

1 Christopher W. Arledge (Bar No. 200767)
 carledge@onellp.com
 2 John Tehranian (Bar No. 211616)
 jtehranian@onellp.com
 3 **ONE LLP**
 4 4000 MacArthur Boulevard
 West Tower, Suite 1100
 Newport Beach, California 92660
 5 Telephone: (949) 502-2870
 Facsimile: (949) 258-5081
 6

7 Attorneys for Defendants Charles S. DeVore and
 Justin Hart
 8

9 **UNITED STATES DISTRICT COURT**
 10 **CENTRAL DISTRICT OF CALIFORNIA**

11 DON HENLEY, MIKE CAMPBELL, and
 12 DANNY KORTCHMAR

13 Plaintiffs,

14 v.

15 CHARLES S. DEVORE and JUSTIN
 HART,

16 Defendants.
 17

Case No. SACV09-0481 JVS (RNBx)
 Hon. James V. Selna

**DEFENDANTS' REPLY IN SUPPORT
 OF MOTION FOR SUMMARY
 JUDGMENT OR, IN THE
 ALTERNATIVE, PARTIAL
 SUMMARY JUDGMENT AS TO
 EACH CAUSE OF ACTION IN
 PLAINTIFFS' FIRST AMENDED
 COMPLAINT**

18 AND RELATED COUNTERCLAIMS
 19

Date: June 1, 2010
 Time: 10:00 a.m.
 Courtroom: 10C

TABLE OF CONTENTS

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

I. INTRODUCTION.....1

II. DEFENDANTS’ VIDEOS ARE PROTECTED BY THE FAIR USE
DOCTRINE.....1

 A. Defendants’ videos are parodic and transformative, and the first
fair use factor therefore weighs in defendants’ favor.....1

 1. Plaintiffs’ efforts to undercut the factual support for Defendants’
argument is irrelevant.....1

 2. Plaintiffs’ arguments about Defendants’ intent are irrelevant
and could not be accepted at summary judgment in any event.....4

 3. Plaintiffs misunderstand how directly and in what direction
a parody must aim.....6

 B. The fourth fair use factor favors Defendants.....10

III. HENLEY IS NOT ENTITLED TO QUASI-COPYRIGHT PROTECTION
UNDER THE LANHAM ACT.....12

IV. CONCLUSION.....15

TABLE OF AUTHORITIES

Cases

Bourne Co. v. Twentieth Century Fox Film Corp.,
602 F.Supp.2d 499, 507 (S.D.N.Y. 2009) 3

Burnett v. Twentieth Century Fox Film Corp.,
491 F.Supp.2d 962, 967-969 (C.D.Cal. 2007)..... 7

Butler v. Target Corp.,
323 F.Supp.2d 1052 (C.D. Cal. 2004) 13

Cardtoons, L.C. v. Major League Baseball Players Ass'n,
95 F.3d 959, 970 (10th Cir. 1996) 14

Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.,
604 F.2d 200 (2d Cir. 1979)..... 12

Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.,
109 F.3d 1394, 1400 (9th Cir. 1997)..... 2

Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.,
924 F. Supp. 1559, 1568 (S.D. Cal. 1996)..... 7

EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopulos, Inc.,
228 F.3d 56, 64 (2d Cir. 2000)..... 13

New York Times Co. v. Sullivan,
376 U.S. 254, 271 (1964)..... 3

Oliveira v. Frito-Lay, Inc.,
251 F.3d 56 (2d Cir. 2001)..... 14

Salinger v. Colting,
641 F.Supp.2d 250, 262 (S.D.N.Y. 2009) 7

Waits v. Frito-Lay, Inc.,
978 F.2d 1093, 1106 (9th Cir. 1992) 12

1 *White v. Samsung Elecs. Am., Inc.*,
2 989 F.2d 1512 (9th Cir.1993) 14
3 *White v. Samsung Electronics America, Inc.*,
4 971 F.2d 1395 (9th Cir. 1992)..... 14
5 *Worldwide Church of God v. Philadelphia Church of God, Inc.*,
6 227 F.3d 1110, 1119-1120 (9th Cir. 2000) 10

7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

1 **I. INTRODUCTION**

2 This is Defendants’ third brief on the issues in the parties’ cross motions for
3 summary judgment. By now, many of the issues have been adequately fleshed out in other
4 papers, and it is unnecessary to address every argument in Plaintiffs’ Opposition. So
5 Defendants focus on three primary issues here. The first, and probably the most important,
6 is whether Defendants’ videos are transformative. They are, and Defendants show below
7 that all of Plaintiffs’ arguments to the contrary are lacking. Second, Defendants show that
8 the videos do not harm the value of the underlying copyrights and, therefore, do not
9 undercut the purpose of copyright law, which is to allow authors to benefit from their
10 creations in order to encourage the creation and dissemination of creative works. Plaintiffs’
11 argument, that there could be some hypothetical harm in a future, hypothetical market is
12 insufficient to avoid summary judgment. Finally, Plaintiffs are unable to identify any legal
13 authority that could support a false endorsement claim under these facts. Henley wants to
14 extend the Lanham Act to offer quasi-copyright protection so he can control even the use of
15 compositions that he does not own. The law will not permit it.

