

A comparative French and U.S. law approach to *scènes à faire* and other non-protectable elements in copyright law¹

Published in French in *Propriétés Intellectuelles*, January 2009, Issue n° 30.

By Winston Maxwell (Paris), Katherine Bolger (New York) and Thomas Zeggane (Paris),
Hogan & Hartson LLP

Introduction. Copyright does not protect ideas but merely their original expression. The principle is simple, but its application riddled with uncertainties. In 1930, Judge Learned Hand wrote of the frontier between idea and expression : “Nobody has ever been able to fix that boundary, and nobody ever can.”² The 1930 case decided by Learned Hand involved the author of a play named *Abie's Irish Rose*, who sued the producer of a motion picture entitled *The Cohens and The Kellys* for copyright infringement on the basis of the substantial similarities between the two works. In his opinion, Learned Hand dismissed plaintiff’s claims on the ground that “[a] comedy based upon conflicts between Irish and Jews, into which the marriage of their children enters, is no more susceptible of copyright than the outline of *Romeo and Juliet*.” As predicted by Judge Hand in 1930, the uncertainties between idea and expression still plague practitioners today. Creators of successful dramatic or literary works are often attacked by individuals alleging that the successful work infringes their own prior (generally unsuccessful) work. Plaintiffs are able in most cases to demonstrate that they wrote an earlier treatment, script or book containing several elements similar to those found in the second successful work. French and U.S. approaches to this situation are quite similar. In the U.S., the first inquiry will be to determine whether the defendant had access to the earlier work. In France, the traditional approach skips this test. However, two recent French decisions appear to include an “access” test similar to that used in the U.S. After the access test, the next test consists of determining whether the similarities identified are limited to non-protectable elements or relate to elements of original expression of the earlier work. Next, the mere existence of similarities with copyrightable elements of the prior work is not sufficient, these similarities must be “substantial.” The author of the second work may also provide evidence that the work was created independently and that the similarities with the earlier work are purely fortuitous. Under both French and U.S. law, the “substantial similarity” tests give room for subjectivity, which in turn creates uncertainties. More than 75 years after Judge Hand’s decision, the line of demarcation between idea and expression remains difficult to draw, in both France and the U.S.

Freedom of speech. Copyright is a restriction of free speech. While not always expressly acknowledged in the case law, the tension between copyright and freedom of speech affects copyright analysis in three ways :

First, in assessing the protectability of the elements reused in the second work. The U.S. concept of *scènes à faire* and its equivalent in French law (“the common heritage of literature,” *banalités*, “in the air of the times”) strike a balance between freedom of speech and copyright³.

¹ The original French version of this article appeared in *Propriétés Intellectuelles*, n° 30, January 2009.

² *Nichols v. Universal Pictures Corporation*, 45 F.2d 119 (2nd Cir. 1930).

