

No. 21-

IN THE
Supreme Court of the United States

JOHANNSONGS-PUBLISHING, LTD,

Petitioner,

v.

PEERMUSIC LTD., UNIVERSAL-POLYGRAM
INTERNATIONAL PUBLISHING, INC.,
UMG RECORDINGS, INC. AND WARNER
BROS. RECORDS INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

In a copyright infringement case, when deciding whether two musical works are substantially similar, should the courts apply the ordinary observer test as is the rule in the Second Circuit, or should the courts apply the two-part extrinsic/intrinsic test as is the rule in the Ninth Circuit?

PARTIES TO PROCEEDING

Petitioners:

Petitioner Johannsongs-Publishing, Ltd (hereinafter “Johannsongs”) is a California Corporation. Petitioner has no parent corporation and there is no publicly held company owning 10% or more of Petitioner’s stock.

Respondents

Respondents are: Peermusic Ltd., Universal-Polygram International Publishing, Inc., UMG Recordings, Inc., and Warner Bros. Records Inc. Neither of the named defendants Rolf Lovland nor Brendan Graham have appeared below. Apple, Inc. and Spotify Technology S.A. were dismissed without prejudice pursuant to F.R.Civ.P. 41(a).

CORPORATE DISCLOSURE STATEMENT

Petitioner Johannsongs-Publishing, Ltd has no parent corporation and there is no publicly held company owning 10% or more of Petitioner's stock.

RELATED CASES

- Johannsongs-Publishing, Ltd. v. Rolf Lovland, et. al., No. 2:18-cv-10009-AB-SS, U.S. District Court for the Central District of California. Judgment entered April 20, 2020.
- Johannsongs-Publishing, Ltd. v. Rolf Lovland, et. al., No. 20-55552/55759, U.S. Court of Appeals for the Ninth Circuit. Judgment entered November 29, 2021.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit in this case.

OPINIONS BELOW

The November 29, 2021, decision of the Ninth Circuit Court of Appeals (App., *infra*, pages 1a-5a) is unreported and can be found at 2021 U.S. App. LEXIS 35135 * | 2021 U.S.P.Q.2D (BNA) 1167 | 2021 WL 5564626

The April 3, 2020, order of the District Court (App., *infra* pages 6a-23a) granting Respondents' motion for summary judgment also is unreported and can be found at 2020 U.S. Dist. LEXIS 82464 and 2020 WL 2315805.

JURISDICTION

The judgement of the Ninth Court of Appeals was entered on November 29, 2021. The jurisdiction of this court is invoked pursuant to 28 U.S.C. § 1254(1).

CONSTITUTIONAL PROVISIONS, TREATIES, STATUTES, ORDINANCES AND REGULATIONS INVOLVED IN THIS CASE

The Copyright and Patent Clause of the Constitution, Art. I, § 8, cl. 8, provides [The Congress shall have power] 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.

17 USCS § 102 provides:

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described,

explained, illustrated, or embodied in such work.

STATEMENT OF THE CASE

This case concerns the most famous and best-selling song in Iceland ever, *Soknudur*¹, which was copied by the Norwegian defendant Rolf Lovland who had access to the song in his native Norway, and in Iceland where he came to record two albums in the mid 1990's and at the Eurovision Song Contest in Zagreb, in 1990. Rolf Lovland's derivative version of *Soknudur* was entitled, *You Raise Me Up* ("Raise"). *You Raise Me Up* was first released in 2001 by Rolf Lovland's band Secret Garden. A couple of years later, Josh Groban recorded his version of *You Raise Me Up* and had an international smash hit. Both songs still get constant airplay, although *Soknudur* is primarily played in Iceland², and *You Raise Me Up* is played throughout the world and is one of the most often performed songs of all time.

After hearing *You Raise Me Up*, Johann Helgason, the composer of the music to *Soknudur*, contacted the Icelandic Performing Rights Society, STEF. They had two musicologists analyze the two songs and found that 97% of *You Raise Me Up*'s melodic material is related to *Soknudur*.

1. The Icelandic spelling of *Soknudur* is *Söknuður*.

2. *Soknudur* was voted Iceland's favorite song, and it is so well known in Iceland, that when Josh Groban performed *You Raise Me Up* in concert in Iceland, the audience sang along with the words to *Soknudur*.

STEF then wrote to TONO, the Norwegian Performing Rights Society of which Rolf Lovland is a member. TONO did its own analysis and replied that any similarity found between the two songs in question relate back to *Londonderry Air* or *Danny Boy*³. Thereafter, the issue became framed whether *Soknudur* was substantially similar to *You Raise Me Up* after taking *Danny Boy* into consideration.

The dispute moved to California after Petitioner Johannsongs, the assignee of Johann Helgason's rights to the music, filed a lawsuit against Respondents in accordance with both *28 U.S.C. § 1331* and *28 U.S.C. § 1338(a)*.

Unlike *Williams v. Gaye* 895 F.3d 1106 (2018) and *Skidmore v. Zeppelin* 952 F.3d 1051 (9th Cir. 2020) where the deposit copy of the work accompanying the registration was sheet music, here the deposit copy submitted to the Copyright Office is a mp3 copy of the original sound recording of *Soknudur*.

Respondents filed a motion for summary judgment claiming *Soknudur* and *You Raise Me Up* were not substantially similar and that any similarity was found in *Danny Boy*. Each side provided expert reports prepared by well known musicologists. Petitioner's musicologist was Judith Finell, the musicologist for the Gaye Family in *Williams v. Gaye*, *supra*. Respondents' musicologist was

3. *Londonderry Air* is an Irish folk tune first published in 1855 and was set to lyrics in 1913 in the well-known Irish song *Danny Boy*. Accordingly, in the record below, the parties and the Court sometimes have used the names interchangeably. (App., *infra* page 7a fn3.)

Lawrence Ferrara. The District Court judge referred to them as the dueling experts. (App., *infra* page 21a.)

Defendants' expert, Lawrence Ferrara created sheet music of the mp3 sound recording of *Soknudur*, and compared this derivative work of the deposit copy to sheet music of *You Raise Me Up* and sheet music of *Danny Boy*, matched up and counted the notes he decided to concentrate on – while ignoring others - and concluded *Soknudur* was not substantially similar to *You Raise Me Up* and that any similarities between the two were found in the prior art.

Judith Finell's expert report explained that when comparing two pieces of music, one must distinguish between the important notes and the unimportant notes. Using the song *Happy Birthday* as an example, she explained that an ordinary listener hearing a jazzed-up version of *Happy Birthday* would still recognize the song to be *Happy Birthday*, even if there are extra notes inserted or if the duration of some notes were prolonged. Her expert report pointed out that the practice of strictly counting notes and their relative positions, without listening as an ordinary observer, would lead to improper results and false conclusions. She pointed out that the Ferrara report "uses rigidly narrow criteria in comparing "Soknudur" with "Raise," yet adopts vastly more flexible criteria in comparing prior art to the two works at issue. This contradiction misleads the reader and results in false and unreliable conclusions." Additionally, she noted significant differences in prior art are omitted from the Ferrara report. She concluded that no prior art identified in the Ferrara report is as similar as *Soknudur* and *Raise* are to one another.

Unfortunately, the Judge refused to consider the commonsense of Ms. Finell’s expert reports and struck her expert reports. Following the Ninth Circuit’s two-part extrinsic/intrinsic test for substantial similarity, the District Court concluded that Ms. Finell failed to satisfactorily filter out the prior art, stating she failed to “filter out prior art from *Soknudur* and *Raise* before comparing them. (App., *infra* page 19a.) The Judge only considered Lawrence Ferrara’s report, which led to summary judgement for Respondents. If, however, the District Court Judge had applied the Ordinary Observer Test of the Second Circuit instead of the two-part extrinsic/intrinsic test, he would not have discarded Judith Finell’s expert report, and the results would have been different. At oral argument the Judge noted,

At first blush, this is, you know, your classic case of the dueling experts, which at first blush, one might think, all right. You’ve got dueling experts, classic triable issues of fact.

