

## Are Rule 12(b)(6) Dismissals In Copyright Infringement Lawsuits In Danger?

Until recently, the Second and Ninth Circuits have both been receptive to dismissals under Rule 12(b)(6) if the court determines the plaintiff cannot plausibly state a claim of copyright infringement because the two works are not substantial similar. However, a pair of recent “unpublished” Ninth Circuit reversals involving prominent motion pictures stand in contrast to a recent Second Circuit decision affirming such a dismissal.

By Alan Friedman

Federal district courts in the U.S. Courts of Appeals for the Second and Ninth Circuits have regularly granted Rule 12(b)(6) dismissals of copyright infringement lawsuits against motion pictures and other literary works if, following review of the works in issue, the court determines the plaintiff cannot plausibly state a claim of copyright infringement because the two works are not substantial similar.

Motions to dismiss under Rule 12(b)(6) of the Federal Rules of Civil Procedure are typically confined to the allegations in the pleadings. However, consistent with the law in other circuits, the Second

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and Ninth Circuits permit consideration of documents incorporated by reference in or integral to the allegations in a complaint in resolving Rule 12(b)(6) motions. *See, e.g., Peter F. Gaito Architecture LLC v. Simone Dev. Corp.*, 602 F.3d 57 (2d Cir. 2010); *Knieval v. ESPN*, 393 F.3d 1068 (9th Cir. 2005). Under this rule, courts regularly review the allegedly infringed and infringing works on Rule 12(b)(6) motions.

Until recently, the Second and Ninth Circuits have both been receptive to such dismissals. However, a pair of recent “unpublished” Ninth Circuit reversals of Rule 12(b)(6) dismissals involving prominent motion pictures — *Zindel v. Fox Searchlight Pictures Inc.*, 18-56087 (9th Cir. 2020); *Alfred, II v. The Walt Disney Co.*, 19-55669 (9th Cir. 2020) — stand in contrast to a recent Second Circuit decision affirming such a dismissal. (Under Ninth Circuit Rule 36-3, “unpublished” decisions are not precedent



for unrelated copyright decisions. However, they may be cited by litigants and may influence how district court judges approach future Rule 12(b)(6) motions.)

While two unpublished reversals do not establish a trend, in an area in which copyright plaintiffs have historically met with little success, the close timing of these decisions adds to their impact. In fact, a third unpublished decision issued after the two reversals, affirmed a Rule 12(b)(6) dismissal of a copyright infringement claim because the plaintiff could not plausibly show

that the allegedly infringing movie was substantially similar to the plaintiff's book. *See, Masterson v. The Walt Disney Co.*, 19-55650 (9th Cir. 2020).

The tests in the Second and Ninth Circuits to determine substantial similarity, while not identical, share common elements. In the Second Circuit, courts ask "whether an average lay observer, unless he set out to detect the disparities, would be disposed to overlook them and regard [the] aesthetic appeal as the same." *Yurman Design Inc. v. PAJ Inc.*, 262 F.3d 101 (2d Cir. 2001) (internal citations and quotations omitted). Or, if the works in issue incorporate both protectable and unprotectable elements under the Copyright Act, courts in the Second Circuit, instead, apply a "more discerning observer" test, which requires substantial similarity between only the protectable elements of the two works. *See, e.g., Knitwaves Inc. v. Lollytops Ltd. (Inc.)*, 71 F.3d 996 (2d Cir. 1994). Regardless of which "observer" test applies, the Second Circuit also requires courts to examine the similarities of the works "total concept and feel, theme, characters, plot, sequence, pace and setting" in determining if a claim of substantial similarity can plausibly be stated. *See, e.g., Peter F. Gaito Architecture LLC v. Simone Dev. Corp.*, 602 F.3d 57 (2d Cir 2010).

In the Ninth Circuit, similar to the "more discerning observer" test, courts apply an "extrinsic test" through which courts assess the

objective similarities of the works in issue, focusing only on the protectable elements in the plaintiff's work. *Rentmeester v. Nike Inc.*, 883 F.3d 1111 (9th Cir. 2018). (In *Skidmore v. Zeppelin*, 952 F.3d 1051 (9th Cir. 2020), (*en banc*), the Ninth Circuit overruled *Rentmeester* on other grounds, *i.e.*, rejecting its application of the "inverse ratio" rule, which required a lower standard of proof of substantial similarity when the plaintiff established a "high degree of access" to plaintiff's work.) Under this test, the court filters out unprotectable elements, *e.g.*, material in the public domain and *scenes à faire* elements such as stock characters or standard features for the genre of the work and then compares the remaining protectable elements to assess similarity in the objective details of the works. For literary works, the extrinsic test focuses on the same type of similarities as the Second Circuit, including plot, themes, characters, pace and setting.