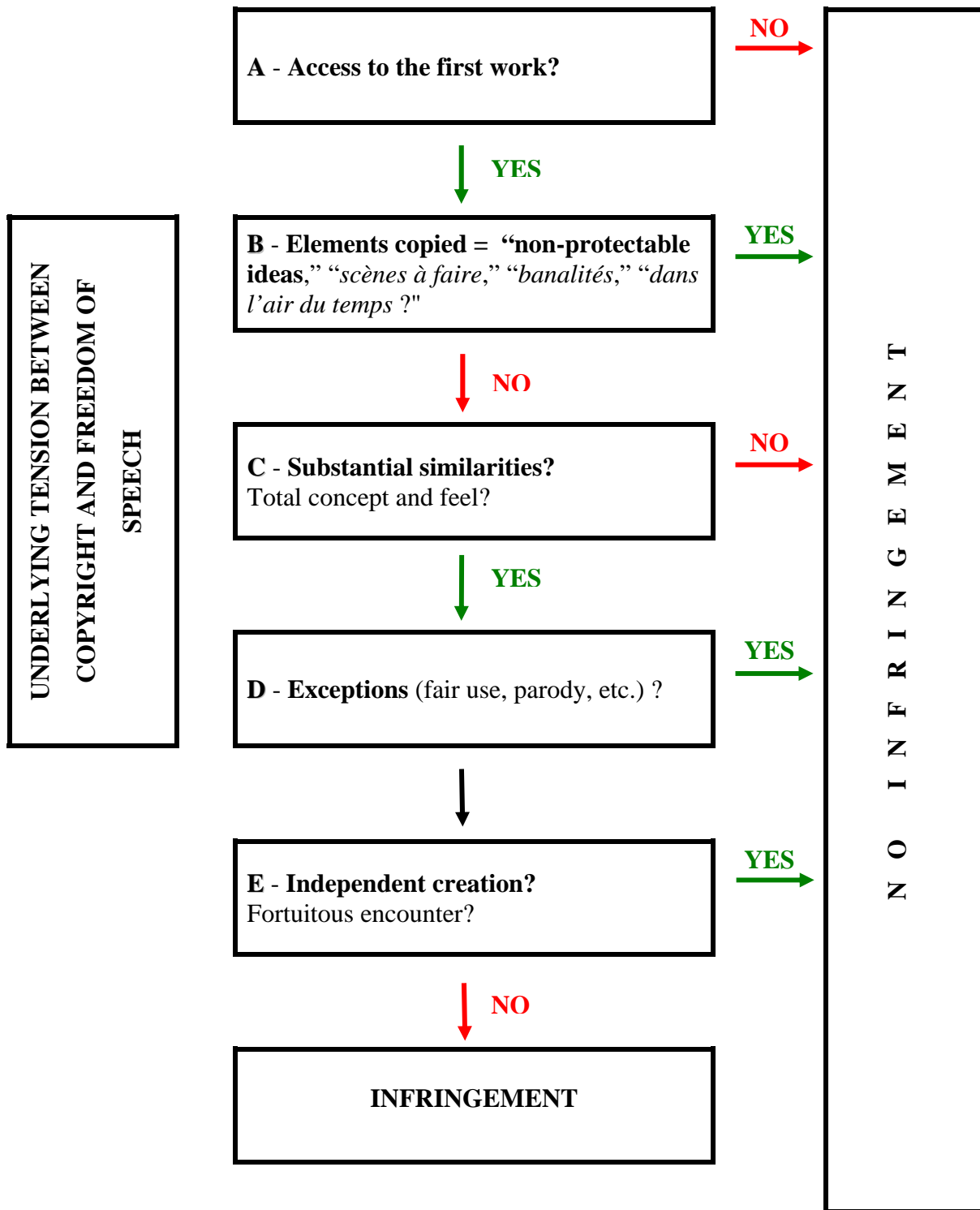
³ See, *Eldred v. Ashcroft*, 537 U.S. 186, 211 (2003), and the idea of built-in safeguards in copyright law such as the idea-expression dichotomy or the fair use exception. The Supreme Court already stated that copyright was “the engine of free expression.” See, *Harper & Row Publishers, Inc. v. Nation Enterprises*, 47 U.S. 539 (1985).

Second, freedom of speech may affect the assessment – necessarily subjective – of the so-called “similarities.” Although copyright infringement is principally based on the similarities as opposed to the differences between two works, French and U.S. judges may take into account the transformative nature of the second work and decide that, because of significant creative changes (new characters, new plots, different tone and overall atmosphere), the similarities are not sufficient to warrant a finding of copyright infringement.

Finally, freedom of expression is part of the exception of fair use under U.S. law and its French equivalent (article L. 122-5 of the Intellectual Property Code).

Proposed analytical model. For the purpose of comparing French and U.S. case law, we refer to the following analytical model :

PROPOSED FLOWCHART FOR ANALYZING COPYRIGHT INFRINGEMENT
UNDER U.S. AND FRENCH LAW



French and U.S. decisions finding no copyright infringement usually rely upon a combination of several factors. In the U.S., the absence of access (block “A” in the flowchart) combined with evidence of independent creation (block “E”) and the fact that similarities are limited to non-protectable elements flowing from the underlying ideas (block “B”) may be used as cumulative reasons why infringement does not exist. In France, decisions tend to focus on blocks “B,” “C,” and “E,” although the access test (block “A”) has been taken into account in two recent decisions. In this regard, U.S. and French analytical methods seem to converge. The fair use exception and its equivalent in France (block “D”) are routinely claimed but, at least in the cases that we reviewed, rarely recognized.

Specific examples. *The Wind Done Gone* case⁴ in the U.S. and the *La Bicyclette Bleue* case⁵ in France are good illustrations of the influence of freedom of speech on how French and U.S. courts decide copyright infringement cases. Both cases related to a new treatment of Margaret Mitchell’s *Gone With The Wind*. In *The Wind Done Gone* case (hereinafter “TWDG”), the author Alice Randall retold the story of “Gone With The Wind” (hereinafter “GWTW”) from the viewpoint of a slave. Randall and her publisher took the position that the second work was not substantially similar to Margaret Mitchell’s novel owing to the transformative changes made by Randall⁶. As an additional defense, Randall and her publisher claimed that notwithstanding any similarity that may exist, the second work was a fair use of GWTW. On the first defense (no substantial similarity), the court concluded that several copyrightable elements from GWTW were used by the author of TWDG, in particular the plot, the characters and their relationships. The court compared only the similarities between the two works and not their differences, before concluding that the similarities were substantial enough to constitute potential infringement. However, the court held that TWDG was a fair use because of the highly transformative use of the protected elements from GWTW and because of the purpose of the work, i.e. a critique of the depiction of slavery and of the relationships between blacks and whites during Civil War as presented in GWTW. The transformative nature of TWDG lessened the significance of its commercial exploitation⁷. The Court of Appeals emphasized the importance of freedom of speech in the application of copyright law principles, and concluded that TWDG constituted a parody within the ambit of the U.S. fair use exception. The parody qualification was not self-evident. TWDG resembles a social commentary or a satire rather than a parody⁸.

