions should adequately explain which material is protectible in determining substantial similarity. *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 207 (9th Cir.1989).

It is not necessary to instruct that if access is proved similarity need not be great in order to find copying. It has been held proper simply to say that the jury may find copying and that access plus similarity may support an inference of copying which the jury is not required to accept. *Arc Music Corp. v. Lee*, 296 F.2d 186, 187 (2d Cir.1961).

It is appropriate to instruct the jury that if the alleged copy is "strikingly similar" to the original, access does not have to be proven. *Gaste v. Kaiserman*, 863 F.2d 1061, 1067-68 (2d Cir.1988). *Accord Repp v. Webber*, 132 F.3d 882, 889 (2d Cir.1997), cert. denied, 525 U.S. 815, 119 S.Ct. 52, 142 L.Ed.2d 40 (1998); *Lipton v. Nature Co.*, 71 F.3d 464, 471 (2d Cir.1995); *Ty, Inc. v. GMA Accessories, Inc.*, 132 F.3d 1167, 1169 (7th Cir.1997). The inference of copying must be reasonable in light of all the evidence. *Gaste v. Kaiserman*, 863 F.2d 1061, 1067-68 (2d Cir.1988). See *Bouchat v. Baltimore Ravens, Inc.*, 228 F.3d 489, 492 (4th Cir.2000), amended on denial of rehearing 241 F.3d 350 (4th Cir.2001) (although jury was entitled to infer defendants had access, court rejected mere "speculative reasoning" as basis for proving access).

In *Granite Music Corp. v. United Artists Corp.*, 532 F.2d 718 (9th Cir.1976), the court stated:

If a plaintiff offers proof that the defendant had 'access' to his work and that the two works are substantially similar, then a presumption of copying by the defendant arises. The [trial] court described this presumption to the jurors, then the court stated: "The defendants, under such circumstances, have the burden of explaining such similarities or identities between the two works. Any evidence produced by the defendant which explains or accounts to the satisfaction of the jury for such similarity or identity, rebuts such presumption. . . ."

532 F.2d at 721.

In *Granite*, plaintiff claimed that the instruction was erroneous in telling the jury that any evidence would rebut the presumption, but it appears that the instruction is saved by the statement that the evidence must be explained in a manner satisfactory to the jury. At the same time, the Court of Appeals indicated that it would be preferable to instruct in terms of an inference of copying arising from a showing of access. This is in line with instructions in other areas, in which the use of a term such as "presumption" is disfavored. The case also held that evidence that the same four-note sequence appeared in other works

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besides the copyrighted work and the allegedly infringing work could be received to show lack of originality in the copyrighted work.

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COPYING—ACCESS AND SUBSTANTIAL SIMILARITY

If you find by a preponderance of the evidence that the defendant had access to the plaintiff's copyrighted work and that there are substantial similarities between the defendant's work and original elements of the copyrighted work [and that the defendant's work was not independently created], you shall find copying.

Comment

If the defendant has made a claim of independent creation, you may use the bracketed part.

See generally *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1018 (9th Cir.1985) (discussion of access, substantial similarity and independent creation), cert. denied, 474 U.S. 1059 (1986).

See *Granite Music Corp. v. United Artists Corp.*, 532 F.2d 718, 720-21 (9th Cir.1976) (showing of access and showing of similarity permits inference of copying).

A showing of access and substantial similarity creates a presumption of copying. The defendant has the burden to rebut or meet the presumption with evidence of independent creation. See *Walker v. University Books, Inc.*, 602 F.2d 859, 864 (9th Cir.1979) (demonstration of access and substantial similarity establishes a prima facie case of copyright infringement); *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 829 (11th Cir.1982) ("proof of access and substantial similarity raises only a presumption of copying which may be rebutted by the defendant with evidence of independent creation"); *Benson v. Coca-Cola Co.*, 795 F.2d 973, 974 (11th Cir.1986) (proof of access and similarity is insufficient to affirmatively establish infringement; elements of access and similarity raise a presumption of infringement which may be rebutted by proof of independent creation); *Keeler Brass Co. v. Continental Brass Co.*, 862 F.2d 1063, 1065-66 (4th Cir.1988) (prima facie case shifts burden of going forward but not burden of persuasion).

