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12
13 UNITED STATES DISTRICT COURT
14 SOUTHERN DISTRICT OF CALIFORNIA

15
16 DR. SEUSS ENTERPRISES, L.P., a
California limited partnership,

17 Plaintiff,

18 v.

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

23 Defendants.
24

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

**PLAINTIFF DR. SEUSS
ENTERPRISES, L.P.'S
MEMORANDUM OF POINTS AND
AUTHORITIES IN OPPOSITION
TO DEFENDANT COMICMIX
LLC'S MOTION TO DISMISS
PURSUANT TO FED. R. CIV. P.
12(B)(6)**

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27
28

TABLE OF CONTENTS

	<u>Page</u>
I. PRELIMINARY STATEMENT	1
II. APPLICABLE LEGAL STANDARD ON A MOTION TO DISMISS	2
III. ARGUMENT	3
A. ComicMix’s Motion To Dismiss DSE’s Copyright Claim Fails	3
1. Defendant’s Copyright Fair Use Defense Is Inappropriate For Determination On A 12(b)(6) Motion	8
2. The Copyright Fair Use Doctrine, Even If Considered, Does Not Absolve ComicMix Of Liability	9
a. The Purpose and Character of the Use	9
b. The Nature of the Copyrighted Work	12
c. The Amount and Substantiality of the Portion Used	13
d. The Effect of the Use Upon the Potential Market	14
B. ComicMix’s Motion To Dismiss DSE’s Trademark and Unfair Competition Claims Fails	16
1. DSE’s Trademark Claims Are Not Preempted By The Copyright Act	17
2. Titles Can Function As Trademarks	18
3. ComicMix’s First Amendment Arguments Fail	19
4. ComicMix’s Nominative Fair Use Argument Is Premature	22
IV. CONCLUSION	24

TABLE OF AUTHORITIES

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

Page

CASES

Adobe Sys. Inc. v. Blue Source Group, Inc.,
125 F. Supp. 3d 945 (N.D. Cal. 2015)..... 16

Adobe Sys. Inc. v. Software Tech,
14-cv-02140, 2016 WL 4728119 (N.D. Cal. Sep. 8, 2006) 16

Am. Express Co. v. Goetz,
515 F.3d 156 (2d Cir. 2000) 18

Americas Outlaw Spirits Inc. v. Steven Gunn,
12-cv-04132, 2012 WL 12886419 (C.D. Cal. Sep. 21, 2012) 21, 22

AMF, Inc. v. Sleekcraft Boats,
599 F.2d 341 (9th Cir. 1979) 20, 21

Ashcroft v. Iqbal,
556 U.S. 662 (2009) 2

Autodesk, Inc. v. Dassault Sys. Solidworks Corp.,
No. C 08–04397 WHA, 2008 WL 6742224 (N.D. Cal. Dec.18, 2008) 23

Bach v. Forever Living Products U.S., Inc.,
473 F. Supp. 2d 1110 (W.D. Wash. 2007) 17

Bell Atl. Corp. v. Twombly,
550 U.S. 544 (2007) 2

Browne v. McCain,
611 F. Supp. 2d 1073 (C.D. Cal. 2009) 8

Browne v. McCain,
612 F. Supp. 2d 1125 (C.D. Cal. 2009) 14

Burnett v. Twentieth Century Fox Film Corp.,
491 F. Supp. 2d 962 (C.D. Cal. 2007) 11, 21

Campbell v. Acuff-Rose Music, Inc.,
510 U.S. 569 (1994) passim

TABLE OF AUTHORITIES

(continued)

	<u>Page</u>
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	
	4
	21, 22
	7
	23
	16, 21, 22
	2
	10, 11, 17
	23
	18
	3, 4
	8
	3
	23, 24
	7

TABLE OF AUTHORITIES

(continued)

	<u>Page</u>
1	
2	
3	
4	
5	
6	
7	
8	
9	
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11	
12	
13	
14	
15	
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17	
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21	
22	
23	
24	
25	
26	
27	
28	

<i>Harper & Row Publishers v. Nation Enterprises</i> , 471 U.S. 539 (1985)	13, 14
<i>In re: Dual-Deck Video Cassette Recorded Antitrust Litigation</i> , 11 F.3d 1460 (9th Cir. 1993)	24
<i>Int-Elect Engineering, Inc. v. Clinton Harley Corp.</i> , No. C. 92-20718, 1993 WL 557639 (N.D. Cal. June 24, 1993)	8
<i>Katzenbach v. Grant</i> , No. 04-cv-6501, 2005 WL 1378976 (E.D. Cal. June 7, 2005)	8
<i>Kiedis v. Showtime Networks</i> , No. 07-cv-8185, 2008 WL 11173143 (C.D. Cal. Feb. 19, 2008)	18, 19, 20
<i>KP Permanent Make-Up, Inc. v. Lasting Impression, Inc.</i> , 408 F.3d 596 (9th Cir. 2005)	23
<i>Leadsinger, Inc. v. BMG Music Publ'g.</i> , 512 F.3d 522 (9th Cir. 2008)	12, 15
<i>Levi Strauss & Co. v. Blue Bell, Inc.</i> , 778 F.2d 1352 (9th Cir. 1985)	16, 21
<i>Lucent Techs., Inc. v. Johnson</i> , 2000 U.S. Dist. LEXIS 16002 (C.D. Cal. 2000)	21
<i>Mattel, Inc. v. MCA Records, Inc.</i> , 296 F.3d 894 (N.D. Cal. 2014)	21
<i>Metcalf v. Bochco</i> , 294 F. 3d 1069 (9th Cir. 2002)	7, 8
<i>Morgan Creek Productions, Inc. v. Capital Cities/ABC, Inc.</i> , 89-cv-5463, 1991 WL 352619 (C.D. Cal. Oct. 28, 1991)	20
<i>Muromura v. Rubin Rostaer & Associates</i> , CV 12-09263 DDP AGRX, 2015 WL 1728324 (C.D. Cal. 2015)	6
<i>Murray v. Cable Nat'l Broad. Co.</i> , 86 F.3d 858 (9th Cir. 1996)	20

TABLE OF AUTHORITIES

(continued)

	<u>Page</u>
1	
2	
3	
4	
5	
6	
7	
8	
9	
10	
11	
12	
13	
14	
15	
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23	
24	
25	
26	
27	
28	
	23, 20
	3
	11, 13, 15
	passim
	2
	21, 22
	23
	17
	7
	19, 20, 21, 22
	11
	11
	4, 6

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

TABLE OF AUTHORITIES
(continued)

	<u>Page</u>
17 U.S.C. § 107(1).....	9, 12
17 U.S.C. § 107(3).....	13
17 U.S.C. § 107(4).....	14
 OTHER AUTHORITIES	
Fed. R. Civ. P. 8(a)(2).....	2
Fed. R. Civ. P. 12(b)(6)	passim
Fed. R. Evid. 201(b)	9
1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 6:17.50 (4th ed.).....	17
2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:59 (4th ed.).....	18
NIMMER ON COPYRIGHT, §13.05[A][3].....	13
NIMMER ON COPYRIGHT § 13.05[A][5][a]	8

1 Plaintiff Dr. Seuss Enterprises, L.P. (“DSE”), by and through its undersigned
2 counsel, respectfully submits this opposition to Defendant ComicMix LLC’s
3 (“ComicMix” or “Defendant”) Motion to Dismiss Pursuant to Fed. R. Civ. P.
4 12(b)(6) (the “Motion”). (ECF No. 8.)

5 **I. PRELIMINARY STATEMENT**

6 In *Oh, The Places You’ll Boldly Go!* (the “Infringing Work”), Defendants
7 have taken some of the most creative and recognized Dr. Seuss expression and
8 indicia. Defendants do not shy away from this taking, but instead excuse it by
9 claiming that it was necessary in order to market, crowd-fund, and eventually sell
10 its competing book, a purported parodic “mash-up” of Dr. Seuss and Star Trek
11 intellectual property.

