

United States District Court, S.D. New York.

O.P. SOLUTIONS, INC., Plaintiff,

v.

INTELLECTUAL PROPERTY NETWORK, LTD., Defendant.

No. 96 Civ. 7952(LAP).Feb. 2, 1999.

Opinion

MEMORANDUM AND ORDER

PRESKA, J.

*1 Plaintiff O.P. Solutions (“OPS”) has sued defendant Intellectual Property Network, Ltd. (“IPN”), alleging copyright infringement, false designation under the Lanham Act, common law trade dress infringement, common law unfair competition, and trade secret misappropriation. This memorandum and order addresses IPN’s motion for summary judgment on all counts, and plaintiff’s cross-motion for summary judgment on the copyright count. For the reasons discussed below, the motions are denied.

I. BACKGROUND

OPS designs, develops, markets and services computer software programs, among which are programs that cater to law firms with intellectual property practice areas. These programs assist such firms in managing the prosecution of patent and trademark applications. (Complaint ¶ 4). At the time it filed its complaint OPS had released three such programs: “PATTSY FOR DOS DATAEASE VERSION,” released in 1991 (“Patsy Dataease DOS”) (Complaint ¶¶ 6–10); “PATTSY FOR WINDOWS DATAEASE VERSION,” released in 1994 (“Patsy Dataease Windows”) (Complaint ¶¶ 11–15); and “PATTSY FOR WINDOWS—MS ACCESS VERSION,” released in 1996 (“Patsy MS Access”) (Complaint ¶¶ 16–20). OPS’s programs will be referred to collectively as “PATTSY” or the “PATTSY programs”.

IPN also develops and markets trademark practice management programs, and in fact has done so for longer than OPS has. IPN released its first such program in 1986, and has released six more since then. This suit centers on OPS’s claim that its PATTSY programs were infringed by two recent IPN programs, “WorldMark 4.0 for Windows” and “WorldMark 4.1 for Windows,” each of which was released in 1996.¹ The allegedly infringing programs will be referred to collectively as the “WorldMark Windows Programs”.

Each company’s programs “assist trademark attorneys and owners in procuring, renewing and managing trademark portfolios.” (Supplemental Declaration of Laurent Delrieu, ¶ 1). The parties seem to agree that successful portfolio management requires a certain number of functions. To this end, the programs allow their users to: store general information on each of their clients; store information about each client’s particular applications; identify each necessary action that must be taken in the course of a successful trademark prosecution; record information about each action taken in the prosecution of the action; calculate, based on the date that a given action was taken, the date on which the next required

action should be taken; and carry out “docket notification” services, i.e., notify responsible individuals within the firm of impending deadlines.

For example, PATTSY assists attorneys in tracking and meeting deadlines and prompts them to take “follow-up” actions during the course of an application. So-called “follow-up” actions include filing responses to actions by the Patent and Trademark Office of the U.S. Department of Commerce (the “PTO”), as well as engaging in general “due diligence” by checking up on and inquiring about the status of pending applications. For example, the PTO encourages practitioners to enclose with papers filed with the PTO a stamped, self-addressed envelope. Upon receipt of the papers, the PTO stamps the receipt date on the card and returns the card to the sender. As the PTO itself has noted, “[t]hese cards are useful in helping one learn of the possibility of abandonment, and such a card can be used as evidence in support of a petition to revive [a lapsed registration].” See Patent and Trademark Office, U.S. Dep’t of Commerce, Trademark Manual of Examining Procedure (“TMEP”) § 1112.05(b)(iii) (2d Ed., 1st Rev. Ed.1997) (copy annexed as Exhibit A to declaration of Jeffrey M. Samuels in Support of Def. Motion for Dismissal/Summary Judgment, signed August 1, 1997). The programs allow users to track return-receipt of the post-card and will automatically trigger a “tickler” to responsible individuals approximately one month after the papers are sent to the PTO.

*2 Because many of these deadlines and filing periods are derived from the statutes and administrative rules of the jurisdictions in which the applications are prosecuted, the programs also contain “law files” which house different countries’ relevant statutory and administrative deadlines. For example, the time limit to respond to a PTO action is set by statute. See e.g., 15 U.S.C. § 1062(b) (granting applicant six months in which to reply to PTO’s refusal to register the mark; failure to respond results in application being deemed abandoned unless applicant makes showing of “unavoidable delay”). The programs calculate the statutory or rule-based due date and then generate reminders to responsible individuals (up to two attorneys and a paralegal) some period of time in advance of that due date.

OPS concedes that the functions described above are indispensable to a successful trademark portfolio application system and acknowledges that “prior programs operated to docket information to responsible individuals, calculated dates and kept track of the status of a trademark filing.” (OPS Mem. at 3). Indeed, as OPS notes, “[a]ll trademark docketing systems use a process whereby data is entered and displayed,” and many such programs “calculate a date and display it.” (OPS Mem. at 12). Not surprisingly, OPS does not seek protection for these functions themselves but instead argues that “there are many ways to form th[ese] display[s]” and the way chosen by OPS is unique and “expressive” for copyright purposes. (OPS Reply Mem. at 10). In short, as it explained at argument, OPS seeks to protect the overall “look and feel” of its program. Whether and to what degree PATTSY is entitled to such protection lies at the heart of this case.

II. COPYRIGHT INFRINGEMENT GENERALLY

In any suit for copyright infringement, the plaintiff must establish (1) its ownership of a valid copyright, and (2) that the defendant copied constituent elements of the work that are original. *Feist Publications, Inc. v. Rural Telephone Serv. Co.*, 499 U.S. 340, 361, 111 S.Ct. 1282, 1296 (1991); *Computer Assoc., Inc. v.*

Altai, Inc., 982 F.2d 693 (2d Cir.1992). Here, OPS has registered the PATTSY programs with the U.S. Copyright office, which serves as prima facie evidence of ownership of a valid copyright. 17 U.S.C. § 410(c); Fonar Corp. v. Domenick, 105 F.3d 99, 104 (2d Cir.1997). For the purposes of this motion IPN does not dispute that the first prong of the infringement test is met. (See IPN Reply Mem. at 2). Thus the inquiry in this case focuses on Feist's second prong, i.e., whether IPN has copied original constituent elements so as to constitute infringement.

A. Copying of Original Constituent Elements

Feist's second prong—copying of original constituent elements—itself involves two separate inquiries: “1) whether the defendant, as a factual matter, copied portions of the plaintiff's program; and 2) whether, as a mixed issue of fact and law, those elements of the program that have been copied are protected expression and of such importance to the copied work that the appropriation is actionable.” Mitek Holdings Inc. v. Arce Eng'g Co., 89 F.3d 1548, 1554 (11th Cir.1996) (quoting Gates Rubber Co. v. Bando Chem. Indus., Ltd., 9 F.3d 823, 832 (10th Cir.1993)). Stated differently, a plaintiff must establish both that the defendant copied in the factual sense and that that copying, as a legal matter, constituted prohibited copyright infringement.

1. Copying as a Factual Matter: Did the Defendant Copy Plaintiff's Program?

*3 A plaintiff may establish copying either by direct or indirect evidence. Not surprisingly, plaintiffs rarely acquire direct evidence of copying. Rather, in most cases a plaintiff will attempt to show copying through indirect evidence. To do so, the plaintiff must establish that (1) the defendant had access to the plaintiff's copyrighted work and (2) the defendant's work is “substantially” or, more clearly, “probatively” similar to the plaintiff's work.

a. Access

IPN does not seriously dispute that it had access to the elements of the PATTSY programs alleged to have been copied. PATTSY programs have been publicly available since 1991. Further, OPS has had a presence at industry conferences, where it has rented display booths, demonstrated PATTSY to visitors, and distributed promotional copies of the PATTSY demonstration disk, which contained software displaying the PATTSY screens and provided detailed descriptions of the available functions. (See Declaration of Spenser Siskind (“Siskind Decl.”) ¶ 20). Further, OPS alleges that IPN representatives visited the OPS booth at a 1993 trade show, and intimates that IPN individuals stole a PATTSY user manual from that booth. (Siskind Decl. ¶ 19). OPS contends that these facts establish that IPN had access to the PATTSY program and, as noted above, IPN does not seriously contest that it had access to the allegedly infringed PATTSY programs.

b. “Substantial” or “Probative” Similarity

(1) Standard

Courts often use the term “substantial similarity” to describe the standard by which a court must evaluate whether, as a factual matter, a defendant copied a plaintiff's work. Use of the word

“substantial” in this context is unfortunate because that term is also used to describe the test for determining, after actual copying is established, whether as a legal matter such copying constitutes actionable copyright infringement. As a result, the Court of Appeals has “noted that the term ‘probative similarity’ should be used when referring to the initial burden of proving copying by establishing access and/or similarities.” See *Repp v. Webber*, 132 F.3d 882, 889 n. 1 (2d Cir.1997) (noting that copyright caselaw has caused considerable confusion by the use of the term “substantial similarity” at two different points of the copyright infringement analysis), cert. denied, 119 S.Ct. 52 (1998). “Probative similarity,”—the standard for determining copying as a factual matter—is a less-demanding standard than “substantial similarity”—the standard for determining whether copying is actionable as a legal matter. The probative similarity standard has been described as follows:

when the question is copying as a factual matter, then similarities that, in the normal course of events, would not be expected to arise independently in the two works are probative of defendant's having copied as a factual matter from plaintiff's work.

Nimmer, § 13.03[B], at 13–11 to 13–13.

