

NOT FOR PUBLICATION

**UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY**

AMERICAN BOARD OF INTERNAL
MEDICINE,

Plaintiff,

v.

JAMIE SALAS RUSHFORD, M.D.,

Defendant.

Civil No.: 14-cv-6428 (KSH) (CLW)

OPINION *FILED UNDER SEAL*

Katharine S. Hayden, U.S.D.J.

I. Introduction

This matter is before the Court on the parties' cross-motions for summary judgment.

Plaintiff American Board of Internal Medicine ("ABIM") has asserted that defendant Dr. Jaime Salas Rushford ("Salas Rushford")¹ emailed material allegedly found in one or more ABIM board certification examinations to the proprietor of a test-preparation company whose review course he had attended, and that this conduct was copyright infringement. Salas Rushford concedes sending emails, but denies that what he sent was protected. The motions are fully briefed, and the Court decides them without oral argument.

II. Factual Background

A. Board Certification by ABIM and Salas Rushford's Pursuit of It

ABIM is an Iowa non-profit corporation based in Philadelphia, Pennsylvania. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 1.)² It is a physician-led organization that certifies doctors practicing

¹ Salas Rushford's first name is spelled differently in the caption and in parts of the record. This opinion uses the spelling "Jaime," as that is what appears in the defendant's submissions on the pending motions.

² The factual statements recited herein are undisputed unless otherwise noted.

internal medicine and related subspecialties. (*Id.* ¶ 2.)³ A doctor designated “board certified” by ABIM has “met certain educational, training, and professionalism requirements, and passed a secure, proctored, computer-based examination in internal medicine.” (*Id.* ¶ 4; *see also id.* ¶ 5.) The one-day, ten-hour exam is administered at testing centers across the country and abroad. (*Id.* ¶¶ 7-8.) In August 2009, the ABIM exam was offered in Puerto Rico on August 11, 12, 14, 17, 18, 20, 24, 25, 26, and 27. (*Id.* ¶ 9.) ABIM uses various measures to ensure the secrecy and security of the exam questions, including confidentiality agreements imposed on test-takers as a condition for taking the exam, and “numerous physical and electronic controls” over exam content storage and access. (*Id.* ¶ 11.) The third-party centers where the exams are administered also have procedures in place to protect the secrecy of the exam content. (*Id.* ¶ 12.)

Salas Rushford attended medical school in Puerto Rico and subsequently trained at hospitals in New York City. (*Id.* ¶ 47.) From 2008 to 2009, he completed his training in Puerto Rico. (*Id.* ¶ 48.) In approximately December 2008, he registered for the August 2009 ABIM examination in Puerto Rico. (*Id.* ¶ 49.) He scheduled his exam for August 20, 2009. (*Id.* ¶ 51.)

On November 5, 2008, Salas Rushford signed up for a board review course with Arora Board Review (“ABR”), run by Dr. Rajender Arora (“Arora”). (*Id.* ¶ 52.) On the order form, the email address he used was jsalasmd@yahoo.com. (*Id.* ¶ 53.) He also used that email address to ask Arora a scheduling question in December 2008. (*Id.* ¶ 54 & Pl. Ex. 8.)

Salas Rushford went on to attend the ABR course from May 18 to 23, 2009. (*Id.* ¶ 55.) A few days later, he emailed Arora asking about the price of another course (again using the same email address). (*Id.* ¶ 56 & Pl. Ex. 10.) On August 20, 2009, Salas Rushford sat for, and

³ Salas Rushford disputes other aspects of ABIM’s factual assertions in this paragraph, but not that it certifies internal medicine doctors. (D.E. 212-2, Def. R. 56.1 Counterstatement ¶ 2.)

passed, the ABIM internal medicine board certification exam. (D.E. 212-3, Def. R. 56.1 Stmt. ¶ 12.) It is undisputed that he did not share the contents of his exam with anyone, including Arora. (*Id.*) ABIM’s theory of liability is different: it claims that a series of emails Salas Rushford sent or received in August 2009 *before* he sat for his exam included the contents of test questions protected by copyright. Those emails are discussed further *infra*.

B. ABIM’s 2009 Investigation

ABIM came to believe that ABR, Arora’s test-prep company, was engaging in copyright infringement based on sample test questions posted on ABR’s website, and decided to investigate. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶¶ 144-45.) In December 2009, ABIM sued ABR, Arora, and Dr. Anise Kachadourian (alleged to be Arora’s assistant) in the Eastern District of Pennsylvania, alleging that the company “unlawfully obtained ABIM’s secure [e]xamination items by mobilizing course attendees to divulge the contents of the [e]xamination” in violation of federal copyright law. *Am. Bd. of Internal Med. v. Arora*, Civ. No. 09-5707, Dkt. Entry 1, at 1 (E.D. Pa. Dec. 2, 2009) (the “Arora action”). That complaint also named John Doe defendants, “a presently unknown number of past and/or present candidates for Board Certification who have complied with [Arora’s] requests . . . to provide secure, copyrighted [e]xamination content to Arora for further dissemination.” *Id.* When ABIM initiated the Arora action, it obtained an *ex parte* seizure order permitting it to enter ABR’s and Arora’s premises in Livingston, New Jersey, and take possession of infringing materials (as defined in the order) and related items, including correspondence with ABR customers relating to infringement. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 145 & Pl. Ex. 24.) ABIM seized documents and computer files from ABR’s location. (*Id.* ¶¶ 146-47.)

The Arora action settled in six months and was dismissed in June 2010. *Arora*, Civ. No. 09-5705, Dkt. Entry 24 (E.D. Pa. June 11, 2010). But ABIM continued to pursue individual physicians; the same day it filed papers to resolve the *Arora* action, ABIM posted a press release stating that it “took formal action today [i.e., June 9, 2010] to sanction 139 physicians for soliciting or sharing confidential exam questions used to certify doctors in internal medicine and its subspecialties.” (See ABIM, *ABIM Sanctions Physicians for Ethical Violations* (June 9, 2010), <https://www.abim.org/media-center/press-releases/abim-sanctions-physicians-for-ethical-violations.aspx> (“ABIM Press Release”); D.E. 212-3, Def. R. 56.1 Stmt. ¶ 22 (citing ABIM Press Release).)⁴

ABIM’s press release went on to state that the doctors in question all participated in ABR’s review course and described sanctions ABIM was imposing on them, including suspension of board certification for up to five years of already-certified doctors; a one-year bar on taking the exam for not-yet-certified doctors; and revocation for any doctor “who systematically sought to undermine certification through the organization, collection and distribution of ABIM exam questions.” (ABIM Press Release.) One of the affected physicians was Dr. Geraldine Luna, who reached a confidential settlement with ABIM in July 2011. (D.E. 212-3, Def. R. 56.1 Stmt. ¶ 22 (citing Def. Ex. 7 (Luna Settlement Agmt.)).) As discussed below, Luna figures prominently in ABIM’s infringement claim against Salas Rushford.

ABIM also reported in its 2010 press release that it had sued several doctors allegedly involved in sharing questions with Arora. (ABIM Press Release.) *See also Am. Bd. of Internal*

⁴ ABIM disputes the accuracy of Salas Rushford’s characterization of its actions as a “program of extracting \$15,000 payments and cooperation guarantees from physicians who had, unlike [Salas Rushford], spoken about their own test, under threat of revoking or not granting their board certification,” but as to the press release, concedes that it “speaks for itself.” (D.E. 215-1, Pl. Response to Def. R. 56.1 Stmt. ¶ 22.)

Med. v. Mukherjee, No. 10-CV-2676, 2011 WL 294029, at *1 (E.D. Pa. Jan. 31, 2011) (“The instant case is one of a series of lawsuits commenced on June 4, 2010 by [ABIM] against several individual physicians who it alleged had copied and disseminated its ‘secure, copyrighted Examination items’ from its Certifying Examination in Internal Medicine.”); *id.* at *1 n.1 (listing four additional cases commenced the same day).⁵

C. ABIM’s Pursuit of Salas Rushford

ABIM’s lawsuit against Salas Rushford was not part of the initial crop of actions it initiated in June 2010. Instead, in May 2012 (a delay ABIM attributes to Salas Rushford’s purported efforts to conceal his identity when he communicated with Arora in August 2009) ABIM notified Salas Rushford that it was seeking to revoke his board certification through an internal disciplinary process. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 154.) Salas Rushford appealed the recommended sanction, which was a permanent revocation of his board certification, through an “appeal process” that concluded with a hearing on July 24, 2014, before a panel of ABIM-

⁵ Of the five lawsuits referenced in the *Mukherjee* case and in ABIM’s press release, it appears that one went to trial. *American Board of Internal Medicine v. Von Muller* resulted in a jury verdict against a doctor who bought actual exam questions from ABR “for \$480 plus her promise to provide actual test questions to Arora after she took the examination.” No. 10-CV-2680, 2012 WL 2740852, at *1 (E.D. Pa. July 9, 2012). There, ABIM submitted evidence that Von Muller “independently recalled” the details of her examination questions and transmitted that information to Arora with the understanding that it would be used in future board review courses. *Id.* at *5 n.1.

