No.

IN THE
Supreme Court of the United States

JOE GREGORY CARLINI,
Petitioner,

v.

PARAMOUNT PICTURES CORPORATION, ET AL.,
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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QUESTION PRESENTED

Joe Gregory Carlini, ("Carlini") filed suit against Paramount Pictures Corporation, *et al.* (collectively "Paramount") alleging that the film, *What Men Want* ("WMW") infringed the copyright to his screenplay *What the F Is He Thinking* ("WTF"). Despite alleging numerous similarities between the works – numbering more than sixty (60) in total – the district court, applying its own subjective literary judgment as fact-finder, dismissed the operative complaint on Paramount's motion under Fed. R. Civ. P. 12(b)(6), finding a lack of substantial similarity and access. Following a de novo review, the Ninth Circuit affirmed, compounding the error

The approach taken by the district court and Ninth Circuit reflects a dangerous recent trend that has emerged in the Ninth Circuit in which lower courts have become increasingly unbridled in dismissing copyright infringement claims at the pleadings stage, undermining procedures designed to ensure that the quintessentially factual question of substantial similarity of expression is decided on a more developed record. In copyright-infringement cases these courts have hand-waved away such principles as the (i) "no reasonable juror" standard, (ii) "selection and arrangement" test, (iii) inverse-ratio rule, and (iv) the importance of expert opinion regarding what is often subtle and complex literary interpretation.

The dismissal gives rise to the following questions:

1. Whether the district court and Ninth Circuit erred in applying the extrinsic test for substantial similarity by "filter[ing] out" elements that the court considered "common" or "unprotected," without first

analyzing whether Carlini's selection and arrangement of protected and unprotected elements in WTF are substantially similar to those of WMW.

2. Whether, in characterizing WTF's literary elements, both the district court and Ninth Circuit erred by improperly substituting their subjective literary judgment for that of the fact-finder, contrary to the rule that dismissal of a copyright-infringement claim at the pleading stage is proper only if no reasonable juror could find substantial similarity between the works.

PARTIES TO THE PROCEEDING

In addition to the parties listed in the caption, "Will Packer Productions, Inc.," "Black Entertainment Television, LLC," "Tina Gordon Chism," "Peter Hyuck," "Alex Gregory," "Jas Waters," "Will Packer," "James Lopez" and John Does 1 through 100 were named as defendants in the district court and listed as appellees in the court of appeals.

RELATED PROCEEDINGS

- *Carlini v. Paramount Pictures Corporation, et al.*, No. 2:19-cv-08306-SB-RAP, U. S. District Court for the Central District of California. Order Granting Motion to Dismiss Second Amended Complaint entered Feb. 2, 2021.
- *Carlini v. Paramount Pictures Corporation, et al.*, No. 21-55213, U. S. Court of Appeals for the Ninth Circuit. Judgment entered Mar. 2, 2022.

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Joe Gregory Carlini respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit (Ninth Circuit).

OPINIONS BELOW

The decision of the court of appeals (Pet. App 1a-5a) is unpublished. The order of the district court granting the Motion to Dismiss the Second Amended Complaint (Pet. App. 6a-42a) is unpublished.

JURISDICTION

The judgment of the court of appeals was entered on March 2, 2022. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Pertinent provisions of the Copyright Act of 1976 (17 U.S.C. §101, *et seq.*) and the Federal Rules of Civil Procedure (Fed. R. Civ. Proc. 12(b)(6)) are reprinted in the Appendix, *infra*, at 43a-59a.

STATEMENT

In affirming the district court's dismissal of Carlini's copyright and declaratory relief claims at the pleading stage, the Ninth Circuit disregarded or misapplied the following core copyright principles

governing the application of the "extrinsic test" for substantial similarity:

(a) The court must consider whether the "selection and arrangement" of literary elements may be substantially similar irrespective of whether each element, standing alone, is copyright protected, *see Metcalf v. Bochoco*, 294 F.3d 1069, 1074 (9th Cir. 2002);

(b) Similar elements cannot be disregarded as unprotected *scènes à faire* unless they meet the narrow exclusion for "stock" elements "indispensable" to a given subject, *see Ets-Hokin v. Skyy Spirits, Inc.,* 225 F.3d 1068, 1082 (9th Cir. 2000);

(c) The court cannot consider elements that defendants added or changed in their work, but must focus exclusively on the works' shared elements, *see Shaw v. Lindheim*, 919 F.2d 1353, 1357-58 (9th Cir. 1990); and

(d) The court must not impose its subjective judgment in evaluating the works, and may dismiss only if no reasonable juror could find substantial similarity, *see L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 851 (9th Cir. 2012).

