

TOTAL CONCEPT AND





FEEL: A DOCTRINE RUNNING AMOK?

By Mitchell J. Rotbert

Lord knows I have tried to persuade my teenage son and his friends to adopt “Total Concept and Feel” as the name of one of their rock bands. But, as he’s instructed me, the Summer of Love is only in my head. So, whenever litigating a copyright action, I need to remind myself that “Total Concept and Feel” is not just an old man’s nod to the Glory Days, but one of the tags the federal courts have used to identify a highly disruptive copyright doctrine. Total Concept and Feel expands copyright law to its farthest outpost, at the theoretical boundary between protected expression and non-protected idea – and, as a practical matter, beyond.

To appreciate Total Concept and Feel, a review of the rudiments of copyright law is in order. First, it is an oft-stated axiom that “copyright protection extends only to a particular expression of an idea, and not to the idea itself.” *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 765 (2d Cir. 1991). Second, to be protected, the expression must be original to the author: not necessarily novel or unique, just some new expression, “one not copied from pre-existing works” or from the public domain. *Boisson v. American Country Quilts and Linens, Inc.*, 273 F.3d 262, 268 (2d Cir. 2001). The Courts have repeatedly emphasized that the “requisite level of originality” to satisfy this test is minimal. In *Feist Publications, Inc. v. Rural Telephone Serv. Co.*, 499 U.S. 340 (1991), the Supreme Court determined, albeit in *dictum*, that most fact compilations, e.g. a telephone book, will satisfy the “originality” element of copyright protection if the compilation “features an original selection or arrangement.” *Feist*, 499 U.S. at 348. *Feist* denied copyright protection over a telephone book because there was a complete absence therein of any originality whatsoever: black telephone numbers on a white page, arranged alphabetically. If there had been a design along the edge of each page, that would have arguably satisfied the originality element of the copyright law; and then the protection of the Copyright Act would attach to the design against the setting of the numbers, but nothing more than that. Third, in an infringement action, once the court determines that a work contains copyrightable expression and that there is evidence that the work was copied by the alleged infringer, the court turns to the central question in copyright law: whether the copyrightable elements of the infringing

work are “substantially similar” to the copyrightable elements in the alleged infringing work.

Feist restates the beating heart of modern copyright law, especially in the Age of IT, data management, and data presentation. That is so for three reasons. First, everything that we can know, every experience, depends on a reference to some other knowledge or experience. Freud said it most succinctly: “The essential relativity of all knowledge, thought, or consciousness cannot but show itself in language. If everything that we can know is viewed as a transition from something else, every experience must have two sides; and either every name must have a double meaning, or else for every meaning there must be two names.” S. Freud, *The Antithetical Sense of Primal Words* (1910), reprinted in *Character and Culture* (1963) (quoting the “Philosopher Bain,” who that is). A simple example: to know “night,” we need to know “day.” The two terms do not mean much without the other. The same is true for assessing substantial similarity of different works under copyright law. To appreciate “East of Eden” we do well to know Genesis. Every infringement ruling is, essentially, a comparison of two or more expressions of the same or a similar idea.

Second, if the “essential relativity” of experience is so (and it is), then even an “original” expression has a precursor. There is nothing new under the sun. Show me a Shakespeare comedy, and I’ll show you a short story from medieval Florence. Shakespeare could not claim copyright protection for the sequence of events or plot in *Romeo and Juliet*; but he could claim complete protection for the expression, “Wherefore art thou, Romeo!” and all other verses besides. In every

work, there will be elements of protectible original expression and non-protectible unoriginal expression and idea. Compilers bear this observation the hardest. They are primarily in the business of compiling and presenting non-copyrightable ideas or expressions that are not original. Yet, under *Feist*, even a compilation can have copyright protection if some of its elements, i.e., presentation, are duly original.

Third, copyrightability is a question of law. So, in an infringement action, if the District Court can be persuaded that there is sufficient “original expression” in the presentation of protectable expression in a work that has allegedly been infringed, the infringing work will survive a motion for summary judgment if there is substantial similarity between the copyrightable aspects of the infringing work and the infringing work. And for most plaintiffs, clearing the summary judgment hurdle leads the way to settlement. (If the infringing party is aggrieved by the summary judgment ruling of the District Court, that party may ask a panel of three appellate judges to perform the same analysis *de novo*.)

