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CASE NOTE

The Incredibly Shrinking Triable Issue: Summary Judgment in Copyright Infringement after *Denker v. Uhry*

I. INTRODUCTION

The seminal copyright case *Arnstein v. Porter*¹ is heavily cited because of its clarity in articulating the framework for analyzing copyright infringement actions.² However, Judge Frank's holding in *Arnstein* that summary judgment should be denied if "there is the slightest doubt as to the facts,"³ has been soundly disparaged,⁴ compelling at least one commentator to remark that "*Arnstein* is dead" with regard to the issue of summary judgment.⁵ As we eulogize over *Arnstein*'s demise, we must ask what has risen from its ashes. *Denker v. Uhry*,⁶ a 1992 case out of the Second Circuit, signals a radical departure from *Arnstein*'s "slightest doubt" standard, holding that a court may dismiss an infringement claim on a summary judgment motion even after the potential infringer has admitted to actual copying.⁷ Such a dismissal would be based on a subjective analysis previously reserved for the trier of fact regarding the similarity between the copyrighted work and the allegedly infringing work.⁸ By analyzing the *Denker* decision in the context of established copyright and summary judgment principles, and juxtaposing the decision with two other recent copyright cases out of the Seventh and Ninth Circuits, this note seeks to determine whether, under the *Denker* analysis, the copyright owner's infringement claim is given sufficient protection.

1. 154 F.2d 464 (2d Cir. 1946).

2. See Alan Latman, *Probative Similarity as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement*, 90 COLUM. L. REV. 1187, 1191 (1990).

3. *Arnstein*, 154 F.2d at 468.

4. *Dressler v. MV Sandpiper*, 331 F.2d 130 (2d Cir. 1964), *Beal v. Lindsay*, 468 F.2d 287 (2d Cir. 1972), *Warner Bros. v. American Broadcasting Cos.*, 654 F.2d 204 (2d Cir. 1981), *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986).

5. Alan Hartnick, *Summary Judgment in Copyright: From Cole Porter to Superman*, 3 CARDOZO ARTS & ENTER. L.J. 53 (1984).

6. 996 F.2d 301 (2d Cir. 1993), *aff'd.* without opinion.

7. *Denker v. Uhry*, 820 F.Supp. 722, 728, 736 (S.D.N.Y. 1992).

8. *Denker*, 820 F.Supp. 728.; *Arnstein*, 154 F.2d at 468; *Sid & Marty Kroffit Television Prods. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977).; *Shaw v. Lindheim*, 919 F.2d 1353 (9th Cir. 1990).

II. BACKGROUND

A. *The Purpose of Copyright Law*

The Constitution provides that Congress shall have the power “to promote the progress of science and useful arts, by securing for limited time to authors and inventors the exclusive right to their respective writings and discoveries.”⁹ Copyright laws serve to promote the “progress of science and useful arts” by protecting the labors of those who create original works and thereby ensuring the profitability of their endeavors and their willingness to bring novel ideas to the public.¹⁰ The Supreme Court has stated that “the economic philosophy behind the clause . . . is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare.”¹¹

The ultimate aim of copyright law, therefore, is to create an incentive which will stimulate artistic creativity for the public good.¹² Copyright law attempts to achieve this aim by granting the copyright holder a limited monopoly in the form of exclusive rights over her creation.¹³ However, a delicate equilibrium must be reached which affords protection to authors as an incentive to create, while appropriately limiting the extent of that protection so as to avoid monopolistic stagnation.¹⁴ Giving authors too much control over their works may deny the public the benefit of authors’ creations, while giving them too little control may destroy their incentive to create socially valuable works.¹⁵

B. *Copyright Infringement*

It is well settled that a copyright infringement claim contains two basic elements: (1) the plaintiff’s ownership of a valid copyright in a work; and (2) copying by the defendant in creating his subsequent work.¹⁶ Analysis of the first element requires a court to determine whether the work in question is “an original work of authorship fixed in any tangible medium of expression.”¹⁷ A court must also determine which elements of the copyrighted work are protected. Only an author’s original expression is protected by copyright; facts and ideas within a work are not.¹⁸ In the case of compilations of factual information, the

9. U.S. CONST. art. I, §8, cl. 8; 1 NIMMER ON COPYRIGHT §1.02 (1963).

10. *Stillman v. Leo Burnett Company, Inc.*, 720 F.Supp. 1353, 1357 (N.D. Ill. 1989), (quoting *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 428-29 (1984).)

11. *Computer Assoc. Int’nl. v. Altai, Inc.*, 982 F.2d 693, 696 (2d Cir. 1992)(quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)).

12. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

13. 17 U.S.C.A. § 105 (1976); 1 NIMMER ON COPYRIGHT §1.03[A].

14. *Altai*, 982 F.2d 693.