12 With its Motion, ComicMix asks the Court to determine whether the
13 Infringing Work is a fair use under both copyright and trademark law. But a Rule
14 12(b)(6) motion is ill-suited for determination, as a matter of law, on both fair use
15 affirmative defenses. This is because both copyright and trademark fair use
16 defenses involve highly specific fact-intensive inquiries. As such, courts routinely
17 reject fair use as a basis to dismiss copyright and trademark claims at the pleading
18 stage. ComicMix has not come close to demonstrating that its Motion should be
19 the exception to this rule. Nevertheless, as demonstrated below, an analysis of the
20 relevant factors under both areas of law demonstrates the weakness of those
21 defenses to ComicMix’s infringements. The four factors used by courts to
22 determine fair use under the Copyright Act all weigh in DSE’s favor, as the
23 Infringing Work, as pled in the Complaint, is a commercial undertaking that has
24 blatantly copied large portions of DSE’s works without any commentary or critique
25 on those works, but merely to attract attention and consumers. And, the three
26 factors used by courts to determine nominative fair use under trademark law
27 likewise do not support ComicMix’s position. The Infringing Work is not a fair use

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1 under either copyright or trademark law, and simply calling the Infringing Work a
2 fair use parody does not magically make it so.

3 ComicMix's remaining attacks are also failures, as each one misapplies,
4 misstates, or completely ignores the relevant law. In its moving brief, ComicMix:
5 (1) attempts to break down DSE's renowned works into smaller pieces to
6 demonstrate a lack of protectability; (2) argues that DSE's trademark claims are
7 preempted by the Copyright Act; and (3) asserts that that the title of DSE's work
8 *Oh The Places You'll Go!* as well as other source-identifying aspects of its works
9 are not amenable to trademark protection as a matter of law. As explained herein,
10 each of these arguments has no basis in the applicable law and should be rejected.

11 ComicMix's motion should be denied.

12 **II. APPLICABLE LEGAL STANDARD ON A MOTION TO DISMISS**

13 A motion to dismiss under Rule 12(b)(6) tests the legal sufficiency of the
14 complaint. *See Parks Sch. of Bus., Inc. v. Symington*, 51 F.3d 1480, 1484 (9th Cir.
15 1995). In ruling on the motion, a court must "accept all material allegations of fact
16 as true and construe the complaint in a light most favorable to the non-moving
17 party." *Vasquez v. L.A. Cnty.*, 487 F.3d 1246, 1249 (9th Cir. 2007). A complaint
18 must contain "a short and plain statement of the claim showing that the pleader is
19 entitled to relief." Fed. R. Civ. P. 8(a)(2). The Supreme Court has interpreted this
20 rule to mean that "[f]actual allegations must be enough to raise a right to relief
21 above the speculative level." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007).
22 The allegations in the complaint must "contain sufficient factual matter, accepted as
23 true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556
24 U.S. 662, 678 (2009) (quoting *Twombly*, 550 U.S. at 570). The well-pled
25 allegations of a complaint are assumed to be true, but a court is not required to
26 accept legal conclusions couched as facts, unwarranted deductions, or unreasonable
27 inferences. *Dk Holdings v. Miva, Inc.*, No. 16-CV-0580 W (RBB), 2016 WL

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1 4943048, at *2 (S.D. Cal. Sept. 16, 2016) (citing *Papasan v. Allain*, 478 U.S. 265,
2 286 (1986); *Sprewell v. Golden State Warriors*, 266 F.3d 979, 988 (9th Cir. 2001)).

3 **III. ARGUMENT**

4 **A. ComicMix’s Motion To Dismiss DSE’s Copyright Claim Fails**

5 A plaintiff bringing a claim for copyright infringement must show “(1)
6 ownership of a valid copyright, and (2) copying of constituent elements of the work
7 that are original.” *Feist Publ’ns., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361
8 (1991). ComicMix does not dispute that DSE owns the copyrights to the Dr. Seuss
9 copyrighted works (the “DSE Works”), which are duly registered with Copyright
10 Office. (See ECF No. 1 (“Compl.”) at App’x A.) Instead, ComicMix asserts that
11 the Court should dismiss DSE’s copyright claim for failure to plausibly allege
12 copyright infringement because “copyright law limits the scope of DSE’s claims.”
13 (ECF No. 8-1 (“Br.”) at 7-9.) ComicMix is wrong. The Complaint states a clear
14 and well-pled claim for infringement of the DSE Works, identifying the numerous
15 ways in which the Infringing Work has misappropriated the DSE Works. (See
16 Compl. at ¶¶ 18-28, 45-50.)

17 Typically, courts conduct a substantial similarity analysis to assess
18 infringement, which “focuses on articulable similarities between the plot, themes,
19 dialogue, mood, setting, pace, characters, and sequence of events in the two works.”
20 *Funky Films, Inc. v. Time Warner Entm’t Co., L.P.*, 462 F.3d 1072, 1077 (9th Cir.
21 2006) (internal citations and quotations omitted). While ComicMix asserts that
22 “[c]opyright protects few of the elements that DSE claims as a basis for
23 infringement,” and that “[the Infringing Work] employs fewer and infringes none,”
24 its Motion does not ask the Court to conduct a “substantial similarity” analysis
25 between the DSE Works and the Infringing Work, or to dismiss DSE’s copyright
26 claim for lack of substantial similarity, and therefore infringement, as a matter of

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1 law.¹ Rather, ComicMix concedes its blatant unauthorized use of the DSE Works,
 2 asks the Court “filter out” certain “unprotectable” elements of the same from its
 3 analysis, and focus solely on whether ComicMix’s unauthorized use of the
 4 “protectable” elements is a “fair use.” (See Br. at 9 (“The allegedly
 5 misappropriated title, story arc and characters are either unprotected by copyright or
 6 not infringed by [the Infringing Work], leaving illustrations as the sole pleaded
 7 basis for DSE’s copyright claim.”).)²

8 As an initial matter, the DSE Works are original works of authorship, and
 9 thus copyrightable. See *Feist*, 499 U.S. at 345 (“The *sine qua non* of copyright is
 10 originality. To qualify for copyright protection, a work must be original to the
 11 author. Original, as the term is used in copyright, means only that the work was
 12 independently created by the author (as opposed to copied from other works), and
 13 that it possesses at least some minimal degree of creativity.”). Courts view a
 14 copyrightable work as a whole, and do not dissect copyrighted works into separate
 15 components as Defendant attempts here, because to do so would be “akin to
 16 accepting the position that every song is merely a collection of basic notes, every
 17 painting a derivative work of color and stroke, and every novel merely an
 18 unprotected jumble of words.” *Yurman Design, Inc. v. PAJ, Inc.*, 93 F. Supp. 2d
 19 449, 457 (S.D.N.Y. 2000) (“As the district court noted, if we took this argument

20 _____
 21 ¹ ComicMix also fails to address the Ninth Circuit’s two-part analysis—the
 22 extrinsic and intrinsic tests—to determine whether two works are substantially
 23 similar. See *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002).
 24 Likewise, ComicMix does not address the “inverse ratio rule,” which applies here,
 25 given Defendants’ undisputed access to the DSE Works, “justify[ing] a lower
 26 standard of proof [for DSE] to show substantial similarity.” *Shaw v. Lindheim*, 919
 27 F.2d 1353, 1361 (9th Cir. 1990). DSE’s allegations concerning infringement of the
 28 DSE Works satisfy the extrinsic test prong of substantial similarity and, thus,
 survive the Motion. (See Compl. at ¶¶ 18-31.)

