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### Authoring Prior Art

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# Authoring Prior Art

*Joseph P. Fishman\**  
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*Patent law and copyright law are widely understood to diverge in how they approach prior art, the universe of information that already existed before a particular innovation's development. For patents, prior art is paramount. An invention can't be patented unless it is both novel and nonobvious when viewed against the backdrop of all the earlier inventions that paved the way. But for copyrights, prior art is supposed to be virtually irrelevant. Black-letter copyright doctrine doesn't care if a creative work happens to resemble its predecessors, only that it isn't actually copied from them. In principle, then, outside of the narrow question of whether someone might have drawn from a preexisting third-party source, copyright infringement disputes would seem to have little doctrinal use for prior art.*

*But that principle turns out to be missing a big part of what's actually going on in copyright litigation today. In this Article, we identify a surprising trend: parties in cases involving music are increasingly discussing anticipatory earlier works, and judges are increasingly holding it against them if they don't. The concept of prior art, once for inventors only, is now for authors, too.*

*A major cause for this change, we argue, is the influence of a small cadre of expert witnesses. We interviewed several of the most active experts in music copyright disputes, and we analyzed dozens of reports that they have filed over the last two decades. Our data revealed a group that has been focused on authorial prior art since well before the courts were. These experts' professional self-understanding, moreover, diverges sharply from the traditionally limited role that experts are supposed to play in evaluating copyright infringement. They view prior art research as a major part of their job. And for many of them, that research is important not just because it can sift between copying and*

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*independent creation, but also because it informs their normative view of what expression deserves legal exclusivity in the first place. Because of this expert community, prior art isn't just for patents anymore.*

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## INTRODUCTION

At the core of the patent system is the concept of “prior art,” the universe of information that already existed before a particular innovation’s development. An invention doesn’t merit a patent unless it’s sufficiently different from what society already knows.<sup>1</sup> The prior art, which defines the scope of that knowledge, sets the baseline against which patentability questions are measured.<sup>2</sup>

Elsewhere within the world of intellectual property (“IP”), by contrast, the notion of prior art is supposedly irrelevant. In copyright, the body of law that confers rights over authorial expression rather than technological invention, black-letter doctrine doesn’t care if a creative work happens to resemble some of its predecessors.<sup>3</sup> Any such

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1. See 35 U.S.C. §§ 102, 103 (requiring that inventions be novel and nonobvious to be eligible for a patent).

2. See, e.g., Timothy R. Holbrook, *Patent Prior Art and Possession*, 60 WM. & MARY L. REV. 123, 134 (2018).

3. See, e.g., *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345–46 (1991).

overlap is fine just so long as it resulted coincidentally from independent creation, not from outright copying. In principle, then, outside of the narrow question of whether someone might have directly drawn from a preexisting source, the notion of prior art should have no work to do in copyright.<sup>4</sup> As a result, in a leading treatise's words, "the search for prior art that frequently goes into challenging a patent does not form an inherent part of adjudicating copyright cases."<sup>5</sup>

Indeed, using the term in copyright discussions is a surefire way to brand yourself a doctrinal out-of-towner. On social media, IP experts "recoil" if they encounter such slippage and declare it "wrong" and "crazy."<sup>6</sup> Prior art, it's reasonably insisted, "is not a thing for copyright."<sup>7</sup> Likewise, treatise authors scold copyright defendants who try to surround the plaintiff's work with prior art in an effort to minimize its creativity<sup>8</sup>—to say nothing of any judge who is careless enough to let them do it.<sup>9</sup>

Yet however much commentators may try to keep prior art in the patent lane, it's not staying there. In this Article, we identify a surprising trend: parties in cases involving music are increasingly

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4. See, e.g., *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 610 (1st Cir. 1988) (holding that evidence of similar expression in works that predated the plaintiff's work could be relevant only for evaluating whether the plaintiff or defendant had actually copied something from those works, and that absent any such defense the evidence had therefore been "wholly irrelevant"); *BMS Ent./Heat Music LLC v. Bridges*, No. 04 CIV. 2584, 2005 WL 1593013, at \*4 (S.D.N.Y. July 7, 2005) (rejecting a defendant's argument concerning similar expression in earlier works because "[t]he concept of originality in copyright law is fundamentally different from concepts of anticipation and novelty in patent law").

5. See 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01[A][2] (2021 ed.); see also PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 1.14.2.2[C] (2021) ("Copyright law's relatively low standard for protection and its relatively high standard for infringement make it unnecessary for authors and publishers to conduct costly and often fruitless prior art searches."); Sylvia Ngo, *Egyptian Goddess v. Swisa: Patently Obvious? Reconciling the Ordinary Observer and Point of Novelty Tests*, 10 HOUS. BUS. & TAX L.J. 110, 128 (2010) (commenting that copyright's substantial similarity standard for infringement "surveys the entire view of a product as compared to another without regard to prior art").

6. Pamela Chestek (@pchestek), TWITTER (May 12, 2020, 3:51 PM), <https://twitter.com/pchestek/status/1260326833792397320> [<https://perma.cc/9XYY-F5BW>] ("Oh, this makes me recoil—'prior art' for copyrights, as in your registration will be invalid if there is 'prior art' . . . ."); Sharon K. Sandeen, Reply, FACEBOOK (May 27, 2020, 9:15 PM) (on file with author) ("This is the second time in two days that I have seen copyright and prior art used in the same sentence in judicial opinions. STOP. WRONG. CRAZY.").

7. Charles Duan (@charles\_duan), TWITTER (Sept. 1, 2018, 8:08 AM), [https://twitter.com/charles\\_duan/status/1035876966942105600](https://twitter.com/charles_duan/status/1035876966942105600) [<https://perma.cc/X3TR-EXYU>].

8. See 2 NIMMER & NIMMER, *supra* note 5, § 8.01[C] ("[T]he common practice of defendants at trial in pointing out a similar work created in antiquity, or at least prior to defendant's creation, is of no assistance unless the trier of fact believes that defendant copied from that prior work.").

9. 3 THOMAS D. SELZ, MELVIN SIMENSKY, PATRICIA ACTON & ROBERT LIND, ENTERTAINMENT LAW 3D: LEGAL CONCEPTS AND BUSINESS PRACTICES § 16:13.50 (2020) (criticizing any such judicial decisions as aberrations that "undermine[] the basic premise of copyright law that two authors can each create a protected work, if neither copied from the other").

discussing anticipatory earlier works, and judges are increasingly holding it against them if they don't. Take, for example, the 2020 case that dismissed an infringement claim for "fail[ing] to consider prior art," rendering the plaintiff's comparison of the parties' two works "legally deficient and irrelevant."<sup>10</sup> Or take another case from the same year that dismissed a claim for want of "any information about prior art,"<sup>11</sup> after the defendant had introduced three songs that overlapped with the allegedly copied expression.

These cases, along with many others we discuss here, aren't primarily about whether the defendant actually copied something from the owner—the only question for which earlier works are supposed to be relevant. They're about whether any copying mattered. Courts are using prior art, in other words, to assess the normative substantiality of any similarities they find. However much that analysis conflicts with traditional doctrine, in music infringement cases it's becoming remarkably common. The concept of prior art, once for inventors only, is now for authors, too.

A major cause for this change, we argue, is the influence of a small cadre of expert witnesses. We interviewed several of the most active experts in music copyright disputes, and we analyzed dozens of reports that they have filed over the last two decades. Our data revealed a group that has been focused on authorial prior art since well before the courts were. These experts' professional self-understanding, moreover, diverges sharply from the traditionally limited role that experts are supposed to play in evaluating copyright infringement. They view prior art research as a major part of their job. And for many of them, that research is important not just because it can sift between copying and independent creation, but also because it informs their normative view of what expression deserves legal exclusivity in the first place.

Through their written reports, expert witnesses have been invoking the concept of authorial prior art for at least the past two decades. Only in the last few years, however, have some judges begun to adopt the concept in their opinions. In the intervening time period, experts have been quietly functioning as what the law-and-social-norms literature might call norm entrepreneurs, working to influence decisionmakers' opinions on which kinds of copying are proper or improper.<sup>12</sup>

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10. *Johannsongs-Publ'g Ltd. v. Lovland*, Case No. CV 18-10009, 2020 WL 2315805, at \*5 (C.D. Cal. Apr. 3, 2020).

11. *Smith v. The Weeknd*, No. CV 19-2507, 2020 WL 4932074, at \*6 (C.D. Cal. July 22, 2020).

12. See, e.g., Cass R. Sunstein, *Social Norms and Social Roles*, 96 COLUM. L. REV. 903, 909 (1996) (coining the term "norm entrepreneurs" to identify individuals who work to change existing

If experts have been saying the same thing for so long, why have courts only just recently begun to voice their acceptance? The evidence we present here doesn't answer that question. But we suspect it may have something to do with recent doctrinal changes within copyright law in general and music copyright in particular. As we discuss below, the Supreme Court's elimination of the laches defense in copyright cases has made it easier to sue downstream creators over works that they created and commercialized decades ago. And since 2015's phenomenally high-profile jury verdict finding that the hit song "Blurred Lines" infringed Marvin Gaye's "Got to Give It Up," there's been a pervasive narrative among commentators that it's getting too easy to find liability for musical similarity between songs.<sup>13</sup> When a federal appeals court affirmed that verdict, the dissenting judge warned that the copyright owner had effectively "copyright[ed] a musical style," establishing "a dangerous precedent that strikes a devastating blow to future musicians and composers everywhere."<sup>14</sup> It wouldn't surprise us if developments like those are encouraging judges to consider prior art more frequently in copyright cases.<sup>15</sup>

Whatever other factors might be at play, we don't claim to curate all of them here. Our descriptive goal is to show the growth of a prior art doctrine within copyright law and to highlight forensic experts' role in fueling that growth. This small group probably isn't the only cause. But it has been an influential—and, to legal scholars, largely unexamined—agent of change behind the emerging reality that prior art isn't just for patents anymore.

Finally, we note here at the outset that while the notion of expert witnesses convincing judges to alter the substantive content of law might sound ominous, we think that in this context it's probably a good thing. The substantial similarity standard for infringement, a concept that appears nowhere in the Copyright Act, has always been developed by judges through common-law evolution.<sup>16</sup> If judges are exercising that

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social norms); Robert C. Ellickson, *The Market for Social Norms*, 3 AM. L. & ECON. REV. 1, 13–16 (2001) (distinguishing norm entrepreneurs from other opinion leaders).

13. See, e.g., Amy X. Wang, *How Music Copyright Lawsuits Are Scaring Away New Hits*, ROLLING STONE (Jan. 9, 2020, 2:08 PM), <https://www.rollingstone.com/pro/features/music-copyright-lawsuits-chilling-effect-935310/> [<https://perma.cc/2WMA-BFM3>] (reporting that due to a "boom in copyright lawsuits . . . the once-sleepy realm of music copyright law has turned into a minefield").

14. *Williams v. Gaye*, 895 F.3d 1106, 1138 (9th Cir. 2018) (Nguyen, J., dissenting).

15. We discuss these changes below at Part III.B.

16. See Jessica Litman, *Silent Similarity*, 14 CHI.-KENT J. INTELL. PROP. 11, 16 (2014) (noting that "[i]n the first third of the century, courts and lawyers articulated much of the doctrine that 21st century scholars see as intrinsic to copyright and firmly cemented in copyright's core."); Peter S. Menell, *The Mixed Heritage of Federal Intellectual Property Law and Ramifications for Statutory Interpretation*, in INTELLECTUAL PROPERTY AND THE COMMON LAW 63, 63

traditional common-law role in a way that's informed by experts whose arguments they find persuasive, we see nothing wrong with it. And, as we explain in this Article's conclusion, on the merits there's a lot that's right with it. Considering prior art allows judges to understand a work in its creative context rather than in a vacuum. It also provides those judges a tool that can help dispose of cases on summary judgment, generating a jurisprudence that can guide future actors in a way that black-box jury verdicts simply cannot. Given the baseline that copyright doctrine has already set for how broadly substantial similarity can be defined, we see greater consideration of authorial prior art by judges as a healthy development.

Part I begins with a review of prior art's central role in patent law and what used to be its virtually nonexistent role in copyright law. We show, however, that the concept has become increasingly central in judicial opinions on music infringement over the past two decades. In Part II, we move from the ultimate legal decisions to a close study of the expert witnesses who, we argue, are most responsible for causing this doctrinal shift. We make this argument drawing from both our interview data and experts' written reports that have been filed in litigated cases. Part III offers some possible theories as to why expert witnesses in music cases have converged around prior art—and taken courts along with them—despite decades of doctrine seemingly placing that approach off limits. Finally, a concluding section explains how our findings on the emergence of authorial prior art suggests both some immediate tactical lessons for practitioners as well as deeper structural reforms regarding the role of the expert in copyright litigation.

## I. THE CONCEPT OF PRIOR ART

Copyrights and patents are each supposed to promote innovation through the grant of their own form of exclusivity.<sup>17</sup> Copyrights cover works of authorship like books, music, and movies, while patents cover functional inventions like pharmaceuticals, smartphone components, and manufacturing methods. The same constitutional clause empowers Congress to legislate in both spheres in

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(Shyamkrishna Balganesch ed., 2013) (discussing the standards for patent and copyright infringement and concluding that “the judiciary’s imprint and evolving role are unmistakable and profound”).

17. See, e.g., *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 216 (2d Cir. 2012) (noting that both the copyright and patent systems “seek to encourage innovation”); Michael W. Carroll, *One for All: The Problem of Uniformity Cost in Intellectual Property Law*, 55 AM. U. L. REV. 845, 846 (2006) (“The law grants patents to inventors and copyrights to authors to encourage investments in technological and cultural innovation.”).

order to “promote the Progress of Science and useful Arts.”<sup>18</sup> The rationale that most U.S. commentators give for that power lies in the likelihood that informational goods, whether expressive or functional, would be undersupplied if imitators could easily enter the market and undercut the originator’s prices without having to bear the same fixed costs of creation.<sup>19</sup> A patent’s or copyright’s exclusivity thus offers an appropriability mechanism that could encourage investment in creative activity that might not otherwise occur.

But society ends up paying for that exclusivity. For consumers, the existence of IP rights can raise prices in the marketplace. And for downstream creators, it can complicate efforts to build on the protected product and develop a new one. As a matter of policy, then, it might be reasonable to limit protection to products that are genuinely new. If the ostensible innovator gives us something that we already have, after all, why incur all those social costs?

### *A. Prior Art in Patent Law*

Unsurprisingly, patent law doesn’t ask us to incur them. Ever since the nation’s first Patent Act, which offered protection only to contributions that were “not before known or used,”<sup>20</sup> the law has required an invention to be novel in order to be patentable. In the Supreme Court’s early encapsulation: “To entitle a man to a patent, the invention must be new to the world.”<sup>21</sup> Congress formally codified this novelty element in 1836, requiring any protectable invention to be, in a word, “new.”<sup>22</sup> That element remains codified today in sections 101 and 102 of the current Patent Act.<sup>23</sup>

Not only must an invention be new, but it must also be unconventional in some way. Even an entirely novel invention will be denied a patent if the differences between it and what came before

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18. U.S. CONST. art. I, § 8, cl. 8; *see also* *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’”).

19. *E.g.*, Mark A. Lemley, *The Economics of Improvement in Intellectual Property Law*, 75 TEX. L. REV. 989, 994 (1997); SUZANNE SCOTCHMER, *INNOVATION AND INCENTIVES* (2004).

20. Patent Act of 1790, 1 Stat. 109, 110.

21. *Pennock v. Dialogue*, 27 U.S. 1, 20 (1829) (emphasis omitted). An even earlier case explained that “if the thing was not originally discovered by the patentee, but had been in use, or had been described in some public work, anterior to the supposed discovery of the patentee, . . . the patent [shall be] declared void.” *Evans v. Eaton*, 16 U.S. (3 Wheat.) 454, 514 (1818) (emphasis omitted).

22. Patent Act of 1836, 5 Stat. 117, 118.

23. 35 U.S.C. § 101 (requiring that an invention be “new” in order to be patentable); *id.* § 102 (outlining specific conditions for satisfying this novelty requirement).



