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13 **UNITED STATES DISTRICT COURT**
 14 **CENTRAL DISTRICT OF CALIFORNIA**
 15

16 DON HENLEY, MIKE CAMPBELL
 and DANNY KORTCHMAR,

Case No. SACV09-0481 JVS (RNBx)

17
 18 Plaintiffs,

**PLAINTIFFS' REPLY
 MEMORANDUM OF POINTS AND
 AUTHORITIES IN SUPPORT OF
 PARTIAL SUMMARY JUDGMENT**

19 v.

20 CHARLES S. DEVORE and
 21 JUSTIN HART,

Date: June 1, 2010
 Time: 10:00 A.M.
 Ctrm: Hon. James V. Selna

22 Defendants.
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INTRODUCTION

This is not a case about politics, as much as Defendants would have this Court believe otherwise. Plaintiffs do not dispute that Defendants are entitled to express their political views in any lawful manner that they choose. Rather, this is a case about the rights of creators, under the law, to preserve the integrity and value of the intellectual property they conceive. Defendants have appropriated Plaintiffs' copyrighted songs in a manner that finds no possible justification in the law. Plaintiffs urge this Court to protect their valuable works – and livelihoods – against such flagrant takings.¹

I. DEFENDANTS CANNOT PREVAIL ON THEIR FAIR USE DEFENSE

Fair use is an affirmative defense, so Defendants bear the burden of presenting evidence to establish the validity of their claim. *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994). Defendants have failed to do so.

A. The First Fair Use Factor Overwhelmingly Favors Plaintiffs

In Plaintiffs' opening brief and opposition to Defendants' cross-motion for summary judgment ("Pls. Op."), Plaintiffs have demonstrated that Defendants' Hope and Tax Videos neither comment on, nor criticize, Plaintiffs' works, as required under *Campbell*. Plaintiffs have further shown why Defendants' copying cannot be considered "transformative" under the law. And Plaintiffs have established that Defendants' assertions that they intended to comment on Plaintiffs' works, or Plaintiffs, are demonstrably false, lack evidentiary support, or both.

Contrary to Defendants' hollow claim that Plaintiffs have "nothing admissible," Plaintiffs have put forth abundant evidence to show that Defendants' fair use claim is unfounded. This includes, *inter alia*, the videos themselves, as compared to Plaintiffs' original songs; Defendants' own characterizations of the videos; the report of Dr. Mark

¹As the parties' motions for summary judgment essentially mirror one another, Plaintiffs respectfully request that this Court consider the totality of arguments and evidence presented by Plaintiffs in support of Plaintiffs' motion and in response to Defendants' cross-motion in ruling on each motion. Plaintiffs note that Defendants have made a similar request. (*See* Defendants' opposition brief ("Defs. Op.") at 1.)

1 Rose, Plaintiffs’ literary expert; and the report of Dr. Lawrence Ferrara, Plaintiffs’
2 musicologist. (See Defs. Op. at 7.) Against this substantial record, Defendants must
3 come forward with genuine evidence, not conclusory or specious testimony, to defeat
4 summary judgment. *Nelson v. Pima Cmty. Coll.*, 83 F.3d 1075, 1081-82 (9th Cir. 1996).
5 But self-serving statements and flawed arguments are all Defendants have to offer.

6 **1. Defendants Were Not Targeting Plaintiffs or Their Works**

7 Defendant complain that Plaintiffs “spill much ink” on the fact that Defendants
8 invented their parody excuse. (Defs. Op. at 1.) It is clear from the record, however, and
9 significant, that Defendants’ intent was not to parody Plaintiffs, but to promote DeVore.
10 Defendants’ opposition itself is telling: “If the parodies generated attention, more people
11 would come to know and understand *DeVore’s political positions.*” (Defs. Op. at 2
12 (emphasis added).) Defendants had their own agenda – it was not to spread insight into
13 Plaintiffs’ works.

14 Defendants’ suggestion that in using the word “parody” DeVore’s intent was to
15 target Plaintiffs’ songs or Plaintiffs – rather than something else – is belied by the series
16 of admissions set forth in Plaintiffs’ opposition, which unequivocally demonstrate that
17 Defendants’ videos were aimed at Obama and Boxer, not Plaintiffs or their songs. (See
18 Pls. Op. at 2-3.) Notably, in the only document cited by Defendants to defend their
19 position, DeVore refers to his lyrics as “*Obama parody lyrics set to Don Henley’s ‘Boys*
20 *of Summer.*” Defendants cannot cite an example more helpful to their cause because
21 there is none. (See Defs. Op. at 2; see also Ch. Decl., Ex. 22 (emphasis added).) In sum,
22 Defendants’ multiple admissions that their lyrics and videos were aimed at Obama and
23 Boxer, rather than Plaintiffs’ songs, weigh significantly against a finding of fair use. See
24 *Salinger v. Colting*, No. 09-2878, 2010 U.S. App. LEXIS 8956, at *39-40 (2d Cir. Apr.
25 30, 2010) (defendants unlikely to prevail on fair use defense where their claim of critical
26 purpose is contradicted by earlier statements); *Dr. Seuss Enters., L.P. v. Penguin Books*
27 *USA, Inc.*, 109 F.3d 1394, 1403 (9th Cir. 1997) (rejecting defendants’ *post hoc* claim of
28 parody as “‘completely unconvincing’”) (quoting district court).

1 **2. First Amendment Interests Are Encompassed By the Fair Use Doctrine**

2 Citing no legal authority, Defendants next suggest that their videos are entitled to
3 some vague, additional “special protection” under the First Amendment. (Def’s. Op. at
4 3.) As explained by Plaintiffs earlier, the protection of Defendants’ First Amendment
5 interests within the context of copyright law is not separate from the fair use doctrine – it
6 is the fair use doctrine. In *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471
7 U.S. 539 (1985), in which a publisher challenged the unauthorized publication of
8 excerpts of President Gerald Ford’s memoirs by the *Nation* magazine, the Supreme Court
9 considered – and rejected – the argument that the First Amendment interest in reporting
10 information of “substantial public import” should override the fair use analysis of
11 copyright law. *Id.* at 556. The Court explained that “copyright’s idea/expression
12 dichotomy ‘[strikes] a definitional balance between the *First Amendment* and the
13 Copyright Act by permitting free communication of facts while still protecting an
14 author’s expression.’” *Id.* (quoting opinion below). The Court declined to sanction
15 “what amounts to a public figure exception to copyright”; a speaker may borrow ideas
16 freely, but the use of protected expression is subject to the balancing test of fair use. *Id.*
17 at 560.

18 Other courts, including the Ninth Circuit, are in complete agreement that First
19 Amendment concerns in copyright cases “are subsumed within the fair use inquiry.”
20 *Elvis Presley Enters. v. Passport Video*, 349 F.3d 622, 626 (9th Cir. 2003); *A&M*
21 *Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1028 (9th Cir. 2001) (“First Amendment
22 concerns in copyright are allayed by the presence of the fair use doctrine.”); *Nihon*
23 *Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65, 74 (2d Cir. 1999) (“We
24 have repeatedly rejected First Amendment challenges to injunctions from copyright
25 infringement on the ground that First Amendment concerns are protected by and
26 coextensive with the fair use doctrine.”) (citing *New Era Publ’ns. Int’l v. Henry Holt &*
27 *Co.*, 873 F.2d 576, 584 (2d Cir. 1989) (“[T]he fair use doctrine encompasses all claims of
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1 *first amendment* in the copyright field.”)). Defendants’ use of Plaintiffs’ songs in
2 campaign ads is therefore appropriately analyzed under the factors of Section 107.

