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UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF CALIFORNIA

CARMICHAEL LODGE NO. 2103,
BENEVOLENT AND PROTECTIVE
ORDER OF ELKS OF THE UNITED
STATES OF AMERICA, a
California corporation,

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

Plaintiff,

v.

O R D E R

RONALD L. LEONARD dba RV TRAVEL
GUIDES, a California company,
and DOES 1 through 50,
inclusive,

Defendants.

_____ /

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

1 counterclaims, including a claim that the Carmichael Elks is
2 infringing on copyrights owned by Leonard for portions of the same
3 guides. Pending before the court is Leonard's motion for summary
4 adjudication as to these two cross copyright infringement claims.
5 Carmichael Elks have not filed a cross motion as to either claim.

6 **I. BACKGROUND¹**

7 Carmichael Elks is a California corporation and the local
8 chapter of a national fraternal organization, the Benevolent and
9 Protective Order of Elks of the United States of America.
10 Defendant and counterclaimant Ron Leonard is an individual
11 presently residing in Carmichael, California. Leonard was a member
12 of the Carmichael Elks from 1998 until July 11, 2008. Although
13 Leonard's departure from the Carmichael Elks appears to be based
14 on the circumstances underlying the instant copyright infringement
15 claims, the facts of his departure do not influence the present
16 motion.

17 **A. The Elkdom Travel Guides**

18 The parties' dispute concerns a series of travel guides. In
19 or about 1984, two members of the Carmichael Elks, Ira and Barbara
20 David, began creating a series of "Elkdom Travel Guides." These
21 guides contain information about Elks lodges, accompanied by some
22

23 ¹ Leonard has lodged objections to several items of evidence
24 relied on by Carmichael Elks. Some of this evidence is not
25 necessary to the resolution of the instant motion--including the
26 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.

1 maps, directions, and notes regarding points of interest. While the
2 guides include RV travel information, they include all Elks lodges
3 regardless of whether RV facilities are available. Carmichel Elks
4 claims a protected interest in Elkdom Travel Guides I through III.

5 In 1988, Carmichel Elks obtained copyright registrations for
6 Elkdom Travel Guides I and II, Registration Nos. TX-2-522-753 and
7 TX-2-522-754. "Elkdom Travel Guide I" was originally published in
8 1984, and contains information regarding seven Pacific Coast
9 states. "Elkdom Travel Guide II" was initially published in 1986,
10 and pertains to eleven states east of those encompassed by Guide
11 I and west of the Mississippi River.² The 1988 copyright
12 registrations indicate that Ira and Barbara David authored these
13 guides, but that the Davids assigned ownership of the copyrights
14 to the Carmichael Elks.

15 Elkdom Travel Guide III, pertaining to nine southeastern
16 states, was not included with these initial copyright
17 registrations. Instead, Guide III was first published in or about
18 1991. Carmichael Elks did not seek to register a copyright for
19 this guide until 2007, after the facts underlying this dispute had
20 already arisen.

21 Guides I through III follow the same format. Prior to
22 Leonard's involvement in the guides, the guides were oriented in
23 a landscape or horizontal format, with the Elks logo and the badge

24
25 ² This guide encompasses Montana, North Dakota, South Dakota,
26 Wyoming, Nebraska, Utah, Colorado, Kansas, Oklahoma, New Mexico and
Texas. The parties curiously label this grouping of states as
"Midwestern."

1 for the Carmichael Elks on the cover. The guides were divided into
2 a section for each state, arranged alphabetically. Each section
3 provided information for cities that had an Elks lodge,
4 alphabetized by city name. The pages were divided in half
5 vertically and horizontally, generating four "tiles," with
6 information for each city presented in a single tile. This
7 information included the Elk's lodge number, phone number, address,
8 meeting times, dinner hours, and bar hours. Each tile also
9 explained whether the lodge featured RV parking, applicable parking
10 fees if any, the availability of water, electric, and dumping
11 hookups, and whether the lodge had an RV club. Finally, each tile
12 included a section which could contain directions, miscellaneous
13 information, or a small map. Miscellaneous information included
14 notations regarding lodge events such as bingo nights, regular
15 menus (e.g., "Fish & Chicken Fri night"), and whether the lodge,
16 instead of being a dedicated building, was another facility used
17 for meetings (e.g., "Lodge meets at Vally Nat'l Bank Building on
18 Coronado Blvd."). Maps, if included, were simplified, including
19 only major highways and streets, represented by straight lines of
20 uniform thickness, and noting the location of the lodge.

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

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

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

24 During this time, Forrest Wright continued to manage the
25 printing and distribution of the guides. Mr. Wright also conveyed
26 information from lodges and Elks travelers to Leonard to be

1 included in the guide. On at least one issue, Mr. Wright exercised
2 control over the content of the guides. Leonard suggested
3 abbreviating the information regarding lodges that did not provide
4 parking for RVs, a change that would make the guides more RV-
5 centric, but Wright rejected this suggestion.³ Wright Dep., 41:9 -
6 43:7. Other than the various Elks members who submitted the
7 information that was included in the guides, no other individuals
8 were directly involved in the production of the content for Guides
9 I through III.

10 Leonard did not receive monetary compensation aside from
11 reimbursement of printing expenses. Leonard never executed any
12 written agreement regarding ownership of his contributions to the
13 guides. Leonard updated the guides in this manner until April of
14 2007.

15 **C. Elkdom Travel Guide IV**

16 Separate from the above three guides, in or about June 1996,
17 Carmichael Elks granted Gulf Coast Lodge No. 2782, located in Gulf
18 Shores, Alabama, the right to publish Elkdom Travel Guides covering
19 specified Northeastern States. Compl. ¶¶ 15-16. The Gulf Coast
20 Lodge published Elkdom Travel Guide IV, covering these states,
21 until October 13, 2005. At that time, the Gulf Coast Lodge entered
22 an agreement with Carmichael Elks wherein the Gulf Coast Lodge
23 returned the right to publish Elkdom Travel Guide IV to Carmichael
24 Elks in exchange for an agreement to pay royalties to the Gulf

25
26 ³ As noted below, Leonard would later implement this change
in the guides he published separately.

1 Coast Lodge. Despite this development, Carmichael Elks has not
2 published the fourth guide. In May of 2006, Leonard entered into
3 a separate arrangement with the Alabama lodge to publish Elkdom
4 Travel Guide IV without the involvement of Carmichael Elks.

