

COPYRIGHT, ORIGINALITY, AND THE END OF THE *SCÈNES À FAIRE* AND
MERGER DOCTRINES FOR VISUAL WORKS

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I. INTRODUCTION

Compare two works, one of which is alleged to be a copy of the other. The first is the *Mona Lisa* by Leonardo da Vinci.¹ The second is another portrait of a woman with long, dark hair sitting in a window overlooking a somewhat dramatic landscape of twisting roads and bending rivers. A determination must be made as to whether the second work is an infringement of the *Mona Lisa*.² There is no direct evidence of copying; therefore, the two works must be compared for substantial similarity.³

Consideration now must be given to the merger doctrine in the area of copyrights which states that if an idea and the expression of the idea are so tied together that the idea and its expression are one—there is only one conceivable way to express and embody the idea in a work—then the expression of the idea is not copyrightable because ideas may not be copyrighted.⁴ The *scènes à faire* doctrine complements the merger doctrine

¹Portrait of *Mona Lisa* (1503–06), also known as *La Gioconda*, the wife of Francesco del *Giocondo*, oil on wood, 77 x 53 cm, Musee du Louvre, Paris, France, available at [http://www.harley.com/art/abstract-art/images/\(davinci\)-mona-lisa.jpg](http://www.harley.com/art/abstract-art/images/(davinci)-mona-lisa.jpg) (last visited Apr. 5, 2006).

²This will require a little imagination because the *Mona Lisa* is most definitely in the public domain, but this example depends on the *Mona Lisa* being protected by copyright.

³In the absence of direct proof of actual copying, which is to say in the majority of copyright infringement cases, a court must make a determination of whether or not the defendant copied using a two part test: (1) whether the defendant had access to the plaintiff's work, and (2) whether the works are similar enough to suggest that it is likely that the defendant copied the plaintiff's work. See *MiTek Holdings, Inc. v. Arce Eng'g Co.*, 89 F.3d 1548, 1554 (11th Cir. 1996); *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992). If there is sufficient proof of access and probative similarity to suggest copying, then the court compares the two works for substantial similarity to determine whether the defendant's copying of the plaintiff's work constitutes infringement. See *MiTek*, 89 F.3d at 1554; *Rogers*, 960 F.2d at 307–08. "Striking similarity" between the works is held to be conclusive proof of copying even in the absence of proof of access. *Positive Black Talk Inc. v. Cash Money Records Inc.*, 394 F.3d 357, 371 & n.10 (5th Cir. 2004); *Repp v. Webber*, 132 F.3d 882, 889 (2d Cir. 1997). But even overwhelming proof of access does not take the place of evidence of probative similarity to infer copying. See *Positive Black Talk*, 394 F.3d at 371 & n.10.

⁴See, e.g., *Educ. Testing Servs. v. Katzman*, 793 F.2d 533, 539 (3d Cir. 1986). There is a great deal of scholarship discussing the merger doctrine. E.g., Mark A. Lemley, *What's Different about Intellectual Property?*, 83 TEX. L. REV. 1097, 1101 (2005) [hereinafter Lemley, *What's Different*]; Jane C. Ginsburg, "The Exclusive Right to Their Writings": *Copyright and Control in the Digital Age*, 54 ME. L. REV. 195, 210 & n.91 (2002); Scott Abrahamson, Comment, *Seen One, Seen Them All? Making Sense of the Copyright Merger Doctrine*, 45 UCLA L. REV. 1125 (1998); Mark A. Lemley, *Convergence in the Law of Software Copyright?*, 10 HIGH TECH. L.J. 1, 9–10 (1995) [hereinafter Lemley, *Convergence*]; L. Ray Patterson & Craig Joyce, *Monopolizing*

by providing that certain subject matter—stock images, tried and true story lines, fables and folklore, scenes of nature, common visual and cultural references, all of which fall under the title of “scenes that must be done”—are not able to be copyrighted because they are part of the public domain and no one can obtain a monopoly on such images by putting them into a fixed and tangible medium of expression.⁵ As a result, in many jurisdictions, if the first work embodies any images that are *scènes à faire* or subject to the merger doctrine, one is required to cancel them out before considering whether the second work infringes on the first. In other words, the second work must have elements that are substantially similar to the protected elements of the first work, not the first work as a whole.

In our example, certainly the fact that the subject of the portrait is a woman must be canceled out because da Vinci can claim no monopoly on this subject matter. The long dark hair is common to many women; we must disregard it. The coy, shy (or is it knowing, mysterious, or inviting) expression on the woman’s face must also be disregarded; facial expressions are natural images, not subject to capture and monopolization by any artist. Her posture is a natural image. Posing a sitter in a window overlooking a landscape of twisting roads and bending rivers surely is a stock image in portraiture—perhaps one that incorporates a scene from a fable or fairy tale that da Vinci cannot claim for his own. The simple frock she wears is not of intricate design and ornamentation—features that da Vinci might have claimed were products of his creative fancy and thus substantially original and protected. As it is, her attire fails to reveal creative elements and largely must be ignored. Lastly, the colors chosen by da Vinci for the work must be ignored; colors are in the public domain.⁶ At the end of this reductionist dissection process, there is little or no protected element to compare to the second work. Therefore, even if the second work

the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations, 36 UCLA L. REV. 719 (1989).

⁵ See, e.g., *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 616 (7th Cir. 1982), *superseded by rule in part*, Fed. R. Civ. P. 52(a), *as recognized in Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980); Leslie A. Kurtz, *Copyright: The Scènes à Faire Doctrine*, 41 FLA. L. REV. 79 (1989) [hereinafter Kurtz]; see also Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215, 219 & n.24, 254 (2002) [hereinafter Ochoa, *Public Domain*] (considering that patent law requires novelty, indispensable expressions are part of the public domain); Lemley, *What’s Different*, *supra* note 4, at 1102; Lemley, *Convergence*, *supra* note 4, at 11.

⁶ Ochoa, *Public Domain*, *supra* note 5, at 219.

is manifestly similar in appearance to the work, da Vinci has so few protected elements in his work that no reasonable finder of fact could determine that the second work is substantially similar to the *Mona Lisa*. The court must grant summary judgment in favor of the artist of the second work.

Consider one additional example that moves us forward several centuries: Grant Wood's *American Gothic*.⁷ A second work looks suspiciously similar to Wood's masterpiece of Americana. But in many jurisdictions the merger and *scènes à faire* doctrine require one to filter out any unprotectable elements. Surely, the posing of a man and his daughter together must be disregarded. Such is the very nature of *scènes à faire*—a scene that must be done—and an artist wishing to paint a father and daughter side-by-side is common. The viewer must disregard the stern, almost comically morose expressions on the subjects' faces. Facial expressions are natural images, and Wood has no monopoly on stern-faced subjects. The posing in front of their home recreates a stock American image and, thus, must be disregarded. The fact that they are farmers and are dressed in classic "Sunday Best" attire (for farmers) is an image from the public domain for which Wood cannot claim credit.⁸ Farmers hold pitchforks, so forget the pitchfork. This kind of cliché must certainly be subject to the *scènes à faire* doctrine if not the merger doctrine. The architecture of the house (the quasi-Gothic design to the window of the house) in the background may be unique enough in design to allow Wood to claim protection for it. Thus, the only elements to compare are some of the ornamentation on the subjects, the brooch worn by the woman, the exact style of eyewear worn by the man, and the unique architecture of the building in the background. Perhaps Wood included too few protected elements to enable him to proceed with a copyright infringement claim, and the court may grant summary judgment for the artist of the second work before even considering the second work.

Such is the state of the copyright law in many parts of the United States.⁹ Although the courts have from time to time acknowledged that the standards for originality and creativity required for copyright are

⁷*American Gothic* (1930), oil on beaverboard, 74.3 x 62.4 cm, Art Institute of Chicago, Chicago, Ill., available at http://www.artic.edu/artaccess/AA_Modern/pages/MOD_5_lg.shtml (last visited Apr. 5, 2006) or <http://www.npr.org/templates/story/story.php?storyId=4748148> (last visited Apr. 5, 2006).

⁸Ochoa, *Public Domain*, *supra* note 5, at 219.

⁹See *Mitek Holdings, Inc. v. Arce Eng'g Co.*, 89 F.3d 1548, 1554 (11th Cir. 1996).

intentionally low—and that there are myriad ways to express themes and ideas visually—half of the circuits of the United States courts of appeals have applied the kind of “reductionist,” dissection approach described in the two examples above in their consideration of infringement of visual works that is driven by an expanded view of the applicability of the merger and *scènes à faire* doctrines to visual works.¹⁰

This Article will first argue that the merger doctrine and *scènes à faire* doctrine are perfectly well adapted to verbal and literary works, but have no meaning and no proper application with regard to visual works and should be discarded in the consideration of infringement of visual works. Part II will describe the merger doctrine and *scènes à faire* doctrine that fall under the requirement of originality in the United States copyright law and explain the proper application of the doctrines to verbal and literary works. Part III will describe the current state of the law in which half of the circuits of the United States courts of appeals feel compelled by the existence of the merger and *scènes à faire* doctrines to engage in filtering and dissection and other reductionist approaches to the elements of visual works when evaluating substantial similarity in infringement cases. Finally, Part IV will complete the argument for a rejection of the merger and *scènes à faire* doctrines for visual works.

II. THE MERGER DOCTRINE AND *SCÈNES À FAIRE* DOCTRINE

A. *Originality in Copyright*

The discussion of originality in copyright law begins with one axiomatic proposition: There can be no valid copyright in facts.¹¹ No author may copyright his ideas¹² or the facts he narrates.¹³ The key to understanding the

¹⁰*Id.*; *Rogers v. Koons*, 960 F.2d 301, 308 (2d Cir. 1992).

¹¹*Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344 (1991). The *Feist* case and the originality requirements defined therein are discussed in Tyler T. Ochoa, *1984 and Beyond: Two Decades of Copyright Law*, 20 SANTA CLARA COMPUTER & HIGH TECH. L.J. 167, 169–70 (2003); Daniel J. Gervais, *Feist Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law*, 49 J. COPYRIGHT SOC'Y U.S.A. 949 (2002); Jane C. Ginsburg, Wendy J. Gordon, Arthur R. Miller, & William F. Patry, *The Constitutionality of Copyright Term Extension: How Long Is Too Long?*, 18 CARDOZO ARTS & ENT. L.J. 651, 660–63 (2000); Jane C. Ginsburg, *No “Sweat”? Copyright and Other Protection of Works of Information after Feist v. Rural Telephone*, 92 COLUM. L. REV. 338, 367–87 (1992).

¹²*See* 17 U.S.C. § 102(b) (2000).

merger and *scènes à faire* doctrines lies in understanding why facts are not copyrightable.

In *Feist*, the Supreme Court explained the meaning of a copyright:

The sine qua non of copyright is originality. To qualify for copyright protection, a work must be original to the author. Original, as the term is used in copyright, 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. . . . To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, “no matter how crude, humble or obvious” it might be.¹⁴

Originality is not the same thing as novelty.¹⁵ A work may be original even if it closely resembles another work or several different works.¹⁶ The single requirement of originality is that any similarity between the new work and older works must be accidental and fortuitous; the product of random, independent creation.¹⁷ The similarity must not be the result of copying.¹⁸ Thus, the copyright requirement of originality amounts to little more than a prohibition on actual copying.¹⁹

Alternatively, no one may claim originality as to the reporting and publication of facts.²⁰ Facts, data, and information about the world do not

¹³ *Feist*, 499 U.S. at 344–45; *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985).

¹⁴ *Feist*, 499 U.S. at 345 (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.08[C][1] (1990)); see *Harper & Row*, 471 U.S. at 547–49; 1 PAUL GOLDSTEIN, COPYRIGHT § 2.2.1 (2d ed. 2005) [hereinafter Goldstein]; 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §§ 2.01[A], [B] (2005) [hereinafter Nimmer].

¹⁵ *Feist*, 499 U.S. at 345; Goldstein, *supra* note 14, § 2.2.1.

¹⁶ See *Feist*, 499 U.S. at 345; Goldstein, *supra* note 14, § 2.2.1.

¹⁷ See *Feist*, 499 U.S. at 345.

¹⁸ See *id.*

¹⁹ See *Feist*, 499 U.S. at 345–46; *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879) (holding originality requires independent creation plus a modicum of creativity); *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936) (Hand, J.).

²⁰ *Feist*, 499 U.S. at 347; Goldstein, *supra* note 14, § 2.2.1; Nimmer, *supra* note 14, § 2.11[A].

owe their origin to an act of authorship.²¹ The first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence.²² Facts are not original to an author who writes about those facts. “[A]ll facts—scientific, historical, biographical, and news of the day”—belong to the public domain and are available to every person.²³

Nevertheless, while others may copy the underlying facts and ideas from a publication, they may not copy the exact words or arrangement used to present them.²⁴ For example, the facts of a president’s life are subject to copying and republication but not his exact words and phrases regarding public figures and public events written in an autobiography.²⁵ The artist or author’s creative expression and embodiment of the idea is protected.²⁶ Copyright assures authors the right to control their original expression, but encourages others to borrow the underlying ideas and themes used by the original author and create their own original expression.²⁷ This principle, known as the idea-expression dichotomy, applies to all works of authorship.²⁸

B. *The Scope of Protection for Ideas Versus Expressions*

The definition of an “idea” in a literary work often is the most difficult aspect of the idea-expression dichotomy.²⁹ Judge Learned Hand characterized the difficulty in *Nichols v. Universal Pictures Corp.* as arising from the fact that an idea, as opposed to the expression of the idea in literature, can be manipulated by viewing the interest protected by copyright at differing levels of abstraction.³⁰ If protection is limited to the words as they appear on the page—a strictly literal application of the term “expression”—the protection for original “Writings” envisioned by the

²¹ *Feist*, 499 U.S. at 347; Goldstein, *supra* note 14, § 2.2.1.

²² *Feist*, 499 U.S. at 347.

²³ *Feist*, 499 U.S. at 347; *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1369 (5th Cir. 1981); Goldstein, *supra* note 14, § 2.2.1.

²⁴ *See Feist*, 499 U.S. at 348.

²⁵ *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556–57, 563 (1985).

²⁶ *Id.*; *Feist*, 499 U.S. at 348–49.

²⁷ *Feist*, 499 U.S. at 349–50; *Harper & Row*, 471 U.S. at 556–57.

²⁸ *Feist*, 499 U.S. at 350; *see Harper & Row*, 471 U.S. at 556–57. *See generally* Goldstein, *supra* note 14, § 2.3.

²⁹ *See* Goldstein, *supra* note 14, § 2.3.1.1; Nimmer, *supra* note 14, § 1.10[B][2].

³⁰ 45 F.2d 119, 121 (2d Cir. 1930); *see also* *Nash v. CBS, Inc.*, 899 F.2d 1537, 1540 (7th Cir. 1990) (discussing *Nichols*).

Constitution³¹ would be considerably thin.³² A new author could imitate the plot, character types, exposition, conflict, resolution, and all other original elements of a novel so long as she changed the wording.³³ But if protection extends to the full range of derivative works that might be expressed by the author arising from the author's fleshing out of an "idea" in literature, then an author could claim property rights to an entire genre.³⁴ This would mean that Edgar Allan Poe or Wilkie Collins could have captured the mystery genre with the publication of a single mystery story; the innovators of the first reality television show, *Survivor*, might have deprived the public of *The Amazing Race*, *Fear Factor*, *Big Brother*, or even *Temptation Island*.³⁵

This difficulty is not present in visual works because there are myriad possible ways to express ideas visually;³⁶ a new author need only refrain from copying one. A perfect example of the idea-expression dichotomy in visual works is the case of photography. Photography takes as its subject the concrete objects (the facts) of the world around us, and yet for over a hundred and twenty years the Supreme Court has recognized that works of photography are sufficiently creative and original as to obtain the protection of copyright.³⁷ This is true for staged and posed subjects of photographs, as well as for advertising and for more natural or random snap-shots.³⁸ What

³¹ U.S. CONST. art. I, § 8, cl. 8.

³² Nimmer, *supra* note 14, § 1.10[B][2]; see Goldstein, *supra* note 14, § 2.3.1.2 (stating that when idea and expression are inseparable, protecting the expression would confer a monopoly of the idea).

³³ See Nichols, 45 F.2d at 121.

³⁴ Nimmer, *supra* note 14, §§ 1.10[B][2], [C][2]; see also Goldstein, *supra* note 14, § 2.3.2.

³⁵ *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 291 (3d Cir. 2004) (en banc) (Roth, J., dissenting), *cert. denied*, 126 S. Ct. 336 (2005); *Nash*, 899 F.2d at 1540.

³⁶ *Mattel, Inc. v. Goldberger Doll Mfg. Co.*, 365 F.3d 133, 135 (2d Cir. 2004) (holding that there are innumerable ways of depicting doll faces); *Southco*, 390 F.3d at 292 (Roth, J. dissenting) (stating that Southco's numbering rules and the resulting numbers are one of many possible expressions of the idea of using a code to convey product specifications); *Atari Games Corp. v. Oman*, 979 F.2d 242, 245 (D.C. Cir. 1992) [hereinafter *Atari II*] (Ginsburg, J.) (holding that there are innumerable ways of depicting breakout game features), *appeal after remand from* 888 F.2d 878 (D.C. Cir. 1989) [hereinafter *Atari I*] (Ginsburg, J.).

³⁷ See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60–61 (1884); *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210, 1215–16 (11th Cir. 2000). Yet, there are dissenting voices regarding the recognition of photography as a creative, original, copyrightable media. See generally Christine Haight Farley, *The Lingering Effects of Copyright's Response to the Invention of Photography*, 65 U. PITT. L. REV. 385, 446–51 (2004) (criticizing the conception of the authorship used for photographs).

³⁸ See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903); *Burrows-Giles*

the author of a photographic work brings to the creativity and originality equation is an artist's sense of composition, angle, exposure, F-stop and aperture settings, background, lighting, and the creation of certain elements of the scene.³⁹ In *Mannion v. Coors Brewing Co.*, the Southern District of New York categorized photographic originality into three specific areas: rendition of the photograph (angle, light, shade, exposure, filter effects, developing techniques, or composition), the timing of the photograph (how it fortuitously or consciously captures the moment when the expression associated with the subject matter is the most poignant), and the creation of the subject matter of the photograph (i.e. when the photographer stages or creates original subject matter for photographing).⁴⁰ However, nothing in these original elements prevents another author from photographing, painting, writing about, or otherwise using the same subject matter (the facts) in their own original expression as long as they do not copy the first author's expression.⁴¹

C. *Doctrines of Limitation Based on Originality: Merger and Scènes à Faire*

Copyright protection is subject to an important limitation: "The mere fact that a work is copyrighted does not mean that every element of the work may be protected."⁴² The requirement of originality means that copyright protection extends only to those components of a work that are original to the author.⁴³

The merger doctrine is a variation or application of the idea-expression dichotomy. When the idea and the expression of the idea are inseparable, then the expression will not be copyrightable because it would necessarily give the author a monopoly on the expression of the underlying idea.⁴⁴ In other words, if there is only one way to express or depict an idea then no

Lithographic Co., 111 U.S. at 60; *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 820 (9th Cir. 2003); *Leigh*, 212 F.3d at 1215; *Los Angeles News Serv. v. Tullo*, 973 F.2d 791, 794 (9th Cir. 1992).

³⁹ *Bleistein*, 188 U.S. at 250; *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1077 (9th Cir. 2000); *Los Angeles News Serv.*, 973 F.2d at 794 (quoting *United States v. Hamilton*, 583 F.2d 448, 452 (9th Cir. 1978)).

⁴⁰ 377 F. Supp. 2d 444, 452-53 (S.D.N.Y. 2005).

⁴¹ *See id.* at 454; *Ets-Hokin*, 225 F.3d at 1082; *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 138 (5th Cir. 1992).

⁴² *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991).

⁴³ *Id.*

⁴⁴ *Educ. Testing Servs. v. Katzman* 793 F.2d 533, 539 (3d Cir. 1986).

one may claim a copyright in that single manner of expression or depiction because that would evict everyone else from the right to express or depict that idea.⁴⁵

The merger doctrine is traced to Learned Hand's opinion in *Nichols v. Universal Pictures Corp.*, which links the principles underlying the merger doctrine to those underlying the *scènes à faire* doctrine, although neither doctrine is named in the opinion.⁴⁶ The *Nichols* case involved two literary works (a stage play and a screenplay) alleged to be substantially similar.⁴⁷ There was no allegation that actual scenes or actual text was copied from the first work into the second, but Judge Hand observed that: "It is of course essential to any protection of literary property, whether at common-law or under the statute, that the right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations."⁴⁸ The first work involved a Jewish widower whose son secretly married an Irish Catholic girl whose widower father opposed the union as did the Jewish father.⁴⁹ Eventually, the two fathers reconcile in order to rejoin the company of their respective children and grandchildren.⁵⁰ The second work involved a Jewish family who lived in a state of animosity with their neighbors, an Irish Catholic family.⁵¹ The plot centered around the quarrelling of the two families: the fathers fought, the mothers bickered, and even the children and pets clashed.⁵² The only family members not engaged in the squabble were the Jewish daughter and the Irish son, who, as you may have guessed, secretly married.⁵³ Further conflict is introduced when the Jewish father inherits a sizeable sum of money, but later learns that the proper legatee is the Irish father, and by turning over the money, he prompts an unlikely friendship and partnership between the two fathers.⁵⁴

Judge Hand noted the difficulty in applying the merger doctrine:

⁴⁵ See Goldstein, *supra* note 14, § 2.3.2.

⁴⁶ 45 F.2d 119, 120–21 (2d Cir. 1930).

⁴⁷ *Id.* at 120.

⁴⁸ *Id.* at 121.

⁴⁹ *Id.* at 120.

⁵⁰ *Id.* at 120–22.

⁵¹ *Id.* at 120.

⁵² *Id.*

⁵³ *Id.*

⁵⁴ *Id.* at 121.

[W]hen the plagiarist does not take out a block in situ [sic], but an abstract of the whole, decision is more troublesome. Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since otherwise the playwright could prevent the use of his "ideas," to which, apart from their expression, his property is never extended. Nobody has ever been able to fix that boundary, and nobody ever can.⁵⁵

The opinion declared that stealing lines or scenes or stealing specific characters from a work may be actionable if it is a substantial taking.⁵⁶ The court reasoned that the comparison of the similarity between two plots and storylines requires examination at the lowest level of abstraction that it takes to find the two works are the same; if the works are only similar at a high level of abstraction, it will be less likely that their similarity will constitute actionable infringement.⁵⁷ For example, the two works at issue in *Nichols* may be abstracted as follows (starting with a high level of abstraction and working downward):

two works about two men with children;

two works about two men whose children marry;

two works about two men whose children marry causing the men grief and anger;

two works about two men whose children marry in secret causing the men grief and anger;

two works about two men from different religions whose children marry in secret causing the men grief and anger because of their religious differences;

two works about two men from different religions whose children marry in secret, causing the men grief and anger because of their religious differences, but who reconcile in the end;

⁵⁵ *Id.* (citation omitted).

