

# THE COLUMBIA JOURNAL OF LAW *& the* ARTS

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A QUARTERLY JOURNAL OF LAW AND THE ARTS,  
ENTERTAINMENT, COMMUNICATIONS, AND INTELLECTUAL PROPERTY

Dividing Trademark Use

*Jeremy N. Sheff*

Copyright Infringement Test (Re)visited:  
U.S. Spillover into China Yielding a Similar Test?

*Yang Chen*

Lift Ev'ry Voice and Sing:  
Tracing the Legacy of Appropriation of Black Artists Under U.S. Copyright Law

*Sydni J. Wynter*

Rhyme and Reason: How Intellectual Property Law Can Inform  
the Use of Rap Lyrics as Evidence in Criminal Trials

*Amanda Wang*

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**Vol. 48, No. 2**

COLUMBIA LAW SCHOOL





# THE COLUMBIA JOURNAL OF LAW *& the* ARTS

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VOL. 48

NO. 2

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*Produced and published by members of the Columbia Journal of Law & the Arts.  
All members are students at Columbia Law School.*

Columbia Journal of Law & the Arts (JLA)  
Columbia Law School  
435 West 116th Street  
New York, NY 10027  
[jla-editor@law.columbia.edu](mailto:jla-editor@law.columbia.edu)  
<http://www.lawandarts.org>

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*ISSN (Print): 1544-4848  
ISSN (Online): 2161-9271*

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*Cite this volume: 48 COLUM. J.L. & ARTS.*

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*Typeset in Crimson Text.*

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*Printed in the United States of America.*

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*Printed by Sheridan PA, a CJK Group Company*

Sheridan  
450 Fame Avenue  
Hanover, PA 17331

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# THE COLUMBIA JOURNAL OF **LAW***&the* **ARTS**

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**VOL. 48**

**NO. 2**

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## Dividing Trademark Use

Jeremy N. Sheff\*

### ABSTRACT

*The trademark law of the United States places special emphasis on whether and how a trademark is used in commerce. But over the long history of the Lanham Act—including some less-than-careful drafting by Congress and some aggressive acts of interpretation by the federal courts—the concept of “use” has become complicated and in many ways confused. Two recent Supreme Court cases—Jack Daniel’s Properties, Inc. v. VIP Products LLC and Abitron Austria GmbH v. Hetronic International, Inc.—reflect and in some ways exacerbate that confusion. But the opinions in these cases also expose an interesting property of “use” in trademark law that has not been deeply examined in the caselaw or the academic literature. That property is that the use of a trademark can be divided among multiple agents with respect to a single product or service. The potential for divided use raises issues of secondary responsibility that trademark law has never comprehensively addressed. This Article catalogues the various notions of “use” in trademark law, shows how Jack Daniel’s and Abitron destabilize these notions, and applies principles of secondary responsibility to attempt to reconcile those cases with other contentious areas of trademark doctrine under the framework of divided use.*

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\* Professor of Law, St. John’s University School of Law. This Article benefited from discussion at the 2024 Tri-State Region IP Workshop at NYU Law School and at the 2024 Trademark and Unfair Competition Scholarship Roundtable at Harvard Law School, and particularly from comments from Megan Bannigan, Barton Beebe, Felicia Caponigri, Graeme Dinwoodie, Rochelle Dreyfuss, Christine Haight Farley, Michael Goodyear, Justin Hughes, Mark Lemley, Sari Mazzurco, Mark McKenna, Alexandra Roberts, Jennifer Rothman, Jessica Silbey, Eva Subotnik, Rebecca Tushnet, and Saurabh Vishnubhakat.

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## INTRODUCTION

The trademark law of the United States places special emphasis on the *use* of trademarks in affording those marks legal protection and determining the scope of that protection. But “use” means many different things and plays many different roles in United States trademark law. The *mere fact* of a plaintiff’s use is a criterion for establishing trademark rights;<sup>1</sup> the *mere fact* of a defendant’s use is an element of a claim of infringement.<sup>2</sup> The *manner* of a plaintiff’s use can be a barrier to the registration or protection of a trademark;<sup>3</sup> the *manner* of a defendant’s use can be a defense to liability.<sup>4</sup> The *location* of both parties’ use can affect the scope and priority of their rights; the *location* of both parties’ uses may also affect whether either of them can obtain any relief in American courts against the other.<sup>5</sup>

The complexity and ambiguity of “use” in trademark law have long been a bugbear of the scholarly literature. But recently the Supreme Court decided two cases that complicate the concept even further. In one case, *Jack Daniel’s Properties, Inc. v. VIP Products LLC*, the Court gave new life to the concept of “trademark use” in cases where a defendant’s use of a trademark implicates freedom of expression.<sup>6</sup> “When a mark is used *as a mark*,” the Court opined, “the likelihood-of-confusion inquiry does enough

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1. See Lanham Act § 45, codified as amended at 15 U.S.C. § 1127 (defining “trademark” as a symbol “used by a person . . . to identify and distinguish his or her goods” and defining “use in commerce” as “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”).

2. See Lanham Act § 32(1), 15 U.S.C. § 1114(1) (“Any person who shall, without the consent of the registrant . . . use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by the registrant for the remedies hereinafter provided.”); Lanham Act § 43(a)(1), 15 U.S.C. § 1125(a)(1) (“Any person who . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof . . . which . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.”); Lanham Act § 43(c)(1), 15 U.S.C. § 1125(c)(1) (“[T]he owner of a famous mark that is distinctive . . . shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark.”).

3. See U.S. PATENT & TRADEMARK OFF., TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMPEP”) § 1202 (2023) (“In an application under § 1 of the Trademark Act, the examining attorney must determine whether the subject matter for which registration is sought is used *as a trademark* . . . Not everything that a party adopts and uses with the intent that it *function as a trademark* necessarily achieves this goal or is legally capable of doing so . . .”) (emphasis added).

4. See, e.g., Lanham Act § 33(b)(4), 15 U.S.C. § 1115(b)(4) (providing a defense against trademark infringement liability where the defendant has used the plaintiff’s mark “otherwise than as a mark, . . . fairly and in good faith only to describe the goods or services of” the defendant).

5. See, e.g., *Dawn Donut Co. v. Hart’s Food Stores, Inc.*, 267 F.2d 358 (2d Cir. 1959).

6. *Jack Daniel’s Props. v. VIP Prods.*, 599 U.S. 140 (2023).

work to account for the interest in free expression,” making more defendant-friendly doctrinal screens (such as the two-part test formulated by the Second Circuit in *Rogers v. Grimaldi*) unwarranted.<sup>8</sup> In the other case, *Abitron Austria GmbH v. Hetronic International, Inc.*, the Court held that the Lanham Act’s jurisdictional “use in commerce” requirement does not extend liability to foreign conduct with effects on commerce in the United States, but rather limits liability to a defendant’s conduct within the United States.<sup>9</sup> In doing so, the *Abitron* majority—seemingly without realizing it—awakened long-festering concerns over whether the Lanham Act’s statutory definition of “use in commerce” is relevant to all the various forms of “use” that arise in trademark cases (including the “trademark use” that formed the basis of the Court’s opinion in *Jack Daniel’s*).

The opinion of the Court in *Abitron* drew two substantial concurring opinions. One, by Justice Sotomayor, disagreed about the majority’s application of the Court’s extraterritoriality precedents. She would have allowed trademark infringement liability to lie against foreign actors who cause consumer confusion in the United States, on grounds that the relevant “focus” of the Lanham Act, for purposes of the Court’s test for extraterritoriality, is the confusion of American consumers, and that imposing liability to redress that harm is a permissible domestic exercise of Congress’s powers even where some of the conduct causing that confusion occurs overseas.<sup>10</sup> The other, by Justice Jackson, focused instead on the question of use itself. She hypothesized that if a person sold a product bearing an allegedly infringing mark outside the United States to a buyer who later resold the product inside the United States, the *initial seller* could be considered to have “used” the mark *inside the United States* by virtue of their buyer’s subsequent U.S.-based conduct.<sup>11</sup>

At one level, the opinions in *Abitron* reflect sparring by the Justices of the Supreme Court over issues of territorial jurisdiction, choice of law, and comity. But when juxtaposed with the renewed focus in *Jack Daniel’s* not only on the *fact* and *location* of parties’ use of a trademark, but also the *manner* of that use, they expose an interesting property of use in trademark law that has not been deeply examined in the caselaw or the academic literature. That property—crystallized in Justice Jackson’s *Abitron* concurrence—is that use of trademarks can be *divided* with respect to a single product or service. Specifically, one party might perform some aspects of use—use of a mark in commerce subject to the jurisdiction of Congress, for example—but not a different aspect of use—use “as a mark,” for example—though a *different* party might perform that missing aspect of use with respect to the same mark on the same good or service. In such cases of divided use, interesting doctrinal questions arise. One question is whether the requirements of use that apply to either the acquisition of trademark rights (on the plaintiff side), or the infringement of such rights (on the defendant’s side), have

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7. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

8. *Jack Daniel’s*, 599 U.S. at 159 (emphasis added).

9. *Abitron Austria GmbH v. Hetronic Int’l*, 600 U.S. 412 (2023).

10. *Id.* at 432–46 (Sotomayor, J., concurring in judgment).

11. *Id.* at 429–32 (Jackson, J., concurring).

been satisfied. And even if the answer to this question is yes, we face an additional question: *Who* exactly has engaged in the required use? Where use is divided, this second question raises issues of secondary responsibility: When is it appropriate to ascribe the acts or omissions of one person to another person? And which types of acts or omissions are susceptible to such secondary responsibility?

These questions are most clearly presented in cases such as *Abitron* (and particularly in the hypothetical scenario of Justice Jackson's concurrence), where use is divided across national boundaries. But that is not the only way use may be divided in trademark cases. Sometimes one party in this country will use a trademark "in commerce," but not "as a trademark," while another party in this country will use the same trademark on the same goods or services "as a trademark," but not use it "in commerce." Unlike patent law, which has statutory provisions and mature decisional law that specifically address analogous scenarios of divided use,<sup>12</sup> trademark law has developed judge-made doctrines to deal with these types of scenarios on an *ad hoc* basis without recognizing the structural connection between them—indeed, without treating them as implicating the requirement of "use" at all. This Article will explore and organize such doctrines as various iterations of the overarching problem of *divided use*. Divided use implicitly involves secondary responsibility, but trademark law (unlike patent law) has not historically considered the problem in this context outside of the doctrine of contributory infringement liability.<sup>13</sup> This Article thus makes two novel contributions. First, it shows how various apparently unconnected doctrines can be understood as instantiations of the problem of divided use. And second, it integrates these various instantiations of divided use with principles of secondary responsibility. That juxtaposition reveals a deep theoretical question underlying the various problems of divided use involving the role of consumers in trademark law: Are consumer beliefs merely evidence of the nature or effects of parties' behavior, or are consumer behaviors attributable to the parties as a matter of legal responsibility?

This Article proceeds as follows. Part I catalogs the various types of "use" of a trademark that are relevant to determining the rights and liabilities of parties with interests in the trademark system. Part II demonstrates how some of these forms of use have traditionally been subject to secondary responsibility: One party could claim the benefit, or be subjected to the burden, of another party's use of a trademark. Part III then describes patterns of divided use in order to determine whether, in such scenarios, the rules of secondary liability reviewed in Part II could be used to establish the requisite forms of use identified in Part I.

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12. 35 U.S.C. § 271(f); *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 797 F.3d 1020, 1022 (Fed. Cir. 2015) ("Where more than one actor is involved in practicing the steps [of a patented method], a court must determine whether the acts of one are attributable to the other such that a single entity is responsible for the infringement. We will hold an entity responsible for others' performance of method steps in two sets of circumstances: (1) where that entity directs or controls others' performance, and (2) where the actors form a joint enterprise."); see generally Mark A. Lemley, David O'Brien, Ryan M. Kent, Ashok Ramani, & Robert Van Nest, *Divided Infringement Claims*, 33 AIPLA Q.J. 255 (2005).

13. See *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 853–54 (1982) (explaining the standard for contributory infringement liability in trademark law).



Part III considers the possibility that a party may engage in one type of “use” relevant to a trademark dispute but not another. For example, if the “use” required to show either the establishment of trademark rights by a plaintiff or the infringement of those rights by a defendant requires *both* “use in commerce” and “use as a trademark,” the possibility arises that a party could have engaged in one form of “use” but not the other. We might then look about to see whether any *other* party’s use could be attributed to that party and thereby fill the gap. This becomes important in at least three types of “divided use” scenarios, each of which has its own doctrinal architecture that has been developed in apparent disregard for the structural similarities among them. The first involves cross-border uses of the type involved in *Abitron*: where a party uses a mark as a trademark but not in commerce (at least not in commerce subject to the regulation of Congress). The second involves the post-sale confusion theory of liability most commonly invoked with respect to admitted knock-offs of luxury goods; in such cases a defendant uses a mark in commerce, and at least arguably uses it as a trademark, but such use does not cause any actionable confusion until some *other* use of the marked good is made by someone *other than* the defendant. The third involves expressive uses: where a party uses a mark in commerce but not (or not solely) as a trademark. In such contexts, again, a party uses the mark in commerce, but whether they also use it as a mark depends on resolving a deep theoretical debate within trademark law about the role of consumers.

The Article concludes by discussing that role and suggests that the framework of divided use helps us distinguish between two different ways of conceptualizing it. In the first—what I will call the “evidentiary view”—consumers are less *agents* than *evidence*: Their beliefs are the mere effects of the behaviors of the parties to trademark disputes, and evidence of those beliefs determines whether the parties’ behaviors give rise to legal rights or obligations. In the second—what I will call the “secondary responsibility view”—consumers are agents in their own right, and their behaviors are imputed to the parties to trademark disputes, who vicariously seek to vindicate both their own interests and the interests of aligned consumers. This Article does not seek to defend one of these views of the consumer in trademark law over the other, but rather points out that the latter view requires trademark law to take substantive positions on what uses of trademarks it will tolerate, without reference to the likelihood-of-confusion standard that has been the mainstay of the field for decades.

## I. USE IN TRADEMARK LAW

We may begin examining the concept of “use” in trademark law through the lenses of two separate doctrinal questions: (1) When does the presence or absence of “use” matter to any legal issue in a trademark dispute; and (2) What constitutes the “use” whose presence or absence matters in this way? We can begin to answer the first question by distinguishing between what I will call “plaintiff-side” use and “defendant-side” use.

### A. PLAINTIFF-SIDE AND DEFENDANT-SIDE USE

Use matters in two primary contexts in trademark law. First, on the side of the trademark plaintiff (or more broadly the claimant of intellectual property rights in a trademark), use of the mark by the plaintiff in connection with their goods or services is a prerequisite to obtaining trademark rights: It is an element of the mark's *validity*. Without using a mark, a plaintiff can claim no rights in it. Second, on the side of the trademark defendant, use of a trademark by the defendant is an element of any claim against that defendant under federal trademark law: It is an element of the cause of action for trademark *infringement*. (Relatedly, certain forms of use by a defendant may be insulated from liability; they may bear on the availability of certain *defenses*.)

#### 1. Plaintiff-Side Use: Use and Validity

Use of a trademark is a prerequisite to acquiring proprietary rights in that trademark. The trademark system of the United States, in contrast to those of most other nations, is a “use-based” system. In most other countries, trademark rights are initially acquired through *registration*: filing an application with the administrative agency that oversees intellectual property rights under the law of the jurisdiction.<sup>14</sup> This has never been true in the United States. Indeed, the first federal trademark statute was invalidated by the Supreme Court in the *Trade-Mark Cases*,<sup>15</sup> on grounds that Congress lacked the authority it had asserted to allocate trademark rights according to priority of registration. Congress had claimed such authority under the Progress Clause: the provision of the federal Constitution establishing Congress's power to grant patents and copyrights.<sup>16</sup> But as the Court explained, trademarks are not the types of “writings and discoveries” contemplated by the Progress Clause; in the Anglo-American tradition they were, historically at least, common-law rights appurtenant to the goodwill of an ongoing business:

The trade-mark may be, and generally is, the adoption of something already in existence as the distinctive symbol of the party using it. At common law the exclusive right to it

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14. Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS Agreement”), art. 15, ¶ 3, Apr. 15, 1994, 1869 U.N.T.S. 299 (“Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.”); Regulation (EU) 2017/1001, art. 6, 2017 OJ (L 154) 8 (“An EU trade mark shall be obtained by registration.”). Until recently, Canada also required use as a prerequisite to registration; it eliminated that requirement in 2019. An Act To Implement Certain Provisions of the Budget Tabled in Parliament on February 11, 2014 and Other Measures (Economic Action Plan 2014 Act, No. 1), S.C. 2014, c. 20, s. 345 (Can.); Order Fixing June 17 and 18, 2019 as the Days on Which Certain Provisions of the Three Acts Come Into Force, SI/2018-100 (Can.).

15. *In re Trade-Mark Cases*, 100 U.S. 82 (1879).

16. U.S. CONST. art. I, § 8, cl. 8 (granting Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”).

grows out of its use, and not its mere adoption. By the [challenged] act of Congress this exclusive right attaches upon registration. . . . While such legislation may be a judicious aid to the common law on the subject of trade-marks, and may be within the competency of legislatures whose general powers embrace that class of subjects, we are unable to see any such power in the constitutional provision concerning authors and inventors, and their writings and discoveries.<sup>17</sup>

Thus, in the United States, in order for a party to establish rights in a trademark, it must *use* that mark in connection with an ongoing business.<sup>18</sup> The *Trade-Mark Cases* implied that Congress could regulate the use of trademarks in those areas of commerce constitutionally committed to its supervision—i.e., “commerce with foreign nations, or among the several States, or with the Indian tribes”—but held that the statute before it was not limited to those spheres and therefore was not a valid exercise of the Commerce Power.<sup>19</sup> Subsequent federal statutes—including the Lanham Act, which is the current source of federal trademark law—have therefore all included such a limitation on their face.<sup>20</sup> Registration, in this view, confirms pre-existing common-law rights acquired by use and allows them to be extended nationwide on a uniform basis, pursuant to Congress’s power to regulate interstate commerce.

Despite this grounding of federal trademark law and the federal registration system in the Commerce Power, the requirement of use as a prerequisite to the acquisition of trademark rights—even registered rights—has persisted. The Lanham Act’s current statutory definition of a trademark is “any word, name, symbol, or device, or any combination thereof . . . *used by a person* . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods.”<sup>21</sup> As the Supreme Court recently explained:

Registration of a mark is not mandatory. The owner of an unregistered mark may still use it in commerce and enforce it against infringers. But registration gives trademark owners valuable benefits. For example, registration constitutes “prima facie evidence” of the mark’s validity. And registration serves as “constructive notice of the registrant’s claim of ownership,” which forecloses some defenses in infringement actions. Generally, a trademark is eligible for registration, and receipt of such benefits, if it is “used in commerce.”<sup>22</sup>

In short, *use* of a trademark is *the* key act required to establish protectable legal rights in that trademark, whether registered or unregistered.<sup>23</sup> For this reason, showing that

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17. *Trade-Mark Cases*, 100 U.S. at 94.

18. *Lyons v. Am. Coll. of Veterinary Sports Med. & Rehab.*, 859 F.3d 1023, 1027 (Fed. Cir. 2017) (“It is axiomatic in trademark law that ownership of a mark is predicated on priority of use in commerce.”).

19. *Trade-Mark Cases*, 100 U.S. at 96–97.

20. See, e.g., Lanham Act § 45, 15 U.S.C. § 1127 (2023) (“The word ‘commerce’ means all commerce which may lawfully be regulated by Congress.”).

21. Lanham Act § 45, 15 U.S.C. § 1127 (2023) (emphasis added).

22. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297–98 (2019) (internal citations omitted).

23. While the filing of an “intent-to-use”-based application to register a trademark can constitute *constructive* use of that mark *if* the application ultimately proceeds to registration, such an application *cannot* proceed to registration until the applicant has *actually used* the mark. See Lanham Act §§ 1(b), 1(d), 7(c), 15 U.S.C. §§ 1051(b), 1051(d), 1057(c) (2023). If a mark is unregistered, rights in that mark are limited to the

a party never used a claimed trademark, or has ceased using that trademark, defeats any claim that they own the mark,<sup>24</sup> and a plaintiff who does not own a trademark cannot claim infringement of that mark.<sup>25</sup>

## 2. Defendant-Side Use: Use and Infringement

Use of a trademark is also an element of any claim of infringement of a right in that trademark. Insofar as the use of a trademark establishes an exclusive intellectual property right in that trademark, the infringement of that right consists in a violation of that exclusivity. That is: Infringement arises where a defendant *uses* another's trademark in commerce without that person's consent,<sup>26</sup> provided all other elements of an infringement claim (particularly that the defendant's use is likely to cause confusion<sup>27</sup>) are present. If an infringement defendant has not *used* the plaintiff's trademark (or at least a mark similar enough to cause confusion), the defendant cannot be held liable.

For some trademarks, however, some types of uses of the mark will give rise to liability, while others will not. A defendant's mere placement of another person's trademark somewhere on a product will not necessarily be enough to establish a "use" of that mark that will subject the defendant to trademark infringement liability. To take a simple example, Apple Inc. will not be able to prevail on a trademark infringement claim against a greengrocer who advertises "apples" for sale, even though "Apple" is a

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territorial extent of its actual use. *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 415–16 (1916); *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97–98, 100–101 (1918).

24. *Aycock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1357 (Fed. Cir. 2009) ("The registration of a mark that does not meet the use requirement is void ab initio."); *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 954–55 (7th Cir. 1992) ("Because trademark rights derive from the use of a mark in commerce and not from mere registration of the mark, the owner of a mark will lose his exclusive rights if he fails actually to use it."). The recently enacted Trademark Modernization Act provides two new administrative procedures for expunging or cancelling marks that were erroneously registered despite failing to meet the use requirement. *See* Lanham Act § 16(a)–(b), 15 U.S.C. § 1066(a)–(b) (2023).

25. *1-800 Contacts, Inc. v. WhenU.Com, Inc.*, 414 F.3d 400, 406–07 (2d Cir. 2005) ("In order to prevail on a trademark infringement claim for registered trademarks, pursuant to 15 U.S.C. § 1114, or unregistered trademarks, pursuant to 15 U.S.C. § 1125(a)(1), a plaintiff must establish that (1) it has a valid mark that is entitled to protection under the Lanham Act . . .") (footnotes omitted). Even if a mark is registered, it generally cannot be enforced outside the geographic area of its actual use. *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358, 364 (2d Cir. 1959) ("[I]f the use of the marks by the registrant and the unauthorized user are confined to two sufficiently distinct and geographically separate markets, with no likelihood that the registrant will expand his use into defendant's market, so that no public confusion is possible, then the registrant is not entitled to enjoin the junior user's use of the mark.") (footnote omitted).

26. *1-800 Contacts*, 414 F.3d at 406–07 ("In order to prevail on a trademark infringement claim for registered trademarks, pursuant to 15 U.S.C. § 1114, or unregistered trademarks, pursuant to 15 U.S.C. § 1125(a)(1), a plaintiff must establish that . . . (2) the defendant used the mark, (3) in commerce, (4) 'in connection with the sale . . . or advertising of goods or services,' 15 U.S.C. § 1114(1)(a), (5), without the plaintiff's consent.") (footnotes omitted).

27. Lanham Act §§ 32(a), 43(a)(1)(A), 15 U.S.C. §§ 1114(a), 1125(a)(1)(A) (2023); *see also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 20 cmt. d (AM. L. INST. 1995) ("The term 'likelihood of confusion' has long been used to describe the standard of liability for trademark infringement in actions at common law and under federal and state trademark and unfair competition statutes.").

valid and enforceable trademark owned by Apple, Inc. and even though the greengrocer has used the trademark in commerce. Nor does this conclusion necessarily depend on the absence of confusion arising from the greengrocer's use of the term: Even if some bemused consumers later showed up at the grocery hoping to buy the latest iPhone, the greengrocer could still continue to advertise "apples" (i.e., the fruit) for sale without fear of liability. After *Jack Daniel's* and *Abitron*, however, the doctrinal path that allows the greengrocer to avoid liability is not necessarily clear. Perhaps a court will find that he has not used the term "Apple" as a trademark, and that this means he has not made the "use in commerce" of a plaintiff's trademark required to give rise to infringement. Perhaps a court will find that he has made the necessary "use in commerce" or "commercial use" but that this use is "otherwise than as a mark," allowing him to claim the statutory descriptive fair use defense.<sup>28</sup> And perhaps the fact that he has used the mark in a non-trademark manner (to identify the nature of his products rather than their source) will be deemed relevant to the selection or application of a doctrinal test for infringement that makes a finding in his favor all but assured.<sup>29</sup> As the rest of this Part explains, there are multiple different aspects of "use," and they each play slightly different roles in establishing trademark validity, infringement, and defenses.

## B. ASPECTS OF USE

Some of the most vexing doctrinal issues in trademark law arise around the question of what constitutes "use" of a trademark sufficient to satisfy the requirements for establishing trademark ownership and validity on the plaintiff side, or for the purpose of establishing or avoiding liability for infringement on the defendant side. The most obvious source of guidance on these questions is the statutory definition of "use in commerce" in Section 45 of the Lanham Act.<sup>30</sup> Unfortunately, that definition (like much of the Lanham Act) is a product of multiple rounds of careless drafting and amendment by Congress. Some courts have engaged in heroic interpretation of the statutory definition in order to maintain the coherence of trademark law; other courts have carelessly interpreted the definition in ways that threaten that coherence. Moreover, courts and the United States Patent and Trademark Office ("USPTO") have added additional glosses on the meaning of "use" in order to capture certain policy concerns that arise in trademark law in a process of common-law evolution, without grounding those concerns in the text of the Lanham Act itself. The result is that "use"

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28. Lanham Act § 33(b)(4), 15 U.S.C. § 1115(b)(4) (2023) (establishing a defense against infringement for certain uses of a plaintiff's trademark "otherwise than as a mark").

29. *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 155–56 (2023) ("[T]he *Rogers* [*u. Grimaldi*] test has applied only to cases involving 'non-trademark uses'—or otherwise said, cases in which 'the defendant has used the mark' at issue in a 'non-source-identifying way.' The test has not insulated from ordinary trademark scrutiny the use of trademarks as trademarks, 'to identify or brand [a defendant's] goods or services.'") (quoting Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669, 1683–84 (2007)).

30. 15 U.S.C. § 1127 (2023). This section includes the generally applicable definitions for the rest of the Lanham Act, which are stated to apply "unless the contrary is plainly apparent from the context." *Id.*

of a trademark has been decomposed across trademark doctrine into a number of distinct considerations. These include:

- “Use in commerce,” which in turn may be decomposed into:
  - “Bona fide use,” and
  - “Affixation and entry into commerce”;
- “Commercial use”;
- “Trademark use”; and
- “Use in commerce subject to the control of Congress.”

Some of these considerations are clearly grounded in statutory text; others less clearly so. Some apply similarly to both plaintiff-side and defendant-side use, others apply only to one or the other, and still others apply differently in either context. The result is a tangled rat’s nest of doctrinal threads that are easy to confuse or conflate with one another. This Section attempts to tease them apart.

### 1. “Use” and “Use in Commerce”—The Statutory Framework

Section 45 of the Lanham Act defines the “use in commerce” of a trademark as follows:

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.<sup>31</sup>

This is the only explicit, generally applicable definition of “use in commerce,” and indeed even of “use,” in the Lanham Act.<sup>32</sup> It contains two general requirements that

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31. Lanham Act § 45, 15 U.S.C. § 1127 (2023).

32. The statutory definition of abandonment has its own definition of use, which reproduces a portion of the statutory definition of use in commerce. See Lanham Act § 45, 15 U.S.C. § 1127 (“A mark shall be deemed to be ‘abandoned’ if . . . its use has been discontinued with intent not to resume such use. . . . ‘Use’ of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.”).

will be discussed further below: a “bona fide use” requirement, and an “affixation and entry into commerce” requirement. But a problem immediately arises from an attempt to incorporate these two requirements into appearances of the terms “use” or “use in commerce” elsewhere in the statute.

Such appearances occur in four places of interest to this Article. Two of these appearances are relevant to plaintiff-side use. They are:

- A separate provision of Section 45 of the Lanham Act, which defines a “trademark” in relevant part as “includ[ing] any word, name, symbol, or device, or any combination thereof (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register . . . to identify and distinguish his or her goods . . . and to indicate the source of the goods . . . .”<sup>33</sup>; and
- Section 1 of the Lanham Act, which provides for federal registration of “a trademark used in commerce.”<sup>34</sup>

The other two appearances are relevant to defendant-side use:

- Section 32 of the Lanham Act, which establishes a private right of action for infringement against any person who, without the consent of the owner of a registered trademark, “use[s] in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion”;<sup>35</sup> and
- Section 43(a) of the Lanham Act, which similarly establishes a private right of action for infringement of an unregistered trademark by subjecting to liability any person who, “on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof . . . which . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.”<sup>36</sup>

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33. 15 U.S.C. § 1127 (2023) (emphasis added).

34. 15 U.S.C. § 1051(a) (2023) (“The owner of a trademark used in commerce may request registration of its trademark on the principal register . . . .”) (emphasis added in text). Sections 8 and 9 of the Lanham Act provide that continued use in commerce is a prerequisite for maintenance and renewal of a registration. 15 U.S.C. §§ 1058–1059 (2023).

35. 15 U.S.C. § 1114(1) (2023) (“Any person who shall, without the consent of the registrant . . . use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by the registrant for the remedies hereinafter provided.”) (emphasis added in text).

36. Lanham Act § 43(a)(1), 15 U.S.C. § 1125(a)(1) (2023) (“Any person who . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof . . . which . . . is likely to cause confusion,

There are several problems that arise when trying to apply the statutory definition of “use in commerce” to these four statutory provisions. First, the “bona fide use of a mark in the ordinary course of trade” element of the statutory definition in Section 45 was added to the statute to address concerns about plaintiff-side use arising from a change to the registration system in 1988, making its application to defendant-side use unclear and perhaps even absurd. And second, the definition fails to capture other aspects of use that courts and the USPTO have engrafted onto trademark law.

*a. Bona Fide Use*

The first sentence of the Lanham Act’s current statutory definition of “use in commerce,” which requires “bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark,” was added to the statute in 1988, before which time the definition consisted of the language *following* this sentence only. This addition was part of an overhaul of federal registration that created the “intent-to-use” application system.<sup>37</sup> This system allows applicants for registration to *apply* for a trademark registration *before* actually using their mark, with the understanding that the registration cannot *issue* until *after* use of the mark has been made.<sup>38</sup> This change to the registration system helped to avoid situations where two or more parties would, unbeknownst to one another, simultaneously undertake costly preparations to launch a new brand, only to find that only one of them would be able to protect that brand as a trademark, causing the other companies’ investments to go to waste.<sup>39</sup> Prior to 1988, the risk of such undeserved forfeiture had led the USPTO to accept so-called “token uses” as a sufficient basis to apply for a registration. Such uses—typically involving a pretextual shipment of prototype goods with a mock-up label across state lines to a party colluding in the pretext—allowed an application to be filed that could give the applicant some comfort that their more substantial subsequent investments in preparing to market goods under the mark would not be wasted.<sup>40</sup> That is, they were uses designed primarily, if perhaps not “merely,” to “reserve a right in a mark.”

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or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.” (emphasis added in text). Use in commerce is also invoked in the statutory definition of dilution, but antidilution rights are not of interest to the project of this Article. *See* Lanham Act § 43(c)(1), 15 U.S.C. § 1125(c)(1) (2023) (“[T]he owner of a famous mark that is distinctive . . . shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark.”)

37. Trademark Law Revision Act of 1988 Pub. L. No. 100–667, 102 Stat. 3935.

38. *See* Lanham Act § 1, 15 U.S.C. § 1051 (2023).

39. *See, e.g.,* Blue Bell, Inc. v. Farah Mfg. Co., Inc., 508 F.2d 1260, 1262 (5th Cir. 1975) (resolving a priority dispute between “two prominent manufacturers of men’s clothing [who] created identical trademarks for goods substantially identical in appearance . . . [with] no indication of bad faith in the design and adoption of the labels”).

40. *Standard Pressed Steel Co. v. Midwest Chrome Process Co.*, 183 U.S.P.Q. 758, 764 (T.T.A.B. 1974) (“[I]n view of the expenditures involved in introducing a new product on the market generally and the



The intent-to-use system established in the 1988 amendments to the Lanham Act abolished this practice and the legal fiction that rested upon it. In one sense the new system goes even further than the USPTO had done, allowing businesses to apply to register a trademark before making even a “token use” of it, merely by swearing that they have a bona fide intent to use the mark in commerce. The filing of such an intent-to-use application constitutes “constructive use” of the trademark, conferring nationwide priority as of the application’s filing date, *provided that* the application ultimately proceeds to registration.<sup>41</sup> More importantly, it puts the rest of the world on notice of the applicant’s claim to the mark via the public record at the USPTO, and thus (hopefully) avoids wasteful duplication of investment in the mark by others. Such a filing does not, however, allow a registration to issue until a “bona fide use” of the mark has been made.<sup>42</sup> The intent and the effect of the 1988 amendments was thus to make *plaintiff-side* trademark use—the use needed to establish a right to registration—procedurally easier to establish and more transparent, but substantively more demanding.<sup>43</sup>

The bona fide use requirement makes good sense in the context of plaintiff-side use under an intent-to-use system. Requiring bona fide use prior to enforcing a trademark or issuing a registration serves as an important guard against wasteful rent-seeking or trademark hoarding, by refusing to allocate trademark rights to parties that do not

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attendant risk involved therein prior to the screening process involved in resorting to the federal registration system and in the absence of the existence of an ‘intent to use’ statute, a token sale or a single shipment in commerce may be sufficient to support an application to register a trademark in the Patent Office notwithstanding that the evidence may not show what disposition was made of the product so shipped. That is, the fact that a sale or a shipment of goods bearing a trademark was designed primarily to lay a foundation for the filing of an application for registration does not, per se, invalidate any such application or a registration subsequently issued thereon.”).

41. Lanham Act § 7(c), 15 U.S.C. § 1057(c) (2023).

42. See Lanham Act §§ 1, 13(b), 15 U.S.C. §§ 1051, 1063(b) (2023).

43. As the Senate sponsor of the amendments explained:

American companies can expend months or years and hundreds of thousands of dollars in developing a new product only to discover that another company has already used the same trademark. Even more disturbing is the fact that foreign companies applying to register trademarks in the United States are not subject to these same use requirements that apply to U.S. applicants [under international treaties to which the United States is signatory]. This discriminating aspect of the Lanham Act has resulted in the commercially transparent practice of “token use,” in which the first sale is generally of a less than commercial quantity of the product, often one-case shipment or even as little as a single unit.

The proposed legislation provides for a dual system of filing, whereby the applicant for trademark registration can file in one of two ways, either by using the Lanham Act’s existing use provision or by using the new “intent-to-use” provision. Applicants will also be subject to a more stringent definition of use in commerce, which will help to eliminate the practice of “token use.” At the same time, applicants will receive the benefit of “constructive use” establishing nationwide priority from the date of filing. . . . By allowing applicants to file based on an intent to use the mark in commerce, the new legislation will save time, money and effort manufacturers must expend to market a new product. It will also eliminate the inefficient practice of “token use” which has created legal uncertainty.

133 CONG. REC. 32812–13 (Nov. 19, 1987) (statement of Sen. DeConcini). See also *United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors*, 77 TRADEMARK REP. 375, 393 (1987) (explaining the advantages of an intent-to-use system over token use).

themselves use the mark productively as a symbol of the goodwill an ongoing business. It allocates priority of rights in trademarks based on the public fact of filing rather than on the private fact of token use. And it thereby protects good-faith investments in preparations to launch a new brand against unwitting forfeiture.

The problem is that these changes to the statutory definition of “use in commerce,” necessary to the tightened standards of plaintiff-side use under the new intent-to-use registration system, are not explicitly limited to the plaintiff-side “use in commerce” required to support registration. Section 45 of the Lanham Act explicitly states that its definitions apply throughout the Lanham Act “unless the contrary is plainly apparent from the context.”<sup>44</sup> And as noted above, the term “use in commerce” also appears as an element of the cause of action for trademark infringement, whether registered or unregistered.<sup>45</sup>

In this defendant-side context, the statute’s “bona fide use” requirement makes far less sense. As the Second Circuit observed in *Rescuecom Corp. v. Google, Inc.*,<sup>46</sup> attempting to impose a general bona fide use requirement on the use of another’s mark that subjects a defendant to infringement liability would be perverse, because it “would mean that an accused infringer would *escape* liability, notwithstanding deliberate deception, precisely because he acted *in bad faith*. A bad faith infringer would not have made a use in commerce [under Section 45’s statutory definition], and therefore a necessary element of liability would be lacking. Liability would fall only on those defendants who acted *in good faith*.”<sup>47</sup>

Even if we do not join the Second Circuit in reading the statutory term “bona fide” literally in the broad general sense of “good faith,” and treat “[use] merely to reserve a right in a mark” as a particularly disqualifying type of activity not otherwise relevant to determining the boundaries of “use in commerce,” typical defendant-side use is still difficult to characterize as “bona fide.” The Second Circuit’s consideration of the term, for example, became the subject of an extensive and unusual “appendix” to its opinion in *Rescuecom*,<sup>48</sup> which concluded that the statutory definition of “use in commerce” should not, and was not intended to, apply to what this Article has called defendant-side use. The court nevertheless concluded that, because of Congress’s carelessness in amending Section 45, the definition *does* apply to defendant-side use—*except for* the bona fide use requirement of the definition’s first sentence, which *only* applies to what this Article has called plaintiff-side use.<sup>49</sup> This solution, which was adopted with apparent reluctance in part to avoid overruling the Second Circuit’s own prior

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44. 15 U.S.C. § 1127 (2023).

45. See *supra* notes 35–36 and accompanying text.

46. 562 F.3d 123 (2d Cir. 2009).

47. *Id.* at 132.

48. *Id.* at 131–41.

49. *Id.* at 139–40.

precedent,<sup>50</sup> was later adopted with greater enthusiasm by the Ninth Circuit.<sup>51</sup> The leading trademark treatise goes even further, opining that the Section 45 definition of “use in commerce” “defines the kinds of ‘use’ needed to acquire registerable [sic] trademark rights—not to infringe them.”<sup>52</sup>

These efforts by courts and commentators to salvage some coherence from the Lanham Act’s careless amendment history may have been unwittingly undone by a single sentence in the majority opinion in *Abitron*. In that case, as previously noted, the Supreme Court ruled that uses of a federally registered trademark outside the territorial jurisdiction of the United States is not actionable as infringement. Applying the “focus” prong of its two-prong extraterritoriality test, the majority held that “the conduct relevant to any focus [of the Lanham Act] the parties have proffered is *infringing use in commerce, as the Act defines it*.”<sup>53</sup> Then—apparently unaware of and uninterested in lower courts’ and commentators’ labors to make sense of that very definition—the majority continued: “Under the Act, the ‘term ‘use in commerce’ means the bona fide use of a mark in the ordinary course of trade,’ where the mark serves to ‘identify and distinguish [the mark user’s] goods . . . and to indicate the source of the goods.’”<sup>54</sup>

*Abitron* was a case in which the plaintiff and defendants each claimed rights in the same trademark—the plaintiff in the United States, and the defendants in Europe.<sup>55</sup> The case thus presents one of the few trademark infringement scenarios in which the defendant’s conduct maps well to the framework of “bona fide use . . . not made merely to reserve a right in a mark” included in Section 45’s definition.<sup>56</sup> It is therefore perhaps unsurprising, if still disappointing, that the Justices did not attend to the problems that arise in applying that definition to the far more common situation in which a trademark infringement defendant is accused of *not* making “bona fide use” of the plaintiff’s trademark but rather of engaging in spurious and bad-faith use of the mark in an effort to mislead consumers. The leading trademark treatise suggests that this aspect of the *Abitron* majority opinion ought to be disregarded entirely as a careless and obvious mistake;<sup>57</sup> other trademark commentators argue that it overrules *Rescuecom* and requires a radical shift in our thinking about the conduct that constitutes infringement.<sup>58</sup> This Article takes no position on the matter, other than to note that *if*

50. *Id.* at 139–40 & n.12 (“We express no view which of the alternative available solutions would seem preferable if our Circuit had not previously applied the second sentence to sections of the Act defining infringement.”).

51. *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1145 (9th Cir. 2011) (“We now agree with the Second Circuit that such use is a ‘use in commerce’ under the Lanham Act.”).

52. 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 23:11:50 (5th ed. 2023) [hereinafter, 4 MCCARTHY].

53. *Abitron Austria GmbH v. Hetronic Int'l, Inc.*, 600 U.S. 412, 422 (2023) (emphasis added).

54. *Id.* at 428 (quoting 15 U.S.C. § 1127).

55. *Id.* at 415–16.

56. Lanham Act § 45, 15 U.S.C. § 1127.

57. 4 MCCARTHY, *supra* note 52, at § 29:57 (“When the *Abitron* opinion is read as a whole, it is clear that by this mistake the Court never intended to limit trademark infringement solely to cases where the accused use is a trademark use [as defined in Section 45].”).

58. See Rebecca Tushnet, ‘15th Trademark Scholars’ Roundtable: Session 1: Congress and the Courts (Including the Role of the Supreme Court), REBECCA TUSHNET’S 43(B)LOG (Feb. 23, 2024),

“bona fide use” of a trademark by the defendant is an element of an infringement claim after *Abitron*, that makes the theoretical questions addressed below—questions about how consumer behavior factors in to the delineation of various types of “use”—all the more important.

*b. Affixation and Entry into Commerce*

The most straightforward aspects of use in trademark law come from the portions of Section 45’s statutory definition of “use in commerce” that do *not* deal with the user’s *bona fides*. This language is generally held to create two requirements in order to establish “use in commerce”: *First*, that a trademark be *affixed* to goods in some way; and *second*, that those goods be sold or transported in commerce subject to the control of Congress.

As Section 45 of the Lanham Act says explicitly, the first requirement will be satisfied where a mark is placed in any manner “on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto,” or if the nature of the goods makes such placement impracticable, then on “documents associated with the goods or their sale.”<sup>59</sup> Likewise for services, which are not susceptible to physical affixation, the requirement can be satisfied if the claimed trademark is “used or displayed in the sale or advertising of [the] services.”<sup>60</sup>

In addition to affixing a mark to goods or services, those goods or services must actually enter the stream of commerce in order to satisfy the use in commerce requirement.<sup>61</sup> This does not necessarily require an arms-length sale of goods for a

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<https://tushnet.blogspot.com/2024/02/15th-trademark-scholars-roundtable.html>

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[<https://web.archive.org/web/20241215205502/https://tushnet.blogspot.com/2024/02/15th-trademark-scholars-roundtable.html>] (“Rescuecom: is it overruled? . . . I think you could say that when you claim to have a ‘mark’ subject to 43(a), you use the relevant [statutory] definition, but when you’re asserting some other claim under 43(a), you don’t have to do so.”).

59. Lanham Act § 45, 15 U.S.C. § 1127 (2023). The affixation requirement can be satisfied not only by placing the mark on the goods or their packaging, but also by placing it on, for example, catalogs that provide the information necessary to order the goods, see *Lands’ End Inc. v. Manbeck*, 797 F. Supp. 511 (E.D. Va. 1992), shipping labels for the goods, see *In Re Schering-Plough Corp.*, 211 U.S.P.Q. 69 (T.T.A.B. 1981), websites that display the mark in a way sufficient to associate it with the goods and that provide information necessary for ordering those goods, see *In re Sones*, 590 F.3d 1282 (Fed. Cir. 2009); *In Re Dell Inc.*, 71 U.S.P.Q.2d 1725 (T.T.A.B. 2004), trade show flyers and displays where the goods are available to order at the trade show itself, see *Marketquest Grp., Inc. v. BIC Corp.*, 316 F. Supp. 3d 1234, 1286 (S.D. Cal. 2018); *In Re Ancha Elecs., Inc.*, 1 U.S.P.Q.2d 1318 (T.T.A.B. 1986); *In Re Shipley Co.*, 230 U.S.P.Q. 691 (T.T.A.B. 1986), and instruction manuals for the goods, see *In Re Ultraflight*, 221 U.S.P.Q. 903, at \*2 (T.T.A.B. Jan. 9, 1984).

60. Lanham Act § 45, 15 U.S.C. § 1127 (2023).

61. *Id.*

valuable consideration—any sufficiently publicly accessible distribution will suffice.<sup>62</sup> Even a single sale can satisfy the requirement.<sup>63</sup>

Like the “bona fide use” requirement, these standards are most clearly applicable to the plaintiff-side “use in commerce” that gives rise to a right to register a trademark under Section 1 of the Lanham Act.<sup>64</sup> Indeed, when the Lanham Act was drafted nearly eighty years ago that was their only apparent relevance.<sup>65</sup> Their import is that mere preparatory activity is insufficient to establish registered trademark rights, and that the trademark registration system will only take notice of activities involving trademarks where members of the public have actually had an opportunity to encounter those marks in a commercial context and thereby associate them with a particular source.

But unlike the “bona fide use” requirement, the affixation and entry into commerce requirements are easier to find in most instances of defendant-side use. If a defendant has not displayed an allegedly confusing mark somewhere on or even *near* a good or service that has entered commerce, it is difficult to imagine how a trademark owner would ever have occasion to become aware of it, let alone to claim infringement. That said, the leading trademark treatise again argues that this aspect of the Section 45 definition of “use in commerce,” like the “bona fide use” requirement, has no application to the elements of an infringement claim, being a relic of 19<sup>th</sup>-century technical requirements for trademark validity.<sup>66</sup> In this view, the definition of the “use” that constitutes infringement simply has nothing to do with the definition of the “use” that gives rise to trademark rights.

## 2. Commercial Use

Instead, some courts—most prominently the Ninth Circuit—have arrived at other sources of related but less specific doctrinal requirements for defendant-side use. In the view of such courts, the key defined term in the sections of the Lanham Act governing infringement is not “use in commerce,” but rather simply “commerce,” which the Lanham Act defines as “all commerce which may lawfully be regulated by Congress.”<sup>67</sup> That defined term simply enforces the requirement of the *Trade-Mark Cases* that

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62. See *Planetary Motion, Inc. v. Techplosion, Inc.*, 261 F.3d 1188, 1195–97 (11th Cir. 2001) (holding free distribution of software over the internet sufficient to establish use).

63. See *Lane Cap. Mgmt., Inc. v. Lane Cap. Mgmt., Inc.*, 15 F. Supp. 2d 389, 397 (S.D.N.Y. 1998) (“The use of a protectable mark need not have gained wide public recognition, for ‘[a]doption and a single use of the mark may be sufficient to entitle the user to register the mark.’”), *aff’d*, 192 F.3d 337 (2d Cir. 1999).

64. Lanham Act § 1(a)(1), 15 U.S.C. § 1051(a)(1) (2023) (“The owner of a trademark used in commerce may request registration of its trademark . . .”).

65. *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123, 136 (2d Cir. 2009) (“[T]he Lanham Act as passed in 1946, on any reading, did not restrict liability for infringement to those who ‘used in commerce,’ as defined in § 45’s restrictive terms. Such a ‘use in commerce’ was simply one of several ways to satisfy one of several elements of a cause of action under § 43(a). By contrast, to justify imposition of liability on an infringer, the Act required, as an element of the cause of action, that the infringer cause the [infringing] goods or services to enter into commerce—a jurisdictional predicate for Congress’s power to legislate in this area.”).

66. 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 23:11:50 (5th ed. 2023).

67. Lanham Act § 45, 15 U.S.C. § 1127 (2023).

Congress's regulation of trademarks be constrained to the scope of its Commerce Power.<sup>68</sup> In this view, it is "erroneous" to treat the statutory definition of "use in commerce" as an element of infringement, because in the infringement context "[u]se in commerce" is simply a jurisdictional predicate to any law passed by Congress under the Commerce Clause.<sup>69</sup> Instead, courts adopting this view define the "use" necessary to give rise to infringement liability by reference to the "in connection with . . . goods or services" language of the statutory provisions defining infringement.<sup>70</sup> Though it is a matter of some dispute whether "commercial use" is in fact an element of a trademark infringement claim, enough cases do seem to impose such a requirement—and distinguish it from the statutory definition of "use in commerce"—to justify treating it as a distinct form of "use."<sup>71</sup>

Sometimes referred to as a "commercial use" requirement, this inquiry could simply have asked questions similar to those raised by the plaintiff-side use-in-commerce inquiry: Has the defendant affixed the challenged trademark to goods or displayed them in the marketing of goods or services? Have those goods or services entered the stream of commerce? And indeed, a few courts outside the Second and Ninth Circuits, not having had as much occasion to adjudicate cases in which the defendant's performance of such acts is open to question, simply apply those tests to the "use" element of an infringement claim.

But perhaps because in the absence of such facts few plaintiffs would even think to assert a trademark infringement claim, defendant-side commercial use tends to be discussed most often in contexts involving defendants' *expressive* uses of trademarks that enter the stream of commerce. In these contexts—typically involving news reporting, commentary, criticism, or parody—the commercial use requirement serves primarily to *exclude* such uses of a trademark from liability, even if they involve affixation of the plaintiff's trademark to the defendant's goods or services that have been sold in commerce (such as books, magazines, recordings, or media and entertainment services), to avoid potential conflicts with First Amendment freedoms of expression.<sup>72</sup>

Because of this typical factual context for the discussion of defendant-side commercial use, it may be tempting to define "commercial use" negatively, as the absence of expressive use. Indeed, "noncommercial use" is explicitly excluded from liability in the federal trademark dilution statute as a self-consciously speech-protective

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68. See *supra* notes 19–20 and accompanying text.

69. *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005).

70. See *supra* notes 35–36.

71. See Jennifer E Rothman, *Commercial Speech, Commercial Use, and the Intellectual Property Quagmire*, 101 VA. L. REV. 1929, 1939–41 (2015) (collecting cases).

72. *Radiance Found., Inc. v. N.A.A.C.P.*, 786 F.3d 316, 322–27 (4th Cir. 2015) (essay criticizing the NAACP on a pastor's website that solicited donations held not to be a commercial use); *Farah v. Esquire Mag.*, 736 F.3d 528 (2013) (magazine blog post held not to be "commercial speech" and therefore not actionable under the Lanham Act); *Bosley Med. Inst.*, 403 F.3d at 672 (gripe site with plaintiff's trademark in its domain name was not a "commercial use" where the site did not offer competing services but only criticized the trademark owner).

measure<sup>73</sup> (even though that statute also confusingly seems to treat “noncommercial use” as distinct from “parodying, criticizing or commenting” and from “news reporting and news commentary”).<sup>74</sup> But this temptation should be avoided, for at least three reasons.

First, a framing of “commercial use” as the opposite or absence of “expressive use” can be misleading or even internally inconsistent. There are many cases—usually involving the titles of commercially sold entertainment products like sound recordings, books, and films—in which a defendant has affixed a challenged mark to goods that have entered the stream of commerce, but such use of the mark still constitutes a recognizable form of protectable expression.<sup>75</sup>

Second, even outside of the expressive context a simple commercial use requirement can insulate some uses from liability—the most obvious example arises in a line of cases involving vanity telephone numbers that use alphanumeric coding to mimic a well-known trademark. In such cases, defendants were held not to have made a “use” of the mark so long as they did not themselves advertise or promote the vanity trademark number.<sup>76</sup>

Third, treating “commercial use” as the absence of “expressive use” tends to blur the lines between “commercial use” and yet another aspect of “use” in trademark law that has received renewed interest since the Supreme Court’s decision in *Jack Daniel’s*. This is the distinct concept of “trademark use” or “use as a mark.”

### 3. Trademark Use/Use as a Mark

The most contentious and least doctrinally clear element of use is what is referred to variously as “trademark use” or “use as a mark,” which is contrasted with “non-

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73. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 905 (9th Cir. 2002) (reciting legislative history that suggests the “noncommercial use” exception to trademark dilution liability was intended by its sponsors to be a protection for noncommercial expression).

74. Lanham Act § 43(c)(3), 15 U.S.C. § 1125(c)(3) (2023). Lee Ann Lockridge argues that the noncommercial use defense serves as a catch-all or backstop defense to prevent application of dilution liability even outside of these more clearly identified categories without having to resort to constitutional analysis. *See generally* Lee Ann W. Lockridge, *When Is a Use in Commerce a Noncommercial Use?*, 37 FLA. ST. U. L. REV. 337 (2010).

75. *Mattel*, 296 F.3d at 894 (holding that the title of the popular Aqua song “Barbie Girl” was a “commercial use” of Mattel’s “Barbie” trademark because it used the trademark to sell Aqua’s goods, but also a “noncommercial use” under the dilution statute because it constituted protected expression); *Rogers v. Grimaldi*, 875 F.2d 994, 997 (2d Cir. 1989) (“Movies, plays, books, and songs are all indisputably works of artistic expression and deserve protection. Nonetheless, they are also sold in the commercial marketplace like other more utilitarian products, making the danger of consumer deception a legitimate concern that warrants some government regulation.”). In this view, expressive use is not analytically related to “commercial use”; it is what I have called in other contexts a “trump card”: a legal category that, when satisfied, dictates the result of a legal dispute notwithstanding the simultaneous satisfaction of other legal categories that would otherwise dictate a contrary result. Jeremy N. Sheff, *Legal Sets*, 40 CARDOZO L. REV. 2029, 2083–88 (2019). As we will see below, however, the Supreme Court’s opinion in *Jack Daniel’s* calls this characterization of expressive use into question.

76. *See, e.g., DaimlerChrysler AG v. Bloom*, 315 F.3d 932 (8th Cir. 2003); *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619 (6th Cir. 1996).

trademark use” or “use otherwise than as a mark.” Trademark use is present where a party “has used a trademark to designate the source of its own goods—in other words, has used a trademark as a trademark.”<sup>77</sup> Although trademark use has been described on both the plaintiff side and the defendant side, it refers to slightly different phenomena in each of the two contexts. Defendant-side trademark use is a concept that underlies the question whether consumers are likely to believe that the defendant’s products or services originate with, or are sponsored or approved by, or somehow affiliated with, the trademark owner: It bears on the analysis of likelihood of confusion. Plaintiff-side trademark use asks instead whether consumers are likely to understand the plaintiff’s manner of using its claimed trademark as identifying any source of goods or services at all.<sup>78</sup>

*a. Defendant-Side Trademark Use*

Trademark use is more commonly invoked on the defendant side than on the plaintiff side. It has statutory grounding in certain defenses, particularly the statutory defense of descriptive fair use, which is available to defendants who use a plaintiff’s trademark “otherwise than as a mark” in order to describe their own goods (such as in the “Apples” example above).<sup>79</sup> In those contexts, “trademark use” on the defendant side makes such statutory defenses *unavailable*.

Because of its association with such defenses, trademark use is sometimes erroneously conflated with other aspects of use that are elements of an infringement claim under the law of the various Courts of Appeals, such as “use in commerce” or “commercial use.”<sup>80</sup> But trademark use is a distinct concept, and this error confuses the presence of an element of an affirmative defense with the absence of an element of a plaintiff’s claim—an error that the Supreme Court has warned against in precisely this context.<sup>81</sup> A defendant might use a trademark “otherwise than as a mark” but still “commercially” (or “in commerce”), and it might use a mark at least in part expressively (or “noncommercially”) but also as a mark. These two possibilities have been the source of much of the doctrinal development surrounding “trademark use” in the past two decades.

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77. Jack Daniel’s Props., Inc. v. VIP Prods. LLC, 599 U.S. 140, 145 (2023).

78. Despite these differences, leading trademark law commentator Professor Thomas McCarthy has opined that cases on defendant-side trademark use are relevant to determinations of plaintiff-side trademark use, and vice-versa. See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:4 (5th ed. 2023) [hereinafter, 1 MCCARTHY].

79. Lanham Act § 33(b)(4), 15 U.S.C. § 1115(b)(4) (2023); see also Lanham Act § 43(c)(3)(A), 15 U.S.C. § 1125(c)(3)(A) (2023) (excluding certain uses “other than as a designation of source for the [defendant’s] own goods or services” from dilution liability).

80. Indeed, the Second Circuit’s own conflation of these issues in *1-800 Contacts, Inc. v. WhenU.Com, Inc.*, 414 F.3d 400 (2d Cir. 2005), was largely responsible for the extensive and unusual statutory interpretation analysis in *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123 (2d Cir. 2009).

