



UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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MATTHEW LOMBARDO AND WHO'S
HOLIDAY LLC,

Plaintiffs,

v.

DR. SEUSS ENTERPRISES, L.P.,

Defendants.
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OPINION AND ORDER
GRANTING DECLARATORY
JUDGMENT FOR PLAINTIFFS
AND DISMISSING
DEFENDANT'S
COUNTERCLAIMS

16 Civ. 9974 (AKH)

ALVIN K. HELLERSTEIN, U.S.D.J.:

Plaintiff Matthew Lombardo is the author of *Who's Holiday!* (the "Play"), a comedic play that makes use of the characters, plot, and setting of the Dr. Seuss book, *How the Grinch Stole Christmas!* ("*Grinch*"), to make fun of it and to criticize its qualities, i.e., to parody it. Plaintiffs Lombardo and Who's Holiday LLC seek a declaration that the Play is fair use and therefore does not infringe upon defendant Dr. Seuss Enterprises, L.P.'s copyright in *Grinch*.

Defendant asserts counterclaims alleging copyright and trademark infringement. Plaintiffs move for judgment on the pleadings pursuant to Rule 12(c), arguing that the Play constitutes fair use of defendant's copyright. Plaintiffs also move to dismiss defendant's counterclaims for failure to state a legally sufficient claim for relief. For the reasons stated herein, plaintiffs' motion is granted. The Play constitutes fair use and therefore does not infringe defendant's copyright in *Grinch* or related trademarks. Defendant's counterclaims are dismissed.

BACKGROUND

I. The Original Work: *How The Grinch Stole Christmas!*

Grinch, originally published in 1957, is a well-known children's book written by the author known as Dr. Seuss. First Amended Compl. ("FAC") ¶ 7. Defendant owns a

copyright in *Grinch*, and alleges ownership of trademarks in (i) the characters of the Grinch and Cindy-Lou Who; (ii) the stylized hand-lettering used consistently throughout Dr. Seuss books; and (iii) certain drawn images of Cindy-Lou Who. FAC ¶ 8; Counterclaims ¶ 20.

Grinch tells the story of the Grinch, a green creature that lives in a cave on Mount Crumpit above the town of Who-Ville, home of the merry and cheerful Whos, who positively love Christmas. The Grinch, who despises Christmas, decides to ruin Christmas for Who-Ville by disguising himself as Santa Claus and stealing all of Who-Ville's Christmas trees and presents. While executing his plan, the Grinch encounters Cindy-Lou Who, an adorable two-year old girl. When Cindy-Lou asks the Grinch why he is taking her family's tree, the Grinch lies to Cindy-Lou, telling her that he needs to repair a light on the tree but will return it soon. Cindy-Lou believes the Grinch and returns to bed. The next day, the Grinch listens from Mount Crumpit for the sound of crying Whos, but instead hears the sounds of merry singing. The Grinch, upon learning that the Whos could remain joyous during Christmas even without presents or Christmas trees, realizes that Christmas means more than presents. The Grinch, his heart having "grown three sizes that day," returns to Who-Ville with all of the presents and joins the Whos for a scrumptious feast, featuring a dish called roast beast. *See generally*, Greenberger Decl. Ex. 2.

II. The Allegedly Infringing Work: *Who's Holiday*

Plaintiff Lombardo is the author of the play, *Who's Holiday*. Lombardo formed plaintiff Who's Holiday LLC to produce the Play. *Who's Holiday* is a one-actress 75-minute comedic play featuring a rather down-and-out 45 year-old version of Cindy-Lou Who. The Play takes place at Cindy-Lou's 1970s era trailer in the hills of Mount Crumpit. Cindy-Lou speaks to the audience only in rhyming couplets that are clearly intended to evoke the work of Dr. Seuss. While waiting for guests to arrive for her Christmas party, Cindy-Lou tells the audience the story

of her life, beginning with her first encounter with the Grinch at the age of two. Throughout the Play, as she shares her history, Cindy-Lou drinks hard alcohol, abuses prescription pills, and smokes a substance she identifies as “Who Hash,” which she describes as just “like a prescription” which keeps her in check to avoid a “conniption.” She engages in this self-medication following her realization that none of the guests she invited to her party is likely to attend, as they keep calling throughout the Play to cancel.

