

Case No. 19-55348

**IN THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

DR. SEUSS ENTERPRISES, L.P.

Plaintiff-Appellant

v.

COMICMIX LLC, ET AL.

Defendants-Appellees

On Appeal from the United States District Court
for the Southern District of California
No. 3:16-cv-02779-JLS-BGS
Hon. Janis L. Sammartino

**BRIEF OF *AMICI CURIAE* ELECTRONIC FRONTIER FOUNDATION,
ORGANIZATION FOR TRANSFORMATIVE WORKS, PUBLIC
KNOWLEDGE, FRANCESCA COPPA, DAVID MACK, AND
MAGDALENE VISAGGIO IN SUPPORT OF DEFENDANTS-APPELLEES
AND AFFIRMANCE**

Dated: October 11, 2019

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CORPORATE DISCLOSURE STATEMENT

Pursuant to Rule 26.1 of the Federal Rules of Appellate Procedure, *amici curiae* Electronic Frontier Foundation, Public Knowledge, Organization for Transformative Works, Francesca Coppa, David Mack, and Magdalene Visaggio each state that they are individuals and/or that they do not have parent corporations and that no publicly held corporation owns ten percent or more of their stock.

Dated: October 11, 2019

By: /s/Mason Kortz
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STATEMENT OF COMPLIANCE WITH RULE 29

Pursuant to Federal Rule of Appellate Procedure 29(a)(2), *amici curiae* certify that all parties have consented to the filing of this brief.

Pursuant to Federal Rule of Appellate Procedure 29(a)(4)(E), *amici curiae* certify that no party's counsel authored this brief in whole or in part; no party or party's counsel contributed money that was intended to fund the preparation or submission of this brief; and no person — other than the amici curiae, their members, or their counsel — contributed money that was intended to fund the preparation or submission of this brief.

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STATEMENT OF INTEREST OF AMICI CURIAE

Amicus curiae Electronic Frontier Foundation (“EFF”) is a member-supported, non-profit civil liberties organization that works to protect free speech and privacy in the digital world. Founded in 1990, EFF and its over 32,000 dues-paying members have a strong interest in helping the courts and policymakers ensure that copyright law serves the interests of creators, innovators, and the general public.

Amicus curiae Organization for Transformative Works (“OTW”) is a non-profit organization dedicated to protecting and preserving non-commercial works created by fans based on existing works, including popular television shows, books, and movies. OTW’s “Archive of Our Own” also functions as a platform hosting transformative non-commercial works, supporting over 2,000,000 registered users and receiving upwards of 230 million page views per week.

Amicus curiae Public Knowledge (“PK”) is a non-profit organization that is dedicated to preserving the openness of the Internet and the public’s access to knowledge, promoting creativity through balanced intellectual property rights, and upholding and protecting the rights of consumers to use innovative technology lawfully. PK advocates on behalf of the public interest for a balanced copyright system, particularly with respect to new and emerging technologies.

Amicus curiae Francesca Coppa is a Professor of English and Director of Women's and Gender Studies at Muhlenberg College, where she teaches courses in dramatic literature, popular fiction, and mass media storytelling. A founding member of OTW, she is the author of *The Fanfiction Reader: Folk Tales for the Digital Age* (2017), which won the Prose Award for Best Book in Media and Cultural Studies. She has been an advocate for copyright reform and fair use. Her book on fan vidding, *Vidding: A History*, is forthcoming from the University of Michigan Press.

Amicus curiae David Mack is a *New York Times* bestselling author whose experience spans multiple media, including television, novels, comic books and video games. His work runs the gamut from comedy to drama, fantasy to science fiction, and includes numerous *Star Trek* novels and television scripts. As a literary artist, he depends upon the protection of the First Amendment and the standards of Fair Use.

Amicus curiae Magdalene Visaggio is the writer and creator of the Eisner-nominated comic series *Kim & Kim* and *Eternity Girl*, the latter for DC Comics. She is also the creator of *Vagrant Queen*, which will air on SyFy in 2020.

Amici curiae EFF, OTW, PK, Dr. Coppa, David Mack, and Magdalene Visaggio (“*Amici Curiae*” or “*Amici*”) share a strong interest in promoting a robust and balanced fair use doctrine. *Amici* have decades of collective experience and

expertise among them, advocating for the interests of creators and ensuring that copyright law (and, in particular, application of copyright’s fair use doctrine) serves to promote values of free speech and freedom of expression.

SUMMARY OF ARGUMENT

Millions of Americans communicate through the art of mash-up, putting multiple works in conversation with one another to create new expression. The district court correctly concluded that the fair use doctrine protects this important form of expression, which makes transformative use of source material from other works. *Amici* urge the Court to affirm that conclusion.

This case concerns two works: *Oh The Places You’ll Boldly Go!*, by David Gerrold and Ty Templeton (“*Boldly*”) and *Oh The Places You’ll Go!* by Theodore Geisler (professionally known as Dr. Seuss) (“*Go!*”) (the latter in the context of the works of Dr. Seuss more generally). The lower court found, correctly, that — to the extent that *Boldly* borrows from and builds upon copyrightable material embodied in *Go!* — such use constitutes fair use within the meaning of Section 107 of the United States Copyright Act. 17 U.S.C. § 107.

Boldly is a significantly transformative work within the meaning of copyright law. It recasts, recontextualizes, and adds new expression or meaning to *Go!* in order to create a new, significant work of creative expression. *Boldly* falls within the broader genre of “mash-ups,” which can be highly worthwhile works of

art that serve many purposes. Mash-ups often comment on the works on which they rely and compare their themes to those of other works. They also can provide a powerful way for marginalized groups to critique media and use existing cultural works to express a new, transformative meaning. *Boldly's* creative adaptation of selected parts of Dr. Seuss works is just one example of the expression that would be stifled by an overly restrictive application of copyright law.

ARGUMENT

I. *Boldly* Is a Highly Transformative Work Within the Meaning of the Fair Use Doctrine.

A. Transformative Works Like *Boldly* Satisfy the First Factor of the Fair Use Test and Further the Goals of Copyright Law.

Copyright's fair use doctrine protects the creation of transformative works, or those that "add[] something new, with a further purpose or different character, altering the [original work] with new expression, meaning, or message." *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).¹ In this way, the law recognizes that artists, thinkers, writers, and creators must have the freedom to build upon existing elements of culture to create new works that further enrich our society and advance the very purposes of copyright law. *Id.*; see Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1109 (1990).

¹ In recognizing that creativity requires "breathing space," the Supreme Court declared that "the goal of copyright . . . is generally furthered by the creation of transformative works." *Campbell*, 510 U.S. at 579.

Although transformative aspects of remix works, like mash-ups, often involve or imply commentary on the underlying work(s), a remix work does not have to comment on the original to be transformative for the purposes of the first fair use factor. *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1177 (9th Cir. 2013). This Court and other courts have found visual art works that use prior works as “raw material” to be transformative even when they fail to comment on or parody the original. For example, this Court held that Green Day’s use of a black and white illustration of a face frozen mid-scream, *Scream Icon*, as a backdrop for a music video was transformative. *Id.* at 1170. The poster was slightly weathered and had been spray-painted with a bright red cross. *Id.* at 1174. In holding that the use was transformative, this Court emphasized the difference between the “expressive content and message” of the video and *Scream Icon*. *Id.* at 1176-77. *Scream Icon* reflected a specific time and culture of Los Angeles, whereas the video had a religious theme. *Id.*

The Second Circuit has similarly held that visual collages — works incorporating other artists’ images into unique, cohesive wholes — were transformative because they changed the expression or aesthetic of the underlying works. In *Cariou v. Prince*, 714 F.3d 694 (2nd Cir. 2013), Prince, an artist, used photographs of Rastafarians to create a collection of collages. 714 F.3d at 706. For some of the collages, Prince painted bright objects, such as lozenges and an electric

blue guitar, over the photographs; for others, Prince took bits and pieces of the photographs to create distorted human shapes. *Id.* at 699-702. The majority of the collages were transformative because the aesthetic differed from that of the original photographs. *Id.* at 706. In *Blanch v. Koons*, 467 F.3d 244 (2nd Cir. 2006), the court held that a collage created from photographs of women’s legs imposed over a pastoral landscape dotted with scrumptious desserts was transformative. 467 F.3d at 247, 253. The court commented directly on how original works could serve as “raw material,” writing, “[w]hen, as here, the copyrighted work is used as raw material in the furtherance of distinct creative or communicative objectives, the use is transformative.” *Id.* at 253 (internal citations and quotations omitted).

B. A Close Reading of *Boldly* and *Go!* — Within the Broader Context of the Worlds of *Star Trek* and Dr. Seuss — Underscores *Boldly*’s Status as a Transformative Work.

The district court in this case correctly concluded that *Boldly* is a transformative work and makes fair use of elements of *Go!* because *Boldly* adapts the stylistic, visual, and rhyming elements from *Go!* to create new expression. *Dr. Seuss Enters., L.P. v. ComixMix LLC*, 372 F. Supp. 3d 1101, 1115 (S.D. Cal. 2019). A close reading of the works demonstrates that this conclusion was correct and that the lower court’s decision should be affirmed.

In *Boldly*, the authors have remixed and remade not a single Dr. Seuss book but the very idea of “Dr. Seuss.” *Boldly* speaks with specificity to thematic

elements of *Star Trek*. It draws out those meanings of “Dr. Seuss” that resonate with *Star Trek* fans while adding new meanings that speak with particularity to the themes of *Star Trek* beloved by its community of fans.

Star Trek fandom is, indeed, a community as numerous scholarly works have documented. See, e.g., John Tulloch et al., *Science Fiction Audiences: Watching Doctor Who and Star Trek* (1995); Roberta Pearson & Máire Messenger Davies, *Star Trek and American Television* (2014). *Star Trek* is, for many people, a culture in the literal sense: a place of shared history and family. There are *Star Trek* weddings. See, e.g., Gerard Milewski, *How to Plan Your Own Star Trek Wedding*, *Star Trek* (May 19, 2019), <https://www.startrek.com/article/our-star-trek-wedding>. *Star Trek* provides a text that parents eagerly look forward to sharing with their children (hence the existence of products like *Star Trek* uniform onesies, plush toys, and crib mobiles²). Parents want their kids to share their love of *Star Trek* and the show’s values.³

² *Star Trek* products include a wide variety of unlicensed merchandise available on sites like Etsy. See, e.g., *Popular Items for Star Trek Onesie*, Etsy, https://www.etsy.com/market/star_trek_onesie (last visited Oct. 9, 2019) (displaying 64 results).

³ Andrew Copson describes *Star Trek*’s values as humanist, and notes that they include cooperation, liberality, the equality of persons, the dignity of life, scientific curiosity and awe at the natural world. Andrew Copson, *The Humanist Values of Star Trek*, *The New Statesman* (Feb. 22, 2007) <https://www.newstatesman.com/blogs/the-faith-column/2007/02/star-trek-humanist-values>.

Both the original *Star Trek* and the works of Dr. Seuss share a wonky “Sixties vibe.” In fact, both *Star Trek* and the television version of *How The Grinch Stole Christmas* debuted in 1966. *Star Trek*, IMDB, <https://www.imdb.com/title/tt0060028/> (last visited Oct. 9, 2019); *How the Grinch Stole Christmas! (1966)*, IMDB, <https://www.imdb.com/title/tt0060345/> (last visited Oct. 9, 2019). Both texts still feel of that era and appear antiquated to contemporary audiences. Mervyn Nicholson argues that, compared to almost all subsequent science fiction, including later iterations of *Star Trek*, the original series is minimalist, “primitive, even quaint — not much more than ‘a lot of orange paint [and] plastic plants.’” Mervyn Nicholson, *Minimalist Magic: The Star Trek Look*, *Bright Lights Film Journal* (Apr. 30, 2010), <https://brightlightsfilm.com/minimalist-magic-the-star-trek-look/#.XZ4ao-dKjOQ>. This description could easily describe Dr. Seuss’s illustrations. Nicholson goes on to argue that the look of *Star Trek*, its odd visual style (which includes the use of strong blocks of color and what he calls “winding ways,” that is, “places where there are turnings and no direct route . . . for instance, of rocky barren lands, foggy landscapes, caverns — places that are confusing or that lack markers,” *id.*), is integral both to *Star Trek*’s meaning and its success. Similar strong blocks of color (orange deserts, green skies) and “winding ways” appear throughout the works of Dr. Seuss, some of which have been sampled and reread for *Boldly*.

