

By STEVEN T. LOWE

DEATH OF COPYRIGHT

Copyright infringement may be the only remaining area of law in which courts seem increasingly willing to decide material facts on summary judgment

COPYRIGHT INFRINGEMENT claims against motion picture studios and television networks, for all intents and purposes, are dead. Of the 48 copyright infringement cases against studios or networks that resulted in a final judgment within the Second and Ninth Circuits (and the district courts within those circuits) in the last two decades,¹ the studios and networks prevailed in all of them—and nearly always on motions for summary judgment. (See “Perfect Storm,” at 34.) In fact, in the last 20 years, only two publicly available copyright infringement cases (published or unpublished) against studios or networks proceeded to jury trial—with verdicts for the defendants.²

Were all these cases without merit, or did the studios and networks simply have far superior counsel in each case? These suppositions are very unlikely. The case law governing these actions simply has become so amorphous that for almost every principle of law favorable to creators, the courts have endorsed and applied an opposite principle.

As a result, the determination of each case now rests almost entirely in the unfettered discretion of trial judges, who have consistently dismissed plaintiffs’ claims. Unless the current trend changes, longstanding principles once favorable to creators may be eclipsed by an evolving body of law so unfavorable to them that the studios and networks are essentially immunized from liability except in cases of identical copying and conceded access to the plaintiff’s work.

Since direct evidence of copying rarely is available in a copyright infringement suit,³ plaintiffs typically must establish that the defendant had access to the plaintiff’s work and that the two works are substantially similar.⁴ Proof of access requires only a “reasonable possibility” to view or copy the plaintiff’s work.⁵ However, courts commonly cite to the countervailing principle that “mere speculation or conjecture” is insufficient. Because the analysis of a reasonable possibility necessarily includes some conjecture and speculation, the “line between a ‘bare’ pos-

sibility and a ‘reasonable’ possibility of access is difficult to draw.”⁶ If the work has not been widely disseminated—which is usually the case for unpublished screenplays—“a particular chain of events” must be established between the plaintiff’s work and the defendant’s access to that work.⁷

Early cases outside of the Ninth Circuit found access even when the plaintiff could not actually place the work in the hands of the defendant. For example, in the First Circuit case of *Morrissey v. Procter & Gamble Company*, the plaintiff offered evidence that he had mailed his copyrighted work to the defendant’s principal office. The court held that this mailing created “an inference that the letter reached its proper destination,” and to require the plaintiff to show that the “particularly

Steven T. Lowe is a principal of Lowe Law, a boutique entertainment litigation firm in Los Angeles. He wishes to thank Daniel Lifschitz, Chris Johnson, and Michael Salvatore for their assistance in the preparation of this article.

AMANE KANEKO

responsible employees had received his communication" would have been unfair.⁸ Similarly, in 1971, a New York district court held in *Bevan v. Columbia Broadcasting System, Inc.*, that corporate receipt could be "sufficient to raise a triable issue, despite plaintiff's inability to show receipt by the responsible employee,"⁹ because it would be unfair to "saddle a plaintiff with disproving non-access within a corporate structure foreign to him and with witnesses not his own."¹⁰

Unfortunately for creators, the *Bevan* holding was rejected by some courts.¹¹ For example, in *Meta-Film Associates, Inc. v. MCA, Inc.*, a 1984 case, the Central District of California identified only three circumstances that would meet the type of close relationship between coworkers necessary to give rise to a reasonable opportunity of access. The person who received the plaintiff's work must 1) be "a supervisor with responsibility for the defendant's project," or 2) "part of the same work unit as the copier," or 3) have "contributed creative ideas or material to the defendant's work."¹² By limiting, as a matter of law, the instances in which a plaintiff can prove access within a corporate structure, the *Meta-Film* court effectively precluded plaintiffs from establishing access in numerous scenarios in which there is actual

access but the facts do not fall into one of the court's enumerated categories.¹³

The *Meta-Film* court also recognized situations in which a third-party intermediary not of the same business enterprise as the alleged infringer may be found to have passed along the plaintiff's work.¹⁴ The court limited such situations, however, to instances when the third-party intermediary "provided creative suggestions and ideas" concerning the allegedly infringing work, and "the dealings between the three entities (plaintiff, defendants, and [intermediary])...related to the identical subject matter."¹⁵ Although *Meta-Film's* effect in the Ninth Circuit has been limited to several district court cases¹⁶—and the Ninth Circuit has not adopted its holding¹⁷—*Meta-Film* has been influential in the Second Circuit, which expressly relied on the case when it overruled the *Bevan* holding.¹⁸ Thus, *Meta-Film* remains a prominent example of why commentators note that "many courts set an unrealistically high bar as to what constitutes a close relationship" for establishing access.¹⁹

Substantial Similarity

Even when access is established, the path to a favorable judgment remains perilous for plaintiffs.²⁰ In fact, in many cases in which

summary judgment has been granted for defendants, the courts simply presumed that access existed.²¹ This is because "even massive evidence of access cannot by itself avoid the necessity of also proving the full measure of substantial similarity."²² And this full measure has become virtually impossible to establish under recent case law.

To determine whether substantial similarity exists between works at the summary judgment phase, the Ninth Circuit has instructed that courts perform an "extrinsic" analysis of the works' objective elements, focusing on "articulable similarities between the plot, themes, dialogue, mood, setting, pace, characters, and sequence of events."²³ In application, however, this analysis has been unpredictable and has resulted in wildly conflicting case law and results. In addition, in recent years, the Ninth Circuit has ignored established case law that requires the court to not only include "unprotectable elements" in its analysis²⁴ but also exclude dissimilarities between the two works.²⁵

A long line of copyright infringement cases holds that a plaintiff and defendant's works should be compared in their entirety, including both protectable and unprotectable elements,²⁶ to determine whether a qualitatively (or quantitatively) significant portion of

Perfect Storm

In the last 20 years, in the Second and Ninth Circuits and the lower courts within those circuits, 48 copyright infringement cases against studios or networks were litigated to final judgment. In all 48 cases, the victors were the studio and network defendants. Most of the cases were determined by a grant of summary judgment.

✱ *Arden v. Columbia Pictures Industries*, 908 F. Supp. 1248 (S.D. N.Y. 1995) (summary judgment for defendant) (*Groundhog Day*).

✱ *Benay v. Warner Bros. Entertainment, Inc.*, 607 F.3d 620 (9th Cir. 2010) (summary judgment for defendant affirmed) (*The Last Samurai*).

✱ *Benjamin v. Walt Disney Company*, 2007 U.S. Dist. LEXIS 91710 (C.D. Cal. 2007) (summary judgment for defendant) (*Sweet Home Alabama*).

✱ *Betheav v. Burnett*, 2005 WL 1720631 (C.D. Cal. 2005) (summary judgment for defendant) (*The Apprentice*).

✱ *Blakeman v. Walt Disney Company*, 613 F. Supp. 2d 288 (E.D. N.Y. 2009) (summary judgment for defendant) (*Swing Vote*).

✱ *Burns v. Imagine Films Entertainment, Inc.*, 2001 U.S. Dist. LEXIS 24653 (W.D. N.Y. 2001) (summary judgment for defendant) (*Backdraft*).

✱ *Brown v. Perdue*, 177 Fed. Appx. 121 (2d Cir. 2006) (summary judgment for defendant affirmed) (*The Da Vinci Code*).

✱ *Bunick v. UPN*, 2008 U.S. Dist. LEXIS 35536 (S.D. N.Y. 2008) (summary judgment for defendant) (*South Beach*).

✱ *Cabell v. Sony Pictures Entertainment, Inc.*, 2010 U.S. Dist. LEXIS 54667 (S.D. N.Y. 2010) (summary judgment for defendant) (*You Don't Mess with the Zohan*).

✱ *Cax v. Abrams*, 1997 U.S. Dist. LEXIS 6687 (S.D. N.Y. 1997) (summary judgment for defendant) (*Regarding Henry*).

✱ *Flaherty v. Filardi*, 2009 U.S. Dist. LEXIS 22641 (S.D. N.Y. 2009) (sum-

mary judgment for defendant) (*Bringing Down the House*).

✱ *Flynn v. Sumow*, 2003 U.S. Dist. LEXIS 26973 (C.D. Cal. 2003) (summary judgment for defendant) (24).

✱ *Funky Films v. Time Warner Entertainment*, 462 F.3d 1072 (9th Cir. 2006) (summary judgment for defendant) (*Six Feet Under*).

✱ *Gable v. NBC*, 2010 WL 2990977 (C.D. Cal. 2010) (summary judgment for defendant) (*My Name Is Earl*).

✱ *Gilbert v. New Line Productions*, 2010 U.S. Dist. LEXIS 27134 (C.D. Cal. 2010) (summary judgment for defendant) (*Monster in Law*).

✱ *Gregory v. Murphy*, 1991 U.S. App. LEXIS 4893 (9th Cir. 1991) (summary judgment for defendant affirmed) (*Coming to America*).

✱ *Grosso v. Miramax Film Corporation*, 2001 U.S. Dist. LEXIS 26199 (C.D. Cal. 2001) (summary judgment for defendant) (*Rounders*).

✱ *Historical Truth Productions v. Sony Pictures Entertainment*, 1995 U.S. Dist. LEXIS 17477 (S.D. N.Y. 1995) (summary judgment for defendant) (*Universal Soldier*).

✱ *Hudson v. Universal Pictures Corporation*, 2004 U.S. Dist. LEXIS 11508 (E.D. N.Y. 2004) (summary judgment for defendant) (*Life*).

✱ *Idema v. Dreamworks, Inc.*, 162 F. Supp. 2d (C.D. Cal. 2001) (summary judgment for defendant) (*The Peacemaker*).

✱ *Kodadek v. MTV Networks*, 1996 U.S. Dist. LEXIS 20776 (C.D. Cal. 1996) (summary judgment for defendant) (*Beavis & Butthead*).

a plaintiff's work was appropriated.²⁷ This comports with basic principles of copyright law and is known as the "selection and arrangement" test.²⁸

In the seminal 1991 case *Feist Publications Inc. v. Rural Telephone Services Company*, the U.S. Supreme Court held that when dealing with works largely (or even entirely) composed of unprotectable elements, "choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original."²⁹ Transposed to the literary arts, the test provides that although copyright law does not generally protect basic plot premises in literary works or commonly used expressions that flow naturally from those premises ("scenes a faire"), the original selection and arrangement of these elements can constitute a protectable work in and of itself.³⁰ Therefore, the wholesale exclusion of all "unprotectable" elements improperly limits the scope of copyright protection. The Ninth Circuit has recognized this principle on numerous occasions but has spent the better part of the past decade aggressively denying its use to plaintiffs in copyright infringement cases against studios and networks.

Metcalfe v. Bochco, decided in 2002, is

one of only two copyright infringement cases against a studio or network in the last 20 years that proceeded to trial. (The other is *Shaw v. Lindheim*.³¹) In *Metcalfe*, the plaintiff offered evidence that the defendant had misappropriated many elements of the plaintiff's screenplay to create a television series for NBC. The court recognized that "the similarities proffered by [the plaintiff] are not protectable when considered individually; they are either too generic or constitute 'scenes a faire.'"³² However, "the presence of so many generic similarities and the common patterns in which they arise help satisfy the extrinsic test."³³ The court memorably compared the elements of literary works to those of musical compositions:

The particular sequence in which an author strings a significant number of unprotectable elements can itself be a protectable element. Each note in a scale, for example, is not protectable, but a pattern of notes in a tune may earn copyright protection.³⁴

The court did not strip the works of their unprotectable elements before diving into an extrinsic analysis of substantial similarity, consistent with the general purpose of the selection and arrangement test (that is, to protect in combination that which cannot

be protected separately).³⁵ In the years since its publication, however, the analysis of *Metcalfe* has proven to be the exception and not the rule.

The 2003 case of *Rice v. Fox Broadcasting Company* may have played the heaviest hand against the use of the selection and arrangement test. The *Rice* court stated that "similarities derived from the use of common ideas cannot be protected."³⁶ This assertion ignored the holdings and rationales of the cases that the court cited, including *Metcalfe*, but the *Rice* court attempted to distinguish *Metcalfe* by stating that it was "based on a form of inverse ratio rule analysis" (i.e., the rule whereby more access requires less substantial similarity and vice versa) and seemed to imply that the selection and arrangement test is only applicable when access is conceded.³⁷ This implication, which limits *Metcalfe* to its facts, overlooks that nowhere in *Metcalfe* (or any case prior to it) is the inverse ratio rule required for the application of the selection and arrangement test.³⁸ Nevertheless, *Rice's* misinterpretation of *Metcalfe* has been repeatedly followed by the Ninth Circuit in subsequent opinions.

Indeed, in the 2006 case of *Funky Films, Inc. v. Time Warner Entertainment Company, L.P.*, the Ninth Circuit once again ignored the

* *Kouff v. Walt Disney Pictures and Television*, 16 F. 3d 1042 (9th Cir. 1994) (summary judgment for defendant affirmed) (*Honey, I Shrank the Kids*).
 * *Kretschmer v. Warner Bros.*, 1994 U.S. Dist. LEXIS 7805 (S.D. N.Y. 1994) (summary judgment for defendant) (*Defending Your Life*).
 * *Lane v. Universal City Studios*, 1994 U.S. App. LEXIS 23769 (9th Cir. Cal. 1994) (summary judgment for defendants affirmed) (*Kojak: Fatal Flaw*).
 * *Laskay v. New Line Cinema*, 1998 U.S. App. LEXIS 23461 (C.D. Cal. 1998) (summary judgment for defendant) (*Don Juan DeMarco*).
 * *Lassiter v. Twentieth Century Fox Film Corporation*, 238 Fed. Appx. 194 (9th Cir. 2007) (summary judgment for defendant affirmed) (*Drumline*).
 * *Mallery v. NBC Universal, Inc.*, 331 Fed. Appx. 821 (2d Cir. 2009) (summary judgment for defendant affirmed) (*Heroes*).
 * *Memill v. Paramount Pictures Corporation*, 2005 U.S. Dist. LEXIS 45401 (C.D. Cal. 2005) (summary judgment for defendant) (*Crossroads*).
 * *Mestre v. Vivendi Universal U.S. Holding Co.*, 273 Fed. Appx. 631 (9th Cir. 2008) (summary judgment for defendant affirmed) (*Billy Elliot*).
 * *Metcalfe v. Bochco*, 294 F. 3d 1069 (9th Cir. 2002) (jury verdict in favor of defendant studio), *aff'd*, *Metcalfe v. Bochco*, 200 Fed. Appx. 635 (9th Cir. 2006) (*City of Angels*).
 * *Milano v. NBC Universal, Inc.*, 584 F. Supp. 2d 1288 (C.D. Cal. 2008) (summary judgment for defendant) (*The Biggest Loser*).
 * *Mowry v. Viacom International, Inc.*, 2005 U.S. Dist. LEXIS 15189 (S.D. N.Y. 2005) (summary judgment for defendant) (*The Truman Show*).
 * *Novak v. National Broadcasting Company*, 752 F. Supp. 164 (S.D. N.Y. 1990) (summary judgment for defendant) (*Saturday Night Live*).
 * *Ostrowski v. Creative Artists Agency*, 1994 U.S. App. LEXIS 23732 (9th Cir. Cal. 1994) (summary judgment for defendant affirmed) (*To Forget Palermo*).

* *Pelt v. CBS, Inc.*, 1993 U.S. Dist. LEXIS 20464 (C.D. Cal. 1993) (summary judgment for defendant) (*Listen Up! Young Voices for Change*).
 * *Rice v. Fox Broadcasting Company*, 330 F. 3d 1170 (9th Cir. 2003) (summary judgment for defendant affirmed) (*The Mystery Magician*).
 * *Robinson v. Viacom International*, 1995 U.S. Dist. LEXIS 9781 (S.D. N.Y. 1995) (summary judgment for defendant) (*Hi Honey*).
 * *Rodriguez v. Heidi Klum Company, LLC*, 2008 U.S. Dist. LEXIS 80805 (S.D. N.Y. 2008) (summary judgment for defendant) (*Project Runway*).
 * *Rosenfeld v. Twentieth Century Fox Film*, 2009 U.S. Dist. LEXIS 9305 (C.D. Cal. 2009) (summary judgment for defendant) (*Robots*).
 * *Shaw v. Lindheim*, 809 F. Supp. 1393 (C.D. Cal. 1992) (upon remand, judgment as a matter of law in favor of defendant studio) (*The Equalizer*).
 * *Stewart v. Wachowski*, 574 F. Supp. 2d 1074 (C.D. Cal. 2005) (summary judgment for defendant) (*The Matrix*).
 * *The Sheldon Abend Revocable Trust v. Steven Spielberg*, 2010 WL 3701343 (S.D. N.Y. 2010) (summary judgment for defendants) (*Disturbia*).
 * *Thomas v. Walt Disney Company*, 337 Fed. Appx. 694 (9th Cir. 2009) (defendant's motion to dismiss affirmed) (*Finding Nemo*).
 * *Walker v. Viacom International, Inc.*, 2010 U.S. App. LEXIS 1475 (9th Cir. 2010) (summary judgment for defendant) (*SpongeBob SquarePants*).
 * *Weygand v. CBS*, 1997 U.S. Dist. LEXIS 19613 (C.D. Cal. 1997) (summary judgment for defendant) (*Charlie*).
 * *Williams v. Crichton*, 84 F. 3d 581 (2d Cir. 1996) (summary judgment for defendant) (*Jurassic Park*).
 * *Willis v. HBO*, 2001 U.S. Dist. LEXIS 17887 (S.D. N.Y. 2001) (summary judgment for defendant) (*Arli\$S*).
 * *Zella v. E. W. Scripps Company*, 529 F. Supp. 2d 1124 (C.D. Cal. 2007) (defendant's motion to dismiss granted) (*Rachael Ray*).—S.T.L.

selection and arrangement test, holding that: [Courts] must take care to inquire only whether the *protectable elements*, *standing alone*, are substantially similar. In so doing, [courts] filter out and disregard the non-protectable elements in making [their] substantial similarity determination.³⁹

Moreover, in one flourish of its pen, the *Funky Films* court created a whole new defense for alleged infringers where none previously existed and which has been heav-

ily relied upon in subsequent court opinions. The court stated that a "reading of the two works reveal[ed] greater, more significant differences" than similarities.⁴⁰ In essence, the court constructed a brand new test of "substantial dissimilarity" in the context of copyright infringement, one that completely contravenes the well-established principle that dissimilarity is irrelevant as long as the plaintiff makes a showing of the defendant work's similarity to a substantial element of the plaintiff's work.⁴¹

arrangement test, comfortably stripping all unprotected elements from the works and ultimately using the new *Funky Films* dissimilarity analysis as a basis to rule against the plaintiffs on their copyright claim.⁴⁹ In the end, the *Benay* plaintiffs only were able to continue to pursue their state law claim of breach of implied contract.⁵⁰ Though this claim can be satisfied when copying does not rise to a level of substantial similarity, it requires a higher level of access to establish an implied contract, as well as privity between

the parties.⁵¹ Furthermore, even if established, the remedies available in a breach of implied contract claim are not as broad as those for copyright claims.⁵² Overall, the state claim is a poor substitute for the once robust protections offered to creators under copyright law. The claim also has been limited extensively by the application of the preemptive effect of federal copyright law—the very law creators hoped it would supplement.⁵³

Not only has the ad hoc use of substantial dissimilarity and the refusal to acknowledge selection and arrangement stripped creators of the doctrines that once protected them, but it also effectively endorses creative theft whenever the elements of an implied contract are not satisfied.

