

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.

No. 19-55348

Appeal from District Court
Case No. 3:16-cv-02779-JLS-BGS

United States District Court for the
Southern District of California

Hon. Janis L. Sammartino

**DEFENDANT-APPELLEES
ANSWERING BRIEF
[REDACTED]**

DAN BOOTH
DAN BOOTH LAW LLC
60 Thoreau St. #121
Concord, MA 01742
Telephone: (646) 573-6596

MICHAEL LICARI
SPRINKLE LLOYD & LICARI
LLP 2801 B. ST. STE. 556
San Diego, CA 92102
Telephone: (858) 717-0013

Attorneys for Defendants-Appellees

ComicMix LLC, Glen Hauman, David Gerrold and Ty Templeton

CORPORATE DISCLOSURE STATEMENT

Pursuant to Federal Rule of Appellate Procedure 26.1(a), Defendant-Appellee ComicMix LLC states that it has no parent corporation, and no publicly held corporation owns 10% or more of its stock. The other Defendant-Appellees are not corporations.

TABLE OF CONTENTS

I.	JURISDICTIONAL STATEMENT	1
II.	STATEMENT OF ISSUES PRESENTED FOR REVIEW	1
III.	STATEMENT OF THE CASE	1
	A. <i>Star Trek</i> and the Defendants	1
	B. Dr. Seuss and DSE	4
	C. <i>Oh, the Places You'll Boldly Go!</i>	5
	D. DSE's demand letter to Defendants terminated AMP's support	10
	E. DSE's takedown notice to Kickstarter blocked all publication funds and prevented fulfillment of ThinkGeek's order	11
	F. Upon ComicMix's response and counternotice to Kickstarter, DSE filed suit	13
	G. Post-complaint developments	14
	H. Procedural history	16
IV.	SUMMARY OF ARGUMENT	19
V.	ARGUMENT	23
	A. <i>Boldly</i> makes fair use of the Dr. Seuss books	23
	1. <i>Boldly</i> is a parody mashup that makes creative criticism and comment about <i>Oh, the Places You'll Go!</i>	25
	2. First factor: <i>Boldly</i> 's transformative character and purpose weigh in favor of fair use	34
	3. Second factor: the nature of the Dr. Seuss books weighs slightly against fair use	37

4. Third factor: <i>Boldly</i> 's limited and reasonable use of Dr. Seuss elements weighs in favor of fair use	38
5. Fourth factor: DSE's failure to present evidence of any negative market effect weighs in favor of fair use	43
6. Weighed together in light of the purposes of copyright, the fair use analysis supports a finding of fair use	58
B. <i>Boldly</i> does not infringe on any legitimate DSE trademark	59
1. <i>Boldly</i> 's use of the title of <i>Go!</i> is protected under the <i>Rogers</i> test	59
2. Illustrative styles and lettering styles are not trademarks	61

TABLE OF AUTHORITIES

Cases

<i>Authors Guild, Inc. v. HathiTrust</i> , 755 F.3d 87 (2d Cir. 2014)	43
<i>Bill Graham Archives v. Dorling Kindersley Ltd.</i> , 448 F.3d 605 (2d Cir. 2006)	26, 37, 46
<i>Calkins v. Playboy Enters. Int’l, Inc.</i> , 561 F. Supp. 2d 1136 (E.D. Cal. 2008)	48
<i>Campbell v. Acuff-Rose Music, Inc.</i> , 510 U.S. 569 (1994)	passim
<i>Cambridge Univ. Press v. Patton</i> , 769 F.3d 1232 (11th Cir. 2014)	47
<i>Dastar Corp. v. Twentieth Century Fox Film Corp.</i> , 539 U.S. 23 (2001)	19, 23, 63
<i>Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.</i> , 109 F.3d 1394 (9th Cir. 1997)	passim
<i>Dr. Seuss Enters., L.P. v. Penguin Book USA, Inc.</i> , 924 F. Supp. 1559 (S.D. Cal. 1996)	41
<i>Elvis Presley Enters. v. Passport Video</i> , 349 F.3d 622 (9th Cir. 2003)	43
<i>Equals Three, LLC v. Jukin Media, Inc.</i> , 139 F. Supp. 3d 1094 (C.D. Cal. 2015)	43
<i>Gordon v. Drape Creative, Inc.</i> , 909 F.3d 257 (9th Cir. 2018)	59, 60, 61
<i>Harper & Row, Publishers v. Nation Enters.</i> , 471 US. 539 (1985)	41, 44, 47
<i>Kelly v. Arriba Soft Corp.</i> , 336 F.3d 811 (9th Cir. 2003)	34, 38, 45
<i>Lenz v. Universal Music Corp.</i> , 815 F.3d 1145 (9th Cir. 2016)	11, 24, 46
<i>Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc.</i> , 780 F. Supp. 1283 (N.D. Cal. 1991)	37

<i>Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc.</i> , 964 F.2d 965 (9th Cir. 1992)	24, 37
<i>Lombardo v. Dr. Seuss Enters., L.P.</i> , 279 F. Supp. 3d 497 (S.D.N.Y. 2017)	15, 56
<i>Lombardo v. Dr. Seuss Enters., L.P.</i> , 729 Fed. Appx. 131 (2d Cir. 2018)	15
<i>Mattel, Inc. v. MGA Entm't, Inc.</i> , 616 F.3d 904 (9th Cir. 2010)	41
<i>Mattel, Inc. v. Walking Mtn. Prods.</i> , 353 F.3d 792 (9th Cir. 2003)	24, 26, 49, 50
<i>Monge v. Maya Magazines, Inc.</i> , 688 F.3d 1164 (9th Cir. 2012)	38, 45
<i>New Kids on the Block v. News Am. Publ'g, Inc.</i> , 971 F.2d 302 (9th Cir. 1992)	62
<i>Norse v. Henry Holt & Co.</i> , 847 F. Supp. 142 (N.D. Cal. 1994)	48
<i>On Davis v. Gap, Inc.</i> , 246 F.3d 152 (2d Cir. 2001)	38
<i>Perfect 10, Inc. v. Amazon.com, Inc.</i> , 508 F.3d 1146 (9th Cir. 2007)	24, 34, 45
<i>Ringgold v. Black Entm't Television, Inc.</i> , 126 F.3d 70 (2d Cir. 1997)	44
<i>Rogers v. Grimaldi</i> , 875 F.2d 994 (2d Cir. 1989)	23, 59, 60, 61
<i>Sega Enters. v. Accolade, Inc.</i> , 977 F.2d 1510 (9th Cir. 1992)	43
<i>Seltzer v. Green Day</i> , 725 F.3d 1170 (9th Cir. 2013)	passim
<i>SOFA Entm't, Inc. v. Dodger Prods.</i> , 709 F.3d 1273 (9th Cir. 2013)	26, 34, 38, 41
<i>Sony Corp. of America v. Universal Studios, Inc.</i> , 464 U.S. 417 (1984)	47

<i>Twentieth Century Film Corp. v. Empire Distribution, Inc.</i> , 875 F.3d 1192 (9th Cir. 2017)	59
<i>VHT, Inc. v. Zillow Group, Inc.</i> , 918 F.3d 723 (9th Cir. 2019)	24, 34
<i>Zivkovic v. S. Cal. Edison Co.</i> , 302 F.3d 1080 (9th Cir. 2002)	47
Statutes	
17 U.S.C. § 102(a)	41
17 U.S.C. § 102(b)	41
17 U.S.C. § 106(2)	25
17 U.S.C. § 107	passim
17 U.S.C. § 108((f)4)	18
17 U.S.C. § 512(f)	11
Other Authorities	
Joseph Bien-Kahn, “ <i>Star Trek</i> Is Brilliantly Political. Well, at Least It Used to Be,” <i>Wired</i> (Sept. 8, 2016)	29
Charles D. Cohen, <i>The Seuss, the Whole Seuss, and Nothing But the Seuss</i> (Random House 2004)	32
Anthony D’Alessandro, “How Much Green Did ‘The Grinch’ Steal?,” <i>Deadline</i> (Mar. 26, 2019)	57
Fed. R. Civ. P. 12(b)(6)	17
H.R. Rep. No. 1476 (1976)	25
Julia Kristeva, “Word, Dialogue, and the Novel” (1966), in <i>Desire in Language</i> , Leon Rudiez ed., Thomas Gora and Alice Jardine trans. (Columbia University 1980)	27
Lawrence Lessig, <i>Remix</i> (Bloomsbury 2008)	27

Hon. Pierre Leval, <i>Toward a Fair Use Standard</i> , 103 Harv. L. Rev. 1105 (1990)	34
Lydia Pallas Loren, <i>Fair Use: An Affirmative Defense?</i> , 90 Wash. L. Rev. 685 (2015)	46
Alison Lurie, <i>Boys and Girls Forever: Children’s Classics from Cinderella to Harry Potter</i> 102 (Penguin 2003)	31, 33
William F. Patry, <i>Patry on Copyright</i> § 10:153	44
Ned Snow, <i>Proving Fair Use: Burden of Proof as Burden of Speech</i> , 31 Cardozo L. Rev. 1781 (2010)	46
Elizabeth Vincentelli, “A Raunchy Riff on Dr. Seuss’s Yuletide Tale,” <i>New York Times</i> (Dec. 8, 2017)	56

I. JURISDICTIONAL STATEMENT

Appellant Dr. Seuss Enterprises, L.P.’s (“DSE”) jurisdictional statement is complete and correct.

II. STATEMENT OF ISSUES PRESENTED FOR REVIEW

1. Does Defendants’ unpublished book *Oh, the Places You’ll Boldly Go!* (“*Boldly*”) make fair use of DSE’s copyrighted works?
2. Is the Defendants’ use in *Boldly* of any valid DSE trademark protected by the First Amendment?

III. STATEMENT OF THE CASE

A. *Star Trek* and the Defendants

“Space: the final frontier. These are the voyages of the starship *Enterprise*. Its five-year mission: to explore strange new worlds. To seek out new life and new civilizations. To boldly go where no man has gone before!” So declared the opening monologue of the 1960’s science-fiction television series *Star Trek*, which depicted the adventures of Captain James T. Kirk and his *Enterprise* crew. DER46¹.

Boldly highlights those adventures in comic, quasi-Seussian form. The appellees are *Boldly*’s author David Gerrold, its illustrator Ty Templeton, its

¹ Citations in the form “DER__” are to Defendants’ Excerpts of Record.

editor Glenn Hauman, and his publishing company ComicMix LLC (“Defendants”).

Gerrold is a renowned science-fiction author. His writings include more than 50 books, episodes of such television series as *Logan’s Run*, *Sliders*, *Babylon 5*, and *Land of the Lost*, and the novella “The Martian Child,” which won a Hugo Award and a Nebula Award and was adapted into a feature film. ER284, ER287, ER340, ER1129.²

Templeton has written and illustrated hundreds of comics since *Stig’s Inferno* in 1985. A “popular *Batman* artist in the ‘90s and 2000s,” he won three Eisner Awards for DC Comics’ *Batman and Robin Adventures* series and worked on animations for Warner Brothers’ *Batman: The Animated Series*. ER177-78, ER234-36, ER261, ER1129.