A good remix like *Boldly* is not accidental; the mashed-up works are chosen particularly to resonate and cannot simply be swapped out with another work. *Star Trek* mashed-up with *Peanuts* would be a very different creation despite them being from the same era. *Peanuts* has a pop-psychological vibe, and it deals with themes like anxiety, depression, and failure, which are very different from *Star Trek*'s utopian idealism. *Star Trek* in the style of Andy Warhol would mean something else altogether. Owen Galliger notes that, in remix, “previously understood meanings of particular visual signs are altered and updated through recontextualization.” Owen Gallagher, *Reclaiming Critical Remix Video: The Role of Sampling in Transformative Works* 4 (2017). Gallagher goes on to explain:

The ability to recall the meaning of a specific visual sign and immediately understand it points to the fact that its meaning is stored in memory as a result of having been perceived in the past . . . However, in the case of remix, previously perceived and understood signs are presented in a very different context, which causes a moment of realization in the viewer, during which comparisons are made between the old and new meanings and a reinterpretation of the previously understood signs occurs.”

Id. In other words, the intervention has to be visible to make it mean something; similarity between the old and new work is not an accident. *Boldly* re-evaluates the previously perceived through the pleasure of a good pun, giving the reader joy through hearing and understanding two meanings simultaneously. See Sigmund Freud, *Wit and Its Relation to the Unconscious* 173 (1999).

The audience re-sees the saucer-shape on Dr. Seuss's cover as the famous saucer of *Star Trek*'s iconic ship, the Enterprise. ER1105. It sees beloved *Star Trek* creatures like the *Gorn* (a giant lizard who wears a sparkly tunic), *Star Trek: The Arena* (NBC television broadcast Jan. 19, 1967); the *Horta* (a silicon-based rock creature who turns out to be an incredibly sensitive and enlightened alien being), *Star Trek: The Devil in The Dark* (NBC television broadcast Mar. 9, 1967); and Gerrold's own *Tribbles* (fuzzy animals who multiply faster than rabbits), *Star Trek: The Trouble with Tribbles* (NBC television broadcast Dec. 29, 1967), drawn in the style of Seussian creatures. ER1110; ER1115; ER1126. The remix integrates all these creatures with their delightful names into one great, alien-sixties-fantastic. It also argues that the sense of wonder and curiosity toward the strange that readers find in Dr. Seuss's work for children should continue into adulthood.

Science- and science-fiction-loving adults believe strongly in cultivating and maintaining a sense of curiosity and wonder about the universe. They value optimism and international collaboration, both political (the United Federation of Planets) and scientific. This makes the audience re-imagine Seuss's characters as the world's future explorers and scientists, reinscribing Seussian fantasy and fable into the real world of science and politics. The line of Whos of Dr. Seuss's Whoville — who hold hands and sing — is redrawn so as to include not only Starfleet officers in their gold, red, and blue uniforms but also Vina (a green-

skinned alien slave girl) and Christopher Pike (the disabled former Enterprise captain in his futuristic wheelchair). ER1111. An original panel in Dr. Seuss's *How The Grinch Stole Christmas* reflects the idea of community coming together around the Christmas tree to sing; in *Boldly*, that idea of community is extended in ways meaningful to *Star Trek* and science fiction fans. *See Id.* It is a vision of a utopian international community of the future.

The fact that *Boldly* does not rely solely on *Go!* but reworks and responds to individual drawings from five of Seuss's books is part of what makes it a good remix. There has been curation and careful artistic selection, just as DJs select samples and beats from the larger sea of music, *see* Aram Sinnreich, *Mashed Up: Music, Technology, and the Rise of Configurable Culture* (2010), and vidders select short clips out of the vast archive of television and film footage, *see* Francesca Coppa, *Women, Star Trek, and the Early Development of Fannish Vidding*, 1 *Transformative Works & Cultures* (2008), <https://doi.org/10.3983/twc.2008.044>. The selection process is important: remix is all about the editing.

The imagery selected in *Boldly* invites the reader to reimagine *Star Trek* in the Dr. Seuss universe, drawing parallels between similar themes, storylines and characters. *Boldly* primarily uses three kinds of images: (1) alien machines and landscapes (including Nicholzen's winding ways); (2) depictions of flight; and (3)

portrayals of community. All of these images are particularly resonant for *Star Trek* fans. Gerrold and Templeton's expression focuses on the communal exploration of alien worlds, not on home-bound mischief as in *The Cat in the Hat* or on the isolated figure who walks down new streets as in *Go!*. From *Go!*, Gerrold and Templeton take only images of flight and then turn to other Seussian texts to pull resonant images and reinterpret them. For instance, Sylvester McMonkey McBean, whom Seuss describes a "fix it up chappie," Dr. Seuss, *The Sneetches*, in *The Sneetches and Other Stories* 9 (1961) ("*The Sneetches*"), is reimagined as Scotty, the famously "can-do" Chief Engineer of the Enterprise. ER1122.

McBean's marvelously cobbled-together machine is reimagined as a *Star Trek* transporter. *Id.* While McBean is a trickster figure whose machine enables endless status competition between Sneetches until he departs for greener pastures, *The Sneetches*, at 22, Scotty constantly works last-minute engineering miracles on *Star Trek*, see, e.g., *Star Trek IV: The Voyage Home* (Paramount Pictures 1986) (Scotty being described as a "miracle worker" by the ship's chief medical officer). The audience see McBean as Scotty and Scotty as McBean in a kind of visual pun, and there is also a commentary on the relative "rickety-ness" of *Star Trek*'s *mis en scene* of cardboard control panels and colored lights. *Star Trek*'s sets and props were, famously, improvised — wall decorations made of spray-painted styrofoam packaging, medical equipment made of salt and pepper shakers. See generally,

Stephen E. Whitfield & Gene Roddenberry, *The Making of Star Trek* (1986). In short, the behind-the-scenes world of *Star Trek* is made to evoke Dr. Seuss's cobbled-together steam pipes and blowing horns. And, conversely, *Boldly* invites the reader to see those aspects of the Dr. Seuss universe as creative engineering.

Similarly, the meeting of the North-Going and South-Going Zax, Dr. Seuss, *The Zax, in The Sneetches and Other Stories* (1961) (“*The Zax*”) (story of two creatures who, upon meeting each other, each refuse to give way), is reimagined as *Star Trek*'s iconic character, Mr. Spock, meeting his evil, bearded doppelganger, *Star Trek: Mirror, Mirror* (NBC television broadcast Oct. 6, 1967). ER1123.

Where the Zax argue endlessly, *see The Zax*, the Spocks battle in their own, highly logical way through 3-dimensional chess, *Star Trek: Mirror, Mirror* (NBC television broadcast Oct. 6, 1967). The story of the pointlessly fighting Zax also evokes a classic *Star Trek* theme: the narcissism of small differences. Though nearly identical in appearance and aim, the North-Going Zax and the South-Going Zax can't cooperate enough for either of them to succeed. For the Trekkie, this evokes *Star Trek* storylines like the race war between *people whose faces are black on the left side and white on the right side* and those whose are opposite. *Star Trek: Let That Be Your Last Battlefield* (NBC television broadcast Jan. 10, 1969). On one hand, these disputes are silly; on the other, they are deadly serious. Mashing-

up Dr. Seuss and *Star Trek* highlights the way the latter uses fables, metaphors, and thought experiments to instigate ethical thinking.

Technology has allowed humans to share culture on a scale never before seen. Millions upon millions read the same books, hear the same music, and watch the same movies. The sheer scale of distribution means works like *Star Trek* have become a shared cultural language. While fans of *Star Trek* and Dr. Seuss may get different meaning from the ways in which the two universes intersect, their shared utopianism argues that mashing together *Star Trek* with Dr. Seuss contributes to a mutual culture of optimism and experimentation. By putting these two bodies of work into conversation, *Boldly* cleverly comments on both *Star Trek* and the works of Dr. Seuss, and it expresses new visual and thematic puns by comparing and contrasting them.

II. Mash-Ups, Generally, Constitute Works of Important Transformative Value.

Mash-ups are works that generate new meaning through the combination of two or more original works. Like the video in *Seltzer* or the collages in *Cariou*, mash-ups transform original works by adding context, characters, imagery, and storylines from one work to another. They imbue original works with new expression or aesthetic; add commentary, insight, or humor; or reshape old narratives through new voices. The creative act of combining works tends to change the context of the originals, as the case at hand perfectly illustrates. Just as

Green Day's video adds a religious theme to *Scream Icon*, *Boldly* instills *Go!* with *Star Trek*'s themes of utopian optimism, human dignity, and scientific discovery and exploration.

The prevalence of mash-ups in music, visual art, and literature highlights the many ways in which mash-ups enrich our culture. From the perspective of consumers, because mash-ups typically juxtapose or draw parallels between two works, they provide new insights, commentary, or meaning. From the perspective of creators, mash-ups enable individuals, particularly new and inexperienced creators or minorities, to express themselves with a unique salience and poignancy. Mash-ups are an integral part of a flourishing cultural landscape, and their creation should be encouraged to foster creativity and new expression.

A. Mash-ups Are Ubiquitous Across Many Media and Genres of Art.

Both historically and currently, musical mash-ups have been an important part of the musical landscape. Beginning in the Renaissance Era and extending into the 1900s, European classical composers such as Johann Sebastian Bach would weave refrains from secular, and often bawdy, popular tunes into sacred music, in a composition known as a quodlibet. *See* Maria Rika Maniates, *Quodlibet Revisum*, 38 *Acta Musicologica* 169, 169-78 (Dec. 1966); Thomas Braatz, *The Quodlibet Represented in Bach's Final Goldberg Variation*, Bach Cantatas Website (Jan. 2005), [https://www.bach-cantatas.com/Articles/BWV988-Quodlibet\[Braatz\].htm](https://www.bach-cantatas.com/Articles/BWV988-Quodlibet[Braatz].htm).

While quodlibets took many forms, the juxtaposition of the profane and the sacred was often done as a form of musical parody. *See* Maniates, *supra*, at 170-71. In the United States, the practice of interweaving musical snippets became popular in early 20th century jazz music. *See* Kembrew McLeod & Peter DiCola, *Creative License: The Law and Culture of Digital Sampling*, 29-30 (2011). Jazz musicians commonly “riffed” or improvised on variations of other songs in their own music. *Id.* at 29. In later decades, musical sampling was integral to electronic, disco, and hip-hop music, “becom[ing] the most important technique of today’s composers and songwriters.” *Id.* at 7 (quoting Joanna Demers, *Steal This Music: How Intellectual Property Law Affects Musical Creativity* 9 (2006)).

Musical mash-ups have received critical acclaim and widespread popularity. For example, *Feed the Animals*, an album by Girl Talk, ranked number four on *Time* magazine’s top ten album list in 2008. Josh Tyrangiel, *Top 10 Albums*, *Time* (Nov. 3, 2008), http://content.time.com/time/specials/packages/article/0,28804,1855948_1864324_1864335,00.html. It also received four stars from *Rolling Stone* magazine. Christian Hoard, *Girl Talk: Feed the Animals*, *Rolling Stone* (Jul. 10, 2008), https://web.archive.org/web/20080626154650/http://www.rollingstone.com/reviews/album/21457036/review/21463543/feed_the_animals. A more recent YouTube mash-up artist, DJ Earworm, has produced mash-ups of popular songs that have

received over 25 million views. *See, e.g.*, DJ Earworm, *DJ Earworm Mashup - The United States of Pop 2014 (Do What You Wanna Do)*, YouTube, <https://www.youtube.com/watch?v=BjYWwZLYEs> (last visited Oct. 9, 2019).

In the fine arts, mash-ups have been canonized as an art form in the form of collage, papier collés, bricolage, and more. *See* Richard Rinehart, *Collage is Dead, Long Live Collage!*, in *Remix: Selections from the International Collage Center* 15 (2012). First emerging as a revolutionary technique during early 20th century movements such as Cubism, Surrealism, and Dadaism, collage was provocative, reflecting disillusionment in politics, society, and culture through the fragmentation of original works. Thomas Piché Jr., *Remix Metaphors: A Brief History of Post-War Collage*, in *Remix: Selections from the International Collage Center* 10 (2012). Celebrated artists such as Pablo Picasso, Marcel Duchamp, and Andy Warhol routinely appropriated and transformed original imagery into iconic works. McLeod & DiCola, *supra*, at 36. As collage became more ingrained as a technique, artists used it to challenge mainstream narratives, from expressing discontentment with World War II to the questioning of societal conditions by marginalized groups, such as members of the LGBT community and ethnic minorities. Piché Jr., *supra*, at 11-12.

