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15 **UNITED STATES DISTRICT COURT**
16 **SOUTHERN DISTRICT OF CALIFORNIA**

17 **DR. SEUSS ENTERPRISES, L.P.,**

18 Plaintiff,

19 v.

20 **COMICMIX LLC; GLENN**
21 **HAUMAN; DAVID JERROLD**
22 **FRIEDMAN a/k/a DAVID**
23 **GERROLD; and TY TEMPLETON,**

24 Defendants.

Case No. 3:16-cv-02779-JLS-BGS

**MEMORANDUM OF PONTS &
AUTHORITIES IN SUPPORT OF
DEFENDANTS' MOTION FOR
SUMMARY JUDGMENT**

Assigned to Hon. Janis L. Sammartino
United States District Judge

Hearing Date: January 31, 2019
Hearing Time: 1:30 p.m.
Hearing Place: Schwartz Courthouse,
Courtroom 4A

I. Introduction

Plaintiff Dr. Seuss Enterprises, L.P. (“DSE”) filed the instant lawsuit against Defendants ComicMix LLC, Glenn Hauman, David Gerrold, and Ty Templeton (collectively “Defendants”), asserting that their unpublished book *Oh, the Places You’ll Boldly Go!* (“*Boldly*”) infringes the copyright in five “Dr. Seuss” books, and in DSE’s alleged trademarks in matters deriving from those books. But *Boldly* is a mash-up—a highly transformative, creative work, as the Court found. Because of that unique nature, the standard analysis and burdens of proof in copyright and trademark cases do not apply. Even if DSE could make out a prima facie case on its infringement claims, fair use and the First Amendment prevail.

Under copyright law, transformative works are not presumed to harm copyrighted works. To defeat the fair use defense, DSE must identify a market in which *Boldly* could cause some cognizable, substantial harm to DSE’s licensing opportunities, and bring forward evidence that it would do so. DSE fails to identify, and to substantiate, any cognizable harms. And DSE’s claims sounding in trademark face a heightened burden because *Boldly* is a creative work protected by the First Amendment. Under Ninth Circuit precedent, DSE must show that the use of its alleged marks in *Boldly* has *no artistic relevance*, or that the use is *explicitly misleading* as the source or content of *Boldly*. DSE has introduced no evidence that would suffice.

Boldly constitutes fair use and protected First Amendment speech. The interests of Defendants and the public, favoring publication and free expression, outweigh the unsupported, theoretical harms that DSE has claimed. DSE has not placed in dispute any issue germane to the defenses raised by Defendants.

II. Factual Background.

Theodor S. Geisel wrote and illustrated children’s books under the pseudonym Dr. Seuss. Declaration of Dan Booth (“Booth Decl.”) ¶ 4. *Star Trek* was a 1960’s television series that spawned an entertainment franchise. *Id.* ¶ 5. No licensed product has combined elements from their two discrete creative worlds. *Id.* ¶ 6.

1 *Boldly* does. It “is most appropriately termed a literary and pictorial mash-up.”
 2 Order Granting in Part and Denying in Part Motion to Dismiss (“First MTD Order”),
 3 ECF No. 38 p. 7. “[I]t is no doubt transformative. In particular, it combines into a
 4 completely unique work the two disparate worlds of Dr. Seuss and *Star Trek*.” *Id.* p.
 5 8. Of the Dr. Seuss books, *Boldly* draws from several Dr. Seuss books, primarily
 6 from *Oh, the Places You’ll Go!* (“*Go!*”). Booth Decl. ¶ 7.

7 *Boldly* tells the tale of the ... strange beings and circumstances
 8 encountered during the voyages of the Star Trek Enterprise, and it
 9 does so through *Go!*’s communicative style and method. *Go!*’s
 10 rhyming lines and striking images, as well as other Dr. Seuss works,
 11 are often copied by *Boldly*, but the copied elements are always
 interspersed with original writing and illustrations that transform
Go!’s pages into repurposed, *Star-Trek*–centric ones.

12 First MTD Order p. 8.

13 In the present case, there is no dispute that *Boldly* copies many aspects
 14 of *Go!*’s and other Dr. Seuss illustrations. However *Boldly* does not
 15 copy them in their entirety; each is infused with new meaning and
 16 additional illustrations that reframe the Seuss images from a unique
 17 *Star-Trek* viewpoint. Nor does *Boldly* copy more than is necessary to
 accomplish its transformative purpose.

18 *Id.* p. 9. *Boldly* was written by David Gerrold, illustrated by Ty Templeton, and
 19 edited by Glenn Hauman of comics publisher ComicMix LLC in 2016. Booth Decl.
 20 ¶ 8. ComicMix ran a Kickstarter campaign for *Boldly* through September 2016 to
 21 crowdfund the initial printing and distribution costs. *Id.* ¶ 9. The Kickstarter page
 22 called *Boldly* “a parody mash-up.” *Id.* ¶ 10. It told potential donors:

23 While we firmly believe that our parody, created with love and
 24 affection, fully falls within the boundary of fair use, there may be
 25 some people who believe that this might be in violation of their
 26 intellectual property rights. And we may have to spend time and
 money proving it to people in black robes. And we may even lose that.

27 *Id.* ¶ 11. The campaign goal was to raise \$20,000 toward a scheduled December
 28 2016 publication for *Boldly*. *Id.* ¶ 12. It raised \$29,575 in pledges. *Id.* During the

campaign, Andrews McMeel Publishing contacted Defendants and agreed to partner with ComicMix to publish *Boldly* by December. *Id.* ¶ 13. On September 28, 2016, two days before the campaign ended, DSE sent Defendants a cease-and-desist letter asserting ownership of the intellectual property rights in the Dr. Seuss books. *Id.* ¶ 14. Andrews McMeel quickly withdrew from the project. *Id.* ¶ 15. On October 7, 2016, DSE sent a second letter to Defendants and sent a DMCA takedown notice to Kickstarter, which disabled public access to the campaign. *Id.* ¶ 16. DSE sent Defendants a third letter on October 25, 2016, and they responded on October 28, 2016. *Id.* ¶ 17. ComicMix sent Kickstarter a counternotice on October 31, 2016. *Id.* ¶ 18. DSE filed suit ten days later. *Id.* ¶ 19. Kickstarter returned all pledges to the donors. *Id.* ¶ 20.

III. Legal Standard.

“The court shall grant summary judgment if the movant shows 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). A “material fact” is one that might affect the outcome of the case under governing law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). “A genuine dispute of a material fact is ‘one that could reasonably be resolved in favor of either party.’” *Folkens v. Wyland Worldwide, LLC*, 882 F.3d 768, 773 (9th Cir. 2018) (quoting *Ellison v. Robertson*, 357 F.3d 1072, 1075 (9th Cir. 2004)). “[C]onclusory or speculative testimony is insufficient to raise a genuine issue of fact to defeat summary judgment.” *Anheuser-Busch, Inc. v. Natural Beverage Distribs.*, 69 F.3d 337, 345 (9th Cir. 1995).

For issues “on which the nonmoving party bears the burden of proof ... the burden on the moving party may be discharged by ‘showing’—that is, pointing out to the district court—that there is an absence of evidence to support the nonmoving party’s case.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). “[A] complete failure of proof concerning an essential element of the nonmoving party’s case necessarily renders all other facts immaterial.” *Id.* at 323.

1 A. Copyright Claims and Fair Use

2 DSE’s first cause of action is for copyright infringement. “[T]he fair use of a
3 copyrighted work ... is not an infringement of copyright.” 17 U.S.C. § 107.

4 In determining whether the use made of a work in any particular case
5 is a fair use the factors to be considered shall include—

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

13 *Id.* Fair use doctrine “calls for case-by-case analysis,” and the statutory factors
14 are not exclusive, and are considered “together, in light of the purposes of
15 copyright.” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577-78 (1994). “The
16 fair use doctrine thus ‘permits [and requires] courts to avoid rigid application of the
17 copyright statute when, on occasion, it would stifle the very creativity which that
18 law is designed to foster.” *Id.* at 577 (alteration in original) (quoting *Stewart v.*
19 *Abend*, 495 U.S. 207, 236 (1990)).

20 On a summary judgment motion, the Court may decide the issue of fair use when
21 “no material, historical facts are at issue and the parties dispute only the ultimate
22 conclusions to be drawn from those facts.” *Seltzer v. Green Day, Inc.*, 725 F.3d 1170,
23 1175 (9th Cir. 2013) (citing *Fisher v. Dees*, 794 F.2d 432, 436 (9th Cir. 1986)).

24 The Court has analyzed fair use twice in this case, upon Defendants’ motions to
25 dismiss the Complaint (ECF No. 1), and the First Amended Complaint (“FAC”; ECF
26 No. 39). In light of the transformative nature of *Boldly*, the Court found that the first
27 fair use factor “weighs in favor of finding Defendants’ use to be fair.” First MTD
28 Order pp. 7-8. The second factor weighed only slightly in DSE’s favor. *Id.* p. 9. The
Court found the third factor “is neutral” and “does not weigh against Defendants.”
Id. pp. 10 & 13. As for the fourth factor—the market effect of the use on the

1 copyrighted work—the Court found Defendants could not demonstrate fair use at the
 2 motion to dismiss stage, with no record evidence on point, and when “Plaintiff’s
 3 allegations are taken as true, and therefore a potential harm to licensing opportunities
 4 is presumed.” *Id.* p. 11 (“In the current procedural posture Defendants are at a clear
 5 disadvantage under this factor’s required analysis.”). Yet the Court also found,

6 this presumed harm is neutralized somewhat by the fact that *Boldly*
 7 does not substitute for the original and serves a different market
 8 function than *Go!* ... *Boldly*’s market relies on consumers who have
 9 already read and greatly appreciated *Go!* and Dr. Seuss’s other works,
 10 and who simultaneously have a strong working knowledge of the *Star Trek* series. It is therefore unlikely that *Boldly* would severely impact
 11 the market for Dr. Seuss’s works.

12 *Id.* The Court further considered the purposes of copyright, which serve to
 13 stimulate the production of new creative works by affording creators a period of
 14 exclusive rights, while also limiting those rights “‘regarding works that build upon,
 15 reinterpret, and reconceive existing works.’” *Id.* p. 12 (quoting *Mattel, Inc. v.*
 16 *Walking Mountain Prods.*, 353 F.3d 792, 799 (9th Cir. 2003). The Court recognized
 17 the implications for other mash-up works: “if fair use was not viable in a case such
 18 as this, an entire body of highly creative work would be effectively foreclosed.” *Id.*
 19 Yet without relevant evidence regarding factor four, the Court denied the motion to
 20 dismiss “given the procedural posture of this motion and near-perfect balancing of
 21 the factors.” *Id.* p. 13.

22 The Court also denied Defendants’ motion to dismiss the copyright claims in the
 23 FAC on fair use grounds. Order Denying Motion to Dismiss (“Second MTD Order”;
 24 ECF No. 51). This time, the Court determined that market harm cannot be presumed
 25 because *Boldly* is transformative. *Id.* p. 9 (citing *Campbell*, 510 U.S. at 591; *Perfect*
 26 *10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1168 (9th Cir. 2007)). Yet, where DSE
 27 had alleged that it licenses derivative works, the Court found a potential harm to that
 28 market based on the allegations of the FAC. *Id.*

B. Trademark Claims and the First Amendment

DSE's causes of action under the Lanham Act and California Business and Professions Code § 17200 *et seq.*, sound in trademark (the "trademark claims"). To prevail on such claims, "a plaintiff must prove ... it has a valid, protectable trademark ... [Such proof] is comprised of two sub-parts: the mark's protectability and the plaintiff's ownership of the mark." *S. Cal. Darts Ass'n v. Zaffina*, 762 F.3d 921, 929 (9th Cir. 2014). In addition, the plaintiff must prove that the defendant's use is likely to cause confusion as to source. *Id.*

And DSE "bears a heightened burden—the plaintiff must satisfy not only the likelihood-of-confusion test but also at least one of *Rogers's* two prongs." *Gordon v. Drape Creative, Inc.*, No. 16-56715, 2018 U.S. App. LEXIS 32796, *12 (9th Cir. Nov. 20, 2018) (citing *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989)). Because DSE alleges use of its purported trademarks in an expressive work, its trademark claims implicate First Amendment interests. In such cases, Ninth Circuit precedent applies the *Rogers* test "to an expressive work only if the defendant's use of the mark (1) is not artistically relevant to the work or (2) explicitly misleads consumers as to the source or content of the work." *Id.*

When, as here, the defendant moves for summary judgment and has demonstrated that its use of the plaintiff's mark is part of an expressive work, the burden shifts to the plaintiff to raise a genuine dispute as to at least one of *Rogers's* two prongs. In other words, to evade summary judgment, the plaintiff must show a triable issue of fact as to whether the mark is artistically relevant to the underlying work or explicitly misleads consumers as to the source or content of the work.

Id. at *13. The Court has found that both prongs of the *Rogers* test are satisfied and dismissed each of the trademark claims, to the extent that they are based on the title of *Boldly*. Order Granting in Part Motion for Partial Judgment on the Pleadings ("MJP Order"; ECF No. 89) pp. 6-9. The remaining trademark claims concern the Defendants' use of a stylized font and an illustration style. *Id.* pp 8-9; FAC ¶ 17.

IV. Argument

A. Defendants are Entitled to Judgment on the Copyright Claims Raised in Count I of the Complaint on the Basis of Fair Use

The evidence leaves no genuine dispute as to any material fact related to the fair use defense. DSE has not shown that its licensed derivative works compete with *Boldly* or similar transformative works, and it has no basis to prevent publication.

The Court's analysis of three of the four statutory fair use factors is settled. The first factor favors Defendants; the second favors Plaintiff, but only slightly; the third is neutral. First MTD Order p. 13; Second MTD Order p. 6. The relevant evidence on the fourth factor tips the balance toward Defendants, showing that the market effect of *Boldly* would likely be neutral, if not positive, toward DSE's works.

The fourth factor turns on whether a substantial demonstrable harm of market substitution can be shown, for the original work or reasonably likely derivatives. *Campbell*, 510 U.S. at 590. *See* Patry on Copyright § 10:153 ("Assuming a transformative use, the fourth factor should weigh against the defendant only when the harm is substantial."). The proponent of fair use has the burden to show that it applies, because it is an affirmative defense. *Id.*; *see Perfect 10*, 508 F.3d at 1158. That burden would be difficult to carry "without favorable evidence about relevant markets." *Id.* But market harms cannot be presumed when the Defendants' work is transformative. *Campbell*, 510 U.S. at 591; Second MTD Order p. 9. So, in such cases, the plaintiff also bears an evidentiary burden under the fourth factor.

When no presumption of harm is warranted, burdens on the fourth factor shifts to the plaintiff. For example, for a noncommercial work, the plaintiff must demonstrate a likelihood of potential harm. *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984). This "requires proof either that the particular work is harmful, or that if it should become widespread, it would adversely affect the potential market for the copyrighted work." "What is necessary is a showing by a preponderance of the evidence that *some* meaningful likelihood of future harm

exists.” *Id.* Likewise, for transformative works, because a likelihood of market harm also cannot be presumed, “the burden falls on the plaintiff to demonstrate the existence of market harm.” *Righthaven, LLC v. Jama*, No. 10-cv-1322 JCM, 2011 U.S. Dist. LEXIS 43952, *12 (D. Nev. Apr. 22, 2011).

