

## TIFFANY DESIGN, INC. V. RENO-TAHOE SPECIALTY, INC.

By Swatee L. Mehta

### I. INTRODUCTION

The Copyright Act<sup>1</sup> seeks to advance the constitutional goal of encouraging creativity.<sup>2</sup> By granting limited exclusive rights to the authors of qualifying works, the Act gives these authors an incentive to produce new works, yet ensures that these works will become accessible to the public for use as source material for further creativity.<sup>3</sup>

As one of its provisions for furthering creativity, the Act grants owners of copyrights in works of art the exclusive right to create derivative works based on those works.<sup>4</sup> It defines derivative works as works “based upon” the copyrighted work, including “art reproduction[s], abridgment[s], condensation[s], or any other form[s] in which a work may be recast, transformed, or adapted.”<sup>5</sup> While it is understood that a derivative work is one which “incorporate[s] a portion of the copyrighted work in some form,”<sup>6</sup> courts interpret the statute as also requiring that an infringing work be substantially similar to the work on which it is based.<sup>7</sup>

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1. 17 U.S.C. § 101 et seq. (1994).

2. See U.S. CONST. art. I, § 8, cl. 8 (granting Congress the right “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”).

3. See *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975); see also *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1163 (9th Cir. 1977).

4. See 17 U.S.C. § 106(2).

5. 17 U.S.C. § 101.

6. H.R. REP. NO. 94-1476, at 62 (1976).

7. See, e.g., *Litchfield v. Spielberg*, 736 F.2d 1352, 1357 (9th Cir. 1994) (rejecting the argument that the right to make derivative works covers any work based on a copyrighted work and holding that substantial similarity must exist before a work would be considered derivative within the meaning of 17 U.S.C. § 106(2)); see also *Ferguson v. NBC, Inc.*, 584 F.2d 111, 113 (5th Cir. 1978) (applying substantial similarity test); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3rd Cir. 1975) (using substantial similarity inquiry); cf. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2nd Cir. 1930) (characterizing the test for infringement as “whether the part . . . taken is ‘substantial.’”).

While “substantial similarity” is accepted as the test for infringement of the right to create derivative works, what the term actually stands for can be a mystery.<sup>8</sup> Courts have produced so many definitions of the substantial similarity test and applied them in so many different ways that one commentator has deemed the test unworkable.<sup>9</sup>

This Note discusses how the substantial similarity test may be improved by developing variants which address the creative and incentive needs for different kinds of works, both in terms of medium and market. More specifically, the Note examines how the test could be modified to handle the special needs of the visual arts as illustrated by the battle of the postcard makers in *Tiffany Design, Inc. v. Reno-Tahoe Specialty, Inc.*<sup>10</sup>

## II. CASE SUMMARY

### A. Factual Background

In January of 1998, Tiffany Design, Inc. hired Robert Burton, a graphic designer, to create a postcard image of the Las Vegas Strip.<sup>11</sup> The company gave Burton photographs taken by Grant Gresser, its owner, and David Phillips, an aerial photographer hired by Gresser, as source material for the image.<sup>12</sup> Using a computer, Burton manipulated the photographs and created “an artistic depiction of the Strip and its surrounding environs,” which “featured a number of enhancements or changes, including the addition of illumination, the modification of the size of certain hotels

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8. See *Krofft*, 562 F.2d at 1162 (arguing that statements such as “substantial similarity . . . frequently serve merely as boilerplate to copyright opinions); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975) (stating that “substantial similarity is not always substantial similarity”); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (claiming that “[t]he test for infringement of a copyright is of necessity vague”); 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A] (1998) (explaining that “the determination of the extent of similarity that will constitute a *substantial*, and hence infringing, similarity presents one of the most difficult questions in copyright law”) (emphasis in original). See generally Jeanne English Sullivan, *Copyright for Visual Art in the Digital Age: A Modern Adventure in Wonderland*, 14 CARDOZO ARTS & ENT. L.J. 563, 600 (1996) (characterizing substantial similarity as “a most difficult question”); Maura Giannini, *The Substantial Similarity Test and Its Use in Determining Copyright Infringement Through Digital Sampling*, 16 RUTGERS COMPUTER & TECH. L.J. 509, 520 (1990) (noting that “[c]ourts have been unable to agree on what exactly is a substantial taking”).

9. See Amy B. Cohen, *Masking Copyright Decisionmaking: The Meaninglessness of Substantial Similarity*, 20 U.C. DAVIS L. REV. 719, 735 (1987).

10. 55 F. Supp. 2d 1113 (D. Nev. 1999).

