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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

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

Plaintiff,

v.

COMICMIX LLC, a Connecticut limited
liability company; GLENN HAUMAN,
an individual; DAVID JERROLD
FRIEDMAN a/k/a DAVID GERROLD,
an individual; and TY TEMPLETON,
an individual,

Defendants.

Case No.: 16-CV-2779 JLS (BGS)

**ORDER (1) DENYING
DEFENDANTS’ MOTION FOR
RECONSIDERATION AND
(2) DENYING PLAINTIFF’S
RENEWED MOTION FOR
SUMMARY JUDGMENT**

(ECF Nos. 176, 177)

Presently before the Court are Defendants ComicMix LLC, Glenn Hauman, David
Jerrold Friedman, and Ty Templeton’s (collectively, “ComicMix” or “Defendants”) Motion for Reconsideration of Order Denying Motion for Issuance of Request to the Register of Copyrights Pursuant to 17 U.S.C. § 411(b) (“Reconsid. Mot.,” ECF No. 177) and Plaintiff Dr. Seuss Enterprises, L.P.’s (“Seuss” or “Plaintiff”) Renewed Motion for
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1 Summary Judgment (“MSJ,” ECF No. 176).¹ Also before the Court are Seuss’s opposition
2 to the Reconsideration Motion (“Reconsid. Opp’n,” ECF No. 178), ComicMix’s reply in
3 support of the Reconsideration Motion (“Reconsid. Reply,” ECF No. 181), ComicMix’s
4 opposition to the MSJ (“MSJ Opp’n,” ECF No. 179), and Seuss’s reply in support of the
5 MSJ (“MSJ Reply,” ECF No. 180). The Court took both matters under submission without
6 oral argument pursuant to Civil Local Rule 7.1(d)(1). *See* ECF No. 182. Having
7 considered the Parties’ arguments, the law, and the facts, the Court **DENIES** ComicMix’s
8 Reconsideration Motion and **DENIES** Seuss’s MSJ for the reasons set forth below.

9 **BACKGROUND**

10 **I. Factual and Procedural Background**

11 The Parties, who are intimately familiar with the facts of this case, do not submit
12 new Statements of Fact in support of or in opposition to Seuss’s MSJ. Rather, Seuss
13 “directs the Court to the Statement of Facts (“SOF”) submitted in connection with its
14 original motion for summary judgment,” MSJ at 3 n.1 (citing ECF No. 107-2), and, other
15 than a brief, one-paragraph summary of the procedural history, ComicMix does not provide
16 any recitation of the facts, *see* MSJ Opp’n. Accordingly, the Court incorporates by
17 reference the factual and procedural background as set forth in its Order Granting
18 Defendants’ Motion for Summary Judgment and Denying Plaintiff’s Motion for Summary
19 Judgment (“MSJ Order,” ECF No. 149 at 2–13) and its Order Denying Defendants’ Motion
20 for Issuance of Request to the Register of Copyrights (“Referral Order,” ECF No. 88 at 2–
21 3).

22 Seuss is the owner, by assignment, of the copyrights to the works of Theodor S.
23 Geisel, the author and illustrator of the books written under the pseudonym “Dr. Seuss.”
24 Pl.’s Statement of Undisputed Material Facts in Support of Pl.’s MSJ (“SOF”), ECF No.
25 115-1, ¶¶ 1–4. Mr. Geisel wrote and illustrated the works at issue here: *Oh, the Places*
26

27
28 ¹ Seuss filed what appears to be a substantively identical motion earlier the same day, *see* ECF No. 175,
which the Court **DENIES AS MOOT** in light of the second filing.

1 *You'll Go!* (“Go!”); *How the Grinch Stole Christmas!* (“Grinch”); and *The Sneetches and*
2 *Other Stories* (“Sneetches”) (collectively, the “Copyrighted Works”). SOF ¶¶ 2–7

3 In 2016, Defendants set out to create *Oh, the Places You'll Boldly Go!* (“*Boldly!*”).
4 Each of Mr. Templeton, Mr. Gerrold, and Mr. Hauman testified that he considered *Boldly!*
5 a parody, a mash-up, and a transformative work of the Copyrighted Works. *See, e.g.,*
6 Declaration of Tamar E. Duvdevani in Support of Pl.’s MSJ (“Duvdevani Decl.”) Ex. 1,
7 ECF No. 107-23 at 120:14–23; Duvdevani Decl. Ex. 2, ECF No. 107-24, at 68:7–8, 77:19–
8 78; Duvdevani Decl. Ex. 3, ECF No. 107-25, at 75:23–76:11. However, each Defendant
9 also testified that he copied the Copyrighted Works to create *Boldly!*. SOF ¶¶ 33, 51–54,
10 56, 64.

11 After learning about *Boldly!*, Seuss sent ComicMix three letters, dated September
12 28, October 7, and October 25, 2016, demanding that ComicMix immediately cease all use
13 of the Copyrighted Works. SOF ¶¶ 103–05. Seuss also sent a DMCA takedown notice to
14 Kickstarter on October 7, 2016. *Id.* ¶ 68. ComicMix sent Seuss a responsive letter on
15 October 28, 2016, which refused Seuss’s demands. SOF ¶¶ 106–08. Seuss filed this
16 infringement action on November 10, 2016. ECF No. 1.

17 As relevant to the present motions, on December 22, 2017, ComicMix filed a motion
18 for issuance of a request to the Register of Copyrights pursuant to 17 U.S.C. § 411(b)(2),
19 on the basis that Mr. Geisel’s copyright registration applications for *Go!* and *Sneetches*
20 were knowingly and materially inaccurate and incomplete. *See* ECF No. 57. On May 21,
21 2018, the Court denied ComicMix’s motion. *See generally* Referral Order. In the Referral
22 Order, the Court concluded that neither of the copyright applications was based on
23 inaccurate information, as neither of the works in question contained a “substantial”
24 amount of the undisclosed previously published material, and accordingly the Court
25 declined to issue a request to the Register of Copyrights. *See id.* at 8–10.