Had the District Court Judge followed the Second Circuit’s test, summary judgment would have been denied, and the case would have gone before a jury. On appeal, the Ninth Circuit summed up the matter succinctly, effectively inviting Petitioner to file this petition seeking a writ of certiorari.

Johannsongs argues that the panel should depart from the Ninth Circuit’s two-part extrinsic/intrinsic test for substantial similarity and instead apply the Second Circuit’s “ordinary observer” test. Compare *Corbello v. Valli*, 974 F.3d 965, 974 (9th Cir. 2020), *cert. denied*, 141

S. Ct. 2856, 210 L. Ed. 2d 963 (2021), *with Andy Warhol Found. for Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 53 (2d Cir. 2021). The panel has no occasion to consider such an argument because the two-part extrinsic/intrinsic test is circuit precedent and the panel may only depart from such precedent “if a subsequent Supreme Court opinion ‘undercut[s] the theory or reasoning underlying the prior circuit precedent in such a way that the cases are clearly irreconcilable.’” *In re Nichols*, 10 F.4th 956, 961 (9th Cir. 2021) (alteration in original) (quoting *Miller v. Gammie*, 335 F.3d 889, 900 (9th Cir. 2003) (*en banc*)). No such opinion exists here. (App., pages 3a-4a.)

REASONS FOR GRANTING WRIT

Invariably federal court opinions involving claims of copyright infringement cite *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) for the proposition that to establish a claim for copyright infringement, a plaintiff must prove: “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”

Typically, the plaintiff has a copyright registration, and the analysis shifts to whether there was copying. “The copying element of the infringement analysis contains two separate components: “copying” and “unlawful appropriation.” *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1116-17 (9th Cir. 2018) (citing *Feist*, 499 U.S.

at 361). “To prove copying⁴, “the similarities between the two works need not be extensive, and they need not involve protected elements of the plaintiff’s work. They just need to be similarities one would not expect to arise if the two works had been created independently.” *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 140. To prove unlawful appropriation, on the other hand, the similarities between the two works must be “substantial” and they must involve protected elements of the plaintiff’s work. *Laureyssens*, 964 F.2d at 140.

Applying the proper test for substantial similarity is the confusing part of the copyright analysis and has long caused problems for jurists and parties. Adding to the confusion has been the notion by some courts that the exact same test for substantial similarity ought to be applied to all copyright materials, whether it’s a phone book, computer code, a sculpture, a film, a play, a novel, or a song. One panel of the Sixth Circuit decided that the test for a sound recording should be different than the test for musical compositions. “The analysis that is appropriate for determining infringement of a musical composition copyright, is not the analysis that is to be applied to determine infringement of a sound recording. *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 798 (6th Cir. 2005)

Similarly, this Court’s opinion in *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183 suggests that perhaps the test for substantial similarity need not necessarily be the

4. Copying was not at issue. The parties had agreed to hold in abeyance the issue of access and copying pending the district court’s resolution of the substantial similarity issue.

same for each type of work of authorship specified in 17 USCS § 102.

Generically speaking, computer programs differ from books, films, and many other “literary works” in that such programs almost always serve functional purposes. These and other differences have led at least some judges to complain that “applying copyright law to computer programs is like assembling a jigsaw puzzle whose pieces do not quite fit.” *Lotus Development Corp. v. Borland Int’l, Inc.*, 49 F.3d 807, 820 (CA1 1995) (Boudin, J., concurring). *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1198.

But besides the occasional instance where one appellate court realizes it is not necessary or logically required to have the same test for substantial similarity apply to each work of authorship specified in 17 USCS § 102, most courts follow either the Second Circuit’s Ordinary Observer Test or the Ninth Circuit’s two-part extrinsic/intrinsic test.

The District Court below, explained the extrinsic test deployed:

“[U]sing analytic dissection, and, if necessary, expert testimony, the court must determine whether any of the allegedly similar features are protected by copyright.” (citing *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994). (App., page 12a.)

In contrast, the Second Circuit writes, “It is commonplace that in comparing works for infringement purposes -- whether we employ the traditional “ordinary observer” test or the . . . “more discerning” inquiry -- we examine the works’ “total concept and feel.” *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003 (2nd Cir. 1995).

The *Knitwaves* court rejected the notion that they were required to dissect the designs into their separate components and compare only those elements which are in themselves copyrightable, commenting, “if we took this argument to its logical conclusion, we might have to decide that “there can be no originality in a painting because all colors of paint have been used somewhere in the past.” *Id.*

Judge Canby, in *Swisky v. Carey*, 376 F.3d 841, 848 (9th Cir. 2004) criticized the extrinsic test as follows, before reluctantly applying it:

The application of the extrinsic test, which assesses substantial similarity of ideas and expression, to musical compositions is a somewhat unnatural task, guided by relatively little precedent. Music is an art form that “produces sounds and expresses moods,” Debra Presti Brent, *The Successful Musical Copyright Infringement Suit: The Impossible Dream*, 7 U. Miami Ent. & Sports. L. Rev. 229, 244 (1990), but it does not necessarily communicate separately identifiable ideas. *The extrinsic test provides an awkward framework to apply to copyrighted works like music or art objects, which lack distinct elements of idea and expression.* Nevertheless, the test is our law and we must apply it.”

Other notable legal authorities have similarly criticized the extrinsic test. In *Metcalf v. Bochco*, 294 F.3d 1069, 1071, Judge Kozinski began his opinion with the preface, “We delve once again into the turbid waters of the ‘extrinsic test’ for substantial similarity under the Copyright Act.” *Metcalf*, 294 F.3d at 1071.

And Professor Nimmer, in *Nimmer on Copyright* describes the extrinsic test/intrinsic test dichotomy as, “The most elaborate metaphysics.” 4 *Nimmer on Copyright* §13.03 (2021)

Despite the criticisms, the extrinsic/intrinsic test became entrenched in the Ninth Circuit and other circuits have followed. Meanwhile, the Second Circuit continues to proceed differently, explicitly disavowing the Ninth Circuit’s explicit/intrinsic test’s requirement of analytical dissection.

“No matter which test we apply, however, we have disavowed any notion that ‘we are required to dissect [the works] into their separate components, and compare only those elements which are in themselves copyrightable.’” *Knitwaves, supra* at 1003; see *Boisson v. Banian, Ltd*, 273 F.3d 262, 272-73 (2d Cir. 2001). Instead, we are principally guided “by comparing the contested design’s ‘total concept and overall feel’ with that of the allegedly infringed work,” *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 133 (2d Cir. 2003); see *Boisson*, 273 F.3d at 272; *Knitwaves Inc.*, 71 F.3d at 1003, as instructed by our “good eyes and common sense,” *Hamil Am.*, 193 F.3d at 102 (alteration omitted).” *Griffin v. Sheeran*, 351 F.Supp.3d 492, 498-499 (S.D. N.Y. 2019)

As the leading copyright law treatise states:

“Although it is clear that the determination of substantial similarity presents an issue of fact, the correct procedure for that determination remains clouded. For over a century, the courts in general have purported to apply what is called the ordinary observer or audience test. . . . Yet, the authority for the audience test emanates exclusively from the inferior courts, and may not be in harmony with the views of the nation’s highest tribunal. Accordingly, this discussion must be placed into a type of mental “suspense account.” It must inevitably be taken into account, and may indeed prove dispositive. But until the Supreme Court validates or negates the audience test, the copyright bar will be left in suspense as to its ultimate validity. 4 Nimmer on Copyright §13.03 (2021)

This case that is now before this Court presents a perfect opportunity for the Court to set out once and for all what is the proper test for determining substantial similarity with regards to musical works, and perhaps with regards to other copyright works too.

A. There Is A Circuit Conflict And The Courts Seek Guidance.

The test for substantial similarity depends upon where a court is situated. Some circuits follow the Second Circuit’s practice, some follow the Ninth Circuit’s practice, while some circuits are inconsistent. Still, some follow a hybrid model.

1. The Ninth Circuit extrinsic test invites dissection of works of authorship.

As discussed already, the Ninth Circuit utilizes the two-part extrinsic/intrinsic test regardless of the category of Work of Authorship listed in 17 USCS § 102. As a result, the Ninth Circuit uses analytic dissection for all Works of Authorship. *Corbello* supra at 974. “The extrinsic test often requires analytical dissection of a work and expert testimony” *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 2000), a music case citing *Apple Computer, Inc v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994) a case about computers.