⁵⁶ *Id.*

⁵⁷ *Id.*

two works about a Jewish man and an Irish Catholic man whose children marry in secret, causing them grief and anger because of their religious differences, but who reconcile in the end;
and so on.

If the level of abstraction at which the works share the most similarities mainly involves the level of ideas (*e.g.*, the idea of pig-headed men who cannot get along because of religious differences; the idea of men who overcome petty religious differences in favor of stronger values), or generalities (*e.g.*, problems of marriages of two people from different religions; the situation of marriages that cause animosity in families but later produce a kind of coexistence), or repeats plot devices and stock themes common to many works (*e.g.*, star-crossed lovers; feuding families brought together by a marriage of defectors; fathers who compromise because of love of children or grandchildren), then the works are similar at a level where the first author cannot claim protection. The abstraction of two literary works for comparison of the plot and storyline must not result in a pattern of similarity that eliminated so many disparate details of the works that the remaining similarities are simply plot ideas, stock themes, or common character types interacting in predictable ways.⁵⁸ This is the level of abstraction where Judge Hand found the two works in *Nichols*, and he rejected the claim for infringement.⁵⁹

The process of abstraction and comparison described in *Nichols* works well in literary pieces where individual authors, all using a common language (English), may discuss a common theme, plot device, or character-type or may flesh out a familiar scene or stock image. In such instances, all literary works will share commonalities if they share a common idea but not elements that are original to one author. The idea and the expression of the idea will merge in a literary sense as the idea itself captures the several words and phrases necessary to communicate the idea in writing. Judge Hand recognized that it is prudent to declare such plot ideas, character-types, familiar scenes, and stock images as part of the public domain, available to all authors who wish to embody the idea or scene in their own work.⁶⁰ Thus, his decision is the grandfather of both the merger doctrine and the *scènes à faire* doctrine.

⁵⁸ *Id.* at 120–21.

⁵⁹ *Id.* at 121–22.

⁶⁰ *See id.*

In the last two decades, the merger doctrine has seen the greatest increase in its application in cases concerning the copyrightability of computer programs. Computer programs are both literary (the source code and object code)⁶¹ and functional.⁶² Sometimes computer programs also produce visual results. The argument was raised and accepted in many computer code copyright cases that within a given programming language, certain results (the ideas) cannot be achieved without using certain expressions (source code).⁶³ Thus, a merger of idea and expression was found and sequences of source code were declared to be uncopyrightable to avoid giving an early programmer a monopoly over a number of results in the context of the use of a certain programming language.⁶⁴

The merger doctrine is inapplicable when the same idea can be expressed in a plurality of different manners.⁶⁵ In these situations each author's creative original expression of the idea deserves copyright protection.⁶⁶

A perfect example of how courts misinterpret the merger doctrine in connection with visual works is the Ninth Circuit case of *Herbert Rosenthal Jewelry Corp. v. Kalpakian*.⁶⁷ In *Kalpakian*, the court determined that there was only one way for the idea of a jeweled pin in the shape of a bee to effectively be depicted.⁶⁸ As a result, the court ruled that the defendant could copy a plaintiff's depiction of a jeweled bee pin because the plaintiff's depiction was the only possible effective depiction, and the plaintiff cannot claim a copyright monopoly of the only available method of depicting an idea.⁶⁹ The idea and the depiction are one, and no one can copyright an idea.⁷⁰ Although this is a venerated opinion, cited and

⁶¹ Nimmer, *supra* note 14, § 2.04[C]; see 17 U.S.C. § 101 (2000) (definition of "computer program").

⁶² Nimmer, *supra* note 14, § 2.18[J].

⁶³ *Id.* §§ 2.04[C], 2.18[B], 2.18[J]; see Lemley, *Convergence*, *supra* note 4, at 11, 14, 16, 31.

⁶⁴ An outcome that should be precluded by *Baker v. Selden*, 101 U.S. 99, 103–04 (1879). See generally Nimmer, *supra* note 14, §§ 2.04[C], 2.18[B].

⁶⁵ *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983); Goldstein, *supra* note 14, § 2.3.2.

⁶⁶ Goldstein, *supra* note 14, § 2.3.2; *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926) (holding that when a myriad of variations of a scene are possible, a myriad of protectable copyrights can exist).

⁶⁷ 446 F.2d 738 (9th Cir. 1971).

⁶⁸ See *id.* at 742.

⁶⁹ See *id.* at 740.

⁷⁰ See generally *id.*

accepted for decades,⁷¹ the opinion is simply wrong. The fallacy of the opinion is that there is only one effective way to depict a jeweled bee pin. Nothing limits the creative potential of the designer of a jeweled bee pin other than the simple notion that the end product should resemble a bee.⁷² The amount of gold or other metal used and exposed in the design, the size and shape and number of the gems or semi-precious stones used, the color, tone, shade, clarity, and brilliance of the gems or stones used, whether the gems or stones will have few or many or no facets are simply the beginning of the creative opportunities available to a designer of a jeweled bee pin.⁷³ The plaintiff monopolizes nothing by coming out with one possible design when there are so many other available designs. In the light of these creative opportunities, there is no need to allow the defendant to copy plaintiff's single and original design.

The *scènes à faire* doctrine compliments the merger doctrine when it is applied to literary works. The *scènes à faire* doctrine provides that when discussing a certain topic, story-line, or genre, there are certain themes, scenes, incidents, character types, or settings that, as a practical matter, must be used to properly treat the topic.⁷⁴ A literary discussion of a salmon run will inevitably describe how they swim for hundreds of miles, fly up over waterfalls, some being snatched in mid-air by hungry grizzly bears, and the rest striving to return to the pools where they were spawned. Motion pictures following the boy-meets-girl, boy-gets-girl, boy-loses-girl, boy-gets-girl-back storyline inevitably will employ character types of thoughtless boys and petulant girls, and contain similar scenes of miscommunication, anger, and reconciliation in their conflict development and conflict resolution. A discussion of the 'Three Stooges' or Chris

⁷¹ E.g., Goldstein, *supra* note 14, § 2.3.2.

⁷² If the only similarity between the two works was that they both resembled a bee, then the plaintiff's claim of infringement properly failed. The similarity would have been limited to the shared concept or idea of the two works, and the idea itself is not copyrightable. If the holding of *Kalpikian* were limited to this proposition, the case would be correct. But the opinion goes much farther by declaring that plaintiff produced the only possible design and depiction of a jeweled bee inviting every subsequent jeweler to copy plaintiff's bee design without limitation. See *Herbert Rosenthal Jewelry*, 446 F.2d at 742.

⁷³ The record unfortunately indicates that plaintiff's counsel was not sufficiently knowledgeable about jewelry when it came to explaining the different design opportunities available to the defendant. See *id.* at 740.

⁷⁴ E.g., *Atari Inc., v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 616 (7th Cir. 1982), *superseded by rule in part*, Fed. R. Civ. P. 52(a), *as recognized in Scandia Down Corp. v. Euroquilt, Inc* 772 F. 2d 1423 (7th Cir. 1985); see Goldstein, *supra* note 14, § 2.3.2.

Farley's movies will inevitably contain references to "slap-stick," "prat falls," "physical comedy," and "self-effacing humor." The works discussing these scenes and themes will use similar language even at a fairly low level of abstraction because the very idea that is being expressed requires authors to use certain terminology and phrasing.⁷⁵ An author's use of these terms and phrases is not original and cannot impose a monopoly on the terms and phrases associated with the scene or theme.⁷⁶

When applied in the context of literary or utilitarian works, the *scènes à faire* doctrine means that copyright protection is denied to common elements of work that are essential to the presentation of the subject matter of the work.⁷⁷ The rationale for the rule is that elements dictated by subject matter itself necessarily lack originality.⁷⁸ Another way of looking at it is that stock images and themes that are covered under the *scènes à faire* doctrine are in the public domain, and are thus free to be used by all.⁷⁹ In a true *scènes à faire* situation, the plaintiff author is as likely to have drawn her material from the public domain as the plagiarist is, and it is even more likely that the alleged plagiarist has not copied plaintiff author's work at all, but instead drew the material from the public domain.

The *scènes à faire* doctrine has no proper application in the case of visual works.⁸⁰ To the extent that the idea of certain images is in the public domain, they are free for use whether characterized as *scènes à faire* or simply themes and ideas.⁸¹ In the visual work context, all themes and ideas (mundane ideas and clever ideas, stock images and innovative images, scenes that must be done and those that are more optional) are proper subjects for works as long as the author does not copy the expression of

⁷⁵ See Goldstein, *supra* note 14, § 2.3.2.

⁷⁶ *Id.*

⁷⁷ *Dun & Bradstreet Software Servs., Inc. v. Grace Consulting, Inc.*, 307 F.3d 197, 214–15 (3d Cir. 2002); *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1375 (10th Cir. 1997). See generally Kurtz, *supra* note 5, at 90–96; Goldstein, *supra* note 14, § 2.3.2.

⁷⁸ *Dun & Bradstreet*, 307 F.3d at 214–15; *Mitel*, 124 F.3d at 1375.

⁷⁹ See *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 400 F.3d 1007, 1011–12 (7th Cir. 2005); *Swirsky v. Carey*, 376 F.3d 841, 850 (9th Cir. 2004); *Murray Hill Publ'ns, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 319 (6th Cir. 2004); *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 132 (2d Cir. 2003); *Computer Mgmt. Assistance Co. v. Robert F. DeCastro, Inc.*, 220 F.3d 396, 401 (5th Cir. 2000).

⁸⁰ See *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 287 (3d Cir. 2004) (en banc) (Becker, J., concurring), *cert. denied*, 126 S. Ct. 336 (2005).

⁸¹ See *Murray Hill Publ'ns*, 361 F.3d at 319.

another copyrighted visual work.⁸² In other words, there is no single visual expression of stock theme or commonplace idea that must be copied in order for the “scene” to be “done” properly. That is why many courts have recognized that *scènes à faire* is a doctrine that applies to literary or dramatic works.⁸³ It does not fit with visual works.

The idea of a soup can as the subject of a painting is in the public domain, but Andy Warhol’s embodiment of that idea in the form of a Warhol painting of a Campbell’s soup can is not in the public domain.⁸⁴ No artist wishing to embody the idea of a soup can in their work needs to copy Warhol’s embodiment of that idea. They are free to paint all the soup cans they want (in a copyright sense, without regard to the limitations of other areas of the law, such as trademark, unfair competition, and false designation of origin laws) as long as they do not copy Warhol’s embodiment of the idea. Jeff Koons can paint or sculpt a work embodying the idea of two people holding a string of puppies in their laps; he just cannot copy Art Roger’s embodiment of that idea in the form of an Art Roger photograph.⁸⁵

The difficulties in applying the idea-expression dichotomy in photography in light of the lurking presence of the merger and *scènes à faire* doctrines is revealed by comparing two cases from the federal trial court of the Southern District of New York, *Mannion v. Coors Brewing Co.*⁸⁶ and *Kaplan v. Stock Market Photo Agency, Inc.*⁸⁷ In *Mannion*, the court considered a photograph of basketball star Kevin Garnett who was depicted wearing a considerable assortment of men’s jewelry.⁸⁸ A similar photograph appeared as part of a Coors billboard advertisement, where the allegedly plagiarized photograph zeroed in on the hands and mid-section of the model.⁸⁹ Similarities were noted in the heavily veined hands of the

⁸² See *Country Kids ‘N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1286–87 (10th Cir. 1996).

⁸³ *Southco*, 390 F.3d at 287 (Becker, J., concurring); *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 535 (6th Cir. 2004); *Murray Hill Publ’ns*, 361 F.3d at 319–20; *Cavalier v. Random House, Inc.*, 297 F.3d 815, 823 (9th Cir. 2002); *Sheen*, 77 F.3d at 1286.

⁸⁴ Assuming no lapse in the registration, renewal, and protection for works created prior to 1979, the copyright should last at least until 70 years after Warhol’s death. 17 U.S.C. § 302(a) (2000).

⁸⁵ See *Rogers v. Koons*, 960 F.2d 301, 307–08 (2d Cir. 1992).

⁸⁶ 377 F. Supp. 2d 444 (S.D.N.Y. 2005).

⁸⁷ 133 F. Supp. 2d 317 (S.D.N.Y. 2001).

⁸⁸ 377 F. Supp. 2d at 447 (referring to it as “bling bling”).

⁸⁹ *Id.* at 448.

model in both photographs, the same white athletic attire, and the same number, type, assortment, and placement of the items of jewelry worn by the model, although the composition of the allegedly infringing work was a mirror image of the original.⁹⁰ Coors and its ad agency defended the allegations by asserting that plaintiff's photograph was not protectable: It was a rendition of an unprotectable idea—a heavily bejeweled African-American man—and any alleged similarities between the two works were attributable to the fact that both photographers had chosen to depict the same subject matter.⁹¹ Subject matter from the real world is fact, and the idea of depicting such subject matter in a photograph is an idea, and ideas and facts are not copyrightable.

The *Mannion* court rejected these assertions in their entirety.⁹² The court noted that photographs are readily copyrightable, and the creative, original elements are found in the photographer's rendition of the photograph, the timing of the photograph, or the creation of the subject matter of the photograph.⁹³ The court noted the originality of plaintiff's creation and the rendition of the subject matter and the substantial similarity between defendants' depiction and plaintiff's⁹⁴ and denied defendants' summary judgment motion.⁹⁵

In *Kaplan*, the court declared that the second of two photographs, each depicting a person in businessman's attire staring down at his feet which dangle over the edge of a tall building as if he is contemplating a leap from the edge (*i.e.*, a photograph of a potential executive jumper taken from the jumper's perspective) could not be held to infringe the first photograph.⁹⁶ The court reasoned that the general similarity between the two works was attributed to the two photographers' choices to depict the same subject matter, and any direct similarities between the actual photographs was

⁹⁰ See *id.* and Images 1 and 2 attached to the opinion.

⁹¹ *Id.* at 452, 455–56, 462.

⁹² *Id.* at 462–63.

⁹³ *Id.* at 452–53.

⁹⁴ *Id.* at 456 (“The ‘idea’ (if one wants to call it that) [of the photograph] postulated by the defendants does not even come close to accounting for all the similarities between the two works, which extend at least to angle, pose, background, composition, and lighting. It is possible to imagine any number of depictions of a black man wearing a white T-shirt and ‘bling bling’ that look nothing like either of the photographs at issue here.”).

⁹⁵ *Id.* at 462–63.

⁹⁶ See *Kaplan v. Stock Mkt. Photo Agency, Inc.*, 133 F. Supp. 2d 317, 323–26 (S.D.N.Y. 2001).

necessitated by the common scene and subject matter of the photographs.⁹⁷ If that were the extent of the discussion, the case would gel nicely with *Mannion*, but the court goes on to state that “[i]t would be impossible to depict the photograph’s subject matter without portraying [the subject] in [the] pose” selected by the original photographer.⁹⁸ Then, the court incongruously identifies several aspects of the two photographers’ rendition or staging of the photograph that were freely open to artistic creativity: the point of view of the photograph (bird’s eye, over the shoulder, frontal, below from a far angle, below from a direct upward angle, or from the jumper’s point of view), the cropping of the photograph (close up, medium, wide angle), the angle of the jumper’s perspective (*e.g.*, whether it took in a snippet of pin-striped pants legs or a knee to shoe length of pin-striped pants legs), the shading of the street below in the one photograph and the inclusion of a second building closely abutting the opposite side of the street in the other photograph.⁹⁹ With respect to the point of view, the court even admits: “There may be, as [plaintiff] Kaplan suggests, many other angles from which to depict the scene”¹⁰⁰ Nevertheless, the court believed that each artistic decision of the original photographer was dictated by the merger of the subject matter with the depiction and any specific elements of the depiction not merged with the idea of the subject matter were *scènes à faire* of the scene depicted.¹⁰¹

The *Mannion* court rejected the application of the merger and *scènes à faire* doctrines to visual works because it held that the idea-expression distinction should be severely limited in cases involving visual works, while in *Kaplan* the court placed no such limitation on their application to visual works.¹⁰² *Mannion* discussed the abstraction analysis of *Nichols* and the concept of the “line” that must be drawn where the second work takes too much protected original expression because it encompasses too specific an abstraction of the first work.¹⁰³ *Mannion* stated that with respect to visual media, such as photography:

⁹⁷ *See id.*

⁹⁸ *Id.* at 324.

⁹⁹ *Id.* at 325–26.

¹⁰⁰ *Id.* at 326.

¹⁰¹ *Id.* at 323, 324 & n.10, 325.

¹⁰² *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 452–53 (S.D.N.Y. 2005); *Kaplan*, 133 F. Supp. 2d at 323–24 (applying *scènes à faire* doctrine to visual works).

¹⁰³ *Mannion*, 377 F. Supp. 2d at 457.

[T]he line itself is meaningless because the conceptual categories it purports to delineate are ill-suited to the subject matter

The idea/expression distinction arose in the context of literary copyright. For the most part, the Supreme Court has not applied it outside that context

In the visual arts, the distinction breaks down “[O]ne cannot divide a visual work into neat layers of abstraction in precisely the same manner one could with a text”

. . . [L]ittle is gained by attempting to distinguish an unprotectible [sic] “idea” from its protectible [sic] “expression” in a photograph or other work of visual art

. . . .
. . . The idea/expression distinction in photography, and probably the other visual arts, thus achieves nothing . . .

. . . [and] is not useful or relevant.¹⁰⁴

The *Mannion* opinion preserves the creative original components of photography and original combinations of unprotectable components that are meant to be protected under the holdings of *Feist* and *Sarony*.¹⁰⁵ It accomplishes this by limiting the application of the idea-expression distinction in cases involving visual works and rejecting the expansive application of the merger and *scènes à faire* doctrines to visual works.

III. EFFECTS OF THE EXPANDING APPLICATION OF THE MERGER AND SCÈNES À FAIRE DOCTRINES TO VISUAL WORKS

Sadly, the courts have not been content to limit the application of the merger and *scènes à faire* doctrines to literary or dramatic settings. Instead, courts have applied these doctrines to claims of infringement of visual works wherein the elements of visual works that are claimed to be unprotected under these doctrines are filtered out and purposefully ignored

¹⁰⁴ *Id.* at 458–59, 461 (quoting Jon O. Newman, *New Lyrics for an Old Melody: The Idea/Expression Dichotomy in the Computer Age*, 17 CARDOZO ARTS & ENT. L.J. 691, 698 (1999)) (footnotes omitted).

¹⁰⁵ *Id.* at 461–62; *Sarony v. Ehrich* 28 F. 79, 80 (C.C.S.D.N.Y. 1886). See generally *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

when comparing a competing work against the original in a test of substantial similarity.¹⁰⁶ The result in far too many cases is that visual works are reduced down to nothing, which further results in the award of summary judgment or judgment as a matter of law for the defendant before the finder of fact even gets a chance to make an intrinsic evaluation of the substantial similarity of the two works.¹⁰⁷

This section presents the law of each circuit regarding the merger doctrine and *scènes à faire* doctrine in evaluating substantial similarity of two visual works. I will present the circuits favoring an expansive interpretation of the two doctrines first, followed by the circuits that have a more a circumscribed approach to the application of the merger and *scènes à faire* doctrines to visual works. In one instance, I will present the circuits out of order for the reason that the Ninth Circuit's jurisprudence on the issue reveals the problem I am analyzing in the starkest focus.

A. *Circuits With an Expansive View of the Application of the Merger and Scènes à Faire Doctrines to Visual Works*

1. First Circuit

The First Circuit presents a relevant starting point for this discussion. In *Yankee Candle Co. v. Bridgewater Candle Co.*,¹⁰⁸ the First Circuit affirmed and endorsed the substantial similarity test applied by the lower court, the District of Massachusetts.¹⁰⁹ The case involved the comparison of pictorial labels for scented candles.¹¹⁰ The District of Massachusetts applied the

¹⁰⁶The most common formulation of the test is called the abstraction-filtration-comparison test, which is traced to *Computer Associates International, Inc. v. Altai, Inc.*, where the court applied the abstraction-filtration-comparison test in the evaluation of similarity of merged and *scènes à faire* elements of computer programs. 982 F.2d 693, 706–07 (2d Cir. 1992).

¹⁰⁷*E.g.*, *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25 (1st Cir. 2001).

¹⁰⁸*Id.*

¹⁰⁹*Id.* at 32. The prevailing law on substantial similarity is to subject the work to two tests: an extrinsic similarity test (sometimes called probative similarity test) in which the ideas behind the two works and expressions of those ideas are evaluated for evidence of probable copying, and an intrinsic similarity test (sometimes called substantial similarity test) in which a non-expert, ordinary observer is to determine the extent or substantiality of the copying. *See id.* at 33; *Dam Things from Den. v. Russ Berrie & Co.*, 290 F.3d 548, 562 & nn.19–20 (3d Cir. 2002); *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 140 (2d Cir. 1992). The two step nature of the analysis is traced to *Arnstein v. Porter*, 154 F.2d 464, 468–69 (2d Cir. 1946).

¹¹⁰*Yankee*, 259 F.3d at 32.

merger doctrine and *scènes à faire* doctrine to dissect the Yankee labels and remove much of their contents from the intrinsic similarity analysis: the rectangular shape, the gold border, the small rectangular center box containing the fragrance name, the “full-bleed” style of photography (where the picture extends to the edges of the labels), and, in general, the photographic representation of fruits, flowers, plants, and scented objects on the labels.¹¹¹ All of these were claimed to be *scènes à faire* elements, merged elements, or elements that incorporated public domain features.¹¹²

On appeal, Yankee made the argument that this application ignored the fact that there are myriad ways to photograph fruit, flowers, plants, and scented objects and combine them in an attractive way by making artistic choices¹¹³ much in the same way that Napoleon Sarony in the *Sarony* case had to make artistic choices in his photographing of Oscar Wilde.¹¹⁴ Yankee argued for a test of intrinsic similarity that allowed the finder of fact to consider the “total look and feel” of the label.¹¹⁵ After all, it is black letter copyright law that a creative combination of unprotected elements can obtain protection under copyright law¹¹⁶ and such a combination deserves to be regarded in the substantial similarity evaluation.¹¹⁷

The First Circuit rejected each argument. The court accepted the fact that Yankee had proved that Bridgewater copied the labels;¹¹⁸ yet it affirmed summary judgment for Bridgewater, stating that “even if Bridgewater actually copied Yankee’s labels, the merger doctrine operates so that no reasonable juror could have found Bridgewater’s labels to be ‘substantially similar’ to those of Yankee.”¹¹⁹ The court’s rendering of the merger doctrine held that:

Some ideas admit of only a limited number of expressions.
When there is essentially only one way to express an idea,
the idea and its expression are inseparable and copyright is

¹¹¹ *Yankee Candle Co. v. Bridgewater Candle Co.*, 99 F. Supp. 2d 140, 143–45, 148 (D. Mass. 2000).