Hauman has worked in publishing for more than 25 years, including at ComicMix since its founding in about 2007. He is ComicMix’s vice president of production and sole employee. ER164-65, ER336-37, ER344.

ComicMix provides services in the comics industry akin to a book packager. It has produced the Eisner-nominated Planned Parenthood benefit *Mine!* and reissued *GrimJack* and *Jon Sable, Freelance*, among other comics. ER157, ER166, ER365.

² Citations in the form “ER__” are to DSE’s Excerpts of Record.

Gerrold, Templeton, and Hauman have worked in the *Star Trek* entertainment franchise. See ER178, ER239, ER1129. Gerrold wrote “The Trouble With Tribbles,” one of the best-known and most comedic episodes in the original series (“TOS”), wrote for and appeared in several of the franchise’s series, and has written *Star Trek* novels and books about his *Star Trek* experience. ER176, ER284, ER293, ER319, ER415-16, ER1154-55. Templeton wrote *Star Trek: Mission’s End* comics for IDW Publishing. ER265-66. Hauman wrote several novels in Pocket Books’ *Star Trek: Starfleet Corps of Engineers* series and was a consultant to Simon & Schuster Interactive on *Star Trek* projects. ER172. ComicMix reissued Gerrold’s books *The World of Star Trek* and *The Trouble With Tribbles* with new Templeton covers in 2016. ER293, ER415-17, ER484.

Through their professional experience, they developed a working understanding of how fair use applies in the publishing industry, especially to the literary techniques of parody and mashup. Gerrold wrote a mashup story combining Sherlock Holmes and Oscar Wilde, and *A Doctor For The Enterprise*, a *Dr. Who/Star Trek* mashup comic. ER287-88; ER341. Templeton worked on fair use parodies for *Mad* and *National Lampoon*, among other publications, and is “familiar with parody culture.” ER244-46, ER261-62. Hauman has followed publishing fair use cases over his career,

not least *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997) (“*Penguin*”). ER343-44, ER355.

B. Dr. Seuss and DSE

Theodor Geisel wrote and illustrated children’s books under the pseudonym Dr. Seuss, including *Horton Hears A Who* (“*Horton*”), *How the Grinch Stole Christmas!* (“*Grinch*”), *The Sneetches and Other Stories* (“*Sneetches*”), *The Lorax*, and *Oh, the Places You’ll Go!* (“*Go!*”), published by Random House Children’s Books. ER671, ER879, ER947, ER975, ER1007, ER1297, ER1392. Geisel died in 1991. ER549.

Appellant DSE is the post-mortem licensing entity that exploits Geisel’s intellectual property. ER547-555, ER877, ER884. It has licensed new works and thousands of other products derivative of the Seuss books. ER655-661, ER675-76. Dozens of licensees generate hundreds of DSE-branded items derivative of *Go!* alone. ER1502-05, ER1509-18. Licensed *Go!* derivatives include books published by Random House Children’s Books. ER888-89, ER1217-69, ER1315-1500.

DSE provides its licensees a proprietary Style Guide instructing that derivative products should not mix Seussian and non-Seussian elements. ER32, DER134-35.

C. Oh, the Places You'll Boldly Go!

Defendants conceived *Boldly* over email. ER266. On May 27, 2016, Gerrold suggested to Hauman the concept of “a Star Trek Primer” in the vein of a *Dick and Jane* children’s book, whether by a license or “as a parody.” ER287-89, ER393. Hauman responded, “If we’re parodying TWO things (Pat the Bunny and Trek) we’re on safer ground, I think.” *Id.* By day’s end, Hauman had envisioned Templeton as the illustrator and considered approaching retailer ThinkGeek about publishing that year: “For the appropriately dated look, this is right in Ty’s wheelhouse. ... It’ll be tough to do these by September, but we’ll definitely want to talk to people at ThinkGeek for Christmas.” ER392. Hauman suggested other parodic titles, including “Oh, the Places You’ll Boldly Go!.” *Id.*; ER182. His “boldly go” split-infinitive title invoked both *Go!* and *Star Trek*. ER88, ER186, ER306.

On May 28, 2016, Hauman sketched and sent Gerrold a dummy mock-up cover for “Oh, the Places You’ll Boldly Go!” depicting Kirk standing on the *Enterprise*. ER181, ER391. He sent Gerrold the text of *Go!* with initial thoughts on *Star Trek* episodes to reference, and Gerrold replied, “I am SOOO in!” ER1043-45. Hauman discussed possible legal repercussions with Gerrold: “I’m slightly concerned, although we’re pretty well protected by parody. (Of course, IANAL, but I feel pretty secure on the

point. It helps that we're using Trek to parody Seuss and Seuss to parody Trek.)” ER1049. Gerrold responded, mentioning his “*Dr. Who/Star Trek* mashup comic.” ER341, ER1049. On May 29, 2016, Hauman replied, referring to the *Penguin* case, “I was more worried about Seuss; they initiated a lawsuit about 20 years back that helped define the boundary between parody and satire. Which, if nothing else, shows they can be litigious. Luckily, we come down well on the side of parody here—at least as I envision this thing going.” ER1049; ER343, ER355.

Hauman picked Templeton for the *Boldly* project based on his artistic talent, his expressive style, and his ability to evoke, rather than imitate, an artistic style. ER178-79. On June 14, 2016, he sent Templeton the mockup cover sketch and solicited him to illustrate *Boldly* with “Seuss-style TOS backgrounds.” ER180, ER413-14. Templeton at once appreciated the premise of a mashup of *Star Trek* and Dr. Seuss and joined in enthusiastically. ER239, ER413.

As they developed *Boldly*, Defendants sought to evoke *Go!* with recognizable references for parodic purposes, and to provide commentary on both *Go!* and *Star Trek*. ER168-69, ER245-50. They each “considered *Boldly* a parody, a mash-up, and a transformative work,” not a mere

imitation. ER7, ER120, ER124, ER131, ER146-48, ER178-81, ER289-90, ER297, ER343, ER351, ER445.

On June 15, 2016, Hauman sent Gerrold and Templeton a first draft of “starting snippets” to develop the script. ER305. Gerrold wanted to follow the “structure” of *Go!* and told Hauman, “I want to parallel it as close as I can.” ER304, ER400. Gerrold sent Hauman his own draft script “from scratch” on June 20, 2016. ER402-08. Hauman began editing the drafts together in July. ER306, ER480. On July 11, 2016, he sought Templeton’s input on the script. ER421. On July 12, 2016, Templeton replied, “I think we have to keep to [*Go*’s] sentiment to make the parody and spirit work.” *Id.* After years at *National Lampoon* and *Mad*, he calls it “a commonality in parody publishing that you try to match the thing that you are parodying,” by necessity: “The parody works if the elements from the original are still recognizable.” ER247, ER249-50, ER262, ER272-73.

Also on July 12, 2016, alluding to *Penguin*, Hauman told Templeton’s wife that *Boldly* would be “a parody of [Seuss] work, which legally allows for reuse, vs. satire, which doesn’t. Ironically, it was a Seuss lawsuit that helped define the legal distinction.” ER277, ER479. He speculated (quite wrongly, it turned out) that DSE might, upon seeing *Boldly*, “want to publish it themselves and give us a nice payday for doing so.” ER479.

Templeton sent Hauman a rough “sketch version of Kirk below the tribbles, Seuss style” on July 15, 2016. ER762-64. On July 18, 2016, Hauman forwarded it to ThinkGeek and explained that Defendants were proceeding without a license: “this is straight parody fair use of both Seuss and Trek.” ER426. He did not think shopping *Boldly* to *Star Trek* licensees was necessary to because he considered it fair use. ER174.

ComicMix ran a crowdfunding campaign on Kickstarter from August 31 to September 30, 2016 to cover *Boldly*’s initial production and distribution costs. ER180, ER366, ER444-52. The campaign page included Templeton’s cover art and some preliminary drawings, with more artwork added as the month progressed. ER445-48, ER449-52. It called *Boldly* “a parody mash-up.” ER445. A disclaimer stated, “While we firmly believe that our parody, created with love and affection, fully falls within the boundary of fair use, there may be some people who believe that this might be in violation of their intellectual property rights.” ER448. Defendants “thought it is perfectly obvious that it is a parody,” and the disclaimer reflected their belief that *Boldly* constitutes fair use. ER193, ER302, ER246, ER628.

Kickstarter selected the campaign as a “Project We Love.” ER451. 727 project backers pledged \$29,575 to support a scheduled December 2016 publication. ER444.

Allison Adler (“Adler”), an editor at Andrews McMeel Publishing (“AMP”), came across the campaign in early September 2016. ER1151. She viewed *Boldly* as a mashup of the Dr. Seuss and *Star Trek* brands, in the vein of other parody children’s books. ER1151, ER1154. On September 15, 2016, she emailed Templeton and Gerrold proposing to publish *Boldly*. ER158-59, ER454. She spoke with Hauman and sought to determine if AMP could handle a print run before the holiday season. ER751-60, ER1161-71. Hauman told her about ThinkGeek’s anticipated order and the Kickstarter campaign pre-orders, and mindful of both licensing and fair use, he approved of merchandise options based on “what can be done legally with and without permission.” ER760, ER1171. On September 19, 2016, Adler offered Hauman a printing and distribution deal in which ComicMix would “essentially act as a book packager” for AMP, and they reached agreement on the principal terms in a “letter of agreement” two days later. ER324, ER456-58.

On September 23, 2016, ThinkGeek agreed to purchase 5,000 copies of *Boldly*, contingent on delivery in time for Black Friday sales. ER1181. AMP planned a rush first printing sufficient for ThinkGeek and the Kickstarter backers, followed by publication in wide release in spring 2017. DER37, ER1175. Adler told Hauman, “to make the ThinkGeek Black Friday

promotion we'd need files from you the first week in October." DER37.

Defendants tried to comply. ER441.

D. DSE's demand letter to Defendants terminated AMP's support

AMP was on course towards production on September 28, 2016. ER1175. DSE sent a cease-and-desist letter to Defendants that afternoon, blindly claiming that *Boldly* was not a fair use. ER470-72. The book was "not even close to done," with the text not finalized and Templeton still drawing. ER188. He thought the cease-and-desist had been sent in error because the images on Kickstarter "did not seem to be enough [for DSE] to form an opinion on what we were doing." ER267.

Templeton sent Hauman and Gerrold more *Boldly* artwork that day, aiming to meet the deadlines by October 5, 2016. ER197. He asked Hauman, "Are we ignoring the cease and desist letter to keep the schedule? This is expected or annoying?" *Id.* Hauman told him that he'd forwarded the letter to AMP. ER197, ER361-62, ER460. Templeton noted that several of his *Boldly* layouts were based on Seuss layouts: "To me, that's essential to the parody is that people recognise the source material in poses since they WON'T be seeing the [Seuss characters]. I'm concerned if we try to completely ignore the source material the gags fall apart." DER42, ER8. Hauman assured Templeton that his use of Seuss material was appropriate:

“The mistake that the C&D makes is that they think we’re not parodying Seuss, when we very specifically are. ... 1. They have no way of knowing whether we’re commenting on their work as they haven’t read it. 2. We’re obviously commenting on Dr. Seuss.” DER42. Reassured, Templeton sent Hauman more artwork that week, basing his “drawings quite closely on the images and layouts of” *Go!*, “the one we’re parodying.” DER42, ER140, ER269, ER740.