15. See Note, *Computer Software Rental Amendments Act*, 41 CATH. U. L. REV. 177, 183 (1991).

16. 3M NIMMER ON COPYRIGHT § 13.01 (1963); *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 548 (1985).; *Stillman*, 720 F.Supp. at 1358.; *Arnstein*, 154 F.2d at 468.

17. 17 U.S.C.A. § 102 (1976).

18. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. at 556; *Feist Publications v. Rural Telephone Service Company*, 499 U.S. 340, 345.

17 U.S.C.A. § 102(b) states:

compiler's selection and arrangement of the facts may be protected if such selection and arrangement constitute original expression.¹⁹

Over the years, courts have elaborated on the second element, copying, with varying degrees of lucidity. Perhaps the most successful attempt at synthesizing the various formulations espoused by leading cases in this area was made by the Seventh Circuit in *Stillman v. Leo Burnett Company, Inc.*²⁰ The *Stillman* court stated the copyright infringement test as follows:

To prevail on a copyright claim, a plaintiff must prove (1) a valid copyright, and (2) illicit copying. To prove illicit copying, he must establish both (1) copying, and (2) unlawful appropriation. To establish copying, a plaintiff must show (1) access, and (2) substantial similarity between the works "when compared in their entirety including both protectible and unprotectible material." Finally, to show unlawful appropriation (i.e., substantial similarity as a matter of law) the plaintiff must demonstrate that the defendant's copying extended to the plaintiff's protectible expression.²¹

With this articulation, the *Stillman* court successfully illuminated the often confusing dual usage of the term "copying" by distinguishing between "copying," referring to the "factual issue of whether the defendant has used the plaintiff's work as a starting point for his own," and "illicit copying," referring to the "legal issue of whether the defendant has violated the copyright laws by reproducing protectible expression from the plaintiff's work."²² This distinction is important because, traditionally, the former has been decided by the court following a detailed factual analysis of the concrete elements of the works in question.²³ The latter can be reached only after the trier of fact has concluded that, according to the ordinary observer, the "accused work has captured the 'total concept and feel' of the copyrighted work," and is, therefore, substantially similar to the original copyrighted work as a matter of law.²⁴

In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.).

Judge Learned Hand articulated the widely used "abstractions test" for distinguishing between unprotected ideas and protected expression:

Upon any work . . . a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out . . . [T]here 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.

Nash v. CBS, 704 F.Supp. 823, 827 (N.D. Ill. 1989)(citing *Atari v. North American*, 672 F.2d 607, 615-16 (7th Cir. 1982), (quoting *Nichols v. Universal Pictures*, 45 F.2d 119, 121 (2d Cir. 1930)).

19. *Feist*, 499 U.S. at 345.

20. *Stillman v. Leo Burnett Company, Inc.*, 720 F. Supp. 1353, 1358 (N.D. Ill. 1989). Of course *Stillman* owes a debt to *Arnstein v. Porter*, fn. 1 *supra*, which established the basic framework upon which leading copyright cases have elaborated.

21. *Id.* at 1358 (footnotes omitted).

22. *Id.* at 1357.

23. See *Krofft*, 562 F.2d at 1163.; *Arnstein v. Porter*, 154 F.2d at 468-469.

24. *Stillman*, 720 F. Supp. at 1359; *Atari*, 672 F.2d at 614; *Krofft*, 562 F.2d at 1164; *Arnstein*,

The Ninth Circuit's articulation of the copyright infringement test differs from the Seventh Circuit's mainly in terminology, but the differences are worth noting. Like the Seventh Circuit in *Stillman*, the Ninth Circuit in *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*²⁵ set forth a two-prong test for proving illicit copying. The first prong or "extrinsic test" addresses "copying," and the second prong or "intrinsic test" addresses "unlawful appropriation."²⁶ The *Krofft* 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 protectible expression under the "intrinsic test."²⁷ Under the extrinsic test, analytic dissection and expert testimony are appropriate to determine if copying of certain concrete elements such as the type of artwork involved, the materials used, the subject matter, the setting of the subject, plot, theme, character, dialogue, mood, pace, and sequence has occurred.²⁸ The extrinsic test does not depend on the responses of the trier of fact, but may be decided as a matter of law. The intrinsic test, by contrast, does not depend on the analysis of specific criteria but on the general observations and impressions of the "ordinary reasonable person." Therefore, analytic dissection and expert testimony are not appropriate under this prong.²⁹

C. Summary Judgment Overview

"Since substantial similarity is usually an extremely close question of fact, summary judgment has traditionally been disfavored in copyright litigation."³⁰ As the *Krofft* court explained, summary judgment is rarely appropriate under the unlawful appropriation prong of the copyright infringement test since laymen are as qualified as judges to determine the reactions of the ordinary observer.³¹ However, the evolution of summary judgment and its increased acceptance as a means of disposing of meritless claims have caused courts to reevaluate its application in copyright infringement actions. Most notably, a pair of Supreme Court cases decided in 1986 demonstrated the Court's willingness to use the summary judgment motion to achieve its intended purpose of disposing of meritless claims.³² As Justice Rehnquist stated in *Celotex Corp. v. Catrett*, "Summary judgment procedure is properly regarded not as a disfavored

154 F.2d at 468.

25. *Krofft*, 562 F.2d 1157.

