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# NOT DE MINIMIS: (IMPROPER) APPROPRIATION IN COPYRIGHT

OREN BRACHA\*

*The requirement of improper appropriation as a precondition for copyright infringement, a bedrock principle of copyright, has been under attack in recent case law. One line of attack attempts to eliminate the requirement in a specific area. Another erodes the requirement by construing it as a de minimis exception to infringement across all copyrightable subject matter. Ironically, a recent decision by the United States Court of Appeals for the Ninth Circuit that is commonly read as a staunch defense of the improper appropriation requirement represents the culmination of this second and far more dangerous line of attack. The decision insists that the improper appropriation requirement equally applies across the law of copyright, thereby creating a circuit split. It also construes, however, improper appropriation as a de minimis exception to copyright infringement and strictly limits it to cases where the original, as used in the user's work, would not be recognized at all. This approach adopts an extremely frail version of the improper appropriation requirement. In effect this rule says: "Get a license or never copy anything recognizable!" This Article describes the process through which courts came to conflate the improper appropriation requirement with a de minimis exception. It explores the function of the requirement by analyzing its origin and underlying policy. Improper appropriation based on the criterion of substantial similarity is one of copyright's most important doctrinal mechanisms for allowing breathing space for secondary creation and*

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*assuring that copyright does not become an impediment for the creativity it is supposed to promote. The doubly narrow reading of the doctrine as a de minimis exception based on unrecognizability is inadequate for carrying out this function. The de minimis version of improper appropriation is based on a fundamental misunderstanding of cultural creativity as a cumulative process and the role played by this doctrine with respect to it. This Article argues that to properly carry out its function of ensuring a lively, dynamic, and just cultural sphere, there is a need for a much more robust improper appropriation doctrine than the de minimis version. It also explains why neither the uncertainty of the improper appropriation standard nor the existence of the fair use doctrine supports trivializing the requirement.*

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## INTRODUCTION

Copying is not per se copyright infringement. To constitute infringement, the copied material must be substantially similar to the copyrighted work, and thus rise to the level of improper appropriation.<sup>1</sup> This requirement of improper appropriation is part of the prima facie case of copyright infringement. And therefore it is clear that, even prior to considering fair use or any of the more specific defenses and exemptions in the Copyright Act, certain cases of copying do not constitute infringement. This has been a bedrock principle of American copyright law for over a century.

And yet for decades now, the requirement of improper appropriation has been under attack. Notoriously, the Court of Appeals for the Sixth Circuit held that Congress eliminated the requirement altogether regarding sound recordings.<sup>2</sup> Far more concerning, however, is a broader trend of trivializing improper appropriation. A line of cases, including a recent decision by the Ninth Circuit, which explicitly rejected elimination of the requirement for sound recording copyright, construed improper appropriation as a feeble and trivial standard.<sup>3</sup> Improper appropriation, this approach assumes, is a “de minimis” exception—a rare exemption for extremely trivial cases where nobody would recognize the copying at all.<sup>4</sup> And this reading of the requirement applies not only to specific subject matter, but across the law of copyright. Reducing improper appropriation to a de minimis exception is not yet the universally accepted rule.<sup>5</sup> But

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1. 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A] (2018); *see also* W. Publ’g Co. v. Edward Thompson Co., 169 F. 833, 861 (C.C.E.D.N.Y. 1909) (observing that “[s]ome copying is permitted”).

2. *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 800–01 (6th Cir. 2005).

3. *See VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 880–84 (9th Cir. 2016).

4. *See infra* Section I.C.

5. Equating improper appropriation and de minimis is not a uniformly followed rule even in the Ninth Circuit, which has issued several opinions that adopted this approach. For a recent example of a Ninth Circuit opinion engaged in a proper

this largely unnoticed, creeping trend, has achieved a significant foothold in the case law.<sup>6</sup>

Despite the disagreement on sound recordings, the elimination and trivialization approaches implicitly share a common logic: improper appropriation as a precondition for infringement is a troubling doctrine that should be cabined and constrained. Often underlying this logic is an absolutist conception of copyright under which owners should internalize the entire social value of their creation by controlling any act of borrowing from their works—subject, perhaps, only to narrow and rare exceptions.

What is wrong with this approach to improper appropriation? First, it misunderstands both the origin and function of the improper appropriation requirement. The doctrine developed beginning in the late nineteenth century as part of a process of expansion of copyright's scope. Replacing the prior principle under which infringement was limited to near literal reproduction, improper appropriation extended copyright's scope to the much broader zone of "substantial similarity" to the original.<sup>7</sup> At the same time, however, the doctrine became the new central mechanism for monitoring copyright's boundaries. Even under the expanded scope, not all copying of protectable elements was banned, but only that which resulted in a sufficiently high level of similarity.

As a central doctrine regulating copyright's scope, improper appropriation can be coherently applied only if informed by the underlying policy served by it. I suggest that this policy is obtaining a satisfactory balance between copyright's incentive to create—a benefit achieved by exclusion—and its unfortunate negative effect on further creation by burdening the essential ability to borrow from previous works and build on them. Improper appropriation operates as a doctrinal lever that allows courts to place cases involving creative appropriation outside copyright's scope when the burden on the ability to appropriate outweighs any forgone incentive benefit. More specifically, improper appropriation is focused on those cases where the relevant policy judgment could be made primarily by comparing the expressive content of the primary and secondary works. This underlying logic

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analysis of improper appropriation with no hint of reducing the requirement to a de minimis exception, see *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1117 (9th Cir. 2018).

6. See *infra* Section I.C.3.

7. See *infra* Section II.A.

provides guidance on how to apply the criterion of substantial similarity that otherwise might appear mysterious or even capricious.

The rising trend of reducing improper appropriation to a *de minimis* rule stands in stark contrast to the function and purpose of the doctrine. *De minimis*, a concept borrowed from other legal fields, is a narrow exception for trivialities. It applies in rare cases when a particular case technically falls within the ambit of a legal rule, but the cost of enforcement greatly outweighs the harm of the relevant act and the benefit of enforcing. Improper appropriation forced into this frame is ill-suited to serve its purpose within the modern copyright framework. This purpose requires a robust boundary-regulating mechanism—not a rare exception for trivialities. Furthermore, the substantive focus is on the broad incentive benefits and freedom to borrow cost of subjecting certain expressive uses to copyright's exclusive control—not on the narrow question of the cost of the enforcement process compared to its benefits.

The focus of this Article is not a *de minimis* exception to copyright infringement, but rather, the much more important improper appropriation doctrine that it must not be confused with. This Article argues that improper appropriation is a powerful tool for regulating copyright's scope. Courts that reduce improper appropriation to a *de minimis* exception that applies only when the copying is unrecognizable misunderstand the doctrine and risk undue expansion of copyright in contravention of underlying policies. Moreover, the fair use doctrine, while an important check on over-expansive copyright, cannot adequately substitute for a robust improper appropriation limitation on infringement. Courts, therefore, should refrain from both dilution of improper appropriation and over-reliance on fair use. Instead, they should apply improper appropriation as a robust check on copyright's scope, in line with this doctrine's function and purpose in modern copyright law.

This Article proceeds in three parts. Part I explores the developing attack on improper appropriation and the rising trend of construing it as a *de minimis* exception. It describes and critiques the Sixth Circuit's sound recording exceptionalism approach to improper appropriation. Next, this Article argues that the Ninth Circuit's recent rejection of this exceptionalism is a Pyrrhic victory for improper appropriation because, even as it embraced the requirement as applying throughout copyright's subject matter, it also incorporated and perpetuated a narrow reading of the requirement as a *de minimis* exception. This

Article then reviews the decades-long process of doctrinal drift in which the de minimis reading of improper appropriation rose to its current dominant status. Part II explains the function of improper appropriation in modern copyright law. It first describes the origin of the requirement in the late nineteenth century expansion of copyright's scope and how it came to be copyright's new central mechanism for monitoring its boundaries. This Article then shows how two sets of consequence-oriented normative frameworks endow the policy lever of improper appropriation with concrete content. The first framework is efficiency as a dominant variant of welfarism. The second framework is a group of three other theories that step beyond mere summation of subjective individual welfare: self-determination, cultural democracy, and human flourishing. Part II concludes by explaining why a robust freedom to borrow and re-appropriate is essential for a vibrant creative process, and therefore should be shielded by a vital improper appropriation doctrine as informed by the relevant normative theories. Finally, Part III considers improper appropriation in its doctrinal environment. It tackles and rejects two possible arguments in favor of scaling back the requirement: (1) the uncertain character and unpredictable application of the open-ended improper appropriation standard and (2) the claim that it is wastefully redundant in light of the fair use doctrine that already regulates copyright's scope.

Let me be clear: I am not arguing that improper appropriation is a panacea. Far from it. There are many justified complaints against the doctrine; its open-ended, often hard to predict, and even confusing character not being the least of them. I find it quite likely that an alternative—more certain robust mechanism for regulating copyright's scope—would be preferable. Yet for better or worse, improper appropriation is the doctrine that emerged as the main mechanism for performing this function. Simply eliminating it or reducing it to a trivial de minimis exception will not do. I am arguing, then, that improper appropriation is charged with a central role in modern copyright and rather than simply eroding it, we should think how to fix or replace it with something better.

### I. IMPROPER APPROPRIATION UNDER SIEGE

The improper appropriation requirement has been under pressure recently. The most notorious example is the *Bridgeport Music, Inc. v.*

*Dimension Film*<sup>8</sup> decision.<sup>9</sup> *Bridgeport* is rooted in hostility towards improper appropriation, but its line of attack is narrow. The decision is based on sound recording exceptionalism and its heart is the proposition that copyright in recorded sounds is unique because, unlike copyright in any other subject matter, it is infringed upon copying with no additional requirement of improper appropriation.<sup>10</sup> This logic is extreme. It mandates the complete elimination of the improper appropriation requirement. But it is also limited in scope because it applies only to one important, but relatively limited, area out of the many expressive fields covered by copyright. However, the decision provides a glimpse of the reasons underlying the hostility toward improper appropriation shared by both *Bridgeport*'s supporters and many of its critics. I briefly explain below the basis of the *Bridgeport* decision, its fatal flaws, and the skeptical approach to improper appropriation embodied within it.

Far more worrisome than *Bridgeport*'s approach is a more universal erosion in the case law of the improper appropriation requirement. The theme of these cases is not elimination, but trivialization. In a decades-long creeping process, some courts have interpreted the requirement narrowly and limited its scope of application. Such readings usually march under the banner of de minimis and present improper appropriation as simply the embodiment of this general legal principle in the domain of copyright. The result is a frail version of improper appropriation as a narrow exception that applies only in extreme cases. And the effect is much broader than *Bridgeport*'s targeted elimination because it applies across the law of copyright to all expressive works. Ironically, this process of trivialization has ripened into a fully developed version of improper appropriation minimalism in a recent decision that is framed as a staunch defense of this doctrine: *VMG Salsoul, LLC v. Ciccone*.<sup>11</sup> After explaining how the decision trivializes improper appropriation, I outline the gradual process that led to the misguided understanding of this requirement as a narrow de minimis exception.

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8. 410 F.3d 792 (6th Cir. 2005).

9. *Id.* at 800 (holding that sound recording copyright is infringed upon copying with no additional requirement of improper appropriation).

10. *Id.* at 798.

11. 824 F.3d 871, 880–81 (9th Cir. 2016).

A. *Sound Recording Exceptionalism and Its Discontents*

In *Bridgeport*, the Sixth Circuit held that “no substantial similarity . . . inquiry should be undertaken at all” when it is established that a sound recording had been copied.<sup>12</sup> As the court framed its announced rule: “Get a license or do not sample.”<sup>13</sup> The court based its holding on a variety of justifications, each of which falls flat upon examination.

1. *Text*

The central plank of *Bridgeport*'s reasoning is that it is dictated by a plain reading of the sections of the Copyright Act that govern copyright in sound recordings. In 1971, Congress extended copyright to sound recordings,<sup>14</sup> thereby recognizing on the federal level recorded sounds as a copyrightable subject matter distinct from any underlying musical composition.<sup>15</sup> When it did so, and later in the 1976 Copyright Act, Congress narrowly defined the scope of copyright in such newly recognized subject matter.<sup>16</sup> The owner's exclusive reproduction entitlement under § 106(1) was limited in § 114(b) to “the right to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording.”<sup>17</sup> Furthermore, the derivative works right was limited to cases where “the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality.”<sup>18</sup> Congress also clarified that these two entitlements “do not extend to the making or duplication of another sound recording

12. *Bridgeport*, 410 F.3d at 798.

13. *Id.* at 801.

14. Sound Recording Amendment Act, Pub. L. No. 92-140, 85 Stat. 391 (1971).

15. Copyright law differentiates between two distinct subject matter categories. A “musical composition,” a term not defined in the statute, is the general expression including both music and words embodied in a musical work. *See* 17 U.S.C. § 102(a) (2) (2012). Sound recordings are “works that result from the fixation of a series of musical, spoken, or other sounds.” § 101 (defining “sound recordings”); § 102(a) (7) (listing sound recordings as copyrightable material). Musical compositions were protected since the earliest days of the American regime although the category was only added explicitly to the statute in 1831, and the relevant entitlements expanded beyond reproduction in print only later. *See* An Act To Amend the Several Acts Respecting Copyrights, 4 Stat. 436, § 1 (1831). Sound recordings were recognized as a distinct category only in 1971. § 1(a), 85 Stat. at 391.

16. *See id.*; *see also* 17 U.S.C. § 114(b).

17. 17 U.S.C. § 114(b). “Phonorecords” are “material objects in which sounds . . . are fixed.” § 101.

18. § 114(b).

that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording.”<sup>19</sup> In short, § 114 limits both the reproduction and the derivative works rights to mechanical duplication of the actual sounds embodied in the copyrighted sound recording. One might infringe the sound recording copyright by duplicating the actual recording of Pink Floyd’s song “Wish You Were Here” in whole or in part or by “remixing” those recorded sounds. But one cannot infringe the sound recording copyright—as opposed to the copyright in the underlying musical composition—by recording an independent version of the song, no matter how similar to the original recording the new version is.

From this limited scope of sound recording copyright, the *Bridgeport* court concluded that a copyright owner in a sound recording has “the exclusive right to ‘sample’ his own recording.”<sup>20</sup> And in what it described as a “literal reading”<sup>21</sup> of the statute, it understood this to mean that sound recording copyright is violated upon duplication of the actual recorded sounds and, unlike copyright in other subject matter, does not require the additional element of improper appropriation to establish infringement.<sup>22</sup> From this perspective, when Congress said that only a duplication of the actual recorded sounds is infringement, it meant that *every* duplication of such sounds is an infringement—period.<sup>23</sup> It disposed of any additional requirement necessary elsewhere for establishing the prima facie case of infringement.

As observed by others, this reasoning is a non-sequitur.<sup>24</sup> It does not follow from the statute’s proposition that sound recording copyright is limited to duplication of the actual recorded sounds that any duplication of the actual recorded sounds is infringing irrespective of

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19. *Id.*

20. *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 801 (6th Cir. 2005).

21. *Id.* at 805.

22. *Id.* at 801 (observing that with sound recording “substantial similarity [does] not enter the equation”).

23. *See, e.g., VMG Salsoul, LLC v. Ciccone*, 824 F.3d 871, 884 (9th Cir. 2016) (discussing congressional intent with respect to 17 U.S.C. § 114).

24. *See Saregama India Ltd. v. Mosley*, 687 F. Supp. 2d 1325, 1340–41 (S.D. Fla. 2009), *aff’d* by 635 F.3d 1284 (11th Cir. 2011) (finding that § 114(b) does not distinguish between sound recordings and other copyrightable works); NIMMER & NIMMER, *supra* note 1, § 13.03[A][2][b] (explaining that *Bridgeport* rests on a “misapprehension of the statutory structure”); WILLIAM F. PATRY, 3 PATRY ON COPYRIGHT § 9.209 (2015) (referring to the decision as “one of the most wrong-headed copyright opinions in 300 years of case law”).

additional conditions. On its face, the text of the statute simply limits the scope of sound recording copyright to mechanical reproduction.<sup>25</sup> It says nothing about the applicability, or lack thereof, of the general improper appropriation element. Following the logic of the court's reasoning, any subject-matter-specific statutory restriction of the scope of entitlements might be read as dispensing with the improper appropriation requirement. For example, copyright in an architectural work that has been constructed does not include the right to prevent the making, distribution, or public display of "pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place."<sup>26</sup> Shall we say that any pictorial representation of an architectural work not embodied in a building located in or visible from a public place is infringement, irrespective of improper appropriation? It is much more plausible to read the limitations of entitlements for both architectural works and sound recordings as being just that: limitations on the scope of entitlements. Rather than dispensing with the improper appropriation requirement, the plain language of the statute simply gives effect to various policy concerns by limiting the scope of copyright in certain subject matter, while saying nothing at all about other general elements of the infringement case.

*Bridgeport's* holding is thus anything but a "literal reading" of the statute. Perhaps, however, it is still possible that Congress chose this extremely opaque textual strategy for expressing the purpose of dispensing with improper appropriation. In theory, that is, it is possible that other indicia of statutory interpretation might lend support to this textually implausible reading of the statute. As it happens, expanding the lens beyond the statutory text further bolsters the conclusion that Congress left the improper appropriation requirement untouched.

## 2. *Legislative history, purpose, and structure*

The legislative history of the 1976 Copyright Act confirms that the purpose of § 114 was to limit the scope of sound recording copyright rather than to expand it by dispensing with the improper

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25. 17 U.S.C. § 114(b) (2012) ("The exclusive right of the owner of copyright in a sound recording . . . is limited to the right to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording.").

26. § 120(a).

appropriation requirement. The House Report explains that § 114(b) clarifies that “statutory protection for sound recordings extends only to the particular sounds of which the recording consists.”<sup>27</sup> Furthermore, it “would not prevent a separate recording of another performance in which those sounds are imitated” because “[m]ere imitation of a recorded performance” does not constitute infringement.<sup>28</sup> The 1976 Copyright Act House Report could even be read as expressing implicit recognition of the improper appropriation requirement when it observes that “infringement takes place whenever all or any substantial portion of the actual sounds that go to make up a copyrighted sound recording are reproduced.”<sup>29</sup> Thus, the legislative history confirms that the purpose of § 114 was simply to limit the scope of sound recording copyright and even contains an implied recognition of the application of improper appropriation.<sup>30</sup>

What was, however, the purpose of the statutory limitation of the scope of sound recording copyright? The answer requires some familiarity with the history of the extension of copyright to recorded sound. Luckily, a rough outline of some aspects of the labyrinth that is pre-1971 legal protection for sound recordings suffices for our purposes. Attempts to obtain exclusive rights in sound recordings started soon after the commercialization of the technology. Over the decades, they followed three different routes: (1) procurement of federal or state legislation; (2) judicial recognition of common law copyright in sound recording and; (3) judicial imposition of liability on copiers under unfair competition law.<sup>31</sup>

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27. H.R. REP. NO. 94-1476, at 106 (1976), *as reprinted in* 1976 U.S.C.C.A.N. 5659, 5721.

