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Transforming “Total Concept and Feel”: Dialogic Creativity and Copyright’s Substantial Similarity Doctrine

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TRANSFORMING “TOTAL CONCEPT AND FEEL”: DIALOGIC CREATIVITY AND COPYRIGHT’S SUBSTANTIAL SIMILARITY DOCTRINE♦

CARYS J. CRAIG*

ABSTRACT

Copyright infringement doctrine currently overprotects copyright owners against the perceived wrong of copying, failing to adequately countenance copying as an essential part of the authorial creative process. Drawing on existing infringement doctrine in the United States and Canada, this Article will offer an interpretation of “substantial similarity” that opens up (or at least better safeguards) space for creative copying—that is to say, copying that substantially transforms the original copied work and, in doing so, advances the public interest goals of the copyright system. Part I lays the groundwork by briefly presenting a dialogic vision of authorship that complicates conventional assumptions around creativity, originality, and copying. Part II offers an overview of the ways in which existing copyright doctrine can accommodate the realities of dialogic authorship, first through the fair use doctrine, and then turning to the potential role of a more rigorous substantial similarity doctrine to better mediate the copying/creativity divide. Part III explores divergent approaches to substantiality determinations, contrasting a holistic comparison approach that takes into account a work’s “total concept and feel” with a more granular approach that “dissects” the copyright work into protectable and unprotectable elements. Overprotection of the plaintiff’s work is the obvious risk of the holistic

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approach, failing as it does to adequately circumscribe the boundaries of the copyright owner's claim to exclusivity. The holistic comparison test also contains within it, however, the possibility of a greater appreciation of the dialogic relationship between the two works. As Part IV argues, reorienting copyright's holistic "total concept and feel" test could provide the necessary space in copyright infringement doctrine to permit transformative copying of protected works without requiring resort to the fair use defense. It turns out that courts holistically comparing the "total concept and feel" of works may have been asking the right question all along—albeit typically for the wrong reason.

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INTRODUCTION

Copyright law is concerned with the exclusive right to copy. But what is a copy? For centuries now, common law courts have struggled to define the limits of the author's exclusive right to copy, and the circumstances in which that right might be infringed by something other than an identical and wholesale reproduction of a protected work. Courts across the United States and the common law world have formulated a variety of more or less convoluted legal tests that differ in their technical or semantic details; but the broader dimensions of the resulting

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doctrine—and the tensions they inevitably produce—are remarkably consistent across time and place.

First, there arises the factual question as to whether an act of copying has indeed occurred. This first step typically involves an assessment of the similarities between two works and the probability, under the circumstances, that such similarities are causally connected and not merely coincidental. Second, there comes the critical inquiry into whether such copying, if established, amounts to unlawful taking or “improper appropriation.” This second step demands an evaluation of what and how much has been copied from the protected work, and whether it is sufficiently “substantial” to render the alleged copy *prima facie* infringing. In this respect, courts have struggled with whether to approach the assessment holistically, comparing the works as a whole, or through a more careful dissection process, identifying and examining the copyrightability of the particular pieces that the works share in common. In U.S. cases, this struggle manifests most obviously as the divergence between the so-called “total concept and feel” test (as coined fifty years ago by the Ninth Circuit in *Roth Greeting Cards v. United Card Co.*),¹ and the “Abstraction-Filtration-Comparison” test articulated by the Second Circuit in *Computer Associates International, Inc. v. Altai, Inc.*² In Canada, more recently, it has been presented as a choice between a “weeding out” approach that expressly endorses the U.S. *Altai* approach, and a “holistic comparison” test that rejects *Altai* in favor of U.K. precedent.³

The question of how best to assess the substantiality of copying arises, of course, because not all copying is legally wrongful, and not every part of a protected work is within the scope of the copyright owner’s exclusive domain. The work, while claimed as the singular object of the copyright owner’s right, is not protected by copyright law in its entirety—thus, as Justice Learned Hand explained, an author’s “copyright [does] not cover everything that might be drawn from” their work.⁴ Rather, the divide between copyright and the public domain is one that traverses the work; only original protectable elements attributable to the author fall within the scope of their exclusivity. While an owner can

¹ *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970); see generally 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A] (2020).

² *Comput. Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706-12 (2d Cir. 1992) (building upon the “abstractions” test established in *Nichols v. Universal Pictures Corp.*); see *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (enunciating the theoretic framework for the “abstractions” test, under which substantial similarity is analyzed).

³ See *Cinar Corp. v. Robinson*, [2013] 3 S.C.R. 1168, para. 35 (Can.); see also *Designers Guild Ltd. v. Russell Williams (Textiles) Ltd.* [2000] UKHL 58, [2000] 1 WLR 2416 (Eng.).

⁴ *Nichols*, 45 F.2d at 122.

control a “substantial part” of their copyrightable expression, then, they cannot control “every ‘particle.’”⁵

It is the second step of the infringement analysis that is the focus of this Article, for the substantiality determination goes directly to the core of a well-recognized copyright policy conundrum: If the creative process necessarily demands some degree of inspiration and borrowing from preexisting works, can the copyright system reasonably prohibit copying without becoming an obstacle to the very creative processes that it is meant to encourage? How much copying must it permit and in what circumstances if it is to further the objective of incentivizing creativity and promoting progress? With these framing questions in mind, we can turn to the doctrinal dilemma with which this Article is concerned: On what basis should a work that copies from another work be reduced to the status of a derivative *infringing copy*—and when should it nonetheless be hailed as a *prima facie* non-infringing *new work*?

As a starting point, it is my general contention that copyright infringement doctrine currently overprotects owners against the perceived wrong of copying, failing to adequately countenance copying as an essential part of the authorial creative process (or creativity as part of an authorial copying process, for that matter). In what follows, drawing on existing copyright infringement doctrine in the United States and Canada in particular, I will offer an interpretation of “substantial similarity” that opens up (or at least better guards) space for *creative copying*—that is to say, copying that substantively transforms the original copied work, in its “total concept and feel,” and therefore advances the ultimate goals of the copyright system.

Part I lays the groundwork by briefly presenting a dialogic vision of authorship that complicates traditional assumptions around creativity, originality, and copying. Part II considers the ways in which existing copyright doctrine can accommodate the realities of dialogic authorship through the fair use doctrine before turning to the potential role of the substantial similarity doctrine in better mediating the copying/creativity divide. In Part III, I explore various jurisprudential approaches to the substantiality determination, contrasting a more impressionistic “holistic” comparison approach with a more granular approach that “dissects” works and filters out unprotected elements before comparing what remains. In Part IV, I argue that a reoriented version of copyright’s holistic “total concept and feel” test could provide the necessary space in copyright infringement doctrine to permit transformative copying of protected works without requiring resort to the fair use defense.

⁵ *Cinar Corp.*, 3 S.C.R. at para. 25 (quoting DAVID VAVER, INTELLECTUAL PROPERTY LAW: COPYRIGHT, PATENTS, TRADE-MARKS 182 (2d ed. 2011)).

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The proposed “reverse dissection” approach to the unlawful appropriation analysis would begin by asking, first, whether a defendant’s work is substantially similar to, or different from, the work from which it copied *in its* “total concept and feel.” If it is substantially *different* from the plaintiff’s work when compared holistically, it should be recognized as a *non-infringing new work*—an example of dialogic creativity to be encouraged, as opposed to duplicative copying to be enjoined. Only if this initial holistic comparison produces a finding of substantial *similarity* in “total concept and feel” would it be necessary to embark on a dissective analysis, which should be guided by expert evidence as required. And only if a final comparison reveals a substantial similarity between the defendant’s work and the *protected* elements of the plaintiff’s work should it be necessary to proceed to consideration of a fair use defense.

As it turns out, I will conclude, decision-makers impressionistically assessing whether works are substantially similar in their “total concept and feel” may have been asking the right question all along—albeit usually for the wrong reason.

I. CONCEPTUALIZING CREATIVITY

A. *The Originality Myth (and Its Implicit Morality)*

It is, by now, trite to insist that there is no such thing as truly original *de novo* authorship.⁶ Copyright protects only original literary, dramatic, musical or artistic expression, it is true, but “original” in this respect is a legal term of art: Nothing is created out of nothing, after all. The law recognizes that originality is, in fact, a minimal threshold to achieve in order for copyright protection to attach. It demands a mere modicum of creativity, or a splash of skill and judgment in the selection and arrangement of elements, in order for the resulting work to be recognized in law as a copyright-protected work of expression in which exclusive rights subsist.⁷ It asks for no objective novelty or innovation, and no subjective aesthetic quality, never mind a feat of creative genius.⁸ It is, then, not because of the quality of their substance but just the sheer fact of their seemingly individual origination that works are thought to merit

⁶ See Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 966 (1990), <https://repository.law.umich.edu/cgi/viewcontent.cgi?article=1221&context=articles> [<https://perma.cc/PD72-S79N>] (describing the very act of authorship as being “more akin to translation and recombination than it is to creating Aphrodite from the foam of the sea”).

⁷ See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340 (1991); see also *CCH Canadian Ltd. v. Law Soc’y of Upper Canada*, [2004] 1 S.C.R. 339 (Can.).

⁸ See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903); see also *George Hensher Ltd. v. Restawile Upholstery (Lancs.) Ltd.* [1976] AC 64 (HL) 78-79 (appeal taken from Eng.); see also *Hay & Hay Constr. Co. Ltd. v. Sloan* (1957), 12 D.L.R. 2d 397, para. 5 (Can. Ont. H.C.).

protection. And yet, with this easily acquired badge of originality, the work magically manifests, in our legal imagination, as a new “thing” unto itself—a quasi-proprietary object, no less—to be owned and occupied, exploited and enjoyed, only by or with the permission of the rightholder.

Copyright law protects “original” works, and it prevents “copying.” The moral imperative behind these aphorisms is clear: Be original! Do not copy! Originality is valued over imitation; creativity over copying. The complicating factor, when it comes to recasting the moral equation into workable legal rules, is that originality necessarily involves some degree of imitation, and creativity requires a certain amount of copying.⁹ It falls to copyright law to mediate these binaries (originality/imitation, creativity/copying) in order to determine who is a meritorious author-owner whose expressive activities should be encouraged, and who is a mere copier-infringer whose expressive activities should be enjoined.¹⁰

At the outset of a copyright infringement action, then, the roles are essentially assigned: The plaintiff steps into the role of presumed originator, and the defendant into the role of alleged copier. The authorial processes undertaken by each party in the creation of their respective work are appraised accordingly: For the plaintiff, the expectation is minimally original authorship in the creation of the work; for the defendant, originality is, strictly speaking, neither here nor there—the question is whether the defendant’s work nonetheless involved substantial copying of the plaintiff’s work. The court is concerned, in the infringement analysis, not with the defendant’s creativity as author, but only their culpability as copier. This is crisply captured in Justice Learned Hand’s famous observation: “no plagiarist can excuse the wrong by showing how much of his work he did not pirate.”¹¹

While there are, as we shall see in what follows, some doctrinal nuances to these assertions, the point for now is a larger one about

⁹ See Litman, *supra* note 6; see also Olufunmilayo B. Arewa, *The Freedom to Copy: Copyright, Creation, and Context*, 41 U.C. DAVIS L. REV. 477, 481 (2007), https://lawreview.law.ucdavis.edu/issues/41/2/articles/davisvol41no2_arewa.pdf [<https://perma.cc/7EFC-DPTR>] (“As a result of the stigmatization of copying, legal analysis of copyright, copying, and creation does not sufficiently recognize the importance of the freedom to copy as an integral part of processes of creation.”); see generally MARILYN RANDALL, *PRAGMATIC PLAGIARISM: AUTHORSHIP, PROFIT, AND POWER* (2001).

¹⁰ See Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of “Authorship”*, 1991 DUKE L.J. 455, 472 (1991), <https://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=3150&context=dlj> [<https://perma.cc/6WU2-RG9D>]; see also Keith Aoki, *Adrift in the Intertext: Authorship and Audience “Recoding” Rights—Comment on Robert H. Rotstein*, “Beyond Metaphor: Copyright Infringement and the Fiction of the Work”, 68 CHI.-KENT L. REV. 805 (1993), <https://scholarship.kentlaw.iit.edu/cgi/viewcontent.cgi?article=2893&context=cklawreview> [<https://perma.cc/76TD-G2KS>]; see also James D.A. Boyle, *The Search for an Author: Shakespeare and the Framers*, 37 AM. U. L. REV. 625 (1988), https://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=5781&context=faculty_scholarship [<https://perma.cc/DK7J-K6T3>]; see also MARK ROSE, *AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT* (1995).

¹¹ *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936).

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positioning and power. The problem with placing the claimed originator in a privileged position over the accused copier in this legal (and moral) equation is that it renders virtually invisible the copying that was inevitably part of the plaintiff’s creative processes, while it discounts the significance of any creativity that was part of the defendant’s copying processes. In doing so, it hierarchizes authors in a way that fails to reflect the true messiness of creative practice—the eclectic range of methods and expressive modes that are part of authorship. As Julie Cohen has argued, the law, in its usual quest for economic fixity and predictability, therefore fails to accommodate the fluid realities of creative play and so distorts, in damaging ways, the essential authorial (indeed simply human) processes of “working through culture.”¹² And, of course, it ought not to surprise us that the hierarchized vision of creator/copier frequently maps onto other hierarchies of social and cultural power.¹³ It is worth underscoring, if only in passing, that there are, therefore, politics at play in any move to disrupt the creator/copier divide.

B. Dialogic Creativity and the Text as Utterance

Copyright’s focus on originality is salient for our purposes insofar as it produces a distorted picture of authorship, undermining the importance of influence, and obscuring the discursive relations between texts and authors. As I have argued elsewhere,¹⁴ the copyrightable work is not a separate thing unto itself but, as a text—an act of communication—it can be understood only in dialogic relation to other texts.¹⁵ As Roland Barthes evocatively explained, “a text is made of multiple writings, drawn from many cultures and entering into mutual relations of dialogue, parody, [and] contestation.”¹⁶ Drawing on the insights of Russian philosopher and literary scholar Mikhail Bakhtin, it follows that all works—in Bakhtinian terms, all *utterances*—should be understood as interactive and inter-animating, containing within them a clamorous *multivocality*.¹⁷ Put more simply, no work can be understood

¹² JULIE E. COHEN, CONFIGURING THE NETWORKED SELF: LAW, CODE, AND THE PLAY OF EVERYDAY PRACTICE 103-04 (2012).

¹³ See generally Elizabeth L. Rosenblatt, *Copyright’s One-Way Racial Appropriation Ratchet*, 53 U.C. DAVIS L. REV. 591 (2019), https://lawreview.law.ucdavis.edu/issues/53/2/articles/files/53-2_Rosenblatt.pdf [<https://perma.cc/3TKX-V2SP>].

¹⁴ See generally Carys J. Craig, *Reconstructing the Author-Self: Some Feminist Lessons for Copyright Law*, 15 AM. U. J. GENDER, SOC. POL’Y & L. 207 (2007), <https://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?referer=https://www.google.com/&httpsredir=1&article=1109&context=jgspl> [<https://perma.cc/X6L6-JPLZ>] (employing feminist literary and political theory to reimagine authorship through a feminist lens); see also Carys Craig & Ian Kerr, *The Death of the AI Author*, 52(1) OTTAWA L. REV. 31 (2021), <https://rdo-olr.org/2021/the-death-of-the-ai-author/> [<https://perma.cc/RC8D-Y5D8>].

¹⁵ See M. M. BAKHTIN, THE DIALOGIC IMAGINATION: FOUR ESSAYS 354 (Michael Holquist ed., Caryl Emerson & Michael Holquist trans., 1981).

¹⁶ ROLAND BARTHES, IMAGE—MUSIC—TEXT 148 (Stephen Heath trans., 1977).

¹⁷ See BAKHTIN, *supra* note 15, at 354-56.

in isolation, reduced to the voice of a single author, attributed solely to his individual imagination, or elevated out of the cultural cacophony. This vision of the text rejects the notion of the work as autonomous or independent from other texts or links in the “utterance chain.”¹⁸ And this, I suggest, presents a potent challenge to copyright’s existing structures of control—as well as illuminating a path toward their improvement.

In her work on relational dialectics, communications scholar Leslie Baxter offers a helpful typology of Bakhtin’s utterance chain in the context of interpersonal communications that neatly depicts the nature of this challenge.¹⁹

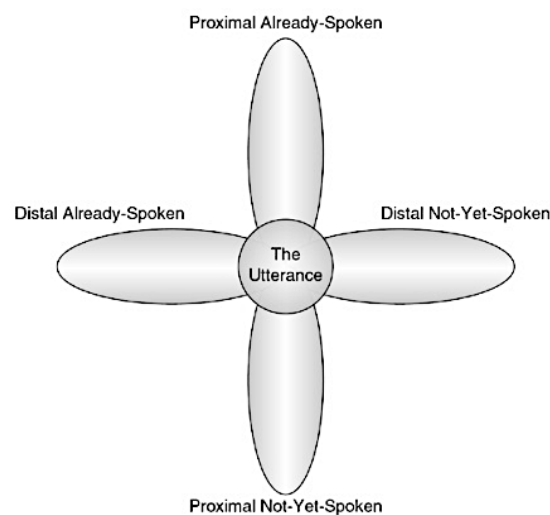


Figure 1: The Utterance Chain²⁰

The four petals in the diagram above illustrate the relationship between any particular utterance, that which has been said before, and that which is anticipated by way of response.²¹ Whether looking backward (to the *already-spoken*) or forward (to the *not-yet-spoken*), the utterance stands in relation to other *proximal* utterances (those spoken

¹⁸ M. M. BAKHTIN, *The Problem of Speech Genres*, in *SPEECH GENRES AND OTHER LATE ESSAYS* 60, 91-93 (Caryl Emerson & Michael Holquist eds., Vern W. McGee trans., 1986), <https://ia800802.us.archive.org/25/items/SpeechGenresAndOtherLateEssays/Speech%20Genres%20and%20Other%20Late%20Essays.pdf> [<https://perma.cc/R8EZ-BD5X>].

¹⁹ LESLIE A. BAXTER, *VOICING RELATIONSHIPS: A DIALOGIC PERSPECTIVE* 50-51 (2010) (developing a typology, previously presented by Baxter and Montgomery, “of four distinct forms of utterance links that are implicated in a given utterance” (citing LESLIE A. BAXTER & BARBARA M. MONTGOMERY, *RELATING: DIALOGUES & DIALECTICS* (1996))).

²⁰ *Id.* at 50 (“Figure [1] presents a visual metaphor of the components of the utterance chain.”).

