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## IMPROPER APPROPRIATION

by Daniel Gervais\*

*The traditional test for copyright infringement is satisfied when the owner of a valid copyright establishes, first, that her work was actually copied and second, that the copying amounts to an improper or unlawful appropriation. As applied by courts, the second prong of the test is often applied quantitatively that is, when the amount of the copyrighted work that is copied is more than de minimis. This seems odd for a test expressed using a term wrought with moral overtones (impropriety). This Article discusses whether this test could be applied differently by requiring an examination of the (im)propriety of the defendant's appropriation.*

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## INTRODUCTION

The traditional *Arnstein* test for copyright infringement is satisfied when the owner of a valid copyright establishes unauthorized copying by the defendant.<sup>1</sup> To demonstrate unauthorized copying, one of the major tests is that the plaintiff must first “show that [her] work was actually copied”; second, she must establish “substantial similarity” or that “the copying amounts to an *improper or unlawful* appropriation.”<sup>2</sup> The second prong is satisfied when (i) protected expression in the earlier work was copied and (ii) the “amount of the copyrighted work that is copied . . . must be more than *de minimis*.”<sup>3</sup> Facially—and, as this Article will attempt to demonstrate, in more substantive ways as well—it seems odd that a test expressed using a term wrought with moral overtones (impropriety) is essentially applied as a quantitative test. One could apply this test differently and use it to lay a key normative pillar of copyright infringement requiring an examination of the (im)propriety of the defendant’s appropriation.

This Article examines, first, how impropriety has been applied in copyright infringement cases, and, second, whether the test could (doctrinally) and should (normatively) perform additional work as we move ever more into an era of massive creative reuse of existing works, whether as appropriation art, user-generated content or otherwise. The Article suggests that the notion of propriety should play an enhanced role, especially in cases of reuse of pre-existing copyrighted works.

## I. CURRENT ROLE OF PROPRIETY IN COPYRIGHT LAW

A. *Propriety in Early Copyright Law*

Any analysis of impropriety and its positive antipode, propriety, requires utmost semantic caution because historically, “propriety” was a term used at times to mean what we would today refer to as property.<sup>4</sup> In that sense, it is connected to

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<sup>1</sup> *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946) (establishing the *Arnstein* test). See also Douglas Y’Barbo, *The Origins of the Contemporary Standard for Copyright Infringement*, 6 INTELL. PROP. L.J. 285 (1999).

<sup>2</sup> *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp. Inc.*, 150 F.3d 132, 137 (2d Cir.1998) (emphasis added and internal quotation marks omitted) (citing *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 139–40 (2d Cir. 1992)).

<sup>3</sup> *Id.* at 138.

<sup>4</sup> *Proprietary*, BLACK’S LAW DICTIONARY (8th ed. 2004). See also MARK ROSE, AUTHORS AND

Aquinas' use of *proprietas* for any form of individual and exclusive possession.<sup>5</sup> In any discussion of the role of "propriety" in early copyright history, therefore, one must navigate around semantic shoals and distinguish it, where appropriate, from its use in more modern jurisprudence. As Professor Patterson noted, some early British printing ordinances, including the one issued in 1643, referred to "propriety of Copies" of books, for example.<sup>6</sup> We see this meaning of "propriety" as "property" in words such as "proprietor" and "proprietary."<sup>7</sup> In more modern contexts, the term has taken on a different hue.

## B. *Propriety in Current US Copyright Law*

### 1. *Gauging (Im)propriety in Copyright Law*

The *Arnstein* test speaks of *improper or unlawful* appropriation.<sup>8</sup> Does "proper" mean the same thing as "legal"? In other words, is "improper" a synonym of "illegal"? The best answer is negative:

Justice Brennan implicitly recognized in his dissent in *Harper & Row*, if one defines propriety in terms of legality, the factor is circular. If 'good faith and fair dealing' mean engaging only in activities not violative of the Copyright Act, then it is impossible to decide whether a given activity violates the Act by considering its propriety.<sup>9</sup>

Without positive law to provide a definition efforts to gauge propriety require using metes and bounds from other sources. These can be found in *custom and practice, and ethics*.

Let us begin with custom and practice. In *Harper & Row*, Justice Brennan referred to "standard journalistic practice" in his attempt to determine the propriety of the defendant's conduct.<sup>10</sup> Indeed, "in the majority of fair use cases, courts could

OWNERS: THE INVENTION OF COPYRIGHT 32 (1993); Justin Hughes, *Copyright and Incomplete Historiographies: Of Piracy, Propertization, and Thomas Jefferson*, 79 S. CAL. L. REV. 993, 1011–12 (2006).

<sup>5</sup> See JAMES TULLY, *A DISCOURSE ON PROPERTY: JOHN LOCKE AND HIS ADVERSARIES* 65 (1980).

<sup>6</sup> LYMAN RAY PATTERSON, *COPYRIGHT IN HISTORICAL PERSPECTIVE* 129 (1968).

<sup>7</sup> Authors sometimes play on this, for example when discussing the propriety of a proprietary standard. See, e.g. Tom W. Bell, *Copyright Porn Trolls, Wasting Taxi Medallions, and the Propriety of "Property"*, 18 CHAPMAN L. REV. 799 (2015); Mark A. Lemley & David McGowan, *Could Java Change Everything? The Competitive Propriety of a Proprietary Standard*, 43 ANTITRUST BULL. 715 (1998).

<sup>8</sup> See *Arnstein* 154 F.2d at 468.

<sup>9</sup> William W. Fisher III, *Reconstructing the Fair Use Doctrine*, 101 HARV. L. REV. 1659, 1679–80 (1988).

<sup>10</sup> *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 593 (1985) (Brennan, J., dissenting).

not rely upon industry practice to make sense of and justify the 'propriety and custom' factor."<sup>11</sup> Custom and practice, as Professor Fisher rightly suggests, is a particularly useful factor when parties to the case belong to the same epistemic community.<sup>12</sup> This link between custom and practice, on the one hand, and propriety, on the other hand, has a long track record. Adam Smith defined propriety (and impropriety) in relational terms involving an agent (whose behavior is being "judged"), the recipient of the action and a third party (spectator).<sup>13</sup>

The role of custom and practice in law is quite common. It is sometimes reflected in the notion of "customary practice," which refers to widespread behavior (or behavior perceived as such by a defendant), that may in some cases amount to a social norm.<sup>14</sup> The Restatement (Second) of Contracts equates customary practice and usage and notes that an agreement can be supplemented "if each party knows or has reason to know of the usage and neither party knows or has reason to know that the other party has an intention inconsistent with the usage."<sup>15</sup> Trade usages "having such regularity of observance in a place, vocation, or trade" acquire normative force and justify "an expectation that [they] will be observed with respect to a particular agreement."<sup>16</sup> Custom and practice also plays a central role in tort cases.<sup>17</sup>

Because the *Arnstein* test refers to propriety, which can be gauged based on relevant practices, it seems fair to suggest that, in copyright infringement cases, the practices of users and especially creative reusers in a given field could and should be considered. How custom and practice could play a greater role in copyright infringement analyses may be illustrated by cases situated at the border between breach of contract and copyright law. For example, in a case dealing with copyright in architectural drawings, the Ninth Circuit decided that the architect plaintiff's "right to recover ultimately turns on the custom and usage of the architectural profession."<sup>18</sup>

<sup>11</sup> Fisher, *supra* note 9, at 1681.

<sup>12</sup> *Id.* at 1682.

<sup>13</sup> See ADAM SMITH, *THE THEORY OF MORAL SENTIMENTS* 19 (D.D. Raphael & A.L. Macfie eds., 1982).

