

1 Dan Booth (MA Bar No. 672090)
2 BOOTH SWEET LLP
3 32R Essex Street
4 Cambridge, MA 02139
5 dbooth@boothsweet.com
6 (617) 250-8602
7 *Pro Hac Vice Pending*

8 Michael Licari (SBN 265241)
9 D'EGIDIO LICARI & TOWNSEND, APC
10 5402 Ruffin Road, Suite 209
11 San Diego, CA 92123
12 mlicari@deltlaw.com
13 (619) 550-3011
14 *Local Counsel*

15 *Attorneys for Defendant ComicMix LLC*

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 TEMPLETON,**

25 Defendants.

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

MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT OF
COMICMIX LLC'S MOTION TO
DISMISS PURSUANT TO FED. R.
CIV. P. 12(b)(6)

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

Hearing Date: March 16, 2017
Hearing Time: 10:00 a.m.
Hearing Place: Schwartz Courthouse,
Courtroom 4A

TABLE OF CONTENTS

1

2 **Table of Contents** **ii**

3 **Table of Authorities** **iii**

4 **I. Introduction: *Oh, the Uses Seuss Sues!*** **1**

5 **II. Applicable Legal Standards** **1**

6 **a. Federal Rule of Civil Procedure 12(b)(6)** **1**

7 **b. 17 U.S.C. § 107 - Fair Use Under Copyright Law** **2**

8 **c. Nominative Fair Use Under Trademark Law** **2**

9 **III. Statement of Material Facts** **3**

10 **IV. Argument** **5**

11 **a. The Court may resolve the issue of fair use upon this motion.** **6**

12 **b. ComicMix’s book is a non-infringing fair use under copyright law.** **7**

13 **i. Copyright law limits the scope of DSE’s claims.** **7**

14 **ii. Any use of protected elements of DSE’s works in *Boldly* is a**

15 **fair use.** **9**

16 **1. First Factor: The Purpose and Character of the Use** **10**

17 **2. Second Factor: The Nature of the Copyrighted Work** **16**

18 **3. Third Factor: The Amount and Substantiality of the Work Used** **17**

19 **4. Fourth Factor: The Effect on the Market for the Copyrighted**

20 **Work** **18**

21 **c. ComicMix’s book is not an infringement under trademark law.** **19**

22 **V. Conclusion** **24**

23

24

25

26

27

28

TABLE OF AUTHORITIES

Cases

1		
2		
3	<i>Acad. of Motion Picture Arts & Sciences v. Creative House</i>	
4	<i>Promotions, Inc.</i> , 944 F.2d 1446 (9th Cir. 1991)	3
5	<i>Acuff-Rose Music, Inc. v. Campbell</i> , 972 F.2d 1429 (6th Cir. 1992)	11
6	<i>Am. Express Co. v. Goetz</i> , 515 F.3d 156 (2d Cir. 2000)	20
7	<i>AMF, Inc. v. Sleekcraft Boats</i> , 599 F.2d 341 (9th Cir. 1979)	2
8	<i>Application of Cooper</i> , 45 C.C.P.A. 923, 254 F.2d 611 (C.C.P.A. 1958)	23
9	<i>Ashcroft v. Iqbal</i> , 556 U.S. 662 (2009)	1
10	<i>Bateman v. Mnemonics, Inc.</i> , 79 F.3d 1532 (11th Cir. 1996)	9
11	<i>Bell Atl. Corp. v. Twombly</i> , 550 U.S. 544 (2007)	1, 2
12	<i>Bill Graham Archives v. Dorling Kindersley Ltd.</i> , 448 F.3d 605 (2d Cir. 2006)	17
13	<i>Bradbury v. CBS</i> , 287 F.2d 478 (9th Cir. 1961)	8
14	<i>Branch v. Tunnell</i> , 14 F.3d 449 (9th Cir. 1994)	4
15	<i>Brownmark Films, LLC v. Comedy Partners</i> , 682 F.3d 687 (7th Cir. 2012)	6
16	<i>Cairns v. Franklin Mint Co.</i> , 292 F.3d 1139 (9th Cir. 2002)	2, 3, 11, 23
17	<i>Cavalier v. Random House, Inc.</i> , 297 F.3d 815 (9th Cir. 2002)	8
18	<i>Campbell v. Acuff-Rose Music, Inc.</i> , 510 U.S. 569 (1994)	<i>passim</i>
19	<i>Campbell v. Walt Disney Co.</i> , 718 F. Supp. 2d 1108 (N.D. Cal. 2010)	5, 6, 11
20	<i>Cleary v. News Corp.</i> , 30 F.3d 1255 (9th Cir. 1994)	3
21	<i>Cliff's Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc.</i> ,	
22	886 F.2d 490 (2d Cir. 1989)	24
23	<i>Closed Loop Mktg. v. Closed Loop Mktg., LLC</i> ,	
24	589 F. Supp. 2d 1211 (E.D. Cal. 2008)	4
25	<i>Columbia Pictures Corp. v. Nat'l Broad. Co.</i> ,	
26	137 F. Supp. 348, 354 (S.D. Cal. 1955)	18
27	<i>Comedy III Prods., Inc. v. New Line Cinema</i> , 200 F.3d 593 (9th Cir. 2000)	21
28	<i>Dastar Corp. v. Twentieth Cent. Fox Film Corp.</i> , 539 U.S. 23 (2011)	21
	<i>DC Comics v. Towle</i> , 802 F.3d 1012 (9th Cir. 2015)	7

1	<i>Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.</i> ,	
2	109 F.3d 1394 (9th Cir. 1997)	16, 17
3	<i>Elsmere Music, Inc. v. Nat'l Broad. Co.</i> , 623 F.2d 252 (2d Cir. 1980)	18
4	<i>EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopulos, Inc.</i> ,	
5	228 F.3d 56 (2d Cir. 2000)	20
6	<i>E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.</i> , 547 F.3d 1095 (9th Cir. 2008)	23
7	<i>Fisher v. Dees</i> , 794 F.2d 432 (9th Cir. 1986)	6
8	<i>Fletcher Studios, Inc. v. A.V.E.L.A., Inc.</i> , 654 F.3d 958 (9th Cir. 2011)	20
9	<i>Folsom v. Marsh</i> , 9 F. Cas. 342 (No. 4,901) (CCD Mass. 1841)	10
10	<i>Halicki Films, LLC v. Sanderson Sales & Mktg.</i> , 547 F.3d 1213 (9th Cir. 2008)	7
11	<i>Harper & Row, Publishers, Inc. v. Nation Enters.</i> , 471 U.S. 539 (1985)	10
12	<i>Henley v. DeVore</i> , 733 F. Supp. 2d 1144 (C.D. Cal. 2010)	19
13	<i>In re Dual-Deck Video Cassette Recorder Antitrust Litig.</i> ,	
14	11 F.3d 1460 (9th Cir. 1993)	6
15	<i>In re Scholastic, Inc.</i> , 223 U.S.P.Q. (BNA) 431	
16	(Trademark Trial & App. Bd. 1984)	21
17	<i>Kelly v. Arriba Soft Corp.</i> , 336 F.3d 811 (9th Cir. 2003)	17
18	<i>Knievel v. ESPN</i> , 393 F.3d 1068 (9th Cir. 2005)	4
19	<i>Leadsinger, Inc. v. BMG Music Publ'g</i> , 512 F.3d 522 (9th Cir. 2008)	6
20	<i>Lenz v. Universal Music Corp.</i> , 815 F.3d 1145 (9th Cir. 2016)	9
21	<i>Marcus v. Rowley</i> , 695 F.2d 1171 (9th Cir. 1983)	2
22	<i>Mattel, Inc. v. MCA Records</i> , 296 F.3d 894 (9th Cir. 2002)	21, 22, 23
23	<i>Mattel Inc. v. Walking Mt. Prods.</i> , 353 F.2d 792 (9th Cir. 2003)	2, 9, 11, 22, 24
24	<i>New Kids on the Block v. News Am. Publ'g, Inc.</i> ,	
25	971 F.2d 302 (9th Cir. 1992)	23, 24
26	<i>Olson v. NBC</i> , 855 F.2d 1446 (9th Cir. 1988)	7
27	<i>Papasain v. Allain</i> , 478 U.S. 265 (1986)	2
28	<i>Playboy Enters., Inc. v. Welles</i> , 78 F. Supp. 2d 1066 (S.D. Cal. 1999)	3
	<i>Playboy Enters, Inc. v. Welles</i> , 279 F.3d 796 (9th Cir. 2002)	2