²¹ *Id.* (“This flowerlike visual metaphor presents the utterance as the center, interdependent with four kinds of petals that can be understood as the four kinds of links in the utterance chain. These petals are comprised of discourses that come together in a given utterance to construct its meaning.”).

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in direct or immediate communicative relation to the speaker) and to *distal* utterances (“cultural communications” that circulate more widely in the culture at large).²² As Baxter explains, “[E]ach individual utterance can be thought of as the site in the utterance chain where already uttered discourses voiced by others come together with discourses anticipated in others’ responses.”²³ As such, “[a] dialogically informed analysis of . . . communication thus begins with an identification of the distal already-spoken that interanimate talk,” while recognizing that each communication also anticipates a response from an immediate or imagined audience, as well as from generalized others (Bakhtin’s *superaddressee*).²⁴ “A[ny] given utterance ‘is [therefore] filled with echoes and reverberations of other utterances to which it is related’” on each of these axes.²⁵ It is along this “chain of speech communion” that meaning-making happens.²⁶

This quick foray into communications theory should help to lay bare the challenge that Bakhtin’s theory of language presents for copyright law. With respect to “originality” as such, Bakhtin observed that “the single utterance, with all its individuality and creativity, can in no way be regarded as a completely free combination of forms.”²⁷ For Bakhtin, any utterance (for our purposes, let us say, any work) is, rather, a profoundly intertextual social unit.²⁸ “The speaker [(call him copyright’s original author)] is not the biblical Adam, dealing only with virgin . . . objects”²⁹ Bakhtin continues:

The speaker is not Adam, and therefore the subject of his speech itself inevitably becomes the arena where his opinions meet . . . others’ speech . . . and it cannot but be reflected in the utterance. . . . [A]n utterance is a link in the chain of speech communication, and it cannot be broken off from the preceding links that determine it both from within and from without, giving rise within it to unmediated responsive reactions and dialogic reverberations.³⁰

I have argued elsewhere, drawing on dialogic theory, that the mischaracterization of authorship as an individualized exercise, especially when combined with the allocation of stable property-like attributes to the authored work, leads to a copyright system that unduly

²² *Id.* (“Distal versus proximal captures the temporal proximity of prior (and anticipated) utterances to the immediate utterance.”).

²³ *Id.*

²⁴ *Id.* at 52-53.

²⁵ *Id.* at 50 (quoting BAKHTIN, *supra* note 18, at 91).

²⁶ *Id.* (quoting BAKHTIN, *supra* note 18, at 93).

²⁷ BAKHTIN, *supra* note 18, at 81 (emphasis omitted).

²⁸ BAXTER, *supra* note 19, at 52.

²⁹ BAKHTIN, *supra* note 18, at 93.

³⁰ *Id.* at 94.

restricts expressive engagement and creative practice.³¹ As the law that allocates rights over—and regulates our interactions with—expressive works, copyright law should reflect the relational nature of the authored text and accommodate the dialogic processes that produce it. Conceptually situating the author in their cultural context, and placing the protected work within a chain of utterances, illuminates a challenge to copyright law and its treatment of downstream authors and works: If its normative imperative is to encourage creativity and the exchange of meaning, then copyright law, which grants individual control over the *already-spoken*s, must promote the creation of new works as *dialogic utterances*—and still leave space for the *not-yet-spoken*s.

With this conceptual framing in mind, then, let us turn to the question of whether and how copyright doctrine can do so.

II. ACCOMMODATING DIALOGIC CREATIVITY IN COPYRIGHT LAW: THE LIMITED FUNCTION OF FAIR USE

The dialogic challenge to copyright doctrine is not a new one. While the concepts of poststructuralist literary theory or communications studies may seem far removed from legal doctrine, the law of copyright has always had to accommodate the realities of human creativity and communication (these theories are, after all, meant to be descriptive of those realities) in order to advance its objectives—or at least to sustain its claim to legitimacy. The boundaries of the rights that copyright law grants have therefore always functioned to constrain the scope of control that an individual speaker can exert over the subsequent speech of others.

When copyright was, at its first inception and for some time thereafter, limited to “books” as printed, and controlled only “copies” of the book as a whole, the right did not extend to protect against derivative works that were meaningfully different in substance, form, or purpose from the original, even if they were simply abridgements or translations thereof.³² It is the expansion of the copyright interest to include not just “copies” per se but also derivatives, adaptations, and “colourable imitations” that has captured dialogic responses within its net.³³ With this

³¹ See generally CARYS J. CRAIG, COPYRIGHT, COMMUNICATION AND CULTURE: TOWARDS A RELATIONAL THEORY OF COPYRIGHT LAW (2011).

³² See Robert Burrell, *Reining in Copyright Law: Is Fair Use the Answer?*, 4 INTELL. PROP. Q. 361, 367-73 (2001); see also Kathy Bowrey, *On Clarifying the Role of Originality and Fair Use in Nineteenth Century UK Jurisprudence: Appreciating ‘the Humble Grey Which Emerges as the Result of Long Controversy’*, in THE COMMON LAW OF INTELLECTUAL PROPERTY: ESSAYS IN HONOUR OF PROFESSOR DAVID VAVER 45 (Catherine W. Ng et al. eds., 2010).

³³ See *Francis, Day & Hunter v. Feldman & Co.* [1914] 2 Ch 728 (Eng.). While U.S. copyright law separately defines “[a] ‘derivative work’ [as] a work based upon one or more preexisting works” in Section 101 of the Copyright Act, Canadian copyright law holds that any work that copies a substantial part of a preexisting work in contravention of its Copyright Act falls within the general category of “infringing work.” Compare Copyright Act, 17 U.S.C. § 101 (2018), <https://www.govinfo.gov/content/pkg/USCODE-2018-title17/pdf/USCODE-2018-title17-chap1-sec101.pdf>

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development, the boundaries of the copyright owner’s work—the limits of what could properly be claimed—were cast farther from the contours of the original author’s contribution and into muddier terrain. As Jessica Litman has explained, the boundaries of the copyrightable work (and its Other, the Public Domain) have since been doctrinally constructed through law in order to make possible—and palatable—a copyright system tasked with protecting original works against copying, when the inconvenient truth is that creativity requires copying and originality is little more than an apparition sustained by human hubris.³⁴

The myth of the wholly original work may disregard the realities of human communication captured by the utterance chain idea; but core components of copyright doctrine—from the recognition of the public domain to the idea-expression dichotomy, *scènes à faire*, the merger doctrine, and the exclusion of facts—can be regarded as means by which copyright law attempts to accommodate dialogism. With respect to those *distal* communications that circulate more broadly in our culture—ideas, information, shared genres, and common stock elements, for example³⁵—such unprotected ephemera can animate and reverberate in any utterance, unimpeded by copyright (or, at least, so the theory goes). The same doctrinal boundaries also make some room for *proximal* utterances insofar as the facts and information, shared language, common stock devices, and unoriginal expressions can be passed freely along the utterance chain as public domain elements, interanimating the dialogic exchange.

Even within the doctrinal confines of the copyrightable expressions, there are limits and exceptions to the rights that copyright owners can enforce, which also create space for such intertextuality. Most notably, even when a substantial portion of a protected work is copied, the fair use doctrine may permit such copying, rendering it lawful, if it is “fair.”³⁶ The

[<https://perma.cc/S5GB-MG4Y>], with Copyright Act, R.S.C. 1985, c C-42, § 2 (Can.), <https://laws.justice.gc.ca/PDF/C-42.pdf> [<https://perma.cc/7HEU-PRLB>]. Moreover, Section 16 of the United Kingdom’s Copyright, Designs and Patents Act provides that certain derivative works might fall within the category of infringing “adaptations” of the work. Copyright, Designs and Patents Act 1988, c. 48, § 16 (Eng.), <http://www.legislation.gov.uk/ukpga/1988/48/data.pdf> [<https://perma.cc/R3P7-T7K4>]. Notably, however, the U.S. is the only country to enforce a Copyright Act that grants copyright owners the exclusive right to control all derivative works. 17 U.S.C. § 106(2), <https://www.govinfo.gov/content/pkg/USCODE-2018-title17/pdf/USCODE-2018-title17-chap1-sec106.pdf> [<https://perma.cc/CWV6-4D7V>]; see generally Patrick R. Goold, *Why the U.K. Adaptation Right Is Superior to the U.S. Derivative Work Right*, 92 NEB. L. REV. 843 (2014), <https://digitalcommons.unl.edu/cgi/viewcontent.cgi?referer=https://www.google.com/&httpsredir=1&article=1221&context=nlr> [<https://perma.cc/S3A6-9DEH>] (explaining the differences between the two approaches to downstream works and the relative flaws of the U.S. derivative work right as being excessively broad and costly).

³⁴ Litman, *supra* note 6.

³⁵ For a further discussion of these doctrinal limitations on copyright’s scope, see discussion *infra* Part III. A.

³⁶ See 17 U.S.C. § 107, <https://www.govinfo.gov/content/pkg/USCODE-2018-title17/pdf/USCODE-2018-title17-chap1-sec107.pdf> [<https://perma.cc/9BPF-KUN4>].

fairness of an otherwise infringing use is determined through a multifactorial test that examines the purpose and character of the use, the nature of the work, the amount and substantiality of the portion used, and the likely effect on the market for the original.³⁷ The kinds of uses that might qualify as fair use (uses such as criticism, comment, news reporting, scholarship, etc.) and the present emphasis on the extent to which the downstream user has “transformed” the original work (creating a new meaning or conveying a different message)³⁸ all support the notion that the U.S. fair use doctrine effectively facilitates dialogism by design.³⁹

Indeed, the prototypical fair use scenario in U.S. copyright dovetails perfectly with the archetypal dialogic moment in Bakhtin’s theory: that of parody. Parody, for Bakhtin, is a perfect site of discursive struggle, an intertextual practice in which the utterance becomes deliberately, if indirectly, “double-voiced.”⁴⁰ Bakhtin portrays parody as a means of accomplishing a radical skepticism toward the ridiculed system of meaning through a communicative act of playfulness.⁴¹ By using a privileged discourse, the parodist simultaneously calls into question the dominant norms that produce that privilege, mixing official and unofficial in a juxtaposition of styles and codes of meaning. The discursive struggle thus plays out at the site of the distal *already-spoken*, in its use of shared systems of meaning; and also the proximal *already-spoken* if it employs another’s text as its target; and finally it is located at the site of the

³⁷ *Id.*; see *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994); see also *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87 (2d Cir. 2014); see also *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013); see also Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005*, 156 U. PA. L. REV. 549 (2008), [https://www.law.upenn.edu/journals/lawreview/articles/volume156/issue3/Beebe156U.Pa.L.Rev.549\(2008\).pdf](https://www.law.upenn.edu/journals/lawreview/articles/volume156/issue3/Beebe156U.Pa.L.Rev.549(2008).pdf) [<https://perma.cc/4Y96-C8NB>]; see also Neil Weinstock Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715 (2011), <https://law.lclark.edu/live/files/9132-lcb153netanelpdf> [<https://perma.cc/EBC8-68QY>]; see also Matthew Sag, *Predicting Fair Use*, 73 OHIO ST. L.J. 47 (2012), https://kb.osu.edu/bitstream/handle/1811/71532/OSLJ_V73N1_0047.pdf [<https://perma.cc/9JDL-Z5VH>]; see also Pamela Samuelson, *Possible Futures of Fair Use*, 90 WASH. L. REV. 815 (2015), <https://digitalcommons.law.uw.edu/cgi/viewcontent.cgi?article=4856&context=wlr> [<https://perma.cc/N8F8-G478>].

³⁸ See Clark D. Asay et al., *Is Transformative Use Eating the World?*, 61 B.C. L. REV. 905 (2020), <https://lawdigitalcommons.bc.edu/cgi/viewcontent.cgi?article=3850&context=bclr> [<https://perma.cc/4WTL-DUEY>] (arguing that now, more than ever before, U.S. courts are utilizing the transformative use doctrine to resolve questions of fair use); see also Amy Adler, *Fair Use and the Future of Art*, 91 N.Y.U. L. REV. 559, 563 (2016), <https://www.nyulawreview.org/wp-content/uploads/2018/08/NYULawReview-91-3-Adler.pdf> [<https://perma.cc/TRP3-QRKH>] (critiquing modern courts’ focus on transformative use in the context of contemporary visual arts).

³⁹ Cf. Annemarie Bridy, *Fearless Girl Meets Charging Bull: Copyright and the Regulation of Intertextuality*, 9 U.C. IRVINE L. REV. 293, 299 (2019), https://www.law.uci.edu/lawreview/vol9/no2/Online_Bridy.pdf [<https://perma.cc/7JQ8-77J2>] (arguing that “U.S. copyright law is hospitable to intertextuality by design”).

⁴⁰ See *id.* at 311 (“[I]n all possible varieties of parodistic discourse the relationship between the author’s and the other person’s aspirations remains the same: these aspirations pull in different directions, in contrast to the unidirectional aspirations of [singled-voiced (monologic) discourse].” (alterations in original) (quoting MIKHAIL BAKHTIN, PROBLEMS OF DOSTOEVSKY’S POETICS 194 (Caryl Emerson ed. & trans., 1984), https://monoskop.org/images/1/1d/Bakhtin_Mikhail_Problems_of_Dostoevskys_Poetics_1984.pdf [<https://perma.cc/2F2C-L6T5>])).

⁴¹ BAXTER, *supra* note 19, at 137 (citing BAKHTIN, *supra* note 40).

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proximal *not-yet-spoken* in anticipation that the parody will be recognized as such.⁴²

As Elizabeth Rosenblatt has demonstrated, Bakhtin’s exploration of *carnival*, in particular, can shed light on copyright’s struggle to accommodate multivocality.⁴³ Bakhtin connected the social forces behind the tradition of *carnival* with forms of literature and language that, similarly, playfully disrupt the dominant order and unsettle the monologic (single-voiced) societal ideal.⁴⁴ For Rosenblatt, Bakhtin’s dialogic theory provides us with an illuminating way to conceive of fair use: “Like the carnivalesque, fair uses employ the communicative tools of the establishment to convey a new, possibly contradictory meaning [F]air users of copyrighted work assign . . . new meanings to signs that would otherwise be locked into the single meaning controlled by the copyright owner.”⁴⁵

Employing a dialogic lens, Annemarie Bridy similarly points to the fair use doctrine as evidence that the U.S. Copyright Act “[p]resuppos[es] the dialogic nature of artistic production.”⁴⁶ For “second-degree authors” (those whose works “depend directly and often focally on one or more existing works”), she notes, the fair use doctrine gives considerable “flexibility in their intertextual engagements.”⁴⁷ By permitting these authors to engage (or in Julia Kristeva’s terms, to “absorb” and “reply to”) preexisting works in highly transformative ways, fair use clears the path most notably for antagonistic intertextuality, precluding the possibility of “veto by authors whose aesthetics skew monologic.”⁴⁸ For Bridy, the United States’ flexible fair use doctrine is thus an essential component of the Copyright Act “[g]rounded in the premise that intertextuality is intrinsic to acts of authorship”⁴⁹

There are, however, clear shortcomings to relying on fair use to accommodate dialogic creativity within copyright’s structures. Most fundamentally, there is the conceptual objection that, like carnival, fair use exists “in the zone of the anomalous.”⁵⁰ If fair uses like criticism, parody, satire, scholarship, and so forth map conceptually onto the

⁴² *Id.*

⁴³ Elizabeth L. Rosenblatt, *Fair Use as Resistance*, 9 U.C. IRVINE L. REV. 377, 386 (2019), <https://scholarship.law.uci.edu/cgi/viewcontent.cgi?article=1349&context=ucilr> [<https://perma.cc/KC7B-8JQK>].

⁴⁴ See GRAHAM ALLEN, *INTERTEXTUALITY* 217 (2d ed. 2011).

⁴⁵ Rosenblatt, *supra* note 43, at 388-89.

⁴⁶ Bridy, *supra* note 39, at 316.

⁴⁷ *Id.*

⁴⁸ *Id.* at 317.

⁴⁹ *Id.* at 315.

⁵⁰ Cf. Clair Wills, *Upsetting the Public: Carnival, Hysteria and Women’s Texts*, in BAKHTIN AND CULTURAL THEORY 85, 93 (Ken Hirschkop & David Shepherd eds., 2d ed. 2001) (contemplating whether “women may have a different relationship to carnival, since . . . they are both placed together in the zone of the anomalous”).

carnavalesque, then—like carnival—fair uses occur with the blessing of the dominant social order “only within certain authority-defined parameters.”⁵¹ They are protected (or tolerated) by social and legal expectations only within their established constraints. Carnival days offer a moment of release and playful revolt for the people. Understood in this way, the “breathing space” that fair use affords within the constraints of the copyright system looks more like an “escape valve”: It “permit[s] people to communicate in dialogue with copyrighted works without defying or losing all respect for the copyright system.”⁵² In other words, fair use offers a safe route for measured release, not with a view to fundamentally disrupting the dominant order of private exclusivity, but rather, with the promise of enabling its peaceful continuation. In this sense, relying on the fair use defense to accommodate such dialogic creativity at the margins of the copyright system ultimately supports and sustains a more pervasive monologic ideal.

Moreover, as I have argued elsewhere, the defendant who is forced to rely on a successful fair use defense to avoid infringement liability is already cast on the wrong side of copyright’s moral equation, as the would-be free rider placed in juxtaposition with the plaintiff as meritorious of producer value.⁵³ On the defensive, by definition, the fair user must excuse their use of the original author’s work, pleading for an exception to be made to the general rule that would render such copying unlawful.⁵⁴ Operating *ab initio* within the realm of the exception, defenses tend to be narrowly confined and reluctantly conceded. The would-be fair user is required to provide a contextual justification for their use of the plaintiff’s work by explaining their purpose and the way in which they used the work; the extent to which their use was transformative in meaning or message; whether their use was commercial or non-commercial; whether the copied work was published or private; whether it was core or peripheral to copyright’s protective purposes; and whether their act of copying might harm the plaintiff’s economic interests or the value of the original work in the marketplace.⁵⁵

⁵¹ Rosenblatt, *supra* note 43, at 389.

⁵² *Id.* at 390 (“[F]air use is resistance without rebellion.”).

⁵³ See CRAIG, *supra* note 31, at 139.

⁵⁴ See Lydia Pallas Loren, *Fair Use: An Affirmative Defense?*, 90 WASH. L. REV. 685 (2015), <https://digitalcommons.law.uw.edu/cgi/viewcontent.cgi?article=4853&context=wlr> [https://perma.cc/G5QF-FZSB] (arguing that fair use should not be treated as an affirmative defense but as a component of a holistic infringement analysis aimed at establishing whether an allegedly infringing use exceeded a copyright’s scope).