26. *Id.* at 1163-1164.

27. *Id.*

28. *Shaw*, 919 F.2d at 1356 (quoting *Jason v. Fonda*, 526 F. Supp. 774 (C.D. Cal. 1981)).

29. *Krofft*, 562 F.2d at 1164.

30. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 977 (2d Cir. 1980).

31. *Krofft*, 562 F.2d at 1166.

32. *Celotex*, 477 U.S. 317.; *Liberty Lobby*, 477 U.S. 242. Justice Rehnquist demonstrated his affection for the summary judgment motion in *Celotex* by stating, "One of the principal purposes of the summary judgment rule is to isolate and dispose of factually unsupported claims or defenses, and we think it should be interpreted in a way that allows it to accomplish this purpose." *Celotex*, 477 U.S. at 323-24.

procedural shortcut, but rather as an integral part of the Federal Rules as a whole, which are designed to secure the just, speedy, and inexpensive determination of every action."³³ Many courts have adopted this favorable stance towards summary judgment in the context of copyright infringement cases.³⁴

The purpose of summary judgment is to isolate and dispose of factually unsupported claims in the interests of justice and efficiency.³⁵ Accordingly, Rule 56 of the Federal Rules of Civil Procedure provides that summary judgment is appropriate "only if the pleadings, supporting papers, affidavits, and admissions on file, when viewed with all references in favor of the nonmoving party, demonstrate that there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law."³⁶ "An issue is 'genuine' if the evidence is such that a reasonable jury could find for the non-moving party on that issue."³⁷ A fact is "material" if it influences the outcome of the litigation under governing law.³⁸ The moving party not only has the burden of making a prima facie showing that there is no genuine issue of material fact, he also retains the burden of persuasion once the prima facie case has been rebutted by facts pointing to a genuine issue.³⁹ A moving party is entitled to judgment as a matter of law when the non-moving 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."⁴⁰ However, when ruling on a motion for summary judgment, "the judge's function is not himself to weigh the evidence and determine the truth of the matter, but to determine whether there is a genuine issue for trial."⁴¹ "If there remains any doubt as to whether a trial is necessary, summary judgment should not be granted."⁴²

III. SUMMARY JUDGMENT APPLIED TO COPYRIGHT INFRINGEMENT: FRAMING THE ISSUE

It is against this backdrop that federal courts have recently explored the parameters of the summary judgment motion in the copyright context. The

33. *Celotex Corp.*, 477 U.S. 317 (footnotes omitted). See also *Liberty Lobby*, 477 U.S. at 253 (holding that the clear-and-convincing standard of proof, rather than the scintilla of evidence standard, should be taken into account in ruling on a summary judgment motion).

34. *Nash v. CBS*, 899 F.2d 1537 (7th Cir. 1990); *Green v. Proctor & Gamble, Inc.*, 709 F.Supp. 418 (S.D.N.Y. 1989); *Warner Bros.*, 654 F.2d 204; *Beal*, 468 F.2d 287.

35. See *Celotex*, 477 U.S. at 323; Hartnick, *supra* note 5, at 54.

36. FED.R.CIV.P. Rule 56(c); *Jarvis v. A&M Records*, 827 F. Supp. 282 (D.N.J. 1993).

37. *Jarvis*, 827 F.Supp. at 287 (citing *Anderson Inc.*, 477 U.S. at 248.);

Justice White noted in *Anderson* that the "genuine issue" standard for summary judgment and the "reasonable jury" standard for a motion for directed verdict are "very close." The inquiry under each is "whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law. *Id.* at 251-52.

38. *Liberty Lobby*, 477 U.S. at 248.

39. *Jarvis*, 827 F.Supp. at 288.

40. *Shaw*, 919 F.2d at 1359 (quoting *Celotex*, 477 U.S. at 322-23).

41. *Anderson*, 477 U.S. at 249.

42. *Jarvis*, 827 F.Supp. at 288. (See *Celotex Corp.*, 477 U.S. 317, 330-333).

question presented is this: At what point in the application of the infringement test can a court, not the trier of fact, decide that no genuine issue of material fact exists to take the case to a jury? More specifically, once copying of concrete elements of a plaintiff's work has been established under the first prong of the infringement test, may a court conclude that the two works are not substantially similar based on its own subjective analysis under the second prong, thereby dismissing the copyright owner's claim by granting summary judgment to the defendant? Two recent cases, *Shaw v. Lindheim*⁴³ out of the Ninth Circuit and *Nash v. CBS*⁴⁴ out of the Seventh Circuit, illustrate a difference of opinion among the federal courts on this issue.

