

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

ICC EVALUATION SERVICE, LLC, *et al.*,

Plaintiffs,

v.

**INTERNATIONAL ASSOCIATION OF
PLUMBING AND MECHANICAL
OFFICIALS, INC. *et al.*,**

Defendants.

No. 16-cv-54-EGS-ZMF

REPORT AND RECOMMENDATION

Plaintiff ICC Evaluation Service, LLC (“ICC-ES”) and Plaintiff-Intervenor International Code Council, Inc. (“ICC”) (together, “Plaintiffs” or “ICC Entities”) bring this action against Defendants International Association of Plumbing and Mechanical Officials, Inc. (“IAPMO”) and IAPMO Evaluation Service, LLC (“IAPMO-ES”) (together, “Defendants” or “IAPMO Entities”) for copyright infringement, in violation of 17 U.S.C. §§ 101 et seq. (the “Copyright Act”). Pending for consideration by the Court are Plaintiffs’ Motion for Summary Judgment, ECF No. 199 (Pls.’ Mot.), and Defendants’ Motion for Summary Judgment, ECF No. 200 (Defs.’ Mot.), pursuant to Federal Rule of Civil Procedure 56 and Local Rule 7(h). After careful consideration of the motions, oppositions and replies, and entire record, the Court recommends GRANTING in part and DENYING in part Plaintiffs’ motion and DENYING Defendants’ motion. To the extent that the motion requests findings related to damages, the Court concludes that material facts preclude summary judgment.

I. BACKGROUND

Plaintiff ICC-ES and Defendant IAPMO-ES are direct competitors in the nationwide market for the evaluation of building products, components, methods, and materials. *See* ECF No. 199, Plaintiffs’ Statement of Material Facts (“PSMF”) ¶¶ 5, 481; ECF No. 200, Defendants’ Statement of Material Facts (“DSMF”) ¶ 13; ECF No. 221, Defendants’ Counter-Statement of Material Facts (“Defs.’ CSMF”) ¶ 744. Plaintiffs claim that Defendants have infringed upon ICC-ES’s copyrights in certain of Plaintiffs’ “evaluation reports” and “acceptance criteria” (collectively, “Works at Issue”). Evaluation reports are documents developed for clients that aim to verify whether certain building products, components, methods, and materials comply with building codes and regulations. *See* PSMF ¶¶ 1, 6. Acceptance criteria are documents containing the standards by which to evaluate and demonstrate the compliance of a certain building product, method, material, or system not specifically referenced in the code.¹ *See id.* ¶¶ 2–4.

ICC-ES issues original evaluation reports and acceptance criteria (“Contemporary Works”), *see id.* ¶¶ 1–2, and re-issues evaluation reports and acceptance criteria developed by its predecessor (“Legacy Works”), *see id.* ¶¶ 15–20. The parties’ briefings and the Court’s analysis divides the Works at Issue between the Legacy Works and the Contemporary Works.

A. Legacy Works

ICC-ES is a subsidiary of ICC and part of the ICC family of companies. *See* Pls.’ Mot. at 2; PSMF ¶ 11; DSMF ¶ 3. ICC develops, maintains, and publishes model codes and standards. *See* PSMF ¶ 10. ICC and ICC-ES are the progenies of predecessor organizations that engaged in

¹ Criteria documents are alternatively called “evaluation criteria” and “acceptance criteria” throughout the briefings. The Court will refer to documents in this category as “acceptance criteria.”

building evaluation for many decades, including the International Conference of Building Officials, Inc. (“ICBO”). *See* PSMF ¶ 14.

Starting in the 1970’s and continuing through 1983, ICBO authored evaluation reports and acceptance criteria in multiple publications (collectively, “Serial Publications”). *See* PSMF ¶¶ 15–20; 38. In 1985, ICBO formed ICBO Evaluation Service, Inc. (“ICBO-ES”) as a subsidiary company. *See* PSMF ¶ 277; ECF No. 201, Johnson Ex. 3. ICBO-ES obtained control of developing the evaluation reports and acceptance criteria published in the Serial Publications. *See* PSMF ¶¶ 17–18. ICBO’s policies continued to govern the engineers that worked at ICBO-ES. *See id.* ¶ 18. For example, ICBO continued to “issue[] the paychecks” as well as retirement and healthcare benefits for the engineers who “worked at ICBO-ES.” *Id.* ¶ 19. ICBO also continued to regularly register the Serial Publications—including the constituent evaluations reports and acceptance criteria therein—with the U.S. Copyright Office as “works for hire,” with ICBO listed as the author.² *See id.* ¶¶ 17–20.

In 2003, ICC-ES acquired the rights to ICBO’s copyrighted works and “continued to author, write, create, or otherwise develop versions of Evaluation Reports and Acceptance Criteria originally issued by ICBO.” *Id.* ¶ 40. The epic journey of the Legacy Works from ICBO to ICC-ES, or there and back again, is detailed below:

² As discussed below, Defendants dispute whether the works authored by ICBO-ES employees were appropriately registered as works for hire by ICBO. *See* ECF No. 221, Defs.’ Opp. at 14–15.

1. *Transfer from ICBO to ICC*

On January 31, 2003, several code evaluation organizations and their affiliates—including ICBO, ICBO-ES, and NES³ (collectively, “Legacy Organizations”)—consolidated to form ICC and ICC-ES. *See* ECF No. 202 (“Sims Decl.”) ¶ 3. As part of the consolidation, ICBO assigned all rights, title, and interest in its evaluation reports and acceptance criteria—including its copyrights and copyright registrations—to ICC. *See* ECF No. 202, Johnson Ex. 5; ECF No. 201, Sims Ex. 2 (“Confirmatory Assignment”); Sims Decl. ¶ 5.

2. *Transfers from ICC to NES to ICC Evaluation Service, Inc.*

On January 31, 2003, on the same day as ICC’s formation, ICC assigned all right, title, and interest in its newfound evaluation reports and acceptance criteria to NES. *See* Confirmatory Assignment; PSMF ¶ 28. The Legacy Organizations consolidated with the stated intent of NES changing its name to ICC-ES and “assum[ing] all of the evaluation activities” of the Legacy Organizations, including creating and issuing evaluation reports and acceptance criteria. ECF No. 202, Sims Ex. 1; *see* ECF No. 202, Sims Ex. 2. On May 1, 2003, NES changed its name to “ICC Evaluation Services, Inc.” and changed it again on January 14, 2009, to “ICC Evaluation Service, Inc.” (changing “Services” to “Service”). *See* ECF No. 202 (“Johnson Decl.”) ¶ 19; Johnson Ex. 4. On February 9, 2018, ICC executed a confirmatory assignment, memorializing its 2003 donation and transfer to NES. *See* Confirmatory Assignment; PSMF ¶ 36.

³ In 1992, National Evaluation Services, Inc. (“NES”) was formed as an organization unrelated to ICBO. *See* PSMF ¶ 24; ECF No. 201, Johnson Ex. 4.

3. *Transfers from ICC Evaluation Service, Inc. to ES Acquisition Co. to ICC-ES*

On July 30, 2010, ICC Evaluation Service, Inc. sold and transferred all of its property and rights—including all copyrights and copyright registrations in the Legacy Works—to ES Acquisition Co., LLC. *See* ECF No. 202, Johnson Ex. 6; PSMF ¶¶ 33, 57–64. On August 10, 2010, ES Acquisition Co., LLC changed its name to ICC-ES (the Plaintiff in this case). *See* PSMF ¶ 35.

Plaintiffs claim that Defendants infringed upon their copyrights in the Legacy Works, of which ICC-ES has continued to author, write, create, or otherwise develop new versions. *See* PSMF ¶¶ 602–04.

B. Contemporary Works

Since at least 2003, the entity that would become ICC-ES continued the business of “author[ing], writ[ing], creat[ing], or otherwise develop[ing]” new evaluation reports and acceptance criteria. Pls.’ Mot. at 4. Plaintiffs claim that Defendants infringed upon its copyrights in the Contemporary Works, each of which was published with a copyright notice in favor of ICC-ES.⁴ *See* PSMF ¶¶ 2–4, 66, 68, 504.

C. Development of Works at Issue

1. *Evaluation Reports*

Organizations like Plaintiff ICC-ES create evaluation reports by summarizing and organizing applicable data into a concise format that allows the user to determine whether a particular product or service is up to code. *See* PSMF ¶ 44; ECF No. 209, Wise Ex. 58 (“Jan. 15,

⁴ Except Proposed AC 453, which was not yet published at the time of the alleged infringement. *See* PSMF ¶ 71.

2018 Dep.”) 137:2–6. The challenge is “cull[ing] through large volumes of material and distill[ing] it down to a much smaller report.” PSMF ¶ 44; *see also* Jan. 15, 2018 Dep. 137:3–23. A witness from IAPMO-ES testified that “it’s typically a lot of work to do a[n] [evaluation] report.” PSMF ¶ 42. It typically takes “6 to 12 weeks” to prepare a report. *Id.* ¶ 43. ICC-ES employs “highly experienced professionals, including licensed architects and engineers specializing in civil, structural, fire protection, and mechanical engineering . . . [to] author and revise Evaluation Reports and Acceptance Criteria.” *Id.* ¶ 41. ICBO’s employees are similarly experienced. *See id.* ¶ 39.

ICC-ES’s process for creating a Contemporary Work is initiated by a customer’s application. *See id.* ¶ 46. Once an application is received, ICC-ES assigns a member of its technical staff to evaluate the data and work with the applicant throughout the evaluation process. *See id.* ¶ 53. ICC-ES staff evaluate the applicant’s technical data to determine if the product is compliant with the relevant building codes and/or ICC-ES acceptance criteria and requests additional information from the client as needed. *See id.* ¶ 46. Draft reports go through a peer review process before being sent to the client for review. *See id.* ¶ 54. Prior to client approval, ICC-ES requests comments from the client. *See id.* ¶ 55.

Once issued, the report enters a one- or two-year subscription period, during which time the report is publicly accessible on ICC-ES’s website for free. *See id.* ¶¶ 60–62. ICC-ES also grants a limited license to the report holder to “use” and “reproduce[] in its entirety” the finalized report in “the report holder’s literature, advertising, or promotional materials.” *Id.* ¶ 47. Other than the limited license, ICC-ES retains control of the publication, use, suspension, and revocation of the evaluation reports and their drafts. *See id.*

The development process for the Legacy Works is slightly different. ICC-ES's allows the holder of an ICBO evaluation report to either maintain its report with ICC-ES or to convert the report to an ICC-ES evaluation report. *See id.* ¶ 48. All Legacy Works are re-issued with the same limited license to the report holder to "use" and "reproduce[] in its entirety" the report in "the report holder's literature, advertising, or promotional materials." *Id.* ¶ 49.

2. *Acceptance Criteria*

ICC-ES's acceptance criteria process is initiated by the need for standards of evaluation, such as for building products or services not specifically addressed in the code. *See* PSMF ¶ 59. Two ICC-ES technical staff, including one senior technical staff member, work together to develop new or revised acceptance criteria. *See id.* The staff also draft a cover letter containing the rationale for the acceptance criteria. *See id.* There is an extensive review process involving both an ICC-ES working group and the public. *See id.* Before issuance, the ICC-ES Evaluation Committee performs a review of the "proposed acceptance criteria" for final approval. *Id.* If rejected, the assigned ICC-ES technical staff draft revisions and resubmit the report to the Committee. *See id.* Once approved, all relevant documents and communications related to the acceptance criteria's creation are saved to ICC-ES files. *See id.*

Unlike evaluation reports, which were freely accessible, ICC-ES's Acceptance Criteria were typically only available for purchase from ICC-ES's website. *See id.* ¶ 64. On its website, ICC-ES expressly limited the license to use by the purchaser and prohibited use on more than "four electronic devices" and "[u]se on a local area network or other network." *Id.* ¶ 65.

