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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

#29/30/31

CIVIL MINUTES - GENERAL

Case No.	CV 08-6314 PSG (VBKx)	Date	July 16, 2009
Title	Arthur Metrano v. Twentieth Century Fox Film Corp., et al.		

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

Wendy K. Hernandez	Not Present	n/a
Deputy Clerk	Court Reporter	Tape No.

Attorneys Present for Plaintiff(s):	Attorneys Present for Defendant(s):
Not Present	Not Present

Proceedings: (In Chambers) Order on Motions to Dismiss and to Strike

Before the Court are Defendant Fox's motions to dismiss and to strike portions of the operative complaint. The Court finds the matter appropriate for decision without oral argument. Fed. R. Civ. P. 78; L.R. 7-15. After considering the moving and opposing papers, the Court GRANTS in part and DENIES in part the motion to dismiss, and GRANTS the motion to strike.

I. Background

Arthur Metrano ("Plaintiff") is an entertainer who claims to be famous for his one-man comedy routine known as "The Amazing Metrano," which he has performed since 1969. In "The Amazing Metrano," Plaintiff hums a tune while moving his hands around as if performing magic tricks. According to Plaintiff, the routine pokes fun at magic acts and their performers. On September 25, 2008, Plaintiff filed suit against Twentieth Century Fox Film Corporation ("Fox"), Seth McFarlane, Steve Callaghan, and Alex Borstein,[1] alleging that they misappropriated "The Amazing Metrano" by portraying an animated Jesus Christ performing a version of the routine in front of a group of onlookers in *Stewie Griffin: The Untold Story* ("*Stewie*"), an animated motion picture based on the popular television program *Family Guy*. Plaintiff's second amended complaint ("SAC") asserts causes of action for copyright infringement and violation of the Lanham Act. Fox now moves to dismiss the SAC.

II. Legal Standard

[1] Plaintiff has not served MacFarlane, Callaghan, or Borstein.

A. Motion to Dismiss

Pursuant to Federal Rule of Civil Procedure 12(b)(6), a defendant may move to dismiss a cause of action if the plaintiff fails to state a claim upon which relief can be granted. In evaluating the sufficiency of a complaint under Rule 12(b)(6), courts must be mindful that the Federal Rules require only that the complaint contain "a short and plain statement of the claim showing that the pleader is entitled to relief." Fed. R. Civ. P. 8(a)(2). Although a complaint does not need detailed factual allegations to survive a 12(b)(6) motion to dismiss, "a plaintiff's obligation to provide the 'grounds' of his 'entitle[ment] to relief' requires more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do." *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555, 127 S. Ct. 1955, 167 L. Ed. 2d 929 (2007) (internal citations omitted). Rather, the complaint must allege sufficient facts to raise a right to relief above the speculative level. *Id.* (citing 5 C. Wright & A. Miller, Federal Practice and Procedure § 1216, pp. 235-36 (3d ed. 2004)). However, detailed and "[s]pecific facts are not necessary; the statement need only give the defendant fair notice of what the . . . claim is and the grounds upon which it rests." *Erickson v. Pardus*, 551 U.S. 89, 94, 127 S. Ct. 2197, 167 L. Ed. 2d 1081 (2007) (citation and internal quotation marks omitted).

In deciding a 12(b)(6) motion, a court must accept all factual allegations in the complaint as true. *Leatherman v. Tarrant County Narcotics Intelligence and Coordination Unit*, 507 U.S. 163, 164, 113 S. Ct. 1160, 122 L. Ed. 2d 517 (1993). Courts must also construe all reasonable inferences in the light most favorable to the plaintiff. *See Broam v. Bogan*, 320 F. 3d 1023, 1028 (9th Cir. 2003). To further the inquiry, courts may consider documents outside the pleadings without the proceeding turning into summary judgment. *See Branch v. Tunnell*, 14 F.3d 449, 453 (9th Cir. 1994), *overruled on other grounds by Galbraith v. County of Santa Clara*, 307 F.3d 1119 (9th Cir. 2002). However, the Court may only consider these documents if their authenticity is not questioned and the complaint either refers to them or necessarily relies upon them. *See id.; see also Parrino v. FHP, Inc.*, 146 F.3d 699, 706 (9th Cir. 1998), *superceded by statute on other grounds.*

