

ARE IDEAS REALLY FREE AS THE AIR? RECENT DEVELOPMENTS IN THE LAW OF IDEAS

JOSEPH J. SIPRUT*

I. INTRODUCTION

Shocking as it always seems to non-lawyers, there is nothing inherently unlawful about deciding that someone else has a good idea and then ripping it off. The notion that ideas are “free as the air” has been an oft-quoted maxim since Justice Brandeis first coined the phrase in 1918.¹ But this general principle does have limits, and anyone that deals in the idea trade must understand those parameters.

Although many theft of idea cases stem from the entertainment industry, it is a mistake to think businesses and individuals operating in other industries will not encounter these issues. Businesses must innovate or die. Good ideas will always be important and will always have commercial value. Businesses must therefore be prepared to deal in the idea trade—both to monetize and protect their investments in ideas, and to manage their liability risk.²

* Joseph Siprut is a Chicago-based attorney and the founder of SIPRUT PC. His litigation practice includes the prosecution and defense of idea submission and copyright claims.

¹ *Int'l News Serv. v. Associated Press*, 248 U.S. 215, 250 (1918).

² *See, e.g., Wrench L.L.C. v. Taco Bell Corp.*, 256 F.3d 446, 451 (6th Cir. 2001) (creators of the “Psycho Chihuahua” cartoon character brought suit against Taco Bell for use of the Chihuahua idea in Taco Bell ad campaigns). Recently, Facebook and its founders faced a lawsuit brought by Connectu. *See Amended Complaint and Demand for Jury Trial, Connectu L.L.C. v. Zuckerberg* No. 04-11923-DPW (D. Mass. Oct. 28, 2004). Connectu’s founders were a group of college students at Harvard in the early 2000s, and alleged they created a venture similar to what Facebook would later become. *Id.* at 3. Mark Zuckerberg, one of Facebook’s eventual founders and a Harvard student at the time, was hired by Connectu to develop code for Connectu’s website. *Id.* The rest is history. Connectu brought claims for breach of contract, misappropriation of trade secrets, breach of fiduciary duty, unjust enrichment, intentional interference with prospect business advantage, breach of duty of good faith and fair dealing, and fraud. *Id.* at 1. The case later settled for what was intended to be an undisclosed sum, but the Associated Press discovered the terms of the settlement by copying and pasting from redacted portions of court documents posted online. *See* Jason Kincaid,

112 *IDEA—The Intellectual Property Law Review*

Generally, claims involving the wrongful use of an idea involve one of two familiar scenarios. In the first, the plaintiff comes up with an idea, proposes or “pitches” it to the defendant, and the defendant rejects the idea. The plaintiff then later discovers, to his or her amazement, that the idea has been used by the defendant in some sort of creative work—a film, a television show, a book, or the like. Claims based on these facts are known as “idea submission” claims.

In the second scenario, the plaintiff publishes a creative work, but does not necessarily have any contact with the defendant. The defendant simply sees and is able to access the plaintiff’s work somewhere, and then copies it to some degree. Common examples of the second scenario include developing a television show or writing a book that incorporates elements of a previously published work. In both scenarios, there are multiple factors that determine whether the plaintiff has a claim.

Although raw ideas are not themselves subject to legal protection, the *expression* of an idea can be subject to copyright protection. And if the wrongful use of someone else’s idea violates an agreement between the creator of the idea and the party that uses the idea, liability may attach under a contract theory. As a result, claims for the wrongful use of an idea generally must fit within the contours of copyright or contract law. This article will canvass the “law of ideas” by focusing on recent leading cases that analyze idea claims through the contract and copyright paradigms.³ In the last few years, several important cases have either clarified or changed the law of ideas. Anyone who deals in the idea trade must be aware of these cases and understand their practical implications.

II. IMPLIED CONTRACT CLAIMS

A. *Overview*

Individuals who wish to sell or license an idea generally have to rely on a contract theory to recover for the unauthorized or wrongful use of their idea. Under an express contract, a person to whom an idea is submitted expressly

The AP Reveals Details of Facebook/ConnectU Settlement with Greatest Hack Ever, TECHCRUNCH (Feb. 11, 2009), <http://techcrunch.com/2009/02/11/the-ap-reveals-details-of-facebookconnectu-settlement-with-best-hack-ever>.

³ This article primarily focuses on decisions issued by the Ninth Circuit and Second Circuit, because most of the leading cases in this area originate from those jurisdictions, and the law of those jurisdictions frequently applies to idea cases. Although state law applies to contract claims, idea cases usually end up in federal court because of the presence of copyright claims. There are a few instances where the laws of the Ninth and Second Circuits conflict with one another, and those situations are noted in the article.

promises to pay if the idea is used.⁴ A common example of an express contract in this context is a movie studio securing an “option” to make a movie based upon a writer’s treatment or screenplay. If the studio later makes a movie based on the writer’s work, the option agreement is triggered.