⁵⁵ See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). Nothing here is intended to undermine the notion of fair use or fair dealing as a positive “user right” rather than merely a defense. See *CCH Canadian Ltd. v. Law Soc’y of Upper Canada*, [2004] 1 S.C.R. 339 (Can.). However, even properly construed as a user right, fair use has its conceptual limits, being subject always to “balance” with the countervailing rights of the copyright-owning author. See Carys J. Craig, *Globalizing User Rights-Talk: On Copyright Limits and Rhetorical Risks*, 33 AM. U. INT’L

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The fair use doctrine thus favors a certain kind of activity and expressive engagement with the protected work and effectively conditions the lawfulness of that engagement on the prior claims, expectations, and economic interests of the original author/owner.⁵⁶ However, it does not, by any means, place the author/owner and the user on equal footing.⁵⁷ Moreover, because arguing for fair use comes with an onerous burden and an unpredictable outcome, conditioning lawful use on the affirmative fair use defense presents inevitable risks to a user/defendant—risks that will chill expression and, in many cases, reinforce or compound the vulnerabilities that accompany litigants from the cultural into the legal realm. Rosenblatt is surely correct to conclude that fair use—while making doctrinal space for the dialogic—nonetheless reinforces author-hierarchies that undermine copyright’s larger commitment to intertextual speech and the dialogic ideal.⁵⁸

Finally, and on a more practical note, it should also be recalled that the flexible, open, and general fair use doctrine that accommodates parody and transformative uses is available only in the United States and a handful of other jurisdictions,⁵⁹ but is not currently found in the copyright law of Canada, the United Kingdom, or elsewhere in the common law world (and even less so in the civil law world).⁶⁰ Canada

L. REV. 1 (2017), <https://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=1944&context=auilr> [<https://perma.cc/4TT7-CYPT>].

⁵⁶ See Cathay Y. N. Smith, *Political Fair Use*, 62 WM. & MARY L. REV. (forthcoming 2020) (“In disputes arising from the unauthorized political uses of copyrighted works, courts appear to implicitly modify their analyses . . . of the fair use factors . . . to . . . accommodate the import of political speech . . . Under the courts’ political fair use analysis, one determination—the nature of the original copyrighted work—seems to exert an outsized influence on the determination of all four fair use factors, [thereby] permitting certain unauthorized political uses of copyrighted works to appear presumptively fair.”).

⁵⁷ See Rosenblatt, *supra* note 43, at 392-400; see also Bitu Amani, *Copyright and Freedom of Expression: Fair Dealing Between Work and Play*, in DYNAMIC FAIR DEALING: CREATING CANADIAN CULTURE ONLINE 43, 45 (Rosemary J. Coombe et al. eds., 2013) (arguing that copyright law “privileges a particular elitist vision of culture in which only creators and distributors of works speak expressively and, in turn, use these privileges to silence the playful expressions of others”).

⁵⁸ See Rosenblatt, *supra* note 43, at 379. Uncertainty, particularly in the context of economic hierarchies, can also pave the way for a gradual extension of the presumptive zone of private exclusivity. See James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 882 (2007), https://www.yalelawjournal.org/pdf/519_8mm42tz5.pdf [<https://perma.cc/5VX7-CHAS>] (arguing that unpredictable liability causes risk-averse intellectual property users to seek unnecessary licenses, with the result that, over time, the public privilege recedes and rights expand).

⁵⁹ Israel, Liberia, Malaysia, the Philippines, Singapore, South Korea, Sri Lanka, and Taiwan have adopted the fair use regime or a close variant.

⁶⁰ The fair dealing defense, originally enacted in the United Kingdom’s Copyright Act of 1911 and exported to commonwealth jurisdictions, is generally confined to a closed list of enumerated purposes. See Copyright Act 1911, 1 & 2 Geo. 5 c. 46, § 2(1)(ii) (Eng.), http://www.legislation.gov.uk/ukpga/1911/46/pdfs/ukpga_19110046_en.pdf [<https://perma.cc/2DCC-CJ7K>]; but see Ariel Katz, *Fair Use 2.0: The Rebirth of Fair Dealing in Canada*, in THE COPYRIGHT PENTAGON: HOW THE SUPREME COURT OF CANADA SHOOK THE FOUNDATIONS OF CANADIAN COPYRIGHT LAW 93 (Michael Geist ed., 2013), <https://library.oapen.org/bitstream/id/59c08b4f-2f36-4759-bae3-c9411f63c072/515360.pdf> [<https://perma.cc/B4FL-YKW2>] (contesting the conventional wisdom that fair dealing is really so limited). Civil law jurisdictions tend to have an extensive list of

has quite recently added to its more restrictive “fair dealing” provision the possibility that use of a protected work for the purposes of “parody or satire” could benefit from the defense.⁶¹ However, despite Canada’s Supreme Court emphasizing the importance of giving such purposes “a large and liberal” interpretation in order to protect “user rights” and advance the purposes of copyright,⁶² recent case law continues to suggest a limited scope for defendants to successfully mount a fair dealing defense when substantial copying is found.⁶³ Meanwhile, international efforts to globalize and transplant U.S.-like fair use are repeatedly challenged and commonly derailed—often by virtue of pressures imposed by U.S. trade interests and industry actors.⁶⁴ If the copyright system at large is to be capable of accommodating dialogic creativity, it will not suffice to point to a fair use defense that is domestically hard-fought, jurisdictionally limited, and internationally fraught.

In the following Part, then, I want to shift our focus away from the fair use defense as guardian of dialogic creativity and turn our attention back to the limited scope of the copyrightable work. For it is, first of all, in the essential limits of *what* copyright protects, that we might more effectively rein in the reach of copyright control and thereby better facilitate all of those *not-yet-spoken* still to come.

narrowly drawn and conditional exceptions or limitations rather than a general and open-ended equivalent to fair use. See Christophe Geiger et al., *The Three-Step Test Revisited: How to Use the Test’s Flexibility in National Copyright Law*, 29 AM. U. INT’L L. REV. 581, 583-84 (2014), <https://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=1816&context=auilr> [https://perma.cc/A2VZ-ARWE]; see also P. Bernt Hugenholtz & Martin R.F. Senfleben, *Fair Use in Europe. In Search of Flexibilities* 26-27 (Inst. for Info. Law, Research Paper No. 2012-33, 2011), <https://core.ac.uk/download/pdf/15478131.pdf> [https://perma.cc/73T6-QAH3] (explaining that, given the restrictive approach to exceptions and limitations in the European Union, greater flexibility for transformative works may be found by narrowly defining the author’s right of adaptation, which is outside the EU *acquis*).

⁶¹ See Copyright Act, R.S.C. 1985, c C-42, § 29 (Can.).

⁶² CCH Canadian Ltd. v. Law Soc’y of Upper Canada, [2004] 1 S.C.R. 339, para. 51 (Can.); see Alberta v. Canadian Copyright Licensing Agency, [2012] 2 S.C.R. 345 (Can.); see also Soc’y of Composers, Authors & Music Publishers v. Bell Can., [2012] 2 S.C.R. 326 (Can.).

⁶³ See Canadian Copyright Licensing Agency v. York Univ., [2018] 2 F.C.R. 43 (Can.); see also United Airlines, Inc. v. Cooperstock, [2018] 1 F.C.R. 188 (Can.).

⁶⁴ See Peter K. Yu, *Customizing Fair Use Transplants*, LAWS, Mar. 2018, at 1 <https://scholarship.law.tamu.edu/cgi/viewcontent.cgi?article=2253&context=facscholar> [https://perma.cc/H8YX-2945] (examining the increasing efforts to transplant fair use into the copyright system based on the U.S. model); see also Niva Elkin-Koren & Neil Weinstock Netanel, *Transplanting Fair Use Across the Globe: A Case Study Testing the Credibility of U.S. Opposition*, 72 HASTINGS L.J. (forthcoming 2020), <https://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=1052&context=research> [https://perma.cc/ZS2K-C7HT]. Jurisdictions such as Australia, Hong Kong, Ireland, Canada, and South Africa have advanced proposals to facilitate the adoption of an open-ended fair use defense—so far, without success. See, e.g., Denise Nicholson, *South Africa’s Copyright Amendment Bill – One Year On*, INFOJUSTICE (Mar. 30, 2020), <http://infojustice.org/archives/42212> [https://perma.cc/LZK4-R3V8] (discussing the ongoing struggle to adopt fair use in South Africa).

III. RE-CENTERING COPYRIGHT’S INFRINGEMENT DOCTRINE

A. *The Limited Scope of Copyright*

As I mentioned in passing above, copyright law is rather replete with doctrines aimed at defining the limited scope of copyrightable expression, and so circumscribing the reach of the rightholder’s claim to exclusivity.⁶⁵ The idea-expression dichotomy is perhaps the paradigmatic example, drawing a line (however arbitrary or elusive it may be) between protectable expression (whether literal or non-literal) and unprotectable ideas (however creative or laborious their origins).⁶⁶ As Abraham Drassinower explains, “[t]he idea/expression dichotomy amounts to a distinction between authorship and copyright, between the scope of what the author sends into the world (i.e., idea as much as expression) and the narrower scope of what is subject to legal protection (i.e., expression alone).”⁶⁷ Ideas contained within a protected work do not come under the author’s exclusive control because, to use Justice Learned Hand’s terminology in *Nichols v. Universal Pictures Corp.*, they are “too generalized an abstraction from what [they] wrote.”⁶⁸ But the distinction between the specific and the generalized, between the concrete and the abstract, is not an objectively stable one from which legal conclusions can simply be drawn; it is, rather, a legal conclusion in itself—a conclusion, that is, about whether the element at issue *ought to be* protected. Whether an element within the work is merely idea or protectable expression flows not from some internal or stable quality of that element, but more fundamentally from the relationship between the parties in respect of the work: Applying the dichotomy demands at least an implicit assessment of whether the defendant *should* be free to use the common element in the exercise of their authorial agency.⁶⁹ The idea-expression dichotomy is therefore readily understood as one—perhaps the most—important way in which copyright doctrine preserves space for

⁶⁵ See, e.g., Copyright Act, 17 U.S.C. § 102(b) (2018), <https://www.govinfo.gov/content/pkg/USCODE-2018-title17/pdf/USCODE-2018-title17-chap1-sec102.pdf> [https://perma.cc/5L2X-SA35] (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”).

⁶⁶ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930). Judge Hand famously noted the elusive line between ideas and protected expression: “Nobody has ever been able to fix that boundary, and nobody ever can.” *Id.*

⁶⁷ Abraham Drassinower, *A Rights-Based View of the Idea/Expression Dichotomy in Copyright Law*, 16 CANADIAN J.L. & JURIS. 3, 9 (2003), <https://tspace.library.utoronto.ca/bitstream/1807/88486/1/Drassinower%20Rights%20Based.pdf> [https://perma.cc/8HPT-PXM5].

⁶⁸ *Nichols*, 45 F.2d at 122.

⁶⁹ Cf. Drassinower, *supra* note 67, at 9-10; see *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir. 1985) (“General . . . ideas . . . remain forever the common property of artistic mankind.”).

downstream and dialogic creativity. Unfortunately, however, the dichotomy largely “operates solely on instinct.”⁷⁰

The normative fluidity of the idea-expression dichotomy becomes more evident still when we consider the judge-made “merger” doctrine, which excludes from protection particular expression that represents one or a limited number of ways in which an idea might be expressed.⁷¹ The logic for excluding mergers of idea and expression is that to do otherwise would allow a copyright owner to effectively exhaust all future treatments of the subject by claiming exclusivity over the expression.⁷² Again, the conclusion as to whether something in fact exhibits a merger of idea and expression is not drawn inevitably from the text,⁷³ but flows from consideration of the downstream author and what they should be free to use in their own expressive enterprise.⁷⁴ As the Court of Appeals for the Ninth Circuit noted in *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, drawing the line between protectable and unprotectable expression therefore requires consideration of the appropriate copyright balance and its preservation: “What is basically at stake is the extent of the copyright owner’s monopoly—from how large an area of activity did Congress intend to allow the copyright owner to exclude others?”⁷⁵

Also removed from copyright in the *Nichols* case were “stock figures” and “prototypes,” or “less developed” characters marked “too indistinctly.”⁷⁶ To permit private ownership of such things would be to remove them from the common stock elements that find their way into

⁷⁰ 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, 420 (1989), <https://lawdigitalcommons.bc.edu/cgi/viewcontent.cgi?article=1714&context=lsfp> [https://perma.cc/ZF4Y-458L].

⁷¹ See, e.g., *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967).

⁷² See *id.* at 678-79 (explaining that, because, in cases of merger, “to permit copyrighting would mean that a party . . . could exhaust all possibilities of future use of the substance[,] [i]n such circumstances . . . the subject matter would be appropriated by permitting the copyrighting of its expression,” therefore, copyright “cannot [be] recognize[d] . . . as a game of chess in which the public can be checkmated”).

⁷³ See Allen Rosen, *Reconsidering the Idea/Expression Dichotomy*, 26 U.B.C. L. REV. 263, 279 (1992) (presenting the merger doctrine as an infinitely malleable device and a conclusory principle from which courts will work backwards to achieve what they regard as the desirable balance between the rights of the creator and the public); see also *Apple Comput., Inc. v. Mackintosh Computs. Ltd.*, [1987] 1 F.C. 173, para. 20 (Can.) (opining that many copyrighted works, such as poems and paintings, can be said not to exhibit a merger of idea and the expression thereof “only if the idea communicated . . . is described in highly abstract, remote and general terms”); see also Edward Samuels, *The Idea-Expression Dichotomy in Copyright Law*, 56 TENN. L. REV. 321, 384 (1989) (“On balance, the merger doctrine is no clearer than the idea-expression dichotomy, but it is simply a ‘somewhat metaphysical issue . . . whether particular ideas and expressions have merged.’” (alteration in original) (quoting *Apple Comput., Inc. v. Franklin Comput. Corp.*, 714 F.2d 1240, 1253 (3d Cir. 1983))).

⁷⁴ See, e.g., *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) (holding that “[a] jeweled bee pin . . . [was] an ‘idea’ that [the] defendants were free to copy” because exclusive control over the relevant expression would create “a larger private preserve” than should be set aside for the copyright owner).

⁷⁵ *Id.*

⁷⁶ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121-22 (2d Cir. 1930).

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the works of many, and through which many more subsequent works might therefore find expression.⁷⁷ For similar reasons, courts have also excluded so-called *scènes à faire*: particular “features of a work [that] are ‘as a practical matter indispensable, or at least standard, in the treatment of a given idea.’”⁷⁸ Again, such elements circulate broadly within our culture and so to render them exclusive to any particular author would unduly limit others seeking to create popular works within the same genre or general cultural sphere. As the Court of Appeals for the Ninth Circuit recently explained in *Skidmore v. Led Zeppelin*:

These building blocks belong in the public domain and cannot be exclusively appropriated by any particular author. Authors borrow from predecessors’ works to create new ones, so giving exclusive rights to the first author who incorporated an idea, concept, or common element would frustrate the purpose of the copyright law and curtail the creation of new works.⁷⁹

While merger and *scènes à faire* have enjoyed a less receptive welcome into the copyright jurisprudence outside of the United States, similar bases have emerged or developed in parallel to exclude equivalent subject matter, typically by invoking the unprotectability of information or ideas, or pointing to the absence of originality in such common elements as a reason to reject a plaintiff’s copyright infringement claim.⁸⁰

Indeed, as the threshold requirement for protection, the originality doctrine is tasked with the critical work of defining the protectable

⁷⁷ See, e.g., *Smith v. Jackson*, 84 F.3d 1213, 1216 n.3 (9th Cir. 1996) (explaining that copyright does not extend to “common or trite” musical elements); see also *Williams v. Gaye*, 895 F.3d 1106, 1140-41 (9th Cir. 2018) (Nguyen, J., dissenting) (maintaining that copyright does not protect “commonplace elements that are firmly rooted in the genre’s tradition”).

⁷⁸ *Ets-Hokin v. Skyy Spirits Inc.*, 323 F.3d 763, 765-66 (9th Cir. 2003) (quoting *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1444 (9th Cir. 1994)); see *Cain v. Universal Pictures Co., Inc.*, 47 F. Supp. 1013 (S.D. Cal. 1942) (finding that a movie scene in which two protagonists took refuge from a storm in a church bore only natural similarities to a scene in the plaintiff’s book due to the common situation); see also *Walker v. Time Life Films, Inc.*, 784 F.2d 44 (2d Cir. 1986) (attributing features in the plaintiff’s book and the defendant’s gangster movie—cockfights, drunks, stripped cars, prostitutes and rats—to unprotected stereotypical ideas).

⁷⁹ *Skidmore v. Led Zeppelin*, 952 F.3d 1051, 1069 (9th Cir. 2020); see *Satava v. Lowry*, 323 F.3d 805, 810-12 (9th Cir. 2003) (“[E]xpressions that are standard, stock, or common to a particular subject matter or medium are not protectable under copyright law. . . . [W]e must be careful in copyright cases not to cheat the public domain.”); see also *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir. 1985) (“General . . . ideas . . . remain forever the common property of artistic mankind.”).

⁸⁰ See, e.g., *Ladbroke, Ltd. v. William Hill, Ltd.* [1964] 1 All ER 465 (HL) (appeal taken from Eng.); see also *Designers Guild Ltd. v. Russell Williams (Textiles) Ltd.* [2000] UKHL 58, [2000] 1 WLR 2416 (Eng.); see also *Baigent v. Random House Grp. Ltd.* [2007] EWCA (Civ) 247 (Eng.). In Canada, similar doctrinal approaches to unoriginal common stock devices and mergers are evident in several cases. See, e.g., *Kilvington Bros. Ltd. v. Goldberg* (1957), 8 D.L.R. 2d 768 (Can. Ont. H.C.J.); see also *Hutton v. Canadian Broad. Corp.* (1989), 102 A.R. 6 (Can. Alta. Q.B.); see also *Delrina Corp. v. Triolet Sys. Inc.* (2002), 58 O.R. 3d 339 (Can. Ont. C.A.); see also *Cinar Corp. v. Robinson*, [2013] 3 S.C.R. 1168 (Can.); see also *VAVER*, *supra* note 5, at 182 (explaining that, in Canadian copyright law, “[t]he general stock of incidents in fiction or drama is free for all to use—a substantial part of everyone’s culture, not of any one individual’s work”).

expression and excluding any elements that were copied from elsewhere, whether from a particular identifiable source (a proximal utterance, in Bakhtinian terms) or from the common texts that circulate in our culture (distal utterances) that the author will likely have encountered. As determined by the U.S. Supreme Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*, copyright requires authorship, and authorship involves originality: Originality, in the *Feist* formulation, “means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.”⁸¹ Accordingly, “copyright protection may extend only to those components of a work that are original to the author.”⁸² Facts, which according to the Supreme Court “do not owe their origin to an act of authorship,” always belong in the public domain and are “free for the taking.”⁸³

Each of these exclusions from the copyright domain should function to permit dialogic creativity along the utterance chain. I raise these points here because the implications of these doctrinal copyright exclusions—their ability to in fact preserve space for dialogic creativity—are dependent upon their recognition and implementation in the determination of *prima facie* copyright infringement. Each exclusion, when applied to circumscribe the scope of copyright control, reflects a normative commitment to recognizing the *limited nature* of the original author’s copyright claim in relation to subsequent authors and the public at large. Here, the substantial similarity doctrine must therefore play a vital mediating role between the so-called original author and the downstream, transformative author-user. A substantial similarity doctrine that fails to parse out these public domain elements from the protectable scope of the copyright work—one that captures almost any recognizable copying with the owner’s net—is fundamentally at odds with a copyright system tasked with encouraging the cultural dialogic and creative exchange of ideas.