It appears that the old Learned Hand chestnut that "no plagiarist can excuse the wrong by showing how much of his work he did not pirate" may no longer be true.⁴² The result of this shift in copyright law is that third parties now have the freedom to steal from screenplays with impunity, provided they cover their tracks by creating sufficient dissimilarities in what is, in reality, a "derivative work."⁴³ The recent case of *Benay v. Warner Bros.* illustrates this point.⁴⁴

In *Benay*, decided in June 2010, the plaintiffs' agent pitched and provided a copy of their screenplay *The Last Samurai* to the president of production at Warner Bros.⁴⁵ The studio declined to proceed further with the screenplay but later produced and released a film with the exact same title and premise as the plaintiffs' work.⁴⁶ Despite compelling evidence that actual copying of the plaintiff's screenplay occurred,⁴⁷ the court deemed it "insufficient to overcome the overall lack of similarities between protected elements of the works."⁴⁸ The Ninth Circuit's extrinsic analysis once again ignored the selection and

dismiss expert witnesses to screenplay copyright infringement claims and analyze the works themselves.⁵⁷

Phasing Out Experts and Juries

The outcome in *Benay* is emblematic of just how far copyright decisions have strayed from maintaining a balance between the interests of creators and the interests of producers. Not only has the ad hoc use of substantial dissimilarity and the refusal to acknowledge selection and arrangement stripped creators of the doctrines that once protected them, but it also effectively endorses creative theft whenever the elements of an implied contract are not satisfied. If more juries were exposed to the facts of these cases, creators might hope to reverse the imbalance. However, the determination of appropriation has time and again been allocated to the presiding judge of each case instead. Indeed, copyright infringement may be the only remaining area of the law in which judges seem increasingly willing to decide material facts on summary judgment, effectively removing both experts and juries from the process entirely.

While courts repeatedly cite the proposition that "summary judgment is not highly

dismiss expert witnesses to screenplay copyright infringement claims and analyze the works themselves.⁵⁷ In 2001, the Central District of California stated in *Fleener v. Trinity Broadcasting Network* (a case that was not against a major studio), "There is abundant case-law establishing that expert testimony is particularly appropriate in summary judgment motions under the copyright 'extrinsic test.'"⁵⁸ However, judges have become comfortable with disregarding this type of testimony when they believe they can do their own comparison, regardless of how it comports with well-established legal standards.⁵⁹

Many troubling questions arise from this trend. Why do judges believe they can perform the extrinsic analysis of literary works better than plaintiffs' experts?⁶⁰ An extrinsic analysis is no easy feat. A judge who dismisses an expert witness, believing the subject matter within his or her grasp, effectively acts as a self-appointed expert. This is a disservice to the creators of literary works. It implies that writing a screenplay is a less complex and involved undertaking than writing a song or a software program. Moreover, the judge essentially deprives plaintiffs of their constitutional right to a jury trial. Nevertheless, this is the current state of copyright law for literary works, with no signs of rebalancing anytime soon.

In copyright infringement cases, judges are supposed to play the role of gatekeeper to the jury. Their task in analyzing substantial similarity is supposed to be extrinsic—that is, objective.⁶¹ If a plaintiff can show objective

similarity, a jury is brought in to determine whether the total concept and feel—the intrinsic test—of the plaintiff's and defendant's works are substantially similar. In practice, however, the extrinsic test has been devoured by an intrinsic test performed by the judge. Simply put, with judges able to substitute their opinions for those of experts and juries on issues of material fact, all other witnesses to the case become effectively redundant.

Case law has provided defendants with an impenetrable shield of confusing and often contradictory principles that thwart plaintiffs in nearly every instance, with only tiny cracks in that shield providing a mere glimpse of hope. Unless the Ninth Circuit seriously reexamines where courts have taken the law of copyright infringement, the cards will remain completely stacked in favor of the studios and networks. ■

¹ One case arguably did not result in a clear-cut victory for the defendant studio. See *Miller v. Miramax Film Corp.*, 2001 U.S. Dist. LEXIS 25967, at *28 (2001). However, the case achieved no final judgment on the merits. The court denied summary judgment to the defendant on the plaintiff's copyright infringement claim (much like two other cases discussed *infra*) before the case disappeared from the docket entirely.

² See *Shaw v. Lindheim*, 809 F. Supp. 1393 (C.D. Cal. 1992) (upon remand, judgment as a matter of law in favor of defendant studio); *Metcalf v. Bochco*, 294 F. 3d 1069 (9th Cir. 2002) (jury verdict in favor of defendant studio, *aff'd* *Metcalf v. Bochco*, 200 Fed. Appx. 635 (9th Cir. 2006)).

³ See 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §13.02[A] (2007).

⁴ *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F. 2d 1157, 1162 (9th Cir. 1977); *Berkic v. Crichton*, 761 F. 2d 1289, 1291 (9th Cir. 1985); *Apple Computer, Inc. v. Microsoft Corp.*, 35 F. 3d 1435, 1442 (9th Cir. 1994); *Three Boys Music Corp. v. Bolton*, 212 F. 3d 477, 481 (9th Cir. 2000).

⁵ *Id.*

⁶ *Id.*

⁷ *Three Boys Music*, 212 F. 3d at 482.

⁸ *Morrissey v. Procter & Gamble Co.*, 379 F. 2d 675, 677 (1st Cir. 1967).

⁹ *Bevan v. Columbia Broad. Sys.*, 329 F. Supp. 601, 609 (D.C. N.Y. 1971).

¹⁰ *Id.* at 610.

¹¹ See *Jorgensen v. Epic/Sony Records*, 351 F. 3d 46 (2d Cir. 2003); *Meta-Film Assocs., Inc. v. MCA, Inc.*, 586 F. Supp. 1346 (C.D. Cal. 1984).

¹² *Meta-Film*, 586 F. Supp. at 1355-56.

¹³ See *Mestre v. Vivendi Universal U.S. Holding Co.*, 2005 WL 1959295 (D. Or. 2005), *aff'd*, 273 Fed. Appx. 631 (9th Cir. 2008); *Merrill v. Paramount Pictures Corp.*, 2005 WL 3955653 (C.D. Cal. 2005).

¹⁴ *Meta-Film*, 586 F. Supp. at 1358.

¹⁵ *Id.* at 1359 (analyzing and distinguishing *Kamar Int'l, Inc. v. Russ Berrie & Co.*, 657 F. 2d 1059 (9th Cir. 1981)).

¹⁶ See *Merrill*, 2005 WL 3955653, at *8 (citing only *Meta-Film*'s three categories as a requirement for access); *Mestre*, 2005 WL 1959295, at *5 (applying the three categories as limiting but adding the requirement that "at a minimum, the dealings between the plaintiff and the intermediary and between the intermediary and the alleged copier must involve some

overlap in subject matter"); *Weygand v. CBS Inc.*, 43 U.S.P.Q. 2d 1120, 1123 (C.D. Cal. 1997) (ignoring the three categories altogether, and instead citing general *Meta-Film* language as a catch-all provision: "courts have found access when...an individual in a position to provide suggestions or comments with respect to the defendant's work...had the opportunity to view the plaintiff's work").

¹⁷ The Ninth Circuit has cited *Meta-Film* but never for this proposition. See *Cleary v. News Corp.*, 30 F. 3d 1255, 1263 (9th Cir. 1994); *E. W. French & Sons v. General Portland*, 885 F. 2d 1392, 1401 (9th Cir. 1989); *Lloyd v. Schlag*, 884 F. 2d 409, 414 (9th Cir. 1989); *Little Oil Co. v. Atlantic Ritchfield Co.*, 852 F. 2d 441, 445 (9th Cir. 1988).

¹⁸ *Jorgensen v. Epic/Sony Records*, 351 F. 3d 46 (2d Cir. 2003).

¹⁹ Nick Gladden, *When California Dreamin' Becomes a Hollywood Nightmare: Copyright Infringement and the Motion Picture Screenplay: Toward an Improved Framework*, 10 J. INTELL. PROP. L. 359, 359-84 (2003).

²⁰ One unreported case may offer some hope for creators. See *Miller v. Miramax Film Corp.*, 2001 U.S. Dist. LEXIS 25967, at *28 (2001) (holding that evidence of a screenplay submitted to Universal Pictures, along with evidence that agents were common to the writers of both works, was sufficient to preclude summary judgment on access).

²¹ See *Benay v. Warner Bros. Entm't, Inc.*, 607 F. 3d 620 (9th Cir. Cal. 2010); *Funky Films, Inc. v. Time Warner Entm't Co., L.P.*, 462 F. 3d 1072 (9th Cir. 2006); *Mestre*, 2005 WL 1959295, at *5; *Zella v. E. W. Scripps Co.*, 529 F. Supp. 2d 1124 (C.D. Cal. 2007).

²² 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §13.03[D] (2007).

²³ *Kouf v. Walt Disney Pictures & Television*, 16 F. 3d 1042, 1045 (9th Cir. 1994) (citation and internal quotation marks omitted).

²⁴ *Metcalf v. Bochco*, 294 F. 3d 1069, 1074 (9th Cir. 2002), *aff'd* *Metcalf v. Bochco*, 200 Fed. Appx. 635 (9th Cir. 2006) ("The particular sequence in which an author strings a significant number of unprotectable elements can itself be a protectable element.").

²⁵ See *Shaw v. Lindheim*, 809 F. 2d 1353, 1362 (1990) (quoting *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F. 2d 49, 56 (2d Cir. 1936)); *Aliotti v. R. Dakin & Co.*, 831 F. 2d 898, 901 (9th Cir. 1987) ("Dissection of dissimilarities is inappropriate because it distracts a reasonable observer from a comparison of the total concept and feel of the works."); 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §13.03[B][1][a] (2007).

²⁶ See *Weitzenkorn v. Lesser*, 256 P. 2d 947 (Cal. 1953) (en banc); *Morse v. Fields*, 127 F. Supp. 63 (S.D. N.Y. 1954); *Roth Greeting Cards v. United Card Co.*, 429 F. 2d 1106 (9th Cir. 1970); *United States v. Hamilton*, 583 F. 2d 448 (9th Cir. 1978); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991); *Shaw*, 809 F. Supp. 1393; *Three Boys Music Corp. v. Bolton*, 212 F. 3d 477, 481 (9th Cir. 2000); *Fleener v. Trinity Broad. Network*, 203 F. Supp. 2d 1142 (C.D. Cal. 2001); *Metcalf*, 294 F. 3d 1069; *Satava v. Lowry*, 323 F. 3d 805 (9th Cir. 2003); *Swirsky v. Carey*, 376 F. 3d 841 (9th Cir. 2004).

²⁷ *Baxter v. MCA*, 812 F. 2d 421, 425 (9th Cir. 1987); 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §13.03[B][1][a] (2007).

²⁸ 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §2.11 (2007).

²⁹ *Feist Publ'ns*, 499 U.S. 340.

³⁰ *Metcalf*, 294 F. 3d at 1074.

³¹ *Shaw v. Lindheim*, 809 F. Supp. 1393 (C.D. Cal. 1992).

³² *Metcalf*, 294 F. 3d at 1074.

³³ *Id.* at 1073.

³⁴ *Id.* at 1074.

³⁵ See *Fleener v. Trinity Broad. Network*, 203 F. Supp. 2d 1142, 1150 (C.D. Cal. 2001) ("[C]opyright also protects the expressive act of arranging completely unprotected works. See *Apple Computer, Inc. v. Microsoft Corp.*, 35 F. 3d 1435, 1445 (9th Cir. 1994).").

³⁶ *Rice v. Fox Broad. Co.*, 330 F. 3d 1170, 1174-75 (2003) ("In analyzing the scope of copyright protection afforded to *The Mystery Magician*, we note at the outset that ideas generally do not receive protection, only the expression of such ideas do."); *Metcalf*, 294 F. 3d at 1074 ("It is true that this dichotomy between an idea and its expression is less clear when the idea and expression are 'merged' or practically indistinguishable. However, we have held that 'similarities derived from the use of common ideas cannot be protected; otherwise, the first to come up with an idea will corner the market.' *Apple*, 35 F. 3d at 1443.").

³⁷ *Rice*, 330 F. 3d at 1179. See *Mestre v. Vivendi Universal U.S. Holding Co.*, 273 Fed. Appx. 631, 632 (9th Cir. 2008) ("Moreover, even if '[t]he particular sequence in which an author strings a significant number of unprotectable elements can itself be a protectable element' in certain contexts, *Mestre* has not demonstrated sufficient similarities in sequence to qualify for such protection.") (citations omitted)).

³⁸ While the plaintiff's case in *Metcalf* was "strengthened considerably" by the defendant's concession of access, the *Metcalf* court never actually invoked the inverse ratio rule, nor did it hold that finding substantial similarity through selection and arrangement was contingent on access being admitted.

³⁹ *Funky Films, Inc. v. Time Warner Entm't Co., L.P.*, 462 F. 3d 1072, 1077 (9th Cir. 2006) (citations omitted) (emphasis in original).

⁴⁰ *Id.* at 1078.

⁴¹ 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §13.03[B][1][a] (2007).

⁴² *Shaw v. Lindheim*, 809 F. 2d 1353, 1362 (1990) (quoting *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F. 2d 49, 56 (2d Cir. 1936)).

⁴³ A "derivative work," as defined by 17 U.S.C. §101, is "a work based upon one or more pre-existing works...including any form in which a work may be recast, transformed, or adapted." 17 U.S.C. §106 provides that, subject to other sections of the Copyright Act, a copyright owner "has the exclusive rights to do and to authorize...derivative works based upon the copyrighted work."

⁴⁴ *Benay v. Warner Bros. Entm't, Inc.*, 607 F. 3d 620 (9th Cir. 2010).

⁴⁵ *Id.* at 622.

⁴⁶ *Id.* at 622-23.

⁴⁷ *Benay v. Warner Bros. Entm't*, 2008 U.S. 9th Cir. Briefs 55719 (9th Cir. June 9, 2009) ("Defendants copied plaintiffs' work right down to the historical inaccuracy of cannons being new when in fact cannons date back to the fourteenth century.").

⁴⁸ *Benay*, 607 F. 3d at 629.

⁴⁹ *Id.* at 625 ("We agree with the district court that '[w]hile on cursory review, these similarities may appear substantial, a closer examination of the protectable elements including plot, themes, dialogue, mood, setting, pace, characters, and sequence of events, exposes many more differences than similarities between Plaintiffs' Screenplay and Defendants' film.").

⁵⁰ *Id.* at 629, 633.

⁵¹ See *Rokos v. Peck*, 182 Cal. App. 3d 604, 617-18 (1986) (holding that an implied-in-fact contract between the plaintiff and the writer was effective only between them).

⁵² While copyright law allows for recovery of actual damages and profits resulting from the infringement, a breach of contract allows recovery of damages only for the amount the plaintiff would have received under the contract. See 17 U.S.C.A. §504; RESTATEMENT

(SECOND) OF CONTRACTS §345; Benay, 607 F. 3d 620.

⁵³ In *Montz v. Pilgrim Films & TV, Inc.*, decided less than a week before *Benay*, the court affirmed the defendants' motion to dismiss on the grounds that the plaintiff's implied-in-fact contract claim was "merely derivative" of the plaintiff's rights under 17 U.S.C. §106 and was thus preempted by federal copyright law. *Montz v. Pilgrim Films & TV, Inc.*, 606 F. 3d 1153, 1159 (9th Cir. 2010). *Montz* thus stands as another major blow for creators, who saw a chance to protect their works through implied contract claims based on earlier Ninth Circuit cases. See *Grosso v. Miramax Film Corp.*, 2004 U.S. App. LEXIS 28043 (holding that the implied promise to pay constituted an extra element for preemption purposes that transformed the action from one arising under the ambit of federal copyright law to one sounding in contract).

⁵⁴ See *Funky Films, Inc. v. Time Warner Entm't Co.*, L.P., 462 F. 3d 1072, 1076 (9th Cir. 2006); *Berkic v. Crichton*, 761 F. 2d 1289, 1292 (9th Cir. 1985); *Litchfield v. Spielberg*, 736 F. 2d 1352, 1355 (9th Cir. 1984); *Shaw v. Lindheim*, 809 F. Supp. 1393, 1355 (C.D. Cal. 1992).

⁵⁵ In re *Apple Computer Sec. Litig.*, 886 F. 2d 1109, 1116 (9th Cir. 1989) (citing *Bieghler v. Kleppe*, 633 F. 2d 531, 534 (9th Cir. 1980) ("As a general rule, summary judgment is inappropriate where an expert's testimony supports the nonmoving party's case.")).

⁵⁶ *Wylar Summit P'ship v. Turner Broad. Sys., Inc.* 235 F. 3d 1184, 1192 (9th Cir. 2000) ("Weighing the credibility of conflicting expert witness testimony is the province of the jury.").

⁵⁷ See *Rice v. Fox Broad. Co.*, 330 F. 3d 1170 (2003) (holding that district court did not abuse its discretion in disregarding the testimony of plaintiff's expert); *Betha v. Burnett*, 2005 WL 1720631, at *12 (C.D. Cal. 2005) (ignoring plaintiff's expert's testimony, finding it unhelpful to the court's own analytic dissection); *Shaw v. Lindheim*, 809 F. Supp. 1393 (C.D. Cal. 1992) (disregarding plaintiff's expert's testimony in overturning jury verdict in favor of plaintiff); *Funky Films*, 462 F. 3d at 1076 ("[T]he district court conducted an independent analysis of [the works]."); *Gable v. NBC*, 2010 U.S. Dist. LEXIS 77772, at *59 (C.D. Cal. 2010) ("Expert testimony is far less critical in a case like this than it is in a case where specialized knowledge is required to dissect the objective components of the copyrighted work.").

⁵⁸ *Fleener v. Trinity Broad. Network*, 203 F. Supp. 2d 1142, 1147 (C.D. Cal. 2001) (denying defendants' requests for reconsideration and summary adjudication based on substantial similarities between the two works).

⁵⁹ But see *Swirsky v. Carey*, 376 F. 3d 841, 846 (9th Cir. 2004) (The district court's dismissal of expert testimony and use of its own substantial similarity analysis to discount similarities between the two works as scenes a faire was erroneous.) (quoting *Brown Bag Software v. Symantec Corp.*, 960 F. 2d 1465, 1472 (9th Cir. 1992)).

⁶⁰ See *Brown Bag Software*, 960 F. 2d at 1473-74 (relying on expert testimony in order to identify the objective points of comparison among different computer software programs); *Swirsky*, 376 F. 3d at 847-48 (relying on expert testimony comparing the objective elements—pitch, melodies, baselines, tempo, chords, structure, and harmonic rhythm—of musical works).