² As discussed in detail further below, the “fair use” defense is inappropriate for
 consideration on this Motion. Moreover, ComicMix’s slipshod approach to
 filtering out certain “unprotectable” elements of the DSE Works, “mischaracterizes
 the scope of [DSE’s] copyright claims.” *Paramount Pictures Corp. v. Axanar
 Prods., Inc.*, No. CV 15-09938, 2016 WL 2967959, *5 (C.D. Cal. May 9, 2016)
 (denying defendants’ motion to dismiss plaintiffs’ copyright claim).

1 [that court was required to dissect copyrighted designs into separate components] to
2 its logical conclusion, we might have to decide that there can be no originality in a
3 painting because all colors or paint have been used somewhere in the past.”).

4 On this point, the court’s analysis in *Paramount* is instructive. There,
5 Paramount Pictures Corporation and CBS Studios Inc. (collectively “Paramount”),
6 owners of the copyrights in the Star Trek franchise, which includes six television
7 series and twelve motion pictures spanning nearly fifty years, brought a copyright
8 infringement action against Axanar Productions, Inc. and Alec Peters (collectively
9 “Axanar”) arising out of Axanar’s creation of two films, which allegedly copied
10 numerous protected elements from the Star Trek works, including elements of the
11 Battle of Axanar, characters, species, costumes, makeup, weapons, and starships.
12 *Paramount Pictures*, 2016 WL 2967959 at *1-2.

13 The court denied Axanar’s 12(b)(6) motion to dismiss, rejecting Axanar’s
14 argument that Paramount’s copyright claims should be dismissed because these
15 elements are not individually protectable. *Id.* at *5. Specifically, Axanar argued, as
16 Defendant does here, that the court must “filter out” non-protectable elements of the
17 Star Trek works, such as: “(1) costumes; (2) geometric shapes (e.g., the Starfleet
18 command insignia); (3) words and short phrases (e.g., the names of planets or
19 races); (4) elements of works derived from nature, the public domain, or third party
20 works (e.g., Vulcans’ appearance with pointy ears or the concept of warp drive); (5)
21 the Klingon language; (6) the mood or theme of “science fiction action adventure”;
22 (7) scenes-a-faire elements (e.g., staples of science fiction such as starships and
23 medals on uniforms); and (8) characters identified by [Paramount] (e.g., Garth of
24 Izar, Soval, and Robau.” *Id.* The court rejected Axanar’s dissection of the Star
25 Trek works into individual elements and held that this “argument mischaracterizes
26 the scope of [Paramount’s] copyright claims.” *Id.* The court further stated:

27 When viewed in a vacuum, each of these elements may
28 not individually be protectable by copyright. Plaintiffs,
however, do not seek to enforce their copyright in each of

1 these elements individually. Rather, Plaintiffs' copyright
 2 infringement claims are based on the Star Trek
 3 Copyrighted Works as a whole. The Complaint clearly
 4 defines the works at issue (the Star Trek Copyrighted
 5 Works), and includes the copyright registration numbers
 6 for the motion pictures and the first episode of each
 7 television series. The Court finds it unnecessary to
 8 analyze whether the allegedly non-protectable elements of
 9 the Star Trek Copyrighted Works are eligible for
 10 copyright protection because Plaintiff describes these
 11 elements in the Complaint solely in an effort to
 12 demonstrate how the Axanar Works are substantially
 13 similar to the Star Trek Copyrighted Works.

8 Further, even if each individual element were not
 9 protected by copyright, unprotectable elements "may gain
 10 some protection in combination with each other. Specific
 11 combinations of unprotectable elements may be
 12 copyrightable provided that the elements combined are
 13 numerous enough and their selection and arrangement
 14 original enough that their combination constitutes an
 15 original work of authorship."

13 *Id.* (citing *Muromura v. Rubin Rostaer & Associates*, CV 12-09263 DDP AGRX,
 14 2015 WL 1728324, at *3-4 (C.D. Cal. 2015)).

15 ComicMix's argument fails for the same reasons as Axanar's: like
 16 Paramount's, DSE's copyright infringement claims are based on the DSE Works *as*
 17 *a whole*. (Compl. at ¶¶ 45-50.) The Complaint clearly defines the works at issue,
 18 includes the copyright registration numbers for the works, (*id.* at App'x A), and
 19 describes Defendants' unauthorized use thereof in the Infringing Work. (*See id.* at
 20 ¶¶ 18-31.) Even if ComicMix had not misstated the law, however, and the Court
 21 were to accept the invitation to break down the DSE Works into individual
 22 elements, those elements of the DSE Works that Defendants have misappropriated
 23 are, in fact, copyrightable.³

25 ³ ComicMix also contends that its misappropriation of the title *Oh, The Places*
 26 *You'll Go!* is not actionable as copyright infringement. (Br. at 7.) However, DSE
 27 alleges that ComicMix's misappropriation of the title is actionable as *trademark*
 28 infringement, as discussed *infra* in Section III.B. (Compl. at ¶¶ 17, 51-57.) And,
 "[n]evertheless, if the copying of a title is not an act of copyright infringement, it
 may have copyright significance as one factor in establishing whether the substance
 of plaintiff's work (not the title) has been copied." *Shaw*, 919 F.2d at 1362.

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1 **Characters**: Contrary to ComicMix’s contention, “[c]ourts have recognized
2 that copyright protection extends not only to an original work as a whole, but also
3 to ‘sufficiently distinctive’ elements, like comic book characters, contained within
4 the work.” *DC Comics v. Towle*, 802 F.3d 1012, 1019 (9th Cir. 2015) (citing
5 *Halicki Films, LLC v. Sanderson Sales & Mktg.*, 547 F.3d 1213, 1224 (9th Cir.
6 2008)). And the Ninth Circuit has “long held that such characters are afforded
7 copyright protection.” *Id.* (citing *Walt Disney Productions v. Air Pirates*, 581 F.2d
8 751 (9th Cir. 1978)). To qualify for such protection, “a character must be
9 “sufficiently delineated” and display “consistent, widely identifiable traits.” *Id.*

10 ComicMix argues, without any supporting citation, that “DSE declines to
11 identify any such well-delineated character, leaving its allegations of character
12 ‘misappropriation’ wholly speculative.” (Br. at 8.) DSE’s well-pled allegations are
13 sufficient to support its copyright infringement claim. *See Paramount Pictures*,
14 2016 WL 2967959 at *5. Moreover, ComicMix’s conclusory argument that the
15 DSE Works contain no copyrightable characters is inappropriate for resolution at
16 the pleading stage since the issue of “whether a particular work is subject to
17 copyright protection is a mixed question of fact and law . . .” *DC Comics*, 802
18 F.3d at 1022. Indeed, the courts in ComicMix’s cited cases—*DC Comics* and *Rice*
19 *v. Fox Broad. Co.*, 330 F.3d 1170 (9th Cir. 2003)—decided the copyrightability
20 issue on a motion for summary judgment, and *not* on a Rule 12(b)(6) motion to
21 dismiss.

22 **“Story Arc”**: ComicMix contends that “[g]eneral plot lines are not
23 protected by copyright law,” (Br. at 8), which is an accurate reflection of the law.
24 *See Metcalf v. Bochco*, 294 F. 3d 1069, 1074 (9th Cir. 2002). However, ComicMix
25 overlooks that “protectable expression includes the specific details of an author’s
26 rendering of ideas, or the actual concrete elements that make up the total sequence
27 of events and the relationships between the major characters.” *Id.* (internal citation
28 omitted). Regardless of whether the similarities alleged are not protectable when

1 considered individually, because they are either “too generic” or constitute “scenes
2 a faire,” the overwhelming presence of *so many* similarities and common patterns
3 between the Infringing Work and the DSE Works would satisfy the extrinsic test at
4 this stage, had ComicMix moved to dismiss based on substantial similarity. *Id.*
5 (noting that “[t]he particular sequence in which an author strings a significant
6 number of unprotectable elements can itself be a protectable element. Each note in
7 a scale, for example, is not protectable, but a pattern of notes in a tune may earn
8 copyright protection. A common pattern that is sufficiently concrete warrants a
9 finding of substantial similarity.”)