16 **II. DEFENDANTS’ VIDEOS ARE PROTECTED BY THE FAIR USE**
17 **DOCTRINE**

18 **A. Defendants’ videos are parodic and transformative, and the first fair use**
19 **factor therefore weighs in defendants’ favor**

20 The crux of this dispute is, and always has been, whether Defendants’ videos are
21 transformative works entitled to protection as fair use. The question for this Court is
22 whether a reasonable person could perceive in Defendants’ videos some commentary or
23 criticism of the original works or of Don Henley. Because a reasonable person could do so,
24 the first fair use factor weighs heavily in Defendants’ favor. Plaintiffs raise three primary
25 arguments for why the works are not parodic, but all of these arguments fail.

26 **1. Plaintiffs’ efforts to undercut the factual support for**
27 **Defendants’ argument is irrelevant**

28 Plaintiffs’ core contention is that Defendants are factually wrong: wrong about the
meaning of Plaintiffs’ original songs, and wrong about Henley’s status as a liberal icon.

1 The Boys of Summer, they say, is “a nostalgic song about a summer romance” not a
2 political or social statement. Plaintiffs’ Opposition at 3-4. And All She Wants to Do Is
3 Dance is not a critique of American policy; the argument that it is being mere “fiction” that
4 was “rejected” by Kortchmar and Henley. *Id.* Moreover, Henley is not an icon of
5 entertainment liberalism; he does not accept that he is “liberal” and he even sometimes
6 support Republican candidates for office. *See* Supplemental Declaration of Don Henley.
7 Thus, Plaintiffs say, Defendants lack factual support for their parody argument.

8 What Plaintiffs argue, then, is that Defendants must lose because their statements
9 about Don Henley and his works are not *true*. But if, as Plaintiffs allege, any factual
10 weakness in Defendants’ argument undercuts their fair use defense, then the converse must
11 also be true: if Defendants’ argument is factually accurate it is more compelling and more
12 worthy of a possible fair use defense. That is, under Plaintiffs’ logic, if Defendants rightly
13 interpreted the original works—if The Boys of Summer really were a political statement
14 and if All She Wants to Do Is Dance really were a critique of American foreign policy—
15 and if they rightly understood Don Henley as being an outspoken, liberal icon, then
16 Defendants’ arguments might have some merit. Under this approach, the fair use defense
17 rises or falls on the truth of Defendants’ message.

18 Of all the arguments Plaintiffs make in this case, this is probably the most
19 pernicious, because its adoption by this—or any other—Court would undercut a settled and
20 important understanding of the First Amendment. “Parody is regarded as a form of social
21 and literary criticism, having a socially significant value as free speech under the First
22 Amendment.” *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1400
23 (9th Cir. 1997). Plaintiffs contend, in part, that because Defendants are wrong about the
24 meaning of the original songs, Defendants’ works are not protected parodies.

25 But Plaintiffs’ argument undercuts everything we know about the First Amendment
26 and protected speech. “Authoritative interpretations of the First Amendment guarantees
27 have consistently refused to recognize an exception for any test of truth-whether
28 administered by judges, juries, or administrative officials-and especially one that puts the

1 burden of proving truth on the speaker. The constitutional protection does not turn upon
2 ‘the truth, popularity, or social utility of the ideas and beliefs which are offered.’” *New*
3 *York Times Co. v. Sullivan*, 376 U.S. 254, 271 (1964). Defendants might be wrong about
4 the meanings of the original songs. They might be wrong about Henley being an icon of
5 the liberal, entertainment elite. But Plaintiffs’ assertions that Defendants are wrong about
6 these things can never serve as the basis for concluding that Defendants’ works are not
7 entitled to First Amendment protection.