26 On December 11, 2018, the Parties filed cross-motions for summary judgment. *See*
27 ECF Nos. 107, 108. ComicMix sought summary judgment as to all of Seuss’s surviving
28 claims on the ground that ComicMix was entitled to summary adjudication on its

1 affirmative defenses for fair use and the First Amendment. *See generally* ECF No. 108.
2 Seuss sought summary judgment of ComicMix’s willful copyright infringement. *See*
3 *generally* ECF No. 107. On March 12, 2019, the Court granted ComicMix’s motion as to
4 the copyright infringement claims, finding ComicMix was entitled to its fair use defense.
5 *See* MSJ Order at 33. ComicMix also sought summary judgment of the surviving
6 trademark infringement claims on the grounds that neither a stylized font nor an illustration
7 style is subject to trademark protection, and, even if they were, ComicMix’s use thereof
8 merits First Amendment protection under *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).
9 *See generally* ECF No. 108. The Court agreed that an illustration style is not protectable,
10 *see* MSJ Order at 34, and that the “use of Seussian typefaces, not in conjunction with an
11 enforceable mark, cannot support a claim for violation of the Lanham Act.” *Id.* at 36–37.
12 Accordingly, the Court granted ComicMix’s motion as to the surviving trademark and
13 unfair competition claims. *Id.* at 35, 37. Given this disposition, the Court declined to
14 address the First Amendment issues. *Id.* at 37. Further, given the Court’s determination
15 that ComicMix was entitled to summary judgment on its fair use defense, the Court denied
16 Seuss’s cross-motion. *Id.*

17 On March 26, 2019, Seuss appealed the MSJ Order. *See* ECF No. 151. The Ninth
18 Circuit heard oral argument on Seuss’s appeal on April 27, 2020. *See Dr. Seuss Enters.,*
19 *L.P. v. ComicMix LLC*, 983 F.3d 443, 443 (9th Cir. 2020). On December 18, 2020, the
20 Ninth Circuit issued its opinion affirming in part and reversing in part the MSJ Order. *See*
21 *id.* The Court held a mandate hearing on March 5, 2021, during which the Court set a
22 briefing schedule for any motions. *See* ECF No. 173. The present motions followed.

23 **II. The Ninth Circuit’s Opinion**

24 The Ninth Circuit reversed the Court’s grant of summary judgment in favor of
25 ComicMix on the copyright infringement claim but affirmed the Court’s Rule 12(c)
26 dismissal and grant of summary judgment in favor of ComicMix on the trademark claim.
27 *ComicMix*, 983 F.3d at 448.

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1 As relevant to the present motions, the Ninth Circuit concluded that each of the four
2 statutory fair use factors “decisively weigh[s] against ComicMix and no countervailing
3 copyright principles counsel otherwise.” *Id.* at 451. As to the first factor, the purpose and
4 character of the use, because *Boldly!* is “indisputably commercial” and not transformative,
5 the Ninth Circuit found that the first factor weighs against fair use. *Id.* at 451–52. The
6 Ninth Circuit concluded *Boldly!* is not a parody because it does not critique or comment
7 on the Copyrighted Works by, for example, holding Dr. Seuss’s style up to ridicule or
8 criticizing the “purported self-importance of [the Copyrighted Works’] characters.” *Id.* at
9 452–53. Nor does replacing Seuss characters and elements with *Star Trek* material render
10 the work transformative, as this replacement does not give Seuss’s work new purpose or
11 meaning. *Id.* at 453. *Boldly!* lacks the benchmarks of transformative use, instead
12 paralleling the Copyrighted Works’ purpose. *Id.* at 453–55.

13 As to the second factor, the nature of the copyrighted work, the Copyrighted Works
14 are creative and expressive works, which weighs against a finding of fair use. *Id.* at 456.
15 As to the third factor, the amount and substantiality of the portion of the copyrighted work
16 used, the quantitative amount of the Copyrighted Works taken by *Boldly!* “was
17 considerable,” *id.*, with close replication of well-known and significant illustrations from
18 all of the Copyrighted Works and copying of 14 of *Go!*’s 24 pages, *id.* The Ninth Circuit
19 also found the qualitative value used by *Boldly!* to be “substantial,” as *Boldly!* “took the
20 heart of Dr. Seuss’s works” by, for example, taking the machine at the heart of *Sneetches*
21 and repurposing it as a *Star Trek* transporter. *Id.* at 457–58.

22 As to the fourth factor, the effect on the value or market for the copyrighted work,
23 the Ninth Circuit found that the Court erred in shifting the burden of showing market harm
24 to Seuss, resulting in a “skewed analysis” of this factor. *Id.* at 458. Weighing the factors,
25 the Ninth Circuit concluded that ComicMix could not sustain its fair use defense and that
26 this Court therefore erred in granting summary judgment in favor of ComicMix on the
27 copyright infringement claim. *Id.* at 461.

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1 *Id.* at 1196. The registration was a “single-unit registration” of thirty-one designs, one of
2 which was the allegedly infringed design. *Id.* Twenty-two of the designs covered by the
3 registration, including the allegedly infringed design, bore the prefix “EH,” which meant
4 they had been created in January 2011; the remaining nine bore the prefix “CEH,” which
5 meant they were “confined” works designed in January 2011. *Id.* The plaintiff’s
6 “confined” works were created for specific customers, who would receive exclusive use
7 for several months. *Id.* The copyright registration indicated that all thirty-one designs had
8 a January 15, 2011 date of first publication. *Id.*

9 The defendant appealed the judgment against it, arguing that the copyright
10 registration covering the design in question was invalid due to the inclusion of known
11 inaccuracies in the registration application. *Id.* at 1197. Specifically, the defendant argued
12 that the designs were improperly registered as a “single unit” because they were not first
13 sold or offered for sale in an integrated manner, given that some of the works were
14 displayed publicly in the plaintiff’s showroom and others were “confined” works sold
15 separately and exclusively to individual customers. *Id.* at 1197–98. When presented with
16 this issue, the district court had found against the defendant for two reasons. *Id.* at 1198.
17 First, the district court had held that invalidation required a showing that the plaintiff had
18 intended to defraud the Copyright Office, and no evidence of such an intent had been
19 introduced. *Id.* Second, the district court found that all thirty-one designs were first
20 “published” and made available to the public on the same day. *Id.*

21 The Ninth Circuit found that the district court was wrong on both counts. *Id.* The
22 Ninth Circuit acknowledged that its prior case law implied an intent-to-defraud
23 requirement but noted that its recent decision in *Gold Value International Textile, Inc. v.*
24 *Sanctuary Clothing, LLC*, 925 F.3d 1140, 1147 (9th Cir. 2019), clarified that no such
25 requirement exists. 959 F.3d at 1198. The Ninth Circuit further held that a “single unit”
26 registration requires that the collection of works first first published as a single, bundled
27 collection; because the “confined” designs were not placed in the showroom for sale at the
28 same time as the other designs, they were not “published” on the same date. *Id.* at 1198–

1 200. The Ninth Circuit further reasoned that the plaintiff knew that some of the designs on
2 the registration were “confined” and therefore published separately to exclusive customers,
3 satisfying the knowledge requirement of section 411(b). *Id.* at 1200. The Ninth Circuit
4 therefore reversed the district court’s entry of judgment in favor of the plaintiff and
5 remanded to the district court to submit an inquiry to the Register of Copyrights. *Id.* at
6 1200–01.

