

1 Morgan E. Pietz (SBN 260629)
mpietz@gerardfoxlaw.com
2 Timothy G. Lamoureux (SBN 294048)
tlamoureux@gerardfoxlaw.com
3 Trevor C. Maxim (SBN 317859)
tmaxim@gerardfoxlaw.com
4 GERARD FOX LAW, P.C.
1880 Century Park East, Suite 1410
5 Los Angeles, CA 90067
6 Telephone: (310) 441-0500
Facsimile: (310) 441-4447

7 *Attorneys for Defendant ZULILY, LLC*

8
9 **UNITED STATES DISTRICT COURT**
10 **CENTRAL DISTRICT OF CALIFORNIA**
11

12 STAR FABRICS, INC., a California
13 Corporation

14 Plaintiff,

15 v.

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

25 Defendants.
26
27
28

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

Assigned to: Judge Andre Birotte Jr.

Referred to: Magistrate Judge Alka Sagar

**ZULILY’S REPLY IN FURTHER
SUPPORT OF ITS MOTION FOR
PARTIAL JUDGMENT ON THE
PLEADINGS**

Hearing Before Judge Birotte:

Date: March 2, 2018

Time: 10:00 a.m.

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

TABLE OF CONTENTS

1

2 TABLE OF CONTENTS..... 2

3 TABLE OF AUTHORITIES 3

4 I. INTRODUCTION AND SUMMARY..... 6

5 II. THE PICTURES AND DESCRIPTIONS STAR RELIES UPON DO NOT

6 ESTABLISH EXTRINSIC SIMILARITY 12

7 III. THERE IS NO GOOD REASON WHY COURTS IN THE NINTH CIRCUIT

8 SHOULD APPLY ONE STANDARD FOR LITERARY CASES BUT A

9 DIFFERENT STANDARD IN FABRIC CASES 17

10 IV. STAR HAS ADMITTED AWAY ITS CLAIM AND FAILS TO IDENTIFY

11 NEW FACTS THAT WOULD ESTABLISH EXTRINSIC SIMILARITY SO

12 LEAVE TO AMEND SHOULD BE DENIED 19

13 V. CONCLUSION..... 20

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

TABLE OF AUTHORITIES

Cases

Apple Computer Corp. v. Microsoft Corp.,
35 F.3d 1435 (9th Cir. 1994).....14, 15

Benay v. Warner Bros. Entm't,
607 F.3d 620 (9th Cir. 2010).....6, 16, 17, 19

Bernal v. Paradigm Talent & Literary Agency,
788 F. Supp. 2d 1043 (C.D. Cal. 2010).....18

Cavalier v. Random House,
297 F.3d 815 (9th Cir. 2002).....6

Ets-Hokin v. Skyy Spirits, Inc.,
225 F.3d 1068 (9th Cir. 2000).....9, 14

Ets-Hokin v. Skyy Spirits, Inc.,
323 F.3d 763, 765–66 (9th Cir. 2003).....9, 14, 15, 20

Feist Publications, Inc. v. Rural Telephone Service Co.,
499 U.S. 340, 111 S. Ct. 1282 L.Ed.2d 358 (1991).....7, 10, 11, 15

Funky Films v. Time Warner Entm't Co.,
462 F.3d 1072, 1075 (9th Cir. 2006).....15, 17, 19

Idema v. Dreamworks, Inc.,
162 F. Supp. 2d 1129 (C.D. Cal. 2001).....17

Johnson v. American Airlines, Inc.,
834 F.2d 721 (9th Cir. 1987).....20

Kaplan v. Stock Market Photo Agency, Inc.,
133 F. Supp. 2d 317 (S.D.N.Y. 2001).....9

King Zak Industries, Inc. v. Toys 4 U USA, Corp.,
S.D.N.Y. No. 16-cv- 9676, ECF No. 50, 12/8/1711

Kouf v. Walt Disney Pictures & Television,
16 F.3d 1042 (9th Cir. 1994).....17

1 L.A. Printex Indus., Inc. v. Aeropostale, Inc.,
2 676 F.3d 841 (9th Cir. 2012).....passim
3 Lassiter v. Twentieth Century Fox Film Corp.,
4 238 F. App'x. 194 (9th Cir. 2007)16, 18
5 Mestre v. Vivendi Universal U.S. Holding Co.,
6 273 F. App'x 631 (9th Cir. 2008)18
7 Milano v. NBC Universal, Inc.,
8 584 F. Supp. 2d 1288 (C.D. Cal. 2008).....18
9 Pasillas v. McDonald's Corp.,
10 927 F.2d 440 (9th Cir. 1991).....17
11 Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.,
12 602 F.3d 57 (2d Cir. 2010).....11
13 Petrella v. Metro-Goldwyn-Mayer, Inc.,
14 572 US __, 134 S. Ct. 1962 (2014)10
15 Rice v. Fox Broad. Co.,
16 330 F.3d 1170 (9th Cir. 2003).....17, 19
17 Roth v. Garcia-Marquez,
18 942 F.2d 617 (9th Cir. 1991).....20
19 Satava v. Lowry,
20 323 F.3d 805 (9th Cir. 2003).....15
21 Shame on You Prods., Inc. v. Elizabeth Banks,
22 120 F. Supp. 3d 1123 (C.D. Cal. 2015).....18
23 Star Athletica, L. L. C. v. Varsity Brands, Inc.,
24 580 U. S. __, 137 S. Ct. 1002 (2017)10, 11
25 Thomas v. Walt Disney Co.,
26 337 F. App'x 694 (9th Cir. 2009)18
27 Ventress v. Japan Airlines,
28 603 F.3d 676 (9th Cir 2010).....20