8 Indeed, the Supreme Court has made clear that courts are not tasked with
9 determining whether the parody’s criticisms have merit. In *Campbell*, the judges at various
10 levels came to differing opinions on whether 2 Live Crew’s song even contained criticism
11 of or commentary on Roy Orbison’s *Pretty Woman*, much less what the criticism was.
12 According to the district court, 2 Live Crew’s song criticized Orbison’s original as being
13 “bland and banal.” *Campbel v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 582 (1994). The
14 intermediate appellate judges were less sure. One Court of Appeal judge believed the
15 parody “ridicule[d] the white-bread original.” *Id.* The other members of the panel,
16 however, “had trouble discerning any criticism of the original in 2 Live Crew’s song.” *Id.*
17 The Supreme Court majority found that the parody’s lyrics “can be taken as a comment on
18 the naivete of the original of an earlier day....” *Id.* at 583. Thus, the various judges who
19 reviewed 2 Live Crew’s alleged parody were not unanimous in their understanding of the
20 work. But the disagreement was not problematic because 2 Live Crew was not required to
21 prove the accuracy of their commentary. They were not forced to prove that Orbison’s
22 original really was “bland,” “banal,” “naïve,” or anything else. And—most importantly—
23 Orbison could not avoid a finding of fair use simply by filing a declaration stating that 2
24 Live Crew’s interpretation of his original was mistaken or inaccurate. Orbison and 2 Live
25 Crew undoubtedly disagreed about the value of Orbison’s song, the meaning of its lyrics,
26 and the value of 2 Live Crew’s commentary. But none of that mattered. The issue was
27 simply “whether a parodic character may reasonably be perceived.” *Id.* at 582; *see also*
28 *Bourne Co. v. Twentieth Century Fox Film Corp.*, 602 F.Supp.2d 499, 507 (S.D.N.Y. 2009)

1 (The television show Family Guy included the song, “I Need a Jew,” which was allegedly a
2 parody of the song “When You Wish Upon A Star.” Defendants argued that the parody
3 was based in part on Walt Disney’s alleged anti-Semitism. Plaintiff denied that Disney was
4 anti-Semitic and denied that the public views him as such. The court found the dispute
5 irrelevant and granted summary judgment of fair use. “Defendants need to prove neither
6 that the public associates the song with Walt Disney individually or personally nor
7 ‘actually believes’ Walt Disney was an anti-Semite; Defendants need only demonstrate that
8 ‘a parodic character may be reasonably perceived.’”).

9 The Court’s logic leads to the same result in this case. Plaintiffs and Defendants
10 disagree about the proper interpretation of the original songs’ lyrics. They disagree about
11 the value of Defendants’ compositions. None of that really matters. This Court could
12 decide that the commentary in Defendants’ videos is foolish or factually insupportable. It
13 could even conclude that the commentary in Defendants’ videos would be missed or
14 misunderstood by most viewers. Yet the Court would still have to conclude that the works
15 contain parody, because the only issue is whether Defendants’ videos “may reasonably be
16 perceived” as having a parodic character. In other words, to reject Defendants’ parody
17 argument, this Court would have to conclude that *a reasonable person absolutely could not*
18 *perceive* in Defendants’ videos any commentary on the original songs. And in light of
19 Defendants’ thorough and detailed explanation in their moving papers about how the
20 parodies do comment on the originals, the record before this Court does not allow such a
21 finding.

22 **2. Plaintiffs’ arguments about Defendants’ intent are irrelevant**
23 **and could not be accepted at summary judgment in any event**

24 Plaintiffs’ second argument concerns whether Defendants’ explanation of the parodic
25 character of the videos is legitimate or, in Plaintiffs’ words, merely an effort to
26 “retrospectively ... portray their campaign ads as parodies....” Plaintiffs’ Opposition at 2.
27 Their argument, then, hinges on Defendants’ intent. It fails.

1 It is not clear why Defendants' subjective intent should matter. Imagine that a
2 songwriter subjectively intends to comment and criticize a copyrighted work directly—that
3 he has nothing but parodic intent swimming in his head the entire time he works on a
4 project—but the resulting would-be parody in no way comments on or criticizes the
5 original. In such circumstances, would a court deem the work parodic simply because,
6 while the author failed entirely to comment on or criticize the original, he really had wanted
7 to? Courts have not indicated that the law governing fair use is akin to a T-ball game,
8 where trying hard and having good intentions is what really matters.

9 Conversely, if 2 Live Crew had no intention whatsoever of commenting on Pretty
10 Woman—if their entire goal was to take Roy Orbison's tune only because it would be
11 easier than writing their own—would not the work at issue in *Campbell* still be parody? It
12 would still comment on or criticize the original work (even if purely by accident). Put
13 another way, if a work comments on or criticizes an earlier work—be it the 2 Live Crew
14 song at issue in *Campbell* or the archetypical parodies discussed in Dr. Rose's report—and
15 if the work would otherwise satisfy the legal definition of parody, how could the author's
16 subjective intent morph the clearly parodic work into something else?

