

This Book Is a Movie: The Faithful
Adaptation as a Benchmark for
Analyzing the Substantial Similarity
of Works in Different Media

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* Law Clerk to the Honorable Consuelo M. Callahan, United States Circuit Judge, United States Court of Appeals for the Ninth Circuit, and former Law Clerk to the Honorable Timothy M. Burgess, United States District Judge, United States District Court for the District of Alaska. I thank Judge Callahan, Judge Burgess, Stewart E. Sterk, Pamela Samuelson, Michael Abramowicz, Jerry L. Dasti, Jinnifer Pitcher, Robert Keele, Kevin Noble Maillard, and Eric C. Chaffee for their helpful comments and encouragement. The title of this article comes from a song by the band Spoon. SPOON, *This Book Is a Movie*, on GIRLS CAN TELL (Merge Records 2001). I would have worked in a clever reference to the lyrics somewhere if not for the fact that it is an instrumental.

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ABSTRACT

How should courts compare works in different media when determining whether one infringes the other? A plaintiff in a copyright infringement action must establish that the defendant’s work is “substantially similar” to the plaintiff’s work. In order to determine whether two works are substantially similar, courts typically evaluate the elements of the works that constitute “protected expression,” which differ depending on the work’s medium (e.g., literary, film, visual artwork, photography, music, etc.). Courts and commentators generally agree that the differences in media are not relevant to whether two works are substantially similar, but have not explained how to compare expressive elements of works in different media.

In this Article, drawing on the nature of the statutory derivative work right as clarified by the theoretical research and related case law, I argue that courts should translate the expressive elements of the plaintiff’s original work into equivalent modes of expression in the new medium to create a hypothetical “faithful adaptation.” The faithful adaptation would then serve as the benchmark for comparison to the defendant’s work. The author’s right to create transformations (or derivatives) of the original work must serve as the basis for comparison because it is the right that has allegedly been infringed. Thus, applying the “faithful adaptation” standard will transform the plaintiff’s “orange” into an “apple” to allow for an “apples-to-apples” comparison of the two works. Accordingly, adopting the faithful adaptation standard will allow courts to apply the existing variations of the substantial similarity test to works in different media without being derailed by irrelevant dissimilarities inherent to different media.

INTRODUCTION

To prevail in a copyright infringement action, a plaintiff must prove that the defendant’s work is “substantially similar” to the plaintiff’s work. When evaluating literary works, for example, assessing substantial similarity requires a comparison of the “articulable similarities between the plot, themes, dialogue, mood,

setting, pace, characters, and sequence of events in the two works.”¹ However, this comparison becomes problematic when a defendant infringes a work by translating it into a different medium.² The Copyright Act’s derivative work right unquestionably protects an author’s right to translate a work into a different medium.³ But, comparing works in different media raises several issues. For example, how does one compare the pacing of a book to the pacing of a film?⁴ The differences between the two works may be attributable to the difference in medium rather than a lack of substantial similarity.⁵ Most courts and commentators have recognized that differences dictated by a choice of medium are not relevant to an analysis of substantial similarity.⁶ Yet, they have not explained how to apply the existing test when analyzing works in different media.

In this Article, I argue that the correct manner of analyzing the substantial similarity of works in different media is to translate the plaintiff’s work into the same medium as the allegedly infringing work. After all, the derivative work right encompasses the right to create that transformation. Consequently, that transformation should serve as the relevant benchmark. Thus, courts should be guided by what a “faithful adaptation” of the plaintiff’s work would look like in the infringing work’s medium. The faithful adaptation can then be

¹ Funky Films, Inc. v. Time Warner Entm’t Co., 462 F.3d 1072, 1077 (9th Cir. 2006) (citation omitted) (internal quotation marks omitted); *accord* Boisson v. Banian, Ltd., 273 F.3d 262, 273 (2d Cir. 2001) (“[W]hen evaluating claims of infringement involving literary works, we have noted that . . . our examination would encompass ‘the similarities in such aspects as the total concept and feel, theme, characters, plot, sequence, pace, and setting of the plaintiff’s books and the defendants’ works.’” (alteration marks omitted)).

² See generally Pamela Samuelson, *The Quest for a Sound Conception of Copyright’s Derivative Work Right*, 101 GEO. L.J. 1505, 1520 (2013) (“Dramatizations and motion-picture versions transform expressive elements of the plot, structure, characters, narrative thread, and the like of the underlying work to a different medium. Often, numerous changes are necessitated by the change in medium.”).

³ Paul Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 J. COPYRIGHT SOC’Y U.S.A. 209, 210 (1983).

⁴ *Idema v. Dreamworks, Inc.*, 162 F. Supp. 2d 1129, 1185 (C.D. Cal. 2001) (noting the difficulty of “compar[ing] ‘mood and pace’ between works which are captured in different media (written word versus film)”, *aff’d*, 90 F. App’x 496 (9th Cir. 2003)).

⁵ Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 VAND. L. REV. 1, 46–47 (1985) (“Application of the ‘substantial similarity’ test . . . is extremely problematic, particularly in the context of adaptations. . . . The use of this test with respect to derivative and preexisting works requires caution . . . because the technical requirements of a different medium usually necessitate certain changes, which could lull an ordinary observer into believing that no substantial similarity exists.”).

⁶ See, e.g., *Rogers v. Koons*, 751 F. Supp. 474, 477–78 (S.D.N.Y. 1990).

compared to the allegedly infringing work using the traditional substantial similarity analysis for the second medium. The faithful adaptation standard will therefore allow courts to correctly filter out differences solely attributable to choice of medium and apply the accepted test for substantial similarity within the second medium. Although cases involving films that allegedly infringe books may provide the most typical example, the standard would apply in any infringement action involving an infringing work in a different medium than the plaintiff's original work.

In order to ensure that plaintiffs are not permitted to use the standard to expand the derivative work right beyond its intended scope, however, the theoretical research suggests that infringement claims involving works in different media must be limited to those implicating derivative markets that the plaintiff could have reasonably contemplated exploiting at some point during the creative process.⁷ This limitation provides sufficient protection for authors' rights to exploit derivative markets to the extent that those markets would have provided some incentive for creating the work in the first instance.⁸

The faithful adaptation test thus proceeds in two steps. First, it asks whether there was a foreseeable market for the adaptation of the work in the new medium. To the extent that there is no foreseeable market, then no faithful adaptation exists. Second, it asks whether there is substantial similarity between the two works after translating the plaintiff's work into the second medium using that medium's equivalent means of expression. Substantial similarity is evaluated with reference to the second medium's expressive elements. In applying both aspects of the faithful adaptation test, courts may find expert analysis particularly instructive.⁹

Accordingly, the faithful adaptation standard would allow plaintiffs to recover in infringement actions only to the extent that the plaintiffs would have if they actually had decided to exploit their rights to prepare derivative works in new media.¹⁰ Thus, authors' incentives to create works that can be exploited in new media will be preserved

⁷ Cf. Samuelson, *supra* note 2, at 1522–23; Shyamkrishna Balganesh, *Foreseeability and Copyright Incentives*, 122 HARV. L. REV. 1569, 1574–75 (2009); Michael Abramowicz, *A Theory of Copyright's Derivative Right and Related Doctrines*, 90 MINN. L. REV. 317, 373 (2005); Stewart E. Sterk, *Rhetoric and Reality in Copyright Law*, 94 MICH. L. REV. 1197, 1215–16 (1996).

⁸ Cf. Samuelson, *supra* note 2, at 1527–28; Goldstein, *supra* note 3, at 221.

⁹ See, e.g., *Swirsky v. Carey*, 376 F.3d 841, 845, 847–48 (9th Cir. 2004).

¹⁰ See *infra* Part III.

without unnecessarily limiting opportunities for other authors to build upon past works in new markets in a way that is consistent with the primary rationale for protecting the right to produce derivative works.¹¹

This Article is divided into three parts. Part I discusses the relevant background, including basic copyright principles, the derivative work right, and substantial similarity. Part II explains the nature of the problem, highlighting the difficulties of applying the current substantial similarity framework to infringement claims where the works are in different media. Part III then explains how the faithful adaptation standard resolves the problem without expanding plaintiff's rights.

I BACKGROUND

A. Copyright Principles

The U.S. Constitution gives Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”¹² Following this directive, the Second Circuit has described the purpose of the Copyright Act as “promot[ing] the advancement of knowledge and learning by giving authors economic incentives (in the form of exclusive rights to their creations) to labor on creative, knowledge-enriching works.”¹³ Some commentators have also suggested that copyright protection is justifiable because authors “deserve” compensation for their creative works.¹⁴ Thus, copyright

¹¹ See *infra* Part III.B and notes 84, 239–40.

¹² U.S. CONST. art. 1, § 8, cl. 8.

¹³ *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 65 (2d Cir. 1994). Although Congress's stated purpose of providing copyright protection is to incentivize creativity, Joel Waldfoegel's research on the music industry found scant evidence of such an effect. Joel Waldfoegel, *Bye, Bye, Miss American Pie? The Supply of New Recorded Music Since Napster 7* (Nat'l Bureau of Econ. Research, Working Paper No. 16882, 2011) (“While it is customary to assume that IP protection provides . . . an incentive [for creativity], there is actually very little evidence about its effect on music supply.”).

¹⁴ *E.g.*, Sterk, *supra* note 7, at 1227 (“[C]ourts, Congress, and scholars have invoked the notion that authors ‘deserve’ the public benefit their creations generate, even if those authors would have created the same works without any promise of copyright monopoly. Indeed, a number of long-standing copyright doctrines are far more consistent with a desert theory of copyright than with any incentive rationale.”).

holders are granted a statutory monopoly to exploit their works.¹⁵ Subject to certain defenses and other limitations, the Copyright Act gives the copyright owner “the exclusive rights to reproduce, to distribute, and to display the copyrighted work, as well as to prepare derivative works based on the copyrighted work.”¹⁶

One of the central problems of copyright law is balancing the interests of copyright holders and the interests of those who would build upon their work.¹⁷ As one court put it: “Intellectual property rights aren’t free: They’re imposed at the expense of future creators and of the public at large.”¹⁸ Accordingly, too much protection reduces the number of copies of a work available to the public and constrains the rights of other authors to build upon those works while providing only a limited marginal increase in the incentives to create new works.¹⁹ “To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.”²⁰ Copyright protection is “limited to those aspects of the work—termed ‘expression’—that display the stamp of the author’s originality.”²¹ The key distinction between copyright and patent protection is that copyright protection does not protect ideas.²² Indeed, unlike patents, copyrights are not

¹⁵ See *id.* at 1204–05.

¹⁶ *Montz v. Pilgrim Films & Television, Inc.*, 649 F.3d 975, 982 (9th Cir. 2011) (O’Scannlain, J., dissenting) (citing 17 U.S.C. § 106 (2012)).

¹⁷ *Satava v. Lowry*, 323 F.3d 805, 813 (9th Cir. 2003) (“Only by vigorously policing the line between idea and expression can we ensure both that artists receive due reward for their original creations and that proper latitude is granted other artists to make use of ideas that properly belong to us all.”); Thomas M.S. Hemnes, *The Adaptation of Copyright Law to Video Games*, 131 U. PA. L. REV. 171, 207 (1982) (“[T]he central problem of copyright law is to reconcile and balance interests in, on the one hand, rewarding individuals for their ‘unique creative efforts,’ and, on the other hand, making authors’ ‘ideas freely accessible to the public so that they may be used for the intellectual advancement of mankind,’ thus promoting ‘the Progress of Science and useful Arts.’” (citations omitted)).

¹⁸ *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1245 (9th Cir. 2013).

¹⁹ *Sterk*, *supra* note 7, at 1207 (“Although each additional increment in copyright protection increases the return to authors and hence induces potential authors to give up other enterprises, the number of creative works produced will not be directly proportional to the level of copyright protection. We would expect each additional increment of protection to induce fewer additional authors to engage in creative work. That is, once returns to creative activity have become high relative to returns in other pursuits, more of the people who could be induced to engage in creative activity already would have done so.”).

²⁰ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 349–50 (1991).

²¹ *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547 (1985).

²² See *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1443 (9th Cir. 1994) (indicating that copyright law does not provide “patent-like” protection for ideas).

subject to a rigorous examination of novelty before protection is granted.²³ The Copyright Act accordingly provides that copyright protection does not “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.”²⁴ Although the distinction between ideas and expression is easily stated, it can be difficult to draw in practice.²⁵

Copyright protection is also subject to other significant limitations.²⁶ Protectable works must display originality, which requires independent creation and “a modicum of creativity.”²⁷ Additionally, certain forms of expression are not protectable.²⁸ These include “[f]amiliar stock scenes and themes that are staples of literature” as well as “[s]cenes-a-faire, or situations and incidents that flow necessarily or naturally from a basic plot premise.”²⁹ Similarly, under the “merger” doctrine, “[w]hen the ‘idea’ and its ‘expression’ are . . . inseparable, copying the ‘expression’ will not be barred, since protecting the ‘expression’ in such circumstances would confer a monopoly of the ‘idea’ upon the copyright owner free of the conditions and limitations imposed by the patent law.”³⁰ The fair use defense also provides an important counterweight “to the copyright law’s goal of protecting creators’ work product.”³¹ The defense is

²³ Pamela Samuelson, *Why Copyright Law Excludes Systems and Processes from the Scope of Its Protection*, 85 TEX. L. REV. 1921, 1932 (2007).