⁶¹ In re *Apple Sec. Litig.*, 886 F. 2d 1109, 1442 (9th Cir. 1989) (citing *Brown Bag Software*, 960 F. 2d at 1475; *Shaw v. Lindheim*, 919 F. 2d 1353, 1357 (9th Cir. 1990)) ("[T]he extrinsic test now objectively considers whether there are substantial similarities in both ideas and expression, whereas the intrinsic test continues to measure expression subjectively.").



LOWE LAW

A professional law corporation emphasizing
Entertainment, Art and Business Law



Since 1991, Lowe Law has provided
cutting-edge, aggressive, yet strategic legal
services with an extremely high success rate.

Practice Areas

- Civil Trial Practice
- Entertainment Law
- Art Law
- Intellectual Property
- Idea Theft
- Copyright Infringement
- Trademark Infringement
- Corporate Law
- Contracts
- Licensing
- Defamation
- Privacy & Publicity Rights
- Business Formations

Contact Us

Phone : 310-477-5811 Fax : 310-477-7672
11400 Olympic Blvd. Suite 640, Los Angeles, CA 90064

In addition to those listed in *Death of Copyright*, the following recent copyright infringement cases in the 2nd and 9th Circuits have also resulted in studio victories:

- *Bernal v. Paradigm Talent & Literary Agency*
2010 U.S. Dist. LEXIS 142573 (C.D. Cal. Feb. 22, 2010)
--Desperate Housewives
- *Campbell v. Walt Disney Co.*
718 F. Supp. 2d 1108 (D. Cal. May 7, 2010)
--Cars
- *Novak v. Warner Bros Pictures, LLC*
387 Fed. Appx. 747 (9th Cir. Cal. July 15, 2010)
--We Are Marshall
- *Clements v. Screen Gems, Inc.*
2010 U.S. Dist. LEXIS 132186 (C.D. Cal. Dec. 13, 2010)
--Stomp the Yard
- *Buggs v. Dreamworks, Inc.*
2010 U.S. Dist. LEXIS 141515 (C.D. Cal. Dec. 28, 2010)
--Flushed Away
- *Muller v. Twentieth Century Fox Film Corp.*
2011 U.S. Dist. LEXIS 34288 (S.D.N.Y. Mar. 30, 2011)
--Alien vs. Predator
- *Goldberg v. Cameron*
2011 U.S. Dist. LEXIS 36840 (N.D. Cal. Apr. 4, 2011)
--Terminator
- *Wild v. NBC Universal, Inc.*
2011 U.S. Dist. LEXIS 62989 (C.D. Cal. May 24, 2011)
--Heroes
- *Alexander v. Murdoch*
2011 U.S. Dist. LEXIS 79503 (S.D.N.Y. July 14, 2011)
--Modern Family

Substantial Similarity Sample Comparison Chart

Comparison Chart: *Metcalf* (2002) v. *Funky Films* (2006)

Metcalf v. Bochco 294 F.3d 1069, 1073-74 (2002)	Funky Films, Inc. v. Time Warner 462 F.3d 1072, 1077-78 (2006)
<ul style="list-style-type: none"> Concerns an overburdened county hospital in inner-city Los Angeles with mostly black staff. 	<ul style="list-style-type: none"> Concerns a small family-owned funeral home and the lives of the family members who operate it.
<ul style="list-style-type: none"> Deals with issues of poverty, race relations and urban blight. 	<ul style="list-style-type: none"> Deals with issues of death, relationships, and sex.
<ul style="list-style-type: none"> Main characters are young, good-looking, muscular black surgeons. 	<ul style="list-style-type: none"> Main characters are brothers who inherit equal shares of the business after the sudden death of their father.
<ul style="list-style-type: none"> Both surgeons grew up in the neighborhood of the hospital. 	<ul style="list-style-type: none"> Both older brothers live in a distant city, working outside the funeral industry.
<ul style="list-style-type: none"> Both surgeons wrestle to decide between lucrative private practice and the rewards of working in the inner city. 	<ul style="list-style-type: none"> Both older sons wrestle to decide between selling off the family business and trying to save it from dilapidation.
<ul style="list-style-type: none"> In both works, the hospital's bid for reaccreditation is vehemently opposed by a Hispanic politician. 	<ul style="list-style-type: none"> In both works, the brothers are approached by a rival funeral home hoping to buy their business with a lowball offer.
<ul style="list-style-type: none"> Both surgeons are romantically involved with young professional women when they arrive at the hospital, but develop strong attractions to once-married and childless hospital administrators in their thirties. The attractions flourish and culminate in a kiss, but are strained when the administrator observes a display of physical intimacy between the surgeon and his original love interest. 	<ul style="list-style-type: none"> Both businesses are shown to be financially fragile at the beginning of their stories, in debt and operating out of substandard facilities with obsolete equipment and a hearse that stalls. In the process of reviving the businesses, the other brother creatively uses the funeral home parlor to stage musical entertainment, while the younger brother changes his church affiliation to increase the client bases of the business.

Aside from the final points of comparison in Metcalf and Funky Films, all the similarities *acknowledged by the courts* are near identical in type and degree. Yet in Metcalf, the court finds a material issue of fact on substantial similarity and reverses the grant of summary judgment to the defendant (294 F.3d at 1073-74), while in Funky Films, the court takes up the role of fact-finder and proceeds to distinguish the similarities on its own accord (462 F.3d at 1077-81)



Lou Shaw; Eastborne Productions, Inc., Plaintiffs-Appellants, v. Richard Lindheim; Michael Sloan; Universal City Studios, Inc.; Columbia Broadcasting Systems; MCA Television, Ltd., Defendants-Appellees

No. 88-6677

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

919 F.2d 1353; 1990 U.S. App. LEXIS 12020; 15 U.S.P.Q.2D (BNA) 1516; Copy. L. Rep. (CCH) P26,606

June 5, 1990, Argued and Submitted, Pasadena, California

July 17, 1990, Filed

SUBSEQUENT HISTORY: [**1] Rehearing Denied and Suggestion for Rehearing En Banc Rejected November 23, 1990, Reported at *1990 U.S. App. LEXIS 20420*. As Corrected November 23, 1990. Correction Order Reported at *1990 U.S. App. LEXIS 20420*.

PRIOR HISTORY: Appeal from the United States District Court for the Central District of California; D.C. No. CV-87-6926-AHS; Alicemarie H. Stotler, District Judge, Presiding. Previously Reported at *908 F.2d 531*.

DISPOSITION: AFFIRMED IN PART, REVERSED AND REMANDED IN PART.

COUNSEL: Richard D. Aldrich, Westlake Village, California, for the Plaintiffs-Appellants.

Louis P. Petrich, Leopold, Petrich & Smith, Los Angeles, California, for the Defendants-Appellees.

JUDGES: Arthur L. Alarcon, Melvin Brunetti and Diarmuid F. O'Scannlain, Circuit Judges. Opinion by Judge Alarcon.

OPINION BY: ALARCON

OPINION

[*1355] ALARCON, Circuit Judge.

Lou Shaw and Eastbourne Productions, Inc. (Shaw) appeal from a grant of summary judgment in favor of Richard Lindheim, Michael Sloan, and three entertainment corporations (defendants). On appeal, Shaw argues that the district court erred in finding that, as a matter of law, there was no [**2] substantial similarity between his script entitled "The Equalizer" and defendants' pilot script for their "Equalizer" television series. Because a reasonable trier of fact could have found that the two works are substantially similar, Shaw argues, the district court erred in dismissing his copyright and Lanham Act claims on summary judgment. We reverse and remand.

STATEMENT OF THE CASE

Lou Shaw is a well-known writer and producer in the entertainment industry in Los Angeles. At one time during the 1976-1977 television season, there were eight network television programs on the air that Shaw had created, written for, or produced.¹ In February 1978, Shaw entered into an option

contract with Richard Lindheim, an executive in the Dramatic Programming Division of NBC Television, that granted NBC the option to develop "The Equalizer," a pilot script created by Shaw, into a television series. Shaw delivered the script to Lindheim on July 27, 1978. Lindheim read Shaw's script. Because NBC declined to produce it, all rights in the script reverted back to Shaw.

1 These series were "Quincy," "Nancy Drew," "McCloud," "Columbo," "Switch," "Maude," "Six Million Dollar Man," and "Barnaby Jones." Shaw has also been a writer for such television mainstays as "Mission: Impossible," "Ironside," "Love American Style," and "The Munsters."

[**3] Lindheim left NBC in 1979 and began work for Universal Television. In 1981, Lindheim wrote a television series treatment entitled "The Equalizer." Lindheim admits that he copied the title of his treatment from Shaw's script. In 1982, defendant Michael Sloan expanded Lindheim's treatment, and the revised version became the pilot script for defendants' Equalizer series, which was broadcast on CBS beginning in 1985.

On November 19, 1987, Shaw filed an action for copyright infringement and unfair competition, alleging that defendants' pilot script and series were substantially similar to the script he had submitted. On August 8, 1988, defendants moved for summary judgment. On October 28, 1988, the district court found that there was no substantial similarity between the two works as a matter of law and granted summary judgment on Shaw's copyright and Lanham Act claims. Shaw timely appeals.

STANDARD OF REVIEW

We review a grant of summary judgment de novo. *Narell v. Freeman*, 872 F.2d 907, 909 (9th Cir. 1989). "Although [**4] summary judgment is not highly favored on questions of substantial similarity in copyright cases, summary judgment is

appropriate if the court can conclude, after viewing the evidence and drawing inferences in a manner most favorable to the non-moving party, that no reasonable juror could find substantial similarity of ideas and expression." *Id.* at 909-10. We have frequently affirmed summary judgment in favor of copyright defendants on the issue of substantial similarity. *See Worth v. Selchow & Righter Co.*, 827 F.2d 569, 571 (9th Cir. 1987) (citing cases), *cert. denied*, 485 U.S. 977, 99 L. Ed. 2d 482, 108 S. Ct. 1271 (1988). Where reasonable minds could differ on the issue of substantial similarity, however, summary judgment is improper. *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327, 1329-30 (9th Cir. 1983) (reversing a grant of summary judgment because reasonable minds could differ as to whether the television series "Battlestar: Galactica" infringed on the motion picture "Star Wars"); *Baxter v. MCA, Inc.*, 812 F.2d 421, 425 [**5] (9th Cir.) (same as to the composition "Joy" and the [*1356] theme from "E.T."), *cert. denied*, 484 U.S. 954, 108 S. Ct. 346, 98 L. Ed. 2d 372 (1987).

DISCUSSION

I. Copyright Claim

Copyright law protects an author's expression; facts and ideas within a work are not protected. *Narell*, 872 F.2d at 910. To establish a successful copyright infringement claim, Shaw must show that he owns the copyright and that defendant copied protected elements of the work. *Id.* Because, in most cases, direct evidence of copying is not available, a plaintiff may establish copying by showing that the infringer had access to the work and that the two works are substantially similar. *Id.* The defendants conceded Shaw's ownership of the original Equalizer script and their access to the script for purposes of the summary judgment motion. As a result, the only issue before the district court on the copyright claim was whether defendants' version of the Equalizer is substantially similar to Shaw's original script.

Any test for substantial similarity is necessarily [**6] imprecise:

"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 of only 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."

Sid & Marty Krofft Television Prods. Inc. v. McDonald's Corp., 562 F.2d 1157, 1163 (9th Cir. 1977) (quoting *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930), cert. denied, 282 U.S. 902, 75 L. Ed. 795, 51 S. Ct. 216 (1931)). It is thus impossible to articulate a definitive demarcation that measures when the similarity between works involves copying of protected expression; decisions must inevitably be ad hoc. *Id.* at 1164 (citing *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (L. Hand, J.)); see also *Comment*, [**7] Does Form Follow Function?, 35 *UCLA L. Rev.* 723 (1988) (discussing the difficulty of demarcating the idea-expression line).

A. The Krofft Framework

The Ninth Circuit employs a two-part test for determining whether one work is substantially similar to another. *Narell*, 872 F.2d at 912; *Olson v. National Broadcasting Co.*, 855 F.2d 1446, 1448 (9th Cir. 1988). Established in *Sid & Marty Krofft Television Prods. Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977), the test permits a finding of infringement only if a plaintiff proves

both substantial similarity of general ideas under the "extrinsic test" and substantial similarity of the protectable expression of those ideas under the "intrinsic test." *Olson*, 855 F.2d at 1449; *Krofft*, 562 F.2d at 1164.

1. Scope of the *Krofft* Tests

Krofft defined the extrinsic test as a "test for similarity of ideas" under which "analytic [**8] dissection and expert testimony are appropriate." 562 F.2d at 1164. The intrinsic test, according to *Krofft*, should measure "substantial similarity in expressions . . . depending on the response of the ordinary reasonable person. . . . It does not depend on the type of external criteria and analysis which marks the extrinsic test." *Id.* In decisions under the intrinsic test, "analytic dissection and expert testimony are not appropriate." *Id.*

Relying on this language, panels applying *Krofft* to literary works have included a lengthy list of concrete elements under the extrinsic test. Whereas *Krofft* listed "the type of artwork involved, the materials used, the subject matter, and the setting for the subject" as criteria for consideration under the extrinsic test, *id.*, a series of opinions beginning with the district court opinion in *Jason v. Fonda*, 526 F. Supp. 774 (C.D. Cal. 1981), *aff'd and incorporated by reference*, 698 F.2d 966 (9th Cir. 1982), [**9] have listed "plot, themes, dialogue, mood, setting, pace, and sequence" [*1357] as extrinsic test criteria. 526 F. Supp. at 777; see also *Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir. 1984) (repeating this list), cert. denied, 470 U.S. 1052, 84 L. Ed. 2d 817, 105 S. Ct. 1753 (1985); *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir.) (same), cert. denied, 474 U.S. 826, 88 L. Ed. 2d 69, 106 S. Ct. 85 (1985); *Olson*, 855 F.2d at 1450 (same); *Narell*, 872 F.2d at 912 (adding "characters" to the list and transforming "sequence" into "sequence of events").

Now that it includes virtually every element that may be considered concrete in a literary work,

the extrinsic test as applied to books, scripts, plays, and motion pictures can no longer be seen as a test for mere similarity of ideas. Because the criteria incorporated into the extrinsic test encompass all objective manifestations of creativity, the two tests are more sensibly described as objective and subjective [**10] analyses of *expression*, having strayed from *Krofft's* division between expression and ideas. See *Narell*, 872 F.2d at 912 (referring to an *objective*, extrinsic test and a *subjective*, intrinsic test); *Berkic*, 761 F.2d at 1292 (same); *Litchfield*, 736 F.2d at 1356 (same). But see *Olson*, 855 F.2d at 1448-49 (adhering to *Krofft's* idea/expression distinction). Indeed, a judicial determination under the intrinsic test is now virtually devoid of analysis, for the intrinsic test has become a mere subjective judgment as to whether two literary works are or are not similar. See *Berkic*, 761 F.2d at 1294 (reaching a result under the intrinsic test in one paragraph); *Olson*, 855 F.2d at 1453 (same).

2. The District Court's Application of *Krofft*

An example of how the absence of legal analysis may frustrate appellate review of the intrinsic test is the district court's order in this matter. The district court found, after extensive analysis, that reasonable minds might conclude that plaintiffs' and defendants' works were substantially similar as to the objective characteristics [**11] of theme, plot, sequence of events, characters, dialogue, setting, mood, and pace. Nevertheless, the court made a subjective determination under the intrinsic test that *no* reasonable juror could determine that the works had a substantially similar total concept and feel. The district court order reads in part:

2. *Application of the Extrinsic Test*

Under the first part of *Krofft's* two-part test, the plaintiff must prove that the general ideas in both the plaintiffs' and defendants' works are substantially similar. . . .

. . . .

a. Theme

The theme of both works revolves around the main character, the Equalizer, -- "a man who will equalize the odds, a lone man working outside the system to protect his underdog clients and to resolve their predicaments as a part of his rough notion of justice." . . . Beyond the defendants' superficial evaluation of the themes of both works, one discovers some similarity. For example, plaintiffs' lead character describes his job as "the greatest thing a man could do with his life . . . [that is] help give somebody an even shot, shake up the odds a little;" while defendants' lead character tells a client that his job is to [**12] "Equalize the odds. Put the odds in your favor."

b. Plot

A comparison of the plots of both works reveals significant similarities and differences. For example, both works involve a cover up/blackmail conspiracy and a woman who is in jeopardy, however, in defendants' work the main character takes on two cases whereas plaintiffs' Equalizer has only one client. A review of plaintiffs' expert's analysis reveals substantial similarities between the respective works, yet, as defendants point out many of these comparisons are taken out of order or context. For example, both works involve a criminal organization that blackmails a public official. The defendants' Equalizer, however, involves a tight blackmail ring, operated out of the corporate

headquarters of a telecommunication company in New York city, whereas plaintiffs' criminal organization is described as a Mafia that controls [*1358] the Boyle Heights Chicano Community of Los Angeles.

Despite these dissimilarities, the respective plots do parallel each other. Dr. Seger's declaration illustrates how the plots in both scripts share a common sequence and rhythm. *See* Seger Dec. at p. 51.

c. Characters and Dialogue
[**13]

Both parties' scripts have similar lead characters. In defendants' story, McCall, the former spy turned Equalizer is motivated by past wrongs and seems intent on helping any underprivileged person who faces insurmountable odds. Plaintiffs' lead character, Jericho, also seeks to prevent injustice, however, as defendants point out his motivations are often unclear. Both leads are well educated, wealthy and have expensive tastes. The most striking similarity between the McCall and Jericho is their self-assuredness, and unshakable faith in the satisfactory outcome of any difficult situation.

Although certain characters (such as Erica in plaintiffs' script) are not duplicated in defendants' work, their absence is not of major significance when considering both stories in their entirety. Instead many of defendants' characters share similar traits with plaintiffs' characters. Examples include the clients, Tracy Rollins and Colleen Randall; the candidates, Kale

and Blanding; the cover up villains, Rivera and Morgan; the former colleagues/inside contacts, Fleming and Brahms. Such a parallel may go unnoticed, however, when considering the overall format of each work.

The dialogue in the [**14] respective works do share some striking similarities. Plaintiffs' expert has set forth, side-by-side, dialogue from a variety of characters which almost match. *See* Seger Dec. at 60.

Utilizing the extrinsic test adopted in *Krofft* it appears that reasonable minds might differ as to the substantial similarity between the protected *ideas* of the respective works.

3. *Application of the Intrinsic Test*

The second step of the *Krofft* analysis requires the trier of fact to decide whether there is substantial similarity in the expression of the ideas so as to constitute copyright infringement. *Krofft*, 562 F.2d at 1164. This second step is called the intrinsic or audience test, because it depends on the response of the ordinary reasonable person. *Id.* The Court must determine whether reasonable minds can differ as to whether defendants' Equalizer captured the total "concept and feel" of plaintiffs' scripts. . . .

. . . Reasonable minds could not differ as to whether the total concept and feel of the respective Equalizer works is substantially similar [under the intrinsic test]. Although general

similarities between the works exist, plaintiffs [**15] have failed to establish that enough protected *expression* is infringed to warrant denial of defendants' Motion for Summary Judgment.

