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## Benay v. Warner Bros. Entertainment, Inc.: New Standard Needed For Determining Actual Use

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## NOTE

*BENAY v. WARNER BROS.  
ENTERTAINMENT, INC.:*  
NEW STANDARD NEEDED FOR  
DETERMINING ACTUAL USE

## INTRODUCTION

Picture a screenwriter who watches a movie and realizes that its storyline is similar to a screenplay that she registered with the United States Copyright Office.<sup>1</sup> The copyright prevents others from copying the screenwriter's method of expressing ideas.<sup>2</sup> Further suppose that the screenwriter attempted to sell her screenplay to the film's producer some time before the release of the movie, but her screenplay was rejected. Nevertheless, the two stories share the same familiar settings, historical facts, and situations that are customary for their genre. For instance, envision that the two works are about Japanese samurai and share such elements as martial arts, decorative armor, and fight scenes involving the use of katanas.<sup>3</sup>

One cause of action the screenwriter may plead is copyright infringement pursuant to 17 U.S.C. § 501(b).<sup>4</sup> In this context, the court would interpret federal law to determine if the screenwriter is afforded relief.<sup>5</sup> Suppose that the screenwriter brings a copyright infringement

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<sup>1</sup> The United States Copyright Office reviews copyright applications and issues certificates of registration when all the registration formalities are satisfied. 17 U.S.C.A. § 410 (Westlaw 2011).

<sup>2</sup> *Cavalier v. Random House, Inc.*, 297 F.3d 815, 823 (9th Cir. 2002).

<sup>3</sup> Katana is a moderately curved, single-edged sword historically associated with Japanese samurai. *Katana Definition*, DICTIONARY.COM, <http://dictionary.reference.com/browse/katana> (last visited Apr. 26, 2011).

<sup>4</sup> 17 U.S.C.A. § 501(b) (Westlaw 2011).

<sup>5</sup> *Id.*

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action and alleges that the production company copied aspects of her screenplay without permission. The court will require a showing of substantial similarity between the screenwriter's copyrighted work and the alleged infringing work for the screenwriter to prevail.<sup>6</sup> Since the copyright infringement standard for substantial similarity is a high burden to meet, the screenwriter will not find relief under federal law by merely showing similarities between characteristics that typically arise from the two works' shared genre.<sup>7</sup>

Imagine that the screenwriter also pleads a separate cause of action for breach of contract. Courts in this context refer to state law to determine if a contract existed and if the defendant breached the agreement.<sup>8</sup> Although breach of an express contract may be an available cause of action, due to their superior bargaining power over screenwriters, producers will seldom make explicit agreements.<sup>9</sup> The screenwriter may nonetheless plead a breach of an implied-in-fact contract. A California claim for breach of an implied-in-fact contract over the use of an idea also requires substantial similarity between the works, but California has a much lower standard of proof for substantial similarity than a federal copyright infringement claim.<sup>10</sup> Either cause of action, however, may provide the plaintiff protection of rights to his or her creative work.<sup>11</sup> While the availability of multiple causes of action with varying standards of proof may please the screenwriter, it creates problems because authors are given too much protection in their creative works at the expense of the promotion of art and science.

In *Benay v. Warner Bros. Entertainment, Inc.*, the United States Court of Appeals for the Ninth Circuit was presented with both causes of

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<sup>6</sup> *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072, 1076 (9th Cir. 2006) (quoting *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481 (9th Cir. 2000)).

<sup>7</sup> See *Benay v. Warner Bros. Entm't, Inc.*, 607 F.3d 620, 625 (9th Cir. 2010) (finding that the similarities between the two works were insufficient for copyright infringement, since most similarities arose naturally from the two works' shared premise of an American war veteran who travels to Japan to fight the samurai rebellion).

<sup>8</sup> 23 RICHARD A. LORD, *WILLISTON ON CONTRACTS* § 63:10 (4th ed. 2010).

<sup>9</sup> Kerry Ryan, *Using the Uniform Commercial Code to Protect the "Ideas" That Make the Movies*, 27 SANTA CLARA L. REV. 693, 697-98 (1987) (discussing producers' reluctance to make express contracts due to their greater bargaining power over screenwriters).

<sup>10</sup> See *Benay*, 607 F.3d at 631 ("[O]ur holding (above) that the Screenplay and the Film are not substantially similar for purposes of copyright infringement does not preclude a finding of substantial similarity for purposes of an implied-in-fact contract under California law.").

<sup>11</sup> See *Shaw v. Lindheim*, 919 F.2d 1353, 1363 (9th Cir. 1990) (reversing summary judgment on the copyright infringement claim since there were enough similarities between the two works at issue to present a triable issue of material fact); see also *Buchwald v. Paramount Pictures Corp.*, No. C 706083, 1990 WL 357611, at \*15 (Cal. Super. Ct. Jan. 8, 1990) (finding that there were enough similarities between the two works at issue for purposes of breach of contract).

action and concluded that a lack of substantial similarity under federal copyright infringement law did not preclude a finding of substantial similarity under California law for breach of an implied-in-fact contract.<sup>12</sup> Two brothers, Aaron and Matthew Benay (the “Benays”), wrote a screenplay entitled *The Last Samurai* (the “Screenplay”), and provided a written copy of the Screenplay to Warner Brothers Entertainment, Inc. (“Warner Brothers”).<sup>13</sup> The parties created an implied-in-fact contract with the mutual understanding that the Benays would be compensated if Warner Brothers used the Screenplay to produce a movie.<sup>14</sup> After Warner Brothers released the film *The Last Samurai* (the “Film”), the Benays brought an action that included claims for copyright infringement under federal law and breach of implied-in-fact contract under California law.<sup>15</sup> The Benays alleged that they were never compensated after Warner Brothers copied aspects from their Screenplay to produce the Film.<sup>16</sup> In support of their claim, the Benays pointed to similarities in historical facts, common characters, and standard scenes that naturally arose from the two works’ shared premise of an American war veteran who travels to Japan to fight the samurai rebellion.<sup>17</sup> These similarities, however, were mere “unprotectable elements” that flowed necessarily and naturally from their basic plot premise.<sup>18</sup> Accordingly, the Ninth Circuit affirmed the grant of summary judgment for Warner Brothers on the federal claim, because substantial similarity between mere unprotectable elements is insufficient to prove copyright infringement.<sup>19</sup> However, the Ninth Circuit reversed and remanded the grant of summary judgment on the California law contract claim because a showing of substantial similarity between unprotectable elements is not necessarily insufficient to prove a breach of an implied-in-fact contract claim.<sup>20</sup>

This Note examines *Benay v. Warner Bros. Entertainment, Inc.*, and the substantial-similarity standard under a California breach of an implied-in-fact contract claim and a federal copyright infringement claim. The standard used in *Benay* will hinder the free flow of ideas by

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<sup>12</sup> *Benay v. Warner Bros. Entm’t, Inc.*, 607 F.3d 620, 631 (9th Cir. 2010).

<sup>13</sup> *Id.* at 622.

<sup>14</sup> *Id.* at 622-23.

<sup>15</sup> *Id.* at 622.

<sup>16</sup> *Id.*

<sup>17</sup> *Id.* at 625.

<sup>18</sup> *Id.* (explaining that unprotectable elements “are shared historical facts, familiar stock scenes, and characteristics that flow naturally from the works’ shared basic plot premise”).

<sup>19</sup> *Id.* at 629.

<sup>20</sup> *Id.* at 632.