<sup>14</sup> See Cass R. Sunstein, *Social Norms and Social Roles*, 96 COLUM. L. REV. 903, 911 (1996) (noting that "individual actors acting together can produce the relevant shifts."). See also Daniel J. Gervais, *The Price of Social Norms: Towards A Liability Regime for File-Sharing*, 12 J. INTELL. PROP. L. 39 (2004) (discussing music "file-sharing" and its compatibility with social norms); Richard H. McAdams, *The Origin, Development, and Regulation of Norms*, 96 MICH. L. REV. 338, 355 (1997); Richard A. Posner, *Social Norms and the Law: An Economic Approach*, 87 AM. ECON. REV. 365 (1997).

<sup>15</sup> UCC § 1-303 (AM. LAW INST. & UNIF. LAW COMM'N 2014); RESTATEMENT (SECOND) OF CONTRACTS § 221 (AM. LAW INST. 1981).

<sup>16</sup> RESTATEMENT (SECOND) OF CONTRACTS § 222 (AM. LAW INST. 1981).

<sup>17</sup> See WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF TORT LAW* 132-33 (1987).

<sup>18</sup> *May v. Morganelli-Heumann & Assoc.*, 618 F.2d 1363, 1367 (9th Cir.1980).

The plaintiff argued what amounted to an implied term in the contract between the parties, which required due consideration, leading the court to reverse summary judgment of the defendant.<sup>19</sup> It seems reasonable to posit that, if licensing practices can be scrutinized (the existence of a license, express or implied, being a defense to copyright infringement), then the *absence of a license due to applicable custom and practice* could be considered as well.<sup>20</sup> As the Supreme Court discussed in *Harper & Row*, a court could find that an implied license (e.g., to reuse material posted online under certain circumstances) existed, thus avoiding a fair use analysis.<sup>21</sup> In the same way, a court could decide whether applicable custom and practice make an appropriation *proper*, or, in other words, permissible. Looking for propriety in relevant custom and practice strikes this author as normatively more straightforward than trying to discern the existence of an implied license.

There is an important caveat that applies to the use of custom and practice to situate behavioral guideposts. In some circles, such as book publishing, there is a practice of licensing short excerpts that may well be fair uses. Publishers, by licensing short quotes to one another, limit the work done by fair use, which, over time, may restrict the scope of the doctrine.<sup>22</sup> Custom and practice developed by only a discrete part or subset of the relevant community (which in this case would also include authors (including the use of quotations) and librarians) are thus suspect. Hence, this Article agrees with Rothman's suggestion that "a custom should generally only be applied against parties who participated in its development or, at least, who were adequately represented in its development."<sup>23</sup>

Turning to the role of ethics in copyright law, Justice O'Connor "seemed to assume that *popular morality* can and should be the yardstick."<sup>24</sup> A court could avoid the pitfalls of "deriving substantive standards from 'society's widely shared values' .

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<sup>19</sup> *Id.* at 1368.

<sup>20</sup> See Dylan J. Quinn, *Associated Press v. Meltwater: Are Courts Being Fair to News Aggregators?*, 15 MINN. J.L. SCI. & TECH. 1189, 1190–91 (2014) (discussing *Associated Press v. Meltwater U.S. Holdings, Inc.*, 931 F. Supp. 2d 537 (S.D.N.Y. 2013) and noting that "an expanded implied license doctrine in the context of online news media presents an intriguing alternative to traditional copyright law.").

<sup>21</sup> This is tricky of course, as it reduces the work done by the fair use doctrine, but possibly also its scope of application. See Jennifer Rothman, *The Questionable Use of Custom in Intellectual Property*, 93 VA. L. REV. 1899, 1943–44 (2007) ("Many courts have picked up the implied consent analysis from *Harper & Row*. There are two significant problems, however, with the Court's suggested approach. First, fair use ceases to make any sense if it turns on whether an author would consent to the use, since the guiding principle of fair use is to allow uses when there is no consent, implied or otherwise.").

<sup>22</sup> *Id.* at 1911–16.

<sup>23</sup> *Id.* at 1908.

<sup>24</sup> Fisher, *supra* note 9, at 1681 (emphasis added).

. . . in a culture as fractured as that of the United States today.”<sup>25</sup> To do so, it could refer to a moral standard to identify “a theory that would enable it to distinguish good behavior from bad.”<sup>26</sup> The idea that ethical behavior can be derived from “popular” or community behavior indicates that, in this context at least, “ethics” is likely a close cousin of custom and practice.<sup>27</sup>

What is perhaps most striking in comparing the copyright cases about issues not related to improper appropriation, mentioned in the next section (I.B.2.), and those on improper appropriation, discussed in the following section (I.B.3.), is the normative quality with which propriety is infused in the former, but not the latter, group of cases. In large part, this is probably because, in the latter group of cases, the impropriety of the defendant’s appropriation is an inquiry framed as factual and performed without expert evidence as to norms or permissibility (if any) that is applicable to the defendant’s conduct.<sup>28</sup> This framing is not an insurmountable obstacle, however. After all, fact-finders often make factual determinations interwoven with normative strands, such as whether conduct is “reasonable” or not in medical malpractice cases, or when juries decide deeply moral questions, such as whether criminal conduct is sufficiently “cruel” to warrant a harsher penalty.<sup>29</sup> In the version of the improper appropriation test proposed in Part II of this Article, a determination of whether the defendant’s conduct was proper, that is, whether the copying

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<sup>25</sup> *Id.*

<sup>26</sup> *Id.* at 1682. In his article, Professor Fisher discusses several options in that regard. *See id.* at 1744–94 (Part V: Utopian Analysis).

<sup>27</sup> A determination of relevant customs, practices and applicable ethical norms may require expert evidence. For an example of expert evidence used to determine the scope and relevance of a trade usage, see *Commercial Union Ins. v. Seven Provinces Ins. Co.*, 9 F. Supp. 2d 49, 66, *aff’d*, 217 F.3d 33 (1st Cir. 2000). Expert evidence is routinely used, for example, concerning usage in determining “usefulness of the article and whether any apparent functional aspects can be separated from the artistic aspects.” *Poe v. Missing Persons*, 745 F.2d 1238, 1243 (9th Cir. 1984). *See also* *Norris Indus. v. Int’l Tel. & Tel.*, 696 F.2d 918, 922 (11th Cir. 1983); *Trans-World Manufacturing v. Al Nyman & Sons, Inc.*, 95 F.R.D. 95, 97 (D. Del.1982). This change alone (allowing expert evidence at this stage of the inquiry) could transform the role that propriety plays in infringement analyses.

<sup>28</sup> *See* *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp. Inc.*, 150 F.3d 132, 137–38 (2d Cir.1998); *infra* note 45 and accompanying text.

<sup>29</sup> This cuts both ways, as juries may soften a law’s harsh application or adopt a harsher stance than might otherwise seem warranted. *See* Kristen K. Sauer, *Informed Conviction: Instructing the Jury About Mandatory Sentencing Consequences*, 95 COLUM. L. REV. 1232, 1256 (1995) (“Historically, juries have exercised their nullification power as a political check on the imposition of both harsh punishments and harsh laws.”). On determinations of reasonable medical behavior, by juries, see Neil Vidmar, *Are Juries Competent to Decide Liability in Tort Cases Involving Scientific/Medical Issues: Some Data From Medical Malpractice*, 43 EMORY L.J. 885, 906–07 (1994) (“Anecdotes about the widespread malperformance of juries do not stand up to systematic data . . .” which “indicate that juries are not systematically biased against doctors and that in the preponderance of cases they make reasonable decisions.”).

was permissible, would amount to this type of “normative-factual” determination.

