



LEXSEE 2009 U.S. DIST. LEXIS 84857

CARMICHAEL LODGE NO. 2103, BENEVOLENT AND PROTECTIVE ORDER OF ELKS OF THE UNITED STATES OF AMERICA, a California corporation, Plaintiff, v. RONALD L. LEONARD dba RV TRAVEL GUIDES, a California company, and DOES 1 through 50, inclusive, Defendants.

NO. CIV. S-07-2665 LKK/GGH

UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF CALIFORNIA

2009 U.S. Dist. LEXIS 84857

**September 15, 2009, Decided
September 16, 2009, Filed**

PRIOR HISTORY: *Carmichael Lodge No. 2103 v. Leonard, 2009 U.S. Dist. LEXIS 39223 (E.D. Cal., Apr. 23, 2009)*

COUNSEL: [*1] For Carmichael Lodge No. 2103 Benevolent and Protective Order of Elks of the United States of America, A California Corporation, Plaintiff, Counter Defendant: Glenn W. Peterson, LEAD ATTORNEY, Millstone Peterson & Watts, LLP, Roseville, CA; Pamela W. Bertani, LEAD ATTORNEY, Law Offices of John P. Costello, Sacramento, CA.

For Ronald L. Leonard, a California Company, Doing business as RV Travel Guides, Defendant: Mark R. Leonard, LEAD ATTORNEY, Davis & Leonard, LLP, Sacramento, CA.

For Ronald L. Leonard, a California Company, Counter Claimant: Mark R. Leonard, LEAD ATTORNEY, Davis & Leonard, LLP, Sacramento, CA.

JUDGES: LAWRENCE K. KARLTON, UNITED STATES DISTRICT COURT SENIOR JUDGE.

OPINION BY: LAWRENCE K. KARLTON

OPINION

ORDER

The core of this action is a copyright dispute between plaintiff/counterdefendant Carmichael Lodge No. 2103, Benevolent and Protective Order of Elks of the United States of America ("Carmichael Elks" or "Lodge") and defendant/counter-claimant Ronald Leonard, d/b/a RV Travel Guides. Carmichael Elks filed suit alleging that Leonard has infringed on the Lodge's copyrights regarding various travel guides. Leonard has brought various counterclaims, including a claim that the Carmichael Elks is infringing [*2] on copyrights owned by Leonard for portions of the same guides. Pending before the court is Leonard's motion for summary adjudication as to these two cross copyright infringement claims. Carmichael Elks have not filed a cross motion as to either claim.

I. BACKGROUND¹

1 Leonard has lodged objections to several items of evidence relied on by Carmichael Elks. Some of this evidence is not necessary to the resolution of the instant motion--including the portions of the deposition transcript challenged by Leonard's seventh objection. As to objections one through six, to the extent that the evidence objected to is relevant and the court has relied on it, those objections are OVERRULED.

Carmichael Elks is a California corporation and the local chapter of a national fraternal organization, the Benevolent and Protective Order of Elks of the United

States of America. Defendant and counterclaimant Ron Leonard is an individual presently residing in Carmichael, California. Leonard was a member of the Carmichael Elks from 1998 until July 11, 2008. Although Leonard's departure from the Carmichael Elks appears to be based on the circumstances underlying the instant copyright infringement claims, the facts [*3] of his departure do not influence the present motion.

A. The Elkdom Travel Guides

The parties' dispute concerns a series of travel guides. In or about 1984, two members of the Carmichael Elks, Ira and Barbara David, began creating a series of "Elkdom Travel Guides." These guides contain information about Elks lodges, accompanied by some maps, directions, and notes regarding points of interest. While the guides include RV travel information, they include all Elks lodges regardless of whether RV facilities are available. Carmichael Elks claims a protected interest in Elkdom Travel Guides I through III.

In 1988, Carmichael Elks obtained copyright registrations for Elkdom Travel Guides I and II, Registration Nos. TX-2-522-753 and TX-2-522-754. "Elkdom Travel Guide I" was originally published in 1984, and contains information regarding seven Pacific Coast states. "Elkdom Travel Guide II" was initially published in 1986, and pertains to eleven states east of those encompassed by Guide I and west of the Mississippi River.² The 1988 copyright registrations indicate that Ira and Barbara David authored these guides, but that the Davids assigned ownership of the copyrights to the Carmichael Elks.

² This [*4] guide encompasses Montana, North Dakota, South Dakota, Wyoming, Nebraska, Utah, Colorado, Kansas, Oklahoma, New Mexico and Texas. The parties curiously label this grouping of states as "Midwestern."

Elkdom Travel Guide III, pertaining to nine southeastern states, was not included with these initial copyright registrations. Instead, Guide III was first published in or about 1991. Carmichael Elks did not seek to register a copyright for this guide until 2007, after the facts underlying this dispute had already arisen.

Guides I through III follow the same format. Prior to Leonard's involvement in the guides, the guides were oriented in a landscape or horizontal format, with the Elks logo and the badge for the Carmichael Elks on the cover. The guides were divided into a section for each state, arranged alphabetically. Each section provided information for cities that had an Elks lodge, alphabetized by city name. The pages were divided in half vertically and horizontally, generating four "tiles," with information for each city presented in a single tile. This

information included the Elk's lodge number, phone number, address, meeting times, dinner hours, and bar hours. Each tile also explained [*5] whether the lodge featured RV parking, applicable parking fees if any, the availability of water, electric, and dumping hookups, and whether the lodge had an RV club. Finally, each tile included a section which could contain directions, miscellaneous information, or a small map. Miscellaneous information included notations regarding lodge events such as bingo nights, regular menus (e.g., "Fish & Chicken Fri night"), and whether the lodge, instead of being a dedicated building, was another facility used for meetings (e.g., "Lodge meets at Vally Nat'l Bank Building on Coronado Blvd."). Maps, if included, were simplified, including only major highways and streets, represented by straight lines of uniform thickness, and noting the location of the lodge.

From 1984 through 1992, these three guides were authored and updated by Barbara and Ira David. During this time, other Carmichael Elks lodge members, primarily Muriel and Forrest Wright, were responsible for the printing and distribution. In 1992, the Davids ceased participating in the production or updating of the guides.

B. Leonard's Initial Involvement with Guides I through III

In or about 1998, Leonard, then a member of the Carmichael [*6] Elks, began working on the guides. Leonard updated the guides by contacting the listed lodges to validate the information contained in the guides. Relatedly, Leonard added to the notes for various lodges, incorporating information that was conveyed to him by Forrest Wright (who in turn received information from travelers) and that Leonard received over the internet. Deposition of Forrest Wright 38:5-15. Leonard put this information into his own words. Declaration of Ronald Leonard Supp. Def.'s Mot. Summ. J., P 3. Leonard also performed word processing and desktop publishing tasks. After Leonard began working on the guides, the guides switched from a landscape to a portrait layout, and switched from using four tiles on each page to four rows. Lastly, he replaced the maps, using curved lines to represent roads, thicker lines to represent freeways, signifying highways and freeways by presenting the road number in a symbol overlaying the line rather than with text, and by using a star symbol rather than a box to indicate the location of the lodge. These changes were first reflected in guides printed in 2000. In performing the above, Leonard used information contained in prior versions [*7] of the Elkdom Travel Guides, but exclusively relied upon online mapping tools for creating the maps.

During this time, Forrest Wright continued to manage the printing and distribution of the guides. Mr. Wright also conveyed information from lodges and Elks

travelers to Leonard to be included in the guide. On at least one issue, Mr. Wright exercised control over the content of the guides. Leonard suggested abbreviating the information regarding lodges that did not provide parking for RVs, a change that would make the guides more RV-centric, but Wright rejected this suggestion.³ Wright Dep., 41:9 - 43:7. Other than the various Elks members who submitted the information that was included in the guides, no other individuals were directly involved in the production of the content for Guides I through III.