With the invention of digital technology, visual mash-ups took on new forms and meanings. “Vids,” for example, are fan-made music videos that combine

footage from one or more visual media sources, typically as a form of commentary or criticism. See *Vidding History*, Organization for Transformative Works, <https://www.transformativeworks.org/vidding-history/> (last visited Oct. 9, 2019). Take one such vid, *Vogue*. Luminosity Deville, *Vogue - 300*, YouTube (Sep. 27, 2009), https://www.youtube.com/watch?v=2_NrUD1iqME. This vid “takes footage of violence and suffering from the film *300* and sets it to Madonna's hit song, transforming the homoeroticism of the original into something blatant and ludicrous.” Rebecca Tushnet, *Scary Monsters: Hybrids, Mashups, and Other Illegitimate Children*, 86 *Notre Dame L. Rev.* 2133, 2136 (2011). Regardless of their medium, visual mash-ups are powerful forms of expression in the art world.

Literary mash-ups are frequently seen in fan works, such as fan fiction, where writers bring together characters or storylines from different sources. Often these works blend together well-known storylines, such as a mash-up between *Twilight* and *Harry Potter* which envisions Edward Cullen at Hogwarts. Ewan Morrison, *In the Beginning, There Was Fan Fiction: From the Four Gospels to Fifty Shades*, *The Guardian* (Aug. 13, 2012), <https://www.theguardian.com/books/2012/aug/13/fan-fiction-fifty-shades-grey>. These mash-ups can be extremely popular and appeal to a wide audience. For example, as of September 2019, fanfiction.net, a website that allows individuals to post their own fan writings, contained over 47,000 mash-ups involving *Harry*

Potter. Book Crossovers,⁴ FanFiction, <https://www.fanfiction.net/crossovers/book/> (last visited Sep. 23, 2019). Literary mash-ups have also been successful commercially. *Pride and Prejudice and Zombies*, a reimagined version of *Pride and Prejudice* with a zombie apocalypse storyline, reached number three on the *New York Times*' best sellers list and was eventually turned into a movie. Alison Flood, *Jane Austen in Zombie Rampage Up the Book Charts*, *The Guardian* (Apr. 9, 2009), <https://www.theguardian.com/books/2009/apr/09/austen-zombie-pride-prejudice>.

B. Mash-ups Generate New Meaning and Cultural Value for Both Creators and Consumers.

In any genre, mash-ups are valuable forms of cultural expression for both creators and consumers alike. On the consumer side, mash-ups can provide insight, humor, or political, social, and cultural commentary. Combining together two or more works of art exposes how those works overlap and intersect; likewise, juxtaposing them sharply highlights the incongruities or contradictions in their narratives. *See, e.g.*, Ragnhild Brøvig-Hanssen & Paul Harkins, *Contextual Incongruity and Musical Congruity: The Aesthetics and Humour of Mash-Ups*, 31 *Popular Music* 87 (Jan. 2012) (discussing how musical mash-ups tend to combine incongruous music, such as the Beatles and Jay-Z, often for humorous effect).

⁴ A “crossover” is a term used in fan works to describe a scenario where a character from one story “crosses over” into another story.

Through these intersections and contradictions, mash-ups add new meaning to the original works. Sometimes the new expressive content is commentary or humor, such as a popular 2002 video that satirized George W. Bush and Tony Blair's close relationship by overlaying the duet "Endless Love" with clips of them ostensibly singing the lyrics. Johan Söderberg, *Read My Lips: Bush and Blair*, YouTube (Mar. 26, 2011), <https://www.youtube.com/watch?v=g6-NDTWM8VE>. Other times new meaning is created by telling new narratives through the intersection of different works. Fanfiction mash-up writers imagine compelling ways in which distinct worlds and characters collide. Characters from one storyline interact with characters from another in ways that neither originally intended nor expressed, ultimately transforming the originals. See Kyle D. Stedman, *Remix Literacy and Fan Compositions*, 29 *Computers & Composition* 107, 117 (2012) (describing a yearly fanfiction event called Remix Redux where authors are assigned to remix each other's works).

On the creator side, the ability to utilize original works to create new ones enables people to express themselves more saliently and persuasively. Mash-ups are a uniquely poignant form of expression because they contain content that is often well-known to the audience. Just as a picture is worth a thousand words, speaking through cultural works has the power to resonate strongly because of the associations, familiarity, and emotional significance of the underlying works.

Lawrence Lessig, *Remix: Making Art and Commerce Thrive in the Hybrid Economy* 74 (2008).

Mash-ups also empower and educate new speakers. Many successful writers began their careers by creating mash-ups and other fan works. David O'Brien, *Famous Authors Who Began in Fan Fiction*, Authors.Me (Oct. 27, 2016), <https://www.authors.me/famous-authors-began-fan-fiction/>. Starting with familiar material helps new authors “to think through their own plots” or “develop new insights into the characters” and stimulates their creativity by allowing them to engage with a familiar platform. Henry Jenkins, *Why Heather Can Write*, MIT Tech. Rev. (Feb. 6, 2004), <https://www.technologyreview.com/s/402471/why-heather-can-write/>. Constructing a mash-up forces the creator to comprehend the underlying materials deeply and insightfully in order to effectively combine elements from different sources. *See, e.g.*, McLeod & DiCola, *supra*, at 64 (discussing how music sampling requires a “deep musical knowledge” of “every part” of the original songs). There are also educational benefits to mash-ups. Musical and video mash-ups are valuable teaching tools because they are accessible and enable interest-based learning: “When kids get to do work that they feel passionate about, kids (and for that matter, adults) learn more and learn more effectively.” Lessig, *supra*, at 80. The process of creating a mash-up also teaches

important skills, such as critical thinking, editing, writing, and video and software development.

Mash-ups also serve as an important expressive outlet for minorities. Despite progress in recent years, women and minorities are still underrepresented in mainstream media.⁵ Mash-ups provide an opportunity for minorities and women to change these narratives and to insert their own voice, whether by highlighting the dominance of overrepresented perspectives or reimagining the viewpoints of underwritten characters. For example, a video mash-up between *Buffy the Vampire Slayer* and *Twilight* that has received over 4 million views and been translated into over thirty languages comments on *Twilight*'s idolization of male stalking and female disempowerment by juxtaposing clips of Edward Cullen acting creepy with clips of sassy comments from Buffy. See Kasia Cieplak-Mayr Von Baldegg, *Buffy vs. Edward: Twilight Remixed*, *The Atlantic* (Nov. 17, 2011), <https://www.theatlantic.com/entertainment/archive/2011/11/buffy-vs-edward-twilight-remixed/469065/>.

⁵ A 2018 study by the Center for the Study of Women in Television and Film reported that, of the 100 top-grossing films, female characters accounted for 31% of protagonists. See *2018 Statistics, Women & Hollywood* (2018), <https://womenandhollywood.com/resources/statistics/2018-statistics/>. Similarly, a UCLA study reported that 78.1% of film roles in 2016 were for white characters, even though minorities comprised nearly 40% of the U.S. population. *Hollywood Diversity Report 2018: Five Years of Progress and Missed Opportunities*, UCLA (2018), <https://socialsciences.ucla.edu/wp-content/uploads/2018/02/UCLA-Hollywood-Diversity-Report-2018-2-27-18.pdf>.

C. Requiring Artists to Seek Permission Before Developing Mash-Ups Would Have a Chilling Effect and Stifle Important Creative Expression.

If every mash-up artist had to receive permission to use every underlying source, it is likely that many, if not most, mash-up artists would not be able to engage in their valuable craft. Licensing is not a reasonable option for the average creator. In the music, film, and photography industries, licensing options are limited and likely to be prohibitively expensive. Rebecca Tushnet, *Comments of the Organization for Transformative Works (OTW)*, Organization for Transformative Works 67-68 (Nov. 13, 2013), https://www.uspto.gov/sites/default/files/documents/Organization_for_Transformative_Works_Comments.pdf (“OTW Comments”). Nor is the chilling effect on mash-ups is merely hypothetical. Music sampling declined in the 1990s because the high costs and difficulties of negotiating licenses effectively made it impossible to create certain kinds of musical mash-ups, particularly those that used multiple samples.⁶

⁶ Multiple scholars have argued that increasingly strict enforcement of licensing has led to the decline of sampling in hip-hop music. See McLeod & DiCola, *supra*, at 28; Erik Nielson, *Did the Decline of Sampling Cause the Decline of Political Hip Hop?*, The Atlantic (Sep. 18, 2013), <https://www.theatlantic.com/entertainment/archive/2013/09/did-the-decline-of-sampling-cause-the-decline-of-political-hip-hop/279791/>; see also Marjorie Heins & Tricia Beckles, *Will Fair Use Survive?*, Brennan Ctr. for Just. 6 (Nov. 16, 2005), https://www.brennancenter.org/sites/default/files/2019-08/Report_Will%20Fair%20Use%20Survive%3F.pdf (describing how the

The bureaucratic complexity of the licensing system also particularly discourages younger and less experienced creators, who likely have access to fewer resources and less information. However, it is precisely this demographic who should be encouraged to be creative if copyright law’s goal to “promote the Progress of Science and useful Arts,”⁷ is to be fulfilled. Giving young and inexperienced creators the freedom to fully express themselves is the key to incentivizing creation of valuable cultural works in the future.

A licensing-focused system also enables censorship. OTW Comments at 69-70. If a copyright holder does not like the way a transformative work portrayed the original, then the copyright holder could refuse to license. Critical works, or those that comment on the underlying works in unflattering ways, are particularly likely to be suppressed. *Id.* at 69. Fair use is the essential safety valve that ensures subsequent speakers do not have to beg permission from a copyright holder in order to make transformative art to express a new meaning — even when that meaning is one that the copyright holder does not like.

“clearance culture” forces filmmakers to cut parts of their work for which they cannot get permission).

⁷ See *Campbell*, 510 U.S. at 575 (citations omitted) (discussing how fair use fulfills “copyright’s very purpose, ‘[t]o promote the Progress of Science and useful Arts’” by “simultaneously . . . protect[ing] copyrighted material and . . . allow[ing] other to build upon it”).

Mash-ups enrich society in a myriad of ways. They serve as tools to generate new creative expression and empower communities who otherwise might feel they lack a voice. They have also become an integral technique across many genres of art. It is important to remove barriers to the creation of transformative works like mash-ups to stimulate a flourishing culture and society.

III. Application of the Third and Fourth Fair Use Factors to *Boldly and Go!* Weigh in Favor of Protection for *Boldly* under Copyright’s Fair Use Doctrine.

A. The Third Fair Use Factor Permits Transformative Works to Use More Than the Minimal Amount Necessary for Their Purpose.

Under the third fair use factor, transformative works are permitted to use *more* than “the absolute minimum amount of the copyrighted work possible.” *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 804 (9th Cir. 2003); *see also Campbell*, 510 U.S. at 588. In assessing the third factor, “the extent of permissible copying *varies* with the purpose and the character of the use.” *Campbell*, 510 U.S. at 586-87. This Court has recognized that transformative works may permissibly use substantial or even verbatim copying of the original works to create “new expression, meaning or message.” *Seltzer*, 725 F.3d at 1179; *see also Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 820-21, (9th Cir. 2003); *Cariou*, 714 F.3d at 710.

Identifying whether the work is transformative is only part of the third factor analysis. A court must also consider the fourth factor in relation to the third factor.

“Once enough [of the work] has been taken to assure identification, how much more is reasonable will depend [on] ... the likelihood that [the work] may serve as a market substitute for the original.” *Campbell*, 510 U.S. at 588. “[S]o long as the first and fourth factors favor the parodist” then the third factor has “little, if any, weight against fair use.” *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 116 (2d Cir. 1998).

While the district court correctly concluded that the third factor did not weigh against ComicMix, *Dr. Seuss Enters.*, 372 F. Supp. 3d at 1118, the district court should have analyzed the third factor more broadly in light of *Boldly*'s transformative nature. The district court compared *Boldly* to *Leibovitz* by focusing on the number of original protectable elements *Boldly* copied from *Go!*. *Id.* Analyzing the third factor in such a numerically comparative way oversimplifies how mash-ups like *Boldly* use original works. Rather, given the transformative nature of *Boldly*, the district court should have acknowledged that *more* than the minimal use of the original work is allowed. Limits to how much copying beyond the minimum should be based on the market effect of *Boldly* on *Go!*. For works like *Boldly*, the amount of copying permitted beyond the minimal should be generous because the district court was correct in stating that the market effect is merely hypothetical, as will be discussed next.