17 Thus, Plaintiffs' focus on whether Defendants really tried to create a parody seems to
18 miss the point. And while the Supreme Court intentionally avoided weighing in on the
19 importance (or lack of importance) of the defendant's intent in *Campbell*, see 510 U.S. at
20 1174 n.18, there seems to be little basis in logic for finding the author's intent to be a
21 determining factor. In light of the Ninth Circuit's clear holding that whether a work
22 contains parody is a pure question of law, it is difficult to understand how a purely factual
23 inquiry over the author's subjective intent could be important in this purely legal analysis.

24 But if this Court disagrees and concludes that it is important to divine Defendants'
25 intent, the Court must assume for purposes of summary judgment that DeVore's
26 declaration is valid. That is, this Court could not reject DeVore's declaration and simply
27 declare his stated intent to be false. By demanding that this Court do so, Plaintiffs are
28

1 asking this Court to reject evidence and resolve a factual dispute in their favor, something
2 the Federal Rules of Civil Procedure do not permit.

3 Plaintiffs' basis for the request seems to be *Dr. Seuss*. They insist that this case is
4 "legally indistinguishable" from *Dr. Seuss*, and they therefore encourage the Court here to
5 find that Defendants' explanations are "pure schtick" just as the Ninth Circuit did there.
6 Plaintiffs' Opposition at 5-6. But *Dr. Seuss* was an appeal of a preliminary injunction
7 order. The court determined who was likely to prevail; it did not make a final ruling. The
8 parties had no right to a jury determination at that preliminary stage, and the Ninth Circuit
9 reviewed the district court's factual findings for clear error. *Dr. Seuss*, 109 F.3d at 1403.
10 Procedurally, this case is in a far different posture, and this Court cannot reject Defendants'
11 testimony and find a lack of parodic intent. The Court has evidence of Defendants' intent
12 from DeVore. It has no contrary evidence. Thus, if this Court believes Defendants' intent
13 is critical to the fair use analysis, it must find in DeVore's favor on that question.

14 **3. Plaintiffs misunderstand how directly and in what direction a 15 parody must aim**

16 Plaintiffs' final parody arguments concern the directness and aim of a parody. They
17 say that Defendants' videos are not parodies because they primarily target DeVore's
18 political opponents. In addition, they say that parodies must directly target the original
19 works and only the original works; even commenting on or criticizing Henley would not
20 implicate the fair use doctrine. Plaintiffs are wrong.

21 The videos can be and are parodies even though they also target Barack Obama,
22 Barbara Boxer and other Democratic politicians. Plaintiffs make much of the fact that from
23 the beginning Defendants spoke about how the videos criticize those political figures.
24 They do. But the videos can criticize those figures and still be parodies. Parody is "the use
25 of some elements of a prior author's composition to create a new one that, **at least in part**,
26 comments on that author's works." *Campbell*, 510 U.S. at 580 (emphasis added).
27 Defendants have never contended that their videos are solely parodic, and there is no
28 requirement that they be solely parodic. *See, e.g., id.* at 581 (noting that "parody often

1 shades into satire” and “a work often contains both parodic and nonparodic elements,” but
2 that a work can still be protected by fair use under the four fair use factors). As explained
3 in Defendants’ moving papers, the videos do comment at least in part on the original songs.

4 Plaintiffs also argue that any commentary on or criticism of Henley himself would
5 not justify Defendants’ use of the original works. *See* Plaintiffs’ Opposition at 7. They
6 argue that a parody can only target an author’s works, not the author or performer. *Id.*
7 Their support for that position is two district court cases from other districts, *Salinger v.*
8 *Colting*, 641 F.Supp.2d 250, 262 (S.D.N.Y. 2009) and *Dr. Seuss Enters., L.P. v. Penguin*
9 *Books USA, Inc.*, 924 F. Supp. 1559, 1568 (S.D. Cal. 1996). It is worth noting that both of
10 these cases were affirmed on appeal, but neither appellate court adopted the theory that
11 Plaintiffs espouse here. Indeed, it is not even clear that the district court in *Salinger*
12 espoused Plaintiffs’ view at all. *See Salinger*, 641 F.Supp.2d at 262 (The court seems to
13 assume that targeting Salinger would be non-parodic but the court does not say so directly
14 and offers no authority and the court proceeds to analyze whether the targeting of *Salinger*,
15 which it deems “transformative,” is sufficient to trigger a fair use defense).