1 Walker v. Viacom Int'l, Inc.,
2 362 F. App'x 858 (9th Cir. 2010)18
3 Wild v. NBC Universal, Inc.,
4 788 F. Supp. 2d 1083 (C.D. Cal. 2011).....18
5 Zella v. E.W. Scripps Co.,
6 529 F. Supp. 2d 1124 (C.D. Cal. 2007).....18
7 **Statutes**
8 17 U.S.C. § 410.....7
9 **Other Authorities**
10 R. Helfing, “Substantial Similarity in Literary Infringement Cases: A Chart for
11 Turbid Waters” 21 UCLA Ent. L. Rev. 1 (2014).....18, 19
12
13
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I. INTRODUCTION AND SUMMARY

Star acknowledges, as it must, that to survive this motion for judgment on the pleadings, it must plausibly allege that “Zulily copied¹ *protectable elements* of the Subject Design.” Opp.² at 5:9½-10½ (emphasis added). Yet Star curiously defends its stated position of “refusing” and “resisting” Zulily’s attempts to meet and confer about which *elements* of Star’s copyrighted design are supposedly *protectable* as unnecessary because Star thinks having to articulate that is an “incorrect legal standard.”³ The Ninth Circuit did away with the need to dissect a copyrighted work into its different elements to analyze which of them are protectable, Star tells us, in *Aeropostale*, when the Court purportedly “specifically h[eld] that analytic dissection is not appropriate for fabric design artwork cases.” Opp. at 2:15 & fn 3. But *Aeropostale* says nothing of the sort. In fact, it says just the opposite. “Because copyright law protects expression of ideas, not ideas themselves, we distinguish protectible from unprotectible elements and ask only whether the protectible elements in two works are substantially similar.” *Aeropostale*, 676 F.3d at 849; citing *Cavalier v. Random House*, 297 F.3d 815, 822 (9th Cir. 2002) (in applying extrinsic test, courts must “filter out and disregard the non-protectable elements in making [the] substantial similarity determination”); accord, e.g., *Benay v. Warner Bros. Entm’t*, 607 F.3d 620, 624–25 (9th Cir. 2010) (court must “inquire only whether the protect[able] elements, standing alone, are substantially similar.”)

¹ “‘Because direct evidence of copying is not available in most cases,’ a plaintiff can establish copying by showing (1) that the defendant had access to the plaintiff’s work and (2) that the two works are substantially similar.” *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 846 (9th Cir. 2012), *as amended on denial of reh’g and reh’g en banc* (June 13, 2012) (“*Aeropostale*”).

² Plaintiff’s Opp. to Zulily’s Mtn. for Partial Judg. on the Pleadings, ECF No. 30.

³ Star says this motion is motivated by “nothing more than Zulily’s frustration at Star’s refusal to confer inside of incorrect legal standards” (Opp. at 1:13-14) and that “Star resisted Zulily’s efforts to confer over an incorrect legal standard for evaluating substantial similarity.” (*id.* at 2:14-15).

1 In other words, what the law in the Ninth Circuit says is that to survive a
2 dispositive motion challenging substantial similarity, a plaintiff must (a) articulate
3 what elements are supposedly protectable in its copyrighted design, and (b)
4 demonstrate objective similarity *between those elements* and a defendant's product.
5 Here, during the meet and confer process, Star outright "refused" to do (a).⁴ And in
6 its opposition, Star simultaneously argues that having to do (a) is an "incorrect legal
7 standard," while also belatedly throwing together a description of certain specific
8 elements that it now claims are sufficient to carry its burden as to (b).⁵

9 To be clear, it is indeed *Star's burden* to demonstrate substantial similarity by
10 passing the Ninth Circuit's "extrinsic test."⁶ This point only needs clarifying
11 because Star spends a significant portion of its opposition brief attacking a straw
12 man. On this motion, *Zulily is not challenging the validity of Star's registration or*
13 *arguing that its copyrighted work is unoriginal.* Accordingly, the presumption of
14 validity afforded by a registration certificate,⁷ which Star discusses at length, is
15 irrelevant.⁸ As noted in Zulily's moving brief⁹, it is entirely possible that Star has a
16 valid copyright and was properly issued a registration certificate based on an original
17

18 ⁴ See fn. 3, above; see also ECF No. 25-1, Exh. A (meet and confer letter and
19 attached emails memorializing Star's refusal to articulate what elements it would
20 claim as protectable).