B. Hypothetical Markets Are Insufficient to Establish Market Harm Under the Fourth Fair Use Factor.

1. The Plaintiff Bears the Burden of Proving Market Harm When a Use Is Transformative.

The district court was correct that when a work is transformative, as it found *Boldly* to be, there is no presumption of market harm. *Dr. Seuss Enters.*, 372 F. Supp. 3d at 1111. Plaintiffs have conceded that they bear the burden of demonstrating market harm if this Court finds, as the lower court has, that *Boldly* is transformative. *Id.* at 1119. Applicable case law supports a paradigm in which, when a use is transformative, plaintiff must show by a preponderance of the evidence that a work like *Boldly* is likely to substantially harm the market for a work like *Go!* (or its licensed derivatives). *See Campbell*, 510 U.S. at 593; *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984).

2. Plaintiff’s Argument That It Could Have Licensed This Work Is the Kind of “Circular Reasoning” This Court Has Warned Against.

The market harm factor considers whether defendants’ use would harm “traditional, reasonable, or likely to be developed markets.” *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 930 (2d Cir. 1994). This factor is not meant to encourage a finding of market harm on the syllogistic grounds that plaintiff could have licensed any fair use work. *See Seltzer*, 725 F.3d at 1179. Many courts have warned against such circular reasoning in analyzing the fourth factor. *See*

Cambridge Universal Press v. Patton, 769 F.3d 1232 (11th Cir. 2014)

("[L]icensing poses a particular threat that the fair use analysis will become circular, and Plaintiffs may not head off a defense of fair use by complaining that every potential licensing opportunity represents a potential market for the purposes of the fourth fair use factor.")

Courts must walk a careful line in analyzing this factor: the statute requires that they consider potential markets, but blanket consideration of all hypothetical harms undermines the fair use analysis. Although there are no clear guidelines for restraining excessively speculative market harm, the case law offers some useful limits. Most importantly, courts should adhere closely to the prevailing practice of accounting only for hypothetical markets that are "likely to be developed." *Am. Geophysical Union*, 60 F.3d at 930. Accordingly, plaintiffs with clear policies against licensing a given category of uses should not be able to assert potential market harm for transformative works that fall within said category. In this case, Plaintiff instructed licensees not to "use Seuss characters with third party's characters," *Dr. Seuss Enters.*, 372 F. Supp. 3d at 1124 n.8, suggesting that Plaintiff would not have licensed a Seuss mash-up such as *Boldly*. The market for such licenses was not "likely to be developed" by Plaintiffs. *Id.* Additionally, the Second Circuit has suggested that the danger of circular reasoning is especially pronounced when a potential market is too narrowly defined. *Swatch Grp. Mgmt.*

Servs. Ltd. v. Bloomberg L.P., 756 F.3d 73, 91 (2d Cir. 2014). In *Swatch*, the court held that a potential market for “audio recordings of earnings calls convened by foreign companies that are exempt from Regulation FD” was too narrow to show market harm. *Id.* Had Dr. Seuss Enterprises argued in the case at hand that they had a potential licensing market for Seuss/*Star Trek* mash-ups, the court should have found that such a narrow market was unduly hypothetical. Likelihood of development and unreasonable narrowness are not the only limits that should be imposed upon a market harm analysis. Nevertheless, courts should ensure that they are not establishing precedent that would restrict an overly broad category of legitimate transformative uses simply because they could hypothetically be licensed.

Indeed, an overly broad reading of the fourth factor could preclude virtually all defendants from winning motions to dismiss on fair use grounds. If a plaintiff could assert that a defendant’s use infringes upon any hypothetical market, a defendant would never win on the fourth factor and courts would be highly unlikely to dismiss cases against them at the pleading stage. The ability to dismiss a case on fair use grounds is essential to the copyright balance for two reasons. First, it ensures that defendants are not forced to litigate long, expensive cases against “copyright trolls” — entities dedicated to litigating copyright cases on often dubious grounds — or other plaintiffs seeking to abuse the copyright system.

Second, early dismissal helps online content creators fight DMCA takedown notices quickly and ensure that their works can remain online. Often, when large media companies send mass takedown notices to hosting sites like YouTube in an effort to have infringing content removed, works that clearly constitute fair use, such as political remix videos, are caught in the net. *See* MG Siegler, *Hitler is Very Upset That Constantin Film is Taking Down Hitler Parodies*, TechCrunch (Apr. 19, 2010), <http://techcrunch.com/2010/04/19/hitler-parody-takedown/> (reporting on the removal of the popular Hitler internet memes). Creators who challenge these notices expose themselves to potential litigation. Without the ability to end that litigation quickly, at relatively small expense, these creators will not often seek to defend their legal content. To ensure that defendants have an opportunity to dismiss cases based on a fair use defense, and thereby maintain the essential copyright balance, courts must be aware of the dangers of circular reasoning in the fourth fair use factor.

CONCLUSION

For the foregoing reasons, *Amici* respectfully request that this Court affirm the decision of the district court.

Dated: October 11, 2019

Respectfully submitted,

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⁸ *Amici* thank fall 2019 Cyberlaw Clinic students Tyler Bowen and Katie Lin, summer 2019 Cyberlaw Clinic interns Shenelle Salcido and Michelle Rodriguez, and summer 2019 Electronic Frontier Foundation intern Carmen Sobczak for their valuable contributions to this brief.

CERTIFICATE OF COMPLIANCE

Pursuant to the Fed. R. App. P. 32(a)(7)(C), I hereby certify that:

This brief complies with the type volume limitations of Fed. R. App. P. 29(a)(5) and 32(a)(7)(b) and Ninth Circuit Rule 32-1(a) because it contains 6,984 words as calculated by the word count feature of Microsoft Word 2017, exclusive of the sections exempted by Fed. R. App. P. 32(f).

This brief complies with the typeface requirement of Fed. R. App. P. 32(a)(5)(A) and (a)(6) because it uses 14-point proportionally spaced Times New Roman font.

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CERTIFICATE OF SERVICE

I hereby certify that I electronically filed the foregoing Brief of *Amici Curiae* Electronic Frontier Foundation, Organization for Transformative Works, Public Knowledge, Francesca Coppa, David Mack, and Magdalene Visaggio in Support of Defendants-Appellees and Affirmance with the Clerk of the Court for the United States Court of Appeals for the Ninth Circuit by using the appellate CM/ECF system on October 11, 2019. I certify that all participants in this case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECC system.

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Case No. 19-55348

**IN THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

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

Plaintiff-Appellant,

v.

COMICMIX LLC, a Connecticut limited liability company; GLENN
HAUMAN, an individual; DAVID JERROLD FRIEDMAN, an
individual, AKA David Gerrold; TY TEMPLETON, an individual,

Defendants-Appellees.

On Appeal from the United States District Court
for the Southern District of California
No. 3:16-cv-02779-JLS-BGS
Hon. Judge Janis L. Sammartino

**BRIEF OF AMICI CURIAE INTELLECTUAL PROPERTY LAW
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INTEREST AND IDENTITY OF THE AMICI CURIAE

Amici, identified individually in Appendix A, are law professors who teach and have written extensively on trademark law and related subjects. Amici have no stake in the outcome of this case but have an interest in ensuring that trademark law develops in a clear and consistent way.¹

SUMMARY OF ARGUMENT

For nearly two decades, this Court has evaluated claims regarding the use of trademarks in expressive works using a framework derived from *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Applying that framework, the District Court correctly dismissed Appellant Dr. Seuss Enterprises’s (“Dr. Seuss”) claims against Appellees’ book *Oh! The Places You’ll Boldly Go!* (“*Boldly*”). The title, font, and illustration style of Dr. Seuss’s *Oh the Places You’ll Go!* (“*Go!*”) are artistically relevant to Appellees’ “mash-up of two creative worlds,” and nothing in *Boldly* explicitly misleads as to the source or content of the work. *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 256 F. Supp. 3d 1099, 1111 (S.D. Cal. 2017). *Gordon v. Drape* does not change that result. 909 F.3d 257 (9th Cir. 2018). Indeed, this case highlights precisely why

¹ Pursuant to Rules 29(a)(4)(E) of the Federal Rules of Appellate Procedure, amici certify that no part of this brief was authored by either party’s counsel, neither party nor their counsel contributed money that was intended to fund preparing or submitting the brief, and no person—other than the amici and their counsel—contributed money that was intended to fund preparing or submitting the brief. All parties have consented to the filing of this brief.

Rogers, as consistently applied by this Court prior to *Gordon*, is the appropriate framework for claims involving expressive works. Engaging in the type of analysis urged by Dr. Seuss would turn Lanham Act claims into just the sort of mutant copyright claims the Supreme Court was unwilling to allow in *Dastar v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

ARGUMENT

I. ***Boldly's* Title, Font, and Illustration Style are Protected by the First Amendment**

The District Court's decision dismissing Dr. Seuss's trademark claims is consistent with this Court's longstanding application of *Rogers* to claims of trademark infringement involving expressive works.

"A trademark is a word, phrase or symbol that is used to identify a manufacturer or sponsor of a good or the provider of a service. It's the owner's way of preventing others from duping consumers into buying a product they mistakenly believe is sponsored by the trademark owner." *Mattel, Inc. v. MCA Records*, 296 F.3d 894, 900 (9th Cir. 2002) (internal citations omitted). But as this Court has routinely recognized, when trademarks are used for their expressive value rather than as source indicators, the public's interest in remaining free from consumer confusion must be balanced with the public's First Amendment interest in free expression. *Twentieth Century Fox TV v. Empire Distribution, Inc.*, 875 F.3d 1192, 1196 (9th Cir. 2017); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013).

This Court has long balanced those interests by applying a test first developed by the Second Circuit in *Rogers*. *Twentieth Century Fox*, 875 F.3d at 1196; *Brown*, 724 F.3d at 1239; *E.S.S. Ent'mt 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 806-07 (9th Cir. 2003); *MCA Records*, 296 F.3d at 900. And *Rogers* is the “only relevant legal framework for balancing the public’s right to be free from consumer confusion . . . and [Appellees’] First Amendment rights” in the context of Lanham Act claims involving expressive works. *Brown*, 724 F.3d at 1242. Under the *Rogers* test, use of a trademark in an expressive work is not actionable unless the use “[1] has no artistic relevance to the underlying work whatsoever, or, [2] if it has some artistic relevance, [use of the mark] explicitly misleads as to the source or the content of the work.” *Gordon*, 909 F.3d at 266 (quoting *Rogers*, 875 F.2d at 999).

Though the Second Circuit developed the *Rogers* test to evaluate use of a mark in the title of a work, this Court has on several occasions applied the same framework to claims involving use of a mark within the content of the defendant’s work. *See E.S.S.*, 547 F.3d at 1099 (noting there is “no principled reason why [*Rogers*] ought not also apply to the use of a trademark in the body of a work”); *Brown*, 724 F.3d at 1241 (“We have consistently employed the *Rogers* test in § 43(a) cases involving expressive works since *MCA*, including where the trademark or other identifying material in question was used in the body of a work rather than in the title.”).

As the District Court properly determined, Dr. Seuss's claims must be dismissed under *Rogers*. There can be no doubt that *Boldly*'s title, font, and illustration styles are artistically relevant.² *Boldly* is, as the District Court found, "a mash-up of two creative worlds, and *Go!*'s title, font, and illustration style must be employed to evoke *Go!* and the other Dr. Seuss works here at issue." *Dr. Seuss Enters.*, 256 F. Supp. 3d. at 1111. Use of Dr. Seuss's claimed trademarks therefore easily exceeds this Court's standard for artistic relevance, which "merely must be above zero." *E.S.S.*, 547 F.3d at 1100; *see also Brown*, 724 F.3d at 1243, 1245 ("even the slightest artistic relevance" is sufficient, and courts should not have to engage in extensive "artistic analysis").

And there is no reasonable argument that *Boldly* is explicitly misleading. Dr. Seuss alleges no "explicit indication," "overt claim," or "explicit misstatement" that causes confusion. *Brown*, 724 F.3d at 1245. Indeed, as the District Court noted, *Boldly* "explicitly announces on its cover that it is authored not by Dr. Seuss but instead by David Gerrodl & Ty Templeton." *Dr. Seuss Enters.*, 256 F. Supp. 3d. at 1111. "And *Boldly*'s copyright page even includes an explicit disclaimer that 'this is

² Amici assume for the sake of argument here that *Go!*'s font and illustration style are capable of being considered trademarks. There are good reasons to doubt that conclusion, particularly with respect to "style," and that is a question this Court would have to confront if it were to apply *Rogers* in the way Dr. Seuss has suggested. That is yet another virtue of applying *Rogers* faithfully, as this Court has done for nearly two decades.

a work of parody, and is not associated with or endorsed by CBS Studios or Dr. Seuss Enterprises, L.P.” *Id.*

Dr. Seuss nonetheless argues that this Court should find *Boldly* explicitly misleading based on use of the purported marks alone. But this Court has repeatedly rejected parties’ attempts to read the word “explicitly” out of the standard. “It is well established that the use of a mark alone is not enough to satisfy [the explicitly misleading] prong of the *Rogers* test.” *Brown*, 724 F.3d at 1245. Indeed, “if the use of a mark alone were sufficient ‘it would render *Rogers* a nullity.’” *Id.* (quoting *MCA*, 296 F.3d at 902); *see also E.S.S.*, 547 F.3d at 1100 (“[T]he mere use of a trademark alone cannot suffice to make such use explicitly misleading”).