¹¹² *Id.* at 145–46.

¹¹³ *Yankee*, 259 F.3d at 35.

¹¹⁴ *Sarony v. Ehrich*, 28 F. 79, 80 (C.C.S.D.N.Y. 1886).

¹¹⁵ *See Yankee*, 259 F.3d at 32.

¹¹⁶ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co. Inc.*, 499 U.S. 340, 348 (1991).

¹¹⁷ *See Yankee*, 259 F.3d at 32.

¹¹⁸ *Id.* at 33.

¹¹⁹ *Id.*

no bar to copying that expression. [Even] [w]hen the idea and its expression are not completely inseparable, there may still be only a limited number of ways of expressing the idea.¹²⁰

The court stated that in light of the merger doctrine's application in the case of depictions of items found in nature or in everyday life,¹²¹ the plaintiff must bear a "heavy burden" of showing near identity between the two works.¹²² Finding it impossible for a jury to find that kind of "near identity," the court affirmed the trial court's decision to take the issue away from the jury.¹²³

The expansive application of the merger and *scènes à faire* doctrines was also affirmed in *Matthews v. Freedman*.¹²⁴ The trial court refused to compare the common elements of a souvenir t-shirt bearing the logo "Someone Went to Boston and got me this shirt because they love me Very much"¹²⁵ surrounded by a sailboat and a lobster with a competing souvenir t-shirt bearing the logo "Someone Who Loves Me Went to Boston and Got Me this Shirt" also surrounded by a sailboat and a lobster.¹²⁶ The Court of Appeals admitted that the case presented a problem where:

An alleged infringing work taken as a whole may seem "substantially similar" to the copyrighted work taken as a whole, but the impression of similarity may rest heavily upon similarities in the two works as to elements that are

¹²⁰ *Id.* at 36; see *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678–79 (1st Cir. 1967) (rules of a contest were so simple they merge with the expression of the rules). *But see* *John G. Danielson, Inc. v. Winchester-Conant Props., Inc.*, 322 F.3d 26, 42–44 (1st Cir. 2003) (holding that the merger doctrine was inapplicable to architectural drawings where a restrictive covenant made one method of developing the site legally easier and cheaper than others, but it did not transform the drawings into the only physically possible means to express ideas for such development).

¹²¹ *Yankee*, 259 F.3d at 36 (citing *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 608–11 (1st Cir. 1988) (depicting deer in lawn ornaments); *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210, 1214–16 (11th Cir. 2000) (depicting a Bird Girl statute relating to the book and film *Midnight in the Garden of Good and Evil*); *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 739 (9th Cir. 1971) (depicting a jeweled bee)).

¹²² *Yankee*, 259 F.3d at 36.

¹²³ *Id.* at 36–37.

¹²⁴ 157 F.3d 25 (1st Cir. 1998).

¹²⁵ *Id.* at 26 (random capitalization of words shown is the same as in the original).

¹²⁶ *Id.* Each shirt had one or more other iconic symbols of Boston that were dissimilar.

not copyrightable—because those elements are the underlying ideas, or expressions that are not original with the plaintiff, or for some like reason.¹²⁷

Each shirt had lettering drawn in a childish style, but the court affirmed that the choice of rendering letters in a childish style was inevitable and necessary.¹²⁸ The use of similar iconic symbols of Boston was also inevitable and necessary.¹²⁹ The fact that the words were so similar was ignored because the court found that it was only the idea behind the words that was similar.¹³⁰ Rejecting the possibility that the two creators' rendering and embodiment of the ideas might in fact be one creator copying the other's embodiment of the ideas, and that improper copying is what the court should be considering, the trial court instead approved the procedure of expelling any part of the shirt that might, in fact, embody a stock image or idea relating to Boston and people who buy t-shirts for loved ones.¹³¹ The First Circuit declared, in effect, that the initial creator's copyright is so thin that only a slavish copy—a complete, 100% true copy produced by scanning or photocopying or photographic reproduction of the first author's creation—would violate the first author's copyright in her work.¹³²

The most puzzling part of the First Circuit's analysis is that the court recognizes that "entirely unoriginal expressions taken from others might sometimes be combined in a way that gives rise to a new protectible [sic] expression."¹³³ The court also acknowledged that the ordinary observer (intrinsic similarity) test in copyright precludes copying if the second author's works are to the average observer substantially similar in design and overall aesthetic appeal.¹³⁴ By dissecting out of the work all of the elements that are supposedly merged with their underlying ideas or that embody stock, or *scènes à faire*, elements (leaving aside the fact that there are myriad ways to embody a stock image or idea in a visual work), the court leaves little or nothing from the original author's composition to

¹²⁷ *Id.* at 27 (emphasis in original).

¹²⁸ *Id.* at 28.

¹²⁹ *Id.*

¹³⁰ *Id.*

¹³¹ *Id.* at 27–28.

¹³² *See id.*

¹³³ *Id.* at 28 (comparing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358–59 (1991)).

¹³⁴ *Id.* (citing *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 608–11 (1st Cir. 1988)).

compare to the alleged plagiarist's work. The judgment in favor of the plagiarist was affirmed.¹³⁵ To add insult to injury, the court also affirmed the award of \$25,000 in attorneys' fees to the defendant because in the court's estimation the original artist chose to bring a weak, nonfrivolous, case and argued for an unreasonable extension of copyright protection.¹³⁶

In these two cases, the First Circuit's expansive application of the merger and *scènes à faire* doctrines took the cases away from the jury. Average observers were not allowed to compare the works. The court failed to acknowledge that the plaintiffs might have combined unprotectable elements in a creative, original way, producing a complete and protectable construct that would be attractive for copying—even in the face of fairly certain evidence that the defendants did copy plaintiff's creation. After stripping away what the judges thought were stock images and merged elements, the court saw that little or nothing was left to plaintiffs' works in both cases. Thus, with nothing to show to the average observers, there can be nothing substantial that could have been copied by the defendant. Summary judgment or judgment as a matter of law in favor of the alleged plagiarist is the inevitable result.

2. Ninth Circuit

The Ninth Circuit's interpretation of the merger and *scènes à faire* doctrines has also led to the destruction and reduction of visual works at the intrinsic similarity stage of the analysis.¹³⁷ The results of this analysis come into starkest focus in *Satava v. Lowry*.¹³⁸ The court in *Satava* held that there are obstacles to enforcing a copyright in a work that portrays or depicts a natural object, in this case, a jellyfish.¹³⁹ Using the intrinsic similarity test, the Ninth Circuit has held that unprotectable elements must be removed and discarded before the finder of fact is to perform the lay person intrinsic similarity analysis.¹⁴⁰ Guided by the principle that there must be only one way to depict a jelly fish in a visual media, the Ninth Circuit intentionally ignored the evidence collected by the district court in the case showing that

¹³⁵ *Id.* at 29.

¹³⁶ *Id.*

¹³⁷ See generally *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003).

¹³⁸ See *id.* at 810.

¹³⁹ See *id.* at 810–813.

¹⁴⁰ See *id.*; see also *Ets-Hokin v. Skyy Spirits Inc.*, 323 F.3d 763, 766 (9th Cir. 2003); *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987).

there were literally hundreds of ways to depict jellyfish, including the multiple ways produced by Satava and the many other ways attempted by Lowry and his associates.¹⁴¹ In fact, the court used this information against the plaintiff by stating that it had examined dozens of photographs of glass-in-glass jellyfish and found them all to be substantially similar.¹⁴² The court stated, “[t]hough none of the sculptures are identical, all of them are substantially similar. They differ only insofar as an artist has added or omitted some standard element.”¹⁴³

The belief that there is only one way to depict jellyfish in this art form would have allowed the court to find the idea of a jellyfish and the expression of the jellyfish merged. However, the court did not reach the merger issue in favor of a vigorous application of the *scènes à faire* doctrine as the court held that every depiction of jellyfish is an amalgam of unprotected standard images from nature.¹⁴⁴ The result of the analysis was the holding that an artist who produces a work that portrays or depicts a natural object will have an unenforceable copyright.¹⁴⁵ True, the court allows that a paper-thin copyright might exist, but it anticipates that no combination of unprotectable elements related to natural objects will add up to a substantial amount when found in the same proportion in the plagiarist’s work.¹⁴⁶

The road to *Satava* in the Ninth Circuit was a long and uneven one. Until recently, the circuit was not known for its hostility to the original contributions of artists working in visual media. It may come as a surprise to some that the Ninth Circuit is recognized as establishing the “total concept and feel” standard in the analysis of intrinsic similarity of visual works that usually coincides with a restrictive view of the merger and *scènes à faire* doctrines. *Sid & Marty Krofft Television Products, Inc. v.*

¹⁴¹ See *Satava v. Lowry*, No. CIV-S-01-701 GEB/DAD, slip op. at *2–4, 11 (E.D. Cal. June 12, 2002) (Lowry affirmed that there were “a myriad of ways that one could portray jellyfish in glass art;” Lowry’s associate described and produced multiple shapes and forms for jellyfish in glass art; Satava produced approximately 300 unique and individual glass-in-glass sculptures of jellyfish a month).

¹⁴² See *Satava*, 323 F.3d at 812.

¹⁴³ *Id.* at 812 n.5.

¹⁴⁴ See *id.* at 810–11, 812 & n.5 (finding it unnecessary to reach the merger doctrine issue as it had produced the same effect under the rationale that Satava could not claim a monopoly in any realistic depictions of jellyfish, and that any depiction of jellyfish must necessarily be a combination of unprotectable standard images).

¹⁴⁵ *Id.* at 811.

¹⁴⁶ See *id.* at 812.

McDonald's Corp. brought the phrase to the two prong extrinsic and intrinsic similarity test.¹⁴⁷ The first prong in the analysis was an extrinsic analysis to determine similarity in the general ideas underlying the expression in the two works.¹⁴⁸ Because some material that would appear to be similar would be unprotected under the originality and idea-expression restrictions (public domain themes and concepts, merged ideas, *scènes à faire*), the court instructed that analytic dissection is appropriate under extrinsic analysis so that protected expression in the first work can be compared with allegedly similar expression in the second work.¹⁴⁹ Expert witnesses can aid in determining when components of the work are similar.¹⁵⁰ The Ninth Circuit indicated that in many cases the extrinsic similarity may be determined by the court as an issue of law.¹⁵¹

The second part of the analysis was an intrinsic test that compared the substantiality of the similarity in the expression of both works.¹⁵² The intrinsic similarity test was to be determined by the ordinary reasonable person.¹⁵³ The finder of fact was to examine the works as a whole to evaluate their “total concept and feel.”¹⁵⁴ Therefore, analytic dissection at this stage of analysis was prohibited.¹⁵⁵

¹⁴⁷ See *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164–67 (9th Cir. 1977). The case involved the claim of the creators of the seemingly innocent children's show, *H. R. Pufnstuf*, against McDonald's, who allegedly copied the central puppet characters from *Pufnstuf* to populate the fanciful McDonaldland with Mayor McCheese, Grimace, and Hamburglar. Later, *Pufnstuf* was more closely examined for its marijuana references (e.g., puffing stuff; H.R. for hand rolled), which was held to be consistent with McDonald's interest in the *Pufnstuf* characters to attract not only hungry children who are fond of larger than life puppets with oversized heads, but also stoners with the munchies. See <http://www.cannabisculture.com/articles/2926.html> (last visited Mar. 22, 2006).

¹⁴⁸ *Sid & Marty Krofft*, 562 F.2d at 1164.

¹⁴⁹ *Id.*

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ *Id.* at 1167 (*Sid & Marty Krofft* gets the credit for working this standard into the intrinsic similarity test even though the opinion acknowledges *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970), as the origin of the four word phrase, “total concept and feel”.)

¹⁵⁵ *Id.* at 1164 (quoting *Twentieth Century Fox-Film Corp. v. Stonesifer*, 140 F.2d 579, 582 (9th Cir. 1944)) (“The two works involved in this appeal should be considered and tested, not hypercritically or with meticulous scrutiny, but by the observations and impressions of the average reasonable reader and spectator.”).

The two-part test was applied to realistic depictions of animals in *Kamar International, Inc. v. Russ Berrie & Co.*¹⁵⁶ Far from placing insurmountable obstacles in the face of the creator of such works, in 1981 the Ninth Circuit was positively offended by the proposition that realistic depictions of animals could not be original enough to be copyrightable: “Berrie makes the novel contention that realistic depictions of live animals are not copyrightable We find no authority for Berrie’s proposition. Anyone can copyright anything, if he adds something original to its expression.”¹⁵⁷ The Ninth Circuit reversed the district court in part for using the analytic dissection test in the intrinsic similarity prong of the two part substantial similarity test.¹⁵⁸

The court started to turn the corner on the merger and *scènes à faire* doctrines in *Aliotti v. R. Dakin & Co.*¹⁵⁹ In a case involving depictions of actual creatures (dinosaurs), the court reconsidered the *Sid & Marty Krofft* formulation of the intrinsic similarity test so as to better accommodate the merger doctrine.¹⁶⁰ The court noted:

Appellants argue correctly that the district court’s determination as to substantial similarity of expression relied incorrectly on the analytic dissection of the dissimilar characteristics of the dolls. Similarity of expression exists only when “the total concept and feel of the works” is substantially similar. Dissection of dissimilarities is inappropriate because it distracts a reasonable observer from a comparison of the total concept and feel of the works.¹⁶¹

The subtle insertion of the word dissimilarities is important because the court makes a point about dissection of similarities in an effort to open the door to the merger doctrine in visual media cases.¹⁶² The court held that:

To the extent that it is necessary to determine whether similarities result from unprotectable expression, it is

¹⁵⁶ 657 F.2d 1059, 1060–61 (9th Cir. 1981).

¹⁵⁷ *Id.* at 1061.

¹⁵⁸ *See id.* at 1063.

¹⁵⁹ 831 F.2d 898 (9th Cir. 1987).

¹⁶⁰ *Id.* at 902.

¹⁶¹ *Id.* at 901 (citations omitted).

¹⁶² *See id.*

appropriate under *Krofft*'s intrinsic test to perform analytic dissection of similarities. Although even unprotectable material should be considered when determining if there is substantial similarity of expression, no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas.¹⁶³

Thus, dissection entered the intrinsic portion of the similarity test, albeit after the "total concept and feel" of the works as a whole was evaluated by the finder of fact.¹⁶⁴ If there was no substantial, intrinsic similarity as to the works as a whole, the case was closed; but if there was substantial, intrinsic similarity as to the works as a whole, the similar features of the works could then be dissected and separately analyzed to make sure that all similarities were not as to unprotected elements.¹⁶⁵

Aliotti's innovation was not limited to taking down the total concept and feel standard of intrinsic similarity analysis. *Alliotti* also marks the expanded application of the merger doctrine and *scènes à faire* doctrine in visual media cases in the Ninth Circuit.¹⁶⁶ Courts who are intent on expanding the application of the doctrine find it hard to accomplish this in the face of the total concept and feel standard.¹⁶⁷ The total concept and feel standard finds its support in the bedrock copyright law stating that original combinations of uncopyrightable components can be protected.¹⁶⁸ Therefore, the evaluator must look at the total combination, not a stripped down combination when comparing it to the alleged plagiarist's work. By shelving the total concept and feel test, and stressing the dissection and filtration of allegedly merged and *scènes à faire* material, the court creates the opportunity for summary disposition of the suit—the more material that is stripped away from plaintiff's work, the more comfortable the court will be with finding as a matter of law that no average person could find the two works to be substantially similar as to the few items remaining in the plaintiff's work. If a court takes the total concept and feel standard seriously, it almost guarantees a jury trial unless the two works in their

¹⁶³ *Id.* (emphasis in original) (citations omitted).

¹⁶⁴ *See id.* at 901–02.

¹⁶⁵ *See id.*

¹⁶⁶ *See id.*

¹⁶⁷ *See id.*

¹⁶⁸ *See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991).

entirety are simply and manifestly dissimilar. Taking away a stripped down plaintiff's creation from the jury is an easier call than making an aesthetic determination that an average person could not find substantial similarity in the two works as a whole.

After *Aliotti* opened the door of the intrinsic test to the merger doctrine, the total part of the total concept and feel standard was not long for the Ninth Circuit's world. The wheels came off dramatically when the circuit had to face visual elements of computer programs in a monumental struggle between Apple and Microsoft for the rights of Microsoft to develop the graphical user interface (GUI) that became Windows 2.03 and 3.0 and opened the door to the release of Windows 95.¹⁶⁹ The facts of the case should have produced a narrow holding: Apple had entered into a license agreement with Microsoft that allowed Microsoft to adapt many of the graphical user interface features of Apple's operating system into Windows 2.03.¹⁷⁰ As a contract case, the outcome of the case is unremarkable: In the core provision of the license, Apple allowed its main competitor to copy and adapt many attractive elements of Apple's GUI in exchange for the right to use and adapt any attractive GUI features Microsoft developed during the license term.¹⁷¹ Apple came to regret the scope of the contract because it helped Microsoft to develop its product into the market-dominating operating system that we know today.¹⁷² However, the district court and the Ninth Circuit were forced to address issues beyond the contract's interpretation.¹⁷³ Apple raised tangential copyright issues as to the size, placement, and appearance of certain icons and certain features of

¹⁶⁹The struggle produced six district court opinions: *Apple Computer, Inc. v. Microsoft Corp.*, 709 F. Supp. 925 (N.D. Cal. 1989), *aff'd*, 35 F.3d 1435 (9th Cir. 1994) (Apple I); *Apple Computer, Inc. v. Microsoft Corp.*, 717 F. Supp. 1428 (N.D. Cal. 1989), *aff'd*, 35 F.3d 1435 (9th Cir. 1994) (Apple II); *Apple Computer, Inc. v. Microsoft Corp.*, 759 F. Supp. 1444 (N.D. Cal. 1991), *aff'd*, 35 F.3d 1435 (9th Cir. 1994) (Apple III); *Apple Computer, Inc. v. Microsoft Corp.*, 779 F. Supp. 133 (N.D. Cal. 1991), *aff'd*, 35 F.3d 1435 (9th Cir. 1994) (Apple IV); *Apple Computer, Inc. v. Microsoft Corp.*, 799 F. Supp. 1006 (N.D. Cal. 1992), *aff'd*, 35 F.3d 1435 (Apple V); *Apple Computer, Inc. v. Microsoft Corp.*, 821 F. Supp. 616 (N.D. Cal. 1993), *aff'd*, 35 F.3d 1435 (9th Cir. 1994) (Apple VI). The end result is the Ninth Circuit's opinion in *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435 (9th Cir. 1994).

¹⁷⁰*Apple*, 35 F.3d at 1438.

¹⁷¹*See id.* at 1440 & n.8 (Other provisions pertained to the delay of the release of Microsoft's Excel product for platforms other than Apple's Macintosh platform and the development of a new version of Microsoft's Word product for Apple's Macintosh platform.).

¹⁷²*See id.*

¹⁷³*Id.* at 1442-47.

the design and appearance of the “windows” on the GUI that were not sufficiently addressed in the license between the parties.¹⁷⁴ It is in this discussion of copyright law by the Ninth Circuit that an alarming interpretation of the merger and *scènes à faire* doctrines in the context of visual works was spawned.

As in other computer program cases, the district court was shaken by the possibility that programs might be subject simultaneously to the limiting doctrines of originality, functionality, standardization, *scènes à faire*, and merger.¹⁷⁵ As a result, the district court dissected the disputed features of the Macintosh and Windows interfaces based on a list of similarities submitted by Apple to decide which were protectable.¹⁷⁶ Thereafter, the district court applied the limiting doctrines of originality, functionality, standardization, *scènes à faire*, and merger to arrive at a finding of no copying of protectable elements in Windows 2.03 or 3.0.¹⁷⁷ The court then held that the Windows 2.03 and 3.0 works as a whole would be compared with Apple’s works for virtual identity.¹⁷⁸ When Apple declined to oppose motions for summary judgment of noninfringement for lack of virtual identity, however, judgments in favor of Microsoft were entered.¹⁷⁹

The Ninth Circuit approved of the dissection and discard of all allegedly unprotectable elements.¹⁸⁰ First, it summarized Apple’s objections to the district court’s ruling as follows:

Apple makes a number of related arguments challenging the district court’s copyright analysis. It contends that the district court deprived its works of meaningful protection by dissecting them into individual elements and viewing each element in isolation. Because the Macintosh GUI is a dynamic audiovisual work, Apple argues that the “total concept and feel” of its works—that is, the selection and arrangement of related images and their animation—must be compared with that of the Windows . . . GUIs for substantial similarity. Apple further

¹⁷⁴ *See id.*

¹⁷⁵ *Id.*

¹⁷⁶ *Id.* at 1438.

¹⁷⁷ *See id.*

¹⁷⁸ *Id.*

¹⁷⁹ *Id.*

¹⁸⁰ *See id.* at 1439.

asserts that in this case, the court had no occasion to dissect its works into discrete elements because Microsoft and HP [Hewlett Packard, Microsoft's licensee] virtually mimicked the composition, organization, arrangement and dynamics of the Macintosh interface, as shown by striking similarities in the animation of overlapping windows and the design, layout and animation of icons. Apple also argues that even if dissection were appropriate, the district court should not have eliminated from jury consideration those elements that are either licensed or unprotected by copyright. Though stated somewhat differently, all of these contentions boil down to the same thing: Apple wants an *overall comparison* of its works to the accused works for *substantial similarity* rather than virtual identity.¹⁸¹

In *Apple*, The Ninth Circuit knew it was evaluating a complex visual work rather than program codes registered as a literary work, but it was not ready to allow a total look and feel analysis of the overall graphical user interface of Apple compared to Microsoft's GUI.¹⁸² The Ninth Circuit stated that the law of the circuit had changed in *Brown Bag Software v. Symantec Corp.*, and that the intrinsic similarity test now included an analytic dissection and rejection of components before evaluating the less than total concept and some of the feel of the two programs.¹⁸³ In fact, the *Brown Bag* court had not held this and in fact had not reached the issue.¹⁸⁴ In any event, *Apple* drove a stake through the heart of evaluation of visual works: There would be a two stage test with analytical dissection at each stage and rejection of parts that were supposedly subject to the merger and

¹⁸¹ *Id.* at 1442 (emphasis in original).

