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U.S. COURT OF APPEALS

**NOT FOR PUBLICATION**

UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

SOPHIA & CHLOE, INC., a California corporation,

Plaintiff-Appellee,

v.

BRIGHTON COLLECTIBLES, LLC, a California corporation,

Defendant-Appellant.

No. 15-56867

D.C. No.

3:12-cv-02472-AJB-KSC

MEMORANDUM\*

SOPHIA & CHLOE, INC., a California corporation,

Plaintiff-Appellant,

v.

BRIGHTON COLLECTIBLES, LLC, a California corporation,

Defendant-Appellee.

No. 16-55681

D.C. No.

3:12-cv-02472-AJB-KSC

Appeal from the United States District Court  
for the Southern District of California

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\* This disposition is not appropriate for publication and is not precedent except as provided by Ninth Circuit Rule 36-3.

Anthony J. Battaglia, District Judge, Presiding

Argued and Submitted October 2, 2017  
Pasadena, California

Before: RAWLINSON and N.R. SMITH, Circuit Judges, and KORMAN,\*\*  
District Judge.

1. In an action for copyright infringement, the district court must determine whether to instruct the jury to apply the “substantially similar” standard or the more exacting “virtually identical” standard. *Mattel, Inc. v. MGA Entm’t, Inc.*, 616 F.3d 904, 913-14 (9th Cir. 2010), *as amended on denial of reh’g* (Oct. 21, 2010).

Given that others may freely copy a work’s ideas (and other unprotectable elements), we start by determining the breadth of the possible expression of those ideas. If there’s a wide range of expression (for example, there are gazillions of ways to make an aliens-attack movie), then copyright protection is “broad” and a work will infringe if it’s “substantially similar” to the copyrighted work. If there’s only a narrow range of expression (for example, there are only so many ways to paint a red bouncy ball on blank canvas), then copyright protection is “thin” and a work must be “virtually identical” to infringe.

*Id.* (internal citations omitted). Thus, if there are only a few ways to express the idea contained in the Buddha’s Kiss earring, then the appropriate standard is “virtually identical.” Whereas if there are numerous ways to express the idea in the Buddha’s Kiss earring, then the appropriate standard is “substantially similar.”

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\*\* The Honorable Edward R. Korman, United States District Judge for the Eastern District of New York, sitting by designation.

The Buddha's Kiss earring does not contain any individual protectable elements. However, "[o]riginal selection, coordination, and arrangement of unprotectible elements may be protectible expression." *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841, 849 (9th Cir. 2012), *as amended on denial of reh'g and reh'g en banc* (June 13, 2012). The United States Copyright Office rejected Sophia & Chloe's initial copyright application, reasoning that the Buddha's Kiss design did not contain "sufficient creative authorship within the meaning of the copyright statute and settled case law." Sophia & Chloe submitted a request for reconsideration, arguing that the Buddha's Kiss was entitled to copyright protection, because it selected and arranged three common, unprotectable elements: (1) the henna symbol for the word kiss; (2) the image of the Buddha; and (3) the teardrop shape. Based on this argument, the Copyright Office granted Sophia & Chloe its copyright but noted that the Buddha's Kiss contained a "sufficient, **although minimal**, amount of original and creative sculptural authorship in the treatment and configuration of its elements." (emphasis in original). Thus, the Buddha's Kiss contains a single protectable idea: a teardrop-shaped earring incorporating the henna symbol for the word "kiss" and the shape of the Buddha.

Like the idea of painting “a red bouncy ball on blank canvas,” there are a limited number of ways to design a teardrop-shaped earring incorporating the henna symbol for the word kiss and the shape of the Buddha. *See L.A. Printex*, 676 F.3d at 851. The dissent is correct that there are numerous ways to design an earring, but then misses the relevant question: whether there are many or few ways to design a teardrop-shaped earring incorporating the henna symbol for the word “kiss” and the shape of the Buddha. Because there are only a few ways to design an earring that incorporates those three elements, the district court erred in instructing the jury to apply the “substantially similar” standard.

Sophia & Chloe admitted at oral argument that it could not meet the “virtually identical” standard. Therefore, we reverse and remand for the district court to reconsider its denial of Brighton’s request for attorney’s fees under the Copyright Act.

2. After the district court considered Brighton’s motion for attorney’s fees under the Lanham Act, we overruled much of our precedent related to awarding attorney’s fees under the Act. *SunEarth, Inc. v. Sun Earth Solar Power Co.*, 839 F.3d 1179, 1181 (9th Cir. 2016). Thus, we vacate the district court’s order and remand so that the district court can make a decision based on the legal standard articulated in *SunEarth*.

