IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF UTAH

ESTHER ISRAEL, Plaintiff, v. UNIVERSITY OF UTAH, DONALD STEVEN STRASSBERG, JORDAN ELIZABETH RULLO, JULIA MACKARONIS, KELLY KINNISH and MICHAEL MINER, Defendants.	MEMORANDUM DECISION AND ORDER DENYING PLAINTIFF'S MOTION FOR LEAVE TO AMEND Case No. 2:15-CV-741 TS District Judge Ted Stewart

This matter is before the Court on Plaintiff's Motion for Leave to File an Amended Complaint. For the reasons discussed below, the Court will deny the Motion.

I. BACKGROUND

Esther Israel ("Plaintiff") filed a Complaint against the University of Utah, Donald Steven Strassberg, Jordan Elizabeth Rullo, Julia Mackaronis, Kelly Kinnish, and Michael Miner (collectively, "Defendants") on October 16, 2015. Plaintiff filed a Motion for Leave to Amend on September 26, 2016, seeking to add an additional alleged infringing publication titled "Beholder and Beheld: A Multilevel Model of Perceived Sexual Appeal" (the "Publication") and three additional state-law claims of: (1) breach of fiduciary duty/implied warranty of good faith against the University of Utah and Dr. Strassberg; (2) promissory estoppel; and (3) violation of the common law right of publicity against the University of Utah, Dr. Strassberg, and Dr. Rullo. Defendants oppose Plaintiff's Motion, claiming the addition of these claims would be futile.

II. MOTION TO AMEND STANDARD

Generally, once a responsive pleading is filed, "a party may amend its pleading only with the opposing party's written consent or the court's leave."[1] Federal Rule of Civil Procedure 15(a) specifies that "[t]he court should freely give leave when justice so requires."[2] The Supreme Court has indicated that leave sought should be given unless "undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, [or] futility of [the] amendment"[3] is present. "A proposed amendment is futile if the complaint, as amended, would be subject to dismissal."[4]

III. DISCUSSION

To resolve Plaintiff's Motion, the Court must consider whether amendment would be futile. The Court will consider Plaintiff's proposed additional claims in turn.

A. COPYRIGHT INFRINGEMENT

In order to establish copyright infringement, two elements must be met: (1) ownership of a valid copyright; and (2) copying of constituent elements of the work that are original.[5]

Defendants assume for the purposes of this Motion that Plaintiff has a valid copyright in her work. Thus, Plaintiff must sufficiently allege that Defendants copied constituent elements of her work that are original. To prove copying, Plaintiff must establish that the Defendants copied

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[1] Fed. R. Civ. P. 15(a)(2).

[2] *Id.*

[3] *Foman v. Davis*, 371 U.S. 178, 182 (1962).

[4] *Jefferson Cty. Sch. Dist. No. R-1 v. Moody's Inv'rs Servs., Inc.*, 175 F.3d 848, 859 (10th Cir. 1999).

[5] *Blehm v. Jones*, 702 F.3d 1193, 1199 (10th Cir. 2012).

Plaintiff's work as a factual matter and, as a mixed issue of fact and law, that the elements copied were protected.[6]

To prove copying of legally protectable material, a plaintiff must demonstrate that there is a substantial similarity between the legally protectable elements of the original work and allegedly infringing work.[7] In order to decide whether two works are substantially similar, the court asks "whether the accused work is so similar to the plaintiff's work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff's protectable expression by taking material of substance and value."[8] To determine whether the defendant has copied legally protectable material, courts often utilize the "abstraction-filtration-comparison" analysis.[9] This analysis is described as follows:

> At the abstraction step, we separate the ideas (and basic utilitarian functions), which are not protectable, from the particular expression of the work. Then, we filter out the nonprotectable components of the product from the original expression. Finally, we compare the remaining protected elements to the allegedly copied work to determine if the two works are substantially similar.[10]

Plaintiff states that the Publication "utilizes the Original Material as well as an unpublished rating system (e.g., view, explicitness, picture quality and target population) Israel placed in her Original Material to evaluate the pictures in her master's thesis study; thus,

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[6] *Jacobsen v. Deseret Book Co.*, 287 F.3d 936, 942 (10th Cir. 2002).

[7] *Id.* at 942–43.

[8] *Id.* at 943 (quoting *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1288 (10th Cir. 1996)).

[9] *Id.* at 943 n.5.

[10] *Id.* (quoting *Country Kids 'N City Slicks, Inc.*, 77 F.3d at 1284–85).

Mackaronis, Strassberg, Cundiff and Cann created a derivative work that is based on Israel's Original Material."[11]

Accordingly, using the abstraction-filtration-comparison test, the Court will analyze: (1) the Plaintiff's Original Materials, which consists of study pictures,[12] study text,[13] and computer syntax;[14] and (2) the unpublished rating system.

1. Original Materials

The first step of the abstraction-filtration-comparison analysis is to separate the ideas from the expression. The pictures within Plaintiff's Original Materials were all taken from "commercially available magazines . . . , websites . . . and clothing catalogues."[15] Because the pictures were taken from these sources, Plaintiff does not have any copyright in the individual pictures. However, Plaintiff's "original selections or arrangements of [unprotected] elements may be protectable."[16]

Next, the text of the Original Materials appears to be copyrightable and protectable material. It is well established that an author's expression of ideas are protectable, however, the ideas themselves are not protectable.[17] Applying this to the text of the Original Materials, the

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[11] Docket No. 37 Ex. 1 ¶36.

[12] Docket No. 43 Ex. 1.

[13] *Id.* Ex. 2.

[14] *Id.* Ex. 3.

[15] *Id.* Ex. 4, at 52.

[16] *Savant Homes, Inc. v. Collins*, 809 F.3d 1133, 1139 (10th Cir. 2016).

[17] *Feist Publication, Inc. v. Rural Telephone Servs. Co., Inc.*, 499 U.S. 340, 350 (1991).

idea of a voluntary survey based on sexuality is not protectable. However, similar to Plaintiff's arrangement of pictures, her expression is protectable.

Finally, the computer syntax of the Original Materials may have protectable elements. However, Plaintiff's proposed Amended Complaint does not provide enough information for the Court to gauge whether or not protectable elements are present.

The next step in the abstraction-filtration-comparison analysis is to compare the remaining protected elements to the allegedly copied work to determine if the two works are substantially similar. Copyright law only protects against the copying of expression, but ideas themselves, or expression that falls under the "merger doctrine" is not copyrightable.[18] "Under the merger doctrine, copyright protection is denied to expression that is inseparable from or merged with the ideas, processes, or discoveries underlying the expression."[19] Similarly, under the *scenes a faire* doctrine, protection is denied to expressions that are "standard, stock, or common to a particular topic or that necessarily follow from a common theme or setting."[20]

Comparing the Original Materials pictures to the Publication, substantial similarity is not met. The Publication used 34 photographs of men and 34 photographs of women from a variety of media sources, similar to the Original Materials.[21] However, Plaintiff has not shown that the Publication copied Plaintiff's protectable selection and arrangement of photographs. The mere idea of using photographs of men and women from media sources in a study about sexuality is not protectable expression. Thus, there is no infringement.

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[18] *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 838 (10th Cir. 1993).

[19] *Id.*

[20] *Id.*

[21] Docket No. 42 Ex. B, at 3.

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