The U.S. fair use exception is quite vague when compared to French exceptions to copyright that are listed in article L 122-5 of the French Intellectual Property Code⁹. The U.S.

⁴ *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257 (11th Cir. 2001).

⁵ Paris, November 21, 1990, Dalloz 1991, p. 85, note Pierre-Yves Gautier ; Civ. 1^{ère}, February 4, 1992, Dalloz 1992, p. 182, note Pierre-Yves Gautier ; Versailles, December 15, 1993, Dalloz 1994, p. 132, note Pierre-Yves Gautier.

⁶ For changes deemed not transformative enough, see, *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997). In this case, the appropriation of elements of Dr. Seuss’ “The Cat In The Hat” in a book relating the O.J. Simpson proceedings.

⁷ See also, *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) regarding the use by a Rap music band of elements of Roy Orbison et William Dees’ “Oh, Pretty Woman.”

⁸ For a similar discussion on terminology in French copyright law, see, Pierre-Yves Gautier, *Propriété littéraire et artistique*, 6^{ème} édition, n° 368, where the author takes position in favor of the generic use of the term “parody” in all instances.

⁹ So much so that the fair use issue has been characterized as “the most troublesome [theory] in the whole law of Copyright.” See, *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429, 1439 (6th Cir. 1992) (Nelson, J., dissenting).

exception tolerates any fair use of a work for purposes such as criticism, comment, news reporting, teaching, scholarship, or research. The factors to be considered when assessing whether a certain use is a fair use are: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work. Alice Randall's work, *TWDG*, overtly refers to the original story of *GWTW* to criticize Margaret Mitchell's "romantic, idealized portrait of the antebellum South during and after the Civil War." The court held that the exception of fair use was applicable because the second work was, in the court's view, a parody. The court applied block "D" of our flowchart.

In the *La Bicyclette Bleue* case, the Court of Appeals decided on remand that Régine Déforges' novel did not infringe Margaret Mitchell's novel, not because it was a parody, but because the similarities between the two works were not substantial enough, i.e., the similarities did not pass the block "C" test of the flowchart. *La Bicyclette Bleu* borrowed several themes from *Gone With The Wind*, telling a similar story in a World War II setting. *La Bicyclette Bleue* is not a critique or a parody of *GWTW* but rather a new story with new characters within the general plot framework of *GWTW*. The author of *La Bicyclette Bleu* admitted that the initial similarities were deliberate, and contributed to her "playful intent" to create an "amused complicity" with readers. In both *TWDG* and *La Bicyclette Bleue* cases, judges sided for freedom of expression, although they used different rationales to reach the outcome: in *TWDG* case, the fair use exception (block "D"); in the *La Bicyclette Bleue* case, the absence of substantial similarities (block "C"). However, in both cases the judges were sensitive to the fact that the works significantly departed from the earlier works. The approach of the UK Court of Appeals in the *Da Vinci Code* case¹⁰ is similar to that of the Versailles Court of Appeals in *La Bicyclette Bleue*: Dan Brown's book *Da Vinci Code* copied certain original themes developed in an earlier work. However, the themes that were copied represented a combination of historical events, theories and suppositions which were not protectable as such. As a consequence, the court held that Dan Brown did not copy a "substantial part" of the earlier work and therefore committed no copyright infringement. The *Da Vinci Code* case, which may also be compared to the *Amistad* case in the U.S.¹¹, is a good illustration of block "B" and "C" of our flowchart.

Some outcomes may seem unfair : a children's book told the story of an island used as a dinosaur zoo. The island had a nursery for dinosaur eggs, group excursions in safari outfits, electrical fences that are part of a sophisticated security system that inevitably malfunctions leaving a child unprotected amidst dinosaurs. The author of these children's books believed that Michael Crichton's novel *Jurassic Park* and its motion picture adaptation by Steven Spielberg infringed his copyrights. The Court of Appeals for the Second Circuit dismissed plaintiff's claims based on blocks "B" and "C" of our flowchart¹²: Although there are several similarities between "Jurassic Park" and the children's books, the elements that were copied were not protectable because they constituted *scènes à faire*, i.e. situations that flow naturally from the underlying idea of a dinosaur zoo. The use of the French idiom *scènes à faire* in U.S. copyright law amuses French lawyers because the term is basically meaningless in French. In English, *scènes à faire* means "themes and concepts that flow predictably from [an] idea"¹³ or

¹⁰ *Baigent v Random House*, [2007] EWCA Civ 247.