11. See *id.* at 1116.

12. See *id.* at 1115-16.

and casinos, and the addition or subtraction of colors.”<sup>13</sup> Gresser secured from Phillips and Burton releases for all copyrights attached to this image (the “Burton Image”) and obtained a federal copyright registration for the image.<sup>14</sup>

Also interested in creating a manipulated photographic image of the Las Vegas Strip, Reno-Tahoe Specialty, Inc. (“Reno-Tahoe”) had begun work on such an image in “early 1998.”<sup>15</sup> After seeing the Burton Image, Reno-Tahoe’s graphic designer, Todd Johnson, scanned the image onto a computer, creating a “precursor image” from which he “cut and manipulated” at least six of the image’s architectural components.<sup>16</sup> He later inserted these architectural works into Reno-Tahoe’s products.<sup>17</sup>

After discovering the Reno-Tahoe products, Gresser and Tiffany Design, Inc. (collectively, “Tiffany Design”) filed suit for copyright infringement.<sup>18</sup> Specifically, Tiffany Design alleged that the creation of the precursor image violated its exclusive right to reproduce the Burton image, and that Reno-Tahoe’s use of the six copied architectural images in its products rendered them derivative works which violated Tiffany Design’s exclusive rights to create derivative works and distribute copies of the Burton Image.<sup>19</sup> Tiffany Design then moved for partial summary judgment on both claims.<sup>20</sup>

## B. The Court’s Decision

The court first examined whether the Burton image contained copyrightable expression and whether Gresser held a valid copyright in the image.<sup>21</sup> It held that the signed writings obtained by Gresser satisfied the re-

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13. *Id.* at 1116.

14. *See id.*

15. *Id.*

16. *Id.*

17. *See id.*

18. *See id.* at 1115.

19. *See id.* at 1116.

20. *See id.*

21. *See id.* at 1117-20. In order to win a claim of copyright infringement, a plaintiff must show (1) that she holds a valid copyright in the copied work and (2) that the defendant copied that work’s protected expression. *See Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1217 (9th Cir. 1997). While expression is copyrightable, ideas are not. *See* 17 U.S.C. § 102(b) (1994); *Mazer v. Stein*, 347 U.S. 201, 217 (1954). Also uncopyrightable are facts and expression inseparable from a useful article’s utilitarian aspects. *See* 17 U.S.C. § 101 (“[T]he design of a useful article . . . shall be considered a [protectable] work only if, and to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.”); *Feist*

quirements for conveyance of copyrights and therefore Reno-Tahoe failed to overcome the presumption of validity that the certificate of copyright registration raised.<sup>22</sup> Stating that “[i]t is basic copyright law that a photograph possesses a wide range of protectable elements, including the posture of subjects, lighting, angle, selection of film and camera,” and composition, the court held that a computer enhanced photograph is copyrightable.<sup>23</sup> In doing so, the court rejected Reno-Tahoe’s arguments that the image constituted a non-copyrightable “idea”<sup>24</sup> and that because the images it copied into its products were of architectural landmarks, such copying was not actionable under 17 U.S.C. § 120(a).<sup>25</sup>

Having found that the Burton Image was protected by copyright, the court next examined whether Reno-Tahoe had infringed upon Tiffany Design’s right to reproduce the image. It focused on the Copyright Act’s requirement that copies be “fixed” in order to be actionable.<sup>26</sup> Applying the rule that a copy is fixed if it is “sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration,”<sup>27</sup> the court held that since “the digitization or input of any copyrighted material, whether it be computer code or visual imagery, may support a finding of infringement notwithstanding only the briefest of existence in a computer’s RAM [random access mem-

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Publications, Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340, 344-45 (1991) (holding facts contained in telephone directory white pages uncopyrightable); *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 489 (9th Cir. 1984) (holding historical facts not copyrightable). Nevertheless, factual compilations are protectable to the extent copyright protection applies to expression found in the compilation’s selection and arrangement. *See Feist*, 499 U.S. 340 at 348. Finally, in order to receive protection under copyright law, all types of expression must be original to the author. *See id.* at 345.

22. *See Tiffany Design*, 55 F. Supp. 2d at 1117-18.

23. *Id.* at 1119.

24. *Id.* at 1120 (explaining that Tiffany Design was not attempting to copyright the idea of an aerial view of the Las Vegas Strip; but instead sought protection of its “artistic rendition of this view.”).

25. *See id.* at 1119-20 (holding that while the Copyright Act states that “owners of copyrights to ‘architectural works’ may not prevent the making or distribution of pictorial representations of such structures if they are visible from a public space,” this is inapplicable to photographs of buildings because the term “architectural works” in this context only refers to the designs of buildings and structures. Thus, “while an architect may not prevent a photographer from producing pictures of her buildings, . . . that photographer may in turn certainly copyright those pictures.”).

26. *See id.* at 1120; *see also* 17 U.S.C. § 101 (1994) (defining copies as “material objects” which are “fixed”).