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detering producers from accepting an author's screenplay for fear of breaching an implied-in-fact contract. Part I of this Note summarizes the history and development of the protection of rights to creative works. Part II provides the facts and procedural history of *Benay v. Warner Bros. Entertainment, Inc.* Part III analyzes and criticizes the Ninth Circuit's holding in *Benay*. Finally, Part IV proposes that California's standard for a breach of an implied-in-fact contract claim, like that brought by the Benays, should be heightened so that a plaintiff must show substantial similarity between protectable elements, not merely between unprotectable elements. This Note proposes a standard that will not only promote the purposes of copyright law but also better indicate when the plaintiff's work was actually used in creating the defendant's production.

I. HISTORY AND DEVELOPMENT OF THE PROTECTION OF RIGHTS TO CREATIVE WORKS

A. COPYRIGHT INFRINGEMENT UNDER FEDERAL LAW

The enactment of copyright laws in the United States is authorized by the Copyright Clause of the federal Constitution, which states, "The Congress shall have Power . . . To 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."<sup>21</sup> In response, Congress has authorized the copywriting of works under 17 U.S.C. § 501(b), which empowers a copyright holder to institute an action for copyright infringement.<sup>22</sup> However, an author does not have an absolute right to prevent others from creating a similar work.<sup>23</sup> Others are free to use the same fact or idea as the author did, as long as they do not copy the author's original expression.<sup>24</sup>

A copyright therefore gives limited rights to an author by preventing others from copying his or her method of using facts and expressing

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<sup>21</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>22</sup> 17 U.S.C.A. § 501(b) (Westlaw 2011).

<sup>23</sup> 17 U.S.C.A. § 102(b) (Westlaw 2011) ("In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.").

<sup>24</sup> See, e.g., *Baker v. Selden*, 101 U.S. 99, 103 (1879) ("The copyright of a book on perspective, no matter how many drawings and illustrations it may contain, gives no exclusive right to the modes of drawing described, though they may never have been known or used before.").

ideas.<sup>25</sup> While copyright protection instantly attaches upon the creation of an original work, registration must be made with the United States Copyright Office before a claim for copyright infringement may be brought.<sup>26</sup> To register a copyright, a registrant must send a completed application form, a filing fee, and records of the work to the United States Copyright Office.<sup>27</sup> The United States Copyright Office reviews the application for errors and issues a certificate of registration when all the registration formalities are satisfied.<sup>28</sup>

In order to prevail on a federal copyright infringement claim, the plaintiff must show that he or she owned a copyright, and that the defendant copied original elements of the copyrighted work.<sup>29</sup> To establish the latter, the plaintiff must prove that the defendant had access to the copyrighted work, and that there is substantial similarity between the copyrighted work and the alleged infringing work under two tests: the intrinsic test and the extrinsic test.<sup>30</sup>

### 1. *The Intrinsic Test*

The intrinsic test is a subjective comparison that focuses on whether the ordinary, reasonable audience would find the two works substantially similar in their total concept and feel.<sup>31</sup> The inquiry must be made without expert analysis and requires the plaintiff to prove that an ordinary observer would find that the ideas between the two works are substantially similar.<sup>32</sup> Thus, the pivotal issue is what makes two works “substantially similar.”

In *Litchfield v. Spielberg*, Lisa Litchfield, the author of a musical play entitled *Lokey from Maldemar* brought suit against the producers of the film *E.T.: The Extra-Terrestrial* for federal copyright infringement, among other claims.<sup>33</sup> Since expert testimony and the comparison of individual features of the works are not appropriate when applying the intrinsic test, the only available evidence to infer substantial similarity

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<sup>25</sup> *Id.*

<sup>26</sup> 17 U.S.C.A. § 411 (Westlaw 2011).

<sup>27</sup> 17 U.S.C.A. § 408 (Westlaw 2011).

<sup>28</sup> 17 U.S.C.A. § 410 (Westlaw 2011).

<sup>29</sup> *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072, 1076 (9th Cir. 2006) (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991)).

<sup>30</sup> *See Berkic v. Crichton*, 761 F.2d 1289, 1292 (9th Cir. 1985) (stating that the substantial-similarity requirement implies a two-pronged analysis of general ideas and the expression of those ideas).

<sup>31</sup> *Id.*

<sup>32</sup> *Id.*

<sup>33</sup> *Litchfield v. Spielberg*, 736 F.2d 1352, 1354-55 (9th Cir. 1984).

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was the total concept and feel of the two works.<sup>34</sup> The Ninth Circuit observed that *Lokey from Maldemar* used satire to critique mankind's egotism, whereas *E.T.: The Extra-Terrestrial* used character development to highlight the bond between a child and an extra-terrestrial.<sup>35</sup> Applying the intrinsic test, the so-called "Court of Appeals for the Hollywood Circuit"<sup>36</sup> held that no reasonable juror would find that *E.T.: The Extra-Terrestrial* was substantially similar to *Lokey from Maldemar*.<sup>37</sup>

## 2. *The Extrinsic Test—Protectable Elements Versus Unprotectable Elements*

The extrinsic test is an objective comparison that focuses on whether the individual expressive elements of the works are substantially similar.<sup>38</sup> For instance, the extrinsic test can focus on similarities between the plot, themes, dialogue, mood, setting, pace, characters, and sequence of events.<sup>39</sup> Unlike the intrinsic test, the court "compares, not the basic plot ideas for stories, but the actual concrete elements that make up the total sequence of events and the relationships between the major characters."<sup>40</sup> On a motion for summary judgment, the court applies only the extrinsic test, because the intrinsic test is the jury's exclusive responsibility.<sup>41</sup> If the plaintiff fails to satisfy the extrinsic test, summary judgment is entered for the defendant, but if plaintiff satisfies the extrinsic test, there must be a trial on the intrinsic test.<sup>42</sup>

In *Kouf v. Walt Disney Pictures & Television*, for example, Jeffrey Kouf alleged that Walt Disney Pictures & Television's film *Honey, I Shrunk the Kids*, involving kids who were accidentally shrunk by a ray gun invention, infringed on his copyrighted screenplay *The Formula*, about a

<sup>34</sup> *Id.* at 1357.

<sup>35</sup> *Id.*

<sup>36</sup> *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1521 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc) ("For better or worse, we are the Court of Appeals for the Hollywood Circuit.").

<sup>37</sup> *Litchfield*, 736 F.2d at 1357.

<sup>38</sup> *Id.* at 1356.

<sup>39</sup> See *Benay v. Warner Bros. Entm't, Inc.*, 607 F.3d 620, 632 (9th Cir. 2010) (quoting *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994)).

<sup>40</sup> *Berkic v. Crichton*, 761 F.2d 1289, 1293 (9th Cir. 1985).

<sup>41</sup> See *Benay*, 607 F.3d at 632 ("On a motion for summary judgment, we apply only the extrinsic test. The intrinsic test is left to the trier of fact."); see also *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072, 1081 (9th Cir. 2006) (applying only the extrinsic test and finding that the two works at issue were not substantially similar).