The other four cases were dismissed on jurisdictional grounds either by court order or voluntarily by ABIM. *See Mukherjee*, 2011 WL 294029, at *1; *Am. Bd. of Internal Med. v. Todor*, No. 10-cv-2678, 2011 WL 344077, at *1 (E.D. Pa. Feb. 1, 2011); *Am. Bd. of Internal Med. v. Oni*, No. 10-cv-2679, 2010 WL 3860444, at *1 (E.D. Pa. Sept. 30, 2010); *Am. Bd. of Internal Med. v. Salehi*, No. 10-cv-2677, Dkt. Entry 15 (E.D. Pa. Dec. 16, 2010). It is unclear whether those actions were re-filed elsewhere; the Court has found no indication that they were.

designated doctors. (*Id.* ¶¶ 155-56.) The panel issued a written decision on October 16, 2014, that changed the sanction to a seven-year suspension. (*Id.* ¶ 156.)

D. Procedural History of this Action

The day after ABIM’s internal disciplinary proceedings against Salas Rushford concluded with the reduced sanction, ABIM sued him in this court for copyright infringement. (D.E. 1, Compl., filed Oct. 17, 2014.) Salas Rushford characterizes the decision to file as a response to his threat to legally challenge the suspension of his board certification; ABIM denies knowing about that. (D.E. 212-3, Def. R. 56.1 Stmt. ¶ 18; D.E. 215-1, Pl. Response to Def. R. 56.1 Stmt. ¶ 18.)

ABIM alleges that Salas Rushford “unlawfully obtained, copied and disseminated” ABIM exam questions to Arora Board Review. (Compl. ¶ 1.) The complaint describes a series of emails in which Salas Rushford either sent or received material alleged to be from ABIM exams. ABIM charges that Salas Rushford’s “unauthorized copying and distribution of and creation of derivative works based on [ABIM’s internal medicine certification] Examination” amounted to actual, willful infringement of ABIM’s copyrights. (*Id.* ¶¶ 53-54.) By way of relief, the complaint sought compensatory and “[a]pplicable” statutory damages, along with costs and attorneys’ fees. (*Id.*, Prayer for Relief.)

In September 2015, this Court resolved initial motion practice concerning personal jurisdiction and issues related to a parallel action ABIM filed in the District of Puerto Rico. (D.E. 26, 27.) After that, Salas Rushford moved for judgment on the pleadings that ABIM’s copyright claim against him was time-barred under the Copyright Act’s three-year statute of limitations, 17 U.S.C. § 507(b). In March 2017, the Court granted his motion and dismissed ABIM’s complaint. (D.E. 153, 154.) The Court reasoned that the alleged infringement took

place in August 2009; ABIM filed suit in October 2014, five years later; and that neither the discovery rule nor equitable tolling applied because by its own account, ABIM learned of the facts necessary to sue Salas Rushford within the original limitations period.

Separately, when he answered the complaint, Salas Rushford asserted counterclaims and third-party claims against ABIM and various ABIM officers, challenging their conduct in connection with suspending his board certification and asserting statutory and common law causes of action. (D.E. 33.) In September 2017, Magistrate Judge Waldor granted Salas Rushford’s motion to transfer his claims (which, by virtue of this Court’s March 2017 dismissal of ABIM’s copyright claim, were at that point the only live claims) to the District of Puerto Rico. (D.E. 173.) This Court upheld Judge Waldor’s ruling in June 2019. (D.E. 181, 182.)

On June 25, 2019, after Salas Rushford’s counterclaims and third-party claims were transferred, ABIM appealed this Court’s March 2017 order dismissing its copyright claim to the Third Circuit, which reversed. (D.E. 183 (Notice of Appeal); D.E. 190-1 (Third Cir. Opinion).) The panel held that the discovery rule “means that the statute of limitations period begins to run as of the date of discovery of the cause of action,” after which, under 17 U.S.C. § 507(b), the plaintiff has three years to sue. (Third Cir. Op. at 6.) The panel identified the date of discovery of the cause of action as January 2012, when ABIM “was tipped off by another test taker” and thereby “discovered Rushford’s (intentionally concealed) identity.” (*Id.*) Per the ruling, section 507(b)’s limitations period did not begin to run from the date of injury (August 2009) even though ABIM discovered Salas Rushford’s identity within three years thereafter; it began to run when ABIM discovered his identity (January 2012), which equated with ABIM discovering its cause of action. (*Id.* at 1, 6.) A complaint filed in October 2014 was within three years of January 2012 and therefore was timely. (*Id.* at 6.)

The panel further concluded that even absent the discovery rule, “ABIM’s allegations concerning Rushford’s deliberate attempts to disguise his identity should have warranted the application of equitable tolling,” identifying those attempts as “using a pseudonym and an email address that conceals one’s identity.” (*Id.* at 7.) The case was remanded for further proceedings.

Despite the restoration of ABIM’s copyright claim, it took no action to continue litigating the case on remand. Ultimately this Court prompted the parties to address whether they intended to continue pursuing the case and, if so, how. (*See* D.E. 191, 192.) ABIM indirectly attributed the dormancy of its case to the litigation of Salas Rushford’s counterclaims and third-party claims in the District of Puerto Rico and, later, the First Circuit. (D.E. 193.)⁶ Settlement efforts under the supervision of Magistrate Judge Waldor were unsuccessful, and active litigation resumed, culminating in these summary judgment motions issued under Judge Waldor’s briefing schedule. (D.E. 206.)

E. Summary Judgment Motions

In seeking summary judgment, ABIM casts this as a straightforward case of infringement: it created original content in preparing the exams; it registers its exams with the United States Copyright Office and has received registration certificates for the exams at issue here; it owns the copyrights in the registered materials; and the copyrights cover the exam content in Salas Rushford’s emails, which ABIM seeks to prove with both direct evidence of copying and circumstantial evidence in the form of access plus similarity. (D.E. 207-1, Pl. Moving Br.) Among the exhibits ABIM offers in support of its motion is the expert report of

⁶ On August 29, 2024, the First Circuit affirmed the District of Puerto Rico’s grant of judgment on the pleadings in favor of ABIM and the other defendants in that case on Salas Rushford’s affirmative claims (i.e., the counterclaims and third-party claims originally filed in this Court and transferred to the District of Puerto Rico in 2019). *Am. Bd. of Internal Med. v. Salas Rushford*, 114 F.4th 42 (1st Cir. 2024).

Lawrence D. Ward, M.D., in which he opines that excerpts from email attachments sent by Salas Rushford are copied or derived from ABIM exam questions. Ward's report attaches a table reflecting, for each identified excerpt, which exam question he believes the excerpt copied or was derived from and why. (D.E. 207-15, Pl. Ex. 13, Report of Lawrence D. Ward, M.D. ("Ward Report").)

Ward states that the material supporting his conclusions consists of four of Salas Rushford's emails (items (1), (2), (3), and (5), as described in section IV.C., *infra*), along with two ABIM documents: first, a batch of what appears to be exam questions, Bates numbered ABIM00054 to ABIM00156 (which are provided as Exhibit 20 to ABIM's motion for summary judgment and filed at D.E. 207-22), and second, documents numbered ABIM03134 to ABIM03483 (provided as Exhibit 5 to ABIM's motion for summary judgment and filed at D.E. 207-7). The first document, Exhibit 20, is described by ABIM as "the ABIM examination questions that Dr. Ward identified as copied by" Salas Rushford, without further elaboration. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 129.) The second, Exhibit 5, is described by ABIM as "copies of screenshots of 2009 ABIM Examinations." (*Id.* ¶ 39.)

In vigorously opposing ABIM's motion and cross-moving for summary judgment, Salas Rushford challenges nearly every aspect of the infringement claim. (D.E. 212-1, Def. Cross-Mot. Br.) In addition to revisiting the claim's timeliness based on what was revealed in discovery, Salas Rushford challenges ABIM's proofs on copyrightability and asserts that it has not shown it owned the test questions when it registered the exams; has not shown copying either directly or indirectly; has not established access; has not provided a side-by-side comparison of alleged infringed/infringing content; relies on an expert report that is neither sworn nor sufficient to allow the claim to proceed; and has not sought to prove damages and has none. Generally,

Salas Rushford argues that ABIM’s attempt to fit the facts here into the framework of copyright infringement is a strained and untenable use of copyright law. Among the supporting exhibits to the opposition and cross-motion are an expert report from Westby G. Fisher, M.D., who opines on “the topic of board certification in internal medicine” (D.E. 212-6, Report of Westby G. Fisher, M.D. (“Fisher Report”), at 1), and a second expert report from Fisher responding to Ward’s report (D.E. 212-7, Rebuttal Report of Westby G. Fisher, M.D. (“Fisher Rebuttal Report”).)

