



auspices of LNC Education Associates (“LNC”), presented a seminar on legal nurse consulting in Bucks County, Pennsylvania. Osley and McHugh repeated the seminar in September, 1995 in Fairfax, Virginia. Defendant Janice Ouimette assisted them in preparing course materials and planning the Fairfax seminar, although she did not attend. As a result of poor attendance at the Fairfax seminar, the defendants canceled the remainder of their scheduled seminars and LNC subsequently ceased doing business thereafter.

In December, 1995, plaintiff filed the present complaint against the defendants, alleging violation of its copyright in its course materials, pursuant to the Copyright Act of 1976, as amended, 17 U.S.C. §§ 101 - 1101. Plaintiff seeks an injunction to prevent defendants from further alleged infringement, as well as statutory damages and attorney’s fees, as provided for under the Act. Presently, plaintiffs have moved for summary judgment, and one of the defendants has cross-moved for summary judgment as to her.

## **Discussion**

### **I Standard for Summary Judgment**

Summary judgment is properly granted to the moving party if the “pleadings, depositions, answers to interrogatories, and admissions on file, together with affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.” Fed.R.Civ.P. 56(c). A dispute regarding a material fact is genuine “if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.”

Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248, 106 S. Ct. 2505, 2510 (1986). The evidence

must be viewed in the light most favorable to the nonmoving party. Lang v. New York Life Ins. Co., 721 F.2d 118, 119 (3d Cir. 1983). The moving party has the initial burden of demonstrating that no genuine issue of material fact exists. See Celotex Corp. v. Catrett, 477 U.S. 317, 323, 106 S. Ct. 2548, 2553 (1986). Once the moving party has satisfied this requirement, the burden shifts to the nonmoving party to present evidence that discloses a genuine issue for trial. Id. at 324, 106 S. Ct. at 2553; Fed.R.Civ.P. 56(e). Additionally, the substantive law controlling the case will determine those facts that are material for the purposes of summary judgment. Anderson, 477 U.S. at 248, 106 S. Ct. at 2510.

## **II Plaintiff's Motion for Summary Judgment**

Copyright infringement is established if the plaintiff proves that it owned the copyrighted material and that the copyrighted material was copied by the defendant. Ford Motor Company v. Summit Motor Products, Inc., 930 F.2d 277, 290 (3d Cir.), cert. denied, 502 U.S. 939 (1991). Furthermore, though facts themselves are not copyrightable, compilations of facts do fall within the protection of the Copyright Act. Feist Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340, 344-45, 111 S. Ct. 1282, 1287 (1991). Others may copy the underlying facts from the compilation, but not the selection, coordination, or arrangement used to present them. Id. at 348, 111 S. Ct. at 1289. Within a compilation, "copyright protection may extend only to those components of a work that are original to the author." Id. In Feist Publications, the Court held that a telephone directory containing only alphabetized basic information about a town's residents, failed to meet the constitutional minimum for copyright protection due to insufficient creativity in the selection or arrangement of the facts. Id.

at 362, 111 S. Ct. at 1296. Cf. Project Development Group, Inc. v. O.H. Materials Corp., 766 F. Supp. 1348 (W.D.Pa. 1991) (compilation of facts may possess requisite originality for copyright protection if author chooses which facts to include, in what order to place them, and how to arrange such facts). Thus, notwithstanding a valid copyright in the factual compilations, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as 1) the protected work contains some minimum creative spark in the selection, coordination, or arrangement of the pre-existing material, and 2) the competing work does not feature the same selection, coordination or arrangement of the facts. Feist Publications, 499 U.S. at 359-61, 111 S. Ct. 1295-96.

In the instant case, plaintiff argues that there is no genuine issue of fact as to plaintiff's ownership of the copyrights asserted in this action.<sup>2</sup> Plaintiff argues further that there is no genuine issue of fact regarding the defendants' access to the copyrighted works. Finally, plaintiff argues that there is no genuine issue of fact as to whether the defendants' allegedly infringing work is substantially similar to plaintiff's copyrighted material. Thus, plaintiff argues, summary judgment is appropriately entered in favor of plaintiff.