More commonly, idea submission claims will involve an implied contract. Under an implied contract theory, although there is no express agreement between the parties, the mutual assent of the parties to buy and sell the idea must still be clear—expressed through deeds or conduct, if not words.⁵ Like an express contract, recovery under an implied contract theory requires: mutual assent (both parties understood and agreed that the writer would be paid if the idea was used); consideration (compensation awarded for the service of conveying the idea); and breach (the idea was actually used by the defendant).⁶

B. Desny v. Wilder

Implied contract claims in the idea submission context are commonly referred to as “*Desny* claims,”⁷ after the 1956 California state case, *Desny v. Wilder*.⁸ In *Desny*, the plaintiff read a three-page synopsis about a man trapped in an underground cave to the defendant’s secretary over the phone.⁹ The plaintiff told the secretary that the defendant could only use the story if the defendant paid him, and the secretary agreed.¹⁰ The defendant then later produced the movie *Ace in the Hole*, about a man trapped in an underground cave.¹¹ The court set forth a two-prong test for recovering on implied contract claims in the idea submission context: the offer to convey the idea must be conditioned “upon an obligation to pay for it if it is used,” and the defendant, “knowing [this] condition before . . . know[ing] the idea, voluntarily accept[ed] its disclosure.”¹² The court also noted that the promise to pay can be made either before or just after the disclosure.¹³

⁴ See RESTATEMENT (SECOND) OF CONTRACTS § 4 cmt. a (1981).

⁵ See *Grosso v. Miramax Film Corp.*, 383 F.3d 965, 967 (9th Cir. 2004).

⁶ See *id.* (laying out the elements of a breach of implied-in-fact contract claim).

⁷ See *id.* (referring to a breach of implied-in-fact contract claim as a *Desny* claim).

⁸ 299 P.2d 257 (Cal. 1956) (en banc).

⁹ *Id.* at 262.

¹⁰ *Id.*

¹¹ *Id.* at 261.

¹² *Id.* at 270.

¹³ *Id.* at 270 (citations omitted); *Grosso v. Miramax Film Corp.*, 383 F.3d 965, 967 (9th Cir. 2004).

Although *Desny* created a framework for writers to establish idea submission claims, the rise of the Copyright Act gradually changed that. Courts began to hold that state law claims involving the wrongful use of an idea were preempted by the Copyright Act.¹⁴ The tide shifted again, however, in the landmark case of *Grosso v. Miramax Film Corp.*¹⁵

C. *Grosso v. Miramax*

In *Grosso*, the plaintiff filed a lawsuit alleging that the movie *Rounders* unlawfully incorporated ideas and themes from Grosso's screenplay, *The Shell Game*.¹⁶ Grosso brought claims for copyright infringement and breach of implied contract against Miramax and various other individuals and entities involved with the creation of *Rounders*, although Grosso had no previous contact with these defendants.¹⁷ Grosso claimed that he submitted his screenplay to a production company, Gotham Entertainment, which had a "first-look" deal with Miramax.¹⁸ The defendants filed a motion to dismiss the contract count on the grounds that the Copyright Act preempted it and a motion for summary judgment on the copyright claim.¹⁹ The district court granted both motions, and Grosso appealed to the Ninth Circuit.²⁰

The Ninth Circuit upheld summary judgment on the copyright claim because there was no substantial similarity between Grosso's screenplay and the *Rounders* movie.²¹ In particular, the court explained that the works do not share substantially the same "genre, mood, and pace; their themes, settings, and characters are different; their plots and sequences of events are not parallel."²²

¹⁴ See, e.g., *Entous v. Viacom Int'l, Inc.*, 151 F. Supp. 2d 1150, 1160 (C.D. Cal. 2001); *Selby v. New Line Cinema Corp.*, 96 F. Supp. 2d 1053, 1054 (C.D. Cal. 2000); *Worth v. Universal Pictures, Inc.*, 5 F. Supp. 2d 816, 822 (C.D. Cal. 1997). The Copyright Act supersedes state law rights that are equivalent to any of the rights within the general scope of copyright and that fall within the subject matter of copyright. See 17 U.S.C. § 301 (2006).

¹⁵ 383 F.3d 965 (9th Cir. 2004).

¹⁶ *Id.* at 967; *Grosso v. Miramax Film Corp.*, No. CV 99-10930 ABC (AIJx), 2001 U.S. Dist. LEXIS 26199, at *6 (C.D. Cal. Nov. 6, 2001).

¹⁷ *Grosso*, 2001 U.S. Dist. LEXIS 26199, at *9.

¹⁸ *Id.* at 12.

¹⁹ *Grosso v. Miramax Film Corp.*, 383 F.3d 965, 967 (9th Cir. 2004).

²⁰ See *id.*

²¹ *Id.*

²² *Id.* The copyright theory is separately analyzed below.

Are Ideas Really Free as the Air?

115

However, the court reversed the order dismissing the contract count on preemption grounds.²³

Channeling *Desny*, the court held that to recover on an implied contract theory, the writer must establish (1) he conditioned an offer to convey the idea upon an obligation to pay for it if it is used; and (2) the defendant, knowing this condition at the time the idea is revealed to him, voluntarily accepted its disclosure.²⁴ Additionally, the court stated that once the writer establishes this threshold requirement, the writer must establish (3) that the defendant actually used the idea.²⁵ The court held that implied contract claims can survive a preemption challenge because the “implied promise to pay” constitutes an “extra element that transforms the action from one arising under the ambit of the federal statute to one sounding in contract.”²⁶

The court remanded *Grosso* to the California state court, where the parties litigated the contract claim.²⁷ The court granted summary judgment for the defendants, finding that there was no evidence that the defendants had contact with the plaintiff, or that the plaintiff conditioned his disclosure on any obligation to pay for his ideas if used.²⁸

Grosso is an extremely significant ruling because for years, lower courts had dismissed writers’ implied contract claims on preemption grounds. For that reason, *Grosso* is generally regarded by commentators as a “boon” to writers.²⁹ Although *Grosso* sets forth a framework for pleading implied contract claims that can survive preemption, other cases have supplied additional principles that can apply to idea submission claims.