16 The district court in *Dr. Seuss* undeniably did espouse Plaintiffs’ argument that
17 parody must criticize or comment on the original work, not the author. *Dr. Seuss*, 924
18 F.Supp. at 1568. But the Ninth Circuit was right not to adopt that logic on appeal. As
19 explained in a district court opinion from this district, parody is not so limited. In *Burnett*
20 *v. Twentieth Century Fox Film Corp.*, 491 F.Supp.2d 962, 967-969 (C.D.Cal. 2007), Carol
21 Burnett sued for copyright infringement after the television program Family Guy used a
22 character from the Carol Burnett show, the Charwoman, in an episode. Specifically, the
23 show’s characters explain that a porn shop is clean “because ‘Carol Burnett works part-
24 time as a janitor’” and the show makes reference “to Carol Burnett's signature ear tug.”

25 Burnett, like Plaintiffs here, argued that use of the original work is not parodic if the
26 true target is a person (there, Carol Burnett) rather than the original work. And they argued
27 that the target of the Family Guy was Carol Burnett. They supported that argument by
28 pointing out that “the Charwoman never tugged her ear in The Carol Burnett Show; rather,

1 Carol Burnett playing *herself* tugged at her ear in the closing segment of the show as a
2 salute to her grandmother. Furthermore, plaintiffs assert that the act of placing the
3 Charwoman in the role of a janitor in an erotic store is neither ‘absurd’ nor ‘transformative’
4 because ‘one could easily imagine a charwoman cleaning the floor of a porn shop.’” Thus,
5 “the crux of plaintiffs’ argument is that the target of the ‘Family Guy’s crude joke’ appears
6 to be Burnett, her family, and her wholesome image as opposed to the Charwoman.”
7 *Burnett*, 491 F.Supp.2d at 968.

8 The court found the alleged distinction irrelevant. “As defendant correctly notes, it
9 is immaterial whether the target of Family Guy’s ‘crude joke’ was Burnett, the Carol
10 Burnett Show, the Charwoman, Carol’s Theme Music or all four. The eighteen-second clip
11 ... is clearly designed to ‘imitate [] the characteristic style of an author or a work for comic
12 effort or ridicule,’ and is executed in such a manner that ‘the characteristic turns of thought
13 and phrase or class of authors are imitated in such a way as to make them appear
14 ridiculous.’” *Id.* at 968-69. Thus, even if Family Guy sought to criticize or comment on
15 Burnett rather than the original copyrighted work (the Carol Burnett Show), it still satisfied
16 the definition of parody. *See also Bourne*, 602 F.Supp.2d at 499 (finding Family Guy’s use
17 of “When You Wish Upon A Star” parodic in part because it comments on or criticizes
18 Walt Disney, even though Disney did not write, perform, or own the copyright in the song).

19 The *Burnett* court’s logic is sound. In order to comment on or criticize an entertainer
20 like Carol Burnett or Don Henley—and under the First Amendment, such commentary or
21 criticism is legitimate, protected speech—a parodist must be free to use the target’s work.
22 How do you successfully parody Don Henley without using his music?¹ It is his music that
23 makes him famous and worth parodying in the first place. (There is substantially less value
24 in parodying the political statements of persons who nobody has heard of or listens to.)

26 ¹ The *Dr. Seuss* district court’s contention that the would-be parodist or satirist “may ... freely
27 plunder the myriad familiar works already in the public domain through the expiration of
28 copyright protection” is not encouraging being that a copyright term is life of the author plus 70
years. *See Dr. Seuss*, 924 F.Supp. at 1568. A public figure like Don Henley would effectively be
free from parodic criticism until 70 years after his death.

1 Henley may refuse to pick up his socks at home, and he may even cry during sad movies.
2 But the world has no reason to know (or care) about any of this. It is his work that makes
3 him matter, and it is largely through his work that the public knows him. If a parodist may
4 not use Henley’s work in order to mock or criticize him, the parodist is denied the only
5 effective tool in his arsenal.