5 **D. Leonard's Claim to Copyright in the Guides**

6 The Elkdom Travel Guides published from 2000 to 2006 bore a
7 notice stating that the copyright for the guides was owned by
8 Carmichael Elks. At some point in 2006, Leonard replaced this
9 notice with one stating that the copyright was owned by RV Travel
10 Guides, e.g., "Copyright © 2000, 2001, 2002, 2003, 2004, 2005,
11 2006; RV Travel Guides, Sacramento, CA." R. Leonard Decl. Ex. A
12 (May 12, 2006, deposit copy of Elkdom Travel Guide I). This change
13 did not occur uniformly. For example, the "deposit copy" of Elkdom
14 Travel Guide I submitted in connection with Leonard's copyright
15 registration includes the above internal statement, and the cover
16 of this guide also indicates that the copyright is owned by RV
17 Travel Guides. R. Leonard Decl. Ex. A. However, in the November
18 28, 2006 printing of Elkdom Travel Guide I, the cover states "©
19 BPOE Lodge 2103, Carmichael, CA" while the first page includes the
20 RV Travel Guides copyright statement. See Deposition of Ronald
21 Leonard, 97:8-98:4.

22 On January 9, 2007, Leonard applied to register copyrights for
23 the May 12, April 16, March 6, and October 1 2006 editions Elkdom
24 Travel Guides I through IV, respectively. Registration Nos. TX
25 6-585-010, TX 6-585-011, TX 6-585-012, TX 6-585-013 Compl. Ex. D-G.
26 Leonard used a "short form" application provided by the Copyright

1 Office. This form required that he specify the "year of creation"
2 for the subject work. On each form, Leonard answered "2000,"
3 although Leonard now declares that this was in error, such that the
4 works were created in the years he provided as their initial
5 publication. Leonard indicated that he was the sole author of each
6 work and owner of each copyright. The short form did not inquire
7 as to whether there were any prior registrations of the subject
8 works.

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

16
17 ⁴ Carmichael Elks state in their opposition memo that on March
18 2, 2007, Alden Almquist, a copyright examiner, sent a letter
19 explaining the following:

20 We are delaying registration because this work
21 contains preexisting material, and the Short
22 Form application your [sic] used does not have
23 space to distinguish old and new material.
24 When a new work contains material that has
25 been either previously registered or
26 published, or that is in the public domain,
the copyright claim must be limited to the new
copyrightable authorship that has been added.
In 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

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

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

13 R. Leonard Decl. Ex. E.

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

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

22 **E. Subsequent Sale of the Guides**

23 On or about April 2007, Leonard began to sell the guides
24 independently, under the title "Elk RV Travel Guides." In

25 _____
26 the public domain.

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

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

1 preparing these guides, Leonard also added latitude, longitude and
2 elevation information for each lodge, removed the Elks logo from
3 the cover, revised and added some notes, and revised the format of
4 the guides to list lodges that do not offer RV parking at the end
5 of each section in an abbreviated form. R. Leonard Decl. Ex. F-H.

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

16 **II. STANDARD FOR A MOTION FOR SUMMARY JUDGMENT**

17 Summary judgment is appropriate when it is demonstrated that
18 there exists no genuine issue as to any material fact, and that the
19 moving party is entitled to judgment as a matter of law. Fed. R.
20 Civ. P. 56(c); Adickes v. S.H. Kress & Co., 398 U.S. 144, 157
21 (1970); Poller v. Columbia Broadcast System, 368 U.S. 464, 467
22 (1962); Jung v. FMC Corp., 755 F.2d 708, 710 (9th Cir. 1985); Loehr
23 v. Ventura County Community College Dist., 743 F.2d 1310, 1313 (9th
24 Cir. 1984).

25 Under summary judgment practice, the moving party

26 ////

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

9 Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986). "[W]here the
10 nonmoving party will bear the burden of proof at trial on a
11 dispositive issue, a summary judgment motion may properly be made
12 in reliance solely on the 'pleadings, depositions, answers to
13 interrogatories, and admissions on file.'" Id. Indeed, summary
14 judgment should be entered, after adequate time for discovery and
15 upon motion, against a party who fails to make a showing sufficient
16 to establish the existence of an element essential to that party's
17 case, and on which that party will bear the burden of proof at
18 trial. Id. at 322. "[A] complete failure of proof concerning an
19 essential element of the nonmoving party's case necessarily renders
20 all other facts immaterial." Id. In such a circumstance, summary
21 judgment should be granted, "so long as whatever is before the
22 district court demonstrates that the standard for entry of summary
23 judgment, as set forth in Rule 56(c), is satisfied." Id. at 323.

24 If the moving party meets its initial responsibility, the
25 burden then shifts to the opposing party to establish that a
26 genuine issue as to any material fact actually does exist.
Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574,
586 (1986); First Nat'l Bank of Arizona v. Cities Serv. Co., 391
U.S. 253, 288-89 (1968); Ruffin v. County of Los Angeles, 607 F.2d

1 1276, 1280 (9th Cir. 1979), cert. denied, 455 U.S. 951 (1980).

2 In attempting to establish the existence of this factual
3 dispute, the opposing party may not rely upon the denials of its
4 pleadings, but is required to tender evidence of specific facts in
5 the form of affidavits, and/or admissible discovery material, in
6 support of its contention that the dispute exists. Rule 56(e);
7 Matsushita, 475 U.S. at 586 n.11; First Nat'l Bank, 391 U.S. at
8 289; Strong v. France, 474 F.2d 747, 749 (9th Cir. 1973). The
9 opposing party must demonstrate that the fact in contention is
10 material, i.e., a fact that might affect the outcome of the suit
11 under the governing law, Anderson v. Liberty Lobby, Inc., 477 U.S.
12 242, 248 (1986); T.W. Elec. Serv., Inc. v. Pacific Elec.
13 Contractors Ass'n, 809 F.2d 626, 630 (9th Cir. 1987), and that the
14 dispute is genuine, i.e., the evidence is such that a reasonable
15 jury could return a verdict for the nonmoving party, Anderson, 242
16 U.S. 248-49; Wool v. Tandem Computers, Inc., 818 F.2d 1433, 1436
17 (9th Cir. 1987).

18 In the endeavor to establish the existence of a factual
19 dispute, the opposing party need not establish a material issue of
20 fact conclusively in its favor. It is sufficient that "the claimed
21 factual dispute be shown to require a jury or judge to resolve the
22 parties' differing versions of the truth at trial." First Nat'l
23 Bank, 391 U.S. at 290; T.W. Elec. Serv., 809 F.2d at 631. Thus,
24 the "purpose of summary judgment is to 'pierce the pleadings and
25 to assess the proof in order to see whether there is a genuine need
26 for trial.'" Matsushita, 475 U.S. at 587 (quoting Fed. R. Civ. P.

1 56(e) advisory committee's note on 1963 amendments); International
2 Union of Bricklayers v. Martin Jaska, Inc., 752 F.2d 1401, 1405
3 (9th Cir. 1985).

