Current Trends in 2016 on Constitutional Intellectual Property and Collection, and Use of Data Issues in Entertainment

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A Minor’s Right to Disavow Contracts
By Shannon Harvey

Britto Central, Inc. vs Craig Redman, Karl Maier Ltd. And Apple Inc.
MINORS’ RIGHT TO DISAVOW CONTRACTS

(General Points and Considerations)

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I. CONTRACTS WITH MINORS, GENERALLY

Technically, a minor can, in fact, enter into a contract; however, with some significant exceptions, a contract made by a minor is voidable. Courts and statutes provide minors with the ability to repudiate (i.e., disavow, void, avoid, disaffirm) the contract at the minor’s discretion. This is largely due to the fact that minors are believed to lack the capacity to enter into contacts.

A minor can formally void a contract by either filing a lawsuit requesting the Court to do so or by raising the affirmative defense of lack of capacity if they have been sued on the contract. Disaffirming may also indirectly occur when the minor states, either in a verbal declaration or by their actions, that they no longer intend to be bound by the terms of the contract to which they are a party.

A minor cannot disavow only a portion of a contract; the contract is considered in its entirety. Additionally, when a minor seeks to disavow a contract he or she must, in theory, return whatever property or value has been received under the contract to the other party. However, if the minor cannot return the consideration received pursuant to the contract because it has been spent, destroyed or damaged he or she may still avoid the contract. Remarkably, even if a minor misrepresents his or her age while signing the contract, this fraudulent action will still not prevent the minor from later avoiding the contract in most states.

The contract must be voided during the minor’s minority status and only for a reasonable time after he or she reaches the age of majority. If they do not disaffirm the contract within a reasonable period of time after, they are considered to have ratified the contract. As stated, the minor must disaffirm the contract agreement within a reasonable amount of time of reaching the age of majority; however, many states do not define “reasonable
time.” Therefore, each case may be viewed on its own accord. In several cases, a three-month delay after attaining the age of majority before giving notice of repudiation was acceptable to courts. In more rare cases, a delay of 29 months may be acceptable. Conversely, courts have held that a three-year post-emancipation delay was unacceptable.

Emancipation may cause an individual to no longer be considered a minor. Therefore, a minor who has been emancipated generally has all the contractual rights and obligations of a person who has reached the age of majority.

Disavowing often occurs with arbitration agreements as minors very often have very little understanding of what arbitration is or what rights they are agreeing to give up.

II. CONTRACTS WITH MINORS IN THE ENTERTAINMENT INDUSTRY

Considering that minors’ right to disaffirm contracts present significant problems in the entertainment industry, many states passed laws to address this issue. Several of which provide mechanisms for court approval of a minor’s entertainment-related contract. This substantially limits the minor's right to disavow.

EXAMPLES

Under California Family Code § 6751, a contract, otherwise valid, of a type described in Cal. Fam. Code § 6750 (i.e. rendering artistic or creative services, disposing of rights pertaining to literary, musical, motion picture, television or dramatic properties, or use of a person's likeness, voice recording, performance, or life story, participating or playing in a sport, and other similar contracts as further enumerated in the code) entered into during minority, cannot be disaffirmed on that ground either during the minority of the person entering into the contract, or at any time thereafter, if the contract has been approved by the superior court in any county in which the minor resides or is employed or in which any party to the contract has its principal office. Approval of the court may be given on petition of any party to the contract, after such reasonable notice to all other parties. Approval of the court given in this circumstance extends to the whole of the contract and all of its terms and provisions, including, but not limited to, any optional or conditional provisions contained in the contract. For the purposes of this court proceeding, a parent or legal guardian entitled to the physical custody, care, and control of the minor at the time of the proceeding shall be considered the minor's guardian ad litem during the proceeding, unless the court determines otherwise. See Cal. Fam. Code § 6751.

Judicial approval of contracts by infant entertainers (i.e. minor entertainers) is also authorized in New York. Pursuant to New York Consolidated Laws Art & Cultural Affairs § 35.03, a contract made by an infant or made by a parent or guardian of an infant or a person who is employed to render services to the infant in connection with such services, may be approved by the supreme court or the surrogate's court where the infant is a resident of New York or the services of the infant are to be performed or rendered in New York. If the contract is so approved the infant may not, either during his minority or upon reaching his majority, disaffirm the contract on the ground of infancy or assert that the parent or guardian lacked authority to make the contract. A contract modified, amended or assigned after its approval under such a judicial proceeding shall
be deemed a new contract. Such approval applies only to performing artists, such as actors, musicians, dancers and professional athletes. This statute aims to provide a degree of certainty for parties contracting with entertainment–industry minors, so that the validity of such contracts is less likely to be litigated. See NY CLS Art & Cult. Affr. § 35.03 for complete provisions and procedures in this law.

In Florida, a contract made by a minor or by a parent or guardian of a minor, or a contract proposed to be so made, involving artistic and creative services and professional sports (and contract types enumerated more fully within Florida Statute §743.08) may be approved by the probate division of the circuit court or any other division of the circuit court that has guardianship jurisdiction, where the minor is a resident of Florida or the services of the minor are to be performed or rendered in Florida. If the contract is so approved, the minor may not, either during his or her minority or upon reaching his or her majority, disaffirm the contract on the ground of minority or assert that the parent or guardian lacked authority to make the contract. A contract modified, amended, or assigned after its approval under such statute shall be deemed a new contract.

In order for the Florida court to approve such contract either a written acquiescence to such contract must be filed in the proceeding by the parent(s) or custodian of the minor, or the court finds that the minor is emancipated, or written approval must be given by the guardian ad litem appointed by the court. Approval of a specific contract pursuant this statute does not remove the disability of nonage for any other contract with the same minor which has not been approved by the court. No contract shall be approved, if the term during which the minor is to perform or render services, including any extensions thereof by option or otherwise, extends for a period of more than three (3) years from the date of approval of the contract. If the contract contains any other covenant or condition which extends beyond such 3 years, the same may be approved if found to be reasonable and for such period as the court may determine. See Fla. Stat. § 743.08.