Whether the defendant’s use of the mark is explicitly misleading is also not a function of the amount of possible confusion. In *Brown*, the plaintiff argued that survey evidence demonstrating that a majority of consumers were mistaken about his affiliation with a video game based only on the use of his likeness raised a triable issue of fact on *Rogers* second prong. *Brown*, 724 F.3d at 1245. This Court squarely rejected that contention. “The [*Rogers*] test requires that the use be explicitly misleading to consumers. To be relevant, evidence must relate to the nature of the behavior of the identifying material’s user, not the impact of the use.” *Id.* at 1245-46. That conclusion was not based on some misunderstanding of *Rogers*, but on a fundamental recognition of the speech issues at stake. “The risk of

misunderstanding, not engendered by any explicit indication on the face of the [work], is so outweighed by the interest in artistic expression as to preclude application of the [Lanham] Act.” *Brown*, 724 F.3d at 1246 (quoting *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 937 (6th Cir. 2003)); see also William McGeeveran & Mark P. McKenna, *Confusion Isn’t Everything*, 89 NOTRE DAME L. REV. 253, 305-06 (2013) (emphasizing the need for a categorical rule protecting use of a mark within expressive works, particularly to avoid the chilling effects of speech-detering lawsuits). The standard is *explicitly* misleading, and nothing in *Boldly* meets that standard. See *Twentieth Century Fox*, 875 F.3d at 1199 (“To fail the second prong of the *Rogers* test, it is key that the creator must *explicitly* mislead consumers. We must ask not only about the likelihood of consumer confusion but also whether there was an explicit indication, overt claim, or explicit misstatement that caused such consumer confusion.” (internal quotation marks and citations omitted)).

II. *Gordon v. Drape* Does Not Change the Result

Gordon’s suggestion that “[i]n some instances, the use of a mark alone may explicitly mislead consumers about a product’s source if consumers would ordinarily identify the source by the mark itself” was inconsistent with settled Ninth Circuit precedent and should not be expanded beyond that case. 909 F.3d at 270. As previously noted, this Court has repeatedly held that use of a mark alone cannot be

explicitly misleading. That holding has never been limited to cases involving titles. *See Brown*, 724 F.3d at 1245-46. Explicitness is a critical principle of *Rogers*, and weakening it would “render *Rogers* a nullity,” *id.* at 1245, since *every* mark owner argues that use of its mark is likely to cause confusion.³

This case highlights precisely why *Gordon* should be interpreted narrowly. Dr. Seuss claims as trademarks the title, font, and illustration style of its own expressive works, and it alleges that Appellees’ title, font, and illustration style infringe those “trademarks.” Evaluating that claim would require comparison of the respective expressive works—just the sort of comparison copyright requires. Unsurprisingly, Dr. Seuss’s copyright claims refer to copying of exactly the same elements.

This Court’s longstanding application of *Rogers* avoids a potential conflict with copyright by making comparison of the content of the work unnecessary when, as here, the defendant’s work makes no explicitly misleading claim. Extending *Gordon* here would have just the opposite effect—it would turn Dr. Seuss’s trademark claims

³ Ninth Circuit rules make clear that a panel cannot overrule a previous panel, and as a result, any inconsistency between *Gordon* and this Court’s previous applications of *Rogers* must be resolved in favor of the rules adopted by multiple panels prior to *Gordon*. *Sierra Forest Legacy v. Sherman*, 646 F.3d 1161 (9th Cir. 2011) (“One three-judge panel of this court cannot reconsider or overrule the decision of a prior panel.” (quoting *United States v. Gay*, 967 F.2d 322, 327 (9th Cir. 1992)); *Duckor Spradling & Metzger v. Baum Tr. (In re P.R.T.C., Inc.)*, 177 F.3d 774, 782 n.8 (9th Cir. 1999) (“A three-judge panel . . . lacks authority to overrule the decision of another panel.”)).

into mutant copyright claims by requiring consideration of “the degree to which the junior user uses the mark in the same way as the senior user” and the “extent to which the junior user has added his or her own expressive content to the work beyond the mark itself.” *Gordon*, 909 F.3d at 270.⁴ Neither of those considerations have precedent in this Circuit’s (or any other circuit’s) *Rogers* caselaw. But they are, not coincidentally, remarkably similar to the copyright fair use concepts of “purpose and character of the use” and “transformativeness.” *See, e.g., Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994); *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164 (9th Cir. 2012). That similarity should be a red flag regarding the appropriateness of those concepts in evaluating a trademark claim.

⁴ The panel in *Gordon* apparently believed the defendant’s greeting cards had little expressive content beyond use of the plaintiff’s mark itself—as if they were analogous to a poster with only the McDonald’s logo against a blank white background, containing nothing else by which a separate source might be indicated. There are good reasons to reject *Gordon*’s approach even in such a case—it makes the question of whether explicit misleadingness can be established by use of the mark alone turn on the court’s determination of the amount of expressive content in the defendant’s work. That would, for example, raise the prospect that explicit misleadingness is a question of fact with respect to Andy Warhol’s famous Campbell’s Soup Cans. But certainly *Gordon* should not be extended to cases, like this one, where the defendant’s work contains substantial expressive content and the authors and publishers are clearly identified.

III. Applying *Rogers* Avoids the *Dastar* Problem

Faithful application of *Rogers* has another significant benefit in this case—it avoids the need to engage the Supreme Court’s decision in *Dastar*. Dr. Seuss’s fundamental complaint is that consumers will believe *Boldly* is an authorized Dr. Seuss book. Specifically, Dr. Seuss complains that, because *Boldly* uses a title, font, and illustration style that evoke *Go!*, consumers will believe that Dr. Seuss is the origin of the content of the book. Opening Br. of Plaintiff-Appellant Dr. Seuss Enterprises, L.P. 14. (“Appellant Br.”). That claim is clearly barred by *Dastar*, which unambiguously holds that only misrepresentations of the origin of physical goods are actionable under the Lanham Act. 539 U.S. at 37. Other sorts of misrepresentations, including but not limited to misrepresentations of the origin of creative content, are not actionable. *Id.* (holding that “origin of goods” as used in the Lanham Act refers only to “the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in those goods”); see also *Slep-Tone Entm’t Corp. v. Wired for Sound Karaoke and DJ Services, LLC*, 845 F.3d 1246, 1250 (9th Cir. 2017) (per curiam) (“When the claim is more accurately conceived of as attacking unauthorized copying, *Dastar* requires us to avoid recognizing a ‘species of mutant copyright law’ by making such claims

cognizable under the Lanham Act.” (quoting *Dastar*, 539 U.S. at 34)).⁵

As this Court recognized in *Sybersound Records, Inc. v. UAV Corp.*, 517 F.3d 1137, 1144 (9th Cir. 2008), the legitimacy of a party’s use of content is an issue for copyright law, not for the Lanham Act.⁶ That’s an important reminder here, because Dr. Seuss has asserted a copyright claim with respect to which there is a genuine fair use issue. That issue should be resolved as a matter of copyright law, not evaded by Dr. Seuss by means of an inappropriate trademark claim.⁷

Dastar was decided in 2003, after this Court began applying *Rogers* in the context of expressive works. But all of the cases this Court has resolved under the *Rogers*

⁵ While the Court in *Dastar* was interpreting the language of § 43(a) specifically, 15 U.S.C. § 1125(a)(1)(A), the same rule applies in cases of infringement of registered marks under § 32 despite that section’s slightly less specific language. 15 U.S.C. § 1114; see *Slep-Tone Entm’t*, 845 F.3d at 1249 (noting that “although the Supreme Court [in *Dastar*] was interpreting the unfair competition provision in section 43 of the Lanham Act, the same standard applies to both registered and unregistered trademarks.”).

⁶ *Sybersound* is a false advertising case, but its logic applies to false designation of origin cases as well; indeed, even more strongly given *Dastar*’s recognition that false advertising is a broader cause of action than false designation of origin. See *Dastar*, 539 U.S. at 38 (suggesting that the producer of a video that substantially copied the Crusade series but which, in advertising or promotion, gave purchasers the impression that the video was quite different from the series might have a false advertising claim); *A.H. Lundberg Associates, Inc. v. TSI, Inc.*, No. C14–1160, 2014 WL 5365514 (W.D. Wash. Oct. 21, 2014) (origin of intangible elements of goods cannot be proper subject of false designation of origin claim under *Dastar*).

⁷ This Court should be particularly concerned about the appropriateness of Dr. Seuss’s trademark claims in light of the company’s documented efforts to use trademark law to circumvent copyright’s limitations. See Philip Nel, *The Disneyfication of Dr. Seuss: Faithful to Profit, One Hundred Percent?*, 17 CULTURAL STUDIES 579, 587-91 (2003).

framework also implicate *Dastar* in that they all involved allegations that consumers would be confused about the origin of creative content. *See, e.g., Twentieth Century Fox*, 875 F.3d at 1195; *Brown*, 724 F.3d at 1240; *MCA Records*, 296 F.3d at 901. The same is true here. If this case is not dismissed under *Rogers*—because *Boldly*'s title, font, and illustration style are artistically relevant and Appellees have done nothing explicitly misleading—then *Dastar* will apply.

Dr. Seuss's claim would not be saved under *Dastar* by a superficial re-framing of the allegations to refer to the origin of physical copies of *Go!*. As this and other courts have recognized, *Dastar* precludes claims that use of the plaintiff's mark suggests that the plaintiff created or authorized a particular physical (or digital) copy, if the evidence of misrepresentation is based solely on the content of the copy. *See Slep-Tone Entm't.*, 845 F.3d at 1250 (alleged confusion caused by the content of copyrighted music files was not actionable under *Dastar*); *Phx. Entm't Partners v. Rumsey*, 829 F.3d 817, 828 (7th Cir. 2016) (same).

If it were otherwise, Disney could prevent others from selling copies of Steamboat Willie even after its copyright expired by arguing that, because Mickey Mouse is in the movie and is Disney's trademark, consumers will be confused about the source of physical copies of the movie. That claim could be argued to survive *Dastar* because it is nominally focused on the source of physical goods, but in truth it hinges on an assertion that consumers will think Disney authorized the

reproduction of the content. That interpretation would make *Dastar* a dead letter, since it would allow any plaintiff to plead around the holding, creating precisely the sort of “mutant copyright law” the Supreme Court rejected. *Dastar*, 539 U.S. at 34; cf. *Bretford Mfg. v. Smith Sys. Mfg. Corp.*, 419 F.3d 576, 580-81 (7th Cir. 2005) (noting that consumers might see marks embedded in other products, and holding that *Dastar* bars claims based solely on that embedding).

Dastar also compels rejection of Dr. Seuss’s argument, derived from a footnote in *Rogers*, that *Go!* can be considered explicitly misleading because its title is confusingly similar to *Boldly*’s title. Appellant Br. 59 (quoting *Gordon*, 909 F.3d at 270, which quotes *Rogers*, 875 F.2d at 999 n.5, for the proposition that “misleading titles that are confusingly similar to other titles can be explicitly misleading, regardless of artistic relevance”). Insofar as a confusingly similar title misleads by causing confusion about authorship of the defendant’s work, that form of confusion is irrelevant under *Dastar*, which post-dates *Rogers* and controls on that point.

CONCLUSION

For the foregoing reasons, the judgment of the district court should be affirmed.

Dated: October 11, 2019

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

**1. This BRIEF OF AMICI CURIAE INTELLECTUAL PROPERTY
LAW PROFESSORS IN SUPPORT OF DEFENDANTS-APPELLEES**

complies with the type volume limitation contained in Fed. R. App. P. 29(a)(5) and Ninth Circuit Rule 32-1(a), because it contains 3185 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(f).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word in 14 point Times New Roman font.

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APPENDIX A

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CERTIFICATE OF SERVICE

I hereby certify that on October 11, 2019, I electronically filed the foregoing **BRIEF OF AMICI CURIAE INTELLECTUAL PROPERTY LAW PROFESSORS IN SUPPORT OF DEFENDANTS-APPELLEES** with the Clerk of the Court for the United States Court of Appeals for the Ninth Circuit by using the appellate CM/ECF system.

