Prior Art in Copyright

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Joseph P. Fishman & Kristelia García, *Authoring Prior Art*, 75 **Vand. L. Rev.** __ (forthcoming 2022), available at SSRN.

Patent and copyright law share what the Supreme Court calls a "historic kinship": they both grant exclusive rights under the IP Clause to incentivize production of new knowledge goods. But they implement this goal through very different doctrinal frameworks, including different roles for "prior art"—all the information that existed before the innovation at issue. Patent validity crucially depends on whether an invention is new and nonobvious compared to the prior art. In contrast, it doesn't matter if a copyrighted work is similar to earlier works as long as it wasn't actually copied from them. Copyright treatises unquestioningly assert that the formal prior art analysis of patent law has had no place in blackletter copyright doctrine.

The doctrinal trend identified in a new article by Joseph Fishman and Kristelia García, *Authoring Prior Art*, is thus interesting and surprising: in at least some recent copyright music cases, judges are looking at prior art. One judge even dismissed an infringement claim for "failing to consider prior art," rendering the comparison between the original and infringing works "legally deficient." Another dismissed a claim because the plaintiff's expert report lacked "any information about prior art," whereas the defendant's expert cited three earlier songs with similar expressive qualities. Identifying this trend would be valuable on its own, but Fishman and García go further in tracing the source of this development to the influence of a small set of musicologist expert witnesses.

Judges rely on experts in music cases more than in any copyright field except software, perhaps because they are less comfortable assessing the similarity of musical works than works like novels, films, and paintings. And the pool of music copyright experts is tiny: Fishman and García analyzed fifty reports and found that they were produced by only ten experts, with one expert producing 23 out of 29 defense-side reports. These defense-side reports generally identified prior art to argue that any similarities between the allegedly infringing work and the copyrighted work were also present in the prior art, and plaintiffs' experts generally argued not that prior art is irrelevant, but that any prior art wasn't that similar to the copyrighted work at issue. Fishman and García also interviewed six of these experts, who described a perceived duty to assess the prior art not only to determine whether the defendant's work was actually copied from the plaintiff's, but also to evaluate the creative importance of any similarities between the works.

To understand exactly how these cases are using prior art in the infringement analysis, it's worth recapping the relevant blackletter doctrine. Assessing whether a defendant copied enough from a plaintiff's work to constitute copyright infringement first requires filtering out any unprotectable elements, such as abstract ideas and "scènes à faire"—stock elements that are ubiquitous in the genre. The works are then compared for "substantial similarity" from the perspective of the ordinary observer of the works in question. Both steps of this analysis are frustratingly vague, especially for those trained in the comparatively formulaic rules of patent law: it isn't easy to draw a line between unprotectable ideas and protectable expression or to determine if any remaining similarity is "substantial."

Prior art isn't a formal part of this doctrine, but it is implicit in the analysis. Judges know that "star-crossed lovers" is an abstract idea that should be filtered out because this idea recurs in prior art ranging from *Romeo and Juliet* to *Buffy the Vampire Slayer*; they know that shootouts in Westerns and dead phones in horror films are scènes à faire because of prior art in these genres. (Patent readers might analogize to the amorphous category of "abstract ideas" like "longstanding practices" under recent patentable subject matter caselaw.) The musicologist expert reports—and cases that follow them—surveyed by Fishman and García make this reliance on prior art explicit, and they expand the relevant prior art from ubiquitous elements that judges are personally familiar with to a more patent-like universe of all prior

works identified through specialized search tools. Experts frequently argue that elements drawn from the prior art should be discounted in the substantial similarity analysis as "musicologically insignificant," so that a work cannot be infringing if it is closer to the prior art than to the plaintiff's work.

This approach is similar to that suggested a decade ago by Rebecca Tushnet, who asked whether "substantial similarity doctrine could be improved by, in essence, placing the plaintiff's work alongside an array of prior art and trying to place the accused work in the 'space' defined by the expressive universe," and then framing the legal question as "whether the similarity between the plaintiff's work and the accused work is any greater than the similarity between the accused work and [the prior art]." For these reasons, the recent adoption of prior art analysis in music copyright cases may be a beneficial development. As Fishman and García explain, "prior art allows judges to understand a work in its creative context rather than in a vacuum."

Fishman and García don't offer a prediction on whether this use of prior art will expand into non-music cases, or whether such an expansion would be a good thing. These seem like important questions to pursue in future work, both by scholars and by practitioners and experts in other copyright cases. Prior art is certainly not a panacea—facts and broad ideas can't be copyrighted even if far removed from the prior art, just as natural laws and abstract ideas can't be patented no matter how novel. But if prior art could make the elusive line between ideas and expression somewhat more predictable, that would be a welcome development for both potential copyright litigants and future students of IP law.

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