21 ⁵ Opp. at 10:1-5, 14:6-16.

22 ⁶ *Aeropostale*, 676 F.3d at 846 ("To establish copyright infringement, **a plaintiff**
23 **must prove** two elements: '(1) ownership of a valid copyright, and (2) copying of
24 constituent elements of the work that are original.'") (emphasis added); quoting
Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991).

25 ⁷ 17 U.S.C. § 410(c), (a registration certificate "made before or within five years
26 after first publication of the work shall constitute prima facie evidence of the validity
27 of the copyright and of the facts stated in the certificate.")

28 ⁸ Thus, the Court can more or less ignore everything said in the Opposition from
5:21½ to 7:10.

⁹ ECF No. 23-1 at 8:6-8 & fn. 3.

1 selection and arrangement of colors. But Star’s potentially original color selection
2 as seen in Subject Design A is not at all similar to the color scheme in defendants’
3 Subject Product A. Where Star’s claim fails, and the issue that Zulily’s motion *is*
4 *focused upon*, is the lack of objective, or extrinsic, similarity *between the protectable*
5 *elements of Star’s work* and defendants’ product. Indeed, Star appears to have a
6 hard time even articulating the elements we should be comparing.

7 Star’s argument is summed up neatly in its Conclusion. According to Star,

8 “Zulily admits that Design A is a stylized rendition of a zig-zag pattern
9 and cannot in good faith deny that said rendition contains protectable
10 artistic expression. Moreover, a simple comparison of Design A and the
11 offending Zulily design reveals striking similarity of that very same
artistic expression, line-by-line. So owing, this motion must be denied.”

12 Opp. at 16:9-13. Taking this one step at a time:

13 Zulily does admit that Design A is a stylized rendition of a zig-zag pattern and
14 Zulily does not deny that the design contains protectable artistic expression. But
15 what Zulily argued and, indeed, proved, by resort to judicial notice evidence,¹⁰ is
16 somewhat more specific. What Zulily demonstrated is that the design at issue here
17 is not just any old zig-zag. Rather, it is very clearly a Missoni-inspired zig-zag.
18 Plaintiff does not own the concept of a Missoni-inspired zig-zag; if anyone owns this
19 ubiquitous motif, it is Missoni. But Missoni is not suing; Star Fabrics is the one
20 trying to monopolize the field.

21 Further, while it is true that a comparison of Star’s copyrighted design and the
22 defendants’ product shows certain similarities, the Ninth Circuit’s extrinsic test for
23 substantial similarity does not reduce down to a children’s matching game.
24 Similarities between the unprotectable elements of a plaintiff’s design and a
25 defendant’s product *do not amount to copyright infringement*. See *Satava v. Lowry*,

26
27 ¹⁰ See RFJN (ECF No. 24) and Exhs. B to E to Maxim Decl. (ECF No. 25)
28 (examples of Missoni zig-zags); Suppl. RFJN, filed concurrently herewith.

1 323 F.3d 805, 812 (9th Cir. 2003). This especially has to be so where both the
2 plaintiff and defendant are basing their patterns on the same underlying public
3 domain stock element or idea; here, a Missoni zig-zag. This motion perfectly
4 illustrates why the copyright limiting doctrines of merger and scènes à faire¹¹ —
5 which Star all but ignore in the opposition¹²—are so important. These doctrines
6 promote free competition and protect the market from being improperly
7 monopolized by any would-be registrant with an eye for what’s ‘on-trend’ and a
8 spare \$35 for a copyright registration application.

9 Aside from boldly proclaiming that *Aeropostale* held one thing when there is
10 specific language in the opinion that actually says the exact opposite, Star’s

11 _____
12 ¹¹ See Zulily’s Mot. Br. (ECF No. 23-1) at 17-19.

