FROM THE FACULTY BLOG

Copyright law requires courts to answer difficult questions, such as: How much of the photo, immediately above to the left, is fact, and how much is art? And how much of that art is taken by the illustration at right?

Source of Prince images: Opinion of U.S. Supreme Court, No. 21-869 (May 18, 2023)

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The Grapes of *Roth*

Bruce E. Boyden, associate professor of law, posted a series of entries on the Marquette Law School Faculty Blog concerning his recent law review article on copyright law. The following combines the first two posts, appearing on January 26 and 27, 2025.

My latest article, "The Grapes of *Roth*," has just come out in print in the *Washington Law Review*. In it, I argue that copyright law passed through at least three important phases over the course of the last century, in which judges struggled in different ways with the process of how to determine whether two works are infringing. This periodization of copyright decision-making is, I believe, insufficiently appreciated; copyright lawyers, scholars, and students tend to read cases from any era as going about the decision-making process in the same way. The goal of the article is to focus more attention on how decision-making has varied over time, and to at least begin the discussion of which era's procedure is closer to optimal.

The title is a reference to the old copyright chestnut *Roth Greeting Cards v. United Card Co.* (9th Cir. 1970), in which the majority concluded that infringement was the right call based on the shared "total concept and feel" of the plaintiff's and defendant's greeting cards. The "total concept and feel" standard from *Roth* is one that copyright lawyers love to hate. The phrase is nearly meaningless: concepts are explicitly excluded from protection under 17 U.S.C. § 102(b), and copyrighted works are distinct from any physical embodiment, meaning they have no "feel." The influential Nimmer treatise has for decades reproached the standard as "invit[ing] an abdication of analysis."

So why is it so popular? Judges seem to have no qualms about using it, no matter what the commentariat says. They have cited it regularly as the standard for infringement in cases involving non-identical works from the 1980s to the present day. Indeed, it has found its way into jury instructions: juries are commonly told, without further elaboration, that two works are infringing if one was copied from the other and they share the same "total concept and feel." The answer to this puzzle, I argue, sheds light on the transition from the first phase of copyright law during the last century to the second, and reveals the trap sprung (or the "grapes" pressed) in the third phase.

The story starts with Learned Hand. Judge Hand, as I've mentioned before [in "Learned Hand: You're Reading Him Wrong," a post on the Marquette Law School Faculty Blog on April 13, 2018], is one of the giants of copyright law. His opinions for the Second Circuit in *Nichols v. Universal Pictures Corp.* (1930), *Sheldon v. Metro-Goldwyn Pictures Corp.* (1936), and *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.* (1960) have been mainstays in copyright textbooks and cited in caselaw and treatises for decades.


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But one of the reasons why is not often appreciated. Take a look at any copyright decision from Hand's heyday, such as his district court opinion in *Fred Fisher v. Dillingham* (S.D.N.Y. 1924), the report of which begins as follows: "In Equity. Bill by Fred Fisher, Inc., against Charles Dillingham and others. Decree for complainant."

The most important words are the first: "In Equity." Up through 1938, when the Federal Rules of Civil Procedure were adopted, and even for decades after that time, judges were used to resolving certain disputes based on considerations of fairness and justice—suits brought in equity. Not just any claim could be filed in equity; complainants had to be requesting some sort of relief that was not available to them "at law," either because that relief was only equitable (discovery, injunctions, rescission, etc.) or because there was some sort of gap or loophole in the law that needed filling. The judge hearing a dispute in equity would resolve the issue without a jury and based on principles of fairness, such as those encapsulated in the maxims of equity.

Most copyright cases—indeed, most intellectual property cases—before 1938 were brought in equity, because typically the primary relief being sought was an injunction. Indeed, well after the merger of law and equity in 1938, courts still heard copyright cases claiming injunctive relief in an equitable fashion, without a jury; and even after the Supreme Court nixed that practice whenever damages were alleged, in 1959's *Beacon Theatres, Inc. v. Westover*, juries were rarely requested in copyright cases until the 1980s. The result was that, throughout the middle decades of the 20th century, judges were quite used to making infringement decisions on their own, based on their impressions of the two works at issue.

This was in many ways fortunate, because an infringement determination in non-exact copying cases involves a tricky balance of three disparate inquiries. *First*, there is a question of amount: how much of the plaintiff's material wound up in the defendant's work? *Second*, there is a legal determination to be made: was the borrowed material the sort that the law should categorize as protected? And *finally*, there is a question of line-drawing: where is the threshold of impermissible borrowing, and did the defendant cross it?

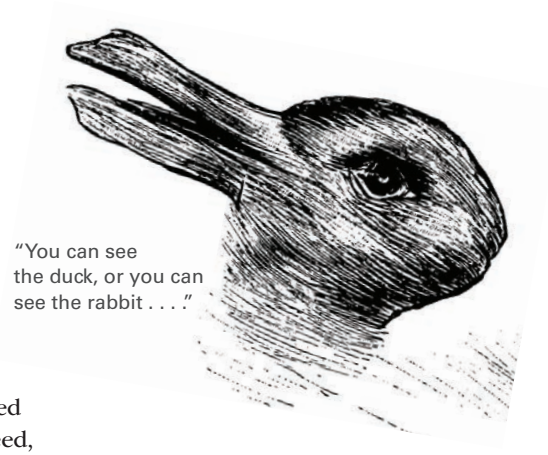
The first of these questions is more or less factual, although determining whether or how much a defendant's non-identical character or melody or painting is based on the plaintiff's is the stuff of many late-night pop culture arguments. (Is 1978's *Battlestar Galactica* derivative of *Star Wars*? How much?) The second question is mostly legal, and no less difficult. Factual material is not protected, and neither are the general ideas or concepts underlying a work. But where's the boundary between a fact (not protected) and how it's expressed (protected)? What is the expression in a work (protected) and when does it become so abstract or common that it becomes a mere idea (unprotected)?