B. Motion to Strike

Rule 12(f) of the Federal Rules of Civil Procedure provides that "the court may order stricken from any pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." "Immaterial matter is that which has no essential or important relationship to the claim for relief " and "[i]mpertinent matter consists of statements that do not pertain, and are not necessary, to the issues in question." *Fantasy, Inc. v. Fogerty*, 984 F.2d 1524, 1527 (9th

Cir. 1993) (internal citations omitted), *rev'd on other grounds*, 510 U.S. 517, 114 S. Ct. 1023, 127 L. Ed. 2d 455 (1994). "The function of a 12(f) motion to strike is to avoid the expenditure of time and money that must arise from litigating spurious issues by dispensing with those issues prior to trial." *Sidney-Vinstein v. A.H. Robins Co.*, 697 F.2d 880, 885 (9th Cir. 1983).

III. Discussion

A. Motion to Dismiss

i. Copyright Claim

Fox argues that, even assuming *arguendo* that Plaintiff possess a valid copyright in "The Amazing Metrano," his copyright infringement claim is barred by the doctrine of fair use. The Copyright Act of 1976 protects the "fair use" of another's copyrighted work "for purposes such as criticism [or] comment." 17 U.S.C. § 107. In determining whether a defendant's alleged infringement constitutes "fair use," courts must consider: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for the copyrighted work. *Id*. Because fair use is an affirmative defense, Fox bears the burden of demonstrating it in the instant case. *Campbell v. Acuff-Rose Music, Inc*., 510 U.S. 569, 590, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (1994).

Fair use is a mixed question of law and fact. *Harper & Row Publishers, Inc. v. Nation Enters*., 471 U.S. 539, 560, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985). "The Court may conduct a fair use analysis, as a matter of law, where the facts are presumed or admitted." *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962, 967 (C.D. Cal. 2007). Here, Fox has submitted a full-length copy of *Stewie* on DVD (Ex. B), a DVD featuring Plaintiff performing "The Amazing Metrano" (Ex. A), and a DVD with the scene from *Stewie* that is at issue (Ex. C). Although these documents were not physically attached to Plaintiff's complaint, the SAC necessarily relies on them, and Plaintiff does not contest their authenticity. Accordingly, the Court may consider them without turning the instant motion into one for summary judgment. *Parrino*, 146 F.3d at 705-06. Further, the Court takes judicial notice of Exhibits 1-3 pursuant to Federal Rule of Evidence 201(b). *See Food Lion, Inc. v. Capital Cities/ABC, Inc*., 964 F. Supp. 956, 964 n.5 (M.D.N.C. 1997) (taking judicial notice of contents of videotape that was publicly disseminated and therefore "capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned"); *see also Burnett*, 491 F. Supp. 2d at 966.

(1) Purpose & Character of the Use

The first factor in the fair use analysis, the "purpose and character of the use," looks to "whether the new work merely supersedes the objects of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message, in other words, whether and to what extent the new work is transformative." *Campbell*, 510 U.S. at 579. One example of a "transformative" use is parody, "a literary or artistic work that imitates the characteristic style of an author or a work for comic effort or ridicule." *Id*. at 580. The Supreme Court has recognized that parody "has an obvious claim to transformative value" because "it can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one." *Id*. at 579. To lay claim to fair use protection, a parodist must use "at least some elements of a prior artist's composition to create a new one that, at least in part, comments on that author's work." *Id*. at 580. "If, on the contrary, the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another's work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality, loom larger." *Id.*

It is irrelevant whether a parody is successful, funny, or in good taste. *See id.* at 582-83; *Burnett*, 491 F. Supp. 2d at 965. Rather, "[t]he threshold question when fair use is raised in defense of parody is whether a parodic character may reasonably be perceived." *Campbell*, 510 U.S. at 582. For example, in *Campbell*, the Supreme Court found that the hip hop group 2 Live Crew's rendition of "Pretty Woman" was a parody of the original because it could "be taken as a comment on the naivete of the original of an earlier day, as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies." *Id*. at 583.

