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Cases of Note--Copyright and Patent: Substantial Similarity

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LEGAL ISSUES



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Cases of Note — Copyright and Patent: Substantial Similarity

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AMINI INNOVATION CORPORATION V. ANTHONY CALIFORNIA, INC. and JAMES CHANG. UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, 439 F.3d 1365; 2006 U.S. App. LEXIS 5383.

Anthony California, Inc. (Anthony) is a bedroom furniture designer/owner of the Sonoran and Hercules collections. **James Chang** is Prez and major shareholder (since it's a C-Corp — although why he chooses to pay corporate tax is a mystery).

Going to their Website, I can't identify what is being fought over. Presumably it was taken off the market.

Anthony's big rival is **Amini Innovation (Amini)**, which sells LaFrancaise and Paradiso collections.

Their Website has neither collection. Did these folks just agree to a draw and give up the disputed designs?

Amini went after **Anthony/Chang**, and **Anthony/Chang** won summary judgment. The appeal went to the U.S. Court of Appeals for the Federal Circuit.

Perhaps like me you did a double-take there. Why not those zany black-robed folks at the Ninth?

The U.S. Court of Appeals is in DC, created by Congress in 1982. It combined the Court of Customs and Patent Appeals with the appellate division of the U.S. Court of Claims. And tragically it ousted the Cosmos Club from a magnificent building.

It is the only appellate court with jurisdiction based not on geography but the subject matter of 28 USC § 1295. This covers an absolute grab-bag of stuff like appeals from the Northern Marianas and Guam, the Natural Gas Policy Act of 1978 (still with us), the Plant Variety Protection Act, the Economic Stabilization Act of 1970 (which is still with us). (This is only a sample. Seriously, the list of federal meddling is near endless).

But as to our issue, they took jurisdiction because the suit included claims for patent and copyright infringement. They cite 28 U.S.C. §§ 1292, 1295, 1338 (2005).

Anyhoo, back to our facts. **Amini** has copyright registrations for "carved ornamental

woodwork" in bedroom furniture as well as a patent for a bedframe.

And there it semi-makes sense that they're in the U.S. Court of Appeals. 28 USC § 1295 (a)(4)(A) has language about "appeals from post-grant review." But that's not what this is.

Copyright

The court applies copyright law as interpreted by the Ninth Circuit. **Atari Games v. Nintendo of Am.**, 897 F.2d 1572, 1575 (Fed. Cir. 1990) and we're sort of back on familiar ground. Design questions are a mix of fact and law. If reasonable minds could differ, summary judgment is a no-no. **Cavalier v. Random House, Inc.**, 297 F.3d 815, 822 (9th Cir. 2002).

In a copyright action, the plaintiff must show ownership and unauthorized copying. You must present evidence of literal copying or else access to the designs before coming up with the infringing ones. And there must be "substantial similarity" in the expression of the idea (remember the old expression v. idea dichotomy?). **Shaw v. Lindheim**, 919 F.2d 1353, 1356 (9th Cir. 1990).

There's no dispute as to **Amini** holding copyright. And there's no dispute that both parties use what is standard "carved ornamental" features in their furniture, to wit: "lion's paw, ball, reeds, leaf-and-flower motifs, foliate scrolls, C- and S-shaped scrolls, a serpentine decoration, a seashell motif, laurel wreaths, an iron-canopy rail, beads and moldings."

Yawn. You can hardly wait to get on a furniture Website.

But **Anthony/Chang** says he had no access and there is no "substantial similarity."

The Ninth Circuit applies an "inverse-ratio rule." They allow "a lesser showing of substantial similarity if there is a strong showing of access." **Three Boys Music Corp. v. Bolton**, 212 F.3d 477, 486 (9th Cir. 2000).

How do they dream these things up?

Incredibly, the court says the record doesn't show much in the way of access by **Anthony/Chang**.

And Amini was a company selling furniture to the public? Everyone had access.

But with their reasoning, **Amini** must make a strong showing of substantial similarity.

Now they had to separate protectable expression from unprotectable. See **Rachel v. Banana Republic, Inc.** 831 F.2d 1503, 1507 (9th Cir. 1987). A bed is a bed. Utilitarian design. Not protectable. "Carved ornamental woodwork" is protectable expression.

For similarity analysis, the Ninth Circuit has a two-part exam — extrinsic and intrinsic. For the extrinsic, they objectively look at specific criteria including "type of artwork involved, materials used, subject matter and setting." **Shaw v. Lindheim supra** at 1356. And that of course requires expert testimony.

As to intrinsic, they ask subjectively whether the "ordinary reasonable audience" would find real alike vis-à-vis "the total concept and feel of the works." **Cavalier v. Random House, Inc.**, 297 F.3d 815, 822 (9th Cir. 2002).

Well, they've certainly over-thought this. Aren't jurors supposed to be objective?

And wouldn't you know, they found the trial court screwed up and stuck "total concept and feel" in extrinsic. And this is key, because the Ninth puts extrinsic as a matter of law and intrinsic as typically a jury question.

So, our U.S. Court of Appeals then finds reasonable slobbs picked out of a phone book could differ on similarity.

And why, you well ask?

The lion's paw has an anatomically incorrect five toes in both designs!! And reed designs rising from the paws are very similar.

Gotcha!

There were a raft of similarities. I'm being unfair.

Finally We Get to the Patent Issue

You can indeed patent a design with functional and ornamental features.

Who knew? This seems like a topic for future investigation. I know. You can hardly wait.