10 Accordingly, Defendant’s arguments regarding the protectability of the DSE
11 Works fail. Its fair use arguments suffer a similar fate, as discussed below.

12 **1. Defendant’s Copyright Fair Use Defense Is Inappropriate**
13 **For Determination On A 12(b)(6) Motion.**

14 Rule 12(b)(6) motions are particularly unsuitable for adjudicating a fair use
15 defense to copyright infringement, such as that advanced herein by ComicMix. *See*
16 *e.g., Browne v. McCain*, 611 F. Supp. 2d 1073, 1078 (C.D. Cal. 2009) (“Generally,
17 when analyzing a Rule 12(b)(6) motion, a court’s analysis of the plaintiff’s claims
18 is limited to its allegations in the complaint. At this stage, a court does not make
19 factual findings, nor deem material facts undisputed or admitted. Thus, in light of a
20 court’s narrow inquiry at this stage and limited access to all potentially relevant and
21 material facts needed to undertake the analysis, courts rarely analyze fair use on a
22 12(b)(6) motion.”); *Four Navy Seals v. Associated Press*, 413 F. Supp. 2d 1136,
23 1148 (S.D. Cal. 2005) (12(b)(6) motion denied because fair use “is inappropriate
24 for determination in a 12(b)(6) motion, since fair use is an affirmative defense to an
25 infringement claim”); *Katzenbach v. Grant*, No. 04-cv-6501, 2005 WL 1378976,
26 *17 n.14 (E.D. Cal. June 7, 2005) (“the fair use defense is not appropriately decided
27 at the pleading stage.”); *Int-Elect Engineering, Inc. v. Clinton Harley Corp.*, No. C.
28 92-20718, 1993 WL 557639, at *2 (N.D. Cal. June 24, 1993); NIMMER ON

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-8-

1 COPYRIGHT § 13.05[A][5][a] (“Given the need to explore the factors as they
2 interact, it is typically impossible to dismiss a copyright infringement claim on the
3 basis of fair use....”). Thus, while possible in rare instances to decide fair use at the
4 pleading stage, it is inappropriate here, where significant material facts are
5 necessary to make a determination of fair use.⁴

6 **2. The Copyright Fair Use Doctrine, Even If Considered, Does** 7 **Not Absolve ComicMix Of Liability**

8 The Copyright Act sets forth four non-exclusive factors to be considered in
9 determining whether the use made of a work in any particular case is a fair use. 17
10 U.S.C. § 107. “All are to be explored, and the results weighed together, in light of
11 the purposes of copyright.” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578,
12 (1994).

13 **a. The Purpose and Character of the Use**

14 The first statutory factor analyzes “the purpose and character of the use,
15 including whether such use is of a commercial nature or is for nonprofit educational
16 purposes.” 17 U.S.C. § 107(1). The “central purpose” of this factor is to ask
17 “whether and to what extent the new work is ‘transformative.’” *Campbell*, 510
18 U.S. at 579.

19 There is nothing transformative about the Infringing Work. Instead, the
20 Infringing Work slavishly copies the DSE Works, recreating entire pages from the
21

22 ⁴ ComicMix asks the Court to take judicial notice of multiple “facts” extrinsic to the
23 Complaint for its fair use analysis. (*See Br. passim*; ECF Nos. 8-2.) For the
24 reasons set forth in DSE’s contemporaneously filed Opposition to ComicMix’s
25 Request for Judicial Notice, the Court should deny ComicMix’s RJN and disregard
26 such extrinsic “facts.” Moreover, ComicMix cites to numerous *Star Trek* episodes
27 in its brief (Br. at 13-15, n.9-11), apparently asking the Court to consider the
28 episodes’ content in its “fair use” analysis. Putting aside that ComicMix did not
properly request that the Court take judicial notice of these extrinsic “facts,” for the
reasons set forth in DSE’s Opposition to ComicMix’s Request for Judicial Notice,
filed contemporaneously herewith, the Court should disregard them, too, because
they are not be the proper subject of judicial notice. *See generally* Fed. R. Evid.
201(b); *Von Grabe v. Sprint PCS*, 312 F. Supp. 2d 1285, 1311 (S.D. Cal. 2003)
 (“[T]he Ninth Circuit tends to be strict with its application of Rule 201(b).”).

1 DSE Works with meticulous precision. (Compl. at ¶ 28.) ComicMix asserts that
2 the Infringing Work is “a détournement, parody, or pastiche, adding transformative
3 matter to DSE’s work.” (Br. at 10.) Defendants’ repeated characterization of the
4 Infringing Work as a parody is not credible. A parody is a “literary or artistic work
5 that imitates the characteristic style of an author or a work for comic effect or
6 ridicule.” *Campbell*, 510 U.S. at 580. The Infringing Work speaks for itself, and it
7 is devoid of social commentary, criticism, or ridicule of the DSE Works. While
8 Defendants have “broadly mimic[ked] Dr. Seuss’ characteristic style,” the
9 Infringing Work “does not hold his style up to ridicule.” *Dr. Seuss Enterprises,*
10 *L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997). The
11 Infringing Work has absolutely “no critical bearing on the substance or style of the
12 [DSE Works].” *Id.* Defendants have simply slavishly copied many of the most
13 recognizable and protected elements of the DSE Works in order to, apparently, “get
14 attention or maybe even to avoid the drudgery in working up something fresh.” *Id.*
15 Accordingly, the Infringing Work is not a parody, nor may it reasonably be
16 perceived as one. *Id.*; *Campbell*, 510 U.S. at 582 (“The threshold question when
17 fair use is raised in defense of parody is whether a parodic character may
18 reasonably be perceived.”).

19 Indeed, even before DSE filed this lawsuit, Defendants admitted their willful
20 and blatant infringement, and recognized that the Infringing Work was likely not a
21 parody. (Compl. at ¶ 35.) In its Motion, however, ComicMix spends seven pages
22 of its moving brief contriving a post hoc “transformative purpose” for the
23 Infringing Work. For example, ComicMix states that the Infringing Work’s “book-
24 length reframing of [the DSE Works] through the lens of Star Trek, while
25 irreverent, cheeky, and tongue-in-cheek, consistently turns to a critical re-
26 evaluation of priorities.” (Br. 13.) ComicMix’s re-characterization of the
27 Infringing Work’s content, after a lawsuit has been filed, has been employed by
28 copyright defendants before, and courts have held that after-the-fact claims of

1 criticism, commentary or parody are not to be given any weight, and have gone so
2 far as to label such post hoc rationales as “shtick.” *See Dr. Seuss*, 109 F.3d at 1403
3 (rejecting defendants’ arguments that their work was a parody as “pure shtick” and
4 “completely unconvincing”); *Salinger v. Colting*, 607 F.3d 68, 73 (2d Cir. 2010)
5 (finding defendants unlikely to prevail on fair use defense when their claim that
6 their work had a critical purpose was contradicted by earlier public statements);
7 *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1268 (11th Cir. 2001) (“The
8 fact that parody by definition must borrow elements from an existing work,
9 however, does not mean that every parody is shielded from a claim of copyright
10 infringement as a fair use.”); *Campbell*, 510 U.S. at 581 (“parody may or may not
11 be fair use, and [defendants’] suggestion that any parodic use is presumptively fair
12 has no more justification in law or fact than the equally hopeful claim that any use
13 for news reporting should be presumed fair”); *cf Burnett v. Twentieth Century Fox*
14 *Film Corp.*, 491 F. Supp. 2d 962, 972 (C.D. Cal. 2007) (“[T]he cry of ‘parody!’
15 does not magically fend off otherwise legitimate claims of trademark infringement
16 or dilution.”).