The Court may withhold its approval of the contract until the filing of a guardianship plan by the parent(s) or legal guardian which shall set forth in detail the minor’s earning and the amount to be set aside and saved for the minor until he or she reaches major or until a time fixed by the court. The judge will determine the proportion of net earning to be set aside as he or she deems to be in the best interest of the minor. Factors such as the financial circumstances of the parent(s) of the minor and whether the minor has any dependents of their own may be considered. In general, if the minor has no dependents the court may not require the setting aside of more than two-thirds of the net earnings. See Fla. Stat. § 743.095.

In addition to judicial approval of contracts, minors in the entertainment industry are also subject to limitations in the number of hours they can work. In California, as one example, minors employed in the entertainment industry may not work more than 8 hours in one day, or more than 48 hours in one week. They may not work before 5 a.m., or after 10 p.m. on any day preceding a school day. On a day not preceding a school day, they may work until 12:30 a.m. of the non school day. See California Labor Code §1308.7.
UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA

BRITTO CENTRAL, INC.,

v. 

CRAIG REDMAN, KARL MAIER, KARL MAIER LTD., and APPLE INC.,

Defendants.

___________________________________/

DEFENDANTS CRAIG REDMAN, KARL MAIER, AND KARL MAIER LTD.’S MOTION FOR JUDGMENT ON THE PLEADINGS

Defendants, CRAIG REDMAN, KARL MAIER, and KARL MAIER LTD. (collectively “C&K”), by and through undersigned counsel, and pursuant to Fed. R. Civ. P. 12(c), file their Motion for Judgment on the Pleadings, and state as follows:

PRELIMINARY STATEMENT

Plaintiff BRITTO CENTRAL, INC. (“Plaintiff”) alleges that it owns all intellectual property rights in visual images created by Romero Britto (the “Britto Images”). See Complaint [DE-1] at ¶2. Plaintiff alleges that some unspecified number of visual images (the “C&K Images”) created by C&K are substantially similar to seven (7) of the Britto Images, in violation of Plaintiff’s rights under the Copyright Act. Id. at ¶¶77-83. Plaintiff alleges further that some unspecified number of the Britto Images serve as unregistered “trade dress” for an indeterminate line of products and services manufactured and provided by third parties under license from Plaintiff. Id. at ¶¶17-21. Plaintiff alleges that some unspecified number of the C&K Images, including one allegedly used for advertising purposes by Defendant APPLE INC. (“Apple”), id.
at ¶33, violate Plaintiff’s asserted trade dress rights in his “distinctive style of artwork,” *id.* at ¶21, by using similar design elements.\(^1\)

**ARGUMENT**

The Plaintiff’s claims should be dismissed pursuant to Fed. R. Civ. P. 12(c). Under Rule 12(c), “[j]udgment on the pleadings is appropriate when there are no material facts in dispute, and judgment may be rendered by considering the substance of the pleadings and any judicially noticed facts.” *Medcomp, Inc. v. United Healthcare Ins. Co.*, 562 Fed. Appx. 754 (11th Cir. 2014), quoting *Hawthorne v. Mac Adjustment, Inc.*, 140 F.3d 1367, 1370 (11th Cir. 1998). A motion for judgment on the pleadings under Fed. R. Civ. P. 12(c) is governed by the same standard as a Rule 12(b)(6) motion to dismiss; on a motion for judgment on the pleadings, a court must make all inferences in favor of the nonmoving party and “must ‘accept the facts alleged in the complaint as true.’” *See Guarino v. Wyeth LLC*, 823 F.Supp.2d 1289, 1291 (M.D. Fla. 2011) (quoting *Bankers Ins. Co. v. Fla. Residential Prop. & Cas. Joint Underwriting Ass’n*, 137 F.3d 1293, 1295 (11th Cir. 1998)).

The Complaint here, specifically including the images that are included in the Complaint and the Answers of Defendants C&K [DE-31, 32], does not “plausibly give rise to an entitlement to relief.” *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. at 1950 (2009). Simply alleging that the C&K Images are substantially similar to the Britto Images, or that Plaintiff has successfully licensed some of its images to third parties to decorate their products and packaging, is not

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1. Plaintiff does not allege infringement of any registered trademark, or of the so-called “BRITTO® Brand,” the latter of which is defined in the Complaint (at ¶15) but does not appear in any of the causes of action.
2. C&K do not here dispute Plaintiff’s ownership of valid copyrights in the works identified as the “Infringed Works” at ¶84 of the Complaint, but reserve the right to challenge ownership and validity if this matter goes forward beyond the instant motion.
3. C&K concede access *arguendo* for purposes of this motion, but without waiving the right to dispute
enough to support a valid cause of action under the Copyright Act, the Lanham Act, the Florida statutes, or common law on which Plaintiff purports to rely.

I. PLAINTIFF’S COPYRIGHT CLAIM MUST BE DISMISSED BECAUSE THE WORKS AT ISSUE ARE NOT SUBSTANTIALLY SIMILAR WITH RESPECT TO PROTECTABLE EXPRESSION

To prevail on a claim of copyright infringement, a plaintiff must show that: (1) it owns a valid copyright,\(^2\) and (2) the defendant copied constituent elements of the work that are original. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991). To show copying, where, as here, “the plaintiff does not have direct proof of copying, the plaintiff may show copying by demonstrating that the defendants had access to the copyrighted work\(^3\) and that the works are ‘substantially similar.’” *Oravec v. Sunny Isles Luxury Ventures, L.C.*, 527 F.3d 1218, 1223 (11th Cir. 2008). Substantial similarity, in turn, requires the Court to determine “both whether the similarities between the works are substantial from the point of view of the lay [observer] and whether those similarities involve copyrightable material.” *Herzog v. Castle Rock Entm’t*, 193 F.3d 1241, 1248 (11th Cir. 1999).\(^4\) Thus, this Court has recently held that “where works contain similarities of only non-protectable elements, there can be no copyright infringement.” *Siever Suarez Architectural Partnership, Inc. v. Arquitectonica Int’l Corp.*, 998 F. Supp. 2d 1340, 1347 (2014).\(^5\) *See also Durham Ind. Inc. v. Tomy Corp.*, 630 F.2d 905, 912 (2d Cir. 1980)(“a general

\(^2\) C&K do not here dispute Plaintiff’s ownership of valid copyrights in the works identified as the “Infringed Works” at ¶84 of the Complaint, but reserve the right to challenge ownership and validity if this matter goes forward beyond the instant motion.