A. *Shaw v. Lindheim*

In *Shaw*, the plaintiff, a well-known television writer and producer, entered into an option contract with NBC Television for the development of his pilot script entitled "The Equalizer." Shaw delivered the script to the defendant Richard Lindheim who, at that time, worked for NBC as an executive in the Dramatic Programming Division. Lindheim read Shaw's script, but when NBC decided not to produce it all rights to the script reverted back to Shaw. Following his departure from NBC in 1979 to work for Universal Television, Lindheim wrote his own television pilot entitled "The Equalizer" which Universal developed into a series for CBS.⁴⁵

Shaw filed a copyright infringement action in the United States District Court for the Central District of California claiming that the defendant's script and the subsequent television series were substantially similar to the script that Shaw had previously submitted to the defendant while he worked for NBC.⁴⁶ After finding substantial similarities between the two works' concrete elements under the extrinsic test of the *Krofft* framework,⁴⁷ the court nevertheless determined that the works were not substantially similar as a matter of law, and granted summary judgment in favor of the defendant.⁴⁸ Shaw appealed.

Judge Alarcon of the United States Court of Appeals for the Ninth Circuit began his analysis by stating that if reasonable minds could differ on the issue of substantial similarity, the granting of summary judgment would be improper.⁴⁹ The issue before court on appeal was whether the district court erred in granting summary judgment for the defendant after concluding that reasonable minds might find the objective characteristics of the two works, namely theme, plot, sequence of events, characters, dialogue, setting, mood, and pace to be substantially similar.⁵⁰

43. 919 F.2d 1353.

44. 899 F.2d 1537 (7th Cir. 1990).

45. *Shaw*, 919 F.2d 1353, 1355.

46. *Id.* at 1355.

47. *Id.* at 1357-58.

48. *Id.* at 1358.

49. *Id.* at 1355.

50. *Id.* at 1356.

In reversing the district court's summary judgment determination, Judge Alarcon declared that in a copyright infringement action involving a literary work, "satisfaction of the extrinsic test creates a triable issue of fact" which precludes summary judgement based on an absence of substantial similarity under the intrinsic test.⁵¹ Judge Alarcon stated, significantly, that when the objective elements of the two works are found to be substantially similar by the court, "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."⁵² Since the district court's finding of substantial similarity was devoid of analysis, based on nothing more than a subjective judgment regarding the "total concept and feel" of the two works, granting summary judgment for the defendant was improper.⁵³ The court reasoned 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 for trial."⁵⁴ The court summed up its holding as follows:

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 . . . It is for the trier of fact to determine whether the intrinsic test is satisfied.⁵⁵

B. *Nash v. CBS, Inc.*

The plaintiff in *Nash* had written a number of books, including *The Dillinger Dossier*, published in 1983, about the notorious American outlaw John Dillinger.⁵⁶ In these works Nash theorized that John Dillinger did not die in 1934, as is popularly believed, in front of the Biograph Theater in Chicago after being led into a storm of F.B.I. gunfire by the infamous "lady in red." Instead,

51. *Id.* at 1358, 1361.

The court in *Shaw* distinguished cases in which the idea and expression had merged, stating that "no substantial similarity will be found (under the intrinsic test) when the 'idea and its expression are . . . inseparable,' given that 'protecting the expression in such circumstances would confer a monopoly of the idea upon the copyright owner.'" *Id.* at 1360 (quoting *Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 208 (9th Cir. 1988)).

The court contrasted examples of merger, such as a stuffed dinosaur toy, a karate video game, and a jeweled bee pin, with literary works in which "there is an infinite variety of novel or creative expression available to the author . . . based on a preexisting idea. *Id.*

52. *Shaw*, 919 F.2d at 1357. Judge Alarcon found the terms "objective" and "subjective" to be more agreeable than "extrinsic" and "intrinsic."

53. *Id.* at 1359.

54. *Id.* at 1359 (quoting *Liberty Lobby*, 477 U.S. at 249).

55. *Shaw*, 919 F.2d at 1361.

56. *Nash*, 704 F. Supp. 823, 827 (N.D. Ill. 1989). Nash's "Dillinger Story" appeared in four of his works including: *Dillinger: Dead or Alive?*, *Citizen Hoover*, *Bloodletters and Badmen*, and *The Dillinger Dossier*.