B. *Assessing Substantial Similarity*

Copyright law is concerned with copying, and, as Shyamkrishna Balganesh observes, “copying, or the act of appropriation that copyright law cares about, is both *factual* and *normative*.”⁸⁴ Copyright infringement

⁸¹ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991) (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 2.01[A]-[B] (1990)).

⁸² *Id.* at 348.

⁸³ *Id.* at 347-49; *cf.* *CCH Canadian Ltd. v. Law Soc’y of Upper Canada*, [2004] 1 S.C.R. 339, para. 22 (Can.).

⁸⁴ Shyamkrishna Balganesh, *The Normativity of Copying in Copyright Law*, 62 DUKE L.J. 203, 215 (2012), https://scholarship.law.upenn.edu/cgi/viewcontent.cgi?article=1701&context=faculty_scholarship [https://perma.cc/Y9VM-UUXG].

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doctrine looks, in the first place, for evidence of copying in fact, supported by proof of a defendant’s access to the allegedly copied work. Once copying is established, the legal question turns to whether that copying rises to the level of “improper” or “illicit” copying, as determined through the doctrinal device of “substantial similarity.”⁸⁵

The brief review of unprotectable subject matter above is important for the discussion that follows. It offers a simple but fundamental starting point for the infringement analysis: It is not unlawful to copy from a protected work if one copies less than a substantial part of the *copyrightable* expression therein. And, of course, if one copies lawfully—by taking only what is free for the taking or reproducing less than a substantial part of the *protected expression* in a work—there is no need to raise or successfully plead a fair use defense in order to avoid liability, for there has been no infringing act in need of a defense.

What the above review also makes evident, however, is the vague, indeterminate, and shifting nature of the boundaries that purport to separate the protectable from the unprotectable elements of a work. In this sense it underscores the challenging nature of the legal inquiry into the substantiality of the taking, which requires the parsing of protectable from unprotectable elements, as well as a substantive evaluation of the significance of the protectable portions that have been reproduced. The task is challenging not only from an evidentiary, technical, and doctrinal perspective, then, but also because, in application, it necessarily involves a more or less implicit but undertheorized assessment of the *wrongfulness* of the copying. Balganesh explains:

Substantial similarity is a judicially created rule that places the burden to establish that the defendant’s copying is . . . improper or wrongful in order to be actionable. The 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. Unsurprisingly, this inquiry inevitably entails the conscious introduction of a large normative/evaluative dimension into the analysis of the entitlement.⁸⁶

As the doctrinal entranceway for normative judgments about the right and wrong of copying, the assessment of substantial similarity is therefore the critical conceptual moment for established assumptions about the (im)morality of copying to inform the infringement analysis—and so, by the same token, it is the perfect doctrinal place to explore and seek to unsettle those assumptions.

⁸⁵ See *id.*

⁸⁶ *Id.* at 206 (internal footnotes omitted).

A variety of different approaches have been taken by courts tasked with assessing substantial similarity in copyright cases, but what they share in common, to greater or lesser degrees, is that they are ill-equipped to get to the legal and normative issues at play in the analytic process. For our purposes, it is sufficient to explore the few landmark cases that established the various approaches commonly (if inconsistently) employed.

1. The *Arnstein* Two-Step Test

Any overview of these approaches typically begins with the influential Second Circuit case *Arnstein v. Porter*, in which Ira Arnstein accused successful composer Cole Porter of infringing his copyright in several songs, including some that had never before been published.⁸⁷ Faced with the question of whether copying was even possible, the court bifurcated the infringement analysis into the two steps of actual copying and improper appropriation.⁸⁸ For the purposes of the first step, it was determined that expert evidence may be admissible regarding the nature of the similarities and the differences between the works, and the trier of fact may engage in a process of “dissection” of the works at issue to establish the degree of probative similarity from which copying might be inferred.⁸⁹ When it comes to the second step, however, expert testimony was not to be allowed, for the relevant question, according to the *Arnstein* court, is the impression that would be formed by the ordinary observer.⁹⁰ Putting itself in the position of the ordinary observer, the court is not to engage in a technically dissection analysis of the works and their common components but rather to undertake an assessment of the overall similarity between the two works to determine if, as perceived by the relevant audience, the defendant improperly copied the plaintiff’s work.⁹¹

Variations of the *Arnstein* ordinary observer test appear to be followed in the United States in the First, Third, Fifth, and Seventh Circuits.⁹² Its extraordinary influence—especially given that it merely reversed the grant of summary judgment—is attributed by Pamela

⁸⁷ *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946).

⁸⁸ *Id.*

⁸⁹ *Id.* at 468.

⁹⁰ *Id.*

⁹¹ See PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT §§ 9.1, 9.3.1 (3d ed. 2014).

⁹² See ROBERT C. OSTERBERG & ERIC C. OSTERBERG, SUBSTANTIAL SIMILARITY IN COPYRIGHT LAW § 3:1.1-.5 (2003). However, given the variations and fluidity of the *Arnstein* test in its articulation and application, it is difficult to state definitively which circuits faithfully apply it. Notably, its persuasive force has extended beyond the United States: Lord Upjohn cited the decision in the British landmark subconscious copying case of *Francis, Day & Hunter Ltd. v. Bron*. See *Francis, Day & Hunter Ltd. v. Bron* [1963] Ch 587 at 601 (Eng.) (“Where evidence of access is absent to prove copying, the similarities must be so striking as to preclude the possibility that the plaintiff and the defendant independently arrived at the same result.” (citing *Arnstein*, 154 F.2d 464)).

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Samuelson to the fact that it grounds the discussion of infringement in the Goldstein treatise.⁹³ This is notwithstanding the many bases on which the decision is vulnerable—and has been widely subjected—to critique.

The decision can, for example, readily be criticized for providing “scant guidance about the improper-appropriation step of the test,” offering, as it does, little indication of what level, degree, or nature of similarity is appropriate to ground the conclusion that copying is unlawful.⁹⁴ The resulting test ultimately leaves the determination of substantial similarity to the impressionistic response of the lay observer or, in music cases, the lay listener, simply asking the basic question of whether they would recognize the accused work as having been copied from the original⁹⁵ or regard the works’ aesthetic appeal as the same.⁹⁶ Even the “more discerning” ordinary observer, who made a welcome appearance in subsequent iterations of the test, is tasked, in the end, with comparing the works as a whole.⁹⁷ In Amy Cohen’s terse assessment,

⁹³ Pamela Samuelson, *A Fresh Look at Tests for Nonliteral Copyright Infringement*, 107 NW. U. L. REV. 1821, 1824 n.8 (2013), <https://scholarlycommons.law.northwestern.edu/cgi/viewcontent.cgi?article=1045&context=nulr> [<https://perma.cc/PR5Y-BNUT>] (noting that, as of early 2013, *Arnstein* had been cited in every circuit except the Federal Circuit).

⁹⁴ *Id.* at 1825.

⁹⁵ See, e.g., *Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F.3d 996, 1001 (2d Cir. 1995) (describing the circuit’s test for unlawful “substantial similarity” as “whether ‘an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work’” (quoting *Malden Mills, Inc. v. Regency Mills, Inc.*, 626 F.2d 1112, 1113 (2d Cir. 1980))).

⁹⁶ See, e.g., *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1072 (2d Cir. 1992) (“Two works are substantially similar where ‘the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard [the] aesthetic appeal [of the two works] as the same.’” (alteration in original) (quoting *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960))).

⁹⁷ The improved “more discerning observer” test developed in the Second Circuit for cases in which works include significant non-original or public domain material (which should, but apparently does not, apply to all works). See *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 766 (2d Cir. 1991) (“[S]ince only some of the design enjoys copyright protection, the observer’s inspection must be more discerning.”); see also *Key Publ’ns, Inc. v. Chinatown Today Publ’g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991) (finding that a “more refined analysis” is required where a plaintiff’s work is not “wholly original,” but instead incorporates elements from the public domain). However, the trier of fact is still required to consider the works as a whole. See *Knitwaves, Inc.*, 71 F.3d at 1003 (declining to exclude unprotectable elements from the substantial similarity inquiry even when applying the “more discerning” inquiry because “[i]t is commonplace that in comparing works for infringement purposes—whether we employ the traditional ‘ordinary observer’ test or the *Folio Impressions* ‘more discerning’ inquiry—we examine the works’ ‘total concept and feel’”; see also *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001) (“In applying [the ‘more discerning’ ordinary observer] test, a court is not to dissect the works at issue into separate components and compare only the copyrightable elements. To do so would be to take the ‘more discerning’ test to an extreme . . . [T]he test is guided by comparing the ‘total concept and feel’ of the contested works.” (internal citation omitted)); see also Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright*, 125 HARV. L. REV. 683, 718 (2012), https://cdn.harvardlawreview.org/wp-content/uploads/pdfs/vol125_tushnet.pdf [<https://perma.cc/TH5K-9TNA>] (arguing that, while “[t]he case law indicates that, in the second step, the works should be considered as a whole[,] . . . [i]n the same case, a court will caution that the relevant similarity has to be based on the protectable elements of a work and then immediately state that the factfinder can’t just compare the copyrightable elements in its evaluation” (citing *Boisson*, 273 F.3d at 273)).

“[i]nstead of using some objective standards or criteria . . . courts [are] to determine infringement on an unpredictable, impressionistic basis.”⁹⁸

The primary concern here, from my perspective, is not with unpredictability per se (which is often the unavoidable downside of an appropriately contextual case-by-case inquiry) but with the obvious risk of *overprotection* of the plaintiff. Dismissing the dissection analysis in the second step “impl[ies] that unprotectable ideas, tropes, and facts do come back into consideration.”⁹⁹ Even taking seriously the proposition that only copying of protectable elements can amount to infringement, the ordinary observer under the *Arnstein* test is given “the impossible task of comparing only protected expression in determining substantial similarity without engaging in any thoughtful dissection or analysis of the works.”¹⁰⁰

As Mark Lemley has convincingly argued, it is precisely at the stage of determining the substantiality of the taking that the need for expertise and careful dissection analysis is most pronounced.¹⁰¹ This is where some parsing of the work is essential to establishing, for example, which elements are common stock in the genre and therefore part of the public domain and freely available to be copied by anyone. Indeed, as Guillaume Laroche and I demonstrated in the context of musical compositions, reliance on the perception of the ordinary lay listener as opposed to the musical expert to determine substantial similarity can hardly avoid producing conclusions that are fundamentally at odds with basic copyright doctrine.¹⁰² And if mere *recognizability* of the plaintiff’s work

⁹⁸ Amy B. Cohen, *Masking Copyright Decisionmaking: The Meaninglessness of Substantial Similarity*, 20 U.C. DAVIS L. REV. 719, 732 (1987), <https://digitalcommons.law.wne.edu/cgi/viewcontent.cgi?article=1048&context=facschol> [https://perma.cc/Z4HW-K7GL].

⁹⁹ Tushnet, *supra* note 97, at 718.

¹⁰⁰ Cohen, *supra* note 98, at 749; see Tushnet, *supra* note 97, at 687-88 (arguing that the current approach to determining substantial similarity “makes impossible and self-contradictory demands on factfinders”); see also Nicole Lieberman, *Un-Blurring Substantial Similarity: Aesthetic Judgments and Romantic Authorship in Music Copyright Law*, 6 N.Y.U. J. INTELL. PROP. & ENT. L. 91, 108-12 (2016), https://jipel.law.nyu.edu/wp-content/uploads/2017/02/NYU_JIPEL_Vol-6-No_1_4_Lieberman_SubstantialSimilarity.pdf [https://perma.cc/3TUU-5ABJ] (critically assessing the unlawful appropriation step in the *Arnstein* test).

¹⁰¹ Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 J. COPYRIGHT SOC’Y U.S.A. 719, 719 (2010) (arguing that the *Arnstein* and *Krofft* approach “has the analysis of proof exactly backwards— . . . falling back on the ‘ordinary observer’ test on the very questions that require careful dissection by the court”).

¹⁰² Carys Craig & Guillaume Laroche, *Out of Tune: Why Copyright Law Needs Music Lessons, in* INTELLECTUAL PROPERTY FOR THE 21ST CENTURY: INTERDISCIPLINARY APPROACHES 43 (B. Courtney Doagoo et al. eds., 2014), https://digitalcommons.osgoode.yorku.ca/cgi/viewcontent.cgi?article=3401&context=scholarly_works [https://perma.cc/RML2-7XN8]; see Joseph P. Fishman, *Music as a Matter of Law*, 131 HARV. L. REV. 1861 (2018), https://harvardlawreview.org/wp-content/uploads/2018/05/1861-1923_Online.pdf [https://perma.cc/W265-AJE5]; see also J. Michael Keyes, *Musical Musings: The Case for Rethinking Music Copyright Protection*, 10 MICH. TELECOMM. & TECH. L. REV. 407 (2004), https://pdfs.semanticscholar.org/eddb/111a156ff011abd7831d64d155b59d0f8732.pdf?_ga=2.265344839.915042264.1591320421-1654005928.1591320421 [https://perma.cc/P57T-B5YM]; see also Jamie Lund, *An Empirical Examination of the Lay Listener Test in Music Composition Copyright Infringement*, 11 VA. SPORTS & ENT. L.J. 137 (2011).

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is to be the determining factor, this would seem to render any discernable copying unlawful by default.

In sum, the *Arnstein* approach to assessing substantial similarity involves an impressionistic test, the absence of careful analytic dissection of the work, the exclusion of expert evidence, and the moral disapprobation likely to flow from having already established copying in step one—surely a combination that stacks the deck in the plaintiff’s favor.¹⁰³ For my purposes here, the problem to be underscored is this: When following *Arnstein*, particularly in cases where copying-in-fact is not disputed,¹⁰⁴ the distinction between copyrightable and public domain elements within the work is potentially wholly submerged beneath the impressionistic—and so normative/evaluative—assessment of the *wrongfulness* of having copied “too much” (whatever that might be taken by the decision-maker to mean).

2. *Roth, Krofft*, and the “Total Concept and Feel” Test

Nonetheless, in the Ninth Circuit a similar two-step infringement test has been developed that applies, in Goldstein’s assessment, “a somewhat cloudy gloss” to the *Arnstein* approach.¹⁰⁵ As first laid out in *Sid & Marty Krofft Television Productions, Inc. v. McDonald’s Corp.*, the first step—referred to, a little bemusingly, as the “extrinsic test”—involves the examination of similarities between the ideas of the two works, relying on expert opinion and analytic dissection of the works as appropriate and focusing on an objective comparison.¹⁰⁶ In step two, an “intrinsic test” inquires into the similarity in the expression of the works, with a focus on the subjective “response of the ordinary reasonable person”¹⁰⁷ to the “total concept and feel”¹⁰⁸ of a work, therefore excluding expert testimony and dissection.¹⁰⁹ Presented as involving the “same type of bifurcated test” as *Arnstein*,¹¹⁰ subsequent cases purporting to follow *Krofft* diverge with respect to how the extrinsic and intrinsic steps map onto *Arnstein*’s two prongs of probative and unlawful copying.¹¹¹ In any

¹⁰³ Cf. Samuelson, *supra* note 93, at 1826.

¹⁰⁴ See *id.* at 1827.

¹⁰⁵ Aaron M. Broaddus, *Eliminating the Confusion: A Restatement of the Test for Copyright Infringement*, 5 DEPAUL J. ART, TECH. & INTELL. PROP. L. 43, 51 (1995) (quoting PAUL GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES: CASES AND MATERIALS ON THE LAW OF INTELLECTUAL PROPERTY 714 (3d ed. 1990)), <https://via.library.depaul.edu/cgi/viewcontent.cgi?article=1413&context=jatip> [<https://perma.cc/FSY8-RW8A>].

¹⁰⁶ *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

¹⁰⁷ *Id.*

¹⁰⁸ *Id.* at 1167 (quoting *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970)).

¹⁰⁹ *Id.* at 1164.

¹¹⁰ *Id.*

¹¹¹ For example, while some courts use the extrinsic test to determine actual copying and the intrinsic test to establish unlawful copying, other courts use both the extrinsic *and* intrinsic tests at

event, as noted in the subsequent case of *Shaw v. Lindheim*, the extrinsic/intrinsic distinction in *Krofft* is “more sensibly described as [an] objective and subjective” distinction, wherein the subjective analysis is “virtually devoid of analysis, for the intrinsic test has become a mere subjective judgment as to whether two . . . works are or are not similar.”¹¹² While it is in some respects better, and in others worse,¹¹³ for our purposes the Ninth Circuit’s *Krofft* test suffers from essentially the same flaws as the *Arnstein* approach insofar as it ultimately turns, for its assessment of unlawful copying, on an impressionistic and subjective comparison of the two works, potentially without any careful dissection of protectable and unprotectable elements at the substantial similarity stage.¹¹⁴ The problem is compounded by the Ninth Circuit’s embrace, in the second (intrinsic) step, of the controversial “total concept and feel” test, to which we now turn.

either the probative copying stage, or the improper appropriation stage, or both. *See, e.g.,* Gates Rubber Co. v. Bando Am., Inc., 798 F. Supp. 1499, 1509-10 (D. Colo. 1992) (“For the extrinsic test, the fact-finder must decide whether there is sufficient similarity between the two works in question to conclude the alleged infringer used the copyrighted work in making his own.”); *see also* Cottrill v. Spears, No. 02-3646, 2003 U.S. Dist. LEXIS 8823, at *30 (E.D. Pa. May 22, 2003) (employing the “extrinsic” test to determine the “actual copying” component of the infringement analysis); *see also* Gianacopoulos v. Glen Oak Country Club, No. 3:05-CV-2417, 2007 U.S. Dist. LEXIS 7710 (M.D. Pa. Feb. 2, 2007) (suggesting that the “extrinsic” test is concerned with actual copying); *see also* Blakeman v. Walt Disney Co., 613 F. Supp. 2d 288, 304 (E.D.N.Y. 2009) (applying the “average lay observer” and “total concept and feel” tests when determining probative similarity); *see also* Price v. Fox Entm’t Grp., Inc., 499 F. Supp. 2d 382 (S.D.N.Y. 2007) (indicating that it is the average lay observer who is to compare the works to determine actual copying).