The district court's decision to grant summary judgment solely on a subjective assessment under *Krofft's* intrinsic test conflicts with the prescriptions of *Krofft*. In *Krofft*, this court stated that the outcome of the extrinsic test "may often be decided as a matter of law." 562 F.2d at 1164. In contrast, "if there is substantial similarity in ideas, then *the trier of fact* must decide [under the intrinsic test] whether there is substantial similarity in the expressions of the ideas so as to constitute infringement." *Id.* (emphasis added); *see also id.* at 1166 ("The intrinsic test for expression is uniquely suited for determination by *the trier of fact*." (emphasis added)). Professor Nimmer has also noted that "the second step in the [*Krofft*] analytic process requires that *the trier of fact* then decide 'whether there is substantial similarity in the expressions of the ideas so as [**16] to constitute infringement.'" 3 M. Nimmer, *Nimmer on Copyright* § 13.03[E][3], at 62.14 (1989) [hereinafter *Nimmer on Copyright*].

3. *Krofft* and the Summary Judgment Standard

The test for summary judgment in a copyright case must comport with the standard [*1359] applied to all civil actions. The Supreme Court recently explained the standard for granting a summary judgment in *Celotex Corporation v. Catrett*, 477 U.S. 317, 91 L. Ed. 2d 265, 106 S. Ct. 2548 (1986), and *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986). "Under *Rule 56(c)*, summary judgment is proper 'if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of

law.'" *Celotex*, 477 U.S. at 322 (quoting *Fed. R. Civ. P. 56(c)*). The inquiry is "whether the evidence presents a sufficient disagreement to require submission to a jury [**17] or whether it is so one-sided that one party must prevail as a matter of law." *Anderson*, 477 U.S. at 251-52. The Court in *Celotex* elaborated:

In our view, the plain language of *Rule 56(c)* mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial. In such a situation, there can be "no genuine issue as to any material fact," since a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial. The moving party is "entitled to a judgment as a matter of law" because the nonmoving party has failed to make a sufficient showing on an essential element of her case with respect to which she has the burden of proof.

477 U.S. at 322-23.

We must determine in this matter whether a party that demonstrates a triable issue of fact under the extrinsic test has made a sufficient showing of substantial similarity to defeat a summary judgment motion. As noted [**18] above, the extrinsic test focuses on "specific similarities between the plot, theme, dialogue, mood, setting, pace, characters, and sequence of events. . . . 'the actual concrete elements that make up the total sequence of events and the relationships between the major characters.'" *Narell*, 872 F.2d at 912 (quoting *Berkic*, 761 F.2d at 1293). These are the

measurable, objective elements that constitute a literary work's expression. Because these elements are embodied in the extrinsic test, we hold that it is improper for a court to find, as the district court did, that there is no substantial similarity as a matter of law after a writer has satisfied the extrinsic test. To conclude otherwise would allow a court to base a grant of summary judgment on a purely subjective determination of similarity. This result would conflict with the Court's instruction in *Anderson*, that "at the summary judgment stage, the judge's function is not [herself] to weigh the evidence and determine the truth of the matter but to determine whether there is a genuine issue [*19] for trial." 477 U.S. at 249.

The rule we announce today -- that satisfaction of the extrinsic test creates a triable issue of fact in a copyright action involving a literary work -- is in harmony with our prior decisions. Although various panels of this circuit have affirmed grants of summary judgment on the issue of substantial similarity between books, scripts, films, or plays, none of these decisions have rested on application of the intrinsic test alone. See *Narell*, 872 F.2d at 912-13 (failure to satisfy both tests); *Olson*, 855 F.2d at 1450-53 (same); *Berkic*, 761 F.2d at 1293-94 (same); *Litchfield*, 736 F.2d at 1356-57 (same); *See v. Durang*, 711 F.2d 141, 143 (9th Cir. 1983) (per curiam) (not specifying either test, but engaging in the dissection and analysis appropriate under the extrinsic test); *Jason v. Fonda*, 698 F.2d 966 (9th Cir. 1982) (incorporating by reference *Jason v. Fonda*, 526 F. Supp. 774, 777 (C.D. Cal. 1981)) (failure to satisfy [*20] both tests).

Defendants point to *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901-02 (9th Cir. 1987), and *Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d 204 (9th Cir. 1988), as cases in which we have indicated that it is proper for a court to engage in a subjective assessment [*1360] of substantial similarity in ruling on a motion for summary judgment. In *Aliotti*, we affirmed a grant of summary judgment

based upon our conclusion that the stuffed dinosaur toys produced by the defendant were not substantially similar to the plaintiff's product under a "total concept and feel" standard. 831 F.2d at 902. Similarly, in *Data East* we concluded that "a discerning 17.5 year-old boy could not regard [two karate video games] as substantially similar." 862 F.2d at 209-10 (footnote omitted).

Both *Aliotti* and *Data East* relied on the principle that "no substantial similarity of expression will be found when 'the idea and its expression are . . . inseparable,' given that 'protecting the expression in such circumstances would confer a monopoly of the *idea* upon the copyright owner.'" *Data East*, 862 F.2d at 208 [*21] (quoting *Aliotti*, 831 F.2d at 901 (quoting *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971))) (emphasis in *Data East*). Thus, both cases should be read as involving a union of idea and expression. See *Kalpakian*, 446 F.2d at 742 ("On this record the 'idea' and its 'expression' appear to be indistinguishable."). Where idea and expression are unified, extending copyright protection to the objective elements of expression would grant the copyright holder a monopoly over the ideas expressed in the works, in violation of 17 U.S.C. § 102(b). See *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967) (where the topic permits only a limited amount of expression, "the subject matter would be appropriated by permitting the copyrighting of its expression") (discussing rules for a sweepstake contest involving social security numbers).

By creating a discrete set of standards for determining the objective similarity of literary works, the law of this circuit has implicitly recognized the distinction between situations in which idea and expression merge [*22] in representational objects and those in which the idea is distinct from the written expression of a concept by a poet, a playwright, or a writer. A high degree of similarity is "inevitable from the use of [the]

jewel-encrusted bee forms" at issue in *Kalpakian*, 446 F.2d at 742, or the stuffed dinosaur forms at issue in *Aliotti*, or the karate video games in *Data East*. As a result, the scope of the copyright protection afforded such works is necessarily narrow. *See id.* ("A jeweled bee pin is . . . an 'idea' that defendants were free to copy."). In contrast, there is an infinite variety of novel or creative expression available to the author of a book, script, play, or motion picture based on a preexisting idea.

Given the variety of possible expression and the objective criteria available under the extrinsic test to analyze a literary work's expression, as distinct from the ideas embodied in it, the intrinsic test cannot be the sole basis for a grant of summary judgment. Once a court has established that a triable question of objective similarity of expression [**23] exists, by analysis of each element of the extrinsic test, its inquiry should proceed no further. What remains is a subjective assessment of the "concept and feel" of two works of literature -- a task no more suitable for a judge than for a jury. This subjective assessment is not a legal conclusion; rather it involves the audience in an interactive process with the author of the work in question, and calls on us "to transfer from our inward nature a human interest and a semblance of truth sufficient to procure for these shadows of imagination that willing suspension of disbelief for the moment, which constitutes poetic faith." S. T. Coleridge, *Biographia Literaria*, ch. 14, *reprinted in 5 English Literature: The Romantic Period* (A. Reed ed. 1929). This interactive assessment is by nature an individualized one that will provoke a varied response in each juror, for what "makes the unskillful laugh, cannot but make the judicious grieve." W. Shakespeare, *Hamlet*, Act III, scene ii, ll. 27-28. It is not the district court's role, in ruling on a motion for a summary judgment, to limit the interpretive judgment of each work to that produced by its own experience.

A determination [**24] that a bee fashioned by a jeweler, or a stuffed animal produced by a toymaker, embodies an idea -- the form of [*1361] a natural creature -- that cannot be separated from its expression, primarily involves the observer's physical senses. Where idea and expression merge, a court is well-suited to make the required determination of similarity on a motion for summary judgment. A comparison of literary works, on the other hand, generally requires the reader or viewer to engage in a two-step process. The first step involves the objective comparison of concrete similarities; the second employs the subjective process of comprehension, reasoning, and understanding. The imagery presented in a literary work may also engage the imagination of the audience and evoke an emotional response. Because each of us differs, to some degree, in our capability to reason, imagine, and react emotionally, subjective comparisons of literary works that are objectively similar in their expression of ideas must be left to the trier of fact.

For these reasons, a showing of substantial similarity with reference [**25] to the eight objective components of expression in the extrinsic test applied to literary works creates a genuine issue for trial. If a district court concludes, after analyzing the objective criteria under the extrinsic test, that reasonable minds might differ as to whether there is substantial similarity between the protected expression of ideas in two literary works, and the record supports the district court's conclusion, there is a triable issue of fact that precludes summary judgment. This rule is necessary because our expansion of the extrinsic test as applied to literary works has incorporated all objective elements of expression, leaving a mere subjective assessment of similarity for the intrinsic test. Because such an assessment may not properly be made as a matter of law, it is for the trier of fact to determine whether the intrinsic test is satisfied. ² Accordingly, our decision in this matter turns on whether Shaw has

raised a triable issue of fact under *Krofft's* extrinsic test.

2 This is not to say that summary judgment on the issue of *expression* is never proper. See *Overman v. Universal City Studios, Inc.*, 605 F. Supp. 350, 352 (C.D. Cal. 1984) (Rymer, J.) (attributing this view to Nimmer and refuting it), *aff'd* without opinion, 767 F.2d 933 (9th Cir. 1985); *Nimmer on Copyright* § 13.03 [E][3], at 62-15 n. 251 (denying adherence to this view). When a plaintiff demonstrates an issue of fact as to the objective components of expression now embodied in the extrinsic test, however, it is improper to grant summary judgment based on a subjective assessment under the intrinsic test alone.

[**26] B. The Extrinsic Test

1. Role of Access

Although access was not an issue before the district court for purposes of the defendants' summary judgment motion, we must consider defendants' access to Shaw's script in determining substantial similarity. The holding in *Krofft* itself rested in part on a finding that the defendants' "degree of access justifies a lower standard of proof to show substantial similarity." 562 F.2d at 1172. As we stated in *Krofft*:

No amount of proof of access will suffice to show copying if there are no similarities. This is not to say, however, that where clear and convincing evidence of access is presented, the quantum of proof required to show substantial similarity may not be lower than when access is shown merely by a preponderance of the evidence. As Professor Nimmer has observed:

"Clear and convincing evidence of access will not avoid the necessity of also proving substantial similarity since access without similarity cannot create an inference of copying. However this so-called 'Inverse Ratio Rule' . . . would seem to have [**27] some limited validity. That is, since a very high degree of similarity is required in order to dispense with proof of access, it must logically follow that *where proof of access is offered, the required degree of similarity may be somewhat less* than would be necessary in the absence of such proof."

Id. (quoting 2 M. Nimmer, *Nimmer on Copyright* § 143.4, at 634 (1976) (citations omitted)) (emphasis added). *But see Aliotti*, 831 F.2d at 902 (questioning, in dictum, the "continuing viability of Professor Nimmer's proposal"). Because no subsequent decision has disturbed the access rule established [*1362] in *Krofft*, we believe that it is the law of this circuit. Thus, defendants' admission that they had access to Shaw's script is a factor to be considered in favor of Shaw.

2. Effect of Identical Title on Substantial Similarity

The fact that the two works have identical titles also weighs in Shaw's favor. In *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946), the Second Circuit held that "[a] title cannot be copyrighted." *Id.* at 474. This is true in the sense that titles, in and of

themselves, cannot [**28] claim statutory copyright. 1 M. Nimmer, *Nimmer on Copyright*, § 2.16, at 2-186 (1989). Nevertheless, "if the copying of a title is not an act of copyright infringement, it may . . . have copyright significance as one factor in establishing whether the substance of plaintiff's work (not the title) has been copied." *Id.* at 2-188. As the Seventh Circuit has stated, "the title of a copyrighted work should be taken into account when the same title is applied to a work [allegedly] copied from it." *Wihtol v. Wells*, 231 F.2d 550, 553 (7th Cir. 1956); see also *Robert Stigwood Group, Ltd. v. Sperber*, 457 F.2d 50, 55 (2d Cir. 1972) ("The admitted desire of defendants to make reference to [the title 'Jesus Christ Superstar'] in its advertisement provides further evidence that the performance is intended to come as close as possible to the original dramatic co-musical."). Thus, we acknowledge and consider defendants' admitted copying of Shaw's title in determining whether there is substantial similarity of protected expression between the two works.

[**29] 3. The Extrinsic Test Applied

As noted earlier, a court applying the extrinsic test must compare "the individual features of the works to find specific similarities between the plot, theme, dialogue, mood, setting, pace, characters, and sequence of events." *Narell*, 872 F.2d at 912; *Berkic*, 761 F.2d at 1292. "The test focuses not on basic plot ideas, which are not protected by copyright, but on 'the actual concrete elements that make up the total sequence of events and the relationships between the major characters.'" *Narell*, 872 F.2d at 912 (quoting *Berkic*, 761 F.2d at 1293). Our study of the two scripts at issue reveals the following objective similarities in protected expression under the extrinsic test:

a) Theme

As the district court noted, the theme of both works revolves around the character of the Equalizer -- "a man who will equalize the odds, a

lone man working outside the system." This, in itself, is but an unprotectable idea -- the same could be said of literary characters from Aladdin to Zorro. Yet the similarity in theme extends beyond this basic idea -- the Equalizer in each script solicits [**30] clients requiring assistance that conventional law enforcement cannot offer, and each lead character describes his role as to "equalize" or "shake up" the odds. Defendants point to differences in their pilot, contending that their Equalizer is motivated by his dissatisfaction with prior covert government employment and his desire to renew his relationship with his estranged wife and son. These themes, although different, are secondary and do little to erode the similarity between the central themes embodied in the titles of the two works. "No plagiarist can excuse the wrong by showing how much of his work he did not pirate." *Nimmer on Copyright* § 13.03[B][1][a], at 13-48 to 13-49 (quoting *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir.), cert. denied, 298 U.S. 669, 80 L. Ed. 1392, 56 S. Ct. 835 (1936)). The similarity in themes in the two works before the court extends to elements of protectable expression.

b) Plot/Sequence of Events

Shaw provides a list of "26 strikingly similar events" that he claims appear in both works [**31] in substantially the same sequence. Examination of this list after a reading of both scripts, however, reveals that it is, for the most part, a compilation of "random similarities scattered throughout the works" that this court discounted in *Litchfield*. 736 F.2d at 1356. Shaw's list misrepresents the order and similarity [*1363] of many of these events, and relies heavily on "scenes a faire" -- that is, scenes that flow naturally from a basic plot premise. *Berkic*, 761 F.2d at 1293. Indeed, defendants provide a list of similarities between "The Wizard of Oz" and "Star Wars" that is virtually as compelling as Shaw's.

Shaw's overexuberance, however, does not change the fact that many of the events in the two works are substantially similar. Both works involve a criminal organization that blackmails a candidate for public office. Both organizations attempt to kill a prospective Equalizer client, who has discovered their operation, by means of an oncoming truck. In both scripts, henchmen for the criminal organization interrupt the Equalizer's initial meeting with the client, chase and shoot at the Equalizer and the client, and are foiled as the [**32] Equalizer saves the client. In both scripts, the uninvited Equalizer appears at a party in a tuxedo. In both, the Equalizer confronts the candidate/blackmail victim after a campaign speech. After thwarting the leader of the criminal conspiracy, the Equalizer rushes to save a female client from danger. The Equalizer's actions in both scripts result in the candidate/blackmail victim's withdrawal from the political race.

Even if none of these plot elements is remarkably unusual in and of itself, the fact that both scripts contain all of these similar events should give rise to a triable question of substantial similarity of protected expression. As the district court noted, "the respective plots parallel each other. . . . The plots in both scripts share a common sequence and rhythm." "Where plot is . . . properly defined as 'the "sequence of events" by which the author expresses his "theme" or "idea,"' it constitutes a pattern which is sufficiently concrete so as to warrant a finding of substantial similarity if it is common to both plaintiff's and defendant's works." *Nimmer on Copyright* [**33] § 1303[A], at 13-31 (quoting *Shipman v. RKO Radio Pictures, Inc.*, 100 F.2d 533, 537 (2d Cir. 1938)).

c) Mood, Setting and Pace

Both works are fast-paced, have ominous and cynical moods that are lightened by the Equalizer's victory, and are set in large cities. These similarities are common to any action adventure series, however, and do not weigh heavily in our decision.

d) Characters and Dialogue

As the district court noted, both the dialogue and the characters in the respective works share some striking similarities. A particularly glaring example of similar personal traits is revealed by a comparison of the principal characters in both works. As the district court found, both scripts have "similar lead characters. . . . Both leads are well dressed, wealthy and have expensive tastes. The most striking similarity is their self-assuredness, and unshakeable faith in the satisfactory outcome of any difficult situation." Although James Bond may have the Equalizers' demeanor and the Ghostbusters may have their penchant for unpopular assignments, the totality of the similarities between the two characters goes beyond the necessities of the "Equalizer" theme [**34] and belies any claim of literary accident. We find that defendants' copying of the Equalizer character and other characters extends to elements of protected expression. Because the similarities between the principals in each script and among the other common characters point to copying of more than a general theme or plot idea, they support the district court's finding that Shaw raised a triable issue of fact regarding substantial similarity under the extrinsic test.

4. Conclusion

We conclude that Shaw has satisfied the extrinsic test for literary works and thus has presented a triable issue of fact regarding substantial similarity of protected expression. "Even if a copied portion be relatively small in proportion to the entire work, if qualitatively important, the finder of fact may properly find substantial similarity." *Baxter*, 812 F.2d at 425. A reasonable trier of fact could find that the similarity between Shaw's script and defendants' pilot is not so general as to be beyond the protections of copyright law. Because [*1364] Shaw has produced a triable issue [**35] of fact under the extrinsic test, we reverse the district court's grant of summary judgment on Shaw's copyright claim.

II. *Lanham Act Claim*

The district court also granted summary judgment on Shaw's claim that defendants violated section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). Section 43(a) makes a person liable for using a false description of origin in connection with any goods or services put into commerce. 15 U.S.C. § 1125(a) (1988); *Litchfield*, 736 F.2d at 1357.

The district court based its dismissal of Shaw's Lanham Act claim on its finding that there is no substantial similarity between Shaw's script and defendants' pilot. See *Litchfield*, 736 F.2d at 1358 ("Without substantial similarity there can be no claim for reverse passing off under section 43(a)."); accord *Berkic*, 761 F.2d at 1291 n. 1. Because we reverse the district court's finding that there is no substantial similarity between the two works as a matter of law, we must decide whether a situation such [**36] as that presented here is an appropriate basis for a Lanham Act claim.

The Lanham Act explicitly condemns false designations or representations in connection with any goods or services. *Smith v. Montoro*, 648 F.2d 602, 605 (9th Cir. 1981). Section 43(a) of the Lanham Act provides:

Any person who shall affix, apply, or annex, or use in connection with any goods or services . . . a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce . . . shall be liable to a civil

action by any person . . . who believes that he is or is likely to be damaged by the use of such false description or representation.

15 U.S.C. § 1125(a) (1988). Shaw interprets the "false designation of origin" language to include [**37] instances in which a defendant has copied a product and committed "reverse passing off" by selling it under his own label. He relies on *Smith*, which held that an actor may state a claim under § 43(a) when his name is replaced with another's in a motion picture's credits.