¹⁸² *See id.* at 1442–43.

¹⁸³ *See id.* at 1443 (citing *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1475–76 (9th Cir. 1992)).

¹⁸⁴ *Brown Bag Software*, 960 F.2d at 1475–76. *Apple* also cited *Shaw v. Lindhein*, an opinion that in dicta made the remarkably backwards statement that the intrinsic similarity evaluation of visual works such as were involved in *Aliotti* (stuffed dinosaurs) and *Kalpakistan* (bee shaped jewelry) was well suited for determination by the court on a summary judgment motion when the merger doctrine is alleged to be involved, but the same could not be said for literary works. 919 F.2d 1353, 1360–61 (9th Cir. 1990). The *Shaw* court held that if a showing of similarity is made on the extrinsic evaluation of a literary work, it is wrong for the court to resolve the intrinsic evaluation of the work on a summary judgment motion. *Id.* at 1361. Instead, the finder of fact must make the subjective evaluation of the literary work. *Id.*

scènes à faire doctrines.¹⁸⁵ There would be no subjective evaluation of the total concept and feel of any visual work that allegedly merged with its underlying ideas (there being a drastically limited number of ways of depicting the idea visually) or allegedly embodied stock images that must be copied in order to depict the idea.¹⁸⁶

In *Cavalier v. Random House, Inc.*, *Apple's* holding was interpreted to mean that in visual art cases, the court is to filter out unprotectable elements in both the extrinsic and intrinsic similarity tests.¹⁸⁷ Oddly, the court did not think that this bears on the ability of an artist or author to receive protection for original combinations of unprotectable elements as described in *Feist*.¹⁸⁸ Nor did the court believe that this prevents the intrinsic similarity evaluator from considering the total concept and feel of the two works.¹⁸⁹ The court stated:

This does not mean that at the end of the day, when the works are considered under the intrinsic test, they should not be compared as a whole. Nor does it mean that infringement cannot be based on original selection and arrangement of unprotected elements. However, the unprotectable elements have to be identified, or filtered, before the works can be considered as a whole.¹⁹⁰

The end of this line of thinking is a case like *Satava*.¹⁹¹ But along the way we encounter *Ets-Hokin v. Skyy Spirits Inc.*, a case involving commercial photography.¹⁹² The court was receptive to the argument that there were only a drastically limited number of ways of depicting a Skyy Vodka bottle in photography, and thus used the merger doctrine to strip away the apparently similar features of plaintiff's and defendant's photography.¹⁹³ What similarities were left after the merger analysis were

¹⁸⁵ See *Apple*, 35 F.3d at 1442–47.

¹⁸⁶ See *id.*

¹⁸⁷ 297 F.3d 815, 825–26 (9th Cir. 2002) (“The basic mode of analysis for comparison of the literary elements applies to comparison of the art work. As with literary works, unprotectible [sic] elements should not be considered when applying the extrinsic test to art work.”).

¹⁸⁸ See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991).

¹⁸⁹ See *Cavalier*, 297 F.3d at 826.

¹⁹⁰ *Id.* (quoting *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir. 1994)).

¹⁹¹ See generally *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003).

¹⁹² See generally 323 F.3d 763 (9th Cir. 2003).

¹⁹³ See *id.* at 765–66 (“Though the Ets-Hokin and Skyy photographs are indeed similar, their

rejected as *scènes à faire* of commercial photography.¹⁹⁴ Plaintiff argued that application of the merger doctrine and *scènes à faire* doctrine to photography contradicted the established law regarding the originality and creativity of photography as an artistic medium.¹⁹⁵ The court failed to see the point; it held that photography certainly can achieve the level of originality required for copyright protection but still be susceptible to the merger and *scènes à faire* doctrines because similarities in photographs depicting the same subject necessarily flow from the subject matter and such similarities are, “as a practical matter, indispensable, or at least standard.”¹⁹⁶ The Ninth Circuit affirmed the lower court’s grant of summary judgment to defendant.¹⁹⁷

3. Fifth Circuit

In evaluating computer programs, the Fifth Circuit embraces the abstraction-filtration test, more popularly known as the abstraction-filtration-comparison test.¹⁹⁸ The goal of the test is to separate out unprotectable elements from the original work before the finder of fact makes a comparison with the allegedly infringing work.¹⁹⁹ In practice, the first step of the test is dissection, for only when the parts of a program or other work (starting with object code, source code, subroutines, and program structure, and working up to an articulation of the program’s ultimate function) are dissected can they be abstracted to their appropriate level of generality.²⁰⁰ Then each dissected part can be examined separately to see if any part is essentially composed of uncopyrightable ideas,

similarity is inevitable, given the shared concept, or idea, of photographing the Skyy bottle.”).

¹⁹⁴ See *id.* at 766 (citing *Apple*, 35 F.3d at 1442).

¹⁹⁵ See *id.* at 765 (citing *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884)).

¹⁹⁶ See *id.* at 765–66 (citing *Apple*, 35 F.3d at 1444).

¹⁹⁷ *Id.* at 764.

¹⁹⁸ See *Computer Mgmt. Assistance Co. v. Robert F. DeCastro, Inc.*, 220 F.3d 396, 400 (5th Cir. 2000); see also *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (first recognizing the abstraction test); *Eng’g Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1342–43 (5th Cir. 1994) (discussing the abstraction filtration comparison test); *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 834 (10th Cir. 1993) (discussing the abstraction filtration comparison test); *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706 (2nd Cir. 1992) (discussing the abstraction filtration-comparison test).

¹⁹⁹ *Computer Mgmt. Assistance Co.*, 220 F.3d at 401.

²⁰⁰ See *id.*; *Eng’g Dynamics*, 26 F.3d at 1342–43; *Gates Rubber*, 9 F.3d at 834; *Altai*, 982 F.2d at 706–07.

processes, facts, public domain information, merged material, or *scènes à faire* material.²⁰¹ Those parts that fit one of these categories are thrown out (filtered out in the terms of the test), but the end result is the same: The finder of fact never is to see them or consider them when comparing the original work with the allegedly infringing work.²⁰² To the extent that this stripping down process renders the original work an incomplete chop-shop jalopy that has alternately missing doors and windows, so be it. Under the abstraction-filtration test, the finder of fact may never see the original work as a whole and evaluate its total concept and feel.

As rooted as the abstraction-filtration test is in computer cases, the Fifth Circuit has been inconsistent in applying the test in other factual situations. In *Positive Black Talk Inc. v. Cash Money Records Inc.*,²⁰³ the court held that at the probative similarity stage,²⁰⁴ two competing musical works should be compared as a whole and “in their entirety, including both protectable and unprotectable elements.”²⁰⁵ As in most jurisdictions, the Fifth Circuit, in the absence of proof of actual copying, requires an initial showing of (1) defendant’s access to the original work, and (2) a showing of probative similarity of the two works to indicate probable copying.²⁰⁶ Then, in the absence of defendant’s proof of independent creation, the works are evaluated for substantial similarity.²⁰⁷ Even at the substantial similarity stage, the court affirmed the jury instruction that the “total concept and feel” of the two works must be evaluated.²⁰⁸

Lower courts in the Fifth Circuit have not been as expansive in their application of the merger and *scènes à faire* doctrines in visual art cases. In *Maggio v. Liztech Jewelry*, the Eastern District of Louisiana considered the merger doctrine in the context of evaluation of decorative jewelry.²⁰⁹ The

²⁰¹ See *Altai*, 982 F.2d at 706–07; *Computer Mgmt. Assistance*, 220 F.3d at 401; *Eng’g Dynamics*, 26 F.3d at 1342–44; *Gates Rubber*, 9 F.3d at 834–35.

²⁰² See *Altai*, 982 F.2d at 707–10; *Computer Mgmt. Assistance*, 220 F.3d at 402; *Eng’g Dynamics*, 26 F.3d at 1344–45; *Gates Rubber*, 9 F.3d at 836, 841.

²⁰³ 394 F.3d 357 (5th Cir. 2004).

²⁰⁴ This is held to be another wording for the “extrinsic similarity” step of the analysis, or whether the ideas underlying the original work were copied. See, e.g., *id.* at 373–74 & n.13.

²⁰⁵ *Id.* at 370 n.9 (citing *Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp.*, 25 F.3d 119, 123 (2d Cir. 1994)).

²⁰⁶ *Id.* at 368.

²⁰⁷ *Id.*

²⁰⁸ See *id.* at 373–74.

²⁰⁹ 912 F. Supp. 216, 223 (E.D. La. 1996).

court held that the merger doctrine applies only when there is only one way to express an idea.²¹⁰ Where the “idea is clearly capable of different forms of expression,” the idea does not merge with any one form of expression.²¹¹ In *Maggio*, the court found that the jewelry pins consisting of silhouettes of natural or symbolic shapes cut from chrome and embellished with copper wire and beading obviously was only one possible expression of the idea of making jewelry based on the silhouettes of natural and symbolic forms and shapes.²¹² The merger doctrine took nothing away from the original creator’s works.²¹³ Nor did the court strike away parts of the jewelry—the central part of the jewelry, the silhouette of a natural creature or symbolic shape—on the basis of the *scènes à faire* doctrine before allowing the finder of fact to consider the similarity of the two competing sets of jewelry.²¹⁴ Instead, the jewelry was to be evaluated as a whole for a comparison of the total concept and feel of the works.²¹⁵

4. Sixth Circuit

The Sixth Circuit is as unapologetic as the First Circuit in applying the merger and *scènes à faire* doctrines to visual works. The court states that “before comparing similarities between two works a court should first identify and eliminate those elements that are unoriginal and therefore

²¹⁰ *Id.*; see also *Veeck v. S. Bldg. Code Cong. Int’l, Inc.*, 293 F.3d 791, 801 (5th Cir. 2002) (en banc) (legislation enacting provision of copyrighted model code becomes part of the law, and the law cannot be copyrighted; the merger doctrine applies because the legislation is the only way to express the idea of the law).

²¹¹ See *Maggio*, 912 F. Supp. at 223.

²¹² See *id.*

²¹³ See *id.* at 223 n.5 (distinguishing *Tabra, Inc. v. Treasures de Paradise Designs, Inc.*, No. C 90-0155 MHP, 1990 WL 126187 (N.D. Cal. Apr. 24, 1990) (mem.) (expression of “primitive-look” bone, stone, shell, and beads jewelry held merged with idea of the same in that there was no distinguishing arrangement of the raw materials evident in the original works) and *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971) (expression of naturalistic jeweled bee pin held merged with idea of jeweled bee pin where pin was a lifelike representation of a natural creature and the court thought there was no unique or original arrangement of jewels)).

²¹⁴ See *Maggio*, 912 F. Supp. at 223; see also *Naghi v. Europe’s Finest, Inc.*, 114 Fed. App’x 606, 607 (5th Cir. 2004) (stating that even though hemp leaves are natural objects, expression of hemp leaf Mardi Gras necklace did not merge with idea of same because hemp leaves were susceptible to multiple expressions).

²¹⁵ See *Maggio*, 912 F. Supp. at 223.

unprotected.”²¹⁶ The court states that it will be faithful to *Feist* which “favors an approach that involves reducing the [substantial similarity] comparison to elements that are original.”²¹⁷ In and of themselves, these statements are unremarkable—unprotectable elements should be unprotectable and unoriginal components are unprotectable. But when combined with an expansive interpretation of the merger and *scènes à faire* doctrines, it spells disaster for visual works that feature expressions of real world objects and entities.

The Sixth Circuit accepts the abstraction-filtration-comparison test.²¹⁸ The Sixth Circuit follows the approach taken in *Sturdza v. United Arab Emirates*, which in turn took the test from the Tenth Circuit in *Country Kids ‘N City Slicks, Inc. v. Sheen*, which itself borrowed from the Second Circuit in *Computer Assocs. Int’l, Inc. v. Altai*.²¹⁹ Thus, the originality rubric of the Sixth Circuit is descended from computer software cases. In computer cases, the test ruthlessly filters out merged items and *scènes à faire* elements to avoid the situation where a programmer will corner the market on “the only and essential means,” or one of the only practical and efficient ways, to accomplish a programming task using a selected computer language and targeting a selected computer hardware configuration.²²⁰ Technical and practical requirements, design standards, and appropriate methods of operation dictate programming choices rather than the creative input of the creator, and in these circumstances the copyright requirement of originality precludes broad protection of the code written by the programmer whether the rationale is expressed as lack of originality, functionality over creative design, merger of programming elements with the idea of the program’s operation, or *scènes à faire* program elements.²²¹

The reductionist approach manifested in the abstraction-filtration test is also manageable in functional, non-software-related situations that mimic

²¹⁶ *Kohus v. Mariol*, 328 F.3d 848, 853 (6th Cir. 2003); see also *Small v. Exhibit Enters., Inc.*, 364 F. Supp. 2d 648, 652 (E.D. Mich. 2005).

²¹⁷ *Kohus*, 328 F.3d at 854 (citing *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)).

²¹⁸ *Id.* at 855 & n.1.

²¹⁹ See *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1295–96 (D.C. Cir. 2002); *Country Kids ‘N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1284 (10th Cir. 1996); *Computer Assocs. Int’l, Inc. v. Altai*, 982 F.2d 693, 706–07 (2d Cir. 1992).

²²⁰ See *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 534–36 (6th Cir. 2004).

²²¹ See *id.*

Baker and *Feist*, which are the classic cases involving non-original works created to present data.²²² In *ATC Distribution Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, and *Tastefully Simple, Inc. v. Two Sisters Gourmet, L.L.C.*, the Sixth Circuit followed the approach taken in *Baker* and *Feist* by applying the originality test and merger doctrine to find that an automobile parts catalogue and standard forms produced for reporting sales tax information and other food sales customer information were uncopyrightable because they simply allow for the reporting of standard information in the auto parts business and food sales business.²²³ There was no creativity in the arrangement of the parts listings or parts numbers in *ATC* nor in the line items on the forms and categories listed in *Tastefully Simple* that were not merged with the idea of keeping track of categories of information as a necessary part of doing business.²²⁴ *ATC* and *Tastefully Simple* are on all fours with *Baker* and *Feist*.

In a literary context, the abstraction-filtration test at least provides a framework to consider the similarity of literary works by focusing on the level of abstraction required to find that the works are the same.²²⁵ Judge Hand's process of abstraction in *Nichols* did not answer the question of how abstract is too abstract.²²⁶ But courts such as the Sixth Circuit are not deterred in finding that at the level of abstraction needed in the case at hand is too abstract to support an infringement claim, and the question should be taken away from the jury.²²⁷ Audio visual media, such as motion pictures and television, most often are analyzed as literary works because it is an unusual case where there is a question about actual audio and visual copying (taping) of a motion picture, stage play, or television show outside of the de minimis use or fair use contexts.²²⁸ Instead, the abstraction-filtration test is used when an allegation is made that characters, plots, scenes, or situations are stolen from a motion picture, stage play, or

²²² See generally *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991); *Baker v. Selden*, 101 U.S. 99 (1879).

²²³ See *ATC Distribution Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 710–11 (6th Cir. 2005); *Tastefully Simple, Inc. v. Two Sisters Gourmet, L.L.C.*, 134 Fed. App'x 1, 4–5 (6th Cir. 2005).

²²⁴ *Tastefully Simple*, 134 Fed. App'x at 4–5; *ATC*, 402 F.3d at 711–12.

²²⁵ See *Stromback v. New Line Cinema*, 384 F.3d 283, 296–300 (6th Cir. 2004); *Murray Hill Publ'ns, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 315–21 (6th Cir. 2004).

²²⁶ See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122 (2d Cir. 1930).

²²⁷ See, e.g., *Stromback*, 384 F.3d at 297–99; *Murray Hill*, 361 F.3d at 315–24.

²²⁸ See *Stromback*, 384 F.3d at 293.

television show.²²⁹ The filtration step still works to cancel out merged elements and *scènes à faire* character types, plot devices, standard scenes, and common situations from literary works.²³⁰ Problems arise, however, when a test created for computer software or the reporting of factual information begins to be applied in creative, visual media cases.²³¹

The filtration step, in the context of copying of static visual media sounds innocuous until you expand the definition of merger and *scènes à faire*. The Sixth Circuit in *Kohus* opined that latches for an outdoor play area were functional, which almost necessarily means that parts of their design are dictated by efficiency.²³² Rather than seeing the situation as one in which multiple efficient original designs might be possible, the court seemed to be looking for an excuse to find that only one set of characteristics would be efficient, and thus find that those characteristics were dictated by the task. Therefore, they are unoriginal, and are unprotectable under the merger doctrine.²³³ Similarly, under the *scènes à faire* doctrine, the court seems predisposed to find that certain characteristics of the latches must have been “dictated by external factors such as particular business practices[,] . . . standard industry practices for constructing latches, or safety standards.”²³⁴ If found, these features are filtered out largely based on the court’s subjective interpretation of what is necessary, functional, efficient, or original.²³⁵

Potential for greater respect for visual works is afoot in the Sixth Circuit. In *Winfield Collection, Ltd. v. Gemmy Industrial, Corp.*, the Sixth Circuit purported to apply the abstraction-filtration test in the context of a

²²⁹ *E.g.*, *Stromback*, 384 F.3d at 296–297; *Murray Hill*, 361 F.3d at 319–20.

²³⁰ *See Stromback*, 384 F.3d at 296–97; *Murray Hill*, 361 F.3d at 319–320.

²³¹ *See, e.g.*, *Kohus v. Mariol*, 328 F.3d 848, 857–58 (6th Cir. 2003) (drawing of a latch); *Sturza v. United Arab Emirates*, 281 F.3d 1287, 1295–96 (D.C. Cir. 2002) (architectural designs); *County Kids ‘N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1284 (10th Cir. 1996) (wooden dolls).

²³² *See Kohus*, 328 F.3d at 856.

²³³ *See id.*

²³⁴ *Id.* (quoting *Computer Mgmt. Assistance Co. v. Robert F. Castro, Inc.*, 220 F.3d 396, 401 (5th Cir. 2000)).

²³⁵ *Compare id.* (many aspects of play-area latches filtered out as driven by industry practices, functionality, efficiency, or necessity), *with Kellman v. Coca-Cola Co.*, 280 F. Supp. 2d 670, 676 (E.D. Mich. 2003) (aspects of foam headgear designed to look like a wing nut fastening device were not filtered out because court embraced the creators’ original and creative conception of the work as a visual pun on the phrase “wing nuts” as nutty fanatics of the Detroit Red Wings hockey team).

dispute involving a two-dimensional paper design for creating a “crashing witch” craft project that was compared to a competing three-dimensional “crashing witch” creation.²³⁶ The court found the works were purely aesthetic (as opposed to functional or utilitarian).²³⁷ In the analysis, the court considered the argument that most of the purported similarities of the two witch creations were merged with the idea of a crashing witch or were *scènes à faire* of witches in general: black clothing, curled boots, flowing cape, and a broom.²³⁸ But the court refused to end the analysis there. Instead, the court followed the reasoning of the Second Circuit in *Mattel, Inc. v. Goldberger Doll Manufacturing Co.*²³⁹ In *Goldberger Doll*, the Second Circuit recognized that works embodying common features are not without protection from direct copying.²⁴⁰ Even though in that case Mattel claimed a copyright for Barbie dolls that embody common doll features such as widely spaced eyes, upturned noses, and bow lips, the Second Circuit (as quoted by the Sixth Circuit) held that:

There are innumerable ways of making upturned noses, bow lips, and widely spaced eyes. Even if the record had shown that many dolls possess upturned noses, bow lips, and wide-spaced eyes, it would not follow that each such doll—assuming it was independently created and not copied from others—would not enjoy protection from copying.²⁴¹

The finding that there are common features typical of the idea of a doll’s face or *scènes à faire* of doll faces in general does not strike these features from the case under the merger doctrine or *scènes à faire* doctrine.²⁴² Instead, the Sixth Circuit followed the Second Circuit in concluding that the court must compare the creative embodiment or arrangement of these common features in the original creator’s work for evidence of direct copying.²⁴³ In *Winfield*, the court held that there was no similarity between

²³⁶ See 147 Fed. App’x 547, 552–54 (6th Cir. 2005).

²³⁷ *Id.* at 551.

²³⁸ *Id.* at 554.

²³⁹ *Id.* at 554–56 (citing *Mattel, Inc. v. Goldberger Doll Mfg. Co.*, 365 F.3d 133 (2d Cir. 2004)).

²⁴⁰ 365 F.3d at 135.

²⁴¹ *Winfield*, 147 Fed. App’x at 554–55 (quoting *Goldberger Doll*, 365 F.3d at 135).

²⁴² See *id.* at 555.

²⁴³ See *id.* at 554–55.

the embodiment of the witch features in the one work compared to the other, thus summary judgment for the defendant still was affirmed by the Sixth Circuit.²⁴⁴ But the appreciation of visual works is on the rise in the circuit.

5. Tenth Circuit

The Tenth Circuit implements the reductionist method under the name of the abstraction-filtration-comparison test to determine whether one product is substantially similar to another.²⁴⁵ First, the court separates the ideas (and basic utilitarian functions), which are not protectable, from the particular expression of work.²⁴⁶ Then, the court filters out the unprotectable components of the product from the original expression.²⁴⁷ Finally, the court compares the remaining protected elements to determine if the two works are substantially similar.²⁴⁸

In *Country Kids 'N City Slicks, Inc.*, plaintiff was a wholesale doll manufacturer that sold wooden dolls similar in size and shape to traditional paper dolls.²⁴⁹ In mid-1993, plaintiff noticed defendants marketing and selling similar wooden paper dolls, and subsequently brought suit for copyright infringement.²⁵⁰ Defendants claimed that while their dolls employed the concept of plaintiff's dolls, their dolls had distinctly different features, such as the eyes, hair, and nose.²⁵¹ Plaintiff argued that the wooden dolls were a form of expression of paper dolls, rather than an idea of a doll.²⁵² The court stated, "to the extent that the idea and the particular expression cannot be separated, the work cannot be protected by copyright because 'protecting the 'expression' in such circumstances would confer a monopoly of the 'idea' upon the copyright owner.'"²⁵³ Accordingly, the court affirmed the district court's characterization of wooden dolls as an

²⁴⁴ *Id.* at 556.