“would have been obvious . . . to a person having ordinary skill in the art to which the claimed invention pertains.”<sup>24</sup> In practice, according to the Court’s most recent exploration of the standard in *KSR International Co. v. Teleflex Inc.*, some activity may be creative but would nevertheless fall within the statute’s “ordinary skill” zone.<sup>25</sup> “A person of ordinary skill,” the Court said, “is also a person of ordinary creativity, not an automaton.”<sup>26</sup>

Of course, in order to assess whether an informational good is truly new and nonobvious, one first needs to know about what information society already has. Since the late nineteenth century, the U.S. patent system has called that universe of information the “prior art.” So far as we’ve been able to determine, the first legal usage of that term in the United States came in an obscure 1885 infringement decision, *McFarland v. Deere & Mansur Manufacturing Co.*<sup>27</sup> A few years later, and almost certainly more significantly, William Robinson’s influential treatise adopted the term.<sup>28</sup> Beginning in the last few years of the nineteenth century, judges began using “prior art” in the same sense that modern patent practitioners would immediately recognize.<sup>29</sup>

Following a series of Supreme Court nonobviousness decisions that continued to emphasize “prior art” in the 1930s and 1940s,<sup>30</sup>

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24. *Id.* § 103. Though now statutory, this nonobviousness element was originally judge-made. See Joseph P. Fishman, *Originality’s Other Path*, 109 CALIF. L. REV. 861, 868 (2021) (reviewing the growth of the nonobviousness doctrine in the second half of the nineteenth century).

25. 550 U.S. 398, 417 (2007).

26. *Id.* at 421; see also *id.* at 420 (“[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.”).

27. 22 F. 781, 783 (C.C.N.D. Ill. 1885) (assessing an attempt to invalidate a patent for lack of novelty by “look[ing] back into the prior art”). According to the West database, no subsequent authority has yet cited the case.

28. *E.g.*, 3 WILLIAM C. ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* 263 (1890) (“The identity of the prior art or article with the patented invention may be established by any kind of relevant testimony.”); *id.* at 267 (describing evidence that could convince a jury “that the prior art or article was identical with the patented invention”). Robinson’s addition of the “or article” language suggests that he was using “art” to refer to earlier published disclosures specifically, as distinguished from earlier physical embodiments that had been publicly exploited.

29. See, e.g., *Knapp v. Morss*, 150 U.S. 221, 224 (1893) (“In determining the proper construction to be placed upon [a patent’s claim], it is necessary to consider the action of the patent office upon the original application of the patentee, and also examine the prior art.”); *Duer v. Corbin Cabinet Lock Co.*, 149 U.S. 216, 221 (1893) (identifying “features of improvement not disclosed by the prior art”); *Gates Iron Works v. Fraser*, 153 U.S. 332, 348 (1894) (referring to a patent claim that had been granted because it “was an improvement on anything contained in the prior art”); see also *Determining the Validity of A Patent on Demurrer to A Bill in Equity*, 5 YALE L.J. 213, 215 (1896) (“In the trial of patent cases usually the most important element in passing on the validity of a patent is what is known as the state of the prior art; which is proof of what is old and in general use at the date of the invention.”).

30. See, e.g., *Altoona Publix Theatres v. Am. Tri-Ergon Corp.*, 294 U.S. 477, 486 (1935) (holding that an improvement on existing technology is not patentable if it is the “mere exercise of the skill of the calling or an advance plainly indicated by the prior art”); *Cuno Eng’g Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 88 (1941) (same).

Congress included the term as part of the new Patent Act in 1952. That Act's nonobviousness standard, still persisting today under 2011's most recent revision of the statute, withholds protection "if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious."<sup>31</sup> This provision requires fact finders assessing an invention's nonobviousness to, in the Court's words, determine "the scope and content of the prior art" as well as the "differences between the prior art and the claims at issue."<sup>32</sup> More recently, the Federal Circuit has explained that "the real meaning of 'prior art' in legal theory . . . is knowledge that is available, including what would be obvious from it, at a given time, to a person of ordinary skill in an art. Society, speaking through Congress and the courts, has said 'thou shalt not take it away.'"<sup>33</sup> Differentiation from the prior art thus stands as a central element of patentability for literally every invention.<sup>34</sup>

### *B. Prior Art in Copyright Law*

Now contrast that approach with copyright law's. Traditionally, copyright doctrine is perfectly content to hand out protection to a work that overlaps with earlier ones, just so long as that overlap was coincidental. If two works are created independently of one another, each can receive its own copyright regardless of how similar they are—and the later one does not infringe the earlier.<sup>35</sup> The work need only be original to its particular author, not necessarily new to the world. "Originality," the Supreme Court has stressed, "does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying. . . . [A]ssume that two poets, each ignorant of the other,

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31. 35 U.S.C. § 103; *see also* H.R. REP. NO. 1923, at 7 (1952) ("Section 103 . . . refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102.").

32. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

33. *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1453–54 (Fed. Cir. 1984).

34. *See* Holbrook, *supra* note 2, at 134 (arguing that "[d]efining what constitutes 'prior art' is a critical aspect of the gatekeeping function performed by the USPTO and the federal courts, ensuring that patents are awarded for only merit-worthy inventions" and that prior art provides the basis of every novelty and nonobviousness determination because "the invention must be compared to what came before it").

35. *See, e.g.,* *Mag Jewelry Co. v. Cherokee, Inc.*, 496 F.3d 108, 116 (1st Cir. 2007) (relying on the Nimmer treatise for the proposition that "a work is original and may command copyright protection, even if it is completely identical with a prior work, provided it was not copied from such prior work but is rather a product of the independent efforts of its author"); *Boisson v. Banian Ltd.*, 273 F.3d 262, 270 (2d Cir. 2001) ("Absent evidence of copying, an author is entitled to copyright protection for an independently produced original work despite its identical nature to a prior work, because it is independent creation, and not novelty that is required.")

compose identical poems. Neither work is novel, yet both are original and . . . copyrightable.<sup>36</sup> The most famous application of this principle belongs to Learned Hand, who in 1936 famously quipped, “[I]f by some magic a man who had never known it were to compose anew Keats’s Ode on a Grecian Urn, he would be an ‘author,’ and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats’s.”<sup>37</sup>

Over the years, commentators have offered a number of theories to explain this difference in copyright’s and patent’s tolerance for repetition. Clarisa Long, for example, points to copyright’s high information costs, arguing that it would be too burdensome to expect creators to sift through the entirety of copyrighted expression.<sup>38</sup> Paul Goldstein argues that the difference can be explained by what he perceives to be different outputs that each system is trying to stimulate: copyright seeks to encourage *abundant* information on the one hand, while patent law seeks to encourage *efficient* information on the other.<sup>39</sup> Jeanne Fromer has offered a supply-side theory rooted in the psychology of artistic creativity.<sup>40</sup> Because audiences value creative problem-finding in the arts and not just problem-solving, she argues, copyright rewards authors for their subjective expression regardless of whether that expression objectively resembles another’s.<sup>41</sup>

Whatever the rationale, it would seem that the concept of prior art should have little relevance to copyright as a doctrinal matter. The only uncontroversial exception would be if the defendant were using it to challenge whether copying had in fact occurred. That sort of challenge could come in two forms, one focused on the author’s creative process and the other on the accused infringer’s. First, since originality requires independent creation, a defendant might introduce prior art in order to argue that the putative author had actually derived the relevant expression from earlier sources. Second, because one cannot be liable for copyright infringement without actually copying from the

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36. Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345–46 (1991); *see also* Selle v. Gibb, 741 F.2d 896, 901 (1984) (“[T]wo works may be identical in every detail, but, if the alleged infringer created the accused work independently or both works were copied from a common source in the public domain, then there is no infringement.”).

37. Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 54 (2d Cir. 1936).

38. Clarisa Long, *Information Costs in Patent and Copyright*, 90 VA. L. REV. 465, 529–33 (2004); *see also* William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325, 345–46 (1989) (arguing that copyright’s independent creation defense is in part a function of how hard it is to search through the universe of copyrighted works).

39. *See* GOLDSTEIN, *supra* note 5, § 2.2.1.1.

40. Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 NW. U. L. REV. 1441, 1492–93 (2010).

41. *Id.* at 1493.

plaintiff's work, a defendant might also introduce prior art in order to show that the similarity at issue was merely coincidental.<sup>42</sup> Maybe similarities in earlier works strengthen the probability of independent creation by suggesting that the allegedly copied expression is the sort of thing that artists working separately from each other will all naturally gravitate toward. Or maybe they support an inference that the defendant had copied not from the plaintiff but from an unrelated third party who happened to have written the same thing.

In circumstances where there's a legitimate concern that the accused copyist has independently created or that the author has not, we'd of course want to know what works had already come before. But those concerns are rarely implicated. In copyright's grand scheme of things, validity seldom falters on an imposturous author's clandestine copying.<sup>43</sup> Infringement liability likewise seldom falters on mislabeling an act of coincidental re-creation as an act of copying.<sup>44</sup> Authors simply don't converge around identical literary expression anywhere near as often as inventors converge around identical solutions to technological problems.

Given that rarity, we should expect prior art to come up only infrequently in copyright cases. As Paul Goldstein summarizes in his copyright treatise, the independent creation doctrine renders it "unnecessary for authors and publishers to conduct costly and often fruitless prior art searches" and "assure[s] them protection for their works—and freedom from liability for infringing copyright in the works of others—so long as they do not copy from other works."<sup>45</sup>

Yet as the remainder of this Part shows, in a growing number of cases copyright prior art searches may no longer be so unnecessary after

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42. See *Rentmeester v. Nike, Inc.*, 883 F.3d 1111,1117 (9th Cir. 2018).

43. See, e.g., John F. Duffy, *Inventing Invention: A Case Study of Legal Innovation*, 86 TEX. L. REV. 1, 9 (2007) (arguing that "claims of true independent duplication are much more rare" for copyrightable works than they are for patentable inventions and that copyright policy can afford to grant protection over similar but independently created works, despite the social inefficiency of redundant output, because "independently created copyrighted works are so unlikely to be identical that the problem of wasteful duplication is negligible").

44. See, e.g., Dan L. Burk, *Method and Madness in Copyright Law*, 2007 UTAH L. REV. 587, 599–600 (2007) ("[I]ndependent re-creation is a defense to a claim of copyright infringement. But we assume both as a matter of evidence and as a matter of causality that the chances of independently re-creating a Picasso painting or a Moby soundtrack, or Keats' *Ode on a Grecian Urn*, are vanishingly small."); Clark D. Asay, *Independent Creation in a World of AI*, 14 FIU L. REV. 201, 211 (2020):

[I]n many copyright contexts, independent creation is simply an impossibility, such that the defense rarely if ever plays an important role in limiting copyright. And while in other contexts we may often point to independent creation as playing a role in allowing parties to develop similar works, typically the idea-expression, scenes a faire, and merger doctrines do much of the actual work in limiting copyright protections.

45. GOLDSTEIN, *supra* note 5, § 1.14.2.2[C].

all. In spite of its black-letter irrelevance, prior art has provided the basis for many challenges to a copyrighted work's originality over the last century. For almost all of that time, as we discuss below in Section I.B.1, those challenges all failed. But over the last two decades, multiple copyright cases involving musical similarity have assessed the protectability of a plaintiff's expression by focusing patent-style on whether that expression had been anticipated in the corpus of earlier works.

We survey this modern case law in Section I.B.2. We find that, like patent law, these cases are surprisingly willing to reject an infringement accusation if the plaintiff's material turns out to resemble earlier contributions, regardless of whether the plaintiff was ever actually aware of them. Indeed, many decisions expressly refer to those contributions as "the prior art." The key analytical move in these cases is that prior art can weaken the plaintiff's claim even if the plaintiff had come up with its overlapping material entirely independently. The mere existence of the earlier works is enough to make the defendant's alleged appropriation unactionable.

In two important respects, however, this nascent concept of authorial prior art differs from patent law's version. First, unlike in patent challenges, the copyright cases aren't invoking prior art in order to invalidate the entitlement altogether. Instead, they're doing it in order to modulate the substantiality of the similarity between parties' works: a similarity is more substantial if the author's expression is genuinely novel, and less substantial if the author's expression turns out to have been done before. Second, patent law follows a one-and-done model in which a single prior-art reference can preclude protection.<sup>46</sup> In these copyright cases, by contrast, magnitude matters. The copyright version seems to depend on finding some unstated number of earlier works, rather than just flipping on a switch by finding a single one.

Before we get there, though, we ought to explain how the reasoning that we're tracking in these cases differs from another staple copyright doctrine known as "scènes à faire."<sup>47</sup> That judge-made

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46. Patentability doctrines do not especially care whether there is a lot of prior art or a little, just so long as the relevant information can be found somewhere within it. A claimed invention will fail the novelty requirement if all of its elements are already contained in a single prior-art reference, no matter how obscure. *See, e.g., In re Hall*, 781 F.2d 897, 900 (Fed. Cir. 1986) (holding that an applicant's invention was anticipated, and therefore unpatentable, based solely on one doctoral thesis in a German university library). Similarly, while the nonobviousness standard will typically survey multiple references to see if their combined teachings would predictably lead to the claimed invention, it assigns no greater weight if many of those references say the same thing.

47. Judge Leon Yankwich coined the term for copyright purposes in *Cain v. Universal Pictures Co.*, 47 F. Supp. 1013, 1017 (S.D. Cal. 1942). He wrote that plot elements that were "inherent in the situation itself" or "what the French call 'scenes a faire,'" would "necessarily [be] associated with such a situation," and that "such similarities and incidental details necessary to

limitation on copyright scope teaches that “a copyright owner can’t prove infringement by pointing to features of his work that are found in the defendant’s work as well but that are so rudimentary, commonplace, standard, or unavoidable that they do not serve to distinguish one work within a class of works from another.”<sup>48</sup> To the extent that the defendants in the cases below are trying to invoke earlier works in order to prove commonality, one might reasonably guess that they’re ultimately arguing a version of *scènes à faire*, whether they call it that or not.<sup>49</sup>

We think, however, that here again there are two significant differences between that doctrine and the reliance on prior art that we discuss here. First, *scènes à faire* is meant to apply only where the allegedly copied expression has truly become standardized (think shoot-outs outside a saloon in a Western film). By contrast, many of the prior art arguments discussed here don’t depend on a theory of standardization; instead, they’re content to show that the expression has simply appeared enough times to be unextraordinary.<sup>50</sup>

Second, according to several decisions, *scènes à faire* is supposed to be specific to a work’s genre, not a freeform search for anticipatory materials lurking anywhere they might be found.<sup>51</sup> The Ninth Circuit, for example, rejected a *scènes à faire* defense in a music infringement case where the songs were “not in the same relevant ‘field’ of music.”<sup>52</sup> Categorizing the plaintiff’s work within a “hip-hop/R & B genre” and the proffered third-party work within the “folk music genre,” the court concluded that comparing one with the other was unhelpful because it didn’t answer whether the allegedly similar elements were “an indispensable idea” specifically within the genre in which the author was working.

Thus, as Bob Clarida recently put it, *scènes à faire* “is not a novelty standard, this is not saying ‘has anything ever had this element

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the environment or setting of an action are not the material of which copyrightable originality consists.” *Id.*

48. *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 929 (7th Cir. 2003).

49. *Cf. Dale Cendali, Litigating Scènes à Faire*, 43 COLUM. J.L. & ARTS 415, 417 (2020) (noting that “expert witnesses are so important in trying to establish *scènes à faire*” because they “could help provide more information as to what is truly common”).

50. *See, e.g., Smith v. The Weeknd*, No. CV 19-2507, 2020 WL 4932074, at \*3 (C.D. Cal. July 22, 2020) (dismissing an infringement claim based on only three works in the prior art).

51. *See Gable v. Nat’l Broad. Co.*, 727 F. Supp. 2d 815, 837–38 (C.D. Cal. 2010), *aff’d*, 438 F. App’x 587 (9th Cir. 2011):

[C]omparisons to prior art are only helpful to the extent that they are genre-specific. . . . [I]t is not helpful to simply point out that certain past works also included a particular element; rather, to demonstrate that the element is not protectable, it must be shown that such an element is standard or indispensable in [that genre].

52. *Swirsky v. Carey*, 376 F. 3d 841, 850 (9th Cir. 2004).

in it—but another work *in the genre*, that’s really the relevant question.”<sup>53</sup> As we’ll see, though, the prior art arguments that we track here are pretty much asking exactly that first, forbidden question: whether *anything* ever had the relevant element in it. The identification of, say, a twelve-bar-blues chord progression in a Romantic-period piano sonata should not be able to support a *scènes à faire* argument since that progression is not commonplace in that genre. It could, by contrast, qualify as prior art that helps weaken the substantiality of an alleged similarity between the parties’ works.

### 1. Early Case Law

The first usage of the term “prior art” in a reported copyright case occurred in an otherwise unremarkable 1929 decision over decorative shoebox labels. In *Hoague-Sprague Corp. v. Frank C. Meyer Co.*, the court concluded that the author’s label design was sufficiently original notwithstanding the many “anticipations” that the defendant had highlighted.<sup>54</sup> It reasoned that the defendant’s evidence didn’t matter because the plaintiff’s work was “not a copy of any of the prior art offered in evidence, and the originality required in case of copyright means little more than a prohibition of actual copying.”<sup>55</sup> While the terminology might displease copyright purists, the proposition should look substantively familiar to modern practitioners: we care about earlier works in copyright cases only for purposes of identifying actual copying.