In the instant case, Fox's motion picture *Stewie* includes a short clip (less than 20 seconds) in which the animated character Stewie describes having traveled in time and seen Jesus Christ. Exs. B, C. He remarks that Christ's "abilities might have been exaggerated a bit." Ex. C. Then a scene appears in which an animated Jesus performs a routine by humming a tune and moving his hands around as if performing magic. Ex. C. The music and hand gestures are nearly identical to those Plaintiff uses in "The Amazing Metrano." Exs. A, C.

Defendant argues that its use of "The Amazing Metrano" constitutes a parody because it was used to "make Plaintiff and his routine appear ridiculous." It contends that this case is highly analogous to *Burnett*. In that case, the actress Carol Burnett brought suit against Fox for

copyright infringement based on an episode of *Family Guy* in which an animated figure resembling the "Charwoman" from the Carol Burnett Show was depicted as a janitor working amid blow-up dolls and "XXX" videos in a adult store. *Burnett*, 491 F. Supp. 2d at 966. Fox argued that its use of Burnett/the Charwoman was fair use because it was a parody, targeting Burnett's wholesome image. *Id*. at 968. The court agreed, finding that "a parodic character may reasonably be perceived in the Family Guy's use of the Charwoman" because "[t]he episode at issue put a cartoon version of Carol Burnett/the Charwoman in an awkward, ridiculous, crude, and absurd situation in order to lampoon and parody her as a public figure." *Id*. at 969.

There is a key distinction, however, between *Burnett* and the instant case. Here, the butt of the joke in the *Stewie* scene at issue is *not* Plaintiff: it is Jesus and his followers. The scene cannot be "reasonably perceived" as mocking Plaintiff and the popularity of his routine, as Defendant contends. It does not criticize or comment upon Plaintiff's routine or lampoon Plaintiff by depicting him in a new or different way, as did the episode of *Family Guy* in *Burnett*. *See id*. Although the Jesus scene does mimic "The Amazing Metrano," it does not hold *Plaintiff's routine* up to ridicule. *See Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997). Rather, *Stewie* pokes fun at and questions Jesus's purported ability to work miracles. Fox merely used Plaintiff as their uncompensated comedy writer. Because *Stewie* does not constitute a parody of "The Amazing Metrano," the commercial nature of the film further cuts against the fair use defense. *Id*.

(2) The nature of the copyrighted work

The second factor in the fair use analysis recognizes that "creative works are closer to the core of intended copyright production than informational and functional works," and consequently, that fair use is more difficult to establish when the former are copied. *Id.* at 1402. However, "this factor typically has not been terribly significant in the overall fair use balancing." *Id*. In the instant case, Plaintiff's routine is creative, as opposed to informational or functional. Accordingly, this factor also tilts the scale against fair use.

(3) The amount and substantiality of the portion used in relation to the copyrighted work as a whole

The third factor focuses on "the persuasiveness of a parodist's justification for the particular copying done." *Campbell*, 510 U.S. at 586. Although Fox's argument focuses largely on the brevity of the clip which allegedly misappropriates "The Amazing Metrano"—approximately 20 seconds out of an 88-minute long film—the relevant question is

what proportion of the *copyrighted work* has been utilized. *See id.* at 587. Further, "this factor calls for thought not only about the quantity of the materials used, but about their quality and importance, too." *Id*. Here, Fox copied approximately 20 seconds of Plaintiff's routine, reproducing the tune and hand gestures almost exactly. Moreover, Fox's argument that it took "just enough" to make its parody recognizable is unavailing, given that the Court has already determined that *Stewie* is not a parody of "The Amazing Metrano" in a legal sense. Accordingly, this factor also militates against fair use.

(4) The effect of use on the potential market

The final factor the Court must consider is "the extent of market harm caused by the particular actions of the alleged infringer" and "whether unrestricted and widespread conduct of the sort engaged in by the defendant . . . would result in a substantially adverse impact on the potential market for the original." *Id.* at 590. This factor "is undoubtedly the single most important element of fair use."