*4 When evaluating probative similarity, a court should compare the works in their entirety, including both protectable and unprotectable elements. See *Fisher–Price, Inc. v. Well–Made Toy Mfg. Corp.*, 25 F.3d 119, 123 (2d Cir.1994). This is appropriate because although the plaintiff must ultimately establish infringement by showing that the defendant copied a substantial amount of protectable elements, (i.e., meet the “substantial similarity” standard), the fact that non-protectable elements were copied, although not a basis for liability, can be probative of whether protected elements were copied (i.e., help establish probative similarity). See *Gates Rubber*, 9 F.3d at 832 n. 7 (explaining that failure to consider nonprotectable elements when evaluating question of actual copying deprives court of “probative, and potentially essential, information on the factual issue of copying”).

While copying as a factual matter typically depends on evidence of access and probative similarity, presentation of such evidence does not compel the trier of fact to find actual copying. Indeed, even after proof of access and probative similarity a trier of fact may be justified in finding no copying “if such trier believes the defendant's evidence of independent creation.” Nimmer § 13.01[B], at 13–13. Nonetheless, evidence of independent creation will not defeat a finding of copying where the similarity between the two works is such that “no explanation other than copying is reasonably possible.” *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 1092 n. 2 (2d Cir.1977) (quotation omitted); *R. Dakin & Co. v. Charles Offset Co.*, 441 F.Supp. 434 (S.D.N.Y.1977); Nimmer § 13.01[B], at 13–13.

(2) Application

OPS seeks to establish actual copying by demonstrating that IPN's programs are “substantially similar” to OPS's programs; I presume that OPS's use of the term “substantially similar” in this context to refer to the “probative similarity” standard discussed above. To make this showing, OPS details a number of elements of the two programs taken from the “List of Similarities” that the parties prepared during the course of preliminary discovery in this matter and argues that the quantity and degree of similarity between the programs ineluctably leads to the conclusion that the WorldMark Windows Programs were

copied from PATTSY. In support of these arguments OPS provides expert evidence which concludes that IPN must have copied the program structure from OPS. (See Declaration of Dr. Kenneth A. Ross (“Ross Decl.”) ¶¶ 24–25). In fact, one of OPS's experts comes to the conclusion that “the similarities between PATTSY and WorldMark 4.0 are so extensive that in fact, if were I[sic] to receive these two programs as homework assignments from students in one of my database classes, my conclusion could only be that one student had copied from another.” (Ross Decl. ¶ 11).

I will assume without deciding that OPS has met its burden of demonstrating actual copying. As explained below, however, summary judgment is nonetheless inappropriate because issues of fact exist as to whether any copying that IPN has engaged in constitutes actionable infringement.

2. Copying as a Legal Matter: Is Defendant's Copying Actionable?

*5 As noted above, it is not enough for the plaintiff to establish that the defendant copied all or some of the work in question; the plaintiff must also establish that the copying in question is unlawful. See *Fisher–Price, Inc.*, 25 F.3d at 123. As the *Fisher–Price* court noted,

[p]arrotty does not always mean piracy, however. The plaintiff must also show illegality, and this requires a sharper focus; the court must find a substantial similarity between the protectable elements of the two works. That is, the plaintiff must show that defendant appropriated the plaintiff's particular means of expressing an idea, not merely that he expressed the same idea.

Id. In determining whether the copying is unlawful and hence actionable, the critical question is whether there is so-called “substantial similarity” between the defendant's work and the protectable elements of the plaintiff's work. *Repp v. Webber*, 132 F.3d at 889 (“It is only after actual copying is established that one claiming infringement is required to show substantial similarity between the two works relating to protectable material.”); *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 140–41 (2d Cir.1992). This inquiry differs from the probative similarity inquiry described above in that it inquires only whether there is such extensive copying of the protected elements to establish infringement.

Here, IPN seeks a summary judgment finding of non-infringement on the ground that the programs are not “substantially similar” for copyright purposes because any similarity that does exist between the programs relates exclusively to unprotectable material. For its part, OPS contends there is sufficient similarity between the protectable elements of the program to justify a summary judgment of infringement.

“Although the issue of substantial similarity often raises questions of fact not appropriately resolved on a motion for summary judgment, ‘a district court may determine noninfringement as a matter of law on a motion for summary judgment either when the similarity concerns only noncopyrightable elements of plaintiff[s] work, or when no reasonable trier of fact could find the works substantially similar.’” *Productivity Software Int'l Inc. v. Healthcare Technologies, Inc.*, No. 93 Civ. 6949(RPP), 1995 WL 437526, at *2 (S.D.N.Y. July 25, 1995) (quoting *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48 (2d Cir.), cert. denied, 476 U.S. 1159 (1986)). In light of these claims, the next section addresses how copyright law applies to computer programs generally and how that law applies here.

III. COPYRIGHT PROTECTION OF COMPUTER PROGRAMS

The Court of Appeals addressed the copyrightability of computer programs in *Computer Associates, Int'l Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir.1992), creating its well-known three-part test to determine whether the “non-literal” elements of two computer programs are “substantially similar” for copyright purposes. In this case the parties have focused extensively, almost exclusively, on that case and the framework of analysis it set forth. As explained below, given what precise elements of its product that OPS seeks to protect, I wonder whether use of the Altai rubric is entirely appropriate here. Nevertheless, because that case ultimately instructs courts to apply the tests traditionally applied in copyright cases, it is useful to refer to its teachings.

*6 Before creating its test, the court addressed the threshold question of whether programs should be protected at all. The court noted that in 1980, Congress amended the Copyright Act to include for the first time a definition of “computer program.” To this end, the Act defines a computer program as “a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.” 17 U.S.C. § 101. Legislative history indicates that Congress intended computer programs to be considered “literary works” for the purposes of the Copyright Act. See H.R.Rep. No. 94–1476, at 54 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5667. “Literary works,” in turn, are defined as “works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.” 17 U.S.C. § 101.

Just like regular literary works such as novels and short stories, computer programs contain both “literal” and “non-literal” elements. Literal elements consist of actual computer programming codes, of which there are two kinds: “source code,” which consists of human readable instructions actually typed in by the programmer, and “object code,” which consists of the machine readable instructions that dictate how the computer behaves. “Source code” is created using human language; “object code” is created using language that only the computer can understand, often consisting exclusively of a series of zeros and ones. Source code is translated to object code during a process called compilation. See *Altai*, 982 F.2d at 702.

In contrast, a computer's “non-literal” elements consist of elements other than the code, and may generally be described as the “structure, sequence, and organization” of the underlying program. These elements include “general flow charts, as well as the more specific organization of inter-modular relationships, parameter lists, and macros.” *Altai*, 982 F.2d at 702. As defined and understood in *Altai*, such non-literal elements include the conceptual underpinnings and theoretical structure of the program itself. Courts have extended this understanding of “non-literal” elements beyond the program's conceptual scheme to include the program's output, such as the screen displays and user interfaces, menus, and “command tree” structures² contained on the screens. See *Mitek*, 89 F.3d at 1555 n. 15. That protection extends to non-literal elements is not surprising; as noted by Judge Learned Hand, “[i]t is of course essential to any protection of literary property that the right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations.” *Nichols v. Universal Pictures Co.*, 45 F.2d 119, 121 (2d Cir.1930) (L.Hand, J.), cert. denied, 282 U.S. 902, 51 S.Ct. 216 (1931). To this end,

liability will attach where the “fundamental essence or structure” of one work is duplicated in another, even if the so-called “literal” elements of the work are not similar. See *Altai*, 982 F.2d at 701 (citing 3 *Nimmer*, § 13.03[A][1], at 13–24).

*7 As noted above, in *Altai* the Court of Appeals created a three-part test to determine whether the non-literal elements of two computer programs are “substantially similar” for copyright purposes. 982 F.2d 682. While the *Altai* framework of analysis is customized to apply to the non-literal elements of computer programs, at bottom, the test instructs courts to do what all courts do when evaluating infringement claims: compare the protectable elements of each work to determine whether they are so “substantially similar” as to justify a finding of infringement. *Altai*, 982 F.2d at 706.3 The *Altai* Court termed the steps “abstraction,” “filtration,” and “comparison.”

A. Abstraction

The abstraction portion of the test is directed at identifying what aspects of the work fall within the subject matter of copyright. Viewing the work in varying levels of abstraction “help[s] a court separate ideas [and processes] from expression and eliminate from the substantial similarity analysis those portions of the work that are not eligible for copyright protection.” *Engineering Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1342 (5th Cir.1994) (citing *Nimmer* § 13.03[F] at 13–102.17).

Because the copyright holder bears the ultimate burden of establishing infringement, in cases where “the copyright holder presents the court with a list of features that it believes to be protectable (i.e., original and outside of 17 U.S.C. § 102(b)), the court need not abstract further such features.” *Mitek*, 89 F.3d at 1555; see *Softel Inc. v. Dragon Medical and Scientific Comm., Inc.*, 118 F.3d 955, 969 n. 9 (2d Cir.1997) (citing *Mitek* with approval and noting that a court applying the *Altai* test is responsible only to “analyze evidence properly brought before it by a party”).⁴

In this case, following the *Mitek* court's suggestion (see OPS Moving/Opp. Mem at 17), OPS has presented a list of 160 PATTSY elements which it maintains (1) are protectable, and (2) were illegally copied by IPN. Both parties agree that, under *Mitek* and its approval in *Softel*, I need not abstract this list further. Accordingly, I accept OPS's list of similarities as its evidence of an abstracted list of the allegedly similar, protectable elements of its program and will proceed to filter those elements through the various doctrines which limit the scope of copyright protection.