<sup>42</sup> *Benay*, 607 F.3d at 632.

boy genius who invented a formula to shrink people.<sup>43</sup> The two works had substantially different plots, themes, and sequences of events, given that the characters in *Honey, I Shrank the Kids* and *The Formula* were “shrunk to different sizes (1/4 inch versus 1 foot), by different means (ray gun machine versus liquid formula), for different reasons (accident versus evil thieves), [and] with different frequency (once versus several times).”<sup>44</sup> The mood, setting, and pace differed because *The Formula* was a dark adventure that took place at many different locations in the span of a week, whereas *Honey, I Shrank the Kids* was a light-hearted comedy that took place at the family residence in less than a day.<sup>45</sup> Applying the extrinsic test, the Ninth Circuit agreed with the district court that the works were not substantially similar.<sup>46</sup>

When applying the extrinsic test, the court must separate the protectable elements from the unprotectable elements.<sup>47</sup> Unprotectable elements include stock scenes, historical facts, and themes that are staples of literature.<sup>48</sup> Unprotectable scènes-à-faire refer to customary characters, scenes or situations that naturally arise from a basic plot premise.<sup>49</sup> An example of scènes-à-faire can be found in *Walker v. Time Life Films, Inc.*, involving a book and a film that depicted adventures of a New York police department.<sup>50</sup> The Second Circuit found that “[e]lements such as drunks, prostitutes, vermin and derelict cars would appear in any realistic work about . . . policemen in the South Bronx,” and were therefore unprotectable scènes-à-faire.<sup>51</sup> Furthermore, “[f]oot chases and the morale problems of policemen, not to mention the familiar figure of the Irish cop, are venerable and often-recurring themes of police fiction.”<sup>52</sup>

After the elements of the works have been separated, the court must inquire into whether the protectable elements, and not the unprotectable elements, are substantially similar.<sup>53</sup> Copyright protection, thus, cannot

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<sup>43</sup> Kouf v. Walt Disney Pictures & Television, 16 F.3d 1042, 1043 (9th Cir. 1994).

<sup>44</sup> *Id.* at 1045.

<sup>45</sup> *Id.*

<sup>46</sup> *Id.* at 1046.

<sup>47</sup> See *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002) (finding that there was insufficient similarity after the protectable elements were separated from the unprotectable elements).

<sup>48</sup> *Id.* at 822-23.

<sup>49</sup> *Id.*

<sup>50</sup> *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 46-47 (2d Cir. 1986).

<sup>51</sup> *Id.* at 50.

<sup>52</sup> *Id.*

<sup>53</sup> *Cavalier*, 297 F.3d at 822.



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be extended to stock characters or familiar scenes in a story.<sup>54</sup> If all the similarities between the works arise from the use of unprotectable elements, the plaintiff fails to satisfy the extrinsic test.<sup>55</sup> In *Williams v. Crichton*, for instance, Geoffrey Williams, author of a series of children's books entitled *Dinosaur World*, brought an action for copyright infringement against the creators of the movie *Jurassic Park*.<sup>56</sup> The Second Circuit found no infringement because the elements of electrified fences, automated tours, and dinosaur nurseries were unprotectable scènes-à-faire that inevitably flowed from the two works' shared premise of a dinosaur adventure park.<sup>57</sup>

Treating the protectable elements and unprotectable elements differently is justified by the distinction between an unprotectable idea and the protectable expression of that idea.<sup>58</sup> This so-called "idea-expression dichotomy" means that "[c]opyright law only protects expression of ideas, not the ideas themselves."<sup>59</sup> In *Baker v. Selden*, the landmark case explaining the idea-expression dichotomy, Charles Selden obtained a copyright for a book on the art of bookkeeping, which he called *Selden's Condensed Ledger*.<sup>60</sup> Baker produced a book with a similar bookkeeping method that achieved similar results but was made with a different arrangement of columns and headings.<sup>61</sup> The United States Supreme Court held that *Selden's Condensed Ledger* was not infringed by Baker's book, since an author's original expression is protected by copyright, while the facts and ideas explained by the work are public property.<sup>62</sup> This principle attempts to reward individuals for their creativity and effort while at the same time promoting the progress of science and art by permitting the public to use the same subject matter.<sup>63</sup> For fear of granting monopolies over ideas, copyright law prevents individuals from taking the basic idea for a story out of the circulation of public property.<sup>64</sup> The courts have recognized that authors must work from ideas within the public domain, and in turn, the courts

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<sup>54</sup> *Id.* at 823.

<sup>55</sup> *Benay v. Warner Bros. Entm't, Inc.*, 607 F.3d 620, 632 (9th Cir. 2010).

<sup>56</sup> *Williams v. Crichton*, 84 F.3d 581, 582 (2d Cir. 1996).

<sup>57</sup> *Id.* at 589.

<sup>58</sup> *Cavalier v. Random House, Inc.*, 297 F.3d 815, 823 (9th Cir. 2002).

<sup>59</sup> *Id.*

<sup>60</sup> *Baker v. Selden*, 101 U.S. 99, 99-101 (1879).

<sup>61</sup> *Id.*

<sup>62</sup> *Id.* at 107.

<sup>63</sup> Karen L. Poston, *All Puff and No Stuff: Avoiding the Idea/Expression Dichotomy*, 9 LOY. L.A. ENT. L. REV. 337, 343 (1989).

<sup>64</sup> *Id.*

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have created the distinction between protectable elements and unprotectable elements.<sup>65</sup>

**B. EXPRESS CONTRACT UNDER CALIFORNIA LAW**

State law offers protection of rights to creative works under certain contractual circumstances.<sup>66</sup> While copyright infringement is based on federal law,<sup>67</sup> breach of contract is independently grounded in state law.<sup>68</sup> For instance, federal copyright law offers an author protection as against everyone, even those who never entered into a contract with the author.<sup>69</sup> Thus, a screenwriter is able to bring both a federal copyright infringement claim and a state breach of contract claim.<sup>70</sup> An express contract is an agreement the conditions of which are explicitly stated in words.<sup>71</sup> However, while there are a large number of screenwriters who wish to sell their ideas, there are fewer production companies that wish to buy screenplays.<sup>72</sup> As a result of their superior bargaining power over screenwriters, production companies will hardly ever make explicit promises, and therefore, express contracts are rarely of help to screenwriters.<sup>73</sup> However, other causes of action are still available to screenwriters.

**C. IMPLIED-IN-FACT CONTRACT UNDER CALIFORNIA LAW**

An implied-in-fact contract is one in which the parties' agreement is not expressed in words.<sup>74</sup> An implied-in-fact contract, for example, includes conditions that are manifested by conduct.<sup>75</sup> In the absence of an express contract, when a service or good is requested, then subsequently rendered or provided, the law infers or implies a promise to

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<sup>65</sup> *Id.*

<sup>66</sup> See *Benay v. Warner Bros. Entm't, Inc.*, 607 F.3d 620, 629 (9th Cir. 2010) ("Contract law, whether through express or implied-in-fact contracts, is the most significant remaining state-law protection for literary or artistic ideas.").

<sup>67</sup> 17 U.S.C.A. § 501(b) (Westlaw 2011).

<sup>68</sup> 23 RICHARD A. LORD, *WILLISTON ON CONTRACTS* § 63:10 (4th ed. 2010).

<sup>69</sup> See generally *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1043 (9th Cir. 1994) (recognizing that the plaintiff was able to bring a copyright infringement claim even though a contract was never entered into with defendant).

<sup>70</sup> *Id.*

<sup>71</sup> 1 RICHARD A. LORD, *WILLISTON ON CONTRACTS* § 1:5 (4th ed. 2010).

<sup>72</sup> Kerry Ryan, *Using the Uniform Commercial Code to Protect the 'Ideas' That Make the Movies*, 27 SANTA CLARA L. REV. 693, 697 (1987).

<sup>73</sup> *Id.* at 697-98.

<sup>74</sup> *Desny v. Wilder*, 299 P.2d 257, 267-68 (Cal. 1956).

<sup>75</sup> *Id.* at 269.