Over the next decade, defendants in several cases repeated the same strategy without much success. One example comes from one of the most famous copyright decisions in U.S. history, *Nichols v. Universal Pictures Corp.*<sup>56</sup> The plaintiff, a playwright who created a massively popular Broadway play, accused a Hollywood studio of making a nonliterally infringing film. Judge Learned Hand authored the appellate decision rejecting her claim. That decision has become a law school casebook staple primarily for its discussion of the distinction

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53. Robert W. Clarida, *Making Sense of Scènes à Faire Through the Lens of Feist*, 43 COLUM. J.L. & ARTS 419, 420 (2020); *see also id.* at 422 (observing that the doctrine “seems to say that an element can be protectable if it’s used in a work in *this* genre, but not if it’s used in a work in *that* genre”); Robert Kirk Walker, *Breaking with Convention: The Conceptual Failings of Scènes à Faire*, 38 CARDOZO ARTS & ENT. L.J. 435, 456, 458 (2020) (“When courts ask what incident, characters, or settings are practically ‘indispensable, or at least standard, in the treatment of a given topic,’ they are implicitly asking: To what genre does this work belong? . . . [E]valuating *scènes à faire* mainly comes down to understanding genre conventions . . .”).

54. 31 F.2d 583, 586 (E.D.N.Y. 1929).

55. *Id.*

56. 45 F.2d 119 (2d Cir. 1930).

between protectable expression and unprotectable ideas. But the defendant didn't chiefly rely on any such distinction in litigating the case. Instead, it argued extensively that any similarities between the two works had already been anticipated in over seventy different works, which it repeatedly and conspicuously labeled "the prior art" throughout its appellate brief.<sup>57</sup> The plaintiff, for her part, offered a witness at trial who testified as "an expert on the prior art" that the work in suit was full of elements not previously found in "any play or structure in literature."<sup>58</sup>

That argument failed to impress the trial judge, who dismissed the claim after finding that the thematic similarities were "not new" and thus "common property."<sup>59</sup> On appeal, the plaintiff faulted the defendant for bringing a patent to a copyright fight. It's no defense against an independent creator, she argued, to invoke "prior art and/or public domain, unless the alleged infringer is able to connect himself with prior art and/or public domain as the source from which he derived the alleged infringing work."<sup>60</sup> The prior art might very well be "open to all who tread it," but it should not be "a defense to those who invade the closes of others, however similar to prior art and/or public domain."<sup>61</sup>

The plaintiff may have been right about that, but she lost the appeal anyway. The Second Circuit held that, regardless of what earlier material the author might have previously been aware of, she was impermissibly trying to extend copyright protection over ideas and stock themes.<sup>62</sup> The alleged similarities with the defendant's film were simply too abstract to merit protection. The battle over prior art that occupied so much attention at trial and during the appeal received only the faintest gesture in the court's opinion, which was willing to concede "that the plaintiff's play was wholly original" and "that novelty is not essential to a copyright."<sup>63</sup> Still, it concluded, "there is no monopoly in such a background. Though the plaintiff discovered the vein, she could not keep it to herself; so defined, the theme was too generalized an abstraction from what she wrote. It was only a part of her 'ideas.'"<sup>64</sup>

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57. See Brief for Appellee at 82–83, *Nichols*, 45 F.2d 119 [hereinafter *Nichols* Appellee Brief]. As Jessica Litman notes in her close reading of the *Nichols* case file, the defendant "directed major efforts to finding as many works as possible that resembled" the plaintiff's play. Litman, *supra* note 16, at 34.

58. *Nichols* Appellee Brief, *supra* note 57, at 82 (citing trial record).

59. *Nichols v. Universal Pictures Corp.*, 34 F.2d 145, 149 (S.D.N.Y. 1929).

60. Brief on Behalf of Appellant at 7, *Nichols*, 45 F.2d 119 (No. 4).

61. *Id.* at 7–8.

62. *Nichols*, 45 F.2d at 122.

63. *Id.*

64. *Id.*



A few years later, a defendant tried a similar approach in *Arnstein v. Edward B. Marks Music Corp.*<sup>65</sup> The case involved similar pop songs,<sup>66</sup> probably the first of what in the next Section we show would become a long line of music cases where the defense tried to minimize the originality of the author's work by introducing anticipatory prior art.<sup>67</sup> It contended that the plaintiff's music consisted of nothing more than sequences that "were to be found in previous musical compositions of some of the great musical masters of the past."<sup>68</sup> The court rejected that argument on the ground that requiring a composition to be original to its composer "does not necessarily mean it is an absolutely new production."<sup>69</sup>

One of the clearest rejections of such an anticipation defense came in another Learned Hand chestnut decided the following year, *Sheldon v. Metro-Goldwyn Pictures Corp.*<sup>70</sup> That case is probably most famous today for Learned Hand's memorable line, already mentioned above, that imagined competing yet somehow independently created "Odes on a Grecian Urn."<sup>71</sup> Less frequently quoted is Hand's language that immediately preceded that line:

We are to remember that it makes no difference how far the play was anticipated by works in the public demesne which the plaintiffs did not use. The defendants appear not to recognize this, for they have filled the record with earlier instances of the same dramatic incidents and devices, as though, like a patent, a copyrighted work must be not only original, but new. . . . [I]t is plain beyond peradventure that anticipation as such cannot invalidate a copyright.<sup>72</sup>

This passage from *Sheldon* served as Hand's emphatic proclamation of the point that he only gestured at six years earlier in *Nichols*. Authors cannot be anticipated.

65. 11 F. Supp. 535 (S.D.N.Y. 1935), *decree aff'd*, 82 F.2d 275 (2d Cir. 1936).

66. Or, as the district court put it in a scathing review nested within a judicial opinion, "[n]either is a work of great merit, both being popular songs of the kind that have a limited vogue and soon pass into the great limbo of forgotten songs, never to be resurrected." *Arnstein*, 11 F. Supp. at 535.

67. See *infra* Section I.B.2.

68. *Arnstein*, 11 F. Supp. at 535.

69. *Id.* at 536. Curiously, the court thought that this principle made copyright more like patent law, not less. It continued:

[A] new arrangement of an old piece may be copyrighted, provided it is more than a mere copy with variations, and *the same test is to be applied as in the case of patents*; that is, it must indicate an exercise of inventive genius as distinguished from mere mechanical skill or change.

*Id.* (emphasis added). For more on the line of copyright cases demanding patent-like "inventive genius," see Fishman, *supra* note 24.

70. 81 F.2d 49 (2d Cir. 1936).

71. *Id.* at 54; see *supra* note 37.

72. *Sheldon*, 81 F.2d at 54.

Barely a month later, in perhaps the most surprising turn in this history, the chairman of the House Committee on Patents introduced a copyright reform bill that seemingly rejected Hand's premise.<sup>73</sup> The bill was one of several attempts at a general revision of the 1909 Copyright Act by Congressman William Sirovich.<sup>74</sup> Many of the bill's wide-ranging provisions were debated extensively on the House floor. Then, tucked away under a heading on Rules of Practice, came one that wasn't: "In all actions for infringement of the copyright in any work, the court shall receive and consider expert and other evidence, as to source material in the public domain, the prior art, and on the issue of infringement."<sup>75</sup>

This provision, which isn't discussed anywhere in the legislative history, is cryptic. It could be read narrowly to do little more than reaffirm the courts' duty to ensure that the author indeed created the work rather than copying it, or perhaps that the defendant indeed copied the work rather than created it. Certainly the inclusion of the "source material" language indicates a goal of excluding *someone's* copying. But it could also plausibly be read more broadly. "Prior art" is set apart from "source material" in the catalog of items that judges are instructed to consider. And if "source material" isn't modifying "prior art," courts would be required to investigate the prior art in all infringement proceedings, full stop—just as in a patent case.

Had the proposed rule taken hold, it would have abruptly upended Hand's month-old admonition that anticipation cannot invalidate a copyright.<sup>76</sup> If you were going to choose someone in government to meld copyright and patent this way, at least Sirovich—who was not only the patents committee chairman but also a Broadway playwright—looked the part.<sup>77</sup> But the bill didn't advance, and its provision on prior art remains an obscurity that has never reappeared.

Throughout the remaining decades before the 1976 Act's passage, defendants occasionally continued to invoke prior art. And they continued to fail.<sup>78</sup> By the time of that Act's passage, treatise

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73. See H.R. 11420, 74th Cong. (1936).

74. See ABE A. GOLDMAN, COPYRIGHT LAW REVISION STUDIES: THE HISTORY OF U.S.A. COPYRIGHT LAW REVISION FROM 1901 TO 1954, at 7–9 (1955) (summarizing the many copyright revision bills that Sirovich introduced during this period).

75. H.R. 11420 § 41(a), at 50.

76. See *Sheldon*, 81 F.2d at 54 ("[I]t is plain beyond peradventure that anticipation as such cannot invalidate a copyright.")

77. *William Irving Sirovich*, U.S. HOUSE OF REPRESENTATIVES HIST., ART & ARCHIVES, [https://history.house.gov/People/Listing/S/SIROVICH,-William-Irving-\(S000452\)/](https://history.house.gov/People/Listing/S/SIROVICH,-William-Irving-(S000452)/) (last visited Mar. 18, 2022) [<https://perma.cc/BV9X-2QJQ>].

78. See, e.g., *Detective Comics v. Bruns Publ'ns*, 111 F.2d 432, 433 (2d Cir. 1940) ("The prior art is only relevant as bearing on the question whether an alleged infringer has copied the author or has taken his material directly from the prior art."); *Baron v. Leo Feist, Inc.*, 78 F. Supp. 686, 690 (S.D.N.Y. 1948) (disregarding evidence of similar songs that predated the plaintiff's because

author Melville Nimmer had seen enough to lament over defendants' "common practice" of "pointing out a similar work created in antiquity, or at least prior to the defendant's creation."<sup>79</sup> Such facts, Nimmer admonished, would offer "no assistance unless the trier of fact believes that the defendant copied from such works."<sup>80</sup> Some members of the defense bar might have thought that finding a close-enough predecessor to the plaintiff's work would defeat a claim, but courts certainly didn't.

## 2. Modern Case Law

Most contemporary commentators have internalized that lesson well. Like the judges from the first half of the twentieth century, they generally don't recognize any use for prior art within copyright adjudication except for ferreting out whether one of the parties copied the expression at issue.<sup>81</sup> There would be no room, by contrast, to argue that a particular similarity between the parties' works is less substantial just because it had been anticipated in the preexisting literature.

But tell that to the plaintiff in *Johannsongs-Publishing Ltd. v. Lovland*, whose infringement claim was dismissed in 2020 precisely for failing to rebut that very argument.<sup>82</sup> Three separate times, the trial judge called the reports submitted by the plaintiff's expert "fatally flawed," all for the apparently mortal sin of omitting a prior art search. Because those reports "fail[ed] to consider prior art," their comparison of the parties' works necessarily "fail[ed] to filter out unprotectable prior art elements."<sup>83</sup> As a result, the court declared, that expert's

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"[i]t is immaterial that other songs are similar unless it casts doubt upon the originality (copyrightability) of plaintiff's song or upon the fact that defendant copied plaintiff's song"), *decree aff'd*, 173 F.2d 288 (2d Cir. 1949); *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 1093 n.3 (2d Cir. 1977) ("[P]rior works in the public domain do not . . . reduce the protection from copying afforded [the plaintiff's work] by its copyright."); *see also* George E. Frost, *Comments and Views Submitted to the Copyright Office on the Registration of Copyright* (October 5, 1958), in SUBCOMM. ON PATENTS, TRADEMARKS & COPYRIGHTS, S. COMM ON THE JUDICIARY, 86TH CONG. 71, 71 (Comm. Print 1960) (contrasting patent examination, where "the main emphasis . . . is the 'prior art' and the search by which the examiner locates that art," with copyright registration, where "the originality concept of the copyright law makes 'prior art' immaterial").

79. 1 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 101.6, at 381 (1976 ed.).

80. 1 *id.* at 381–82.

81. *See, e.g.*, 2 NIMMER & NIMMER, *supra* note 5, §§ 2.01[A][2], 8.01[C]; Selz, *supra* note 9, § 16:13.50; *see supra* text accompanying notes 3–9.

82. No. CV 18-10009, 2020 WL 2315805, at \*5 (C.D. Cal. Apr. 3, 2020), *aff'd*, No. 20-55552, 2021 WL 5564626 (9th Cir. Nov. 29, 2021).

83. *Id.*

opinion about the two works' similarities was "legally deficient and irrelevant."<sup>84</sup>

The plaintiff appealed—but not, as the conventional account might predict, on the ground that prior art was conceptually irrelevant to substantial similarity. On the contrary, the plaintiff seemed to agree with the lower court's premise that prior art mattered.<sup>85</sup> Its theory of the case was, rather, that the particular prior art that the defendant had proffered was simply insufficient.<sup>86</sup>

Shortly before this Article went to press, the Ninth Circuit summarily affirmed the lower court's decision. It held that the trial judge didn't abuse his discretion in excluding the expert's reports "because they failed to filter out similarities that are attributable to prior art."<sup>87</sup> The preceding Section's rundown of black-letter doctrine should make this move look radical. And yet here both bench and bar treated it as thoroughly uncontroversial.

A few months after the district court's decision in *Johannsongs*, the court in *Smith v. The Weeknd* similarly dismissed an infringement claim after concluding that the plaintiff's expert report was inadequate for omitting "any information about prior art."<sup>88</sup> The defendant's expert, by contrast, referenced three earlier songs that shared expressive qualities in common with the two parties' works.<sup>89</sup> On the strength of only those three preexisting works, the court filtered out nearly all of the expressive elements that had supported the claim, leaving nothing left for the plaintiff to sue over.<sup>90</sup>

*Johannsongs* and *Smith* are the strongest exemplars of prior art's newly invigorated role in music copyright infringement disputes. But they weren't the first. In 2016, for example, a court dismissed an

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84. *Id.* The court later explained: "[T]he point is to eliminate the non-protectible prior art components from the songs in issue, and then compare the protectible remainder, to see how similar that protectible remainder is. A comparison that includes both unprotectible and protectible elements is invalid under the extrinsic test and is legally irrelevant." *Id.* at \*6 (emphasis omitted).

85. See Appellant's Opening Brief at 13–14, *Johannsongs-Publishing, Ltd.*, 2021 WL 5564626 (Nos. 20-55759 and 20-55552) (arguing, for example, that defendant's expert "uses rigidly narrow criteria in comparing *Sokundur* with *Raise*, yet adopts vastly more flexible criteria in comparing prior art to the two works at issue"); *id.* at 14 ("A consistent comparison process is the only accurate way to evaluate the similarities here, and to assess the works' originality as compared to prior art.")

86. See *id.* at 15–18.

87. *Johannsongs-Publishing, Ltd.*, 2021 WL 5564626 at \*1.

88. *Smith v. The Weeknd*, No. CV 19-2507, 2020 WL 4932074, at \*6 (C.D. Cal. July 22, 2020), *aff'd sub nom.* *Clover v. Tesfaye*, No. 20-55861, 2021 WL 4705512 (9th Cir. Oct. 8, 2021).

89. *Id.* at \*3.

90. See *id.* at \*6 (relying on defendant's expert to determine that, after removing similarities in prior art, only "three notes of protectible elements remain" in common between the parties' songs).

infringement claim after the plaintiff's expert "did not do a search of prior art" and thus, in the court's view, had no factual basis on which to opine that the plaintiff's allegedly copied expression was "unusual."<sup>91</sup> Likewise, a 2011 case criticized the plaintiffs' experts for opining on the works' substantial similarity without "not[ing] any relevant prior art."<sup>92</sup>

The dismissive takes that had accurately described courts' behavior during the previous century thus turn out to be surprisingly outdated when matched up with case law in the current one. Defendants today can still use prior art to help prove that they created the expression independently, just as they always could.<sup>93</sup> But they can often do a lot more with it, too. Many copyright decisions, especially those dealing with musical subject matter, in fact welcome authorial prior art in order to evaluate whether an alleged similarity is substantial.<sup>94</sup> And at *Johannsongs's* extreme, some may even require it.

Defendants are now quickly seizing on that point in litigation. In *Smith* itself, they cited *Johannsongs* to argue that the report submitted by the plaintiff's expert was "fatally flawed because he did not consider prior art."<sup>95</sup> In another case, the defendants argued that

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91. Connor Bowen v. Paisley, No. 13-cv-0414, 2016 WL 4480165, at \*8, \*12, \*15 (M.D. Tenn. Aug. 25, 2016).

92. *Batts v. Adams*, No. CV 10-8123, 2011 WL 13217923, at \*5 (C.D. Cal. Feb. 8, 2011).