81. *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 120 (2004) (“[I]t would make no sense to give the defendant a defense of showing affirmatively that the plaintiff cannot succeed in proving some element [like confusion]; all the defendant needs to do is to leave the factfinder unpersuaded that the plaintiff has carried its own burden on that point.”).



The first of these scenarios—use “other than as a mark” that is still “commercial,” was the ground for the revived scholarly interest in the concept of “trademark use” nearly two decades ago. Scholarly proposals concerning a separate “trademark use” doctrine were prompted by judicial efforts to figure out how trademark law should apply to the internet, and particularly to the phenomenon of internet keyword advertising. This is the business model in which companies such as Google sell online advertisements whose selection and presentation is triggered by keywords input by internet users in their search queries.<sup>82</sup> Where the keywords sold by an internet advertising platform to an advertiser were trademarks of the advertiser’s competitor, that competitor would sometimes bring suit against the advertiser or the platform under the Lanham Act, and the question arose whether either defendant had “used” the mark in a way that could constitute infringement. The courts ultimately rejected the arguments of some scholars that such advertising ought to be shielded from liability on grounds that the sale of a trademark as an advertising keyword, while a “use” of that mark “in commerce,” was not a “trademark use” of the type that infringement doctrine ought to address—a use of a trademark as an indicator of the source of the good or service to which it is affixed.<sup>83</sup> Instead, infringement liability in such cases turns not on whether the defendant has used the plaintiff’s mark “as a mark,” but whether whatever use the defendant has made of the mark in commerce is likely to cause confusion.<sup>84</sup>

The absence of “trademark use” as an element of an infringement claim has substantial implications. It has been argued in the keyword advertising context that where a defendant is using a plaintiff’s trademark otherwise than as a trademark,

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82. For some key entries in this academic debate, see generally Margreth Barrett, *Internet Trademark Suits and the Demise of Trademark Use*, 39 U.C. DAVIS L. REV. 371 (2006); Mark D. Janis & Graeme B. Dinwoodie, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597 (2007); Dogan & Lemley, *supra* note 29; Stacey L. Dogan & Mark A. Lemley, *The Trademark Use Requirement in Dilution Cases*, 24 SANTA CLARA COMPUT. & HIGH TECH. L.J. 541 (2008); Mark P. McKenna, *Trademark Use and the Problem of Source*, 2009 U. ILL. L. REV. 773 (2009).

83. *Rescuecom Corp.*, 562 F.3d at 129–30; *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1144–45 (9th Cir. 2011).

84. Indeed, even in the Sixth Circuit, which is the only jurisdiction that treats trademark use as a threshold issue on an infringement claim, the trademark use inquiry is essentially a form of abbreviated likelihood of confusion inquiry. As the Sixth Circuit explained in justifying its rule:

Applying the eight factors [of the standard likelihood of confusion test] is useful to determine likelihood of confusion in typical cases . . . where there is not any question that the defendant is using the challenged mark to identify its goods. In such a case, it makes sense to consider such things as the similarity of the marks and the relatedness of the goods and services identified by those marks. . . . If defendants are only using IPC’s trademark in a “non-trademark” way—that is, in a way that does not identify the source of a product—then trademark infringement and false designation of origin laws do not apply.

*Interactive Prods. Corp. v. a2z Mobile Office Sols., Inc.*, 326 F.3d 687, 695 (6th Cir. 2003). While “laws do not apply” is a shockingly sweeping statement, the beginning of this quoted passage merely explains that in the absence of trademark use, it may be unnecessary to perform the standard multifactor analysis of likelihood of confusion, because the facts are non-standard and unlikely to be consistent with such a likelihood of confusion. Indeed, the Sixth Circuit might itself be moving toward this understanding of its idiosyncratic doctrine. See *Sazerac Brands, LLC v. Peristyle, LLC*, 892 F.3d 853, 859 (6th Cir. 2018) (“The critics may have a point, but they exaggerate the consequences of our approach.”).

confusion is inherently unlikely.<sup>85</sup> If defendant-side “trademark use” has any doctrinal relevance, then, this appears to be where it lies: in informing the analysis of likelihood of confusion. And that understanding of trademark use recently received a substantial endorsement from the Supreme Court’s decision in *Jack Daniel’s Properties, Inc. v. VIP Products LLC*.<sup>86</sup>

*Jack Daniel’s* involves the latter of the two scenarios described above: expressive uses of a mark “as a trademark.” This scenario has been the subject of several cases (including *Jack Daniel’s*) involving what Stacey Dogan and Mark Lemley have referred to as “brand parodies”: “parodies that serve as brands, logos, or taglines for commercial products.”<sup>87</sup> Such defendant-side uses of trademarks generally cannot be insulated from liability by means of the “commercial use” element of an infringement claim, because they are clearly “commercial uses” insofar as they are uses “on or in connection with goods or services.” Nor can they take advantage of certain statutory defenses—such as the descriptive fair use defense or the parody defense to dilution<sup>88</sup>—because those statutory defenses explicitly require the excused use to be “otherwise than as a mark”<sup>89</sup> or “other than as a designation of source for the [defendant]’s own goods or services.”<sup>90</sup> But because they have an expressive aspect that is noncommercial in nature and that implicates First Amendment protections, such brand parodies seem to call out for different treatment than mine-run infringement cases.

In *Jack Daniel’s*, the Court considered what test to use to determine whether a parody dog toy shaped like a bottle of Jack Daniel’s whiskey and labeled “Bad Spaniels” constituted an infringement of the Jack Daniel’s trademarks. Over the years leading up to the case, lower courts had increasingly analyzed the use of trademarks for the purpose of noncommercial expression (including but not limited to parody) using the two-step test set forth by the Second Circuit in *Rogers v. Grimaldi*.<sup>91</sup> In that case, the Second Circuit held that the Lanham Act:

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85. 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 25A:8 (5th ed. 2023) (“In the author’s view, a computer user who sees a search engine results page and clicks on a non-deceptive advertising link resulting from a trademark keyword purchased by a competitor is not confused as to the source or affiliation of any ultimate purchase that is made from that web site.” (footnote omitted); Barrett, *supra* note 82, at 430 (“[I]t is unlikely that a consumer who enters a trademark as a search term will assume that all of the websites listed in the search result page are related to the trademark owner. It is common experience that most of the results of an Internet keyword search are irrelevant.”); cf. *Multi Time Machine, Inc. v. Amazon.com, Inc.*, 804 F.3d 930, 937 (9th Cir. 2015) (explaining that infringement liability in the keyword advertising context depends on likelihood of confusion).

86. 599 U.S. 140 (2023).

87. Stacey L. Dogan & Mark A. Lemley, *Parody as Brand*, 47 U.C. DAVIS L. REV. 473, 484 (2013).

88. *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007) (“The finding of a successful parody only influences the way in which the [likelihood of confusion] factors are applied.”); *id.* at 266 (“Although the TDRA does provide that fair use is a complete defense and allows that a parody can be considered fair use, it does not extend the fair use defense to parodies used as a trademark.”).

89. Lanham Act § 33(b)(4), 15 U.S.C. § 1115(b)(4) (2023).

90. Lanham Act § 43(c)(3)(A), 15 U.S.C. § 1125(c)(3)(A) (2023).

91. 875 F.2d 994 (2d Cir. 1989).

should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression. In the context of allegedly misleading titles using a celebrity's name, that balance will normally not support application of the Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work.<sup>92</sup>

Over time the *Rogers* test was extended beyond the titles of "artistic works" to their contents,<sup>93</sup> and beyond films to songs, videogames, works of visual art, and even greeting cards.<sup>94</sup> The fact that such uses might involve noncommercial expression protected by the First Amendment and the fact that they might constitute non-trademark uses has often been correlated, but this is not a necessary relation. And in *Jack Daniel's*, the Court held that where the correlation fails—where an expressive use is a *trademark use*—the *Rogers* test should not apply.<sup>95</sup>

Taken together, the keyword advertising cases and the *Jack Daniel's* case suggest that trademark use plays a limited role in defendant-side use. Rather than being an element of an infringement claim, its main function is as the antithesis of the "use otherwise than as a mark" that is an element of certain statutory affirmative defenses. Beyond that, at least outside of the Sixth Circuit,<sup>96</sup> trademark use is not an element of any claim or defense.<sup>97</sup> Rather, it informs the application of the test for likelihood of confusion. A non-trademark use, particularly in a context involving protected expression, may not be subject to the standard multi-factor balancing test for likelihood of confusion, while a trademark use, under *Jack Daniel's*, will be.

#### *b. Plaintiff-Side Trademark Use*

Plaintiff-side trademark use is on less obvious statutory footing, but it plays a more substantial role in the analysis of trademark rights and liabilities than it does on the defendant side. Commentators identify the plaintiff-side trademark use requirement

92. *Id.* at 999.

93. *Louis Vuitton Malletier S.A. v. Warner Bros. Ent. Inc.*, 868 F. Supp. 2d 172 (S.D.N.Y. 2012).

94. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002) (extending *Rogers* test to songs); *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008) (extending *Rogers* test to videogames); *Univ. of Alab. Bd. of Trs. v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012) (extending *Rogers* test to works of visual art); *Gordon v. Drape Creative, Inc.*, 909 F.3d 257 (9th Cir. 2018) (extending *Rogers* test to greeting cards).

95. *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 159 (2023) (holding that for trademark uses, "the First Amendment does not demand a threshold inquiry like the *Rogers* test. When a mark is used as a mark (except, potentially, in rare situations), the likelihood-of-confusion inquiry does enough work to account for the interest in free expression.").

96. *See supra* note 84.

97. It has been argued that the *Abitron* Court's citation of Section 45's definition of "use in commerce" in connection with the test for infringement has the effect of importing that definition (including, presumably, both the "trademark use" requirement and the bona fide use requirement) into what this Article calls defendant-side use. But Professor McCarthy makes the cogent point that if this were true, the holding of *Jack Daniel's* that the *Rogers* test is inapplicable to "trademark uses" would make no sense: *Only* trademark uses would be actionable at all, and there would be no reason to distinguish them from non-trademark uses. 4 MCCARTHY, *supra* note 52, at § 29:57.

with the Lanham Act’s definition of a trademark as “any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods.”<sup>98</sup> In this view, for a trademark to be protectable, it must be used in a certain way: “to identify and distinguish” the claimant’s goods or services.<sup>99</sup> Words and symbols used for other purposes or in other ways do not give rise to trademark rights.

The USPTO has enforced this understanding of plaintiff-side trademark use by refusing to register trademarks that, in its view, fail to function as trademarks because they serve other, non-source-identifying functions. The Trademark Manual of Examining Procedure (“TMEP”) instructs USPTO examining attorneys that trademark use is a prerequisite for registration, and describes a number of situations in which examining attorneys may be called on to distinguish trademark uses from non-trademark uses.<sup>100</sup> Subject matter that serves purposes *other than* source identification—for example, decorative or ornamental subject matter, mere informational matter, or model number designations<sup>101</sup>—is not registrable because such subject matter is not *used as a trademark*.

The most common situation in which an application is refused registration for failure to function as a trademark is when the applicant seeks to register a slogan or meme as a trademark for apparel or similar merchandise. Such applications are fairly transparent efforts to gain a business advantage by monopolizing popular trends, jokes, or sayings, rather than to identify the source of goods or services. In such cases, the claimed subject matter fails to function as a mark because consumers are unlikely to understand the slogan or meme to be indicating the source of a product, and are instead likely to simply recognize it as a popular phrase.<sup>102</sup> For example, a burst of applications to register “COVID-19” and related phrases for use on apparel and other merchandise was largely disposed of via failure-to-function refusals.<sup>103</sup>

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98. Lanham Act § 45, 15 U.S.C. § 1127 (2023) (emphasis added).

99. 1 MCCARTHY, *supra* note 78, at § 3:1 (citation and footnote omitted); Alexandra J Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977, 1981–82 (2019).

100. See TMEP §§ 1202.01–1202.19.

101. TMEP § 1202.03 (decorative or ornamental subject matter); TMEP § 1202.04 (informational matter); TMEP § 1202.16 (model number designations).

102. TMEP §§ 1202.03(f)(i), 1202.04(b) (collecting cases).

103. Irene Calboli, *Trademarks and the COVID-19 Pandemic: An Empirical Analysis of Trademark Applications Including the Terms “COVID,” “Coronavirus,” “Quarantine,” “Social Distancing,” “Six Feet Apart,” and “Shelter in Place”*, 54 AKRON L. REV. 401, 455–62 (2021). Failure-to-function refusals are also common where an application seeks to register general information about the applicant’s goods or services, such as descriptive phrases or general claims of superiority. In re Boston Beer Co., 198 F.3d 1370, 1372–74 (Fed. Cir. 1999) (affirming the refusal to register “THE BEST BEER IN AMERICA” as a trademark for beer on grounds that the phrase was “so highly laudatory and descriptive of the qualities of its product that the slogan does not and could not function as a trademark to distinguish Boston Beer’s goods and serve as an indication of origin.”); In re TracFone Wireless, Inc., 2019 U.S.P.Q.2d 222983, at \*3 (T.T.A.B. 2019) (precedential) (affirming the refusal to register “UNLIMITED CARRYOVER” as a trademark for wireless cellular services because it “simply provides information about the services.”). For this subset of refusals to register, as Professor Alexandra Roberts has argued, failure-to-function analysis overlaps substantially (but not entirely) with inherent distinctiveness analysis. See Roberts, *supra* note 99, at 2024–43; see also Lucas Daniel Cuatrecasas, Note, *Failure to Function and Trademark Law’s Outermost Bound*, 96 N.Y.U. L. REV. 1312 (2021) (critiquing failure to function doctrine on this ground).

This reasoning is curious, and it bears further comment, as it underlies the central theoretical tension that this Article is working to expose. That is: Failure-to-function doctrine purports to determine how a trademark claimant has *used* a trademark by looking at how that trademark will be *perceived* by consumers. Unless there is always perfect correspondence between the purpose with which an act is undertaken and the effect that act has in the world, this is fallacious reasoning. The general policy of denying exclusive rights to parties who wish to monopolize trends in popular culture may be sound enough, but the means of achieving that end reflects a lack of clarity—even an internal contradiction—regarding the doctrinal implementation of that policy. That implementation assumes a correspondence of understanding between speakers and audience—between trademark applicants and consumers—that is often lacking. I will return to this contradiction in Part III. Before doing so, there is one final aspect of “use” in trademark law that remains to be discussed.

#### 4. Use in Commerce Subject to the Control of Congress; Territoriality

The final aspect of use in trademark law is of constitutional and jurisdictional dimensions. As explained above, the *Trade-Mark Cases* limit federal jurisdiction over trademarks to regulation of trademarks in commerce subject to the control of Congress. And the requirement of use “in commerce,” combined with the definition of “commerce” in the Lanham Act that implements this constitutional limitation, means that there will be some uses of trademarks that might otherwise constitute “use in commerce” under the statutory definition in Section 45 that will fail to do so because they fall outside of the sphere of commerce that Congress is empowered to regulate. Since the broad expansion of the Commerce Power in the 20<sup>th</sup> century, this limitation is not commonly invoked for domestic uses of trademarks, and when invoked is typically found satisfied.<sup>104</sup> But it does from time to time meaningfully affect outcomes in trademark cases in circumstances involving foreign and cross-border activities, such as the activities that were at issue in last term’s *Abitron* case. In such cases, the limits of Congress’s power to regulate commerce may overlap or interact with general principles of territoriality, international comity, and choice of law. This has led to some asymmetry between the plaintiff-side and defendant-side versions of use in commerce subject to the control of Congress as the Supreme Court’s general extraterritoriality jurisprudence has evolved.

On the plaintiff side, federal authorities have been relatively permissive in allowing uses of trademarks outside of the territorial jurisdiction of the United States to give rise to rights enforceable within the United States. Though there are some limits to this permissiveness—prior adoption of a mark overseas will not suffice to displace a mark

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104. See, e.g., *Patsy’s Italian Rest. v. Banas*, 658 F.3d 254, 268 (2d Cir. 2011) (“The provision of services to interstate customers is sufficient to show that the services were rendered in commerce.”) (citing *Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 666 (Fed. Cir. 1991) (“The record here established that the BOZO’S mark has been used in connection with services rendered to customers traveling across state boundaries. It is not required that such services be rendered in more than one state to satisfy the use in commerce requirement.”)).

already actively used in the United States by another<sup>105</sup>—foreign uses of a trademark can sometimes give the foreign user a right to prevent registration or use of the mark by others in the United States. For example, the Fourth Circuit has held that a foreign trademark owner’s rendering of services under their mark to American citizens abroad constitutes use “in commerce” subject to the jurisdiction of Congress that can give rise to trademark rights in the United States.<sup>106</sup>

Even in the absence of such direct evidence of transactions between foreign sellers and American buyers, domestic rights may arise out of foreign use of a trademark under the “well-known marks doctrine” of international trademark law.<sup>107</sup> This doctrine allows foreign users of a trademark to prevent others from using or registering that trademark in the United States, if their foreign use is sufficiently notorious to persons in the United States as to give rise to a reputation among American consumers. The exact mechanism for the assertion of this right, and the exact criteria for establishing it, vary somewhat from circuit to circuit. But in general, if a mark has a sufficiently measurable reputation among American consumers, even if that reputation depends entirely on use of the mark overseas, that reputation can give rise to a right to prevent others from using the mark in the United States.<sup>108</sup>

On the defendant side, long-settled principles of use in commerce have recently been upended by the Supreme Court’s overhaul of its extraterritoriality jurisprudence. For decades, Supreme Court precedent had allowed a defendant’s use of a trademark outside the United States to satisfy the “use in commerce” element of an infringement claim if that use had sufficient effects on consumers within the United States—particularly if it were likely to confuse consumers in the United States.<sup>109</sup> In *Abitron Austria GmbH v. Hetronic International, Inc.*, the Supreme Court all but overruled that precedent, holding that use of a mark overseas is not actionable as infringement under the Lanham Act.<sup>110</sup> *Abitron* is not a constitutional opinion. It does not hold that it is beyond Congress’s power to impose liability on extraterritorial uses of trademarks; only that the Lanham Act does not purport to exercise such power when construed under a presumption against extraterritoriality. Under such a construction, in the view of the *Abitron* majority, the Lanham Act only applies to domestic conduct relevant to its

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105. See *Person’s Co., Ltd. v. Christman*, 900 F.2d 1565, 1568–69 (Fed. Cir. 1990).

106. *Int’l Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 364–67 (4th Cir. 2003).

107. TRIPS Agreement, *supra* note 14, art. 16 ¶ 2.

108. *ITC Ltd. v. Punchgini, Inc.*, 518 F.3d 159, 160–61 (2d Cir. 2008); *Grupo Gigante SA De CV v. Dallo & Co., Inc.*, 391 F.3d 1088, 1094–98 (9th Cir. 2004). The Fourth Circuit has gone so far as to hold that use in commerce subject to the control of Congress is not a requirement of a claim for unfair competition under Section 43(a) of the Lanham Act. *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 705–10 (4th Cir. 2016).

109. *Steele v. Bulova Watch Co.*, 344 U.S. 280 (1952) (allowing an injunction against an American citizen who manufactured and sold watches under the BULOVA mark in Mexico, advertised the watches in both Mexico and the United States, and generated confusion among consumers in Texas).

110. *Abitron Austria GmbH v. Hetronic Int’l, Inc.*, 600 U.S. 412, 421–23 (2023).

focus—i.e., only to *domestic* “uses in commerce” that cause confusion in the United States.<sup>111</sup>

The majority’s reasoning in *Abitron* drew disagreement from Justice Sotomayor, supported by three other justices. Concurring in the Court’s judgment, she argued that the focus of the Lanham Act is on preventing confusion of consumers in the United States, and that the Court’s extraterritoriality jurisprudence, properly read, allowed the imposition of liability against foreign conduct that sufficiently implicated that concern.<sup>112</sup> In this disagreement, as in the context of “trademark use,” we see the shadow of a deeper theoretical disagreement: not over extraterritoriality, but over the role of consumers in trademark law. The majority’s focus on the *actions of the defendant* mirrors the focus in plaintiff-side trademark use doctrine on the *use by the trademark claimant*. It suggests that the key facts to a trademark dispute are to be found in the conduct of one of the parties to that dispute; that the *effects* of that conduct are secondary. Justice Sotomayor’s focus on the confusion of domestic consumers suggests a different concern: a concern over the consumer experience. It is possible to dismiss this difference as a difference between, say, textualism and purposivism in statutory interpretation. But it is also possible to see this doctrinal disagreement as a deeper theoretical problem particular to trademark law. It is possible to treat this difference—as I will argue Justice Jackson’s concurrence in *Abitron* treats it—as a question of *secondary responsibility*. That is, it is possible to see a focus on consumers not only as a concern over the effects of the parties’ conduct, but as an inquiry into the scope of conduct that the parties themselves may be held legally responsible for. To explore that distinction further, it will be necessary to dig a bit deeper into the principles of secondary responsibility in trademark law.

## II. SECONDARY RESPONSIBILITY

### A. DEFENDANT-SIDE SECONDARY RESPONSIBILITY

Secondary liability has long been a doctrinal vehicle to allow for a finding of trademark infringement against a party who did not themselves use a trademark, by imputing to such party legal responsibility for the use of the trademark by another.<sup>113</sup> Secondary trademark infringement liability, like secondary liability in other areas of intellectual property, follows general principles of tort law. As the Supreme Court explained in *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*:

[L]iability for trademark infringement can extend beyond those who actually mislabel goods with the mark of another. Even if a manufacturer does not directly control others in the chain of distribution, it can be held responsible for their infringing activities under

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111. *Id.* at 423 (“Because Congress has premised liability on a specific action (a particular sort of use in commerce), that specific action would be the conduct relevant to any focus [of the statute].”).

112. *Id.* at 435–44 (Sotomayor, J., concurring in the judgment).

113. See Dogan & Lemley, *supra* note 29, at 1679–81 (reviewing the origins of contributory trademark infringement liability).

certain circumstances. Thus, if a manufacturer or distributor intentionally induces another to infringe a trademark, or if it continues to supply its product to one whom it knows or has reason to know is engaging in trademark infringement, the manufacturer or distributor is contributorially responsible for any harm done as a result of the deceit.<sup>114</sup>

Secondary liability generally depends on holding the defendant responsible for the infringing acts of another.<sup>115</sup> Such secondary responsibility for the acts of another arises most often in trademark law in cases where one party affixes a mark to goods that another party had previously placed in the stream of commerce; in such cases the latter party is held to be contributorially liable for the former party's direct infringement. *Inwood Labs* and the case it principally relied on, *William R. Warner & Co. v. Eli Lilly & Co.*,<sup>116</sup> both involved such a division of the acts constituting infringement between a distributor and a retailer. In both cases the distributor—a competitor of the trademark owner—provided its products to the retailer—a pharmacist—and encouraged the pharmacist to mislabel the products with, or sell the products under, the plaintiff's trademark. While the pharmacists could surely have been held liable for trademark infringement on such facts, the question in both cases was whether the *distributor* could be held liable for its *customers'* infringement, and the answer in both cases was yes. The key factor in both cases was the state of mind of the distributor: their intentional encouragement of, or knowing contribution to, the infringing conduct of their customer. Where such a state of mind is present, the fact that the distributor did not themselves “use” the plaintiff's trademark does not avoid liability: The distributor can be held legally responsible for the “use” of the mark by their customer.

But secondary responsibility need not only be a vehicle for *imposing* liability on the defendant side; it could also be a vehicle for *avoiding* liability. Though it is not commonly understood as a secondary responsibility doctrine, trademark law's first-sale doctrine shares certain structural features with its secondary liability doctrines. The first-sale doctrine provides that once a trademark owner has authorized the sale of an article bearing that trademark, their trademark rights in that particular article are

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114. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 855 (1982). Copyright and patent law have similar doctrines; copyright's being judicially created, and patent law's being statutory. See *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 930–36 (2005) (setting forth copyright law's principles of secondary liability); 35 U.S.C. § 271(b)–(c) (2023) (codifying patent law's rules of secondary liability).

115. To be perfectly precise, “vicarious” liability typically involves liability of a principal for the acts of their agent, or more generally the liability of one person for the acts of another that they benefited from and had the right to control, while the liability of a defendant for facilitating a tortious course of conduct completed by a party who is not subject to the defendant's control is more appropriately described as “contributory” liability—though the distinction is not always clear or clearly applied. Cf. *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1175 (9th Cir. 2007) (“Although the lines between direct infringement, contributory infringement, and vicarious liability are not clearly drawn, in general, contributory liability is based on the defendant's failure to stop its own actions which facilitate third-party infringement, while vicarious liability is based on the defendant's failure to cause a third party to stop its directly infringing activities.”) (internal quotation marks and citation omitted); *Leonard v. Stemtech Int'l Inc.*, 834 F.3d 376, 388 (3d Cir. 2016) (“To establish vicarious infringement, a plaintiff must prove that the defendant had (1) the right and ability to supervise or control the infringing activity; and (2) a direct financial interest in such activities.”).

116. 265 U.S. 526 (1924).



exhausted. This means that the article can in most circumstances be re-sold by its owner without incurring liability for trademark infringement.<sup>117</sup> The doctrine has long been justified by arguments regarding the free alienability of personal property, the common-law's antipathy toward servitudes in chattels, and the freedom to convey accurate information in the marketplace.<sup>118</sup> But it is also possible to understand it formalistically as a case of defendant-side secondary responsibility. Under such an understanding, the trademark owner may be deemed secondarily responsible for the resale of its own goods by the defendant in the secondary market, by virtue of having authorized the sale of the goods to the defendant in the primary market.

The analogy is not exact: A defendant's generalized knowledge that some of its customers *may* commit direct infringement is generally insufficient to support contributory liability against that defendant; more specific knowledge of actual infringing activity—or willful blindness toward such activity—is required.<sup>119</sup> We might therefore expect that first-sale doctrine would only excuse liability where the trademark owner authorized the sale of an article knowing or having reason to know that the *particular purchaser* of that article would eventually resell it. But a difference in the background entitlements of the parties may account for this difference in the degree of knowledge required to assign secondary responsibility between the two cases. Because all property owners have the power to alienate their property, all purchases of branded goods should be understood by the seller to entail the power to resell them, and so all sales of such branded goods might be understood to imply the seller's intention to grant that power to the purchaser. Such an expectation does not apply in the context of contributory infringement, insofar as the background legal framework does *not* entail a right to affix someone else's mark to your products without their consent. So, for example, the wholesaler of a generic drug might not ordinarily expect its retail purchasers to mislabel the drug with a competitor's brand name, but the manufacturer of a new car might ordinarily expect the purchaser of that car to eventually resell it without *removing* the brand name.<sup>120</sup>

This move—which satisfies the traditional knowledge and intent requirements of secondary responsibility doctrines by reference to the intent implied by background legal entitlements and principles rather than by reference to any analysis of the

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117. *Champion Spark Plug Co. v. Sanders*, 331 U.S. 125, 128–29 (1947); *Prestonettes, Inc., v. Coty*, 264 U.S. 359, 368–69 (1924).

118. *Coty*, 264 U.S. at 368 (“The defendant of course by virtue of its ownership had a right to compound or change what it bought, to divide either the original or the modified product, and to sell it so divided. . . . Then what new rights does the trade-mark confer? It does not confer a right to prohibit the use of the word or words. . . . When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth. It is not taboo.”); see generally Molly Shaffer Van Houweling, *The New Servitudes*, 96 GEO. L.J. 885 (2008) (charting the free alienability arguments in favor of first-sale doctrines in copyright law and against enforcement of post-sale license restrictions); *Sanders*, 331 U.S. 125 at 128–30.

119. *Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 108–09 (2d Cir. 2010).

120. *Sanders*, 331 U.S. at 129 (“[W]e would not suppose that one could be enjoined from selling a car whose valves had been reground and whose piston rings had been replaced unless he removed the name Ford or Chevrolet.”).

subjective state of mind of the affected agent—is admittedly a novel one. It potentially expands the boundaries of secondary responsibility. And it does so in a way that invites accusations of circularity: if we infer constructive knowledge and intent from background legal rules, then secondary responsibility is more a function of those background rules than it is a function of any analysis of an agent’s legal or moral responsibility. This is a cogent objection to the move, and offers a plausible basis for rejecting secondary responsibility as a justification for trademark doctrines outside of traditional contributory liability. But as I will argue in the next Part, accepting the move—even if only for the sake of argument—offers some surprising implications regarding various trademark doctrines that have struggled to coherently justify themselves. Before examining those implications, plaintiff-side examples of secondary responsibility in trademark law bear investigating.

## B. PLAINTIFF-SIDE SECONDARY RESPONSIBILITY

The foregoing examples of secondary responsibility involve what this Article has referred to as defendant-side use. But they suggest an intriguing question: Might there be such a thing as secondary responsibility for another’s use on the *plaintiff* side? There is one area where the answer to this question is clearly yes: Use *by the public* can be ascribed to trademark claimants, for good or for ill. Specifically, uses of a term (such as a nickname) by members of the consuming public to refer to a trademark owner can afford the trademark owner rights in that term even if the owner themselves has never used it on their goods or services. Conversely, uses of a trademark by members of the consuming public as a generic term can cause the trademark owner to *lose* rights in that trademark. In both instances, we are faced with the same theoretical question that cropped up at various points in the previous Part: Are these doctrines merely relying on consumer *beliefs* as evidence of a party’s *conduct*? Or are they rather ascribing legal *responsibility* for consumer *conduct* to the parties themselves?

With respect to the first type of public use, the second view seems more likely. A line of cases holds that use of a nickname or abbreviation by the public alone, without any evidence of use by the trademark owner, can create trademark rights in the nickname.<sup>121</sup> These user-generated trademark rights include “Coke” for Coca-Cola, “AmEx” for American Express, and “Big Blue” for IBM.<sup>122</sup> The Federal Circuit has used the language of secondary responsibility in describing the basis for these trademark rights:

[E]ven without use directly by the claimant of the rights, the courts and the [Trademark Trials and Appeals] Board generally have recognized that abbreviations and nicknames of trademarks or names used only by the public give rise to protectable rights in the owners

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121. For a fuller discussion of this line of cases, see generally Peter M. Brody, *What’s In a Nickname — Or, Can Public Use Create Private Rights*, 95 TRADEMARK REP. 1123 (2005).

122. Coca-Cola Co. v. Busch, 44 F. Supp. 405, 410, 52 U.S.P.Q. 377 (D. Pa. 1942); Am. Stock Exchange, Inc. v. Am. Express Co., 207 U.S.P.Q. 356 (T.T.A.B. 1980); Big Blue Prods., Inc. v. Int’l Business Machines Corp., 19 U.S.P.Q.2d 1072 (T.T.A.B. 1991).

of the trade name or mark which the public modified. Such public use by others inures to the claimant's benefit and, where this occurs, public use can reasonably be deemed use "by" that party in the sense of a use on its behalf.<sup>123</sup>

Thus it seems that plaintiff-side secondary responsibility is possible: Trademark owners can claim the legal benefit of uses of trademarks by the public.

But turnabout is fair play: trademark owners are also *chargeable with* acts by the public that are *against* the trademark owner's interests. This possibility arises most commonly in the context of "genericide": the scenario in which the public comes to use a trademark as the generic name for the category of product made by the trademark owner. Such generic terms, which "refer[], or ha[ve] come to be understood as referring, to the genus of which the particular product is a species," are ineligible for trademark protection as a matter of law.<sup>124</sup> Examples of former trademarks that have become generic include "Aspirin," "Cellophane," and "Murphy Bed."<sup>125</sup> In such cases, the loss of trademark rights is framed as an abandonment, which occurs "[w]hen any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark."<sup>126</sup> Here again, we see the question raised as to whether we are to understand consumer beliefs as *evidence* of a party's conduct, or rather whether the party is being held legally *responsible* for the conduct of consumers.

The Lanham Act's above-quoted definition of abandonment, on which genericide doctrine depends, refers to "acts of omission . . . [or] [of] commission, [that] cause[] the mark to become . . . generic." This language, as applied in the genericide context, seems susceptible to two interpretations. In one view—turning on acts of commission—genericide is a result of overzealous and incautious advertising by the trademark owner: "[A] suggestive or fanciful term [may] become generic as a result of a manufacturer's own advertising efforts."<sup>127</sup> In this view, consumer use is merely *evidence* of incautious advertising by the trademark owner, which implicitly must have used the trademark in a generic sense. But another view—one which turns on acts of omission—seems to blame the trademark owner for the fact that consumers believe their former trademark is a generic term, as if the trademark owners had the authority to prevent such uses but failed to exercise that authority. The most common argument in this vein is that adequate policing and enforcement by trademark owners could

123. Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Eds., Inc., 937 F.2d 1572, 1577–78 (Fed. Cir. 1991).

124. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976). *See also id.* at 9 ("[N]o matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.").

125. Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921); DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75 (1936); Murphy Door Bed Co., Inc. v. Interior Sleep Sys., Inc., 874 F.2d 95 (2d Cir. 1989).

126. Lanham Act § 45, 15 U.S.C. § 1127 (2023).

127. *Abercrombie & Fitch*, 537 F.2d at 10.

prevent such generic consumer uses of the mark from being made.<sup>128</sup> But even where such enforcement has been undertaken, a trademark owner may still suffer genericide—a particular danger with unique, market-leading, category-defining products. As the Second Circuit said in holding “Murphy Bed” to be a generic term: “[W]hen, as here, the mark has ‘entered the public domain beyond recall,’ *policing is of no consequence* to a resolution of whether a mark is generic.”<sup>129</sup> Insofar as it is not clear how any enforcement activity—any act at all—by the Murphy Door Bed Company might have compelled the public to refrain from using its trademark as a generic term, genericide doctrine seems once again to suggest that consumer behavior, rather than being *evidence* of some failure on the part of the trademark owner, is instead being attributed to trademark holders as a matter of secondary responsibility, and that this responsibility cannot be effectively disclaimed by the mark owner itself. That is to say: If consumers are using a term in a generic sense, the law will interpret uses of that term by a trademark claimant as subject to the meaning implicit in the public’s use: it will treat the trademark claimant as if the public’s use of the term is incorporated into the claimant’s own use.

These examples of plaintiff-side secondary responsibility may not be precise mirror-images of the examples of defendant-side secondary responsibility reviewed above. In particular, as with first-sale doctrine, they make no reference to the intent and knowledge elements that are central to secondary liability in trademark law. This does not mean that such knowledge and intent are irrelevant to plaintiff-side secondary responsibility; it may just be that in these examples they are uncontroversially present. It is difficult, for example, to imagine that a trademark owner could claim the benefit of public use of a nickname for their brand without being aware of that use or without intending to adopt it for the mark owner’s benefit. Similarly, to the extent that genericide depends on the mark owner’s secondary responsibility for tolerating or even encouraging members of the public using its mark in a generic sense, the very idea of toleration or encouragement presupposes knowledge of such public use and implies the intent that it continue. So even though these plaintiff-side doctrines do not explicitly incorporate the knowledge and intent aspects of secondary responsibility, they likely do so implicitly.

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128. 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 12:29 (5th ed. 2023) [hereinafter, 2 MCCARTHY].

129. *Murphy Door Bed Co.*, 874 F.2d at 101 (emphasis added) (quoting *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963) (holding “Thermos” to have become generic)). Professor McCarthy suggests that this language in *Murphy* merely refers to policing efforts made *after* a mark has already become generic. 2 MCCARTHY, *supra* note 128, at § 12:29 & n.9. But the district court opinion in the case suggests that competitors did not use the name “Murphy” on their competing products until shortly before the case arose, and that Murphy took enforcement action against the only competitor who did so. *Murphy Door Bed Co.*, 687 F. Supp. at 761.

### C. SECONDARY RESPONSIBILITY AND FLAVORS OF USE

Similarly, the examples reviewed above of secondary responsibility for the use of trademarks by others—on both the plaintiff's and defendant's side—do not explicitly distinguish among the various meanings of "use" catalogued in Section I.B of this Article. But again, this may not mean that such distinctions are irrelevant; it may simply reflect the fact that such distinctions are not generally implicated in the various examples. When a generic drug manufacturer induces a pharmacist to mislabel their drug with a competitor's brand name, there is not much question that the pharmacist's actions constitute a "commercial" use "on or in connection with" that product, and that it has been used in commerce subject to the territorial jurisdiction and constitutional authority of Congress; for good measure we could also point out that the pharmacist has affixed the mark to the product and that this constitutes a "trademark use" intended to (falsely) indicate the source of the product. When a consumer orders a "Coke," there is no question that they are making a "trademark use" of the term to identify the source of a product that they wish to purchase, that they are not doing so "merely to reserve rights in a mark," and that those goods to which the mark is being applied are being sold or offered for sale in commerce subject to the control of Congress. But we could imagine scenarios where one or another of these forms of use were not present in the conduct for which a trademark plaintiff or defendant was being held secondarily responsible. In such circumstances, we might ask whether the plaintiff's or defendant's *direct* conduct might supply those aspects of use absent from the *secondary* conduct being attributed to them as a matter of legal responsibility. As I will argue in the next part, it is possible to understand a number of trademark doctrines as examples of such a combination of primary and secondary responsibility, though they are not explicitly conceived of in this way. These doctrines raise the possibility of a new overarching category of trademark use: *divided use*.

### III. DIVIDED USE SCENARIOS

Based on the discussion in Section I.B, we can identify various aspects of "use" that are relevant to determining trademark rights and infringement liability. On the plaintiff side, a plaintiff seeking to establish trademark rights will have to establish: (1) bona fide use; (2) affixation and entry into commerce; (3) trademark use; and (4) use in commerce subject to the control of Congress. On the defendant side, in order to establish liability for trademark infringement, a plaintiff will have to show that the defendant: (1) made a commercial use of the mark; (2) in commerce subject to the jurisdiction of Congress; and (3) within the territorial jurisdiction of the United States, all in a manner that creates a likelihood of confusion. Liability apparently does not require a showing that the defendant engaged in bona fide use or trademark use (unless the majority's reference to "use in commerce" in *Abitron* overruled many years' worth of lower court precedent without saying it was doing so), though a showing of *non*-trademark use may qualify the defendant for a statutory defense to liability, and may

afford the defendant a more permissive standard for likelihood of confusion (as implied by *Jack Daniel's*).

The primary concern of this Part is the possibility that these various aspects of use may be *divided* between primary and secondary actors. In such situations, one party may engage in some aspects of use necessary to a claim, but not others. Rather than defeating the claim, however, this division of the various aspects of use may instead simply require the claimant to identify use by *other* parties—or even by members of the public—that could plausibly be ascribed as a matter of legal responsibility to the party whose use is in some way incomplete. In such scenarios, we might expect courts to allow the claim, substituting secondary responsibility for actual use. Where the secondary use is a use by the public, as we have seen, it can be especially difficult to distinguish between a doctrine that ascribes the public's use to a party as a matter of secondary responsibility, and one that merely treats the public's behavior as *evidence* of that party's own conduct or intentions. This is a serious theoretical challenge to trademark law, particularly if one views the knowledge and intent elements of secondary liability on the defendant side as applicable to secondary responsibility on the plaintiff side. A review of various scenarios that have traditionally *not* been conceived of in terms of divided use can help illustrate the theoretical challenge those scenarios pose. What this review reveals is that a number of trademark doctrines—including some that have been the subject of theoretical criticism—are surprisingly easy to recast in terms of divided use. Whether recasting them in this way rehabilitates them against the criticism they have suffered may in turn depend on whether the secondary actor's knowledge and intent is an element of each doctrine, and what type of showing will be necessary to satisfy that element if indeed it applies. This Section explores these questions through three examples of divided use: cross-border uses (in which one party engages in some aspect of use outside the United States and another engages in some other aspect of use inside the United States, as in Justice Jackson's *Abitron* concurrence); post-sale confusion liability (in which a non-confused purchaser buys a knockoff product and consumes it in the view of a confused audience); and expressive uses (in which a trademark is used in a way that might be intended to express a non-trademark message but might be perceived as a trademark, or vice versa).

#### A. CROSS-BORDER DIVIDED USE

We can begin with a scenario proposed by Justice Jackson in her *Abitron* concurrence. The scenario is worth quoting at length:

Imagine that a German company begins making and selling handbags in Germany marked "Coache" (the owner's family name). Next, imagine that American students buy the bags while on spring break overseas, and upon their return home employ those bags to carry personal items. Imagine finally that a representative of Coach (the United States company) sees the students with the bags and persuades Coach to sue the German company for Lanham Act infringement, fearing that the "Coache" mark will cause consumer confusion. Absent additional facts, such a claim seeks an impermissibly extraterritorial application of the Act. The mark affixed to the students' bags is not being "use[d] in commerce"

domestically as the Act understands that phrase: to serve a source-identifying function “in the ordinary course of trade,” § 1127.

Now change the facts in just one respect: The American students tire of the bags six weeks after returning home, and resell them in this country, confusing consumers and damaging Coach’s brand. Now, the marked bags are in domestic commerce; the marks that the German company affixed to them overseas continue “to identify and distinguish” the goods from others in the (now domestic) marketplace and to “indicate the source of the goods.” *Ibid.* So the German company continues to “use [the mark] in commerce” within the meaning of the Act, thus triggering potential liability under § 1114(1)(a) and § 1125(a)(1).

In brief, once the marks on its bags are serving their core source-identifying function in commerce in the United States, this German company is doing—domestically—exactly what Congress sought to proscribe. Accordingly, the German company may be subject to liability for this domestic conduct—i.e., it cannot successfully obtain dismissal of the lawsuit on extraterritoriality grounds—even though it never sold the bags in, or directly into, the United States.<sup>130</sup>

Here, Justice Jackson has offered a vision of divided use that leans heavily on secondary responsibility without saying so. In her second hypothetical in particular, the German company has *itself* made a commercial use of the mark, in commerce subject to the *constitutional* jurisdiction of Congress (the foreign company sold its goods to American citizens, and thus in foreign trade subject to Congress’s jurisdiction under the Commerce Clause<sup>131</sup>), but did not *itself* use the mark in commerce subject to the direct *territorial* jurisdiction of the United States. Justice Jackson’s solution is, apparently, to ascribe the actions of the German company’s *customers* to that company. Justice Jackson’s finding of territorial jurisdiction requires us to treat the resale of the bags within the *territorial* jurisdiction of the United States by the German company’s *American customers* as part of the activity of *the German company itself*. That is, she would hold the company liable *based on the acts of its customers* (though somewhat confusingly describing these as acts of the company itself).

No other member of the Court joined Justice Jackson’s opinion in *Abitron*. And without adding facts to her hypothetical, it is not clear that her novel solution to the extraterritoriality puzzle squares with the principles of secondary liability discussed in the previous Part. The hypothetical is silent as to the knowledge and intent element of secondary responsibility. And importantly, it is not necessarily a background right of a purchaser of products lawfully sold *abroad* to import and resell them in the United States. In particular, because trademark and other intellectual property rights are territorial—created by and subject to the law of the territory in which they are

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130. *Abitron Austria GmbH v. Hetronic Int’l, Inc.*, 600 U.S. 412, 430–32 (2023) (Jackson, J., concurring).

131. See *Int’l Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 365–66 (4th Cir. 2003) (holding that rendering services to United States citizens abroad constitutes use in commerce subject to Congress’s jurisdiction under the Commerce Clause).

asserted<sup>132</sup>—it is perfectly plausible for one party to own rights to a trademark in one country, and a different party to own rights to the same trademark in another country. Thus, holding the foreign seller secondarily responsible for acts of importation and sale in the U.S. by its customers would seem to require some specific knowledge and intent on the part of the foreign seller. If—but only if—it could be shown that the German company either *induced* its American customers to bring the bags back to the United States for resale, or sold the bags to them *knowing* that this was their intent, then secondary liability would almost certainly apply, provided that the activities of the American purchasers were sufficient to bring the foreign conduct of the German company within the ambit of the statute’s “focus” under the Court’s evolving extraterritoriality jurisprudence.

This problem is the mirror-image of one that has been previously addressed in patent law. Clever schemes to circumvent direct or secondary infringement liability by dividing activities across borders, combined with a Supreme Court opinion construing the patent infringement statute to exclude foreign activities undertaken in such schemes, led Congress to explicitly codify a form of liability that captures (at least some) cross-border conduct.<sup>133</sup> Trademark law, however, has no such statute. And even if it did, it would almost certainly incorporate the knowledge and intent elements of secondary liability in tort law that Justice Jackson’s hypothetical ignores—as the Patent Act’s divided infringement statute does.<sup>134</sup> And in the absence of the secondary responsibility on which her hypothetical seemingly depends, Justice Jackson’s solution to the problem of divided use seems untenable.

To capture the conduct of the German company in her hypothetical where the company neither knew nor intended that its American customers would resell its goods in the United States, one would instead have to adopt Justice Sotomayor’s approach. That is, rather than seeking to hold the German company secondarily responsible for their customer’s resale of the company’s products in the United States, one would do better to recognize that the German company engaged in use subject to the control of Congress by selling products to *American citizens*, and then simply ask whether that use generated harm in the United States in the form of likelihood of confusion. In this framing of the issue, again, it is not the German company’s responsibility for the acts of others that determines their liability, but rather the *effects* of their actions on the beliefs of consumers in the United States. Resale by the company’s American customers,

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132. *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 599 (5th Cir. 1985) (“The concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country’s statutory scheme.”) (footnote omitted).

133. *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518 (1972) (holding that manufacturing and selling the components of a machine subject to a United States patent in the United States and shipping the components abroad for final assembly did not infringe the patent because the patented invention was only “made” and “used” outside the territorial jurisdiction of the United States), *superseded by statute*, Patent Law Amendment Act of 1984, Pub. L. No. 98-622, 98 Stat. 3383 (codified as amended at 35 U.S.C. § 271(f)); *see generally* Lemley et al., *supra* note 12.

134. *See* 35 U.S.C. § 271(f) (requiring either “actively induc[ing]” another’s acts of infringement or “knowing that [a] component . . . will be combined outside of the United States in a manner that would infringe” as elements of cross-border divided infringement claims).



in this view, is merely additional *evidence of the harm* caused by the German company's own acts, rather than conduct legally attributable to the company as a matter of secondary responsibility.

In attempting to determine which view of third-party uses we ought to adopt—the evidentiary view or the secondary responsibility view—the example of cross-border divided use thus demonstrates deep disagreement, at least among the members of the Supreme Court. Other examples, however, may be less theoretically ambivalent.

## B. POST-SALE CONFUSION

Post-sale confusion is a theory of infringement liability primarily applied to knockoff luxury or status goods bearing a well-known trademark or mimicking a well-known trade dress.<sup>135</sup> In post-sale confusion cases, the defendant sells such a knockoff to a knowing, willing, *non-confused* purchaser—a purchaser who understands that the product they are buying is not sourced from or authorized by the owner of the trademark affixed to it. Because likelihood of confusion is an element of infringement, and because knowing purchasers of knockoffs are concededly not confused about what they are buying, some other type or locus of confusion must be identified if the sellers of knockoff goods are to be held liable for infringement. The lower federal courts have identified several candidates, all of them arising from the *non-confused purchaser's* subsequent use of the knockoff product. The purchaser might re-sell the knockoff, passing it off as genuine to a confused secondary purchaser;<sup>136</sup> or they might use the knockoff in view of potential purchasers of the genuine article who might mistake it for a genuine branded product and draw mistaken inferences about the quality of such genuine products;<sup>137</sup> or they might use the knockoff in view of a social audience in a way that leads that audience to afford the purchaser the social status of having purchased the genuine branded product, without regard to any beliefs about the qualities or characteristics of the products themselves.<sup>138</sup> In each of these scenarios, a potential objection to liability arises because, unlike in any other form of trademark infringement liability, the defendant has admittedly not confused *anybody*: their customers know full well what they are getting and are grateful for the opportunity. It is thus difficult to identify a harm caused by the *defendant's own conduct* that trademark law might seek to remedy.

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135. I have previously written about this theory of confusion at some length. See generally Jeremy N. Sheff, *Veblen Brands*, 96 MINN. L. REV. 769 (2011); Jeremy N. Sheff, *Misappropriation-Based Trademark Liability in Comparative Perspective*, in THE CAMBRIDGE HANDBOOK OF INTERNATIONAL AND COMPARATIVE TRADEMARK LAW 452 (Irene Calboli & Jane C. Ginsburg eds., 2020).

136. I have referred to this scenario as “downstream confusion,” and argued that it would be better analyzed under the first-sale doctrine or contributory infringement doctrine. *Veblen Brands*, *supra* note 135, at 785–90.

137. I have referred to this scenario as “bystander confusion.” *Id.* at 778–85.

138. I have referred to this scenario as “status confusion.” *Id.* at 790–94. I have argued that it is particularly problematic within trademark law's dominant theoretical framework because, “whereas the economic theory of trademarks is directed at the flow of information about products, status confusion doctrine is directed at the flow of information about people.” *Id.* at 776.

The divided-use framework, however, offers a potential solution to this theoretical problem. It should be apparent that status confusion scenarios are structurally quite similar to the secondary responsibility scenarios that have been the primary concern of this Article. However, unlike the previously identified examples of secondary responsibility (particularly those involving contributory infringement and secondary-market sales), the two actors in status confusion cases do *not* both engage in all the aspects of use identified in Part I.B of this Article in ways that are likely to cause confusion. The knockoff seller certainly uses the luxury good manufacturer's trademark on or in connection with goods or services, and uses it in commerce subject to the territorial and constitutional jurisdiction of commerce. But that use causes no confusion. The *purchaser* of the knockoff purportedly causes confusion, but it is difficult to conclude they use the mark *in commerce*, as it is questionable (under current Supreme Court Commerce Clause jurisprudence) that merely carrying a handbag or wearing a watch to impress a social audience is enough to bring the consumer under the Commerce Power.<sup>139</sup> Thus, even if we held the knockoff seller secondarily responsible for the acts of their customer, it is not clear that those acts could be characterized as infringing.

If, however, the various aspects of use could be *divided* between the two parties, *and* if the seller could be held secondarily responsible for the acts of its customers, this problem disappears. The likelihood of confusion—absent from the seller's conduct—is supplied by the buyer's conduct for which the seller bears secondary responsibility, while the use in commerce subject to the regulation of Congress—absent from the buyer's conduct—is supplied by the seller's *direct* conduct. Combine the two, and all the required aspects of use are present (assuming, of course, that the particular type of confusion caused by the purchaser is a proper concern of trademark law—which I have elsewhere argued it is not).<sup>140</sup>

One obstacle remains to this merger of primary and secondary responsibility as a means of satisfying the various defendant-side “use” requirements of trademark law in the context of post-sale confusion cases. This is the knowledge and intent element typically required for the assignment of secondary responsibility. As in the context of first-sale doctrine, it is clear that the seller of knockoffs is *generally* aware that their

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139. *United States v. Morrison*, 529 U.S. 598, 613 (2000) (“[O]ur cases have upheld Commerce Clause regulation of intrastate activity only where that activity is economic in nature.”); *United States v. Lopez*, 514 U.S. 549, 567 (1995) (“The possession of a gun in a local school zone is in no sense an economic activity that might, through repetition elsewhere, substantially affect any sort of interstate commerce.”). One might make the argument that in the aggregate, widespread consumption of knockoffs would undermine the market for genuine branded luxury goods—indeed this argument is often made by courts in post-sale confusion cases. *See, e.g., Hermes Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 108 (2d Cir. 2000) (“[T]he purchaser of an original is harmed by the widespread existence of knockoffs because the high value of originals, which derives in part from their scarcity, is lessened.”). But such aggregate effects of individual non-marketplace behaviors have an uncertain status under contemporary Commerce Clause jurisprudence. *Nat'l Fed'n of Indep. Bus. v. Sebelius*, 567 U.S. 519, 550 (2012) (“The power to *regulate* commerce presupposes the existence of commercial activity to be regulated.”); *but cf. Wickard v. Filburn*, 317 U.S. 111 (1942).

140. *See generally Veblen Brands*, *supra* note 135; *see also* Jeremy N. Sheff, *Marks, Morals, and Markets*, 65 STAN. L. REV. 761, 801–06 (2013).

products may be used by the seller's customers in a way that might cause confusion. But it is likewise clear that *specific* knowledge that any *particular* purchaser will do so would be difficult for a plaintiff to establish. In the context of first-sale doctrine we noted that this apparent deficiency might be remedied by looking to the background entitlements of the party whose acts were to be ascribed to another as a matter of secondary responsibility: if the act was within that actor's background entitlements (as in the case of selling one's personal property), perhaps constructive knowledge and intent that the act be performed could be ascribed to the secondarily responsible party. If instead the act was not within that actor's background entitlements (as in the case of applying someone else's trademarks to the actor's goods without the mark owner's consent), some additional evidence of knowledge and intent might be demanded. In the case of post-sale confusion, if (as we have assumed) carrying a purse or wearing a watch is an activity outside the scope of Congress's commerce power, it seems that it would be within the background entitlement of the knockoff purchaser to do it.<sup>141</sup> This would therefore seem to be a way to satisfy the knowledge and intent requirement for ascribing the purchaser's conduct to the knockoff seller as a matter of secondary responsibility. And understanding the doctrine in this way mitigates some (though admittedly not all) of the theoretical objections to post-sale confusion doctrine.

### C. EXPRESSIVE USES

In the previous part, I noted some areas where uses of trademarks by the public seemed to be ascribed to a trademark plaintiff or claimant as a matter of secondary responsibility. This phenomenon suggests that trademarks—and particularly the *meanings* of trademarks—are a common resource that both their owners and others might contribute to, and that all of those contributions are implicated every time the mark is used—*by anyone*. Such an understanding of trademarks is consistent with the arguments of scholars who have critiqued the expansion of trademark infringement liability in ways that might inhibit freedom of expression. As Jessica Litman put it twenty-five years ago:

[T]rade symbols . . . are also now metaphors with meanings their proprietors would not have chosen. They got that way in spite of any advertising campaigns because the general public invested them with meaning. The value of persuasive trade symbols, in short, results from mutual investment by producers and consumers. . . . The building of a brand that becomes its own product is a collaborative undertaking; the investment of both dollars and imagination flows both ways. There is no particularly good reason to adopt a rule permitting the producers of the brands to arrogate all of that collaboratively created value to themselves. The icons that embody the persuasive force of those brands, I suggest, should properly be viewed as collectively owned.<sup>142</sup>

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141. I have elsewhere argued that the First Amendment likely entails a right to engage in such socially expressive consumption. *Veblen Brands*, *supra* note 135, at 815–28.

142. Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age Symposium: Ralph Sharp Brown, Intellectual Property, and the Public Interest*, 108 YALE L.J. 1717, 1734 (1999).

This is a different way of understanding expressive uses than the one we typically see in the caselaw. In cases like *Rogers v. Grimaldi*, courts seem to be concerned with balancing the intellectual property interests of trademark owners on the one hand with the constitutional freedom of expression of speakers on the other—treating the two interests as distinct and opposed to one another.<sup>143</sup> *Jack Daniel's* itself seems to adopt this view.<sup>144</sup> But Professor Litman's view resonates with the analysis of the Ninth Circuit's gloss on *Rogers* in *Mattel, Inc. v. MCA Records, Inc.*:

Some trademarks enter our public discourse and become an integral part of our vocabulary. How else do you say that something's "the Rolls Royce of its class"? What else is a quick fix, but a Band-Aid? . . . Trademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions. Once imbued with such expressive value, the trademark becomes a word in our language and assumes a role outside the bounds of trademark law.<sup>145</sup>

The interaction of public uses of a mark with uses by the mark's owner creates puzzles on both the defendant side and the plaintiff side of the "use" puzzle that this Article has examined. It raises the question whether and when defendant-side uses charged as infringements may claim the benefit of publicly created meanings to avoid liability. And it also raises the plaintiff-side question whether and how public uses of a term as a part of our common cultural vocabulary may affect a trademark claimant's ability to obtain protection for that term (or the scope of that protection). Both these questions compel us to consider whether the secondary responsibility and divided use frameworks developed in this Article can help find or perhaps even justify an answer.

On the plaintiff side, as observed above, the failure-to-function doctrine implicates these frameworks most directly. Sometimes a word or slogan claimed as a trademark is argued not to function as a mark, not necessarily because the claimant is not trying to use the slogan as a trademark, but because it will not be perceived by consumers as a trademark.<sup>146</sup> As I suggested above, we could understand this doctrine in at least two ways. In one understanding, consumer *perceptions* are *evidence* of trademark claimants' *actions*. That understanding—what I have called the evidentiary view—requires some heroic assumptions about the correlation between purposes and effects. If instead we conceive of failure-to-function doctrine as an expression of how trademark law believes a trademark will be *used by consumers*—and attribute *those* uses to the trademark claimant as a matter of secondary responsibility as we do in the context of genericide or the nickname cases—that assumption becomes unnecessary. In its place, we need instead some justification for holding the trademark claimant responsible for the

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143. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989) ("We believe that in general the Act should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.").