3 **3. Dr. Rose’s Expert Testimony Is Wholly Appropriate and Admissible**

4 Defendants devote several pages of their opposition to Dr. Mark Rose, a professor
5 of English who has testified many times as an expert on literary issues arising in
6 copyright cases. (Declaration of Mark Rose (“Rose Decl.”) ¶ 2, Ex. 1 at 26-38.)

7 Defendants’ chief complaint with Rose is that he invoked the Supreme Court’s definition
8 of parody in *Campbell* in conducting his literary analysis of Plaintiffs’ and Defendants’
9 works. That is, Rose considered, from a literary perspective, whether Defendants’ works
10 commented on the style or substance of Plaintiffs’ works. (*Id.* Decl. ¶¶ 4-7, Ex. 1 at 9-
11 24.) He concluded they did not. (*Id.* ¶¶ 6-7, Ex. 1 at 25.)

12 Defendants’ argument is nonsensical. First, Rose’s report would be of little value
13 if he had failed to perform his literary analysis with reference to the core concerns of
14 *Campbell*, and had instead adopted an inconsistent or irrelevant approach to the question
15 of parody – a central flaw of the report submitted by Defendants’ literary expert, as
16 discussed in more detail below.

17 Second, courts routinely accept testimony from literary and artistic experts on
18 whether the use of an earlier work is parodic. Federal Rule of Evidence 702 permits
19 expert testimony based on “specialized knowledge” if it will “assist the trier of fact to
20 understand the evidence or to determine a fact in issue,” and a court has ““broad
21 latitude”” to admit expert testimony when it is reliable and relevant. Fed. R. Evid. 702;
22 *Rivera v. Bio Engineered Supplements & Nutrition, Inc.*, No. SACV07-1306, 2008 U.S.
23 Dist. LEXIS 95083, at *41 (C.D. Cal. Nov. 13, 2008) (quoting *Elsayed Mukhtar v. Cal.*
24 *State Univ., Hayward*, 299 F.3d 1053, 1064 (9th Cir. 2002)). The *Campbell* record itself
25 includes expert testimony on the question of parody, and many other courts have
26 considered the opinions of experts on this issue. *See, e.g., Campbell*, 510 U.S. at 589
27 n.19 (referencing expert affidavit); *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429,
28 1433, 1442, 1445 (6th Cir. 1992) (reviewing expert testimony); *Mattel Inc. v. Walking*

1 *Mountain Prods.*, 353 F.3d 792, 797-98 (9th Cir. 2003) (noting several expert reports
2 admitted by district court); *Salinger v. Colting*, 2010 U.S. App. LEXIS 8956, at *9
3 (describing testimony of “two literary experts” in support of fair use parody defense).²

4 Third, nowhere in his report does Rose purport to be opining on the ultimate *legal*
5 question of parody or fair use. Indeed, as Defendants aptly observe, Rose expressly
6 *declined* to testify on questions of law during in his deposition. (*See* Defs. Op. at 4
7 (quoting Rose’s testimony that he is “‘not a lawyer and . . . not qualified to provide you a
8 fair use analysis’” and “‘can’t testify to that [what the Supreme Court meant in footnote
9 14 of its *Campbell* opinion . . .], I’m not a lawyer.’”).) Nor does Rose opine on the
10 question of parody from a musicological perspective, which is also outside his area of
11 expertise. Rather, his report focuses on the literary aspects of Plaintiffs’ and Defendants’
12 songs – their respective structures, stylistic devices and literary interpretations – to reach
13 the conclusion that Defendants’ works do not mock or comment on Plaintiffs’. He also
14 compares Defendants’ lyrics to a widely recognized, classic parody, “Father William,”
15 further to illustrate, from a literary perspective, why Defendants’ works lack parodic
16 qualities. The type of analysis performed by Rose is clearly a product of “specialized
17 knowledge” and a wholly appropriate subject of expert testimony. Fed. R. Evid. 702.

18 In this regard, Defendants simply misread *Mattel, Inc.*, 353 F.3d 792. *Mattel*
19 considered an artist’s photographs of Barbie, which depicted the doll in the midst of
20 threatening home appliances and in sexually suggestive poses. *Id.* at 802. The court
21 concluded that the photographs commented on Barbie in a parodic manner. *Id.* In
22 reaching this conclusion, the court rejected survey evidence submitted by the plaintiff to
23 show that not everyone perceived the parody. *Id.* at 801. The court explained that the
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25 ² Notably, Defendants do not challenge Rose’s qualifications to perform such a literary
26 analysis, for they are unassailable. (*See* Rose Decl. ¶ 2, Ex. 1 at 26-38; Defs. Op. at 5
27 (“Dr. Rose is, by all accounts, a gifted academic and a very bright man.”).)
28

1 issue of parody was not one of “majority opinion,” but rather an issue of law to be
2 decided by the court. *Id.*

3 Despite Defendants’ suggestion, the *Mattel* court did not hold that literary or other
4 expert testimony is inappropriate in parody cases. To the contrary, several expert reports
5 were admitted by the district court in the *Mattel* case, including a report offered by an art
6 expert in support of the defendant’s parody claim. *Id.* at 797-98. The Ninth Circuit did
7 not reject this evidence or in any way suggest it had been improperly considered by the
8 court below. *See id.* at 797-98, 801. The statement in *Mattel* cited by Defendants that
9 there is “no case law in support of [the] contention that the parodic nature of a
10 defendant’s work should be assessed using surveys and opinion testimony” thus clearly
11 refers to the *lay* opinion testimony elicited through the plaintiff’s survey – not the expert
12 testimony on which the court below relied.

13 Further, while the *Mattel* court indicated that one must consider the “social
14 context” (as well as the specific artistic context) of the defendant’s parody, it did not
15 suggest that any particular context or point of view should reign. Rather, the court
16 employed a basic, cultural understanding of Barbie in interpreting defendant’s
17 photographs. *See id.* at 802 (recognizing Barbie as symbol of American girlhood
18 associated with “beauty, wealth, and glamour”). This is exactly what Rose did here,
19 considering Defendant’s works not in a social vacuum, as Defendants suggest, but with
20 an obvious understanding of American culture and appreciation of the social significance
21 of figures such as President Obama, Barbara Boxer, Nancy Pelosi, Al Gore and Scrooge
22 McDuck – not to mention the 2008 presidential election, Wall Street, global warming,
23 Wayfarer sunglasses, “Deadhead” stickers and Cadillacs. (*See generally* Rose Decl., Ex.
24 1 at 12-24.) Far from ignoring “social context,” as Defendants assert, Rose expressly
25 relied upon it in presenting his literary analysis of the works at issue. (*See* Second
26 Supplemental Declaration of Jacqueline Charlesworth (“Ch. 2d Supp. Decl.”), Ex. C at
27 26-27 (Deposition of Mark Rose at 125:14-126:9) (“[S]ince I am a part of American
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1 culture, there are many things about this song that are simply obvious to me as a part of
2 American culture”.)

3 Finally, Defendants complain that Rose “cannot tell us how Chuck DeVore’s
4 intended audience—or anybody else—would have understood the works.” (Defs. Op. at
5 6.) Of course, the same can be said of Defendants. Moreover, Defendants’ “audience”
6 was not limited to DeVore supporters; the videos were available to Internet users around
7 the world. (Plaintiffs’ Statement of Uncontroverted Facts and Conclusions of Law
8 (“St.”) ¶¶ 79, 131.) Regardless, the *Mattel* court did not limit its analysis to Barbie
9 critics or patrons of contemporary photography. *Mattel* nowhere suggests that a court
10 should consider the views of only a limited audience or an “intended audience” – even if
11 it were possible to do so – in evaluating the question of parody.