B. Filtration

As noted above, *Altai*'s second step dictates that the court employ a “successive filtering” method for separating protectable expression from unprotectable material. As stated by the *Altai* court,

[t]his process entails examining the structural components at each level of abstraction to determine whether their particular inclusion at that level was “idea” or was dictated by considerations of efficiency, so as to be necessarily incidental to that idea; required by factors external to the program itself; or taken from the public domain.

*8 Altai, 982 F.2d at 707. The filtration step merely “appl[ies] well developed doctrines of copyright law” and may “leave behind a ‘core of protectable material.’ ” Id. (quoting 3 Nimmer § 13.03[F][5], at 13–72).

1. Filters

The filters through which the material must pass include the constitutional requirement of originality, the Copyright Act's distinction between expression and ideas or processes (found in 17 U.S.C. § 102(b)), the related doctrines of “merger” and “scenes a faire,” and the public domain exception, all of which are discussed briefly below.

As an initial matter, the Constitution limits copyright protection to original works of authorship. See *Feist*, 499 U.S. at 345, 111 S.Ct. at 1287 (noting that “sine qua non of copyright is originality” and that “[o]riginality is a constitutional requirement”). This principle is reflected in the requirements, discussed above, that a work have been copied in the first instance and that copyright protects only those constituent elements of a work that possess more than a de minimis quantum of creativity. See 499 U.S. at 348; 111 S.Ct. at 1287.

Furthermore, the material must be considered in light of 17 U.S.C. § 102(b), which provides that:

In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 U.S.C. § 102(b). This language sets limits on the proper subject matter of copyright law, forcing a distinction between ideas and functional items (which are not protected) and creative, expressive works (which are). *Baker v. Selden*, 101 U.S. 99, 103 (1879); see generally *Lotus Dev. Co. v. Borland, Inc.*, 49 F.3d 807 (1st Cir.1995) (holding menu command hierarchy of spreadsheet program to be unprotectable “method of operation” under § 102(b)), *aff'd*, 516 U.S. 233 (1996).

The merger doctrine further restricts the realm of protectable material by recognizing that although “expression” of an idea is entitled to protection, “even 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.” *Genessee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 146 (2d Cir.1997) (quoting *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 322 (2d Cir.1996) (internal quotation marks omitted)); see *Apple Computer Inc. v. Microsoft Corporation*, 799 F.Supp. 1006, 1021 (N.D.Cal.1992) (noting simply that “[m]erger means there is practically only one way to express an idea.”), *aff'd* in relevant part, *rev'd* and *remanded* in part, 35 F.3d 1435 (9th Cir.1994).

An additional filter is the “scenes a faire” doctrine, which strips protection from expression made in the form of “stock features required by specifications of the computer itself and supported software, or by industry standards and customary programming practices.” *Productivity Software*, 1995 WL 437526, at *4 (citing *Altai*, 982 F.2d at 709–10). The scenes a faire doctrine, which is closely related to the public domain doctrine discussed below, “den[ies] protection to stock devices that are either standard

expressions within a particular industry or are standard programming techniques.” *Harbor Software, Inc. v. Applied Sys. Inc.*, 925 F.Supp. 1042, 1048 (S.D.N.Y.1996) (“Harbor Software I”).

*9 Related to “scenes a faire” is the principle that protection is not accorded to expressive elements taken from the public domain. See *Altai*, 982 F.2d at 709; *Autoskill Inc. v. National Educ. Support Sys., Inc.*, 994 F.2d 1476, 1494 (10th Cir.), cert. denied, 510 U.S. 916 (1993); *Nimmer* § 13.03 [F] [4] (noting that it is “axiomatic” that material in the public domain is not protected by copyright, even when incorporated into a copyrighted work). As the *Altai* court noted, there is “no reason to make an exception to this rule for elements of a computer program that have entered the public domain.” *Altai*, 982 F.2d at 710.

2. Compilations

Before applying these filters, it is useful to address the level of protection afforded to what are known in copyright law as “compilations.” The Act defines a compilation as the “collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” 17 U.S.C. § 101. Copyright in compilations is limited, extending “only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.” 17 U.S.C. § 103(b); see *Feist*, 499 U.S. at 359, 111 S.Ct. at 1295.

Under the compilation doctrine, even if the constituent elements of a work are not protected, protection may extend to the “selection, coordination, or arrangement” of such elements in the work as a whole. For example, the constitutional requirement of originality precludes copyright protection for facts. *Feist*, 499 U.S. at 344–45, 111 S.Ct. at 1287. Nonetheless, if unprotectable facts are selected, coordinated and arranged in a manner that demonstrates a minimal degree of creativity, the author may claim protection in that selection and arrangement. *Id.* at 348, 111 S.Ct. at 1289. Similarly, if constituent elements of a screen display or user interface lack requisite originality, or are outside the scope of copyrightable material under § 102(b), or are otherwise unprotectable, the selection, coordination, and arrangement of such elements may be protectable, even though those individual elements are not. See, e.g., *Apple*, 799 F.Supp. at 1023 (noting protectability of screen display’s unprotectable constituent elements); *Mitek*, 89 F.3d at 1554.

Protection of compilations is thin, as it is limited to just “those components of a work that are original to the author,” 499 U.S. at 348, 111 S.Ct. at 1289, and originality will be found only if the author has “ma[de] the selection and arrangement independently (i.e., without copying that selection or arrangement from another work), and [the compilation] display[s] some minimal level of creativity.” *Id.* The *Feist* Court commented that while “the vast majority of works will pass this test, not all will.” *Id.*

*10 The Court of Appeals recently articulated the test for determining creativity in selection and arrangement. “[C]reativity in selection and arrangement therefore is a function of (i) the total number of options available, (ii) external factors that limit the viability of certain options and render others non-creative, and (iii) prior uses that render certain selections ‘garden variety.’” *Matthew Bender & Co., Inc. v. West Publishing Co.*, 158 F.3d 674, 682–83 (2d Cir.1998).

The Court clarified that “when it comes to the selection or arrangement of information, creativity inheres in making non-obvious choices from among more than a few options.” Id. at 622. Where “selection from two or three options, or of options that have been selected countless times before and have become typical, is insufficient.” Id. This is because “[p]rotection of such choices would enable a copyright holder to monopolize widely-used expression and upset the balance of copyright law.” Id.

In cases where originality was found in selection, “the compiler selected from among numerous choices, exercising subjective judgments relating to taste and value that were not obvious and were not dictated by industry convention.” Id. at 689.

C. Comparison

In the final step, the court is to compare the protected elements of each program to determine whether the works are “substantially similar.” In this case, IPN argues that the aspects of the PATTSY program upon which OPS bases its claim all should be “filtered” out under the second step of the Altai test, and, as a result, the OPS program as a whole is not protectable, and any copying would not be actionable. Not surprisingly, OPS disagrees, arguing not only that the elements contained in the list of similarities are protectable expression, but also that IPN has copied so much of the expression so as to justify a summary judgment finding of infringement. As discussed below, I disagree with both positions and deny each party's request for summary disposition.

IV. FILTRATION ANALYSIS

A. What OPS Seeks to Protect

For the most part, the elements contained in OPS's proposed list of similarities concern the appearance of the screens, the manner in which the user interacts with the program and the information that the program takes from and gives back to the user. When the Altai court spoke of “elements,” it was not referring to “elements” of the screen display or data input fields; rather, as expressed in Altai, “non-literal” elements referred to the organizational structure of the actual program that itself generates the screen displays, tables, and data fields that the user sees and interacts with. In Altai the court addressed “non-literal elements” such as the flowcharts, charts, modules, and parameters designed by the programmer. See Altai, 982 F.2d at 697–98; see also Productivity Software, 1995 WL 437526; Harbor Software I, 925 F.Supp. at 1047.

*11 Here, in contrast, plaintiff's list of similarities makes virtually no reference to the internal operation of the program. Nor does OPS seek protection for any of the specific trademark information that its program conveys, or for the processes of calculating due dates based upon certain actions or of notifying specific personnel of upcoming due dates. Rather, OPS focuses on such elements as the on-screen placement of its input fields, the use of a grid to display the entire historical record for each trademark application, and the appearance and sequence of the data entry and docket directing choices presented to the user. Although not articulating as much, OPS seeks to protect the program's “user interface.”

Courts have consistently deemed “user interfaces” to be “nonliteral elements” of computer programs, rather than products generated by the program, as would be the case if they were deemed to be audiovisual works. See e.g., *Mitek Holdings Inc. v. Arce Eng'g Co.*, 89 F.3d 1548, 1554 (11th Cir.1996); *Engineering Dynamics*, 26 F.3d at 1342; *Harbor Software I*, 925 F.Supp. at 1046 (finding that copyright registration in computer program extended to screen displays generated by program); *Manufacturers Technologies, Inc. v. Cams, Inc.*, 706 F.Supp. 984 (D.Conn.1989) (same).

In this regard, courts have extended the protection of a registered program's code to the screen displays generated by that code. *Manufacturers Technologies*, 706 F.Supp. at 993 (treating “the single registration of the computer program as accomplishing two interrelated yet distinct registrations; one of the program itself and one of the screen displays or user interface of that program, to the extent that each contains copyrightable subject matter”); see also *Harbor Software I*, 925 F.Supp. at 1052.