²³ *Id.*

²⁴ *Id.*

²⁵ Inference of use by the defendant can be “dispelled as a matter of law by direct evidence of independent creation.” *Hollywood Screentest of Am., Inc. v. NBC Universal, Inc.*, 60 Cal. Rptr. 3d 279, 290–91 (Cal. Ct. App. 2007).

²⁶ *Grosso*, 383 F.3d at 968.

²⁷ *Grosso v. Miramax Film Corp.*, No. B193872, 2007 WL 2585053, at *1 (Cal. App. 2 Dist. Sept. 10, 2007).

²⁸ *Id.* at *10.

²⁹ Nonetheless, as other commentators have pointed out, production studios and other corporate defendants that deal in the idea trade have now become increasingly reluctant to accept unsolicited material because of *Grosso*, which will tend to harm writers and other idea purveyors in the long run by increasing barriers to entry. See Shannon M. Awsumb, “*Idea Theft*” *Claims Post-Grosso: Did Grosso Really Change Anything?*, ENT. & SPORTS LAWYER, Fall 2006, at 14–15; Allison H. Weiner, *Lawyer Is Upping the Ante in Claims of Idea Theft in Hollywood*, N.Y. TIMES, July 27, 2006, available at <http://www.nytimes.com/2006/07/27/movies/27gadf.html>.

116 *IDEA—The Intellectual Property Law Review*

D. Industry Custom

Further adding to the *Desny* regime, in *Whitefield v. Lear*,³⁰ the Second Circuit Court of Appeals, applying California law, held that a contract can be implied based on the communications between the parties *and industry custom*.³¹ Under this theory, even if a defendant is not expressly informed about a conditional promise to pay, knowledge can be imputed if the conditional promise is standard in the industry.³² As a result of the *Whitefield* decision, many studios refuse to accept any unsolicited ideas unless the author signs a release giving up all rights to the material.

E. No Requirement of Novelty

Under California law, the idea at the core of the implied contract need not be “new” or “novel” as a precondition to recovery.³³ However, as an evidentiary matter, it will likely be harder to establish breach—“use” of the idea—if the idea is not novel. Under New York law, the case law is somewhat muddled and it is unclear whether novelty is a requirement.³⁴

F. Taking Inventory

These are the main lessons that can be distilled from the cases discussed so far:

1. If there is no contact between the plaintiff and defendant, then the basic elements of contract formation cannot be established (as was demonstrated in *Grosso*). Thus, if the plaintiff never directly submits the idea to the defendant, but the defendant uses the idea after obtaining it from some other source, there can be no implied contract between the plaintiff and defendant.

2. Even if the plaintiff submits his work directly to the defendant, that does not establish an implied contract. The plaintiff must submit the idea with

³⁰ 751 F.2d 90 (2d Cir. 1984).

³¹ *Id.* at 93.

³² *See id.*

³³ *See Blaustein v. Burton*, 88 Cal. Rptr. 319, 334 (Cal. Ct. App. 1970) (citations omitted); *Chandler v. Roach*, 156 Cal. App. 2d 435, 441–42 (Cal. Dist. Ct. App. 1957).

³⁴ *See, e.g., Brandwynne v. Combe Int'l, Ltd.*, 74 F. Supp. 2d 364, 375 (S.D.N.Y. 1999) (“To establish novelty, an idea ‘need not reflect the ‘flash of genius,’ but it must show[] genuine novelty and invention, and not a merely clever or useful adaptation of existing knowledge.”).

the expectation of payment and the defendant must be aware (and thus implicitly agree with) that expectation of payment.

3. Even if the plaintiff and defendant have no direct communications regarding the expectation of payment, however, such an expectation can be implied based on the custom of that industry.

4. The plaintiff's idea need not necessarily be new or novel to form the basis of an implied contract (although that requirement may vary by state), but it is harder to prove that the defendant actually used the idea if it is not novel.

III. COPYRIGHT INFRINGEMENT

A. Overview

As *Grosso* illustrates, in addition to implied contract theories, the other primary method of recovery for the unauthorized use of an idea is a copyright infringement claim.³⁵ To establish copyright infringement, a plaintiff must prove "ownership of a valid copyright" and copying by the defendant of "constituent elements" of the work.³⁶ Because it is usually not possible to present direct evidence of copying by the defendant, the plaintiff can establish copying "circumstantially, by demonstrating that the person who composed the defendant's work had access to the copyrighted material and that there is substantial similarity between the two works."³⁷

Not all copying constitutes copyright infringement, however. As the following cases illustrate, copyright infringement is perhaps best viewed as a spectrum in which liability (or lack thereof) is clear on both ends, but murkier in the middle. Many cases will invariably fall somewhere in that murkier middle area, which is what keeps lawyers in business.

³⁵ See *Grosso v. Miramax Film Corp.*, 383 F.3d 965, 967 (9th Cir. 2004).