27. *Tiffany Design*, 55 F. Supp. 2d at 1120 (quoting 17 U.S.C. § 101).

ory],”<sup>28</sup> Reno-Tahoe infringed Tiffany Design’s copyright in the Burton Image when Todd Johnson scanned it as a precursor to manipulation.<sup>29</sup>

Although the court granted Tiffany Design’s motion for summary judgment on the issue of copying, it declined to do so on the issue of derivative works. It found a triable issue of fact as to whether Reno-Tahoe’s images contained sufficient recognizable imagery from the Burton Image to constitute an infringing derivative work.<sup>30</sup> The court stated that since Reno-Tahoe “touched up or modified” the copyrighted material it used, a trial was necessary to determine whether it “substantially incorporated protected materials” from the Burton Image.<sup>31</sup> If its manipulation rendered the copied materials “*de minimis* or unrecognizable in nature,” Reno-Tahoe would not be liable for violating Tiffany Design’s exclusive right to make derivative images based on the Burton Image and its source photographs.<sup>32</sup>

Finally, the court declined to rule on Tiffany Design’s claim that Reno-Tahoe’s distribution of unauthorized derivative works violated its exclusive right to distribute the Burton Image. Stating that the question need not be resolved because there was a triable issue as to whether Reno-Tahoe created an infringing derivative work, the court refused to comment on whether the maker of an unauthorized derivative work, upon publication or sale of such work, violates a copyright owner’s exclusive right to distribute the copyrighted image.<sup>33</sup> The court did, however, recognize that this is a novel question, to which there is no clear answer because, in the past, plaintiffs have “usually focused solely on the reproduction and derivative works provisions” of the Copyright Act.<sup>34</sup>

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28. *Id.* at 1121.

29. *See id.* See English Sullivan, *supra* note 8, at 587, for a discussion of the support for this outcome, and criticism of its impact on the visual arts.

30. *See id.* at 1121-22.

31. *Id.*

32. *Id.* at 1122. For an analysis on the extent of copying necessary for a determination of infringement, see 2 NIMMER, *supra* note 8, § 8.01[G].

33. *See id.* at 1122 n.6.

34. *Id.* Although an exploration of this issue is beyond the scope of this Note, the importance of this argument should be recognized: if the trial court finds that there is substantial similarity between the two postcards, it will be in a position to create new precedent; and if it finds that distribution of derivative works indeed violates a copyright holder’s right to distribute copies of the copyrighted work, a supplemental avenue of relief will be opened for plaintiffs, and debate as to whether this is desirable under the policies of the Copyright Act will surely ensue.

### III. DISCUSSION

Courts have adopted many variations of the substantial similarity test, leading to inconsistent results and much criticism from scholars. A brief overview of Ninth Circuit case law illustrates the problem facing this country's courts<sup>35</sup> and is useful in understanding how the issue will be approached in *Tiffany Design*, how the outcome of cases can vary depending on the precedent the court chooses to follow, and whether any of the current tests are capable of meeting the needs of the visual arts.

#### A. Substantial Similarity in the Ninth Circuit

Originally, the Ninth Circuit test for substantial similarity involved a determination of whether the copied and allegedly infringing works were the same "in total concept and feel."<sup>36</sup> Infringement occurred if the defendant's work was "recognizable by an ordinary observer as having been taken from the copyrighted source."<sup>37</sup>

The test was radically altered in *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*,<sup>38</sup> where the Ninth Circuit outlined a two-step test for substantial similarity.<sup>39</sup> In the first step, a court uses dissection<sup>40</sup> and expert testimony to analyze whether the copyrighted and allegedly infringing work share similar ideas.<sup>41</sup> *Krofft* calls this the "extrinsic test."<sup>42</sup> If the ideas are substantially similar, then a factual examination is made to determine whether there is substantial similarity of expression.<sup>43</sup> This "intrinsic test" involves the response of the ordinary observer without any dissection.<sup>44</sup> In holding that the two works involved in the

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35. This Note focuses on the Ninth Circuit case law because that is the circuit in which the *Tiffany Design* court is located. An examination of each circuit is beyond the scope of this Note. For an overview of the approaches taken in other circuits, see 4 NIMMER, *supra* note 8, § 13.03.

36. *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970).

37. *Id.* (internal quotation marks and citations omitted).

38. 562 F.2d 1157 (9th Cir. 1977).

39. *See id.* at 1164 (stating that this two step test developed from the test outlined by the Second Circuit in *Arnstein v. Porter*, 154 F.2d 464 (2nd Cir. 1946)).

40. Dissection involves analyzing the component parts of the work by looking at criteria such as "the type of artwork involved, the materials used, the subject matter, and the setting for the subject." *Krofft*, 562 F.2d at 1164.