3 As noted below, Leonard would later implement this change in the guides he published separately.

Leonard did not receive monetary compensation aside from reimbursement of printing expenses. Leonard never executed any written agreement regarding ownership of his contributions to the guides. Leonard updated the guides in this manner until April of 2007.

C. Elkdom Travel Guide IV

Separate from [*8] the above three guides, in or about June 1996, Carmichael Elks granted Gulf Coast Lodge No. 2782, located in Gulf Shores, Alabama, the right to publish Elkdom Travel Guides covering specified Northeastern States. Compl. PP 15-16. The Gulf Coast Lodge published Elkdom Travel Guide IV, covering these states, until October 13, 2005. At that time, the Gulf Coast Lodge entered an agreement with Carmichael Elks wherein the Gulf Coast Lodge returned the right to publish Elkdom Travel Guide IV to Carmichael Elks in exchange for an agreement to pay royalties to the Gulf Coast Lodge. Despite this development, Carmichael Elks has not published the fourth guide. In May of 2006, Leonard entered into a separate arrangement with the Alabama lodge to publish Elkdom Travel Guide IV without the involvement of Carmichael Elks.

D. Leonard's Claim to Copyright in the Guides

The Elkdom Travel Guides published from 2000 to 2006 bore a notice stating that the copyright for the guides was owned by Carmichael Elks. At some point in 2006, Leonard replaced this notice with one stating that the copyright was owned by RV Travel Guides, e.g., "Copyright © 2000, 2001, 2002, 2003, 2004, 2005, 2006; RV Travel Guides, [*9] Sacramento, CA." R. Leonard Decl. Ex. A (May 12, 2006, deposit copy of Elkdom Travel Guide I). This change did not occur uniformly. For example, the "deposit copy" of Elkdom Travel Guide I submitted in connection with Leonard's copyright registration includes the above internal statement, and the cover of this guide also indicates that the copyright is owned by RV Travel Guides. R. Leonard Decl. Ex. A.

However, in the November 28, 2006 printing of Elkdom Travel Guide I, the cover states "© BPOE Lodge 2103, Carmichael, CA" while the first page includes the RV Travel Guides copyright statement. See Deposition of Ronald Leonard, 97:8-98:4.

On January 9, 2007, Leonard applied to register copyrights for the May 12, April 16, March 6, and October 1 2006 editions Elkdom Travel Guides I through IV, respectively. Registration Nos. TX 6-585-010, TX 6-585-011, TX 6-585-012, TX 6-585-013 Compl. Ex. D-G. Leonard used a "short form" application provided by the Copyright Office. This form required that he specify the "year of creation" for the subject work. On each form, Leonard answered "2000," although Leonard now declares that this was in error, such that the works were created in the years he [*10] provided as their initial publication. Leonard indicated that he was the sole author of each work and owner of each copyright. The short form did not inquire as to whether there were any prior registrations of the subject works.

Both parties have introduced copies of Leonard's registration forms, all of which bear a "certificate of registration" from the Copyright Office indicating that the registrations became effective on January 9, 2007. Carmichael Elks state that these registrations were nonetheless not granted by the Copyright Office until some time after March 2, 2007, but Carmichael Elks have not introduced any evidence to this effect.⁴

4 Carmichael Elks state in their opposition memo that on March 2, 2007, Alden Almquist, a copyright examiner, sent a letter explaining the following:

We are delaying registration because this work contains preexisting material, and the Short Form application your [sic] used does not have space to distinguish old and new material. When a new work contains material that has been either previously registered or published, or that is in the public domain, the copyright claim must be limited to the new copyrightable authorship that has been added. In [*11] such cases, the application should describe both preexisting material and the added material in the space provided for this information. This information is required regardless of whether you or someone else published the preexisting material, or whether

the preexisting material is copyrighted or in the public domain.

This purported quote appears in Carmichael Elks' opposition memorandum and complaint, but not in any evidence submitted by Carmichael Elks.

While the Carmichael Elks contend that Leonard's registrations became effective at a later date, they have not provided any explanation as to why the application forms indicate that the registration became effective on January 9, 2007, or on what later date the registrations took effect.

On January 19, 2007, Leonard wrote a letter to Carmichael Elks stating that

effective 3-31-2007, I am withdrawing permission to use my copyrighted format and maps used in Elkdom Travel Guides I, II and III, which I created and have registered with the US Library of Congress Copyright Office. My copyright extends only to the format (layout) of the Guides, and to the maps which I created, so perhaps another editor/publisher can be found who will prepare [*12] and use a different format.

R. Leonard Decl. Ex. E.

E. Carmichael Elks' 2007 Registration of Elkdom Travel Guide III

On March 27, 2007, Carmichael Elks filed to register a copyright for the then-current edition of Elkdom Travel Guide III. The certificate of registration lists Ira and Barbara David as the authors of this guide, and does not mention Leonard. Nor does the certificate mention the registrations filed by Leonard on January of 2007, or otherwise refer to the dispute regarding these materials.

E. Subsequent Sale of the Guides

On or about April 2007, Leonard began to sell the guides independently, under the title "Elk RV Travel Guides." In preparing these guides, Leonard also added latitude, longitude and elevation information for each lodge, removed the Elks logo from the cover, revised and added some notes, and revised the format of the guides to list lodges that do not offer RV parking at the end of each section in an abbreviated form. R. Leonard Decl. Ex. F-H.

Since March 2007 Carmichael Elks have continued to sell versions of Guides I, II, and III that are based on the last versions Leonard contributed to before the dispute arose. Wright Dep. 74:10-17. The versions sold by Carmichael [*13] Elks are nearly identical to the versions for which Leonard obtained copyright registrations, with only minor revisions consisting of updates to some of the lodge information. See Exhibits H-M to the Declaration of Mark Leonard Supp. Def.'s Mot. Summ. J. As of April 27, 2009 the Carmichael Elks were still referring customers for Leonard Guide IV to Leonard. M. Leonard Decl. Ex. A (Wright Depo. 98:15-23)

II. STANDARD FOR A MOTION FOR SUMMARY JUDGMENT

Summary judgment is appropriate when it is demonstrated that there exists no genuine issue as to any material fact, and that the moving party is entitled to judgment as a matter of law. *Fed. R. Civ. P. 56(c)*; *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 157, 90 S. Ct. 1598, 26 L. Ed. 2d 142 (1970); *Poller v. Columbia Broadcast System*, 368 U.S. 464, 467, 82 S. Ct. 486, 7 L. Ed. 2d 458 (1962); *Jung v. FMC Corp.*, 755 F.2d 708, 710 (9th Cir. 1985); *Loehr v. Ventura County Community College Dist.*, 743 F.2d 1310, 1313 (9th Cir. 1984).

Under summary judgment practice, the moving party

[A]lways bears the initial responsibility of informing the district court of the basis for its motion, and identifying those portions of "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the [*14] affidavits, if any," which it believes demonstrate the absence of a genuine issue of material fact.

Celotex Corp. v. Catrett, 477 U.S. 317, 323, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986). "[W]here the nonmoving party will bear the burden of proof at trial on a dispositive issue, a summary judgment motion may properly be made in reliance solely on the 'pleadings, depositions, answers to interrogatories, and admissions on file.'" *Id.* Indeed, summary judgment should be entered, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial. *Id.* at 322. "[A] complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial." *Id.* In such a circumstance, summary judgment should be granted, "so

long as whatever is before the district court demonstrates that the standard for entry of summary judgment, as set forth in *Rule 56(c)*, is satisfied." *Id.* at 323.

If the moving party meets its initial responsibility, the burden then shifts to the opposing party to establish that a genuine issue [*15] as to any material fact actually does exist. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586, 106 S. Ct. 1348, 89 L. Ed. 2d 538 (1986); *First Nat'l Bank of Arizona v. Cities Serv. Co.*, 391 U.S. 253, 288-89, 88 S. Ct. 1575, 20 L. Ed. 2d 569 (1968); *Ruffin v. County of Los Angeles*, 607 F.2d 1276, 1280 (9th Cir. 1979), cert. denied, 455 U.S. 951, 445 U.S. 951, 100 S. Ct. 1600, 63 L. Ed. 2d 786 (1980).