1	<i>RDF Media Ltd. v. Fox Broad Co.</i> , 372 F. Supp. 2d 556 (C.D. Cal. 2005)	20
2	<i>Rice v. Fox Broad. Co.</i> , 330 F.3d 1170 (9th Cir. 2003)	7
3	<i>Ringgold v. Black Entm’t Television, Inc.</i> , 126 F.3d 70 (2d Cir. 1997)	18
4	<i>Rogers v. Grimaldi</i> , 875 F.2d, 994 (2d Cir. 1989)	22, 23
5	<i>Ryan v. Editions Ltd. W., Inc.</i> , 417 F. App’x 699 (9th Cir. 2011)	21
6	<i>Seltzer v. Green Day, Inc.</i> , 725 F.3d 1170 (9th Cir. 2013)	10, 17, 18
7	<i>Shaw v. Lindheim</i> , 919 F.2d 1353 (9th Cir. 1990)	7
8	<i>Silvers v. Sony Pictures Entm’t</i> , 402 F.3d 881 (9th Cir. 2005)	7
9	<i>SOFA Entm’t, Inc. v. Dodger Prods.</i> , 709 F.3d 1273 (9th Cir. 2013)	10, 17
10	<i>Sony Corp. of Am. v. Universal City Studios, Inc.</i> , 464 U.S. 417 (1984)	10
11	<i>Sprewell v. Golden State Warriors</i> , 266 F.3d 979 (9th Cir. 2001)	1
12	<i>Swartz v. KPMG LLP</i> , 476 F.3d 756 (9th Cir. 2007)	1, 2
13	<i>Sybersound Records, Inc. v. UAV Corp.</i> , 517 F.3d 1137 (9th Cir. 2008)	7, 21
14	<i>Thane Int’l v. Trek Bicycle Corp.</i> , 305 F.3d 894 (9th Cir. 2002)	12
15	<i>Theta Chi Fraternity, Inc. v. Leland Stanford Junior Univ.</i> ,	
16	No. 16-cv-01336-RMW, 2016 U.S. Dist. LEXIS 116863	
	(N.D. Cal. Aug. 30, 2016)	5
17	<i>Time Inc. v. Bernard Geis Assocs.</i> , 293 F.3d 130 (S.D.N.Y. 1968)	19
18	<i>Toho Co. v. Sears, Roebuck & Co.</i> , 645 F.2d 788 (9th Cir. 1981)	20
19	<i>Toyota Motor Sales, U.S.A., Inc. v. Tabari</i> , 610 F.3d 1171 (9th Cir. 2010)	2, 23
20	<i>Yankee Publ’g, Inc. v. News Am. Publ’g, Inc.</i> ,	
21	809 F. Supp. 267 (S.D.N.Y. 1992))	22
22		
23	Statutes, Rules, Regulations, and Constitutions	
24	15 U.S.C. § 1125(a)	21
25	15 U.S.C. § 1127	20
26	17 U.S.C. § 107	2, 5, 7
27	17 U.S.C. § 107	18
28	California Business and Professions Code § 17200	3

1	Fed. R. Civ. P. 12(b)(6)	1, 6, 24
2	Fed. R. Evid. 201(b)	4
3	37 C.F.R. § 202.1	7
4	U.S. Const. amend. I	<i>passim</i>
5		
6	Books, Dictionaries, and Encyclopedias	
7	American Heritage Dictionary 1317 (3d ed. 1992)	11
8	7 Encyclopedia Britannica 768 (15th ed. 1975)	11
9	Dr. Seuss, <i>Horton Hears a Who</i> (Random House 1955)	7, 9
10	Dr. Seuss, <i>How the Grinch Stole Christmas!</i> (Random House 1957)	7, 9, 13, 14, 16
11	Dr. Seuss, <i>The Lorax</i> (Random House 1971)	7, 9
12	Dr. Seuss, <i>Oh, the Places You'll Go!</i> (Random House 1990)	<i>passim</i>
13	Dr. Seuss, <i>The Sneetches and Other Stories</i> (Random House 1961)	7, 9, 15, 16
14		
15	Television Programs and Online Videos	
16	<i>Star Trek</i> , “And the Children Shall Lead” (broadcast Oct. 11, 1968)	15
17	<i>Star Trek</i> , “The Apple” (broadcast Oct. 13, 1967)	13
18	<i>Star Trek</i> , “Arena” (broadcast Jan. 19, 1967)	13
19	<i>Star Trek</i> , “The Cage” (broadcast Oct. 14, 1986)	13
20	<i>Star Trek</i> , “Day of the Dove” (broadcast Nov. 1, 1968)	15
21	<i>Star Trek</i> , “The Deadly Years” (broadcast Dec. 8, 1967)	15
22	<i>Star Trek</i> , “The Devil in the Dark” (broadcast Mar. 9, 1967)	13
23	<i>Star Trek</i> , “Elaan of Troyius” (broadcast Dec. 20, 1968)	15
24	<i>Star Trek</i> , “I, Mudd” (broadcast Nov. 3, 1967)	14
25	<i>Star Trek</i> , “The Menagerie” (broadcast Nov. 17 & 24, 1968)	13
26	<i>Star Trek</i> , “The Savage Curtain” (broadcast Mar. 7, 1969)	13
27	<i>Star Trek</i> , “A Taste of Armageddon” (broadcast Feb. 23, 1967)	13
28	<i>Star Trek</i> , “That Which Survives” (broadcast Jan. 24, 1969)	13

1	<i>Star Trek</i> , “This Side of Paradise” (broadcast Mar. 2, 1967)	15
2	<i>Star Trek</i> , “The Trouble With Tribbles” (broadcast Dec. 29, 1967)	4
3	<i>Star Trek</i> , “What Are Little Girls Made Of?” (broadcast Oct. 20, 1966)	13
4	<i>Star Trek</i> , “Where No Man Has Gone Before” (broadcast Sept. 22, 1966)	14
5	<i>Star Trek</i> , “Wink of an Eye” (broadcast Nov. 29, 1968)	15
6	<i>Star Trek</i> , “Wolf in the Fold” (broadcast Dec. 22, 1967)	15
7	Smithsonian Nat’l Air & Space Museum, <i>Opening Credits</i> (June 27, 2016)	11
8	YouTube, <i>Star Trek Original Series - Opening Credits</i> (Oct. 13, 2016)	11

9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

1 **I. Introduction: *Oh, the Uses Seuss Sues!***

2 Defendant ComicMix LLC (“ComicMix”) respectfully moves the Court for an
3 order dismissing this matter for failure to state a claim pursuant to Fed. R. Civ. P.
4 12(b)(6), on the grounds that ComicMix’s allegedly infringing book constitutes fair
5 use of any elements of Dr. Seuss books protected by copyright or trademark law.

6 This case presents a simple question: May an author’s estate use the courts to
7 stymie publication of a book that makes critical, parodic use of the author’s books?
8 On the facts alleged, the answer must be no. The Copyright Act, the Lanham Act and
9 the First Amendment fully protect ComicMix’s right to comment and build on Dr.
10 Seuss’ works. The law does not place his beloved books above parody, beyond
11 critical commentary, or past the reach of cultural transformation and nominative use.

12 **II. Applicable Legal Standards**

13 **a. Federal Rule of Civil Procedure 12(b)(6)**

14 Under Federal Rule of Civil Procedure 12(b)(6), a party may raise by motion the
15 defense that the complaint “fail[s] to state a claim upon which relief can be granted.”
16 To survive a Rule 12(b)(6) motion to dismiss, “a complaint must contain sufficient
17 factual matter, accepted as true, to ‘state a claim to relief that is plausible on its
18 face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v.*
19 *Twombly*, 550 U.S. 544, 570 (2007)). A plaintiff must assert “more than labels and
20 conclusions[] and a formulaic recitation of the elements of a cause of action.”
21 *Twombly*, 550 U.S. at 555. “Factual allegations must be enough to raise a right to
22 relief above the speculative level.” *Id.*

23 “All allegations of material fact are taken as true and construed in the light most
24 favorable to the nonmoving party. ... The court need not, however, accept as true
25 allegations that contradict matters properly subject to judicial notice or by exhibit.”
26 *Sprewell v. Golden State Warriors*, 266 F.3d 979, 988 (9th Cir. 2001). A “court may
27 consider a writing referenced in a complaint but not explicitly incorporated therein if
28 the complaint relies on the document and its authenticity is unquestioned.” *Swartz v.*

1 *KPMG LLP*, 476 F.3d 756, 763 (9th Cir. 2007). And “on a motion to dismiss, courts
2 ‘are not bound to accept as true a legal conclusion couched as a factual allegation.’”
3 *Twombly*, 550 U.S. at 555 (quoting *Papasain v. Allain*, 478 U.S. 265, 286 (1986)).

4 **b. 17 U.S.C. § 107 - Fair Use Under Copyright Law**

5 Section 107 of the Copyright Act codifies the judicial doctrine of fair use. *Marcus*
6 *v. Rowley*, 695 F.2d 1171, 1174 (9th Cir. 1983). It provides that, “the fair use of a
7 copyrighted work . . . for purposes such as criticism [or] comment . . . is not an
8 infringement of copyright.” 17 U.S.C. § 107.