Defendants do not contest plaintiff's ownership of the copyrighted material, however, they argue that three of the eleven subject publications were copyrighted after

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<sup>2</sup> Certificates of registration issued by the U.S. Copyright Office constitute prima facie evidence of the validity and ownership of the material. Ford Motor Company, 930 F.2d at 290-91. In the instant case, plaintiff has established ownership by proffering such certificates of registration. (Pl.'s Mot. For Summ. J., Exs. "A-1 to A-11.")

the alleged infringement occurred. Defendants do not contest that they had access to the plaintiff's copyrighted materials. However, defendants argue that summary judgment is inappropriate because there is a genuine issue of fact as to whether the allegedly infringing material is "substantially similar" to the copyrighted materials owned by plaintiff.

Plaintiff proffers no direct evidence of copying by the defendants. However, because direct evidence of copying is rarely available, it may be inferentially proven by "showing that the defendant had access to the allegedly infringed work, ... that the allegedly infringing work is substantially similar to the copyrighted work," and that one of the rights guaranteed to copyright owners by the Copyright Act is implicated by the defendant's actions.<sup>3</sup> Ford Motor Company, 930 F.2d at 291 (quoting Whelan Associates v. Jaslow Dental Laboratory, 797 F.2d 1222, 1232 (3d Cir. 1986), cert. denied, 479 U.S. 1031 (1987)).

"Substantial similarity" may be determined through a two-prong test, both prongs of which must be met. Id. The first prong, known as the "extrinsic test," is "whether there is sufficient similarity between the two works in question to conclude that the alleged infringer used the copyrighted work in making his own." Id. (quoting Whelan Associates, 797 F.2d at 1232). "In making this determination, expert testimony and a

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<sup>3</sup> Section 106 of the Copyright Act states in relevant part:

[s]ubject to sections 107 through 118, the owner of copyright under this title has the exclusive rights to do and authorize any of the following: (1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending. . . .

17 U.S.C. § 106.

visual comparison between the copyrighted work and the allegedly infringing work are frequently utilized.” Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904, 907 (3d Cir. 1975). However, expert testimony is required only when the plaintiff seeks to establish that two works are strikingly similar, without first establishing direct proof of defendant’s access to the copyrighted work. Testa v. Janssen, 492 F.Supp. 198, 203 (W.D.Pa. 1980) (emphasis added). Such is not the case presently as defendants concede access to the copyrighted work.

The second prong of "substantial similarity," called the "intrinsic test," is whether, from a lay perspective, the copying was an unlawful appropriation of the copyrighted work. Whelan Associates, 797 F.2d at 1232; Universal Athletic Sales Co., 511 F.2d at 907. "Unlawful appropriation" has been defined as "a taking of the independent work of the copyright owner which is entitled to the statutory protection." Universal Athletic Sales Co., 511 F.2d at 908. The factors to be considered when determining if an appropriation occurred, include the reciprocal relationship between creativity and independent effort,<sup>4</sup> "the nature of the protected material, and the setting in which it appears." Id. "In short, copying is demonstrated when someone who has access to a copyrighted work uses material substantially similar to the copyrighted work in a manner which interferes with a right protected by 17 U.S.C. § 106." Ford Motor Company, 930 F.2d at 291.

