

UNITED STATES DISTRICT COURT  
DISTRICT OF NEW HAMPSHIRE

T-PEG, INC and )  
TIMBERPEG EAST, INC., )  
Plaintiffs, )  
)  
vs. ) No. 03-CV-462-M  
)  
VERMONT TIMBER WORKS, INC., )  
and DOUGLAS FRIANT, )  
Defendants. )

DEFENDANTS' MEMORANDUM IN SUPPORT OF  
MOTION FOR RECONSIDERATION  
OF PORTION OF MARCH 28, 2008 ORDER (Document 147)

Defendants, Vermont Timber Works, Inc. ("VTW") and Douglas Friant ("Friant"), have moved the Court to reconsider that portion of its March 28, 2008 Order which denies their motion for summary judgment ("MSJ II") (Document 44) on the stated ground it "has been foreclosed by the court of appeals, see T-Peg, 459 F. 3d at 110." (Document 147 at 13-14) This memorandum is submitted in support.<sup>1</sup>

DEFENDANTS' MSJ II (DOCUMENT 44) WAS BASED ON NON-PROTECTABILITY OF THE DESIGN ELEMENTS ALLEGEDLY COPIED, NOT COPYRIGHTABILITY OF THE OVERALL DESIGN

The basis of Heading I of the MSJ II (Document 44 at 4-9) was that "The Elements Allegedly Copied Are Not Protectible" (Document 44, at 4), and Sub-Heading B made clear that this was based on "Filtering out Of Design Elements Which Are (1) Non-Original, (2) Standard Features, (3) Functionally Required, (4) Used With Permission, or (5) Mere Ideas" (Document 44, at 4). This was clearly based on the Feist requirement that "to establish copyright infringement, [a plaintiff must prove] copying of constituent elements of the work

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<sup>1</sup> The reconsideration issue is separate from the issues the Court has directed the parties to brief, and VTW will go forward with that briefing parallel to this motion for reconsideration.

that are original.” Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 361 (1991); T-Peg, 459 F. 3d at 108.

Admittedly the overall title of the MSJ II stating that it was “On Non-Copyrightability” was confusing and unfortunate. However, the text of the MSJ II argument (Document 44 at 4-9) makes it absolutely clear that it is addressed to the issue of “filtering” or “separating out” the non-protectible design elements, that is, the Feist issue. Since the federal courts apply notice pleadings, not technicalities, the title is unfortunate but irrelevant. Moreover, the subsequent pleadings on this motion from both sides, (Documents 56, 60, 145, 146 and 148) make it absolutely clear that “filtering” or “separating out” of non-protectible elements was the issue being briefed by both sides. Plaintiffs themselves acknowledged (e.g., Document 56, at 5, “filtering out;” and Document 146, at 3-5, “disaggregation theory”) that the motion addresses the “filtering out” or “separation” process.

Indeed, the most significant of the elements VTW proposes to “filter out” or “separate out” – the floorplan measurements – are not unprotectible because of non-copyrightability, but because Timberpeg gave permission when it sold Isbitski the foundation plan and expressly authorized him to use the foundation plan. Thus the broader term “non-protectibility,” used in the memoranda after the original motion, is more appropriate.

In any event, the MSJ II, Heading I ground – “The Elements Allegedly Copied Are Not Protectible” – was never determined or even addressed by this Court, which dismissed all of the MSJ II as “moot” when granting the MSJ I (Document 90, at 31).

### THE MSJ I RULING

This Court’s initial resolution of the case was based on defendants’ MSJ I, filed August 16, 2004 (Document 23), Heading 1(b). The MSJ I made no argument to “filter out” or

“separate” the protectible from the non-protectible, but simply argued that even accepting everything in plaintiffs’ plans as protectible, there still was no “substantial similarity.” Document 23 at 15. VTW’s argument there was that there could not be substantial similarity because

VTW did not design or build anything but a timber frame [whereas] the Timberpeg floor plan does not even contain a drawing of a frame.

That was precisely the argument this Court accepted, and which was the basis of its MSJ I ruling:

[P]laintiff’s infringement claim fails because the allegedly infringing work, VTW’s shop drawings, lack probative similarity to the second set of preliminary plans. . . . The second set includes no frame drawings. The VTW shop drawings depict nothing other than a timber frame.