²⁴⁵ *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1285 (10th Cir. 1996).

²⁴⁶ *Id.*

²⁴⁷ *Id.*

²⁴⁸ *Id.*

²⁴⁹ *Id.* at 1283.

²⁵⁰ *Id.*

²⁵¹ *Id.*

²⁵² *Id.*

²⁵³ *Id.* at 1285 (citations omitted).

idea rather than a protected expression.²⁵⁴ In response to the plaintiff's argument that the features of the dolls are still copyrightable, the court stated: "[T]o the extent that the shape and size of Plaintiff's dolls are not inherent in the idea of a wooden paper doll, they are typical paper doll features found in the public domain and therefore are not copyrightable."²⁵⁵ After abstracting the idea from the expression and filtering out the unprotectable elements of the dolls, the court then looked to determine whether the protectable portions of the original work that had been copied constituted a substantial part of the original work.²⁵⁶ In determining substantial similarity, the court opined that the traditional test is "whether the accused work is so similar to the plaintiff's work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff's protectable expression by taking material of substance and value."²⁵⁷

In *Todd v. Montana Silversmiths, Inc.*, two artists who produce western-themed jewelry squared off over competing barbed-wire bracelet and matching earrings creations.²⁵⁸ Even though the court stated that "one can imagine any number of original ways to rearrange silver wire, barbs, [and] end caps,"²⁵⁹ the court eagerly applied the merger doctrine and took out the public domain elements of barbed-wire effects, hoop-style bracelets, and earrings.²⁶⁰ Plaintiff argued that the individual elements are not the focus of the originality tests, but rather the overall design (in plaintiff's words, the "creative gestalt") of the work.²⁶¹ Citing *Feist*, plaintiff asserted that copyright protection attached to the particular way she formed, placed, balanced, and harmonized together the elements of her barbed wire styled jewelry.²⁶² The court in its unhumble opinion did not think that plaintiff's combination of elements had any originality.²⁶³ The court held that plaintiff

²⁵⁴ *Id.* at 1286.

²⁵⁵ *Id.* at 1287 (citation omitted).

²⁵⁶ *Id.*

²⁵⁷ *Id.* at 1288 (quoting *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982), *superseded by rule in part*, Fed. R. Civ. P. 52(a), *as recognized in Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985)).

²⁵⁸ 379 F. Supp. 2d 1110, 1111 (D. Colo. 2005).

²⁵⁹ *Id.* at 1113.

²⁶⁰ *See id.* at 1112–13.

²⁶¹ *See id.* at 1112.

²⁶² *Id.*

²⁶³ *See id.* at 1113.

“arranged [the elements] in a way that by all objective measures still matches the elemental arrangement of barbed-wire.”²⁶⁴ The court must have supposed that the artist simply walked out and found barbed wire hoops laying around in the shape of spurs, cowboy hats, and boots, and then just dusted them off and attached a post and clasp to some to distinguish the bracelets from the earrings. Thus, plaintiff could not preclude defendant from producing barbed wire jewelry in the exact same configurations of western symbols (boots, spurs, and cowboy hats).²⁶⁵

The ordinary observer test, as applied by the Tenth Circuit, does not require a work to be a virtual copy of a protected one.²⁶⁶ Nor does it turn on whether an ordinary observer would confuse the two works in their entirety.²⁶⁷ Rather, the test only answers whether a reasonable person would conclude that “[a] defendant unlawfully appropriated the plaintiff’s protectable expression by taking material of substance and value.”²⁶⁸ Thanks to the merger and the *scènes à faire* doctrines, so much of the plaintiff’s work can be stripped away that it is easy, as a matter of law, to imagine that no other work could be substantially similar to the plaintiff’s, regardless of whether another started out to copy it or not.

6. Eleventh Circuit

The Eleventh Circuit’s application of the merger and *scènes à faire* doctrines in cases involving literary works is unremarkable.²⁶⁹ It is its approach to the two doctrines in cases involving visual works that earns it its placement among the circuits favoring an expansive application of the doctrines. In *Leigh v. Warner Brothers, Inc.* the court applied the merger and *scènes à faire* doctrines in its analysis of photographer Jack Leigh’s photographs of the Bird Girl statue in Bonaventure Cemetery in Savannah, Georgia that were allegedly copied for use in the promotion of the film, *Midnight in the Garden of Good and Evil*.²⁷⁰ The court pointed out several

²⁶⁴ *Id.*

²⁶⁵ *See id.* at 1113–14.

²⁶⁶ *See Country Kids ‘N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1288 (10th Cir. 1996).

²⁶⁷ *See id.*

²⁶⁸ *Id.* (quoting *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982), *superseded by rule in part*, Fed. R. Civ. P. 52(a), *as recognized in Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985)).

²⁶⁹ *See generally Palmer v. Braun*, 287 F.3d 1325 (11th Cir. 2002); *Herzog v. Castle Rock Entm’t.*, 193 F.3d 1241 (11th Cir. 1999).

²⁷⁰ *See* 212 F.3d 1210, 1213–15 (11th Cir. 2000).

obvious restrictions on the protectable content of Leigh's work, including the subject matter of the work (the statue itself) and the setting of the photograph in Bonaventure Cemetery as the appearance of the statute and the cemetery are facts and not copyrightable.²⁷¹ Further, the court stated that any connotations surrounding the statue as associated with the mood, themes of the novel, or its setting are ideas and thus unprotectable even though these associations may owe their origin to Leigh's original use of his photograph to illustrate the cover of the novel, *Midnight in the Garden of Good and Evil*.²⁷²

The Eleventh Circuit recognized the lighting, shading, timing, angle, and film choices as protected elements of Leigh's work.²⁷³ Leigh stressed that the court should also look at the combined effect of these separate elements as creating an eerie mood and suggesting the spirituality of the scene.²⁷⁴ The court disagreed, finding that "eerie moods" and "spiritual moods" were *scènes à faire* of cemeteries.²⁷⁵ The court did not stop to dwell on the incongruity of the finding that Leigh had copied a stock image of an eerie mood or a spiritual mood when he photographed the Bird Girl statue.²⁷⁶ The court was reluctant to allow the comparison of the total concept and especially the feeling evoked by the complete work for the same reason that Leigh was demanding such an evaluation: that the viewer would be attracted by the mood evoked by the photograph and would be unable to untangle the mood effects of the subject matter itself from the creative additions of Leigh.²⁷⁷ It approved of the lower court's dissection and evaluation of the similarities and dissimilarities of the Leigh photograph and the images of the Bird Girl that appear in the film and the court's grant of summary judgment to defendants on the film footage, but did not approve of the lower court's grant of summary judgment on the promotional still photographs created by defendants.²⁷⁸ The court found that

²⁷¹ *Id.* at 1214–15.

²⁷² *See id.* at 1214; *see also* Original Appalachian Artworks, Inc. v. Toy Loft, Inc., 684 F.2d 821, 829 n.11 (11th Cir. 1982) (idea of soft sculpture human-figure doll is not copyrightable).

²⁷³ *Leigh*, 212 F.3d at 1215.

²⁷⁴ *Id.*

²⁷⁵ *See id.*

²⁷⁶ *See id.*

²⁷⁷ *See id.*

²⁷⁸ *See id.* at 1215–16.

these photographs might be found by an average viewer to be substantially similar to Leigh's photographs, and thus reversed and remanded the case.²⁷⁹

7. Federal Circuit

The Federal Circuit is neutral on the application of the merger and *scènes à faire* doctrines because in a copyright claim, the Federal Circuit applies copyright law as interpreted by the regional circuit wherein the facts of the case arose.²⁸⁰ Thus, the Federal Circuit in *Amini Innovation Corp. v. Anthony California, Inc.* was happy to apply the Ninth Circuit's interpretation and application of the merger and *scènes à faire* doctrines as reflected in its substantial similarity tests.²⁸¹ The court reversed the trial court for having taken on the intrinsic similarity analysis of carved ornamental designs on woodwork without acknowledging the fact intensive nature of the analysis which made the case inappropriate for summary judgment on the intrinsic analysis part of the test.²⁸²

The United States Court of Federal Claims produced a remarkably expansive opinion applying the merger and *scènes à faire* doctrines to a work depicting a heart-shaped picture of Earth.²⁸³ The jurisdiction of the court was triggered because the artist, Meade, accused the United States Postal Service of copying his heart-shaped Earth design on a postage stamp.²⁸⁴ The court held that Meade's work was uncopyrightable under the merger doctrine because the entire depiction was an idea not an expression.²⁸⁵ Furthermore, any trivial variations added by the creative, original input of the artist, such as the color, placement, and appearance of the continents on the Earth picture, were dismissed as *scènes à faire* elements dictated by the requirements of any depiction of the scene.²⁸⁶ In what might be described as stunning incongruity, the court plainly stated that "[w]hile a heart-shaped picture of earth certainly can be considered an

²⁷⁹ See *id.* at 1216.

²⁸⁰ *Amini Innovation Corp. v. Anthony Cal., Inc.*, 439 F.3d 1365, 1368 (Fed. Cir. 2006); *Atari Games Corp. v. Nintendo of Am., Inc.*, 897 F.2d 1572, 1575 (Fed. Cir. 1990).

²⁸¹ See 439 F.3d at 1368.

²⁸² See *id.* at 1370.

²⁸³ See *Meade v. United States*, 27 Fed. Cl. 367, 369–72 (1992), *aff'd*, 5 F.3d 1503 (Fed. Cir. 1993) (unpublished table decision).

²⁸⁴ *Meade*, 27 Fed. Cl. at 370–72.

²⁸⁵ *Id.* at 371.

²⁸⁶ See *id.* at 372–73.

expression of a larger idea, such a picture is itself capable of being expressed in myriad ways, each varying depending on the selection and arrangement of continents, colors, words, and other details."²⁸⁷ Ignoring the maxim cited above, that when myriad variations of a scene are possible, a myriad of protectable copyrights can coexist,²⁸⁸ the court granted summary judgment for the defendant.²⁸⁹

B. Circuits Restricting the Application of the Merger and Scènes à Faire Doctrines in the Visual Media Context

The important difference between the circuits presented in this section and the circuits presented above is not in the comparison test they use, but rather in whether or not they have a mature and circumscribed understanding of the merger and *scènes à faire* doctrines in the context of visual works. The particular version of the substantial similarity test used is not nearly as important. A circuit that revels in physical dissection of works may still have a mature understanding of the limitations of the merger and *scènes à faire* doctrines with respect to visual works and will avoid the most blatant forms of chopping and dissection. A circuit that professes to preserve the total concept and feel of the work for an intrinsic similarity evaluation may still have an expansive view of the applicability of the merger and *scènes à faire* doctrines to visual works and will wind up taking the case away from the finder of fact at the extrinsic similarity stage, or through instructions given as part of a more discerning observer analysis, or after an intrinsic comparison because the court has determined that the only features copied are barred by merger or *scènes à faire* under an expansive reading of the two doctrines. Therefore, a mature understanding of the limits or nonapplicability of the two doctrines is essential to protecting the full potential of visual media from copying.

1. Second Circuit

The Second Circuit is as much to blame for the application of the merger and *scènes à faire* doctrines to visual works as it is for showing, of late, a great deal of restraint in the application of these doctrines in the comparison of visual works. It was the Second Circuit in *Nichols* that laid

²⁸⁷ *Id.* at 372.

²⁸⁸ See *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926).

²⁸⁹ *Meade*, 27 Fed. Cl. at 374.

out the philosophical justification for both the merger and the *scènes à faire* doctrines and the abstraction test.²⁹⁰ It was also the Second Circuit in *Altai* that added the filtration and comparison parts to the abstraction test in the context of computer programs, and in so doing, brought the *scènes à faire* doctrine to computerized visual works.²⁹¹

The lower courts of the circuit, particularly the Southern District of New York, have produced famously expansive opinions on the merger and *scènes à faire* doctrines.²⁹² The Second Circuit has happily applied the merger and *scènes à faire* doctrines to lifelike toys, such as dolls in humanoid form, and just as happily preserved the same types of dolls from the two doctrines when it suited it to do so.²⁹³

²⁹⁰ See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

²⁹¹ See *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 707–10 (2d Cir. 1992); see also *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 617 (7th Cir. 1982), superseded by rule in part, Fed. R. Civ. P. 52(a), as recognized in *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985) (maze framework of PAC-MAN is a standard game device and thus not copyrightable under doctrine of *scènes à faire*; only specific characters used in the game are protectable).

²⁹² See, e.g., *Earth Flag Ltd. v. Alamo Flag Co.*, 153 F. Supp. 2d 349, 353–58 (S.D.N.Y. 2001) (flag depicting photograph of the Earth has no original components that entitled it to copyright protection); *Past Pluto Prods. Corp. v. Dana*, 627 F. Supp. 1435, 1440–45 (S.D.N.Y. 1986) (no originality in foam hat designed to resemble the Statue of Liberty's crown).

²⁹³ See *Mattel, Inc. v. Azrak-Hamway Int'l, Inc.*, 724 F.2d 357, 360 (2d Cir. 1983) (“Though the dolls’ bodies are very similar, nearly all of the similarity can be attributed to the fact that both are artist’s renderings of the same unprotectable idea—a superhuman muscleman crouching in . . . a traditional fighting pose.”); *Eden Toys, Inc. v. Marshall Field & Co.*, 675 F.2d 498, 500–01 (2d Cir. 1982) (finding no infringement where both plaintiff and defendant produced stuffed snowmen of the same size with traditional snowman features); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 915–17 (2d Cir. 1980) (finding no infringement although dolls were mechanically identical and structurally similar, both were made of plastic and between three and four inches tall and there was similarity as to standard doll features; mechanical aspects of dolls were not copyrightable and “all dolls attempting to express the same idea will of necessity display at least some similarity”); *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022–23 (2d Cir. 1966) (many features of doll faces are standard and stereotypical); *Uneeda Doll Co. v. P & M Doll Co.*, 353 F.2d 788, 789 (2d Cir. 1965) (per curiam) (idea of doll in a display box with its arm around a red and white striped pole is not copyrightable); *Ideal Toy Corp. v. Kenner Prods. Div. of Gen. Mills Fun Group, Inc.*, 443 F. Supp. 291, 304 (S.D.N.Y. 1977) (“The defendants have no more right to a monopoly in the theme of a black-robed, helmeted, evil figure in outer-space conflict with a humanoid and a smaller non-humanoid robot than Shakespeare would have had in the theme of a ‘riotous knight who kept wassail to the discomfort of the household’ and who had conflicts with ‘a foppish steward who became amorous of his mistress.’” (citation omitted)); see also *Mattel, Inc. v. Goldberger Doll Mfg. Co.*, 365 F.3d 133, 135 (2d Cir. 2004) (“There are innumerable ways of making upturned noses, bow lips, and widely spaced eyes.”).

In *Mattel v. Goldberger Doll Manufacturing Co.*, the court recognized that there are an unlimited number of ways of combining standard features of dolls depicting youthful female faces.²⁹⁴ This means that any doll creator can use the same stock of features (bow lips, pert noses, large, widespread eyes) without limitation, but the doll creator cannot copy the creative and original arrangement of those features expressed in the work of another author. Barbie is Barbie because Mattel put together a winning combination of stock doll features in an attractive and original way.²⁹⁵ Mattel has no monopoly on pert noses, bow lips, or any other typical facial figures of dolls, but it does have a monopoly on its original combination of these stock features, which add up to the instantly recognizable face of a Barbie doll.²⁹⁶ A competitor must make its own combination because it cannot copy Mattel's.²⁹⁷

The merger doctrine does not apply to Mattel's doll image because doll creators are not limited in how to depict the face of a youthful female; the *scènes à faire* doctrine does not apply because there are unlimited combinations of stock features of dolls all of which may be separately copyrighted.²⁹⁸ In like manner, the Second Circuit recently held that the merger and *scènes à faire* doctrines do not apply to original combinations of common, unprotected elements of an on-line grocery shopping site²⁹⁹ or to original selections and arrangements of common articles in jewelry designs.³⁰⁰

The present law of the Second Circuit preserves works whose features are alleged to be subject to the merger and *scènes à faire* doctrines from exclusion in the subjective, intrinsic similarity portion of the substantial similarity evaluation.³⁰¹ More often than not, this will allow the finder of fact the opportunity to consider the substantiality of the similarity between the total work of the plaintiff compared to the total work of the

²⁹⁴ See *Goldberger Doll*, 365 F.3d at 135.

²⁹⁵ See *id.*

²⁹⁶ *Id.* at 136.

²⁹⁷ *Id.*

²⁹⁸ See *id.* at 135.

²⁹⁹ See *MyWebGrocer, LLC v. Hometown Info., Inc.*, 375 F.3d 190, 193–94 (2d Cir. 2004).

³⁰⁰ See *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 111–12 (2d Cir. 2001).

³⁰¹ See *Goldberger Doll*, 365 F.3d at 136–37; *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 133–34 (2d Cir. 2003); *Boisson v. Banian, Ltd.*, 273 F.3d 262, 268–72 (2d Cir. 2001).

defendant.³⁰² The Second Circuit's rationale for employing a "total concept and feel" test is "[that the test] functions as a reminder that, while the infringement analysis must begin by dissecting the copyrighted work into its component parts in order to clarify precisely what is not original, infringement analysis is not simply a matter of ascertaining similarity between components viewed in isolation."³⁰³

For example, in *Boisson*, the plaintiff claimed that the defendant copied two of her registered quilt designs.³⁰⁴ The court first looked to whether the plaintiff owned a valid copyright and determined that she did.³⁰⁵ Next, the court concluded that the defendant actually did copy plaintiff's work.³⁰⁶ But because pure copying does not establish infringement, the plaintiffs still must show "'substantial similarity' between defendants' quilts and the protectable elements of their own quilts."³⁰⁷ Although colors in general and the letters of the alphabet in particular are part of the public domain and the idea of using letters of the alphabet on a quilt was an unprotectable idea, the court held that the layout of the alphabet on plaintiff's quilt (the arrangement, shape, combination of colors, and overall design of how the letters would appear on the quilt) was protectable because it was an independent creation.³⁰⁸

Having found that plaintiff's quilts were copyrightable and that the defendant actually copied some of the elements of the quilt, the court went on to determine if the quilts were substantially similar.³⁰⁹ The court first looked to whether "the ordinary observer . . . would be disposed to overlook [the disparities], and regard their aesthetic appeal as the same."³¹⁰ In applying this test, the court applied a "total concept and feel" standard.³¹¹ Therefore, the court compared the defendant's and the plaintiff's quilts on

³⁰² See, e.g., *Goldberger Doll*, 365 F.3d at 135; *Tufenkian*, 338 F.3d at 133–34; *Boisson*, 273 F.3d at 272–73.

³⁰³ *Tufenkian*, 338 F.3d at 134.

³⁰⁴ *Boisson*, 273 F.3d at 265.

³⁰⁵ See *id.* at 267.

³⁰⁶ See *id.*

³⁰⁷ *Id.* at 268 (citation omitted).

³⁰⁸ See *id.* at 269–71.

³⁰⁹ See *id.* at 271–73.

³¹⁰ *Id.* at 272 (quoting *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 765 (2d Cir. 1991)).

³¹¹ See *id.*

the basis of arrangement and shapes of the letters, colors chosen, quilting patterns, and particular placement of icons.³¹²

The Second Circuit devised a solution to a problem raised by the facts of the case: Plaintiff Boisson admitted that some aspects of the quilts (the use of alphabet letters in large blocks, on a quilt) were copied from other sources.³¹³ Because some of the quilt was not original and, therefore, not protectable, the court then applied a “more discerning [observer] test” which is required when a plaintiff’s work is not wholly original but rather incorporates elements from the public domain.³¹⁴ The test is not used when there is no proof, admission, or concession in the case that plaintiff copied certain other works and incorporated them into the work in question.³¹⁵ For the “more discerning observer” test, the ordinary observer must view the work as a whole but with a more critical eye; it must discern substantial similarity while taking into account the court’s instructions that certain parts of the plaintiff’s work are not original and not to be considered.³¹⁶ The observer must find substantial similarity between only those elements that are copyrightable.³¹⁷ In *Boisson*, because the concept of using letters from the alphabet in large blocks on a quilt was taken from the public domain, the court determined that it had to apply a “more discerning ordinary observer test.”³¹⁸

The apparent difference between the dissection-filtration approach and the “more discerning observer” approach is that in the latter the observer still is to compare the works as a whole.³¹⁹ The observer must mentally note that if the only similarity noted is as to the unoriginal components instructed to the observer by the court (*e.g.*, in *Boisson*, if the only similarity noted was that the two quilts each featured letters of the alphabet in large blocks), then the observer is to return a finding of no substantial

³¹² *Id.* at 273.

³¹³ *Id.* at 269.

³¹⁴ *See id.* at 272; *see also* Key Publ’ns, Inc. v. Chinatown Today Publ’g Enters., Inc., 945 F.2d 509, 514 (2d Cir. 1991).

³¹⁵ *Boisson*, 273 F.3d at 272; *see also* Key Publ’ns, Inc., 945 F.2d at 514.

³¹⁶ *See Boisson*, 273 F.3d at 272.

³¹⁷ *See id.*

³¹⁸ *Id.*

³¹⁹ *Id.* (“[W]e have nevertheless always recognized that the [more discerning] test is guided by comparing the ‘total concept and feel’ of the contested works.” (citing Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996, 1003 (2d Cir. 1995))).

similarity.³²⁰ Under the dissection-filtration approach, the courts give the impression that the observer never is to see the unoriginal parts; in the case of a visual work, they might very well be erased, masked, cut, or whited out of the depiction. This approach makes it extremely difficult if not impossible to evaluate the concept and feel of the piece, let alone the total concept, look, and feel.

The important difference between the Second Circuit and other courts (particularly the circuits presented above) is not in the comparison test it uses but rather in its thoughtful and circumscribed understanding of the merger and *scènes à faire* doctrines in the context of visual works. The test used is not nearly as important. A circuit that revels in physical dissection of works may still have an understanding of the limitations of the merger and *scènes à faire* doctrines with respect to visual works and will avoid the most blatant forms of chopping and dissection. A circuit that professes to preserve the total concept and feel of the work for an intrinsic similarity evaluation may still have an expansive view of the applicability of the merger and *scènes à faire* doctrines to visual works and will wind up taking the case away from the finder of fact at the extrinsic similarity stage, or through instructions given as part of a “more discerning observer” analysis, or after an intrinsic comparison because the court has determined that the only features copied are barred by merger or *scènes à faire* under an expansive reading of the two doctrines. Therefore, an understanding of the limits or nonapplicability of the two doctrines is essential to protecting the full potential of visual media from copying.