D. Copying by Defendants

IAPMO develops model codes for adoption by jurisdictions regarding safe, sanitary plumbing and mechanical systems. *See* DSMF ¶ 7. IAPMO-ES is "wholly-owned by Defendant

IAPMO.” *Id.* ¶ 8. Like ICC-ES, IAPMO-ES issues evaluation reports and acceptance criteria. *See* Defs.’ CSMF ¶¶ 739–40, 743; PSMF ¶ 9.

Plaintiffs claim that Defendants made copies or reproduced ICC-ES’s Works at Issue by retaining electronic copies of them. *See* Pls.’ Mot. at 23; PSMF ¶¶ 504–618. Plaintiffs also claim that Defendants engaged in widespread copying of ICC-ES’s Works at Issue in creating and publishing competing evaluation reports and acceptance criteria (collectively, the “Accused Works”). *See id.* at 22.

1. *Storing and Transmitting Copies*

a. Evaluation Reports

IAPMO-ES’s clients included ones who previously used a competitor to draft their evaluation report or acceptance criteria. *See* Defs.’ Mot. at 5. During a client’s transition to IAPMO-ES, IAPMO-ES engineers would obtain a copy of the evaluation report authored by its competitor (such as ICC-ES). *See* PSMF ¶ 517. As a result, IAPMO-ES copied dozens of ICC-ES Evaluation Reports onto the Defendants’ content management system (the “Laserfiche”) and their internal server. *See id.* ¶¶ 518–21; ECF No. 209, Wise Ex. 121 (“Beck Dep.”) 160:25–161:3 (“Q. So wouldn’t you expect IAPMO-ES to have a copy of every one of the works at issue in the Laserfiche? A. Yes.”). IAPMO-ES engineers also saved local copies of ICC-ES evaluation reports and emailed them to support staff to be saved in the Laserfiche. *See* PSMF ¶ 218; ECF No. 209, Wise Ex. 100 (“Merrigan Dep.”) 126:7–128:3.

IAPMO-ES employees created editable copies of the Works at Issue, either by copying and pasting or, by “hand typing” the Work at Issue into a template publishable by IAPMO-ES when a PDF could not be “unlocked.” PSMF ¶¶ 526, 532–46; *see also* Merrigan Dep. 129:21–130:5

(confirming practice of directly typing the contents of an ICC-ES report into a format to be published by IAPMO-ES).

In shades of *The Colbuffington Re-Post*,⁵ IAPMO-ES overtly copied and repurposed competitor work. *See* PSMF ¶¶ 574–76. For example, on February 18, 2015, an IAPMO-ES engineer emailed a draft of IAPMO-ES’s ER 382 that still referred to ICC Evaluation Service and included the ICC-ES Evaluation Report number. *See id.*

b. Acceptance Criteria

Defendants kept a repository of approximately 200 ICC-ES acceptance criteria on a shared drive accessible by all IAPMO-ES employees. *See* PSMF ¶ 636; ECF No. 209, Wise Ex. 108 (“Donado Dep.”) 47:23–54:6. This dataset included acceptance criteria from before and after ICC-ES charged for this service. *See* PSMF ¶ 637–38. Indeed, Mr. Richard Beck, a Vice President at IAPMO, testified that “[t]here is probably a copy of every single [acceptance] criteria ICC had on the date – a month or so before [ICC-ES] started charging for them.” *Id.* ¶ 637; Beck Dep. 164:3–5. Once ICC-ES began charging a fee, Mr. Beck directed Mr. Duane Huisken, an IAPMO employee, to purchase ICC-ES acceptance criteria “using his ICC Membership discount and save them to Defendants’ shared drive[.]” PSMF ¶ 638. Mr. Huisken continued that practice as recently as November 15, 2019, when he purchased and downloaded ICC-ES AC 11. *See id.* ¶ 639.

2. *Creating Derivatives*

Defendants admit that they copied material from each of the Works at Issue for use in the Accused Works. *See* PSMF ¶ 504; *see* ECF No. 209, Wise Ex. 74 (“Jan. 29, 2018 Dep.”) 307:19–23 (“Q. There are parts of each of the works at issue that IAPMO-ES copied into the accused

⁵ *See* Alexia Tsotsis, *Stephen Colbert Launches HuffPo Parody Clone “The Colbuffington Re-Post,”* TechCrunch (Feb. 17, 2011), <https://techcrunch.com/2011/02/17/techcrunch-repost/>.

works; right? A. Yes.”). For example, Ms. Karen Snowden, a former office manager at IAPMO, testified that it took “just a few seconds” to copy the text from ICC-ES’s ER 2481 into IAPMO-ES’s template, although the “[t]ables t[ook] longer to paste.” *Id.* ¶¶ 536–37. Mr. Rafael Donado, an IAPMO engineer, admitted that he copied about 90 percent of the language from ICC-ES’s ER-2481 when creating IAPMO’s UES ER 319. *See* PSMF ¶ 541.

Defendants offered faster and less expensive products than ICC-ES while claiming to ICC-ES customers: “[o]ur reports are equal in every way to the reports that you have been receiving from ICC-ES.” *See* PSMF ¶¶ 620, 721.

E. Plaintiffs’ Warnings

On December 12, 2013, Plaintiffs first communicated their objections to Defendants regarding Defendants’ extensive copying. *See* PSMF ¶¶ 511–13. IAPMO-ES subsequently rewrote one of its evaluation reports. *See id.* ¶ 513. On October 28, 2015, Plaintiffs again emailed Defendants concerning IAPMO’s issuance of evaluation reports and acceptance criteria that copied substantial portions of ICC-ES’s copyrighted material. *See id.* ¶ 605. Plaintiffs’ email contained an exhibit with comparisons between the ICC-ES work and the corresponding accused IAPMO-ES work. *See id.* In response, Defendants removed nine evaluation reports and one acceptance criteria from their website and decided to “rewrite [them] from scratch.” *Id.* ¶¶ 607–08. Mr. Beck specifically instructed “the [IAPMO-ES] staff to write the next draft without opening – without viewing that original ICC report.” Jan. 29, 2018 Dep. 305:2–7. Defendants considered at least seven formats for rewriting their evaluation reports. *See* PSMF ¶ 653. After Defendants’ revision, ICC-ES no longer objected to the language in four of the nine revised evaluation reports. *See id.* ¶ 652.

On January 13, 2016, Plaintiffs served Defendants in this lawsuit. *See* ECF No. 5. Despite Defendants responding to Plaintiffs' objections and allegations, including this lawsuit, Defendants have continued to copy from and use ICC-ES Evaluation Reports as templates for their competing "UES Evaluation Reports." *See* PSMF ¶¶ 632–35.

II. LEGAL STANDARD

A motion for summary judgment must be granted when "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the 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). The issue must be both "material," meaning that "a dispute over it might affect the outcome of a suit," and "genuine," meaning that "a reasonable jury could return a verdict for the nonmoving party." *Holcomb v. Powell*, 433 F.3d 889, 895 (D.C. Cir. 2006). The "materiality" of particular facts is determined by the pleadings and the substantive law. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986) ("[T]he substantive law will identify which facts are material.").

A party seeking summary judgment bears the initial burden of identifying the basis for its motion and the portions of the pleadings and discovery responses which demonstrate the absence of a genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). "When, as in this case, both parties file cross-motions for summary judgment, each must carry its own burden under the applicable legal standard." *Ehrman v. United States*, 429 F. Supp. 2d 61, 67 (D.D.C. 2006). Where the moving party will have the burden of proof on an issue at trial, the movant must affirmatively demonstrate that no reasonable trier of fact could find other than for the moving party. *See Calderone v. United States*, 799 F.2d 254, 259 (6th Cir. 1986). If the moving party meets its initial burden, the nonmoving party must then set forth, by affidavit or as

otherwise provided in Rule 56, “specific facts showing that there is a genuine issue for trial.” *Anderson*, 477 U.S. at 250; *see* Fed. R. Civ. P. 56(e). Where the nonmoving party will have the burden of proof on an issue at trial, however, the moving party can prevail merely by pointing out that there is an absence of evidence to support the nonmoving party’s case. *See id.* The obligations of summary judgment “cannot be met by ‘mere allegation or denial[,]’ but instead, require a showing by ‘affirmative evidence.’” *Frito-Lay, Inc. v. Willoughby*, 863 F.2d 1029, 1034 (D.C. Cir. 1988) (quoting *Anderson*, 477 U.S. at 256–57). When a Court “does not grant all the relief requested by the [summary judgment] motion, it may enter an order stating any material fact — including an item of damages or other relief — that is not genuinely in dispute and treating the fact as established in the case.” Fed. R. Civ. P. 56(g).

“Courts have historically viewed summary judgment as inappropriate in the copyright infringement context because of the inherently subjective nature of the inquiry.” *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1232 (11th Cir. 2010) (citing *Oravec v. Sunny Isles Luxury Ventures, L.C.*, 527 F.3d 1218, 1223 (11th Cir. 2008)). However, courts may enter summary judgment when there is no serious dispute that the defendant reproduced plaintiff’s copyrighted material. *See Television Dig., Inc. v. U.S. Tel. Ass’n*, 841 F. Supp. 5, 7 (D.D.C. 1993).

III. ANALYSIS

“To prevail on a copyright claim, a plaintiff must prove both [(1)] ownership of a valid copyright and [(2)] that the defendant copied original or ‘protectable’ aspects of the copyrighted work.” *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1295 (D.C. Cir. 2002) (citation omitted). Though “[a] plaintiff rarely has direct evidence of actual copying,” *Prunte v. Universal Music Grp.*, 563 F. Supp. 2d 41, 43 (D.D.C. 2008), that is the case here. Defendants concede Defendant IAPMO-ES copied Plaintiff ICC-ES’s Works at Issue and instead argue 1) that Plaintiff ICC-ES

does not have ownership of valid copyrights,⁶ *see* Defs.’ Opp. at 11–15, and 2) that the copying is not actionable because the works at issue are not the type of content protected by copyright, *see* Defs.’ Mot. at 12–31.

A. Ownership of Valid Copyright

Plaintiff ICC-ES is the author and copyright owner of the Contemporary Works. The Certificates of Registration for the Contemporary Works state that ICC-ES is the “claimant” of the copyrights. PSMF ¶ 119. And “a copyright claimant is either: (i) The author of a work; [or] (ii) A person or organization that has obtained ownership of all rights under the copyright initially belonging to the author.” 37 C.F.R. § 202.3(a)(3). Defendants raise no arguments to the contrary as to the Contemporary Works. *See* Defs.’ Opp. at 2–3.

Defendants raise unavailing objections to ICC-ES’s ownership of the Legacy Works.⁷

⁶ Defendants argue that ownership of the Legacy Works need not be decided because their summary judgment request is directed to the “copyrightability of the Asserted Works regardless of who owns them.” Defs.’ Mot. at 1. However, because ownership is a material fact to copyright infringement, it must be decided here. Furthermore, Plaintiffs seek summary judgment as to the issue of ownership in their motion. *See* Pls.’ Mot. at 17.