Document 90 at 16-17. The Court reiterated this ruling in its reaffirmation of the summary judgment. Document 98, at 9 (“VTW did not design or build that house; it only designed and built the timberframe”).

In short, absolutely nothing in the MSJ I motion papers or the ruling thereon addressed, in any way, the “separation”/“filtration” concepts at issue in MSJ II.

#### THE FIRST CIRCUIT MANDATE AND “LAW OF THE CASE”

An appellate court’s jurisdiction only addresses the issues ruled on in the inferior court and set forth in the notice of appeal. Kotler v. American Tobacco Co., 981 F. 2d 7 (1<sup>st</sup> Cir. 1992). The concept of “law of the case” governs what aspects of an appellate court’s ruling is binding on the lower court on remand, and “law of the case” binds a lower court only when a higher court has ruled on the issue before it. Absent a ruling by a higher court, a lower court is always free to reconsider and revise its own rulings, or to address matters not previously addressed:

The doctrine of law of the case comes into play only with respect to issues previously determined [by a higher court]. On remand, the [lower court] may consider and decide any matters left open by the mandate of

[the higher] court. . . While a mandate is controlling as to matters within its compass, on the remand a lower court is free as to other issues.

Quern v. Jordan, 440 U.S. 332, 347 n. 18 (1979). See also, Field v. Mans, 157 F. 3d 35, 40 (1<sup>st</sup> Cir. 1998):

For a bar to exist, an issue must have been actually considered and decided by the appellate court, or a decision on the issue must be necessarily inferred from the disposition on appeal. The [law of the case] doctrine does not bar litigation of all questions which were within the issues of the case and which, therefore, might have been decided.

See also, Wright & Miller, Federal Practice & Procedure §4478, at 789 (1981) (“Questions that have not been decided do not become law of the case merely because they could have been decided.”)

The reversal of a summary judgment occupies a unique, weak “law of the case” status, as the reversal is not itself a dispositive order but merely a determination that, based on the evidence presented at that stage, there was an issue of fact. Indeed, since the party moving for summary judgment may have discovered additional evidence after the appellate reversal, it is even conceivable that a renewed summary judgment on the same ground could be made after an appellate reversal. That is not what VTW is doing here, but the possibility illustrates the reality that the First Circuit ruling could not be “law of the case,” and could not foreclose consideration now, of any points not considered by this Court and the First Circuit in Round 1.

Clearly this Court was considering “law of the case” principles in stating that

the court of appeals did not have before it the issue of whether plaintiffs’ architectural work was copyrightable. . . . To be sure, the court did state that “Timberpeg bases its claims here on a combination of elements, which taken together, are protectable under the definition of an architectural work in 17 U.S.C. §101. T-Peg, 459 F. 3d at 115. But because this court never reached defendants’ argument that plaintiffs’ architectural work was not copyrightable (see document no. 90 (mooting document no. 44, in which defendants first raised their argument on non-copyrightability)), the court of

appeals, necessarily, did not decide that the work is, as a matter of law, copyrightable.

Document 147 at 14-15 (emphasis added). But defendants respectfully urge that the Court’s “law of the case” analysis did not go far enough: The court of appeals also did not have before it (1) the “separation”/ “filtration” issue, (2) the effect of plaintiffs’ authorizing Isbitski to use the foundation plan, or (3) the formal admissions by plaintiffs that they do not claim originality or copyrightability in several design components, which were the true bases of the MSJ I.

It necessarily follows from the limited character of this Court’s original summary judgment grant, that the First Circuit ruling vacating it also did not rule on these issues, and its mandate does not encompass them. These issues were raised for the first time in the MSJ II, which was never ruled on.

The holding (mandate) of the First Circuit reversal was the same point on which this Court had entered summary judgment: that a mere frame design could indeed infringe a work which had no frame:

The district court and VTW emphasized that VTW designed only a frame, while Timberpeg’s plans did not contain a complete frame design. This emphasis wrongly assumes that the only question here is whether a reasonable jury could conclude that VTW’s frame is substantially similar to Timberpeg’s *frame design* and that since Timberpeg never designed a complete frame, there can be no infringement. That is wrong.