In most cases the constituent elements of the user interface or screen display are not independently protectable, and the user interface is protectable only as a compilation. See *Apple*, 35 F.3d at 1446 (holding that where constituent elements of screen display were not protectable, plaintiff was forced to rest its infringement claim on copying of its “unique selection and arrangement of all of these features” and that in such circumstances infringement would be found only where the programs were virtually identical); *Mitek*, 89 F.3d at 1558 (holding that “a user interface, here a screen display (itself an audiovisual work), may be entitled to copyright protection as a compilation); *Digital Communications Assocs., Inc. v. Softclone Distrib Corp.*, 659 F.Supp. 449, 463, 465 (N.D.Ga.1987) (holding initially that the “status screen, which is a compilation, is copyrightable to the extent of its arrangement and design of parameter/command terms,” and restricting level of protection so that infringement would be found only where the allegedly infringing work was “virtually identical” to plaintiff's work); *Harbor Software, Inc. v. Applied Systems, Inc.*, 936 F.Supp. 167, 171 (S.D.N.Y.1996) (“*Harbor Software II*”) (concluding that “trivial difference” test applied to screen displays and reports which were compilations of factual information).

*12 For example, in *Manufacturers Technologies*, cited with approval in *Altai*, plaintiff designed a program which enabled its user to estimate the cost of machining a manufactured part. The plaintiff sought to protect as “compilations” the screen displays generated by the program. The court granted protection for the “external flow and sequencing” of the screens, finding that the order in which the screens were presented to the user “drive the user's thought processes through a number of manufacturing and engineering decisions, thereby expediting the process of creating a cost-estimate and communicating to the user the manner in which a cost-estimate should be derived.” 706 F.Supp. at 994. The court found protectable only those aspects of the screen displays that possessed creativity sufficient to render them “original,” and that conveyed information sufficient to make the forms more than unprotectable blank forms. See *Engineering Dynamics*, 26 F.3d at 1342 (holding screen displays and input and output formats copyrightable because their selection and arrangement contained enough originality under *Feist* to warrant protection); Cf. *Softel, Inc. v. Dragon Med. and Scientific Communications, Inc.*, 118 F.3d 955, 963 (2d Cir.1997) (holding that district court should have considered whether the combination of non-literal code elements could constitute protectable expression, even if those elements standing alone were not protectable).

Here, from the outset OPS has sought to protect not the underlying elements of its program themselves, but rather the “unique selection and arrangement” of its features. OPS stresses throughout its briefs, and it reiterated at oral argument, that it seeks protection not for the processes of docket directing, date calculation, or for the use of a grid to store information on individual trademark records. Rather, OPS seeks to protect the way these processes are expressed, i.e., it seeks to protect the overall look and feel of its program.

B. PATTSY's User Interface and The Blank Form Doctrine

So while it is clear that a user interface is entitled to protection, in this case an additional question arises concerning the specific type of interface at issue. As noted above, and discussed more fully below, OPS seeks to protect aspects of its screen display including, most importantly, its “action grid.” Because this grid is to a large extent a form in which the user enters information, a word need be said about copyright protection of so-called “blank forms.”

Although not a computer case, *Kregos v. Associated Press*, 937 F.2d 700 (2d Cir.1991), cited supra, provides important analogies to the types of displays that OPS seeks to protect. There, Kregos created and distributed to subscribing newspapers a form that displayed information on various baseball pitching statistics, for use in handicapping each day's games. When a non-subscriber published a similar form, Kregos brought a copyright infringement action. The district court granted defendants' summary judgment motion on the ground that Kregos did not have a copyrightable interest in the forms, because those forms were insufficiently original, were unprotectable under the merger doctrine, and constituted an unprotectable “blank form.” 937 F.2d at 703.

*13 The “blank form” doctrine derives from the Supreme Court's decision in *Baker v. Selden*, 101 U.S. at 103, where the Court denied protection to blank forms contained in a book explaining a system of double-entry bookkeeping. Those forms consisted of columns and headings designed for use in conjunction with the system. *Id.* at 104. The Court stressed that the author could not claim a copyright for his bookkeeping system, nor for the “ruled lines and headings of accounts [which] must necessarily be used as incident to it.” *Id.* Patent, not copyright, was the medium through which he could attempt to protect his system. In conclusion, the Court, “in a ... statement that is susceptible to overreading,” *Kregos*, 937 F.2d at 708, said that “blank account-books are not the subject of copyright.” *Baker*, 101 U.S. at 107.

To this end, the regulations of the Copyright Office preclude copyright registration to:

Blank forms such as time cards, graph paper, account books, diaries, bank checks, scorecards, address books, report forms, order forms and the like, which are designed for recording information and do not in themselves convey information.

37 C.F.R. § 202.1(c) (1997); see *Kregos*, 937 F.2d at 708. This regulation embodies the well-established rule “that forms usable only for the recording of information are not copyrightable.” *Januz Mktg. Comm., Inc. v. Doubleday & Co., Inc.*, 569 F.Supp. 76, 78 (S.D.N.Y.1982) (citation omitted).

As the Kregos court noted, however, this rule is not all-expansive. Accordingly, while a form that conveys no information and serves only to provide blank spaces for recording information contains no expression or selection of information that could possibly warrant copyright protection ... it should be equally obvious that a writing that does contain a selection of categories of information worth recording, sufficiently original and creative to deserve a copyright as a compilation of facts, cannot lose that protection simply because the work also contains blank space for recording the information.

Kregos, 937 F.2d at 708. Accordingly, a form will be entitled to protection so long as it conveys a minimal degree of creativity.

As the Kregos court continued,

When the Copyright Office denies a copyright to scorecards or diaries that 'do not in themselves convey information,' it must be contemplating works with headings so obvious that their selection cannot be said to satisfy even minimal creativity (a baseball scorecard with columns headed 'innings' and lines headed 'players'; 'a travel diary with headings for 'cities' 'hotels,' and 'restaurants'). Such a work conveys no information, not just because it contains blanks, but because its selection of headings is totally uninformative. On the other hand, if the scorecard or diary contained a group of headings whose selection (or possible arrangement) displayed cognizable creativity, the author's choice of those headings would convey to users the information that this group of categories was something out of the ordinary.

*14 Id.

In light of this exception to the blank form doctrine, the Court of Appeals reversed, holding that the selection of statistics in the form constituted a compilation of facts that demonstrated the requisite degree of creativity under Feist to warrant protection, additionally that the expression found in the forms had not merged into the idea of creating an outcome-predictive pitching form, and for the same reasons the form satisfied Feist, the selection reflected in Kregos' form communicated some information to the reader and thus was not rendered unprotectable under the blank form doctrine. Id. at 705, 707, 709.

The court recognized that the level of protection would be narrow, however, because a plaintiff's attempt to protect a compilation will fail if the defendant can show that his work differs in more than a "trivial degree" from the plaintiff's work. Kregos, 937 F.2d at 710; see Harbor Software II, 936 F.Supp. at 170. This "thin" level of protection, which denies protection where the works in question possess more than a "trivial difference," appears analogous to the "virtual identity"-type tests applied in Apple, 35 F.3d at 1446, and Mitek, 89 F.3d at 1554.

With these principles in mind, the alleged similarities are discussed below.

C. THE ALLEGED SIMILARITIES

OPS's list of similarities can be broken down into a number of categories, each of which is discussed below.

1. Screen Layout (Items 1–3)

Similarities one through three correspond to the actual screen layout of PATTSY's various input fields. In particular, Item one describes the top portion of the main trademark screen, which contains fields which prompt the user to enter such information as country, trademark, client's name, owner, agent, client's reference, agent's reference, trademark status, trademark type, and the firm's internal reference number. (See Ross Decl. Exhs. 1–3; OPS 56.1(a) ¶ 1; IPN 56.1(a) ¶ 1). These input fields generally exist in the same area in each program. (See Ross. Decl. Exhs. 1–3; IPN 56.1(a) ¶ 1). Item two refers to the so-called “middle portion” of the trademark screen, which contains fields which prompt the user to enter such information as application number, application date, registration number, and registration date. (Ross Decl. Exhs. 1–3; OPS 56.1(a) ¶ 2; IPN 56.1(a) ¶ 2).⁶ Item three corresponds to what OPS describes as an “Action Grid.” (See OPS 56.1(a) ¶ 3; IPN 56.1(a) ¶ 3; Ross Decl. Exhs. A–C). The left column is titled “Description,” and the columns to the right contain headers for “action's due date,” “action's final date,” “action's call up date,”⁷ and “action's response/completion date.”

Individual fields which seek information do not constitute original expression, but rather are abbreviations for commonplace terms, and as such are unoriginal and uncopyrightable. The coordination, selection, and arrangement of these fields, however, may be entitled to protection as a compilation, so long as it is “sufficiently original and creative to deserve a copyright as a compilation of facts.” *Kregos*, 937 F.2d at 703, 708; *Harbor Software II*, 936 F.Supp. at 171. Although the layout is protectable, IPN's copying of the layout will constitute infringement only if it is found that IPN's program differs by no more than a trivial degree. *Kregos*, 937 F.2d at 710.