\(^3\) C&K concede access *arguendo* for purposes of this motion, but without waiving the right to dispute access if this matter goes forward.

\(^4\) *See also Beal v. Paramount Pictures Corp.*, 20 F.3d 454, 459 n.4 (11th Cir. 1994) (actionable similarity must be “similarity of expression, *i.e.*, material susceptible to copyright protection”); *Miller’s Ale House, Inc. v. Boynton Carolina Ale House, LLC*, 702 F.3d 1312, 1325 (11th Cir. 2012)(question is whether competing designs are “substantially similar at the level of protected expression”).

\(^5\) *See also 17 U.S.C. § 102(b)(precluding copyright protection for ideas, as opposed to expression); Feist, supra*, 499 U.S. at 350 (copyright “assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.”)
impression of similarity is not sufficient to make out a case of infringement. The only similarity of significance in assessing claims of infringement is similarity of expression.”

Where the works at issue are attached to or referenced in plaintiff’s complaint,

Eleventh Circuit case law supports a trial court’s ruling based on infringement at a motion to dismiss. . . . In the instant case, with no direct proof of copying, substantial similarity is the crucial issue. Accordingly, in the Eleventh Circuit, it is appropriate for this Court to determine whether the works are substantially similar and, therefore, whether Plaintiff can plausibly demonstrate entitlement to relief, in connection with the instant Motion to Dismiss.

Sieger Suarez, supra at at 1350-1351.

Here, as in Sieger Suarez, “substantial similarity is the crucial issue,” and the visual works at issue were attached to and/or referenced in the pleadings. Accordingly, this Court may properly decide “whether the works are substantially similar and, therefore, whether Plaintiff can plausibly demonstrate entitlement to relief, in connection with the instant Motion to Dismiss.” Id.

On the facts as alleged in the Complaint, dismissal is warranted because the parties’ respective works are not substantially similar with respect to protectable expression. The only similarities relate to unprotectable elements, e.g., a general impression of colorful whimsy arising from the use of irregularly placed fields of mismatched and overscaled stripes, dots, and flowers as surface decoration on simply drawn subjects (hands, faces, alphabet letters, etc.), often with heavy black outlines. The actual rendering of the Britto Images – i.e., the copyrightable expression they contain – differs significantly in every instance from the C&K Images. See Defendants Karl Maier and Karl Maier, Ltd.’s Answer [DE-32] (“Maier Ans.”) at Exh. H [DE-32-11](side-by-side comparison of images).

Further, to the extent the alleged stylistic similarities are not merely ideas, they are not original to Plaintiff but have been used by dozens of artists over the past century. They are thus scenes a faire, part of the common creative vocabulary of the pop art genre. See Maier Ans. at
Exhs. A-D [DE-32-1-4]. As such, neither Plaintiff nor any other artist can monopolize their use under the aegis of the Copyright Act. *Beal v. Paramount Pictures Corp.*, 20 F.3d 454, 459 (11th Cir. 1994) (*scenes a faire* not protectable); *Herzog v. Castle Rock Ent’t*, 193 F.3d 1241, 1248 (11th Cir. 1999) (same); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1266 (11th Cir. 2001) (same).

The Tenth Circuit in *Blehm v. Jacobs*, 702 F.3d 1193 (10th Cir. 2012) recently rejected a copyright claim virtually identical to Plaintiff’s here. In *Blehm*, the plaintiff, a Colorado-based commercial artist, sued for alleged infringement of his “Penmen” series of stick-figure characters. The characters have “round heads, disproportionately large half-moon smiles, four fingers, large feet, disproportionately long legs, and a message of unbridled optimism.” *Blehm*, at *2 (quoting Appellant’s brief). In the 1980’s, plaintiff created six posters featuring the character in various poses (running, swimming, biking, skateboarding, playing guitar, golfing, etc.).

Defendants therein began marketing “Life Is Good” t-shirts in 1994, featuring a stick-figure character they named “Jake” in various poses (running, swimming, biking, skateboarding, playing guitar, golfing, etc.) Plaintiff sued for copyright infringement in 2009, and in April 2011 the District of Colorado granted summary judgment of non-infringement for defendants. Even assuming access and copying, the court found that the Jake images were not substantially similar to the protectable elements of the Penman works. Plaintiff appealed.

The Tenth Circuit unanimously affirmed. Citing the Supreme Court’s decision in *Feist v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991), the court held that the defendants’ images were not substantially similar to the plaintiff’s expression. The court focused on two specific work-by-work comparisons that it deemed most favorable to plaintiff, the “Peace Sign” images and the “Frisbee” images. The parties’ respective Peace Sign images:
featured “numerous differences in the specific renderings, including the rendering of the smile on the two figures,” (emphasis added) and accordingly no reasonable juror could find the defendants’ images “substantially similar to the protected, expressive choices” made by plaintiff. *Id.* at *23* (emphasis original).

The court reached the same conclusion regarding the Frisbee images:

![Frisbee images](image)

The Tenth Circuit found no infringement because “[t]he infringement determination depends on what is copied. Assuming Life Is Good copied Penman images when it produced Jake images, our substantial similarity analysis shows it copied ideas rather than expression.” The similarities between the C&K Images and the Britto Images here are likewise limited to the idea of depicting certain common subjects, such as alphabet letters and the “peace sign” hand gesture, using certain common, mismatched, decorative patterns like stripes and dots, none of which are original to Mr. Britto. Even more so than in *Blehm*, the “specific renderings” of the subjects and the decorative patterns are completely different. *See* Maier Ans. at Exh. H [DE-32-11](side-by-side comparison).