Against this backdrop, the federal judiciary has struggled to define tests to guide it in ruling on questions of “substantial similarity” between the copyrightable elements of competing works. The basic test is called the “ordinary observer” test. “Generally, an allegedly infringing work is considered substantially similar to a copyrighted work if ‘the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.’” *Boisson*, 273 F.3d at 272 (citing *Folio Impressions*).

But in the real world where, as we have seen, everything is relative and

there is nothing new under sun, the “ordinary observer” test is deemed inadequate. A “more refined analysis” is required where a plaintiff’s work is not ‘wholly original,’ but rather incorporates elements from the public domain.” *Boisson*, 273 F.2d at 272 (citation omitted). This test is the “more discerning” ordinary observer test. As stated by the Second Circuit:

In applying this test, a court is not to dissect the works at issue into separate components and compare only the copyrightable elements. To do so would be to take the “more discerning” test to an extreme, which would result in almost nothing being copyrightable because original works broken down into their composite parts would usually be little more than basic unprotectible elements like letters, color, and symbols. This outcome – affording no copyright protection to an original compilation of unprotectible elements – would be contrary to the Supreme Court’s holding in *Feist Publications*.

Id. That test is “guided by comparing the ‘total concept and feel’ of the contested works.” *Id.*

Total Concept and Feel can be traced back to two cases decided in the 1970s, one decided in the Ninth Circuit and one in the Second Circuit, the two hotbed circuits for copyright litigation. In *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106 (9th Cir. 1970), the Ninth Circuit reversed a decision of the district court below, which had found that a set of greeting cards were not copyrightable because the text of the cards consisted of “common and ordinary English words and phrases which are not original with Roth and were in the public domain prior to the



to the highest bidder.
By one of the most trusted auctioneers.

Estate Sales, Commercial Real Estate,
Residential Real Estate, Business Liquidations,
Bankruptcies and Foreclosures,
Antique & Furniture Auctions

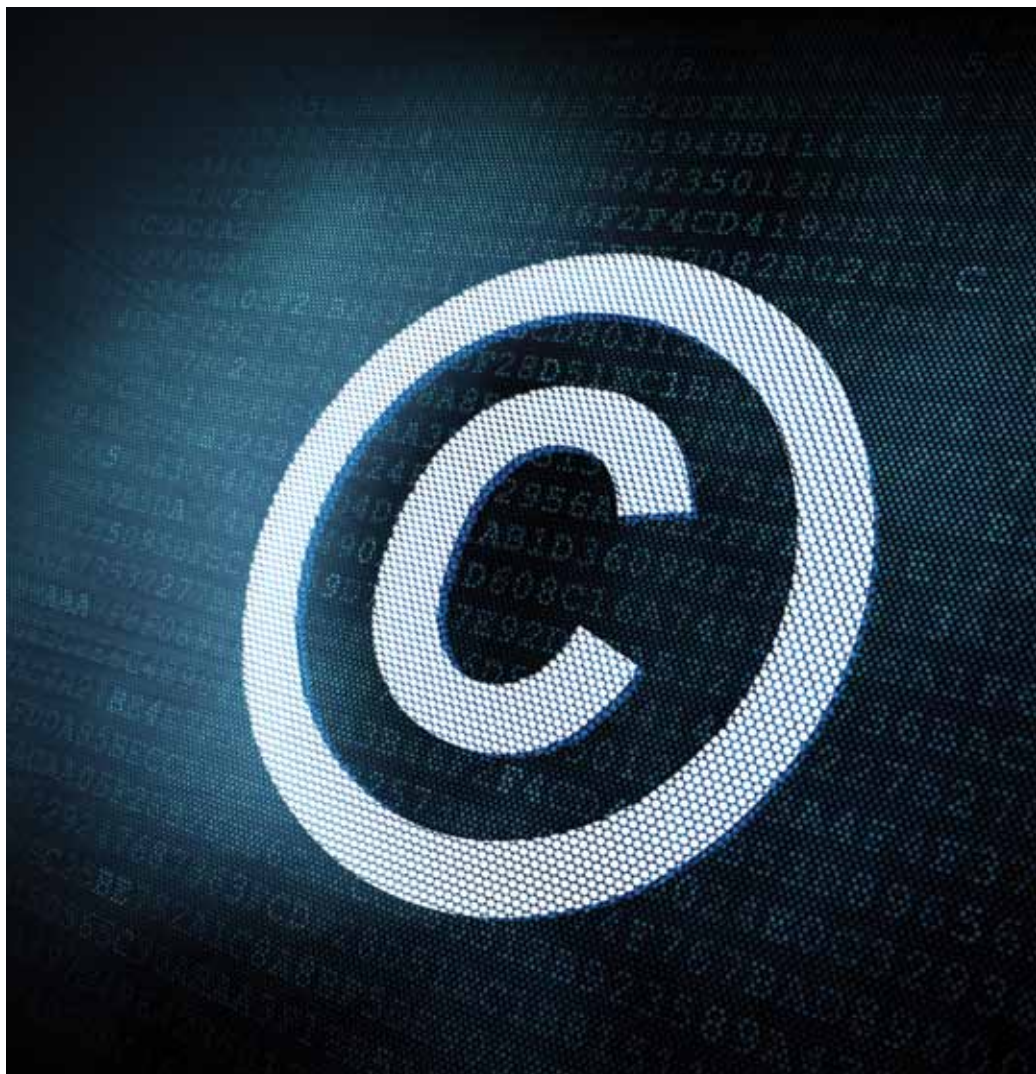
 **Alex Cooper** SINCE 1924
AUCTIONEERS INC