4 In resolving the summary judgment motion, the court examines
5 the pleadings, depositions, answers to interrogatories, and
6 admissions on file, together with the affidavits, if any. Rule
7 56(c); Poller, 368 U.S. at 468; SEC v. Seaboard Corp., 677 F.2d
8 1301, 1305-06 (9th Cir. 1982). The evidence of the opposing party
9 is to be believed, Anderson, 477 U.S. at 255, and all reasonable
10 inferences that may be drawn from the facts placed before the court
11 must be drawn in favor of the opposing party, Matsushita, 475 U.S.
12 at 587 (citing United States v. Diebold, Inc., 369 U.S. 654, 655
13 (1962) (per curiam)); Abramson v. Univ. of Haw., 594 F.2d 202, 208
14 (9th Cir. 1979). Nevertheless, inferences are not drawn out of the
15 air, and it is the opposing party's obligation to produce a factual
16 predicate from which the inference may be drawn. Richards v.
17 Nielsen Freight Lines, 602 F. Supp. 1224, 1244-45 (E.D. Cal. 1985),
18 aff'd, 810 F.2d 898, 902 (9th Cir. 1987).

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

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1
2 **III. ANALYSIS**

3 **A. Plaintiff Carmichael Elks' Claim**

4 Carmichael Elks claims that Leonard's publication of the
5 "Leonard Guides" infringes on copyrights held by the Lodge. The
6 basic elements of a claim for copyright infringement are (1)
7 ownership of a valid copyright in a work and (2) copying of
8 protected elements from that work. Feist Publ'ns, Inc. v. Rural
9 Tel. Serv. Co., 499 U.S. 340, 361 (1991); Cavalier v. Random
10 House, Inc., 297 F.3d 815, 822 (9th Cir. 2002). In addition,
11 registration of the copyright, while "not a prerequisite to a valid
12 copyright, . . . is a prerequisite to suit." S.O.S., Inc. v.
13 Payday, Inc., 886 F.2d 1081, 1085 (9th Cir. 1989) (citing 17 U.S.C.
14 §§ 408(a), 411).⁵ Therefore, to succeed on a claim for
15 infringement, a plaintiff must show (1) that the plaintiff is the
16 owner of the subject copyright, (2) that the copyright has been
17 registered, and (3) that the defendant has infringed on protected
18 elements of the copyrighted work.

19 In this case, the court begins with the second step, looking
20 to whether the assertedly infringed-upon work has been registered.
21 In subpart III(A)(1) below, the court concludes that Carmichael
22 Elks' only valid registrations are those pertaining to the 1988
23 editions of Elksdom Travel Guides I and II. Because Carmichael Elks
24 is the undisputed owner of the copyrights in these works,
25 discussion of ownership is unnecessary. Accordingly, in subpart

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

1 III(A) (2), the court turns to which elements, if any, of these
2 works are both eligible for copyright protection and have been
3 impermissibly copied by Leonard's guides.⁶

4 **1. Carmichael Elks' Registrations of Copyrights**

5 **a. The 1988 Registrations of Guides I and II**

6 Carmichael Elks registered Elkdom Travel Guides I and II in
7 1988, and did not register any subsequent editions of these guides.
8 Leonard does not dispute the validity of the 1988 registrations.

9 Carmichael Elks argue that the 1988 registrations effectively
10 registered subsequent editions of Guides I and II as well. This
11 argument does not lie. Registration of a work does not extend to
12 future works derived from the registered work.⁷ Well-Made Toy Mfg.

13
14 ⁶ Ninth Circuit cases have not always approached the problem
15 in this way. For example, some cases first look to whether the
16 work contains copyrightable elements in the abstract or in
17 discussion of the first step (ownership of a copyright), only then
18 turning to whether copyrightable elements have been infringed upon.
19 See, e.g., Ets-Hokin v. Skyy Spirits, 225 F.3d 1068, 1076 (9th Cir.
20 2000). Other cases have discussed protectability largely as part
21 of the infringement analysis. See, e.g., Cavalier, 297 F.3d at
22 822; see also Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S.
23 340, 361 (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
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.

24 ⁷ A derivative work is one that "would be considered an
25 infringing work if the material which it has derived from a
preexisting work had been taken without the consent of a copyright
26 proprietor of such preexisting work." Mirage Editions, Inc. v.
Albuquerque A.R.T. Co., 856 F.2d 1341, 1343 (9th Cir. 1988)

1 Corp. v. Goffa Int'l Corp., 354 F.3d 112, 115 (2d Cir. 2003).
2 Accordingly, when a plaintiff registers one work, creates a
3 derivative of that work, and then claims that a third work created
4 by another person infringes on the derivative, the requirement of
5 registration as a prerequisite to suit may not be satisfied. Id.
6 In such a situation, an infringement action will succeed only if
7 the third work copied from the unregistered derivative elements
8 that were also present in the registered original. In such a case,
9 the plaintiff effectively brings a claim for infringement of the
10 original. See, e.g., Montgomery v. Noga, 168 F.3d 1282, 1292-93
11 (11th Cir. 1999); see also Russell v. Price, 612 F.2d 1123, 1128
12 (9th Cir. 1979) (“[t]he established doctrine prevents unauthorized
13 copying or other infringing use of the underlying work or any part
14 of that work contained in the derivative product so long as the
15 underlying work itself remains copyrighted.”), Dalton-Ross Homes,
16 Inc. v. Williams, 2007 U.S. Dist. LEXIS 64135, *7 (D. Ariz. Aug.
17 29, 2007). Therefore, Carmichael Elks may base a claim for
18 infringement on the 1988 editions of Elkdom Travel Guides I and II,
19 but not on unregistered derivative works, including future editions

20 _____
21 (quoting 1 Nimmer on Copyright § 3.01 (1986)). See also 17 U.S.C.
22 § 101.

23 In a separate argument, Carmichael Elks assert that they “own
24 any contributions supplied by [Leonard] as derivative works.” This
25 is incorrect. As noted, a derivative work is one that includes
26 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).

1 of these guides.

2 **b. The 2007 Registration of Elkdom Travel Guide III**

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

7 17 U.S.C. section 409 provides the requirements for an
8 application for copyright registration. These requirements
9 include, inter alia, the names of the authors, an explanation as
10 to how the claimant came to own the copyright (if the claimant is
11 not the author), dates of prior publication of the work, and "in
12 the case of a compilation or derivative work, an identification of
13 any preexisting work or works that it is based on or incorporates,
14 and a brief, general statement of the additional material covered
15 by the copyright claim being registered." 17 U.S.C. §§ 409(2),
16 (5), (8), (9). The registration application form used by
17 Carmichael Elks also specifically inquires as to whether
18 "registration for this work, or for an earlier version of this
19 work, [has] already been made in the Copyright Office," and
20 requests details of any such prior registrations. "The knowing
21 failure to advise the Copyright Office of facts that might have
22 occasioned a rejection of the application constitutes reason for
23 holding the registration invalid and thus incapable of supporting
24 an infringement action, or to deny enforcement on the ground of
25 unclean hands." Fleming v. Miles, 181 F. Supp. 2d 1143, 1154 (D.
26 Or. 2001); see also Harris v. Emus Records Corp., 734 F.2d 1329,

1 1335 (9th Cir. 1984) ("inaccuracies in copyright registration,"
2 when prejudicial or intended to defraud, may bar an action for
3 infringement.)