²⁴ 17 U.S.C. § 102(b) (2012).

²⁵ Hemnes, *supra* note 17, at 211 (“For graphic works such as paintings and sculptures the [idea versus expression] distinction is especially inept; it is perhaps in recognition of this that Congress reversed the Act’s logic for ‘pictorial, graphic, and sculptural works,’ granting their expression protection only if ‘capable of existing independently of’ the ‘utilitarian’ aspects of the work. Justice Kaplan has argued persuasively that the identification of ‘ideas’ in musical works, particularly modern works lacking in melody, is equally futile.” (citing 17 U.S.C. § 101 (1976 & Supp. V 1981); BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 53 (1967))).

²⁶ Sterk, *supra* note 7, at 1210 (discussing several “long-standing doctrinal limitations on copyright protection [that] reflect a concern with the monopoly power that overbroad copyright doctrine generates”).

²⁷ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991).

²⁸ *Cavalier v. Random House, Inc.*, 297 F.3d 815, 823 (9th Cir. 2002).

²⁹ *Id.*

³⁰ *CDN Inc. v. Kapes*, 197 F.3d 1256, 1261 (9th Cir. 1999).

³¹ *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1163 (9th Cir. 2007); *see also* *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 804–05 (9th Cir. 2003) (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575–77 (1994)) (“Recognizing that science and art generally rely on works that came before them and rarely spring forth in a

primarily intended to protect the use of works “for purposes such as criticism, comment, news reporting, teaching[,] . . . scholarship, or research.”³²

Professor Shyamkrishna Balganesh has argued that an additional limitation is inherent in copyright’s incentive structure: foreseeability.³³ Professor Balganesh contends that courts should “employ a test of foreseeability to determine the point up to which a copyright owner should be allowed to internalize the gains from his work.”³⁴ Thus, the question “to ask [is] whether the use complained of is one that the copyright owner (that is, the plaintiff) could have reasonably foreseen at the time that the work was created (that is, the point when the entitlement commences).”³⁵ As explained below, these considerations are particularly significant when evaluating the extent to which the derivative work right protects an author’s right to exploit new markets resulting from new technologies.³⁶

B. Derivative Works

One of the more controversial rights that the Copyright Act grants to copyright owners is the exclusive right “to prepare derivative works based upon the copyrighted work.”³⁷ Congress has defined derivative works as those “based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted.”³⁸ Professor Pamela Samuelson has suggested that these statutory examples can be clustered into three main categories: shorter versions, faithful renditions, and transformations of expression from one medium or genre to another.³⁹ Works “consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole,

vacuum, the Act limits the rights of a copyright owner regarding works that build upon, reinterpret, and reconceive existing works.”).

³² 17 U.S.C. § 107 (2012).

³³ Balganesh, *supra* note 7, at 1572–75.

³⁴ *Id.* at 1574.

³⁵ *Id.* at 1575.

³⁶ *See id.* at 1572.

³⁷ 17 U.S.C. § 106(2); *see also* Gracen v. Bradford Exch., 698 F.2d 300, 303 (7th Cir. 1983) (noting that a person who has no authority to make a derivative work could not copyright such a work).

³⁸ 17 U.S.C. § 101.

³⁹ Samuelson, *supra* note 2, at 1518–20.

represent an original work of authorship” are also considered “derivative works.”⁴⁰ Thus, “[t]he derivative work right redresses misappropriation of indirect or potential markets for the work, as well as the usurpation of primary or direct markets, by prohibiting the unauthorized use of expressive elements in subsequent works, regardless of whether such use involves any ‘copying’ in the ordinary sense of the term.”⁴¹

1. Evolution of the Derivative Work Right

The derivative work right is a relatively recent development. At common law, copyright protection was essentially limited to verbatim copying with courts finding that even translations and abridgements did not infringe copyrights.⁴² The Copyright Act of 1790 similarly provided no protection for derivative works.⁴³ In the 1800s, courts initially remained resistant to protection for anything resembling derivative works.⁴⁴ The courts sometimes noted that infringement of an adaptation in a new medium was unlikely to have any impact on the market for the original work.⁴⁵ According to Professor Paul Goldstein, this understanding reflected the existing “technology of the printing press and . . . the assumption that the law’s proper concern was with literal copies rendered in the same medium.”⁴⁶ As technology evolved and the variety of mediums expanded, however,

⁴⁰ 17 U.S.C. § 101.

⁴¹ Lateef Mtima, *So Dark the Con(tu) of Man: The Quest for a Software Derivative Work Right in Section 117*, 70 U. PITT. L. REV. 1, 57 (2008).

⁴² Hemnes, *supra* note 17, at 208.

⁴³ Christina Bohannon, *Reclaiming Copyright*, 23 CARDOZO ARTS & ENT. L.J. 567, 581 (2006) (“Early American copyright statutes provided copyright owners with very rudimentary rights. The first Copyright Act (of 1790) ensured protection of any ‘map, chart or book’ for an initial term of 14 years plus a renewal term of 14 years. Moreover, the scope of the copyright given to an author was limited to the right to copy the work itself and did not include the right to make ‘derivative works’ (such as translations of a novel into another language, for example).”).

⁴⁴ Kindra Deneau, *The Historical Development and Misplaced Justification for the Derivative Work Right*, 19 B.U. J. SCI. & TECH. L. 68, 77 (2013) (“At the start of the nineteenth century, courts typically found no infringement in what leading French commentary called ‘the transmutation of form that the translator causes the original to undergo.’” (alteration marks omitted)).

⁴⁵ *Id.* at 86.

⁴⁶ Goldstein, *supra* note 3, at 210–11.

resistance to the protection of non-verbatim transformations began to erode.⁴⁷

By 1870, Congress was ready to recognize protection for derivative works.⁴⁸ In the 1870 Copyright Act, Congress expanded copyright protection to translations and dramatizations.⁴⁹ Derivative rights were expanded again in the 1909 Act, which recognized an author's ability to transform a work into a new medium.⁵⁰ Authors were provided with certain specific rights, including the exclusive right to transform their works into novels, nondramatic works, and musical arrangements and adaptations.⁵¹ One commentator suggests that Congress did not intend to provide greater protection to works in different media; it only intended to extend the test for copying to "the conversion of works across different commercial media."⁵² In any event, the courts began to recognize nonliteral copying as actionable.⁵³

In 1961, anticipating revisions to the copyright laws, the Register of Copyrights noted that the right to make translations, dramatizations, and to execute models or designs had been a part of the Copyright Act since 1870. As a result, the Register recommended that "the right to make new versions should be retained as a separate right in the new Copyright Act to 'avoid any doubt' about the extent of an authors' copyright protection."⁵⁴ In response, bill drafts from Congress referenced a "right of 'making new versions' of a copyright-protected work."⁵⁵

⁴⁷ See Hemnes, *supra* note 17, at 208 ("Nineteenth century decisions in England and in the United States preserved the rules that permitted translations and abridgements. However, the dike separating actionable verbatim copying from all other forms of taking suffered a steady erosion under the influence of expansive copyright legislation, judicial elaboration of the concept of 'substantial' taking, and scholarly criticism of the early limitations on copyright protection.").

⁴⁸ Goldstein, *supra* note 3, at 214.

⁴⁹ Deneau, *supra* note 44, at 70.

⁵⁰ *Id.* at 80.

⁵¹ *Id.*

⁵² *Id.* at 82–83.

⁵³ Goldstein, *supra* note 3, at 215 ("Most of the early [derivative rights] cases . . . recognized that, for the original work to be given the appropriate level of protection, literal changes could not be allowed to avoid infringement. *Dam v. Kirk La Shelle Co.*, 175 F. 902 (2d Cir. 1910),] is typical, the court there holding that defendant's play, 'The Heir to Hoorah,' infringed plaintiff's right to dramatize his story, 'The Transmogrification of Dan,' even though the play borrowed only the story's central incident and contributed events, characters and dialogue of its own.").

⁵⁴ Deneau, *supra* note 44, at 87.

⁵⁵ *Id.*

Instead, however, Congress enacted the current statute, representing the culmination of a growing “commitment to derivative rights.”⁵⁶ The resulting 1976 Act expanded the derivative right beyond the strict dictates of the 1909 Act.⁵⁷ Professor Goldstein has argued that this expansion of derivative rights reflects the “growth of new copyright industries” and the need to detach copyright law from the technological confines of the printing press.⁵⁸ Others have made the less welcoming observation that it also represents an expansion of the rights of copyright owners and their monopoly power.⁵⁹

2. *Understanding the Derivative Work Right*

The derivative work right is widely understood as extending protection to the transformation of a work into a different medium.⁶⁰ In what may be the most common example of the derivative right in action, an author of a book has the exclusive right to transform the work into a film.⁶¹ The right, however, can stretch far beyond that

⁵⁶ Goldstein, *supra* note 3, at 210.

⁵⁷ Michael Wurzer, Note, *Infringement of the Exclusive Right to Prepare Derivative Works: Reducing Uncertainty*, 73 MINN. L. REV. 1521, 1525 (1989) (noting that the 1976 Act extended the right to prepare derivative works from authors of literary works to authors of all works).

⁵⁸ Goldstein, *supra* note 3, at 209 (noting, for example, that “[h]ardcover book sales, which once represented the principal measure of a novel’s popular success, are today dwarfed by the income from motion pictures, television series, sequels and merchandise derived from the novel.”).

⁵⁹ Bohannon, *supra* note 43, at 586 (suggesting that protection for derivative works is a “product of special-interest influence” that is “difficult to justify on economic grounds”). Professor Christina Bohannon has also characterized the derivative work right as “a right to prevent others from producing new works that build or improve upon the copyright owner’s work.” *Id.* at 588.

⁶⁰ Goldstein, *supra* note 3, at 209 (“Copyright, which once protected only against the production of substantially similar copies in the same medium as the copyrighted work, today protects against uses and media that often lie far afield from the original.”); *see also* Bohannon, *supra* note 43, at 588 (criticizing the statutory framework of the derivative work right, but conceding that the reasons for protecting reproductions against copying “might justify a narrow derivative works right, or a right that protects against substantially copying the original work in a new form or medium”).

⁶¹ Abramowicz, *supra* note 7, at 326 (“The [derivative work] definition thus leaves little doubt that a movie version of a book would be covered, and it is uncontroversial that a sequel to a book or movie similarly would count as a transformation or an adaptation.”); David E. Shipley & Jeffrey S. Hay, *Protecting Research: Copyright, Common-Law Alternatives, and Federal Preemption*, 63 N.C. L. REV. 125, 130–31 (1984) (“The author also has authority over the preparation of works derived from his protected work, such as the adaptation of a book or movie. This right is similar to the reproduction right, and it allows an author to control how his work is recast and transformed in a different medium.

typical example to the point where the resulting work bears little resemblance to the original.⁶² A derivative work, however, need not be in a different medium to warrant protection.⁶³ For example, a colorized version of a classic black-and-white film would qualify as a derivative work.⁶⁴ However, the derivative work must still have elements of originality distinct from the original work to warrant independent protection.⁶⁵

As many commentators have observed, there is a substantial degree of overlap between the reproduction right and the derivative right.⁶⁶ Some have argued that this creates a state of confusion, susceptible to

Thus, a movie studio that adapted a book to a movie without authorization could be liable for violating the right to prepare derivative works, as well as the right of reproduction and the right to control performances.”).

⁶² Shipley & Hay, *supra* note 61, at 131 n.51 (“Determining whether an adaptation infringes another’s copyright is not easy unless it is a very close reproduction. The transformations often may be so great that it is difficult to see any connection between the works.”); Goldstein, *supra* note 3, at 217 (“The continuum may stretch from an underlying novel or story to the work’s adaptation into a motion picture, its transformation into a television series, and the eventual embodiment of its characters in dolls, games and other merchandise. The works at the outer reaches of this continuum, and some intermediate works as well, will frequently bear scant resemblance to the expression *or* the ideas of the seminal work and will often be connected only by a license authorizing use of a title or character name.”).

⁶³ See, e.g., *infra* note 64.

⁶⁴ Abramowicz, *supra* note 7, at 375 (“Colorized versions of movies generally are considered to be derivative works . . .”).

⁶⁵ Shipley & Hay, *supra* note 61, at 130 n.44 (“Only those elements that are original to the derivative work—materials contributed by the work’s author—are entitled to protection.”); Abramowicz, *supra* note 7, at 377 (“The modifications to a work must themselves be original, for a nonoriginal modification can never create something original. But that is not enough. The word ‘represent’ recognizes that modifications are not of interest in and of themselves, but only in that they point to or symbolize something broader. To consider whether modifications make a derivative work, we cannot just look at the modifications themselves, but must look at whether the modifications represent an original work.”).