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pay for it.<sup>76</sup> If the law obligates the producer to provide compensation for the use of the author's idea and the producer refuses to pay, then the implied-in-fact contract has been breached.<sup>77</sup>

An author may therefore plead a cause of action for breach of an implied-in-fact contract under state law.<sup>78</sup> The California Supreme Court announced the rule for the formation of an implied-in-fact contract for the use of an idea in the case of *Desny v. Wilder*, the landmark decision in so-called "idea submission cases."<sup>79</sup> Victor Desny telephoned the office of Billy Wilder, the producer for Paramount Pictures, and read his synopsis for a movie to Wilder's secretary.<sup>80</sup> Although Desny never directly communicated with Wilder, the secretary had authority to receive and transmit messages to Wilder.<sup>81</sup> Desny told the secretary that Wilder could use the story only if Desny was paid "the reasonable value of it."<sup>82</sup> The secretary assured Desny that if Wilder and Paramount Pictures used the story, "naturally we will pay you for it."<sup>83</sup> Alleging that he was never compensated after his idea was used in Wilder's motion picture photoplay entitled *Ace in the Hole*, Desny brought an action under California law for breach of an implied-in-fact contract.<sup>84</sup>

The *Desny* court held that an implied-in-fact contract exists when the author conditions the disclosure of an idea upon an obligation to pay for it if used, and the buyer voluntarily accepts the disclosure knowing the reasonable value of the work and the condition on which it was tendered.<sup>85</sup> Merely accepting Desny's submission of his idea did not alone contractually obligate Wilder to compensate Desny.<sup>86</sup> Instead, Wilder manifested his assent by knowing the condition to pay for the disclosure of the idea, and then accepting Desny's condition.<sup>87</sup> The conduct of Wilder in accepting the work, therefore, implied a promise to fulfill the condition of payment, and as a result, an implied-in-fact contract was created.<sup>88</sup>

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<sup>76</sup> *Id.* at 266.

<sup>77</sup> *Id.* at 270.

<sup>78</sup> *Id.* at 278.

<sup>79</sup> *Id.* at 274.

<sup>80</sup> *Id.* at 262.

<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

<sup>83</sup> *Id.*

<sup>84</sup> *Id.*

<sup>85</sup> *Id.* at 270.

<sup>86</sup> *Id.*

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

### 1. *Federal Preemption of State Law Protection*

Since copyright is governed by federal law<sup>89</sup> and idea submission claims are built on state law,<sup>90</sup> federal law can preempt protection of rights to creative works under the Supremacy Clause.<sup>91</sup> In 1976, Congress invalidated most state copyright laws by enacting the Federal Copyright Act, which states in relevant part:

On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright . . . in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright . . . are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.<sup>92</sup>

Any state law protecting an author's rights to his or her creative work is preempted insofar as the state law falls within the scope of the federal law.<sup>93</sup> That is, if the plaintiff's state law contract claim alleges rights that are entirely covered by a federal copyright infringement claim, then the plaintiff's state law contract claim will be barred.<sup>94</sup> However, a state breach of an implied-in-fact contract claim will not be preempted by the Federal Copyright Act if the claim alleges an extra element that distinguishes it from a federal copyright infringement claim.<sup>95</sup>

### 2. *Distinguishing State Law Claims from Federal Law Claims*

In *Grosso v. Miramax Film Corp.*, the Ninth Circuit found that a federal copyright infringement claim did not preempt a California breach of an implied-in-fact contract claim.<sup>96</sup> Jeff Grosso submitted his screenplay *The Shell Game* to Miramax Film Corp. with the mutual understanding that Grosso would be reasonably compensated if his idea

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<sup>89</sup> 17 U.S.C.A. § 501(b) (Westlaw 2011).

<sup>90</sup> 23 RICHARD A. LORD, WILLISTON ON CONTRACTS § 63:10 (4th ed. 2010).

<sup>91</sup> U.S. CONST. art. VI, cl. 2 ("This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding.").

<sup>92</sup> 17 U.S.C.A. § 301(a) (Westlaw 2011).

<sup>93</sup> *Id.*

<sup>94</sup> *Grosso v. Miramax Film Corp.*, 383 F.3d 965, 968 (9th Cir. 2004).

<sup>95</sup> *Id.*

<sup>96</sup> *Id.*

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was used.<sup>97</sup> Grosso filed a breach of contract claim under California law and a copyright infringement claim under federal law, alleging that Miramax Film Corp. used his idea when it made the movie *Rounders*, which, like *The Shell Game*, involved poker players in high-stakes games of Texas Hold'em.<sup>98</sup> The *Grosso* court affirmed the grant of summary judgment for Miramax Film Corp. on the federal copyright infringement claim, due to lack of substantial similarity between the two works.<sup>99</sup> Although both works had poker settings, the two works were not substantially similar because the only similarities in dialogue arose from "the use of common, unprotectable poker jargon."<sup>100</sup> As for the breach of contract claim, however, the Ninth Circuit found that the district court erred in holding that the state law claim was equivalent to the federal law claim.<sup>101</sup> The Ninth Circuit held that Grosso's claim for breach of an implied-in-fact contract was not preempted by the Federal Copyright Act, because the extra element of an "implied promise to pay" for the use of the idea transformed the claim from one arising under federal law to one built on state contract law.<sup>102</sup>

In an idea submission case, to prevail under California law on a breach of an implied-in-fact contract claim, the plaintiff must prove that (1) he or she submitted the work for sale to the defendant, (2) he or she conditioned the use of the work on payment, (3) the defendant knew or should have known of the condition, (4) the defendant voluntarily accepted the work, (5) the defendant actually used the work, and (6) the work had value.<sup>103</sup> The fifth element, actual use of the plaintiff's idea by the defendant, has been the most controversial and difficult to prove in idea submission cases.<sup>104</sup> California courts permit actual use to be inferred from evidence of the defendant's access to the idea and substantial similarity between the defendant's production and plaintiff's idea.<sup>105</sup> The degree of similarity necessary to show actual use depends on the conditions of the parties' contract.<sup>106</sup> In breach of express contract claims, the degree of similarity required hinges on the terms of

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<sup>97</sup> *Id.* at 967.

<sup>98</sup> *Id.*

<sup>99</sup> *Id.*

<sup>100</sup> *Id.*

<sup>101</sup> *Id.* at 968.

<sup>102</sup> *Id.*

<sup>103</sup> *Benay v. Warner Bros. Entm't, Inc.*, 607 F.3d 620, 629 (9th Cir. 2010) (citing *Mann v. Columbia Pictures, Inc.*, 180 Cal. Rptr. 522, 533 n.6 (Ct. App. 1982); *Faris v. Enberg*, 158 Cal. Rptr. 704, 709 (Ct. App. 1979)).

<sup>104</sup> *See, e.g., Mann v. Columbia Pictures, Inc.*, 180 Cal. Rptr. 522, 533 (Ct. App. 1982).

<sup>105</sup> *Id.* at 534.