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

12 The application submitted by Carmichael Elks identifies the
13 work to be copyrighted as the March 6, 2006 edition of Elkdom
14 Travel Guide III. Carmichael Elks identified Ira and Barbara David
15 as the authors of this 2006 edition of Elkdom Travel Guide III,
16 although the Davids had ceased contributing to the guides in 1992.
17 The application omitted any reference to Leonard as a possible
18 author. "As a general rule, the author is the party who actually
19 creates the work, that is, the person who translates an idea into
20 a fixed, tangible expression entitled to copyright protection."
21 Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730, 737 (1989)
22 (citing 17 U.S.C. § 102). In a similar omission, the application
23 notes the 1988 registrations of Elkdom Travel Guides I and II, but
24 does not refer to Leonard's application for registration and
25 registration of the guides. If none of the work authored by
26 Leonard was of a kind entitled to protection, and if Leonard's

1 prior registration was invalid, then Carmichael Elks might have
2 been entitled to registration of this copyright. However, there
3 were serious questions as to the propriety of the Carmichael Elks'
4 registration attempt. The undisputed evidence establishes that at
5 the time of registration, Carmichael Elks was aware of these
6 disputes, and Carmichael Elks nonetheless failed to inform the
7 copyright office of these issues. Accordingly, as explained by
8 Fleming, Carmichael Elks' registration of Elkdom Travel Guide III
9 cannot support a claim for infringement. 181 F. Supp. 2d at 1154.
10 Any infringement claim brought by the Carmichael Elks must
11 therefore be based solely on the versions of Elkdom Travel Guides
12 I and II registered in 1988.

13 **2. Copying of Protected Elements**

14 Because ownership of the copyrights in Elkdom Travel Guides
15 I and II is undisputed, the remaining step in the infringement
16 analysis is whether "defendant copied protected elements of the
17 work." Cavalier, 297 F.3d at 822. A plaintiff may prevail on this
18 step by showing "that the infringer had access to plaintiff's
19 copyrighted work and that the works at issue are substantially
20 similar in their protected elements." Id. Access and similarity
21 are on a sliding scale, such that when a defendant has greater
22 access, the Ninth Circuit accepts "a lower standard of proof of
23 substantial similarity." Swirsky v. Carey, 376 F.3d 841, 844 (9th
24 Cir. 2004). However, while a strong showing of access may offset
25 a weak showing of similarity, the standard for protectability is
26 constant. Thus, even where direct, verbatim copying has occurred,

1 there is no infringement unless the copied elements are the type
2 protected by copyright. Feist, 499 U.S. at 364, Matthew Bender,
3 158 F.3d at 689.

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

24 Under the extrinsic test, "A court must take care to inquire
25 only whether the *protectible elements, standing alone*, are
26 substantially similar. Therefore, when applying the extrinsic

1 test, a court must filter out and disregard the non-protectible
2 elements in making its substantial similarity determination.”
3 Cavalier, 297 F.3d at 822 (emphasis in original). The court
4 reviews the scope of copyright protection before turning to the
5 application of the extrinsic similarity test to this case.

6 **a. Scope of Copyright Protection**

7 Copyright does not protect bare “ideas” or “facts.” Cavalier,
8 297 F.3d at 823 (citing Berkic v. Crichton, 761 F.2d 1289, 1293-94
9 (9th Cir. 1985)); see also 17 U.S.C. § 102(b). Although “[i]t may
10 seem unfair” that certain elements may be copied with impunity,
11 “this is not ‘some unforeseen byproduct of a statutory scheme.’”
12 Feist, 499 U.S. at 349 (quoting Harper & Row, Publr. v. Nation
13 Enters., 471 U.S. 539, 589 (1985) (dissenting opinion)). The
14 constitution provides the power “to promote the Progress of Science
15 and useful Arts,” Art. I, § 8, cl. 8, and Congress has determined
16 that the law best serves this purpose when it “encourages others
17 to build freely upon the ideas and information conveyed by a work.”
18 Feist, 499 U.S. at 350. Although neither facts nor ideas are
19 copyrightable, copyright protects particular expressions of ideas
20 and creativity in the compilation of facts, as explained in the
21 following two sections. 17 U.S.C. § 103(b); Feist, 499 U.S. at
22 344, CDN Inc. v. Kapes, 197 F.3d 1256, 1259 (9th Cir. 1999).

23 **i. The Idea/Expression Distinction**

24 The expression of an idea, but not the idea itself, may be
25 eligible for copyright protection. Cavalier, 297 F.3d at 823
26 (citing 17 U.S.C. § 102(b)). This limit applies to preclude

1 copyright protection of an "idea" regardless of whether the idea
2 is original or the product of creativity. Although the distinction
3 between an idea and an expression thereof is imprecise, numerous
4 Ninth Circuit cases illustrate the distinction's application. For
5 example, in discussing claims by Apple Computer that Microsoft
6 infringed on Apple's copyrights for design of computer interfaces,
7 the Ninth Circuit held that many elements of the interface were
8 ideas not subject to copyright protection, including "the idea of
9 a graphical user interface, or the idea of a desktop metaphor" for
10 such an interface, "use of windows to display multiple images on
11 the computer screen and to facilitate user interaction with the
12 information contained in the windows; iconic representation of
13 familiar objects from the office environment; manipulation of icons
14 to convey instructions and to control operation of the computer;
15 use of menus to store information or computer functions in a place
16 that is convenient to reach, but saves screen space for other
17 images; and opening and closing of objects as a means of
18 retrieving, transferring and storing information." Apple Computer,
19 35 F.3d at 1443-44. In a later case concerning a guide to coin
20 prices, the Ninth Circuit explained that an author cannot protect

21 [the] idea of creating a wholesale price
22 guide, but [the author] can use the copyright
23 laws to protect its idea of what those prices
24 are. Drawing this line preserves the balance
25 between competition and protection: it allows
26 [the author's] competitors to create their own
price guides and thus furthers competition,
but protects [the author's] creation, thus
giving it an incentive to create such a guide.

