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10 **UNITED STATES DISTRICT COURT**
11 **CENTRAL DISTRICT OF CALIFORNIA**
12

13 STAR FABRICS, INC., a California
14 Corporation

15 Plaintiff,

16 v.
17

18 ZULILY, LLC, a Washington limited
19 liability company; J MODE, a
20 California business entity of form
21 unknown; LI YUAN TEXTILE AND
22 APPAREL, INC., a New York
23 Corporation; AVITAL, INC., a
24 California Corporation; 2 HEARTS,
25 INC., a California Corporation; LELE
26 FOR KIDS, a California business
27 entity of form unknown; and DOES 1
28 through 10,

Defendants.

Case No. 2:17-cv-08358-AB-AS

Assigned to: Judge Andre Birotte Jr.
Referred to: Magistrate Judge Alka Sagar

**MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT OF
ZULILY LLC’S NOTICE OF
MOTION AND MOTION FOR
PARTIAL JUDGMENT ON THE
PLEADINGS**

**[Request for Judicial Notice and
Declaration of Trevor Maxim Filed
Concurrently]**

Hearing Before Judge Birotte:

Date: February 16, 2018

Time: 10:00 a.m.

Place: Courtroom 7B
350 West First Street
Los Angeles CA 90012

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I. INTRODUCTION AND SUMMARY

Plaintiff’s claim that defendants’ Subject Product A supposedly infringes plaintiff’s Subject Design A fails the Ninth Circuit’s extrinsic test for substantial similarity as a matter of law and should therefore be dismissed. In applying the extrinsic test, courts “distinguish protectible from unprotectible elements and ask only whether the protectible elements in two works are substantially similar.” L.A. Printex Indus., Inc. v. Aeropostale, Inc., 676 F.3d 841, 849 (9th Cir. 2012), *as amended on denial of reh’g and reh’g en banc* (June 13, 2012); Cavalier v. Random House, 297 F.3d 815, 822-23 (9th Cir. 2002) (in applying extrinsic test, courts must “filter out and disregard the non-protectable elements in making [the] substantial similarity determination”).

The kinds of “non-protectable elements” that courts must “filter out and disregard” (Cavalier, 297 F.3d at 822-23) in applying the extrinsic test for substantial similarity include ideas, stock elements, and scènes à faire¹. *See, e.g.*, Satava v. Lowry, 323 F.3d 805, 810 (9th Cir. 2003) (“expressions that are standard, stock, or common to a particular subject matter or medium are not protectable under copyright law”); Ets-Hokin v. Skyy Spirits, Inc., 225 F.3d 1068, 1082 (9th Cir. 2000) (“Ets-Hokin I”) (“Under the merger doctrine, courts will not protect a copyrighted work from infringement if the idea underlying the copyrighted work can be expressed in only one way, lest there be a monopoly on the underlying idea. In such an instance, it is said that the work’s idea and expression ‘merge.’ Under the related doctrine of scènes à faire, courts will not protect a copyrighted work from infringement if the expression embodied in the work necessarily flows from a commonplace idea; like merger, the rationale is that there should be no monopoly on

¹ The term “scènes à faire” is a legal term of art used in the Ninth Circuit to describe standard elements, which comes from the world of theater and is “vaguely French for ‘scenes which ‘must’ be done.’” Satava, 323 F.3d at 810 fn.3; *see also* BLACKS LAW DICTIONARY, 8th ed. (scènes à faire: “Standard or general themes that are common to a wide variety of works and are therefore not copyrightable.”)

1 the underlying unprotectable idea.”). This process of filtering out unprotectable
2 elements, such as mere ideas, while evaluating substantial similarity under the
3 extrinsic test is sometimes called “analytic dissection.” *See, e.g., Olson v. National*
4 *Broadcasting Co., Inc.*, 855 F.2d 1446, 1453 (9th Cir. 1988) (even if a reasonable
5 jury were to find substantial similarity in total concept and feel, there is no
6 infringement “where analytic dissection demonstrates that all similarities in
7 expression arise from the use of common ideas”).