In attempting to establish the existence of this factual dispute, the opposing party may not rely upon the denials of its pleadings, but is required to tender evidence of specific facts in the form of affidavits, and/or admissible discovery material, in support of its contention that the dispute exists. *Rule 56(e)*; *Matsushita*, 475 U.S. at 586 n.11; *First Nat'l Bank*, 391 U.S. at 289; *Strong v. France*, 474 F.2d 747, 749 (9th Cir. 1973). The opposing party must demonstrate that the fact in contention is material, i.e., a fact that might affect the outcome of the suit under the governing law, *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986); *T.W. Elec. Serv., Inc. v. Pacific Elec. Contractors Ass'n*, 809 F.2d 626, 630 (9th Cir. 1987), and that the dispute is genuine, i.e., the evidence is such that a reasonable jury could return a verdict for the non-moving party, *Anderson*, 477 U.S. at 248-49; [*16] *Wool v. Tandem Computers, Inc.*, 818 F.2d 1433, 1436 (9th Cir. 1987).

In the endeavor to establish the existence of a factual dispute, the opposing party need not establish a material issue of fact conclusively in its favor. It is sufficient that "the claimed factual dispute be shown to require a jury or judge to resolve the parties' differing versions of the truth at trial." *First Nat'l Bank*, 391 U.S. at 290; *T.W. Elec. Serv.*, 809 F.2d at 631. Thus, the "purpose of summary judgment is to 'pierce the pleadings and to assess the proof in order to see whether there is a genuine need for trial.'" *Matsushita*, 475 U.S. at 587 (quoting *Fed. R. Civ. P. 56(e)* advisory committee's note on 1963 amendments); *International Union of Bricklayers v. Martin Jaska, Inc.*, 752 F.2d 1401, 1405 (9th Cir. 1985).

In resolving the summary judgment motion, the court examines the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any. *Rule 56(c)*; *Poller*, 368 U.S. at 468; *SEC v. Seaboard Corp.*, 677 F.2d 1301, 1305-06 (9th Cir. 1982). The evidence of the opposing party is to be believed, *Anderson*, 477 U.S. at 255, and all reasonable

inferences that may be [*17] drawn from the facts placed before the court must be drawn in favor of the opposing party, *Matsushita*, 475 U.S. at 587 (citing *United States v. Diebold, Inc.*, 369 U.S. 654, 655, 82 S. Ct. 993, 8 L. Ed. 2d 176 (1962) (per curiam)); *Abramson v. Univ. of Haw.*, 594 F.2d 202, 208 (9th Cir. 1979). Nevertheless, inferences are not drawn out of the air, and it is the opposing party's obligation to produce a factual predicate from which the inference may be drawn. *Richards v. Nielsen Freight Lines*, 602 F. Supp. 1224, 1244-45 (E.D. Cal. 1985), aff'd, 810 F.2d 898, 902 (9th Cir. 1987).

Finally, to demonstrate a genuine issue, the opposing party "must do more than simply show that there is some metaphysical doubt as to the material facts. . . . Where the record taken as a whole could not lead a rational trier of fact to find for the nonmoving party, there is no 'genuine issue for trial.'" *Matsushita*, 475 U.S. at 587 (citation omitted).

III. ANALYSIS

A. Plaintiff Carmichael Elks' Claim

Carmichel Elks claims that Leonard's publication of the "Leonard Guides" infringes on copyrights held by the Lodge. The basic elements of a claim for copyright infringement are (1) ownership of a valid copyright in a work and (2) copying of protected [*18] elements from that work. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991); *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002). In addition, registration of the copyright, while "not a prerequisite to a valid copyright, . . . is a prerequisite to suit." *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081, 1085 (9th Cir. 1989) (citing 17 U.S.C. §§ 408(a), 411).⁵ Therefore, to succeed on a claim for infringement, a plaintiff must show (1) that the plaintiff is the owner of the subject copyright, (2) that the copyright has been registered, and (3) that the defendant has infringed on protected elements of the copyrighted work.

⁵ There is an exception to this rule, not relevant here, for "work of visual art." 17 U.S.C. §§ 411(a), 106A.

In this case, the court begins with the second step, looking to whether the assertedly infringed-upon work has been registered. In subpart III(A)(1) below, the court concludes that Carmichael Elks' only valid registrations are those pertaining to the 1988 editions of Elksdom Travel Guides I and II. Because Carmichael Elks is the undisputed owner of the copyrights in these works, discussion of ownership is unnecessary. Accordingly, [*19] in subpart III(A)(2), the court turns to which elements, if any, of these works are both eligible for copyright pro-

tection and have been impermissibly copied by Leonard's guides.⁶

6 Ninth Circuit cases have not always approached the problem in this way. For example, some cases first look to whether the work contains copyrightable elements in the abstract or in discussion of the first step (ownership of a copyright), only then turning to whether copyrightable elements have been infringed upon. See, e.g., *Eis-Hokin v. Skyy Spirits*, 225 F.3d 1068, 1076 (9th Cir. 2000). Other cases have discussed protectability largely as part of the infringement analysis. See, e.g., *Cavalier*, 297 F.3d at 822; see also *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991) (concluding that the first step of this test, "ownership of a valid copyright," was satisfied as by the concession that the work contained at least some copyrightable elements, and then discussing copyrightability of particular elements as part of the infringement analysis). See also *Apple Computer v. Microsoft Corp.*, 35 F.3d 1435, 1443 (9th Cir. 1994) (articulating a yet another process, in three steps, for evaluation [*20] of infringement claims). Although all approaches lead to the same result, it appears to the court that the *Cavalier* approach is both more common and better suited to this case, and the court adopts it here.

1. Carmichael Elks' Registrations of Copyrights

a. The 1988 Registrations of Guides I and II

Carmichael Elks registered Elkdom Travel Guides I and II in 1988, and did not register any subsequent editions of these guides. Leonard does not dispute the validity of the 1988 registrations.

Carmichael Elks argue that the 1988 registrations effectively registered subsequent editions of Guides I and II as well. This argument does not lie. Registration of a work does not extend to future works derived from the registered work.⁷ *Well-Made Toy Mfg. Corp. v. Goffa Int'l Corp.*, 354 F.3d 112, 115 (2d Cir. 2003). Accordingly, when a plaintiff registers one work, creates a derivative of that work, and then claims that a third work created by another person infringes on the derivative, the requirement of registration as a prerequisite to suit may not be satisfied. *Id.* In such a situation, an infringement action will succeed only if the third work copied from the unregistered derivative elements that [*21] were also present in the registered original. In such a case, the plaintiff effectively brings a claim for infringement of the original. See, e.g., *Montgomery v. Noga*, 168 F.3d 1282, 1292-93 (11th Cir. 1999); see also *Russell v. Price*,

612 F.2d 1123, 1128 (9th Cir. 1979) ("[t]he established doctrine prevents unauthorized copying or other infringing use of the underlying work or any part of that work contained in the derivative product so long as the underlying work itself remains copyrighted."), *Dalton-Ross Homes, Inc. v. Williams*, 2007 U.S. Dist. LEXIS 64135, *7 (D. Ariz. Aug. 29, 2007). Therefore, Carmichael Elks may base a claim for infringement on the 1988 editions of Elkdom Travel Guides I and II, but not on unregistered derivative works, including future editions of these guides.

7 A derivative work is one that "would be considered an infringing work if the material which it has derived from a preexisting work had been taken without the consent of a copyright proprietor of such preexisting work." *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341, 1343 (9th Cir. 1988) (quoting 1 *Nimmer on Copyright* § 3.01 (1986)). See also 17 U.S.C. § 101.

