**In summary**

– Alleged copyright infringers often rely on the scènes à faire doctrine to exclude computer programs from copyright protection

– Courts have yet to provide an explicit analytical framework for applying the scènes à faire doctrine to computer software, even though the doctrine is often cited in court opinions

– Several case outcomes show a flawed methodology is sometimes applied. The authors have formulated a test, explained here, for the proper application of the doctrine

**Authors**

**Krista S Schwartz** (left) is a partner at Jones Day in the Intellectual Property Group. She specializes in the area of high-tech intellectual property litigation, including patent, copyright, trade secret, and unfair competition cases.

**Stacy A Baim** (middle) is counsel to Jones Day in the Intellectual Property Group. She has a diverse intellectual property practice, including litigation and transactional matters relating to patents, trademarks, copyrights, trade secrets, and unfair competition.

**Sasha Mayergoyz** (right) is a senior associate at Jones Day in the Intellectual Property Group. His practice focuses primarily on patent and copyright litigation.

# Software and scènes à faire

## *A modest proposal for application of the doctrine in computer software cases*

**Krista S Schwartz, Stacy A Baim and Sasha Mayergoyz of Jones Day suggest a test for applying scènes à faire**

Computer software is once again becoming a popular subject of copyright litigation, and enforcement of software copyrights has led to the formation of a complicated body of case law. An almost inevitable occurrence in copyright litigation is an alleged infringer's reliance on various doctrines in an attempt to exclude parts (or all) of a computer program from copyright protection. One commonly invoked doctrine is "scènes à faire," a French phrase literally meaning "scenes that must be done".

The scènes à faire doctrine was first introduced into copyright law more than 75 years ago in a decision involving scenes from a movie titled *When Tomorrow Comes*.[1] At its most general, the doctrine denies copyright protection "to those expressions that are standard, stock, or common to a particular topic, or that necessarily follow from a common theme or setting."[2] In the computer software context, the scènes à faire doctrine precludes copyright protection for aspects of a computer program that are "dictated by practical realities – e.g., by hardware standards and mechanical specifications, software standards and compatibility requirements, computer manufacturer design standards, target industry practices, and standard computer programming practices."[3]

### Court analyses confused

Though many decisions recite these lists of material excluded from copyright protection, courts have yet to provide an explicit analytical framework for applying the scènes à faire doctrine to computer software. Notably absent from many court analyses is an evaluation of whether the disputed material was "standard, stock, or common" at the time when the copyright holder authored the computer program in question. Many courts fail to consider timing at all, while others mistakenly focus on whether the material was standard at the time of the alleged infringement or at the time of the litigation. The absence of an analytical framework including a logical temporal component has resulted in confusion and frequent misapplication of the scènes à faire doctrine in computer software copyright cases.

Opinions involving copyrights for widely-used software programs provide instructive examples of this confusion. *In Apple Computer, Inc. v. Microsoft Co*, a central issue was whether the scènes à faire doctrine precluded copyright protection for certain elements of the Apple Macintosh graphical user interface graphical user interface.[4]

At the time of the litigation, the Apple Macintosh enjoyed widespread commercial success and many companies emulated its graphical user interface in the hope of capturing a share of Apple's market. The district court noted that "[n]o better evidence of 'market factors' (i.e., expectations of users) accounting for the features of the computer user interfaces can be found than the almost invariable incorporation of those features in most graphical user interfaces."[5]

The court then determined that the scènes à faire doctrine precluded copyright protection for various features because those features were included in other graphical user interface systems, most of which post-dated creation of the Apple Macintosh

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**"The scènes à faire analysis must evaluate whether the disputed software was original or whether it was "standard or stock" when the author created the program"**

graphical user interface. For example, the court excluded from protection the feature "that redisplays all newly-exposed areas on the screen after a window is moved" because it was present in 25 of the other graphical user interface systems canvassed by the court, despite the fact that 23 of those other systems were created after the Apple Macintosh graphical user interface.[6]

Applying a similar rationale, another district court recently used the scènes à faire doctrine to preclude copyright protection for parts of a computer program that were derived from files commonly used in the software industry.[7] The court in *Integrated Bar Coding Systems* excluded various sets of files from protection without discussing whether the copyrighted work predated use of similar files by developers in the industry. Again, the court focused on widespread use of the copyrighted material at the time of the *litigation*, skirting the issue of whether the material was in use at the time the copyrighted work was authored.

The authors of this article recently encountered this very issue while successfully enforcing copyrights for a popular software used by scientists and engineers to perform numeric calculations.[8] During the course of the litigation, the defendants attempted to use the commercial success of the copyrighted software as a sword, arguing that the software was now so prevalent as to have become an industry standard, thereby precluding copyright protection under the scènes à faire doctrine. Though the court ultimately rejected the defendants' argument, our experience confirms the temptation by litigants (and some courts) to focus on industry use of the copyrighted material at the time of the litigation, rather than at the time of authorship.

## Suggested test

All three instances discussed above highlight a flawed methodology for applying the scènes à faire doctrine in which some courts, and many litigants, latch on to the rubric of "standard, stock, or common to a particular context" and then proceed to determine whether the disputed material is standard or stock at the time of the alleged infringement. Courts should instead be analysing whether the disputed material was standard or stock when the copyrighted software was created. We have formulated a test, including the proper temporal framework, for applying the scènes à faire doctrine in the computer software context.

To determine whether the scènes à faire doctrine precludes copyright protection for material in a computer program, courts should evaluate the disputed material (1) from the point of view of the author of the copyrighted work and (2) based on other computer programs existing at the time the copyrighted work was created. This test properly focuses the scènes à faire inquiry by requiring examination of the originality of the author's work measured against the circumstances existing when the work was created. In doing so, the test furthers both the policy and economic aim of copyright protection.

