

Litigating Scènes à Faire

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Scènes à faire: What is it? Generally speaking, it's when certain things are so commonplace, and so naturally associated with the treatment of the subject, that everyone needs to be able to use them in order to also write, or talk, or deal with that subject. What have courts found to be scènes à faire? Lots of different things, in lots of different contexts. Some are easy to picture: If you're going to have an underwater world, having sand dollars as money, oyster shells as plates, and things like that—that makes some sense. Aquaman rides a seahorse; other underwater people might ride seahorses. Or the idea that superheroes wear capes and masks—you can understand that that's something common to the genre that everyone should be free to use. Similarly, if you are setting something in World War II, you might have a German beer hall. If you are setting something in a small town in the American South, you might have a country music bar with a gritty atmosphere and music playing from a jukebox; it's going to be playing a sad song, and then dancing will ensue. More things may happen after that, but the setting could have common elements.

One interesting question is: When does the law test for scènes à faire? In terms of the *when*, merger and scènes à faire are linked in this kind of discussion. Courts are in disagreement as to whether a scènes à faire analysis (and, to a similar extent, merger) should be addressed when the court is determining copyrightability or when it is assessing infringement. The Second Circuit and the Ninth Circuit—where many copyright cases are filed—are of the view that scènes à faire is an affirmative defense in an infringement analysis.¹ This places the burden on the defendant to prove that the scènes à faire element should be filtered out, and that therefore they are able to use it. However, the Sixth Circuit in *Lexmark* disagreed and found that when external factors or expectations (like scènes à faire) control the form of expression, the copyrightability of the work is placed squarely at issue.² The Fifth and Seventh Circuits have also found that scènes à faire and merger belong in a copyrightability

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1. See *Satava v. Lowry*, 323 F.3d 805, 810 n.3 (9th Cir. 2003); *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 322 (2d Cir. 1996).

2. *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 536 (6th Cir. 2004).

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analysis.³ According to this view, if everything in your whole work is something that is *scènes à faire*, then what do you have to protect?

You could argue, as I think my partner Josh Simmons was saying with respect to merger,⁴ that one could assess *scènes à faire* at different times depending on the nature of the work and how much of the work constitutes *scènes à faire*. For instance, if the entire work is *scènes à faire*, then it could make sense to make such an assessment initially, before an infringement analysis. This is consistent with the idea that unless the plaintiff has a registration (*prima facie* evidence of validity and required to file an action in federal court), then the burden falls on the plaintiff to prove that it has a copyright. On the other hand, if the element of *scènes à faire* is only a small portion of the overall work, then it makes sense to filter these elements out and address them later in the substantial similarity portion of an infringement analysis.

One of the things that follows, as a practical matter, is how do you litigate *scènes à faire*? How do you prove it, and via what procedural mechanism? Often, we try to get rid of copyright cases early on a motion to dismiss. That is wonderful because not all cases are meritorious, but almost all cases can be expensive. Subjecting authors to depositions and the distraction and expense associated with them should be avoided, if possible, and most clients will ask to avoid it.

The issue, then, is how do you get the *scènes à faire* information before the court in a motion to dismiss? As to the works themselves, usually if they're not attached to the pleadings, they are incorporated by reference. There is a whole body of law that says that things mentioned in the pleadings are incorporated by reference.⁵ But if you start actually bringing in new facts that aren't in the pleadings, then you risk your motion to dismiss being converted into a motion for summary judgment. A lot of courts only let you have one motion for summary judgment, and it can be risky using the opportunity early on. So how do you get around it? One option is to use the doctrine of judicial notice. Some courts are very strict when deciding to take judicial notice. Local rules may require you to file a formal application for judicial notice. The standard for judicial notice can also be quite high in some courts, such that they could deny it outright. Moreover, the fact in question could be susceptible to many meanings or interpretations; for such facts, seeking judicial notice is not always effective.

That said, sometimes, you can just simply argue that something is subject to judicial notice in a motion to dismiss and the court will simply accept it. For example, you could say, "Your honor, we all know that capes on superheroes are *scènes à faire*. We don't have to debate it, won't you agree?" Some courts will simply say, "I don't need more proof that superheroes in capes are common to the genre." Of course, it is more persuasive to any court if you can cite other cases where, as a matter of law, other courts have recognized something as *scènes à faire*,

3. *Veeck v. Southern Building Code Congress International*, 293 F.3d 791, 801 (5th Cir. 2002); *Ho v. Taflove*, 648 F.3d 489, 493–94 (7th Cir. 2011).