I certify that all participants in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

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Dated: October 11, 2019

No. 19-55348

**IN THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

DR. SEUSS ENTERPRISES, L.P.,

Plaintiff-Appellant,

v.

COMICMIX LLC, *et al.*,

Defendants-Appellees.

On Appeal from the United States District Court
for the Southern District of California
No. 3:16-cv-02779-JLS-BGS
Hon. Janis L. Sammartino

**BRIEF OF *AMICI CURIAE* PROFESSORS MARK A. LEMLEY, JESSICA
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INTEREST OF AMICI¹

Amici are full-time legal academics who teach and write about copyright law and who have written extensively about fair use practice and jurisprudence. Mark A. Lemley is William H. Neukom Professor of Law, Stanford Law School; Jessica Litman is John F. Nickoll Professor of Law, University of Michigan Law School; Lydia Loren is Henry J. Casey Professor of Law, Lewis & Clark Law School; Pamela Samuelson is Richard M. Sherman Distinguished Professor of Law and Information, University of California, Berkeley, School of Law; Rebecca Tushnet is Frank Stanton Professor of First Amendment Law, Harvard Law School. Collectively, amici represent multiple decades of experience and expertise in the area of copyright law and policy. Amici respectfully submit this brief solely in the interest of proper interpretation of traditional principles of copyright law and out of concern that the fair use doctrine not be unduly restricted to chill the creation of transformative new works of expression.

¹ The parties have consented to the filing of amicus briefs. No party's counsel authored this brief in whole or in part, and no party or party's counsel made a monetary contribution to fund the preparation or submission of this brief. No person or entity other than Amici made a monetary contribution to the preparation or submission of this brief.

SUMMARY OF ARGUMENT

In keeping with its recent precedents, this Court should endorse a robust and flexible conception of transformative fair use in this case and eschew the rigid approach that Doctor Seuss Enterprises (“DSE”) and its amici have urged this Court to adopt. Particularly when a second comer uses a pre-existing work that has a widely shared cultural significance to reinterpret another work of similar significance, courts should be skeptical about granting the first work’s author control over the ability to reconceptualize its meaning through creative reuses.

The District Court properly refused to require the second work to criticize the first author’s work. It avoided characterizing “mashups” as a monolithic category. And it avoided second-guessing the artistic choices of the second comer’s use. Its analysis was faithful to the statutory text and to fair use’s important role in furthering the constitutional purpose of copyright and the free expression interests of follow-on creators that are protected by the First Amendment.

This Court in *Lenz v. Universal Music Corp.*, 801 F.3d 1126 (9th Cir. 2015), characterized fair uses as “wholly authorized by law” and said it was a “misnomer” to call fair use an affirmative defense. Hence, the District Court correctly put the burden of proving market harm on DSE and concluded that it had failed to establish a likelihood of market harm, notwithstanding DSE’s extensive licensing regime. DSE was unlikely to have licensed the particular use at issue here, and the District

Court rightly concluded that Appellees' work will not supplant demand for the original.

To ensure that fair use fulfills its constitutional purpose, copyright owners should have to show a likelihood of harm to their traditional, reasonable, or likely markets. It never has been and never should be enough to carry that burden to show that the copyright owner maintains a robust licensing program or participates in a seasonal market that the second comer would like to enter. A likelihood of market substitution must be shown, and the District Court properly concluded that DSE had failed to make a sufficient showing to satisfy its burden.

ARGUMENT

I. Fair use supports creative reuses of existing works to promote the progress of science and culture.

As the Ninth Circuit and other appellate courts have held, and contrary to the claims of DSE and its amici, transformative uses are not restricted to criticism, comment, and parody. The purpose of the transformativeness inquiry is to provide new creators with breathing room to enable them to make their own meaningful contributions to the universe of expressive works.

A. Using one work to reinterpret and explain another is a favored transformative purpose.

Culturally significant works, such as *Star Trek* and Dr. Seuss's books, invite a variety of creative responses. Given that some cultural symbols "have a grip on the

mind that only use of the original can shake,” preserving the ability to repurpose those symbols is one vital function of fair use. Wendy J. Gordon, *A Property Right in Self-Expression*, 102 Yale L.J. 1533, 1568-69 (1993). “Should these former audience members and those they serve not be able to play with the symbols that formed their mental vocabulary, they may be worse off than if they had initially not been exposed to them.” *Id.* Monopolies on the interpretation of well-known works can be particularly harmful to public discourse, since well-known works provide useful guides to thinking about the world. *See, e.g., Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 802 (9th Cir. 2003) (protecting use of Barbie dolls in photographs because they “convey[] these messages in a particular way that is ripe for social comment”); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1272 (11th Cir. 2001) (noting cultural significance of *Gone with the Wind*).

To confine fair use’s protection for iconic works to explicit criticism or obvious commentary on those works would mean that, absent the author’s permission, cultural symbols could be repurposed only to refer to themselves. Fair use provides more freedom of interpretation. The ability to use original works for varied transformative purposes unlocks new forms of creativity. *See, e.g., Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 328 (S.D.N.Y.

2019) (lithographs made from photographs of the late musician Prince “can reasonably be perceived to have transformed Prince from a vulnerable, uncomfortable person to an iconic, larger-than-life figure”).

The fundamental purpose of the transformativeness inquiry is thus not whether the secondary use straightforwardly comments on or criticizes the original. It is whether the defendant’s use has “alter[ed] the first with new expression, meaning, or message,” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994), that “may *reasonably* be perceived” in the new work, *id.* at 582 (emphasis added).²

² “May reasonably be perceived” does not require there to be a consensus about the message of the transformative work. Fair use is not reserved for the artistically competent who manage to communicate so clearly that everyone in the audience understands the message. *Yankee Publ’g Inc. v. News Am. Publ’g Inc.*, 809 F. Supp. 267, 280 (S.D.N.Y. 1992) (“First Amendment protections do not apply only to those who speak clearly, whose jokes are funny, and whose parodies succeed.”) (quoted in *Campbell*, 510 U.S. at 583). More importantly, to engage in commentary is not to impose a singular meaning on a work. *Cf. Mattel*, 353 F.3d at 801 (majority opinion should not determine fair use). In a large and diverse world, the meaning of a work will never be uniformly agreed upon. Empirical work demonstrates that different audiences read mainstream works differently, meaning that there is no one message to rebut. *See, e.g.*, Neil Vidmar & Milton Rokeach, *Archie Bunker’s Bigotry: A Study in Selective Perception and Exposure*, 24 J. Comm. 36, 37 (1974). Given the inevitability of varying interpretation, the “reasonably perceived” standard both serves the interests behind the Copyright Act in promoting the creation of new expression as well as the First Amendment interests served by fair use. *See* Rebecca Tushnet, *Judges as Bad Reviewers: Fair Use and Epistemological Humility*, 25 Law & Lit. 20 (2013) (arguing in favor of recognizing the multiplicity of meanings to different communities); Michael W. Tyszko, Note, *Whose Expression Is It, Anyway? Why “New Expression, Meaning, or Message” Should Consider All Reasonably Available Viewpoints*, 65 Syracuse L. Rev. 221 (2014) (advocating use of multiple reasonable viewpoints).

Here, the District Court could reasonably perceive *Boldly* as, among other things, using Seussian imagery to interpret and explain another cultural icon, which simultaneously changes the meaning and message of the original images. The juxtaposition of two cultural icons that were ubiquitous during the childhood of many of today's adults creates new meaning in ways that words alone could not do. *Cf. Mattel*, 353 F.3d at 802 (finding visual transformativeness evident even without a clear narrative statement). Especially given its use of *Star Trek* characters rather than Seuss characters, *Boldly* is not a “new Dr. Seuss book”; it is an interpretation of *Star Trek* that also offers a way to think about Seuss.

Separate from this litigation, commentators have recognized the hyper-individualistic character of *Go!*. *See, e.g.,* Alison Lurie, *Boys and Girls Forever: Children's Classics from Cinderella to Harry Potter* 102 (Penguin 2003); Thomas Esposito, *The Roots that Clutch: Letters on the Origins of Things* 59 (2018) (noting that *Go!*'s “lone primary character never interacts with *anyone* except in competitive terms, and he does not once perceive the need to seek or receive help along his way”); David Brooks, *The Strange Failure of the Educated Elite*, N.Y. Times, May 28, 2018, <https://perma.cc/38Y2-PJBU> (“On graduation days, members for the educated class give their young Dr. Seuss’ ‘Oh, the Places You’ll Go!’ which shows a main character, ‘you,’ who goes on a solitary, unencumbered journey through life

toward success. If you build a society upon this metaphor you will wind up with a society high in narcissism and low in social connection.”).

Boldly, by contrast, endorses not individual enterprise randomly leading to positive encounters as in the original, but rather institutional structures that promote discovery through combining the efforts of trained commanders, scientists, engineers, and others. Whereas recent “official” *Star Trek* programs have followed the trend in mass culture towards darkness, moral ambiguity, and “gritty” reboots,³ Appellees read the original *Star Trek* as a story about exploration, adventure, and connection-building. They used Seussian imagery as an interpretive tool by which to make the case for a hopeful future, achieved by collective efforts and not by unplanned individual wanderings alone, more persuasively than words alone, or unfamiliar images, could. The use of Seussian imagery thus has a new purpose: not merely to retell the same story or a sequel, but to create new meaning by juxtaposing two culturally significant works.

DSE and its amici attempt to avoid this understanding of Appellees’ work by misconstruing the District Court’s ruling as having concluded that all mash-ups were

³ See, e.g., Emily Todd VanDerWerff, *Star Trek: Discovery’s First Season Shows Dark, Gritty Reboots Can Have a Purpose*, Vox (Feb. 11, 2018), <https://perma.cc/9XFE-BQ76>; Ben Travis, *Tarantino’s Star Trek Project Is Sweary and R-Rated*, Empire (June 12, 2019), <https://www.empireonline.com/movies/news/tarantino-star-trek-project-sweary-r-rated/>.

automatically transformative in purpose. Opening Br. at 29-30, MPAA Br. at 16. DSE's brief also oversimplifies the relevant purposes of the original and secondary works as "to entertain the reader . . . with an uplifting story." Opening Br. at 37. The former is not an accurate description of the District Court's holding. The latter ignores the specificity required by fair use analysis. It is always possible to describe the purpose of a work at multiple levels of abstraction: the purposes "to increase the amount of knowledge in the world," "to entertain," and so on are shared by many works, including both those that rely on fair uses and their sources. Wisely, courts have eschewed word games about the purpose of a use. Instead, where a case involves two creative works in the same general genre, courts ordinarily look for differences in expressive *meaning* or *message*. *Campbell*, 510 U.S. at 579 (two musical works); *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006) (two works of visual art); *Cariou v. Prince*, 714 F.3d 694, 706 (2d Cir. 2013) (multiple works of visual art).

B. Flexibility in the transformativeness inquiry furthers the purpose of copyright and First Amendment interests.

Many creative, original works build on earlier ones, which is why fair use is necessary to fulfill copyright's purpose to promote the progress of science and the useful arts. *Campbell*, 510 U.S. at 575. Rather than being limited to a set of statutorily endorsed purposes, transformativeness is present when someone uses some expression from another's copyrighted work to create a new artistic or expressive work, and when the second work "adds something new, with a further purpose or

different character, altering the first with new expression, meaning, or message.” *Id.* at 579. Consistent with *Campbell*, this Court has protected works that build upon, reinterpret, and reconceive existing works, rejecting a narrow view of transformability. *Mattel*, 353 F.3d at 799-800; *SOFA Entm’t, Inc. v. Dodger Prods. Inc.*, 709 F.3d 1273, 1280 (9th Cir. 2013).

The flexibility of fair use is not, as DSE and its amici would have it, either accidental or unfortunate. The Supreme Court has explained that fair use must avoid “rigid applications” that “would stifle the very creativity which [copyright] law is designed to foster.” *Campbell*, 510 U.S. at 577. Courts consistently recognize a secondary use’s transformative purpose where existing work is used as “raw material . . . in the creation of new information, new aesthetics, new insights and understandings.” *Seltzer v. Green Day*, 725 F.3d 1170, 1176 (9th Cir. 2013) (quoting Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990)). How that “raw material” gets cooked may vary, and fair use accommodates that variance.

This flexibility ensures that copyright does not impinge on the breathing space for new authors mandated by the First Amendment. *Eldred v. Ashcroft*, 537 U.S. 186, 220-21 (2003); *Suntrust Bank*, 268 F.3d at 1264 (“The exceptions carved out for these purposes are at the heart of fair use’s protection of the First Amendment,

as they allow later authors to use a previous author’s copyright to introduce new ideas or concepts to the public.”).