The Copyright Clause in the United States Constitution empowers Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[9] The purpose of the Copyright Clause is to reward an author's original creation. To that end, the United States Supreme Court has established that the "*sine qua non* of copyright is originality.

To qualify for copyright protection, a work must be original to the author."[10] Consistent with these principles, the scènes à faire analysis must evaluate whether the disputed software was original or whether it was "standard or stock" when the author created the program. Evaluating the originality of a disputed program at any other point in time, such as comparing a disputed program to other programs existing at the time of litigation, defeats the aim of rewarding an author's originality. Indeed, such analysis improperly holds the success and acceptance of the copyrighted work against the author.

The propriety of anchoring the scènes à faire analysis to the date when the copyrighted work was created also finds support in the analogous field of patent law. There, a decision-maker determines whether a claimed invention is valid or whether it would have been obvious by "cast[ing] the mind back to the time the invention was made."[11] In fact, the patent law vigilantly guards against using the phrase "is obvious" because it "improperly focuses on the present" and "may lead to an improper approach in which the judge determines whether the invention is presently obvious."[12] Similarly in the copyright context, courts must guard against applying the scènes à faire doctrine by determining whether a computer program is "standard or stock" based on currently available programs. Rather, courts should look to what was standard and existing when the author created the computer program.

The economic underpinnings of copyright law also support the proposed test. "The economic philosophy behind the [Copyright] clause … is the conviction that encouragement by personal gain is the best way to advance public welfare."[13] To that end, applying the scènes à faire doctrine by focusing on the computer programs existing at the time of litigation frustrates the incentives for creating original works. For example, if a copyrighted program becomes commercially successfully and widely copied, a scènes à faire analysis that evaluates the existence of current computer programs to determine if the copyrighted program is "common or stock" creates a perverse scenario in which the copyrighted work loses its value by becoming successful and widely adopted.

## Bringing clarity to cases

We do not mean to suggest that our proposed test is a watershed idea without basis in current copyright jurisprudence. A careful review of recent cases involving enforcement of copyrights for computer software suggests that aspects of our proposed test appear to be latent in several decisions that apply the scènes à faire doctrine. For example, the Tenth Circuit's opinion in *Mitel, Inc. v. Iqtel, Inc.* criticised a district court's scènes à faire analysis because the opinion "discussed whether

external factors such as market forces and efficiency considerations justified *Iqtel's copying* of the command codes, [while the] court's analytical focus should have remained upon the external factors that dictated *Mitel's selection* of registers, descriptions, and values."[14] Along similar lines, the Third Circuit's opinion in *Dun & Bradstreet Software Services, Inc. v. Grace Consulting, Inc.* also endorsed the notion that a computer program should be examined from the viewpoint of the creator, not the alleged infringer.[15]

Some district courts likewise have recognized that a scènes à faire analysis should focus on the copyright holder's, rather than the alleged infringer's, perspective. A district court in Minnesota framed the question of the applicability of the scènes à faire doctrine as follows: "The question to be examined is whether external factors limited the choices available to [the copyright holder's] programmers, not whether external factors may somehow limit the choices of [the alleged infringer's] programmers."[16] In Texas, a district court confirmed the availability of copyright protection for software, noting that "[t]he issue is not whether the *copier* had any choice of data to use, but whether the *author* had any choice."[17]

These decisions, while correctly applying the scènes à faire doctrine, fail to establish an expressly-formulated framework for analysing the doctrine in the computer software context. We believe that our proposed test would bring order and clarity to an area of copyright law that is inherently complicated by virtue of the difficult subject matter of computer software. As set out above, when analysing computer software, courts applying the scènes à faire doctrine should evaluate whether disputed material is precluded from copyright protection as "standard, stock, or common" (1) from the point of view of the author of the copyrighted work and (2) based on other computer programs existing at the time the copyrighted work was created.

**Notes**

1. *Cain v. Universal Pictures, Co.*, 47 F. Supp. 1013 (S.D. Cal. 1942) (determining that church scenes from a book and a movie were inherent to a particular plot line, thus denying copyright protection to book author).
2. E.g., *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 838 (10th Cir. 1993).
3. E.g., *Lexmark Int'l Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 535 (6th Cir. 2004).
4. 799 F. Supp. 1006 (N.D. Cal. 1992).
5. *Id*. at 1023.
6. *Id*. at 1033.
7. *Integrated Bar Coding Systems, Co. v. Wemert*, 2007 WL 496464 at *5-6 (E.D. Mich. Feb. 12, 2007) (citing Lexmark, 387 F.3d 522).
8. *MathWorks, Inc. v. Comsol AB, Civil Action No. 6:06-cv-335-LED* (E.D. Tex. 2008).
9. U.S. CONST. Art. I, § 8, cl. 8.
10. E.g., *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991).
11. In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988).
12. *Rosemount, Inc. v. Beckman Instrument, Inc.*, 727 F.2d 1540, 1544 n.3 (Fed. Cir. 1984).
13. *Mazer v. Stein*, 347 U.S. 201, 219; *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) ("The ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good.").
14. 124 F.3d 1366, 1375 (10th Cir. 1997) (emphasis in original).
15. 307 F.3d 197, 215 (3d Cir. 2002) ("[I]n determining aspects of the program not entitled to protection because of external factors, we examine the program from the viewpoint of the creator.") (emphasis in original).
16. *Control Data Systems, Inc. v. Infoware, Inc.*, 903 F. Supp. 1316, 1323 (D. Minn. 1995).
17. *Compaq Computer Corporation v. Procom Technology, Inc.*, 908 F. Supp. 1409, 1418 n.8 (S.D. Tex. 1995) (emphasis in original).