2001). There, plaintiff created the following depiction of a “suicide leap” from the perspective of a businessman standing on the ledge of a building looking down to the street below:

![ Plaintiff's Image ]

The defendant therein later created the following image for an advertising campaign for camera lenses, in direct competition with plaintiff, who was also bidding for the campaign:

![ Defendant's Image ]

In *Kaplan* at 323, the court found no substantial similarity as a matter of law, because the specific renderings of the parties’ respective images were very different, despite the similar subject matter:

> the Court finds that nearly all the similarities between the works arise from noncopyrightable elements, thus rendering the works not substantially similar. The subject matter of both photographs is a businessperson contemplating a leap

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6 Plaintiff’s image: https://www.bing.com/images/search?q=kaplan+v.+stock+market&view=detailv2&idd=050B7FCEF88F1D16BD98528DCD7073C1C7B1EFFA&selectedIndex=1&ccid=tU4UL8VJ&simid=608043305366259810&thid=JN.rkJX%2fctYVKPBybVn8U%2fKA&ajaxhist=0

Defendant’s image: https://www.bing.com/images/search?q=on+top+with+peter+b+kaplan+v.+stock+market&view=detailv2&idd=050B7FCEF88F1D16BD9871C4AF0C8B26491E217C&selectedIndex=0&ccid=SnBpmiPU&simid=608008301379980909&thid=JN.SEV96J8sMjGmbCqxr8KQBQ&ajaxhist=0
from a tall building onto the city street below. As the photograph's central idea, rather than Kaplan's *expression* of the idea, this subject matter is unprotectible in and of itself. (Emphasis added).

Because common subject matter is not protectable, courts in visual art cases necessarily engage in very detailed analysis of fine distinctions in the way the works at issue are rendered. *See, e.g.*, Kaplan at 326-327 (lengthy analysis of differences between parties’ works as to composition, perspective, foreground and background details). A similarly careful side-by-side comparison of the C&K Images with the Britto Images reveals numerous differences in expression, after the common subject matter is disregarded. Without exception, the works differ significantly as to composition, color palette, tone, selection of patterns, scale of patterns, placement of patterns, and degree of detail. *See* Maier Ans. at Exh. H (side-by-side comparison of Britto Images and C&K Images).

Accordingly, as with Blehm and Kaplan, the C&K Images here are not substantially similar to the protectable expression in the Britto Images as a matter of law. Repeating patterns of stripes, flowers or Ben-Day dots, used to decorate simply rendered, commonplace subjects with heavy black outlines, have been used widely in commercial and fine visual art for many years. *See* Maier Ans. at Exhs. A-D. Accordingly, Plaintiff cannot monopolize the use of such stylistic features, or its subject matter, but can only protect the specific rendering of its original works, the particular expression that Mr. Britto created. None of the C&K Images are substantially similar to that specific expression as a matter of law.

**II. PLAINTIFF’S LANHAM ACT CLAIMS MUST BE DISMISSED UNDER DASTAR**

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7 *See also* Gentieu v. Tony Stone Images/Chicago Inc., 255 F. Supp. 2d 838 (N.D. Ill. 2003)(questions of substantial similarity “require a much more in-depth analysis” and “the fundamental vice in Gentieu's entire case” was that “it attempts impermissibly to claim a monopoly over abstract ideas, while it is of course the expressions of that abstract idea that matter.”)
Plaintiff cannot expand the scope of its protection by re-characterizing its claim as unfair competition or infringement of unregistered trade dress under the Lanham Act. A unanimous 2003 U.S. Supreme Court decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 123 S. Ct. 2041 (2003)(“*Dastar*”), expressly precludes such an end-run around the Copyright Act. In *Dastar*, the Supreme Court held that federal unfair competition law, as codified in Section 43(a) of the Lanham Act, could not impose Lanham Act liability on the producers of a series of reissued television programs. The programs were originally produced in the late 1940’s by respondent Fox. In the 1990’s, petitioner Dastar reissued the programs in an edited version, sold in packaging that credited Dastar as the producer and did not mention Fox.

Like Plaintiff here, which also alleges the use of altered versions of its artwork without attribution, Fox sued under § 43(a) of the Lanham Act, which prohibits the use of “any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which is likely to . . . deceive as to . . . the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.” *Id.*

Because Dastar was in fact the source of the physical videotapes it sold in commerce, however, the Court held that there could be no false statement or representation. To hold otherwise would turn the Lanham Act into a “species of mutant copyright law,” held the Court. *Dastar* tells us not to use trademark law to achieve what copyright law forbids.

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9 *Dastar*, 539 U.S. at 34. See also *Eastland Music Group, LLC v. Lionsgate Entertainment, Inc.*, 707 F.3d 869 (7th Cir. 2013)(Easterbrook, J)(“*Dastar* held that trademark law cannot be used to obtain rights over the content of an artistic work. . . . ; *Dastar* tells us not to use trademark law to achieve what copyright law forbids.”)
grant that would be superfluous if all creators could assert broad Lanham Act rights as to their creative works, as Plaintiff attempts here. *Id.* at 34–35.