144. *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 159 (2023) ("When a mark is used as a mark (except, potentially, in rare situations), the likelihood-of-confusion inquiry does enough work to account for the interest in free expression.").

145. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

146. See *supra* Section I.B.3.b.

actions of those consumers—specifically, for consumers’ use of the mark “other than as a trademark,” defeating the requirement of trademark use on the plaintiff side. And that justification, it seems, requires us to defend some view of how consumers are entitled to use language and symbols, even where someone might claim that language and those symbols as trademarks, and even where some confusion might result.

This brings us back to defendant-side use, and to the place where this Article began: *Jack Daniel’s*. The majority opinion in that case tells us that “trademark uses” by a defendant, though perhaps not a required element of an infringement claim, are more likely to cause confusion—and thus more likely to be considered infringing—than non-trademark uses: “confusion [as to source] is most likely to arise when someone uses another’s trademark as a trademark—meaning, again, as a source identifier—rather than for some other expressive function.”<sup>147</sup> But of course, a defendant might use a plaintiff’s trademark “other than as a mark,” while still causing confusion. Whole theories of infringement liability—contested theories like initial-interest confusion, affiliation/sponsorship/approval confusion, and merchandising rights—have been built around such uses. One way of conceiving of this result is as a mirror-image of failure-to-function doctrine on the plaintiff side. That is, rather than seeing these attenuated theories of confusion as *evidence*—as the *effect* of trademark defendants’ behaviors on consumers—we might take what this Article has called the secondary responsibility view. That is, we might view consumers as *participants* in the construction of trademarks’ meaning, see that participation as in itself a form of “use” of the trademark, and ascribe such “uses” to the defendant. This change in conception might not necessarily result in different outcomes under these various theories of liability. But it would require us to develop an account of the ways that consumers are entitled to use and refer to branded goods and services, and to consider whether those uses ought to be insulated from liability even if some confusion results.

#### IV. CONCLUSION

As I and others have pointed out elsewhere, trademark law in the twentieth century underwent a substantial shift in its conception of the role of consumers. Whereas consumer confusion under earlier caselaw was merely *evidence* of the competitive injury inflicted by a defendant on a plaintiff, the Lanham Act came to treat such consumer confusion as the primary harm trademark law sought to prevent. With the recent focus on use as a key concern of trademark law, and the various ways doctrines developed *after* this historical shift can be conceptualized through the lens of divided use and secondary responsibility, a new possible conception of consumers’ role can be perceived. Rather than mere evidence of competitive injury, or even passive victims of tortious conduct, consumers in this view become active participants in the behaviors that trademark law attempts to regulate. Those behaviors are complex and interconnected; they are multidimensional and cumulative. Using legal tools such as secondary responsibility to try to delineate the relationship between consumer

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147. *Jack Daniel’s*, 599 U.S. at 157.

behaviors and producer behaviors, and tie those relationships to validity and infringement doctrines, creates novel avenues for understanding and perhaps even justifying doctrines that have been subject to substantial criticism under existing theoretical frameworks.

But such a reformulation of our understanding of trademark law also raises new questions. Traditionally, secondary responsibility is grounded in one agent's knowledge of, and intent to assist or bring about, another agent's actions. And where specific knowledge cannot be readily proven, arguments about constructive knowledge—what the secondary actor should have known—might be invoked to fill the gap. As I have shown in this Article, such arguments about constructive knowledge in the trademark system require us to fall back on background principles of law that allocate entitlements to engage in behaviors that are alleged to be within the constructive knowledge of secondary actors. In this sense, the reformulation of use in trademark law as a question of divided and secondary responsibility may solve some doctrinal puzzles, but only if we are prepared to stake out substantive normative positions regarding what uses of trademarks are or are not within the rights of people acting within the trademark system—particularly consumers—independently of the question of consumer confusion. This is not an exercise that twentieth century trademark law was prepared to undertake, as confusion became the single most important issue in the field while also becoming increasingly nebulous and malleable as a concept. But perhaps a renewed focus on formal questions—questions of use—may offer an avenue to more consciously consider how different actors within the trademark system might have interests in the use of trademarks, how those uses might interact, and how we might balance those interests against one another.

## Copyright Infringement Test (Re)visited: U.S. Spillover into China Yielding a Similar Test?

Yang Chen\*

### ABSTRACT

One of the most pivotal doctrines in copyright law is its infringement test, which determines whether a defendant's acts violate reproduction rights. This test, which continues to plague U.S. copyright law, includes two widely adopted and influential prongs: (1) factual copying; and (2) improper appropriation. To establish factual copying, U.S. courts allow a sliding scale of proof between the defendant's *access* to the copyrighted work and *similarities* between the defendant's and plaintiff's works. The improper appropriation prong requires the similarities to reach a *substantial* level that is deemed improper. However, both prongs are fervently discussed, questioned, and criticized by U.S. courts, scholars, and practitioners. These critics neither form a unified understanding of each prong nor share similar viewpoints on the test's desirability and potential reform. Despite the test's intricate complications, its influence extends to other jurisdictions due to the global "reach" of U.S. copyright law.

China, a jurisdiction that has adopted many doctrines and rules from U.S. copyright law, seemingly uses a similar copyright infringement test: the rule of "substantial similarity" plus "access." The strikingly similar terminology, supported by anecdotal evidence, suggests a direct legal transplantation of this test from the U.S. to China. This observation implies that China essentially shares the same test as the U.S. due to this legal transplantation. However, positive discussions of China's law in books and

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empirical explorations of the law in practice in this Article reveal substantial differences from the U.S. version, despite the similar terminology, which remain unnoticed and underexplored in current literature. Although some spillover from the U.S. test to China is acknowledged, the similarities noted in the current literature are quite superficial. These differences raise several unexplored questions: Should China's test draw further from the U.S. to enhance future improvements? Does the Chinese version function effectively in practice and withstand theoretical scrutiny? If not, what should be the future direction for the Chinese version based on comparative insights? Should China consider a direct transplantation of the entire U.S. test in the future?

This Article unravels the differences between the U.S. and Chinese infringement tests and addresses these questions. It delves into the history of how the "substantial similarity" plus "access" test was introduced to Chinese copyright law and its relationship with the superficially similar U.S. test, indicating the potential spillover. It also offers some empirical evidence based on Chinese court cases applying the test to see how it functions in practice, with a particular focus on whether the Chinese test achieves similar outcomes to the U.S. test. The Article attempts to reveal whether the Chinese version achieves the intended function of copyright infringement tests and withstands theoretical discussions. This Article argues that the Chinese version is more desirable than the U.S. version for China. One reason is that the Chinese version better aligns with China's civil procedure law, which differs significantly from U.S. law. Also, the Chinese version can address the issues and problems identified in the current U.S. tests. Therefore, there should be caution about suggesting any future transplantation from the U.S. However, this Article acknowledges the vagueness and problems of the Chinese version and proposes a reformed test for Chinese law to better achieve its intended functions.



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## INTRODUCTION

Copyright law remains at the forefront of the public's attention. The rampant spread of AI-generated works created through the ChatGPT or the more specifically designed Midjourney has catalyzed intensive judicial and scholarly debates on whether those works can ever receive copyright protection and whether they may potentially infringe prior copyrighted works.<sup>1</sup> The trending computer game available on Steam titled "Palworld," which used AI to create main characters imitating copyrighted Pokémon characters owned by The Pokémon Company, raised serious concerns about the copyright infringement issue yet was tremendously popular among players.<sup>2</sup> The essence of many copyright protection issues raised by the launch of a new controversial technology, product, or work centers on determining whether the conduct amounts to actionable copyright infringement.<sup>3</sup>

To sustain a copyright infringement claim, copyright holders need to establish the authorship or ownership of the copyrighted work, the copyrightability of the work, and, very importantly, the fact that alleged infringers' conduct falls into the domain of any of the copyright holder's exclusive rights.<sup>4</sup> While copyright holders enjoy various

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1. See, e.g., Mark A. Lemley & Bryan Casey, *Fair Learning*, 99 TEX. L. REV. 743 (2021); Jane C. Ginsburg & Luke Ali Budiardjo, *Authors and Machines*, 34 BERKELEY TECH. L.J. 343 (2019); Pamela Samuelson, *Fair Use Defenses in Disruptive Technology Cases*, 71 UCLA L. REV. (forthcoming 2024); Zhen (Katie) Feng et al., *Beijing Internet Court Grants Copyright Protection for AI Artworks, but Copyrightability Debate of AI-generated Output Continues*, HOGAN LOVELLS ENGAGE (Dec. 6, 2023), <https://www.engage.hoganlovells.com/knowledgeservices/news/beijing-internet-court-grants-copyright-protection-for-ai-artworks-but-copyrightability-debate-of-ai-generated-output-continues> [https://perma.cc/35U6-P6T6]; *The Yuan Global Talks on Generative AI and Human Creativity*, BERKELEY CTR. FOR L. & TECH (2024), <https://www.law.berkeley.edu/research/bclt/bcltevents/yuan-global-talks/> [https://perma.cc/PXH2-6BGC].

2. See, e.g., Adam Bankhurst, *The Pokemon Company Makes an Official Statement on Palworld: 'We Intend to Investigate'*, IGN (Jan. 25, 2024), <https://www.ign.com/articles/the-pokemon-company-makes-an-official-statement-on-palworld-we-intend-to-investigate> [https://perma.cc/2PB4-PX99] [https://web.archive.org/web/20241003002444/https://www.ign.com/articles/the-pokemon-company-makes-an-official-statement-on-palworld-we-intend-to-investigate]; Michael Nam, *'Palworld' Video Game Ignites Furor as It Becomes an Overnight Sensation*, CNN (Jan. 24, 2024), <https://edition.cnn.com/2024/01/24/tech/palworld-sales-pokemon-with-guns/index.html> [https://perma.cc/WDR6-ATQV] [https://web.archive.org/web/20240130160615/https://edition.cnn.com/2024/01/24/tech/palworld-sales-pokemon-with-guns/index.html].

3. An exception to this is the issue of AI authorship, which raises the question of whether AI-generated work can be copyrightable or whether AI can be considered as an author. Yet the ownership/authorship issue is also one of the steps in analyzing whether there is copyright infringement. The same applies to the fair use doctrine, which is also one critical step in copyright infringement analysis and is hotly debated as well. See, e.g., Abraham Bell & Gideon Parchomovsky, *Propertizing Fair Use*, 107 VA. L. REV. 1255 (2021); Peter K. Yu, *Fair Use and Its Global Paradigm Evolution*, 2019 U. ILL. L. REV. 111 (2019).

4. See, e.g., Shyamkrishna Balganesh, Irina D. Manta & Tess Wilkinson-Ryan, *Judging Similarity*, 100 IOWA L. REV. 267, 272 (2014); Zhang Xiaoxia (张晓霞) & Zhang Jiayi (张嘉艺), *Qin Quan Xing Wei Gou*

exclusive rights, the right to copy remains fundamental, even in today's digital environment.<sup>5</sup> The right to copy controls any unauthorized reproduction of the work, demanding the plaintiff to prove that their work was copied.<sup>6</sup> Yet the reproduction right does not just control literal copying (or copying verbatim), which should be an easy case for analysis.<sup>7</sup> It extends to some forms of non-literal copying, requiring courts to determine when and to what extent non-literal copying amounts to illegitimate copyright infringement.<sup>8</sup> That is why courts have developed and used the so-called copyright infringement test to decide whether there is actionable copying—a test that has long plagued courts and copyright experts and remains subject to heated debate.<sup>9</sup>

In the United States, the copyright infringement test primarily consists of two widely adopted and influential prongs: (1) factual copying; and (2) improper appropriation.<sup>10</sup> To establish factual copying, U.S. courts allow a sliding scale of proof between the defendant's *access* to the copyrighted work and *similarities* between the defendant's and the plaintiff's works.<sup>11</sup> The improper appropriation prong requires the similarities to reach a *substantial* level that is deemed improper.<sup>12</sup> However, U.S. courts, scholars, and practitioners fervently discuss, question, and criticize both prongs. They neither form a unified understanding of each prong nor share similar viewpoints on the test's desirability and potential reform.<sup>13</sup> Despite the test's intricate complications,

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Cheng Yao Jian Dui "Jie Chu Jia Shi Zhi Xiang Si" Gui Ze De Zhi Heng—Lun Qin Hai Zuo Quan Jiu Fen De Cai Pan Si Lu (侵权行为构成要件对“接触加实质性相似”规则的制衡—论侵害著作权纠纷的裁判思路) [On the Balance of the Constituent Elements of Tort Against the "Access Plus Substantial Similarity" Rule—on the Adjudication Thinking of Copyright Infringement Disputes], 12 ZHI SHI CHAN QUAN (知识产权) [INTELL. PROP.] 40, 45 (2021).

5. See, e.g., Shyamkrishna Balganesh, *The Normativity of Copying in Copyright Law*, 62 DUKE L.J. 203, 205 (2012). See generally, Glynn S. Lunney Jr., *The Death of Copyright: Digital Technology, Private Copying, and the Digital Millennium Copyright Act*, 87 VA. L. REV. 813 (2001); Joseph P. Liu, *Owning Digital Copies: Copyright Law and the Incidents of Copy Ownership*, 42 WM. & MARY L. REV. 1245 (2001).

6. Balganesh, Manta, & Wilkinson-Ryan, *supra* note 4, at 272.

7. See Pamela Samuelson, *A Fresh Look at Tests for Nonliteral Copyright Infringement*, 107 NW. U. L. REV. 1821, 1822 (2013).

8. See *id.* at 1822–23.

9. See, e.g., Shyamkrishna Balganesh & Peter S. Menell, *Proving Copying*, 64 WM. & MARY L. REV. 299 (2022); Clark D. Asay, *An Empirical Study of Copyright's Substantial Similarity Test*, 13 UC IRVINE L. REV. 35 (2022); Daryl Lim, *Saving Substantial Similarity*, 73 FLA. L. REV. 591 (2021); Shyamkrishna Balganesh, *The Questionable Origins of the Copyright Infringement Analysis*, 68 STAN. L. REV. 791 (2016).

10. The two-prong test originates from the Second Circuit in *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946). See Asay, *supra* note 9, at 43–50; Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 J. COPYRIGHT SOC'Y U.S. 719, 721–22 (2010). It should be noted, however, that there are some differences between the tests adopted by the Ninth Circuit and the Second Circuit, though in essence they more or less both require the substance of the two prongs. See Douglas Y'Barbo, *The Origin of the Contemporary Standard for Copyright Infringement*, 6 J. INTELL. PROP. L. 285, 294–300 (1999).

11. Balganesh & Menell, *supra* note 9, at 304–05.

12. See Lim, *supra* note 9, at 602.

13. See generally Lim, *supra* note 9; Lemley, *supra* note 10; Asay, *supra* note 9 (giving empirical evidence on diverse approaches taken by courts across the states); Balganesh & Menell, *supra* note 9 (discussing some courts' misunderstandings of the first prong); Alan Latman, *Probative Similarity as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement*, 90 COLUM. L. REV. 1187 (1990) (focusing on the true meaning of "substantial similarity" in the first prong); Irina D. Manta, *Reasonable Copyright*, 53 B.C. L. REV. 1303 (2012).

its influence extends to other jurisdictions due to the global “reach” of U.S. copyright law.<sup>14</sup>

China is one of the jurisdictions whose intellectual property (“IP”) laws, including copyright law, have adopted many doctrines and rules from the United States.<sup>15</sup> The country uses a seemingly similar copyright infringement test—the rule of *substantial similarity* plus *access*—that allegedly derives from the U.S. test, consciously or subconsciously.<sup>16</sup> The strikingly similar usage of terminology, along with anecdotal evidence,<sup>17</sup> both point to a conclusion: There is a direct legal transplantation of the test from the U.S. to China. A further inference from this observation is that China shares essentially the same test as the U.S. due to this legal transplantation.

However, despite the similar terminology, the positive discussions of China’s law in books and empirical explorations of the law in practice in this Article reveal substantial differences with the U.S. version.<sup>18</sup> These differences remain unnoticed and underexplored in current literature. Some literature hints at the spillover or potential transplantation of the Chinese test from the U.S. but fails to uncover the meaningful divergences between them, sloppily equating the two.<sup>19</sup> Some regrettably misunderstands the functions of each prong of the U.S. test and, accordingly, applies these misunderstandings to the Chinese test under the premise of legal transplantation.<sup>20</sup> Several others refuse to acknowledge any spillover, much less legal

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(identifying the bias concerning the copyright infringement test); Daniel Gervais, *Improper Appropriation*, 23 LEWIS & CLARK L. REV. 599 (2019) (debating on the “improper appropriation” prong).

14. For example, due to its influence, some civil law jurisdictions, such as China, Japan, and Germany also adopt similar versions of the test. See Zhang & Zhang, *supra* note 4, at 42.

15. See Tianxiang He, *Transplanting Fair Use in China? History, Impediments and the Future*, U. ILL. J.L. TECH. & POL’Y 359, 361–62 (2020). For other IP laws, see Yang Chen, *Development of China’s Trade Secrets Law in the US’ Shadow: Negative Consequences for China and Suggestions*, 17 U. PA. ASIAN L. REV. 138, 161–68 (2022).

16. See Liu Lin (刘琳), *Woguo Banquan Qin Quan “Jie Chu” Yao Jian De Jian Tao Yu Zhong Gou (我国版权侵权“接触”要件的检讨与重构)* [Review and Reconstruction of the “Access” Element of Copyright Infringement in China], 11 ZHI SHI CHAN QUAN (知识产权) [INTELL. PROP.] 71, 72–73 (2021); Zhang & Zhang, *supra* note 4, at 42.

17. See *infra* Part II.A.

18. See *infra* Parts II–IV.

19. See, e.g., Wu Handong (吴汉东), *Shi Lun “Shi Zhi Xiang Si + Jie Chu” De Qin Quan Ren Ding Gui Ze (试论“实质性相似+接触”的侵权认定规则)* [On the Rule of Infringement Determination of “Substantial Similarity + Access”], 8 FA XUE [L. SCI.] 63, 63 (2015) (mentioning only that the test originates from the U.S. without offering more details or more nuanced comparison); Zhang & Zhang, *supra* note 4, at 41–43 (providing a brief discussion on China’s transplantation of the test from the US without offering more details or specifics of the U.S. test); Liang Zhiwen (梁志文), *Banquan Fa Shang Shi Zhi Xiang Si De Pan Ding (版权法上实质性相似的判断)* [Judgment of Substantial Similarity in Copyright Law], 6 FA XUE JIA [JURIST] 37, 40–41 (2015) (discussing the origin of the second prong (substantial similarity) but does not mention the first prong (access) since it is not the focus of the article); Jinchuan Chen (陈锦川), *Xiao Yi “Jie Chu Jia Shi Zhi Xiang Si” Gui Ze (小议“接触加实质性相似”规则)* [Brief Discussion on the Rule of “Access Plus Substantial Similarity”], 1 ZHONG GUO BAN QUAN [CHINA COPYRIGHT] (Mar. 2, 2018) (mentioning that the China test was directly transplanted by Chinese courts from the U.S. as the Chinese statute never mentions any similar two-prong test), [https://mp.weixin.qq.com/s/ESaLfjci4mYOVmVArRI-w\\_\\_](https://mp.weixin.qq.com/s/ESaLfjci4mYOVmVArRI-w__) [<https://perma.cc/25XN-ANY8>].

20. See, e.g., Liu, *supra* note 16, at 80–81 (misunderstands the “inverse ratio rule” which only exists in the first prong of the U.S. test rather than the second prong).

transplantation, from the U.S. test to the Chinese one,<sup>21</sup> which, in certain ways, muddies the understanding of the functions and purposes of the test.

The current literature not only fails to reveal the differences between the Chinese test and the U.S. version, but it also leaves important questions unexplored: Does the Chinese version function effectively in practice and withstand theoretical scrutiny? If not, what direction should the Chinese version take based on comparative insights? Should China directly transplant the entire U.S. test for future improvements? In other words, should China's test continually draw lessons from the U.S. for ongoing enhancements?

This Article addresses these research gaps. It acknowledges the spillover from the U.S. test to China, underscoring the importance of understanding the nuances of the Chinese test through the comparative lens of the U.S. test. However, the similarities observed in the current literature between the Chinese and U.S. versions are quite superficial. The empirical evidence presented in this Article, along with a deeper examination, reveals substantial divergences, making it inappropriate to equate the two superficially. This Article argues that these divergences stem from significant differences in the civil procedure laws of the two jurisdictions. Indeed, the Chinese version is more suitable for China as it aligns better with China's civil procedure law and addresses the issues and problems identified in current U.S. tests. Therefore, this Article cautions against any future legal transplantation from the U.S. It also acknowledges the vagueness and problems of the Chinese version and proposes a reformed test for Chinese law to better fulfill its intended functions.

To articulate these arguments, this Article is structured as follows: Part I provides more accurate details of the U.S. copyright test(s) that the current literature in China fails to offer, setting the stage for a more precise understanding and comparison with the Chinese test. Part II then provides a comprehensive account of the Chinese test by discussing the laws on the books and presenting empirical evidence on how the Chinese test functions in practice. Part III first delves briefly into the history of the substantial similarity plus access test in Chinese copyright law and its relationship with the superficially similar U.S. test, suggesting a spillover effect. It then builds on the explorations in Parts I and II, uncovering the substantial divergences between the

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21. See, e.g., Wenjie Ding (丁文杰), *Jie Chu Yao Jian De Ji Ben Nei Han Ji Ren Ding Gui Ze* (接触要件的基本内涵及认定规则) [The Basic Connotation and Recognition Rules of Access Elements], 3 ZHI SHI CHAN QUAN (知识产权) [INTELL. PROP.] 24, 29 (2019) (only footnote 33 briefly mentions the U.S. two-prong test); Xiaozhou Zhou (周小舟), *Lun Jie Chu Yao Jian Zai Jie Jie An Zhong De Cheng Xu He Shi Zhi Yi Yi—Cong “Xiao Zhan” An Qie Ru* (论接触要件在剽窃案中的程序和实质意义—从《小站》案切入) [On the Procedural and Substantive Significance of the Access Element in Plagiarism Cases—From the Case of “Xiao Zhan”], 2 HUA DONG ZHENG FA DA XUE XUE BAO [J. EAST CHINA UNI. POLIT. SCI. & L.] 108 (2016); Haijun Lu (卢海君), *Lun Zuo Pin Shi Zhi Xiang Si He Ban Quan Qin Quan Pan Ding De Lu Jing Xuan Ze—Yue Jian Zhu Yi Yu Zheng Ti Gai Nian He Gan Jue Yuan Ze* (论作品实质性相似和版权侵权判定的路径选择—约减主义与整体概念和感觉原则) [On the Path Choice of Substantial Similarity of Works and Copyright Infringement Determination—Reductionism and the Principle of Overall Concept and Feeling], 1 ZHENG FA LUN CONG [POLIT. & L. FORUMS] 138 (2015).

Chinese and U.S. tests, despite the spillover, and disproving the superficial equivalence between the two. Part IV justifies these divergences, advises against any future legal transplantation from the U.S., and offers normative suggestions for improving the Chinese test.

## I. COPYRIGHT INFRINGEMENT TESTS IN THE UNITED STATES: SETTING THE COMPARISON FORUM

The U.S. copyright infringement test is important locally and globally because it spills over into other jurisdictions through explicit legal transplantation or implicit reference.<sup>22</sup> Yet the test still plagues U.S. courts and local copyright scholars despite its transnational effect.<sup>23</sup> This Article primarily intends to dissect the Chinese test by comparing it with the U.S. version, so there is no need to join the endless debate on how each prong of the U.S. test *should* be. It suffices to offer relatively accurate and commonly shared understandings of what the U.S. test is *now* and what functions each prong tends to achieve to set the stage for comparison.

The following sections briefly introduce the history of the U.S. copyright infringement test and discuss the two commonly used versions adopted by the Ninth Circuit and the Second Circuit. Then, they dive into the Second Circuit's two-prong test with a keen focus on what functions each prong strives to achieve from the perspectives of copyright and civil procedure law.

### A. COPYRIGHT INFRINGEMENT TESTS: THE DIVISION BETWEEN THE NINTH AND SECOND CIRCUITS

Though U.S. courts currently lack a unified legal standard to determine copyright infringement,<sup>24</sup> most have relied upon the approaches adopted by the Second Circuit in *Arnstein v. Porter* and the Ninth Circuit in *Sid and Marty Krofft*.<sup>25</sup> Other circuits explicitly or implicitly follow one of these two approaches or treat them interchangeably, blending or switching between them.<sup>26</sup> These two approaches can serve as rough proxies for the copyright infringement tests used nationwide.

In *Arnstein*, the Second Circuit creatively introduced the “notorious” two-prong test to the copyright regime, though it was the *dicta* in the opinion that developed the test,

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22. See *supra* note 14 and accompanying text.

23. See *supra* note 13 and accompanying text.

24. See *Y'Barbo*, *supra* note 10, at 285; *Asay*, *supra* note 9, at 43–50 (descriptions of seemingly similar but still different copyright infringement tests adopted by different courts in the U.S.); Balganes & Menell, *supra* note 9, at 302 (Congress never set forth an infringement test, leaving room for judicial development).

25. *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946); *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977); Lemley, *supra* note 10, at 719; *Y'Barbo*, *supra* note 10, at 285.

26. *Y'Barbo*, *supra* note 10, at 316; Manta, *supra* note 13, at 1334–1336 (explaining that most circuits adopted either the *Arnstein* or the *Krofft* test with occasional modifications depending on the circumstances).

the precedential influence of which Judge Frank may not have anticipated.<sup>27</sup> The *Arnstein* test uses two prongs to determine whether the defendant substantially copied and infringed the plaintiff's copyrighted work. It requires plaintiffs to prove "(a) that defendant copied from plaintiff's work and (b) that the copying (assuming it to be proved) went so far as to constitute improper appropriation."<sup>28</sup> Motivated by the Second Circuit's approach, the Ninth Circuit formulated its own version of this two-prong test, demanding the plaintiff to prove (a) whether there is substantial similarity of ideas (extrinsic test) and (b) whether there is substantial similarity in expressions (intrinsic test).<sup>29</sup>

Though the Ninth Circuit explicitly mentions the *Arnstein* test as the basis for its test and intends to achieve similar functions,<sup>30</sup> some scholars argue that the two versions still differ.<sup>31</sup> While the Second Circuit divides the infringing copying issue into two, with only the second prong dedicated to the question of unlawful appropriation, both prongs of the Ninth Circuit's test point to the improper appropriation issue.<sup>32</sup> Put another way, the Ninth Circuit's two prongs "implicitly subsume[]" the derivation (actual copying) issue, whereas the Second Circuit uses prong one to determine the actual copying.<sup>33</sup> Yet because both versions require similar elements, scholars also widely recognize their similar purposes and functions.<sup>34</sup>

This is one reason this Article primarily uses the *Arnstein* test as the comparison point and refrains from delving into the detailed differences between the two versions. The *Arnstein* test, as the model of the two-step test widely adopted in the United States, is sufficient for this comparative study. More importantly, as elaborated shortly, it is the *Arnstein* test that uses the same terms as the Chinese version of the copyright infringement test ("access" and "substantial similarity").<sup>35</sup> With these factors in mind, the following sections dissect the *Arnstein* test by exploring the prongs' unique relationship and procedural functions.

## B. THE TWO PRONGS OF THE ARNSTEIN TEST: AN INTRICATE RELATIONSHIP

Each prong of the *Arnstein* test demands distinct proof and serves different functions. The first prong (the actual copying prong) can be established through direct

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27. See, e.g., Balganes, *supra* note 9, at 804–09, 811–13.

28. *Arnstein*, 154 F.2d at 468.

29. *Sid & Marty Krofft Television Prods., Inc.*, 562 F.2d at 1164–65.

30. *Id.* at 1165.

31. See, e.g., Samuelson, *supra* note 7, at 1829–30; Lim, *supra* note 9, at 610–11; Y'Barbo, *supra* note 10, at 294–300.

32. See Y'Barbo, *supra* note 10, at 295–96; Lim, *supra* note 9, at 611.

33. Y'Barbo, *supra* note 10, at 296; Gervais, *supra* note 13, at 610–11.

34. See, e.g., Lemley, *supra* note 10, at 723 (stating the Ninth Circuit takes the same basic two-step approach).

35. See *infra* Part II.

or circumstantial evidence.<sup>36</sup> Direct evidence includes admissions made by defendants or eyewitness testimony about the copying conduct of defendants—both of which are rare.<sup>37</sup> The infrequent appearance of direct proof renders the circumstantial evidence pivotal in inferring the actual copying. Two common pieces of circumstantial evidence recognized by precedent to infer the existence of actual copying, which always function in combination with each other, are “the defendant’s access to the plaintiff’s work and what courts call ‘substantial similarity.’”<sup>38</sup> As such, prong one can roughly be summarized as substantial similarity plus access.

The prevalent interpretation of access is proof of an opportunity to copy the copyrighted work.<sup>39</sup> In other words, the access does not need to be actual contact with the work; it can be a reasonable possibility of access as long as it is more than a “bare possibility based on mere speculation or conjecture.”<sup>40</sup> The plaintiff may succeed in proving access through widespread dissemination of the copyrighted work or the defendant’s receipt of the work from the plaintiff.<sup>41</sup> The threshold for proving access is, thus, relatively low, which may be why prong one is satisfied at a high rate, particularly when many courts simply rubber stamp prong one *only* through access (wholly disregarding the substantial similarity).<sup>42</sup>

While access is a relatively easier and much less contested issue, substantial similarity in the first prong is more controversial as it involves indirect proof of “similarities sufficient to prove copying.”<sup>43</sup> One may, however, easily confuse it with the substantial similarities required to constitute the improper misappropriation in the second prong, as many courts use the same terminology to refer to the similarities required in both prongs.<sup>44</sup> Due to this double use of terminology, some courts have conflated substantial similarity in the two prongs, lumping them together as a single test.<sup>45</sup> As further explored in Part IV, this is likely the same “mistake” Chinese courts made when they transplanted the U.S. test consciously or subconsciously,<sup>46</sup> making the accurate understanding of prong one and its relationship with prong two pivotal.

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36. Balganes & Menell, *supra* note 9, at 304; Lydia Pallas Loren & Anthony Reese, *Proving Infringement: Burdens of Proof in Copyright Infringement Litigation*, 23 LEWIS & CLARK L. REV. 621, 641–42 (2019).

37. Loren & Reese, *supra* note 36, at 641; Balganes & Menell, *supra* note 9, at 304; Lemley, *supra* note 10, at 719–20.

38. Lemley, *supra* note 10, at 719–20; Balganes & Menell, *supra* note 9, at 304; Balganes, Manta, & Wilkinson-Ryan, *supra* note 4, at 272–73.

39. Stacy Brown, *The Corporate Receipt Conundrum: Establishing Access in Copyright Infringement Actions*, 77 MINN. L. REV. 1409, 1417–18 (1993).

40. *Id.*; Lim, *supra* note 9, at 600.

41. Lim, *supra* note 9, at 600–01.

42. *See* Asay, *supra* note 9, at 75–77.

43. Latman, *supra* note 13, at 1193.

44. *See id.* at 1190–91; Lemley, *supra* note 10, at 720; Balganes & Menell, *supra* note 9, at 305.

45. *See* Lemley, *supra* note 10, at 720; Latman, *supra* note 13, at 1190; Asay, *supra* note 9, at 76–77 (empirical evidence on some courts lumping the substantial similarity question together within the prong two).

46. *See infra* Part IV.



The circumstantial proof of substantial similarity in prong one never truly requires plaintiffs to raise the similarity to a substantial level, despite using the word “substantial” in some cases.<sup>47</sup> Instead, the substantial similarity in prong one can be proven by some similarities between the two works that suggest copying.<sup>48</sup> In other words, the role of prong one’s substantial similarity is merely *probative*, allowing courts to infer copying from certain similarities along with other circumstantial evidence (particularly access).<sup>49</sup> It would be more proper to call it “probative similarity.”<sup>50</sup> Nevertheless, the substantial similarity of prong one can be quite striking in some scenarios, even rising to a level higher than substantial. Yet, no matter how substantial or striking, the similarity in prong one would not, on its own, resolve the infringement issue.<sup>51</sup> Its function is purely probative in that a higher level of similarity can ease the evidentiary burden of plaintiffs in offering other circumstantial evidence.<sup>52</sup>

The famous “inverse ratio rule” vividly demonstrates the probative value of prong one substantial similarity.<sup>53</sup> According to the rule, “the more compelling the similarities supporting an inference of copying, the less compelling the evidence of access need be.”<sup>54</sup> Striking or extensive similarity may even allow courts to dispense with proof of access altogether.<sup>55</sup> Conversely, the probative value of a lower level of similarity in proving actual copying can be compensated for by strong evidence of access, though similarity can never be dispensed even when there is striking evidence of access.<sup>56</sup> The rule recognizes the inversely proportional relationship between the probative values of substantial similarity and access in prong one, treating both as two points of inference on actual copying.<sup>57</sup>

Yet some courts’ conflation of substantial similarity in prongs one and two also causes them to misapply the inverse ratio rule.<sup>58</sup> They erroneously allowed “a lower level of improper misappropriation, the second infringement prong, upon a showing of greater proof of access.”<sup>59</sup> Put another way, they wrongfully applied the inverse ratio rule, which should only function in inferring actual copying in prong one, in deciding prong two. Such misapplication led to the Ninth Circuit rejecting the rule in its en banc opinion in *Skidmore v. Led Zeppelin*, which received applause from copyright scholars

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47. See Latman, *supra* note 13, at 1204; Y’Barbo, *supra* note 10, at 290.

48. Asay, *supra* note 9, at 44.

49. See, e.g., Latman, *supra* note 13, at 1204; Balganesch & Menell, *supra* note 9, at 306.

50. See generally Latman, *supra* note 13 (suggesting calling the substantial similarity in the prong one probative similarity).

51. Prong one only deals with the actual copying issue instead of the infringement issue. See *supra* text accompanying notes 10–12.

52. See, e.g., Latman, *supra* note 13, at 1204–05.

53. For a comprehensive understanding of the inverse ratio rule, see generally Balganesch & Menell, *supra* note 9.

54. *Rentmeester v. Nike, Inc.*, 883 F.3d 111, 1124 (9th Cir. 2018); see *id.* at 310.

55. Balganesch & Menell, *supra* note 9, at 319; Latman, *supra* note 13, at 1204; Loren & Reese, *supra* note 36, at 642.

56. See Balganesch & Menell, *supra* note 9, at 319, 332.

57. Loren & Reese, *supra* note 36, at 642.

58. See Balganesch & Menell, *supra* note 9, at 305–06.

59. *Id.* at 305.

and lawyers who share the same mistaken view of the rule.<sup>60</sup> Nonetheless, a correct and more precise understanding of the *Arnstein* test treats substantial similarity in prong two as a standalone issue, leaving no room for applying the inverse ratio rule.

Prong two deals with the question of whether the copying by defendants (proven by prong one) amounts to improper appropriation.<sup>61</sup> The copying should result in a work that shares substantial similarities with copyrighted work to become illicit copying; in other words, a work that includes more than a *de minimis* amount of copyrightable expression.<sup>62</sup> Courts ask whether “a defendant’s copying is quantitatively and qualitatively ‘enough’ to be rendered actionable” under prong two’s substantial similarity requirement<sup>63</sup> and may examine whether the ordinary observer of the two works would consider the copying substantial enough to be wrongful.<sup>64</sup> Though the evidence on similarities can function twice in prongs one and two, prong two points to a distinct issue and entails differentiated criteria and requirements for the level of similarities. Thus, despite their intricate relationship, one should treat prong two as distinct from prong one for a more accurate understanding of the U.S. copyright infringement test.

### C. DELINEATING THE RELATIONSHIP: THE PROCEDURAL FUNCTIONS OF EACH PRONG

While it is critical to understand the substantive functions of each prong, for comparison purposes, having a basic knowledge of why *procedurally* the *Arnstein* test adopts the bifurcated test is equally pivotal. The reason is that the unique procedural need for the United States to adhere to the two-prong test may explain why China has adopted a seemingly similar yet essentially different test.<sup>65</sup> The widespread adoption of the two-prong test in U.S. courts can be attributed to the special jury system (compared to China) and the availability of the distinctive summary judgment in U.S. civil procedure.<sup>66</sup>

Examining the history of the *Arnstein* test, one can see Judge Frank’s procedural focus when formulating his opinions, with the substantive content attributed to the two prongs largely emerging as an ancillary outcome.<sup>67</sup> As a strong opponent to the

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60. See *id.* at 306.

61. See, e.g., Lim, *supra* note 9, at 601–02.

62. See *id.*; Lemley, *supra* note 10, at 720; Asay, *supra* note 9, at 45–46; Balganes, Manta, & Wilkinson-Ryan, *supra* note 4, at 272.

63. Balganes, *supra* note 5, at 216.

64. *Id.* at 217; The ordinary observer test is adopted by the Second Circuit, where the *Arnstein* test originates from. However, there are also different tests used to judge substantial similarity. See Asay, *supra* note 9, at 46–48, 79–86.

65. See *infra* Part IV.

66. For a history and deeper thoughts on why the *Arnstein* court created the two-prong test, see generally Balganes, *supra* note 9. The primary reason for Judge Frank to bifurcate the copyright infringement test is his desire to ensure the plaintiff obtained a jury trial in lieu of summary judgment. See Balganes, *supra* note 9, at 842–47.

67. See *id.* at 804–09, 839–42.

increasing trend of using summary judgment to resolve issues of facts, Judge Frank tried to require the lower court to only allow summary judgment in cases when there is the slightest doubt as to the facts; otherwise, the plaintiff deserves a jury trial.<sup>68</sup> He applied the same standard to copyright infringement and divided the issue of the slightest doubt, a factual question, into two prongs—a novel approach with little precedent.<sup>69</sup> For the actual copying prong, which is genuinely an issue of fact, Judge Frank allowed the use of expert witnesses and a dissection of the work for comparing similarities.<sup>70</sup> He should have stopped at the actual copying prong, as the trial court only dealt with whether the defendant truly copied the plaintiff's work.<sup>71</sup> However, Judge Frank was concerned that the trial court might use summary judgment to resolve the improper appropriation once the case was sent back. Therefore, he turned his attention to prong two.<sup>72</sup>

Prong two can be framed as a question of whether the ordinary observer or lay audience believes that enough of the parts “pleasing to [them]” have been taken (in other words, their impression about the impropriety of the appropriation).<sup>73</sup> Because the ordinary observer test concerns the reactions of lay observers, any expert testimony or dissection for comparison was deemed irrelevant to the determination.<sup>74</sup> In other words, applying the ordinary observer test, the court would not allow a component-by-component comparison but instead assess the overall similarity between the two works to determine prong two.<sup>75</sup> As the second part of the copyright infringement test, prong two can determine the merits of the case, which was why Judge Frank construed it as an issue of fact for the jury to decide.<sup>76</sup> However, he disregarded the fact that substantial subjective and normative judgments are required when determining whether the copying amounts to an improper level.<sup>77</sup>

Judge Frank's (over)focus on procedural needs makes prong two a hotly debated and criticized part of the copyright infringement test. Several scholars have questioned the exclusion of expert witnesses and of comparison after dissection in prong two.<sup>78</sup> They have expressed worries about lay observers' unfamiliarity with several important copyright doctrines which divide unprotected elements with protectable expressions, such as the merger and *scènes à faire* doctrines.<sup>79</sup> Without expert evidence and proper dissection, the jury could easily form their overall impression on similarities based on

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68. See *id.* at 804.

69. See *id.* at 804, 842–44.

70. See *id.* at 804–05.

71. See *id.* at 806–07.

72. See *id.* at 807–08.

73. *Id.* at 807. See also Samuelson, *supra* note 7, at 1825.

74. Balganes, *supra* note 9, at 805; Balganes, *supra* note 5, at 217–18.

75. Balganes, *supra* note 5, at 217.

76. See Balganes, *supra* note 9, at 807–08, 844–47.

77. See *id.* at 807; Balganes, *supra* note 5, at 217; Lemley, *supra* note 10, at 737–38; Lim, *supra* note 9, at 606–07 (arguing that every case becomes a decision maker's value judgment).

78. See, e.g., Lemley, *supra* note 10, at 737–40; Samuelson, *supra* note 7, at 1826–27.

79. See Lemley, *supra* note 10, at 737–39; Samuelson, *supra* note 7, at 1826–27. See generally Manta, *supra* note 13, at 1335–36 (arguing that the test leads to inconsistent and unclear jury instructions).

unprotected elements, which should not be the basis for a finding of copyright infringement.<sup>80</sup> Other scholars have voiced concerns that jurors may easily allow a determination of actual copying to spill over to a finding of substantial similarity, making prong two easier to satisfy.<sup>81</sup> A lay jury is more likely to lump together the act of copying and the impropriety of the act.<sup>82</sup> Controversies on the bifurcated test in U.S. copyright law endure.

In this way, the two-prong test in U.S. copyright law originated from Judge Frank's desire to have copyright infringement decided by a jury rather than a court (on summary judgment).<sup>83</sup> The *Arnstein* court did not rationalize the division between actual copying and improper appropriation well, nor the substantive content of each prong, resulting in intense criticism from scholars and inconsistent application and interpretation by other courts.<sup>84</sup> Understanding the U.S. two-prong test and its procedural considerations can enlighten our positive and empirical explorations of the Chinese test in the next section, which uses seemingly similar terminology.

## II. POSITIVE AND EMPIRICAL ACCOUNTS: CHINA'S SEEMINGLY SIMILAR TEST

### A. CHINESE TEST ON THE BOOKS

Neither the PRC Copyright Act nor judicial interpretations and administrative regulations offer any guidance on determining copyright infringement.<sup>85</sup> Such a determination largely depends on the courts' discretion in approaching the issue—with no guarantee of uniform determinations. However, despite some cross-court divergences,<sup>86</sup> Chinese courts generally have adopted a facially similar version of substantial similarity plus access in deciding copyright cases.<sup>87</sup> Due to limited primary sources, it is not feasible to pinpoint when Chinese courts started to use the test and where they transplanted it from or, much more unlikely though possible, how and when they developed it from scratch. Anecdotal evidence shows that Chinese courts have applied the test at least since 2010, when the Guangzhou Intermediate Court decided one of the top ten IP cases that year (as designated by the Supreme People's

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80. See Lemley, *supra* note 10, at 737–39; Samuelson, *supra* note 7, at 1826–27.

81. See Manta, *supra* note 13, at 1339–41; Samuelson, *supra* note 7, at 1826.

82. Manta, *supra* note 13, at 1341.

83. Balganes, *supra* note 9, at 846.

84. For how different courts differ from each other even though they more or less adopt the similar bifurcated test, see Asay, *supra* note 9, at 75–89.

85. No provision in the PRC Copyright Act, the 2020 SPC Judicial Interpretation on the Copyright Act, or the Regulations on the Protection of Computer Software ever touches on the test for determining copyright infringement. Some argue that, in China, the determination of copyright infringement should follow the standard elements for torts. See generally, Zhang & Zhang, *supra* note 4.

86. See *infra* Part II.B for empirical results.

87. See sources cited, *supra* note 16.

Court (“SPC”).<sup>88</sup> In a case comment on another case in 2010, one of the judges explicitly referred to substantial similarity plus access as the basic rule for judging copyright infringement in Chinese judicial practice.<sup>89</sup>

On the surface, the Chinese appear to follow a two-prong test consisting primarily of access and substantial similarity.<sup>90</sup> To sustain the copyright infringement, the plaintiff should offer evidence to prove that the defendant has access to the copyrighted work. However, actual access to the work is not required; per common court practice, evidence of the possibility of access to the work or potential contact with the work will suffice.<sup>91</sup> In other words, plaintiffs can relatively easily dispense with the burden of proof under the access prong by showing that the defendants have chances to access the copyrighted work.<sup>92</sup> It allows courts to infer the existence of actual access to—or contact with—the work through a mere possibility of access, substantially alleviating the burden of proof for plaintiffs.<sup>93</sup> The overly low threshold for access in China receives harsh criticism from some scholars who argue for paying more attention to the access issue rather than treating it as an insignificant and subsidiary prong compared to substantial similarity.<sup>94</sup>

Substantial similarity is a more hotly discussed prong in the Chinese test because it serves a pivotal gatekeeping function.<sup>95</sup> Plaintiffs must prove substantial similarities between the copyrighted work and the defendant’s work to sustain an infringement claim, which again seems akin to prong two of the U.S. test.<sup>96</sup> Indeed, the primary approaches Chinese courts use to judge the substantial similarity between works,

88. See *Guangzhou Shi Ka Shi Tu Zhi Yi Youxian Gongsi v. Guangzhou Shi Jie Hui Fuzhuang Youxian Gongsi, Zhu Moumou* (广州市喀什图制衣有限公司诉广州市杰晖服装有限公司、朱某某侵犯著作权纠纷案) [Copyright Infringement Dispute Between Guangzhou Kashitu Garment Co., Ltd., Guangzhou Jiehui Garment Co., Ltd., and Zhu Moumou], 知产宝 [Intell. Prop. House] (Guangzhou Intermediate People’s Ct., 2010) (China). One of the three judges, Wenbing Zhu, a JSD candidate at City University of Hong Kong School of Law, claimed the case as the first one in China explicitly adopting the “Substantial Similarity” plus “Access” test in copyright infringement cases.

89. Jianjun Zhu (祝建军), *Pan Ding Qin Fan Zuo Quan Gui Ze De Fa Lu Shi Yong—Shen Zhen Zhong Yuan Pan Jue Da Zu Ji Guang Gong Si Su Ao Hua Ji Guang Gong Si Qin Fan Zuo Quan Jiu Fen An* (判定侵犯著作权规则的法律适用—深圳中院判决大族激光公司诉奥华激光公司侵犯著作权纠纷案) [Legal Application of the Rule for Determining Copyright Infringement—Judgment of Shenzhen Intermediate Court on the Copyright Dispute Case Between Dazu Laser Company and Aohua Laser Company], 6 REN MIN FA YUAN BAO [PEOPLE’S COURT DAILY] (2011).

90. See, e.g., Zhou, *supra* note 21, at 108–10; Xiong Qi (熊琦), *Jiechu + Shizhixing Xiangsi Shi Banquan Qinquan Rending De “Shenqi” Ma?* (接触+实质性相似是版权侵权认定的“神器”吗?) [Is “Access + Substantial Similarity” a “Magic Weapon” for Copyright Infringement Determination?], 10 ZHONGGUO ZHISHI CHANQUAN BAO [CHINA INTEL. PROP. NEWS] (2017); Zhang & Zhang, *supra* note 4, at 41; Liang, *supra* note 19, at 38.

91. See Ding, *supra* note 21, at 26; Liu, *supra* note 16, at 78–80.

92. See *Yu Zheng Yu Dongyang Xing Rui Yingshi Wenhua Chuanmei YouXian Gongsi* (余征与东阳星瑞影视文化传媒有限公司) [Yu Zheng v. Dongyang Xingrui Film and Television Culture Media Co., Ltd.] (Beijing High People’s Ct. 2015); Ding, *supra* note 21, at 26.

93. Ding, *supra* note 21, at 28; Zhou, *supra* note 21, at 112.

94. See Liu, *supra* note 16, at 74–78.

95. See, e.g., Liu, *supra* note 16, at 71–72; Ding, *supra* note 21, at 24. In the U.S., there is also more attention drawn to the substantial similarity prong. See Balganesch & Menell, *supra* note 9, at 303.

96. See text accompanying *supra* notes 61–64.

namely comparison after dissection or the abstraction-filtration-comparison, come from U.S. law.<sup>97</sup> However, the intended function of the substantial similarity prong in the Chinese context remains unspecified, unlike prong two of the U.S. test, which is designed to exclude trivial copying and other instances of copying that do not reach the threshold of impropriety.<sup>98</sup> Some Chinese judges have hinted in case comments that the substantial similarity prong aims to test whether the defendant's work is original enough to receive standalone copyright protection.<sup>99</sup> Still, one may argue that the Chinese substantial similarity prong serves a similar function to the U.S. improper appropriation prong because they share similar approaches for determination.<sup>100</sup>

Despite the apparent and striking similarities to the U.S. test—particularly in employing a two-prong approach and utilizing identical terminology—distinct substantive and procedural differences emerge, as discussed later in Part III.<sup>101</sup> These differences raise the question of whether the divergent test adopted in China, despite the spillover from the U.S.,<sup>102</sup> is adequate with careful local adjustment, or if China should directly transplant the entire test from the U.S. to achieve the desired results. Before addressing these critical questions, the next section illustrates how Chinese courts have applied the test in practice, thereby elucidating its practical application to enhance the subsequent comparison.

## B. THE CHINESE TEST IN PRACTICE: AN EMPIRICAL STUDY

No prior empirical work explores how the Chinese courts approach the copyright infringement issue concerning the substantial similarity plus access test. Therefore, this Article offers insight into how the two-prong test works in China to provide a more accurate comparison with the U.S. test. To be more precise, this section explores and tests the following questions to facilitate comparison: First, what approach(es) do Chinese courts take in terms of deciding the “access” prong? Specifically, what types of evidence are considered to establish the existence of access, and what functions does the access prong serve in the copyright infringement analysis? Second, how do Chinese courts determine “substantial similarity,” and how do these methods compare to those used in the U.S.? Additionally, what role does the substantial similarity prong serve in terms of copyright infringement analysis in China? Third, and equally important, what

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97. Lu, *supra* note 21, at 138–40; Liang, *supra* note 19, at 38–41; Haoning Feng (冯颢宁), *Lun Ban Quan Fa Zhong Shi Zhi Xiang Si Ren Ding Biao Zhun De Xuan Ze* (论版权法中实质性相似认定标准的选择) [On the Choice of Substantial Similarity Determination Standard in Copyright Law], 6 ZHONG GUO BAN QUAN [CHINA COPYRIGHT] 77, 77–78 (2016) (arguing that the tests used to judge substantial similarity originate from the U.S.).

98. See *supra* notes 61–64 and accompanying text.

99. See Guoquan Li (李国泉), Zhongliang Shou (寿仲良), and Wentao Dong (董文涛), *Shi Zhi Xiang Si Jia Jie Chu De Qin Quan Biao Zhun Pan Ding* (实质性相似加接触的侵权标准判断) [Judgment of Infringement Standard for Substantial Similarity Plus Access], 16 REN MIN SI FA [PEOPLE'S JUDICIARY] 37, 38 (2010). Some scholars in China also adopt the same viewpoint. See Zhang & Zhang, *supra* note 4, at 42–43.

100. See, e.g., Wu, *supra* note 19, at 67–68. For a more detailed comparison, see *infra* Part III.

101. See *infra* Part III.

102. See *infra* notes 141–144 and accompanying text.

is the relationship between the access prong and the substantial similarity prong in China?

## 1. Study Design and Data Collection

This Article created an original dataset for this study. The data (coding results drawn from judgments decided by Chinese courts) comes from Wolters Kluwer (“WK”), one of the most widely used commercial legal databases in China.<sup>103</sup> The study used WK rather than China Judgments Online (“CJO”), the unified official judicial documents publication database maintained by the SPC, for three reasons. First, the CJO remains one of the primary sources from which WK would collect data on Chinese judgments. Therefore, WK includes most judgments available on the CJO, updating judgments published by all levels of Chinese courts on a daily basis.<sup>104</sup> Second, WK obtains additional judgments from other sources, such as important cases published in printed journals, making its database even more comprehensive than the CJO.<sup>105</sup> Third, WK is more convenient than the CJO for searching for judgments, making it a popular choice for empirical studies in China.<sup>106</sup>

To search for Chinese judgments in the WK database that apply substantial similarity plus access, we used the search function named “search in the whole

103. See WOLTERS KLUWER, [https://law.wkinfo.com.cn/?tip=\[https://perma.cc/LQ86-8UP6\]\[https://web.archive.org/web/20241118022505/https://law.wkinfo.com.cn/?tip=\]](https://law.wkinfo.com.cn/?tip=[https://perma.cc/LQ86-8UP6][https://web.archive.org/web/20241118022505/https://law.wkinfo.com.cn/?tip=]) (last visited Oct. 25, 2024). For an introduction to and comparison between different commercial legal databases available in China, see Sun Yudi (孙玉娣), *Zhongwen Falü Zhuanye Shujuku Bijiao Fenxi—Yi Beida Fabao, Wei ke Xianxing, Wanlü Zhongguo, Lü Shang Lianxun Wei Li* (中文法律专业数据库比较分析——以北大法宝、威科先行、万律中国、律商联讯为例) [Comparative Analysis of Chinese Legal Professional Databases—Taking PKULAW, Westlaw China, LawInfoChina, and LexisNexis China as Examples], Falü Xinxi Yanjiu Wang [Legal Information Studies Network], <http://www.chinalawlib.org.cn/LunwenShow.aspx?CID=20081224141343797149&AID=20180528171907303354&FID=20081224141110233122> [https://web.archive.org/web/20180919041320/http://chinalawlib.org.cn/LunwenShow.aspx?CID=20081224141343797149&AID=20180528171907303354&FID=20081224141110233122] (last visited Nov. 17, 2024).

104. See page 13 of the Wolters Kluwer user guide of the legal database, available at <https://law.wkinfo.com.cn/help/mobile/index.html> [https://perma.cc/ZQ77-XC7J] (last visited Oct. 21, 2024).

105. Lecture slides introducing the Wolters Kluwer database mention that it would collect additional judgments in addition to ones published on official websites. See <http://lib.uibe.edu.cn/docs/2018-11/20181107170711627624.pptx> [https://perma.cc/G462-GSYP] (last visited Oct. 11, 2024).

106. Quite a few studies in China use Wolters Kluwer as the database for conducting empirical studies. See, e.g., Yi Ling (易玲) & Shi Aosheng (石傲胜), *Feiwuzhi Wenhua Yichan Shangbiao Zhuze Yu Shiyong: Zhidu Jili, Xianshi Kunjing Ji Guifan Lujing* (非物质文化遗产商标注册与使用：制度机理、现实困境及规范路径) [Trademark Registration and Use of Intangible Cultural Heritage: Institutional Mechanisms, Practical Dilemmas, and Regulatory Pathways], 12 ZHISHI CHANQUAN (知识产权) [INTELL. PROP.] 89, 90 (2023); Du Wen (杜闻), *Woguo Minshi Xianzhi Ziren de Hanyi, Leixing Ji Shiyong—Yi 24 Pian Caipan Wenshu Wei Shijiao* (我国民事限制自认的含义、类型及适用——以 24 篇裁判文书为视角) [The Meaning, Types, and Application of Civil Limitations on Self-Recognition in China—From the Perspective of 24 Judicial Decisions], 28 ZHENGJU KEXUE (证据科学) [EVIDENCE SCI.] 100, 103–104 (2020); Han Kangqi (韩康麒) & Ding Junfeng (丁俊峰), *Biaoxian Dai’li Zhong Beidailiren Ke Guizexing de Shizheng Yanjiu* (表现代理中被代理人可归责性的实证研究) [An Empirical Study on the Attributability of the Principal in Ostensible Agency], 17 FALV SHIYONG (法律适用) [L. APP.] 114, 115–17 (2018).

judgment.” Two groups of search terms—two Chinese expressions for “substantial similarity” plus “access”—were used.<sup>107</sup> The search terms and the search function captured all judgments in the database that contain the terms “substantial similarity” and “access.” We then limited the results to copyright infringement cases because other non-copyright cases might have included those two terms in an unrelated context.

The search time frame was limited to 2014–2021. We did not collect cases from 2022 and 2023 for two reasons. First, Chinese courts stopped publishing many of their judgments online in 2022 for unknown reasons.<sup>108</sup> Second, some cases may not have been published due to the potential delay between decision and publication.<sup>109</sup> However, the study collected a sufficient number of cases to unpack how the test works in Chinese courts.

Notwithstanding those search caveats, the initial search returned over 4,000 copyright judgments. In selecting samples for coding, this study primarily used the judgmental sampling method while drawing some insights from probability proportional to size (“PPS”) sampling.<sup>110</sup> The judgmental sampling method was used because not every judgment that applied the two-prong test provided the court’s reasoning for its application. Several judgments merely mentioned the two-prong test without providing any reasoning. Thus, we disregarded those judgments and chose the ones with some reasoning; otherwise, the dataset would not have been able to enlighten us on the application of the test in practice. We also considered the main insights from PPS by selecting the judgments for each year, each province, and each court level.<sup>111</sup> PPS aims to maintain the proportionality of the number of cases sampled from each year, each province, and each court level to the proportion of cases they represent in the overall population. Under these selection criteria, we chose approximately 30% of the judgments from the total pool for further analysis, resulting in a sample of 1,401

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107. (1) “实质性相似” + “接触”; (2) “实质相似” + “接触”.