¹¹ *Barbara Chase-Riboud v. Dreamworks, Inc.*, CV 97-7619 ABC (C.D. Cal. 1997).

¹² *Williams v. Crichton*, 84 F.3d 581 (2nd Cir. 1996).

¹³ *Hogan v. DC Comics*, 48 F Supp 2d 298, 311 (S.D.N.Y. 1999).

“incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.”¹⁴ The concept of a dinosaur zoo is not protectable under copyright law because it is just an idea. According to the court, putting the park on an island (“Where else would it be?”), the nursery for dinosaur eggs, and the defective security system are all *scènes à faire* that logically flow from the underlying idea of a zoo for dinosaurs. These *scènes à faire* are no more protected than the underlying idea itself. In addition, the court held that the works as a whole did not present sufficient similarities (block “C” of the flowchart) because the “total concept and feel” of the two works, and their overall character, differ. Thus, even if the assessment of copyright infringement is, in principle, based on similarities and not differences, differences between the two works play a role in the subjective appraisal of the significance and the extent of the similarities. In another case, plaintiffs wrote a story, based on their activities in real life as “divination artists,” in which an artist has the ability to paint the future. The artist draws a picture predicting that two planes will destroy the World Trade Center, and tries to warn people of the imminent danger. A similar scene was used in the TV series “Heroes.” According to the Southern District Court of New York, there was no infringement because the idea of a divination artist who has the ability to paint the future is not copyrightable in itself¹⁵. The fact that this artist predicts apocalyptic explosions in Manhattan is not original, especially following the September 11 terrorist attacks; that the artist tries to prevent these events from happening is a predictable *scène à faire* that flows directly from the underlying idea. In an approach similar to that used in the Jurassic Park case, the court held that the overall concept and feel of the two works were entirely different and that the similarities were not substantial enough to warrant a finding of infringement. In both cases, the judges’ rationale rested upon blocks “B” and “C” of the flowchart.

French cases. In France, an author wrote a short narrative about a patient stuck in his hospital bed and who had to rely on his roommate to describe events he saw happening in the outside world. At the end of the story, we discover that the window used by the roommate had no view of the outside world and that the roommate invented the stories. This idea was also used in a short film, but the Paris Court of Appeals held that the idea was a non-protectable and that, in addition, the idea had already been used in previous works¹⁶. According to the court, the similarities between the two works did not go beyond the underlying idea (block “B” of the flowchart). Moreover, the works differ significantly in their tone and spirit (block “C”). French judges use the term *banalités* to designate situations that naturally flow from the underlying idea (the equivalent of *scenes à faire*). French Professor Pierre-Yves Gautier cites in his copyright treatise a 1909 lawsuit brought by the famous playwright Courteline who accused another author of copying scenes from Courteline’s story. The French court dismissed Courteline’s claims, concluding that the scenes that were copied, involving a love triangle, belonged to “theater’s common heritage”¹⁷. Although the term *scènes à faire* is only used by U.S. courts, the same concept has existed in French case law at least since 1909. In a more recent case involving the picture *The Professional*, the Paris Court of Appeals held that the similarities between a screenplay entitled *A Broken Childhood* and the motion picture *The Professional* were not substantial enough¹⁸. According to the court, the theme of a child disrupting the habits of a lonely and emotionally detached adult who

¹⁴ *Alexander v. Haley*, 460 F.Supp. 40 (S.D.N.Y.1978).

¹⁵ *Mallery v. NBC Universal, Inc.*, 2007 WL 4258196 (S.D.N.Y. 2007).

¹⁶ Paris, February 21, 1996, Juris-Data n° 1996-021471.

¹⁷ Pierre-Yves Gautier, *Propriété littéraire et artistique*, 6^{ème} édition, n° 41, p. 59, quoting Paris, May 12, 1909, DP 1910.2.81, 1^{ère} esp., note Claro, S., 1910.2.257, note Taillefer.

¹⁸ Paris, June 27, 2001, RIDA, April 2002, p. 426.

eventually gets attached to the child is in itself trivial, and commonly used in literature and film. This theme “cannot be subject to any appropriation beyond the specific development carried out and the creative input which conferred to this work its originality and defines the limits of the protection that the author may claim.” The Court applied block “B” of the flowchart.