13 ¹² The entirety of what Star has to say about merger and scènes à faire is as follows:
14 Zulily “spills much ink discussing its component merger and scenes-a-faire
15 doctrines. But it is well-settled that those tests are inapplicable to two-dimensional
16 artwork infringement cases; rather, the *Petrella* standard set forth above is to be
17 applied.” Opp. at 12:4-7. The assertion that the merger and scènes à faire doctrines
18 do not apply to 2-d artwork is notably unsupported by any citation, and, indeed, like
19 several other arguments made by Star, is **simply not true**. See, e.g., *Ets-Hokin v.*
20 *Skyy Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000) (a binding, Ninth Circuit
21 authority that Zulily cited in its motion brief, holding that the doctrines of merger
22 and scènes à faire barred an infringement claim based on a 2-d photograph of a blue
23 Skyy vodka bottle); *Kaplan v. Stock Market Photo Agency, Inc.*, 133 F. Supp. 2d
24 317 (S.D.N.Y. 2001) (dismissing photographer’s claim for copyright infringement
25 because, “almost all of the similarities in expression between the two photographs
26 are unprotectable elements or themes that flow predictably from the underlying
27 subject matter.”) Star’s only other comment about merger and scènes à faire comes
28 in a footnote, “The cases relied on by Zulily in which the abstraction-filtration test
was applied to separate out scènes à faire and the merger doctrine are not two-
dimensional art cases—rather, they concern software, plays, novels, and a 1933
decision regarding a “silent photoplay”—all cases in which a juror could not easily
look at and compare the works at issue.” Opp. at 13 fn. 8. Again, **not true**: Zulily
cited to and extensively discussed both *Ets Hokin I* and *Ets Hokin II*, in the moving
brief, Ninth Circuit cases involving 2-d art in the form of photographs. Mot. Br. at
pp. 6:17-7:1, 17:13-18:19, 20:6-21:14.

1 argument rests on three other cases, which Star also materially misrepresents.

2 First, citing to *Star Athletica, L. L. C. v. Varsity Brands, Inc.*, 580 U. S. ____,
 3 137 S. Ct. 1002 (2017), Star tells us that “the Supreme Court recently held that
 4 infringement may lie from copying garments featuring nothing more than a series of
 5 lines, zig-zags, and color blocks having much less originality than Design A.” Opp.
 6 at 10: 7½-11½. According to Star’s reading, “The Court concluded that such
 7 designs were entitled to copyright protection and affirmed the [Sixth Circuit] (which
 8 held that plaintiff was entitled to proceed on its infringement claims).” *Id.* at 10:
 9 15½-18½. In actuality, the *Star Athletica* decision revolved around the useful
 10 articles doctrine. The High Court *held* that designs on cheerleading uniforms were a
 11 proper *subject matter* for copyright and thus *eligible* for protection, which is to say,
 12 not excluded from coverage by operation of the useful articles doctrine. Far from
 13 “concluding” that basic designs such as stripes and chevrons “were entitled to
 14 copyright protection,” as Star contends, what the Court’s opinion actually said is

15 ***“We do not today hold that the surface decorations are copyrightable.***
 16 ***We express no opinion on whether these works are sufficiently***
 17 ***original to qualify for copyright protection, see Feist Publications, Inc.***
 18 ***v. Rural Telephone Service Co.***, 499 U.S. 340, 358–359, 111 S. Ct.
 19 1282, 113 L.Ed.2d 358 (1991), or on whether any other prerequisite of
 a valid copyright has been satisfied.”

20 *Star Athletica*, 137 S. Ct. at 1012 & fn. 1 (emphasis added). Indeed, Justice Breyer
 21 pointed out in his dissent that “considered on their own, the simple stripes are
 22 plainly unoriginal.” *Id.* at 1036 (Breyer, J., dissenting).

23 Second, Star argues that *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 US __,
 24 134 S. Ct. 1962 (2014) announced a new “standard” for substantial similarity, one
 25 which supposedly supersedes the traditional “abstraction-filtration” test and rejects
 26 the merger and *scènes à faire* doctrine for 2-d artwork. Opp. at 11:21½-12:7. This,
 27 too, is entirely incorrect; *Petrella* says nothing of the sort. *Petrella* was a case which
 28 asked whether the equitable doctrine of laches still applies to copyright infringement

1 actions given the Copyright Act’s unusual statute of limitations, which reaches back
 2 three years from the date of a claim. So the Court did discuss the types of evidence
 3 one would expect to see in a copyright case. But *Feist* (the case the *Star Athletica*
 4 Court cited to in its footnote 1, as seen in the block quote above, in 2017) remains
 5 the guiding U.S. Supreme Court precedent on substantial similarity. One would
 6 think that if the Supreme Court intended to abrogate decades worth of jurisprudence
 7 on substantial similarity, merger, or scènes à faire, it might have actually said
 8 something about any of those doctrines. All three terms—“substantial similarity,”
 9 “merger,” and “scènes à faire”—do not appear anywhere in the opinion.

10 Third and finally, Star looks to “*King Zak Industries, Inc. v. Toys 4 U USA,*
 11 *Corp.*, 7-16-cv-09676” for support. Opp. at 12:8-25. This is apparently an
 12 unreported District Court order out of the Southern District of New York applying
 13 the law of the Second Circuit. *King Zak*, S.D.N.Y. No. 16-cv- 9676, ECF No. 50,
 14 12/8/17. Since “the Second Circuit has ‘disavowed any notion that ‘we are required
 15 to dissect [the works] into their separate components, and compare only those
 16 elements which are in themselves copyrightable’” Judge Siebel chose not to do so.
 17 *Id.* at p. 10; quoting *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602
 18 F.3d 57, 66 (2d Cir. 2010). As the *Aeropostale* court acknowledged, however, the
 19 law of the Ninth Circuit is different. *Aeropostale*, 676 F.3d at 850 (“Though the
 20 Second Circuit’s “ordinary observer” and “more discerning ordinary observer” tests
 21 differ somewhat from our two-part extrinsic/intrinsic test for substantial similarity,
 22 its reasoning, at least in the context of fabric designs, is persuasive, and it guides our
 23 comparison of the designs in this case.”)¹³ Thus, while Judge Siebel was free to