1 CDN Inc. v. Kapes, 197 F.3d 1256, 1262 (9th Cir. 1999).⁸ In a
2 third illustration of the idea/expression distinction, concerning
3 a claim for infringement of a copyright in a television show
4 demonstrating magic tricks, the Ninth Circuit explained that “while
5 similarities in tangible expressive elements . . . are pertinent
6 to our analysis, the mere fact that both The Mystery Magician and
7 the Specials reveal the secrets behind magic tricks does not by
8 itself constitute infringement.” Rice v. Fox Broad. Co., 330 F.3d
9 1170, 1175 (9th Cir. 2003). See also Satava v. Lowry, 323 F.3d
10 805, 811 (9th Cir. 2003) (“no copyright protection may be afforded
11 to the idea of producing a glass-in-glass jellyfish sculpture or
12 to elements of expression that naturally follow from the idea of
13 such a sculpture.”).

14 **ii. Factual Compilations**

15 Roughly similar to the way in which an idea may not be
16 copyrighted but its expression may be, facts may not be
17 copyrighted, but their creative and original selection or
18 arrangement in a factual compilation may be. “A ‘compilation’ is
19 a work formed by the collection and assembling of preexisting
20 materials or of data that are selected, coordinated, or arranged
21

22 ⁸ The CDN court’s conclusion that the prices themselves were
23 copyrightable has little bearing on this case. The court concluded
24 that the prices included in the guide were “estimates” that could
25 not be formulaically calculated, and that each individual price was
26 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.

1 in such a way that the resulting work as a whole constitutes an
2 original work of authorship." 17 U.S.C. § 101. To be eligible for
3 protection, this selection or arrangement must be made
4 independently by the compiler and entail a minimum degree of
5 creativity. Feist, 499 U.S. at 361. Creativity and originality
6 are the sole issues; whether discovery or collection of facts
7 "takes much time and effort is wholly irrelevant to whether the .
8 . . work is copyrightable." CDN, 197 F.3d at 1260 (citing Feist,
9 499 U.S. at 349). "Copyright rewards originality, not effort."
10 Feist, 499 U.S. at 364.⁹ The Supreme Court has explained that:

11 the originality requirement is not
12 particularly stringent. . . . Originality
13 requires only that the author make the
14 selection or arrangement independently (i.e.,
15 without copying that selection or arrangement
16 from another work), and that it display some
17 minimal level of creativity. Presumably, the
18 vast majority of compilations will pass this
19 test, but not all will. There remains a
20 narrow category of works in which the creative
21 spark is utterly lacking or so trivial as to
22 be virtually nonexistent.

18 Feist, 499 U.S. at 358-59. A majority of courts treat the question
19 of whether given facts demonstrate the requisite creativity as a
20 question of law, although this court is not aware of a Ninth
21 Circuit or the Supreme Court decision directly speaking to the
22 issue. See Mid Am. Title Co. v. Kirk, 59 F.3d 719, 722 (7th Cir.

24 ⁹ However, not all originality is rewarded or protected by the
25 copyright system. As explained above, ideas are not protected,
26 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).

1 1995), BellSouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g,
2 999 F.2d 1436, 1444 (11th Cir. 1993); but see Matthew Bender & Co.
3 v. West Publ'g Co., 158 F.3d 674, 681 (2d Cir. 1998) ("the question
4 of whether particular elements of a work demonstrate sufficient
5 originality and creativity to warrant copyright protection [is] a
6 question for the factfinder.").¹⁰ I adopt the majority approach
7 here.

8 For the selection or arrangement of facts to be creative, the
9 author must make "non-obvious choices from among more than a few
10 options." Matthew Bender & Co. v. West Publ'g Co., 158 F.3d 674,
11 683 (2d Cir. 1998). External factors may eliminate options, and
12 demonstrate that a choice among the remaining options was not
13 creative. Id., Mid Am. Title Co. v. Kirk, 59 F.3d 719, 722 (7th
14 Cir. 1995). In this circumstance, a subsequent publisher may take
15 the work of the compiler.

16 In Mid Am. Title Co., the plaintiff claimed infringement of
17 a compilation of selected land title data. 59 F.3d at 721. The
18 Seventh Circuit held that the selection of this data was "a matter

19
20 ¹⁰ Outside the factual compilation context, the Ninth Circuit
21 has held that "Issues involving the availability and extent of
22 copyright protection . . . present mixed questions of law and
23 fact." Harper House, Inc. v. Thomas Nelson, Inc., 889 F.2d 197,
24 201 (9th Cir. 1989). In CDN, the Ninth Circuit cited Harper
25 House, but CDN did not explain whether the Feist question of
26 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 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.

1 of convention and strict industry standards." Id. at 722. All
2 individuals preparing a similar document "ultimately would have
3 selected the same facts to include." Id. In particular, because
4 external forces required that the plaintiff "list all facts which
5 affect marketable title, there was no room for creativity in
6 determining which liens or which encumbrances to include in the
7 title commitment." Id. at 723.

8 In Matthew Bender, the Second Circuit considered the selection
9 and arrangement of information in publication of federal court
10 opinions. 158 F.3d at 683. Plaintiffs sought a declaratory
11 judgment that certain elements of West Publishing Company's
12 formatting of Court of Appeals and Supreme Court opinions were not
13 eligible for copyright protection. The Second Circuit held that
14 the selection and arrangement of certain information was so limited
15 by external factors that no creativity was involved. As to the
16 parties' names, the deciding court, and the dates of argument and
17 decision, the selection of these facts for inclusion was compelled
18 by these facts' importance, and selection was not a function of
19 West's creativity. Id. at 683. As to the arrangement of
20 information regarding subsequent appellate history before the same
21 court--amendments, rehearings, opinions related to rehearing en
22 banc--the court held that there would almost never be more than
23 "one or two realistic or useful options" as to how to arrange this
24 information, and that the choice among these options would be
25 dictated by the form of the later decision and its timing relative
26 to the printing of the reporter. Id. at 685. Similarly, "the

1 standard of the legal profession" determined the use of parallel
2 or alternative citations, leaving no room for the exercise of
3 creativity. Id.

4 Even when multiple options for selection or arrangement are
5 available, the choice from among those options must be non-obvious
6 in order to be protectable. In Feist, the Supreme Court held that
7 the selection of information published in a phone book--a person's
8 name, town, and telephone number--"could not be more obvious." 499
9 U.S. at 362.¹¹ The alphabetical listing of names was equally
10 obvious and therefore uncopyrightable. Id. at 363. In a similar
11 case, the Eleventh Circuit concluded that the arrangement of
12 listings in a yellow pages directory under categories such as
13 "attorneys" and "banks," or the division of "churches by
14 denomination or attorneys by area of specialty," was obvious for
15 purposes of Feist. BellSouth Adver. & Publ'g Corp. v. Donnelley
16 Info. Publ'g, 999 F.2d 1436, 1444 (11th Cir. 1993).

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

24
25 ¹¹ Although common practice is to include addresses in phone
26 directories, it is not as clear to this court as 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.