TV formats. TV formats¹⁹ deliver “a smooth, well-tested mechanism” allowing “a reproducible or even guaranteed success.”²⁰ Because of their success, TV formats generate lawsuits on both sides of the Atlantic. One of the first U.S. cases to offer a detailed approach of the copyrightability of non-scripted TV shows involved two television networks, CBS and ABC²¹. CBS claimed that ABC infringed CBS’s copyright to the TV show *Survivor*²² with ABC’s own *I’m a Celebrity – Get Me Out of Here!*²³ (hereinafter “*Celebrity*”). After stating that the allegedly infringing TV show was a “combination of generic elements,” the Southern District Court of New York held that the works ought to be compared with regard to their “total concept and feel, theme, characters, plot, sequence, pace and setting.”²⁴ The court compared the “unalterable seriousness” of *Survivor* to the humoristic tone of *I’m A Celebrity*. Then, the court went on to compare the production techniques of the works, in particular the “lush, artful photography and painstaking etiquette” of *Survivor* versus the technique used in *Celebrity*, which was “closer to the home video look creating a drastically different look and feel.” The court examined the characters as if they were fictional characters linked to a particular storyline. The court contrasted the characters’ motivations, *Survivor* generating “cut-throat competition” while the candidates of *Celebrity* are mainly concerned about their public image and reputation without any competitive spirit. Analyzing the tests faced by the candidates, the court observed that the tests in *Survivor* were mandatory and “physically difficult,” noting in particular that “[i]mmunity challenges are particularly serious, because a life or death decision is made as a result of the immunity challenge.” On the contrary, the tests in *Celebrity* were voluntary and “essentially meaningless and silly or gross.” Finally, the court examined in more details its “favorite” scene, the “worm eating scene,” which was regarded as a *scène à faire*.²⁵ The Court considered the presentation of the worm sequence in *Survivor* where “the unattractive black worms are set out in a tribal-looking Wheel of Fortune layout” and where “the mood is tense and competitive,” so much so that a contestant got sick in front of the cameras. This dramatic tension contrasts with the scene in *Celebrity* where “the unattractive looking white worm appears on a banquet table with fine linens and fine China next to an absolutely delicious meal, which apparently the contestants can all smell,” concluding that such settings contributed to the “light-hearted” tone of the show, and underscore the differences in tone and spirit of the two shows. To dismiss the plaintiff’s claims, the court based its decision on blocks “B” and “C” of the flowchart, stressing that the

¹⁹ The concept of format is not defined in the French Intellectual Property Code. One decision (of first instance) in particular attempted to provide a definition or more precisely the criteria to render a format protectable: “To be protectable, the format must include the idea, the title, the configuration of the TV show, the structure and sequencing of the show or the series of show, i.e., the precise arrangement of the future work, the ideas being organized and classified, and the subjects precisely delimited.” See, TGI Paris, January 3, 2006, *Légipresse* 2006, 232-07 “Permis de conduire – Le grand test.”

²⁰ Christine Palluel et Philippe Larcher, *Le format de l’œuvre audiovisuelle à l’épreuve du droit d’auteur*, *Légipresse* 1999, II, 56.

²¹ *CBS Broadcasting, Inc. v. ABC, Inc.*, No 02 Civ. 8813, 2003 U.S. Dist LEXIS 20258 (S.D.N.Y. Jan. 13, 2003).

²² In this TV reality show, candidates are on a deserted island and have to adapt to their wild environment.

²³ In this TV reality show, it is celebrities who are brought in a deserted island setup.

²⁴ For a detailed analysis, see, Daniel Fox, *Harsh Realities: Substantial Similarity in the Reality Television Context*, 13 *UCLA Ent. L. Rev.* 223.

²⁵ The Court noting that “in a remote, hostile environment, or deserted island setup, eating unattractive, crawling creatures is part of the scenes a faire.”

creativity invested in the first work was irrelevant because the facts and ideas that were borrowed in the second work were not protectable.

In France, the Paris Court of Appeals refused to protect a TV format dedicated to senior citizens on the ground that it constituted a mere “unelaborated thread of a TV show that did not go beyond the expression of an idea in a simple framework form.”²⁶ The outline of format was described in only two pages, and the proposal included a particularly unoriginal description : “a 26-minute format, weekly, dedicated to citizens senior that would be an entertaining, playful program aiming at a large public.” Similarly, the proposal suggested episodes based on “sport, music, dance, fashion, and beauty,” the use of “digital captions” and the support of “hosts chosen among former radio and television stars.” The court found the proposal “devoid of any originality,” including elements “frequently used in practice.” In this case, the court limited its analysis to block “B” to dismissed the plaintiff’s claims.