³⁶ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

³⁷ *Meta-Film Assocs., Inc. v. MCA, Inc.*, 586 F. Supp. 1346, 1354–55 (C.D. Cal. 1984). Note, however, that just because a company *receives* the plaintiff's work does not necessarily mean that the defendant had *access* to the plaintiff's work within the meaning of copyright law. See *id.* at 1355. For example, under the "bare corporate receipt" doctrine, the bare corporate receipt of the plaintiff's work is insufficient where there is no evidence of a nexus between the recipients at the company and the alleged infringers. See *Jones v. Blige*, No. 04-60184, 2006 WL 3343741, at *5 (E.D. Mich. Nov. 17, 2006) (citation omitted), *aff'd*, 558 F.3d 485 (6th Cir. 2009). There must be some evidence that the plaintiff's work was conveyed to someone connected to the allegedly infringing work. See *id.* For a thorough analysis of the corporate receipt doctrine, see Lee S. Brenner & Allison S. Rohrer, *The Bare Corporate Receipt Doctrine*, 24 COMM'NS LAWYER 3 (2007).

B. Metcalf v. Bocho

In *Metcalf v. Bocho*,³⁸ the author of a television screenplay filed suit against television producer Steven Bocho and various other defendants for copyright infringement, based on similarities between the screenplay and a television show produced by Bocho.³⁹ The district court granted the defendants summary judgment on the ground that the screenplay and show were not substantially similar.⁴⁰ The Ninth Circuit reversed.⁴¹

The court identified the many similarities between the two works:

Both the Metcalf and Bocho works are set in overburdened county hospitals in inner-city Los Angeles with mostly black staffs. Both deal with issues of poverty, race relations and urban blight. The works' main characters are both young, good-looking, muscular black surgeons who grew up in the neighborhood where the hospital is located. Both surgeons struggle to choose between the financial benefits of private practice and the emotional rewards of working in the inner city. Both are romantically involved with young professional women when they arrive at the hospital, but develop strong attractions to hospital administrators. Both new relationships flourish and culminate in a kiss, but are later strained when the administrator observes a display of physical intimacy between the main character and his original love interest. Both administrators are in their thirties, were once married but are now single, without children and devoted to their careers and to the hospital. In both works, the hospital's bid for reaccreditation is vehemently opposed by a Hispanic politician. *The totality of the similarities . . . goes beyond the necessities of the . . . theme and belies any claim of literary accident. The cumulative weight of these similarities allows the Metcalfs to survive summary judgment.*⁴²

³⁸ 294 F.3d 1069 (9th Cir. 2002).

³⁹ *Id.* at 1072.

⁴⁰ *Id.*

⁴¹ *Id.* at 1075.

⁴² *Id.* at 1073 (emphasis added) (internal quotation marks omitted). The Ninth Circuit employs a two-part test—divided into “extrinsic” and “intrinsic” components—to determine whether there is substantial similarity (copying) of protected expression between the works at issue. *Id.* The extrinsic test is an objective analysis of concrete expressive element. *Id.* It “focuses on articulable similarities between the plot, themes, dialogue, mood, setting, pace, characters, and sequence of events” in the respective works. *Id.* The intrinsic test is a subjective analysis that focuses on whether the “ordinary, reasonable” audience would recognize the defendant’s work as a “dramatization” or “picturization” of the plaintiff’s work. *Berkic v. Crichton*, 761 F.2d 1289, 1292 (9th Cir. 1985).

The *Metcalf* court focused on the extrinsic test, finding that “on summary judgment, ‘only the extrinsic test is relevant,’ because a plaintiff avoids summary judgment by satisfying it.” *Id.* at 1073. The Second Circuit utilizes the “ordinary observer” test, under which

Are Ideas Really Free as the Air?

119

Although the similarities between the works were not protectable when considered individually, “the presence of so many generic similarities and the common patterns in which they arise do help . . . satisfy the extrinsic test.”⁴³ The court also stated that the plaintiff’s claim was “strengthened considerably by Bocho’s concession of access to their works.”⁴⁴

In subsequent opinions, the Ninth Circuit has held that not “any combination of unprotectable elements automatically qualifies for copyright protection.”⁴⁵ Instead, such a combination is eligible for copyright protection “only if those elements are numerous enough and their selection and arrangement are original enough that their combination constitutes an original work of authorship.”⁴⁶

“an allegedly infringing work is considered substantially similar to a copyrighted work if 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.” *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001) (internal quotation marks omitted). “[W]hen the works at issue contain considerable elements from the public domain that are unprotectable by copyright, the usual ‘ordinary observer’ test becomes ‘more discerning.’ Under this ‘more discerning’ test, the court must attempt to extract the unprotectable elements from our consideration and ask whether the protectable elements, standing alone, are substantially similar.” *Lapine v. Seinfeld*, 92 U.S.P.Q.2d 1428, 1433 (S.D.N.Y. 2009) (citations omitted) (internal quotation marks omitted); *see generally* *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628 (9th Cir. 2008).

⁴³ *Id.* at 1074. *Metcalf* is among the first Ninth Circuit opinions to hold that a work consisting entirely of generic, individually unprotectable elements was sufficient to satisfy the extrinsic test.

⁴⁴ *Id.* at 1075. This statement is consistent with the Ninth Circuit’s “inverse ratio” rule. *Jones v. Blige*, No. 04-60184, 2006 WL 3343741, at *5 (E.D. Mich. Nov. 17, 2006), *aff’d*, 558 F.3d 485 (6th Cir. 2009). Under that rule, the court requires a lower standard of proof on substantial similarity when a high degree of access is shown. *Id.* Conversely, a plaintiff may be excused from proving access if it can establish “striking similarity.” *See* *Smith v. Jackson*, 84 F.3d 1213, 1220 (9th Cir. 1996); *Shaw v. Lindheim*, 919 F.2d 1353, 1361–62 (9th Cir. 1990).