Although this court has twice specifically reserved the question whether "reverse passing off" claims may be recognized in situations where works are substantially similar, *Litchfield*, 736 F.2d at 1358; *Kamar Int'l Inc. v. Russ Berrie & Co.*, 657 F.2d 1059, 1064 (9th Cir. 1981), *Smith* and *Lamothe v. Atlantic Recording Corp.*, 847 F.2d 1403 (9th Cir. 1988), have implicitly limited the "reverse passing off" doctrine to situations of bodily appropriation. *Smith* defined "reverse passing off" as removing or obliterating the original trademark without authorization before reselling goods produced by someone else. 648 F.2d at 605. *Smith* limited reverse passing off to two situations: "Reverse passing off is accomplished 'expressly' when the wrongdoer [**38] removes the name or trademark on another party's product and sells *that product* under a name chosen by the wrongdoer. 'Implied' reverse passing off occurs when the wrongdoer simply removes or otherwise obliterates the name of the manufacturer or source and sells *the product* in an unbranded state." *Id.* (emphasis added). *Lamothe* also defined reverse passing off as limited to these two situations, 847 F.2d at 1406, and neither case indicated that § 43(a) is applicable where the products at issue are merely substantially similar.

We are reluctant to expand the scope of § 43(a) to cover the situation presented here. Shaw's claim is not consistent with the Lanham Act's purpose of

preventing individuals from misleading the public by placing their competitors' work forward as their own. In spite of the similarities between Shaw's script and defendants' pilot, the likelihood that the two works will be confused is minimal. We decline to expand the scope of the Lanham Act to cover

cases [*1365] in which the Federal Copyright Act provides an adequate remedy. Therefore, we affirm the district court's dismissal of Shaw's Lanham Act claim.

AFFIRMED IN PART, [**39] REVERSED
AND REMANDED IN PART.



JEROME C. METCALF, an individual; LAURIE METCALF, an individual, Plaintiffs-Appellants, v. STEVEN BOCHCO, an individual; BOCHCO STEVEN PRODUCTIONS, a corporation; CBS ENTERTAINMENT, INC., a corporation; CBS PRODUCTIONS, INC., a corporation; MICHAEL L. WARREN, an individual; NICHOLAS WOOTTON, an individual; PARIS BARCLAY, an individual, Defendants-Appellees. JEROME C. METCALF, an individual; LAURIE METCALF, an individual, Plaintiffs-Appellants, v. STEVEN BOCHCO, an individual; BOCHCO STEVEN PRODUCTIONS, a corporation; CBS ENTERTAINMENT, INC., a corporation; CBS PRODUCTIONS, INC., a corporation; MICHAEL L. WARREN, an individual; NICHOLAS WOOTTON, an individual; PARIS BARCLAY, an individual, Defendants-Appellees. JEROME C. METCALF, an individual; LAURIE METCALF, an individual, Plaintiffs-Appellants, v. STEVEN BOCHCO, an individual; BOCHCO STEVEN PRODUCTIONS, a corporation; CBS ENTERTAINMENT, INC., a corporation; CBS PRODUCTIONS, INC., a corporation; MICHAEL L. WARREN, an individual; NICHOLAS WOOTTON, an individual; PARIS BARCLAY, an individual, Defendants-Appellees.

No. 01-55811, No. 01-56249, No. 01-56250

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

294 F.3d 1069; 2002 U.S. App. LEXIS 11278; 63 U.S.P.Q.2D (BNA) 1412; 2002 Cal. Daily Op. Service 5202; 2002 Daily Journal DAR 6585

March 13, 2002, Argued and Submitted, Pasadena, California

June 12, 2002, Filed

SUBSEQUENT HISTORY: Subsequent appeal at *Metcalf v. Bochco*, 2006 U.S. App. LEXIS 22244 (9th Cir. Cal., Aug. 28, 2006)

PRIOR HISTORY: [**1] Appeal from the United States District Court for the Central District of California. D.C. CV-00-04550-RJK. D.C. CV-00-04550-RJK. D.C. No. CV-00-04550-RJK. Robert J. Kelleher, Senior District Judge, Presiding.

DISPOSITION: The court of appeals reversed the district court's ruling on the merits, and also reversed the award of attorneys' fees to the defendant, Bochco.

COUNSEL: Robert F. Helfing, Sedgwick, Detert, Moran & Arnold, Los Angeles, California, argued for the plaintiffs-appellants.

Edward A. Ruttenberg, Leopold, Petrich & Smith, P.C., Los Angeles, California, argued for the

defendants-appellees. Robert S. Gutierrez, Leopold, Petrich & Smith, P.C., and Thomas M. Norminton, Norminton & Wiita, Beverly Hills, California, assisted on the brief.

JUDGES: Before: Alex Kozinski and Ronald M. Gould, Circuit Judges, and Charles R. Breyer, District Judge. * Opinion by Judge Kozinski.

* The Honorable Charles R. Breyer, United States District Judge for the Northern District of California, sitting by designation.

OPINION BY: Alex Kozinski

OPINION

[*1071] KOZINSKI, Circuit Judge: We delve once again into the turbid waters of the "extrinsic test" for substantial similarity under the Copyright Act. Facts ¹

1 Because we review a summary judgment against plaintiffs, we recite the facts as alleged by them. *San Francisco Baykeeper v. Whitman*, 287 F.3d 764, 767 (9th Cir. 2002).

[**2] In November 1989, Jerome Metcalf read two newspaper articles about the Army's practice of training surgeons at inner-city hospitals to expose them to combat-like conditions. Based on these articles, Jerome and his wife Laurie ("the Metcalfs") conceived a story about a county hospital in inner-city Los Angeles and the struggles of its predominantly black staff. Along with third party Joan Ray, the Metcalfs formed a corporation ("CCA") to develop the idea into a full-length motion picture. Jerome then discussed the idea with defendant Michael Warren, a friend and actor who had starred in television shows produced by defendant Steven Bochco, including "Hill Street Blues." Warren liked the idea and encouraged Jerome to write a project summary or "treatment," [*1072] with the promise that he would present it to Bochco.

CCA commissioned a writer to prepare a treatment based on the Metcalfs' idea. Unhappy with the result, the Metcalfs wrote their own treatment, titled it "Give Something Back," and gave it to Warren. Warren said he liked it and relayed it to Bochco. Warren later told Jerome that Bochco also liked the treatment, but declined to use it because he was busy with other projects.

[**3] CCA then hired another author to write a screenplay based on the treatment. Warren also reviewed this work, titled "As Long As They Kill Themselves," and submitted it to Bochco. Near the end of 1991, Warren again told Jerome that Bochco lacked the time to develop the Metcalfs' idea.

Undaunted, the Metcalfs revised the screenplay and retitled it "About Face." In 1992, they pitched the work to Bochco (again via Warren) and defendant CBS, but neither avenue proved fruitful. CBS explained that it had another hospital series in development at the time.

Much to the Metcalfs' surprise, on January 16, 2000, the television series "City of Angels" premiered on CBS. The pilot and first episode were produced and written by Bochco, starred Warren, and featured a county-run, inner-city hospital in Los Angeles with a predominantly black staff.

The Metcalfs filed suit in state court against Bochco, Bochco Steven Enterprises, CBS Entertainment, CBS Productions, Michael Warren, Nicholas Wootton and Paris Barclay ² (collectively, "Bochco"), alleging various claims based upon theft of literary property. Bochco removed the action to federal court. The Metcalfs filed an amended complaint that added [**4] a claim of copyright infringement. Bochco successfully moved to dismiss the Metcalfs' state-law claims, then moved for summary judgment on the remaining copyright claim. Bochco argued that the Metcalfs could not prove ownership of the allegedly copied works because the works were owned by CCA, and that

the "City of Angels" series was not substantially similar to those works.

2 Bochco, Wootton and Barclay were jointly credited with having created and written the "City of Angels" television series.

The district court held that the Metcalfs owned valid copyrights in "Give Something Back," "As Long As They Kill Themselves," and "About Face," and that the evidence was sufficient to establish that Bochco had access to these works. However, the court granted Bochco's summary judgment motion on the ground that the Metcalf and Bochco works were not substantially similar. The district court also awarded Bochco \$ 83,316.81 in attorneys' fees. The Metcalfs appeal.

Discussion

To prevail on their infringement [**5] claim, the Metcalfs must show that they own the works in question and that Bochco copied them. *Shaw v. Lindheim*, 919 F.2d 1353, 1356 (9th Cir. 1990). Copying may be established by showing that the Metcalf and Bochco works are substantially similar in their protected elements and that Bochco had access to the works. *Id.*

1. The Metcalfs, and not CCA, own the treatment "Give Something Back" and those portions of the screenplay "About Face" that the Metcalfs wrote. These are not "works made for hire" for CCA. 17 U.S.C. § 201(b). In the absence of a written agreement, to determine whether the writer of a work is an employee who does not own the work, or instead [*1073] an independent contractor who does, we apply "principles of general common law of agency." *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 734, 751, 104 L. Ed. 2d 811, 109 S. Ct. 2166 (1989). Under these principles, the Metcalfs were independent contractors who retained the rights to "Give Something Back" and the Metcalf-authored portions of "About Face." They were not on payroll and did

not receive benefits. *See id. at 753*. Screenplay [**6] production was not "regular business" for CCA, *id.*; rather, CCA was formed specifically to develop the Metcalfs' idea. The Metcalfs used their own tools to write, and had discretion over "when and how long to work." *Id. at 752-53*.

The Metcalfs, however, do not own the screenplay "As Long As They Kill Themselves" or those portions of "About Face" that they did not write. These are "works made for hire," 17 U.S.C. § 201(b), and are thus owned by CCA. According to the written contract between CCA and the writer of "As Long As They Kill Themselves," the screenplay is a "work made for hire" for CCA, which "is and shall be considered the author of said Material for all purposes and the sole and exclusive owner of all of the rights comprised in the copyright." ³

3 We note that the Metcalfs may be able to amend their complaint to include CCA as a plaintiff, *see Fed. R. Civ. P. 15*, or file a new claim on CCA's behalf. Although CCA is now defunct, it may still pursue "claims that arose after its dissolution, . . . just as an estate is permitted to prosecute a cause of action arising after the decedent's death." *Penasquitos, Inc. v. Superior Court*, 53 Cal. 3d 1180, 812 P.2d 154, 161, 283 Cal. Rptr. 135 n.8 (Cal. 1991); *see Fed. R. Civ. P. 17(b)* ("The capacity of a corporation to sue or be sued shall be determined by the law under which it was organized.").

[**7] [1] 2. We employ a two-part analysis -- an extrinsic test and an intrinsic test -- to determine whether two works are substantially similar. *Shaw*, 919 F.2d at 1356. However, on summary judgment, "only the extrinsic test is relevant," because a plaintiff avoids summary judgment by satisfying it. *Smith v. Jackson*, 84 F.3d 1213, 1218 (9th Cir. 1996).

[2] The extrinsic test is an objective one that focuses on "articulable similarities between the plot, themes, dialogue, mood, setting, pace, characters, and sequence of events." *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994) (citation and internal quotation marks omitted). Even without considering "As Long As They Kill Themselves," we conclude that the Metcalfs satisfied this test and raised a genuine issue of triable fact on the question of substantial similarity.

[3] The similarities between the relevant works are striking: Both the Metcalf and Bochco works are set in overburdened county hospitals in inner-city Los Angeles with mostly black staffs. Both deal with issues of poverty, race relations and urban blight. The works' [**8] main characters are both young, good-looking, muscular black surgeons who grew up in the neighborhood where the hospital is located. Both surgeons struggle to choose between the financial benefits of private practice and the emotional rewards of working in the inner city. Both are romantically involved with young professional women when they arrive at the hospital, but develop strong attractions to hospital administrators. Both new relationships flourish and culminate in a kiss, but are later strained when the administrator observes a display of physical intimacy between the main character and his original love interest. Both administrators are in their thirties, were once married but are now single, without children and devoted to their careers and [**1074] to the hospital. In both works, the hospital's bid for reaccreditation is vehemently opposed by a Hispanic politician. "The totality of the similarities . . . goes beyond the necessities of the . . . theme and belies any claim of literary accident." *Shaw*, 919 F.2d at 1363. The cumulative weight of these similarities allows the Metcalfs to survive summary judgment.

Bochco correctly argues that copyright law protects a [**9] writer's expression of ideas, but

not the ideas themselves. *Kouf*, 16 F.3d at 1045. "General plot ideas are not protected by copyright law; they remain forever the common property of artistic mankind." *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir. 1985). Nor does copyright law protect "scenes a faire," or scenes that flow naturally from unprotectable basic plot premises. *Id.*; *See v. Durang*, 711 F.2d 141, 143 (9th Cir. 1983). Instead, protectable expression includes the specific details of an author's rendering of ideas, or "the actual concrete elements that make up the total sequence of events and the relationships between the major characters." *Berkic*, 761 F.2d at 1293. Here, the similarities proffered by the Metcalfs are not protectable when considered individually; they are either too generic or constitute "scenes a faire." *Berkic*, 761 F.2d at 1293; *Kouf*, 16 F.3d at 1045. One cannot copyright the idea of an idealistic young professional choosing between financial and emotional reward, or of love triangles among young professionals that eventually become strained, or of [**10] political forces interfering with private action.

[4] However, the presence of so many generic similarities and the common patterns in which they arise do help the Metcalfs satisfy the extrinsic test. The particular sequence in which an author strings a significant number of unprotectable elements can itself be a protectable element. Each note in a scale, for example, is not protectable, but a pattern of notes in a tune may earn copyright protection. A common "pattern [that] is sufficiently concrete . . . warrants a finding of substantial similarity." *Shaw*, 919 F.2d at 1363; *see id.* ("Even if none of these [common] plot elements is remarkably unusual in and of itself, the fact that both [works] contain all of these similar events gives rise to a triable question of substantial similarity of protected expression."); *id.* (where main characters are both well dressed, wealthy, self-assured and have expensive tastes, "the totality of these similarities . . . goes beyond the necessities of [defendants' work's] theme and belies any claim of literary accident").

Neither *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435 (9th Cir. 1994), [**11] nor *Cavalier v. Random House, Inc.*, 297 F.3d 815, No. 00-56192, slip op. 7427, 2002 U.S. App. LEXIS 9554 (9th Cir. May 21, 2002), hold otherwise; nor could they, as *Shaw* was the law of the circuit when they were decided. In *Apple Computer*, we held that the basic ideas of a desktop metaphor in a computer's operating system -- windows on the computer screen, icons representing familiar office objects, drop-down menus and objects that open and close -- were not individually protectable. 35 F.3d at 1443-44. However, consistent with *Shaw*, we also held that infringement can "be based on original selection and arrangement of unprotected elements." *Id.* at 1446. In fact, Apple was entitled to and did license the way in which it "put [unprotectable] ideas together" through the "creative[]" use of "animation, overlapping windows, and well-designed icons." *Id.* at 1443.

In *Cavalier*, we did not address the protectability of the selection and sequence of generic elements. Plaintiffs argued unsuccessfully that the many "random similarities scattered throughout the works" satisfied the extrinsic test, 297 F.3d 815, 2002 U.S. App. LEXIS 9554, No. 00-56192, slip [*1075] op. at 7443 [**12] (emphasis added) (quoting *Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir. 1984)), but apparently did not make an argument based on the overall selection

and sequencing of these similarities. See 297 F.3d 815, 2002 U.S. App. LEXIS 9554, *id.* at 7441. ⁴

4 We imply no conclusion as to what the result might have been had this argument been made. Because the record in *Cavalier* is not before us, we cannot judge how that case would have been decided had the plaintiff there raised an argument it did not raise.

[5] The Metcalfs' case is strengthened considerably by Bochco's concession of access to their works. *Shaw*, 919 F.2d at 1361. Indeed, here we have more than access: One of the defendants, Michael Warren, allegedly stated that he had read three versions of the script, and had passed them on to defendant Steven Bochco, who had also read them and liked them. Warren and Bochco were intimately involved with "City of Angels," as star and writer, respectively. If the trier of fact were [**13] to believe that Warren and Bochco actually read the scripts, as alleged by the Metcalfs, it could easily infer that the many similarities between plaintiffs' scripts and defendants' work were the result of copying, not mere coincidence.

Because we reverse the district court's ruling on the merits, we, of course, also reverse the award of attorneys' fees to Bochco.

REVERSED.



FUNKY FILMS, INC., a California corporation; GWEN O'DONNELL,
Plaintiffs-Appellants, v. TIME WARNER ENTERTAINMENT
COMPANY, L.P., a Delaware limited partnership; HOME BOX OFFICE, a
division of Time Warner Entertainment Company, L.P., Defendants-
Appellees.

No. 04-55578

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

*462 F.3d 1072; 2006 U.S. App. LEXIS 22231; 80 U.S.P.Q.2D (BNA) 1052;
Copy. L. Rep. (CCH) P29,237; 34 Media L. Rep. 2345; 39 Comm. Reg. (P & F)
331*

February 13, 2006, Argued and Submitted, Pasadena, California

August 30, 2006, Filed

PRIOR HISTORY: [**1] Appeal from the United States District Court for the Central District of California. D.C. No. CV-03-00964-CJC. Cormac J. Carney, District Judge, Presiding.

COUNSEL: Robert F. Helfing (argued), Los Angeles, California, and Rex T. Reeves, Newport Beach, California, for the appellants. Jeffrey A. Conciatori (argued), Margret Caruso, New York, New York, and Christopher Tayback, Los Angeles, California, for the appellees.

JUDGES: Before: Betty B. Fletcher, Warren J. Ferguson, and Consuelo M. Callahan, Circuit Judges. Opinion by Judge B. Fletcher.

OPINION BY: B. FLETCHER

OPINION

[*1074] B. FLETCHER, Circuit Judge:

Gwen O'Donnell and Funky Films, Inc. (collectively, "appellants"), creators of the screenplay "The Funk Parlor," appeal the district

court's summary judgment to Time Warner Entertainment Company and Home Box Office (collectively, "HBO"), creators of the award-winning television mini-series "Six Feet Under," for copyright infringement. Appellants assert that the district court erred in concluding that "The Funk Parlor" and "Six Feet Under" are not substantially similar. They also appeal the district court's denial of a request for additional discovery. For the reasons set forth below, we affirm the judgment [**2] of the district court.

Gwen O'Donnell and Funky Films, Inc. (collectively, "appellants"), creators of the screenplay "The Funk Parlor," appeal the district court's summary judgment to Time Warner Entertainment Company and Home Box Office (collectively, "HBO"), creators of the award-winning television mini-series "Six Feet Under," for copyright infringement. Appellants assert that the district court erred in concluding that "The Funk Parlor" and "Six Feet Under" are not substantially similar. They also appeal the district court's denial of a request for additional discovery. For the

reasons set forth below, we affirm the judgment of the district court.