In ABIM’s combined opposition to Salas Rushford’s cross-motion and reply in support of its motion, it disputes many of Salas Rushford’s arguments and explains why, in its view, certain demonstrable deficiencies in its claim are not fatal.⁷ (D.E. 215, Pl. Reply Br.) Addressing the issue of damages, ABIM’s brief discloses that it has elected not to seek actual damages for the alleged infringement, but instead is now pursuing statutory damages—but only with respect to the 2007 and 2008 exams and *not* for any infringement of the 2009 exam. (*Id.* at 24-27.) This is because ABIM concedes that Salas Rushford is correct that the 2009 exam was registered *after* his alleged acts of infringement in August 2009 and not within three months of its first publication, so statutory damages are unavailable under 17 U.S.C. § 412(2). (*Id.* at 25.)

Salas Rushford argues in his reply that this concession effectively defeats ABIM’s claim. (D.E. 216, Def. Reply Br. 1 (“ABIM’s untimely registrations comprise the basis for nearly all of its allegations in this case. ABIM has not presented any admissible evidence about any infringement on the works it registered in 2007 and 2008.” (footnote omitted).) He also

⁷ In the latter category, ABIM supplied a declaration from Ward affirming the contents of his earlier-submitted report and a copy of a post hoc July 2011 agreement that it describes as “confirm[ing] prior agreements with item-writers as to ABIM’s ownership rights” and “assign[s] ownership to ABIM” of the exam questions. (D.E. 215, Pl. Reply Br. 5 & Pl. Reply Ex. A.)

continues to challenge the validity of ABIM’s copyright registrations, its ownership of the test questions, the matter in which it presented its proofs, and the action’s timeliness.⁸

III. Standard of Review

Summary judgment is appropriate where the movant has shown that “there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). The movant has the “initial burden of showing the basis for its motion and identifying those portions of the record which it believes demonstrate the absence of a genuine issue of material fact,” after which the burden shifts to the non-moving party to ““come forward with specific facts showing that there is a *genuine issue for trial* and do more than simply show that there is some metaphysical doubt as to the material facts.”” *Carolina Cas. Ins. Co. v. Liberty Mut. Fire Ins. Co.*, 2022 WL 9997385, at *4 (D.N.J. Oct. 17, 2022) (Martini, J.) (first citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 325 (1986); and then quoting *United States v. Donovan*, 661 F.3d 174, 185 (3d Cir. 2011)).

“[A]ctual evidence” is required to show the existence of a triable fact issue, and “unsupported assertions, speculation, or conclusory allegations” do not suffice. *Id.* “The moving party is entitled to judgment as a matter of law when the non-moving party fails to make ‘a sufficient showing on an essential element of her case with respect to which she has the burden of proof.’” *TitleMax of Del., Inc. v. Weissmann*, 24 F.4th 230, 236 n.3 (3d Cir.), *cert. denied*, 142 S. Ct. 2870 (2022) (quoting *Celotex*, 477 U.S. at 323).

⁸ As to Salas Rushford’s argument relying on *Sohm v. Scholastic Inc.*, 959 F.3d 39 (2d Cir. 2020), that ABIM’s damages were limited to the three years before it filed suit, *Sohm* was recently abrogated by *Warner Chappell Music, Inc. v. Nealy*, 601 U.S. 366 (2024), and there is therefore no need to address this line of argument further.

The Court views the evidence in the light most favorable to the nonmoving party and draws all inferences in favor of that party. *Auto-Owners Ins. Co. v. Stevens & Ricci, Inc.*, 835 F.3d 388, 402 (3d Cir. 2016). To withstand summary judgment, a “genuine” dispute of “material” fact is necessary; a factual dispute is “genuine” if the evidence would permit a reasonable factfinder to return a verdict for the nonmovant, *Jutrowski v. Twp. of Riverdale*, 904 F.3d 280, 289 (3d Cir. 2018), and facts are “material” if their “existence or nonexistence might impact the outcome of the suit under the governing law.” *Carolina Cas.*, 2022 WL 9997385, at *4 (quoting *Santini v. Fuentes*, 795 F.3d 410, 416 (3d Cir. 2015)). The Court may not resolve credibility disputes or weigh the evidence in ruling at the summary judgment stage. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986).

The same standards govern when the parties have cross-moved for summary judgment. *Auto-Owners*, 835 F.3d at 402. In that scenario, the Court must “rule on each party’s motion on an individual and separate basis, determining, for each side, whether a judgment may be entered in accordance with the Rule 56 standard.” *Id.* (quoting 10A Charles Alan Wright et al., *Federal Practice & Procedure* § 2720 (3d ed. 2016)); *see also Carolina Cas.*, 2022 WL 9997385, at *4 (in ruling on cross-motions for summary judgment, the court is required to “consider each motion independently and view the evidence on each motion in the light most favorable to the party opposing the motion”).

IV. Discussion

The case against Salas Rushford began in 2014 with ABIM’s broad allegations that, more than five years earlier, Salas Rushford “unlawfully obtained, copied and disseminated hundreds of secure, copyrighted questions” from ABIM’s certifying exam in internal medicine before he took that exam, sent them to Arora, and thereafter sought to cover up what he did. (D.E. 1,

Compl. ¶ 1.) As described above, the litigation went on for years, involving several rounds of motion practice; an appeal to the Third Circuit; litigation on Salas Rushford’s own affirmative claims in the Districts of New Jersey and Puerto Rico and the First Circuit; and has now landed back here on remand from the Third Circuit. Discovery was considerable. The sealed portion of the motion record alone spans more than 11,000 pages, reflecting how dug-in and at times caustic⁹ this case has been.

Notably, there is much that this case is *not* about. Significantly, and in contrast with other actions ABIM mounted, this case is not about whether Salas Rushford breached agreements or pledges applicable to him as a candidate sitting for ABIM’s exam. ABIM neither supplies any such agreements nor does it assert any claims on that basis. *Cf. Von Muller*, 2012 WL 2740852, at *1 (“ABIM asserted that in [buying actual ABIM exam questions in exchange for money and a promise to provide Arora actual questions after she took the exam], Von Muller acted unlawfully in violation of its copyright and trade secret rights and in breach of the ‘Pledge of Honesty’ which she signed at the time she took the examination.”). ABIM’s lawsuit is not about whether Salas Rushford copied, disseminated, or published content from the exam he actually sat for. ABIM does not contend that he did, and has supplied no proof that he did. ABIM’s lawsuit against Salas Rushford is also not a referendum on ABIM’s governance.

Getting down to the operative events, there is also no claim that Salas Rushford infringed ABIM’s copyrighted 2009 exam because ABIM admits it has no entitlement to statutory damages (the only relief it seeks) as to that exam. Even absent that concession, 17 U.S.C.

⁹ The Court notes, in particular, excerpts from Salas Rushford’s deposition, in which an attorney for ABIM said, of Salas Rushford, “Let’s see just how dumb he can be,” and resisted opposing counsel’s demands that he apologize for that name-calling because Salas Rushford hadn’t “earned it.” (D.E. 212-5, Def. Dep. Tr. 94:3-22.)

§ 412(2) would compel summary judgment for Salas Rushford on any infringement claims based on the 2009 exam because the undisputed record evidence is that he sent the emails before ABIM registered its copyright on the 2009 exam, and that ABIM’s registration came more than three months after ABIM’s first publication of that exam, all of which makes statutory damages unavailable. *See Small Bus. Bodyguard Inc. v. House of Moxie, Inc.*, 230 F. Supp. 3d 290, 306 (S.D.N.Y. 2017) (granting summary judgment for defendant on infringement claim where plaintiff “cannot be awarded statutory damages—the only damages here sought” by operation of 17 U.S.C. § 412(2)); *Bumgarner v. Hart*, 2007 WL 2470094, at *5 (D.N.J. Aug. 30, 2007) (Bumb, J.) (granting summary judgment for defendant on statutory damages claim based on 17 U.S.C. § 412(2)).

ABIM’s claim that remains is this: Salas Rushford, in the attachments to four emails (two on August 12, 2009, one on August 13, 2009, and one on August 16, 2009), unlawfully copied content from ABIM’s 2007 and 2008 internal medicine certifying exams, as to which ABIM owns valid copyrights. Whether ABIM or Salas Rushford—or neither—is entitled to summary judgment begins with what the Copyright Act requires for a successful infringement claim.

A. Copyright Law and the Requirements for Infringement Claims

The Copyright Act of 1976 grants authors of original works “a bundle of exclusive rights.” *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508, 526 (2023) (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 546 (1985)); *see also* 17 U.S.C. § 102. Those exclusive rights are set forth in 17 U.S.C. § 106, and they include the right to reproduce the copyrighted work, prepare derivative works based on it, and to distribute copies of it “to the public by sale or other transfer of ownership, or by rental, lease, or lending.”