In a separate argument, Carmichael [*22] Elks assert that they "own any contributions supplied by [Leonard] as derivative works." This is incorrect. As noted, a derivative work is one that includes protected elements from an earlier work. However, a derivative work might also include novel protectable elements. In such a case, ownership of the novel elements in the derivative is not automatically transferred to the owner of the original. See 17 U.S.C. § 201(a) (copyright initially vests in the author of a work).

b. The 2007 Registration of Elkdom Travel Guide III

On March 21, 2007, Carmichael Elks filed for registration of Elkdom Travel Guide III. Compl. Ex. C. Leonard contends that this registration is defective, and therefore cannot support an infringement action.

17 U.S.C. section 409 provides the requirements for an application for copyright registration. These requirements include, inter alia, the names of the authors, an explanation as to how the claimant came to own the copyright (if the claimant is not the author), dates of prior publication of the work, and "in the case of a compilation or derivative work, an identification of any preexisting work or works that it is based on or incorporates, and a brief, general statement [*23] of the additional material covered by the copyright claim being registered." 17 U.S.C. §§ 409(2), (5), (8), (9). The registration application form used by Carmichael Elks also specifically inquires as to whether "registration for this work, or for an earlier version of this work, [has] already been made in the Copyright Office," and requests details of any such prior registrations. "The knowing failure to advise the

Copyright Office of facts that might have occasioned a rejection of the application constitutes reason for holding the registration invalid and thus incapable of supporting an infringement action, or to deny enforcement on the ground of unclean hands." *Fleming v. Miles*, 181 F. Supp. 2d 1143, 1154 (D. Or. 2001); see also *Harris v. Emus Records Corp.*, 734 F.2d 1329, 1335 (9th Cir. 1984) ("inaccuracies in copyright registration," when prejudicial or intended to defraud, may bar an action for infringement.)

Although this court finds *Fleming* to be a persuasive statement of the law, it is also clear that an application for registration need not include all information that might conceivably result in the application's rejection. The possibility that the information would cause [*24] rejection must cross some threshold. This court need not decide precisely where that threshold lies, because two omissions here, regarding Leonard's authorship and registrations of the work, undoubtedly surpass any plausible threshold.

The application submitted by Carmichael Elks identifies the work to be copyrighted as the March 6, 2006 edition of Elkdom Travel Guide III. Carmichael Elks identified Ira and Barbara David as the authors of this 2006 edition of Elkdom Travel Guide III, although the Davids had ceased contributing to the guides in 1992. The application omitted any reference to Leonard as a possible author. "As a general rule, the author is the party who actually creates the work, that is, the person who translates an idea into a fixed, tangible expression entitled to copyright protection." *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737, 109 S. Ct. 2166, 104 L. Ed. 2d 811 (1989) (citing 17 U.S.C. § 102). In a similar omission, the application notes the 1988 registrations of Elkdom Travel Guides I and II, but does not refer to Leonard's application for registration and registration of the guides. If none of the work authored by Leonard was of a kind entitled to protection, and if Leonard's prior [*25] registration was invalid, then Carmichael Elks might have been entitled to registration of this copyright. However, there were serious questions as to the propriety of the Carmichael Elks' registration attempt. The undisputed evidence establishes that at the time of registration, Carmichael Elks was aware of these disputes, and Carmichael Elks nonetheless failed to inform the copyright office of these issues. Accordingly, as explained by Fleming, Carmichael Elks' registration of Elkdom Travel Guide III cannot support a claim for infringement. 181 F. Supp. 2d at 1154. Any infringement claim brought by the Carmichael Elks must therefore be based solely on the versions of Elkdom Travel Guides I and II registered in 1988.

2. Copying of Protected Elements

Because ownership of the copyrights in Elkdom Travel Guides I and II is undisputed, the remaining step in the infringement analysis is whether "defendant copied protected elements of the work." *Cavalier*, 297 F.3d at 822. A plaintiff may prevail on this step by showing "that the infringer had access to plaintiff's copyrighted work and that the works at issue are substantially similar in their protected elements." *Id.* Access and similarity [*26] are on a sliding scale, such that when a defendant has greater access, the Ninth Circuit accepts "a lower standard of proof of substantial similarity." *Swirsky v. Carey*, 376 F.3d 841, 844 (9th Cir. 2004). However, while a strong showing of access may offset a weak showing of similarity, the standard for protectability is constant. Thus, even where direct, verbatim copying has occurred, there is no infringement unless the copied elements are the type protected by copyright. *Feist*, 499 U.S. at 364, *Matthew Bender*, 158 F.3d at 689.

In this case, access has been clearly shown, and the dispute therefore concerns "substantial[ly] similar[ity] [of] protected elements." For this, the Ninth Circuit uses yet another two part test, in which a plaintiff must show both "extrinsic" and "intrinsic" similarity. *Cavalier*, 297 F.3d at 822; *Apple Computer v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994). The "extrinsic" part of this test objectively looks to whether the protectable elements of the works are similar. The "intrinsic" part of this test "is a subjective comparison that focuses on whether the ordinary, reasonable audience would find the works substantially similar in the total concept [*27] and feel of the works." *Id.* Extrinsic similarity is a question of fact that may, in some circumstances, be resolved on summary judgment, but intrinsic similarity is a factual question that must be left to the jury. *Id.* at 824. Therefore, the issue on this motion is whether Carmichael Elks have provided evidence sufficient to support a finding that Leonard's "Elk RV Travel Guides" include elements that are substantially similar to the protectable elements, if any, of the 1988 editions of Elkdom Travel Guides I and II. If not, Leonard is entitled to summary judgment dismissing this claim.

Under the extrinsic test, "A court must take care to inquire only whether the *protectible elements, standing alone*, are substantially similar. Therefore, when applying the extrinsic test, a court must filter out and disregard the non-protectible elements in making its substantial similarity determination." *Cavalier*, 297 F.3d at 822 (emphasis in original). The court reviews the scope of copyright protection before turning to the application of the extrinsic similarity test to this case.

a. Scope of Copyright Protection

Copyright does not protect bare "ideas" or "facts." *Cavalier*, 297 F.3d at 823 (citing [*28] *Berkic v.*

Crichton, 761 F.2d 1289, 1293-94 (9th Cir. 1985)); see also 17 U.S.C. § 102(b). Although "[i]t may seem unfair" that certain elements may be copied with impunity, "this is not 'some unforeseen byproduct of a statutory scheme.'" *Feist*, 499 U.S. at 349 (quoting *Harper & Row, Publs. v. Nation Enters.*, 471 U.S. 539, 589, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985) (dissenting opinion)). The constitution provides the power "to promote the Progress of Science and useful Arts," Art. I, § 8, cl. 8, and Congress has determined that the law best serves this purpose when it "encourages others to build freely upon the ideas and information conveyed by a work." *Feist*, 499 U.S. at 350. Although neither facts nor ideas are copyrightable, copyright protects particular expressions of ideas and creativity in the compilation of facts, as explained in the following two sections. 17 U.S.C. § 103(b); *Feist*, 499 U.S. at 344, *CDN Inc. v. Kapes*, 197 F.3d 1256, 1259 (9th Cir. 1999).

i. The Idea/Expression Distinction

The expression of an idea, but not the idea itself, may be eligible for copyright protection. *Cavalier*, 297 F.3d at 823 (citing 17 U.S.C. § 102(b)). This limit applies to preclude copyright protection of an "idea" regardless [*29] of whether the idea is original or the product of creativity. Although the distinction between an idea and an expression thereof is imprecise, numerous Ninth Circuit cases illustrate the distinction's application. For example, in discussing claims by Apple Computer that Microsoft infringed on Apple's copyrights for design of computer interfaces, the Ninth Circuit held that many elements of the interface were ideas not subject to copyright protection, including "the idea of a graphical user interface, or the idea of a desktop metaphor" for such an interface, "use of windows to display multiple images on the computer screen and to facilitate user interaction with the information contained in the windows; iconic representation of familiar objects from the office environment; manipulation of icons to convey instructions and to control operation of the computer; use of menus to store information or computer functions in a place that is convenient to reach, but saves screen space for other images; and opening and closing of objects as a means of retrieving, transferring and storing information." *Apple Computer*, 35 F.3d at 1443-44. In a later case concerning a guide to coin prices, the Ninth [*30] Circuit explained that an author cannot protect

[the] idea of creating a wholesale price guide, but [the author] can use the copyright laws to protect its idea of what those prices are. Drawing this line preserves the balance between competition and protection: it allows [the author's] competitors to create their own price guides and thus

further competition, but protects [the author's] creation, thus giving it an incentive to create such a guide.