Because both prongs of the test require scrutiny of the items, the determination

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<sup>4</sup> In other words, the greater the level of creativity and originality, the less the level of independent effort that need be shown. Or conversely, where independent effort is great, a lower level of creativity will be accepted. Universal Athletic Sales Co. v. Salkeld, 511 F.2d at 908.

of substantial similarity is exceedingly fact intensive. Fyk v. Roth, No. 94-cv-3826, 1995 WL 321803, at \*2 (E.D.Pa. May 25, 1995). Such a determination involves a side-by-side comparison of the protected and accused works with a view to several factors, including whether any similarities result from the fact that they both attempt to depict a common object, and the degree of originality, creativity and independent effort involved in the copyrighted work. Clarke v. G. A. Kayser & Sons, Inc., 472 F.Supp. 481, 482 (W.D.Pa. 1979). Moreover, where the quantum of originality is very modest, more than a substantial similarity is necessary for a finding of copyright infringement. Id. at 483.

In the instant case, the majority of plaintiff's subject works consist of compilations of facts, lists, and phrases of common usage related to the medical and legal professions. Thus, the Court initially notes that the plaintiff's subject works entail only modest amounts of originality and creativity, and therefore, more than a substantial similarity is necessary to establish copyright infringement. See Clarke, 472 F. Supp. at 483. With respect to such compilational works, "even absolute identity as to matters in the public domain will not suffice to prove infringement. What must be shown is substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation." Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc., 945 F.2d 509, 514 (2nd Cir. 1991). The element, in this case, that provides copyrightability is the originality of the selection, coordination, and arrangement of the facts and phrases used in the compilational materials.

Here, plaintiff relies primarily on a side-by-side comparison of their subject works

with the defendants' accused works. (Pl.'s Mot. For Summ. J., Ex. "E.") However, although some of the same terms are used in both works, plaintiff has failed to identify for the Court precisely which selections, coordinations or arrangements of facts and information in the subject compilations are actually original creations as opposed to being merely lists taken from the public domain or intact from other sources.

Furthermore, the majority of plaintiff's side-by-side comparison points to lists of phrases and terms which plaintiff claims were copied by the defendants. However, protection is denied to mere "fragmentary words and phrases." See CMM Cable Rep., Inc. v. Ocean Coast Properties, Inc., 97 F.3d 1504, 1519 (1st Cir. 1996). See also Perma Greetings, Inc. v. Russ Berrie & Co., Inc., 598 F.Supp. 445, 448 (E.D.Mo. 1984) ("Cliched language, phrases and expressions conveying an idea that is typically expressed in a limited number of stereotypic fashions, are not subject to copyright protection.").

Given the common availability of the majority of the contents of plaintiff's works, coupled with the fact that plaintiff has failed to differentiate between which elements are protected, and which are unprotected facts or material within the public domain, plaintiff has not established the absence of a genuine issue of fact as to whether the accused work and the copyrighted work are substantially similar. Accordingly, the issue of whether the protected and the accused works are "substantially similar" should be determined at trial, where the Court may assess the credibility of witnesses as to the sources of both the plaintiff's protected works and the defendants' accused works. Thus, summary judgment will be denied.

### **III Defendant Janice Ouimette's Summary Judgment Motion**

Defendant Ouimette seeks summary judgment in her favor. She argues that



there is no genuine issue as to her lack of personal involvement in the alleged copyright infringement. Plaintiff, in opposing defendant's motion, argues that there is a genuine issue as to Ouimette's personal involvement in the production of the accused works.

Defendants allege that Ouimette did not participate in the creation of the accused works, or participate in either the March or September, 1995 seminars. Nor does plaintiff have personal knowledge of Ouimette's involvement. (Mot. of Def. Janice Ouimette for Summ. J., Ex. "D" (Dep. of Vickie Milazzo).) However, at a conference in April or May, 1995, Ouimette admitted to plaintiff's general counsel that she was involved in developing course materials for LNC. (Defs.' Resp., Ex. "B" at 37-41.) Moreover, Ouimette permitted her name to appear on a LNC cover letter included with the accused works. Thus a genuine factual issue exists as to the extent of Ouimette's involvement in the development of the accused works. Accordingly, defendant Ouimette's Motion for Summary Judgment will be denied.

An appropriate Order follows.