8 Here, plaintiff’s claim for Subject Design A cannot withstand analytic
9 dissection. Plaintiff has not alleged in the complaint—and, during the meet and
10 confer process, Plaintiff steadfastly refused to articulate²—any particular elements
11 embodied within Subject Design A that it claims constitute its own protectable,
12 original expression. Presumably, plaintiff was reluctant to articulate specific
13 elements it might claim as original because it knows that there is nothing it can
14 identify that (a) withstands analytic dissection, and (b) is actually similar to
15 defendant’s design. Perhaps plaintiff will back off its present position that it is not
16 legally required to tell the defendants or the Court what is supposedly original about
17 its copyrighted designs and come up with something novel in opposition. In any
18 event, for Subject Design A, whatever plaintiff might argue in opposition, or
19 whatever it might try and allege in an amended complaint is ultimately of little
20 import because plaintiff’s problem with this claim is not one that can be fixed.

21 As shown here by reference to judicial notice evidence, geometrically
22 repeating lines in a curved, zig-zag pattern is a ubiquitous design concept common
23 in the fashion industry, which was popularized not by the plaintiff, but by the well-
24 known Missoni fashion house decades ago. So, for Subject Design A, plaintiff

25
26 ² *See Exhibit A* to Maxim Decl. (meet and confer correspondence where plaintiff relies solely on a
27 single out-of-circuit district court case to claim that the analytic dissection approach has been
28 rejected for simple, two dimensional artwork (which is very clearly not the law on the Ninth
Circuit) and refuses to articulate any specific elements of its challenged designs that it claims are
original and protectable).

1 should not be heard to argue that there is anything supposedly original or protectable
2 about its selection and arrangement of curved, zig-zag lines on a piece of fabric.
3 This precise kind of design has been done, by Missoni and all its many imitators
4 throughout the fashion industry, repeatedly, for decades. In other words, the
5 selection and arrangement of the various elements appearing in Subject Design A is
6 the fabric equivalent of an unprotectable stock element or *scène à faire*. The only
7 thing conceivably original (and thus protectable) about plaintiff’s Subject Design A
8 is the color scheme.³ But the potentially original color scheme in plaintiff’s
9 copyrighted design is indisputably *not similar* to defendants’ product.

10 **Plaintiff’s Subject Design A:**



24 [Compl. ¶ 17, ECF No. 1]

11 **Defendants’ Subject Product A:**



24 [Compl. ¶ 17, ECF No. 1]

27 ³ This may explain why the Copyright Office, which typically does only very limited substantive
28 review of incoming applications, and which does not compare designs applicants seek to register
with prior registrations, allowed this particular design to be registered.

1 **Typical Missoni Zig-Zag Design:**



Missoni Iconic Zig-Zag Knit Shawl
\$650



PURCHASE
MAKE AN OFFER

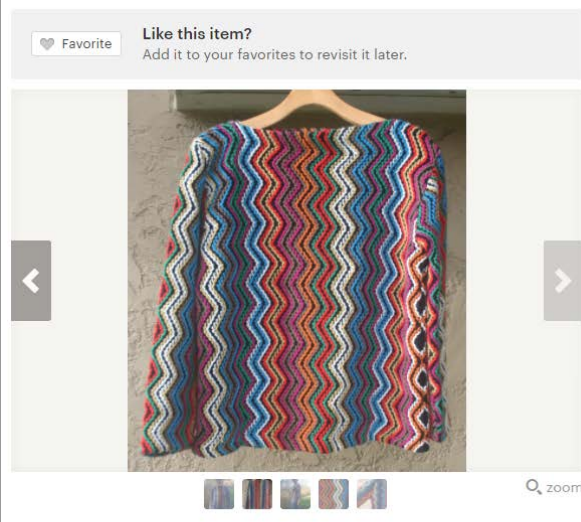
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12 **Exhibit C at p. 1 to Maxim Decl.**

13 **Typical Missoni-Inspired Imitation:**



Ziggy Zig Zag Sweater Multi Size Small

\$34.00

Ask a question

Add to cart

Don't wait. There's only 1 of these available.

22 **Overview**

- Vintage item from the 1970s
- Material: acrylic
- Feedback: 43 reviews
- Favorited by: 14 people
- View shop policies
- Gift message available

This shop accepts Etsy gift cards

23 **Shipping**

Ready to ship in 3-5 business days
From United States

Get shipping cost

24 **Description**

Vibrant, fun 1970s sweater with rainbow zig-zag print. Reminds us of Missoni, but definitely not made by Missoni. Looks so cute with jeans or tan cords.