⁶⁶ Shipley & Hay, *supra* note 61, at 130 n.45 (indicating that the derivative right “arguably is superfluous because an adaptation ‘reproduces’ the underlying work.”); Abramowicz, *supra* note 7, at 326 (noting that it may be unclear how the derivative right can “be distinguished from the reproduction right in cases in which the creation of an adaptation also involves the copying of some expression from the original work”); Goldstein, *supra* note 3, at 215 (“The English and American history reflects both a growing commitment to derivative rights and a clear sense that the proper measure for their infringement will often necessarily differ from the measure employed in cases involving the narrower reproduction right. Yet virtually none of the decisions has drawn a principled line capable of separating derivative rights from reproduction rights . . .”).

abuse.⁶⁷ Scholars have offered a number of distinctions between the two rights to help resolve this problem.⁶⁸ Professor Goldstein has suggested that the derivative right applies at “that point at which the contribution of independent expression to an existing work effectively creates a new work for a different market.”⁶⁹ He thus suggests that “the proper question to ask in determining whether an exclusive right should be given to prepare [such] works is whether the grant of such a right is needed to attract the appropriate amount of investment to the underlying work’s expression, and to channel this investment in appropriate directions.”⁷⁰ Professor Samuelson has suggested that the derivative right applies where: (1) the author has contributed “some original expression” to the work; (2) the second work’s expression is “intermingled with [the] expression from the underlying work” such that the expression has been transformed or is otherwise “distinguishable from the underlying work”; and (3) the second work will supplant demand for authorized derivatives, although not necessarily the underlying work itself.⁷¹ Additionally, Professor Michael Abramowicz has suggested that a derivative work “would be expected to cause significant demand diversion from actual or hypothetical transformations that the original author plausibly might make,” as opposed to a work that would cause demand diversion from the original, which would infringe the reproduction right.⁷² He has further noted that the significance of the derivative right lies later in the copyright term, when interest for the original work wanes but may still exist for derivatives such as sequels and adaptations.⁷³ Thus, the existence of a distinct market for the second work, which bears some degree of originality but also borrows some expression from the first work, appears to be the touchstone of the derivative work right.⁷⁴

⁶⁷ Deneau, *supra* note 44, at 97 (arguing that the derivative work right should be eliminated so as to “prevent future encroachments on ideas and confusion in the application of copyright law” since the derivative work right is “superfluous”).

⁶⁸ See *infra* notes 69–73.

⁶⁹ Goldstein, *supra* note 3, at 217.

⁷⁰ *Id.* at 230.

⁷¹ Samuelson, *supra* note 2, at 1522–23.

⁷² Abramowicz, *supra* note 7, at 373.

⁷³ *Id.* at 322.

⁷⁴ See *Midway Mfg. Co. v. Artic Int’l, Inc.*, 704 F.2d 1009, 1014 (7th Cir. 1983) (determining that a sped-up version of a video game constituted a derivative work because the right to market it was valuable, unlike the right to market, for example, a sped-up record); Goldstein, *supra* note 3, at 217 (“[M]otion pictures, translations and comic strips based on the novel will all infringe the derivative right because they add new expressive

Confusion over the scope of the derivative right is not limited to the overlap with the reproduction right. Some have suggested that there is tension with the fair use defense.⁷⁵ As noted above, the fair use defense is intended to shield certain types of uses (e.g., criticism, news reporting, education, research⁷⁶) of existing works from liability. However, it also moderates the Act's property rights by allowing others to reference otherwise-protected works.⁷⁷ Accordingly, "a secondary work may constitute a fair use even if it serves some purpose" other than those listed in the statute, namely where it is used in the creation of something that conveys a fundamentally different perspective in the form of new aesthetics, expression, meaning, or message.⁷⁸ Analysis of the defense proceeds by considering the four statutory factors: (a) the purpose and character of the use, (b) the nature of the works, (c) the amount and substantiality of the taking, and (d) the market impact of the use.⁷⁹ The "purpose and character" factor focuses on the "transformative" nature of the second work.⁸⁰ The distinction between the sphere protected by the derivative right and that insulated against infringement claims by the fair use defense appears to lie with the intention behind the transformation. A derivative work transforms the original work in such a way as to take advantage of a distinct but logical extension of the original market, while a "fair use" of a work either transforms the work for a protected purpose, such as criticism, or otherwise changes the underlying message.⁸¹ Similarly, the

elements and serve markets that differ from the market in which the original was first introduced.").

⁷⁵ Bohannon, *supra* note 43, at 594 (arguing that "there is tension" between the derivative work right and the fair use defense); Hemnes, *supra* note 17, at 187–88 ("Both tradition and the Copyright Act hold that off-shoots such as commentary, criticism, and parody are not infringing, despite the fact that such works are fundamentally parasitic on the work of the original author. The commentary must not paraphrase or quote so extensively that it becomes a substitute for the original . . .").

⁷⁶ 17 U.S.C. § 107 (2012).

⁷⁷ *Cariou v. Prince*, 714 F.3d 694, 705 (2d Cir. 2013) ("Because excessively broad protection would stifle, rather than advance, the law's objective, fair use doctrine mediates between the property rights copyright law establishes in creative works, which must be protected up to a point, and the ability of authors, artists, and the rest of us to express them—or ourselves by reference to the works of others, which must be protected up to a point." (citation omitted) (alteration and internal quotation marks omitted)).

⁷⁸ *Id.* at 706, 708.

⁷⁹ 17 U.S.C. § 107.

⁸⁰ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

⁸¹ The central inquiry of the "purpose and character of the use" aspect of the fair use test is whether the new work is intended merely to "supersede the objects of the original

derivative right—which allows an author to take advantage of new markets built upon goodwill accrued for past works—may have significant overlap with aspects of unfair competition and trademark law, which are focused on protecting brand identity and preventing consumer confusion.⁸²

Commentators have offered a number of rationales for extending copyright protection to derivative works.⁸³ First, the derivative right may provide a valuable incentive for the creation of works, like copyright protection in general, as authors may create works with the expectation that they will be able to take advantage of derivative markets.⁸⁴ Indeed, in some cases, the introduction of a derivative work into the market may actually increase demand for the original

creation” or is “transformative” in that it “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.” *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1164 (9th Cir. 2007) (citing *Campbell*, 510 U.S. at 579). In *Castle Rock Entertainment, Inc. v. Carol Publishing Group, Inc.*, 150 F.3d 132, 143 (2d Cir. 1998), the court found that the second work infringed the derivative work right but was not sufficiently transformative to merit fair use protection, noting that:

Although derivative works that are subject to the author’s copyright transform an original work into a new mode of presentation, such works—unlike works of fair use—take expression for purposes that are not “transformative.” In the instant case, since [the infringing work] has transformed [the original work’s] expression into trivia quiz book form with little, if any, transformative purpose, the first fair use factor weighs against defendants.

Id. Professor Bohannon has suggested that this means that, when evaluating whether a work is transformative for purposes of the fair use test, a court “would be precluded from taking into account only those changes which were incidental to converting the original work into another form or medium.” Bohannon, *supra* note 43, at 603.

⁸² Goldstein, *supra* note 3, at 220 (suggesting that some elements taken from one work when adapted to a different medium “though not protected by copyright, may be protected under unfair competition or trademark law”); *see also* Hemnes, *supra* note 17, at 221 (“Trademark law and section 43(a) of the Lanham Act share the broad purposes of protecting a first user’s exclusive right to profit from the goodwill he has generated and of protecting the public against ‘false designations of origin.’ Thus, trademark law recognizes a right in the first user of a mark to make all of the profit derived from the goodwill associated with a mark and to prevent unfair or deceptive use of the same or confusingly similar marks by other persons. By contrast, protection for the economic interests of the copyright owner is more limited. The owner’s profits are not an end in themselves, but only a means to the constitutional goal of encouraging the development of ‘science and the useful arts.’”).

⁸³ *See infra* notes 84–89.

⁸⁴ Samuelson, *supra* note 2, at 1527; Sterk, *supra* note 7, at 1215–16; *see also* Goldstein, *supra* note 3, at 230 (“[T]he proper question to ask in determining whether an exclusive right should be given to prepare these latter works is whether the grant of such a right is needed to attract the appropriate amount of investment to the underlying work’s expression, and to channel this investment in appropriate directions.”).

work.⁸⁵ Second, the derivative right provides authors with the power to determine what markets to exploit, rather than forcing their hand to hastily prepare derivative works to compete in a crowded market flooded with derivatives created by others.⁸⁶ Third, authors “deserve” some degree of compensation for the right to exploit their own works, both to preclude unjust enrichment of third parties who would otherwise exploit the foreseeable markets and to preserve the integrity of an inherent aspect of the authors’ own creative identity.⁸⁷ Fourth, the derivative right reduces transaction costs by giving one copyright owner power over reproduction and derivative rights.⁸⁸ Fifth, as an administrative matter, it may be too difficult to distinguish between protecting an original work and a derivative work.⁸⁹

3. Criticism

Some academics and practitioners have fiercely criticized the derivative work right. Professors Stewart Sterk and Christina Bohannon have argued that the incentive justification is ill-founded and contend that derivative rights only provide significant creative incentives in the rare circumstances where the projected returns from the work itself are low, but projected returns from derivative works are high enough to justify the author’s effort to create the work.⁹⁰

⁸⁵ Abramowicz, *supra* note 7, at 328 (noting that “adaptation might increase sales of the original, perhaps explaining the lamentable practice of placing movie stills on the covers of books that have been adapted”); *see also* Samuelson, *supra* note 2, at 1520 (“In some cases, motion-picture versions of a book may create positive demand for the original version.”); Hennes, *supra* note 17, at 185–87 (noting that a court found infringement despite the fact that the infringing work did not act as a substitute for the original, and if anything, would have enhanced sales of the original).

⁸⁶ Samuelson, *supra* note 2, at 1528; Sterk, *supra* note 7, at 1216–17 (citing William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325, 354–55 (1989)); Abramowicz, *supra* note 7, at 320 (“The derivative right thus can be defended as a tool that allows authors to take their time. Less obviously, but perhaps just as importantly, the derivative right may enhance social welfare, even placing aside the potentially destructiveness of copyright races.”), 324–25 (“The derivative right also eliminates copyright races to create adaptations, allowing the original author time to create a relatively high-quality work and to build audience anticipation.”).

⁸⁷ Sterk, *supra* note 7, at 1227, 1230; Samuelson, *supra* note 2, at 1528.

⁸⁸ Sterk, *supra* note 7, at 1216–17 (citing Landes & Posner, *supra* note 86, at 354–55).

⁸⁹ *Id.* at 1217 (“If derivative-works protection has any significant economic basis, that basis must rest on the administrative difficulty of distinguishing preparation of a derivative work from copying an original work.”).

⁹⁰ *Id.* at 1215–16 (“One argument for giving authors copyright in derivative works is that the prospect of profits from derivative works is necessary to create adequate incentives for production of the original. The argument is persuasive only in those situations when (1) the projected returns from the original work are too small to justify the

Professor Sterk has also argued that “[t]he notion that authors ‘deserve’ copyright protection . . . rests on shaky foundations,”⁹¹ rejecting suggestions that copyright protection can be justified based on notions of what authors deserve, whether predicated on principles of corrective justice, distributive justice, or personal identity.⁹²

Instead, Professor Sterk and others suggest that the Act’s broad copyright protections are a product of special interest influence.⁹³ The primary problem these commentators see with a broad derivative right is that it precludes other authors from building upon prior works and creating new works for the benefit of the public at large.⁹⁴ They contend that the derivative right should be eliminated or significantly scaled back.⁹⁵

Some scholars have also suggested narrower readings of the derivative right. Professor Bohannon has suggested that ambiguities in the Copyright Act should be construed against the special interests that helped create them.⁹⁶ Professor Samuelson has persuasively

costs of production, and (2) the projected returns from the derivative work are so large relative to the cost of producing the derivative work that the difference will more than make up the projected deficit on the original work alone.”); Bohannon, *supra* note 43, at 589 (“[B]ecause a derivative work involves an expenditure to adapt the original work into a new form, and there is a low *ex ante* probability that any particular work will be successful enough to justify producing the derivative work, authors are not likely to count on derivative works as a source of income sufficient to justify producing the original work.”).

⁹¹ Sterk, *supra* note 7, at 1239.

⁹² *Id.* at 1230–44.

⁹³ *Id.* at 1244 (“[M]uch in the history of twentieth-century copyright legislation suggests that those industries have used political muscle to expand protection at public expense.”); Bohannon, *supra* note 43, at 586 (suggesting that protection for derivative works is a “product of special-interest influence” that is “difficult to justify on economic grounds”).

⁹⁴ Bohannon, *supra* note 43, at 590 (“Because a broad derivative works right prevents second-comers from creating new works based on existing works while providing little incentive to create the original works, it seems likely that the costs of the right outweigh the benefits.”); *see also* Deneau, *supra* note 44, at 91 (“The derivative work right promotes the growth of such dangerous monopolies, because it can only separately protect against insubstantial copying of ideas, not expression.”).

