

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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SKETCHWORKS INDUSTRIAL STRENGTH
COMEDY, INC.,

Plaintiff,

-v-

No. 19-CV-7470-LTS-VF

JAMES H. JACOBS, et al.,

Defendants.

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MEMORANDUM OPINION AND ORDER

Sketchworks Industrial Strength Comedy, Inc. (“Plaintiff” or “Sketchworks”), brings this action against James H. Jacobs, as Trustee of the James H. Jacobs Trust, and Richard Casey, Peggy Ann Adams, Martha Bombardi, Leonard Casey, and Linda Casey, as Trustees of the Warren Casey Trust Under Will (together “Defendants”), seeking a declaratory judgment, pursuant to 28 U.S.C. section 2201, that its theater production, titled Vape, constitutes fair use of the musical Grease under the Copyright Act, 17 U.S.C. section 107, and therefore does not infringe Defendants’ copyright in Grease. (Docket entry no. 56, Second Amended Complaint, (“SAC”).) Plaintiff asserts that Vape is a parody of Grease and seeks a judicial determination that Vape does not infringe on Defendants’ copyright interest in Grease or any derivatives thereof. (Id. ¶¶ 69, 74.) Before the Court are Plaintiff’s and Defendants’ cross-motions for judgment on the pleadings, pursuant to Federal Rule of Civil Procedure 12(c). (Docket entry nos. 63, 69.) The Court has jurisdiction of this case pursuant to 28 U.S.C. sections 1331, 1338(a), and 1367.

The Court has considered carefully the parties' submissions and arguments and, for the following reasons, grants Plaintiff's motion for judgment on the pleadings in its entirety, and denies Defendants' cross-motion for judgment on the pleadings in its entirety.

BACKGROUND

The following recitation of facts is drawn from the Second Amended Complaint, Defendants' answer to the Second Amended Complaint setting forth Defendants' counterclaims (see docket entry no. 57 ("Def. Answer")), and Plaintiff's answer to Defendants' counterclaims. (See docket entry no. 58 ("Pl. Answer").) Because the parties have filed cross-motions for judgment on the pleadings, the Court will "employ the same standard applicable to Rule 12(b)(6) motions to dismiss" and "[a]ccept[] the non-moving party's allegations as true" for the purposes of this decision, Vivar v. City of New York, No. 18-CV-5987, 2020 WL 1505654, at *5 (S.D.N.Y. Mar. 30, 2020) (quotation omitted), with the exception that the Court is "not limited to looking at the Complaint" and "need not ignore the well-pleaded allegations of the answer[s] that are not controverted in the [respective] pleading[s]." Harper v. City of New York, No. 11-CV-4333-CM, 2013 WL 432599, at *1 (S.D.N.Y. Jan. 31, 2013) (explaining Rule 12(c) standard); see also Koninklijke Philips Elecs. N.V., v. The ADS Grp., 694 F. Supp. 2d 246, 250 n.7 (S.D.N.Y. 2010) (explaining that a "Rule 12(c) motion differs from a Rule 12(b)(6) motion in that it implicates the pleadings as a whole as opposed to simply the complaint and its attachments") (citing Wright & Miller, Federal Practice & Procedure, §§ 1367, 1368 (2d. ed 1995)).

Plaintiff operates a sketch comedy company incorporated in Georgia, and owns a copyright in Vape, an alleged parody of the popular theatrical work, Grease, of which Warren

Casey¹ and Defendant James H. Jacobs are co-authors. (SAC ¶¶ 2, 5, 22.) Grease follows a group of teenagers in the 1950s “as they navigate adolescence, peer pressure, personal values, sexual exploration, love and friendship.” (Id. ¶ 8.) Grease has been produced in multiple versions, including the original musical play and a popular 1978 film version featuring John Travolta and Olivia Newton-John, on which Vape is allegedly based. (Id. ¶¶ 8-9.) The film’s story line begins on summer break, and showcases a summer romance between a local teenager, Danny Zuko, and Sandy Olsson, a teenager visiting from abroad. (Id. ¶ 10.) The school year then begins and, rather than returning home after the summer break, Sandy enrolls at Rydell High School, which Danny attends along with other supporting characters including Rizzo, Frenchy, Marty, and Jan, who comprise the “Pink Ladies” friend group, and Danny’s friends, Kenickie, Doody, Sonny, and Putzie, who comprise Danny’s greaser gang known as the “T-Birds.” (Id. ¶¶ 11-12.) The film follows the challenges these characters face in their relationships and personal lives, as well as the ups-and-downs of Sandy and Danny’s romantic relationship. (Id. ¶¶ 13-21.) The film culminates in Danny and Sandy’s reunion, where Sandy, “who is normally conservatively dressed . . . shocks Danny when she arrives [on the last day of school] provocatively dressed like a greaser in black leather with teased hair and smoking a cigarette.” (Id. ¶¶ 19-20.) They proceed to ride off together “in a car that flies off into the sky.” (Id. ¶ 21.)