25 **Exhibit D at p. 1 to Maxim Decl.**

26 Plaintiff does not have a monopoly on curved, zig-zag fabric designs. Since
27 there is no similarity between any protectable element of plaintiff's design and
28 defendants' product, Zulily, LLC respectfully requests that partial judgment on the pleadings be granted in its favor as to "Subject Design A."

II. FACTUAL AND PROCEDURAL BACKGROUND

(a) Plaintiff’s Claims for Copyright Infringement

The Plaintiff, Star Fabrics, Inc. (“Star”) is well known-within the Central District of California as a professional litigant. See Exhibit F to Maxim Decl. (showing that Star has filed 425+ copyright lawsuits in the Central District of California since 2007).

As relevant here, Star alleges in its complaint as follows:

“14.Plaintiff owns an original two-dimensional artwork used for purposes of textile printing entitled 37493 (“Subject Design A”) which has been registered with the United States Copyright Office.

15. Prior to the acts complained of herein, Plaintiff widely disseminated fabric bearing Subject Design A to numerous parties in the fashion and apparel industries.

16. Plaintiff is informed and believes and thereon alleges that following its distribution of Subject Design A, ZULILY, J MODE, DOE Defendants, and each of them sold and/or distributed fabric and/or manufactured or caused to be manufactured garments featuring a design substantially similar to Subject Design A (hereinafter “Subject Product A”) without Plaintiff’s authorization, including but not limited to products sold as follows:

a. by ZULILY under Style No. d199 and label J MODE indicating it was manufactured or caused to be manufactured by J MODE;

b. by ZULILY under SKU Nos. 308-6719-2; 308-6719-6 with label “Mahal”; and

c. by ZULILY under Style No. R3F507-U068TNLO with label “RU Apparel” and bearing RN 101620, indicating it was manufactured or caused to be manufactured by RHE HATCO.

17.An image of Subject Design A and one exemplar of Subject Product A are set forth hereinbelow: [*Pictures omitted*]

...

44. Plaintiff is informed and believes and thereon alleges that one or more of the Defendants manufactures garments and/or is a garment vendor. Plaintiff is further informed and believes and thereon alleges that said Defendant(s), and each of them, has an ongoing business relationship with Defendant retailers, and each of them, and supplied garments to said retailers, which garments infringed Subject Designs in

1 that said garments were composed of fabric which featured
2 unauthorized print designs that were identical or substantially similar to
3 the Subject Design, or were an illegal modification thereof.”

4 Compl. (ECF No. 1) at ¶¶ 14-17, 44.

5 Star filed suit against Zulily and five other named defendants, asserting a
6 single cause of action for copyright infringement on November 15, 2017. *Id.* The
7 complaint alleges claims for infringement as to seven different works, styled as
8 Subject Designs A-G. *Id.* at ¶¶ 14-49.

9 **(b) Meet and Confer Process: After Being Informed Zulily Would Challenge
10 Substantial Similarity, Star Claims it is Not Legally Required to Identify
11 Protectable Elements**

12 Zulily started the meet and confer process regarding a motion to dismiss for
13 lack of substantial similarity on December 14, 2017. Exhibit A at p. 10 to Maxim
14 Decl. After two extensions of time to respond to the complaint, and several emails
15 back and forth between counsel, counsel conducted a formal L.R. 7-3 conference on
16 December 26, 2017. *Id.* at p. 4. Undersigned defense counsel then sent a follow-up
17 letter, memorializing the meet and confer discussions, and asking Star, for a final
18 time, to articulate whatever it would claim as supposedly original about its designs.
19 *Id.* at p. 1. Star did not respond to the final letter, other than to note that it dismissed
20 the claim related to Subject Design D.⁴ *Id.* at p. 12.

21 With respect to Zulily’s request that Star articulate those specific elements
22 that it might claim constitute protectable, original authorship, for purposes of
23 applying the extrinsic test on this motion, Star’s response was as follows:

24 “If your grasp on copyright law were as good as you thought you
25 would understand that the abstraction-filtration-comparison test is not
26 applied to two-dimensional, non-complex works.

