Surprising Results of a New Study of Copyright Substantial Similarity Analyses

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Clark Asay, *An Empirical Study of Copyright's Substantial Similarity Test*, 13 **UC Irvine L. Rev.** __ (forthcoming, 2022), available at SSRN.

Far fewer empirical studies in the intellectual property field have focused on copyrights than on patents. Each new entrant to this small field is, however, welcome. The latest offering by Clark Asay reports on his study of a random sample of 1005 judicial opinions assessing substantial similarity infringement analyses in 974 cases decided between 1978-2020. He coded for subject matters, rights in dispute, procedural postures, subtests, expert evidence, whether courts discussed copyright limitations, sources of authority, and outcomes.

Those of us who teach copyright law have long had the impression that substantial similarity analyses in the opinions we teach are a hot mess. Asay has now provided empirical evidence that this impression is mostly quite accurate.

Each circuit, he reports, "has its own particular way of applying [the substantial similarity test], with different circuits employing a multitude of subtests within the larger substantial similarity inquiry." Asay concludes that substantial similarity analysis is "notorious for its lack of uniformity, both within circuits and across them, despite commentators' attempts to provide sanitized versions of what different circuits do." Treatises "seek to provide clarity around the law," he notes, but this "sometimes [comes] at the expense of accuracy."

So what surprises does Asay uncover with this empirical study? For one thing, he reports that the first step of the conventional substantial similarity test—which focuses on whether the challenged work is similar enough to the plaintiff's work to prove that the defendant copied something (even if not protected expression) from the plaintiff's work—is "mostly moribund." Although commonly cited infringement cases have endorsed using experts for this first step, Asay says that courts rarely rely on them. When courts do consider this step, however, plaintiffs prevail more often than defendants.

To me, the biggest surprise was that defendants prevailed in more than two-thirds of the cases when courts reached the second step—whether the defendant has improperly appropriated protected expression from the plaintiff's work based on substantial similarities in the two works' expression—and discussed at least some of the limiting doctrines of copyright law, such as the merger and scenes a faire doctrines. Asay reports that sixty-three percent of the opinions did indeed discuss some of these doctrines. By contrast, plaintiffs prevailed in two-thirds of the cases in which judges made no mention of any limiting doctrines.

Another surprise was that although courts in the Second Circuit between 1978 and 1999 produced well over twice as many published substantial similarity analysis opinions as the Ninth Circuit, these two courts have produced roughly the same number of such opinions since 2000. And if one counts unpublished substantial similarity analysis opinions dating from 2000 on, Ninth Circuit courts have produced nearly three times as many opinions per year as Second Circuit courts.

Also surprising was that the late 20th century courts rarely decided copyright substantial similarity cases on motions to dismiss, but starting in 2006, there was an upward trend of cases decided on motions to dismiss. In 2018 and 2019, the last two years Asay studied, more substantial similarity cases were decided on motions to dismiss than on summary judgment. Yet, almost half of the overall opinions in his study were decided on summary judgment motions,

although the second most common procedural posture was motions to dismiss.

Asay kept track of the subtests that courts used in substantial similarity opinions. He found several variations among them: ordinary observer, more discerning observer, average lay person, audience, intended audience, reasonable observer, and reasonable person. It is, of course, unclear how much (if any) difference which characterization the courts used.

Twenty-eight percent of the substantial similarity cases applied the ordinary observer test, while 24 percent applied the extrinsic/intrinsic test, 21 percent the total concept and feel test, and 11 percent the abstraction-filtration-comparison (AFC) test. Asay reports that courts in the Ninth Circuit have applied the AFC test more often than courts in the Second Circuit from whence the AFC test originated.

One last surprising result before this jot concludes: Nearly 98 percent of the 1005 substantial similarity opinions Asay studied cited at least some authorities. Fifty-six percent cited to Second Circuit precedents. Next most influential was the Supreme Court whose precedents (usually the *Feist* decision) were cited in just over half of the 1005 opinions. Ninth Circuit opinions were the third most influential source of authority. The least influential authority was the Federal Circuit, which accounted for only 2 percent of the authorities cited in Asay's sample of cases.

Many other useful insights can be found in Asay's study, so I highly recommend it to Jotwell's readers.

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