Plaintiffs “can reasonably be expected to have the evidence as to availability of licenses for their own works. It is therefore reasonable to place on Plaintiffs the burden of going forward with the evidence on this question [of the fourth factor].” *Cambridge Univ. Press v. Patton*, 769 F.3d 1232, 1279 (11th Cir. 2014). So, while Defendants “retain[] the overall burden of persuasion on the fourth factor,” *id.* at 1280, an evidentiary burden on market harm rightly falls on the plaintiff DSE. And when a plaintiff “has not identified any market for a derivative work that might be harmed by the [transformative work], ... the defendant had no obligation to present evidence showing lack of harm in a market for derivative works.” *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 116 n.6 (2d Cir. 1998). The Ninth Circuit’s approach is consistent. When the contested work is transformative, the plaintiff is expected to bring forward probative evidence of harm in an existing market, or “any impact on ‘traditional, reasonable, or likely to be developed markets.’” *Seltzer*, 725 F.3d at 1179 (quoting *Ringgold v. Black Entm’t TV, Inc.*, 126 F.3d 70, 81 (2d Cir. 1997)). Absent such evidence, “[w]here the allegedly infringing use does not substitute for the original and serves a ‘different market function,’ such factor weighs in favor of fair use.” *Id.* (quoting *Campbell*, 510 U.S. at 591).

Boldly “does not substitute for the original and serves a different market function than *Go!*” First MTD Order p. 11. Because direct market substitution is not at issue, the only cognizable market harm of potential concern would be any impact on licensing caused by “works of *Boldly*’s type.” *Id.* Defendants have produced substantial probative evidence addressing any such concern for the market effect of their complementary work.

Defendants produced expert testimony from Dr. Joshua Gans, a highly qualified witness and economics professor. Booth Decl. ¶ 21. Dr. Gans’ research has a particular focus on the role of intellectual property protections and competition in driving commercialization strategy by technology entrepreneurs. *Id.* ¶ 22. He is the author of several books and more than one hundred published papers, including research concerning the role of a fair use regime in licensing creative works. *Id.* ¶ 23; *see* Gans, Joshua S., “Remix rights and negotiations over the use of copy-protected works,” *Journal of Industrial Organization* vol. 41(C) pp. 76-83 (2015). In his expert report, Dr. Gans’ found that *Boldly* addresses a different market and market function from *Go!* and the other “Dr. Seuss” books and products, and does not impact their target market. Booth Decl. ¶ 24. Dr. Gans found a “strong prima facie case that there is unlikely to be any direct adverse impact of the publication of *Boldly* on any of Plaintiff’s products.” *Id.* ¶ 25. And “far from having a detrimental effect on Dr. Seuss products, *Boldly* is reasonably likely to have a positive impact on sales of Dr. Seuss books, including *Go!* and the other Seuss Books.” *Id.* ¶ 26.

Random House has been DSE’s publisher, and the publisher of the “Dr. Seuss” books by Theodor Geisel, since at least 1939. *Id.* ¶ 27. Dr. Gans’ expert report studied third-party works published outside DSE’s Random House license. Dr. Gans found available for sale on Amazon examples of third-party books that, like *Boldly*, draw from Dr. Seuss works, but are not published by Random House. *Id.* ¶ 28. He found that Amazon indicates that purchasers of those junior works also bought, and are likely to buy, other DSE-licensed “Dr. Seuss” books. *Id.* ¶ 29. By contrast, the Amazon page for *Go!* did not indicate that any of the third-party works were recommended to, or likely to be purchased by, *Go!* purchasers. *Id.* ¶ 30. Dr. Gans found this evidence strongly suggests that *Go!* and other “Dr. Seuss” books, “and works derivative or transformative thereof, are likely to serve as complements rather than substitutes in the eyes of consumers.” *Id.* ¶ 31. Therefore, he found a strong indication that the availability of derivative or transformative works such as *Boldly*

1 “will increase purchases” of *Go!* and other “Dr. Seuss” books that they derive from
2 or transform. *Id.* ¶ 32.

3 One such complementary book, *Oh, the Meetings You’ll Go To!* (“*Meetings*”) by
4 the pseudonymous “Dr. Suits,” was published in 2017 by an imprint of Random
5 House, DSE’s publisher, but without DSE’s consent or license. *Id.* ¶ 33. *Meetings*
6 purports to be a parody of *Go!* *Id.* ¶ 34. Penguin Random House’s 2017 catalog
7 promoted *Meetings* as one of twenty “Featured Titles” due to be published that year.
8 *Id.* ¶ 35. DSE produced no evidence that the presence on the market of *Meetings*, or
9 any other unlicensed complementary work, has harmed the market effect or value of
10 *Go!* or any of its other licensed works. *Id.* ¶ 36.

11 Dr. Gans not only found evidence that *Boldly* and other transformative works are
12 not substitutes for the Dr. Seuss works. He further found that publication of *Boldly* is
13 not likely to impede DSE from striking licensing deals. *Id.* ¶ 37. DSE’s licensed
14 goods, he found, would likely “outcompete unofficial transformative works.” *Id.* ¶
15 38. DSE has not produced evidence that contradicts or raises a genuine dispute as to
16 any material fact material to Dr. Gans’ expert report or his testimony. *Id.* ¶ 39.

17 Further, the highly transformative nature of *Boldly* prevents any cognizable harm
18 to DSE’s licensed, non-transformative works. DSE has presented no evidence that it
19 has licensed mash-ups, “where artists combine two independent works in a new and
20 unique way.” First MTD Order p. 12; *see id.* pp. 7-8; Booth Decl. ¶ 40. DSE has
21 presented no evidence that it has licensed transformative works of any more
22 traditional variety, such as parodies like *Meetings*. And DSE has produced no
23 evidence that unlicensed transformative works, when made available to the public,
24 cause it any cognizable market harm. For another example, DSE sent cease-and-
25 desist letters to the playwright and producer of *Who’s Holiday*, a play that parodies
26 the “Dr. Seuss” book *How the Grinch Stole Christmas*. *Lombardo v. Dr. Seuss*
27 *Enters., L.P.*, 279 F. 3d 497, 502-04 (S.D.N.Y. 2017), *aff’d*, 729 Fed. App’x 131 (2d
28 Cir. 2018); Booth Decl. ¶ 41. The playwright and producer won a declaratory

judgment of non-infringement and the play has had a theatrical run. *Id.*; Booth Decl. ¶ 42. DSE has not shown any harm arising from that unlicensed transformative use. Just as the parody *Who's Holiday* would not be a plausible substitute for a DSE “authorized derivative work,” *Lombardo v. Dr. Seuss Enters., L.P.*, 279 F. Supp. 3d at 512, *Boldly* poses no risk of substitution to any DSE-licensed derivative.

No cognizable loss has been shown. “A loss in the value of the copyrighted work resulting from transformative use is irrelevant to this [fourth] factor.” *Sedgwick Claims Mgmt. Servs. v. Delsman*, No. C 09-1468 SBA, 2009 US Dist. LEXIS 61825, *18 (N.D. Cal. July 16, 2009) (citing *Walking Mt. Prods.*, 353 F.3d at 805). This factor favors fair use “when the only possible adverse effect occasioned by the secondary use would be to a potential market or value that the copyright holder has not typically sought to, or reasonably been able to, obtain or capture.” *Am. Geophysical Union v. Texaco*, 60 F.3d 913, 930 (2d Cir. 1994). DSE’s allegation that *Boldly* may usurp a reasonably likely derivative or licensing market is not plausible because the use is transformative, and exists in a transformative market. “A market harm for licensing revenues will only be recognized ‘if the market is traditional, reasonable, or likely to be developed,’ and is not a protected transformative use.” *Bill Graham Archives, LLC v. Dorling Kindersley Ltd.*, 386 F. Supp. 2d 324, 333 (S.D.N.Y. 2005) (emphasis added), *aff’d*, 448 F.3d 605 (2d Cir 2006). To be cognizable as market harm, any impairment to DSE licensing opportunities must be in “a traditional, as opposed to a transformative market.” *Id.*, 448 F.3d at 614. “A use that ‘falls within a transformative market’ *does not* cause the copyright holder to ‘suffer market harm due to the loss of license fees.’” *Authors Guild, Inc. v. HathiTrust*, 902 F. Supp. 2d 445, 463 (S.D.N.Y. 2012) (quoting *Bill Graham Archives*, 448 F.3d at 615) (emphasis added), *aff’d in pertinent part*, 755 F.3d 87 (2d Cir. 2014). Conversely, when the Defendants’ use is clearly transformative, “plaintiff cannot prevent defendants from entering this fair use market.” *Arrow Prods. v. Weinstein Co. LLC*, 44 F. Supp. 3d 359, 372 (S.D.N.Y. 2014).

1 In particular, *Boldly* is a mash-up that combines existing elements from two
 2 discrete properties into a unique whole. Booth Decl. ¶ 43. DSE has pointed to no
 3 comparable licensed hybrid work of its own. *Id.* ¶ 44. DSE, formed in 1994, has had
 4 ample time to develop or license such works. *Id.* ¶ 45. Its extensive and growing line
 5 of licensed derivative works is undisputed. *Id.* ¶ 46. But the magnitude of DSE’s
 6 licensing efforts, and the absence from the marketplace of DSE-licensed hybrids like
 7 *Boldly*, is evidence that *Boldly* is not in a market that DSE traditionally or
 8 reasonably would enter, or is likely to develop on its own. *Id.* ¶ 47. “If a publisher
 9 makes licenses available for some uses but not for others, this indicates that the
 10 publisher has likely made a reasoned decision not to enter the licensing market for
 11 those uses, which implies that the value of that market is minimal.” *Patton*, 769 F.3d
 12 at 1278. Absent evidence of licenses for similar hybrid works, or competitive harms
 13 from such works, any market harm alleged is theoretical, and neither substantial nor
 14 cognizable under the fourth factor.

15 There is no genuine dispute over any material fact as to Defendants’ thorough
 16 showing of fair use, and they are entitled to judgment as a matter of law.

17 **B. Defendants are Entitled to Judgment on Count II of the Complaint**
 18 **Related to the Title of *Boldly* on the Basis of the *Rogers* Test**

19 DSE alleged that it has protectable trademark rights in the title of *Go!*, a stylized
 20 font used on or in Dr. Seuss books, and “the unique illustration style of the
 21 characters and backgrounds found throughout Dr. Seuss books.” FAC ¶ 17. Upon
 22 “finding that the title of *Boldly* does not violate the Lanham Act,” the Court granted
 23 Defendants’ motion for judgment on the pleadings as to each trademark claim “as
 24 they relate to the title of *Boldly*.” Order Granting in Part Motion for Partial Judgment
 25 on the Pleadings (“MJP Order”), ECF No. 89 pp. 8 & 9. So narrowed, the trademark
 26 claims are limited to those based on the alleged “stylized font” and generalized
 27 “illustration style.” That eliminates DSE’s second cause of action.
 28

Count II of the FAC alleges a violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114, based on DSE's registered mark for the title of *Go!*: United States Trademark Registration No. 5,099,531, the "OTPYG E-Book Mark." FAC ¶¶ 66-72; *see id.* ¶ 18 & ECF No. 61-3 (registration certificate). In Count II, DSE does not claim any infringement or use of its purported, unregistered font and style marks, which are the only remaining basis for the trademark claims. Because the Court granted partial judgment on the pleadings on all claims based on the title of *Boldly*, Defendants are entitled to judgment on Count II as a matter of law.

C. Defendants are Entitled to Judgment on Counts III and IV of the Complaint Based On Trademark Claims in an Insufficiently Pleaded "Illustration Style" and "Stylized Font"

DSE contends that it owns, and *Boldly* infringes on, trademarks in a "stylized font" that appears on or in Dr. Seuss books, and a generalized "illustration style" found in the books. FAC ¶ 17. Neither allegation is sufficiently pleaded, specified, or supported to withstand summary judgment.

Trademark law does not protect an artist's overall style, rather than discrete manifestations of that style. "Is there such a thing as trademark protection for the 'style' of an artist? Most courts have said no." *McCarthy on Trademarks* § 6.14 at n. 21 (4th ed. 2017) (collecting cases). Trademark law, like copyright law, may protect a "specific artistic expression" like a specified design or logo, but not an "artistic style." *Hartford House Ltd. v. Hallmark Cards, Inc.*, 846 F. 2d 1268, 1274 (10th Cir. 1988). "If the law protected style at such a level of abstraction, Braque might have prevented Picasso from selling cubist paintings in the United States." *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 382 (2d Cir. 1997). DSE has cited no cases holding that an artist's style, *per se*, may be exclusive or proprietary.

Based on the information before the Court at that stage of the proceedings, the Court found that DSE's "claimed general 'illustration style' is not protectable." Second MTD Order p. 15; *see also* ECF No. 52 (November 28, 2017 hearing

transcript) at 4:11-13 (tentatively finding that DSE’s “claimed illustration style is not a protectable trademark”). Those findings should be made conclusive, because DSE has done nothing to alter them. Booth Decl. ¶ 48. DSE has not identified the elements of its alleged illustration style with enough specificity that trademark significance could be claimed. *Id.* And DSE has cited no precedent supporting cognizable trademark rights in a mutable artistic style *qua* style. *Id.*

There is no genuine dispute as to any material fact and Defendants are entitled to judgment as a matter of law on the trademark claims, to the extent that they are based on DSE’s asserted rights in an unregistered trademark for an amorphous illustration style. No such rights exist.

DSE also alleged trademark rights in, and misappropriation of, an unspecified “stylized font used consistently in the front and back covers, spine, and title page of the Dr. Seuss books.” FAC ¶¶ 17 & 40; *see also id.* ¶¶ 76 & 85 (alleging “willful misappropriation of the stylized font that DSE uses consistently throughout the Dr. Seuss books”). This simply asserts DSE’s unsustainably broad claim of trademark rights in an illustration style, as applied to unspecified letterforms instead of unspecified “characters and backgrounds found throughout Dr. Seuss books.” *Id.* ¶ 17. A mutable font is no more susceptible of trademark rights than a general style.

At oral argument, DSE rested its broadly claimed “trademark rights on all fonts on all covers of Dr. Seuss’s books or Dr. Seuss Enterprises books ... and the font throughout all the books,” on the narrow basis that “distinctive writing can be protectable.” ECF No. 52 at 10:20-12:1; *see* Second MTD Order p. 14. Particular letters written in a consistent, distinctive form may be protectable, but the FAC does not claim such rights. DSE contends that the overall font, not any particular manifestation thereof, has gained secondary meaning as “Dr. Seuss’s distinctive font, it’s not just some fancy way of just doing letters.” ECF No. 52 at 10:6-7. This claim is as unsupported as the claim that “the illustrative style of Dr. Seuss,” rather than “a particular piece of artwork,” has attained secondary meaning in the marketplace. *Id.*

at 10:5-8. Both claims unduly stretch what DSE recognizes as “the basic premise of secondary meaning”—that it attaches to a particular “word or phrase or symbol out in the public sphere.” *Id.* at 9:18-23. It was insufficient for DSE to argue, “I don’t know of any jurisprudence that says that distinctive lettering is not protectable.” *Id.* at 11:25-12:1. Distinctive lettering of particular letters is protectable as a word-plus-design mark, just as particular letters in no particular design may be protected as a standard character mark. But DSE’s concocted rights to “lettering” *per se*, in no specific form, do not support a trademark claim. To the extent that DSE’s trademark claims are based on an alleged “stylized font,” no material fact is genuinely disputed and Defendants are entitled to summary judgment.

