UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES - GENERAL

Case No.	CV 17-8358 PSG (MRWx)	Date	April 17, 2018
Title	Star Fabrics, Inc. v. Zulily, LLC et al.		

Present: The Honorable	Philip S. Gutierrez, United States District Judge

Wendy Hernandez	Not Reported
Deputy Clerk	Court Reporter
Attorneys Present for Plaintiff(s):	Attorneys Present for Defendant(s):
Not Present	Not Present

Proceedings (In Chambers): Order GRANTING Defendant's motion for partial judgment on the pleadings

Before the Court is a motion for partial judgment on the pleadings filed by Defendant Zulily, LLC ("Zulily"). *See* Dkt. # 23 ("*Mot.*"). Plaintiff Star Fabrics, Inc. ("Star") opposes the motion, *see* Dkt. # 30 ("*Opp.*"), and Zulily replied, *see* Dkt. # 37 ("*Reply*"). The Court finds the matter appropriate for decision without oral argument. *See* Fed. R. Civ. P. 78; L.R. 7-15. Having considered the moving papers, the Court **GRANTS** Zulily's motion.

I. Background

Star owns an original two-dimensional artwork used for purposes of textile printing entitled 37493 ("Subject Design A" or "Design A"), which it asserts is registered with the United States Copyright Office. *See Complaint*, Dkt. # 1 ("*Compl.*"), ¶ 14. Star "widely disseminated fabric bearing Subject Design A to numerous parties in the fashion and apparel industries." *Id.* ¶ 15.

On November 15, 2017, Star filed a complaint in which it alleges that various defendants, Zulily included, infringed its copyright in Subject Design A. Specifically, Star claims that Zulily "sold and/or distributed fabric and/or manufactured or caused to be manufactured garments featuring a design substantially similar to Subject Design A"; this allegedly infringing fabric ("Subject Product A" or "Product A") was purportedly produced without Star's authorization. *Id.* ¶ 16. Star provides a side-by-side comparison of its Subject Design A and Zulily's allegedly infringing Subject Product A:

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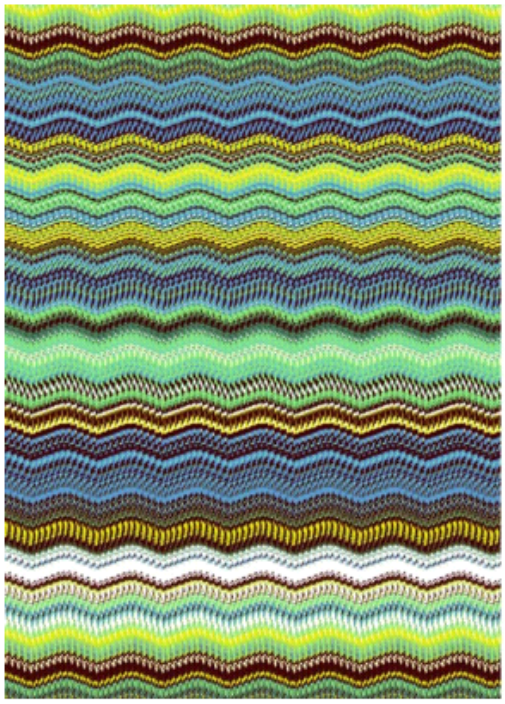
Subject Design A **Subject Product A**



Id. ¶ 17.

Zulily now moves for partial judgment on the pleadings as to the infringement claim relating to Subject Design A, arguing that it "fails the Ninth Circuit's extrinsic test for substantial similarity as a matter of law and should therefore be dismissed." *Mot.* 6:2–4.

II. Legal Standard

Federal Rule of Civil Procedure 12(c) provides that "[a]fter the pleadings are closed—but early enough not to delay trial—a party may move for judgment on the pleadings." Fed. R. Civ. P. 12(c). A Rule 12(c) motion is "functionally identical" to a motion under Rule 12(b)(6) and "'the same standard of review' applies to motions brought under either rule." *Cafasso v. General Dynamics C4 Sys., Inc.*, 637 F.3d 1047, 1054 n. 4 (9th Cir. 2011) (quoting *Dworkin v. Hustler Magazine Inc.*, 867 F.2d 1188, 1192 (9th Cir. 1989)). Thus, on a Rule 12(c) motion, all material allegations of the non-moving party must be accepted as true and construed in the light most favorable to that party. *See Hal Roach Studios, Inc. v. Richard Feiner & Co., Inc.*, 896 F.2d 1542, 1550 (9th Cir. 1989). A Rule 12(c) motion is properly granted if "the moving party clearly establishes on the face of the pleadings that no material issue of fact remains to be resolved and that it is entitled to judgment as a matter of law." *Id.* Although detailed factual

