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I. INTRODUCTION

Decades ago, Judge Learned Hand wrote that "if by some magic a man who had never known it were to compose Keats' Ode On a Grecian Urn, he would be an 'author,' and, if he copyrighted it, others might not copy that poem, though they might, of course, copy Keats."[1] In doing so, Judge Hand clearly laid out a copyright truism that has held firm for almost 100 years—that an infringer cannot rely on "prior art" to challenge a creator's copyright or to defend against a copyright infringement claim.

Yet, as of late, the "prior art" defense, has been traditionally confined to patent law and crept into the copyright realm through cases like *Skidmore v. Led Zeppelin*.[2] Unfortunately, some courts now eschew the teachings of Judge Hand and the decades of accordant authority to undermine creator's rights by relying upon prior art as evidence that a creator's copyright is unenforceable.[3]

Widely known as a patent doctrine, "prior art" has no place in copyright law.[4] Unlike patents, which require novelty, courts have long held that "the originality necessary to support a copyright merely calls for independent creation, not novelty."[5] Indeed, for copyright protection to accrue, "the work offered for registration need not be new, but only original, i.e., the product of the registrant."[6] On the other hand, prior art has been a longstanding defense in patent infringement cases because patents require "novelty," while copyright only requires a "modicum of originality."[7]

The Second Circuit laid this out in *Alfred Bell*, which the Ninth Circuit later cited in *Krofft*:

"Originality in this context 'means little more than a prohibition of actual copying.' No matter how poor artistically the 'author's' addition, it is enough if it be his own."[8]

As novelty is not required, an infringer should not be able to invoke the "prior art" doctrine to attempt to diminish or otherwise disrupt the enforcement of an artist's copyright. As the Tenth Circuit has explained, any

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1. Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 54 (2d Cir.1936), cert. denied, 298 U.S. 669, 56 S.Ct. 835, 80 L.Ed. 1392 (1936) (remaining citation omitted); *see also* Premier Fabrics, Inc. v. Woodland Trading Inc., 42 F. Supp. 3d 549, 554 (S.D.N.Y. 2014)(same).

2. Skidmore v. Led Zeppelin, 952 F.3d 1051, 1064–1065 (9th Cir. 2020).

3. *See* Smith v. Weeknd, 2020 U.S. Dist. LEXIS 130549 at 20 (C.D.Cal. 2020); Copeland v. Bieber, 2016 U.S. Dist. LEXIS 178817 at 16 (E.D.Va. 2016).

4. DONALD CHISUM, 2 CHISUM ON PATENTS § 5.03 (2023).

5. Roth Greeting Cards v. United Card Co., 429 F.2d 1106, 1109 (9th Cir. 1970), citing Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102 (2d Cir. 1951), cf. Baker v. Selden, 101 U.S. 99, 102-103, 25 L.Ed. 841 (1879).

6. Sid & Marty Krofft Television v. McDonald's Corp., 562 F.2d at 1163, n. 5 (9th Cir.1977).

7. Feist Publ'ns, Inc., v. Rural Tel. Serv. Co., Inc., 499 US 340, 345-346 (1991).

8. Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp., 562 F.2d 1157, 1163 (9th Cir. 1977), overruled on other grounds by Skidmore as Tr. for Randy Craig Wolfe Tr. v. Led Zeppelin, 952 F.3d 1051 (9th Cir. 2020), quoting Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 102-03 (2 Cir. 1951).

"copyrightable work can be sliced into elements unworthy of copyright protection."[9] For example, "[b]ooks could be reduced to a collection of non-copyrightable words. Music could be distilled into a series of non-copyrightable rhythmic tones. A painting could be viewed as a composition of unprotectable colors."[10] As every word, note, and color exists in the prior art, allowing infringers to argue as much would defeat the copyright's purpose, which is to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[11]

Accordingly, "the common practice of defendants at trial in pointing out a similar work created in antiquity, or at least prior to the defendant's creation is of no assistance unless the trier of fact believes that the defendant copied from such work."[12] Yet, some recent cases allow infringers to point out similar works in antiquity to avoid infringement liability.[13] This recent "trend" in crediting the prior-art defense poses numerous discrete problems, which we lay out below.

In addition to the fact that prior art has no place in copyright law legally other than possibly to establish that a particular element is a *scenes a faire*, significant practical implications may also arise when we apply the prior art doctrine to copyright cases.[14] Unlike patent plaintiffs, who can rely on the United States Patent and Trademark Office ("USPTO") and accessible databases to establish prior art, copyright plaintiffs would face the near-impossible task of combing through the vast sea of literature and music throughout history to ascertain whether their work was protectable.[15] This places an unreasonable burden and an untenable onus on copyright holders, making it virtually impossible to determine copyright protection. Normalizing prior art defenses in copyright infringement cases would allow the largest corporations with the largest databases to win every copyright battle.

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9. Enter. Mgmt. Ltd., Inc. v. Warrick, 717 F.3d 1112, 1119 (10th Cir. 2013) (citation omitted).

10. *Id.*

11. *USCS Const.* Art. I, § 8, Cl 8; N. Coast Indus. v. Jason Maxwell, Inc., 972 F.2d 1033 (finding that an individual's original work may garner copyright protection although not representing something "entirely new under the sun").

12. Novelty Textile Mills v. Joan Fabrics Corp., 558 F.2d 1090, 1093 n. 3 (2d Cir.1977) (quoting MELVILLE B. NIMMER, 1 NIMMER ON COPYRIGHT § 101.6 at 381–382 (1976)).

13. *See* Smith v. Weeknd, 2020 U.S. Dist. LEXIS 130549, at 20 (C.D.Cal. 2020); Copeland v. Bieber, 2016 U.S. Dist. LEXIS 178817, at 16 (E.D.Va. 2016).

14. Taylor Barlow, *Tons a Faire: Strengthening the Scenes a Faire Doctrine for Music Copyright Cases*, 20 VA. SPORTS & ENT. L.J. 106, 119 (2021).

15. *See* Joseph P. Fishman & Kristelia Garcia, *Authoring Prior Art*, 75 VAND. L. REV. 1159, 1200-02 (2022) (discussing the ways individuals put together their knowledge and resources to create their own databases) *Compare* Google Patents, GOOGLE PATENTS, https://patents.google.com/ [https://perma.cc/EK3F-8U27] (last visited June 26, 2023); Espacenet, EUROPEAN PATENT OFFICE, https://worldwide.espacenet.com/ [https://perma.cc/G43G-X3Q9] (last visited June 26, 2023); DEPATISnet, GERMAN PATENT AND TRADEMARK OFFICE, https://depatisnet.dpma.de/DepatisNet/depatisnet [https://perma.cc/4GGZ-EVQN] (last visited June 26, 2023).

Additionally, introducing prior art as a defense in copyright law may undermine the very purpose of copyright protection.[16] Almost all creative works share commonalities with prior works to some extent, even if they ultimately possess originality. Granting defendants the ability to invoke prior art as a defense would provide an improper tool to evade liability. Plaintiffs must already prove creation, ownership, access, and copying, and potentially refute a host of defenses including fair use and independent creation, to name a few.[17] Prevailing on copyright claims are already exceedingly difficult. Adding prior art as a defense would further stack the deck against plaintiffs, jeopardizing the incentives for creators to produce original works and receive due recognition and compensation for their creativity.[18]

We must also consider the historical context. Throughout history, Courts have rejected prior art defenses in copyright cases.[19] This historical absence suggests that copyright and patent law have fundamental differences that warrant separate treatment. In addition, the *scenes à faire* doctrine already exists and can be applied in cases of copyright infringement, which does take into consideration prior art deemed "indispensable" to the genre to establish a particular element is not separately protectable under copyright law.[20] Crucially, though, the *scenes à faire* doctrine does not have the same broad scope and potential impact as the prior art defense.[21]

As set forth below, incorporating the prior-art doctrine into copyright law would undermine the essence of copyright protection, weaken copyright safeguards, and diminish the incentives for creators to produce original works.[22] It would also impose an unreasonable and untenable burden on copyright holders, grant unfair advantages to defendants, and disregard the historical and practical distinctions between copyright and patent law.