28. *Id.* The report further clarifies that the same intention of limiting the right to prevent protection for imitative performances applies to the derivative works entitlement. Similar explanations appear in the reports accompanying the first introduction of federal copyright protection of sound recordings in 1971. H.R. REP. NO. 92-487, at 13 (1971), *as reprinted in* 1971 U.S.C.C.A.N. 1566, 1578 (explaining that the right “does not include imitation or simulation of that performance”). The report refers several times to the intention of creating a “limited copyright” in sound recording and explains that the right “does not extend to the making or duplication of another sound recording that is an independent fixation of other sounds.” *Id.* at 8.

29. H.R. REP. NO. 94-1476, at 106.

30. *See id.*

31. *See* BARBARA A. RINGER, S. COMM. ON THE JUDICIARY, 86TH CONG., THE UNAUTHORIZED DUPLICATION OF SOUND RECORDINGS 10–19 (Comm. Print 1961) [hereinafter SOUND RECORDING STUDY] (describing various approaches to common law protection of dubbing); STUART BANNER, AMERICAN PROPERTY: A HISTORY OF HOW,

One impediment for the court-centered routes, especially the unfair competition one, was the reluctance of courts to recognize distinct rights in the style or manner of performance. Arguments for sound recording protection that emphasized the creative contribution of the performer were met with stiff resistance.<sup>32</sup> Courts based this resistance on a variety of considerations including concerns about the proper subject matter of copyright, originality, and over-fragmentation of rights in expressive subject matter.<sup>33</sup> One court explained that the specter of owning “creative mannerisms” led to the rule that “what we may call generically by the French word *représentation* [ ]—which means to perform, act, impersonate, characterize, and is broader than the corresponding English word, is not copyrightable or subject to any right recognized under the law of unfair competition.”<sup>34</sup> Moreover, in earlier iterations of the legislative debates, various interest groups opposed to rights in recorded music, such as songwriters or broadcasters, invoked the principle established in the case law that performers could not assert rights in their style or manner of performance.<sup>35</sup>

This barrier for obtaining statutory copyright in sound recordings was eventually bypassed by distinguishing assertions of ownership of the performer’s style from more modest claims for controlling a specific reproduction of recorded sounds. A 1951 copyright office study drew a sharp distinction between mechanically reproducing recorded sounds, which it called “dubbing” and control of “imitation or simulation of a style or method of performance.”<sup>36</sup> It observed that

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WHY, AND WHAT WE OWN 110–11, 121 (2011) (discussing the various proposals to provide copyright in sound recordings before the enactment of the Copyright Act).

32. SOUND RECORDING STUDY, *supra* note 31, at 10.

33. See *Green v. Minzensheimer*, 177 F. 286, 286 (C.C.S.D.N.Y. 1909) (refusing to find imitation of “the voice, postures and mannerisms” of a performer to be copyright infringement); *Savage v. Hoffmann*, 159 F. 584, 585 (C.C.S.D.N.Y. 1908) (observing that “complainant has no literary property in the manner in which [others] dance or posture”); *Bloom v. Nixon*, 125 F. 977, 978 (C.C.E.D. Pa. 1903) (interpreting the Act of 1897 to mean that copyright is not infringed upon by good faith imitation of a character); *Murray v. Rose*, 30 N.Y.S.2d 6, 7 (Sup. Ct. 1941) (refusing to enjoin the performance of a dance that was alleged to imitate the plaintiff’s rendition of the dance).

34. *Supreme Records, Inc. v. Decca Records, Inc.*, 90 F. Supp. 904, 909 (S.D. Cal. 1950).

35. See *Authorizing a Composer’s Royalty in Revenues from Coin-Operated Machines and to Establish a Right of Copyright in Artistic Interpretations: Hearings on H.R. 1269, H.R. 1270, and H.R. 2570 Before the Subcomm. on Patents, Trade-Marks, and Copyrights of the H. Comm. on the Judiciary*, 80th Cong. 35–38, 45–52, 61–83, 274–76 (1947) (identifying testimony from seven industry participants and explaining that style is not protectable and may be imitated).

36. SOUND RECORDING STUDY, *supra* note 31, at 1 & n.3.

“[f]ailure to draw the distinction resulted in confusion and misunderstandings.”<sup>37</sup> Sensing that “[t]here was practically no direct opposition to the principle of protection of sound recordings against unauthorized dubbing,” it adopted the strategy of focusing on this protection and tossing performance rights aside.<sup>38</sup> The purpose of limiting statutory sound recording copyright was to embody this distinction and leave out rights in performance style. And it was this purpose that was reflected in every iteration of the long legislative process leading to the 1971 and 1976 statutes. Thus, the limitation of the scope of sound recording copyright in what became § 114 had nothing to do with the improper appropriation requirement. It was all about congressional resolve to strictly limit the new subject matter to recorded sound as such, a resolve that was an incarnation of a longstanding debate over performers’ style rights.

The structural location of § 114 within the Copyright Act reflects this logic.<sup>39</sup> Chapter 1 of the Copyright Act has a clear structure: § 106 and § 106A<sup>40</sup> broadly define the exclusive entitlements of the owner, and all succeeding sections<sup>41</sup> narrow down these entitlements through various defenses, exemptions, restrictions, and compulsory licenses.<sup>42</sup> Section 114(b)’s location would be a structural anomaly had it been intended to expand the entitlements in sound recordings by eliminating the applicability of the improper appropriation requirement.

### 3. *Legislative tradition*

The conclusion that § 114(b) was not intended to eliminate the improper appropriation requirement is bolstered by a long and unbroken tradition of seeing the test of copyright infringement, and its improper appropriation element, as part of the judicial province. In an uninterrupted pattern since the first iteration of the Copyright Act of 1790, Congress has defined the exclusive entitlements of the copyright owner both positively and negatively by way of various

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37. *Id.* at 1 n.3.

38. *Id.* at 37.

39. *See* VMG Salsoul, LLC v. Ciccone, 824 F.3d 871, 883 (9th Cir. 2016); NIMMER & NIMMER, *supra* note 1, § 13.03[A][2][b].

40. 17 U.S.C. §§ 106–106A (2012).

41. §§ 107–122.

42. *See* H.R. REP. NO. 94-1476, at 61 (1976) (“The approach of the bill is to set forth the copyright owner’s exclusive rights in broad terms in section 106, and then to provide various limitations, qualifications, or exemptions in the 12 sections that follow.”).

qualifications but left the formulation of the test for copyright infringement to the courts. The same is true of the 1976 Copyright Act, which, like its predecessors, remained completely silent on the subject of the infringement test.<sup>43</sup>

Against the backdrop of this long tradition, it is extremely unlikely that Congress intended to define a special infringement test for a specific subject matter by simply dispensing with an element that courts had treated for over a century as an essential part of that test. It is even less likely that it intended to do so through the supposed implication of simply remaining silent on the issue.

#### 4. *Miscellaneous*

The assortment of other support that the *Bridgeport* court found for its reading of § 114(b) can be dismissed fairly quickly. For example, the claim that “[w]hen you sample a sound recording you know you are taking another’s work product” is neither accurate nor relevant.<sup>44</sup> While the unconscious copying of sound recording is perhaps not common, it is not impossible.<sup>45</sup> More to the point, under existing doctrine, knowledge of copying or lack thereof is simply irrelevant for infringement.<sup>46</sup> It is not surprising, therefore, that the improper appropriation requirement has nothing to do with knowledge: copying which is not substantially similar to the original is not an infringement, whether or not the copier knew that she was copying. Therefore, a sampler’s knowledge that she is copying is beside the point.

Similarly, the assertion that sampling of sounds “is a physical taking rather than an intellectual one” is flatly wrong.<sup>47</sup> Duplicating recorded sounds, whether digitally or analogically, is a mechanical process by which a physical object is manipulated so that it represents the same information as another preexisting physical object, information that with the aid of a proper device can be translated into sounds.<sup>48</sup> When

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43. See Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 CORNELL L. REV. 857, 857 & n.7 (1987).

44. *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 801 (6th Cir. 2005).

45. Consider, for example, the case of A’s authorized sampling of B’s sound recording that unbeknownst to A contains unauthorized sampling of C’s sound recording.

46. See *Buck v. Jewell-La Salle Realty Co.*, 283 U.S. 191, 198 (1931); *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 722 F.2d 988, 998 (2d Cir. 1983).

47. *Bridgeport*, 410 F.3d at 802.

48. See 17 U.S.C. § 101 (2012) (defining “phonorecords” as “material objects in which sounds . . . are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated”).

one digitally duplicates recorded sounds, that person does not physically take the copy from which she reproduces, any more than she physically appropriates a book when she photocopies it. Mechanical reproduction is not a physical taking, but rather a use of a device to duplicate in a new physical form the informational content of an existing physical object.<sup>49</sup> It is not unique to sound recording but can be found across the board of copyrightable subject matter. Most importantly, mechanical reproduction is not treated in copyright law differently from non-mechanical reproduction. Just as with non-mechanical derivation of the information content, mechanical duplication infringes only if it satisfies the general infringement test, including its improper appropriation element.

### 5. *Policy*

And then there is policy. While claiming to be based primarily on the plain meaning of the statutory text, the bulk of *Bridgeport's* reasoning is actually devoted to developing a specific policy justification. The heart of this policy justification is the facilitation of market transactions through “bright line” rules.<sup>50</sup> The paramount goal here is to ensure that rights owners can transact easily with others who want to use recordings owned by them. Clear rules as to the scope of the rights, the argument goes, are critical to reduce not just the cost of disputes and litigation, but, more importantly, that of private transactions.<sup>51</sup> When it is crystal clear to all parties involved what is owned, negotiations are likely to be smoother and cheaper. The improper appropriation requirement, with its obvious open-ended inquiry over substantial similarity, is a troubling source of uncertainty, and one that must be removed in order to grease the wheels of the market for sound recording rights.

Below I examine critically the merits of the bright-line rule policy argument as it applies to the improper appropriation requirement in general.<sup>52</sup> For now, it is sufficient to observe that this policy argument cannot support the sound recording exceptionalism of *Bridgeport*.

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49. *Id.*

50. *Bridgeport*, 410 F.3d at 803 n.18; *see also* VMG Salsoul, LLC v. Ciccone, 824 F.3d 871, 890 (9th Cir. 2016) (Silverman, J., dissenting) (praising the dispensation of an improper appropriation requirement for being a bright line rule).

51. *Bridgeport*, 410 F.3d at 802 (“If any consideration of economy is involved it is that of the music industry.”).

52. *See infra* Section III.A.

Remember that the decision does not purport to reject the improper appropriation requirement in general, but simply eliminates it in the context of sound recordings. To support this decision, one must explain what is special about this context in relation to the relevant policy. In other words, to justify sound recording exceptionalism, it is not enough to show that transactional efficiency policies cut in favor of the elimination of improper appropriation. Rather, it is necessary to show that there is something unique about sound recordings that make such a proposition significantly more apt to this subject matter, relative to all other contexts, where it was insufficient to tilt the balance against improper appropriation. While context matters for the analysis of the relationship between legal rules and transactional efficiency, it is simply unclear why recorded sounds are fundamentally different compared to all other subject matter and industries. And in the absence of such uniqueness, whatever the general merits of the bright-line rule argument, it cannot support a unique treatment of sound recordings.

#### 6. *Making sense of it*

At this point, one has to pause and ask: what is going on here? How is it that a court of appeals in a high stakes case—and indeed a fuming dissent in another court of appeals’ decision<sup>53</sup>—adopts a statutory interpretation that is implausible on its face and even less plausible when its reasoning is closely examined? One may suspect that a particular understanding of copyright as a property right plays a role here.<sup>54</sup> *Bridgeport* seems to be motivated by an absolutist conception of

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53. See *VMG Salsoul, LLC*, 824 F.3d at 888–90 (Silverman, J., dissenting) (“This inconsistent approach is plainly in contravention of Congressional intent that copyright laws be predictable and uniform, yet the majority defends its rogue path on the ground that Congress must have intended something other than what the Sixth Circuit has concluded . . .”).

54. There is an ongoing scholarly debate on whether framing intellectual property and particularly copyright in property terms contributes to an absolutist conception of this field. One camp of scholars argues that there is nothing absolutist about property; rather, property offers many doctrinal tools for restricting rights and accommodating the interests of non-users. See, e.g., Michael A. Carrier, *Cabining Intellectual Property Through a Property Paradigm*, 54 *DUKE L.J.* 1, 4 (2004); Hanoch Dagan, *Property and the Public Domain*, 18 *YALE J.L. & HUMAN.* 84, 88 (2006); David Fagundes, *Property Rhetoric and the Public Domain*, 94 *MINN. L. REV.* 652, 675–76 (2010); Christopher M. Newman, *Transformation in Property and Copyright*, 56 *VILL. L. REV.* 251, 255–57 (2011); Molly Shaffer Van Houweling, *The New Servitudes*, 96 *GEO. L.J.* 885, 898 n.57, 912 (2008). An opposing camp argues that the rhetoric of property lends itself easily to interpretations of strong or even absolutist owner’s control. See, e.g., Mark A. Lemley, *Romantic*

property that simply assumes that owners must receive a broad and strong control over whatever is being owned.<sup>55</sup> Clues to this underlying assumption can be found in the careless assertion that copying sounds involves a “physical taking”<sup>56</sup> and in the invocation by the court of the moralistic “[t]hou shalt not steal” command.<sup>57</sup> But the absolutist conception of property in *Bridgeport* is not completely formalistic. It is covered by a thin patina of policy justification embodied in the opinion’s discussion of the virtues of bright-line rules as a precondition for transactional efficiency.<sup>58</sup> This misguided, but common, position sees copyright’s ultimate goal as making sure that the owner internalizes the full value of her creation accompanied by rules that facilitate smooth market transfers.<sup>59</sup> It often goes hand in hand with absolutist assumptions about intellectual property rights.

It is this fundamental attitude—an absolutist conception of property covered by a thin patina of the policy of full internalization and transactional efficiency, as well as a straightforward judicial craving for an easy to apply rule<sup>60</sup>—that connects *Bridgeport*’s exceptionalism with

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*Authorship and the Rhetoric of Property*, 75 TEX. L. REV. 873, 895–904 (1997); Lawrence Lessig, *Re-crafting a Public Domain*, 18 YALE J.L. & HUMAN. 56, 81 (2006); Neil W. Netanel, *Why Has Copyright Expanded? Analysis and Critique*, in 6 NEW DIRECTIONS IN COPYRIGHT L. 3, 11–15 (Fiona Macmillan ed., 2007). Whether or not property rhetoric has a general tendency in this respect, it seems that in our case it is exactly the absolutist version that informs and motivates judicial support for eliminating the improper appropriation requirement for sound recordings.

55. *Bridgeport*, 410 F.3d at 800–01.

56. See *id.* at 802; see also *VMG Salsoul, LLC*, 824 F.3d at 889 (Silverman, J., dissenting). Needless to say, even when physical interests are at stake, it does not follow that property rights are or could be absolute. There is, however, a strong and longstanding tradition of associating a physicalist understanding of property with an absolutist one.

57. *Bridgeport*, 410 F.3d at 801 n.12; see also *VMG Salsoul, LLC*, 824 F.3d at 890 (Silverman, J., dissenting) (echoing the invocation). The appeal to the intuitive force of the biblical command has a long history in copyright sampling cases. See *Grand Upright Music Ltd. v. Warner Bros. Records, Inc.*, 780 F. Supp. 182, 183 (S.D.N.Y. 1991) (opening the opinion, which found unauthorized sampling by defendant infringing, with “‘Thou shalt not steal’ has been an admonition followed since the dawn of civilization”).

58. *Bridgeport*, 410 F.3d at 799, 802.

59. For a critical discussion, see Oren Bracha, *Give Us Back Our Tragedy: Nonrivalry in Intellectual Property Law and Policy*, 19 THEORETICAL INQUIRIES L. 633, 647–48 (2018); Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1033–45 (2005).

60. Frederick Schauer, *The Tyranny of Choice and the Rulification of Standards*, 14 J. CONTEMP. LEGAL ISSUES 803, 805 (2005) (observing that “enforcers have systematically resisted standards” because of psychological resistance to unconstrained decision power).

its rejection in *VMG Salsoul*. As will be shown momentarily, while the latter rejects *Bridgeport's* doctrinal conclusion, it represents a culmination of a line of cases that are based on the same deeper assumptions underlying that decision: sound recording exceptionalism and its rejection may not be that different after all.

*B. Improper Appropriation Trivialized*

In *VMG Salsoul*,<sup>61</sup> the Ninth Circuit firmly rejected sound recording exceptionalism.<sup>62</sup> It held that the improper appropriation requirement is an essential element of the infringement test in this area as it is in regard to any other subject matter.<sup>63</sup> Seemingly this decision is a resounding victory for improper appropriation. A closer look, however, reveals that it is a Pyrrhic victory, apparent in the way the court described and then operationalized the requirement of improper appropriation.<sup>64</sup> The opinion repeatedly refers to the requirement as synonymous with a rule that “de minimis” copying is not infringement.<sup>65</sup> Moreover, the court describes this element as a “de minimis exception”<sup>66</sup> to copyright infringement. Several times, when elaborating on the meaning of de minimis in the context of copyright, the court identifies it with trivial or negligible copying.<sup>67</sup> From here, the way is short to the second troubling aspect of the decision—citing previous authority, the court observes that a “use is de minimis only if the average audience would not recognize the appropriation.”<sup>68</sup> Its analysis of the case at hand hinges on this criterion, finding that a “reasonable jury could not conclude that an average audience would recognize an appropriation” of the copyrighted song by the allegedly infringing one.<sup>69</sup>

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61. 824 F.3d 871, 884 (9th Cir. 2016).

62. *Id.* at 874.

63. *Id.* at 887.

64. *Id.* at 880–81.

65. *Id.* at 874, 877–78.

66. *Id.* at 877–78, 881–83.

67. *Id.* at 876–77, 880 (“The principle that trivial copying does not constitute actionable infringement has long been a part of copyright law . . . This principle reflects the legal maxim, *de minimis non curtat lex* (often rendered as ‘the law does not concern itself with trifles.’)”) (citing *Newton v. Diamond*, 388 F.3d 1189, 1192–93 (9th Cir. 2004)).

68. *Id.* at 878 (citing *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2004)) (emphasis added) (explaining that a use will be considered de minimis *only if* an average audience would not determine that there has been appropriation).

69. *Id.* at 879.

*VMG Salsoul* erects, then, a two-pillar edifice of the improper appropriation requirement: (1) copying of protected subject matter does not constitute improper appropriation *if and only if* it is so trivial as to be de minimis, and (2) copying is de minimis *if and only if* the ordinary members of the audience would not recognize the copying at all.<sup>70</sup>

Each of these propositions may, at first, appear eminently reasonable. However, the structure they create forms a much more radical challenge to improper appropriation than that posed by the Sixth Circuit. *Bridgeport* is rooted in sound recording exceptionalism embodied in the assumption that recorded sounds are governed by special infringement rules.<sup>71</sup> *VMG Salsoul* is founded on a universal view of copyright.<sup>72</sup> Its premise is that the same infringement principles apply equally to all subject matter.<sup>73</sup> Consequently, *Bridgeport* eliminated improper appropriation in an important but limited area, leaving it untouched elsewhere. *VMG Salsoul* hastened to save improper appropriation in this limited area, only to eviscerate it across the entire spectrum of creative expression.<sup>74</sup> It envisions a feeble version of the requirement, which is rooted in a misunderstanding of the doctrine and its purpose. If allowed to take root, this misunderstanding risks perpetuating a new maxim, far worse than that of *Bridgeport*: get a license or never copy anything recognizable!