108. Despite recent public outrage, the Supreme People’s Court has assured the public through an official announcement that judgments from all levels of courts will continue to be published. See *Zuigaofa: Jiada Caipan Wenshu Shangwang Lidu* (最高法: 加大裁判文书上网力度) [Supreme Court: Increase Efforts to Publish Judicial Documents Online], XINHUA SHE (新华社) [XINHUA NET] (Jan. 14, 2024), <http://www.news.cn/20240114/7697db95b07d4463a18c2a643485b549/c.html> [https://perma.cc/W27G-N9A7]

[https://web.archive.org/web/20240115101350/http://www.news.cn/20240114/7697db95b07d4463a18c2a643485b549/c.html].

109. Yang Chen, *Demystifying China’s Trade Secrets Law in Action—A Statistical Analysis*, 13 QUEEN MARY J. INTELL. PROP. 198, 205 (2023).

110. See generally, Chris J. Skinner, *Probability Proportional to Size (PPS) Sampling*, WILEY STATSREF: STATISTICS REFERENCE ONLINE 1, 1–5 (2014); Hamed Taherdoost, *Sampling Methods in Research Methodology: How To Choose a Sampling Technique for Research*, 5 INT’L J. ACAD. RSCH. MGMT. 18, 23 (2016).

111. For example, consider a dataset comprising 4,000 total judgments, distributed annually as follows: 100 in 2014, 200 in 2015, 300 in 2016, 400 in 2017, 500 in 2018, 600 in 2019, 700 in 2020, and 1,200 in 2021. If the study aims to select a sample of 30% from these results, the number of judgments sampled each year would be approximately 30% of that year’s total (e.g., 90 from 2016, 150 from 2018, 200 from 2019, etc.). This proportional selection approach is also applied to judgments from different provinces and court levels within each year.



judgments.<sup>112</sup> This sample included representative decisions, encompassing various reasoning, from each court level across all provinces between 2014 and 2021.

Each judgment in the sample was hand-coded for basic case information, including court level, province, decision year, proceeding, and type of copyrighted work.<sup>113</sup> Substantive coding criteria primarily included: (1) the court's reasoning on access; (2) doctrines adopted by the court in dissecting the work; (3) the court's reasoning on judging substantial similarities; (4) whether evidence from expert witnesses was used to judge substantial similarities; (5) the court's reasoning on the inverse ratio rule, if any; (6) the court's reasoning on independent development, if any; and (7) the phases in which the court addressed those issues.<sup>114</sup> Those coding criteria enabled our understanding of how Chinese courts have applied the two-prong test in practice.

## 2. Limitations

There are three limitations in our study design. First, we did not use a random sampling method, making the results of our study difficult to generalize. This sampling limitation is justified because our main aim is to unpack the reasoning of Chinese courts in applying the two-prong test. Thus, the selection of judgments with some minimal reasoning is necessary. Even though we cannot use any statistical inference to generalize, the sample size of our study is still large enough to offer valuable insights into how various court levels in different provinces have approached the copyright infringement issue. Second, there can be a source of error arising from hand-coding, which happens when the coding criteria are “ambiguous or include room for subjectivity,” potentially causing “inconsistent application and negatively impact[ing] reproducibility.”<sup>115</sup> We partially addressed these concerns by requiring coders to follow written coding instructions and highlight any ambiguous scenarios for internal discussion and confirmation.<sup>116</sup> Third, no database is perfect; it is very likely that some or many court decisions that include reasoning about the two-prong test are not

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112. The final number of judgments coded is 1,401. Although the target sample proportion is 30%, the actual number of samples exceeds this target. This discrepancy arises because, in instances where the calculated sample size for a specific court level within a province for a given year is less than 1, the study opts to include at least one judgment. This approach ensures that the dataset captures the reasoning or application methods utilized by that court level in that province. Consequently, the aggregate sample size surpasses the 30% threshold.

113. Two research assistants (“RAs”) were responsible for the hand-coding, which they did according to a pre-designed coding scheme with detailed instructions on each coding criteria. *See infra* Appendix A.

114. *See infra* Appendix A.

115. *See* Camilla Alexandra Hrdy & Christopher B. Seaman, *Beyond Trade Secrecy: Confidentiality Agreements that Act Like Noncompetes*, 133 YALE L.J. 669, 733 (2024).

116. The coders, two law school students with prior knowledge of copyright law, were assigned classical articles on the copyright infringement test in the U.S. and China before coding. They also contributed to selecting and creating the coding criteria. During the coding process, they were required to flag any court reasoning deemed too ambiguous for coding, for discussion in weekly meetings. These discussions ensured that each RA knew with relative precision how to code similar situations in subsequent judgments.

published or available in the WK database.<sup>117</sup> The reasons can be numerous.<sup>118</sup> However, we maintain that our sample size is large enough to offer valuable information as long as we bear in mind the inherent limitations of our dataset when interpreting the results.

### 3. Results

#### a. General results

The dataset shows a roughly linear growth trend in decision numbers by year, except for 2021, as presented in Figure 1. The numbers generally followed an upward linear trend between 2014 and 2020 and peaked in 2020. The year 2021, however, witnessed a sharp decrease in decision numbers, deviating from the linear trend, for reasons probably related to the pandemic and the delay between judgment decision and publication identified by previous studies.<sup>119</sup> Unsurprisingly, there are more copyright judgments on the substantial similarity plus access test in relatively more developed provinces or cities, with around 43% in Guangdong, 12% in Beijing and Zhejiang, 6% in Shanghai, 4% in Fujian, and 3% in Hunan and Jiangsu provinces.<sup>120</sup> The finding is similar to that from other empirical studies conducted on IP cases.<sup>121</sup> Figure 2 presents the judgment numbers by province/city.

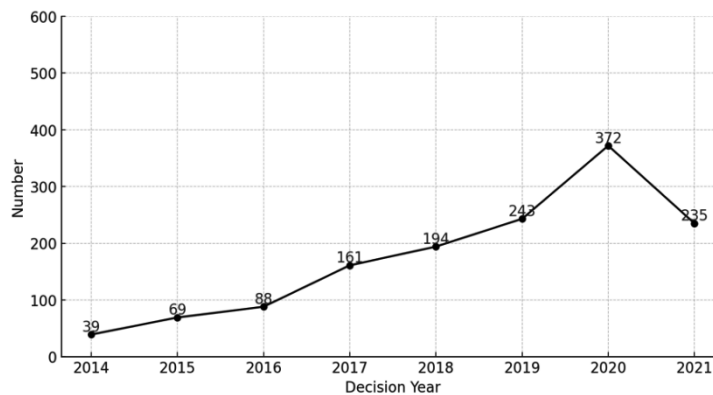


Figure 1: Judgment Numbers by Year

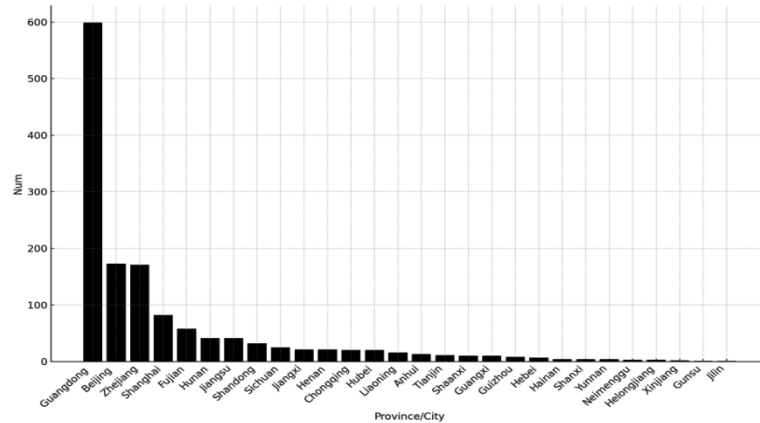
117. See Chen, *supra* note 109, at 205.

118. For limits of judgment publications in China, see *id.*

119. See *id.* at 207.

120. Guangdong (599); Beijing (173); Zhejiang (171); Shanghai (82); Fujian (58%); Hunan (41); Jiangsu (41).

121. See, e.g., Chen, *supra* note 109, at 208 (The five provinces or cities where there are relatively more trade secrets cases are Guangdong, Beijing, Shanghai, Zhejiang, and Jiangsu.).



**Figure 2: Judgment Numbers by Province/City**

We see a significant number of judgments coming from intermediate courts (around 33%) and, unsurprisingly, primary courts (more than 50%). Yet the dataset also includes nearly thirty judgments from the SPC, which is influential in setting guidance for lower courts in applying the test. Of the judgments we studied, 66% were first-instance judgments, and 32% were appeal judgments, with retrial judgments only accounting for 2%, which generally conforms with the normal distribution of judgments across court levels and proceedings. Figure 3 illustrates the judgment numbers by court level and proceedings.

The results drawn from the types of copyrighted works are more surprising. Initially, the study expected to see literary works more frequently occurring in cases. Yet artistic works represent a majority (64.5%) of the judgments in the dataset, substantially larger than literary works (12.6%). Other copyrighted works appearing in more than 5% of judgments are photographic works (10.1%) and computer software (6.6%). Figure 4 presents the judgment numbers by work type. The overrepresentation of artistic works in the dataset reminds us that, when interpreting the substantial results below and when appropriate, the study may analyze the results per work type if courts adopt different approaches according to the work type.

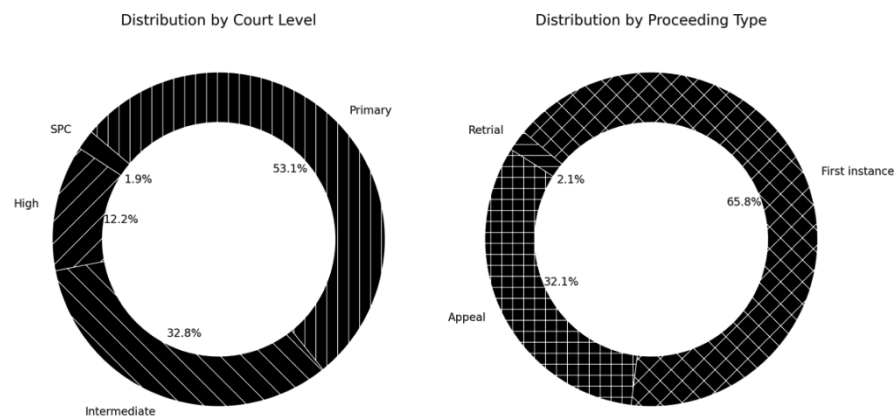


Figure 3: Judgment Numbers by Court Level and Proceeding Type

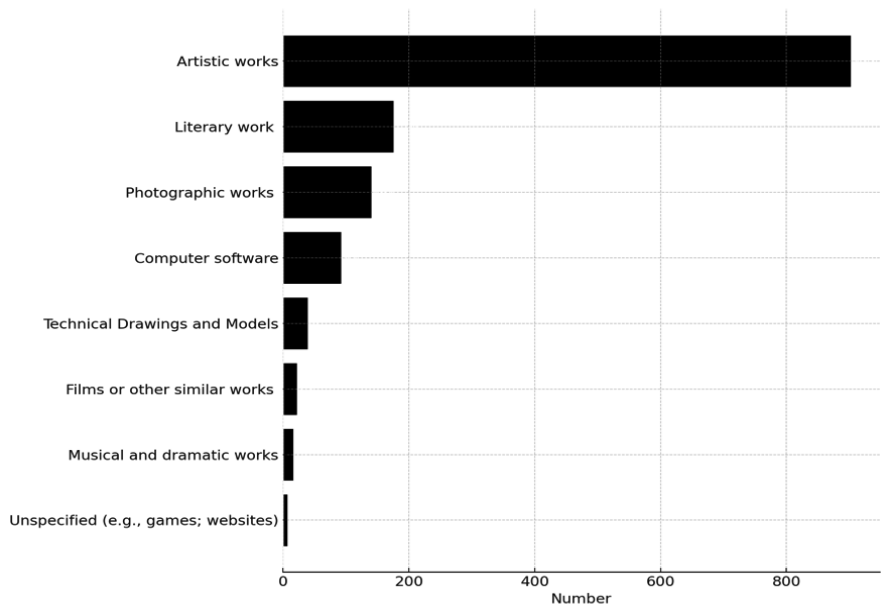
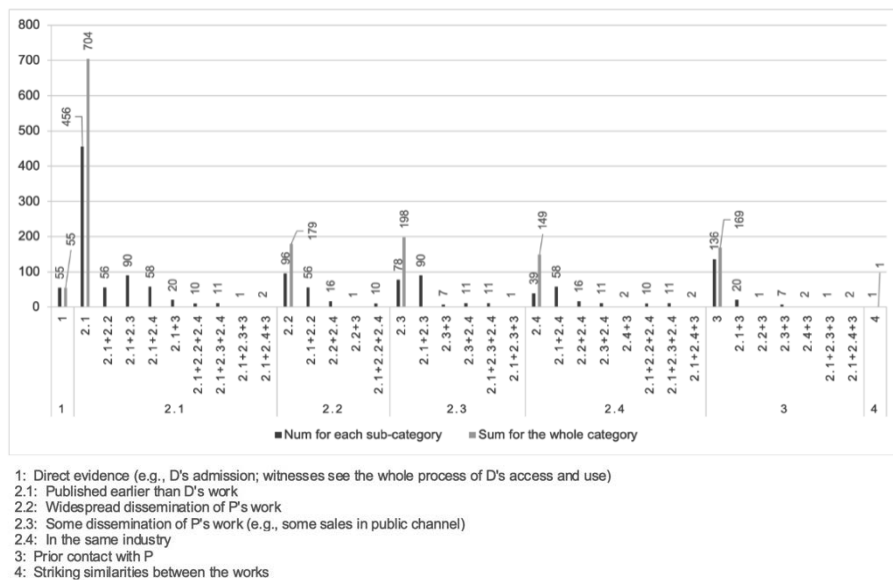


Figure 4: Judgment Numbers by Work Type

*b. Access Prong*

Of the 1,401 coded judgments in which the substantial similarity plus access test is explicitly mentioned, courts decided the access prong in 1,230 judgments and found that the access prong is fulfilled in 93% of judgments.<sup>122</sup> The high success rate is understandable given the very low threshold for the access prong required by Chinese courts, as pointed out in the current literature<sup>123</sup> and our empirical data. For those decisions where courts offer at least some reasoning on how to approach the access prong, the study further coded the specific reasons courts found or rejected the existence of access to the copyrighted work. The codes include seven types of evidence that either directly or, in some ways, indirectly prove access. Example circumstantial proofs coded include the fact that the copyrighted work has an earlier publication date (denoted as 2.1), dissemination of the copyrighted work (2.2 or 2.3, depending on how wide the dissemination was), the fact that both litigating parties were in the same industry (2.4), and prior dealings and relationships between litigating parties (3). Figure 5 depicts the details of evidence the courts accepted for establishing access.



**Figure 5: Evidence for Access Prong**

The low threshold for fulfilling the access prong is well delineated by the empirical data in this study. First, conforming with conventional wisdom, our data shows that

122. The access prong is satisfied in 1,146 decisions and failed in 84 decisions.

123. See *supra* notes 91–94 and accompanying text.

direct evidence of access is usually absent because direct evidence is cited in less than 5% of decisions where courts considered the access prong as satisfied (hereinafter “access decisions”). Chinese courts thus relied mainly upon circumstantial evidence to reach the ruling. However, in nearly 40% of cases, the court would rubber stamp the access prong as long as the plaintiff’s work was published earlier than the defendant’s alleged infringing work. In approximately 20% of access decisions, plaintiffs could fulfill their burden of proof by offering evidence of at least some dissemination (or wide dissemination) of their work in the public or that both parties were in the same industry. Some courts (representing around 20% of access decisions) would combine the aforementioned circumstantial evidence to draw an inference (e.g., combine evidence on earlier publication plus some spreading of the work in the public and/or situating in the same industry). Yet the combined approach still represents a low bar for proving access because it can be practically effortless for plaintiffs to offer evidence on each. A limited number of more discerning courts factored in one type of relatively convincing circumstantial evidence: defendants’ prior actual contact or dealing with plaintiffs, which, by intuition, can make the inference on the existence of prior access to plaintiffs’ works more reasonable. The percentage of those more satisfactory decisions is low (less than 15% of access decisions).

While Chinese courts usually dedicate some space, though notoriously limited, to what evidence they factored into access, they barely mention what function access would serve in copyright infringement.<sup>124</sup> They seem to list the evidence they considered and then start opining on the substantial similarity prong, leaving readers wondering about the purpose of proving access. This approach differs from the U.S. test, as discussed in Part III.<sup>125</sup>

*c. Substantial Similarity Prong*

Unlike the access prong, the substantial similarity prong enjoys much more attention from Chinese courts, as confirmed by our study and according to the conventional account in the current literature.<sup>126</sup> While U.S. courts generally follow specific approaches to determine substantial similarity or improper misappropriation, and many would specify the standard they used,<sup>127</sup> Chinese courts rarely speak about

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124. This impression was drawn by RAs based on their reading of the judgments during the coding process.

125. See *infra* Part III.

126. See, e.g., Liu, *supra* note 16, at 71–72; Ding, *supra* note 21, at 24. The impression on the relatively more detailed reasoning in the substantial similarity prong was drawn by RAs based on their reading of the judgments during the coding process.

127. It is admitted that there are some divergences in which approach U.S. courts choose to judge substantial similarity, and the number of distinct approaches is not low. Yet since there are still some common approaches taken by the courts, and U.S. judges more frequently tell readers what standard they adopt for their determinations, it is much easier to code these approaches in the U.S. empirical studies as compared to Chinese studies. For the relevant U.S. empirical studies, see Asay, *supra* note 9, at 79–89; Lim, *supra* note 9, at 622–23.

the approach or standard they would adopt in assessing substantial similarity.<sup>128</sup> Therefore, it would be more difficult to code the approaches taken by Chinese courts in the studied decisions.

Despite the ambiguity articulated in the current literature and reflected in the interim results of the test coding process, the study found that Chinese courts roughly follow the “total concept and feel approach” or “comparison after dissection” method to measure substantial similarity.<sup>129</sup> Accordingly, the study coded the two methods when they appeared in decisions. In several decisions, the study found that courts would engage in some form of quantitative analysis to see whether the defendants took a portion of copyrighted work that is quantitatively significant. As such, the study coded the decision as “quantitative” when it involved some form of quantitative analysis. For others where neither quantitative analysis nor the first two methods appeared, the study denoted them as “Not specified (some form of qualitative approach).”

It must be admitted that, in addition to decisions with too-limited reasoning to code any meaningful information, some courts still engage in comparisons centering on whether the defendants took qualitatively significant parts of the plaintiffs’ work.<sup>130</sup>

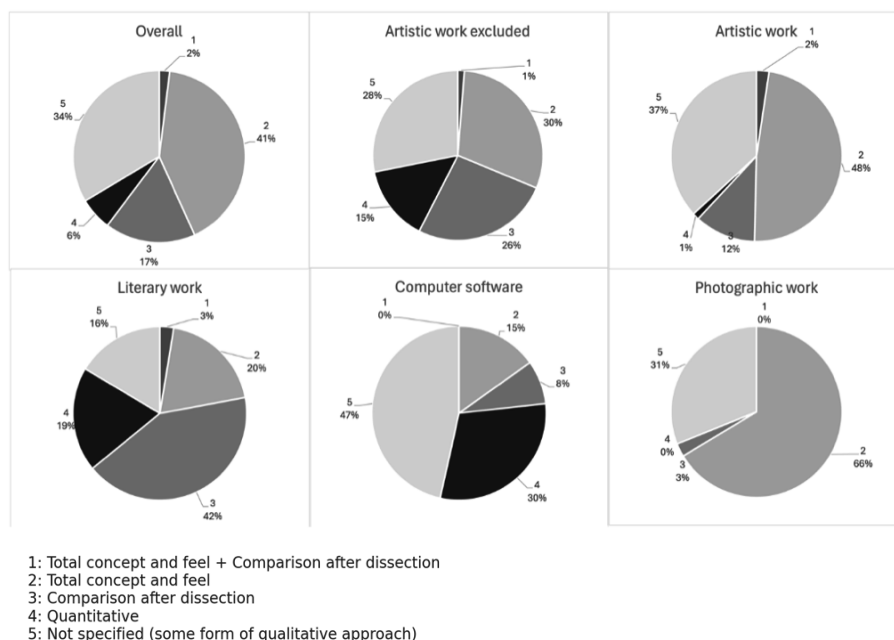
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128. This impression was drawn by RAs based on their reading of the judgments during the coding process.

129. The “total concept and feel” approach involves courts directly comparing the overall appearance of the works in question to determine whether there is substantial similarity. In contrast, the “comparison after dissection” method requires courts to first dissect the works, focusing solely on the copyrightable elements for comparison. *See, e.g.*, Feng, *supra* note 97, at 77–78; Lu, *supra* note 21, at 138–39.

130. *See, e.g.*, Zhongshanshi Anyiyuan Fushi Youxian Gongsi, Zhushi Huishe Yiwu Suoyou Deng Qinhai Zuopin Fuzhiquan Jiufen Minshi Shenqing Zaishen Shenchu Minshi Caidingshu (中山市安逸猴服饰有限公司、株式会社一无所有等侵害作品复制权纠纷民事申请再审查民事裁定书) [Anyiyuan Clothing Co., Ltd. v. Nowhere Co., Ltd. et al.], Zhongguo Caipan Wenshuwang (中国裁判文书网) [China Judgements Online] (Sup. People’s Ct., June 29, 2021); Dongguanshi Changan Miluo Wujin Jiagongchang Yu Shenzhenshi Tianyifang Jingpin Zhizao Youxian Gongsi Zhuzuoquan Quanshu, Qinquan Jiufen Yian Minshi Ershen Panjueshu (东莞市长安米罗五金加工厂与深圳市天一坊精品制造有限公司著作权权属、侵权纠纷一案民事二审判决书) [Dongguan Changan Miluo Hardware Processing Factory v. Shenzhen Tianyifang Boutique Mfg. Co., Ltd.], Zhongguo Caipan Wenshuwang (中国裁判文书网) [China Judgements Online] (Guangdong Dongguan Intermediate People’s Ct., July 24, 2020); Honglian Guoji Maoyi Youxian Gongsi Yu Shanghai Leifeng Dianqi Youxian Gongsi Zhuzuoquan Quanshu, Qinquan Jiufen Minshi Yishen Anjian Minshi Panjueshu (宏联国际贸易有限公司与上海磊峰电器有限公司著作权权属、侵权纠纷民事一审案件民事判决书) [Grand Union Int’l Trading Co., Ltd. v. Shanghai Leifeng Elec. Co., Ltd.], Zhongguo Caipan Wenshuwang (中国裁判文书网) [China Judgements Online] (Shanghai Putuo Dist. People’s Ct. Dec. 30, 2021); Hunan Panzi Yu Suizhoushi Zengduqu Yufuren Hunsha Yinglou, Suizhoushi Jiading Wenhua Chuanmei Youxian Zeren Gongsi Zhuzuoquan Quanshu, Qinquan Jiufen Yishen Minshi Panjueshu (湖南盘子与随州市曾都区余夫人婚纱影楼、随州市佳鼎文化传媒有限公司有限责任公司著作权权属、侵权纠纷一案民事判决书) [Hunan Panzi Culture Tech. Co., Ltd. v. Suizhou City Mrs. Yu Wedding Studio et al.], Zhongguo Caipan Wenshuwang (中国裁判文书网) [China Judgements Online] (Hunan Changsha Intermediate People’s Ct. Oct. 31, 2018); Huaqiang Fangte (Shenzhen) Dongman Youxian Gongsi Yu Fuzhoushi Cangshanqu Zhang Shoulin Bianlidian Zhuzuoquan Quanshu, Qinquan Jiufen Yishen Minshi Panjueshu (华强方特(深圳)动漫有限公司与福州市仓山区张寿林便利店店著作权权属、侵权纠纷一案民事判决书) [Huaqiang Fantawild (Shenzhen) Animation Co. Ltd v. Fuzhou Cangshan Dist. Zhang Shoulin Convenience Store], Zhongguo Caipan Wenshuwang (中国裁判文书网) [China Judgements Online] (Fujian Fuzhou Intermediate People’s Ct. Nov. 19, 2020); Gong Tianhua, Wuhan Diyier Keji Youxian Gongsi Zhuzuoquan Quanshu, Qinquan Jiufen Minshi Yishen Minshi Panjueshu (龚天华、武汉迪易尔科技有限公司著作权权属、侵权纠纷民事一审民事判决书) [Gong Tianhua v.

The typical reasoning behind that line of decisions is first identifying the most prominent features or parts of the copyrighted works and then deciding whether the two works are substantially similar.<sup>131</sup> Unfortunately, the courts did not clearly indicate whether they compared the overall appearance or the parts after dissection. Accordingly, it would be more rational to code them as a miscellaneous option for using some form of qualitative analysis. Otherwise, the risk of errors during the coding process would be too high as the determination would entail too many personal judgments. With these caveats in mind, Figure 6 details the approaches Chinese courts took to judging substantial similarity.



**Figure 6: Approaches for Judging Substantial Similarity**

Wuhan Diyier Tech. Co., Ltd.] Zhongguo Caipan Wenshuwang (中国裁判文书网) [China Judgements Online] (Hubei Wuhan Hanjiang Dist. People's Ct. Sept. 27, 2021).

131. See, e.g., Zhongshanshi Anyiyuan Fushi Youxian Gongsi, Zhushi Huishe Yiwu Suoyou Deng Qin Hai Zuopin Fuzhiquan Jiufen Minshi Shenqing Zaishen Shenchu Minshi Caidingshu (中山市安逸猴服饰有限公司、株式会社一无所有等侵害作品复制权纠纷民事申请再审审查民事裁定书) [Anyiyuan Clothing Co., Ltd. v. Nowhere Co., Ltd. et al.], Zhongguo Caipan Wenshuwang (中国裁判文书网) [China Judgements Online] (Sup. People's Ct., June 29, 2021).



Comparing the pie charts in Figure 6, Chinese courts prefer certain approaches depending on the type of copyrighted work. About half of the decisions on artistic works involve the court using the total concept and feel approach to judge substantial similarity, with comparison after dissection and quantitative approaches being much less popular (under 15% of decisions in total). The prevalence of the total concept and feel approach can also be seen in decisions on photographic works (more than two-thirds). In contrast, the total concept and feel approach is less popular among courts for judging substantial similarity for literary works and computer software. In cases concerning literary works, courts are more likely to adopt the comparison after dissection approach (about 45% of decisions) and engage in some quantitative analysis (around 20% of decisions). Interestingly, there are five decisions on literary works where courts expressly mentioned the abstraction-filtration-comparison test, which originated from the United States as the way to compare two works after dissection.<sup>132</sup> In decisions on computer software, courts feel more inclined to conduct quantitative evaluations (30% of decisions).

Despite the tendencies towards one or two approaches depending on the type of copyrighted work, the Chinese courts lack a uniform approach in judging substantial similarity. There are a number of decisions where the courts did not offer much reasoning on their approaches or simply made some comparisons without spelling out any approach (nearly 35% of decisions overall). This general finding is consistent with the uniformity issue identified in U.S. empirical studies; it also aligns with Chinese law, where there is no explicit reference to any particular approach in statutes, judicial interpretations, or judicial documents.<sup>133</sup>

132. See Hangzhou Youka Wangluo Jishu Youxian Gongsi Yu Guangzhou Changyou Xinxi Keji Youxian Gongsi, *Guangzhou Dayu Xinyi Keji Youxian Gongsi Deng Zhuzuoquan Quanshu*, Qinqian Jiufen Yishen Minshi Panjueshu (杭州游卡网络技术有限公司与广州常游信息科技有限公司、广州大娱信息科技有限公司等著作权权属、侵权纠纷一审民事判决书) [Hangzhou Youka Network Tech. Co., Ltd. v. Guangzhou Changyou Info. Tech. Co., Ltd. et al.] *Zhongguo Caipan Wenshuwang* (中国裁判文书网) [China Judgements Online] (Shanghai Pudong New Dist. People's Ct., Jan. 10, 2019); Wuhan Yawenhua Yishu Fazhan Youxian Gongsi, *Huang Qiansheng Yu Liu Ruoying, Ye Ruting Deng Zhuzuoquan Quanshu*, Qinqian Jiufen Yishen Minshi Panjueshu (武汉光亚文化艺术发展有限公司、黄乾生与刘若英、叶如婷等著作权权属、侵权纠纷一审民事判决书) [Wuhan Guangya Culture and Art Development Co., Ltd. v. Liu Ruoying et al.] *Zhongguo Caipan Wenshuwang* (中国裁判文书网) [China Judgements Online] (Hubei Wuhan Intermediate People's Ct., Oct. 25, 2019); Liu Jiajun, *Xian Qujiang Yaya Yingshi Wenhua Gufen Youxian Gongsi Deng Yu Ni Xueli Zhuzuoquan Quanshu*, Qinqian Jiufen Ershen Minshi Panjue Shu (刘嘉军、西安曲江丫丫影视文化股份有限公司等与倪学礼著作权权属、侵权纠纷二审民事判决书) [Xi'an Qujiang Yaya Screen Culture Co., Ltd. et al. v. Ni Xueli] *Zhongguo Caipan Wenshuwang* (中国裁判文书网) [China Judgements Online] (Beijing Intell. Prop. Ct., Dec. 14, 2017); Zhang Litao Yu Song Weiwei Deng Zhuzuoquan Quanshu, Qinqian Jiufen Yishen Minshi Panjueshu (张立涛与宋巍巍等著作权权属、侵权纠纷一审民事判决书) [Zhang Litao v. Song Weiwei et al.] *Zhongguo Caipan Wenshuwang* (中国裁判文书网) [China Judgements Online] (Beijing Xicheng Dist. People's Ct., Dec. 20, 2019); Dongyang Jinbaixing Yingshi Wenhua Chuanbo Youxian Gongsi Yu Ji Hua Deng Yishen Minshi Panjueshu (东阳金百星影视文化传播有限公司与季桦等一审民事判决书) [Dongyang Jinbaixing Film and Television Culture Comm'n Co., Ltd. v. Ji Hua et al.] *Zhongguo Caipan Wenshuwang* (中国裁判文书网) [China Judgements Online] (Beijing Haidian Dist. People's Ct., Dec. 31, 2020).

133. For the relevant US empirical studies, see Asay, *supra* note 9, at 79–89; Lim, *supra* note 9, at 622–23.

#### d. Other Results

In addition to coding the approaches for judging substantial similarity, the study documented whether the courts mentioned any dissection rules in their decisions (e.g., idea-expression dichotomy, functionality, *scènes à faire*, facts). Of 306 decisions, courts in more than half discussed one or more dissection doctrines before conducting an infringement analysis when they analyzed the originality requirement for plaintiffs' works.<sup>134</sup> Quite a number of courts (more than 40% of decisions) mentioned dissection doctrines shortly before or within their reasoning on substantial similarity to set the comparison base for the two works at issue.<sup>135</sup> A few cases (seven decisions) also discussed dissection doctrines only after analyzing substantial similarity and access because the defendants argued that only unprotected elements were copied, compelling the courts to address these arguments towards the end.<sup>136</sup>

For a better comparison with the U.S. test, it would also be valuable to explore in which phase Chinese courts discuss the possibility of independent creation. In the U.S. test, prong one deals with the independent development issue. In an influential decision, the SPC advised that the courts follow the sequence of substantial similarity-access-independent development defense in deciding copyright infringement cases.<sup>137</sup>

134. See, e.g., Dongyang Jinbaixing Yingshi Wenhua Chuanbo Youxian Gongsi Yu Ji Hua Deng Yishen Minshi Panjueshu (东阳金百星影视文化传播有限公司与季桦等一审民事判决书) [Dongyang Jinbaixing Film and Television Culture Comm'n Co., Ltd. v. Ji Hua et al.], 中国裁判文书网 [China Judgements Online] (Beijing Haidian Dist. People's Ct., Dec. 31, 2020) (China); Yin Yusheng Yu Huashan Wenyi Chuban She Youxian Zeren Gongsi, Bo Ku Shuzi Chuban Chuanmei Jituan Youxian Gongsi Zhuzuoquan Quan Shu, Qinquan Jiufen yishen Minshi Panjueshu (尹玉生与花山文艺出版社有限责任公司、博库数字出版传媒集团有限公司著作权权属、侵权纠纷一案一审民事判决书) [Yin Yusheng and Huashan Literature and Art Publ'g House Co., Ltd. v. Boku Digital Publ'g and Media Grp. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Hangzhou Railway Transport Ct., Nov. 6, 2020) (China); Cengzhaoyu, Quanzhou Yi Xiao Feng Maoyi Youxian Gongsi Zhuzuoquan QuN Shu, Qinquan Jiufen Ershen Minshi Panjueshu (曾招裕、泉州逸小风贸易有限公司著作权权属、侵权纠纷二审民事判决书) [Zeng Zhaoyu v. Quanzhou Yixiaofeng Trading Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Fujian High People's Ct., Aug. 31, 2020) (China).

135. See, e.g., Xigang Qu Kelan Shipin Dian, Shanghai Ke Lan Shangmao Youxian Gongsi Zhuzuoquan Quan Shu, Qinquan Jiufen, Shangye Huilu Bu Zhengdang Jingzheng Jiufen Ershen Minshi Panjueshu (西岗区珂兰饰品店、上海珂兰商贸有限公司著作权权属、侵权纠纷、商业贿赂不正当竞争纠纷二审民事判决书) [Xigang Dist. Kelan Jewelry Store v. Shanghai Kelan Trading Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Dalian Intermediate People's Ct. of Liaoning Province, Dec. 7, 2020) (China).

136. See, e.g., Xu haojie Yu Sichuan Diwang Jieju Gufen Youxian Gongsi Qinhai Shangbiao Quan Jiufen Yishen Minshi Panjueshu (徐豪杰与四川帝王洁具股份有限公司侵害商标权纠纷一案一审民事判决书) [Xu Haojie v. Sichuan Diwang Sanitary Ware Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Chengdu Intermediate People's Ct. of Sichuan Province, Nov. 27, 2014) (China); Xiamen Xin Yixian Wenhua Chuanmei Youxian Gongsi, Xu Ziwei Zhuzuoquan Quan Shu, Qinquan Jiufen Ershen Minshi Panjueshu (厦门鑫一线文化传媒有限公司、徐紫薇著作权权属、侵权纠纷二审民事判决书) [Xiamen Xinyixian Culture Media Co., Ltd. v. Xu Ziwei], 中国裁判文书网 [China Judgements Online] (Xiamen Intermediate People's Ct., Fujian Province, Aug. 28, 2020) (China); Zhangjianhui Yu Mengfanpeng Zhuzuoquan Quan Shu, Qinquan Jiufen Yishen Minshi Panjueshu (张建辉与孟繁鹏著作权权属、侵权纠纷一案一审民事判决书) [Zhang Jianhui v. Meng Fanpeng], 中国裁判文书网 [China Judgements Online] (People's Ct. of Shenyang High-tech Indus. Dev. Zone, Liaoning Province, Sept. 17, 2019) (China).

137. Zhongshan Shi Anyi Yuan Fushi Youxian Gongsi, Zhushi Huishe Yiwusuoyou Deng Qinhai Zuopin Fuzhi Quan Jiufen Minshi Shenqing Zaishen Shenchu Minshi Caiding Shu (中山市安逸猿服饰有

Our empirical results roughly confirm the SPC's approach in a majority of decisions; the possibility of the defendants' independent creation is mentioned and analyzed only after the court has reached a conclusion on substantial similarity.<sup>138</sup>

The SPC's approach seems different from the U.S. test, which deals with the independent creation defense in the first prong rather than the second prong. Admittedly, however, a few decisions merge the discussion on independent creation with the access prong, which seems similar to the U.S. approach.<sup>139</sup> As elaborated in Part III, even these cases differ markedly from the U.S. test in terms of addressing the independent creation defense.<sup>140</sup> With these empirical results or positive accounts of China's practical applications of substantial similarity plus access in mind, the following Part undertakes a more detailed and focused comparison of the U.S. and Chinese tests. It assesses whether the spillover from the U.S. has yielded a genuinely similar test in China. If not, what are the differences that remain underexplored by the current literature?

### III. COMPARISON: SOME SPILLOVER BUT SUBSTANTIAL DIVERGENCES

#### A. THE TWO-PRONG TEST

Several secondary sources indicate that Chinese courts transplanted the test from U.S. law rather than developed it.<sup>141</sup> Some scholars even strongly criticize the direct

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限公司、株式会社一无所有等侵害作品复制权纠纷民事申请再审审查民事裁定书) [Zhongshan Anyiyuan Clothing Co., Ltd. v. Yiwuyou Co., Ltd.], SUP. PEOPLE'S CT. GAZ. (Sup. People's Ct., June 29, 2021) (China) (a classical case identified by the SPC; included in the newly launched official database that includes only cases the SPC considers influential and important).

138. Admittedly, only a few decisions have ever mentioned the independent development (only eighty-one decisions). Seventy decisions discussed the possibility of independent creation after "substantial similarity" analysis.

139. There are ten decisions in total. *See, e.g.*, Xiang Wei Ren Yu Shenzhen Shi Guo Dashi Yishu Pin Touzi Youxian Gongsi, Zhangrucai Zhuzuoquan Quan Shu, Qinquan Jiufen Yishen Minshi Panjueshu (项维仁与深圳市国大师艺术品投资有限公司、张汝财著作权权属、侵权纠纷一案民事判决书) [Xiang Weiren and Shenzhen Guodashi Art Investment Co., Ltd. v. Zhang Rucai], 中国裁判文书网 [China Judgements Online] (Shenzhen Futian Dist. People's Ct., Guangdong Province, Dec. 27, 2018) (China); Shenzhen Shi Zhongshi Zongheng Sheji Youxian Gongsi Yu Chongqing Baoli Gaoerfu Qiu Hui Youxian Gongsi Zhuzuoquan Quan Shu, Qinquan Jiufen Yishen Minshi Panjueshu (深圳市中世纵横设计有限公司与重庆保利高尔夫球会有限公司著作权权属、侵权纠纷一案民事判决书) [Shenzhen Zhongshi Zongheng Design Co., Ltd. v. Chongqing Poly Gold Club Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Shenzhen Futian Dist. People's Ct., Guangdong Province, Nov. 11, 2016) (China); Chongqing Tian Zhihui Qi Keji Youxian Gongsi, Jinke Dichan Jituan Gufen Youxian Gongsi Yu Zhengzhou Shi Jinshui Dashan Peixun Xuexiao Youxian Gongsi Qinhai Zuopin Fuzhi Quan Jiufen Ershen Ershen Minshi Panjueshu (重庆天智慧启科技有限公司, 金科地产集团股份有限公司与郑州市金水区大山培训学校有限公司侵害作品复制权纠纷二审二审民事判决书) [Chongqing Tianzhihuiqi Tech. Co., Ltd. v. Zhengzhou Jinshui Dist. Dashan Training Sch. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Chongqing First Intermediate People's Ct., Oct. 26, 2021) (China).

140. *See infra* Part III.

141. *See* Liu, *supra* note 16, at 72–73; Zhang & Zhang, *supra* note 4, at 41–42; Chen, *supra* note 19; Wu, *supra* note 19, at 66–67 (citing secondary sources in U.S. copyright law when talking about "substantial

application of a test deriving from U.S. law to Chinese cases when the PRC Law offers no guidance.<sup>142</sup> Moreover, in a case note published in 2010, the judges emphasized the importance of the substantial similarity plus access test in computer software cases and referenced a U.S. case when discussing how to determine substantial similarity.<sup>143</sup> This evidence suggests that the Chinese courts either subconsciously gained insights from U.S. law or explicitly transplanted the U.S. test with some modifications. Accordingly, it is safe to argue that though there is no direct, explicit evidence proving the direct legal transplantation of the U.S. test into China, there is evidently some spillover from the U.S. into the Chinese test.

Yet, the spillover from the U.S. has made some scholars in China inattentively equate the Chinese test with the U.S. one, without a deeper examination and comparison. Specifically, a number of scholars acknowledge the origin of the Chinese test from the *Arnstein* test, arguing that access and substantial similarity aptly corresponds to actual copying and improper appropriation.<sup>144</sup> Following that line of the reasoning, the access prong in China suggests the likelihood that the defendant's work is not independently created but rather derived from the copyrighted material, congruous to the actual copying prong in the United States.<sup>145</sup> The substantial similarity prong subsequently deals with whether an unlawful portion of copyrighted works is taken, based on the existence of actual copying instead of independent development, to complete the infringement.<sup>146</sup>

At first glance, the arguments equating China's two prongs with the *Arnstein* test seem reasonable. Given that Chinese courts use roughly similar approaches to judge substantial similarities, as indicated in our empirical results and the current literature,<sup>147</sup> one may easily equate that approach with improper appropriation under the *Arnstein* test. When the substantial similarity prong undertakes the role of improper appropriation, it becomes natural to approximate the remaining access prong as fulfilling the function of actual copying in the U.S. test.

However, there are a wealth of defects in making such an ostensibly straightforward equation, since the Chinese test shares features distinct from those of the U.S. test. First, if the Chinese test is comparable to the U.S. test, it should follow the same order in analyzing the two parts. In other words, because the *Arnstein* test strictly follows the sequence of actual copying to improper appropriation,<sup>148</sup> Chinese courts should always determine access before examining substantial similarity. Admittedly, some courts, notably the SPC, seem to allude to an order to follow in the determination from access

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similarity" plus "access" in copyright law); Feng, *supra* note 97, at 77–78 (arguing that the tests used to judge substantial similarity originate from the U.S.); Liang, *supra* note 19, at 40.

142. See Chen, *supra* note 19; Qi, *supra* note 90.

143. Li et al., *supra* note 99, at 38–40.

144. See, e.g., Liu, *supra* note 16, at 73.

145. See, e.g., Zhou, *supra* note 21, at 115; Liu, *supra* note 16, at 73; Y'Barbo, *supra* note 10, at 295 (considering prong one as a separate derivation requirement from the "unlawful copying" prong).

146. See, e.g., Liu, *supra* note 16, at 73; Zhou, *supra* note 21, at 115.

147. See *infra* Part II.

148. See *infra* Part I.

to substantial similarity.<sup>149</sup> However, none emphasized the order or expressly mandated that the order should be followed. They simply mentioned and followed the order without any clues as to why they first judged access rather than substantial similarity.<sup>150</sup> That is likely why numerous Chinese courts do not strictly follow the sequence, dealing with access only after resolving the issue of substantial similarity.<sup>151</sup> Some even merely

149. For SPC decisions, see, e.g., Beijing Zhong Rong Heng Shengmuye Youxian Gongsi, Zuo Shangming She Jiaju Yongpin (Shanghai) Youxian Gongsi Zhuzuoquan Quan Shu, Qinqun Jiufen Zaishen Shenchu Yu Shenpan Jiandu Minshi Caiding Shu (北京中融恒盛木业有限公司、左尚明舍家居用品(上海)有限公司著作权权属、侵权纠纷再审审查与审判监督民事裁定书) [Beijing Zhongrong Hengsheng Wood Indus. Co., Ltd. v. Zuo Shangmingshe Home Furnishings (Shanghai) Co., Ltd.], SUP. PEOPLE'S CT. GAZ. (Sup. People's Ct., Dec. 29, 2018) (China); Guangzhou De Yi Wangluo Youxian Gongsi, Guangzhou Chengbei Xinxu Keji Youxian Gongsi Qinhai Jisuanji Ruanjian Zhuzuoquan Jiufen Ershen Minshi Caiding Shu (广州得翼网络有限公司、广州城北信息科技有限公司侵害计算机软件著作权纠纷二审民事裁定书) [Guangzhou Deyi Network Co., Ltd. v. Guangzhou Chengbei Info. Tech. Co., Ltd.], SUP. PEOPLE'S CT. GAZ. (Sup. People's Ct., May 20, 2020) (China). For other court decisions, see (武汉光亚文化艺术发展有限公司、黄乾生与刘若英、叶如婷等著作权权属、侵权纠纷一审民事判决书) [Wuhan Guangya Culture and Art Development Co., Ltd. v. Liu Ruoying], 中国裁判文书网 [China Judgements Online] (Wuhan Intermediate People's Ct., Hubei Province, Oct. 25, 2019) (China); Yongfu Youxian Gongsi Yu Shanghai Lin Yu Maoyi Youxian Gongsi, Zhengmingquan Zhuzuoquan Quan Shu, Qinqun Jiufen Yishen Minshi Panjueshu (永福有限公司与上海临宇贸易有限公司、郑明全著作权权属、侵权纠纷一审民事判决书) [Yongfu Co., Ltd. v. Shanghai Linyu Trading Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Shanghai Pudong New Area People's Ct., Mar. 30, 2020) (China); Chongqing Tian Zhihui Keji Youxian Gongsi, Jinke Dichan Jituan Gufen Youxian Gongsi Yu Zhengzhou Shi Jinshui Qu Dashan Peixun Xuexiao Youxian Gongsi Qinhai Zuopin Fuzhi Quan Jiufen Ershen Minshi Panjueshu (重庆天智慧启科技有限公司、金科地产集团股份有限公司与郑州市金水区大山培训学校有限公司侵害作品复制权纠纷二审民事判决书) [Chongqing Tianzhihuiqi Tech. Co., Ltd. v. Zhengzhou Jinshui Dist. Dashan Training Sch. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Chongqing First Intermediate People's Ct., Oct. 26, 2021) (China); Zhushi Huishe Mou Sheng Yu Guangdong Tai Mou Shipin Youxian Gongsi, Xiao Mou (Shanghai) Shipin Youxian Zeren Gongsi, Ao Mou Qinhai Zuopin Fuzhi Quan Jiufen, Faxing Quan Jiufen, Wangluo Chuanbo Quan Jiufen An (株式会社某生与广东泰某食品有限公司、小某(上海)食品有限责任公司、敖某侵害作品复制权纠纷、发行权纠纷、网络传播权纠纷案) [Mou Sheng Co., Ltd. v. Guangdong Tai Food Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Shanghai First Intermediate People's Ct., May 3, 2013) (China).

150. See, e.g., Guangzhou De Yi Wangluo Youxian Gongsi, Guangzhou Chengbei Xinxu Keji Youxian Gongsi Qinhai Jisuanji Ruanjian Zhuzuoquan Jiufen Ershen Minshi Caiding Shu (广州得翼网络有限公司、广州城北信息科技有限公司侵害计算机软件著作权纠纷二审民事裁定书) [Guangzhou Deyi Network Co., Ltd. v. Guangzhou Chengbei Info. Tech. Co., Ltd.], SUP. PEOPLE'S CT. GAZ. (Sup. People's Ct., May 20, 2020) (China); Zhongshan Shi Anyi Yuan Fushi Youxian Gongsi, Zhushi Huishe Yiwusuoyou Deng Qinhai Zuopin Fuzhi Quan Jiufen Minshi Shenqing Zaishen Shenchu Minshi Caiding Shu (中山市安逸猿服饰有限公司、株式会社一无所有等侵害作品复制权纠纷民事申请再审审查民事裁定书) [Zhongshan Anyiyuan Clothing Co., Ltd. v. Yiwuyou Co., Ltd.], SUP. PEOPLE'S CT. GAZ. (Sup. People's Ct., June 29, 2021) (China); Zhouhaohui Yu Yu Zheng, Zhou Jing Deng Qinhai Zuopin Shezhi Quan Jiufen Ershen Minshi Panjueshu (周浩晖与余征、周静等侵害作品摄制权纠纷二审民事判决书) [Zhou Haohui v. Yu Yu Zheng], 中国裁判文书网 [China Judgements Online] (Jiangsu High People's Ct., Dec. 26, 2018) (China).

151. See, e.g., Shanghai Shu Long Keiji Youxian Gongsi Yu Shanghai Jin Chang Wangluo Keji Youxian Gongsi, Shanghai Tao Jin Wangluo Keji Youxian Gongsi Deng Zhuzuoquan Quan Shu, Qinqun Jiufen Yishen Minshi Panjueshu (上海数龙科技有限公司与上海晋昶网络科技有限公司、上海淘进网络科技有限公司等著作权权属、侵权纠纷一审民事判决书) [Shanghai Shulong Tech. Co., Ltd. v. Shanghai Jinchang Network Tech. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Shanghai Pudong New Area People's Ct., Dec. 30, 2020) (China); Dongyang Shi Leshi Hua Er Yingshi Wenhua Youxian Gongsi Yu Beijing Zhongguancun Tushu Dasha Youxian Gongsi Deng Ershen Minshi Panjueshu (东阳市乐视花儿影

considered substantial similarity and left no room for access.<sup>152</sup> A few courts simply combined both into one analysis to find infringement.<sup>153</sup>

Indeed, many Chinese courts are lenient about the order and likely to consider both as two standalone elements for purposes of the copyright infringement test without a

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视文化有限公司与北京中关村图书大厦有限公司等二审民事判决书) [Dongyang Leshi Huaer Film and Television Culture Co., Ltd. v. Beijing Zhongguancun Book Bldg. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Beijing Intell. Prop. Ct., Sept. 28, 2020) (China); Beijing Ding Tian Wenhua Yule Youxian Gongsi Yu Shenzhen Shi Long Ban Wenhua Fazhan Youxian Gongsi Qin Hai Zuopin Xinxu Wangluo Chuanbo Quan Jiufen Yishen Minshi Panjue.. (北京鼎甜文化传媒有限公司与深圳市龙版文化发展有限公司侵害作品信息网络传播权纠纷一案民事判决.) [Beijing Dingtian Culture and Ent. Co., Ltd. v. Shenzhen Longban Culture Dev. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Beijing Internet Ct., Dec. 16, 2020) (China); Guangzhou Zheng Bai Shangmao Youxian Gongsi, Jin Shi Wenhua Chuanbo (Fushan) Youxian Gongsi Zhuzuoquan Quan Shu, Qinquan Jiufen Minshi Ershen Minshi Panjueshu (广州正佰商贸有限公司、金狮文化传播(佛山)有限公司著作权权属、侵权纠纷民事二审民事判决书) [Guangzhou Zhengbai Trading Co., Ltd. v. Golden Lion Culture Comm'n (Foshan) Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Guangzhou Intell. Prop. Ct., Sept. 6, 2021) (China); Si Ping Ma Si Te Youxian Gongsi Minshi Panjueshu (斯平玛斯特有限公司民事判决书) [Civil Judgment of Spin Master Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Guandong High People's Ct., May 28, 2018) (China); (武汉光亚文化艺术发展有限公司、黄乾生与刘若英、叶如婷等著作权权属、侵权纠纷一案民事判决书) [Wuhan Guangya Culture and Art Dev. Co., Ltd. v. Liu Ruoying], 中国裁判文书网 [China Judgements Online] (Wuhan Intermediate People's Ct., Hubei Province, Oct. 25, 2019) (China); Chen Yang Yu Fuxiaofan Deng Yishen Minshi Panjueshu (陈扬与傅小凡等一审民事判决书) [Chen Yang v. Fu Xiaofan], 中国裁判文书网 [China Judgements Online] (Beijing Haidian Dist. People's Ct., Dec. 11, 2017) (China); Mou Keji (Shanghai) Gufen Youxian Gongsi Su Shenzhen Shi Mou Keji Youxian Gongsi, Shanghai Mou Dianzi Lingjian Youxian Gongsi Jicheng Dianlu Bu Tu Sheji Zhuan You Quan Quan Shu, Qinquan Jiufen An (某科技(上海)股份有限公司诉深圳市某科技有限公司、上海某电子零件有限公司集成电路布图设计专有权权属、侵权纠纷案) [Mou Keji (Shanghai) Co., Ltd. v. Shenzhen Mou Keji Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Shanghai High People's Ct., Sept. 23, 2014) (China); Jiang Yue Yu Zhongguo Shuji Chubanshe Youxian Gongsi Zhuzuoquan Quan Shu, Qinquan Jiufen Yishen Minshi Panjueshu (蒋跃与中国书籍出版社有限公司著作权权属、侵权纠纷一案民事判决书) [Jiang Yue v. China Book Publ'g Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Beijing Fengtai Dist. People's Ct., Feb. 27, 2023) (China); Pujiang Xian Ao Er Te Gongyipin Youxian Zeren Gongsi, Fujian Shu Jing Wenhua Keji Youxian Gongsi Qin Hai Zuopin Fuzhi Quan Jiufen Ershen Minshi Panjueshu (浦江县奥尔特工艺品有限责任公司、福建书境文化科技有限公司侵害作品复制权纠纷一案民事判决书) [Pujiang County Aorte Crafts Co., Ltd. v. Fujian Shujiang Culture and Tech. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Zhejiang High People's Ct., Sept. 25, 2020) (China).

152. See, e.g., Xin Si Keji Youxian Gongsi, Wuhan Xin Dong Keji Youxian Gongsi Qin Hai Jisuanji Ruanjian Zhuzuoquan Jiufen Ershen Minshi Panjueshu (新思科技有限公司、武汉芯动科技有限公司侵害计算机软件著作权纠纷一案二审民事判决书) [Synopsys Inc. v. Wuhan Xindong Tech. Co., Ltd.], SUP. PEOPLE'S CT. GAZ. (Sup. People's Ct., Feb. 25, 2021) (China); Zhouliying Yu Wangliyun Zhuzuoquan Quan Shu, Qinquan Jiufen Yishen Minshi Panjueshu (周立英与王丽云著作权权属、侵权纠纷一案民事判决书) [Zhou Liying v. Wang Liyun], 中国裁判文书网 [China Judgements Online] (Kunming Intermediate People's Ct., Yunnan Province, Oct. 28, 2015) (China); Xiziruo Yu Xiang Chengshi Shui Zhai Yi Meng Fuzhuang Chang, Zhang Hui Zhuzuoquan Quan Shu, Qinquan Jiufen Yishen Minshi Panjueshu (谢子若与项城市水寨依梦服装厂、张辉著作权权属、侵权纠纷一案民事判决书) [Xie Ziruo v. Xiangcheng Shuizhai Yimeng Garment Factory], 中国裁判文书网 [China Judgements Online] (Guangzhou Internet Ct., May 9, 2020) (China).

153. See, e.g., Zhuruyue Yu Jiangsu Fenghuang Wenyi Chubanshe Youxian Gongsi Deng Zhuzuoquan Quan Shu, Qinquan Jiufen Ershen Minshi Panjueshu (朱茹月与江苏凤凰文艺出版社有限公司等著作权权属、侵权纠纷一案二审民事判决书) [Zhu Ruyue v. Jiangsu Phoenix Literature and Art Publ'g House Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Beijing's Second Intermediate People's Ct., Sept. 16, 2014) (China).

sequence to follow for determination.<sup>154</sup> For example, several first-instance courts that analyzed substantial similarity before access had their judgments appealed. Nevertheless, the appellate courts did not question the order these first-instance courts followed, even though they determined access before substantial similarity.<sup>155</sup>

The current literature also ignores the order of the two prongs in China, simply treating them as separate elements to satisfy without a meaningful sequence.<sup>156</sup> Even those scholars who recognize the U.S. origin of the Chinese test and try to equalize them do not care about the order; some have even proposed that Chinese courts consider substantial similarity first.<sup>157</sup> All told, it contradicts the current practice in China to opine that the Chinese test follows the same determination order as the *Arnstein* test, such that the two are congruous with each other.

## B. DOES ACCESS EQUAL ACTUAL COPYING?

The application of the Chinese two-prong test, which adopts terminology similar to the U.S. test, remains chaotic in practice due to the ambiguity regarding the specific function each prong is intended to fulfill. As discussed earlier, the first prong of the U.S. test establishes that the defendants at least copied something from the plaintiffs to defeat the independent creation defense, while the second prong measures whether a substantial portion has been taken to make the copying improper.<sup>158</sup> In sharp contrast, the current literature rarely discusses the functions of the two prongs of the Chinese test in detail; the Chinese courts do not receive guidance from the current law or helpful

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154. This impression was drawn by RAs based on their reading of the judgments during the coding process. For typical cases where courts consider access and substantial similarity as two standalone elements without a particular sequence for determination, see e.g., *Guangzhou Shi Yuexiu Qu Shang Wei Baozhuang Cailiao Shanghang, Gao Yi Zhuzuoquan Quan Shu, Qinquan Jiufen Minshi Ershen Minshi Panjueshu* (广州市越秀区上伟包装材料商行、高义著作权权属、侵权纠纷民事二审民事判决书) [Guangzhou Yuexiu Dist. Shangwei Packaging Materials Co., Ltd. v. Gaoyi], 中国裁判文书网 [China Judgements Online] (Guangzhou Intell. Prop. Ct., June 9, 2022) (China) (mentioning that the common test for copyright infringement would be access plus substantial similarity, meaning both elements should be satisfied without indicating any order to follow).