93. See, e.g., *Granite Music Corp. v. United Artists Corp.*, 532 F.2d 718, 720 (9th Cir. 1976) ("Evidence of similar musical phrases appearing in prior works is . . . logically relevant to rebut the inference of copying. Such evidence demonstrates that the musical language was of such ordinary and common occurrence that the probability of independent, coincidental production was great."); *Lester v. U2 Ltd.*, No. CV 07-06612, 2009 WL 10673938, at \*3 (C.D. Cal. 2009) (denying summary judgment to the defendants but noting that "the existence of prior art is relevant to whether the [defendants] copied"); *Gooch v. Raymond*, No. 09-0891, 2012 WL 13055741, at \*4 (M.D. Tenn. Feb. 27, 2012) (describing how the plaintiff's expert was "forced . . . to recant his opinion that the similarities between plaintiff's song and the defendants' works could only have occurred through copying" after he had been "confronted" with prior art at his deposition, *rep. and recommendation adopted*, 2012 WL 13055742 (M.D. Tenn. Mar. 21, 2012); *New Old Music Grp., Inc. v. Gottwald*, 122 F. Supp. 3d 78, 86 (S.D.N.Y. 2015) (deciding that, after finding prior art with elements in common to both parties' songs, "it may well be that no reasonable juror could find that [these] similarities . . . would be probative of copying"); *Kaseberg v. Conaco, LLC*, No. 15-CV-1637, 2019 WL 16411161, at \*7 (S.D. Cal. Apr. 16, 2019) (agreeing, in a dispute over allegedly copied comedy routines, to admit evidence of similar third-party jokes that predated the plaintiff's because those jokes would be "relevant to Defendants' independent creation defense," though refusing to admit comparable evidence for jokes that postdated it); Mark Avsec, "Nonconventional" *Music Analysis and "Disguised" Infringement: Clever Music Tricks to Divide the Wealth of Tin Pan Alley*, 52 CLEV. ST. L. REV. 339, 358-59 (2004) ("Prior art is important because if the relevant portions already existed in past musical compositions, the fact that they now turn up in both plaintiff's and defendant's musical pieces is not surprising and is not necessarily by itself indicative of copying.")

94. See, e.g., *Batts*, 2011 WL 13217923, at \*5 (discussing the role of prior art in the substantial similarity determination).

95. Memorandum of Points & Authorities in Support of Motion for Summary Judgment or, in the Alternative, Partial Summary Judgment at 15, *Smith v. Tesfaye*, No. 19-cv-02507, 2020 WL

the failure of the plaintiff's expert "to conduct a reliable prior art search renders his Report defective and his testimony inadmissible."<sup>96</sup> In yet another, the defendants contended that "neither the 'combination' or selection and arrangement of . . . individual elements constituted copyrightable expression based on . . . undisputed prior art," and faulted the plaintiffs' expert for "fail[ing] to rebut prior art showing such 'combination' was . . . unprotectable."<sup>97</sup>

This use of prior art as a shield against substantial similarity is happening almost exclusively in music cases.<sup>98</sup> We suspect that there are several possible reasons for this skew. First, music infringement cases have become expert driven to an extent unmatched by other copyright fields outside of software.<sup>99</sup> It wasn't always so. In 1977, when first laying out its framework for assessing substantial similarity, the

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4932074 (C.D. Cal. June 1, 2020) (No. 113-1). In defending against the plaintiff's subsequent appeal, the defendants pushed this point even further. *See* Answering Brief at \*45–46, *Clover v. Tesfaye*, No. 19-cv-2507, 2021 WL 4705512 (9th Cir. Apr. 28, 2021) (No. 20-55861) (arguing that the opposing expert "has an established history of claiming substantial similarity by pointing to random unprotectable similarities taken out of context, and failing to consider prior art," and that he had "lived up to his reputation in this case").

96. Defendants' Reply Memorandum of Law in Further Support of Their Motion to Preclude Dr. Alexander Stewart from Testifying at Trial at 4, *Griffin v. Sheeran*, No. 17-cv-5221, 2020 WL 5627840 (S.D.N.Y. July 29, 2020); *see also* Defendants' Memorandum of Law in Support of their Motion to Preclude Dr. Alexander Stewart from Testifying at Trial at 15, *Griffin*, 2020 WL 5627840 (arguing that the same opposing expert's opinions that the musical element at issue "was not commonplace" and could "not be found in prior works" should not be credited without "an appropriate and reliable prior art analysis," and that "[t]he absence of any reference to any search for prior art makes the [expert's] Report defective").

97. Appellees' Brief at 17, 40, *Gray v. Hudson*, No. 20-55401 (9th Cir. Mar. 29, 2021) (emphasis omitted).

98. There are occasional exceptions dealing with other subject matter, however. *See* *Briggs v. Blomkamp*, 70 F. Supp. 3d 1155, 1176 (N.D. Cal. 2014) (film); *8th Wonder Ent., LLC v. Viacom Int'l, Inc.*, No. 2:14-cv-01748-DDP-JCG, 2016 WL 6882832, at \*5 (C.D. Cal. Nov. 22, 2016) (television show). We also would not be surprised to see prior art used in this way in software cases, another area where experts tend to play an indispensable role. But our search of the case law did not uncover such usage, at least not with the same "prior art" terminology. To be sure, some key software copyright decisions examine an earlier third-party work in order to assess whether the defendant's copying was necessary to interoperate with it. *See, e.g.,* *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1375–76 (10th Cir. 1997) (holding that the plaintiff's code for a call controller was unprotectable because "some of the values for the set of command codes that were actually copied were dictated by the need for compatibility with older-model [hardware] or the limits on the capabilities of the controller itself," while "[o]ther values were dictated by the limits inherent in the public telephone networks that the call controllers accessed"); *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 715 (2d Cir. 1992) (affirming the district court's conclusion that the two allegedly infringed aspects of the code's structure "was dictated by the nature of other programs with which [that code] was designed to interact and, thus, is not protected by copyright"). But that is an analytically distinct move from the one we are focused on here, in which earlier third-party works make the plaintiff's expression appear less creative on its own terms, with no compatibility issues at stake.

99. *See* Joseph P. Fishman, *Tonal Concept and Feel*, 38 CARDOZO ARTS & ENT. L.J. 655, 667–68 (2020) (describing the unusually important role of experts in music infringement cases relative to other copyright disputes).

Ninth Circuit described expert testimony as potentially “appropriate.”<sup>100</sup> In 2000, however, the court elevated the importance of expert evidence in music cases, concluding that the test “often requires . . . expert testimony.”<sup>101</sup> Four years later, the court restated that proposition, but this time without the word “often”—experts were simply required, full stop.<sup>102</sup> And, to put an exclamation point on that proposition, in 2018 the court declared that adjudicating claims of nonliteral music infringement couldn’t even function without experts on hand: “It is unrealistic to expect district courts to possess even a baseline fluency in musicology . . . . After all, we require parties to present expert testimony in musical infringement cases for a reason.”<sup>103</sup>

In requiring expert testimony to help fact finders evaluate substantial similarity, musical subject matter is an outlier within copyright infringement litigation. The traditional rule is that experts should speak only to whether the alleged similarities resulted from copying or from independent creation, not to whether those similarities are substantial as a normative matter.<sup>104</sup> That’s been the system ever since the Second Circuit’s hugely influential 1946 decision in *Arnstein v. Porter*.<sup>105</sup> By moving away from that system over the past twenty years, music cases have evolved to give experts an unusually large platform to opine on whether similarities are substantial or not.

As we argue below in Part II, a small number of expert witnesses who stand on that platform are having an outsized role in focusing courts on prior art. Relative to other copyright disputes, music cases give experts disproportionately frequent opportunities to make that kind of impact.

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100. *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977).

101. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 2000).

102. *Swirsky v. Carey*, 376 F.3d 841, 845 (9th Cir. 2004).

103. *Williams v. Gaye*, 895 F.3d 1106, 1137 (9th Cir. 2018).

104. *See, e.g., Comput. Assocs. Int’l, Inc.*, 982 F.2d at 713 (noting that “[s]ince the test for illicit copying is based upon the response of ordinary lay observers, expert testimony is thus ‘irrelevant’ and not permitted,” though making an exception for software due to its technical complexity); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 907 (3d Cir. 1975) (“[S]ubstantial similarity to show that the original work has been copied is not the same as substantial similarity to prove infringement. . . . [D]issection and expert testimony in the former setting are proper but are irrelevant when the issue turns to unlawful appropriation.”); *see also* Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 J. COPYRIGHT SOC’Y U.S.A. 719, 738–39 (2010) (“[A] strict application of [this rule] means that in any case in which copying is admitted, expert testimony should be entirely inadmissible, since the only remaining question is improper appropriation, which is to be judged by the ordinary observer . . . without the benefit of expert testimony.”).

105. 154 F.2d 464, 468 (2d Cir. 1946) (“If there is evidence of access and similarities exist, then the trier of facts must determine whether the similarities are sufficient to prove copying. On this issue, . . . the testimony of experts may be received to aid the trier of fact.”).

A second possible reason for the prevalence of prior art in music cases is that judges are probably less confident taking judicial notice of commonality in musical composition than they are in more narrative subject matter areas like literature or film.<sup>106</sup> In the *scènes à faire* context, judges frequently appear comfortable offering their personal take on what's standard in, say, a Hollywood movie.<sup>107</sup> As one experienced copyright litigator has noted, “[S]ometimes, you can just simply argue that something is subject to judicial notice in a motion to dismiss and the court will simply accept it. . . . Some courts will simply say, ‘I don’t need more proof that superheroes in capes are common to the genre.’”<sup>108</sup> That sort of analysis proceeds essentially by intuition alone. In music, by contrast, few judges probably feel those intuitions as strongly. Judges don’t typically have the vocabulary or training to venture off on their own to identify a specific compositional element within a work, or to then evaluate whether that element is creative or mundane.<sup>109</sup> If judges perceive that as a barrier to entry, it gives experts an opening to introduce specific earlier works that can provide guideposts on whether a particular musical move seems creatively significant.

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106. *Cf.* Walker, *supra* note 53, at 456 (“Rather than generating thoughtful analysis regarding what elements are protected and why, *scènes à faire* acts as a kind of copyright-specific judicial notice, decreeing that certain aspects of a work are unprotected without the need for explanation or supporting evidence.”).

107. *See, e.g.,* Berkic v. Crichton, 761 F.2d 1289, 1293 (9th Cir. 1985) (refusing to grant protection over “depictions of the small miseries of domestic life, romantic frolics at the beach, and conflicts between ambitious young people on one hand, and conservative or evil bureaucracies on the other,” reasoning that “[t]hese familiar scenes and themes are among the very staples of modern American literature and film” and that the parties’ works “merely remind[ ] us that in Hollywood, as in the life of men generally, there is only rarely anything new under the sun”); Zella v. E.W. Scripps Co., 529 F. Supp. 2d 1124, 1129 (C.D. Cal. 2007) (taking judicial notice that it’s common for television shows to feature “(a) a host; (b) guest celebrities, (c) an interview; and (d) a cooking segment . . . because these elements are generally known and can be verified simply by watching television for any length of time”); Bernal v. Paradigm Talent & Literary Agency, 788 F. Supp. 2d 1043, 1062 (C.D. Cal. 2010) (contrasting the parties’ dispute over a film script with a hypothetical dispute involving “a highly technical area of expertise,” such as “a patent case comparing two technical devices, or a copyright case involving computer software or music,” because “this case involves . . . works [that] are targeted at a general audience and deal with subject matter readily understandable by any ordinary person, including the Court,” reducing the need for expert guidance).

108. Cendali, *supra* note 49, at 416.

109. *See* Williams v. Gaye, 895 F.3d 1106, 1137 (9th Cir. 2018) (criticizing the dissenting judge’s independent musicological analysis of the parties’ works because it “does not provide a workable standard for district courts to follow,” and observing that “[i]t is unrealistic to expect district courts to possess even a baseline fluency in musicology, much less to conduct an independent musicological analysis at a level as exacting as the one used by the dissent”).



A third reason for the skew toward music cases is that they make some judges especially concerned about managing copyright scope.<sup>110</sup> Take, for example, *Gray v. Perry*, a headline-grabbing case in which the judge overturned a jury verdict against pop star Katy Perry over an ostinato in her song's underlying track.<sup>111</sup> The court downplayed the extent of the claimed similarity because, when measured against the prior art, the allegedly copied elements did not form "a particularly unique or rare combination."<sup>112</sup> Of course, uniqueness or rareness have never been the traditional bars that a copyright plaintiff would need to clear in order to establish actionable similarity. Nevertheless, the court explained that music cases should receive special treatment:

Although there is generally a low bar for originality in copyright, given the limited number of notes and chords available to composer, and because common themes frequently reappear in various compositions, many if not most of the elements that appear in popular music are not individually protectable. Music, perhaps more than any other work of art, borrows, and must necessarily borrow, and use much which was well known and used before. For this reason, courts in musical copyright cases have a significant obligation to . . . limit[] the scope of copyright protection to truly original expression only.<sup>113</sup>

We found that courts' interest in prior art typically comes up where the plaintiff's claim centers on a short fragment, rather than on similarities that permeate the entire work.<sup>114</sup> Such claims are probably the ones where a searcher could most easily find the relevant expression in an earlier work to begin with. The shorter and less complex the

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110. See, e.g., *id.* at 1142 (Nguyen, J., dissenting) ("Requiring similarities to be substantial is of heightened importance in cases involving musical compositions."); *Gaste v. Kaiserman*, 863 F.2d 1061, 1068 (2d Cir. 1988) (noting "the limited number of notes and chords available to composers and the resulting fact that common themes frequently reappear in various compositions, especially in popular music"); *Arnstein v. Edward B. Marks Music Corp.*, 82 F.2d 275, 277 (2d Cir. 1936) (observing that musical devices "do not admit of so many agreeable permutations that we need be amazed at the re-appearance of old themes").

111. *Gray v. Perry*, No. 15-CV-05642, 2020 WL 1275221 (C.D. Cal. Mar. 16, 2020), *aff'd sub nom Gray v. Hudson*, 28 F.4th 87 (9th Cir. 2022). An "ostinato" is a "repetition of a musical pattern many times in succession while other musical elements are generally changing." Laure Schnapper, *Ostinato*, GROVE MUSIC ONLINE (2001), <https://www.oxfordmusiconline.com/grovemusic/view/10.1093/gmo/9781561592630.001.0001/omo-9781561592630-e-0000020547> [<https://perma.cc/A6N8-467P>].

112. *Gray*, 2020 WL 1275221, at \*10.

113. *Id.* at \*4 (internal quotation marks omitted) (citations omitted).

114. See, e.g., *Lil' Joe Wein Music, Inc. v. Jackson*, No. 06-20079-CIV, 2006 WL 5428227, at \*5 (S.D. Fla. Oct. 27, 2006) (relying on prior art in both music and film to hold that the lyrical phrase "Go, it's your birthday" is "unprotectible because it uses a common musical and lyrical phrase that has been used in other prior works"), *aff'd*, 245 F. App'x 873 (11th Cir. 2007); *Roberts v. Gordy*, No. 13-24700-CIV, 2015 WL 12911328, at \*5 (S.D. Fla. Sept. 15, 2015) (dismissing an infringement claim on summary judgment after the defendant showed that several songs released prior to the plaintiff's used the allegedly copied lyrical phrase "everyday I'm hustlin," rendering it unprotectible); *Newton v. Diamond*, 204 F. Supp. 2d 1244, 1254 (C.D. Cal. 2002) (relying on prior art to reject a claim over a short sequence of notes), *aff'd*, 388 F.3d 1189 (9th Cir. 2002).

sequence of information, the more likely it has already appeared at some point.

In disputes over nonliteral similarity, these decisions in the aggregate provide accused infringers an emerging line of defense. Even where an expressive element has not reached the level of outright ubiquity to qualify as *scènes à faire*, its anticipation in earlier works could still reduce its weight in the substantial similarity analysis. In this way, authorial prior art can help courts draw the difficult line between protectable expression and unprotectable ideas.<sup>115</sup> As Rebecca Tushnet has noted, “Works exist within a field of other works. . . . Looking at prior art in copyright could help define what constitutes protectable expression and what is merely an idea or concept that should not be subject to any single creator’s control.”<sup>116</sup> Our research suggests that in some cases, this approach is already happening.

