

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

THE BASU GROUP, INC.,

Plaintiff,

- against -

SEVENTH AVENUE, INC.,

Defendant.

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16 Civ. 461 (PGG)

**ORDER**

PAUL G. GARDEPHE, U.S.D.J.:

Plaintiff The Basu Group, Inc. ("Basu") brings this action against Defendant Seventh Avenue, Inc. asserting copyright infringement of Basu's peacock feather design under 17 U.S.C. § 101 et. seq. (See Cmplt. (Dkt. No. 1) ¶¶ 1, 11-24) Defendant has moved to dismiss pursuant to Fed. R. Civ. P. 12(b)(6), arguing that Basu has not demonstrated that Defendant's peacock feather design is substantially similar to Basu's peacock feather design. (See Dkt. No. 30)

**BACKGROUND**

Basu owns a registered copyright for a peacock feather design, and uses the design to decorate consumer goods it offers for sale, including women's handbags, purses, and wallets. (See Cmplt. (Dkt. No. 1) ¶¶ 5, 12, 14 and Ex. A) The Complaint alleges that Defendant Seventh Avenue – which sells consumer goods online – has infringed Basu's copyright by selling handbags that bear copies of Basu's peacock feather design. (See id. ¶¶ 7-9, 16-17)

The Complaint also asserts that "Defendant had full and specific knowledge of [Plaintiff's] copyright rights in the Peacock Feather Design" before manufacturing the allegedly infringing handbags at issue, because Basu had previously filed a copyright infringement lawsuit

against Defendant based on, inter alia, alleged infringement of Basu's peacock feather design. (Id. ¶ 19) The Complaint further asserts that Defendant has acted in "willful violation" of Basu's rights; that all of Defendant's acts with respect to Basu's peacock feather design are without permission, license, or consent; and that Defendant has been unjustly enriched by the alleged infringement. (See id. ¶¶ 21-23)

Defendant moved to dismiss on September 9, 2016. (Dkt. No. 30)

## **DISCUSSION**

### **I. STANDARD OF REVIEW**

"To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009) (quoting Bell Atl. Corp. v. Twombly, 550 U.S. 544, 570 (2007)). "In considering a motion to dismiss . . . the court is to accept as true all facts alleged in the complaint," Kassner v. 2nd Ave. Delicatessen Inc., 496 F.3d 229, 237 (2d Cir. 2007) (citing Dougherty v. Town of N. Hempstead Bd. of Zoning Appeals, 282 F.3d 83, 87 (2d Cir. 2002)), and must "draw all reasonable inferences in favor of the plaintiff." Kassner, 496 F.3d at 237 (citing Fernandez v. Chertoff, 471 F.3d 45, 51 (2d Cir. 2006)).

"In considering a motion to dismiss for failure to state a claim pursuant to Rule 12(b)(6), a district court may consider the facts alleged in the complaint, documents attached to the complaint as exhibits, and documents incorporated by reference in the complaint." DiFolco v. MSNBC Cable L.L.C., 622 F.3d 104, 111 (2d Cir. 2010) (citing Chambers v. Time Warner, Inc., 282 F.3d 147, 153 (2d Cir. 2002); Hayden v. Cty. of Nassau, 180 F.3d 42, 54 (2d Cir. 1999)).

## II. “SUBSTANTIAL SIMILARITY” UNDER THE COPYRIGHT ACT

Defendant argues that Basu has not demonstrated that Defendant’s peacock feather design is substantially similar to Basu’s peacock feather design. According to Defendant, under the ordinary observer test, the works at issue “do not share the same ‘total concept and feel’ and few aspects of the peacock feather portions of the works are the same.” (Def. Br. (Dkt. No. 30) at 13) To the extent the peacock feather designs look similar, it is because they portray unprotectible ideas found in nature. (Id. at 9)

### A. Legal Standard

Copyright protection is available for original works of authorship fixed in a tangible medium of expression. See 17 U.S.C. § 102(a). Copyright protection does not, of course, “extend to any idea.” 17 U.S.C. § 102(b). In order to establish a claim of copyright infringement, “a plaintiff with a valid copyright must demonstrate that: (1) the defendant has actually copied the plaintiff’s work; and (2) the copying is illegal because a substantial similarity exists between the defendant’s work and the protectible elements of plaintiff’s.” Peter F. Gaito Architecture, LLC v. Simone Dev. Corp., 602 F.3d 57, 63 (2d Cir. 2010) (quoting Hamil Am. Inc. v. GFI, 193 F.3d 92, 99 (2d Cir. 1999)).