Nash's research attempted to show that Dillinger sent a look-alike in his place on the fated evening, and that the embarrassed F.B.I. kept the mistake a secret from the public.⁵⁷ The real Dillinger, Nash posited, assumed an alias, married, and moved to the west coast where he survived until at least 1979.⁵⁸

In 1979, CBS Television broadcast an episode of its dramatic series *Simon and Simon* entitled *The Dillinger Print*. The plaintiff sued CBS for copyright infringement, claiming that *The Dillinger Print* violated the copyright in his version of Dillinger's life story. After CBS conceded access to the plaintiff's work and copying of the work's factual material, the district court granted summary judgment in favor of the defendant, holding that the two works were not substantially similar, and that CBS's treatment did not unlawfully appropriate any of the plaintiff's protected expression.⁵⁹ The United States Court of Appeals for the Seventh Circuit affirmed the judgment.⁶⁰

After noting that the defendant conceded copying under the first prong of the infringement test, the district court focused its inquiry on whether the defendant's work unlawfully appropriated copyrightable elements from Nash's work.⁶¹ In a previous opinion, the district court had ruled that Nash indeed held a valid copyright in his version of the *Dillinger Story*.⁶² Therefore, in ruling on the

57. *Nash*, 899 F.2d at 1538.

58. *Id.* at 1538.

Discrepancies between a number of Dillinger's physical characteristics and those of the corpse provided Nash with the evidence to substantiate his theory: Dillinger had a scar on his upper lip and the corpse did not; Dillinger lacked a tooth that the corpse possessed; Dillinger had blue eyes and the corpse had brown eyes; Dillinger had thicker eyebrows than did the corpse. Nash also found suspicious Dillinger's father's choice to encase the corpse in concrete before burial.

59. *Id.* at 1539.

60. *Id.* at 1543.

The Seventh Circuit Court framed the question differently than the district court, focusing on whether the copied material constituted ideas or expression, and whether the defendants took more of the plaintiff's material than was allowed under the "fair use" doctrine. *Id.* at 1540.

Despite this difference in focus, in affirming the district court's judgment, the appellate court implicitly accepted the district court's basis, muddled as it may have been, for granting summary judgment in favor of the defendants.

61. *Nash*, 704 F.Supp. at 826.

Judge Grady of the district court admitted being confused over the nature of the copying prong inquiry, but opted not to resolve the matter because the defendants had conceded copying. Judge Grady stated, "Indeed, the Seventh Circuit has not clearly described the nature of the first prong inquiry . . . Fortunately we can (again) dodge the bullet on a tough question of copyright law. As the defendant agreed to assume copying . . . we need not address the issue." *Id.*

However, in refusing to discern what is meant by "copying" under the first prong of the infringement test, Judge Grady could not accurately assess what the defendants in this case admitted to copying and how that copying might tilt the scale towards denying their motion for summary judgment. Consequently, the bullet that Judge Grady dodged may have severely wounded the copyright owner's protection against infringement.

62. *Id.* at 828.

The United States District Court for the Northern District of Illinois determined that Nash's copyright protected only his presentation and exposition, in other words, his *Dillinger Story*, but not any of the historical events. The court stated generally that "the way in which Nash employs certain facts and evidence to create his own story about Dillinger is copyrightable." *Id.*

defendant's motion for summary judgment in the latter opinion, the district court set out to decide "whether a reasonable trier of fact could find that the Dillinger Print unlawfully appropriated Nash's Dillinger Story."⁶³

Judge Grady of the district court began his analysis by noting that an "eyeball comparison" of the two works revealed that they were similar in only the slightest way.⁶⁴ The court then proceeded to determine at what level of abstraction the two works were substantially similar.⁶⁵ The court found the level of similarity to be only "slightly more particular than the idea that Dillinger did not die in 1934," which was a non-copyrightable fact,⁶⁶ even though the plaintiff had submitted detailed descriptions of particular similarities between the two works.⁶⁷ Concluding that no genuine issue of material fact existed as to "the material issue of substantial similarity," the court granted summary judgment in favor of the defendants.⁶⁸

IV. SUBJECT OPINION: *DENKER V. UHRY*

A. *Facts and Procedure*

The Second Circuit, consistent with the Seventh Circuit in *Nash*, recently ruled in favor of granting a defendant's motion for summary judgment based on unlawful appropriation. In *Denker v. Uhry*,⁶⁹ author and playwright Henry Denker filed a copyright infringement suit against Alfred Uhry and those responsible for the production and distribution of the film version of Uhry's play

The court continued by saying, "We hold only that Nash's interpretive Dillinger Story is copyrightable. Neither the idea that Dillinger did not die in 1934 nor the historical facts cited by Nash in support of the Dillinger Story are protected." Perhaps if this prior opinion had more specifically described what was protectible about Nash's Dillinger Story, the court in the subsequent opinion would have had a more sound basis upon which to decide whether the copying had risen to a level that precluded granting summary judgment to the defendant.

63. *Id.* at 827.

64. *Id.* at 829. Judge Grady stated that the "plot, characters, tone, time period, and mood of the works have almost nothing in common."

65. *Id.* at 829.

66. *Id.* at 829.

67. *Id.* at 829-831. These similarities included the physical discrepancies between the "real" Dillinger and the corpse which the F.B.I. claimed to be Dillinger. *Id.* at 831.