In *Boisson*, the use of letters and the placement of letters in large blocks were not original but the arrangement, shape, color, and design of the letters used and all of the non-alphabetical design elements were original.³²¹ The court did not filter out the alphabet letters from consideration because to do so would deny the plaintiff recognition and protection for the original and creative arrangement, shape, color, and design of the letters used. After a comparison of the several quilts at issue in the case, the Second Circuit

³²⁰ *Id.*

³²¹ *Id.* at 273–74. See also *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 129–30, 134–35 (2d Cir. 2003) (stating that certain elements of plaintiff’s rugs admittedly were copied from public domain sources, but the arrangement, combination, and manipulation of those elements were original; the observer was to consider the rugs as a whole bearing in mind that substantial similarity cannot be attributed solely to a common, non-original element).

concluded that some of the defendants' quilts were substantially similar to plaintiff's and some were not.³²²

2. Third Circuit

Franklin Mint Corp. v. National Wildlife Art Exchange, Inc. is a landmark Third Circuit opinion on the idea-expression dichotomy.³²³ The court considered the situation of a wildlife artist who transferred the copyright to a painting of a male and female cardinal, and later painted another work embodying the same subject matter.³²⁴ The copyright owner of the first painting alleged infringement.³²⁵ The court traveled the path of the law, finding that although the subject matter or theme of the works was an unprotectable idea, the embodiment of the idea of a naturalistic painting of two cardinals in the two works was separately protectable.³²⁶ Far from denying that the first work did not have copyright protection because it featured an accurate and realistic rendition of factual subject matter from the real world (the nature and appearance of cardinals), the court focused instead on whether the second work was substantially similar to the first work.³²⁷ The court never discussed the merger doctrine or *scènes à faire* doctrine even though the opportunity was staring it in the face—the idea of an actual cardinal might be held to merge with every realistic depiction of the bird, thus rendering every painting of the bird to be uncopyrightable. On the other hand, the *scènes à faire* doctrine might have been held to dispel the plaintiff's claim because any realistic depiction of an actual bird might very well have been held to be the kind of stock image or natural theme that must be done in order to depict the bird, and thus be held uncopyrightable.³²⁸ Regardless of the two doctrines, the Third Circuit

³²² *Boisson*, 273 F.3d at 274–75.

³²³ 575 F.2d 62, 67 (3d Cir. 1978).

³²⁴ *Id.* at 63–64.

³²⁵ *Id.* at 63.

³²⁶ *Id.* at 64–65.

³²⁷ *Id.* at 65–66.

³²⁸ *Cf.* *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 908–09 (3d Cir. 1975). The court passed up the opportunity to apply the merger doctrine or *scènes à faire* doctrine in an earlier case involving charts designed to illustrate weight-lifting techniques. *See id.* Instead of stripping the first chart of its design elements because they are merged with concepts relating to weight-lifting or embody a *scène à faire* relating the use of weight machines, the court simply evaluated the two works side-by-side for comparison of similarity. *See id.* The court stated: “[W]ith respect to commercial documents . . . the similarity probably must be more extensive than

approved of the submission of the two works to the finder of fact for analysis of substantial similarity, and on appeal the court carefully weighed the two works side by side and found an absence of similarity in several notable features of the two works, supporting the findings below.³²⁹ The Third Circuit concluded that it is perfectly acceptable for an artist to create a “variation on a theme” of an earlier work without copying it even if the two works do have obvious similarities because they depict the same subject matter and are by the hand of the same artist.³³⁰

Parts of *Franklin Mint Corp.* are still evident in Third Circuit jurisprudence. In *Southco, Inc. v. Kanebridge Corp.*,³³¹ then Circuit Judge Alito, writing for the Third Circuit sitting *en banc*, embraced the doctrine of originality as established in *Feist*³³² and *Sarony*.³³³ The Third Circuit endorsed the doctrine that a mechanical process such as photography that captures a slice of reality nonetheless reveals artistic creativity and originality.³³⁴ The court recognized that the subject matter of photography may be the real world objects and places (unprotectable facts) but the artist captures and creates an original embodiment in the form of an original work of photographic art (protectable expression).³³⁵

The Third Circuit determined that a screw fastener manufacturer had not achieved the requisite level of originality in the mechanical application of a numbering system for its products.³³⁶ The assignment of numbers was based on a scheme or process invented by Southco, but like other processes and methods of operation, it was held to be uncopyrightable under 17 U.S.C. § 102(b).³³⁷

Circuit Judge Roth, in dissent, reminded the court that where “the same idea can be expressed in a plurality of totally different manners, a plurality

in the case of more artistic works in order to justify a finding of substantial similarity.” *Id.* at 908 (quoting 1 M. NIMMER, NIMMER ON COPYRIGHT § 143.2 (1973)).

³²⁹ See *Franklin Mint Corp.*, 575 F.2d at 66.

³³⁰ See *id.*

³³¹ 390 F.3d 276, 281–84 (3d Cir. 2004) (*en banc*), *cert. denied*, 126 S. Ct. 336 (2005).

³³² *Id.* at 281 (discussing *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358–63 (1991)).

³³³ *Id.* at 283–84 (discussing *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58–59 (1884)).

³³⁴ See *id.* at 284.

³³⁵ See *id.*

³³⁶ *Id.* at 281.

³³⁷ *Id.* at 284–85.

of copyrights may result.”³³⁸ Later in the dissent, Judge Roth stated: “While facts may not be copyrighted, original selections and arrangements of facts are entitled to protection. Thus, with respect to the selection and arrangement of non-copyrightable facts, ‘it is almost inevitable that the original contributions of the compilers will consist of *ideas*.’”³³⁹ In these circumstances, Circuit Judge Roth points out, the merger doctrine should not prevent the recognition of copyright for original combinations and arrangements of unprotectable elements.³⁴⁰

Although the majority and the dissent in *Southco* seemed to be walking the same path for a great distance, the ultimate disagreement on the application of *Feist*’s originality principles reveals the trouble courts have in recognizing the originality and copyrightability of original creations that incorporate or compile subject matter that is arguably uncopyrightable as ideas, processes and procedures, or stock themes and images.³⁴¹ The confusion became most obvious in other circuits in the case of copyrightability of computer programs. The Third Circuit was one of the pioneers of the application of originality principles to this troublesome area, and like some pioneers, it had trouble staying on course.³⁴²

In *Whelan* the Third Circuit held that the non-literal structure of a computer program represented expression, rather than an idea, and was entitled to copyright protection.³⁴³ Non-literal is a term used in reference to the so-called “literal” parts of programs—the source code and object

³³⁸ *Id.* at 293 n.11 (Roth, J., dissenting) (quoting *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983)).

³³⁹ *Id.* at 297 (quoting *CCC Info. Servs., Inc. v. MacLean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 70 (2d Cir. 1994)) (citations omitted) (emphasis in original).

³⁴⁰ *Id.* at 293 n.11, 297.

³⁴¹ *Id.* at 281–82, 297.

³⁴² See generally, *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222 (3d Cir. 1986).

³⁴³ *Id.* at 1239. *Whelan* has been roundly criticized for its ultimate interpretation of the idea-expression dichotomy—that everything nonessential to a computer program’s function may be interpreted as “expression” and not the “idea” of the program. See, e.g., *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 840, 844 (10th Cir. 1993); *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1525 (9th Cir. 1992); *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 705 (2d Cir. 1992); *Plains Cotton Coop. Ass’n v. Goodpasture Computer Serv., Inc.*, 807 F.2d 1256, 1262 (5th Cir. 1987). I cite *Whelan* for its historical role in developing the abstraction-filtration test as a method of separating unprotectable elements from protectable elements in copyrightable works, not as a precedent on proper interpretation of the idea-expression dichotomy or the abstraction-filtration test.

code—that is coded by a programmer and thus is verbal in nature (alphanumeric) in that it contains arabic numbers and sometimes letters and actual words (although object code has heretofore been limited to a sequence of 1's and 0's functioning as “on” and “off” commands to the machine).³⁴⁴ The non-literal parts are the design elements or applications (the opinion discussed them as algorithms, subroutines, and modules) which the programmer wished to achieve when she puts together the code.³⁴⁵ This allows comparison of the audiovisual output and other user applications of the program.³⁴⁶

The Third Circuit recognized that the *scènes à faire* doctrine or merger doctrine might come into play with computer programs as literary works.³⁴⁷ The court has limited the doctrine in two important respects. First, the doctrine is to be applied from the perspective of the creator of the work, not the plagiarist.³⁴⁸ In other words, if the creator of the computer program was limited in her design choices by the requirements or limitations of the programming language (there are a limited number of ways to get a task accomplished using the programming language), or the machinery (there are a limited number of variations that will run properly on the computer hardware the program is being designed to run on), or by standard operating procedures for computer programming (sound programming policies dictate certain programming choices), then these limitations may affect how original the choices were that were made by the programmer.³⁴⁹ Choices dictated by the language, the machinery, or by standard procedures are not original to the programmer and thus not copyrightable by the programmer.³⁵⁰ The difference is that *only* choices dictated by the constraints of the programming language or the machinery or standard procedures would be subject to attack by the plagiarist who would bear the burden of proving that elements were not original; the doctrine does not reward the choice of the plagiarist to copy the original program under a

³⁴⁴ *Whelan*, 797 F.2d at 1230–31, 1233.

³⁴⁵ *Id.* at 1229–30.

³⁴⁶ *Id.* at 1230–33.

³⁴⁷ *See Dun & Bradstreet Software Servs., Inc. v. Grace Consulting, Inc.*, 307 F.3d 197, 214–15 (3d Cir. 2002).

³⁴⁸ *Id.* at 215.

³⁴⁹ *Id.* at 214–15.

³⁵⁰ *See id.*

belief that most of the program must have been dictated by the programming language or the machinery or standard procedures.³⁵¹

The Third Circuit's approach to merger is restrictive, particularly with regard to visual works. In *Kay Berry, Inc. v. Taylor Gifts, Inc.*, the court evaluated allegations of merged idea and expression in the context of a cement-cast outdoor garden sculpture.³⁵² The Kay Berry, Inc. sculptures were designed to look like rocks or stones but included a flat area with an inscription molded onto the sculpture.³⁵³ The sculpture at issue in the litigation bore a public domain poem, but the lettering and arrangement of the words showed design choices regarding the font and grouping of the lines.³⁵⁴ In *Kay Berry*, a competitor, Taylor, came out with a similar sculpture in the same size, rectangular shape, stone-like appearance, with the same poem arranged in the same style of font and word grouping.³⁵⁵ To defend its version of the sculpture, Taylor claimed that Kay Berry's sculpture was uncopyrightable under the merger doctrine.³⁵⁶

The Third Circuit stated: "Merger is rare . . . and is generally found in works with a utilitarian function. This Court has never found an instance in which a completely aesthetic expression merged into an idea."³⁵⁷ The court further stated that "[a] sculptural work's creativity derives from the combination of texture, color, size, and shape, as well as the particular verse inscribed and the way the verse is presented."³⁵⁸

The court did not strip the sculpture of its characteristics under a theory of merger or *scènes à faire*. Instead the court stated:

It means nothing that these elements may not be individually entitled to protection; "all creative works draw on the common wellspring that is the public domain. In

³⁵¹ See *id.* at 215–16.

³⁵² See 421 F.3d 199, 202 (3d Cir. 2005).

³⁵³ *Id.*

³⁵⁴ *Id.*

³⁵⁵ *Id.*

³⁵⁶ See *id.* at 207–08. The allegation easily could have been made under the *scènes à faire* doctrine in that representations of natural objects are often held to be the kind of stock images that are alleged to be uncopyrightable under the doctrine. See, e.g., *Satava v. Lowry*, 323 F.3d 805, 810 n.3 (9th Cir. 2003).

³⁵⁷ *Kay Berry*, 421 F.3d at 209. (citing *Educ. Testing Servs. v. Katzman*, 793 F.2d 533, 539 (3d Cir. 1986); *Brown Instrument Co. v. Warner*, 161 F.2d 910 (D.C. Cir. 1947); *M.M. Bus. Forms Corp. v. Uarco, Inc.* 472 F.2d 1137 (6th Cir. 1973)).

³⁵⁸ *Kay Berry*, 421 F.3d at 207.

this pool are not only elemental ‘raw materials,’ like colors, letters, descriptive facts, and the catalogue of standard geometric forms, but also earlier works of art that, due to the passage of time or for other reasons, are no longer copyright protected.”³⁵⁹

The court continued: “When an author combines these elements and adds his or her own imaginative spark, creation occurs, and the author is entitled to protection for the result.”³⁶⁰ The court directly analogized the situation with Kay Berry’s sculpture to two situations: that of a magazine cover design and to three-dimensional costume nose masks.³⁶¹ With regard to the former, the Third Circuit stated that “although no element of [a] magazine cover—ordinary lines, typefaces, and colors—is entitled to copyright protection, the distinctive arrangement is entitled to protection as a graphic work.”³⁶² With regard to the latter, the court found that sculptural renderings of animal noses were original, copyrightable creations even though they embodied realistic elements of actual living creatures and anyone setting out to make a realistic sculpture of an animal nose would be bound to turn to the same source material: actual animals.³⁶³ The court stated:

By holding that Masquerade’s nose masks are copyrightable, we do not intimate that [Masquerade] has the exclusive right to make nose masks representing pig, elephant and parrot noses. On remand, it will be Masquerade’s burden to show that Unique’s nose masks incorporate copies, in the copyright law sense, of Masquerade’s sculptures, rather than sculptures that derive their similarity to Masquerade’s sculptures merely from the commonality of the animal subjects both represent.³⁶⁴

³⁵⁹ *Id.* (citing *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 132 (2d Cir. 2003)).

³⁶⁰ *Id.* (citing *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991)).

³⁶¹ *Id.* at 207, 209.

³⁶² *Id.* at 207 (citing *Reader’s Digest Ass’n, Inc. v. Conservative Digest, Inc.*, 821 F.2d 800, 806 (D.C. Cir. 1987)).

³⁶³ *See id.* at 209 (discussing *Masquerade Novelty, Inc. v. Unique Indus., Inc.* 912 F.2d 663, 666, 671–72 (3d Cir. 1990)).

³⁶⁴ *Id.* (citing *Masquerade Novelty*, 912 F.2d at 671–72).

The difference is that the court will not strip the sculptures down to nothing by subtracting out individual parts or characteristics embodied in the works that relate to the idea of real objects or creatures, and subsequently take the case away from the finder of fact on summary judgment or judgment as a matter of law or directed verdict because the majority of parts or characteristics embodied in the work do relate to real world objects.³⁶⁵ Instead, the Third Circuit will allow the plaintiff to prove and the finder of fact to consider whether, “as a whole,”³⁶⁶ the unique expression of the first creator’s combination and arrangement of the elements has been copied or whether the similarities between the works are solely attributable to the two works’ unavoidable expression of the non-copyrightable and non-original innate characteristics of real world objects.³⁶⁷

3. Fourth Circuit

The Fourth Circuit’s law on merger and *scènes à faire* is comparatively undeveloped. That is to say, research does not reveal an opinion of the court discussing these two doctrines by name; however, the underlying concepts of each doctrine (originality, idea-expression dichotomy) have been analyzed in Fourth Circuit cases,³⁶⁸ and to the extent a pattern emerges it is in favor of a circumscribed application of the merger and *scènes à faire* doctrines with regard to visual works.³⁶⁹

Evidence of the rejection of an expansive approach to the merger and *scènes à faire* doctrines is seen, perhaps ironically, in *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, a case involving

³⁶⁵ *Id.* at 208–10.

³⁶⁶ “As a whole” refers to the total concept and feel test which is accepted and applied in the Third Circuit. *See, e.g.*, *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1234 (3d Cir. 1986); *Damiano v. Sony Music Entm’t, Inc.*, 975 F. Supp. 623, 631 (D.N.J. 1996).

³⁶⁷ *Kay Berry*, 421 F.3d at 208.

³⁶⁸ *E.g.*, *United States ex rel. Berge v. Bd. of Trs. of the Univ. of Ala.*, 104 F.3d 1453, 1465 (4th Cir. 1997); *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 492 (4th Cir. 1996); *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 436 (4th Cir. 1986).

³⁶⁹ *E.g.*, *Towler v. Sayles*, 76 F.3d 579, 584 (4th Cir. 1996) (using a total concept and feel evaluation in testing the similarity of two motion picture treatments); *Dawson v. Hinshaw Music Inc.*, 905 F.2d 731, 733–34 (4th Cir. 1990) (discussing the use of the ordinary observer’s evaluation of total concept and feel as part of the intrinsic similarity test). *See also* *Comins v. Discovery Commc’ns, Inc.*, 200 F. Supp. 2d 512, 521 (D. Md. 2002) (applying a total concept and feel evaluation in comparing two films).

taxidermy models.³⁷⁰ The court evaluated the originality of models formed in part from actual carcasses of animals.³⁷¹ The representation of actual living creatures, particularly in three-dimensional forms with lifelike size and postures, presents a classic situation to interpret the meaning of the idea-expression dichotomy and the breadth of the merger and *scènes à faire* doctrine whether or not these doctrines are discussed by name. The Ninth Circuit, following *Satava*, would make short work of this issue: There is practically no way that an artist can make a lifelike representation of a living creature and hope to defend it from a plagiarist who copies the work and subsequently produces a lifelike representation of the same creature.³⁷²

The Fourth Circuit did not take the bait. The court did not dissect the creature into its parts—the result of this process inevitably would be to find an overwhelming number of features that are common to animals in real life as well as to the plagiarist’s work.³⁷³ Therefore, they might be stricken from consideration at any stage of the evaluation, and the court should deny plaintiffs’ preliminary injunctions and grant summary judgment or judgment as a matter of law in favor of the defendants, as the court indicated in *Satava*.³⁷⁴ Instead, the Fourth Circuit emphasized that even with lifelike representations, the representation of the animal contains artistic choices and creative input that exceeds the simple idea of the animal itself: “Several sculptors may copy a deer, even the same deer, in creating a sculpture, and each may obtain copyright protection for his or her own expression of the original. Such individual creative efforts inevitably possess some degree of originality.”³⁷⁵ The animal’s body is the fact, the idea of the equation; the artist’s work is the portrayal, the expression of the idea.³⁷⁶ And a portrayal as with other expressions of ideas is protectable under copyright.³⁷⁷

³⁷⁰ 74 F.3d 488 (4th Cir. 1996).

³⁷¹ *Id.* at 492–95.

³⁷² *Satava v. Lowry*, 323 F.3d 805, 811–13 (9th Cir. 2003).

³⁷³ *Id.* at 812–13.

³⁷⁴ *See Superior Form Builders, Inc.*, 74 F.3d 488, 492 (4th Cir. 1996).

³⁷⁵ *Id.* (citing *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503 (9th Cir. 1987)).

³⁷⁶ *See id.* at 492, 494.

³⁷⁷ *Id.* at 494–495.

4. Seventh Circuit

The Seventh Circuit has avoided the path of applying the doctrines of merger and *scènes à faire* through a dissection method.³⁷⁸ It also has not adopted the abstraction-filtration test.³⁷⁹ The court has made a more thoughtful application of the two doctrines than many circuits.

The circuit's rejection of the dissection method and its limited application of the merger and *scènes à faire* doctrines started fairly early in, of all things, a computer program case. In *Atari, Inc. v. North American Philips Consumer Electronics Corp.*, the court examined the idea-expression dichotomy in the context of video games to determine which elements of the Pac-Man video game were expression, subject to protection, rather than ideas which are in the public domain.³⁸⁰ The court rejected the dissection of the subject matter into copyrighted and unprotected elements in favor of examining the "total concept and feel" of the copyrighted work.³⁸¹ The court cautioned that while such dissection was not appropriate, the substantial similarity inquiry "must take into account that the copyright laws preclude appropriation of only those elements of the work that are protected by the copyright."³⁸² The reason dissection is inappropriate is that the substantial similarity inquiry is conducted from the perspective of the "ordinary observer, [who] unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same."³⁸³ In other words, an ordinary observer is going to compare the two works in their entirety for both similarities and differences, rather than compare an incomplete, dissected version of the original work to the allegedly infringing work. The Seventh Circuit therefore applies a "total concept and feel" analysis test which "does not

³⁷⁸ See e.g., *Gentieu v. Tony Stone Images/Chicago, Inc.* 255 F. Supp. 2d 838, 848 (N.D. Ill. 2003) (citing *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 615 (7th Cir. 1982), *superseded by rule in part*, Fed. R. Civ. P. 52(a), *as recognized in Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985)).

³⁷⁹ See *Nash v CBS, Inc.*, 899 F.2d 1537, 1540 (7th Cir. 1990) (rejecting the abstraction-filtration test).

³⁸⁰ 672 F.2d 607 (7th Cir. 1982), *superseded by rule in part*, Fed. R. Civ. P. 52(a), *as recognized in Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985) (altering only the standard of review).

³⁸¹ *Id.* at 614.

³⁸² *Id.*

³⁸³ *Id.* (quoting *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960)).

involve ‘analytic dissection and expert testimony,’³⁸⁴ but depends on whether the accused work has captured the ‘total concept and feel’ of the copyrighted work.”³⁸⁵

The total concept and feel test (sometimes phrased as the total look and feel test) does not ignore unprotected elements. The Seventh Circuit admits that, “[i]t is an axiom of copyright law that the protection granted to a copyrightable work extends only to the particular expression of an idea and never to the idea itself.”³⁸⁶ Thus, “if the only similarity between plaintiff’s and defendant’s works is that of the abstract idea, there is an absence of substantial similarity and hence no infringement results.”³⁸⁷ The court stated: “When the alleged infringing work is not a duplicate of the copyrighted work, a determination of whether protected elements have been taken requires a close analysis of the differences and similarities between the two works.”³⁸⁸ In other words, a defendant still will be able to defend the charge of infringement by pointing out that the only factors of similarity are unprotectable factors.

The difference in approach is obvious in cases involving creative visual media. The “no dissection-total concept and feel” test was applied to greeting cards in *Roulo v. Russ Berrie & Co.*,³⁸⁹ to three-dimensional stuffed animal heads and tails affixed to duffle bags in *Wildlife Express Corp. v. Carol Wright Sales, Inc.*,³⁹⁰ and to a doll’s head and facial design in *Susan Wakeen Doll Co. v. Ashton-Drake Galleries*.³⁹¹ The difference is that the finder of fact (or the court, at the motion stage) is predisposed to evaluating similarities between the original and the allegedly infringing work, not to eliminate elements of the original work before attempting to compare the works. In this manner, obvious similarities between the complete original and the alleged copy will stand out. For example, in *Roulo*, the court might have looked at the copied elements of the plaintiff’s greeting card (striping, font, paper color, font color, size of the card, single-

³⁸⁴ *Id.* (citing *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946)).