In the *Fort Boyard – 1ère Compagnie* case²⁷, the defendant attempted to claim the parody exception under French law (block “D” of the chart). In this case, a reality TV show named *1ère Compagnie* used elements from a famous French game show called *Fort Boyard*²⁸ to compile a summary of the sequences of the daily show for the so-called “prime-time show.” The elements used included “the music, the name of the characters of the game show, the use of keys, the title, and especially the sequencing of the game.” Some elements, such as the names of the characters were not verbatim copies but puns based on the original names and intended to be humorous. The French court rejected the parody defense, holding that the purpose of the copying was “to energize the show, to provide a rhythm since the sequence consisted in repeats of sequences already broadcasted during the weeks which the audience has already seen.” The court therefore concluded that the borrowing was “strictly parasitic and aimed at benefiting from the notoriety of FORT BOYARD.” The court rejected the exception of parody and found copyright infringement.

Access. In the U.S. as in France, the discussion on infringement may involve an inquiry into whether the second author had access to the first work. In the U.S., block “A” and block “D” are essential parts of establishing copyright infringement. The plaintiff must demonstrate that the author of the second work had a reasonable and not merely theoretical possibility of access to the first work. The question of access can involve witness testimony and document discovery in the U.S. This differs significantly from France, where no discovery exists. In the U.S., if the plaintiff cannot satisfy the burden of proof by showing that the second author had a reasonable opportunity to have access to the first work, the discussion on infringement will stop there. Plaintiff will not have to make this showing, however, where that there are “striking similarities” between the two works²⁹. In France, the act of reproducing the work is traditionally considered sufficient to establish copyright infringement. The fact that the defendant is in good faith is irrelevant in civil proceedings³⁰. In criminal proceedings, a presumption of bad faith is drawn from the existence of significant similarities between two works³¹. On May 16, 2006, the French Highest Civil Court, the *Cour de Cassation*,

²⁶ Paris, September 25, 2005, Juris-Data n° 2005-286242.

²⁷ TGI Paris, March 5, 2008, Propr. intell., n° 28, p. 327, obs. J.-M. Bruguière.

²⁸ In this TV game show, contestants compete for keys and eventually prize money in physical challenges and logical riddles on a fort located on a small island akin to the Alcatraz island.

²⁹ See, *Arnstein v. Porter*, 154 F.2d 464 (2nd Cir. 1946) : “If evidence of access is absent, the similarities must be so striking as to preclude the possibility that plaintiff and defendant independently arrived at the same result.”

³⁰ Pierre-Yves Gautier, L’indifférence de la bonne foi dans le procès civil pour contrefaçon, *Propriétés Intellectuelles*, 2002, p. 2.

³¹ Pierre-Yves Gautier, *op. cit.*, n° 760.

recognized a defense based on “fortuitous encounters and reminiscences”³² (block “E”). Since the 2006 Supreme Court case, the Paris Court of Appeals applied the access test (block “A”) in France³³ in a dispute relating to the French film *La Totale* and its U.S. remake *True Lies*. The Court held that the plaintiff did not provide evidence showing that Claude Zidi, the screenwriter for *La Totale*, had access to the prior script entitled *Emilie*. The same reasoning prevailed in a very recent case involving the picture *Syriana*. The Paris Court of First Instance dismissed the case in part because there was no credible evidence that plaintiff had access to the first script. Plaintiff claimed that the script had been stolen from her computer disk by a computer hacker but provided no evidence to support her allegation. In France, the question of access (block “A”) and that of fortuitous encounters (block “E”) were previously merged within a single block (block “E”). A trend appears to be emerging in French case law to recognize a separate “block A.”

A reality TV show entitled *Project Runway*, which purports to identify the next great fashion designer through a contest hosted by the model Heidi Klum, recently gave rise to an interesting judgment in the U.S.³⁴ The Southern District Court of New York reaffirmed that the plaintiff has the burden of presenting evidence that the alleged infringer had a “reasonable opportunity” – and not a “bare possibility” – of access to the plaintiff’s work. In the *Project Runway* case, the Court found that plaintiff did not present any evidence to demonstrate the “creative role” of the individuals to whom plaintiff’s work has been presented. The recipients of plaintiff’s work contemplated collaborating with the production team of *Project Runway* and only discussed marketing and logistics issues. The court concluded that although it was “hypothetically possible that Defendants could have received the Treatment from employees [of its business partner],” this mere theoretical possibility was not sufficient. Plaintiff must demonstrate that the alleged infringers had a “reasonable possibility” to review or copy the plaintiff’s work. Even though the court could have stopped its analysis at that point, it went on to assess the similarities between the works. The court decided that the similarities identified were mainly *scènes à faire* naturally flowing from the underlying idea of a reality TV show about a fashion designer contest, i.e., “[t]he use of a panel of judges composed of fashion industry experts, a design workroom with sewing machines, a specific number of contestants, professional models, hairstylists, make-up artists, weekly episodes and the setting of New York.” Finally, the defendants were able to produce evidence of an independent creation (block “E”): The court acknowledged that the defendants “have also produced ample evidence that they created *Project Runway* independently of any purported exposure to