“Because only those elements of a work that are protectable and used without the author’s permission can be compared when it comes to the ultimate question of illicit copying, we use *analytic dissection* to determine the scope of copyright protection before works are considered ‘as a whole.’” *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442-1443 (9th Cir. 1994)

2. The Second Circuit on the other hand disavows any notion that dissection is required.

The Second Circuit’s test for substantial similarity is set forth below.

“[T]wo works are substantially similar when ‘an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.’” *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 53 (2nd Cir. 2021), quoting *Knitwaves, Inc.*

v. Lollytogs, Ltd., 71 F.3d 996, 1003 (2d Cir. 1995), quoting *Malden Mills, Inc. v. Regency Mills, Inc.*, 626 F.2d 1112, 1113 (2d Cir. 1980)”

“The standard test for substantial similarity between two items is whether an ‘ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard [the] aesthetic appeal as the same.’” *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 111 (2d Cir. 2001) (quoting *Hamil Am. Inc. v. GFI*, 193 F.3d 92, 100 (2d Cir. 1999)). In applying the so-called “ordinary observer test,” we ask whether “an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.” *Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F.3d 996, 1002 (2d Cir. 1995) (*internal quotation marks omitted*). On occasion, though, we have noted that when faced with works “that have both protectible and unprotectible elements,” our analysis must be “more discerning,” *Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp.*, 25 F.3d 119, 123 (2d Cir. 1994), and that we instead “must attempt to extract the unprotectible elements from our consideration and ask whether the protectible elements, standing alone, are substantially similar,” *Knitwaves, Inc.*, 71 F.3d at 1002 (*emphasis omitted*). No matter which test we apply, however, we have disavowed any notion that “we are required to dissect [the works] into their separate components, and compare only those elements which are in themselves copyrightable.” *Id.* at 1003; *see*

Boisson v. Banian, Ltd., 273 F.3d 262, 272–73 (2d Cir. 2001). Instead, we are principally guided “by comparing the contested design’s ‘total concept and overall feel’ with that of the allegedly infringed work,” *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 133 (2d Cir. 2003); see *Boisson*, 273 F.3d at 272; *Knitwaves Inc.*, 71 F.3d at 1003, as instructed by our “good eyes and common sense,” *Hamil Am.*, 193 F.3d at 102 (alteration omitted).

3. Circuits that follow the Second Circuit

(a) The Third Circuit

The Third Circuit follows the ordinary observer test of the Second Circuit. “On substantial similarity, the question is how the works “would appear to a layman viewing [them] side by side,” *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 908 (3d Cir. 1975), and we have rejected the usefulness of experts in answering this question, *id.* at 907. *Tanksley v. Daniels*, 902 F.3d 165, 172.

(b) The Fifth Circuit

Likewise, the Fifth Circuit follows the ordinary observer test, stating that when determining whether “substantial similarity” exists between the copyrighted work and the allegedly infringing work, “[a] side-by-side comparison must be made between the original and the copy to determine whether a layman would view the two works as ‘substantially similar.’” *Bridgmon v. Array Sys. Corp.*, 325 F.3d 572, 576-577 (5th Cir. 2003).

(c) The Seventh Circuit

The Seventh Circuit also agrees. The leading Seventh Circuit case on this issue is *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607 (7th Cir. 1982) where the Court stated, “Specifically, the test is whether the accused work is so similar to the plaintiff’s work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff’s protectible expression by taking material of substance and value. (*Citations omitted.*) *Id* at 614.

The Atari Court quoted the Second Circuit in saying:

Judge Learned Hand, in finding infringement, once stated that “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.” *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960). It has been said that this test does not involve “analytic dissection and expert testimony,” *Arnstein*, 154 F.2d at 468, but depends on whether the accused work has captured the “total concept and feel” of the copyrighted work, *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970). *Id.*

A more recent Seventh Circuit case commented on the difficulty of the subject of substantial similarity. “It seems somehow fitting that the *Atari* case, involving the insatiable little yellow circle PAC-MAN, is a leading case guiding us through the maze of copyright law as applied

to video games.” *Incredible Techs., Inc. v. Virtual Techs., Inc.*, 400 F.3d 1007, 1011 (7th Cir. 2005)

4. Circuits that follow the Ninth Circuit

(a) The Fourth Circuit.

Like the Ninth Circuit, the Fourth Circuit applies a two-part extrinsic/intrinsic test. *Copeland v. Bieber*, 789 F.3d 484, 489 (4th Cir. 2015). There, the Court noted of the extrinsic test, “And because it is focused only on the original elements of the copyrighted work, a court examining extrinsic similarity must first engage in a process we sometimes call “analytic dissection,” separating out those parts of the work that are original and protected from those that are not. *Id.* (citations omitted.)

(b) The Eighth Circuit

The Eighth Circuit follows the two-part extrinsic/intrinsic test also.

“Substantial similarity incorporates two concepts. First, there must be similarity of ideas, which must be “evaluated extrinsically, focusing on [the] objective similarities . . . of the works.” . . . Second, if the ideas are similar, they must be similarly expressed, meaning that an “ordinary, reasonable person” would think that “the total concept and feel of the [designs] in question are substantially similar.” (citations omitted) *Designworks Homes, Inc. v. Thomson Sailors Homes, L.L.C.*, 9 F.4th 961, 963 (8th Cir. 2021)

5. Other Circuits

(a) The First Circuit

The First Circuit has used the Ordinary Observer test in the past. “Whether two works are substantially similar is determined by the “ordinary observer” test. (Internal citations omitted). The test is whether the accused work is so similar to the plaintiff’s work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff’s protectible expression by taking material of substance and value.” *Segrets, Inc. v. Gillman Knitwear Co.*, 207 F.3d 56, 62 (1st Cir. 2000)

More recently however, the First Circuit has changed its tune and now says, “This assessment, of course, must be informed by the dissection analysis. *Harney v. Sony Pictures TV, Inc.*, 704 F.3d 173, 179 (1st Cir 2013)

“The court initially “dissect[s]” the earlier work to “separat[e] its original expressive elements from its unprotected content.” The two works must then be compared holistically to determine if they are “substantially similar,” but giving weight only to the protected aspects of the plaintiff’s work as determined through the dissection.” (citations omitted) *Id.*

(b) The Sixth Circuit

In *Kohus v. Mariol*, 328 F.3d 848, 854-855 (6th Cir. 2003), the Sixth Circuit adopted a two-part test that allows expert evidence and dissection, and the second part requires the trier of fact to evaluate similarity based

on whether the ordinary reasonable person would fail to differentiate between the two works being compared.

One panel of this Circuit strayed from this test, creating a unique test for sound recordings. *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792, 798 (6th Cir. 2005). (See page 8 *supra*.)

(c) The Tenth Circuit.

The Tenth Circuit case law appears to be in a state of flux. Its abstraction-filtration-comparison test traces back to *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280 (10th Cir.1996) which used an “abstraction-filtration-comparison test.” At the abstraction step, the court separates the unprotectable ideas from the particular expression of the work. Then the next step is to filter out the nonprotectable components of the product from the original expression. Lastly the court compares the remaining protected elements to the accused work to determine if the two works are substantially similar using the “ordinary observer test. *Id* at 1284-1285, 1288.

However according to a later case in the 10th Circuit, “not every case requires extensive analysis,” and the appropriate test “may vary depending upon the claims involved, the procedural posture of the suit, and the nature of the works at issue.” *Blehm v. Jacobs*, 702 F.3d 1193, 1220 (10th Circuit 2012). The *Blehm* court noted that although it did not use the abstraction-filtration comparison analysis, its goal is the same: “separating unprotectable ideas from protectable expression. . . and comparing the remaining protectable expression” to the accused work to determine whether they are substantially similar. *Id*.

In the relatively recent case of *Craft Smith, LLC v. EC Design, LLC*, 969 F.3d 1092 (10th Cir. 2020) there was no mention of this test. Instead, the Court stated, “Substantial similarity exists when ‘the accused work is so similar to the plaintiff’s work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff’s [protectable] expression by taking material of substance and value.’” *Id* at 1104. (citation omitted).