7 **II. Summary of the Parties’ Positions**

8 ComicMix argues that *Unicolors*, which was decided after oral argument was held
9 on Seuss’s appeal in this case, *see* Reconsid. Mot. at 3, is an intervening change in
10 controlling law, *see id.* at 9. ComicMix argues that *Unicolors* “changed the nature of how
11 courts in this Circuit are required to address such § 411(b) requests” by clarifying that
12 “§ 411 is mandatory by its express terms.” *Id.* at 9. ComicMix relies on following
13 language in *Unicolors* in making this argument:

14 In practice, once a defendant alleges that (1) a plaintiff’s
15 certificate of registration contains inaccurate information; (2)
16 “the inaccurate information was included on the application for
17 copyright registration”; and (3) the inaccurate information was
18 included on the application “with knowledge that it was
19 inaccurate,” a district court is then required to submit a request
20 to the Register of Copyrights “to advise the court whether the
21 inaccurate information, if known, would have caused [it] to
22 refuse registration.” [17 U.S.C.] § 411(b)(1)–(2). In other
23 words, courts may not consider in the first instance whether the
24 Register of Copyrights would have refused registration due to the
25 inclusion of known inaccuracies in a registration application.

26 959 F.3d at 1197. ComicMix further argues that the intent-to-defraud requirement was
27 “unclear” at the time this Court issued its order on the Referral Motion, and that “*Unicolors*
28 further clarifies” this issue. Reconsid. Mot. at 10. ComicMix argues that, “[b]ecause the
Court exercised its discretion rather than first soliciting and obtaining the Register of
Copyrights’ opinion,” the Referral Order must be altered under *Unicolors*. *Id.* at 11.

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1 Seuss argues that *Unicolors* is not an intervening change in controlling law because
2 it “did not disapprove of, much less change, long-standing precedent permitting district
3 courts to weed out meritless 17 U.S.C. § 411(b)(2) motions by initially determining
4 whether an [sic] copyright application actually contains an inaccuracy known to the
5 applicant and denying motions where no such inaccuracy is present.” Reconsid. Opp’n at
6 9. Because this Court followed that long-standing procedure in denying the Referral
7 Motion, reconsideration is not necessary. *Id.* In support of its position, Seuss cites to
8 *Roxana Towry Russell v. Walmart Incorporated*, No. CV 19-5495-MWF (JCX), 2020 WL
9 9073046, at *4 (C.D. Cal. Oct. 16, 2020), a case post-dating *Unicolors* in which “Walmart
10 argued that because it has alleged that Plaintiff submitted inaccurate information in her
11 copyright registration applications, the Court has no discretion to deny its Remand Motion
12 and must refer the matter to the Register of Copyrights,” but the district court disagreed.
13 2020 WL 9073046, at *4. The court noted that “[r]ecent Ninth Circuit case law is
14 consistent with this gatekeeping procedure,” and *Unicolors* only remanded with
15 instructions to submit an inquiry to the Register of Copyrights “after finding that the
16 application contained ‘known inaccuracies.’” *Id.* at *5 (citation omitted).

17 On reply, ComicMix contends that there was no Ninth Circuit law interpreting
18 section 411(b) until *Gold Value* in 2019, which held that a showing of fraud is not required,
19 and that *Unicolors* subsequently made clear that a defendant need only “allege”
20 inaccuracies in the application, not “prove” them. Reconsid. Reply at 4–5 (citations
21 omitted). ComicMix cites to two post-*Unicolors* district court cases for its position:
22 *Yellowcake, Inc. v. Morena Music, Inc.*, No. 1:20-cv-0787 AWI BAM, 2021 WL 795823
23 (E.D. Cal. May 5, 2021); and *Fashion Ave. Sweater Kniths, LLC v. Poof Apparel Corp.*,
24 No. 2:19-cv-06302-CJC-JEM, 2020 WL 7861970 (C.D. Cal. Dec. 3, 2020). *Id.* at 5.

25 **III. Analysis**

26 The Court agrees with Seuss’s interpretation of *Unicolors* and the extent to which it
27 changed—or rather, failed to change—Ninth Circuit law. Although *Unicolors* would have
28 been an intervening change in controlling law were the question of “what it means to

1 publish multiple works as a ‘single unit’” at issue, 959 F.3d at 1199 (footnote omitted)
2 (noting that “this court has never previously addressed [this question]”), there was no
3 change in controlling law with regard to the issues raised by ComicMix, *see Teamsters*
4 *Loc. 617 Pension & Welfare Funds v. Apollo Grp., Inc.*, 282 F.R.D. 216, 224 (D. Ariz.
5 2012) (explaining that, in the context of Rule 59(e), “cases which generally or substantively
6 alter existing law, such as by overruling it, or creating a significant shift in a court’s
7 analysis,” are intervening changes in law warranting relief, whereas “cases which merely
8 confirm, clarify or explain existing case law do not provide a basis for relief”).

9 The section of *Unicolors* ComicMix contends is a change in how courts are required
10 to address section 411(b) requests is nothing more than a brief summary of the already
11 existing law in the Ninth Circuit. Further, *Unicolors* does not itself change the law
12 concerning intent-to-defraud, but merely confirms the prior clarification of the standard
13 contained in *Gold Value*. At any rate, this Court’s Referral Order never addressed the
14 intent-to-defraud issue in light of its finding that there were no known inaccuracies in
15 Seuss’s copyright applications and registrations. *See generally* Referral Order. Thus, the
16 alleged statements of new controlling law cited by ComicMix are merely restatements or
17 clarifications of existing law that neither necessitate nor permit this Court’s revisiting of
18 the Referral Order.