Substantiating these assertions requires explaining the purpose and policy underlying the improper appropriation requirement. Before turning to that, however, it is important to understand that *VMG Salsoul* is anything but a rogue decision. Rather, it is a culmination of a long process in which many decisions developed the concept of de minimis within copyright law.

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70. *Id.* at 881.

71. *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 800 (6th Cir. 2005).

72. *VMG Salsoul, LLC*, 824 F.3d at 885.

73. *Id.* (“[E]ven accepting the premise that sound recording differs qualitatively from other copyrighted works and therefore *could warrant* a different infringement rule, that theoretical difference does not mean that Congress *actually adopted* a different rule.”).

74. *Id.* at 881–83.

C. *The Strange Copyright Career of De Minimis*

De minimis is a principle with deep roots in equity and common law that applies across doctrinal fields.<sup>75</sup> While there are debates over the scope and the exact details of this doctrine,<sup>76</sup> its core is clear. It is captured by the maxim *de minimis non curat lex*, which is commonly translated as “the law does not concern itself with trifles.”<sup>77</sup> Under this principle, courts refuse to find that a legal norm is violated when such violation is trivial or of negligible harm—even if technically the relevant conduct does violate the norm.<sup>78</sup> At its core, this principle is about the administration of justice. Its rationale is that in cases where the cost of judicial enforcement radically outweighs its benefit, society is better off if the right is not enforced.<sup>79</sup> Thus understood, de minimis is a safety valve that operates in extreme and rare cases. It corrects on the margin, an unfortunate side-effect of the generality of legal rules: the fact that in a small subset of cases that fall within the ambit of such rules the cost of enforcement so overwhelmingly outweighs its benefit that enforcing the rules will be clearly detrimental. In line with this logic, courts that apply the de minimis doctrine consider the relationship between the small magnitude of the harm involved with a particular violation and the cost of enforcement, as well as other factors that may bear on whether enforcing is extremely undesirable.<sup>80</sup>

American copyright law has had a complex relationship with this general concept of de minimis. In this area, courts used what was

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75. See, e.g., Andrew Inesi, *A Theory of De Minimis and a Proposal for Its Application in Copyright*, 21 BERKELEY TECH. L.J. 945, 948–49 (2006); see also Frederick G. McKean, Jr., *De Minimis Non Curat Lex*, 75 U. PA. L. REV. 429, 429–30 (1927); Jeff Nemerofsky, *What is a “Trifle” Anyway?*, 37 GONZ. L. REV. 315, 322–24 (2002); Max L. Veech & Charles R. Moon, *De Minimis Non Curat Lex*, 45 MICH. L. REV. 537, 537–44 (1947).

76. See generally Nemerofsky, *supra* note 75, at 316 (describing the different translations from commentators and courts).

77. Inesi, *supra* note 75, at 947–48.

78. Nemerofsky, *supra* note 75, at 323–24.

79. *City of Bozeman v. Vaniman*, 898 P.2d 1208, 1211 (Mont. 1995) (“When a legal matter is termed ‘de minimus,’[sic] it means that courts need not consider it because the matter is ‘trifling’ or too minor to be considered in the interest of judicial economy.”); *Schlichtman v. N.J. Highway Auth.*, 579 A.2d 1275, 1279 (N.J. Super. Ct. Law Div. 1990) (stating that de minimis is required to protect the court and defendants “against expensive and mischievous litigation about trifling matters which, in consequence of the insignificance of the amount involved, would do the parties themselves more harm than good” (quoting *Kelaher v. English*, 50 A. 902, 902 (N.J. Ch. 1901))); see also Inesi, *supra* note 75, at 957.

80. See Inesi, *supra* note 75, at 951–56 and the cases cited therein.

already an elusive concept in different ways and endowed it with varying meanings. The result is an elaborate and confusing tangle that must be untangled. Two caveats are essential at the outset. First, the analysis here focuses on the use of the concept of de minimis in the context of copyright's infringement test. It leaves aside the use of the concept in numerous other copyright contexts such as originality<sup>81</sup> or as part of the fair use analysis.<sup>82</sup> Second, the use of the concept of de minimis within copyright decisions has often been opaque, cryptic or even incoherent. As a result, often it is simply impossible to pin down with certainty the exact meaning of the concept being invoked. Nevertheless, when one examines the large body of judicial decisions that employ the de minimis concept as part of the analysis of copyright infringement, clear patterns emerge.

The dominant use of the term de minimis has been as a label that refers to the improper appropriation requirement. In this usage it is not the general technical meaning of de minimis that is invoked, but rather the very different standard of the copyright infringement test.<sup>83</sup> In another set of cases, courts occasionally used de minimis in its proper sense, refusing to enforce copyright in circumstances where the harm was extremely trivial.<sup>84</sup> A third category is formed by cases that began to appear around the 1990s where courts obscured the boundaries between the first two meanings. In these decisions, the term de minimis was associated with copyright's improper appropriation infringement test, but elements from de minimis proper

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81. See, e.g., *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363 (1991); *Garcia v. Google, Inc.*, 743 F.3d 1258, 1265 (9th Cir. 2014); *McIntyre v. Double-A Music Corp.*, 166 F. Supp. 681, 683 (S.D. Cal. 1958).

82. See, e.g., *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 n.34 (1984); *L.A. Times v. Free Republic*, No. CV 98-7840, 2000 WL 565200, \*18-19 (C.D. Cal. Apr. 4, 2000); *Hustler Magazine, Inc. v. Moral Majority, Inc.*, 606 F. Supp. 1526, 1531 (C.D. Cal. 1985); *Williams & Wilkins Co. v. United States*, 487 F.2d 1345, 1377 (Ct. Cl. 1973). But see *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70, 75-76 (2d Cir. 1997) (opining that the concept of de minimis is "an inappropriate one to be enlisted in fair use analysis").

83. *Hoffman v. Le Traunik*, 209 F. 375, 379 (N.D.N.Y. 1913).

84. See, e.g., *Knickerbocker Toy Co. v. Azrak-Hamway Int'l, Inc.*, 668 F.2d 699, 702-03 (2d Cir. 1982) (declining to find infringement where production of the allegedly infringing item was stopped soon after the initiation of production and no actual orders for the product had been taken); *Toulmin v. Rike-Kumler Co.*, 316 F.2d 232, 232 (6th Cir. 1963).

were read into this test.<sup>85</sup> The result of this usage has been an erosion of the infringement test that culminated in its complete reduction to a narrow *de minimis* exception. In other words, within this third category, copyright's improper appropriation requirement became *de minimis* proper and nothing more.

1. *De minimis as a label for improper appropriation*

*De minimis* first appeared in American copyright law in 1847 as a hardly noticeable sideshow.<sup>86</sup> The concept began to trickle into copyright opinions once again in the early twentieth century.<sup>87</sup> The typical use in this period—and the dominant one for many decades to come—was a loose invocation of the term *de minimis*, not in its general technical sense, but as a reference to the standard copyright infringement test. By this time, the modern test of copyright infringement had consolidated. Under this new test, copyright infringement was no longer limited to verbatim or colorable copies as in earlier times, but extended to cases where the defendant's work fell short of this high degree of identity but was still substantially similar to the original.<sup>88</sup> Courts sometimes invoked the term "*de minimis*" simply as synonymous with this substantial similarity test.<sup>89</sup> Representative of this usage is one court's observation that infringement "is not confined to literal repetition or reproduction but includes also the various modes in which the matter of any work may be adopted, imitated, transferred, or reproduced" with the critical qualification that "on the principle of *de minimis non curat lex*, it is necessary that a substantial part

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85. *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2004) (explaining the usage of the term *de minimis* in connection to the substantial similarity test, but still attempting to address the test in the context of its technical definition).

86. In *Webb v. Powers*, the court cited a master in chancery report that briefly employed the concept in its traditional sense to reject one aspect of a copyright infringement claim. 29 F. Cas. 511, 513 n.2 (C.C.D. Mass. 1847) (No. 17,323).

87. There is other sporadic use of the term *de minimis* in copyright cases of the period that has little bearing on the infringement test. See, e.g., *Ginn & Co. v. Apollo Publ'g Co.*, 215 F. 772, 778 (E.D. Pa. 1914); *Hartford Printing Co. v. Hartford Directory & Printing Co.*, 148 F. 470, 473 (C.C.D. Conn. 1906); *Henry Bill Publ'g Co. v. Smythe*, 27 F. 914, 928 (C.C.S.D. Ohio 1886).

88. See *infra* notes 164–76 and accompanying text.

89. *Newton*, 388 F.3d at 1193 (examining the relationship between the *de minimis* and substantial similarity standards, pointing out that "[t]o say that a use is *de minimis* because no audience would recognize the appropriation is thus to say that the use is not sufficiently significant").

of the copyrighted work be taken.”<sup>90</sup> De minimis is not used here in its technical sense, namely as a rare exception that applies in extreme cases where the triviality of the harm is radically disproportionate to the cost of enforcement. The term is simply used as a synonym for “no substantial similarity” to invoke the general infringement test and its requirement that to infringe the copying must be of such a nature and extent that it crosses the normative threshold of prohibited taking.

Courts continued to use the term de minimis simply to refer to the standard substantial similarity test.<sup>91</sup> Overwhelmingly, this usage happened in cases of fragmented literal similarity, meaning instances where short fragments of the copying work bear intense similarity to fragments of the original work.<sup>92</sup> The typical case of this kind involved a defendant’s multi-page text using a few sentences nearly identical to those appearing in plaintiff’s multi-page work.<sup>93</sup> Another category of cases involved closely similar reproduction of an entire work with the alleged lack of similarity manifesting in other dimensions of the use such as its brief duration or the level of visibility within defendant’s work. A paradigmatic example here is a copyrighted poster that appears in a motion picture or a television program for a very brief duration, simply as part of the background scenery and with no particular focus on it either visually or as part of the narrative.<sup>94</sup>

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90. *Hoffman v. Le Traunik*, 209 F. 375, 379 (N.D.N.Y. 1913).

91. *See, e.g., Mathews Conveyer Co. v. Palmer-Bee Co.*, 135 F.2d 73, 85 (6th Cir. 1943); *Williams Prods., Inc. v. Constr. Gaskets, Inc.*, No. 6-71616, 1977 WL 22704, at \*3 (E.D. Mich. Dec. 2, 1977); *Rexnord, Inc. v. Modern Handling Sys., Inc.*, 379 F. Supp. 1190, 1194 (D. Del. 1974); *Markham v. A. E. Borden Co.*, 108 F. Supp. 695, 707 (D. Mass. 1952), *rev’d*, 206 F.2d 199 (1st Cir. 1953); *Shapiro, Bernstein & Co. v. P. F. Collier & Son Co.*, No. 65-3, 1934 WL 25419, at \*3 (S.D.N.Y. July 26, 1934); *M. Witmark & Sons v. Pastime Amusement Co.*, 298 F. 470, 476 (E.D.S.C. 1924), *aff’d*, 2 F.2d 1020 (4th Cir. 1924).

92. *See NIMMER & NIMMER, supra* note 1, § 13.03[A][2] (defining fragmented literal similarity as similarity which is literal but not comprehensive).

93. *See Henry Holt & Co. v. Liggett & Myers Tobacco Co.*, 23 F. Supp. 302, 304 (E.D. Pa. 1938) (rejecting a motion to dismiss based on the claim that defendant’s pamphlet copying three sentences from plaintiff’s book was de minimis).

94. *See Gordon v. Nextel Commc’ns*, 345 F.3d 922, 923–24 (6th Cir. 2003) (finding that the use of plaintiff’s illustration in a television commercial “does not rise to the level of actionable copying” because the “illustration is never in focus and appears only as distant background”); *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 218 (2d Cir. 1998) (finding that the de minimis threshold was not crossed where defendant’s film displayed plaintiff’s photographs in poor lighting, out of focus, and at a great distance); *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70, 77 (2d Cir. 1997) (finding that the de minimis threshold for infringement was crossed where defendant’s TV program displayed plaintiff’s poster-quilt nine short times); *Gottlieb*

While not all cases fell into these patterns,<sup>95</sup> it is not surprising that the dominant use of the term *de minimis* as a synonym for the substantial similarity test occurred in cases of close verbatim similarity. Given a high degree of literal similarity of some expressive content of two works, triviality—the core connotation of “*de minimis*”—must have frequently appeared as the natural way of describing dissimilarity along other dimensions, such as quantity, duration or visibility, that could still cause the use to fall short of the infringement bar.<sup>96</sup> Notwithstanding the use of the term and the typical settings in which it tended to occur, courts simply used “*de minimis*” in these cases as synonymous with the general improper appropriation requirement.

## 2. *De minimis proper*

In another, smaller group of copyright cases, courts used the term *de minimis* quite differently by invoking its technical sense. Occasionally, that is, courts found that whether or not a particular use technically amounted to copyright infringement, the magnitude of the harm was so miniscule that it was justified not to enforce the copyright owner’s right.<sup>97</sup> For example, in *Toulmin v. Rike-Kumler Co.*,<sup>98</sup> the court refused to find that a use of a sentence and a half from a copyrighted book infringed copyright.<sup>99</sup> The district court cryptically fused together indistinguishably lack of substantial similarity, *de minimis*

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*Dev. LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625, 631 (S.D.N.Y. 2008) (finding that the *de minimis* threshold was not crossed where defendant’s film displayed plaintiff’s copyrighted pinball machine in the background of a scene sporadically and for less than a few seconds at a time).

95. *See, e.g.*, *Bauer v. Yellen*, 548 F. Supp. 2d 88, 95–96 (S.D.N.Y. 2008) (granting defendant’s motion for summary judgment partially because plaintiff could not demonstrate that the defendant copied more than a *de minimis* amount of the plaintiff’s work, where the plaintiff’s and defendant’s screen plays had similar—although not identical—themes); *Compaq Comput. Corp. v. Ergonome, Inc.*, 137 F. Supp. 2d 768, 779 (S.D. Tex. 2001) (relating *de minimis* to substantial similarity where defendant had taken the arrangement of facts relating to proper keyboard use from plaintiff’s book and reincorporated them into its own reading material).

96. *See Ringgold*, 126 F.3d at 74–75 (defining this meaning of *de minimis* as “a technical violation of a right so trivial that the law will not impose legal consequences” and distinguishing it from the substantial similarity inquiry).

97. *See, e.g.*, *Knickerbocker Toy Co. v. Azrak–Hamway Int’l, Inc.*, 668 F.2d 699, 703 (2d Cir. 1982); *Toulmin v. Rike-Kumler Co.*, 316 F.2d 232, 232 (6th Cir. 1963).

98. 316 F.2d 232 (6th Cir. 1963).

99. *Id.* at 232.

proper, and fair use.<sup>100</sup> But the short upholding opinion by the Sixth Circuit was based more clearly on a *de minimis* proper. In its opinion, the court emphasized not only the tiny amount of text copied, but also that fact that defendant's book had been out of print for thirty years "with no plans or intentions at any time to [be] republish[ed] or reprint[ed]" and agreed that "this was a clear case of *de minimis*."<sup>101</sup> Another clearer example of the use of *de minimis* proper is a court's refusal to find infringing a copy of a toy car illustration on a blister card packaging.<sup>102</sup> Although the illustration was very close—perhaps identical—to the original, the court found that it was a temporary "office copy" used only to position the art work on defendant's packaging with intention to use a completely different illustration on the actual packaging released to the public.<sup>103</sup> The court of appeals agreed that this use "falls squarely within the principle of *de minimis non curat lex*" and upheld the dismissal of the relevant claim.<sup>104</sup> Plainly, the issue in this case was not the lack of substantial similarity, but simply the trivial magnitude of the harm that did not justify enforcement.<sup>105</sup>

Although scholars expressed different opinions about the desirability of a *de minimis* proper exception in copyright,<sup>106</sup> some courts clearly recognized and applied such a rule.<sup>107</sup> Not surprisingly, in some

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100. *Toulmin v. Rike-Kumler Co.*, No. 2442, 1962 WL 8784, at \*3 (S.D. Ohio June 30, 1962), *aff'd*, 316 F.2d 232, 232 (6th Cir. 1963).

101. 316 F.2d at 232.

102. *Knickerbocker Toy Co.*, 668 F.2d at 702.

103. *Id.* at 703.

104. *Id.*

105. *Id.*

106. Compare *NIMMER & NIMMER*, *supra* note 1, § 8.01[G] (arguing that *de minimis* defense "should be limited largely to its role in determining either substantial similarity or fair use" and not be used as an independent ground for negating infringement), with Pierre N. Leval, *Nimmer Lecture: Fair Use Rescued*, 44 UCLA L. REV. 1449, 1457–58 (1997) (describing various personal uses as immunized by the doctrine of *de minimis non curat lex* "that is of great importance to a proper understanding of the law of copyright").

107. See *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 916 (2d Cir. 1994) (stating in dicta that *de minimis* proper might apply to photocopying by an individual of copyrighted materials for personal use); *Mihalek Corp. v. Michigan*, No. 92-1641, 1993 WL 460787, at \*3 (6th Cir. Nov. 9, 1993) (*per curiam*) (applying *de minimis* proper where defendant's harm due to photocopying of his work was small); *Design Data Corp. v. Unigate Enter., Inc.*, 63 F. Supp. 3d 1062, 1069–70 (N.D. Cal. 2014) (finding that downloading but never installing software is a *de minimis* violation); *Repp v. Webber*, 914 F. Supp. 80, 84 (S.D.N.Y. 1996) (discussing *de minimis* proper, but finding that it did not apply to defendant's small scale sales); *Nat'l Enquirer, Inc.*

decisions it is not clear whether the term is used to denote *de minimis* proper or as a synonym for the substantial similarity test.<sup>108</sup> Practically, there is some overlap between the two realms. Many circumstances that give rise to *de minimis* proper, such as use of a particularly minuscule and insignificant fraction of the copyrighted work, are also likely to bar satisfaction of the substantial similarity test.<sup>109</sup> But the overlap is only partial. There are cases of *de minimis* proper where substantial similarity is present and many uses that cannot escape as *de minimis* proper but do not constitute substantial similarity. As long as courts did not restrict the substantial similarity test to the confines of *de minimis* proper, their occasional failure to clearly distinguish the two was of limited concern. Yet in a relatively recent line of decisions, this boundary was crossed. Such decisions did not simply fail to draw a crisp line between *de minimis* proper and substantial similarity, but increasingly reduced the latter to the former.<sup>110</sup>

### 3. *Down the slippery slope*

Around the early 1990s, some decisions began to fuse the two meanings of *de minimis*—invoking elements of *de minimis* proper reasoning but implanting them within the substantial similarity analysis. This trend originated in a footnote. In *Fisher v. Dees*,<sup>111</sup> the Ninth Circuit, in a few lines deeply buried in a footnote, dismissed the defendant's argument that the borrowing in his parodic version of

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v. News Grp. News, Ltd., 670 F. Supp. 962, 970 (S.D. Fla. 1987) (considering but refusing to apply *de minimis* proper).