⁴⁵ *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003).

⁴⁶ *Id.* Preliminary drafts of the work may play a role in determining copyright liability. *See* Lee S. Brenner & Ken Kronstadt, *Evidence in the Wastebasket: The Use of Preliminary Drafts in Copyright Litigation*, COMM’NS LAWYER, Dec. 2009, at 3 (reviewing case law on the use of preliminary drafts of work in determining copyright litigation). Federal courts have long held that only the final version of the defendant’s work, as presented to the public, should be considered in determining substantial similarity. *Id.* However, preliminary drafts may be relevant to establish (or disprove) independent creation, or that the defendant had access to the plaintiff’s work. *Id.*

C. The “Reality Show” Context

1. *Rice v. Fox Broadcasting Co.*

*Rice v. Fox Broadcasting Co.*⁴⁷ involved two television shows that revealed the secrets of professional magicians.⁴⁸ The plaintiff, Robert Rice, owned the copyright to a 1986 home video entitled *The Mystery Magician*, in which a masked magician revealed how to perform well-known magic tricks.⁴⁹ About 17,000 copies of this video were sold worldwide.⁵⁰ In 1996, Fox Broadcasting began developing a series of television specials in which a masked magician revealed the secrets behind famous magic tricks and illusions.⁵¹ Fox aired four of the specials in 1997 and 1998.⁵²

Rice sued Fox for copyright infringement and false advertising.⁵³ Fox successfully moved for summary judgment on the copyright claim.⁵⁴ The Ninth Circuit affirmed, holding that Rice failed to satisfy the substantial similarity extrinsic test because his list of purported similarities between the two shows consisted entirely of “generic and inconsequential” elements.⁵⁵ Finding that “there are only a discrete number of ways to express a magician revealing the secrets behind magic tricks and illusions while disguising his identity,”⁵⁶ the court held that the expressive elements common to the two works were unprotectable by operation of the merger and scenes à faire doctrines.⁵⁷ The similari-

⁴⁷ 330 F.3d 1170 (9th Cir. 2003).

⁴⁸ *Id.* at 1173.

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *Id.*

⁵² *Id.*

⁵³ *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1174 (9th Cir. 2003).

⁵⁴ *Id.*

⁵⁵ *Id.* at 1177.

⁵⁶ *Id.* at 1176.

⁵⁷ *Id.* at 1177. An expression that is inherent in the treatment of a given idea is not protected. *Id.* at 1175. Thus, under the so-called “merger” doctrine, if an idea is capable of being expressed in only one way, the expression merges with the idea itself and is therefore not subject to copyright protection. *See id.* In comparing allegedly similar elements under the extrinsic test, courts must filter out any parts of the copyrighted work that are not protected. *Id.* at 1174. “[A] party claiming [copyright] infringement may place ‘no reliance upon any similarity in expression resulting from unprotectable elements.’” *Id.* (citations omitted). Under the related “scenes à faire” doctrine, “expressions indispensable and naturally associated with the treatment of a given idea ‘are treated like ideas and are therefore not protected by copyright.’” *Id.* at 1175 (citations omitted).

ties present in *Rice* included: an unidentified masked magician in a traditional magician's tuxedo and cape as the host, a "secret" location for filming without an audience, magic tricks that first were performed and then revealed and explained, a message that the purpose of the shows was to "inspire children," and an "overall mood of secrecy and mystery."⁵⁸

Rice sought to rely on "*Metcalfe* for the proposition that 'the cumulative weight of . . . similarities'" may allow a plaintiff "to survive summary judgment" under the extrinsic test.⁵⁹ The *Rice* court, however, distinguished *Metcalfe* in two ways. First, it construed *Metcalfe* as presenting an unusual "totality of similarities" and found that Rice's claim did not involve "the same pattern of generic similarities as in *Metcalfe*."⁶⁰ This approach may signal that the Ninth Circuit will read *Metcalfe* narrowly in the future as limited to cases presenting patterns of generic similarities that are uniquely alike.

Second, the Ninth Circuit distinguished *Metcalfe* by reading it as "based on a form of inverse ratio rule analysis."⁶¹ The court noted that although the *Metcalfe* opinion did not expressly invoke that rule, the *Metcalfe* court found the defendants' concession of access in that case to be an "important factor in its substantial similarity analysis."⁶² Moreover, *Metcalfe* involved an unusually high degree of access—including repeated, direct submissions of the plaintiffs' materials to the producer, who read and responded to those submissions of the allegedly infringing work.⁶³ Usually, however, "access" is typically defined as "an opportunity to view or copy [the] plaintiff's work."⁶⁴

2. *CBS Broadcasting, Inc. v. ABC, Inc.*: The "Survivor" Case

In *CBS Broadcasting, Inc. v. ABC, Inc.*,⁶⁵ CBS filed suit to enjoin ABC from broadcasting the reality series *I'm a Celebrity—Get Me out of Here*.⁶⁶ In *Celebrity*, eight "B-list" celebrities were dropped by helicopter into a remote

⁵⁸ *Id.* at 1176–77.

⁵⁹ *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1178–79 (9th Cir. 2003).

⁶⁰ *Id.* at 1179.

⁶¹ *Id.*

⁶² *Id.* at 1179 n.6.

⁶³ *Id.* at 1179.