[*1075] 1

Between October 1997 and July 1999, Gwen O'Donnell drafted "The Funk Parlor," a screenplay tracing the lives of a small, family-run funeral parlor in Connecticut. Sometime in 1998, O'Donnell was injured in an automobile accident and sought treatment from Stacey Smith, a chiropractor. During these appointments, the two discussed O'Donnell's screen- play; eventually, Smith took an interest in the script and asked O'Donnell if she would like him to give a copy to his friend and client Chris Albrecht, the President of Original [**3] Programing at HBO. O'Donnell agreed and gave Smith a copy of "The Funk Parlor." Three months later, Carolyn Strauss, Albrecht's top lieutenant, solicited Alan Ball to develop "Six Feet Under" for HBO. ¹

1 In the district court, appellees submitted declarations in support of their claim that they never had access to "The Funk Parlor." That issue is not before us, because the district court assumed access for purposes of summary judgment.

Appellants allege that "The Funk Parlor" and "Six Feet Under" are substantially similar and that HBO unlawfully infringed upon appellants' copyrighted work. "As a determination of substantial similarity requires a detailed examination of the works themselves," *Williams v. Crichton*, 84 F.3d 581, 583 (2d Cir. 1996) (internal citation and quotation marks omitted), we begin with a discussion of the works at issue.

A

"The Funk Parlor" takes place in a small, family-run funeral home in Connecticut. John Funk Sr., the patriarch, has committed suicide, and [**4] the deteriorating funeral parlor has been handed down to his two sons, John Jr. and Tom. John, the

older brother who had moved away to start his own business promoting nightclubs in Los Angeles, reluctantly decides to remain in Connecticut after his father's death to help out with the struggling venture. Applying his business acumen, John revives it, all the while staving off an attempted take over by a larger competitor. Meanwhile, he attracts the attention of Sophie, a neighbor and longtime acquaintance, and the two become romantically involved. Sophie repeatedly talks of entering a convent to become a nun, although in actuality she is a psychopathic murderer whose killing sprees breathe new life (as it were) into the Funk business. John and Sophie intend to marry, but John eventually figures out that he is Sophie's next target and that he must kill her (which he does) to spare his own life.

Tom, who had been running the funeral home during John's absence and who expresses an interest in Sophie as well, is murdered midway through the play. After Tom's death, John continues operating the business to bring it out of debt. After Sophie's death, John sells the business, moves to New [**5] York, and returns to the nightclub business.

Like "The Funk Parlor," "Six Feet Under" takes place in a funeral home and begins with the death of the patriarch, Nathaniel Fisher, and return of the "prodigal son," Nate, who receives an equal share of the business along with his younger brother, David. Nate decides to stay and help David maintain the business, which, like the Funk business, struggles against a larger competitor. The story traces the interpersonal relationships and romantic lives of each of the Fisher sons. It also revolves around the lives of the mother, Ruth, and sister, Claire, as well as other characters who come into contact with members of the Fisher family. The father, though deceased, reemerges [*1076] throughout the drama. He continues to interact with each remaining character of the Fisher family, often helping them piece together problems that seemed irresolvable during his lifetime.

At the beginning of the drama, Nate begins a relationship with Brenda Chenoweth, a massage therapist he meets on an airplane. David, who is gay, struggles with his sexuality and begins a relationship with Keith, a police officer he meets at church.

B

The district court conducted [**6] an independent analysis of the "The Funk Parlor" and the first three episodes of "Six Feet Under," comparing the two works for their setting, plot, characters, theme, mood, pace, dialogue, and sequence of events. The court determined that the works' few similarities operate at a general, abstract level and that no jury could reasonably find substantial similarities between the two works. Accordingly, the court granted HBO's motion for summary judgment.²

2 Appellants also alleged violations of statutory and common law, unfair competition laws and the Lanham Act. The district court granted HBO's motion to dismiss those claims, and Funky Films does not press them on appeal. Appellants filed a timely notice of appeal.

II

We review the district court's grant of summary judgment de novo, *see Government of Guam v. United States*, 179 F.3d 630, 632 (9th Cir. 1999), viewing the evidence in the light most favorable to the non-moving party to determine the presence of any issues of material [**7] fact. *See Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1044 (9th Cir. 1994). Summary judgment is appropriate only when "there is no genuine issue as to any material fact," *see Fed. R. Civ. P. 56(c)*, and only if "the evidence . . . is so one-sided that one party must prevail as a matter of law." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251-52, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986).

A

A plaintiff bringing a claim for copyright infringement must demonstrate "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). Appellants' ownership in the copyright is undisputed; they need only demonstrate a triable issue of fact whether HBO "cop[ied] anything that was 'original' to" their work. *Id.* Absent evidence of direct copying, "proof of infringement involves fact-based showings that the defendant had 'access' to the plaintiff's work and that the two works are 'substantially similar.'" *See, e.g., Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481 (9th Cir. 2000). [**8] Because the district court assumed, without deciding, appellees' access to "The Funk Parlor," we must decide whether the two works are substantially similar.

"When the issue is whether two works are substantially similar, summary judgment is appropriate if no reasonable juror could find substantial similarity of ideas and expression." *Kouf*, 16 F.3d at 1045 (internal citations and punctuation omitted). Although "summary judgment is not highly favored on the substantial similarity issue in copyright cases," *Berkic v. Crichton*, 761 F.2d 1289, 1292 (9th Cir. 1985), substantial similarity "may often be decided as a matter of law." *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th [**1077] Cir. 1977). Indeed, "[w]e have frequently affirmed summary judgment in favor of copyright defendants on the issue of substantial similarity." *Shaw v. Lindheim*, 919 F.2d 1353, 1355 (9th Cir. 1990). *See Berkic*, 761 F.2d at 1292 ("we have frequently affirmed summary judgments in favor of copyright defendants on the substantial similarity issue") (citing cases); *see also Kouf*, 16 F.3d at 1045-1046 [**9] (finding no substantial similarity as a matter of law).

B

The substantial-similarity test contains an extrinsic and intrinsic component. At summary judgment, courts apply only the extrinsic test; the intrinsic test, which examines an ordinary person's subjective impressions of the similarities between two works, is exclusively the province of the jury. *See Shaw*, 919 F.2d at 1360-61. A "plaintiff who cannot satisfy the extrinsic test necessarily loses on summary judgment, because a jury may not find substantial similarity without evidence on both the extrinsic and intrinsic tests." *Kouf*, 16 F.3d at 1045.

Extrinsic analysis is objective in nature. "[I]t depends not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed." *Krofft*, 562 F.2d at 1164. The extrinsic test focuses on "articulable similarities between the plot, themes, dialogue, mood, setting, pace, characters, and sequence of events" in the two works. *Kouf*, 16 F.3d at 1045 (citations omitted). In applying the extrinsic test, this court "compares, not the basic plot ideas for stories, but the actual concrete [**10] elements that make up the total sequence of events and the relationships between the major characters." *Berkic*, 761 F.2d at 1293.

"[P]rotectable expression includes the specific details of an author's rendering of ideas." *Metcalf v. Bochco*, 294 F.3d 1069, 1074 (9th Cir. 2002). However, *scenes A faire*, which flow naturally from generic plot-lines, are not protectable. *See id.* We "must take care to inquire only whether 'the protectable elements, standing alone, are substantially similar.'" *Cavalier v. Random House*, 297 F.3d 815, 822 (9th Cir. 2002) (quoting *Williams*, 84 F.3d at 588 (emphasis in original)). In so doing, we "filter out and disregard the non-protectable elements in making [our] substantial similarity determination." *Id.*

C

Appellants allege a number of similarities between "The Funk Parlor" and "Six Feet Under." According to appellants, both works concern "a

narrative about a small funeral home, and the lives of the family members who operate it"; plot-lines involving "the death of the father . . . [who] has for decades run the business"; a father whose death is "unexpected [**11] and not attributable to natural causes" (suicide in "The Funk Parlor" and a car accident in "Six Feet Under"); and the presence of "two sons" who receive equal shares of the business, with the "older son . . . liv[ing] in a distant city, working outside the funeral industry." In both works, the older son initially "has no interest in becoming involved with the funeral business"; moreover, "[t]he family business is financially fragile, and in both works the funeral home is pointedly shown to be in debt and operating out of a substandard facility with obsolete equipment and a hearse that stalls." Both works also contain an attempt by a "rival funeral home," spear-headed by "the female principal of the rival business" to "take[] advantage of their vulnerable financial condition," "bluntly mak[ing] a lowball offer" and "approaching [**1078] one of the brothers at the father's funeral with a proposal to buy the family business." In both works, the older brother initially "expresses his desire to sell" but "changes his mind and commits himself to help his brother keep the business afloat." Finally, appellants point out the older brother's creativity, which stands in "pointed contrast to [**12] the leaden conservatism of the younger brother"; that the funeral home in both works is used as a "site for musical entertainment"; that the "younger brother . . . change[s] his church affiliation in order to increase their client base" in both works; and that "the rival's takeover attempt does not succeed."

D

At first blush, these apparent similarities in plot appear significant; however, an actual reading of the two works reveals greater, more significant differences and few real similarities at the levels of plot, characters, themes, mood, pace, dialogue, or sequence of events.

1. *Plot*

Both "Six Feet Under" and "The Funk Parlor" commence with the death of the father and return of the "prodigal son." Aside from that rather uneventful similarity, the plots of the two stories develop quite differently. The father's suicide in "The Funk Parlor" sets the stage for a series of additional murders, including several of the central characters in the play. The story revolves around the life of the older brother, John, who rehabilitates the fledgling business, falls in love with Sophie, proposes to her and then, upon discovering that she is a serial murderer, kills her [**13] in an effort to spare his own life.

"Six Feet Under," unlike "The Funk Parlor," is not a murder mystery, nor does it revolve around any plot-line in particular. Rather, "Six Feet Under" explores the intimate lives of each member of the Fisher family by examining each character's complex psyche and his or her interpersonal interactions and emotional attachments. "Six Feet Under" develops separate plot-lines around each member of the Fisher family, including the mother and daughter, for whom there are no comparable characters in "The Funk Parlor." "Six Feet Under" is not so much a story about *death* as it is about the way the characters struggle with *life* in the wake of the cataclysmic death of the father.³

3 "The Funk Parlor" contains a number of scenes with no equivalent in "Six Feet Under" -- a surgical blood-transfusion procedure that John executes at the funeral parlor; a discussion regarding the extraction of ejaculatory material from a corpse; and numerous scenes involving group-drinking, a techno-rave party that generates money for the ailing funeral home, and recurring references to the band *Led Zeppelin*.

[**14] 2. *Characters*

Although appellants attempt to link up the various characters of the two works, there are very few real similarities between any of them. John Funk, Sr., is a minor character who vanishes at the start of "The Funk Parlor" and does not reappear except during one quick flashback scene; his relationships with the other characters are not consciously explored. Nathaniel Fisher, Sr., by contrast, appears throughout the drama and continues to interact with each character separately. In that regard, "Six Feet Under" traces each character's unique set of relationships with the deceased father, exploring issues that were apparently not resolvable during life.

The "prodigal son" characters of the two works, while similar at the abstract level, are markedly different in the two scripts. [*1079] Nate Fisher's search for meaning originally led him away from the family business; prior to his return home, he remained somewhat adrift in Seattle. Although he reluctantly agrees to remain in Los Angeles to help his brother David run the business, he shows little interest or skill. John Funk, Jr., by contrast, is a talented and creative business person whose efforts quickly restore [**15] the moribund business. Unlike Nate, John graduated from mortuary school and took on an active role in the business before decamping for Los Angeles to become a club promoter.

The characters of David Fisher and Tom Funk, both younger brothers, are remarkably different. Tom's role in "The Funk Parlor" is less developed (in part because he is killed roughly midway through the story), though he is clearly less skilled than his brother at maintaining the family business. Although Tom is rumored to be gay, his homosexuality remains a matter of speculation and is never pursued through any relationship or meaningful dialogue. David, by contrast, is deeply enmeshed in a struggle with sexual identity, which he hides from his family and explores privately. His coming-out process and his relationship with Keith

occupy a central plot-line of the story. The complexity of David's character has no equivalent in "The Funk Parlor."

Appellants equate Sophie Zemlaskas with Brenda Chenoweth, both of whom are romantically involved with the older brother in each story. However, the two have little in common. Sophie, a devout and obsessive Catholic who plans to enter the convent, is a psychopathic killer. [**16] Unlike Sophie, Brenda is not homicidal. Brenda, a massage therapist, is psychologically astute and expresses no interest in religion. While Sophie expresses deep conflict over her sexuality, Brenda engages in an apparently conflict-free sexual life with Nate (and others).

Appellants also try to draw connections between Jamie, a twelve-or thirteen-year-old cousin who works at the funeral home, and Claire Fisher, the younger sister in "Six Feet Under." But Jamie is a very minor character; Claire, by contrast, is a central character who develops relationships of her own. Her struggle to define herself within the family, while rejecting any place within the family business, is a recurring theme in "Six Feet Under."

Completely missing from "The Funk Parlor" is any character similar to Ruth Fisher, the mother and one of the central characters of "Six Feet Under." Ruth is presented as a strong-willed woman who struggles to overcome her lingering maternal instincts over her now-grown children. Her own romantic attachments and relationships form an important part of the plot-line as well.

Additional characters within "Six Feet Under" that have no counterpart in "The Funk Parlor" are Fredrico [**17] Diaz, an employee of the Fisher business who eventually becomes a partner, and Keith Charles, David's boyfriend who struggles to remain in the relationship despite David's conflicts in coming to terms with his sexuality.

3. Themes

Although both works explore themes of death, relationships, and sex, they do so in very different ways. "The Funk Parlor," a murder mystery, is driven by a series of murders, which catalyze the salvation of the business. The use of death in "Six Feet Under" is quite different: there, death provides the focal point for exploring relationships and existential meaning. As noted by the district court, the general theme of "Six Feet Under" "is that sex and death provide focal points for relationships," while the predominant theme of [**1080] "The Funk Parlor" is that "sex and religion don't mix."

In addition to the numerous murders that take place, "The Funk Parlor" traces a number of religious themes (tension between members of the Protestant and Catholic communities, religious conversion, and a general fear of God). Much of the story takes place at the Polish deli owned by Sophie's family, and several of the deaths take place at "Overlook Point." Characters [**18] continually brush up against law-enforcement officials investigating the series of murders. Meanwhile, the religious themes serve as a conscious moral structure against the backdrop of the mass killings that take place. The characters must come to grips with religious expectations, agonizing that they will "burn in Hell" and that "God is punishing us." John Funk considers religious conversion and seeks confession as a source of absolution. Sophie, meanwhile, is obsessed with religion and, for much of the story, appears ready to enter the convent to become a nun.

"Six Feet Under," by contrast, is a neo-realistic, postmodern account of family and romantic relationships, without any overarching religious themes or overtones. Themes of love, romance, death, and sexuality are explored entirely through the characters' complex interactions. The story focuses on the characters' longing for connection, their insecurities, and their complaints. Unlike "The Funk Parlor," none of the main characters are murderers or murder victims.

4. *Setting, Mood, and Pace*

Although both works take place in a contemporary, family-run funeral home, the similarities in setting end there. "Six Feet Under" takes place in a well-maintained funeral home in Los Angeles. Although the business struggles against a competitor and is, at times, somewhat sluggish, "The Funk Parlor," located in Connecticut, is in shambles. The moods of the two works are drastically different as well. "The Funk Parlor" is a farcical mystery, while "Six Feet Under" is serious, dramatic, and introspective. "The Funk Parlor" moves at a rapid clip, while "Six Feet Under" evolves slowly and often in repetitive fashion. Beyond the basic premise of a family-run funeral home, there are no similarities in the setting, mood or pace of the two works.

5. *Dialogue*

The encounters explored in "The Funk Parlor" are at times pedestrian, and the dialogue, at times, rather trite. The characters play beer-drinking games like "I never" and express concern about "burning in hell" and that "God is punishing us." "Six Feet Under," by contrast, is full of complex and subtle dialogue, including ironic turns of phrases that heighten the already-fraught interactions among the characters.

6. *Sequence of Events*

The sequence of events in the two works are different as well. "The Funk Parlor" opens with a younger John [**20] Funk attempting to seduce Jennifer Angeli at "Overlook Point." Their automobile crashes; John is blamed for the death; he leaves home; and returns only later at the death of his father. "Six Feet Under" begins with a montage of different scenes depicting each character's reaction to the death of Nathaniel Sr., who is killed in an automobile accident on the way to pick up Nate Jr. at the airport. Minutes before finding out, Nate engages in a sexual encounter

with Brenda in an airport broom closet; Claire smokes crystal methamphetamine with a group of friends; and Ruth broods over dinner and Nate's favorite breakfast cereal. [*1081] Shortly after these scenes, the Fisher children are reunited with their mother at the hospital to identify their father's body, thus beginning the exploration of their complex relationships. While "The Funk Parlor" unfolds in a straight, linear trajectory, "Six Feet Under" employs repetition, dreams, and flashbacks to intensify certain scenes and conflate the real with the unreal.

E

At a very high level of generality, both works share certain plot similarities: the family-run funeral home, the father's death, and the return of the "prodigal son," who assists [**21] his brother in maintaining the family business. But "[g]eneral plot ideas are not protected by copyright law; they remain forever the common property of artistic mankind." *See Berkic*, 761 F.2d at 1293. *See also Cavalier*, 297 F.3d at 824 ("basic plot ideas, such as this one, are not protected by copyright law"); *Shaw*, 919 F.2d at 1356 ("Copyright law protects an author's expression; facts and ideas within a work are not protected."). Beyond that, "[t]he stories do not share any detailed sequence of events." *Cavalier*, 297 F.3d at 824. *See Berkic*, 761 F.2d at 1293 ("Both deal with criminal organizations that murder healthy young people, then remove and sell their vital organs to wealthy people in need of organ transplants. To some extent, both works take their general story from the adventures of a young professional who courageously investigates, and finally exposes, the criminal organization. But this degree of similarity between the basic plots of two works cannot sustain a plaintiff's claim that the works are 'substantially similar.'"). The similarities recounted throughout appellants' brief [**22] rely heavily on *scenes A faire* -- not concrete renderings specific to "The Funk Parlor" -- and are, at best,

coincidental. Consequently, the two works are not substantially similar.

F

The district court disposed of the motion for summary judgment exclusively on the issue of substantial similarity and, in so doing, assumed for the sake of argument appellees' access to the script. Although appellants wanted to take additional discovery on the issue of access, the court found it unnecessary because appellants could not meet the lower burden required by the substantial-similarity test. Appellants contend, however, that they should be given an opportunity to satisfy an even lower burden of proof under the "inverse-ratio rule," which applies to those cases in which a party demonstrates the alleged copier's "high degree of access" to the purportedly copied material. *See Three Boys Music*, 212 F.3d at 485 ("we require a lower standard of proof of substantial similarity when a high degree of access is shown") (internal citation omitted). Appellants contend that further discovery would allow them to demonstrate such access; that they would prevail under the [**23] lower burden of proof required in cases where such a degree of access is shown; and that the district court erred in failing to conduct that inquiry.

