

A VIEW FROM THE BRIDGE:
NAVIGATING THROUGH RECENT COPYRIGHT, RIGHT OF
PUBLICITY AND TRADEMARK RULINGS IN THE 9TH CIRCUIT AND
UNITED STATES SUPREME COURT

Los Angeles Copyright Society
Dinner Meeting Oct. 13, 2010

I. **Developments Regarding the Right of Publicity:**

White v. Samsung Electronics America, Inc., 971 F.2d 1395 (9th Cir. 1992) (reversing summary judgment) Ads which predicted that current products would be items used in the 21st Century, to humorous effect. A robot with a blond wig and gown to resemble Vanna White was standing next to a "Wheel of Fortune" game. Held: Civil Code Section 3344(a) action properly dismissed because robot in advertisement was not plaintiff's "likeness." However, triable issue existed whether the ad depicting robot had appropriated her "identity" and violated Vanna White's common-law right of publicity or constituted an implied endorsement in violation of Lanham Act section 43(a). Dissent by Judge Alarcon who concluded no identification of White merely because Wheel of Fortune set might remind a viewer of White. No Lanham claim because no deception. Parody could provide a defense. "The difference between a 'parody' and a 'knockoff' is the difference between fun and profit."

989 F.2d 1512 (9th Cir. 1993) (**Kozinski, J., dissenting from order rejecting suggestion for rehearing en banc, joined by Alarcon, Kleinfeld, O'Scannlain**), over-protecting private property is harmful.

Wendt v. Host Intl, Inc., 125 F.3d 806 (9th Cir. 1997) (reversed summary judgment for defendants who operated airport Cheers bars, licensed by Paramount, owner of the "Cheers" series. Plaintiffs George Wendt and John Ratzenberger, who played characters Norm and Cliff, sued for violation of statutory and common law rights of publicity and unfair competition. District court earlier found no use of likeness based on photos of plaintiffs. After reversal and remand, district court repeated ruling based on plaintiffs' appearance in court.

197 F.3d 1284 (9th Cir. 1999) (**Kozinski, J. dissenting from order rejecting the suggestion for rehearing en banc, joined by Judges Kleinfeld and Tashima**). Now conflicting with copyright law. Paramount owns the characters.

Hilton v. Hallmark Cards, 2010 WL 1039872 (9th Cir. 2010) (affirmed denial of anti-SLAPP motion directed to Paris Hilton's claim for violation of common law right of publicity. Triable issue whether greeting card was entitled to First

Amendment defense based on California's "transformative" test, set out in Comedy III Rods, Inc. v. Gary Saderup, Inc., 25 Cal. 4th 387 (2001) (Three Stooges drawings not sufficiently transformative); Winter v. DC Comics, 30 Cal. 4th 881 (2003) (transformative comic book parody of Winter Bros., depicted as half human, half worms).

II. Developments Regarding Copyright Infringement Standards:

In 1977, in Sid & Marty Krofft Television v. McDonalds Corp., the Ninth Circuit created a new way of analyzing copyright infringement claims. Extrinsic and Intrinsic tests of ideas and expression. Extrinsic test may sometimes be decided as a matter of law. Can't get to trial unless pass the extrinsic test. Later, in Shaw v. Lindheim (9th 1990), the Ninth Circuit told us that both tests analyze similarity of protected expression.

Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 556 (1985) ("copyright's idea/expression dichotomy 'strike[s] a definitional balance between the First Amendment and The Copyright Act by permitting free communication of facts while protecting an author's expression.'... No author may copyright his ideas or the facts he narrates.")