41. *See id.*

42. *Id.*

43. *See id.*

44. *Id.*

case were substantially similar, *Krofft* stated that the defendants “captured the ‘total concept and feel’” of the plaintiff’s work.<sup>45</sup>

*Aliotti v. R. Dakin & Co.*<sup>46</sup> made it clear that the merger and *scenes-a-faire* doctrines apply to cases using the *Krofft* test.<sup>47</sup> *Scenes-a-faire* are “incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic,”<sup>48</sup> and are unprotectable under copyright law.<sup>49</sup> The merger doctrine applies when the expression of an idea necessarily follows from the use of the idea, or where there are only a few ways of expressing the idea.<sup>50</sup> Since protection of the expression would effectively grant the author a monopoly in the uncopyrightable<sup>51</sup> idea, the expression is unprotectable,<sup>52</sup> and is considered to have “merged” into the idea.<sup>53</sup> The court in *Aliotti* stated:

To the extent that it is necessary to determine whether similarities result from unprotectable expression, it is appropriate under *Krofft*’s intrinsic test to perform analytic dissection of similarities. Although even unprotectable material should be considered when determining if there is substantial similarity of expression, no substantial similarity may be found under the intrinsic test where analytic dissection demonstrates that all similarities in expression arise from the use of common ideas.<sup>54</sup>

The court also held that the point of view of the reasonable observer was that of the intended audience of the works.<sup>55</sup>

The following year, the Ninth Circuit further explained that when elements of a work “are indispensable from, indispensable to, or even standard treatment of the idea,” the idea and expression “coincide,” and only “identical copying” will lead to a finding of infringement.<sup>56</sup>

While these cases seem to clear up some of the confusion surrounding the *Krofft* test, a recent Ninth Circuit case shows that the issue of whether

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45. *Id.* at 1167.

46. 831 F.2d 898 (9th Cir. 1987).

47. *See id.* at 901.

48. *Alexander v. Haley*, 460 F. Supp. 40, 45 (S.D.N.Y. 1978).

49. *See See v. Durang*, 711 F.2d 141, 143 (9th Cir. 1983).

50. *See John Pinheiro & Gerard LaCroix, Protecting the ‘Look and Feel’ of Computer Software*, 1 HIGH TECH. L.J. 411, 428 (1987).

51. *See supra* note 21.

52. *See Aliotti*, 831 F.2d at 901.

53. *See* 4 NIMMER, *supra* note 8, § 13.03[B][3].

54. *Aliotti*, 831 F.2d at 901 (citations omitted).

55. *See id.* at 902.

56. *Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 209 (9th Cir. 1988).

dissection is allowed under the intrinsic test is not settled. In *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*,<sup>57</sup> the defendant argued that certain elements of the copyrighted work should be excluded from the intrinsic test because they were either uncopyrightable or were part of the public domain.<sup>58</sup> Without ruling on whether the elements were indeed unprotectable under copyright law, the court held that “analytic dissection is not appropriate when conducting the subjective or ‘intrinsic test.’”<sup>59</sup> Although *Dr. Seuss* did not involve the merger doctrine—which was the case in *Aliotti*—the court’s decision seems contrary to *Aliotti*’s statement that “[t]o the extent that it is necessary to determine whether similarities result from unprotectable expression, it is appropriate under *Krofft*’s intrinsic test to perform analytic dissection of similarities.”<sup>60</sup>

While *Dr. Seuss* illustrates the uncertainty surrounding the Ninth Circuit substantial similarity test, among post-*Aliotti* cases are some which—because of their consideration of the needs of particular creative mediums—could be used to craft a solution to the problems presented by the “total concept and feel” test.

### 1. *Shaw v. Lindheim*

*Shaw v. Lindheim*,<sup>61</sup> made significant changes to the Ninth Circuit test as applied to literary works. First, it distinguished between literary and representational works by saying that while in representational works “ideas and expression merge in the representational objects” so that there are but a few ways of expressing the idea, in literary works the two remain separate because “there is an infinite variety of novel or creative expression available to the author.”<sup>62</sup> Also, instead of focusing on *Krofft*’s distinctions of ideas (extrinsic test) and expression (intrinsic test), the court stated that “[b]ecause the criteria incorporated into the extrinsic test encompass all objective manifestations of creativity, the two tests are more sensibly described as objective and subjective analyses of expression, having strayed from *Krofft*’s division between expression and ideas.”<sup>63</sup>

Even though *Shaw* involved literary works, the case has the potential to affect cases involving representational works. In addition to the court’s

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57. 109 F.3d 1394 (9th Cir. 1997).

58. *See id.* at 1398-99.

59. *Id.* at 1399.

60. *Aliotti*, 831 F.2d at 901 (emphasis removed).

61. 919 F.2d 1353 (9th Cir. 1990).

62. *Id.* at 1360.