CDN Inc. v. Kapes, 197 F.3d 1256, 1262 (9th Cir. 1999).

⁸ In a third illustration of the idea/expression distinction, concerning a claim for infringement of a copyright in a television show demonstrating magic tricks, the Ninth Circuit explained that "while similarities in tangible expressive elements . . . are pertinent to our analysis, the mere fact that both *The Mystery Magician* and the *Specials* reveal the secrets behind magic tricks does not by itself constitute infringement." *Rice v. Fox Broad. Co.*, 330 F.3d 1170, 1175 (9th Cir. 2003). See also *Satava v. Lowry*, 323 F.3d 805, 811 (9th Cir. 2003) ("no copyright protection may be afforded to the idea of producing a glass-in-glass jellyfish sculpture or to elements of expression that naturally [*31] follow from the idea of such a sculpture.").

8 The *CDN* court's conclusion that the prices themselves were copyrightable has little bearing on this case. The court concluded that the prices included in the guide were "estimates" that could not be formulaically calculated, and that each individual price was therefore itself the result of a creative process. 197 F.3d at 1260. Accordingly, the prices themselves were eligible for copyright protection, notwithstanding the *CDN* court's separate discussion of cases dealing with compilations of individually unprotectable facts. *Id.*

ii. Factual Compilations

Roughly similar to the way in which an idea may not be copyrighted but its expression may be, facts many not be copyrighted, but their creative and original selection or arrangement in a factual compilation may be. "A 'compilation' is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101. To be eligible for protection, this selection or arrangement must be made independently by the compiler and entail a minimum degree [*32] of creativity. *Feist*, 499 U.S. at 361. Creativity and originality are the sole issues; whether discovery or collection of facts "takes much time and effort is wholly irrelevant to whether the . . . work is copyrightable." *CDN*, 197 F.3d at 1260 (citing *Feist*, 499 U.S. at 349). "Copyright rewards originality, not effort." *Feist*, 499 U.S. at 364. ⁹ The Supreme Court has explained that:

the originality requirement is not particularly stringent. . . . Originality requires

only that the author make the selection or arrangement independently (i.e., without copying that selection or arrangement from another work), and that it display some minimal level of creativity. Presumably, the vast majority of compilations will pass this test, but not all will. There remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent.

Feist, 499 U.S. at 358-59. A majority of courts treat the question of whether given facts demonstrate the requisite creativity as a question of law, although this court is not aware of a Ninth Circuit or the Supreme Court decision directly speaking to the issue. See *Mid Am. Title Co. v. Kirk*, 59 F.3d 719, 722 (7th Cir. 1995), [*33] *BellSouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g*, 999 F.2d 1436, 1444 (11th Cir. 1993); but see *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 674, 681 (2d Cir. 1998) ("the question of whether particular elements of a work demonstrate sufficient originality and creativity to warrant copyright protection [is] a question for the factfinder.").¹⁰ I adopt the majority approach here.

9 However, not all originality is rewarded or protected by the copyright system. As explained above, ideas are not protected, regardless of their originality, and *Feist* did not change this rule. *Rice*, 330 F.3d at 1175 (applying, after *Feist* was decided, the idea/expression distinction).

10 Outside the factual compilation context, the Ninth Circuit has held that "Issues involving the availability and extent of copyright protection . . . present mixed questions of law and fact." *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 201 (9th Cir. 1989). In *CDN*, the Ninth Circuit cited *Harper House*, but *CDN* did not explain whether the *Feist* question of whether selection and arrangement of facts that are not themselves eligible for copyright was or was not a question of law. Instead, *CDN* merely cited [*34] *Harper House* for the proposition that the question of whether prices were facts was reviewed de novo. 197 F.3d at 1259 n.1. As explained above, this determination differs from the question of whether selection of uncopyrightable facts is sufficiently creative.

For the selection or arrangement of facts to be creative, the author must make "non-obvious choices from among more than a few options." *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 674, 683 (2d Cir. 1998). External factors may eliminate options, and demonstrate

that a choice among the remaining options was not creative. *Id.*, *Mid Am. Title Co. v. Kirk*, 59 F.3d 719, 722 (7th Cir. 1995). In this circumstance, a subsequent publisher may take the work of the compiler.

In *Mid Am. Title Co.*, the plaintiff claimed infringement of a compilation of selected land title data. 59 F.3d at 721. The Seventh Circuit held that the selection of this data was "a matter of convention and strict industry standards." *Id.* at 722. All individuals preparing a similar document "ultimately would have selected the same facts to include." *Id.* In particular, because external forces required that the plaintiff "list all facts which affect marketable title, [*35] there was no room for creativity in determining which liens or which encumbrances to include in the title commitment." *Id.* at 723.

In *Matthew Bender*, the Second Circuit considered the selection and arrangement of information in publication of federal court opinions. 158 F.3d at 683. Plaintiffs sought a declaratory judgment that certain elements of West Publishing Company's formatting of Court of Appeals and Supreme Court opinions were not eligible for copyright protection. The Second Circuit held that the selection and arrangement of certain information was so limited by external factors that no creativity was involved. As to the parties' names, the deciding court, and the dates of argument and decision, the selection of these facts for inclusion was compelled by these facts' importance, and selection was not a function of West's creativity. *Id.* at 683. As to the arrangement of information regarding subsequent appellate history before the same court--amendments, rehearings, opinions related to rehearing en banc--the court held that there would almost never be more than "one or two realistic or useful options" as to how to arrange this information, and that the choice among these options [*36] would be dictated by the form of the later decision and its timing relative to the printing of the reporter. *Id.* at 685. Similarly, "the standard of the legal profession" determined the use of parallel or alternative citations, leaving no room for the exercise of creativity. *Id.*

Even when multiple options for selection or arrangement are available, the choice from among those options must be non-obvious in order to be protectable. In *Feist*, the Supreme Court held that the selection of information published in a phone book--a person's name, town, and telephone number--"could not be more obvious." 499 U.S. at 362.¹¹ The alphabetical listing of names was equally obvious and therefore uncopyrightable. *Id.* at 363. In a similar case, the Eleventh Circuit concluded that the arrangement of listings in a yellow pages directory under categories such as "attorneys" and "banks," or the division of "churches by denomination or attorneys by area of specialty," was obvious for purposes

of Feist. *BellSouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g*, 999 F.2d 1436, 1444 (11th Cir. 1993).

11 Although common practice is to include addresses in phone directories, it is not as clear to this court as [*37] it was to the Supreme Court in Feist that addresses form a necessary component of a phone book. Nonetheless, this court is bound by *Feist*.

The above factors may preclude a finding of creativity even when they reduce the range of options to very few, but not a single, choice for selection or arrangement. *Matthew Bender*, 158 F.3d at 687-88. In such a scenario, affording copyright protection to the choice may make it impossible for future authors to avoid infringement. *Id.* When options are so constrained, the choice of any one option is not creative. *Id.*

In contrast, when the choices for selection or arrangement are not so constrained, the choice among them may demonstrate protectable creativity or "exercise of judgment." *Key Publ'ns, Inc. v. Chinatown Today Pub. Enters, Inc.*, 945 F.2d 509, 513 (2d Cir. 1991). Key Publications concerned a business directory for New York's Chinese-American community. *Id.* at 511. The Second Circuit held that both the selection and arrangement of information demonstrated creativity. The selection was creative because, at the minimum, the directory's author excluded "businesses she did not think would remain open for very long, such as certain insurance brokers, [*38] take-out restaurants, and traditional Chinese medical practitioners," and identification of these business required creative judgment. *Id.* at 513. The arrangement of listings within the directory was creative because it involved creation of categories "of particular interest to the Chinese-American community and not common to yellow pages, e.g., 'BEAN CURD & BEAN SPROUT SHOPS.'" ¹² *Id.* at 514.