<sup>106</sup> *Benay*, 607 F.3d at 630.

the agreement.<sup>107</sup> In breach of implied-in-fact contract claims, since the parties have not specified any terms, “the weight of California authority is that there must be substantial similarity between plaintiff’s idea and defendant’s production to render defendant liable.”<sup>108</sup> This is the law the Ninth Circuit applied in *Benay v. Warner Bros. Entertainment, Inc.*

## II. FACTS AND PROCEDURAL HISTORY OF *BENAY V. WARNER BROS. ENTERTAINMENT, INC.*

The Benays wrote their Screenplay *The Last Samurai* between 1997 and 1999, and they registered it with the United States Copyright Office in 2001.<sup>109</sup> On May 9, 2000, the Benays’ agent, David Phillips, orally pitched the Screenplay to Richard Solomon, the President of Production for Bedford Falls Productions, Inc. (“Bedford Falls”), a production company in association with Warner Brothers.<sup>110</sup> On May 16, 2000, Phillips provided a written copy of the Screenplay to Solomon with the condition that the Benays would be compensated if Bedford Falls used it to produce a movie.<sup>111</sup> After receiving the Screenplay, Solomon told Phillips that Bedford Falls had declined to use the Screenplay because it was already developing a similar project.<sup>112</sup> On December 5, 2003, Bedford Falls and Warner Brothers publicly released the Film *The Last Samurai*.<sup>113</sup>

The Screenplay is a fast-paced adventure story based around James Gamble, a successful professor living in the United States with his wife and son.<sup>114</sup> He is haunted by his mistake during the Civil War where he accidentally killed eight of his own soldiers.<sup>115</sup> At the request of President Grant, Gamble travels to Japan to lead the Japanese Imperial Army against a samurai rebellion led by a samurai named Saigo.<sup>116</sup> Gamble’s son is killed by Saigo, which sends Gamble into an opium addiction.<sup>117</sup> He is eventually saved from despair by his wife and

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<sup>107</sup> *Id.*

<sup>108</sup> *Id.* at 631 (quoting 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 19D.08[A] (Matthew Bender, rev. ed. 2009)).

<sup>109</sup> *Id.* at 622.

<sup>110</sup> *Id.*

<sup>111</sup> *Id.* at 622-23.

<sup>112</sup> *Id.* at 623.

<sup>113</sup> *Id.*

<sup>114</sup> *Id.*

<sup>115</sup> *Id.*

<sup>116</sup> *Id.*

<sup>117</sup> *Id.*

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Masako, a female samurai warrior who betrayed Saigo.<sup>118</sup> Gamble then seeks to exact revenge by leading the Imperial Army in a series of battles against the samurai rebels.<sup>119</sup> During the final battle, Saigo kills Masako in a sword fight, but Gamble, in turn, kills Saigo.<sup>120</sup> The Screenplay ends with Gamble returning to the United States, where he lives with his wife and a newborn baby named Masako.<sup>121</sup>

The Film employs a nostalgic and reflective mood driven by Nathan Algren, a lonely alcoholic who has just been fired from his job selling rifles.<sup>122</sup> He is haunted by his participation in a brutal attack on an innocent tribe during the Indian Wars.<sup>123</sup> Algren is recruited by his former commanding officer to travel to Japan to train the Imperial Army in modern warfare against the samurai rebellion led by their honorable leader named Katsumoto.<sup>124</sup> After Algren is captured by samurai warriors at the end of the first battle, he is assimilated into the samurai way of life.<sup>125</sup> He develops a friendship with Katsumoto and begins a romantic relationship with Taka, the widow of a samurai warrior.<sup>126</sup> He learns to appreciate the samurai culture and eventually joins the samurai against the Imperial Army.<sup>127</sup> After the samurai lose in the final battle against the Imperial Army, Algren confronts the Japanese Emperor and teaches him the value of traditional samurai culture.<sup>128</sup> The Film ends with Algren returning to the samurai village, where he lives with Taka.<sup>129</sup>

Bedford Falls contended that the Film was developed independently of the Screenplay.<sup>130</sup> The Film's writer, Edward Zwick, alleged that before the Benays' Screenplay was pitched to Solomon, he had conceived of his own story about a war veteran confronting Japanese culture.<sup>131</sup> Zwick invited John Logan and Marshall Herskovitz to work with him on this project, and by April 12, 2000, one month before the Benays' agent submitted the Screenplay to Bedford Falls, they had independently formed all of the main elements of what would become

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<sup>118</sup> *Id.*

<sup>119</sup> *Id.*

<sup>120</sup> *Id.*

<sup>121</sup> *Id.*

<sup>122</sup> *Id.*

<sup>123</sup> *Id.*

<sup>124</sup> *Id.*

<sup>125</sup> *Id.*

<sup>126</sup> *Id.*

<sup>127</sup> *Id.*

<sup>128</sup> *Id.*

<sup>129</sup> *Id.*

<sup>130</sup> *Id.* at 630.

<sup>131</sup> *Id.*

the Film.<sup>132</sup>

The Benays alleged that the creators of the Film copied many aspects from the Screenplay without permission, and they filed suit on December 5, 2005, two years after the release of the Film.<sup>133</sup> Warner Bros. Entertainment, Inc., Bedford Falls Productions, Inc., Radar Pictures, Inc., Edward Zwick, John Logan, and Marshall Herskovitz (collectively “Warner Brothers”) were named as defendants.<sup>134</sup> The Benays asserted four claims for relief: copyright infringement under federal law, as well as breach of contract, breach of confidence, and intentional interference with prospective economic advantage under California law.<sup>135</sup> Arguing that the Benays could not establish substantial similarity between the Screenplay and the Film, Warner Brothers moved for summary judgment on the copyright and breach of contract claims.<sup>136</sup>

The United States District Court for the Central District of California granted summary judgment to Warner Brothers on both claims.<sup>137</sup> The district court reasoned that since all the similarities between the works arose from unprotectable elements, no reasonable juror could find that the Benays’ Screenplay and Warner Brothers’ Film were substantially similar for purposes of copyright infringement.<sup>138</sup> In addition, the district court found that there was insufficient evidence of similarities on which a reasonable juror could conclude that Warner Brothers actually used the Benays’ Screenplay under a California breach of an implied-in-fact contract claim.<sup>139</sup> The Benays appealed the grant of summary judgment and the case went before the Ninth Circuit.<sup>140</sup>

### III. THE NINTH CIRCUIT’S HOLDING AND REASONING

The Ninth Circuit held that Warner Brothers was properly granted summary judgment on the copyright infringement claim because a comparison of the two works showed that the similarities were merely between unprotectable elements.<sup>141</sup> However, the Ninth Circuit held that

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<sup>132</sup> *Id.*

<sup>133</sup> *Id.* at 623.

<sup>134</sup> *Id.* at 622.

<sup>135</sup> *Id.* at 623.

<sup>136</sup> *Id.*

<sup>137</sup> *Id.*

<sup>138</sup> *Id.*

<sup>139</sup> *Id.*

<sup>140</sup> *Id.*

<sup>141</sup> *Id.* at 629.



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such similarities may be sufficient to find that an implied-in-fact contract was breached.<sup>142</sup> Thus, the Ninth Circuit recognized that unlike a federal copyright infringement claim, in a California breach of implied-in-fact contract claim, the court may inquire whether the unprotectable elements as well as the protectable elements are substantially similar.<sup>143</sup> Ultimately, the Ninth Circuit reversed the grant of summary judgment on the contract claim and remanded for the district court to determine whether there was actual use of the Benays' Screenplay by Warner Brothers.<sup>144</sup>

A. THE NINTH CIRCUIT'S RATIONALE FOR AFFIRMING THE GRANT OF WARNER BROTHERS' MOTION FOR SUMMARY JUDGMENT ON THE FEDERAL COPYRIGHT INFRINGEMENT CLAIM

Since Warner Brothers did not deny that the Benays owned a valid copyright, the issue on appeal for the copyright infringement claim was whether there was substantial similarity between the two works.<sup>145</sup> Applying the extrinsic test, the Ninth Circuit compared the two works' plot, characters, theme, settings, mood, pace, dialogue, title and sequence of events.<sup>146</sup> The Ninth Circuit did not find it surprising that a Hollywood film about the samurai rebellion would tell the story from an American character's perspective.<sup>147</sup> To the extent the works shared themes, scenes and dialogue, these elements arose naturally from the storyline of an American war veteran who travels to Japan to fight the samurai.<sup>148</sup> And, although the leader of the samurai rebellion was one of the works' main characters, this character was based on Saigo Takamori, a historical figure commonly associated with the samurai rebellion.<sup>149</sup> Likewise, the shared title between the Screenplay and the Film was also insignificant because Saigo Takamori is commonly referred to as "The Last Samurai."<sup>150</sup> Ultimately, although the two works shared a number of similarities, the Ninth Circuit found that the similarities were between

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<sup>142</sup> *Id.* at 632.