19 The cases on which ComicMix relies on reply are not persuasive in arguing the
20 contrary. In *Yellowcake*, the court cited to the same statement of the legal standard from
21 *Unicolors* on which ComicMix relies, but ultimately the court ended up seeking
22 supplemental briefing on the invalidity issue where the authorship information in judicially
23 noticed registration documents was inconsistent with the ownership interest claimed in a
24 counterclaim, in which case “[t]he Counterclaim therefore indicates that the registrations
25 contain incorrect information in terms of authorship.” 2021 WL 795823, at *19. That the
26 court ordered supplemental briefing, rather than simply accepting the allegation of
27 inaccurate information, supports the view that *Unicolors* does not mandate that a court
28 refer all requests made under section 411(b) to the Register of Copyrights. Indeed, the

1 Court was explicit that, “[i]f, after reviewing the supplemental information, the Court is
2 satisfied that there is inaccurate information that is part of the registrations and that was
3 included in the applications to the Copyright Office, the Court will send an inquiry as
4 required by § 411/*Unicolors*.” *Id.*

5 Similarly, the court in *Fashion Avenue* did not simply accept at face value allegations
6 of inaccurate information in referring a validity issue to the Register of Copyrights. As the
7 earlier decision actually electing to refer the issue to the Register of Copyrights makes
8 clear, both allegations in the complaint and evidence presented by the defendants tended
9 to show that the designs at issue were published before registration, raising a genuine issue
10 as to the copyright’s validity. *See Fashion Ave. Sweater Knits, LLC v. Poof Apparel Corp.*,
11 No. CV1906302CJCJEMX, 2020 WL 7862132, at *3 (C.D. Cal. Oct. 28, 2020). Thus,
12 both *Yellowcake* and *Fashion Avenue* suggest that the district court’s gatekeeping function
13 under section 411(b) remains intact post-*Unicolors*, as the district court in *Russell* explicitly
14 held. Accordingly, the Court **DENIES** ComicMix’s Reconsideration Motion.

15 **SEUSS’S RENEWED MOTION FOR SUMMARY JUDGMENT**

16 **I. Legal Standards**

17 **A. Summary Judgment**

18 Under Federal Rule of Civil Procedure 56(a), a party may move for summary
19 judgment as to a claim or defense or part of a claim or defense. Summary judgment is
20 appropriate where the Court is satisfied that there is “no genuine dispute as to any material
21 fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a);
22 *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). Material facts are those that may affect
23 the outcome of the case. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A
24 genuine dispute of material fact exists only if “the evidence is such that a reasonable jury
25 could return a verdict for the nonmoving party.” *Id.* When the Court considers the
26 evidence presented by the parties, “[t]he evidence of the non-movant is to be believed, and
27 all justifiable inferences are to be drawn in his favor.” *Id.* at 255.

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1 The initial burden of establishing the absence of a genuine issue of material fact falls
2 on the moving party. *Celotex*, 477 U.S. at 323. The moving party may meet this burden
3 by identifying the “portions of ‘the pleadings, depositions, answers to interrogatories, and
4 admissions on file, together with the affidavits, if any,’” that show an absence of dispute
5 regarding a material fact. *Id.* When a plaintiff seeks summary judgment as to an element
6 for which it bears the burden of proof, “it must come forward with evidence which would
7 entitle it to a directed verdict if the evidence went uncontroverted at trial.” *C.A.R. Transp.*
8 *Brokerage Co. v. Darden Rests., Inc.*, 213 F.3d 474, 480 (9th Cir. 2000) (quoting *Houghton*
9 *v. South*, 965 F.2d 1532, 1536 (9th Cir. 1992)).

10 Once the moving party satisfies this initial burden, the nonmoving party must
11 identify specific facts showing that there is a genuine dispute for trial. *Celotex*, 477 U.S.
12 at 324. This requires “more than simply show[ing] that there is some metaphysical doubt
13 as to the material facts.” *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574,
14 586 (1986). Rather, to survive summary judgment, the nonmoving party must “by her own
15 affidavits, or by the ‘depositions, answers to interrogatories, and admissions on file,’
16 designate ‘specific facts’” that would allow a reasonable fact finder to return a verdict for
17 the non-moving party. *Celotex*, 477 U.S. at 324; *Anderson*, 477 U.S. at 248. The non-
18 moving party cannot oppose a properly supported summary judgment motion by “rest[ing]
19 on mere allegations or denials of his pleadings.” *Anderson*, 477 U.S. at 256.

20 ***B. Copyright Infringement***

21 “A plaintiff bringing a claim for copyright infringement must demonstrate ‘(1)
22 ownership of a valid copyright, and (2) copying of constituent elements of the work that
23 are original.’” *Funky Films, Inc. v. Time Warner Entm’t Co., L.P.*, 462 F.3d 1072, 1076
24 (9th Cir. 2006) (quoting *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991)).

25 A “copyright registration creates a presumption of ownership.” *Micro Star v.*
26 *Formgen Inc.*, 154 F.3d 1107, 1110 (9th Cir. 1998) (citing *Triad Sys. Corp. v. Se. Express*
27 *Co.*, 64 F.3d 1330, 1335 (9th Cir. 1995)). “To rebut the presumption [of validity], an
28 infringement defendant must simply offer some evidence or proof to dispute or deny the

1 plaintiff's prima facie case of infringement.” *United Fabrics Int’l, Inc. v. C&J Wear, Inc.*,
2 630 F.3d 1255, 1257 (9th Cir. 2011) (quoting *Lamps Plus, Inc. v. Seattle Lighting Fixture*
3 *Co.*, 345 F.3d 1140, 1144 (9th Cir. 2003)) (internal quotation marks omitted).

4 “The second prong of the infringement analysis contains two separate components:
5 ‘copying’ and ‘unlawful appropriation.’” *Skidmore as Tr. for Randy Craig Wolfe Tr. v.*
6 *Led Zeppelin*, 952 F.3d 1051, 1064 (9th Cir. 2020) (citation omitted). To establish copying,
7 the plaintiff can rely on direct evidence of copying or can show either: “(1) the two works
8 in question are substantially similar and the defendant had access to the subject work; or
9 (2) that the works are strikingly similar.” *Corbello v. Valli*, 974 F.3d 965, 973 (9th Cir.
10 2020) (citation omitted); *Malibu Textiles, Inc. v. Label Lane Int’l, Inc.*, 922 F.3d 946, 952
11 (9th Cir. 2019) (citations omitted). “On the other hand, the hallmark of ‘unlawful
12 appropriation’ is that the works share *substantial* similarities.” *Skidmore*, 952 F.3d at 1064
13 (citing *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2004)) (emphasis in original).

14 “In assessing whether particular works are substantially similar, or strikingly similar,
15 this Circuit applies a two-part analysis: the extrinsic test and the intrinsic test.” *Unicolors,*
16 *Inc. v. Urban Outfitters, Inc.*, 853 F.3d 980, 985 (9th Cir. 2017). “The extrinsic test
17 requires plaintiffs to show overlap of concrete elements based on objective criteria.” *Id.*
18 (internal quotation marks and citations omitted). “The extrinsic test requires a three-step
19 analysis: (1) the plaintiff identifies similarities between the copyrighted work and the
20 accused work; (2) of those similarities, the court disregards any that are based on
21 unprotectable material or authorized use; and (3) the court must determine the scope of
22 protection (“thick” or “thin”) to which the remainder is entitled ‘as a whole.’” *Corbello*,
23 974 F.3d at 974 (citation omitted).