2. Field Names

*¹⁵ OPS has also included in its proposed list of similarities the names of the fields in its grids and in other places on its screens. (See OPS 56.1(a) ¶¶ 5–29; IPN 56.1(a) ¶¶ 5–29, 56, 61–69).⁸ These terms, by themselves, are not original, are within the public domain, and are not entitled to individual protection. See *Salinger v. Random House, Inc.*, 811 F.2d 90, 98 (2d Cir.) (noting that ordinary phrases and words generally not entitled to copyright protection), opinion supplemented on denial of reh'g, 818 F.2d 252, cert. denied, 484 U.S. 890 (1987); *Acuff–Rose Music, Inc. v. Jostens, Inc.*, 988 F.Supp. 289, 295 (S.D.N.Y.1997) (noting that “ ‘ordinary’ phrase may be freely quoted or otherwise used without fear of infringement”); *Productivity Software*, 1995 WL 437526, at *6; *Arica Inst., Inc. v. Palmer*, 770 F.Supp. 188, 191–92 (S.D.N.Y.1991), aff'd, 970 F.2d 1067 (2d Cir.1992);

To be entitled to protection as a compilation, the selection and arrangement of these terms and fields as a “compilation” must demonstrate adequate creativity within the framework articulated in *Bender*. Although there is a strong case to be made that this selection and arrangement is not sufficiently creative under *Bender*, I am unable to conclude that no reasonable juror could find creativity sufficient to render the compilation original enough for protection. As such, I may not grant IPN summary judgment as to these items.

3. Action Grid (Items 3, 30–53, 60, 70–78, 82–83, 88)

Much of OPS's claim centers on what it calls its "Action Grid," which appears on a number of PATTSY's screens, including the main trademark screen (similarities 30–53), the countries screen (similarities 60, 70–78), and the general matters file (similarities 82–83, 88).⁹ The two primary aspects of the action grid for which OPS claims protection are the permanent display of the Action Grid on each respective screen and the grid's "single line action expression feature." The "single line" terminology refers to the fact that the grid includes multiple items of information about the trademark action within a single row, and each row contains information on a given action taken in regard to the trademark file discussed on each screen; that is, the top portion of the screen includes certain basic information about the trademark file, including, *inter alia*, the country in which the application is being prosecuted, the owner of the mark, the agent, the client of the firm, etc. The "Action Grid" then receives, stores, tracks and displays information about each action taken in the life of that application; each action in the trademark's history receives its own line, and the grid displays all lines at once. OPS claims that PATTSY is the first trademark docketing program to organize an "action grid" of this kind.

As noted above, the left column, titled "Action," records the particular action taken, e.g., a response to an action by the trademark office, a status check, or submission to the trademark office of evidence of use.¹⁰ Columns to the right contain headers for information such as the "action's due date," the "action's final date," the "action's call up date," and the "action's response/completion date."

*¹⁶ Further, OPS's claims protection of what it calls its "docket directing" feature, which, operating from the action grid, allows the user to indicate what firm personnel are to be notified of impending due dates with regard to a given file. Up to three individuals may be selected, and the columns that seek this function are headed "1", "2", and "3", which designations are meant to indicate "attorney 1", "attorney 2" and "paralegal." See Ross Decl. Exhs. 1–3; OPS 56.1(a) ¶¶ 33–34. Further, the single line action grid contains a notes field, in which the user may include information that qualifies or amplifies the action (OPS 56.1(a) ¶ 35), and there is a field that displays the action's due date (OPS 56.1(a) ¶ 36), calculated based on the date the action was taken, the statutory or due diligence due date, and the number and duration of any extensions given. (OPS 56.1(a) ¶¶ 36–37). Additionally, a reminder date, set to notify relevant attorneys of impending deadlines, is also displayed. (*Id.*).

OPS claims protection for the fact that the action grid retains and displays all current and historical actions in a single grid (OPS 56.1(a) ¶ 40),¹¹ that the grid, by default, displays all actions taken concerning the file whenever the trademark file is brought to the screen, (OPS 56.1(a) ¶ 42), and that the grid is designed to house all actionable due dates (OPS 56.1(a) ¶ 43). OPS does not seek to protect the method by which the program calculates the relevant dates, sorts dates or otherwise performs functions on the data it gathers. Rather it is the selection, coordination and format of this display that OPS seeks to protect.¹²

Because methods of operation are precluded from protection under § 102(b), any elements from the list which purport to protect such processes or methods of operation are not entitled to protection. That is,

to the extent OPS seeks to protect the functions that the grid performs, those functions are unprotectable under § 102(b). See *Baker v. Selden*, 101 U.S. at 103.

For example, OPS may not secure copyright protection of the following elements: the fact that the grid can be “populated” (i.e., made to reflect information) through a number of different methods (OPS 56.1(a) ¶ 45); the manner in which the program, in response to the user's entry of a trigger date, automatically determines and displays all the relevant actions to be taken with regard to that action, based upon information that is stored in the computer's “predefined action” table (Id. ¶ 46); the program's ability to respond to either statutory or non-statutory events (id. ¶ 47); the way the balance of the fields in the action line, including those for relevant dates, call up period, and docket directing information, are populated automatically once the user enters information in the initial action field (id. ¶ 48); the method by which the user chooses manual actions for entry into the action grid, as well as the method by which the program or user then populates the remaining fields based upon the action's corresponding base date (id. ¶¶ 49, 50 and 51); the fact that the program displays a new renewal date whenever the old renewal date is satisfied (id. ¶ 52);¹³ and the fact that every time an action is entered onto the grid, the program automatically re-sorts the open or incomplete actions in date order (id. ¶ 53).¹⁴

*¹⁷ These elements describe the way that the program works and the manner in which the user operates the program. As such, these elements are processes and methods of operation and are unprotectable under § 102(b). Indeed, those elements that describe the manner in which the user enters data describe a feature common to any computer program involving data entry. Moreover, WorldMark DOS, a prior program published by IPN, employed these features, although it did so in a separate stand-alone grid on a separate screen, rather than as part of the permanent action grid at the bottom of the main trademark screen. Further, WorldMark DOS employed the same process, but as part of a fixed field, rather than as part of a grid. OPS attempts to capitalize on these differences by claiming that “[e]ntering manual actions into a separate Office Action Grid[, as done in WorldMark DOS,] is a different expression than entering manual actions into the a[sic] permanent action grid located on the main trademark screen,” see Ross Decl. Exh. A at 31. This argument suggests that these items, which are nothing more than methods of data entry unprotectable under § 102(b), somehow become original and protectable expression when they are carried out on a different screen from prior programs. This cannot be so. OPS has already claimed that the placement and permanence of its action grid is protectable on account of the original expression that went into the selection and arrangement of its screen display. The actual methods described by these items are the same regardless of where in the program they are executed; these data entry and calculation items describe a functional and unprotectable process—they do not describe protectable expression.

4. Organization and Structure of the “Clients/Address” “General Matters” Files

The “Clients/Address” files are, as their names suggest, organized by client. These files house information on the client, and, most importantly, house the default information as to which attorneys and paralegals are assigned to which clients. Accordingly, when given client information is entered on the trademark screen, the program draws on this file to identify which attorneys are to correspond to

the “Atty 1” “Atty 2” and “Para” fields in the action grid. Item 55 refers to the three-field data entry screen, which is organized on a client-by-client basis. These data input forms are protectable only as a compilation, similar to items 1–3.

Item 57 describes the function by which entry of the client name on the trademark screen causes the names of the relevant attorneys to pop up automatically on the trademark record. Item 58 describes the user's ability to override the default staff fields for a given trademark record, and item 59, somewhat duplicatively of item 57, describes the fact that absent a user-override, the default values for the attorney information are taken from the client file. PATTSY also contains a “General Matters” file for use in managing a firm's non-trademark cases. Users may store information on non-trademark cases in this file (Item 79 (OPS 56.1(a) ¶ 79), and OPS lists as a protectable element the feature that allows a user printing a docket to include due dates related to either trademark matters, general matters, or both. OPS 56.1(a) ¶ 95.

*18 As with the aspects of the action grid deemed unprotectable under § 102(b), supra, OPS again here improperly seeks to protect processes or methods of operation.

5. Similarities in the Sequence of Operation

OPS also seeks protection for PATTSY's “sequence of operation” in a number of areas. To this end OPS offers items 99, 100, and 102, which describe steps the user takes in entering basic trademark information. Here, OPS merely describes basic steps that a user would take in entering information into a computer. These steps are neither original nor expressive of any idea; they merely provide a method by which the user can interact with the program and enter relevant information. They constitute a process and/or method of operation under § 102(b) and, in short, are not entitled to copyright protection.

Item 104 and 105 describe how the program displays follow-up dates and due dates automatically upon a user's entry of certain dates into the main trademark action grid, gives the user an option either to utilize the automatic feature or enter the dates manually, generates additional rows for a “post-card check” and a “filing receipt status check,” and calculates and displays the due date, final date, call up date, and which attorneys or paralegal, if any, are to receive docket notifications concerning the action in question. (OPS 56.1(a) ¶¶ 104–105). PATTSY also claims protection for the sequence of steps a user would follow in adding manual actions to the grid and to the “pick list” menu of actions from which a user can choose when populating the grid. (OPS 56.1(a) ¶¶ 108–111). Additional items describe the method by which the program automatically generates renewal dates for cyclic actions (OPS 56.1(a) ¶ 112–13) and calculates relevant dates even when the action is entered manually (id. ¶ 114).

As presented, these items describe processes or methods; quite literally, they explain the steps that the user takes in entering and organizing information. As such these items describe a method or process unprotectable under § 102(b) and are unprotectable in all regards. Moreover, prior programs performed these same functions, and the only thing that makes them unique here is the fact that they are performed in an action grid; therefore the protection, if any, attaches to the grid, not to the processes performed on or in the grid.