Contact Paul Cooper | paul@alexcooper.com
908 York Road, Towson, MD | 410-828-4838 | realestate.alexcooper.com

first use by plaintiff." *Roth*, 429 at 1109. The Ninth Circuit held:

It appears to us that in total concept and feel the cards of United are the same as the copyrighted cards of Roth. [T]he characters depicted in the art work, the mood they portrayed, the combination of art work conveying a particular mood with a particular message, and the arrangement of the words on the greeting card are substantially similar as in Roth's cards. In several instances the lettering is also very similar.

Id. at 1110. In *Reyher v. Children's Television Workshop*, 533 F.2d 87 (2d Cir. 1976), the Second Circuit affirmed the district court's holding that a Sesame Street® illustrated story entitled, "The Most Beautiful Woman in the World" did not infringe plaintiffs' illustrated children's book entitled, "My Mother is the Most Beautiful Woman in the World." After a detailed comparison of the two works of fiction, the Second Circuit determined that the "two works differ in 'total feel.'" *Reyher*, 533 F.2d at 92. "The two stories are not similar in mood, details, or characterization. Since both presented only the same idea, no infringement as to protected expression occurred." *Id.* at 92-93. Both *Roth* and *Reyher* have a glib appeal. Both Circuits determined that "mood and message" (*Roth*) and "mood, details, or characterization" (*Reyher*) represent copyrightable expression and not non-copyrightable idea or non-copyrightable jargon in the public domain. And we go along with those conclusions because, after all, both *Roth* and *Reyher* are dealing with works of fiction, where we figure questions of "mood" predominate in any "substantial similarity" analysis.



Ever since, Total Concept and Feel has been put to work as the reigning test for comparing competing works of fiction, primarily in the area of visual arts. For example, in *Brown v. Perdue*, the author of two works of fiction argued that they were infringed by Dan Brown's novel, *The Da Vinci Code*. In comparing the total concept and feel of the competing works, the Court held that the plaintiffs' work "is more action-packed, with several gunfights and violent deaths" . . . a "perilous journey" and "sex scenes"; whereas, *The Da Vinci Code* "is an intellectual, complex treasure hunt, focusing more on the codes, number sequences, cyptexes and hidden messages left behind as clues than on any physical adventure." *Brown v. Perdue*, 2005 U.S. Dist LEXIS 15995, * 32 (S.D.N.Y.

Aug. 4, 2005). Plaintiffs lost, primarily because the Court determined that their best argument on similarity involved non-protected historical facts and themes or the "unprotectible idea of a mystery thriller set against a religious backdrop." *Id.* at *23. See also *Canal+ Image UK Ltd. v. Lutkvak*, 773 F. Supp.2d 419 (S.D.N.Y. 2011) (pushing back on Total Concept and Feel in comparison of a film and a musical).

But there is no list of elements for Total Concept and Feel. In each case, the elements of the doctrine are contextual, determined by the understanding of the federal judge(s) tapped to decide how to weigh competing copyrightable matter while giving little or no weight to the non-copyrightable idea or public domain jargon therein. And that division is

highly subjective. District Court Judge Jack Weinstein openly struggled with the test. He wrote:

The *Boisson* opinion did not elaborate on how the “total concept and feel” accounts for unprotectible elements. . . . The *Boisson* court’s lengthy discussion of how to define the “more discerning” test suggest that there must be some accounting for unprotectible elements; otherwise, the *Boisson* court would have saved time and avoided confusion by explicitly collapsing the “ordinary” and “more discerning” tests. . . .