⁶⁴ *See Three Boys Music Corp. v. Bolton*, 212 F. 3d 477, 482 (9th Cir. 2000).

⁶⁵ No. 02 Civ. 8813 (LAP), 2003 U.S. Dist. LEXIS 20258 (S.D.N.Y. Jan. 14, 2003).

⁶⁶ *See id.* at *1.

part of Australia, where they were forced to fend for themselves with few resources.⁶⁷ CBS claimed that the show infringed CBS's copyright in *Survivor*.⁶⁸

In particular, CBS alleged that *Celebrity* imitated the distinctive style and the look and feel of *Survivor*, and that *Celebrity* copied *Survivor*'s format of stranding a group of strangers in a remote and uncivilized location, requiring the contestants to fend for themselves, subjecting the contestants to artificial challenges, and eliminating them in ritualized ceremonies at the end of each episode.⁶⁹

The Southern District of New York denied CBS's preliminary injunction motion because the protectable expression of the two series was not substantially similar.⁷⁰ The court emphasized that it was "crucial to consider each program series as a whole."⁷¹ In so doing, the court concluded that the two programs shared a common idea, but presented that idea via "different expressions."⁷²

The court contrasted the "unalterable seriousness" of *Survivor* against the comedic tone of *Celebrity*.⁷³ The court also observed that the elimination ceremony in *Survivor* "is a highly ritualized sequence" occurring in the dark, with torches, and accompanied by "dramatic tribal-sounding music."⁷⁴ "Celebrity, on the other hand, [had] no comparable ritual."⁷⁵ The departing contestants on *Celebrity* are announced in the morning while the contestants are standing around drinking coffee and escorted "onto a completely silly-looking party barge with fireworks, waiters, and glasses of champagne."⁷⁶ And while *Survivor* utilized "lush, artful photography" and production values, *Celebrity* had a "home video look."⁷⁷ Based on these factors, the court concluded that the two series were "substantially different in concept and feel."⁷⁸

⁶⁷ *See id.* at *27–28.

⁶⁸ *See id.* at *4.

⁶⁹ *See id.* at *32–33.

⁷⁰ *Id.* at *46.

⁷¹ *CBS Broad. Inc. v. ABC, Inc.*, No. 02 Civ. 8813 (LAP), 2003 U.S. Dist. LEXIS 20258, at *19 (S.D.N.Y. Jan. 14, 2003).

⁷² *Id.* at *43.

⁷³ *Id.* at *26–27.

⁷⁴ *Id.* at *27–28. Misspellings in the quotations from the original transcript have been corrected.

⁷⁵ *Id.* at *28.

⁷⁶ *Id.*

⁷⁷ *CBS Broad. Inc. v. ABC, Inc.*, No. 02 Civ. 8813 (LAP), 2003 U.S. Dist. LEXIS 20258, at *29 (S.D.N.Y. Jan. 14, 2003).

⁷⁸ *Id.*

The court next considered the “setting” of each show and concluded that the mere concept of a remote, inhospitable locale was too “generic” to be protectable on its own.⁷⁹ Focusing on the “visual expression” of that generic concept, the court contrasted the “dry Outback bush area” featured in *Survivor* with the “dense vegetation” that provided the backdrop in *Celebrity* and found that the inhospitable settings were expressed differently.⁸⁰ The court also found that the “plot” of each series was expressed differently.⁸¹ In *Survivor*, the “contestants are required to participate” in challenges, “the challenges are physically difficult,” and the “[i]mmunity challenges are particularly serious,” and result in a “life or death decision.”⁸² By contrast, the *Celebrity* “challenges are voluntary,” silly, or gross rather than physically difficult, and only the loss of “upscale rations” is at stake.⁸³ In addition, while “the contestants vote each other off at the end of each episode” of *Survivor*, the contestants on *Celebrity* are ousted based upon home audience vote.⁸⁴

In sum, based upon all of these differences, the court concluded that CBS was “not likely to prove that a lay observer would consider the works as substantially similar to one another.”⁸⁵

D. The Game Show Context

In *Barris/Fraser Enterprises v. Goodson-Todman, Enterprises, Ltd.*,⁸⁶ the producers of a new game show pilot, *Bamboozle*, filed a declaratory judgment action seeking a ruling that their program did not infringe the copyright in the game show *To Tell the Truth*.⁸⁷

Both shows featured a panel of three contestants, two of which were “liars” who claimed to be telling the truth about an incident, talent, or identity, and a panel of celebrities who had to determine which contestant was telling the truth.⁸⁸ The court held that the raw “idea of a game [show] in which [con-

⁷⁹ *Id.* at *30–31.

⁸⁰ *Id.* at *30.

⁸¹ *Id.* at *33–34.

⁸² *Id.* at *34–35.

⁸³ *CBS Broad. Inc. v. ABC, Inc.*, No. 02 Civ. 8813 (LAP), 2003 U.S. Dist. LEXIS 20258, at *35–36 (S.D.N.Y. Jan. 14, 2003).

⁸⁴ *Id.* at *36–37.

⁸⁵ *Id.* at *42.

⁸⁶ 5 U.S.P.Q.2d 1887 (S.D.N.Y. 1988).

⁸⁷ *Id.* at 1887.