⁷ Defendants repeatedly deny or refuse to admit a statement of fact on the basis that Defendants were denied discovery of the Legacy Works. *See* Defs.’ CSMF ¶¶ 21–25, 27–30, 33, 36–37, 39, 68–70, 72–73, 76–77, 80, 82–83, 87–88, 90–91, 93, 96–97, 107, 114, 117, 254, 257–78, 280–479, 662, 686–99, 728, 730. The Court already rejected Defendants’ argument. *See* Minute Order (June 18, 2020). Magistrate Judge Robinson found that “Defendants made a unilateral decision to pursue some, but not all, discovery related to the Legacy Works from both ICC and ICC-ES.” *Id.* “Plaintiffs made available documents for inspection, but Defendants declined to inspect them. According to counsel for Defendants during the Status and Scheduling Conference, Defendants based these decisions to not vigorously pursue discovery in part on a cost-benefit analysis to save time and expense for discovery related to pending dispositive motions and Defendants’ motion for a stay.” *Id.* On July 2, 2020, Defendants filed objections to Judge Robinson’s minute order. *See* ECF No. 188. On January 22, 2021, Judge Sullivan overruled Defendants’ objections, deferring to Judge Robinson’s finding that “Defendants had ample opportunity to seek discovery” pursuant to Defendants’ agreed upon schedule. *See* Minute Order (Jan. 22, 2021). Defendants’ attempt to relitigate the matter is without merit.

1. *Collective Work Registrations*

“[I]f the copyright owner of the collective work is . . . the copyright owner of the components, registration of the collective work registers the components.” *Alaska Stock, LLC v. Houghton Mifflin Harcourt Pub. Co.*, 747 F.3d 673, 684 (9th Cir. 2014) (citing 2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 7.16(B)(5)(c) (2013)). “[C]ollective work registrations [are] sufficient to permit an infringement action on behalf of component works, at least so long as the registrant owns the rights to the component works as well.” *Metro. Reg’l Info. Sys., Inc. v. Am. Home Realty Network, Inc.*, 722 F.3d 591, 598 (4th Cir. 2013).

Plaintiffs’ predecessor, ICBO, registered the Serial Publications (containing the Legacy Works) as collective works. *See* Defs.’ Opp. at 12; PSMF ¶ 253. Doing so effectively registered the individual works therein as well. *See Alaska Stock*, 747 F.3d at 684. Defendants are incorrect that ICBO had to individually name the Legacy Works in the registration statement. *See id.* Neither fashion nor the law require belt and suspenders. Thus, there is no genuine dispute regarding ICBO’s ability to legally transfer its copyrights in the Legacy Works.⁸

“It is well established that if a plaintiff fails to respond to an argument raised in a motion for summary judgment, it is proper to treat that argument as conceded.” *Wilkins v. Jackson*, 750 F.Supp.2d 160, 162 (D.D.C. 2010). Thus, the Court deems conceded any of Defendants’ omissions made based on denied discovery.

⁸ Plaintiffs listed inconsistent copyright registration numbers for ICBO ER-3568 throughout their briefings (citing TX 192-485, TX 229-194, TX 229-195, TX 236-722, or TX 361-966). *See* ECF No. 70, Third Amended Compl. ¶ 79; ECF No. 138, First Amended Intervenor Compl. ¶ 84; Defs.’ CSMF ¶ 255. However, Plaintiffs resolved any potential factual dispute by providing the cover sheets to the Serial Publications, which identify each of the component works therein, and corresponding certified copyright registrations. *See* PSMF ¶ 16; ECF No. 202, Hoge Exs. A–D. Here, Research Report Vol. XVII lists ICBO ER-3568 (Issued Feb. 1979) among its contents and according to its certified copyright registration was registered with the copyright office in November 1979. *See* ECF No. 210, Wise Exs. 19, 126.

2. *Assignment*

a. *Writing Requirement*

In general, a copyright transfer must be “in writing and signed by the owner of the rights conveyed or such owner’s duly authorized agent.” 17 U.S.C. § 204(a). However, an oral transfer may be valid if later reduced to writing. *See, e.g., Billy-Bob Teeth, Inc. v. Novelty, Inc.*, 329 F.3d 586, 591 (7th Cir. 2003) (recognizing oral transfer later reduced to writing); *Eden Toys, Inc. v. Florelee Undergarment Co., Inc.*, 697 F.2d 27, 36 (2d Cir. 1982) (same); *Arthur Rutenberg Homes, Inc. v. Drew Homes, Inc.*, 29 F.3d 1529, 1532 (11th Cir. 1994) (collecting cases). There is no strict timeline for subsequent memorialization. *See Magnuson v. Video Yesteryear*, 85 F.3d 1424, 1428–29 (9th Cir. 1996) (finding sufficient a writing dated more than fourteen years after the oral transfer where there was no dispute about the transfer by the transferring parties). The February 9, 2018, confirmatory assignment memorializing ICC’s 2003 transfer of copyrights to NES satisfies the signed writing requirement.⁹

b. *Admissibility*

Defendants do not produce evidence controverting Plaintiffs’ unbroken chain of title in these copyrights from ICBO to ICC-ES. *See* PSMF ¶¶ 21–37; Johnson Decl. ¶¶ 20, 24. Defendants instead argue that the Legacy Organizations’ documentation of formation and transfer

⁹ Judge Robinson determined at the motion to dismiss stage that “Defendants . . . lack[ed] standing to challenge the confirmatory assignment.” *ICC Evaluation Serv., LLC v. Int’l Ass’n of Plumbing & Mech. Offs., Inc.*, No. 16-cv-54, 2019 WL 8501430, at *6 (D.D.C. Nov. 22, 2019), report and recommendation adopted, 2020 WL 1905132 (D.D.C. Apr. 17, 2020). “[W]here there is no dispute between the copyright owner and the transferee about the status of the copyright, ‘it would be unusual and unwarranted to permit a third-party infringer to invoke section 204(a) to avoid suit for copyright infringement.’” *Billy-Bob Teeth*, 329 F.3d at 592-93 (quoting *Imperial Residential Design*, 70 F.3d at 99). This is particularly so where, as here, “both the original owner and the transferee have joined as plaintiffs in the same lawsuit.” *Imperial Residential Design*, 70 F.3d at 99. Defendants have offered no reason to disrupt this finding on summary judgment.

“lack[] authentication.” *See, e.g.*, Defs.’ CSMF ¶¶ 21–30. This argument is misplaced given that Rule 56 eliminated the authentication requirement in 2010. *See Akers v. Beal Bank*, 845 F. Supp. 2d 238, 243 (D.D.C. 2012); *see also* Fed. R. Civ. P. 56 advisory committee’s note to 2010 amendment (“The requirement that a sworn or certified copy of a paper referred to in an affidavit or declaration be attached to the affidavit or declaration is omitted as unnecessary.”).

Defendants also argue that various declarants lack “personal knowledge” of their declarations and the documents attached thereto. *See* Defs.’ CSMF ¶¶ 19–22 (objecting to the Johnson and Wise Declarations). Movants may submit declarations that are “made on personal knowledge, set out facts that would be admissible in evidence, and show that the affiant or declarant is competent to testify on the matters stated.” Fed. R. Civ. P. 56(c)(4). Mr. Mark Johnson represents in his declaration that as the Executive Vice President and Director of Business Development for Plaintiff ICC, he “ha[s] personal knowledge of the facts set forth [t]herein, and, if called upon to do so, [he] could and would testify competently thereto.” *See* Johnson Decl. ¶ 1. Mr. Johnson also confirms that he is “personally knowledgeable about each of the documents attached to [his] declaration . . . [which] are each kept and maintained in the regular course of ICC-ES’s usual business practices.” *Id.* ¶¶ 1–2. Mr. Johnson’s declaration is sufficient under the personal knowledge standard because it is “based on [an employee’s] personal knowledge or information made known to [him] in the course of [his] official duties.” *Citizens for Resp. & Ethics in Wash. v. Leavitt*, 577 F. Supp. 2d 427, 434 n.5 (D.D.C. 2008); *see also Axxiom Mfg., Inc. v. McCoy Invs., Inc.*, 846 F. Supp. 2d 732 (S.D. Tex. 2012) (finding plaintiff’s role as vice president and general manager to be sufficient basis for personal knowledge and admitting plaintiff’s declaration on motion for summary judgment in copyright suit).

Ms. Jane Wise similarly represents that, as an attorney at the Plaintiffs’ law firm, she has “personal knowledge” of the facts set forth in her declaration and could testify competently thereto. *See* ECF No. 210 (“Wise Decl.”) ¶ 1. Courts have deemed attorney declarations sufficient to establish personal knowledge when knowledge is based on the attorney’s experience at the law firm and review of the relevant business records. *See Crear v. Select Portfolio Servicing Inc.*, 760 F. App’x 291, 295 (5th Cir. 2019). Because the Johnson and Wise Declarations sufficiently establish personal knowledge, *see* Johnson Decl. ¶ 1; Wise Decl. ¶ 1, the Court may consider them on summary judgment. *See, e.g., Akers*, 845 F. Supp. 2d at 243.

3. *Rebuttable Presumption of Validity*

a. Application of Presumption

A certificate of registration issued “before or within five years after first publication of work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.” 17 U.S.C. § 410(c). This rebuttable presumption includes the “presumption of ownership.” *Stern v. Lavender*, 319 F. Supp. 3d 650, 670 (S.D.N.Y. 2018) (citing *id.*). This presumption applies to all of the Works at Issue except ESR-1215, AC 51, and AC 86, which were registered outside the five-year window.¹⁰ *See* Pls.’ Mot. at 18–19.

Where the presumption does not apply, the Court has discretion to determine the weight to be afforded to the facts stated in the certificates of registration. *See* 17 U.S.C. § 410(c). Courts have found copyright registration certificates issued more than five years after publication to be

¹⁰ ICC-ES first published ESR-1215 in November 2008 and registered it seven years later in November 2015. *See* PSMF ¶ 121. ICC-ES re-issued ESR-1215 in October 2012 and re-registered it just over five years later in November 2017. *See* PSMF ¶ 127. ICC-ES first published AC 51 in December 2007 and registered it in February 2018. *See* PSMF ¶ 229. ICC-ES first published AC 86 in February 2008 and reissued it in February 2010, both of which it registered in July 2015. *See* PSMF ¶¶ 235, 241.

presumed valid where the designs were functionally the same as designs registered within the five-year period. *See CJ Prods. LLC v. Snuggly Plushez LLC*, 809 F. Supp. 2d 127, 143–44 (E.D.N.Y. 2011). Courts have also afforded an equal presumption of validity to works registered more than five years after publication where the same claimant also brings claims for works registered within five years of publication. *See, e.g., id.* at 143; *Telerate Sys., Inc. v. Caro*, 689 F. Supp. 221, 227 (S.D.N.Y. 1988). ICC-ES authored ESR-1215, AC 51, and AC 86 based on the Legacy Works, which were registered within the five-year period. *See* PSMF ¶¶ 68, 72–75, 109–16. Thus, Plaintiffs’ ESR-1215, AC 51, and AC 86 are also presumed valid. *See Telerate Sys.*, 689 F. Supp. at 227. Moreover, “[g]iven that the overwhelming majority of the [Works at Issue] are clearly entitled to the statutory presumption of validity, the Court finds that it is especially appropriate to exercise the discretion accorded it by statute and afford the same weight to the [three] certificates registered outside the protected harbor timeline.” *CJ Prods. LLC v. Concord Toys Int’l Inc.*, No. 10-CV-5712 ENV JO, 2011 WL 178610, at *3 (E.D.N.Y. Jan. 19, 2011).

b. Rebuttal as to Ownership

Defendants bear the burden of establishing the invalidity of Plaintiffs’ presumptively valid registration certificates. *See MOB Music Pub. v. Zanzibar on the Waterfront, LLC*, 698 F. Supp. 2d 197, 202 (D.D.C. 2010). Defendants may challenge validity by demonstrating “that such certificates were improvidently issued,” *Stenograph L.L.C. v. Bossard Assocs., Inc.*, 144 F.3d 96, 99 (D.C. Cir. 1998), or “present[ing] any evidence to support a finding that Plaintiff does not in fact own the copyright for the [Works at Issue],” *Lifetime Homes, Inc. v. Residential Dev. Corp.*, 510 F. Supp. 2d 794, 801 (M.D. Fla. 2007).