allegations are not required to survive a motion under Rule 12(b)(6) or Rule 12(c), a complaint that "offers 'labels and conclusions' or 'a formulaic recitation of the elements of a cause of action will not do.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007)). Rather, the complaint must allege sufficient facts to support a plausible claim to relief. *See Iqbal*, 556 U.S. at 678.

III. Discussion

At the outset, the Court notes that both parties expend a considerable amount of ink recounting various purported slights and frustrations stemming from the meet-and-confer process, as well as accusing each other of vexatious litigation practices. *See, e.g.*, *Mot.* 11:8–12:17; *Opp.* 2:1–4:28. The Court is not interested in such allegations, and, cognizant that on a motion such as this "the scope of review . . . is limited to the contents of the complaint," *Marder v. Lopez*, 450 F.3d 445, 448 (9th Cir. 2006), will not consider them in ruling on Zulily's motion.

To establish copyright infringement, a plaintiff must prove "(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., Inc.*, 499 U.S. 340, 361 (1991). A plaintiff can establish copying by "showing that defendant had access to plaintiff's work and that the two works are substantially similar in idea and in expression of the idea." *Smith v. Jackson*, 84 F.3d 1213, 1218 (9th Cir. 1996) (internal quotation marks omitted). When the works at issue are, as here, attached to the complaint, a defendant may contest substantial similarity on a motion to dismiss. *See Christianson v. West Pub. Co.*, 149 F.2d 202, 203 (9th Cir. 1945) ("There is ample authority for holding that when the copyrighted work and the alleged infringement are both before the court, capable of examination and comparison, non-infringement can be determined on a motion to dismiss."); *Shame on You Prods., Inc. v. Banks*, 120 F. Supp. 3d 1123, 1171 (C.D. Cal. 2015) ("The court [] concludes that there is no substantial similarity between plaintiff's and defendants' works as a matter of law, and that [defendants'] motion to dismiss [plaintiff's] copyright infringement claim must be granted."). This extends to infringement claims relating to works of visual art. *See Christianson*, 149 F.2d at 203 (dismissing claim for copyright infringement of map on motion to dismiss); *Cory Van Rijn, Inc. v. California Raisin Advisory Bd.*, 697 F. Supp. 1136, 1145 (E.D. Cal. 1987) (dismissing claim for copyright infringement of anthropomorphic raisin characters on motion to dismiss).

Courts within the Ninth Circuit employ a two-part analysis—an extrinsic test and an intrinsic test—to determine whether two works are substantially similar. *See Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002). "The 'extrinsic test' is an objective comparison of specific expressive elements" that "focuses on articulable similarities" between

the works. *Id.* (quoting *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994)). "The 'intrinsic test' is a subjective comparison that focuses on 'whether the ordinary, reasonable audience' would find the works substantially similar in the 'total concept and feel of the works.'" *Cavalier*, 297 F.3d at 822 (quoting *Kouf*, 16 F.3d at 1045).[1]

To begin the extrinsic test, the Court must first filter out the unprotectable elements of Subject Design A. *See Mattel, Inc. v. MGA Entm't, Inc.*, 616 F.3d 904, 916 (9th Cir. 2010) (holding that "[t]he district court [erred] in failing to filter out all the unprotectable elements" from the work at issue because "a finding of substantial similarity between two works can't be based on similarities in unprotectable elements"); *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 849 (9th Cir. 2012) ("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."). Zulily notes, correctly, that under the Copyright Act, ideas are not protectable. *See* 17 U.S.C. § 102(b) ("In no case does copyright protection for an original work of authorship extend to any idea . . ."). Two related doctrines are particularly important to Zulily's motion: merger and scènes à faire. The Ninth Circuit has described these doctrines as follows:

> 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 the underlying unprotectable idea.