II. UNDERSTANDING PRIOR ART IN PATENT AND COPYRIGHT LAW

In the realm of patent law, the concept of prior art takes center stage.[23] Patents confer "the right to exclude others from making, using, offering for sale, or selling" the invention in the United States or "importing" the invention into the United States.[24] Notably, a patent includes the right to exclude

16. USCS CONST. art. I, § 8, cl 8.

17. MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §13D (2024).

18. *See* Robert F. Helfing, *"Substantial Similarity in Literary Infringement Cases: A Chart for Turbid Waters,"* 21 UCLA ENT. L. REV., Issue 1 (2014).

19. *See e.g.* Arnstein v. Porter, 154 F.2d 464, 475 (2d Cir. 1946).

20. Swirsky v. Carey, 376 F.3d 841, 849–850 (9th Cir. 2004).

21. *See* Gable v. NBC, 727 F.Supp.2d 815, 837 (C.D.Cal. 2010) (distinguishing how scenes a faire is applied when considering whether an element of a story "derives from a basic plot idea" while prior art refers to whether that element has ever been used in a work before).

22. USCS CONST. art. I, § 8, cl 8.

23. CHISUM, *supra* note 4, § 5.03.

24. 35 U.S.C. § 271.

others, rather than the right to make or use the invention itself.[25] There is a clear distinction between copyrights and patents due, in part, to patents providing a more extensive monopoly than copyrights, and the relatedly higher bar of novelty that patent applicants must meet to receive patent protection.[26]

When it comes to patent applications, one of the most common grounds for rejecting claims for inventions is the existence of prior art.[27] Prior art encompasses all previously disclosed information, documentation, and references.[28] This includes a wide array of materials such as printed documents, admissions made by the applicant regarding certain aspects of the invention being prior art, and items that have been offered for sale.[29] Prior art plays a crucial role in assessing the novelty and non-obviousness of a new patent compared to what has come before.[30] Given that patents must be both novel and non-obvious, prior art serves as a vital tool in determining patentability.[31]

In contrast to copyrights, accessing prior art in the patent field is relatively straightforward.[32] The U.S. Patent Office provides a search tool on its website, facilitating the location of relevant prior art—a convenience that the Copyright Office lacks entirely.[33] Moreover, the body of prior art in the field of patents only extends as far as the prior art actually cataloged in the United States.[34] This composes a far more discreet database than the entire body of expressive works since the dawn of time; for example, in *Johannsongs-Publishing, Ltd., v Lovland*, the defense's expert persuaded the District Court and ultimately the 9th Circuit that the existence of old Irish folk songs were sufficient to defeat a copyright claim.[35] Not only were the prior works not contained in any searchable database, but they were not even an American folk song.[36] Patents primarily pertain to inventions, while copyright

25. NIMMER & NIMMER, *supra* note 17, §2.01.

26. Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 103 (2d Cir. 1951).

27. J.D. Houvener, *What are the Most Common Patent Rejections*, BOLD PATENTS: BLOG (October 30, 2023), https://perma.cc/GZ4E-GZZG.

28. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 104 n.17 (2d Cir. 1951).

29. Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 CARDOZO ARTS & ENT. L.J. 81, 89 (1998); *Feist Publ'ns, Inc., v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340 (1991).

30. J.D. Houvener, *What are the Most Common Patent Rejections*, BOLD PATENTS: BLOG (October 30, 2023), https://boldip.com/what-are-the-most-common-patent-rejections/ [https://perma.cc/GZ4E-GZZG].

31. 35 U.S.C. § 101.

32. *See* Fishman & Garcia, *supra* note 15 (discussing the ways individuals put together their knowledge and resources to create their own databases); *Compare* Google Patents, GOOGLE PATENTS, https://patents.google.com/ [https://perma.cc/EK3F-8U27] (last visited June 26, 2023); Espacenet, EUROPEAN PATENT OFFICE, https://worldwide.espacenet.com/ [https://perma.cc/G43G-X3Q9] (last visited June 26, 2023); DEPATISnet, GERMAN PATENT AND TRADEMARK OFFICE, https://depatisnet.dpma.de/DepatisNet/depatisnet [https://perma.cc/4GGZ-EVQN] (last visited June 26, 2023).

33. U.S. CONST. art. I, § 8.

34. *Id.*

35. Johannsongs-Publishing, Ltd. v. Lovland, No. 20-55552, 2020 U.S. Dist. LEXIS 82464, at *10, and *20 (9th Cir. Nov. 16, 2021).

36. *Id.*

protection extends to a broad range of creative works spanning millennia.[37] Humans have been crafting art, music, stories, plays, poems, and folklore for thousands of years, making the sheer breadth and depth of prior art an insurmountable challenge to process within the realm of copyright. Finally, copyright protection arises at the moment of fixation;[38] thus, it is axiomatic that millions of untold works protectable by copyright have not even been registered.

Congress codified the concept of prior art in patent law under 35 U.S.C. § 103, following the landmark decision in *Graham v. John Deere Co*., which introduced the non-obviousness doctrine.[39] This section of the Patent Act of 1952 outlines that a patent's subject matter is considered obvious if, at the time of the invention, it would have been apparent to a person with ordinary skill in the relevant field.[40] The *Graham* decision established a framework for assessing non-obviousness, which includes evaluating prior art, differentiating it from the claims, determining the level of ordinary skill in the field, considering secondary factors of non-obviousness, and ultimately determining patentability based on these factors.[41]

Several noteworthy cases further shed light on the significance of prior art in patent law.[42] For instance, in *KSR v. Teleflex Inc*., the U.S. Supreme Court examined a patent claim involving pedal systems.[43] The Court concluded that the claim was obvious based on the prior art, finding little difference between the prior art and the claimed invention, which a person with ordinary skill in the field could have devised.[44] The Court emphasized that it may find a claim obvious if it involves a predictable combination of elements from the prior art.[45]

In essence, the concept of prior art plays a critical role in patent law, serving as a yardstick for assessing novelty and non-obviousness.[46] Its presence ensures that the U.S.P.T.O. only grants patents for truly inventive and groundbreaking contributions while also preventing the appropriation of existing knowledge.[47] By contrast, the vast and diverse nature of creative works protected by copyright poses unique challenges in applying the concept of prior art.[48] Thus, we must maintain a clear distinction between patent

37. Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 NW. U.L. REV. 1441, 1441 (2010).
38. 17 U.S.C. § 102.
39. 35 U.S.C. § 103; Graham v. John Deere Co., 383 U.S. 1 (1966).
40. NIMMER & NIMMER, *supra* note 17, §2.01.
41. JBJ Fabrics, Inc. v. Mark Industries, Inc., No. CV 86-4881, 1987 WL 47381, at *1 (C.D. Cal., Nov. 5, 1987).
42. *See e.g.* KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007).
43. *Id.*
44. *Id*. at 427.
45. *Id*. at 418.
46. CHISUM, *supra* note 4, § 5.03.
47. *Id.*
48. Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 NW. U.L. REV. 1441, 1441–1442 (2010).

and copyright law to preserve the integrity and purpose of each respective field.

Unlike novelty in patent law, in copyright law, all that is required is a "modicum of originality."[49] In copyright, courts find a work original if the author independently created it without copying from prior works.[50] However, unlike patent law's novelty standard, copyright law focuses on independent creation rather than innovation.[51] In an infringement case, the copyright judge must determine if the claiming author imbued their work with a "modicum of creativity" through independent creation and whether the alleged infringer copied that work without independent creation.[52]

To further understand the divergent paths of patent and copyright law, one must appreciate the underlying legislative goals and standards in infringement actions. Patent law serves to incentivize innovation, offering exclusivity in exchange for public disclosure of the invention.[53] In contrast, copyright law strives to "promote the progress of science and useful arts" by safeguarding authors' rights to their creations.[54] Considering prior art in copyright actions would erode the very protections guaranteed by the Constitution and hinder authors from enjoying their constitutionally provided rights.

Throughout the annals of copyright law, the concept of prior art has been largely irrelevant, save for the scenes-a-faire doctrine (discussed in more detail below).[55] Unlike patent law, which relies on prior art to determine novelty, copyright law recognizes that multiple authors may hold valid copyrights in independent works.[56] Each author's creation, regardless of novelty, is protected if it exhibits originality—a hallmark of copyright protection.[57] Embracing prior art analysis beyond the limited scope of scenes-a-faire not only defies efficiency but also sets a perilous precedent that threatens to deprive authors of the very essence of protection, particularly in the realm of music.