108. See, e.g., *Mathews Conveyer Co. v. Palmer-Bee Co.*, 135 F.2d 73, 85 (6th Cir. 1943) (stating the rule as “[o]n the principle of *de minimis non curat lex*, it is necessary that a substantial part of the copyrighted work be taken” and finding no infringement because the injury to plaintiff was “obviously infinitesimal”); *La. Contractors Licensing Serv., Inc. v. Am. Contractors Exam Servs., Inc.*, 13 F. Supp. 3d 547, 552 (M.D. La. 2014), *aff'd*, 594 F. App'x 243, 243–44 (5th Cir. 2015) (*per curiam*) (explaining that the *de minimis* doctrine provides that if the unauthorized copying is sufficiently trivial the law will not impose legal consequences, but simultaneously relating *de minimis* to the substantial similarity requirement); *Straus v. DVC Worldwide, Inc.*, 484 F. Supp. 2d 620, 639 (S.D. Tex. 2007) (referring to three meanings of *de minimis* and explaining substantial similarity but then proceeding to apply *de minimis* proper analysis based on the small magnitude and harm of unauthorized use).

109. See, e.g., *La. Contractors Licensing Serv., Inc.*, 13 F. Supp. 3d at 552–53 (finding that the sampling of a six second rendition of three notes from a song was *de minimis*).

110. See, e.g., *Fisher v. Dees*, 794 F.2d 432, 435, 440 (9th Cir. 1986) (holding that a comedic parody was legal).

111. 794 F.2d 432 (9th Cir. 1986).

plaintiff's song did not infringe on account of being *de minimis*.<sup>112</sup> It observed that "a taking is considered *de minimis* only if it is so meager and fragmentary that the average audience would not recognize the appropriation."<sup>113</sup> The court was clearly, if somewhat distractedly, applying the substantial similarity test for infringement.<sup>114</sup> But in doing so, it read into it the emphasis of *de minimis* proper on triviality by insisting that only meager and fragmentary copying could escape.<sup>115</sup> To add to the confusion, the court associated such extremely trivial copying with unrecognizability by the audience.<sup>116</sup> The audience reaction criterion had long been part and parcel of the most dominant substantial similarity test, often phrased as turning on the question of whether a lay member of the work's target audience would find the original and copying works substantially similar.<sup>117</sup> In the *Fisher* footnote, the court introduced a subtle but critical change to this formula, now asking whether the audience would not recognize the taking at all. This injected into the substantial similarity test a version of *de minimis* proper's focus on extreme triviality dressed in the familiar garments of the audience reaction. The result was a new hybrid form of analysis: the substantial similarity test read as a rare exception for trivial unrecognizable takings.<sup>118</sup>

In 1994, one district court demonstrated how *Fisher's* footnote could be the basis of a new mutant form of the substantial similarity test.<sup>119</sup> The court, in granting summary judgment on a claim for infringement for use of certain materials from a commercial brochure, quoted

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112. *Id.* at 434 n.2.

113. *Id.*

114. *Id.* at 438.

115. *Id.* at 434 n.2.

116. *Id.*

117. *See, e.g.,* *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 409 F.2d 1315, 1316 (2d Cir. 1969) (per curiam) ("The ultimate test in a copyright infringement case . . . is whether an average lay observer would find a substantial similarity in the designs."); *Ideal Toy Corp. v. Fab-Lu Ltd. (Inc.)*, 360 F.2d 1021, 1022 (2d Cir. 1966) ("[T]he appropriate test for determining whether substantial similarity is present is whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work."); *Arnstein v. Broad. Music, Inc.*, 137 F.2d 410, 412 (2d Cir. 1943) (explaining that the test for substantial similarity is not based on a technical or expert analysis of the works and instead should be evaluated from the perspective of a layperson).

118. *See infra* notes 124–127 and accompanying text (examining the development of a narrow exception to the traditional analytical framework).

119. *Epic Metals Corp. v. CONDEC, Inc.*, 867 F. Supp. 1009, 1013 (M.D. Fla. 1994).

*Fisher's* formula of de minimis as unrecognizability and found that defendant's brochure was "substantially similar to the plaintiff's" because "an average person would recognize the appropriation."<sup>120</sup> The court was clearly engaged in analysis of the substantial similarity requirement. It read the requirement, however, as a narrow exception for trivial taking and following *Fisher* limited such exempted trivial copying to cases where the copied material is completely unrecognizable.<sup>121</sup>

A similar drift between the two meanings of de minimis occurred more subtly in a line of Second Circuit cases. Even *Ringgold v. Black Entertainment Television, Inc.*,<sup>122</sup> a decision that drew a very clear analytic distinction between de minimis proper and de minimis as a label for improper appropriation, exhibited this tendency.<sup>123</sup> When applying the substantial similarity test, the *Ringgold* court observed that a display of a pictorial work in a film might fall short of this bar if it involves such a distance and poor focus that "a typical program viewer would not discern any decorative effect that the work of art contributes to the set."<sup>124</sup> This sounded much like saying that the substantial similarity requirement is not met only when the use of the original in defendant's work was extremely trivial, and indeed bordering on the unrecognizable. A year later, a different Second Circuit decision read *Ringgold's* construal of substantial similarity exactly as a narrow exception for extreme trivialities, letting the defendant escape only because plaintiff's photographs used in his film were "virtually unidentifiable."<sup>125</sup>

In the same year, yet another decision from the same court—*Castle Rock Entertainment v. Carol Publishing Group, Inc.*<sup>126</sup>—dealt with a claim that a book containing trivia quizzes about the television show *Seinfeld* infringed the copyright in the show.<sup>127</sup> The court found that "[b]ecause 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

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120. *Id.*

121. *Id.*

122. 126 F.3d 70 (2d Cir. 1997).

123. *Id.* at 75 (examining the divide between traditional and modern tests for de minimis usage).

124. *See id.* at 77 (discussing the clarity and significance of the usage of a copyrighted material).

125. *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 218 (2d Cir. 1998).

126. 150 F.3d 132 (2d Cir. 1998).

127. *See id.* at 135 (examining the qualitative/quantitative test for similarity).

quantitative/qualitative approach are not particularly helpful to our analysis.”<sup>128</sup> The quantitative/qualitative test referred to was the court’s reading of *Ringgold*, according to which substantial similarity “requires that the copying [be] quantitatively *and* qualitatively sufficient to support the legal conclusion that infringement (*actionable* copying) has occurred.”<sup>129</sup> Critically, the relevant threshold for both the quantitative (i.e. the amount taken) and the qualitative (i.e. the taking of protectable subject matter) sides was described as taking “more than ‘*de minimis*.’”<sup>130</sup> Buried in the technicalities of the quantitative/qualitative test was a fundamental move: reducing the domain of no substantial similarity to cases of exceptional trivial taking.<sup>131</sup>

Both *Ringgold* and *Castle Rock* can be read as limited in scope. One could read them not as equating substantial similarity with trivial, *de minimis* copying in general, but doing so only in regard to the subset of cases with which they dealt: inter-genre copying in *Castle Rock*<sup>132</sup> and instances where the only claim of lack of similarity is based on poor observability or short duration in *Ringgold*.<sup>133</sup> These decisions laid the basis, however, for a general understanding of the substantial similarity test as a limited exception for trivial taking. In the 2003 case *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*,<sup>134</sup> involving overall similar patterns of two rugs rather than literal copying of a small portion, the Second Circuit stated its understanding of the *Castle Rock* quantitative/qualitative test as the general criterion for substantial similarity.<sup>135</sup> Copying amounted to substantial similarity, the court noted, whenever it is established “(i) that it was protected expression in the earlier work that was copied and (ii) that the amount that was copied is ‘more than *de minimis*.’”<sup>136</sup> The opinion in *Tufenkian* was a traditional analysis of the substantial similarity test which was not applied by the court as a narrow exception.<sup>137</sup> Analytically, however, the decision supplied the remaining step required for reducing the test

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128. *Id.* at 139.

129. *Id.* at 138 (quoting *Ringgold*, 126 F.3d at 75).

130. *Id.*

131. *Id.* at 137.

132. *Id.*

133. 126 F.3d at 73, 75.

134. 338 F.3d 127 (2d Cir. 2003).

135. *Id.* at 131.

136. *Id.*

137. *Id.*

exactly to such an exception: *Castle Rock* construed de minimis as exempting only extremely trivial takings; *Tufenkian* installed de minimis as the general criterion for substantial similarity applicable in all cases.

The 2000s saw an increase of decisions that applied the terminology of de minimis to the substantial similarity test. Many of these decisions avoided reducing the test to a narrow exception, while others remained ambiguous on this point.<sup>138</sup> But other decisions embodied exactly such reduction of the infringement test to a de minimis exception.<sup>139</sup> An important landmark is the 2003 decision in *Newton v. Diamond*.<sup>140</sup> The majority found that a sampling of a six-second, three-note segment of defendant's song did not infringe the copyright in the musical composition because it was de minimis and thus fell short of the substantial similarity bar.<sup>141</sup> The analysis brought together many of the previous precedents to create a framework that clearly equated the substantial similarity requirement with a de minimis exception.<sup>142</sup> *Ringgold* was cited for the propositions that substantial similarity means only that "trivial copying does not constitute actionable infringement" and that "[t]his principle reflects the legal maxim, *de minimis non curat[ur] lex*."<sup>143</sup> The *Fisher* footnote now became "[a] leading case on de minimis infringement," standing for the proposition that "a use is de

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138. See, e.g., *Situation Mgmt. Sys., Inc. v. ASP Consulting LLC*, 560 F.3d 53, 58 (1st Cir. 2009) (using the term de minimis as a label for traditional substantial similarity analysis); *La. Contractors Licensing Serv., Inc. v. Am. Contractors Exam Servs., Inc.*, 13 F. Supp. 3d 547, 551–52 (M.D. La. 2014); *TufAmerica, Inc. v. Diamond*, 968 F. Supp. 2d 588, 596–99 (S.D.N.Y. 2013); *Poindexter v. EMI Record Grp. Inc.*, No. 11 Civ. 559(LTS) (JLC), 2012 WL 1027639, at \*4 (S.D.N.Y. Mar. 27, 2012); *Allen v. Scholastic Inc.*, 739 F. Supp. 2d 642, 654 (S.D.N.Y. 2011) (also using the term de minimis as a label for traditional substantial similarity analysis); *Lewinson v. Henry Holt & Co.*, 659 F. Supp. 2d 547, 564, 573 (S.D.N.Y. 2009) (also using the term de minimis as a label for traditional substantial similarity analysis); *Bauer v. Yellen*, 548 F. Supp. 2d 88, 93 (S.D.N.Y. 2008).

139. See *Williams v. Bridgeport Music, Inc.*, No. LA CV13-06004 JAK(AGRx), 2015 WL 4479500, at \*21 n.14 (C.D. Cal. July 14, 2015); *Danjaq, LLC v. Universal City Studios, LLC*, No. CV 14-02527 SJO(Ex), 2014 WL 7882071, at \*4 (C.D. Cal. Oct. 2, 2014); *Pryor v. Warner/Chappell Music, Inc.*, No. CV 13-04344 RSWL (AJWx), 2014 WL 2812309, at \*5 (C.D. Cal. June 20, 2014); *Gottlieb Dev. LLC v. Paramount Pictures Corp.*, 590 F. Supp. 2d 625, 631–34 (S.D.N.Y. 2008); *Silberman v. Innovation Luggage, Inc.*, No. 01 Civ. 7109(GEL), 2003 WL 1787123, at \*8 (S.D.N.Y. Apr. 3, 2003) (analyzing substantial similarity as de minimis judged by recognizability); *Compaq Comput. Corp. v. Ergonome, Inc.*, 137 F. Supp. 2d 768, 778–79 (S.D. Tex. 2001).

140. 388 F.3d 1189 (9th Cir. 2004).

141. *Id.* at 1193–96.

142. *Id.* at 1193–94.

143. *Id.* at 1193.

minimis only if the average audience would not recognize the appropriation.”<sup>144</sup> The two-pillar structure that would be repeated in *VMG Salsoul*<sup>145</sup> was complete: (1) substantial similarity is merely an exception for de minimis copying of an extremely trivial nature; and (2) such de minimis copying occurs only when the taking is completely unrecognizable by the target audience. Improper appropriation was now dwarfed into a rare de minimis exception. This understanding of the improper appropriation requirement as an exception for unrecognizable minor copying is not the only one in the case law.<sup>146</sup> But it is now firmly located within the main stream and gaining in dominance and influence.<sup>147</sup> What if anything is wrong with this?

## II. WHAT IMPROPER APPROPRIATION SHOULD BE

To evaluate the trend of reducing the improper appropriation requirement to a de minimis exception, this Part first explains the function of this requirement as it was consolidated at its late nineteenth century origin. Next, this Part explains how the function of improper appropriation serves relevant copyright policies. Having done so, the Part answers the question: does the de minimis version of this doctrine allow it to properly serve its function in light of underlying policies and the context of cultural creativity that copyright law regulates?

### A. Origin

Improper appropriation appeared as part of the fundamental transformation of copyright law in the second half of the nineteenth century. Following the traditional English approach, early American

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144. *Id.*

145. *See supra* notes 65–69.

146. *See supra* note 139 and accompanying text.

147. *Id.* There is also a growing trend in legal scholarship to confuse or blur the line between improper appropriation and a de minimis exception for trivial copying. *See, e.g.,* PATRY, *supra* note 24, § 9.60 (discussing the de minimis doctrine and the requirement of substantial similarity together); 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) (observing that “[t]he doctrine of substantial similarity is a natural extension of the doctrine of *de minimis non curat lex*”); Thomas W. Joo, *Remix Without Romance*, 44 CONN. L. REV. 415, 439 (2011) (equating “de minimis copying” with lack of substantial similarity); Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 J. COPYRIGHT SOC’Y U.S.A. 719, 720 (2010) (describing improper appropriation as a “de minimis doctrine” whose purpose is “to avoid flooding the courts with trivial infringement cases”).

copyright's scope was narrow. The organizing concept was that of the "copy."<sup>148</sup> Traditionally understood as the publisher's right to reprint a text, the core of copyright was seen as the right to reproduce in print an exact copy of a text.<sup>149</sup> The courts also recognized a thin penumbra of protection against reproduction with only colorable or evasive changes.<sup>150</sup> There were two interlocking implications to this approach. First, many secondary uses of copyrighted works such as abridgments or translations were seen as meritorious works of authorship in their own right and were allowed as long as they did not cross the line of evasive reproduction.<sup>151</sup> Second, infringement in general was defined on a low level of abstraction and was limited to concrete levels of textual similarity between works.<sup>152</sup>

This traditional approach to "copy-right" came under pressure beginning in the 1830s and increasingly lost ground after the Civil War.<sup>153</sup> The leading commentator of the time, Eaton Drone, observed in his 1870 treatise, "The definition that a copy is a literal transcript of the language of the original finds no place in the jurisprudence with which we are concerned."<sup>154</sup> He defined the scope of copyright instead as controlled by the question of "whether the substance of the work is taken without authority"<sup>155</sup> and insisted, "That which constitutes the

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148. See *Stowe v. Thomas*, 23 F. Cas. 201, 202, 207 (C.C.E.D. Pa. 1853) (No. 13,514) (observing that "the author's exclusive property in a literary composition or his copyright, consists only in a right to multiply copies of his book"). See generally OREN BRACHA, *OWNING IDEAS: THE INTELLECTUAL ORIGINS OF AMERICAN INTELLECTUAL PROPERTY, 1790–1909* 125 (2016) (discussing the development of the right of copying in early American history).

149. BRACHA, *supra* note 148, at 126.

150. See *Stowe*, 23 F. Cas. at 207 (discussing protections against reproduction for translations). See generally BRACHA, *supra* note 148, at 147 (examining the traditional role of copyrights).

151. See GEORGE TICKNOR CURTIS, *A TREATISE ON THE LAW OF COPYRIGHT* 265 (1847) (describing the traditional rule that allowed good faith abridgments and calling for its revision); *Stowe*, 23 F. Cas. at 206; *Story v. Holcombe*, 23 F. Cas. 171, 172 (C.C.D. Ohio 1847) (No. 13,497). See generally BENJAMIN KAPLAN, *AN UNHURRIED VIEW OF COPYRIGHT* 10 (1967) (discussing the traditional roles of copying, such as translations and abridgement).

152. See, e.g., *Blunt v. Patten*, 3 F. Cas. 762, 765 (C.C.S.D.N.Y. 1828) (No. 1,579).

153. BRACHA, *supra* note 148, at 150–51, 160–65; KAPLAN, *supra* note 151, at 32.

154. EATON S. DRONE, *A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES* 451 (1879).

155. *Id.* at 385.

essence and value of literary composition . . . may be capable of expression in more than one form of language different from that of the original.”<sup>156</sup>

This conceptual shift was embodied in significant doctrinal changes. The permissive approach to secondary uses was replaced by a more protective attitude. At first, this shift happened mostly through statutory amendments that began to extend copyright to cover various uses such as dramatization or translation.<sup>157</sup> Courts, for their part, gradually restated the infringement test and began to apply it in a way that captured increasingly abstract levels of expressive similarity, previously seen as outside copyright’s ambit.<sup>158</sup>

This is where substantial similarity enters the picture. The infringement analysis slowly shifted from having a strong focus on verbatim copying to encompassing increasingly remote levels of similarity.<sup>159</sup> The standard formula for capturing this change emphasized that infringement occurred even in the absence of verbatim copying as long as the two works were substantially similar.<sup>160</sup> In one famous example of this trend, a court found that a dramatic scene involving a person tied to railroad tracks infringed the copyright in a play despite marked differences in the text and other expressive aspects.<sup>161</sup> One contemporary observer described the decision as the first recognition of “the doctrine of romantic equivalents.”<sup>162</sup>

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156. *Id.* at 451.

157. See Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212.

158. See *Simms v. Stanton*, 75 F. 6, 9–10 (C.C.N.D. Cal. 1896); *Gilmore v. Anderson*, 38 F. 846, 849 (C.C.S.D.N.Y. 1889); *Lawrence v. Dana*, 15 F. Cas. 26, 58 (C.C.D. Mass. 1869) (No. 8,136); *Emerson v. Davies*, 8 F. Cas. 615, 620 (C.C.D. Mass. 1845) (No. 4,436). See generally BRACHA, *supra* note 148, at 160–61, 163, 165 (discussing the development of the modern text examining expressive similarity).

159. See *supra* notes 137–38 and accompanying cases.

160. See *Perris v. Hexamer*, 99 U.S. 674, 676 (1878) (explaining that to infringe “a substantial copy of the whole or of a material part must be produced”); *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926) (observing that “infringement of copyright is judicially held to consist in the copying of some substantial and material part”); *Eggers v. Sun Sales Corp.*, 263 F. 373, 375 (2d Cir. 1920) (observing that “infringement consists in the copying of some substantial and material part” of a work); *Maxwell v. Goodwin*, 93 F. 665, 666 (C.C.N.D. Ill. 1899); *Simms*, 75 F. at 10 (determining that a copyright is infringed when the labors “of the original author are, to a material degree, appropriated”).

161. *Daly v. Palmer*, 6 F. Cas. 1132, 1133 (C.C.S.D.N.Y. 1868) (No. 3,552).