In the instant case, the Court is unable to properly evaluate this factor on a 12(b)(6) motion. Given the undeveloped factual record and lack of admitted or undisputed facts, the Court is unable to determine whether *Stewie Griffin: The Untold Story* is likely to have an adverse impact on the market for "The Amazing Metrano." *See Browne v. McCain*, 611 F. Supp. 2d 1073, 1078 (C.D. Cal. 2009); *Campbell*, 510 U.S. at 590 ("Since fair use is an affirmative defense, its proponent would have difficulty carrying the burden of demonstrating fair use without favorable evidence about relevant markets.").

In sum, Fox has not established that Plaintiff's copyright claim is barred, as a matter of law, under the fair use doctrine.

ii. Lanham Act Claims

Defendant next argues that Plaintiff's Lanham Act claims fail because *Stewie* is protected by the First Amendment. In *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), the Second Circuit held that the Lanham Act "should be construed to apply to artistic works only where the public interest in avoiding consumer confusion outweighs the public interest in free expression." *Id.* at 999. The Ninth Circuit has adopted the two-part test established in *Rogers* to ensure that First Amendment rights are afforded sufficient protection. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002); *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008). Under the *Rogers* test, "[a]n artistic work's use of a trademark that

would otherwise violate the Lanham Act is not actionable unless the use of the mark has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless it explicitly misleads as to the source or content of the work." *E.S.S.*, 547 F.3d at 1099.

The Ninth Circuit first adopted the *Rogers* test in *MCA Records*, in which Mattel, the maker of "Barbie," sued MCA for trademark infringement based on the title of a song the record company released called "Barbie Girl." 296 F.3d at 899-900; *see also E.S.S.*, 547 F.3d at 1099. The song commented on the values that Barbie supposedly represents. *MCA Records*, 296 F.3d at 902. Applying the two-pronged *Rogers* test, the Court first found that "the use of Barbie in the song title [was] clearly relevant to the underlying work" because the song was about Barbie. *Id*. As for the second prong, however, the Court held that the song title did not "explicitly mislead as to the source of the work" because it did not suggest that it was produced by Mattel. *Id*. "The only indication that Mattel might be associated with the song," reasoned the Court, "is the use of Barbie in the title; if this were enough to satisfy this prong of the *Roger*s test, it would render *Roger*s a nullity." *Id.* Accordingly, Mattel's Lanham Act claim failed as a matter of law.

In *E.S.S.*, the owner of a strip club named "Play Pen Gentlemen's Club" sued the maker of a video game, claiming that the depiction of a club called "Pig Pen" in the game violated the club owner's trademark and trade dress protection under the Lanham Act. 547 F.3d at 1097-98. Applying *Rogers*, the Court held that the inclusion of the "Pig Pen" strip club in the game had "some artistic relevance" to creating a "cartoon-style parody of East Los Angeles." *Id*. at 1100. However, the game did not "explicitly mislead[] as to the source or content of the work" because "[n]othing indicate[d] that the buying public would reasonably have believed that ESS [the club owner] produced the video game or, for that matter, that Rockstar [the video game maker] operated a strip club." *Id*. Further, the game did "not revolve around running or patronizing a strip club." *Id*. Accordingly, the video game maker's use of the club owner's trademark was protected by the First Amendment. *Id*. at 1101.

In the instant case, Fox argues that its alleged use of "The Amazing Metrano" was artistically relevant to *Stewie*, particularly the film's irreverent approach to well-known figures and "human beings' propensity to put them on a pedestal and to exaggerate their abilities." The Court disagrees with Fox's contention that the point of incorporating "The Amazing Metrano" into the film was to compare Plaintiff to Christ; rather, the joke targeted what many people believe to be Jesus's ability to work miracles. Nonetheless, the alleged use of Plaintiff's routine satisfies the *de minimis* requirement that the level of artistic relevance be "above zero." *E.S.S.*, 547 F.3d at 1100. Notably, Plaintiff does not contend otherwise.