Applying *Dastar*, an Ohio District court in *Clark v. Walt Disney Co.*, 642 F. Supp. 2d 775 (S.D. Ohio 2009) dismissed plaintiff’s claim under Rule 12(b)(6) where the complaint alleged that defendant’s posters embodied plaintiff’s protected content, thus “the public is likely to believe that the accused posters were produced by Plaintiff or were somehow sponsored or approved by him.” *Id.* at 785 (emphasis added). That is exactly the claim Plaintiff makes here. See, *e.g.*, Complaint at ¶46 (“Defendant’s unauthorized use of the Britto Trade Dress in the Start Something New campaign creates the false and deceptive commercial impression that the Start Something New campaign, and all products and services that the Start Something New campaign promotes, are associated with, endorsed by, or sponsored by Plaintiff”) (emphasis added). As in *Clark v. Walt Disney*, and following *Dastar*, the claim must be dismissed as Defendants are the producers of the C&K Images. Even if the C&K Images embody ideas or creative content created by Mr. Britto, which Defendants deny, *Dastar* makes clear that the Lanham Act does not provide a remedy for such alleged false statements. *See Dastar*, 539 U.S. at 32 (no Lanham Act remedy for misstatements regarding “the ideas or communications that ‘goods’ embody or contain”). Accordingly, since *Dastar*, courts faced with claims like Plaintiff’s have uniformly found them impermissible under *Dastar*, often dismissing such claims under rule 12(b)(6).10

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10 *See, e.g.*, Sybersound Records, Inc. v. UAV Corp., 517 F.3d 1137, 1143-44 (9th Cir. 2008) (affirming grant of Rule 12(b)(6) dismissal based on *Dastar*); Harbour v. Farquhar, 245 Fed. Appx. 582 (9th Cir. 2007) (affirming grant of Rule 12(b)(6) dismissal under *Dastar*; “Under *Dastar*, the ‘goods’ at issue here were the completed television programs, or the products offered for sale to the public. [Plaintiff’s] musical compositions were ‘ideas, concepts, or communications embodied within those goods.’ Therefore, *Dastar* controls and [plaintiff] fails to state a claim under the Lanham Act”); Bretford Mfg., Inc. v. Smith Sys. Mfg. Corp., 419 F.3d 576 (7th Cir. 2005); Zyla v. Wadsworth, Div. of Thomson Corp., 360 F.3d 243, 251-52 (1st Cir. 2004) (finding that *Dastar* barred a Lanham Act claim regarding authorship of sections of a nutrition textbook); Gen. Universal Sys., Inc. v. Lee, 379 F.3d 131, 148-49 (5th Cir. 2004) (finding that *Dastar* barred a Lanham Act claim regarding failure to attribute portions of software used by
Even prior to Dastar, the courts of this Circuit held that artists’ works of art and their “visual style” were not entitled to protection under the Lanham Act. The Northern District of Georgia, for example, held in Leigh v. Warner Bros., 10 F. Supp. 2d 1371 (N.D. Ga. 1998) that:

if a picture or work of art merely identifies the artist rather than any products or services, it cannot be protected as a trademark. See Hughes v. Design Look Inc., 693 F. Supp. 1500, 1505 (S.D.N.Y. 1988) (holding estate of Andy Warhol had no trademark rights in Warhol paintings that were copied and included in defendant's calendar as they were never used by artist to identify source of goods or services). This rule applies even if the work is an example of an artist's unique artistic style. Style is a matter more properly protected by copyright law. Galerie Furstenberg v. Caffaro, 697 F. Supp. 1282, 1290 (S.D.N.Y. 1988)(holding unique artistic style of Salvador Dali is not protected by trademark law; rather any protection available is through copyright law). There has been a debate over the use of trademark law to protect the rights of artists in their visual style. The better rule appears to be that the protection an artist receives against infringement of his work arises under copyright law, not the Lanham Act.

does not create trade dress rights for the artist. \textit{Id.} ("The identity of the designer or artist who created the image is irrelevant unless that person is identified as the source of the product or service sold under the trademark image") quoting 1. J Thomas McCarthy, \textit{McCarthy on Trademarks and Unfair Competition}, § 3:4 (4th ed. 1998).

Since \textit{Dastar}, the Lanham Act’s inability to “protect the rights of artists in their visual style” is not merely “the better rule,” it is the law. \textit{See also Scholastic Inc. v. Speirs}, 28 F. Supp. 2d 862, 871 (S.D.N.Y. 1998)(no need for likelihood of confusion analysis, where plaintiff’s image does not function “to distinguish anything other than the image itself”). Further, Plaintiff has made no plausible allegation, nor could it, that it is the origin of any of the goods or services referenced in the complaint that bear the purported Trade Dress, such as Mattel Barbie Dolls, Florida State Lottery tickets, or LG electronics. In fact, the Complaint concedes that third parties, not Plaintiff, are the origin of these goods, \textit{see e.g.}, ¶22 ("Britto artwork and trade dress was licensed to the Florida State Lottery for use on \textit{its} lottery tickets.")

\footnote{This paragraph, with its reference to “artwork \textit{and} trade dress,” also exemplifies Plaintiff’s consistent attempts in the Complaint to obscure the fact that the artwork \textit{is} the alleged “trade dress.”}
III. PLAINTIFF’S DESIGNS ARE NOT PROTECTABLE AS TRADE DRESS FOR PLAINTIFF

Assuming arguendo that Plaintiff’s trade dress and dilution claims are not foreclosed by Dastar, they cannot succeed as a matter of law because Plaintiff has failed to establish the consistency and distinctiveness needed to give rise to protectable trade dress.

A. PLAINTIFF HAS FAILED TO ESTABLISH A PRECISE, CONSISTENT LOOK COVERING THE ASSERTED FAMILY OF GOODS AND SERVICES

Plaintiff’s asserted trade dress, allegedly covering many disparate decorative designs on products ranging from Florida State lottery tickets to Mattel Barbie dolls, is not protectable because, inter alia, it lacks the definiteness and consistency necessary to function as a source indicator. See Mobile Shelter Systems USA, Inc. v. Grate Pallet Solutions, LLC, 845 F.Supp.2d 1241 (M.D. Fla. 2012) (granting judgment for defendant as a matter of law on closely analogous facts). The Mobile Shelter court observed that when, as in this case, the asserted trade dress covers a range of goods and services, the court must determine the threshold question of consistency across the product line, even before addressing the distinctiveness of an alleged trade dress:

[A] trade dress plaintiff seeking to protect a series or line of products faces a particularly difficult challenge, as it must show that the appearance of the several products is ‘sufficiently distinct and unique to merit protection.’ Yankee Candle Co. v. Bridgewater Candle Co., 259 F.3d 25, 42 (1st Cir.2001). This is so because trade dress claims across a line of products present special concerns in their ability to artificially limit competition, as such claims are generally broader in scope than claims relating to an individual item. . . . [A] plaintiff, seeking protection for a series or line of products, must first demonstrate that the series or line has a recognizable and consistent overall look. Only after the plaintiff has established the existence of recognizable trade dress for the line or series of products should the trial court determine whether the trade dress is distinctive, whether the trade dress is nonfunctional, and whether the defendant's use of plaintiff's trade dress is likely to cause consumer confusion.