As Cindy-Lou recounts her initial encounter with the Grinch and his subsequent change of heart, paralleling the plot of the original *Grinch*, she incorporates age-inappropriate language and details that do not appear in the original work. (“I watched for a while as he was stealin’ our shit / Then I cooed by mistake and he saw me. That twit.”); (“How would I know he was evil or crass? / He gave me some water. Then patted my ass.”). After recounting the plot of the original *Grinch*, Cindy-Lou goes on to tell the audience – using rhymes involving bawdy, ribald innuendo – that she became friends with the Grinch during her school-age years, and that she engaged in sexual intercourse with the Grinch upon turning eighteen. Cindy-Lou refers to the size of the Grinch’s genitalia growing “three sizes that day.” After learning that she is pregnant, Cindy-Lou informs the Grinch, who asks her to marry him. Over her parents’ protestation (“When I told my parents they weren’t pleased in the least / I mean, who wants their baby girl deflowered by a beast.”), Cindy-Lou marries the Grinch, moves into his cave at the top of Mount Crumpit, and gives birth to their child (“With the fur and the paws it looked just like its Daddy / With no who dilly attached, I named the kid Patti.”).

As the years go by, Cindy-Lou and the Grinch’s relationship begins to sour as they struggle with issues such as unemployment, access to health care, lack of heat, and hunger. One day, Cindy-Lou discovers that the family dog Max has frozen to death, and she decides to

cook his carcass in order to feed her family. When the Grinch discovers what his dinner is made of, he attempts to physically abuse Cindy-Lou. During the ensuing scuffle, the Grinch falls off the edge of a cliff and dies. Following the Grinch's death, Cindy-Lou is arrested, convicted and incarcerated, and her daughter is put into foster care. After describing how her time in prison ultimately made her stronger and wiser, Cindy-Lou eventually finds out that all of her guests have declined to attend her party and begins to cry. It then dawns on her that she can celebrate Christmas with the audience instead. After singing a few Christmas songs, the door bells rings. Cindy-Lou expects it to be a local prankster, but it turns out to be her daughter, Patti. *See generally*, FAC Ex. 1.

III. Procedural History

In July 2016, defendant sent plaintiffs and related entities numerous cease-and-desist letters requesting that plaintiffs refrain from any conduct that infringed defendant's intellectual property. After receipt of these letters, plaintiffs elected not to move forward with their planned production of the Play, and instead filed this lawsuit. In addition to seeking a declaration that the Play constitutes fair use, plaintiffs also filed several tort claims seeking recovery of funds lost as a result of the cancelled production. In an earlier opinion, I granted defendant's motion to dismiss plaintiff's tort claims. *See Lombardo v. Dr. Seuss Enterprises, L.P.*, 2017 WL 1378413 (S.D.N.Y. Apr. 7, 2017). In response to plaintiffs' first amended complaint, defendant filed counterclaims alleging copyright and trademark infringement. Over defendant's objection that discovery was necessary before the fair use issue could be resolved, I invited plaintiffs to file a motion for judgment on the pleadings pursuant to Rule 12(c) to test the issue. *See* Scheduling Order, Dkt. No. 40 (June 7, 2017).

DISCUSSION

I. The Question of Whether the Play Constitutes Fair Use Is Properly Resolved on a Rule 12(c) Motion

The parties dispute whether the question of fair use can be resolved on a motion for judgment on the pleadings. Plaintiffs argue that discovery is unnecessary because the only task for the Court is to conduct a side-by-side comparison of the Play and *Grinch* and apply the law of fair use. Defendant counters that the following discovery is necessary to resolve the fair use question: (i) all versions of the Play's website and potential advertisements (as opposed to just those attached as exhibits to plaintiffs' pleadings); (ii) all drafts of the Play itself; (iii) all set and costume designs; and (iv) deposition testimony from the Play's author, director, set designer and costume designer.

No such discovery is necessary in this case. Numerous courts in this district have resolved the issue of fair use on a motion for judgment on the pleadings by conducting a side-by-side comparison of the works at issue. In *Arrow Prods., LTD. v. Weinstein Co. LLC*, 44 F. Supp. 3d 359 (S.D.N.Y. 2014), for example, the court held that "discovery would not provide any additional relevant information in this inquiry" because "[a]ll that is necessary for the court to make a determination as to fair use are the two films at issue." 44 F. Supp. 3d at 368. Similarly, in *Adjmi v. DLT Entm't Ltd.*, 97 F. Supp. 3d 512 (S.D.N.Y. 2015), which concerned a play that parodied the television show *Three's Company*, the court addressed fair use on a motion for judgment on the pleadings, reasoning that "[c]ourts in this Circuit have resolved motions to dismiss on fair use grounds in this way: comparing the original work to an alleged parody, in light of applicable law." 97 F. Supp. 3d at 527; see also *Effie Film, LLC v. Murphy*, 932 F. Supp. 2d 538 (S.D.N.Y. 2013) (resolving copyright infringement claim on motion for judgment on the pleadings by comparing screenplays side-by-side); *Swatch Grp. Mgmt. Servs. Ltd. v. Bloomberg*

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