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

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

18 *Id.*

19 **c. Nominative Fair Use Under Trademark Law**

20 A “nominative fair use . . . is, by definition, not infringement.” *Toyota Motor*
21 *Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1175 (9th Cir. 2010). “In cases where
22 a nominative fair use defense is raised, we ask whether (1) the product was ‘readily
23 identifiable’ without use of the mark; (2) defendant used more of the mark than
24 necessary; or (3) defendant falsely suggested he was sponsored or endorsed by the
25 trademark holder.” *Id.* at 1175-76 (quoting *Playboy Enters, Inc. v. Welles*, 279 F.3d
26 796, 801 (9th Cir. 2002)). “The nominative fair use test replaces the traditional *AMF,*
27 *Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979), analysis” of likelihood
28 of confusion. *Mattel Inc. v. Walking Mt. Prods.*, 353 F.2d 792, 810 n. 19 (9th Cir.
2003) (citing *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150 (9th Cir. 2002) and
Welles, 279 F.3d at 801). “The nominative fair use analysis is appropriate where a

1 defendant has used the plaintiff's mark to describe the plaintiff's product, *even if the*
2 *defendant's ultimate goal is to describe his own product....*" *Cairns*, 292 F.3d at
3 1152 (emphasis in original).

4 "[A]ctions pursuant to California Business and Professions Code § 17200 are
5 'substantially congruent' to claims made under the Lanham Act." *Cleary v. News*
6 *Corp.*, 30 F.3d 1255, 1262-63 (9th Cir. 1994) (*citing Acad. of Motion Picture Arts &*
7 *Sciences v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1457 (9th Cir. 1991)).
8 For such claims, the Court's "analysis of the fair use defense is identical." *Playboy*
9 *Enters., Inc. v. Welles*, 78 F. Supp. 2d 1066, 1075 n. 4 (S.D. Cal. 1999).

10 **III. Statement of Material Facts**

11 The pertinent facts alleged in the complaint, taken as true for purposes of this
12 motion, and those drawn from writings referenced in the complaint but not expressly
13 incorporated therein and otherwise subject to judicial notice, are as follows.

14 The late Theodor S. Geisel, better known under his pseudonym Dr. Seuss, wrote
15 and illustrated children's books. Doc. 1 ¶ 1, 12. Plaintiff Dr. Seuss Enterprises, L.P.
16 ("DSE") is the assignee of the copyright registration for Dr. Seuss books and owner
17 of certain trademark rights in Dr. Seuss goods. *Id.* ¶¶ 3, 16-17. *Oh, the Places You'll*
18 *Go!* ("*Go!*") is one of Dr. Seuss' best-known books. *Id.* ¶ 15.

19 Defendants are comics publisher ComicMix, its co-founder and vice-president
20 Glenn Hauman ("Hauman"), author David Gerrold ("Gerrold"), and illustrator Ty
21 Templeton ("Templeton"). *Id.* ¶¶ 4-7. ComicMix marketed, and each Defendant
22 intended "to sell, reproduce, and distribute" a projected book written by Gerrold,
23 illustrated by Templeton, and edited by Hauman, entitled *Oh, the Places You'll*
24 *Boldly Go!* ("*Boldly*" or "the book"). *Id.* ¶¶ 2, 4-7, 19-22. DSE alleges that *Boldly*
25 "misappropriates key elements" of *Go!* and four other Dr. Seuss books. *Id.* ¶ 26.
26 DSE alleges that *Boldly* "purports to be an amalgamation of the Dr. Seuss works and
27 certain characters, imagery, and other elements from *Star Trek*, the well-known
28 science fiction entertainment franchise created by Gene Roddenberry." *Id.* ¶ 18.

1 ComicMix ran a crowdfunding campaign for the costs of printing and distributing
 2 *Boldly* on the website Kickstarter.com (the “Campaign”). *Id.* ¶ 34; *see* ComicMix’s
 3 Request for Judicial Notice (“RJN”) Ex. 1.¹ The Campaign told potential donors:

4 ***Oh, The Places You’ll Boldly Go!*** is a parody mash-up from the mind
 5 that brought you “[The Trouble With Tribbles](#)” that brings together two
 6 of the most beloved creations in history in a joyous celebration that
 will inspire you to join the high fliers who soar to high heights!

7 RJN Ex. 1. In a section titled “Risks and challenges,” the Campaign explained:

8 While we firmly believe that our parody, created with love and
 9 affection, fully falls within the boundary of fair use, there may be
 10 some people who believe that this might be in violation of their
 11 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.

12 *Id.*; Doc. 1 ¶ 35. The Campaign “raised nearly \$30,000” in pledges toward
 13 production costs. Doc. 1 ¶ 2. DSE moved to suppress the Campaign and obstruct
 14 publication. Its attorneys sent Defendants cease-and-desist letters on September 28
 15 and October 7, 2016. *Id.* ¶¶ 36, 38. On October 7, 2016, sent a takedown notice to
 16 Kickstarter asserting that Defendants’ use of Dr. Seuss works infringed DSE’s
 17 copyrights. *Id.* ¶ 40; RJN Ex. 2.² Kickstarter responded to the notice by disabling the
 18 Campaign. Doc. 1 ¶ 41. It remains suspended due to DSE’s claims. *See* RJN Ex. 3.³

19 ¹ The Campaign, incorporated by reference in the complaint, is subject to judicial
 20 notice. The Court may take judicial notice of documents whose contents are alleged
 21 in the complaint where no party disputes its authenticity. *Branch v. Tunnell*, 14 F.3d
 22 449, 453 (9th Cir. 1994). That includes the content of publicly available websites.
Knievel v. ESPN, 393 F.3d 1068, 1076 (9th Cir. 2005); Fed. R. Evid. 201(b).

23 ² The Court may take judicial notice of web pages referenced in the complaint.
 24 *Knievel*, 393 F.3d at 1076.

25 ³ The Campaign web page now redirects to a page that states, “Oh The Places You’ll
 26 Boldly Go! is the subject of an intellectual property dispute and is currently
 27 unavailable.” *Id.* The Court may take judicial notice of web pages referenced in the
 28 complaint, the fact that the website redirects to a different page than identified in the
 complaint, and the content of the current web page. *See Closed Loop Mktg. v. Closed
 Loop Mktg., LLC*, 589 F. Supp. 2d 1211, 1215 & n.2 (E.D. Cal. 2008).

1 DSE’s attorneys sent ComicMix a third letter on October 25, 2016. Doc. 1 ¶ 42.
 2 Three days later, ComicMix’s undersigned attorney sent DSE’s attorneys a response
 3 letter explaining its position that *Boldly* constitutes fair use. *Id.* ¶ 43; *see* RJN Ex. 4.⁴
 4 That same day, October 28, 2016, the undersigned attorney sent DSE’s attorneys a
 5 complete copy of *Boldly* in PDF form. RJN Ex. 5.⁵ The U.S.S. *Enterprise*, familiar
 6 from the *Star Trek* series, occupies more than half of *Boldly*’s cover art. *Id.* p. 1. The
 7 cover, title page, and copyright page each credit the book as “by David Gerrold & Ty
 8 Templeton.” *Id.* pp. 1-2. The copyright page bears a disclaimer in large type that
 9 states, “This is a work of parody, and is not associated with or endorsed by CBS
 10 Studios or Dr. Seuss Enterprises, L.P.” *Id.* p. 2. Immediately below, a second
 11 disclaimer states, “Copyright Disclaimer under section 107 of the Copyright Act
 12 1976, allowance is made for ‘fair use’ for purposes such as criticism, comment, news
 13 reporting, teaching, scholarship, education, research, and parody.” *Id.* The page also
 14 bears a dedication: “for Gene [Roddenberry] and Ted [Geisel] who went before.” *Id.*

15 ComicMix sent a counter-notice to Kickstarter seeking reinstatement of the
 16 Campaign on October 31, 2016. Doc. 1 ¶ 44. On November 10, 2016, DSE filed a
 17 complaint including pages from the otherwise unreleased *Boldly*, alleging copyright
 18 and trademark infringement and unfair competition. Doc. 1 ¶ 28; *see* RJN Ex. 5.

19 **IV. Argument**

20 DSE fails to state a claim. The Court may resolve the issue of fair use upon this
 21 motion to dismiss. *Boldly* is neither infringing nor unfair, so none of the causes of
 22 action can survive and the action should be dismissed.

23 _____
 24 ⁴ The Court may take “judicial notice of the fact that counsel made particular
 25 statements” in correspondence between the parties’ counsel referenced in the
 26 complaint. *Theta Chi Fraternity, Inc. v. Leland Stanford Junior Univ.*, No. 16-
 cv-01336-RMW, 2016 U.S. Dist. LEXIS 116863, *12-13 (N.D. Cal. Aug. 30, 2016).

27 ⁵ The Court may take judicial notice of the contents of a defendant’s allegedly
 28 infringing work referenced in, but not attached to, the complaint. *Campbell v. Walt
 Disney Co.*, 718 F. Supp. 2d 1108, 1111 n.3 (N.D. Cal. 2010) (“*Walt Disney*”).

1 **a. The Court may resolve the issue of fair use upon this motion.**

2 Under both copyright and trademark law, fair use is appropriate for resolution
3 under Rule 12(b)(6) where it appears on the face of the complaint, and no material
4 facts are in dispute. *Leadsinger, Inc. v. BMG Music Publ'g*, 512 F.3d 522, 530 (9th
5 Cir. 2008) (copyright); *Brownmark Films, LLC v. Comedy Partners*, 682 F.3d 687,
6 692 (7th Cir. 2012) (copyright; “When a defendant raises a fair use defense claiming
7 his or her work is a parody, a court can often decide the merits of the claim without
8 discovery or a trial.”); *In re Dual-Deck Video Cassette Recorder Antitrust Litig.*, 11
9 F.3d 1460, 1466-67 (9th Cir. 1993) (trademark).