Ets-Hokin v. Skyy Spirits, Inc., 225 F.3d 1068, 1082 (9th Cir. 2000) ("*Ets-Hokin I*") (citation omitted).

Here, Zulily argues that Subject Design A's use of zig-zags is an unprotectable element. It premises this contention, at least in part, on its argument that the "distinctive zig-zag design[]" originated with the Missoni fashion brand, which became well known for this design in the 1960s. *Mot.* 12:18–13:28. The Court cannot consider this argument or the evidence supplied by Zulily in support of it—it goes beyond the contents of the complaint in such a way that would be

[1] The Court can focus only on the extrinsic test on this motion. *See Funky Films, Inc. v. Time Warner Entm't Co., L.P.*, 462 F.3d 1072, 1077 (9th Cir. 2006) ("[C]ourts apply only the extrinsic test; the intrinsic test, which examines an ordinary person's subjective impressions of the similarities between two works, is exclusively the province of the jury.").

appropriate for consideration on a motion for summary judgment but not a motion for judgment on the pleadings—but the alleged Missoni connection is not needed for the Court to agree with Zulily that the zig-zags are unprotectable. "[F]amiliar symbols or designs" like zig-zags "are not subject to copyright." 37 C.F.R. § 202.1. They are the sort of expression that is "standard, stock, or common to a particular subject matter or medium"—in this case, fabric design—and is hence "not protectable under copyright law." *Satava v. Lowry*, 323 F.3d 805, 810 (9th Cir. 2003). Since there are only a "limited number of ways" to depict zig-zags on fabric, *L.A. Printex*, 676 F.3d at 851, "the range of protectable expression is narrow, [and] the appropriate standard for illicit copying is virtual identity." *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 766 (9th Cir. 2003) ("*Ets-Hokin II*") (quoting *Apple Comput., Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1439 (9th Cir. 1994)).

Zulily relies heavily on *Ets-Hokin II*, in which the Ninth Circuit applied the merger and scènes à faire doctrines to determine that an infringement claim was precluded as to two similar photographs. The court noted that though the photographs were "indeed similar, their similarity is inevitable, given the shared concept, or idea, of photographing the Skyy bottle. When we apply the limiting doctrines, subtracting the unoriginal elements, Ets–Hokin is left with only a 'thin' copyright, which protects against only virtually identical copying." *Ets-Hokin II*, 323 F.3d at 766. It further determined that the allegedly infringing photographs were "not virtually identical to those of Ets–Hokin. Indeed, they differ[ed] in as many ways as possible within the constraints of the commercial product shot. The lighting differ[ed]; the angles differ[ed]; the shadows and highlighting differ[ed], as [did] the reflections and background. The only constant [was] the bottle itself." *Id.*

The Court finds the analogy to *Ets-Hokin II* persuasive. Here, Star similarly has only a thin copyright, because the zig-zag pattern constitutes a shared concept that must be subtracted for purposes of the extrinsic test. "As far as Zulily can tell"—and the Court agrees—"nothing about Subject Design A is conceivably original, except, perhaps, the color selection," which is vastly dissimilar to the color scheme of Subject Pattern A and hence *not* "virtually identical." *Mot.* 20:21–25. Therefore, Design A and Product A are *not* substantially similar: once the unprotectable zig-zag element is filtered out from Design A, it does not bear a substantial similarity to Product A.

In opposition, Star points to its copyright registration in Subject Design A and argues that "Zulily bears the burden of disproving either the originality or copyright protectability of the design." *Opp.* 5:20–7:10. However, Zulily is not challenging the validity of that copyright registration, and so the presumption of validity to which Star refers is irrelevant here. Star also mischaracterizes several cases. For example, it asserts that "the Supreme Court recently held that infringement may lie from copying garments featuring nothing more than a series of lines,