³⁸⁵ *Id.* (citing *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970)).

³⁸⁶ *Id.* at 615 (quoting *Reyher v. Children’s Television Workshop*, 533 F.2d 87, 90 (2d Cir. 1976)).

³⁸⁷ *Id.* (citing 3 M. NIMMER, NIMMER ON COPYRIGHT § 13.03(A)(1) (1981)).

³⁸⁸ *Id.* at 614 n.6 (quoting EDMUND W. KITCH & HARVEY S. PERLMAN, LEGAL REGULATION OF THE COMPETITIVE PROCESS 665 (2d ed. 1979)).

³⁸⁹ 886 F.2d 931, 939 (7th Cir. 1989).

³⁹⁰ 18 F.3d 502, 510–11 (7th Cir. 1994).

³⁹¹ 272 F.3d 441, 451 (7th Cir. 2001).

sided format) as unoriginal stock and trade of the greeting card genre and eliminated them from consideration. Instead, the court noted, “While it is true that these elements are not individually capable of protection, just as individual words do not deserve copyright protection, it is the unique combination of these common elements which form the copyrighted material.”³⁹² Under the total concept and feel evaluation, the court found:

[Defendant Berrie’s] TY cards not only used the same unprotectable elements as [plaintiff’s] FS cards, but also used them in a format nearly identical to that used by the FS cards. It cannot be disputed that Berrie could have produced a non-infringing card with colored stripes, but Berrie used similar stripes flanking the verse on both the left and right side from top to bottom just as the FS cards did. The color of paper is unprotected, yet the TY cards are printed on a nearly identical beige paper. The use of cursive writing is also a common element as well as the brown ink used, yet TY cards, out of the entire range of colors and handwritings available, chose brown ink and a similar cursive writing. The minute differences which Berrie painstakingly incorporated to prevent a mirror image copy of FS cards are insignificant in light of the nearly identical composition and appearance used in both card lines.³⁹³

The same is true for the animal heads and tails in *Wildlife Export*,³⁹⁴ the doll head and facial design in *Susan Wakeen*,³⁹⁵ the flatulence-producing

³⁹² *Roulo*, 886 F.2d at 939.

³⁹³ *Id.* at 940.

³⁹⁴ 18 F.3d at 510–11. The court stated that:

Upon consideration of the overall look and character of the duffle bags, or their ‘total concept and feel,’ . . . we see a remarkable resemblance between *Wildlife*’s and Carol Wright’s works. They are very similar in size, shape, pose, and feel. We note some dissimilarities in the color and type of plush fur, the animals’ eyes and noses; the trunk and the ears of the elephants also differ slightly. However, such variations are, no doubt to some extent, factors of the products available to each company and perhaps of slight adaptations in the patterns. These differences are of minor importance in the overall artistic expression of the entire animal faces and tails under review, and, consequently, they do not preclude a finding of infringement under the ordinary observer test.

Id.

³⁹⁵ 272 F.3d at 451–52.

“pull my finger” toy in *JCW Investments, Inc. v. Novelty, Inc.*,³⁹⁶ and the picture frames in *Stanislawski v. Jordan*.³⁹⁷

The “no dissection-total concept and feel” test limits the power of the merger doctrine and *scènes à faire* doctrine in other copyright originality situations.³⁹⁸ Even in *Bucklew v. Hawkins, Ash, Baptie & Co.*, a case presenting a pure *Baker v. Selden* situation involving a computer program, the Seventh Circuit panel did not set out on a path to eliminate elements; instead, the court applied the merger and *scènes à faire* doctrines in a more circumscribed way.³⁹⁹ The alleged plagiarist in *Bucklew* claimed that a program designed to collect and report HUD data in a tabular format was uncopyrightable under either the merger or the *scènes à faire* doctrines.⁴⁰⁰ The court recognized the functional nature of the computer program, but pointed out that:

If Bucklew [the original author] were claiming copyright in the tabular presentation of the summary data required by HUD, this case would be governed by *Baker v. Selden*. But he is not. He is claiming copyright in tables configured in an optional way, tables that are the product of format choices that are not unavoidable, for which indeed there were an immense number of alternative combinations any one of which HAB [the plagiarist] was free to use in lieu of Bucklew’s.⁴⁰¹

With regard to the *scènes à faire* doctrine, the court further explained:

Every expressive work can be decomposed into elements not themselves copyrightable—the cars in a car chase, the kiss in a love scene, the dive bombers in a movie about Pearl Harbor, or for that matter the letters of the alphabet in any written work. The presence of such elements obviously does not forfeit copyright protection of the work as a whole, but infringement cannot be found on the basis of such elements alone; it is the combination of elements, or

³⁹⁶ 289 F. Supp. 2d 1023, 1039 (N.D. Ill. 2003).

³⁹⁷ 337 F. Supp. 2d 1103, 1115 (E.D. Wis. 2004).

³⁹⁸ See, e.g., *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 929–30 (7th Cir. 2003).

³⁹⁹ *Id.* at 929.

⁴⁰⁰ *Id.* at 928.

⁴⁰¹ *Id.* at 928.

particular novel twists given to them, that supply the minimal originality required for copyright protection.⁴⁰²

Ultimately, the court preserved the work from the attack of the merger and *scènes à faire* doctrines, stating:

[Merged and *scènes à faire* elements] are at the opposite extreme from the arbitrary details, such as the pattern of boldfacing in Bucklew's form 52566, that contribute such originality as a new expressive work may have. The format choices that Bucklew made were not generic. It is not as if everyone who writes programs of this sort uses Swiss font or displays an output range or uses a particular pattern of boldfacing.⁴⁰³

The pattern of boldfacing, choice of font, and inclusion of a superfluous output range found in both works were held instead to be evidence of direct copying of Bucklew's work by HAB.⁴⁰⁴

In *Gaiman v. McFarlane*, the court again evaluated the merger and *scènes à faire* doctrines, this time in the unusual posture of cartoon artist Todd McFarlane's claim that his own works were not original enough to be copyrighted in order to escape the charge of plaintiff-appellant Neil Gaiman that he was the co-author of a copyrightable work by McFarlane.⁴⁰⁵ In the analysis, the court indicated that under the merger and *scènes à faire* doctrines, there is a "difference between literary and graphic expression."⁴⁰⁶ A medieval knight might be a stock character and the typical verbal description of a medieval knight in armor carrying a shield may be a public domain concept, but the rendering of such a knight in a graphic medium certainly produces a copyrightable work.⁴⁰⁷ There is no standard public domain image of a knight that must be copied by original creator and plagiarist alike in order to communicate the graphic expression of the concept of a medieval knight.⁴⁰⁸

⁴⁰² *Id.* at 929.

⁴⁰³ *Id.* at 929–30.

⁴⁰⁴ *See id.* at 927–30.

⁴⁰⁵ 360 F.3d 644, 648 (7th Cir. 2004).

⁴⁰⁶ *Id.* at 660.

⁴⁰⁷ *See id.* at 661.

⁴⁰⁸ *See id.* at 660–61.

Nevertheless, vigilant repetition of the creed of “no dissection” is necessary to avoid backsliding because the temptation always is present. A recent opinion of the Seventh Circuit indicates the length of time that passed since *Atari v. North American Philips*, and in the analysis of video games the court no longer seems enamored of the “total concept and feel” of the genre.⁴⁰⁹ In *Incredible Technologies*, the Seventh Circuit panel appeared eager to cancel out merger and *scènes à faire* elements from a computer golf simulation program.⁴¹⁰ Ignoring the plain and abundant evidence of actual copying in the case wherein the plagiarist admitted that its goal was to create a golf simulation game so similar to the plaintiff’s game that it could be played without any substantial learning curve, the court instead set off on a course to see how much of the original game it could eliminate from the protection of copyright by application of the merger and *scènes à faire* doctrines.⁴¹¹ With regard to design elements, even visual elements, the court was unimpressed with Incredible Technologies’ (IT) visualization of a game of golf recreated through digitalized visual media.⁴¹² “Even if there are multiple methods by which an operation can be performed, a plaintiff’s choice of a particular method of operation is not eligible for protection.”⁴¹³ The court accepted all of the plagiarist’s suggestions that:

[M]any elements of the video display were common to the game of golf. For instance, the wind meter and club selection features were found to account for variables in real golf and so were indispensable to an accurate video representation of the game. Furthermore, the court said that the game selection features, such as the menu screens which indicate the number of players and other variables of the game, are common to the video-game format.⁴¹⁴

The court failed to recognize that while elements of golf such as club selection may be part of any golf game, the particular embodiment of that concept can be protected from direct copying.⁴¹⁵ It was simpler for the

⁴⁰⁹ See generally *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 400 F.3d 1007 (7th Cir. 2005).

⁴¹⁰ *Id.* at 1010–1012, 1014–1015.

⁴¹¹ *Id.*

⁴¹² *Id.* at 1012.

⁴¹³ *Id.* at 1012 (citing *Lotus Dev. Corp. v. Borland Int’l, Inc.*, 49 F.3d 807 (1st Cir. 1995)).

⁴¹⁴ *Id.* at 1014.

⁴¹⁵ *Id.* at 1015 (discussing the lack of protection for video game presentation of standard

court to avoid aesthetic comparisons of the two games and avoid having to instruct the jury on making aesthetic comparisons of the games under the guise of an application of the merger and *scènes à faire* doctrines.⁴¹⁶

5. Eighth Circuit

The United States Court of Appeals for the Eighth Circuit has a firm grip on the merger and *scènes à faire* doctrines.⁴¹⁷ Dissection is not allowed to prevent the ordinary observer from evaluating the total concept and look and feel of the complete works of the original creator and of the alleged plagiarist.⁴¹⁸

Perhaps the simplest way to characterize the Eighth Circuit test is to consider that the court does not eliminate the possibility of merger and *scènes à faire* elements just as the court does not reject the originality requirement and the idea-expression dichotomy codified in 17 U.S.C. § 102(b) and discussed in *Feist*.⁴¹⁹ Rather, the court treats the two step extrinsic similarity and intrinsic similarity test as being a two-part test with two independent steps, not a test in which one step (intrinsic) is dependent on a favorable finding on the other step (extrinsic).⁴²⁰ They are steps of a test, not elements of a claim or defense. An allegation of merged elements or the presence of *scènes à faire* elements in the first test will not prevent the court from allowing the finder of fact to consider the second test unless a reasonable ordinary observer could find no similarity in the total concept and look and feel of the two works in the intrinsic analysis, and the only alleged similarity is in common stock elements or a common idea or theme behind the works in the extrinsic analysis.⁴²¹

elements of golf).

⁴¹⁶*Id.* at 1011 (questioning the usefulness of the “ordinary observer” test as a lay person might not appreciate the idea-expression dichotomy).

⁴¹⁷*See* Taylor Corp. v. Four Seasons Greetings, LLC, 315 F.3d 1039, 1043 (8th Cir. 2003); Hartman v. Hallmark Cards, Inc., 833 F.2d 117, 120–21 (8th Cir. 1987); Hoch v. Mastercard Int’l Inc., 284 F. Supp. 2d 1217, 1223 (D. Minn. 2003).

⁴¹⁸*E.g.*, Hartman, 833 F.2d at 120 (analytical dissection is not called for under the second step in which the response of the ordinary, reasonable person measures the expression).

⁴¹⁹*Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350 (1991). *See also* Taylor, 315 F.3d at 1042–43 (discussing idea-expression dichotomy and applicability of the merger and *scènes à faire* doctrines); Hartman, 833 F.2d at 120–21; Hoch, 284 F. Supp. at 1222–23.

⁴²⁰*See, e.g.*, Hartman, 833 F.2d at 120.

⁴²¹*E.g.*, Hoch, 284 F. Supp. at 1222–23 (noting that summary judgment was appropriate because no ordinary observer would think total concept and feel of documentary to save

The doctrines of merger and *scènes à faire* are circumscribed in the Eighth Circuit, particularly in the case of visual works. Courts in the Eighth Circuit have found the doctrines inapplicable to greeting cards⁴²² and quilt designs,⁴²³ because of the multiple (if not infinite) number of ways that component parts or common ideas can be expressed visually.⁴²⁴ But if the intrinsic similarity is lacking, a copyright owner cannot fall back on common public domain elements of the work (similar ideas, similar themes) and make a list of similar features if those features would qualify as merged or *scènes à faire* elements.⁴²⁵ Thus, the balance between the realm of ideas and realm of expressions is preserved.

6. District of Columbia Circuit

Sturdza v. United Arab Emirates reveals the District of Columbia Circuit's approach to the merger and *scènes à faire* doctrines in cases involving visual works.⁴²⁶ Sturdza was an architect that brought suit against another architect, Demetriou, for copyright infringement on Sturdza's design for the United Arab Emirates' new embassy.⁴²⁷ In the case, the United Arab Emirates (UAE) held a competition for the architectural design of a new embassy and chancery building that it planned to construct in Washington, D.C.⁴²⁸ The UAE provided a Program Manual that detailed the requirements for various aspects of the design.⁴²⁹ Sturdza and Demetriou both submitted designs, and a board of architects and civil engineers chose Sturdza's design; the UAE notified Sturdza of her win.⁴³⁰ The UAE began negotiations with Sturdza, but stopped communicating

Minnesota Twins was similar to Mastercard campaign regarding string of ballpark visits on the intrinsic analysis, and any similarities were attributable only to common idea behind the works of a roadtrip to visit baseball stadiums and *scènes à faire* elements associated with expression of idea of ballpark visits in the extrinsic analysis).

⁴²² *Taylor*, 315 F.3d at 1042–43.

⁴²³ *Thimbleberries, Inc. v. C & F Enters., Inc.*, 142 F. Supp. 2d 1132, 1138 (D. Minn. 2001).

⁴²⁴ *Taylor*, 315 F.3d at 1043; *Thimbleberries*, 142 F. Supp. 2d at 1138.

⁴²⁵ *Hartman*, 833 F.2d at 121 (determining that the only similar features were noncopyrightable ideas or *scènes à faire*); *Hoch*, 284 F. Supp. 2d at 1223.

⁴²⁶ 281 F.3d 1287, 1295–97 (D.C. Cir. 2002).

⁴²⁷ *Id.* at 1291.

⁴²⁸ *Id.*

⁴²⁹ *Id.* at 1291–92.

⁴³⁰ *Id.* at 1292.

with her without signing a contract proposal.⁴³¹ A year later, Sturdza learned that the UAE had presented an embassy design to the National Capital Planning Commission.⁴³² The design belonged to Demetriou, and he had allegedly “copied and appropriated many of the design features that had been the hallmark of her [Sturdza’s] design.”⁴³³ The court stated that “[t]he substantial similarity determination requires comparison not only of the two works’ individual elements in isolation, but also of their ‘overall look and feel.’”⁴³⁴ In other words, “[t]he touchstone of the analysis is the overall similarities rather than the minute differences between the two works.”⁴³⁵ The court strove to apply a total look and feel analysis because “protectable expression may arise through the ways in which artists combine even unprotectable elements.”⁴³⁶

In applying the total look and feel concept to Sturdza’s and Demetriou’s designs, the court said: “The size, shape, and placement of Demetriou’s wind-towers, parapets, and pointed domes, when viewed from the front, give his building a contour virtually identical to Sturdza’s.”⁴³⁷ Furthermore, the court looked at the similarities between the two buildings and stated:

[B]oth buildings have a pyramid-like clustering of pointed arches around the front entrances, prominent horizontal bands and vertical columns demarcating the windows, slightly protruding midsections, diamond grids, and similar latticework patterning inside the arches. Finally, Demetriou achieves the “Islamic” effect sought by the UAE by expressing and combing his wind-towers, arches, dome, parapet, and decorative patterning in ways quite similar to Sturdza’s expression and combination of these elements.⁴³⁸

The court concluded that despite differences between Demetriou’s and Sturdza’s designs, and despite the incorporation of various *scènes à faire* architectural elements (domes, arches, wind-towers, parapets, and Islamic

⁴³¹ *Id.*

⁴³² *Id.*

⁴³³ *Id.*

⁴³⁴ *Id.* at 1296 (citing *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001)).

⁴³⁵ *Id.* (quoting *Country Kids ‘N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1288 (10th Cir. 1996)).

⁴³⁶ *Id.*

⁴³⁷ *Id.* at 1299.

⁴³⁸ *Id.*

patterns),⁴³⁹ Demetriou's design was substantially similar to Sturdza's because the differences were too minute to take away from the total look and feel of Sturdza's design.⁴⁴⁰

The District of Columbia Circuit's restricted view of the merger and *scènes à faire* doctrines is further revealed in the computer program case of *Atari Games Corp. v. Oman*.⁴⁴¹ Instead of following the well traveled path of automatically excluding elements of video games as merged ideas or stock images (paddles, walls, geometric shapes, colors), the court carefully considered the effect of *Feist* and its holding that combinations of unprotected elements may yet be arranged in an original way and receive copyright protection.⁴⁴² The court noted that the acclaimed artistic works of Mondrian and Malevich were combinations and arrangements of geometric shapes and lines in various colors.⁴⁴³ The District of Columbia Circuit reaffirmed its holding in *Reader's Digest Association, Inc. v. Conservative Digest, Inc.* when it held that layout and typeface elements, although obviously public domain elements, can be combined in a creative and distinctive composite that is copyrightable and protectable from a substantially similar composite put forth by an alleged plagiarist.⁴⁴⁴ In *Atari II*, the court held that the bricks, rectangular "paddle," side to side motion, and rebounding motion of the ball that were found in plaintiff's BREAKOUT game were part of an original and distinctive whole, even though each part might be common to other video games and thus arguably subject to the merger, *scènes à faire*, or functionality originality defenses.⁴⁴⁵ The court remanded the case twice with instructions for the district court and the Register of Copyrights that the creative combination of unprotected game elements should receive copyright status and subsequent protection from substantially similar infringing games.⁴⁴⁶

⁴³⁹ *Id.* at 1297.

⁴⁴⁰ *Id.* at 1299.

⁴⁴¹ See generally 979 F.2d 242 (D.C. Cir. 1992) (*Atari II*), appeal after remand from 888 F.2d 878 (D.C. Cir. 1989) (*Atari I*).

⁴⁴² *Id.* at 244–45.

⁴⁴³ See *id.* at 243 n.1. The court also posited the rhetorical question: "If Picasso had painted a round object on a canvas, would you say because it depicts a familiar subject—namely, something that's round—it can't be copyrighted?" *Id.* (citing *OddzOn Prods., Inc. v. Oman*, 924 F.2d 346, 348 n.1 (D.C. Cir. 1991)).

⁴⁴⁴ *Id.* (citing *Reader's Digest Ass'n, Inc. v. Conservative Digest, Inc.*, 821 F.2d 800, 806 (D.C. Cir. 1987)).

⁴⁴⁵ *Id.* at 246–47.

⁴⁴⁶ *Id.* at 247; *Atari Games Corp. v. Oman*, 888 F.2d 878, 886 (D.C. Cir. 1989).

IV. REJECTION OF THE MERGER DOCTRINE AND *SCÈNES À FAIRE* DOCTRINE FOR VISUAL WORKS

Is the substantial similarity test inherently wrong? Are the merger and *scènes à faire* doctrines simply bad law? The answer to both questions is no. The problem is not the existence of the merger and *scènes à faire* doctrines. These doctrines are supported by 17 U.S.C. § 102(b) and the concept of the idea-expression dichotomy discussed and clarified in *Feist*.⁴⁴⁷ Ideas cannot be copyrighted.⁴⁴⁸ If there is only one way to express an idea, the idea and expression merge and the expression cannot be copyrighted.⁴⁴⁹ Public domain elements of literary works such as standard themes, stock plot devices, standard character types, and clichéd phrases cannot be appropriated by any author.⁴⁵⁰ This is a great blessing in literary works: No one can capture words or phrases or settings or genres by simply being the first to write them down.

The merger and *scènes à faire* doctrines are a great curse in visual art settings because their application rests on a fallacy: That an idea of a visual work and the expression of the idea can merge, or that artists must copy a standard image in order to depict an idea.⁴⁵¹ No one captures an idea by being the first to depict it visually. There is never a single way to depict some thing visually—object, creature, or idea. Another depiction is always possible. The presumption behind the application of the merger doctrine to visual works is that if we grant the creator full recognition for her original depiction and original combinations of unprotected elements this will somehow limit the creative potential of the next artist to try her hand at depicting the idea of the scene.⁴⁵² There is no such limitation except that which is within the mind of the second artist who cannot conceive of a different way of depicting the idea and resorts to plagiarism out of frustration for lack of creativity.

The presumption behind the application of the *scènes à faire* doctrine to visual works is that the original author was forced to choose from a drastically limited number of images to copy in order to properly or

⁴⁴⁷ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350 (1991).

⁴⁴⁸ *Id.*

⁴⁴⁹ *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 209 (3d Cir. 2005).

⁴⁵⁰ *E.g.*, *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 535 (6th Cir. 2004) (citing *Gates Rubber Co. v. Bando Chem. Indus., Inc.*, 9 F.3d 823, 838 (10th Cir. 1993)).

⁴⁵¹ *Satava v. Lowry*, 323 F.3d 805, 811–12 (9th Cir. 2003).

⁴⁵² *See id.* at 812.

efficiently depict the idea, and we cannot blame the plagiarist for also copying one of the images (namely, the original author's).⁴⁵³ If that is true, courts should require the defendant to prove which stock image the original author copied to state a prima face case for the application of the *scènes à faire* doctrine as an affirmative defense. Of course, in most cases this will be impossible; most plaintiffs did not copy a prior image, which is what made their original art so attractive for the plagiarist to copy. If the plaintiff did copy another image, her copyright claim would be subject to attack for lack of originality defeating her entire copyright over the work in question.⁴⁵⁴

There are three distinct problems with an expansive application of the merger and *scènes à faire* doctrines to visual works. First, the merger and *scènes à faire* doctrines were created to protect the public domain from excessively broad enforcement of literary works whose scope extends to abstractions of the work beyond its actual words so that a plagiarist cannot get away with stealing simply by avoiding the literal⁴⁵⁵ or actual copying of the original author's words.⁴⁵⁶ Infringement of visual works is much more often based on a claim of literal or actual copying; no abstraction of the work is required, and, therefore, there is no need to circumscribe the scope of plaintiff's work to protect the public domain from an expansive protection of abstractions of plaintiff's work. Second, courts applying the merger and *scènes à faire* doctrines expansively often reveal an inability to understand or appreciate the creative opportunities to express and portray objects visually and to identify and appreciate the contributions of the artist to the work above and beyond the simple ideas behind the works; this

⁴⁵³ See *id.*

⁴⁵⁴ See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (stating that originality is required for a copyright).