⁸⁸ *Id.* at 1888.

tants] lie and [a panel] guess[es] who is telling the truth is not” protected by copyright.⁸⁹ Moreover, “many of the similarities between” the two shows “flow[ed] from the logic and necessities of television game shows and as such [were] not protectable.”⁹⁰

Nevertheless, the court denied both parties’ summary judgment motions because of fact questions regarding whether the overall composition of *Bamboozle* infringed *To Tell the Truth*.⁹¹ The court held that “even though a television game show is made up entirely of stock devices, an original selection, organization, and presentation of such devices can . . . be protected, just as it is the original combination of words or notes that leads to a protectable book or song.”⁹²

E. Substantial Similarity in the Publishing Context: The Sneaky Chef

In *Lapine v. Seinfeld*,⁹³ cookbook author Missy Chase Lapine sued comedian Jerry Seinfeld and his wife, Jessica.⁹⁴ Lapine alleged that a cookbook authored by Jessica Seinfeld infringed the copyright of a similar book authored by Lapine.⁹⁵ Lapine originally submitted her cookbook proposal to HarperCollins on two separate occasions, but it was rejected both times.⁹⁶ Her cookbook was later published by Running Press under the title *The Sneaky Chef: Simple Strategies for Hiding Health Food in Kids’ Favorite Meals*.⁹⁷ Seinfeld’s book, *Deceptively Delicious: Simple Secrets to Get Your Kids Eating Good Food*, was published several months later by Collins, an imprint of HarperCollins, and reached number one on the *New York Times* best seller list.⁹⁸

⁸⁹ *Id.* at 1889.

⁹⁰ *Id.* at 1891. Misspellings in the original corrected.

⁹¹ *Barris/Fraser Enters. v. Goodson-Todman, Enters.*, 5 U.S.P.Q.2d 1887, 1891 (S.D.N.Y. 1988).

⁹² *Id.*

⁹³ 92 U.S.P.Q.2d 1428 (S.D.N.Y. 2009).

⁹⁴ *Id.* at 1431.

⁹⁵ *Id.* The Complaint also includes several state law claims, including for implied contract. *Id.* at 1431. The Court did not analyze the state law claims because it dismissed the federal claims and declined to exercise supplemental jurisdiction over the state claims. *Id.* The Court also analyzed Lapine’s trademark claim, although this article will not focus on the trademark claim. *Id.* at 1438–39.

⁹⁶ *Id.* at 1431.

⁹⁷ *Lapine v. Seinfeld*, 92 U.S.P.Q.2d 1428, 1431 (S.D.N.Y. 2009).

⁹⁸ *Id.*

Are Ideas Really Free as the Air?

125

After setting forth the basic elements of copyright liability, the court considered the substantial similarity between the two works, which “is to be guided by comparing the total concept and feel of the contested works.”⁹⁹ The court began the substantial similarity analysis by noting several fundamental principles. First, the court noted that “*scenes a faire*”—“scenes that necessarily result from the choice of a setting or situation”—are not protectable.¹⁰⁰ The court also noted “that individual recipes do not necessarily qualify for copyright protection.”¹⁰¹ Finally, the court stated “that the *idea* of camouflaging vegetables in children’s favorite foods is not copyrightable.”¹⁰² And because the “overlapping subject matter of the books—hiding healthy foods in dishes that children enjoy by including pre-made purees in popular types of kids’ foods”¹⁰³—was insufficient to establish substantial similarity, the court then considered specific allegations of copying.¹⁰⁴

The court stated that any similarities in “organization, pattern, structure and sequence” were simply unprotectable “[s]tock elements resulting from the initial choice of subject matter.”¹⁰⁵ Moreover, the two works had a completely different “look and feel” and appeared to be directed to a different audience.¹⁰⁶ In particular, “Lapine’s cookbook is a dry, rather text-heavy work”¹⁰⁷ while Seinfeld’s cookbook is bright and cheerful, full of different colors and various

⁹⁹ *Id.* at 1434 (internal quotations marks omitted). The Court noted that in the Second Circuit, courts usually apply the “ordinary observer test” in determining substantial similarity. *Id.* at 1433. However, “[u]nder certain circumstances, when the works at issue contain considerable elements from the public domain that are unprotectable [sic] by copyright, the usual ‘ordinary observer’ test becomes ‘more discerning.’” *Id.* Under the latter “test, the court must . . . extract the unprotectable [sic] elements from our consideration and ask whether the protectible [sic] elements, standing alone, are substantially similar.” *Id.* (internal quotation marks omitted). The Court held that it did not matter whether application of the “more discerning” test is proper, because there was not substantial similarity even under the ordinary observer test. *Id.*

¹⁰⁰ *Id.* at 1434.

¹⁰¹ *Id.* (citing 17 U.S.C. § 102(b) (2006), which excludes from copyright protection “any idea, procedure, process, system, method of operation, concept, principle, or discovery”).

¹⁰² *Id.* at 1435.

¹⁰³ *Lapine v. Seinfeld*, 92 U.S.P.Q.2d 1428, 1435 (S.D.N.Y. 2009).

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* at 1435–36 (“[W]hen a cookbook is based on a particular idea or theme . . . the individual recipes in that book are certain to share that common theme and will likely share certain similarities with recipes in other cookbooks based on the same idea.”).

¹⁰⁶ *Id.* at 1437–38.

¹⁰⁷ *Id.* at 1437.

patterns.”¹⁰⁸ Based on these factors, the court held that the works were not substantially similar for purposes of copyright liability.¹⁰⁹

F. Summary

Based on these cases, we can distill the following general principles:

1. To establish copyright infringement, a plaintiff must prove ownership of a valid copyright and copying (substantial similarity) by the defendant of “protectable elements” of the work.