AMP backed out of the project on September 29, 2016, to avoid being drawn into the dispute. ER360-62, DER45, DER81.

E. DSE’s takedown notice to Kickstarter blocked all publication funding and prevented fulfillment of ThinkGeek’s order

On October 7, 2016, Hauman told ThinkGeek’s buyer it was not feasible to provide copies of *Boldly* by the first week of November, but “we should be able to hit 2nd week for the full order.” ER486. Later that day, DSE sent Defendants a second cease-and desist letter. ER474. That evening DSE sent a DMCA takedown notice to Kickstarter claiming ComicMix infringed the copyright in *Go!*, “an illustrated children’s book.” ER1862. Although 17 U.S.C. § 512(f) requires copyright holders to form “a subjective good faith belief that the use was not authorized by law” before a takedown notice, *Lenz v. Universal Music Corp.*, 815 F.3d 1145, 1148 (9th

Cir. 2016), DSE still had not seen the book. Kickstarter promptly disabled access to the campaign page and froze all funds pledged. ER466, ER1860.

On October 8, 2016, Hauman told the other Defendants he intended to file a Kickstarter counter-notice and show that DSE was arguing in bad faith. ER466. He sought other means to fulfill ThinkGeek's order, but ComicMix could not "pay for the giant print job" without the Kickstarter funds. ER362-63, ER466.

Templeton completed his artwork on October 13, 2016, spending about seven hours drawing the last image to "knock it out of the park." ER8, ER257-59, ER766-69, ER1012, ER1122. Hauman sent ThinkGeek a complete draft of *Boldly* that day. ER468.

On October 17, 2016, Hauman informed ThinkGeek: "We're currently dealing with a problem with the Seuss estate, which has sent us a cease & desist and has put a hold on all of our funds from the Kickstarter, which we were going to use for printing costs." DER54, ER365-66.

On October 25, 2016, DSE sent Defendants another cease-and-desist letter insisting again, sight unseen, that any distribution of *Boldly* would infringe DSE's copyrights and violate trademark and unfair competition laws. ER476-77.

F. Upon ComicMix’s response and counternotice to Kickstarter, DSE filed suit

On October 28, 2016, ComicMix sent a response letter to DSE explaining that *Boldly* is a mashup protected by fair use that DSE obstructed “based on nothing more than a hunch.” DER44-50, ER315-16, ER370, ER636. It explained that DSE’s interference had cost ComicMix AMP’s publishing support and the Kickstarter pledges needed to cover printing costs, without which it expected to lose ThinkGeek’s order as well. DER45. ComicMix asked DSE to recognize that *Boldly* is fair use and accede to reinstatement of the Kickstarter campaign. DER49-50.

That same day, ComicMix also sent a counter-notice to Kickstarter seeking reinstatement and a return of the funds pledged. ER636, DER49, DER52.

Only then did DSE ask to review *Boldly*. ComicMix provided DSE a copy of the just-completed draft that day, October 28, 2016. ER636. In that draft, the copyright page bears a disclaimer: “This is a work of parody, and is not associated with or endorsed by CBS Studios or Dr. Seuss Enterprises, L.P.” ER1107. A second disclaimer immediately below states, “Copyright Disclaimer under section 107 of the Copyright Act 1976, allowance is made for ‘fair use’ for purposes such as criticism, comment, news reporting, teaching, scholarship, education, research, and parody.” *Id.* Defendants

included the disclaimers, as they had on Kickstarter, “to make sure that it is perfectly clear this is a parody” and not licensed use. ER188-89, ER298.

Upon review, DSE did not ask ComicMix to declare *Boldly* a parody on the cover, change the cover’s lettering style, or request any other alterations. ER189, ER352. DSE filed suit on November 10, 2016, suppressing publication. ER699.

G. Post-complaint developments

In the days after the complaint, Gerrold suggested that revising the artwork, to reduce its links to particular Seuss illustrations, could be a “way out” of the lawsuit that “really weakens [DSE’s] case.” ER410. He thought revisions might appease DSE: “could we back it off a little bit so as to reduce [DSE’s] objection.” ER157-58. But Defendants have not revised *Boldly* since, considering those links essential to their transformative purposes, they. Templeton responded that, while he was open to revisions “if it takes away our problems,” he had made the artwork “as accurate to the originals as I could to maintain the parody element, so I did, in fact, slavishly copy from Seuss to do it. To me, who grew up with the National Lampoon and SNL, it wasn’t enough to make it ‘feel’ like Seuss, it had to match the design and layouts as well.” ER410.

On November 15, 2016, Hauman informed ThinkGeek that it could not provide *Boldly* by the holiday season due to DSE’s legal action, but hoped to offer it once the dispute was resolved. ER366-67, ER489. On February 2, 2017, Hauman told ThinkGeek that *Boldly* could not go to press while the litigation was pending. ER367, ER468. After three years of litigation, *Boldly* remains unpublished and exists “as a set of files.” ER263.

Meanwhile several unlicensed, fair use works based on Seuss books have reached the market. In 2017, Random House published *Oh, the Meetings You’ll Go To!* (“*Meetings*”), a *Go!* parody credited to “Dr. Suits,” [REDACTED] ER890-91.

Also in 2017, the *Grinch* parody play *Who’s Holiday* premiered on Broadway, after it was judged a fair use over DSE’s opposition. ER931; *Lombardo v. Dr. Seuss Enters., L.P.*, 279 F. Supp. 3d 497 (S.D.N.Y. 2017), *aff’d*, 729 Fed. Appx. 131 (2d Cir. 2018).

DSE has not produced evidence that sales of *Go!*, *Grinch*, or any other Seuss work have suffered due to any fair use works. Instead, DSE touts Dr. Seuss as 2017’s “top licensed book brand.” ER491, ER1297. After *Meetings* was published, *Go!* maintained its streak topping the *New York Times* Best Sellers list every spring, and new *Go!*-themed merchandise lines launched from licensees Komar Kids, MantraBand, American Greetings, Target,

Hallmark, and Moleskine. ER31, ER1285, ER1512, ER1517-18, Opening Brief 2.³ And after *Who's Holiday* premiered, DSE's *Grinch* stage play continued its national tour, and its licensed *The Grinch* movie broke box office records. ER1283-84, ER1294. Random House continues to publish new DSE-licensed derivative books, including *Grinch* derivatives. ER879-81, ER1204-08, ER1521-29.

H. Procedural history

DSE filed suit on November 10, 2016. ER699-715. It claimed that *Boldly* infringes DSE copyrights in five Seuss books: *Grinch*, *The Lorax*, *Horton*, *Sneetches*, and *Go!*. ER703, ER710-11, ER715. It also claimed trademark infringement and unfair competition based on alleged unregistered, common-law trademark rights in the title of *Go!*, a Seussian illustration style, and a Seussian stylized font. ER703-04, ER708-13.

Defendants moved to dismiss the copyright claim on fair use grounds, and the trademark and unfair competition claims on grounds including failure to function as a trademark, nominative fair use, and the First Amendment. ER74-93, ER664-65. On June 9, 2017, the court dismissed the trademark and unfair competition claims on the basis of nominative fair use, granting leave to amend. ER90-93.

³ Citations to DSE's Opening Brief are to the pagination supplied by DSE.

The court denied the motion to dismiss the copyright claims upon its initial fair use analysis. ER77-86. It found that *Boldly* is “a highly transformative work that takes no more than necessary to accomplish its transformative purpose and will not impinge on the original market for Plaintiff’s underlying work.” ER85. The court found a “near-perfect balancing” of the four fair use factors set out in 17 U.S.C. § 107. The first factor (the purpose and character of the use) and fourth factor (its market effect), generally viewed as the most important factors, then stood “in equipoise.” ER86. The first weighed in favor of fair use, but at the pleading stage with no record evidence on point, and with DSE’s alleged harms accepted as true under Rule 12(b)(6), the fourth weighed against. ER76, ER81, ER84 (“In the current procedural posture Defendants are at a clear disadvantage under this [fourth] factor’s required analysis.”).

DSE amended the complaint on June 22, 2017. ER666-ER695. It added a claim that *Boldly* infringed a trademark, registered after the initial complaint, for the title OH THE PLACES YOU’LL GO as a mark for goods including downloadable digital children’s books. ER650-52, ER671-72, ER687-88. It also added allegations about licensed *Go!*-derivative works, new works, and collaborations with other rights holders. ER54 n.3, ER673-

76. Defendants again moved to dismiss, and the court denied their motion on December 7, 2017. ER50-73.

Defendants answered the amended complaint on December 21, 2017. ER619-63. That same day, Defendants moved for partial judgment on the pleadings on the trademark and unfair competition claims on First Amendment grounds. ER725. The court heard the motion on May 9, 2018, and granted the motion in part, to the extent it related to the title of *Boldly*, on May 21, 2018. ER41-49, ER729.

On December 11, 2018, Defendants moved for summary judgment on all remaining claims, while DSE moved to exclude Defendants' expert witness and moved for summary judgment on its copyright claims related to *Go!*, *Grinch*, and *Sneetches*. ER731-32. The court heard the motions on February 7, 2019, and granted Defendants' summary judgment motion and denied DSE's motions on March 12, 2019. ER3-40, ER735-36. The court found that *Boldly* is a fair use of DSE's copyrighted works, and that the stylized typeface and illustration style Dr. Seuss used in *Go!* are not protectable as trademarks. ER16-39. DSE filed notice of this appeal on March 26, 2019. ER94-95.

IV. SUMMARY OF ARGUMENT

Boldly makes fair use of the Seuss books that is fully protected from DSE's copyright claims. As an expressive work, *Boldly* is protected from DSE's trademark and unfair competition claims related to its title and contents. The Seussian illustrated style and stylized lettering in *Go!* fail to function as marks subject to trademark protection, as the court found. *Dastar* also precludes the trademark and unfair competition claims over matters within the domain of copyright law. The court correctly decided the case and should be affirmed in all respects.

Boldly animates, and is animated by, fair use. It is a playful mashup of elements from the original *Star Trek* series and from several Seuss books, creatively combined to new ends. Its bright colors and comic surfaces are laced with parodic commentary on *Go!*. *Boldly* deploys themes from *Star Trek* to contrast and critique *Go!*'s starkly egocentric, winner-take-all motif. The preamble to 17 U.S.C. § 107 enshrines its criticism and comment as customary purposes for fair use.

The court's fair use finding is well grounded in the four statutory factors: the purpose and character of the use; the nature of the copyrighted work; the amount and substantiality of the portion used; and the effect on the

potential market for, or value of, the copyrighted work. 17 U.S.C. § 107(1)-(4).

The first factor weighs strongly in Defendants' favor because *Boldly* makes highly transformative use of Seuss materials, with radically distinct purpose and effect. As a parody mashup, *Boldly* is intertextual, crafting new meanings from the interplay between *Star Trek*'s and Seuss's creative worlds. Jarring transpositions give *Boldly* a metafictional dimension that no Seuss book approaches. *Boldly*'s critical counter-narrative to *Go!*'s "hero's journey" cannot cause DSE any cognizable harm.