To be sure, not every contemporary decision follows this trend. Outside of musical subject matter, one recent fabric-design case refused to use prior art to weaken an alleged similarity’s significance, instead doubling down on the traditional approach.<sup>117</sup> The Ninth Circuit there disregarded an expert report opining that the design’s floral motif had been anticipated by numerous other such motifs “found in many prior art materials in the public domain.”<sup>118</sup> That was the wrong copyrightability standard to apply, the court explained, because “similarity of one design to another has no bearing on whether [the author] independently created the subject design.”<sup>119</sup> When the defendants then tried to argue that at least the anticipated elements should be filtered out of the infringement analysis, the court again brushed it aside. “That the Subject Design may not be novel,” it reasoned, “is immaterial to the question whether it is original.”<sup>120</sup>

Even within music infringement cases, there were a few decisions in the 2000s that were similarly dismissive.<sup>121</sup> In *Lester v. U2*,

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115. See, e.g., *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (“[N]o principle can be stated as to when an imitator has gone beyond copying the ‘idea,’ and has borrowed its ‘expression.’ Decisions must therefore inevitably be ad hoc.”).

116. Rebecca Tushnet, *The Eye Alone Is the Judge: Images and Design Patents*, 19 J. INTELL. PROP. L. 409, 424 (2012).

117. See *Desire, LLC v. Manna Textiles, Inc.*, 986 F.3d 1253, 1259 (9th Cir. 2021).

118. *Id.*

119. *Id.* at 1259–60 (internal quotation marks omitted).

120. *Id.* at 1261 (internal quotation marks omitted).

121. See, e.g., *Ulloa v. Universal Music & Video Distrib. Corp.*, 303 F. Supp. 2d 409, 414 n.6 (S.D.N.Y. 2004) (“Defendants’ arguments regarding the similarity of the Vocal Phrase to other musical works in the public domain are not relevant in an originality inquiry where, as here, copying is conceded.”); *BMS Ent./Heat Music LLC v. Bridges*, No. 04 Civ. 2584, 2005 WL 1593013, at \*4 (S.D.N.Y. July 7, 2005):

for example, the defendant argued that an allegedly copied guitar riff could not support an infringement claim because it was too similar to a particular “prior art composition.”<sup>122</sup> The court disagreed, remarking that “the existence of prior art that is substantially similar to a copyrighted work does not defeat copyright protection.”<sup>123</sup> A work might indeed overlap with an “old or stock situation,” but, citing Nimmer’s treatise, the court concluded that “unless the trier of fact is persuaded that plaintiff copied from such old or stock situation, he may not be denied relief merely because his work is not novel.”<sup>124</sup>

It’s fair to say, then, that judges’ recent embrace of prior art in copyright cases hasn’t been uniform. It’s still primarily a music-infringement phenomenon, and even there only in the last several years. Still, given how unanimously courts had once opposed recognizing authorial prior art as a feature of copyright doctrine, the shift remains striking. At least in music cases, the concept of authorial prior art is becoming normalized. In the following Part, we explore why.

## II. EXPLAINING PRIOR ART’S RISE: THE ROLE OF EXPERTS

What accounts for prior art’s growing foothold in music copyright litigation? There are likely several factors at work, but as we explain below, we think that a fundamental one is the influence of a small cadre of expert witnesses.

To begin with, courts’ renewed interest in authorial prior art wouldn’t be the first example of “patentization” of copyright law. Since the Supreme Court’s 1984 decision in *Sony Corp. v. Universal City Studios*, which asserted that the two regimes share a “historic kinship,”<sup>125</sup> courts have repeatedly justified applying precedent from

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Despite the defendants’ efforts to portray the plaintiffs’ composition . . . as unoriginal, the facts submitted on this motion do not foreclose the possibility that this case falls within the Second Circuit’s classic example of “a man who had never known it” composing anew Keats’s “Ode on a Grecian Urn.”;

Lester v. U2 Ltd., No. CV 07-06612, 2009 WL 10673938, at \*3 (C.D. Cal. Apr. 10, 2009) (“Moreover, after listening to recordings of the riffs and drawing inferences in a manner most favorable to [the plaintiff], the Court concludes that reasonable minds could differ on the issue of substantial similarity.”).

122. *Lester*, 2009 WL 10673938, at \*3.

123. *Id.*

124. *Id.* (quoting 2 NIMMER & NIMMER, *supra* note 5, § 2.01[A]).

125. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 439 (1984). In the exact context of *Sony*, the Court relied on the kinship to justify applying the Patent Act’s “staple article or commodity of commerce” limitation on contributory infringement, 35 U.S.C. § 271(c), even though the Copyright Act lacks any such limitation—or, indeed, any contributory infringement provision whatsoever.

one area to another.<sup>126</sup> Observers have noted various areas of copyright law where patent law has influenced judges' approach, from secondary liability<sup>127</sup> to registration practices<sup>128</sup> to derivative works.<sup>129</sup> Courts' focus on prior art in music cases should be understood against this backdrop.

On top of that long-term trend, it's possible that more recent doctrinal developments within copyright law have increased some judges' desire for tools to dispose of music infringement cases. Since a federal jury returned its infringement verdict in the "Blurred Lines" case in 2015, the popular press has persistently reported on rising perceptions of risk among musicians and publishers who no longer can tell whether they're treading too close to another's song.<sup>130</sup> The dissenting judge on the appellate panel that affirmed that judgment sounded an alarm when she cautioned that the majority was allowing the copyright owner to "accomplish what no one has before: copyright a

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126. See, e.g., *Harris v. Emus Recs. Corp.*, 734 F.2d 1329, 1333 (9th Cir. 1984) ("Where precedent in copyright cases is lacking, it is appropriate to look for guidance to patent law 'because of the historic kinship between patent law and copyright law.'" (quoting *Sony*, 464 U.S. at 439)). The Supreme Court has invoked this "kinship" rationale most recently in *Impression Products, Inc. v. Lexmark International, Inc.* in support of a rule that a foreign sale of a patented item exhausts U.S. patent rights in that item, just as it would for a copy of a copyrighted work. 137 S. Ct. 1523, 1536 (2017). For a survey of lower-court references to this language, see David W. Barnes, *Abuse of Supreme Court Precedent: The "Historic Kinship,"* 16 CHI.-KENT J. INTELL. PROP. 85 (2016).

127. See, e.g., 6 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 21:42 (2021) (commenting that the Supreme Court's decision in *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005), which held a peer-to-peer filesharing platform liable for inducing infringement, "represents a recent phenomenon, the 'patentization' of copyright law"; *id.* § 21:79 ("The latest statutory patent liability judicially legislated into the Copyright Act by the Supreme Court is inducement. . . . [T]he new theory has no roots in copyright law. The entirety of *Grokster's* discussion of its new theory is patent based . . .").

128. See Steven J. Metalitz, *Copyright Registration After Feist: New Rules and Roles?*, 17 U. DAYTON L. REV. 763, 766 (1992) (criticizing a court's decision to invalidate the registrant's copyright after it "fail[ed] to disclose prior art adequately to the Copyright Office in the registration process," which "seemed to import a very patent-like standard of disclosure to a copyright registration setting").

129. See Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 CARDOZO ARTS & ENT. L.J. 81, 122–24 (1998) (summarizing a court's decision to deny copyrightability to a musical arrangement based on its proximity to what other musicians could do, and lamenting that it "sounds so much more like patent than copyright doctrine").

130. See, e.g., Ben Sisario, *"Blurred Lines" on Their Minds, Songwriters Create Nervously*, N.Y. TIMES (Mar. 31, 2019), <https://www.nytimes.com/2019/03/31/business/media/plagiarism-music-songwriters.html> [<https://perma.cc/6Y56-DLPA>]; *Why American Songwriters Are Suing Each Other*, ECONOMIST (May 13, 2021), <https://www.economist.com/business/2021/05/13/why-american-songwriters-are-suing-each-other> [<https://perma.cc/X8TG-RL83>] (reporting that "[b]etween 1844 and 2014 no more than eight [music copyright] cases a year were heard in American federal courts," while "[t]he past six years have seen an average of 16"); Wang, *supra* note 13 (describing how "the once-sleepy realm of music copyright law has turned into a minefield").

musical style.”<sup>131</sup> She accused the majority of “establish[ing] a dangerous precedent that strikes a devastating blow to future musicians and composers everywhere.”<sup>132</sup> This judicial decision may have put the musical similarity issue more centrally on judges’ radar, just as it did for many within the industry.<sup>133</sup>

Another significant legal change came from the Supreme Court, which in a 2014 decision eliminated the laches defense as a bar to copyright infringement actions.<sup>134</sup> That change allowed legacy artists (or their estates) to file lawsuits over allegedly infringing adaptations that were written decades ago, limited only by the Copyright Act’s three-year limitations period as a cap on damages. The classic rock band Spirit, for example, could sue Led Zeppelin over a claim that “Stairway to Heaven” infringed its earlier song “Taurus,” despite the fact that “Stairway” was written all the way back in 1971.<sup>135</sup> Here, again, we can only conjecture what spillover effect this might have on judges’ handling of music infringement more generally. But it’s at least plausible that as the Supreme Court invites in more claims, district court judges could become more interested in finding ways to winnow the number down.

Alongside these doctrinal developments, technology is improving. It’s far more feasible today to search for copyright prior art than it used to be. The development of the internet and improvements in data storage and analytics have allowed sophisticated parties to perform queries that once would have been time- or cost-prohibitive.<sup>136</sup>

Nevertheless, even given all of these changes in the background, we doubt that authorial prior art would have made it this far without the efforts of expert witnesses. Pulling back the judicial decisions’ curtain and looking at the experts’ work product, we find that those same experts’ norm entrepreneurship has pioneered the concept of authorial prior art. After a long period of accumulating expectations, a

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131. *Williams v. Gaye*, 895 F.3d 1106, 1138 (9th Cir. 2018) (Nguyen, J., dissenting).

132. *Id.*

133. One influential treatise went so far as to call the case “a stain on the federal judiciary” in which “[e]xpert witnesses were allowed to usurp the role of the jury.” 3 PATRY, *supra* note 127, § 9:247.30. “We would be better off banning all expert witnesses,” it continued, “than tolerating such a fundamental failure.” *Id.* We don’t subscribe to that dire assessment ourselves. Nevertheless, its prominent inclusion within the treatise highlights how much negative publicity the “Blurred Lines” litigation has received within the copyright bar.

134. *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 668 (2014).

135. *See Skidmore v. Led Zeppelin*, 952 F.3d 1051, 1057 (9th Cir. 2020) (en banc) (“One may wonder how a suit so long in the making could survive a laches defense. The Supreme Court answered this question in *Petrella v. Metro-Goldwyn-Mayer, Inc.*, which clarified that laches is not a defense where copyright infringement is ongoing.”).

136. *See infra* Section II.B.3 (reporting our interview data on experts’ use of computer databases to run prior art searches).

judge may reasonably feel justified in discarding a plaintiff's expert report for failing to engage sufficiently with prior art, just as the court in *Johannsons* did.<sup>137</sup> But ultimately, the courts that do so are making a move that opposing experts had been urging for years.<sup>138</sup>

In order to understand expert witnesses' role in these copyright disputes, we collected information from two sources. First, we analyzed a sampling of experts' written reports in litigated cases over music infringement. Because these reports contain the evidence that litigants are actually putting in front of courts, including in cases that never generate a written judicial opinion, they offer a more complete picture of the arguments that judges are exposed to on a regular basis. Second, to see how the experts themselves think about prior art, we conducted a series of interviews with several of them who are actively practicing. Together, these sources show that, unlike what traditional doctrine has said about the concept in copyright cases, the experts understand prior art research to be a central part of their professional identity. These experts, moreover, are convincing. Judges are increasingly relying on experts for help deciphering the particularly complicated issues of musical similarity, and those experts in turn are persuading judges to adopt the same concept of authorial prior art that earlier generations had once so consistently renounced.

### *A. Written Reports*

The experts who appear in these cases are known as forensic musicologists. There is no formal academic discipline that defines a forensic musicologist's methodology or body of knowledge. Roughly, though, the role requires the application of musical analysis to the particular questions that tend to arise in copyright matters. A forensic musicologist's educational background typically focuses on music rather than law. Nevertheless, as we discuss further below in our summary of our interviews, individual experts can pick up enough from the lawyers with whom they work to at least be conversant in copyright basics.

We analyzed fifty forensic musicologist reports that parties filed in litigated music copyright cases between 1995 and 2020. Of these, twenty-nine were filed by the defendant and twenty-one by the

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137. See *Johannsons-Publishing Ltd. v. Lovland*, No. CV 18-10009, 2020 WL 2315805, at \*5 (C.D. Cal. Apr. 3, 2020) (noting the legal deficiency of the expert's report due to its failure to consider the prior art).

138. See *infra* Section II.A.2.

plaintiff.<sup>139</sup> Our sample comprises the work product of ten individual experts. Remarkably, of the defense-side reports, all but six came from one especially prolific witness: music professor Lawrence Ferrara.<sup>140</sup>

For each report, we tracked whether the expert discussed third-party works that predated the work-in-suit. If so, we also tracked what conclusion the expert was using those works to support: an opinion on whether a similarity supported an inference of actual copying, on whether a similarity was normatively substantial, or on both.

Generally, it was the defendant's expert who defined the universe of prior art at issue. Plaintiff-side experts, by contrast, tended not to mention specific prior art references except to rebut what the opposing expert had argued. They did not affirmatively cite earlier works in order to, say, show how different the author's expression was from its predecessors (as would be done, for example, with technological inventions in a patent prosecution).

Significantly, though, even the plaintiffs' experts seemed to work from the premise that prior art *would* be relevant if it were indeed close enough to the work-in-suit. Sometimes they announced that they had undertaken a search themselves and hadn't found anything.<sup>141</sup> Other times they argued that the defense's prior art was so inapplicable that the defense's reliance on it only demonstrated just how original the

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139. Depending on the age of the docket, not every document was available to us in every dispute.

140. See *Lawrence Ferrara*, NYU STEINHARDT, <https://steinhardt.nyu.edu/people/lawrence-ferrara> (last visited Feb. 4, 2022) [<https://perma.cc/2TFQ-M7JV>].

141. See, e.g., Report or Affidavit of Dr. Michael E. Harrington ¶ 4, *Lessem v. Taylor*, 766 F. Supp. 2d 504 (S.D.N.Y. 2011) (No. 32-7), 2008 WL 8552599 ("In my opinion, [defendant's song] is substantially similar to [plaintiff's song]. . . . [T]his conclusion is based upon my careful analysis and transcription of the music and lyrics of [defendant's and plaintiff's songs], and my search for prior and contemporary musical sources."); Declaration of Sandy Wilbur ¶ 25, *Bourne Co. v. Twentieth Century Fox Film Corp.*, 602 F. Supp. 2d 499 (S.D.N.Y. 2009) (No. 33), 2008 WL 2234041 ("I believe this [musical element at issue] is unique since I was unable to find any prior art (other songs using these four notes in the same way before the publication of [plaintiff's song]."); *Musicological Comparison/Analysis of "The Reasons Why," "No More Pain" and "Burn" of George S. Saadi* ¶ 50, *Straughter v. Raymond*, No. CV 08-2170, 2011 WL 3651350 (C.D. Cal. Aug. 19, 2011) (No. 270-1), 2011 WL 4836131:

I am unaware of any prior song or songs embodying all [allegedly copied] elements. I am informed that, after three years of litigation, the Defendants have yet to locate and identify any such song or songs. I am consequently of the opinion that . . . it is inconceivable for it to be a result of coincidence, or of independent creation, or of both songs having been based on the same prior source.

Plaintiffs' lawyers, for their part, also operate from the same premise in court. See, e.g., Plaintiff's Response in Opposition to Defendants' Motion to Exclude Plaintiff's Proposed Expert Witness at 11, *Watt v. Butler*, 744 F. Supp. 2d 1315 (N.D. Ga. 2010) (No. 83), 2010 WL 3253145 (emphasizing that the expert retained by the plaintiff had "searched prior art to determine whether the composition . . . is original, and therefore, entitled to copyright protection").

author's expression truly was.<sup>142</sup> But in all instances, prior art mattered.

In the following Sections, we discuss two of the most striking throughlines in these expert musicologist reports. First, the experts regularly use prior art to address the substantiality of similarities between the parties' works, and not just the issue of copying. Second, defense-side reports routinely characterize a prior art search as a genuine must-have for succeeding on an infringement claim, a proposition that, as already discussed above,<sup>143</sup> judges have just recently begun adopting.

### 1. Actual Copying Versus Substantiality

Plaintiff- and defense-side experts alike nearly always devoted significant attention to the probability that a similarity between the parties' works had resulted from copying rather than coincidence.<sup>144</sup> The appearance of a particular chord progression in both the plaintiff's and defendant's works, for example, may look less suspicious if that same progression had also appeared in thirteen other works already published before the plaintiff's even existed.<sup>145</sup> This use of prior art is unsurprising. It neatly tracks expert witnesses' traditional evidentiary assignment in copyright infringement cases.<sup>146</sup>

Yet like the judicial decisions discussed in the previous Section,<sup>147</sup> experts also frequently used prior art in order to weigh in on whether similarities were substantial. Take, for example, the two sides' reports in *Jean v. Bug Music, Inc.*, a case about the alleged infringement of an R&B song.<sup>148</sup> The accused infringer's expert argued that melodic

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142. See, e.g., Response to the Report of Dr. Lawrence Ferrara at 7, 10, *Watt*, 744 F. Supp. 2d 1315 (No. 74-2), 2010 WL 4392579:

The search through varied repertoires undertaken by Dr. Ferrara in search of prior art demonstrates one fact indisputably: he has been unable to locate prior art of striking similarity that would undermine the original status of the [the original author's expression]. . . . The failure to find prior art, despite having combed through classical, pop, rock, and movie soundtrack repertoires, highlights the similarity of the [plaintiff's song] to the comparable phrase in [the defendant's song].