Some uses may be explicitly critical of the original; others need not be. *See Campbell*, 510 U.S. at 577 (examples cited in the statute are illustrative and not exclusive). In *Seltzer v. Green Day*, this Court held that the second comer’s use of an earlier work as raw material in a “street-art focused music video about religion” was fair notwithstanding that the original work “clearly says nothing about religion.” *Seltzer*, 725 F.3d at 1176-77, 1179. The Second Circuit too has recognized that the question is whether the secondary user had a “genuine creative rationale for borrowing.” *Blanch*, 467 F.3d at 255; *see also Cariou*, 714 F.3d at 706. Thus, Appellees’ work, which transmutes Seussian images into interpretations of the *Star Trek* universe, is not required to be conventional criticism or parody.⁴

DSE and its amici attempt to avoid the rule that transformativeness can be present where a new meaning or message could reasonably be perceived. *See, e.g.,*

⁴ *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997) does not require a contrary conclusion. Among other things, that case was about a different work and a different fair use analysis. In addition, that case confined its analysis to whether the secondary use was a parody; defendants focused exclusively on parody in their briefs, *id.* at 1402-03. But parody is not the standard required by *Campbell*: transformativeness is. *Seltzer*, 725 F.3d at 1177 (new work can be transformative without comment on the original so “long as new expressive content or message is apparent”). *See also* R. Anthony Reese, *Transformativeness and the Derivative Work Right*, 31 Colum. J.L. & Arts 467, 472-73, n.27 (2008) (criticizing case).

Opening Br. at 31 (suggesting that a secondary use must be parody, commentary, or criticism to be “meaningfully transformative”); Sesame Workshop Amicus Br. at 14 n.6 (arguing that “‘True Mud’ is transformative both in parodying the dark, violent, original series and in creating new expression, meaning, and purpose by using the mash-up to teach young children to rhyme”). Sesame Workshop’s distinction relies on common knowledge that Sesame Street is funny and the existence of an additional (albeit not critical) message about rhymes. Neither the humor of the collision of two well-known works nor the intention to teach rhyming is a “new meaning” that is meaningfully distinguishable from Appellees’ new message about *Star Trek*. See also Sesame Street, *Homelamb*, YouTube (Oct. 28, 2013), <https://youtu.be/v1zL106SGZ8> (Sesame Street version of *Homeland*). Sesame Street’s popularity should not give it greater rights to engage in fair use than unknown creators would have; to defer to its status would give powerful speakers more free speech rights than others.

C. The derivative work right does not change the analysis.

Section 107 is crystal clear: fair use limits all of the copyright owner’s exclusive rights under § 106, including the derivative work right. See *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87, 95 (2d Cir. 2014). The derivative work right has an important role to play, but that role is not to shrink fair use. See Pamela Samuelson,

The Quest for a Sound Conception of Copyright's Derivative Work Right, 101 Geo. L.J. 1505, 1538 (2013).

A transformative use that has a new *purpose* is not the same thing as a derivative work, such as a sequel, that simply has new *expression*. See Reese, *supra*, at 484-85. Instead, the absence of significant aesthetic additions or contextual changes may prevent a finding of fair use transformativeness. *Cariou*, 714 F.3d at 711 (remanding to district court to determine whether alterations in five works were transformative). For example, an unauthorized creation of a new episode of *Gilligan's Island* would not be identical to previous episodes, but the different ways in which Gilligan bollixed a new attempt to leave the island would not themselves change the meaning or message of Gilligan programs. *Cf. TCA Television Corp. v. McCollum*, 839 F.3d 168, 181-83 (2d Cir. 2016) (reversing grant of motion to dismiss because comedy routine was not meaningfully altered, nor did its specific content matter to the meaning of the accused work as a whole).

The proper reconciliation of the two kinds of use is that a fair use does not interfere with the legitimate scope of copyright rights, including the derivative work right or the other exclusive rights subject to § 107 fair use.

II. Transformative uses of culturally significant works can be fair use when the amount taken is reasonable in light of a creator’s artistic purpose.

The extent of permissible copying varies with the purpose and character of the use. *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 613 (2d Cir. 2006) (quoting *Campbell*, 510 U.S. at 586-87). Where there is pervasive alteration, copying of even substantial elements of the original can be fair. *See, e.g., Suntrust Bank*, 268 F.3d 1257 (retelling of *Gone With the Wind* that reversed its racial judgments and sexual mores); *Adjmi v. DLT Entm’t Ltd.*, 97 F. Supp. 3d 512 (S.D.N.Y. 2015) (reworking of *Three’s Company* with more modern content); *Lombardo v. Dr. Seuss Enters., L.P.*, 279 F. Supp. 3d 497, 513 (S.D.N.Y. 2017) (uses of Seuss characters for distinct purposes was fair use).

Deference to artistic decisions about follow-on uses of such works is consistent with the “breathing room” fair use must provide. A fair user can take more than strictly necessary (as determined by judicial hindsight) to accomplish the user’s transformative purpose. More than a “fleeting evocation of an original” may be needed for the transformative use to make its point. *Elsmere Music, Inc. v. Nat’l Broad. Co.*, 623 F.2d 252, 253 n.1 (2d Cir. 1980) (per curiam). Even when the second comer goes to great lengths to copy protectable elements, taking more of a work “than was minimally necessary to conjure it up” does not necessarily tip against fair use. *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 116 (2d Cir. 1998).

The District Court looked to the *Leibovitz* decision because it recognized that case's essential similarity to this one: once a second comer has made an artistic decision to transform some expression from a specific existing work, the copying of small details can be important to that artist *as an artist*. Courts should not force artists to do different work than they are capable of where the overall work they produce has a new meaning and message. To require the second artist to use only the absolute minimum that courts might someday deem necessary would force artists to be preoccupied with second-guessing the unknowable minutiae of justification. The choice is, in fact, between the judicial judgment of artistic choices and artistic judgment of artistic choices, and as between those, *Bleistein* counsels the latter. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."); *Mattel*, 353 F.3d at 802 n.7 ("We do not make judgments about what objects an artist should choose for their art.").

Once transformativeness has been established, courts should be guided by the artist's choices about what is a reasonable amount, especially where the copying is

of only a portion of the original work rather than a full copy.⁵ See Michael C. Donaldson, *Refuge from the Storm: A Fair Use Safe Harbor for Non-Fiction Works*, 59 J. Copyright Soc’y U.S.A. 477, 489-90 (2012) (a court’s fair use determination “often explicitly defers to the artist to determine how much is needed” and “the real test is whether the creator of the new work only uses what is reasonably appropriate to illustrate or support the point being made in the new work”). This flexibility is particularly sensible given that the details of the images and the placement of characters on the page are unlikely to affect either whether there is a transformative meaning or a substantial market effect. Indeed, DSE had never seen *Boldly* when it asserted that the book infringed its copyright. Appellees Br. at 12.

Here, particularly because *Boldly* uses no Dr. Seuss characters, the meticulous copying of certain settings (which themselves constitute only a small number of the total Seuss images) was reasonable in view of its purpose of using the Seussian and

⁵ The “amount taken” analysis may differ when the transformation at issue involves a pure transformation in purpose, without a change in the content. For example, entire images at a lower level of definition may be acceptable for image search, *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146 (9th Cir. 2007); and amounts exceeding the length of the average news story may be unacceptable for TV news, *Fox News Network, LLC v. TVEyes, Inc.*, 883 F.3d 169 (2d Cir. 2018). Judges need not be guided by artistic choices in “big data” cases. But in cases where new art has been created, creators’ aesthetic decisions should be given attention and respect.

Trekkian worlds to interpret each other. Deference to Appellees' artistic decisions allows the court to avoid passing judgment on the artistic merits of the copying.

III. The District Court properly held that DSE failed to show a likelihood of harm to the traditional, reasonable, or likely markets for its works.

The text of the Copyright Act and this Court's precedents support placing the burden on the plaintiff copyright owner to show a likelihood of market harm when a defendant raises a fair use defense. Where the second comer has transformed some expression from an existing work targeted at a different audience, the existence of an extensive licensing regime and the original work's prominence in a seasonal market do not suffice to carry that burden. The District Court properly concluded that the market harm factor favored neither party.

A. Consistent with this Court's precedents, the copyright owner bears the burden of showing a likelihood of market harm.

Although the Supreme Court in *Campbell*, 510 U.S. at 590, characterized fair use as an "affirmative defense" and said the burden of proof was on defendants who raise fair use defenses, this Court in *Lenz* recognized that this characterization was a "misnomer." 801 F.3d at 1133. It was thus consistent with Ninth Circuit precedent for the District Court below to place the burden on DSE to demonstrate a likelihood of harm to the market for its works. ER 25.

In *Lenz*, the Ninth Circuit relied on the text of the fair use provision, case law, and relevant policies to support the view that fair use is a defense, but not an affirmative defense. *Lenz*, 801 F.3d at 1132-33.⁶ As that decision pointedly observed: “Fair use is not just excused by the law; it is wholly authorized by the law.” *Id.* at 1132.

The court in *Lenz* more specifically concluded that unless Universal Music considered fair use, it could not rightfully send a takedown notice to YouTube demanding it take down Lenz’s video of her son dancing to a Prince song. *Id.* at 1133. The statute explicitly requires copyright owners to affirm that they have a “good faith belief” that a particular unlicensed use of a protected work is “not authorized by the copyright owner, its agent, or the law” before sending a takedown notice. *Id.* at 1132 (quoting 17 U.S.C. § 512(c)(3)(A)(v)). Because fair uses are “authorized by the law,” Universal could send a takedown notice in good faith only if it decided that Lenz’s use was unfair. *Id.* at 1133.

The textual argument supporting the proposition that fair use is a defense, but not an affirmative defense, is simple and straightforward. Section 106, which sets forth the exclusive rights granted to authors, states that all exclusive rights are “[s]ubject to sections 107 through 122.” 17 U.S.C. § 106. That is, the exclusive rights

⁶ The *Lenz* decision cited approvingly to a scholarly article explaining why fair use is a defense, but not an affirmative defense. See Lydia Pallas Loren, *Fair Use: An Affirmative Defense?*, 90 Wash. L. Rev. 685 (2015), cited in *Lenz*, 801 F.3d at 1133.

set forth in § 106 do not extend to any acts that fall within the limitations or exceptions authorized by these sections. Section 107, moreover, plainly states that “the fair use of a copyrighted work . . . is not an infringement of copyright,” 17 U.S.C. § 107, and specifically states that this is so “[n]otwithstanding the provisions of sections 106 and 106A.” *Id.* The Ninth Circuit also invoked 17 U.S.C. § 108(f)(4), which characterizes fair use as a “right,” as further statutory evidence supporting its view that fair uses are “authorized by the law” and must be considered before copyright owners can conclude that any particular use constitutes an infringement. *Lenz*, 801 F.3d at 1132; *see also id.* at 1133 (quoting *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1542 n.22 (11th Cir. 1996) for the proposition that because fair use is not infringement, the better view is that fair use is a right); *Suntrust Bank*, 268 F.3d at 1260 n.3 (11th Cir. 2001) (opining that under the 1976 Act fair use should be considered an affirmative right).

As with a merger defense, the defendant may initially need to raise fair use as a defense to an infringement charge, but the burden of persuasion that a challenged use is infringing and not based on merged expression or not a fair use should remain on the plaintiff because these defenses undermine the plaintiff’s prima facie case. *See, e.g., Ho v. Taflove*, 648 F.3d 489, 499 (7th Cir. 2011) (plaintiff failed to show defendant copied protectable expression); *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 36 (1st Cir. 2001) (plaintiff bears “heavy burden” of proof when

merger defense raised). *See also* Loren, *supra*, at 697-98 (citing *Schaffer v. Weast*, 546 U.S. 49, 57-58 (2005) (“Absent some reason to believe that Congress intended otherwise, . . . the burden of persuasion lies where it usually falls, upon the party seeking relief.”)). The Ninth Circuit in *Lenz* distinguished fair use from misuse and similar types of affirmative defenses because those defenses excuse what would otherwise be infringing acts. *Lenz*, 801 F.3d at 1132-33. By contrast, fair use is only “affirmative” in the sense that the defendant must raise it as a procedural matter. *Id.*

While there is no ambiguity in the text of § 107 that would require looking into the legislative history of that provision, this history nevertheless supports the interpretation of fair use as a defense, but not an affirmative defense. The Register of Copyright’s 1965 Supplementary Report on the copyright reform bills then pending reported that copyright industry groups had proposed that the burden of persuasion in fair use cases should be put on defendants. *See* Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1965 Revision Bill at 28 (Comm. Print 1965). The Register rejected that idea, saying that this would constitute “a radical change in the meaning and effect of the doctrine of fair use.” *Id.* Two years later, a House Report stated the committee’s view that “any special statutory provision placing the burden of proving fair use on one side or the other would be unfair and undesirable.” H.R. Rep. No. 90-83, at 37 (1967).