(d) The Eleventh Circuit

In the Eleventh Circuit, the test for substantial similarity seems to depend on the panel of judges. Eleventh Circuit case law appears to support both the ordinary observer test and the two-part extrinsic/intrinsic test. For example, in *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1266 (11th Cir 2001) the Court wrote, “In order to prove copying, SunTrust was required to show a “substantial similarity” between the two works such that “an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.”

Also in *Leigh v. Warner Bros.*, 212 F.3d 1210, 1214 (11th Cir 2000) the Court states, “Substantial similarity, in this sense, “exists where an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.” (internal quotation omitted).

Yet, in contrast to the above two cases adopting the ordinary observer test, in *Herzog v. Castle Rock Entertainment*, 193 F.3d 1241, 1257 (11th Cir. 1999) the Eleventh Circuit backed the two-part extrinsic/intrinsic test.

To establish substantial similarity, a plaintiff must satisfy a two-pronged test: an extrinsic, or objective test and an intrinsic or subjective test. *Herzog v. Castle Rock Entertainment*, 193 F.3d 1241, 1257. (11th Cir. 1999)

(e) The D.C. Circuit

In *Atkins v. Fischer*, 331 F.3d 988, 993-994 (DC Cir. 2003), one panel of the D.C. Circuit explained the process of determining substantial similarity approvingly quoting the Second Circuit and Judge Learned Hand in the process.

The question is whether “an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.” *Hamil America, Inc. v. GFI*, 193 F.3d 92, 100 (2d Cir. 1999). Judge Learned Hand previously described the test as whether the ordinary observer, “unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.” *Id.* (quotation omitted). When determining similarity, courts are to look at the “total concept and feel” of the designs. *Id.* at 102. When comparing the designs, it is not sufficient to dissect separate components and dissimilarities. The original way that the author “selected, coordinated, and arranged the elements” of her work is the focus of the court. *Id.* at 103. Although all derivative works have differences from the original, it is the similarities, rather than the differences,

that inform whether the “total concept and feel” of the works and their “aesthetic appeal” is the same. *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1004 (2d Cir. 1995).

Please note however, a year earlier, a different panel previously approved of “filtering out” separate components of the plaintiff’s design it viewed as unprotectible ideas. *Sturdza v. U.A.E.*, 281 F.3d 1287, 1297 (D.C. Cir. 2002)

Overall, there seems to be a bit of a free-for-all in the courts -- both for stating the test of substantial similarity and in applying the test to the facts. Petitioner believes the test need not be the same for all types of works. For instance, the test for finding substantial similarity for literary works and audiovisual works need not be the same for musical works.

B. The Decision Below is Incorrect. The Rationale For Applying The Two-Part Extrinsic/Intrinsic Test To Musical Works Is Logically Flawed.

There does not appear to be a rationale for applying the two-part extrinsic/intrinsic test to musical works. It seems the 9th Circuit and the circuits that follow have simply taken a test judicially created in the context of whether a McDonald’s commercial infringed the copyright of H.R. Pufnstuf’s children’s television show,⁵ and assumed they should follow the same procedure with respect to a musical composition, even though they are different types of original works of authorship, set out in the Copyright

5. *Sid & Marty Krofft TV Prods. v. McDonald’s Corp.*, 562 F.2d 1157 (9th Cir. 1977)

Act in different categories. One is covered by category (a)(6) for audiovisual works and the other is covered by category (a)(2) for musical works. 17 USCS § 102. The statute does not say the legal analysis as to each copyright category must be the same. Indeed, to the contrary, by creating separate categories for different works of authorship, it suggests it might be prudent to analyze each category differently just like one might analyze a camera differently from a trombone.

When it comes to musical works, the common practice of listening to the sound recording deposit copy and turning that into sheet music and doing the same with the relevant songs, and then analyzing the sheet music – a derivative work—seems apt to lead to error and confusion. This is not to say that this can never be helpful or illustrative; but for any analysis of two songs to involve so much dissection removes the soul from the music. Two people may look virtually alike but their personalities may differ remarkably. So too it is with music. The sheet music of two songs may share certain similarities but yet there still may remain an essence – a spirit- or a soul in one song that does not carry over to the other song with similar sheet music. Simply put music must be heard and listened to in order to be judged.

Unlike a phone directory that would have thousands and perhaps even millions of names, addresses and phone numbers, or a computer program with thousands of lines of code, music only has seven notes. The seven notes can be accented with sharps and flats and are assembled together in various permutations with various time distances between the notes, and various lines of music played on top of one another. It makes no more sense to

attempt to dissect the musical notes of two songs and compare them on paper than it would be to dissect the organs of two deceased people and decide if they were alike or substantially similar. The analysis the Ninth Circuit applies to musical works, in short, ignores the soul.

The test for Substantial Similarity of Musical works set out in category (a)(2) of the Copyright Act should be the Ordinary Observer Test as described by the Second Circuit.

It's vital that the trier of fact listen to the musical works in question and compare what is heard as opposed to comparing sheet music and counting up the notes. In the case below the deposit copy was a mp3 file of the first published recording of *Soknudur*. Respondents' expert created derivative works, i.e. sheet music, of *Soknudur* and compared the derivative work to sheet music of *You Raise Me Up* and *Londonderry Air*.

Also, respondents' expert created recordings of himself playing excerpts of "Sokndur" on the piano, and compared his own recording of himself playing excerpts of both *You Raise Me Up* and *Londonderry Air* on the piano. So, in effect, respondents' argument below was:

Here's how I play *Soknudur*,

Here's how I play *You Raise Me Up*

Since I play them differently, therefore, they are not substantially similar.

Contrarily, here's how I play *You Raise Me Up*, and

Here's how I play *Londonderry Air*,

Since I play these two the same, therefore, they
are substantially similar.

If one applies this process to sculptures it further illustrates how illogical the extrinsic test can become for certain types of copyrighted works. Imagine if you will a plaintiff suing a defendant for copying his original sculpture and the defense expert makes drawings of the two sculptures from which he renders an analysis of whether the two drawings are substantially similar. This is the case here. The trier of fact needs to compare the original works of art and not derivative sketches or sheet music or derivative recordings of an expert playing a piano.

Introducing derivative works to the analysis confuses the matter. The district court judge was led astray by a method that compared identical notes only, like a robot scanning sheet music. This method of comparing similarity between melodies ignores the commonplace knowledge that some notes in a melody are more important than others, some much more.

In music, some notes, literally touch a nerve and can cause one to shed a tear. A robotic analysis cannot replace the touch and feel test that should be used with music.

If Petitioner had brought its copyright infringement case in New York City, instead of Los Angeles, the result on summary judgment would have been different.

C. For Musical Works and Art Objects the Second Circuit's Ordinary Observer Test is the Best Approach.

As Judge Canby wrote in *Swirsky*,

“The extrinsic test provides an awkward framework to apply to copyrighted works like music or art objects, which lack distinct elements of idea and expression. . . . Music, like software programs and art objects, is not capable of ready classification into only five or six constituent elements; music is comprised of a large array of elements, some combination of which is protectable by copyright. *Swirsky* supra at 848.

Naturally then, it seems to follow that musical works should have a different test for substantial similarity than the *Kfrofft* two-part extrinsic/intrinsic test. For musical works, it makes most sense to apply the ordinary observer test and for courts to be “guided by comparing the ‘total concept and overall feel’ of the musical works in question. There is no logical reason why there should be a one-size fits all test for each category of copyright. This is even more so when the test has so many weaknesses.

One prominent copyright authority, William F. Patry, comments as follows on the *Kfrofft* two-part extrinsic/intrinsic test.

Regrettably, not only does *Krofft* provide a poor foundation, the obvious weaknesses in it have led the court of appeals to erect Rube

Goldberg—like work arounds, so that in the end one is left with a final structure that looks like an Escher drawing—one ascends a staircase but somehow ends up at a lower level than where one began. There is no solution other than destroying the foundation and the entire structure erected on it and starting over again from scratch.