143. See *supra* text accompanying notes 73–82.

144. See, e.g., Report or Affidavit of Lawrence Ferrara ¶ 66, *Bradford v. Carter*, No. 09-CV-00156, 2011 WL 13175669 (N.D. Ga. Sept. 29, 2011) (No. 147-1), 2010 WL 5651752 (opining that a “commonplace 3-note rhythmic similarity is a result of coincidence, not copying”).

145. See Declaration of Dr. Lawrence J. Ferrara ¶ 7, *Griffin v. Sheeran*, 351 F. Supp. 3d 492 (S.D.N.Y. 2019) (No. 68), 2018 WL 7197820.

146. See *supra* text accompanying notes 104–105 (discussing courts' general rule that an expert may opine on whether a similarity resulted from copying but not on whether that similarity is normatively substantial).

147. See *supra* Section I.B.2.

148. No. 00-CV-4022, 2002 WL 287786 (S.D.N.Y. Feb. 27, 2002).



similarity between the parties' works could also be found in several preexisting works, thereby "refuting defendants' claim of original creation of this melodic phrase."<sup>149</sup> Many of these works came from genres that were far afield from the original author's, such as art music by composers like Stravinsky, Ravel, and Bartok. The argument was not that the author had necessarily listened to those compositions, and so had failed to create the melody independently. Rather, it was that the melodic phrase simply wasn't creative enough—too many earlier authors had already written the same thing. On that basis, the expert argued, copying it from the copyright owner would be musicologically insignificant.

The copyright owner's expert, meanwhile, had earlier opined that no such prior art was likely to exist. But like his counterpart, he too began from the proposition that more prior art would weaken the expression's protectability, while less prior art would enhance it.<sup>150</sup> Though they disagreed over whether any prior art existed in this particular case, they agreed on the general principle—prior art affects a similarity's substantiality.

Some defense-side reports adopted an even stronger version of that proposition by going out of their way to bracket the issue of copying altogether. They clarified upfront that prior art mattered regardless of whether the defendant had indeed copied from the plaintiff.<sup>151</sup> In other words, even assuming such copying occurred, it would be immaterial—the prior art effectively rendered the similarity inconsequential.

Experts frequently referred to prior art affecting the "originality" of an expressive element within the original songwriter's work. As every good copyright attorney knows, originality is a legal term of art encompassing both a requirement of independent creation and at least a small degree of creativity.<sup>152</sup> Forensic musicologists may very well know this principle too,<sup>153</sup> but they were sometimes vague

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149. Report or Affidavit of Lawrence Ferrara at 10, *Jean*, 2002 WL 287786 (No. 00-CV-4022 (DC)), 2000 WL 35934960 (emphasis omitted).

150. Report or Affidavit of Gerald Eskelin ¶ 3, *Jean*, 2002 WL 287786 (No. 00-CV-4022 (DC)), 1999 WL 35139549 ("It is unlikely that this unique combination of similar elements can be found in prior musical literature. Therefore, the earlier expression of this musical excerpt appears to be protectible by copyright and the later expression constitutes an infringement of it.").

151. See, e.g., Report or Affidavit of Lawrence Ferrara, Ph.D. ¶¶ 92, 96, *Watt v. Butler*, 744 F. Supp. 2d 1315 (N.D. Ga. 2010) (No. 1:08-CV-3386-TWT), 2009 WL 6700011 (opining that the relevant similarity was coincidental but that "[e]ven if there were copying . . . that alleged copying would represent a fragment of a building block in music which is not original to [plaintiff's song] and cannot be monopolized by any composer").

152. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991) (stating that "originality requires independent creation plus a modicum of creativity").

153. See Interview with Expert D (Oct. 1, 2020) ("[T]he word novel . . . is not really copyright law. . . . I view it as 'original' often means it's original to the creator, the creator did it."); Interview

about whether their references to “originality” meant independent creation, creativity, or both. For example, in one case a defense-side expert explained that the similar melody in the two parties’ works had also appeared in numerous German folk songs from centuries ago.<sup>154</sup> He didn’t conjecture that the original songwriter had derived the melody directly from those folk songs.<sup>155</sup> Nevertheless, in the expert’s view, the folk songs’ existence buttressed the conclusion that “plaintiff cannot claim that the music placed in issue represents plaintiff’s original expression.”<sup>156</sup>

The reasoning behind that statement is ambiguous. It might be that the expression’s repeated appearances in antiquity suggest that the plaintiff had probably encountered it *somewhere* before writing the song, even if he mistakenly thought he came up with it on his own. Alternatively, it might mean that the expression’s previous appearances in such old material diminishes its creative significance today. Or maybe it means both. Across the reports, this sort of imprecise usage of “originality” sometimes made it difficult to say with certainty that experts were trying to evaluate how truly novel a song is.<sup>157</sup>

But other times they left little doubt. On the basis of only three prior art references, a defendant’s expert concluded that the melodic similarity between the parties’ works “is not musicologically significant” because those works were “closer” to the prior art than they were to each other.<sup>158</sup> The report did not address the probability that

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with Expert B (Oct. 2, 2020) (“There is this whole principle that if it’s not copied then it is original, so something could be found in prior art, and if it wasn’t copied, then the expression at issue could still be legally considered original. In a legal sense, original simply means ‘not copied.’”). As we explain further in Section II.B.1 below, we do not identify any interview subjects by name.

154. See, e.g., Report or Affidavit of Lawrence Ferrara, Ph.D. ¶ 45, *Griffin v. J-Records*, 398 F. Supp. 2d 1137 (E.D. Wash. 2005) (No. 47-2), 2005 WL 3734135 (“[T]he same[ ] generic sequence of seven pitches at issue [was] embedded in numerous German folk songs that pre-date the 18th century. Many of these German folk songs feature the identical sequence of seven pitches at the end of melodic phrases.”).

155. He also cited a Beatles song, where that derivation conjecture would be far more plausible. *Id.* ¶¶ 34–38.

156. *Id.* ¶ 46.

157. See also, e.g., Expert Declaration of Sandy Wilbur ¶¶ 69, 72, 78, *Williams v. Bridgeport Music, Inc.*, No. 13-CV-06004, 2015 WL 4479500 (C.D. Cal. July 14, 2014) (No. 91-1) (opining that the individual similarities identified by the plaintiff’s expert are merely “a few of the basic building blocks of musical composition that are present, if not inevitable, in many songs,” that even together in combination they “can be found in songs that predate [the copyright owner’s work] and are not original to [that work],” and that the combination “is neither original nor an indication of substantial similarity between [the parties’ works] or any other songs that share one or more of these elements”).

158. Declaration of Dr. Lawrence Ferrara ¶ 6(f), *Smith v. Tesfaye*, No. 2:19-cv-02507, 2020 WL 4932074 (C.D. Cal. July 6, 2020) (No. 113).

the plaintiff had heard these songs before.<sup>159</sup> Instead, it simply declared that the anticipatory references made any similarity musicologically unimportant. It's hard to read that statement as anything other than an incorporation of a novelty standard.

In another case, the same expert likewise opined that his discovery of four centuries-old Irish folk songs sharing the plaintiff's expression "significantly undermines and debilitates" a substantial-similarity claim.<sup>160</sup> That "prior art," along with other contemporary songs, "provides very strong musicological support for finding that Plaintiff cannot monopolize musical expression that is in common between the two songs in issue. That expression has been widely used and available for centuries."<sup>161</sup> Here, again, this statement doesn't depend on the original songwriter having copied anything from anyone. The expert is telling the court that, even if independently created, the expression at issue simply has too old an ancestry for any claimant to assert an infringement claim over it today.<sup>162</sup>

## 2. The Necessity of a Prior Art Search

Over our sample's entire chronology, defense-side experts have consistently admonished plaintiff's experts for rendering an opinion without having first performed a prior art search. As early as 1998, for example, a defense expert opined that the opposing witness had "overlook[ed] a vital concern in determining musical similarity—the study of prior and contemporary art."<sup>163</sup> He explained that "[t]o render a competent opinion as to copyright infringement, a music expert must be aware of how common or uncommon and therefore how likely musical elements are to occur independently in two different songs in a particular style of music."<sup>164</sup> Knowledge of the prior art is critical because, if a musical element appears frequently in other songs, then a

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159. The references were Blondie's "Heart of Glass," the title song for the James Bond film *The World Is Not Enough*, and the theme music for the television series, *X-Men: The Animated Series*. *Id.*

160. Declaration of Lawrence Ferrara ¶ 39, *Johannsongs-Publ'g Ltd. v. Lovland*, No. 18-cv-10009, 2020 WL 5077931 (C.D. Cal. June 7, 2019).

161. *Id.*

162. *See, e.g.*, Lawrence Ferrara Rebuttal to the Report and Testimony of Thomas Z. Shepard at 2, 5, *Ulloa v. Universal Music*, 303 F. Supp. 2d 409 (S.D.N.Y. 2004) (No. 01-CV-9583) (citing Mozart sonatas, Haydn sonatas, a Beethoven trio, and Couperin's beginner piano pieces, among others, as "prior art musical compositions" that show that the expression at issue "has been commonly used in many genres for centuries and does not rise to the threshold of original expression").

163. Affidavit of Dr. E. Michael Harrington ¶ 34(ii), *McKinley v. Raye*, No. 96-CV-2231P, 1999 WL 47260 (N.D. Tex. Jan. 22, 1999) (No. 58009-2), 1998 WL 35176908.

164. *Id.*

similarity between the parties' works "has little meaning in determining whether two songs containing the musical element are 'substantially similar' in the copyright infringement context."<sup>165</sup>

In a different case, another defense expert similarly proclaimed that his counterpart had "fail[ed] to consider prior art in connection to the [musical elements] she places in issue."<sup>166</sup> As a result, he concluded, "she does not and cannot opine as to whether those melodies represent original expression."<sup>167</sup> In yet another case, that expert argued that the opposing side's "failure to complete a requisite prior art search has blind[ed] his analysis and Report" to how commonplace the relevant musical elements really were.<sup>168</sup>

Defendants in these cases regularly hammer on this notion that a prior art search is a "must" or a "requisite." Plaintiff-side experts, for their part, often downplay how important a documented search really is.<sup>169</sup> Early on, judges stayed on the sidelines and let the experts duke it out amongst themselves as to whether everyone had done sufficient homework.<sup>170</sup>

Lately, though, judges are coming around to the idea that a prior art search really is a must-have. In 2016's *Bowen v. Paisley*, for instance, the defense expert characteristically insisted that the plaintiff's report should "fail" because there had been "no search for (or analysis of) prior art," and "the absence of any search for (or analysis of) prior art does not allow [plaintiff's expert] to filter out the elements that she places at issue that were in common use prior to [plaintiff's song]."<sup>171</sup> The plaintiff in the case pushed back. In opposing summary judgment, she freely conceded that there had been no search. In fact, she argued, it would be "an extraordinary theory" to contend that

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165. *Id.*

166. Report or Affidavit of Dr. Lawrence Ferrara, Ph.D: Rebuttal to the Reports of Judith Finell ¶ 37, *Pyatt v. Jean*, No. 04-CV-03098, 2006 WL 8440910 (E.D.N.Y. Aug. 29, 2006) (No. 118), 2005 WL 6521958.

167. *Id.*

168. Introduction and Summary of Lawrence Ferrara, Ph.D. ¶ 41, *Lessem v. Taylor*, 766 F. Supp. 2d 504 (S.D.N.Y. 2011) (No. 32-9), 2009 WL 8140412.

169. *See, e.g.*, Rebuttal of Report by Lawrence Ferrara of November 18, 2015 of Judith Finell, MA ¶ 33, *Bowen v. Paisley*, 2016 WL 4480165 (M.D. Tenn. Aug. 25, 2016) (No. 113-8), 2016 WL 4256931 (noting matter-of-factly that "it was beyond the scope of our study to conduct a formal prior art investigation," but adding that none was necessary because "within my decades of experience and research within the musical literature, I know of no other song that combines the same compositional and expressive features shared here").

170. In the *Lessem* case mentioned in the previous paragraph, for example, the court held that "whatever can be made of this [prior art] material's absence from [the plaintiff-side expert's] initial report is left for cross-examination, not exclusion from evidence," and ultimately denied the defendants' summary judgment motion. *Lessem*, 766 F. Supp. 2d at 512, 515.

171. Report Regarding of Dr. Lawrence Ferrara, Ph.D. ¶ 102, *Bowen*, 2016 WL 4480165 (No. 118-1), 2015 WL 11253070.

“originality of a copyrighted work can never be established without conducting one.”<sup>172</sup> Invoking the traditional rule that the concept of prior art has no bearing on copyright cases, the plaintiff continued:

Defendants and their expert attempt to confuse the issues by using the misleading term ‘prior art’ a term not typically utilized in copyright law. The term is borrowed from patent law. . . . The concept of originality in copyright law is fundamentally different from concepts of anticipation and novelty in patent law. . . . The use is misleading because, in patent law, which requires novelty as well as originality, a single item of prior art can invalidate an entire patent. . . . Copyright’s analogous requirement is the much less stringent requirement that the protected expression arose from the author’s independent creativity.”<sup>173</sup>

But in a move that would have been unthinkable years earlier, the court sided with the defendant. It stressed that while the plaintiff’s expert had asserted that certain features of the plaintiff’s work were “unusual,” that expert had also “concede[d] that she did not conduct a review of any prior works.”<sup>174</sup> The defense expert, by contrast, did.<sup>175</sup> After reviewing the defense’s prior art (a term that the court used without comment), the court concluded that regardless of what the opposing expert might say, the musical features at issue “are not particularly ‘unusual.’”<sup>176</sup> It found no substantial similarity between the works and dismissed the case.<sup>177</sup>

As we discussed in Section I.B.2, over the last two years some judges have embraced this position so firmly that they are all but ignoring plaintiffs’ experts in music infringement cases if those experts haven’t performed a prior art search.<sup>178</sup> Time will tell whether that rule gains widespread adoption. But whatever its future within the judiciary, years of expert witness testimony got it this far.

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172. Response in Opposition to Defendants’ Motion for Summary Judgment, *Bowen*, 2016 WL 4480165 (No. 124), 2016 WL 3449522.

173. *Id.*

174. *Bowen*, 2016 WL 4480165, at \*12.

175. *Id.*

176. *Id.* The court emphasized that it was not holding the allegedly copied elements to be unoriginal for copyright purposes. It concluded that while the defendants had “shown that some elements of the plaintiff’s expression . . . were used prior to the creation of the [plaintiff’s] Work,” they still had “not shown that [plaintiff’s] particular use and integration of these features in her expression of the ‘hook’ in her song is unoriginal.” *Id.* at \*9. Nevertheless, the court decided it was proper to consider prior art evidence while assessing the degree of similarity between the parties’ works. *Id.* at \*10.

177. *Id.* at \*15.

178. See *supra* text accompanying notes 82–92.

## *B. Interviews*

In addition to our review of written expert materials, we interviewed several forensic musicologists who frequently participate in copyright infringement matters. The interview subjects revealed a shared understanding of prior art analysis as central to their work. For many of them, it affected what deserves legal protection to begin with.

### 1. Interview Methodology

Our interviews did not use a random sample. In fact, the number of forensic musicologists who routinely appear in U.S. copyright litigation is small enough that our interview data covers most of the relevant population. Using a semi-structured interview format, we asked the experts whom we spoke with to reflect on what questions they needed to answer in order to reach a conclusion on an infringement issue.<sup>179</sup> With that as a baseline, we then asked them to speak to whether the existence of earlier works with close similarities to the work-in-suit would be musicologically meaningful to them and why. We also asked about whether, leaving aside their personal views, they had seen such similarities persuade a legal decisionmaker before. Finally, in the interest of cutting through semantics, we asked about what specific terms they and their colleagues use to refer to those earlier works.