17 DSE alleges—and ComicMix does not dispute—that Defendants, without
18 authorization, copied the DSE Works, and recreated entire pages therefrom with
19 meticulous precision. (Compl. at ¶¶ 18-28.) Far from being “transformative,” the
20 Infringing Work is meant to faithfully recreate many of the most recognizable and
21 protected elements of the DSE Works. Courts have held that using copyrighted
22 elements, and placing those elements into a new story, is not transformative, and
23 simply constitutes the unauthorized production of an infringing derivative work.
24 *See Dr. Seuss*, 109 F.3d at 1402; *Paramount Pictures Corp. v. Axanar Prods., Inc.*,
25 15-cv-09938, 2017 WL 83506, at * 5 (C.D. Cal. Jan. 3, 2017) (holding that the
26 infringing works were not transformative because, among other reasons, defendants
27 “intentionally use[d] or reference[d] many elements similar to those in the Star Trek
28 Copyrighted Works to stay true to Star Trek canon down to excruciating details”);

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1 *see also Salinger v. Colting*, 641 F. Supp. 2d 250, 262 (S.D.N.Y. 2009) (“As the
2 Second Circuit clearly noted..., just because a work recast[s], transform[s], or
3 adapt[s] an original work into a new mode of presentation, thus making it a
4 ‘derivative work’ under 17 U.S.C. § 101, does not make the work ‘transformative’
5 in the sense of the first fair use factor....”) (internal citations and quotations
6 omitted)).

7 Moreover, Defendants’ use “is of a commercial nature,” and is not “for
8 nonprofit educational purposes.” 17 U.S.C. § 107(1). “And commercial use of
9 copyrighted material is ‘presumptively an unfair exploitation of the monopoly
10 privilege that belongs to the owner of the copyright.’” *Leadsinger, Inc. v. BMG*
11 *Music Publ’g.*, 512 F.3d 522, 530 (9th Cir. 2008) (quoting *Sony Corp. of America*,
12 464 U.S. at 451)). Indeed, DSE alleges that “Defendants have raised nearly
13 \$30,000 so far to produce the Infringing Work, and have agreed to a publishing
14 deal, intending to print and ship thousands of copies of the Infringing Work....”
15 (Compl. at ¶ 2.)⁵ The first factor therefore cuts against fair use.

16 **b. The Nature of the Copyrighted Work**

17 A work “of creative expression, as opposed to an informational work, [] is
18 precisely the sort of expression that the copyright law aims to protect.” *Leadsinger*,
19 512 F.3d at 531 (finding that the second factor weighs in copyright owner’s favor
20 because the work at issue was a creative one). The DSE Works are indisputably
21 works of highly creative expression. *See Paramount Pictures*, 2017 WL83506 at
22 *8 (“The creativity in these [Star Trek works] and their status as published works
23

24 ⁵ To the extent that the Court takes judicial notice of ComicMix’s counsel’s
25 October 28, 2016 letter to DSE’s counsel, therein ComicMix further described the
26 nature of its planned commercial exploitation of the DSE Works: “Andrews
27 McMeel Publishing had agreed to publish the book and planned to rush it out for
28 release in time for Christmas, but has pulled out entirely because of your notice.
Also anticipating Christmas sales, one vendor ordered 5,000 copies of the book as
long as printing and shipping are completed by November 11, but ComicMix
expects to lose that order because, thanks to your notice, Kickstarter is withholding
all \$29,575 that the campaign raised, so ComicMix cannot use that money to cover
the printing costs as intended.” (ECF No. 8-8 at 1.)

1 are not disputed. They are the type of works that are given broad copyright
 2 protections.”). Other than its feeble contention that this factor “has negligible
 3 weight in this case,” by circling back to its failing transformative use and parody
 4 arguments (Br. at 16-17), ComicMix does not proffer any basis upon which to find
 5 that this factor weighs in its favor. The factor favors DSE.

6 **c. The Amount and Substantiality of the Portion Used**

7 The third factor provided by the Copyright Act is “the amount and
 8 substantiality of the portion used in relation to the copyrighted work as a whole,”
 9 17 U.S.C. § 107(3), which necessarily “includes a determination of not just
 10 quantitative, but also qualitative substantiality.” NIMMER ON COPYRIGHT,
 11 §13.05[A][3]. ComicMix contends that defendants took from DSE’s works no
 12 more than is necessary for their intended use: parody. (Br. 17-18.) But
 13 ComicMix’s argument is belied by its “slavish copying of the Dr. Seuss
 14 Copyrighted Works, which attempt to recreate entire pages from the Dr. Seuss
 15 Books with meticulous precision.” (Compl. at ¶ 28; *compare* ECF No. 8-9 with
 16 ECF No. 8-10.) Here, Defendants intentionally and blatantly use many of the most
 17 recognizable and protected elements of the DSE Works to create a work that
 18 “stay[s] true to [Seuss] canon down to excruciating details.” *Paramount*, 2017 WL
 19 83506 at *8 (concluding that this factor favors Paramount, despite Axanar’s parody
 20 arguments, because “it is fair to say that elements of the Star Trek Copyrighted
 21 Works pervade the Axanar Works”). Indeed, the misappropriated elements are
 22 “qualitatively important because they give the [Infringing Work] the [Seuss] feel
 23 and enable Defendants to stay true to the [Seuss] canon.” *Id.* Moreover, as
 24 discussed above, despite ComicMix’s characterization of the Infringing Work as a
 25 parody, it is devoid of social commentary, criticism, satire, or ridicule of the DSE
 26 Works. This factor, too, weighs against fair use.

27 ////

28 ////

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1 **d. The Effect of the Use Upon the Potential Market**

2 The fourth and “single most important element of fair use” also weighs
3 strongly in favor of DSE. *Harper & Row Publishers v. Nation Enterprises*, 471
4 U.S. 539, 566 (1985). This factor is “the effect of the use upon the potential market
5 for or value of the copyrighted work.” 17 U.S.C. § 107(4). This factor’s analysis
6 “requires courts to consider not only the extent of market harm caused by the
7 particular actions of the alleged infringer, but also whether unrestricted and
8 widespread conduct of the sort engaged in by the defendant would result in a
9 substantially adverse impact [of market substitution] for the original” and for
10 derivative works. *Campbell*, 510 U.S. at 587, 590 (internal quotation marks and
11 alteration omitted). And, “[s]ince fair use is an affirmative defense, its proponent
12 would have difficulty carrying the burden of demonstrating fair use without
13 favorable evidence about relevant markets.” *Id.* at 590 (citing *Harper & Row*, 471
14 U.S. at 561). “The market for potential derivative uses includes only those that
15 creators of original works would in general develop or license others to develop.”
16 *Id.* at 592.

17 This factor is particularly unsuitable for resolution on ComicMix’s Motion
18 because “in order to undertake the fair use analysis, a court usually must make
19 factual findings, or rely on undisputed or admitted material facts.” *Browne v.*
20 *McCain*, 612 F. Supp. 2d 1125, 1130 (C.D. Cal. 2009) (citing *Harper & Row*, 471
21 U.S. at 560). The Court must accept as true DSE’s specific allegations as to the
22 harm that will result from Defendants’ unauthorized use of the DSE Work.
23 *Vasquez*, 487 F.3d at 1249. ComicMix will not be able to prove its bald assertion
24 that “[t]here is no likelihood of market substitution.” (Br. at 19.) ComicMix does
25 not even discuss the relevant markets for the DSE Works and the Infringing Work,
26 let alone proffer any evidence to support its conclusory assertion. ComicMix’s
27 Motion cannot discharge Defendants’ “burden of demonstrating fair use without
28 favorable evidence about relevant markets.” *Campbell*, 510 U.S. at 590.