162. T.W. Clarke, *Copyright*, 3 AM. L. REV. 453, 453 (1868). Clarke, who represented the defendant in this case, analogized the decision’s expansion of copyright’s scope to the doctrine of equivalents in patent law, which allows courts to find infringement even when the accused device is not completely identical to the patented invention. *Id.*

The concept of substantial similarity played a dual role in this transformation of copyright. Substantial similarity was the doctrinal heart of the expansion process. Replacing the organizing concept of a literal copy with a focus on the flexible and porous criterion of substantial similarity between works allowed courts to expand the scope of copyright.<sup>163</sup> This form of analysis was based on the assumption that an identical intellectual essence could underlie many concrete expressive forms.<sup>164</sup> At the same time, substantial similarity became a new boundary-setting mechanism. When the concept of the copy declined, its limiting effect on the scope of copyright was also swept away.<sup>165</sup> Copyright's scope, however, did not become boundless. New boundary-setting mechanisms were gradually developed to replace the old ones.<sup>166</sup> Some of these were the fair use doctrine,<sup>167</sup> the idea/expression dichotomy that denied protection to abstract ideas,<sup>168</sup> and other rules such as the denial of copyright protection to functional systems and procedures.<sup>169</sup>

The most important new scope-regulating doctrine was substantial similarity. While copyright now extended to any substantially similar copying, it extended only as long as the copying was substantially similar.<sup>170</sup> Courts used this requirement to shield cases of borrowing from copyrighted works resulting in attenuated or abstract levels of similarity.<sup>171</sup> In 1878, the Supreme Court captured this duality of the function of the new concept of substantial similarity.<sup>172</sup> To infringe

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163. See *supra* note 157 and accompanying text.

164. BRACHA, *supra* note 148, at 160; DRONE, *supra* note 154, at 451.

165. See KAPLAN, *supra* note 151, at 32.

166. See *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2004).

167. The American fair use doctrine is usually traced to the case of *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841) (No. 4,901). Its roots extend much further back, however, to eighteenth century English case law. See Matthew Sag, *The Prehistory of Fair Use*, 76 BROOK. L. REV. 1371, 1373 (2011).

168. See *Holmes v. Hurst*, 174 U.S. 82, 86 (1899); *London v. Biograph Co.*, 231 F. 696, 698–99 (2d Cir. 1916); *Eichel v. Marcin*, 241 F. 404, 408 (S.D.N.Y. 1913).

169. See *Baker v. Selden*, 101 U.S. 99, 100–01 (1879). See generally Pamela Samuelson, *The Story of Baker v. Selden: Sharpening the Distinction Between Authorship and Invention (Copyright)*, in INTELLECTUAL PROPERTY STORIES 159, 180–92 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2006) (discussing *Baker v. Selden* and its influence on American copyright law).

170. *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, 345 F.3d 1140, 1143–44 (9th Cir. 2003).

171. See, e.g., *Perris v. Hexamer*, 99 U.S. 674, 675–76 (1878); *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926); *Maxwell v. Goodwin*, 93 F. 665, 666–67 (C.C.N.D. Ill. 1899).

172. *Perris*, 99 U.S. at 675–76.

copyright, it said, “a substantial copy of the whole or of a material part must be produced.”<sup>173</sup> This formula, while still containing a residue of the traditional copy concept, no longer limited the scope of copyright to exact or evasive literal reproduction.<sup>174</sup> At the same time, however, it used substantial similarity to draw boundaries around this expanded scope.<sup>175</sup> The decision found that a map of Philadelphia that used a system of signs identical to that of the plaintiff’s map of New York was not substantially similar and therefore non-infringing.<sup>176</sup>

Substantial similarity was eventually consolidated and formalized as a central element of copyright’s infringement test: improper appropriation. The 1946 Second Circuit decision in *Arnstein v. Porter*<sup>177</sup> became the canonical statement of the test.<sup>178</sup> *Arnstein* erected the basic structure of the modern infringement test by sharply distinguishing its two elements: (1) actual copying from the copyrighted work and (2) that the copying “went so far as to constitute improper appropriation.”<sup>179</sup> There are several key components to this test.

First, by sharply distinguishing actual copying from improper appropriation and making the occurrence of both a necessary condition for infringement, the test makes it crystal clear that some copying is allowed. As the *Arnstein* opinion put it, “there can be ‘permissible copying.’”<sup>180</sup> Furthermore, as later courts clarified, some copying is allowed even of otherwise protectable subject matter.<sup>181</sup> Put

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173. *Id.* at 676.

174. *Id.* at 675–76.

175. *Id.* at 676.

176. *Id.* at 675–76.

177. 154 F.2d 464 (2d Cir. 1946).

178. *Id.* at 468. See generally Shyamkrishna Balganesh, *The Questionable Origins of the Copyright Infringement Analysis*, 68 STAN. L. REV. 791, 791 (2016) (discussing the “*Arnstein* test” and arguing that copyright jurisprudence should reconsider the extent of its reliance on the test).

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

180. *Id.* at 472.

181. Modern courts tend to incorporate this principle into the improper appropriation test by stating that the substantial similarity required must be to protectable elements of the copyrighted work. See *Johnson v. Gordon*, 409 F.3d 12, 19 (1st Cir. 2005) (observing that an impression of substantial similarity that “flows from similarities as to elements that are not themselves copyrightable” is insufficient); see also *Rogers v. Koons*, 960 F.2d 301, 308 (2d Cir. 1992) (stating that the focus of the substantial similarity inquiry “must be on the similarity of the *expression* of an idea or fact, not on the similarity of the facts, ideas or concepts themselves”). Saying that the substantial

differently, improper appropriation shields from liability some copying quite distinctly from other doctrines that deny copyright protection to ideas, facts, stock elements (*scènes à faire*), and other aspects of expressive works.

Second, while the decision designates both elements as questions of fact, it is beyond doubt that the second element involves a normative inquiry. The court described the relevant question as whether the copying is “illicit” and whether “defendant wrongfully appropriated something which belongs to the plaintiff.”<sup>182</sup> In other words, within the improper appropriation element, substantial similarity is not simply a question of ontological identity of expressions. Rather, it is a normative inquiry about prohibited or permissible taking and as such necessarily implicates a normative metric for evaluation.

Third, *Arnstein* adopted the use in previous case law of the audience perspective as the relevant vantage point from which to conduct the normative inquiry.<sup>183</sup> The owner’s protected interest is in financial returns from his potential audience. Therefore, the relevant question is “whether defendant took from plaintiff’s works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such popular music is composed” as to cross the normative line separating permissible and impermissible appropriation.<sup>184</sup>

In the decades following *Arnstein*, all circuit courts developed similar infringement tests that incorporated the improper appropriation criterion.<sup>185</sup> These tests diverged in various respects, but all of them embodied the same fundamental principles as the test crafted in *Arnstein*: some copying of protectable material from a copyrighted work is allowed; the question of when there is enough substantial similarity so that the threshold of improper appropriation had been

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similarity must be of protectable elements is tantamount to recognizing that copying of protectable elements is allowed when such copied elements are not similar enough.

182. *Arnstein*, 154 F.2d at 472–73.

183. See *Dymow v. Bolton*, 11 F.2d 690, 692 (2d Cir. 1926) (observing that copyright “is made for plain people” and that “copying which is infringement must be something ‘which ordinary observation would cause to be recognized as having been taken from’ the work of another”).

184. *Arnstein*, 154 F.2d at 473.

185. See Balganes, *supra* note 178, at 794 (observing that “[w]hile a few circuits have made important modifications to its central approach, the ‘*Arnstein* test,’ as it has come to be known, remains the dominant approach to copyright infringement analysis today”). For a survey of the approaches in the different circuits, see PATRY, *supra* note 24, §§ 9.120–9.211.

crossed is a normative inquiry; and this normative inquiry incorporates the presumed reaction or experience of the relevant target audience.<sup>186</sup>

It is this structure that defined the function of the improper appropriation doctrine in modern copyright. Far from a rare exception for extreme trivialities, the requirement came to operate at the very heart of modern copyright. It became a central device for limiting and tuning the scope of copyright. And this tuning function was explicitly recognized as normative, meaning, as playing a central role in making sure that copyright serves its underlying purpose. In other words, improper appropriation became one of copyright's main policy levers.<sup>187</sup>

### *B. Improper Appropriation as a Policy Lever*

If improper appropriation is a central policy lever in modern copyright, what exactly is the policy being served by its boundary-setting function? Put differently, what is wrong with copyright whose scope encompasses any copying from a protected work, subject perhaps only to rare exceptions in extreme cases? And what useful purpose is served by a doctrinal lever that allows courts to limit the scope of copyright as a matter of routine, thereby permitting various uses of materials taken from copyrighted works? The answers to these questions necessarily depend on a normative framework. While scholars suggested various normative accounts of the improper appropriation requirement,<sup>188</sup> my focus here is on consequence-

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186. See, e.g., *Dawson v. Hinshaw Music Inc.*, 905 F.2d 731, 735–36 (4th Cir. 1990) (holding that the ordinary observer test “must adopt the perspective of the works’ intended audience” and discussing the examples of other circuits making similar adjustments in their own application of the test).

187. By “policy lever,” I mean a legal doctrine whose adjustment and varying application in specific cases is used by courts and other legal actors to make sure that the results produced by legal rules track their underlying policy purposes.

188. See Wendy J. Gordon, *The Concept of “Harm” in Copyright*, in *INTELLECTUAL PROPERTY AND THE COMMON LAW* 452, 453 (Shyamkrishna Balganesh ed., 2013) (analyzing substantial similarity as a prerequisite for showing harm, which is of great importance for both libertarian and liberal normative approaches); Shyamkrishna Balganesh, *The Normativity of Copying in Copyright Law*, 62 *DUKE L.J.* 203, 210 (2012) (arguing that the substantial similarity requirement has a two-step structure that allows combining utilitarian and personality-based normative considerations without having to be traded-off directly); Pamela Samuelson, *A Fresh Look at Tests for Nonliteral Copyright Infringement*, 107 *Nw. U. L. REV.* 1821, 1845–47 (2013) (analyzing substantial similarity in terms of utilitarian incentives).

oriented accounts of copyright.<sup>189</sup> Specifically, this Section examines the rationale of improper appropriation from two consequence-oriented perspectives: economic efficiency as the dominant variant of welfarism, and a cluster of normative theories focused on a richer concept of human welfare and its components, including self-determination and human flourishing.

### 1. *Efficiency*

From the perspective of economic efficiency, copyright is a delicate balancing act designed to maximize total social effective preferences in the area of cultural expression.<sup>190</sup> Legal rights that create limited exclusivity in expressive works provide a mechanism for solving the problem of insufficient incentive for producing such works. The difficulty in excluding others from using and reproducing expressive works, combined with the gap between the cost of creating cultural works and copying them, may lead to the inability of creators to internalize enough of their works' value to ensure sufficient incentives for their creation.<sup>191</sup> Where alternative methods<sup>192</sup> are unlikely to provide sufficient returns to creators, and other forms of governmental or social support for creation seem undesirable,<sup>193</sup> intellectual property rights allow creators to legally exclude others from certain uses of their

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189. See generally Oren Bracha & Talha Syed, *Beyond Efficiency: Consequence-Sensitive Theories of Copyright*, 29 BERKELEY TECH. L.J. 229, 244–47 (2014) (comparing economic and other consequence-based theories of copyright).

190. The focus on maximizing effective preferences is what distinguishes efficiency from other welfarist theories. Effective preferences are measured in willingness and ability to pay and are assumed to be fungible and commensurable both in regard to specific individuals and across individuals.

191. Oren Bracha & Talha Syed, *Beyond the Incentive-Access Paradigm? Product Differentiation & Copyright Revisited*, 92 TEX. L. REV. 1841, 1849 (2014).

192. These methods may include, for example, first mover advantages, pre-commitments by purchasers, norms and sanctions among publishers or other players, and non-exclusionary ways of monetizing works, such as live performances or bundled services. For a classic discussion, see Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281, 290–91 (1970).

193. These other methods may include: governmental subsidies or tax benefits, governmental prizes, governmental production, or support from private patrons. For discussion of such alternatives, see WILLIAM W. FISHER III, PROMISES TO KEEP: TECHNOLOGY, LAW, AND THE FUTURE OF ENTERTAINMENT 200–01 (2004); Daniel J. Hemel & Lisa Larrimore Ouellette, *Beyond the Patents-Prizes Debate*, 92 TEX. L. REV. 303, 317–26 (2013); Amy Kapczynski, *The Cost of Price: Why and How to Get Beyond Intellectual Property Internalism*, 59 UCLA L. REV. 970, 983 (2012).

works and thereby gain a measure of pricing power. This ensures incentive to create. Exclusionary rights come, however, with inevitable costs, the most important of which is an inefficient denial of access to the work both for those who want to consume it (static cost)<sup>194</sup> and for those who want to use it to create new works (dynamic cost).<sup>195</sup> Copyright law and policy attempt to strike a satisfactory balance between the property right's incentive benefit and its access cost. In a general copyright regime, this incentive/access balance operates across different works: at any alternative level of copyright, some works receive more protection than necessary to incent their creation, thereby entailing unnecessary access cost, while others receive insufficient protection and therefore are not created at all.<sup>196</sup> Copyright's Holy Grail is finding a satisfactory balance point where robust incentives for creation are provided for an acceptable access cost.

From this perspective, the bulk of copyright law and policy revolves around marginal adjustments. The ideal here is to include within copyright specific legal arrangements that are likely to provide substantial incentives at relative low cost, and exclude from it those with a low incentive effect for a high cost.<sup>197</sup> Three main dimensions stand out among the numerous ways of pursuing this goal: duration, scope, and breadth. Duration refers to a copyright's term, and scope refers to the activities and uses that are covered by copyright.<sup>198</sup> In regard to both dimensions, at a certain point additional increments of protection result in an unattractive incentive/access ratio that demarcates the outer limits of copyright. This accounts for copyright's limited duration<sup>199</sup> and for the fact

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194. This is often referred to as "deadweight loss." See, e.g., William W. Fisher III, *Reconstructing the Fair Use Doctrine*, 101 HARV. L. REV. 1659, 1702 (1988) (observing that "consumers who value the work at more than its marginal cost but less than its monopoly price will not buy it," resulting in deadweight loss); Glynn S. Lunney, Jr., *Reexamining Copyright's Incentives-Access Paradigm*, 49 VAND. L. REV. 483, 497–98 (1996) (discussing deadweight loss).

195. Mark A. Lemley, *The Economics of Improvement in Intellectual Property Law*, 75 TEX. L. REV. 989, 997–98 (1997) (discussing copyright's dynamic cost).

196. See Bracha & Syed, *supra* note 191, at 1854–56 (analyzing the intellectual property supramarginal-inframarginal tradeoff).

197. Fisher, *supra* note 194, at 1703.

198. See 17 U.S.C. §§ 106, 302 (2012).

199. See § 302 (defining copyright's limited duration).

that many aspects and uses of works, such as the copying of facts<sup>200</sup> or private performances,<sup>201</sup> are not within copyright's scope.

The same analysis applies to the breadth dimension. Breadth refers to the level of similarity between the copyrighted and the copying work.<sup>202</sup> And just as in the case of duration and scope, increasing breadth entails a marginally declining incentive/access ratio. At some point, protection against copying on remote levels of similarity generates such a low level of incentive relative to its substantial access cost that it becomes inefficient on balance.

On the incentive side, there are two distinct reasons for this. First, expanded breadth has decreasing incentive returns. The more remote the level of similarity, the less danger the copying poses to the primary markets of the work and the less value can the copyright owner extract from licensing.<sup>203</sup> The ability to exclude verbatim reproduction of a novel, for example, allows the copyright owner to internalize much more value than the ability to exclude others from borrowing on a diffused and general level two of the novel's characters. On the margin everything matters, but the point is that it matters less. The more remote and obscure the level of similarity, the less likely it is that copyright would make the difference in incenting the creation of a particular work. Second, there is substantial correlation between the need to control remote-similarity uses as the marginal factor in incenting the creation of a work and the net social value of that work. If the fixed cost of producing a work cannot be recouped by internalizing the value from primary markets and requires extraction

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200. See § 102(b) (delineating categories of uncopyrightable subject matter).

201. See § 106(4) (creating an exclusive entitlement only with respect to public performances).

202. Christopher S. Yoo, *Copyright and Product Differentiation*, 79 N.Y.U. L. REV. 212, 265 (2004). Other scholars use the term "thickness" to describe this dimension of copyright protection. See Balganesch, *supra* note 188, at 207–08; Lydia Pallas Loren, *The Pope's Copyright? Aligning Incentives with Reality by Using Creative Motivation to Shape Copyright Protection*, 69 LA. L. REV. 1, 30 (2008).

203. The distinction between breadth and scope is important here. In some cases, uses that are different than that of the original work may generate much value, sometimes even more than that of the work's core market. Consider, for example, a novel whose licensing for motion picture adaptation generates royalties higher than the proceeds from book sales. This example, however, goes to the copyright's scope. It would be rarer for a work to generate high income from remote similarity uses. In our example, income is likely to drop in both the book and motion pictures markets from uses of expressive materials from the novel as remote and dissimilar borrowing.

of the decreasing value from more remote uses, this is usually a good indication that the net social value of the work (i.e. the gap between the cost of creating it and its social value) is low. To be sure, there may be exceptions, but as a general guidance this principle holds.<sup>204</sup>

As for the access side, the cost of copyright keeps accumulating as breadth is expanded.<sup>205</sup> It is mainly the dynamic cost—copyright’s drag on future creation—that is relevant here. The reason is that the creative process is cumulative. New creation often relies in various ways on using and incorporating preexisting expressive materials. The further copyright reaches to implicate such uses, the more it burdens creation, and licensing transactions are bound to be an imperfect remedy to this problem.<sup>206</sup> As copyright breadth expands, more possibilities for use of preexisting materials are excluded and an increasing number of avenues for creation are shut off. Protection on increasingly remote levels of similarity escalates this cost. Typically, as the used expressive elements become more remote, the value attributable to them in the secondary work—as opposed to the second creator’s contribution in adapting, reworking, and combining the materials—declines. This increases the likelihood that transaction costs will frustrate the possibility of licensing. Publishers often license a translation of a novel. But it is significantly less feasible for licensing to occur for one character in a different novel that is loosely based on the original one. In addition, even when licensing does occur, transaction costs, in terms of having to scour works for potentially infringing materials and then “clearing rights,” are increased as breadth expands, thus increasing this form of waste.<sup>207</sup>

In sum, increasing breadth of copyright has marginally decreasing incentive returns and marginally constant or even increasing access cost. Improper appropriation is the main legal doctrine that tracks copyright’s breadth dimension.<sup>208</sup> Its main function is to allow courts

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204. See Bracha & Syed, *supra* note 191, at 1878.

205. *Id.* at 1861, 1864.

206. See Lemley, *supra* note 195, at 1048–67 (discussing complications in bargaining over intellectual property rights that prevent private transactions from adequately solving the problem of these rights placing a burden on innovation).

207. 17 U.S.C. § 101 (2012); Lemley, *supra* note 195, at 997–98.

208. Other important doctrines that serve this purpose are the idea/expression dichotomy, *scènes à faire*, and fair use. Under the modern understanding, the idea/expression dichotomy permits copying of materials on high levels of abstraction. See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122–23 (2d Cir. 1930). *Scènes à faire* permits the use of stock elements which are deemed indispensable or very

to draw the boundary between copying on a sufficiently concrete and substantial level, and borrowing whose inclusion within copyright's exclusionary power is likely to cause more harm than good.<sup>209</sup> Substantial similarity is thus copyright's main check on its dynamic cost, or in simpler terms, it is the main doctrinal safeguard against copyright becoming a drag on the creative innovation it was meant to promote.