6 Here, Defendants do comment, at least in part, on Henley as a representative of
7 liberal, entertainment icons. It is Henley and his fellow celebrity Democrats that serve as
8 the narrators in *The Hope of November*, as is explained in Defendants’ moving papers.
9 (Note that the video also comments on *The Boys of Summer* itself, as the moving papers
10 make clear, so the video is parodic in two different ways.) Plaintiffs’ argument to the
11 contrary seems to hinge on the lack of a direct reference to Henley or a use of his picture in
12 the video. But the law does not require that a parody name its target. *See, e.g., Campbell*,
13 510 U.S. at 583 n.17 (“Parody serves its goals whether labeled parody or not, and there is
14 no obvious reason to require parody to state the obvious (or even the reasonably
15 perceived).”). Indeed, Henley himself makes clear that such a standard would be
16 nonsensical. As Henley himself concedes, “certainly some of my songs have social
17 commentary in them, which I think is my right as a citizen and an artist, but I don’t try to
18 beat people over the head, you know. I don’t name names in my songs.” Second
19 Supplemental Declaration of Christopher Arledge, Exh. 1 at 24:1-5. For example, Henley
20 has described “On the Border,” one of his Eagles works, as “a thinly, perhaps I should say
21 thickly disguised political piece about Nixon and all the trouble he was in.” *Id.* at 28:17 to
22 29:6. Yet the song nowhere mentions Richard Nixon. *Id.* at 26:2-9. Henley believes it is a
23 mark of “good songwriting” to be more subtle about his social commentary. *Id.* at 34:7-15.

24 Henley’s testimony, the testimony of one of America’s great songwriters, shows the
25 flaw in Plaintiffs’ argument. A writer can comment on a person without naming him or
26 her, and there is no reason why a parodist must identify by name the targets of his parody.
27 If commentary or criticism can reasonably be perceived without identifying a target by
28 name, there is no reason in law or logic that the definition of parody would not be satisfied.

1 **B. The fourth fair use factor favors Defendants**

2 Plaintiffs question the factual support for Defendants’ argument under the fourth fair
3 use factor. They say “Defendants’ primary argument that their uses are not harmful is
4 based on the (unfounded) opinion of DeVore that Defendants’ uses could not possibly harm
5 the market for Plaintiffs’ original recordings.” Opposition at 16. Plaintiffs are wrong.
6 Defendants relied primarily on *Plaintiffs’* concessions that they have no basis to conclude
7 the videos impacted the value of the original songs, on *Plaintiffs’* concessions that the
8 videos are “amateurish” and that they do not believe anybody would find them to be
9 legitimate substitutes for the original songs, and on *Plaintiffs’* concessions that there is no
10 market for licensing the songs because they do not allow one to exist. *See* Defendants’
11 Memorandum at 13-14. Defendants’ evidentiary showing is compelling, and in light of the
12 inherent difficulty of proving a negative, it would be unreasonable to expect anything more.

13 Ultimately, the issue is simple. There is no evidence (and no reason to believe) that
14 the videos harm sales of the original songs. Any potential harm would have to be found in
15 the market for licensing. But there are two problems with Plaintiffs’ licensing-harm
16 argument. First, Plaintiffs have chosen not to permit any licensing opportunities. To be
17 clear, Defendants do not believe, and are not asking this Court to believe, that the original
18 songs would have no value in the marketplace if Plaintiffs chose to license them. But
19 Plaintiffs have not chosen to license them; thus, there is no market to harm. Plaintiffs argue
20 that this fact does not mean that the Court must find in Defendants’ favor on this fourth
21 factor. But it is an important consideration and certainly a reason why this Court should
22 pause before finding that the fourth factor weighs in *Plaintiffs’* favor.

23 Plaintiffs rely on *Worldwide Church of God v. Philadelphia Church of God, Inc.*,
24 227 F.3d 1110, 1119-1120 (9th Cir. 2000) to prove their argument under this fourth factor.
25 The case actually helps Defendants. There, the defendant argued that the fourth factor
26 weighed in its favor because the plaintiff had not exploited the copyrighted work for 10
27 years. The court declined to adopt that reasoning, finding that a plaintiff retains some
28 interest in a work because he might change his mind, and noting that the plaintiff had

1 intended to revise the work and publish a new version in the future. Thus, the plaintiff in
2 *Worldwide Church* had a much stronger argument than Plaintiffs here; unlike Plaintiffs
3 here, the plaintiff in that case intended to enter the market. Plaintiffs here made clear in
4 deposition that they have no desire to license their songs commercially. But—critically—
5 the court in *Worldwide Church* still did not find that the fourth fair use factor therefore
6 favored the plaintiff. Instead, the court treated the fourth fair use factor as neutral.