12 **4. Dr. Zeilinger’s Opinion Is Unreliable and Should Not Be Credited**

13 As part of their effort to jettison Rose, Defendants indicate a willingness to
14 sacrifice their own literary expert, Dr. Martin Zeilinger. Defendants declare Zeilinger’s
15 report inadmissible and, though they submit it to the Court, decline otherwise to cite it in
16 their brief. (*See* Defs. Op. at 6 n.1.) Defendants’ concession is hardly surprising, for the
17 unreliability of Zeilinger’s report is evident from the face of the report itself, and further
18 underscored by Zeilinger’s deposition testimony.

19 Zeilinger is a recent Ph.D. from the University of Toronto who has never
20 previously been qualified as an expert witness. (Declaration of Martin Zeilinger
21 (“Zeilinger Decl.”), Ex. A at App. 1; Ch. 2d Supp. Decl., Ex. D at 33 (Deposition of
22 Martin Zeilinger (“Zeilinger Dep.”) at 15:17-25).) During his deposition, it became
23 apparent that Zeilinger is a proponent of “appropriation art” – or, the use of “already-
24 existing source material and transferring this material into new work.” (Ch. 2d Supp.
25 Decl., Ex. D at 40-43 (Zeilinger Dep. at 74:9-77:2).) Consistent with this mission,
26 Zeilinger believes that fair use principles (or “fair dealing,” its Canadian counterpart)
27 should be expanded to permit freer use of copyrighted material. (*Id.*, Ex. D at 34-39, 44
28 (Zeilinger Dep. at 23:3-28:19, 83:3-21).)

1 Unlike Rose, Zeilinger applies no fixed definition of parody in his report, let alone
2 the definition espoused by the Supreme Court, which he does not even cite. (*See*
3 *generally* Zeilinger Decl., Ex. A; *see also* Ch. 2d Supp. Decl., Ex. D at 45-48 (Zeilinger
4 Dep. at 102:22-105:21) (Zeilinger “can’t seem to find” *Campbell*’s definition of parody
5 in his report.)) Instead, he relies upon multiple, open-ended characterizations of parody
6 drawn from a variety of sources. According to Zeilinger, a meaningful standard for
7 parody is not even possible, for “parody has an overall destabilizing quality that makes it
8 notoriously hard to pin down in any narrow and universalizing definitions.” (Zeilinger
9 Decl., Ex. A at 8.) Thus, Zeilinger variously describes parody as ““any cultural practice
10 which provides a relatively polemical allusive imitation of another cultural production or
11 practice””; ““a mode, or . . . a range in the spectrum of possible intertextual relations””;
12 and as something that “instrumentalizes the works on which it draws for its own
13 purposes . . . reworks the originals . . . and create[s] new meanings that arise out of the
14 synthesis between the resulting text and the original.” (*See id.*, Ex. A at 11-15.)

15 To summarize Zeilinger’s view, any new text that “instrumentalizes” or “reworks”
16 another qualifies as parody because the meaning of the old text is imported into the new
17 – regardless of whether the new text comments on the old. (*See* Ch. 2d Supp. Decl., Ex.
18 D at 49-51 (Zeilinger Dep. at 136:5-138:21) (“What I mean by that is that the meanings
19 of the original works are carried on in the reworking. They are implied in the
20 reworking.”).) Under this expansive definition, Zeilinger was comfortable opining that
21 Defendants’ works were parodies simply because *they appropriated Plaintiffs’ songs*.
22 (Zeilinger Decl., Ex. A at 37 (“[P]arody must be understood not simply as a process in
23 which the parodist mocks the author . . . , but rather as a process in which the parodist
24 emulates an authorial voice through a variety of techniques, including citation, imitation
25 and allusion – something that Mr. DeVore’s songs clearly do”)).) Of course, when
26 one text copies another largely verbatim – as Defendants’ do here – it is hardly
27 remarkable that meaning from the original text is “carried on” in the new. The law does
28 not call this parody, however. It calls it infringement.

1 **5. Defendants Profited From Their Use of Plaintiffs’ Songs**

2 Defendants continue to urge that their videos should be considered noncommercial
3 for purposes of fair use, even though their use of Plaintiffs’ works was, by Defendants’
4 own admission, a substitute for paid political advertising. (Defs. Op. at 9-10; *see also* St.
5 ¶ 37.) Evidently, they still fail to grasp the governing principle of *Harper & Row*, that
6 the commercial/nonprofit distinction of Section 107 does not turn simply on monetary
7 gain or how the copying is labeled. Rather, the analysis also considers whether a
8 defendant benefited from the exploitation in nonmonetary ways – including, as here, by
9 attracting recognition, supporters and donations. *See Harper & Row*, 471 U.S. at 562
10 (crux of the profit/non-profit distinction is “whether the user stands to profit from
11 exploitation of the copyrighted material without paying the customary price”);
12 *Weissmann v. Freeman*, 868 F.2d 1313, 1324 (2d Cir. 1989) (inquiry is not “dollar
13 dominated”); *Worldwide Church of God v. Philadelphia Church of God, Inc.*, 227 F.3d
14 1110, 1117 (9th Cir. 2000) (monetary gain not the sole criterion). As demonstrated in
15 Plaintiffs’ earlier briefs, news reporting, academic use and religious activities – all of
16 which claim entitlement under the First Amendment – are found to constitute for-profit
17 uses where, as here, the user stands to profit. *See, e.g., Harper & Row*, 471 U.S. at 562;
18 *Worldwide Church*, 227 F.3d at 1115-16. Defendants’ continued reliance on
19 *MasterCard Int’l Inc. v. Nader 2000 Primary Comm., Inc.*, No. 00 Civ. 6068, 2004 U.S.
20 Dist. LEXIS 3644 (S.D.N.Y. Mar. 8, 2004) and *Keep Thomson Governor Comm. v.*
21 *Citizens for Gallen Comm.*, 457 F. Supp. 957 (D.N.H. 1978), is misplaced, for these
22 cases do not follow *Harper & Row*. The third case cited by Defendants, *Florida Bar v.*
23 *Went For It, Inc.*, 515 U.S. 618 (1995), concerns attorney advertising, not copyright, and
24 is simply beside the point.

25 **6. Defendants’ Attempt to Rely on an Unauthenticated Music Video Not**
26 **in Evidence Is Improper and Should Be Ignored**

27 Although not referenced in their brief itself, Defendants, in an eleventh-hour ploy,
28 invite the Court to consider an additional, unauthenticated music video not in evidence.