24 _____
 25 ¹³ While the three-judge panel in *Aeropostale* found the Second Circuit’s reasoning
 26 “persuasive,” it did *not* jettison the extrinsic test or eliminate the need to filter out
 27 unprotectable elements in applying the extrinsic test, as Star contends. Nor could it;
 28 such a drastic break from decades of prior opinions by dozens of other three-judge
 panels would presumably have to be done *en banc*. Further, what the *Aeropostale*
 court actually did was break the design at issue down into its elements and determine

1 disregard an approach that involved dissecting a work into its constituent elements
2 and then filtering out those elements that are unprotectable for purposes of applying
3 the extrinsic test, that test remains the law within this Circuit. *Aeropostale*, 676 F.3d
4 at 849 (“[W]e distinguish protectible from unprotectible elements and ask only
5 whether the protectible elements in two works are substantially similar.”)

6 In sum, Star Fails to establish that there is objective similarity between any
7 specific, protectable elements embodied within its copyrighted design and
8 defendant’s product. So this motion should be granted. Since Star fails to point to
9 any new facts that would cure this problem, leave to amend should be denied.

10
11 **II. THE PICTURES AND DESCRIPTIONS STAR RELIES UPON**
12 **DO NOT ESTABLISH EXTRINSIC SIMILARITY**

13 After Star got beyond its meet and confer position that having to articulate the
14 specific elements within its work that it claims are protectable is a “silly exercise”
15 that it “refused”¹⁴ to do, what Star eventually came up with in opposition admits
16 away its claim.

17 Star’s opposition points to four pictures (the pair of pictures alleged in the
18 complaint for Subject Design A and Subject Product A, plus two new “slightly
19 enlarged” excerpts—which appears to mean substantially manipulated by counsel)
20 and two different textual passages as supposedly demonstrating extrinsic similarity.

21 According to Star,

22 “Design A is composed of lines of differing thicknesses, some of which
23 are solid, others of which are composed of stylized dashes (some of
24 which move from right to left as they go from top to bottom, while the

25 whether any of them were protectable for purposes of satisfying the extrinsic test.
26 *Aeropostale*, 676 F.3d at 849-51 (applying extrinsic test and ultimately reversing
27 after concluding there were “objective similarities in protectible elements.”)

28 ¹⁴ ECF No. 25-1, Exh. A to Maxim Decl. at p. A-4 (meet and confer email from S. Doniger); *see also* fn. 3, above.

1 dashes that make up other lines go from left to right as they go from top
2 to bottom), and still others of which are made up of other shapes.”

3 Opp. at 10:1-5. Later, beneath the “enlarged”/manipulated photographs, Star claims,

4 “Moving from top to bottom, both designs consist of an initial zig-
5 zag—green in Design A and pink in Zulily’s design—followed by a
6 crème colored gap of space. If the green coloring in Design A were
7 changed to pink, the top half of both designs would be virtually
8 indistinguishable. Next, both designs feature a zig-zag made up of black
9 left to right back-slashes against a crème background—in Design A it is
10 between two green zig-zag lines and in the Zulily design it is between
11 two pink zig-zag lines. Then, under the respective green and pink lines
12 there is a thin black line, under which is a thin crème line, under which
13 is a thick black zig-zag line which incorporates a knife design that
14 drops from right to left and merges into the solid yellow zig-zag line
15 beneath. Under that are a substantially similar series of black and blue
16 lines.”

17 Opp. at 14:6-16.

18 The entirety of the two foregoing passages is nothing more than a description
19 of what a Missoni-type zig-zag fabric pattern looks like, zoomed in. These judicial
20 admissions are binding, and Star cannot now try and claim something different in an
21 amended complaint. Star does not expressly claim that any of these elements are
22 individually original and thus protectable. Rather, what Star claims is that overall
23 selection and arrangement of the design—i.e., the Missoni zig-zag look—is what
24 supposedly constitutes its own, protectable original authorship. But this type of
25 selection and arrangement is not original to Star; it is a common, stock element that
26 Missoni popularized in the 1960’s, as Zulily’s judicial notice evidence establishes.