Treating fair use as a defense, but not an affirmative defense, is also appropriate given the very important role that fair use plays in providing breathing space for new creations that build upon parts of pre-existing works. *Campbell*, 510 U.S. at 579. Allowing subsequent creators to engage in transformative uses of some expression from those works advances the constitutional purpose of copyright, *id.* at 575-77, and maintains copyright law's consistency with the First Amendment's guarantee of freedom of expression. *See Eldred*, 537 U.S. at 219-20; *see also* Ned Snow, *Proving Fair Use: Burden of Proof as Burden of Speech*, 30 *Cardozo L. Rev.* 1781, 1795-98 (2010) (arguing that the burden of proof should lie with copyright owners when defendants raise fair use defenses).

Finally, placing the burden on plaintiffs to show market harm also makes sense because they are in a position to have better information about harm caused by the challenged use than the defendants can have. *See Loren, supra*, at 691, 707. "Requiring the defendant to elicit this information through laborious discovery when it is at the plaintiff's disposal would only prolong litigation and encourage evasion of the discovery process." Jay Dratler, Jr., *Distilling the Witches' Brew of Fair Use in Copyright Law*, 43 *U. Miami L. Rev.* 233, 323 (1988) (also noting that placing the burden on the defendant would effectively require proving a negative).

B. Showing a likelihood of harm requires more than evidence of an extensive licensing regime or a favorable market position.

Presumptions of market harm are unwarranted in cases involving transformative uses, even commercial ones. *See Campbell*, 510 U.S. at 591 (“No ‘presumption’ or inference of market harm . . . is applicable to a case involving something beyond mere duplication for commercial purposes.”); *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1181 (9th Cir. 2012) (refraining from presuming market harm from use of unpublished photos). This is true even when the original work is widely popular and heavily merchandised. With the record before it, the District Court’s evaluation of evidence was careful, and its conclusion that the fourth factor favored neither party was proper. By refusing to recast an extensive licensing regime and *Go!*’s seasonal best-seller status as a comprehensive bar against unlicensed transformative uses, the court preserved fair use’s role in “facilitat[ing] a class of uses that would not be possible if users always had to negotiate with copyright proprietors.” *Kienitz v. Sconnie Nation LLC*, 766 F.3d 756, 759 (7th Cir. 2014).

The market harm inquiry considers “any impact on ‘traditional, reasonable, or likely to be developed markets.’” *Seltzer*, 725 F.3d at 1179 (quoting *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70, 81 (2d Cir. 1997)). *See also Campbell*, 510 U.S. at 592 (“The market for potential derivative uses includes only those that creators of original works would in general develop or license others to develop.”).

Thus, courts have found that the fourth factor favors the second comer when no evidence suggests the copyright owner “would ever develop or license secondary uses of his work in the vein” of the second comer’s work. *Cariou*, 714 F.3d at 709.

DSE tries to pull *Boldly* into *Go!*’s orbit by pointing to its “robust licensing program.” *See, e.g.*, Opening Br. at 3-4 (cataloging licensed Dr. Seuss derivative works and merchandise). Licensing and merchandising of *Go!* and other Seuss properties are undeniably extensive, including children’s books, television shows and movies, accessories and footwear, even home furnishings. ER 673-76. This licensing also includes collaborations with other rightsholders, such as a television show with “muppetized” characters, a line of children’s clothing, figurines, and a free-to-play video game for mobile phones. ER 32. However, while extensive, DSE’s putative “mash-up type collaborations with other copyright owners,” Opening Br. at 20, such as Dr. Seuss-themed Chuck Taylor shoes or “co-branded collegiate bibs,” ER 676, are quite distinct from works like *Boldly*. With the possible, and very marginal, exception of *Grinch Panda Pop*,⁷ none of these collaborations involve combining characters from distinct worlds. A Funko-style or Muppet-style Dr. Seuss character is

⁷ *Panda Pop* is a free-to-play “bubble shooter” mobile game. *Panda Pop*, Jam City, <https://perma.cc/ECL6-S5S> (last visited Oct. 9, 2019). It does not combine characters in any meaningful sense: putting the Grinch in a videogame does not comment on or affect the meaning of the other game characters. *See Panda Pop, Tutorial: The Grinch’s First Race Event*, YouTube (Dec. 4, 2017), <https://youtu.be/1fDcQF2R080>.

not a “mashup,” but rather a Seuss character presented in a different artistic style. Nor is there any record of DSE licensing a literary mash-up like *Boldly*. Simply put, current licensing does not use Seussian imagery as an interpretive tool to understand a different cultural artifact.⁸

Treating a pair of shoes, a video game, and *Boldly* as if they perform the same function and serve the same, undifferentiated market would convert an extensive licensing and merchandising regime into a universal one that controls even transformative works. As this Court has recognized, “[i]t is not in the public’s interest to allow [the copyright owner] complete control over the kinds of artistic works that use [the original] as a reference for criticism and comment.” *Mattel*, 353 F.3d at 806. Courts have thus been careful not to treat the existence of a licensing market as foreclosing fair use. *See Bill Graham Archives*, 448 F.3d at 615 (“a publisher’s willingness to pay license fees for reproduction of images does not establish that the publisher may not, in the alternative, make fair use of those images”). *See also* Rebecca Tushnet, *All of This Has Happened Before and All of This Will Happen Again: In-*

⁸ As one Seuss critic explains, for example, “the ‘Wubbulous’ books [are] ‘blank parody’, a ‘neutral practice of [. . .] mimicry, without any of parody’s ulterior motives, amputated of the satiric impulse.’” Philip Nel, *The Disneyfication of Dr Seuss: Faithful to Profit, One Hundred Percent?*, 17 *Cultural Stud.* 579, 598 (2003) (citation omitted).

novation in Copyright Licensing, 29 Berkeley Tech. L.J. 1447, 1487 (2014) (“Current doctrine correctly recognizes that copyright owners’ willingness to license, control, or monetize a use does not mean that the use is unfair if unauthorized.”).

Preserving room for fair use to operate even in the face of an extensive licensing regime is particularly important for the category of works that lie near but outside the copyright owner’s traditional, reasonable, and likely-to-be-developed markets. For example, while DSE licenses stage productions, it is unlikely to ever license the adult-themed play, centered on the *Grinch* character Cindy-Lou Who, at issue in *Lombardo*. In its market harm analysis there, the court accepted as true that DSE was developing *Grinch* derivatives that included the same character and involved adult themes. Nonetheless, the court held that the fourth factor weighed strongly in the second comer’s favor because DSE “makes no allegations that it intends to authorize a parody containing references to bestiality, drug use, and other distinctly ‘un-Seussian’ topics.” *Lombardo*, 279 F. Supp. 3d at 513.

Similarly, Harper Festival publishes the best-selling children’s book *Goodnight Moon* by Margaret Wise Brown and Clement Hurd. In addition to the original book, there are *Goodnight Moon* stuffed animals, puppets, clothing, board games,

videos, and more.⁹ However, that extensive licensing regime does not give Harper Festival the right to lay claim to, or censor, Julia Yu’s mash-up *Goodnight Dune*, an online publication that depicts characters, places, and objects from Frank Herbert’s 1965 science fiction classic *Dune* in the literary and artistic style of the original children’s book.¹⁰ The transformative work lies beyond the licensing regime. So, too, here. For all of its licensed derivatives, DSE offers nothing like *Boldly*.

Moreover, the record includes evidence that works like *Boldly* are disfavored, or perhaps even prohibited. DSE polices its brand integrity in part through a proprietary “Style Guide, . . . the packet of materials that a partner under license would receive to help them start designing products for Dr. Seuss[.]” ER 32 n.8.¹¹ The Style Guide’s “Do’s and Don’ts” includes two relevant limitations on licensees’ use of the works. First, “Plaintiff instructs its licensees not to show characters with items ‘not

⁹ See *United Media Begins “Goodnight Moon” Licensing*, Gifts & Decorative Accessories (Feb. 18, 2010), <https://perma.cc/3WQA-HLUJ>. All of the examples given above may be found on Amazon.com.

¹⁰ Julia Yu, *Goodnight Dune*, <http://goodnightdune.com/>.

¹¹ Because DSE filed the Style Guide under seal both here and in the pleadings below, we rely on the description of the Style Guide in the District Court’s decision and the parties’ pleadings. To the extent that DSE suggests it may break its own rules, fair use exists precisely so transformative uses do not depend on the magnanimity of the copyright owner, particularly when they do not harm derivative markets the copyright owner is *likely* to develop.

from [the Seuss] world’ and not to ‘use Seuss characters with third party’s characters.” *Id.* (quotations and alterations in the original). Second, the Guide instructs licensees not to “make up Seuss-like rhymes.” *Id.* As the District Court noted, *Boldly* breaks these rules. *Id.* Other decisions similarly have looked to licensing conditions or restrictions in determining whether a secondary use fell within or harmed the copyright owner’s markets for licensed derivatives. *See Suntrust Bank*, 268 F.3d at 1282 (Marcus, J., concurring) (noting that the secondary work contravened “certain editorial restrictions on the authors of its licensed derivatives”). Those conditions also may help identify market niches the copyright owner is unlikely to fill. *See Twin Peaks Prods., Inc. v. Publications Int’l, Ltd.*, 996 F.2d 1366, 1377 (2d Cir. 1993) (“In the cases where we have found the fourth factor to favor a defendant, the defendant’s work filled a market niche that the plaintiff simply had no interest in occupying.”).

Just as an extensive licensing regime does not suffice to show that a secondary use falls within the penumbra of likely derivatives, a prominent position in a market the secondary user seeks to enter does not suffice to show a likelihood of market harm. Instead, the copyright owner must show that the secondary use would serve as an “effective competing substitute” for the original work or likely derivatives in relevant markets. *Perfect 10*, 508 F.3d at 1168 (holding that the fourth factor favored

neither party when the potential harm to the relevant markets “remains hypothetical”). The market harm analysis requires a careful “balance . . . between the benefit the public will derive if the use is permitted and the personal gain the copyright owner will receive if the use is denied.” *MCA, Inc. v. Wilson*, 677 F.2d 180, 183 (2d. Cir. 1981); *see also Bill Graham Archives*, 448 F.3d at 613. Assigning dispositive weight to a copyright owner’s licensing regime or best-seller status is inconsistent with that careful balancing.

Both at summary judgment and on appeal, DSE’s market harm argument relies chiefly on *Go!*’s licensing program, its perennial best-seller status in the graduation gift market, and Appellees’ interest in entering that market. Opening Br. at 51-52; DER 69-73. A prominent position in a market is not enough to enjoin publication of a transformative work seeking access to that market, particularly when much more relevant evidence is available.¹² This would be akin to saying that Acuff-Rose was entitled to a presumption of market harm if both Orbison’s “Oh, Pretty Woman” and 2 Live Crew’s “Pretty Woman” were Christmas songs. Similarly, the directive to consider potential impact should the accused use become widespread, *Campbell*, 510

¹² For example, the transcript of the summary judgment hearing discusses weekly sales figures that might have shown whether previous unlicensed books using *Go!*’s protectable elements impacted sales of the original. DER 82-83.

U.S. at 590, does not entitle a copyright owner to a presumption of harm. The outcome in *Campbell* would be no different if the Court hypothesized 2 Live Crew’s transformative use joined by a variety of other parodies. In all cases, there must be evidence to show a likelihood of harm. Given its absence here, the District Court properly concluded that the fourth factor favored neither party, particularly in view of its conclusion that *Boldly*’s target audience—adult *Star Trek* fans who already have an appreciation for *Go!*—is distinct from the market for *Go!* or its likely derivatives. Treating a leading market position or extensive licensing program as sufficient evidence of market harm on its own would set a troubling precedent to keep transformative works out of the marketplace and give today’s prominent speakers more rights than less well-recognized speakers, contrary to the constitutional purpose of copyright. *See Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1523-24 (9th Cir. 1993) (“[A]n attempt to monopolize the market by making it impossible for others to compete runs counter to the statutory purpose of promoting creative expression and cannot constitute a strong equitable basis for resisting the invocation of the fair use doctrine.”).

CONCLUSION

The District Court properly analyzed the works and evidence before it, recognizing the multiplicity of ways in which a new work can be transformative and the appropriate burden of providing evidence of harm. This Court should affirm the District Court's grant of summary judgment.

Dated: October 11, 2019

Respectfully submitted,

/s/ Erik Stallman

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