1 In a supplemental declaration, Defendants’ counsel, Christopher Arledge, provides an
2 Internet link to what he represents as “Henley’s music video for ‘All She Wants to Do Is
3 Dance,’” and – acting as his own fact and expert witness – proceeds to offer a
4 “reasonable interpretation” of that video. (Supplemental Declaration of Christopher W.
5 Arledge (“Arledge Supp. Decl.”) ¶ 3.) Arledge opines that the “allegedly unknown
6 location” in the video is “actually a location in Latin America,” and that “the uniforms
7 worn by soldiers in the video are consistent with the uniforms used by the Nicaraguan
8 Contras.” (*Id.*) Thus, concludes Arledge, the video is “a criticism of American foreign
9 policy and the apathy of the American people to that policy.” (*Id.*)

10 Despite Plaintiffs’ requests for “[a]ll documents . . . upon which [Defendants]
11 intend to rely to support the affirmative defenses” and “[a]ll documents concerning the
12 allegations . . . that ‘[Plaintiffs’ claims] are barred by the doctrine of copyright fair use,’”
13 the video referenced by Arledge was never identified or produced by Defendants during
14 discovery, or authenticated by anyone. (Ch. 2d Supp. Decl., Ex. F at 64-65 (request nos.
15 43, 51).) Although Arledge calls it “Henley’s video,” he provides no basis for the
16 assumption that Henley was responsible for the conception or production of the video,
17 rather than, say, the record label that released it. Plaintiffs had no opportunity to review
18 the video with DeVore, Hart (or Arledge) during discovery. Plaintiffs would have been
19 interested to know, for example, why DeVore (and Arledge) believe that the brown
20 uniforms depicted in the video “are consistent” with Nicaraguan Contra uniforms, when
21 Plaintiffs’ cursory research suggests that Nicaraguan Contras wore green camouflage.

22 As demonstrated in Plaintiffs’ concurrently filed objections, Defendants’ latest
23 tactic is outside the bounds of proper litigation for several reasons.³ But even if the
24 video, and Defendants’ unfounded assertions about it, were admissible, it gets them
25 nowhere. Kortchmar, the author of Dance – speaking, unlike Defendants, from personal

26 ³ Plaintiffs reserve their rights concerning Arledge’s apparent desire to act as a witness in
27 this case.
28

1 knowledge – has explained that he did not write the song as a comment on Central
2 America, or as a criticism of the United States. (Kortchmar Decl. ¶ 7; Ch. 2d Supp.
3 Decl., Ex. B at 12-14, 19-20 (Kortchmar Dep. at 57:9-19, 71:16-72:20, 140:14-141:5).)
4 But even more to the point, Defendants’ Tax Video is addressed to Barbara Boxer’s
5 taxation policies. It does not speak to Latin America, Nicaraguan Contras or U.S.
6 foreign policy. It does not reference, let alone spoof, the “All She Wants to Do Is
7 Dance” video. There is no evidence in the record to establish that viewers of the Tax
8 Video are familiar with, or in any way influenced by, the “All She Wants to Do Is
9 Dance” video. Finally, even if Defendants’ statements about this inadmissible video
10 could be credited, that another video incorporating Dance includes political subject
11 matter in no way addresses whether the *Tax Video* comments on the style or substance of
12 Dance.

13 **B. Plaintiffs’ Works Are at the Core of Copyright Protection**

14 While not a dispositive factor, the fact that Plaintiffs’ works are highly creative
15 and at the “core” of copyright protection “tilts the scale against fair use.” *Campbell*, 510
16 U.S. at 586; *Dr. Seuss*, 109 F.3d at 1402.

17 **C. Defendants’ Takings Are Excessive and Unprecedented**

18 To Defendants’ question as to why Plaintiffs retained Dr. Ferrara, a musicologist,
19 to assess Defendants’ musical copying, the answer is simply that Ferrara’s analysis
20 measures, in objective terms, the flagrancy of Defendants’ takings. (*See* Defs. Op. at 9.)
21 Ferrara shows that with respect to both *Boys of Summer* and *Dance*, Defendants copied
22 virtually the *entirety* of Plaintiffs’ music and melodies, and the majority of the lyrics.
23 (Ferrara Decl. ¶¶ 6-7, Ex. 1 at 6-7, 12-15, 20.) Defendants’ excuse for appropriating
24 virtually the entirety of Plaintiffs’ copyrighted songs amounts to nothing more than a
25 bald assertion that they did it because they wanted to. As demonstrated in Plaintiffs’
26 opposition, such excess finds no support in the law. Indeed, even if Defendants had
27 invoked Plaintiffs’ works for a legitimate parodic purpose, their use of Plaintiffs’ songs
28 far exceeds what prior decisions have considered fair. *See, e.g., Campbell*, 510 U.S. at

1 589 (remanding for further consideration of less extensive musical takings than
2 Defendants’ here); *Fisher v. Dees*, 794 F.2d 432, 434, 439 (9th Cir. 1986) (challenged
3 use was only 29 seconds of defendant’s 40-minute album).

4 **D. Defendants’ Uses Are Harmful to Plaintiffs’ Works**

5 The burden is on Defendants to demonstrate that their unauthorized uses of
6 Plaintiffs’ songs would not be harmful to the value of, or market for, Plaintiffs’
7 copyrighted works, if those uses were to become widespread. *Campbell*, 510 at 590; *Dr.*
8 *Seuss*, 109 F.3d at 1403; 17 U.S.C. § 107(4) (court must consider “effect of the use upon
9 the potential market for or value of the copyrighted work”). Defendants cannot satisfy
10 their obligation merely by offering statements that there is no market harm, but instead
11 must bring forth affirmative evidence that Plaintiffs’ works will not be adversely
12 impacted. *Dr. Seuss*, 109 F.3d at 1403 (mere uncontroverted submissions do not
13 suffice); *Columbia Pictures Indus., Inc. v. Miramax Films Corp.*, 11 F. Supp. 2d 1179,
14 1189 (C.D. Cal. 1998) (rejecting fair use where defendant failed to provide “affirmative
15 evidence” concerning impact on “relevant markets”). Defendants have presented no
16 such evidence. Thus, they could not expect to prevail on this factor even if Plaintiffs
17 failed to make any showing at all as to the adverse impact of Defendants’ takings.

18 Even so, Plaintiffs have not stood idly by. Rather, Plaintiffs have presented
19 substantial evidence of market harm should Defendants’ uses be permitted to continue.
20 Plaintiffs’ licensing expert, Jon Albert, provided testimony about the impact of
21 Defendants’ appropriations. Albert is an independent consultant with over 30 years of
22 experience licensing popular music and celebrity talent for promotional purposes.
23 (Declaration of Jon Albert (“Albert Decl.”) ¶ 2, Ex. 1 at 6, 14.) He regularly seeks
24 license fee quotes, typically 700 to 800 per year, and negotiates contracts for such uses.
25 (*Id.*) He has served as an expert witness for both plaintiffs and defendants, and his
26 testimony has been relied upon by courts. (*See* Albert Decl., Ex. 1 at 15); *see also, e.g.*,
27 *Yeager v. Cingular Wireless LLC*, No. 2:07-cv-02517, 2009 U.S. Dist. LEXIS 113313, at
28 *25 (E.D. Cal. Dec. 7, 2009) (citing Albert’s testimony).

1 Plaintiffs’ songs have considerable value in derivative licensing markets, in
2 addition to their value as originally recorded. (See Declaration of Lisa Thomas
3 (“Thomas Decl.”) ¶¶ 5-6, 8; Albert Decl. ¶¶ 16-17, Ex. 1 at 8-12.) Such secondary
4 markets include movies, television, music videos, commercials (including commercials
5 using modified lyrics). (See Thomas Decl. ¶¶ 6, 8; Albert Decl., Ex. 1 at 6-10; St. ¶ 27.)
6 With respect to promotional uses, Albert has explained that advertisers are selective in
7 their use of music in advertising campaigns. (Albert Decl. ¶¶ 8-10, Ex. 1 at 12.) They
8 often investigate, typically through Internet searches, how an artist is perceived by the
9 public, including the involvement of the artist and the artist’s music in other advertising
10 or endorsements. (*Id.* ¶ 8.) Advertisers and other licensees avoid songs that are already
11 associated with other products or causes, especially ones that are politically polarizing.
12 (*Id.* ¶¶ 9-10, Ex. 1 at 12.) Accordingly, Albert concluded that Defendants’ uses decrease
13 the attractiveness of, and harm the market for, Plaintiffs’ songs. (*Id.* ¶¶ 10-12, Ex. 1 at
14 12.) Albert further opined that Defendants’ uses would threaten the market for Plaintiffs’
15 original recordings, as Plaintiffs’ fans might be alienated by the political association. (*Id.*
16 ¶ 11, Ex. 1 at 12.)