Our test for infringement is whether that ordinary lad or lass would "be deceived" by

continued on page 54



Questions & Answers — Copyright Column

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QUESTION: *A university librarian writes that he receives notifications from Research Gate for his institution's faculty authors when new content becomes available on their Research Gate pages. He has seen publisher pdfs posted which appear to be directly contrary to the publisher's terms and conditions. In such cases, who is the infringing party? Sometimes the papers were added by a co-author but appear the faculty author's page. Does that matter?*

ANSWER: It is possible that the terms and conditions of a publisher are not violated at all. Some publishers permit such posting some years after publication, and to determine whether the posting is a violation would require a review of each publisher's terms and conditions. Assume, however, that the posting of an author's content does violate the publisher's terms and conditions; it is the poster who has infringed copyright by reproducing the article without permission of the copyright owner. Posting without permission by one other than the copyright owner typically is infringement unless the owner has given permission for the posting. A co-author who has not transferred the copyright can post the article without permission of the other co-author. But if the poster is not an author who owns the copyright, there likely is infringement if the publisher has not given permission.

QUESTION: *An employee at a small Christian publisher asks a question concerning a work of art. Recently, a piece of original art was purchased by church members and donated to the denomination because of its justice work in Nigeria. The organization is exploring the feasibility of making quality prints of this art and wants to include the appropriate copyright information (and/or credit line) on the prints. Who owns the copyright? Should the organization obtain permission before making copies? If so, what copyright information*



should be placed on the prints? Is the crucial date when the church acquired the work or the date that it was originally created?

ANSWER: When someone purchases a work of art, the copyright remains with the artist unless there is a written transfer of copyright (as opposed to transfer of the artwork itself). A typical sale of a work of art does not include a transfer of copyright. So, to make reproductions permission of the artist is required absent purchase of the copyright itself.

The crucial date is the date that the work was created and not the date of the church's acquisition. The appropriate information is (1) name of the artist; (2) year of creation (or copyright registration, if registered; and (3) the copyright symbol (or the word "copyright" or abbreviation "copr." The church may wish to include some other statement to indicate that the sale of the prints of the work support its justice work in Nigeria.

QUESTION: *If a colleague at another institution requests a copy of a journal article or book chapter via a professional listserv, may an academic library provide the requested copy?*

ANSWER: Yes, and the library should treat it as an interlibrary loan. The colleague would be the recipient as a part of the borrowing institution, which would be responsible for the recordkeeping.

QUESTION: *A public librarian asks whether the library may add music to a PowerPoint presentation to be shown solely to a group of its library assistants.*

ANSWER: Section 106 of the *Copyright Act* details the categories of copyrighted works. In the House Report that accompanied the Act, H.R. 94-1476, there is a statement that routine meetings of businesses and government personnel are not public performances, and a PowerPoint presented to employees of a public library is such a meeting for govern-

ment employees. The copying of the recording to play with the slides normally would require permission from the owners of the copyrights in both the underlying musical composition and the recording. It is very likely though that this use is a fair use due to the restricted nature of the performance. The library should guard against posting the PowerPoint with the music on the Web, however.

QUESTION: *When someone writes to letter to a member of the House of Representatives does the person hold copyright in the correspondence they initiate? The correspondence is now a part of a research collection at a university library.*

ANSWER: Letters written by members of Congress as part of their official duties are in the public domain as works by U.S. Government officials, but letters from constituents are different. Constituents are not public officials, so their letters are not in the public domain unless the copyright has expired. There is an argument, however, that there is an implied license to make the letter available along with the response from the member of Congress. Unless the research collection is to be placed on the Web, just having the letter in the collection presents no problem. Further, there may be no problem in posting the correspondence on the Web, but it would be preferable to obtain permission from the author of the letter.

QUESTION: *What constitutes a "signing" for works of visual arts? Does it count if the signature is stamped on the back of the work?*

ANSWER: This question relates to the *Visual Artists Rights Act* found at section 106A of the *Copyright Act*. It extends two additional rights to the creators of works of visual arts identified as one-of-a-kind paintings, sculptures, and photographs or fewer than 200 signed and numbered prints or reproductions thereof. The *Act* applies only to works that are publicly displayed, and the additional rights afforded to the artist are attribution and integrity, which endure only for the life of the artist. Attribution is the right to have any publicly displayed work attributed to the artist. The right of integrity is the right to prevent the intentional "distortion, mutilation, or modification" of a publicly displayed work.

"Signed" is not defined in the *Act*, but it likely envisions an actual signature. The *Free Legal Dictionary* defines signed as "a mark or sign made by an individual on an instrument or document to signify knowledge, approval, acceptance, or obligation." It further states that the word "signature" generally means written with one's own hand, but it is not critical that a signature actually be written by hand for it to be legally valid. Therefore, stamping the signature on the work may be sufficient. 🍄

Cases of Note from page 53

common features in the "overall design" of the two. See *KeyStone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1450 (Fed. Cir. 1993).

Our court holds that you should be getting the overall feel of the thing and not focusing on minute details in configuration. The trial court focused on the micro stuff and not the macro.

The trial court said **Amini's** design had "four hollow metal orb and bed posts" and **Anthony/Chang's** didn't. But they weren't addressing "overall similarity."

So summary judgment is reversed with each side bearing its own costs.

And they get to start all over again. Full employment for lawyers. Perhaps explaining the lack of lion's paw floral on the two company Websites. 🍄