We do not agree that appellants' invocation of the inverse-ratio rule requires reversal of the district court's decision. "No amount of proof of access will suffice to show copying if there are no similarities," *Krofft*, 562 F.2d at 1172, and, in this case,

additional discovery would not change the fact that the two works lack any concrete or articulable similarities. ⁴ [**1082] Thus, appellants would not be able to demonstrate unlawful copying even under a relaxed version of the substantial-similarity test. Consequently, we affirm the district court's summary judgment in appellees' favor as well as its ruling on additional discovery. *See Anderson*, 477 at 248 ("Only disputes over facts that might affect the outcome of the suit under the governing law will properly preclude the entry of summary judgment.").

4 Moreover, this is not a circumstance in which the defendant has conceded access to the purportedly copied material. *See Metcalf*, 294 F.3d at 1075 (noting that a plaintiff's claim was "strengthened considerably by [the defendant's] concession of access to their works"); *Shaw*, 919 F.2d at 1361-62 (applying a lower standard of proof under substantial similarity in light of defendants' admission of access to the work in question).

[**24] |||

For the reasons stated above, the district court's summary judgment in appellees' favor is AFFIRMED.



AARON BENAY; MATTHEW BENAY, individually, Plaintiffs-Appellants,
v. WARNER BROS. ENTERTAINMENT, INC., a Delaware corporation;
RADAR PICTURES, INC., a California corporation; BEDFORD FALLS
PRODUCTIONS, INC., a California corporation; EDWARD ZWICK, an
individual; MARSHALL HERSKOVITZ, an individual; JOHN LOGAN, an
individual, Defendants-Appellees.

No. 08-55719

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

607 F.3d 620, 2010 U.S. App. LEXIS 11707; 95 U.S.P.Q.2D (BNA) 1165; Copy.
L. Rep. (CCH) P29,934

October 8, 2009, Argued and Submitted, Pasadena, California

June 9, 2010, Filed

PRIOR HISTORY: [**1]

Appeal from the United States District Court for
the Central District of California. D.C. No. 2:05-cv-
08508-PSG-FMO. Philip S. Gutierrez, District
Judge, Presiding.

DISPOSITION: AFFIRMED IN PART AND
REVERSED IN PART.

COUNSEL: Sylvia Havens, Los Angeles,
California, for the appellants.

George R. Hedges, Gary E. Evans, QUINN
EMANUEL URQUHART OLIVER & HEDGES,
LLP, Los Angeles, California, Jaime Wayne
Marquart, Daryl Marc Crone, BAKER
MARQUART CRONE & HAWXHURST, LLP,
Los Angeles, California, for the appellees.

JUDGES: Before: William A. Fletcher and Richard
R. Clifton, Circuit Judges, and James K. Singleton, *
Senior District Judge. Opinion by Judge William A.
Fletcher.

* The Honorable James K. Singleton,
Senior United States District Judge for the
District of Alaska, sitting by designation.

OPINION BY: William A. Fletcher

OPINION

[*622] W. FLETCHER, Circuit Judge:

Plaintiffs are two brothers, Aaron and Matthew
Benay, who wrote and copyrighted a screenplay,
The Last Samurai ("the Screenplay"). The Benays
contend that the creators of the film *The Last
Samurai* ("the Film") copied from the Screenplay
without permission. They sued Warner Brothers
Entertainment, Inc., Radar Pictures, Inc., Bedford
Falls Productions, Inc., Edward Zwick, Marshall
Herskovitz, [**2] and John Logan (collectively
"Defendants"), who wrote, produced, marketed,
and/or distributed the Film. *Inter alia*, the Benays
alleged copyright infringement under federal law
and breach of contract under California law.

The district court granted summary judgment to Defendants on the copyright and breach of contract claims. We affirm on the copyright claim. We reverse and remand on the breach of contract claim.

I. Background

The Benays wrote their Screenplay between 1997 and 1999. They registered it with the Writers Guild of America in 1999 and with the federal copyright office on February 23, 2001. The Benays' agent, David Phillips, "pitched" the Screenplay to the president of production at Bedford Falls, Richard Solomon, on the telephone sometime between May 9, 2000, and May 12, 2000. Phillips provided a copy of the Screenplay to Solomon on May 16, 2000. According to Phillips, he provided the Screenplay with the implicit understanding [*623] that if Bedford Falls used it to produce a film, the Benays would be appropriately compensated. Solomon informed Phillips after receiving the Screenplay that Bedford Falls had decided to "pass" because it already had a similar project in development.

The [**3] Benays point to circumstantial evidence that, in their view, indicates that important aspects of the Film were copied from the Screenplay. Defendants contend that the Film was developed independently of the Screenplay. The Screenplay and the Film are similar in some respects and dissimilar in others.

The protagonist in the Screenplay is James Gamble, a successful West Point professor with a beautiful wife and a five-year-old son. Gamble travels to Japan at the request of President Grant. Gamble owes a debt to the President because then-General Grant saved Gamble's career after he accidentally killed eight of his own men during the Civil War. Gamble is initially successful in training and leading the Japanese Imperial Army, which is victorious in its first battle against the samurai. However, that battle turns out to be a strategic blunder because it incites a full samurai rebellion

led by a treacherous samurai named Saigo. Gamble's five-year-old son is killed during Saigo's attack on a Christian church service. The death of his son leads Gamble to launch an attack against Saigo, which results in a devastating loss for the Imperial Army. Gamble falls into an opium-aided stupor, in which [**4] he is haunted by his failure, his mistake during the Civil War, and the death of his son. Gamble eventually is pulled out of this crisis by his wife and by Masako, a female samurai warrior who has double-crossed Saigo. The remainder of the Screenplay consists of Gamble's campaign to exact revenge. A series of battles unfolds between the Imperial Army, led by Gamble, and the samurai rebels. The conflict eventually ends with Gamble killing Saigo in a sword fight with the help of Masako, who dies in the fight. Gamble returns to the United States, where he lives in a Japanese-style house with his wife and a newborn child named Masako.

The protagonist in the Film is Nathan Algren, an unmarried alcoholic. He is haunted by his role in an attack on an innocent tribe during the Indian Campaigns. He has just been fired from his dead-end job hawking Winchester rifles when he is recruited by his former commander to train the Japanese Imperial Army in modern warfare. He travels to Japan as a mercenary. After Algren is captured by the samurai at the end of a disastrous first battle, he is exposed to traditional samurai culture. Algren bonds with Katsumoto, the honorable leader of the samurai rebellion, [**5] and falls in love with Taka, the widow of a samurai Algren killed while fighting for the Imperial Army. Algren assimilates into a samurai village, eventually joining the samurai in a final futile battle against the modernized Imperial Army. After the samurai army is devastated, Algren confronts the young Emperor and teaches him the value of traditional samurai culture before returning to live with Taka in the samurai village.

The Benays filed suit on December 5, 2005, exactly two years after the public release of the Film. They asserted claims of copyright infringement under federal law, and breach of contract, breach of confidence, and intentional interference with prospective economic advantage under California law. Only the copyright and breach of contract claims survived to the summary judgment stage. The district court granted summary judgment to Defendants on both claims.

The Benays timely appealed the grant of summary judgment.

[*624] II. Standard of Review

We review *de novo* the district court's grant of summary judgment, viewing the evidence in the light most favorable to the non-moving party to determine the presence of any issues of material fact. *See Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1044 (9th Cir. 1994).

III. [**6] Discussion

A. Copyright Claim

To prevail on their copyright infringement claim, the Benays "must demonstrate '(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.'" *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072, 1076 (9th Cir. 2006) (quoting *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991)). Defendants do not deny that the Benays own a valid copyright, but they deny having copied from the Screenplay. The issue before us on appeal is whether there is substantial similarity between protected elements of the Screenplay and comparable elements of the Film. *See id.* ("Absent evidence of direct copying, proof of infringement involves fact-based showings that the defendant had access to the plaintiff's work and that the two works are substantially similar." (quotation omitted)).

" 'When the issue is whether two works are substantially similar, summary judgment is appropriate if no reasonable juror could find substantial similarity of ideas and expression.'" *Id.* (quoting *Kouf*, 16 F.3d at 1045). Substantial similarity is a fact-specific inquiry, but it " 'may often be decided as a matter of law.'" *Id.* (quoting [**7] *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp. ("Krofft")*, 562 F.2d 1157, 1164 (9th Cir. 1977)). "Indeed, '[w]e have frequently affirmed summary judgment in favor of copyright defendants on the issue of substantial similarity.'" *Id.* at 1077 (quoting *Shaw v. Lindheim*, 919 F.2d 1353, 1355 (9th Cir. 1990)).

"The Ninth Circuit employs a two-part test for determining whether one work is substantially similar to another." *Shaw*, 919 F.2d at 1356. To prevail in their infringement case, the Benays must "prove[] both substantial similarity . . . under the 'extrinsic test' and substantial similarity . . . under the 'intrinsic test.'" *Id.* (emphasis in original). "The 'extrinsic test' is an objective comparison of specific expressive elements." *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002). "The 'intrinsic test' is a subjective comparison that focuses on 'whether the ordinary, reasonable audience' would find the works substantially similar in the 'total concept and feel of the works.'" *Id.* (quoting *Kouf*, 16 F.3d at 1045). On a motion for summary judgment, we apply only the extrinsic test. The intrinsic test is left to the trier of fact. *See Swirsky v. Carey*, 376 F.3d 841, 844-45 (9th Cir. 2004); [**8] *Funky Films*, 462 F.3d at 1077. If the Benays fail to satisfy the extrinsic test, they cannot survive a motion for summary judgment. *See Olson v. Nat'l Broad. Co.*, 855 F.2d 1446, 1448-49 (9th Cir. 1988).

"The extrinsic test is an objective test based on specific expressive elements: the test focuses on articulable similarities between the plot, themes, dialogue, mood, setting, pace, characters, and sequence of events in two works." *Kouf*, 16 F.3d at

1045 (quotation omitted). "A court must take care to inquire only whether the protect[able] elements, standing alone, are substantially similar." *Cavalier*, 297 F.3d at 822 (emphasis and quotation omitted). "Copyright law only protects expression of ideas, not the ideas themselves." *Id.* at 823. "Familiar stock scenes and themes that are staples of literature are not protected." *Id.* "Scenes-a-faire, or situations [*625] and incidents that flow necessarily or naturally from a basic plot premise, cannot sustain a finding of infringement." *Id.* Historical facts are also unprotected by copyright law. *Narell v. Freeman*, 872 F.2d 907, 910-11 (9th Cir. 1989).

Under the "inverse ratio" rule, if a defendant had access to a copyrighted work, the plaintiff may [**9] show infringement based on a lesser degree of similarity between the copyrighted work and the allegedly infringing work. *See Shaw*, 919 F.2d at 1361 (citing 2 M. Nimmer, Nimmer on Copyright § 143.4, at 634 (1976)); *see also Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1178 (9th Cir. 2003). For purposes of the Benays' copyright claim, we assume without deciding that the inverse ratio rule applies to lower the burden on the Benays to show similarity. Even if the Defendants had access to the Screenplay, the Benays have not shown sufficient similarity between the Screenplay and the Film to maintain an infringement claim under federal copyright law.

The Benays point to a number of similarities between the Screenplay and the Film. Both have identical titles; both share the historically unfounded premise of an American war veteran going to Japan to help the Imperial Army by training it in the methods of modern Western warfare for its fight against a samurai uprising; both have protagonists who are authors of non-fiction studies on war and who have flashbacks to battles in America; both include meetings with the Emperor and numerous battle scenes; both are reverential toward Japanese culture; and [**10] both feature the leader of the samurai rebellion as

an important foil to the protagonist. Finally, in both works the American protagonist is spiritually transformed by his experience in Japan.

We agree with the district court that "[w]hile on cursory review, these similarities may appear substantial, a closer examination of the protectable elements, including plot, themes, dialogue, mood, setting, pace, characters, and sequence of events, exposes many more differences than similarities between Plaintiffs' Screenplay and Defendants' film." The most important similarities involve unprotectable elements. They are shared historical facts, familiar stock scenes, and characteristics that flow naturally from the works' shared basic plot premise. Stripped of these unprotected elements, the works are not sufficiently similar to satisfy the extrinsic test.

1. Plot and Sequence of Events

In applying the extrinsic test, we look "beyond the vague, abstracted idea of a general plot." *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir. 1985). Though the Screenplay and the Film share the same basic plot premise, a closer inspection reveals that they tell very different stories.

In both the Screenplay and [**11] the Film, an American war veteran travels to Japan in the 1870s to train the Imperial Army in modern Western warfare in order to combat a samurai uprising. Not surprisingly, the stories share similar elements as a result of their shared premise. In both, the protagonist starts in America and travels to Japan where he meets the Emperor, who is struggling to modernize Japan. Both protagonists introduce modern warfare to the Imperial Army, using contemporary Western weaponry and tactics. Both works feature a Japanese foil in the form of the leader of the samurai rebellion. And in both works the protagonist suffers a personal crisis and is transformed as a result of his interaction with the samurai.

Despite these similarities, the two narratives are strikingly different. We agree with the district court's characterization:

[*626] Plaintiffs' protagonist, Gamble, emerges from domestic security, to despair at the loss of his son, to revenge and triumph when he defeats his ruthless antagonist, Saigo. In contrast, the protagonist in Defendants' film moves from isolation and self-destructive behavior, to the discovery of traditional values and a way of life that he later comes to embrace. Thus, unlike [**12] Plaintiffs' Screenplay, which is largely a revenge story, Defendants' film is more a captivity narrative reminiscent in some respects to *Dances With Wolves*.

(quotation omitted).

While the works share a common premise, that premise contains unprotectable elements. For example, there actually was a samurai uprising in the 1870s, the Satsuma Rebellion, led by Saigo Takamori, who is sometimes referred to as "The Last Samurai." See Charles L. Yates, *Saigo Takamori in the Emergence of Meiji Japan*, 28 Mod. Asian Stud. 449, 449 (1994); Kenneth G. Henshall, *A History of Japan: From Stone Age to Superpower* 78 (Palgrave Macmillan 2d ed. 2004) (1999). While there is no clear historical analogue to the American protagonist who travels to Japan to help fight the samurai rebellion, it is not surprising that a Hollywood film about the rebellion would insert an American character.

This case is similar to *Funky Films*, in which the two works at issue told the story of a small funeral home operated by two brothers after the sudden death of their father. 462 F.3d at 1077. The works shared numerous similarities: in both works the older brother moved home from a distant city,

was creative in contrast to his [**13] conservative younger brother, and initially had no interest in becoming involved in the family business; in both the business was financially fragile; in both a rival funeral home attempted to take over the home but failed; and in both the younger brother changed his church affiliation in order to increase their client base. *Id.* at 1077-78. However, closer examination of the works revealed one to be essentially a murder mystery and the other to be a study of "the way the characters struggle with life in the wake of the cataclysmic death of [their] father." *Id.* at 1078 (emphasis omitted). We therefore held that the plots developed "quite differently" and rejected the plaintiffs' copyright claim. *Id.* Similarly, the Screenplay and Film in the case now before us tell fundamentally different stories, though they share the same premise and a number of elements that follow naturally from that premise.

2. Characters

The Benays point to similarities between various characters in the two works, most notably the American protagonists. But on close inspection there are only a few similarities that have significance under copyright law. Most of the similarities are either derived from historical [**14] facts or are traits that flow naturally from the works' shared premises. See *Olson*, 855 F.2d at 1451-53 (noting that only distinctive characters are protectable, not characters that merely embody unprotected ideas).

The most similar characters in the two works are the American protagonists, but the differences between them at least equal the similarities. The Benays' protagonist, Gamble, begins the Screenplay as a happily married and successful West Point professor, while the Defendants' protagonist, Algren, begins the Film as an unmarried loner, a drunk, and a failure, with a meaningless job selling Winchester rifles; Gamble's flashbacks are to his accidental killing of eight of his own men during a Civil War battle, while Algren's are to his role in a

brutal attack on an innocent Indian tribe; and Gamble gains [*627] an appreciation of Japanese culture and honor but returns to America at the end of the Screenplay, while Algren fully assimilates into the samurai way of life by the end of the Film.

Although both works include the leader of the samurai rebellion as a central character, he is based on a historical figure, Saigo Takamori, and is therefore unprotected for copyright purposes. Moreover, [**15] the Screenplay's Saigo is a treacherous and ruthless warlord who deceives the Emperor, attacks a church service resulting in the death of Gamble's son, and is killed by Gamble at the end of the Screenplay. By contrast, the Film's Katsumoto is an honorable and spiritual samurai who respects the Emperor, fights only to preserve the honor of the samurai way of life, and becomes a friend and mentor to Algren by the end of the Film.

The two works present the Japanese Emperor in starkly different ways. The Emperor in both works seeks to modernize Japan. The Screenplay's Emperor is confident, wise, and forward-looking. The Film's Emperor, on the other hand, is young and tentative, torn between modernization and traditional Japanese culture, and is bullied by his advisors.

There are a number of important characters in the Film and the Screenplay who have no obvious parallel in the other work. In the Screenplay, Gamble's wife Britany and his son Trevor play an important role in the development of the plot. Trevor's death is the catalyst for Gamble's opium-aided breakdown and is the motivation for his revenge against Saigo. Gamble's relationship with his wife Britany is tested throughout the movie. [**16] The Screenplay also includes a character named Masako, a beautiful samurai warrior who betrays Saigo to help Gamble. In the Film, Algren is childless. He falls in love with Taka, the widow of a samurai warrior. But Taka plays a very different role in the Film from the roles played by Britany and Masako in the Screenplay. Taka helps

Algren assimilate into samurai culture and shares few character traits with Britany. Taka is graceful and giving, while Britany is fiery and strong-willed. Unlike Masako, Taka is not a warrior. In the Screenplay, Britany's father plays an important role in getting Gamble to Japan and is the central figure in a side-plot in which he attempts to break up Gamble's marriage. There is no parallel character or side-plot in the Film. Finally, the Film includes Algren's former commander during the Indian Campaigns, whom Algren despises. There is no parallel character in the Screenplay.

3. Theme

The district court noted that "both works explore general themes of the embittered war veteran, the 'fish-out-of water,' and the clash between modernization and traditions." But to the extent the works share themes, those themes arise naturally from the premise of an American [**17] war veteran who travels to Japan to fight the samurai. Moreover, the works develop those themes in very different ways. The Screenplay exalts the Americanized modernization of Japan, expressed by Gamble triumphantly raising the American flag over Iwo Jima after killing Saigo. It characterizes samurai as part of an ugly class system from Japan's feudal past, and is largely positive about the role of westerners in modernizing Japan. By contrast, the Film is ambivalent toward modernization and is nostalgic for disappearing Japanese traditions. The Film treats the samurai tradition as an honorable way of life, sadly left behind by modernization, and treats westerners as self-interested and exploitative.

4. Settings

Given that both works involve an American war veteran who travels to Japan to [*628] help the Emperor fight a samurai rebellion, it is not surprising that they share certain settings: a scene of the protagonist sailing into Japan, scenes in the Imperial Palace, scenes on the Imperial Army's training grounds, and battle scenes in various places

in Japan. These are all scenes-a-faire that flow naturally from the works' shared unprotected premise and are therefore disregarded for purposes [**18] of the extrinsic test. *See Cavalier*, 297 F.3d at 824 ("[T]his setting naturally and necessarily flows from the basic plot premise . . . [and] therefore . . . constitutes scenes-a-faire and cannot support a finding of substantial similarity.").