Ownership of a protectable work “vests initially in the author or authors of the work.” 17 U.S.C. § 201(a). “In the case of a work made for hire, the employer or other person for whom the

work was prepared is considered the author.” *Id.* § 201(b). Work for hire must be prepared by an “employee” as determined by the general common law of agency. *See Cmty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 750–51 (1989). Factors used to determine whether a party is hired as an “employee” include, *inter alia*, the right of control over the product, the skill required, the source of the instrumentalities and tools, the location of the work, the duration of the relationship, the hiring party’s right to assign additional projects to the hired party, the method of payment, the provision of employee benefits, the tax treatment of the hired party, and whether the work is part of the hiring party’s regular business. *See id.* at 751–52.

The registration certificates for the Legacy Works list ICBO as the “author,” whose “contribution to the work [was] a ‘work made for hire.’” ECF No. 210, Wise Exs. 16–35. Defendants have failed to demonstrate that the Legacy Works were not authored by “employees” of ICBO. *See* Defs.’ Opp. at 14; Defs.’ CSMF ¶ 18. The Legacy Works were prepared by engineers at ICBO-ES, which was established and owned by ICBO. *See* PSMF ¶ 277; ECF No. 225, Pls.’ Reply at 6. Mr. Gerber, a vice president at IAPMO and former employee at ICBO, stated that “policies such as working hours or working environment . . . decided for ICBO employees [were] also applicable to those of us that worked at [ICBO-ES] . . . [W]e were technically ICBO employees anyway regardless of which group we worked in.” ECF No. 209, Wise Ex. 125 (“Jul. 13, 2020 Dep.”) 47:9–50:3, 252:2–10; *see* PSMF ¶ 507. Mr. Gerber testified that ICBO issued paychecks and administered healthcare benefits for ICBO-ES engineers and that the companies shared certain functionalities, such as a physical location, IT department, and legal department. *See* Jul. 13, 2020 Dep. 250:3–252:10; PSMF ¶ 18. Thus, the Legacy Works were prepared as works made for hire by ICBO “employees” within the meaning of 17 U.S.C. § 201(b). *See Reid*, 490 U.S. at 750–52.

“Defendants have offered no evidence whatsoever tending to show that . . . [ICBO] does not in fact own the copyrights in the products covered by [its] registrations.” *CJ Prods. LLC v. Concord Toys Int’l Inc.*, No. 10-CV-5712, 2011 WL 178610, at *3 (E.D.N.Y. Jan. 19, 2011). Defendants cannot overcome the presumption of validity where they offer no evidence to rebut the fact that ICBO-ES engineers were employees of ICBO who prepared the Legacy Works for ICBO as works for hire. *See Lifetime Homes*, 510 F. Supp. 2d at 801. “Accordingly, the Court finds that Plaintiff[s have] established [they own] valid copyright[s] as to the [Works] as a matter of law and [are] entitled to summary judgment as to this element of its claim.” *Id.*

B. Copyrightability

To prevail on a copyright claim, the plaintiff must establish that the defendant violated one of its “exclusive rights.” *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1372 (2d Cir. 1993). Here, Plaintiffs claim that Defendants infringed upon Plaintiff ICC-ES’s exclusive rights to “reproduce[] and/or prepare[] derivatives of” the Works at Issue. Third Amended Compl. ¶¶ 59, 62; *see Stewart v. Abend*, 495 U.S. 207, 220 (1990) (citing 17 U.S.C. § 106). The right to “reproduce” a work means the right to make a copy of the work in whole or in any substantial part by duplicating it exactly or by transcription, imitation, or simulation. *See* H.R. Rep. No. 94-1476, at 61 (1976). The right to prepare a derivative work means the right to produce a work “based upon the copyrighted work.” *Id.* at 62.

It is uncontested that Defendants engaged in actual copying. *See supra* Part I.D. Instead, much of the litigation centers on whether the Works at Issue are copyrightable. Determining copyrightability requires first reviewing what copyright protects: “*original* works of authorship fixed in any tangible medium of expression.” 17 U.S.C. § 102(a) (emphasis added). A work is original if it is “independently created by the author and possesses some minimal degree of

creativity.” *Television Dig.*, 841 F. Supp. at 7–8, (citing *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344-45 (1991)). “[T]he requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, ‘no matter how crude, humble or obvious’ it might be.” *Atari Games Corp. v. Oman*, 979 F.2d 242, 244 (D.C. Cir. 1992) (quoting *Feist*, 499 U.S. at 345).

The question is whether the Works at Issue, which are fact-based, possess the requisite originality to enjoy copyright protection. The Court easily answers in the affirmative.

1. *Originality*

“[I]n the context of fact-based works, the originality requirement can be satisfied either (1) by ‘cloth[ing] facts with an original collocation of words,’ in which case ‘[o]thers may copy the underlying facts from the publication, but not the precise words used to present them’ or (2) by ‘select[ing] and arrang[ing] the facts’ in an original manner.” *Sassafras Enters., Inc. v. Roshco, Inc.*, 889 F. Supp. 343, 346 (N.D. Ill. 1995) (citing *Feist*, 499 U.S. at 348–49). Determining originality for fact-based works is not about the “sweat of the brow,” but instead the *creative spark* involved in deciding which information to include and how to communicate it. *Feist*, 499 U.S. at 360–61. “[C]reativity derives from the combination of texture, color, size, and shape, as well as the particular verse inscribed and the way the verse is presented When an author combines these elements and adds his or her own imaginative spark, creation occurs, and the author is entitled to protection for the result.” *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 207 (3d Cir. 2005) (citing *Feist*, 499 U.S. at 345).

ICC-ES’s particular *expression* of factual information, including the accompanying descriptive text, is copyrightable. *See WPOW, Inc. v. MRLJ Enters.*, 584 F. Supp. 132, 136 (D.D.C. 1984) (holding that a “plaintiff clearly has a copyright on [an] engineering report”). In

Mitel, Inc. v. Iqtel, Inc., the court found a plaintiff’s call and command codes to be protected by copyright because, despite the presence of other unprotectible elements, the plaintiff had displayed a minimal degree of creativity with respect to the listed values (“110 baud,” “300 baud,” “600 baud,” etc.). 124 F.3d 1366, 1374 (10th Cir. 1997). In contrast to the minimal creativity exercised in *Iqtel*, the creation process for evaluation reports involved substantial expert analysis, culling down voluminous product information, and summarization into one or more pages of text. See PSMF ¶¶ 41–44, 54–57, 75. The Works at Issue thus “contain expression that is certainly technical but that still bears markings of creativity.” *Am. Soc’y for Testing & Materials v. Public.Resource.org, Inc.*, No. 13-CV-1215 (TSC), 2017 WL 473822, at *9 (D.D.C. Feb. 2, 2017) (“*ASTM P*”), *rev’d in part on other grounds, vac. in part sub nom.*, 896 F.3d 437 (D.C. Cir. 2018) (“*ASTM IP*”).

Plaintiffs’ process for creating the Works at Issue is indicative of their originality. First, Plaintiffs’ drafting and peer review process for evaluation reports and assessment criteria involved reviewing a significant amount of information and “summariz[ing] the applicable data into a concise format for the code official or the architect.” PSMF ¶¶ 41–44, 54–57, 75. In so doing, ICC-ES (and its predecessor, ICBO) “organiz[ed] the factual information [and data] in a useful manner.” *Axxiom Mfg., Inc. v. McCoy Invs., Inc.*, 846 F. Supp. 2d 732, 747–48 (S.D. Tex. 2012). ICC-ES also addressed customers’ comments on the draft evaluation reports and decided whether to include them. See ECF No. 225 (“Pls.’ RSMF”) ¶ 751; ECF No. 209, Wise Ex. 78 (“Gerber Dep.”) 177:8–19. Acceptance criteria similarly required experts to “review[] and analyz[e] the relevant codes, standards, and regulations for [the product], as well as third-party comments on each version, and . . . synthesize[] these materials in a concise written expression.” Pls.’ RSMF ¶112; see PSMF ¶¶ 41, 59–60. Plaintiffs’ “creative choices in describing [factual] processes and

systems, including the [Works' at Issue] overall arrangement and structure, are subject to copyright protection.” *Logical Operations Inc. v. 30 Bird Media, LLC*, 354 F. Supp. 3d 286, 296–97 (W.D.N.Y. 2018) (quoting *Situation Mgmt. Sys., Inc. v. ASP Consulting LLC*, 560 F.3d 53, 61 (1st Cir. 2009)).

Thus, the Works at Issue surpass *Feist*'s minimal threshold of originality for copyright. *See, e.g., Greaver v. Nat'l Ass'n of Corp. Dirs.*, No. C.A. 94–2127(WBB), 1997 WL 34605245, at *3–4 (D.D.C. Nov. 19, 1997) (seminar manual copyrightable); *B2B CFO Partners, LLC v. Kaufman*, 787 F. Supp. 2d 1002, 1007 (D. Ariz. 2011) (employee training manual copyrightable); *Portionpac Chem. Corp. v. Sanitech Sys.*, 217 F. Supp. 2d 1238, 1246 (M.D. Fla. 2002) (reference manual copyrightable).