Krofft's errors began with a rigid bifurcated test with formidable but meaningless names: "extrinsic" and "intrinsic." 3 Patry on Copyright § 9:235 | September 2021

D. The Question Presented Is Important.

The issue of how to determine substantial similarity between a copyrighted work and an accused work comes up in almost all copyright cases once a plaintiff's case progresses beyond the basics of establishing a valid copyright and establishing copying. In 2020 there were 3,443 copyright cases filed in the district courts, and in 2021 the number was higher – 3,483 copyright cases filed.⁶ Yet, the concept of substantial similarity—a sine qua non of every copyright infringement determination—remains one of the most elusive in copyright law.

Part of the difficulty results from a lack of uniformity in judicial language addressing the subject. More confusion arises from the lack of a single substantial similarity test

6. Figures courtesy of <https://www.uscourts.gov/statistics/table/c-2/statistical-tables-federal-judiciary/2021/06/30>

employed throughout the circuits. Added difficulty results from physical differences in copyrightable subject matter; materials as diverse as plays, music, computer programs, and literary characters cannot be compared in exactly the same way.” *Robert C. Osterberg & Eric C. Osterberg, Substantial Similarity In Copyright Law, at Preface (2021)*

Most copyright cases involving musical works will involve an entertainment conglomerate with offices in both New York and California, and perhaps even in Tennessee. With jurisdiction assured in these locales and without a uniform nationwide test for substantial similarity for musical works, plaintiffs will be tempted to analyze the case law for substantial similarity in the various circuits and file suit in a district court within the circuit where the law suits their case best.

E. This Case Is An Ideal Vehicle

Here the district court granted summary judgment after finding that Petitioner’s expert did not filter out the prior art as required by the Ninth Circuit’s two-part extrinsic/intrinsic test after inquiring of the parties twice at oral argument why should this case simply not come down to a battle of dueling experts. If the district court judge had applied the Second Circuit’s Ordinary Observer test summary judgment would have been denied, and the case would have been set up for a jury trial. The facts in this case present an ideal vehicle for this Court to resolve this age-old problem and set a national standard for determining substantial similarity with respect to musical works if not other types of art too, such as sculptures

and paintings. It presents issues of not just determining when two musical works are substantially similar, but also determining substantial similarity in the context of prior art that bears similarities to both musical works.

CONCLUSION

Johannsongs-Publishing respectfully submits that these considerations justify this Court's granting of the petition for a Writ of Certiorari.

Dated this 25th day of February, 2022.

Respectfully submitted,

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APPENDIX

1a

**APPENDIX A — MEMORANDUM OF THE
UNITED STATES COURT OF APPEALS FOR THE
NINTH CIRCUIT, FILED NOVEMBER 29, 2021**

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

No. 20-55552

JOHANNSONGS-PUBLISHING, LTD.,

Plaintiff-Appellant,

v.

ROLF LOVLAND; *et al.*,

Defendants-Appellees.

No. 20-55759

JOHANNSONGS-PUBLISHING, LTD.,

Plaintiff-Appellee,

v.

PEERMUSIC LTD.,

Defendant-Appellant,

UMG RECORDINGS, INC.,

Defendant-Appellant,

2a

Appendix A

WARNER RECORDS INC., INCORRECTLY SUED
AS WARNER MUSIC GROUP,

Defendant-Appellant,

POLYGRAM PUBLISHING, INC., SUCCESSOR
TO UNIVERSAL-POLYGRAM INTERNATIONAL
PUBLISHING, INC. AND INCORRECTLY SUED AS
UNIVERSAL MUSIC PUBLISHING GROUP,

Defendant-Appellant,

and

ROLF LOVLAND,

Defendant,

BRENDAN GRAHAM; APPLE INC.,

Defendants,

DOES, 1-20,

Defendant,

SPOTIFY TECHNOLOGY S.A.,

Defendant.

Appendix A

Appeal from the United States District Court for the
Central District of California. D.C. No. 2:18-cv-10009-
AB-SS. Andre Birotte, Jr., District Judge, Presiding.

November 16, 2021, Argued and Submitted,
Pasadena, California
November 29, 2021, Filed

MEMORANDUM*

Before: BYBEE and BENNETT, Circuit Judges, and
BATAILLON,** District Judge.

Johannsongs-Publishing, Ltd. holds the copyright to the musical composition of the 1977 Icelandic song *Söknuður*. It alleges that *You Raise Me Up*, a song composed by Rolf Løvland in 2001 and popularized by Josh Groban in 2003, infringes on its copyright. The district court granted Defendants’ motion for summary judgment and denied Defendants’ motion for attorney’s fees under 17 U.S.C. § 505. The parties cross-appealed. We affirm.

1. Johannsongs argues that the panel should depart from the Ninth Circuit’s two-part extrinsic/intrinsic test for substantial similarity and instead apply the Second Circuit’s “ordinary observer” test. *Compare Corbello v. Valli*, 974 F.3d 965, 974 (9th Cir. 2020), *cert. denied*, 141

* This disposition is not appropriate for publication and is not precedent except as provided by Ninth Circuit Rule 36-3.

** The Honorable Joseph F. Bataillon, United States District Judge for the District of Nebraska, sitting by designation.

Appendix A

S. Ct. 2856, 210 L. Ed. 2d 963 (2021), *with Andy Warhol Found. for Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 53 (2d Cir. 2021). The panel has no occasion to consider such an argument because the two-part extrinsic/intrinsic test is circuit precedent and the panel may only depart from such precedent “if a subsequent Supreme Court opinion ‘undercut[s] the theory or reasoning underlying the prior circuit precedent in such a way that the cases are clearly irreconcilable.’” *In re Nichols*, 10 F.4th 956, 961 (9th Cir. 2021) (alteration in original) (quoting *Miller v. Gammie*, 335 F.3d 889, 900 (9th Cir. 2003) (en banc)). No such opinion exists here.

2. The district court granted summary judgment after refusing to admit the reports of Johannsongs’ expert, Judith Finell, and admitting the reports of Defendants’ expert, Dr. Lawrence Ferrara. The district court concluded that Ferrara’s analysis was “effectively, un rebutted” and held that *Söknuður* and *You Raise Me Up* are not substantially similar. We hold that the district court did not abuse its discretion in excluding Finell’s expert reports because they failed to filter out similarities that are attributable to prior art, as required under the extrinsic test. *See Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1174-80 (9th Cir. 2003), *overruled on other grounds by Skidmore v. Led Zeppelin*, 952 F.3d 1051 (9th Cir. 2020) (en banc). Furthermore, the district court did not abuse its discretion in admitting Ferrara’s reports because the court’s findings—that Ferrara applied reliable principles and methods, he appropriately filtered out prior art, and his conclusions are well supported by evidence—are supported by the record. *Cf. Swirsky v. Carey*, 376 F.3d 841, 846-47 (9th Cir. 2004).

Appendix A

Considering *de novo* the evidence before the district court, we hold that the district court did not err in granting summary judgment. Johannsongs failed to offer admissible evidence to rebut Ferrara's analysis, so there is no genuine dispute of material fact as to his conclusions that *Söknuður* and *You Raise Me Up* are not substantially similar and most of their similarities are attributable to prior art. Based on these conclusions, Johannsongs has failed to satisfy the extrinsic test and Defendants are entitled to judgment as a matter of law. *See Newton v. Diamond*, 388 F.3d 1189, 1196 (9th Cir. 2004).

3. We also hold that the district court's findings that Johannsongs' claim was not frivolous nor objectively unreasonable are supported by the record. *See Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 815 (9th Cir. 2003); *cf. Shame On You Prods., Inc. v. Banks*, 893 F.3d 661, 666 (9th Cir. 2018). Accordingly, the district court did not abuse its discretion in denying attorney's fees to Defendants. 17 U.S.C. § 505.

AFFIRMED. Each side to bear its own costs.

**APPENDIX B — ORDER OF THE UNITED
STATES DISTRICT COURT FOR THE CENTRAL
DISTRICT OF CALIFORNIA, FILED APRIL 3, 2020**

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

Case No. CV 18-10009-AB (SSx)

JOHANNSONGS-PUBLISHING LTD.,

Plaintiff,

v.