63. *Id.* at 1357.



adoption of “objective and subjective analyses of expression,”<sup>64</sup> its dicta stating that due to the applicability of the merger doctrine to representational objects, “the scope of copyright protection afforded such works is necessarily narrow”<sup>65</sup> could influence how such cases are resolved in the future. Although it is generally accepted that the *Krofft* extrinsic test now involves an objective inquiry into similarity of both ideas and expression,<sup>66</sup> *Shaw*’s take on the narrow protection available to representational works has not been tested.

## 2. *Apple Computer, Inc. v. Microsoft Corp.*

*Apple Computer, Inc. v. Microsoft Corp.*<sup>67</sup> rejected the total concept and feel test in the context of examining a claim of copyright infringement in a computer’s graphical user interface (“GUI”), which the court characterized as an inquiry into a “computer program’s artistic look as an audiovisual work.”<sup>68</sup> The matter was complicated because a license covered some of the uses.<sup>69</sup> In a case like this, the court held, the first step of the analysis involves separating out the licensed uses, so that “infringement cannot be founded on a licensed similarity.”<sup>70</sup> Next, a separation of ideas and expression, and a dissection of unlicensed elements occurs “in order to determine whether the remaining similarities lack originality, flow naturally from basic ideas, or are one of the few ways in which a particular idea can be expressed given the constraints of the computer environment.”<sup>71</sup> Finally, if the similarities between the remaining protectable elements are few, they can only receive “limited protection,” meaning that “the appropriate standard for illicit copying is virtual identity.”<sup>72</sup> Thus, a subjective comparison cannot occur until a determination as to whether the scope of protection is “broad” or “thin” has been made.<sup>73</sup>

It is important to note that a traditional intrinsic test, examining whether there is substantial similarity in total concept and feel, was not required. Unlike *Aliotti*, which stated that even unprotectable elements are

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64. *Id.* at 1356-57.

65. *Id.* at 1360.

66. *See, e.g., Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994); *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1475-76 (9th Cir. 1992).

67. 35 F.3d 1435 (9th Cir. 1994).

68. *Id.* at 1439.

69. *See id.*

70. *Id.*

71. *Id.* at 1439, 1443-45.

72. *Id.* at 1439.

73. *Id.* at 1443.

to be considered during the intrinsic test,<sup>74</sup> *Apple Computer* held that unprotectable elements must be dissected or “filtered” so that no finding of infringement is based on these elements.<sup>75</sup>

While *Apple Computer* could serve as an indication that the “total concept and feel” test is headed towards abandonment,<sup>76</sup> the test might still be used in cases involving simpler representational works.<sup>77</sup>

## B. Problems with the Total Concept and Feel Approach

The Ninth Circuit’s total concept and feel approach to substantial similarity is susceptible to attack on many fronts, among which are the use of the ordinary observer as the final determiner of substantial similarity, confusion over the applicability of expert testimony and dissection, the possibility that judicial value judgments may prejudice the outcome of cases, and failure to consider the needs of various creative mediums.

### 1. *Problems with the ordinary observer, dissection, and expert testimony*

*Aliotti*’s holding that both protected and unprotected material should be considered during the intrinsic test, yet that no infringement may be found when “all” similarities in expression arise from the use of unprotected expression or common ideas<sup>78</sup> is dangerous precedent not only because it would allow a finding of substantial similarity in a case where there is only a small amount of shared protected expression, but also because it would allow such a finding where a substantial portion of the similarities are due to unprotectable ideas and expression. Another problem lies in that after performing dissection to determine if all expression is due to unprotectable elements, the intrinsic test requires that the works be compared as a whole.<sup>79</sup> Here, the ordinary observer, if truly following the

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74. See *supra* note 54 and accompanying text.

75. *Apple Computer*, 35 F.3d at 1446. Professor Nimmer argues that although the court did not “fully discard the audience test,” this case essentially does away with any comparison of the works as a whole in favor of a comparison of an “analytically dissected distillation” of the work. See 4 NIMMER, *supra* note 8, § 13.03[F][5], at 13-144 n.345.

76. See 4 NIMMER, *supra* note 8, § 13.03[A][1][d].

77. Indeed, in a latter case involving an inquiry into the similarities of two book covers, the Ninth Circuit, after mentioning *Apple Computer*, proceeded to apply *Krofft*. The court allowed an intrinsic test that compared the two works in their entirety (without filtration), while stating that dissection is not appropriate at such time. See *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1398-99 (9th Cir. 1997).