<sup>143</sup> *Id.*

<sup>144</sup> *Id.*

<sup>145</sup> *Id.* at 625.

<sup>146</sup> *Id.*

<sup>147</sup> *Id.* at 626.

<sup>148</sup> *Id.* at 628.

<sup>149</sup> *Id.* at 626-27 (citing Charles L. Yates, *Saigo Takamori in the Emergence of Meiji Japan*, 28 MOD. ASIAN STUD. 449, 449 (1994); KENNETH G. HENSHALL, A HISTORY OF JAPAN: FROM STONE AGE TO SUPERPOWER 78 (Palgrave Macmillan 2d ed. 2004)).

<sup>150</sup> *Benay*, 607 F.3d at 629 (citing Charles L. Yates, *Saigo Takamori in the Emergence of Meiji Japan*, 28 MOD. ASIAN STUD. 449, 449 (1994)).

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unprotectable elements that flowed naturally from their shared premise and were therefore disregarded for purposes of federal copyright infringement.<sup>151</sup>

B. THE NINTH CIRCUIT'S RATIONALE FOR REVERSING AND REMANDING THE GRANT OF WARNER BROTHERS' MOTION FOR SUMMARY JUDGMENT ON THE CALIFORNIA BREACH OF AN IMPLIED-IN-FACT CONTRACT CLAIM

The Ninth Circuit held that the absence of federal copyright infringement did not preclude a finding of substantial similarity for purposes of California breach of an implied-in-fact contract.<sup>152</sup> Since Warner Brothers did not deny that the parties entered into an implied-in-fact contract, the issue on appeal was whether there was substantial similarity to permit an inference of actual use of the Benays' Screenplay by Warner Brothers.<sup>153</sup> The Ninth Circuit found that when a completed creative work is submitted under an implied-in-fact contract, the elements covered by the contract are not limited to those elements that are protected by copyright.<sup>154</sup> Thus, the court recognized that unprotectable elements can be used to show substantial similarity in a California breach of an implied-in-fact contract claim.<sup>155</sup> The rationale is that although an unprotectable idea could not be adequate consideration for a promise to pay money, the disclosure of the idea may be of substantial benefit to the person to whom the idea is disclosed.<sup>156</sup> Therefore, unprotectable ideas may be what the production company is bargaining for and seeking to actually use in its movie.<sup>157</sup> This principle was introduced by California Supreme Court Justice Roger J. Traynor in his dissenting opinion in *Stanley v. Columbia Broadcasting System, Inc.*:

The policy that precludes protection of an abstract idea by copyright does not prevent its protection by contract. Even though an idea is not property subject to exclusive ownership, its disclosure may be of

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<sup>151</sup> *Id.* at 625.

<sup>152</sup> *Id.* at 631.

<sup>153</sup> *Id.* at 630.

<sup>154</sup> *Id.* at 631 ("California case law does not support the proposition that when a complete script is submitted under an implied-in-fact contract, only those elements of the script that are protected under federal copyright law are covered by the contract.").

<sup>155</sup> *Id.*

<sup>156</sup> *Stanley v. Columbia Broad. Sys., Inc.*, 221 P.2d 73, 85 (Cal. 1950) (Traynor, J., dissenting).

<sup>157</sup> *Id.*

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substantial benefit to the person to whom it is disclosed. That disclosure may therefore be consideration for a promise to pay.<sup>158</sup>

Unprotectable elements may be of value to a producer since unprotectable elements “are not freely usable by the entertainment media until the latter are made aware of them.”<sup>159</sup> For example, in *Reginald v. New Line Cinema Corp.*, Rex Reginald submitted his idea for a movie entitled *The Party Crasher’s Handbook* to New Line Cinema with the condition of payment if his idea was used.<sup>160</sup> Reginald brought a breach of implied-in-fact contract claim alleging that he was never paid after his idea was used for New Line Cinema’s motion picture film entitled *The Wedding Crashers*, which, like *The Party Crasher’s Handbook*, was about two bachelors who crashed parties.<sup>161</sup> The California Court of Appeal, Second Appellate District, noted that there is no requirement that the substantial similarity be between protectable elements in a California breach of implied-in-fact contract.<sup>162</sup> The rule is justified by the theory that the bargain is not for an idea itself, but for the services of conveying the idea.<sup>163</sup>

For example, imagine that New Line Cinema obligated itself to pay for the disclosure of unprotectable scènes-à-faire involving beautiful women, gourmet food, and artfully blended drinks. Although such ideas are unprotectable elements that naturally flow from a premise about two bachelors who crash parties, New Line Cinema might not have included such elements in its movie if it were not for the disclosure of the ideas. Hypothetically, New Line Cinema therefore entered into the bargain specifically to use these unprotectable ideas in its movie. Thus, unlike a federal copyright infringement claim, in which a showing of substantial similarity is limited to a comparison of protectable elements, actual use in a California breach of an implied-in-fact contract claim can be shown by substantial similarity between unprotectable elements.<sup>164</sup> Such a standard, however, is problematic.

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<sup>158</sup> *Id.*

<sup>159</sup> *Desny v. Wilder*, 299 P.2d 257, 265 (Cal. 1956).

<sup>160</sup> *Reginald v. New Line Cinema Corp.*, No. B190025, 2008 WL 588932, \*1-3 (Cal. Ct. App. Mar. 5, 2008).

<sup>161</sup> *Id.* at \*4.

<sup>162</sup> *Id.* (citing *Weitzenkorn v. Lesser*, 256 P.2d 947, 956 (Cal. 1953)).

<sup>163</sup> *Chandler v. Roach*, 319 P.2d 776, 781 (Cal. Dist. Ct. App. 1957) (“There is nothing unreasonable in the assumption that a producer would obligate himself to pay for the disclosure of an idea which he would otherwise be legally free to use, but which in fact, he would be unable to use but for the disclosure.”).

<sup>164</sup> *Benay v. Warner Bros. Entm’t, Inc.*, 607 F.3d 620, 632 (9th Cir. 2010).

## C. THE NEED FOR A NEW STANDARD FOR DETERMINING ACTUAL USE

1. *The Standard Used in Benay Does Not Adequately Reflect Actual Use of Plaintiff's Idea by Defendant*

Under the standard used in *Benay*, a producer who accepts the submission of a screenwriter's work but does not pay for it could be found liable for breach of an implied-in-fact contract, regardless of the fact that the producer did not actually use the screenwriter's work to produce its film.<sup>165</sup> For example, in *Buchwald v. Paramount Pictures Corp.*, Art Buchwald alleged that he was contractually owed money for the use of his screenplay *King for a Day* in the Paramount Pictures film *Coming to America*, both of which were premised on an African aristocrat who travels to America.<sup>166</sup> Since Paramount Pictures created a work with similar unprotectable elements that naturally arose from the two works' shared premise, the court ruled in favor of Buchwald, finding that *King for a Day* and *Coming to America* were substantially similar for purposes of actual use.<sup>167</sup> Furthermore, Paramount Pictures was found liable even though it contended that the film was developed independently from Buchwald's work.<sup>168</sup>

As *Buchwald* illustrates, by refusing to compensate the screenwriter after producing a work with similar unprotectable elements, the producer could be held liable to the screenwriter for breach of an implied-in-fact contract, whether or not the producer actually used the screenwriter's work.<sup>169</sup> It is entirely possible for two works created by two different parties to have similar unprotectable elements even though one party neither used nor copied the other party's work when creating its own production.<sup>170</sup> However, in such a situation, the producer, who is sued for breach of implied-in-fact contract for refusing to compensate the screenwriter, could be found liable simply because the work is based on

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<sup>165</sup> Peter Swarth, *The Law of Ideas: New York and California Are More Than 3,000 Miles Apart*, 13 HASTINGS COMM. & ENT. L.J. 115, 130 (1990).