ROLF LOVLAND, *et al.*,

Defendants.

April 3, 2020, Decided

April 3, 2020, Filed

**ORDER *GRANTING* DEFENDANTS' MOTION FOR
SUMMARY JUDGMENT [DKT. NO. 28]**

Before the Court is a Motion for Summary Judgment (“Motion,” Dkt. No. 28) filed by Defendants Peermusic, Ltd., Universal-Polygram International Publishing, Inc. (“Universal-Polygram”) (incorrectly sued as Universal Music Publishing Group), UMG Recordings, Inc., and Warner Bros. Records Inc. (incorrectly sued as Warner Music Group) (collectively, “Defendants”). Plaintiff Johannsongs-Publishing Ltd. (“Plaintiff”) filed an opposition and Defendants filed a reply. The Court

Appendix B

heard oral argument on December 6, 2020, and took the matter under submission. Thereafter, Defendants filed a Notice of Supplemental Authority (Dkt. No. 50), which Plaintiff asked the Court to strike (Dkt. No. 51), to which Defendants filed a reply (Dkt. No. 53). The Court finds that Defendants appropriately filed Dkt. No. 50 and therefore declines to strike it. The Motion for Summary Judgment is **GRANTED**.

I. BACKGROUND

Plaintiff alleges that it owns all rights to the 1977 musical composition *Soknodur*, except for the lyrics. Compl. ¶¶ 14, 90. Plaintiff alleges that the song *You Raise Me Up* (“*Raise*”), written by defendants Rolf Lovland and Brendan Graham¹, and released in 2001 by Secret Garden and in 2003 by Josh Groban, infringes on *Soknodur*. See Compl. ¶¶ 1-4, 14.² The moving Defendants are corporations involved in publishing and/or selling *Raise*. *Id.* ¶¶ 29-32. They seek summary judgment on the ground that the elements that are supposedly similar between *Raise* and *Soknodur*—the melody and lyrical themes—are not actually sufficiently similar to support a finding of copyright infringement, and the similarities that do exist are derivative of the Irish folk tune *Londonderry Air*, aka *Danny Boy*³, which is in the public domain, and several of other prior art songs.

1. Neither Lovland nor Graham have appeared.

2. Plaintiff also alleged a claim for unjust enrichment but stipulated to its dismissal.

3. According to the parties, *Londonderry Air* is an Irish folk tune first published in 1855, and was set to lyrics in 1913 in the well-

*Appendix B***II. LEGAL STANDARD****A. Summary Judgment**

A motion for summary judgment must be granted when “the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(e); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986). The moving party bears the initial burden of identifying the elements of the claim or defense and evidence that it believes demonstrates the absence of an issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986).

Where the nonmoving party will have the burden of proof at trial, the movant can prevail merely by pointing out that there is an absence of evidence to support the nonmoving party’s case. *Id.* The nonmoving party then “must set forth specific facts showing that there is a genuine issue for trial.” *Anderson*, 477 U.S. at 248.

“Where the record taken as a whole could not lead a rational trier of fact to find for the nonmoving party, there is no ‘genuine issue for trial.’” *Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 587, 106 S. Ct. 1348, 89 L. Ed. 2d 538 (1986). The Court must draw

known Irish song *Danny Boy*. See Statement of Undisputed Facts (“SUF,” Dkt. No. 44) 51. The parties and the Court sometimes use the names interchangeably.

Appendix B

all reasonable inferences in the nonmoving party's favor. *In re Oracle Corp. Sec. Litig.*, 627 F.3d 376, 387 (9th Cir. 2010) (citing *Anderson*, 477 U.S. at 255).

Nevertheless, inferences are not drawn out of thin air, and it is the nonmoving party's obligation to produce a factual predicate from which the inference may be drawn. *Richards v. Nielsen Freight Lines*, 602 F. Supp. 1224, 1244-45 (E.D. Cal. 1985), *aff'd*, 810 F.2d 898 (9th Cir. 1987). "[M]ere disagreement or the bald assertion that a genuine issue of material fact exists" does not preclude summary judgment. *Harper v. Wallingford*, 877 F.2d 728, 731 (9th Cir. 1989).

B. Legal Framework for Copyright Infringement**1. The Two Primary Elements of a Copyright Infringement Claim: Ownership and Copying**

To establish a claim for copyright infringement, a plaintiff must prove: "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991); *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481 (9th Cir. 2000). Here, Defendants do not challenge the first element, that Plaintiff owns a valid copyright in *Soknudor*. Rather, Defendants challenge the second element, contending there is no triable issue as to copying.

*Appendix B***2. Copying Consists of Copying and Unlawful Appropriation**

The copying element of the infringement analysis contains two separate components: “copying” and “unlawful appropriation.” *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1116-17 (9th Cir. 2018) (citing *Feist*, 499 U.S. at 361). “Although these requirements are too often referred to in shorthand lingo as the need to prove ‘substantial similarity,’ they are distinct concepts.” *Skidmore v. Led Zeppelin*, 952 F.3d 1051, 2020 WL 1128808, at *9 (9th Cir. 2020).

“Proof of copying by the defendant is necessary because independent creation is a complete defense to copyright infringement . . . [n]o matter how similar the plaintiff’s and the defendant’s works are. . .” *Rentmeester*, 883 F.3d at 1117. And, “[p]roof of unlawful appropriation—that is, *illicit* copying—is necessary because [the Copyright Act] does not forbid all copying,” and in fact expressly excludes such matters as ideas, concepts, or principles from its protection. *Id.* (emphasis in original); *see also* 17 U.S.C. § 102(b). Thus, a defendant who copies “ideas” or “concepts” does not commit unlawful appropriation and therefore cannot be liable for copyright infringement.

Accordingly, to prove *copying*, “the similarities between the two works need not be extensive, and they need not involve protected elements of the plaintiff’s work. They just need to be similarities one would not expect to arise if the two works had been created independently.” *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 140

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(2d Cir. 1992); 4 Nimmer on Copyright § 13.01[B]. To prove *unlawful appropriation*, on the other hand, the similarities between the two works must be “substantial” and they must involve protected elements of the plaintiff’s work. *Laureyssens*, 964 F.2d at 140.

**3. Unlawful Appropriation Requires Proof of
“Substantial Similarity,” As Determined
by the Extrinsic Test and the Intrinsic Test**

To consider whether works are substantially similar sufficient to establish unlawful appropriation, the Ninth Circuit employs a two-part test: an extrinsic test and an intrinsic test. *See Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994). The extrinsic test compares the objective similarities of specific expressive elements in the two works, *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002), and often requires expert analysis. *See Apple*, 35 F.3d at 1443. The intrinsic test “test[s] for similarity of expression from the standpoint of the ordinary reasonable observer, with no expert assistance.” *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 637 (9th Cir. 2008) (quoting *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994) (“*Apple*”). Both tests must be satisfied for the works to be deemed substantially similar. *See Funky Films, Inc. v. Time Warner Entm’t Co.*, 462 F.3d 1072, 1077 (9th Cir. 2006). However, the only the extrinsic test may be considered on a motion for summary judgment, because only it can be resolved by the court as a question of law. *Kouf*, 16 F.3d at 1045. The subjective question of whether the works are intrinsically similar is left to the

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jury. *Swirsky v. Carey*, 376 F.3d 841, 845 (9th Cir. 2004), *as amended on denial of reh’g* (Aug. 24, 2004).

4. The Extrinsic Test

To satisfy the extrinsic test, the plaintiff must first identify the sources of the alleged similarity between the two subject works. *See Apple*, 35 F.3d 1435, 1443 (9th Cir. 1994). When analyzing musical compositions, a “variety of compositional elements may be considered, including melody, harmony, rhythm, timbre, structure, instrumentation, meter, tempo, and lyrics.” *Batts v. Adams*, No. CV 10-8-8123-JWF (RZx), 2011 U.S. Dist. LEXIS 161402, 2011 WL 13217923, at *5 (C.D. Cal. Feb. 8, 2011) (citing *Swirsky*, 376 F.3d at 849). Then, “[u]sing analytic dissection, and, if necessary, expert testimony, the court must determine whether any of the allegedly similar features are protected by copyright.” *Apple*, 35 F.3d at 1443. “[A] finding of substantial similarity between two works can’t be based on similarities in unprotectable elements.” *Mattel, Inc. v. MGA Entm’t, Inc.*, 616 F.3d 904, 916 (9th Cir. 2010), *as amended on denial of reh’g* (Oct. 21, 2010)

The Court must therefore “filter out” any unprotectable elements in the plaintiff’s work before assessing whether it is substantially similar to the defendant’s work. *Apple*, 35 F.3d at 1446 (“the unprotectable elements have to be identified, or filtered, before the works can be considered as a whole.”).