78. See *supra* note 54 and accompanying text.

79. See, e.g., *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1475-76 (9th Cir. 1992); *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987).

directive that he rely on his immediate, visceral reaction to the works,<sup>80</sup> will be unable to separate protected and unprotected expression. An immediate inquiry without thoughtful deliberation will of necessity include a comparison of ideas and non-protectable expression. And, if he attempts to compare only the protectable expression, the ordinary observer is bound to perform impermissible dissection of dissimilarities.<sup>81</sup>

Additionally, while the use of a member of the work's intended audience as the ordinary observer is a laudable idea, in reality it may not be reconcilable with our jury system and the policies behind the total concept and feel test in cases where the intended audience for the works involved is a highly knowledgeable, expert audience. For example, *Aliotti*, the case where such use was advanced, involved an intended audience of children.<sup>82</sup> While jury members might be able to imagine themselves in the shoes of a child in order to determine how a child would view two stuffed dinosaurs, such a projection will not be possible in a case where the intended audience of the works is composed of, for example, 19th Century Latin American poetry experts. In such a case, in order to project himself into the intended audience's shoes, a jury member will need to be thoroughly educated in the works at issue, most likely through the use of expert witnesses—which often, if not always, will be prohibited by the intrinsic test.<sup>83</sup>

These problems illustrate the need for use of dissection and expert guidance during both parts of the substantial similarity test—regardless of whether the case involves “inseparable” ideas and expression under *Aliotti*. Without guidance, there may be situations where fact finders find a lack of substantial similarity in “total concept and feel” because their eyes are not trained to perceive the nuances of the creations before them. Furthermore, there may be other situations where they find infringement, while experts would view the similarities as trivial. Finally, using dissection and expert guidance during the intrinsic test makes sense because a trier of fact who hears expert testimony during the extrinsic test may not

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80. See *Shaw v. Lindheim*, 919 F.2d 1353, 1360-61 (9th Cir. 1990); *Aliotti*, 831 F.2d at 901.

81. See *Aliotti*, 831 F.2d at 901.

82. See *id.* at 902.

83. *Krofft* held that “analytic dissection and expert testimony are not appropriate” during the intrinsic test. 562 F.2d at 1164. Although *Aliotti* did not state whether its holding would alter *Krofft* and allow expert testimony when analytic dissection is performed during the intrinsic test to “determine whether similarities result from unprotectable expression,” 831 F.2d at 901, it would make sense to allow expert testimony during such an analytical inquiry. Nevertheless, at least for purposes of traditional “total concept and feel” inquiries, *Krofft* is probably controlling.

be able to ignore such testimony when performing the “total concept and feel” intrinsic test.<sup>84</sup> The outcome of cases should not vary solely with whether or not the fact finder was able to follow instructions that she ignore previous expert testimony and focus on her immediate reaction to the “total concept and feel” of the works before her.

2. *Judicial value judgments influence application of the idea-expression dichotomy and the merger doctrine*

The definition of the idea is one of the most important determinations in a copyright infringement case. If the idea is defined broadly, infringement is less likely because fewer elements of the plaintiff’s work will be considered expression and there will be a higher likelihood that the court will conclude that such expression was dictated by the subject matter.<sup>85</sup> Conversely, if the idea is defined narrowly, there will be more expression and a higher likelihood that the defendant appropriated it.<sup>86</sup> For example, if the idea for the postcard in *Tiffany Design* is defined as “an aerial image of the Las Vegas Strip,” there will be more potential expression than if it is defined as “a computer-manipulated, photographic aerial image of the Las Vegas Strip.”

Unfortunately, there are no clear guidelines for courts making these decisions.<sup>87</sup> The guiding consideration has been described as “the preservation of the balance between competition and protection reflected in the patent and copyright laws.”<sup>88</sup> What may ultimately occur, however, is a

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84. See Alice J. Kim, *Expert Testimony and Substantial Similarity: Facing the Music in (Music) Copyright Infringement Cases*, 19 COLUM.-VLA J.L. & ARTS 109, 122 (1995) (explaining that “where the finder of fact is the same for both the extrinsic and intrinsic tests, it seems of doubtful value to ask the finder of fact to ‘forget’ the expert testimony when considering similarity of expression. . .”).

85. See Amy B. Cohen, *Copyright Law and the Myth of Objectivity: The Idea-Expression Dichotomy and the Inevitability of Artistic Value Judgments*, 66 IND. L.J. 175, 212 (1990).

86. See *id.* at 212.

87. See *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2nd Cir. 1960) (stating that “no principle can be stated as to when an imitator has gone beyond copying the ‘idea,’ and has borrowed its ‘expression.’”); see also Alfred C. Yen, *A First Amendment Perspective on the Idea/Expression Dichotomy and Copyright in a Work’s ‘Total Concept and Feel,’* 38 EMORY L.J. 393, 419, 433 (1989) (noting that inherent problems in the dichotomy lie in that the idea-expression distinction can be very difficult to make, often relies solely upon instinct, and “may be construed to imply either an extremely broad scope of copyright protection or a very narrow one” depending on how the idea is defined).

88. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971). See also *Warner Brothers, Inc. v. Am. Broad. Cos.*, 720 F.2d 231, 240 (2nd Cir. 1983) (explaining that the idea-expression dichotomy, though “imprecise” “enable[s]

judicial determination as to the artistic merit of a particular work.<sup>89</sup> Commentators argue that a judge's personal judgment as to what constitutes a creative, distinctive work is the most important factor influencing idea-expression determinations.<sup>90</sup> Additional factors include the commercial success of works and the reputations of their creators.<sup>91</sup> As applied to *Tiffany Design*, value judgments could lead a court which believes the Burton Image to be of artistic merit to define the idea as "an image of the Las Vegas Strip" instead of using either of the above options.

In addition to the idea-expression dichotomy, courts have the opportunity to use value judgments in their merger determinations. If there is only one way of expressing an idea, a court will have no option but to find merger; however, where there are more than a few ways of expressing the idea, the court can decide where to draw the boundaries of protectable expression according to policy considerations similar to those involved in the idea-expression decision.<sup>92</sup>

In a world where "persons trained only in the law" are supposed to refrain from making artistic judgments "outside of the narrowest and most obvious limits,"<sup>93</sup> this is quite problematic. The boundaries between idea and expression are perhaps better determined by resorting to expert testimony and considerations of the creativity expressed by the medium involved.

### 3. *Failure to consider medium and market needs*

While the different needs of each medium may influence a court's merger determination, the total concept and feel test fails to ensure that the needs of different types of works are met. Cases such as *Shaw* and *Apple Computer* provide hope that courts will consider media when deciding how to approach the question of substantial similarity, but without explicit adoption of similar rules, the pictorial arts, which have traditionally been considered in terms of the old rules, will not be guaranteed such treatment.

*Shaw's* discussion of different ranges of protection for different types of works is useful, but the blanket statement that representational works

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courts to adjust the tension between [the] competing effects of copyright protection:" promoting creativity by granting authors exclusive rights, and "deter[ring] the creation of new works if authors are fearful that their creations will too readily be found to be substantially similar to preexisting works").

89. See Cohen, *supra* note 85, at 208 & n.127, 212-20 (1990); English Sullivan, *supra* note 8, at 604-09.

90. See Cohen, *supra* note 85, at 208 n.127, 212-20.

91. See *id.*

92. See *id.* at 212, 230.

93. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

are of necessity given narrow protection is not because it ignores the fact that there are different types of representational works. Within the general category of representational works, works should be given broader protection than others depending on how much "visual fact" is involved. For example, in the graphic arts, where one can expect a certain "industry aesthetic" to occur through use of similar ideas, concepts, and common goals, the protection should at times be narrower than in areas such as fine art painting, where artists may tend to portray more individuality and creativity. More protection should be given to a work which is entirely composed of imagined creatures set in a never-before-seen fantasy world than a realistic image of a dog lying in a store-bought doghouse. The closer a work comes to exact portrayals of reality, or the more it relies on standard medium manipulations, the more similarity would be needed for a finding of infringement. Using the case of *Tiffany Design*, this can be illustrated by imagining two extreme possibilities for what the Burton Image may look like: if the image consists of a heavily manipulated and distorted view of the Las Vegas Strip in which the buildings are no longer in the correct order or proportion to each other, the image would deserve more protection than if it simply touches up or slightly alters the coloring or scale of a photograph which served as source material for the image.<sup>94</sup> The latter image, as nearly composed only of "visual facts," would require near identical similarity for a finding of infringement.

### C. Application of Ninth Circuit Law to the Visual Arts: The Need to Build upon *Apple Computer*

Many commentators have proposed alternatives to the current tests for substantial similarity. Among these, some propose a focus on the injury suffered by the plaintiff,<sup>95</sup> some talk of redefining derivative works,<sup>96</sup> and

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94. Because the district court's opinion is vague in its description of the extent of manipulation and creativity involved in the creation of the Burton Image, see *supra* text accompanying note 14, this Note is left to speculate about what the image looks like.

95. See Laura G. Lape, *The Metaphysics of the Law: Bringing Substantial Similarity Down to Earth*, 98 DICK. L. REV. 181, 202, 204 (1994) (arguing that substantial similarity be determined by a finding of "substantial harm," composed of either "economic harm, harm to reputation, loss of privacy, and loss of artistic control").