10 The complaint, and documents sufficiently referenced therein or otherwise
11 subject to judicial notice, are sufficient to enable the Court to evaluate the issue of
12 fair use. The complaint raises the issue directly. It quotes from the Campaign where
13 ComicMix explained its belief that *Boldly* constitutes fair use, while recognizing that
14 others (such as DSE) might dispute the issue, including through litigation. Doc. 1 ¶
15 35. The Campaign further explained that *Boldly* “is a parody mash-up.” RJN Ex. 1.

16 The material facts are not disputed. ComicMix ran the Campaign in anticipation
17 of publishing *Boldly*, the only allegedly infringing work. Doc. 1 ¶¶ 34-35. The
18 content of the Campaign, which was publicly available online, is not in dispute. *See*
19 RJN Ex. 1. The content of *Boldly* is also not disputed. *Id.* Ex. 5. ComicMix
20 voluntarily provided a copy to DSE, which DSE excerpted in the complaint. Doc. 1
21 ¶ 28. As alleged, *Boldly* makes use of elements of certain works by Dr. Seuss,
22 primarily *Go!*, the content of which is also not disputed. *See id.*; RJN Ex. 6 (Dr.
23 Seuss, *Oh, the Places You'll Go!* (Random House 1990)).⁶ The only dispute is
24 whether the use was fair. Such fair use “judgments are legal in nature,” and are to be
25 made by the court. *Fisher v. Dees*, 794 F.2d 432, 436 (9th Cir. 1986).

26
27
28 ⁶ The Court may take judicial notice of allegedly infringed written works referenced
in the complaint but not attached thereto. *Walt Disney*, 718 F. Supp. 2d at 1111 n.3.

1 **b. ComicMix’s book is a non-infringing fair use under copyright law.**

2 Copyright is wholly a ‘creature of statute, and the only rights that exist under
3 copyright law are those granted by statute.’” *Sybersound Records, Inc. v. UAV Corp.*,
4 517 F.3d 1137, 1143-44 (9th Cir. 2008) (quoting *Silvers v. Sony Pictures Entm’t*, 402
5 F.3d 881, 883-84 (9th Cir. 2005) (en banc)). Copyright protects few of the elements
6 that DSE claims as a basis for infringement, *Boldly* employs fewer and infringes
7 none. Its transformative, parodic use poses no risk of market substitution for Dr.
8 Seuss books and constitutes fair use under the guiding factors in 17 U.S.C. § 107.

9 **i. Copyright law limits the scope of DSE’s claims.**

10 DSE alleges that *Boldly* infringes its copyrights to *Go!*’s title, “story arc,” and
11 characters and illustrations from *Go!*, *Horton Hears a Who*, *How the Grinch Stole*
12 *Christmas!* (“Grinch”), *The Lorax*, and *The Sneetches and Other Stories*. Doc. 1 ¶
13 26. Yet copyright covers few of those elements, and *Boldly* infringes none.

14 Titles of books are not independently copyrightable. “Words and short phrases
15 such as names, titles, and slogans” are “examples of works not subject to copyright.”
16 37 C.F.R. § 202.1. “[T]itles, in and of themselves, cannot claim statutory copyright.”
17 *Shaw v. Lindheim*, 919 F.2d 1353, 1362 (9th Cir. 1990). Identical titles can support a
18 showing of substantial similarity between two works, *see id.*, but not in this case,
19 where *Boldly* makes non-infringing fair use of *Go!* and its title, as discussed *infra*.

20 “[C]haracters are ordinarily not afforded copyright protection.” *Rice v. Fox*
21 *Broad. Co.*, 330 F.3d 1170, 1175 (9th Cir. 2003). “[C]opyright protection is available
22 only ‘for characters that are especially distinctive.’” *DC Comics v. Towle*, 802 F.3d
23 1012, 1019 (9th Cir. 2015) (quoting *Halicki Films, LLC v. Sanderson Sales & Mktg.*,
24 547 F.3d 1213, 1224 (9th Cir. 2008)). “To meet this standard, a character must be
25 ‘sufficiently delineated’ and display ‘consistent, widely identifiable traits.’” *Id.*
26 (quoting *Rice*, 330 F.3d at 1175). “[C]haracters that have been ‘lightly sketched’ and
27 lack descriptions may not merit copyright protection.” *Id.* (citing *Olson v. NBC*, 855
28 F.2d 1446, 1452-53 (9th Cir. 1988)).

1 DSE declines to identify any such well-delineated character, leaving its allegation
2 of character “misappropriation” wholly speculative. No character in *Go!* meets this
3 standard. The one character to appear more than once (except perhaps some
4 elephants, who do not reappear in *Boldly*) is the protagonist, a walking cipher. The
5 boy has no name or dialogue and few distinguishing characteristics beyond his
6 yellow knit-cap and onesie. This lightly sketched everyman lacks the “distinctive
7 character traits” required to be protectable by copyright. *Towle*, 802 F.3d at 1020.

8 Further, *Boldly* does not copy any Dr. Seuss character or its traits. In the boy’s
9 place is the *Enterprise*’s captain, wearing the uniform of *Star Trek* commanding
10 officers (a gold shirt with an arrowhead insignia over the left breast, and black
11 trousers) or a spacesuit, or on one page, a green tunic like Captain Kirk sometimes
12 wore. His spiky, adult hairstyle is not covered by a child’s knit-cap. *Boldly*’s wholly
13 distinct characters do not infringe on any protectable character trait of the original.

14 Nor does *Boldly* infringe on *Go!*’s simple, episodic storyline. See RJN Ex. 6. In
15 *Go!*, the boy decides to leave town. He joins a balloon race, taking the lead before
16 getting stuck in a tree. He lands in a “Slump,” comes to a place with unmarked
17 streets, and has a hard time deciding where to turn. In confusion, he races down the
18 road to “The Waiting Place,” where “everyone is just waiting.” He escapes to watch
19 a musical performance by a “Boom Band”, then to join a parade of banner-flying
20 elephants, and then to play on a convoluted ball-field. His athletic skill makes him
21 world-famous, but he is again left all alone to face more scary things.

22 Copyright does not protect the general plot line of an adventurer persevering as
23 he faces both emotional and physical highs and lows. “The copyright of a story
24 covers what is new and novel in it.” *Bradbury v. CBS*, 287 F.2d 478, 485 (9th Cir.
25 1961). “General plot lines are not protected by copyright law.” *Cavalier v. Random*
26 *House, Inc.*, 297 F.3d 815, 823 (9th Cir. 2002) (internal citations omitted). “Familiar
27 stock scenes and themes that are staples of literature are not protected.” *Id.*

1 Any story element in *Go!* that is not too generic to warrant copyright protection
 2 is not copied in *Boldly*, which depicts no confusing streets, balloon races, Slump,
 3 Waiting Place, music, elephants, or parades. The *Go!* boy’s one idiosyncrasy, a talent
 4 for playing an unusual multi-player sport, also does not recur in *Boldly*. Instead,
 5 *Boldly* is filled with allusions to episodes of the original *Star Trek* series. Any
 6 similarities between the plot lines of *Boldly* and *Go!* are generic and unprotectable.

7 **ii. Any use of protected elements of DSE’s works in *Boldly* is a fair use.**

8 The allegedly misappropriated title, story arc and characters are either
 9 unprotected by copyright or not infringed by *Boldly*, leaving illustrations as the sole
 10 pleaded basis for DSE’s copyright claim. Doc. 1 ¶ 26. Certain backgrounds and the
 11 physical postures and positioning of certain characters in *Boldly* refer to selected
 12 visual elements from Dr. Seuss illustrations. The complaint identifies seven
 13 instances of alleged copying from three Dr. Seuss books: *Go!*, *Grinch*, and *The*
 14 *Sneetches and Other Stories* (specifically, “The Sneetches” and “The Zax”). *Id.* ¶ 28
 15 & pp. 7-10.⁷ In each such case, and in the title, the use is a fair use that substantially
 16 transforms and repurposes its source, leaving no grounds for the copyright claim.

17 “Fair use is not just excused by the law, it is wholly authorized by the law.” *Lenz*
 18 *v. Universal Music Corp.*, 815 F.3d 1145, 1151 (9th Cir. 2016). “As a statutory
 19 doctrine, however, fair use is not an infringement. ... [I]nstead, it is logical to view
 20 fair use as a right.” *Id.* at 1152 (quoting *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532,
 21 1542 n.22 (11th Cir. 1996)). Recognizing fair use, the Copyright Act “limits the
 22 rights of a copyright owner regarding works that build upon, reinterpret, and
 23 reconceive existing works.” *Walking Mt. Prods.*, 353 F.3d at 799 (citing *Campbell v.*
 24 *Acuff-Rose Music, Inc.*, 510 U.S. 569, 575-77 (1994)). Fair use doctrine “calls for
 25 case-by-case analysis.” *Campbell*, 510 U.S. at 577.