For example, take photographs, such as one of the musician Prince [see opposite page]. Obviously Prince's face is not something the photographer created, and she can't claim protection over it—Prince's face is a sort of fact. But the artistry that the photographer added is copyrightable. What is it, exactly? And how much of the artistry, and not merely the features of Prince's face, is duplicated in the Warhol artwork [to the right of the photograph]?

These two questions—the amount taken and its protectability—are hard to consider simultaneously. Focus on the total amount of similarities and dissimilarities, and their protectability fades from view. Focus on the protectability of various pieces of the plaintiff's work, and the total amount taken becomes blurry. It's a bit like the old duck–rabbit image popular in introductory psychology courses. [See image at the top of the next page.] You can see the duck, or you can see the rabbit, and maybe you can rapidly shift back and forth, but unless you have super-human perception or you are utterly unfamiliar with animals, you can't see a "duck–rabbit."

So the first two questions are difficult to answer together. But it's also impossible to disentangle them. The amount question and the protection question cannot be tackled seriatim but, rather, have to be considered at once in order to answer the third question: has the defendant taken enough *protectable material* to be liable for infringement? That third question is in some ways the most difficult of all, because it is neither a factual question nor a legal question, but a policy question: how much taking of protected material from the plaintiff's work is too much? When does it become unreasonable?

Policy questions involving reasonableness calculations might be ideal for a jury to determine, but not only is it not possible to take on the



"You can see the duck, or you can see the rabbit . . . ."

three questions one at a time, it's also not possible to assign them neatly to different decision-makers. Copyrighted material cannot simply be separated out like gold ore from silt. Both the precise details of a work, such as lines of dialogue, and its higher-level structure, such as a novel's plot, can be copyrightable. A judge could not therefore itemize every protected or unprotected component of a work for a jury. Indeed, determining whether the defendant took protected material depends on exactly how the defendant copied it—isolated phrases or pages of text; the general concept or every beat of the narrative. The amount of appropriation depends on what is protected, and what is protected depends on the amount of appropriation.

Judges in the Learned Hand era resolved the question of infringement by making all of the judgment calls at once, in one fell swoop. They announced these decisions with all of the explanatory detail that football referees provide when they are trying to determine if a receiver both completed the catch and made a "football move" before dropping it—in other words, "fumble" or "incomplete."

Here's Hand himself in his classic 1936 opinion in *Sheldon v. Metro-Goldwyn Pictures* (2d Cir.), involving an infringement claim against the Joan Crawford film *Letty Lynton* [see the top image on p. 44 simply for illustrative purposes]. After summarizing the plaintiff's play, the historical event on which it was based, the historical novel that the defendant's film was allegedly based on, and the defendant's film, Hand concluded that there were a number of similarities traceable only to the plaintiff's play: e.g., "Each heroine's waywardness is suggested as an inherited disposition; each has had an errant parent involved in scandal; one killed, the other becoming an outcast." As to why such seemingly general similarities amounted to infringement of protected expression, Hand wrote only that "the dramatic significance of the scenes we have recited is the same, almost to the letter." Case closed.

Hand's well-known and earlier-mentioned 1930 *Nichols* opinion is similar. *Nichols* involved another play-to-film infringement claim, this time that Universal Pictures had ripped off the plot and characters of the plaintiff's hit play, *Abie's Irish Rose*, to make the silent film, *The Cohens and the Kellys* (described in some ill-advised ad copy as "the 'Abie's Irish Rose' of the Screen"). Hand famously spends some time talking about how general ideas are not infringing even if copied, and how some characters in a work have sufficient detail to be copyrightable whereas others don't. Then it's time for the "Application" part of the Issue–Rule–Application–Conclusion or IRAC analysis (as I tell my students, the *A* is what you get paid for!), where Hand concludes, "In the two plays at bar we think both as to incident and character, the defendant took no more—assuming that it took anything at all—than the law allowed."

Why is this? "The stories are quite different." Hand then identifies several differences. "The only matter common to the two is a quarrel between a Jewish and an Irish father, the marriage of their children, the birth of grandchildren and a reconciliation. . . . [T]here is no monopoly in such a background. . . . [S]o defined, the theme was too generalized an abstraction from what she wrote. It was only a part of her 'ideas.'" Why ideas and not protected material? Not only does Hand not explain why the material in question is unprotected, he insists that it's unexplainable: "Nobody has ever been able to fix that boundary, and nobody ever can."

Nor is this some sort of quirk about Learned Hand. Copyright opinions from the 1900s through the 1950s bore this sort of decision-making style. For example, in *Nikanov v. Simon & Schuster, Inc.* (2d Cir. 1957), future Supreme Court justice Potter Stewart affirmed a district court's finding that the defendant's Russian language textbook infringed on the plaintiff's explanatory chart, holding that "[w]hile only a part of the plaintiff's copyrighted work was appropriated, what was taken was clearly material." As to whether the taken portion constituted idea or expression, Stewart held that by copying the "arrangement, order of presentation and verbal illustration" of a portion of the chart, "more than mere idea" was taken. Why more? It just seemed that way to the court. "This case is perhaps close to the borderline, but no closer than many others in which copyright protection has been afforded."

For better or worse, judges decided non-identical infringement claims in the early to mid-twentieth century by comparing the two works as an ordinary observer would and then mentally paring down the similarities to compare only protected expression, at the end making some judgment about whether the similar and protected material was significant enough to result in liability for the defendant. All that came screeching to a halt in the 1960s, when judges started concluding that this method of decision-making was not sufficiently "law-like." That will be the focus of my next blog post. ■