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

18 In another opinion concluding that the selection of facts for
19 inclusion in a compilation was creative, the Second Circuit
20 considered selection of baseball pitching statistics. Kregos v.
21

22 ¹² However, under Ninth Circuit precedent, the decision to
23 create a Chinese-American business directory is an idea that is not
24 copyrightable. Rice, 330 F.3d at 1175. If, once this decision is
25 made, external factors dictate the inclusion of a category for
26 "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.

1 Associated Press, 937 F.2d 700 (2d Cir. 1991). The compilation
2 used nine statistics for each player. Id. at 702. This particular
3 combination had not been previously used, and one of these
4 statistics had not be used in any prior compilation. Id. at 703.
5 The defendant had moved for summary judgment on the ground that
6 this selection was not copyrightable. Id. The Second Circuit
7 upheld the district court's denial of defendant's motion. Where
8 "there are at least scores of available statistics about pitching
9 performance available . . . and therefore thousands of combinations
10 of data that a selector can choose It cannot be said as a
11 matter of law that in selecting the nine items . . . [plaintiff]
12 has failed to display enough selectivity to satisfy the requirement
13 of originality." Id. at 704.

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

16 In this case, Carmichael Elks argue that the 1988 editions of
17 Elkdom Travel Guides I and II demonstrate the requisite creativity
18 in selection and arrangement of the information to be included, as
19 well as in the notes accompanying some entries, and that Leonard
20 has infringed upon these elements.¹³ The court considers these
21

22 ¹³ Carmichael Elks also argue that the maps included in the
23 original guides are eligible for copyright protection. Leonard
24 does not dispute this, and instead argues that there is no
25 similarity between the protectable elements of the Carmichael Elks
26 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.

1 choices separately.

2 **i. Selection of Categories of Information**

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

10 Carmichael Elks therefore may not use copyright law to prevent
11 others from publishing such a similar guide--now that Carmichael
12 Elks have come up with the idea, copyright law encourages others
13 to build upon it. Feist, 499 U.S. at 350. Thus, the Carmichael
14 Elks cannot protect the selection of information that would be
15 necessary or obvious in any travel guide for Elks. See, e.g.,
16 Matthew Bender, 158 F.3d at 683, 685. For this reason, the guides'
17 inclusion of the following information for each lodge is not
18 protectable: city name, lodge number, phone number and address.
19 Inclusion of meeting times, dining room hours, and bar hours was
20 also obvious in light of the guide's purpose. The submitted
21 evidence indicates that the needs of the guides' intended readers
22 compelled the inclusion of meeting times, dining room hours, and
23 bar hours, and Carmichael Elks, who bears the burden of proof on
24 this issue at trial, has not submitted any evidence supporting a
25 contrary conclusion. Matthew Bender, 158 F.3d at 685. Selection
26 of this information is therefore obvious (if not necessary) and

1 non-creative.

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

23 Although there is no similarity regarding this general
24 decision, Leonard did copy the selection of particular categories
25 of RV information for inclusion--RV parking availability, fees,
26 hookups for electricity, water and dumping, and existence of an RV

1 club. Carmichael Elks argue that the selection of these specific
2 categories is subject to copyright protection. Although the
3 creativity or judgment involved in selection of these categories
4 is hardly overwhelming, Carmichael Elks have demonstrated that
5 other travel guides including RV information do not all include
6 these categories of information, and that other guides often
7 include other categories not found in the Elkdom Travel guides.
8 Accordingly, while selection of these categories may not be
9 entitled to significant protection, they exceed the low threshold
10 adopted by Feist and illustrated by the above-cited cases.
11 Moreover, all of the Elk RV Travel Guides include these exact
12 categories of RV travel information, such that a jury could find
13 that substantial similarity exists with regard to this protectable
14 element. Accordingly, Leonard's motion for summary judgment as to
15 Carmichael Elks' claim must be denied on this ground.

16 **ii. Arrangement of Information**

17 The decisions to group the entries by state, to arrange states
18 alphabetically, and to arrange cities within each state
19 alphabetically are all obvious and under the cases ineligible for
20 copyright protection.¹⁴ The arrangement of information within each
21 entry (in the 1988 Guides, within each "tile") is, under the cases,
22 equally uncreative. Some aspects of this intra-entry arrangement,

23
24 ¹⁴ Carmichael Elks argue that the decision to arrange the
25 lodges alphabetically by city, rather than in order of lodge
26 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 arrangement to be protectable.

1 such as the arrangement of information regarding electricity,
2 water, and dumping RV hookups, are arbitrary, and do not reflect
3 the exercise of creative judgment. Key Publ'ns, 945 F.2d at 513.
4 To the extent that the arrangement does reflect judgment, the
5 arrangement is obvious, such as the choice to list the name of the
6 city first, or to list whether there is RV parking before listing
7 whether there are hookups for RVs. Accordingly, neither the
8 arrangement of entries within the guides nor the arrangement of
9 information within each entry is copyrightable. The court wishes
10 to be clear that this conclusion has no bearing on its separate
11 conclusion that selection of this information for inclusion is
12 potentially subject to copyright.

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

17 **iii. Notes**

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

1 Opp. Mot. Summ. J., 21:18 - 22:4. Carmichael Elks contend that
2 these examples drawn from Colorado listings are representative of
3 the similarities in all states included in Guides I and II.
4 Leonard does not challenge the representativeness of these
5 examples, instead arguing that the these notes are not protectable.

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

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

22 **3. Summary of Carmichael Elks' Claim**

23 For the reasons stated above, the court grants Leonard's
24 motion for summary judgment as to Carmichael Elks claim for
25 infringement insofar as the claim is based on infringement of the
26 originally registered editions of Elksdom Travel Guides I and II.

1 Carmichael Elks's selection of which types of RV information to
2 include was a creative judgment that is eligible for copyright
3 protection. Material questions of fact exist as to whether all of
4 Leonard's Elks RV Travel Guides are substantially similar to the
5 Carmichael Elks' Elkdom Travel Guides I and II in this regard under
6 the extrinsic test, such that both extrinsic and intrinsic
7 similarity must be decided by the trier of fact. Separately, the
8 court concludes that at least some notes included in Elkdom Travel
9 Guides I and II are eligible for protection, and that triable
10 questions exist as to whether Leonard's Elks RV Travel Guides I and
11 II are substantially similar in this regard.

