Dr. Seuss / Star Trek Mashup Case Heads to Trial After Fair Use Roller Coaster Ride

By Jeremy S. Goldman

A made-for-law-school copyright case involving a *Dr. Seuss* / *Star Trek* mashup is heading for trial. On August 9, 2021, U.S. District Judge Janis Sammartino denied a motion for summary judgment brought by the plaintiff, Dr. Seuss Enterprises, leaving it to a jury to decide whether ComicMix's unpublished book – *Oh, the Places You'll Boldly Go!* – infringes the copyrights in Dr. Seuss' famous children's books. The case not only raises terrific questions of fair use and substantial similarity under copyright law, but also features a roller coaster ride at the district court and a battle royale with the Ninth Circuit over fair use.

Oh, the Places You'll Boldly Go! (or Not)

Dr. Seuss Enterprises owns the copyrights in the works of Theodor S. Geisel a/k/a Dr. Seuss, the author and illustrator of *Oh, the Places You'll Go!*, *How the Grinch Stole Christmas!*, and *The Sneetches and Other Stories*, among many other works. In 2016, ComicMix launched a Kickstarter campaign to fund the publication of *Oh, the Places You'll Boldy Go!*, an illustrated book that combines aspects of Dr. Seuss' books with characters, imagery and other elements of *Star Trek*. ComicMix described the book as a "parody" that "fully falls within the boundary of fair use," but acknowledged that they "may have to spend time and money proving it to people in black robes." Indeed!

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Fair Use Roller Coaster Ride at the District Court

On November 11, 2016, Dr. Seuss sued ComicMix and its principals for copyright infringement, trademark infringement and unfair competition in the U.S. District Court for the Southern District of California. This article focuses only on the copyright claim. On June 9, 2017, the court ***denied*** ComicMix's motion to dismiss, holding that "the Court cannot say as a matter of law that Defendants' use of Plaintiff's copyrighted material was fair." Dr. Seuss filed an amended complaint, ComicMix again moved to dismiss, and the court again ***denied*** it, doubling down on its prior fair use ruling. After discovery, the parties cross moved for summary judgment. This time, on March 12, 2019, the court ***granted*** ComicMix's motion, holding that *Boldly* was fair use as a matter of law. The court concluded that, because "*Boldly* is highly transformative," ComicMix "took no more than was necessary for their purposes," and the harm to Dr. Seuss' market was "speculative," the four fair use factors of Section 107 of the Copyright Act favored ComicMix.

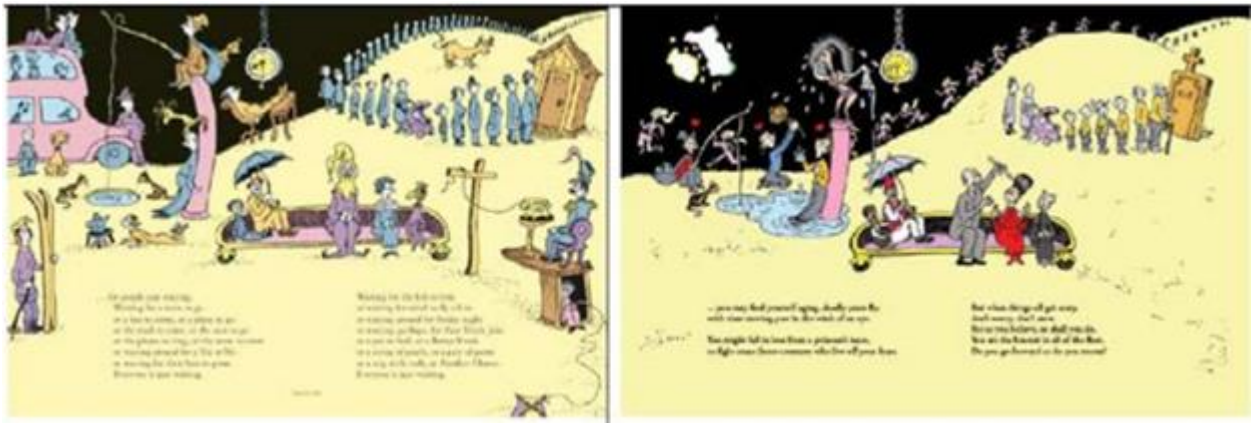
The Ninth Circuit Drops the Hammer on Fair Use