## 2. *Application to Cases Other Than Improper Appropriation*

The term “propriety” is often used by U.S. courts in copyright cases to perform work not related to improper appropriation determinations. This is hardly surprising. Propriety, and its adjectival form “proper,” are terms that, like fairness/fair, can inform a court’s analysis and serve as a convenient vehicle to carry an equitable determination to its outcome in a court’s decision. For example, propriety played a role in situating the border between protected expression and unprotected idea. Professor Golvan, in discussing the 1935 case of *Echevarria v. Warner Bros Pictures*, opined that “an unfair commercial advantage may be obtained through the use of the detail of a story without the originator of the story receiving some reward,” in an analysis focused on “commercial propriety.”<sup>30</sup> In *Perfect10 v. Google*, the Ninth Circuit applied propriety as a general principle in evaluating injunctive relief (in copyright cases).<sup>31</sup> Propriety has also been a crucial factor in determining whether a court should exercise jurisdiction over foreign infringement.<sup>32</sup>

Propriety has also played a key role in helping courts in fair use cases. For example, in *Cariou v. Prince*, the court expressly considered the “propriety” of the defendant’s conduct and “faulted artist Richard Prince for never seeking permission to use the plaintiff’s works or even attempting to contact him to ask ‘about usage rights to the Photos, even though [the plaintiff’s work] clearly identified [the plaintiff] as the sole copyright holder’ and the plaintiff’s email address was readily available.”<sup>33</sup>

This is but one such example. Professor Fisher’s analysis of fair use cases sheds useful additional light on the broader role of propriety.<sup>34</sup> He notes, for instance,

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<sup>30</sup> Colin Golvan, *Copyright and Writers*, 9 EUR. INT’L. PROP. REV. 66, 67 (1987) (discussing *Echevarria v. Warner Bros. Pictures, Inc.*, 12 F. Supp. 632 (S.D. Cal. 1935)).

<sup>31</sup> *Perfect 10, Inc. v. Google, Inc.*, 653 F.3d 976, 980–81 (9th Cir. 2011) (“[P]ropriety of injunctive relief in cases arising under the Copyright Act must be evaluated on a case-by-case basis in accord with traditional equitable principles and without the aid of presumptions or a ‘thumb on the scale’ in favor of issuing such relief.”).

<sup>32</sup> See Graeme W. Austin, *Domestic Laws and Foreign Rights: Choice of Law in Transnational Copyright Infringement Litigation*, 23 COLUM.-VLA J.L. & ARTS 1, 40 (1999); Phanesh Koneru, *The Right “To Authorize” in U.S. Copyright Law: Questions of Contributory Infringement and Extraterritoriality*, 37 IDEA: J. L. & TECH 87, 92 (1996) (discussing the “propriety of the extraterritorial application of copyright laws under appropriate facts.”).

<sup>33</sup> Simon J. Frankel & Matt Kellogg, *Bad Faith and Fair Use*, 60 J. COPYRIGHT SOC’Y. U.S.A. 1, 28 (2012) (discussing *Cariou v. Prince*, 784 F. Supp. 2d 337 (S.D.N.Y. 2011)). See also Katherine C. Hall, *Deconstructing a Robotic Toy: Unauthorized Circumvention and Trafficking in Technology*, 20 SANTA CLARA COMPUTER & HIGH TECH. L.J. 411, 468 (2004) (“Copyright owners and information users disagree about the propriety of the conduct that enables information users to seize control over creative works in digital and analog form.”).

<sup>34</sup> Fisher, *supra* note 9, at 1678–82.



that in “cases decided prior to 1976 courts occasionally referred either to the decency of the defendant’s behavior or to its consistency with customary practices.”<sup>35</sup> Propriety of conduct played a decisive role in several major post-1976 cases as well. To take just one seminal case, in *Harper & Row*, Justice O’Connor wrote that “[a]lso relevant to the ‘character’ of the [challenged] use is ‘the propriety of the defendant’s conduct.’”<sup>36</sup>

Scholars have made several proposals designed to inject more “propriety” in copyright law. Professor Yen, for example, has suggested using propriety to avoid the “[b]ootstrap formalism [that] creates the danger of carelessly expanding copyright law to the detriment of the public interest.”<sup>37</sup> Another commentator suggested using propriety to avoid “hyperownership” of public domain works.<sup>38</sup> Professor Lunney referred to the “propriety of copyright *vel non*” in articulating “a clear distinction in copyright between competitor or commercial copying and end-user copying.”<sup>39</sup> In a different context, Professor Bell invoked the impropriety of allowing “copyright porn trolls” to claim their rights.<sup>40</sup> Last but not least, James Boyle used propriety to oppose the use of copyright to silence critics of the Church of Scientology.<sup>41</sup> These uses of propriety are normative. They differ from the use of the term propriety in improper appropriation cases. But as this Article argues below, this need not necessarily be so.<sup>42</sup> Although those general uses of propriety are often devoid of clear definitional boundaries, the Article suggests that they illustrate the normative potential that the notion, properly structured, can play.

### 3. *Application in Improper Appropriation Cases*

As the following pages explicate, there is a lack of uniformity across Circuits as

<sup>35</sup> *Id.* at 1678.

<sup>36</sup> *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562–63 (1985), citing 3 Nimmer § 13.05[A], at 13–72.

<sup>37</sup> Alfred C. Yen, *The Danger of Bootstrap Formalism in Copyright*, 5 J. INTELL. PROP. L. 453, 455 (1998).

<sup>38</sup> Charles Cronin, *Possession Is 99% of the Law: 3D Printing, Public Domain Cultural Artifacts and Copyright*, 17 MINN. J.L. SCI. & TECH. 709, 729 (2016).

<sup>39</sup> Glynn S. Lunney, Jr., *Copyright, Private Copying, and Discrete Public Goods*, 12 TUL. J. TECH. & INTELL. PROP. 1, 27 (2009).

<sup>40</sup> Bell, *supra* note 7, at 810.

<sup>41</sup> James Boyle, *A Politics of Intellectual Property: Environmentalism for the Net?*, 47 DUKE L.J. 87, 108 (1997).

<sup>42</sup> Recourse to propriety in copyright is not limited to the Judicial Branch. Two examples may be helpful. First, the CONTU report discussed the propriety of copyright protection in computer programs. See National Commission on New Technological Uses of Copyrighted Works (CONTU), *Final Report on the National Commission on New Technological Uses of Copyrighted Works*, 3 J. MARSHALL J. INFO. TECH. & PRIVACY L. 53, 53 (1981). See also Timothy K. Armstrong, *Symbols, Systems, and Software as Intellectual Property: Time for CONTU, Part II?*, 24 MICH. TELECOMM. & TECH. L. REV. 131, 143 (2018).

to exactly which test should be used to determine the existence of an *improper* appropriation in copyright infringement cases. Courts generally agree, however, that the question is best stated as one of fact and thus defer to the fact-finder on the propriety of the copying.<sup>43</sup> A noticeable effect of considering propriety as a purely factual matter is that it cannot be decided on summary judgment, thus crowding court dockets on matters that more appropriately call for a legal-normative determination that could be addressed at the summary judgment stage.<sup>44</sup> Moreover, most courts have held that the use of objective evidence and expert testimony are not admissible to assist in making this determination.<sup>45</sup> Treating propriety as merely factual, in this Article's view, gives short shrift to what could be a normatively portentous test, as explained in Part II.