96. See, e.g., Naomi Abe Voegtli, *Rethinking Derivative Rights*, 63 BROOK. L. REV. 1213 (1997) (arguing that in order to advance the needs of appropriation artists, a 'derivative work' should be defined as "either (1) a work based significantly upon one or more pre-existing works, such that it exhibits little originality of its own or that it unduly diminishes economic prospects of the works used; or (2) a translation, sound recording, art reproduction, abridgment, and condensation.").

yet others argue that substantial similarity should be replaced entirely.<sup>97</sup> In reality, however, substantial similarity is probably here to stay, and a solution must be found through extensions of current law. Although several other commentators have proposed similar solutions,<sup>98</sup> this Note attempts to make a more detailed, workable test. In the case of the visual arts, many of the problems identified in the previous discussion could be solved by providing works with different levels of protection according to the specific needs of the field. This, if done with use of expert testimony in a step-by-step analysis similar to that used in *Apple Computer*, would restrict judicial value judgments and create a more workable system.

First, the idea should be defined and compared, the merger and *scenes-a-faire* doctrines considered, and a test of copyrightability, originality and functionality performed. For these steps, expert testimony and dissection should be used to avoid judicial value judgments affecting the inquiry, and the idea should be defined narrowly or broadly depending on the type of work involved and the level of creativity shown by the plaintiff. For the work involved in *Tiffany Design*, the idea should be defined as a computer manipulated, aerial photographic depiction of the Las Vegas Strip. Such an idea is quite predictable given modern technology's ability to manipulate photographs with a computer and the desirableness of the Las Vegas Strip as a subject for postcards. The merger doctrine or a finding of lack of originality could apply to the placement of different aspects of the strip in different areas of the postcard if these are logical design solutions given the subject matter of the image and the use of standard computer-manipulation techniques.

Next, the remaining expression should be filtered according to independent creation, licenses, conveyances, or similar considerations. While *Apple Computer* explicitly mentioned that licensed expression could not support a finding of infringement, it failed to mention the possibility of an artist independently creating part of the expression (perhaps because that

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97. See, e.g., Cohen, *supra* note 9, at 741-42 (proposing that the substantial similarity test be replaced with fair use considerations).

98. See, e.g., 4 NIMMER, *supra* note 8, § 13.03[E][1][b] (arguing that dissection and filtering should be performed not only in cases involving factual compilations and computer programs, but "across the gamut of copyright law" in order to prevent findings of substantial similarity from including considerations of non-protectable elements); Lawrence Jeffrey Sher, *The Search for a Suitable Standard of Substantial Similarity: The Ninth Circuit's Application of the Krofft Test*, 25 U.C. DAVIS L. REV. 229, 258-59 (1991) (proposing a four part test: (1) determining whether there is substantial similarity of ideas, (2) determining if the plaintiff's work contains any protectable material, (3) determining whether there is objective substantial similarity, and (4) determining whether there is intrinsic, "look and feel" substantial similarity).

was not an issue in the case). In a case such as *Tiffany Design*, where there is evidence that the defendant had begun work on its own image of the Las Vegas Strip prior to its encountering the plaintiff's image, a factual determination of independent creation should occur, and any expression found in the defendant's image that results from independent creation should be removed from the substantial similarity inquiry.

Finally, if there is enough remaining protectable expression, a substantial similarity inquiry should occur with respect to those elements. The level of similarity required for a finding of infringement should vary depending on the type of work involved and the amount of protectable expression in relation to the whole. While this step could use an ordinary observer audience as the trier of fact, this should be done in combination with expert testimony and dissection so that the inquiry considers only protectable elements. Even in a case such as *Tiffany Design*, where the intended audience for the works is an ordinary layperson, expert testimony would ensure that the fact finder keeps sight of the amount of protectable expression in the plaintiff's work and does not find substantial similarity by looking at non-protectable expression.

Although this proposal shies away from the traditional "total concept and feel" used by the Ninth Circuit, it is consistent with *Apple Computer*, and better advances the goal of copyright law of making new creative works available to the public. Because visual artists will benefit from stronger protection in works that exhibit a greater degree of creativity, those artists are given an incentive to invest their time in works which are unique and therefore beneficial to the public, instead of investing it in attempts to monopolize entire areas of subject matter via the use of a small amount of creative, protectable expression. Also, by using the aid of experts at every stage, the test insures that judicial value judgments do not cloud the outcome of cases, and makes it easier for those involved in the visual arts—usually experts themselves—to predict the scope of protection in different works of visual art. Authors are thus provided with an incentive to create a larger variety of works because they know how much creativity is needed to ensure copyright protection. In addition, more works will be created through artistic borrowing of non-protectable elements found in other works, which the authors may have previously been hesitant to use.

#### IV. CONCLUSION

*Tiffany Design* will bring the issue of substantial similarity in the context of visual art to center stage, and presents yet another opportunity for a



court to reinterpret its meaning and devise a clear path that other courts may follow in order to produce relatively consistent rulings. A creative interpretation of current case law can give the court the tools it needs to devise a workable test which better balances the competing goals of copyright law, meets the needs of the visual arts, and allows plaintiffs a reasonable prediction of the types of conduct impermissible under copyright law. A resolution of the battle of the postcards shall be anxiously awaited.