⁹⁵ Deneau, *supra* note 44, at 97 (arguing that the derivative work right should be deleted so as to “prevent future encroachments on ideas and confusion in the application of copyright law” since the derivative work right is “superfluous”); Bohannon, *supra* note 43, at 588 (conceding that the reasons for protecting reproductions against copying “might justify a narrow derivative works right, or a right that protects against substantially copying the original work in a new form or medium”).

⁹⁶ Bohannon, *supra* note 43, at 569–70 (“Although the Copyright Act has its roots in the public interest, which it serves by encouraging the creation and dissemination of expressive works, the general trend in copyright law has been an expansion of the rights of

argued that the broad language in the statutory definition of “derivative work” should be read narrowly such that the broad, final clause in the statutory definition (“or any other form in which a work may be recast, transformed, or adapted”) “should be construed in light of the nine exemplary derivatives.”⁹⁷ This interpretation would limit the derivative work right to foreseeable and proximate markets for the three main statutory categories of derivative works (i.e., shorter versions, faithful renditions, and medium or genre transformations) and “close analogues.”⁹⁸ Still, others like Professor Goldstein appear to be more comfortable with a robust derivative work right, seeing it as a reflection of the growth of new industries and development of new media.⁹⁹ Regardless of how one views the derivative work right, however, it is firmly ingrained in the Copyright Act and is unlikely to disappear anytime soon.

C. Substantial Similarity

In order to prevail, “[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.’”¹⁰⁰ However, a defendant need not create an exact copy to infringe.¹⁰¹ To prove copying, the plaintiff must establish not only

copyright owners at the expense of public access and improvements to copyrighted works. This tension between private and public interests in copyright law often presents itself in copyright infringement cases as a statutory ambiguity between private- and public-interest provisions in the Copyright Act. This Article argues that, where possible, such statutory ambiguities in the interpretation of the Act should be resolved by a rule of interpretation that reclaims copyright for the public interest. Pursuant to this rule of interpretation, ambiguities between private- and public-interest provisions should be resolved by construing the private-interest provision narrowly and the public-interest provision broadly.”).

⁹⁷ Samuelson, *supra* note 2, at 1517–20.

⁹⁸ *Id.* at 1559 (“The derivative work right most clearly extends to works operating in foreseeable markets such as those implicated by the nine exemplary derivatives in the statutory definition and close analogues. The rationales for granting derivative work rights . . . also anticipate foreseeable markets. For example, incentives to create new works of authorship may be grounded for some creators upon expectations of rights to recoup research-and-development costs through control over readily foreseeable markets, such as the nine exemplary derivatives in the definition. But if first-generation creators do not foresee opportunities in remote markets, it is unclear that their incentives to create will be diminished if others perceive and then act on the imagined new market.”).

⁹⁹ See Goldstein, *supra* note 3, at 209–11.

¹⁰⁰ 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 (1991)).

¹⁰¹ Shipley & Hay, *supra* note 61, at 130 (“[C]opyright is infringed by the substantial appropriation of the author’s ‘particular expression through similarities of treatment,

that the defendant actually copied the work, but also that “the copying is illegal because a substantial similarity exists between the defendant’s work and the protect[a]ble elements of plaintiff’s work.”¹⁰² In cases where infringement is disputed, substantial similarity is often dispositive.¹⁰³ The issue most frequently arises in cases where the reproduction right is at issue,¹⁰⁴ and creates some unique problems in the context of the derivative right.¹⁰⁵

1. Test

The circuits are not in total agreement on the test for substantial similarity.¹⁰⁶ All courts appear to regard it as a question of fact and generally apply some variation of the “ordinary observer or audience test.”¹⁰⁷ These variations of the test seek to determine “whether the accused work is so similar to the plaintiff’s work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff’s protect[a]ble expression by taking material of substance and value.”¹⁰⁸ Generally, courts may first engage in some form of “filtering” to remove the unprotectable elements of the

details, scenes, events and characterization.’ Infringement may result from ‘imitation, paraphrasing, or colorable alteration’ as well as literal copying.” (internal quotation marks omitted)).

¹⁰² *Belair v. MGA Entm’t, Inc.*, 831 F. Supp. 2d 687, 691–92 (S.D.N.Y. 2011) (alteration marks omitted). Some language in Ninth Circuit opinions suggests that a plaintiff who can establish direct copying need not show substantial similarity. *E.g.*, *Funky Films*, 462 F.3d at 1076 (“*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.’” (emphasis added) (internal quotation marks omitted)). As Nimmer suggests, this is not very persuasive. 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.01[B] at 13-8 to 13-9 (2012) [hereinafter “NIMMER”] (arguing that the “copying” element requires an examination of both the factual question of whether the defendant used the plaintiff’s material and the legal question of whether the defendant’s work is “substantially similar to plaintiff’s work such that liability may attach”). The Ninth Circuit, however, has previously limited direct copying claims that do not require a showing of substantial similarity to those that involve “virtual duplication of a plaintiff’s entire work.” *Narell v. Freeman*, 872 F.2d 907, 910 (9th Cir. 1989). Consequently, the disagreement appears to be largely irrelevant in practice.

¹⁰³ *E.g.*, *Funky Films*, 462 F.3d at 1076–81.

¹⁰⁴ *See Hemnes, supra* note 17, at 194 (acknowledging “the accepted principle that a work can be ‘reproduced in copies’ in violation of the owner’s exclusive rights under section 106(1) of the Act if the infringer makes a ‘substantially similar’ copy.” (alteration marks and ellipsis omitted)).

¹⁰⁵ *See infra* Part I.C.4.

¹⁰⁶ *See NIMMER, supra* note 102, § 13.03[E][1] at 13-92 to 13-93.

¹⁰⁷ *Id.*

¹⁰⁸ *Hemnes, supra* note 17, at 196 (internal quotation marks omitted).

plaintiff's work before determining whether there is a genuine dispute of material fact appropriate for resolution by a jury.¹⁰⁹

Thus, in both the Second and Ninth Circuits, the court will first compare the two works, using filtering and expert analysis. Then, the court will address whether an ordinary observer would deem the works substantially similar, which is usually a question of fact reserved for the jury.¹¹⁰ In essence, these variations may be distilled as contemplating “a single inquiry: whether a reasonable jury could find the [works] substantially similar at the level of protected expression.”¹¹¹

The substantial similarity test may vary to some degree depending on the medium at issue.¹¹² Courts frequently analyze the constituent elements of the works.¹¹³ For example, for literary works, a court might focus on “articulable similarities between the plot, themes, dialogue, mood, setting, pace, characters, and sequence of events in

¹⁰⁹ See NIMMER, *supra* note 102, § 13.03[E][1][b] at 13-98 to 13-100; L.A. Printex Indus., Inc. v. Aeropostale, Inc., 676 F.3d 841, 849 (9th Cir. 2012) (“Because copyright law protects expression of ideas, not ideas themselves, [the court must] distinguish protect[a]ble from unprotect[a]ble elements and ask only whether the protect[a]ble elements in two works are substantially similar.”); Peter F. Gaito Architecture, LLC v. Simone Dev. Corp., 602 F.3d 57, 66 (2d Cir. 2010) (explaining that, in the Second Circuit, “when faced with works ‘that have both protect[a]ble and unprotect[a]ble elements,’ our analysis must be ‘more discerning,’ . . . and that we instead ‘must attempt to extract the unprotect[a]ble elements from our consideration and ask whether the protect[a]ble elements, standing alone, are substantially similar’” (citations omitted)); Funky Films, Inc. v. Time Warner Entm’t Co., 462 F.3d 1072, 1076 (9th Cir. 2006) (indicating that the courts “filter out” unprotectable elements when evaluating substantial similarity).

¹¹⁰ NIMMER, *supra* note 102, § 13.03[E][3][a][i] at 13-105 to 13-106 (discussing the test formulated by Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946)); L.A. Printex, 676 F.3d at 848 (discussing the Ninth Circuit’s two-part “extrinsic” and “intrinsic” test); Peter F. Gaito Architecture, 602 F.3d at 66 (discussing the Second Circuit test).

¹¹¹ Oravec v. Sunny Isles Luxury Ventures, L.C., 527 F.3d 1218, 1224 n.5 (11th Cir. 2008); see also NIMMER, *supra* note 102, § 13.03[E][3][c] at 13-118 to 13-119 (discussing Oravec with approval).

¹¹² See *infra* notes 114–15 and accompanying text.

¹¹³ See *infra* notes 114–15. This may also raise questions about what aspects of a work actually constitute expression. This may not always be the same thing as the aspects that make the work valuable. For example, for some art, the artist’s story itself is part of the value. See *What Do We Value Most?*, NPR: TED RADIO HOUR (Apr. 25, 2012 11:00 AM), <http://www.npr.org/templates/transcript/transcript.php?storyId=151357124>. For example, Marla Olmstead sold paintings for thousands of dollars at the age of three. *Id.* When questions were raised about whether her father was helping her create the paintings, they dropped dramatically in value. *Id.*; see also Rebecca Leung, *New Questions About Child Prodigy*, CBS NEWS (Feb. 22, 2005), www.cbsnews.com/2100-500164_162-675522.html. This may affect the elements of the work that should be evaluated, but may be more of an issue of unfair competition law as it raises fundamental questions about authenticity.

the two works.”¹¹⁴ For visual artwork, in contrast, the court might focus on “the subject matter, shapes, colors, materials, and arrangement of the representations.”¹¹⁵ Similarly, a comparison of photographs might focus on the subject, themes, setting, props, wardrobes, angles of view, framing, poses, shading, and lighting.¹¹⁶ How these elements are assessed may vary to some degree between the circuits. The Ninth Circuit has endorsed analytic dissection—i.e., the process of comparing the two works’ constituent elements.¹¹⁷ The Second Circuit, although invoking many of the constituent elements, remains somewhat resistant, insisting that the ultimate focus remains on the work’s “total concept and feel.”¹¹⁸

2. Degree of Similarity Required

Two works need not be identical in order to support a finding of substantial similarity. “[T]he relevant inquiry is whether a substantial portion of the protect[a]ble material in the *plaintiff’s* work was appropriated—not whether a substantial portion of *defendant’s* work was derived from plaintiff’s work.”¹¹⁹ In other words, “no plagiarist can excuse the wrong by showing how much of his work he did not pirate.”¹²⁰ “[A]ssuming that particular material is copyrightable, a determination of the qualitative importance of the material to the plaintiff’s work is more significant than a quantitative calculation of the portion allegedly appropriated by the defendant.”¹²¹ In contrast, “if . . . the similarity is only as to nonessential matters, then a finding of no substantial similarity should result.”¹²² By way of illustration,

¹¹⁴ *Funky Films*, 462 F.3d at 1077 (internal quotation marks omitted).

¹¹⁵ *Cavalier v. Random House, Inc.*, 297 F.3d 815, 826 (9th Cir. 2002).

¹¹⁶ See *L.A. News Serv. v. Tullo*, 973 F.2d 791, 794 (9th Cir. 1992); *LaChapelle v. Fenty*, 812 F. Supp. 2d 434, 445–47 (S.D.N.Y. 2011).

¹¹⁷ *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1398 & n.3 (9th Cir. 1998).

¹¹⁸ *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001) (noting that when employing the Second Circuit’s “more discerning” ordinary observer test, “a court is not to dissect the works at issue into separate components and compare only the copyrightable elements”).

¹¹⁹ *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 570 n.1 (9th Cir. 1987).

¹²⁰ *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936).

¹²¹ *Worth*, 827 F.2d at 570 n.1; see also *Shaw v. Lindheim*, 919 F.2d 1353, 1363 (9th Cir. 1990) (“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.” (citation omitted) (internal quotation marks omitted)).

¹²² NIMMER, *supra* note 102, § 13.03[A][2][a] at 13–55.

inexact or nonliteral similarity of twenty percent of one film was sufficient to constitute infringement where it constituted “an integral and essential part” of the story.¹²³ Although generally not sufficient to warrant a finding of substantial similarity, if distinctive enough, an exact copy of a phrase or sentence can also amount to a “substantial taking.”¹²⁴ In this respect, substantial similarity is related to the de minimis doctrine.¹²⁵

3. Use of Expert Analysis

Not all courts or commentators accept the use of expert analysis. Some fear that experts may mislead jurors, causing them to focus on irrelevancies.¹²⁶ Nonetheless, expert analysis appears to be generally accepted in cases involving media that untrained laypersons are less qualified to evaluate, such as musical works and computer programs.¹²⁷ Similarly, expert analysis may be useful in analyzing emerging media.¹²⁸

¹²³ *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F.2d 354, 360 (9th Cir. 1947).

¹²⁴ NIMMER, *supra* note 102, § 13.03[A][2][a] at 13-59 n.113 (citing as examples, “[w]hen there is no room in hell . . . the dead will walk the earth” from the film *Dawn of the Dead* and “I love you E.T.” from the film *E.T.*).