³² Cass., 1^{ère} Civ., May 16, 2006, Communication Commerce Électronique 2006, commentaire 104, note Christophe Caron “Djobi Djoba.” The legal provisions on which the decision is grounded evidence the importance of the opening statement of the Court : “Whereas the infringement of a copyrighted work result from its sole reproduction and cannot be dismissed unless the party challenging it demonstrates that the existing similarities between the two works proceed from a fortuitous encounter or reminiscences resulting in particular from a common source of inspiration.”

³³ See, also for an application of the access requirement prior to the *Cour de cassation* decision, Paris, September 24, 2003, Juris-Data n° 2003-228116, “Le Dénicheur – Amélie dite Casque d’Or.” In this case, the Court of Appeals of Paris stated that to establish the copyright infringement, the plaintiff ought to “establish the anteriority of the work to the allegedly infringing work and, should such evidence be produced, that the author of the second work had, under circumstances specific to each instance, the opportunity to have access to the first work.” Because the plaintiff did not demonstrate the anteriority of the first work, the Court shifted the burden of proof, stating that “the plaintiff did not account for the circumstances under which the defendant would have been able to have access to the [allegedly infringing] script” to confirm the first-instance decision, noting that “the analysis of the similarities between the contested book and the script was therefore an *obiter dictum*.”

³⁴ *Rodriguez and Zwiebach v. Heidi Klum Company et al.*, S.D.N.Y., 05-cv-10218-LAP.

the Treatment.” The court dismissed the plaintiff’s claim with a combined application of the blocks “A,” “B,” and “E” of the flowchart³⁵.

As noted above, the access test enabled the Court of Appeals in remand in the French *La Totale* case to dismiss the plaintiff’s claim.³⁶ As in the *Project Runway* case, plaintiff’s script had been communicated to an employee of a company doing business with the defendant, director and screenwriter Claude Zidi. There was, in theory, a possibility that the director had knowledge of the prior script but this mere possibility was not sufficient. The French court held that the plaintiff should have produced more substantial evidence that Claude Zidi could reasonably have gained knowledge of the existing work. The court discarded the plaintiff’s claims based on the block “A” of the chart, which is fairly audacious in France where the existence of block “A” is not traditionally recognized.

In the *Syriana* case mentioned above³⁷, the Paris Court of First Instance used the method applied by the Southern District Court of New York in the *Project Runway* case: it analyzed the matter using the block “A,” but then went to examine blocks “B” and “E” of the flowchart. The plaintiff claimed that the film *Syriana* was a copy of two of her scripts. The court concluded that the plaintiff did not produce evidence that the authors of *Syriana* had the opportunity to gain knowledge of the first scripts. (The court did not believe plaintiff’s story about the computer hacker.) In addition, the court found that the similarities between the two works were not substantial enough, also noting that the defendants demonstrated that most of the elements allegedly common to both works were based upon real facts (block “B”) on which the defendants conducted independent research (block “E”).

Conclusion: In most of the cases we reviewed, courts found no copyright infringement because plaintiff’s claim failed to satisfy one or more of the tests identified in our flowchart as necessary to establish infringement. Certain of these tests, in particular the blocks “B” and “C,” are necessarily subjective. Block “C,” in particular, is based on a global appreciation of the two works. Even though French and U.S. courts are supposed to focus mainly on the similarities between two works, the differences inevitably play a role in the outcome of the block “C” analysis. The uncertainties and the subjectivity linked to the substantial similarities test lead, in the U.S. at least, to tactical choices. Some plaintiffs prefer to bring a lawsuit before the federal courts of the Ninth Circuit, under the assumption that the Ninth Circuit courts are more inclined to protect copyright, whereas the courts in New York will favor freedom of speech. However, these assumptions may prove wrong in practice, because each judge will have his or her own view on the proper balance between freedom of speech and copyright. Each judge enjoys significant discretion, especially in preliminary hearings. In the course of a motion to dismiss or a motion for summary judgment, the U.S. judge has the power to decide the case based only on the evidence that has been produced by the parties at that point. The French equivalent is the summary (*référé*) proceedings brought before the *juge des référés*. Because of the high costs of a trial in the U.S., many cases end when a summary judgment is issued. At that stage, the discretionary power of the judge is significant.