17 In light of this, it is simply baffling that Defendants claim that “Plaintiffs’ [sic]
18 offer no evidence that Defendants’ videos have usurped the market for the songs in
19 question, and there is no reasonable basis for concluding that they could.” (Defs. Br. at
20 11.) Albert has clearly demonstrated that they *would*. Defendants’ attempt to dismiss
21 Albert’s conclusion as “speculation” is misguided – and nothing more than a protest that
22 Albert has offered an opinion concerning the injury to Plaintiffs’ works, which he clearly
23 is entitled to do, based on his specialized knowledge and experience. See Fed. R. Evid.
24 702.

25 Defendants also assert (in italics) that “*Henley refuses to license his songs.*”
26 (Defs. Op. at 11.) This is simply false. Licensing documents produced to Defendants
27 demonstrate that Henley approves the licensing of his songs for secondary purposes.
28 (See Henley Decl. ¶ 17; Ch. Decl. Ex. 52.) Henley employs a licensing representative,

1 Lisa Thomas, to handle the hundreds of requests for his songs each year. (Thomas Decl.
2 ¶ 5.) Thomas works directly under Henley’s supervision, consulting with Henley to
3 respond to individual requests. (*Id.* ¶ 3.) Henley has agreed to the use of his songs in
4 feature films, television shows, film trailers, television promotional spots, Internet uses
5 and music videos, among other uses. (*Id.* ¶ 6; St. ¶ 27.) Although Henley does not
6 actively seek to license his songs for commercials, his songs are sought out for this
7 purpose, and he has instructed Thomas to refer such requests to him for his consideration
8 (and did agree to a commercial use in Japan). (Henley Decl. ¶ 18; Thomas Decl. ¶ 8.)

9 Defendants also mischaracterize the views of Kortchmar and Campbell concerning
10 the licensing of their songs. Kortchmar is “open to all of [his songs] being licensed.”
11 (Ch. 2d Supp. Decl., Ex. B at 15, 17-18 (Kortchmar Dep. at 110:7-10, 117:17-118:14).)⁴
12 Campbell did not speak to the extent his works have been licensed for ancillary uses at
13 his deposition, because such licensing his handled by his management. (Campbell Decl.
14 ¶ 9; Ch. 2d Supp. Decl., Ex. A at 6-7 (Campbell Dep. 42:19-43:7).)⁵

15 Brushing aside the inconvenient fact that Plaintiffs *do* in fact permit the use of
16 their songs for derivative uses, Defendants assert that Plaintiffs’ supposed refusal to
17 license means that no potential market for their works can be considered. Defendants
18 simply ignore the law on this point. Whether Plaintiffs currently license their songs is
19 not determinative of the question of market harm. Because the fourth factor considers
20 the *potential* market for Plaintiffs’ works, courts have soundly rejected the very
21 argument Defendants make here. *See Worldwide Church*, 227 F.3d at 1119 (relevant

22 ⁴ Kortchmar did *not* testify that he “would not license a [Henley-recorded] song without
23 Henley’s permission,” as Defendants contend (Defs. Op. at 11); his actual testimony was
24 that, because Henley is a friend, he would “very likely” call Henley to “pay him the
25 respect of letting him know what was happening with a song he is identified with.” (Ch.
26 2d Supp. Decl., Ex. B at 16 (Kortchmar Dep. at 111:5-14).)

27 ⁵ Defendants also misconstrue a statement made by Campbell at his deposition by
28 quoting only half of the sentence. (Defs. Op. at 11 (“I don’t want the song [Boys of
Summer] used for anything”) (quoting Campbell).) Campbell’s complete statement
was, “I don’t want the song used for anything, especially without my permission.” (Ch.
2d Supp. Decl., Ex. A at 8 (Campbell Dep. at 47:3-5).)

1 consideration is not current licensing activity, but “potential market”); *Salinger v.*
2 *Random House, Inc.*, 811 F.2d 90, 99 (2d Cir. 1987) (same) (citing 17 U.S.C. § 107(4)).
3 The fact that a copyright owner is not currently exploiting a particular market does not
4 preclude a finding of market harm. This is because the law respects a copyright owner’s
5 right *not* to speak, as well as the “right to change his mind.” *Harper & Row*, 471 U.S. at
6 559; *Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc.*, 150 F.3d 132, 145-46 (2d Cir.
7 1998); *Worldwide Church*, 227 F.3d at 1119; *Salinger v. Random House, Inc.*, 811 F.2d
8 at 99; *see Napster*, 239 F.3d at 1027 (copyright holder has right to curb development of a
9 derivative market by refusing to license).

10 **II. DEFENDANTS’ INFRINGEMENT WAS WILLFUL**

11 “[I]nfringement is willful under the Copyright Act if the defendant had knowledge
12 that his conduct was infringing, or . . . acted with reckless disregard for the copyright
13 holder’s rights.” *Microsoft Corp. v. Marturano*, No. 1:06cv1747, 2009 U.S. Dist. LEXIS
14 44450, at *13-14 (E.D. Cal. May 27, 2009); *Microsoft Corp. v. E&M Internet Bookstore,*
15 *Inc.*, No. C 06-06707, 2008 U.S. Dist. LEXIS 4381, at *7 (N.D. Cal. Jan. 22, 2008)
16 (same). A continuation of infringing conduct after receiving notice of infringement
17 “clearly demonstrate[s]” willfulness. *Adobe Sys. Inc. v. Kern*, No. C 09-1076, 2009 U.S.
18 Dist. LEXIS 123566, at *20 (N.D. Cal. Nov. 24, 2009); *Peer Int’l Corp. v. Pausa*
19 *Records, Inc.*, 909 F.2d 1332, 1336 (9th Cir. 1990) (licensee’s continuation of conduct
20 after notice of license revocation found to be willful); *Kamar Int’l, Inc. v. Russ Berrie &*
21 *Co.*, 752 F.2d 1326, 1330 (9th Cir. 1984) (notice gave defendant “the option to change
22 his conduct”); *Chi-Boy Music v. Charlie Club, Inc.*, 930 F.2d 1224, 1227 (7th Cir. 1991)
23 (“[E]vidence that notice had been accorded to the alleged infringer before the . . .
24 infringement occurred is perhaps the most persuasive evidence of willfulness . . .”).
25 Where the relevant facts are not in dispute, willfulness is appropriately resolved on
26 summary judgment. *Peer Int’l*, 909 F.2d at 1333, 1336.

27 Here, as chronicled in Plaintiffs’ earlier briefs, Defendants have not only admitted
28 to – but gloated over – a course of conduct that amply supports a finding of willfulness.