By categorizing many of the key elements of WTF as "common" or "unprotectable" in isolation, without regard to the selection and arrangement of those elements in combination, as to and subjectively resolving disputes of interpretation against Carlini, both the district court and Ninth Circuit continue a recent alarming trend in the Ninth Circuit in which the benefits of expert opinion are disregarded, and the courts insert their own subjective fact finding, usurping the jury's role. As a result, Carlini was

denied a fair opportunity to present expert testimony on the myriad inter-related ways in which WTF was appropriated in WMW.

SUMMARY OF THE ARGUMENT

Circuits are split as to the test for substantial similarity at the pleading stage. District courts in the Ninth Circuit, and the Ninth Circuit itself, in contravention of its own precedent, have supplanted the (what should be) purely objective extrinsic test with a highly subjective fact-based analysis. This approach is reminiscent of that applied by courts the Second Circuit, which squarely conflicts with the approach and precedent of the Ninth Circuit. In the Second Circuit, for example, a district court may analyze and rule upon every aspect of the substantial similarity test, including the subjective issues of "'[t]he similarities in such aspects as the total concept and feel, theme, characters, plot, sequence, pace, and setting.'" *Abdin v. CBS Broad., Inc.*, 971 F.3d 57, 66 (2d Cir. 2020), quoting *Williams v. Crichton*, 84 F.3d 581, 588 (2d Cir. 1996). *See, e.g.*, *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 63-64 (2d Cir. 2010) (noting that in the Second Circuit, "it is entirely appropriate for a district court to resolve [substantial similarity] as a matter of law" and that when a defendant raises substantial similarity at the pleadings stage, "a district court may consider 'the facts as asserted within the four corners of the complaint' together with 'the documents attached to the complaint as exhibits….'" quoting *McCarthy v. Dun & Bradstreet Corp.*, 482 F.3d 184, 191 (2d Cir. 2007)).

In contrast, in the Ninth Circuit, a district court may only rule upon the extrinsic test of substantial similarity as a matter of law; the subjective intrinsic test, however, "is uniquely suited for determination by trier of fact." *Shaw v. Lindheim*, 919 F.2d 1353, 1358 (9th Cir. 1990), *overruled on other grounds by Skidmore v. Led Zeppelin*, 952 F.3d 1051, 1066 (9th Cir. 2020); *see also Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1118 (9th Cir. 2018) ("Only the extrinsic test's application may be decided by the court as a matter of law") (citation omitted); *Zindel v. Fox Searchlight Pictures, Inc.*, 815 Fed. Appx. 158, 159 (9th Cir. 2020) (same). For this reason, dismissal of copyright claims at the pleadings stage is not favorable in the Ninth Circuit. *Zindel*, 815 Fed. Appx. at 159 ("we have long held that '[s]ummary judgment is not 'highly favored' on questions of substantial similarity" and "[c]ourts must be just as cautious before dismissing a case for lack of substantial similarity on a motion to dismiss.") (quoting *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 848 (9th Cir. 2012)). As such, the Ninth Circuit has held it is reversible error for a district court to decide the intrinsic test on a Rule 12(b) motion. *See, e.g.*, *Shaw*, 919 F.2d at 1358; *Rentmeester*, 883 F.3d at 1118; *Zindel*, 815 F. Appx. at 158.

