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Current Case

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CURRENT CASE


In Broderbund, the United States District Court for the Northern District of California extended the scope of copyright protection beyond computer programs to nongame audiovisual displays. Defendant's version was found to infringe because it had the same "total concept and feel" as the original work. Broderbund is the first Ninth Circuit case to hold that nongame audiovisual displays are protected by copyright. It represents an adoption by the Circuit of Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc., 797 F.2d 1222 (3d Cir. 1986), cert. denied, — U.S. —, 93 L. Ed. 831 (1987).

In the Spring of 1983 David Balsam and Martin Kahn, Pixel-lite Software principals, were developing a program which would allow the user to create a greeting card out of the software disk itself. It was not a printing program. The user, following the disk's instructions, would design and write the greeting card which was stored on the disk. The recipient could then slip the disk into a compatible personal computer and view the greeting card.

Balsam and Kahn brought the program to Broderbund who encouraged them to broaden the concept and develop a printing program. Balsam and Kahn spent about a year developing "The Print Shop," an Apple-compatible program that allowed the printing of greeting cards, signs, posters and banners. It was agreed that Broderbund would have an exclusive license to distribute the program and Broderbund began a successful world-wide marketing campaign.

In May, 1984 Unison began discussions with Broderbund about converting The Print Shop to make it compatible with other computers. Unison also indicated an interest in acquiring the conversion rights to an IBM version. Unison's primary business is converting other publisher's software to other formats. It rarely produces original programs.

A period of cooperation began. Balsam and Kahn met with
Unison and showed the source code to Unison's programmer, McDuff Hughes, to familiarize him with some of the intricacies of the program as then developed. Under the direction of Hong Lu, Unison's president, Hughes began to "imitate" The Print Shop. Hughes met periodically with Balsam and Kahn to discuss progress, the latter giving Hughes pointers about where the difficulties in the program lay.

After considerable progress by Hughes, the Broderbund-Unison negotiations broke down because Lu felt Broderbund was not offering sufficient advance payment on its percentage of future royalties. Lu told Hughes to stop copying The Print Shop but to continue to develop an enhanced version. Hughes was thereafter free to improve what had already been developed. This enhanced version was released by Unison as its own creation in March, 1985, under the name Printmaster. The court found that releasing its own version of The Print Shop "had been Lu's game plan all along." Broderbund at 1131. Hughes kept the copying he had already done which included the menu screens, about ten screens in the "greeting card" and "sign" functions, and the user interface in the "picture editor" function. Subsequently, other programmers elaborated on the program by adding a "calendar" function, simplifying the way that ready-made designs could be selected and by providing for the memorization of user-created designs. Otherwise, the Unison-IBM version was identical to the one on which Hughes had worked.

Plaintiffs brought this action in May, 1985, for copyright infringement, trademark infringement and unfair competition. The court severed the case and tried only the audiovisual copyright infringement claim. In November, 1985, Broderbund released its IBM version of The Print Shop.

The court dealt first with the question of whether audiovisuals are protected under copyright law. Citing Whelan with approval, the court found that the overall structure, sequencing and layout of screens fall within the scope of copyright protection.

In rejecting the argument that The Print Shop audiovisuals did not warrant copyright protection because they were not "pictorial" or "graphic" works within the meaning of 17 U.S.C. § 101 (1977) but were, rather, mechanical or utilitarian features, the court found that the structure, sequence and layout of the audiovisuals "were dictated primarily by artistic and aesthetic considerations" and, therefore, protected. The court also used the artistic and aesthetic
finding to reject defendant’s argument that the menu screens were not protected because they were merely “rules and instructions.”

Having found the audiovisual displays protected, the court turned to the question of whether there had been copying. Copying can be shown either directly or indirectly. Since direct evidence of copying is rarely available, it is most often shown indirectly by proving access and substantial similarity. The court found that plaintiffs had established copying directly. However, in the interest of making a comprehensive record, it went on to an analysis of the indirect evidence and found both access and substantial similarity.