7 Second, Plaintiffs focus on an alleged harm that copyright law does not take into
8 account. Plaintiffs’ expert argues that the videos harm the value of the songs and Henley’s
9 persona by politicizing them and thus “alienating fans.” Plaintiffs’ Opposition at 16. But
10 that expert opinion assumes much for which there is no foundation: namely, that Henley is
11 not already politicized (it’s hard to make that argument about a “well-known” Democrat
12 who admittedly puts social commentary in his songs, and the expert gives no support for
13 his position), and that the public will believe Henley has an association with the videos
14 (something he has tried unsuccessfully to support in this case as part of its Lanham Act
15 claim). Most importantly, the harm that Plaintiffs describe is not cognizable under the
16 Copyright Act. Copyright law is concerned only with a particular type of harm. 2 Live
17 Crew’s vulgar parody of *Pretty Woman* may have harmed the value of Orbison’s original
18 song, either because it highlighted the “naivety” of the original or because the association
19 with 2 Live Crew’s vulgar lyrics and themes simply turned off potential customers. But the
20 Court in *Campbell* held that the lower courts erred if they took such concerns into account.
21 *Campbell*, 510 U.S. at 592. Copyright law is only concerned with whether the second work
22 *usurps* demand for the original. *Id.* A parody can permissibly ruin all demand for the
23 original work as long as it does not usurp the value of the original work. *See also Bourne*,
24 602 F.Supp.2d at 510 (finding that the plaintiff relied on a “misconception of the fourth
25 factor analysis” in arguing that the original song would be harmed because the defendants’
26 use “would be highly offensive to a significant number of people” thus “harming the
27 original song by association.”). Plaintiff’s expert’s speculation that the videos could
28 politicize the songs or Henley’s persona is, therefore, irrelevant.

1 **III. HENLEY IS NOT ENTITLED TO QUASI-COPYRIGHT PROTECTION**
2 **UNDER THE LANHAM ACT**

3 Henley wants this Court to give him control over the use of copyrighted materials
4 under the Lanham Act rather than the Copyright Act. Courts have been careful not to allow
5 such a result, for the reasons discussed at length in Defendants’ other briefs. Thus, the
6 Ninth Circuit requires a plaintiff in a false endorsement claim, like Henley, to show that the
7 defendant misappropriated one of the plaintiff’s distinctive attributes. Henley, who cannot
8 make such a showing, continues to insist that his false endorsement claim does not require
9 proof that Defendants used a distinctive characteristic or attribute of his, despite the Ninth
10 Circuit’s clear and voluminous statements to the contrary. Thus, Henley’s argument would
11 permit Henley to have protection of particular copyrighted works even if he does not own
12 the copyrights (he doesn’t as to one of the songs here) and even if a user does not reference
13 Henley or use any of Henley’s identifiable characteristics. No court has done what Henley
14 asks this Court to do. This Court should decline the invitation to be the first.

15 Henley points to three cases as authority for his position. All are distinguishable. The
16 first, *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir.
17 1979), is facially inapplicable. The issue there was whether the plaintiff had a protectable
18 mark in the Dallas Cowboys Cheerleading uniform. The court concluded that plaintiff did
19 have a viable trademark in the uniform. Not surprisingly, in the process of reaching that
20 conclusion, the court said absolutely nothing about whether a celebrity can have a viable
21 “mark” for purposes of a false endorsement claim absent evidence that defendant
22 misappropriated a distinctive attribute. It certainly did not undercut a later Ninth Circuit
23 case holding that in a false endorsement claim the “mark” at issue is a distinctive attribute
24 of the celebrity plaintiff. *See Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1106 (9th Cir. 1992)
25 (“[C]ourts have recognized false endorsement claims brought by plaintiffs, including
26 celebrities, **for the unauthorized imitation of their distinctive attributes, where those**
27 **attributes amount to an unregistered commercial “trademark.”**) (emphasis added).

1 The second case, *Butler v. Target Corp.*, 323 F.Supp.2d 1052 (C.D. Cal. 2004), also
2 does not support Henley. Two things about *Butler* are important. First, the plaintiffs in
3 *Butler* probably had a stronger claim for false endorsement than Henley does because the
4 defendant actually used their voices—which are undoubtedly distinctive attributes of
5 theirs—in the advertisements. “Plaintiffs’ voices are prominent and recognizable in the
6 Recording and in television broadcasting of commercials for Target Stores which featured
7 the Recording as the soundtrack.” *Id.* at 1054. Even so, it appears that the plaintiffs rested
8 their Lanham Act claim on a different theory entirely.

9 That theory, and this is the second point to be made about *Butler*, was different than
10 Henley’s. The plaintiffs in *Butler* argued that the title and key lyrics of their song were
11 valid trademarks and were being infringed. They relied on *EMI Catalogue P’ship v. Hill,*
12 *Holliday, Connors, Cosmopulos, Inc.*, 228 F.3d 56, 64 (2d Cir. 2000). *See Butler*, 323
13 F.Supp.2d at 1059. But Henley does not argue that he has a trademark in the title or lyrics
14 of the songs; Henley’s case assumes that the mark is his persona. *Butler* is inapposite.