68. *Id.* at 831.

In a confusing opinion, the district court succeeded in obfuscating the already blurry line between the appropriation of unprotected elements of a copyrighted work, and the unlawful appropriation of protectible material that rises to the level of substantial similarity. The court could have avoided this confusion by dismissing the case on the basis that, since the work in question was a historical work, the only protection afforded to it was protection from verbatim reproduction. *Hoeling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980).

Courts have traditionally allowed extensive reliance on prior works of history. *Id.* at 978. The Second Circuit in *Hoeling* held that in order "to avoid a chilling effect on authors who contemplate tackling an historical issue or event, broad latitude must be granted to subsequent authors who make use of historical subject matter, including theories or plots." *Id.* at 978.

Driving Miss Daisy.⁷⁰ Plaintiff Denker claimed that defendant Uhry's play and subsequent screenplay infringed upon Denker's copyright for his novel and play entitled *Horowitz and Mrs. Washington*, which was originally published in 1979 and had a short run on Broadway in 1980. Uhry's play, *Driving Miss Daisy*, won a Pulitzer Prize in 1987. The subsequent screen adaptation won four Academy Awards including best screenplay and best picture.⁷¹

The defendants, after conceding that the plaintiff owned a valid copyright in his prior work and that actual copying had occurred under the first prong of the infringement test, nevertheless moved for summary judgment based on the second prong of the test, unlawful appropriation.⁷² Judge Michael B. Mukasey of the United States District Court for the Southern District of New York determined that the two works were not substantially similar, and therefore held that in the absence of an issue of fact which would be material to the outcome of the litigation, summary judgment for the defendant was proper.⁷³ The United States Court of Appeals for the Second Circuit affirmed the decision without opinion.⁷⁴

B. The District Court's Opinion

Judge Mukasey initially asserted the court's readiness to make its own subjective determination by stating that "a court may determine non-infringement as a matter of law on a motion for summary judgment either because the similarity between the two works concerns only non-copyrightable elements of the plaintiff's work, or because no reasonable jury, properly instructed, could find that the two works are substantially similar."⁷⁵ He further indicated that under an unlawful appropriation analysis, the court could assume the "point of view of the lay reader."⁷⁶

Moving on to the issue of unlawful appropriation, the court thwarted the plaintiff's attempt to introduce expert testimony regarding the works' similarities because expert testimony and analytic dissection are only appropriate under the copying prong analysis.⁷⁷ The court then proceeded to conduct its own analytic dissection and determined that, although similarities indeed existed in theme, setting, tone, plot, dialogue, characters, and the total concept and feel of the works, these similarities were either unprotected ideas and "scenes a faire,"⁷⁸ or

70. *Id.* at 723.

71. *Id.* at 724.

72. *Id.* at 728.

73. *Id.* at 729, 736.

74. *Denker*, 996 F.2d 301 (2d Cir. 1993), *aff'd.* without opinion.

75. *Denker*, 820 F.Supp. at 728.

76. *Id.* at 729.

77. *See Krofft*, 562 F.2d at 1163-64.

78. *Denker*, 820 F.Supp. at 730-36. "Scenes a faire" are stock literary devices, incidents, or events that necessarily follow from a common theme or setting. *See Reyher v. Children's Television Workshop*, 533 F.2d 87, 91 (2d Cir. 1976), *cert. denied*, 429 U.S. 980 (1976); NIMMER, *supra* note 16, at §13.03[B].

could simply not qualify as substantial. Based on just the sort of subjective analysis followed by the Seventh Circuit in *Nash* and criticized by the Ninth Circuit in *Shaw*, the court granted summary judgment in favor of the defendant.⁷⁹

V. ANALYSIS

The question that must be asked is whether a court, in assuming the role traditionally reserved for the trier of fact in copyright actions, that of determining whether an infringing work is substantially similar to a copyrighted work to the degree that it could be said to unlawfully appropriate the original work's protected expression, is in line with the accepted standard for summary judgment motions as articulated by the Supreme Court, and with the goals of copyright law. As a subpart to this question, it must be determined how a concession of copying under the first prong of the infringement test should affect the court's analysis under the unlawful appropriation prong.