27 Aside from the overall selection and arrangement of the design, Star mentions
28 only two other things: stock elements standard in textiles that have a crochet-knit
type construction or look (which are not original); and the color scheme (which
might be original, but which isn’t similar). The description of how some of the lines
‘zig’ to the right while others ‘zag’ to the left simply describes how crochet-knit
fabrics are constructed. And the “dashes” Star claims are not “stylized,” they are

1 simply a function of how yarn of one color overlaps yarn of different colors, thus
 2 making it look like the lines are dashed. To illustrate, take for example this vintage
 3 crochet-knit Missoni scarf ¹⁵ (where one can see the individual threads on the end),
 4 as compared to Star’s copyright, and to defendants’ product:



12 *Missoni crochet-knit* *Plaintiff’s Design A* *Defendants’ Product A*

13 What Star claims as supposedly protectable is obviously just *Textiles 101*.

14 Further, the foregoing comparison uses the same number of peaks and valleys,
 15 counting across, as a baseline for comparison. By contrast, the cherry-picked photo
 16 excerpt found in Star’s opposition was “slightly-enlarged” (Opp. at 13: 21½ -14:5)
 17 to be 5 peaks wide for the plaintiff and 7 wide for the defendants. That misleadingly
 18 served to fatten-up plaintiff’s design vertically, to try and make it look more similar.
 19 Star’s ‘fun with Photoshop’ is not evidence; and it is not even honest argument.

20 “When similar features of a work are ‘*as a practical matter*’ indispensable, or
 21 at least standard, in the treatment of a given idea, they are treated like ideas and are
 22 therefore not protected by copyright.” *Ets Hokin v. Skyy Spirits, Inc.*, 323 F.3d
 23 763, 765–66 (9th Cir. 2003) (“*Ets Hokin II*”) (emphasis added); quoting *Apple*
 24 *Computer Corp. v. Microsoft Corp.*, 35 F.3d 1435, 1444 (9th Cir. 1994). As noted
 25 above, Star has no answer to *Ets Hokin I* or *II*; it doesn’t even address those cases,
 26 much less distinguish them. Here, the “dashes” are “as a practical matter

27 ¹⁵ See Zulily’s Supp. Request for Judicial Notice, Exh. G (website and enlarged pic),
 28 filed concurrently herewith.

1 indispensable” in the treatment of a crochet-knit Missoni zig-zag, so the limiting
2 doctrines of merger and scènes à faire make these elements unprotectable in order to
3 keep Star from monopolizing a basic design motif it claims to own.

4 The remainder of Star’s claim comes down to color scheme; but plaintiff’s
5 color scheme is not even substantially similar to defendants’ product, much less
6 “virtually identical,” which is the correct standard here. As the Supreme Court held
7 in *Feist*, it is possible to obtain copyright in an original selection and arrangement of
8 otherwise unprotectable elements (in *Feist*, the layout of a phone book full of
9 unprotectable facts), but such copyrights are said to be “thin.” *Feist*, 499 U.S. at
10 349. But for “thin” copyrights, the test for infringement is made harder; the standard
11 for similarity is raised to “virtual identity.” *Satava*, 323 F.3d at 812 (“Satava
12 possesses a thin copyright that protects against only virtually identical copying.”);
13 citing *Ets Hokin II*, 323 F.3d at 766 (“When we apply the limiting doctrines,
14 subtracting the unoriginal elements, Ets Hokin is left with ... a ‘thin’ copyright,
15 which protects against only virtually identical copying.”); *Apple Computer*, 35 F.3d
16 at 1439 (“When the range of protectable expression is narrow, the appropriate
17 standard for illicit copying is virtual identity.”). Here, if we are considering *color*
18 *selection* (colors themselves are obviously not individually protectable; nobody
19 owns the color red) as part of the claim, plaintiff’s design and defendants’ product
20 are clearly not virtually identical, or even substantially similar.

21 Star would have the Court ignore the significant differences between its
22 design and defendants’ product (Opp. at 14:21-15:8½) but that is not the law on the
23 Ninth Circuit. In *Funky Films v. Time Warner Entm’t Co.*, 462 F.3d 1072, 1075
24 (9th Cir. 2006), the Court relied on the “greater, more significant differences”
25 between the two works at issue to conclude there was no substantial similarity,
26 despite acknowledging similarities that, “at first blush,” seemed significant. *Id.*
27 at 1075, 1078-81 (emphasis added). Indeed, Ninth Circuit courts routinely
28 focus on differences between the works in order to find substantial similarity

1 lacking. *See, e.g., Benay*, 607 F.3d at 625 (“many more differences than
2 similarities”); *Lassiter v. Twentieth Century Fox Film Corp.*, 238 F. App’x
3 194, 195 (9th Cir. 2007) (“significant differences and few real similarities”).