*Appendix B***III. DISCUSSION**

The Court finds that there are no triable issues of fact requiring a trial, and that Defendant is entitled to summary judgment.

A. Plaintiff Has No Standing to Pursue an Infringement Claim Based on Alleged Similarities Between the Lyrics of *Raise* and *Soknudor*.

The Complaint repeatedly alleges that *Raise* copies the lyrics and lyrical themes of *Soknudor*. *See, e.g.*, Compl. ¶¶ 29, 43, 54. And in its opposition, Plaintiff argues that the songs' lyrics are similar. *See* Opp'n (Dkt. No. 34), pp. 17-18. However, the Complaint also concedes that Plaintiff does not own any rights to *Soknudor*'s lyrics, *see* Compl. ¶ 90, and the opposition states that Plaintiff does not seek to recover for similarity in the lyrics. *See* Opp'n p. 17. To clear up any confusion, Plaintiff's claim for copyright infringement cannot be based on the lyrics because Plaintiff has no rights in the lyrics and thus lacks standing to pursue such a claim. *Feist*, 499 U.S. at 361 (claim for copyright infringement consists of two elements: "(1) ownership of a valid copyright, and (2) copying. . ."). Thus, insofar as the Complaint encompasses a claim based on the lyrics, Defendants are entitled to summary judgment on that claim.

*Appendix B***B. *Raise* is Not Substantially Similar to *Soknudur***

The dispositive issue in this Motion is whether *Raise* is substantially similar to *Soknudur* under the extrinsic test. It is not. Both sides filed expert reports in support of their positions, but only Defendants' expert report correctly applies the extrinsic test.

1. The Ferrara Reports (Defendants' Expert)

Defendants' expert, Dr. Lawrence Ferrara, analyzed (1) five musical elements (structure, harmony, rhythm, melody, and lyrics) of *Soknudur* and *Raise* in their entirety, (2) the songs' component elements individually and in combination, (3) prior art (pre-1977 compositions), and finally (4) *Soknudur* and *Raise* in their entirety within the context of the analysis of their component elements and prior art. *See* Ferrara Report (Dickstein Decl. (Dkt. No. 31), Ex. A). The analysis is supported with visual illustrations showing and comparing the structures (p. 5), harmonies/chord progressions (p. 10), and melodies (p. 17) of *Soknudur* and *Raise*, and comparing the melodies of *Soknudur* and *Raise* with prior art songs (*see, e.g.*, pp. 21, 25, 27, 28, 32). Ferrara also prepared (and Defendants lodged) multiple audio recordings demonstrating his analysis. In his analysis, Ferrara applied reliable principles and methods to the facts of the case, *see* Fed. R. Evid. 702(c), (d), and has appropriately filtered out prior art from his comparison, as required by the extrinsic test.

Defendants have distilled Ferrara's findings as facts in their Statement of Undisputed Facts ("SUF," Dkt. No.

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44 (Reply SUF)), so the Court will refer to those facts. Ferrara found that *Soknudur* and *Raise* lack significant structural similarities (SUF 22) and gives multiple examples of how their structures differ (SUF 23-27). Ferrara found that *Soknudur* and *Raise* lack significant harmonic similarities (SUF 28, 29, 33) and that their harmonic similarities are either commonplace or present in prior art, especially in *Danny Boy*. (SUF 30, 31.) Likewise, Ferrara found that *Soknudur* and *Raise* lack any significant rhythmic similarities and gives examples of how they differ. (SUF 34-37.) Finally, Ferrara concluded that there are no significant melodic similarities between *Soknudur* and *Raise* (SUF 38, 39, 41-47), and that “[a]ny melodic expression in common between [*Soknudur*] and [*Raise*] is found in Irish folk songs that date back to the 18th and 19th century, and some is also found in a popular song [*When a Child is Born*] released shortly before the release of [*Soknudur*].” (SUF 40, 48-49). Ferrara then goes on to explain how any melodic similarities between *Soknudur* and *Raise* are actually found in prior art, most importantly in the prior art songs *Londonderry Air* and *Danny Boy* which are in the public domain. (SUF 48-61, 63, 65-71). For example, Ferrara finds that out of a total of 87 notes in the melody of verse 1 and chorus 1 in *Raise*, there are only 20 scattered notes that have the same pitch and metric placement. (SUF 63; Ferrara Report ¶ 37, Musical Example 3.) Of these 20 similar notes, there are “only 5 isolated and fragmentary notes [] with the same pitch and metric placement in [*Soknudur* and *Raise*] [that are] not also found in [*Londonderry Air*] and [*Danny Boy*].” (SUF 63; Ferrara Report ¶ 37, Musical Example 3.) Furthermore, of these 20 notes shared by *Sokndur* and

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Raise, there is only one 3-note sequence, but it appears in *Londonderry Air* and *Danny Boy*. Ferrara Report ¶ 37. These facts are well-supported by the proffered underlying evidence, which includes the Ferrara Report and all of its exhibits, as well Ferrara's Rebuttal Report ("Ferrara Rebuttal Report," Dickstein Decl. (Dkt. No. 43) Ex. A) submitted with the reply. For the reasons discussed below, the Court finds that Plaintiff does not genuinely dispute these facts, so the Court finds them undisputed.

Based on such facts, Ferrara presents the following conclusion:

On the basis of my musicological analysis . . . it is my professional opinion that while "Soknudur" and "You Raise Me Up" share some musical similarities, those similarities exist in well-known prior art songs. The similarities in common between "Soknudur" and "You Raise Me Up" were widely available to the writers of both "Soknudur" and "You Raise Me Up". The musical elements that are found in both "Soknudur" and "You Raise Me Up" derive from well-known 18th and 19th century folk songs, particularly Irish folk songs, and are also embodied in at least one well-known popular song that was released shortly before "Soknudur". From a musicological perspective, the similarities that preexist "Soknudur" in famous, longstanding works, cannot be used to support a claim of copying, let alone a claim of the copying of expression that can be

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monopolized by “Soknudur”. As a result, when viewed in the context of this prior art, there are no significant structural, harmonic, rhythmic, lyrical, or melodic similarities between “You Raise Me Up” and “Soknudur,” and there is no support for a claim that musical elements found in “You Raise Me Up” were copied from “Soknudur.”

Ferrara Report p. 1-2. These conclusions flow directly from the analysis and the Court accepts them.

2. The Finell Reports (Plaintiff’s Expert)

Plaintiff offers a contrary opinion from their expert Judith Finell, who prepared a Report and a Rebuttal Report. *See* Machat Decl. (Dkt. No. 36) Exs. 3-5 (Finell Report), Ex. 7 (Finell Rebuttal Report). Based on the Finell Reports, Plaintiff contends that Ferrara’s analysis is faulty and purports to dispute most of Defendants’ proffered facts. However, the Court finds that Finell’s Reports are fatally flawed and therefore declines to consider them. As a result, Ferrara’s reports are not meaningfully rebutted, the well-supported undisputed facts derived from them are not *genuinely* disputed, and the resulting conclusions prevail.

At the outset, the Court notes that the initial Finell Report (entitled “Preliminary Comparison...”) is far less comprehensive than the Ferrara Report, as it consists of only 7 paragraphs of “preliminary” findings contained in fewer than 4 double-spaced pages, supported by 2 exhibits

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purporting to compare the “skeletal pitches” and “skeletal pitch series within similar structure and musical event sequence” in *Soknudur* and *Raise*. See Finell Report. The Finell Report states that the songs share a similar melodic theme based on a series of “skeletal pitches” and musical events. Finell Report ¶ 5-8. The Report’s two exhibits consist of a few staves of music (with embedded audio) excerpted from each song, but the Report lacks adequate explanation of the terms used, and fails to put the selected excerpts in the context of the entire compositions. Thus, the Finell Report does not reflect the application of reliable principles and methods to the facts of the case, as required to be admissible under Fed. R. Evid. 702(c) and (d).