Id. § 106(1)-(3).¹⁰ Other provisions limit the scope of those exclusive rights, including the fair use defense in 17 U.S.C. § 107, *see* 17 U.S.C. § 106 (“Subject to sections 107 to 122,” the copyright owner has the listed exclusive rights), and the idea/expression dichotomy as expressed in 17 U.S.C. § 102(b), whereby protection is not extended to ideas, as opposed to the expression of ideas, *see Goldsmith*, 598 U.S. at 526 (“The Act . . . makes facts and ideas uncopyrightable, § 102 . . .”). Related limitations are the merger doctrine, which “prohibits the copyrighting of expression when there are no or few other ways of expressing a particular idea,” and a variation of it, the *scenes à faire* doctrine, which “leaves unprotected incidents, characters, or settings which are as a practical matter indispensable in the treatment of a given topic.” *TD Bank v. Hill*, 928 F.3d 259, 277-78 (3d Cir. 2019) (cleaned up).

To succeed on a claim for copyright infringement, a plaintiff must demonstrate “(1) ownership of a valid copyright; and (2) unauthorized copying of original elements of the plaintiff’s work.” *Dun & Bradstreet Software Servs., Inc. v. Grace Consulting, Inc.*, 307 F.3d 197, 206 (3d Cir. 2002); *accord TD Bank*, 928 F.3d at 270 (explaining that successful infringement claim requires proof of ownership of valid copyright and copying of the protected expression without privilege).

Relative to the first element, ABIM relies primarily on its copyright registrations.¹¹ Under 17 U.S.C. § 410(a), the Register of Copyrights issues a certificate of registration if, after examination, the register determines that the deposited material “constitutes copyrightable subject matter and that the other legal and formal requirements of [the Copyright Act] have been

¹⁰ The other three types of exclusive rights are public performance, public display, and public performance by digital audio transmission. 17 U.S.C. § 106(4)-(6).

¹¹ ABIM also goes into some detail about how its exam questions are developed (D.E. 207-2, Pl. R. 56.1 Stmt. ¶¶ 17-19, 21, 24, 26, 29-31).

met.” A copyright infringement plaintiff may rely on its certificate of registration as *prima facie* evidence of the validity of its copyright and the facts stated in the certificate. *Id.* § 410(c); *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 290-91 (3d Cir. 1991) (“Certificates of registration issued by the U.S. Copyright Office constitute *prima facie* evidence of the validity and ownership of the material.”). A certificate of registration is valid even if it contains inaccuracies, unless “(A) the inaccurate information was included on the application . . . with knowledge that it was inaccurate; and (B) the inaccuracy of the information, if known, would have caused the Register of Copyrights to refuse registration.” 17 U.S.C. § 411(b)(1). The applicant’s lack of knowledge of either fact or law “can excuse an inaccuracy in a copyright registration.” *Unicolors, Inc. v. H&M Hennes & Mauritz, L.P.*, 595 U.S. 178, 182 (2022).

The “copying” referenced in the second element is “shorthand” for acts infringing any one or more of the copyright owner’s “bundle of exclusive rights.” *Ford Motor*, 930 F.2d at 291; *Goldsmith*, 598 U.S. at 526; *see also* 17 U.S.C. § 501(a) (providing that “[a]nyone who violates any of the exclusive rights of the copyright owner” under 17 U.S.C. § 106 is a copyright infringer). This element, unauthorized copying, “comprises two (frequently conflated) components: actual copying and material appropriation of the copyrighted work.” *Tanksley v. Daniels*, 902 F.3d 165, 173 (3d Cir. 2018). “‘Actual copying’ focuses on whether the defendant did, in fact use the copyrighted work in creating his own,” as opposed to independently creating his own work. *Id.* Material, or unlawful, appropriation focuses on whether the defendant copied protected aspects of the copyrighted work. *Id.* at 174. Both of these components are required. *Id.* at 173. A successful copyright infringement plaintiff may be awarded actual damages and the infringer’s profits, or may instead elect to recover statutory damages. 17 U.S.C. § 504.

B. What the Allegedly Infringed Works Are

Much of ABIM's opening submission focused on the 2009 exam, which, as noted, is no longer at issue. The essential facts behind ABIM's contentions regarding that exam is that the aforementioned Geraldine Luna, a residency colleague of Salas Rushford, sat for the 2009 exam and testified at her deposition that she shared exam questions from memory in phone calls with Salas Rushford, all of this occurring before Salas Rushford took the exam. The remaining works ABIM relies on are its 2008 and 2007 exams. It has supplied certificates of registrations for those exams, as well as redacted versions of the deposit copies provided to the Copyright Office.

The 2008 exam was registered under TX 7-116-687, which reflects a first publication date of August 1, 2008, and TX 7-116-718, which reflects a first publication date of May 1, 2008. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 34; Pl. Ex. 1, at 7, 9.)¹² For both registrations, the listed effective date is January 15, 2009, and "Material excluded from this claim" is "[s]ome texts previously published." (Pl. Ex. 1, at 7, 9.) "New material included in claim" is "[a]dditional text never before published and editorial revisions." (*Id.*) Exhibit 6 to ABIM's motion is the deposit copy of the 2008 exam modules as registered with the Copyright Office; of the 1,952 pages in this exhibit, all but 50 pages of questions, plus module cover pages, is redacted. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 43 & Pl. Ex. 6.)

The 2007 exam was registered under registration numbers TX 6-871-423, reflecting a first publication date of May 1, 2007, and TX 6-871-490, reflecting a first publication date of August 1, 2007. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 34; Pl. Ex. 1, at 11, 12.) Both registrations are effective November 8, 2007, and the same limitations listed in the 2008 registrations appear in the 2007 ones (excluded material is "[s]ome texts previously published," and new material

¹² Page references in this exhibit are to the page numbers assigned by the CM/ECF system.

included in the claim is “[a]dditional text never before published and editorial revisions”). (Pl. Ex 1, at 11, 12.) Exhibit 7 to ABIM’s motion is the deposit copy of the 2007 exam modules as registered with the Copyright Office; of the 4,571 pages in this exhibit, all but 100 pages scattered throughout, plus the module cover pages, is redacted. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 46 & Pl. Ex. 7.) The unredacted questions in the 2007 and 2008 exams are the basis of ABIM’s infringement claim. As will be seen below, the registrations certificates’ details about the scope of claimed copyright become critical to the copying analysis.

C. The Allegedly Infringing Works

In terms of infringing works, ABIM points to six emails, and argues that four of them ((1), (2), (3), and (5)) contain infringing content. The other emails appear to be provided as context for the inferences ABIM seeks to draw with respect to copying. All six emails came from (or to) the email address padrinojr@yahoo.com, a different email address from the one Salas Rushford used to sign up for ABR’s review course and communicate with Arora before and immediately after he took the course.

1. August 12, 2009 email from Salas Rushford to Arora, attaching handwritten notes *[allegedly infringing]*

On August 12, 2009, Salas Rushford sent an email, subject line “info,” to Arora that attached eight pages of handwritten notes. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 58 & Pl. Ex. 11.)¹³ The email itself states, in full:

Dr. Arora as per our conversation a few minute ago . . . Here is the info. I will be sending you more info latter on when other colleges forward me more input.

¹³ ABIM states that the email “attach[ed] seven pages of handwritten notes” and Salas Rushford does not dispute this part of its factual assertion, but the exhibit itself includes eight, not seven, pages of handwritten notes after the cover email. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 57 & Pl. Ex. 11; D.E. 212-2, Def. R. 56.1 Counterstatement ¶ 58.)

info

thanks !!!!

(Pl. Ex. 11.) ABIM asserts that the handwritten notes to the email contained questions from the August 12, 2009 ABIM exam that Salas Rushford wrote down in the course of a conversation he had with Luna, who sat for the exam that day. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶¶ 60-62, 64.) Salas Rushford disputes that the notes came from Luna, pointing to his deposition testimony that the handwritten notes were his own notes from the board review course, and denies soliciting exam questions from Luna. (D.E. 212-2, Def. R. 56.1 Counterstatement ¶¶ 60, 64.)

2. Second August 12, 2009 email from Salas Rushford to Arora, attaching a longer set of handwritten notes *[allegedly infringing]*

Salas Rushford sent a second email to Arora on August 12, 2009, with the subject line “Dr. Arora A more complete list I have added 20+ questions.” (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 102 & Pl. Ex. 15.) The body of the email was “Once again thank you.” (Pl. Ex. 15.) The attachment consisted of the handwritten notes he had attached to the earlier August 12 email, plus three additional pages of handwritten notes. (*Compare* Pl. Ex. 11 with Pl. Ex. 15.) ABIM asserts that these additional notes were more exam content Salas Rushford got from Luna. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶¶ 106-09.) Salas Rushford disputes this. (D.E. 212-2, Def. R. 56.1 Counterstatement ¶¶ 104-09.)