The parties shall bear their own costs on appeal.

**REVERSED in part, VACATED in part, and REMANDED.**

**FILED**

***Sophia & Chloe, Inc. v. Brighton Collectibles, LLC***  
**Case Nos. 15-56867 and 16-55681**  
**Rawlinson, Circuit Judge, dissenting:**

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There are an infinite number of ways earrings can be configured to capture a particular image. Otherwise, no woman would be motivated to own more than a few pair of earrings. But we know that is not the case. *See Women's Earrings*, Amazon.com, <https://www.amazon.com/Womens-Earrings/b?ie=UTF8&node=7454917011> (last visited December 13, 2017) (offering 185,584 earring selections). I seriously disagree with my colleagues in the majority that there were only a limited number of ways to depict the Buddha's Kiss earrings at issue in this case.

At trial, evidence was presented through diagrams, expert testimony and actual pieces of both designs. After seeing this evidence, a jury determined that Brighton Collectibles had infringed on the copyrighted Buddha's Kiss design. The district court denied Brighton's renewed motion for judgment as a matter of law. The majority reversed the district court's ruling on the basis that, because there is only a limited number of ways to depict the Buddha's Kiss design, the court should have instructed the jury to find that the two designs were virtually identical rather than substantially similar. I disagree.

Indeed, the majority's conclusion is directly contrary to the testimony of the

designer. She testified that “the minute [she] looked at the [Buddha’s Kiss shape] [she] thought [she] could manipulate this shape *thousands* of different ways.” She explained that “[t]here are so many different things I could do with this [Buddha’s Kiss shape]– big, small, multiple, three, ten, whatever.” She also explained that the bracket portion of the earring “can be all different shapes” and “have all sorts of dimensions.” The majority’s conclusion that there is only a limited number of ways to depict the Buddha’s Kiss design completely ignores this testimony and the reality of earring design. The majority accuses me of ignoring the relevant question, but the majority ignores the relevant answer from the designer: that the Buddha’s Kiss shape could be manipulated “thousands of different ways.”

We addressed a similar situation in *L.A. Printex Indus., Inc. v. Aeropostale, Inc.*, 676 F.3d 841 (9th Cir. 2012). *L.A. Printex* involved a floral fabric print design. *See id.* at 850. Even though the floral pattern itself was not protectible, the “original selection, coordination, and arrangement” of the floral pattern was protectible. *Id.* The same is true for the Buddha’s Kiss earrings. As the designer testified, her “selection, coordination and arrangement” of the design elements was original and protectible. *Id.*

I respectfully dissent.

## United States Court of Appeals for the Ninth Circuit

**Office of the Clerk**  
95 Seventh Street  
San Francisco, CA 94103

### Information Regarding Judgment and Post-Judgment Proceedings

#### **Judgment**

- This Court has filed and entered the attached judgment in your case. Fed. R. App. P. 36. Please note the filed date on the attached decision because all of the dates described below run from that date, not from the date you receive this notice.

#### **Mandate (Fed. R. App. P. 41; 9th Cir. R. 41-1 & -2)**

- The mandate will issue 7 days after the expiration of the time for filing a petition for rehearing or 7 days from the denial of a petition for rehearing, unless the Court directs otherwise. To file a motion to stay the mandate, file it electronically via the appellate ECF system or, if you are a pro se litigant or an attorney with an exemption from using appellate ECF, file one original motion on paper.

#### **Petition for Panel Rehearing (Fed. R. App. P. 40; 9th Cir. R. 40-1)**

#### **Petition for Rehearing En Banc (Fed. R. App. P. 35; 9th Cir. R. 35-1 to -3)**

#### **(1) A. Purpose (Panel Rehearing):**

- A party should seek panel rehearing only if one or more of the following grounds exist:
  - ▶ A material point of fact or law was overlooked in the decision;
  - ▶ A change in the law occurred after the case was submitted which appears to have been overlooked by the panel; or
  - ▶ An apparent conflict with another decision of the Court was not addressed in the opinion.
- Do not file a petition for panel rehearing merely to reargue the case.

#### **B. Purpose (Rehearing En Banc)**

- A party should seek en banc rehearing only if one or more of the following grounds exist:



- ▶ Consideration by the full Court is necessary to secure or maintain uniformity of the Court's decisions; or
- ▶ The proceeding involves a question of exceptional importance; or
- ▶ The opinion directly conflicts with an existing opinion by another court of appeals or the Supreme Court and substantially affects a rule of national application in which there is an overriding need for national uniformity.