4 If one looks at the entirety of the works, major differences are obvious:



20 ***Plaintiff’s Design A (per Compl.)*** ***Defendants’ Product A (per Compl.)***

21 Where, for example, is there an extra-wide segment surrounding a line like this ●
22 on plaintiff’s design? Nowhere. All of plaintiff’s zig-zags are more or less of
23 uniform thickness. Defendants’ product, by contrast, has zig-zags of
24 approximately 3 or 4 different thicknesses. By undersigned counsel’s count, if
25 one starts at the top and works down on plaintiff’s design, there are
26 approximately 57 different-colored horizontal lines before the pattern repeats.
27 By contrast, on defendants’ design, there are only approximately 13 different-
28 colored horizontal lines before the pattern repeats. Especially given the limited

1 range of artistic expression available to someone trying to do a Missoni-look
 2 zig-zag design, these key differences defeat substantial similarity. *See Funky*
 3 *Films*, 462 F.3d at 1075, 1078-81; *Benay*, 607 F.3d at 625.

4 In short, Star fails to carry its burden of establishing virtual identity or
 5 even substantial similarity between any protectable elements in its design and
 6 the defendants' products. Star's claim to a supposedly original arrangement of
 7 zig-zags ultimately reduces down to an attempt to monopolize a ubiquitous
 8 design motif, specifically, the Missoni zig-zag, which the doctrines of merger
 9 and scènes à faire prohibit it from doing. Further, there are significant
 10 differences between Star's design and defendants' product, which
 11 independently defeats substantial similarity.

12
 13 **III. THERE IS NO GOOD REASON WHY COURTS IN THE NINTH**
 14 **CIRCUIT SHOULD APPLY ONE STANDARD FOR LITERARY CASES**
 15 **BUT A DIFFERENT STANDARD IN FABRIC CASES**

16 Star argues that "the Ninth Circuit 'has expressed a certain disfavor for
 17 summary judgment on questions of substantial similarity.'" *Pasillas v. McDonald's*
 18 *Corp.*, 927 F.2d 440, 442 (9th Cir. 1991).'" Opp. at 5:13-15. That observation may
 19 have been correct in 1991. But in the more than quarter century since then, the
 20 Ninth Circuit has "frequently affirmed summary judgment in favor of copyright
 21 defendants on the issue of substantial similarity," *Benay*, 607 F.3d at 624 (9th Cir.
 22 2010).¹⁶ The same is true when the case is dismissed on the pleadings.¹⁷

23 ¹⁶E.g., *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042 (9th Cir. 1994)
 24 (affirming grant of summary judgment to defendant due to lack of substantial
 25 similarity); *Rice v. Fox Broad. Co.*, 330 F.3d 1170 (9th Cir. 2003) (same); *Funky*
 26 *Films, Inc. v. Time Warner Entm't Co., L.P.*, 462 F.3d 1072 (9th Cir. 2006) (same);
 27 *Benay v. Warner Bros. Entm't*, 607 F.3d 620 (9th Cir. 2010) (same); *Idema v.*
 28 *Dreamworks, Inc.*, 162 F. Supp. 2d 1129 (C.D. Cal. 2001) (granting defendant's
 motion for summary judgment due to lack of substantial similarity) *aff'd in relevant*
part by 90 F. App'x 496 (9th Cir. 2003), *as amended on denial of reh'g* (Mar. 9,
 2004); *Milano v. NBC Universal, Inc.*, 584 F. Supp. 2d 1288 (C.D. Cal. 2008)

1 The tendency of courts within the Ninth Circuit to dismiss copyright claims
2 for lack of substantial similarity on a dispositive motion is particularly pronounced
3 in what are called “literary infringement” or ‘a Hollywood-studio-stole-my-idea-for-
4 a-movie’ type cases. Of this phenomenon, one commentator noted in 2014,

5 “A common sequel to the latest hit motion picture or television series is
6 a lawsuit asserting copyright infringement, *almost invariably ending*
7 *with a pretrial ruling that the plaintiff failed to show substantial*
8 *similarity as matter of law. In the Ninth Circuit, no type of claim is*
9 *dismissed with greater regularity or dispatch* than those asserting that a
10 popular work of entertainment has infringed a literary copyright: *in the*
11 *past 35 years, Ninth Circuit courts have allowed only three such cases*
12 *to avoid summary dismissal, and no case has avoided it since 2002.”*

11 R. Helfing, “Substantial Similarity in Literary Infringement Cases: A Chart for
12 Turbid Waters” 21 UCLA Ent. L. Rev. 1 at p. 2 (2014) (emphasis added). Further,

13 “the courts have continued the virtually automatic rejection of literary
14 infringement claims under extrinsic test scrutiny. They do so, in part, by
15 doggedly dissecting works to reach the continually renewing discovery
16 that the individual elements of similarity are not entitled to protection.”

16 *Id.* at 22-23.

17
18 (granting defendant’s motion for summary judgment due to lack of substantial
19 similarity); *Bernal v. Paradigm Talent & Literary Agency*, 788 F. Supp. 2d 1043
20 (C.D. Cal. 2010) (same); *Lassiter v. Twentieth Century Fox Film Corp.*, 238 F.
21 App’x 194 (9th Cir. 2007) (unpublished) (affirming grant of summary judgment to
22 defendant due to lack of substantial similarity); *Mestre v. Vivendi Universal U.S.*
23 *Holding Co.*, 273 F. App’x 631 (9th Cir. 2008) (same); *Walker v. Viacom Int’l, Inc.*,
24 362 F. App’x 858 (9th Cir. 2010) (same).