3. August 13, 2009 email from Salas Rushford to Arora attaching multiple files *[allegedly infringing]*

The next day, Salas Rushford again emailed Arora, attaching various typewritten files. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 110 & Pl. Ex. 16.)¹⁴ The subject line was “Fw: DON’T DON’T DON’T DON’T FORWARD.” (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 111 & Pl. Ex. 16.) According to

¹⁴ ABIM says the email has nine attachments; the email itself lists 10 attachments.

ABIM, the documents attached to the email “contain a compilation of ABIM Examination questions from several years’ prior,” a conclusion it draws from notations in the documents that include “Board Questions 2007,” “IM Board 2006,” “Questions repeated on Board 2008,” and “At this moment I was burned out . . . my answer was (A), but I am not sure.” (D.E. 207-2, Pl. R. 56.1 Stmt. ¶¶ 112-14 & Pl. Ex. 16.) The email itself does not indicate how Salas Rushford got these documents, and ABIM supplies no evidence about its provenance aside from the above conclusions it draws from the email notations.

4. August 13, 2009 email from Arora to Salas Rushford

Later on August 13, 2009, Arora emailed Salas Rushford, subject line “FW: Some Q’s.” (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 116 & Pl. Ex. 17.) It was a forwarded email from another person, not involved in this lawsuit who signed as “Omar[,] San Juan, PR,” and wrote:

Here are a few that a friend from Florida that went to the crash course sent me. Also a lateral view of CXR of constrictive pericarditis that you can add to your presentations. If you have any new questions I can use before the exam I’ll be happy to use them before the exam on Friday [sic]. . . .

(*Id.*, Pl. Ex. 17.) The email attached some 24 pages of handwritten notes.¹⁵ ABIM does not discuss the sender or author of the forwarded materials Arora sent or the provenance of those materials.

5. August 16, 2009 email from Salas Rushford to Arora, with a typewritten attachment *[allegedly infringing]*

On August 16, 2009, Salas Rushford emailed Arora with the subject line “164 question the one that repeated in every exam.” (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 118; Pl. Ex. 18.) The body of the email starts with “ABIM 2009 Learning Points,” and pages of non-sequentially-numbered typewritten notes follow. ABIM describes the content as “a list of specific testing

¹⁵ The picture referenced in the email is not attached to the copy of the email supplied to the Court.

points and ABIM exam questions that Dr. Salas Rushford had received by email from a residency colleague earlier that day.” (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 120.) It does not cite any factual support for that assertion, aside from the email itself, which does not reflect where Salas Rushford acquired the material he forwarded to Arora.

Arora responded to Salas Rushford’s email as follows:

AMAZING WORK!

YOU WILL NOT HAVE ANY DIFFICULTY PASSING THIS EXAM.

WHEN YOU COME BACK FROM EXAM, SIMPLY TICK THE ONES THAT WERE THERE IN YOUR EXAM – TO SEE WHAT PERCENTAGE OF THESE ARE REALLY THERE IN ONE CANDIDATE’S PORTION.

DR. ARORA

(Pl. Ex. 18.) Salas Rushford responded: “Will do, I am just worried about the hurricane coming to PR later in the week near my exam date! Can you imagine . . .” (*Id.*)

6. August 19, 2009 email from Salas Rushford to Arora

ABIM asserts that Salas Rushford continued emailing Arora “exam content” until the day before he sat for his exam. ABIM’s Exhibit 19 is an email chain that begins with Salas Rushford sending an email to Arora with the subject line “questions.” (Pl. Ex. 19.) The body includes what appears to be a question about how to treat a patient with a certain type of condition, followed by choices. In all capital letters, a treatment is stated. The response from Arora has the subject line “RE: questions,” and the body of the email contains no text. A logical reading of this email is that Arora wrote the capitalized text in responding to Salas Rushford, but ABIM provides no information about this exchange other than supplying a copy of the email and describing it as Salas Rushford emailing “ABIM content to Dr. Arora.” (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 122.)

D. Analysis

1. Preliminary Observations

The record reveals one genuine dispute of material fact: when ABIM was, or should have been, on notice of Salas Rushford’s identity, such that it could have filed suit. The timeliness issue, as noted, came up earlier in this case, with this Court dismissing on that ground and the Third Circuit reversing; ABIM asserts that the issue is therefore settled. But as Salas Rushford observes, the Third Circuit received the case from a motion for judgment on the pleadings, and a substantial record has been developed on remand. When the issue was on appeal, the record before the Third Circuit included copies of Salas Rushford’s August 2009 emails (which used the padrinojr@yahoo.com email address and were unsigned), ABIM’s characterization of those emails as using a “disguised” email address and the “pseudonym ‘Jimmy R.’” and assertions in ABIM’s complaint that Salas Rushford had used the different jsalasmd@yahoo.com email address to communicate with Arora in late 2008 and in May 2009 and had signed those emails. (Compl. ¶¶ 1, 32-38, 41, 43-46 & Ex. B to F.) The legal standard governing this Court’s and the Third Circuit’s review called for an assumption that ABIM’s pleaded factual allegations were true, and for inferences to be drawn in ABIM’s favor. *Bibbs v. Trans Union LLC*, 43 F.4th 331, 339 (3d Cir. 2022).

Salas Rushford now points to a fuller factual record, which includes actual copies of the earlier emails. These establish that “Jimmy” was in the “From” line of both the jsalasmd@yahoo.com emails and the padrinojr@yahoo.com emails. (Pl. Ex. 8, 10, 11, 15, 16, 17, 18, 19.) The email dated December 18, 2008 is illustrative: the “From” line is “Jimmy Salas <jsalasmd@yahoo.com>,” the “Subject” line is “Jaime A. Salas MD,” and at the bottom of the email text is “Jaime A. Salas, MD,” and a phone number. (Pl. Ex. 8.) In other words, “Jimmy”

is used as a nickname from the outset of Salas Rushford's correspondence with Arora, and that correspondence links "Jimmy" with Salas Rushford.

The factual record also includes Salas Rushford's deposition testimony that he used the padrinojr@yahoo.com address from approximately 1997 to 2010; in other words, he was using it both before and after he exchanged the emails in question with Arora. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 57.) It includes Luna's deposition testimony that in June 2011 she identified Salas Rushford to her attorney as the writer of the notes attached to the August 12, 2009 emails, and that with respect to communicating with ABIM, "[e]verything was through [her] attorney." (Pl. Ex. 12, Luna Dep. Tr. 139:18-144:9; D.E. 212-3, Def. R. 56-1 Stmt. ¶ 39; D.E. 215-1, Pl. Resp. to Def. R. 56.1 Stmt. ¶ 39.) ABIM contends that it did not have Luna's identification of Salas Rushford until January 2012. The rival contentions can't be resolved on summary judgment, but additional context appears in the record from an email from ABIM's attorney to Luna's attorney, sent shortly before the point when ABIM asserts Luna disclosed Salas Rushford's name to it. There, ABIM's attorney contends that Luna had not told the truth during her interview and that she risked being held "in breach of her duty to cooperate and her settlement agreement." (D.E. 212-3, Def. R. 56.1 Stmt. ¶ 37; Def. Ex. 8; D.E. 215-1, Pl. Resp. to Def. R. 56.1 Stmt. ¶¶ 37, 39.)

From this, a reasonable factfinder could (but need not) conclude that ABIM should have discovered Salas Rushford's identity—the missing piece for its cause of action—*before* October 17, 2011 (three years before its complaint was filed), and that Salas Rushford was not intentionally concealing his identity when he sent the August 2009 emails.¹⁶ That said, this

¹⁶ Moreover, while diligent investigation does not require overturning every stone, ABIM is conspicuously silent on several obvious avenues of inquiry, such as whether it asked Arora who the "Jimmy" in the emails was, given that at least one of them referenced a conversation the two had "a few minute[s] ago." (Pl. Ex. 11.)

dispute, which concerns a defense on which Salas Rushford would bear the burden of proof, ultimately becomes material only if ABIM’s affirmative copyright case withstands Salas Rushford’s cross-motion for summary judgment.

2. Ownership of Valid Copyright

That affirmative case on which the motions hang begins with ownership of copyright, the first element of the infringement test. ABIM relies on its certificates of registration for the 2007 and 2008 exams, which are *prima facie* evidence of ownership and validity of the material covered by the registration. 17 U.S.C. § 410(c); *Ford Motor*, 930 F.2d at 290-91. Based on the certificates’ representation that the works were made for hire, Salas Rushford asserts the registrations are invalid because ABIM has not shown that it had legally sufficient agreements in place with the individuals who developed the exam questions such that the works were properly “for hire.”

