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Do Those Plans Infringe on My Plans? Depends Where You Are

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The primary intellectual property protection afforded for construction designs is copyright, which protects the author of construction designs against having competitors steal their unique designs and creativity. Copyright infringement occurs when someone other than the author or a license holder reproduces the copyrighted work, prepares a derivative work based on the copyrighted work, or prepares a work that is impermissibly similar to the copyrighted work. Generally, an author must prove three things in order to demonstrate copyright infringement:

- The author is the owner of a valid copyright in the allegedly infringed work;
- The defendant had access to the copyrighted work; and
- The allegedly infringing work is substantially similar to the copyrighted work.

The defendant's work infringes on the author's copyrighted work only if it is substantially similar

to the author's copyrighted work.¹ In the context of copyright infringement, substantial similarity is a term of art. The exact meaning of substantial similarity, and the process for determining whether one work is substantially similar to another, varies from jurisdiction to jurisdiction.

The U.S. Court of Appeals for the Ninth Circuit's test for evaluating the substantial similarity of two works entails a bifurcated analysis.

This article analyzes how different federal court circuits have articulated the test for substantial similarity in construction designs. As will be discussed herein, the differences in how various federal circuits articulate the test have major effects on how copyright infringement cases in those circuits should be prosecuted. Among other issues, how the substantial similarity test is articulated in a jurisdiction has a substantial effect on how expert witness testimony can be used in a case in that jurisdiction.

THE EXTRINSIC/INTRINSIC TEST

The U.S. Court of Appeals for the Ninth Circuit's test for evaluating the substantial similarity of two works entails a bifurcated analysis.

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First, the court performs the “extrinsic test,” and objectively considers whether the two works share substantially similar ideas.

Second, the jury performs the “intrinsic test,” and determines whether an ordinary observer would perceive that the two works express those shared ideas in a substantially similar way.

The U.S. Courts of Appeals for the Fourth² and Eighth³ Circuits also use this test.

Extrinsic Analysis Stage

The extrinsic test involves an examination of “specific criteria which can be listed and analyzed.”⁴ Expert testimony is often admissible to help identify these criteria and inform the court’s comparative analysis.⁵

Intrinsic Analysis Stage

If the court finds that the two works share copyrightable ideas, the case advances to the fact finder for the intrinsic analysis. This test does not hinge on specific objective criteria. Rather, it asks what “the ordinary reasonable person” perceives about the two works. Expert opinions are not relevant to that inquiry.⁶ Thus, litigants generally may not present expert testimony during the intrinsic stage of analysis.⁷

The court reversed the district court’s judgment and ordered a new trial to determine whether the two works contained substantially similar designs.

In *Rotlund Co. v. Pinnacle Corp.*,⁸ the Eighth Circuit vacated a jury verdict because the district court admitted expert testimony during the intrinsic stage of analysis. There, the plaintiff sued a group of homebuilders and an architectural firm for infringing its copyrighted architectural designs and works.⁹ Before trial, the district court performed the extrinsic test, granting partial summary judgment for the plaintiff after finding that the ideas expressed in the defendants’ technical drawings were substantially similar to the copyrighted works.¹⁰

At trial, certain of the defendants presented the testimony of an architectural expert witness. That expert created electronic overlays of the townhomes

at issue, and “testified regarding the differences of the key elements of the [architectural] plans.”¹¹ He also highlighted disparities in the kitchen designs, gabled entries, and stairways of the two townhomes.¹² Ultimately, the jury found that none of the defendants’ drawings or works infringed upon the plaintiff’s copyrights.

On appeal, the Eight Circuit reasoned that the “only issue before the jury was whether the expression in [the defendants’] works was substantially similar to the expression in [the plaintiff’s] works.”¹³ And because expert opinion is not relevant to that intrinsic analysis, the district court abused its discretion in admitting the expert’s testimony.¹⁴ Thus, the court reversed the district court’s judgment and ordered a new trial to determine whether the two works contained substantially similar designs.

THE INTENDED AUDIENCE TEST

Other federal appellate courts, including the U.S. Courts of Appeals for the Sixth, Tenth,¹⁵ and D.C. Circuits,¹⁶ use a different bifurcated analysis to determine whether two works are substantially similar.

In step one, the court identifies what aspects of a work, if any, are copyrightable.¹⁷

The second step asks whether, from the perspective of the work’s intended audience, “the allegedly infringing work is ‘substantially similar’ to the protectable elements of the [copyrighted] work.”¹⁸

This test is also referred to as the “abstract filtration” test.

Protectable Elements Stage

The first part of this test is a question of law that requires the court to “filter out” elements of the copyrighted work that are not copyrightable (hence the “filtration” portion of the “abstract filtration” test).¹⁹ Because courts are reluctant to admit expert testimony on questions of law, the Sixth Circuit and D.C. Circuit “apply a more stringent standard [than the Ninth Circuit] regarding when to allow expert testimony on the first part of the test.”²⁰ Nonetheless, these courts will admit expert testimony so long as it helps to “identify whether there are original design elements present” in the plaintiff’s work.²¹

Substantial Similarity Stage

During the second prong of the test – the substantial similarity analysis – the Sixth and D.C.