27 Indeed, not even a week ago the Court in *King Zak Industries, Inc. v. Toys 4 U USA, Corp.*, 7-16-cv-09676 partially denied
28 defendant's motion for judgment on the pleadings, rejecting defendant's
argument that the court should apply the "abstraction-filtration-comparison" test to the works at issue when determining substantial

⁴ Unless otherwise noted, all references to “Rules” are to the Federal Rules of Civil Procedure.

1 similarity. The Court held: "few federal courts have applied the
 2 ['abstraction-filtration-comparison' ('AFC')] test outside the context of
 3 computer program copyrights. . . . That test--a version of which was
 4 originally created by Learned Hand and applied in the context of plays
 5 and novels . . . was reformulated in *Computer Associates International,
 6 Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992), specifically to address
 7 the complex nature of computer programs, which 'are likely to be
 8 somewhat impenetrable by lay observers--whether they be judges or
 9 juries--and, thus, seem to fall outside the category of works
 10 contemplated by those who engineered the [ordinary observer] test.' . . .
 11 [I]n a case such as this, where the works contains both protectable and
 12 unprotectable elements, the 'inquiry is more holistic' and the Court is to
 13 compare the works' 'total concept and overall feel . . . as instructed by
 14 our good eyes and common sense.' . . . [B]ecause Plaintiff's copyright is
 15 easily analyzed by a layperson, I need not apply the complex AFC test."

16 And again, we believe the works to be entirely original and
 17 protectable, both in their elements and in the selection and arrangement
 18 of those elements." *Id.* at p. 6-7.

19 Although Zulily repeatedly asked Star "Are you claiming protectable, original
 20 expression that goes beyond selection and arrangement of otherwise unprotectable
 21 elements? Yes or no? And if yes, what specifically?" (*Id.* at p. 7), Star refused to
 22 answer beyond the above.

23 **(c) Missoni and its Iconic Curved Zig-Zag Fabric Designs**

24 The Missoni fashion brand began in the 1950s in Gallarate, Lomardy, Italy.
 25 Exhibit B at p. 1 to Maxim Decl. By the 1960s, the company had become well
 26 known for its distinctive zig-zag designs on knitwear products. *Id.* In the late
 27 1990s, Missoni expanded globally, offering a more diverse array of products. *Id.* at
 28 p. 2. The brand spread to modest and heavily trafficked retail outlets including
 Target, whose collaboration with Missoni in 2011 caused the Target website to
 crash. *Id.*

Missoni's iconic zig-zag design has been imitated throughout the fashion
 industry on fabric designs such as the Plaintiff's. Garments and other goods bearing
 the design are sold through a variety of vendors and on a variety of brands, ranging

1 from children’s shoes to scarves and everything in between. Exhibit D to Maxim
2 Decl. (showing examples of Missoni-inspired goods available for sale). Missoni’s
3 own website admits that the curved zig-zag style is a “dominant motif” that “has
4 been repeated and renewed over time,” and represents “a form of modernism” that
5 recalls that aesthetics of the 1960s. Exhibit B at p. 3 to Maxim Decl. In 2016, the
6 Museo MAGA museum in Italy opened an exhibit called (in English), “Missoni, Art,
7 Color,” which celebrated the influential history of the brand and its designs. *Id.* at p.
8 4 to Maxim Decl.

9 As representative examples, here are two pictures of Missoni zig-zags (that
10 are very similar to the design plaintiff seeks to protect) dating to the earliest days of
11 Missoni and to the 1970’s respectively:



25
26 See Exhibit E at p. 7, 10 to Maxim Decl. (WGSN fashion trend periodical article on
27 the “Unravel: Knitwear in Fashion” exhibition at the MoMu Museum in Antwerp,
28 Belgium).