¹¹² *Shaw v. Lindheim*, 919 F.2d 1353, 1357 (9th Cir. 1990).

¹¹³ *Cf.* Samuelson, *supra* note 93, at 1829 (arguing that *Krofft* improves on *Arnstein* given its focus, in step one, on sorting out whether similarities relate to ideas or protected elements, as well as separating the question of independent creation from substantial similarity; but also noting that it is worse than *Arnstein* in its inapt extrinsic/intrinsic terminology, and its erroneous concern with the substantial similarity of ideas in the second step).

¹¹⁴ *Cf.* Robert F. Helfing, *Substantial Similarity in Literary Infringement Cases: A Chart for Turbid Waters*, 21 UCLA ENT. L. REV. 1, 13 (2014), <https://escholarship.org/content/qt0m10v6t3/qt0m10v6t3.pdf?t=nndfph> [<https://perma.cc/C4KW-JLLP>] (explaining that, because the original *Krofft* test left copying of protected content to be determined through the intrinsic test and based on the subjective impression of a jury, “*Krofft*’s two-step process, therefore, allowed for a finding of infringement even where the defendant had copied nothing but ideas and other unprotectable matter”). In subsequent cases, courts have attempted to address this flaw by recasting the extrinsic test to identify similarities between the protected expressions as a matter of law, and not to find similarities between the ideas of the works as a matter of fact. *See, e.g.,* Litchfield v. Spielberg, 736 F.2d 1352, 1357 (9th Cir. 1984) (holding that the plaintiff had failed to satisfy the extrinsic test because plot similarities existed “only at the general level for which [the] plaintiff [could not] claim copyright protection”); *see also* Berkic v. Crichton, 761 F.2d 1289, 1293-94 (9th Cir. 1985) (finding that the plaintiff had failed to satisfy the extrinsic test as a matter of law because it could not be satisfied by the similarity of “[g]eneral plot ideas”); *see also* *Shaw*, 919 F.2d at 1357 (stating that the extrinsic test “can no longer be seen as a test for mere similarity of ideas,” but rather the extrinsic and intrinsic tests “are more sensibly described as objective and subjective analyses of *expression*, having strayed from *Krofft*’s division between expression and ideas”); *see also* Cooling Sys. & Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 493 (9th Cir. 1985) (stating, with regard to the “intrinsic” test, that “[w]hat is important is not whether there is substantial similarity in the total concept and feel of the works, but whether the very small amount of protectible expression in [the plaintiff’s] catalog is substantially similar to the equivalent portions of [the defendant’s] catalog”).

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The *Krofft* case is widely cited in support of the “total concept and feel” test, having employed this phrase in concluding that the defendants’ “McDonaldland” television commercials were substantially similar to the plaintiff’s H.R. Pufnstuf children’s television show because they “captured the ‘total concept and feel’ of the . . . show.”¹¹⁵ The court in *Krofft* expressly resisted embarking on an analytic dissection of the ideas and expression in the show: “Lest we fall prey to defendants’ invitation to dissect the works, . . . we should remember that it is the combination of many different elements which may command copyright protection because of its particular subjective quality. . . . ‘[T]he over-all impact and effect indicate substantial appropriation.’”¹¹⁶ The “total concept and feel” test in fact traces back fifty years to the less well-known but landmark ruling of *Roth Greeting Cards v. United Card Co.*¹¹⁷ Arising out of a dispute between competitors in the market for greeting cards, and in the context of clear copying-in-fact by the defendant, the appellate court reversed a lower court judgment that had found no infringement in light of graphical differences between the parties’ cards.¹¹⁸ On appeal, having held that copyright subsisted in the plaintiff’s card designs when “considered as a whole,” the court concluded that the copyright was infringed by the defendant’s similar cards notwithstanding that its artwork was “somewhat different.”¹¹⁹ Applying the test of “whether the work is recognizable [to] an ordinary observer as having been taken from the copyrighted source,”¹²⁰ the court in *Roth* determined that “in total concept and feel the cards of United [were] the same as the copyrighted cards of Roth.”¹²¹ In doing so, it pointed to similarities between “the characters depicted in the art work, the mood they portrayed, the combination of art work conveying a particular mood with a particular message, and the arrangement of the words on the greeting card.”¹²² As in *Krofft*, then, taking into account the total concept and feel of a work was apparently seen as an antidote to the dangers of dissection, ensuring that the work *as a whole* is adequately protected against perceived

¹¹⁵ *Sid & Marty Krofft Television Prods., Inc.*, 562 F.2d at 1167 (quoting *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970)).

¹¹⁶ *Id.* at 1169 (emphasis omitted) (quoting *Malkin v. Dubinsky*, 146 F. Supp. 111, 114 (S.D.N.Y. 1956)).

¹¹⁷ *Roth Greeting Cards*, 429 F.2d at 1110.

¹¹⁸ *Id.* at 1107-11.

¹¹⁹ *Id.* at 1109-10.

¹²⁰ *Bradbury v. Columbia Broad. Sys., Inc.*, 287 F.2d 478, 485 (9th Cir. 1961).

¹²¹ *Roth Greeting Cards*, 429 F.2d at 1110. Notably, the “total concept and feel” terminology was not presented as a test in itself but was instead an observation in passing when applying the “ordinary observer” test to the works at issue. See Samuelson, *supra* note 93, at 1833 (“It is hence somewhat bizarre that the total concept test has become so widely used in copyright cases.”). Rather, it offered the phrase more as an off-hand observation to be considered, in passing, when applying the “ordinary observer” test to the works at issue. See *id.*

¹²² *Roth Greeting Cards*, 429 F.2d at 1110.

misappropriation. In his dissent, Judge Kilkenny disputed the logic of the majority's ruling, finding that there was neither infringement of the text (which consisted of common phrases belonging in the public domain) nor the artwork (which was imitated but not closely copied), and so to grant a monopoly over the total composition was to make "the whole . . . substantially greater than the sum total of its parts."¹²³

I have suggested above that, owing to the inherent vagueness of copyright's boundaries, the interpretation of its limits has more to do with the perceived relationship between the parties and the public, and a normative evaluation of their respective rights and wrongs, than to anything essential within the work or inevitable within the applicable legal rules. For example, with respect to *Roth*, I agree with Pamela Samuelson's observation that "[t]he *Roth* majority was probably influenced by a sense that United had engaged in unfair competition by not doing enough independent creative work."¹²⁴ Rather than hiring writers or artists, the defendant had set about imitating its competitors, and "[t]his unfairness may have tipped the scale toward infringement despite numerous visual differences in the cards."¹²⁵ Meanwhile, Judge Kilkenny was concerned more by the plaintiff's claimed monopoly than by the defendant's free-riding efforts at competition, and was thus able to conclude, on the same facts, that the copying was not unlawful or improper.¹²⁶ Once again, as with *Krofft* and *Arnstein*, the *Roth* case reveals: "a large normative component in which courts are to judge the wrongfulness of a defendant's act of copying, . . . allowing courts to infuse [substantiality] thresholds with largely intuitive notions of when an appropriation is to be considered wrongful and therefore actionable."¹²⁷

Most worrying, however, when it comes to the "total concept and feel" test that emerged from the *Roth* dictum, is the unavoidable potential for the test to extend protection to—one would think it hardly need be said—the underlying "concept" and overall "feel" of a work. Under U.S. copyright law, "concepts" are not only clearly included within the domain of abstract ideas to which copyright protection cannot extend, but they are also explicitly excluded; specifically, Section 102(b) of the Copyright Act states that "[i]n no case does copyright protection . . . extend to any

¹²³ *Id.* at 1111 (Kilkenny, J., dissenting); *cf.* Tushnet, *supra* note 97, at 719 ("Roth is misguided. The original elements (the art) weren't copied, and the copied elements (the words and the font) weren't original.").

¹²⁴ Samuelson, *supra* note 93, at 1833.

¹²⁵ *Id.*

¹²⁶ *Roth Greeting Cards*, 429 F.2d at 1111-12 (Kilkenny, J., dissenting) ("Feeling, as I do, that the copyright act is a grant of limited monopoly to the authors of creative literature and art, I do not think that we should extend a 56-year monopoly in a situation where neither infringement of text, nor infringement of art work can be found.").

¹²⁷ Balganes, *supra* note 84, at 221.

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... concept”¹²⁸ As for protecting the “feel” of an expressive work, it is hard to even embark upon imagining how that might appropriately be formulated as a legal standard for allocating liability.¹²⁹ It is harder still to justify a plaintiff’s right to exercise exclusivity or control over the *feeling* that their work may generate in any particular ordinary observer.

All in all, it seems fair to say that the “total concept and feel” test—to the extent that it can be conceived of as a test at all—was “ill-advised in the extreme.”¹³⁰ There is some sound logic to the insistence that decision-makers comparing works ought to have regard to the forest as well as the trees, so to speak, because an original combination of unprotectable elements may itself merit protection.¹³¹ But, as Alfred Yen has argued, “*Roth* and *Krofft* strongly suggest that the very mood a work creates constitutes its protectable expression. If copyright claims can in fact be maintained at such a high level of abstraction, practically any similarity could conceivably support a finding of infringement.”¹³² If the idea-expression dichotomy does indeed “operate[] solely on instinct,” as Yen suggests, then: “in applying this instinct the courts have failed to leave us any firm doctrinal guidance as to when the idea/expression dichotomy should be used to limit copyright claims. Indeed, the doctrine left behind in cases like *Roth* [and] *Krofft* . . . indicates that no meaningful limits exist.”¹³³ By failing to focus on the protected expressive elements of a plaintiff’s work and allowing (indeed, practically requiring) unprotectable elements to be swept into the critical comparison,¹³⁴ the “total concept and feel” test for assessing substantial similarity poses significant risks of overprotection of copyright owners to the obvious detriment of downstream creators and the public interest.

Copyright overreach is the inevitable result of what Samuelson evocatively describes as “a fuzzy totality approach.”¹³⁵ As such, it is important to identify, as a point of potential contrast, the “dissection”

¹²⁸ Copyright Act, 17 U.S.C. § 102(b) (2018).

¹²⁹ See 4 NIMMER & NIMMER, *supra* note 1, § 13.03[A][1][c] (expressing concern that the “total concept and feel” test may “invite[] an abdication of analysis” because “feel” seems to be “a wholly amorphous referent”); see also Tushnet, *supra* note 97, at 719 (“That two works produce the same emotional state in a viewer does not mean that they are the same.”).

¹³⁰ 4 NIMMER & NIMMER, *supra* note 1, § 13.03[A][1][c]; see Daniel Gervais, *Improper Appropriation*, 23 LEWIS & CLARK L. REV. 599, 611 (2019), <https://scholarship.law.vanderbilt.edu/cgi/viewcontent.cgi?article=2118&context=faculty-publications> [<https://perma.cc/M2R4-JPR4>].

¹³¹ See *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 618 (7th Cir. 1982) (“When analyzing two works to determine whether they are substantially similar, courts should be careful not to lose sight of the forest for the trees.”); see also *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 348 (1991) (“[C]hoices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original . . .”).

¹³² Yen, *supra* note 70, at 411 (internal footnote omitted).

¹³³ *Id.* at 420.

¹³⁴ See Samuelson, *supra* note 93, at 1832.

¹³⁵ *Id.*

approach to which I have so far referred only in passing. Central to this discussion is an examination of the Second Circuit's holding in the landmark computer software case *Computer Associates International, Inc. v. Altai, Inc.*¹³⁶

3. *Altai* and the "Dissection" Approach

The *Altai* case involved the non-literal copying of a computer program, which presented the court with the daunting task of establishing the scope and limits of protectable literary expression within software code.¹³⁷ The careful analytic dissection of the plaintiff's work that ensued was no doubt motivated by a certain unease with the technical subject matter at hand, as well as doubts about its proper fit within the copyright system.¹³⁸ What thereby resulted was a thoughtful parsing of the protected work attentive to the doctrinal limits and policy objectives of copyright.¹³⁹ The court's three-step test was, importantly, designed to replicate and apply established doctrine to this highly complex subject matter, as opposed to developing new rules for the specific technology.¹⁴⁰

The test requires, first, the *abstraction* of the allegedly copied program, dissecting its structure and isolating each level of abstraction within it.¹⁴¹ Step two then *filters out* unprotected elements of the program, which includes (by virtue of the doctrinal limits of copyrightability, discussed above) high-level abstractions like the functions of program modules, but also elements dictated by efficiency considerations or external elements like hardware or interoperability requirements, as well as any elements taken from the public domain.¹⁴² This filtering step leaves behind the core or "golden nugget" of copyrightable expression, which is the proper object of *comparison* for the third and final step in which the defendant's work is compared to the protected elements of the plaintiff's work in order to establish whether there is substantial similarity.¹⁴³ This iterative analytic approach, needless to say, does not depend solely on the impression of the ordinary lay observer.

¹³⁶ *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992).

¹³⁷ *Id.*

¹³⁸ *Id.* at 712 ("Generally, . . . [the court believed] that copyright registration—with its indiscriminating availability—[was] not ideally suited to deal with the highly dynamic technology of computer science. . . . [M]any of the decisions in this area reflect the courts' attempt to fit the proverbial square peg in a round hole.").

¹³⁹ *See id.* Cf. *Google LLC v. Oracle America, Inc.*, 539 U.S. __ (2021) (finding that the copying of computer code from the plaintiff's Application Processing Interface was fair use and so declining to rule on the antecedent issue of copyright subsistence and scope).

¹⁴⁰ *Id.* at 706 (arguing that the court's three-step "approach breaks no new ground; rather, it draws on such familiar copyright doctrines as merger, *scenes a faire*, and public domain").

¹⁴¹ *Id.* at 706-07. The theoretical framework for step one of the court's three-step test is based upon the "abstractions test" enunciated by Judge Learned Hand in *Nichols v. Universal Pictures Corp.* *See Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121-22 (2d Cir. 1930).

¹⁴² *Altai, Inc.*, 982 F.2d at 707.

¹⁴³ *Id.* at 710.

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Notably, the *Altai* ruling was a response to a previous decision in the Third Circuit, *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, which also concerned copyright infringement of a computer program.¹⁴⁴ In the absence of literal copying of code, the *Whelan* court was concerned with whether there was “comprehensive nonliteral similarity” between the two programs, such that “the fundamental essence or structure of one work is duplicated in another.”¹⁴⁵ In finding infringement, the *Whelan* ruling had effectively protected the overall “look and feel” of the plaintiff’s program against copying by its competitor.¹⁴⁶ According to the *Altai* court, in doing so, the *Whelan* court had failed to appropriately filter out the unprotectable elements within software code, thereby overprotecting the plaintiff’s work and its utilitarian features.¹⁴⁷ At least in the context of computer programs, the *Altai* case was therefore a stern repudiation of an infringement test that fails to adequately limit the scope of the copyright owner’s exclusivity and thereby restricts downstream development.

The Abstraction-Filtration-Comparison test has now been adopted by most circuits in respect of computer software infringement,¹⁴⁸ while courts in the Tenth, Sixth, and D.C. Circuits have applied the test or a variant of it to all categories of works.¹⁴⁹ Nimmer has argued that “[i]n the wake of *Feist*, [a successive filtration approach] should be considered not only for factual compilations and computer programs, but across the gamut of copyright law”¹⁵⁰ Conversely, William Patry has criticized the Abstraction-Filtration-Comparison test as “the most complicated

¹⁴⁴ *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222 (3d Cir. 1986).

¹⁴⁵ *Id.* at 1234 n.26 (quoting 4 NIMMER & NIMMER, *supra* note 1, § 13.03[A][1]).

¹⁴⁶ See Richard D. Moreno, Note, “*Look and Feel*” as a Copyrightable Element: The Legacy of *Whelan v. Jaslow*? Or, Can Equity in Computer Program Infringement Cases Be Found Instead by the Proper Allocation of Burden of Persuasion?, 51 LA. L. REV. 177, 199 (1990), https://digitalcommons.law.lsu.edu/cgi/viewcontent.cgi?referer=https://scholar.google.com/scholar?cluster=5108409867023910043&hl=en&as_sdt=0,33&httpsredir=1&article=5266&context=lalrev [<https://perma.cc/7F8Z-VQH8>] (“It seems clear in retrospect that the court was concerned with one person appropriating the economic value of the intellectual effort of another by copying the ‘Look and Feel’ where there was no literal copying.”); see also Matthew J. Fortnow, Note, *Why the “Look and Feel” of Computer Software Should Not Receive Copyright Protection*, 14 CARDOZO L. REV. 421 (1992).

¹⁴⁷ *Altai, Inc.*, 982 F.2d at 705 (“Since each subroutine is itself a program, and thus, may be said to have its own ‘idea,’ *Whelan*’s general formulation that a program’s overall purpose equates with the program’s idea is descriptively inadequate.”); see *Lotus Dev. Corp. v. Paperback Software Int’l*, 740 F. Supp. 37, 62 (D. Mass. 1990) (“I have not found the ‘look and feel’ concept . . . to be significantly helpful in distinguishing between nonliteral elements of a computer program that are copyrightable and those that are not.”).

¹⁴⁸ See OSTERBERG & OSTERBERG, *supra* note 92, § 8:6.

¹⁴⁹ See *id.* § 3:3; see also Katherine Lippman, *The Beginning of the End: Preliminary Results of an Empirical Study of Copyright Substantial Similarity Opinions in the U.S. Circuit Courts*, 2013 MICH. ST. L. REV. 513, 531-33 (2013), <https://digitalcommons.law.msu.edu/cgi/viewcontent.cgi?article=1010&context=lr> [<https://perma.cc/H5EF-56XP>].