The historical context underscores why prior art has no place in copyright law. Prior art, with its far-reaching implications, extends to all creative works, registered with the copyright office or not, throughout the entirety of human history.[58] By design, copyright law aims to protect the individual author's expression, irrespective of novelty, providing a robust shield against unauthorized copying.[59] Introducing a prior art analysis into the equation

49. *Feist*, 499 U.S. 340.
50. NIMMER & NIMMER, *supra* note 17, §2.01.
51. *Id.*
52. *Feist*, 499 U.S. 340, at 346.
53. Aronson v. Quick Point Pencil Co., 440 U.S. 257, 262–263 (1979).
54. U.S. CONST. art. 1, § 8.
55. Fishman & Garcia, *supra* note 15, at 1160-61.
56. *Feist*, 499 U.S. 340, at 351.
57. NIMMER & NIMMER, *supra* note 17, §2.01.
58. *JBJ Fabrics, Inc. v. Mark Indus., Inc.*, No. CV 86-4881, 1987 WL 47381, at *1.
59. *Id*. at 3-4.

would not only be impractical but also undermine the core principles that underpin copyright law's constitutional mandate. As we delve into the intricate tapestry of copyright and prior art, we must tread carefully to preserve the delicate balance between protecting authors' rights and fostering the progress of creative endeavors.

III. WHY PRIOR ART HAS NO PLACE IN COPYRIGHT LAW

History Instructs Us Why Prior Art and Copyright are Incompatible

Prior Art's Absence Throughout Copyright Law's History

Creative works have long been built upon existing ideas and concepts.[60] This iterative process has led to the development of various artistic movements and cultural expressions. The absence of copyright protection for prior art in historical legal systems serves as a testament to prior art's limited compatibility with the nature and purpose of copyright law.[61] During the Renaissance period, numerous masterpieces emerged as artists drew inspiration from classical Greek and Roman works.[62] Indeed, prior art protection did not hinder artists such as Sandro Botticelli from creating masterpieces like "The Birth of Venus"[63] because artists through history have freely incorporatde and reinterpreted pre-existing ideas..[64]

Throughout copyright law's evolution, the concept of prior art has remained conspicuously absent, save for its limited relevance to the *scenes a faire* doctrine.[65] Copyright law has always staunchly advocated for nurturing creativity and unrestricted expression, setting it apart from the world of innovation governed by patent law.[66] As explained by the U.S. Copyright Office, copyright primarily serves to safeguard original works of authorship, granting creators exclusive rights to reproduce, distribute, and display their artistic endeavors.[67] As discussed above, it does not concern itself with assessing the novelty or inventiveness of ideas, a realm more fitting for patent law.[68] Incorporating considerations of innovativeness into copyright

60. Terry Hart, *Supporting Invention and Inspiration: License to Remix*, 23 GEO. MASON L. REV. 837, 885 (2016) ("the vast majority of works both build upon, yet do not infringe upon existing works").

61. U.S. CONST. art. 1, § 8.

62. *See generally* Lee Down, *The Influence of Ancient Greek Art on Renaissance Art*, ARTS, ARTISTS, ARTWORK (May 20, 2023), https://artsartistsartwork.com/the-influence-of-ancient-greek-art-on-renaissance-art/ [https://perma.cc/WKB2-82LA].

63. *Id.*

64. *Id.*

65. Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 NW. U.L. REV. 1441, 1441 (2010).

66. Jessica Litman, *The Public Domain*, 39 EMORY L.J 965, 990 (1990).

67. U.S. Copyright Office, COPYRIGHT BASICS 3 (2021), https://www.copyright.gov/circs/circ01.pdf [https://perma.cc/ZF98-GMJZ].

68. Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 NW. U.L. REV. 1441 (2010).

analysis would fundamentally alter its nature and introduce a patentability framework that deviates from its core principles.[69]

Legal precedents illustrate the historical exclusion of prior art analysis in copyright disputes. Landmark cases such as *Arnstein v. Porter and Sheldon v. Metro-Goldwyn Pictures Corp.* consistently rejected the application of prior art analysis to copyright claims.[70] For example, in *Arnstein*, the court emphasized that a musical composition can still be considered original even if it is not entirely new.[71] *Sheldon* distinguished copyright law from patent law, clarifying that while prior art can invalidate a patent, copyright protection can be granted for adaptations or reworkings of works in the public domain.[72]

In the 1988 case of *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.,* the defendant attempted to invalidate the plaintiff's copyright protection by submitting catalogs of other concrete mold manufacturers that resembled the plaintiff's design.[73] The defendant argued that the existence of similar molds in the market demonstrated the lack of originality in plaintiff's work, thereby invalidating the copyright protection.[74] However, the U.S. First Circuit Court of Appeals held that this prior art evidence of similar molds was "wholly irrelevant to the claim or the defense as it was presented."[75] The court relied on the holding in *Novelty Textile Mills v. Joan Fabrics Corp*., which held that pointing out a similar work created in antiquity or prior to the defendant's creation is of no assistance unless the jury believes that the defendant copied such public domain works.[76] By excluding the prior art evidence from consideration, the Concrete Mach. Co. court upheld the traditional understanding of copyright law, which emphasized the protection of originality and expression rather than considering the existence of prior similar works.[77] This case serves as an important historical precedent that supports the exclusion of prior art as a defense in copyright infringement cases.[78] It underscores the idea that copyright is primarily concerned with the protection of original works and does not require novelty or inventiveness as criteria for copyright protection (in stark contrast to patent requirements).[79]

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69. NIMMER & NIMMER, *supra* note 17, §2.01.

70. Arnstein v. Porter, 154 F.2d 464, 468 (2d Cir. 1946); Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 54 (2d Cir. 1936).

71. *Arnstein*, 154 F.2d 464, 468.

72. *Sheldon*, 81 F.2d 49, 54.

73. *See generally* Concrete Mach. Co. v. Classic Lawn Ornaments, Inc., 843 F.2d 600 (1st Cir. 1988).

74. *Id.*

75. *Id*. at 610.

76. *Id.* (citing Novelty Textile Mills v. Joan Fabrics Corp., 558 F.2d 1093 (2nd Cir. 1977)).

77. *See generally* Concrete Mach. Co. v. Classic Lawn Ornaments, Inc., 843 F.2d 600 (1st Cir. 1988).

78. *Id.*

79. *Id.*

Instead, the focus remains on determining whether there has been unauthorized copying.

In recent years, a series of noteworthy music copyright infringement cases have reinforced the longstanding tradition of excluding prior art from the copyright analysis.[80] These cases have garnered substantial support from legal commentators and scholars who staunchly advocate for upholding the fundamental principles of copyright law and vehemently oppose any attempt to introduce prior art analysis into copyright disputes.[81]

In *Swirsky v. Carey*, the court resolutely adhered to the prevailing understanding of copyright law, affirming the importance of protecting creative expression over scrutinizing the presence of prior art.[82] This ruling emphasized copyright law's design for fostering artistic creation and safeguarding the rights of creators, rather than becoming entangled in intricate debates about prior artistic works.[83] Similarly, in *Bolton v. Three Boys Music Corp.*, the court steadfastly maintained the traditional approach to copyright analysis, dismissing any consideration of prior art in determining copyright infringement.[84] The court underscored that the focus should remain on evaluating the originality and creative merit of the works at issue, rather than delving into the vast landscape of prior art.[85] Likewise, *Baxter v. MCA* served as a resounding affirmation of the prevailing understanding of copyright law.[86] The court in *Baxter* firmly rejected the notion of engaging in prior art analysis, emphasizing that copyright protection should be primarily concerned with nurturing and safeguarding the expressive endeavors of creators.[87]

The Emerging, Improper Prior Art Defense in Music Infringement Cases

In the past decade, and even more so in the last five years, a very concerning development has taken place in music copyright disputes. Some courts have begun to embrace the applicability of prior art as a defense to infringement claims.[88] This shift toward prior art analysis in copyright cases

80. *See e.g.* Swirsky v. Carey, 376 F.3d 841 (9th Cir. 2004); Three Boys Music Corp. v. Bolton, 212 F.3d 477 (9th Cir. 2000); and Baxter v. MCA, Inc., 812 F.2d 421 (9th Cir. 1990).