But as noted earlier, the Copyright Act provides for a safe harbor, whereby even an inaccurate registration certificate is valid if the copyright holder did not know the information was inaccurate at the time it applied for registration. 17 U.S.C. § 411(b)(1)(A); *Unicolors*, 595 U.S. at 182. To prevail, Salas Rushford would have to show that ABIM had “actual, subjective awareness” when applying for the copyright registration that the “work for hire” designation was incorrect factually (because, for example, it did not have written agreements, only oral ones) or legally (because, for example, it had agreements that did not satisfy the legal definition of “work for hire” in 17 U.S.C. § 101). See *Unicolors*, 595 U.S. at 185 (“knowledge” in the safe harbor means “actual, subjective awareness of both the facts and the law”).

He has not done this, instead arguing the July 2011 agreement ABIM produced with its opposition, purporting to memorialize an earlier agreement about work-for-hire status, shows

that qualifying work-for-hire agreements were not in place at the time of the 2007 and 2008 registrations. He further contends ABIM's registrations are not valid because it never corrected them. But the relevant inquiry is ABIM's subjective knowledge at the time it applied for registration; the closest Salas Rushford gets is one line in his reply that ABIM's 2011 agreement "show[s] it had subjective awareness that its exams were not works for hire." (D.E. 216, Def. Reply Br. 4.) That agreement, standing alone (Salas Rushford offers nothing else), does not support that ABIM knew when it registered the exams years earlier that it did not have a basis to claim work-for-hire status; stated differently, a reasonable jury could not conclude based on this agreement that ABIM had the requisite knowledge of inaccuracy at the relevant time.

To the contrary, the agreement tends to show that ABIM was unaware it had a (potential) problem until well after the fact. Ultimately, it is up to Salas Rushford to rebut the presumption created by the safe harbor, and assertions and speculation do not get him there at the summary judgment stage. *Carolina Cas.*, 2022 WL 9997385, at *4. Cf. *Unicolors*, 595 U.S. at 187-88 (listing ways a defendant can show actual knowledge of inaccuracies in copyright application). Summary judgment is thus not warranted in Salas Rushford's favor on the first element of ABIM's claim.

3. Unauthorized Copying

The second element is unauthorized copying of the original elements of the copyrighted work, with its constituent sub-elements, actual copying and material appropriation, done in a manner that implicates a right listed in 17 U.S.C. § 106.¹⁷ With respect to actual copying, direct

¹⁷ Neither side goes into detail about which of the exclusive rights granted in 17 U.S.C. § 106 is in play (which is part of the claim's requirements, *Ford Motor*, 930 F.2d at 291), but based on a review of the record as a whole, the likely candidates are § 106(1) (right to reproduce copyrighted work in copies) and § 106(2) (right to prepare derivative works based on the copyrighted work); *see also* 17 U.S.C. § 101 (defining derivative work). Because the issue is not

evidence, though “rarely” available, can be used. *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1231-32 (3d Cir. 1986). More commonly, plaintiffs rely on circumstantial evidence of actual copying, which involves showing that the alleged infringer (i) had access to the copyrighted work, and (ii) that there is sufficient similarity between the copyrighted work and the allegedly infringing work to conclude that the alleged infringer used the former in making the latter. *Tanksley*, 902 F.3d at 173; *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199, 208 (3d Cir. 2005). As the Third Circuit summarized in *Kay Berry*:

First, the fact-finder must decide whether there is sufficient similarity between the two works in question to conclude that the alleged infringer used the copyrighted work in making his own. A showing of substantial similarity in this sense,^[18] coupled with evidence that the infringing author had access to the original work, permits a fact-finder to infer that the infringing work is not itself original, but rather is based on the original. At this stage of the inquiry, expert testimony is permissible to help reveal the similarities that a lay person might not ordinarily perceive. Direct evidence of copying or an admission by the infringing author would satisfy this test as well.

421 F.3d at 208 (internal citations and quotation marks omitted). At this step, the factfinder can consider “any aspect of the works that supports an inference of copying, even elements that are incapable of copyright protection.” *Tanksley*, 902 F.3d at 173.

If the plaintiff establishes actual copying, the factfinder then decides whether the infringer copied protected aspects of the copyrighted work. *Kay Berry*, 421 F.3d at 208. The focus, therefore, is on whether the “substantial similarities” in the works “relate to protectible

dispositive here, this opinion assumes that Salas Rushford’s accused emails fit into either or both of these categories. ABIM’s submissions also reference Salas Rushford’s “distribution,” but § 106(3) gives the copyright owner the exclusive right “to distribute copies . . . to the public by sale or other transfer of ownership, or by rental, lease, or lending,” and ABIM has not explained how that language applies to the accused conduct.

¹⁸ To avoid confusion, “substantial similarity” in the actual copying analysis is often referred in this circuit as “probative similarity,” with “substantial similarity” reserved for the misappropriation step of the analysis. *Tanksley*, 902 F.3d at 173.

material.” *Id.* (quoting *Dam Things from Denmark*, 290 F.3d at 562). Unlike the previous step, the factfinder undertaking this comparison cannot look at the works in their entirety; “only similarities in protectable expression may be considered.” *Tanksley*, 902 F.3d at 173.

This analysis is typically done based on a “lay observer” standard, without the benefit of expert testimony. *Kay Berry*, 421 F.3d at 208. However, where copyrighted material is “particularly complex” and “unfamiliar[] to most members of the public,” the Third Circuit has recognized the limitations of this standard. *Whelan*, 797 F.2d at 1232-33 (describing lay observer test as “not useful” and “potentially misleading” in that scenario). In such cases, “a single substantial similarity inquiry [applies,] according to which both lay and expert testimony would be admissible.” *Id.*; see *Tanksley*, 902 F.3d at 172 & n.3 (noting that Third Circuit has rejected the use of experts at this step, with the caveat that “[w]e have expressed more openness to expert testimony when the works are highly technical in nature,” such as computer programs).

a. Actual Copying

As described earlier, the allegedly infringing works are four emails sent by Salas Rushford to Arora: two on August 12, 2009, one on August 13, 2009, and one on August 16, 2009. The analysis of ABIM’s case actual copying for the first two emails differs somewhat from its case on the second two emails, so they are addressed separately.

i. August 12, 2009 Emails (Emails 1 and 2)

For these emails, ABIM offers what it characterizes as direct evidence of copying. This is Luna’s deposition testimony that the notes attached to these emails were the contents of the ABIM exam she took that day and told Salas Rushford over the course of multiple discussions.

(*See, e.g.*, D.E. 207-2, Pl. R. 56.1 Stmt. ¶¶ 60-71, 106-109; Pl. Ex. 12 (Luna Dep. Tr. 9:6-63).)¹⁹

In other words, Luna's testimony is that Salas Rushford wrote down the contents of the 2009 exam as dictated by her, after she sat for that exam.

Although ABIM continued to tout this direct evidence argument in its reply, it no longer has a live claim based on the copying of the 2009 exam. For Luna's testimony to establish that Salas Rushford copied content from the 2007 or 2008 exam, ABIM also has to show that content from the 2007 or 2008 exams appeared on the 2009 exam that Luna took, and that she relayed that content to him. It has not supplied a copy of Luna's exam, only the 2009 deposit modules of the exam and several sets of screenshots of the 2009 exam that are not connected with any particular examinee. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶¶ 38-39; Pl. Ex. 2 to 5.)

To bridge the gaps, ABIM has the Ward Report. He connects excerpts from Salas Rushford's emails to ABIM exam questions and reasons that, based on certain similarities in the content, the emails must have copied the exam questions. (Pl. Ex. 13, Ward Report, App'x B.) However, Ward did not rely on specific questions identified as coming from the 2007 or 2008 exams. The questions he considered came from (i) Plaintiff's Exhibit 5, screenshots of the 2009 exam not tethered to a specific examinee, and (ii) Plaintiff's Exhibit 20, a collection of exam questions with additional content (correct answer, rationales, and identification of testing points) not appearing in the deposit copies of the exams, and which are also not identified as coming from any particular administration or year of the exam. (*See* Pl. Ex. 13, Ward Report ¶ 11

¹⁹ As explained earlier, Salas Rushford disputes Luna's account, but credibility and weight-of-testimony disputes are not resolvable on summary judgment motions.

(listing documents considered in preparing report); Pl. Ex. 5; Pl. Ex. 20; *see also, e.g.*, Pl. Ex. 2 (deposit copy of 2009 exam).)²⁰

To show that Ward’s analysis of 2009 (or undated) questions also applies to 2007 and 2008 questions, ABIM has a “summary chart” that it created “[f]or the convenience of the Court” that links rows of the Ward report to where questions from the 2007 and 2008 exams can be found. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 131; Pl. Ex. 14.)²¹

Using a specific example, the factfinder’s analysis would go thus: Ward, in Row 1 of his chart, opined that a 19-word excerpt from Salas Rushford’s first email matched wrong answer choices, a missing correct answer, and the same testing point as ABIM internal question number 37451, the text of which is found in ABIM’s Exhibit 20, at page 15,²² bearing Bates number ABIM00067. Exhibit 14, the “summary chart,” directs one to ABIM04990, a page in Exhibit 7 (the 2007 deposit copy) to find the 2007 exam version of this question. Because this 2007 version of the question is largely identical to the question text Ward considered, ABIM internal question number 37451, Ward’s opinion on copying applies to the 2007 version of the question as well.