23 ¹⁷ *Shame on You Prods., Inc. v. Elizabeth Banks*, 120 F. Supp. 3d 1123 (C.D. Cal.
24 2015) (granting defendant’s motion to dismiss due to lack of substantial
25 similarity), *aff’d sub nom.*, *Shame on You Prods., Inc. v. Banks*, 690 F. App’x. 519
26 (9th Cir. 2017); *Thomas v. Walt Disney Co.*, 337 F. App’x 694 (9th Cir. 2009)
27 (unpublished) (affirming grant of motion to dismiss due to lack of substantial
28 similarity); *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124 (C.D. Cal. 2007)
(granting defendant’s motion to dismiss due to lack of substantial similarity); *Wild v.*
NBC Universal, Inc., 788 F. Supp. 2d 1083 (C.D. Cal. 2011) (same).

1 In its opposition, Star argues that the analytic-dissection approach that so
 2 commonly leads to early dismissal of suspect claims in the ‘Hollywood-stole-my-
 3 movie’ context should not apply to 2-d artwork. Yet Star fails to present a
 4 convincing argument—or even to really attempt to explain—*why* its fabric cases
 5 should be waved on through to trial after clearing a special, easier standard than the
 6 one applied in literary infringement cases. And there is no good reason. The
 7 binding precedents that Courts within this district commonly follow in Hollywood
 8 cases apply with equal force to cases brought against the fashion industry.
 9 Moreover, a Judge is no better or worse equipped to dissect and analyze a plaintiff’s
 10 copyrighted fabric design and compare that to a defendant’s garment than he or she
 11 is to read a plaintiff’s script and watch a defendant’s movie. *Sometimes* expert
 12 testimony *may* be helpful in both types of cases; but it really is not necessary on a
 13 design as straightforward and ubiquitous as a Missoni-style zig-zag.

14 Accordingly, this Court should do what *Aeropostale* says it must, and
 15 “distinguish protectible from unprotectible elements and ask only whether the
 16 protectible elements in two works are substantially similar.” *Aeropostale*, 676 F.3d
 17 at 849. And in so doing, this Court should ‘follow the script’ of Ninth Circuit
 18 opinions like *Benay*, *Funky Films*, *Rice*, *etc.* (see fns. 16-17, above), and conclude
 19 that the plaintiff here has failed, as a matter of law, to pass the extrinsic test.

20
 21 **IV. STAR HAS ADMITTED AWAY ITS CLAIM AND FAILS TO IDENTIFY**
 22 **NEW FACTS THAT WOULD ESTABLISH EXTRINSIC SIMILARITY**
 23 **SO LEAVE TO AMEND SHOULD BE DENIED**

24 Star only reluctantly retreated from its initial position, which it held
 25 throughout the meet and confer process, of “refusing” to articulate what is
 26 supposedly original about its designs. But even if it were allowed to amend and
 27 include the new textual descriptions of the supposedly original aspects of its design,
 28 or include the misleading, “slightly-enlarged” photo excerpts it now relies upon in
 opposition, its claim would still fail. Star has effectively admitted that its claim here

1 is based on nothing more than trying to monopolize a stock element, specifically, the
2 Missoni zig-zag. Star points to nothing that is not “inevitable, given the shared
3 concept or idea” of doing a Missoni-style zig-zag print in crochet-knit. *Ets-Hokin II*,
4 323 F.3d at 765-66. Other than the arguments already raised in the opposition,
5 which constitute binding judicial admissions that Star cannot amend around, Star
6 points to no additional, specific facts it would or could allege to try and save the day.

7 Leave to amend need not be given when amendment would be futile. See
8 *Ventress v. Japan Airlines*, 603 F.3d 676, 680 (9th Cir 2010). “[F]utility includes
9 the inevitability of a claim’s defeat on summary judgment.” *Roth v. Garcia-*
10 *Marquez*, 942 F.2d 617, 628–29 (9th Cir. 1991); quoting *Johnson v. American*
11 *Airlines, Inc.*, 834 F.2d 721, 724 (9th Cir. 1987).

12 Here, amendment would be futile, so leave to amend should be denied.

13
14 **V. CONCLUSION**

15 For all of the foregoing reasons, Zulily respectfully requests that the Court
16 grant partial judgment on the pleadings in its favor on the claim for infringement as
17 to Subject Design A.

18
19 Respectfully submitted,

GERARD FOX LAW, P.C.

20
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BY: /s/ Morgan E. Pietz

22 Morgan E. Pietz
23 Timothy G. Lamoureux
24 Trevor C. Maxim
25 *Attorneys for Defendant*
26 *ZULILY, LLC*