Mobile Shelter, supra, at 1255-1256 (emphasis added, internal quotations and citations omitted).
Plaintiff here has claimed trade dress rights covering a potentially infinite range of products and services (Complaint at ¶¶17-22) but has failed to plausibly allege a “consistent overall look” for the myriad of products and services for which it claims protection, short of the vague reference to Mr. Britto’s artistic style: the images in the Complaint alone belie any such allegation. As the court continued in Mobile Shelter at 1256,

It is incumbent upon the proponent of a trade dress to define the elements of its trade dress. If the proponent does not precisely define its trade dress, the analysis that follows necessarily devolves into an abstract exercise of questioning unprotectable qualities such as beauty or cachet. See, e.g., Yurman Design, Inc. v. P.A.J., Inc., 262 F.3d 101, 116–17 (2d Cir.2001); see also Rose Art Indus., 235 F.3d at 173 (“[I]f a plaintiff seeking trade dress protection cannot show that its packages have a ‘consistent overall look,’ the trade dress that the defendant is allegedly infringing ‘does not exist,’ and the defendant must prevail.” (Internal quotations omitted)).

The Complaint makes clear that this conclusion applies fully to Plaintiff. The Plaintiff unabashedly seeks to protect a “style of artwork” as its trade dress. Complaint ¶21 (“Mr. Britto’s distinctive style of artwork has become so famous and pervasive as to constitute a distinctive trade dress that identifies the highly-coveted BRITTO® lifestyle brand”). The Complaint fails to identify which products or services allegedly comprising the “BRITTO® lifestyle brand” bear a particular trade dress; the only allegedly uniting factor is the purported “cachet” of Mr. Britto’s general design style. Accordingly, as in Mobile Shelter at 1256, the court should find that Plaintiff has failed to show its products possess a protectable “consistent overall look.”

Further, the Court agrees with the Second Circuit's statement that ‘a plaintiff's inability to explain to a court exactly which aspects of its product(s) design merit protection may indicate that its claim is pitched at an improper level or generality, i.e., the claimant seeks protection for an unprotectable style, theme or idea.

That is exactly what Plaintiff attempts to do here, to seek protection for an unprotectable “style, theme or idea.” The Complaint at ¶23 seeks to remedy this glaring deficiency by alleging
a random collection of so-called “elements” such as “vibrant color combinations,” “uplifting, bright and happy visual themes,” “randomly shaped swaths,” and “distinctive patterns.” This description of the allegedly protectable elements is inconsistent with other articulations of the trade dress appearing in prior paragraphs of the Complaint and is not reflected in dozens of products ostensibly within the “BRITTO® lifestyle brand” by virtue of displaying Mr. Britto’s “artistic style” (see Amended Answer of Defendant Apple, Inc., Exhibit A)[DE-30-1].

In this case, Plaintiff has failed to articulate what consistent overall look is present in its family of products. Some products appear to have some of the elements; other products appear to lack some of those elements.

Mobile Shelter at 1256 (emphasis added).

At the same time, Plaintiff’s articulated elements are also so broad that they encompass a vast number of disparate artistic designs. Thus, even this inconsistent attempt to articulate the “consistent overall look” of Plaintiff’s alleged trade dress provides an insufficiently specific basis on which to claim trade dress protection.

Compounding Plaintiff’s failure to articulate a line of products and services bearing a particular and consistent trade dress, the Complaint is also conspicuously silent as to any specific item of Plaintiff’s trade dress allegedly infringed by the Start Something New campaign image, or any other C&K Image. As pleaded, the claim could pertain to the Barbie doll, the lottery ticket, or the baby stroller, to name but a few, all of which look remarkably unlike each other. Such vague pleading as to the elements of the asserted trade dress is inadequate to survive a motion to dismiss. See National Lighting Co. v. Bridge Metal Industries, LLC, 601 F. Supp. 2d 556 (S.D.N.Y. 2009). See also Landscape Forms Inc. v. Columbia Cascade Co., 113 F.3d 373,

12 “In its Complaint, plaintiff offered a vague description of its claimed trade dress and appended, as separate exhibits, promotional materials for some of its lighting fixtures and photos of defendants' showroom. . . . This description is a laundry list of the elements that constitute a lighting fixture's design,
381-382 (2d Cir. 1997) (“Yet, these and the many other similarly laudatory descriptions in the record fail to indicate what unique combination of features makes the trade dress of the ten items in the Petoskey line inherently distinctive….If the law protected style at such a level of abstraction, Braque might have prevented Picasso from selling cubist paintings in the United States.”)

B. PLAINTIFF’S ASSERTED TRADE DRESS IS NOT DISTINCTIVE

Even if Plaintiff had specified a consistent trade dress with particularity, the Lanham Act claims would nonetheless fail because the Complaint contains no allegation that the asserted trade dress is distinctive. Plaintiff’s allegations of distinctiveness are mere legal conclusions and need not be credited by this Court under Iqbal. See, e.g., Vedder Software Group Ltd. v. Insurance Services Office, Inc., 545 Fed. Appx. 30 (2d Cir. 2013) (affirming dismissal of trade dress claim under Iqbal where complaint merely alleged asserted trade dress to be “distinctive” and “non-functional”). Here, the images in the pleadings belie any such conclusory allegation. See Maier Ans. at Exhs. A-D.

