

June 2010

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Recommended Citation

Strauch, Bruce (2010) "Cases of Note -- Copyright: Right to Publicity -- SLAPP and Anti-SLAPP," *Against the Grain*: Vol. 22: Iss. 3, Article 24.

DOI: <https://doi.org/10.7771/2380-176X.5563>

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LEGAL ISSUES



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Cases of Note — Copyright

Right to Publicity – SLAPP and Anti-SLAPP

by **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>

Paris Hilton v. Hallmark Cards, United States of Appeals for the Ninth Circuit, 2010 U.S. App. LEXIS 6104 (2009).

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 is so convinced this is her very essence she has actually registered the phrase as a trademark.

Hallmark Cards of course fills the nations’ stationery 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 connections 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 Enters., 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.

Anyway, 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. Stetten*, 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 Gubernator.

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 the public eye”; (2) “conduct that could directly affect a large number of people beyond the direct participants” (3) “or 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

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against pathetic little local shopper paper to frighten them to death with legal costs.

Paris' suit misappropriation of the common law right of publicity has these elements: "(1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury." *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1001 (9th Cir. 2001).

Hallmark doesn't dispute that all are present. Rather they raise the affirmative defenses of "transformative use" and "public interest."

Transformative

The First Amendment protects an artist's otherwise rip-off copying if it is sufficiently *transformative* or "the value of the work does not derive primarily from the celebrity's fame." *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 810 (Cal. 2001).

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 had 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 (Ct. App. 1995). And 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 (Ct. 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 newsworthy items. *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-snot 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. 🐼

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 songs 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." It is unclear whether the copyright for Group Leadership was been renewed. 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 not the same as" 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 1957. 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: It is still under copyright. **Disney** studios has always been very careful about renewing its copyrights. The copyright in the original movie would have been 28 years, so it was protected without renewal until 1985. In 1991 the **Copyright Act** was amended to eliminate copyright renewals and to give works published between 1964 and 1978 an automatic 75 years of protection with no need to renew the copyright. In 1998 the term of copyright was extended by an additional 20 years, so the work produced in 1957 will remain under copyright until 2052. **Disney Studios** also is very vigorous in enforcing its copyrights.

QUESTION: *A university library received a photography archive of a famous woman photographer upon her death in 1990. One of her more famous photographs is a portrait of an author that was used on the book jacket of his most popular book. When the author died, the library was asked repeatedly for permission to use this portrait in news stories to announce the author's death. Is it a copyrighted photograph? Does the university own the copyright?*

ANSWER: The copyright status of her photographs is likely to be unclear. If they were published with notice, then they were protected by copyright from the date of publication. If the photos were published without a copyright notice, they entered the public domain. The term of copyright depends on when they were published with notice. *See* www.unc.edu/~unclng/public-d.htm to determine the term.

Another question for this particular issue is whether the photographer transferred the copyright to the publisher of the book or to the author or whether she retained the copyright in this particular photograph. This will take some research in order to determine the publication arrangement between the publisher and the

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