Circuits apply a more refined standard than the simple “ordinary observer” standard of the Ninth and Second Circuits. This standard asks who is the “ordinary observer” of the copyrighted work? That is, who is the intended audience?²²

Under this standard, expert testimony is prohibited if the intended audience of a copyrighted work is the lay public.²³ However, if the intended audience is expected to possess some specialized expertise, “the specialist’s perception of similarity may be much different from the lay observer’s, and it is appropriate in such cases to consider similarity from the specialist’s perspective.”²⁴

In other words, litigants may use expert testimony if the trier of fact should consider the substantial similarity determination from the perspective of a specialist. The expert’s job in these cases is “to educate the trier of fact” about those elements of a work for which the specialized audience will look.²⁵

The admissibility of expert testimony in courts applying this test thus hinges on whether the intended audience for architectural designs is the general public. No court has specifically ruled on that question. However, litigants may be able to introduce expert testimony by arguing that their architectural designs are not targeted at the general public: such designs are created to help constructors, engineers, and other specialized audiences create buildings.²⁶

It is critical to conceptually distinguish between the designs themselves and the built structure.

It is critical to conceptually distinguish between the designs themselves and the built structure. The intended audience for the built structure is likely to be the general public. But that is a wholly separate copyright from the copyright in the design drawings. And, as discussed earlier, design drawings do not infringe on built structure copyrights. The general public almost never sees the design drawings for a building, and few would argue that the general public (rather than contractors and other designers) are the intended audience for design drawings.

Thus, one should be able to convincingly argue that design drawings *are* intended for a specialized

audience of construction professionals. If the court accepts this argument, expert testimony should be admissible during the substantial similarity analysis.

THE ORDINARY OBSERVER TEST

The U.S. Courts of Appeals for the First,²⁷ Second,²⁸ Third,²⁹ Fifth,³⁰ Seventh,³¹ and Eleventh Circuits³² use what is commonly referred to as an “ordinary observer” test. A court summarized the “ordinary observer” test for substantial similarity as: “where an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.”³³

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Expert testimony is usually admissible if it will assist the trier of fact with deciding whether an infringement occurred. The expert must rely on copyrightable expressions when analyzing the substantial similarity of two works; if an expert relies on uncopyrightable ideas, the report and testimony are excludable.³⁴

It often comes as a surprise to architects and engineers (and lawyers) that juries may be asked to decide if a particular construction design infringes on another design without the aid of any testimony from experts. Nevertheless, such is the case in many states. The lawyer who is forewarned is also forearmed, and can structure her or his case to take advantage of the state of the law in the state in which the case is venued.

Notes

1. Courts commonly hold that copyright infringement can be proved either by direct evidence of copying or by demonstrating access and substantial similarity. *See, e.g., Nelson v. PRN Prod., Inc.*, 873 F.2d 1141, 1142 (8th Cir. 1989). However, no court has ever been called on to find infringement via direct copying when the resulting work is not substantially similar to the copyrighted work. Therefore, the best view of the law is that substantial similarity will be required even if liability is proved through