“The standard test for substantial similarity between two items is whether an ‘ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard [the] aesthetic appeal as the same.’” Id. at 66 (quoting Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101, 111 (2d Cir. 2001)). “In applying the so-called ‘ordinary observer test,’ [the court] ask[s] whether ‘an average lay observer would recognize the alleged copy as having

been appropriated from the copyrighted work.”<sup>1</sup> *Id.* (quoting *Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F.3d 996, 1002 (2d Cir. 1995)).

The issue of substantial similarity is generally not susceptible to resolution as a matter of law:

The determination of the extent of similarity that will constitute a substantial, and hence infringing, similarity presents one of the most difficult questions in copyright law, and one that is the least susceptible of helpful generalizations. For that reason, and because the question of substantial similarity typically presents an extremely close question of fact, questions of noninfringement have traditionally been reserved for the trier of fact.

*Id.* at 63 (emphasis omitted) (internal citations omitted). “Although the question of substantial similarity often must be resolved by a jury, a district court may ‘resolve that question as a matter of law’ [where] . . . ‘no reasonable jury, properly instructed, could find that the two works are substantially similar.’” *DiTocco v. Riordan*, 815 F. Supp. 2d 655, 666 (S.D.N.Y. 2011) (citing

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<sup>1</sup> Courts apply a “more discerning” test where “a work contains both protectible and unprotectible elements.” In such circumstances, the court must “eliminate the unprotectible elements from its consideration and to ask whether the protectible elements, standing alone, are substantially similar.” *Hamil Am.*, 193 F.3d at 101 (citing *Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F.3d 996, 1002 (2d Cir. 1995); *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 765-66 (2d Cir. 1991)).

However, the “more discerning” test applies only where the copyrighted work “is not ‘wholly original,’ but rather incorporates elements from the public domain.” *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001) (quoting *Key Publ’ns, Inc. v. Chinatown Today Publ’g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991); see also *Aaron Basha Corp. v. Felix B. Vollman, Inc.*, 88 F. Supp. 2d 226, 231 (S.D.N.Y. 2000) (“[the more discerning] test applies only if a plaintiff has imported a substantial portion of its work from the public domain.” (citing *Hamil Am.*, 193 F.3d at 100-02)); *Diamond Direct, LLC v. Star Diamond Grp., Inc.*, 116 F. Supp. 2d 525, 530 n.31 (S.D.N.Y. 2000) (“[T]he Second Circuit has cautioned that [application of the “more discerning” test] is appropriate only where the other elements of the work have been copied from the public domain.”).

Here, Plaintiff’s peacock feather design is not – in whole or in part – “simply the [unprotectible] depiction of a [feather] as it would appear in nature. It is an artistic rendering that has its own unique qualities.” *Hamil Am.*, 193 F.3d at 101 (noting that “the fact that the designs at issue . . . portrayed flowers [does] not preclude the use of the ordinary observer standard”). Accordingly, the “ordinary observer” test is the appropriate standard in this case.

Gaito Architecture, 602 F.3d at 63); see Warner Bros. Inc. v. Am. Broad. Cos., 720 F.2d 231, 240 (2d Cir. 1983)).

“When a court is called upon to consider whether the works are substantially similar, no discovery or fact-finding is typically necessary, because ‘what is required is only a visual comparison of the works.’” Gaito Architecture, 602 F.3d at 64 (quoting Folio Impressions, Inc. v. Byer Cal., 937 F.2d 759, 766 (2d Cir. 1991)). Therefore, “where, as here, the works in question are attached to a plaintiff’s complaint, it is entirely appropriate for the district court to consider the similarity between those works in connection with a motion to dismiss, because the court has before it all that is necessary in order to make such an evaluation.” Id.