*Zindel v. Fox Searchlight Pictures Inc.*, 18-56087 (9th Cir. 2020), the first of the two recent reversals, involved a claim that the book and motion picture *The Shape of Water* infringed the copyright owner's stage play. The relevant works were properly presented to the district court in advance of its ruling that the works were not substantially similar. On review, the appellate panel first noted that the Ninth Circuit has long held that "[s]ummary judgment is 'not highly favored' on questions of substantial

similarity" and that "Courts must be just as cautious dismissing a case for lack of substantial similarity on a motion to dismiss" (internal citation omitted).

With that introductory context, the appellate panel ruled that the district court erred in dismissing the plaintiff's claim because "additional evidence, including expert testimony, would aid the objective literary analysis needed to determine the extent and qualitative importance of the similarities that Zindel identified in the works' expressive elements, particularly the plausibly alleged shared plot sequence." The panel stated that "[a]dditional evidence would also illuminate whether any similarities are mere unprotectable literary tropes or *scenes à faire*," without explaining why the district court's comparison of the works themselves was not sufficient.

The absence of such an explanation creates uncertainty in future cases in which a defendant argues that a copyright claim should be dismissed under Rule 12(b)(6) because the claimed similarities are unprotectable *scenes à faire*. (During the *Zindel* oral arguments, one member of the appellate panel characterized it as hubris for judges who don't go to film school to think they can dismiss anything but the most frivolous of claims under Rule 12(b)(6). This sentiment, while not included in the panel's decision, appears to be at odds with the Supreme Court's instruction in *Ashcraft v. Iqbal*, 556 U.S. 662 (2009), that determining whether a complaint states a

plausible claim “requires the reviewing court to draw on its own judicial experience and common sense.” (The defendant petitioned for rehearing en banc, which the Ninth Circuit denied.)

In *Alfred II v. The Walt Disney Co.*, 19-55669 (9th Cir. 2020), the second reversal from the Ninth Circuit, the plaintiffs claimed that the motion picture *Pirates of the Caribbean: Curse of the Black Pearl* infringed their copyrighted screenplay. In support of its reversal, the appellate panel found that the selection and arrangement of similarities between the two works was “more than de minimus” and that the district court failed to compare the original selection and arrangement of the unprotectable elements in the two works. The panel identified the alleged similarities as including: 1) beginning with a prologue from 10 years before the main story; 2) introducing the main characters during a battle, at gunpoint; 3) including treasure stories that take place on islands and in jewel-filled caves; 4) including past stories of betrayal by the first mate; 5) containing fearful moments involving skeletons; 6) focusing on the redemption of a young rogue pirate; and 7) sharing some similarities in dialogue and tone.

While the district court’s filtering out of the foregoing similarities under the extrinsic test as *scenes à faire* elements of works in the pirate genre was consistent with existing Rule 12(b)(6) decisions within the Ninth Circuit, the panel faulted the district court’s conclusion

that many of these shared elements were “unprotected, generic, pirate-movie tropes.” Instead, the panel ruled that, at the pleading stage, “it is difficult to know whether such elements are indeed unprotectable” and that “[a]dditional evidence would help inform the question of substantial similarity.” (Disney petitioned for rehearing en banc, which the Ninth Circuit denied.)

As with *Zindel*, *Alfred II* provides little guidance to district courts in resolving future motions to dismiss in which a defendant argues that the claimed similarities are unprotectable *scenes à faire* for the applicable genre. For example, in the spy genre, double identities, hiding secrets from loved ones, being tailed by enemy agents and avoiding detection, among others, are commonly recognized as classic *scenes à faire* elements — just like the elements in *Alfred II* appeared to be classic *scenes à faire* elements for the pirate genre. As such, the *Zindel* and *Alfred II* decisions may lead district court judges in the Ninth Circuit to be more restrained in granting motions to dismiss — even when supported by no more than *scenes à faire* elements — because the two Ninth Circuit panels questioned district judges’ qualifications to filter out these elements prior to the parties conducting discovery and hearing from experts.

While not involving a literary work, in *Platform Architecture & Design PLLC v. Escobar*, 1:20-cv-00012 (D.Ida. 2020), the district court, which resides in the Ninth

Circuit, recently denied a Rule 12(b)(6) motion to dismiss a copyright claim based upon the defendants’ alleged infringement of the plaintiff’s architectural drawings. After noting that “[j]udges are not trained architects,” the district court referred to the need for experts to determine if alleged similarities were of protectable or unprotectable elements. In support of its ruling, the district court cited, among other things, *Zindel*’s ruling that “additional evidence, including expert testimony, would aid in the objective literary analysis needed to determine the extent and qualitative importance of the similarities that [plaintiff] identified.”