Metcalf v. Bochco, 294 F.3d 1069 (9th Cir. 2002) (reversing summary judgment for defendants, holding that triable issue existed as to whether defendants' TV series set in an inner city hospital was substantially similar to plaintiff's treatment. Judge Kozinski wrote that there was protecting in the selection and sequence of generic elements. He added:

The Metcalf's case is strengthened considerably by Bochco's concession of access to their works, Shaw [v. Lindheim], 919 F.2d at 1361 [9th Cir. 1990] ["The Equalizer" case]. One of the defendants, Michael Warren, allegedly stated that he had read three versions of the script, and had passed them on to defendant Steven Bochco, who had also read them and liked them. Warren and Bochco were intimately involved with "City of Angels," as star and writer, respectively. If the trier of fact were to believe that Warren and Bochco actually read the scripts, as alleged by the Metcalfs, it could easily infer that the many similarities between plaintiffs' scripts and defendants' work were the result of copying, not mere coincidence.

[On remand and trial, a jury rendered a general verdict for defendants, which was affirmed on appeal. 200 Fed. Appx. 635 (9th Cir. 2006).]

Rice V. Fox Broadcasting Co., 330 F.3d 1170 (9th Cir. 2003) (affirms summary judgment for defendants TV magician special series for lack of substantial

similarity with plaintiff's "Mystery Magician" video, even though some evidence of "access." The panel reasoned:

Here, there is no such concession of access as most of Rice's claim based purely on speculation and inference. Because we are not confronted with the same totality of similarities and the same degree of access, this case is readily distinguishable from Metcalf.

Funky Films v. Time Warner Entertainment Co., 462 F.3d 1072 (9th Cir, 2006) (affirms summary judgment for defendant HBO's program "Six Feet Under" for lack of substantial similarity of protected expression, even though district court assumed "access" for sake of the motion). Panel concludes that assumption of access has no affect where there is no similarity.

"We do not agree that appellants' invocation of the inverse-ratio rule requires reversal of the district court's decision. 'No amount of proof of access will suffice to show copying if there are no similarities, Krofft, 562 F.2d at 1172..."

Benay v. Warner Bros. Entert. Inc., 607 F.3d 620 (9th Cir. 2010) ("The Last Samurai") (affirms summary judgment on copyright claim; reverses summary judgment on implied-in-fact contract). Remanded contract claim to the district court. Holds that the works are not substantially similar as to protectible expression because both based on historical fact and other similarities relate to ideas and scènes-à-faire. The panel reasoned:

"Even if the Defendants had access to the [Plaintiffs'] Screenplay, the Benays have not shown sufficient similarity between the Screenplay and the Film to maintain an infringement claim under federal copyright law."

III. Developments Regarding Trademarks and the Lanham Act:

Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir. 1997) (affirmed preliminary injunction, holding that book "The Cat NOT In The Hat": a prima facie case of copyright infringement existed because the book was substantially similar to "The Cat In The Hat"; the book was not a parody because it did not target the original and thus was nit a fair use; serious questions existed whether the book infringed plaintiff's trademark and the injunction was not overbroad.

Mattel, Inc. v. MCA Records, Inc. (song "Barbie Girl") (Kozinski, J.) The Ninth Circuit adopts the Second Circuit approach to the alleged use of plaintiff's trademark in defendants' expressive work. Because of the balancing of First Amendment considerations, some amount of possible confusion is tolerated, if the defendants' use if artistically relevant to the defendant's expressive work and the use is not explicitly misleading.'

E.S.S. Entertainment 2000 Inc. v. Rock Star Videos, Inc., 547 F.3d 1095 (9th Cir. 2008) (affirms summary judgment for defendant videogame “Grand Theft Auto; San Andreas”) Use of title “Pig Pen Gentlemen’s Club” to describe fictional strip joint was artistically relevant to the story in the videogame and not explicitly misleading so as to create confusion or implied endorsement by Plaintiff’s “Play Pen Gentlemen’s Club” located in East L.A. Holds that the artistic relevance need only be more than zero.

Perfect 10 v. Visa, 494 F.3d 788 (9th Cir, 2007) (Kozinski, J., dissenting)

IV. Obsessive Authors:

In **Litchfield v. Spielberg**, 736 F.2d 1352, 1358 (9th Cir. 1984), Circuit Judge Eugene Wright concluded a decision affirming a summary judgment for defendants, holding that the movie “E.T. The Extraterrestrial” was not substantially similar to expression in the unpublished play “Lokey From Maldemar” and thus did not infringe plaintiff’s copyright – with these words borrowed from the Second Circuit:

As is too often the case, Litchfield’s action was premised

“partly upon a wholly erroneous understanding of the extent of copyright protection; and partly upon that obsessive conviction, so common among authors and composers, that all similarities between their works and any others which appear later must inevitably be ascribed to plagiarism.”