2. If the purported similarities between the two works consist entirely of “generic” and “inconsequential” elements, the plaintiff will not meet the standard for copyright protection. That is, if there are only a “discrete number of ways” to express a particular idea, then under the merger doctrine, the expressions of that idea merge with the idea itself—and the idea is not subject to copyright protection.

3. Not “any combination of unprotectable elements automatically qualifies for copyright protection.” Instead, such a combination is eligible for copyright protection “only if those elements are numerous enough and their selection and arrangement are original enough” that their combination constitutes an original work of authorship.

4. A plaintiff may be held to a lower standard of proof on substantial similarity when a “high degree of access is shown.” A plaintiff may also be excused from proving access if it can establish “striking similarity.”

IV. CONCLUSION AND PRACTICE POINTERS

Let us return to some of the themes introduced in this article’s introduction. Claims involving the theft or unauthorized use of ideas often involve the submission of the idea (in some form) from the plaintiff to the defendant—“idea submission claims.” Generally these claims will be predicated on either an implied contract between the parties, or copyright infringement based on substantial similarity between the works. In other cases, there may be no contact whatsoever between the plaintiff and defendant. Claims in those cases can be predicated on copyright liability but not an implied contract.

In reality, it is a misnomer to think that the second category—pure copyright cases—involves the law of ideas in the first place. As discussed above,

¹⁰⁸ *Id.* “[T]he resulting feel is of a less formal, more conclusive work; the reader is one of a community of parents that includes the author.” *Id.* at 1438.

¹⁰⁹ *Id.* at 1438.

Are Ideas Really Free as the Air?

127

the Copyright Act does not protect ideas; it protects the *expression* of ideas. In this way, the Act strikes a balance between two competing goals. On the one hand, the law allows the owner of a creative work to exert a monopoly over that work for a period of time. This creates an incentive to invest resources in the development of creative works. On the other hand, the law encourages the evolution and development of the arts and sciences, which necessarily involves using and building on the ideas of others.

But while the Copyright Act does not extend protection to pure ideas, ideas can still be extremely valuable commercially. And therein lies a major dilemma: In order to sell your idea, you have to *tell* your idea. But how do you tell your idea without risk of losing it? The same way you take a gorilla's blood pressure: very carefully. And even then, the reality is that there will always be *some* risk that an idea, once let out of the bag, will be used by others in ways not originally intended. The key is to manage that risk. And that is true on both sides of the coin; corporate defendants that deal in the idea trade must understand how to navigate these waters without exposing themselves to liability.

With that in mind, here are some practice pointers that may help both idea purveyors and the recipients of those ideas:

- Those submitting ideas should try to get the recipient to execute a non-disclosure agreement. The terms of the agreement should require payment if the idea is used, and should make clear that the idea belongs to the disclosing party unless and until the parties execute a subsequent agreement relating to its use. If the agreement does not specify the terms of sale (what the owner of the idea gets paid if the idea is purchased), it should at least make clear that there is an *expectation* of payment.
- At a bare minimum, those submitting ideas should send a letter establishing the expectation of payment before or at the same time any dialogue takes place regarding the content of the idea. If no such dialogue is possible, then the letter may need to go with the idea itself, in written form. The letter should also establish that the idea is being submitted only on the condition that the idea remain confidential, and that all rights to the idea are reserved unless and until the parties agree to enter into a subsequent contract governing the idea.
- Corporate defendants that may receive ideas can choose between not accepting unsolicited ideas at all, signing or editing whatever agreements are thrust on them by those submitting the idea, or crafting their own standard agreement tailored for such situations.
- Those submitting an idea might try not to provide all the specifics, and to say only as much as necessary.

- In the case of completed creative works (a manuscript, screenplay, etc.), the author should consider registering the work with the United States Copyright Office. Registration is a prerequisite to filing a lawsuit for copyright infringement, and by registering the work before any infringement, the author becomes eligible for statutory damages.¹¹⁰ Recognize, however, that the creative work will no longer be a secret at that point.
- Both sides should keep records of what was discussed, with whom, where, and when.

These practice pointers may provide some helpful general guidance, but each situation must be evaluated independently. What works in some contexts will simply not be possible in others. For example, signing a non-disclosure agreement before revealing a commercial idea may be standard between two sophisticated corporate parties. However, if an unknown individual tried to get a major production company to sign a non-disclosure before revealing an idea, the production company would likely refuse to do so and would, one suspects, somehow find a way to survive without ever learning the idea.

Those wishing to submit an idea must therefore evaluate acceptable degrees of risk and balance that risk against the perceived value of potential opportunities. That is not an easy thing to do, but it is one of the ways that a good lawyer can help.

¹¹⁰ Under the Copyright Act, the remedies for infringement include either “the copyright owner’s actual damages and any additional profits of the infringer . . . or statutory damages.” 17 U.S.C. § 504 (a)(1) (2006). Statutory damages can be as high as \$150,000 if the infringement is deemed willful. 17 U.S.C. § 504 (c)(2) (2006). However, if the plaintiff “did not register [his] copyright *before* infringement,” the plaintiff “can only recover actual damages and profits under Section 504(b), not statutory damages under Section 504(c).” *Polar Bear Prods., Inc. v. Timex Corp.*, 384 F.3d 700, 708 n.5 (9th Cir. 2004).