Impropriety, as a central element of the Second Circuit's *Arnstein* test, is omnipresent in copyright infringement cases, including cases in which the Supreme Court denied certiorari petitions.<sup>46</sup> The *Arnstein* test calls for a two-part inquiry in determining whether the defendant infringed the plaintiff's copyright. The first step requires a determination of whether probative similarity with protected elements of the plaintiff's work is present.<sup>47</sup> The elements of the work that are protectable are the "constituent elements of the work that are original" because infringement can only happen in respect of protected works or parts of works.<sup>48</sup> Many courts use Judge Learned Hand's "abstraction test."<sup>49</sup> The "abstraction test" seeks to distill the plaintiff's work down to its expression and to identify the "levels of abstraction" (or distinct elements) that can be identified as expressions of the underlying idea.<sup>50</sup> These elements may include specific aspects of character or plot development, for example. A different way to complete this step is to use the "filtration approach," in which unprotectable elements are systematically filtered out.<sup>51</sup> Elements such as

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<sup>43</sup> See, e.g., *Arnstein v. Porter*, 154 F.2d 464, 469 (2d Cir. 1946).

<sup>44</sup> Shyamkrishna Balganes, *The Questionable Origins of the Copyright Infringement Analysis*, 68 STAN. L. REV. 791, 796 (2016).

<sup>45</sup> *Id.* at 795–96.

<sup>46</sup> See *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48 (2d Cir. 1986), *cert. denied*, 476 U.S. 1159 (1986) (quoting *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 977 (2d Cir. 1980), *cert. denied*, 449 U.S. 841 (1980)); *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 775 F. Supp. 544, 557–58 (E.D.N.Y. 1991), *aff'd in part, vacated in part*, 982 F.2d 693 (2d Cir. 1992).

<sup>47</sup> The expression was probably first coined by Professor Alan Latman. See generally Alan Latman, "Probative Similarity" as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement, 90 COLUM. L. REV. 1187 (1990).

<sup>48</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

<sup>49</sup> *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121–22 (2d Cir. 1930).

<sup>50</sup> *Id.*

<sup>51</sup> *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 707 (2d Cir. 1992).

*scènes à faire*, ideas and elements in the public domain, are removed for lack of copyright protection.<sup>52</sup> The “filtration approach” is often paired with the “abstraction test.”<sup>53</sup>

After separating expression from unprotectable elements, the court must look for evidence that the defendant actually copied from plaintiff’s work.<sup>54</sup> The defendant can only be found to have copied if she had access to the plaintiff’s work, a step that is functionally almost dispensed with if there is “a very high degree of similarity” between the plaintiff’s and the defendant’s work.<sup>55</sup> Analysis, dissection, and expert testimony are admissible in the probative similarity inquiry.<sup>56</sup> As this portion of the inquiry rarely benefits from direct evidence of copying by the defendant, it tends to rely on circumstances that justify an inference of copying.<sup>57</sup> This type of evidence might take the form of a defect (deliberate or not) in the plaintiff’s work that the defendant copied, such as a fake name on a map or a misplaced thumbnail on a doll.<sup>58</sup>

The second step is an examination of the “substantial similarity” of the two works. This step is conducted through the use of the lay (or ordinary) observer test. The court in *Harold Lloyd Corp. v. Witwer* described a lay observer test as an assessment of whether a reasonable, ordinary person could ascertain the effect of the allegedly infringing work on the public “without any aid or suggestion or critical analysis by others.”<sup>59</sup> As the Second Circuit later noted, “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them and regard their aesthetic appeals as the same.”<sup>60</sup> As part of this second step, the trier of fact must decide whether the appropriation was *improper*.<sup>61</sup> Under the test as traditionally applied, expert testimony may not be used, although a number of courts have reconsidered this exclusion.<sup>62</sup> For example, expert testimony has proven to be useful

<sup>52</sup> *Id.* at 710.

<sup>53</sup> See Aaron M. Broaddus, *Eliminating the Confusion: A Restatement of the Test for Copyright Infringement*, 5 DEPAUL-LCA J. ART & ENT. L. 43, 60–61 (1994).

<sup>54</sup> *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132, 137 (2d Cir. 1998).

<sup>55</sup> Access is deemed proven, absent evidence to the contrary, when the degree of similarity is very high. See 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[D] (rev. ed. 2018).

<sup>56</sup> *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

<sup>57</sup> See Jeanette Rene Busek, Comment, *Copyright Infringement: A Proposal for a New Standard for Substantial Similarity Based on the Degree of Possible Expressive Variation*, 45 UCLA L. REV. 1777, 1785–86 (1998).

<sup>58</sup> See *Hassenfeld Bros. v. Mego Corp.*, No. 66 Civil 2202, 1966 WL 7646, at \*786 (S.D.N.Y. 1966).

<sup>59</sup> *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1, 18 (2d Cir. 1933).

<sup>60</sup> *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

<sup>61</sup> *Arnstein*, 154 F.2d at 468.

<sup>62</sup> See Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 J.

to aid an “ordinary or lay observer” in understanding the complexities of software.<sup>63</sup>

Impropriety is rarely if ever invoked or defined *directly*. Instead, courts ask whether *actual copying* takes place and whether the plaintiff and the defendant’s work were *substantially similar* (with the copied expression). These two elements strike the Article as focusing essentially on the appropriation prong instead of the propriety of the defendant’s conduct. Put differently, in considering the application of propriety to infringement cases, the improper appropriation prong of the *Arnstein* test subsumed improper appropriation under the notion of actual copying, which left virtually no room for propriety to play a normative role.<sup>64</sup>

In contrast, in the Ninth Circuit, to determine “whether there is sufficient similarity between the two works in question to conclude that the alleged infringer used the copyrighted work in making his own,” expert testimony and visual comparison between the copyrighted work and the allegedly infringing work are frequently utilized.<sup>65</sup> After this “extrinsic” comparison, the Court turns to the overall, “intrinsic” similarity between the two works.<sup>66</sup> The purpose of this two-prong approach was “to restrict the scope of a plaintiff’s copyright from extending to (unprotectable) ideas.”<sup>67</sup> The Ninth Circuit uses a “total concept and feel” test.<sup>68</sup> It expressly targets the subjective quality of the work as perceived by its “intended audience.”<sup>69</sup> This test is more encompassing than the abstraction test in that it considers character and plot development, arrangement and choice of words, in addition to the general message or theme sought to be conveyed by the work.<sup>70</sup> Other relevant factors include the “type of artwork involved, the materials used, the subject matter, and the setting for the subject.”<sup>71</sup> This test can be easily applied to a variety of works (literary work, musical work, software, etc.).<sup>72</sup> It is not obvious for a lay jury to put themselves in the shoes of a theoretically defined “intended audience.”<sup>73</sup>

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COPYRIGHT SOC’Y. U.S.A. 719, 726–27 (2010).

<sup>63</sup> *Id.* at 733 (“[S]oftware cases diverge significantly from the ordinary two-step analysis. Virtually all the courts considering infringement of computer code have permitted expert testimony. . .”).

<sup>64</sup> *See* Y’Barbo, *supra* note 1, at 289.

<sup>65</sup> *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975).

<sup>66</sup> *See* Y’Barbo, *supra* note 1, at 293.

<sup>67</sup> *Id.* at 302.

<sup>68</sup> *See* Busek, *supra* note 57, at 1790.

<sup>69</sup> *Id.*

<sup>70</sup> *Id.*

<sup>71</sup> *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

<sup>72</sup> *See* Whelan Assocs. v. Jaslow Dental Lab., Inc., 797 F.2d 1222, 1232–33 (3d Cir. 1986).