¹²⁵ Julie D. Cromer, *Harry Potter and the Three-Second Crime: Are We Vanishing the De Minimis Defense from Copyright Law?*, 36 N.M. L. REV. 261, 271 (2006).

¹²⁶ See, e.g., Steven G. McKnight, *Substantial Similarity Between Video Games: An Old Copyright Problem in a New Medium*, 36 VAND. L. REV. 1277, 1295 (1983) (arguing that experts “shed little light on the key issue in copyright infringement actions: whether the public believes the two works are substantially similar. Instead, expert witnesses could easily mislead juries by focusing their attention on minor differences or similarities between two works that have little bearing on the infringement issue.”).

¹²⁷ *Swirsky v. Carey*, 376 F.3d 841, 845, 848–49 (9th Cir. 2004) (indicating that, in a case involving musical works, assessing substantial similarity “require[d] analytical dissection of a work and expert testimony” and further observing that “[t]he application of the extrinsic test” to music is an unnatural task as music like software programs and art objects, is not capable of ready classification into only five or six constituent elements” (internal quotation marks omitted)); *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 713 (2d Cir. 1992) (discussing the use of expert testimony to assess the similarity of computer programs and acknowledging the difficulty lay observers may have with the subject matter); NIMMER, *supra* note 102, § 13.03[A][1] at 13-50 (indicating that “expert testimony is essential to any analysis of the similarities between computer programs”); Howard Root, Note, *Copyright Infringement of Computer Programs: A Modification of the Substantial Similarity Test*, 68 MINN. L. REV. 1264, 1286–87 (1984) (“Because computer programs possess a general aesthetic feel only from their functioning and output, however, expert testimony is needed to uncover any similarities between the actual programs.”).

¹²⁸ Hennes, *supra* note 17, at 217–18 (“It is submitted that in unusual contexts, such as video games, the admission of evidence, both expert and otherwise, about other works similar to the copyrighted and accused works, should become standard practice. Such evidence would provide valuable information about the standard devices (*scenes a faire*) found in games similar to the ones involved in the suit at hand. Such evidence would also

4. Difficulty of Analyzing the Substantial Similarity of Derivative Works

Evaluating substantial similarity presents unique problems where the plaintiff contends that the defendant has infringed the derivative work right. The test for infringement has developed independently of the derivative right's evolution into its present form, making it difficult to apply in the derivative context.¹²⁹ Accordingly, modifications to whichever variation of the test is applicable may be necessary when the infringement claim implicates the derivative right.¹³⁰ Additionally, expert analysis may be particularly useful in determining whether a derivative market exists for a given work.¹³¹

Notably, some commentators have suggested that the substantial similarity test should not apply when assessing an alleged infringement of the derivative work right.¹³² However, the weight of authority is to the contrary.¹³³ The substantial similarity test also

allow the courts to place their comparison of the copyrighted and allegedly infringing games into the context in which the games are actually created and played. The routine use of such evidence would guard against over-broad copyright protection, and at the same time facilitate a less metaphysical and more policy-oriented approach to infringement issues. Over time, as the courts' experience catches up with new medium, the need for such evidence can be expected to diminish.”)

¹²⁹ See Goldstein, *supra* note 3, at 219 (“The rules on copyright infringement were shaped in the years before derivative rights were added to the statute, when the only question for decision was whether defendant’s work constituted a copy of plaintiff’s.”).

¹³⁰ See Wurzer, *supra* note 57, at 1535–36.

¹³¹ See *Rogers v. Koons*, 751 F. Supp. 474, 480 (S.D.N.Y. 1990) (noting that the plaintiff had “shown through the affidavits of competent experts that photographers may earn additional income through the sale of ‘art rendering’ rights, namely, creating an art work based on the photograph in a medium other than photography”).

¹³² Chandra Gehri Spencer, Comment, *Beware of the Highwayman on the Information Superhighway: A Balanced Proposal to Protect Copyrights Within the National Information Infrastructure*, 24 PEPP. L. REV. 121, 170 (1996) (“The Working Group [on Intellectual Property Rights of the federal interagency Information Infrastructure Task Force] suggests that the substantial similarity test should not be applied to derivative works because ‘neither the meaning of derivative work nor the statutory standard for infringement appears to require an infringing derivative work to be substantially similar.’” (citation omitted) (internal quotation marks omitted)); Mtima, *supra* note 41, at 57 n.179 (suggesting that some authorities suggest that adaptation can violate the derivative right even in an absence of substantial similarity, explaining: “for example, where a novel is loosely adapted into a movie or its recognizable characters are used in another story without permission, the derivative work right is infringed despite the fact that there may be no reproduction of protected expression in the ordinary sense”).

¹³³ *Atkins v. Fischer*, 331 F.3d 988, 993–94 (D.C. Cir. 2003) (indicating that the “substantial similarity” requirement should be applied to determine if a work infringed the derivative right); Shipley & Hay, *supra* note 61, at 131 n.48.

applies when the two works at issue are in different media.¹³⁴ Indeed, the outcome of the substantial similarity test may effectively dictate whether a work is “based upon” another work for the purposes of implicating the derivative right.¹³⁵

Additionally, the fact that a defendant has copied the plaintiff’s work in a different medium will not preclude a finding of infringement based on substantial similarity.¹³⁶ Accordingly, for example, courts have held that photographs could infringe choreography,¹³⁷ a music video could infringe photographs,¹³⁸ a sculpture could infringe a photograph,¹³⁹ a quiz book could infringe a television show,¹⁴⁰ and a three-dimensional toy could infringe a two-dimensional cartoon character.¹⁴¹ Some courts that have acknowledged that a change in medium will not preclude a finding of infringement have specifically cited the codification of the derivative

¹³⁴ *Belair v. MGA Entm’t, Inc.*, 831 F. Supp. 2d 687, 693 (S.D.N.Y. 2011) (“It is well established that ‘substantial similarity may be found even where the protected work and the accused work exist in entirely different media.’” (quoting *LaChapelle v. Fenty*, 812 F. Supp. 2d 434, 442 (S.D.N.Y. 2011))).

¹³⁵ *Integral Sys., Inc. v. Peoplesoft, Inc.*, No. C-90-2598-DLJ, 1991 WL 498874, at *12 (N.D. Cal. 1991) (“The only basis for reaching a conclusion that a work is ‘based upon’ another is if there is substantial similarity between the two.”). *But cf.* *Kwall*, *supra* note 5, at 43 (noting that in contract disputes, some courts have used tests other than the substantial similarity test to determine whether a derivative work was “based upon” a preexisting work).

¹³⁶ *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 618–19 n.12 (7th Cir. 1982), *abrogated on other grounds by* *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985), *and* *Flava Works, Inc. v. Gunter*, 689 F.3d 754, 755 (7th Cir. 2012); *Walker v. Univ. Books, Inc.*, 602 F.2d 859, 864 (9th Cir. 1979); *Rogers*, 751 F. Supp. at 477 (“[Defendant’s] effort to limit that protection to [a] photograph ‘as a photograph’ runs counter to caselaw. In copyright law the medium is not the message, and a change in medium does not preclude infringement. That has long been the rule of this Court and the Second Circuit.”).

¹³⁷ *Horgan v. MacMillan, Inc.*, 789 F.2d 157, 158, 163 (2d Cir. 1986) (finding that the district court “erroneously held that still photographs cannot infringe choreography” in a case where the estate of a choreographer sought to enjoin the publication of a book portraying photographs of a production of *The Nutcracker*).

¹³⁸ *LaChapelle*, 812 F. Supp. 2d at 446 (finding that photographer David LaChapelle “successfully alleged” that Rihanna’s music video for the song “S & M” “embodie[d] substantial similarities to protect[a]ble elements in” LaChapelle’s photographs).

¹³⁹ *Rogers*, 751 F. Supp. at 477 (finding that the defendant’s “reproduction of the [plaintiff’s] photograph in sculpture form does not preclude a finding of copyright infringement”).

¹⁴⁰ *Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc.*, 150 F.3d 132, 138 (2d Cir. 1998) (finding the fact that a quiz book allegedly infringing the *Seinfeld* television series was “in question and answer form is by itself without particular consequence”).

¹⁴¹ *Rogers*, 751 F. Supp. at 477–78 (citing *King Features Syndicate v. Fleischer*, 299 F. 533, 535 (2d Cir. 1924)).

work right as support for the proposition.¹⁴² Of course, there may be many instances where a work in a different medium does not infringe the plaintiff's work.¹⁴³

II

THE PROBLEM: APPLYING THE SUBSTANTIAL SIMILARITY TEST TO WORKS IN DIFFERENT MEDIA

As discussed in the previous Part, it is apparent that a defendant may infringe a copyright owner's right to prepare derivatives by creating an infringing work in a different medium.¹⁴⁴ It is also clear that the substantial similarity test should be used to determine whether the defendant's work infringes the original work.¹⁴⁵ The substantial similarity test, however, becomes problematic when utilized to compare works in different media.¹⁴⁶ As illustrated below, this is because a change in medium necessarily dictates changes in expression in the works that may cause two works that are actually similar to appear different.¹⁴⁷

For example, in *Idema v. Dreamworks, Inc.*, the plaintiffs alleged that the defendants' film *The Peacemaker* infringed a story set out in eight written works that they had developed and owned.¹⁴⁸ On summary judgment, the court dutifully set out to compare the works' plots, themes, dialogue, moods, pacing, settings, characters, and sequences of events.¹⁴⁹ When it reached "mood and pace," however, the court stalled, noting that "it is always difficult to compare 'mood

¹⁴² See, e.g., *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 618–19 n.12 (7th Cir. 1982) (citing 17 U.S.C. § 106(2)), *abrogated on other grounds as recognized in Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985), and *Flava Works, Inc. v. Gunter*, 689 F.3d 754, 755 (7th Cir. 2012).

¹⁴³ Goldstein, *supra* note 3, at 228–29 (noting "decisions acknowledging that copyrighted architectural drawings are not infringed by buildings constructed from them, that traffic control systems are not infringed by bridges that embody them, and that a book on sales techniques is not infringed by a motion picture illustrating those techniques").

¹⁴⁴ See *supra* Part I.

¹⁴⁵ See *id.*

¹⁴⁶ *Castle Rock Entm't, Inc. v. Carol Publ'g Group, Inc.*, 150 F.3d 132, 139 (2d Cir. 1998) ("Because in the instant case the original and secondary works are of different genres and to a lesser extent because they are in different media, tests for substantial similarity other than the quantitative/qualitative approach are not particularly helpful to our analysis.").

¹⁴⁷ See *infra* Part II.

¹⁴⁸ 162 F. Supp. 2d 1129, 1143–55 (C.D. Cal. 2001), *aff'd*, 90 F. App'x 496, 498 (9th Cir. 2003).

¹⁴⁹ *Id.* at 1177–78.

and pace’ between works which are captured in different media (written word versus film).”¹⁵⁰ Nonetheless, it proceeded to make the comparison between the plaintiffs’ writings and the defendants’ film.¹⁵¹ It determined that “to the extent that” the elements could be discerned in the works, there was no substantial similarity.¹⁵²

The *Idema* court has not been alone in struggling to evaluate the substantial similarity of works in different media. In *Capcom Co., Ltd. v. MKR Group, Inc.*, the court noted the same difficulty when attempting to compare the mood of a film and the mood of a video game.¹⁵³ In *Thomas v. Walt Disney Co.*, the court observed that it was “virtually impossible to compare the pace of [the plaintiff’s] eleven page story with that of [the defendants’] feature length film,” and refused to even try.¹⁵⁴ In *Duckhole Inc. v. NBC Universal Media LLC*, the court found that it could not compare the pace and dialogue of the plaintiff’s treatment for a prospective television series with the defendants’ television series because the treatment did not include any dialogue, and the defendant’s series “was fully developed into a television show with distinctive pace and scripted dialogue.”¹⁵⁵ Worse yet, other courts have appeared to conclude that differences attributable to the medium were significant.¹⁵⁶

The difficulty in these cases arises because the manner in which authors communicate their expression to their audience varies depending on the medium. For example, Professor Goldstein has described the process of adapting a novel into a film as follows:

The first step “in adapting a book for the screen is to pare it down, cut it back to the basics and distill it into what movie people call its ‘filmable elements.’” . . . As a book is transformed into a movie or television series, descriptive passages drop out and the actors’ and set designers’ skills substitute for the novelist’s detailed characterization and scenic descriptions. Screenplays, it has been

¹⁵⁰ *Id.* at 1185.

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ No. C 08-0904 RS, 2008 WL 4661479, at *9 (N.D. Cal. Oct. 20, 2008) (citing *Idema*, 162 F. Supp. 2d at 1185).

¹⁵⁴ No. C-07-4392 CW, 2008 WL 425647, at *5 n.3 (N.D. Cal. Feb. 14, 2008) (citing *Idema*, 162 F. Supp. 2d at 1185), *aff’d*, 337 F. App’x 694 (9th Cir. 2009).

¹⁵⁵ No. CV 12-10077 BRO (CWx), 2013 WL 5797279, at *8 (C.D. Cal. Sept. 6, 2013).