2. *Functional Information*

Defendants' central argument against copyrightability is that the Works at Issue are composed of uncopyrightable “functional” information. *See* Defs.' Mot. at 12.

a. No dissection

A court must “be careful not to over-dissect the plaintiff's work, causing it to ignore the plaintiff's protectable expression.” *Situation Mgmt. Sys., Inc. v. ASP. Consulting LLC*, 560 F.3d 53, 59 (1st Cir. 2009). Defendants improperly divide the Works at Issue into their individual component parts and analyze those parts for stand-alone copyrightability. *See* Defs.' Mot. at 17–30. Courts have typically only applied this dissection technique to works containing raw data or facts, where the data sections or headers—such as name, address, and phone number—denote a type of information that is inherently unoriginal and noncopyrightable. *See, e.g., Assessment Techs. of WI, LLC v. WIREdata, Inc.*, 350 F.3d 640, 644 (7th Cir. 2003) (rejecting infringement claim for copying data from database of addresses, owners' names, age of properties, and assessed

property values because data was entirely factual, with no injection of creativity or originality); *Feist*, 499 U.S. at 363 (finding “names, towns, and telephone numbers” to be unoriginal). The raw data denied protection in *Feist* and *WIREData*—indiscriminate rows of names, addresses, and numbers—is qualitatively different than the written descriptions of products and procedures contained in Plaintiffs’ evaluation reports and acceptance criteria.¹¹ As such, the Court must consider each work here as a whole when considering copyrightability. *See Atari*, 979 F.2d at 244–45.

b. No statutory exception

Defendant’s functional information argument is not based in the Copyright Act. The only statutory carve out for functional “or utilitarian” use concerns “pictorial, graphic, and sculptural works,” which are defined as:

two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans [and] the design of a useful article . . . only to the extent that, such design incorporates pictorial, graphic, or sculptural features that *can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.*

17 U.S.C. § 101 (emphasis added). This exception covers graphics like “For Rent” and “For Sale” signs. *See Sem-Torq, Inc. v. K Mart Corp.*, 936 F.2d 851, 854–855 (6th Cir. 1991) (such signs are not copyrightable due to a lack of sufficient originality). This bears no resemblance to the instant

¹¹ Defendants’ isolation of the subparts “CSI Designation” (a master specification number) and “Name of the Product and Report Holder” is appropriate to the extent those subparts of the report include only unprotectible elements. *See, e.g., Gem Prod., Inc. v. Robertshaw Control Co.*, No. CV-85-7283, 1986 WL 32733, at *3 (C.D. Cal. Feb. 26, 1986) (finding catalogs protectable by copyright to the extent of the creative arrangement but not as to the parts numbers, which were considered unprotectible facts). Indeed, Plaintiffs concede that “ICC-ES does not claim copyright in the CSI designation or name of the product or report holder contact details in isolation.” *See Pls.’ Opp.* at 20. However, these sections cannot be excised from Plaintiffs’ whole product to determine copyrightability.

case, which concerns literary works—not “pictorial, graphic, [or] sculptural works.”¹² 17 U.S.C. § 101. Because Congress included no corollary limitation in the “literary works” definition or Section 102(b) more broadly, the Copyright Act protects the type of functional expression at issue here. *See Russello v. United States*, 464 U.S. 16, 23 (1983) (“[W]here Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion.”).

c. No functional exception

The Copyright Act lists the elements of a work that are not copyrightable—including “any idea, procedure, process, system, method of operation, concept, principle, or discovery.” § 102(a)-(b). “[I]n shorthand form . . . unlike patents, which protect novel and useful ideas, copyrights protect ‘expression’ but not the ‘ideas’ that lie behind it.” *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1196 (2021) (citing *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936)). In fact, copyright “encourages others to build freely upon the ideas and information conveyed by a work. This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship.” *Feist*, 499 U.S. at 350–51 (citation omitted).

Defendants try to contort this fact/expression dichotomy into a categorical exception from copyright protection for all “functional” information. *See* Defs.’ Mot. at 12, 17–30. Defendants strain themselves trying to fashion their argument, alternatively characterizing the language in the

¹² The Works at Issue fall in the copyright category of “literary works,” which are “works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia.” 17 U.S.C. § 101; *see also Am. Dental Ass’n v. Delta Dental Plans Ass’n*, 126 F.3d 977, 979 (7th Cir. 1997) (“[A] work need not be aesthetically pleasing to be ‘literary.’ . . . Scholarship that explicates important facts about the universe likewise is well within this domain. Einstein’s articles laying out the special and general theories of relativity were original works even though many of the core equations, such as the famous $E=mc^2$, express ‘facts’ and therefore are not copyrightable. Einstein could have explained relativity in any of a hundred different ways; another physicist could expound the same principles differently.”).

Works at Issue as “functional description[s] of the uses and applications,” *id.* at 21, “literal description[s],” *id.*, “reflect[ing] functional considerations,” *id.* at 22, “serv[ing] purely a utilitarian function,” *id.* at 22, “functional expression[s],” *id.* 24, and “functionally-based expressions,” *id.* at 25 (emphasis added). Defendants’ own characterizations undo their argument by acknowledging the descriptive and expressive composition of the Works at Issue.

In any case, “simply calling a work a ‘procedure’ or a ‘method’ does not revoke its copyright protection under the Copyright Act. This argument misunderstands or ignores the expression/idea dichotomy . . . codified in § 102(b).” *ASTM I*, 2017 WL 473822, at *8. Indeed, courts have long extended copyright protection to works containing both fact and expression. For example, exam prep materials, which are inundated with facts, can be copyrightable. *See Med. Educ. Dev. Servs., Inc. v. Reed Elsevier Grp., PLC*, No. 05-CV-8665, 2008 WL 4449412, at *6 (S.D.N.Y. Sept. 30, 2008) (rejecting argument that nursing exam prep book was “dictated largely by the [exam] and the science of nursing” and thus not copyrightable). The same is true for news articles: “though there can be no copyright in the news itself, copyright does protect ‘the manner of expression, the author’s analysis or interpretation of events, the way he structures his material and marshals facts, his choice of words, and the emphasis he gives to particular developments.’” *Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65, 70 (2d Cir. 1999) (quoting *Wainwright Sec. Inc. v. Wall St. Transcript Corp.*, 558 F.2d 91, 95–96 (2d Cir. 1977)). Similarly, that the Works at Issue *contain* factual or functional information about building products does not support Defendants’ extreme conclusion that the Works at Issue *as a whole* are not copyrightable. *See, e.g., Honeywell Int’l, Inc. v. W. Support Grp., Inc.*, 947 F. Supp. 2d 1077, 1081–82 (D. Ariz. 2013) (finding copyrightable aircraft manuals that included factual information, such as “procedures for checking and repairing aircraft parts,” and followed federal regulations dictating

the publication, distribution, and “format and content of the manuals”); *SecureInfo Corp. v. Telos Corp.*, 387 F. Supp. 2d 593, 611 (E.D. Va. 2005) (finding copyrightable “manuals conveying a detailed procedure to accomplish a specific goal”).

Defendants rely on *Gennie Shifter* to argue that the “Installation Instructions” sections of the Works at Issue are unprotectible as “merely the recitation of the mechanical steps and parts dictated by the installation process.” *Gennie Shifter, LLC v. Lokar, Inc.*, No. 07-CV-01121, 2010 WL 126181, at *16 (D. Colo. Jan. 12, 2010); see Defs.’ Mot. at 24–25. Yet the *Gennie Shifter* court found that “[t]hough some of the copied textual material is unprotected statement of fact dictated by similar subject matter, much of it is protectable creative expression. In light of Gennie Shifter’s copying of organization, structure, and diction, . . . an ordinary observer would conclude that Gennie Shifter unlawfully appropriated Lokar’s protectable expression.” 2010 WL 126181, at *8. Likewise, Plaintiffs’ copyrights in the Works at Issue protect the particular “organization, structure, and diction” chosen to convey the factual/functional information therein. *Id.* *Gennie Shifter* highlights what Defendants ignore: the presence of facts or ideas within a work does not thwart copyrightability of the work as a whole. *See id.* This is because uncopyrightable “[i]deas, plans, methods, systems, or devices, [are] distinguished from the particular manner in which they are expressed or described in a writing,” which is copyrightable. 37 C.F.R. § 202.1 (emphasis added).¹³

¹³ Defendants conflate the standards of copyrightability and infringement in relying on several cases dealing with infringement for their functionality argument. *See* Defs.’ Mot. at 24–26 (citing *Rozenblat v. Sandia Corp.*, 79 F. App’x 904, 906 (7th Cir. 2003) (infringement); *Presby Constr., Inc. v. Clavet*, Civ. No. 00-457-M, 2001 U.S. Dist. LEXIS 20951, *6 (D.N.H. Nov. 19, 2001) (infringement); *CMM Cable Rep, Inc. v. Ocean Coast Props., Inc.*, 97 F.3d 1504, 1515 (1st Cir. 1996) (infringement); *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1072 (2d Cir. 1992) (parties did not dispute copyright validity)). At the infringement stage of analysis, Courts ask not whether a work is protectible (i.e., copyrightability) but whether a defendant copied upon the protectible

3. *Merger Doctrine and Scènes à faire*

Defendants next ask the Court to find the Works at Issue uncopyrightable pursuant to the doctrines of merger and scènes à faire.¹⁴ See Defs.’ Mot. at 31–35. “The doctrine of scenes a faire is closely related [to the merger doctrine].” *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1444 (9th Cir. 1994). “The merger doctrine provides that ‘expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself.’” *BUC Int’l Corp. v. Int’l Yacht Council Ltd.*, 489 F.3d 1129, 1142 (11th Cir. 2007) (quoting *BellSouth Advert. & Pub. Corp. v. Donnelley Info. Pub., Inc.*, 999 F.2d 1436, 1442 (11th Cir. 1993)). “If the court concludes that the idea and its expression are inseparable, then the merger doctrine applies and the expression will not be protected.” *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 138–39 (5th Cir. 1992).

The scènes à faire doctrine bars from copyright protection the “incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.” *Sturdza*, 281 F.3d at 1295 (internal citations and quotations omitted). For example, scènes à faire prohibits the copyright of “abstract plot points like the birth of a child or a fight between parents.” See *Scott-Blanton v. Universal City Studios Prods. LLLP*, 539 F. Supp. 2d 191, 202 (D.D.C. 2008), *aff’d*, 308 F. App’x 452 (D.C. Cir. 2009). However, copyright continues to protect the *expression* surrounding such standard concepts. *Id.*

expression within a work. See *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1295–96 (D.C. Cir. 2002). Thus, Defendants’ citations to a court’s infringement analysis are inapposite here.

¹⁴ Courts diverge as to whether the doctrines of merger and scènes à faire should be approached as questions of copyrightability or as defenses to infringement. See *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 138 n. 5 (5th Cir. 1992) (noting split as to the doctrine of merger); *ASTM I*, 2017 WL 473822, at *14–15 (acknowledging split and declining to decide). Because Defendants invoked these doctrines as arguments against copyrightability, the Court proceeds accordingly.

In determining whether the merger or *scènes à faire* doctrines apply, courts tend to “focus on whether the idea is capable of various modes of expression.” *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 536 (6th Cir. 2004) (quoting *Montgomery Data*, 967 F.2d at 138). Neither doctrine bars copyrightability of the Works at Issue as a matter of law.

Defendants argue the merger doctrine applies because: (1) “there are only a limited number of ways to express a literal description of a product, the proper installation of a product, the uses of a product and a description of the labeling of a product”; and (2) “[t]he Evaluation reports and Acceptance Criteria at issue here reference building codes and other industry standards.” Defs.’ Mot. at 33. Yet it is Plaintiffs’ particular expression of product descriptions and building code references that is protected here. *See, e.g., Soc’y of Holy Transfiguration Monastery, Inc. v. Gregory*, 689 F.3d 29, 48 (1st Cir. 2012). As Defendants concede: “[i]n the context of applying the English language, yes, there are numerous ways [to convey this information].” PSMF ¶ 656. “[T]he fact that one author has copyrighted one expression of that idea will not prevent other authors from creating and copyrighting their own expressions of the same idea.” *Montgomery Data*, 967 F.2d at 138–39. For example, the merger doctrine did not prevent an English language translation of Greek religious texts from being copyrightable—even though other authors might translate it similarly—because the art of translation involved choices among many possible means of expressing ideas. *Gregory*, 689 F.3d at 53.

Further, evidence of alternative expressions exists for the Works at Issue. Defendants were able to successfully revise and republish four out of the nine reports initially objected to by ICC-ES. *See* PSMF ¶ 652. In developing the new report format, Defendants considered at least seven different potential format options. *See* PSMF ¶¶ 653, 655, 659. Mr. Beck, a Vice President at IAPMO, believed IAPMO-ES’s rewritten reports were better formatted. *See* PSMF ¶ 654. “[T]hat

other parties have written different [reports] on the same exact subject matter as [] Plaintiffs’ [reports] undermin[es] the argument that the [reports] are so technical and precise there can be only one possible expression.” *See ASTM I*, 2017 WL 473822, at *9.