12 **B. Leonard's Counterclaim**

13 Leonard also moves for summary judgment on his counterclaim
14 for infringement of the copyrights he registered in 2007. Leonard
15 argues that Carmichael Elks copied notes and maps he created;
16 Leonard does not claim any protected interest in the selection of
17 general categories of information or in the arrangement of his
18 guides. Despite the narrowness of this counterclaim, the
19 counterclaim raises similar issues of the registrations' validity,
20 protectability of Leonard's work, and infringement. Carmichael
21 Elks also argue that Leonard worked under a work-for-hire
22 arrangement, such that ownership of any copyrightable work created
23 by Leonard initially vested in the Lodge, and not Leonard. The
24 court does not address these issues, because Carmichael Elks have
25 demonstrated a triable question as to whether Leonard is equitably
26 estopped from bringing this claim. Therefore, Leonard's motion for

1 summary judgment as to this claim must be denied.

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

13 In a copyright infringement action, four elements are
14 necessary to establish estoppel: "(1) The party to be estopped must
15 know the facts; (2) he must intend that his conduct shall be acted
16 on or must so act that the party asserting the estoppel has a right
17 to believe it is so intended; (3) the latter must be ignorant of
18 the true facts; and (4) he must rely on the former's conduct to his
19 injury." Hampton, 279 F.2d 100, 104 (9th Cir. 1960); accord United
20 States v. King Features Entertainment Inc., 843 F.2d 394, 399 (9th
21 Cir. 1988). This test, so formulated, does not differ from the
22 more general approach to estoppel in this circuit. Tellingly, King
23 Features cited Bob's Big Boy Family Rests. v. N.L.R.B., 625 F.2d
24 850, 854 (9th Cir. 1980), a non-copyright case, as authority for
25 the elements of estoppel in a copyright infringement action. King
26 Features, 843 F.2d at 399.

1 In this case, Leonard argues that the Carmichael Elks' use of
2 Leonard's works prior to March 31, 2007 was permissive, and that
3 Leonard's conduct during this time could not estopp Leonard from
4 revoking such permission and then enforcing his copyright through
5 an infringement action arising out of the Elk's use of Leonard's
6 material after March 31, 2007. Leonard bases this argument on
7 Professor Nimmer's phrasing of the elements of estoppel in an
8 infringement action, and in particular, Nimmer's phrasing of the
9 first element. Citing Hampton, 279 F.2d 100, Nimmer states that
10 the first element is that "the plaintiff must know the facts of *the*
11 *defendant's infringing conduct.*" 4-13 Nimmer on Copyright § 13.07
12 (emphasis added). Leonard argues that because there was no
13 infringing conduct prior to Leonard's revocation of permission,
14 Leonard's conduct prior to this time cannot satisfy the first
15 element of the estoppel test.¹⁵

16 Contrary to Leonard's argument, courts that have considered
17 the issue have held that a copyright owner's conduct during a
18 period of permissive use may estopp the owner from later revoking
19 permission and bringing an infringement claim. Carson v. Dynegy,
20 Inc., 344 F.3d 446, 453 (5th Cir. 2003), DeCarlo v. Archie Comic
21 Publ'ns, Inc., 127 F. Supp. 2d 497, 509 (S.D.N.Y. 2001), Quinn v.
22

23 ¹⁵ More fully, Leonard argues that "anything Leonard did prior
24 to January 19, 2007 [the date on which Leonard sent a letter
25 revoking permission to use his works] is irrelevant because there
26 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.

1 City of Detroit, 23 F. Supp. 2d 741, 753 (E.D. Mich. 1998).
2 Leonard's reading of Nimmer is belied by the fact that Nimmer cites
3 these cases for this proposition. For example, Nimmer explains
4 Carson as a case where an "employee who previously consented to his
5 company's exploitation of the subject work [was] estopped
6 to complain post-termination about the company's continued usage
7 of his work." 4-13 Nimmer on Copyright § 13.07. Alternatively,
8 to the extent that Nimmer's statement that the owner must have had
9 knowledge of "the infringing conduct" does compel Leonard's
10 conclusion that infringement must predate the conduct giving rise
11 to estoppel, Nimmer is at variance with the Ninth Circuit test for
12 estoppel in infringement actions. King Features, 843 F.2d at 399,
13 Hampton, 279 F.2d at 104. Neither King Features nor Hampton used
14 Nimmer's language, nor did either case discuss such a requirement.
15 Instead, King Features demonstrated that the normal test for
16 estoppel applies by citing Bob's Big Boy Family Restaurants, which
17 considered an estoppel argument raised in the context of a labor
18 dispute. King Features, 843 F.2d at 399.

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

25 In Carson, the plaintiff had created a copyrightable
26 spreadsheet while employed by defendant. 344 F.3d at 448. This

1 spreadsheet was authored and owned by plaintiff. Plaintiff had
2 encouraged other defendant's employees to use the spreadsheet. Id.
3 at 499. Plaintiff was later fired for unrelated reasons. Id. at
4 450. When the defendant continued to use the spreadsheet,
5 plaintiff brought a claim for copyright infringement. Id. When
6 defendant moved for summary judgment on the ground that plaintiff
7 was estopped from bringing this claim, plaintiff argued that
8 defendant could not satisfy the first, third, and fourth elements
9 of the test for estoppel. Id. at 453 (quoting the Nimmer
10 formulation of the elements of estoppel).

11 The Fifth Circuit affirmed the grant of summary judgment,
12 concluding that all of the elements of estoppel were satisfied.
13 The first element was satisfied by plaintiff's knowledge of
14 defendant's use of the spreadsheet. Id. at 455. The Fifth Circuit
15 specifically rejected the argument that the plaintiff must have had
16 knowledge of infringing use of the spreadsheet, instead holding
17 that knowledge of non-infringing use during the period of
18 employment was sufficient. Id. at 455 n.9 (citing Basic Books,
19 Inc. v. Kinko's Graphics Corp., 758 F. Supp. 1522, 1540 (S.D.N.Y.
20 1991)). Although the court stated that the second element was not
21 in dispute, the court's analysis implied that defendant's reliance
22 on plaintiff's conduct was reasonable in part because of the "clear
23 relationship" between the parties. Id. at 455 n.9 (distinguishing
24 Steinberg v. Columbia Pictures Indus., Inc., 663 F. Supp. 706,
25 715-16 (S.D.N.Y. 1987)). The third element was satisfied because
26 defendant was ignorant of the fact that plaintiff, rather than

1 defendant, owned the spreadsheet. Id. at 453-54. "[Plaintiff]
2 encouraged the adaptation, modification, and preparation of a
3 derivative program for other [Defendant's] employees to use.
4 [Plaintiff], . . . admitted that he never explicitly told anyone
5 that the worksheet could not be modified or used unless he was
6 present and he never appeared to correct the impression among some
7 of [Defendant's] employees that [the spreadsheet] was a
8 team-created program." Id. at 453. Although the Fifth Circuit
9 discussed plaintiff's encouragement of the creation of derivative
10 works as part of the third element, this fact also speaks to the
11 second and fourth elements. Id. Finally, the court held that the
12 fourth element could be satisfied by defendant's reliance on
13 plaintiff's conduct during the course of plaintiff's employment,
14 even though the alleged infringement only occurred after the
15 employment ended. Id. at 455.