This framework helps endow the otherwise somewhat mysterious substantial similarity criterion with tractable content. Understood this way, the test is not about some unmoored notion of ontological similarity between expressive works. The expressive content of the two works has to be compared in light of the overarching purpose of the doctrine: assessing whether the use of expressive materials from the original, if allowed, is likely to significantly erode creative incentives, or if its inclusion within copyright's ambit would generate little incentive relative to its cost on further creation.

## 2. *Beyond efficiency*

Welfarism and its subset of efficiency are not the only consequence-oriented normative frameworks of copyright.<sup>210</sup> Three other theories are worth mentioning here.

The first is *self-determination* whose lodestar is the ability of individuals to reflectively form and revise their own concept of the good and effectively pursue a life-plan for its realization.<sup>211</sup> Copyright as a regulation of expression is of importance here for two reasons: it may affect an individual's life plans inherently connected to the cultural expressive sphere;<sup>212</sup> and it shapes the expressive sphere in ways that affect the ability of individuals to critically form, evaluate, and revise

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common within a genre. See *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 50 (2d Cir. 1986). Fair use is discussed in Section III.B.

209. See Lunney, *supra* note 194, at 504, 506.

210. See Bracha & Syed, *supra* note 189, at 249–57.

211. See generally GERALD DWORKIN, *THE THEORY AND PRACTICE OF AUTONOMY* 101, 112 (1988); JOSEPH RAZ, *THE MORALITY OF FREEDOM* 207–09 (1986) (discussing self-determination). On self-determination as applied to copyright, see Yochai Benkler, *Siren Songs and Amish Children: Autonomy, Information, and Law*, 76 N.Y.U. L. REV. 23, 50–54, 110–13 (2001); Bracha & Syed, *supra* note 189, at 250–51.

212. See Benkler, *supra* note 211, at 54 (identifying a “concern with information about the range—both quantitative and qualitative—of options open to all or to some subset of individuals in society”).

their choices and to have a variety of genuinely different alternatives from which to choose.<sup>213</sup>

The second theory is *cultural democracy*, which is an extension of self-determination to the social-cultural sphere.<sup>214</sup> The premise here is of a two-way relationship between individuals and culture—the semiotic realm of the social processes for generating, communicating and interpreting meaning and symbols. Culture constitutes individual subjectivity by shaping concepts, beliefs, values, and preferences. Yet individuals, rather than being merely passive captives of culture, have the capacity to interact with culture, revise, and reshape it. In this sense, culture is a mechanism of collective self-determination. It is the realm where individual subjectivity and preferences are forged collectively. To preserve individual self-determination within such an inherently collective “governance” process, two conditions must obtain.<sup>215</sup> First, the prerequisites for individual self-determination must apply to the collective process of cultural meaning-making, which means that individuals must have effective agency and genuine choice in regard to their own exposure to culture.<sup>216</sup> Second, and more radically, cultural meaning-making as a process of collective decision making must be decentralized in the sense of allowing all individuals opportunity to participate in it on a roughly equal basis.<sup>217</sup> Copyright is of interest from this perspective because it obviously affects both of these conditions for cultural self-determination.

The third theory, *human flourishing*, while incorporating self-determination’s commitment to robust processes of individual and collective free choice also moves beyond it and specifies certain features of a substantive vision of the good as applied to the cultural sphere.<sup>218</sup> While different versions of this theory specify somewhat

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213. Bracha & Syed, *supra* note 189, at 252.

214. *Id.* at 253–56. For works in this vein, see generally Jack M. Balkin, *Digital Speech and Democratic Culture: A Theory of Freedom of Expression for the Information Society*, 79 N.Y.U. L. REV. 1, 6 (2004); Rosemary J. Coombe, *Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue*, 69 TEX. L. REV. 1853, 1857–58 (1991); Niva Elkin-Koren, *Cyberlaw and Social Change: A Democratic Approach to Copyright Law in Cyberspace*, 14 CARDOZO ARTS & ENT. L.J. 215 (1996).

215. Bracha & Syed, *supra* note 189, at 255.

216. *Id.* at 254–56; see RAZ, *supra* note 211, at 208.

217. Bracha & Syed, *supra* note 189, at 256.

218. *Id.* at 256–58. For works in this vein, see generally Fisher, *supra* note 194, at 1748–52; Oren Bracha, *Standing Copyright on Its Head? The Googlization of Everything and*

different substantive features, many of these features tend to fall into two common categories. The first is “meaningful activity,” meaning human activity that significantly engages one’s physical or cognitive capacities and involves challenge and discipline.<sup>219</sup> The second is “sociality,” meaning relations and activities whose character and meaning is established communally through interaction with others with such affiliations and collaborations being both intrinsically valuable and partially constitutive of individuals.<sup>220</sup> Copyright as a regulation of expression shapes the extent to which robust opportunities are available to individuals in regard to both of these dimensions.

Most important is a fundamental feature common to all three theories: a normative yardstick that includes elements distinct from and prior to the summation of subjective, individual welfare effects.<sup>221</sup> Each of the three theories successively adds an additional element that is placed higher on the normative hierarchy relative to subjective individual preferences: the prerequisites for self-determination; effective equal power to affect collective self-determination processes; and the substantive dimensions of the good life. This is the direct connection to the topic at hand because these prioritized normative elements lead all three theories, each for its own reasons, to place a normative premium on a robust freedom to engage in certain secondary uses of expressive works.<sup>222</sup> The upshot is that such a robust freedom to re-appropriate works in certain ways is valued independently of its effect on social welfare, indeed, in a way that is normatively prior and superior to such effect. Put differently, in

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*the Many Faces of Property*, 85 TEX. L. REV. 1799, 1842–49 (2007); William W. Fisher III, *The Implications for Law of User Innovation*, 94 MINN. L. REV. 1417, 1463–72 (2010).

219. Bracha & Syed, *supra* note 189, at 256–57.

220. *Id.* at 257.

221. *Id.* at 251–57.

222. *Id.* at 258–66. Each of the three theories has somewhat different reasons for this position, which may lead to divergence on which secondary uses are favored and to what extent. What all three have in common, however, is favoring of some freedom to engage in secondary uses beyond that mandated by the strict calculus of subjective welfare due to some higher-order normative concern. For self-determination, the higher-order concern at work here is twofold: fostering uses that are essential for the diverse and robust expressive sphere, which is a precondition for self-determination and facilitating individuals’ central life choices. Cultural democracy adds a concern for the equal distribution of robust expressive opportunities among all members of society. Human flourishing, for its part, imputes a higher normative value to secondary expressive uses which are germane to various forms of two central dimensions of the good life: meaningful activity and sociality.

certain cases, self-determination, cultural democracy, and human flourishing are likely to support a strong freedom to re-appropriate expressive works, even when the calculus of subjective social welfare does not or is inconclusive. This is not to say that these theories are indifferent to copyright's incentive/access tradeoff. It does mean that the tradeoff in these cases applies to the normatively prioritized feature, such as the structural conditions of self-determination, which may very well generate results more favorable to freedom to use than the calculus of welfare.<sup>223</sup>

As in the case of efficiency, improper appropriation functions as a doctrinal lever for achieving the purposes of the modified incentive/access balance that follows from each of the three theories. Its purpose is to identify those cases where freedom to appropriate is required not just to maximize welfare, but under one of the higher-priority features of the relevant normative framework and place them outside copyright's ambit.

### 3. *Creativity and appropriation*

Once improper appropriation's normative function is unpacked, it becomes easy to see how different it is from that of *de minimis*, both in basic logic and scope. *De minimis* is a tool for minor, marginal corrections.<sup>224</sup> As applied to copyright infringement, it assumes that on the primary normative level, the relevant secondary use is properly within the right's scope.<sup>225</sup> As a secondary consideration, in rare cases, the cost of enforcing against such a use would significantly outweigh its benefit. *De minimis* is a safety valve that allows an escape route in these exceptional cases. The logic dictated by it is comparing the cost of enforcement proceedings to the substantive benefit served by it.<sup>226</sup> Improper appropriation as informed by the above normative theories is fundamentally different. It operates as a mechanism for demarcating

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223. Bracha & Syed, *supra* note 189, at 314 (observing that consequence-sensitive theories of copyright face an incentive/access tradeoff homologous to that of efficiency but these theories do not "collapse into efficiency").

224. See *On Davis v. Gap, Inc.*, 246 F.3d 152, 173 (2d Cir. 2001) (noting that "[t]rivial copying is a significant part of modern life" and "but for the *de minimis* doctrine," most honest citizens would frequently engage in trivial copying); *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 217 (2d Cir. 1998) (referring to *de minimis* as copying "so trivial 'as to fall below the quantitative threshold of substantial similarity'").

225. See *Sandoval*, 147 F.3d at 217.

226. See *supra* note 224.

the boundaries of the right. Inquiring whether a particular use is properly within copyright's scope on the primary normative level is the very purpose of the doctrine.<sup>227</sup> Accordingly, improper appropriation must be applied not as a rare exception but as a policy lever central to copyright's purpose. Its role is to regularly weigh whether particular secondary uses properly fall within copyright's ambit and thus maintain a constant drawing and patrolling of copyright's boundaries.

At this point, one may wonder why such a constant patrolling of copyright's borders is necessary. Why is it important to allow people a robust degree of freedom to re-appropriate expressive materials from copyrighted works? To answer this question, some unpacking of the above cryptic observation that the creative process is cumulative is necessary.<sup>228</sup> It is widely recognized that creativity does not occur *ex nihilo*. To create something one always has, to one degree or another, to use preexisting expressive materials. As Justice Story observed in one of the earliest American copyright opinions: "Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before. No man creates a new language for himself."<sup>229</sup> This cumulative nature of the creative process has been documented in numerous contexts.<sup>230</sup>

Creativity often consists not in a completely new contribution but exactly in transforming, rearranging, or shedding new light on the

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227. See Lemley, *supra* note 147, at 720.

228. See *supra* note 206 and accompanying text.

229. Emerson v. Davies, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436).

230. See generally Olufunmilayo B. Arewa, *Copyright and Borrowing*, in 1 INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE 33, 33, 40–41 (Peter K. Yu ed., 2007); JULIE E. COHEN, CONFIGURING THE NETWORKED SELF: LAW, CODE, AND THE PLAY OF EVERYDAY PRACTICE 61–62, 65–66, 71, 74, 76, 80–81 (2012); CARYS J. CRAIG, COPYRIGHT, COMMUNICATION AND CULTURE: TOWARDS A RELATIONAL THEORY OF COPYRIGHT LAW 11–16 (2011); GIANCARLO F. FROSIO, RECONCILING COPYRIGHT WITH CUMULATIVE CREATIVITY: THE THIRD PARADIGM 15, 18–21 (2018); LAWRENCE LESSIG, FREE CULTURE: HOW BIG MEDIA USES TECHNOLOGY AND THE LAW TO LOCK DOWN CULTURE AND CONTROL CREATIVITY 18–19, 46 (2004); Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 966–67 (1990). For studies of the cumulative character of creation in specific contexts see, e.g., JAMES BOYLE & JENNIFER JENKINS, THEFT! A HISTORY OF MUSIC (2017); Olufunmilayo B. Arewa, *From J.C. Bach to Hip Hop: Musical Borrowing, Copyright and Cultural Context*, 84 N.C. L. REV. 547, 561–62, 566–71, 577, 586 (2006); Giancarlo F. Frosio, *A History of Aesthetics from Homer to Digital Mash-Ups: Cumulative Creativity and the Demise of Copyright Exclusivity*, 9 LAW & HUMAN. 262, 262–64, 266 (2015); Cathay Y.N. Smith, *Beware the Slender Man: Intellectual Property and internet Folklore*, 70 FLA. L. REV. (forthcoming 2018), <https://ssrn.com/abstract=3005668>.

meaning of existing materials. Nor is the question of whether any borrowed material is recognizable the touchstone of creativity. Alice Randall's novel, *The Wind Done Gone*, is no less creative because it retells events from *Gone with the Wind* from the point of view of a slave including many recognizable elements.<sup>231</sup> Arguably, much of its creativity derives exactly from the juxtaposition of the recognizable with a radically different perspective. All of this is particularly true in our digital remix culture,<sup>232</sup> where the means for appropriative creativity from mashups to fanfiction are widely available, and “glomming on” to dominant cultural materials is a common creative strategy.<sup>233</sup>

While examples could extend over many pages, one case involving the improper appropriation requirement is demonstrative. In *Warner Bros. Inc. v. American Broadcasting Cos.*,<sup>234</sup> the character of Ralph Hinkley in the television show “The Greatest American Hero” was claimed to infringe the copyright in the character of Superman.<sup>235</sup> Given the concept of the show as “what happens when you [the average person] become Superman,”<sup>236</sup> it is unsurprising that Hinkley had many traits reminiscent or evocative of Superman. Essentially, however, Hinkley—an ordinary school teacher who is thrown reluctantly into a superhero status, and uses his powers clumsily due to the loss of the instruction book—is the antithesis of Superman.<sup>237</sup> Finding the characters

231. See MARGARET MITCHELL, *GONE WITH THE WIND* (1964); ALICE RANDALL, *THE WIND DONE GONE* (2002); see also *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1266–67, 1273, 1276 (11th Cir. 2001) (vacating an injunction against publication of *THE WIND DONE GONE* because plaintiff would be unlikely to overcome defendant's fair use defense).

232. See LAWRENCE LESSIG, *REMIX: MAKING ART AND COMMERCE THRIVE IN THE HYBRID ECONOMY* 14–15, 56 (2008); KEMBREW MCLEOD & PETER C. DiCOLA, *CREATIVE LICENSE: THE LAW AND CULTURE OF DIGITAL SAMPLING* 36–41 (2011) (explaining the “sound collage,” sampling, and other music borrowing techniques in light of the development of sound reproduction technology); Fisher, *supra* note 218, at 1418–22 (discussing users' creative appropriation of cultural goods in the digital age); Peter S. Menell, *Adapting Copyright for the Mashup Generation*, 164 U. PA. L. REV. 441, 446–58 (2016) (exploring music mashups); Rebecca Tushnet, *Legal Fictions: Copyright, Fan Fiction, and a New Common Law*, 17 LOY. L.A. ENT. L.J. 651, 653–66 (1997) (discussing fan fiction).

233. See Balkin, *supra* note 214, at 10–11 (expanding on “glomming on” as a creative strategy in the internet age based on appropriating dominant cultural materials and using them as a platform for innovation).

234. 720 F.2d 231 (2d Cir. 1983).

235. *Id.* at 235.

236. *Id.* at 236.

237. *Id.*

“profoundly different,” the court ruled there was lack of substantial similarity and concluded that: “In the genre of superheroes, Hinkley follows Superman as, in the genre of detectives, Inspector Clouseau follows Sherlock Holmes.”<sup>238</sup> As for clearly recognizable lines from the Superman saga, the court found that these were used “not to create a similarity with the Superman works, but to highlight the differences.”<sup>239</sup> In short, the creativity of “The Greatest American Hero” consisted exactly in borrowing central elements of the Superman character, including some that were easily recognizable, and rearranging them to create a new and substantially different work. As the court’s ruling recognized, it was exactly the kind of appropriative creativity that improper appropriation—as opposed to a *de minimis* exception—is meant to place outside of copyright’s bounds.<sup>240</sup>

Thus, valuable cultural creativity often relies on borrowing preexisting materials including in ways that make such materials recognizable to the audience. Recognizability is often the pivot of creativity rather than its antithesis. A robust freedom to create requires a robust freedom to creatively appropriate. And if copyright extended to such appropriative creativity by covering any recognizable borrowing it would impose a significant dynamic cost on creativity. This heavy burden on future creativity would “purchase” a diminishing incentive benefit,<sup>241</sup> making such expansive copyright unattractive on balance from the point of view of any of the normative frameworks discussed here.<sup>242</sup> Improper appropriation is copyright’s main instrument for avoiding this unfortunate outcome by managing the scope of the property right to ensure that it does not become an impediment for the creative process it was meant to promote.

### III. IMPROPER APPROPRIATION IN ITS DOCTRINAL ENVIRONMENT

The policy purpose underlying improper appropriation makes it clear that the doctrine should be a robust mechanism for regulating copyright’s boundary rather than a *de minimis* exception. Yet much of the hostility to the requirement is framed not so much as a matter

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238. *Id.* at 243.

239. *Id.* at 244.

240. *Id.* at 247.

241. *See supra* notes 203–204 and accompanying text.

242. *See* Lemley, *supra* note 195, at 996–98.

of abstract normative framework, but as deriving from the way it functions as a legal doctrine. There are two main objections to a robust improper appropriation requirement as a doctrinal rule: (1) the uncertainty of the open-ended standard embodied in it and (2) its redundancy in view of the existence of the fair use doctrine. This Part responds, in turn, to each of those objections.

### A. *Blurred Lines*

Improper appropriation is often described as one of the unruliest doctrines of copyright.<sup>243</sup> In many cases, it is extremely hard to predict what outcome the broad, open-ended standard would generate. This results in uncertainty and difficulties in bargaining *ex ante* and complex and costly dispute resolutions *ex post*.<sup>244</sup> Although the sentiment is seldom expressed explicitly, one might suspect that a primary motivation for the case law's trend of eliminating or trivializing improper appropriation is hostility toward this unpredictability and a desire for greater certainty. This attitude originates in a mix of a latent absolutist conception of property, appreciation of the policy virtues of bright line rules, and a simple judicial craving for easy-to-apply rules.<sup>245</sup> Improper appropriation, this approach suggests, is a dysfunctional doctrine that should be replaced with a more predictable and less unruly norm.<sup>246</sup>

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243. See *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (noting that the test for infringement of a copyright is necessarily “vague” and determinations must be made “ad hoc”); see also Amy B. Cohen, *Masking Copyright Decisionmaking: The Meaninglessness of Substantial Similarity*, 20 U.C. DAVIS L. REV. 719, 731–32 (1987); Laura G. Lape, *The Metaphysics of the Law: Bringing Substantial Similarity down to Earth*, 98 DICK. L. REV. 181, 189–94 (1994); Lemley, *supra* note 147, at 720, 733, 738–40; Jarrod M. Mohler, Comment, *Toward a Better Understanding of Substantial Similarity in Copyright Infringement Cases*, 68 U. CIN. L. REV. 971, 988–89 (2000); Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright Law*, 125 HARV. L. REV. 683, 716–17 (2012) (“The substantial similarity test is notoriously confusing and confused, perplexing students and courts alike.”).

244. See *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 802 (6th Cir. 2005); Joseph P. Fishman, *Music as a Matter of Law*, 131 HARV. L. REV. 1861, 1904–05 (2018) (explaining the costs of unpredictability of the scope of the right in copyright by analogy to patent law).