- direct copying. Indeed, the notion that a direct copy can be anything but substantially similar to the work from which it was copied is, at best, a philosophical abstraction.
2. See *Towler v. Sayles*, 76 F.3d 579 (4th Cir. 1996). The Fourth Circuit has a slight deviation where the second prong of this test, the intrinsic evaluation, is viewed from the perspective of the intended audience (the next test discussed in this chapter). This means that the perspective of the intended audience may sometimes be different from that of an ordinary observer. However, to date, this deviation has only been applied to children's music and computer programs to date.
 3. See *Rottlund Co. v. Pinnacle Corp.*, 452 F.3d 726 (8th Cir. 2006).
 4. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).
 5. See *Plan Pros, Inc. v. Zych*, No. 8:08CV125, 2009 U.S. Dist. LEXIS 124671, at *13 (D. Neb. Dec. 22, 2009) ("In evaluating the extrinsic step, expert testimony is often helpful to ascertain whether the works are objectively similar."); see also *Nelson Design Group, LLC v. Puckett*, No. 3:07CV00177 BSM, 2009 U.S. Dist. LEXIS 69343, at *4 (E.D. Ark. July 28, 2009) ("[S]imilarity of ideas is analyzed extrinsically, with the focus being on the objective similarities in the details. . . . Expert opinion and analytical dissection are admissible to prove similarity of ideas.").
 6. *Sid & Marty Krofft Television Prods., supra*, 562 F.2d at 1164.
 7. Cf. *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1398 (9th Cir. 1997) (stating that "analytic dissection" is allowed during the extrinsic test, but not during the intrinsic test); *Rottlund Co. v. Pinnacle Corp.*, No. 01-1980, 2004 U.S. Dist. LEXIS 16723, at *83 (D. Minn. Aug. 20, 2004) ("Substantial similarity is a legal test with two prongs—extrinsic and intrinsic—and the extrinsic prong is the only prong that accepts expert opinion evidence.").
 8. 452 F.3d 726 (8th Cir. 2006).
 9. *Id.* at 729.
 10. *Id.*
 11. *Id.* at 730.
 12. *Id.* at 729-30.
 13. *Id.* at 731.
 14. *Id.* at 731-32.
 15. See *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280 (10th Cir. 1996).
 16. The D.C. Circuit only applies this test if both unprotectable and protectable elements are at issue. If only protectable elements are being evaluated, the D.C. Circuit employs the ordinary observer test established by the Second Circuit. See *Recording Indus. Ass'n of Am., Inc. v. Verizon Internet Servs.*, 351 F.3d 1229 (D.C. Cir. 2003); *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1291 (D.C. Cir. 2002).
 17. *Kohus v. Mariol*, 328 F.3d 848, 855 (6th Cir. 2003); *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1295 (D.C. Cir. 2002).
 18. *Kohus*, 328 F.3d at 855 (quoting *Sturdza*, 281 F.3d at 1296).
 19. *Kohus*, 328 F.3d at 855; *Winfield Collection, Ltd. v. Gemmy Indus., Corp.*, 147 Fed. App'x 547, 554 (6th Cir. 2005) ("In performing the filtering process, the basic guidepost to keep in mind is that copyright only protects an author's original expression; thus, courts must exclude as unprotectable [sic] any elements of the work that are not original.").
 20. *Murray Hill Publ'ns, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 318 (6th Cir. 2004).
 21. *Frank Betz Assocs. v. Signature Homes*, No. 3:06-0911, 2010 U.S. Dist. LEXIS 31449, at *9, 11-13 (M.D. Tenn. Mar. 29, 2010) (discussing the admissibility of expert testimony regarding the originality of copyrighted works).
 22. *Kohus*, 328 F.3d at 856 (stating that the "ordinary reasonable person" standard of the second step in the substantial similarity analysis "is in need of modification").
 23. *Winfield Collection*, 147 Fed. App'x at 554 (holding that, because the parties agreed that the lay public was the intended audience, "expert testimony should not be required").
 24. *Kohus*, 328 F.3d at 857.
 25. *Id.*; *RGIS, LLC v. A.S.T., Inc.*, No. 2:07-CV-10975, 2008 U.S. Dist. LEXIS 4226, at **6-7 (E.D. Mich. Jan. 22, 2008) ("Kohus . . . made clear that when technical material is involved [the] 'ordinary observer' test for substantial similarity is insufficient. . . . Because the judicial officers involved in this case lack [computer programming] competence, it is necessary to have the assistance of a competent computer expert capable of factual analysis interpreting and comparing computer source codes.").
 26. At least one circuit court was willing to consider this argument. In *Sturdza v. United Arab Emirates*, 281 F.3d 1287 (D.C. Cir. 2002), the D.C. Circuit declined to rule on the issue of whether the parties in an architectural design copyright infringement case could present expert testimony during the substantial similarity stage of analysis. The court, however, remanded the case with an invitation for the parties to revisit the issue in a subsequent appeal "with the benefit of full briefing." *Id.* at 1301.
 27. See *T-Peg, Inc. v. Vt. Timber Works, Inc.*, 459 F.3d 97 (1st Cir. 2006); *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606 (1st Cir. 1988).
 28. See *Arnstein v. Porter*, 154 F.2d 464, 472-473 (2nd Cir. 1946). The Second Circuit has developed an additional analysis when the works involve both unprotectable and protectable elements. This variation asks whether, looking at the protectable elements, the overall look and feel of the compared works is substantially similar. See

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- Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127 (2nd Cir. 2003); *Boisson v. Banian, Ltd.*, 273 F.3d 262 (2nd Cir. 2001).
29. See *Ford Motor Co. v. Summit Motor Products, Inc.*, 930 F.2d 277 (3rd Cir. 1991); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904 (3rd Cir. 1975).
30. See *Peel & Co. v. The Rug Mkt.*, 238 F.3d 391 (5th Cir. 2001).
31. See *Selle v. Gibb*, 741 F.2d 896 (7th Cir. 1984); *Scott v. WKJG, Inc.*, 376 F.2d 467 (7th Cir. 1967); *Sanford v. CBS, Inc.*, 594 F.Supp. 713 (N.D. Ill. 1984).
32. See *Intervest Constr., Inc. v. Canterbury Estate Homes, Inc.*, 554 F.3d 914 (11th Cir. 2008); *Original Appalachian Artworks v. Toy Loft, Inc.*, 684 F.2d 821 (11th Cir. 1982).
33. *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 829 (11th Cir. 1982).
34. *Corwin v. Walt Disney World Co.*, 475 F.3d 1239, 1250-51 (11th Cir. 2007) (affirming the district court's exclusion of four expert reports because they focused on the concepts and ideas behind a building, rather than on the expressions of those concepts and ideas).

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