155. See, e.g., *Beijing Dong Ao Shidai Jiaoyu Keji Youxian Gongsi Deng Ershen Minshi Panjueshu* (北京东奥时代教育科技有限公司等二审民事判决书) [Second Civil Judgment of Beijing Dongao Times Educ. Tech. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Beijing Intell. Prop. Ct., Nov. 22, 2021) (China); *Chongqing Tian Zhihui Qi Keji Youxian Gongsi, Jin Ke Dichan Jituan Gufen Youxian Gongsi Yu Zhengzhou Shi Jinshui Qu Dashan Peixun Xuexiao Youxian Gongsi Qinhai Zuopin Fuzhi Quan Jiufen Ershen Ershen Minshi* (重庆天智慧启科技有限公司, 金科地产集团股份有限公司与郑州市金水区大山培训学校有限公司侵害作品复制权纠纷二审二审民事判决书) [Chongqing Tianzhihuiqi Tech. Co., Ltd. v. Zhengzhou Jinshui Dist. Dashan Training Sch. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Chongqing First Intermediate People's Ct., Oct. 26, 2021) (China).

156. See generally Ding, *supra* note 21 (arguing that access should be a standalone element from substantial similarity with no hints on the order to follow); Li et al., *supra* note 99, at 39 (treating each as dispositive element but no mentioning of the sequence though it used the terms “substantial similarity” plus “access” instead of in the reverse way).

157. See, e.g., Zhang & Zhang, *supra* note 4, at 42–43; Liang, *supra* note 19, at 38.

158. See *supra* Part I.

insights from scholarship.<sup>159</sup> Some courts treat the two-prong test as a given, making little effort to understand the function of each prong, while others consider each prong as fulfilling the same function as its corresponding prong in the U.S. test.<sup>160</sup> Delving into the cases where Chinese courts have applied the two-prong test, we can easily identify the inherent difficulty in equating the function of access with actual copying and that of substantial similarity with improper appropriation.

The few scholars who equate the two prongs of the Chinese test with the U.S. test consider access to be the weaker version of the actual copying prong because proving access can showcase the likelihood that defendants copied the copyrighted works.<sup>161</sup> However, such a proposition is inherently defective because access is only one piece of circumstantial evidence from which to infer actual copying.<sup>162</sup> From the perspective of evidence law, it would be unreasonable to say that access alone can prove actual copying, fulfilling a similar function to the actual copying prong of the U.S. test.<sup>163</sup> Considering the empirical results, the under-scrutinized equating of the function of access with actual copying is even more unjustified. The most popular types of evidence accepted by Chinese courts to satisfy the access prong, at best and only to a very limited extent, indicate the defendants' *potential* contact with the copyrighted works.<sup>164</sup> If merely providing those types of evidence of access, which can quite plausibly satisfy the Chinese access prong, suffices to prove actual copying and to overcome the independent development defense, then the actual copying prong becomes fundamentally redundant. That is probably why these scholars treat access as a weaker version of actual copying while tacitly demanding the finding of similarities between two works to remedy the otherwise fragile inference.<sup>165</sup>

Many Chinese courts would not just rely on the typical types of access evidence to infer actual copying and rule out the possibility of independent development; they unavoidably have to take into account the similarities between the two works to make a more reasonable inference.<sup>166</sup> The typical line of reasoning for these courts is using

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159. For the very few scholarly works that briefly mention the functions, see, e.g., Zhang & Zhang, *supra* note 4, at 42–43; Ding, *supra* note 21, at 25–26.

160. See, e.g., Zhang & Zhang, *supra* note 4, at 42–43; Ding, *supra* note 21, at 25–26.

161. Liu, *supra* note 16, at 73.

162. See *supra* notes 36–38 and accompanying text.

163. See Balganesch & Menell, *supra* note 9, at 314–19 (detailing the evidential functions of access and probative similarity).

164. See *supra* Part II.

165. See, e.g., Liu, *supra* note 16, at 73.

166. See, e.g., Chen Yang Yu Fuxiaofan Deng Yishen Minshi Panjueshu (陈扬与傅小凡等一审民事判决书) [Chen Yang v. Fu Xiaofan], 中国裁判文书网 [China Judgements Online] (Beijing Haidian Dist. People's Ct., Dec. 11, 2017) (China); Zhongshan Shi Anyi Yuan Fushi Youxian Gongs, Zhushi Huishe Yiwusuoyou Deng Qin Hai Zuopin Fuzhi Quan Jiufen Minshi Shenqing Zaishen Shench Minshi Caiding Shu (中山市安逸猿服饰有限公司、株式会社一无所有等侵害作品复制权纠纷民事申请再审审查民事裁定书) [Retrial of Zhongshan Anyiyuan Clothing Co.], SUP. PEOPLE'S CT. GAZ. (Supreme People's Ct., June 29, 2021) (China); Meiguo Mou Keji Youxian Gongs Su Wuhan Mou Keji Youxian Gongs Qin Hai Jisuanji Ruanjian Zhuzuoquan Jiufen An (美国某科技有限公司诉武汉某科技有限公司侵害计算机软件著作权纠纷案) [US Co. v. Wuhan Co.], SUP. PEOPLE'S CT. GAZ. (Supreme People's Ct., Feb. 25, 2021) (China); Beijing Mou Keji Youxian Gongs Su Shenzhen Shi Mou Keji Youxian Gongs, Mou Jishu (Shenzhen) Youxian Gongs, Shenzhen Shi Mou Jishu Youxian Gongs Deng Zhuzuoquan Quan Shu,



the similarities between two works plus the defendants' probable contact with the copyrighted works (access evidence) to rule out the coincidence of independent creation.<sup>167</sup> This may be why we see, in our empirical results, that a majority of court decisions in China only start analyzing the possibility of independent creation after comparing two works to judge the substantial similarity.<sup>168</sup> They need to rely on the evidence of similarities to facilitate the inference. Even for these decisions identified by our empirical results where the possibility of independent creation is analyzed within the access prong,<sup>169</sup> they are not using the evidence of access to prove actual copying and thus rule out the independent creation possibility. Instead, they are simply mentioning the failure of the defendants to offer evidence of independent creation such that the probable access to the copyrighted works still exists based on the access evidence offered by the plaintiffs.<sup>170</sup>

Qinquan Jiufen An (北京某科技有限公司诉深圳市某科技有限公司、某技术(深圳)有限公司、深圳市某技术有限公司等著作权权属、侵权纠纷案) [Beijing-based Co. v. Shenzhen-based Co.]. 中国裁判文书网 [China Judgements Online] (Guangdong High People's Ct., Dec. 25, 2009) (China); Beijing Dong Ao Shidai Jiaoyu Keji Youxian Gongsi Deng Ershen Minshi Panjueshu (北京东奥时代教育科技有限公司等二审民事判决书) [Second Civil Instance of Beijing Dongao Times Educ. Tech. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Beijing Intell. Prop. Ct., Nov. 22, 2021) (China); Wang Qian Yu Beijing Kaixin Mahua Ying Ye Youxian Gongsi Deng Yishen Minshi Panjueshu (王倩与北京开心麻花影业有限公司等一审民事判决书) [Wang Qian v. Beijing Mahua FunAge Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Beijing Chaoyang Dist. People's Ct., Sept. 30, 2020) (China); Beijing Huayu Daye Wenhua Chuanmei Youxian Gongsi Yu Zhaoxinghua, Beijing Ya Xuan Wenhua Jiaoliu Youxian Zeren Gongsi Qinhai Zhuzuoquan Jiufen Shangsu An (北京华语大业文化传媒有限公司与赵兴华、北京亚轩文化交流有限责任公司侵害著作权纠纷上诉案) [Beijing Huayu Daye Culture Media Co., Ltd. v. Zhao Xinghua & Beijing Yaxuan Culture Exchange Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Beijing Second Intermediate People's Ct., Apr. 24, 2014) (China); Shanghai Fu Diao Shi Youxian Gongsi, Dongyang Shi OU Xiang Jiaju Yongpin Youxian Gongsi Deng Zhuzuoquan Quan Shu, Qinquan Jiufen Ershen Minshi Panjueshu (上海福雕家饰有限公司、东阳市欧象家居用品有限公司等著作权权属、侵权纠纷二审民事判决书) [Shanghai Fudiao Home Decoration Co., Ltd. v. Dongyang Ouxiang Home Furnishing Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Shanghai Intell. Prop. Ct., Apr. 2, 2018) (China); Heli Yi Jie (Beijing) Xinxu Jishu Youxian Gongsi Deng Yu Caizhibin Deng Qinhai Jisuanji Ruanjian Zhuzuoquan Jiufen Yishen Minshi Panjueshu (合力亿捷(北京)信息技术有限公司等与蔡质彬等侵害计算机软件著作权纠纷一审民事判决书) [Heliyijie (Beijing) Info. Tech. Co., Ltd. v. Cai Zhibin], 中国裁判文书网 [China Judgements Online] (Beijing Intell. Prop. Ct., Sept. 29, 2018) (China).

167. See, e.g., Beijing Huayu Daye Wenhua Chuanmei Youxian Gongsi Yu Zhaoxinghua Beijing Ya Xuan Wenhua Jiaoliu Youxian Zeren Gongsi Qinhai Zhuzuoquan Jiufen Shangsu An (北京华语大业文化传媒有限公司与赵兴华、北京亚轩文化交流有限责任公司侵害著作权纠纷上诉案) [Beijing Huayu Daye Culture Media Co., Ltd. v. Zhao Xinghua], 中国裁判文书网 [China Judgements Online] (Beijing Second Intermediate People's Ct., Apr. 24, 2014) (China); Wang Qian Yu Beijing Kaixin Mahua Ying Ye Youxian Gongsi Deng Yishen Minshi Panjueshu (王倩与北京开心麻花影业有限公司等一审民事判决书) [Wang Qian v. Beijing Mahua FunAge Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Beijing Chaoyang Dist. People's Ct., Sept. 30, 2020) (China); Shenzhen Shi Zhong Jia Xun Keji Youxian Gongsi, Kailide Xin Jishu Shenzhen Shi Kailide Jisuanji Xitong Jishu Youxian Gongsi Yu Beijing Chang Di Wan Fang Keji Youxian Gongsi Qinfan Zhuzuoquan Jiufen (深圳市中佳讯科技有限公司、凯立德欣技术深圳市凯立德计算机系统技术有限公司与北京长地万方科技有限公司侵犯著作权纠纷上诉案) [Shenzhen Zhongjiaxun Tech. Co., Ltd. v. Beijing Changdi Wanfang Tech. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Guangdong High People's Ct., Dec. 18, 2009) (China).

168. See *supra* Part II and note 138 and accompanying text.

169. See *supra* Part II and note 139 and accompanying text.

170. See, e.g., Mengfanpeng, Zhangjianhui Zhuzuoquan Quan Shu, Qinquan Jiufen Ershen Minshi Panjueshu (孟繁鹏、张建辉著作权权属、侵权纠纷二审民事判决书) [Meng Fanpeng v. Zhang

Based on the empirical results, we can confidently consider the access prong in China to differ from the actual copying prong in the United States in terms of its functions. Because most decisions in China rely on evidence of access and similarities to assess the possibility of independent creation, this common approach of the Chinese courts perceives the access prong as merely one component in proving actual copying rather than a definitive and standalone criterion.

### C. MUDDIED FUNCTIONS: DOES ACCESS PLUS SUBSTANTIAL SIMILARITY EQUAL ACTUAL COPYING?

If viewing the Chinese test in this way, it seems that access plus substantial similarity can function analogously to the actual copying prong in the United States because both aim to infer the existence of some copying from defendants to defeat the independent creation defense. That is to say, the previous understanding of the Chinese test uncovered by the empirical results and representative decisions reveals that substantial similarity in China ostensibly performs a similar role to probative similarity in prong one of the *Arnstein* test.<sup>171</sup> Substantial similarity also functions as circumstantial proof to facilitate the evidential inference as to the existence of actual copying, which functions just like the U.S. prong one probative similarity. Based on that proposition, one may conclude that China's access plus substantial similarity equals the United States' actual copying prong.

Superficially, this equation conforms with the current practice in China in some respects. For instance, a handful of decisions considered the appearance of common errors in the works of the plaintiff and the defendant as part of the substantial similarity analysis.<sup>172</sup> This is one of the parallels with probative similarity in prong one of the

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Jianhui), 中国裁判文书网 [China Judgements Online] (Shenyang Intermediate People's Ct. of Liaoning Province, June 20, 2020) (China); Shenzhen Shi Zhongshi Zongheng Sheji Youxian Gongsu Yu Chongqing Baoli Gao'erfu Qiu Hui Youxian Gongsu Zhuzuoquan Quan Shu, Qinquan Jiufen Yishen Minshi Panjueshu (深圳市中世纵横设计与重庆保利高尔夫球会有限公司著作权权属、侵权纠纷一审民事判决书) [Shenzhen Zhongshi Zongheng Design Co., Ltd. v. Chongqing Poly Golf Club Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Shenzhen Futian Dist. People's Ct., Guangdong Province, Nov. 11, 2016) (China); Xiang Wei Ren Yu Shenzhen Shi Guo Dashi Yishu Pin Touzi Youxian Gongsu, Zhangrucai Zhuzuoquan Quan Shu, Qinquan Jiufen Yishen Minshi Panjueshu (项维仁与深圳市国大师艺术品投资有限公司、张汝财著作权权属、侵权纠纷一审民事判决书) [Xiang Weiren v. Shenzhen Guodashi Art Inv. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Shenzhen Futian Dist. People's Ct., Guangdong Province, Dec. 27, 2018) (China).

171. See *supra* notes 47–57 and accompanying text.

172. See, e.g., Beijing Shan Liang Shishang Xinxu Jishu Youxian Gongsu, Bu Luan Mai Dianzi Shangwu (Beijing) Youxian Gongsu Qinhai Jisuanji Ruanjian Zhuzuoquan Jiufen Ershen Minshi Panjueshu (北京闪亮时尚信息技术有限公司、不乱买电子商务(北京)有限公司侵害计算机软件著作权纠纷二审民事判决书) [Beijing Shining Fashion Info. Tech. Co., Ltd. v. Buluanmai E-commerce (Beijing) Co., Ltd.], SUP. PEOPLE'S CT. GAZ. (Supreme People's Ct., Dec. 23, 2019) (China); Guangzhou Shi Ming Jing Wutai Dengguang Shebei Youxian Gongsu, Guangzhou Shi Yu Zhan Dianzi Youxian Gongsu Qinhai Jisuanji Ruanjian Zhuzuoquan Jiufen Minshi Yishen Minshi Panjueshu (广州市明静舞台灯光设备有限公司、广州市煜展电子有限公司侵害计算机软件著作权纠纷民事一审民事判决书) [Guangzhou Mingjing Stage Lighting Equip. Co., Ltd. v. Guangzhou Yuzhan Elecs. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Guangzhou Intell. Prop. Ct., Dec. 24, 2018) (China); Beijing Zhong Ke Heng Chao Keji Youxian

*Arnstein* test.<sup>173</sup> Furthermore, the common approach to *Arnstein* is allowing the dissection of the works to determine actual copying while not allowing any dissection in the improper appropriation prong.<sup>174</sup> As demonstrated in our empirical results, analytical dissection is one of the common methods Chinese courts use in their substantial similarity analysis,<sup>175</sup> making it more akin to prong one of the *Arnstein* test.

Meanwhile, some courts appeared to treat substantial similarity as probative similarity, though perhaps due to their confusions between the two, they adopted some arrangements touching the core of the inverse ratio rule. U.S. courts use a sliding scale approach to prove actual copying, allowing greater evidence on similarities to remedy less evidence on access, and vice versa.<sup>176</sup> Likewise, several Chinese courts utilized the essence of the inverse ratio rule. For example, some relied on the striking similarities between the two works to rule out the possibility of independent creation and find infringement.<sup>177</sup> Others used unconventional similarities between the two works to

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Zeren Gongsi Yu Beijing Pei Te Lai Dianqi Youxian Gongsi Deng Qin Hai Jisuanji Ruanjian Zhuzuoquan Jiufen Yishen Minshi Panjueshu (北京中科恒朝科技有限责任公司与北京佩特来电器有限公司等侵害计算机软件著作权纠纷一审民事判决书) [Beijing Zhongke Hengchao Tech. Co., Ltd. v. Beijing Peitelai Elec. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Beijing Intell. Prop. Ct., Aug. 30, 2018) (China); Chongqing Suo Ding Keji Youxian Gongsi Yu Lǔxiaobo Zhuzuoquan Qinquan Jiufen Shangsu An (重庆索鼎科技有限公司与吕晓波著作权侵权纠纷上诉案) [Chongqing Suoding Tech. Co., Ltd. v. Lv Xiaobo], 中国裁判文书网 [China Judgements Online] (Chongqing First Intermediate People's Ct., Nov. 30, 2015) (China); Chen Zhe Yu Yu Zheng, Hunan Jing Shi Wenhua Chuanbo Youxian Gongsi, Dongyang Huan Yu Yingshi Wenhua Youxian Gongsi, Wanda Yingshi Chuanmei Youxian Gongsi, Dongyang Xing Rui Yingshi Wenhua Chuanmei Youxian Gongsi Qin Hai Zhuzuoquan Jiufen Yishen Minshi Panjueshu (陈喆与余征、湖南经视文化传播有限公司、东阳欢娱影视文化有限公司、万达影视传媒有限公司、东阳星瑞影视文化传媒有限公司侵害著作权纠纷一审民事判决书) [Chen Zhe v. Yu Zheng], 中国裁判文书网 [China Judgements Online] (Beijing No. 3 Intermediate People's Ct., Dec. 25, 2014) (China); Shenzhen Shi Jianzhu Sheji Yanjiu Zong Yuan Youxian Gongsi, Jingmen Zhong Chen Zhiye Fazhan Youxian Gongsi Jianshe Gongcheng Hetong Jiufen Ershen Minshi Panjueshu (深圳市建筑设计研究总院有限公司、荆门中辰置业发展有限公司建设工程合同纠纷二审民事判决书) [Shenzhen Gen. Inst. of Architectural Design & Rsch. Co., Ltd. v. Jingmen Zhongchen Real Est. Dev. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Hubei Provincial High People's Ct., Aug. 10, 2017) (China).

173. Latman, *supra* note 13, at 1205; *see also* Balganeshe & Menell, *supra* note 9, at 334.

174. *See* Lemley, *supra* note 10, at 726.

175. *See supra* Part II.

176. *See supra* notes 53–57 and accompanying text.

177. *See, e.g.*, Fuzhu Gongye Zhushi Hui She Yu Shantou Shi San Ma Sujiao Zhipin Youxian Gongsi Deng Qin Hai Zuopin Fuzhi Quan Jiufen Minshi Yishen Anjian Minshi Panjueshu (福助工业株式会社与汕头市三马塑胶制品有限公司等侵害作品复制权纠纷民事一审案件民事判决书) [Fuzhu Indus. Co., Ltd. v. Shantou Sanma Plastic Prods. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Shanghai Xuhui Dist. People's Ct., Oct. 29, 2020) (China); Cengzhaoyu, Quanzhou Yi Xiao Feng Maoyi Youxian Gongsi Zhuzuoquan Quan Shu, Qinquan Jiufen Ershen Minshi Panjueshu (曾招裕、泉州逸小风贸易有限公司著作权权属、侵权纠纷二审民事判决书) [Zeng Zhaoyu v. Quanzhou Yixiaofeng Trading Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Fujian High People's Ct., Aug. 31, 2020) (China); Hangzhou Bi Ling Wangluo Keji Youxian Gongsi Yu Hangzhou Fanshen Wangluo Keji Youxian Gongsi, Hangzhou Li Xing Baihuo Jituan Youxian Gongsi Zhuzuoquan Quan Shu, Qinquan Jiufen Yishen Minshi Panjueshu (杭州必灵网络科技有限公司与杭州反身网络科技有限公司、杭州利星百货集团有限公司著作权权属、侵权纠纷一审民事判决书) [Hangzhou Biling Network Tech. Co., Ltd. v. Hangzhou Fanshen Network Tech. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Hangzhou Railway Transp. Ct., Sept. 24, 2020) (China); Xie Ying Yu Hangzhou Maikē Sī Měi Maoyi Youxian Gongsi, Hangzhou Maikē Sī Měi Maoyi Youxian Gongsi Shanghai Zhangning Qu Fen Gongsi Deng Qin Hai Zuopin Fuzhi Quan

infer actual access and, taken together, proved actual copying,<sup>178</sup> which implicitly borrowed insights from the inverse ratio rule. In addition, certain scholars hold the same view that the inverse ratio rule is available in the Chinese access and substantial similarity test.<sup>179</sup> These observations reinforce the impression that the Chinese substantial similarity is equivalent to probative similarity.

However, such alignment still suffers from critical flaws as it pronouncedly downplays the actual functions the substantial similarity prong in China achieves. Unlike probative similarity where any level of similarity may facilitate the inference of actual copying without any quantitative or qualitative conditions, Chinese courts meant the similarity to be of some degree or satisfy some requirements for the prong to be sustained. For example, as demonstrated in our empirical results, several decisions demand that the similarity between two works be quantitatively significant when analyzing substantial similarity.<sup>180</sup> Many require that similarities lie in the expression or other protectable elements of the plaintiff's works; not all similarities can necessarily satisfy the substantial similarity prong, regardless of how probative they may be.<sup>181</sup>

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178. See, e.g., Cengzhaoyu, Quanzhou Yi Xiao Feng Maoyi Youxian Gongsi Zhuzuoquan Quan Shu, Qinquan Jiufen Ershen Minshi Panjueshu (曾招裕、泉州逸小风贸易有限公司著作权权属、侵权纠纷二审民事判决书) [Zeng Zhaoyu v. Quanzhou Yixiaofeng Trading Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Fujian High People's Ct., Aug. 31, 2020) (China); Zhongshan Shi Anyi Yuan Fushi Youxian Gongsi, Zhushi Huishe Yiwusuoyou Qinhai Zuopin Fuzhi Quan Jiufen, Qinhai Zuopin Faxing Quan Jiufen, Qinhai Zuopin Xinxi Wangluo Chuanbo Quan Jiufen Ershen Minshi (中山市安逸服装服饰有限公司、株式会社一无所有侵害作品复制权纠纷、侵害作品发行权纠纷、侵害作品信息网络传播权纠纷二审民事判决书) [Zhongshan Anyiyuan Clothing Co., Ltd. v. Yiwuyou Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Liaoning Provincial High People's Ct., Apr. 9, 2020) (China); Shenzhen Shi Xing Liao Da Jinshu Youxian Gongsi Yu Zhuhai Shi Yuan Fang Xi Gongyi Jishu Yanfa Youxian Gongsi Qinhai Zuopin Fuzhi Quan Jiufen Ershen Minshi Panjueshu (深圳市兴廖达金属制品有限公司与珠海市圆方锡工艺技术研发有限公司侵害作品复制权纠纷二审民事判决书) [Shenzhen Xingliaoada Metal Prods. Co., Ltd. v. Zhuhai Yuanfang Tin Tech. Rsch. & Dev. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Zhuhai Intermediate People's Ct. of Guangdong Province, Sept. 14, 2015) (China); *Id.*; Shenzhen Shi Jianzhu Sheji Yanjiu Zong Yuan Youxian Gongsi Yu Jingmen Zhong Chen Zhiye Fazhan Youxian Gongsi, Hubei Sheng Jian Ke Jianzhu Sheji Yuan Jianshe Gongcheng Hetong Jiufen Yishen Minshi Panjueshu (深圳市建筑设计研究总院有限公司与荆门市辰置业发展有限公司、湖北省建科建筑设计院建设工程合同纠纷一审民事判决书) [Shenzhen Architectural Design & Rsch. Inst. Co., Ltd. v. Jingmen Zhongchen Real Est. Dev. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Wuhan Intermediate People's Ct., Hubei Province, June 7, 2016) (China); Fan Hua Jiaju (Shanghai) Youxian Gongsi Yu Shanghai Mei Xuan Shiye Youxian Gongsi Zhuzuoquan Quan Shu, Qinquan Jiufen Yishen Minshi Caiding Shu (梵华家具(上海)有限公司与上海美旋实业有限公司著作权权属、侵权纠纷一审民事裁定书) [Fanhua Furniture (Shanghai) Co., Ltd. v. Shanghai Meixuan Indus. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Shanghai Pudong New Area's People's Ct., May 27, 2017) (China).

179. See, e.g., Liu, *supra* note 16, at 86–87; Meng Ting (孟霆) & Dong Shi (董石), *Zuopinquan Qinquan de Shencha Lujing* (著作权侵权的审查路径) [*The Examination Path of Copyright Infringement*], CHINA BUS. L.J. (Mar. 1, 2022).

180. See *supra* Part II.

181. See *id.*

The inadequacy of equating substantial similarity with probative similarity or considering it as part of actual copying is amplified when we consider another main approach Chinese courts take in applying this prong: total concept and feel.<sup>182</sup> While many Chinese courts comfortably engage in the total concept and feel analysis to judge substantial similarities as indicated by our empirical results, especially in artistic works, this approach originates from U.S. courts when they determine the improper appropriation prong.<sup>183</sup> The practice of Chinese courts shown in decisions sends a signal to the public that they do not just use substantial similarity to infer actual copying. More significantly, just like U.S. courts, Chinese courts also engage in some level of normative judgment on whether the defendant takes too much—for example, whether or not a substantial amount of protectable material is taken.<sup>184</sup> As such, Chinese courts use the substantial similarity analysis not just to exercise its probative value but also to emphasize its function of judging the impropriety of the defendant's copying conduct.

#### D. SIMILAR TERMINOLOGY, DIVERGENT FUNCTIONS: A SUMMARY

Given the discussion above, one can easily perceive the inherent muddiness in understanding what each prong means and how it functions in China. It is inaccurate to equate access with actual copying or access plus substantial similarity with actual copying. Likewise, a simplistic matching between substantial similarity and improper appropriation is equally unprecise because substantial similarity in China also partially functions as probative similarity. Therefore, China currently adopts a somewhat distinct version of the two-prong test, despite the spillover from the United States and the use of similar terminology.

Specifically, the substantial similarity prong in China performs dual functions. First, it contributes to the finding of actual copying by defendants and, together with the access prong, operates to dismiss the independent creation defense. Second, and more importantly, substantial similarity is similar to improper appropriation in determining whether the defendant's copying from the copyrighted works has reached a substantial level that constitutes illegitimate infringement. Table 1 depicts the more apt comparison between the Chinese test and the United States' *Arnstein* test.

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182. See *id.*

183. See Asay, *supra* note 9, at 81, 83 (finding that total concept and feel is one common approach adopted in the U.S. courts when judging improper appropriation according to the empirical results).

184. See Wu, *supra* note 19, at 67–68; Liang, *supra* note 19, at 38–39.

TABLE 1: THE CHINESE TEST VERSUS THE U.S. *ARNSTEIN* TEST

Functions	China	U.S.
Actual Copying	Access	Access
& Independent Creation	Substantial Similarity	& Probative Similarities <sup>185</sup>
Improper Appropriation		Substantial Similarity
Legal Outcome	Finding of Copyright Infringement	

#### IV. JUSTIFYING THE DIVERGENCES

##### A. SPILLOVER LEADING TO A JUSTIFIABLY DIVERGENT TEST

Judging from the perspective of legal transplantation, if one considers there is one, some may propose that Chinese courts have failed to fully transplant the copyright infringement test from the United States. It looks like the Chinese courts misread the *Arnstein* two-prong test and transplanted the two frequently occurring terms into their own test—access and similarity—without knowing the differences between probative similarity and substantial similarity; they did not have a clear picture of what distinct functions each tried to achieve in the United States.<sup>185</sup> During the transplantation, Chinese courts probably made the same mistake as some U.S. courts, which confused probative similarity and substantial similarity, construing both as the same element and fulfilling the same functions. As mentioned, the former achieves different functions from the latter such that the correct understanding of the *Arnstein* decision should differentiate the two.<sup>186</sup>

Nevertheless, this Article has pointed out the frequently occurring misreading of the *Arnstein* decision by follow-on U.S. courts because of its double use of the term substantial similarity in both prongs.<sup>187</sup> Even though some circuits (e.g., the Fifth and Second Circuits) have correctly used the term probative similarity to substitute

185. That is why the Chinese courts have quite divergent approaches in terms of analyzing the access and substantial similarity prongs in reality. *See supra* Part III.

186. *See supra* notes 47–64 and accompanying text.

187. *See supra* notes 44–45 and accompanying text.

substantial similarity in prong one to eliminate confusion,<sup>188</sup> several U.S. courts have conflated two types of similarities and lumped them together.<sup>189</sup> It can be argued by those who consider that there is a legal transplantation that, when transplanting the U.S. test, Chinese courts were equally confused by the dual determinations of similarity in the two prongs, similar to these U.S. courts, or subtly influenced by the U.S. courts' erroneous interpretations. As a result, Chinese courts may have conflated the two types of similarity into one overarching substantial similarity. The inaccuracies in the potential legal transplantation may be further evidenced by the flawed application of the inverse ratio rule by some Chinese courts.<sup>190</sup> These courts recognize a sliding scale between substantial similarity and access, mirroring the error made by some U.S. courts due to their conflation of the two types of similarity.<sup>191</sup> Following this line of reasoning, it seems that there should be further legal transplantations to "correct" the inaccuracies of the current Chinese test to better align it with the U.S. test.

However, this Article rejects this reasoning and proposes that there should be no further transplantation from the U.S. test, if there was one before, as the divergent Chinese test better suits the Chinese judicial system and offers more substantive benefits. First, as discussed earlier, there are unique procedural reasons behind why the *Arnstein* court divided the copyright infringement test into two prongs.<sup>192</sup> The *Arnstein* court adopted the bifurcated test by deliberately dividing the question of copying into actual (prong one) and improper (prong two) for the unique jury-judge division system as well as the availability of summary judgment in the United States.<sup>193</sup> The court wanted the *whole* question of copying to be resolved by a group of laypersons through a jury rather than trial court judges through the summary judgment proceeding.<sup>194</sup> Because the trial court in *Arnstein* only addressed whether the defendant had actually copied the work, leaving another copying question of whether the copying amounted to an infringing act untouched, Judge Frank was concerned that if he did not address improper copying as part of the overall copying question, the trial court would continue to rely on summary judgment rather than defer to a jury on the issue of improper copying after the case was remanded on the issue of actual copying.<sup>195</sup> That is why Judge Frank, despite very weak precedents adopting the same bifurcated test, insisted that the copying question should be separated into two and emphasized the importance of having juries decide the impropriety of copying.<sup>196</sup> Yet, the similarity

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188. See Latman, *supra* note 13, at 1204; Asay, *supra* note 9, at 45; Lemley, *supra* note 10, at 722.

189. See, e.g., Steinberg v. Columbia Pictures Indus., 663 F. Supp. 706 (S.D.N.Y. 1987); Ideal Toy Corp. v. Kenner Prods. Div. of Gen. Mills Fun Grp., Inc., 443 F. Supp. 291 (S.D.N.Y. 1977); Novelty Textile Mills, Inc. v. Joan Fabrics Corp., 558 F.2d 1090 (2d Cir. 1977); Skidmore v. Led Zeppelin, 952 F.3d 1051 (9th Cir. 2020) (en banc) (rejecting the inverse ratio rule because of conflations between substantial similarity and probative similarity). See also *supra* notes 44–45 and accompanying text.

190. See *supra* notes 177–179 and accompanying text.

191. See *supra* notes 58–60 and accompanying text.

192. See *supra* notes 67–84 and accompanying text.

193. See Balganes, *supra* note 9, at 850.

194. See *id.* (emphasis added).

195. See *id.* at 807–08.

196. See *id.* at 808, 842–46.

between the works, originally a critical part of the entire copying question, now has to function twice in both copying prongs, acting as the dispositive element in both and the entire test.<sup>197</sup>

The division between probative and substantial similarity in the bifurcated prongs was further motivated by Judge Frank's disfavor of expert evidence in judging illicit copying and his allowance of it in determining actual copying.<sup>198</sup> His analysis construed the question of improper appropriation as a fact to be analyzed through the lens of laypersons such that "a judge should neither make the assessment nor indeed control it by allowing the jury to hear expert evidence."<sup>199</sup> This distinction stems from Judge Frank's concerns about trial courts using expert evidence to influence jury findings on illicit copying, essentially circumventing the jury's determinations on the overall question of copying.<sup>200</sup>

The Chinese legal system has no special procedural considerations supporting the *Arnstein* bifurcated test. Though there is certainly a distinction between questions of law and questions of facts in China, the distinction does not matter that much because Chinese courts do not have the unique judge-jury system as in the United States.<sup>201</sup> In most circumstances, Chinese judges determine all questions of law and facts.<sup>202</sup> Moreover, Chinese courts do not have any discretion to resolve an issue at an early stage of the proceedings, such as summary judgment, which is available to U.S. courts.

Generally, Chinese courts hear evidence presented by both parties and consider their debates to ascertain the facts and apply the law to reach a final decision.<sup>203</sup> The exception is the civil mediation process, a unique and complex system in China that goes beyond the scope of this Article. Expert evidence is generally available in Chinese court proceedings to assist judges in their determinations upon request by the parties

197. See *id.* at 844.

198. See *id.* at 850.

199. See *id.* at 852.

200. See *id.* at 850–52.

201. Chinese courts do invite some portions of the public to attend the court proceedings as people's assessors. However, people's assessors are by no means similar to jurors compatible with the jury system in the U.S. For an overview of the Chinese people's assessors system, see Guodong Du, *Does the Jury Exist in China?*, CHINA JUST. OBSERVER (Feb. 21, 2020), <https://www.chinajusticeobserver.com/a/does-the-jury-exist-in-china> [https://perma.cc/3UXG-D9R9] [https://web.archive.org/web/20240722024722/https://www.chinajusticeobserver.com/a/does-the-jury-exist-in-china].

202. Technically speaking, people's assessors would serve as members of the judge panel. The whole judge panel would vote to decide on the questions of facts and law. See FALIAN ZHANG, *Comparison Between Chinese Assessor System and Western Jury System*, in A COMPARATIVE STUDY OF CHINESE AND WESTERN LEGAL LANGUAGE AND CULTURE 382–83 (Qing Zhang & Hongfang Zhao trans., 2021). However, anyone familiar with China's judicial system can easily identify the limited decision power that people's assessors have in court proceedings.

203. For a brief introduction to Chinese civil procedure law and China's judicial system, see Guodong Du, *Litigation in China 101: A Basic Understanding of Civil Litigation in China*, CHINA JUST. OBSERVER (Nov. 24, 2019), <https://www.chinajusticeobserver.com/a/china-litigation-101> [https://perma.cc/W2H2-5YBL] [https://web.archive.org/web/20240420155759/https://www.chinajusticeobserver.com/a/china-litigation-101].



or *ex officio* by the courts, especially in IP cases that require strong technical expertise.<sup>204</sup> No matter whether it concerns probative similarity in actual copying or substantial similarity in improper appropriation, Chinese courts may rely on expert evidence as they deem appropriate. Therefore, none of the procedural considerations justifying the division between probative similarity and substantial similarity in the two-prong U.S. test exist in the Chinese legal system. It then becomes much more understandable why Chinese courts, despite the spillover from the U.S. test, did not make a similar distinction between the two types of similarity but instead lumped them together as a single substantial similarity issue. They formulated a two-prong test that better aligns with China's own civil proceedings and judicial system.

Aside from the procedural considerations, the current version of the Chinese test is not necessarily inferior to the standard *Arnstein* test from a substantive viewpoint. As mentioned, the double use of and determination of similarity between two works in two prongs has confused many U.S. courts. The same evidence on similarities no doubt has to be used twice to satisfy both prongs if strictly adhering to the *Arnstein* division approach.<sup>205</sup> Using the same evidence twice in one infringement analysis seems burdensome and counterintuitive. There appears to be no substantive reason for a double determination of similarities, which often leads to confusion, instead of consolidating it into one, aside from the procedural concerns mentioned above.<sup>206</sup> It is also questionable whether fact finders (judges or juries) can keep the two types of similarity separate—rendering the distinction even less meaningful in practice.<sup>207</sup> Most likely due to the confusion and the lack of substantive considerations for the double determination, the most recent empirical work in the United States has indicated that “most courts address prong one simply by assessing the defendant’s probable access to the plaintiff’s work,” with only slightly over 25% of the opinions discussing some form of similarity within their prong one analysis.<sup>208</sup> Though some courts made mistakes in combining two types of similarity, many courts deliberately leave the similarity question to prong two as they consider probative similarity in prong one redundant.<sup>209</sup> These courts try to avoid duplicating the efforts in judging similarities to achieve greater judicial efficiencies.<sup>210</sup> From this angle, the unified determination of similarities in the substantial similarity prong in China may not be that problematic.

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204. Minshi Susong Fa (民事诉讼法) [Civil Procedure Law] (promulgated by the Nat'l People's Cong., Apr. 9, 1991, rev'd Sept. 1, 2023, effective Jan. 1, 2024), art. 79, 2023 P.R.C. LAWS (China), <https://www.lawinfochina.com/display.aspx?lib=law&id=41817> [<https://web.archive.org/web/20240723165813/https://www.lawinfochina.com/display.aspx?lib=law&id=41817>]. For the increasing use of expert evidence in IP cases, see Yang Chen, *Rebalancing the Burden of Proof for Trade Secrets Cases in China: A Detailed Scrutiny and Comparative Analysis of Article 32*, 84 U. PITT. L. REV. 826, 871–72 (2023).

205. See Balganes, *supra* note 9, at 805.

206. See *id.* at 850; Samuelson, *supra* note 7, at 1825–26.

207. Samuelson, *supra* note 7, at 1826.

208. Asay, *supra* note 9, at 75.

209. *Id.* at 76.

210. *Id.* at 76, 78.

Moreover, the fact finders' sequential double determination of similarities tends to unfairly disadvantage the defendants due to their inevitable hindsight bias. To be more precise, once fact finders have established the probative similarity, indicating actual copying, they are likely to harbor some bias against the defendants because of their copying behavior.<sup>211</sup> They may unavoidably draw conscious or subconscious conclusions from the first prong copying and thus become more inclined to determine that the copying is substantial and, therefore, improper.<sup>212</sup> The potential spillover from a finding of actual copying to the determination of improper copying is quite real, as there is a general sense of free-riding rhetoric existing in intellectual property cases.<sup>213</sup> The rhetoric of free riding may predispose fact finders to view copying, once established in the first prong, as improper.<sup>214</sup> Empirical evidence has confirmed this bias, demonstrating that mere knowledge of copying can influence judgments of similarity. This effect is due to people's moral disapproval of copying and tendency to punish the copier.<sup>215</sup> Considering the inevitable bias stemming from the need to determine similarity in two separate copying prongs, the current approach in Chinese law appears less flawed because it only involves a single evaluation of similarity, thereby reducing the risk of hindsight bias.

However, the current Chinese approach and its practical application, which merges two types of similarities, may have some shortcomings. As such, despite cautions against suggesting any future transplantation, this Article normatively proposes a reformed test to address the pressing issues. These issues are identified shortly, followed by suggestions for reform.<sup>216</sup> Explanations and responses to the potential counterarguments to the reform suggestions also follow.

## B. JUSTIFIED WITH LOOPHOLES: SOME SHORT PROPOSALS FOR REFORM

Although previous writings have suggested that there is no procedural need for China to separate two types of similarity into distinct prongs, and that there are substantive benefits to avoiding such a division, the current Chinese approach still suffers from some significant flaws that need to be addressed. The foremost issue with the current Chinese practice is the lack of any clear understanding of what functions each part of the test tries to achieve.<sup>217</sup> Most Chinese courts are unaware of probative similarity as a concept distinct from substantial similarity. This oversight is likely because China lacks a counterpart to the U.S. system's procedural considerations that result in the distinction such that they cannot understand or even envision a double

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211. See Samuelson, *supra* note 7, at 1826; Manta, *supra* note 13, at 1339–41; Shyamkrishna Balganesh, *Foreseeability and Copyright Incentives*, 122 HARV. L. REV. 1569, 1631 (2008).

212. See Manta, *supra* note 13, at 1340.

213. See Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1039 (2005); *Id.* at 1340.

214. See Manta, *supra* note 13, at 1340.

215. Balganesh, Manta, & Wilkinson-Ryan, *supra* note 4, at 280–81.

216. See *infra* Part IV.B.

217. See *supra* Part III.

determination of similarities between two works.<sup>218</sup> They are nothing like certain U.S. courts that recognize the functions to be fulfilled by findings of different types of similarity and access, despite their disapproval of having to decide on similarities twice and genuinely considering one as redundant.<sup>219</sup> Quite a few have clumsily applied the substantial similarity plus access test. They assess the relevant evidence, make findings, and then reach conclusions on infringement without clearly delineating the purposes of each determination.<sup>220</sup> That is why it remains obscure in Chinese practice whether the courts should decide substantial similarity before access or vice versa.<sup>221</sup> It is also why some courts erroneously apply the inverse ratio rule when dealing with substantial similarity (rather than probative similarity) and access.<sup>222</sup>

In summary, under the spillover from the U.S. test, China inadvertently created a version more tailored to its own legal system. However, the ambiguous functions of the test's components still need clarification. Only then can the customized test be used consistently and effectively to judge copyright infringement in Chinese cases.

Considering these points, the Article offers suggestions to refine China's substantial similarity plus access test. The goal is to eliminate uncertainties while maintaining the test's original framework, thereby minimizing the learning curve for Chinese judges. The Chinese approach should be revised to a substantial similarity plus independent creation defense test, with a strict sequence of evaluation. Chinese courts should initially determine whether the works in question are substantially similar, focusing on whether the defendant has taken copyrighted expressions from the plaintiff's work. Then, the courts should examine the possibility of independent creation by the defendant.

In deciding the second prong, courts can use their findings of similarity from the first phase as circumstantial evidence. Additionally, they should consider whether the defendant likely had access to the copyrighted work. Other forms of circumstantial evidence, such as the presence of common errors in both parties' works, may also support the assessment of independent creation. Still, the similarities and potential access to the copyrighted work are the most crucial types of circumstantial evidence for deducing actual copying, thereby negating the possibility of independent creation. Defendants can present evidence of their creation process to counter the inference drawn from the plaintiffs' evidence.

Moreover, in the revised test, Chinese courts can safely apply the inverse ratio rule in the second prong, allowing the degree of similarity identified in prong one to compensate for a lack of evidence regarding access. Striking similarities could negate the need for the plaintiff to prove access, aligning with practices some courts already employ though the reverse is not true.<sup>223</sup> The ultimate function of the new version of

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218. See *supra* Part IV.A.

219. See *supra* note 209 and accompanying text.

220. See *supra* notes 159–160 and accompanying text.

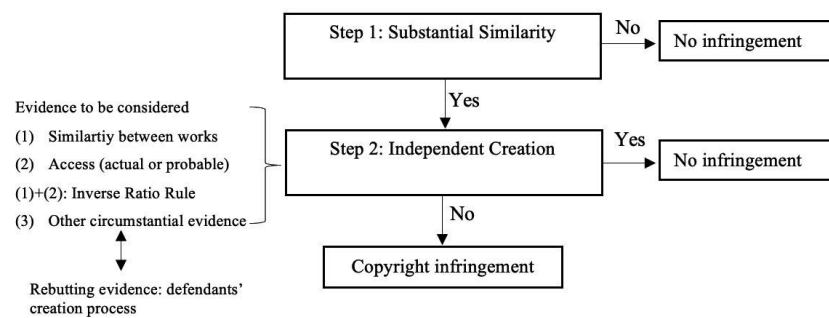
221. See *supra* notes 149–157 and accompanying text.

222. See *supra* notes 177–179 and accompanying text.

223. For cases where evidence of striking similarities between the works allows plaintiffs to dispense with the need to prove access, see, e.g., Xie Ziruo *yu* Xiangcheng Shuizhai Yimeng Fuzhuang Chang, Zhang

prong two, regardless of what circumstantial evidence courts pay more attention to, is to deal with the possibility of the defendant's independent creation such that the defendant shall be held liable for taking too much from the plaintiff's work (the function of the new version of prong one). Table 2 depicts the details and corresponding functions of the new version test.

**TABLE 2: DECISION PROTOCOLS: A REVISED COPYRIGHT INFRINGEMENT TEST IN CHINA**



While the current test is essentially holistic, allowing courts to make an overall analysis based on evidence of “access” and “substantial similarity” without a clear sequence, the revised test adopts a sequential approach with a strict order for evaluating the two components. This Article argues that the revised test offers several substantive benefits and addresses the pressing issues associated with the current test in China.

First and foremost, the revised test clearly defines the functions that each step is designed to achieve, thereby resolving the ambiguities that have confused Chinese courts when applying the current test. This clarity ensures more consistent application of the test and consideration of relevant evidence by courts, effectively addressing issues of judicial uncertainty. This stands in sharp contrast to the current holistic test, where courts conduct a combined analysis of both components without a clear

Hui Zhuzuoquan Quanshu, Qinquan Jiufen Yishen Minshi Panjueshu (谢子若与项城市水寨依梦服装厂、张辉著作权权属、侵权纠纷一审民事判决书) [First Instance Civil Judgment on the Copyright Ownership and Infringement Dispute Between Xie Ziruo and Xiangcheng Shuizhai Yimeng Garment Factory and Zhang Hui], 中国裁判文书网 [China Judgments Online] (Guangzhou Internet Ct., May 9, 2020 (China)); Xin Si Ke Ji You Xian Gong Si, Wu Han Xin Dong Ke Ji You Xian Gong Si Qin Hai Ji Suan Ji Ruan Jian Zhuo Zuo Quan Jiufen Er Shen Min Shi Pan Jue Shu (新思科技有限公司、武汉芯动科技有限公司侵害计算机软件著作权纠纷二审民事判决书) [Civil Judgment of the Second Instance in the Dispute over Infringement of Computer Software Copyright Between Synopsys Inc. and Wuhan Xindong Tech. Co., Ltd.], 中国裁判文书网 [China Judgements Online] (Sup. People's Ct., Feb. 25, 2021) (China).

understanding of the distinct functions each is supposed to fulfill.<sup>224</sup> In this way, different courts may require distinct evidence and corresponding burdens of proof based on their individual understanding of the components' functions, which can lead to judicial uncertainty and inconsistency.<sup>225</sup>

In addition to reducing judicial inconsistency stemming from the current holistic test, the revised test's strict sequence can address the significant problem of the excessively low threshold for the "access" prong, as identified in current literature. It is widely recognized by scholars<sup>226</sup> and confirmed by this Article's empirical evidence<sup>227</sup> that the threshold for satisfying the "access" prong in China is too low. One of the "pills" offered by these scholars focuses on increasing the burden of proof for the "access" prong, such as elevating the standard from "mere possibility of access" to "reasonable possibility of access."<sup>228</sup> Alternatively, they also argue for introducing "probative similarity" into the "access" prong in China, essentially enlarging the definition of "access" to make the evidentiary inference more reasonable.<sup>229</sup> In essence, the revised test aligns with the second approach to address the low-threshold issue, but it does so in a more comprehensible manner. For one thing, the revised test rejects the first approach because, as mentioned, the inverse ratio rule permits a low level of evidence on access when there is a high level of evidence on similarities.<sup>230</sup> Thus, setting a threshold for the evidence of access is unnecessary as long as courts learn to use evidence of similarities as a remedial point for circumstantial inference. Additionally, with similarities in place, the issue of a low threshold for the "access" prong ceases to be problematic when courts understand how to combine different types of circumstantial evidence in Step 2 of the revised test to draw reasonable inferences about factual copying.

For another, the revised test departs from the existing scholarly approach by refusing to expand the notion of "access" to include "probative similarities." The reason is that the literal meaning of "access" struggles to encompass "similarities." This counterintuitive expansion of the definition may lead to confusion among courts. Instead, it is more straightforward to use "independent creation" as a framework to incorporate various types of circumstantial evidence. This not only includes both "access" and "similarities" but also clearly delineates the function of Step 2 for the courts. Furthermore, since the independent creation step also considers the similarities between the works, the revised test strategically places it in Step 2, following the determination of substantial similarity in Step 1. This sequence allows courts to leverage the results from Step 1 in Step 2, thereby avoiding duplication of efforts and enhancing judicial efficiency.

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224. See *supra* Part II.

225. See *supra* Part II.

226. See, e.g., Zhou, *supra* note 21, at 110–13; Ding, *supra* note 21, at 25–26, 29; Liu, *supra* note 16, at 76–80.

227. See *supra* Part II.

228. See, e.g., Ding, *supra* note 21, at 29; Liu, *supra* note 16, at 77–80.

229. See, e.g., Ding, *supra* note 21, at 29–30; Liu, *supra* note 16, at 83–84.

230. See *supra* Part I.

Third, Chinese judges are familiar with the terminology, methods, approaches, and evidence utilized in the revised test. Many have frequently addressed issues of substantial similarity, access, and independent creation defense, albeit inconsistently and unsystematically.<sup>231</sup> The new version proposed here is a reshuffle and consolidation of the elements already familiar to them more systematically and clearly. It will present a minimal learning curve for Chinese judges. Also, to enhance the Chinese courts' understanding of the new version and the purpose of each step, future amendments to the PRC Copyright Act or judicial interpretations should explicitly recognize the test as substantial similarity plus independent creation defense. New provisions should clearly mention similarities and access as crucial circumstantial evidence in the second step while also acknowledging the possibility of considering other types of circumstantial evidence.

The proposal is not without any comparative support. Quite a few U.S. scholars have questioned the unsoundness of the current U.S. two-prong test and formulated reformed versions, which try to move the improper appropriation to the first step.<sup>232</sup> United States courts have not adopted any of these versions, possibly due to numerous procedural concerns. These concerns include the availability of expert witnesses and analytical dissection in each prong, the division between questions of fact and law, and the unique distribution of power between judges and juries in the U.S. judicial process.<sup>233</sup> However, it is important to note that the Chinese judicial system does not share these procedural concerns, as has been emphasized. Accordingly, there should be substantially fewer procedural hurdles for the Chinese courts to truly understand the meanings of substantial similarity and access and apply the new version in practice.

There may be arguments against conflating the two types of similarities as one in the proposed new version. For instance, certain U.S. scholars express significant concern over some U.S. courts conflating the two types of similarities. This conflation could result in courts halting their analysis at probative similarity without delving into whether these similarities constitute protectable expression that amounts to improper appropriation.<sup>234</sup> These scholars are concerned that permissible copying, such as the replication of uncopyrightable elements, might be wrongly prohibited, thereby disrupting the carefully delineated balance in copyright law.<sup>235</sup> However, though these concerns may be highly probable under the U.S. test, they are unlikely to exist in the Chinese context, even adopting the proposed new version because Step 1 of the new version is still substantial similarity. Previous writings have extensively argued that probative similarity is likely not recognized in Chinese courts. Typically, these courts assess similarities between copyrightable elements to determine substantial similarity

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231. See *supra* Part II.

232. See Balganes, *supra* note 9, at 858–62; Lemley, *supra* note 10, at 740–41.

233. This helps to explain why, when Professor Balganes attempts to formulate a new version, he has to very carefully argue how the new version can deal with the questions of fact and law, the judges' and juries' duties, and the availability of expert witnesses and analytical dissection. See Balganes, *supra* note 9, at 858–62.

234. See, e.g., Asay, *supra* note 9, at 77–78.

235. See, e.g., *id.*

rather than permitting the copying of ideas to meet this criterion.<sup>236</sup> As such, the proposed new version, emphasizing the original substantial similarity prong in Step 1, would not run the risk of wrongfully prohibiting permissible copying in China.

Another potential objection to the new version may lie in judicial efficiency. According to the argument, deciding the issue of actual copying before improper appropriation can filter out some cases where there is no copying by defendants but only independent creation at the early stage. For those cases, the judicial resources would no longer be wasted in determining the substantial similarity between works in the improper appropriation prong.<sup>237</sup> Likewise, this counterargument may be more plausible in the U.S. context but not in China. The reason is straightforward: the Chinese courts, under the current version of the test, would always decide on the substantial similarity issue, which is sometimes considered the sole or the most critical component in the whole copyright infringement analysis.<sup>238</sup> It is unlikely that they can dispense with the need to explore the substantial similarity issue as the threshold for access prong in China is very low.<sup>239</sup> Therefore, the proposed new version, which positions substantial similarity as the first step, is unlikely to significantly reduce judicial efficiency or waste resources in the non-copying cases in China compared to the current Chinese practice.

## V. CONCLUSION AND FUTURE DIRECTIONS

The test for copyright infringement is a pivotal issue in copyright law that requires more focused attention. Currently, Chinese courts and scholarly discussions take for granted the application of the golden test—substantial similarity plus access—in Chinese copyright cases. However, there is a notable lack of effort to explore the true meanings and functions of these two prongs. The current literature treats the Chinese test as a transplantation from the United States and thus carelessly equates the two without meaningful comparisons or deeper examination. This Article represents the first endeavor to demystify the substantial similarity plus access test in China, employing empirical and comparative analyses. Despite the spillover from the United States, our empirical findings and detailed comparison reveal significant differences between the two versions. The divergences raise questions about whether the different test works well in China and whether China should further transplant the entire test from the United States to achieve the desired functions.

Nevertheless, this Article argues that the substantial divergences in the Chinese test are justified, as the test is more attuned to the Chinese legal context. Unlike the U.S. test, the Chinese test does not rely on the procedural underpinnings unique to the U.S. judicial system. Additionally, the version currently used by Chinese courts brings some substantive advantages. However, the Chinese version has shortcomings, notably a lack

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236. See *supra* Parts II–III.

237. See Y'Barbo, *supra* note 10, at 297–300.

238. See Ding, *supra* note 21, at 24.

239. See Part III. See also *id.* at 28–29.

of a unified understanding of the objectives served by each prong, which have led to inconsistent applications, uncertain interpretations, and sometimes dubious decisions. Therefore, this Article proposes reforms to create a more streamlined and systematic approach to determining copyright infringement, aligning with the terminology, methods, and evidence familiar to Chinese judges. The revised test is designed to reduce ambiguities while preserving the framework of the original test, thus easing the learning curve for Chinese judges.

The findings in this Article also highlight potential directions for future research. Although the empirical findings primarily dissect the practical applications of the Chinese test, they provoke further questions. For example, the results indicate that when assessing substantial similarity, approaches vary depending on the type of copyrighted work involved. This variation raises important questions: Why do courts adopt different approaches, and should they continue to do so? Furthermore, it prompts consideration of whether a uniform test applicable to all types of works might be more desirable. These questions, while beyond the scope of this Article, are highly valuable for future studies.