245. See *supra* notes 50–51 and accompanying text.

246. See generally Cohen, *supra* note 243, at 720, 723, 731–32, 735, 747–48.

An ostensibly obvious starting point for assessing this objection to improper appropriation is the jurisprudence of rules and standards.<sup>247</sup> Legal norms can be rule-like by specifying outcomes on the basis of clear and easy to apply factual conditions (e.g. a speed limit of fifty miles per hour), or closer to being a standard by sketching broad, open-ended criteria that require complex and often discretionary application (e.g. a speed limit of reasonable speed in the circumstances). Rules and standards thus differ not in complexity as such, but in whether the legal norm is given specific content *ex ante* or *ex post*.<sup>248</sup> The two types of norms have typical pros and cons. Standards generate more *ex ante* uncertainty burdening both individual behavior and transacting, as well as more likelihood of disputes and cost in resolving them.<sup>249</sup> Rules, by contrast, often suffer from under and over inclusiveness: because of their rigidity, they fail to capture some cases where the underlying policy applies and capture others where it does not.<sup>250</sup>

The porous improper appropriation norm is clearly located close to the standard pole of this continuum.<sup>251</sup> And the typical pros and cons apply: the requirement generates much *ex ante* uncertainty with the attendant unfortunate side effects, but it also allows for tailoring of the application to the specific contingencies of each case and thus reduces under and over inclusiveness.<sup>252</sup> Importantly, improper appropriation operates under circumstances where the relative advantages of standards tend to overshadow those of rules. When the universe of

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247. On rules and standards, see generally Colin S. Diver, *The Optimal Precision of Administrative Rules*, 93 YALE L.J. 65, 65–66 (1983); Isaac Ehrlich & Richard A. Posner, *An Economic Analysis of Legal Rulemaking* 3 J. LEGAL STUD. 257, 258, 261 (1974); Louis Kaplow, *Rules Versus Standards: An Economic Analysis*, 42 DUKE L.J. 557, 559–60 (1992); Duncan Kennedy, *Form and Substance in Private Law Adjudication*, 89 HARV. L. REV. 1685, 1687–1700 (1976).

248. See Kaplow, *supra* note 247, at 559.

249. *Id.* at 580–84 (discussing individual behavior and law enforcement under rules and standards).

250. See Kennedy, *supra* note 247, at 1689–90. As Kaplow points out, the argument about the under- and over-inclusiveness of rules implicitly assumes that the compared rule and standard are not equal in their complexity and that the rule is simpler. See Kaplow, *supra* note 247, at 589. This assumption is not always correct. *Id.* at 593–96. As discussed in the text, however, the circumstances under which rules are likely to be more under and over-inclusive are precisely one of the important considerations in deciding which kind of norm is preferable.

251. Niva Elkin-Koren & Orit Fischman-Afori, *Rulifying Fair Use*, 59 ARIZ. L. REV. 161, 162 (2017).

252. *Id.* at 188–89.

cases governed by the norm is highly heterogonous—involving a broad variance of factors and situations relevant for the underlying policy—the significance of an ability to tailor results in application is greatest and the feasibility of crafting rules with a tolerable degree of under- and over-inclusiveness is lowest.<sup>253</sup> The set of cases governed by improper appropriation is a textbook example of intense heterogeneity. The verbal formula of “substantial similarity” may seem monolithic, but recall that what the formula stands for is a policy function: a relationship between two works’ expressive content that makes it unlikely that extension of copyright’s scope to such cases would yield desirable incentive/access effects.<sup>254</sup> The factors that affect the application of this underlying policy can hardly be reduced to one uniform set of circumstances. Indeed, it is hard to see how unidimensional rules could be formulated here with a plausible degree of accuracy.<sup>255</sup> At least, in the modern context of copyright’s broad scope.

Nevertheless, one could still object to an unpredictable standard on other grounds. The most likely objection would be the distributive effects of such a norm.<sup>256</sup> Uncertain standards often can only be effectively applied after costly disputes and litigation whose indefinite outcomes create ex ante risk.<sup>257</sup> The typical side effect is that those who can better bear the ex ante risk of uncertainty<sup>258</sup> and afford the

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253. See Kaplow, *supra* note 247, at 595 (observing that “when each instance . . . is unique in important ways, substantial ex ante analysis for each conceivable contingency would be a poor investment, whereas ex post determinations under standards are made with the knowledge that the scenario has indeed arisen”) (emphasis omitted).

254. See *supra* notes 202–208 and accompanying text.

255. Substantial similarity thus seems to be in the category of cases described by Kaplow as those where “legal commands cannot plausibly be formulated as rules,” such as in cases where a zoning ordinance precludes “aesthetically inappropriate” building designs. See Kaplow, *supra* note 247, at 599–600.

256. See *infra* note 259.

257. James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 887 (2007) (mentioning “the substantial similarity test” as a copyright doctrine that causes risk-averse parties to avoid non-infringing uses of copyrighted works by securing a license).

258. See Kaplow, *supra* note 247, at 605 (observing that when individuals are risk averse “it may be more valuable than otherwise for the cost of legal advice to be low, a factor favoring rules”).

cost of such disputes disproportionately benefit from a standard compared to those who cannot.<sup>259</sup>

This is the stock analysis of the advantages and weaknesses of improper appropriation as a broad standard. A moment's reflection would show, however, that this stock analysis is deeply misleading here. Its underlying assumption is that there is an agreed upon policy or purpose and that the question at hand is which type of legal norm would be most effective in implementing it. Yet, this is not at all the case here. As things stand now, there is no choice between a standard and a rule for serving the policy function of improper appropriation. The trend toward elimination of the requirement in the case law means that the choice is between the very imperfect traditional standard and nothing at all.<sup>260</sup> Or if the new *de minimis* version is taken to be the alternative, then the choice is between the existing standard and a rule that applies only in extreme rare cases and is based on a completely distinct purpose and therefore cannot be understood as having even a pretense of tracking the same policy. The analogy, in other words, is not to a choice between "reasonable speed" and "fifty miles per hour." The analogous case is rather: "reasonable speed" versus no speed limit, or perhaps a speed limit of "741 miles per hour" meant to avoid supersonic booms.

Understanding that the choice at hand is between the imperfect improper appropriation standard and the underlying policy purpose being left unaddressed, makes the case for the former much stronger.<sup>261</sup> The point may be brought home by considering the origins of the doctrine surveyed above.<sup>262</sup> Improper appropriation appeared in the wake of a significant expansion of copyright's breadth and scope.<sup>263</sup> It was this expansion well beyond verbatim or evasive

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259. See HANOCH DAGAN, PROPERTY: VALUES AND INSTITUTIONS 148 (2011) (arguing that vague standards often create "regressive outcomes"); Lawrence Lessig, *Re-Crafting a Public Domain*, 18 YALE J.L. & HUMAN. 56, 58 (2006) (arguing that a "free culture" requires a "lawyer free zone" because "[u]nless the freedoms of the public domain are self-authenticating, they will be unequally distributed") (internal quotations omitted).

260. In other words, this is an extreme case of the phenomenon pointed out by Kaplow of a confused comparison of a competing rule and standard which are non-equivalent. See Kaplow, *supra* note 247, at 588–89.

261. This is subject to the possibility that the policy purpose is being addressed by the fair use doctrine. As discussed below, fair use alone is insufficient to carry out this important function. See *infra* Section III.B.

262. See *supra* Section II.A.

263. See *supra* Section II.A.

reproduction that generated much of the uncertainty about what counts as infringement.<sup>264</sup> Now, a century later, the removal of the remaining modest check on copyright's breadth is motivated by concerns over this uncertainty. The uncertainty, in other words, is a result of trying to limit copyright's breadth under conditions where this breadth is very broadly defined in the first place. It is a strange remedy for this difficulty to remove altogether any check on copyright's breadth. One may respond that the preferred alternative is to abandon the entire modern framework of a very wide breadth checked by the problematic mechanism of improper appropriation. Far better to return to a much narrower breadth of verbatim reproduction surrounded by a thin penumbra.<sup>265</sup> This alternative may indeed be superior. Unfortunately, because it would require a major overhaul of entrenched modern doctrine its feasibility seems remote. And, of course, the rise of *de minimis* does not embody such a process, but rather marks the dissipation of the traditional improper appropriation check with no corresponding scaling back of copyright's breadth. The first priority is to stop this process. More ambitious reforms could be attempted after that.

Finally, the standard alternative is not an all or nothing choice. To be sure, in the existing environment of extensive breadth, an effective limiting mechanism will have to be a fairly open-ended and, therefore, uncertain standard.<sup>266</sup> But some conversion of the norm into somewhat more predictable sub-norms (i.e. "rulification") is possible in specific contexts.<sup>267</sup> A good example is Joseph Fishman's recent account of the way courts consider the element of melody in musical copyright infringement cases.<sup>268</sup> The rule often applied in these cases is that there is no improper appropriation where a copying does not involve the melody and is restricted to other musical elements.<sup>269</sup>

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264. See *supra* notes 159–169 and accompanying text.

265. See Samuelson, *supra* note 188, at 1847 (mentioning that returning to an approach that limits infringement to near-literal copying "has some normative appeal" but finding this unlikely due to the weight of precedents and statutory factors); Tushnet, *supra* note 243, at 739 (suggesting to limit the reproduction right to verbatim copying and deal with nonliteral copying under a restricted version of the derivative works right).

266. Elkin-Koren & Fischman-Afori, *supra* note 251, at 169.

267. See Schauer, *supra* note 60, at 806 (observing that "rulification of standards" is a common occurrence); see also Elkin-Koren & Fischman-Afori, *supra* note 251, at 169–71 (discussing the rulification of standards in the context of copyright).

268. See Fishman, *supra* note 244, at 1873.

269. See *supra* Section I.A.

Fishman shows that this rule has little support in musicological or audience experience considerations, but is rested on a different foundation. A hard and fast rule of “no infringement if no melody was copied” seems like a reasonable way of “rulifying” the improper appropriation standard in this area and mitigating the unfortunate side effects of its uncertainty, while still maintaining a meaningful check on copyright’s breadth.<sup>270</sup> Perhaps this is unique to music, but it may be the case that similar or other ways may be found for partial “rulification” of improper appropriation in different expressive contexts. Other adjustments or refinements either to the infringement test itself<sup>271</sup> or to its procedural aspects<sup>272</sup> are also worth considering.

In sum, the concern over the uncertainty of the improper appropriation standard is certainly not baseless. Simply abandoning the important policy function of the doctrine by trading it for a feeble *de minimis* exception, however, hardly seems an appropriate response. While an ambitious reform of copyright’s breadth and scope may be desirable and refinements of the doctrine may provide some relief in its absence, the overall attack on improper appropriation can find no support in this concern.

### B. *Improper Appropriation and Fair Use*

It is time to turn to the elephant that has been waiting patiently in the room, namely, the fair use doctrine. The fair use doctrine allows courts to find presumptively infringing uses of copyrighted works fair and therefore permissible by weighing several factors.<sup>273</sup> This doctrine has become copyright’s main mechanism for allowing certain uses that

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270. See Fishman, *supra* note 244, at 1909. To be sure, the certainty advantages of this rulification strategy are insufficient by themselves to make it appealing. One also has to assume that restricting copyright’s breadth in this context to cases of copying the melody strikes a satisfactory substantive incentive/access balance.

271. See, e.g., Samuelson, *supra* note 188, at 1840–47 (describing seven ways of improving non-literal infringement analysis).

272. See Balganes, *supra* note 178, at 858–61 (proposing to reform infringement analysis by adding a cognizable similarity step to be decided by judges as a matter of law prior to sending the infringement question to juries); Lemley, *supra* note 147, at 741 (suggesting “a rule that gives to the jury the basic question of whether the defendant copied, which might or might not involve expert testimony, but reserves the question of whether the copying was unlawful for the court”). Note that procedural adjustments of this kind, which might be desirable in themselves, will have little effect if the substantive standard of improper appropriation is the extreme one of a *de minimis* exception.

273. See 17 U.S.C. § 107 (2012).

otherwise would be infringing in a variety of contexts. One may argue that fair use is copyright's boundary-drawing mechanism, which already adequately shields desirable secondary uses.<sup>274</sup> If that is the case, an overlapping improper appropriation doctrine is unnecessary and may even be confusing and wasteful.<sup>275</sup> Ostensibly, the logical course of action is to remove this redundancy by eliminating improper appropriation or at least scaling it back to a minor exception for trivialities as its *de minimis* construal does.

This objection is misguided because it fails to consider the valuable role that properly designed redundancy can play in legal doctrine.<sup>276</sup> The overlap between fair use and improper appropriation is partial. There is an important subset of cases where a robust improper appropriation requirement can shield secondary uses more efficiently and effectively, thereby better tracking underlying policies.<sup>277</sup> This becomes both more apparent and more significant once procedure is taken into account. Crucially, in an important subset of cases improper appropriation is better suited for a quick and early dismissal of meritless copyright claims using the procedural mechanisms of summary judgment and motion to dismiss.<sup>278</sup> Moreover, the partial overlap between fair use and improper appropriation functions as an important procedural safeguard for freedom of speech by supplying speakers who re-appropriate expressive materials a double layer of protection.<sup>279</sup> Taking all of this into account, improper appropriation emerges as having a significant role even in the face of fair use, and the partial overlap between the two appears to be beneficial rather than wasteful.

### 1. *Relative certainty*

Both fair use and improper appropriation are open ended and therefore often unpredictable standards. There is, however, an

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274. See Lape, *supra* note 243, at 188.

275. Cohen, *supra* note 243, at 745–46; see also Lape, *supra* note 243, at 189–90 (referring to some scholars noticing and criticizing the overlap between fair use and substantial similarity); Michael F. Sitzer, Note, *Copyright Infringement Actions: The Proper Role for Audience Reactions in Determining Substantial Similarity*, 54 S. CAL. L. REV. 385, 395 (1981) (criticizing “the duplication of investigating market effects in the determination of substantial similarity” with the fourth fair use factor).

276. See generally John M. Golden, *Redundancy: When Law Repeats Itself*, 94 TEX. L. REV. 629, 633 (2016) (explaining how legal redundancy can create benefits in certain circumstances).

277. See *supra* Section III.B.2.

278. See *supra* Section III.B.2.

279. See *supra* Section III.B.3.

important subset of the cases where improper appropriation can generate more certainty *ex ante* and a simpler process *ex post*. Those are cases in which the conclusion against infringement can be reached relatively easily on the basis of limited information. This happens when a comparison of the two works, perhaps with minimal additional contextual information, suffices to conclude that finding infringement would impose substantial cost on future creation for little incentive benefit. The reason for the superiority of improper appropriation in such cases is its narrow focus. Fair use is a multi-focal doctrine. It covers many different categories of uses, founded on a variety of reasons and therefore requiring taking into account a large swath of considerations.<sup>280</sup> Improper appropriation has a much more focused orientation. The doctrine is designed to locate cases where on the sole basis of comparison of the expressive content of two works, it is possible to make a sound assessment that the cost of including the relevant secondary use within the exclusionary property right clearly outweighs any incentive benefit.<sup>281</sup>

Consider, for example, the *Warner Bros.* case.<sup>282</sup> Could the outcome that the character of Ralph Hinkley did not infringe the copyright in Superman be reached on the basis of fair use rather than lack of improper appropriation? Probably. Indeed, the decision briefly invokes fair use, only to subsequently drop it aside.<sup>283</sup> The point is that a fair use analysis in this case would have been more complex, costly, and open to unexpected twists and turns. The improper appropriation analysis required comparing the expressive content of the two works and discerning the material differences in their meaning, notwithstanding the technical similarities. This relatively simple analysis tracked well the underlying policy question. The substantial divergence of the meaning of the two works provided a good indication that including this use within the right's breadth would generate little marginal incentive for creating characters like

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280. See Joseph P. Liu, *Fair Use, Notice Failure, and the Limits of Copyright as Property*, 96 B.U. L. REV. 833, 837 (2016) (arguing that “[a]s a contextual, multifactor standard, the fair use defense contains within it, inherently, a degree of uncertainty”).

281. See Balganes, *supra* note 188, at 206 (observing that “[t]he substantial-similarity analysis has courts focus entirely on the significance of the similarity between the plaintiff’s and the defendant’s works for their assessment of actionability” but offering a different normative account of the purpose of this doctrine).

282. *Warner Bros. v. Am. Broad. Cos.*, 720 F.2d 231, 243 (2d Cir. 1983).

283. *Id.* at 242.

Superman, relative to the burden it would place on subsequent creativity by others who wish to draw on established and culturally dominant materials. This type of analysis can be undertaken simply by examining the works themselves and perhaps some minimal additional information. There is hardly a need for a taxing process of discovery and fact-finding or overly complex legal reasoning.<sup>284</sup>

Fair use, by contrast, would have required a more complex consideration of several, potentially conflicting factors. Under modern fair use doctrine and especially the rise within it of the inquiry of whether a secondary use is transformative,<sup>285</sup> there is a good chance that today the defendant in this case could win on this alternative ground. Still, the analysis would have to run through multiple tricky questions such as: the weight to be imputed to the commercial nature of the use,<sup>286</sup> whether and the extent to which the use could be considered transformative or even parodic,<sup>287</sup> the amount and substantiality of the material taken evaluated in relation to the purpose of the use,<sup>288</sup> the likely market effect on profits from the original in light of lack of an apparent market failure in negotiating a license on the one hand,<sup>289</sup> and the possible transformative character of the use

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284. See *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 64 (2d Cir. 2010) (“When a court is called upon to consider whether the works are substantially similar, no discovery or fact-finding is typically necessary.”); see also *NIMMER & NIMMER*, *supra* note 1, § 12.10[B][3] (stating that when a court decides substantial similarity as a matter of law “the works themselves supersede and control any contrary allegations, conclusions, or descriptions of the works contained in the pleadings”).

285. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578–79 (1994); *Cariou v. Prince*, 714 F.3d 694, 705–06 (2d Cir. 2013); *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 608 (2d Cir. 2006).

286. See 17 U.S.C. § 107(1) (2012); *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 921–22 (2d Cir. 1995).

287. *Campbell*, 510 U.S. at 579–81. Compare *Bill Graham Archives*, 448 F.3d at 608–12 (finding that the use of concert posters in a biographical book is transformative), and *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1268–69, 1272 (11th Cir. 2001) (noting that the use of extensive materials from original novel is transformative and parodic), with *TCA Television Corp. v. McCollum*, 839 F.3d 168, 179–83 (2d Cir. 2016) (holding that the use of a comedy routine in a play is not transformative), and *Salinger v. Colting*, 641 F. Supp. 2d 250, 256–63 (S.D.N.Y. 2009) (finding that the use of materials from original novel is neither parodic nor highly transformative), *vacated*, 607 F.3d 68 (2d Cir. 2010).

288. See 17 U.S.C. § 107(3); *Campbell*, 510 U.S. at 586–89.

289. See § 107(4); *Am. Geophysical Union*, 60 F.3d at 913 (finding that courts should only consider “traditional, reasonable, or likely to be developed markets” under the fourth fair use factor). In *Warner Bros.*, there was no market failure because prior to

on the other.<sup>290</sup> Each of these questions may require not just complex legal analysis, but also the need for discovery and fact finding on relevant issues.<sup>291</sup> And since the courts treat fair use as an affirmative defense, the defendant is seen as carrying the burden of producing favorable evidence pertinent for these critical factors.<sup>292</sup> Thus, in a case where the underlying policy could be tracked well by the narrow inquiry of comparing the two works' expressive meaning, using fair use would have been more complex, resource-intensive, and open to unpredictable doctrinal turns relative to improper appropriation.

