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16 UNITED STATES DISTRICT COURT
17 SOUTHERN DISTRICT OF CALIFORNIA

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

20 Plaintiff,

21 v.

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

26 Defendants.
27
28

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Case No. 16-cv-02779 JLS BGS

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

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

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1 **I. INTRODUCTION**

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

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

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

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

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

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

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

1 **II. FACTS NOT SUBJECT TO GENUINE DISPUTE**

2 **A. The DSE Intellectual Property**

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

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

21 DSE oversees a robust publishing program, working closely with its
22 publishers as well as with consumer product companies that utilize DSE’s
23 intellectual property. (SOF ¶¶ 128-137.) As part of this program, DSE licenses
24 authors and illustrators to publish additional works under the Dr. Seuss brand
25

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

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

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

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

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

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

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

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

20 B. Defendants’ Infringing Conduct

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

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





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

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

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

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

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

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

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

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

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

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

21 /////

22 /////

23 /////

24 /////

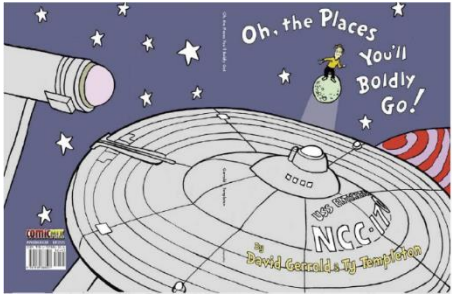



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<i>Boldly</i>	Control Work
	
	

The Control Group and Control Work were used to isolate and eliminate consumer confusion that could arise for reasons other than use of the DSE Marks, such as similarities in title, story or other prose. (SOAF ¶ 59.) After exposure to the specific work, the Test Group was asked who they believed created, sponsored or endorsed *Boldly*, and the Control Group was asked who they believed created, sponsored or endorsed *NCC-1701* or the Control Work. (SOAF ¶¶ 60-62.)

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

D. Defendants’ Unreliable Expert Witness

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

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

8 **III. ARGUMENT**

9 **A. The Court Should Grant Summary Judgment To DSE on its** 10 **Copyright Claims**

11 **1. Boldly Infringes DSE’s Copyrights**

12 As shown in DSE’s motion for summary judgment, there is no genuine
 13 dispute that: (1) DSE owns valid copyrights in the DSE Works; and (2) Defendants
 14 directly and substantially copied from the DSE Works to create *Boldly*. (ECF No.
 15 107 at Sec. III(A).) Having moved on only their fair use defense, Defendants
 16 effectively concede DSE’s *prima facie* case of infringement: in this Circuit, “[t]his
 17 affirmative defense presumes that unauthorized copying has occurred, and is
 18 instead aimed at whether the defendant’s use was fair.” *Monge v. Maya Magazines,*
 19 *Inc.*, 688 F.3d 1164, 1170 (9th Cir. 2012). “As with all affirmative defenses,
 20 [Defendants] bear the burden of proof.” *Id.* And because Defendants have not
 21 carried their burden and DSE has established in its motion that no fair use defense
 22 is available, the Court should deny Defendants’ motion and grant DSE’s motion.

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

24 **a. The First Three Fair Use Factors Favor DSE**

25 Defendants conclude, without supporting authority or even rationale, that the
 26

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

12 **1. Legal Standard For Trademark Infringement**

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

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

27 **2. DSE Owns Protectable Rights in the DSE Marks**

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

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

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

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

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

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

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

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

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

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

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

23 Defendants also ignore *Romm Art Creations Ltd. v. Simcha Intern., Inc.*, 786
24

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

23 **IV. CONCLUSION**

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

1 Dated: January 3, 2019

Respectfully submitted,

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