A further conflict exists between the Ninth and Second Circuits concerning the use of expert testimony in works that are complex – such as screenplays or literary works. For instance. while the Second Circuit has held that expert testimony is irrelevant except in situations which are highly technical (*see, e.g., Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 713 (2d Cir. 1992); *Peter F. Gaito*, 602 F.3d at 66), the Ninth Circuit has numerous times

held that expert testimony is not only admissible, but needed in order to determine whether similarities in two works regard unprotectable material. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977); *Shaw*, 919 F.2d at 1358; *Zindel*, 815 F. Appx. at 160. It is true that the Ninth Circuit has held in the past that "determining substantial similarity does not necessarily require expert testimony." *Masterson v. Walt Disney Co.*, 821 Fed. Appx. 779, 781 (9th Cir. 2020). However, the court pointed out that this has been when "'[n]othing disclosed during discovery could alter the fact that the allegedly infringing works are as a matter of law not substantially similar'" (*id.*, quoting *Rentmeester*, 883 F.3d 1123) or when the court "'engage[s] in an extensive analysis of the alleged similarities in expressive elements.'" *Id.*, quoting *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1180 (9th Cir. 2003). Therefore, a dismissal at the pleading stage based on lack of intrinsic similarity without allowing discovery is improper in the Ninth Circuit absent the above mentioned extensive court analysis and/or the absolute lack of anything which, if brought in through discovery, would change the outcome. *See Masterson*, 821 Fed. App. at 780 (noting that the Ninth Circuit had not issued a published decision affirming dismissal of a literary work infringement case on substantial similarity grounds before discovery has been conducted).

In the instant case, the district court and Ninth Circuit committed two (2) separate errors, each warranting review by this Court, as follows:

1. The courts erred in applying the extrinsic test for substantial similarity by filtering out elements

that the court considered common or unprotected, without first analyzing whether Carlini's selection and arrangement of protected and unprotected elements in WTF are substantially similar to those of WMW.

2. The courts erred by improperly substituting their subjective judgment for that of the fact-finder at the pleading stage, contrary to the rule that dismissal of a copyright-infringement claim at the pleading stage is proper only if no reasonable juror could find substantial similarity between the works.

REASONS FOR GRANTING THE WRIT

A. The District Court and Ninth Circuit Erred in Applying the Extrinsic Test for Substantial Similarity.

A close comparison of WTF and WMW reveals that the two works are not only substantially similar, but strikingly similar. While the works incorporate the same "general" premise—that the main character can read men's minds—the use of that premise in both works goes beyond the realm of coincidence and into copying.

Courts in the Ninth Circuit are supposed to employ a two-part test to determine if works are substantially similar: an intrinsic test and an extrinsic test. *Funky Films, Inc. v. Time Warner Entm't Co.*, L.P., 462 F.3d 1072, 1077 (9th Cir. 2006). "The 'intrinsic test' is a subjective comparison that focuses on 'whether the ordinary, reasonable audience' would find the works substantially similar in the 'total concept and feel of the works.'" *Benay v. Warner Bros. Entm't*, 607 F.3d 620, 624 (9th Cir. 2010). Because the intrinsic test is

a "subjective assessment of the concept and feel of two works," (*Shaw*, 919 F.2d at 1360), a determination of two works' intrinsic similarities "must be left to the jury" (*Smith v. Jackson*, 84 F.3d 1213, 1218 (9th Cir. 1996)). Importantly, "the intrinsic test is reserved exclusively for the trier of fact." *Williams v. Gaye*, 895 F.3d 1106, 1119 (9th Cir. 2018). Thus, as noted, the court may rule against a plaintiff under the extrinsic test only if "no reasonable juror could find" that the works are substantially similar. *Swirsky v. Carey*, 376 F.3d 841, 844 (9th Cir. 2004).

Thus, on a motion to dismiss, courts may only consider the extrinsic test. *See Schkeiban v. Cameron*, 2012 U.S. Dist. LEXIS 145384, *3 (C.D. Cal. Oct. 4, 2012). And, on a motion to dismiss or a motion for summary judgment, a court may only conclude that two works "are not substantially similar as a matter of law if the court concludes that 'no reasonable jury could find that the works are substantially similar, or if it concludes that the similarities between the two works pertain only to unprotected elements of the works.'" *See Dillon v. NBCUniversal Media, LLC*, 2013 U.S. Dist. LEXIS 100733, *11 (C.D. Cal. June 18, 2013) (quoting *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124, 1131 (C.D. Cal. 2007)).