Vanna White

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C.A.9,1993.
White v. Samsung Electronics America, Inc.
989 F.2d 1512, 21 Media L. Rep. 1330, 26
U.S.P.Q.2d 1362

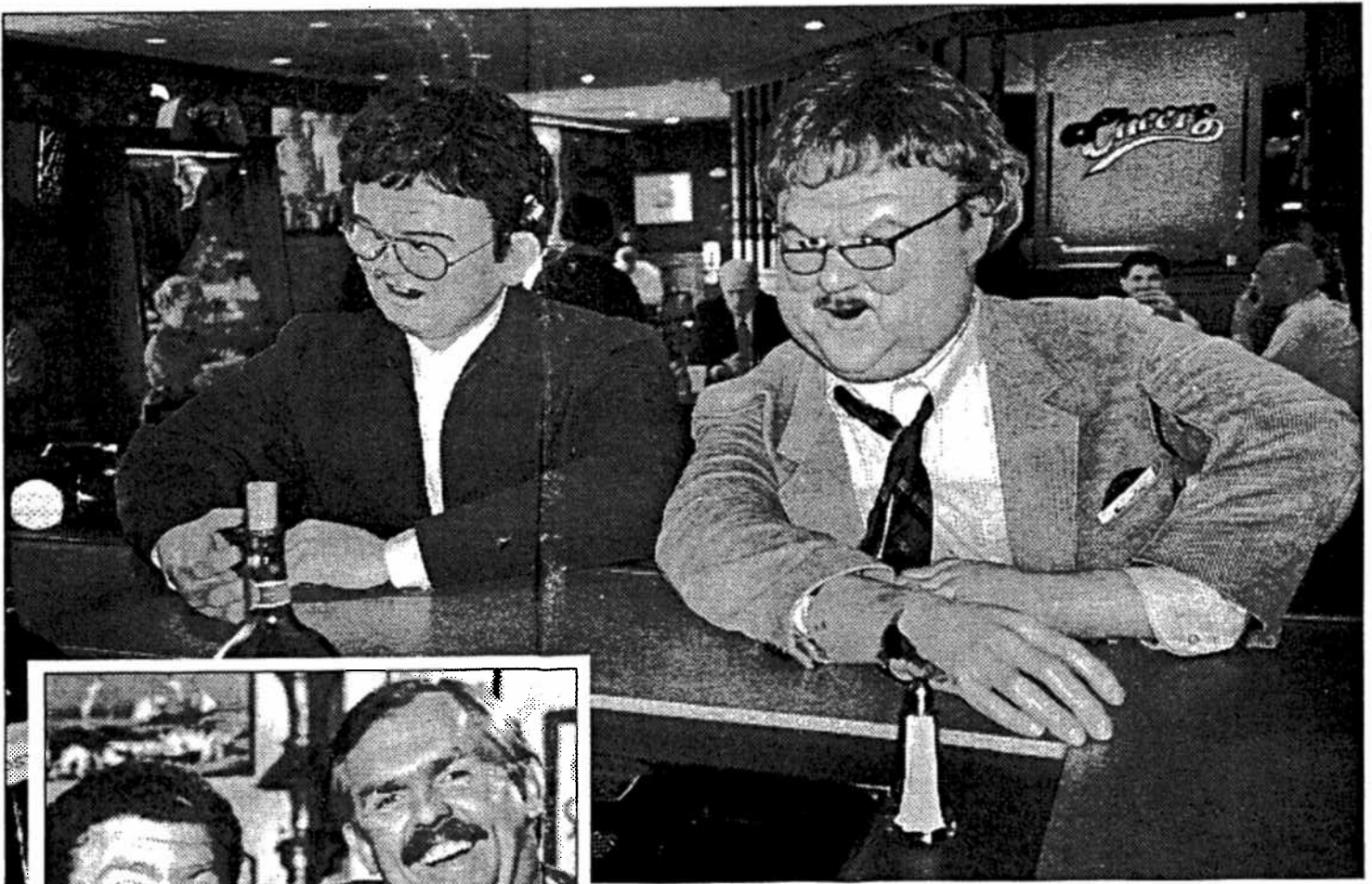
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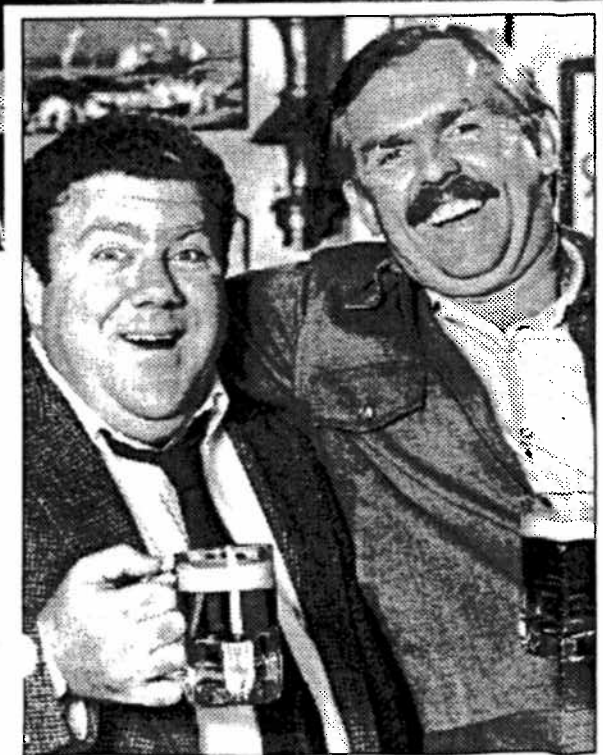
Daily Journal