81. *See e.g.* Kristen H. Strickland, *"It's Still Rock and Roll" - But Are its Chord Progressions Copyrightable and Subject to an Infringement Claim or Are they Unprotected Scenes a Faire?*, 45 AM. J. TRIAL ADVOC. 157, 159–161 (2021) (citing Swirsky v. Carey, 376 F.3d 841 (9th Cir. 2004); and Three Boys Music Corp. v. Bolton, 212 F.3d 477 (9th Cir. 2000)).

82. *Swirsky*, 376 F.3d at 846.

83. *Id.*

84. *Bolton*, 212 F.3d at 482.

85. *Id*.

86. *Baxter*, 812 F.2d at 423–424.

87. *Id.* at 425.

88. *See generally* Skidmore v. Led Zeppelin, 952 F.3d 1051 (9th Cir. 2020); Johannsongs-Publishing, Ltd., v Lovland, U.S. App. LEXIS 35135 (9th Cir. 2021) (the court ruled that any similarities found between the two songs at issue were found in prior art and public domain songs, and therefore insufficient to satisfy the Ninth Circuit extrinsic test).

has been catalyzed by the growing presence of musicologists as expert witnesses.[89] The *Skidmore v. Led Zeppelin* decision helped trigger this shift.[90] The case involved misleading jury instructions that erroneously stated that "any elements from prior works or the public domain are not considered original parts and not protected by copyright."[91] This instruction diverged from well-established copyright principles elucidated in the above discussion.[92] As clarified in *Feist*, even unprotectable elements can still be eligible for copyright protection if their selection and arrangement exhibit the requisite creativity and originality.[93] Consequently, it is fairly well-established in this day and age that copyright protection may extend to elements that, individually, lack protection or have been previously expressed.[94]

Implicating prior art in substantial similarity decisions concerning musical works is untenable. Taken to its logical extreme, no song would enjoy copyright protection because the notes comprising said songs are all "prior art" and thus excluded from protection.

Moreover, the breadth of prior art virtually ensures that any infringer can locate similar works in the dusty archives of long ago. Human beings have created art and music since time immemorial, rendering comprehensive prior art searches fundamentally impracticable. Besides the inherent inefficiency of such an undertaking, considering the vast number of songs in existence (there is simply no way to sift through every single song in the country, let alone in the world from the dawn of time), the adoption of prior art analysis runs counter to the objectives outlined in the Constitution and contemporary copyright legislation.[95] *Williams v. Gaye* underscores the peculiar nature of popular music, wherein numerous compositions exhibit varying degrees of similarity to prior songs.[96] In acknowledging this reality, the court affirmed that artists operating in the realm of popular music frequently draw inspiration from existing works.[97] For example, the *Williams* dissent agreed with the majority that "in the field of popular songs, many, if not most, compositions bear some similarity to prior songs."[98] Artists can create because of the freedom to build upon others' ideas.[99] However, this freedom to build on existing works should not be confused with misappropriation. While

89. Fishman & Garcia, *supra* note 15, at 1198.

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

91. *Id.* at 1071.

92. Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 348 (1991).

93. *Id*.

94. *Id*.; Hanagami v. Epic Games, Inc., 85 F.4th 931, 940 (9th Cir. 2023) ("individual dance elements 'are not copyrightable. . .' they are the 'building blocks of choreographic expression' from which all choreographic works are build")(citing Copendium §805.5).

95. U.S. CONST. art. 1, § 8, cl. 8 (Copyright protections aim to "promote the progress of science and useful arts" by assuring authors that their work will be protected); *See also* 17 U.S.C. § 102(a) (2021).

96. Williams v. Gaye, 895 F.3d 1106, 1140 (9th Cir. 2018) (quoting NIMMER ON COPYRIGHT § 2.05[B] (rev. ed. 2017)).

97. *Id*. at 1111.

98. *Id.* at 1140.

99. *Id.*

artists must refrain from directly copying expression, the freedom to build upon preexisting ideas remains integral to the creative process.[100] This principle stems from the well-established idea/expression dichotomy, which enables artists to draw inspiration from prior works while avoiding misappropriation.[101] Thus, with "nothing new under the sun," artists must still have the freedom to draw inspiration from the existing ideas found in other works without prior art invalidating their constitutionally provided copyright protection.[102] The "selection and arrangement" test guarantees this result.[103] That test for copyright infringement recognizes that no one element is truly new or unique and an author can gain copyright protection from selecting and arranging expressive elements in an original way.[104]

Proponents of applying prior art search results in music copyright disputes argue that it protects against undeserving legal exclusivity for works that are not sufficiently innovative.[105] But how do courts determine what is and what is not sufficiently innovative when in fact originality constitutes the standard for valid copyright protection? A study conducted by Professors Joseph Fishman and Kristelia Garcia sheds further light on the prevailing trend of incorporating prior art analysis in music copyright disputes.[106] The study reveals that judges have increasingly relied on expert witnesses, particularly musicologists, who have become indispensable in music copyright infringement suits.[107] For instance, in recent years, the courts have determined that musicologists were necessary for the court to be able to properly evaluate claims of musical infringement, as "it is unrealistic to expect district courts to possess even a baseline fluency in musicology."[108] Notably, these musicologists have their education in music, not law.[109] Moreover, courts should not accept legislative interpretation from experts with merely a "working knowledge of copyright law"[110] While experts may have an encyclopedia of knowledge of musical history, the plaintiff is unlikely to have that same knowledge and is likely not even aware of the existence of the prior art identified by the expert. This reliance on musicologists to define the scope of copyright protection runs the risk of leading to outcomes that

100. *Id.*

101. *See generally* Mazer v. Stein, 347 U.S. 201, 217 (1954).

102. *N. Coast Indus.* 972 F.2d 1033 at 1033.

103. Alfred v. Walt Disney Co., 821 Fed. Appx. 727 (9th Cir. 2020); Hanagami v. Epic Games, Inc., 85 F.4th 931, 942 (9th Cir. 2023).

104. *Id*. at 729.

105. *See* Taylor Barlow, *Tons a Faire: Strengthening the Scenes a Faire Doctrine for Music Copyright Cases*, 20 VA. SPORTS & ENT. L.J. 106, 119 (2021).

106. Fishman & Garcia, *supra* note 15, at 1198.

107. *Id.* at 1163–1164; *Swirksy,* 375 F.3d at 845.

108. Williams v. Gaye, 895 F.3d 1106, 1137 (9th Cir. 2018).

109. Vand. L. Sch., WHEN PRIOR ART APPLIES TO COPYRIGHT LAW, https://law.vanderbilt.edu/news/when-prior-art-applies-to-copyright-law/ [https://perma.cc/3K2S-T3WR] (last visited July 19, 2023) (noting that expert's "work with lawyers affords them a working knowledge of copyright law").

110. *Id*.

grossly deviate from the fundamental principles and well-established historical precedents of copyright law.

Novelty v. Originality

As discussed, the threshold for originality in copyright law is remarkably modest compared to the standard of novelty required for patent protection.[111] A work qualifies for copyright protection as long as it exhibits even a slight amount of creative spark, irrespective of its crude, humble, or obvious nature.[112] "Anyone can copyright anything, if he adds something original to its expression."[113] This means that as long as an author contributes something more than a merely trivial variation, recognizably their own, the work qualifies for copyright protection. In the case of *Weissmann v. Freeman*, the court recognized that copyright protection does not demand a high level of creativity.[114] Similarly, in *Gaste v. Kaiserman*, the court emphasized that originality in copyright law does not necessitate novelty, allowing a work to be considered original even if it closely resembles other works, as long as the resemblance is coincidental rather than a result of copying.[115] Additionally, *Kamar Int'l, Inc. v. Russ Berrie & Co.* held that the work offered for copyright registration need not be new, but only original, which means that it must be the product of the registrant.[116] "Original" in reference to a copyright work, according to this court, signifies that the particular work owes its origin to the author.[117] This definition emphasizes that copyright does not require a large measure of novelty.[118]

Unlike in patent law where elements of the public domain, such as prior art, may invalidate a patentee's application for patent due to lack of novelty, the presence of elements from the public domain does not preclude a finding of originality for the purpose of obtaining valid copyright protection.[119] In the case of *L. Batlin & Son, Inc. v. Snyder*, the court made it clear that using elements from the public domain does not automatically undermine the originality of a work.[120] For instance, the fact that copyright plaintiff's stuffed toy chimp is based on a live model does not diminish its originality.[121] The courts have recognized that using real-life inspiration does not strip a work

111. Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 NW. U.L. REV. 1441, 1453 (2010).