<sup>73</sup> *See* Jamie Lund, *Fixing Music Copyright*, 79 BROOK. L. REV. 61, 74 (2013) (“[T]his act of substituting the jury’s judgment for that of a work’s intended audience can be problematic when the jury does not properly represent the constituencies that make up the particular work’s intended

The Second and Ninth Circuits differ substantially. To summarize, the Second Circuit test proceeds as follows: (1) proof of ownership of a valid copyright; (2) actual copying by the defendant, which includes access and probative similarity (both of which can be combined if there is a high degree of similarity); and (3) improper appropriation. By contrast, the “Ninth Circuit, albeit with some modification, adopted the *Arnstein* test and interpreted it to require the application of (1) an ‘extrinsic’ test aimed at determining whether there exists a substantial similarity in underlying ideas; and (2) an ‘intrinsic’ test to ascertain whether there exists a substantial similarity in the expression of the underlying idea.”<sup>74</sup> The first step, under the Ninth Circuit’s *Krofft* test, “is focused on a dissective analysis of similarities and differences in expression in the works at issue.”<sup>75</sup>

For our purposes, probably the most significant difference is that the Second Circuit test separates the copying determination (with possible input from experts) and the improper appropriation determination (usually without expert evidence).<sup>76</sup> Using the lay observer test at that stage means that uncopyrightable elements of the plaintiff’s work may be considered by the fact-finder, if only because they may be difficult to exclude in a side-by-side comparison.<sup>77</sup> A jury might also be tempted to follow an impulse that copying that appears as free-riding should be illegal, even though free-riding is not per se illegal.<sup>78</sup> Jury instructions are tricky in this area.<sup>79</sup> Put differently, it is not an easy task for a jury comparing two works side-by-side. While similarity between two works may be because both use similar ideas, *scènes à faire* and other unprotectable elements, it is difficult to resist anti-free-riding intuitions.<sup>80</sup> To quote Professor Samuelson, the risk is “that the trier of fact may conclude

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audience.”). See also Christopher Jon Sprigman & Samantha Fink Hedrick, *Copyright’s Filtration Problem*, 23 LEWIS & CLARK L. REV. 571 (2019).

<sup>74</sup> *Broderbund Software, Inc. v. Unison World, Inc.*, 648 F. Supp. 1127, 1136 (N.D. Cal. 1986).

<sup>75</sup> Pamela Samuelson, *A Fresh Look at Tests for Nonliteral Copyright Infringement*, 107 NW. U. L. REV. 1821, 1830 (2013).

<sup>76</sup> See Y’Barbo, *supra* note 1, at 296.

<sup>77</sup> *Id.*

<sup>78</sup> See Shyamkrishna Balganeshe et al., *Judging Similarity*, 100 IOWA L. REV. 267, 288 (2014) (“[T]he law could embrace the reality that moral intuitions relating to labor and free-riding directly influence the assessment of similarity, which in turn serves as a simple proxy for wrongfulness.”).

<sup>79</sup> See Zahr K. Said, *A Transactional Theory of the Reader in Copyright Law*, 102 IOWA L. REV. 605, 639 (2017) (“Jury instructions in copyright cases often fail in terms of being comprehensible to jurors, being feasible for jurors, and being fully accurate with respect to copyright law.”).

<sup>80</sup> This may be analogized to the determination of non-obviousness in patent infringement cases. Because after seeing the invention it is likely to seem obvious, courts have devised devices to avoid cognitive biases. See Emer Simic, *The TSM Test Is Dead! Long Live the TSM Test! The Aftermath of KSR, What Was All the Fuss About?*, 37 AIPLA Q.J. 227, 231 (2009) (“The Supreme

that second-step copying has occurred as a spillover from a finding of first-step copying,” because unprotected elements are relevant to the first part of the inquiry but not the second.<sup>81</sup> A test such as “total concept and feel” in Ninth Circuit jurisprudence arguably calls for a holistic yet potentially imprudent test that risks blending into the analysis unprotectable elements, and is therefore unlikely to ameliorate outcomes.<sup>82</sup>

Ostensibly, both the Second Circuit and Ninth Circuit are concerned about overprotection.<sup>83</sup> In *Castle Rock*, for example, the Second Circuit underscored the requirement that copying be “qualitatively and quantitatively sufficient” to be actionable.<sup>84</sup> If overprotection concerns are to be truly a part of the equation, then finding ways to filter unprotectable elements correctly and address free-riding fuzziness in “factual” determinations of copying is essential.

Interestingly, some courts have abandoned, or at least transformed, the bifurcated test of substantial similarity in cases involving computer programs, using instead an integrated substantial similarity test under which both lay and expert testimony are admissible.<sup>85</sup>

Many scholars have argued that a hybrid of the tests by the Second and Ninth Circuits, possibly based on the application of the idea-expression distinction, should be developed.<sup>86</sup> Others have opted for one over the other. Professor Nimmer, for instance, has argued that the “total concept” test was “ill-advised in the extreme.”<sup>87</sup> The Article suggests a revised test in Part II.

## II. A GREATER ROLE FOR PROPRIETY IN COPYRIGHT LAW

### A. *Propriety Is Not “Purely Factual”*

This Article suggests that propriety should inform copyright infringement anal-

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Court’s objective [*Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966)] factors are instructive not only because they provide judges with a way to analyze technical issues, but also because they attempt to guard against the inevitable problem of hindsight bias in obviousness determinations.”). Such formal analytical devices are almost non-existent in copyright law.

<sup>81</sup> Samuelson, *supra* note 75, at 1826.

<sup>82</sup> *See id.* at 1830–32 (explaining the risks of using a total concept and feel test).

<sup>83</sup> *See* Claudia Hong, Comment, *New Yorkers Have Got It Right: A Call for a Uniform Standard to Copyright Infringement Analysis*, 27 LOY. L.A. ENT. L. REV. 33, 49 (2006).

<sup>84</sup> *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132,138 (2d Cir.1998).

<sup>85</sup> *See* *Whelan Assocs. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1233–35 (3d Cir. 1986); *Broderbund Software, Inc. v. Unison World, Inc.*, 648 F. Supp. 1127, 1136 (N.D. Cal. 1986).

<sup>86</sup> *See* Broadus, *supra* note 53, at 44; Hong, *supra* note 83, at 34. *See also* Balganes, *supra* note 44, at 859.

<sup>87</sup> 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[A][1][c] (rev. ed. 2018).

yses. This proposal uses the *Arnstein* test but actually reflects the words used to describe the test. Recognizing the normative role of impropriety might make propriety of copying a mixed question of fact and law which, as the Ninth Circuit said in *Smith v. Commissioner*, requires “the consideration of legal concepts and . . . the exercise of judgment about the values underlying legal principles.”<sup>88</sup> Exactly.<sup>89</sup>

The task of defining a propriety-based standard can be approached in a variety of ways, for example, by considering the actions or intent of the agent or by focusing instead on the consequences of the action. Adam Smith’s guidance is a useful starting point. Smith carefully explicated how propriety is not a synonym of virtue, but rather one of its components.<sup>90</sup> Copyright law does not require that defendants in a copyright case be virtuous. Instead, we should ask, if we are to apply a normative propriety-based test, whether the defendant’s behavior was proper. Simply put, some appropriations are proper and thus permissible; others are not. In the latter case, a defendant may then invoke fair use or another exception or defense.