Vape, a stage musical, follows the same characters along roughly the same story-arc as Grease, depicting Danny and Sandy’s romance over their summer vacation, and the ups-

¹ Warren Casey is deceased. (Docket entry no. 68 (“Def. Mem.”) at 18.) Defendants Richard Casey, Peggy Ann Adams, Martha Bombardi, Leonard Casey, and Linda Casey are the special trustees responsible for administering the Casey Trust’s various copyrights and trademarks associated with the production of Grease. (SAC ¶ 4.)

and-downs their relationship takes over the course of a school year at Rydell High School. (SAC ¶¶ 23-24, 31-55.) Vape also depicts the relationships and challenges experienced by the characters Rizzo, Frenchy, Marty, and Jan, who name their girl group the “#PinkSquad,” and Kenickie, Doody, Sonny, and Putzy, who, together with Danny, refer to their group as “the-T-Bros.” (Id. ¶¶ 24, 26, 27, 33.) In addition to using the setting and character names from Grease, Vape features portions of nine songs from Grease and/or its licensed versions, including the songs’ instrumental tracks and chord progressions. (Def. Answer at 10-11, ¶¶ 12-13.)

Plaintiff asserts that Vape is a parody of Grease, explaining that it “pokes fun at various absurdities in Grease” (SAC ¶¶ 52, 55), and “uses millennial slang, popular culture, a modern lens, and exaggeration to comment upon the plot, structure, issues and themes of Grease and to criticize its misogynistic and sexist elements.” (SAC ¶ 53.) In so doing, Vape, which was written and directed by women, “reexamines Grease from a female perspective in the #MeToo era,” and “exposes how the ‘humor’ and rape-cultured elements of Grease have not aged well” by, for example, “directly criticiz[ing] Grease’s ‘happy ending,’ where a woman completely changes who she is in order to please a man.” (Id. ¶ 53.) Vape also “recognizes that modern youth still navigate complex issues relating to sex, drugs, and peer pressure – just in different forms from their 1950s counterparts.” (Id. ¶ 54.)

Defendants dispute Plaintiff’s characterization of Vape as a parody and assert that Vape infringes their copyright in Grease by utilizing the music, plot, characters, settings, and other elements from Grease. (Def. Answer at 13, ¶ 21.) After learning that Vape was scheduled to be performed in New York City in August 2019, Defendants sent Plaintiff, and the theater where Vape was scheduled to be performed, cease and desist letters on July 29, 2019. (SAC ¶¶

57-58.) Shortly after, the theater cancelled the scheduled performances. (Id. ¶ 60.) Despite these cancellations, Sketchworks hopes to perform Vape in the future. (Id. ¶ 64.)

Defendants also assert that Plaintiff misappropriated Defendants' trademark in the registered mark "Grease," and the name of Defendant Jim Jacobs, by using them without permission in order "to commercially benefit" from their attached "popularity and goodwill." (Def. Answer at 14, ¶¶ 30-31.) At the beginning of the performance of Vape, Plaintiff displays title and opening credits slides. (Pl. Answer ¶ 30.) One of the slides states, "Based on GREASE by Jim Jacobs and Warren Casey." (Id.) Plaintiff also describes Vape as "A live musical parody of Grease!" in its advertising materials. (Id.) Defendants allege that these representations are "likely to" lead consumers to believe that "Vape has been authored, approved, licensed, endorsed or in some way affiliated with the Defendants." (Def. Answer at 15, ¶ 34.) Defendants pursue counterclaims for trademark infringement under the Lanham Act, 15 U.S.C. § 1125 et seq., and violation of the right of privacy under sections 50 and 51 of the New York Civil Rights Law for these alleged infringements.

A copy of the 1978 film of Grease and a video recording of a performance of Vape are incorporated by reference into the pleadings, and copies of the works were provided to the Court. (See Exhibits 2 and 3 to docket entry no. 64, Declaration of Jordan Greenberger ("Greenberger Decl.").)

DISCUSSION

Under Fed. R. Civ. P. 12(c), "a party is entitled to judgment on the pleadings only if it has established that no material issue of fact remains to be resolved and that it is entitled to judgment as a matter of law." Zurich Ins. Co. v. Crowley Latin Am. Servs., LLC, No. 16-CV-

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