¹⁵⁰ 4 NIMMER & NIMMER, *supra* note 1, § 13.03[E][1][b] (internal footnote omitted).

copyright ‘test’ ever conceived,”¹⁵¹ and one that misses important holistic elements of artistic works by preferring their “brutal . . . desiccation.”¹⁵²

Opinions are similarly divided in the jurisprudence. Courts applying the “total concept and feel” test reject—at least implicitly but often explicitly—the “abstraction, filtration, comparison” test,¹⁵³ and, as we have seen, *vice versa*.¹⁵⁴ The assumption seems to be that a choice must be made between a “totality” and “dissection” approach¹⁵⁵ and, moreover, that the choice is a principled one insofar as it has implications for the strength and scope of copyright. At the risk of oversimplifying, as a matter of principle, it seems clear that the “totality” approach is regarded as a means by which to ensure the adequate protection of the author-owner against misappropriation, while the “dissection” approach is purposefully protective of downstream users and the public domain. The doctrinal tension evident in the jurisprudence between “total concept and feel” and “Abstraction-Filtration-Comparison” is therefore critical from a normative perspective precisely because it mirrors the larger philosophical tension evident in copyright theory between the rights and interests of authors and the public.

I argue, however, that a “totality” approach can and should be transformed into a doctrinal tool for advancing the public interest in preserving space for dialogic creativity. Rather than permitting the overreach of authors’ rights, the “total concept and feel” test should be redeployed to *limit* copyright’s reach. The judgment of the Supreme Court of Canada in *Cinar Corp. v. Robinson*—albeit a good illustration of these tensions and the dangers inherent in a “totality” approach—also

¹⁵¹ 3 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 9:94 (2020).

¹⁵² 2 *id.* § 4:27; see Kevin J. Hickey, *Reframing Similarity Analysis in Copyright*, 93 WASH. U. L. REV. 681, 694-95 (2016), https://openscholarship.wustl.edu/cgi/viewcontent.cgi?article=6199&context=law_lawreview [<https://perma.cc/E6CJ-VYD4>].

¹⁵³ See, e.g., *Roulo v. Russ Berrie & Co., Inc.*, 886 F.2d 931, 939 (7th Cir. 1989) (“[D]issection of the subject matter into copyrighted and unprotected elements is generally rejected in favor of examining the ‘total concept and feel’ of the copyrighted work.” (citing *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982))); see also *Atkins v. Fischer*, 331 F.3d 988, 993 (D.C. Cir. 2003) (“When comparing the designs, it is not sufficient to dissect separate components and dissimilarities. The original way that the author ‘selected, coordinated, and arranged the elements’ of her work is the focus of the court.” (quoting *Hamil Am., Inc. v. GFI, Inc.*, 193 F.3d 92, 103 (2d Cir. 1999))).

¹⁵⁴ See *Comput. Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706 (2d Cir. 1992) (arguing that the court’s three-step “approach breaks no new ground; rather, it draws on such familiar copyright doctrines as merger, *scènes a faire*, and public domain”); see, e.g., *Kohus v. Mariol*, 328 F.3d 848 (6th Cir. 2003) (adopting a filtration/comparison approach on the basis that an ordinary observer test fails to exclude unoriginal, unprotectable elements as required by *Feist*).

¹⁵⁵ Cf. Samuelson, *supra* note 93, at 1840-41 (agreeing with the “intuition that triers of fact in nonliteral similarity cases should engage in some dissection analysis . . . as well as make a more holistic or overall impressionistic judgment as to whether the defendant’s appropriation of expression from the plaintiff’s work was substantial enough to subject [them] to liability for infringement” (emphasis added)).

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provides a small but clear window into how the holistic comparison might be repurposed to better protect the public interest.¹⁵⁶

4. The *Cinar* Decision: Holistic Comparison and the Non-Infringing “New Work”

In *Cinar*, Canada’s Supreme Court had its first opportunity to pronounce on the appropriate substantial similarity doctrine in copyright infringement cases. As is often the case in Canadian jurisprudence, the doctrinal debate presented itself as a choice between competing approaches to the problem drawn from the conflicting jurisprudence of the jurisdictions to which Canadian courts frequently look for persuasive authority. In this instance, the Court was tasked with choosing between a “holistic comparison” or “totality” approach drawn most directly from the U.K. authorities¹⁵⁷ and the “abstraction-filtration-comparison” or “dissection” approach drawn from the U.S. Second Circuit.¹⁵⁸

This classic “pitch and pinch” case involved Quebec artist Claude Robinson who, in 1982, drew the first sketches of the characters for a proposed children’s television series to be called *The Adventures of Robinson Curiosity*, inspired in part by Daniel Defoe’s *Robinson Crusoe*, as well as his own life experiences.¹⁵⁹ Having unsuccessfully pitched the television show to the Cinar Corporation, Robinson was shocked when he saw a broadcast of Cinar’s new children’s television production, *Robinson Sucroë*, using a similar premise and several parallel characters, settings, and scenes.¹⁶⁰ Robinson’s copyright infringement action was successful at first instance, with the trial judge finding that the defendants had copied a number of features and that, considered as a whole, the copied features constituted a substantial part of Robinson’s work.¹⁶¹ The

¹⁵⁶ See *Cinar Corp. v. Robinson*, [2013] 3 S.C.R. 1168 (Can.).

¹⁵⁷ See *Ladbroke, Ltd. v. William Hill, Ltd.* [1964] 1 All ER 465 (HL) (appeal taken from Eng.); see also *Designers Guild Ltd. v. Russell Williams (Textiles) Ltd.* [2000] UKHL 58, [2000] 1 WLR 2416 (Eng.); see also *Baigent v. Random House Grp. Ltd.* [2007] EWCA (Civ) 247 (Eng.).

¹⁵⁸ See *Altai, Inc.*, 982 F.2d 693.

¹⁵⁹ *Cinar Corp.*, 3 S.C.R. at para. 3 (explaining that the plaintiff’s central character “lives on a tropical island and must learn to interact with its other inhabitants”). Defoe’s work, of course, belongs in the public domain and is, therefore, one of the *distal already-spoken*s that circulate in our culture and on which Claude Robinson—and anyone else—is thus free to draw. See *supra* Section I.B.

¹⁶⁰ *Cinar Corp.*, 3 S.C.R. at paras. 8-9 (explaining that Robinson perceived *Sucroë* as being “a blatant copy of *Curiosity*” because, “[i]n [his] view, the characters and environment depicted in *Sucroë* closely tracked his work”).

¹⁶¹ *Robinson c. Films Cinar Inc.*, [2009] R.J.Q. 2261, para. 685 (Can. Que.). In Canada, “[i]t is an infringement of copyright for any person to do, without the consent of the owner of the copyright, anything that by [its Copyright] Act only the owner of the copyright has the right to do.” Copyright Act, R.S.C. 1985, c C-42, § 27(1) (Can.). Section 3(1) of the Canadian Copyright Act defines “copyright” to mean “the sole right to produce or reproduce the work or any substantial part thereof in any material form whatever.” *Id.* § 3(1). Therefore, critical to a determination of *prima facie* infringement is whether the defendant has reproduced a “substantial part” of the plaintiff’s work. See *Cinar Corp.*, 3 S.C.R. at para. 25.

Court of Appeal upheld this judgment, agreeing that the correct approach to determining infringement is to “examine the substantiality of the similarities with regard to the work as a whole and not with regard to the parts classified as substantial beforehand.”¹⁶² To do otherwise, the court opined, “would reduce the content of the work, [and] unduly restrict the scope of the protection granted by the *Copyright Act*.”¹⁶³

On appeal to the Supreme Court, Cinar argued that the lower court had applied the wrong substantial similarity test in finding that its show infringed Robinson’s copyright.¹⁶⁴ Instead of applying a holistic approach, Cinar contended that the court should have applied a three-step test: first, to determine what elements of Robinson’s show were original; second, to exclude non-protectable features of Robinson’s work (such as ideas, elements drawn from the public domain, and generic elements commonplace in children’s television shows); and finally, to compare what remained of *Robinson Curiosity* after this “weeding-out” process in order to determine whether a substantial part of Robinson’s work was reproduced.¹⁶⁵ In other words, Canada’s Supreme Court was being asked to apply—and so to affirm as the correct approach to determining substantial similarity in all classes of works—the *Altai* Abstraction-Filtration-Comparison test.¹⁶⁶ This approach had previously found some measured degree of favor in a software infringement case before the Ontario Court of Appeal, which had approved the reasoning of the trial judge who, citing extensively from *Altai*, had reasoned that: “[w]hether a Canadian court should adopt the abstraction-filtration-comparison method in deciding an action for copyright infringement or some other similar method’ it was clear that ‘some method must be found to weed out or remove from copyright protection those portions which . . . cannot be protected by copyright.’”¹⁶⁷

Chief Justice McLachlin, writing for the unanimous Court in *Cinar*, did “not exclude the possibility that . . . [the *Altai*] approach might be useful” in cases involving, for example, computer programs, but reasoned that “many types of works do not lend themselves to a reductive

¹⁶² Fr. Animation S.A. c. Robinson, [2011] R.J.Q. 1415, para. 46 (Can. Que.).

¹⁶³ *Id.* at para. 43; see *Tele-Direct (Publ’ns) Inc. v. Am. Bus. Info., Inc.* (1997), [1998] 2 F.C. 22, para. 21 (Can. C.A.) (“A wrong result can easily be reached if one begins by dissecting the plaintiffs’ work and asking, could section A be the subject of copyright if it stood by itself, could section B be protected if it stood by itself, and so on.” (quoting *Ladbroke, Ltd. v. William Hill, Ltd.* [1964] 1 All ER 465 (HL) 469 (appeal taken from Eng.))).

¹⁶⁴ *Cinar Corp.*, 3 S.C.R. at para. 34.

¹⁶⁵ *Id.*

¹⁶⁶ *Id.* at para. 35 (“The approach proposed by the Cinar appellants is similar to the ‘abstraction-filtration-comparison’ approach used to assess substantiality in the context of computer software infringement in the United States.” (citing *Comput. Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992))).

¹⁶⁷ *Delrina Corp. v. Triolet Sys. Inc.* (2002), 58 O.R. 3d 339, para. 43 (Can. Ont. C.A.).

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analysis.”¹⁶⁸ The Chief Justice observed that “Canadian courts have generally adopted a qualitative and holistic approach to assessing substantiality”:¹⁶⁹

As a general matter, it is important to not conduct the substantiality analysis by dealing with the copied features piecemeal. The approach proposed by the Cinar appellants would risk dissecting Robinson’s work into its component parts. The “abstraction” of Robinson’s work to the essence of what makes it original and the exclusion of non-protectable elements *at the outset of the analysis* would prevent a truly holistic assessment. This approach focuses unduly on whether each of the parts of Robinson’s work is *individually* original and protected by copyright law. Rather, the cumulative effect of the features copied from the work must be considered, to determine whether those features amount to a substantial part of Robinson’s skill and judgment expressed in his work as a whole.¹⁷⁰

With this passage, the Court endorsed a holistic comparison approach that suffers, in my opinion, from the same shortcomings as *Arnstein*’s impressionistic “ordinary lay observer” test and the *Roth* and *Krofft* approach to comparing “total concept and feel.” Here, too, no instruction is given to fact finders that, in assessing the substantiality of the copying, they must filter out unprotected elements of the plaintiff’s work. As Cameron Hutchison argues:

The holistic approach . . . eschews the distinction between ideas (and other non-protected elements) and expression on the basis that such an analysis is reductive of the originality of the first work. However, the refusal to identify those elements not subject to copyright protection undermines a key balancing mechanism within copyright doctrine A substantial taking may now consist of unprotectable elements—in whole or in part—that heretofore were available for all to use.¹⁷¹

Moreover, as Hutchison also notes, the failure of the Court to rigorously examine and explicitly parse the expressive elements from unprotected elements that combined to make up the “whole” of the work is likely to be interpreted as support for an impressionistic assessment of overall similarity.¹⁷²

Somewhat frustratingly, the Court ultimately does appear to base its finding of substantial similarity on the reproduction of a cumulatively

¹⁶⁸ *Cinar Corp.*, 3 S.C.R. at para. 35.

¹⁶⁹ *Id.*

¹⁷⁰ *Id.* at para. 36.

¹⁷¹ Cameron J. Hutchison, *Substantial Similarity After Cinar Corp v Robinson*, 31 CANADIAN INTELL. PROP. REV. 3, 11 (2015), https://ipic.ca/_uploads/54zqsu9sd.pdf [<https://perma.cc/WM9P-E57D>].

¹⁷² *Id.*

significant amount of detailed, expressive elements within the work, from the overall architecture to the graphic appearance of the settings and characters. The Court upheld the infringement finding based “not in the idea behind *Curiosity*, but in the way Robinson expressed that idea.”¹⁷³ In other words, it could have reached the same result with a more rigorous analytical dissection of the protected work. It is the Court’s position, however, that rather than separating ideas from expression at the outset, a holistic comparison between the works should be conducted *first*.¹⁷⁴ Arguably, then, what emerges from the Court’s reasoning is (on a generous reading) a “reverse dissection”¹⁷⁵ approach—one could call it, *comparison-abstraction-filtration*. If the point of dissection is to remove from consideration unprotected elements of the work before assessing substantial similarity, then it seems reasonably intuitive that, contrary to the approach in *Cinar*, “dissection should come first, and impression second.”¹⁷⁶ Nonetheless, as I will explain below, there might be something to be gained from turning this on its head.

Before we get there, however, a final notable point of divergence with the U.S. jurisprudence is the Supreme Court of Canada’s opinion that expert evidence may be admissible at the substantial similarity stage of the infringement analysis. Although similarity is to be judged “from the perspective of the lay person in the intended audience for the works at issue,” the Court reasoned:

This question should be answered from the perspective of a person whose senses and knowledge allow him or her to fully assess and appreciate all relevant aspects—patent and latent—of the works at issue. In some cases, it may be necessary to go beyond the perspective of a lay person in the intended audience for the work, and to call upon an expert to place the trial judge in the shoes of “someone reasonably versed in the relevant art or technology.”¹⁷⁷

The Court’s willingness to entertain expert evidence seemed geared toward ensuring that even latent similarities would not go unnoticed in layered or complex works or works intended for specialized audiences. It is potentially important, insofar as such expertise can assist decision-

¹⁷³ *Cinar Corp.*, 3 S.C.R. at para. 43.

¹⁷⁴ *Id.* at para. 36 (“[T]he exclusion of non-protectable elements at the outset of the analysis would prevent a truly holistic assessment.”). After this initial holistic assessment, however, the Court’s task is “to determine whether those [copied] features amount to a substantial part of Robinson’s skill and judgment expressed in his work as a whole.” *Id.* (emphasis added). The Court expressly acknowledges that “[w]hat constitutes a substantial part is determined in relation to the originality of the work that warrants the protection of the *Copyright Act*.” *Id.* at para. 26.

¹⁷⁵ See Hutchison, *supra* note 171, at 12.

¹⁷⁶ Samuelson, *supra* note 93, at 1841.

¹⁷⁷ *Cinar Corp.*, 3 S.C.R. at paras. 50-51 (quoting *VAVER*, *supra* note 5, at 187).

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makers, to exclude from consideration irrelevant similarities that owe their origin to unoriginal or public domain elements in the works.

While there are some promising aspects to the Court’s ruling, it is hard to disagree with Hutchison’s critical assessment that, in all likelihood, *Cinar*’s “holistic approach will . . . be applied in ways that unduly strengthen copyright protection.”¹⁷⁸ Frustrating as this case was for those of us who had hoped for a clear and well-articulated substantial similarity doctrine in Canada, my aim here is not to bemoan the confusing holistic comparison approach applied in *Cinar*. As we have seen, the inadequacy of impressionistic “totality” approaches to assessing substantial similarity is hardly a jurisdictional anomaly—indeed, it is a predictable path. What I do want to shine a light on, however, is a particular passage of the Canadian Supreme Court judgment that potentially reorients the substantial similarity test to make space for downstream creators. Admittedly, the passage begins by stating the generally accepted rule: “The question of whether there has been substantial copying focuses on whether the copied features constitute a substantial part of the plaintiff’s work—not whether they amount to a substantial part of the defendant’s work.”¹⁷⁹ But it continues:

The alteration of copied features or their integration into a work that is notably different from the plaintiff’s work does not *necessarily* preclude a claim that a substantial part of a work has been copied.

. . . .

This is not to say that differences are irrelevant to the substantiality analysis. *If the differences are so great that the work, viewed as a whole, is not an imitation but rather a new and original work, then there is no infringement.* As the Court of Appeal put it, “the differences may have no impact if the borrowing remains substantial. Conversely, the result may also be a novel and original work simply inspired by the first. Everything is therefore a matter of nuance, degree, and context.”¹⁸⁰

By the end of the passage, then, the Court has acknowledged that differences between the two works, when compared *as a whole*, can support a conclusion that the works are not substantially similar. In other words, the Court’s holistic or impressionistic “totality” approach can reveal that, notwithstanding the copying of protected elements from the

¹⁷⁸ Hutchison, *supra* note 171, at 19.

¹⁷⁹ *Id.* at para. 39. This is consistent with Lord Millet’s judgment in *Designers Guild Ltd. v. Russell Williams (Textiles) Ltd.* See *Designers Guild Ltd. v. Russell Williams (Textiles) Ltd.* [2000] UKHL 58, [2000] 1 WLR 2416 (Eng.) (“[W]hile the copied features must be a substantial part of the copyright work, they need not form a substantial part of the defendant’s work.”).

¹⁸⁰ *Cinar Corp.*, 3 S.C.R. at paras. 39-40 (emphasis added).

plaintiff's work, the defendant has produced *not a copy* but a *new work*. As a new work, examined in context, it is revealed to be original and not infringing despite what was borrowed. This is consistent with Professor David Vaver's view that "[a] decision on substantiality is best reached by considering not only what was taken but the context of the taking, including what the taker did with it."¹⁸¹ Looking holistically at both the similarities and differences between two works in this way, it becomes possible to see the defendant not merely as copier, but also as creator.

Somewhat paradoxically, with its resistance to the *Altai* dissection approach and its insistence upon holistic comparison, Canada's Supreme Court has therefore provided a doctrinal route toward a more equal assessment of the relative creative contributions of the plaintiff's and defendant's works. It has created space for the conclusion that a work that copies substantial expression from another is nonetheless *not a copy* because of the transformative nature of the copying. And, in doing so, it has created breathing room for transformative taking without any recourse to fair dealing.

In the following Part, we turn our attention back to the U.S. context, identifying a similar route toward accommodating the creative copy without the need to invoke fair use.