The second factor weighs no more than slightly in favor of DSE. *Go!*, *Sneetches*, and *Grinch* are no doubt creative works. They are also cultural touchstones and perennial best-sellers, entrenched in the public eye. Their widespread publication minimizes any conceivable negative effect of *Boldly*'s use.

The third factor weighs in favor of Defendants. By its nature, *Boldly* includes elements of its source materials, with background art, layouts, colors, shapes, objects, and character poses that refer directly to drawings in Seuss books, primarily *Go!*. Mashups and parodies must directly employ original source work as raw material for their creativity. *Boldly* uses no more

than needed from any Seuss book to serve its transformative purposes. Its uses are justified and appropriate to make the comedy work.

The fourth factor weighs in favor of fair use. The case hinged on this factor; it was all that prevented resolution on Defendants' first motion to dismiss. ER83-86. When Defendants' second motion to dismiss was also denied, the court explained that because *Boldly* is transformative, market harm could not be presumed. ER58. DSE speculates that it may be harmed when *Boldly* is published, but has not demonstrated it.

DSE's unsubstantiated claims of harm were facially implausible. *Boldly*, like *Star Trek*, is an adult entertainment laden with death, violence, sexual innuendos, and mature social commentary. Its Seussian veneer provides comic incongruity, not market competition for Dr. Seuss children's books or DSE's derivative works. Direct market substitution is unlikely because intertextual works do not have the same purpose or function as the texts they transform. *Boldly*'s literary effects depend on references to multiple earlier works. It is for readers who, having already digested Seuss and *Star Trek*, can appreciate its hybrid references to both. No licensed Seuss-derivative book depends on such cross-franchise references. DSE's Style Guide steers licensees away from the freewheeling mixture that Defendants created. Defendants' parody mashup is not within any of DSE's

“traditional, reasonable, or likely to be developed markets.” *Seltzer v. Green Day*, 725 F.3d 1170, 1179 (9th Cir. 2013). *Boldly* is simply outside the limited monopoly that copyright confers. Because market harm cannot be presumed and no reasonable basis to find it has been shown, the fourth factor weighs in favor of fair use.

Each factor supports a finding of fair use except perhaps the second, generally considered the least significant factor, which favors DSE at most slightly. *Boldly* embodies the goal of copyright to foster creative work built on the foundation of other creative work. DSE claims only speculative harms, which cannot justify the genuine harm this litigation causes Defendants every day that it prevents *Boldly* from going to market. The court’s fair use finding must be affirmed.

DSE’s trademark and unfair competition claims also could not withstand the court’s scrutiny. Its claim of trademark rights in *Go!*’s title does not overcome Defendants’ First Amendment right to use that title in an expressive work. The title of *Boldly* is itself a mashup, invoking both *Go!* and *Star Trek*’s famous split-infinitive opening line. By signaling the book’s techniques, it helps discourage any misconception that *Boldly* bears DSE’s imprimatur, as do *Boldly*’s express disclaimers and transformative content. The use of *Go!*’s title is artistically relevant to *Boldly*, and does not

explicitly mislead, so it is protected from DSE's claims under this Court's precedents applying *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

DSE also claimed trademark rights in Dr. Seuss's overall illustration style and a hand-lettering style used on his book covers. As the court rightly found, those are not legitimate trademarks at all. They are variable methods of marking. A fixed permutation of a style may be a mark, like a particular illustration or a specific hand-lettered logo, but styles *per se* do not function as trademarks. Under *Dastar*, any protection lies in the realm of copyright. Recognizing a trademark in such unbounded phantom marks would open a side door for copyright holders to expand infringement claims indefinitely.

V. ARGUMENT

A. *Boldly* makes fair use of the Dr. Seuss books

The Copyright Act recognizes the judicial doctrine of fair use. *Campbell*, 510 U.S. at 577. It sets out four non-exclusive factors courts must consider when assessing whether a use of a work is fair:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use on the potential market for or value of the copyrighted work.

17 U.S.C. § 107. All four factors “are to be explored, and the results weighed together, in light of the purposes of copyright.” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994).

“Fair use is not just excused by the law, it is wholly authorized by the law.” *Lenz*, 815 F.3d at 1151. “[F]air use is not an infringement of copyright”; it is “a right.” *Id.* at 1152 (quoting 17 U.S.C. §§ 107 & 108(f)(4)).

“Fair use both fosters innovation and encourages iteration on others’ ideas, ‘thus providing a necessary counterbalance to the copyright law’s goal of protecting creators’ work product.’” *VHT, Inc. v. Zillow Group, Inc.*, 918 F.3d 723, 739 (9th Cir. 2019) (quoting *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1163 (9th Cir. 2007)). Accordingly, the Copyright Act “limits the rights of a copyright owner regarding works that build upon, reinterpret, and reconceive existing works.” *Mattel, Inc. v. Walking Mtn. Prods.*, 353 F.3d 792, 799 (9th Cir. 2003) (citing *Campbell*, 510 U.S. at 575-77).

The fair use defense is therefore available to derivative works. *Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc.*, 964 F.2d 965, 970 (9th Cir. 1992). As the court recognized, a copyright holder’s right to prepare derivative works is subject to the right of fair use, and “a derivative work is

not foreclosed from being transformative (or constituting a fair use).” ER19-20, see 17 U.S.C. §§ 106(2) & 107.

DSE contends that *Penguin*, in which it defeated a fair use defense, is “the most relevant precedent” and controls this case. Opening Brief 25. Yet fair use is inherently fact-specific and entails a “case-by-case analysis.” *Campbell*, 510 U.S. at 577 “[E]ach case raising the question [of fair use] must be decided on its own facts.” H.R. Rep. No. 1476, at 65 (1976). In *Penguin*’s distinct fact pattern, a different book made different uses of different Seuss books, with no critical bearing on their substance or style and “no effort to create a transformative work with ‘new expression, meaning, or message.’” 109 F.3d at 1401 (quoting *Campbell*, 510 U.S. at 579). The new work failed to “target” the Seuss works and was found satirical, not parodic, and not transformative. *Id.* at 1400, 1401 n.9. Hauman considered *Penguin* and abided by it as he developed *Boldly* as a mashup that targets both *Go!* and *Star Trek* for parody and comment. ER335, ER343, ER355, ER479, ER1049.

1. *Boldly* is a parody mash-up that makes creative criticism and commentary about *Oh, the Places You’ll Go!*

“[T]he fair use of a copyrighted work ... is not an infringement of copyright.” 17 U.S.C. § 107. Section 107’s preamble lists illustrative examples of fair use purposes, including “criticism” and “comment.” *Id.*;

Campbell, 510 U.S. at 577. A fair use need not fit any of the preamble’s purposes, especially if the use is transformative and recontextual. See *Seltzer*, 725 F.3d 1170; *SOFA Entm’t, Inc. v. Dodger Prods.*, 709 F.3d 1273 (9th Cir. 2013); *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 612 (2d Cir. 2006). Yet the examples may guide courts even if the new use is not among the categories listed, as when *Campbell* held that “parody, like other comment or criticism, may claim fair use under § 107.” 510 U.S. at 578-79.

Parody “has an obvious claim to transformative value” because “it can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one.” *Id.* at 579. “Parody is an objectively defined rhetorical device.” *Walking Mtn.*, 353 F.3d at 801. The same is true of mashups, in which “artists combine two independent works in a new and unique way.” ER85.

Mashup is a rhetorical, aesthetic device that juxtaposes elements of existing works from different sources, creating a “synergistic effect that makes a different statement.” ER290. Its intertextuality applies the postmodern view of literature as fundamentally referential: a “conception of the ‘literary word’ as an intersection of textual surfaces rather than a point (a fixed meaning), as a dialogue among several writings: that of the writer, the

addressee (or the character), and the contemporary or earlier cultural context.” Julia Kristeva, “Word, Dialogue, and the Novel” (1966), in *Desire in Language* 66, Leon Rudiez ed., Thomas Gora and Alice Jardine trans. (Columbia University 1980). Thus in mashup and other forms of remix, as in parody, “meaning comes not from the content of what they say; it comes from the reference, which is expressible only if it is the original that gets used.” Lawrence Lessig, *Remix* 74 (Bloomsbury 2008).

The court did not consider *Boldly* parodic upon Defendants’ first motion to dismiss, perceiving no commentary on the Seuss books. ER80-81. Defendants did not press the point, as the court nevertheless found *Boldly* a transformative mashup. ER81, ER344. Yet “a parodic character may reasonably be perceived” as well, reinforcing its transformative nature. *Campbell*, 510 U.S. at 582. A parody is a “literary or artistic work that imitates the characteristic style of an author or a work for comic effect or ridicule.” *Id.* at 580. While Defendants respect Dr. Seuss and acknowledge his work as a cultural touchstone, ER311-12, their tongue-in-cheek parody mashup constructs an implicit critique of *Go!* by contrast with *Star Trek*.

On the surface, *Boldly* treats its sources as complementary, reflecting their commonalities. Both *Star Trek* and *Go!* show a “trek” with highs and lows, conveying encouragement—“an uplifting message (something over

which Plaintiff cannot exercise a monopoly).” ER19. Both are set in fantastic spaces with unusual design, and the science-fiction visuals of *Star Trek* backgrounds “already look like Seussian backgrounds in many ways.” ER180. But time and again, *Boldly* emphasizes their incongruities. In comic form, it embraces adult topics featured in *Star Trek* but absent from *Go!*—sex, love, friendship, death, violence, work, teamwork, community, duty, and mission. *Boldly* employs *Star Trek* (and cleverly, selections from other Seuss books) to subtly probe *Go!*’s underlying messages. It establishes a study in contrasts between *Go!*’s independent, individualist themes and *Star Trek*’s interdependent, universalist values.

Go! is a children’s book published by Random House Children’s Books in 1990. ER947. DSE told Defendants that *Go!* is an “iconic children’s book” and told Kickstarter that *Go!* is an “illustrated children’s book.” ER470, ER1862. [REDACTED]

[REDACTED] ER893-94, ER911, ER934. *Go!* does not address *Boldly*’s mature topics. It relates a childlike version of “the Hero’s Journey that Joseph Campbell talked about ... in a child appropriate language, like Mr. Rogers would have.” ER312. Unlike “Joseph Campbell’s model for a hero’s journey—a man rises from the dust, and with the help of mentors along the way, defeats a great and mighty evil—*Star Trek* is about a

powerful organization trying to negotiate the most humane way to move through a combustible galaxy.” Joseph Bien-Kahn, “*Star Trek* Is Brilliantly Political. Well, at Least It Used to Be,” *Wired* (Sept. 8, 2016), <https://www.wired.com/2016/09/star-trek-politics/>.

Star Trek was designed as social commentary for an adult demographic “about the challenges that adults face,” according to Gerrold, one of its original writers. ER291. *Boldly* reflects its mature themes. As Templeton explained, “a Dr. Seuss book is, like a children’s book. It’s a very safe, non-threatening environment for somewhat simple ideas that are expected to be presented to a younger reader. And *Star Trek* is in many ways the opposite. It’s a violent, sexual, sophisticated adult entertainment.” ER125. *Star Trek* is “high drama, life and death circumstances, things that are often very violent, sometimes very sexy. It’s a sophisticated world of fiction. And to place [*Star Trek* characters] in the context of [Dr. Seuss] is funny. It’s not where you would expect to see these kind of characters and situations.” ER124.

