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Dr. Seuss Enterprises v. ComicMix: Insufficient Facts About Mashups Invite Danger

by Elizabeth Brannen and Hanna Chandoo

In the immortal words of Mr. Spock, "insufficient facts always invite danger." Star Trek, Season 1, Episode 24 ("Space Seed," 1968). A recent Ninth Circuit decision, *Dr. Seuss Enterprises, L.P. v. ComicMix LLC*, 983 F.3d 443 (9th Cir. 2020), illustrates that this is true of mashups—artistic works created by combining elements from two or more sources. The case involves an unpublished mashup book called *Oh, the Places You'll Boldly Go!* ("*Boldly*"). In *Boldly*, Captain Kirk and the *Enterprise* crew journey through a bright and colorful landscape of candy-striped halls, quilted meadows, and "Boom Bands" concert venues borrowed from classic Dr. Seuss books, including *Oh, the Places You'll Go!* ("*Go!*"), which is especially popular during graduation season.

Boldly's Trekkie creators at ComicMix did not obtain a license from Dr. Seuss Enterprises ("Seuss"), which owns the intellectual property in Dr. Seuss's works and extensively licenses and oversees the creation of new works under the Dr. Seuss brand. Nor did they consult counsel. Instead, ComicMix proceeded on the assumption that *Boldly* "would be 'pretty well protected by parody,'" despite acknowledging "that 'people in black robes' may disagree." *Id.* at 448. And disagree they did.

ComicMix had prevailed before the Southern District of California, which rejected Seuss's trademark claims and held that although *Boldly* was not a parody it was nevertheless a fair use of *Go!*, *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 372 F. Supp. 3d 1101, 1115, 1126-27 (S.D. Cal. 2019). But *Boldly's* life was neither long nor prosperous. On appeal, despite clearing *Boldly* of trademark infringement, a unanimous Ninth Circuit panel held that the mashup could not avoid copyright infringement as a fair use of *Go!*. *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 461 (9th Cir. 2020).

The decision is interesting for more than just its many iconic cultural references. In essence, the Ninth Circuit deemed *Boldly* expressive enough to dodge Seuss's trademark infringement claims but not expressive enough *in the right ways* to avoid liability for copyright infringement. Does the decision address the needs of the many mashup creators looking to avoid liability? Or is it highly illogical? While some may find it the beginning of wisdom, not the end, this post will summarize the decision's logic and let readers decide for themselves.

Copyright

Copyright law in the United States exists to motivate creative activity. The Copyright Clause of the Constitution grants Congress the power to give authors exclusive rights to their works, for

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limited times, "to promote the Progress of Science." *See* U.S. Const. Art. I, § 8, cl. 8. To help further this end, Congress has both provided for a special reward in the form of copyright protection and placed important limits on the scope of such protection. One important limit is fair use.

Section 107 of the Copyright Act codifies the doctrine of fair use. "Fair use was traditionally defined as 'a privilege in others than the owner of the copyright to use the copyrighted material in a reasonable manner without his consent.'" *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 549 (1985) (quoting H. Ball, Law of Copyright and Literary Property 260 (1944)). The current statute "requires a case-by-case determination whether a particular use is fair, and the statute notes four nonexclusive factors to be considered." *Id.*; *see also Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994). Section 107 recites the following four factors:

> (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.

Disagreeing with the lower court and prominent copyright scholars, the Ninth Circuit held that all four statutory fair use factors weighed against ComicMix: (1) the use was commercial and not transformative; (2) *Go!* is an expressive work at the "core" of copyright protection; (3) the amount taken was quantitatively and qualitatively substantial; and (4) *Boldly* interfered not only with the market for *Go!* but also with the potential market for derivative works. The court found that each factor favored Seuss, and ruled that no countervailing copyright principles counseled in favor of fair use.

As to the first factor, "the purpose and character of the use," the Ninth Circuit identified the use as indisputably commercial. The court then addressed the closer question: whether *Boldly* was transformative. The court noted that "[t]ransformative use of the original work can tip the first factor in favor of fair use." *Dr. Seuss Enters.*, 372 F. Supp. 3d at 452. But after discussing at length, the similarities between the illustrations in *Boldly* and in *Go!*, the court held that *Boldly* did not *transform Go!* with any new expression, meaning, or message. *Boldly* merely "repackaged" *Go!* "into a new format, carrying the story of the *Enterprise* crew's journey through a strange star in a story shell already intricately illustrated by Dr. Seuss." *Id.* at 454-55. Thus, this factor did not weigh in favor of fair use.