IV. TRANSFORMING "TOTAL CONCEPT AND FEEL"

It is generally regarded as uncontroversial that the substantial similarity analysis focuses on what has been borrowed from the plaintiff's work, and not on the extent to which the borrowing contributes to the defendant's work. In Justice Learned Hand's memorable formulation, once again, "no plagiarist can excuse the wrong by showing how much of his work he did not pirate."¹⁸² In Nimmer's equally definitive version, "[i]t is entirely immaterial that, in many respects, plaintiff's and defendant's works are dissimilar, if in other respects, similarity as to a substantial element of plaintiff's work can be shown."¹⁸³ It is this approach to assessing substantial similarity that allows infringement to be found when, for example, pop tracks borrow folk song riffs, or hip hop tracks sample the golden oldies, or stylized paintings reproduce conventional photographs. When the defendant's work is different in total concept and feel, but a substantial part of the plaintiff's work is recognizably reproduced within it, conventional copyright wisdom tells us that it is nonetheless *prima facie* infringing. This conventional wisdom

¹⁸¹ VAVER, *supra* note 5, at 186.

¹⁸² *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936).

¹⁸³ 4 NIMMER & NIMMER, *supra* note 1, § 13.03[B][1][a].

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is, however, misguided and contrary to the public purposes of the copyright system.

A. *Transformative Taking and the Significance of Substantial Dissimilarity*

The rule that it matters only what is taken, and not what is added, is widely accepted but by no means absolute. As noted by the Second Circuit in *Warner Bros. Inc. v. American Broadcasting Companies, Inc.*, Nimmer also recognizes, as a second and potentially contradictory proposition, that “a defendant may legitimately avoid infringement by intentionally making sufficient changes in a work which would otherwise be regarded as substantially similar to that of the plaintiff’s.”¹⁸⁴ In other words, sufficiently transforming whatever is copied can turn an infringing copy into a non-infringing new work. In *Durham Industries, Inc. v. Tomy Corp.*, the Second Circuit Court of Appeals observed that: “numerous differences tend to undercut substantial similarity. As a matter of logic as well as law, the more numerous the differences between two works the less likely it is that they will create the same aesthetic impact so that one will appear to have been appropriated from the other.”¹⁸⁵

This, in turn, suggests that additional differences might overwhelm the similarities that result from copying, such that placing the borrowed elements in new contexts and adding original expression can avoid a conclusion of substantial similarity.¹⁸⁶ Thus, in *Warner Bros. II*, a caped superhero character was sufficiently different from Superman in his overall aesthetic impression that, notwithstanding numerous overlapping

¹⁸⁴ *Warner Bros. Inc. v. Am. Broad. Companies, Inc.*, 720 F.2d 231, 241 (2d Cir. 1983) (quoting 4 NIMMER & NIMMER, *supra* note 1, § 13.03[B][1][b]); *see* *Warner Bros. Inc. v. Am. Broad. Companies, Inc.*, 654 F.2d 204, 211 (2d Cir. 1981); *see also* *Eden Toys, Inc. v. Marshall Field & Co.*, 675 F.2d 498, 501 (2d Cir. 1982).

¹⁸⁵ *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 913 (2d Cir. 1980) (internal citation omitted).

¹⁸⁶ *See, e.g.*, *Runstadler Studios, Inc. v. MCM Ltd. P’ship*, 768 F. Supp. 1292, 1298-99 (N.D. Ill. 1991) (“Assuming a significant level of protectible expression, those differences in and of themselves do not negate infringement. They do, however, combine to produce a different concept and feel. . . . [A]n ordinary observer would not find the sculptures to be similar and would note the differences without those differences being brought to his attention. The sculptures are sufficiently different so that the . . . [defendant’s] does not capture the ‘total concept and feel’ of [plaintiff’s]. Consequently, plaintiff has failed to show improper appropriation of its copyright work.”); *see also* *Reyher v. Children’s Television Workshop*, 533 F.2d 87, 93 (2d Cir. 1976) (upholding the district court’s finding that the two illustrated scenes had “such substantial differences as not to warrant a finding of infringement”); *see also* *Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir.1984) (holding that a list of direct similarities between at least seven scenes in the novels did not support a finding of substantial similarity because it “emphasize[d] random similarities scattered throughout the works”); *see also* *Williams v. Crichton*, 84 F.3d 581, 590 (2d Cir. 1996) (explaining that “such a scattershot approach . . . fails to address the underlying issue: whether a lay observer would consider the works as a whole substantially similar to one another”); *see also* *Blakeman v. Walt Disney Co.*, 613 F. Supp. 2d 288, 314-15 (E.D.N.Y. 2009) (“[T]he Court conclude[d] that all of the similarities between the works [arose] from noncopyrightable elements and [that] no lay observer—when comparing the total concept and feel, theme, characters, plot, scenes, sequence, pace and setting—could find the works as a whole to be substantially similar.”).

expressive details, he was found not to be substantially similar.¹⁸⁷ But then, is this not the plagiarist simply pointing to how much he did not pirate?

Judge Newman explained the tension between Nimmer's propositions in terms of the differences between different kinds of works having more or less linear components.¹⁸⁸ In fact, I would suggest, the doctrinal tension is better understood as reflecting the larger and inescapable tension between creativity and copying: the flawed notion that a neat line can be drawn between an original work that is within the exclusive control of the author and a copy that merely misappropriates another's work. It reflects, that is, the inconvenient reality that creativity is dialogic and cumulative.

Putting aside the dictates of copyright doctrine, *of course* one can create an original new work while copying a substantial part of another. And the ordinary observer, comparing two works that are substantially different in their overall meaning and effect, will *not* regard one as being, essentially, a reproduction of the other. When works are perceived and compared in their entirety, significant differences will readily be noted in the differing dominant impressions that they create. A "multi-dimensional total perception" of two works can quickly see past similarities to recognize the defendant's work as a new text in the proverbial utterance chain.¹⁸⁹

The thrust of the totality approach to determining substantial similarity has typically been toward finding infringement even—as critics have been wont to point out—in the absence of substantial reproduction of protected elements. It is generally understood that a "total concept and feel" test is capable of (and indeed intended to) capture infringements that a dissection approach might miss.¹⁹⁰ But there is, in

¹⁸⁷ *Warner Bros. Inc.*, 720 F.2d 231.

¹⁸⁸ *Id.* at 241-42 ("The tension between these two propositions perhaps results from their formulation in the context of literary works and their subsequent application to graphic and three-dimensional works. A story has a linear dimension: it begins, continues, and ends. If a defendant copies substantial portions of a plaintiff's sequence of events, he does not escape infringement by adding original episodes somewhere along the line. A graphic or three-dimensional work is created to be perceived as an entirety. Significant dissimilarities between two works of this sort inevitably lessen the similarity that would otherwise exist between the total perceptions of the two works. The graphic rendering of a character has aspects of both the linear, literary mode and the multi-dimensional total perception. What the character thinks, feels, says, and does and the descriptions conveyed by the author through the comments of other characters in the work episodically fill out a viewer's understanding of the character. At the same time, the visual perception of the character tends to create a dominant impression against which the similarity of a defendant's character may be readily compared, and significant differences readily noted.").

¹⁸⁹ *Id.*

¹⁹⁰ *Cf. Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 134 (2d Cir. 2003) ("[T]he total-concept-and-feel locution functions as a reminder that . . . infringement analysis is not *simply* a matter of ascertaining similarity between components viewed in isolation. For the defendant may infringe on the plaintiff's work . . . by parroting properties that are apparent only when numerous aesthetic decisions embodied in the plaintiff's work of art . . . are considered in

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these authorities, support for a totality approach that refutes infringement claims even when a substantial part of the original protected expression *is* reproduced. This could be especially important in cases of what Nimmer terms “fragmented literal similarity,” where particular elements from the plaintiff’s work are reproduced exactly.¹⁹¹ A rigorous dissection approach would produce a finding of infringement in such cases if substantial or vital elements of the plaintiff’s protected expression have been copied, even if the works are entirely different in overall concept and feel. A holistic comparison approach should not.

Recent decisions in the Ninth Circuit, applying a more nuanced extrinsic/intrinsic test, have emphasized that both the extrinsic test (which now filters out unprotected elements) and the intrinsic test (which compares the works in their total concept and feel) must be satisfied in order to find infringement.¹⁹² It should follow that, even where the extrinsic test shows substantial similarities in the objective details of the protected elements of the works, there can be no finding of infringement if a holistic, subjective comparison of the works reveals them to be substantially different in their overall impression. Thus, in the *Warner Bros.* case, as Oren Bracha explains, “[t]he improper appropriation analysis required comparing the expressive content of the two works and discerning the material differences in their meaning, *notwithstanding the technical similarities*.”¹⁹³ Even in cases where the “golden nuggets” of protected expression have been copied into the defendant’s work, the resulting work may look and feel very different from that of the plaintiff. In such cases, the “total concept and feel” test could therefore *preclude* a finding of infringement that a dissection approach might catch.

In the Second Circuit, the case of *The Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith* provides a helpful example of how this should work.¹⁹⁴ The case involves photographs taken by a professional photographer, Lynn Goldsmith, of the late and great pop icon, Prince.¹⁹⁵ Based on one of Goldsmith’s photographs, Andy Warhol had produced

relation to one another.”).

¹⁹¹ 4 NIMMER & NIMMER, *supra* note 1, § 13.03[A][2].

¹⁹² See, e.g., *Skidmore v. Led Zeppelin*, 952 F.3d 1051 (9th Cir. 2020); see also *Rentmeester v. Nike, Inc.*, 883 F.3d 1111 (9th Cir. 2018); see also *Funky Films, Inc. v. Time Warner Entm’t Co., L.P.*, 462 F.3d 1072, 1077 (9th Cir. 2006).

¹⁹³ Oren Bracha, *Not De Minimis: (Improper) Appropriation in Copyright*, 68 AM. U. L. REV. 139, 194 (2018) (emphasis added), http://www.aulawreview.org/au_law_review/wp-content/uploads/2018/11/03-Bracha.to_Printer.pdf [https://perma.cc/Q245-SYQ8]; cf. *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272-73 (2d Cir. 2001); see *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 748 (2d Cir. 1998) (affirming a finding of no infringement, not because what was taken fell within the public domain, but “because the total concept and overall feel created by the two works [could] not be said to be substantially similar”).

¹⁹⁴ *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312 (S.D.N.Y. 2019), rev’d, No. 19-2420 (2d Cir. 2021).

¹⁹⁵ *Id.* at 316.

sixteen prints known as the “Prince Series” that depicted Prince, in classic Warhol style, as “larger-than-life” and in “loud, unnatural colours.”¹⁹⁶



Goldsmith Photo



2016 Cover of Condé Nast
with Warhol Illustration

The Andy Warhol Foundation sought a declaratory judgment that the Prince Series did not infringe Goldsmith’s copyright in the underlying photograph because the works were not substantially similar, and the transformative use of the photograph was fair use.¹⁹⁷ The District Court agreed but based its summary judgment on fair use. The case is, however, a compelling example of the kind of transformative use that could be held not to infringe copyright in the first place. As fifteen Amici Curiae law professors argued on appeal to the Second Circuit Court of Appeals:

The dramatic divergence in visual rendition makes the two works not substantially similar. Although the district court was correct to grant summary judgment in favor of Warhol, [a] traditional infringement analysis is a more fundamental ground on which to decide this case than fair use.

Fair use is a valuable and flexible tool for realizing the goals of copyright. However, there is no need to use a Swiss Army knife when a simpler implement—traditional infringement analysis—will do. No matter what its purpose or effect on the market, a work that is not substantially similar in its use of copyrightable elements from the original simply does not infringe.¹⁹⁸

¹⁹⁶ *Id.* at 326.

¹⁹⁷ *Id.* at 322.

¹⁹⁸ Brief of Amici Curiae Law Professors in Support of Appellees & Affirmance at 4-5, *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, No. 19-2420-CV (2d Cir. Feb. 28, 2020), <http://clinic.cyber.harvard.edu/files/2020/03/192420cvAmicusLawProfs.pdf> [https://perma.cc/3V2H-NB6U] (signed by fifteen law professors and copyright scholars, including the author).

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Notwithstanding common expressive elements in the works, Amici argued, “the aesthetic of the protectable aspects of the Prince Series is very different from that of the Goldsmith Photo.”¹⁹⁹ It is not by virtue of the careful dissection and filtering out of unprotectable elements that the alleged copy is non-infringing, but because the “overall aesthetic appeal” of the defendant’s work could not reasonably be found to be substantially similar. When the protectable elements are “viewed as a whole,” they “differ significantly from the Goldsmith Photo in their aesthetic impression.”²⁰⁰ Through its expressive reinterpretation, “Warhol’s technique dramatically distorted the rendition of the Prince photograph, translating it from traditional portraiture to an unmistakably Warholian graphic collage, from an aesthetic that conveys an ‘uncomfortable’ and ‘vulnerable’ individual, to one that highlights the iconic, larger-than-life nature of its subject.”²⁰¹

In other words, Warhol created a new work that incorporated and responded to the preexisting photograph and its subject, invoking the symbols and icons that circulate more broadly in our culture. By comparing the works holistically, we can perceive them in expressive relation to one another. It becomes clear that Warhol’s dialogic engagement with the underlying image is not unlawful appropriation but an act of creative expression that brings a new work into being.

Although the Second Circuit Court of Appeals was ultimately unpersuaded,²⁰² the arguments presented in the Amici Brief nicely capture the way in which the “total concept and feel” test could be effectively reoriented to accommodate transformative uses of protected expression at the infringement stage:

In assessing the total aesthetic impression, this Court often considers whether the tone or theme of the works being compared is similar. By capturing when a protectable arrangement of unprotectable elements creates a distinct aesthetic impression, this test protects against

¹⁹⁹ *Id.* at 19.

²⁰⁰ *Id.* at 20.

²⁰¹ *Id.* at 24 (citing *Andy Warhol Found. for the Visual Arts, Inc.*, 382 F. Supp. 3d at 326).

²⁰² The Court of Appeals reversed the district court’s summary judgment on both the declaration of fair use and the dismissal of the copyright infringement claim. The ruling underscores the risks of relying on transformative fair use as an affirmative defence to protect dialogic creativity. *See id.* at 32-33 (“[t]here is little doubt . . . that the Prince Series reflects Andy Warhol’s talent, creativity, and distinctive aesthetic.’ . . . But . . . the question we must answer is simply whether the law permits Warhol to claim it as his own, and AWF to exploit it, without Goldsmith’s permission. And . . . we conclude that the answer to that question is ‘no.’”) The ruling also evinces the flaws of an impressionistic “ordinary observer” test when unauthored elements are not appropriately filtered from the analysis and the dialogic nature of the downstream work is disregarded. *See id.* at 54-55 (“AWF has conceded that the Goldsmith Photograph served as the ‘raw material’ for the Prince Series works [G]iven the degree to which Goldsmith’s work remains recognizable within Warhol’s, there can be no reasonable debate that the works are substantially similar.”)

dissecting a work into unprotectable elements in a way that misses the forest for the trees. *Reciprocally, similarity between the constituent elements of two works does not amount to copyright infringement if the total concept and feel is fundamentally different.*²⁰³

Notwithstanding the practical and principled shortcomings of the two-step tests developed on the foundations of *Arnstein*, *Roth*, and *Krofft*, it seems possible that a reconfigured combination of dissection and holistic comparison could appropriately limit the copyright owner's claim. A dissective analysis that parses protected from unprotected elements is essential to preventing copyright's overreach, and necessarily requires expertise in both copyright law and the expressive subject matter beyond the ken of the ordinary lay observer. On the other hand, a holistic comparison of two works is essential to understanding their dialogic relationship—it is only by comparing the two works in their totality that we can determine if one is reasonably viewed as an unlawful copy of the other. A work that is sufficiently different in its overall aesthetic is a new expressive work in its own right. A dialogic response is not reducible to an infringing reproduction; it is another text in the utterance chain that copyright law ought to encourage and not foreclose.

B. *Accommodating Dialogic Creativity Through Reverse Dissection: The Comparison-Abstraction-Filtration Approach*

In *Cinar*, as we saw, Canada's Supreme Court seemed to stumble upon what could, in its best light, be characterized as a "reverse dissection" approach (comparison-abstraction-filtration). To my mind, this order of analysis in copyright infringement claims might hold the key to accommodating dialogic creativity by better integrating the dissective and holistic approaches, as well as specialized expertise and lay-person impressions.

Once copying is established as a matter of fact (in light of sufficient objective similarity and access), the unlawful appropriation step should begin with the holistic comparison of the two works to determine if their overall aesthetic appeal is substantially similar. If the works are, perceived in their totality, *substantially different*, then the infringement inquiry should end there: The defendant has created a non-infringing new work that is, in its "total concept and feel," more than merely a colorable imitation of the plaintiff's work.²⁰⁴ If the works are substantially similar

²⁰³ *Id.* at 9 (emphasis added) (internal citations omitted).

²⁰⁴ See Rosenblatt, *supra* note 13, at 656 (arguing that, in assessing infringement, "[a] reframing of copyright as applying only to original *aspects* . . . would lead one to consider not whether a work is 'substantially similar' to a copyrighted work, but whether it is 'substantially different' from it"); see also Washington College of Law – AV, -B- (9/28/18 11:20 AM) *The 5th Global Congress on IP & the Public Interest*, YOUTUBE (Sept. 28, 2018), <https://www.youtube.com/watch?t=2982&>

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in their overall impression, the decision-maker should proceed (with the necessary expert evidence) to dissect the plaintiff’s work into protectable and public domain elements, and to filter out the latter from the infringement analysis. The defendant’s work can then be compared again to the *protected elements* in the plaintiff’s work. If they are not substantially similar after the unprotected elements have been appropriately filtered out, then there is no infringement *notwithstanding the similarities in their* “total concept and feel.” If, on the other hand, the defendant’s work is substantially similar to the protected expression in the plaintiff’s work, *prima facie* infringement is established, and the decision-maker can proceed to consider the availability of a fair use defense.²⁰⁵

The potential significance of such a reverse dissection analysis is most clearly seen in the context of cases involving a fragmented literal similarity that is recognizable and more than *de minimis*.²⁰⁶ Take the controversial Australian case of *EMI Songs Australia Pty Ltd. v Larrikin Music Publishing Pty Ltd.* as an example.²⁰⁷ Here, the High Court found that the hit song “Down Under” by Men at Work infringed copyright in the iconic Australian folk song “Kookaburra Sits in the Old Gum Tree” because a flute line played two of the four phrases in the traditional round song.²⁰⁸ Assessing the substantiality of the taking, Justice Emmett noted that “each melody or phrase may, by virtue of its importance in the overall schema of such an original musical work, constitute a substantial part of that work.”²⁰⁹ As such, it was concluded that by recognizably reproducing two phrases (albeit as a deliberate allusion to the original), the pop

v=2Rdw8VfODoU&feature=youtu.be [https://perma.cc/9PEC-VNSE] (watch from 50:00-1:05:00 for Carys Craig’s discussion on *Substantial Transformative Taking: Holistic Comparison and the Non-Infringing ‘New Work’*).