The narrow focus of improper appropriation means that there will be a hard core covered by the requirement: a set of cases where the application of a robust version of this doctrine should be relatively simple and certain. Fair use, while tending to develop some predictable patterns over time,<sup>293</sup> always carries the potential for more complications, uncertain twists and the need to obtain and process additional information. This is a function of the multi-focal character of the doctrine and the structure of its analysis as involving several factors, each entailing choices of interpretation and application. Consequently, there is an important set of cases where a robust improper appropriation requirement can more cheaply and

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the unauthorized use, the parties engaged in licensing negotiations. *See Warner Bros. v. Am. Broad. Cos.*, 720 F.2d 231, 236 (2d Cir. 1983).

290. *Campbell*, 510 U.S. at 591 (finding that when the use is transformative, "market harm may not be so readily inferred"); *Bill Graham Archives*, 448 F.3d at 614–15 (finding that licensing markets for transformative uses are not considered under the fourth fair use factor even if already established).

291. Demonstrative of this point is the fact that in *Campbell*, which is often seen as a strong pro-fair-use decision, the Supreme Court refrained from deciding the issue on the merits. Despite its highly favorable attitude toward the parodic use, the Court remanded the case to the trial court with instructions for further proceedings on the issues of the substantiality of the part taken and effect on the secondary market for rap versions. The Court added comments on deficiencies in the record in regard to these issues and expressed its confidence that the "evidentiary hole" will be plugged on remand. *See Campbell*, 510 U.S. at 589, 593–94. Generally, an appellate court may decide fair use as a matter of law with the crucial condition that the trial court "has found facts sufficient to evaluate each of the statutory factors." *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985).

292. *Campbell*, 510 U.S. at 590.

293. *See* Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549, 556 (2008); Neil Weinstock Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715, 717–18 (2011); Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537, 2541 (2009).

predictably shield socially beneficial secondary uses and thus more effectively serve the underlying policy.

## 2. *Procedural aspects*

The procedural dimension bolsters the relative superiority of improper appropriation regarding the hard core of cases covered by it. Whether a legal rule can effectively shield desirable secondary uses of copyrighted works depends not only on the substantive result generated by the rule post-litigation or even the predictability of that result. An additional crucial element is how complex and expensive the process leading to the result might be. A privilege to use that can be effectuated only through a long and expensive litigation is likely to create a chilling effect.<sup>294</sup> Conversely, a simpler and more accessible vindication of the privilege is likely to boost the willingness of users to take the risk and decrease threats issued in the shadow of litigation.<sup>295</sup> This is where procedure enters the picture.

One relevant procedure is summary judgment. Courts have shown some willingness to grant summary judgment to defendants on the basis of findings of fair use in the appropriate cases.<sup>296</sup> Nevertheless, for the reasons just discussed, there is a subset of cases where summary judgment should be much easier to grant on the basis of lack of improper appropriation.<sup>297</sup> Courts are generally willing to grant

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294. Gibson, *supra* note 257, at 887 (outlining four factors that lead users to seek licenses even where unauthorized use will not result in liability); Joseph P. Liu, *Copyright and Breathing Space*, 30 COLUM. J.L. & ARTS 429, 434 (2007) (discussing the chilling effect of uncertainty in fair use); Gideon Parchomovsky & Kevin A. Goldman, *Fair Use Harbors*, 93 VA. L. REV. 1483, 1497–98 (2007) (discussing the problem of over-deterrence in copyright); Alfred C. Yen, Eldred, *The First Amendment, and Aggressive Copyright Claims*, 40 HOUS. L. REV. 673, 679 (2003) (arguing that vague copyright doctrine encourages “[a]ggressive copyright claims”).

295. See Ned Snow, *Proving Fair Use: Burden of Proof as Burden of Speech*, 31 CARDOZO L. REV. 1781, 1810–15 (2010) (describing how easier vindication of fair use through reassignment of the burden of proof is likely to reduce self-censorship of users).

296. See *Wright v. Warner Books, Inc.*, 953 F.2d 731, 735 (2d Cir. 1991); *Cable/Home Comm’n Corp. v. Network Prods., Inc.*, 902 F.2d 829, 845 (11th Cir. 1990); *Fisher v. Dees*, 794 F.2d 432, 436 (9th Cir. 1986); see also NIMMER & NIMMER, *supra* note 11, § 12.10[B][4]. For a discussion of the rules pertaining to summary judgment and fair use, see Ned Snow, *Fair Use as a Matter of Law*, 89 DENVER U. L. REV. 1, 38–46 (2011).

297. See *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 918 (2d Cir. 1980) (internal quotations omitted) (observing that “where both the plaintiff’s and defendant’s works are before the court, the court may compare the two works and render a judgment for the defendant on the ground that as a matter of law a trier of fact would

summary judgment to defendants “either because the similarity between two works concerns only ‘non-copyrightable elements of the plaintiff’s work,’ . . . or because no reasonable jury, properly instructed, could find that the two works are substantially similar.”<sup>298</sup> In such cases, courts can reach the focused conclusion of no improper appropriation on the basis of relatively simple inquiry based mainly on comparing the works themselves, while the multi-faceted fair use doctrine might require the further consideration and deliberation of full trial.<sup>299</sup> For example, *Warner Bros.* was decided on summary judgment on the basis of comparing the two works with little resort to other factual issues.<sup>300</sup> Similarly, consider *Walker v. Time Life Films, Inc.*,<sup>301</sup> where the trial court granted summary judgment rejecting an infringement claim by an author against the producers and screenwriter of a motion picture allegedly based on his book.<sup>302</sup> The court reached its decision after analyzing the two works on the basis of a thin version of stipulated facts agreed to by the parties for purposes of the motion<sup>303</sup> and expert opinions analyzing the works.<sup>304</sup> Notwithstanding the resort to expert opinions, this was a relatively simple and cheap way of reaching the conclusion relative to the alternatives including a full fair use analysis.

The allocation of the burden of proof under improper appropriation and fair use shores up the case for as the former as a basis for quick and inexpensive dismissal of unfounded infringement claims through summary judgment.<sup>305</sup> Because fair use is treated by courts as an affirmative defense, the burden of proof, including the burden of producing relevant evidence, with respect to it lies with the

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not be permitted to find substantial similarity”); *Malibu Media, LLC v. Doe*, 82 F. Supp. 3d 650, 653 n.1 (E.D. Pa. 2015); *Wavelength Film Co. v. Columbia Pictures Indus., Inc.*, 631 F. Supp. 305, 306–07 (N.D. Ill. 1986); *Anderson v. Paramount Pictures Corp.*, 617 F. Supp. 1, 2–3 (C.D. Cal. 1985); see also *NIMMER & NIMMER*, *supra* note 1, § 12.10[B][3].

298. *Warner Bros. v. Am. Broad. Cos.*, 720 F.2d 231, 240 (2d Cir. 1983) (internal quotations omitted).

299. *Id.* at 239–40; *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48–49 (2d Cir. 1986).

300. *Warner Bros. v. Am. Broad. Cos.*, 530 F. Supp. 1187, 1189–95 (S.D.N.Y. 1982).

301. 615 F. Supp. 430 (S.D.N.Y. 1985), *aff’d*, 784 F.2d 44 (2d Cir. 1986).

302. *Id.* at 432–33.

303. *Id.* at 433 n.1.

304. *Id.* at 438; *Walker*, 784 F.2d at 47–48.

305. I thank Bob Bone for pointing out this issue to me.

defendant.<sup>306</sup> Improper appropriation, by contrast, is part of the prima facie case of infringement, and thus the burden of proof with respect to it is placed on the plaintiff.<sup>307</sup> Generally, courts impose a higher standard on a party seeking summary judgment when that party bears the burden of proof at trial with respect to the relevant claim.<sup>308</sup> It follows that when the asserted basis for summary judgment is fair use, obtaining such a decision would be harder and more demanding compared to cases where the basis is lack of improper appropriation.

Even more important is the earlier termination of meritless cases through a motion to dismiss for failure to state a claim under rule 12(b)(6).<sup>309</sup> Unlike fair use, improper appropriation is part of the prima facie case of copyright infringement that must be established by a plaintiff.<sup>310</sup> This is important in light of two other elements: the heightened pleading burden imposed by the Supreme Court in civil cases that requires a complaint to plausibly suggest an entitlement to relief<sup>311</sup> and the general willingness of courts to grant motions to dismiss in suitable copyright cases due to failure to plausibly allege improper appropriation.<sup>312</sup> Together, these elements create the potential for an effective tool for early dismissal of meritless suits and for the discouragement of frivolous or dubious claims with their attendant chilling effect on secondary uses. Granting a motion to dismiss allows courts to dismiss a case at an earlier stage compared to a summary judgment decision and before much of the effort and

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306. See PATRY, *supra* note 24, § 10.9; *Infinity Broad. Corp. v. Kirkwood*, 150 F.3d 104, 107 (2d Cir. 1998) (observing that “[s]ince fair use is an affirmative defense to a claim of infringement, the burden of proof is on its proponent”).

307. See NIMMER & NIMMER, *supra* note 1, § 13.01[A]—[B]; PATRY, *supra* note 24, § 9.4.

308. See *Leone v. Owsley*, 810 F.3d 1149, 1153 (10th Cir. 2015); *Cockrel v. Shelby Cty. Sch. Dist.*, 270 F.3d 1036, 1056 (6th Cir. 2001); 11 JEFFERY W. STEMPER & STEVEN S. GENSLER, *MOORE’S FEDERAL PRACTICE* § 56.40[1][c] (3d ed. 2018); 10A CHARLES A. WRIGHT, ET AL., *FEDERAL PRACTICE AND PROCEDURE* § 2727.1 (4th ed. 2018).

309. FED. R. CIV. P. 12(b)(6).

310. PATRY, *supra* note 24, § 9.4.

311. *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 557 (2007) (finding that a complaint requires allegations “plausibly suggesting” a valid claim).

312. See, e.g., *Tanikumi v. Walt Disney Co.*, 616 F. App’x 515, 521 (3d Cir. 2015) (per curiam); *Hobbs v. John*, 722 F.3d 1089, 1096 (7th Cir. 2013); *Winstead v. Jackson*, 509 F. App’x 139, 144–45 (3d Cir. 2013) (per curiam); *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 69 (2d Cir. 2010); *Taylor v. IBM*, 54 F. App’x 794, 794 (5th Cir. 2002) (per curiam); *Nelson v. PRN Prods., Inc.*, 873 F.2d 1141, 1143–44 (8th Cir. 1989); see also NIMMER & NIMMER, *supra* note 1, § 12.10[B][3].

expense of litigation, including discovery, has been incurred.<sup>313</sup> When making such a decision, a court concludes that a comparison of the expressive content of the relevant works precludes the possibility of substantial similarity, that “the works themselves supersede and control contrary descriptions of them’ in the pleadings,”<sup>314</sup> and that no further consideration of evidence can change this result.<sup>315</sup> In such cases, courts simply compare the expressive content of the relevant works on the basis of the complaint and attached exhibits, sometimes asserting that “no discovery or fact-finding is typically necessary, because ‘what is required is only a visual comparison of the works.’”<sup>316</sup> And again, improper appropriation can create the basis for this early dismissal in an important set of cases where fair use—a doctrine that almost always carries the potential for a need to resort to evidence beyond the works themselves—is unlikely to play this role.<sup>317</sup>

### 3. *Free speech*

The overlap between improper appropriation and fair use also plays a role as an embodiment of free speech safeguards within copyright doctrine. The inherent tension between copyright and free speech is widely recognized.<sup>318</sup> Copyright is a limitation of speech backed by

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313. *Twombly*, 550 U.S. at 559.

314. *See* *McDonald v. West*, 669 F. App’x 59, 60 (2d Cir. 2016) (quoting *Peter F. Gaito Architecture, LLC*, 602 F.3d at 64).

315. *See* *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1123 (9th Cir. 2018) (affirming a grant of a motion to dismiss for lack of improper appropriation and concluding that “[n]othing disclosed during discovery could alter the fact that the allegedly infringing works are as a matter of law not substantially similar” to the plaintiff’s work).

316. *Peter F. Gaito Architecture, LLC*, 602 F.3d at 64 (citing *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 766 (2d Cir. 1991)). For examples of such cases, see *Hobbs*, 722 F.3d at 1096 (internal quotations omitted) (finding that the two songs “simply tell different stories” and “do not share enough unique features to give rise to a breach of the duty not to copy another’s work”); *Nelson*, 873 F.2d at 1143 (ruling that “the trial court carefully studied the lyrics involved and determined that reasonable minds could not differ as to the absence of substantial similarity”).

317. *See, e.g., Nelson*, 873 F.2d at 1144 (affirming the trial court’s decision to grant a motion to dismiss without allowing further discovery because the relevant information was relevant for refuting a fair use defense while the court decided the case on the basis of lack of substantial similarity).

318. *See, e.g.,* C. Edwin Baker, *First Amendment Limits on Copyright*, 55 VAND. L. REV. 891, 894 (2002); Robert C. Denicola, *Copyright and Free Speech: Constitutional Limitations on the Protection of Expression*, 67 CAL. L. REV. 283, 284 (1979); Neil Weinstock Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 7 (2001); Melville

legal sanctions and remedies.<sup>319</sup> This is even more true in cases where substantial similarity is a question. Such cases often involve not mere copying or repetition of another's speech but appropriation for purposes of creating significantly different expression.<sup>320</sup> Since Melville Nimmer first suggested it in 1970, the standard response to this concern is that copyright law incorporates internal mechanisms that appropriately balance speech interests with those served by copyright.<sup>321</sup> It is one thing, however, to simply declare that copyright's doctrine already optimally factors-in free speech interests; it's quite another to actually design and apply the relevant doctrinal mechanism to do so.<sup>322</sup>

The partial overlap of improper appropriation and fair use is exactly such an internal copyright mechanism for protecting speech interests. To establish copyright infringement, a plaintiff must jump through two hoops. She must *both* establish improper appropriation and survive any assertion of a fair use defense.<sup>323</sup> A defendant can escape by *either* a failure to establish improper appropriation or a successful fair use defense.<sup>324</sup> Such a lopsided structure is an important way of designing copyright doctrine to give proper weight to freedom of speech interests, particularly for expressive re-appropriations of original works

B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180, 1181 (1970).

319. See Denicola, *supra* note 318, at 284–85.

320. See NIMMER & NIMMER, *supra* note 1, § 13.03[A].

321. See *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2003) (observing that “copyright’s built-in free speech safeguards are generally adequate to address” First Amendment concerns); *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985); *New Era Publ’ns Int’l, ApS v. Henry Holt & Co.*, 873 F.2d 576, 584 (2d Cir. 1989), *superseded by statute*, 17 U.S.C. § 107, (2012); *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1170 (9th Cir. 1977), *superseded by statute*, 17 U.S.C. § 504(b) (2012). This argument is usually traced to Nimmer. See NIMMER & NIMMER, *supra* note 1, § 218C. The built-in speech balancing mechanisms typically pointed at are: the idea/expression dichotomy, the fair use doctrine, and copyright’s limited duration.

322. See Netanel, *supra* note 318, at 26 (concluding that “it is highly—and increasingly—doubtful that copyright limitations adequately protect First Amendment values”); David S. Olson, *First Amendment Interests and Copyright Accommodations*, 50 B.C. L. REV. 1393, 1413 (2009) (arguing that “due to the significant changes to the traditional contours of copyright . . . the idea/expression dichotomy and fair use doctrines cannot come close to adequately protecting the public’s interests in speech”).

323. *Wright v. Warner Books, Inc.*, 953 F.2d 731, 736 (2d Cir. 1991); see also Wendy J. Gordon, *Copyright Owners’ Putative Interests in Privacy, Reputation, and Control: A Reply to Gould*, 103 VA. L. REV. ONLINE 36, 36–38 (2017).

324. See Gordon, *supra* note 323, at 36–38 (describing the burdens a plaintiff must overcome in copyright law during a showing of fair use and improper appropriation).

for which this doctrinal layering is most significant. Giving due weight to free speech is achieved exactly by the lopsided design of the doctrine. The speech of secondary users is surrounded by two layers of protection. The plaintiff who asks the court to limit another's expression has to cross two—not completely identical—doctrinal safeguards for speech. The speaker gets two bites at the apple, increasing the chance that at least one of them will work to prevent liability and shield his speech. This structure of fair use and improper appropriation is in line with a long tradition of procedural safeguards for speech<sup>325</sup> and of tailoring private law doctrines to accommodate free speech interests.<sup>326</sup>

### CONCLUSION

Improper appropriation doctrine is far from perfect. The source of many of its afflictions, however, is the extensive breadth of modern copyright. The substantial similarity criterion which is at the heart of this doctrine is a double-edged sword in this regard. It is both the source of the extensive breadth (i.e. anything that is substantially similar) and the mechanism for trying to lay some restrictions on it (only as long as it is substantially similar).<sup>327</sup> Simply eliminating the doctrine or replacing it with a feeble exception for rare trivialities hardly seems the solution to its problems. It amounts to leaving the sword with only one edge—copyright's extensive breadth without the mechanism that was meant to restrain it. As this Article explained, there are important policy reasons why copyright should not extend to any copying, not even any copying of protectable and recognizable elements of a work. And fair use, while having a role to play in this regard, is not by itself adequate for performing this function. As a result, eliminating or trivializing improper appropriation would leave this important function unaddressed.

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325. See Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 150 (1998) (internal quotations omitted) (discussing “[t]he First Amendment due process” in the context of prior restraint as applied to copyright); Eugene Volokh & Brett McDonnell, *Freedom of Speech and Independent Judgment Review in Copyright Cases*, 107 YALE L.J. 2431, 2465 (1998) (quoting *Bantam Books, Inc. v. Sullivan*, 372 U.S. 58, 66 (1963)) (arguing that “‘rigorous procedural safeguards’ are needed because ‘the freedoms of expression must be ringed about with adequate bulwarks’”).

326. See *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 292 (1964).

327. See *supra* Section III.B.

The erosion of the improper appropriation requirement out of existence is all the more troubling because it unfolds in the case law not as a conscious and reasoned decision, but as a creeping stealth process. Its main thrust originated in a convoluted and often confused use of the concept of *de minimis* in decades of copyright case law. Now, almost unnoticeably, the process has reached the stage where it threatens to reduce improper appropriation to a *de minimis* exception for unrecognizable copying: a pale limitation whose underlying function has nothing to do with that served for a century by improper appropriation. We are not quite yet at the bottom of this slope, but the rolling rock has already gathered much speed unnoticed or perhaps unheeded.

The first thing to be done is to stop this process. Courts should recognize explicitly: improper impropriation *is not* a *de minimis* exception to copyright infringement. Those are two separate doctrines, undergirded by very distinct purposes that give rise to a very different substance. That is true whether or not a distinct rule of a *de minimis* exception to copyright infringement is recognized.

When the slide toward trivializing improper appropriation is stopped, we can consider how to address its problems, whether by ambitious reforms of copyright's breadth and scope or by more limited tweaks of existing doctrine. In fact, the analysis offered here of the purpose of improper appropriation and its relative advantages over other doctrines offers support to some adjustments proposed by others, such as a more robust power to judges to find, in suitable cases, a lack of improper appropriation as a matter of law at an early stage of legal proceedings. Such adjustments can be valuable, however, only if the collapse of improper appropriation into a *de minimis* exception is averted. No robust procedural treatment as an early threshold question would be of much help if the substantive standard applied is that of a rare exception for trivial, unrecognizable borrowing. At the end, the argument of this article comes down to this: if it is broken fix it; don't break it further.

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