

UNDERSTANDING SUBSTANTIAL SIMILARITY AND SCOPE OF PROTECTION

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Reported copyright decisions often reflect a misunderstanding of “substantial similarity” and “scope of protection.” The proper application of these key principles can help you shape a copyright infringement case to your best advantage.

SUBSTANTIAL SIMILARITY

The term “substantial similarity” causes confusion in the copyright infringement analysis because the same term has different meanings at two different points in the infringement analysis. To prove infringement, the plaintiff must show that the defendant copied elements of a work that are original. Feist Publication, Inc., v. Rural Telephone Service Co., 499 U.S. 340 (1991).

The Feist test for infringement involves two separate inquiries. First, did the defendant actually copy the plaintiff’s work. Second, were the copied elements protected expression and sufficiently important to be actionable. In other words, did the copying constitute infringement. The term “substantial similarity” is used by the courts for both inquiries, but has a different meaning in each instance.

The first prong of the infringement test – actual copying – can be established by showing access to the work and substantial similarity. Here, substantial similarity means that the works are in fact sufficiently similar to support a conclusion that one was actually copied from the other. This involves a relatively low threshold: substantial similarity for the purpose of showing actual copying involves a comparison of the works in their entirety, including protectable and unprotected elements.

The second prong of the infringement test also involves a showing of “substantial similarity” but

the meaning is very different. Here, the question is limited to similarities of protected expression. The bar is higher, requiring a showing that the defendant copied a substantial amount of protectable expression.

Problems can arise in litigation when the wrong definition of “substantial similarity” is used. For example, if the court use the first definition for the second prong of the infringement analysis, the defendant suffers. The court may incorrectly find infringement based on the works as a whole, without determining if the copying involves protectable expression. Similarly, if the court applies the second definition to evaluate the question of actual copying, the failure to consider the works as a whole may disadvantage the plaintiff.

Recognizing the confusion caused by the use of the same term for two different tests, some courts have suggested a distinction between probative or factual similarity on the one hand and substantial or legal similarity on the other. See, for example, Repp v. Webber, 132 F.3d 882, 889 (2d Cir. 1997)(noting the considerable confusion caused by the use of the term “substantial similarity” for two different tests). According to this line of cases, the first prong involves probative similarity. That is, whether as a matter of fact, the similarities show actual copying. Under the second prong, the inquiry into substantial similarity is primarily a legal conclusion: are there substantial similarities of protected expression sufficient to support a finding of infringement.

Although helpful, the distinction between probative similarity and substantial similarity is not widely stated in reported decisions. Since few courts have a regular docket of copyright infringement matters, litigators should ensure that the court is fully informed about the different definitions of substantial similarity arising in a copyright infringement action, particularly when the difference may have an effect on their clients position.

SCOPE OF PROTECTION

A second area of confusion involves the scope of protection afforded protectable expression in copyright infringement actions. Not all works are entitled to the same level of protection. This issue is particularly important when the works involve a compilation of otherwise unprotectable elements.

The constitutional requirement of originality precludes protection for facts, and the copyright statute precludes protection of “any idea, procedure, process, system, method of operation, concept, principle or discovery.” 17 U.S.C. 102(b). Nevertheless, the “selection, coordination or arrangement” of such unprotectable elements may be entitled to protection if the selection and arrangement has a minimal degree of creativity.

The scope of protection granted to a compilation of unprotectable elements is less than the protection afforded to elements protectable in their own right.. It is sometimes said that compilations and factual works are only entitled to “thin” protection, but what does this mean?

According to the Second Circuit, a compilation is not infringed if the defendant’s work differs in more than a “trivial degree” from the plaintiff’s work. Kregos v. Associated Press, 937 F.2d 700, 710 (2d Cir. 1991). See also Harbor Software, Inc. v. Applied Systems, Inc., 936 F. Supp. 167, 171 (S.D.N.Y. 1996)(applying the “trivial difference” test to computer screen displays which were compilations of factual information).

In other courts, the “thin” protection afforded compilations means no relief unless the works are “virtually identical.” See, for example, Mitek Holdings Inc. v. Arce Engineering Co., 89 F.3d 1548, 1554 (11th Cir. 1996); Apple Computer Inc. v. Microsoft Corporation, 35 F.3d 1435, 1446 (9th Cir.1994).

In practice, the “trivial difference” test and the “virtual identical” standard have the same result.

The plaintiff's burden is higher when seeking protection for compilations of unprotectable elements, and the defendant may escape liability if the works differ by more than a trivial degree. If the plaintiff's work involves elements protectable in their own right, there will be a lower test for infringement. In such cases, the defendant will be liable if the works are found to be substantially similar, as that term is understood in the second prong of the infringement test discussed above.

CONCLUSION

In the abstract world of copyright litigation, the formulation of the tests applied by the court to determine infringement can have a major impact on the outcome of the case. Much may turn on whether the judge or jury is asked to determine if works are substantially similar as a whole or only with respect to protectable elements. Likewise, the results may differ if the fact finder is instructed to determine that the works are virtually identical rather than substantially similar. An understanding of these different tests is important for successful litigation.