We targeted our interview requests to musicologists who have regularly appeared as expert witnesses or who maintain an active copyright consulting practice. Six agreed to speak with us. Of these, five were conducted orally over Zoom, while one was conducted through a written survey in order to accommodate the subject's schedule.<sup>180</sup> All but one of the interviewees additionally participated in a follow-up interview via Zoom.<sup>181</sup> The oral interviews ran approximately one hour in length (with recorded follow-up interviews averaging an additional half hour), and most of our subjects opted to speak anonymously. For this reason, all quotations in this Part use the pronouns "they" and "their" and are ascribed to a deidentified letter. All oral interviews were recorded and transcribed; the one written interview was standardized to reflect the same protocol questions.

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179. The Institutional Review Board at our respective institutions approved the interview protocols.

180. Because we conducted these interviews during the COVID-19 pandemic, all interviews were necessarily remote.

181. The follow-up sessions allowed us to ask clarifying questions and inquire more deeply into themes that we noticed during our review of the initial interviews.

## 2. What Prior Art Does

Interview subjects generally agreed that an expert should have familiarity with the relevant musical repertory that predates a work on which they're opining.<sup>182</sup> But consistent with the pattern we observed in experts' written reports,<sup>183</sup> subjects also told us that it's up to the defense expert to raise the issue. "Typically," one said, "if one is being hired by the plaintiffs, it is not the burden of the plaintiffs to provide prior art[,] . . . [whereas] I've never known of a defense case that hasn't searched for prior art."<sup>184</sup> Still, they note, "[plaintiff's experts] often do that investigation [for prior art] to see whether or not the case is likely to be challenged in that way."<sup>185</sup> Another interviewee mentioned that, while plaintiffs might use the existence of prior art to decide whether to pursue a claim, for the defense prior art is "a very good defense. In fact, it's a common defense."<sup>186</sup> This subject thought that there had been "more emphasis on [prior art] in recent years," and without being prompted mentioned the *Johannsongs* decision in which the court had thrown out a plaintiff-side analysis for lack of a prior art search.<sup>187</sup>

Recall that defendants might try to introduce prior art in a copyright case either in order to rebut an allegation of actual copying or, perhaps more controversially, in order to challenge the substantiality of alleged similarities between the works. We discussed both possibilities with our interview subjects. Strikingly, they embraced not just the actual copying usage but largely the substantiality one as well.

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182. See Interview with Expert A (Oct. 8, 2020):

[W]e're asked to opine on . . . the originality of the music involved, in terms of any similar features, could it be explained by either third party music, or public domain music, prior art, or for some other reason, that both Song A and Song B utilized something that is identified as part of a preexisting recording, for example.;

*id.* ("I always encourage prior art research, regardless of which side is involved, because it's a very important part of the sort of combined information that's needed to make an informed decision about approach or whether or not to walk away entirely."); Interview with Expert B (Oct. 2, 2020):

[Prior art] is of utmost importance, I'd say it's essential. To do that kind of search is essential . . . so, yeah, it's the second phase of my participation in these types of matters . . . [It is essential to show] whether there is music out there . . . even if it's just one piece, but if it was a piece that was widely disseminated, then I think that, for a plaintiff, that would be pretty much the end of their case.;

Interview with Expert E (Nov. 5, 2020) ("Understanding prior art is a very important part of forming an opinion.").

183. See *supra* Section II.A.2.

184. Interview with Expert A (Oct. 8, 2020).

185. *Id.*

186. Interview with Expert B (Oct. 2, 2020).

187. *Id.*; see *supra* notes 82–87 and accompanying text (discussing *Johannsongs*).

We start with copying, which requires less discussion to unpack. The proposition that prior art could weaken an inference that the defendant had actually copied anything has always been unextraordinary.<sup>188</sup> The more works featuring similar expression that predate the plaintiff's work, the more plausible a defendant's allegation that it just happened to converge around that similarity through pure coincidence. Maybe the evidence suggests that those earlier works, and not the plaintiff's, provided the defendant its true source material. Or maybe it suggests that the expression at issue is the sort of thing that many people are likely to produce independently (as might be the case where fixed physical or cultural constraints funnel individual artists toward the same creative choices). Either way, the evidence goes toward gauging the probabilities as to what really happened in the past: Is the alleged similarity attributable to copying from the plaintiff, or to something else?

As previously discussed, actual copying has long been the infringement element most welcoming to proof through expert testimony.<sup>189</sup> Unsurprisingly, the experts whom we interviewed unanimously agreed that a big part of their job was to address that issue, looking at earlier music to see how it might affect the probability that the accused party had derived the material from somewhere other than the plaintiff's work. For instance, one subject told us that "I talk about copying because copying is a musical act that I can have a legitimate opinion on."<sup>190</sup> Further, this subject continued, peers regularly discuss earlier works as an important part of forming and defending that opinion. "Every report I've ever read where . . . earlier works are relevant has mentioned [those works' significance] because . . . to a musicologist, it's key. Not necessarily in . . . a direct line of musical influence, but in inferring the likelihood of coincidental similarity as opposed to copying."<sup>191</sup> Another interviewee similarly explained:

If they're more similar to each other than they are to any prior art found . . . I would say that that increases the likelihood that the second work copied the first. If on the other hand, we find . . . prior art that is more similar to one or both of the other works . . . then I would say that the possibility of copying declines.<sup>192</sup>

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188. *See, e.g.*, *Detective Comics, Inc. v. Bruns Publ'ns, Inc.*, 111 F.2d 432, 433 (2d Cir. 1940) ("The prior art is only relevant as bearing on the question whether an alleged infringer has copied the author or has taken his material directly from the prior art.").

189. *See supra* text accompanying note 104.

190. Interview with Expert C (Sept. 24, 2020).

191. *Id.*

192. Interview with Expert A (Oct. 8, 2020).



Yet however unremarkable it is to use prior art to disprove actual copying, using it to attack a similarity's substantiality as well seems like a shakier proposition. For one thing, as Section I.B discussed, up until recently that move had long been a surefire loser in court.<sup>193</sup> At least that certainly seemed to be the precedential upshot for most of the twentieth century, from Learned Hand's admonition that "it makes no difference how far [a work] was anticipated by works in the public demesne which the plaintiffs did not use,"<sup>194</sup> to the Supreme Court's capstone statement in *Feist* that "a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying."<sup>195</sup> And for another thing, as we discussed above in the Introduction, many contemporary commentators still consider a lawyer's invocation of "prior art" in a copyright case to be an unwitting admission of ignorance.

Despite that party line, however, our interview subjects described a duty to evaluate whether allegedly copied compositional elements were creative enough to be deemed musicologically substantial. That inquiry would always take place against the backdrop of what songwriters have previously done. One subject explained that prior art speaks to what's essentially a policy question of what belongs under copyright. In their view, the expert's task was to determine whether the music "rises to the level of being worthy of copyright protection . . . . If I can find that music preexisting in Beethoven and Bach in blues and public domain type sources, then I would tend to think it's not worthy of copy protection."<sup>196</sup> Put differently, the subject continued, "[i]t's original to someone who created it, but it's not original expression really, it just comes from somewhere."<sup>197</sup>

To this subject, it wouldn't matter if the songwriter in question had ever before encountered those earlier sources. Researching the prior art isn't just about a lack of copying, they said, but also to ensure that legal exclusivity isn't being handed out for something insufficiently innovative. "Something that hasn't been done before. Unprecedented. . . . That's what I'm getting at. . . . To me, whatever word can be used to . . . say this hasn't happened before, you're the first to do this, I think that's significant. That would deserve more copy protection."<sup>198</sup> The more frequently a given element of expression has appeared in the past, this subject continued, the less it can claim

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193. See *supra* Section I.B.1.

194. *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 53 (2d Cir. 1936).

195. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

196. Interview with Expert D (Oct. 1, 2020).

197. *Id.*

198. *Id.*

musicological significance in a copyright lawsuit: “If [the element at issue] is just a short melody, a short phrase, and I can find it happening frequently . . . I don’t think it’s worthy of protection. . . . I just think it’s something that seems to make sense.”<sup>199</sup>

Similarly, another interview subject said that the fact that the author may not have ever encountered the earlier works before “doesn’t matter.”<sup>200</sup> Their overarching concern was not to let any one claimant assert exclusivity over too basic a musical building block. Referencing the recent claim over Led Zeppelin’s guitar introduction to “Stairway to Heaven,” they asked incredulously whether a plaintiff who was truly unaware of various earlier works that included similar expression could now say that “he now owns a broken chord and a chromatic scale? That doesn’t make any sense to me.”<sup>201</sup>

This subject confirmed that it was “absolutely a part” of their job to assess the originality of an allegedly similar musical element.<sup>202</sup> “Prior art,” they explained, “is an incredibly important part of the job of determining how original something is.”<sup>203</sup> When asked what they meant by “originality” in this context, they stressed that “I know that originality has a very low bar” but that, even so, some musical expression just isn’t creative enough.<sup>204</sup>

One expert went so far as to quantify prior art’s relevance to substantiality: “We have criteria. We actually weigh it. We basically have created a scale . . . in essence of one to ten, one being completely dissimilar and ten being near identical as in a sampling case.”<sup>205</sup> They added, “we also have a scale of one to ten for originality. And you can conceivably have something that’s an eight or nine in similarity, but one or two or nothing in originality.”<sup>206</sup> Scoring that factor, this subject continued, depended on what already existed in the prior art:

If I find five other songs [that contain the musical element at issue], that kind of weakens the originality factor . . . . If [that element] is trivial, trite materials that can be found in countless other places, I would say that . . . it still doesn’t deny that they’re similar, it just denies the significance of the similar part.<sup>207</sup>

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199. *Id.*

200. Interview with Expert E (Feb. 8, 2021).

201. *Id.*

202. *Id.*

203. *Id.*

204. *Id.*

205. *Id.*

206. *Id.*

207. *Id.*

Or, to put a finer point on it, “it doesn’t mean they’re not similar, it just means the similarity doesn’t matter in a legal proceeding.”<sup>208</sup>

There was one subject, however, who offered something of a dissenting view. Out of concern that a party might manipulate the substantiality question, they cautioned against using prior art to talk about a similarity’s importance. They illustrated that concern through a hypothetical example in which the defendant’s expert identified prior art containing the same sequence of notes as the pieces at issue—same rhythm, same pitches—such that only three notes were left between the two works at issue, one in each measure. The opposing expert would then argue that the remaining notes were insufficiently original to be protectable. But that dissective move, the interview subject told us, would obscure the reality of how the music actually sounds: “Then the argument was, well look at these notes. These three isolated notes. Are they protectable? No. Of course not. But those three notes don’t really exist anywhere . . . they’re a creation of this analysis.”<sup>209</sup>

To be sure, we suspect that many musicologists who have previously worked on a plaintiff’s behalf would be sympathetic. So, for that matter, would many judges who have expressed wariness over copyright defendants trying to break a work down into artificially small pieces.<sup>210</sup> Nevertheless, given how extensively most other experts engage in some degree of dissection, this interview subject’s aversion to using prior art in order to talk about substantiality struck us as an outlier.

### 3. Experts’ Work Flow

Each expert whom we interviewed described an individual process of conducting a prior art search, but those processes share some common features. Broadly speaking, they tended to rely on two sources the most. First, their own in-house know-how and deep knowledge of

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208. *Id.*

209. Interview with Expert B (Oct. 2, 2020).

210. *See, e.g.*, *Enter. Mgmt. Ltd. v. Warrick*, 717 F.3d 1112, 1119 (10th Cir. 2013) (“Any copyrightable work can be sliced into elements unworthy of copyright protection. Books could be reduced to a collection of non-copyrightable words. . . . Music could be distilled into a series of non-copyrightable rhythmic tones. A painting could be viewed as a composition of unprotectable colors.”); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003 (2d Cir. 1995) (“[I]f we took this [dissection] argument to its logical conclusion, we might have to decide that there can be no originality in a painting because all colors of paint have been used somewhere in the past.”) (internal quotation marks omitted); Daryl Lim, *Saving Substantial Similarity*, 73 FLA. L. REV. 591, 602 (2021) (“The problem, however, is that the protectable elements of any work can be dissected to a point where almost nothing remains but its unprotectable parts, and caselaw provides little indication of where to stop in the reductionist analysis.”).

musical repertory; and second, some kind of database or technological tool.

One expert whose process was generally representative of the full cohort explained that the tech would only get you so far. The subject boasted “a very broad musical education myself,” combined with “a team of people who also have . . . a century’s worth of musical mental library.”<sup>211</sup> To be sure, they said, “there is some technology that narrows it down a little bit, but it really takes the musical knowledge of someone with a vast musical literature background.”<sup>212</sup> They went on to explain that “part of it’s done through technology, say a lyric search . . . and then there’s a lot of what you might call on-the-ground searching of archives.”<sup>213</sup>

Another subject told us that they consult multiple resources, from online search queries to an informal professional network. “Online databases are very important,” this subject said, “and there are also some published sources, print sources that I’ve used. And also . . . just talking to other scholars and musicians who are really schooled musically, in popular music in particular, has been very fruitful for me . . . there are people out there who just have encyclopedic knowledge.”<sup>214</sup> Likewise, a different subject reported “occasional” use of technological tools, their “own repertoire knowledge,” and “sometimes consult[ing] anonymously with people, with other musicians I know who have other repertoire knowledge.”<sup>215</sup> One subject even reported building their own personal database from scratch: “I transcribe so much music. I’ve transcribed 50–60,000 pieces. I have a database of these. . . . And I’ve got over 11,000 CDs, I’ve got a ton of music. So I have access to a lot.”<sup>216</sup>

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In sum, our interview data reveals a group of expert witnesses whose professional self-understanding diverges sharply from the traditional doctrinal account of what experts are supposed to do in copyright cases. They view prior art research as a central part of their job. And for many of them, that research is important not just because it can help prove whether an accused infringer has actually engaged in copying, but also because it informs which musical bits and pieces

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211. Interview with Expert A (Oct. 8, 2020).

212. *Id.*

213. *Id.*

214. Interview with Expert B (Oct. 2, 2020).

215. Interview with Expert C (Sept. 24, 2020).

216. Interview with Expert D (Oct. 1, 2020).

deserve legal exclusivity in the first place. Having made the case that forensic musicologists are driving courts' doctrinal shift toward prior art, we turn in the next Part to the questions of how and why these experts have coalesced around that position.

### III. EXPERT COALESCENCE

Learned Hand's pronouncement that prior art had no major relevance in copyright held sway universally over the course of the twentieth century.<sup>217</sup> Yet so far over the course of the twenty-first, music infringement cases are giving prior art a meaningful—and, to some judges, indispensable—place in the doctrine. As the previous Part documented, expert witnesses have been pushing courts toward this shift.

They probably couldn't have succeeded in making that push, however, without sharing certain prior commitments. And indeed we found that our interview subjects agree on a lot. Terminologically, several of them personally use the phrase "prior art." All of them, whether they use that phrase or not, understand it to mean works that were known to the public before the creation of one or both of the parties' works.<sup>218</sup> They also agree, as discussed in Section II.B.2 above, that bringing prior art to the court's attention in the first place is the defendant's burden in a litigated dispute.<sup>219</sup>

Most fundamentally, they agree on the centrality of prior art to the expert's job.<sup>220</sup> For example, one expert told us that prior art "is of utmost importance, I'd say it's essential . . . to show whether there is music out there . . . even if it's just one piece . . . that was widely disseminated, . . . for a plaintiff, that would be pretty much the end of their case."<sup>221</sup> Another described prior art as "a very important part of the sort of combined information that's needed to make an informed decision about approach or whether or not to walk away entirely."<sup>222</sup> This shared focus on prior art is similarly borne out in the experts' work product. Most of the written reports we reviewed in Section II.A devoted substantial real estate to analyzing prior art.

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217. See *supra* text accompanying note 37 (discussing *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir. 1936)).

218. See, e.g., Interview with Expert E (Nov. 5, 2020) (using prior art to mean "works publicly known before the date of both works in question").

219. See, e.g., Interview with Expert A (Oct. 8, 2020) ("[I]t is not the burden of the plaintiffs to provide prior art.").

220. See *supra* note 182.

221. Interview with Expert B (Oct. 2, 2020).

222. Interview with Expert A (Oct. 8, 2020).

Here in this final Part, we explore some possible explanations for how forensic musicologists coalesced around the concept of authorial prior art, notwithstanding decades of case law sweeping in the opposite direction. Part of the answer may lie in the social processes through which these musicologists build expertise and in turn project it to others. Another may have to do with their individual economic incentives. Though it's beyond our scope here to prove the causal link, we at least suspect that both sociological and economic factors are at work, which we describe below.

### A. A Community of Experts

As a group, forensic musicologists share two salient characteristics: First, they have a deep, technical knowledge base. These experts sit at the intersection of two specialized fields, musicology and copyright law. Though they are not typically trained in law directly, forensic musicologists often work closely with lawyers to tailor their knowledge to the complicated and quirky world of copyright litigation.