26
 27 ⁷ The complaint does not depict or otherwise specify any element of *The Lorax* or
 28 *Horton Hears A Who!* that could support any of its claims, so DSE’s copyright claim
 also fails to the extent it is based on any infringement of either book. *See id.*

1 “The four factors identified by Congress as especially relevant in determining
2 whether the use was fair are: (1) the purpose and character of the use; (2) the nature
3 of the copyrighted work; (3) the substantiality of the portion used in relation to the
4 copyrighted work as a whole; (4) the effect on the potential market for or value of
5 the copyrighted work.” *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S.
6 539, 560-61 (1985). Those factors vindicate *Boldly* as a fair use.

7 **1. First Factor: The Purpose and Character of the Use**

8 An allegedly infringing work’s commercial character “tends to weigh against a
9 finding of fair use.” *Id.* at 562. Such commercial character is “‘not conclusive,’ but
10 rather a fact to be ‘weighed along with other[s] in fair use decisions[.]’” *Campbell*,
11 510 U.S. at 585 (quoting *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S.
12 417, 448-49 & n. 32 (1984)). “The central purpose of this investigation is to see ...
13 whether the new work merely ‘supersede[s] the objects’ of the original creation, ...
14 or instead adds something new, with a further purpose or different character, altering
15 the first with new expression, meaning, or message; it asks, in other words, whether
16 and to what extent the new work is ‘transformative.’” *Id.* at 579 (quoting *Folsom v.*
17 *Marsh*, 9 F. Cas. 342, 348 (No. 4,901) (CCD Mass. 1841)). “[T]he more
18 transformative the new work, the less will be the significance of other factors, like
19 commercialism, that may weigh against a finding of fair use.” *Id.* Imbuing
20 copyrighted material with new meaning, without usurping the demand for the
21 original, is fair use. *SOFA Entm’t, Inc. v. Dodger Prods.*, 709 F.3d 1273, 1276 (9th
22 Cir. 2013). Specifically, commentary and parody are well-recognized fair uses.
23 *Campbell*, 510 U.S. at 579.

24 *Boldly* is a détournement, parody, or pastiche, adding transformative matter to
25 DSE’s works. “It is not simply a quotation or a republication.” *Seltzer v. Green Day,*
26 *Inc.*, 725 F.3d 1170, 1176 (9th Cir. 2013) (finding fair use). “[A]n allegedly
27 infringing work is typically viewed as transformative as long as new expressive
28 content or message is apparent.” *Id.* at 1177. Mashing up Seuss-like images in the

1 *Star Trek* context critically alters their meaning and message. *Boldly*'s title
 2 exemplifies that method by invoking both *Go!* and the "boldly go" split-infinitive
 3 from *Star Trek*'s iconic opening monologue: "Space: the final frontier. These are the
 4 voyages of the starship Enterprise. Its five-year mission: to explore strange new
 5 worlds, to seek out new life and new civilizations, to boldly go where no man has
 6 gone before."⁸ The title both employs and adverts to Defendants' mash-up approach
 7 to *Star Trek* and Dr. Seuss. See Doc. 1 ¶ 18. It assists readers in distinguishing the
 8 book from *Go!* while making transformative, fair use of *Go!*'s title.

9 "[P]arody has an obvious claim to transformative value," because "it can provide
 10 social benefit, by shedding light on an earlier work, and, in the process, creating a
 11 new one." *Campbell*, 510 U.S. at 579. "A parody is a 'literary or artistic work that
 12 imitates the characteristic style of an author or a work for comic effect or ridicule.'" *Walking Mt. Prods.*, 353 F.3d at 801 (quoting *Campbell*, 510 U.S. at 580 (quoting
 13 American Heritage Dictionary 1317 (3d ed. 1992))). "The original work need not be
 14 the sole subject of the parody; the parody 'may loosely target an original' as long as
 15 the parody 'reasonably could be perceived as commenting on the original or
 16 criticizing it, to some degree.'" *Id.* (quoting *Campbell*, 510 U.S. at 580-81, 583).
 17 "The germ of parody lies in the definition of the Greek *parodeia*, ... as 'a song sung
 18 alongside another.' *Campbell*, 510 U.S. at 580 (quoting *Acuff-Rose Music, Inc. v.*
 19 *Campbell*, 972 F.2d 1429, 1440 (6th Cir. 1992) (Nelson, J., dissenting) (quoting 7
 20 Encyclopedia Britannica 768 (15th ed. 1975))).

21
 22 So defined, parody aptly conveys the Defendants' recombinant method. Tying
 23 together Dr. Seuss and *Star Trek*, disparate threads of popular culture, *Boldly*

24 ⁸ See Smithsonian Nat'l Air & Space Museum, *Opening Credits* (June 27, 2016),
 25 [https://airandspace.si.edu/stories/objects/star-trek-starship-enterprise-studio-model-
 26 opening-credits](https://airandspace.si.edu/stories/objects/star-trek-starship-enterprise-studio-model-opening-credits) (last visited Dec. 14, 2016); see also YouTube, *Star Trek Original
 27 Series - Opening Credits* (Oct. 13, 2016), <https://youtu.be/4pptCGR9N4g> (posted by
 28 Nat'l Air & Space Museum) (last visited Dec. 14, 2016). Filmed dialogue is a proper
 subject for judicial notice. See *Walt Disney*, 718 F. Supp. 2d at 1111 n.3. Materials
 on a museum website are also fit for judicial notice. *Cairns*, 107 F. Supp. 2d at 1216.

1 amplifies the thematic resonances between them, highlighting their common ground.
2 A trek, of course, is a long, arduous journey, typically one made on foot. *See*
3 *generally Thane Int'l v. Trek Bicycle Corp.*, 305 F.3d 894, 912 n.14 (9th Cir. 2002).
4 In both *Go!* and *Star Trek*, daring travelers explore alien landscapes and encounter
5 unusual creatures, so they do in *Boldly* as well. Yet as *Boldly* targets those
6 similarities, it teases out fundamental differences, developing a study in contrasts.

7 *Go!* glorifies individualism, establishing the theme from the outset: “You’re on
8 your own.” RJN Ex. 6 p. 5. Its boy adventurer sets out by himself and stays that way,
9 forging no lasting bonds. As the narrator warns, “You’ll get mixed up with many
10 strange birds as you go. So be sure when you step. Step with care and great tact.” *Id.*
11 p. 42. He moves mountains single-handed. *Id.* pp. 43-44. He appears on the same
12 page with other people only twice, both times at a distance. *Id.* pp. 29, 33. Even in a
13 parade of elephants, he is the only person in sight. *Id.* pp. 11, 31. His experiences are
14 all extremes: either soaring above the world as “the best of the best,” “the
15 winningest winner of all ... famous as famous can be,” *id.* pp. 18 & 33, or left
16 behind, stuck in a Slump, all alone. Either way, *Go!* foregrounds his separateness.

17 *Boldly* questions that separation by emphasizing community and mission. It
18 depicts the adventures of the captain of a starship and, critically, the crew he leads.
19 *See* RJN Ex. 5 p. 1 (“You’ve earned the big chair of the best in the fleet!”).
20 Downplaying *Go!*’s isolated individualism, *Boldly* points out that the captain is far
21 from alone; he has a “marvelous crew” of “lifelong friends.” *Id.* p. 4. Unlike the *Go!*
22 wanderer, the captain can rely on others for support: “You can get out of trouble, any
23 that’s knotty, because in a pinch you’ll be beamed out by Scotty.” *Id.* p. 9. *Go!*’s
24 narration repeatedly hails the boy for choosing where to go, while *Boldly* hails the
25 captain for choosing what to *be*: “You know what you are now, and what you are
26 not.” *Id.* And unlike in *Go!*, the captain has more choices than simply fight or flight,
27 either running from danger or overcoming it: “here there be dangers, *but here you’ll*
28 *make friends out of those who are strangers.*” *Id.* p. 8 (emphasis added).

1 *Boldly*'s book-length reframing of *Go!* through the lens of *Star Trek*, while
 2 irreverent, cheeky, and tongue-in-cheek, consistently turns to a critical re-evaluation
 3 of priorities. It proposes an alternate mission statement for *Go!* readers built on the
 4 ideals fostered through the *Star Trek* series' "five-year mission," imbued with a pro-
 5 communitarian ethos. *Boldly* contrasts the independence touted in *Go!* with *Star*
 6 *Trek*'s ideal of interdependence, both among people and between species. Where *Go!*
 7 tells us "you're on your own," *Boldly* conveys the message that we are not alone.

8 Understood in that context, the seven illustrations depicted in the complaint do
 9 not show "slavish copying" as alleged. Doc. 1 ¶ 28 & pp. 7-10. Rather, they
 10 demonstrate *Boldly*'s transformative purpose, character, and message at work.