D. Defendants are Entitled to Judgment on Counts III and IV of the Complaint on the Basis of the *Rogers* Test and the First Amendment

In addition, all trademark claims alleged in the FAC cannot proceed on the basis of the *Rogers* test, which protects First Amendment interests in expressive work. The First Amendment limits the application of trademark law against artistic works like *Boldly* that use the plaintiff’s trademarks to describe or comment on the plaintiff’s goods or services. “When unauthorized use of another’s mark is part of a communicative message and not a source identifier, the First Amendment is implicated in opposition to the trademark right.” *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 900 (9th Cir. 2002) (quoting *Yankee Publ’g, Inc. v. News Am. Publ’g, Inc.*, 809 F. Supp. 267, 276 (S.D.N.Y. 1992)).

To balance trademark law and the First Amendment, the Ninth Circuit has adopted the approach taken by the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d, 994, 999 (2d Cir. 1989). *See Walking Mt. Prods.*, 353 F.3d at 807. Under the *Rogers* test, an artistic or creative work does not violate the Lanham Act by using a mark unless the use “has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless [it] explicitly misleads as to the source or the

content of the work.” *MCA Records*, 296 F.3d at 902 (*quoting Rogers*, 875 F.2d at 999). Though the Ninth Circuit first applied the *Rogers* test to the use of a trademark in a work’s title in *MCA Records*, 296 F.3d at 902, it has found “no principled reason why it ought not also apply to the use of a trademark in the body of the work.” *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008). In particular, defendants’ use of a plaintiff’s alleged marks on the cover of their book, replicating distinctive visual elements that appear on the covers of the plaintiff’s books, including the lettering, is subject to the *Rogers* test. *See Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 492-95 (2d Cir. 1989).

The use of DSE’s alleged marks in *Boldly* merits First Amendment protection under *Rogers*. First, it has “at least ‘some artistic relevance.’” *E.S.S. Entm’t 2000*, 547 F.3d at 1100 (*quoting MCA Records*, 296 F.3d at 902). Under *Rogers*, the quantum of “artistic relevance” required must merely be “above zero.” *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1243 (9th Cir. 2013). The use of fonts and illustrations that recall Dr. Seuss’s style is directly relevant to a creative work that addresses the relationship between *Go!* and other Dr. Seuss works and the *Star Trek* universe. Booth Decl. ¶ 49. “This Court previously found that Defendants’ invocation of Plaintiff’s alleged trademarks is relevant to *Boldly*’s artistic purpose.” MJP Order p. 6 (citing First MTD Order p. 15). What the Court found true of *Boldly* as to its use of *Go!*’s title is equally incontestable as to its use of DSE’s alleged trademark “stylized font” and “illustration style.”

When analyzing the second *Rogers* prong upon Defendants’ motion for judgment on the pleadings, the Court began: “The second prong of the *Rogers* test requires a junior user to show that its work does not explicitly mislead as to the source or content of the work.” *Id.* p. 7 (citing *MCA Records*, 296 F.3d at 902). The Ninth Circuit has since “clarif[ied] the burden of proof under the *Rogers* test.” *Gordon*, 2018 U.S. App. LEXIS 32796, *12. When the allegedly infringing use is expressive, the burden shifts to the plaintiff seeking to impinge on the defendants’ First

Amendment rights. “[T]o evade summary judgment, the plaintiff must show a triable issue of fact as to whether the mark is artistically relevant to the underlying work or explicitly misleads consumers as to the source or content of the work.” *Id.* *13.

DSE cannot sustain that burden. There is nothing explicitly misleading about the use of any alleged DSE mark in *Boldly*. “[T]he mere use of a trademark alone cannot suffice to make such use explicitly misleading.” *E.S.S. Entm’t 2000*, 547 F.3d at 1100 (*citing MCA Records*, 296 F.3d at 902). And the book expressly disclaims DSE’s sponsorship or endorsement: “This is a work of parody, and is not associated with or endorsed by CBS Studios or Dr. Seuss Enterprises, L.P.” ECF No. 8-9 p. 2. The disclaimer is one of two that appear on the copyright page, a typical place for disclaimers and legal notices. *Id.*; Booth Decl. ¶ 50. The contested uses are on the spine and title page of *Boldly*, which display the title and its use of the famous *Star Trek* “boldly go” split infinitive; on the cover, which depicts the same usage above a Captain figure and the U.S.S. Enterprise from the same TV series; and throughout the book’s contents, which are rife with *Star Trek* allusions. *Id.* p. 1 & *passim*; Booth Decl. ¶ 51. Those many points of reference steer consumers clear of any confusion by guiding them to the defining characteristics of *Boldly*’s creative combination.

These explicit disclaimers and implicit points of distinction between *Boldly* and the “Dr. Seuss” books ensure that Defendants’ use of the alleged marks is not explicitly misleading as to source or content. The Ninth Circuit’s latest opinion under *Rogers* considers “the degree to which the junior user uses the mark in the same way as the senior user.” *Gordon*, 2018 U.S. App. LEXIS 32796, *26. Concern over consumers being explicitly misled “is generally allayed when the mark is used as only one component of a junior user’s larger expressive creation, such that the use of the mark at most ‘implicitly suggest[s]’ that the product is associated with the mark’s owner.” *Id.* *28 (quoting *Rogers*, 875 F.2d at 998-99). By contrast, “using a mark as the centerpiece of an expressive work itself, unadorned with any artistic contribution by the junior user, may reflect nothing more than an effort to ‘induce

1 the sale of goods or services’ by confusion or ‘lessen[] the distinctiveness and thus
 2 the commercial value of’ a competitor’s mark.” *Id.* *28-29 (quoting *S.F. Arts &*
 3 *Athletics, Inc.v. U.S. Olympic Comm.*, 483 U.S. 522, 539 (1987)).

4 In *Boldly*, Defendants’ use of the alleged trademarks decidedly fits in the former
 5 type of use that allays concerns about misled consumers. There is no genuine dispute
 6 that DSE’s alleged marks are only one component of Defendants’ larger expressive
 7 creation. And DSE cannot credibly contend that *Boldly* is unadorned with any
 8 artistic contribution from its author and illustrator.

9 The *Gordon* court found “a triable issue of fact as to whether defendants simply
 10 used Gordon’s mark with minimal artistic expression of their own, and used it in the
 11 same way that Gordon was using it—to identify the source of humorous greeting
 12 cards in which the bottom line is ‘Honey Badger don’t care.’” *Id.* *30. No such issue
 13 arises from *Boldly*. Defendants’ extensive, creative contributions developed over the
 14 course of multiple drafts and revisions. Booth Decl. ¶ 52. And this is not a case over
 15 interchangeable greeting cards. Any use of a legitimate DSE trademark in the *Boldly*
 16 mash-up is both in a different manner, and with a different function, than DSE’s
 17 uses. *Boldly* serves a different market function than the “Dr. Seuss” books, and it is
 18 rigorously distinguished from its source material, building on that material while
 19 incorporating new material of the creators’ making. *Id.* Under the Ninth Circuit
 20 precedent applying the *Rogers* test, no material fact is reasonably subject to dispute.
 21 Defendants are entitled to judgment as a matter of law on the trademark claims.

22 **VI. Conclusion**

23 Defendants are entitled to judgment as a matter of law on all claims, and no
 24 material facts are in genuine dispute. Therefore, Defendants respectfully requests
 25 that the Court grant them summary judgment pursuant to Fed. R. Civ. P. 56(a).
 26
 27
 28

1 Respectfully submitted,

2 DATED: December 11, 2018

3
4 BOOTH SWEET LLP

SPRINKLE LLOYD & LICARI LLP

5
6 /s/ Dan Booth

/s/ Michael Licari

7 Dan Booth
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11 *David Gerrold and Ty Templeton*
12

13 **CERTIFICATE OF SERVICE**

14 I hereby certify that on this December 11, 2018 I electronically filed the
15 foregoing document by using the Court's ECF system, thereby causing a true copy
16 thereof to be served upon counsel of record for each party to have appeared to date,
17 as identified on the Notice of Electronic Filing.
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19 /s/ Dan Booth
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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

DR. SEUSS ENTERPRISES, L.P., a
California limited partnership,

Plaintiff,

v.

COMICMIX LLC, a Connecticut
limited liability company; MR.
GLENN HAUMAN, an individual;
MR. DAVID JERROLD
FRIEDMAN A/K/A DAVID
GERROLD, an individual; and MR.
TY TEMPLETON, an individual,

Defendants.

Case No. 16-cv-02779 JLS BGS

**PLAINTIFF DR. SEUSS
ENTERPRISES L.P.'S
MEMORANDUM OF POINTS AND
AUTHORITIES IN OPPOSITION
TO DEFENDANTS' MOTION FOR
SUMMARY JUDGMENT**

Date: January 31, 2019
Time: 1:30 pm
Courtroom: 4D
Judge: Hon. Janis L. Sammartino

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1 I. INTRODUCTION

2 In their motion for summary judgment, Defendants ask the Court to find that
 3 (1) their extensive taking from DSE's copyrighted works is fair use and (2) their
 4 copying of Dr. Seuss's unique illustration style and distinctive font is not trademark
 5 infringement, either because the style and font are not legally protected or because
 6 the *Rogers* exception to infringement applies. These arguments fail, because they
 7 misconstrue the law and ignore the facts developed in discovery. The Court should
 8 deny Defendants' summary judgment motion, and grant partial summary judgment
 9 in DSE's favor that (1) Defendants have infringed DSE's copyrights, and (2) the
 10 DSE Marks are valid and protectable.

11 Defendants, who bear the burden of proof on copyright fair use, initially
 12 argue that the Court's analysis of the first and third fair use factors, at the pleading
 13 stage, is "settled." This is not the law. A court is not bound on summary judgment
 14 by its prior rulings on a motion to dismiss, where the only question presented was
 15 whether the complaint pleads a plausible claim. Moreover, fair use is inherently a
 16 factual inquiry, and the factual record developed in discovery shows that all four
 17 factors strongly favor DSE's position, and that no reasonable juror could excuse
 18 Defendants' infringing conduct as a fair use.

19 In particular, Defendants fail to carry their burden on the "most important"
 20 fourth factor: the negative impact on actual and potential markets for Dr. Seuss
 21 books and derivatives were Defendants and others allowed to infringe at will. DSE
 22 has provided ample proof of likely economic harm, including a history of licensing
 23 collaborative derivative works where Seuss creations appear in the same work as
 24 other parties' creations, just as *Oh, The Places You'll Boldly Go!* ("Boldly")
 25 intermingles Seuss and *Star Trek*. DSE has also shown that Defendants
 26 intentionally aimed *Boldly* at DSE's *Oh, The Places You'll Go!*'s ("Go!") core
 27 graduation market, and planned to sell *Boldly* in the same channels of trade,
 28 demonstrating that *Boldly* would likely usurp a material portion of that market.

1 Defendants ignore these facts and counter with the unsworn and inadmissible
2 opinions of their proffered expert, Joshua S. Gans. But as set forth in DSE’s
3 *Daubert* motion, Gans’s opinions are unsupported by facts and follow no accepted
4 methodology for assessing market impact. Gans’s unreliable opinions should be
5 excluded, and the Court should find that the fourth factor strongly favors DSE.

6 On DSE’s trademark infringement claims, Defendants contend that unique
7 illustration styles and distinctive fonts cannot function as trademarks. The law,
8 however, says that they can be protectable trademarks if they have acquired
9 secondary meaning. The factual record shows ample evidence of secondary
10 meaning: the consuming public strongly associate Seuss’s illustration style, and the
11 font consistently used by him and DSE, with Seuss and no other source.

12 Nor can Defendants argue that *Rogers* protects their deliberate trademark
13 use, in light of the Ninth Circuit’s recent decision in *Gordon v. Drape Creative,*
14 *Inc.*, 909 F.3d 257 (9th Cir. 2018). *Gordon* reversed an order dismissing a
15 trademark infringement claim on *Rogers* grounds. It held that use of another’s
16 mark in an expressive work may be “explicitly misleading,” and therefore
17 infringing, without an affirmative statement that the mark owner authorized the use.
18 *Gordon* held that where the junior user uses the mark in the same market and
19 “similar artistic expressions” as the senior user, this usage has an “especially
20 strong” potential to mislead consumers. This case presents just such a scenario, as
21 Defendants deliberately used the DSE Marks without material alteration, and used
22 these marks in the same way as Seuss did, and DSE does—to denote the source of
23 books and other licensed goods—and on works that were intended to compete in
24 the same market as Seuss’s works, namely as gifts for graduating students.

25 For these reasons, discussed in detail below, Defendants’ motion for
26 summary judgment should be denied in its entirety, and partial summary judgment
27 entered in DSE’s favor that (1) Defendants have infringed DSE’s copyrights, and
28 (2) the DSE Marks are valid and protectable.

II. FACTS NOT SUBJECT TO GENUINE DISPUTE

A. The DSE Intellectual Property

DSE is the owner, by assignment, of the intellectual property relating to the works of Theodor S. Geisel, the author and illustrator of the books written under the pseudonym “Dr. Seuss.” (Statement of Additional Undisputed Material Facts (“SOAF”) ¶ 1.) Geisel wrote and illustrated the copyrighted works at issue here: *Go!; How the Grinch Stole Christmas!* (“Grinch”); and *The Sneetches and Other Stories* (collectively, the “DSE Works”). (ECF No. 107-2 (“SOF”) ¶¶ 2-7.)

DSE claims protectable rights in the Unregistered Dr. Seuss Marks, defined in its First Amended Complaint as: “(1) the title OH, THE PLACES YOU’LL GO!; (2) the stylized font used consistently on the front and back covers, spine, and title page of the Dr. Seuss books such that this use of the stylized font has come to be recognized by consumers as a source identifier for Dr. Seuss; and (3) the unique illustration style of the characters and backgrounds found throughout Dr. Seuss books.” (ECF No. 39 at ¶17.) On May 21, 2018, the Court granted in part Defendants’ motion for partial judgment on the pleadings, dismissing DSE’s trademark claims as they relate to Defendants’ unauthorized use of the title OH, THE PLACES YOU’LL GO!. (ECF No. 89.) DSE’s trademark claims on the remaining Unregistered Dr. Seuss Marks—the “Seussian style” and the “Seussian font” (collectively, the “DSE Marks”)—proceeded through discovery.¹

DSE oversees a robust publishing program, working closely with its publishers as well as with consumer product companies that utilize DSE’s intellectual property. (SOF ¶¶ 128-137.) As part of this program, DSE licenses authors and illustrators to publish additional works under the Dr. Seuss brand

¹ “Seussian style” refers to the unique illustration style of the characters and backgrounds found throughout Dr. Seuss books and “Seussian font” refers to the stylized font used consistently on the front and back covers, spine, and title page of the Dr. Seuss books. (ECF No. 39 at ¶ 17.)