1 Defendants celebrated their receipt of Henley’s notice of infringement, ensured that the
2 video he had taken down from YouTube was available elsewhere, and welcomed the
3 possibility of an injunction. (St. ¶¶ 77, 80, 82-88, 93, 99.) Notwithstanding the
4 infringement notice, they proceeded to make and distribute a second video using
5 Henley’s work, and promised to “rifle through . . . Henley’s cateloge [sic]” for other
6 songs to take. (St. ¶¶ 98-100.) They made a calculated decision that the “earned media
7 value” of a lawsuit would outweigh the burden to their campaign – hoping that the
8 money “might come rolling in.” (St. ¶¶ 86-87.) And they did all of this without
9 retaining a lawyer to advise them as to whether they had a valid claim of fair use –
10 blithely ignoring a friend’s advice that it would be a “good idea” to consult an attorney.
11 (St. ¶¶ 91, 109.)

12 “To refute evidence of willful infringement, [the defendant] must not only
13 establish *its good faith belief in the innocence of its conduct, it must also show that it was*
14 *reasonable in holding such a belief.*” *Peer Int’l*, 909 F.2d at 1336 (emphasis added).
15 Especially after receiving Henley’s notice regarding the Hope Video – and being advised
16 to consult an attorney about the legality of their conduct – Defendants had no reasonable
17 basis to believe in the “innocence” of their conduct. Far from holding a “reasonable
18 belief” in their innocence, they openly acknowledged – and even hoped – that they
19 would be enjoined. (St. ¶ 93.) Plaintiffs’ copyrights, and the possibility of a federal
20 lawsuit, did not matter to Defendants, for they saw greater benefit in continuing to
21 infringe. There could hardly be a more compelling example of callous disregard for
22 copyright holders’ rights.

23 Defendants’ reliance on *Princeton University Press v. Michigan Document*
24 *Services, Inc.*, 99 F.3d 1381 (6th Cir. 1996), only highlights the culpability of their
25 conduct. In *Princeton University*, the defendant studied the relevant law, and *obtained*
26 *an opinion from an attorney*, before arriving at his conclusion that copying academic
27 materials for student use constituted a fair use. *Id.* at 1384. On this record, the Sixth
28 Circuit declined to find willfulness. *Id.* at 1392. Notably, the Sixth Circuit later reached

1 the opposite conclusion in a case much closer to the one here, where a record company
2 defendant received notices of infringement concerning a song, but made no “effort to
3 compare the two songs [at issue] and evaluate whether the use of elements of [plaintiff’s
4 song] was actually ‘fair’” *Bridgeport Music, Inc. v. UMG Recordings, Inc.*, 585
5 F.3d 267, 279 (6th Cir. 2009). The *Bridgeport* court specifically distinguished *Princeton*
6 *University* based on the record company’s failure to evaluate its fair use claim by
7 “stud[ying] the fair-use doctrine and consult[ing] an attorney.” *Id.* Thus, in contrast to
8 the defendant in *Princeton University*, the record company “did not present any evidence
9 to establish a basis for their claim of good faith” *Id.* It is *Bridgeport*, not *Princeton*
10 *University*, that is the relevant precedent here.

11 **III. HENLEY IS ENTITLED TO SUMMARY JUDGMENT ON HIS LANHAM** 12 **ACT CLAIM**

13 **A. Defendants’ Legal Arguments Lack Merit**

14 Defendants reiterate the same arguments concerning Henley’s Lanham Act claim –
15 in some cases for the third time – but they do not improve with repetition.

16 There is no separate element of “distinctive attribute” required in celebrity cases
17 under the Lanham Act. The use of “distinctive attribute” and “distinguishing
18 characteristic” in the case law refers to the “symbol” or “device” that is used to invoke
19 the celebrity. The Lanham Act is broadly worded, and broadly construed, so that not
20 only names, faces, voices and physical appearance, but also robots, uniforms,
21 photographs, distinctive sounds and “distorted song lyrics,” have been held to constitute
22 confusing devices. (*See* July 8, 2009 Order Denying Defendants’ Motion to Dismiss,
23 Docket No. 22, at 13); *see also* *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1106-07 (9th Cir.
24 1992); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399-1401 (9th Cir. 1992);
25 *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204-05 (2d
26 Cir. 1979); *Butler v. Target Corp.*, 323 F. Supp. 2d 1052, 1058-59 (C.D. Cal. 2004). As
27 the Supreme Court put it in construing the language of the Lanham Act: “Since human
28 beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of

1 carrying meaning, this language, read literally, is not restrictive.” *Qualitex Co. v.*
2 *Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

3 Here, Defendants mimicked two famous recordings closely associated with Henley
4 as the basis of promotional videos. Defendants used simulated musical performances
5 with changed words – in “distinctive attribute” terms, they employed “distinctive
6 sounds” and “distorted lyrics.” Such simulated performances create confusion. Viewers
7 of Defendants’ videos featuring Henley’s music think that Henley approved the use of
8 his songs and falsely associate him with the videos. That Defendants’ device is, indeed,
9 confusing is borne out by Henley’s survey evidence, which demonstrates that a
10 substantial number of viewers of the videos interpret the use of Henley’s music in just
11 this way.

12 Defendants’ contention that Henley’s Lanham Act claim would “fundamentally
13 change *copyright law*” by barring the authorized use of a musical composition when that
14 use falsely suggests approval or association fails to recognize that this is *already* the law.
15 (See Defs. Op. at 15.) In *Waits*, although defendants were legally entitled to exploit the
16 composition at issue (it had been written expressly for the commercial), the court
17 concluded that defendants’ use was confusing, and therefore wrong. *See Waits*, 978 F.2d
18 at 1097, 1107-11. Confusion, not copyright infringement, was the gravamen of *Waits*.
19 Defendants’ discussion also misses the critical distinction that, unlike the hypothetical
20 they pose, Defendants’ uses were *not* authorized here.

21 As Plaintiffs have previously demonstrated, it is well recognized that a Lanham
22 Act claim may coexist with a claim of copyright infringement. *See Browne v. McCain*,
23 612 F. Supp. 2d 1125, 1128, 1131, 1133 (C.D. Cal. 2009) (use of copyrighted recording
24 in political ad gives rise to both copyright and Lanham Act claims); *Butler*, 323 F. Supp.
25 2d at 1059 (Lanham Act claim based on “distortion” of copyrighted song permitted
26 because it “differs from a copyright claim”); *Microsoft Corp. v. Evans*, No. 1:06-cv-
27 01745, 2007 U.S. Dist. LEXIS 77088, at *25 (E.D. Cal. Oct. 17, 2007) (single act can
28

1 violate both Lanham Act and Copyright Act “because two separate wrongs have been
2 committed”).

3 It is time for Defendants’ arguments to be laid to rest. Henley respectfully refers
4 the Court to his earlier briefs for his response to the remainder of Defendants’ arguments.

5 **B. Although Not Required, Plaintiffs Have Amply Demonstrated Actual Malice**

6 The actual malice standard does not apply in this case. Defendants are not media
7 organizations and Defendants’ uses are promotional, not noncommercial, in nature.
8 Notably, in a recent case involving the unauthorized use of pilot Chuck Yeager’s persona
9 in a pamphlet about emergency preparedness, the court, distinguishing *Hoffman v.*
10 *Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001), determined that the pamphlet –
11 even though it did not “propose a commercial transaction, nor . . . offer for sale any
12 specific products or services” – nonetheless constituted commercial speech because it
13 was aimed at creating “positive associations” with the defendant. *Yeager*, 2009 U.S.
14 Dist. LEXIS 113313, at *4, *14-17; *subsequent proceeding*, 2010 U.S. Dist. LEXIS
15 35954 (E.D. Cal. Mar. 12, 2010) (certifying appeal on question of commercial speech).