- 11 1. An empty field traversed alone by the *Go!* boy is populated, in *Boldly*, by
 12 characters from various *Star Trek* episodes, standing in two rows.⁹ *Id.* p. 7; RJN
 13 Ex. 5 p. 3. In *Boldly*, the text alludes to the mission recited in *Star Trek*'s opening
 14 monologue: "You'll seek out new life-forms for you to behold, and civilizations
 15 both youngish and old." That reference to mission alters, and implicitly critiques,
 16 the *Go!* boy's naive freedom ("It's opener there in the wide-open air."). *Boldly*
 17 further sheds the carefree aspect of the *Go!* image, as the *Star Trek* characters are
 18 depicted as looming over the captain, several times his height; one character
 19 shakes a fist. Against a similar background, *Boldly* conveys a weightier effect.
- 20 2. In a *Grinch* tableau, dozens of Who-ville residents sing Christmas songs hand-
 21 in-hand, with their jubilation undercut because it inspires the anti-hero Grinch's
 22 attack on Christmas. Doc. 1 p. 8. *Boldly* replaces the carolers with fifteen *Star*
 23 *Trek* characters, largely *Enterprise* crew members and the Captain's lovers. *Id.*;

24
 25 ⁹ The episodes referenced are "Arena" (broadcast Jan. 19, 1967); "The
 26 Cage" (rejected 1965 pilot) (broadcast Oct. 14, 1986); "The Menagerie" (broadcast
 27 Nov. 17 & 24, 1968); "The Devil in the Dark" (broadcast Mar. 9, 1967); "That
 28 Which Survives" (broadcast Jan. 24, 1969); "The Apple" (broadcast Oct. 13, 1967);
 "A Taste of Armageddon" (broadcast Feb. 23, 1967); "What Are Little Girls Made
 Of?" (broadcast Oct. 20, 1966); and "The Savage Curtain" (broadcast Mar. 7, 1969).

1 RJN Ex. 5 p. 4. They stand in an arc, at a lesser angle than the carolers, in color
 2 rather than black-and-white. *Boldly* alludes to the jagged red lines that frame the
 3 *Grinch* image, but employs fewer strokes, reducing the frame's size to present
 4 the crew in a bigger close-up. The *Grinch* pages highlights the Grinch's
 5 perceived conflict with the villagers, while the *Boldly* image accentuates
 6 camaraderie ("You'll make lifelong friends. You'll love them like brothers."),
 7 romance ("lovers of every hue," alluding to "The Menagerie" episode's green-
 8 skinned Vina), and shared experience ("Weird things will happen, and usually
 9 do, to starship explorers and their marvelous crew."). This embrace of teamwork
 10 and companionship offers an implicit critique of the dogged individualism of
 11 both the Grinch and *Go!*

- 12 3. A tree limb snags the *Go!* boy's balloon, leaving him suspended over a valley to
 13 look up at other balloonists flying past, emphasizing his isolation. Doc. 1 p. 8. A
 14 similar tree in *Boldly* hoists the captain in a wedgie, where he looks down aghast
 15 at three Klingons taunting him nearby, emphasizing their dangerous proximity.
 16 *Id.*; RJN Ex. 5 p. 5. Resemblances are limited to the setting and physical terrain,
 17 which are recast for different purposes. Where the *Go!* boy's concern is being
 18 left behind, the captain faces mockery, a concern more social than solitary.
- 19 4. The *Go!* boy races across another empty field under uneven arches down a pink
 20 road toward the cavernous Waiting Place, on the horizon beneath clouds. Doc. 1
 21 p. 8. In *Boldly*, only the arches remain. *Id.*; RJN Ex. 5 p. 7. The road has become
 22 two long red bands on a dark blue background of stars and planets beside the
 23 *Enterprise* as it passes a large human figure floating upside-down.¹⁰ The near-
 24 total transformation reframes the image from the *Go!* boy's meandering to the
 25 *Enterprise* charting a course for adventure in outer space.

26
 27 ¹⁰ The red bands are reminiscent of the barrier at the end of the galaxy in "Where No
 28 Man Has Gone Before" (second pilot) (broadcast Sept. 22, 1966). The upside-down
 man recalls Harry Mudd from "I, Mudd" (broadcast Nov. 3, 1967).

- 1 5. The crowded Waiting Place in *Go!* is transformed in *Boldly* into a bevy of textual
2 and visual allusions to *Star Trek* episodes.¹¹ Doc. 1 p. 9; RJN Ex. 5 p. 8. Unlike
3 the Waiting Place’s stationary figures, the kinetic *Boldly* image depicts mostly
4 motion: dozens of women running, with their ponytails flying; a man on a sofa
5 poised to plunge a dagger into a startled woman; enchanting tears flowing from
6 Princess Elaan’s eyes and dripping from her drenched handkerchief, and in the
7 sky, the Beta XII-A entity from the “Day of the Dove” episode, a glowing mass
8 of pure aggression-triggering energy. The *Go!* boy is not shown, but an adult-
9 sized Captain is fully engaged in the counterpart image in *Boldly*, besotted with
10 Elaan upon contact with her tears. In *Go!* a fisherman sits in profile on a column,
11 “waiting for the fish to bite”; in *Boldly*, a different fisherman sits facing forward,
12 with his bag full of fish. From a sixty-person outhouse queue in *Go!*, a man,
13 woman, and child are employed in *Boldly* in an illustration of one person’s
14 progression through life’s stages, growing from infancy to adulthood, leading to
15 a tombstone. In addition to those three people, the sofa, and the column, a
16 modicum of other Waiting Place items appear in *Boldly*: a clock, an umbrella,
17 and a cat; enough to call the original image to mind while transforming it.
- 18 6. In “The Sneetches,” the titular ostrich-like characters drop their cash on a table
19 to pay a salesman for entry to his Star-On Machine, which places a star on their
20 bellies. Doc. 1 p. 9. In *Boldly*, the machine is reimagined as the transporter, *Star*
21 *Trek*’s teleportation device; the *Enterprise*’s engineer Scotty, at the helm of a
22 control panel, replaces the salesman at his table; other crew members replace the
23 sneetches. *Id.* The machine is the only common element in the two images, and
24 its role is transformed to a means to get somewhere, not to chase status symbols.

25
26 ¹¹ The episodes referenced are “The Deadly Years” (broadcast Dec. 8, 1967); “Wink
27 of an Eye” (broadcast Nov. 29, 1968); “Elaan of Troyius” (broadcast Dec. 20, 1968);
28 “Day of the Dove” (broadcast Nov. 1, 1968); “Wolf in the Fold” (broadcast Dec. 22,
1967); “And the Children Shall Lead” (broadcast Oct. 11, 1968); and “This Side of
Paradise” (broadcast Mar. 2, 1967).

1 7. In “The Zax,” an arm’s length apart on two dunes in an otherwise empty desert,
2 two hairy creatures (“Zax”) heading opposite directions block each others’ paths,
3 each demanding that the other step aside. Doc. 1 p. 10. *Boldly* heightens the
4 absurdity, with two Spocks playing three-dimensional chess on one dune while
5 four Kirks play basketball in the distance. *Id.*; RJN Ex. 5 p. 10. The *Boldly*
6 illustration alludes to a few visual aspects of “The Zax”: some outlines of the
7 foregrounded figures’ stances and postures, the footprints in the sand behind
8 them, and the desert itself. Yet the Zax conflict is repurposed to a more civil and
9 rational form. Both Zax have their mouths open to argue, facing and leaning
10 towards each other. One gestures angrily behind him as the other puffs up his
11 chest and threatens to stand his ground for fifty-nine days. By contrast, both
12 Spocks’ mouths are closed, and they stand further apart, facing the chess board
13 between them. One kneads his chin in contemplation as his hand hovers over his
14 next move, while the other waits with belly sagging, back straight, and head
15 tipped back. The Zax argument has been rendered just another game.

16 Notably, while many illustrations in *Boldly* parody and play off only images from
17 *Go!*, the images depicting interactions with the crew also use other Dr. Seuss books
18 as visual reference points. The crew holding hands alludes to a *Grinch* image; Scotty
19 beaming out the crew alludes to *The Sneetches*; and the Captain and Spock each play
20 games against themselves in an illustration that alludes to the Zax standoff. Doc. 1
21 pp. 8-10. In so doing, *Boldly* uses Dr. Seuss’s own works in service of a group-
22 oriented counterpoint to the *Go!* individualist ideal. Responding to *Go!* by deploying
23 these images from Dr. Seuss’s other books is the height of fair-use commentary.

24 In sum, any material taken from or based on Dr. Seuss works is fundamentally,
25 rigorously transformed. The first factor weighs heavily in favor of finding fair use.