While Plaintiff alleges at some length that Mr. Britto’s art is famous and that Mr. Britto is well-known, these are not relevant allegations of the distinctiveness of a trade dress used on any product or in connection with any service. The question of distinctiveness asks whether the trademark or trade dress can distinguish the goods or services of one producer from those of another. Since long before Dastar the courts have consistently recognized that decorative designs on a product can at best serve as trademarks for the producer of the product, but not for the artist rather than a description of which of plaintiff’s trade dress design elements are distinctive and how they are distinctive. See Shevy Custom Wigs, Inc. v. Aggie Wigs, No. 06 Civ. 1657(JG), 2006 WL 3335008, *5 (E.D.N.Y. Nov. 17, 2006) (granting a motion to dismiss a trade dress claim and stating that “[t]he issue is not just which features are distinctive, but also how they are distinctive.”) Plaintiff here has provided no more than such a laundry list, and has pleaded no facts whatsoever to show how the alleged elements are distinctive.
who created the design.  

Indeed, if decorative uses of Plaintiff’s designs cause consumers to think of Mr. Britto the artist, this makes proof of the source-identifying quality of those designs harder, not easier. See Hughes v. Design Look Inc., 693 F. Supp. 1500, 1507 (S.D.N.Y. 1988) (Andy Warhol images on calendars held not protectable as trade dress for Warhol Estate: “to prevail, Plaintiffs must show not that these images have come to signify Andy Warhol as the artist, but Plaintiffs as the source of the product – the calendars”). Plaintiff concedes in the Complaint that third parties such as Mattel and Coca-Cola are the origin or “source” of the goods that bear the purported Britto Trade Dress. There is no allegation that Plaintiff actually produced any of the products referenced in the Complaint.

Finally, the court may take judicial notice of the non-distinctive nature of the asserted trade dress elements. See, e.g., Application of McIlhenny Co., 278 F.2d 953 (C.C.P.A. 1960) (rejecting asserted trade dress in non-distinctive pepper sauce bottle):

On the basis of taking judicial notice of the common shapes of bottles and caps alone, I fail to see any feature of the naked capped bottle which prima facie has sufficient distinctiveness to function as a trademark.

Accordingly, even if the Britto Trade Dress were far more visually distinctive than it is, compared to the vast array of stylistically similar pop art from the past 100 years (see Maier Ans. at Exhs. A, B, C, D) it would not serve to distinguish Plaintiff as the source of any product or service other than Mr. Britto’s artwork, because Plaintiff is not the source of any such product or service. As a matter of law, Andy Warhol had no claim to protectable trade dress when his actual

13 Defendants note that Plaintiff’s attempt to register a federal trademark in a “repeated design or pattern used on some or all of the surfaces of a product or product packaging” was rejected by the Patent and Trademark Office on grounds that the design was merely ornamental or decorative and thus did not function as a trademark.

See http://tsdr.uspto.gov/documentviewer?caseId=sn85137389&docId=O0A20101201174557#docIndex=3&page=1.

14 See also Bill Diodato Photography, LLC v. Kate Spade, LLC, 388 F. Supp. 382, 395 (S.D.N.Y. 2005) (dismissing兰ham Act claim where photographer’s work was copied in advertisement for handbag maker, because photographer was not a producer of tangible goods).
work appeared on the third party calendars in *Hughes*; Mr. Britto can certainly have no better claim for allegedly derivative designs that appear on the challenged uses here.

**IV. PLAINTIFF’S STATE CLAIMS MUST BE DISMISSED**

**A. THE STATE CLAIMS ARE PREEMPTED BY THE COPYRIGHT ACT**

Section 301(a) of the Copyright Act, 17 U.S.C. § 301(a) states as follows:

> On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State. (Emphasis added.)

Plaintiff concedes that its works are fixed in a tangible medium of expression and fall within the general scope of copyright, and indeed it asserts copyright infringement claims as to those works. The case law interpreting § 301(a) makes clear that all of the state-law claims asserted here are “equivalent” to Plaintiff’s copyright claims, because the very same conduct of Defendants – creating and displaying allegedly similar artwork – is the predicate for both the copyright and non-copyright claims.

For example, the Southern District of New York in *Eyal R.D. Corp. v. Jewelex NY Ltd.*, 784 F. Supp. 2d 441 (S.D.N.Y. 2011) applied Rule 12(b)(6) to dismiss state law claims for the same four counts that Plaintiff alleges here: common-law trade dress infringement (Count III here), common-law unfair competition (Count V here), statutory trade dress dilution (Count IV here) and statutory unfair business practices (Count VI here). Like Plaintiff here, plaintiff in *Eyal* at 445 alleged that

> [d]ue to [its] exclusive and widespread use of ... non-functional design features in connection with Jewelry, its Prinuette Trade Dress in the Prinuette product line has acquired enormous value and recognition in the United States.” [Citation to
Further, “[s]uch trade dress is well known to the consuming public and the trade as identifying and distinguishing [Eyal] as the exclusive and unique source of the products that are used in connection with such trade dress.” *Id.* According to Eyal, Jewelex is liable under state law because it “regularly produces, manufactures, advertises, offers for sale and otherwise distributes, for commercial advantage and private financial gain, rings ... by Jewelex ... which use the Prinuette Trade Dress without permission, and thus infringe upon [Eyal's] trade dress.”