112. Feist Publ'ns, Inc., v. Rural Tel. Serv. Co., Inc., 499 US 345 (1991).

113. *See* Kamar Int'l, Inc. v. Russ Berrie & Co., 657 F.2d 1059, 1061 (9th Cir. 1981).

114. Weissmann v. Freeman, 868 F.2d 1313, 1321 (2d Cir. 1989).

115. Gaste v. Kaiserman, 863 F.2d 1061, 1066 (2d Cir. 1988).

116. Kamar Int'l, Inc. v. Russ Berrie & Co., 657 F.2d 1059, 1061.

117. *Id.*

118. *See* Sid & Marty Krofft Television v. McDonald's Corp., 562 F.2d 1157, 1163 n.5 (9th Cir. 1977); Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 102–03 (2d Cir. 1951).

119. Fishman & Garcia, *supra* note 15, at 1160-61 (2022).

120. *See* L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 490 (2d Cir. 1976) (en banc), cert. denied, 429 U.S. 857, 97 S. Ct. 156, 50 L. Ed. 2d 135 (1976) (the use of matters in the public domain does not preclude a finding of originality).

121. Kamar Int'l, Inc. v. Russ Berrie & Co., 657 F.2d 1059, 1061 (9th Cir. 1981).

of the necessary amount of originality.[122] Yet, in patent law, the scope of what an invention may draw from the real world is limited, as the requirement for novelty is much higher and necessitates a thorough analysis of prior art to demonstrate that the invention does not already exist or has not existed in a non-obvious manner.[123] The court in *JBJ Fabrics, Inc. v. Mark Industries, Inc.* emphasized the inapplicability of prior art scrutiny in copyright.[124]

Unlike patents, copyrights do not provide exclusive rights to the underlying ideas themselves, but rather protect the specific expression of those ideas.[125] This distinction was highlighted in *Baker v. Selden,* where a copyrighted book on a particular bookkeeping system was not deemed to be infringed upon by a similar book that used a similar plan and achieved similar results but employed different arrangements and headings.[126] Similarly, in *Fred Fisher, Inc. v. Dillingham*, two individuals independently created identical maps of the same territory, yet each was able to claim the exclusive right to make copies of their respective map without infringing upon the other's copyright.[127] This principle extends to directories as well, where a copyrighted directory is not infringed upon by a similar directory created independently.[128]

The differences in standards between patent and copyright law reflect their distinct legislative goals and infringement standards.[129] The U.S. Constitution, in Article 1, Section 8, underscores the importance of copyright protection in advancing the progress of creative endeavors.[130] Scrutinizing prior art in copyright actions would severely limit the opportunities for copyright authors to enjoy the constitutional protections provided to them. We must maintain a delicate balance between innovation incentives and the preservation of authors' rights to ensure the continued progress of creative endeavors.

Copyright Law Already has the *Scenes a Faire* Doctrine

Prior art is also unnecessary because copyright law already incorporates the *scenes a faire* doctrine.[131] This doctrine, recognizing the idea/expression

122. Rushton v. Vitale, 218 F.2d 434, 436 (2d Cir. 1955); *see also*, Dollcraft Indus., Ltd. v. Well-Made Toy Mfg., 479 F. Supp. 1105 (E.D.N.Y.1978) (stuffed toy lambs and bunnies); R. Dakin & Co. v. A & L Novelty Co., Inc., 444 F. Supp. 1080, 1084 (E.D.N.Y. 1978) (stuffed toy fish, frogs, and monkeys).

123. 35 U.S.C.S. § 103.

124. JBJ Fabrics, Inc. v. Mark Indus., Inc., No. CV 86-4881, 1987 WL 47381, at *1 (C.D. Cal., Nov. 5, 1987).

125. NIMMER & NIMMER, *supra* note 17, §2.02.

126. Baker v. Selden, 101 U.S. 99, 104–107 (1879).

127. Fred Fisher, Inc. v. Dillingham, 298 F. 145, 151 (S.D.N.Y. 1924).

128. Mazer v. Stein, 347 U.S. 201, 218 (1954).

129. *See* NIMMER & NIMMER, *supra* note 17, §1.03, §13D.08; Fishman & Garcia, *supra* note 15, at 1160-61.

130. U.S. CONST. art. I, § 8.

131. Taylor Barlow, *Tons a Faire: Strengthening the Scenes a Faire Doctrine for Music Copyright Cases*, 20 VA. SPORTS & ENT. L.J. 106, 113–114 (2021)

dichotomy discussed above, establishes that basic stock scenes or elements that naturally arise from common ideas are not protectable.[132] It intends to limit copyright protection for elements inherent to a particular genre, idea, or concept, preventing their monopolization.[133]

Imagine a world where certain elements naturally emanate from specific genres, ideas, or concepts—a shared language of creative expression. These elements, known as stock scenes or *scenes a faire*, serve as familiar building blocks for artists, much like recurring motifs in a symphony or recurring themes in a novel.[134] These stock scenes, standing alone, fall outside the realm of protectable elements in copyright law, thereby providing both a defense against and an exception to a plaintiff's copyright protection.[135] The *scenes a faire* doctrine, on the surface, embodies a presumption of reasonableness.[136] Judge Learned Hand, a prominent figure in copyright law, aptly stated, "the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly."[137]

The pivotal case of *Ets-Hokin v. Skyy Spirits, Inc.*, creates a striking illustration of the scenes a faire doctrine in action.[138] In that case, the Ninth Circuit embarked upon a captivating journey into the realm of vodka advertisements, invoking the scenes a faire doctrine to limit the scope of copyright protection for a promotional picture of a vodka bottle.[139] The court recognized the existence of a narrow range of artistic expression within the domain of commercial product shots.[140] The court determined that the advertisement contained copyrightable artistic choices, awarding copyright to the photographer and that the bottle itself was a useful article and not copyrightable.[141]

Another enlightening encounter with the scenes a faire doctrine unfolded in the realm of workplace training diagrams, in the case of *Evergreen Safety Council v. RSA Network, Inc*.[142] The court ventured into the treacherous terrain of dangerous driving scenarios, skillfully applying the *scenes a faire* doctrine.[143] The court's wisdom acknowledged the limited number of simple ways to depict these fundamental scenarios.[144] The resulting simplicity of the diagrams rendered them unprotectable, allowing others to freely traverse this well-trodden path of expression.[145] Moreover, the scenes a faire

132. See v. Durang, 711 F.2d 141, 143 (9th Cir. 1983); NIMMER & NIMMER, *supra* note 17, §13.03.
133. NIMMER & NIMMER, *supra* note 17, §13.03.
134. *See* Barlow, *supra* note 131.
135. *See,* 711 F.2d at 143.
136. *See* Barlow, *supra* note 131.
137. Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2nd Cir. 1930).
138. Ets-Hokin v. Skyy Spirits, Inc., 323 F.3d 763 (9th Cir. 2003).
139. *Id.* at 764.
140. *Id*.
141. *Id*.
142. Evergreen Safety Council v. RSA Network, Inc., 697 F.3d 1221,1228–29 (9th Cir. 2012).
143. *Id*.
144. *Id*. at 1229.
145. *Id*.

doctrine serves as a practical recognition that certain elements or expressions are so commonly employed or essential to a particular theme or idea that they should not be subjected to copyright monopolies.[146] It acknowledges that these elements, standing alone, form a shared pool of ideas and expressions available to all creators within a given genre or context.[147]

An important issue concerning this exception to copyright protection is how courts determine what constitutes *scenes a faire* material. Ample evidence exists to suggest that courts remain reluctant to take judicial notice of elements common to a given genre.[148] Cases such as *Capcom* and *Silas* highlight the courts' hesitation to take judicial notice of numerous other works and common ideas and elements prevalent in certain genres.[149] In *Capcom Co. Ltd v. MKR Group*, Inc., the court declined to take judicial notice of these elements in the context of zombie movies and games.[150] Similarly, in *Silas v. HBO*, the court denied a request for judicial notice of elements common to prior works.[151] These examples indicate that district courts remain cautious when it comes to assuming the existence of common elements in a genre without proper evidence.