16 The opinion in Carson drew heavily from an Eastern District
17 of Michigan opinion, Quinn v. City of Detroit, 23 F. Supp. 2d 741
18 (E.D. Mich. 1998). Quinn also concerned a plaintiff who had
19 prepared a program while employed by defendant, who consented to
20 the employer's use of the program while the plaintiff was employed,
21 and who later revoked this consent upon his termination and claimed
22 that the defendant's continuing use of the program was infringing.
23 Id. at 743-44. After a bench trial, the court concluded that
24 plaintiff was estopped from bringing this claim. The four estoppel
25 factors were satisfied because plaintiff had known of the
26 defendant's use of the program, plaintiff had consented to such

1 use, and the defendant had detrimentally relied upon this consent
2 by abandoning the prior program. Id. at 753, see also Carson, 344
3 F.3d at 454 (discussing Quinn). The court did not separately
4 address the defendant's ignorance of the facts. As explained in
5 Carson, Quinn therefore held that a plaintiff's conduct prior to
6 the alleged infringement may estopp a plaintiff from bringing an
7 infringement claim.

8 The Sourthern District of New York reached a similar result
9 in DeCarlo v. Archie Comic Publ'ns, Inc., 127 F. Supp. 2d 497
10 (S.D.N.Y. 2001). Plaintiff DeCarlo was a comic book artist who had
11 drawn strips published by defendant. Id. at 499. Plaintiff
12 claimed that he owned the rights to a comic book character, and
13 that defendant had been granted only a limited license. Id. at
14 501. However, defendant had for years used the character in ways
15 exceeding the license plaintiff claimed to have granted, plaintiff
16 knew of this use, and plaintiff had not objected. Id. Plaintiff
17 then brought an infringement claim when defendant attempted to use
18 the character in a motion picture. Id. at 502. The court granted
19 summary judgment to defendant on the ground of equitable estoppel.
20 First, "[plaintiff] indisputably knew that [defendant] conducted
21 itself as if it owned the rights that [plaintiff] now claims belong
22 to him." Id. at 509. Second, because of plaintiff's relationship
23 with defendant, plaintiff's silence and inaction in the face of
24 defendant's repeated use justified reliance on plaintiff's conduct.
25 Id. at 510. "[I]t is immaterial to a claim of estoppel that there
26 was no actual attempt to defraud or mislead." Id. (quoting CBS,

1 Inc. v. Stokely-Van Camp, Inc., 522 F.2d 369 (2d Cir. 1975)).
2 Third, defendant believed that it possessed the disputed rights to
3 the character, and was ignorant of the fact that plaintiff claimed
4 such rights. Id. at 511. Fourth, defendant relied on plaintiff's
5 conduct by entering a movie production deal and agreeing to
6 indemnify the other party from copyright infringement claims prior
7 to plaintiff's assertion of ownership. Because defendant had
8 repeatedly asserted ownership over the work, and plaintiff failed
9 "ever to voice a complaint or make a competing claim in the face
10 of numerous opportunities to do so," defendant had "the right to
11 rely on [plaintiff's] silence." Id. at 511.

12 In this case, the evidence permits a trier of fact¹⁶ to
13 conclude that the first three estoppel elements, as interpreted by
14 these cases, are satisfied. The first is satisfied because Leonard
15 both knew of Carmichael Elks' use of the guides, Carson, 344 F.3d
16 at 451; Quinn, 23 F. Supp. 2d at 753, and of Carmichael Elks'
17 belief that they owned the copyright to them, DeCarlo, 127 F. Supp.
18 2d at 509. The second element is satisfied by Leonard's affixation
19

20 ¹⁶ For purposes of this motion, the court need not resolve
21 whether the trier of fact for these questions will be the jury or
22 the court. However, to inform the parties' future briefing, the
23 court notes that because estoppel is an equitable defense, "except
24 for any issues which may be common to . . . legal claims, [an]
25 equitable estoppel defense presents issues to be resolved by the
26 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.

1 a copyright notice stating that the Carmichael Elks owned the work,
2 Leonard's implicit consent to the Elks' use of the work, Leonard's
3 longstanding relationship with the Carmichael Elks, and his
4 knowledge of the Elks' belief regarding copyright. Carson, 344
5 F.3d at 455 n.9, DeCarlo, 127 F. Supp. 2d at 510. Third, for
6 years, Carmichael Elks were ignorant of Leonard's claim to
7 ownership in the guides. Carson, 344 at 453-54, DeCarlo, 127 F.
8 Supp. 2d at 511.

9 As to the fourth element, the evidence would enable a trier
10 of fact to conclude that during this period of ignorance,
11 Carmichael Elks reasonably relied upon Leonard's consent to use the
12 copyrighted notes, as Carmichael Elks passed information received
13 from Elks lodges and members on to Leonard to incorporate, rather
14 than incorporating this information themselves. A trier of fact
15 could conclude that this reliance was detrimental insofar as it
16 prevented the Carmichael Elks from incorporating these notes into
17 a work actually owned by the Lodge. This form of detriment is
18 analogous to the abandonment of a prior software system in Quinn,
19 23 F. Supp. 2d at 755. Carmichael Elks has a similar, although
20 weaker, claim to detrimental reliance on Leonard's maps. Because
21 Leonard incorporated these maps into the Elkdom Travel Guides,
22 Carmichael Elks will suffer expense if they are required to remove
23 these maps from the hundreds of pages in the current publications.
24 Such expense will accrue even if the Carmichael Elks merely replace
25 Leonard's maps with the former handwritten ones. Because Leonard
26 had repeatedly caused these notes and maps to be published under

1 the Carmichael Elks' copyright notice, the court cannot conclude
2 as a matter of law that Carmichael Elks did not reasonably and
3 detrimentally rely on Leonard's conduct.

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

12 **IV. CONCLUSION**

13 For the reasons stated above, defendant and counter-claimant
14 Leonard's motion for summary judgment, Doc. No. 38, is DENIED, both
15 as to plaintiff's claim and as to defendant's counterclaim.
16 Pursuant to Fed. R. Civ. P. 56(d)(1), the court GRANTS partial
17 summary adjudication to defendant Leonard as to plaintiff's
18 infringement claim, concluding that this claim may proceed solely
19 insofar as it alleges infringement based on copying of the
20 selection of particular categories of RV information and of notes
21 included in the registered versions of Elkdom Travel Guides I and
22 II.

23 IT IS SO ORDERED.

24 DATED: September 15, 2009.

25 
26 LAWRENCE K. KARLTON
SENIOR JUDGE
UNITED STATES DISTRICT COURT