¹⁵⁶ *Wild v. NBC Universal, Inc.*, 788 F. Supp. 2d 1083, 1106 (C.D. Cal. 2011) (indicating that the dialogue of the plaintiff’s graphic novel was “extremely limited, simplistic and cliché-ridden” as “[i]t is, after all, a comic book,” while the defendant’s television show contained “detailed, complex, and relatively sophisticated” dialogue), *aff’d*, 513 F. App’x 640 (9th Cir. 2013).

noted, are “barely readable conglomerations of dialogue, camera directions, setting descriptions, and character analysis.” The standard form of literary agreement typically gives the producer the unquestioned right to alter the property at will. The first draft screenplay will invariably be rewritten in the course of filming and editing. Sometimes all that will be left of the original work is little more than the title. The result may be a motion picture that is truer to the novel than any more literal, plodding imitation could possibly be. But has expression been taken and not just ideas?¹⁵⁷

As illustrated by Professor Goldstein’s description, the problem that becomes apparent is that a change in medium necessarily dictates other changes that might then suggest that the works are not substantially similar.¹⁵⁸ Indeed, the distinctions dictated by the change in medium are readily apparent, likely drawing the attention of the ordinary observer.¹⁵⁹ This problem may explain some of the

¹⁵⁷ Goldstein, *supra* note 3, at 219–20; see also Samuelson, *supra* note 2, at 1520 (“Dramatizations and motion-picture versions transform expressive elements of the plot, structure, characters, narrative thread, and the like of the underlying work to a different medium. Often, numerous changes are necessitated by the change in medium.”).

¹⁵⁸ Kwall, *supra* note 5, at 46–47 (“Application of the ‘substantial similarity’ test . . . is extremely problematic, particularly in the context of adaptations. . . . The use of this test with respect to derivative and preexisting works requires caution . . . because the technical requirements of a different medium usually necessitate certain changes, which could lull an ordinary observer into believing that no substantial similarity exists.”); Wurzer, *supra* note 57, at 1532–33 (noting that “derivative works necessarily differ in form from the original and, therefore, strict application of the substantial similarity test may not be appropriate in derivative works cases”); Goldstein, *supra* note 3, at 7–8 (noting that in *Filmvideo Releasing Corp. v. Hastings*, 509 F. Supp. 60, 63 (S.D.N.Y. 1981), *aff’d*, 668 F.2d 91 (2d Cir. 1981), the court recognized “that ‘there will be some differences between a motion picture and the book upon which it is based because of differences in the nature of the medias’”); see also Shipley & Hay, *supra* note 61, at 131 n.51 (“Determining whether an adaptation infringes another’s copyright is not easy unless it is a very close reproduction. The transformations often may be so great that it is difficult to see any connection between the works.”).

¹⁵⁹ *Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc.*, 150 F.3d 132, 139–40 (2d Cir. 1998) (finding the “ordinary observer” test was unhelpful to compare a television series and quiz book as “in the usual case, we might question whether any ‘ordinary observer’ would ‘regard the aesthetic appeal’ in a situation-comedy television program as being identical to that of any book, let alone a trivia quiz book, about that program”); Hennes, *supra* note 17, at 226 (“[T]he ordinary observer test has profound limitations. Nimmer, for example, argues that the test may fail to uncover instances of copying, such as the conversion of a novel into a derivative work such as a movie, in which ‘the immediate and spontaneous observations of a person untrained in the special requirements and techniques of the play, the novel, the short story, and the motion picture, may fail to note similarities which, if analyzed and dissected, would be only too apparent.’”); Wurzer, *supra* note 57, at 1549 n.158 (“Derivative works, by definition, are adapted from the original and, therefore, they may not seem similar to the ordinary observer.”).

confusion over whether a showing of substantial similarity is necessary to establish infringement of the derivative work right.¹⁶⁰

Some have suggested that changes in media *are* relevant to an assessment of substantial similarity,¹⁶¹ the argument being that if the differences are so significant that the ordinary observer cannot detect any similarities, then the plaintiff's rights have not been harmed by the allegedly infringing work in a different medium.¹⁶² The overwhelming majority of courts and commentators, however, have rejected this view.¹⁶³ Indeed, infringement in this context may be more alarming than infringement of the reproduction right because it implicates an untapped market, rather than one that has already been exploited.¹⁶⁴

Some contend that the substantial similarity test needs to be reformed to specifically address distinctions in medium.¹⁶⁵ Many, however, have persuasively suggested that differences dictated by a change in medium must be "filtered out" akin to unprotectable elements.¹⁶⁶ Accordingly, experts may be particularly helpful in the

¹⁶⁰ See articles cited *supra* note 132.

¹⁶¹ See *Crane v. Poetic Prods. Ltd.*, 593 F. Supp. 2d 585, 594–95 (S.D.N.Y. 2009) (citing distinctions between a play and nonfiction book that appeared to be dictated by the change in medium as significant for the purposes of assessing substantial similarity, and concluding that the defendant "not only ha[d] his own 'distinct style and wording,' he ha[d] his own distinct *medium*").

¹⁶² See McKnight, *supra* note 126, at 1290–91 ("If the public perceives the two works as distinct, then the public gains from having both works. Similarly, if ordinary members of the public cannot recognize the similarity between an original work and an allegedly infringing work, the allegedly infringing work probably has not damaged the original work's value in the marketplace.").

¹⁶³ See *supra* notes 136–41 and *infra* note 166.

¹⁶⁴ Kwall, *supra* note 5, at 47 n.179 ("[A] creator's loss may be greater when his work is appropriated, without his permission, into a different medium 'for here his work is made available to a new untapped market whereas if the infringing work were in the original medium, it would only attract the same persons who already had had an opportunity to purchase the plaintiff's work.'").

¹⁶⁵ Swatee L. Mehta, Note, *Tiffany Design, Inc. v. Reno-Tahoe Specialty, Inc.*, 15 BERKELEY TECH. L.J. 49, 50 (2000) (discussing "how the substantial similarity test may be improved by developing variants which address the creative and incentive needs for different kinds of works, both in terms of medium and market").

¹⁶⁶ See *Data E. USA, Inc. v. EPYX, Inc.*, 862 F.2d 204, 209 (9th Cir. 1988) (suggesting that the constraints inherent in the use of a specific home video game system were not relevant in the substantial similarity comparison because they were "not protectable"); *Rogers v. Koons*, 751 F. Supp. 474, 478 (S.D.N.Y. 1990) (rejecting the defendant's argument that the plaintiff had to "show substantial similarity between the photograph and the sculpture to sustain a claim of infringement, and that the differences in size, texture and color preclude such a finding" and noting that it was "really the discredited 'substitute medium' argument in a different form"); see also Goldstein, *supra* note 3, at 232 ("The

context of works in different media to educate the trier of fact about the differences that are dictated by the change in media and those that are voluntary, which may not be intuitive for a court or a jury.¹⁶⁷ Thus, as Professor Goldstein explains, infringement may exist where there are “equivalent” elements that differ only because the differences are “attributable to the changes in format.”¹⁶⁸ “So, for example, in the case of a novel transformed into a motion picture or television series, it should be recognized that scenic descriptions will be transmuted into visual depictions and that character development through interior monologue will be transformed by the actor’s professional contribution to his or her role.”¹⁶⁹ Of course, for infringement to occur, the infringing work must still incorporate a portion of the infringed work’s expression in some form.¹⁷⁰

There appears to be wide agreement that, in this context, infringement must be assessed in light of the economic justification for recognizing the derivative right.¹⁷¹ Thus, the existence of a foreseeable market for the derivative work will drive the analysis.¹⁷² Professor Samuelson has noted that some creators may create works with the expectation that they will be able to exploit derivative

court should again first determine the extent of protectable expression in the underlying [work], and should next determine the extent to which the expression has been copied in the alleged infringing form, *taking into account the changes required when a work is transferred from one format to another*. This last step, commonly taken by courts determining whether a work in one format, such as a motion picture, infringes a work in another, expressively different format, such as a novel, is necessary if derivative rights are to be given their intended full effect.”).

¹⁶⁷ See *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 618-19 n.12 (7th Cir. 1982) (noting “that in some cases it may be important to educate the trier of fact as to such considerations in order to preserve the author’s rights under the Copyright Act”), *abrogated on other grounds as recognized in Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985), and *Flava Works, Inc. v. Gunter*, 689 F.3d 754, 755 (7th Cir. 2012); see also Wurzer, *supra* note 57, at 1549 n.158 (indicating that “experts are needed to elucidate the similarities between the works”).

¹⁶⁸ Goldstein, *supra* note 3, at 226.

¹⁶⁹ *Id.*

¹⁷⁰ Kwall, *supra* note 5, at 45 n.170 (noting that according to the legislative history, in order “[t]o constitute a violation of section 106(2), the infringing work must incorporate a portion of the copyrighted work in some form; for example, a detailed commentary on a work or a programmatic musical composition inspired by a novel would not normally constitute infringements under this clause.”).

¹⁷¹ See *supra* notes 69-74 and *infra* 174-76.

¹⁷² See *supra* note 74 and accompanying text.

markets—including those in different media.¹⁷³ It is those foreseeable derivative markets that should be protected.¹⁷⁴ A related consideration is “whether an unauthorized derivative will supplant demand for an authorized” adaptation in a different medium.¹⁷⁵ Alternatively, one commentator has suggested that the portion of the work that “will generate a significant demand”¹⁷⁶ across media should be considered the protected expression, which could form the basis for a finding of infringement.

Thus, there appears to be wide—although not unanimous—agreement that a change in medium should not preclude a finding of infringement, and that the differences dictated by the change in medium should not be permitted to obscure the similarities when evaluating the substantial similarity of two works in different media.¹⁷⁷ Moreover, although the existing variations of the substantial similarity test may be difficult to utilize when attempting to compare works in different media, the similarities may be assessed using the equivalents specific to each medium.¹⁷⁸ And finally, an infringement analysis should also proceed against the backdrop of the economic incentives that drive copyright law.¹⁷⁹

¹⁷³ Samuelson, *supra* note 2, at 1559 (“The rationales for granting derivative work rights . . . also anticipate foreseeable markets. For example, incentives to create new works of authorship may be grounded for some creators upon expectations of rights to recoup research-and-development costs through control over readily foreseeable markets, such as the nine exemplary derivatives in the definition.”).

¹⁷⁴ *See id.*; *see also* Rogers v. Koons, 751 F. Supp. 474, 480 (S.D.N.Y. 1990) (noting that the plaintiff had “shown through the affidavits of competent experts that photographers may earn additional income through the sale of ‘art rendering’ rights, namely, creating an art work based on the photograph in a medium other than photography”). *But see* Mtima, *supra* note 41, at 8 (noting that for software, a second “work should be denied section 117 adaptation status and be treated as a derivative work only to the extent that the unauthorized work unduly compromises the commercial market interests of the copyright holder in the original program”).

¹⁷⁵ Samuelson, *supra* note 2, at 1520; *see also* Abramowicz, *supra* note 7, at 373 (“If the allegedly infringing work would be expected to cause significant demand diversion from actual or hypothetical transformations that the original author plausibly might make, then it would infringe the derivative right.”); Goldstein, *supra* note 3, at 217 (indicating that “motion pictures, translations and comic strips based on [a] novel will all infringe the derivative right because they add new expressive elements and serve markets that differ from the market in which the original was first introduced”).

¹⁷⁶ Wurzer, *supra* note 57, at 1544–45.

¹⁷⁷ *See supra* notes 6, 136–41, 166.

¹⁷⁸ *See supra* notes 146, 168–69.

¹⁷⁹ *See supra* notes 13, 84–85, 171–76 and accompanying text.

III

THE ROLE OF THE FAITHFUL ADAPTATION AS A BENCHMARK

The widely acknowledged difficulty of assessing the substantial similarity of works of different media in their original forms indicates that there is a missing step in the analysis. That missing step is the faithful translation of the plaintiff's work into the medium of the defendant's work as the representation of the right allegedly infringed: the plaintiff's right to create derivatives. The resulting "faithful adaptation" should serve as a benchmark for comparison when applying the traditional variations of the test for determining whether the plaintiff's work is substantially similar to the defendant's work. As discussed further below, however, there must be an additional check on this process in order to principally restrain the analysis. That is, to determine first whether there is a foreseeable derivative market for the original work in the defendant's medium in light of the incentive rationale underlying copyright law as well as market impact considerations borrowed from the fair use analysis.

A. Defining "Faithful Adaptation"

Most courts and commentators accept that differences required by a change in medium should not matter when evaluating substantial similarity.¹⁸⁰ The implication is that the differences due to the change in medium should be filtered out of the comparative process, much like scenes a faire and other unprotectable elements are filtered out.¹⁸¹ Nonetheless, comparing the protectable elements of works in different media is still problematic, as the *Idema* case demonstrates.¹⁸² For example, when comparing a sculpture to a photograph,¹⁸³ does one look at the elements for visual artwork (which might apply to a sculpture) or the elements for photography?¹⁸⁴ Individual elements are also problematic. Photographic elements like angle of view, framing, shading, and lighting¹⁸⁵ appear to be irrelevant for a three-dimensional sculpture. Similarly, if the visual art work elements

¹⁸⁰ See *supra* notes 6, 136–41.