The worst places in *Go!* are a “not-so-good street,” Bang-Ups, Hang-Ups, a Lurch, a Slump, a “place you could sprain both your elbow and chin,” and The Waiting Place. ER949, ER955-56, ER957-59. *Boldly* is darker, confronting mortality and violent dangers. Monsters who killed *Enterprise*

crewmembers loom over Kirk on several pages. ER250, ER255, ER1110, ER1118. In a *Star Trek* in-joke, characters in red uniforms—“redshirts”—are doomed to die. ER248. “Because it’s their duty to end up quite dead,” Kirk dispatches two of them toward aliens who killed redshirts in TOS episodes. ER248, ER1109. An illustration foregrounds an assault by dagger and Kirks of increasing age queuing up to a gravestone marked R.I.P., as “deadly years fly.” ER1119. Klingons, aliens who “poisoned the grain,” taunt and torment Kirk with a cosmic wedgie. ER253, ER1114, 1126. *Boldly* sends shapes from a *Go!* layout to outer space, alongside an inapposite floating blue corpse. ER254, ER958, ER1117.

Sexual innuendo abounds in *Boldly*, alluding to one-night stands: “You’ll encounter lovers of every hue (though they’ll never be back for an episode two).” ER1111. Frolicking women surround Spock, referencing the subterranean “givers of pain and delight” from *Star Trek*’s episode “Spock’s Brain.” ER254, ER1115. A voyeur peeks over a wall. ER1121. *Boldly* bemoans “the captain can’t get a date,” illustrated by several of Kirk’s paramours as he pulls his boots on. ER1124. Templeton explained the *Star Trek* trope: “after Captain Kirk has bedded a lovely alien lady, you will always see in the scene afterwards, he will be pulling his boots back on. That was the sort of shorthand in *Star Trek* for ‘Captain Kirk got some.’” ER260.

Templeton pushed the innuendo further than even *Star Trek* dared: “the only male character there, he’s played as gay in the episode. So I was trying to suggest that possibly Kirk had a gay liaison.” *Id.*, ER1124. *Go!* does not raise such mature issues for its preadolescent protagonist.

These distinctions set the stage for *Boldly*’s critical aspect. *Go!* makes life a zero-sum game of winning, losing, and “points to be scored.” ER957, ER962. It measures success as surpassing and besting others, becoming “the winning-est winner of all,” with the pinnacle: “*Fame!* You’ll be famous as famous can be with the whole wide world watching you win on TV.” ER954, ER962. *Go!* encourages singlehanded world-beating: “*KID, YOU’LL MOVE MOUNTAINS!*” ER968. The *Go!* boy is so self-reliant as to be rootless. He has “enemies,” but no allies, partners, or friends. ER965. He flies alone, and “join[s] the high fliers” at a distance, never on the same page as his fellow balloonists; when he’s not leading the “gang” they abandon him. ER1071-76. His quest is ultimately for self-discovery and “further solitary triumphs.” Alison Lurie, *Boys and Girls Forever: Children’s Classics from Cinderella to Harry Potter* 102 (Penguin 2003). *Go!*’s “blurb describes the book as a ‘joyous ode to personal fulfillment.’ But what it really reads like is the yuppie dream—or nightmare—of 1990 in cartoon form.” *Id.* 100.

Boldly refracts that banal narcissism through a *Star Trek* lens, advocating not conquest but communion. Its success is not power or fame but engagement: exploring, understanding, and befriending others. ER1109-11, ER1114, ER1127. *Boldly* promotes survival rather than triumph over adversaries, with the Vulcan blessing “Live long and prosper!” ER1128-29. In *Boldly*, “you’ll never quibble” with other beings. ER1127. But “you might fall in love,” encounter one-episode lovers, and form more lasting bonds: “You’ll make lifelong friends. You’ll love them like brothers.” ER1111, ER1119. The “marvelous crew” hold hands and work together. ER1111, ER1120. Kirk and Spock work side by side. ER1116. Kirk has adult responsibilities: to lead the ship, and save Spock from peril. ER1115, ER1129. In turn, Kirk can rely on the crew to “get out of trouble,” even to sacrifice themselves as redshirts. ER1109, ER1121. Following *Star Trek*’s “prime directive” of non-interference with other cultures, *Boldly* encourages: “Here there be monsters, here there be dangers, but here you’ll make friends out of those who are strangers.” ER1120. *Go!* broaches no such possibilities.

Boldly points out *Go!* falling short of ideals touted not only in *Star Trek*, but also in earlier Seuss books. *Sneetches* criticizes social stratification in a “diatribe against bigotry”; *Grinch* promotes community and offer “messages against rampant consumerism.” Charles D. Cohen, *The Seuss, the*

Whole Seuss, and Nothing But the Seuss 309, 339 (Random House 2004). *Boldly*'s selections from those books shine a new light on *Go!*'s solitary journey, refocused on *Enterprise* camaraderie. Templeton replaced *Grinch*'s "Whos from Who-ville" with the diverse crew and Kirk's "lovers of every hue." ER197, ER981, ER1111. He redrew a *Sneetches* machine to signify the *Enterprise* transporter, the means both for crew missions and to be saved by the crew, "because in a pinch you'll be beamed out by Scotty." ER258-59, ER1012, ER1122. He rendered the "lonely games" played in *Go!* absurdly literal, turning a belligerent standoff in *Sneetches* into a contemplative chess match between two Spocks as four Kirks playing two-on-two basketball. ER82-83, ER259, ER1123. *Boldly*'s transformations place the hero-centered *Go!* in counterpoint to both *Star Trek* and Seuss' egalitarian past works, highlighting how

Oh, the Places You'll Go! has a different moral [than earlier Seuss works]. Now happiness ... is equated with wealth, fame, and getting ahead of others. Moreover, anything less than absolute success is seen as failure—a well-known American delusion, and a very destructive one. There are also no personal relationships here except that of competition. Unlike most of Seuss's earlier protagonists, the hero has no friends and no family.

Lurie, *Boys and Girls Forever* 104.

2. First factor: *Boldly*'s transformative character and purpose weigh in favor of fair use

“[T]he first factor assesses the character of the use, including whether it is commercial in nature, and, critically, whether it is ‘transformative.’” *VHT*, 918 F.3d at 742. “The central purpose of this inquiry is to determine whether and to what extent the new work is ‘transformative.’” *Perfect 10*, 508 F.3d at 1164 (quoting *Campbell*, 510 U.S. at 579). “The more transformative the new work, the less important the other factors, including commercialism, become.” *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 818 (9th Cir. 2003) (citing *Campbell*, 510 U.S. at 579); *SOFA*, 709 F.3d at 1278-79.

A transformative use “adds something new, with a further purpose or different character, altering the first with new expression, meaning or message.” *Campbell*, 510 U.S. at 579 (citing Hon. Pierre Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990)).

“If ... the secondary use adds value to the original—if the quoted matter is used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings—this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society.”

Seltzer, 725 F.3d at 1176 (quoting Leval at 1111). “[A]n allegedly infringing work is typically viewed as transformative as long as new expressive content or message is apparent.” *Id.* at 1177. “This is so even

where ... the allegedly infringing work makes few physical changes to the original or fails to comment on the original.” *Id.*

The first factor weighs heavily in favor of Defendants’ fair use. *Boldly* is radically and thoroughly transformative. Its parody mashup artfully skews and skewers *Go!*’s message. And even if its critical commentary and distinct message were not apparent, it transforms with extensive new content. *Boldly* reframes every Seuss element employed, supplants every Seuss character, raises mature issues and adult comic effects, and transports the lot into the “strange new worlds” of *Star Trek*.

DSE argues that “*Boldly* has the same purpose as *Go!* does: to entertain the reader with an uplifting story that teaches that obstacles can be confronted and surmounted.” Opening Brief 23. That oversimplifies matters. Mashups do entertain, but not like their source works; their juxtapositions appeal to media-literate, metacognitive readings alert to serendipitous correspondences and collisions. And *Boldly* offers deeper, more mature lessons than *Go!*. In *Boldly*, not all challenges are to be “surmounted”; some are fended off, others avoided, others simply endured. Success in *Boldly* is communion, mission, learning, and love, not conquest or fame. *Boldly* suggests an alternative to the individualistic, adversarial, winner-take-all *Go!*

mindset. DSE may not use it to monopolize the broad purpose of “entertainment.” Opening Brief 35-37.

DSE misreads *Boldly* as a story about the boy from *Go!* cloaked in *Star Trek* garb. *Id.* 37. As the court found, Defendants do not use any Seuss characters and *Boldly* replaces the boy with Kirk, “with his light, combed-over hair.” ER23 & n.21. That factual finding is well supported by the record. See ER130-32, ER136, ER175, ER291, ER421, ER762, ER766; see ER1110 & ER1114 (*Boldly*’s Kirk exhibiting male pattern baldness).

DSE contends that the court found that “mash-ups are inherently transformative.” Opening Brief 29-30, 44. The opposite is true. While immediately recognizing *Boldly* as “a highly transformative work,” the court explained that “not all mash-ups will or should succeed on a fair use defense; the level of creativity, variance from the original source materials, resulting commentary, and intended market will necessarily make evaluation particularized.” ER85. That particularized evaluation favors Defendants. Their highly creative work consistently reformulates any Seuss elements in an incongruous *Star Trek* hybrid. Its sly commentary aims for an adult market that has already absorbed Seuss enough to appreciate its references. ER84. Mashups surely tend to be transformative; Defendants’ commitment to transformation ensured that *Boldly* is.

3. Second factor: the nature of the Dr. Seuss books weighs slightly against fair use

Under the second factor, courts consider “the nature of the copyrighted work.” 17 U.S.C. § 107(2). This factor “typically has not been terribly significant in the overall fair use balancing.” *Penguin*, 109 F.3d at 1402. Its value is particularly limited when “the creative work of art is being used for a transformative purpose.” *Bill Graham Archives*, 448 F.3d at 612.

The second factor affords strong protection to creative work, mitigated by “the extent to which a work has been published.” *Seltzer*, 725 F.3d at 1178. When a creative work is “widely disseminated,” the second factor as a whole “weighs only slightly in [the plaintiff’s] favor.” *Id.*

Few creative books are more widely disseminated than *Go!*, a consistent best-seller with more than 12.5 million copies sold since 1990 and sales increasing in recent years. ER31, ER1507. *Grinch* and *Sneetches* also have sales in the millions. All three have had at least 80 Random House print runs. ER947, ER975, ER1005. With “millions of copies” published, “[t]he works’ published nature supports the fairness of the use.” *Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc.*, 780 F. Supp. 1283, 1293 (N.D. Cal. 1991), *aff’d*, 964 F.2d 965 (9th Cir. 1992). On balance, this least significant factor weighs at most slightly against fair use.