4. *Third-party Sourcing*

Defendants argue for the first time in their opposition brief that certain of Plaintiffs’ Contemporary Works¹⁵ are not original—and thus not copyrightable—because “portions of the Works were taken fully or nearly verbatim from third-party sources, including Plaintiffs’ customers’ written materials and various test standards.” Defs.’ Opp. at 3; *see* Defs.’ CSMF ¶¶ 801–29. For this defense to be successful, a “defendant must do more than adduce the existence of prior similar works—there must be further evidence that plaintiff copied from such works. In addition, the proof, to be relevant, must show that plaintiff copied not simply the ideas from an antecedent work, but its expression.” 3 *Nimmer on Copyright* § 12.11[B]. “[T]he purportedly cribbed portions [must] ‘pervade’ the works” for this defense to render such works “completely unprotected under the Copyright Act.” *Wolf v. Travolta*, 167 F. Supp. 3d 1077, 1091 (C.D. Cal. 2016).

As to the Works at Issue without identified third-party text,¹⁶ Defendants fail to allege material facts refuting originality. As to the Contemporary Works in question, Defendants offered no more than a single table or single paragraph from an allegedly third-party source. *See* Defs.’ CSMF ¶¶ 801–29. Such fragments of a work cannot amount to pervasive copying as to an entire report. *See Wolf*, 167 F. Supp. 3d at 1091. Indeed, Plaintiffs’ copyright infringement claims cover

¹⁵ ESR-1215; ESR-1607; ESR-1647; ESR-1835; ESR-2017; ESR-2380; ESR-2447; ESR-2448; ESR-2481; ESR-2968; ESR-3111; ESR-3246; ESR-3420; ESR-3511.

¹⁶ All Legacy Works, ESR-3081, AC 11, AC 51, AC 86, and Proposed AC 453. *See* PSMF ¶¶ 660–68; Pls.’ RSMF ¶ 801.

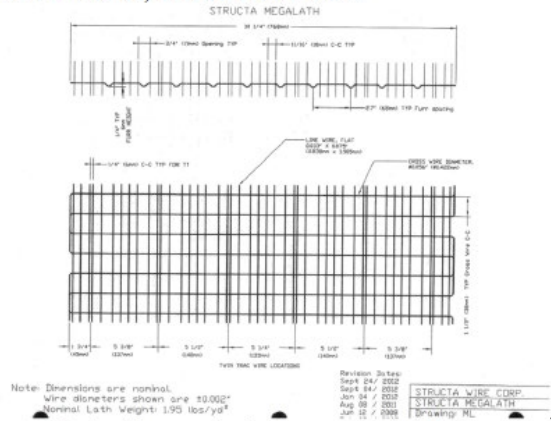
all content in their Contemporary Works, not just the snippets of text that Defendants assert is sourced from a third-party. See Defs.’ CSMF ¶¶ 801–29; Pls.’ Reply at 10–11.

Further, none of Defendants’ side-by-side comparisons of these excerpts depict verbatim copying by Plaintiffs. See 3 Nimmer on Copyright § 12.11[B]. In a particularly baffling example as to ICC-ES’s ESR-2017, Defendants claim that a drawing provided by a third party to ICC-ES “shows in drawing form the dimensions set forth in ESR-2017.” Defs.’ CSMF ¶ 812 (shown below).

3.3 Structa Mega Lath:

The lath is a self-furring welded wire lath for use as an alternative to the 3.4 lb/yd² (1.8 kg/m²) diamond mesh metal lath specified in ASTM C 847 and for use as an alternative to the 1.4 lb/yd² (0.8 kg/m²) woven wire lath specified in ASTM C 1032. The lath is formed from cold-rolled rectangular longitudinal wires with coated thickness dimensions of 0.0330 inch (0.83 mm) by 0.0675 inch (1.71 mm), and round cross wires having a coated diameter of 0.050 inch (1.27 mm). The lath has 0.7-inch-by-1.5-inch (17.8 by 38.1 mm) rectangular-shaped openings formed by longitudinal and cross wires that are resistance-welded at the wire intersections. Five additional cold-rolled rectangular longitudinal wires, with coated thickness dimensions of 0.0330 inch (0.83 mm) by 0.0675 inch (1.71 mm), are resistance-welded to the cross wires. The secondary longitudinal wires are spaced every 5 inches (127 mm) across the width. The wire has a Class 1 galvanized coating complying with ASTM A 641, or a Structa-Chrom-EX™ corrosion-resistant coating. The lath has minimum 1/4-inch (6.4 mm) furring crimps spaced at 1.9 inches (48 mm) on center on each cross wire. The nominal weight of the lath is 1.8 pounds per square yard (0.97 kg/m²). The lath is packaged in rolls 28 7/8 inches (727 mm) wide and 113 feet (34 442 mm) long.

ECF No. 221-22, Second Oldach Ex. L.



None of the language from the drawing appears verbatim in ESR-2017, see Pls.’ RSMF ¶ 812, which is required, see 3 Nimmer on Copyright § 12.11[B]. ESR-2017 contains in the form of text the information depicted in a chart, which shows at best the application of a single idea—not the pervasive copying of expression. See 3 Nimmer on Copyright § 12.11[B]. Ironically, this claim proves that Plaintiffs’ content is amenable to various forms of expression, which is the heart of copyrightability. See Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 547–48 (1985).

Defendants do not provide evidence that Plaintiffs copied the *expression* of a third-party source, let alone that it was pervasive. *See Wolf*, 167 F. Supp. 3d at 1091. Thus, Defendants fail to raise a triable issue as to copyrightability of the Works at Issue.

C. Infringement

An infringement claim requires that a plaintiff “show not only that the defendant actually copied the plaintiff’s work, but also that the defendant’s work is ‘substantially similar’ to protectible elements of the plaintiff’s work.” *Sturdza*, 281 F.3d at 1295; *see also 4 Nimmer on Copyright* § 13.01[B], at 13-8 to -10 (highlighting differentiation between actual copying and substantial similarity, both of which are required).

Substantial similarity requires the court to “determine[e] whether the allegedly infringing work is ‘substantially similar’ to protectible elements of the artist’s work.” *Sturdza*, 281 F.3d at 1296. Substantial similarity exists where “the accused work is so similar to the plaintiff’s work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff’s protectible expression by taking material of substance and value.” *Id.* (quoting *Country Kids ‘N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1288 (10th Cir. 1996)). There is no agreed-upon test for substantial similarity. *See 3 Nimmer* § 13.03[A], at 13-20 to -20.1. “Somewhere between the one extreme of no similarity and the other of complete and literal similarity lies the line marking off the boundaries of “substantial similarity.” *Id.* Finding this line requires “a side-by-side comparison” between the copyrighted and allegedly infringing works. *Gen. Universal Sys., Inc. v. Lee*, 379 F.3d 131, 142 (5th Cir. 2004).

The trier of fact must filter out “unprotectible elements” of a work when deciding whether “the protectible elements, standing alone, are substantially similar.” *Williams v. Crichton*, 84 F.3d 581, 588–91 (2d Cir. 1996). “[S]uch an analysis can be hard to apply, since even verbatim copying

must still appropriate protected elements to be legally actionable.” *Lennar Homes of Texas Sales & Mktg., Ltd. v. Perry Homes, LLC*, 117 F. Supp. 3d 913, 944 (S.D. Tex. 2015), judgment entered sub nom. *Lennar Homes of Texas Sales & Mktg. Ltd v. Perry Homes, LLC*, No. CIV.A. H-14-1094, 2015 WL 4638504 (S.D. Tex. July 24, 2015).

“Because substantial similarity is customarily an extremely close question of fact, summary judgment has traditionally been frowned upon in copyright litigation.” *See Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 977 (2d Cir. 1980). However, “summary judgment for a copyright defendant remains appropriate if the works are so dissimilar as to protectible elements that no reasonable jury could find for the plaintiff on the question of substantial similarity.” *Sturdza*, 281 F.3d at 1296–97. Conversely, “[a] grant of summary judgment for plaintiff is proper where works are so overwhelmingly identical that the possibility of independent creation is precluded.” *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327, 1330 (9th Cir. 1983). The Court separately analyzes substantial similarity as to the reproductions and the alleged derivative works.

1. Reproductions

“[T]he right ‘to reproduce the copyrighted work’ . . . means the right to produce a material object in which the work is duplicated, transcribed, imitated, or simulated in a fixed form from which it can be ‘perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.’” H.R. Rep. No. 94-1476, at 61 (1976) (quoting 17 U.S.C. § 101). In short, the right of reproduction is the right to make a copy.

This case is unique in that Defendants concede to reproducing in full each of the Works at Issue.¹⁷ Defendants reproduced each Work at Issue in a “fixed form” by either saving it to the Laserfiche, saving it to their internal server, emailing it to a colleague, or transcribing it. *See* PSMF ¶¶ 504–618. Moreover, Defendants offer no affirmative evidence to refute Plaintiffs’ claims of reproduction and thus fail to meet their evidentiary obligation at summary judgment. *See Frito-Lay, Inc. v. Willoughby*, 863 F.2d 1029, 1034 (D.C. Cir. 1988). Because “there is no genuine issue of material fact as to whether [Defendants] reproduced . . . exact or near-exact copies of the [Works at Issue],” Plaintiffs are entitled to a finding of substantial similarity as a matter of law. *Gregory*, 689 F.3d at 49.

2. *Accused Works*

As to the Accused Works, the question of substantial similarity presents a genuine issue of material fact. The Accused Works include sections of text from the Works at Issue that are nearly verbatim. *See, e.g.*, IAPMO’s UES 1835, UES 405, UES 400, UES 337, EC 004-2010, and EC 023. However, as Defendants argue,¹⁸ portions of this copied text are from “[f]actual works [which] receive distinct treatment from fictional works under copyright law.” *Worth v. Selchow*

¹⁷ As to the Legacy Works, Defendants failed to respond to ICC-ES’s request for admission regarding storage and transmission of the Legacy Works in the Laserfiche. *See* PSMF ¶¶ 602–03. Defendants also failed to supplement their disclosures once discovery of the Legacy Works commenced. *See* Minute Order (Jan. 22, 2021). And “[t]he duty to supplement or correct is self-executing—that is, it does not require a motion to compel for its enforcement.” *United States v. All Assets Held at Bank Julius Baer & Co.*, No. 04-cv-798, 2019 WL 1167743, at *4 (D.D.C. Mar. 13, 2019). Thus, Defendants’ failure to respond or supplement constitutes a deemed admission as to reproduction of the Legacy Works under Fed. R. Civ. P. 36(b). “Such deemed admissions may properly support a motion for summary judgment.” *Essroc Cement Corp. v. CTI/D.C., Inc.*, 740 F. Supp. 2d 131, 140 (D.D.C. 2010).

¹⁸ Defendants raised similar arguments against copyrightability, however, the factual elements of the Works at Issue are instead relevant for the infringement inquiry. *See Sturdza*, 281 F.3d at 1295–96 (isolating protectible expression to determine infringement).

& Righter Co., 827 F.2d 569, 572 (9th Cir. 1987) (citing *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 488 (9th Cir. 1984)). “Because authors who wish to express ideas in factual works are usually confined to a ‘narrow range of expression . . . , similarity of expression may have to amount to verbatim reproduction or very close paraphrasing before a factual work will be deemed *infringed*.” *Id.* (emphasis added). But “[t]he verbatim repetition of certain words in order to use the nonprotectible facts is [] noninfringing.” *Id.* at 573 (rejecting infringement claim because defendant trivia game developer’s verbatim repetition of certain words from plaintiff’s trivia books was “mere indispensable expression” in order to use nonprotectible facts or ideas).