The burden of proof, however, remains at all times with the plaintiff and does not shift to the defendant. *Overman v. Loesser*, 205 F.2d 521, 524 (9th Cir.), cert. denied, 346 U.S. 910 (1953); see Fed. R. Evid. 301. But see *Kamar Int'l v. Russ Berrie and Co.*, 657 F.2d 1059, 1062 (9th Cir.1981) (copying may be

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Services, Inc., 99 F.3d 100 U.S. 1156, 117 S.Ct. 1156, 117 S.Ct. 1156. Commercial exploitation of excerpts of works in the course was not fair use. See *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396. Both commercial and noncommercial uses are considered whether alleged to be for private benefit or for private

Harper & Row Publishers v. National Enterprise Enterprises, 796 F.2d 1396, 796 F.2d 1396. *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396. *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396.

portion used in relation to the work. See *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396. *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396. *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396.

market for or value of the work. See *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396. *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396. *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396.

FAIR USE

the fair use of the work. See *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396. *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396. *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396.

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1. the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
2. the nature of the copyrighted work;
3. the amount and substantiality of the portion used in relation to the copyrighted work as a whole;
4. the effect of the use upon the potential market for or value of the copyrighted work; and
5. any other factors that bear on the issue of fair use.

[Add appropriate concluding paragraph from Instructions 5.3, 5.4, or 5.5.]

Comment

See *Harper & Row Publishers v. National Enterprise Enterprises*, 796 F.2d 1396, 796 F.2d 1396 (1985) (presenting an analysis of the factors).

See *Supermarket of Homes v. San Fernando Valley Bd. of Realtors*, 786 F.2d 1400, 1408-09 (9th Cir.1986) ("fair use" is an affirmative defense).

Manual of Model Civil Jury Instructions for the District Courts of the Ninth Circuit, Instruction No. 17.4.1 (1997).

§ 160.81 Abandonment

No. License instead.

Defendant _____ contends that copyright does not exist in the work because plaintiff _____ abandoned the copyright. Plaintiff _____ cannot claim ownership of the copyright if it was abandoned.

In order to establish abandonment, defendant _____ has the burden of proving each of the following by a preponderance of the evidence:

First: Plaintiff _____ intended to surrender ownership rights in the work; and

Second: Plaintiff _____ demonstrated that intent by an overt act.

Mere inaction, or publication without a copyright notice, does not constitute abandonment of the copyright. However, these may be factors for you to consider in determining whether plaintiff _____ has abandoned the copyright.

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INSTRUCTIONS FOR FEDERAL CIVIL CASES

NOTES

In General

See *Abend v. MCA, Inc.*, 863 F.2d 1465, 1482 (9th Cir.1988) (abandonment is an affirmative defense in copyright infringement), *aff'd*, 495 U.S. 207, 110 S.Ct. 1750, 109 L.Ed.2d 184 (1990).

Abandonment must be manifested by some overt act indicating an intention to abandon the copyright. *Micro Star v. Formgen, Inc.*, 154 F.3d 1107, 1114 (9th Cir.1998). Delay in obtaining a certificate of registration does not constitute abandonment of a copyright. *Stone v. Williams*, 970 F.2d 1043, 1050 (2d Cir.1992).

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COPYRIGHT—AFFIRMATIVE DEFENSE—
ABANDONMENT

The defendant contends that copyright does not exist in the work because the plaintiff abandoned the copyright. The plaintiff cannot claim ownership of the copyright if it was abandoned. Defendant has the burden of proving each of the following by a preponderance of the evidence:

1. plaintiff intended to surrender ownership rights in the work; and
2. an overt act of the plaintiff evidenced that intent.

Mere inaction [, or publication without a copyright notice,] does not constitute abandonment of the copyright; however, [this may be a factor] [these may be factors] for you to consider in determining whether the plaintiff has abandoned the copyright.

Comment

The bracketed portion pertaining to publication without copyright notice should be used if the copyright infringement action is brought under the 1909 Act.

Abend v. MCA, Inc., 863 F.2d 1465, 1482 & n. 21 (9th Cir.1988) (abandonment is an affirmative defense in copyright infringement), *aff'd*, 495 U.S. 207 (1990).

Forfeiture of copyright may occur as a consequence of publication without proper copyright notice and is effectuated by operation of law regardless of the intent of the copyright owner; abandonment occurs only if the copyright owner intends to surrender rights in the work. 3 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 13.06 (1992).