¹⁸¹ See *supra* note 166.

¹⁸² See *supra* notes 148–52 and accompanying text.

¹⁸³ Cf. *Rogers v. Koons*, 751 F. Supp. 474, 477 (S.D.N.Y. 1990).

¹⁸⁴ See *supra* notes 115–16 and accompanying text.

¹⁸⁵ See *L.A. News Serv. v. Tullo*, 973 F.2d 791, 794 (9th Cir. 1992); *LaChapelle v. Fenty*, 812 F. Supp. 2d 434, 445–47 (S.D.N.Y. 2011).

apply, what does one make of the “materials” element¹⁸⁶ when looking at a typical photograph?

Rather than simply ignoring the precedential tests as irrelevant (as *Idema* might suggest), or attempting to force a “square peg into a round hole” comparison, courts should first translate the plaintiff’s work into the medium of the defendant’s work. The derivative work right protects the author’s right to transform an original work into a new medium in order to exploit a different market.¹⁸⁷ Thus, where a plaintiff alleges that a work in a different medium infringes an original work, it is the plaintiff’s right to produce a derivative work in that second medium that is at issue. Where the derivative work right is infringed, the derivative is the relevant benchmark, *not* the original work. The process of transforming the original work into the second work’s medium will accomplish what the courts have said is the proper manner of proceeding: filtering out the differences necessitated by changing the medium. It will also maintain the utility of the existing test for various works. Courts will no longer be at a loss when attempting to compare works in different media that have different expressive elements due to the fact that they are in different media.

The *Rogers v. Koons* case is illustrative.¹⁸⁸ In that case, the plaintiff’s black-and-white “Puppies” photograph depicted a couple with eight German shepherd puppies that appeared in a newspaper and was later licensed for use in notecards and an anthology.¹⁸⁹ The defendant subsequently prepared a polychrome (i.e., painted) wood sculpture, ultimately measuring forty-two inches by sixty-two inches by thirty-seven inches, that was otherwise intended to “be just like [the] photo.”¹⁹⁰ The court correctly rejected the defendant’s initial argument that the change in medium precluded a finding of infringement.¹⁹¹ The court further rejected the defendant’s argument “that the differences in size, texture and color preclude[d]” a finding of substantial similarity.¹⁹² The court indicated that this second argument was “really the discredited ‘substitute medium’ argument in

¹⁸⁶ See *Cavalier v. Random House, Inc.*, 297 F.3d 815, 826 (9th Cir. 2002).

¹⁸⁷ See *supra* Part I.B.

¹⁸⁸ 751 F. Supp. 474 (S.D.N.Y. 1990).

¹⁸⁹ *Id.* at 475.

¹⁹⁰ *Id.* at 476.

¹⁹¹ *Id.* at 477–78.

¹⁹² *Id.* at 478.

a different form.”¹⁹³ It concluded that there was “no question” that an ordinary observer would recognize the sculpture as an appropriation of the photograph.¹⁹⁴ It explained, “[q]uestions of size and color aside, the sculpture is as exact a copy of the photograph as [the defendant] could fashion.”¹⁹⁵ Thus, the differences between the two works attributable to texture, material, and two- or three-dimensional nature were irrelevant because they were dictated by the choice of medium. Although color and size were not necessarily dictated by the medium, those differences were dwarfed by the striking and overwhelming similarity: the fact that the sculpture depicted the exact same image of a couple with puppies. Thus, in the *Rogers* case, the faithful adaptation would have been virtually identical to the defendant’s sculpture with the possible exception of color and size—distinctions that paled in comparison to the striking similarities.

The dispute over visual artist Shepard Fairey’s iconic poster of then-presidential candidate Barack Obama also provides another interesting example. Fairey had used an Associated Press photographer’s picture of Obama to create his poster.¹⁹⁶ The image in Fairey’s two-dimensional poster was essentially the same as the photograph; however, Fairey had arguably turned it into “a stylized, blue pencil drawing . . . mimic[ing] the propaganda posters of the mid-20th century.”¹⁹⁷ The primary arguments in that case concerned the applicability of the fair use defense,¹⁹⁸ likely because Fairey recognized that he would be unlikely to prevail on a lack of substantial similarity defense given that both works focused on an image of the president that was the same. Fairey’s other changes were arguably dwarfed by that striking similarity.¹⁹⁹

Of course, in many instances, translating a work from one medium to another is much easier said than done. As Professor Goldstein’s description of the process of adapting a novel into a film demonstrates, there may be many significant changes. Courts and

¹⁹³ *Id.*

¹⁹⁴ *Id.*

¹⁹⁵ *Id.*

¹⁹⁶ See Shelly Rosenfeld, *A Photo Finish? Copyright and Shepard Fairey’s Use of a News Photo Image of the President*, 36 VT. L. REV. 355, 355 (2011).

¹⁹⁷ *Id.* at 367.

¹⁹⁸ See *id.* at 355–56.

¹⁹⁹ Cf. *Cariou v. Prince*, 714 F.3d 694, 706–11 (2d Cir. 2013) (determining that a visual artist’s use of numerous altered images from a photographer’s book was protected by the fair use defense for twenty-five of the thirty images at issue).

juries are unlikely to have the familiarity with the process necessary to perform the relevant analysis. Consequently, the process of translating the plaintiff's work into the defendant's medium appears to be one ripe for the assistance of expert analysis. In conducting such an analysis, experts should focus on translating the plaintiff's work into the new medium using the expressive equivalents of the two media. Thus, in a case where a film has allegedly infringed a novel, experts could explain how professionals would go about faithfully adapting the novel into a film. They do this by identifying the "filmable elements" that would be utilized to create the faithful adaptation, and what film equivalents of those elements would be used to create the adaptation.²⁰⁰ With the "faithful adaptation" then in mind, one can easily compare both the individual elements and the "total concept and feel" of the plaintiff's work as adapted into the new medium to the defendant's work. Thus, in a case like *Idema*,²⁰¹ an expert could explain how a studio would distill the plaintiffs' story into "filmable elements," substituting sets and acting for character development and scenic description.²⁰² The court could then compare the hypothetical film resulting from this process to *The Peacemaker* to determine whether there was substantial similarity in plot, themes, dialogue, mood, setting, pace, characters, and sequence of events.²⁰³

The faithful adaptation standard therefore accomplishes what the courts have said they are doing while preserving the relevance of the existing precedent in this context. It filters out the differences attributable to the change in medium while emphasizing the similarities that a lay observer might overlook. It accomplishes this latter task by translating the expressive elements of the plaintiff's work into the new medium's equivalents. By transforming the plaintiff's "orange" into an "apple," it thus allows the court to make an "apples-to-apples" comparison of the two works in the same medium using the accepted test for substantial similarity for that medium.

²⁰⁰ See *supra* note 157 and accompanying text.

²⁰¹ *Idema v. Dreamworks, Inc.*, 162 F. Supp. 2d 1129 (C.D. Cal. 2001), *aff'd*, 90 F. App'x 496, 498 (9th Cir. 2003).

²⁰² See Goldstein, *supra* note 2, at 219.

²⁰³ In most instances, the creation of an actual "faithful adaptation" would be cost prohibitive and is unnecessary since experts are capable of explaining how the process of doing so would unfold, leaving it to the court or jury to evaluate the resulting similarities and differences.

B. Remaining Problems

Some, however, still suggest that differences attributable to a change in medium are significant and should matter when undertaking a comparison for substantial similarity.²⁰⁴ Although some of these commentators and courts may not have focused on the issue, there still may be a number of reasons why one might object to the faithful adaptation standard in a principled manner.

One might object based on the controversial nature of the derivative work right. This raises the question: does the faithful adaptation standard further expand the derivative work right? If so, the standard is problematic for the reasons many scholars have identified when discussing why prior statutory expansions were arguably inappropriate or unnecessary.²⁰⁵ The point of the faithful adaptation standard, however, is not to apply the derivative right to a new category of works or expand the opportunities for infringement claims. The standard more clearly defines the circumstances under which a work in a second medium may infringe the original work. Indeed, the faithful adaptation standard is consistent with understandings of the derivative work right, such as Professor Abramowicz's suggestion that infringement of that right occurs where the defendant's work would compete with an "authorized transformation[] of the original," but not the original itself.²⁰⁶

Clarity in the law allows for predictability—a predicate for intelligent planning and economic expansion.²⁰⁷ Although applying the substantial similarity test in a manner that would account for differences attributable to a change in medium would arguably restrict the derivative work right—which critics²⁰⁸ of the derivative right might view as positive—it would do so at the expense of intellectual

²⁰⁴ See Shipley & Hay, *supra* note 61, at 131 n.48 (suggesting that the relevant comparison is of "substantial similarity of copyrightable expression between the underlying work and the adaptation allegedly constituting a violation of the reproduction right, however, the adaptation will not be deemed derivative so as to infringe 17 U.S.C. § 106(2) (1982)" (emphasis added)).

²⁰⁵ See *supra* Part I.B.3.

²⁰⁶ Abramowicz, *supra* note 7, at 386.

²⁰⁷ Cf. Arthur D. Hellman, *Jumboism and Jurisprudence: The Theory and Practice of Precedent in the Large Appellate Court*, 56 U. CHI. L. REV. 541, 544 (1989) (offering reasons why "a high degree of consistency and predictability in the law is necessary to the successful operation of the legal system," including because consistency and predictability allow for "intelligent planning and structuring of transactions").

²⁰⁸ See *supra* Part I.B.3.

consistency. Moreover, applying the substantial similarity test in this manner would create a disparity with the manner in which the derivative work right is applied where there is no change in medium. To the extent that the derivative work right does protect a translation into a new medium—and under the current statute it plainly does²⁰⁹—the differences attributable to a change in medium should not preclude a finding of infringement. Attempting to accomplish a de facto narrowing of the right by erroneously interpreting the law is the type of subterfuge that should not be condoned. Even if one agrees with the goal, such interpretations create confusion in the law and engender uncertainty.²¹⁰

Beyond fundamental disagreements with the present statutory formulation of the derivative work right, there may be other reasons for resisting the faithful adaptation standard. Indeed, a more difficult question is whether there are instances where no faithful adaptation of the plaintiff's work in a new medium would exist. If so, this begs the follow-up question, how can the faithful adaptation standard address this concern?

There may be some types of works that are incapable of being faithfully adapted from one particular medium to another. In other words, the media may be so different that one work's protected expression may not have any equivalent in the other medium. Most would probably agree that computer code, for example, could not be faithfully adapted into a dramatic work and vice versa.²¹¹ As discussed above, however, derivative works are possible in many

²⁰⁹ See *supra* notes 38–39, 60–61.

²¹⁰ Cf. *Planned Parenthood of Se. Pa. v. Casey*, 505 U.S. 833, 856 (1992) (noting the importance of the law in shaping economic relationships when analyzing *stare decisis*); *State ex rel. City of Charleston v. Bosely*, 268 S.E.2d 590, 601 (W. Va. 1980) (Neely, C.J., dissenting) (“[I]n the area of economics certainty in the law is the pre-eminent policy of justice.”); ALAN GREENSPAN, *THE AGE OF TURBULENCE* 468, 503 (2007) (noting the importance of protecting intellectual property rights to economic prosperity and explaining that “[e]ffective property and individual rights in general decrease uncertainty and open a wider scope for risk taking and the actions that can produce material well-being”).

²¹¹ Cf. Robert A. Kreiss, *Section 117 of the Copyright Act*, 1991 BYU L. REV. 1497, 1543 (1991) (suggesting that in the context of 17 U.S.C. § 117, an “adaptation” of a computer program is a derivative computer program, and not a sound recording, movie, novel, or work in another medium); John Cady, *Copyrighting Computer Programs: Distinguishing Expression from Ideas*, 22 TEMP. ENVTL. L. & TECH. J. 15, 19 (2003) (noting the difficulty of applying traditional literary tests “to factual works such as computer programs which normally do not have events and characters”). This is distinct from the works that one might create utilizing a computer program, which most would agree are not derivative works of the programs—e.g., a piece of music created using a program replicating a musical instrument is not a derivative of the program.

different contexts, including somewhat counterintuitive notions such as photographs infringing choreography,²¹² which at least implies that the choreography could also infringe still images.

Music presents a particularly challenging example. Of course, derivatives of sound recordings may be made using parts of the original sound recording, most frequently in the form of remixes.²¹³ Once the medium changes beyond those traditionally associated with musical works, however, the analysis becomes more difficult. For example, a music video would plainly infringe a sound recording, if not authorized. But what if a video consisted of images depicting the substance of the song's lyrics without using the sound recording or any sound whatsoever?