Because the alleged use of "The Amazing Metrano" has some artistic relevance to the film, Plaintiff has a viable Lanham Act claim only if the movie was "explicitly misleading" as to Plaintiff's endorsement or sponsorship thereof. *MCA*, 296 F.3d at 902. Nothing indicates, however, that the public would reasonably have believed that Plaintiff, an entertainer known for his one-man comedy routine, produced or sponsored *Stewie*, a full-length film featuring characters from *Family Guy*, a well-known animated series. Further, the Jesus scene "seems quite incidental to the overall story" of the film. *E.S.S.*, 547 F.3d at 1100. The 20-second scene incorporating "The Amazing Metrano" is "unambiguously *not* the main selling point" of *Stewie*. *Id*. at 1101. The Court concludes that Fox's alleged use of "The Amazing Metrano" is not explicitly misleading and is therefore protected by the First Amendment. Accordingly, Plaintiff's Lanham Act claims are DISMISSED with prejudice.

B. Motion to Strike

i. Statutory Damages and Attorneys' Fees

Fox moves the Court to strike Paragraph 19, lines 18-19, and the portion of Plaintiff's prayer for relief seeking an award of attorneys' fees and costs, contending that Plaintiff may not recover such an award because Fox's alleged infringement commenced before Plaintiff registered the material with the U.S. Copyright Office.

The express language of 17 U.S.C. § 412 prohibits an award of statutory damages or attorneys' fees when the initial act of infringement occurred after the effective copyright registration date. The purpose of § 412 is twofold: first, it provides an incentive for copyright owners to register their copyrights promptly, and second, it encourages potential infringers to check the Copyright Office's database. *Derek Andrew, Inc. v. Poof Apparel Corp.*, 528 F.3d 696, 700 (9th Cir. 2008).

In the instant case, Plaintiff alleges that he registered "The Amazing Metrano" with the U.S. Copyright Office effective August 9, 2007. *SAC* ¶ 15. According to the SAC, Fox began distributing *Stewie* to the public on September 25, 2005. Thus, Fox argues, on the face of the complaint, an award of statutory damages or attorneys' fees is prohibited. Plaintiff, on the other hand, contends that Fox began distributing *Stewie* in forms of media other than DVDs after the registration date.

The SAC alleges that Fox began distributing *Stewie* to the public "in various medias and formats, including DVD" on September 25, 2005. *SAC* ¶ 12. Nowhere in the SAC does

Plaintiff allege that distribution in any form of media commenced *after* the effective copyright registration date.

Moreover, Plaintiff's argument that distribution in a different type of media would constitute a new infringement, rather than a continuing one, is unavailing under Ninth Circuit precedent. In *Derek Andrew*, the court held that a plaintiff was precluded from recovering statutory damages for a series of ongoing copyright infringements that began prior to the copyright registration date. 528 F.3d at 701. The plaintiff argued that the defendant's manufacture and distribution of new garments with an infringing hang-tag after copyright registration constituted many separate and distinct infringements. *Id*. The Ninth Circuit rejected that argument, finding "no legally significant difference" between the defendant's pre- and post-registration infringement: "[The defendant] began its infringing activity before the effective registration date, and it repeated the same act after that date each time it used the same copyrighted material." *Id.* Similarly, here, the Court finds that there would be no legally significant difference in Fox's manufacture and distribution of *Stewie* in forms of media other than DVD. Accordingly, because the conduct alleged in the complaint constitutes a continuing infringement which commenced prior to Plaintiff's copyright registration, Plaintiff may not recover statutory damages or attorneys' fees under the Copyright Act. The motion to strike is GRANTED.

ii. Punitive Damages

Fox also requests that the Court strike Paragraph 20, lines 24-28, and the portion of Plaintiff's prayer for relief referring to punitive damages. Plaintiff admits that punitive damages are not available under the Copyright Act and does not oppose this part of the motion. Accordingly, Fox's motion to strike the portions of Plaintiff's SAC referring to punitive damages is GRANTED.

IV. Conclusion

For the foregoing reasons, Defendant's motion to dismiss is DENIED as to Plaintiff's copyright claim and GRANTED as to Plaintiff's Lanham Act claims. The motion to strike is GRANTED. The hearing on this motion is hereby VACATED.

IT IS SO ORDERED.

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