4. Third factor: *Boldly*'s limited and reasonable use of Dr. Seuss elements weighs in favor of fair use

The third factor addresses “the quantitative amount and qualitative value of the original work used in relation to the justification for that use.” *Seltzer*, 725 F.3d at 1178 (citing *SOFA*, 709 F.3d at 1279 and *Campbell*, 510 U.S. at 586). This factor “necessarily overlaps somewhat with the first factor—the ‘extent of permissible copying varies with the purpose and character of the use.’” *Id.* (quoting *Campbell*, 510 U.S. at 586-87). Thus, this factor “recognizes that fragmentary copying is more likely to have a transformative purpose than wholesale copying.” *On Davis v. Gap, Inc.*, 246 F.3d 152, 175 (2d Cir. 2001). “If the secondary user only copies as much as is necessary for his or her intended use, then this factor will not weigh against him or her.” *Kelly*, 336 F.3d at 820-21. “The inquiry under this factor is a flexible one, rather than a simple determination of the percentage of the copyrighted work used.” *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1179 (9th Cir. 2012).

The third factor weighs in favor of fair use because the creative, transformative purposes of Defendants’ mashup justify the extent of its use both quantitatively and qualitatively. DSE contests the substantiality of *Boldly*’s use of Seuss illustrations, without mentioning that none were used “in their entirety” as alleged. Opening Brief 42-48, ER82, ER705. Select

fragments of Seuss drawings were redrawn with all Seuss characters beamed out, and repopulated with new life and objects from the *Star Trek* universe. Defendants judiciously incorporated just enough of the originals to be identifiable and serve the comedic purposes of their parody mashup. As the court found,

Defendants took discrete elements of the Copyrighted Works: cross-hatching, object placements, certain distinctive facial features, lines written in anapestic tetrameter. Yes, these are elements significant to the Copyrighted Works, but Defendants ultimately did not use Dr. Seuss' words, his character, or his universe.

ER24.

The uses are not quantitatively substantial. Dr. Seuss wrote almost 60 books. ER670. *Boldly* makes limited use of illustrations from five of them. See ER696. Partly conceding that limited use, DSE sought summary judgment regarding only *Grinch*, *Sneetches*, and *Go!*, the three “relevant works” on appeal. ER4, Opening Brief 3.

Boldly makes use of discrete elements from just one *Grinch* illustration and two in *Sneetches*, which are 64-page illustrated books. ER1111, ER1122-23, ER971-1041. A close-up on 15 *Star Trek* characters holding hands alludes to a *Grinch* long-shot of 40 singing Whos, some posed similarly. ER981, ER1111. The background and positioning of a *Sneetches* argument becomes the setting for *Star Trek* chess and basketball

matches, and an *Enterprise* crew's transporter journey revisits the poses and positioning of characters and a machine in another *Sneetches* illustration.

ER1012, ER1022, ER1122-23. Each uses only what transformation requires. See ER82-83. These modest, incongruous, revamped uses are no substitute for *Sneetches* or *Grinch* and do not threaten the market for any Seuss book.

Boldly also makes limited, justified use of elements from illustrations in *Go!*, a 48-page book. ER943-70. DSE acknowledges that the cover of *Boldly* "contains fairly few of the artistic elements of *Go!*'s cover." Opening Brief 47, ER1105. The same is true for the contents. ER1107-08, ER1110, ER1112, ER1114, ER1117-21, ER1124-25, ER1127-28. The primary Seuss elements incorporated from *Go!* are traces of character poses and positions, retrofitted onto *Star Trek* figures. Defendants' purposes necessitated that use. Because *Boldly* includes no Seuss characters, Templeton found it "essential to the parody ... that people recognise the source material in poses." DER42, ER8.

Some of his art also includes discrete objects, layouts, or background shapes from *Go!*. Defendants' parody mashup purposes justify those vestiges of Seuss. Templeton drew "layouts (and the incidental bits of machinery, etc.) as accurate to the originals as I could to maintain the parody element ... it wasn't enough to make it 'feel' like Seuss, it had to match the

design and layouts as well.” ER410. As he found, using less would lessen the effect, and making *Boldly* less reminiscent of Seuss books would undermine “the parody element.” ER410, DER42. They took the amount needed to serve their transformative purposes.

The Seuss uses are also not qualitatively substantial. DSE’s one argument to the contrary is that the amount used conveys “the ‘feel’ of a true Dr. Seuss book.” Opening Brief 44. That is not germane because copyright only protects “original works of authorship fixed in any tangible medium of expression.” 17 U.S.C. § 102(a); *SOFA*, 709 F.3d at 1279. *Go*’s artwork is under copyright, but its “feel” is a matter of style—not fixed, not tangible, not an expression, and not protected. “[C]opyright infringement requires a similarity of expression, not ideas.” *Mattel, Inc. v. MGA Entm’t, Inc.*, 616 F.3d 904, 917 (9th Cir. 2010); see 17 U.S.C. § 102(b). As DSE knows, Dr. Seuss’ “[g]eneral style, not fixed in any single work, may not be protected” by copyright. *Dr. Seuss Enters., L.P. v. Penguin Book USA, Inc.*, 924 F. Supp. 1559, 1568 n.11 (S.D. Cal. 1996).

DSE notes that using material from “near the creative heart of the original” may be qualitatively significant and weigh against fair use. Opening Brief 42. In fair use jurisprudence, “the heart” of a work is its most valuable or significant part. See *Harper & Row, Publishers v. Nation*

Enters., 471 US. 539, 564-65 (1985). DSE does not claim that any *Go!* illustration stands out as qualified, it contends without support that the referenced drawings from *Grinch* and *Sneetches* were somehow “central.” Opening Brief 43. But those three drawings depict only plot points. The stories’ climaxes and morals have stronger claims to primacy. See ER999-1000, ER1019, ER1024. So would the characters, who also do not appear in *Boldly*. [REDACTED]

[REDACTED] DER136.

To change the substantiality denominator, DSE suggests that each Seuss drawing would have its own copyright “if it had not been published in book form.” Opening Brief 46. But the third factor concerns “the portion used in relation to the copyrighted work as a whole,” and the copyrighted works are complete books. 17 U.S.C. § 107(3), ER695.

DSE claims that the court “never identified *any* limitation on how much a mash-up could take from another work[.]” Opening Brief 44. But the court cited and applied this Court’s standard—a user may take “no more than necessary for his intended use”—and found that Defendants met it. *Seltzer*, 725 F.3d at 1178; ER2124-23, ER82-83.

A use that “does not show more than is reasonably necessary ... to allow the ... jokes, comments, and criticisms to make sense to the viewer and resonate ... favors fair use” under the third factor. *Equals Three, LLC v. Jukin Media, Inc.*, 139 F. Supp. 3d 1094, 1107 (C.D. Cal. 2015). Because the Seuss use is no more than justifiable for their transformative purposes, the third factor weighs in favor of fair use.

5. Fourth factor: DSE’s failure to present evidence of any negative market effect weighs in favor of fair use

The fourth factor is “the effect of the use upon the potential market for or value of the copyrighted work.” 17 U.S.C. § 107(4). It distinguishes “between the copying of works in order to make independent creative expression possible and the simple exploitation of another’s creative efforts.” *Sega Enters. v. Accolade, Inc.*, 977 F.2d 1510, 1523 (9th Cir. 1992).

“Market harm is a matter of degree, and the importance of this factor will vary, not only with the amount of harm, but also with the relative strength of the showing on the other factors.” *Id.* at 591 n.21. “The more transformative the new work, the less likely the new work’s use of copyrighted materials will affect the market for the materials.” *Elvis Presley Enters. v. Passport Video*, 349 F.3d 622, 631 (9th Cir. 2003).

This factor requires “assessing the likelihood of significant market harm[.]” *Campbell*, 510 U.S at 590. “Assuming a transformative use, the

fourth factor should weigh against the defendant only when the harm is substantial.” William F. Patry, *Patry on Copyright* § 10:153.

“This inquiry must take account not only of harm to the original but also of harm to the market for derivative works.” *Harper & Row*, 471 U.S. at 568. However, “[t]he market for derivative uses includes only those that creators of original works would in general develop or license others to develop.” *Campbell*, 510 U.S. at 592. Therefore the derivative-market analysis considers only “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)). Courts also contemplate “whether unrestricted and widespread conduct of the sort engaged in by the defendant ... would result in a substantially adverse impact on the potential market for the original.” *Campbell*, 510 U.S. at 590.

The record includes no evidence that *Boldly* will cause DSE any negative market effect, and substantial evidence that it will not. DSE’s extensive sales and licensing demonstrates a market, not an effect. DSE has cross-licensed derivative products, but none is remotely like *Boldly*. A cross-licensing deal is not a mashup. Defendants demonstrated that DSE’s Style Guide warns its licensees against anything of the sort. Defendants also demonstrated that fair use works entered the market based on Seuss books

including *Go!* and *Grinch*, and DSE has not shown or claimed any resulting effect. Market harm cannot be presumed because *Boldly* is a transformative work, with a different function and market effect. On this record, no substantial market effect has been shown and none will be felt.

DSE contends that under *Penguin*, a “presumption of market harm” arises because “*Boldly* is a commercial work.” Opening Brief 23, 27. The Supreme Court debunked that before *Penguin* was decided. Harm is presumed only “when a commercial use amounts to mere duplication of the entirety of an original.” *Campbell*, 510 U.S. at 591. “[T]his presumption does not arise when a work is transformative[.]” *Perfect 10*, 508 F.3d at 1168. “In light of the Supreme Court’s admonition eschewing presumptions under this factor, we refrain from presuming harm in the potential market[.]” *Monge*, 688 F.3d at 1181. *Boldly* is transformative, not a page-for-page copy, so harm cannot be presumed.

And because it is highly transformative, *Boldly* is not a direct market substitute for *Go!*, *Sneetches*, or *Grinch*. “A transformative work is less likely to have an adverse impact on the market of the original than a work that merely supersedes the copyrighted work.” *Kelly*, 336 F.3d at 821. Any “‘cognizable market harm’ is limited to ‘market substitution.’” *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87, 99 (2d Cir. 2014) (quoting *Campbell*,

510 U.S. at 591). “In other words, under Factor Four, any economic ‘harm’ caused by transformative uses does not count because such uses, by definition, do not serve as substitutes for the original work.” *Id.* (citing *Bill Graham Archives*, 448 F.3d at 614). “Where the allegedly infringing use does not substitute for the original and serves a ‘different market function,’ such factor weighs in favor of fair use.” *Seltzer*, 725 F.3d at 1179 (quoting *Campbell*, 510 U.S. at 591).

Fair use has been labeled an “affirmative defense.” *Campbell*, 510 U.S. at 590. That description was developed through “bald statements in the Supreme Court that lack any reasoned analysis.” Ned Snow, *Proving Fair Use: Burden of Proof as Burden of Speech*, 31 *Cardozo L. Rev.* 1781, 1788 n.62 (2010). This Court explicitly rejects that label: “‘Congress did not intend fair use to be an affirmative defense—a defense, yes, but not an affirmative defense.’” *Lenz*, 815 F.3d at 1153 (quoting Lydia Pallas Loren, *Fair Use: An Affirmative Defense?*, 90 *Wash. L. Rev.* 685, 688 (2015)).

“[F]air use is uniquely situated in copyright law so as to be treated differently than traditional affirmative defenses.” *Id.* While the proponent of a true affirmative defense generally bears the burden of proof as to all elements, for a standard defense like fair use, it suffices to show that the plaintiff failed to overcome it: “A defense which demonstrates that plaintiff

has not met its burden of proof is not an affirmative defense.” *Zivkovic v. S. Cal. Edison Co.*, 302 F.3d 1080, 1088 (9th Cir. 2002).