1 Defendants' creation and dissemination of an unlicensed derivative work of
2 the DSE Works presents a substantial risk of harm to the value of the DSE Works
3 and also to DSE's market for derivative works. As is alleged in the Complaint, Dr.
4 Seuss wrote, illustrated, and published almost 60 books in his lifetime, and DSE has
5 published additional books posthumously. (Compl. at ¶ 12.) Defendants' conduct,
6 if left unchecked, would permit Defendants (and others) to infringe upon DSE's
7 market, and create works based on, and substantially similar to, the DSE Works that
8 incorporate similar, or identical, characters, settings, themes, plots, and dialogue.

9 In addition, here, the Infringing Work is the kind of potential derivative work
10 that DSE could "in general develop or license others to develop." *Campbell*, 510
11 U.S. at 592; *see also*, *Paramount*, 2017 WL 83506 at *9. ("Here, the [Infringing
12 Work] is the kind of potential derivatives Plaintiffs 'would in general develop or
13 license others to develop.'"). Indeed, as DSE alleges in the Complaint, "[i]t is not
14 uncommon for DSE to license the Dr. Seuss Intellectual Property in connection with
15 the creation of new works based upon, and incorporating, the Dr. Seuss Intellectual
16 Property. Such licensing activities have included collaborations with other rights
17 holders. Here, however, Defendants created the Infringing Work without license or
18 authorization from DSE, and thereby usurped DSE's licensing opportunities."
19 (Compl. at ¶ 32.) This allegation, which must be accepted as true on a 12(b)(6)
20 motion, *Leadsinger*, 512 F.3d at 526, cuts sharply against ComicMix's conclusory
21 and unsupported contention that "[t]here is no likelihood of market substitution,"
22 (Br. 19) which is insufficient to sway this factor in its favor.

23 Finally, ComicMix argues that the Infringing Work would actually increase
24 the value of the Dr. Seuss Copyrighted Works. (Br. at 19.) Even if this
25 unsupported, bizarre allegation that Defendant's free-riding plagiarism somehow
26 helps DSE, "the boon to the [latter] does not make [Defendants'] copying fair."
27 *Campbell*, 510 U.S. at 591 n.21. At the very least, the issue of whether the
28 Defendants' use and the Infringing Work will appreciably harm the value of the

1 DSE Works or DSE's market simply cannot be made without discovery and further
2 development of record evidence on the issue. *Campbell*, 510 U.S. at 590. This
3 factor thus strongly weighs against fair use.

4 In sum, while ComicMix's fair use arguments are ill-suited for a motion to
5 dismiss, it is nevertheless clear that the defense is exceedingly weak. ComicMix's
6 motion to dismiss DSE's copyright claim should thus be denied.

7 **B. ComicMix's Motion To Dismiss DSE's Trademark and Unfair**
8 **Competition Claims Fails**

9 "To state a cause of action for trademark infringement, a plaintiff must allege
10 that (1) it has a trademark right; (2) that was used by defendant; (3) in a way that is
11 likely to cause consumer confusion and thus infringe upon the trademark right."
12 *Adobe Sys. Inc. v. Blue Source Group, Inc.*, 125 F. Supp. 3d 945, 966 (N.D. Cal.
13 2015) (citing *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1354 (9th Cir.
14 1985)); *see also Adobe Sys. Inc. v. Software Tech*, 14-cv-02140, 2016 WL 4728119,
15 at *4 (N.D. Cal. Sep. 8, 2006); *Dita v. Mendez*, No. 10-cv-6277, 2010 WL
16 5140855, at *5 (C.D. Cal. Dec. 14, 2010). DSE easily meets these pleading
17 requirements, as it alleges that: (1) it owns trademark rights in specific aspects of
18 the DSE works that function as indicators of source, and that those trademarks are
19 distinctive and have acquired secondary meaning in the minds of the public
20 (Compl. ¶¶ 17, 52); (2) Defendants have used those trademarks without
21 authorization (Compl. ¶¶ 27-29, 33); and (3) Defendants' use of DSE's trademarks
22 is likely to cause consumer confusion. (Compl. ¶¶ 33, 53.)

23 Despite these sufficient allegations, ComicMix launches several attacks on
24 DSE's trademark claims, that: (1) the trademark claims are "precluded" by the
25 Copyright Act (Br. at 20-21); (2) the title *Oh, The Places You'll Go!* cannot
26 function as a trademark (Br. at 21); (3) use of DSE's marks is not infringement
27 under the First Amendment (Br. at 21-22); and (4) the nominative fair use doctrine
28 shields Defendants from liability (Br. at 22-24.) All of these arguments fail.

1 **1. DSE’s Trademark Claims Are Not Preempted By The**
2 **Copyright Act**

3 First, ComicMix’s assertion that DSE’s trademark claims are precluded by
4 the Copyright Act is incorrect as a matter of law. Indeed, *RDF Media Ltd. v. Fox*
5 *Broad. Co.*, 372 F. Supp. 2d 556, 562 (C.D. Cal. 2005), which ComicMix cites in
6 its moving brief (Br. at 20), explains that “trademark and copyright protection may
7 coexist.” *Id.* at 564. While true that the protection of the entire creative expression
8 of an artistic work falls within the purview of copyright, and not trademark law,
9 *RDF Media*, 372 F. Supp. 2d at 562, DSE’s trademark claims are not for the
10 entirety of the DSE works at issue, as asserted by plaintiff in *RDF Media*, but rather
11 are for discrete “aspects” of those works that are alleged to function as “indicators
12 of source.” (See Compl. ¶ 17.) There is no legal basis to assert that aspects of
13 artistic works cannot function as trademarks, particularly where, as here, DSE is
14 asserting distinct claims: one for copyright infringement of its creative works, and
15 one for unauthorized use of source-identifying aspects of those works such that
16 consumer confusion is likely. See *Bach v. Forever Living Products U.S., Inc.*, 473
17 F. Supp. 2d 1110, 1117-18 (W.D. Wash. 2007) (“FLP argues that the claims
18 overlap because the complaint relies on similar factual allegations of copying for
19 both its trademark and copyright claims. But as Plaintiffs point out, Plaintiffs are
20 seeking remedies for distinct wrongs under each legal framework.”); 1 MCCARTHY
21 ON TRADEMARKS AND UNFAIR COMPETITION § 6:17.50 (4th ed.) (“In general, there
22 is no reason why a given work cannot be the subject of both trademark and
23 copyright protection.”) Indeed, the Ninth Circuit acknowledged in *Dr. Seuss*, 109
24 F.3d at 1403, that “Seuss owns the common law trademark rights to the words ‘Dr.
25 Seuss’ and ‘Cat in the Hat,’ as well as the character illustration of the Cat’s stove-
26 pipe hat.” *Id.* The fact that these indicators of source were contained in a literary
27 work did not somehow disqualify them from trademark protection. And, as
28 explained in *Whitehead v. CBS/Viacom, Inc.*, 315 F. Supp. 2d 1, 13 (D.D.C. 2004),

1 titles of books, plays, films, and songs, distinctive elements of a television series,
 2 and distinctive comic book characters, have qualified as marks entitled to protection
 3 under Section 1127 of the Lanham Act. *See id.* (gathering cases). There is also no
 4 question that a distinctive font can qualify for trademark protection as alleged by
 5 DSE here (Compl. ¶ 17), and is not preempted by copyright. *See* 2 MCCARTHY §
 6 12:59 (4th ed.) (“Federal trademark protection for a distinctive typeface or lettering
 7 design would not be preempted, pursuant to Copyright Act.”); *see also, Star Indus.,*
 8 *Inc. v. Bacardi & Co.*, 412 F.3d 373, 382 (2d Cir. 2005) (“[S]tylized shapes or
 9 letters may qualify [as inherently distinctive], provided the design is not
 10 commonplace but rather unique or unusual in the relevant market.”).