24 “Only if the extrinsic analysis succeeds does the so-called ‘intrinsic’ analysis takes
25 place.” *Id.* (citation omitted). “[T]he intrinsic test is subjective and asks whether the
26 ordinary, reasonable person would find the total concept and feel of the works to be
27 substantially similar.” *Urban Outfitters*, 853 F.3d at 985 (internal quotation marks and
28 citations omitted). When it comes to applying the intrinsic test, “a district court may grant

1 summary judgment for plaintiffs on the issue of copying when the works are so
2 overwhelmingly similar that the possibility of independent creation is precluded.” *Id.* at
3 987.

4 **II. Analysis**

5 **A. Summary of the Parties’ Positions**

6 Seuss seeks summary judgment of willful copyright infringement against ComicMix
7 and an award of heightened statutory damages. MSJ at 7. As to the first element of
8 copyright infringement, Seuss argues that the Court previously determined that Seuss’s
9 copyright registrations were valid, and ComicMix did not cross-appeal that decision;
10 accordingly, ComicMix cannot now attack the validity of Seuss’s copyrights. *Id.* at 8. As
11 to the second element, Seuss claims that ComicMix “did not deny” that *Boldly!* copied
12 directly and extensively from the copyrighted works in question and is substantially similar
13 to protected elements in those works; rather, “[ComicMix] argued only that their extensive
14 copying was fair use and therefore not infringing.” *Id.* (citing ECF No. 120 at 15–25).
15 Given that the Ninth Circuit’s opinion eliminated the issue of fair use, no other defenses
16 remain. *Id.* Seuss further argues that the Ninth Circuit’s ruling, which found substantial
17 and significant copying, requires the Court to find that substantial similarity has been
18 established as a matter of law. *Id.* at 8–9. Seuss further claims that the undisputed evidence
19 establishes that ComicMix acted with at least reckless disregard to *Boldly!*’s infringement,
20 and therefore the Court should find ComicMix’s infringement willful. *Id.* at 9–15. Seuss
21 argues that increased statutory damages of \$75,000 per work is appropriate as a result. *Id.*
22 at 15–20.

23 ComicMix opposes, claiming that its pleaded defenses of invalidity as to the
24 copyrights for *Go!* and *Sneetches* and *de minimis* use as to *Sneetches* and *Grinch* require
25 denial of Seuss’s MSJ. MSJ Opp’n at 3. ComicMix reiterates the arguments made in its
26 Reconsideration Motion in arguing that the copyright registrations at issue are invalid, thus
27 requiring referral to the Register of Copyrights before the merits of the claims related to
28 *Go!* and *Sneetches* can be resolved. *Id.* at 4–5. ComicMix further argues that Seuss fails

1 to meet its burden to establish that *Boldly!* is substantially similar to each of the
2 Copyrighted Works, arguing that *Boldly!*'s use of only two illustrations from *Sneetches*
3 and one from *Grinch*, without copying any text from either book, is *de minimis*. *Id.* at 5–
4 9. ComicMix argues that, because each Copyrighted Work is subject to a viable defense,
5 assessing damages at this point is premature. *Id.* at 9. To the extent the Court finds
6 otherwise, ComicMix argues that Seuss fails to meet its burden of proving willfulness and
7 that factual disputes preclude summary judgment. *Id.* at 9–15. Should the Court reach the
8 issue of damages, ComicMix urges the Court to find that any infringement was innocent,
9 *id.* at 15–16, and to award only the statutory minimum in damages, *id.* at 16–18.

10 On reply, Seuss argues that ComicMix's *de minimis* use defense was abandoned by
11 ComicMix's failure to raise it at summary judgment; at summary judgment, ComicMix
12 instead contradicted its *de minimis* use defense by conceding that there could not be fair
13 use unless there was a substantial use. MSJ Reply at 2–3 (citations omitted). Further,
14 Seuss claims that “the Ninth Circuit’s findings that Defendants’ takings of copyrighted
15 material were substantial are incorporated in its mandate and foreclose any argument that
16 Defendants’ infringement of *Sneetches* and *Grinch* was *de minimis*” under the “spirit of the
17 mandate.” *Id.* at 3–4 (citing *United States v. Montgomery*, 462 F.3d 1067, 1072 (9th Cir.
18 2006)). Even if the Court were to consider the defense, Seuss claims it lacks merit, as “[a]n
19 average viewer undoubtedly would recognize the appropriation.” *Id.* at 4. Seuss further
20 urges that ComicMix's infringement is clearly willful. First, given that the Copyrighted
21 Works carry clear copyright notices, Seuss argues that ComicMix is precluded from
22 claiming innocent infringement. *Id.* at 6 (citation omitted). Further, Seuss claims that the
23 evidence clearly establishes “[ComicMix's] reckless conduct,” *id.* at 7, and ComicMix's
24 failure to seek legal counsel, while “highly probative of willfulness,” “is only one of many
25 indications of willful conduct,” *id.* at 8. Finally, Seuss concedes to a jury trial on the
26 amount of statutory damages to be awarded. *Id.* at 10.

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1 **B. Copyright Infringement**

2 As to the issue of ownership of valid copyrights, Seuss has submitted copies of the
3 copyright registrations for each of the Copyrighted Works as well as the documentation
4 establishing the assignment of the relevant copyrights to Seuss. *See* Declaration of Susan
5 Brandt in Support of Pl.’s MSJ (“Brandt Decl.”) Exs. 1–18, ECF Nos. 107-4–21.
6 Accordingly, “Plaintiff has ‘shift[ed] to defendant the burden to prove the invalidity of the
7 copyright[.]’” *L.A. Printex Indus., Inc. v. Lia Lee, Inc.*, No. CV 08-1836ODW(PJWX),
8 2009 WL 789877, at *3 (C.D. Cal. Mar. 23, 2009) (quoting *Entm’t Research Grp. v.*
9 *Genesis Creative Grp., Inc.*, 122 F.3d 1211, 1217 (9th Cir. 1997)). ComicMix, however,
10 has failed to carry its burden. Although ComicMix argues that the copyright registrations
11 for *Sneetches* and *Go!* are invalid, and therefore fail to satisfy the Copyright Act’s
12 registration requirement, due to the inclusion of knowingly inaccurate information in the
13 copyright applications, *see generally* Reconsid. Mot., for the reasons provided *supra* at 5–
14 11, the Court declines to revisit this issue. Thus, “the presumption of validity afforded to
15 [Seuss]’s copyright certificates remains intact,” and “[Seuss] is therefore deemed to own
16 valid copyrights in the designs at issue.” *L.A. Printex Indus., Inc.*, 2009 WL 789877, at *3.