## APPENDIX A: CODING SCHEME

**Case number**, is the official number issued by the courts for cases

**Court Level**, is the level of the court

- \* Supreme People's Court (SPC)
- \* High Court
- \* Intermediate Court
- \* Primary Court

**Court Location**, is the province where the court situates

**Decision Year**, is the year in which the decision was issued

### **Procedural Posture**

- \* First instance: the decision of the first instance
- \* Appeal: the appeal decision
- \* Retrial: the retrial decision

**Criteria 1: Type of Copyrighted Works**, is the statutory category of the work in issue

- \* Literary works
- \* Oral works
- \* Musical, dramatic, quyi, choreographic and acrobatic art works
- \* Artistic works
- \* Cinematographic works and works created in a way similar to cinematography (audiovisual works)
- \* Drawings of engineering designs and product designs, maps, sketches and other graphic works as well as model works
- \* Computer software
- \* Other works that meet the characteristics of works

**Criterion 2, Access**, is whether the court determines that the defendant had prior access to the copyrighted work

- \* Yes
- \* No
- \* N/A

**If Criterion 2 is Yes→Criterion 3, evidence** used by the court to establish access

- \* 1. Direct evidence
- \* 2. Potential access to P's work
  - \*2.1 P's work is published earlier than D's work
  - \*2.2 Widespread dissemination of P's work

- \*2.3 Some dissemination of P's work (e.g., some sales in public channels)
- \*2.4 P and D are in the same industry
- \* 3. Actual access to the work (e.g., prior dealings, relationships with P)
- \* 4. Striking similarities between the works
- \* 5. Suspicious facts (e.g., same technical errors in both works)

**If Criterion 2 is No→Criterion 4, reasoning** of the court

- \* 1. No evidence to show the publication date of P's work
- \* 2. P's work published later
- \* 3. Access evidence not sufficient

**Criterion 5, Inverse ratio rule used or not**

- \* Yes
- \* No

**Criterion 6, Copyright Dissection**, is whether the court dissected the works

- \* Yes
- \* No

**If Criterion 6 is Yes→Criterion 7, where** the court discussed the dissection

- \* 1. Before discussion on access + substantial similarity
- \* 2. After discussion on access + substantial similarity
- \* 3. After access but before substantial similarity
- \* 4. Within substantial similarity

**If Criterion 6 is Yes→Criterion 8, what** copyright exclusion doctrine discussed

- \* 1. Idea/Expression
- \* 2. Facts
- \* 3. *Scènes à faire*
- \* 4. Functional elements
- \* 5. Merger doctrine
- \* 6. Other public domain elements or public interest consideration

**Criterion 9, Substantial similarity**, is whether the court considered that the two works are substantial similar

- \* Yes
- \* No
- \* N/A

**Criterion 10, Method for judging substantial similarity**, is the approach(es) the court used to determine the substantial similarity

- \* 1. Qualitative
- \* 2. Quantitative
- \* 3. Compare overall appearance/impression (of the whole work)

- \* 4. Compare the dissected parts (the copyrightable parts)

**Criterion 11, Expert evidence**, is whether the court used expert evidence for the substantial similarity determination

- \* Yes
- \* No

**Criterion 12, Independent creation**, is whether the court discussed the possibility of independent creation

- \* Yes
- \* No

**If Criterion 12 is Yes→Criterion 13, where** the court considered the independent creation possibility

- \* 1. Before discussion on access + substantial similarity
- \* 2. After discussion on access + substantial similarity
- \* 3. Within access
- \* 4. Within substantial similarity

# Lift Ev'ry Voice and Sing: Tracing the Legacy of Appropriation of Black Artists Under U.S. Copyright Law

Sydni J. Wynter\*

## INTRODUCTION

On Wednesday, November 9th, 2023, Luke Combs took home the coveted “Song of the Year” distinction at the Country Music Awards for the song “Fast Car,” making it the first time a Black songwriter has won the award.<sup>1</sup> In reality, Combs is not Black, and the 2023 “Song of the Year” contender was recorded and released nearly thirty-five years ago.<sup>2</sup> Tracy Chapman, a Black queer woman, first released the folk classic “Fast Car” in 1988. The song retells the brutal reality of a young couple dreaming of a better life while struggling to break out of the cycle of poverty after a series of misfortunes in

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\* J.D. Candidate, Columbia Law School, Class of 2025; B.S., New York University, Class of 2022. I would like to express my deepest gratitude to Professor Philippa Loengard, my Faculty Advisor, for her invaluable guidance, wisdom, and for challenging me to look further and dig deeper throughout this process. I am also immensely grateful to Gabrielle Stanfield, 2024 Executive Notes Editor, and to the members of *The Columbia Journal of Law & the Arts*, Vol. 48, for their encouragement and support during the writing and editing process. Finally, I want to honor the countless Black artists whose creativity built, shaped, and enriched the American musical tradition—artists whose songs are celebrated yet whose names remain unsung. Their legacy resonates like a timeless melody, a testament to the enduring power of Black art.

1. Gloria Oladipo, *Tracy Chapman's Fast Car Wins Country Song of the Year—35 Years After Its Debut*, GUARDIAN (Nov. 9, 2023), <https://www.theguardian.com/music/2023/nov/09/tracy-chapman-fast-car-cma-winner> [https://perma.cc/J8UM-9HMY] [https://web.archive.org/web/20241113012200/https://www.theguardian.com/music/2023/nov/09/tracy-chapman-fast-car-cma-winner].

2. Jonathan Bernstein, *Tracy Chapman Just Became the First Black Songwriter To Win the CMA Song of the Year*, ROLLING STONE (Nov. 8, 2023), <https://www.rollingstone.com/music/music-country/tracy-chapman-luke-combs-fast-car-song-of-the-year-2023-cmas-1234873495/> [https://perma.cc/8FCY-DXL5] [https://web.archive.org/web/20241005191639/https://www.rollingstone.com/music/music-country/tracy-chapman-luke-combs-fast-car-song-of-the-year-2023-cmas-1234873495/].

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their lives.<sup>3</sup> While Chapman's song received some critical acclaim in the United States after its initial release, reaching the sixth spot on the Billboard 100 chart for a week in 1988, Combs's 2023 cover of "Fast Car" peaked at number two on the same chart and remained in the top 10 for forty-two weeks.<sup>4</sup> Section 115 of the Copyright Act permits artists to reproduce covers of another artist's commercially released music without seeking permission from the original artist.<sup>5</sup> This covering and re-popularization of Tracy Chapman's folk classic is not a rare occurrence, but is rather exemplar of a long tradition of the lifting—or rather appropriation—of Black music for a mainstream audience by white artists.<sup>6</sup> The tale of Black musicians in the United States is one defined by an extensive history of exclusion, exploitation, and most enduringly, appropriation.<sup>7</sup>

From the inception of America itself, the Founding Fathers recognized the value in producing, protecting, and promoting creative works by the public. Enshrined in the Constitution itself, Congress was unanimously granted the power to "promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>8</sup> The enactment of a national copyright law thus stood to foster the development of a competitive American culture, and help to balance the public value of creative works

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3. Tina Benitez-Eves, *The Non-Vehicular Meaning Behind Tracy Chapman's 1988 Hit "Fast Car"*, AM. SONGWRITER (May 16, 2024), <https://americansongwriter.com/the-non-vehicular-meaning-behind-tracy-chapmans-1988-hit-fast-car/> [https://perma.cc/WGL6-FKC2] [https://web.archive.org/web/20241005191852/https://americansongwriter.com/the-non-vehicular-meaning-behind-tracy-chapmans-1988-hit-fast-car/]; See also Aurelie Moulin, *Fast Car by Tracy Chapman: Everything About "Fast Car"*, TRACY CHAPMAN ONLINE (May 28, 2023), <https://www.about-tracy-chapman.net/tracy-chapman-fast-car-meaning-fast-car-lyrics-fast-car-videos/#fast-car-meaning> [https://perma.cc/L44P-54US] [https://web.archive.org/web/20241221223830/https://www.about-tracy-chapman.net/tracy-chapman-fast-car-meaning-fast-car-lyrics-fast-car-videos/#fast-car-meaning].

4. Luke Combs's rendition of Chapman's song has now charted for sixty-three weeks as of November 24, 2024. See *Tracy Chapman Chart History*, BILLBOARD, <https://www.billboard.com/artist/tracy-chapman/chart-history/tlp/> [https://perma.cc/C34K-QLFL] [https://web.archive.org/web/20241005192244/https://www.billboard.com/artist/tracy-chapman/chart-history/tlp/] (last visited Nov. 24, 2024); *Luke Combs Chart History*, BILLBOARD, <https://www.billboard.com/artist/luke-combs/> [https://perma.cc/B8BH-2AQR] [https://web.archive.org/web/2024112230318/https://www.billboard.com/artist/luke-combs/] (last visited Oct. 5, 2024).

5. 17 U.S.C. § 115(a)(2).

6. See Emily Yahr, *Tracy Chapman, Luke Combs and the Complicated Response to "Fast Car"*, YAHOO ENT. (July 13, 2023), <https://www.yahoo.com/entertainment/tracy-chapman-luke-combs-complicated-150744898.html> [https://perma.cc/2CSG-DLF8] [https://web.archive.org/web/20230715155921/https://www.yahoo.com/entertainment/tracy-chapman-luke-combs-complicated-150744898.html].

7. While other ethnic and racial subgroups undoubtedly faced struggles in gaining legal recognition and protection for their respective contributions to the development of American popular culture, this Note will focus specifically on the struggle of Black American artists. It will trace the unique fight for Black Americans to gain recognition, protection, and compensation for their inherent involvement in the popularizing of American musical genres and subcultures in light of an extensively documented legal, economic, social, and political struggle.

8. U.S. CONST. art. I, § 8, cl. 8.

with author's property rights in their creations.<sup>9</sup> The eighteenth, nineteenth and twentieth centuries birthed five iterations of the Copyright Act: in 1790, 1831, 1870, 1909, and the modern Copyright Act of 1976.<sup>10</sup> Notably, no version of copyright law has explicitly mentioned race, which aids in perpetuating the idea that copyright is inherently "colorblind." However, copyright law has consistently failed to adequately recognize and protect Black musicians since its inception.<sup>11</sup>

First outlined in the Constitution under the "Copyright clause," the earliest iteration of an intellectual property right did not apply to Black Americans, who—as slaves—were not considered a full person at the time of writing, and therefore unable to own any type of property.<sup>12</sup> To call the system racially neutral would assume that copyright and intellectual property rights have existed within a vacuum—unaffected by the social, cultural, and political structures that have denied Black Americans equal citizenship since America's founding.<sup>13</sup> As Black musical traditions have undoubtedly formed, shaped, and molded the very bedrock of American popular culture, and nearly every genre of music it has produced, the inability for copyright law to adequately rectify shortcomings in the music business through statutory protection has greatly contributed to the persistence of a culture of appropriation within the culture of American music. It is therefore not that Copyright has a "race" problem, it has an *appropriation* problem—one that undeniably and disproportionately impacts Black artists. To best reform the copyright system to address modern issues of appropriation, considering technological advancements in the music industry such as artificial intelligence and the rise of streaming, it is necessary to understand the historical patterns of copyright inequity that have disproportionately affected Black musicians.

The inherently intertwined nature of Black music and Black culture—with Black musical traditions being borne out of the social, political, and economic disenfranchisement of the community throughout history—exacerbates the harm felt by artists who have their work lifted without appropriate compensation. Between the rise of streaming allowing more independent artists to produce music without the legal knowledge that major labels possess, and the generation of artificial intelligence

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9. Irah Donner, *The Copyright Clause of the U. S. Constitution: Why Did the Framers Include it with Unanimous Approval?*, 36 AM. J. LEGAL HIST. 361, 362 (1992).

10. *A Simple Guide to U.S. Copyright Law*, COPYRIGHTLAWS.COM (Aug. 22, 2022), <https://www.copyrightlaws.com/a-simple-guide-to-u-s-copyright-law> [<https://perma.cc/WK42-VG9L>] [<https://web.archive.org/web/20241008203505/https://www.copyrightlaws.com/a-simple-guide-to-u-s-copyright-law/>].

11. K. J. Greene, *Copyright, Culture & (and) Black Music: A Legacy of Unequal Protection*, 21 HASTINGS COMM'NS & ENT. L.J. 339, 340 (1998) (noting that "African-American music artists, as a group, were routinely deprived of legal protection for creative works under the copyright regime.").

12. While there is substantial scholarship, debate, and opinion on the etymological impact and difference between the uses of "African American" versus "Black" to describe Black people in the United States, I will not use the terms interchangeably throughout this Note. I use "African American" to specifically describe to describe Africans that were enslaved and brought to America, and their descendants who reside in America to this day. My use of "Black," however, is inclusive of all racially Black people of the diaspora in the United States regardless of nationally, ethnicity, or ancestral origin. Black will be capitalized, as it incorporates not only a color, but a race, culture, history, and way of existing.

13. *Id.* at 342.

allowing fans to produce music by their favorite artists without the artists' input or knowledge, new technology has created a unique opportunity to alter the existing legal framework of copyright.<sup>14</sup> Specifically, lawmakers have the rare opportunity to reform the existing licensing substructure. Compulsory mechanical licenses in particular have historically perpetuated these behaviors, and in the modern context could potentially aggravate these issues.

This Note will trace the lineage of the structural inequities of copyright law that have generationally impacted Black musicians across genres, arriving to modern day issues and the technological advances that inflame these very inequities. While beginning with a conveyance of the statutory provisions that aided in unequal treatment of Black artists under copyright law is crucial, the focus of analysis and critique will center on copyright law's development of the compulsory licensing scheme and its unique impact on Black artists by questioning the efficacy of the existing licensing structure. Parts I and II will look at the earliest iterations of the Copyright Act: from 1790 to 1909, and the legal status of Black Americans through a series of case studies looking at the Act's effect on Black artists during the emergence of American Popular music in jazz, blues, and rock'n'roll. Part III will examine the creation of modern copyright law against the backdrop of the Civil Rights movement and the emergence of rhythm & blues and hip-hop. Part IV will argue the shortcomings of the 1976 Act and modern challenges that copyright law is unequipped to address and suggest the adoption of an institutional moral right standard for musicians under Copyright law.

The development of artificial intelligence and its ability to replicate the style of artists, alongside the growing presence of digital streaming and independent artistry reinvigorates the continued tradition of the appropriation of Black artists. The modern issues Black artists face in these realms are not occurring in a vacuum but are rather a product of a tradition of imitation, appropriation, and distortion under the copyright scheme—and is therefore pertinent to contextualize the historical treatment of African Americans under intellectual property laws to best address the continuation of these issues in a new generation of music.

## I. PART ONE: EARLY COPYRIGHT LAW<sup>15</sup>

Despite the cultural, historical, and social importance of early musical traditions developed by African slaves and their descendants, not only as the basis of Black

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14. Joe Coscarelli, *An A.I. Hit of Fake 'Drake' and 'The Weeknd' Rattles the Music World*, N.Y. TIMES (Apr. 19, 2023), <https://www.nytimes.com/2023/04/19/arts/music/ai-drake-the-weeknd-fake.html> [https://web.archive.org/web/20241008203930/https://www.nytimes.com/2023/04/19/arts/music/ai-drake-the-weeknd-fake.html].

15. There is no definitive record or consensus on when the first copyright was granted to a Black artist, as the U.S. Copyright Office, in its current practice, does not request racial information during copyright registration. Additionally, earlier versions of the Copyright Act included requirements such as citizenship, alongside other legal and social barriers, which often prevented Black artists from accessing copyright protection. These historical challenges will be explored in the following sections.

American culture, but as the predecessor of nearly every American musical genre, protection was not afforded to these works under the earliest iterations of copyright law.<sup>16</sup> The earliest comprehensive copyright statute, the Copyright Act of 1790 expressly provided protection only to citizens of the United States. The Constitution enumerated the so-called “three-fifths” clause, which considered slaves to be three-fifths of a person.<sup>17</sup> As property themselves, Black slaves were unable to hold or own their property, including intellectual property.<sup>18</sup> Black Americans, regardless of whether they were free or enslaved, were not considered citizens, and therefore lacked the legal standing to register copyrights.<sup>19</sup> The emancipation of enslaved peoples in 1863 and granting of legal citizenship with the passing of the Thirteenth and Fourteenth Amendments in late 1800s led to the first opportunity for Black artists to gain ownership in their work.<sup>20</sup>

The existing legal structures, however, were incompatible with the reality Black artists faced. The Copyright Act of 1870 had stringent formal requirements for protection, including notice, registration, publication, and distribution requirements.<sup>21</sup> In the 1800s, all but three slave states had stringent laws that banned the teaching of slaves to read and write.<sup>22</sup> With much of the formerly enslaved population fully or partially illiterate, proper notation and registration was unrealistic. Additionally, fixation and publication requirements were at odds with Negro spiritual traditions such

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16. See Greene, *supra* note 11; see also *The 18th Century, Highlight: Congress Passes First Copyright Act*, COPYRIGHT.GOV, [https://www.copyright.gov/timeline/timeline\\_18th\\_century.html](https://www.copyright.gov/timeline/timeline_18th_century.html) [<https://perma.cc/WS7G-FKX6>] [[https://web.archive.org/web/20241009203053/https://www.copyright.gov/timeline/timeline\\_18th\\_century.html](https://web.archive.org/web/20241009203053/https://www.copyright.gov/timeline/timeline_18th_century.html)] (last visited Oct. 8, 2024) (The first Copyright Act was passed in 1790—a time in which African slaves and their descendants were not considered citizens, or even humans (but rather property), and were therefore unable to protect their works under this law.).

17. U.S. CONST. art. I, § 2, cl. 3.

18. See Greene, *supra* note 11, at 346.

19. The Copyright Office lacks historical records as to when the first musical copyright was filed by a Black American, either due to inadequate records or the non-disclosure of race in registration, and available scholarship lacks a clear consensus on who the figure may be. However, the “first commercially black songwriter” is argued to be James A. Bland (1854–1911), who became popular overseas. See LARRY STARR & CHRISTOPHER WATERMAN, *AMERICAN POPULAR MUSIC: FROM MINSTRELSY TO MP3*, 16 (condensed ed., U.S. Dep’t of State).

20. *14th Amendment to the U.S. Constitution: Civil Rights (1868)*, NAT’L ARCHIVES, <https://www.archives.gov/milestone-documents/14th-amendment> [<https://perma.cc/5YN3-XWU9>] [<https://web.archive.org/web/2024111070519/https://www.archives.gov/milestone-documents/14th-amendment>] (last visited Oct. 8, 2024).

21. *The 19th Century, Highlight: Supreme Court Decides First Copyright Case*, COPYRIGHT.GOV, [https://www.copyright.gov/timeline/timeline\\_19th\\_century.html](https://www.copyright.gov/timeline/timeline_19th_century.html) [<https://perma.cc/8PM8-NW3R>] [[https://web.archive.org/web/20241009203409/https://www.copyright.gov/timeline/timeline\\_19th\\_century.html](https://web.archive.org/web/20241009203409/https://www.copyright.gov/timeline/timeline_19th_century.html)] (last visited Feb. 25, 2024).

22. *Literacy as Freedom*, SMITHSONIAN AM. ART MUSEUM: THE AM. EXPERIENCE IN THE CLASSROOM, at 1, <https://americanexperience.si.edu/wp-content/uploads/2014/09/Literacy-as-Freedom.pdf> [<https://perma.cc/AV2R-UWKU>] [<https://web.archive.org/web/20241009203637/https://americanexperience.si.edu/wp-content/uploads/2014/09/Literacy-as-Freedom.pdf>] (last visited Jan. 25, 2024).



as the practice of call and response.<sup>23</sup> This led to two trends that remain pervasive in the entertainment industry's treatment of Black artists. Firstly, convoluted registration requirements led to exploitative contracts and practices that preyed on the vulnerabilities of musicians and failed to adequately compensate them for their work.<sup>24</sup> Secondly, it led to the outright appropriation of Black musical works by white artists who were better versed in the formalities in copyright law and were therefore granted ownership in the works.<sup>25</sup>

#### A. NOBODY KNOWS DE TROUBLE I'VE SEEN: THE BIRTH OF AMERICAN POPULAR MUSIC (1619–1900)

"Nobody knows de trouble I've seen. Nobody knows but Jesus."

- Unpublished Negro Spiritual<sup>26</sup>

### 1. The History of Negro Spirituals

African Americans have formed the very bedrock of American popular music culture including inventing and invigorating genres of music from spirituals and jazz to rhythm and blues, rock, and roll, and hip-hop. Arguably, no sub-group of America has been more influential to the creation and development of American culture than Black America.<sup>27</sup> Black music is a direct reflection of the collective Black experience across generations, defined by adaptation, survival, resilience, and the retention of African culture and influences.<sup>28</sup> As such, Black music and Black culture are inherently intertwined—with music generationally employed as a method of expressing freedom, inspiration, and spirituality, which renders the effect of inequity in the law and music

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23. "Call and response" refers to an African musical technique, born out of religious and social traditions, in which music is performed in a question-and-answer format, with a leader prompting the audience. This practice continues in Black musical tradition today and is reflected in genres such as gospel, jazz, blues, and rap. See Adam Longman Parker, *Afrika Presents Principles of Black Music: Call & Response*, ABLETON, <https://www.ableton.com/en/blog/afrika-presents-principles-of-black-music-call-response> [https://perma.cc/7CC2-JKYR] [https://web.archive.org/web/20241009204010/https://www.ableton.com/en/blog/afrika-presents-principles-of-black-music-call-response/] (last visited Jan. 25, 2024).

24. See Greene, *supra* note 11, at 341.

25. *Id.* at 341 n.4.

26. "Nobody Knows De Trouble I've Seen," is an African American spiritual well-known among the Black enslaved population. Despite being performed for centuries, the spiritual was only first published and registered for copyright in 1917. See "*Nobody Knows De Trouble I've Seen*" by Harry Thacker Burleigh, LIBRARY OF CONGRESS, <https://www.loc.gov/item/ihas.200185372/> [https://perma.cc/Y8FB-E8RV] [https://web.archive.org/web/20241105033557/https://www.loc.gov/item/ihas.200185372] (last visited Nov. 4, 2024). The song was later recorded and released by numerous Black musical icons, including Louis Armstrong and Marian Anderson. See also *African American Spirituals*, LIBRARY OF CONGRESS, <https://www.loc.gov/item/ihas.200197495/> [https://perma.cc/ZM65-2X2P] [https://web.archive.org/web/20241221225139/https://www.loc.gov/item/ihas.200197495/] (last visited Nov. 25, 2024).

27. See Greene, *supra* note 11, at 361.

28. *Id.* at 362.

business even more detrimental. The earliest of these traditions grew from the folk-song traditions of Black slaves, a sacred fusion between the musical rituals of Africa and the emerging religious versification arising from the difficulties of plantation life.<sup>29</sup> These folk songs were often performed during informal gatherings—performed as celebrations of gospel, recognition of suffering, and even as ways to communicate escape routes.<sup>30</sup> They were not only used for religious purposes, or as freedom songs, but were also sung by enslaved Africans day to day as working tunes.<sup>31</sup> While written collections of these spirituals have been published and passed down, the Negro spiritual was grounded in orality through call and response form between community members.<sup>32</sup> Viewing these spirituals as a form of resistance, communication, and resilience, the songs were regularly banned on plantations throughout the eighteenth century.<sup>33</sup>

## 2. The Minstrel Show and the Birth of Appropriation

While the earliest forms of Black musical artistry were denied protection under intellectual property laws, the popularity and distinctiveness of early Black music traditions birthed what is arguably the “first distinctively American form of popular culture” leading to “the rise of the modern music industry”—the minstrel show.<sup>34</sup> The practice of minstrelsy consisted of white theatrical and musical performers adorned in blackface, performing songs in the Black traditional style, meant to imitate, parody, and ridicule enslaved Black Africans.<sup>35</sup> The first in a generational, centuries-long tradition of the imitation and appropriation of Black musicians, minstrelsy created an entire entertainment subculture that relied upon the subjugation of Black people, Black culture, and Black creation.<sup>36</sup> Aiming to perpetuate racist stereotypes about Black Americans and their culture, minstrelsy appropriated African American music, dance, and vernacular for the amusement of white audiences. Gaining popularity in the decades surrounding the Civil War, the performance genre became the dominant form

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29. David Dante Troutt, *I Own Therefore I Am: Copyright, Personality, and Soul Music in the Digital Commons*, 20 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 373, 397 (2010).

30. Gennette Cordova, *Negro Spirituals Are the Foundation of Black American Music, Its Traditions Come Full Circle with Hip Hop*, REVOLT (June 14, 2021), <https://www.revolt.tv/article/2021-06-14/51382/negro-spirituals-are-the-foundation-of-black-american-music-its-traditions-come-full-circle-with-hip-hop/> [https://perma.cc/DGS5-6G35].

31. *Id.*

32. *Id.*

33. *Id.*

34. See STARR & WATERMAN, *supra* note 19, at 12.

35. *Blackface: The Birth of an American Stereotype*, NAT'L MUSEUM AFRICAN AM. HISTORY AND CULTURE, <https://nmaahc.si.edu/explore/stories/blackface-birth-american-stereotype> [https://perma.cc/M93Y-8PGM]

[https://web.archive.org/web/20241008175116/https://nmaahc.si.edu/explore/stories/blackface-birth-american-stereotype] (last visited Jan. 25, 2024) (Blackface was the offensive practice of using burnt cork or black makeup, alongside tattered clothes and exaggerated behavior as an attempt to resemble Black Africans.).

36. *Id.*

of entertainment in the mid-to-late nineteenth century.<sup>37</sup> From minstrelsy grew a booming American music publishing business, which included descendant genres such as vaudeville and music hall leading to the establishment of Tin Pan Alley.<sup>38</sup> Tin Pan Alley consisted of sheet music publishing houses that dominated the music industry for nearly a century—producing “plantation songs” and other derivatives of Negro spirituals and African American music traditions.<sup>39</sup> On a larger scale, minstrelsy and its lasting popularity and influence across generations and technological mediums, formed the basis of the continued custom of distorting Black music for the mainstream appeal to white audiences.<sup>40</sup> The eighteenth and nineteenth centuries thus saw the emergence of American Popular music, beginning with the birth of the Negro Spiritual as a method of both entertainment and communication. This period also began a legacy that would impact Black artists for decades to come: the inability for copyright to adequately protect Black artists from a system of appropriation, imitation, and commodification.

## II. PART TWO: THE 1909 ACT

The development of a more robust Copyright framework considering rapid change in the entertainment industry greatly altered the story of Black music. The intersections of persistent social, economic, and legal inequality, predatory practices within the music industry, and the failure of copyright law to safeguard Black musicians against these systemic failures continued throughout the early twentieth century. The Copyright Act of 1909 (“The 1909 Act”) was the first significant overhaul of the copyright statute in its history. Representing a crucial moment in the development of intellectual property law, the 1909 Act revised and adopted numerous features to address the rapid growth of the musical industry in the beginning of the twentieth century. By the time of the 1909 Act, three distinctively Black music forms had materialized: blues, jazz, and rock and roll.<sup>41</sup> The emergence of these genres ultimately shaped the way music was produced, performed, and consumed. However, the 1909 Act was largely criticized by scholars to be incoherent, inconsistent, and opaque. First, the scope of what constituted a protected work was greatly expanded under this Act to expressly include musical compositions, commercial art, nondramatic literary works, and more.<sup>42</sup> The 1909 Act also provided for a public performance right for musical

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37. See STARR & WATERMAN, *supra* note 19, at 13.

38. *Id.* at 16. (“Tin Pan Alley” refers to a physical row of publishing houses on West 28<sup>th</sup> Street in New York City in the 1890s. Following the rising popularity in modern “popular” music, as opposed to classical music, Jewish immigrants created small publishing houses that specialized in producing sheet compositions for this emerging style of music—arranging their offices along 28<sup>th</sup> Street. Tin Pan Alley music would go on to “dominate[] [the] American music industry for almost 70 years.”).

39. *Id.*

40. See Troutt, *supra* note 29, at 398.

41. See Greene, *supra* note 11, at 353.

42. 1900–1950, *Highlight: Congress Passes First Comprehensive Copyright Law of the Twentieth Century*, COPYRIGHT.GOV, [https://www.copyright.gov/timeline/timeline\\_1900-1950.html](https://www.copyright.gov/timeline/timeline_1900-1950.html) [https://perma.cc/HKN4-2D7E]

compositions.<sup>43</sup> This meant revenue garnered from records sales, record play, and broadcast transmission of the phonorecords benefitted the owners of the underlying musical composition, normally the music label or publishing company, but not the artists whose performances *were* the record.<sup>44</sup>

Another one of the distinctive, consequential features of the 1909 Act was the establishment of new formality requirements. Under this Act, copyright protection was not automatically granted once an original creation was authored, but rather relied on a complex and convoluted system of notice and registration.<sup>45</sup> While these changes were intended to clearly notify the public as to who retained the rights in a work, they created additional challenges for artists who were unversed in legal jargon and without adequate legal resources. Works that failed to meet the notice requirements automatically fell into the public domain and were open to use by the public.<sup>46</sup> Artists unfamiliar with or lacking the knowledge of the formal requirements for notice, registration, and publication could easily find their works thrust into the public domain—with it, a forfeiture of all of their exclusive economic interests in the works.<sup>47</sup> The stringent registration requirements of prior copyright Acts remained, with notice, deposit, renewal, and fixation requirements working to limit the amount of works that received protection, rather than entering the public domain. These factors worked to the detriment of Black artists that bore the brunt of these formalities.<sup>48</sup> Additionally, under the 1909 Act, the creator of a work was not granted the presumption of ownership, but could rather be claimed by any individual.<sup>49</sup> This disproportionately affected Black artists, whose “highly original, innovative and valuable works” were “frequently found [to be] used or copyrighted by a non-creator who was clever enough to secure copyright on the works.”<sup>50</sup> These statutory provisions aided in predatory and discriminatory business practices that exploited the ignorance of Black artists as to the rights in their work and the proper procedure in securing these rights.

Copyright scholar K. J. Greene noted four apparent patterns of appropriation that occurred during this period.<sup>51</sup> The first was creation of works by Black artists, followed by the outright appropriation of the works by major labels and white artists.<sup>52</sup> This pattern was most common in the earliest part of the twentieth century amongst jazz

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[[https://web.archive.org/web/20241005133206/https://www.copyright.gov/timeline/timeline\\_1900-1950.html](https://web.archive.org/web/20241005133206/https://www.copyright.gov/timeline/timeline_1900-1950.html)] (last visited Jan. 25, 2024).

43. *Id.* The 1909 Act did not provide protection for sound recordings until an amendment in 1972, nor did it address the granting of a public performance right for sound recording. With most Black musicians making a living through live performances of their works, their contributions to the music industry were denied adequate protection under the statute.

44. *See* Greene, *supra* note 11, at 368.

45. *Id.* at 353–54.

46. *See* COPYRIGHT.GOV, *supra* note 42.

47. *See* Greene, *supra* note 11, at 354.

48. K. J. Greene, *Thieves in the Temple: The Scandal of Copyright Registration and African-American Artists*, 49 PEPP. L. REV. 615, 629 (2022).

49. *See* Greene, *supra* note 11, at 353.

50. *Id.* at 353–54.

51. *Id.* at 372.

52. *Id.*

and blues musicians who sought no protection for their works, were often illiterate, and were at the whim of carnivorous club owners and promoters.<sup>53</sup> The second of these patterns, and one that covertly remains applicable in the modern music landscape, is creative innovation by Black artists, followed by a usurpation of copyright ownership by labels or managers.<sup>54</sup> A number of famous Black musicians, like Chuck Berry, throughout the twentieth century sold off the rights to their compositions to major labels for immediate compensation, but in the totality of their worth were “absurdly small sums.”<sup>55</sup> The last two patterns describe the creation of a new style or genre of music that is then imitated or distorted by white performers (either for entertainment or ridicule) for economic and commercial gain.<sup>56</sup> While meant to protect the creation of artists and promote harmony among a burgeoning music industry, the 1909 Act rather contributed to a continued culture of the exploitation of artists to their moral, cultural, and economic loss.

#### THE CREATION OF THE COMPULSORY MECHANICAL LICENSE

While rigorous formalities and registration requirements under the 1909 Act created barriers for the protection of Black musicians, it additionally created a legal path for the appropriation of Black musicians for generations to come. The Act notably created copyright law’s first compulsory license—a provision that impacted all artists but had a particularly injurious effect on Black artists. This was a provision that significantly impacted the music industry and the dynamics of the compensation scheme for artists.<sup>57</sup> The license was a direct result of the landscape of the music industry at the time: grappling with the rising popularity of phonorecords and allowing for the mass distribution of sheet music due to publishing associations such as that of Tin Pan Alley. The licensing scheme was codified in Section 1(e) of the 1909 Copyright Revision Act stating:

*[A]s a condition of extending the copyright control to such mechanical reproductions, that whenever the owner of a musical copyright has used or permitted or knowingly acquiesced in the use of the copyrighted work upon the parts of the instruments serving to reproduce mechanically the musical work, any other person may make similar use of the copyrighted work upon the payment to the copyright proprietor of a royalty of two cents on each such part manufactured.*<sup>58</sup>

The compulsory mechanical license allowed anyone to reproduce a musical composition that has been distributed to the public, with or without the consent of the

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53. *Id.*

54. *Id.*

55. *Id.* at 372–73.

56. *Id.* at 373.

57. See Howard B. Abrams, *Copyright’s First Compulsory License*, 26 SANTA CLARA HIGH TECH. L.J. 215, 221 (2010).

58. Copyright Act of 1909, Pub. L. No. § 1, 35 Stat. 1075 (1909) (second emphasis added) (prior to repeal by 1976 Act).

copyright owner, so long as a royalty was paid to the copyright owners and other statutory provisions were complied with.<sup>59</sup> The licensing scheme was developed out of a fear throughout the industry over the ownership of a significant number of musical compositions and piano rolls by a single publishing company that could have potentially created a monopolistic power over the recording of music.<sup>60</sup>

The original compulsory licensing scheme had three key features: (1) notice; (2) similarity; and (3) compensation.<sup>61</sup> Once an artist published their musical composition, other artists can also reproduce the song if they provide notice, rather than seek permission, from the copyright owner. While this provision was intended to prevent publishing associations and record companies from creating near-monopolies by acquiring copyright ownership over a significantly sized catalog and barring the recording and public performance of the works, the licensing scheme inherently contradicts the goals of copyright law.<sup>62</sup> From the point of view that copyright aims to incentivize creation by granting artists exclusive rights and limited monopolies in their works, the compulsory licensing scheme subverts this goal by allowing artists to profit off of their works with a mere writing credit and fairly low compensation. In considering the moral rights theories of copyright law that suggest that the law should afford rights to creators because the works are a product of their labor, denying artists control over their works—and who reproduces them—undermines this very principle. In any other medium, the direct copying of someone's existing work would be considered infringement. The compulsory licensing scheme not only permits but *encourages* copying—to the detriment of Black artists who had their works covered and popularized by white artists who could appeal to a wider audience.<sup>63</sup> The provision effectively carves out an exception for infringement and appropriation of non-dramatic music works, which includes American popular songs. The negative effect of this provision is most prevalent in the era of rock and roll, which will be discussed later in this Note.

The 1909 provision specifically states that another person may make “similar use” of a mechanical reproduction, but fails to address whether “similar use” means: an exact reproduction of the musical composition, a new take on the underlying musical composition, or a combination of both. The line between an exact reproduction and a derivative of the original author's works should both facially be considered infringement, but the allowance of either imposes differing consequences on the original artist. While an exact reproduction may usurp the market for the original, as was often the case with the lifting of songs by Black artists, the ability for artists to make a derivative (slightly different, a remix, or adaptation in another genre) infringes upon an entirely different exclusive right of the original author (the exclusive right to prepare a derivative work). Some scholars note that the very creation that results from a

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59. H.R. REP. NO. 94-1476, at 106–07 (1976).

60. See Abrams, *supra* note 57, at 218.

61. Copyright Act of 1909 § 1(e).

62. H.R. REP. NO. 94-1476, at 107–09.

63. Vincent R. Johnson II, Comment, *Sampling as Transformation: Re-Evaluating Copyright's Treatment of Sampling To End Its Disproportionate Harm on Black Artists*, 70 AM. U. L. REV. F. 227, 235, 261 (2021).

compulsory license is necessarily a derivative work, as a sound recording of an underlying musical composition the party lacks ownership in.<sup>64</sup>

The compulsory licensing scheme in Section 1(3) of the 1909 Act ultimately codified, and created a legal protection, for the lifting of music from the Black community for white artists. This created an avenue for the popularization of white musical icons across genres throughout the twentieth century off of the backs of African American artists who received little credit or compensation for their work. The compulsory license created difficult and contrasting implications for Black artists. On one hand, it augmented the potential for Black artists to gain some form of recognition by larger, mainstream artists covering their work. However, this idea relies on the implication that proper credit was given to the original artist. Black songwriters and composers were often unaware of the value of their publishing rights, which were contractually given to white record companies.<sup>65</sup> Therefore, any significant revenue garnered by the covering of their songs by mainstream artists did not benefit the original creators. On the other hand, compulsory licensing had set industry standards, an industry in which Black artists had unequal bargaining power and often faced discrimination in a white-dominated industry.

#### A. STRANGE FRUIT: JAZZ, JIM CROW, AND THE RACIAL DIVIDE

"Southern trees bear a strange fruit. Blood on the leaves, and blood at the Root. Black bodies swingin' in the Southern breeze."

- Strange Fruit, Billie Holiday<sup>66</sup>

#### 1. The Birth of Jazz, Swing, and the Black Blues

The 1909 Act, though representing a substantial reform in copyright law regarding protection and registration, propelled the legal challenges confronting Black musicians into the twentieth century amidst ongoing social, economic, and political struggles for Black Americans. The turn of the twentieth century saw the interplay between Jim Crow segregation, mass migration, and the emergence of a Black cultural and artistic renaissance.<sup>67</sup> One of the most culturally defining by-products of this era was the birth of one of the first American-borne genres of music: jazz.<sup>68</sup> At its very core, jazz is emblematic of America itself: a fusion of culture, language, and exploration. The genre, which emerged from New Orleans in 1900, drew from African American spirituals and blues, ragtime, marching bands, and cultural influences from Europe and the

64. See Abrams, *supra* note 57, at 228.

65. See Greene, *supra* note 11, at 372.

66. BILLIE HOLIDAY, STRANGE FRUIT (Commodore Records 1939).

67. *Harlem Renaissance*, HISTORY.COM, <https://www.history.com/topics/roaring-twenties/harlem-renaissance> [https://perma.cc/PB8N-ZKRY] [https://web.archive.org/web/20241005215332/https://www.history.com/topics/roaring-twenties/harlem-renaissance] (last visited Feb. 25, 2024).

68. See STARR & WATERMAN, *supra* note 19, at 20.

Caribbean.<sup>69</sup> The rise and popularity of the genre and its distinctive style were largely due to the adaptation of Black artists' music for segregated audiences and the need for new musical forms to overcome economic marginalization after the emancipation and mass migration of former enslaved peoples.<sup>70</sup> Jazz music became, and remained, a cultural-defining platform. It allowed Black Americans to establish a new form of expression, identification, and artistic recognition.<sup>71</sup> Many of the pioneering musicians that aided in the rise in popularity of jazz music had roots in traditional forms of Black music, such as spirituals, religious hymns, and blues, before joining the "Great Migration of blacks fleeing lynching and Jim Crow oppression" and economic liberation in northern and western cities.<sup>72</sup> Coupled with the rapid rise in new technologies that revolutionized the way that people interacted with music, such as radio, television, records, and the 'soundtrack,' the music sector experienced rapid expansion and commercialization.<sup>73</sup>

Despite the popularity and ingenuity of the Jazz and Blues genres, Black musicians continued to face persistent discrimination and appropriation at the hands of white artists and major labels who failed to see the appeal of Black music beyond a Black audience.<sup>74</sup> In the upper echelons of society, Hollywood and the Upper classes adopted Jazz as a subculture that spanned fashion, film, music, and physical beauty aesthetics—showing the continued impact of Black creation on popular culture.<sup>75</sup> While Black jazz musicians, even those who had reached international acclaim, were confined to playing for segregated audiences or on international circuits, jazz-style dance bands consisting of white musicians who performed "watered-down, 'safe' version[s] of jazz" gained widespread popularity among white audiences.<sup>76</sup> The copyright system not only failed to protect Black artists from economic and cultural exploitation, but also exacerbated it by codifying legal protections for the appropriation of their music.

Mirroring the social and political segregation of the Reconstruction and Jim Crow eras, the music industry created distinct markets for music created by white and Black musicians.<sup>77</sup> This contributed to the constantly evolving nature of the genre as a response to the cycle of white producers, publishers, record labels, and club owners adapting the Black musical and performance styles for their audiences, and Black artists

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69. *Id.*

70. See Troutt, *supra* note 29, at 409.

71. Erika Lindsay, *Jazz as Part of the African American Cultural Diaspora*, ART BEAT (Mar. 17, 2022), <https://artbeat.seattle.gov/2022/03/17/jazz-as-part-of-the-african-american-cultural-diaspora/> [https://perma.cc/QZ3Y-RUBN] [https://web.archive.org/web/20241006003756/https://artbeat.seattle.gov/2022/03/17/jazz-as-part-of-the-african-american-cultural-diaspora/].

72. See Troutt, *supra* note 29, at 409.

73. *American Popular Song: A Brief History*, HISTORY MATTERS, <https://historymatters.gmu.edu/mse/songs/amsong.html> [https://perma.cc/Y62K-Z37K] [https://web.archive.org/web/20241006004045/https://historymatters.gmu.edu/mse/songs/amsong.html] (last visited Jan. 27, 2024).

74. See STARR & WATERMAN, *supra* note 19, at 22.

75. *Id.*

76. *Id.*

77. *Id.*



adapting to new musical forms and methods of improvisation to distinguish themselves and “overcome . . . marginalization.”<sup>78</sup> For the first half of the twentieth century, labels realizing the value of African-American music to African-American audiences, labels such as Columbia, Paramount, and Okeh garnered significant revenue through the creation of “race music” and “race records”—music exclusively by Black artists for Black artists.<sup>79</sup> It was not that the market for Black music by the greater Black population was novel, but rather it was exploitable by producers and music labels who saw an opportunity to profit off of it. Despite being confined to segregated venues and receiving little air-play across analog mediums, race records were relatively successful and remained the “primary medium for African-American musical expression” in the first half of the twentieth century—leading to national fame for particular Black artists.<sup>80</sup> Despite the commercial success of their music, due to artists’ lack of knowledge of copyright law and its protections, and the lack of a centralized system to track the value of records and their royalties, most artists saw little to no compensation for their work.<sup>81</sup>

Educational and political discrimination also played a factor in the incompatibility of Black musical traditions and copyright law’s formalities. Jazz and blues music, specifically, which relied on improvisation and stylistic performance, were incompatible with the written notation needed to register many of the compositions that fell under the genre.<sup>82</sup> Therefore, artists who were able to reduce the notation to a written form were granted ownership over the work.<sup>83</sup> Finally, the compulsory mechanical licensing scheme disproportionately affected Black jazz musicians aiming to make a name for themselves in the emerging recording industry.<sup>84</sup> Sound recordings were not protected under the Copyright Act, and therefore under the licensing scheme, meaning that artists had less knowledge of and control over their works being recorded and reproduced elsewhere, and received inequitable (if any) compensation or recognition for their creations. The legislative history outlining Congress’ intent for the changes in the 1909 Act illustrates a lack of recognition for the unique and disadvantaged position of Black artists given the social, political, and economic conditions of segregation were not only not considered, but not even mentioned.<sup>85</sup>

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78. See Troutt, *supra* note 29, at 409.

79. Matthew A. Killmeier, *Race Music*, ENCYCLOPEDIA.COM, <https://www.encyclopedia.com/media/encyclopedias-almanacs-transcripts-and-maps/race-music> [https://perma.cc/14xv-evcm] [https://web.archive.org/web/20241008203215/https://www.encyclopedia.com/media/encyclopedias-almanacs-transcripts-and-maps/race-music] (last visited Oct. 12, 2024).

80. *Id.*

81. *Id.*

82. See *Thieves in the Temple*, *supra* note 48, at 628.

83. *Id.*

84. *Id.* at 628 & nn.82, 84.

85. See generally E. Fulton Brylawski & Abe Goldman, *Legislative History of the 1909 Copyright Act*, BULL. COPYRIGHT SOC’Y U.S.A. 77 (1976).

### B. DON'T BE CRUEL: ROCK 'N' ROLL AND THE ERA OF IMITATION

"The future looks bright ahead. Don't be cruel, to a heart that's true"

- Don't Be Cruel, Written by Otis Blackwell<sup>86</sup>

Deeply rooted in the diaspora of African American musical traditions, rock and roll, which emerged in the mid-twentieth century, evolved into the quintessential story of the appropriation of Black artists throughout American music history, and the inability for copyright law to provide recourse for Black musicians. Artists such as Chuck Berry, Little Richard, and Sister Rosetta Tharpe experimenting with faster-tempo renditions of gospel and rhythm and blues music as early influences of rock and roll music, major labels aimed to take this new style of music, performance, and dance, and popularize it on white singers.<sup>87</sup> As a stark contrast to the resurgence of conservative and traditional values following the World Wars, rock and roll was marketed as a rebellious form of music by white teenagers who desired to distance themselves from the music and culture of their parents' generations.<sup>88</sup> Rock and roll was thus born out of the blatant exploitation of Black artists.<sup>89</sup> Despite marketing efforts by record labels focusing primarily on white youth, rock and roll was a culturally-defining genre that transcended division—appealing to country and city, wealthy and inner city, white and Black.<sup>90</sup> With major record labels no longer being able to deny the commercial appeal and success of Black musicians and rhythm & blues, alongside the rapid growth of the vinyl record business after World War II, music executives aimed to find a way to exploit the market of Black music—without Black artists.<sup>91</sup> Labels practiced "whitewashing" Black rhythm and blues records for wider radio and television play.<sup>92</sup> The genre of rock and roll, which was a vernacular term derived from the Black community as a vulgar euphemism for sex, was borne out of this exploitative practice, and was usurped by white youth as a cultural rebellion and movement.<sup>93</sup>

Early Black rock and roll artists reached mainstream popularity and acclaim, such as Chuck Berry and Little Richard who directly marketed their music to the teenage market and created distinct personas consisting of "outrageous performance [styles] that appealed on a basis of . . . novelty and sexual ambiguity."<sup>94</sup> However, the biggest star of the Era was a white man with a Black style: Elvis Presley.<sup>95</sup> Elvis's "Hound Dog,"

86. ELVIS PRESLEY, *Don't Be Cruel on HOUND DOG* (RCA Victor 1956) (lyrics written by Otis Blackwell).

87. See Troutt, *supra* note 29, at 414–15.

88. *Id.* at 415.

89. See *id.* at 410.

90. See STARR & WATERMAN, *supra* note 19, at 62.

91. See Troutt, *supra* note 29, at 414–15.

92. Arnold Shaw, *Researching Rhythm & Blues*, 1 BLACK MUSIC RSCH. J. 71, 74 (1980) (stating that Rock and Roll is a white derivative of R&B music, which was a sociological product of Black exclusion in the music industry for over a century).

93. *Id.* at 74 & n.8.

94. See STARR & WATERMAN, *supra* note 19, at 63.

95. Born in a predominantly Black neighborhood in rural Mississippi to a poor, working class family that was heavily religious, Presley became influenced by gospel and Black musical styles from a young age.

which is one of the best-selling single records of all time, and his highest-selling song, became emblematic of the rock genre itself and shattered records that remain untouched in the twenty-first century.<sup>96</sup> The song simultaneously topped the pop, country, and rhythm and blues charts, highlighting the genre-bending appeal of the song's style. The song, however, was first recorded and published by pioneering Blues singer Big Mama Thornton, three years before Elvis's release.<sup>97</sup> While Thornton received acclaim for the song in the rhythm and blues space, she did not own copyright in the musical composition, and her sound recording in the record was not protected under the 1909 Act.<sup>98</sup> She received a \$500 payment for the song, and never received royalties for the song despite the song being the one of the most popular songs in history.<sup>99</sup>

This was not the only occasion in which Presley covered and popularized songs by Black artists, and the practice arguably erased the significant contributions of many of the early Black figures in rock and roll music. Artists like Ray Charles did not see Presley's imitation of Black musical styles as flattery or particularly beneficial to the Black musical community—noting that Black singers like Nat King Cole were attacked for playing the very music Presley became famous for—*Black* music.<sup>100</sup> The pattern of appropriation at the expense of Black artists that continued through Elvis's career reflects the broader pattern of exploitation and erasure of African American artists that has existed in the entirety of American musical history. While Elvis's popularity is not solely attributed to his adoption and use of Black style and music, his popularity at the expense of those artists perfectly illustrates the legal and social inequalities under copyright law and the broader music industry. Exploitative practices that prevented Black artists from retaining any ownership in their music, a lack of fair compensation for their work, stringent formalities under copyright law, and statutory provisions that allowed for the lifting of Black music by white artists contributed to the unequal protection of Black musicians and their works.<sup>101</sup> Additionally, the lack of protection

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These influences not only revealed themselves in his gyrating dancing style, gospel sound, or stage presence, but also in the direct covering of records by Black blues artists. See STARR & WATERMAN, *supra* note 19, at 63.

96. See generally *Elvis Presley*, BILLBOARD, <https://www.billboard.com/artist/elvis-presley/> [<https://perma.cc/7F27-5WM6>] [<https://web.archive.org/web/20241113222149/https://www.billboard.com/artist/elvis-presley/>] (last visited Jan. 28, 2024). See also *Achievements*, GRACELAND, <https://www.graceland.com/achievements> [<https://perma.cc/D2RD-EUU9>] [<https://web.archive.org/web/20241123010908/https://www.graceland.com/achievements>] (last visited Dec. 21, 2024).

97. Michael Sporke, "Hound Dog"—*Big Mama Thornton (1953)*, LIBRARY OF CONGRESS (2016), <https://www.loc.gov/static/programs/national-recording-preservation-board/documents/HoundDog.pdf> [<https://perma.cc/95C2-8JCW>] [<https://web.archive.org/web/20241007230458/https://www.loc.gov/static/programs/national-recording-preservation-board/documents/HoundDog.pdf>] (last visited Oct. 11, 2024).

98. *Id.*

99. Yohana Desta, *Elvis: What Did Black Artists of the Era Really Think of Presley?*, VANITY FAIR (June 24, 2022).

100. *Id.*

101. See Greene, *supra* note 11, at 371.

for sound recordings under the 1909 Act's compulsory mechanical licensing further denied Black musicians the legal avenues to control the use and appropriation of their music by other artists. The defining process of early mainstream rock and roll was the appropriation, sanitation, imitation, and commodification of popular Black music styles.

**C. A CHANGE IS GONNA COME: THE CIVIL RIGHTS MOVEMENT, MOTOWN, AND THE BIRTH OF THE BLACK MUSIC MECCA**

"It's been a long, a long time comin';, but I know a change gon' come."

- A Change Is Gonna Come, Sam Cooke<sup>102</sup>

Gaining popularity against the backdrop of the Civil Rights movement, continued widespread segregation, and the assassination of Dr. Martin Luther King, soul and rhythm and blues music became more than just a method of entertainment, but rather saw a return to the very origins of the African American musical traditions as sources of strength, hope, and resilience. The genre itself became one of the foremost expressions of Black resilience in the face of continued oppression, injustice, and segregation. Many of the acclaimed songs produced during this period reflected these themes of hope and freedom, becoming the soundtrack for the fight for equality. While the 1950s and 1960s were largely defined by a social, cultural, and political fight for freedom, a shift was also occurring for Black artists in the music world.

Rhythm and blues became one of the first genres of the twentieth century to transcend the "race record" distinction, to reach national acclaim and widespread radio play.<sup>103</sup> Smaller labels recognized the value in R&B to appeal to a younger audience, and forged relationships with Black musicians to increase visibility and profitability.<sup>104</sup> In response to existing performing rights organizations, such as the American Society of Composers, Authors and Publishers ("ASCAP"), which had previously denied their services to Black artists in collecting royalties and distributing licensees, Broadcast Music, Inc ("BMI"), concerted efforts into bringing R&B to the masses, representing the rights of over 90% of the weekly R&B radio hits.<sup>105</sup> The only music licensing organization to devote such efforts to Black artists, BMI represented nearly every pioneer of both rhythm and blues and rock and roll.<sup>106</sup> Despite the popularity and acclaim that rhythm and blues received across national airways, this led to the banning of these records on white stations, and the appropriation and whitewashing of popular

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102. SAM COOKE, A CHANGE IS GONNA COME (RCA Victor 1964).

103. See Troutt, *supra* note 29, at 415.

104. *Id.*

105. BMI's Timeline Through History, BMI, <https://www.bmi.com/about/history> [<https://perma.cc/JV9P-LQGQ>] [<https://web.archive.org/web/20241002053546/https://www.bmi.com/about/history>] (last visited Jan. 28, 2024).

106. *Id.*

records by Black artists for these stations.<sup>107</sup> This spurred the resurgence in the mass production of “racial covers” of Black records by white artists and groups despite demand for the original works.<sup>108</sup> One scholar, David D. Troutt, specifically cites the compulsory licensing scheme under the 1909 Act as the fodder for this practice, noting that “[w]ithout the ability to make white covers of Black songs under [the licensing provision] . . . the industry would have had to alter its racist behavior sooner” by “playing black [records], signing black . . . artists to major labels, and expanding the opportunities for popular and financial recognition for black musical authors.”<sup>109</sup>

This era also saw a shift in the dynamics of the music industry, with the formation of Black records that aimed to produce records for a widespread audience. In 1959, Berry Gordie launched the soul music record label, Motown, a nod to Detroit as the “motor town.”<sup>110</sup> The label successfully contributed to the racial integration of American popular music as an entirely African-American led, run, and produced label that created records of mass appeal.<sup>111</sup> The label became the largest Black-owned corporation in the country, and became a hit-factory, producing some of the greatest artists of the time: from Stevie Wonder, to Marvin Gaye, and the Jackson 5.<sup>112</sup> While many of the inequities of decades and generations past still remained, such as catering to white consumer tastes and unequal ownership of copyright between labels and artists, Motown still marked the beginning of a shift within Black musical culture from both an industrial and artistic perspective.<sup>113</sup>

In contrast to its predecessors, the 1909 Copyright Act introduced significant changes to the landscape of existing copyright law. Unlike prior legislation, which often lacked comprehensive provisions and enforcement mechanisms, the 1909 Act sought to codify and streamline copyright regulations, providing creators with more robust protections for their works. However, as seen through the experience of pioneering Black artists on the forefront of jazz, rock and roll, and rhythm and blues, these statutory advancements perpetuated the systemic barriers that impeded Black artists ability to gain credit, compensation, and protection for their works. While the 1909 Copyright Act underwent a number of amendments in the 1950s and 1960s to keep pace with technological and industry developments that occurred during the twentieth

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107. See Troutt, *supra* note 29, at 417.

108. *Id.*

109. *Id.* (footnotes omitted).

110. Motown, DICTIONARY.COM, <https://www.dictionary.com/browse/motown> [<https://perma.cc/G7DL-7F5S>]

[<https://web.archive.org/web/20240721021220/https://www.dictionary.com/browse/Motown>] (last visited Feb. 21, 2024); Classic Motown, CLASSIC MOTOWN, <https://classic.motown.com/timeline/> [<https://perma.cc/Q3P7-79AB>]

[<https://web.archive.org/web/20240910013540/https://classic.motown.com/timeline/>] (last visited Feb. 20, 2024)

111. Classic Motown, *supra* note 110.

112. *Id.*; Troutt, *supra* note 29, at 419–20.

113. See Troutt, *supra* note 29, at 419–20.

century, the Act underwent a major revision leading to the Copyright Act of 1976 (“the 1976 Act”), which is now the reigning, modern framework for copyright law.<sup>114</sup>

### III. PART THREE: THE MODERN COPYRIGHT ERA

#### A. THE COPYRIGHT ACT OF 1976

Despite the evolution from the 1909 Act to the 1976 Act, Black artists continue to face challenges in the face of changing technological advancements, highlighting ongoing disparities and struggles within the music industry. The 1976 Act was signed into law by President Gerald Ford on October 19, 1976, and went into effect on January 1, 1978.<sup>115</sup> All works created prior to this date were still subject to the Copyright Act of 1909, as that was reigning law during its creation and the new Act would not be applied retroactively, only prospectively.<sup>116</sup> The 1976 Act represented a new philosophy for copyright law in the United States, reasserting legislative supremacy in intellectual property, rather than reliance on courts and judge-made law to determine boundaries of protectability. This led to comprehensive codification of judge-made rule to give doctrines legislative authority, and to create national uniformity on several issues. Aside from greatly expanding the subject matter subject to copyright protection and creating the threshold of an “original creation fixed in a tangible medium,” one of the largest changes reflected in the Act was the simplicity of the statute’s formalities. Firstly, federal copyright protection was now automatically granted for all original works once they are fixed in a tangible form, regardless of whether or not they are published or registered.<sup>117</sup> While registration becomes a prerequisite for an infringement action under 17 U.S.C., it is no longer a requirement for protection.<sup>118</sup> This addition also removes the need for a copyright notice, as all works that meet the protectability threshold are presumed to be protected under copyright law. Additionally, deposit requirements are rendered moot as most works are exempted. Other provisions, such as the length of the term of protection and renewal periods, codified defenses to claimed infringement, and provisions for new forms of protection (namely the internet) were also reflected in the new act.