1 utilizing, among other DSE trademarks, the DSE Marks. (*Id.*) DSE has also
 2 licensed book collaborations, such as the *Wubbulous World of Dr. Seuss*, which
 3 combine Seuss works with another party's property. (SOF ¶ 150-155.) These
 4 works utilize indicia, including the DSE Marks, that signal to consumers that DSE
 5 is the source. (*Id.*; SOAF ¶ 25.) DSE asserts close quality control over its licensed
 6 partners to ensure that their books and other products are of a consistent and high
 7 level of style and quality. (SOF ¶¶ 128-131; SOAF ¶¶ 2-3.) As DSE's President,
 8 Susan Brandt, explained, "[REDACTED]
 9 [REDACTED]
 10 [REDACTED]
 11 [REDACTED]" (SOAF ¶ 2.)

12 DSE is also in the entertainment business, licensing its intellectual property
 13 for use in films, television, stage productions, theme parks, and museum
 14 exhibitions. (SOF ¶ 138.) DSE's product licensing and merchandising program
 15 offers a wide array of goods bearing DSE's trademarks, including the DSE Marks.
 16 (SOF ¶¶ 138-139, 144.) In 2017, market research firm NPD named DSE the top
 17 licensed book brand. (SOF ¶ 159.)

18 Given its obligations as a trademark owner to maintain consistency across its
 19 licensees' use of its trademarks, DSE created a Style Guide for its licensees and
 20 partners, which provides extensive direction on maintaining and meeting the
 21 Seussian style. (SOAF ¶¶ 6-16; 18-22.) The consistent look and style of its
 22 licensees' books and other products is so vital to DSE to denote the Dr. Seuss brand
 23 that DSE also has specific style guides that instruct on the permissible colors,
 24 designs, and images for the licensed work. (*Id.*)

25 As a result of this consistency across works, the Seussian style is so well-
 26 known by the consuming public that "Seussian" is defined by Merriam-Webster as
 27 "of, relating to, or suggestive of the works of Dr. Seuss (Theodore Geisel)
 28 especially: having a playfully inventive or outlandish quality typical or reminiscent

1 of the ... images found in children's stories like *The Cat in the Hat* and *How the*
 2 *Grinch Stole Christmas*.” (SOAF ¶ 23.)

3 The Seussian style is evident when looking at Dr. Seuss's body of work,
 4 including *Go!*. (SOAF ¶ 24.) Examples of elements that comprise the style
 5 include: (1) the appearance of his characters, including their “half-moon” pupils,
 6 unique button noses, and hair drawn to give the appearance of “moving forward,”
 7 their faces almost always drawn at three-quarter profile or complete profile, with
 8 distinctive, pear-shaped bodies; (2) his distinctive line weight, shading, cross-
 9 hatching, patterns, and color combinations; (3) his use of surrealistic architecture
 10 and machinery; and (4) the appearance of his backgrounds and his landscapes, such
 11 as mountains drawn like waves of water and organic shrubbery and trees. (SOF ¶
 12 52; SOAF ¶ 17.) As defendant Hauman testified when acknowledging the
 13 distinctiveness of the Seussian style: “you know it when you see it.” (SOAF ¶ 30.)

14 DSE's Style Guide also [REDACTED]
 15 [REDACTED]” which are based on the hand-lettered titles
 16 that Dr. Seuss drew for the cover art to each of his books. (SOAF ¶¶ 4-5, 11-13.)
 17 These fonts are “unique and proprietary” to DSE. (*Id.*) DSE and its licensees use
 18 these fonts consistently across books, DSE's website, and on licensed products and
 19 packaging to indicate that DSE is the source of the goods. (*Id.*)

20 **B. Defendants' Infringing Conduct**

21 When Hauman was contemplating ideas for his *Star Trek* primer, he told
 22 defendant Gerold that “what we can do as a parody...is pretty dang broad as long as
 23 we aren't doing *too much* trademark infringement.” (SOF ¶ 11 (emphasis added.))
 24 In creating *Boldly*, Defendants made a concerted effort to utilize the DSE Marks to
 25 ensure that *Boldly* would “match the look and feel of Seuss books,” and appear to
 26 the consumer as though it was a “50th Anniversary reprinting of a classic children's
 27 book, as if it had existed in the past.” (SOF ¶¶ 8, 36, 37, 49-50, 52-55, 60, 84;
 28 SOAF ¶¶ 36-42, 43-46.) Hauman searched for an illustrator that could “draw in a

1 Seussian style” because he “wanted to make sure that [Defendants] worked with the
 2 style of [*Go!*]” in order for *Boldly* to be “[e]vocative of Dr. Seuss.” (SOAF ¶¶ 26,
 3 31-36, 42.) Hauman admitted that he “certainly intended” for *Boldly* to be
 4 “Seussian,” and that “Seuss’s artwork is expressive in a particular way.” (*Id.*)

5 Hauman chose defendant Templeton to illustrate *Boldly* because Hauman
 6 considered Templeton adept at copying other artists’ styles. (SOAF ¶¶ 27, 34.)
 7 Templeton made sure that his illustrations for *Boldly* were in the “Seussian” style
 8 by sending to the other Defendants his “prelim and rough sketches,” showing his
 9 “attempts at learning how to Seuss up” the characters. (SOAF ¶ 35.) Templeton
 10 testified that Hauman instructed him to make his illustrations “closer to” *Go!* and so
 11 he “started matching drawings from the original.” (SOF ¶¶ 36-37.) Templeton
 12 “practiced how to illustrate in Dr. Seuss’s illustration style,” and by the time he was
 13 nearly finished with *Boldly*, he had rounded out his mastery of the “Seussian style”
 14 by reviewing “twenty Seuss books and counting.” (SOAF ¶¶ 28-31, 38-39.)

15 Throughout *Boldly*, Templeton copied the “look and feel” of the Seussian
 16 style, which Defendants admit is distinctive. (SOAF ¶¶ 36-37.) He added “flat
 17 colors” for “a Seussian look” and copied the “Seussian art style,” including by: (i)
 18 adopting Dr. Seuss’s “physical movement state” in order to use Seuss’s unique
 19 technique of “cross-hatching” in “a similar way”; (ii) drawing eyes in the same way
 20 as Seuss; (iii) adopting Seuss’s “fondness for the button nose”; (iv) drawing trees
 21 with “big long loopy circles”; and (v) adopting Seuss’s “imprecise quality” in
 22 drawing circle and lines, among many other techniques that make Seuss’s works
 23 uniquely Seussian. (SOAF ¶¶ 39, 48; SOF ¶ 52.) Templeton frankly said that “I
 24 did, in fact, slavishly copy from Seuss,” in illustrating *Boldly*. (SOF ¶ 54.)

25 To complete their deliberate copying, Defendants used a “version of the
 26 Doctor Soos font”—an unauthorized third party font that imitates the recognizable
 27 hand-lettering that Dr. Seuss created for his books—for the title and Gerrold’s and
 28 Templeton’s names on a mockup of *Boldly*’s cover. (SOAF ¶¶ 41-42.) Hauman

1 testified that he chose this font because it was “deliberatively evocative of a
 2 Seussian style” and had a “similarity to existing Dr. Seuss samples.” (*Id.*) Hauman
 3 then “modified” the Doctor Soos font to make it look even more “Seussian.” (*Id.*)
 4 For *Boldly*’s cover, Templeton drew the lettering by hand, copying “as a model” the
 5 font on *Go!*’s cover. (SOAF ¶ 43.)

6 When *Boldly* was being finalized for printing with Defendants’ original
 7 publishing partner, Andrews McMeel Publishing (“AMP”), an AMP editor asked
 8 Hauman whether the cover was “going to be the same image as shown in the
 9 proposal or...one that more closely resembles the original [*Go!*].” (SOAF ¶ 45.)
 10 Hauman sent a modified cover of *Boldly*, placing it side-by-side with *Go!* and
 11 stated “[p]retty close to what you see, which is pretty darn close to the original.”
 12 (*Id.*) And Gerrold admitted that, looking at *Boldly*’s cover, “you could even say it
 13 looks like it was produced by Dr. Seuss.” (SOAF ¶ 46.)

14 Defendants knew that *Go!* was a book marketed as a gift for graduates, and
 15 admitted their intent for *Boldly* to target DSE’s market for *Go!*, the perennial best-
 16 selling book on *The New York Times* Best Sellers list during graduation season.
 17 (SOAF ¶¶ 49-52.) Defendants’ prospective publisher saw graduation as *Boldly*’s
 18 primary market, too, and described the target for *Boldly* as “[REDACTED]
 19 [REDACTED].”
 20 (SOF ¶¶ 72-76, 79; SOAF ¶ 53.) After Defendants and AMP reached an agreement
 21 to publish *Boldly*, AMP selected on [REDACTED]
 22 [REDACTED]” (SOF ¶ 91; SOAF ¶ 53.)

23 AMP backed out of its agreement to publish *Boldly*, so Defendants pushed
 24 another third-party, ThinkGeek, to publish before graduation season arrived. (SOF
 25 ¶¶ 116-126.) Hauman did not promptly notify ThinkGeek about DSE’s claims,
 26 rationalizing to the other Defendants, “[i]f we have to pull the order from
 27 [ThinkGeek], we can smooth things over with them by explaining that we’re
 28 dealing with legal matters and didn’t want to expose them to it, which I’m sure

1 they'll appreciate, and they'll have new orders in time for school graduations."
 2 (SOF ¶ 121.) ThinkGeek was eventually notified of the instant litigation, and on
 3 February 2, 2017, ThinkGeek and Hauman discussed the prospects of offering
 4 *Boldly* in time for graduation. (SOF ¶ 103.) Defendants also planned to offer
 5 *Boldly* for sale at the same retailers as DSE's books, including Barnes & Noble and
 6 Amazon. (SOAF ¶¶ 49-50.)

7 **C. The Unrebutted Poret Likelihood of Confusion Survey**

8 DSE has also provided substantial evidence showing that Defendants'
 9 deliberate use of the DSE Marks is likely to cause consumer confusion. DSE's
 10 expert, Hal Poret, provided a report dated September 27, 2018 (the "Poret Report"),
 11 which is unrebutted. (SOAF ¶ 55.) Mr. Poret describes the consumer survey that
 12 he designed and conducted in order to test the extent to which *Boldly*'s illustration
 13 style and font "causes prospective consumers to mistakenly believe that the work is
 14 created or published by Seuss or that it is sponsored or endorsed by Seuss." (SOAF
 15 ¶ 56.) The survey had a Test Group, who saw *Boldly*, and a Control Group, who
 16 saw an altered version of *Boldly* created under Mr. Poret's direction by an artist
 17 retained by DSE (the "Control Work"). (SOAF ¶¶ 57-58.) The Control Work
 18 includes the identical title, story, and prose as *Boldly* (and even its disclaimer), but
 19 employs an illustration style and font that does not use the DSE Marks. (SOAF ¶
 20 58.) Examples of the Control Work, as compared to *Boldly*, are seen below:

21 /////

22 /////

23 /////

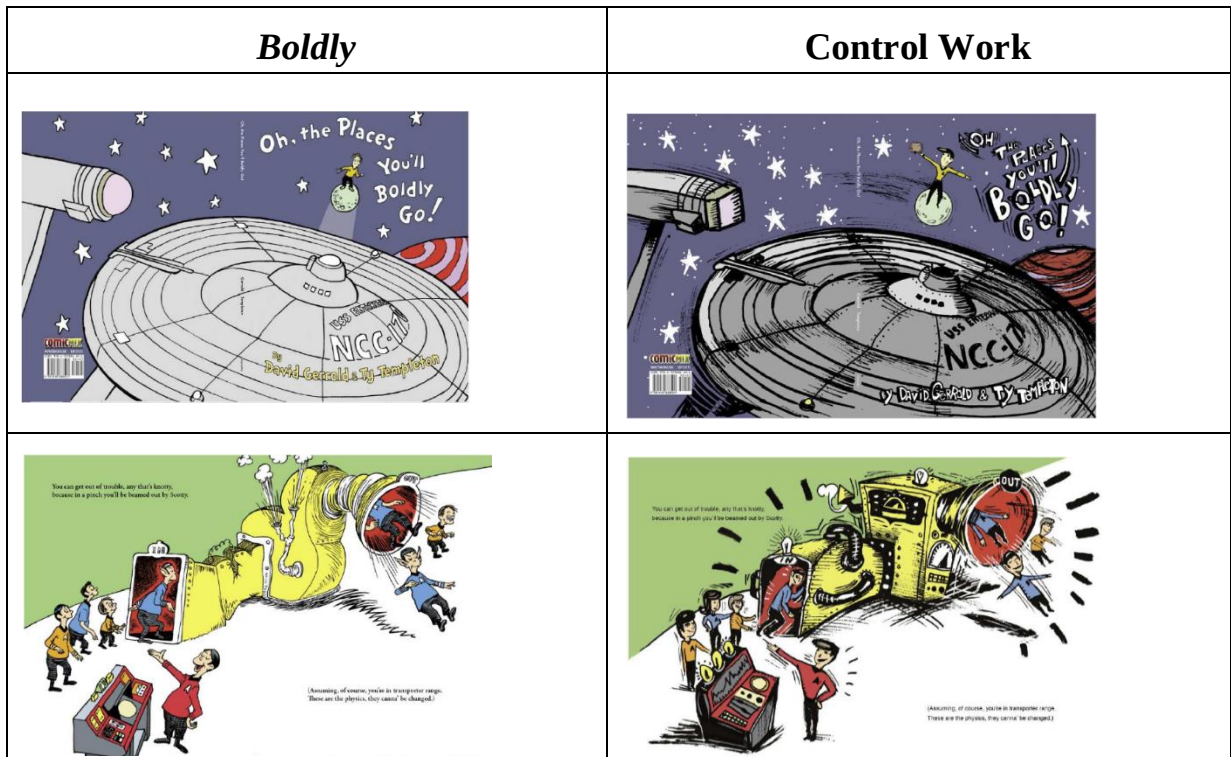
24 /////

25 /////

26 /////

27 /////

28 /////



The Control Group and Control Work were used to isolate and eliminate consumer confusion that could arise for reasons other than use of the DSE Marks, such as similarities in title, story or other prose. (SOAF ¶ 59.) After exposure to the specific work, the Test Group was asked who they believed created, sponsored or endorsed *Boldly*, and the Control Group was asked who they believed created, sponsored or endorsed or the Control Work. (SOAF ¶¶ 60-62.)

The survey results demonstrate a statistically and legally significant finding of consumer confusion. 39.7% of the Test Group registered as confused as to source, compared with 15.7% of the Control Group. (SOAF ¶¶ 63-64.) Subtracting the latter as “noise,” Mr. Poret found a final net confusion rate of 24%. (SOAF ¶ 65.) Mr. Poret thus concluded that “the illustration style and font of *Boldly* creates a substantial likelihood of confusion with respect to Dr. Seuss.” (SOAF ¶ 66.)