17 As to the issue of copying, Plaintiffs have introduced evidence of direct copying of
18 each of the Copyrighted Works. Specifically, Mr. Hauman sent Mr. Gerrold the text and a
19 PDF scan of *Go!*, Duvdevani Decl. Ex. 2, ECF No. 107-24, at 90:8–95:30, and Mr. Gerrold
20 acknowledged that he had a copy of *Go!* that he “flipped through . . . to see what the style
21 of the mood was” “[s]omewhere in the process of writing the verses” of *Boldly!*, *id.* at
22 89:20–90:7. Similarly, Mr. Templeton testified that he had a copy of *Go!* in front of him
23 from which he copied while working on the illustrations for *Boldly!*, including *Boldly!*’s
24 cover and many pages throughout the book. *See, e.g.*, Duvdevani Decl. Ex. 1, ECF No.
25 107-23, at 110:2–12, 123:9–124:11, 125:10–126:1, 133:20–134:18, 141:10–144:7,
26 146:12–25, 150:24–152:2, 152:23–154:7, 155:23–157:25, 161:17–165:12, 173:9–174:7,
27 175:24–176:24; *compare* Duvdevani Decl. Ex. 9, ECF No. 115-3, at 240–41, 243, 245–46,
28 248, 251–53, 255, 257–58, *with* Duvdevani Decl. Ex. 31, ECF No. 115-11, at 452–53, 455,

1 457, 459, 461–62, 464–66, 469–70. Mr. Templeton admitted that he “painstakingly”
2 copied from page 11 of *Sneetches* when illustrating a page of *Boldly!*, from the shape of
3 and crosshatching and lettering on the machine to the poses of the characters. Duvdevani
4 Decl. Ex. 1 at 166:13–170:13; *compare* Duvdevani Decl. Ex. 11, ECF No. 115-5, at 303,
5 *with* Duvdevani Decl. Ex. 31 at 467. For one page of *Boldly!*, Mr. Templeton explained
6 that “the characters from the Star Trek universe are posed in the positions that the Whos
7 from Whoville are posed in *How the Grinch Stole Christmas*” and “there is a set of red
8 lines emanating from above them that are meant to feel similar to the red lines in the
9 drawing” from *Grinch*. Duvdevani Decl. Ex. 1 at 137:19–138:3; *compare* Duvdevani Decl.
10 Ex. 10, ECF No. 115-4, at 273, *with* Duvdevani Decl. Ex. 31 at 456. Indeed, the Ninth
11 Circuit’s Opinion notes that “ComicMix does not dispute that it tried to copy portions of
12 *Go!* as accurately as possible.” 983 F.3d at 450. Given this evidence, it is clear that
13 Defendants directly copied protected elements from Plaintiff’s copyrighted works. *See,*
14 *e.g., Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 924 F. Supp. 1559, 1564–65
15 (S.D. Cal. 1996), *aff’d*, 109 F.3d 1394 (9th Cir. 1997) (finding admissions that illustrations
16 “were inspired by” and text “dr[awn] from” copyrighted texts “probably sufficient to
17 permit a jury finding that protected elements of Dr. Seuss’s text and illustrations found in
18 Penguin’s book got there through copying and not coincidence”) (footnote omitted).

19 The Court therefore turns to the question of unlawful appropriation—in other words,
20 whether *Boldly!* and the Copyrighted Works share “substantial similarities.” As an initial
21 matter, the Court notes that it is somewhat rare for the plaintiff copyright holder
22 affirmatively to move for summary judgment of infringement and for such a motion to be
23 granted. The Ninth Circuit has held that “a district court may grant summary judgment for
24 plaintiffs on the issue of copying when the works are so overwhelmingly similar that the
25 possibility of independent creation is precluded.” *Urban Outfitters*, 853 F.3d at 987.
26 However, historically, the cases in which such “overwhelming similarity” has been found
27 are exceedingly limited.

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1 *Urban Outfitters*, for instance, involved textile designs that were “nearly identical.”
2 *Id.* at 985–87. So, too, with *Neman Brothers & Associates, Inc. v. One Step Up Limited*,
3 No. CV184297DMGAGR, 2019 WL 8129616, at *10 (C.D. Cal. Nov. 25, 2019);
4 *Texkhan, Incorporated v. One Step Up, Limited*, No. CV 16-606 DMG (FFMX), 2017 WL
5 8231368, at *6 (C.D. Cal. July 19, 2017); *Gracing Incorporated v. E.K. Blue, Incorporated*,
6 No. CV 16-5107 MWF (SS), 2017 WL 5640516, at *2–3 (C.D. Cal. June 28, 2017); and
7 *Spectravest, Incorporated v. Mervyn’s Incorporated*, 673 F. Supp. 1486, 1491–92 (N.D.
8 Cal. 1987), all dealing with fabric or apparel designs that were overwhelmingly similar
9 with “minimal” differences. In *Marcus v. Rowley*, the Ninth Circuit reversed a district
10 court’s determination of fair use and ordered entry of summary judgment in favor of the
11 plaintiff with regard to a copyrighted booklet about cake design where “[d]efendant’s
12 [infringing work] could have been a photocopy of plaintiff’s booklet but for the fact that
13 defendant retyped plaintiff’s material.” 695 F.2d 1171, 1177–79 (9th Cir. 1983). In so
14 doing, the Ninth Circuit concluded that “[t]his case presents a clear example of both
15 substantial quantitative and qualitative copying.” *Id.* at 1177. And, in *Applied Business*
16 *Software, Incorporated v. Citadel Servicing Corporation*, No. SACV1701627CJCJDEX,
17 2019 WL 1949455, at *11 (C.D. Cal. Mar. 26, 2019), the district court granted partial
18 summary judgment on the issue of copyright infringement and found the copying in
19 question “substantial” where the defendant copied the entirety of the copyrighted program
20 onto more than twenty computers in contravention of the explicit terms of a license
21 agreement. Accordingly, as summarized by one commentator:

22 A plaintiff seeking summary judgment for substantial similarity
23 will have to show, in most cases, that the defendant’s work is
24 nearly identical to his or that some unusual circumstance
25 conclusively demonstrates copying. Summary judgment is
26 infrequently granted to plaintiffs on this issue. Most cases
27 involve non-literary works: toys, cartoon characters, wall
28 plaques, video games, maps, fabrics, designs on clothing,
magazine covers, auto parts containers, photographs, and
computer software. In each instance, the defendant had either
substantially appropriated the plaintiff’s work or had reproduced

1 it with minor alterations, such as the removal of the plaintiff's
2 name and copyright notice.