Second, there aren't many of them. The American Musicology Society, a leading scholarly organization in the field, lists a total of thirty-five individuals who self-report a specialization in forensic musicology.<sup>223</sup> While it's possible that many of these people are active in a nontestifying capacity as consultants, our review of the last few decades of music copyright judicial decisions suggests a more conservative count of around six names that regularly appear in litigation. In other words, forensic musicology is a very small and very exclusive club. The select few in it understand the confluence of two niche subject areas, musicology and copyright law, that most others do not. Indeed, even within the broader field of musicology, the methodology of forensic musicologists is something of a world unto itself.<sup>224</sup>

That this group is both deeply knowledgeable and also small is probably related. There simply aren't many people who can do what

<sup>223</sup>. *Forensic Musicology*, AM. MUSICOLOGICAL SOC'Y, <https://www.amsmusicology.org/page/ForensicMusicology> (last visited Mar. 9, 2022) [<https://perma.cc/A5NU-5989>].

<sup>224</sup>. See Robert Fink, *Blurred Lines, Ur-Lines, and Color Lines*, AMS MUSICOLOGY NOW (Mar. 15, 2015), <https://musicologynow.org/blurred-lines-ur-lines-and-color-lines/> [<https://perma.cc/4MPN-JTZ5>] (describing, from the perspective of a university musicology professor, the difference between academic musicology's more abstract "conceptual modes of thinking" and forensic musicology's necessarily "clear lines" and "'just the facts ma'am' phenomenology of music, stubbornly shallow and literalist, yes, but also free from . . . the hidden ideological claptrap of musicological training" (internal quotation marks omitted)).

forensic musicologists do, and the training involved in acquiring the expertise is significant.<sup>225</sup> With such an intimate size, one might think the members of this profession would be in regular communication. We initially hypothesized that they probably had some outlet for face-to-face knowledge-sharing.<sup>226</sup> Perhaps, we conjectured, these experts had cultivated shared norms and expectations while socializing and working alongside each other.

Yet every expert with whom we spoke could think of no such networking outlet: no formal professional organization, no annual conference, no series of happy hours or meet-ups. At most, one said, there might be an informal lunch here or there with an individual colleague.<sup>227</sup> Beyond that, however, their most extensive interaction comes only as opposing experts during litigation.<sup>228</sup> In other words, the experts we spoke with do not describe themselves as inhabiting a conventional community of practice whose members cluster within the same institutions and maintain regular social interactions.

Nevertheless, even absent those channels, forensic musicologists have evidently still developed their own norms around prior art's value. While we can't say for sure, it's possible that this process of norm generation is occurring through reading each other's works instead of through in-person socialization. Our interview subjects all described reading their peers' reports, when publicly available, as well as judicial opinions in other music infringement cases in which they were not personally engaged. For example, one told us that they "try to keep abreast of cases that are current, and when possible, I like to look at other musicologists' reports. . . . I also look at amicus briefs that are filed. I try to keep up with that."<sup>229</sup> Another said, "It's only a handful of people who do this, and we all know who each other are, because we read each other's reports, often in opposition."<sup>230</sup> These reports seem to function as a sort of literature within the field. And by repeatedly

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225. When asked how long they had been in practice, for example, one expert we spoke with told us they had been honing their craft for "more than twenty-five years"; another said they began "about twenty-five plus years ago." Interviews with Experts E (Nov. 5, 2020), A (Oct. 8, 2020). A third told us, "I've been a professional musician since I was twelve . . . [and] working as an expert witness since 1993." Interview with Expert D (Oct. 1, 2020).

226. Such communities of practice are common in specialized fields. *See, e.g.*, Laura G. Pedraza-Fariña, *Patent Law and the Sociology of Innovation*, 2013 WIS. L. REV. 813, 839 (summarizing findings from the sociology of scientific expertise, in which individual experts inhabit social worlds that are "defined by a core set of activities: accepted practices, techniques, legitimate research goals, training procedures, and relationships among a cluster of practitioners").

227. Interview with Expert A (Feb. 18, 2021).

228. *Id.*

229. Interview with Expert B (Feb. 11, 2021).

230. Interview with Expert C (Feb. 11, 2021).

exposing its readers to the same prior-art-driven techniques, that literature may be contributing to the interview subjects' commitment to the concept.

### B. *The Market for Experts*

Alongside sociological explanations, there's probably some level of individual economic incentives pushing experts toward prior art as well. The recent proliferation of high-profile infringement cases and record-setting jury verdicts has raised the visibility of music copyright infringement litigation.<sup>231</sup> This publicity, in turn, has elevated the status and importance of the expert witness, who is so often crucial to the outcome.<sup>232</sup> At the same time, the field is becoming busier.<sup>233</sup> As one entertainment lawyer told *Rolling Stone* in 2018: "Since the 'Blurred Lines' case, there has been an increase in calls to lawyers from clients along the lines of, 'This sounds a little like this [other song]. What do you think?' . . . This has certainly increased the workload for working musicologists."<sup>234</sup>

The increased demand for forensic musicologist services has not, however, been met with much new supply in the labor force. As our survey of expert reports in litigated cases confirmed, expert engagements tend to go to the same few individuals again and again. A musicologist looking to become, or remain, a repeat player would be well served to model the practices of successful experts in the field.

One such practice is the prior art search. Courts didn't used to consider these searches to be an indispensable part of music infringement cases, but experts are now successfully convincing the courts that they should be.<sup>235</sup> If these arguments continue to succeed in court, we should expect experts to keep making them. That's especially

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231. See ECONOMIST, *supra* note 130 (reporting that "[b]etween 1844 and 2014 no more than eight [music copyright] cases a year were heard in American federal courts," while "[t]he past six years have seen an average of 16"); Wang, *supra* note 13.

232. Andy Hermann, *Beyond 'Blurred Lines': How Forensic Musicology Is Altering Pop's Future*, ROLLING STONE (Apr. 4, 2018, 5:13 PM), <https://www.rollingstone.com/pro/features/beyond-blurred-lines-how-forensic-musicology-is-altering-pops-future-204986/> [<https://perma.cc/X6F7-9CYJ>] (noting that "the testimony of a savvy forensic musicologist can influence a jury in unpredictable ways").

233. See *id.* (quoting a longtime forensic musicologist's comment that, since the Blurred Lines litigation, "The last two years have been my busiest years ever."); ECONOMIST, *supra* note 130 (referencing a different forensic musicologist also saying that "he is doing more such work since 'Blurred Lines'").

234. Hermann, *supra* note 232.

235. See *supra* Section II.A.2. We found that Lawrence Ferrara, the expert who has appeared most frequently for defendants, has raised prior art in over forty-five separate cases over the last two decades.



true in the case of forensic experts, whose only marketplace lies in actual or threatened legal proceedings and so aren't limited by any external definition of reliable methods.<sup>236</sup>

From a judge's perspective, there are a number of reasons why prior art arguments could look attractive. Chief among them is the potential for a shortcut to dismiss clearly unmeritorious cases. Plaintiffs are filing many music infringement claims these days,<sup>237</sup> some of which aren't even colorable.<sup>238</sup> Given how much uncertainty surrounds the substantial similarity inquiry as a general matter, prior art might be used as a sorting mechanism to cull out the obviously losing claims.

For example, one of our interview subjects told us that prospective clients often come to them "convinced that their unreleased demo has been copied by a major pop star . . . and they believe incorrectly that their own work was original. . . . I spend a lot of my time talking down clients I don't really want to take on."<sup>239</sup> Another subject spoke of filtering out prospective cases even before a formal prior art search is conducted, based simply upon their knowledge of musical repertory. Despite similarities between the parties' works, they recommended against conducting a prior art search in such cases "because it can be very time-consuming, and it's expensive, and I don't think what you have here is going to amount to a strong case. . . . I don't recommend doing it."<sup>240</sup>

Another reason we may find courts today more amenable to prior art in copyright is its usefulness to juries. All cases of nonliteral copying implicate the question of whether or not the copied elements are significant. In music cases, the answer often isn't self evident.<sup>241</sup> One could build an answer on the basis of music theory, but no jury has time to learn that theory from scratch in the courtroom. Prior art might offer

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236. See Jennifer L. Mnookin, *Scripting Expertise: The History of Handwriting Identification Evidence and the Judicial Construction of Reliability*, 87 VA. L. REV. 1723, 1728–29 (2001) (observing that because forensic experts operate exclusively within legal proceedings, the lack of any exogenous definition of scientific validity encourages them to "shape their testimony explicitly to comport with judicial ideas about what is persuasive").

237. See Wang, *supra* note 13.

238. See, e.g., Porter Wells, *Pushing 'Meritless' Migos Infringement Suit Draws Sanctions*, BLOOMBERG (Feb. 27, 2020, 12:08 PM), <https://news.bloomberglaw.com/ip-law/pushing-meritless-migos-infringement-suit-draws-sanctions> [<https://perma.cc/CJT5-639Q>] (quoting a magistrate judge's conclusion that a plaintiff's copyright infringement claim was "objectively unreasonable").

239. Interview with Expert C (Sept. 24, 2020).

240. Interview with Expert B (Oct. 2, 2020).

241. See Gene Maddaus, *Bright Lines: Musicologists Police the Boundaries of Copyright Law*, VARIETY (Dec. 4, 2019), <https://variety.com/2019/music/news/forensic-musicologists-copyright-law-katy-perry-blurred-lines-1203423422/> [<https://perma.cc/7HYR-BZH6>] (quoting one forensic musicologist's observation that "it's often very difficult for the average person to understand some of the nuances and technical aspects of the music presented at trial").

befuddled jurors a concrete reference point that they could latch onto more easily than they could abstract principles of theory.

Finally, emphasizing prior art increases the experts' own value as a litigation resource. Conducting a prior art search is not something many people—certainly not many lawyers—can do. The more central these searches are in music infringement litigation, the more indispensable the experts become to the proceeding. By centering prior art in the analysis, then, experts may create some additional demand for their services.<sup>242</sup>

## CONCLUSION

Our findings suggest several lessons for modern copyright practice. An immediate one is tactical: more often than it's typically given credit for, prior art can win or lose some copyright infringement cases. For now, those cases are virtually all centered on music. Perhaps it will stay that way. If it does, it wouldn't be the first time that judges have crafted copyright rules that seem to operate differently for music than for other subject matter.<sup>243</sup> Or perhaps judges' receptiveness to prior art arguments will eventually migrate to cases involving other kinds of subject matter as well.<sup>244</sup> We don't offer a prediction here. But at least in the music cases where this shift is already underway, lawyers should be paying attention. Defense attorneys are leaving something on the table if they don't make an available argument that an alleged similarity carries less weight in light of overlapping earlier works. On the other side, plaintiff's attorneys are taking an underappreciated risk if they attack the legal premise of such arguments rather than trying to rebut it on the facts.<sup>245</sup>

But we think that there's a more systemic lesson here as well. Forensic musicologists' elevation of prior art as a copyright concept is a case study in how judges can refine their regulation of creative fields by listening to the specialists who know those fields best. As discussed

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242. There is some resonance here with the history of handwriting experts, the first forensic experts in the history of U.S. litigation, who framed their work as both scientific inquiry and juror education in order to make judges value it more. See Mnookin, *supra* note 236, at 1828.

243. See Fishman, *supra* note 24, at 913 (describing copyright doctrine's idiosyncratically high originality threshold for musical arrangements); Joseph P. Fishman, *Music as a Matter of Law*, 131 HARV. L. REV. 1861, 1893–94 (2018) (showing that copyright's infringement analysis historically treated music differently than it did other subject matter by focusing only on a single expressive element, melody, rather than on multiple elements).

244. The Second Circuit's decision in *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946), for example, was factually about music but ended up establishing the analytical framework for every future claim of infringing similarity through the present day.

245. See *supra* text accompanying notes 171–177 (discussing the failure of this strategy for the plaintiff in *Bowen v. Paisley*).

above, copyright doctrine famously minimizes expert witnesses' role in the infringement analysis.<sup>246</sup> It instructs that the lay observer, not the specialist, must be the one to answer whether a copyist has taken too much. That approach has received some withering criticism from scholars, who have argued that fact finders need a specialist's perspective to understand which of a work's elements actually qualify as protectable expression.<sup>247</sup>

Music cases, however, have proven complex enough that courts have set them alongside software as rarified places where experts actually get to weigh in. And now that those experts been invited to speak, our findings here reveal what they're actually saying: prior art affects an alleged similarity's significance. That message is simultaneously in deep tension with close to a century's worth of copyright jurisprudence and yet also perfectly persuasive to many judges today.

These judges are learning something that their predecessors on the bench never had a chance to hear. Forensic musicologists' perspective seems to be affecting not just the courts' view of the facts in discrete cases, but more fundamentally the legal standard that is to be applied across cases. Of course, musicologists will disagree in individual disputes just as expert witnesses do in every area of law. But when they agree on basic principles, as they increasingly have begun to in the context of prior art, courts ought to pay attention.

The courts that have been paying that attention may be finding an analytical tool they increasingly need to use. As plaintiffs file more of these music infringement claims, particularly involving the short

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246. See *supra* text accompanying note 104.

247. See, e.g., Lemley, *supra* note 104, at 739 (“Without the benefit of expert testimony and the ability to dissect the work, judges and juries are more likely to find infringement in dubious circumstances, because they aren’t properly educated on the difference between protectable and unprotectable elements.”); Jeanne C. Fromer & Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 MICH. L. REV. 1251, 1288–89 (2014) (arguing that copyright should welcome more expert testimony on infringement questions because experts can better identify whether a copied element was something standard within the genre or whether the defendant’s work had made a material artistic contribution); Pamela Samuelson, *A Fresh Look at Tests for Nonliteral Copyright Infringement*, 107 NW. U. L. REV. 1821, 1844 (2013) (arguing that “experts may be helpful in a wide range of cases” even beyond software “on issues such as the range of expressive alternatives, design features that have become standard in an industry, respects in which the work at issue is distinguishable from similar works, [and] the degree of its originality”); Shyamkrishna Balganesh, *The Questionable Origins of the Copyright Infringement Analysis*, 68 STAN. L. REV. 791, 859 (2016) (proposing a new infringement framework that “would require (and allow for) the introduction of expert testimony and for the judge to engage in an analytical dissection of the works in comparing them,” where “[s]uch testimony and dissection would guide the judge’s development of the appropriate normative criteria for cognizability by ensuring that it comports with accepted practices and norms within an area of creativity”).

snippets that seem to be occupying so much of the recent case law,<sup>248</sup> judges may find the concept of prior art to be a handy way to view a compositional choice in its full creative context. What's more, to the extent that the tool allows judges to resolve more cases on summary judgment, it also facilitates the emergence of an actual jurisprudence on acceptable versus unacceptable copying. Rather than leaving all such value judgments to the mysteries of the jury, prior art may help judges begin to articulate principles that, over time, could provide more clarity to future creators who'd like to figure out what's permissible.<sup>249</sup> Only weeks before this Article's publication, the Ninth Circuit affirmed the lower court's decision to vacate a jury's infringement verdict against Katy Perry.<sup>250</sup> The appeals court declared that "even when juries serve as factfinders, judges retain an important gatekeeping role in applying the law."<sup>251</sup> Allowing prior art into the adjudication helps judges fulfill that role.

Though the experts whom we studied are playing a significant role in shifting judges' practice on this issue, in our view they're not overstepping their bounds. It's well established that before any fact finder can evaluate the similarity between the parties' works, "the court must filter out the unprotectable elements of the plaintiff's work."<sup>252</sup> The prior art that experts are now pushing to the foreground supplies the factual predicate for courts to perform that filtration. Experts are providing information that helps courts fulfill their proper gatekeeping role of determining which elements of a work are protectable in the first place.

To be sure, we're not naive enough to think that increasing the amount of expert testimony will always lead to more satisfying case outcomes.<sup>253</sup> But we think it's at least important to know when the subject-matter specialists can agree on first principles, however much they might disagree on how to apply those principles to a given set of facts. Our system for adjudicating copyright infringement would be

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248. See *supra* text accompanying note 114 (noting frequency of claims over short fragments of musical works).

249. See Balganes, *supra* note 247, at 797 ("[D]iscouraging summary judgment on the [similarity] question in an effort to have juries make the determination has prevented copyright jurisprudence from developing a coherent set of rules and principles that might guide the decision, thereby producing a body of decisions that appears inextricably ad hoc and arbitrary.").

250. Gray v. Hudson 28 F.4th 87 (9th Cir. 2022); see also *supra* text accompanying note 111 (discussing the lower court's decision).

251. Gray, 28 F.4th at 96–97.

252. *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1118 (9th Cir. 2018) (internal quotation marks omitted).

253. On the contrary, one of us has previously criticized experts' role in the ballooning complexity and resulting unpredictability of music infringement cases. See Fishman, *supra* note 99, at 668–70.

better off if we gave courts more room—across all subject matter—to find out where such areas of agreement exist.