11 ComicMix’s first attack thus fails.

12 2. Titles Can Function As Trademarks

13 ComicMix next asserts that the title *Oh, The Places You’ll Go!* cannot
 14 perform a trademark function (Br. at 21); but this argument fares no better. Indeed,
 15 *EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopulos, Inc.*, 228 F.3d 59,
 16 63 (2d Cir. 2000), which ComicMix cites in its moving brief (Br. at 20), states that
 17 “[t]itles of works of artistic expression, including films, plays, books, and songs,
 18 that have acquired secondary meaning are protected from unfair competition under
 19 § 43(a).” *Id.*; *see also Am. Express Co. v. Goetz*, 515 F.3d 156 (2d Cir. 2000) (song
 20 titles amenable to trademark protection) (also cited by ComicMix (Br. at 20));
 21 *Kiedis v. Showtime Networks*, No. 07-cv-8185, 2008 WL 11173143, at *3 (C.D.
 22 Cal. Feb. 19, 2008) (“As the Second Circuit noted, ‘it would be ironic if, in the
 23 name of the First Amendment, courts did not recognize the right of authors to
 24 protect titles of their creative work against infringement by other authors.’
 25 Consumers, too, benefit when titles receive some trademark protection; artistic
 26 works are commodities ‘sold in the commercial marketplace like other more
 27 utilitarian products, making the danger of consumer deception a legitimate
 28 concern.... The purchaser of a book, like the purchaser of a can of peas, has a right

1 not to be misled as to the source of the product.”) (quoting *Rogers v. Grimaldi*, 875
 2 F.2d 994, 997–98 (2d Cir. 1989)). DSE alleges that the *Oh, The Places You’ll Go!*
 3 has obtained secondary meaning, and is a protectable mark. (Compl. at ¶¶ 17, 52.)

4 ComicMix’s second attack on DSE’s trademark claim is thus meritless.

5 3. ComicMix’s First Amendment Arguments Fail

6 Next, ComicMix contends that, under *Rogers v. Grimaldi*, 875 F.2d 994 (2d
 7 Cir. 1989) and its progeny, its unauthorized uses of DSE’s marks “merit First
 8 Amendment protection.” (Br. at 22.) ComicMix is wrong. In *Rogers*, the Second
 9 Circuit held that the title of the artistic work at issue would not support a Lanham
 10 Act claim unless the title either has no artistic relevance, or if it does, it if explicitly
 11 misleads as to the source or content of the work. *Id.* ComicMix thus asserts that its
 12 motion to dismiss should be granted because the title *Oh, The Places You’ll Boldly*
 13 *Go!* and its other trademark infringements have “at least some artistic relevance”
 14 and that “there is nothing misleading” about the Infringing Work. (Br. at 22.)

15 In advancing a *Rogers* argument with regard to the title of the Infringing
 16 Work, Defendant ignores the most relevant portion of *Rogers*, that “this limiting
 17 construction would not apply to misleading titles that are confusingly similar to
 18 other titles. The public interest in sparing consumers this type of confusion
 19 outweighs the slight public interest in permitting authors to use such titles.” *Id.* at
 20 999, n.5 (emphasis added); *see also, e.g., Kiedis*, 2008 WL 11173143, at *4
 21 (“Defendants acknowledge that the Ninth Circuit adopted this test from the Second
 22 Circuit’s opinion in *Rogers*, but ignore the fact that *Rogers* exempted works with
 23 ‘confusingly similar’ titles from this test. . . . as the risk of consumer confusion is
 24 higher when ‘confusingly similar’ titles are involved, the Court cannot hold, as a
 25 matter of law, that Defendants are entitled to the across-the-board protection of the
 26 two-part test used in the *MCA* case.”); *Toho Co, Ltd. v. William Morrow & Co.,*
 27 *Inc.*, 33 F. Supp. 2d 1206, 1212 (C.D. Cal. 1998) (citing *Rogers* and rejecting
 28 defendant’s First Amendment defense to its use of the title “Godzilla” for its

1 motion picture, alleged to infringe plaintiff’s own movie title.); *Morgan Creek*
2 *Productions, Inc. v. Capital Cities/ABC, Inc.*, 89-cv-5463, 1991 WL 352619, at *4
3 (C.D. Cal. Oct. 28, 1991) (“Neither *New Kids* nor *Rogers* dealt with an allegation
4 that one artistic title was confusingly similar to another. On the contrary.”).

5 Here, DSE alleges that *Oh, The Places You’ll Boldly Go!* is confusingly
6 similar to its own title, *Oh, The Places You’ll Go!*. (See Compl. ¶¶ 17, 30.) In light
7 of the authority discussed above, ComicMix’s First Amendment/*Rogers* defense as
8 to the title of the Infringing Work is thus misplaced and unavailing, particularly on
9 a Rule 12(b)(6) motion to dismiss.

10 In addition, the *Rogers* court held that the Lanham Act should be construed
11 to apply to artistic works “only where the public interest in avoiding consumer
12 confusion outweighs the public interest in free expression.” *Rogers*, 875 F.2d at
13 999. Accordingly, ComicMix’s First Amendment defense inherently requires a
14 determination of consumer confusion pursuant to *AMF, Inc. v. Sleekcraft Boats*,
15 599 F.2d 341, 348–49 (9th Cir. 1979). See *Warner Bros. Ent’tmt v. Global Asylum,*
16 *Inc.*, 12-cv-9547, 2012 WL 6951315, at * (C.D. Cal. Dec. 10, 2012) (“[T]he Court
17 concludes that the *Rogers* defense would also fail because the title is explicitly
18 misleading. In determining whether the title is explicitly misleads consumers,
19 courts apply the *Sleekcraft* likelihood of confusion factors discussed above.”);
20 *Kiedis*, 2008 WL 11173143, at *5 (“The First Amendment concerns in this case
21 modify the standard likelihood of confusion test somewhat, in that a weak level of
22 potential confusion, even if proven, could nonetheless be outweighed by the need to
23 protect Defendants’ right to free expression. But Defendants are not entitled to
24 absolute protection from liability under the Lanham Act, or its state law equivalent,
25 simply because they have created an ‘artistic’ work.”); *Toho Co, Ltd.*, 33 F. Supp.
26 2d at 1212 (assessing consumer confusion in connection with First Amendment
27 defense). It is well-established that a *Sleekcraft* determination is highly factual, and
28 that while possible to decide as a matter of law, *Murray v. Cable Nat’l Broad. Co.*,

1 86 F.3d 858, 860 (9th Cir. 1996), is ill-suited for a motion to dismiss. *See, e.g.,*
 2 *Celebrity Chefs Tour, LLC v. Macy's, Inc.*, 16 F. Supp. 3d 1159, 1166 (S.D. Cal.
 3 2014) (“[W]hile likelihood of confusion is capable of being decided as a matter of
 4 law, ‘[w]hether confusion is likely is a factual determination woven into the law’
 5 that courts ‘routinely treat ... as [an issue] of fact’ best left for determination by a
 6 jury.”) (quoting *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1356, 1356
 7 n.5 (9th Cir. 1985) (emphasis in original)); *Parts.com, LLC v. Yahoo! Inc.*, 996 F.
 8 Supp. 2d 933, 936 (S.D. Cal. 2013) (same); *Americas Outlaw Spirits Inc. v. Steven*
 9 *Gunn*, 12-cv-04132, 2012 WL 12886419, at *2 (C.D. Cal. Sep. 21, 2012) (“‘[T]he
 10 likelihood of confusion inquiry is a fact-intensive evaluation ill suited for
 11 disposition on a motion to dismiss.’”) (quoting *Lucent Techs., Inc. v. Johnson*, 2000
 12 U.S. Dist. LEXIS 16002, at *6 (C.D. Cal. 2000)).⁶

13 Even if ComicMix had attempted to make a showing that no likelihood of
 14 confusion exists here,⁷ such an argument fails because, on a 12(b)(6) motion to
 15 dismiss, DSE’s allegations are construed in its favor, and DSE sufficiently alleges
 16 consumer confusion. (*See* Compl. at ¶¶ 30, 33, 53, 67, 61-62.) For example, in
 17

18 ⁶ Moreover, *Rogers* is only applied by the Ninth Circuit where the mark at issue is
 19 imbued “with a meaning beyond its source-identifying function.” *Mattel, Inc. v.*
 20 *MCA Records, Inc.*, 296 F.3d 894, 900 (N.D. Cal. 2014). ComicMix has not shown
 21 that any of the DSE marks have “gained such widespread cultural and linguistic
 22 prominence as ‘Barbie’, ‘Rolls Royce’ or ‘aspirin’” such that *Rogers* would apply.
 23 *Warner Bros.*, 2012 WL 6951315, at *16.