Furthermore, and critically, the Report expressly admits that Finell had “not yet conducted a prior art investigation,” but nevertheless speculates that “it is highly doubtful that another musical work will share the same lengthy series of skeletal pitches and musical events to the degree of similarity that is shared between [*Soknudur*] and [*Raise*].” Finell Report ¶ 9. Because the Finell Report fails to consider prior art, its comparison between *Soknudur* and *Raise* fails to filter out unprotectable prior art elements, which is the foundation of the extrinsic test. See *Apple*, 35 F.3d at 1446 (“the unprotectable elements have to be identified, or filtered, before the works can be considered as a whole.”). Accordingly, because the Finell Report does not compare *Soknudur* and *Raise* in the manner required by the extrinsic test, its opinion about the similarities between *Soknudur* and *Raise* are legally deficient and irrelevant. Brevity alone does not render an expert report deficient, but Finell’s Report is silent

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on too many matters to be considered either adequately supported or probative of the main issue—the application of the extrinsic test.

Although the Finell *Rebuttal* Report is more extensive, as its name suggest its central purpose is to rebut the Ferrara Report; it does little to reinforce the scanty conclusions presented in the preliminary Finell Report. And, the Finell Rebuttal Report fails to discredit the Ferrara Report for several reasons, the most important being that it repeats the fatal flaw of the preliminary Finell Report—it fails to filter out prior art from *Soknudur* and *Raise* before comparing them. For example, the Finell Rebuttal Report states that both *Soknudur* and *Raise* share the same 8-note sequence. See Finell Rebuttal Report ¶ 10(b), p 5. However, Ferrara points out that this sequence is not identical (in *Soknudur* it has an additional C note in the middle), and more importantly, it is actually present in *Londonderry Air* and *Danny Boy*, Ferrara Rebuttal ¶¶ 44-45, so it must be excluded from the extrinsic test. Finell’s opinion based on this 8-note sequence is therefore irrelevant.

Furthermore, the Court notes that while the Finell Rebuttal Report does discuss the most important prior art—*Londonderry Air* aka *Danny Boy*—it does not do so in a legally relevant way: it does not *filter out* elements of these prior art songs from *Soknudur* and *Raise* and compare the remainder as the case law requires; rather, it just tallies up the number of similarities and concludes that there are more similarities between *Soknudur* and *Raise* than between either of them and *Londonderry Air*. But indiscriminately counting the common notes between

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the songs in issue and the prior art does not satisfy the extrinsic test. Rather, the point is to *eliminate* the non-protectible prior art components from the songs in issue, and then compare the protectable remainder, to see how similar that protectable remainder is. A comparison that includes both unprotectible and protectible elements is invalid under the extrinsic test and is legally irrelevant. Thus, although the Finell Rebuttal Report does analyze prior art, the analysis does not engage in the crucial step of eliminating prior art from the songs in issue. As a result, the Finell Rebuttal Report's criticisms of the Ferrara Report—which incorporate this mistake—are largely unfounded. In fact, this error is woven throughout the Finell Rebuttal Report, rendering it unhelpful and inadmissible. *Knowles v. Spin Master, Inc.*, No. CV 18-5827 PA (JCX), 2019 U.S. Dist. LEXIS 160965, 2019 WL 4565102, at *4 (C.D. Cal. Sept. 17, 2019) (disregarding report where expert “does not attempt to differentiate between protectable and unprotectable elements of the works. At least for the Court’s resolution of the extrinsic test on summary judgment, the Court concludes that [expert’s] opinions are not helpful to the Court at this stage of the proceedings.”); *see also Olson v. National Broadcasting Co.*, 855 F.2d 1446, 1450-51 (9th Cir. 1988) (affirming court’s decision to discount expert testimony that deemphasized dissimilarities and relied on unprotectable elements).

The Ferrara Rebuttal Report also points out ways in which Finell’s Reports are unreliable and reach unsupportable conclusions, or mischaracterize the Ferrara Report. The Court will not recount them all at length but gives three examples. First, Finell considers

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notes to be similar even when they appear in different places in the songs' melodies (different metric placement), *see* Finell Rebuttal Report p. 6, Example 3. Finell offers no justification for this technique of considering notes to be similar despite different metric placements in the melody. Second, Finell opines that “identical pitches [] found in succession in both songs” are similarities, but then admits that there are intervening pitches between some of these notes. *See* Finell Rebuttal Report p. 10. Again, there appears to be no justification for deeming notes to be consecutive when in fact there is an intervening note between them. Finally, neither Finell Report includes sufficient supporting evidence—like comparative transcriptions or sheet music—for the Court to assess the validity and accuracy of her analysis. This renders Finell's analysis conclusory and not helpful.

For all of these reasons, the Finell Reports fail to describe reliable principles and methodology, fail to apply such principles and methodology to the facts, and fail to properly apply the extrinsic test, rendering the Reports unreliable, unhelpful, and inadmissible.

3. Plaintiff Cannot Establish Substantial Similarity Under the Extrinsic Test

Given the foregoing, the Court finds that as a matter of law, *Soknudur* and *Raise* are not substantially similar under the extrinsic test. As noted above, Ferrara established that *Soknudur* and *Raise* lack substantial structural, harmonic, rhythmic, and melodic similarities. The dueling expert reports focus primarily on the melodies, and only Defendants' expert Ferrara applied

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reliable principles and methods to this task, and only Ferrara's analysis filtered out the prior art as required by the extrinsic test. Plaintiff's expert report is fatally flawed as discussed above, and on that basis is excluded. Accordingly, Ferrara's analysis—which is well-supported and thorough—is, effectively, un rebutted. The Court therefore finds that Ferrara's extensive analysis of the melodies is conclusive: any melodic similarities between *Soknudur* and *Raise* are either unprotectible because they are found in prior art songs including *Londonderry Air* aka *Danny Boy*, or they are too scattered to amount to substantial similarity.

In their opposition brief, Plaintiff observes that “copyright may inhere, under appropriate circumstances, in the selection and arrangement of unprotected components.” See Opp’n (Dkt. No. 34) 9:11-15 (quoting *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1476 (9th Cir. 1992)). However, despite quoting this caselaw, Plaintiff fails to apply it in any way and therefore has failed to pursue this theory. A claim based on a selection and arrangement of unprotected elements requires a plaintiff “to explain how these elements are particularly selected and arranged,” otherwise the claim “amounts to nothing more than trying to copyright commonplace elements.” *Skidmore*, 952 F.3d 1051, 2020 WL 1128808, at *18 (copyright claim based on selection and arrangement of unprotected elements is a separate theory that plaintiff failed to present); see also *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) (“a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination

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constitutes an original work of authorship”). Here, neither Plaintiff nor its expert engaged in any analysis that could support a selection and arrangement theory, so the Court concludes that Plaintiff is not genuinely pursuing that theory and certainly has not carried its summary judgment burden as to it.

In light of the foregoing, Plaintiff cannot establish that *Soknudur* and *Raise* are substantially similar under the extrinsic test, properly applied. Because “a plaintiff who cannot satisfy the extrinsic test necessarily loses on summary judgment, *see Kouf*, 16 F.3d at 1045, the Court **GRANTS** Defendants’ Motion.

IV. CONCLUSION

For the foregoing reasons, Defendants’ Motion for Summary Judgment (Dkt. No. 28) is **GRANTED**.

Plaintiff’s Request for Entry of Default (Dkt. No. 46) as to the non-appearing individual defendants is, accordingly, **DENIED**.

Defendants are **ORDERED** to file a proposed Judgment within 5 days of the issuance of this Order.

IT IS SO ORDERED.

Dated: April 03, 2020

/s/ André Birotte Jr.
HONORABLE ANDRÉ BIROTTE JR.
UNITED STATES DISTRICT COURT
JUDGE