The Supreme Court has looked to copyright holders to demonstrate harm under the fourth factor to defeat fair use. “[T]o negate fair use one need only show that if the challenged use ‘should become widespread, it would adversely affect the *potential* market for the copyrighted work.’” *Harper & Row*, 471 U.S. at 568 (quoting *Sony Corp. of America v. Universal Studios, Inc.*, 464 U.S. 417, 451 (1984)). When a use is noncommercial, the copyright holder must show “by a preponderance of the evidence that some meaningful likelihood of future harm exists.” *Sony*, 464 U.S. at 451. Because that likelihood is not presumed for noncommercial use, “it must be demonstrated.” *Id.*

That demonstration must come from DSE. As in *Sony*, only potential market harm could be at issue, because *Boldly* remains unpublished. Opening Brief 16. And likewise, as harm from a transformative use also cannot be presumed, any evidence of harmful effect should be from the party with an interest in showing it. Plaintiffs “can reasonably be expected to have the evidence as to availability of licenses for their own works. It is therefore reasonable to place on Plaintiffs the burden of going forward with the evidence on this question [of the fourth factor].” *Cambridge Univ. Press v.*

Patton, 769 F.3d 1232, 1279 (11th Cir. 2014). While Defendants “retain[] the overall burden of persuasion on the fourth factor,” *id.* at 1280, an evidentiary burden on market harm rightly falls on the plaintiff to show that the use “harmed any existing market or a market that [defendant] was likely to develop.” *Seltzer*, 725 F.3d at 1179. The fourth factor weighs in defendants’ favor when the plaintiff provides no evidence demonstrating a market impact. *Norse v. Henry Holt & Co.*, 847 F. Supp. 142, 147 (N.D. Cal. 1994), *Calkins v. Playboy Enters. Int’l, Inc.*, 561 F. Supp. 2d 1136, 1143-44 (E.D. Cal. 2008).

DSE acknowledged its burden at the summary judgment motion hearing. The court asked DSE: “The burden rests on defendants to establish their fair use defense, but what burden, if any, does plaintiff carry in establishing a likelihood of market harm in this case?” DER63-64. DSE recognized that under the applicable jurisprudence set forth in the order on the second motion to dismiss, “to the extent a work is deemed transformative from a fair use perspective, market harm is not presumed.” DER64, ER58. If, DSE continued, “the use is a transformative one, that does mean that while the defendant has the overall burden of proof on fair use as it is an affirmative defense, it would then be up to Dr. Seuss Enterprises as plaintiff and copyright owner to prove market harm without being afforded a

presumption.” DER64. Despite DSE’s misgivings, that answer was a “plain concession,” not “an equivocal statement,” and a fair assessment of the law and the posture of the case. Opening Brief 50.

Until summary judgment, the four factors stood in a “near-perfect balancing,” as after both motions to dismiss: the first weighed in favor of fair use, the second slightly against, the third did not weigh against Defendants, and the fourth was unresolved. ER7-13, ER55-58, ER81-86. DSE moved for summary judgment that “as a matter of law ... the fair use doctrine does not shield Defendants’ infringing conduct.” DER2. Yet with a paucity of evidence in its favor, DSE claimed only speculative harms in unrelated markets. Its expert testified only about trademark. ER36. Though DSE argued “that some would-be purchasers of *Go!* would instead purchase *Boldly* for a Trekkie graduate, there [was] a dearth of evidence or expert testimony permitting the Court to extrapolate the likely effect—if any—that *Boldly* may have on sales of *Go!*.” ER31.

Courts look “to the type of work itself in determining market harm.” *Walking Mtn.*, 353 F.3d at 805. That category is not drawn broadly. This Court declined to consider the potential effects of parody photographs of Barbie on the entire “licensing market for art in general.” *Id.* Likewise, for the parody rap song in *Campbell*, the relevant markets were for parodies and

for rap music, “and the derivative market for rap music [was] a proper focus of enquiry.” 510 U.S. at 592-93.

Boldly is a parody mashup. ER445. It is therefore reliant on comedic metafictional references to creative elements from another franchise. Only licensed DSE derivatives with those features, or within the parody or mashup markets, could face any cognizable harm in any of DSE’s “traditional, reasonable, or likely to be developed markets.” *Seltzer*, 725 F.3d at 1179. DSE’s derivative works that are neither parodies nor mashups are not in a potential licensing market germane to the analysis.

There is no cognizable licensing market for parodies. *Walking Mtn.*, 353 F.3d at 805. DSE produced no evidence of a cognizable licensing market for mashups, as the term is generally understood. Mashup typically means an intertextual artwork in a literary, video, musical, or visual medium. DSE seeks to redefine it as synonymous with a “collab”: a use of its intellectual property with a partner’s intellectual property to create a new work. ER902, ER907. DSE asserts that it “has engaged in collaborations that combine DSE and another owner’s intellectual property, *i.e.*, mash-ups,” and “mash-up type collaborations with other copyright owners.” Opening Brief 54, 20. DSE has not identified anyone else who shares its idiosyncratic definition, which confuses a creative method or artistic genre with a

marketing strategy. Simply calling licensees “collaborators” does not make cross-licensing deals into rhetorical devices. *Boldly* is not a “collab” and is not in the market for DSE-licensed co-branding initiatives.

DSE failed to show that the market for *Go!* or other DSE derivatives is even substantially related to the potential market for *Boldly*. No Seuss book, and no DSE-licensed derivative book, is a literary mashup reliant on metafictional references to creative elements from another franchise. See ER888-89, ER1217-69, ER1315-1500. Mashups are not within a traditional, reasonable, or likely market for DSE.

The products of DSE’s licensing have little in common with *Boldly*. Its licensed books do not wade into *Boldly*’s adult territory. Each licensed collaborative work DSE identifies features at least one Seuss character, though none appear in *Boldly*. Opening Brief 3-4. DSE notes that it has licensed works that “mix characters from Dr. Seuss and other creators.” *Id.* 55, ER32. But that’s not what *Boldly* does; it lets aliens interact in Seussian spaces, effacing Seuss characters completely. DSE has never licensed a mashup book combining non-character elements of Seuss books with existing characters from *Star Trek* or any other franchise, and it does not show that it is reasonably likely to.

Instead, treating Dr. Seuss as a brand, DSE has licensed brand extensions. ER934. In some, Seuss characters are recast as Funko dolls, ER1805-33, or as Jim Henson puppets in Nickelodeon's '90s TV series *The Wubbulous World of Dr. Seuss*, and derivative products, ER1578-80 & ER1729-67. In others, Seuss characters make cameo appearances in other products, like the *Grinch* Christmastime custom version of Fun City's video game *Panda Pop*. ER1286, ER1772-96, ER1835-40. Among DSE's many branded derivative goods, the licensed books stay firmly within the Seuss universe. DSE's Henson collaboration yielded books with "'muppetized' Dr. Seuss characters, ER4, but none interacting with Kermit and Miss Piggy or strolling down Sesame Street. The polyphony of mashups would be out of place in their orthodox, canonical world.

To maintain its uniformity, DSE provides its licensees a proprietary Style Guide "to help them start designing products for Dr. Seuss [Enterprises]." ER32, ER928-29, ER939. The Style Guide depicts the "proper use" of the characters, text, and images in the Seuss books, and of DSE's trademarks. ER1774, ER1781. Through its Style Guide, DSE aims to create "consistency across works." DER56.

Given its obligations as a trademark owner to maintain consistency across its licensees' use of its trademarks, DSE created a Style Guide for its licensees and partners, which provides extensive direction on maintaining and meeting the

Seussian style. ... The consistent look and style of its licensees' books and other products is so vital to DSE to denote the Dr. Seuss brand that DSE also has specific style guides that instruct on the permissible colors, designs, and images for the licensed work.

DER56. "DSE maintains strict quality control" over licensees' use of its alleged trademarks and distributes the Style Guide "to ensure uniformity of style and quality" across licensed products. DER57. [REDACTED]

[REDACTED]

[REDACTED] DER244.

Its "Do's and Don'ts" section instructs DSE licensees not to mix Seussian and non-Seussian elements: [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] DER135. Licensees are further admonished that [REDACTED]

[REDACTED] and

to avoid [REDACTED]

DER134-35.

DSE requires the rights to review and approve licensed works. Its typical licensing agreement [REDACTED]

[REDACTED] ER911. When DSE licenses a derivative book to Random

House, it “reviews all stages of the publishing of that book, both the manuscript, the layouts, the visuals, the cover, the marketing, and the advertising.” ER879. DSE “is intimately involved in the development and publishing of our books. . . . We come up with the idea of books. We approve manuscripts. We approve [page]-by-page layouts, sketches, art, cover, marketing, release dates, sales, all aspects of bringing a book to market.” *Id.*; ER1322-23, ER1344-75; ER1326, ER1377-92, ER1484-1500; ER1332, ER1403-82; ER1340-41, ER1390-1401. DSE requires the same rights for other derivative works. ER1732-34, ER1762 ER1779-81, ER1812-15.

DSE’s restricts and requires its licensees to avoid the free, creative license that Defendants exercised in *Boldly*. DSE would not license such a book. It is categorically off limits.

DSE speculates “that a meaningful percentage of graduating high school and college seniors, for whom *Go!* would ordinarily be purchased by friends or relatives, are *Star Trek* fans and would be entertained by” *Boldly*. Opening Brief 38. Speculation is not evidence that DSE stands to lose a single sale even in its hypothetical scenario. DSE contends, without evidence, that “the potential audience for *Boldly* is simply a subset of the potential audience for *Go!* and *Go!* derivatives.” Opening Brief 38. To the contrary, the court found that “*Boldly*’s market relies on consumers who

have *already* read and greatly appreciated *Go!* and Dr. Seuss's other works, and who simultaneously have a strong working knowledge of the *Star Trek* series." ER12, ER25, ER29, ER55, ER84 (emphasis added). Seuss is a children's author, so his typical readership ages out after a few years. *Star Trek* is one adult franchise they may move to after consuming Seuss to their satisfaction. That is a subsequent audience, not a subset. Reading *Boldly* before devouring *Go!* (or binging *Star Trek*) would miss half the joke.

DSE claims that Defendants "specifically targeted this graduation gift market." Opening Brief 38. That distorts the record. AMP or ThinkGeek may have targeted graduate sales, but Defendants' primary intended audience was *Star Trek* fans. ER30-31, DER30, ER444-52. Moreover, even if Defendants had targeted graduation sales, there is no basis to find DSE would be harmed. DSE cannot fully occupy the field of books given as gifts in May.

While DSE points to no evidence of potential market harm, substantial evidence indicates that *Boldly* will not cause harm. DSE's licensing practices, history, and Style Guide all suggest it would lose no licensing revenues from *Boldly* or works of its kind. Defendants did not see *Boldly* as a children's book or "expect it to be read by 5 year olds." ER125, ER185. DER26. They thought children would not appreciate the jokes, and

they were aiming for adult readers familiar with Seuss and TOS episodes, who would. ER125, ER185, ER291. *Boldly* “was intended as an adult parody of a kids book.” ER291. DSE is unlikely to turn against its core market by licensing such works.