16 There is another problem with Defendants’ actual malice theory. Unlike in
17 *Hoffman, Kournikova v. General Media Communications, Inc.*, No. CV 02-3747, 2002
18 U.S. Dist. LEXIS 25810 (C.D. Cal. Aug. 9, 2002), or *Solano v. Playgirl, Inc.*, 292 F.3d
19 1078 (9th Cir. 2002) – the cases relied upon by Defendants – Defendants’ videos are not
20 about Henley. They do not name, discuss or depict him. The Ninth Circuit has rejected
21 the applicability of a First Amendment defense where there is only a “tenuous
22 relationship” between the use of a plaintiff’s identity and the publication at issue.
23 *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1001-03 (9th Cir. 2001). In *Downing*,
24 the defendant had published a catalog that included an article about surfing, which was
25 illustrated by a photograph of the celebrated surfer plaintiffs; the court rejected the
26 defendant’s First Amendment defense to the plaintiffs’ right of publicity claim because
27 the photograph was not “in any way connect[ed]” with the content of the article. *Id.* The
28 *Downing* court then proceeded to uphold the plaintiffs’ Lanham Act claim without

1 applying an actual malice standard, reversing the grant of summary judgment below. *Id.*
2 Similarly, in *Browne v. McCain*, 611 F. Supp. 2d 1062 (C.D. Cal. 2009), another case
3 involving both right of publicity and Lanham Act claims, the court rejected First
4 Amendment challenges concerning the use of a Jackson Browne song in a campaign ad:
5 “RNC has not shown how its use of the [song] *itself* is a matter of public interest. . . .
6 [T]he evidence shows that the [c]ommercial did not comment on nor target the [song]
7 nor Browne.” *Id.* at 1067, 1071; *see also* *Browne v. McCain*, 612 F. Supp. 2d 1125,
8 1132-33 (C.D. Cal. 2009) (rejecting First Amendment challenge to Lanham Act claim).

9 But even if actual malice were deemed to apply to Henley’s claim, as shown in
10 Plaintiffs’ opposition, Henley has presented clear and convincing evidence to satisfy that
11 standard. Curiously, counsel for Defendants now seeks to offer his own testimony that
12 the disclaimer that was added to the Tax Video several months after this lawsuit was
13 filed was to eliminate any possibility of Henley’s being able to prove “that the video
14 Defendants were running on the internet was causing consumer confusion”
15 (Arledge Supp. Decl. ¶ 2.)⁶ But Arledge’s testimony only helps Henley, not Defendants,
16 because it corroborates the fact that Defendants were fully aware that their use of
17 Henley’s music could be confusing.

18 **C. The *Sleekcraft* Factors Uniformly Favor Henley**

19 As demonstrated in Plaintiffs’ opening brief, each of the *Sleekcraft* factors favors
20 Henley. Defendants fail to present evidence to establish the contrary.

21 Based on language in *Waits*, Defendants question Plaintiffs’ treatment of Henley’s
22 persona as his trademark, claiming he has no “identifiable ‘mark’.” (Defs. Op. at 18.)
23 But it is clear from Ninth Circuit case law that for purposes of the *Sleekcraft* analysis, the
24 celebrity’s persona is the relevant “mark”: “[T]he term ‘mark’ applies to the *celebrity’s*

25 ⁶ Plaintiffs reserve their rights concerning both Arledge’s acting as a witness and
26 Defendants’ untimely “advice of counsel” defense, of which Plaintiffs were never
27 previously notified. In fact, Defendants specifically resisted Plaintiffs’ attempts to
28 explore the disclaimer with DeVore, asserting a claim of privilege. (Charlesworth
Declaration Ex. 15 at 353 (Deposition of Charles DeVore 289:2-7).)

1 *persona*, the ‘strength’ of the mark refers to the level of recognition that the celebrity has
2 among the segment of the public to whom the advertisement is directed” *Downing*,
3 265 F.3d at 1007 (emphasis added) (citing *White*, 971 F.2d 1400-01); 5 J. THOMAS
4 MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (“MCCARTHY ON
5 TRADEMARKS”) § 28:15, at 28-32 (4th ed. 2010) (“celebrity’s *persona*” serves as the
6 trademark under Ninth Circuit rule). Defendants do not dispute that Henley is a world-
7 famous songwriter, recording artist and performer. (Defendants’ Response to Plaintiffs’
8 Statement of Uncontroverted Facts (“Defs. Resp. to St.”) ¶ 1); *see also* Defs. Op. at 18-
9 19 (Henley a “world-famous musician” with a “ubiquitous” presence.) Pursuant to the
10 first *Sleekcraft* factor, Henley has clearly established a protectable mark in his *persona*.

11 Defendants also attempt to argue, under the second factor, that Henley’s “goods”
12 are not in “proximity” to Defendants’ “goods” – even though Defendants do not dispute
13 that authorized videos featuring Henley’s music are available on YouTube and elsewhere
14 on the Internet – just as Defendants’ videos were and would be, if they were permitted to
15 be restored. (*See* Defs. Resp. to St. ¶ 27.) The concern of the second *Sleekcraft* factor in
16 a case such as this is actually “relatedness of the goods.” *Yeager*, 2009 U.S. Dist. LEXIS
17 13313, at *28. Defendants are distributing videos featuring Henley’s music – the same
18 goods as Henley. This clearly establishes relatedness in Henley’s favor. The fifth
19 *Sleekcraft* factor, too, favors Henley, since Defendants’ videos are distributed through
20 exactly the same channels. Additionally, Defendants do not dispute that their videos are
21 distributed for free on the Internet, just as Henley’s are. (Defs. Op. at 19 (Defendants’
22 videos “are not and never have been for sale”).) This fact demonstrates that the degree of
23 care exercised by “purchasers” – *i.e.*, viewers – of both Henley’s and Defendants videos
24 is undoubtedly low, again favoring Henley.

25 Defendants’ assertions that viewers will not have a mistaken impression of their
26 “goods” vis-a-vis Henley’s goes to the question of confusion, not “proximity” or
27 “relatedness.” (*See* Defs. Op. at 18.) Confusion is a separate concern addressed under
28 the fourth factor, and in this case it is conclusively established by Henley’s survey.

1 **D. Defendants Offer No Legitimate Criticism of Poret’s Survey**

2 Defendants take issue with the survey performed by Henley’s expert, Mr. Hal
3 Poret. (Defs. Op. at 19.) Poret has created, supervised and implemented nearly 300
4 consumer surveys concerning consumer perception, opinion and behavior, over 150 of
5 which have involved issues related to the Lanham Act. (Declaration of Hal Poret (“Poret
6 Decl.”) ¶ 2; Supplemental Declaration of Hal Poret (“Poret Supp. Decl.”) ¶ 2.) Poret’s
7 survey design in this case is based on a highly regarded survey technique known as an
8 “*Eveready*” survey. *See* 5 MCCARTHY ON TRADEMARKS § 32:174 (*Eveready* format is a
9 “now-standard survey format”); § 32:173.50 (*Eveready* test as “gold standard”). When
10 applied to a false endorsement claim, an *Eveready* survey asks survey respondents a
11 series of open-ended questions designed to determine whether the respondents believe,
12 without prompting, that the defendant’s product (here, Defendants’ videos) was approved
13 by or affiliated with the plaintiff. (Poret Supp. Decl. ¶ 3.) Poret’s survey tracked this
14 format and consisted of three parts: screening questions, open-ended questions and a
15 closed-ended question. (*Id.* ¶ 4.) The screening questions identified viewers of the
16 videos who believed that Henley was the artist whose music was used. (*Id.*) This was
17 necessary because, as Poret explained, “surveying individuals who do not understand the
18 music to be Henley’s would not reveal whether or not the videos are confusing or
19 misleading.” (*Id.*)