Item 115 explains how the user would re-sort open action items and notes the fact that the user must enter a base date manually when the trademark record does not provide its own base date. Similarly, item 116 describes the feature by which the program re-sorts the action records automatically whenever a new action is entered. Item 117 describes the user's ability to override any predefined defaults by simply proceeding to the relevant parameter and changing the setting. Item 118 describes the ability to add comments/notes in the "notes" field in the right-most column of the grid. Item 119 describes the ability to add a response date to the renewal action, which thereby suppresses the action from docket printing. (OPS 56.1(a) ¶¶ 115–119).

*19 These items describe processes and methods of operation and thus are unprotectable. They are likely unoriginal, and as to item 118, numerous programs allow users to enter notes on the screen. Indeed, any data entry program that allows comments or notes or even leaves a blank field employs such a mechanism, and as a result this item is not protectable. As above, if anything, the selection, arrangement and display of these options as part of an action grid deserves protection, but that protection is limited to the appearance of the grid itself, not to the underlying processes offered by or performed through the grid.

OPS also claims protection for the sequence of operation in PATTSY's docket printing options. Item 120 restates the program's "docket directing" feature, through which the user may identify which individuals should receive notice of actions related to the trademark record. Item 121 describes the option of viewing and printing the due dates of all assigned attorneys or printing just user's due dates. Item 122 describes the option of printing information from the general matters file, the trademark file, or both. (Called the "Docket Consolidation" feature). Item 123 describes how the call up feature works.¹⁵

As with the above items, these items describe processes, e.g., the process by which the program arrives at a "tickler" date. Although OPS seemingly concedes that such functions are not protected, it maintains that it is entitled to protect the "unique expression" of the functions. At bottom, however, the items that OPS has advanced describe processes and, as such, are not protectable.

Item 124 describes the user's ability to open any one of a number of reference windows (Owner, Client or Agent) directly from the main trademark screen, by "double-clicking" on the screen icon. Item 128 details the steps the user takes when entering a user defined action in the general matters file. Simply, the user enters the name of the action (for example, "appeal" or "service of the complaint"), the due date, the number and term of any extensions, the call up period, if any, as well as the docket directing parameters (which, if any, attorneys or paralegals should receive notice of the action's impending due date). Items 129 and 130 similarly detail how a user would enter a new case into the general matters file, filling in relevant information in each of the particular fields such as type, title, status, etc. Item 131 explains how the user would enter one of the customized actions described above into the action grid. These items describe a process or method of operation and are not protectable.

6. Data Compilation

OPS also claims protection for what it calls PATTSY's "data compilation," i.e., the values (such as timetables and deadlines) it has set for various items, for example: the "Response to Office Action" does

not contain a base date, is set to be due in 6 months, with a one-month call up and no extensions; the “status check” is set to have an 18 months due date, with no extensions; the “post card check” is set to have a one month due date, marked from the date of mailing, with no extensions and no call up; the “Filing Rcpt Status Chk” is set to be due in three months, with no extensions and no call up; the renewal is set for ten years, with a three-month extension and a six-month call up; the “affidavit of use” is set to be due in six years, with no extension and a twelve-month call up; the statement of use is set to be due in six months from an allowance date, with five six-month extensions and a three-month call up; and the “convention ends” parameter is set to be due in twelve months from an application date for patents, with no extensions, with a two-month call up.

*20 As noted above, while facts are not protectable, compilations of facts may be protectable so long as they reflect a requisite, albeit minimal, degree of originality. The selection and arrangement of the information in PATTSY's data compilation contain such a minimal spark of creativity and are entitled to some, albeit thin, protection. Infringement will be found only if the WorldMark Windows programs differ by no more than a trivial degree.

7. Underlying Data Tables

OPS also seeks protection for the structure of the data tables which underlie the program. (OPS 56.1(a) ¶¶ 142–177). Data tables are the tables in which the program stores information entered by users in certain fields.¹⁶ The names of the fields in these tables are not by themselves protectable, although their selection and arrangement may be entitled to thin protection so long as their coordination, selection, and arrangement demonstrate a minimal degree of creativity. These tables do reflect the requisite originality and as such are entitled to protection such that infringement will be found if the WorldMark Windows programs differ by no more than a trivial degree.

8. Similarities in Documentation and Help Screens (OPS 56.1(a) ¶¶ 180–193)

Finally, OPS claims that IPN has unlawfully copied portions of the documentation that accompanies the PATTSY program as well as material displayed in the program's help screens. That material constitutes protectable expression, and IPN's copying will constitute infringement if the material in the WorldMark Windows program is deemed to be “substantially similar” to that contained in the PATTSY programs.

D. Summary

As the above analysis indicates, much of the material in OPS's list of similarities is not entitled to copyright protection. At bottom, OPS is entitled to protection of the selection, coordination, and arrangement of the information contained in PATTSY's (1) screen displays, (2) “action grids,” (3) data compilations, and (4) data tables. Given the limited protection that attaches to such elements, IPN may escape liability if there is more than a “trivial difference” between its works and PATTSY. See *Kregos*, 937 F.2d at 710; *Harbor Software II*, 936 F.Supp. at 171. OPS is also entitled to protection for the expression of the information provided on its help screens, which are protectable in their own right, and hence will be deemed infringed if the WorldMark Windows expression is found to be “substantially similar” to that in PATTSY.

V. COMPARISON

As noted above, although the issue of whether two works are sufficiently similar to trigger copyright liability “often raises questions of fact not appropriately resolved on a motion for summary judgment, ‘a district court may determine noninfringement as a matter of law on a motion for summary judgment either when the similarity concerns only noncopyrightable elements of plaintiff [‘s] work, or when no reasonable trier of fact could find the works substantially similar.’” *Productivity Software*, 1995 WL 437526, at *2 (quoting *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48 (2d Cir.), cert. denied, 476 U.S. 1159 (1986)). As the above discussion explains, OPS has demonstrated that some of the elements shared by PATTSY and WorldMark Windows constitute copyrightable subject matter—in particular the selection, coordination, and arrangement of the information contained in the (1) screen displays, (2) “action grids,” (3) data compilations, and (4) data tables, as well as the non-literal elements of the information provided on the programs’ help screens. As a result, IPN may not secure a summary judgment of non-infringement on the ground that “the similarity concerns only noncopyrightable elements of plaintiff[‘s] work.” *Productivity Software*, 1995 WL 437526, at *2.

*21 Accordingly, IPN’s request for summary judgment must rest on the ground that “no reasonable trier of fact could find the works” to be sufficiently similar. Because the items that are protected (aside from the help screen language) are protectable only as compilations, infringement will lie only if those elements differ from one another by no more than a trivial degree, a concededly high standard. At the same time, however, it is important to note that even though some aspects of the programs may be dissimilar, that fact alone will not preclude a finding of infringement. Rather, in a case like this one, involving a work with both protectable and non-protectable elements, a defendant will escape liability only where the copied, protectable elements constitute an insignificant portion or aspect of the work in question. As the Court of Appeals has stated, after noting that mere dissimilarity of works will not relieve an alleged infringer of liability,

[i]t is only when the similarities between the protected elements of plaintiff’s work and the allegedly infringing work are of “small import quantitatively or qualitatively” that the defendant will be found innocent of infringement.

Williams v. Crichton, 84 F.3d 581, 587 (2d Cir.1996); *Lone Wolf McQuade*, 961 F.Supp. 587, 595 (S.D.N.Y.1997).

After reviewing the material in the record, including reproductions of the various screen displays and representations of the various data tables, I am unable to find, as a matter of law, that “no reasonable juror could conclude” that the user interface, the action grid, the data compilations and data tables do not differ by more than a trivial degree. See *Lone Wolf McQuade Assocs. v. CBS Inc.*, 961 F.Supp. at 594 (refusing to grant summary judgment on “substantial similarity” comparison of characters in television programs); *M.H. Segan Ltd. Partnership v. Hasbro, Inc.*, 924 F.Supp. 512, 521 (S.D.N.Y.1996) (refusing to grant summary judgment on “substantial similarity” comparison). Thus it is for a trier of fact to determine (1) whether the protectable elements of the two programs differ in more than a trivial

degree and, (2) if not, whether those elements are of sufficient import to the works as a whole to render the defendant guilty of infringement.

Because there are disputed issues of material fact regarding whether PATTSY and WorldMark Windows are similar enough to support OPS's claim, the parties' respective motions for summary judgment must be denied.

The parties should confer and advise the court whether they would be amenable to the court's summary disposition of this matter in keeping with the procedure articulated in *Acuff–Rose Music, Inc. v. Jostens, Inc.*, 155 F.3d 140, 143 (2d Cir.1998) (sanctioning summary bench trial upon record amassed on summary judgment motion where parties have so stipulated and have “willingly forgone their right to a full trial”).

VI. TRADE DRESS INFRINGEMENT

*22 Count II of the Amended Complaint alleges trade dress infringement under the Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). Section 43(a) provides a cause of action against any person who “in connection with any goods ... or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof ... which ... is likely to cause confusion, or to cause mistake, or to deceive ... as to the origin, sponsorship, or approval of his or her goods ... by another person .” 15 U.S.C. § 1125(a). Although enacted as part of the Trademark Act, Section 43(a) of the Lanham Act serves a different purpose: it “functions as a federal law of unfair competition for unregistered goods ... and extends protection to a product's trade dress.” *Coach Leatherware Co., Inc. v. AnnTaylor, Inc.*, 933 F.2d 162, 168 (2d Cir.1991).