#### 1. Sound Recording Rights

Section 114 of the 1976 Copyright Act creates an express provision outlining the exclusive rights in sound recordings, which were not granted copyright protection

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114. 1950–2000, *Highlight: Congress Passes the Current Copyright Act*, COPYRIGHT.GOV, [https://www.copyright.gov/timeline/timeline\\_1950-2000.html](https://www.copyright.gov/timeline/timeline_1950-2000.html) [https://perma.cc/BW3E-YALP] [https://web.archive.org/web/20241006181046/https://www.copyright.gov/timeline/timeline\_1950-2000.html] (last visited Jan. 29, 2024) [hereinafter, 1950–2000 Timeline].

115. *Id.*

116. *Id.*

117. *Id.*

118. 17 U.S.C. § 408.

until 1972.<sup>119</sup> Sound recordings being denied protection prior to the 1976 Act primarily affected artists who were making significant contributions to the emerging field of recorded music. Following the added protection for sound recordings in 1972, music publishers brought actions against compulsory license users that not only duplicated the musical composition, but also the sound recording as well. For example, in *Duchess Music Corp v. Stern*, the Ninth Circuit found that even compliance with the compulsory license statutory provisions would not allow a direct reproduction of the sound recording without permission of the copyright owner, as the licensing scheme only covered the underlying musical compositions.<sup>120</sup> While this increased some of the protections of the copyright owner, this would only benefit the original artist if they retained ownership of their work. However, this was a right that many Black musicians were deprived of due to predatory business practices and ignorance of copyright formalities.<sup>121</sup>

Section 114 grants exclusive rights to sound recordings, but only: reproduction rights, derivative work rights, distribution rights, and a public performance right.<sup>122</sup> The reproduction rights afforded in this section do not refer to covers that imitate the performance embodied in the record, but are rather confined to a replication of the actual sounds of the original work, as well as the right to rearrange, remix, or alter the sequence of their original work as a derivative work. This specifically references the practice of sampling. Importantly, the rights afforded to sound recordings do not cover the “independent fixation” of other sounds that imitate or are similar to the protected sound recordings, likely a codification of the independent creation defense often brought in music infringement cases.

## 2. The Amended Compulsory License

The compulsory mechanical license, despite attempts to the contrary, survived the major revision of copyright law and was codified in Section 115 of the Copyright Act of 1976. This section provided that: “In the case of nondramatic musical works, the exclusive rights provided by . . . section 106, to make and to distribute phonorecords of such works, are subject to compulsory licensing under the conditions specified by this section.”<sup>123</sup> Subsection (a) describes the requirements for those seeking a compulsory license: requiring that the record has already been published and distributed, and that the primary purpose in making the reproduction is for distribution to the public for

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119. 1950–2000 Timeline, *supra* note 114.

120. *Duchess Music Corp. v. Stern*, 458 F.2d 1305 (9th Cir. 1972), *cert. denied*, 409 U.S. 847 (1972). *See also* *Edward B. Marks Music Corp. v. Colo. Magnetics, Inc.*, 497 F.2d 285 (10th Cir. 1974) (for the proposition that courts around the country similarly read the statute to provide a sort of first right to the owner of a copyright in a musical composition, giving them “absolute control” over who may record the composition. However, this Court notes that once a composer or copyright owner grants a license for another to use the musical composition, than “any other person may make similar use of the copyrighted work” through the compulsory licensing provisions in the statute).

121. *See* Killmeier, *supra* note 79.

122. 17 U.S.C. § 114(a).

123. 17 U.S.C. § 115.

private use.<sup>124</sup> It is unclear precisely what defines “private use” in a digital, streaming world but there have yet to be actions brought countering this language. The new language expressly included sound recordings—denying compulsory licenses to sound recordings fixed by another person without their express license and permission.<sup>125</sup> Most importantly, the new licensing provisions expressly allowed artists seeking to cover an existing work the ability to alter the arrangement of the song to align with their particular style, so long as the “basic melody or fundamental character of the work” remains unchanged.<sup>126</sup> The subsection also denies copyright protection to the new arrangement as a derivative work *without the express permission of the copyright owner* in the underlying musical composition.<sup>127</sup> The scheme retains the notice and registration requirements of the 1909 Act, and allows for record companies to obtain licenses to distribute the new works digitally.<sup>128</sup> Those who fail to comply with the provisions are subject to actions of infringement amongst other limitations.<sup>129</sup> Additionally, the royalty rates were raised to 7.1 cents per unit, or 1.35 cents per minute of playing time (whichever amount is larger) and allowed for copyright owners to negotiate their own rates.<sup>130</sup>

While the amended licensing scheme addressed concerns raised in relation to the 1909 scheme, a number of issues still remain unresolved under the existing licensing scheme as technology advances and our methods of consumption evolve. In testimony before Congress to amend the compulsory licensing scheme in 2004, the Register of Copyrights, Marybeth Peters, argued that the current scheme failed to reflect the changing nature of technology and the rights of artists in an increasingly digital world.<sup>131</sup> Peters notes that the 1909 compulsory licensing scheme was rarely invoked outside of the context of piracy, as sound recordings did not fall within the purview of the licensing scheme, and most artists went ahead and covered songs without stringently following the provisions of the statute.<sup>132</sup>

The Reporter notes that when considering the amended structure, the House Judiciary Committee found that the current system was “unnecessarily burdensome on copyright owners,” and royalty rates were too low to be effective—which led to the aforementioned changes in the scheme’s structure.<sup>133</sup> Therefore, while compulsory licensing necessarily effected the entirety of the music industry, and impacted artists of

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124. 17 U.S.C. § 115(a)(1)(A)(i).

125. 17 U.S.C. § 115(a)(1)(B)(ii).

126. 17 U.S.C. § 115(a)(2).

127. *Id.*

128. 17 U.S.C. § 115(b)(3).

129. *Id.*

130. 17 U.S.C. § 115(c)(1). *See* 37 C.F.R. § 255.3(i). (The most recent amendment to § 255.3 Adjustment of Royalty Rate, found in section (m), raised the royalty rate for “phonorecords made and distributed on or before January 1, 2006” to “either 9.1 cents, or 1.75 cents per minute of playing time, whichever amount is larger”).

131. *Section 115 Compulsory License: Hearing Before the Subcomm. on Cts., The Internet, and Intell. Prop. of the H. Comm. on the Judiciary*, 108th Cong. 2 (2004) (statement of Marybeth Peters, Register of Copyrights) [hereinafter, Statement of Peters].

132. *Id.*

133. *Id.*



all races, the Black musical community was particularly affected by the amended scheme in two ways. Section 115 outlines that an artist or party interested in re-recording or covering a musical composition or sound recording will not need to seek a compulsory license under two circumstances.<sup>134</sup> The first exclusion applies if the original work is in the public domain because the copyright has expired or “*the work was created before March 1, 1989, and the author or copyright owner failed to comply with formalities necessary to maintain the copyright.*”<sup>135</sup> Under the 1909 Act, which affected works created until 1978, and throughout the history of musical creation within the Black community, the formalities of copyright registration have created barriers for adequate protection.<sup>136</sup> As discussed in Parts I and II, Black artists are likely to have less ownership and control over their music, including both the musical compositions and sound recordings, due to historical and systemic inequities within the music industry.<sup>137</sup>

Despite provisions of the licensing scheme sustaining much of the harm that artists faced in previous generations, Congress did *attempt* to address the changing nature of the music industry and how the provision may affect artists. Noting the changes in music consumption and technological developments with the rise of the internet presenting new challenges to the licensing framework, Congress adopted “The Digital Performance Right in Sound Recordings Act of 1995.”<sup>138</sup> The amendment granted copyright owners an exclusive public performance right by means of digital transmissions and “reaffirmed mechanical rights of songwriters and music publishers in the new world of digital technology.”<sup>139</sup> This allows copyright owners to license out both the sound recording and the underlying musical composition to interested parties. However, while the licensing process was amended to compensate for changes in digital music consumption, it has failed to meet the current moment considering rapid technological advancement that is drastically changing the way we create, produce, distribute, and consume music, setting the stage for Black musicians to again bear the brunt of these statutory shortcomings.

#### IV. PART FOUR: REFORMING THE COMPULSORY LICENSING SYSTEM

The constant tension between technological advancement and copyright law has become increasingly burdensome on creatives whose rights are not adequately adapting at the rate in which technology is. This historical tension has challenged the efficacy of the compulsory mechanical licensing system to adapt quickly enough to these rapidly evolving technologies in order to protect the rights in their works and their economic interests bound in those rights. In an era of music defined by sampling, streaming, and a rise in artificial intelligence’s use in the creative process, the 1976 compulsory

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134. Lisa Weiss, *Music Licensing*, WESTLAW PRACTICAL LAW INTELL. PROP. AND TECH. (last visited Nov. 18, 2024).

135. *Id.* (emphasis added).

136. *See supra* Part II.

137. *Id.*

138. *See* Statement of Peters, *supra* note 131.

139. *Id.*

licensing scheme, and its amendments, have failed to respond to the implications of these technologies on this right. This undoubtedly will affect marginalized artists, especially Black artists, who have historically borne the brunt of copyright law's shortcomings and pitfalls.

As these technologies influence changes in the music industry, the legal gaps formed from the inadequacy of the licensing scheme risk reigniting the inequities that Black artists faced historically—from protection to compensation and appropriation. While all artists are technically subject to the pitfalls of the licensing scheme, the impact on Black artists in light of historical and generational inequities in protection and the inherent intertwined nature of Black music and culture will again disproportionately affect Black musicians. As seen in the continued legal battles of Black artists to have the unauthorized uses of their works by white artists, this issue remains as pertinent as ever.<sup>140</sup> While many of the novel legal issues surrounding these technologies prevent quick and efficient legislation from being enacted, simple amendments to the Section 115 compulsory licensing system can protect artists from exploitation and appropriation in the interim.

#### A. BLURRED LINES: STREAMING AND SYSTEM INTELLIGENCE IN THE ERA OF HIP-HOP

Although Black artists at the dawn of the twenty-first century made significant progress in gaining adequate protection for their contributions to American popular culture, the changing landscape of the music industry in the twenty-first century implicates new legal issues that threaten the livelihoods of Black artists. The issues of appropriation are largely governed by Sections 114 and 115 of the Copyright Act of 1976, which consider the exclusive rights afforded to sound recordings and the licensing system that governs the use of other artists' musical compositions and sound recordings.<sup>141</sup> While the licensing system was amended and updated after the 1909 Act's

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140. See generally *Bright Tunes Music Corp. v. Harrisongs Music, Ltd.*, 420 F. Supp. 177 (S.D.N.Y. 1976) (African-American songwriter Ronnie Mack composed the hit song "He's So Fine" for the African-American girl group, "The Tops." The composition and sound recording were copyrighted by the company Bright Tunes who brought suit claiming that the successful song "My Sweet Lord," performed by former Beatle George Harrison plagiarized their work. Harrison's songs used the same two motifs as the Tops' song and the harmonies of both songs are identical. Additionally, Harrison admitted to being aware of the group's song and was found liable for "subconscious" copying of the composition.); *Newton v. Diamond*, 388 F.3d 1189 (9th Cir. 2004) (Plaintiff Newton, a prominent African American flutist who owned the composition rights to his work, but not the rights to the sound recording, had his work sampled in a song by white, rap rock group "Beastie Boys." The defendants licensed the use of the recording but did not license the underlying composition from Newton. The court found that the use was de minimis and therefore not actionable. Newton therefore received no compensation for the use of his composition.); *Structured Asset Sales, LLC v. Sheeran*, 120 F.4th 1066 (2d Cir. 2024). (A partial owner in the royalties from African-American soul singer, Marvin Gaye, sued English singer Ed Sheeran claiming that his song "Thinking Out Loud" infringed on the copyright in Marvin Gaye's "Let's Get It On." The court, however found that Gaye's song was protected only as defined in the sheet music deposited with the Copyright Office under the 1909 Act. The court found the chord progression and syncopated rhythm to be unprotectable musical building blocks and insufficiently original to warrant copyright protection. It emphasized that overprotecting basic musical elements would "stifle creativity.")

141. 17 U.S.C. §§ 114, 115.

six-decade-long governing of the issue to address many of the concerns that effectively propelled the appropriation of Black artistry, disproportionately impacting Black artists, these changes are becoming less effective in light of technological trends arising in the music industry.

In keeping with the tradition of Black artists at the forefront of innovative change at the outset of the development of new musical genres, the creation of the hip-hop genre by Black artists in the late twentieth and early twenty-first centuries has once again greatly altered the music industry, becoming the most popular genre in the country.<sup>142</sup> Hip-hop returns to the very roots of the Black musical tradition: drawing upon and fusing existing music to express the Black experience and social, political, and economic conditions of the community in a quasi-improvisational oral tradition. This merging of historical musical traditions reflects a continued practice of referential development in Black musical history, and the inherent intertwined nature of Black culture and Black music.<sup>143</sup> Access to cheap technology and oral instrumentation, alongside a growing movement of Black-led labels cognizant of discriminatory mainstream practices within the industry, birthed a strong sense of entrepreneurship amongst the hip-hop community.<sup>144</sup> This allowed artists to retain ownership over their works and allowed for unrestrained experimentation across the genre—contributing to its sustained popularity.<sup>145</sup>

### 1. The Streaming Era: Spotify, Apple Music, and the Decline of Radio

One of the key technological advancements of the early twenty-first century that played a key role in cementing the success of hip-hop in American Pop Culture is the evolution of digital music streaming.<sup>146</sup> Streaming and the rise of digital music platforms have altered the very model at the core of the music industry: both in the way that artists create, the way labels operate, and the way the public consumes music. Major music labels no longer maintain control over music distribution, and thus no

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142. Candace G. Hines, *Black Musical Traditions and Copyright Law: Historical Tensions*, 10 MICH. J. RACE & L. 463, 487 (2005) (noting that, influenced by the disco-funk of the 1970s, the rise of spoken poetry in urban communities in the 1980s, and the sustained popularity of rhythm and blues, this fusion of spoken word and musical traditions arose in the New York inner-city communities at the end of the twentieth century.). See also Charlie Zhang, *Hip Hop Deemed Most Popular Genre of 2020*, HYPEBEAST (July 15, 2020), <https://hypebeast.com/2020/7/hip-hop-most-popular-genre-2020-streaming-sales-data-info> [https://perma.cc/9P5G-2GFY] [https://web.archive.org/web/20230102224759/https://hypebeast.com/2020/7/hip-hop-most-popular-genre-2020-streaming-sales-data-info].

143. See Greene, *supra* note 11, at 365–66.

144. See Troutt, *supra* note 29, at 427–28.

145. *Id.*

146. Ryan Smith, *Hip Hop and the Evolution of Music Streaming: From MP3s to Blockchain*, WRITING BY RYAN (Mar. 20, 2023), <https://www.writingbyryan.com/hip-hop-and-the-evolution-of-music-streaming-from-mp3s-to-blockchain/> [https://perma.cc/PXE7-VDHP] [https://web.archive.org/web/20240525083111/https://www.writingbyryan.com/hip-hop-and-the-evolution-of-music-streaming-from-mp3s-to-blockchain/].

longer act as gatekeepers and necessary intermediaries between artists and the public.<sup>147</sup> With independent artists, labels, and songwriters now able to directly access and harness the power of the internet to reach wide audiences, the ability to effectively monitor the unlicensed use of music in covers and samples on streaming sites is continually diminishing to the detriment of the original artists.

While the licensing scheme in § 115 was amended to include blanket licenses for digital audio transmissions, the covert threat to the compulsory licensing scheme is what streaming *allows* for artists.<sup>148</sup> With labels and publishing companies no longer acting as necessary intermediaries between artists and the public, well-versed in the ins and outs of the intellectual property legal structures and copyright law, many artists are now independently producing music to be released directly to the public.<sup>149</sup> While this allows many of these artists to retain full ownership of their compositions and sound recordings and allows them to circumvent the often-predatory practices of the music industry, it also leads to (ideally, innocent) infringement due to the lack of knowledge or comprehension of the technicalities of copyright law. While many independent artists use covers of popular songs to build a following, doing so under the compulsory licensing system without proper notice and credit could expose the artists to legal repercussions they may not be equipped or resourced-enough to handle.

## 2. Artificial Intelligence: Attribution and Appropriation

In April 2023, a song surfaced across social media platforms called “Heart on My Sleeve,” and became an instant hit amongst fans of Drake and The Weeknd—the two artists featured on the track.<sup>150</sup> However, the artists did not create the song, nor did they lend their voices to someone else’s composition—their voices were digitally cloned using artificial intelligence without the artists’ permission. The track garnered nearly one million hits before being taken down by various platforms for potential copyright infringement.<sup>151</sup> Novel questions concerning copyright and intellectual property implications in the development of artificial intelligence have prevented Congress, and the Copyright Office, from taking preemptive action to protect artists’ intellectual property and livelihoods.

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147. Gary Graham et al., *The Transformation of the Music Industry Supply Chain*, 24 INT’L J. OPERATIONS & PROD. MGMT. 1087, 1090 (2004).

148. See 17 U.S.C. § 115(d)(1)(A).

149. Grant Rindner, *How Streaming Changed Rap*, COMPLEX (Nov. 19, 2019), <https://www.complex.com/music/a/grant-rindner/how-music-streaming-changed-rap> [https://perma.cc/JXP6-6HKR] [https://web.archive.org/web/20230804122705/https://www.complex.com/music/a/grant-rindner/how-music-streaming-changed-rap].

150. Noah A. McGee, *AI-Generated Music Is Creating Black Art Without Black Input*, ROOT (Apr. 19, 2023), <https://www.theroot.com/ai-generated-music-is-creating-black-art-without-black-1850353845> [https://perma.cc/H8LC-TNSZ] [https://web.archive.org/web/20240802003852/https://www.theroot.com/ai-generated-music-is-creating-black-art-without-black-1850353845].

151. *Id.*

The 1976 Copyright Act, which codified existing common law, is regularly amended to update regulatory provisions and registration requirements to reflect new advancements in the realm of creation.<sup>152</sup> However, as new technologies evolve faster than legislation can adapt, questions about traditional concepts of authorship, ownership, and infringement are emerging with increasing urgency. The newest of these debates, surrounding the use of artificial intelligence, namely generative artificial intelligence, poses new questions and debates around how this generated content will affect artists, authors, and creatives, who will own the computer-generated data, and how artists will protect their works—questions that are fundamental to the existence of our current intellectual property systems.<sup>153</sup>

Generative Deep Learning is a specific subset of Artificial Intelligence that uses available training sets of data, which contain examples of the entities that will be used as a beginning point for the generation of new data that is outputted.<sup>154</sup> The sets of data act as training sets in which information can be extracted; however, the data that is contained in these sets may be protected by copyright, such as artworks, poems, articles, and other forms of literary works.<sup>155</sup> One key feature of GDL processing, which lies at the crux of its potentially troublesome legal implications, is that the processing technique learns directly from the whole work as it exists in its expressive forms (which are protected by copyright), not through the study of small features or underlying ideas (which are not protected by copyright).<sup>156</sup> Generative deep learning techniques are trained on a large amount of data, some of which may be protected by copyright, especially in case of musical compositions, but they allow for the generation of new samples that are similar to the training data which could either warrant its own distinct copyright protection or could constitute an infringement.<sup>157</sup>

Beyond questions of resulting ownership or potential infringement, the rise of artificial intelligence also implicates issues of licensing, royalties, and proper credit. When fans, eager for new material from their favorite artists, use artificial intelligence to generate music “in the style” or voice of these artists, they may inadvertently infringe on the artists’ musical compositions and sound recordings, likely without providing proper notice to the artist for authorization for the use of their work.<sup>158</sup> This reinvigorates issues that have been consistent across the history of Black music—the

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152. U.S. COPYRIGHT OFF., COPYRIGHT LAW OF THE UNITED STATES viii (2022).

153. *Artificial Intelligence and Intellectual Property Policy*, WIPO, [https://www.wipo.int/about-ip/en/artificial\\_intelligence/policy.html](https://www.wipo.int/about-ip/en/artificial_intelligence/policy.html).

[[https://web.archive.org/web/20240926232019/https://www.wipo.int/about-ip/en/artificial\\_intelligence/policy.html](https://web.archive.org/web/20240926232019/https://www.wipo.int/about-ip/en/artificial_intelligence/policy.html)] (last visited Feb. 3, 2024).

154. Giorgio Franceschelli & Mirco Musolesi, *Copyright in Generative Deep Learning*, 4 DATA & POL’Y, e17-1–e17-2 (2022).

155. *Id.* at e17-2.

156. *Id.*

157. *Id.*

158. Jonathan Coote & Don McCombie, *AI-Generated Music and Copyright*, CLIFFORD CHANCE, <https://www.cliffordchance.com/insights/resources/blogs/talking-tech/en/articles/2023/04/ai-generated-music-and-copyright.html> [https://perma.cc/Z7FH-NTK9]

[<https://web.archive.org/web/20241006081754/https://www.cliffordchance.com/insights/resources/blogs/talking-tech/en/articles/2023/04/ai-generated-music-and-copyright.html>] (last visited Feb. 13, 2024).

desire to create Black music, without Black artists. When Black artists have just begun to emerge from the centuries-long industrial, social, political, and economical subjugation and discrimination, the inability for copyright law to adequately address the new technology is reinvigorating these patterns of appropriation to the detriment of Black musicians.

## B. A CREATOR-CENTERED SOLUTION TO THE LICENSING WOES OF THE COPYRIGHT LEGAL SCHEME

### 1. A Moral Right for Musicians: The Assurance of Attribution and Integrity Through a Voluntary Licensing System

To ensure that creators, artists, and musicians are centered in the search for a solution to the continually rising tensions between technological advancements, licensing, and the music industry, Congress should follow its own acknowledgement of the importance of artist control through the recognition of a moral right of attribution for musical artists. The underlying moral-rights approach to justifying intellectual property rights suggests that the law should afford protection to creators because works are products of their labor, and thus a form of property deserving of robust ownership protections.<sup>159</sup> This is the theory that generally underlies the European approaches to copyright protection, however the United States has remained highly inconsistent on its treatment of creator's moral rights—prioritizing commercial, corporate, and capitalist interests instead.<sup>160</sup> However, the recognition of a moral right for musicians would not be unprecedented or impracticable. In 1990, Congress passed the Visual Artists Rights Act (“VARA”), which granted artists of qualifying visual works a right of attribution and integrity in their works.<sup>161</sup> This statute grants the owners the right to claim authorship in their works, to prevent the use of their name as the author of works they have not created, as well as rights in the preservation and destruction of their works. These moral rights afford protection for the artist's personal, non-economic interests in receiving attribution for their work and in preserving the work in the way it was created even after its sold or displayed.<sup>162</sup> There

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159. Betsy Rosenblatt, *Moral Rights Basics*, BERKMAN KLEIN CTR. (1998), <https://cyber.harvard.edu/property/library/moralprimer.html> [https://perma.cc/4L9E-YUVX] [https://web.archive.org/web/20240921211925/https://cyber.harvard.edu/property/library/moralprimer.html] (last visited Oct. 10, 2024).

160. Roberta Rosenthal Kwall, *THE SOUL OF CREATIVITY: FORGING A MORAL RIGHTS LAW FOR THE UNITED STATES* 53 (Stanford Univ. Press 2010).

161. 17 U.S.C. § 106(A).

162. Sharon Forscher, *The Visual Artists Rights Act of 1990*, PHILADELPHIA VOLUNTEER LAWYERS FOR THE ARTS, at 1 (2008) [https://www.cabq.gov/artsculture/public-art/documents/visualartistsrightsact\\_philadelphiavolunteerlawyersarts.pdf](https://www.cabq.gov/artsculture/public-art/documents/visualartistsrightsact_philadelphiavolunteerlawyersarts.pdf) [https://perma.cc/JN5X-AGUE] [https://web.archive.org/web/20240727211802/https://www.cabq.gov/artsculture/public-art/documents/visualartistsrightsact\_philadelphiavolunteerlawyersarts.pdf] (last visited Oct. 10, 2024).

are various provisions as to what works are protected under the Act and when the rights under the Act can be invoked by the author.

In a country with a robust history of appropriation, imitation, and distortion of musical works at the ridicule and expense of Black artists who have made invaluable contributions to American popular culture, the adoption and recognition of a moral right for musicians would allow them to control and prevent the use of their music for ways in which it was not intended while preserving the original work. This provision could be solely used as a caveat to the existing compulsory licensing system that would instead opt for a voluntary licensing system when dealing with artists seeking to make covers of existing works. If the right was recognized in the 1909 Act, the continual economic deprivation of Black artists whose works were exploited by white, mainstream artists, could largely have been avoided. Additionally, artists who are concerned about their works being used by artificial intelligence systems to either train their models or create new works would therefore have a statutory right to prevent the use of their work by both the individual and the corporation behind the technology. Furthermore, this could allow artists to set their own royalty rates, rather than falling victim to a rate that is unlikely to reflect economic changes and inflation.

While the reality of a voluntary licensing system could potentially become convoluted due to the sheer amount of musical works produced, the formation of an independent licensing body, that would allow artists to license their works out and review licensing requests, could adequately address the issues raised in this Note concerning technological advances considering the historical treatment of Black artists under the licensing scheme. Akin to the creation of ASCAP and BMI out of the royalty and licensing schemes in the 1909 Act, this independent body could regulate the uses of mechanical reproductions for musical compositions and sound recordings—helping independent artists to navigate the legal complexities of licensing, allowing for permission for sample licensing to be consolidated into one body, and allowing musicians to opt out of having their works being used in artificial intelligence systems.

## 2. Amending the Music Modernization Act

In recognizing the issues that technological advancements are creating or exacerbating for musicians, Congress passed the Music Modernization Act (“MMA”) in 2018 to harmonize the existing statutory licensing scheme with the changing needs of creators in the age of digital streaming.<sup>163</sup> Prior to the law’s enactment, in order for digital streaming services to provide music to their customers, the platforms would be required to have to seek licensing on an individual song-by-song basis or through private negotiations with record labels and publishing companies to “reproduce and distribute the musical works.”<sup>164</sup> The MMA created a blanket licensing system for

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163. Orrin G. Hatch-Bob Goodlatte Music Modernization Act, H.R. 1551, 115th Cong. § 102 (2018); *The Music Modernization Act*, COPYRIGHT.GOV, <https://www.copyright.gov/music-modernization/> [<https://web.archive.org/web/20241113100227/https://www.copyright.gov/music-modernization/>] (last visited Feb. 21, 2024).

164. *Id.*

digital music services to download or stream records.<sup>165</sup> Additionally, the statute formed the “mechanical licensing collective” (“MLC”), to distribute royalties procured through digital music platforms in a central database and to distribute digital licenses. Prior to this service, artists hoping to cover music bore the responsibility of seeking out the rights holders in the composition of interest, and registering the necessary notices, a process that was often ignored.<sup>166</sup>

For songwriters and copyright holders, royalties can only be received on songs that are registered in the MLC’s system. The blanket license created by the MMA, however, now allows any artist who desires to distribute covers of an existing song *solely on an interactive audio platform*, will be covered without the need for a compulsory mechanical license.<sup>167</sup> This license is limited to the distribution of cover songs on interactive, digital audio formats, but does not cover physical copies of the record, the distribution of the song to non-interactive music services such as Apple or Amazon, and digital covers distributed on other sites that do not elect to operate under the blanket license scheme under the MLC.<sup>168</sup> Additionally, it does not cover samples, nor covers of existing records that change the basic melody or fundamentally change the original work.<sup>169</sup> Thus, if the artist intends to sell or distribute the record through a physical phonorecord, the traditional compulsory licensing scheme requirements in 17 U.S.C. § 115 applies.<sup>170</sup> Therefore, the existing convoluted and ineffective compulsory licensing provisions of § 115 still exist, but were further complicated through the introduction of the Music Modernization Act—likely to the continued detriment of artists.

The Act solely addresses the impact of streaming on the compulsory licensing scheme and the implications of digital streaming on the exclusive rights of copyright holders on services that are a party to the blanket license. The MMA, however, fails to address the overall impact of compulsory licensing on artists, and the unique burden

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165. *The Music Modernization Act §115*, COPYRIGHT.GOV, <https://www.copyright.gov/music-modernization/115/> [https://perma.cc/37B9-WLMH] [https://web.archive.org/web/20240927011541/https://copyright.gov/music-modernization/115/] (last visited Feb. 21, 2024).

166. *What Is the Music Modernization Act?*, SONGTRUST, <https://blog.songtrust.com/what-is-the-music-modernization-act> [https://perma.cc/A59N-ZSFU] [https://web.archive.org/web/20240926165417/https://blog.songtrust.com/what-is-the-music-modernization-act] (last visited Feb. 25, 2024).

167. *Id.*; Holland Gormley, *The Breakdown: What Songwriters Need To Know About the Music Modernization Act and Royalty Payments*, LIBRARY OF CONGRESS BLOGS, (Apr. 13, 2020), <https://blogs.loc.gov/copyright/2020/04/the-breakdown-what-songwriters-need-to-know-about-the-music-modernization-act-and-royalty-payments/> [https://perma.cc/9EFN-GHLJ] [https://web.archive.org/web/20240927230208/https://blogs.loc.gov/copyright/2020/04/the-breakdown-what-songwriters-need-to-know-about-the-music-modernization-act-and-royalty-payments/].

168. *What Is the Music Modernization Act (MMA)?*, EASYSong, <https://support.easysong.com/hc/en-us/articles/360061317833-What-Is-The-Music-Modernization-Act-MMA> [https://web.archive.org/web/20240420232903/https://support.easysong.com/hc/en-us/articles/360061317833-What-Is-The-Music-Modernization-Act-MMA] (last visited Nov. 5, 2024).

169. *Id.*

170. See Gormley, *supra* note 167.



placed on Black artists in a long legacy of musical and cultural appropriation. Firstly, the new digital-covering system created by the MMA is still compulsory—artists are given no control over how their music is covered, and who it is covered by. While it may create an avenue for centralized compensation for the rightsholders, it fails to necessarily protect the artists' interest in how their work is used or copied. Additionally, the Act fails to address the use of works on Streaming services for training and use in artificial intelligence systems and platforms. To fully protect artists' work and integrity, not only should the licensing system be amended to reflect a centralized, voluntary system across digital, physical, and analog systems, but Congress should additionally introduce the recognition of a moral right for artists under the existing copyright scheme. For Black artists who have traditionally had their works appropriate or imitated to the appeal of mainstream artists for generations, the continuation of the legal sanctioning of otherwise infringing behavior under the existing licensing perpetuates this cruel legacy.

## V. CONCLUSION

The Black musical experience encapsulates the broader narrative of Black history in America, illustrating a story of appropriation, exploitation, and inequality. Despite having often found their autonomy, livelihoods, and culture mocked, imitated, and appropriated throughout history, these artists have illustrated the very image of resilience. Denied credit, compensation, and acknowledgment in the generational cycle of marginalization and exploitation, Black artists have routinely adapted and shifted to continue to not only use music as an expression of the Black experience, but to continue to create as society takes. In the modern legal landscape, the issue of appropriation and undue profiting from the work of Black artists persists, and continually raises questions about the efficacy of the current copyright infrastructure and its ability to protect the rights of Black musicians. While copyright law operates under supposed "color-blind" neutrality, the system has historically been unable to recognize, respond, and reform the system to better address the social hierarchies and inequities that prevent equal protection for the works of these artists.

From the groundbreaking, industry shifting, and culture-defining contributions through the creation of jazz, rhythm and blues, rock and roll, and now hip-hop, Black artists have continually supported the development of American Popular culture despite the challenges presented by existing intellectual property law. Now, the evolving digital landscape, characterized by streaming platforms and emerging technologies like artificial intelligence, presents both opportunities and challenges for artists. These advancements implicate legal and economic threats to the viability and autonomy of their livelihoods as artists and will undoubtedly and disproportionately affect marginalized communities. However, considering the historical treatment of Black artists under copyright law, and advancements that implicate novel legal questions, intellectual property law is existing in a pivotal moment, with the ability to right historical wrongs and promote equity within the music industry.

This Note proposed a multifaceted approach to addressing these historical, systemic issues that have pervaded genres and generations of Black music. Central to this approach is the adoption and recognition of a moral right for musical artists—an acknowledgement of the intrinsic connection between creator and creation. The recognition of this right would grant artists the right to control the use and exploitation of their works, empowering them to retain autonomy in their works and fair economic distribution. Additionally, the adoption of a voluntary licensing system would grant artists further control over the use and appropriation of their works, while also bolstering a new generation of collaboration and relationships between artists, creators, and the industry to look to the future of music and licensing. By empowering artists to take control of the use of their works, the voluntary licensing system would allow independent artists to better navigate the complexities of the music industry submerged in a digital age, while also promoting innovation and collaboration across generations and genres.

The modern challenges facing Black artists in the music industry today are neither novel nor isolated, but are rather a continuance of a broader, historical tradition of social and societal injustice in the realm of music. By reimagining intellectual property law to directly address these issues and rectify the sins of its past through revolutionary approaches to understanding the digital music age, copyright law can once and for all, truly be just.

# Rhyme and Reason: How Intellectual Property Law Can Inform the Use of Rap Lyrics as Evidence in Criminal Trials

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## INTRODUCTION

On November 27th, 2023, the most high-profile criminal case involving rap lyrics to date began.<sup>1</sup> In this case, Jeffrey Lamar Williams, colloquially known as rapper Young Thug, was charged with ordering and overseeing crimes including “murder, attempted murder, armed robbery, witness intimidation and drug dealing” in connection with his record label, Young Stoner Life.<sup>2</sup> One critical component of the prosecutor’s case-in-chief against Young Thug and his co-conspirators was rap lyrics.<sup>3</sup> Despite overwhelming objections to the use of these rap lyrics by Young Thug’s defense

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1. Joe Coscarelli, *Young Thug’s YSL RICO Trial: What To Know*, N.Y. TIMES (Dec. 12, 2023), <https://www.nytimes.com/article/young-thug-ysl-rico-trial.html>. [<http://web.archive.org/web/20241007023901/https://www.nytimes.com/article/young-thug-ysl-rico-trial.html>].

2. *Id.*

3. *Id.*

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attorneys, other rap artists, and the public writ large, the presiding judge green-lighted the use of at least seventeen sets of rap lyrics.<sup>4</sup>

While Young Thug ultimately pled guilty in this case on October 31, 2024, Young Thug's case represents a larger growing trend in the United States over the past two decades: the use of rap lyrics as evidence in criminal prosecutions, which has the effect of unfairly prejudicing juries against criminal defendants and violating broader principles of both constitutional and evidence law.<sup>5</sup> The introduction of these rap lyrics into evidence proves especially problematic and dangerous for Black and Latino boys and men who already face systemic oppression, bias, and incarceration, and especially for those who lack the same financial resources, platform, and global visibility as Young Thug.<sup>6</sup> Typically, defense counsel object to the introduction of rap lyrics as evidence based on protections within the U.S. Constitution and the Federal Rules of Evidence.<sup>7</sup>

As the use of rap lyrics in criminal prosecutions has increased, so too have the number of proposed solutions and reforms regarding their use. These solutions call for a range of approaches, including the categorical exclusion of rap lyrics as evidence, mandated use of expert witnesses to dissect the rap lyrics in the context of the genre more generally, and limited admission of lyrics that explicitly discuss the specific crime at issue in the defendant's trial. Because this is such a new and evolving area of the law, these solutions often lack a solid doctrinal foundation. The absence of such a doctrinal foundation is detrimental because it creates a barrier to enacting consistent legislation and places more power into the hands of judges, which leads to prejudicial adjudications.

This Note provides a novel doctrinal basis for understanding how courts should treat rap lyrics, based in intellectual property ("IP") law, and proposes two solutions stemming from well-established IP doctrines that put the onus on trial courts, rather than legislatures, to act. The first solution addresses, as a threshold matter, how to determine whether rap lyrics should be admitted at all. Borrowing from trademark

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4. Deena Zaru, *Judge Rules Rap Lyrics Can 'Conditionally' Be Used as Evidence in Young Thug Trial*, ABC NEWS (Nov. 9, 2023), <https://abcnews.go.com/US/judge-rules-rap-lyrics-conditionally-evidence-young-thug/story?id=104760646> [https://perma.cc/ZHL7-4GKQ] [http://web.archive.org/web/20241007030317/https://abcnews.go.com/US/judge-rules-rap-lyrics-conditionally-evidence-young-thug/story?id=104760646].

5. Kate Brumback, *Rapper Young Thug Pleads Guilty To Gang, Drug and Gun Charges*, AP NEWS (Oct. 31, 2024), <https://apnews.com/article/young-thug-trial-guilty-plea-581c38d53dc37f86d5b038f6c23e4b77> [https://web.archive.org/web/20241124203758/https://apnews.com/article/young-thug-trial-guilty-plea-581c38d53dc37f86d5b038f6c23e4b77]; Jaeah Lee, *This Rap Song Helped Sentence a 17-Year-Old To Prison for Life*, N.Y. TIMES (Mar. 30, 2022), <https://www.nytimes.com/2022/03/30/opinion/rap-music-criminal-trials.html> [http://web.archive.org/web/20241007030827/https://www.nytimes.com/2022/03/30/opinion/rap-music-criminal-trials.html].

6. Marmstr3, *Arachnophonia: Rap on Trial*, LISTENING IN: NEWS FROM PARSONS MUSIC LIBR. UNIV. RICHMOND (Feb. 18, 2020), <https://blog.richmond.edu/parsons/tag/rap-on-trial/> [https://perma.cc/6P2E-BW6K] [https://web.archive.org/web/20241004140044/https://blog.richmond.edu/parsons/tag/rap-on-trial/] ("In roughly 95 percent of cases involving rap lyrics, the defendant is a young, black or Latino man with a local fan base, if any fan base at all. Because of their social status, amateur rappers, in the eyes of police and prosecutors, are not real artists.").

7. This Note will consider and reference only the Federal Rules of Evidence (hereinafter, "FRE").

law's spectrum of distinctiveness, a similar spectrum of distinctiveness based on the proximity of the rap lyrics to the specific crime at issue in the trial is an effective solution. This spectrum of distinctiveness encompasses the evidence rule against unfair prejudice and should be used by judges, who already have the requisite experience employing a similar spectrum of distinctiveness in trademark cases, and who are themselves unqualified to dissect rap lyrics.

Second, for those limited situations where rap lyrics *are* deemed admissible, judges should either: (1) provide a court-appointed expert to testify and contextualize the rap lyrics; or (2) allow the defense to bring forth their own expert witness. This solution is based on a cautionary tale from copyright law: the infringement by reproduction doctrine, famously and confusingly codified in the Second Circuit case of *Arnstein v. Porter*.<sup>8</sup> In laying out a two-step test for copyright infringement analysis, the *Arnstein* court categorically excluded expert testimony during step two.<sup>9</sup> Rather than use expert witnesses to determine whether an infringing work constituted improper appropriation, the *Arnstein* court instead relied solely on the response of the ordinary lay hearer (i.e., the jury).<sup>10</sup> This holding is “universally repudiated” by legal copyright scholars.<sup>11</sup> Thus, especially when transferred to the criminal context—where the stakes are much higher—the aftermath of *Arnstein* emphasizes the importance of always permitting, and perhaps even mandating, the use of expert testimony when rap lyrics are introduced against criminal defendants.

Part I provides an overview of how rap lyrics are used as evidence in criminal trials, including how prosecutors introduce these lyrics and how defense attorneys commonly respond. Part II discusses the need to control the use of rap lyrics in criminal trials and various efforts made by legal scholars and legislatures to achieve this end. Part III proposes two solutions rooted in well-established IP doctrines, both of which focus on creating explicit and concrete guidelines for trial court judges to use. Ultimately, rap lyrics should only be admitted in those limited circumstances where the lyrics are explicitly tied to the crime at issue in the trial; and even in these circumstances, criminal defendants should have guaranteed access to expert witnesses who can dissect the contents of these lyrics to the jury.

## I. PART I: BACKGROUND INFORMATION

### A. THE USE OF RAP LYRICS AS EVIDENCE IN CRIMINAL TRIALS

Prosecutors tend to introduce rap lyrics as evidence in one of two ways. First, prosecutors use “lyrics written after the crime . . . as confessions to the alleged criminal

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8. *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946).

9. *Id.* at 468.

10. *Id.*

11. Shyamkrishna Balganesh, *The Questionable Origins of the Copyright Infringement Analysis*, 68 STAN. L. REV. 791, 791 (2016).

acts”; that is, as substantive evidence.<sup>12</sup> When introduced as substantive evidence, i.e., for the truth of the matter asserted, the lyrics are inadmissible hearsay.<sup>13</sup> However, prosecutors overcome this objection under the hearsay exception of admissions by party opponents.<sup>14</sup> Second, prosecutors use rap lyrics written prior to the crime “to show intent,” i.e., to prove *mens rea*.<sup>15</sup>

While prosecutors open the door for the introduction of rap lyrics, it is ultimately judges who determine their admissibility and, if admitted, how the lyrics are treated during trial.<sup>16</sup> As such, judges have a significant role to play. Unfortunately, the case law demonstrates that judges often get it wrong.<sup>17</sup> Such judicial error only furthers the need for control and regulation of when and how rap lyrics should be used as evidence in criminal trials.

In the last thirty years, rap lyrics have increasingly been introduced as evidence and used to convict criminal defendants.<sup>18</sup> Andrea L. Dennis, a leading scholar in this topic area, has manually identified over 500 such cases.<sup>19</sup> What stands out most about these cases is the relevance of race. In roughly 95% of these cases, “the defendant is a young, black or Latino man.”<sup>20</sup> For Black men specifically, the use of rap lyrics as evidence continues centuries-long patterns of oppression and weaponization of black expression and black art.<sup>21</sup> Beyond the oppression of artistic expression, the use and weaponization of rap lyrics against Black and Latino boys and men is also inextricably linked to another rampant form of oppression in America: incarceration. Even though only 13% of Americans are Black, and 19.1% are Latino, each group accounts for 37% and 29.4% of people in prison or jail, respectively.<sup>22</sup> Accordingly, how courts treat rap lyrics as

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12. Briana Carter, Comment, *Lyrics for Lockups: Using Rap Lyrics To Prosecute in America*, 69 MERCER L. REV. 917, 926 (2018).

13. See FED. R. EVID. 801(c).

14. See FED. R. EVID. 801(d)(2)(A).

15. Carter, *supra* note 12, at 926.

16. See FED. R. EVID. 104(a).

17. See, e.g., *Jordan v. State*, 212 So. 3d 836, 855 (Miss. Ct. App. 2015) (in which the trial court did not even view the rap video prior to admitting it into evidence). See also Michael Conklin, *The Extremes of Rap on Trial: An Analysis of the Movement To Ban Rap Lyrics as Evidence*, 95 IND. L.J. 50, 60–61 (2020) (discussing how testimony from experts deemed qualified by judges often does “not even rise to the level of average rap consumer”).

18. Lee, *supra* note 5.

19. ERIK NIELSON & ANDREA L. DENNIS, *RAP ON TRIAL: RACE, LYRICS AND GUILT IN AMERICA* (2019).

20. Marmstr3, *supra* note 6.

21. NIELSON & DENNIS, *supra* note 19, at 22 (“From slave drumming and songs to Jim Crow-era ballads, in cabarets and jook joints, and during the civil rights and black nationalist eras, black art and artists have always been criminally regulated.”).

22. *Race and Ethnicity, PRISON POL’Y INITIATIVE*, [https://www.prisonpolicy.org/research/race\\_and\\_ethnicity/](https://www.prisonpolicy.org/research/race_and_ethnicity/) [https://perma.cc/DQX9-66XF] [https://web.archive.org/web/20241009020806/https://www.prisonpolicy.org/research/race\_and\_ethnicity/] (last visited Oct. 10, 2024); *Hispanic Heritage Month: 2023*, U.S. CENSUS BUREAU (Aug. 17, 2023), <https://www.census.gov/newsroom/facts-for-features/2023/hispanic-heritage-month.html> [https://perma.cc/UB4K-TEUA] [https://web.archive.org/web/20241008023939/https://www.census.gov/newsroom/facts-for-features/2023/hispanic-heritage-month.html]; *Inmate Ethnicity*, FED. BUREAU OF PRISONS (Oct. 25, 2024),

evidence directly implicates the broader systems of oppression and incarceration that exist throughout the United States.

### 1. Common Objections Raised To the Use of Rap Lyrics

This Section will discuss the three primary objections made by defense attorneys to object to the admission of rap lyrics as evidence: The First Amendment, which protects the right to artistic expression; evidence rules prohibiting the admission of character-for-propensity evidence; and evidence rules that shield criminal defendants from admission of evidence that is unfairly prejudicial. In practice, defense attorneys have found more success with the latter two objections rooted in evidence law.

#### a. *The First Amendment*

The First Amendment objection to the introduction of rap lyrics as evidence is seemingly straightforward: The admission of rap lyrics as evidence violates the First Amendment protection of artistic expression.<sup>23</sup> This First Amendment objection was addressed by the Supreme Court in the case of *Elonis v. United States*.<sup>24</sup> There, the Supreme Court held that the true threat exception to First Amendment protections requires proof of a defendant's *intent* to cause actual harm, and language alone cannot constitute such a threat, regardless of how the language makes a victim feel.<sup>25</sup> Despite the success of this argument for the defendant in *Elonis*, he was "not accused of committing an actual crime."<sup>26</sup> This has made subsequent courts reluctant to extend *Elonis*'s holding to criminal contexts where defendants *are* accused of committing an actual crime.<sup>27</sup>

In the context of rap lyrics, courts have been especially "dismissive" of defense attorneys who raise a First Amendment objection.<sup>28</sup> This stems from the fact that "rapper defendants are not considered legitimate artists and rap music does not merit the artistic recognition granted to other forms of art."<sup>29</sup> Thus, efforts to reform the prejudicial use of rap lyrics in criminal prosecutions are more likely to succeed if they are grounded in other, non-constitutional principles.

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[https://www3.fed.bop.gov/about/statistics/statistics\\_inmate\\_ethnicity.jsp](https://www3.fed.bop.gov/about/statistics/statistics_inmate_ethnicity.jsp) [https://perma.cc/G4MV-U56F].

23. U.S. CONST. amend. I.

24. *Elonis v. United States*, 575 U.S. 723 (2015).

25. *Id.* at 739–40.

26. Donald F. Tibbs & Shelly Chauncey, *From Slavery To Hip-Hop: Punishing Black Speech and What's "Unconstitutional" About Prosecuting Young Black Men Through Art*, 52 WASH. U.J.L. & POL'Y 33, 59 (2016).

27. See, e.g., *United States v. Wilson*, 880 F.3d 80, 86–87 (3d Cir. 2018) (reading *Elonis* as applying "only to the extent necessary to prevent criminalizing otherwise innocent conduct and concluding that" *Elonis* was not applicable because the statute at issue "criminaliz[ed] acts knowingly undertaken to deprive someone of property," and thus provided "sufficient mens rea to avoid the risk of making lawful conduct unlawful.").

28. NIELSON & DENNIS, *supra* note 19, at 113.

29. *Id.* at 114.

*b. FRE 404: Impermissible Character Evidence*

Objections rooted in evidence law have been relatively more utilized and successful in practice. One such evidence rule is FRE 404, which outlines parameters for the use of character evidence. Under FRE 404(a)(1), “[e]vidence of a person’s character . . . is not admissible to prove that on a particular occasion the person acted in accordance with the character or trait.”<sup>30</sup> This ban is rooted in fairness to defendants. As the Supreme Court explained in *Michelson v. United States*, character evidence is unquestionably relevant; however, the risk of it influencing the jury such that jury members “prejudge [a defendant] with a bad general record and deny him a fair opportunity to defend against a particular charge” justifies its exclusion.<sup>31</sup> Otherwise put, the rule is justified in two ways: (1) to prevent “inferential error prejudice”; and (2) to prevent “nullification prejudice.”<sup>32</sup> In the context of rap lyrics, defense attorneys argue that rap lyrics are being introduced for impermissible character purposes. The problematic logic goes: Because the defendant wrote violent lyrics, the defendant has a propensity for violence, and therefore, was more likely to have committed the crime at issue in accordance with their violent character.

Unfortunately, the on-its-face logic and strength of the 404(a) argument is undermined by FRE 404(b)(2), which states that character evidence “may be admissible for another purpose.”<sup>33</sup> The statute provides an expansive, non-comprehensive list of such purposes, including capacious concepts like “identity” and “intent.”<sup>34</sup> The breadth of these *permissible* purposes enables prosecutors to mask their *true* purpose for introducing the lyrics (i.e., convincing the jury of the defendant’s propensity to be violent) by having the lyrics put before the jury under the permissible guise of 404(b). Procedurally, prosecutors do so by requesting a limiting instruction from the judge. Limiting instructions enable courts to “routinely assure defendants” that the jury is *only* going to consider the rap lyrics for the permissible purpose, and not the impermissible character evidence purpose.<sup>35</sup> However, limiting instructions have been routinely criticized as ineffective legal fictions that even the Supreme Court has deemed

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30. FED. R. EVID. 404(a)(1).

31. *Michelson v. United States*, 335 U.S. 469, 476 (1948).

32. Ashley G. Chrysler, *Lyrical Lies: Examining the Use of Violent Rap Lyrics as Character Evidence Under FRE 404(b) and 403*, Michigan State University College of Law (2015), <https://www.law.msu.edu/king/2014-2015/Chrysler.pdf> [https://web.archive.org/web/20230531210700/https://www.law.msu.edu/king/2014-2015/Chrysler.pdf].

33. FED. R. EVID. 404(b)(2).

34. *Id.*

35. Andrea Dennis, *Poetic (In)Justice? Rap Music Lyrics as Art, Life, and Criminal Evidence*, 31 COLUM. J.L. & ARTS 1, 11 (2007). *See, e.g.*, *United States v. Foster*, 939 F.2d 445 (permitting prosecutors to introduce lyrics as evidence of the defendant’s knowledge and intent).



untrustworthy.<sup>36</sup> Thus, these assurances are questionable at best, and wholly ineffective at worst.<sup>37</sup>

*c. FRE 403: Unfair Prejudice*

Even in situations where evidence is relevant, or admissible under a FRE 404(b) non-character-for-propensity evidence rationale, FRE 403 grants judges the discretion to exclude evidence “if its probative value is substantially outweighed by a danger of . . . unfair prejudice.”<sup>38</sup> Probative value is tied to relevance in evidence law; both require a determination of whether the evidence “make[s] the fact in issue more or less likely to happen [or to have occurred], no matter how slight its probability is.”<sup>39</sup> However low a bar this is, FRE 403 asks not just whether the evidence *has* probative value, but how *much* it has relative to the risk of unfair prejudice. Given all evidence is prejudicial to some extent, the case law makes clear that FRE 403 is only about the avoidance of “*unfair* prejudice.”<sup>40</sup> Like many other facets of evidence law, the opaqueness of a term like unfair only reinforces the notion that judges retain ultimate discretion.

In the context of rap lyrics, FRE 403 grants a judge the discretion to weigh the lyrics’ probative value (i.e., how helpful the lyrics are in proving a relevant fact in issue is true or not) against their prejudicial effect (i.e., the lyrics’ potential to unfairly bias a jury). Much like other forms of artistic expression and music genres, rappers “often write under fictional personas, reference events in the news . . . and employ lyrical hyperbole.”<sup>41</sup> Thus, “[t]he probative value of rap lyrics is highly questionable,” and in many cases, very low.<sup>42</sup> Weighing this against the pervasive biases that exist against rap music and the Black and Latino artists often behind the music, rap lyrics are especially likely to lead a jury to “declar[e] guilt on an improper basis rather than on proof specific to the offense charged.”<sup>43</sup>

36. See Minn. L. Rev. Ed. Bd., *The Limiting Instruction—Its Effectiveness and Effect*, 51 MINN. L. REV. 264 (1966). See also Peter J. Smith, *New Legal Fictions*, 95 GEO. WASH. L.J. 1435 (2007); *United States v. Stephenson*, 550 F. Supp. 3d 1246, 1253 (M.D. Fla. 2021) (explicitly acknowledging that the “likely curative effect of any limiting instruction is minimal at best” with respect to the admission of defendant’s rap lyrics).

37. The distinction between permissible and impermissible character evidence is particularly unclear in the context of rap lyrics. See Reyna Araibi, Note, “*Every Rhyme I Write*”: *Rap Music as Evidence in Criminal Trials*, 62 ARIZ. L. REV. 805, 832 (2020) (“[T]he normal subject matter of rap music makes it complicated to meaningfully determine if the lyrics demonstrate [purposes like] actual knowledge, motive, or intent, or if they simply talk about guns, drugs, gangs, and violence because of the genre.”).

38. FED. R. EVID. 403.

39. *Probative Value*, LEGAL INFO. INST., [https://www.law.cornell.edu/wex/probative\\_value](https://www.law.cornell.edu/wex/probative_value) [<https://perma.cc/96H2-ZBKD>] [[https://web.archive.org/web/20240117192008/https://www.law.cornell.edu/wex/probative\\_value](https://web.archive.org/web/20240117192008/https://www.law.cornell.edu/wex/probative_value)] (last visited Oct. 10, 2024).

40. *United States v. Mehanna*, 735 F.3d 32, 64 (1st Cir. 2013) (internal citation omitted) (emphasis in original).

41. Kelly McGlynn, Jacob Schriener-Briggs & Jacquelyn Schell, *Lyrics in Limine: Rap Music and Criminal Prosecutions*, 38 COMM’NS LAW. 10, 11 (2023).

42. *Id.*

43. *Old Chief v. United States*, 519 U.S. 172, 172 (1997).

## 2. Notable Case Law: Treatment of Rap Lyrics in Practice

In the 1991 case *United States v. Foster*, prosecutors introduced rap lyrics as evidence to help convict a criminal defendant for the first time.<sup>44</sup> Since then, cases which employ rap lyrics as evidence track the objections outlined in Part II.B and illustrate the expanded use of objections by defense attorneys—from the ultimately discretionary FRE 403 objection to more concrete constitutional objections. Despite these efforts, judges remain reluctant to exclude rap lyrics. *State v. Skinner* marked a rare victory for a criminal defendant, which now poses the question: How can we make the outcome of *Skinner* a norm, rather than an exception?

### a. *United States v. Foster*

*United States v. Foster* marks the first known case where prosecutors introduced and used rap lyrics to convict a criminal defendant, thereby “ignit[ing] a trend across the country in which prosecutors use defendant-authored rap music as evidence at trial.”<sup>45</sup> Defendant Derek Foster faced criminal charges for possession with intent to distribute cocaine and phencyclidine.<sup>46</sup> The prosecution sought to introduce a verse written by the defendant, including the lines, “Key for Key” and “I’m the biggest Dope Dealer and I serve all over town,” as evidence rebutting Foster’s claim of naivete.<sup>47</sup> Defense counsel for Foster objected under FRE 403, arguing that “the prejudice from admitting the verse clearly outweighed its minimal relevance to the issue of knowledge” about the suitcases containing drugs.<sup>48</sup>

The Seventh Circuit held that the district court properly admitted the verse because “it [was] sufficient that the verse made it more probable that Foster had knowledge” based on the verse’s indication “that Foster was familiar with drug code words and . . . narcotics trafficking, [which] made it more probable that he knew that he was carrying illegal drugs.”<sup>49</sup> While the court explicitly acknowledged that these lyrics were a work of fiction, not autobiography, they held that “in writing about this ‘fictional’ character, Foster exhibited knowledge of an activity that is far from fictional,” and therefore, it was relevant.<sup>50</sup> The court rejected defense counsel’s argument of unfair prejudice, merely deferring to the judgment of the district court, which found that the verse was not unfairly prejudicial. Such deference in the context of evidence rules is typical of evidence law and underscores the need to target reform at the trial court level.

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44. *United States v. Foster*, 939 F.2d 445 (7th Cir. 1991).

45. Araibi, *supra* note 37, at 805.

46. *Foster*, 939 F.2d at 449.

47. *Id.*

48. *Id.* at 455; *see also* FED. R. EVID. 403 (providing courts the discretion to “exclude relevant evidence if its probative value is substantially outweighed by a danger of . . . unfair prejudice”).

49. *Foster*, 939 F.2d at 455.