3 Julie J. Bisceglia, *Summary Judgment on Substantial Similarity in Copyright Actions*, 16
4 Hastings Comm. & Ent L.J. 51, 56–57 (1993) (footnotes omitted).

5 1. *Objective Extrinsic Test (Overlap of Concrete Elements)*

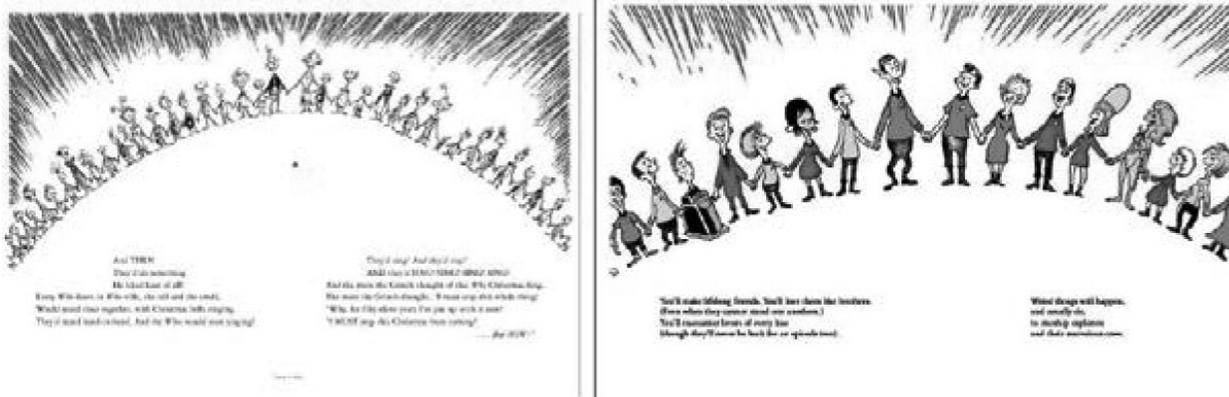
6 As noted above, “[t]he extrinsic test requires a three-step analysis: (1) the plaintiff
7 identifies similarities between the copyrighted work and the accused work; (2) of those
8 similarities, the court disregards any that are based on unprotectable material or authorized
9 use; and (3) the court must determine the scope of protection (‘thick’ or ‘thin’) to which
10 the remainder is entitled ‘as a whole.’” *Corbello*, 974 F.3d at 974 (citation omitted).

11 Here, the Ninth Circuit’s opinion remanding this action was clear that “[t]he issue in
12 this appeal is not whether *Boldly!* infringed [the Copyrighted Works], but whether *Boldly!*
13 was a fair use of [the Copyrighted Works].” 983 F.3d at 450 (footnote omitted). Although
14 the Ninth Circuit’s analysis did not directly address infringement, portions of the Ninth
15 Circuit’s opinion make clear that, extrinsically, *Boldly!* overlaps concrete elements in the
16 Copyrighted Works, particularly in its exacting replication of iconic illustrations from each
17 of the Copyrighted Works.

18 In total, the Ninth Circuit noted that “[ComicMix] copied ‘14 of *Go!*’s 24 pages,’
19 close to 60% of the book, and significant ‘illustrations from *Grinch* and two stories in
20 *Sneetches*,” rendering ComicMix’s copying “considerable.” *Id.* at 456. The Ninth Circuit
21 noted that, “[c]rucially, ComicMix did not merely take a set of unprotectable visual units,
22 a shape here and a color patch there.” *Id.* (footnote omitted). Rather, “[f]or each of the
23 highly imaginative illustrations copied by ComicMix, it replicated, as much and as closely
24 as possible . . . , the exact composition, the particular arrangements of visual components,
25 and the swatches of well-known illustrations.” *Id.*

26 For example, with regard to *Boldly!*’s depiction of “*Grinch*’s iconic finale scene,”
27 the Ninth Circuit noted that “ComicMix captured the placements and poses of the
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1 characters, as well as every red hatch mark arching over the handholding characters,”
2 simply “plugg[ing] in the *Star Trek* characters.” *Id.* at 454.

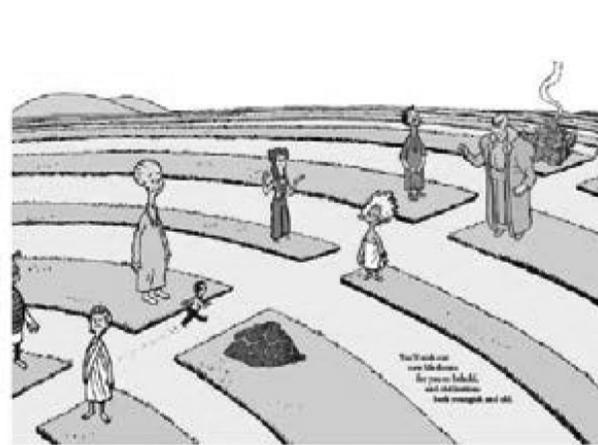
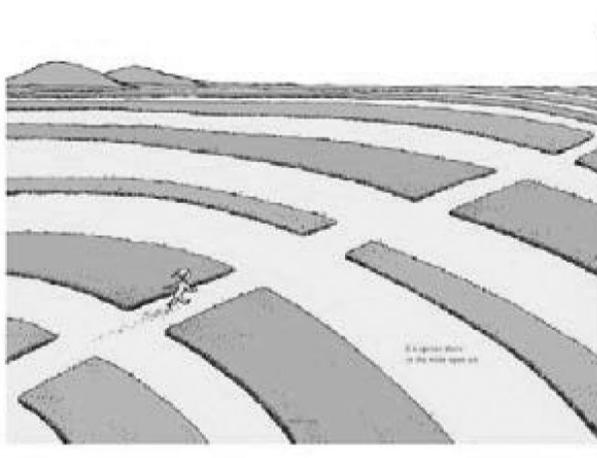


10 *Id.* Likewise, “ComicMix copied the exact composition of the famous ‘waiting place’ in
11 *Go!*, down to the placements of the couch and the fishing spot,” simply “add[ing] *Star Trek*
12 characters who line up, sit on the couch, and fish exactly like the waiting place visitors they
13 replaced.” *Id.*



21 *Id.* at 455. The Ninth Circuit noted that *Boldly!* also “replicated the overall composition
22 and placement of the shapes, colors and detailed linework” of the following illustration
23 from *Go!*:

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9 *Id.* at 457. Similarly, “ComicMix also took the overall composition of [the following]
10 Seuss illustration [from *Go!*]—the placement of the tree, the hills, and the white space
11 surrounding these elements,” even giving “[t]he tress in both versions . . . the same exact
12 number, bends, and lengths of branches, with the same branch in both versions hoisting a
13 dangling figure”:



21 *Id.*

22 As to *Sneetches*, the Ninth Circuit noted that one of *Boldly!*'s illustrations “copie[s]
23 a scene . . . down to the exact shape of the sandy hills in the background and the placement
24 of footprints that collide in the middle of the page. Seussian characters were replaced with
25 Spocks playing chess, making sure they ‘ha[d] similar poses’ as the original, but all
26 ComicMix really added was ‘the background of a weird basketball court.’” *Id.* at 455.