To be sure, however, the sky is not falling. In the unpublished *Masterson v. The Walt Disney Co.* decision, issued after *Zindel* and *Alfred II*, the Ninth Circuit affirmed a Rule 12(b)(6) dismissal of a copyright claim. In that decision, the appellate panel ruled the plaintiff could not plausibly allege that the motion picture *Inside Out* was substantially similar to the plaintiff’s book of poetry. While not mentioning *Zindel* or *Alfred II* by name, the *Masterson* decision seemed to target them by including a lengthy string cite of unpublished Ninth Circuit decisions affirming Rule 12(b)(6) dismissals of copyright infringement claims asserted against literary works and rejecting plaintiff’s argument that determining substantial similarity necessarily requires expert testimony.

Alongside the trio of decisions from the Ninth Circuit, all from

summer 2020, the Second Circuit issued one of its own in which it affirmed the Rule 12(b)(6) dismissal of a copyright infringement claim due to lack of substantial similarity. In *Abdin v. CBS Broadcasting Inc.*, 19-3160 (2d. 2020), the plaintiff asserted that the television series *Star Trek: Discovery* infringed his copyrighted treatment of a videogame that included as one of its characters a “tardigrate,” which is a real life microscopic organism with a factually proven ability to survive in space. The Abdin plaintiff alleged the “tardigrade” character in *Discovery* was substantially similar to his “tardigrade” character, that *Discovery* copied his tardigrade’s space traveling abilities and the presence of other substantial similarities between the two works’ concepts, plots, overall feel and characters.

Applying the Second Circuit’s “more discerning observer” test, the appeals court ruled that Abdin could not plausibly allege substantial similarity, finding that the alleged similarities were unprotected facts, unprotected ideas and *scenes à faire* for works in the science fiction genre. The appeals court noted that “features and themes involving space travel” are unprotected *scenes à faire*, components that “are as a practical matter indispensable, or at least standard,” in the science fiction genre,” quoting *Hudson v. Universal Studios Inc.*, 04-civ-6997 (S.D.N.Y. 2008), *aff’d*, 369 Fed. App’x 291 (2d Cir. 2010). As such, the Second Circuit “ha[d] little trouble

concluding that many of the alleged similarities in the parties’ works (e.g., the use of a space ship, space travel and alien encounters) ‘are unprotectible elements that follow naturally from a work’s theme rather than the author’s creativity’” (internal citation omitted).

The Second Circuit’s treatment of commonplace elements in the science fiction genre stands in noticeable contrast to the Ninth Circuit’s ruling in *Alfred II*. It is hard to see the Second Circuit requiring additional evidence or expert opinion in order to affirm a district court ruling that treasure stories set on islands with jewel-filled caves, skeletons, betrayal by a first mate and redemption of a young pirate were unprotectable elements of a literary work in the pirate genre.

The recent Ninth Circuit cases do not provide enough data to draw a conclusion that that circuit may likely now be more receptive to permitting copyright claims involving literary works to proceed past the pleading stage than the Second Circuit. However, those decisions do reveal that, at the very least, some judges on the Ninth Circuit are open to arguments that district court judges: 1) lack the qualifications to determine at the pleading stage whether alleged similarities are unprotectable tropes or *scenes à faire*; and 2) should exercise restraint in dismissing infringement claims without first providing plaintiffs an opportunity to provide context and expert opinion not included in their complaint. Further, even though set forth in unpublished

rulings, the Ninth Circuit reversals will likely be cited in oppositions to future Rule 12(b)(6) motions and may be relied upon by district courts in denying those motions, as was the case in *Platform Architecture & Design PLLC v. Escobar*.

Given the frequency of copyright challenges to motion pictures and other literary works, relaxing the plausibility standard applicable to motions to dismiss those claims would be an unfortunate development. In cases in which the works in issue are before the district court, there is no reason to limit *Asbcraft’s* instruction that judges use their “judicial experience and common sense” in determining whether a plaintiff has stated a plausible claim of copyright infringement. In fact, the *Masterson* panel expressly cautioned against affording “special treatment” for plaintiffs in copyright lawsuits over literary works. Moreover, if district judges restrain their exercise of their experience and common sense in determining whether copyright claims involving literary works are founded upon unprotectable similarities, this would inevitably lead to wasteful litigation of claims flawed as a matter of law, which, in turn, would inevitably lead to a chilling of the creative process.