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OFFICIAL NEWSPAPER OF THE CITY OF LOS ANGELES AND THE COUNTY OF



The Commercial Appeal



Associated Press

IDENTITY CRISIS — George Wendt, left, and John Ratzenberger, who played Norm and Cliff on the long-running sitcom "Cheers," have been battling a seven-year suit against Host International for allegedly portraying their likenesses in the form of robots at airport bars.

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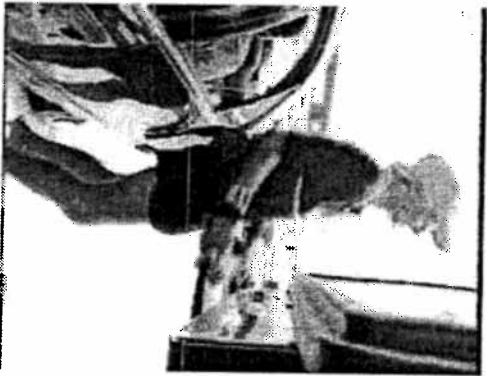
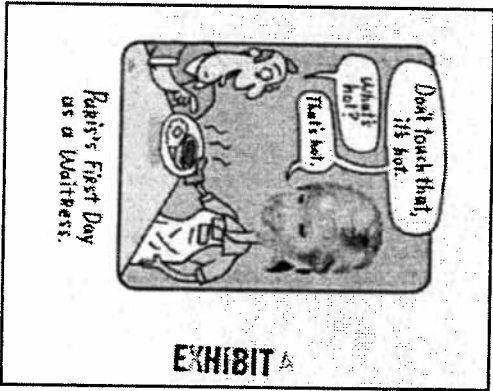
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Paris's First Day
as a Waitress.

Have a smokin' hot birthday.



Cite as 109 F.3d 1394 (9th Cir. 1997)

It is the rule in this Circuit that though the satire need not be only of the copied work and may . . . also be a parody of modern society, the copied work must be, at least in part, an object of the parody, otherwise there would be no need to conjure up the original work. . . . By requiring that the copied work be an object of the parody, we merely insist that the audience be aware that underlying the parody there is an original and separate expression, attributable to a different artist.