D. Defendants’ Unreliable Expert Witness

Defendants designated Joshua S. Gans, an Australian citizen who teaches economics in Canada, as their sole expert in this case. (ECF No. 104-4 at 2.) The

subject of Gans’s proposed opinions is “what likely effect [*Boldly*] will have on the potential market for or value of certain works by Dr. Seuss ... and licensed derivative works thereof.” (*Id.* at 4.) Gans does not offer any opinion in support of Defendants’ defense to DSE’s trademark claims. (*Id.*) Because Gans’s proposed opinions do not even meet the minimum standards of reliability for admissible expert testimony under the Federal Rules of Evidence and *Daubert*, DSE has moved to exclude him and his proposed opinions from this case.² (ECF No. 104.)

III. ARGUMENT

A. The Court Should Grant Summary Judgment To DSE on its Copyright Claims

1. *Boldly* Infringes DSE’s Copyrights

As shown in DSE’s motion for summary judgment, there is no genuine dispute that: (1) DSE owns valid copyrights in the DSE Works; and (2) Defendants directly and substantially copied from the DSE Works to create *Boldly*. (ECF No. 107 at Sec. III(A).) Having moved on only their fair use defense, Defendants effectively concede DSE’s *prima facie* case of infringement: in this Circuit, “[t]his affirmative defense presumes that unauthorized copying has occurred, and is instead aimed at whether the defendant’s use was fair.” *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1170 (9th Cir. 2012). “As with all affirmative defenses, [Defendants] bear the burden of proof.” *Id.* And because Defendants have not carried their burden and DSE has established in its motion that no fair use defense is available, the Court should deny Defendants’ motion and grant DSE’s motion.

2. *Boldly* Is Not A Fair Use of DSE’s Protected Expression

a. The First Three Fair Use Factors Favor DSE

Defendants conclude, without supporting authority or even rationale, that the

² As set forth in DSE’s contemporaneously-filed motion to strike, the Gans expert reports are also unsworn and, therefore, inadmissible.

1 “Court’s analysis of three of the four statutory fair use factors is settled” and may
 2 not be revisited on summary judgment. (Br. at 7.) To the extent Defendants are
 3 relying on the “law of the case” doctrine for this conclusion, they are wrong.
 4 Rulings made on a motion to dismiss consider only whether the well-pleaded
 5 allegations of a complaint state a claim. Because a summary judgment motion
 6 considers the entire evidentiary record developed in discovery, prior rulings have
 7 no binding effect. *Peralta v. Dillard*, 744 F.3d 1076, 1088 (9th Cir. 2014).

8 As explained by *Guadiana v. State Farm Fire & Cas. Co.*:

9 [L]aw of the case ordinarily does not apply to issues
 10 raised on summary judgment after they were rejected on a
 11 motion to dismiss because motions for summary
 12 judgment are subject to a different standard. On a motion
 13 to dismiss, the court considers whether the plaintiff has
 14 stated a claim upon which relief may be granted assuming
 15 allegations in the complaint are true. On summary
 16 judgment, the court considers whether there is a genuine
 17 issue of material fact in light of the evidence uncovered
 18 during discovery.

19 2009 WL 3763693, at *6 (D. Ariz. Nov. 10, 2009).

20 Fair use is an inherently fact-intensive inquiry, *Dr. Seuss Enter., L.P. v.*
 21 *ComicMix LLC*, 256 F. Supp. 3d 1099, 1104 (S.D. Cal. 2017), and as shown in
 22 DSE’s summary judgment motion, based on the extensive record, *Boldly* is highly
 23 commercial, not transformative, was developed in bad faith, and violates DSE’s
 24 right to create derivative works, and, thus, the first factor favors DSE. (ECF No.
 25 107 at Sec. III(B)(1).) The record also reinforces the conclusion that DSE’s
 26 copyrighted works are highly creative, and, thus, the second factor also favors DSE.
 27 (*Id.* at Sec. III(B)(2).) And the record shows that Defendants took far more from
 28 *Go!* than needed to create *Boldly* (even surmising a “way out” of the suit by taking
 less), and, thus, the third factor favors DSE as well. (*Id.* at Sec. III(B)(3).)

29 **b. The Fourth Factor Also Favors DSE**

30 DSE’s motion also shows that *Boldly* is likely to harm the market for *Go!* and
 31 its derivatives. (ECF No. 107 at Sec. III(B)(4).) Defendants’ contention that “the

1 market effect of *Boldly* would likely be neutral, if not positive, toward DSE’s
 2 work,” is neither supported by the law nor the factual record, and thus does not “tip
 3 the balance” on this “most important” factor in favor of fair use towards
 4 Defendants. *See Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539,
 5 566 (1985). Defendants misconstrue the law on which party bears the burden of
 6 proof on this factor, ignore the undisputed record, and criticize DSE for not
 7 bringing forward probative evidence of harm in an existing market or any impact on
 8 reasonably likely to be developed markets. (Br. 7-8.) These arguments all fail.

9 As the Supreme Court has made clear, “[s]ince fair use is an affirmative
 10 defense, its proponent [(Defendants here)] would have difficulty carrying the
 11 burden of demonstrating fair use without favorable evidence about relevant
 12 markets.” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994).
 13 Defendants cannot carry their burden because they do not offer a shred of
 14 admissible evidence about the relevant markets for *Go!*, derivatives of the DSE
 15 Works, and *Boldly*.

16 Defendants’ citation to the Court’s pre-discovery finding on factor one that
 17 *Boldly* does not substitute for *Go!* (Br. at 8) ignores the very different picture
 18 developed in discovery. The facts show that *Boldly* was designed to serve the exact
 19 same market function as *Go!*, from its extensive use of the DSE Marks and
 20 copyrighted expression to convey the same message as *Go!* and to reach the same
 21 audience of graduates and graduation gift-buyers, while selling through the same
 22 channels as *Go!*. (SOF ¶¶ 36-38, 49-50, 52, 55, 60, 75, 84, 86, 92, 100-101, 103,
 23 121, 124, 141, 143-144, 148; SOAF ¶¶ 26, 28, 36, 39, 41-44, 49-54.) “Under these
 24 facts, Defendants evidently intend for their work to effectively function as a market
 25 substitution to [*Go!*].” *Paramount Pictures, Corp. v. Axanar Productions, Inc.*,
 26 2017 WL 83506, at *9 (C.D. Cal. Jan. 3, 2017).

27 Rather than address the undisputed evidence, Defendants rely on Dr. Gans’s
 28 unsupported opinion that “*Boldly* addresses a different market and market function

1 from *Go!* and the other ‘Dr. Seuss’ books and products, does not impact their target
 2 market.” (Br. at 9.). Gans’s proposed opinions, however, can neither overcome the
 3 undisputed factual evidence on this factor, nor meet the minimum standards of
 4 reliability for admissible expert testimony, as shown in DSE’s motion to exclude
 5 Gans from testifying in this action. (ECF No. 104-1 at Secs. III(B)(1)-(4).) The
 6 Court should not consider this unreliable and inadmissible testimony.³

7 Defendants also contend that *Boldly* would not harm DSE’s derivative or
 8 licensing market, because DSE has purportedly “pointed to no comparable licensed
 9 hybrid work of its own.” (Br. at 12.) According to Gans, “the absence from the
 10 marketplace of DSE-licensed hybrids like *Boldly*, is evidence that *Boldly* is not in a
 11 market that DSE traditionally or reasonably would enter, or is likely to develop on
 12 its own.” (*Id.*) Gans is unqualified to offer this expert opinion, (ECF No. 104-1 at
 13 Sec. III(B)(3)), and also ignores the undisputed facts that: (1) DSE has published
 14 several books that are derivative of the DSE Works, including derivatives of *Go!*
 15 (SOF ¶¶ 142-143); (2) DSE oversees a robust licensing program for the DSE Works
 16 (SOF ¶¶ 129-130; SOAF ¶ 2); (3) DSE has partnered, and will partner, with other
 17 rights holders on licensed “collaborations” that combine Dr. Seuss’s works with
 18 another property to create new works (SOF ¶¶ 153-157); and (4) *Boldly* is **exactly**
 19 the type of derivative collaboration that DSE might license. (*Id.*)

20 Worse, Defendants proceed from an erroneous legal assertion: where
 21 potential markets are at issue, the fourth factor favors only the copyright owner who
 22 already had plans to produce a derivative work that is either identical to, or
 23 substantially the same as, the infringing work. (Br. at 11-12.) The law is exactly
 24 the opposite: “[I]t is the ‘potential market’ for the copyrighted work and its
 25

26 ³ Defendants and Gans further contend that *Boldly* is fair because it would have a
 27 “positive impact” on sales of Seuss books. (Br. at 9.) Gans’s conclusion is both
 28 unreliable and not supported by the law, as “the boon to the [Dr. Seuss works] does
 not make [Defendants’] copying fair.” *Campbell*, 510 U.S. at 591 n.21.

1 derivatives that must be examined, even if the ‘author has disavowed any intention
 2 to publish them during his lifetime,’ given that an author ‘has the right to change
 3 his mind’ and is ‘entitled to protect his opportunity to sell his derivative works.’”
 4 *Salinger v. Colting*, 641 F. Supp. 2d 250, 267-68 (S.D.N.Y. 2009) (quoting
 5 *Salinger v. Random House, Inc.*, 811 F.2d 90, 99 (2d Cir. 1987)) *rev’d on other*
 6 *grounds*, 607 F.3d 68 (2d Cir. 2010); *see also*, *Castle Rock Entm’t, Inc. v. Carol*
 7 *Pub. Grp.*, 150 F.3d 132, 145-46 (2d Cir. 1998) (fourth factor favored plaintiff even
 8 where it “evidenced little if any interest in exploiting this market for derivative
 9 works” because the law “respect[s] that creative and economic choice.”). The same
 10 rule prevails in the Ninth Circuit. *See e.g.*, *Paramount*, 2017 WL 83506, at *9
 11 (“Judging by the success of Defendants’ fundraisers, the Axanar Works are the type
 12 of work for which there is a separate demand that Plaintiffs may one day seek to
 13 exploit.”) (int. quote omitted).

14 Accordingly, the fourth factor favors DSE even if DSE has not yet
 15 collaborated with CBS on a work that is identical, or close, to *Boldly*, or chooses
 16 not to license a book to compete directly with *Go!*, its perennial best-seller. *Id.*
 17 Authors have the exclusive right to create—or choose not to create—derivatives of
 18 an original work, *Salinger*, 641 F. Supp. 2d at 267-68, and a work like *Boldly*,
 19 mixing Seuss’s works with the well-known *Star Trek* franchise, is exactly the type
 20 of work that DSE might reasonably license. (SOF ¶¶ 153-157.)

21 Defendants also assert that there already exist “complementary” works
 22 derived from *Go!*, a book called “*Oh the Meetings You’ll Go To!*” (stating on the
 23 cover “a parody by Dr. Suits”), and a play (based on *Grinch*) called “*Who’s*
 24 *Holiday*.”⁴ And even though Gans failed to follow any accepted methodology for
 25 determining whether products are complements or substitutes of one another (ECF
 26

27 ⁴ *Lombardo v. Dr. Seuss Enterprises, L.P.*, 729 F. App’x 131, 132 (2d Cir. 2018)
 28 determined that *Who’s Holiday* is a fair use parody.

No. 104-1 at Sec. III(B)(1)), and did not even mention these two parodies, Defendants cite Gans’s proposed testimony as the sole factual evidence suggesting that “works derivative or transformative [of *Go!*] are likely to serve as complements rather than substitutes in the eyes of consumers.” (Br. at 9.) But *Boldly* is not a parody, and, as discussed above, Defendants themselves sought to make *Boldly* a substitute purchase for *Go!* in the graduation gift market.

For all of these reasons, the undisputed evidence relating to the fourth factor thus strongly tips in DSE’s favor. Accordingly, Defendants’ motion should be denied, and summary judgment should be granted to DSE on its copyright claims.

B. The Court Should Deny Defendants’ Summary Judgment Motion Relating to DSE’s Trademark Claims

1. Legal Standard For Trademark Infringement

“To state a valid cause of action for trademark infringement under the Lanham Act, a plaintiff must prove: (1) that it has a protectable ownership interest in the mark; and (2) that the defendant’s use of the mark is likely to cause consumer confusion.” *Daimler AG v. A-Z Wheels LLC*, 334 F. Supp. 3d 1087, 1095 (S.D. Cal. 2018) (int. quotation marks omitted). Because “summary judgment is generally disfavored in the trademark arena” due to “the intensely factual nature of trademark disputes” in assessing “the ultimate question of likelihood of confusion,” *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1140 (9th Cir. 2002), DSE has not moved for summary judgment on its remaining trademark claims.

Defendants, however, seek summary judgment that the DSE Marks are not valid and on their *Rogers* defense. (Br. at 13-18.) But DSE has proven in discovery that the DSE Marks are valid, and, as shown by the Ninth Circuit’s very recent decision in *Gordon*, 909 F.3d at 257, triable issues of fact remain on whether Defendants’ unauthorized use would be shielded by *Rogers*.

2. DSE Owns Protectable Rights in the DSE Marks

The Lanham Act is intended to “prevent[] competitors from copying a

1 source-identifying mark.” *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539
 2 U.S. 23, 34 (2003); *see also* 15 U.S.C. § 1125(a). The Act expansively defines a
 3 trademark as “any word, term, name, symbol, or device, or any combination
 4 thereof” used “to identify and distinguish his or her goods, including a unique
 5 product, from those manufactured or sold by others and to indicate the source of the
 6 goods, even if that source is unknown.” 15 U.S.C. § 1127. The Supreme Court has
 7 observed the breadth of this definition, noting that the Act “describes that universe
 8 in the broadest of terms. . . . Since human beings might use as a ‘symbol’ or
 9 ‘device’ almost anything at all that is capable of carrying meaning, this language,
 10 read literally, is not restrictive.” *Qualitex Co. v. Jacobson Products Co., Inc.*, 514
 11 U.S. 159, 162 (1995).

12 A mark is valid so long as it is capable of distinguishing goods (and, in the
 13 case of trade dress, if it is nonfunctional). *See Skydive Arizona, Inc. v. Quattrocchi*,
 14 2009 WL 6597892 at *18 (D. Ariz. Feb. 2, 2009) (for a mark to be valid, it “must
 15 be distinctive, i.e., capable of distinguishing the applicant’s goods from those of
 16 others.”) (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992));
 17 *Moldex-Metric, Inc. v. McKeon Products, Inc.*, 891 F.3d 878, 881 (9th Cir. 2018)
 18 (“No protection under the Lanham Act is available if the claimed trade dress is
 19 functional.”). In this Circuit, secondary meaning can be established in several
 20 ways, including “direct consumer testimony; survey evidence; exclusivity, manner,
 21 and length of use of a mark; amount and manner of advertising; amount of sales and
 22 number of customers; established place in the market; and proof of intentional
 23 copying by the defendant.” *Filipino Yellow Pages, Inc. v. Asian Journal*
 24 *Publications, Inc.*, 198 F.3d 1143, 1151 (9th Cir. 1999). Consumer confusion is
 25 another factor indicative of secondary meaning. *Transgo, Inc. v. Ajac Transmission*
 26 *Parts Corp.*, 768 F.2d 1001, 1015 (9th Cir. 1985).