²⁰⁵ This approach recognizes that the unlawful appropriation step of the substantial similarity doctrine as a mixed question of fact and law. Cf. Shyamkrishna Balganes, *The Questionable Origins of the Copyright Infringement Analysis*, 68 STAN. L. REV. 791, 800 (2016), http://www.stanfordlawreview.org/wp-content/uploads/sites/3/2016/04/68_Stan._L._Rev._791_-_Balganes.pdf [https://perma.cc/9CUU-GC37] (observing that “as a principled normative matter—driven by copyright’s utilitarian and constitutional goals—there may be little reason to treat all aspects of the infringement analysis as purely factual questions for a lay jury”); see Gervais, *supra* note 130, at 618 (“[T]he Article proposes that appropriation (copying) be assessed as a mixed question of law and fact with a normative consideration of its (im)propriety based on customs, practices, and applicable ethical rules . . .”). I would suggest that, while a jury may be tasked with deciding underlying substantive issues of fact (e.g. whether there was actual copying on the balance of probabilities and of what), it should be for the judge to determine whether, based on these factual findings, copying amounted to infringement as a matter of law. Cf. *Google LLC*, 593 U. S. ____ (2021), 19-20 (taking a similar approach to fair use as a mixed question of fact and law, reasoning that the ultimate fair use question is primarily a legal one albeit that it involves subsidiary factual questions).

²⁰⁶ See Bracha, *supra* note 193 (identifying a trend in the U.S. copyright jurisprudence to effectively treat any recognizable copying as more than *de minimis*—and therefore as improper appropriation).

²⁰⁷ *EMI Songs Austl. Pty Ltd. v Larrikin Music Publ’g Pty Ltd.* [2011] 191 FCR 444 (Austl.).

²⁰⁸ *Id.* ¶ 58.

²⁰⁹ *Id.* ¶ 97.

anthem had reproduced a substantial part of Kookaburra.²¹⁰ Justice Emmett also conceded, however, that if this seemingly unavoidable conclusion was indeed correct, “then some of the underlying concepts of modern copyright may require rethinking.”²¹¹

The route toward rethinking the infringement determination, I would suggest, lies in the difference between the two works when compared as a whole. As the court noted, “[t]here is no similarity between the respective natures and objects of the work.”²¹² The plaintiff’s work was “a folk melody, children’s song or nursery rhyme, while Down Under was characterised as a rock anthem, and is influenced by ska and/or reggae.”²¹³ A holistic comparison of the two works would surely lead any reasonable listener to conclude that they are fundamentally different in their overall aesthetic impression. Being substantially different in total concept and feel, “Down Under” cannot reasonably be said to be substantially similar to “Kookaburra”—it should therefore have been welcomed into the cultural dialogue as a non-infringing new work (and a pretty great one at that!).

Approached in this way, the *Roth* “total concept and feel” analysis becomes an additional safeguard for downstream authors whose works, while borrowing from the protected expression of others, contribute something new and different to the public discourse. It should be evident how readily this approach could resolve many of the music infringement copyright cases that have recently plagued the U.S. music industry. Looking back to the controversial case of *Bright Tunes Music Corp. v. Harrisongs Music, Ltd.*, in which the court held that George Harrison had subconsciously copied the Chiffons’ “He’s So Fine” when composing “My Sweet Lord,” a reverse dissection approach would likely have found that, notwithstanding any actual copying in fact, the Harrison song was substantially different from the Chiffons’ song in its total concept and feel.²¹⁴ More recently, the same could be said of Katy Perry’s 2013 pop hit “Dark Horse” when compared as a whole to Marcus Gray’s Christian rap track “Joyful Noise”²¹⁵ (despite the similar eight-note ostinato in both works), or indeed of Led Zeppelin’s “Stairway to Heaven” when compared holistically with Spirit’s “Taurus” (even if the initial guitar riff

²¹⁰ *Id.* ¶ 100.

²¹¹ *Id.* ¶ 100; see Matthew Rimmer, *An Elegy for Greg Ham: Copyright Law, the Kookaburra Case, and Remix Culture*, 17 DEAKIN L. REV. 385 (2012), <https://ojs.deakin.edu.au/index.php/dlr/article/view/85/153> [<https://perma.cc/2PMJ-EJVB>] (arguing that the *Kookaburra* case highlights the need for substantive law reform to permit digital sampling, mash-ups, and creative re-mixes).

²¹² *EMI Songs Austl. Pty Ltd.*, 191 FCR at ¶ 92.

²¹³ *Id.*

²¹⁴ *Bright Tunes Music Corp. v. Harrisongs Music, Ltd.*, 420 F. Supp. 177 (S.D.N.Y. 1976).

²¹⁵ See *Gray v. Perry*, No. 2:15-CV-05642-CAS-JCx, 2020 U.S. Dist. LEXIS 46313 (C.D. Cal. Mar. 16, 2020).

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is substantially the same).²¹⁶ Certainly, in sampling cases like *Newton v. Diamond*, there could be no doubt of the conclusion that the Beastie Boys’ “Pass the Mic” hip hop track is fundamentally different in its overall aesthetic appeal from the avant-garde jazz flutist’s “Choir” composition.²¹⁷

Even in cases that involve comprehensive non-literal similarities, an initial holistic comparison approach should offer a better resolution. Surely, for example, it would be difficult to conclude that Pharrell Williams’ and Robin Thicke’s “Blurred Lines” track was substantially similar, *as a whole*, to Marvin Gaye’s “Got to Give it Up.”²¹⁸ The upbeat, explicitly misogynistic rap track might share a certain background “groove” with the relaxed vibes of Gaye’s 1977 hit, but overall the works are quite fundamentally different in their aural appeal. Even if they were found to be substantially similar in their totality, however, a subsequent abstraction-filtration-comparison process—conducted with the assistance of expert evidence—should filter out the abstract “feel” or “groove” of the song and its common stock building blocks, ultimately leaving little if any overlap in the protectable elements of the works. Indeed, when it comes to treating transformative uses as *prima facie* non-infringing, it should be acknowledged that even the landmark case of *Campbell v. Acuff-Rose Music, Inc.*, which established the centrality of transformativity to the fair use defense, could likely have been resolved on the basis that “Big Hairy Woman” was substantially different from “Oh Pretty Women” in the first place.²¹⁹

It might now be objected, given the above examples, that integrating a transformative use analysis into the unlawful appropriation test in this way unduly restricts the copyright owner’s claim: Downstream creative users become non-infringing authors, and the original author is unable to prevent modification or creative re-use of their work. If this is a critique of the reverse dissection approach, I can only say that it ought not to be. A dialogic response is not conceptually or normatively reducible to an infringing reproduction.²²⁰ The point is not that any minimal addition or alteration should be sufficient to escape potential liability, but that works with a substantially different “concept and feel” ought not to be within

²¹⁶ See *Skidmore v. Led Zeppelin*, 952 F.3d 1051 (9th Cir. 2020).

²¹⁷ See *Newton v. Diamond*, 388 F.3d 1189 (9th Cir. 2003).

²¹⁸ See *Williams v. Gaye*, 885 F.3d 1150 (9th Cir. 2018).

²¹⁹ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994).

²²⁰ See Rosenblatt, *supra* note 13, at 656 (distinguishing between derivative works that compete with the underlying work or trade on its appeal, and those that “create[] [their] own distinct expression” and should be largely shielded from liability on social justice grounds); cf. Glynn S. Lunney, Jr., *Reexamining Copyright’s Incentives-Access Paradigm*, 49 VAND. L. REV. 483, 650 (1996), <https://scholarship.law.vanderbilt.edu/cgi/viewcontent.cgi?article=2184&context=vlr> [https://perma.cc/YBG9-GRGB] (proposing an economic argument for limiting the scope of the derivative right to cover only exact or nearly exact reproductions).

the scope of the copyright owner's claim to begin with. If the purpose of copyright is to encourage creative expression in the long-term interests of society—and if creative expression necessarily includes inspiration, borrowing, and re-use—then copyright ought not to prohibit creative, transformative uses of protected works. And if such uses ought not to be prohibited (and, indeed, ought to be encouraged) as a matter of course, then it makes little sense to leave them vulnerable to the vicissitudes of the contextual fair use defense rather than carving them out of the copyright owner's exclusive domain at the outset.

In *EMI Songs*, the Australian court, seemingly somewhat dismayed by the result of its own application of copyright doctrine, noted that the framers of the *Statute of Anne* would likely have regarded the taking of the melody of “Kookaburra” not as infringement but “as a fair use that did not in any way detract from the benefit given to [the author] for her intellectual effort in producing Kookaburra.”²²¹ The original “fair use” cases in eighteenth-century Britain did not require a separate defense to be pled once unlawful appropriation was established; rather, they found that investing intellectual effort to improve upon existing works and so to contribute some new benefit to the public was *prima facie* non-infringing.²²² For a system ostensibly aimed at the encouragement of learning, such a conclusion makes good sense. In 1803, in the first case to recognize the concept of fair use, Lord Ellenborough explained that the defendant had made “use of another's labours for the promotion of science, and the benefit of the public,” and so had not infringed copyright.²²³ In 1839, in the first case to use the term “fair use,” Lord Langdale rejected the argument because the defendant had expended “no other labour . . . than in copying the Plaintiffs' work.”²²⁴ Infringement was found where the later work simply communicated the same knowledge as the original, with mere repetition of another's work conferring no notable advantage upon the public.²²⁵ As Kathy Bowrey

²²¹ *EMI Songs Austral. Pty Ltd. v Larrikin Music Publ'g Pty Ltd.* [2011] 191 FCR 444, ¶ 101 (Austl.) (referencing the first modern copyright legislation, the “Statute of Anne”).

²²² See Bowrey, *supra* note 32; see also Oren Bracha, *Commentary on Folsom v. Marsh (1841)*, PRIMARY SOURCES ON COPYRIGHT, http://www.copyrighthistory.org/cam/tools/request/showRecord?id=commentary_us_1841 [https://perma.cc/J4BJ-M8QT] (“Traditional English doctrine . . . allowed ample breathing space to abridgments, translations, imitations and other derivative uses.”).

²²³ *Cary v. Kearsley* (1802) 170 Eng. Rep. 679, 680; see Burrell, *supra* note 32, at 366; see also WILLIAM F. PATRY, *THE FAIR USE PRIVILEGE IN COPYRIGHT LAW* 17 (2d ed. 1995).

²²⁴ PATRY, *supra* note 223, at 16 (identifying *Lewis v. Fullarton* as the first case in which “fair use” was used to describe the extraction of elements from an existing work during the creation of another: the defendant argued that he had “made only a fair use of a former publication on the subject of his own work”).

²²⁵ See *Roworth v. Wilkes* (1807) 170 Eng. Rep. 889, 890 (KB); see also *Gyles v. Wilcox* (1740) 26 Eng. Rep. 489 (Ch) (“[A] real and fair abridgment, . . . may with great propriety be called a new book, because . . . the invention, learning and judgment of the author is shewn in them, and in many cases are extremely useful”); see generally Matthew Sag, *The Prehistory of Fair Use*, 76

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explains, in these early cases, “[a] finding of ‘piracy’ was reserved for the cases where there was no public interest being served by the defendant’s taking.”²²⁶

From the early years of the modern copyright system, then, courts concerned with copyright’s public purpose have declined to find unlawful appropriation in cases where downstream authors create new works, communicate new knowledge, or confer new benefits upon the public. Rather than relegating consideration of the transformative nature of a use—the new meaning or message conveyed by the defendant’s work—to the realm of affirmative defense, substantially transformative uses should require no defense. With a view to copyright’s history and purpose, as well as the tangled web of copyright infringement authorities, there is ample authority to support this simple but important conclusion: If a defendant’s work is substantially different, in its total concept and feel, from the plaintiff’s work, it is not an infringing copy thereof. A downstream author exercising expressive agency, communicating something new to the public, should not be relegated to the role of infringer or forced to plead a defense—they are engaged not in an act of improper appropriation but in a dialogic act of meaning-making.

CONCLUSION

The unlawful appropriation step of the copyright infringement analysis is a doctrinal entranceway for normative judgments about the right and wrong of copying. Through the doctrinal device of “substantial similarity,” copyright law determines whether copying rises to the level of “improper” or “illicit.” A shift in our conception of the (im)morality of copying should therefore provoke a rethinking of the evaluative means by which unlawful appropriation is to be determined.²²⁷

The Romantic figure of the solitary author, independently producing original works *ex nihilo*, inhabits copyright’s normative core.²²⁸ It follows from this idea that the original author is thereby entitled to own their work (conceived of as a stable, bounded thing capable of occupation and control). When we join the dots of this moral claim to copyright’s

BROOK. L. REV. 1371 (2011), <https://lawcommons.luc.edu/cgi/viewcontent.cgi?article=1157&context=facpubs> [<https://perma.cc/B34R-VFQB>] (exploring the gradual coevolution of copyright and fair use in British copyright law from the eighteenth century to the mid-nineteenth century).

²²⁶ Bowrey, *supra* note 32, at 59.

²²⁷ Cf. Gervais, *supra* note 130 (arguing that “improper appropriation” should be assessed with a view to the *propriety* of copying, to be gauged against the yardstick of copyright’s constitutional purpose, as well as customs, practices and applicable ethical rules).

²²⁸ Cf. Oren Bracha, *The Ideology of Authorship Revisited: Authors, Markets, and Liberal Values in Early American Copyright*, 118 YALE L.J. 186, 188 (2008), https://www.yalelawjournal.org/pdf/733_yaimp1jw.pdf [<https://perma.cc/KB5X-V2WQ>] (“[W]e often continue to picture solitary authors creating original ideas *ex nihilo* through their intellectual labors. This picture lies at the *normative heart* of our vision of copyright.” (emphasis added)).

infringement doctrine, we can see that the doctrine readily permits authorial overreach precisely because it reflects the original author's moral claim to occupy the *whole work* as an object of property. This vision of the worthy independent author informs the normative underpinnings of the traditional "totality" approach to finding infringement, as Peter Jaszi observed:

"Totality" [holistic] analysis is yet another doctrinal reflection of the ideology of Romantic "authorship." In this interpretation of copyright doctrine, "authors'" rights in their "works" extend not only to the content of their own devising, but also to what they have themselves borrowed from the intellectual "commons"—presumably because they have subsequently impressed their artistic personalities on the borrowed materials. This vision marginalizes yet other "authors," who arrive still later on the scene, and denies that they might have an equally important role to play in the continuing process of cultural transmission by which texts are reformulated and elaborated. In effect, "totality" analysis converts copyright into a textual *Homestead Act*.²²⁹

At the outset of this Article, I sketched an alternative vision of the author and their work—one that is based not on the mythical original author-figure, but on the relational author-self; and not on the independent author-as-originator who creates something new out of nothing, but on the socially-situated author-as-speaker, whose creativity is inherently dialogic. The work is not a freestanding thing to be controlled, in this alternative conception, but a text or utterance that can be understood only in dialogic relation to what has gone before and what is yet to come. In Bakhtinian terms, the work as utterance necessarily exists in a chain of utterances, incorporating and responding to the proximal and distal *already-spoken*s, and anticipating the proximal and distal *not-yet-spoken*s. Such a conception of dialogic authorship displaces the monologic claims of the romantic author-as-owner, and, in doing so, it alters the normativity of copying. If every text exists in dialogic relation to others, if creativity is inherently intertextual, then the expressive process of using, reproducing, adapting, and transforming existing texts is no more and no less than creative authorship. And if this is the nature of creative authorship, then it is exactly what the copyright system should be calibrated to encourage.

If our conventional approaches to determining copyright infringement have reflected a monologic idea of authorship, then we need to rethink copyright infringement doctrine to better accommodate

²²⁹ Hutchison, *supra* note 171, at 19 (alteration in original) (quoting Peter Jaszi, *On the Author Effect: Contemporary Copyright and Collective Creativity*, 10 CARDOZO ARTS & ENT. L.J. 293, 305 (1992), <http://cardozoaelj.com/wp-content/uploads/Journal%20Issues/Volume%2010/Issue%202/Jaszi.pdf> [<https://perma.cc/MLU8-2RKT>]).

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dialogic creativity. A “totality” approach to determining unlawful appropriation has typically allowed copyright owners to lay claim to the “totality” of a work—its *total concept and feel*—without adequately parsing out unprotected elements to properly safeguard downstream creativity and the public domain. I have argued, however, that this “totality” approach, which compares works holistically and impressionistically, might paradoxically hold the promise of a more discerning infringement doctrine—one that allows us to perceive the plaintiff’s and defendant’s works in dialogic relation to one another, and so to better gauge the defendant’s contribution to the cultural conversation. By asking, first, whether the defendant’s work is substantially similar to, or different from, the plaintiff’s work in its total concept and feel, we can assess whether it is effectively no more than a mere copy, or whether it is more properly regarded as a new text in the utterance chain. As expressed by Canada’s Supreme Court: “If the differences are so great that the work, viewed as a whole, is not an imitation but rather a new and original work, then there is no infringement.”²³⁰

By conducting an initial holistic comparison at the outset of the unlawful appropriation test, we can determine the lawfulness of a work with a view not only to what it reproduces, but also with an eye to the new meaning that it brings to the benefit of the public, in furtherance of the public interest that copyright is said to serve. This approach makes space for creative re-users whose new works, viewed in their entirety, bear little overall resemblance to the works from which they have borrowed. However, where a downstream work is, in its totality, substantially similar to the protected work from which it copied, it may be more duplicative than dialogic—in which case it may properly be relegated to the category of infringing reproduction. But, before such a final determination can be made, the unprotected elements must be extracted from the analysis through the conceptual process of abstraction and filtration, in order to prevent over-claiming by the copyright owner. Public domain elements should circulate freely in our culture as the *already-spoken* to which no single speaker can lay claim.

If we take seriously the public purposes that justify the copyright system, then we should recognize the creative contribution of transformative uses by downstream authors. An author who transforms the total concept and feel of another’s work has added something new to the cultural conversation. If authorship is inherently dialogic and cumulative, then every author should be empowered to exercise the same creative agency, and to respond to and build upon what has gone before.

²³⁰ Cinar Corp. v. Robinson, [2013] 3 S.C.R. 1168, para. 40 (Can.).

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And if this is true, then copyright infringement doctrine should itself be transformed to better accommodate dialogic authorship—for there is no other kind.