Further, no court in the Ninth Circuit "has **ever** affirmed the dismissal of a case alleging infringement of a literary work without discovery in a published opinion." *Astor-White v. Strong*, 733 Fed.Appx. 407, 409 n.2 (9th Cir. 2018) (Wardlaw, J., concurring) (emphasis added). The only published cases affirming a 12(b)(6) dismissal for lack of substantial similarity compared two photographs, *Rentmeester v. Nike Inc.*,

883 F.3d 1111 (9th Cir. 2018), and maps, *Christianson v. West Pub. Co.*, 149 F.2d 202 (9th Cir. 1945).

But photographs and maps are protected under an entirely separate section of the Copyright Act, 17 U.S.C. § 102 (a)(5), and even more fundamentally, comparing maps or photographs is an inherently simpler task (better suited for a 12(b)(6) motion) than comparing a literary work and a film based on that literary work. Yet, even in that simpler context, *Rentmeester* drew a dissent: "[Substantial similarity] is an inherently factual question which is often reserved for the jury, and rarely for a court to decide at the motion to dismiss stage." *Rentmeester,* 883 F.3d at 1123 (Owens, J., dissenting).

In applying the extrinsic test, courts compare "not the basic plot ideas for stories, but the actual concrete elements that make up the total sequence of events and the relationships between the major characters." *Funky Films*, 462 F.3d at 1077. Furthermore, two works are considered not only substantially similar, but also strikingly similar when the works are "so strikingly similar as to preclude the possibility of independent creation." *Bernal v. Paradigm Talent & Literary Agency*, 788 F. Supp, 2d 1043, 1052 (C.D. Cal. 2010) (internal quotation marks omitted) (quoting *Meta-Film Assoc., Inc. v. MCA Inc.*, 586 F. Supp. 1346, 1355 (C.D. Cal. 1984)); *see also Malibu Textiles, Inc. v. Label Lane Int'l, Inc.*, 922 F.3d 946, 953 (9th Cir. 2019) ("Two works are strikingly similar when the similarities between them are so great that they are 'highly unlikely to have been the product of independent creation.'").

B. The District Court and Ninth Circuit Erred by Improperly Substituting their Subjective Judgment for That of the Fact-Finder.

"Although summary judgment is not highly favored on questions of substantial similarity in copyright cases, summary judgment is appropriate if the court can conclude, after viewing the evidence and drawing inferences in a manner most favorable to the non-moving party, that no reasonable juror could find substantial similarity of ideas and expression." *Swirsky*, 376 F.3d at 844; *Folkens v. Wyland Worldwide, LLC*, 882 F.3d 768, 774 (9th Cir. 2018) (same) (citing *Shaw*, 919 F.2d at 1355). Substantial similarity is "a question of fact uniquely suited for determination by the trier of fact." *Jason v. Fonda*, 526 F. Supp. 774, 777 (C.D. Cal. 1981), *incorp'd by ref*, 698 F.2d 966 (9th Cir. 1982). As such, the "no reasonable juror standard" is not just important, but vital to due process.

It was not the district court's role to decide whether "the works are, in fact, substantially similar," but only to decide whether "reasonable minds could differ as to the issue." *See Baxter v. MCA, Inc.*, 812 F.2d 421, 425 (9th Cir. 1987) (reversing summary judgment for defendant); s*ee also Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327, 1329 n.6, 1330 (9th Cir. 1983) (reversing summary judgment; viewing works in light most favorable to non-movant, reasonable minds could differ whether *Battlestar: Galactica* infringed *Star Wars*).

If this unwavering standard applies on summary judgment, it is even more stringent on a Rule 12(b)(6) motion, where Carlini was cut off at the knees, with

no opportunity to develop the record, take discovery as to Paramount's actual copying or proffer illuminating expert testimony. Instead, the district court, with no particular literary expertise, conveniently unpacked *WTF* into isolated abstractions, substituting its interpretations for those of a jury.