The definition of protectable trade dress traditionally encompassed only “the manner in which a product was ‘dressed up’ to go to market with a label, package, display card, and similar packaging elements.” *Majestic Drug Co., Inc. v. Olla Beauty Supply, Inc.*, No. 97 Civ. 0046(LAP), 1997 WL 37955, at *3 (S.D.N.Y. Jan. 31, 1997). The definition has expanded, however, and now includes “the design and appearance of the product, as well as that of the container, and all elements making up the total visual image by which the product is presented to consumers.” *Id.* Thus, trade dress is “essentially [a product's] total image and overall appearance,” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S.Ct. 2753, 2755 n. 1 (1992), “as defined by its overall composition and design, including size, shape, color, texture, and graphics,” *AnnTaylor*, 933 F.2d at 168. OPS alleges that PATTSY's overall composition and design constitutes protectable trade dress which is infringed by the WorldMark Windows programs.

To prevail on a trade dress claim under Section 43(a) of the Lanham Act, a plaintiff must prove two elements: (1) that its dress is entitled to protection under the Act (i.e., that it either is “inherently distinctive” or has acquired secondary meaning), and (2) that confusion exists between its product and the defendant's product. *Two Pesos*, 112 S.Ct. at 2758. Further, functional packaging and product designs are unprotected, and the functionality of a design may be raised as a defense to an action for trade dress infringement. *LeSportsac, Inc. v. K. Mart Corp.*, 754 F.2d 71, 79 (2d Cir.1985).

While IPN does not challenge PATTSY's entitlement to trade dress protection in the first instance, it does mount two separate, albeit brief, challenges to OPS's trade dress claim. First, although not explicitly saying as much, IPN contends that no confusion could exist between the products because, primarily, "it is not possible to have trade dress infringement if the product is clearly marked with the name of the company selling the product." IPN Mem. at 28. Second, IPN argues that even if confusion could exist, the functionality defense bars OPS's claim. *Id.*

A. Consumer Confusion

*23 Although its papers do not say as much, IPN seems to attack OPS's ability to demonstrate that there could be confusion between the products at issue. In assessing the likelihood of confusion between two competing products, I am to look to the non-exclusive list of factors set forth by Judge Friendly in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir.), cert. denied, 368 U.S. 820 (1961). This inquiry focuses on (1) the strength of the plaintiff's dress; (2) the similarity between the plaintiff's and defendant's dresses; (3) the proximity of the products in the marketplace; (4) the likelihood that the senior owner will bridge the gap between the products; (5) evidence of actual confusion; (6) the defendant's bad faith; (7) the quality of the defendant's product; (8) the sophistication of the relevant consumer group. See *Paddington Corp. v. Attiki Importers & Distrib., Inc.*, 996 F.2d 577, 584 (2d Cir.1993) (citing *Polaroid*). On summary judgment, a court's task is "to determine whether any reasonable trier of fact could conclude that confusion is likely." *The Sports Authority, Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 960 (2d Cir.1996). All factual determinations concerning the *Polaroid* factors must be construed in favor of the non-moving party. *Cadbury Beverages, Inc. v. Cott Corp.*, 73 F.3d 474, 478 (2d Cir.1996). Once questions concerning the factors are so construed, however, the weighing of those factors constitutes a legal question properly resolved by the court as a matter of law. *Id.* Therefore, on a defendant's motion for summary judgment, the Court must resolve reasonable doubts regarding each *Polaroid* factor in plaintiff's favor, before balancing the factors to determine whether any reasonable trier of fact could conclude that confusion is likely.

Here, IPN addresses only two of the *Polaroid* factors and urges that because these factors—customer sophistication and the similarity of the dresses—militate in IPN's favor, confusion is impossible as a matter of law. IPN fails, however, to demonstrate, or even suggest, how a balancing of all of the *Polaroid* factors dictates that no reasonable trier of fact could conclude that confusion is likely.

As to similarity, IPN, relying on *Conopco Inc. v. May Dept. Stores Co.*, 46 F.3d 1556, 1565 (Fed.Cir.1994), argues that because its product is clearly labelled to indicate that it is manufactured by IPN, the products are dissimilar and confusion is impossible as a matter of law. In *Conopco*, the Court of Appeals for the Federal Circuit, applying Eighth Circuit law, held that a product's prominent display of its source weighs heavily against finding a likelihood of confusion. In that case the products were packaged in nearly identical containers, but the allegedly infringing product contained a prominent label bearing the manufacturer's logo. *Id.* at 1567. The court held that the defendant's extensive placement of the logo elsewhere—in the parking lot of its stores, on store signs, employees' badges, in frequent print and television ads, and on other items sold by the defendant, when coupled with the large volume of the defendant's sales and a lack of evidence of actual confusion—gave "rise to the expectation that

consumers identify the logo with [the defendant], rather than [the plaintiff], and use that logo to successfully distinguish the two brands.” Id. at 1568.

*24 Similarly, in *Bristol–Myers Squibb Co. v. McNeil–P.P.C., Inc.*, 973 F.2d 1033, 1046–47 (2d Cir.1992), the court relied heavily upon labelling to preclude a finding of a likelihood of confusion. There, the Court of Appeals reversed the district court's conclusion that consumers were likely to confuse the trade dress of plaintiff's product, “Excedrin PM,” with that of the defendant's product, “Tylenol PM.” The court noted that although the packaging of the products were similar, “when taken as a whole, including the prominently displayed names, they are not similar in any manner that is likely to cause confusion; in fact, the prominent presence of the well known trade names goes far toward countering any suggestion of consumer confusion arising from any of the other factors”. Id. at 1046. Indeed, the “famous names” formed the “most prominent feature of the trade dress in each case.” Id. at 1047. While these cases do establish that labelling works against confusion, IPN overstates its case when it suggests that labelling alone is dispositive.

As an initial matter, IPN has failed to present evidence demonstrating that the labelling in this case weighs as heavily against confusion as was the case in *Conopco* and *Bristol–Myers*. There is no evidence that the brand names involved here are as prominent as those involved in those cases. Moreover, IPN's name, while clearly displayed on the main trademark screen, does not appear so prominently as to overwhelm the other features of OPS's purported trade dress.

More importantly, however, even if the labelling here did weigh strongly against confusion, that factor alone is not dispositive. The *Bristol–Myers* court concluded that confusion was unlikely only after considering all of the Polaroid factors. It cautioned that product identification alone will not always counteract the potential for confusion, and noted that it did “not mean to intimate that the distinctive elements of any trade dress may be freely appropriated as long as the junior use clearly identifies the source of the goods.... In other cases the trade name may be a less dominant feature of the entire trade dress and thus have less force in countering other similarities between two trade dresses. Also, the junior user's trade name may less strongly identify a particular source than the ‘Tylenol’ name at issue here.” Id. at 1047; see also *PAF S.r.l. v. Lisa Lighting Co., Ltd.*, 712 F.Supp. 394, 411 (S.D.N.Y.1989) (“While a label may help in great degree to distinguish products whose designs are fairly common place ... where the trade dress is distinctive and the products so closely resemble each other, labeling cannot preclude the possibility that confusion will occur.”).

Thus labelling is but one of the factors relevant to potential confusion between two trade dresses. IPN's failure to evaluate, or even mention, the balance of the factors—including but not limited to the strength of OPS's dress, actual confusion, and its own bad faith—leaves unresolved issues of material fact that preclude my granting summary judgment. Because I am unable to conclude that no reasonable juror could find a likelihood of confusion, IPN's motion for summary judgment on this ground is denied.

B. Functionality

*25 Even where a plaintiff establishes that its trade dress is entitled to protection and that a likelihood of confusion exists between the dress of its product and that of the defendant's product, “the

manufacturer of the accused product can still avoid liability by showing that the similar arrangement of features is functional.” *Landscape Farms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 377 (2d Cir.1997); *P.E. Guerin, Inc. v. Nanz Custom Hardware, Inc.*, No. 97 Civ. 298(PKL), 1997 WL 777812, at *6 (S.D.N.Y. Dec. 16, 1997). The functionality defense is an issue on which a defendant bears the burden of proof. *LeSportsac*, 754 F.2d at 76; *Majestic Drug*, 1997 WL 37955, at *3.

“The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.” *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 164, 115 S.Ct. 1300, 1304 (1995). This is because “[i]t is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, after which competitors are free to use the innovation.” *Id.* (citation omitted). The Supreme Court has instructed that “[i]n general terms, a product feature is ‘functional,’ and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or it affects the cost or quality of the article,’ that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.” *Id.* (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, n. 10, 102 S.Ct. 2182, 2186, n. 10 (1982)).

As the Court of Appeals has explained, “[a] design feature is ‘essential’ only if the feature is dictated by the functions to be performed; a feature that merely accommodates a useful function is not enough.” *Warner Bros., Inc. v. Gay Toys, Inc.*, 724 F.2d 327, 331 (2d Cir.1983). And a design feature “ ‘affecting the cost or quality of an article’ is one which permits the article to be manufactured at a lower cost, or one which constitutes an improvement on the operation of the goods.” *Id.* (citations omitted). “The fact that an item serves or performs a function does not mean that it may not at the same time be capable of indicating sponsorship or origin, particularly where the decorative aspects of the item are nonfunctional.” *Warner Bros.*, 724 F.2d at 332 (quoting *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir.1979)). Finally, “even if certain individual elements of [OPS's] trade dress are functional, the appropriate inquiry looks at the trade dress as a whole.” *Majestic*, 1997 WL 37955, at *12 (citing *LeSportsac*, 754 F.2d T 76 (stating that “by breaking *LeSportsac's* trade dress into its individual elements and then attacking certain of those elements as functional *K Mart* misconceives the scope of the appropriate inquiry)).