In the case of *Zella v. E.W. Scripps Co.*, the court took judicial notice of four elements common to cooking shows, but only because they could be "verified simply by watching television for any length of time."[152] However, the court declined to take judicial notice of specific cooking shows.[153] The court recognized that the expression of these elements can vary and that specific examples may not be universally accepted or recognized as scenes a faire.[154]

The cautious approach of district courts regarding the judicial notice of common elements in a genre is not only evident in the cases cited but also raises concerns regarding the introduction of prior art in copyright law. The absence of consensus among courts regarding how exactly to go about identifying common and unprotectable elements under the scenes a faire doctrine underscores the inherent vagueness of this exception to copyrightability.[155] The sheer volume of prior art works compounds this vagueness, exacerbating the challenges in determining what elements are unprotectable.

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146. *See* Barlow, *supra* note 131.

147. *But see*, L.A. Printex Indus. v. T.J. Maxx of Cal., LLC, No. CV 09-5868 PA (FFMx), 2010 U.S. Dist. LEXIS 148271 (C.D. Cal. Jan. 11, 2010).

148. Capcom Co. Ltd v. MKR Group, Inc., 2008 U.S. Dist. LEXIS 83836, at *1170 (N.D. Cal. 2008); Silas v. HBO, 201 F.Supp.3d 1158, 1168 (C.D. Cal. 2016).

149. *Capcom Co*., 2008 U.S. Dist. LEXIS 83836, at *1170; *Silas*, 201 F.Supp.3d at 1168.

150. *Capcom Co*., 2008 U.S. Dist. LEXIS 83836, at *1170.

151. Silas v. HBO, 201 F.Supp.3d 1158, 1170 (C.D. Cal 2016) *aff'd* 713 F. App'x 626 (9th Cir. 2018).

152. Zella v. E.W. Scripps Co., 529 F.Supp.2d 1124, 1129 (C.D. Cal 2003).

153. *Id*.

154. *Id*.

155. *See* Capcom Co. Ltd v. MKR Group, Inc., 2008 U.S. Dist. LEXIS 83836, 9–11 (N.D.Cal. 2008); Silas v. HBO, 201 F.Supp.3d 1158, 1168 (C.D.Cal. 2016).

One must bear in mind that while the *scenes a faire* doctrine offers a limited exception to copyright protection, the narrow doctrine diverges from the broader concept of copyright protection. The doctrine exists to prevent the monopolization of commonplace or necessary elements, rather than evaluating the novelty or inventiveness of an idea or expression.[156] On the contrary, if the legal profession uses prior art analysis extensively in copyright law, extending beyond *scenes a faire* to encompass the vast expanse of musical compositions, literary works, and artistic creations throughout history, prior art becomes the elephant in every copyright room. This becomes a valid issue if the scope of prior art extends beyond the confines and restrictions imposed by the *scenes a faire* doctrine. Consequently, prior art could serve as an improper, broad, and all-encompassing bar to copyright protection and succeeding in copyright infringement claims, particularly in the realm of literary works.

The *scenes a faire* doctrine serves as an important recognition that copyright should not exclusively protect certain "indispensable" elements within a genre; there should remain a shared pool of ideas and expressions available to all creators.[157] However, it is worth noting that the application of the scenes a faire doctrine does not exist without challenges. As demonstrated by the cases mentioned, district courts have shown reluctance to take judicial notice of common elements, and no consensus exists for how to establish and prove scenes a faire definitively.[158] The lack of consensus among courts on the copyright protection of these elements only serves to highlight the difficulties applying a prior art at all. Adopting prior art as a defense to copyright protection further adds complexity, as it invites consideration of the protectability of elements in a pool of virtually infinite comparisons to previous works.

A Prior Art Defense Will Make Literary Works Virtually Uncopyrightable

While it is relatively straightforward to establish substantial similarity when there is verbatim duplication or literal similarity, the challenge becomes more difficult when there is an absence of word-for-word or other exact duplication.[159] Currently, it is only music infringement cases that have veered into applying a prior art defense.[160] However, if courts choose to extend this defense to other areas of copyright expression, such as literary works such as screenplays or novels, this will stack the deck completely and utterly against any copyright plaintiff trying to enforce their copyright rights.

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156. NIMMER & NIMMER, *supra* note 17, §13.

157. *Id.*

158. *See* Capcom Co. Ltd v. MKR Group, Inc., 2008 U.S. Dist. LEXIS 83836, 9–11 (N.D.Cal. 2008); Silas v. HBO, 201 F.Supp.3d 1158, 1168 (C.D.Cal. 2016).

159. NIMMER & NIMMER, *supra* note 17, §13.03.

160. *See generally* Skidmore v. Led Zeppelin, 952 F.3d 1051 (9th Cir. 2020); Johannsongs-Publishing, Ltd., v Lovland, U.S. App. LEXIS 35135 (9th Cir. 2021).

Literary works build upon a combination of protectable and unprotectable elements that, when taken together, create a unique and original copyrightable work.[161] Allowing prior art as a defense in literary infringements would effectively erode the copyrightability of such works, as almost nothing would be deemed copyrightable if arguably unprotectable elements are removed from the analysis entirely, a result at odds with the "selection and arrangement" test.[162]

The determination of substantial similarity in copyright infringement cases, particularly in the realm of literary works, remains a contentious issue marked by conflicting tests applied by various circuit courts.[163] Over the past 25 years, courts have grappled with inconsistent approaches to this analysis, resulting in confusion among federal courts.[164] Even within the Ninth Circuit, often referred to as the "Hollywood Circuit," internal conflicts arise regarding the appropriate test for determining substantial similarity in literary infringement cases.[165] For many years, judges in literary infringement cases indicate a concerning trend of consistently applied the wrong test, leading to the obfuscation of blatant copying, and resulting in defendants prevailing at least 95 percent of the time.[166]

The problematic "filtration test" in which unprotectable elements are filtered out *ab initio* has previously gained some traction in the Ninth Circuit in literary infringement cases.[167] This test requires courts to filter out and disregard non-protectable elements when evaluating substantial similarity.[168] This filtration approach stands in contrast to the U.S. Supreme Court's ruling in *Feist Publications, Inc. v. Rural Telephone Service Co.*, which confirmed an original selection and arrangement of non-copyrightable elements is sufficient to enjoy copyright protection.[169] The *Feist* ruling recognized the importance of originality and rejected the notion of excluding non-protectable elements from the analysis.[170] Sadly, the Ninth Circuit has often disregarded this precedent.[171]

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161. Dr. Suess Enters., L.P. v. ComicMix LLC, 256 F.Supp. 3d 1099, 1109 (S.D.Cal. 2017) ("'Every book in literature, science, and art, borrows, and must necessarily borrow, and use much which was well known and used before.'")(citing *Campbell*, 510 U.S. at 575).

162. *Id*.

163. Clark D. Asay, *An Empirical Study of Copyright's Substantial Similarity Test*, 13 U.C. IRVINE L. REV. 35, 39 (2022).

164. Steven T. Lowe, *Death of Copyright 3*, L.A. LAW. 28 (2018); Steven T. Lowe, *Death of Copyright*, L.A. LAW. 32 (2010).

165. Steven T. Lowe, *Death of Copyright 3*, L.A. LAW. 28 (2018).

166. *Id*. at 32.

167. *Id*. at 30.

168. Funky Films, Inc. v. Time Warner Entm't. Co., L.P., 462 F. 3d 1072, 1077 (9th Cir. 2006) (citing *Cavalier*, 297 F. 3d at 822-23).

169. *Feist*, 499 U.S. 340, 348-49, 358 (1991)

170. *Id*.

171. Lilith Games (Shanghai) Co. v. uCool, Inc., No. 15-CV-01267-SC, 2015 U.S. Dist. LEXIS 128619, at *1, *7 (N.D. Cal. 2015); *See generally* Benay v. Warner Bros., 607 F.3d 620 (9th Cir. 2010).