Providing another example of this conundrum, the band Frightened Rabbit wrote a song that was inspired by a scene in a Ben Kingsley film.²¹⁴ In the film, Kingsley's character decides to commit suicide by swimming directly into the ocean with no apparent intention of turning back, before ultimately stopping at his friend's urging, and subsequently being shown back on shore, drenched.²¹⁵ In the song, titled "Swim Until You Can't See Land," the narrator describes a similar predicament while the lyrics and music evoke a mood arguably similar to the character's despair in the film's scene.²¹⁶ But could the song constitute a faithful adaptation of the film?

Most would likely say that the answer is "no." There are, of course, many differences between the two works. Most of them, however, are dictated by the difference in media. If the film were faithfully adapted into a song, many of these differences would drop away. So why then would there not be infringement?

Initially, there is still a question of whether there is a sufficient degree of protected expression in common. The idea of a character contemplating suicide is most certainly unprotectable.²¹⁷ There would

²¹² See *Horgan v. MacMillan, Inc.*, 789 F.2d 157, 163 (2d Cir. 1986).

²¹³ See 17 U.S.C. § 114(b) (2012); see, e.g., RAC, <http://rac.fm> (last visited Sept. 2, 2014).

²¹⁴ See *Frightened Rabbit: Inspired by Solitude*, NPR (Mar. 12, 2010, 12:57 PM), <http://www.npr.org/templates/transcript/transcript.php?storyId=124619818>.

²¹⁵ THE WACKNESS (Sony Pictures Classics 2008).

²¹⁶ FRIGHTENED RABBIT, *Swim Until You Can't See Land*, on THE WINTER OF MIXED DRINKS (Fat Cat Records 2010).

²¹⁷ Cf. *Kaplan v. Stock Market Photo Agency, Inc.*, 133 F. Supp. 2d 317, 323 (S.D.N.Y. 2001) (indicating that depictions of a businessman contemplating suicide by leaping off of a tall building were not protectable).

also be a question about whether a taking from a single scene—albeit an arguably important one—in a ninety-nine minute film is “substantial.”²¹⁸ But assuming there is substantial similarity of protected expression, the problem would remain. The answer must lie with the nature of the derivative work right itself. As noted above, the touchstone of the right is the existence of an independent market unique to the derivative.²¹⁹ Professor Samuelson has persuasively argued that the right extends to the foreseeable and proximate markets for the three main statutory categories of derivative works and “close analogues,” including medium transformations.²²⁰ The question then becomes whether there is a foreseeable market for such a song that would have provided the film’s creators with an incentive to create the film in the first instance. As the answer to the question is certainly “no,” no faithful adaptation of the film in the music medium can exist.²²¹

In these instances, there must be a predicate question of whether an adaptation into the new medium is foreseeable. In other words, does it represent a market that the author might contemplate exploiting at some point during the creative process?²²² To the extent that it does not, it is beyond the scope of the derivative right and is therefore unprotectable. Because the market is theoretical, there is no need for the plaintiff to demonstrate that the author did in fact contemplate exploiting a particular derivative market.²²³ The plaintiff only needs to show that the he or she *could have* reasonably foreseen such a market during the creative process.²²⁴ In this respect, new technologies (involving new markets) are somewhat problematic. However, as Professor Balganesch suggests, the key to whether such a future market is foreseeable depends on whether the new technology

²¹⁸ See *supra* Part I.C.2.

²¹⁹ See *supra* note 74 and accompanying text.

²²⁰ Samuelson, *supra* note 2, at 1559.

²²¹ Other cases might present a tougher issue. For example, where a film’s theme song is expected to have a significant market based on the content of the film itself an author could theoretically invade or even usurp that market with a competing song. This might be the case for film franchises featuring distinctive music (such as the *James Bond* franchise) or films featuring musical content. Compare, e.g., *SKYFALL* (Columbia Pictures 2012), with ADELE, *Skyfall*, on *SKYFALL* (XL Recordings 2012), and 8 MILE (Universal Pictures 2002), with EMINEM, *8 Mile*, on *8 MILE* (Interscope Records 2002).

²²² Balganesch, *supra* note 7, at 1574–75.

²²³ *Id.* at 1605 (“It is not relevant whether the plaintiff actually foresaw the defendant’s form of copying; it only matters that the copying was foreseeable, in light of the information available to him at that stage of creation.”).

²²⁴ *Id.*

“has the effect of replacing the demand for creative work in existent markets” (i.e., results from demand diversion), or primarily creates new demand.²²⁵ The former market is foreseeable; the latter is not. To the extent that no foreseeable derivative market exists, however, then no faithful adaptation would exist, and—although the differences attributable to the fact that the works are in different media remain irrelevant—the similarities must be evaluated compared strictly in their original media.

The fair use defense may provide additional support for finding no substantial similarity where there is no foreseeable market for the second medium.²²⁶ Under a fair use analysis, where a work has been transformed in such a way that it will not usurp a potential market that the author might have foreseen, then no infringement has occurred.²²⁷ When assessing the market impact of an allegedly infringing use under the fair use test’s fourth factor, courts focus on whether the challenged use would have an adverse affect on the potential market for the plaintiff’s work if it became widespread.²²⁸ That is, if the defendant’s conduct were “unrestricted and widespread,” would it “result in a substantially adverse impact on the potential market for or value of the plaintiff’s present work?”²²⁹ The plaintiff, however, must have an interest in the potential market; accordingly, the market impact factor has focused on “traditional, reasonable, or likely to be developed markets.”²³⁰ Notably, the market impact factor has been referred to as the “single most important element of fair use.”²³¹ Applying this analysis to the Frightened Rabbit song, the song might also qualify as a “fair use.” Although the purpose of the use does not appear to have been for criticism or other explicitly protected means, there was a transformative use, the amount of the taking was relatively small, and it very plainly did not supplant any foreseeable market.²³²

Beyond fundamental issues adapting works in certain media to others, Professor Goldstein’s description of adapting a novel into a

²²⁵ *Id.* at 1608.

²²⁶ *See supra* notes 76–79 and accompanying text.

²²⁷ *See* 17 U.S.C. § 107 (2012).

²²⁸ *Harper & Row, Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 568 (1985).

²²⁹ *NIMMER*, *supra* note 102, § 13.05[A][5], at 13-183 to 13-184.

²³⁰ *Princeton Univ. Press v. Michigan Document Servs., Inc.*, 99 F.3d 1381, 1387 (6th Cir. 1996) (quoting *Texaco*, 60 F.3d at 930–31).

²³¹ *Harper & Row*, 471 U.S. at 566.

²³² *Cf.* 17 U.S.C. § 107.

film suggests that there may be instances where an adaptation would not retain any expression from the original work.²³³ In such an instance, the derivative work right would not protect the resulting adaptation because a derivative work must not only bear some degree of originality but also borrow some of the original work's expression.²³⁴ In instances where no expression is retained, such an adaptation is not a derivative work and consequently, cannot constitute a faithful adaptation for the purposes of copyright law.

C. The Faithful Adaptation Standard

The refined faithful adaptation standard thus has two components: (1) assessing the foreseeability of the market for the adaptation of the work in the new medium; and (2) faithfully translating the work into the new medium using equivalent means of expression. The first inquiry asks whether the plaintiff would reasonably contemplate exploiting the market for the work in the new medium at some point during the creative process. A necessary corollary of this inquiry is whether the author could have foreseen such a derivative market that theoretically could have been profitably exploited. The second inquiry then asks how a professional in the relevant field would go about faithfully adapting the work into the second medium by translating the work's expressive elements into the new medium's equivalents, borrowing expression from the original work while adding some degree of originality as dictated by the new medium.

These inquiries are necessarily case and fact specific. The first aspect of the test prevents the second (primary) inquiry from overreaching beyond the intended confines of the derivative work right. The second then seeks to protect those aspects of the author's expression that can be faithfully translated into the new medium. In doing so, it evaluates the similarity of expression without considering the changes dictated by the differences in medium.

Expert analysis may be useful in evaluating both aspects of the test. Expert analysis thus could be used to explain: (a) whether the work could be adapted to the new medium (i.e., is there a market that can be profitably exploited?); and (b) how a professional would adapt the work into the new medium. This does not necessarily mean, however, that expert testimony would be required. As the discussion above demonstrates, there may be situations where there is no reasonable

²³³ Goldstein, *supra* note 2, at 219–20.

²³⁴ See *supra* notes 69–74 and accompanying text.

possibility that an author would have contemplated exploiting a given derivative market. In such cases, a court could rule as a matter of law that no substantial similarity exists.

Similarly, if it is readily apparent that the two works are not substantially similar even disregarding differences dictated by a change in medium, then the court may rule for the defendant as a matter of law based on the plaintiff's inability to satisfy the second aspect of the test, without any expert analysis. Indeed, many courts have recognized that there is no categorical rule precluding them from evaluating substantial similarity as a matter of law, even at the pleading stage.²³⁵ Perhaps demonstrating the continuing relevance of the old maxim that "everyone is a critic,"²³⁶ courts have seemed particularly comfortable evaluating substantial similarity as a matter of law in the case of literary works.²³⁷ Courts will likely also be comfortable evaluating claims where the change in medium is relatively modest. For example, determining whether a film infringes

²³⁵ Peter F. Gaito Architecture, LLC v. Simone Dev. Corp., 602 F.3d 57, 64–65 (2d Cir. 2010); Nelson v. PRN Prods., Inc., 873 F.2d 1141, 1143–44 (8th Cir. 1989); Christianson v. W. Publ'g Co., 149 F.2d 202, 203 (9th Cir. 1945) ("There is ample authority for holding that when the copyrighted work and the alleged infringement are both before the court, capable of examination and comparison, non-infringement can be determined on a motion to dismiss."); Zella v. E.W. Scripps Co., 529 F. Supp. 2d 1124, 1130 (C.D. Cal. 2007); see also NIMMER, *supra* note 102, § 13.03[E][3] at 13-116 n.264.68 (concluding that although "the procedural posture applicable here is usually summary judgment for the defense . . . at times the court may simply dismiss the complaint").

²³⁶ *E.g.*, Frank Rich, *Roaring at the Screen*, N.Y. TIMES (Oct. 30, 2011), <http://query.nytimes.com/gst/fullpage.html?res=950DE0DC1E3BF933A05753C1A9679D8B63> ("[A]mbitious professional arts criticism is an increasingly arcane calling in a digital world where the old maxim, everyone's a critic, is literally true.").

²³⁷ See, *e.g.*, Funky Films, Inc. v. Time Warner Entm't Co., 462 F.3d 1072, 1076 (9th Cir. 2006) (noting that the court has "frequently" affirmed summary judgment in favor of defendants and stating that it is "often" appropriate to determine substantial similarity "as a matter of law"). On occasion, courts have seemingly gone out of their way to opine on the artistic merit (or lack thereof) of the works they were evaluating. *E.g.*, Situation Mgmt. Sys., Inc. v. ASP. Consulting LLC, 560 F.3d 53, 60 (1st Cir. 2009) ("[T]he district court's originality analysis was obviously tainted by its own subjective assessment of the works' creative worth. Its assessment of originality displayed nothing but pejorative disdain for the value of [the plaintiff's] works."). Judges, of course, are human and when evaluating a far-fetched infringement claim by a little-known plaintiff against a well-respected defendant with a broad body of work, it may be difficult to resist the temptation to note the rather obvious fact that the parties are not competing in the same league. The danger here is that the courts may let their own subjective impressions of a work's artistic merit color their legal analysis of an infringement claim. *Cf.* Scarves by Vera, Inc. v. United Merchants & Mfrs., Inc., 173 F. Supp. 625, 627 (S.D.N.Y. 1959) (recognizing that copyright protection applies regardless of a "lack of artistic merit"). A full discussion of this issue is beyond the scope of this Article.

a screenplay may not require any expert analysis.²³⁸ Generally, however, the courts will likely find that expert analysis provides significant assistance when evaluating infringement claims involving a change in medium.

CONCLUSION

Although the derivative work right is controversial, it does not appear to be going anywhere any time soon. As long as it does exist, its contours should be clearly defined. In light of the existence of the right, courts and commentators have generally recognized that changes dictated by a difference in medium should not preclude a finding of substantial similarity. As this analysis demonstrates, it follows that an author's expression should be protected in a second medium to the extent that the second medium represents a market that the author would reasonably contemplate exploiting and the work may be translated into the second medium using expressive equivalents to facilitate a substantial similarity analysis. The faithful adaptation standard protects this interest without expanding the derivative right beyond its statutory underpinnings, in accordance with the Copyright Act's mandate "to promote the advancement of knowledge and learning by giving authors economic incentives . . . to labor on creative, knowledge-enriching works"²³⁹ without unduly limiting the rights of "others to build freely upon the ideas and information conveyed by a work."²⁴⁰

²³⁸ *E.g.*, *Funky Films*, 462 F.3d at 1074–76 (affirming grant of summary judgment on the plaintiffs' claim that the defendants' television series infringed their screenplay).

²³⁹ *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 65 (2d Cir. 1994) (citing U.S. CONST. art. 1, § 8, cl. 8).

²⁴⁰ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349–50 (1991).