Professor Balganesch proposed changing the improper appropriation test to “cognizable similarity,” which would “operate as a mixed question of law and fact.”<sup>91</sup> Interestingly, Professor Balganesch suggested that judges should:

[D]ecide the issue by reference to copyright’s underlying goals and purposes, by asking whether the type/form of copying is likely to affect the market for the work, or indeed whether it involved freeriding on the creator’s authorial contribution to the work, rendering it questionable as a moral matter. Having grappled with this question, the judge would then apply the criteria to the specific work.<sup>92</sup>

This Article agrees with the underlying suggestion, namely that by referring to the purpose and goal of copyright, the analysis is likely to yield more normatively balanced results. Indeed, Professor Balganesch’s masterful dissection of Judge Jerome Frank’s opinion in *Arnstein* shows how it sent improper appropriation to normative oubliettes by entrusting it exclusively to fact-finders.<sup>93</sup> The Article certainly agrees with suggestions, such as Professor Balganesch’s, that the *Arnstein* test can be ameliorated.<sup>94</sup>

Having demonstrated the perils of the *Arnstein* test, at least two quite different

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<sup>88</sup> *Smith v. Comm’r*, 300 F.3d 1023, 1028 (9th Cir. 2002).

<sup>89</sup> As noted below, this change would allow cases to be decided on summary judgment. See *infra* note 2 and accompanying text. The article’s proposal could also be used to present juries with more normative instructions concerning the permissibility of the defendant’s conduct. This would not be unprecedented. See *supra* note 29 and *infra* note 102 and accompanying text.

<sup>90</sup> See SMITH, *supra* note 13, at 23.

<sup>91</sup> Balganesch, *supra* note 44, at 859.

<sup>92</sup> *Id.*

<sup>93</sup> *Id.* at 855.

<sup>94</sup> See *id.*; Samuelson, *supra* note 75, at 1843–44.

remedial approaches are possible. The first is simply to abandon the test. The second is to reinvigorate it. This Article takes the view that the test should be retained but that propriety—construed according to its usual meaning and defined based on applicable customs, practices, and ethical norms—should actually be considered an integral part of the test.

As an example of how this might work, one commentator suggested distinguishing cases where the plaintiff's work contains a narrow range of protectable elements from those where the work contains a wide range.<sup>95</sup> In the former case, virtual identity would be required to constitute improper appropriation.<sup>96</sup> Arguably this is the approach used by the Ninth Circuit in the *Skyy Spirits* case, as there was a very narrow range of protectable expression in the photograph of the blue bottle.<sup>97</sup> Indeed, there is a whole line of cases supporting the proposition that virtual identity is required when copyright protection is thin, meaning that the scope of potentially infringing conduct is narrower or, on the flip side of the doctrinal coin, appropriation is more likely to be proper and thus permissible.<sup>98</sup>

#### *B. Teleological Arguments in Support of the Application of (Im)propriety*

There is a legal-philosophical disconnect in the *Arnstein* test. (Im)propriety is treated as a matter of fact devoid of normative content in current copyright infringement jurisprudence.<sup>99</sup> Yet, semantically at least, propriety *demand*s a normative approach. This Article thus wholeheartedly agrees with Professor Balganesh's assessment that "improper appropriation is indelibly a normative judgment."<sup>100</sup> Rather than splitting cases according to a yardstick such as the amount of protectable expression or range of options available to the defendant, this Article argues that the *Arnstein* test should be forged anew by a normative blacksmith—rather than a purely

<sup>95</sup> Hong, *supra* note 83, at 53–56.

<sup>96</sup> *Id.*

<sup>97</sup> *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 766 (9th Cir. 2003) (finding that similarity between different marketing photographs of Skyy vodka bottles was inevitable due to shared concept, and that subtle differences in lighting, angles, shadows, etc., defeated photographer's infringement claims).

<sup>98</sup> *Mattel, Inc. v. MGA Entm't, Inc.*, 616 F.3d 904, 913–14 (9th Cir. 2010) ("If there's a wide range of expression . . . then copyright protection is 'broad' and a work will infringe if it's 'substantially similar' to the copyrighted work. If there's only a narrow range of expression . . . , then copyright protection is 'thin' and a work must be 'virtually identical' to infringe.") (citation omitted); *TransWestern Publ'g Co. LP v. Multimedia Mktg. Assocs.*, 133 F.3d. 773, 776 (10th Cir. 1998) ("[M]ore similarity is required when less protect[a]ble matter is at issue. Thus, if substantial similarity is the normal measure required to demonstrate infringement, 'supersubstantial' similarity must pertain when dealing with 'thin' works.") (quoting 4 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 13.03[A][4] (rev. ed. 2018)).

<sup>99</sup> See Lemley, *supra* note 62.

<sup>100</sup> Balganesh, *supra* note 44, at 807.



factual carpenter—so that it can play a stronger role in infringement analyses.<sup>101</sup>

What we need to debate is not whether propriety is part of the test (it is: *Arnstain* is good law until courts jettison it), but rather the work that the notion of propriety should perform in the test. In a nutshell, the suggestion—which seems far from outrageous—is that, if a defendant’s appropriation must be *improper to constitute infringement*, its opposite, propriety, should be an integral part of the infringement analysis.

Propriety, defined according to custom and practice, and applicable ethical norms, can function, to that extent, as the notion of “public” in the public performance right. Asking whether a performance is public is distinct from deciding whether a performance took place.<sup>102</sup> Interestingly, the publicness of the performance is a mixed question of fact and law—which can, therefore, be decided on summary judgment.<sup>103</sup> Similarly, asking whether copying took place is a different inquiry than asking whether the appropriation was *improper*. It could be dealt with in the same way as a determination of publicness. Impropriety strikes this Article as at least as defensible as a mixed question of fact and law as publicness.

This Article suggests judging the propriety or impropriety of a defendant’s appropriation teleologically. The question to ask is not so much the purpose of the defendant’s use, but rather whether the appropriation fits the purpose of copyright law to encourage new expression—which, in constitutional terms, arguably promotes the Progress of Science and Useful Arts.<sup>104</sup> Consider for instance a case against Jeff Koons in which the plaintiff argued that a collage created by Mr. Koons using preexisting photographs he found in fashion magazines and advertisements was copyright infringement.<sup>105</sup> The Second Circuit noted that “copyright law’s goal of ‘promoting the Progress of Science and useful Arts’ would be better served by allowing Koons’s use of ‘Silk Sandals’ than by preventing it.”<sup>106</sup>

<sup>101</sup> This would best be done if it was considered a mixed question of fact and law, although fact-finders can make factual-normative determinations. See *supra* note 29 and accompanying text.

<sup>102</sup> Only public performances, as defined in 17 U.S.C. § 101, are subject to the exclusive right contained in 17 U.S.C. § 106(4). The test for infringement was expressed as follows in *Jobete Music Co., Inc. v. Johnson Commc’ns, Inc.*, 285 F. Supp. 2d 1077, 1082 (S.D. Ohio 2003): “[t]o establish a claim for copyright infringement . . . by means of public performance, a claimant must prove: (1) the originality and authorship of a composition; (2) a valid copyright under the formalities of the [1976] Copyright Act; (3) claimant’s ownership of the copyright at issue; (4) *defendant’s public performance of the composition*; and (5) defendant’s failure to obtain permission from the claimant for such performance.” (emphasis added). For a discussion, see Adam Barrett Townshend, *Crashing by Design: Toward a Uniform Standard for Public Place Analysis Under Federal Copyright Law*, 79 NOTRE DAME L. REV. 2045, 2053 (2004).

<sup>103</sup> See, e.g., *Columbia Pictures Indus., Inc. v. Aveco, Inc.*, 800 F.2d 59, 60 (3d Cir. 1986).

<sup>104</sup> U.S. CONST. art. 1, § 8, cl. 8.

<sup>105</sup> *Blanch v. Koons*, 467 F.3d 244, 246–47 (2d Cir. 2006).

<sup>106</sup> *Id.* at 259 (citation omitted). The other case was *Rogers v. Koons*, 960 F.2d 301 (2d Cir.