Consequently, the filtration test raises concerns about the potential erosion of copyright protection for literary works.[172] By excluding non-protectable elements from the analysis, the test effectively diminishes a work down to its individual and incomplete parts, leaving courts to find little, if anything, that is copyrightable.[173] For instance, the Second Circuit, in recognition of the filtration test's reductive scope, asserted that the "'[e]xcessive splintering' of the elements of a work would result in almost nothing being copyrightable because original works broken down into their composite parts would usually be little more than basic non-protectable elements."[174] As a result, courts following the filtration test typically find nothing in the work that qualifies for copyright protection.

Consider a fictional scenario involving a bestselling novel titled "The Enchanted Forest." The novel tells the captivating story of a young protagonist who embarks on a magical journey through a mystical forest, encountering unique creatures and overcoming various challenges.

Now, imagine that a major studio releases a blockbuster film called "Mystic Wilderness." This film shares several similarities with "The Enchanted Forest," such as featuring a young protagonist exploring a magical forest and encountering fantastical creatures. However, the studio argues that these similarities are merely general concepts, scenes à faire, or ideas commonly found in the fantasy genre, and therefore, the Court should consider them non-protectable elements. The court, employing the filtration test, proceeds to filter out and disregard these alleged non-protectable elements, focusing solely on the protectable elements standing alone. During the analysis, the studio's defense introduces prior art, citing a series of pre-existing fantasy novels, movies, and folklore that also depict young protagonists on magical adventures in enchanted forests. The prior art includes works like "The Secret Woods," "Enchanted Realms," and even well-known fairy tales involving similar themes and settings. The studio argues that these pre-existing works establish a common pool of unprotectable elements and scenes à faire in the fantasy genre, which are present in both "The Enchanted Forest" and "Mystic Wilderness." The court, influenced by the analysis resulting from the filtration test and the prior art defense, concludes that the similarities between the protectable elements of "The Enchanted Forest" and "Mystic Wilderness" are minimal or nonexistent. The court may argue that the general premise of a young protagonist in a magical forest is a common concept found in the public domain, and any protectable expression that may

172. Christopher Jon Sprigman & Samantha Fink Hedrick, *The Filtration Problem in Copyright's "Substantial Similarity" Test*, 23 LEWIS & CLARK L. REV. 571, 574–576 (2019); Robert F. Helfing, *"Substantial Similarity in Literary Infringement Cases: A Chart for Turbid Waters,"* 21 UCLA ENT. L. REV., Issue 1 (2014).

173. Steven T. Lowe, *Death of Copyright 3*, L.A. LAW. 28, 30 (2018).

174. *Id.*; New Old Music Group, Inc. v. Gottwald, 122 F. Supp. 3d 78, 94 (2nd Cir. 2015) (citing Mena v. Fox Entm't Group, Inc., No. 11-CV-5501 (BSJ) 2012 WL 4741389 at *4 (2012) (citation omitted).

have existed has been reduced to unprotectable elements shared with the prior art. As a result, the court determines that there is no substantial similarity between the two works, effectively stripping "The Enchanted Forest" of its copyright protection. Despite the original selection and arrangement of elements in the novel, the filtration test, albeit, a test that has largely been abandoned by both the 9th and 2d Circuits, combined with the introduction of prior art, leads to the conclusion that there is little to no protectable expression left in the work.

In this example, the prior art defense, when coupled with the Filtration Test, diminishes the copyright protection of "The Enchanted Forest" by reducing it to a combination of unprotectable elements shared with existing works. This outcome highlights the challenges faced by copyright holders in protecting their literary works against major studios or other defendants who can leverage prior art to erode the originality and protectable expression of a work, leaving it highly vulnerable to infringement.

The lack of consensus among circuit courts regarding the tests for substantial similarity, and the intermittent prevalence of the filtration test in the Ninth Circuit, creates uncertainty and will fundamentally undermine the protection of literary works. By permitting prior art to serve as a tool for invalidating literary copyright protection, courts will not only diminish the ability of creative professionals to safeguard their literary expressions but also contribute to an alarming use of a test that disregards the unprotectable elements that collectively gives the work its unique and original character, in combination.

To foster a robust and consistent protection of artistic works, courts must adopt a clear and unified approach to substantial similarity analysis. This approach should prioritize the assessment of the protected expression in a work rather than delving into the presence of prior art. By doing so, courts can uphold the core principles of copyright law, protect the rights of creative professionals, and ensure that the unique and original character of literary works receives the necessary safeguarding it deserves.

There is No Systematic Way to Search Prior Art in Copyright Cases

One fundamental distinction between patent law and copyright law lies in the availability of comprehensive databases to search for prior art.[175] While patent law benefits from widely established databases that enable patent applicants to determine whether their inventions meet the requirements for exclusive patent protection, no such equivalent exists in the realm of

175. *See* Fishman & Garcia, *supra* note 15, at 1200-02 (discussing the ways individuals put together their knowledge and resources to create their own databases); David Schumann, *Obviousness with Business Methods*, 56 U. MIAMI L. REV. 727, 765 (2002) ("The USPTO has also improved prior art databases and has signed an agreement with the Information Technology Association of America to help examiners get access to additional databases and prior art").

copyright law.[176] This absence of an akin database poses a significant challenge for individuals seeking copyright protection, as it would be practically impossible to know whether they are vulnerable to a prior art defense by sifting through all past artistic works to ensure the validity of their copyrights, even if they independently created their work, and the work was accepted for registration by the copyright office.

In patent law, several renowned databases assist in the search for prior art, allowing patent applicants to determine the novelty and non-obviousness of their inventions.[177] For instance, Google Patents, a search engine offered by Google, indexes patents from the United States Patent and Trademark Office (USPTO) and other international patent offices, including non-patent literature classified using machine-generated CPC codes.[178] Similarly, Espacenet, provided by the European Patent Office, offers an extensive collection of public patent literature from different countries.[179] Additionally, DEPATISnet, a public patent database maintained by the German Patent and Trademark Office, serves as the official publication source for patents and patent applications in Germany, incorporating various national and regional patent collections.[180] Also, PATENTSCOPE, a public patent database provided by the World Intellectual Property Organization (WIPO), acts as the official publication source for patent applications filed under the Patent Cooperation Treaty (PCT), encompassing numerous national and regional patent collections.[181] Furthermore, the Patent Register Portal is yet another online platform that provides access to registers, gazettes, and legal-status-related information from over 200 jurisdictions and patent information collections.[182] These databases collectively offer patent applicants the convenience of quickly assessing the patentability of their inventions.[183]

In contrast, copyright protection extends to creative works of authorship that span millennia, encompassing art, music, stories, plays, poems, folklore, and more. The sheer breadth and depth of prior art in the realm of copyright poses an insurmountable challenge for individuals seeking to identify what if any, prior art exists. Unlike patent law, which benefits from concise databases to swiftly determine patent applicants' eligibility for exclusivity,

176. Fishman & Garcia, *supra* note 15, at 1200-02.

177. Ted G. Dane, *Are the Federal Circuit's Recent 101 Decisions a "Specific Improvement" in Patent Eligibility Law*?, 26 FED. CIR. B.J. 331, 345–346 (2016) (discussing "conventional" and "relational" databases for prior art).

178. Teo Firpo & Michael S. Mireles, *Monitoring Behavior: Universities, Nonprofits, Patents, and Litigation*, 71 SMU L.Rev. 505, 557–559 (2018).

179. EUROPEAN PATENT OFFICE, **ESPACENET** RESOURCE BOOK 95 (2.1 ed. 2017).

180. DEPATISnet, GERMAN PATENT AND TRADEMARK OFFICE, https://depatisnet.dpma.de/DepatisNet/depatisnet (last visited June 26, 2023).

181. PATENTSCOPE, WORLD INTELLECTUAL PROPERTY ORGANIZATION, https://patentscope.wipo.int/search/en/search.jsf (last visited June 26, 2023).

182. Patent Register Portal, WORLD INTELLECTUAL PROPERTY ORGANIZATION, (last visited June 26, 2023).

183. Sean B. Seymore, *The Null Patent*, 53 WM. & MARY L. REV. 2041, 2063 (2012).

copyright law lacks a comparable resource.[184] Consequently, expecting creators to evaluate the entirety of copyrighted expression from the dawn of time to ensure the originality and non-infringement of their works poses an untenable burden.