⁴⁵⁵ I hesitate to use the word "literal" (as in "literal copying") with respect to visual works because the term is derived from the same root as "literary" and thus is an apt term to describe word-for-word copying of verbal works and not the copying of visual works. The term "actual copying" used by some courts is not nearly as effective a term because works are "actually" copied by many means other than word-for-word reproduction or photo-mechanical duplication of visual works. My intention is to describe direct copying of the actual content of visual works, but not necessarily limited to photo-mechanical means such as photographing, photocopying, or scanning. Copying the actual content of a visual work by hand still is direct copying of the content of the work; it is not simply copying an abstraction of the work. To communicate this concept I will use the terms "literal" or "actual copying" as these are the terms the courts use, with apologies to my readers for perpetuating any confusion over these terms.

⁴⁵⁶ See *e.g.*, *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

causes the courts to discount creative combinations and additions to works that have connections to preexisting objects and prior works.⁴⁵⁷ Third, far from exercising humility out of their ignorance, courts are unwilling to allow jurors to take on the burden and make an analysis of the total concept and look and feel of the works at issue.⁴⁵⁸ Instead, courts apparently want to avoid aesthetic determinations altogether by creating the opportunity (through the dissection and filtration tests) to eliminate parts of the original work until it is reduced to such a small sum of parts that it appears as a matter of law that there is not a substantial enough amount of overlap between the two works for a finding that defendant inappropriately copied plaintiff's work.⁴⁵⁹ Often this is done in the face of obvious or even admitted copying of the creative, original components of the visual work by the defendant.

A. *Allegations of Literal or Actual Copying Defeat the Need for the Application of the Merger and Scènes à Faire Doctrines*

Copying is the primary activity that a copyright prevents.⁴⁶⁰ The subtle flaw in the logic of the application of the merger doctrine and *scènes à faire* doctrines to visual works is that the concepts of merger and *scènes à faire* attempt to demonstrate that the defendant need not have copied plaintiff's work in order to produce her own because the idea behind the two works or the nature and genre of the works dictate the embodiment of the idea in a single or a severely limited number of ways.⁴⁶¹ The theory is that the original creator was limited by these same forces, so who can blame the defendant for being coerced by these forces into creating her work in a way that shares similarities with the plaintiff's work. This is true in literary settings.⁴⁶² It is not true in visual settings.

In literary settings, if you want to express the idea of darkness, you have to use the word "dark" or one of a limited number of synonyms of that

⁴⁵⁷ *Satava*, 323 F.3d at 811.

⁴⁵⁸ See e.g., *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 400 F.3d 1007, 1011 (7th Cir. 2005) (questioning the usefulness of an "ordinary observer" test).

⁴⁵⁹ *Id.* at 1010–1012, 1014–1015.

⁴⁶⁰ I intend no insult to the importance of the other rights granted in 17 U.S.C. § 106, but prevention of unauthorized copying is the most important right protected by the copyright laws.

⁴⁶¹ See *Satava*, 323 F.3d at 811–12 (stating that ideas provided by nature are not subject to copyright and even original contributions were only narrowly protected).

⁴⁶² *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 929 (7th Cir. 2003).

word. No one can stop the next author from “copying” the word dark in order to express the idea of darkness. The first author was as limited by the available means provided by the English language in expressing the idea of darkness in writing as the second author was. If a dark and rainy night is the concept an author wishes to express, no one can accuse that author of copying the words “dark and rainy night” to express that concept. The words are necessary or at least the most efficient way to express the concept. If standing under a streetlight while the rain pours down your neck on a dark and rainy night is the idea the author wishes to express, he or she is able to use most if not all of these words to express it. This is the meaning of merger: The idea and the expression merge when there is only one way or practically only a very limited number ways of expressing the concept.⁴⁶³

The concept of *scènes à faire* works a similar protection in literary works. A genre cannot be captured by being the first to write in it (mysteries, crime stories, romance novels, coming-of-age stories, buddies-on-a-roadtrip stories).⁴⁶⁴ Character types cannot be protected simply by describing the type (a lazy husband, a wise old man, a jealous or desperate housewife).⁴⁶⁵ Settings cannot be monopolized simply by working them into your writing (a sleazy dive, a brightly lit restaurant, Red Square in Moscow, Fifth Avenue in Manhattan between 57th and 59th Streets).⁴⁶⁶ If another person wanted to put a scene on Red Square they would have to use the words “Red Square” and when they describe it they no doubt will use similar words as previous authors have used because they have to use those words, not because they have to copy another author’s description of the scene.

Literary works, including for the most part motion pictures, enjoy the freedom preserved by the merger and *scènes à faire* doctrines because in most disputes the fight is not over overt, word-for-word copying of text or actual taping and reproduction of segments of film or television or video. In no case involving books or screenplays or motion pictures or television cited in this Article was the issue that the defendant actually copied the words of the plaintiff or taped and reproduced a segment of the plaintiff’s audiovisual work; these scenarios come up in other copyright disputes over

⁴⁶³Kay Berry, Inc. v. Taylor Gifts, Inc., 421 F.3d 199, 209 (3d Cir. 2005).

⁴⁶⁴See Nash v. CBS, Inc., 899 F.2d 1537, 1540 (7th Cir. 1990).

⁴⁶⁵See, e.g., Walker v. Time Life Films, Inc., 784 F.2d 44, 50 (2d Cir. 1986) (stating that drunks, prostitutes, and policemen would be in any realistic work about the South Bronx).

⁴⁶⁶Herzog v. Castle Rock Entm’t, 193 F.3d 1241, 1248 (11th Cir. 1999).

ownership or fair use. Copyright law expands the protected expression of the author beyond the simple arrangement of words on the page or text on the screenplay to cover creative elements of plot, specific scenes, and specific characters created by the author.⁴⁶⁷ Thus, one cannot duplicate the original plot, original characters, and original storyline of a literary work and escape liability just by changing the wording. The merger doctrine and *scènes à faire* doctrine both work to make sure an author does not monopolize the general themes and settings and stereotypical character types when a second author sets off to plow the same ground.

The scope of the plaintiff's literary work extends beyond the words to a reasonable and limited number of abstractions of the work encompassing the original plot, original characters, and original storyline of the work.⁴⁶⁸ As described by Judge Learned Hand in *Nichols*, there is no way to predict exactly how many levels of abstraction can or should be protected regarding an individual work.⁴⁶⁹ Some works may be so creative and original that many levels of abstraction will still contain protected original expression that should not be freely copied by a later plagiarist.

None of this has any relevance to visual works. There are no stock images existing in some Platonic realm of ideas that must be copied in order to communicate the ideas. Abstraction is not necessary because it is literal or actual copying that is the subject of plaintiff's complaint. It is true that at a certain level of abstraction, some images will share common features with other images. If a person sets out to portray a flag, most will arrive with a pole and a rectangular piece of fabric that is curved slightly to reveal its flexible, flag-like nature. If a person sets out to portray an American flag, the same rectangular piece of fabric on the pole will have red, white, and blue coloring on it. That is it; there is no singular image necessary to copy to communicate flag, unlike in a literary sense in which a limited number of words (i.e., flag, American, United States, U.S.A.) necessarily must be used to communicate the same concept.

The vast majority of copyright actions about visual media concern literal or actual copying. As an artist, I can tell you from experience that it is monumentally unusual for an artist depicting the same subject as another artist to come up with a substantially similar work as the other artist unless she copies the work of the other. Monet and Renoir stood side by side

⁴⁶⁷ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

⁴⁶⁸ *Id.*

⁴⁶⁹ *Id.*

painting bathers at La Grenouillere (the “Frog Pond”) and practicing the principles of Impressionism, the school of art that they founded, yet each produced a singular, original work indicative only in the one case of Monet’s hands⁴⁷⁰ and in the other of Renoir’s hands.⁴⁷¹ However, if one copied the other’s work, the similarity might have been staggering.

B. Judges Reveal an Ignorance of Creative, Original Artistic Combinations and Additions to Works Through an Expansive Application of the Merger and Scènes à Faire Doctrines

There is a simple explanation for the many unusual outcomes of visual art cases in the First, Fifth, Sixth, Ninth, Tenth, and Eleventh Circuits: Courts fail to understand or appreciate the creative opportunities to express and portray objects visually and to identify and appreciate the contributions of the artist to the work above and beyond the simple ideas behind the works. This causes the courts to discount creative combinations and additions to works that portray objects and scenes from the real world or contain original combinations of unoriginal elements.⁴⁷² Justice Oliver Wendell Holmes predicted this problem when he stated:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time That these pictures had their worth and their success is

⁴⁷⁰ See <http://p.giroud.free.fr/monet/grenouillere.jpg> (last visited Oct. 14, 2006).

⁴⁷¹ See <http://www.lannaronca.it/Renoir/La%20Grenouillere.jpg> (last visited Oct. 14, 2006).

⁴⁷² See, e.g., *Satava v. Lowry*, 323 F.3d 805, 810–13 (9th Cir. 2003) (discussing the difficulty in obtaining a copyright for work based on natural objects and the “thinness” of the protection even if obtained).

sufficiently shown by the desire to reproduce them without regard to the plaintiffs' rights.⁴⁷³

Justice Holmes was addressing many courts' failure to appreciate the originality and creativity of certain visual works in the initial copyrightability analysis. The same failure occurs when the courts do not recognize the creative combinations and additions to visual works that allow the works to surpass the common, public domain ideas of the subject matter of the works. At the one extreme is the Ninth Circuit's declaration that it is virtually impossible to render a lifelike artistic depiction of a living creature with enough originality to preclude a plagiarist from making a patently similar copy of the first work.⁴⁷⁴ The holding of the Ninth Circuit in *Satava* cannot be reconciled with the holding of the Third Circuit in *Franklin Mint*⁴⁷⁵ and *Masquerade Novelty*,⁴⁷⁶ the Fourth Circuit in *Superior Form Builders*,⁴⁷⁷ the Seventh Circuit in *Wildlife Express Corp. v. Carol Wright Sales, Inc.*,⁴⁷⁸ and the Ninth Circuit itself in *Kamar International*.⁴⁷⁹ At another extreme is *Yankee Candle*, in which the First Circuit held that creative combinations of common, unoriginal photographic elements cannot add up to a protectable, original whole.⁴⁸⁰ These cases are in direct contradiction of the holding of *Feist*,⁴⁸¹ as well as the holdings of dozens of other circuit court cases that have protected the rights of authors of works containing creative, original, and protectable combinations of unoriginal components.⁴⁸² If anything, this split in the circuits should counsel judges to avoid a rash determination that there are no protectable creative elements

⁴⁷³ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (citing *Henderson v. Tompkins*, 60 F. 758, 765 (C.C. Mass. 1894)).

⁴⁷⁴ *Satava*, 323 F.3d at 810–13.

⁴⁷⁵ *Franklin Mint Corp. v. Nat'l Wildlife Art Exch., Inc.*, 575 F.2d 62, 66–67 (3d Cir. 1978).

⁴⁷⁶ *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 671–72 (3d Cir. 1990).

⁴⁷⁷ *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 492 (4th Cir. 1996).

⁴⁷⁸ See generally 18 F.3d 502 (7th Cir. 1994).

⁴⁷⁹ See generally *Kamar Int'l, Inc. v. Russ Berrie & Co.*, 657 F.2d 1059 (9th Cir. 1981).

⁴⁸⁰ See generally *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25 (1st Cir. 2001).

⁴⁸¹ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991).

⁴⁸² E.g., *Buckle v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 929 (7th Cir. 2003); *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 135–136 (2d Cir. 2003); *Boisson v. Banian, Ltd.*, 273 F.3d 262, 273 (2d Cir. 2001); *Atari Games Corp. v. Oman*, 979 F.2d 242, 245 (D.C. Cir. 1992); *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 939 (7th Cir. 1989); *Reader's Digest Ass'n, Inc. v. Conservative Digest, Inc.*, 821 F.2d 800, 806 (D.C. Cir. 1987).

in works that depict natural objects or contain creative combinations of common, unoriginal elements or subject matter. *Feist* held that the standard for creativity and originality is intentionally low and the vast majority of works should make the grade quite easily.⁴⁸³ Yet, half of the circuits of the United States courts of appeals have seen fit to dissect and filter out the elements of creative visual works through an expansive application of the merger and *scènes à faire* doctrines, reducing the works to a pile of random elements that no rational finder of fact can compare to an alleged plagiarist's work in a determination of substantial similarity.

C. An Expansive Application of the Merger and Scènes à Faire Doctrines Denies Visual Artists the Protection of the Copyright Laws by Taking the Substantial Similarity Determination Away From the Finder of Fact

The subtext of this discussion of the expansion in the application of the merger and *scènes à faire* doctrines to visual works is that many if not most of the cases applying the doctrines through a dissection and filtration analysis wind up determining that the case can be taken away from the jury on summary disposition because so much of the plaintiff's work has been dissected and filtered away that there is nothing substantial left for the alleged plagiarist to have copied. This practice denies visual artists the right to have the intrinsic similarity of their works and the alleged plagiarist's works evaluated by the finder of fact.

The Ninth Circuit shows the development of this process in *Aliotti v. R. Dakin & Co.*, a case involving depictions of actual creatures (albeit dinosaurs).⁴⁸⁴ The court reconsidered the intrinsic similarity test so as to better accommodate the merger doctrine.⁴⁸⁵ First, the court noted:

[T]he district court's determination as to substantial similarity of expression relied incorrectly on the analytic dissection of the dissimilar characteristics of the dolls. Similarity of expression exists only when 'the total concept and feel of the works' is substantially similar. Dissection of *dissimilarities* is inappropriate because it distracts a

⁴⁸³ *Feist*, 499 U.S. at 345.

⁴⁸⁴ 831 F.2d 898 (9th Cir. 1987).

⁴⁸⁵ *Id.* at 901.

reasonable observer from a comparison of the total concept and feel of the works.⁴⁸⁶

The subtle insertion of the word “dissimilarities” was important because the court was about to make a point about dissection of similarities in an effort to open the door to the merger doctrine in visual media cases:

To the extent that it is necessary to determine whether similarities result from unprotectable expression, it is appropriate under *Krofft*'s intrinsic test to perform analytic dissection of *similarities*. Although even unprotectable material should be considered when determining if there is substantial similarity of expression, no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas.⁴⁸⁷

Thus, dissection entered the intrinsic portion of the similarity test, albeit after the “total concept and feel” of the works as a whole was evaluated by the finder of fact.⁴⁸⁸ If there was no substantial, intrinsic similarity as to the works as a whole, the case was closed; however, if there was substantial, intrinsic similarity as to the works as a whole, the similar features of the works could then be dissected and separately analyzed to make sure that all similarities were not as to unprotected elements.

Aliotti recognized that courts that are intent on expanding the application of the doctrine would find it hard to accomplish this in the face of the total concept and feel standard.⁴⁸⁹ Total concept and feel is a standard for ordinary observers, namely the jury as finder of fact in many copyright actions. In light of this fact, courts typically pay lip service to the proposition that the intrinsic similarity determination using the total concept and feel standard is not proper for summary disposition.⁴⁹⁰ The total concept and feel standard finds its support in the bedrock copyright law stating that original combinations of uncopyrightable components can be

⁴⁸⁶ *Id.* (emphasis added) (citations omitted).

⁴⁸⁷ *Id.* (emphasis in original) (citations omitted).

⁴⁸⁸ *See id.*

⁴⁸⁹ *Id.* at 900–903.

⁴⁹⁰ *See id.* at 900 (stating that summary judgment is not favored in substantial similarity cases).

protected;⁴⁹¹ therefore, the evaluator must look at the total combination, not a stripped down combination when comparing it to the alleged plagiarist's work. By shelving the total concept and feel test, and stressing the dissection and filtration of allegedly merged and *scènes à faire* material, the court creates the opportunity for summary disposition of the suit—the more material that is stripped away from plaintiff's work, the more comfortable the court will be with finding as a matter of law that no average person could find the two works to be substantially similar as to the few items remaining in the plaintiff's work. If a court takes the total concept and feel standard seriously it almost guarantees a jury trial unless the two works in their entirety are simply and manifestly dissimilar. Taking away a stripped down plaintiff's creation from the jury is an easier call than making an aesthetic determination that an average person could not find substantial similarity in the two works as a whole. An expansive application of the merger and *scènes à faire* doctrines makes this possible by providing a rationale, albeit a misguided rationale, for dissecting and filtering out components of plaintiff's work.

VI. CONCLUSION: RECOMMENDATIONS AND SOLUTION?

The current state of the law in at least half of the circuits of the United States courts of appeals is to apply the merger and *scènes à faire* doctrines to visual works in a frequent and far reaching manner. The principle result is that the authors of creative visual compilations and depictions and portrayals of objects and entities found in the real world are denied the full protection of copyright promised by the originality standard of *Feist*.⁴⁹² A secondary result is that many copyright cases in which the plaintiff lacks actual proof of direct copying are resolved by summary disposition as opposed to jury trials even though the two step substantial similarity test is supposed to contain an ordinary observer standard that is not appropriate for summary disposition. After an expansive application of the merger or *scènes à faire* doctrine to a plaintiff's visual work, there often is little or nothing to compare side-by-side with the alleged plagiarist's work which necessitates summary judgment for the plagiarist. I offer the following solution to the problem followed by alternative recommendations if the solution offered is not acceptable.

⁴⁹¹ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991).

⁴⁹² *Id.*

A. *Solution: Eliminate the Application of the Merger and Scènes à Faire Doctrines to Visual Works*

The most satisfactory solution is for courts to advance the law by finding that the merger and *scènes à faire* doctrines do not apply to visual works. The merger doctrine should not apply in situations where an idea can be depicted in innumerable ways either through original creation or by original combinations of otherwise unprotected elements. Visual works are a classic example of a situation where ideas can be depicted visually in innumerable ways which should preclude application of the merger doctrine. Furthermore, authors of visual works on the whole do not copy a stock image in the way that literary works adopt and express a stock scene or situation. There is no set of images that must be copied in order to depict the idea of the image. In the absence of proof that plaintiff did in fact copy a preexisting stock image or “required” image, the merger and *scènes à faire* doctrines should not apply to visual media.

B. *Recommendation: Impose a Burden on the Alleged Plagiarist to Produce the Image Copied by the Original Artist in Order to Trigger the Application of the Merger and Scènes à Faire Doctrines to Visual Works*

Short of overturning decades of law, the courts could interpret the merger and *scènes à faire* doctrines more logically and require the alleged plagiarist to produce the image (the stock *scènes à faire* image or the single, acceptable expression of the merged idea) that plaintiff must have copied to prove that one or both of the two doctrines apply. Successfully raising this affirmative defense would in effect prove that plaintiff’s work was not original and, thus, not deserving of copyright protection; that is the correct interpretation of situations in which the merger and *scènes à faire* doctrine should apply. The current interpretation of the two part substantial similarity test puts the burden on the plaintiff to establish both extrinsic similarity and intrinsic similarity. Courts step in to interfere with this process by asserting that the plaintiff’s creation contains merged and *scènes à faire* elements, doubling the burden of the plaintiff. To get to a jury, the plaintiff must not only show factual, objective similarity but also stave off the court’s efforts to reduce her work to a dissembled pile of elements by dissecting and filtering out alleged merged and *scènes à faire* elements. If the court’s application of the merger and *scènes à faire* doctrine is broad enough, the court will not be receptive to the argument that original and

creative compilations of even unprotectable elements may enjoy copyright protection and the court will prevent the work from being evaluated as a whole by the finder of fact.

C. Recommendation: Allow the Finder of Fact to Evaluate the Total Look and Feel of the Two Competing Visual Works, but Impose a Check on the Process with Sspecial Verdict Forms

If the major premises of my argument are not accepted, and courts insist that the merger and *scènes à faire* doctrines apply to visual works, I have one last suggestion: Allow the jury to evaluate the works as a whole, but require the jury to identify through jury interrogatories or a special verdict form the elements of the two works that are similar. Then, the court would have an opportunity to intervene in a situation where the only items of similarity identified by the jury are merged, *scènes à faire*, or other public domain features common to the two works and many others. In this way, the jury is allowed to evaluate the two works as a whole, but the court has built in a check and balance that can halt the jury's progress into enforcement of a copyright through protection of unprotectable subject matter. This method is contemplated by both the Ninth Circuit in *Aliotti* in its recommendation that the court examine the findings of a "total concept and feel" analysis to make sure the items of intrinsic similarity are not all unprotected items,⁴⁹³ and by the Second Circuit in *Boisson* when the court's model for a "more discerning observer" test would require well drafted jury instructions to teach the jury to make a discerning comparison of the competing works that is not based on similarities of unprotectable elements of plaintiff's work.⁴⁹⁴

The merger and *scènes à faire* doctrines have their place in copyright law; their place is with literary works that depend on abstraction for a full protection of the works' creative expression of the general ideas behind the works. Visual works do not rely on levels of abstraction or on abstraction at all. The vast majority of claims of infringement of visual works concern literal or actual copying, not the borrowing of the abstract expressions of the work.

In most cases, defendants will not be able to point to a preexisting image (a stock *scènes à faire* image, or the single image that merges with the idea of the image) that was copied by the plaintiffs and that

⁴⁹³ 831 F.2d at 901.

⁴⁹⁴ See *Boisson v. Banian, Ltd.* 273 F.3d 262, 272 (2d Cir. 2001).

subsequently defendants did copy or might have copied in the production of their own visual work. If such an image exists it should be raised as an affirmative attack on the originality of the plaintiff's work. This would be the logical justification for the application of the merger and *scènes à faire* doctrines to visual works. Instead, courts use the doctrines to chip away at creative visual compositions and original combinations of original and unoriginal elements until the work is reduced to a state where no one could find that it was substantially similar to another work. That the merger and *scènes à faire* doctrines encompass visual images in the public domain that visual artists are required to copy in order to depict or portray certain ideas is a fallacy perpetrated by half of the circuits of the United States courts of appeals. Only by recognizing the common creative practices of visual artists and recognizing the full scope of protection that *Feist* affords to original works and original combinations of unoriginal elements of visual works can this fallacy be dispelled.