Thus, the Court must compare the Accused Works with the Works at Issue, focusing on the protectible elements of expression to determine substantial similarity. *See Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65, 70–72 (2d Cir. 1999) (finding that copyright protected not the news itself but the author’s manner of expression).

In making this determination, the Court disregards several cosmetic changes made by Defendants in an attempt conceal verbatim copying. First, Defendants altered the title and numbering of the Accused Works.¹⁹ Second, regarding sections on product use and installation, Defendants replaced the word “must” with “shall.” *See, e.g.*, PSMF ¶ 528. Third, IAPMO-ES apparently engaged in the practice of swapping the order of the clauses in a sentence. *See id.* ¶ 529; *compare* ICC-ES’s AC 86 (“Installation of the wall assemblies in a structure shall be limited to interior applications where the superimposed axial load is zero pounds.”) *with* IAPMO’s EC

¹⁹ Except Defendants’ “UES 1835,” which utilizes the same report number as Plaintiffs’ “ESR-1835.” *See* PSMF ¶ 586.

004-2010 (“Where the superimposed axial load is zero pounds installation of the wall assemblies in a structure shall be limited to interior applications.”).

Standing alone, these “transparent, syntactic rearrangement of portions of [Plaintiffs’] copyrighted materials” do not rebut substantial similarity. *Kepner-Tregoe, Inc. v. Leadership Software, Inc.*, 12 F.3d 527, 535 (5th Cir. 1994).

However, given the challenge of proving substantial similarity on summary judgment, and after side-by-side review of the entire documents,²⁰ the Court finds that factual issues preclude a finding of substantial similarity as a matter of law. *See Hoehling*, 618 F.2d at 977. First, Defendants have raised genuine issues as to whether the Accused Works are substantially similar to the protectible expression of the Works at Issue as opposed to the unprotectible “indispensable expression” of particular facts. *Worth*, 827 F.2d at 573. For example, the trier of fact must perform that analysis for the parties’ respective reports on complex and technical products, such as “Taperlock Reinforcing Bar Mechanical Splice Couplers.” *See* ECF No. 210, Wise Ex. 185 (“ICC-ES ESR-2481”); ECF No. 209, Wise Ex. 59 (“IAPMO-ES’s UES ER 319”).

Second, Defendants have demonstrated at least some non-cosmetic changes to (arguably) *protectible* expression, for example, by moving information depicted in a table into the text of their report. *Compare* ECF No. 210, Wise Ex. 192 (“ICC-ES’s ESR-3511”) (“The deck boards are limited to the maximum allowable uniform load indicated in Table 1.”) *with* ECF No. 210, Wise Ex. 155 (“IAPMO-ES’s UES 380”) (“The deck boards are limited to a maximum allowable uniform load of 100 lbf/ft² (4.79 kPa).”). Defendants also occasionally changed the language used

²⁰ On January 10, 2022, the Court issued a Rule 56(e) request to the parties requesting additional information regarding their respective motions for summary judgment, including tables of contents that corresponded to CM/ECF system and a side-by-side comparison of the Works at Issue and the Accused Works to aid in the Court’s analysis.

to express information in the text of the report. *Compare* ICC-ES ESR-3511 (“The deck boards have been evaluated for use at ambient air temperatures between -20°F (-29°C) and 125°F (52°C).”) *with* IAPMO-ES’s UES 380 (“The deck boards may be used at service temperatures between -20°F and 125°F (-29°C) and 52°C.”). Defendants also intermittently added additional information not previously found in the respective Work at Issue. *Compare* ICC-ES ESR-2481 (“The Taperlock coupler is a tapered threaded coupler available in three basic styles: Standard (01), Transitional (02), and Positional (03).”) *with* IAPMO-ES’s UES ER 319 (“The Taperlock Reinforcing Bar Couplers consist of a tapered threaded system in four different configurations known as Standard, Flange, Transitional, and Positional.”). These differences raise a genuine question of whether Defendants’ Accused Works are substantially similar to the protectible elements (i.e., the expression) of the Plaintiffs’ Works at Issue. *See, e.g., Peter Letterese And Assocs., Inc. v. World Inst. Of Scientology Enterprises*, 533 F.3d 1287, 1302–07 (11th Cir. 2008) (denying summary judgment in copyright infringement action where genuine issues of material fact precluded determination of substantial similarity between protected elements of copyrighted book on sales techniques and course materials used by church organizations on sales techniques, despite the same content, same selection and organization of materials, and several instances of verbatim copying).

D. Affirmative Defenses

Defendants’ asserted affirmative defenses of fair use and implied license fail as a matter of law.

1. *Fair Use*

The Copyright Act includes a carve out in copyright infringement for one’s “fair use” of another’s copyrighted material. 17 U.S.C. § 107. “Fair use, when properly applied, is limited to

copying by others which does not materially impair the marketability of the work which is copied.”

Harper & Row, 471 U.S. at 566–67. A fair use determination requires consideration of the following four nonexclusive factors:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107. Defendants claim that any use of protectible expression in Plaintiffs’ the Works at Issue is “fair use.” *See* Defs.’ Mot. at 35.

a. Purpose and Character

Regarding the purpose and character of the use, courts often consider whether the use was for a commercial purpose and the transformative nature of the use. *See ASTM II*, 896 F.3d at 449. The purpose and character of Defendants’ use as to all Works at Issue, except ICC-ES’s AC 11 and AC 51, weighs strongly against a finding of fair use. ICC-ES’s AC 11 and AC 51 are outliers for which the purpose and character factor is neutral.

i. Commercial Purpose

Copies made for commercial purposes are presumptively unfair. *See Sony Corp. of America v. Universal City Studios Inc.*, 464 U.S. 417, 449 (1984). “The crux of the profit/non-profit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.” *Television Dig.*, 841 F. Supp. at 9 (quoting *Harper & Row*, 471 U.S. at 562). It is undisputed that Defendants’ reproduction of the Works at Issue was for commercial purposes and that they did not

pay Plaintiffs the customary price to obtain the Works at Issue. *See* PSMF ¶ 631. That Defendants used the Works at Issue for the same commercial purpose as Plaintiffs further weighs against fair use. *See Supermarket of Homes, Inc. v. San Fernando Valley Bd. of Realtors*, 786 F.2d 1400, 1409 (9th Cir. 1986). Indeed, Defendants duplicated Plaintiffs’ Works at Issue to directly compete with Plaintiffs for sales to Plaintiffs’ customers. *See* PSMF ¶¶ 624–26.

Concerning this factor, Defendants’ primary argument is that their evaluation reports and acceptance criteria “serve a significant public benefit by demonstrating the compliance of a product, method or system with the applicable building code to ensure public safety.” Defs.’ Mot. at 38. Defendants’ argument fails because “societal benefit does not guarantee a finding of fair use,” *Infinity Broadcast Corp. v. Kirkwood*, 150 F.3d 104, 110 (2d Cir. 1998), particularly where the primary purpose is profit-driven. “It is virtually axiomatic that the public interest can only be served by upholding copyright protections and correspondingly, preventing the misappropriation of skills, creative energies, and resources which are invested in the protected work.” *Fox Television Stations, Inc. v. FilmOn X LLC*, 966 F. Supp. 2d 30, 51 (D.D.C. 2013) (cleaned up).

ii. Transformative use

A “transformative” use is “a copying use that adds something new and important.” *Google*, 141 S. Ct. at 1203 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)). Each of the Works at Issue were copied either wholly or in large part by Defendants. *See supra* Part III.C.1. “There is little transformative about copying the entirety or large portions of a work verbatim.” *Nihon Keizai Shimbun*, 166 F.3d at 72. Thus, Defendants’ “excessive copying precludes fair use.” *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 758 (9th Cir. 1978).

The outliers under this subfactor are for ICC-ES’s acceptance criteria AC 11 and AC 51, which Defendants’ used to create *evaluation reports* as opposed to replacement acceptance criteria.

See Defs.’ Mot. at 43–44. Defendants’ evaluation reports do not serve the same purpose as, and are not a replacement product for, ICC-ES’s respective acceptance criteria. See PSMF ¶¶ 44, 59. While the use of copyrighted material is more likely to be considered fair where it serves a different function, see *Hustler Mag., Inc. v. Moral Majority, Inc.*, 606 F. Supp. 1526, 1535 (C.D. Cal. 1985), *aff’d*, 796 F.2d 1148 (9th Cir. 1986), the commercial purpose of Defendants’ use of AC 11 and AC 51 was to make profit, without paying *anything* to Plaintiffs, which ultimately outweighs the transformative element of the use by Defendants. See *Television Dig.*, 841 F. Supp. at 9.

b. Nature of the Work

Regarding the nature of the work, courts evaluate 1) whether the work was creative or factual and 2) whether the work was unpublished or published. See *Harper & Row*, 471 U.S. at 563–64.

“The law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy.” *Id.* at 563. Despite the factual nature of the Works at Issue, this factor “does not provide strong support for a fair use finding, since [D]efendants copied both the factual and the expressive elements of [P]laintiffs’ [Works at Issue].” *Los Angeles Times v. Free Republic*, No. CV 98-7840, 2000 WL 565200, at *21 (C.D. Cal. Apr. 4, 2000). Indeed, Defendants made copies of the Works at Issue in their entirety. See *supra* Part III.C.1. “[A]uthors of factual works, like authors of fiction, should be entitled to copyright protection of their protected expression.” *Authors Guild v. Google*, 804 F.3d 202, 220 (2d Cir. 2015).

The fair use doctrine generally accords less protection to published works based on the premise that a “plaintiff’s right to control the first public appearance of the [work] is not implicated [t]here, nor does there exist any issue as to a ‘race to publish.’” *Mathieson v. Associated Press*, No. 90 CIV. 6945, 1992 WL 164447, at *6 (S.D.N.Y. June 25, 1992). That premise does not apply

here. Although all but one of the Works at Issue were published, each of Plaintiffs' evaluation reports and acceptance criteria require periodic amendment and republication. *See* PSMF ¶ 61. Thus, Plaintiffs have a commercial interest not only in a Work's first public appearance but also in its republication. Indeed, Defendants attempted to compete with Plaintiffs by engaging in a "race to publish" the reissued works. *See* PSMF ¶¶ 624–26. Thus, this factor weighs against a finding of fair use.

c. Amount and Substantiality

As to amount and substantiality, Defendants not only copied *entire* Works at Issue but also saved them to Defendants' internal file system and distributed many of them through emails. *See* PSMF ¶¶ 511, 517–21, 525–29, 534–46, 636–45. "[T]he fact that a substantial portion of [each] infringing work was copied verbatim is evidence of the qualitative value of the copied material, both to the originator and to the plagiarist who seeks to profit from marketing someone else's copyrighted expression." *Harper & Row*, 471 U.S. at 565. Because of the volume of copying and sharing, this factor weighs against fair use. *See Television Digest*, 841 F. Supp. at 9 (quoting *id.* at 560) (denying fair use defense on summary judgment where "the entire copyright work was used" and the defendant made multiple copies for internal distribution).

d. Effect Upon the Potential Market

"[T]he effect of the use upon the potential market for or value of the copyrighted work is 'undoubtedly the single most important element of fair use.'" *Television Dig.*, 841 F. Supp. at 10 (quoting *Harper & Row*, 471 U.S. at 566). "The potential for harm to a copyrighted work arises if the defendant's use would tend to diminish the sales of the plaintiff's work, interfere with its marketability or fulfill the demand for the original." *Hustler Mag.*, 606 F. Supp. at 1539.