The singular importance of *Broderbund* is that in its discussion of substantial similarity it extends the “total concept and feel” test of *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106 (9th Cir. 1970) to nongame audiovisuals. The Ninth Circuit test (*Sid & Marty Krofft Television Productions, Inc. v. McDonald’s Corp.*, 562 F.2d 1157 (9th Cir. 1977) for substantial similarity is two-pronged. The extrinsic evidence prong tests the substantial similarity of the underlying ideas by way of expert testimony and analytical dissection. This is an attempt to quantify the similarities in a side-by-side comparison of each element of the two works. The intrinsic prong is a test for similarity in the way in which the idea is expressed. Under *Krofft*, the intrinsic prong is a reasonable person test and does not rely on either expert testimony or analytical dissection. “The question is whether the infringing work captures the ‘total concept and feel’ of the protected work.” *Broderbund* at 1137.

One of the questions raised by extending so broad a test to non-game audiovisuals is whether nongame audiovisuals are more likely than games to present situations in which there are significantly fewer possible expressions of an idea.¹ That is not to suggest that nongame audiovisuals are less creative, but that the creativity may be less obvious than in traditionally protected works of fantasy, and therefore, more problematic for the courts. To the extent that this is so, the use of so amorphous a test as “total concept and feel” may extend copyright so far that it has an anti-competitive effect, thus slowing the growth rate of the industry. It also means that parties will have to become mired in the intricacies and vagaries of where to draw the idea-expression line, plaintiffs wanting to draw it higher.

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¹. One of the conceptual difficulties that complicates both prongs of the substantial similarity test is differentiating between the underlying idea and its expression. This follows from the well-established principle that while an expression of an idea is protected by copyright, the idea isn’t. If an idea is capable of only one or very few expressions, copyright protection is not available.
up on the abstraction scale and defendants, obviously, further down.

Perhaps an even greater problem presented by too broad an extension of "concept and feel" is that it may cause the industry to feel less certain of what can be used as a creative step in the development of one's own program. Lack of predictability in this area of the law may have a direct impact on the rate at which the computer industry continues to grow creatively. One commentator has already suggested protective steps that can be taken to defeat possible future litigation.\(^2\) Perhaps "defensive" programming is a sign of the times.

Given these concerns which have already hit the industry, it is important to note Broderbund's limitations. As indicated above, copying can be shown directly or indirectly. If shown indirectly, plaintiff must show access and substantial similarity. Thus, substantial similarity, with its idea-expression conceptual vagaries, comes into play only if there is no direct evidence of copying. In Broderbund, the Court found sufficient direct evidence of copying to establish infringement, thus rendering the discussion of substantial similarity and the application of "total concept and feel" to non-game audiovisuals unnecessary to the holding. The direct evidence was the uncontradicted testimony that Unison's president and its product's manager had ordered their programmer to copy The Print Shop and the testimony of the programmer that even after the "copy" orders had been suspended in favor of simply enhancing the program, he had kept in the Unison program all the previously copied parts in the interests of speed. The remaining analysis of indirect evidence and the application of "concept and feel" to nongame audiovisuals is, therefore, dicta.

Furthermore, the court's substantial similarity analysis incorporates its own checks on an overly-liberal application of "concept and feel." Even though it rejects the Whelan modification of the Krofft test, it adds its own modifications to Krofft. In the intrinsic prong,\(^3\) the court found first that the ordinary reasonable person would find the programs substantially similar which is all that Krofft requires. However, the court adds an analytical dissection

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2. Davidson, The Whelan Decision: Missing the Middle Ground, 5 (3) COMPUTER LAW REPORTER 335 (Nov. 1986).

3. In the extrinsic prong, the court finds similarity of underlying idea based on expert testimony. However, it goes on to comment that even a lay observer could tell that the purpose and uses of the two programs are virtually identical. Although only dicta, this comment could prove slippery ground for the court when distinguishing idea from expression in very sophisticated technological areas, e.g., artificial intelligence.
element. Although the court uses the troublingly vague phrase “an eerie resemblance between the screens,” it reduces the resemblance to its component elements, some structural and some functional, for example, the structures of the “Main Menu” screens, a “staggered” layout of 3-2-3-2-3, the highlighting and inverse highlighting of the same words on the same screens, and the requirement of both programs that the user create the front of the printed product before creating the inside. It is not mentioned whether the court enumerated these similarities on its own or from expert testimony. It should also be noted that these similarities were in addition to detailed evidence of significant investments by Pixellite and of access and direct copying by Unison. So although “total concept and feel” sounds quite vague, much of that vagueness is attenuated by the factual findings and by anchoring the test to specific variables through analytical dissection.

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