*26 Here, OPS has alleged that IPN copied an overwhelming number of the elements of PATTSY's trade dress, as represented by PATTSY's screen display. While some aspects of that display, and the way it operates, might indeed be functional (e.g., the mere use of a grid), the selection and arrangement of the items on the display could well constitute non-essential, and hence non-functional, elements of PATTSY's trade dress.¹⁷ On this motion for summary judgment IPN has failed to carry its burden of demonstrating that the selection and arrangement of the items on the WorldMark Windows programs' screen displays were incapable of indicating sponsorship or origin, see *Warner Bros.*, 724 F.2d at 332, or that they were necessary to reduce the cost of producing, or to ensure the effective operation of, its programs. *Id.* IPN cannot succeed on the functionality defense it asserts, and its motion for summary judgment on that score is therefore denied.¹⁸

CONCLUSION

For the reasons stated above, the parties' motions for summary judgment (Docket Nos. 23 and 39) are denied. The parties shall appear in Courtroom 12A at 500 Pearl Street for a pre-trial conference on February 19, 1999 at 9:00 a.m.

SO ORDERED:

Parallel Citations

1999 Copr.L.Dec. P 27,887, 50 U.S.P.Q.2d 1399

Footnotes

1

WorldMark 4.1 is fundamentally the same as WorldMark 4.0, incorporating only a number of minor changes. The programs will be considered together.

2

A "command tree structure" is a display that "informs the user, in hierarchical fashion, of the options available and also interacts with the user in requesting information from the user in order to utilize the program." *Mitek*, 89 F.3d at 1556 n. 18.

3

The test has been followed and widely accepted. See *Softel, Inc. v. Dragon Medical and Scientific Communications, Inc.*, 118 F.3d 955, 963 (2d Cir.1997), cert. denied, 118 S.Ct. 1300 (1998); *Harbor Software, Inc. v. Applied Systems, Inc.*, 925 F.Supp. 1042 (S.D.N.Y.1996). See also *Engineering Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1341 (5th Cir.1994) (citing *Altai* with approval and applying version of that test). Nonetheless, district courts have found it difficult to apply the test consistently. See e.g., *Softel*, 118 F.3d at 963 (reversing district court's finding of overall unprotectability for its failure to consider possibility that combination of and interrelationship between design elements could amount to protectable expression).

4

Indeed, the *Mitek* court noted that "[p]erhaps the best approach for a district court in any computer program infringement case, whether involving literal or nonliteral elements, is for it to require the copyright owner to inform the court as to what aspects or elements of its computer program it considers to be protectable." 89 F.3d at 1555.

5

OPS originally sought protection for a list of 193 elements. After consulting with IPN, OPS removed the following 33 items from its list: Nos. 4, 41, 54, 80–81, 89–94, 96–98, 101, 103, 125–127, 132, 141, 179, and 181. As a result, the resulting list consists of 160 elements.

6

References made to IPN's 56.1(a) statement demarcated by “¶” correspond to the numerical list of similarities contained therein. (E.g., “¶ 2” refers to “Item 2”) from the list contained in IPN's 56.1(a) statement.

7

A “call up date” refers simply to the date on which the user should follow up with the agency to whom the application was sent or otherwise be reminded to take a relevant action in regard to the application.

8

On the main trademark screen these include fields from the top portion of the screen (item 1) labeled “Owner”, “Type”, “Client”, “Agent”, “Agent ref”, “Client Ref”, “Mail”, “Allow”, and “ITU.” (Items 5–13). The middle portion of the screen (item 2) contains fields labeled “Appl #”, “Reg#”, “Reg”, “1Appl #”, “1Reg#”, and “1Reg Dt.” (Items 14–19). The action grid (item 3) contains fields labeled “Atty1”, “Atty2”, “Para”, “Actions”, “Base Dt”, “Due Dt”, “Final”, “Call”, “Notes”, and “Status”. See (Items 20–29).

OPS also claims protection for field names in the “Clients/Address File,” (see Item 56), as well as in the “Countries File” action grid, which contain field names such as “Action”, “Base”, “Due In”, “Exts” (an abbreviation for extensions), “Call”, “C”, “1”, “2”, and “P” (see Items 61–69).

9

The “Action Grid” also appears on several other PATTSY screens, including those screens titled “Conflicts”, “Agreements,” “Licenses,” “Non–TM” and “Ownership.”

10

The particular “action” may be chosen from a separate menu or “pick list” of choices presented to the user when he or she double clicks on the “action” field on the table.

11

Item 40 includes what had been previously denoted as Item 41 (see Ross Decl. Exh. A at 12).

12

OPS also claims protection for the “action grid” found in the “general matters” file. This action grid contains headings for a description of the action, a “due in period”, “number of extensions”, “extension term”, call up, attorney 1, attorney 2, and paralegal. OPS 56.1(a) ¶ 83. The screen contains fields for “case type”, “title/description”, “status”, “internal reference number”, “party involved”,

“opposing/other party”, “attorney 1”, “attorney 2”, and “paralegal”. (OPS 56.1(a) ¶ 84). OPS claims protection for a small number of these fields or the functions they perform. For example, OPS alleges protection for the user's ability to choose the case “type” and “status” from lists that the user himself defines at the predefinition level. See OPS 56.1(a) ¶¶ 79, 85, 86. Most generally, OPS identifies the similarity between this action grid and the general matters file “Action Grid” and seeks protection based on the same features and for the same reasons as it did in connection with the grid on the main trademark screen. (OPS 56.1(a) ¶ 89). This grid is protectable to the same extent as the action grid on the main trademark screen.

13

For example, if a particular action needs to be taken once each year (referred to as a “cyclic” action) and is due to be completed on June 1, 1998, upon entry of a completion date reflecting that the action was complete on June 1, 1998, the program automatically displays a new due date of June 1, 1999. OPS even refers to this element as a function. See Ross Decl. Exh. A at 33, ¶ 52. Moreover, a similar method was used in WorldMark DOS, which pre-dated PATTSY, so this element is not original. Moreover, the idea at issue here is keeping a running record of renewal dates for trademark applications. The manner in which this program expresses that idea is limited, and as a result this method of expression is susceptible to the merger doctrine, as there are but a few ways of carrying out this idea.

14

OPS seeks protection for similar functions in connection with the action grid found on the “Countries” screen. In particular, items seventy and seventy-four relate to the interrelation between actions and base dates and describe the manner in which the program automatically docket actions whenever that base date is entered in a trademark record. (OPS 56.1(a) ¶ 70). Item 71 describes how the program calculates the “final date” as a function of the number and length of extensions given to a particular action (OPS 56.1(a) ¶ 71), item 72 describes the predefinition of a “Call Up” date, which indicates the precise amount of time in advance of a due date when the action should begin to appear on the attorney's docket (OPS 56.1(a) ¶ 72), item 73 describes predefinition of “cyclic” actions, including the “subsequent” time period in which they were to be completed, and items 75–78 describe predefinition of the docket directing indicators, which trigger notification of up to two attorneys and a paralegal responsible for a given trademark file (OPS 56.1(a) ¶¶ 75–77) by the user's entering “yes” or “no” in a specified field on the grid (OPS 56.1(a) ¶ 78). For the reasons discussed in connection with the main trademark screen's action grid, these elements describe processes barred from copyright protection under § 102(b). Moreover, a prior IPN program, WorldMark DOS, had a feature quite similar to the “cyclic” predefinition described in item 73, through which dates for repetitive actions were calculated. OPS concedes that the feature may be similar, but contends that the “expression of a pre-defined cyclic action is completely different than the expression in PATTSY.” Ross Decl. Exh. A, at 71, ¶ 73. OPS's conclusory assertion that the “expression” is somehow different in PATTSY is misplaced as the item at issue describes a process rather than expression and as such is precluded from protection by § 102(b).

15

Specifically, depending upon trademark action at issue, the program accesses the relevant countries file, extracts the call-up period information, subtracts that amount of time from the ultimate due date, and then sends docket reports to responsible individuals that many days before the ultimate due date. For example, the program identifies that the renewal date for a trademark is November 15, 1998; the call-up period for such an action is 6 months. Hence the program subtracts that period from the November 15, 1998 date and begins issuing notification on May 15, 1998, until the renewal has been completed.

16

For example, the data table for predefined actions contains a number of fields, set to store information previously placed in corresponding fields such as the action, country code, action description, action type, base date for calculation, time before action is due, number of extensions, extension period, time before first call up, time between cycles (for cyclic actions), attorney/paralegal designation, fields to store information on the date the file was most recently updated as well as the name of the person who most recently updated the field. (OPS 56.1(a) ¶¶ 142–56).

17

This is, of course, assuming that the screen display is distinctive and hence entitled to trade dress protection in the first place—an issue not contested on this motion but on which OPS will bear the burden of proof going forward.

18

Because I have not dismissed OPS's federal claims, supplemental jurisdiction continues to lie over OPS's state law claims. 28 U.S.C. § 1367. Accordingly, IPN's motion to dismiss the state law claims for lack of subject matter jurisdiction, made contingent on dismissal of the federal claims, is denied as moot.