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8 *Id.* Further, the Ninth Circuit noted that the plot, character, and moral of *Sneetches* “center
 9 on a highly imaginative and intricately drawn machine that can take the star-shaped status
 10 symbol on and off the bellies of the Sneetches,” with “[d]ifferent iterations of the machine,
 11 the heart of *Sneetches*, appear[ing] in ten out of twenty-two pages of the book.” *Id.* at 457
 12 (citation omitted). The Ninth Circuit concluded that, in “repurpos[ing]” the machine from
 13 *Sneetches* “painstakingly,” “ComicMix took this ‘highly expressive core’ of *Sneetches*.”
 14 *Id.* And not only was *Boldly!*’s representation of the machines “identical,” *id.* at 457–58,
 15 ComicMix also “took ‘the poses that the Sneetches are in’ so that ‘[t]he poses of
 16 commander Scott and the Enterprise crew getting into the machine are similar.’ *Boldly*
 17 also captured the particular ‘crosshatch’ in how Dr. Seuss rendered the machine, the ‘puffs
 18 of smoke coming out of the machine,’ and the ‘entire layout.’” *Id.* at 458.



27 *Id.*
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1 Accordingly, Seuss, and the Ninth Circuit, clearly have identified similarities
2 between each Copyrighted Work and *Boldly!* based on protectable material. Further, the
3 scope of protection to which the Copyrighted Works, all of which are illustrated books, are
4 entitled is broad. *See, e.g., Fleener v. Trinity Broad. Network*, 203 F. Supp. 2d 1142, 1149
5 (C.D. Cal. 2001) (“Capable of infinite expression, [books] are accorded ‘thick’ copyright
6 protection.”) (citation omitted); *Mod. Dog Design Co. v. Target Corp.*, No. C11-1816 TSZ,
7 2013 WL 12315516, at *3 (W.D. Wash. Aug. 23, 2013) (finding level of copyright
8 protection afforded to stylized “headshot” drawings of dogs broad); *Kevin Barry Fine Art*
9 *Assocs. v. Ken Gangbar Studio, Inc.*, 391 F. Supp. 3d 959, 967 (N.D. Cal. 2019) (finding
10 copyright protection of three-dimensional wall sculpture broad where “‘there [wa]s a wide
11 range of expression for selecting, coordinating, and arranging’ the constituent elements”).
12 Accordingly, the Court finds that concrete, protectible elements of Seuss’s Copyrighted
13 Works entitled to broad protection overlap with *Boldly!*, thus satisfying the extrinsic test.

14 2. *Subjective Intrinsic Test (Substantial Similarity: Total Concept & Feel)*

15 As to the intrinsic test, in light of the rarity of courts granting summary judgment in
16 favor of copyright holders on the issue of copying in this Circuit—*see supra* at 17–19—
17 and the lack of any authorities doing so with regard to subject matter comparable to that at
18 issue here—*i.e.*, illustrated books of rhyming prose—the Court finds, on the record
19 presently before it and viewing the facts and evidence in the light most favorable to
20 ComicMix as the nonmovant, that *Boldly!* “[is] not so similar to the protected [works] that
21 no triable issue exists with respect to whether the total concept and feel of the works are
22 substantially similar. Therefore, the issue of intrinsic similarity must be left for the jury.”
23 *HIT Ent., Inc. v. Nat’l Disc. Costume Co.*, 552 F. Supp. 2d 1099, 1107 (S.D. Cal. 2008).
24 Accordingly, the Court **DENIES** Seuss’s Motion for Summary Judgment.

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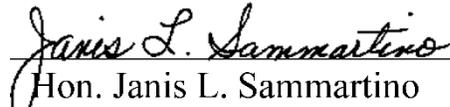
1 In light of the foregoing, the Court finds it unnecessary to rule at this time on the
2 ComicMix’s de minimis use argument.² See MSJ Opp’n at 6. Similarly, because the Court
3 cannot decide the issue of liability for copyright infringement as a matter of law, the Court
4 declines to address the issue of willfulness, see, e.g., *Classical Silk, Inc. v. Dolan Grp.,*
5 *Inc.*, No. CV1409224ABMRWX, 2016 WL 7638113, at *11 (C.D. Cal. Feb. 2, 2016)
6 (citations omitted) (declining to address issue of willfulness on summary judgment where
7 issues of fact precluded summary judgment of infringement), or reach the matter of
8 damages.

9 **CONCLUSION**

10 For the foregoing reasons, the Court **DENIES** ComicMix’s Motion for
11 Reconsideration (ECF No. 177) and **DENIES** Plaintiff’s Renewed Motion for Summary
12 Judgment (ECF No. 176).

13 **IT IS SO ORDERED.**

14 Dated: August 9, 2021


15 Hon. Janis L. Sammartino
16 United States District Judge
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21 ² “The Ninth Circuit has been unclear about whether the de minimis use doctrine serves as an affirmative
22 defense under the Copyright Act’s fair use exceptions or whether the doctrine merely highlights plaintiffs’
23 obligation to show that ‘the use must be significant enough to constitute infringement.’” *Brocade*
24 *Commc’ns Sys., Inc. v. A10 Networks, Inc.*, No. C 10-3428 PSG, 2013 WL 831528, at *8 (N.D. Cal. Jan.
25 10, 2013). The Ninth Circuit has stated, for instance, that “[t]o say that a use is de minimis because no
26 audience would recognize the appropriation is thus to say that the use is not sufficiently significant” to
27 meet the “substantial similarity” requirement for infringement. *Newton v. Diamond*, 388 F.3d 1189, 1193
28 (9th Cir. 2004). Either way, “the *de minimis* use doctrine is either subsumed into the affirmative defense
of fair use or into negating Plaintiff’s prima facie case of copyright infringement.” *Amini Innovation*
Corp. v. McFerran Home Furnishings Inc., No. CV 13-6496 RSWL SSX, 2014 WL 360048, at *4 (C.D.
Cal. Jan. 31, 2014). If the former, the issue of fair use is no longer before the Court in light of the Ninth
Circuit’s ruling, and the de minimis use defense is therefore also foreclosed. If the latter, the matter would
appear to still be in play, but subsumed in the “substantial similarity” analysis *supra*.