A. When Is Evidence "Sufficient" to Create a "Genuine Issue" of Substantial Similarity?

To reiterate, summary judgment may be properly granted when the court determines that there is no genuine issue that is material to the outcome of the litigation based on the evidence presented by the parties to the suit.⁸⁰ The issue that is "material" to the outcome of a copyright infringement action is whether the defendant has illicitly copied the plaintiff's protectible expression.⁸¹ Ownership of a valid copyright is, obviously, insufficient for a finding of infringement. Furthermore, the issue that is material to a finding of illicit copying is unlawful appropriation.⁸² Copying alone under the first prong of the test will not amount to illicit copying. Following this progression, therefore, the issue that is ultimately material to the outcome of a copyright suit is the second prong, unlawful appropriation, and in order to prove unlawful appropriation the plaintiff must show a substantial similarity between the defendant's work and the plaintiff's copyrighted work. From this extrapolation it would appear that the courts in *Denker* and *Nash* correctly and necessarily engaged in a subjective substantial similarity analysis under the second prong, because without so doing, a ruling on the defendant's summary judgment motion would not be possible. The problem with this conclusion is that it accords little significance to the first prong of the infringement test under which the defendant has admitted to an undisclosed degree of copying. Such a conclusion also contravenes a body of precedent calling for the trier of fact to decide whether two works are substantially similar.

79. *Denker*, 820 F.Supp. at 736.

80. *Jarvis*, 827 F.Supp. at 287.

81. *Denker*, 820 F.Supp. at 729, 730, 736.

82. *Stillman*, 720 F.Supp. at 1358.; *Krofft*, 562 F.2d at 1164-65.; *Arnstein*, 154 F.2d at 468.

The Court in *Shaw* held that once a party demonstrates a triable issue of fact under the extrinsic or copying test, she has made a sufficient showing of substantial similarity to defeat a summary judgment motion. Otherwise, a court would merely be engaging in its own subjective determination of similarity, in direct conflict with the proper function of the judge at the summary judgment stage, which is to determine whether there is a genuine issue for trial.⁸³ The courts in *Denker* and *Nash*, on the other hand, were not persuaded that there was a triable issue of fact even though the defendants in both of those cases had conceded the copying prong of the infringement test.⁸⁴ Is there any way to reconcile these seemingly polar positions?

In *Shaw*, the district court had already undergone an extensive analytic dissection of the concrete elements of both the plaintiff's and defendant's television screenplays and had determined that substantial similarities did indeed exist among these elements.⁸⁵ What the appellate court found so objectionable was the apparent arbitrariness of the district court's subjective determination that the "total concept and feel" of the works was not substantially similar after already engaging in this extensive analysis.⁸⁶ In both *Denker* and *Nash*, however, the court was prevented from analyzing the constituent elements of the works by the defendants' stipulation that they had copied some elements of the plaintiff's work under the first prong of the infringement test.⁸⁷ The defendant's concession, therefore, clearly was detrimental to the plaintiff's chances of proving substantial similarity because it removed the plaintiff's opportunity to present expert testimony and to engage in analytic dissection.

The *Denker/Nash* courts, then, were left with the choice of embracing a per se rule that concession of the copying prong creates a triable issue, or determining whether there was a genuine issue on the basis of the unlawful appropriation prong of the test after first eliminating from the analysis those elements of the plaintiff's work that were not copyrightable. Choosing the former would undoubtedly impair the effectiveness of the summary judgment motion. In addition, allowing the case to proceed to trial based solely on a concession would be undesirable because the court would be precluded from engaging in the preliminary abstraction process to determine the elements in the copyrighted work that are protected. Such a cursory treatment of a defendant's case would run the risk of drawing the defendant into a lengthy litigation process that may potentially be based on a frivolous claim. In light of these risks, the *Denker/Nash* approach seems logical. However, there is an inherent potential for abuse and inequity in allowing defendants to subvert the plaintiff's ability to present expert testimony simply by conceding that copying occurred. Ironically, the *Denker* and *Nash* decisions may very well provide an incentive for defendants to concede copying as a preemptive strike against a plaintiff's infringement claim.

83. *Shaw*, 919 F.2d at 1359, (citing *Liberty Lobby*, 477 U.S. at 249).

84. *Denker*, 820 F.Supp. at 728.; *Nash*, 899 F.2d at 1539.

85. *Shaw*, 919 F.2d at 1358.

86. *Id.*

87. *Denker*, 820 F.Supp. at 728.; *Nash*, 899 F.2d at 1539.

*B. Allowing Expert Testimony and Analytic Dissection
under the Second Prong: The Altai Approach*

The New York District Court in *Denker* may have been able to strike a balance between the two extremes represented in the *Shaw* and *Nash* opinions by following another 1992 decision out of its own Second Circuit. In *Computer Assoc. Int'l, Inc. v. Altai, Inc.*,⁸⁸ the Second Circuit expressed an "alternative way of formulating the issue of substantial similarity" in the context of computer programs. The court set out its three-part "abstraction-filtration-comparison" test as follows:

In ascertaining substantial similarity under this approach, a court would first break down the allegedly infringed program into its constituent structural parts. Then by examining each of these parts for such things as incorporated ideas, expression that is necessarily incidental to those ideas, and elements that are taken from the public domain, a court would then be able to sift out all non-protectible material. Left with a kernel, or possibly kernels of creative expression after following this process of elimination, the court's last step would be to compare this material with the structure of an allegedly infringing program. The result of this comparison will determine whether the protectible elements of the programs at issue are substantially similar so as to warrant a finding of infringement.⁸⁹