27 DSE’s First Amended Complaint alleges with particularity that DSE owns
 28 protectable rights in the DSE Marks: the stylized font used consistently on the front

1 and back covers, spine, and title page of the Dr. Seuss books and the unique
 2 illustration style of the characters and backgrounds found throughout Dr. Seuss
 3 books. (ECF No. 39 at ¶17.) And the undisputed evidence amply supports DSE’s
 4 allegations that the DSE Marks are distinctive and have acquired secondary
 5 meaning in the mind of the public, and are readily associated with DSE.

6 The Dr. Seuss books, which utilize the DSE Marks, are iconic, and among
 7 the most popular children’s books of all time. (SOF ¶ 137.) These books have
 8 topped many bestseller lists, sold over 650 million copies worldwide, and been
 9 translated into more than a dozen languages. (*Id.*) In 2017, DSE was named the
 10 top licensed book brand according to market industry research firm NPD (SOF ¶
 11 159), and the Seussian style is so well-known by the consuming public that
 12 “Seussian” is a defined term in the Merriam-Webster dictionary as the distinct style
 13 emanating from Dr. Seuss. (SOAF ¶ 23.) DSE maintains strict quality control over
 14 its licensees’ use of the DSE Marks, and distributes a Style Guide to ensure
 15 uniformity of style and quality across products authorized to use the DSE Marks.
 16 (SOAF ¶¶ 2-22.)

17 Defendants do not dispute how recognizable the Seussian style has become
 18 in the minds of the public: indeed, each Defendant admitted this fact. (SOAF ¶¶
 19 30-31, 37.) Defendants further admitted that they made a concerted effort to copy
 20 and use the DSE Marks to ensure that *Boldly* would “match the look and feel of
 21 Seuss books.” (SOF 48-50, 61 84; SOAF ¶¶ 29, 36, 38-39, 41-44) Defendants also
 22 intentionally copied the Seussian font of *Go!*’s title to make *Boldly* (and its cover)
 23 look as similar as possible to a Dr. Seuss work.⁵ (SOAF ¶¶ 41-44.) This
 24 intentional copying of the distinctive DSE Marks is evidence that they have
 25 secondary meaning. *See adidas Am., Inc. v. Skechers USA, Inc.*, 890 F.3d 747, 755

26
 27 ⁵ This Court has already found that “[t]he look of the lettering is unquestionably
 28 *Enter.*, 300 F. Supp. 3d at 1090.

1 (9th Cir. 2018) (quoting *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 615
 2 (9th Cir. 1989)).

3 Importantly, the unrebutted Poret Survey demonstrates that when a group of
 4 consumers are shown *Boldly*, and a separate control group are shown version of
 5 *Boldly* that removes only the DSE Marks, a far lower percentage of the control
 6 group believed that *Boldly* is associated with Seuss. (SOAF ¶¶ 63-64.) Having
 7 stripped out this “noise,” Poret showed that 24% of consumers are confused as to
 8 origin *because* Defendants deliberately used the DSE Marks, which is legally
 9 probative of confusion.⁶ (SOAF ¶ 65.) This finding of confusion is demonstrative
 10 of secondary meaning, and thus distinctiveness. *Dr. Seuss Enter., L.P. v. ComicMix*
 11 *LLC*, 300 F. Supp. 3d at 1083 (S.D. Cal. 2017) (distinctiveness can be proven
 12 through secondary meaning); *Brighton Collectibles, Inc. v. Marc Chantal USA,*
 13 *Inc.*, 2009 WL 10674087, at *6 (S.D. Cal. May 12, 2009) (“Consumer confusion is
 14 another factor to show secondary meaning.”). Poret also opines that “the net rate of
 15 24.0% of respondents confusing *Boldly* with Seuss due to the illustration style and
 16 font confirms that there is a significant degree of association of the illustration style
 17 and font with Seuss.” (SOAF ¶ 67.)

18 Defendants contend that secondary meaning cannot attach to an illustration
 19 style or a distinctive font. (Br. at 14-15.) While no reported case has involved
 20 these precise facts, Defendants have conversely cited no decision holding such
 21 marks unprotectible. As shown above, illustrative style and font meet the Lanham
 22 Act’s intentionally broad definition of marks.

23 Defendants also ignore *Romm Art Creations Ltd. v. Simcha Intern., Inc.*, 786

24
 25 _____
 26 ⁶ See, e.g., *adidas*, 890 F.3d at 756–57 (affirming finding of irreparable harm where
 27 survey showed a 20% net confusion rate); *Warner Bros. Entm’t v. Global Asylum,*
 28 *Inc.*, 2012 WL 6951315 (C.D. Cal. Dec. 10, 2012), *aff’d without published opinion*,
 2013 WL 5814731 (9th Cir. Oct. 30, 2013) (recognizing a likelihood of confusion
 based, in part, on a survey showing a net confusion rate of 16-24%).

1 F. Supp. 1126 (S.D.N.Y. 1992), an illustrative case analyzing trademark rights in an
 2 illustration style, which is discussed in the McCarthy treatise Defendants cite.

3 In *Romm*, the court issued a preliminary injunction on plaintiff's Lanham Act
 4 Section 43(a) claims. Plaintiff alleged that the infringing works, comprised of
 5 posters, silk screens or limited editions of reproductions of certain paintings, were
 6 "slavishly similar" to plaintiff's works, prepared with "the intention of causing
 7 potential customers and purchasers to confuse them with [plaintiff's works]," and
 8 sold for the "willful and calculated purpose of trading upon plaintiffs' goodwill"
 9 and "the secondary meaning created by [the artist's] unique and distinctive style
 10 and appearance." *Id.* at 1131. In granting the injunction, the court observed that
 11 "courts have long recognized that recovery under § 43(a) is not restricted to
 12 federally registered trademarks, but extends to 'words, symbols, *collections of*
 13 *colors and designs*, or advertising materials or techniques' that the purchasing
 14 public has come to associate with a single source" and generally found no reason to
 15 reject plaintiff's "artistic style" claims so long as, *inter alia*, secondary meaning
 16 were proven. *Id.* at 1134 (emphasis in original). While plaintiff in *Romm* asserted
 17 unregistered trade dress under Section 43(a) and DSE pleaded its common law
 18 rights under the more general umbrella of "trademark infringement," "[t]he goal of
 19 [both] trademark and trade dress law is to protect the 'public interest in avoiding
 20 consumer confusion.'" *Brighton Collectibles*, 2009 WL 10674087, at *4 (citing
 21 *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir.
 22 2008)).⁷ Relatedly, and in addition to *Romm*, Lanham Act protection has also been
 23 awarded to book covers. *See Bach v. Forever Living Products U.S., Inc.*, 473 F.

24
 25 ⁷ During oral argument on Defendants' second motion to dismiss, DSE explained
 26 that DSE's trademark claims relating to the Seussian style and font are akin to trade
 27 dress. [ECF No. 52, at 12:2-15-6] To the extent the Court characterizes the DSE
 28 Marks as trade dress (a category of trademarks), there is no reasonable dispute that
 they are nonfunctional, and therefore capable of protection so long as secondary
 meaning exists.

1 Supp. 2d 1110, 1122 (W.D. Wash. 2007) (Lanham Act protection afforded to book
 2 cover consisting of “a white seagull in silhouette against a blue background”); *see*
 3 *also, e.g., Harlequin Enterprises Ltd. v. Gulf & Western Corp.*, 644 F.2d 946 (2d
 4 Cir. 1981) (affirming preliminary injunction under § 1125(a) where overall features
 5 of book cover design of “Silhouette Romance” found likely to cause confusion with
 6 cover design of “Harlequin Presents” books); *Hughes v. Design Look Inc.*, 693 F.
 7 Supp. 1500, 1505-1506 (S.D.N.Y.1988) (section 1125[a] applicable in case of fine
 8 art poster calendar).

9 Defendants cite the McCarthy treatise and two cases mentioned in the treatise
 10 as showing that an illustration style cannot function as a source identifier. The
 11 cases that he cites as well as those found in McCarthy are limited to their particular
 12 facts and do not support Plaintiffs’ sweeping generalization. In *Hughes*, 693 F.
 13 Supp. at 1505, the Andy Warhol artworks at issue were never used in association
 14 with the promotion of any goods or services, and the court concluded that “in light
 15 of the fact that the Plaintiffs have to date produced no similar products, indeed no
 16 products at all, bearing similar images, secondary meaning cannot be claimed.” In
 17 *Hartford House, Ltd. v. Hallmark Cards, Inc.*, 846 F.2d 1268 (10th Cir. 1988), the
 18 Tenth Circuit affirmed an injunction and noted in passing that plaintiff was not
 19 seeking to protect an artistic style. In *Leigh v. Warner Bros., a Div. of Time*
 20 *Warner Entertainment Co., L.P.*, 10 F. Supp. 2d 1371 (S.D. Ga. 1998), *aff’d in part,*
 21 *rev’d in part on other grounds*, 212 F.3d 1210 (11th Cir. 2000), plaintiff failed to
 22 show it had used its artwork as a trademark prior to the alleged infringement. And,
 23 in *LandscapeForms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373 (2d Cir. 1997),
 24 plaintiff failed to sufficiently define its trade dress in furniture, describing it
 25 “abstractly” as “at once massive, yet appears to float.” *Id.* at 382.⁸

26
 27 ⁸ *See also Munro v. Lucy Activewear, Inc.*, 2016 WL 5660422, at *4-6 (D. Minn.
 28 Sept. 29, 2016), *aff’d in part, rev’d in part and remanded*, 899 F.3d 585 (8th Cir.
 2018) (Defendants sought to use the Lanham Act to protect entire light display art

1 Because the Lanham Act protects artistic styles when they have been used as
 2 trademarks in connection with goods and services (*e.g.*, books) and DSE has
 3 established secondary meaning in the Seussian illustration style, because the
 4 Lanham Act purposefully defines trademarks broadly, and because there exists
 5 precedent that an artistic style can function as a trademark, Defendants' validity
 6 argument fails.

7 Defendants' validity argument related to the Seussian font fails for similar
 8 reasons. The same trademark treatise cited by Defendants states that "Federal
 9 trademark protection for a distinctive typeface or lettering design would not be
 10 preempted, pursuant to Copyright Act." *See* 2 MCCARTHY ON TRADEMARKS AND
 11 UNFAIR COMPETITION § 12:59 (5th ed. 2018); *see also*, *Star Indus., Inc. v. Bacardi &*
 12 *Co.*, 412 F.3d 373, 382 (2d Cir. 2005) ("[S]tylized shapes or letters may qualify [as
 13 inherently distinctive], provided the design is not commonplace but rather unique or
 14 unusual in the relevant market."); *cf* *The Coca-Cola Co. v. Gemini Rising*, 346 F.
 15 Supp. 1183, 1187 (E.D.N.Y. 1972) (although "the word 'Coca-Cola' as such does
 16 not appear anywhere on the [infringing] poster one would have to be a visitor from
 17 another planet not to recognize immediately the familiar 'Coca' in its stylized script
 18 and accompanying words, colors and design."). Defendants admit that the font is
 19 recognizable as Seussian, which is why they copied it. (SOAF ¶¶ 41-44.) Because
 20 the font uniquely functions as a source identifier, it is entitled to protection.

21 In sum, Defendants' invalidity arguments should be rejected, and partial
 22 summary judgment granted in DSE's favor that the Seussian illustration style and
 23 fonts are protectable as a matter of law. *Elliott v. Google, Inc.*, 860 F.3d 1151,
 24 1162 (9th Cir. 2017), *cert. denied*, 138 S. Ct. 362 (2017) (affirming summary
 25 judgment for Google that its mark is valid).

26 _____
 27 exhibit, not just source identifying aspects of that exhibit); *Galerie Furstenberg v.*
 28 *Coffaro*, 697 F. Supp. 1282, 1289-90 (S.D.N.Y. 1988) (dismissing trademark claim
 related to counterfeit Salvador Dali paintings as the subject of copyright).

3. The *Rogers* Test And The First Amendment Do Not Shield Defendants From DSE's Infringement Claims

After the Court dismissed Count II on *Rogers* grounds, the Ninth Circuit issued its most relevant *Rogers* analysis yet in *Gordon*, 909 F.3d at 257. In *Gordon*, the owner of the trademarks “Honey Badger Don’t Care” and “Honey Badger Don’t Give a Sh—” (the “HBDC Marks”) sued defendants for infringement over the unauthorized use of the HBDC Marks in their greeting cards, a product that is also sold by plaintiff’s licensees. *Id.* at 263. Defendants’ greeting cards used variations on the HBDC Marks, but contained no explicit indication that the cards were created, sponsored, or otherwise endorsed by the owner of the HBDC Marks. *Id.* Defendants’ greeting cards also contained defendants’ own trademark “Recycled Paper Greetings” and listed defendants’ websites. *Id.*

The district court granted summary judgment for defendants, applying the *Rogers* test to bar Gordon’s claims. *Id.* at 264. On *Rogers*’s first prong, the court found that defendants’ greeting cards were expressive works and their use of the HBDC Marks related thereto, and, on *Rogers*’s second prong, found that defendants did not explicitly mislead consumers because it made no affirmative statement of sponsorship by plaintiff and the cards included defendants’ own name and websites. *Gordon v. Drape Creative, Inc.*, No. 15 Civ. 4905, ECF No. 94 (Civil Minutes).

The Ninth Circuit reversed and remanded. It held that while greeting cards qualify as expressive works, satisfying *Rogers*’s first prong, a triable issue of fact existed on *Rogers*’s second prong with regard to whether defendants’ use of the HBDC Marks explicitly misleads consumers. *Gordon*, 909 F.3d at 268. In so holding, *Gordon* noted that, in applying *Rogers*’s second prong, courts “must remain mindful of the purpose of the *Rogers* test, which is to balance ‘the public interest in avoiding consumer confusion’ against ‘the public interest in free expression.’” *Id.* at 269 (quoting *Rogers*, 875 F.2d at 999). The Court further noted that *Rogers*’s second prong “is not a mechanical test,” and that “‘all of the

1 relevant facts and circumstances’ must be considered.” *Id.* (quoting *Rogers*, 875
 2 F.2d at 1000 n.6.) Thus, *Gordon* “reject[ed] the district court’s rigid requirement
 3 that, to be explicitly misleading, the defendant must make an ‘affirmative statement
 4 of the plaintiff’s sponsorship or endorsement.’” *Id.* at 269.

5 *Gordon* distinguished the Ninth Circuit’s prior *Rogers* decisions by pointing
 6 out that in those cases where dismissal was affirmed, the “mere use of a trademark
 7 alone” did not suffice to make such use explicitly misleading because in those cases
 8 “it was clear that consumers would not view the mark alone as identifying the
 9 source of the artistic work.” *Id.* at 270. But such reasoning, according to *Gordon*,
 10 “does not extend to instances in which consumers *would* expect the use of a mark
 11 alone to identify the source.” *Id.* (emphasis in original).

12 *Gordon* explained that “[a] more relevant consideration is the degree to
 13 which the junior user uses the mark in the same way as the senior user.” *Id.* In the
 14 Ninth Circuit’s prior *Rogers* decisions, “the junior user has employed the mark in a
 15 different context—often in an entirely different market—than the senior user.” *Id.*
 16 (“consumers would not view the mark alone as identifying the source of the artistic
 17 work” because consumers would not expect that a song or a photograph titled
 18 “Barbie” was created by Mattel, or that a strip club owner produced a video game).
 19 Where the junior user uses the mark in the same market and location as the senior
 20 user, as the defendant did in *Gordon*, “such identical usage could reflect the type of
 21 ‘explicitly misleading description’ of source that *Rogers* condemns.” *Id.* (quoting
 22 *Rogers*, 875 F.2d at 999–1000). Notably, *Gordon* cautioned against “reflexively
 23 apply[ing] *Rogers*’s second prong [to excuse infringement] in this circumstance,”
 24 because such an application “would turn trademark law on its head.” *Id.* at 270.