³⁵ Another decision clearly described the relationship between *de minimis* originality and the possibility of independent creation. See, *Procter & Gamble Co. v. Colgate-Palmolive Co.*, 199 F.3d 74 (2nd Cir. 1999): “The fact that elements (or the combination of elements) of a work display the minimum creativity necessary to avoid the scenes a faire label for purposes of protectability does not eliminate the fact that those elements may be readily susceptible to independent creation. The less creative the choice, the stronger the inference that the same choice or group of choices made by another was made independently.” In this case, the common heritage was linked to the respect of customary practices of the advertising industry.

³⁶ Paris, December 19, 2007, *op. cit.*

³⁷ TGI Paris, November 12, 2008, *op. cit.*

In some cases, it can appear that a judge decides first whether a second work should be allowed to be released or not, and then builds reasoning to support the outcome, using the flexible tools offered by blocks “B” and “C” of the flowchart. The outcome may in large part be intuitive, based on the judge’s own convictions regarding the balance between freedom of speech and copyright. French courts are just as unpredictable. The contradictory decisions in the *La Totale* case illustrate this.

Unfair competition. The malleable nature of the blocks “B” and “C” often lead the alleged victims of copyright infringement to use other causes of action. Even though ideas may not be protected, idea theft may be sanctioned on the grounds of unfair competition, breach of an implied contract³⁸, parasitic conduct³⁹ or trademark infringement⁴⁰. In France as in the U.S., a plaintiff has to choose his or her main cause of action because it is not possible to obtain remedies for the same facts based on both copyright law, unfair competition and/or general civil law liability⁴¹. Unfair competition theories and other tort theories enable courts to punish idea theft and other inequitable conduct. These theories provide a safety net that may be used when copyright law is powerless. This security also permits judges that favor a strict delimitation of the boundaries between non-protectable ideas and protected expression to maintain this distinction while still sanctioning wrongful conduct.

Copyright exceptions. With regard to block “D,” the application of the fair use exception is as unpredictable and fuzzy as the issue of “substantial similarities.” The search for a balance between copyright and freedom of speech probably accounts for the flexible nature of the fair use exception. In the cases that we reviewed, fair use claims rarely succeeded. We came to a similar conclusion with regard to the exceptions provided in article L. 122-5 of the French Intellectual Property Code.

Access : toward convergence? Finally, as regards block “A” of the flowchart, the approach of French and U.S. courts appears to be converging. Block “A” was not part of the traditional analysis in French copyright law. The recent decisions reviewed above suggest an increasing consideration of access in French copyright cases. In the U.S., discovery proceedings make the access issue central to any copyright litigation. It is possible in the U.S. to rely on witness testimony and internal documents to demonstrate that an individual in fact had access to the prior work. In France, discovery is generally not available, which may explain why the access test was not traditionally given much if any weight in French copyright litigation.

The authors can be contacted at:

wjmaxwell@hhlaw.com; kmbolger@hhlaw.com; tzegane@hhlaw.com

³⁸ See, the “Tanguy” case, *op. cit.*, in which the Court held that the defendants violated a loyalty duty by transmitting the first script to the authors of the second work. The Court specified that such communication to a third party constituted a tort “that does not proceed from unfair competition because the parties were not competitors but from general civil law liability based on pre-contractual relationships of the artistic creation sector which necessarily entail the confidentiality of the documents communicated for review.”

³⁹ See, Versailles, March 11, 1993, JCP G 1994, n° 22271, note Jean-Christophe Galoux “La Nuit des Héros – Les Marches de la Gloire.” See also, Cass. Com.; February 7, 1995, pourvoi n° 93-14569, where the Highest French Civil Court rejected the plaintiff’s claims stating that the similarities identified by the Court of Appeals were sufficient to characterize a parasitic conduct, notwithstanding any consideration on the financial investments of the defendant.

⁴⁰ For U.S. case law on idea theft, see, *Desny v. Wilder*, 46 Cal.2d 715, 299 P.2d 257 (1956); *Blaustein v. Burton*, 9 Cal.App.3d 161, 88 Cal.Rptr. 319 (1970). See also, *Buchwald v. Paramount*, 1990 WL 357611 (Cal.Superior 1990) where the parties did sign an agreement. See also, Aaron J. Moss, Implied Contract Claims: No Agreement, No Breach, *The Hollywood Reporter, Esq.*, September 12, 2006.

⁴¹ For an exemplary condemnation under French law obtained on both copyright infringement and unfair competition because the plaintiff produced evidence of distinct facts, see, Paris, September 8, 2004, *Légipresse* 2005, III, 25, note Vincent Varet “Leeloo.”