In other words, a court following the *Altai* approach would conduct its normal analytic dissection under the first prong of the infringement test, using expert testimony to discern whether there is circumstantial evidence of copying based upon a substantial similarity between the infringing work and the protectible and unprotectible expression in the (allegedly) infringed work. Then, under the unlawful appropriation prong, the court will allow expert testimony and further analytic dissection to determine whether there is a substantial similarity between the protectible elements of the infringing work and the infringing work. Essentially, the *Altai* court encouraged analytic dissection during the unlawful appropriation prong in order to sift out non-protectible elements of the allegedly infringed work before comparing the two works to determine whether they are substantially similar. More importantly the court advocated the use of expert testimony in the unlawful appropriation analysis to assist the trier of fact in interpreting the evidence.⁹⁰

Although the court's rationale for allowing expert testimony rested on the highly technical nature of computer programs, a strong argument can be made to use this approach with all literary works⁹¹ when the defendant has conceded copying under the extrinsic test. The *Shaw* court pointed out that "there is an

88. 982 F.2d 693.

89. *Id.* at 706.

90. *Id.* at 713.

91. See 17 U.S.C.A. § 101 (1976) which defines "literary works" as "works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied."

infinite variety of novel or creative expression available to the author of a book, script, play, or motion picture,” based on a given idea.⁹² Therefore, it could be argued that a judge may be just as incapable of making a knowledgeable assessment of the similarities between two screenplays, considering the infinite variety of possible expression of each constituent element (ie. theme, character, plot, setting, etc.), as she would in assessing the similarities between two computer programs.

The unlawful appropriation analysis in both the *Denker* and *Nash* opinions dwelled upon the distinction between protectible and unprotectible elements of the copyrighted literary works in question. Before the courts could decide whether the defendant’s work was substantially similar to the plaintiff’s, they had to first eliminate the unprotected expression from their analysis, and then compare only what remained as protected material. The inherent difficulty in this “abstraction” approach has long been a source of anxiety for courts. Even Judge Hand, who first articulated the abstractions test, admitted, “Obviously no principle can be stated as to when an imitator has gone beyond copying the idea and has borrowed its expression. Decisions must inevitably be ad hoc.”⁹³ As difficult as this distillation may be, however, an accurate appraisal of what is protected is essential in assessing the merit of an infringement claim on a motion for summary judgment. The *Shaw* court’s primary concern was the absence of legal analysis in the district court’s determination that the works were not substantially similar under the intrinsic test. Application of *Altai* principles will solve this problem by allowing a plaintiff to use expert testimony in its abstraction-filtration process under the intrinsic prong, thereby enabling the court to more clearly distinguish between protected expression and unprotected ideas. This, in turn, will enable a court to more accurately assess the merit of the claim of infringement by minimizing the danger of a court making a purely subjective determination, “devoid of analysis,” regarding the similarity between two works.

Conceding copying should not have the effect of bolstering the defendant’s case. To the contrary, such a concession should alert the court to exact a higher level of scrutiny under its unlawful appropriation analysis. If the court is to engage in an analytic dissection of the works in question, as inevitably it must to determine whether the defendant has copied protected expression, the copyright owner should be afforded the opportunity to present sufficient evidence, including expert testimony, to assist in the court’s analysis. This safeguard is especially crucial when the copyright owner has been denied the ability to use his expert testimony as a result of the defendant having admitted copying under the extrinsic test. In such a case, a per se rule allowing the copyright owner to “carry over” his right to present expert testimony into the intrinsic stage is necessary to prevent potential abuse by defendants, and an erosion of the copyright owner’s protection under copyright law.

92. *Shaw*, 919 F.2d at 1360.

93. *Id.* at 1356 (quoting *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960)).

VI. CONCLUSION

A per se rule, such as the one adopted in *Shaw*, allows the trier of fact to decide whether the defendant, who has clearly used the plaintiff's work as a starting point for his own, has illicitly copied the plaintiff's protected expression. In so doing, this per se rule may afford the copyright owner more protection than the *Denker/Nash* approach by virtue of allowing her case to proceed more readily to a trial on the merits. From the standpoint of protecting the copyright owner's incentive to create, this approach is much more desirable. The impact of such a rule, however, will likely increase the burden on the judicial system, a result that is contrary to the intent behind the summary judgment motion. The *Denker/Nash* approach may better serve the efficiency interest behind the summary judgment motion, but what is gained in efficiency is severely diminished by the copyright owner's loss of protection and, with it, her incentive to create. Applying the *Altai* formulation, and allowing expert testimony to carry over into the unlawful appropriation analysis after a defendant has conceded copying may provide an equitable solution to this blatant disparity among the federal circuits regarding the issue of summary judgment in copyright infringement suits.

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