<sup>166</sup> *Buchwald v. Paramount Pictures Corp.*, No. C 706083, 1990 WL 357611, at \*15 (Cal. Super. Ct. Jan. 8, 1990).

<sup>167</sup> *Id.*

<sup>168</sup> *Id.* at \*6 (noting that Paramount Pictures reportedly began developing the shooting script for *Coming to America* based upon a story by Eddie Murphy).

<sup>169</sup> Peter Swarth, *The Law of Ideas: New York and California Are More Than 3,000 Miles Apart*, 13 HASTINGS COMM. & ENT. L.J. 115, 130 (1990).

<sup>170</sup> *See, e.g., Benay v. Warner Bros. Entm't, Inc.*, 607 F.3d 620, 625 (9th Cir. 2010) (noting that the Film and the Screenplay shared similarities between unprotectable elements even though the Film was allegedly developed independently from the Screenplay).

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a similar idea that naturally flows from the screenwriter and producer's shared type of genre.<sup>171</sup> Thus, the standard used in *Benay* reflects not that the producer actually used the screenwriter's work but that the producer merely created a work involving similar unprotectable elements that inevitably arise from their shared genre.<sup>172</sup>

2. *The Standard Used in Benay Impedes Copyright Law's Attempt to Promote the Free Flow of Ideas*

While federal copyright law attempts to "promote the Progress of Science and useful Arts,"<sup>173</sup> the state contract law standard applied in *Benay* dissuades producers from accepting screenplays for fear of breaching an implied-in-fact contract.<sup>174</sup> For instance, when a creative work is submitted to a producer, or any prospective purchaser for that matter, the screenwriter's work may contain a vast amount of unprotectable ideas, all of which may be staples of literature and art. To avoid liability under an implied-in-fact contract, a producer who accepts the screenwriter's work must not only avoid using the screenplay but also avoid producing any work involving similar unprotectable elements.<sup>175</sup> Holding a producer liable for failing to compensate the screenwriter after merely creating a work involving similar unprotectable elements will cause producers to be hesitant to accept screenplays for fear of breaching implied-in-fact contracts.<sup>176</sup> Screenwriters will in turn be discouraged from expressing ideas and writing screenplays when they find it difficult to sell their works to producers.<sup>177</sup>

For example, in *Minniear v. Tors*, Harold Minniear alleged that he entered into a contract with Ziv Television Program in which Minniear would be reasonably compensated if his idea for a television series entitled *The Underwater Legion* was used.<sup>178</sup> After Ziv Television Program released the television series entitled *Sea Hunt*, which, like Minniear's *The Underwater Legion*, was premised on an underwater

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<sup>171</sup> See, e.g., *Buchwald*, 1990 WL 357611, at \*15.

<sup>172</sup> Peter Swarth, *The Law of Ideas: New York and California Are More Than 3,000 Miles Apart*, 13 HASTINGS COMM. & ENT. L.J. 115, 130 (1990).

<sup>173</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>174</sup> Kelly Rem, Note, *Idea Protection in California: Are Writers Too Readily Compensated for Their Screenplays?*, 28 HASTINGS COMM. & ENT. L.J. 333, 350 (2006).

<sup>175</sup> Peter Swarth, *The Law of Ideas: New York and California Are More Than 3,000 Miles Apart*, 13 HASTINGS COMM. & ENT. L.J. 115, 129 (1990).

<sup>176</sup> Kelly Rem, Note, *Idea Protection in California: Are Writers Too Readily Compensated for Their Screenplays?*, 28 HASTINGS COMM. & ENT. L.J. 333, 350 (2006).

<sup>177</sup> *Id.* at 350-51.

<sup>178</sup> *Minniear v. Tors*, 72 Cal. Rptr. 287, 291 (Ct. App. 1968).

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adventure, Minniear brought a breach of implied-in-fact contract claim alleging that he was never compensated after his idea was used.<sup>179</sup> The California Court of Appeal, Second Appellate District, held that there were enough similarities in the basic plot ideas between *The Underwater Legion* and *Sea Hunt* to infer that Ziv Television Program actually used Minniear's idea.<sup>180</sup> The money and resources absorbed by such litigation would discourage the producer from accepting further works submitted by other screenwriters.<sup>181</sup> As a result, screenwriters will be disinclined to spend time and effort on writing screenplays when producers repeatedly decline to consider their ideas.<sup>182</sup> Thus, the standard used in *Benay* discourages the free flow of ideas by imposing liability simply because the producer created a product involving unprotectable elements similar to those in the screenwriter's work.<sup>183</sup> Fortunately, there is a solution to this problem.

## IV. PROPOSED STANDARD FOR DETERMINING ACTUAL USE

## A. PROPOSED STANDARD DEFINED

In a California claim for breach of an implied-in-fact contract over the use of an idea, a court may appropriately infer actual use through a showing of the defendant's access to the plaintiff's work and substantial similarity between the two works at issue.<sup>184</sup> However, since the substantial-similarity standard used in *Benay* inadequately reflects actual use and discourages the free flow of ideas, courts should model the substantial-similarity standard in California breach of implied-in-fact contract claims after the federal copyright infringement standard found under the extrinsic test. Specifically, a court should examine the individual elements of both works and separate the protectable elements from the unprotectable elements. The court should then inquire into whether the protectable elements, and not the unprotectable elements, are substantially similar. If all the similarities between the works arise from the use of unprotectable elements, the court should conclude that the plaintiff failed to demonstrate actual use. In effect, the California

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<sup>179</sup> *Id.*

<sup>180</sup> *Id.* at 294.

<sup>181</sup> Kelly Rem, Note, *Idea Protection in California: Are Writers Too Readily Compensated for Their Screenplays?*, 28 HASTINGS COMM. & ENT. L.J. 333, 350 (2006).

<sup>182</sup> *Id.* at 350-51.

<sup>183</sup> *Id.* at 350.

<sup>184</sup> *Mann v. Columbia Pictures, Inc.*, 180 Cal. Rptr. 522, 534 (Ct. App. 1982).

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standard would match the federal standard such that if the court does not find substantial similarity under a federal copyright infringement claim, the court should be precluded from finding substantial similarity under a California breach of implied-in-fact contract claim. Therefore, to successfully prove that the defendant has actually used his or her idea, the plaintiff must show substantial similarity between protectable elements, not unprotectable elements.

## B. PROPOSED STANDARD JUSTIFIED

1. *The Proposed Standard for Determining Actual Use Better Indicates Actual Use of Plaintiff's Idea by Defendant*

Substantial similarity between protectable elements, rather than unprotectable elements, is a better indication that an idea was disclosed by the plaintiff and used by the defendant. In *Green v. Schwarzenegger*, William Green, author of a screenplay entitled *The Minotaur*, brought an action alleging copyright infringement by the creators of the movie *Terminator 2: Judgment Day*.<sup>185</sup> Although both works contained a similar message about the future of mankind, the United States District Court for the Central District of California found no infringement because a closer examination of the protectable elements in the two works exposed more dissimilarities than similarities.<sup>186</sup> As *Green* demonstrates, even though two works can share the same basic plot premise, they can have completely different protectable elements.<sup>187</sup> Whereas unprotectable elements naturally arise from the limited amount of ideas within the public domain,<sup>188</sup> protectable elements do not derive from basic plot premises.<sup>189</sup> Because of a protectable element's original character, it is less likely for two authors to express the same protectable element in their respective works. Therefore, substantial similarity between protectable elements, rather than unprotectable elements, better reflects the possibility that the defendant actually used the plaintiff's idea.