50. *Id.* at 456.

b. *People v. Olguin*

*People v. Olguin* is heralded as “the seminal [California] case allowing rap lyrics as evidence,” which has informed and emboldened prosecutors across the country and acted as convincing precedent for lower courts to admit rap lyrics into evidence.<sup>51</sup> Three weeks following the crime at issue in the case, police found handwritten rap lyrics when searching one of Defendant Olguin’s co-defendant’s homes.<sup>52</sup> These lyrics included references to certain gang membership and “could be interpreted as referring to disk-jockeying, a part-time employment of [co-Defendant].”<sup>53</sup> Unlike defense counsel in *Foster*, who objected solely under the discretionary FRE 403 unfair prejudice rule, Olguin’s defense counsel further objected to the admission of the lyrics under more concrete bases: impermissible character evidence and the Sixth Amendment right to confrontation.<sup>54</sup>

Similar to *Foster*, the court held that “[t]he mere fact the lyrics might be interpreted as reflective of a generally violent attitude” did not make them unduly prejudicial under FRE 403.<sup>55</sup> On the more concrete character evidence objection, the court held that the lyrics were not impermissible character evidence because of the proper limiting instruction provided to the jury.<sup>56</sup> Given concerns about the effectiveness of limiting instructions, in practice, this holding permitted the jurors to consider the rap lyrics in their entirety for any reason.<sup>57</sup> Finally, the court rejected the *Bruton* Sixth Amendment confrontation clause argument, holding that the lyrics did “not inculcate Olguin any more than they would inculcate any of a hundred other [gang members].”<sup>58</sup>

c. *United States v. Wilson*

*United States v. Wilson* illuminates the progression of the jurisprudence on the admission of rap lyrics as evidence, specifically with respect to the treatment of expert witnesses.<sup>59</sup> One of Defendant Wilson’s criminal charges was “causing death through

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51. Charis E. Kubrin & Erik Nielson, *Op-Ed: A New California Trend—Prosecuting Rap*, L.A. TIMES (Apr. 7, 2014), <https://www.latimes.com/opinion/op-ed/la-oe-kubrin-and-nielson-rap-prosecution-20140408-story.html> [https://perma.cc/BH4W-SPH6] [https://web.archive.org/web/20241004135836/https://www.latimes.com/opinion/op-ed/la-oe-kubrin-and-nielson-rap-prosecution-20140408-story.html] (further stating that nowadays, “prosecutors in gang cases nationwide are encouraged to follow California’s lead . . . so they can, in the words of former Los Angeles Deputy [District Attorney] Alan Jackson, ‘invade and exploit the defendant’s true personality.’”).

52. *People v. Olguin*, 31 Cal. App. 4th 1355, 1372 (1994).

53. *Id.* (emphasis added).

54. *Id.* at 1373.

55. *Id.*

56. *Id.* at 1374.

57. Minn. L. Rev. Ed. Bd., *supra* note 36, at 264, 267.

58. *Olguin*, 31 Cal. App. 4th at 1374–75; see *Bruton v. United States*, 391 U.S. 123, 126 (1968) (holding that a non-testifying co-defendant’s confession, which incriminates another co-defendant, violates the inculcated co-defendant’s confrontation clause right and is therefore inadmissible as evidence, even with a proper limiting instruction).

59. *United States v. Wilson*, 493 F. Supp. 2d 484, 486 (E.D.N.Y. 2006).

use of a firearm.”<sup>60</sup> The prosecution sought to introduce rap lyrics that Wilson had written in the days following the death of the victims, including the line, “Leave a 45 slogs in da back of ya head cause I’m getting dat bread I ain’t goin stop to I’m dead.”<sup>61</sup> To the prosecution, these rap lyrics “constitute[d] a direct and damning admission of Wilson’s guilt.”<sup>62</sup> To combat the prosecution’s claim, the defense sought to introduce an expert “to testify about the common use of lyrics suggesting/depicting violence as a defining feature of gangsta rap.”<sup>63</sup>

The court held that while such “expert testimony about hip hop culture” has been helpful to the jury in copyright and trademark cases, that is not the case in criminal cases.<sup>64</sup> In the court’s words:

If Wilson wishes to argue that the lyrics are impressionistic and therefore carry little weight, he may do so. It is the jury’s job to determine whether to believe such an argument, however, and it would be counterproductive to permit an expert to function as a “thirteenth juror” in resolving this issue.<sup>65</sup>

The significance of this holding is two-fold. First, it effectively closes the door on expert witnesses brought forth by criminal defendants with respect to rap lyrics, thereby leaving the lyrics’ interpretation up to jury’s own lay opinions, or experts brought forth by the prosecution. Second, it highlights the implicit biases of judges evident when they themselves consider rap lyrics. Judge Garaufis’s above quote assumes that the rap lyrics are not “impressionistic,” and are instead, realistic and autobiographical.<sup>66</sup> This creates a presumption disfavoring the defendant in any given case and undermines the artistic characteristics of rap as a music genre altogether.

#### *d. State v. Skinner*

*State v. Skinner* exemplifies a rare, modern win for criminal defendants.<sup>67</sup> The court established a new, heightened standard for the admission of rap lyrics as evidence against criminal defendants and ultimately held that the rap lyrics were inadmissible.<sup>68</sup> Defendant Skinner was charged with “attempted murder and related charges.”<sup>69</sup> To convict Skinner, the prosecution had a testifying police officer read thirteen pages of rap lyrics found in Skinner’s car.<sup>70</sup> Despite the prosecution’s concessions that the “verses

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60. *Id.* at 485.

61. *Id.* at 489.

62. *Id.* at 490.

63. *Id.* at 486.

64. *Id.* at 489–90.

65. *Id.* at 490.

66. *Id.*

67. *State v. Skinner*, 95 A.3d 236, 238 (N.J. 2014).

68. *Id.* at 238–39.

69. *Id.* at 238.

70. *Id.* at 241 (including lyrics like “You pricks goin’ to listen to Threat tonight. ‘Cause feel when I pump this P-89 into your head like lice. Slugs will pass ya’ D, like Montana and Rice, that’s five hammers, 16 shots to damage your life, leave you f\* \* \* \*s all bloody.”).

were in any way revealing of some specific factual connection that strongly tied defendant to the underlying incident,” and that many of the lyrics had been written far before the events in question, they argued that the lyrics revealed the defendant’s “motive and intent.”<sup>71</sup>

The New Jersey Supreme Court excluded the lyrics, acknowledging that “[n]ot all members of society recognize the artistic or expressive value in graphic writing about violence and a culture of hate and revenge,” and thus, the potential for unfair prejudice outweighed any probative value.<sup>72</sup> Taking its holding one step farther, the court established a new rule: “Fictional forms of inflammatory self-expression,” including rap lyrics that depict “bad acts, wrongful acts, or crimes,” are inadmissible unless there is “a strong nexus between the specific details of the artistic composition and the circumstances of the underlying offense.”<sup>73</sup> Further, even in situations where such a nexus exists, courts must take into account the availability of other evidence that could “make the same point.”<sup>74</sup> While the ultimate rule is still one of discretion for trial courts—determining what constitutes a strong nexus—it is the most notable of its kind in limiting the admission of rap lyrics as evidence against criminal defendants.

Altogether, these cases are instructive in a few respects. First, judges are provided an extraordinary amount of discretion about the admission or exclusion of rap lyrics as evidence. Second, this designation is one worthy of skepticism, given many judges’ own biases and lack of understanding of rap music as a genre. Third, prosecutors are eager to introduce rap lyrics as an alternative means for the jury to declare a defendant’s guilt, whether or not the rap lyrics are actually relevant to the crime at issue in any given case.

## II. PART II: THE NEED TO CONTROL THE USE OF RAP LYRICS IN CRIMINAL TRIALS

### A. UNEQUAL TREATMENT AND THE IMPACT OF PROSECUTING RAP

#### 1. The Disproportionate Impact and Consequences of Prosecuting Rap on Black and Latino Boys and Men

The introduction of rap lyrics as evidence against criminal defendants disproportionately impacts Black and Latino boys and men.<sup>75</sup> Further, once a judge deems rap lyrics admissible, the lyrics are put into the discretion and consideration of the jury, whose own biases and flaws can lead to damning convictions.

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71. *Id.* at 238.

72. *Id.* at 249.

73. *Id.* at 238–39.

74. *Id.* at 239.

75. See Marmstr3, *supra* note 6; see also Taifha Natalee Alexander, *Chopped & Screwed: Hip Hop from Cultural Expression To a Means of Criminal Enforcement*, 12 HARV. J. SPORTS & ENT. L. 211, 214 (2021) (describing the relationship between prosecution against rappers and mass incarceration).

One general study about how jurors perceive Black defendants found that “all-white juries are more likely to convict black defendants than white ones, and . . . that prosecutors attempt to exclude younger people from the jury pool.”<sup>76</sup> Given the demographic of rappers—predominantly “young, urban, and black”—it is no coincidence that these defendants face disproportionate consequences from the introduction of rap lyrics as evidence.<sup>77</sup> These disproportionate consequences find support in studies specific to rap lyrics, which have found that there is a “substantial jury bias against rapper-defendants” and that “extant negative stigmas surrounding rap music are exacerbated when rap lyrics are admitted into trial.”<sup>78</sup>

Much like the origins of rap as a genre, these statistics are deeply connected to mass incarceration in America and its disproportionate impact on Black men. It is a reality of our carceral system that police officers, prosecutors, and jurors are biased against, and often explicitly target, defendants of color.<sup>79</sup> Thus, when a prosecutor seeks to introduce rap lyrics, they do so against defendants who already have the odds stacked against them. The stakes get even higher when considering that rap lyrics are used by prosecutors across the entire spectrum of criminal charges, including ones where the ultimate consequence is capital punishment.<sup>80</sup> Leading scholars have identified at least thirty cases where prosecutors sought to introduce rap lyrics to aid them in securing a death sentence.<sup>81</sup> This is to say that in many cases, a judge’s decision to admit or deny rap lyrics can be a matter of life or death.

## 2. Rap Is Uniquely Targeted Relative To Other Genres of Music

Rap is only one of many music genres that are widely produced and consumed in the United States. Yet, it is uniquely targeted and sought to be introduced by prosecutors as evidence against criminal defendants as compared to other genres of music. In fact, researchers have only been able to document a singular case “involving defendant-authored music lyrics admitted into evidence that did not appear to be rap music.”<sup>82</sup>

The canonical genre of comparison is country; for instance, Johnny Cash’s *Folsom Prison Blues* where he sings, “I shot a man in Reno just to watch him die.”<sup>83</sup> Of course,

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76. Lewis Beale, *Can Rap Lyrics Send You To Jail? If You’re a Young Black Male, Yes*, DAILY BEAST (Apr. 6, 2015), <https://www.thedailybeast.com/can-rap-lyrics-send-you-to-jail-if-youre-a-young-black-male-yes/> [https://web.archive.org/web/20241005151326/https://www.thedailybeast.com/can-rap-lyrics-send-you-to-jail-if-youre-a-young-black-male-yes]. See also Jacinto Gau, *The Impact of Selection Procedures on Diversity in Juries*, CRIME & JUST. RSCH. ALL. (Sept. 21, 2015) (finding that “more than 60% of juries consisted of a majority or all White jurors”).

77. Beale, *supra* note 76.

78. Vidhaath Sripathi, *Bars Behind Bars: Rap Lyrics, Character Evidence, and State v. Skinner*, 24 IOWA J. GENDER, RACE & JUST. 207, 220 (2021).

79. See Alexander, *supra* note 75, at 226–27.

80. See, e.g., *People v. Melendez*, 2 Cal. 5th 1, 384 P.3d 1202 (2016); *United States v. Wilson*, 493 F. Supp. 2d 484 (E.D.N.Y. 2006); *Neblett v. Commonwealth*, 2014 WL 3714372 (Ky. Ct. App. July 25, 2014).

81. See NIELSON & DENNIS, *supra* note 19, at 70.

82. Dennis, *supra* note 35, at 2 n.6.

83. JOHNNY CASH, *Folsom Prison Blues*, on I WALK THE LINE (Sun Records 1968).

“[n]o one accused the country legend of murder based on that song.”<sup>84</sup> And even if Johnny Cash had been on trial for murder, numerous studies indicate that neither the prosecution nor jury would have sought to use these lyrics against him. A 1999 study had “participants read a violent lyrical passage,” after which they were told “that it was either a rap song or a country song.”<sup>85</sup> Participants’ differences in reactions were statistically significant depending on whether the lyrics were identified as rap or country.<sup>86</sup> Participants perceived lyrics identified as rap much more negatively than those identified as country, despite the identical content.<sup>87</sup> This differential was particularly stark for age groups 40–52, and 53 and over.<sup>88</sup> Similar results appeared in a 2017 study, where participants “deemed identical lyrics more literal, offensive, and in greater need of regulation when they were characterized as rap compared to country.”<sup>89</sup> These findings reinforce the notion that there exist societal stereotypes against rap music as a genre that inevitably influence jury decision making. Thus, reforms to how rap lyrics are used as evidence must explicitly consider, and address, this notion.

## B. RECENT ACTIVISM

Just as the usage of rap lyrics as evidence in criminal trials has increased over the last few decades, so too has activism condemning this prosecutorial practice.

Social activism has culminated in widespread media attention and public outrage. However, this social activism has primarily focused its attention on famous rappers, who—based on the perceptions of prosecutors and judges—historically lack the need for such protection. Thus, these calls for reform have fallen short by leaving out of the spotlight those whose lives are most commonly at risk: unfamous, amateur rappers.

Another, more concrete form of activism that has begun in the past two years is legislative reform. Both proposed and passed bills have explicitly called out the prejudicial usage and treatment of rap lyrics by prosecutors and judges. However, these legislative efforts also fall short and fail to create the grand scale of change required to address the inequities caused by admitting rap lyrics into evidence. These reforms find themselves incomplete because they lack a solid doctrinal and precedential basis. Given this is a such a new area of the law, legislatures are stuck proposing rough guidelines that sound good in theory. Unfortunately, then, in practice, these bills maintain the same destructive structure that helped create these inequities in the first place: vesting too much discretion with judges.

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84. Martha Neil, *Do Rapper's Lyrics Support Conviction? ACLU Cites Johnny Cash Song, Says Lower Court Was Wrong*, ABA J. (Mar. 27, 2014), [https://www.abajournal.com/news/article/rap\\_music](https://www.abajournal.com/news/article/rap_music) [<https://perma.cc/F66N-ALJJ>] [[https://web.archive.org/web/20241127004221/https://www.abajournal.com/news/article/rap\\_music](https://web.archive.org/web/20241127004221/https://www.abajournal.com/news/article/rap_music)].

85. Carrie B. Fried, *Who's Afraid of Rap: Differential Reaction To Music Lyrics*, 4 J. APPLIED SOC. PSYCH. 705, 705 (1999).

86. *Id.*

87. *Id.* at 708.

88. *Id.* at 713.

89. Adam Dunbar, *Rap Lyrics as Evidence: An Examination of Rap Music, Perceptions of Threat, and Juror Decision Making* (2017) (Ph.D. dissertation, University of California, Irvine) (eScholarship).

## 1. Famous vs. Non-Famous Rappers

When famous Atlanta rapper Young Thug was first charged for conspiracy, in part because of rap lyrics that he had written and released, the rap music industry's greatest leaders rallied around him.<sup>90</sup> The outrage culminated in an open letter published by Warner Music Group with signatures of some of the world's most influential rappers, record labels, and streaming services.<sup>91</sup>

While these famous rappers' calls for action have enabled this issue to gain widespread visibility, the reality is that famous rappers rarely see rap lyrics used against them in court. Rather, it is the not well-known, unfamous rappers who have the most to lose. Judges have explicitly drawn a false distinction between famous and unfamous rappers, stating that famous rappers "speak[] to a general audience for the purpose of entertainment," which is substantively different than "speaking in private to an individual."<sup>92</sup> However, this distinction is premised on a fallacious assumption: that famous rappers' lyrics are limited to consumption in large concert, performance settings. To the contrary, in the same way that an amateur rapper's lyrics may be streamed or performed in an intimate setting, so too can a song by any famous rapper. However, this reality of how our judicial system views amateur rappers creates a need for reforms that prioritize rappers without a platform and audience.

## 2. Recent Legislative Efforts

Just as a California court was the first to admit rap lyrics as evidence against a criminal defendant, so too was California's legislature the first to sign a bill into law limiting their usage.<sup>93</sup> On September 30, 2022, the California legislature officially added California Evidence Code ("CER") Section 352.2 to establish a more structured procedure for courts to use when deciding whether to admit certain forms of expression, including rap lyrics.<sup>94</sup> As a threshold matter of admission under CER

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90. Larisha Paul, *Drake, Megan Thee Stallion, John Legend Sign 'Protect Black Art' Open Letter Defending Creative Expression*, ROLLING STONE (Nov. 1, 2022), <https://www.rollingstone.com/music/music-news/drake-megan-the-stallion-sign-protect-black-art-open-letter-1234622613/> [<https://perma.cc/6QGM-7Y3S>] [<https://web.archive.org/web/20240822181310/https://www.rollingstone.com/music/music-news/drake-megan-the-stallion-sign-protect-black-art-open-letter-1234622613/>].

91. *Art on Trial: Protect Black Art*, <https://www.protectblackart.co/> [<https://perma.cc/NKN6-FNQF>] [<https://web.archive.org/web/20240925183013/https://www.protectblackart.co/>] (last visited Oct. 30, 2024).

92. NIELSON & DENNIS, *supra* note 19, at 110.

93. Natalie Neysa Alund, *California Governor Gavin Newsom Signs Bill Limiting Use of Rap Lyrics as Evidence in Court*, USA TODAY (Oct. 3, 2022), <https://www.usatoday.com/story/news/politics/2022/10/03/california-rap-lyrics-court-evidence/8167269001/> [<https://perma.cc/Q529-BXR9>] [<https://web.archive.org/web/20240802040551/https://www.usatoday.com/story/news/politics/2022/10/03/california-rap-lyrics-court-evidence/8167269001/>].

94. Cal. Evid. Code § 352.2. See *People v. Venable*, 88 Cal. App. 5th 445, 455, 304 Cal. Rptr. 3d 731, 737–38 (2023) (holding that California Evidence Code § 352.2 applied to rap lyrics per the California legislature's explicit intent "to recognize that the use of rap lyrics . . . as circumstantial evidence of motive or



Section 352 (the State code's version of FRE 403), the addendum requires courts to consider the "literal truth" of the expression and the possibility of "inject[ing] racial biases into the proceedings."<sup>95</sup> If the court determines that the expression is admissible, it must then consider the following: testimony describing the social or cultural context of the genre, experimental or social science research "demonstrating that the introduction of [evidence] explicitly or implicitly introduces racial bias into the proceedings," and evidence proffered to rebut the research or testimony.<sup>96</sup>

Despite no other states to date having passed similar bills addressing the use of rap lyrics, various representatives and senators in other states have made efforts to introduce such bills. For instance, on November 17, 2021, New York Senators Brad Hoylman and Jamaal Bailey introduced Bill S7527, which would "prohibit[] prosecutors from using creative expression as criminal evidence . . . without clear and convincing proof that there is a literal, factual nexus between the creative expression and the facts of the case."<sup>97</sup> This very much follows from the rule established by the New Jersey Supreme Court in *State v. Skinner*.<sup>98</sup>

Finally, at the federal level, on July 27, 2022, Georgia Representative Hank Johnson introduced the Restoring Artistic Protection Act of 2022 into the House of Representatives, seeking to amend the Federal Rules of Evidence to include "evidence of a defendant's creative or artistic expression, whether original or derivative" only: (A) "if the expression is original . . . defendant intended a literal meaning"; (B) "if the expression is derivative . . . defendant intended to adopt the literal meaning . . . that the creative expression refers to the specific facts of the crime alleged . . . that the expression is relevant to an issue of fact that is disputed and . . . that the expression has distinct probative value not provided by other admissible evidence."<sup>99</sup> The bill was again reintroduced in 2023, but is still pending in the House.<sup>100</sup>

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intent is not a sufficient justification to overcome substantial evidence that the introduction of rap lyrics creates a substantial risk of unfair prejudice.").

95. Cal. Evid. Code § 352.2(a).

96. Cal. Evid. Code § 352.2(b).

97. Brad Hoylman-Sigal, *Senators Brad Hoylman & Jamaal Bailey Introduce "Rap Music on Trial" Legislation To Prevent Song Lyrics from Being Used as Evidence in Criminal Cases*, N.Y. STATE SENATE (Nov. 17, 2021), <https://www.nysenate.gov/newsroom/press-releases/2021/brad-hoylman-sigal/senators-brad-hoylman-jamaal-bailey-introduce-rap> [<https://web.archive.org/web/20240720194827/https://www.nysenate.gov/newsroom/press-releases/2021/brad-hoylman-sigal/senators-brad-hoylman-jamaal-bailey-introduce-rap>].

98. *State v. Skinner*, 95 A.3d 236 (N.J. 2014).

99. Restoring Artistic Protection Act, H.R. 8351, 117th Cong. (2022).

100. Sofia Lopez, *Congress Reintroduces the Restoring Artistic Protection (RAP) Act, Leading the Federal Efforts To Decriminalize Artistic Expression*, FIRE (May 2, 2023), <https://www.thefire.org/news/congress-reintroduces-restoring-artistic-protection-rap-act-leading-federal-efforts> [<https://perma.cc/EE3F-RFCN>] [<https://web.archive.org/web/20240802040643/https://www.thefire.org/news/congress-reintroduces-restoring-artistic-protection-rap-act-leading-federal-efforts>].

### 3. These Legislative Efforts Continue To Provide Judges with Too Much Discretion

While the legislative attention aimed at reforming the practice of using rap lyrics as evidence against criminal defendants reinforces the need to change the status quo, these efforts and the substantive content of the proposed bills fall short. Despite mandating that judges take certain factors or considerations into account, these bills continue to provide judges with ultimate decision-making power and discretion to admit or exclude rap lyrics.

The legislative instinct to continue granting such judicial discretion—whether conscious or not—is not without explanation. With respect to the codification of evidence rules, often the legislative course of action is adopting evidence rules after a clear consensus in the common law and courts has emerged.<sup>101</sup> This is logical: legislatures defer to judges (relative experts in the practice of evidence law) to work out the major kinks of the legal procedure over time, and only get involved when this iterative process has ceased. However, with respect to the use of rap lyrics as evidence, legislatures have begun involving themselves relatively early—that is, in an area of law that is newly emerging and evolving, and where there does not yet exist a clear consensus amongst the courts nor any history in the common law. This begs the question: Is there a way for legislatures to get involved in a newly evolving area of law that strips judges of this discretion? And if yes, should they get involved?

The answer to both questions is yes: Legislatures can and should pass bills limiting the admission and use of rap lyrics as evidence against criminal defendants. Their intervention is necessary in this new area of the law where judges, who lack subject matter expertise and possess implicit biases, currently possess a wide latitude of discretion. However, for this intervention to be successful and effectuate real change, it needs to be rooted in a solid doctrinal and precedential basis—some area of the law that has withstood the test of time, and from which concrete solutions naturally flow. This will not only increase the legislation’s legitimacy with judicial actors but also allow judges to operationalize the legislation more seamlessly and consistently.

### III. PART III: TWO PROPOSED SOLUTIONS TO THE ADMISSION AND USE OF RAP LYRICS INFORMED BY INTELLECTUAL PROPERTY LAW

As explicitly acknowledged by the *Wilson* court, IP law contains intuitive overlap with the questions posed by the use of rap lyrics as evidence in criminal trials.<sup>102</sup> As a basic example, copyright law broadly protects all “original works of authorship,”

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101. In fact, the initial Federal Rules of Evidence were only “passed by Congress in 1975, after several years of drafting by the Supreme Court.” 2024 *Federal Rules of Evidence*, NAT’L CT. RULES COMM., <https://www.rulesofevidence.org/> [https://perma.cc/6B7U-GYG3] [https://web.archive.org/web/20241002031203/https://www.rulesofevidence.org/] (last visited Nov. 5, 2024).

102. *United States v. Wilson*, 493 F. Supp. 2d 484, 489 (E.D.N.Y. 2006) (citing the use of expert witnesses to understand “hip hop culture” in both copyright and trademark contexts).

including musical compositions.<sup>103</sup> Indeed, copyright disputes over music regularly appear in mass media channels and have affected some of the world's most renowned artists.<sup>104</sup> Thus, many of the questions that arise over the substance of rap lyrics in criminal trials also appear in civil IP cases every day.

Beyond the intuitive appeal of IP law, many core IP doctrines possess both statutory and common law clarity, including trademark law's spectrum of distinctiveness and the copyright doctrine of infringement by reproduction. Applying concepts underlying such well-established IP doctrines has the potential to provide a more coherent and consistent path forward for reforms regarding the use of rap lyrics as evidence.

#### A. INTELLECTUAL PROPERTY PROVIDES AN OPERATIONALIZABLE, DOCTRINAL BASIS FOR HOW COURTS SHOULD TREAT RAP LYRICS AS EVIDENCE

Intellectual property law provides a desirable doctrinal basis for how rap lyrics should be admitted and used as evidence in criminal trials. Two relevant doctrines are the trademark spectrum of distinctiveness and the copyright doctrine of infringement by reproduction, which have existed in their modern forms since 1976 and 1946, respectively.<sup>105</sup> Each arose out of the common law and has remained there since. Therefore, they have been iterated and tested over decades of legal disputes in court such that their strengths and weaknesses are well documented. These IP doctrines have also proven to be adaptable to the rapid societal and technological changes that have occurred since their inception. This sort of stability over time is crucial to the judicial treatment of rap lyrics, as the advent of social media and independent labels projects an increased production and therefore, usage, of rap lyrics in court. Moreover, the fact that these doctrines are well established means that solutions for the treatment of rap lyrics rooted in IP law will not create a large learning curve for judges, who are already familiar with and tasked with operationalizing these IP doctrines in court.

Notwithstanding the sheer length of time that these IP doctrines have existed, they also stand to solve another important part of the current problem with the treatment of rap lyrics as evidence: cabining judicial discretion. Whether by requiring judges to make a declaration of which of four categories a trademark belongs to, or altogether banning a judge's ability to admit expert testimony at a certain stage in copyright, these IP doctrines provide clear, operationalizable instructions that hold judges accountable. Such clarity in the doctrine and accountability for judges who deviate are especially

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103. *What Does Copyright Protect?*, COPYRIGHT.GOV, <https://www.copyright.gov/help/faq/faq-protect.html> [<https://perma.cc/V5AD-TSLF>] (last visited Feb. 21, 2024).

104. See Thania Garcia, *Famous Music Copyright Cases Revisited: Ed Sheeran, Led Zeppelin, Katy Perry and More*, VARIETY (Apr. 27, 2023), <https://variety.com/lists/song-copyright-infringement-cases-ed-sheeran-historic/robin-thicke-pharrell-williams-vs-marvin-gaye-estate-for-blurred-lines/> [<https://perma.cc/U6Y5-QJS2>] [<https://web.archive.org/web/20240208174247/https://variety.com/lists/song-copyright-infringement-cases-ed-sheeran-historic/robin-thicke-pharrell-williams-vs-marvin-gaye-estate-for-blurred-lines/>].

105. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976) (establishing the trademark spectrum of distinctiveness); *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946) (establishing the modern doctrine of infringement by reproduction).

desirable in the context of rap lyrics, given judges' implicit biases and prosecutors' explicit efforts to exploit juror biases.<sup>106</sup>

Finally, while the most glaring difference and therefore, criticism of applying IP law to the treatment of rap lyrics is that IP law covers civil disputes, while the use of rap lyrics occurs most often in criminal cases, the root of the problem—overwhelming judicial discretion and juror biases—are not specific to either civil or criminal law. Further, there are stark similarities that justify IP's application. For starters, often IP disputes, specifically in copyright law, are about music, including rap.<sup>107</sup> The result is that naturally similar questions arise. For instance, in the criminal case of *United States v. Wilson*, the court acknowledged that the same question of “expert testimony about hip hop culture” at issue before it had been helpfully permitted in copyright and trademark cases.<sup>108</sup> While the court in *Wilson* ultimately differentiated from the civil IP cases, stating that the defendant's lyrics were not being offered “to prove substantial similarity to other lyrics, nor [was] their secondary meaning at issue,” why shouldn't we imagine the counterfactual, whereby we *do* consider rap lyrics from these perspectives?<sup>109</sup> That is, what if we *did* ask whether the rap lyrics in question are substantially similar to or hold secondary meaning when compared to industry norms?

#### B. FROM TRADEMARK LAW TO RAP LYRICS AS EVIDENCE: ESTABLISHING A RAP LYRIC “SPECTRUM OF DISTINCTIVENESS”

One proposed solution to the prejudicial use of rap lyrics as evidence in criminal trials mirrors the trademark spectrum of distinctiveness. The trademark spectrum of distinctiveness contains four categories which determine whether a trademark is protectable to begin with. In the context of rap lyrics, this Note propose the creation of a rap lyric spectrum of distinctiveness: three categories which determine whether, as a threshold matter, rap lyrics are admissible. This rap lyric spectrum of distinctiveness centers around how closely related and specific the rap lyrics are to the crimes at issue in the case. It in many ways encompasses the evidence rule against unfair prejudice and should be used by judges, who are themselves subject to implicit biases and unqualified to dissect the content of rap lyrics. As further protection against judges' implicit biases

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106. See Alexander, *supra* note 75, at 231–34. See also Abenaa Owusu-Bempah, *Music on Trial: Challenging the Use of Rap as Evidence in Criminal Courts*, LONDON SCH. ECON. & POL. SCI. (Nov. 15, 2022), <https://www.lse.ac.uk/research/research-for-the-world/race-equity/music-on-trial-challenging-the-use-of-rap-as-evidence-in-criminal-courts> [https://perma.cc/GGB3-NHR3] [https://web.archive.org/web/20240720012420/https://www.lse.ac.uk/research/research-for-the-world/race-equity/music-on-trial-challenging-the-use-of-rap-as-evidence-in-criminal-courts] (summarizing the findings of a study that reviewed over thirty appeal judgments between 2005 and 2020 in England and Wales, which overwhelmingly found rap lyrics “being used as evidence in court to prove acts of criminality.”).

107. See *Music Copyright Cases*, MUSICIANS INST. LIBR., <https://library.mi.edu/musiccopyright/currentcases> [https://perma.cc/5Z4G-YACW] [https://web.archive.org/web/20240901173036/https://library.mi.edu/musiccopyright/currentcases] (last visited Feb. 21, 2024) (providing a list of recent and landmark copyright cases involving music lyrics).

108. *United States v. Wilson*, 493 F. Supp. 2d 484, 489 (E.D.N.Y. 2006).

109. *Id.* at 490.

and lack of subject matter expertise, it would be most beneficial for rap industry experts and leaders to collaborate and use modern machine learning techniques to create a preliminary rap lyric spectrum of distinctiveness, which could serve as a baseline for judges.

### 1. Trademark Law's Spectrum of Distinctiveness

The *sine qua non* of trademark law is distinctiveness: “[T]rademarks are protectable only if they are distinctive.”<sup>110</sup> A trademark’s distinctiveness is determined by a spectrum of distinctiveness, which categorizes marks into one of four categories which denote their “strength” and “inform[] the scope of protection afforded.”<sup>111</sup>

On the farthest end of the spectrum are generic marks, which can never gain protection. Generic marks communicate the “basic nature of articles or services,”<sup>112</sup> rather than the more individualized characteristics of a particular market. Common examples include aspirin and email. The U.S. trademark system does not allow protection of these marks because it would “grant[] a monopoly in the product.”<sup>113</sup>

Next are descriptive marks, which have a clear link to and identify some distinct element of a product. Descriptive marks can only gain protection if there is secondary meaning. Secondary meaning requires affirmative proof that the primary significance of the term in the minds of the consuming public is not the product, but the producer. Evidence presented to show secondary meaning typically comes in one of three forms: “a claim of ownership of one or more previous federal registrations for substantially the same mark for similar products or services, five years of substantially exclusive and continuous use, and actual evidence.”<sup>114</sup> Actual evidence often takes the form of “consumer surveys, consumer testimony, . . . [or] the amount of customers.”<sup>115</sup>

Third on the spectrum are suggestive marks, which *suggest*, rather than describe, some characteristic of the product, i.e. there is *some* link, but consumers must still make

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110. *Distinctive Trademark*, LEGAL INFO. INST., [https://www.law.cornell.edu/wex/distinctive\\_trademark](https://www.law.cornell.edu/wex/distinctive_trademark) [https://perma.cc/8D48-JG2F] [https://web.archive.org/web/20240603184949/https://www.law.cornell.edu/wex/distinctive\_trademark] (last visited Oct. 9, 2024) (providing definition of “distinctive trademark”).

111. *Trademarks: The Spectrum of Distinctiveness*, DRM (Apr. 18, 2016), <https://www.drm.com/articles/trademarks-the-spectrum-of-distinctiveness> [https://perma.cc/G99R-XEAX] [https://web.archive.org/web/20240617204804/https://www.drm.com/articles/trademarks-the-spectrum-of-distinctiveness/].

112. *Am. Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 11 (5th Cir. 1974).

113. *Generic Terms Legally Excluded from Trademark Protection*, JUSTIA, <https://www.justia.com/intellectual-property/trademarks/strength-of-marks/generic-terms> [https://perma.cc/U775-XAUW] [https://web.archive.org/web/20241002112447/https://www.justia.com/intellectual-property/trademarks/strength-of-marks/generic-terms/] (last visited Oct. 18, 2024).

114. *Descriptive Trademarks and Service Marks & Their Potential Legal Protection*, JUSTIA, <https://www.justia.com/intellectual-property/trademarks/strength-of-marks/descriptive-marks/> [https://perma.cc/8EP3-WE44] [https://web.archive.org/web/20240709103752/https://www.justia.com/intellectual-property/trademarks/strength-of-marks/descriptive-marks/] (last visited Oct. 18, 2024).

115. *Id.*

an inferential leap. A common example is Coppertone, a sunscreen brand. These marks are considered inherently distinctive and therefore, receive protection without any other proof required. Finally, there are arbitrary or fanciful marks that have no relation at all to the product or service, such as Apple, a technology brand that sells personal computers and cellphones.

## 2. Merits and Critiques of the Trademark Spectrum of Distinctiveness

Overall, the trademark spectrum of distinctiveness forces judges to be explicit about their decision-making by placing the trademark at issue into one of the four aforementioned categories. This benefits all involved parties to the suit, as well as judges, both ex-ante and ex-post. The spectrum of distinctiveness provides courts guidelines based on a catalog of past terms placed into each category, which leads to more consistent adjudications. It similarly provides trademark holders who are parties to a suit the ability to predict how their chosen trademark will be protected in court, which may inform how they choose this trademark in the first place. These same benefits can be expected when applied to a rap lyric spectrum of distinctiveness.

The biggest criticism of trademark law's spectrum of distinctiveness surrounds secondary meaning. For one, it seems that large corporations with resources are easily able to establish secondary meaning by expending advertising resources and conducting consumer surveys, which allow them to gain protection for otherwise unprotectable marks.<sup>116</sup> Additionally, the Supreme Court's recent expansion of secondary meaning "as relevant for the protectability of marks that might potentially be classified as generic" has the undesired effect of "mov[ing] a term that might plausibly be generic into the descriptive category, thus rendering it protectable."<sup>117</sup> Thus, a rap lyric spectrum of distinctiveness must apply this critique, and redefine secondary meaning to eliminate the use of such external lay data on public opinion. The other major criticism of the spectrum of distinctiveness is that it is hard to operationalize in non-verbal contexts, such as trade dress.<sup>118</sup> Because the rap spectrum of distinctiveness focuses explicitly on rap lyrics (rather than, e.g., rap music videos), this criticism is beyond the solution's scope.

## 3. Proposed Solution: A Rap Lyric Spectrum of Distinctiveness

In the same way that the spectrum of distinctiveness decides, as a threshold matter, whether a trademark can receive protection at all, a three-prong rap lyric spectrum of distinctiveness could determine whether rap lyrics can be admitted as evidence in any

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116. See Jeanne C. Fromer, *Against Secondary Meaning*, 98 NOTRE DAME L. REV. 211, 211 (Nov. 16, 2022) (discussing the "competitive inequalities secondary meaning creates which hurt smaller and newer businesses").

117. *Id.* at 224.

118. See, e.g., Glenn Mitchell & Rose Auslander, *Trade Dress Protection: Will a Statutorily Unified Standard Result in a Functionally Superior Solution?*, 88 TRADEMARK REP. 472 (1998).

given criminal case. Rather than distinctiveness, the *sine qua non* of a rap lyric spectrum of distinctiveness is the lyrics' proximity to the crime at issue in the case.

The first category of distinctiveness is generic rap lyrics: lyrics and phrases that are commonly used in the genre and have no nexus to the crime at issue. In the same way that generic trademarks never get protection, so too generic rap lyrics should be categorically excluded from use in a criminal trial. The lyrics at issue in *State v. Skinner* provide an example of lyrics that would fall into this category.<sup>119</sup> Some of the lyrics that the prosecution sought to introduce depicted "rape and other violent and demeaning treatment of women."<sup>120</sup> Not only were some of these lyrics commonplace for the genre, they had absolutely no connection to the attempted murder charges at issue.<sup>121</sup> Thus, they were properly excluded by the court under this rap lyric spectrum of distinctiveness.

The second category of distinctiveness is descriptive lyrics: lyrics and phrases that are commonly used in the genre but speak more generally about the crime at issue. These lyrics should be excluded unless the prosecution can prove by clear and convincing evidence that there is secondary meaning indicating that the lyrics show the defendant had first-hand experience with the general crime at issue and is not merely speaking about it in the abstract. Secondary meaning should include considerations of several factors, some of which are explored next.

A court might consider contemporaneity, i.e., how closely in time to the crime the rap lyrics were written. If the lyrics were written directly before or after the crime, that has a higher tendency to show that the defendant was involved in the crime than if the lyrics were written years before or after the crime at issue. Next, a court may consider how the lyrics fit into the defendant's broader rap music portfolio, if it exists. A defendant who raps more regularly, and in different ways, about a specific type of crime is more likely to have experience with that crime than a defendant who has only mentioned the type of crime once. Finally, a court may consider how a defendant has advertised or marketed the rap lyrics in commercial settings. A defendant who has made efforts to advertise their rap lyrics to the public—whether by posting on social media or paying for a billboard—should be taken as having produced the descriptive lyrics under a desire for commercial success, i.e. the lyrics merely encompass "stock lyrical topics and tropes shared by performers," that "imitate the lyric formulas of more successful musicians in the hopes of establishing their own credibility and sharing in that success."<sup>122</sup> Such an explicit consideration is necessary to help ensure that courts

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119. *State v. Skinner*, 95 A.3d 236 (N.J. 2014).

120. *Id.* at 241.

121. For instance, one of the admitted lyrics was "f \* \* k her until tomorrow." *See id.* at 241. Functionally identical lyrics can be found in numerous other rap songs. *See, e.g.,* HELLBXY, *See Ya Tomorrow*, on NIGHT IN PURGATORI (2024); GLO RILLA, *Tomorrow*, on TOMORROW (CMG/Interscope Records 2022); FREDDIE DREDD, *Limbo*, on FREDDIE'S INFERNO (RCA Records 2022).

122. Nicholas Stoia, Kyle Adams & Kevin Drakulich, *Rap Lyrics as Evidence: What Can Music Theory Tell Us?*, 8 RACE AND JUST. 1, 3 (2017).

treat rap lyrics like other genres of music, which are automatically presumed as fictional under this same line of reasoning.<sup>123</sup>

Unlike trademark law's secondary meaning jurisprudence, a consideration of rap lyrics' secondary meaning should not allow for the introduction of surveys that would permit lay listeners to provide reactions to the lyrics in question. First, allowing such external lay data would lead to a similar power imbalance as that found in trademark law. Much like wealthy corporations have the power to influence secondary meaning in civil trademark law, prosecutors have relatively unlimited resources to conduct surveys until they, too, reach their desired survey results in criminal law. Second, these surveys are likely to be inaccurate or perpetuate societal biases that the spectrum of distinctiveness' entire purpose is to mitigate.

The third and final category of distinctiveness is arbitrary rap lyrics: lyrics that are so specific to the crime at issue in a case that they are considered *arbitrary* to the generalized genre of rap because they indicate firsthand experience and involvement in the specific crime. These lyrics may include identifying information about the crime, such as exact date, timing, names of those involved, description of the weapon used, and other information that is corroborated by other, independent evidence.

The lyrics at issue in *Commonwealth v. Thomas* help illustrate an application of the second and third categories.<sup>124</sup> In *Thomas*, the defendant was on trial for shooting someone in retaliation for an alleged drug theft.<sup>125</sup> To make their case, the prosecution sought to introduce rap lyrics written by the criminal defendant that told the "story of an individual who is angered that someone stole a brick of cocaine belonging to the narrator and states that 'somebody gonna die on this [corner]. For touching s \* \* \* don't belong to ya.'" <sup>126</sup> In the appellate court's words, because "[t]he lyrics did not mention the victim by name and, standing alone, any connection between the lyrics and the crime is entirely speculative," these lyrics would fall into the second category.<sup>127</sup> Therefore, the lyrics would be inadmissible unless the prosecution could prove clear and convincing independent evidence that the defendant had first-hand experience with the crime at issue. The prosecution did not point out anything to this effect, and therefore, the spectrum of distinctiveness would have come to the same conclusion as the appellate court that the lyrics were inadmissible.<sup>128</sup>

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123. See *id.* at 2 (discussing rap in relation to opera where, unlike rap, it is understood that "violent and sexual themes are conventions within the genre and that it would have been bizarre to treat [famous operas] as somehow representing the literal wishes of their composers or to interpret the lyrics penned by their librettists as autobiographical admissions of crimes.") (footnote omitted).

124. *Commonwealth v. Thomas*, No. 1121 EDA 2013, 2015 WL 6457805 (Pa. Super. Ct. Oct. 2, 2015).

125. *Id.* at \*1.

126. *Id.* at \*3.

127. *Id.* at \*6.

128. *Id.*



### 3. Rap Industry Experts and Leaders Should Collaborate To Create a Baseline Spectrum of Distinctiveness

While trademark law's spectrum of distinctiveness relies on common-sense, everyday consumer perceptions that judges are equipped to determine and categorize, rap lyrics are more complicated. Therefore, rap industry experts and leaders are uniquely positioned to gather and create a preliminary guide outlining the above-described spectrum of distinctiveness for rap lyrics. Such a starting point—created by piecing together the most common words and phrases used in rap—would provide great guidance to judges making these preliminary determinations.

Empirical efforts to this end are already being made. Matt Daniels and his team at The DataFace have used over twenty-six million words from the top 500 charting artists on Billboard's Rap Chart to determine which words were most used, compared the use of words in rap against other genres, and even mapped the lyrical similarity of rappers in an interactive graph.<sup>129</sup> In a separate evaluation, they ranked rappers by the number of unique words used in their lyrics.<sup>130</sup> With the rise of ChatGPT and machine learning techniques, it is increasingly possible and accessible to create such rough categorizations of popular rap lyrics. By taking this work away from judges, who suffer from implicit biases, and instead, empowering empirical data, criminal defendants face relatively lower risk of unfair prejudice from the admission of their rap lyrics.

#### C. SOLUTION 2: AVOIDING *ARNSTEIN* AND MANDATING THE USE OF EXPERT WITNESSES IN CASES INVOLVING RAP LYRICS

While the above solution addresses, as a threshold matter, whether to admit rap lyrics at all, the second solution targets how rap lyrics should be treated once they have cleared this first hurdle, and been deemed admissible. For guidance on how rap lyrics should be treated at trial, which often hinges on the use of expert testimony, the copyright infringement by reproduction doctrine—codified in *Arnstein v. Porter*—is illustrative.<sup>131</sup> There, the Second Circuit categorically banned the use of expert testimony at the substantial similarity phase of copyright infringement cases, instead relying solely on the jury's intuition. This doctrine, and particularly the exclusion of expert testimony, has frustrated copyright scholars since its inception.<sup>132</sup>

In the same way that jurors should not be trusted, without the help of experts, to determine whether two pieces of work are substantially similar in copyright law, jurors should not be trusted to weigh and interpret rap lyrics without the help of experts in

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129. Matt Daniels, *The Language of Hip Hop*, PUDDING (Sept. 2017), <https://pudding.cool/2017/09/hip-hop-words/> [https://perma.cc/VR3Y-6WGJ] [https://web.archive.org/web/20240915214458/https://pudding.cool/2017/09/hip-hop-words/].

130. *Id.*

131. *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946).

132. See Balganes, *supra* note 11; see also Alan Latman, "Probative Similarity" as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement, 90 COLUM. L. REV. 1187, 1188–89 (1990); Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 J. COPYRIGHT SOC'Y U.S.A. 719, 719–22 (2010).

criminal cases. Thus, *Arnstein* serve as a cautionary tale justifying the mandated use of expert witnesses in cases involving rap lyrics. When prosecutors introduce rap lyrics, defendants should be given a choice: a court-appointed expert or their own. For indigent defendants, public funding should be provided to allow them to secure their own expert if so desired. This solution will help ensure that otherwise unequal power dynamics between prosecutors and defendants are not exacerbated by the prosecutors' ability to bring forth experts while defendants are left with nothing.

### 1. Copyright Law: The Cautionary Tale of *Arnstein v. Porter*

One of the most important rights of a copyright holder is the exclusive right “to reproduce the copyrighted work.”<sup>133</sup> When a copyright holder seeks to claim an infringement of this right, they must prove two things: (1) actual copying; and (2) substantial similarity. This modern test was established by the Second Circuit in *Arnstein v. Porter*. Each of these steps relies on a jury's ability to distinguish between two similar—and often indistinguishable—works. Because juries are made up of lay people, who are neither experts nor specialists in all areas of copyrightable works, including music, the important question is: How can we empower a jury to make the most informed and unbiased decision?

Step one, actual copying, requires either direct or circumstantial evidence. With respect to circumstantial evidence, a court must look at whether the accused infringer had access to the copyright owners' work, and at the extent of similarity between the two works. The extent of similarity inquiry serves an evidentiary purpose: are the two works similar enough such that it can be implied that one copied the other? The *Arnstein* court reasoned that the factual nature of this inquiry justified the admission of expert testimony to help guide the jury. Thus, in practice, there is an analytical dissection that occurs whereby the work is split into its component parts, and experts advise on which parts are original versus commonly accepted in that particular art. This expert advice helps juries split their evaluation of similarity into two categories: similarity that arose from art-specific themes and tropes versus similarity that likely arose from copying.

Step two, substantial similarity, is a question of whether the infringer improperly appropriated the original work. That is, even if copying did occur, is it substantial enough to qualify as *unlawful*? Like the first step, the *Arnstein* court classified this inquiry as a factual one, i.e., something for the jury to decide. Assuming *arguendo* that this step of the analysis is correctly classified as a factual one—something legal scholars have debated—it should rely on the same nuances and procedure as the first step. That is, if the best way to guide a jury to determine the extent of similarity is through expert testimony, then experts should also be able to guide juries in their decision of whether the copying was improper. However, the *Arnstein* court held that the test for substantial similarity is the “response of the ordinary lay hearer.”<sup>134</sup> In simple terms, this means

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133. 17 U.S.C. § 106(1).

134. *Arnstein*, 154 F.2d at 468.

that the jury—with no expert advice—is meant to listen to the two works, side by side, and make its own subjective determinations about whether the accused work seems improperly appropriative of the original work.

## 2. Critiques of *Arnstein v. Porter*

The second part of the test established by *Arnstein v. Porter*—which mandates that juries alone determine whether a work has unlawfully appropriated the original—has been criticized continuously by legal scholars since its inception.<sup>135</sup> Judge Clark's dissent is a natural starting point for the criticism that has followed. Judge Clark categorizes the two-step analysis as illogical and void of intellect: “one of finding copying which may be approached with musical intelligence and assistance of experts, and another that of illicit copying which must be approached with complete ignorance.”<sup>136</sup> The cognitive dissonance inherent in requiring the same jury to consider helpful expert testimony at one stage, then disregard it at the next, has continued to puzzle legal scholars and courts alike.<sup>137</sup>

Beyond the logistical impracticability of the *Arnstein* test, there are serious reasons to doubt its doctrinal soundness and origins. What many legal scholars take for granted is the *Arnstein* court's assertion that the question of substantial similarity is one of fact for the juries, and not one of law for judges. As put by copyright expert Shyamkrishna Balganesh, the second step requires “making a normative judgment about the legality of such conduct,” which is more a question of law than fact.<sup>138</sup> While such a consequential mischaracterization by a court—in a test that continues to be applied today—is surprising, the origins of the decision and its author add necessary clarity.

Judge Jerome Frank, author of the majority opinion, was more than just a judge on the Second Circuit; he was also an outspoken legal philosopher.<sup>139</sup> In accordance with his skepticism toward judicial discretion, Judge Frank found himself uncomfortable with the lower court opinion, which relied on the judge's “refus[al] to believe the plaintiff's account of the facts.”<sup>140</sup> Based on Judge Frank's correspondence with his fellow judges, the creation of the two-step test in *Arnstein* was much less about substantive copyright law, and much more about his personal views of legal philosophy.<sup>141</sup> Therefore, the *Arnstein* test should not be considered very doctrinally

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135. See Balganesh, *supra* note 11, at 794 (“Copyright's infringement analysis has been variously described as bizarre, mak[ing] no sense, viscid, and problematic.”) (internal citations and quotations omitted).

136. *Arnstein*, 154 F.2d at 476 n.1 (Clark, J., dissenting).

137. See, e.g., Michelle V. Francis, Comment, *Musical Copyright Infringement: The Replacement of Arnstein v. Porter—A More Comprehensive Use of Expert Testimony and the Implementation of an “Actual Audience” Test*, 17 PEPP. L. REV. 493, 496 n.26 (1990); see also Michael Der Manuelian, Note, *The Role of the Expert Witness in Music Copyright Infringement Cases*, 57 FORDHAM L. REV. 127 (1988).

138. Balganesh, *supra* note 11, at 793.

139. See Julius Paul, *Jerome Frank's Contributions to the Philosophy of American Legal Realism*, 11 VAND. L. REV. 753 (1958).

140. Balganesh, *supra* note 11, at 798.

141. *Id.*

sound or reliable in copyright or as applied in other legal contexts. Rather, *Arnstein* and its aftermath should serve as a cautionary tale in two respects. First, for how detrimental an exclusion of expert testimony can be, and second, for how susceptible judges are to imposing their own beliefs into any given case at the expense of future parties and the greater doctrine.

### 3. Proposed Solution: The Mandated Use of Expert Witnesses in Cases Involving Rap Lyrics

In the aftermath of *Arnstein*, two broadly applicable principles have emerged. First, the exclusion of expert testimony—especially in the context of artistic expression and music—leaves a jury up to their own devices, particularly in the context of artistic expression and music. In the context of rap lyrics, where jury biases towards rap music and Black and brown defendants are well documented, this truth is incredibly worrisome.<sup>142</sup> Second, when judges are left to their own devices, the omnipresent risk of them imposing their own biases and beliefs unto the parties before them can lead to dire consequences.

When thinking about the use of rap lyrics in criminal trials, where judges are uniquely at risk of imposing such biases and beliefs, it becomes even more important to cabin judicial discretion. Combining these two principles, the use of expert witness testimony in criminal cases involving rap lyrics should be mandated.<sup>143</sup> Specifically, criminal defendants should always be given a choice: an independent expert employed by the court or the chance to bring their own expert forward. For indigent defendants, public funding should be provided for them to hire their own chosen experts.

With respect to independent experts employed by the court, FRE 706 governs. The court has the discretion to “appoint any expert that the parties agree on and any of its own choosing.”<sup>144</sup> Regardless of who brings the expert forward, the court ultimately decides whether the expert is qualified to testify under FRE 702.<sup>145</sup> These qualifications include the type of “specialized knowledge” that the expert possesses, and whether the expert’s opinions reflect “a reliable application of the principles and methods to the facts of the case.”<sup>146</sup>

When dealing specifically with rap lyrics, the opaqueness of these qualifications has allowed prosecutors to call upon law enforcement officers masked as “gang experts” to testify and “knowingly misrepresent[] rap music to judges and jurors.”<sup>147</sup> These experts

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142. See *supra* text accompanying notes 76–77.

143. The importance of retaining expert witnesses has been underscored by courts all over the country, including the Supreme Court. See *Ake v. Oklahoma*, 470 U.S. 68 (1985) (holding that an indigent defendant has a constitutional right to a psychiatrist expert to build their defense); see also *Hinton v. Alabama*, 571 U.S. 263 (2014) (finding ineffective assistance of counsel where a public defender failed to request additional funding for qualified experts to counter the prosecution’s experts).

144. FED. R. EVID. 706(a).

145. FED. R. EVID. 702.

146. *Id.*

147. Jeremy Wang-Iverson, *Rap on Trial: Conversation with Erik Nielson and Andrea L. Dennis*, VESTO (Apr. 17, 2020), <https://vestopr.com/rap-on-trial-conversation-with-erik-nielson-and-andrea-l-dennis/>

become especially harmful against indigent defendants who are unable to hire their own experts to rebut false and misleading statements.<sup>148</sup> By providing defendants a guaranteed opportunity to introduce their own experts, the negative impact of law enforcement *experts* can be easily called out. Further, such a mandate continues to take discretion away from trial judges, who would be hard pressed to permit a law enforcement expert, whose only qualifications stem from interacting with gangs on the job, while simultaneously denying a defendant's chosen expert.

One glaring concern with mandating the use of expert witnesses is that this solution assumes an abundance of such experts available and willing to testify. However, in tandem with the first proposed solution, the rap lyric spectrum of distinctiveness will decrease the number of instances where the question of expert witnesses even arises, as more rap lyrics will be deemed inadmissible from the beginning. Further, even taking this second proposal as stand-alone, the mandated use of expert witnesses will create a strong incentive for courts and legislatures to train and make experts available, whether by creating robust training and certification programs, or providing financial incentives. One of the most public and prominent expert witnesses for criminal defendants whose rap lyrics are being used against them is University of Richmond Professor Erik Nielson.<sup>149</sup> As the use of rap lyrics in criminal trials continues to gain public recognition, one lingering hope is that more academic scholars will be willing and available to testify as experts.

Better yet, this second proposal will force prosecutors, judges, and legislatures to more seriously consider whether introducing rap lyrics is a worthy enough goal to justify expending resources and enduring additional procedural hurdles. In other words, it forces these actors to confront the glaring asymmetry in resources between prosecutors and indigent defendants, and either ensure that the asymmetry does not exist in the first place by choosing not to admit the rap lyrics or equalize the advantages by mandating that defendants can call testifying expert witnesses.

#### IV. CONCLUSION

The use of rap lyrics against defendants in criminal prosecutions has become increasingly common in the last three decades. The problematic nature of their usage can be summarized by looking at an educational pamphlet funded by a grant from the United States Department of Justice, which encouraged prosecutors to use rap lyrics "to introduce the jury to the real defendant," where a real defendant is defined as "a criminal

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[<https://perma.cc/77UZ-XWJ9>] [<https://web.archive.org/web/20241005151828/https://vestopr.com/rap-on-trial-conversation-with-erik-nielson-and-andrea-l-dennis/>].

148. See Dennis, *supra* note 35, at 35–36 (stating that allowing an expert on rap music to testify is the "ideal means by which to challenge the admissibility and credibility of lyrical evidence offered by the prosecution").

149. See Wang-Iverson, *supra* note 147 ("Erik has served as an expert witness or consultant in roughly 50 cases involving rap lyrics as evidence.").

wearing a do-rag and throwing a gang sign.”<sup>150</sup> The inherent biases and discrimination that inform a prosecutor’s choice to introduce rap lyrics, a judge’s decision to admit them, and a jury’s interpretation of them necessitate reform. However, modern reform efforts have lacked a clear doctrinal basis justifying the proposed changes. Thus, these efforts continue to grant judges too much discretion and disadvantage criminal defendants.

A novel doctrinal basis for the introduction and use of rap lyrics as evidence in criminal trials can be found in IP law, from which two solutions emerge. First, as a threshold matter of admission, drawing on trademark law’s spectrum of distinctiveness, a rap lyric spectrum of distinctiveness based on the lyrics’ proximity to the crime and specificity about the crime will allow lyrics to be admitted only if the prosecutor has met a high burden of proof or if the lyrics are incredibly specific to the crime. Second, once rap lyrics have been shown to possess a close enough nexus to the crime, defendants should always be given the choice of either having a court-appointed expert or selecting their own to testify about the rap lyrics. In an attempt not to repeat the same mistakes created by *Arnstein*, the use of expert witnesses serves to equalize existing asymmetries between prosecutors and criminal defendants, while simultaneously limiting judges’ discretion to admit or deny expert witness testimony.

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150. See Brennan O’Connor, *Why Are Rap Lyrics Being Used as Evidence in Court?*, VICE (Nov. 3, 2014), <https://www.vice.com/en/article/rap-lyrics-as-evidence/> [https://perma.cc/HYW9-BTYG] [https://web.archive.org/save/https://www.vice.com/en/article/rap-lyrics-as-evidence/].