4. See Joshua L. Simmons, *The 5 W's of Merger*, 43 COLUM. J.L. & ARTS 407, 408–10 (2020).

5. See, e.g., *Prentice v. Apfel*, 11 F. Supp. 2d 420, 424 (S.D.N.Y. 1998) (citing *Brass v. Am. Film Techs., Inc.*, 987 F.2d 142, 150 (2d Cir. 1993)).

but that is not always possible. If there is not enough factual information to address *scènes à faire* in an initial motion to dismiss, one alternative is filing a counterclaim asserting non-infringement and pleading various facts that the opposing party would hopefully admit as true in its responsive pleading. If it does admit these facts, then it may be possible to obtain a judgment on the pleadings to dismiss the case. *Scènes à faire* issues may also arise in the context of a preliminary injunction. There, the standards of evidence are more lenient, given the expedited nature of the proceedings, such that putting in evidence to support *scènes à faire* should not be problematic.⁶ Thus, while *scènes à faire* issues could come up early in litigation, they are frequently assessed on summary judgment or at trial.

There are different ways to prove *scènes à faire*. Sometimes you can use fact witnesses to talk about what is and isn't common in their given industry. Problems sometimes arise, however, when relying on a company's fact witness, because while they may know a lot about the practices of their own company or the opposing party, they may not have a broad lens for third-party acts in the industry generally. That's why expert witnesses are so important in trying to establish *scènes à faire*.

There are all kinds of experts. You can have an expert on virtually anything in any case, and normally the opposing party would find a corresponding expert attempting to rebut your expert's testimony. These experts could help provide more information as to what is truly common. For example, a music expert might know that it's commonplace for the root of a chord to appear in a bass line because it establishes the chord. Another example of experts being used to prove *scènes à faire* was a case involving James Bond, where the plaintiff claimed that a television commercial was knocking off the James Bond films.⁷ The experts were able to help prove whether certain motifs or aspects of the James Bond character, like his famous chase scenes, were *scènes à faire* to spy movies in general or rather were distinct to James Bond. Of course, experts are often used to address *scènes à faire* in cases involving software. Similar to music cases, where the judge or the jury may not themselves be able to comfortably recognize *scènes à faire*, software experts could help educate the judge and jury as to what is truly common in the industry.

One question raised in the previous panel is: To what extent can your own copyrighted work become so popular that the work itself becomes *scènes à faire*?⁸ In my opinion, it doesn't make sense to have a rule that works can become *scènes à faire* simply on the grounds of their own popularity. I first ran across this argument when we were litigating the *Harry Potter Lexicon* case.⁹ In this case, the defendant made the argument that the *Harry Potter* books had become so popular that anybody should be free to do whatever they wanted with them. We had J.K. Rowling testify on rebuttal, and I asked her, "What do you think of that argument, Ms. Rowling?" She said, in a very poignant way that makes me remember that copyright law involves real authors and real people, words to the effect of: "When I was choosing

6. See, e.g., *Mullins v. City of New York*, 626 F.3d 47, 52 (2d Cir. 2010).

7. *Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co., Inc.*, 900 F.Supp. 1287, 1294–95 (C.D. Cal. 1995).

8. See *Simmons*, *supra* note 4, at 413.

9. *Warner Bros. Entm't Inc. v. RDR Books*, 575 F. Supp. 2d 513 (S.D.N.Y. 2008).

in life, between typewriter ribbon and money to feed my baby, if I thought that by making something that people liked, that I would have a lesser scope of rights than if I made something that people didn't like, I just wouldn't get it. It wouldn't follow. It would be a devastating thought." To me, that is persuasive.

The idea that a work's popularity could cause a copyright owner to lose its rights is also featured in the current *Oracle* dispute where, as you know, I represent Oracle. In *Oracle v. Google*, Google has argued that the Java coding language has become so popular that people should be free to copy it and take advantage of the language's familiarity.¹⁰ Recently, the Solicitor General's office filed a brief arguing that certiorari should not be granted by the Supreme Court.¹¹ In that brief, the Solicitor General's office wrote that copyrightability should be assessed at the time of creation.¹² The brief argued that it would not make sense to deprive the work of copyright protection later in time simply because of its popularity.¹³ The Solicitor General's office further argued that this would seem to allow any copyist to carve out the most popular parts of a preexisting work on the grounds that familiar content is likely to make the second work more commercially appealing to admirers of the first.¹⁴ In my view, this is contrary to the Constitution, which grants copyright protection in order to incentivize the creation of new works. In any case, while the Solicitor General's office recommended against certiorari, the Supreme Court has decided to grant cert and we will see what the Court eventually decides.

10. *Oracle Am., Inc. v. Google Inc.*, 886 F.3d 1179 (Fed. Cir. 2018)

11. See Brief for the United States as Amicus Curiae, *Google LLC v. Oracle Am., Inc.*, No. 18-956 (U.S. Sept. 27, 2019).

12. *Id.* at 14.

13. *Id.*

14. *Id.* at 20.