Some of the settings are strikingly dissimilar. As the district court noted, the "American settings of the two works are drastically different." The Screenplay opens at West Point with a classroom scene, a snowball fight, and a scene in Gamble's comfortable home. The Film, on the other hand, opens at a San Francisco convention hall where the drunk Algren is hawking Winchester rifles. In Japan, the Screenplay includes scenes in samurai castles and in an opium den where Gamble has a spiritual crisis, none of which is in the Film. The Film includes extended scenes in a samurai village. No such village appears in the Screenplay.

5. Mood and Pace

Both works contain violent action scenes. But we agree with the district court that the Screenplay "has a triumphant mood" and "is a fast-paced adventure/intrigue story," while the Film "is more nostalgic and reflective in mood" and employs "leisurely sequences" in addition to its battle scenes. The two works [**19] have opposing perspectives on the modernization of Japan and the end of samurai culture. Further, the pacing of the two works is substantially different. The Screenplay jumps from battle scene to battle scene, while the Film has a long period of relative calm in which Algren is held in captivity in the samurai village.

6. Dialogue

There are limited similarities in dialogue between the two works. The Benays point to both works' use of the term "gaijin." But this word, which means "foreigner" or "stranger" in Japanese,

naturally flows from the narrative of an American military advisor in Japan. *See Grosso v. Miramax Film Corp.*, 383 F.3d 965, 967 (9th Cir. 2004) (finding no substantial similarity where "the only similarities in dialogue between the two works come from the use of common, unprotectable poker jargon"). The Benays also point to the use of voice-overs by the protagonists in the two works. But the use of voice-overs is a common cinematic technique. A significant difference between the dialogues is that the Screenplay is written almost entirely in English (except for occasional words like "gaijin"), whereas the Film contains substantial exchanges entirely in Japanese. *Cf. Shaw*, 919 F.2d at 1358 [**20] (finding dialogue similar where "Plaintiffs' expert has set forth, side-by-side, dialogue from a variety of characters which almost match").

7. Title

A title standing alone cannot be copyrighted, but the copying of a title "may . . . have copyright significance as one factor in establishing" an infringement claim. *Shaw*, 919 F.2d at 1362 (quotation omitted). The Benays make much of the fact that the two works share the title "The Last Samurai." The Defendants respond that the identity of titles is not significant because Saigo Takamori, the historical figure on which much of the Film is based, is sometimes referred to as "The [*629] Last Samurai." *See* Charles L. Yates, *supra*, at 449. The limited copyright significance of the shared title in this case is insufficient to overcome the overall lack of similarities between protected elements of the works.

8. Summary

"At a very high level of generality, both works share certain plot similarities." *Funky Films*, 462 F.3d at 1081. "But '[g]eneral plot ideas are not protected by copyright law; they remain forever the common property of artistic mankind.' " *Id.* (quoting *Berkic*, 761 F.2d at 1293); *see also*

Cavalier, 297 F.3d at 824 ("[B]asic plot ideas, such [**21] as this one, are not protected by copyright law."). A number of similarities between the works arise out of the fact that both works are based on the same historical events, take place at the same time and in the same country, and share similar themes. These similarities are largely between unprotected elements--historical facts, characteristics that flow naturally from their shared premise, and scenes-a-faire. *See Berkic*, 761 F.2d at 1293-94. Considering the Screenplay and the Film in their entireties, we conclude that the district court was correct in granting summary judgment to the Defendants on the Benays' federal copyright claim.

B. Breach of Contract Claim

The Benays assert a claim for breach of an implied-in-fact contract under California law. Contract law, whether through express or implied-in-fact contracts, is the most significant remaining state-law protection for literary or artistic ideas. Other previously important state-law protections, such as those against plagiarism, have been preempted by federal copyright law. *See* 4 Melville B. Nimmer & David Nimmer, Nimmer on Copyright ("Nimmer") § 19D.02 (Matthew Bender, rev. ed. 2009). Contract claims for protection of ideas are [**22] not preempted by copyright law because they "allege an 'extra element' that changes the nature of the action." *Grosso*, 383 F.3d at 968. That "extra element" is the agreement between the parties that the defendant will pay for the use of the plaintiff's ideas, independent of any protection offered by federal copyright law. *Id.*

To establish a case for breach of an implied-in-fact contract based on the submission of their Screenplay, the Benays must establish that: (1) they submitted the Screenplay for sale to Defendants; (2) they conditioned the use of the Screenplay on payment; (3) Defendants knew or should have known of the condition; (4) Defendants voluntarily accepted the Screenplay; (5) Defendants actually used the Screenplay; and (6) the Screenplay had

value. *Mann v. Columbia Pictures, Inc.*, 128 Cal. App. 3d 628, 647 n.6, 180 Cal. Rptr. 522 (Ct. App. 1982); *see also Faris v. Enberg*, 97 Cal. App. 3d 309, 318, 158 Cal. Rptr. 704 (Ct. App. 1979).

It is settled law in California that novelty is not required for an implied-in-fact contract claim arising out of unauthorized use. *See Desny v. Wilder*, 46 Cal. 2d 715, 733, 299 P.2d 257 (1956) (disclosure of an idea may be protected by "contract providing that it will be paid for regardless of [**23] its lack of novelty" (quotation omitted)); *Chandler v. Roach*, 156 Cal. App. 2d 435, 441-42, 319 P.2d 776 (Ct. App. 1957). Defendants do not rely on any purported lack of novelty in the Benays' Screenplay. Instead, they contend that we should affirm the district court on any of three grounds. A grant of summary judgment may be affirmed on an alternative ground so long as that ground is fairly supported by the record. *See Security Life Ins. Co. of Am. v. Meyling*, 146 F.3d 1184, 1190 (9th Cir. 1998). The three grounds on which Defendants [**630] rely are: (1) the Benays cannot establish the requisite fifth element of their contract claim, actual use of the Screenplay by the Defendants; (2) the Benays failed to file their contract claim within two years of the breach of contract, as required by the California statute of limitations; and (3) there was no privity of contract between the Benays and any of the Defendants other than Bedford Falls. We decline to affirm on any of these three grounds.

1. Actual Use of the Screenplay by Defendants

It is undisputed that defendants Edward Zwick and John Logan were working on a script entitled *West of the Rising Sun* before the Benays' Screenplay was pitched to Richard Solomon. [**24] In *West of the Rising Sun*, a Civil War veteran joins a samurai and helps him lead a cattle drive in Japan. On April 12, 2000, Zwick sent a fax to Logan in which he described the theme of *West of the Rising Sun*: "There's some nice political intrigue: a cattle drive to a starving city as provocation for a civil war; a rich and modern

metaphor in the introduction of an American passion (beef) and an American agenda (trade), to a culture that has lived happily for thousands of years without either." The Benays' agent pitched the Screenplay to Solomon about a month later, sometime between May 9 and 12, and delivered it to Solomon on May 16.

West of the Rising Sun eventually evolved into the Film, *The Last Samurai*. The Film differs from *West of the Rising Sun*, and resembles the Screenplay, in two particularly important respects. First, the Civil War veteran is no longer a transplanted American cowboy helping to lead a Western-style cattle drive; he is now a military expert helping to modernize the Japanese Imperial Army. Second, the veteran no longer comes to Japan to work side-by-side with the samurai; he now comes to Japan to fight against the samurai. The parties dispute when this evolution [**25] took place and what, if anything, the evolution owes to the Benays' Screenplay.

Defendants' argument on appeal is not based on a factual contention that defendants Zwick and Logan did not have access to, and therefore could not have used, the ideas in the Benays' screenplay in transforming *West of the Rising Sun* into the Film. Rather, Defendants contend that the Screenplay and the Film lack substantial similarity and that therefore, as a matter of law, the Benays cannot prove use of their Screenplay under California contract law.

Similar to the inference of copying in copyright law, California contract law "permits actual use of a plaintiff's idea to be inferred from evidence of access and . . . [T]his inference is not binding; defendant can rebut it through contrary evidence." 4 *Nimmer* § 19D.07[C]; see *Mann*, 128 Cal. App. 3d at 647-48. In breach of contract claims, the level of similarity that permits an inference of actionable use depends on the nature of the agreement between the parties. See 4 *Nimmer* § 19D.08. In cases of explicit contracts where the terms of the agreement

are spelled out, the level of similarity required depends on those terms. See 4 *Nimmer* § 19D.08[B] (comparing [**26] *Fink v. Goodson-Todman Enters.*, 9 Cal. App. 3d 996, 1008-13, 88 Cal. Rptr. 679 (Ct. App. 1970) (where contract required payment for any work "based upon" the submitted work, court required substantial similarity between the works), with *Weitzenkorn v. Lesser*, 40 Cal. 2d 778, 792, 256 P.2d 947 (1953) (theoretically, parties could agree that the defendants must pay for any use "no matter how slight or commonplace the portion which they used"), and Jay S. Kenoff & Richard K. Rosenberg, [**631] "Form 9-3 Producer Multi-Picture Employment Agreement with Commentary," in *Entertainment Industry Contracts* (Donald C. Farber & Peter A. Cross eds., 2006) (form contract whereby studio agrees to pay for submitted ideas whether or not they are ultimately used)).

Where the contract is implied-in-fact rather than explicit, the parties have not specified any standard. In such cases, "the weight of California authority is that there must be 'substantial similarity' between plaintiff's idea and defendant's production to render defendant liable." 4 *Nimmer* § 19D.08[A] (citing *Kurlan v. Columbia Broad. Sys., Inc.*, 40 Cal. 2d 799, 809, 256 P.2d 962 (1953); *Sutton v. Walt Disney Prods.*, 118 Cal. App. 2d 598, 603, 258 P.2d 519 (Ct. App. 1953); *Whitfield v. Lear* 751 F.2d 90, 93 (2d Cir. 1984)). [**27] The requirement of substantial similarity for implied-in-fact contract claims "aligns this field with copyright infringement . . . [and] also means that copying less than substantial material is non-actionable." *Id.* "Courts have specifically rejected the contention that liability could be imposed on defendants on the basis of less than substantial similarities." *Id.*

However, "[f]rom the invocation of the copyright term 'substantial similarity' it does not follow . . . that plaintiffs in idea-submission cases must prove substantial similarity of *copyright-protected* elements." *Id.* Rather, because the claim

is based in contract, unauthorized use can be shown by substantially similar elements that are not protected under copyright law. " 'There is nothing unreasonable in the assumption that a producer would obligate himself to pay for the disclosure of an idea which he would otherwise be legally free to use, but which in fact, he would be unable to use but for the disclosure.' " *Blaustein v. Burton*, 9 Cal. App. 3d 161, 183, 88 Cal. Rptr. 319 (Ct. App. 1970) (quoting *Chandler*, 156 Cal. App. 2d at 441-42). Therefore, our holding (above) that the Screenplay and the Film are not substantially similar for purposes [**28] of copyright infringement does not preclude a finding of substantial similarity for purposes of an implied-in-fact contract under California law. See *Grosso*, 383 F.3d at 967 (affirming grant of summary judgment for defendants on copyright claim due to lack of substantial similarity, but remanding claim of breach of an implied-in-fact contract).

Defendants argue that because the Benays submitted a completed screenplay we must analyze their contract claim in the same manner as their copyright claim. Defendants' argument is counterintuitive. They concede that if the Benays had submitted in outline form the idea of an American Civil War veteran who helps modernize the Japanese Imperial Army and fights against the samurai, the Benays would be protected against unauthorized use under an implied-in-fact contract though not under copyright law. But they argue that because the idea was embodied in a completed screenplay, an implied-in-fact contract can provide no protection beyond that already provided by copyright law.

California case law does not support the proposition that when a complete script is submitted under an implied-in-fact contract, only those elements of the script that are protected [**29] under federal copyright law are covered by the contract. In *Ware v. Columbia Broadcasting System, Inc.*, 253 Cal. App. 2d 489, 494-96, 61 Cal.

Rptr. 590 (Ct. App. 1967), the court of appeal was unwilling to find breach of an implied-in-fact contract where the only similarity between the plaintiff's completed script and the defendant's television episode was that the protagonists in both spoke to inanimate figures (a mannequin in one and a miniature [*632] museum exhibit in the other) and in the end themselves became inanimate figures. *Id.* at 490-91. The court in *Ware* did not hold that a plaintiff who has submitted a completed script can have no contract-based protection of the ideas in that script beyond that afforded by copyright law. The court suggested that the outcome might have been different if the plaintiff had submitted only the basic idea of a protagonist who speaks with inanimate figures and then becomes such a figure. But the plaintiff in that case alleged an implied contract in which the use of an entire "literary property," rather than merely the use of a concept or idea, was offered for sale: "Plaintiff does not allege that the parties contracted with respect to any idea, synopsis, or format. Literary [**30] property is what plaintiff had for sale; that is what he submitted to defendants, and that is the subject matter of his complaint." *Id.* at 494.

In *Donahue v. Ziv Television Programs, Inc.*, 245 Cal. App. 2d 593, 597, 601, 54 Cal. Rptr. 130 (Ct. App. 1966), the court of appeal held that actionable use existed if there were "enough similarities in basic plot ideas, themes, sequences and dramatic 'gimmicks' " between plaintiffs' submission of a "format in written form, together with twelve story outlines, one screenplay and a proposed budget," and defendants' television series. In *Desny*, the California Supreme Court reversed a grant of summary judgment for defendants after comparing elements of plaintiff's submitted synopsis to a synopsis of defendants' photoplay. 46 Cal. 2d at 746-50. In *Blaustein*, the court found a triable issue of fact as to use after comparing the defendants' movie with plaintiff's idea to film Shakespeare's "The Taming of the Shrew" in Italy, with Richard Burton and Elizabeth Taylor starring,

Franco Zeffirelli directing, and various scenes cut from or added to the play. 9 Cal. App. 3d at 184.

In *Grosso*, we recognized that the analysis of similarity under an implied-in-fact contract claim [**31] is different from the analysis of a copyright claim, even where the plaintiff has submitted a full copyright-protected script. 383 F.3d at 967-68. In that case, we affirmed summary judgment for the defendant on the copyright claim because we agreed with the district court that the defendants' movie was not substantially similar to the plaintiff's screenplay. *Id.* But despite this conclusion, we reversed the grant of summary judgment as to the implied-in-fact contract claim and remanded to the district court. *Id.*

As noted above, the Screenplay and the Film share a number of similarities. Most notably, in both works, the protagonist is an embittered American war veteran who travels to Japan where he meets the Emperor, trains the Imperial Army in modern warfare, fights against the samurai, and in the end is spiritually restored. Both works are set at the time of the Satsuma Rebellion of 1877; both works rely heavily on the historical figure Saigo Takamori; and both works share the same title. These similarities are substantial for purposes of an implied-in-fact contract under California law.

We emphasize that we do not here decide whether, and to what degree, these similarities are due to [**32] use of the Benays' Screenplay by Defendants. Suffice it to say that there may be evidence in the record from which a reasonable fact-finder could find unauthorized use by the Defendants. We leave to the district court on remand the task of determining whether there was unauthorized use by Defendants of elements or ideas from the Benays' Screenplay.

2. Statute of Limitations

Defendants argue that the Benays filed their claim more than two years after [**633] their claim

accrued, and that the claim is therefore barred by the statute of limitations. *See Blaustein*, 9 Cal. App. 3d at 185 (two year statute of limitations for implied-in-fact contract claims, under *California Civil Procedure Code* § 339). The Benays filed their claim exactly two years after the release of the Film. Therefore, if their claim accrued at any point before the Film's release, it is time-barred. The district court rejected Defendants' argument that as a matter of law the statute of limitations began to run before the first public release of the film. We agree with the district court.

Defendants contend that the date of accrual depends on when the Benays became aware of Defendants' use of the Screenplay. Defendants argue that [**33] the Benays knew about the development of the Film before it was released, and that their claim therefore accrued before that date. However, the accrual date of an implied-in-fact contract claim "depends on the nature of [Defendants'] obligation, if any, to [the Benays]." *Blaustein*, 9 Cal. App. 3d at 185. In *Blaustein*, the court of appeal refused to find on a motion for summary judgment that the action was barred by the statute of limitations:

A trier of fact might conclude that [the actionable] use was intended to occur the moment a preliminary script is written embodying [plaintiff's] idea, even if in fact no motion picture production, based upon such script, ever occurs. The court might also find that the implied promise to pay arose upon respondents' disclosure of the idea to a substantial segment of the public since such use would tend to destroy any further marketability of the idea.

Id. at 186.

Because the parties' intent is difficult to ascertain in implied-in-fact contract cases,

California courts generally assume that the accrual date is the date on which the work is released to the general public:

[In] implied contract cases, the parties will not have defined the requisite use. [**34] Accordingly, in the absence of any reason to hold otherwise, only a use that "disclosed the idea to a substantial segment of the public" should be regarded as the kind of use requiring payment. For only that type of use "would certainly destroy any further marketability of the idea."

4 *Nimmer § 19D.07[D]* (quoting *Thompson v. Cal. Brewing Co.*, 191 Cal. App. 2d 506, 510, 12 Cal. Rptr. 783 (Ct. App. 1961)).

In *Davies v. Krasna*, 14 Cal. 3d 502, 511-12, 121 Cal. Rptr. 705, 535 P.2d 1161 (1975), the California Supreme Court noted that "[a] suit for breach of an implied contract not to exploit an idea without paying for it does arise only with the sale or exploitation of the idea." 14 Cal. 3d at 511-12. In *Thompson*, the court of appeal held that extensive "test" advertising in San Diego and Sacramento started the running of the statute of limitations only because it "immediately disclosed the idea to a substantial segment of the public," which "would certainly destroy any further marketability of the idea." 191 Cal. App. 2d at 510. In *Donahue v. United Artists Corp.*, 2 Cal. App. 3d 794, 802, 83 Cal. Rptr. 131 (Ct. App. 1969), the court of appeal wrote that "the private auditioning of a film to national advertising agencies" did not compare with "the exhibition of [**35] the idea to 'a substantial

segment of the public in two metropolitan centers in this state,' " and therefore did not cause the action to accrue. The court held that the cause of action accrued at the later time, when the idea was exhibited to a "substantial segment of the public." *Id.*

[*634] 3. Privity of Contract

Finally, Defendants argue that there was privity of contract only between the Benays and Bedford Falls, and that the Benays' contract claim must therefore be dismissed as to all other defendants. Privity between the parties is a necessary element of an implied-in-fact contract claim. *See Rokos v. Peck*, 182 Cal. App. 3d 604, 617-18, 227 Cal. Rptr. 480 (Ct. App. 1986); *Mann*, 128 Cal. App. 3d at 647 n.6. The Benays point out that Defendants did not make their privity-of-contract argument in the district court. The Benays therefore did not have an opportunity to organize and present evidence in the district court in response.

We decline to reach the question whether there is privity of contract between the Benays and defendants other than Bedford Falls. We leave it to the district court to decide this question if and when it is properly presented by Defendants.

Conclusion

We affirm the district court's grant [**36] of summary judgment for Defendants on the Benays' copyright infringement claim. We reverse the grant of summary judgment on the Benays' breach of contract claim and remand for further proceedings consistent with this opinion. We award costs on appeal to the Benays.

AFFIRMED IN PART AND REVERSED IN PART.