²⁰ In its Rule 56.1 statement, ABIM explains this exhibit as “ABIM examination questions that Dr. Ward identified as copied by Dr. Salas” Rushford, shedding no light on where these questions came from or why they were an appropriate subject for Ward’s analysis. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 129.)

²¹ Insofar as the provenance of this chart is unclear beyond the limited description in paragraph 131 of ABIM’s Rule 56.1 statement, it is unclear whether the chart itself would be admissible at trial. *See Snead v. Casino*, 700 F.Supp.3d 203, 216 (D.N.J. 2023) (Bumb, J.) (“courts can only consider admissible evidence on a summary judgment motion”). Assuming, however, that ABIM would either put the contents in admissible form at trial, or offer it simply as a demonstrative to explain the admissible record evidence, the Court considers it for this limited purpose. The Court also notes that much of the same information is in ABIM’s Exhibit 21, which clearly came from its counsel.

²² This refers to the page number assigned by the CM/ECF system.

Even assuming ABIM could present all of this information to a factfinder in admissible form, there is still a problem: ABIM does not have sufficient evidence to allow a reasonable factfinder to conclude that Luna’s exam contained that 2007 (or 2008) content specifically. Essentially, ABIM’s case on actual copying for the first two emails is not based on direct evidence of copying; it hinges entirely on similarity. Direct evidence is not, of course, required; circumstantial evidence is both common and permissible, and the case law is well-developed on what that proof avenue involves: access to the copyrighted work and sufficient similarity to conclude that copying occurred (*i.e.*, “probative similarity”).

A plaintiff can establish “access” in three ways: “(1) direct access; (2) access through third parties; and (3) ‘striking similarity’ between the plaintiff’s and the defendants’ work.”

Hofmann v. Pressman Toy Corp., 790 F. Supp. 498, 505 (D.N.J. 1990) (Debevoise, J.) (granting summary judgment for defense on copyright claim where plaintiff failed to show access), *aff’d*, 947 F.2d 935 (3d Cir. 1991).

“A plaintiff may establish direct access by alleging that the defendant actually viewed, read, or heard the work at issue.” *Walker v. Kemp*, 587 F. Supp. 3d 232, 240 (E.D. Pa. 2022) (citation omitted). “Where a plaintiff cannot show direct access”—and ABIM’s case is not based on direct access, for any of the four accused emails—“[a]ccess through third parties connected to both a plaintiff and a defendant may be sufficient to prove a defendant’s access to a plaintiff’s work.” *Hofmann*, 790 F. Supp. at 506 (quoting *Gaste v. Kaiserman*, 863 F.2d 1061, 1067 (2d Cir. 1988)). Luna is the “third party” here, but the proposition that she had access to the 2007 and 2008 exams is evidentially supported only by Ward’s similarity comparisons. This collapses access and similarity into one step; ABIM *can* do that—but only if it shows “striking similarity” between the accused works and the defendants’ work. *Id.* at 505.

Essentially, “an inference of access may still be established circumstantially [absent evidence of direct or third-party access] by proof of similarity which is so striking that the possibilities of independent creation, coincidence and prior common source are, as a practical matter, precluded.” *Id.* at 508 (quoting *Selle v. Gibb*, 741 F.2d 896, 901 (7th Cir. 1984)). This approach effectively turns the “access plus probative copying” analysis into a single inquiry of similarity, and the burden on a plaintiff invoking it is significant:

Plaintiff has the burden of proving striking similarity, and that burden is not carried if the evidence as a whole does not preclude any reasonable possibility of independent creation. Striking similarity, then, goes far beyond the measure for substantial similarity required for the second element of a copyright claim. Where, as here, the plaintiff has introduced virtually no direct evidence of access, the degree of similarity to establish copying . . . is considerable. The similarities should appear in a sufficiently unique or complex context as to make it unlikely that both pieces were copied from a prior common source, . . . or that the defendant was able to compose the accused work as a matter of independent creation.

Id. at 508-09 (citations and internal quotation marks omitted).

The Ward Report matches questions up and discusses why they match, but striking similarity requires more than a simple comparison. To meet this standard, ABIM has to show evidence that “preclude[s] any reasonable possibility of independent creation.” *Id.* at 508. Ward states that he “considered whether the substance of the excerpts [from the accused emails] indicated that they are class notes from a board review course, or notes from published board preparation materials such as MKSAP,” and that “[i]t is . . . my opinion that the excerpts are not class notes from a board review course, or notes from published board preparation materials such as MKSAP.” (Ward Report ¶¶ 13, 17.)

Ward looked at the emails and concluded that they didn’t come from another source without explaining how he got there. In short, he gave a net opinion. In its reply, ABIM tethered Ward’s conclusions on actual copying to sought his “experience in drafting and

selecting questions for inclusion on the ABIM exam” (D.E. 215, at 17), and challenges various aspects of Fisher’s reports. But Ward’s report does not connect his experience with the ABIM test questions with facts showing why there is no reasonable possibility Salas Rushford got the content elsewhere. His say-so is insufficient: “[A]n expert’s bare conclusions, unsupported by factual evidence are an inadmissible net opinion,” as “[t]he net opinion rule requires the expert to give the ‘why and wherefore’ of the opinion, rather than a mere conclusion.” *Snead*, 700 F. Supp. 3d at 216 (cleaned up). This absence of evidence is placed in even sharper relief by Salas Rushford’s expert, who cited specific portions of two other sources Salas Rushford had access to for content that appears on Ward’s list of allegedly copied questions. (See Def. Ex. 4, Fisher Rebuttal Report ¶ 21.) While ABIM seeks to minimize the weight to be accorded Fisher, it supplies no competent evidence to counter what he says.

ii. August 13, 2009 Email (Email 3) and August 16, 2009 Email (Email 5)

Luna’s deposition testimony does not cover email 3 and email 5, thrusting ABIM squarely in the inferential proof framework for these emails as well. But it cites no evidence establishing where Salas Rushford got the content he forwarded to Arora, much less that he got it from someone who had access to ABIM’s copyrighted 2007 or 2008 exams.²³

Instead, ABIM offers speculation that the content must have come from actual exams because there are references in it to, for example, “Board Questions 2007,” “Questions repeated on Board 2008,” “IM Board 2006,” “At this moment I was burned out . . . my answer was (A), but I am not sure.” (D.E. 207-2, Pl. R. 56.1 Stmt. ¶¶ 112-114.) There is a reference in Salas

²³ In fact, the excerpts provided to the Court from Salas Rushford’s deposition indicate that ABIM unsuccessfully tried to pin down that the forwarded material came from 2007 or 2008 exams. (D.E. 212-5, Def. Ex. 2, Def. Dep. Tr. 147:20-25, 150:15-155:6.)

Rushford's deposition transcript to this material coming from a "Monica,"²⁴ but nothing speaking to whether or when "Monica" took an ABIM exam that gave her access to 2007 or 2008 exam questions. The record as to email 5 is no clearer; ABIM describes it as containing "ABIM exam questions that Dr. Salas Rushford had received by email from a residency colleague earlier that day," citing only the email itself—which contains no such indication. (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 120.) Assuming this was true, there is still no information that (a) the unnamed colleague had taken an ABIM exam and thus had access, or (b) that the colleague had taken an exam that functioned as access to 2007 or 2008 exam material specifically. This would require a factfinder to pile speculation upon speculation to infer that Salas Rushford got the forwarded information from another person; the other person took an exam or otherwise had access to content from the 2007 or 2008 exam; and what the other person passed on to Salas Rushford constituted that 2007 or 2008 exam content. That wobbly tower would then be used to support that Salas Rushford had access, and that access, which, paired with a comparison of the content passed on to Salas Rushford's emails, would permit an inference of direct copying. *Cottrill v. Spears*, 87 F. App'x 803, 806 (3d Cir. 2004) (affirming summary judgment for defendant on copyright infringement claim based on lack of access; "[b]y arguing no more than what is technically possible, plaintiffs engage in speculation Speculation is no substitute for the kind of circumstantial evidence needed to preclude the entry of summary judgment.").

Evidence of a "reasonable possibility of access" is required to withstand summary judgment; a "bare possibility" based on "speculation or conjecture" is insufficient. *Hofmann*, 790 F. Supp. at 505 (quoting *Gaste*, 863 F.2d at 1066 (internal quotation marks omitted)); see

²⁴ D.E. 212-5, Def. Ex. 2, Def. Dep. Tr. 161:9-162:6.

also id. (“The plaintiff has the burden of proving access, which requires ‘sufficient, affirmative and probative evidence to support that claim.’” (quoting *Scott v. Paramount Pictures Corp.*, 449 F. Supp. 518, 520 (D.D.C. 1978)). ABIM has not offered evidence of a reasonable possibility of access, only speculation.

