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Cases of Note -- Copyright: Right to Publicity -- SLAPP and Anti-SLAPP

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**Cases of Note — Copyright**

**Right to Publicity — SLAPP and Anti-SLAPP**


Well. How can one resist a Paris Hilton case? And then when you combine it with Hallmark, the caption itself is worth a million dollars.

Paris Hilton is “famous for being famous.”

This was first applied to Zsa Zsa Gabor the much-married Hungarian. Now it seems to be about everybody on TV.

With Nicole Ritchie, she stars in “The Simple Life,” one of those couch potato reality TV shows which are so very much with us. There she undergoes ordeals — like waitressing fast food — for which her spoiled background has her ill-prepared. When amused, she says, “that’s hot,” and so convinced this is her very essence she has actually registered the phrase as a trademark.

Hallmark Cards of course fills the nations’ stationary shops with cards for all occasions. And trying to stay on the cutting-edge, they created the devilishly inventive “Paris’ First Day as a Waitress” card with Paris’ head on a cartoon body. She tells the customer “Don’t touch that, it’s hot.”

Rube queries, “What’s hot?” She says, “That’s hot.” The inside reads:

*Can you handle this? Are you sitting down?*

“Have a smokin’ hot birthday.”

I know the weaker-minded among you have already gone for your car keys to rush out and buy a gross of those. But for those still in your chair because you are stunned by the low-grade stupidity, weeping, throwing up, or whatever, let’s go forward.

Well, I can tell you, Paris was not amused. She sued Hallmark for misappropriation of publicity, false designation under the Lanham Act, and infringement of a federally registered trademark. And it ended up before those ever-entertaining folks of the Ninth Circuit.

The Lanham Act makes sense. You’re confused by the source of the card. Did Paris sell her likeness to Hallmark? And I guess she can own “that’s hot” in association with her face.

But it certainly does look like a rip-off of her right to her publicity. But not so fast. There’s a new twist here. Hallmark moved to dismiss under California’s Anti-SLAPP statute (Strategic Lawsuit Against Public Participation).

**Anti-SLAPP**

SLAPPS “masquerade as ordinary lawsuits but are brought to deter common citizens from exercising their political or legal rights or to punish them for doing so.” *Batzel v. Smith*, 333 F.3d 1018, 1024 (9th Cir. 2003)

The California legislature was disturbed by the growing number of suits designed to chill free speech. By statute they have provided a special motion to strike, Cal. Civ. Proc. Code §425.16(a)

There are four categories of communication, but the fourth is a catch-all: “any other conduct in furtherance of the exercise of the constitutional right of free speech in connection with a public issue or an issue of public interest.” Id. §425.16(e)(4).

The defendant must make “a threshold showing … of a right of petition or free speech … in connection with a public issue.” *Equilon Enter., LLC v. Consumer Cause, Inc.*, 52 P.3d 685, 694 (Cal. 2002).

The California Supreme Court has been pretty loose about the threshold showing. It’s enough that the activity be communicative. Cf. *Commonwealth Energy Corp. v. Investor Data Exch., Inc.*, 1 Cal. Rptr. 3d 390, 393 n.5 (Ct. App. 2003). Certainly it would suffice if it were “speech” under the First Amendment. So let’s define “speech.”

**Hallmark’s card** shows “[a]n intent to convey a particularized message …, and in the surrounding circumstances the likelihood was great that the message would be understood by those who viewed it.” *Spence v. Washington*, 418 U.S. 405, 410-11 (1974).

Are they serious? I’m sure that’s correct, but when you read something like that you still feel like you’ve stepped through the Looking Glass.

Anyhow, this definition gets Hallmark well within the “conduct in furtherance of.”

In Connection With a Public Issue or An Issue of Public Interest

Now it’s getting tougher. Hilton says they’ve ripped off her waitress role from “The Simple Life.” This is just a standard suit over who gets to profit from her image. There’s no issue of public interest here. Indeed a Seinfeldesque no issue at all. She’s just a celebrity who interests people despite being utterly shallow, ignorant and pointless.

So we go again to the Cal Supremes to see what they’ve said about issues of public interest. Where we find they have “declined to hold that [the Anti-SLAPP statute] does not apply to events that transpire between “private individuals.” *Navellier v. Sletten*, 52 P.3d 703, 710 (Cal. 2002).

That Hilton and Hallmark are not public figures is not important — i.e., you don’t have to be talking about their Terminator Governor.

And the protected activities don’t have to pertain to the lofty standard of self-government to receive protection. *Id.* At 710. Which is to say it doesn’t have to be matters of civic concern. The lowbrow is good enough.

And that certainly includes our Paris of “One Night in Paris,” sex tape fame.

Now how about public interest? Cal has come up with three categories of public issues: (1) statements “concern[ing] a person or entity in a public office or occupation” (2) “conduct that could directly affect a large number of people beyond the direct participants” (3) “a topic of widespread public interest.” *Rivero v. American Federation of State, County & Municipal Employees*, 130 Cal. Rptr. 2d 81, 89 (Ct. App. 2003).

You can certainly see the card fits within those. She is in the public eye and is a topic of widespread prurient interest. So Hallmark can strike her suit? No.