In *Feist*, the Supreme Court found that encouraging original expression (containing a modicum of creativity resulting from an author's creative choices) was necessary to benefit from copyright protection.<sup>107</sup> In *Sony*, the Supreme Court described copyright's purpose as follows:

The sole interest of the United States and the primary object in conferring the [copyright] monopoly lie in the general benefits derived by the public from the labors of the authors. It is said that reward to the author or artist serves to induce release to the public of the products of his creative genius.<sup>108</sup>

A renewed emphasis on propriety would turn the analytical spotlight on the defendant's conduct and measure such conduct by the yardstick of the constitutional direction. In other words, propriety demands normativity, and the propriety (and thus permissibility) of an appropriation should be gauged against the purpose of copyright law, and the alignment, or lack thereof, between that purpose and the defendant's use. This Article agrees, therefore, with Professor Balganesch's suggestion that "as a principled normative matter—driven by copyright's utilitarian and constitutional goals—there may be little reason to treat all aspects of the infringement analysis as purely factual questions for a lay jury."<sup>109</sup>

Professor Fishman has argued that propriety could also play a role as a vehicle by which courts consider the *process* by which a defendant has copied, rather than deciding only on end-product comparison.<sup>110</sup> Some courts have considered, for example, the effort made by the defendant.<sup>111</sup>

Suggesting that propriety should play a more significant role is not a proposition entirely devoid of precedential support. As courts have stated, including the Supreme Court in *Harper & Row*, propriety can play a decisive role in copyright doctrine.<sup>112</sup> In cases other than those applying some version of the *Arnstein* test, such as those dealing with fair use, the notion of propriety is normative. In the infringement test, in contrast, normativity seems to have evaporated, though maybe not entirely. There are traces of the emergence of a normative, propriety-based approach in *Ford Motor Co. v. Summit Motor Prods., Inc.*, a case in which the Third

1992), *cert. denied*, 506 U.S. 934 (1992).

<sup>107</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991). For a discussion, see generally Edward C. Walterscheid, *To Promote the Progress of Science and Useful Arts: The Anatomy of a Congressional Power*, 43 IDEA: J. L. & TECH. 1 (2003).

<sup>108</sup> *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (internal quotation marks omitted) (quoting *United States v. Paramount Pictures*, 334 U.S. 131, 158 (1948)).

<sup>109</sup> Balganesch, *supra* note 44, at 800.

<sup>110</sup> See Joseph P. Fishman, *The Copy Process*, 91 N.Y.U. L. REV. 855, 873 (2016) ("Judges, too, sometimes subtly invoke the defendant's process when ostensibly assessing the propriety of the defendant's product, despite process's black-letter irrelevance.").

<sup>111</sup> *Id.* at 877–78.

<sup>112</sup> *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985).

Circuit considered that among the several factors that should be considered when determining if an improper appropriation occurred were “creativity and independent effort” by the defendant.<sup>113</sup>

However, this is not essential to this Article’s suggestion that judging the propriety of defendants’ conduct in light of applicable practices, custom, and ethical norms could be seen as “[m]ixed questions of law and fact that require the consideration of legal concepts and involve the exercise of judgment about the values underlying legal principles.”<sup>114</sup> Such a change would imply that determinations could be made at the summary judgment stage, although the fact-finder could also be required to factor in applicable norms and customs.<sup>115</sup> It would also imply possible *de novo* review on appeal, which could lead to much clearer lines being drawn by the caselaw to delineate areas of permissible conduct.

### C. Normative Strands of a New Test

The Second and Ninth Circuits agree on several features of the copyright infringement test. Both Circuits should pay heed to the Supreme Court’s direction that unprotectable elements must be filtered out in some way, and both Circuits aim to do so.<sup>116</sup> They also agree that the defendant must have had access to the plaintiff’s work, although in some cases evidence of access will be entirely circumstantial, such as presuming access in cases of striking similarity (which should always be subject to counter-evidence, especially in cases where the work contains few creative choices and where similarity could reasonably derive from a limited universe of possible choices).<sup>117</sup> As noted in Part I, however, the tests differ in their analysis of substantial similarity and the role that the propriety of the defendant’s conduct should play.

When considering propriety in the infringement analysis, there is a distinction between a commercially consumptive use, on the one hand, and a bona fide creative reuse, on the other hand. It is well established that commerciality is not a bar to a finding of transformative fair use, but it weighs heavily against a finding of fair use in a case involving a consumptive use.<sup>118</sup> An unauthorized consumptive use by a defendant can be considered *prima facie* improper.<sup>119</sup>

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<sup>113</sup> *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 291 (3d Cir. 1991) (quoting *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 908 (3d Cir. 1975)).

<sup>114</sup> *Mayors v. Comm’r of Internal Revenue*, 785 F.2d 757, 759 (9th Cir. 1986). *See also* *Smith v. Comm’r*, 300 F.3d 1023, 1028 (9th Cir. 2002).

<sup>115</sup> *See Universal Athletic Sales Co.*, 511 F.2d at 907; *supra* note 29 and accompanying text.

<sup>116</sup> *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

<sup>117</sup> *See supra* note 55.

<sup>118</sup> *See Blanch v. Koons*, 467 F.3d 244, 254 (2d Cir. 2006).

<sup>119</sup> Professor Fishman’s intuition that a link between trade secret law and copyright law can produce productive outcomes seems warranted (*see* Fishman, *supra* note 110, at 856). For

In *Blanch v. Koons*, the Second Circuit found that Jeff Koons' use of preexisting fashion photographs was a fair use.<sup>120</sup> In doing so, it clearly separated significantly transformative reuse from the mere "untransformed duplication," such as a photocopy.<sup>121</sup> This seems fully consistent with the Supreme Court's opinion in *Campbell*, in which it wrote that when "the second use is transformative, market substitution is at least less certain, and market harm may not be so readily inferred."<sup>122</sup> This notion is arguably present in cases dealing with appropriation art but works as a subterranean, normative element.<sup>123</sup> It clearly infuses findings of fair use in appropriation art cases.<sup>124</sup> This Article suggests bringing it fully into the sunlight of the infringement analysis.<sup>125</sup>

Commercially consumptive use of a work (that is, copying for consumption with commercial intent) should normally infringe as improper appropriation—subject to a possible fair use defense. Bona fide creative uses, on the other hand, prima facie fulfill the constitutional direction. *Creative reuses may well be "proper."* In other words, every author can, and many authors do, reuse preexisting material. A quote should not have to rely on fair use, nor should we try to pretend it somehow does not matter by labeling it *de minimis*. A quotation is not always *de minimis*, yet a quotation is usually *proper*.<sup>126</sup> Indeed the quotation right is the only exception formulated in mandatory terms in the Berne Convention—which, as of this writing, applies to 176 countries, including the United States.<sup>127</sup> Simply put, quotation is

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example, in determining whether a misappropriation of a trade secret took place, courts often look at the propriety of the conduct. See RESTATEMENT OF TORTS § 757(a)–(b) (AM. LAW INST. 1939). The interplay between copyright law and trade secret law was discussed, e.g., in *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 775 F. Supp. 544, 564 (E.D.N.Y. 1991), *aff'd in part, vacated in part*, 982 F.2d 693 (2d Cir. 1992).

<sup>120</sup> *Blanch*, 467 F.3d at 246.

<sup>121</sup> *Id.* at 254. This is what distinguishes *Blanch* from *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913 (2d Cir. 1994).

<sup>122</sup> *Campbell v. Acuff–Rose Music, Inc.*, 510 U.S. 569, 591 (1994).

<sup>123</sup> Many thanks to Zahr Said for suggesting this term.

<sup>124</sup> See *Blanch*, 467 F.3d at 253.