12 However, under Ninth Circuit precedent, the decision to create a Chinese-American business directory is an idea that is not copyrightable. *Rice*, 330 F.3d at 1175. If, once this decision is made, external factors dictate the inclusion of a category for "bean curd and bean sprout shops," adoption of this category is not creative. The Second Circuit in *Key Publications* did not address, and this court does not profess to know, whether this particular category is so obvious to New York's Chinese-American community as to demonstrate an absence of creativity.

In another opinion concluding that the selection of facts for inclusion in a compilation was creative, the Second Circuit considered selection of baseball pitching statistics. *Kregos v. Associated Press*, 937 F.2d 700 (2d

Cir. 1991). The compilation [*39] used nine statistics for each player. *Id.* at 702. This particular combination had not been previously used, and one of these statistics had not be used in any prior compilation. *Id.* at 703. The defendant had moved for summary judgment on the ground that this selection was not copyrightable. *Id.* The Second Circuit upheld the district court's denial of defendant's motion. Where "there are at least scores of available statistics about pitching performance available . . . and therefore thousands of combinations of data that a selector can choose It cannot be said as a matter of law that in selecting the nine items . . . [plaintiff] has failed to display enough selectivity to satisfy the requirement of originality." *Id.* at 704.

b. Substantial Similarity of Protected Elements in The Elkdom Travel Guides

In this case, Carmichael Elks argue that the 1988 editions of Elkdom Travel Guides I and II demonstrate the requisite creativity in selection and arrangement of the information to be included, as well as in the notes accompanying some entries, and that Leonard has infringed upon these elements. ¹³ The court considers these choices separately.

13 Carmichael Elks also argue that the maps [*40] included in the original guides are eligible for copyright protection. Leonard does not dispute this, and instead argues that there is no similarity between the protectable elements of the Carmichael Elks maps and the maps used in Leonard's guides. Carmichael Elks implicitly concede this point--they argue that Leonard's maps contain public domain information and information that is not eligible to copyright, but Carmichael Elks identify no similarities between Leonard's maps and theirs.

i. Selection of Categories of Information

Carmichael Elks argue that the selection of categories of information included is entitled to protection. Before addressing this argument, the court notes that the decision to publish a travel guide for Elks is an idea that is not itself copyrightable, as it is akin to the idea to create a show that explains magic tricks, or a guide to the prices of coins. *Rice*, 330 F.3d at 1175, *CDN*, 197 F.3d at 1262.

Carmichael Elks therefore may not use copyright law to prevent others from publishing such a similar guide--now that Carmichael Elks have come up with the idea, copyright law encourages others to build upon it. *Feist*, 499 U.S. at 350. Thus, the Carmichael Elks cannot [*41] protect the selection of information that would be necessary or obvious in any travel guide for Elks. See, e.g., *Matthew Bender*, 158 F.3d at 683, 685. For this

reason, the guides' inclusion of the following information for each lodge is not protectable: city name, lodge number, phone number and address. Inclusion of meeting times, dining room hours, and bar hours was also obvious in light of the guide's purpose. The submitted evidence indicates that the needs of the guides' intended readers compelled the inclusion of meeting times, dining room hours, and bar hours, and Carmichael Elks, who bears the burden of proof on this issue at trial, has not submitted any evidence supporting a contrary conclusion. *Matthew Bender, 158 F.3d at 685*. Selection of this information is therefore obvious (if not necessary) and non-creative.

Carmichael Elks also argue that the decision to include information for RV travelers is entitled to copyright protection. Plainly, not all Elks travel by RV. Accordingly, the decision to include such information in the general guide was not compelled by external circumstances. The decision to include this information, as opposed to any other information regarding any [*42] of the other amenities that appeal to only subsets of Elks travelers, may "display [the] minimal level of creativity" required by the Supreme Court in *Feist, 499 U.S. at 358-59*. However, this decision--to include RV information in a guide for general Elks travelers--was not copied by Leonard. Instead, Leonard has published a series of guides specifically for Elks RV travelers. Leonard's "Elk RV Travel Guides" do not include entries for Elks lodges without RV facilities, instead listing these lodges only in an abbreviated appendix. Thus, although Carmichael Elks may have displayed a modicum of creativity in determining that a general audience of Elks would appreciate RV information, Leonard did not appropriate this creative judgment, because he instead published guides specific to RV travel. Accordingly, there is not a material question regarding the substantial similarity with respect to this selection of RV information in general.

Although there is no similarity regarding this general decision, Leonard did copy the selection of particular categories of RV information for inclusion--RV parking availability, fees, hookups for electricity, water and dumping, and existence of an RV club. [*43] Carmichael Elks argue that the selection of these specific categories is subject to copyright protection. Although the creativity or judgment involved in selection of these categories is hardly overwhelming, Carmichael Elks have demonstrated that other travel guides including RV information do not all include these categories of information, and that other guides often include other categories not found in the Elkdom Travel guides. Accordingly, while selection of these categories may not be entitled to significant protection, they exceed the low threshold adopted by *Feist* and illustrated by the above-cited cases. Moreover, all of the Elk RV Travel Guides include these

exact categories of RV travel information, such that a jury could find that substantial similarity exists with regard to this protectable element. Accordingly, Leonard's motion for summary judgment as to Carmichael Elks' claim must be denied on this ground.

ii. Arrangement of Information

The decisions to group the entries by state, to arrange states alphabetically, and to arrange cities within each state alphabetically are all obvious and under the cases ineligible for copyright protection.¹⁴ The arrangement of information [*44] within each entry (in the 1988 Guides, within each "tile") is, under the cases, equally uncreative. Some aspects of this intra-entry arrangement, such as the arrangement of information regarding electricity, water, and dumping RV hookups, are arbitrary, and do not reflect the exercise of creative judgment. *Key Publ'ns, 945 F.2d at 513*. To the extent that the arrangement does reflect judgment, the arrangement is obvious, such as the choice to list the name of the city first, or to list whether there is RV parking before listing whether there are hookups for RVs. Accordingly, neither the arrangement of entries within the guides nor the arrangement of information within each entry is copyrightable. The court wishes to be clear that this conclusion has no bearing on its separate conclusion that selection of this information for inclusion is potentially subject to copyright.

14 Carmichael Elks argue that the decision to arrange the lodges alphabetically by city, rather than in order of lodge number, demonstrates creativity. Even if the court were to accept that contention that the numerical organization was viable, the range of available options is too small for the selection of an alphabetical [*45] arrangement to be protectable.

The court does not address whether the graphical layout of the guides--in "landscape" format or in a square of tiles--represents a copyrightable arrangement, because Leonard did not copy these elements.

iii. Notes

Carmichael Elks have also demonstrated a question of material fact as to whether Leonard's Elk RV Travel Guides I and II have infringed upon the notes included in Elkdom Travel Guides I and II. Carmichael Elks identify notes for seven Colorado cities for which Elk RV Travel Guide II includes a note that is either similar to, or a verbatim copy of, the note included in the Elkdom Travel Guide II. These notes identify the nearest major cross streets, provide added information about the location of the lodge, and/or identify alternative RV parking and available RV facilities. Pl.'s Mem. Opp. Mot. Summ. J., 21:18 - 22:4. Carmichael Elks contend that these exam-

ples drawn from Colorado listings are representative of the similarities in all states included in Guides I and II. Leonard does not challenge the representativeness of these examples, instead arguing that these notes are not protectable.

At least some of these notes reflect creative judgment. [*46] Notes of this type are provided only for some lodges. The decision as to when to include a note of this type involved the "minimal level of creativity" required by Feist, such that these notes are protectable. 499 U.S. at 358-59. For example, although this court must conclude that inclusion of certain information about the lodges themselves is obvious, the identification of information about alternative RV facilities is not.