Nor does looking at the whole series of emails together cure these deficiencies. Of the two emails ABIM cites but does not accuse as infringing – Arora’s August 13, 2009 to Salas Rushford (email 4), and Salas Rushford’s August 19, 2009 email to Arora (email 6) – the August 19 email plainly adds nothing probative. The August 13 email forwards a message Arora received from an “Omar,” who states that he has not yet taken the exam, asks for “new questions I can use before the exam,” and provides a “few that a friend from Florida that went to the crash course sent [him].” (Pl. Ex. 17.) As best the Court can discern, ABIM put forth this email to show that Arora and Salas Rushford’s week-long exchange of emails included the exchange of actual exam questions, and thus Salas Rushford had access to them. But this is too weak – as in the emails discussed above, ABIM does not supply the required evidentiary support. The “friend from Florida” is not identified, nor is any evidence provided that would tend to show that the “friend” from Omar’s “crash course” was sending actual exam content (as opposed to study notes, for example), and if so, that any of this included 2007 or 2008 exam content. Again: all speculation. Adding more of the same doesn’t change that reality.

Here, too, ABIM is left with the striking similarity test, which as discussed earlier, it can’t meet.

b. Material Appropriation

There are more deficiencies in ABIM’s affirmative copyright claim. Even had it shown actual copying for one or more of the four accused emails, its claim falls short on the material

appropriation element, which examines whether the alleged infringer copied protectable elements of the copyrighted work as opposed to unprotectable elements such as ideas. The copyrighted material here is exam questions developed to test the knowledge and skills of highly educated, highly trained medical doctors already practicing in the field of internal medicine. By ABIM's own account, it stringently guards the confidentiality of these questions to prevent them from becoming publicly available, and claims that the board certification resulting from exam and related requirements is an "internationally recognized marker of physician quality." (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 3.)

A review of the exam content in this motion record confirms what ABIM's description makes apparent: the "particularly complex" material involved is not of a type that most members of the public would be familiar with, and the lay observer test is not workable here. *See Whelan*, 797 F.2d at 1232-33. The Ward Report, ABIM's only expert evidence, expressly disclaims an opinion as to the "extent to which ABIM questions are protectable under copyright law." (Pl. Ex. 13, Ward Report ¶ 9.)

Fisher, Salas Rushford's expert, opines that the questions Ward identified as having been actually copied contain material such as "classic diagnostic criteria, disease variants, diagnostic evaluations, treatments, and differential diagnoses," and that it "is common and logical to use differential diagnoses or treatments of alternate disease states as distractors (wrong answers) in multiple choice exams." (Def. Ex. 4, Fisher Rebuttal Report ¶ 13.) "Any competent review of these topics or material," he continues, "would include the same or very similar distractors or wrong answer choices," and likewise for questions presenting "classic diagnostic criteria, classic disease variants, classic treatments, and classic diagnostic evaluations"; either in reviews or in

other study guides available to physicians, the same information would appear. (*Id.*) ABIM disagrees, but doesn't provide expert evidence to counter that.

Tethering all this to copyright law, Fisher's report supports the conclusion that not all aspects of ABIM's exam questions are protectable by copyright. *See Tanksley*, 902 F.3d at 175 (“[C]ourts have developed several methods and principles for evaluating substantial similarity. In works that involve a mix of protected and unprotected elements, . . . the first step is to identify and exclude from the substantial similarity analysis any unprotected material.”). Faced with Fisher's observations and the undisputed law on substantial similarity, it was up to ABIM, the non-movant on Salas Rushford's cross-motion, to “come forward with specific facts showing that there is a *genuine issue for trial*,” and to supply “actual evidence.” *Carolina Cas.*, 2022 WL 9997385, at *4 (citation omitted). It has not. And in reaching this conclusion, the Court notes what it has before it is not a battle of the experts. Rather, Salas Rushford has the relevant expert testimony on this issue, and ABIM does not.

ABIM is correct that there is case law supporting the copyrightability of exam questions, and that its registrations create a rebuttable presumption “that the questions contain protected expression.” (D.E. 215, Pl. Reply Br. 21.) *Educational Testing Service v. Katzman*, 793 F.2d 533 (3d Cir. 1986), is one such case. There, the panel rejected a defense argument that the exam questions were not copyrightable in the first place, writing that “[w]hile the limited number of ways a concept can be addressed may be relevant to the extent of copying permitted, it does not render an original expression *per se* incapable of copyright protection.” *Id.* at 539. *Katzman* involved aptitude tests (including the SAT) administered to high school students, and it was “apparent on the face of the materials” that there was more than one way of expressing the ideas (such as “square roots or dangling participles”) such that the merger doctrine did not preclude

copyright protection altogether. *Id.* at 540. The issue now is not whether ABIM’s exams are copyrightable in the first place or whether they contain copyrightable content; the registrations and the resulting presumption of validity were discussed earlier. The issue, instead, is what is copyrightable and whether Salas Rushford copied that particular content. The Court concludes ABIM has not supplied evidence that would equip a factfinder to determine that was the case.

Even applying the lay observer test, with no expert testimony relative to material appropriation allowed, ABIM’s factual record is missing information that would allow a reasonable factfinder to conclude, based on evidence (instead of speculation), that Salas Rushford copied *protectable* parts of ABIM’s 2007 and 2008 exams. Going back to ABIM’s copyright registrations, they all exclude from their scope material that was previously published; the claimed copyright only extends to new material added and never before published. (See Pl. Ex. 1, at 3-12.) Exam questions are reused, “especially those that demonstrate repeatedly, through statistical analysis, excellent at assessing the specific subject matter.” (D.E. 207-2, Pl. R. 56.1 Stmt. ¶ 31.) The chart ABIM supplied in Exhibit 14 reflects this: in the first row, for example, the ABIM question analyzed by Ward appears in both the 2007 and 2009 copies of the exam deposited with the Copyright Office. (Pl. Ex. 14, at 1.) Because ABIM’s registrations exclude work that has previously been published, the 2009 appearance of the question in this example would not have been “protectable” material. The 2007 appearance of the question *may* have been protectable, if it did not appear on an earlier test, but there is no record evidence of what was on those earlier tests.

The task for the factfinder under the lay observer test is to “perform[] a side by side comparison of the works and, excluding any unprotectable elements, assess[] whether the two works are substantially similar.” *Tanksley*, 902 F.3d at 174. Applied here, the factfinder’s task

in determining material appropriation would be to compare the contents of Salas Rushford's four emails against the unredacted question pages appearing in the 2007 and 2008 deposit modules, excluding from that comparison what is unprotected because it appeared in prior exams, or because it is so integral to how the medical concept or idea at issue in the question must be tested that it is unprotectable. Then it must decide whether what appears in Salas Rushford's emails replicates the remaining parts that are "of substance and value," *Katzman*, 793 F.2d at 541 (cleaned up), and that represent expression, as opposed to "the idea or theme that . . . [ABIM] seeks to convey or explore," *Kay Berry*, 421 F.3d at 208. ABIM does not supply evidence to make those judgments, assuming the impossible that a lay person could parse through the layers of complicated medical terminology and events constituting the questions. A jury undertaking this exercise would be engaging in pure speculation, rather than drawing reasonable conclusions from evidence.

V. Conclusion

The Supreme Court has observed that "summary judgment procedure is . . . an integral part of the Federal Rules as a whole, which are designed 'to secure the just, speedy and inexpensive determination of every action.'" *Celotex*, 477 U.S. at 327 (quoting Fed. R. Civ. P. 1). "Rule 56 must be construed with due regard not only for the rights of persons asserting claims and defenses that are adequately based in fact to have those claims and defenses tried to a jury, but also for the rights of persons opposing such claims and defenses to demonstrate in the manner provided by the Rule, prior to trial, that the claims and defenses have no factual basis."

Id.

With that mandate in mind, the Court carefully reviewed what ABIM submits as its proofs, documentary, testimonial, and expert opinion, of infringement by Salas Rushford. It

finds that ABIM has failed to raise a genuine factual dispute as to actual copying or material appropriation, essential elements on which it would bear the burden of proof at trial. Salas Rushford has, therefore, shown that “there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law,” Fed. R. Civ. P. 56(a), and that he is entitled to summary judgment of noninfringement. His cross-motion for summary judgment will be granted. ABIM is not, conversely, entitled to judgment as a matter of law that Salas Rushford infringed, and its motion for summary judgment will be denied.

Because the Court has cited to sealed documents, it has filed this opinion under temporary seal. The parties shall file a motion that complies with L. Civ. R. 5.3 on or before October 9, 2024 should they desire to keep this opinion or any portion of it under seal. If no such motion is timely filed, the seal will be lifted.

An appropriate order will issue.

Dated: September 30, 2024

s/ Katharine S. Hayden

Katharine S. Hayden, U.S.D.J.