**(2) Deadlines for Filing:**

- A petition for rehearing may be filed within 14 days after entry of judgment. Fed. R. App. P. 40(a)(1).
- If the United States or an agency or officer thereof is a party in a civil case, the time for filing a petition for rehearing is 45 days after entry of judgment. Fed. R. App. P. 40(a)(1).
- If the mandate has issued, the petition for rehearing should be accompanied by a motion to recall the mandate.
- *See* Advisory Note to 9th Cir. R. 40-1 (petitions must be received on the due date).
- An order to publish a previously unpublished memorandum disposition extends the time to file a petition for rehearing to 14 days after the date of the order of publication or, in all civil cases in which the United States or an agency or officer thereof is a party, 45 days after the date of the order of publication. 9th Cir. R. 40-2.

**(3) Statement of Counsel**

- A petition should contain an introduction stating that, in counsel's judgment, one or more of the situations described in the "purpose" section above exist. The points to be raised must be stated clearly.

**(4) Form & Number of Copies (9th Cir. R. 40-1; Fed. R. App. P. 32(c)(2))**

- The petition shall not exceed 15 pages unless it complies with the alternative length limitations of 4,200 words or 390 lines of text.
- The petition must be accompanied by a copy of the panel's decision being challenged.
- An answer, when ordered by the Court, shall comply with the same length limitations as the petition.
- If a pro se litigant elects to file a form brief pursuant to Circuit Rule 28-1, a petition for panel rehearing or for rehearing en banc need not comply with Fed. R. App. P. 32.

- The petition or answer must be accompanied by a Certificate of Compliance found at Form 11, available on our website at [www.ca9.uscourts.gov](http://www.ca9.uscourts.gov) under *Forms*.
- You may file a petition electronically via the appellate ECF system. No paper copies are required unless the Court orders otherwise. If you are a pro se litigant or an attorney exempted from using the appellate ECF system, file one original petition on paper. No additional paper copies are required unless the Court orders otherwise.

### **Bill of Costs (Fed. R. App. P. 39, 9th Cir. R. 39-1)**

- The Bill of Costs must be filed within 14 days after entry of judgment.
- See Form 10 for additional information, available on our website at [www.ca9.uscourts.gov](http://www.ca9.uscourts.gov) under *Forms*.

### **Attorneys Fees**

- Ninth Circuit Rule 39-1 describes the content and due dates for attorneys fees applications.
- All relevant forms are available on our website at [www.ca9.uscourts.gov](http://www.ca9.uscourts.gov) under *Forms* or by telephoning (415) 355-7806.

### **Petition for a Writ of Certiorari**

- Please refer to the Rules of the United States Supreme Court at [www.supremecourt.gov](http://www.supremecourt.gov)

### **Counsel Listing in Published Opinions**

- Please check counsel listing on the attached decision.
- If there are any errors in a published opinion, please send a letter **in writing within 10 days** to:
  - ▶ Thomson Reuters; 610 Opperman Drive; PO Box 64526; Eagan, MN 55123 (Attn: Jean Green, Senior Publications Coordinator);
  - ▶ and electronically file a copy of the letter via the appellate ECF system by using “File Correspondence to Court,” or if you are an attorney exempted from using the appellate ECF system, mail the Court one copy of the letter.

### United States Court of Appeals for the Ninth Circuit

### BILL OF COSTS

This form is available as a fillable version at:

<http://cdn.ca9.uscourts.gov/datastore/uploads/forms/Form%2010%20-%20Bill%20of%20Costs.pdf>.

**Note:** If you wish to file a bill of costs, it **MUST** be submitted on this form and filed, with the clerk, with proof of service, within 14 days of the date of entry of judgment, and in accordance with 9th Circuit Rule 39-1. A late bill of costs must be accompanied by a motion showing good cause. Please refer to FRAP 39, 28 U.S.C. § 1920, and 9th Circuit Rule 39-1 when preparing your bill of costs.

v.  9th Cir. No.

The Clerk is requested to tax the following costs against:

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\* *Costs per page:* May not exceed .10 or actual cost, whichever is less. 9th Circuit Rule 39-1.

\*\* *Other:* Any other requests must be accompanied by a statement explaining why the item(s) should be taxed pursuant to 9th Circuit Rule 39-1. Additional items without such supporting statements will not be considered.

Attorneys' fees **cannot** be requested on this form.

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("s/" plus attorney's name if submitted electronically)

Date

Name of Counsel:

Attorney for:

*(To Be Completed by the Clerk)*

Date

Costs are taxed in the amount of \$

Clerk of Court

By: , Deputy Clerk