zig-zags, and color blocks having much less originality than Design A," *Opp.* 10:7–9, and then cites to *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017). However, in that decision, the Supreme Court merely held that designs of cheerleading uniforms are the proper subject matter for copyright protection; it explicitly declined to find that the designs themselves were in fact protectable. *See id.* at 1012 n. 1 ("We do not today hold that the surface decorations are copyrightable. We express no opinion on whether these works are sufficiently original to qualify for copyright protection, or on whether any other prerequisite of a valid copyright has been satisfied.") (citation omitted). Star also argues that the abstraction-filtration test that the Court undertook above was recently rejected by the Supreme Court and is "inapplicable to two-dimensional artwork infringement cases." *Opp.* 11:21–12:7. However, in the case cited, *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962 (2014), the Supreme Court only considered whether the equitable doctrine of laches applies to copyright infringement claims; although it noted in passing that, in such cases, "adjudication will often turn on the factfinder's direct comparison of the original and the infringing works, *i.e.*, on the factfinder's 'good eyes and common sense,'" it neither abrogated the tests described in this order nor suggested that they cannot be applied to two-dimensional designs. *Id.* at 1977. Lastly, in support of this same contention, Star cites to *King Zak Industries, Inc. v. Toys 4 U USA Corp.*, No. 16-CV-9676 (CS), 2017 WL 6210856 (S.D.N.Y. Dec. 8, 2017), in which the court declined to dissect the work at issue for purposes of establishing similarity. *See id.* at *5–6. However, this result is attributable to the fact that the Southern District of New York is governed by the Second Circuit, which has "disavowed" such an approach. *Id.* at *6. The Ninth Circuit has expressly stated that its own approach in this context differs from the Second Circuit's. *See L.A. Printex*, 676 F.3d at 850 (noting that "the Second Circuit's 'ordinary observer' and 'more discerning ordinary observer' tests differ somewhat from our two-part extrinsic/intrinsic test for substantial similarity").[2]

Star also attempts to characterize Design A as more than a series of unprotected zig-zags with a distinctive color scheme, noting that, for example "both designs feature a zig-zag made up of black left to right back-slashes against a crème background." *Opp.* 14:6–16. However, Zulily notes in its reply that this particular pattern is a "stock element[] standard in textiles that have a crochet-knit type construction or look"; "[t]he description . . . simply describes how crochet-knit fabrics are constructed." *Reply* 13:23–28. "[W]hen similar features of a work are '*as a practical matter indispensable*, or at least standard, in the treatment of a given idea, they are treated like ideas and are therefore not protected by copyright.'" *Ets-Hokin II*, 323 F.3d at 765–66 (quoting *Apple Comput.*, 35 F.3d at 1444) (emphasis added). The Court agrees with Zulily that the facets of Design A that Star claims are protectable are in fact inevitable traits of crochet-knit fabrics

[2] Although in that case the Ninth Circuit also noted that the Second Circuit's approach "is persuasive" in "the context of fabric designs," and that it "guide[d its] comparison of the designs" in that case, it did not go so far as to mandate this approach for fabric designs. *L.A. Printex*, 676 F.3d at 850.

that are no more protectable than the zig-zags themselves. Therefore, Product A does not bear a substantial similarity to any *protectable* elements of Design A, and so a copyright infringement claim cannot be maintained.

IV. Leave to Amend

Star seeks leave to amend. *See Opp.* 15:23–16:7.

Whether to grant leave to amend rests in the sound discretion of the trial court. *See Bonin v. Calderon*, 59 F.3d 815, 845 (9th Cir. 1995). The Court considers whether leave to amend would cause undue delay or prejudice to the opposing party, and whether granting leave to amend would be futile. *See Sisseton-Wahpeton Sioux Tribe v. United States*, 90 F.3d 351, 355 (9th Cir. 1996). Generally, dismissal without leave to amend is improper "unless it is clear that the complaint could not be saved by any amendment." *Jackson v. Carey*, 353 F.3d 750, 758 (9th Cir. 2003).

Here, Star seeks leave to amend to "more clearly plead" its "ownership of a valid copyright or copying of protectable expression." *Opp.* 15:26–28. However, as mentioned, the validity of Star's copyright is not in dispute, and so amendment on that issue is irrelevant. As for the protectable expression, the Court concludes that amendment would be futile. Star had the opportunity to present these arguments in its opposition, and did so. However, Star's contentions do not change the Court's determination that once unprotectable elements are filtered out, there is not a substantial similarity between Design A and Product A. Because Star is unable to mount arguments to persuade the Court otherwise, amendment would be futile. Therefore, the Court **DENIES** Star leave to amend.

V. Conclusion

For the foregoing reasons, the Court **GRANTS** Zulily's motion for partial judgment on the pleadings as to Star's copyright infringement claim relating to Subject Design A (37493).

IT IS SO ORDERED.