On December 18, 2020, the U.S. Court of Appeals for the Ninth Circuit *reversed* the district court's fair use decision. Judge McKeown, writing for the 3-judge panel, held that it wasn't even a close call, completely disregarding Judge Sammartino's opinion reaching the opposite conclusion. Seriously, the appellate court did not make a single reference to the decision it was reversing.

The opinion provides a bread-and-butter application of the four fair use factors, concluding that all of them weighed "decisively" against a finding of fair use. Not surprisingly, the most interesting part of the decision is the discussion of whether the mash-up is "transformative" under the standard set by the U.S. Supreme Court in *Campbell v. Acuff-Rose*. The court was not persuaded that the "extensive new content" created by the work is enough, holding that "the addition of new expression to an existing work is not a get-out-of-jail-free card that renders the use of the original transformative." Rather than parodying, commenting on, or shedding new light on Dr. Seuss's original, *Boldly!* merely "repackaged" *Go!* "into a new format, carrying the story of the [*Star Trek*] Enterprise crew's journey through a strange star in a story shell already intricately illustrated by Dr. Seuss."

The court juxtaposed several examples in its opinion, including:

And:



And:

District Court Sends the Case to the Jury Anyway

Critically, the Ninth Circuit's decision was on defendant ComicMix's motion for summary judgment. Thus, the appellate court was only telling the district court that it should not have knocked out Dr. Seuss's claim on fair use grounds at the summary judgment stage. The Ninth Circuit did ***not*** hold that *Boldly!* infringed Dr. Seuss's copyright as a matter of law.

Emboldened, however, by the Ninth Circuit's ruling, Dr. Seuss moved for summary judgment on its claim for copyright infringement, arguing that "the Ninth Circuit's ruling, which found substantial and significant copying, ***requires*** the Court to find that substantial similarity has been established as a matter of law."

On August 9, 2021, the court denied Dr. Seuss's motion. The court first noted that "it is somewhat rare for the plaintiff copyright holder affirmatively to move for summary judgment of infringement and for such a motion to be granted." Historically, courts have only done so in in cases involving "overwhelming similarity."

The court then applied the Ninth Circuit's 2-part test for substantial similarity. As to the "objective extrinsic test," which compares the "overlap of concrete elements," the court acknowledged that "portions of the Ninth Circuit's opinion make clear that, extrinsically, *Boldly!* overlaps concrete elements in the Copyrighted Works, particularly in its exacting replication of iconic illustrations from each of the Copyrighted Works."

The court then proceeded to the "subjective intrinsic test," which examines the "total concept & feel" of the two works.

And then, TWIST!

In a two-sentence analysis, the court determined that, while the works have a significant amount of overlap of concrete, protectable elements, *Boldly* "is not so similar to the protected works that no triable issue exists with respect to whether the total concept and feel of the works are substantially similar. Therefore, the issue of intrinsic similarity must be left for the jury."

Given Judge Sammartino's ruling that *Boldy!* was fair use as a matter of law, perhaps it's not all that surprising that she wasn't willing to hand Dr. Seuss a victory "on the papers." Though the district court is bound by the Ninth Circuit's ruling on fair use, Judge Sammartino is going to make a jury take the final step of deciding whether the work is infringing.

Jeremy S. Goldman is a partner at Frankfurt Kurnit Klein + Selz PC.

Dr. Seuss Enterprises is represented by Stanley J. Panikowski, Andrew L. Deutsch,Tamar Y. Duvdevani and Marc E. Miller, of DLA Piper LLP (US). ComicMix is represented by Dan Booth, Dan Booth Law LLC, and Sprinkle Lloyd & Licari.