Nor can the court conclude that the selection of facts included in Leonard's Elk RV Travel Guides I and II is as a matter of law dissimilar under the extrinsic test. Because of Leonard's access to the guides, only a low degree of proof of similarity is needed. *Swirsky*, 376 F.3d at 844. Thus, a trier of fact may conclude that Leonard's selection is similar because it includes many of the same notes, despite the fact that Leonard also added and omitted some notes.

3. Summary of Carmichael Elks' Claim

For the reasons stated above, the court grants Leonard's motion for summary judgment as to Carmichael Elks' claim for infringement insofar as the claim is based on infringement of the originally registered editions of Elkdom Travel Guides I and II. Carmichael Elks's selection [*47] of which types of RV information to include was a creative judgment that is eligible for copyright protection. Material questions of fact exist as to whether all of Leonard's Elks RV Travel Guides are substantially similar to the Carmichael Elks' Elkdom Travel Guides I and II in this regard under the extrinsic test, such that both extrinsic and intrinsic similarity must be decided by the trier of fact. Separately, the court concludes that at least some notes included in Elkdom Travel Guides I and II are eligible for protection, and that triable questions exist as to whether Leonard's Elks RV Travel Guides I and II are substantially similar in this regard.

B. Leonard's Counterclaim

Leonard also moves for summary judgment on his counterclaim for infringement of the copyrights he registered in 2007. Leonard argues that Carmichael Elks copied notes and maps he created; Leonard does not claim any protected interest in the selection of general categories of information or in the arrangement of his guides. Despite the narrowness of this counterclaim, the counterclaim raises similar issues of the registrations' validity, protectability of Leonard's work, and infringe-

ment. Carmichael Elks also [*48] argue that Leonard worked under a work-for-hire arrangement, such that ownership of any copyrightable work created by Leonard initially vested in the Lodge, and not Leonard. The court does not address these issues, because Carmichael Elks have demonstrated a triable question as to whether Leonard is equitably estopped from bringing this claim. Therefore, Leonard's motion for summary judgment as to this claim must be denied.

Equitable estoppel is available as a defense to copyright infringement actions. *Hampton v. Paramount Pictures Corp.*, 279 F.2d 100 (9th Cir. 1960), *Pamfiloff v. Giant Records, Inc.*, 794 F. Supp. 933, 937 (N.D. Cal. 1992), 4-13 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 13.07 (2008). This form of estoppel is a defense in which plaintiff's past conduct bars the plaintiff from asserting certain rights. Although a party may be equitably estopped from bringing a suit for copyright infringement, either for past or future uses of the protected work, estoppel cannot effect a transfer of "ownership of the copyright which originally vested in the works' authors." *Pamfiloff*, 794 F. Supp. at 937.

In a copyright infringement action, four elements are necessary to [*49] establish estoppel: "(1) The party to be estopped must know the facts; (2) he must intend that his conduct shall be acted on or must so act that the party asserting the estoppel has a right to believe it is so intended; (3) the latter must be ignorant of the true facts; and (4) he must rely on the former's conduct to his injury." *Hampton*, 279 F.2d 100, 104 (9th Cir. 1960); accord *United States v. King Features Entertainment Inc.*, 843 F.2d 394, 399 (9th Cir. 1988). This test, so formulated, does not differ from the more general approach to estoppel in this circuit. Tellingly, *King Features* cited *Bob's Big Boy Family Rests. v. N.L.R.B.*, 625 F.2d 850, 854 (9th Cir. 1980), a non-copyright case, as authority for the elements of estoppel in a copyright infringement action. *King Features*, 843 F.2d at 399.

In this case, Leonard argues that the Carmichael Elks' use of Leonard's works prior to March 31, 2007 was permissive, and that Leonard's conduct during this time could not estop Leonard from revoking such permission and then enforcing his copyright through an infringement action arising out of the Elk's use of Leonard's material after March 31, 2007. Leonard bases this argument on Professor [*50] Nimmer's phrasing of the elements of estoppel in an infringement action, and in particular, Nimmer's phrasing of the first element. Citing *Hampton*, 279 F.2d 100, Nimmer states that the first element is that "the plaintiff must know the facts of the defendant's infringing conduct." 4-13 *Nimmer on Copyright* § 13.07 (emphasis added). Leonard argues that because there was no infringing conduct prior to Leonard's revocation of permission, Leonard's conduct prior to this

time cannot satisfy the first element of the estoppel test.¹⁵

15 More fully, Leonard argues that "anything Leonard did prior to January 19, 2007 [the date on which Leonard sent a letter revoking permission to use his works] is irrelevant because there was no infringement prior to that date. Without such infringement, subsequent acquiescence to the infringement, the infringer's ignorance of the infringement claim, and reliance on the copyright owner's acquiescence, there can be no estoppel." Def.'s Reply, 14.

Contrary to Leonard's argument, courts that have considered the issue have held that a copyright owner's conduct during a period of permissive use may estoppel the owner from later revoking permission and bringing an infringement [*51] claim. *Carson v. Dynegey, Inc.*, 344 F.3d 446, 453 (5th Cir. 2003), *DeCarlo v. Archie Comic Publ'ns, Inc.*, 127 F. Supp. 2d 497, 509 (S.D.N.Y. 2001), *Quinn v. City of Detroit*, 23 F. Supp. 2d 741, 753 (E.D. Mich. 1998). Leonard's reading of Nimmer is belied by the fact that Nimmer cites these cases for this proposition. For example, Nimmer explains *Carson* as a case where an "employee who previously consented to his company's exploitation of the subject work . . . [was] estopped to complain post-termination about the company's continued usage of his work." 4-13 *Nimmer on Copyright* § 13.07. Alternatively, to the extent that Nimmer's statement that the owner must have had knowledge of "the infringing conduct" does compel Leonard's conclusion that infringement must predate the conduct giving rise to estoppel, Nimmer is at variance with the Ninth Circuit test for estoppel in infringement actions. *King Features*, 843 F.2d at 399, *Hampton*, 279 F.2d at 104. Neither *King Features* nor *Hampton* used Nimmer's language, nor did either case discuss such a requirement. Instead, *King Features* demonstrated that the normal test for estoppel applies by citing *Bob's Big Boy Family Restaurants*, which considered [*52] an estoppel argument raised in the context of a labor dispute. *King Features*, 843 F.2d at 399.

Having rejected the rule proposed by Leonard, the court turns to the application of the ordinary estoppel factors. Because the Ninth Circuit has not considered analogous facts, the court bases this analysis on *Carson*, *DeCarlo* and *Quinn*, each of which applied an estoppel framework consistent with the Ninth Circuit's decisions in *King Features* and *Hampton*.

In *Carson*, the plaintiff had created a copyrightable spreadsheet while employed by defendant. 344 F.3d at 448. This spreadsheet was authored and owned by plaintiff. Plaintiff had encouraged other defendant's employees to use the spreadsheet. *Id.* at 449. Plaintiff was

later fired for unrelated reasons. *Id.* at 450. When the defendant continued to use the spreadsheet, plaintiff brought a claim for copyright infringement. *Id.* When defendant moved for summary judgment on the ground that plaintiff was estopped from bringing this claim, plaintiff argued that defendant could not satisfy the first, third, and fourth elements of the test for estoppel. *Id.* at 453 (quoting the Nimmer formulation of the elements of estoppel).