<sup>125</sup> This aligns with Joe Fishman's suggestion to make the copy process an explicit element of the infringement analysis. Fishman, *supra* note 110, at 861 ("Copyright doctrine could be both more descriptively transparent and more normatively attractive by expressly looking beyond the face of a copy and asking how it got there.")

<sup>126</sup> *De minimis* is a quantitative test essentially; while propriety is a broader analysis that can take into account quantity, quality, and purpose.

<sup>127</sup> Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, as last revised July 24, 1971, 828 U.N.T.S. 221, art. 10 ("It shall be permissible to make quotations from a work which has already been lawfully made available to the public . . .") (emphasis added). The United States joined the Convention with effect from March 1, 1989. See Berne Convention Implementation Act of 1988, H.R. Res. No. 609, 100th Cong., 2d Sess., at 40 (1988).

not (just) fair use; it is not (just) transformative; it is proper.<sup>128</sup>

This might explain why Victor Hugo, perhaps best known as the author of *Les Misérables* but also a father of Continental authors' rights and of the Berne Convention, wrote that the right of writers must yield to that of "human spirit."<sup>129</sup> The term spirit (*esprit* in French) is quite common in French copyright (authors' rights) law, as a work of authorship is referred to in that system as *une œuvre de l'esprit* (a work of the spirit).<sup>130</sup> It is thus incongruous to treat quotation and other forms of creative reuse as *prima facie* infringement (and thus dependent on the fair use defense), for a premise of that conclusion is that copyright *prima facie should interfere with a creative process it is meant to support*. Bona fide creative reuse (by quotation or otherwise) illustrates a case where the normativity implied by the notion of propriety might be called upon to play a role and offers a window to the potential of a normative infringement test based on propriety.

As noted above, propriety can be measured according to custom, practices, and ethics.<sup>131</sup> A court not only could but, in this Article's suggestion, *should* use propriety as a doctrinal vehicle to consider how custom, practice, or ethics might render a use proper. Ethics may be relevant if the parties to the case are members of the same epistemic community and that community has recognized ethical standards. Custom and practice may be shown to exist in the defendant's field of endeavor by allowing expert evidence.<sup>132</sup> Therefore, the Article proposes that appropriation (copying) be assessed as a mixed question of law and fact with a normative consideration of its (im)propriety based on customs, practices, and applicable ethical rules—which, as noted above, in this context may be derived from "popular morality."<sup>133</sup>

<sup>128</sup> A United States government response submitted to the World Trade Organization described quotation as the "classic" example of fair use. See Council for TRIPS, Review of Legislation on Copyright and Related Rights—Replies to Questions Posed to the United States by Brazil, the European Communities and Their Member States, Australia and Korea, Oct. 30, 1996, WTO Doc. IP/Q/USA/1, at 4. For more on the role of transformativeness, see, e.g., R. Anthony Reese, *Transformativeness and the Derivative Work Right*, 31 COLUM. J.L. & ARTS 467, 468 (2008) (noting that the "'transformative' nature of the defendant's use has thus become a major part of fair use analysis . . .").

<sup>129</sup> See DANIEL J. GERVAIS, (RE)STRUCTURING COPYRIGHT: A COMPREHENSIVE PATH TO INTERNATIONAL COPYRIGHT REFORM, REV'D ED. 34 (2019).

<sup>130</sup> See, e.g., *Les Grands Principes du Droit d'Auteur*, BIBLIOTHEQUE NATIONALE DE FRANCE, [http://www.bnf.fr/fr/professionnels/principes\\_droit\\_auteur.html](http://www.bnf.fr/fr/professionnels/principes_droit_auteur.html).

<sup>131</sup> See *supra* Part I.

<sup>132</sup> See *Evidence—Expert Testimony—Sixth Circuit Holds That Expert Testimony Is Not Needed to Establish A Standard of Care in Surrogacy Cases.—Stiver v. Parker*, 975 F.2d 261 (6th Cir. 1992), 106 HARV. L. REV. 951, 954 (1993) ("[C]ourts usually establish the appropriate standard of care through expert evidence about the custom and practice applicable to the professional conduct in question.").

<sup>133</sup> See Fisher, *supra* note 9, at 1681.

The next section uses appropriation art to illustrate how the suggested reinvigoration of propriety in copyright infringement cases might be applied.

#### D. Application

Recent empirical research suggests that authors are not (in the aggregate) particularly good at maximizing welfare and efficiency and that the ability to reuse (whether because it is licensed, fair use, etc.) pre-existing content is not very closely tied to copyright constraints but rather to a host of other factors.<sup>134</sup> The normative implications are relatively clear: should one stop generations of younger creators who were “born digital” and see no good reason not to use digital tools to create, even if it includes some measure of appropriation? When does that appropriation cross the propriety line?<sup>135</sup> The line has probably been crossed when there is sufficient proximity between the works, especially where much of the primary work’s creative choices have been appropriated and little has been added. This analysis should be informed by the fact that copyright has always tried to avoid judgment on the quality or artistic merit of new forms of creation, and the fact that the appropriation of the past is a necessary ingredient of an intergenerational dialogue, which might take several new and possibly irreverent forms.<sup>136</sup> At the very least, judges should be aware of any underlying bias.<sup>137</sup> Originality is what is added by the artists, both as a contribution to the work’s inherent structure (what one might call aesthetic originality), but often also, especially for new art forms, as a posture of the artist vis-à-vis her creative milieu.<sup>138</sup> Moreover, copyright is precisely meant to create incentives to produce original works.<sup>139</sup> If we mean it when we say that we want to foster the emergence of new expression, proper appropriation should be encouraged, and not seen as *prima facie* infringement subject to a case-by-case fair use determination.<sup>140</sup>

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<sup>134</sup> See Stefan Bechtold et al., *Innovation Heuristics: Experiments on Sequential Creativity in Intellectual Property*, 91 IND. L.J. 1251, 1253 (2016).

<sup>135</sup> On that distinction, see Daniel Gervais, *The Tangled Web of UGC: Making Copyright Sense of User-Generated Content*, 11 VAND. J. ENT. & TECH. L. 841, 850–55 (2009).

<sup>136</sup> The exclusion of artistic merit in copyright policy is well established at least theoretically in most legal systems. In the United States, Justice Holmes’s made the point famously in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). Courts however often fail to properly exclude artistic merit from consideration. See Amy B. Cohen, *Copyright Law and the Myth of Objectivity: The Idea-Expression Dichotomy and the Inevitability of Artistic Value Judgments*, 66 INDIANA L. J. 175, 231 (1990).

<sup>137</sup> See Christine Haight Farley, *Judging Art*, 79 TUL. L. REV. 805, 845–46 (2005).

<sup>138</sup> Catherine Kintzler, *La Copie et l’Original*, DÉMÉTER 1, 8 (Dec. 2003), [demeter.revue.univ-lille3.fr/copiel/kintzler.pdf](http://demeter.revue.univ-lille3.fr/copiel/kintzler.pdf).

<sup>139</sup> Diane Leenheer Zimmerman, *Copyrights as Incentives: Did We Just Imagine That?*, 12 THEORETICAL INQUIRIES L. 29, 30 (2011).

<sup>140</sup> See Kintzler, *supra* note 138, at 8. In some cases, transgression might, in an ironic twist,

## CONCLUSION

The Article reviewed the notion of propriety, which forms an integral part of the main copyright infringement test derived from the Second Circuit 1946's opinion in *Arnstein v. Porter*. The notion of propriety has been stripped of any obvious moral and normative meaning. Yet propriety plays a significant role in other areas of copyright law and indeed, in many other areas of law. This Article argues that propriety should be reinvigorated as a normative notion focused on the defendant's conduct, measured with appropriate custom and practice, and ethical norms, as yardsticks.