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Mash-Up Decision Illuminates Copyright and Trademark Divide

By Jonathan Jennings

“ THE COURT WAS CAREFUL TO NOTE THAT MASH-UPS, AS A FORMAT, MAY BE SUFFICIENTLY TRANSFORMATIVE, BUT THIS ONE WAS NOT. ”

On December 18, 2020, the Ninth Circuit issued an opinion concerning the copyright and trademark implications of an unpublished “mash-up” book entitled “Oh, the Places You’ll Boldly Go!” It combined elements of the Star Trek television show with content from Dr. Seuss’s book “Oh, the Places You’ll Go!” and two other books by Seuss (the late Theodor Geisel). *Dr. Seuss Enterprises, L.P. v. ComicMix LLC*, 983 F.3d 443 (9th Cir. 2020). In a summary judgment ruling, the lower court had found fair use under copyright law, and no actionable trademark claim. On appeal, law professors filed amici briefs on both sides of the fair use question.



The Ninth Circuit first noted that the mash-up borrowed “liberally—graphically and otherwise” from “Oh, the Places You’ll Go!,” as well as from “How the Grinch Stole Christmas!” and “The Sneetches and Other Stories, and that it used “Captain Kirk and his spaceship Enterprise to tell readers that ‘life is an adventure but it will be tough.’” One of the mash-up creators had been a writer of Star Trek episodes, but Star Trek IP was not at issue in this case.

The court balanced the four non-exclusive statutory copyright fair-use factors (17 U.S.C. § 107(1)–(4)):

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

On the first factor, the court described the book as a non-transformative repackaging of Seuss Enterprises's (Seuss's) works. It found no parody--the mash-up authors merely thought it was funny to incorporate Star Trek characters into Seuss story lines, and did not hold the Seuss works up to ridicule; this was insufficient to constitute transformative use under existing precedent, citing *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997). The court was careful to note that mash-ups, as a format, may be sufficiently transformative, but this one was not.

On the second factor, the creative nature of the copyrighted Seuss works weighed against a finding of fair use. Third, on the quantity and substantiality of the copyrighted work that was used, the court found the mash-up included 60% of "Oh, the Places You'll Go!," and significant parts of the two other works—essentially the "heart" of Seuss's works. This also disfavored a finding of fair use.

On the fourth factor, the accused book's impact on the potential market for the plaintiff's work, the Ninth Circuit rejected the lower court's placement of the burden of proof on Seuss to show market harm, and reiterated that fair use was an affirmative defense. Therefore, the burden of persuasion on this factor fell upon ComicMix. The plan to target the school graduation gifts market, where "Oh, the Places You'll Go!" was already a top seller, undercut ComicMix's position that there would be no market impact. Also, Seuss already had authorized collaborations with others, such as The Jim Henson Company, and so the mash-up would have an impact on the market for licensing future derivative works. Even if there had not been an authorized mash-up to date, the court underscored that Seuss had the right to decide if it wanted a mash-up of its works, and ComicMix never asked Seuss for a license.

Ultimately, the court reversed the lower court's finding of copyright fair use and then turned to the question of whether there was an actionable claim under Lanham Act for using the unauthorized title "Oh, the Places You'll Boldly Go!" as well as the Seussian font and style of illustration.

“ THE TRADEMARK RULING WAS A HOLLOW VICTORY TO COMICMIX... ”

In applying the *Rogers* test, the court analyzed whether the artistic relevance of the accused work was "above zero," and if the use of the title and other elements were explicitly misleading. *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). With such a low bar, the court easily found there indeed was sufficient artistic relevance. It then turned to the issue of whether the use of the title and other elements were misleading as to source in light of the following:

- (1) the title merely added the word "boldly" to a famous title;
- (2) the cover uses the "Seussian font;"
- (3) the entire work displays the "Seussian style of illustrations;" and
- (4) the cover "conspicuously" listed the mash-up authors and incorporated a disclaimer that it is "not associated with or endorsed by" Seuss.

Despite a survey purportedly showing some confusion, the court discounted its import because *Rogers* drew the balance in favor of artistic expression and therefore tolerated the "slight risk" that some people may think there is an endorsement. Thus, the Ninth Circuit upheld the lower court's determination that there was no actionable trademark claim.

The trademark ruling was a hollow victory to ComicMix in light of the copyright decision. The low bar required for artistic relevance under *Rogers* presents an interesting contrast to the application of the transformative use test in the copyright fair-use analysis. There are limits to fair use presented here that some will not favor, and undoubtedly not all courts may follow the Ninth Circuit's approach, but the decision provides a path for the creators of future mash-ups to minimize their exposure to IP liability. ■

*firm*UPDATE

APPOINTMENTS



■ Phillip Barengolts

Phil has been re-appointed to the U.S. Subcommittee of the INTA Legislation Committee for 2021-2022.



■ Jessica Ekhoﬀ

Jessica has been elected to the Coalition of Women's Initiatives' Board of Directors for 2021-2022.



■ Bradley Cohn

Bradley has been elected Treasurer of the Illinois Institute of Continuing Legal Education for 2021.

PRESENTATIONS

■ Belinda Scrimenti

As Co-Chair of the DC Bar IP Community, Belinda organized and hosted on December 7, the virtual DC Bar IP Community Champion of Intellectual Property Award and Pro Bono Benefit Reception. The honoree of this annual award was Retired Chief Judge of the Federal Circuit Court of Appeals Paul R. Michel. A special honor was presented in memory of the late Donald R. Dunner, a legendary patent lawyer and supporter of the DC Bar Pro Bono Center.

PUBLICATIONS

■ Jonathan Jennings

The December 2020 issue of *Law Lore & Practice*, a periodical of the Pharmaceutical Trade Marks Group (PTMG), published Jonathan's "U.S. Update" article on a recent TTAB decision outlining trademark assignment pitfalls.

*firm*NOTEWORTHY

2021 INTA Saul Lefkowitz Moot Court Competition

On February 6, **Jonathan Jennings** and **Janet Marvel** will judge oral argument for INTA's Saul Lefkowitz Moot Court Competition (Midwest Region).

Illinois Super Lawyers 2021

Brett August, Phillip Barengolts, Ashly Boesche, Thad Chaloeintiarana, Bradley Cohn, David Hilliard, Jonathan Jennings, Janet Marvel, Robert Sacoff, Belinda Scrimenti and **Joseph Welch II** have been designated Illinois Super Lawyers, and **Jessica Ekhoﬀ** has been designated an Illinois Rising Star.

Law Lore & Practice

Jonathan Jennings was featured in the profile section of the December 2020 issue of *Law Lore & Practice*.

Leading Lawyers

Brett August, Thad Chaloeintiarana, Bradley Cohn, David Hilliard, Jonathan Jennings, Robert Sacoff and **Joseph Welch II** have been selected as Illinois "Leading Lawyers" for 2021.

U.S. News – Best Lawyers "Best Law Firms" 2021

Pattishall McAuliffe has been designated a National Tier 1 Trademark Law Firm, and a Chicago Tier 1 Intellectual Property Litigation and Trademark Law Firm.



World Intellectual Property Review (WIPR)

David Hilliard has been selected as an outstanding IP Practitioner for 2021.