III. ARGUMENT

(a) **Legal Standard for Motion for Judgment on the Pleadings**

The substantive standard governing a Rule 12(c) motion is “functionally identical” to that governing a Rule 12(b)(6) motion. United States ex rel. Cafasso v. Gen. Dynamics C4 Sys., Inc., 637 F.3d 1047, 1054 n.4 (9th Cir. 2011). “Judgment on the pleadings under Rule 12(c) is proper when the moving party establishes on the face of the pleadings that there is no material issue of fact and that the moving party is entitled to judgment as a matter of law.” Jensen Family Farms, Inc. v. Monterey Bay Unified Air Pollution Control Dist., 644 F.3d 934, 937 n.1 (9th Cir. 2011). A motion for judgment on the pleadings need not address every claim at issue. See Strigliabotti v. Franklin Res., Inc., 398 F. Supp. 2d 1094, 1097 (N.D. Cal. 2005) (“it is common to apply Rule 12(c) to individual causes of action”); Moran v. Peralta Community College Dist., 825 F. Supp. 891, 893 (N.D.Cal.1993); O’CONNELL ET AL., RUTTER GROUP PRAC. GUIDE FED. CIV. PRO. BEFORE TRIAL ¶ 9:340 (2017) (common practice to permit “partial judgment on the pleadings”).

As with a Rule 12(b)(6) motion, a claim must be dismissed if it does not plead “enough facts to state a claim to relief that is plausible on its face.” Bell Atlantic Corp. v. Twombly, 550 U.S. 544, 570 (2007). While the allegations of material fact in the complaint are taken as true, a court “is not required to accept legal conclusions in the form of factual allegations if those conclusions cannot reasonably be drawn from the facts alleged.” Clegg v. Cult Awareness Network, 18 F.3d 752, 754 (9th Cir. 1994).

(b) **In Copyright Cases, it is Appropriate to Challenge Substantial Similarity on the Pleadings**

To establish copyright infringement, a plaintiff must prove two elements: “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.” Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991). A plaintiff can prove copying by showing (1) that the defendant had access

1 to the plaintiff’s work and (2) that the two works are substantially similar. *Smith v.*
2 *Jackson*, 84 F.3d 1213, 1218 (9th Cir. 1996).

3 Where the works are attached to the complaint, a defendant may contest
4 substantial similarity with a Rule 12(b)(6) motion. *See, e.g., Christianson v. West*
5 *Pub. Co.*, 149 F.2d 202, 203 (9th Cir. 1945) (“There is ample authority for holding
6 that when the copyrighted work and the alleged infringement are both before the
7 court, capable of examination and comparison, non-infringement can be determined
8 on a motion to dismiss.”). Courts in the Ninth Circuit routinely grant motions to
9 dismiss for lack of substantial similarity when literary works are at issue. *E.g., Wild*
10 *v. NBC Universal, Inc.*, 788 F. Supp. 2d 1083, 1109 (C.D. Cal. 2011) (alleged
11 infringement of copyright in a novel); *Shame on You Prods., Inc. v. Elizabeth Banks*,
12 120 F. Supp. 3d 1123, 1171 (C.D. Cal. 2015), *aff’d sub nom., Shame on You Prods.,*
13 *Inc. v. Banks*, 690 F. App’x. 519 (9th Cir. 2017) (alleged infringement of
14 screenplay); *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124, 1139 (C.D. Cal. 2007)
15 (alleged infringement of script for talk/cooking show).

16 While less common, works of visual art are also proper subjects for motions
17 to dismiss due to lack of substantial similarity. *Cory Van Rijn, Inc. v. California*
18 *Raisin Advisory Bd.*, 697 F. Supp. 1136, 1144 (E.D. Cal. 1987) (visual depictions of
19 raisin characters lacked substantial similarity of protected expression, given that the
20 only similarity was “the common idea of an anthropomorphic raisin”); *Christianson*,
21 149 F.2d at 203 (dismissing claim for copyright infringement of a U.S. map, finding
22 that Plaintiff’s protected material was limited to the arrangement and color scheme
23 and did not include, for example, the outline of the U.S. with state boundaries, which
24 is in the public domain).

25 **(c) In Evaluating Substantial Similarity on a Dispositive Motion, District**
26 **Courts in the Ninth Circuit Must Apply the Extrinsic Test and Filter Out**
27 **Unprotectable Elements**

28 Within the Ninth Circuit, the test for substantial similarity has two parts: an
extrinsic and an intrinsic test. The “extrinsic test” is an “objective comparison of

1 specific expressive elements,” focusing on the “articulable similarities” between two
2 works. Cavalier, 297 F.3d at 822 (quoting Kouf v. Walt Disney Pictures &
3 Television, 16 F.3d 1042, 1045 (9th Cir. 1994)). The “intrinsic test” is a subjective
4 comparison that focuses on “whether the ordinary, reasonable audience” would find
5 the works substantially similar in the ‘total concept and feel of the works.’” Id.