Moreover, the absence of a comprehensive database in copyright law presents a distinct factual advantage to those who have the resources to compile such a database. Major companies, such as major studios, possess the financial means and infrastructure to compile vast databases that encompass a wide array of creative works. These comprehensive databases provide them with a significant advantage in copyright infringement cases, as they can search and cross-reference extensive collections of prior art, giving them a greater likelihood of successfully defending against copyright infringement claims. This situation can potentially undermine the rights of individual artists and creators, with limited resources and the absence of a centralized database significantly constraining their ability to access and navigate the extensive landscape of prior art.

As the author of a law review article on the subject aptly stated, "it is too burdensome to expect creators to sift through the entirety of copyrighted expression in order to ascertain the originality of their works."[185] The absence of a comparable system to patent law's comprehensive databases places a substantial hurdle in the path of creators seeking copyright protection, ultimately impeding their ability to safeguard their creative endeavors.

In the absence of an easily accessible and comprehensive database to search for prior art, like in patent law, a judge allowing for a prior art defense in a copyright case begs the question: Does this term encompass every artistic creation since the dawn of time, effectively placing an overwhelming burden on artists to be aware of and account for every work ever created? Post-*Skidmore* cases like the recent 2020 case of *Johannsongs-Publishing, Ltd. v. Rolf Lovland* highlight the challenges faced by individual artists and musicians when trying to protect their works.[186] The defendants in this case argued that similarities between their song "You Raise Me Up" and the plaintiff's song "Soknudur" did not satisfy a copyright infringement claim, as they could be found in prior art, including the Irish folk songs "Londonderry Air" and "Danny Boy."[187]

By invoking the defense of prior art in *Johannsongs-Publishing, Ltd. v. Rolf Lovland*, the defendant essentially expects individual creators to possess knowledge of and be cognizant of every existing piece of music, art, and

184. *See* Fishman & Garcia, *supra* note 15, at 1200-02 (discussing the ways individuals put together their knowledge and resources to create their own databases).

185. Clarisa Long, *Information Costs in Patent and Copyright*, 90 VAND. L. REV. 465, 529-33 (2004).

186. Johannsongs-Publishing, Ltd. v. Lovland, 2021 U.S. App. LEXIS 35135; Johannsongs-Publ'g Ltd. v. Lovland, 2020 U.S. Dist. LEXIS 82464.

187. *See generally* Johannsongs-Publishing, Ltd. v. Lovland, 2021 U.S. App. LEXIS 35135; Johannsongs-Publ'g Ltd. v. Lovland, 2020 U.S. Dist. LEXIS 82464.

creative work throughout history.[188] However, this expectation is highly improbable, if not impossible, for artists and musicians to fulfill, considering the vast breadth of artistic expression over time. Furthermore, the defense's reference to the 1910 Irish folk song, "Danny Boy," as prior art raises additional concerns, for the artists of "Danny Boy" never even registered their work with the U.S. Copyright Office.[189] Consequently, even if the plaintiff had checked with the U.S. Copyright Office, he would have had no way of knowing if his song, "Soknudur," bore any resemblance to the unregistered song "Danny Boy" while trying to protect his own work.

If defendants can use unregistered folk songs like "Danny Boy" or other obscure works as a catch-all to invalidate a plaintiff's copyright protection, it would create a situation where there would be no real copyright protection at all as there is "nothing new under the sun." Independent artists and musicians, who often lack the resources and expansive databases available to major studios and record labels, would suffer disproportionately compared to the big record labels. This disparity could potentially cause theft and infringement to run rampant, as established entities already have the means to pull from extensive resources while independent creators struggle to navigate the vast landscape of prior art.

In addition, musicians and songwriters operate within a framework of musical theory, where only so many chord progressions, melodies, and keys that create a pleasing and harmonious composition exist. This limited range of musical elements means that similarities and commonalities between different songs will naturally arise.[190] After all, an octave only contains twelve notes. Every composition, no matter how independently created, could potentially be deemed unoriginal based on elements that have been used before. This notion undermines the very essence of copyright protection, which is intended to safeguard and reward original creative expression.[191]

The application of prior art as a broad and indiscriminate tool could disproportionately favor major studios and record labels, who have the financial resources and expansive databases to draw from. Independent artists and musicians, who often lack access to such resources, would suffer a significant disadvantage, as their works may inadvertently overlap with existing compositions due to the inherent limitations of musical creation. Once again, copyright protection revolves around the requirement of originality, which allows for intermittent similarities with other works as long as they were independently created.[192] The notion of prior art bleeding into copyright is not

188. Johannsongs-Publishing, Ltd. v. Lovland, 2021 U.S. App. LEXIS 35135; Johannsongs-Publ'g Ltd. v. Lovland, 2020 U.S. Dist. LEXIS 82464.

189. Johannsongs-Publ'g Ltd. v. Lovland, No. CV 18-10009-AB, 2020 U.S. Dist. LEXIS 82464 (C.D. Cal. Apr. 3, 2020).

190. Metcalf v. Bochco, 294 F.3d 1069, 1074 (9th Cir. 2002).

191. NIMMER & NIMMER, *supra* note 17, §1.03 (breaking down the Constitution's purpose for copyright law as, "to promote the progress of science and useful arts").

192. NIMMER & NIMMER, *supra* note 17, §2.01.

only illogical but also impractical for artists, as artists could not navigate nor understand how to protect their own work in such a vast and diverse creative landscape.

IV. CONCLUSION

Invoking the prior art analysis in copyright cases runs afoul of the spirit and text of the Copyright Act as well as important policy concerns. Divesting an artist of full rights in their work because elements thereof were created at some point in the history of personkind is simply wrong. It would have significant implications for artists and creative professionals striving to safeguard their work from unauthorized use and theft, particularly by well-resourced infringers.

Prior art has absolutely no place in copyright law (other than its limited relevance to the *scenes a faire* doctrine).[193] Introducing prior art analysis in copyright actions would undermine copyright protection by eroding the essence of originality and independent creation requirements.[194] We must maintain this delicate balance between innovation incentives and authors' rights to ensure the progress of creative endeavors as envisioned by the U.S. Constitution.

Courts relying on prior art to resolve copyright disputes deviates from historical tradition and precedent.[195] While proponents argue that prior art protects against protection for more simplistic works, the standard for copyright has forever been modest and humble. .[196] The reliance on experts to interpret copyright law to include consideration of prior art when assessing originality or substantial similarity raises further concerns because, *inter alia*, they may have an extensive database of prior art in their field but the plaintiffs in these cases never have that same database.[197] The absence of a searchable and encompassing database for copyrighted prior art, coupled with the challenges of identifying and navigating the immeasurable landscape of artistic expression, undermines the reasonableness and fairness of copyright protection.

Furthermore, the potential for parties to use unregistered works as prior art undermines the integrity of copyright protection. Allowing such works to serve as a catch-all to invalidate copyright claims would stifle creativity and hinder the ability of independent artists and musicians to protect their works.

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193. CHISUM, *supra* note 4, § 5.03.

194. NIMMER & NIMMER, *supra* note 17, §12.01.

195. Smith v. Weeknd, No. CV 19-2507 PA, 2020 U.S. Dist. LEXIS 130549 at 20 (C.D. Cal. July 22, 2020); Copeland v. Bieber, No. 2:13cv246, 2016 U.S. Dist. LEXIS 178817 at 16 (E.D. Va. September 8, 2016).

196. *See generally* Fishman & Garcia, *supra* note 15.

197. *See generally* Maureen Baker, *La(W)-A Note to Follow So: Have We Forgotten the Federal Rules of Evidence in Music Plagiarism Cases?*, 65 S. CAL. L. REV. 1583 (1992).

In conclusion, the prior art doctrine undermines the text and spirit of the Copyright Act and the rights of artists and copyright holders. It also places an oppressive burden on creators and compromises the core principles of copyright protection. To protect creative works, courts must adopt clear and unified approaches to substantial similarity analysis, prioritize the assessment of protected expression, and recognize the unique challenges posed by copyright law. By doing so, copyright law can effectively reward those who better our world with their creative works.