25 The facts of this case mirror those found in *Gordon*, and Defendants’ motion
 26 should be denied for the same reasons that the Ninth Circuit reversed the *Gordon*
 27 summary judgment grant. It is undisputed that *Boldly*, like *Go!* and the other Dr.
 28 Seuss books, is an illustrated book, *i.e.*, Defendants have employed the DSE Marks

1 in the exact same context that DSE and its authorized licensees regularly employ
 2 the DSE Marks. (SOAF ¶¶ 6, 17, 28, 36, 39, 41-44, 48-54.) And as discussed in
 3 DSE’s motion for summary judgment, and above in Sec. III(A)(2)(b), *Boldly* was
 4 designed to serve the exact same market by slavishly copying *Go!* and the DSE
 5 Marks therein in order to compete for graduation business through the same
 6 channels of trade. (SOF ¶¶ 54, 100-101, 141, 148; SOAF ¶¶ 49-54.)

7 This is not a case where Defendants made a “disparate use” of the DSE
 8 Marks, *Gordon*, 909 F.3d at 270; rather Defendants and DSE both use the DSE
 9 Marks in highly similar artistic expressions, on books destined for the same market,
 10 and often where books are bought as a gift (and the familiarity of the illustration
 11 style and font would be a particularly strong selling point to the purchaser).
 12 Accordingly, “the potential for explicitly misleading usage is especially strong.”
 13 *Id.* at 270. Defendants’ assertion that their use of the DSE Marks “is both in a
 14 different manner, and with a different market function than the ‘Dr. Seuss’ books”
 15 (Br. at 18) ignores the evidence and *Gordon*’s holding. To the contrary, in light of
 16 the look and feel of *Boldly* (an illustrated work), which uses the DSE Marks,
 17 Defendants’ slavish copying of every aspect of the DSE works, and their plans to
 18 sell *Boldly* through the same channels of trade and to the same market of graduation
 19 gift buyers, a reasonable jury could easily conclude that Defendants’ unauthorized
 20 use of the DSE Marks in *Boldly* is explicitly misleading as to its source despite the
 21 absence of an affirmative statement that DSE published or authorized the book.

22 Defendants’ minimization of their use of the DSE Marks as “only one
 23 component of Defendants’ larger expressive creation,” is wrong and ignores the
 24 undisputed record. Defendants admitted to their concerted effort to utilize the DSE
 25 Marks to ensure that *Boldly* would “match the look and feel of Seuss books.”
 26 (SOAF ¶¶ 36, 44) Hauman hired Templeton because he wanted to illustrate *Boldly*
 27 in a “Seussian style.” (SOF ¶ 28-29, 31; SOAF ¶ 34.) Defendants also set out to
 28 make *Boldly*’s cover match the look and feel of a Seuss book by copying the

1 artwork and using the “Seussian font.” (SOF ¶¶ 49, 52; SOAF ¶¶ 29, 40-44)
 2 Templeton drew the lettering of the *Boldly* cover by hand, slavishly copying “as a
 3 model” the font on the cover of *Go!*. (SOF ¶ 49; SOAF ¶¶ 40, 43.) Defendants’
 4 publishing partner, AMP, even pushed Defendants to create a cover for *Boldly* that
 5 was “one that more closely resembles the original [*Go!*].” (SOAF ¶ 45.).

6 This case is not at all like *E.S.S.* because Defendants’ use of the DSE Marks
 7 was hardly “incidental to the overall story” of *Boldly*, and *Boldly*’s “Seussian” look
 8 and feel is, by Defendants’ admissions, its “main selling point.” *Cf. E.S.S.*, 547
 9 F.3d at 1100-01. (SOF ¶ 38.) This case is also not at all like *Brown* because the
 10 Defendants do not use “thousands” of other marks in order to create a universe with
 11 verisimilitude. Defendants stole from two, and only two, properties: Seuss and *Star*
 12 *Trek*. And the DSE Marks are deliberately placed front and center. *Brown v.*
 13 *Electronic Arts, Inc.*, 724 F.3d 1235, 1244-46 (9th Cir. 2013). In stark contrast to
 14 this Circuit’s prior *Rogers* decisions, *Boldly*’s cover and its extensive use of the
 15 DSE Marks, explicitly and intentionally fosters consumer misunderstanding.

16 In sum, DSE has introduced substantial evidence from which a jury could
 17 conclude that Defendants’ use of the DSE Marks in *Boldly* is explicitly misleading.
 18 *Gordon* clarifies that an absence of an “affirmative” statement of DSE’s
 19 sponsorship or endorsement, and the inclusion of Defendants’ names in *Boldly*, is
 20 by no means dispositive of *Rogers*’s second prong, especially where the marks are
 21 both used on illustrated books aimed at the same market. Defendants are therefore
 22 not entitled to summary judgment and their motion should be denied.

23 **IV. CONCLUSION**

24 For the foregoing reasons, the Court should deny Defendants’ motion, and
 25 should enter partial summary judgment (1) rejecting the fair use defense and
 26 holding that Defendants have infringed DSE’s copyrights, and (2) declaring and
 27 determining that the DSE Marks are protectable pursuant to Fed. R. Civ. P. 56(f).
 28 Finally, the Court should direct a jury trial on Defendants’ *Rogers* defense.

1 Dated: January 3, 2019

Respectfully submitted,

2 By /s/ Tamar Duvdevani

3 TAMAR DUVDEVANI

4 DLA Piper LLP (US)

Attorneys for Plaintiff

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16 **UNITED STATES DISTRICT COURT**
17 **SOUTHERN DISTRICT OF CALIFORNIA**

18 **DR. SEUSS ENTERPRISES, L.P.,**

19 Plaintiff,

20 v.

21 **COMICMIX LLC; GLENN**
22 **HAUMAN; DAVID JERROLD**
23 **FRIEDMAN a/k/a DAVID**
24 **GERROLD; and TY**
25 **TEMPLETON,**

26 Defendants.

Case No.: 3:16-cv-02779-JLS-BGS

**DEFENDANTS' REPLY IN SUPPORT
OF THEIR MOTION FOR
SUMMARY JUDGMENT [ECF No.
108]**

Assigned to Hon. Janis L. Sammartino
United States District Judge

Hearing Date: February 7, 2019

Hearing Time: 1:30 p.m.

Hearing Place: Schwartz Courthouse,
Courtroom 4D

Pursuant to CivLR 7.1(e)(3) and the Court’s Order Setting Briefing Schedule on Motions for Summary Judgment and *Daubert* Motions (ECF No. 111), Defendants ComicMix LLC (“ComicMix”), Glenn Hauman (“Hauman”), David Gerrold (“Gerrold”), and Ty Templeton (“Templeton”) (collectively “Defendants”) hereby file this reply in further support of their Motion for Summary Judgment (“MSJ”; ECF No. 108), to address Plaintiff Dr. Seuss Enterprises, L.P.’s (“DSE”) memorandum in opposition thereto (ECF No. 119; “Opposition” or “Opp.”).

A. The Court should grant judgment to Defendants on the copyright claims.

DSE contends that because the MSJ focuses on the fair use defense, “Defendants effectively concede DSE’s *prima facie* case of infringement.” Opp. p. 16. Defendants do not contest that their unpublished book *Oh, the Places You’ll Boldly Go!* (“*Boldly*”) makes use of elements of Dr. Seuss works. But as a matter of law, “fair use is not an infringement.” *Lenz v. Univ. Music Corp.*, 815 F.3d 1145, 1153 (9th Cir. 2016); 17 U.S.C. § 107. And as Defendants have shown, at least one of the allegedly infringed works, the *Sneetches* illustration and story “The Zax,” derives from work in *Redbook* that has entered the public domain. See ECF No. 120 pp. 8-9. The 1961 registration and 1989 renewal of the copyright for the *Sneetches* book, ECF No. 107-6 & 107-7, did not cure the failure to timely renew the *Redbook* copyrights, which cast the original versions of those works into the public domain. DSE cannot make out a *prima facie* infringement claim based on public domain elements of works like “The Zax.” See *Cooling Sys. & Flexibles v. Stuart Radiator, Inc.*, 777 F.2d 485, 490-91 (9th Cir. 1985) (citing 17 U.S.C. § 103(b)).

DSE gives the Court no reason to disturb its findings as to the first three fair use factors, and no reason to doubt that the fourth factor favors fair use.

DSE asserts that under the first factor, its summary judgment motion showed that *Boldly* is commercial, “not transformative,” developed “in bad faith,” and “violates DSE’s right to created derivative works.” Opp. p. 17. While *Boldly* is commercial, DSE adduced no evidence to undermine the Court’s finding that it is

1 highly transformative. DSE’s flat assertion that *Boldly* and *Go!* share “the same
 2 purpose and function” because both are entertaining, illustrated, and uplifting
 3 books, is not evidence. ECF No. 107-1 pp. 21-22. Upon reviewing *Boldly*, the
 4 Court rightly found that it “serves a different market function” than *Go!*, appealing
 5 to people who have already read Dr. Seuss. *ComicMix I*, at 1108. DSE’s assertion
 6 of bad faith, based on Defendants making use of Dr. Seuss elements and seeking to
 7 publish their mashup, “does not hint at any fact that would support a finding that
 8 Defendants believed *Boldly* was anything but a fair use.” ECF No. 120 pp. 17-18.
 9 And DSE’s contention that *Boldly* is simply a derivative work, not transformative,
 10 because it (1) exists and (2) “substantially incorporates protected material from
 11 DSE Works,” would disqualify any third-party work from fair use. *Id.* p. 17
 12 (quoting ECF No. 107-1 p. 24).

13 As for the third factor, DSE posits that Defendants “took more than
 14 necessary” to create their mashup because (again) of “the substantiality of the
 15 taking from DSE,” and because after they were sued, Defendants discussed whether
 16 they could have taken less and achieved the same results. See ECF No. 107-1 p. 26.
 17 But that does not alter the calculus. DSE’s evidence shows that Defendants had
 18 concluded that taking less, to make *Boldly* less visually reminiscent of *Go!* or the
 19 other Seuss books, would have undermined its purposes. See, e.g., Declaration of
 20 Tamar Duvdevani (ECF No. 107-22; “TD Decl.”) Ex. 68, ECF No. 107-64.

21 Nothing in DSE’s Opposition or DSE’s own motion for summary judgment
 22 would justify the Court altering its analysis of the first three fair use factors. And
 23 now that evidence is in, the fourth factor analysis must be found to support fair use.

24 DSE seeks to avoid its obligation to muster some evidence of market harm.
 25 Opp. p. 18. Because *Boldly* has not been published, it is insufficient for DSE to rest
 26 on speculation and offer no expert testimony on market harm. See, e.g., *Universal*
 27 *City Studios, Inc. v. Sony Corp. of Am.*, 480 F. Supp. 429, 439-40 (C.D. Cal. 1979)
 28 (noting plaintiffs had presented, in the absence of any existing evidence of injury,

1 “extensive expert testimony at trial on the issue of prospective harm”); see *id.* at
 2 451-52. In *Sony* (the “Betamax” case), the plaintiffs “were unable to prove that the
 3 practice [of ‘time-shifting’ TV programs by videotaping them for later viewing] has
 4 impaired the commercial value of their copyrights or has created any likelihood of
 5 future harm.” *Sony Corp. of Am. v. Universal Studios, Inc.*, 464 U.S. 417, 421
 6 (1984). “What is necessary is a showing by a preponderance of the evidence that
 7 future harm will result. If the intended use is for commercial gain, that likelihood
 8 may be presumed. But if it is for a noncommercial purpose, the likelihood must be
 9 demonstrated.” *Id.* at 451. The same principle applies in the case of a highly
 10 transformative work like *Boldly*; potential market harm cannot be presumed, so it
 11 must be shown. *ComicMix II*, at 1082. And where the plaintiff offers no evidence
 12 that the defendant’s use “harmed any existing market or a market that [the plaintiff]
 13 was likely to develop,” any evidence that the defendant’s use “did not perform the
 14 same ‘market function’ as the original” will tip the fourth factor in favor of fair use.
 15 *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1179 (9th Cir. 2013).

16 DSE contends that “*Boldly* was designed to serve the exact same market
 17 function as *Go!*.” Opp. p. 18. But *Go!* is a children’s book; DSE and its publisher,
 18 Random House Children’s Books, agree that it is “[REDACTED].” TD
 19 Decl. Ex. 97. *Boldly* was designed and touted on Kickstarter as “a parody mash-up
 20 ... that brings together two of the most beloved creations in history ... that’s
 21 familiar and brand new at the same time.” TD Decl. Ex. 40, ECF No. 107-50 p. 3.
 22 As *Boldly* author (and *Star Trek* scriptwriter) David Gerrold testified, “Dr. Seuss’
 23 demographic is everybody up to seven or eight years old,” while *Star Trek* “is for a
 24 very adult demographic. ... Now we understood that this kind of Star Trek/Dr.
 25 Seuss mashup would not work for kids who have not seen this episode. We’re not
 26 competing with Dr. Seuss’ book, we’re doing this thing for adults who are familiar
 27 with all the episodes ... it was intended as an adult parody of a kids book[.]” TD
 28 Decl. Ex. 2, ECF No. 107-24 at 43:3-45:1.

1 As the Court determined on first viewing *Boldly*, its “market relies on
 2 consumers who have already read and greatly appreciated *Go!* and Dr. Seuss’s
 3 other works, and who simultaneously have a strong working knowledge of the *Star*
 4 *Trek* series.” *ComicMix I*, at 1108. Consumers in that incidental, secondary market
 5 have left the primary market for *Go!* (and *Sneetches* and *Grinch*) so “*Boldly* does
 6 not substitute for the original and serves a different market function than *Go!*” *Id.*

7 Defendant’s expert economics witness Dr. Joshua Gans found evidence
 8 supporting the Court’s initial finding, and further suggesting that “far from having a
 9 detrimental effect on Dr. Seuss products, *Boldly* is reasonably likely to have a
 10 positive impact on sales of Dr. Seuss books, including *Go!* and the other Seuss
 11 books.” ECF No. 110-1 (“Gans Report”) p. 10. He found that other books that make
 12 transformative use of Dr. Seuss books are likely complements to Dr. Seuss books,
 13 not substitutes for them. *Id.* pp. 10-12. Such transformative books are, according to
 14 Amazon, “frequently bought together” with the original Dr. Seuss books; Amazon
 15 further reports that customers who bought the later work “also bought” the original.
 16 *Id.* p. 12. Dr. Gans reasonably finds Amazon’s statements of such joint purchases
 17 provides evidence “that *Go!* and the other Seuss books, and works derivative or
 18 transformative thereof [like *Boldly*], are likely to serve as complements rather than
 19 substitutes in the eyes of consumers.” *Id.* at p. 13.