6 On a dispositive motion, the extrinsic test is the focus. *See, e.g.* Funky Films,
7 Inc. v. Time Warner Entm't Co., L.P., 462 F.3d 1072, 1077 (9th Cir. 2006) (“At
8 summary judgment, courts apply only the extrinsic test; the intrinsic test, which
9 examines an ordinary person's subjective impressions of the similarities between two
10 works, is exclusively the province of the jury.”).

11 A district court errs if it fails to filter out the unprotectable elements when
12 applying the extrinsic test. *See, e.g.,* Mattel, Inc. v. MGA Ent'mt, Inc., 616 F.3d 904,
13 916 (9th Cir. 2010) (“The district court did err, however, in failing to filter out all
14 the unprotectable elements” because “a finding of substantial similarity between two
15 works can’t be based on similarities in unprotectable elements”); *see also* Rice v.
16 Fox Broad. Co., 330 F.3d 1170, 1174 (9th Cir. 2003); Funky Films, 462 F.3d at
17 1077; Benay v. Warner Bros. Entm't, 607 F.3d 620, 624 (9th Cir. 2010). In applying
18 the extrinsic test, courts “distinguish protectible from unprotectible elements and ask
19 only whether the protectible elements in two works are substantially similar.” L.A.
20 Printex, 676 F.3d at 849; Cavalier, 297 F.3d at 822-23 (in applying extrinsic test,
21 courts must “filter out and disregard the non-protectable elements in making [the]
22 substantial similarity determination”).

23 In L.A. Printex, the Ninth Circuit compared two-dimensional fabric designs
24 (like the works at issue here) and determined that certain elements claimed by the
25 plaintiff were not protectable. L.A. Printex, 676 F.3d at 850 (“The idea of a floral
26 pattern depicting bouquets and branches is not protectible, and [Plaintiff’s design]
27
28

1 has elements that are not protectible, for example the combination of open flowers
2 and closed buds in a single bouquet or the green color of stems and leaves.”⁵

3 **(d) Copyright Limiting Doctrines: Merger of Idea and Expression and**
4 **Scènes à Faire; Stock Elements Are Not Protectable; “Thin” Copyright**

5 Under the Copyright Act, ideas are not protectable. 17 U.S.C. § 102(b) (“In
6 no case does copyright protection for an original work of authorship extend to any
7 idea... regardless of the form in which it is described, explained, illustrated, or
8 embodied in such work.”). Rather, it is only the original expression of ideas that can
9 be protected.

10 In exploring the idea/expression dichotomy, the Ninth Circuit has developed
11 two limiting doctrines, called merger and scènes à faire, whereby courts will refuse
12 to protect a copyrighted design on the theory that allowing a plaintiff to protect the
13 design would grant the plaintiff an improper monopoly on a basic idea. “Under the
14 merger doctrine, courts will not protect a copyrighted work from infringement if the
15 idea underlying the work can be expressed only in one way, lest there be a monopoly
16 on the underlying idea. In such an instance, it is said that the work's idea and
17 expression ‘merge.’ Under the related doctrine of scènes à faire, courts will not
18 protect a copyrighted work from infringement if the expression embodied in the
19 work necessarily flows from a commonplace idea...” *Ets-Hokin I*, 225 F.3d at
20 1082. “Likewise, when similar features of a work are ‘as a practical matter
21 indispensable, or at least standard, in the treatment of a given idea, they are treated
22 like ideas and are therefore not protected by copyright.” *Ets-Hokin v. Skyy Spirits,*
23 *Inc.*, 323 F.3d 763, 765–66 (9th Cir. 2003) (“*Ets-Hokin II*”) (quoting *Apple*
24 *Computer Corp. v. Microsoft Corp.*, 35 F.3d 1435, 1444 (9th Cir. 1994)).

25
26
27
28 ⁵ The *LA Printex* court did find, however, that “LA Printex’s original selection, coordination, and arrangement of such elements is protectable.” *L.A. Printex*, 676 F.3d at 850.