459 F. 3d at 114 (italics by the Court).<sup>2</sup>

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<sup>2</sup> To be sure, in giving the ruling context by reciting the two elements under Feist, 349 F. 3d at 108, bottom, the First Circuit noted that

VTW does not challenge Timberpeg’s ownership of a valid copyright in this case. This leaves the question of whether VTW “cop[ied] constituent elements of the work that are original,” citing Feist.

But neither this introductory recitation of the “rules” nor the First Circuit’s listing of “similarities” at page 113 constituted a ruling on those issues, which simply were not a part of the MSJ I. Indeed, this Court’s MSJ I ruling contained no fact recitations about “filtering” or “separating,” about the permission to use the foundation

POSSIBLE CONFUSION BETWEEN DISTINCT CONCEPTS  
OF “SEPARABILITY TEST” AND “SEPARATION” [FILTRATION] TEST

Possibly the First Circuit’s comments at the bottom of 459 F. 3d 110, relating to the “separability test,” have caused confusion. For “pictorial, graphic and sculptural works” the protectible interests must be “separable from the utilitarian aspect of the work” under 17 U.S.C. §102(a)(5). Defendants accept this concept, which is dealt with at length in Nimmer On Copyright §2.18, but which is entirely different from the “filtering test” – which confusingly is called the “separation” or “dissection” test in the First Circuit, Johnson v. Gordon, 409 F. 3d 12, 17 (1<sup>st</sup> Cir. 2005).<sup>3</sup>

Under the separation test a lower court “must engage in dissection of the copyrighted work by separating its original, protected, expressive elements from those aspects that are not copyrightable.” Id., 409 F. 3d at 17. This is based on the Feist mandate that, in addition to having an overall work which is copyrightable, the plaintiff must prove “copying of constituent elements of the work that are original.” Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 361 (1991).

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plan, or about Timberpeg’s admissions that several components were not creative or copyrightable. Neither did either party mention these points in the fact sections of their appellate briefs.

Moreover, while the First Circuit listed similarities in dimension and shape as facts which a jury could use to support “similarity,” 459 F. 3d at 113, it certainly did not consider defendants’ argument in MSJ II that these precise similarities were irrelevant because they had been licensed to Isbitski when plaintiffs authorized him to use the foundation plan. The “permission” could not have been considered, and could not have been factored into the First Circuit holding, because it was not a part of the MSJ I, was not part of this Court’s MSJ I ruling, and was not presented or briefed in the First Circuit. So in no way was it “foreclosed by the court of appeals” as this Court stated in its recent ruling, Document 147 at 13-14.

<sup>3</sup> In addition, recent cases in other courts have made clear that the “separating out” or “filtering out” of non-protectible elements is a clear requirement of the infringement analysis in architectural work cases, as shown in defendants’ Supplemental Memo (Document 148) which this Court specifically permitted them to file even after issuing the Order sought here to be reconsidered.

Most assuredly this dissection or separation process has never been addressed in this case either by this Court or the First Circuit, although it was properly raised by defendants in their MSJ II, Heading I. They are entitled to have it addressed.

**EVEN A PARTIAL RULING WOULD BE BENEFICIAL TO THE PARTIES AND THE PROCESS**

While defendants firmly believe that “separating out” or “filtering out” the protectible elements from the non-protectible will end in a complete summary judgment in their favor, even a partial ruling would be beneficial to the parties and to the efficiency or workability of the trial process in eliminated the non-protectible elements from consideration. For example, it is inconceivable that this Court would permit plaintiffs to claim infringement of the floorplan after having sold the foundation plan to the owner, Isbitski, and expressly having authorized him to use it. Even if the Court only ruled as to the “authorized” elements directly flowing from the foundation plan, it would substantially narrow the issues for trial.

**CONCLUSION**

For the above reasons, defendants respectfully request that the Court reconsider its Order (Document 147 at 13-14), solely to the extent it declined to address the MSJ II’s argument that there are no protectible elements which are alleged to have been copied.

Date: April 8, 2008

VERMONT TIMBER WORKS, INC.  
and DOUGLAS FRIANT,  
Defendants,

/s/ W. E. Whittington  
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CERTIFICATE OF SERVICE

I hereby certify that on April 8, 2008, I served the foregoing pleading on the following counsel of record, by causing it to be filed electronically via the CM/ECF filing system or mailed by first-class United States Mail, postage pre-paid, or in such other manner as may be indicated:

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