The district judge failed to the combine the literary elements that made WTF creative and original, including through selection and arrangement of those elements, and instead wrongly isolated each literary element to make them (by design) *scènes à faire*. For example, the district court concluded the "gay best friend" character in WTF was "common in comedies, particularly in romantic comedies, and is not a unique plot element standing alone." But this rendered that one element meaningless in the context of the overall selection and arrangement of all elements in WTF. As stated above, there are many more aspects of these counterpart characters that support substantial similarity. Under the district court's approach, any element of any literary work—viewed in a vacuum—could be classified as *scènes à faire*.

Further, the district court subjectively and improperly characterized WTF's plot as being a simple "'boy meets girl' plot and fairly trivial." The district court also stated that "the love story is different from beginning to end—except to the extent that there is a beginning, a middle, and an end." Additionally, the district court erroneously isolated, and subjectively characterized the "use of the magical powers" as a generality. The district court completely ignored the particular details of those powers, how they were acquired, how they were used, and how they were lost

in its analysis. This was by design to support a *scènes à fai*re characterization.

Compounding the above errors, the district court violated the bedrock principle that an infringement claim cannot be dismissed unless "no reasonable juror could find substantial similarity." *See Swirsky*, 376 F.3d at 844. This is the same stringent standard that restricts the authority of district courts to render judgment notwithstanding the verdict under Fed. R. Civ. P. 50. *Williams*, 895 F.3d at 1127 ("[i]t is not the courts' place to substitute our [subjective] evaluations for those of the jurors"); *Kaseberg v. Conaco, LLC*, 260 F.3d 1229, 1235 (S.D. Cal. 2017).

This rule is necessary, "[s]ince substantial similarity is usually an extremely close question of fact." *Twentieth Century-Fox Film Corp., 715 F.2d at* 1329 n.6 (denying summary judgment because "reasonable minds could differ"); s*ee Baxter*, 812 F.2d at 424-25 (same); *L.A. Printex*, 676 F.3d at 851 ("genuine dispute of material fact" as to works' similarities). Due to the detailed nature of this factual inquiry, even on summary judgment all literary inferences must be construed "in a manner most favorable to the non-moving party." *Shaw*, 919 F.2d at 1355; *accord Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 n.3 (9th Cir. 1994) (determining substantial similarity as a matter law is "not highly favored"); *Atkins v. Fischer*, 331 F.3d 988, 995 (D.C. Cir. 2003) (same). "A jury ultimately may conclude that the similarities between the protected elements in" the works "are not 'substantial,'" but because "'[s]ubstantial similarity' is a question of fact, [] summary judgment is only appropriate if no reasonable juror could differ in weighing the

evidence." *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210, 1216 (11th Cir. 2000).

A fortiori, on a 12(b)(6) motion, disputes as to substantial similarity and all literary inferences to be drawn from the works must be construed in a plaintiff's favor. The extrinsic test must be applied with the utmost caution as plaintiffs have no opportunity to present relevant evidence, *e.g.,* expert literary opinion and evidence of access. *See Dezendorf v. Twentieth Century-Fox Film Corp.*, 99 F.2d 850, 851 (9th Cir. 1938) (denying 12(b)(6) motion; though court can compare works' contents at pleading stage, "court will rarely impose its judicial knowledge" as to originality/similarity); *Copeland v. Bieber*, 789 F.3d 484, 486 (4th Cir. 2015) (denying 12(b)(6) motion under "no reasonable juror standard").

Where, as in this case, the substantial-similarity inquiry compares a screenplay to a film, the analysis is especially open to a range of interpretations, requiring close analysis of works' elements that often intertwine in "subtle and complex" ways. *Baxter*, 812 F.2d at 424. Whenever such expressive elements could yield conflicting reactions among jurors, the court must leave such questions to the jury. Instead, the district court here substituted its own subjective reactions for those of the jury. In effect, the district court became a jury of one.

Further, instead of viewing the works in the light most favorable to Carlini, the district court compared them in the light most favorable to Paramount to achieve a particular result—dismissal.

CONCLUSION

For the above reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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