15 But the *EMI* case that the *Butler* court relied on does expose the flaws in Henley’s
16 argument. Note that *EMI* was not a claim by a celebrity for an alleged false endorsement.
17 Nor was there any dispute as to whether the plaintiff had a valid trademark. In *EMI*, the
18 “defendants conceded that *EMI* had a right protectable under § 43(a) in the title to the song
19 and that the title had acquired secondary meaning among consumers.” *Id.* at 61. But the
20 scope of the mark was disputed, and the Second Circuit was careful to limit its scope: “*EMI*
21 has no rights to the music as a trademark.” *Id.* at 62. The court offered a detailed
22 explanation for why *EMI* could not have a trademark in the sound recording or composition
23 itself, essentially because “[t]he creation and expression of an original work is protected by
24 copyright law, and once an original work has been produced trademark law is not the
25 proper means of protecting the rights in this originality.” This explanation highlights the
26 error in Henley’s assertion that the Lanham Act allows him to preclude others from using
27 the musical compositions in this case. The remedy for use of a copyrighted composition
28 lies in copyright, not trademark.

1 Plaintiffs' final case, *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th
2 Cir. 1992), is no more useful to Henley than the others. There, the defendant's commercial
3 advertisement featured a robot with a blond wig, long gown, and large jewelry that turned
4 letters on a game show that looked like the Wheel of Fortune set. The court concluded that
5 "[v]iewed separately, the individual aspects of the advertisement ... say little. Viewed
6 together, they leave little doubt about the celebrity the ad is meant to depict." *Id.* at 1399.
7 Thus, the court concluded that the defendant's use of multiple characteristics associated
8 with Vanna White resulted in the misappropriation of Vanna White's identity. *Id.*

9 The *White* opinion has its critics. It drew vehement dissents from Judges Alarcon,
10 *id.* at 1402, and Kozinski, *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (9th Cir.1993)
11 (denial of rehearing en banc) (Kozinski, J., dissenting), and the Sixth Circuit expressly
12 rejected it. *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959,
13 970 (10th Cir. 1996) ("We disagree with the result in that case for reasons discussed in the
14 two dissents that it engendered."). Thus, there is reason to believe that *White* was pushing
15 the boundaries of false endorsement to the breaking point. Yet Vanna White's argument
16 was still far superior to Henley's. In *White* the defendant used characteristics of Vanna
17 White to depict a robot Vanna White. And while none of the characteristics, in isolation,
18 were distinctive, they were in combination. Henley has no such argument. Defendants
19 here have not used any characteristics of Henley. They have simply used copyrighted
20 music. It is up to copyright law alone to determine whether that use was permissible.

21 Finally, Henley's effort to distinguish *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56 (2d
22 Cir. 2001), merits brief attention. He argues, "[u]nlike Gilberto, Henley is *not* claiming a
23 trademark in an otherwise licensed use of his *own* performance, but rather, that two songs
24 widely associated with him were used in unauthorized, simulated performances to falsely
25 suggest an association between Henley and Defendants' videos." Plaintiffs' Opposition at
26 22. He is right; in Gilberto, the defendant used the plaintiff's voice and here the
27 Defendants did not use Henley's voice (or any other aspect of Henley's persona). The
28 mystery is why Henley believes this distinction *helps* him. By Henley's logic, Gilberto's

1 case is worse than his because the defendant actually used a distinguishing characteristic of
2 hers; so would the relative merits of her case have dropped further if the defendant had
3 used her picture also? Henley offers no authority to support this novel legal theory that a
4 false endorsement claim is *improved* by the defendant's failure to use a distinguishing
5 characteristic of the plaintiff; he may be waiting some time before such a case comes along.

6 **IV. CONCLUSION**

7 Defendants' videos transformed the original songs into something new and imputed
8 into them a new meaning. They did so without harming the value of the underlying songs.
9 And they did so to broadcast pure political speech in the middle of a Senate campaign. If
10 any case merits a fair use finding, this one does.

11 Lacking a viable claim under the Copyright Act, Henley looks to the Lanham Act.
12 His argument is novel and unsupported. It flies in the face of all the legal precedent and
13 common sense. Henley has no right to control copyrighted musical compositions through
14 trademark law.

15 Defendants are entitled to summary judgment on all claims.

16 Dated: May 17, 2010

ONE LLP

17
18
19 By: /s/ Christopher W. Arledge
20 Christopher W. Arledge
21 Attorneys for Defendants, Charles S. Devore and
22 Justin Hart
23
24
25
26
27
28