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<sup>185</sup> *Green v. Schwarzenegger*, No. CV 93-5893-WMB, 1995 WL 874191, at \*1 (C.D. Cal. July 12, 1995).

<sup>186</sup> *Id.* at \*18 (“[T]he evil Terminator’s ability to mold its liquid metal body in any shape, which gives rise to its ability to grow ‘adaptable limbs,’ is very different from the Minotaur’s less technologically sophisticated shape-changing.”).

<sup>187</sup> *See generally id.* at \*18.

<sup>188</sup> *See Desny v. Wilder*, 299 P.2d 257, 271 (Cal. 1956) (“It is manifest that authors must work with and from ideas or themes which basically are in the public domain.”).

<sup>189</sup> *See generally Green*, 1995 WL 874191, at \*18.

The standard of proof proposed by this Note will create a better filter to separate those cases dealing with actual instances of unauthorized copying from those cases dealing with coincidental similarities. For example, in *Funky Films, Inc. v. Time Warner Entertainment Co.*, Gwen O'Donnell and Funky Films, creators of the screenplay *The Funk Parlor*, brought a copyright infringement action against Time Warner Entertainment, producer of the television series *Six Feet Under*.<sup>190</sup> Limiting its analysis to similarities between protectable elements, the Ninth Circuit concluded that *The Funk Parlor* and *Six Feet Under* were not substantially similar, given that the similarities between the death of a caring father and return of a detached son were unprotectable scènes-à-faire and “at best, coincidental.”<sup>191</sup> The limited amount of unprotectable scenes and characters that necessarily flow from a shared premise leaves ample opportunity for natural and coincidental similarities.<sup>192</sup> Furthermore, these similarities between unprotectable elements can exist simply because such elements frequently occur in all forms of art and science.<sup>193</sup> Protectable elements, however, stem from more-unique ideas than mere unprotectable scènes-à-faire, and a protectable element's uniqueness makes it easier to recognize instances of coincidental similarities. The more unique and rare an element is in a creative work, the more likely that any similarity to the element was the result of the defendant actually using the plaintiff's idea. Thus, a standard that permits a showing of substantial similarity between protectable elements only will provide a better sense of actual use by giving judges and triers of fact more confidence in determining when the elements of the works at issue are coincidentally similar.

2. *The Proposed Standard for Determining Actual Use Will Provide State Contract Law Protection While Preserving the Purposes and Objectives of Federal Copyright Law*

Requiring substantial similarity strictly between protectable elements will preserve copyright law's idea-expression dichotomy by denying protection to unprotectable elements. In *Berkic v. Crichton*, for instance, Ted Berkic wrote a screenplay called *Reincarnation* and brought an action for copyright infringement against the makers of a

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<sup>190</sup> *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072, 1074 (9th Cir. 2006).

<sup>191</sup> *Id.* at 1081.

<sup>192</sup> See generally, *Desny*, 299 P.2d at 271.

<sup>193</sup> See *Berkic v. Crichton*, 761 F.2d 1289, 1294 (9th Cir. 1985) (“The common use of such stock . . . merely reminds us that in Hollywood, as in the life of men generally, there is only rarely anything new under the sun.”).



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movie entitled *Coma*, which, like *Reincarnation*, involved young professionals exposed to a criminal investigation.<sup>194</sup> Limiting its comparison to strictly protectable elements, the Ninth Circuit found no substantial similarity between the protectable elements of the works and noted that similarity between unprotectable elements “merely reminds us that in Hollywood, as in the life of men generally, there is only rarely anything new under the sun.”<sup>195</sup> With a requirement that substantial similarity be shown between protectable elements, screenwriters will not be given monopolies over customary staples of literature and art.<sup>196</sup> The public will therefore be encouraged to use the same unprotectable ideas in creating their own works, while authors will be afforded state contract law protection over their protectable expressions.<sup>197</sup>

Since the standard used in *Benay* impedes the production of works of art and science, the state law standard should yield to the federal law standard as a matter of conflict preemption.<sup>198</sup> In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, Bonita Boats, a boat manufacturer, sought to enjoin Thunder Craft Boats from using a direct molding process<sup>199</sup> to duplicate Bonita Boats’ boat hulls.<sup>200</sup> At the time, a Florida statute made it unlawful for any person to use the direct molding process to duplicate products for sale without the written permission of the other party.<sup>201</sup> The United States Supreme Court held that since the Florida statute stood as an obstacle to the federal policy favoring the free competition of unprotectable ideas, the state law must be invalidated to the extent that it conflicted with the federal law.<sup>202</sup> Along the same lines, since the standard used in *Benay* impedes the promotion of art and science by offering protection to unprotectable ideas, the state law standard should match the federal law standard so as to create a national uniform rule that safeguards only protectable expression, thereby encouraging the free

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<sup>194</sup> *Id.* at 1291.

<sup>195</sup> *Id.* at 1294.

<sup>196</sup> *Id.* at 1293-94.

<sup>197</sup> *Id.* at 1291.

<sup>198</sup> Conflict preemption occurs when the federal law controls and the state law is invalidated because the state law stands as an obstacle to the accomplishment of the objectives of federal law. *See, e.g., Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 168 (1989).

<sup>199</sup> Direct molding process is the process by which one party uses a particular product to create a mold for mass production and sale of a duplicate product. *Id.* at 163-64.

<sup>200</sup> *Id.* at 145.

<sup>201</sup> *Id.* at 144-45.

<sup>202</sup> *Id.* at 151 (“[S]tate regulation of intellectual property must yield to the extent that it clashes with the balance struck by Congress . . .”).

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flow of ideas.<sup>203</sup> As Justice Sandra Day O'Connor articulated for the unanimous court:

One of the fundamental purposes behind the Patent and Copyright Clauses of the Constitution was to promote national uniformity in the realm of intellectual property. . . . Given the inherently ephemeral nature of property in ideas, and the great power such property has to cause harm to the competitive policies which underlay the federal patent [and copyright] laws, the demarcation of broad zones of public and private right is "the type of regulation that demands a uniform national rule."<sup>204</sup>

## CONCLUSION

Now picture again the screenwriter who watches a movie and realizes that it is substantially similar to one of her very own registered screenplays. If the screenwriter brings a breach of an implied-in-fact contract claim under California law, without a requirement that the similarity be between protectable elements, the production company could be found liable if the film involved the same unprotectable elements as the screenwriter's work, regardless of the fact that the producer did not actually use the screenwriter's idea. It is not hard to imagine the flood gates opening, the crowds of screenwriters filing lawsuits, and the producer's last few words: lights, camera . . . civil action. In California breach of implied-in-fact contract claims, courts should use the standard proposed by this Note, so that, in order to successfully prove that the defendant has actually used his or her idea, the plaintiff must show substantial similarity between protectable elements, not unprotectable elements.

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<sup>203</sup> *Id.*

<sup>204</sup> *Id.* at 162-63 (quoting *Ray v. Atlantic Richfield Co.*, 435 U.S. 151, 179 (1978)).

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