CARLTON FIELDS

An Enterprising Effort Gets Transported Back to Earth: Mash-Ups and the Fair Use Doctrine

December 28, 2020

On December 18, 2020, the Ninth Circuit Court of Appeals issued its decision in *Dr. Seuss Enterprises, L.P. v. ComicMix LLC*, addressing mash-ups, the fair use doctrine, and burdens of proof. The panel set the stage colorfully as follows:

> In Dr. Seuss's classic book, *Oh, the Places You'll Go!* (*Go!*), the narrator counsels the protagonist on a path of exploration and discovery. The book closes with this note of caution:
>
> - I'm sorry to say so
> - But, sadly it's true
> - That Bang-ups
> - And Hang-ups
> - Can happen to you.
>
> If he were alive today, Dr. Seuss might have gone on to say that "mash-ups can happen to you."

The case analyzes a so-called mash-up of Dr. Seuss and Star Trek called *Oh, the Places You'll Boldly Go!* that, the panel explained, "borrows liberally — graphically and otherwise — from *Go!* and other works by Dr. Seuss, and that uses Captain Kirk and his spaceship *Enterprise* to tell readers that 'life is an adventure but it will be tough.'" Dr. Seuss Enterprises sued. The district court entered summary judgment for the defendants, based on the fair use doctrine, after shifting the burden of proof to the plaintiff on a portion of that traditional affirmative defense. On appeal, the panel revealed its view of the case from the outset: "The creators thought their *Star Trek* primer would be 'pretty well protected by parody,' but acknowledged that 'people in black robes' may disagree. Indeed, we do."

The issue, the panel explained, was "not whether *Boldly* infringed *Go!,* but whether *Boldly!* was a fair use of *Go!.*" Finding that the statutory factors decisively weigh against the defendants and no countervailing copyright principles counsel otherwise, the panel concluded that *Boldly* did not make fair use of *Go!* Although the panel thoroughly examined all four statutory factors in reaching its conclusion, two points stand out for mention here as practice pointers. First, the defendants' embrace of a burden of proof that was at odds with binding Ninth Circuit precedent, while successful in the district court, fell flat with the panel. Specifically, the defendants attempted to shift the burden of proving "the effect of the use upon the potential market for or value of the copyrighted work" to Dr. Seuss Enterprises. The panel rejected that attempt:

> Not much about the fair use doctrine lends itself to absolute statements, but the Supreme Court and our circuit have unequivocally placed the burden of proof on the proponent of the affirmative defense of fair use. ComicMix tries to plow a new ground in contending that fair use is not an affirmative defense and that the burden shifts to Seuss to prove potential market harm.

The panel concluded that binding precedent "squarely forecloses this argument." Second, the participation of subject matter experts as amici in support of Dr. Seuss Enterprises clearly impressed the panel. Dr. Seuss Enterprises was supported by an amici curiae brief by Peter Menell, Shyamkrishna Balganesh, and David Nimmer, "law professors at the University of California and the University of Pennsylvania who study and teach intellectual property law." They wrote that "[c]opyright law's fair use defense is one of the most vexing doctrines in all of the law. From its emergence nearly two centuries ago through the present, courts have struggled with and lamented its complexity, unpredictability, and subjectivity. The reporters are replete with cases that could have gone either way." This case, they explained, "does not fall into the gray area." The panel expressly relied on the brief filed by the amici at one point in its decision, directly excerpting a portion of the following argument (specifically, the examples given) in its opinion:

> The District Court's decision destabilizes essential copyright law principles that have long supported markets for collaborations and derivative works. If this decision stands, competitors could flood publishing, television, film, and merchandising markets with unauthorized derivative works merely by "mashing" in other elements. Lucasfilm could produce *Oh the Places Yoda'll Go!* without obtaining a license from Dr. Seuss Enterprises. The developers of the *Pokémon* series could offer *Oh the Places You'll Pokémon Go!*. Castle Rock Entertainment could introduce *Oh the Places You'll Yada Yada Yada!*. Warner Bros. could freely mash together Bugs Bunny with Marvel Comic's Iron Man or Sesame Street's Kermit the Frog.

In sum, the Ninth Circuit has provided practitioners with an important decision regarding the intersection of mash-ups and the fair use doctrine, as well as including some important practice reminders along the way.

Tips:

- Although arguing for an extension of the law is often appropriate or necessary, a determination that an incorrect burden of proof was applied will often lead to a reversal. Therefore, close attention should be paid by appellants and appellees alike to the proper burden of proof when raising and preserving issues, and consideration should be given to arguing in the alternative to cover all bases.
- Amici participation by subject matter experts can give a court comfort in areas of law characterized by their "complexity, unpredictability, and subjectivity." Appellate practitioners should consider whether amici curiae support from independent subject matter experts might assist the court (and in turn their own clients) in such cases.

Authored By

Joseph H. Lang Jr.

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