26 **2. Second Factor: The Nature of the Copyrighted Work**

27 The second factor, the nature of the copyrighted work, “typically has not been
28 terribly significant in the overall fair use balancing.” *Dr. Seuss Enters., L.P. v.*

1 *Penguin Books USA, Inc.*, 109 F.3d 1394, 1402 (9th Cir. 1997) (finding no fair use
2 upon finding allegedly infringing work was not a transformative parody). Creative
3 works like Dr. Seuss’s books are “‘closer to the core of intended copyright
4 protection’ than informational or functional works,” so their nature sometimes “tilts
5 the scale against fair use” under this factor. *Id.* (quoting *Campbell*, 510 U.S. at 586).
6 But this factor has limited use when “the creative work of art is being used for a
7 transformative purpose.” *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d
8 605, 612 (2d Cir. 2006). It is especially limited in a case of parody, since “parodies
9 almost invariably copy publicly known, expressive works.” *Campbell*, 510 U.S. at
10 586. And this factor’s significance is further mitigated because the copyrighted
11 works were already published. *Seltzer*, 725 F.3d at 1178. “‘Published works are more
12 likely to qualify as fair use because the first appearance of the artist’s expression has
13 already occurred.’” *Id.* (quoting *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 820 (9th
14 Cir. 2003)). This second factor has negligible weight in this case.

15 **3. Third Factor: The Amount and Substantiality of the Work Used**

16 “The third factor looks to the quantitative amount and qualitative value of the
17 original work used in relation to the justification for that use.” *Seltzer*, 725 F.3d at
18 1178 (citing *SOFA*, 709 F.3d at 1279 and *Campbell*, 510 U.S. at 586). “[A]n
19 allegedly infringing work that copies little of the original is likely to be a fair use.”
20 *Id.* (citing *SOFA*, 709 F.3d at 1279). Yet “this factor will not weigh against an alleged
21 infringer, even when he copies the whole work, if he takes no more than is necessary
22 for his intended use.” *Id.* (citing *Kelly*, 336 F.3d at 820-21). The “extent of
23 permissible copying varies with the purpose and character of the use.” *Campbell*,
24 510 U.S. at 586-87. The extent of permissible copying must be broadest for a
25 parody, so as not to stifle its ability to comment coherently on its source material.

26 A parody is entitled at least to “conjure up” the original. Even more
27 extensive use would still be fair use, provided the parody builds upon
28 the original, using the original as a known element of modern culture
and contributing something new for humorous effect or commentary.

1 *Elsmere Music, Inc. v. Nat'l Broad. Co.*, 623 F.2d 252, 253 n.1 (2d Cir. 1980)
 2 (construing *Columbia Pictures Corp. v. Nat'l Broad. Co.*, 137 F. Supp. 348, 354
 3 (S.D. Cal. 1955)). A “parody’s humor, or in any event its comment, necessarily
 4 springs from recognizable allusion to its object through distorted imitation.”
 5 *Campbell*, 510 U.S. at 588. “[T]he parody must be able to ‘conjure up’ at least
 6 enough of the original to make the object of its critical wit recognizable.” *Id.*

7 These precedents effectively anticipated the fair use *Boldly* makes of *Go!* and
 8 other Dr. Seuss works: building on them by adding humorous reflections on their
 9 similarities to broad themes and storylines in *Star Trek*, and using those elements to
 10 cast a critical eye on the shortcomings of the self-fulfillment *Go!* preaches. This
 11 factor supports, or at least does not weigh against, a finding of fair use.

12 **4. Fourth Factor: The Effect on the Market for the Copyrighted Work**

13 “The fourth factor asks what effect the allegedly infringing use has on the
 14 ‘potential market for or value of the copyrighted work.’ ... Where the allegedly
 15 infringing use does not substitute for the original and serves a ‘different market
 16 function,’ such factor weighs in favor of fair use.” *Seltzer*, 725 F.3d at 1179 (quoting
 17 17 U.S.C. § 107(4) and *Campbell*, 510 U.S. at 590). “This factor also considers any
 18 impact on ‘traditional, reasonable, or likely to be developed markets.’” *Id.* (quoting
 19 *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70, 81 (2d Cir. 1997)).

20 “A work that is very transformative will often be in a different market from the
 21 original work and therefore is less likely to cause harm to the original work’s
 22 market.” *Kelley*, 280 F.3d at 948. For transformative works, which “involv[e]
 23 something beyond mere duplication for commercial purposes,” market harm cannot
 24 be presumed. *Campbell*, 510 U.S. at 591. “Indeed, as to parody pure and simple, it is
 25 more likely that the new work will not affect the market for the original in a way
 26 cognizable under this factor, that is, by acting as a substitute for it[.]” *Id.* (citations
 27 omitted). “This is so because the parody and the original usually serve different
 28 market functions.” *Id.* (citations omitted). Indeed, “the law recognizes no derivative

1 market for critical works, including parody.” *Id.* at 592. In the case of parody, the
2 only relevant harm to derivatives “is the harm of market substitution. The fact that a
3 parody may impair the market for derivative uses by the very effectiveness of its
4 critical commentary is no more relevant under copyright than the like threat to the
5 original market.” *Id.* at 593.

6 DSE alleged that it has licensed “new works based upon, and incorporating” its
7 copyrights and trademarks. Doc. 1 ¶ 32. It did not, and could not plausibly, allege,
8 that it has licensed or would license any derivative work that parodies or criticizes
9 Dr. Seuss books, or creates a hybrid pastiche of those books with works from a
10 different entertainment franchise. *See id.* ¶ 18. There is no likelihood of market
11 substitution. “[B]ecause the author is unlikely to permit the use of his or her work to
12 criticize or ridicule that work, a parody is unlikely to supplant the market for the
13 original or its derivatives.” *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1151-52 (C.D.
14 Cal. 2010) (*citing Campbell*, 510 U.S. at 592). “It seems more reasonable to
15 speculate that the Book would, if anything, enhance the value of the copyrighted
16 work; it is difficult to see any decrease in its value.” *Time Inc. v. Bernard Geis*
17 *Assocs.*, 293 F.3d 130, 146 (S.D.N.Y. 1968) (finding fair use in book making
18 unauthorized use of copyrighted pictures).

19 The fourth factor also strongly supports a finding of fair use. Viewed in tandem,
20 the four-factor analysis confirms that *Boldly* is a hallmark case of fair use. Fair use is
21 not an infringement, so DSE fails to state a copyright claim.

22 **c. ComicMix’s book is not an infringement under trademark law.**

23 DSE’s trademark infringement and unfair competition claims fail for several
24 reasons. Copyright law, not trademark law, protects the contents of Dr. Seuss books.
25 And to the extent that DSE pleads any cognizable trademark rights in a title, or any
26 other matter used in *Boldly*, that use is protected by the First Amendment and
27 constitutes a nominative fair use, not an infringement.

1 The complaint identifies no registered trademarks in support of its claims, and
2 little that could constitute a trademark. DSE alleges that it owns trademark rights in
3 the title *Oh, the Places You'll Go!*, a stylized font used in Dr. Seuss books, and an
4 illustration style of characters and backgrounds depicted in Dr. Seuss books. Doc. 1
5 ¶ 17. DSE alleges only ownership of “common law trademark rights” in those
6 alleged marks. *Id.* ¶ 59. “Without a federal registration, however, the claimant loses
7 out on the presumption of validity that registration confers.” *Fletcher Studios, Inc. v.*
8 *A.V.E.L.A., Inc.*, 654 F.3d 958, 966-67 (9th Cir. 2011) (citing *Toho Co. v. Sears,*
9 *Roebuck & Co.*, 645 F.2d 788, 790 (9th Cir. 1981)).

10 DSE cannot claim trademark rights based on the content of Dr. Seuss books.
11 Trademark law protects words and symbols that designate a product’s source, but it
12 “does not protect the content of a creative work of artistic expression as a trademark
13 for itself. Copyright law protects the artist’s right in an abstract design or other
14 creative work.” *RDF Media Ltd. v. Fox Broad Co.*, 372 F. Supp. 2d 556, 562 (C.D.
15 Cal. 2005) (quoting *EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopulos,*
16 *Inc.*, 228 F.3d 56, 63 (amended by 2000 U.S. App. LEXIS 30761 (2d Cir. 2000)). A
17 product itself cannot serve as its own trademark. *EMI Catalogue P’ship*, 228 F.3d at
18 63. Under the Lanham Act, “a trademark is any combination of words, names,
19 symbols or devices that are used to identify and distinguish goods and services and
20 to indicate their source.” *Am. Express Co. v. Goetz*, 515 F.3d 156, 159 (2d Cir. 2000)
21 (citing 15 U.S.C. § 1127). “While copyright law protects the content of a creative
22 work itself, ... it is trademark law that protects those symbols, elements or devices
23 which identify the work in the marketplace and prevent confusion as to its source.”
24 *Id.* (citations omitted). “For example, the title of a song might identify that song in
25 the marketplace, but the musical composition itself would not perform that function;
26 thus, while the title may be protectable by trademark, the composition would not
27 be.” *Id.* (citations omitted). The font and illustration style in Dr. Seuss books are not
28 trademarks designating the source of goods. They are integral parts of the goods.