20 DSE has offered no evidence that other unlicensed complements have had
 21 any negative effect on the market for Dr. Seuss books or its derivative works. See
 22 ECF No. 108-1 pp. 10-11. The *Grinch* parody play *Who’s Holiday* premiered on
 23 Broadway in late 2017 after overcoming DSE’s cease-and-desist letters. DSE was
 24 nevertheless able to license *The Grinch*, a derivative film that premiered in late
 25 2018, reportedly the highest-grossing holiday film of all time. In April 2017, DSE’s
 26 own publisher made a featured title of a *Go!* parody book, *Oh, the Meetings You’ll*
 27 *Go To!*. It has not limited DSE’s ability to capitalize on *Go!* with more derivative
 28 works. See TD Decl. Ex. 108 pp. 12-13; see also ECF No. 107-2 ¶¶ 143-144.

1 DSE contends that “Defendants themselves sought to make *Boldly* a
 2 substitute purchase for *Go!* in the graduation gift market.” Opp. p. 21. It offers no
 3 basis to ascribe the intentions of third parties to Defendants. DSE presents evidence
 4 that Defendants’ intended publishing partner Andrews McMeel Publishing
 5 discussed certain publishing plans for *Boldly* in internal emails to which Defendants
 6 were not privy (and still are not, because they are designated Highly Confidential-
 7 Attorney’s Eyes Only). See TD Decl. Ex. 47, 48, 49, 57, 58. Until DSE intervened,
 8 all evidence is that Defendants and Andrews McMeel sought to fulfill the
 9 Kickstarter orders, and their one purchase order from ThinkGeek, by Christmas
 10 2016, not graduation time. See ECF No. 120 pp. 5-6 & 14. When ThinkGeek could
 11 not get the book sooner, it wanted *Boldly* in time for 2017 graduations. See *id.* p.
 12 14; TD Decl. Ex. 3 at 184:2-16. But Hauman would only entertain the possibility of
 13 such post-complaint sales “if the ruling comes down in our favor.” ECF No. 120 p.
 14 19; TD Decl. Ex. 66, ECF No. 107-62. Evidence that he hoped to belatedly fulfill
 15 ThinkGeek’s Christmas order does not show that Defendants wanted *Boldly* to
 16 compete as a graduation gift.

17 Any evidence DSE mustered to indicate a potential market harm does not
 18 overcome Defendants’ showing that any market effects would likely be benign and
 19 limited. DSE’s Opposition simply ignores the point that *Boldly* would operate in a
 20 “fair use market” for readers who enjoy the creative freedom of unlicensed
 21 mashups, unlikely to interfere with DSE’s potential derivative market for a licensed
 22 “collab.” ECF No. 108-1 pp. 12-13; ECF No. 120 pp. 22-25. And DSE does not
 23 address, or overcome, the broader interests that copyright and fair use serve to
 24 protect: to “promote the Progress of Science and useful Arts,” as provided by the
 25 Progress Clause, U.S. Const. Art. 1, § 8, cl. 8; to “stimulate artistic creativity for the
 26 general public good,” *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156
 27 (1975); and to free up productive uses from the gauntlet of negotiating restrictive
 28 licenses, see ECF No. 120 p. 25. “[I]f fair use was not viable in a case such as this,

1 an entire body of highly creative work would be effectively foreclosed.” *ComicMix*
 2 *I*, at 1108-09. The Copyright Act “limits the rights of a copyright owner regarding
 3 works that build upon, reinterpret, and reconceive existing works.” *Id.* (quoting
 4 *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 799 (9th Cir. 2003)). To
 5 serve the purposes of copyright, any close call must weigh in favor of fair use.

6 And this is no close call. There is a paucity of evidence that *Boldly* might
 7 harm a reasonably likely potential market for DSE. The first and fourth factors,
 8 “generally viewed as the most important factors,” *Seltzer*, 725 F.3d at 1179, both
 9 weigh in favor of fair use. The second, least significant factor (*Walking Mountain*,
 10 353 F.3d at 803) weighs at most slightly against, and the third is neutral. Viewing
 11 all factors together in light of the purposes of copyright, the Court should find that
 12 fair use supports *Boldly* and grant Defendants judgment on the copyright claims.

13 **B. The Court should grant judgment to Defendants on the trademark claims.**

14 DSE claims trademark rights in Dr. Seuss’s general “illustration style,” and
 15 in a “stylized font” found on the cover of Dr. Seuss books other than *Go!*. But the
 16 former is not protectable, and the latter is not used by *Boldly*. The expert report,
 17 grounded on the notion that the style and font are both trademarks at issue, is
 18 wholly irrelevant. And the *Rogers* test protects *Boldly*. Under *Rogers*, when the
 19 defendant shows that “its allegedly infringing use is part of an expressive work
 20 protected by the First Amendment ... then the plaintiff claiming trademark
 21 infringement bears a heightened burden ... [It] must show (1) that it has a valid,
 22 protectable trademark, and (2) that the mark is either not artistically relevant to the
 23 underlying work *or* explicitly misleading as to the source or content of the work.”
 24 *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264-65 (9th Cir. 2018). DSE puts
 25 forth no factual issue to meet its burden and salvage its trademark claims.

26 If DSE’s claimed “illustration style of the characters and backgrounds found
 27 throughout Dr. Seuss books” mark was valid, it would include everything on every
 28 page of every Dr. Seuss book except their text. DSE still “does not allege trademark

1 rights in any specific character or background image,” which is all that a trademark
 2 could plausibly protect. *ComicMix II*, at 1086. Trademarks are specific words or
 3 designs, not an overall illustration “style” protected by copyright law.

4 Courts routinely dismiss “endeavors to enforce what is at best a copyright
 5 claim through the mechanism of trademark protection.” *Galerie Furstenburg v.*
 6 *Coffaro*, 697 F. Supp. 1282, 1290 (S.D.N.Y. 1988). DSE may not expand its time-
 7 limited copyrights into potentially infinite trademark rights. “To allow the first
 8 producer of such pictures to prevent others from copying them, save as he can
 9 invoke the Copyright Law, would sanction a completely indefensible monopoly.”
 10 *Nat’l Comics Publs., Inc. v. Fawcett Publs., Inc.*, 191 F.2d 594, 603 (2d Cir. 1951)
 11 (affirming dismissal of unfair competition claim). “[E]xtending trademark
 12 protection to a particular style of artistic expression would improperly extend
 13 trademark law into the area of copyright protection.” *Munro v. Lucy Activewear,*
 14 *Inc.*, Civ. No. 16-79, 2016 U.S. Dist. LEXIS 135692, *17 (D. Minn. Sept. 29,
 15 2016), *aff’d in pertinent part*, 899 F.3d 585, 590 (8th Cir. 2018) (“copyright, not
 16 trademark, protects artistic and creative ideas and concepts”).

17 DSE gives no good reason why the Court should be the first to find that an
 18 illustration style is proprietary under trademark law, after so many other courts and
 19 the leading treatise have determined that it cannot be. The case DSE cites for the
 20 principle, *Romm Art Creations v. Simcha Int’l, Inc.*, 786 F. Supp. 1126 (E.D.N.Y.
 21 1992), was decided “without directly addressing the issue of whether an artist’s
 22 visual style can be considered a trademark” and to the extent it is construed to stand
 23 for that proposition, *Romm Art* “is contrary to the basic tenets of trademark law.”
 24 *Leigh v. Warner Bros.*, 10 F. Supp. 2d 1371, 1381 (S.D. Ga. 1998), *aff’d in*
 25 *pertinent part*, 212 F.3d 1210 (11th Cir. 2000). DSE mentions that McCarthy’s
 26 treatise discusses the case but notably fails to convey what it says: that *Romm Art* is
 27 “a unique result that seriously impinges on the copyright law’s policy that artistic
 28 style is no one’s exclusive property.” McCarthy on Trademarks at 8:6 n.9.

1 A style is part and parcel of the goods; an inseparable element of the content
 2 that exists “not as a separate and distinct mark *on the good*, but, rather, as the good
 3 itself.” *Leigh*, 212 F.3d at 1218 (quoting *Rock & Roll Hall of Fame & Museum, Inc.*
 4 *v. Gentile Prods.*, 134 F.3d 749, 754 (6th Cir. 1998)). The copyrightable content of
 5 Dr. Seuss books is not a set of DSE trademarks, any more than footage of Larry
 6 Fine and Curly and Moe Howard is cognizable as “a collection of trademarks of
 7 The Three Stooges.” *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593,
 8 596 (9th Cir. 2000). “The Lanham Act “‘does not protect the content of a creative
 9 work of artistic expression’ because an ‘artist’s right in an abstract design or other
 10 creative work’ is protected by copyright law.” *Ward v. Andrews McMeel Publ’g,*
 11 *LLC*, 963 F. Supp. 2d 222, 235 (S.D.N.Y. 2013) (quoting *EMI Catalogue P’ship v.*
 12 *Hill, Holliday, Connors, Cosmopolos Inc.*, 228 F.3d 56, 63 (2d Cir. 2000)).

13 DSE claims a multitude of “elements that comprise the style” of Dr. Seuss:
 14 his pencil and ink work, and the appearances of his characters, buildings, machines,
 15 backgrounds, and landscapes. Opp. p. 11. Those are all elements of the copyrighted
 16 illustrations; calling them elements of a trademark “style” does not extend DSE’s
 17 proprietary rights past what copyright protects. See *Leigh*, 10 F. Supp. 2d at 1381-
 18 82. Much of Dr. Seuss’s illustration work with those copyrighted elements is in the
 19 public domain or is otherwise not DSE property. See ECF No. 120 p. 9; *Geisel v.*
 20 *Poynter Prods.*, 295 F. Supp. 331, 354 (S.D.N.Y. 1968) (“Despite the fantastic and
 21 imaginary character of [Dr. Seuss’s] cartoon animals ... some of their ‘component
 22 parts’ exist in nature[.]”). Dr. Seuss’s style, as displayed in public domain *Redbook*
 23 works like “The Zaks,” is not a proper basis for DSE’s trademark claims. See
 24 *Chamberlain v. Columbia Pictures Corp.*, 186 F.2d 923 (9th Cir. 1951) (affirming
 25 dismissal of claim of unfair competition over public domain Mark Twain story).

26 The alleged “stylized font” trademark claim fails for the same reason—and
 27 because *Boldly* does not use that “Seuss font.” DSE alleges that *Boldly* infringes on
 28 a “font used consistently on the front and back covers, spine, and title page of Dr.

Seuss books.” ECF No. 39 ¶ 17. DSE’s Style Guide undercuts that. DSE claims it created proprietary, source-indicative fonts as replicas of Dr. Seuss’s lettering style. Opp. p. 11; ECF No. 119-1, DSE Statement of Additional Facts (“DSE SOAF”) ¶¶ 4-7 & 11-13. DSE’s president and Rule 30(b)(6) designee Susan Brandt testified, “ [REDACTED] [REDACTED].” TD Decl. Ex. 4 (“Brandt Transcript”) at 256:10-16, 258:3-16. The Style Guide provides several “custom fonts” and identifies when to use them. DSE SOAF ¶¶ 11-12. [REDACTED] [REDACTED] TD Decl. Ex. 85 (“Style Guide”) p. 13. [REDACTED] Brandt Transcript at 319:19-320:8; see DSE003599 (Style Guide p. 11). But [REDACTED] the font in which the title of *Go!* appears on its cover is not that “Seuss font,” which is thinner and blockier. [REDACTED] [REDACTED] So the font on the cover of *Go!* is not the allegedly infringed font used “consistently” on Dr. Seuss books. The “Seuss font” [REDACTED] is on the cover, spine, and title page of, for example, *Grinch* and *Sneetches* (TD Decl. Ex. 10 & 11; see also ECF No. 69-3); and some DSE-licensed derivative works (see TD Decl. Ex. 109, 111, 115-117). But it is not used on the cover, spine, or title page of *Go!*, licensed derivatives of *Go!*, or, critically, *Boldly*. See TD Decl. Ex. 9, 31, 100-106.

DSE’s trademark claim relies on an expert witness report premised on the presumption that “DSE could potentially establish trademark rights in the Dr. Seuss illustration style and font.” ECF No. 119-3 p. 4. “The survey was specifically designed to scientifically assess the extent to which the illustration style and font of *Boldly* causes consumers to mistakenly believe that *Boldly* is created or published by, or is sponsored or endorsed by, Seuss.” *Id.* p. 7 (emphasis in original). But Seussian style is not protectable per se as a mark, and the “Seuss font” is not used

1 on or in *Boldly*. DSE’s mistakes of law and fact infect DSE’s expert report, leaving
 2 it too fatally flawed to pose any obstacle to summary judgment for Defendants.¹

3 And the trademark claims are absolutely subject to dismissal under *Rogers*.
 4 The test is simple: trademarks used in an expressive work like *Boldly* do not violate
 5 the Lanham Act if they have at least some artistic relevance, unless they explicitly
 6 mislead as to their source or content. *Mattel, Inc. v. MCA Records*, 296 F.3d 894,
 7 902 (9th Cir. 2002); see *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d
 8 1095, 1099 (9th Cir. 2008) (extending *Rogers* to the body of expressive works).
 9 Seussian style and a Seussian font are artistically relevant to a Seuss/*Star Trek*
 10 mashup. *Boldly* does not explicitly mislead; it explicitly disclaims any association
 11 with or endorsement from DSE). And it does not use DSE’s alleged marks “in the
 12 same way” as DSE. *Gordon*, 909 F.3d at 270. *Boldly* uses no Dr. Seuss characters,
 13 unlike any Dr. Seuss book or DSE-licensed derivative book that DSE has identified.
 14 It uses Seussian style to illustrate *Star Trek* tropes and riff on the interplay between
 15 the two creative universes (e.g., “boldly go”), themes not found in *Go!* or other Dr.
 16 Seuss books and DSE works. The alleged marks are “used as only one component
 17 of [Defendants’] larger expressive creation,” *id.* at 271, in connection with *Star*
 18 *Trek* references and original text and artwork; as DSE put it, “combining the DSE
 19 Works with *Star Trek* intellectual property.” ECF No. 107-1 p. 28. DSE concedes it
 20 has made no such use in collaboration with CBS Studios. *Id.* Under *Rogers*, *Mattel*,
 21 and *Gordon*, DSE’s dubious trademarks cannot prevent Defendants’ First
 22 Amendment right to create *Boldly* and go where no DSE collab has gone before.

23 The Court should enter summary judgment for Defendants on all claims.
 24

25
 26 ¹ The expert report’s other fatal flaws would render its probative value too minimal
 27 to overcome its prejudicial effect. It relies on a “Control Group” version of *Boldly*,
 28 redrawn “by an artist associated with DSE,” Opp. p. 9, with exaggerated stylistic
 quirks, in a disingenuously naïve, rough-edged, outsider-art style that survey
 respondents, unsurprisingly, were less likely to think DSE sponsored.

1 Dated: January 14, 2019

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16 **CERTIFICATE OF SERVICE**

17 I hereby certify that on this January 14, 2019 I electronically filed the
18 foregoing document by using the Court's ECF system, thereby causing a true copy
19 thereof to be served upon counsel of record for Plaintiff Dr. Seuss Enterprises, L.P.,
20 as identified on the Notice of Electronic Filing.

21 /s/ Dan Booth