20 The screening questions yielded 114 eligible respondents.⁷ Out of those 114
21 respondents, 23% answered in response to open-ended questioning that they believed
22 that Henley endorsed the video(s) or gave authorization for his music to be used in the
23 video(s). (Poret Decl. ¶ 7.) An additional 25% of the 114 respondents indicated in the
24 closed-ended question that they believed Henley approved or authorized the use of his
25 music in the videos. (*Id.*) Therefore, a total of 48% of the 114 respondents indicated in

26 ⁷ Because the screening question referencing Henley needed to be asked at the end of the
27 survey – to avoid placing Henley in the minds of respondents up front – 572 qualified
28 respondents actually completed the survey. (Poret Decl. ¶ 6, Ex. 1 at 9.)

1 response to at least one survey question that they thought Henley endorsed the videos or
2 authorized or approved the use of his music in the videos. (*Id.*) This led Poret to
3 conclude “to a high degree of professional certainty that the use of Henley’s music in the
4 videos caused, and is likely to cause, viewers to mistakenly believe that Henley endorsed
5 or approved Defendants’ videos, or to mistakenly believe that there is an affiliation or
6 association between Henley and the videos.” (*Id.* ¶ 8.)

7 Defendants did not conduct their own survey to test Poret’s conclusions. Instead,
8 they turned to an unknowledgeable, inexperienced “expert” witness, Dr. Suzanne Shu.
9 As set forth in more detail in Plaintiffs’ concurrently filed objections, Shu has no
10 background in creating or analyzing Lanham Act likelihood of confusion surveys, and, at
11 the time of her deposition, was not even aware of the *Eveready* survey format. (Ch. 2d
12 Supp. Decl., Ex. E at 54-57 (Deposition of Suzanne Shu (“Shu Dep.”) at 12:20-22,
13 17:10-24, 20:1-3, 21:14-20).) Amazingly, Shu wrote her report *without ever watching*
14 *Defendants’ videos*. (*Id.*, Ex. E at 60 (Shu Dep. at 40:23-24).) Defendants do not rely on
15 Shu’s report in their opposition, other than to note parenthetically that her declaration
16 “tracks much of the analysis [in Defendants’ brief].”⁸ (Defs. Op. at 19.) Their attempt to
17 distance themselves from Shu is not surprising. But the result is that Defendants’
18 arguments amount to nothing more than flawed assertions by Defendants’ counsel, who
19 is not qualified to offer an opinion on Lanham Act survey techniques.

20 Defendants initially challenge the responses to what they deem Poret’s “first set”
21 of open-ended questions, asserting, without support, that “[o]nly about 3% of the
22 respondents said that they believed Henley endorsed or approved Defendants’ videos.”
23 (Defs. Op. at 21.) It is unclear how Defendants arrived at this 3% number, but it was not
24 based on Poret’s survey results, which nowhere support such a figure. (Poret Supp. Decl.
25 ¶ 6.) Defendants then argue that 3% is a “very low percentage,” purporting to cite Poret.

26 _____
27 ⁸ Shu’s Declaration is entirely inadmissible in any event, because it sets forth a series of
28 opinions nowhere included in her expert report, in violation of Rule 26(a)(2)(B)(i).

1 (Defs. Op. at 21.) The quoted portions of Poret’s testimony, however, have nothing to do
2 with the rate of confusion as to Henley; rather, Poret was describing the 3% of
3 respondents who identified *Barack Obama* as a person who endorsed or authorized the
4 Hope Video. (Poret Supp. Decl. ¶ 7; Arledge Supp. Decl., Ex. D, at 46:16-52:14.) The
5 3% figure was used by Poret to gauge the level of “noise” in the survey – or “the
6 tendency of the survey to cause respondents to name Henley for reasons other than a
7 genuine belief that he endorsed the video(s) or authorized the use of his music in the
8 video(s).” (Poret Decl., Ex. 1 at 24-25.) When compared to the 23% of respondents who
9 named Henley in response to open-ended questions, the 3% of respondents who named
10 Obama represents a small percentage, and Poret was able properly to conclude that the
11 level of survey noise was minimal. (Poret Decl., Ex. 1 at 24-25, 36-38.)

12 Perhaps even more deceptive is Defendants’ treatment of the responses to the
13 “second open-ended set” of questions. (Defs. Op. at 21-24.) Defendants include a chart
14 that purports to list the answers to question 7b – just one of nine open-ended questions in
15 the survey. On the basis of question 7b alone, Defendants assert that 20 respondents
16 Poret counted as confused were improperly included. Defendants’ analysis is simply
17 misleading. By isolating the responses to a single question – and then claiming that the
18 answer to the one question does not support Poret’s conclusion because the respondent
19 did not name Henley – Defendants *ignore respondents’ additional answers identifying*
20 *Henley*. For example, Defendants claim that respondent 265 in Defendants’ chart should
21 not have been included by Poret. (Defs. Op. at 22-23.) Defendants, however, omit
22 respondent 265’s statement in response to *other* open-ended questions stating his belief
23 that permission or authorization was given for the music in the Hope video “because he
24 [DeVore] used the song Boys of Summer by Don Henley in this video.” (Poret Supp.
25 Decl. ¶ 9.) Similarly, respondent 162 in Defendants’ chart stated that she believed
26 permission or authorization was given for All She Wants to Do is Dance (which she
27 identified as a Henley song) because “it was for his original song that they changed the
28 lyrics ... they are using the song, just a different mix and words.” When asked who

1 provided permission or authorization to use Henley’s song, the respondent then answered
2 “him.” (*Id.* ¶ 10.) Again, Defendants *simply omit the portion of the response where*
3 *Henley was specifically named.* To more fully demonstrate the disingenuous nature of
4 Defendants’ criticism, Plaintiffs refer the Court to a chart created by Poret showing *all of*
5 the relevant responses from the 26 respondents evidencing confusion in response to
6 open-ended questions. (*Id.*, Ex. 1.) (These are in addition to the 29 respondents (25% of
7 the total) who responded to the closed-ended question in the survey in a manner that
8 demonstrated confusion.)

9 In sum, Defendants have produced no credible testimony or contrary data to refute
10 the results of Poret’s survey, which, under *Sleekcraft* factor four, demonstrates a high
11 level of actual confusion as to Henley’s association with Defendants’ videos. *Thane*
12 *Int’l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 902-03 (9th Cir. 2002) (grant of summary
13 judgment improper because actual confusion could be found from plaintiff’s survey
14 evidence, and actual confusion is “persuasive proof” of likelihood of confusion).
15 Because, based on the uncontroverted evidence, each and every *Sleekcraft* factor favors
16 Henley – and he has clearly demonstrated a likelihood of confusion – he is entitled to
17 summary judgment on the question of Defendants’ liability under the Lanham Act.

18 CONCLUSION

19 For all of the reasons set forth herein, as well as in Plaintiffs’ opening and
20 opposition briefs, Plaintiffs respectfully request that this Court grant Plaintiffs’ motion
21 for partial summary judgment, and deny Defendants’ corresponding cross-motion.

22 Dated: May 17, 2010

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