1 DSE's attempt to cloak copyright claims in trademark clothing is precluded by
2 the Copyright Act, which governs claims of infringement of rights in the content of
3 creative works. *See Sybersound Records*, 517 F.3d at 1150; *Ryan v. Editions Ltd. W.,*
4 *Inc.*, 417 F. App'x 699, 701 (9th Cir. 2011). The Lanham Act, 15 U.S.C. § 1125(a), is
5 not to be construed to "conflict with the law of copyright." *Dastar Corp. v. Twentieth*
6 *Cent. Fox Film Corp.*, 539 U.S. 23, 33 (2011). *Dastar* instructs courts "to avoid
7 overlap between the Lanham and Copyright Acts." *Sybersound Records*, 517 F.3d at
8 1144. "The Lanham Act cannot be used to circumvent copyright law." *Comedy III*
9 *Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 595 (9th Cir. 2000) (disagreeing with
10 "fanciful agreement" that footage from Three Stooges film was a cognizable
11 trademark "rather than the subject of copyright"). Accordingly, DSE's alleged
12 trademark rights in a stylized font in Dr. Seuss books, and in an illustration style for
13 characters and backgrounds in those books, cannot sustain a claim.

14 DSE also cannot prevail on its trademark claim over the title *Oh, the Places*
15 *You'll Go!* "Consumers expect a title to communicate a message about the book or
16 movie, but they do not expect it to identify the publisher or producer." *Mattel, Inc. v.*
17 *MCA Records*, 296 F.3d 894, 902 (9th Cir. 2002). A book title ordinarily "does not
18 perform a trademark function. That is, it does not identify the source of the book, but
19 serves merely to identify the material found therein, i.e., the work of the author. In so
20 doing it is nothing more than a descriptive designation therefor." *In re Scholastic,*
21 *Inc.*, 223 U.S.P.Q. (BNA) 431, 431 (Trademark Trial & App. Bd. 1984).

22 Even if Dr. Seuss's style, font, or the title of *Go!* do function as DSE's trademark
23 as claimed, their use would not constitute infringement under the First Amendment
24 and the doctrine of nominative fair use.

25 The First Amendment limits the application of the Lanham Act against artistic
26 works that use the plaintiff's trademarks to describe or comment on the plaintiff's
27 goods or services. "When unauthorized use of another's mark is part of a
28 communicative message and not a source identifier, the First Amendment is

1 implicated in opposition to the trademark right.” *MCA Records*, 296 F.3d at 900
2 (*quoting Yankee Publ’g, Inc. v. News Am. Publ’g, Inc.*, 809 F. Supp. 267, 276
3 (S.D.N.Y. 1992)). “Simply put, the trademark owner does not have the right to
4 control public discourse whenever the public imbues his mark with a meaning
5 beyond its source-identifying function.” *Id.*

6 To balance trademark law and the First Amendment, the Ninth Circuit has
7 adopted the approach taken by the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d,
8 994, 999 (2d Cir. 1989). *See Walking Mt. Prods.*, 353 F.3d at 807. Under the *Rogers*
9 test, an artistic or creative work does not violate the Lanham Act by using a mark
10 unless the use “has no artistic relevance to the underlying work whatsoever, or, if it
11 has some artistic relevance, unless [it] explicitly misleads as to the source or the
12 content of the work.” *MCA Records*, 296 F.3d at 902 (*quoting Rogers*, 875 F.2d at
13 999). Though the Ninth Circuit first applied the *Rogers* test to the use of a trademark
14 in a work’s title in *MCA Records*, 296 F.3d at 902, it has found “no principled reason
15 why it ought not also apply to the use of a trademark in the body of the work.” *E.S.S.*
16 *Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008).

17 The use of DSE’s alleged marks in *Boldly* merits First Amendment protection
18 under *Rogers*. First, it has “at least ‘some artistic relevance.’” *Id.* at 1100 (*quoting*
19 *MCA Records*, 296 F.3d at 902). The use of *Go!*’s title in *Boldly*, and of fonts and
20 illustrations that recall Dr. Seuss’s style, are directly relevant to a creative work that
21 addresses the relationship between *Go!* and other Dr. Seuss works and the *Star Trek*
22 universe. Second, there is nothing misleading about *Boldly*, explicitly or otherwise.
23 “[T]he mere use of a trademark alone cannot suffice to make such use explicitly
24 misleading.” *Id.* (*citing MCA Records*, 296 F.3d at 902). And the book expressly
25 disclaims DSE’s endorsement: “This is a work of parody, and is not associated with
26 or endorsed by CBS Studios or Dr. Seuss Enterprises, L.P.” RJN Ex. 5 p. 2. The
27 Campaign did so at least implicitly, by calling the book a “parody mash-up,” and by
28 warning that despite fair use, “there may be some people who believe that this might

1 be in violation of their intellectual property rights.” *Id.* Ex. 1. Under the *Rogers* test,
2 and the Ninth Circuit’s precedents, those people would be wrong.

3 ComicMix’s nominative fair use also defeats DSE’s claim. A use of the plaintiff’s
4 mark in a defendant’s product is not infringement if it is not used as a source-
5 identifier. Because the nominative use of a mark “does not implicate the source-
6 identification function that is the purpose of trademark, it does not constitute unfair
7 competition; such use is fair because it does not imply sponsorship or endorsement
8 by the trademark holder.” *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d
9 302, 308 (9th Cir. 1992). The nominative fair use test established in *New Kids* is also
10 animated by First Amendment concerns. “Much useful social and commercial
11 discourse would be all but impossible if speakers were under threat of an
12 infringement lawsuit every time they made reference to [Dr. Seuss] by using its
13 trademark.” *Id.* at 307. “[T]his would have serious First Amendment implications.”
14 *Tabari*, 610 F.3d at 1180. “The nominative fair use doctrine is designed to prevent
15 this type of abuse of the rights granted by the Lanham Act.” *Id.*

16 The three-part nominative fair use test would also defeat the claim. It first asks if
17 the plaintiff’s goods could be readily identified without the mark. It is “virtually
18 impossible to refer to a [book] for purposes of comparison, criticism, point of
19 reference or any other such purpose without using the [title].” *Id.* at 306. Indeed, the
20 function of a title is that it “‘identifies a specific literary work.’” *MCA Records*, 296
21 F.3d at 902 (*quoting Application of Cooper*, 45 C.C.P.A. 923, 254 F.2d 611, 615
22 (C.C.P.A. 1958)). DSE cannot make communications about its book avoid the title.
23 Likewise, DSE cannot preclude parody and parody cannot be effective without
24 directly employing the most recognized terms and designs that identify its subjects.

25 The second question under *New Kids* is whether more of the mark was used than
26 “reasonably necessary to identify the product.” *Id.* at 308. “[W]hat is ‘reasonably
27 necessary to identify the plaintiff’s product’ differs from case to case.” *Cairns*, 292 F.
28 3d at 1154.

1 The use of DSE’s full title, and illustrations and fonts from Dr. Seuss books, was
2 reasonably necessary to facilitate *Boldly*’s parody.

3 [T]he keystone of parody is imitation. It is hard to imagine, for
4 example, a successful parody of Time magazine that did not reproduce
5 Time’s trademarked red border. A parody must convey two
6 simultaneous—and contradictory—messages: that it is the original, but
7 also that it is *not* the original and is instead a parody. To the extent that
8 it does only the former but not the latter, it is not only a poor parody
but also vulnerable under trademark law, since the customer will be
confused.

9 *Cliff’s Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 494
10 (2d Cir. 1989). A parody takes from its source by necessity, and by necessity, those
11 takings may be substantial to serve its parodic purpose. Using the full title of *Go!*,
12 for example, was necessary to the comic effect of combining it with *Star Trek*’s “to
13 boldly go” phrasing. *Boldly*’s artwork and font uses also helped the parody work.

14 Third, the nominative fair use test asks if the defendant has done anything “that
15 would, in conjunction with the mark, suggest sponsorship or endorsement by the
16 trademark holder.” *New Kids*, 971 F.2d at 302. As explained *supra*, ComicMix has
17 not. This “element does not require that the defendant make an affirmative statement
18 that their product is not sponsored by the plaintiff.” *Walking Mt. Prods.*, 353 F.3d at
19 811. ComicMix even did that, disclaiming affiliation in the suppressed book. RJN
20 Ex. 5 p. 2. Indeed, crowdfunding to raise money for a print run further suggests
21 ComicMix’s lack of affiliation with the owner of dozens of books that have “sold
22 over 650 million copies worldwide.” Doc. 1, 14. First Amendment concerns weigh
23 heaviest when such a literary powerhouse sues to squelch critical creative speech.
24 DSE failed to state a claim, and its unfair use of the law should be squelched instead.

25 **V. Conclusion**

26 Therefore, ComicMix respectfully requests that the Court dismiss the action
27 pursuant to Fed. R. Civ. P. 12(b)(6).
28

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Respectfully submitted,
DATED: December 19, 2016

BOOTH SWEET LLP

D’EGIDIO LICARI & TOWNSEND, APC

/s/ Dan Booth

/s/ Michael Licari

Dan Booth
Pro Hac Vice Pending

Michael Licari
Local Counsel

Attorneys for Defendant ComicMix LLC

CERTIFICATE OF SERVICE

I hereby certify that on this December 19, 2016 I electronically filed the foregoing document by using the Court’s ECF system, thereby causing a true copy thereof to be served upon counsel of record for each party to have appeared to date, as identified on the Notice of Electronic Filing.

/s/ Dan Booth