Defendants' copying of Plaintiffs' evaluation reports was key to Defendants' "Transfer and Save" campaign, which Defendants marketed toward capturing ICC-ES's customers. PSMF ¶¶ 624–26. Defendants copied ICC-ES's language and then represented their evaluation service as faster and less expensive than ICC-ES's evaluation service. *See* PSMF ¶¶ 620–29. Defendants claimed to prospective customers: "Our evaluation reports are equal in every way to the reports that you have been receiving from ICC-ES." *See* PSMF ¶ 721; ECF No. 209, Wise Ex. 73. Defendants "sufficiently offer[] the [Plaintiffs'] work in a secondary packaging that potential customers, having read the secondary work, will no longer be inclined to purchase [from Plaintiff]." *New Era Publ'ns Int'l, ApS v. Henry Holt & Co.*, 695 F. Supp. 1493, 1522 (S.D.N.Y. 1988), *aff'd*, 873 F.2d 576 (2d Cir. 1989). Defendants' use is a "superseding use, fulfilling demand for the original." *Campbell*, 510 U.S. at 587–88.

Defendants claim that this factor cannot favor Plaintiffs, because Plaintiffs have not lost market share and in fact have increased their revenue in each year from 2013 to 2019. *See* Defs.' Mot. at 41. This argument is unavailing. The effect on market is measured by the *potential* market and "[a]ctual present harm need not be shown." *Sony*, 464 U.S. at 451. Defendants fail to show that their "copying . . . does not materially impair the marketability of the work which is copied." *Harper & Row*, 471 U.S. at 567. Indeed, Defendants' wholesale copying and digital distribution of ICC-ES's acceptance criteria, including AC 11 and AC 51, deprived ICC-ES of licensing revenue. *See* PSMF ¶¶ 638–41. Defendants' copying thus harmed Plaintiffs' market. *See Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 930-31 (2d Cir. 1994) (finding the fourth factor to favor owners of copyrighted scientific journal articles based on "lost licensing revenue"). The detrimental effect of Defendants' copying on the market weighs strongly against fair use.

Because all factors oppose fair use, Defendants cannot invoke it as a defense.

2. *Implied License*

Defendants argue that when Plaintiffs learned of a customer's plan to transfer, "Plaintiffs did not tell their customers that such a transfer and derivative work creation would be beyond the scope of the customers' limited license," which "was, at least impliedly, licensing the creation of the Accused Works in question" pursuant to 17 U.S.C. § 501. Defs.' Opp. at 3–4. Instead, after losing a client, Plaintiffs would email that client expressing Plaintiffs' "respect" for the decision to renew Plaintiffs' report with a different provider. *See* Defs.' CSMF ¶¶ 830–31.

This argument ignores that these transferring clients previously signed agreements with ICC-ES "not to disclose any such information to others without prior written approval of ICC-ES." ECF No. 202, Johnson Ex. 31M, 31W. Neither these emails nor the Plaintiff's sentiment toward transferring customers imply anything other than the Plaintiffs' good manners. No reasonable jury could imply a license here, particularly where Defendants offer no caselaw to support such an illogical leap.

E. Permanent Injunction

Plaintiffs seek a permanent injunction pursuant to 17 U.S.C. § 502(a) prohibiting Defendants and their employees and agents from any future infringement of Plaintiffs' copyrighted works. *See* Pls.' Mot. at 39. A court has discretion to grant "injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright." 17 U.S.C. § 502(a). In making this determination, the court "considers a modified iteration of the factors it utilizes in assessing preliminary injunctions: (1) success on the merits, (2) whether the plaintiffs will suffer irreparable injury absent an injunction, (3) whether, balancing the hardships, there is harm to defendants or other interested parties, and (4) whether the public interest favors granting the injunction." *ACLU v. Mineta*, 319 F.Supp.2d 69, 87 (D.D.C. 2004).

First, Plaintiffs have partially succeeded on the merits; the Defendants' reproduction of the Works at Issue constitutes copyright infringement. *See supra* Part III.C.1. The Plaintiffs have further provided strong evidence of Defendants' infringement in creating the Accused Works. *See, e.g.*, PSMF ¶¶ 504, 527–30, 532–593.

Second, “a copyright holder is ‘presumed to suffer irreparable harm as a matter of law when his right to the exclusive use of copyrighted material is invaded.’” *Wondie v. Mekuria*, 742 F. Supp. 2d 118, 123 (D.D.C. 2010) (quoting *Health Ins. Ass’n of Am. v. Novelli*, 211 F. Supp. 2d 23, 28 (D.D.C. 2002)). Irreparable harm is particularly likely here given Defendants' unwillingness to cease copying Plaintiffs' copyrighted works. *See* PSMF ¶ 632. Despite numerous objections from ICC-ES, including bringing this lawsuit, Defendants' engineers have continued to copy from and use ICC-ES Evaluation Reports as templates for publishing competing “UES Evaluation Reports.” PSMF ¶¶ 485, 511–12, 525, 632–35. IAPMO has done nothing to ensure that going forward IAPMO-ES does not engage in copying of ICC-ES publications without authorization. PSMF ¶¶ 635, 641–43. This “continuing disregard for Plaintiff[s]' rights demonstrates that Defendant[s] will continue to infringe on Plaintiff[s]' rights, absent an injunction . . . , [which] alone entitles Plaintiff[s] to a permanent injunction.” *Lifted Research Grp., Inc. v. Behdad, Inc.*, 591 F. Supp. 2d 3, 8 (D.D.C. 2008).

Third, the balance of hardships favors Plaintiffs. Despite likely harm of an injunction to Defendants, “[Defendants] ha[ve] no cognizable interest in continuing to infringe Plaintiffs' copyrights and thus cannot complain of the harm it will suffer if ordered to cease doing so.” *Fox Television Stations*, 966 F. Supp. 2d at 51 (citing *Fox Television Sys., Inc. v. BarryDriller Content Sys., PLC*, 915 F. Supp. 2d 1138, 1148–49 (C. D. Cal. 2012)). Conversely, without an injunction,

Plaintiffs may continue to be harmed by Defendants’ copying and creating copies of the Works at Issue. *See Wondie*, 742 F. Supp. 2d at 123.

Finally, “the public interest favors protecting the plaintiff’s copyright and federal copyright law.” *Id.* (citing *Behdad*, 591 F. Supp. 2d at 8); *see also BarryDriller*, 915 F.Supp.2d at 1148–49 (finding that the third and fourth factors of injunction analysis favor plaintiffs because defendant had “no equitable interest in continuing an infringing activity”). Thus, a permanent injunction prohibiting Defendants and their employees and agents from any future infringement of Plaintiffs’ copyrighted works is warranted.

F. Damages

1. *Statutory Damages*

Plaintiffs are entitled to statutory damages for each Work at Issue registered either within three months of first publication or prior to the act of infringement. *See* 17 U.S.C. §§ 412, 504(c)(1). Of the Contemporary Works, it is undisputed that ICC-ES registered ESR-1647 within three months of first publication and thus its infringement warrants statutory damages. *See* PSMF ¶¶ 143–44. Further, the infringement of all Legacy Works warrants statutory damages because each Legacy Work was registered prior to IAPMO-ES’s creation in 2003 and thus prior to its infringement. PSMF ¶¶ 253–54, 481. The remaining Contemporary Works are ineligible for statutory damages.

2. *Willfulness*

Where “infringement was committed willfully,” the Copyright Act provides for statutory damages of up to \$150,000 per work infringed. 17 U.S.C. § 504(c)(2). “To prove willfulness, plaintiffs must show that the infringer had actual or constructive knowledge that it was infringing the plaintiffs’ copyrights or else acted in reckless disregard of the high probability that it was

infringing plaintiffs' copyrights." *Arclightz & Films Pvt. Ltd. v. Video Palace Inc.*, 303 F. Supp. 2d 356, 361–62 (S.D.N.Y. 2003). "Generally, a determination as to willfulness requires an assessment of a party's state of mind, a factual issue that is not usually susceptible to summary judgment." *Sega Enterprises*, 948 F. Supp. at 936 (citing *Hearst Corp. v. Stark*, 639 F. Supp. 970, 980 (N.D. Cal.1986)).

Plaintiffs proffer a wealth of evidence suggesting Defendants knew they were infringing upon Plaintiffs' copyrights. Much of that evidence relates to the Defendants' pursuit of creating the Accused Works. *See, e.g.*, PSMF ¶¶ 523, 524, 526, 632. For example, Defendants removed Plaintiffs' copyright notice and added a copyright notice of their own to the Accused Works. *See* PSMF ¶ 538. While this actions certainly suggests knowledge of infringement, *see Mango v. BuzzFeed, Inc.*, 356 F. Supp. 3d 368, 373–74 (S.D.N.Y. 2019), *aff'd*, 970 F.3d 167 (2d Cir. 2020) (finding willfulness where veteran reporter familiar with obtaining permission and using gutter credits copied a photograph), this Court has not made a determination on infringement as to Accused Works at this stage of litigation and leaves any determination on willfulness for the fact finder. Relatedly, as to the reproductions (i.e., copies) of the Works at Issue stored by Defendants and found to be infringing, Plaintiffs offer evidence from which a jury could imply willfulness, such as each Work at Issue's copyright notice. "Nevertheless, at the summary judgment stage, although an inference of constructive knowledge or reckless conduct seems the better of the possible inferences that can be drawn, we must still draw all inferences in favor of the non-moving party." *Island Software & Computer Serv., Inc. v. Microsoft Corp.*, 413 F.3d 257, 264 (2d Cir. 2005) (reversing district court's finding of enhanced damages where fact issues existed as to whether infringement was willful).

IV. RECOMMENDATION

For the reasons states above, the Court RECOMMENDS GRANTING in part Plaintiffs' motion for summary judgment as to the following findings of material fact for which there exists no genuine issue:

- Plaintiffs have established ownership in the copyrights for all Works at Issue;
- All Works at Issue are supported by valid copyrights;
- Defendants infringed upon Plaintiffs Works at Issue through reproduction;
- Defendants' infringement of Plaintiffs' Work at Issue was not fair use

and DENYING in part Plaintiffs' motion as to infringement through creation of the Accused Works and damages and DENYING Defendants' motion for summary judgment. The Court further RECOMMENDS that Defendants and all persons acting under the direction, control, permission, or authority of Defendants are permanently ENJOINED AND RESTRAINED from infringing by any means upon Plaintiffs' current and future copyrighted works without proper authorization.

V. REVIEW BY THE DISTRICT COURT

The parties are hereby advised that, under the provisions of Local Rule 72.3(b) of the United States District Court for the District of Columbia, any party who objects to the Report and Recommendation must file a written objection thereto with the Clerk of this Court within 14 days of the party's receipt of this Report and Recommendation. The written objections must specifically identify the portion of the report and/or recommendation to which objection is made and the basis for such objections. The parties are further advised that failure to file timely objections to the findings and recommendations set forth in this report may waive their right of appeal from an order

of the District Court that adopts such findings and recommendation. *See Thomas v. Arn*, 474 U.S. 140, 144–45 (1985).

ZIA M. FARUQUI
UNITED STATES MAGISTRATE JUDGE