The unfair competition claim was held preempted because it arose only from defendant’s alleged copying, *Eyal* at 447, citing *Computer Assocs. Int'l Inc. v. Altai, Inc.*, 982 F.2d 693, 717 (2d Cir. 1992) (“[U]nfair competition and misappropriation claims grounded solely in the copying of a plaintiff's protected expression are preempted”). The common-law trade dress infringement claim was likewise preempted, because “[a]s pleaded, the claim flows only from Jewelex's alleged copying.” *Eyal* at 448. The statutory trade dress dilution claim was preempted for the same reason, *id.* (“where a plaintiff can only plead facts to allege harm from copying, a [dilution ] claim . . . should be considered preempted”), as was the statutory unfair business practices claim under N.Y. Gen. Bus. Law §349 (“Eyal, again, has alleged harms arising only from Jewelex's alleged copying of its design, and thus asserts only a harm squarely covered by federal copyright law.”)

The Eleventh Circuit reached the same result under Florida law in *M.G.B. Homes, Inc. v. Ameron Homes, Inc.*, 903 F.2d 1486 (11th Cir. 1990) (reversing district court: “[T]he trial court found that Ameron competed unfairly because it planned to copy MGB's work. It held that this was not pre-empted by the Copyright Act, but arose collaterally. We disagree. . . . *A claim for unfair competition based upon allegations of copying, and in the absence of proof of any element of unfair competition other than copying, is clearly pre-empted by the Act*”)(emphasis added). *See also, e.g.*, *Randolph v. Dimension Films*, 630 F. Supp. 2d 741(S.D. Tex. 2009)(applying
Texas law);\textsuperscript{15} \textit{Logan Developers Inc. v. Heritage Buildings, Inc.}, 2013 WL 5460757 at *6 (E.D. N.C. 2013)(applying North Carolina law: “the UDTPA claim must be supported by factual allegations that demonstrate misconduct separate from, and not controlled by, the Copyright Act”). Therefore, all of Plaintiff’s state law claims here are preempted by §301(a) of the Copyright Act and must be dismissed.

\textbf{B. PLAINTIFF’S ASSERTED TRADE DRESS IS NOT “FAMOUS”}

Plaintiff’s federal and state-law claims for dilution of its trade dress (Count II and Count IV) fail for a second, independent reason: the Britto Trade Dress, to the extent it can be identified, is not sufficiently “famous” to qualify for protection against dilution, either under the Lanham Act or under the Florida anti-dilution statute. First, the requisite level of fame is extremely high, see, e.g., \textit{Luv n’ Care Ltd. v. Regent Baby Prods. Corp.}, 841 F. Supp. 2d 753, 758 (S.D.N.Y. 2012)(Lanham Act “limits federal dilution claims to truly famous marks like Budweiser beer, Camel cigarettes, Barbie Dolls and the like”). There is no plausible allegation, nor could there be, that the purported Britto Trade Dress has attained this level of fame. \textit{See Boarding School Review, LLC v. Delta Career Education Corp.}, 2013 WL 6670584 (S.D.N.Y. 2013).\textsuperscript{16}

Moreover, any fame enjoyed by Mr. Britto as an individual artist is irrelevant to the separate question of the fame of the alleged Trade Dress. \textit{Maule v. Philadelphia Media Holdings, LLC}, 710 F. Supp. 2d 511, 520 (E.D. Pa. 2008)(“the fact that Maule, himself, may be well-

\textsuperscript{15}“If the defendants' alleged acts would violate both state law and federal copyright law, then the state right is deemed ‘equivalent to copyright’.” \textit{Id.} (quoting \textit{Alcatel USA, Inc. v. DGI Techs., Inc.}, 166 F.3d 772, 787 (5th Cir.1999)).

\textsuperscript{16}“Allegations that Defendants own at least fourteen educational institutions, provide educational services to at least 16,000 people, have one subsidiary that has operated for more than 100 years, have invested ‘enormous’ sums of money in marketing, provide services that are ‘highly sought after,’ and have experienced ‘extraordinary and longstanding sales success’ do not make it plausible that Defendants' Marks are truly famous to the general consuming public of the United States” (dismissing dilution claims under rule 12(b)(6)).
known. . . does not establish that either of the two photographs in question are famous”)(granting motion to dismiss Pennsylvania state trademark infringement and dilution claims asserting trademark rights in photographs taken by plaintiff). In *Maule*, the court made clear that “the very concept of a trademark is a symbol or identifier that is placed upon a product to identify the maker or source. The photographs are the goods. . . They are not, however, marks in themselves.” For the same reason, Plaintiff’s various artworks are not marks in themselves, even if a third party has chosen them to decorate the third party’s own goods.

**C. PLAINTIFF’S STATE LAW CLAIMS FAIL FOR THE SAME REASONS AS ITS LANHAM ACT CLAIMS**

Finally, Plaintiff’s state law claims cannot go forward for the same reasons set forth above with respect to the asserted Lanham Act claims. The district court on remand in *Dastar*, for example, held that "the Supreme Court's finding that Defendants' actions were not misleading under the Lanham Act controls the resolution of their California unfair competition claim." 2003 U.S. Dist. LEXIS 21194 at *14 (C.D. Cal. 2003). See also *Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177, 1185 (C.D. Cal. 2003)(“[t]he Ninth Circuit has consistently held that state law unfair competition claims are ‘congruent’ with Lanham Act claims; Plaintiff’s putative unfair competition claim would fail for the same reasons his Lanham Act claim fails”); *Bob Creeden & Assocs. Inc. v. Infosoft, Inc.*, 326 F. Supp. 2d 876, 880 (N. D. Ill. 2004)(“Because [plaintiff] fails to state a claim under the Lanham Act, [plaintiff] likewise has no claims under Illinois’ statutory unfair competition laws”).

**CONCLUSION**

Based on the above reasons and authorities, Defendants Craig Redman, Karl Maier, and Karl Maier Ltd. respectfully request that Plaintiff’s Complaint be dismissed in all respects.

Dated: August 13, 2015. Respectfully submitted,
CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on August 13, 2015, I have filed the foregoing document with the Clerk of Court using the CM/ECF system. I also certify that the foregoing document is being served this day on all counsel of record or pro se parties identified in the attached Service List in the manner specified, either via transmission of Notices of Electronic Filing generated by CM/ECF or in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

By: /s/John F. Bradley/
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