In addition, there is no evidence that DSE is sustaining losses from the Seuss fair uses on the market. *Who’s Holiday*, a bawdy *Grinch* parody, was produced on Broadway in 2017. Elizabeth Vincentelli, “A Raunchy Riff on Dr. Seuss’s Yuletide Tale,” *New York Times* (Dec. 8, 2017) p. C2, <https://www.nytimes.com/2017/12/04/theater/review-whos-holiday-dr-seuss.html>. DSE had sent pre-production cease-and-desist letters, but the playwright won a declaratory judgment finding the play a fair use. See *Lombardo*, 279 F. 3d at 502-04. *The Go!* parody *Meetings*, sold by an imprint of Penguin Random House, has been on the market since April 2017. It has no DSE license, yet its publication *in graduation season* drew no DSE legal action. *Meetings* occupies a share of the market for fair use works based on *Go!* that DSE has blocked Defendants from entering since 2016.

DSE does not contend that *Meetings* or *Who’s Holiday* have harmed the market for *Go!* and *Grinch* or DSE-licensed derivatives. To the contrary, *Go!* still tops the New York Times Best Sellers list every year during

graduation season. Opening Brief 2. And in 2018, a *Grinch*-derivative movie became one of DSE's most lucrative licensed derivative works; its box-office gross topped \$270 million in the United States and \$511 million worldwide. See Anthony D'Alessandro, "How Much Green Did 'The Grinch' Steal?," *Deadline* (Mar. 26, 2019),

<https://deadline.com/2019/03/the-grinch-box-office-profit-2018-1202582389/amp/>.

DSE notes that the court did not specifically find that widespread similar uses would not harm it. Beyond its Doomsday scenario, DSE presented no evidence that *Boldly* would open the floodgates. Other than *Boldly*, and perhaps the book enjoined in *Penguin*, DSE is not aware of any unlicensed book that has used elements of Dr. Seuss works in combination with elements of another intellectual property holder. ER908-09. Neither *Boldly* nor its niche market of unlicensed mashups is likely to harm the markets of their source works or licensed derivatives because they are fundamentally distinct. "[T]he law recognizes no derivative market for critical works, including parody." *Campbell*, 510 U.S. at 592. Speculation is not a sufficient basis to presume market harm from transformative mashups.

6. Weighed together in light of the purposes of copyright, the fair use analysis supports a finding of fair use

As the court recognized, *Boldly* stands with an “emerging ‘mash-up’ culture,” and “if fair use was not viable in a case such as this, an entire body of highly creative work would be effectively foreclosed.” ER85. The hybrid creativity *Boldly* unleashes is especially unlikely to find its audience if mashups must endure a license-or-litigate gauntlet from *two* copyright holders. “The fair use doctrine ‘permits and requires courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.’” *Seltzer*, 725 F.3d at 1175 (quoting *Campbell*, 510 U.S. at 577).

Boldly is “a highly transformative work that takes no more than necessary to accomplish its transformative purpose and will not impinge on the original market for Plaintiff’s underlying work.” ER85. Nothing in the record, beyond sheer speculation, suggests that it will harm the market for any Seuss book or its derivatives, and record evidence suggests it cannot. The first factor weighs in favor of highly transformative fair use; the second weighs at most slightly against; the third and fourth favor fair use, or do not stand against it. In tandem, in light of the purposes of copyright, *Boldly* makes fair use of Seuss’s works. The copyright ruling should be affirmed.

B. *Boldly* does not infringe on any legitimate DSE trademark

1. *Boldly*'s use of the title of *Go!* is protected under the *Rogers* test

The court properly dismissed the trademark and unfair competition claims related to the title of *Boldly*, applying the test set forth in *Rogers v. Grimaldi*, as interpreted and applied by this Court, particularly in *Twentieth Century Film Corp. v. Empire Distribution, Inc.*, 875 F.3d 1192 (9th Cir. 2017).

The First Amendment is especially solicitous toward the use of trademarks in expressive works. “Because overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.” *Rogers*, 875 F.2d at 998. Under *Rogers*, expressive works are shielded from trademark infringement and unfair competition claims over artistically relevant uses that do not explicitly mislead. That is the complete test, and *Boldly* satisfies it. Under *Empire*, the test unequivocally applies to trademark use in the titles of expressive works. And this Court’s decision in *Gordon v. Drape Creative, Inc.*, 909 F.3d 257 (9th Cir. 2018) strongly supports Defendants’ use of the mark.

It is uncontested that *Boldly* is an expressive work making use of a registered mark, so the two-prong *Rogers* test applies. The test “insulates

from restriction titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading but leaves vulnerable to claims of deception titles that are explicitly misleading as to source or content, or that have no artistic relevance at all.” *Rogers*, 875 F.2d at 1000.

It is also uncontested that the first prong is satisfied: use of the title of *Go!* is highly relevant to *Boldly*. That leaves the second prong, under which the title may not “explicitly mislead[] as to the source or content of the work.” *Id.* at 999.

The title of *Boldly* does the opposite of explicitly misleading consumers. As it mashes up Seuss and *Star Trek*, telegraphing the book’s transformative methods, it tells readers in an instant what to expect inside. And inside, the book explicitly disclaims any association with or endorsement from DSE. ER1107. As the court recognized, “Defendants have done nothing in conjunction with the use of the mark to suggest sponsorship or endorsement.” ER72. That should suffice.

Gordon does not call for a different result. This Court found that a defendant’s use of a trademark slogan on the cover of greeting cards, “without any other text,” may explicitly mislead as to source. 909 F.3d at 271. *Boldly*, a 48-page book, is not so unadorned. The *Enterprise* occupies half of its cover and Kirk stands front and center, further indications that this

is not a DSE product. ER1105. Thus, Defendants do not “use the mark in the same way” as DSE. *Gordon*, 909 F.3d at 270. They fuse it with *Star Trek* references in the title itself, on the cover, and on every page, suffusing *Boldly* with ample jarring disconnections to dissuade any reader about any DSE role. For the same reason, Defendants undoubtedly “added [their] own expressive content to the work beyond the mark itself.” *Id.* at 271. The title of *Go!* “is used as only one component of [Defendants’] larger expressive creation.” *Id.* Accordingly, the additional considerations raised in *Gordon* weigh further in favor of Defendants.

Under *Gordon*, it is the plaintiff’s burden to show that the use is explicitly misleading. 909 F.3d at 265. DSE cannot on these facts. The First Amendment protection would be dissipated if this sufficed to require trial. *Rogers* calls for the judgment to be affirmed.

2. Illustrative styles and lettering styles do not constitute trademarks

DSE claimed trademark rights in Dr. Seuss’s illustrative style and in his hand lettering style. Neither is a valid trademark so judgment for Defendants must be affirmed on this matter as well.

A plaintiff asserting a trademark claim bears the burden of establishing a protectable trademark. DSE does not establish it. “A trademark is a limited property right in a particular word, phrase, or

symbol.” *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992). DSE’s trademark claims in generalized stylistic elements are untethered from any particularity. Dr. Seuss was not the first or last to employ any of the elements of his style, and assigning DSE proprietary rights over the elements of style would drain the pool of creative resources available to all artists.

What is style? In a nice turn of phrase, Templeton testified: “Style is essentially your willingness to accept your imperfections.” ER234. “There are elements of Seuss’s style that are common. There are elements of Seuss’s style that are unique to him because of the imperfections that all illustrators have.” ER240. He sees the Dr. Seuss style as “cartoony,” typified by rubbery bones and big noses. *Id.* Yet many cartoonists “illustrate in a style almost identical to Seuss’s.” ER240-41. For example, “You might see a Dr. Seuss machine and think that it was drawn by Sergio Aragones. The [stylistic] range you can have for a silly, whimsical machine is somewhat limited.” ER256. Allowing anyone to monopolize such elements of our common culture as an artistic style is fundamentally antithetical to freedom of expression.

Hauman, a comics industry professional for decades well versed in publishing contracts, does not believe artistic styles are generally licensable,

and has never seen anyone even “try to license an artistic style.” ER194, ER339. DSE put up no evidence that a style *per se* is licensable or ownable. In effect, it asks trademark to do what copyright could not, and convey exclusive rights over the content of *Go!* that would prevent Defendants’ use. But under *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2001), what copyright cannot protect is subject to copying. The claims must be denied, and the court’s judgment affirmed in full.

DATED: October 4, 2019

Respectfully Submitted

s/ Dan Booth

Dan Booth
Dan Booth Law, LLC
60 Thoreau Street #121
Concord, MA 01742
Telephone: 646-573-6596

Michael Licari
Sprinkle Lloyd & Licari LLP
2801 B. St. Ste. 556
San Diego, CA 92102
Telephone: 858-717-0013

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

Form 8. Certificate of Compliance for Briefs

Instructions for this form: <http://www.ca9.uscourts.gov/forms/form08instructions.pdf>

9th Cir. Case Number(s)

I am the attorney or self-represented party.

This brief contains words, excluding the items exempted

by Fed. R. App. P. 32(f). The brief's type size and typeface comply with Fed. R. App. P. 32(a)(5) and (6).

I certify that this brief (*select only one*):

- complies with the word limit of Cir. R. 32-1.
- is a **cross-appeal** brief and complies with the word limit of Cir. R. 28.1-1.
- is an **amicus** brief and complies with the word limit of Fed. R. App. P. 29(a)(5), Cir. R. 29-2(c)(2), or Cir. R. 29-2(c)(3).
- is for a **death penalty** case and complies with the word limit of Cir. R. 32-4.
- complies with the longer length limit permitted by Cir. R. 32-2(b) because (*select only one*):
 - it is a joint brief submitted by separately represented parties;
 - a party or parties are filing a single brief in response to multiple briefs; or
 - a party or parties are filing a single brief in response to a longer joint brief.
- complies with the length limit designated by court order dated .
- is accompanied by a motion to file a longer brief pursuant to Cir. R. 32-2(a).

Signature

Date

(use "s/[typed name]" to sign electronically-filed documents)

Feedback or questions about this form? Email us at forms@ca9.uscourts.gov

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

Form 17. Statement of Related Cases Pursuant to Circuit Rule 28-2.6

9th Cir. Case Number(s) Dr. Seuss Enterprises L.P. v. Comic Mix et al. 19-55348

The undersigned attorney or self-represented party states the following:

I am unaware of any related cases currently pending in this court.

I am unaware of any related cases currently pending in this court other than the case(s) identified in the initial brief(s) filed by the other party or parties.

I am aware of one or more related cases currently pending in this court. The case number and name of each related case and its relationship to this case are:

Signature s/ Dan Booth **Date** October 4, 2019

(use "s/[typed name]" to sign electronically-filed documents)

CERTIFICATE OF SERVICE

I certify that I electronically filed this APPELLEES ANSWERING BRIEF with the United States Court of Appeals for the Ninth Circuit via the Court's CM/ECF system on October 4, 2019, and that service will be made on counsel of record via e-mail/electronic delivery pursuant to an agreement between the parties.

s/ Dan Booth

Dan Booth
Dan Booth Law, LLC
60 Thoreau Street #121
Concord, MA 01742