1 In *Ets-Hokin II*, the Ninth Circuit applied the merger and scènes à faire
2 doctrines to deny protection to a plaintiff who was suing over photographs of Skyy
3 vodka bottles:

4 “Though the Ets–Hokin and Skyy photographs are indeed
5 similar, their similarity is inevitable, given the shared concept, or idea,
6 of photographing the Skyy bottle. When we apply the limiting
7 doctrines, subtracting the unoriginal elements, Ets–Hokin is left with
8 only a “thin” copyright, which protects against only virtually identical
9 copying. See *Apple*, 35 F.3d at 1442 (9th Cir.1994). As we observed, in
10 *Apple*, “[w]hen the range of protectable expression is narrow, the
11 appropriate standard for illicit copying is virtual identity.” *Id.* at 1439.

12 This principle has long been a part of copyright law. Indeed, as
13 Judge Learned Hand observed in the context of stock dramaturgy: “The
14 less developed the characters, the less they can be copyrighted; that is
15 the penalty an author must bear for marking them too indistinctly.”
16 *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir.1930).
17 The same is true here, where the range of protectable expression is
18 constrained by both the subject-matter idea of the photograph and the
19 conventions of the commercial product shot.

20 Skyy's photographs are not virtually identical to those of Ets–
21 Hokin. Indeed, they differ in as many ways as possible within the
22 constraints of the commercial product shot. The lighting differs; the
23 angles differ; the shadows and highlighting differ, as do the reflections
24 and background. The only constant is the bottle itself. The photographs
25 are therefore not infringing.”

26 *Ets-Hokin II*, 323 F.3d at 765–66.

27 In *Satava*, the Ninth Circuit relied on the same principles to deny protection to
28 a plaintiff who was suing on a glass sculpture depicting a jellyfish:

“*expressions that are standard, stock, or common to a particular subject matter or medium are not protectable under copyright law.*”

It follows from these principles that no copyright protection may be afforded to the idea of producing a glass-in-glass jellyfish sculpture or to elements of expression that naturally follow from the idea of such a sculpture.

...

1 Satava's glass-in-glass jellyfish sculptures, though beautiful,
2 combine several unprotectable ideas and standard elements. These
3 elements are part of the public domain. They are the common property
4 of all, and Satava may not use copyright law to seize them for his
5 exclusive use.

6 It is true, of course, that a combination of unprotectable elements
7 may qualify for copyright protection. . . But it is not true that any
8 combination of unprotectable elements automatically qualifies for
9 copyright protection. Our case law suggests, and we hold today, that a
10 combination of unprotectable elements is eligible for copyright
11 protection only if those elements are numerous enough and their
12 selection and arrangement original enough that their combination
13 constitutes an original work of authorship. . .

14 The combination of unprotectable elements in Satava's sculpture
15 falls short of this standard.”

16 Satava, 323 F.3d at 810–11 (citations omitted and emphasis added).

17 Unprotectable stock elements include “geometric shapes” such as “straight or
18 curved lines.” See U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT
19 OFFICE PRACTICES § 906.1 (3d ed. 2017) (“The Copyright Act does not protect
20 common geometric shapes, either in two-dimensional or three-dimensional form...
21 including, without limitation, straight or curved lines...”); cf. 37 C.F.R. § 202.1(a)
22 (“Familiar symbols and designs are not protected by the Copyright Act.”).

23 **(e) Here, After Applying the Extrinsic Test and Filtering Out Unprotectable
24 Elements, there is Nothing Left to Establish Substantial Similarity
25 Between Subject Design A and Defendants’ Products**

26 As the accompanying judicial notice evidence demonstrates, Star Fabrics
27 obviously did not create the iconic Missoni zig-zag design. Exhibit B and Exhibit E
28 to Maxim Decl. (showing history of Missoni brand and designs). This kind of
design is ubiquitous in the marketplace, and has been at least since Missoni made it
famous in the 1960’s. Exhibit B to Maxim Decl. The only thing that distinguishes
Star from the many other companies doing Missoni zig-zag inspired designs is that
Star appears to believe (incorrectly) that it is entitled to monopolize the field. It is
not. The limiting doctrines of merger and scènes à faire prevent Star from doing so.