**Hallmark Has Merely Met the Threshold**

You might imagine that Hallmark is on a roll here, yet Paris can continue to litigate if she can show a likelihood of winning on the merits. Anti-SLAPP only knocks out cases where “plaintiff cannot state and substantiate a legally sufficient claim.” *Navellier*, 52 P.3d at 711. In truth, suits stricken at this point would “lack even minimal merit.” *Id.* At 708.

We’re talking heavyweight corporate lawyers bringing a totally bogus, baseless suit continued on page 51
**Questions & Answers — Copyright Column**

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**QUESTION:** May public libraries use tutorials created under a Creative Commons license on their library Websites without worry about infringement? What would happen if the owner decided to sue for infringement?

**ANSWER:** The Creative Commons (CC) offers a variety of voluntary licenses that a copyright owner may adopt which work along with copyright. So, the answer to the question depends on the type of CC license and the rights that it grants to users. For example, if the CC license for the tutorial is an attribution license, then the library may post the tutorial on its Website but must give credit to the owner of the tutorial. The licenses are detailed on the CC Website at: http://creativecommons.org/about/licenses/.

Should a copyright owner wish to sue someone who violates the terms of CC license, it would be filed in state court since it is a contract matter rather than a copyright one. However, the owner still has a U.S. copyright and could withdraw the CC license at anytime and then sue anyone who subsequently infringes the copyright, even if the defendant is doing something that would have been permitted under the prior CC license. Copyright infringement is a federal matter.

**QUESTION:** A college dance teacher has a personal use license from iTunes. She has loaded the music on her laptop for her personal use but also wants to play the songs in her dance classes. Is this permitted?

**ANSWER:** The question will be answered by the iTunes license agreement. Typically, a “personal use license” does not allow use even in nonprofit educational institutions because this is not a personal use. Apple does offer educational licenses, however, as well as licenses for a number of other organizations. See http://developer.apple.com/softwarelicensing/agreements/itunes.html. Thus, the individual teacher as well as the school could be liable for using the recordings from her personal use license for a dance class.

**QUESTION:** A university library is interested in digitizing handbooks that the university published in order to make them available to the general public. A chapter in one of the handbooks has the following footnote: “Reprinted and adapted from Group Leadership by Robert D. Leigh, by permission of W.W. Norton and Company, Inc. Copyright 1936 by the publishers.” Is the university allowed to digitize this handbook for Group Leadership was been reissued. Assuming the copyright in this publication has not yet expired, does the University have a duty to contact the copyright owner of the work in order to digitize the handbook?

**ANSWER:** Yes, the university should try to contact the publisher or its successor. The original rights granted did not include the digital rights. But this depends on whether the copyright was renewed and the question “are the not the same” indicates that renewal information was not available. It further depends on the university’s willingness to accept the risk that a 1936 work may not have been renewed or that, even if it were renewed, the publisher will not complain when the university library digitizes the handbooks and makes them available on the Web.

**QUESTION:** A faculty member has a DVD of a Disney movie that was originally produced in 1937. He wants to take a freeze frame from the movie and make a poster from the image and is concerned about whether the work is still under the copyright.

**ANSWER:** Transformative expression “is” not confined to parody and can take many forms, including “fictionalized portrayal… heavy-handed lampooning…[and] subtle social criticism.” Id. At 809.

**Hallmark** certainly held that defense. However, *Hilton* could show the “minimal merit” defeating *Hallmark’s* motion to strike. So let’s do that.

In “Sonic Burger Shenanigans” *Hilton* and *Ritchie* cruise on roller skates serving customer’s cars. And *Hilton* will say that this or that is “hot.” *Hilton* says the card is a total rip-off of the episode. *Hallmark* says it’s transformative because the setting is different and “that’s hot” is a literal warning about the temperature of food.

**Hmmm. Shall we call that disingenuous?**

True, there are minor differences in setting, food, and uniform. *Hilton*’s head sits on a cartoon body. But it’s really the same thing and wouldn’t have any impact on the public if it were not.

**Public Interest**

In California, “no cause of action will lie for the publication of matters in the public interest, which rests on the right of the public to know and the freedom of the press to tell it.” *Montana v. San Jose Mercury News, Inc.*, 40 Cal Rptr. 2d 639, 640 (Cal. App. 1995). Now that includes shallow celebrities because “[p]ublic interest attaches to people who by their accomplishments or mode of living create a bona fide attention to their activities.” *Dora v. Frontline Video, Inc.*, 18 Cal. Rptr. 2d 790, 792 (Cal. App. 1993).

But, looked at carefully, *Hallmark* is not helped in the least. Read: “publication of matters in the public interest.” It’s explicitly linked to the reporting of public matters. See *Montana*, 40 Cal. Rptr. 2d at 640-42.

And this is after all just a particularly lame greeting card that doesn’t add to our stock of vital knowledge about Paris. Such as a really juicy Vanity Fair article about rich-shot teenagers burglarizing her house repeatedly and her never noticing anything was missing.

So *Hallmark* can’t strike under the Anti-SLAPP statute and must go to trial with its particularly weak defenses.

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