

Evidence of Originality

Insufficient Evidence Of Originality Leads to Denial Of Relief

A recent decision of Tenth Circuit in *TransWestern Publishing Co. LP v. Multimedia Marketing Associates Inc.*, 1998 U.S. App. LEXIS 229 (10th Cir. 1998), demonstrates the importance of providing specific evidence of original contribution when seeking protection of a compilation.

TransWestern published a combined white and yellow pages telephone directory for Ponca City and nearby towns, including advertisements. Account executives solicited the advertisements, prepared ad layout sheets with customer input and created an arrangement of information that was "pleasing to the eye."

Multimedia published a Ponca City community directory, including a number of advertisements that were "very comparable" to those found in the TransWestern directory.

In the lower court, TransWestern obtained a preliminary injunction. At the permanent injunction hearing, however, the lower court granted Multimedia's motion for judgment as a matter of law.

The Court of Appeals began its review with a discussion of the protection available for compilations. Following *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), the court stated that the protection available for a compilation is "thin," since a compilation gains protection through "only minimal creativity in the selection and arrangement of facts." Accordingly, more similarity is required to show infringement. The court noted the comments of commentators and other courts

indicating that infringement of a compilations requires "supersubstantial similarity," "virtual identity," "extensive verbatim copying."

There were many differences between the works as a whole, so that no one would mistake the Multimedia directory for the TransWestern directory. The Court found the directories to be very different in appearance. Although they included similar information, the format, layout and content were different. Given the "thin" protection afforded compilations, the court concluded that it must affirm the district court's finding of no infringement regarding the compilations as a whole.

The court then considered infringement of the specific ads and focused on TransWestern's obligation to present evidence of creative contributions to the copied material. It was here that TransWestern failed to meet its burden of proof. At the permanent injunction hearing, TransWestern presented one witness, an account executive, and seven exhibits, including the registration certificate, the two directories, layout sheets for three advertisements, and a comparison of similar portions of the directories.

TransWestern's account executive testified that he worked with the customer to prepare the advertisements and created the ads show in the layout sheets. On cross, he claimed his contribution involved "certain logos." When pressed, he acknowledge that the logos were merely words in block print and went on to reveal minimal contributions at best.

Q. Apart from the names . . . did you contribute any other artwork to any of the ads?

A. Artwork meaning pictures, no. Artwork meaning making them pleasing to the eye, yes.

Q. That would be in the way it was typed, right, the size and style of the type?

A. Either that, yes, or just saying something to catch the eye.

Q. But pictures and logos, you wouldn't have anything to do with that, would you?

A. No, I did not draw pictures.

On redirect, he explained he took the information and artwork from the customer and "arranged and designed it into the ad."

The court was not impressed, dismissing the account executive's testimony "vague" and insufficient to allow determination of the plaintiff's original contribution to the advertisement. The court rejected the plaintiff's invitation to make its own comparison of the ads to determining infringement, stating:

"To find original and hence protectible contributions by plaintiff to its yellow page ads the court would have to credit the vague and general testimony of the witness that he 'arranged' information provided by his customers and 'designed' the ads - without himself providing any of the artwork - although he did not identify how his contribution was original in any particular ad allegedly copied by defendants. Thus, even if we were to accept plaintiff's request to compare the allegedly infringing ads for their similar order and placement of information and art work we cannot qualitatively analyze plaintiff's contribution."

The court went on in dicta to consider whether TransWestern copyright in the compilation was a whole would even afford protection in the advertisements. Treating

the directory as a collective work, the court relied on the advertising exclusion in Section 404(a) to conclude that the copyright in the collective work was not applicable to the individual advertisements. This analysis, however, was not necessary to the outcome, given lack of evidence on originality. The court affirmed the lower court's decision by holding that TransWestern "failed to present evidence of its original contributions to the advertisements in question." As a result, the ads were not protectible.

It is, of course, impossible to know from the decision whether the vague testimony of the account executive was the best that could be offered. Perhaps more particularity would have revealed an absence of original contribution. Nevertheless, the decision suggests some important lessons to litigators of compilation cases.

For the plaintiff, protection is not likely to be established merely by waving a copyright registration before the court in hope that someone will salute. When dealing with works that contain preexisting or otherwise unprotectible elements, it is a tactical mistake to concentrate solely on the similarity of the works to show infringement, no matter how striking that similarity may be. No infringement exists unless you succeed in proving that the similarities involve protectible expression. In other words, be prepared to show what original contributions you have made to the content, selection or arrangement of material in which you are claiming rights. Similarly, be prepared to show the specific similarities that involve infringement of protectible expression. Don't expect the finder of fact to make the determination on its own simply by examining the works. The court needs your guidance to rule in your favor and will not be pleased if you ask it to do your job.

For the defendant, the lesson is equally clear. Push the plaintiff during discovery to specify its original contribution to the work in which it claims rights, any preexisting elements in which it cannot claim rights and the similarities of protectible expression it believes are infringed. If the plaintiff relies on vague generalities or mere reference to the works at issue, the case may be ripe for summary judgment at the close of discovery or a directed verdict at the close of the plaintiff's case.