24 ⁷ Defendant completely ignores the requirement to analyze confusion under
 25 *Sleekcraft*, instead stating in conclusory fashion that there is nothing misleading
 26 about its work because of a disclaimer claiming that the work is a parody. (Br. at
 27 22.) The disclaimer at issue appears in small font on the third page of the
 28 Infringing Work. (Ex. 5 at 3.) Even disclaimers that appear on covers of works
 (not buried on the third page) have been found to be “ineffective” and would “not
 alleviate the potential for consumer confusion.” *Toho Co., Ltd.*, 33 F. Supp. 2d at
 1213. Moreover, Defendant’s invocation of “parody” is not proof that the
 Infringing Work qualifies as one. Indeed, “[s]ome parodies will constitute
 infringement, some will not. But the cry of ‘parody!’ does not magically fend off
 otherwise legitimate claims of trademark infringement or dilution. There are
 confusing parodies and non-confusing parodies. All they have in common is an
 attempt at humor through the use of someone else’s trademark.” *Burnett*, 491 F.
 Supp. 2d at 972 (internal quotation marks omitted).

1 *Dita v. Mendez*, No. 10-cv-6277, 2010 WL 5140855, at *3 (C.D. Cal. Dec. 14,
 2 2010), defendant, like ComicMix here, moved to dismiss a trademark claim under
 3 *Rogers*, arguing that the allegedly infringing mark was used in connection with an
 4 artistic work and that the complaint failed to establish any possibility that the public
 5 was confused or misled. *Id.* The court denied the motion, holding that,
 6 “Defendant’s claim cannot prevail on a motion to dismiss in light of the specific
 7 allegations asserted in the Complaint. Not only does the Complaint allege that
 8 Defendant’s use of the mark is likely to cause consumer confusion, it asserts that
 9 Defendant actually intended to mislead the public as to the source or the content of
 10 the work.” *Id.* (emphasis in original). Thus, the court held, those allegations
 11 “expressly negate the second prong of the *Rogers* test.” *Id.* So too here: DSE has
 12 not only pled that a likelihood of confusion exists, that both works are books, that
 13 the infringement usurped DSE’s licensing activities, and that the relevant universe
 14 of consumers are the same (*see* Compl. at ¶¶ 30, 32, 33, 53, 67, 61-62), but that
 15 Defendants’ conduct “has been intentional and willful and is calculated specifically
 16 to trade off the goodwill that DSE has developed in its Dr. Seuss Marks.” (Compl.
 17 ¶ 56.) As such, “after taking all allegations of material fact as true and construing
 18 them in the light most favorable to the nonmoving party,” *Dita*, 2010 WL 5140855,
 19 at *3, ComicMix’s First Amendment argument should be rejected. *See also, e.g.,*
 20 *Celebrity Chefs Tour, LLC*, 16 F. Supp. 3d at 1167 ; *Parts.com, LLC*, 996 F. Supp.
 21 2d at 937-38; *Americas Outlaw Spirits Inc.*, 2012 WL 12886419, at *3-4 (all
 22 finding allegations in a complaint to defeat a motion to dismiss on likelihood of
 23 confusion as a matter of law.)

24 4. ComicMix’s Nominative Fair Use Argument Is Premature

25 Finally, ComicMix asserts a defense of nominative fair use, which requires
 26 proof of three elements: “First, the product or service in question must be one not
 27 readily identifiable without use of the trademark; second, only so much of the mark
 28 or marks may be used as is reasonably necessary to identify the product or service;

1 and third, the user must do nothing that would, in conjunction with the mark,
2 suggest sponsorship or endorsement by the trademark holder.” *New Kids on the*
3 *Block v. News Am. Publ’g Inc.*, 971 F.2d 302, 308 (9th Cir. 1992). “Nominative
4 fair use analysis typically involves questions of law and fact, and determination on
5 a motion to dismiss is premature.” *Electronic Arts, Inc. v. Textron Inc.*, No. C 12-
6 00118, 2012 WL 3042668, at *5 (N.D. Cal. July 12, 2012); *see also KP Permanent*
7 *Make-Up, Inc. v. Lasting Impression, Inc.*, 408 F.3d 596, 609 (9th Cir. 2005) (fair
8 use analysis involves questions of facts), *Autodesk, Inc. v. Dassault Sys. Solidworks*
9 *Corp.*, No. C 08–04397 WHA, 2008 WL 6742224, at *5 (N.D. Cal. Dec.18, 2008)
10 (stating “analysis of nominative fair use is premature on a motion to dismiss”);
11 *Powerlineman.com, LLC v. Jackson*, No. CIV. S–070879 LKK/EFB, 2007 WL
12 3479562, at *4 (E.D. Cal. Nov.15, 2007) (same); *Yeager v. Cingular Wireless LLC*,
13 627 F. Supp. 2d 1170, 1178 (E.D. Cal. 2008) (court could not find third element of
14 nominative fair use test satisfied as a matter of law, and therefore could not
15 dismiss); *Designer Skin, LLC v. S & L Vitamins, Inc.*, No. CV 05–3699 PHXJAT,
16 2007 WL 841471, at *2 (D. Ariz. Mar. 19, 2007) (denying motion to dismiss
17 because “after identifying the three prongs of nominative fair use, Defendants fail
18 to apply them to this case”).

19 ComicMix proffers mere conclusory and unsupported statements as to why
20 the three nominative fair use factors favor its position. (Br. at 23-24.) But none of
21 ComicMix’s conclusory statements trump the Complaint’s allegations and permit
22 the Court to conclude that this affirmative defense applies as a matter of law on a
23 motion to dismiss. *See Gorski v. The Gymboree Corp.*, No. 14-cv-01314, 2014 WL
24 3533324, at *7 (N.D. Cal. July 16, 2014) (motion to dismiss on nominative fair use
25 denied in light of complaint allegations of confusion as to sponsorship or
26 endorsement).

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1 Indeed, just as a First Amendment defense requires an assessment of
2 likelihood of confusion, so too does the third factor of the nominative fair use test.
3 *Id.*; see also *Yeager*, 627 F. Supp. 2d at 1178.⁸ Again, as discussed above,
4 ComicMix has not even argued that there is no likelihood of confusion here.

5 Accordingly, ComicMix’s nominative fair use argument fails.

6 **IV. CONCLUSION**

7 For the foregoing reasons, DSE respectfully submits that ComicMix’s
8 Motion to Dismiss be denied in its entirety.

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10 Dated: January 19, 2017

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⁸ Defendant fails to cite a single case where a court has, on a 12(b)(6) motion, dismissed a trademark claim based on the nominative fair use defense. Indeed, ComicMix cites to *In re: Dual-Deck Video Cassette Recorded Antitrust Litigation*, 11 F.3d 1460 (9th Cir. 1993). (Br. at 6.) *Dual-Deck* related to the materially different *classic fair use* defense and is, thus, wholly inapplicable to this case. *Id.* at 1466-67.

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CERTIFICATE OF SERVICE

I hereby certify that on January 19, 2017 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/ Gina Durham
Gina Durham