Boisson seems best read as meaning that the discerning observer should distinguish between protectible and unprotectible elements, put the unprotectible elements out of mind, and determine whether the remainders of each work, taken together, are similar in total concept and feel.

Well-Made Toy Mfg. Corp. v. Goffa Int’l Corp., 210 F. Supp.2d 147, 162 (E.D.N.Y. 2002), *aff’d* 354 F.3d 112 (2d. Cir. 2003), *abrogated on other grounds in Reed Elsevier, Inc. v. Muchnick*, 130 S.Ct. 1237 (2010). In *Well-Made*, Judge Weinstein was called upon to weigh the total concept and feel of competing rag dolls, one larger than the other. Judge Weinstein concluded that much of what he was comparing – “shaped heads, torsos, embroidered faces, hats, bows, yarn hair,” *etc.* – constituted the unprotectible idea of “ragdoll.” *Id.* at 167. He found that the dolls had different “aesthetic appeal.” *Id.* at 168. Size of the dolls drove that difference, as well as different “body proportions,” “facial features,” “fabric,” and “color choices.” But Judge Weinstein concluded: “What similarities exist arise essentially from

both dolls being expressions of the idea of a female rag doll.” *Id.*

Pause a moment and ask: What is the difference between finding that the “idea” of a female rag doll precludes original expression of a specific rag doll’s features (*Well-Made*) and finding that the “idea” of a greeting card does not preclude copyright on original “lettering” therein (*Roth*)? Judge Weinstein used Total Concept and Feel and found non-protected idea. Is that because everyone knows a rag doll when they see one? *Well-Made* underscores the essential subjectivity of Total Concept and Feel. The Second Circuit attempted to control the doctrine, but with little success. *Tufkenian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 134 (2d. Cir. 2003) (recognizing that Total Concept and Feel “may ‘invite an abdication of analysis’ because ‘feel’ can seem a ‘wholly amorphous referent,’” and restating that the doctrine “functions as a reminder that, while infringement analysis must *begin* by dissecting the copyrighted work into its component parts in order to clarify precisely what is not original, infringement analysis is not *simply* a matter of ascertaining similarity between components viewed in isolation”) (citations omitted) (emphases in original).

And therein lies the danger (or opportunity). Total Concept and Feel is not, by its terms, limited to comparing artistic works. Whenever the more discerning test is required, *i.e.*, nearly always because of the essential relativity of knowledge and expression, Total Concept and Feel is in (or can be put into) use. In *Medical Education Dev. Svcs., Inc. v. Reed Elsevier Group, Inc.*, a case in which I represented the plaintiff claiming infringement, Judge Lynch (now on the Second Circuit) used Total Concept and Feel in part to resolve a summary judgment motion

in a case involving competing instructional books published to assist nursing students to prepare for and pass a standardized examination. *Medical Education Dev. Svcs., Inc. v. Reed Elsevier Group, Inc.*, 2008 U.S. Dist. LEXIS 76899 (S.D.N.Y. Sept. 30, 2008). In that case, Defendants moved for summary judgment, arguing principally that the expressions in plaintiffs’ books were of ideas that could only be expressed in one way, *i.e.*, that the copyright law doctrine of merger precluded recovery. The Court denied the motion, ruling that the court must compare the competing works’ total concept and feel: “[K]eeping in mind the distinction between a work’s nonprotectible elements and its selection, coordination, arrangement, and expression of those elements – which is protectible – a court must look to the protected work’s and the allegedly infringing work’s ‘total concept and feel.’” *Id.* at *29.

The Courts and treatises tell us to follow the axiom that copyright law protects the original expression, not the idea therein. But because *Feist* protects as expression original organization or presentation of non-copyrightable idea or jargon, there has to be a means for federal judges, almost always in the context of summary judgment, to sift the copyrightable from the non-copyrightable and then weigh only the copyrightable. Total Concept and Feel provides the rule of decision there. But it is a rule without any discipline. Total Concept and Feel, essentially a subjective test, serves at best as a porous barrier at the border between protected expression and non-protected idea and jargon.

Mr. Rotbert is an experienced commercial and business trial lawyer who practices in Maryland, Washington, D.C., and New York. He may be reached at mrotbert@gmail.com.