1 Zig-zags are the kind of familiar “geometric shape” stock element that is
 2 “standard, stock, or common to a particular subject matter or medium.” *See Satava*,
 3 323 F.3d at 810–11; COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 906.1;
 4 *cf.* 37 C.F.R. § 202.1(a).

5 To the extent there is any similarity between Plaintiff’s Subject Design A and
 6 Defendants’ Subject Product A, “their similarity is inevitable, given the shared
 7 concept, or idea, of” doing a Missoni curved zig-zag inspired print. *See Ets-Hokin*
 8 *II*, 323 F.3d at 765–66. There are only “a limited number of ways” to depict
 9 Missoni-inspired curved zig-zags. *See LA Printex*, 676 F.3d at 850. Since “the
 10 range of protectable expression is narrow, the appropriate standard for illicit copying
 11 is virtual identity” rather than the lower bar of substantial similarity. *See Ets-Hokin*
 12 *II*, 323 F.3d at 765–66.

13 Plaintiff did not allege in the complaint and refused to identify during the
 14 meet and confer process⁶ any specific elements it claims are original in Subject
 15 Design A. *Contra Muromura v. Rubin Postaer & Assocs.*, No. CV-12-09263-DDP-
 16 AGRX, 2015 WL 1728324, at *2-4 (C.D. Cal. Apr. 15, 2015) (granting motion to
 17 dismiss “Because Plaintiffs have failed to meet their burden to identify specific,
 18 objective, protectable elements”); *Harold Lloyd Corp. v. Witwer*, 65 F.2d 1, 22 (9th
 19 Cir. 1933) (“The plaintiff... should be expected to state to us what it is in the [work]
 20 that is copyrightable as new and novel and what part of such material, if any, has
 21 been misappropriated by the [defendant].”). Presumably, plaintiff refuses to even try
 22 to articulate protectable elements because there are none. As far as Zulily can tell,
 23 nothing about Subject Design A is conceivably original, except, perhaps, the color
 24 selection. But the color selection in plaintiff’s design is not even similar to
 25 defendants’ products, much less “virtually identical.”
 26

27 ⁶ Since plaintiff insists on playing hide the ball and saving its arguments so they will come as a
 28 surprise in the opposition, Zulily may request leave of Court to enlarge the page limit on its reply
 by the number of pages not used in this motion brief, or seek other appropriate relief.

1 If, in its opposition, Star conjures up some small detail as supposedly
2 embodying its own original authorship, which can be seen in common between the
3 plaintiff's design and defendants' products, that is unlikely to be make any
4 difference. Because even if Star could articulate some part of Subject Design A that
5 it supposedly authored, "courts will not protect a copyrighted work from
6 infringement if the expression embodied in the work necessarily flows from a
7 commonplace idea...." *Ets-Hokin I*, 225 F.3d at 1082. "Likewise, when similar
8 features of a work are 'as a practical matter indispensable, or at least standard, in the
9 treatment of a given idea, they are treated like ideas and are therefore not protected
10 by copyright.'" *Ets-Hokin II*, 323 F.3d at 765–66. Anything Star might point to
11 would be "standard in the treatment" of a Missoni-inspired zig-zag design, and the
12 kind of detail that "necessarily flows" from doing a curved, zig-zag, à la Missoni.
13 Thus, amendment of the complaint cannot fix the problem, and leave to amend
14 should be denied if it is sought.

15 In short, after engaging in analytic dissection and filtering out the
16 unprotectable aspects of plaintiff's Subject Design A, there is nothing left to
17 objectively support a finding of substantial similarity.

18 **IV. CONCLUSION**

19 For all of the foregoing reasons, defendant Zulily respectfully requests that the
20 Court (a) hold that plaintiff is required to identify specific, protectable elements in
21 order to survive the extrinsic test for substantial similarity; (b) hold that any
22 potentially original expression in Subject Design A is entitled to only a "thin"
23 protection such that plaintiff must show not merely substantial similarity but "virtual
24 identity"; and (c) conclude, as a matter of law, that plaintiff's Subject Design A
25 contains no protectable elements that are virtually identical, or even substantially
26 similar, to defendants' products, such that partial judgment on the pleadings is
27 granted in Zulily's favor on this claim.
28

1 Respectfully submitted,

GERARD FOX LAW, P.C.

2
3 DATED: January 18, 2018

BY: /s/ Morgan E. Pietz

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