The Fifth Circuit affirmed the [*53] grant of summary judgment, concluding that all of the elements of estoppel were satisfied. The first element was satisfied by plaintiff's knowledge of defendant's use of the spreadsheet. *Id.* at 455. The Fifth Circuit specifically rejected the argument that the plaintiff must have had knowledge of infringing use of the spreadsheet, instead holding that knowledge of non-infringing use during the period of employment was sufficient. *Id.* at 455 n.9 (citing *Basic Books, Inc. v. Kinko's Graphics Corp.*, 758 F. Supp. 1522, 1540 (S.D.N.Y. 1991)). Although the court stated that the second element was not in dispute, the court's analysis implied that defendant's reliance on plaintiff's conduct was reasonable in part because of the "clear relationship" between the parties. *Id.* at 455 n.9 (distinguishing *Steinberg v. Columbia Pictures Indus., Inc.*, 663 F. Supp. 706, 715-16 (S.D.N.Y. 1987)). The third element was satisfied because defendant was ignorant of the fact that plaintiff, rather than defendant, owned the spreadsheet. *Id.* at 453-54. "[Plaintiff] encouraged the adaptation, modification, and preparation of a derivative program for other [Defendant's] employees to use. [Plaintiff], . . . admitted [*54] that he never explicitly told anyone that the worksheet could not be modified or used unless he was present and he never appeared to correct the impression among some of [Defendant's] employees that [the spreadsheet] was a team-created program." *Id.* at 453. Although the Fifth Circuit discussed plaintiff's encouragement of the creation of derivative works as part of the third element, this fact also speaks to the second and fourth elements. *Id.* Finally, the court held that the fourth element could be satisfied by defendant's reliance on plaintiff's conduct during the course of plaintiff's employment, even though the alleged infringement only occurred after the employment ended. *Id.* at 455.

The opinion in *Carson* drew heavily from an Eastern District of Michigan opinion, *Quinn v. City of Detroit*, 23 F. Supp. 2d 741 (E.D. Mich. 1998). *Quinn* also concerned a plaintiff who had prepared a program while employed by defendant, who consented to the employer's use of the program while the plaintiff was employed, and who later revoked this consent upon his termination and claimed that the defendant's continuing use of the program was infringing. *Id.* at 743-44. After a bench trial,

the court concluded [*55] that plaintiff was estopped from bringing this claim. The four estoppel factors were satisfied because plaintiff had known of the defendant's use of the program, plaintiff had consented to such use, and the defendant had detrimentally relied upon this consent by abandoning the prior program. *Id.* at 753, see also *Carson*, 344 F.3d at 454 (discussing Quinn). The court did not separately address the defendant's ignorance of the facts. As explained in *Carson*, Quinn therefore held that a plaintiff's conduct prior to the alleged infringement may estop a plaintiff from bringing an infringement claim.

The Southern District of New York reached a similar result in *DeCarlo v. Archie Comic Publ'ns, Inc.*, 127 F. Supp. 2d 497 (S.D.N.Y. 2001). Plaintiff DeCarlo was a comic book artist who had drawn strips published by defendant. *Id.* at 499. Plaintiff claimed that he owned the rights to a comic book character, and that defendant had been granted only a limited license. *Id.* at 501. However, defendant had for years used the character in ways exceeding the license plaintiff claimed to have granted, plaintiff knew of this use, and plaintiff had not objected. *Id.* Plaintiff then brought an infringement [*56] claim when defendant attempted to use the character in a motion picture. *Id.* at 502. The court granted summary judgment to defendant on the ground of equitable estoppel. First, "[p]laintiff indisputably knew that [defendant] conducted itself as if it owned the rights that [plaintiff] now claims belong to him." *Id.* at 509. Second, because of plaintiff's relationship with defendant, plaintiff's silence and inaction in the face of defendant's repeated use justified reliance on plaintiff's conduct. *Id.* at 510. "[I]t is immaterial to a claim of estoppel that there was no actual attempt to defraud or mislead." *Id.* (quoting *CBS, Inc. v. Stokely-Van Camp, Inc.*, 522 F.2d 369 (2d Cir. 1975)). Third, defendant believed that it possessed the disputed rights to the character, and was ignorant of the fact that plaintiff claimed such rights. *Id.* at 511. Fourth, defendant relied on plaintiff's conduct by entering a movie production deal and agreeing to indemnify the other party from copyright infringement claims prior to plaintiff's assertion of ownership. Because defendant had repeatedly asserted ownership over the work, and plaintiff failed "ever to voice a complaint or make a competing claim in [*57] the face of numerous opportunities to do so," defendant had "the right to rely on [plaintiff's] silence." *Id.* at 511.

In this case, the evidence permits a trier of fact¹⁶ to conclude that the first three estoppel elements, as interpreted by these cases, are satisfied. The first is satisfied because Leonard both knew of Carmichael Elks' use of the guides, *Carson*, 344 F.3d at 451; *Quinn*, 23 F. Supp. 2d at 753, and of Carmichael Elks' belief that they owned the copyright to them, *DeCarlo*, 127 F. Supp. 2d at 509.

The second element is satisfied by Leonard's affixation a copyright notice stating that the Carmichael Elks owned the work, Leonard's implicit consent to the Elks' use of the work, Leonard's longstanding relationship with the Carmichael Elks, and his knowledge of the Elks' belief regarding copyright. *Carson*, 344 F.3d at 455 n.9, *DeCarlo*, 127 F. Supp. 2d at 510. Third, for years, Carmichael Elks were ignorant of Leonard's claim to ownership in the guides. *Carson*, 344 at 453-54, *DeCarlo*, 127 F. Supp. 2d at 511.

16 For purposes of this motion, the court need not resolve whether the trier of fact for these questions will be the jury or the court. However, to inform the parties' future [*58] briefing, the court notes that because estoppel is an equitable defense, "except for any issues which may be common to . . . legal claims, [an] equitable estoppel defense presents issues to be resolved by the court." *Granite States Ins. Co. v. Smart Modular Techs.*, 76 F.3d 1023, 1026-28 (9th Cir. 1996). When legal claims tried to a jury raise factual questions that overlap with the estoppel questions, "the legal claims involved in the action must be determined prior to any final court determination of the equitable claims." *Id.* at 1027 (internal quotations and modification omitted). In this order, the court does not decide whether such common issues exist.

As to the fourth element, the evidence would enable a trier of fact to conclude that during this period of ignorance, Carmichael Elks reasonably relied upon Leonard's consent to use the copyrighted notes, as Carmichael Elks passed information received from Elks lodges and members on to Leonard to incorporate, rather than incorporating this information themselves. A trier of fact could conclude that this reliance was detrimental insofar as it prevented the Carmichael Elks from incorporating these notes into a work actually owned by [*59] the Lodge. This form of detriment is analogous to the abandonment of a prior software system in *Quinn*, 23 F. Supp. 2d at 753. Carmichael Elks has a similar, although weaker, claim to detrimental reliance on Leonard's maps. Because Leonard incorporated these maps into the Elksdom Travel Guides, Carmichael Elks will suffer expense if they are required to remove these maps from the hundreds of pages in the current publications. Such expense will accrue even if the Carmichael Elks merely replace Leonard's maps with the former handwritten ones. Because Leonard had repeatedly caused these notes and maps to be published under the Carmichael Elks' copyright notice, the court cannot conclude as a matter of law that Carmichael Elks did not reasonably and detrimentally rely on Leonard's conduct.

Therefore, a trier of fact could conclude that Leonard's conduct prior to his 2007 assertion of ownership of the copyright in the 2006 editions of the Elksdom Travel Guides estopps Leonard from bringing an infringement action against the Carmichael Elks regarding their use of these guides. Estoppel applies not only to the Carmichael Elks' prior use of these guides, but also prospectively. Accordingly, Leonard's [*60] motion for summary judgment as to this claim must be denied.

IV. CONCLUSION

For the reasons stated above, defendant and counter-claimant Leonard's motion for summary judgment, Doc. No. 38, is DENIED, both as to plaintiff's claim and as to defendant's counterclaim. Pursuant to *Fed. R. Civ. P. 56(d)(1)*, the court GRANTS partial summary adjudi-

cation to defendant Leonard as to plaintiff's infringement claim, concluding that this claim may proceed solely insofar as it alleges infringement based on copying of the selection of particular categories of RV information and of notes included in the registered versions of Elksdom Travel Guides I and II.

IT IS SO ORDERED.

DATED: September 15, 2009.

/s/ Lawrence K Karlton

LAWRENCE K. KARLTON

SENIOR JUDGE

UNITED STATES DISTRICT COURT