**B. Analysis**

Defendant argues that the two peacock feather designs at issue “do not share the same ‘total concept and feel,’” and claims that “few aspects of the peacock feather portions of the works are the same.” (Def. Br. (Dkt. No. 30) at 13) In support of this argument, Defendant lists a number of differences in background, design, color, and shape. (See id. at 7-9) Many of the differences cited by Defendant relate primarily to background and surrounding elements, however, and not to the peacock feather designs themselves. (See id. at 10 (noting abstract shapes in background)) Although Defendant argues that its list of differences “collectively shows substantial dissimilarities of the overall design” (Def. Reply Br. (Dkt. No. 33) at 9), the Court concludes that a reasonable jury could find that the numerous similarities between the two works substantially outweigh any alleged differences.

As an initial matter, the individual strands of each peacock feather design are roughly the same thickness and width. (Compare Cmplt. (Dkt. No. 1) Ex. A (original design) with id., Ex. B (allegedly infringing design)) In both designs, the width of each feather strand gradually tapers off to a point at the tip of the feather. In both designs, the feather strands feature colored inner lines with a black outer border. Many of the colors used in the two designs are the same. In particular, both designs feature blue strands with a black border. Both works also contain a colored, highly distinctive upside-down heart-shaped image in the center area of the feather. In both designs, this heart-shaped image is superimposed over an oval image of a contrasting color. These two shapes are, in turn, encircled by a roundish form, featuring yellow, green and purplish colors. Both designs share the same overall whimsical aesthetic. (Id.)

There are, of course, differences between the two designs. For example, Basu's design features a curved feather, while Defendant's feather is straight and shorter in length. Moreover, the colors utilized in the two designs are not identical. While Defendant's feather features the blue and black borders seen in Basu's feather design, Defendant also uses red and purple feather strands. (Id.) The point of this exercise is not to "set out to detect the disparities" between the two designs, however. Gaito Architecture, 602 F.3d at 66 (quoting Yurman Design, 262 F.3d at 111). Instead, the Court must determine – based on a visual comparison of the two designs – whether a substantial similarity exists between the two designs. See id. at 63. Having conducted that visual comparison, this Court concludes that a reasonable jury could find the two designs substantially similar, given the similar features discussed above.

Defendant argues, however, that this Court should not "totally disregard" the[] differences" in background colors used by Defendant and Plaintiff. (Def. Reply Br. (Dkt. No. 33) at 8) For example, Defendant notes that the red background color used on Defendant's

handbags matches the red “eye” in its feather design. Defendant contends that this feature – not seen in Basu’s handbags – transforms the peacock feather design and eliminates any similarity between the two designs. (See id. at 8-9 (citing Castle Rock Entm’t, Inc. v. Carol Pub. Group, Inc., 150 F.3d 132, n.9 (2d Cir. 1998) for the proposition that “if the secondary work sufficiently transforms the expression of the original work such that the two works cease to be substantially similar, then the secondary work . . . does not infringe the copyright of the original work.”))

The Court concludes that the differences in background colors are not sufficient to defeat Plaintiff’s claim that the two peacock feather designs are substantially similar. Plaintiff’s copyrighted design is the peacock feather, and Plaintiff’s infringement claim is based on the feather design, and not on any use of background color. The background colors used on Defendant’s handbags are not sufficient to transform the underlying peacock feather design at issue.

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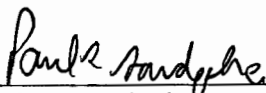
For the reasons discussed above, this Court cannot conclude, as a matter of law, that “no reasonable jury . . . could find that the two works are substantially similar.” DiTocco, 815 F. Supp. 2d at 666. Although there are differences between the two peacock feather designs, “the overall concept and feel of the designs is sufficiently similar for purposes of surviving the motion to dismiss.” I.C. ex rel. Solovsky v. Delta Galil USA, 135 F. Supp. 3d 196, 216 (S.D.N.Y. 2015). “[F]ocusing on minor deviations, even in great detail, is not sufficient to overcome the similarity between the two works at this stage of the litigation.” Id. (citing Knitwaves, 71 F.3d at 1004).

**CONCLUSION**

For the reasons stated above, Defendant's motion to dismiss is denied. Plaintiff's request for an award of attorneys' fees and costs (see Pltf. Br. (Dkt. No. 34) at 9) is denied. The Clerk of the Court is directed to terminate the motion (Dkt. No. 30).

Dated: New York, New York  
December 9, 2016

SO ORDERED.

  
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Paul G. Gardephe  
United States District Judge