What does it mean for use to be transformative? After all, *something* was new and different about Captain Kirk and his crew boldly going where no Star Trek character had gone before. Why was that not transformative? The Ninth Circuit's framing of the question and discussion of parody are both instructive.

The Ninth Circuit framed the transformative use question as follows: whether *Boldly* altered *Go!*, not merely by adding something new, but by "add[ing] something new, *with a further purpose or different character*, altering [*Go!*] with *new expression, meaning or message*." *Id.* at 453 (emphasis added). The question is not "is the resulting work new and different; does it contain new expression." Rather, to qualify as transformative, this case teaches, use must change the nature of the expressive content of the original work.

The court's discussion of parody helps illustrate the difference. ComicMix mistakenly thought *Boldly* would be protected as a parody. Parody, meaning "a spoof, send-up, caricature, or comment on" an original work, *id.* at 452, is quintessential fair use not because the resulting work or message is funny, but because it transforms the original expression by criticizing or commenting on that expression. Neither the district court nor the Ninth Circuit found that *Boldly* was a parody. And it bears noting that even parodies may not qualify as fair use. *See, e.g.*, *Dr. Seuss Enters. L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1400 (9th Cir. 1997) ("[T]he parodist is permitted a fair use of a copyrighted work if it takes no more than is necessary to 'recall' or 'conjure up' the object of his parody.")

The second factor—"nature of the copyrighted work"—followed suit. The court easily recognized *Go!* as the kind of creative work that merits protection. *Id.* at 455.

The court found that the third factor, "amount and substantiality of use," also weighed against fair use. The court reasoned that the amount of content taken from *Go!* was significant; *Boldly* copied over half of *Go!*'s pages and the illustrations replicated *Go!* as much as possible, including "the exact composition, the particular arrangements of visual components, and the swatches of well-known illustrations." *Id.* at 456. These illustrations captured the "heart" and "highly expressive core" of Dr. Seuss's works and were "identifiable as Seussian." *Id.* at 457. The court squarely rejected ComicMix's argument that substantiality should be evaluated by comparing the portion used against all of the copyrighted author's works; the comparison is between the portion used and the specific copyrighted work at issue. *Id.* at 458.

The final factor, the effect of *Boldly* on the "potential market" or "value" of *Go!*, likewise weighed against fair use. *Boldly* was set to issue during graduation season, a plan that "intentionally targeted and aimed to capitalize on the same graduation market as *Go!*." *Id.* at 460. Because Seuss engages consistently in the derivative market, *Boldly*'s release would have impacted *Go!*'s potential market for derivative works.

Trademark

In stark contrast, the Ninth Circuit agreed with the district court that Seuss's trademark infringement claim failed as a matter of law. The court declined to reach whether the Seussian style of illustration and font are valid common law trademarks because the claim failed at an earlier stage: it held the Lanham Act, the primary federal trademark statute in the United States, inapplicable to *Boldly*.

To assess the threshold question of whether the Lanham Act applied, the Ninth Circuit employed the test for expressive works first articulated by the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). Under the *Rogers* test, a trademark owner does not have an actionable Lanham Act claim based upon the use of a trademark in an expressive work unless the use either (1) has no artistic relevance to the underlying work or (2) explicitly misleads consumers as to the source or content of the work." *Dr. Seuss Enters.*, 983 F.3d at 462.

The court stated that if the artistic relevance is "above zero," the Lanham Act does not apply based upon the first prong. *Boldly* easily met this low standard. *Id.*

Analyzing the second prong, whether use of the claimed marks was explicitly misleading, the court evaluated (1) the degree to which Seuss's claimed mark was used and (2) the extent to which *Boldly* added expressive content to *Go!*. *Id.* at 462-63. *Boldly*'s use of "the Seussian font" and style, and even the similarities in titles, was not explicitly misleading. *Id.* at 462. Rather, the court found

that ComicMix had added enough of its own expressive content and noted that *Boldly* explicitly stated that "it is 'not associated with or endorsed by' Seuss." *Id.* at 462-63.

Conclusion

Fear not, creators, there are a few key take-aways: mashups are not automatically fair use. And mashups that simply combine sources to make a new work, no matter how interesting or funny, are unlikely to qualify. If in doubt about whether an intended use criticizes, comments on, or otherwise transforms the purpose or character of original expression, consider consulting counsel. There is a solution to every puzzle; the best one may entail seeking permission, negotiating a license, or changing course.