Similarly, the American Heritage Dictionary defines "parody" as a "literary or artistic work that broadly mimics an author's characteristic style and holds it up to ridicule."

We now turn our attention to *The Cat NOT in the Hat!* itself. The first two pages present a view of Los Angeles, with particular emphasis on the connection with Brentwood, given the depiction of the news camera lights. The story begins as follows:

A happy town
 Inside L.A.
 Where rich folks play
 The day away.
 But under the moon
 The 12th of June.
 Two victims flail
 Assault! Assail!
 Somebody will go to jail!
 Who will it be?
 Oh my! Oh me!

The third page reads: "One Knife? / Two Knife? / Red Knife / Dead Wife." This stanza no doubt mimics the first poem in Dr. Seuss' *One Fish Two Fish Red Fish Blue Fish*: "One fish / two fish / red fish / blue fish. Black fish / blue fish / old fish / new fish." For the next eighteen pages, Katz writes about Simpson's trip to Chicago, the noise outside Kato Kaelin's room, the bloody glove found by Mark Fuhrman, the Bronco chase, the booking, the hiring of lawyers, the assignment of Judge Ito, the talk show inter-

est, the comment on DNA, and the selection of a jury. On the hiring of lawyers for Simpson, Katz writes:

A plea went out to Rob Shapiro
 Can you save the fallen hero?
 And Marcia Clark, hooray, hooray
 Was called in with a justice play.
 A man this famous
 Never hires
 Lawyers like
 Jacoby-Meyers.
 When you're accused of a killing scheme
 You need to build a real Dream Team.
 Cochran! Cochran!
 Doodle-doo
 Johnnie, won't you join the crew?
 Cochran! Cochran!
 Deedle-dee
 The Dream Team needs a victory.

These stanzas and the illustrations simply retell the Simpson tale. Although *The Cat NOT in the Hat!* does broadly mimic Dr. Seuss' characteristic style, it does not hold *his style* up to ridicule. The stanzas have "no critical bearing on the substance or style of" *The Cat in the Hat*. Katz and Wrinn merely use the Cat's stove-pipe hat, the narrator ("Dr. Juice"), and the title (*The Cat NOT in the Hat!*) "to get attention" or maybe even "to avoid the drudgery in working up something fresh." *Acuff-Rose*, 510 U.S. at 580, 114 S.Ct. at 1172. While Simpson is depicted 13 times in the Cat's distinctively scrunched and somewhat shabby red and white stove-pipe hat, the substance and content of *The Cat in the Hat* is not conjured up by the focus on the Brown-Goldman murders or the O.J. Simpson trial. Because there is no effort to create a transformative work with "new expression, meaning, or message," the infringing work's commercial use further cuts against the fair use defense.⁹ *Id.* at 578, 114 S.Ct. at 1171.

9. Penguin and Dove emphasize that the Court in *Acuff-Rose* held that it was error to rule that the commercial, profit-making nature of the defendant's exploitation created a presumption of no fair use defense, overshadowing the other factors to be weighed as to fair use. We agree. Howev-

er, the district court's problem with the fair use defense on these facts was not with the commercial nature of the accused work. The court found that *The Cat NOT in the Hat!* was not entitled to a parody fair use defense because it failed to target the original work.



Fourth, there is no evidence of actual confusion. Because *The Cat NOT in the Hat!* has been enjoined from distribution, there has been no opportunity to prove confusion in the market place. Fifth, the marketing channels used are indeterminate. Sixth, the use of the Cat's stove-pipe hat or the confusingly similar title to capture initial consumer attention, even though no actual sale is finally completed as a result of the confusion, may be still an infringement. See *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 257-58 (2d Cir.1987). Seventh, Penguin and Dove's likely intent in selecting the Seuss marks was to draw consumer attention to what would otherwise be just one more book on the O.J. Simpson murder trial. Eighth and last, the likelihood of expansion of the product lines is indeterminate.

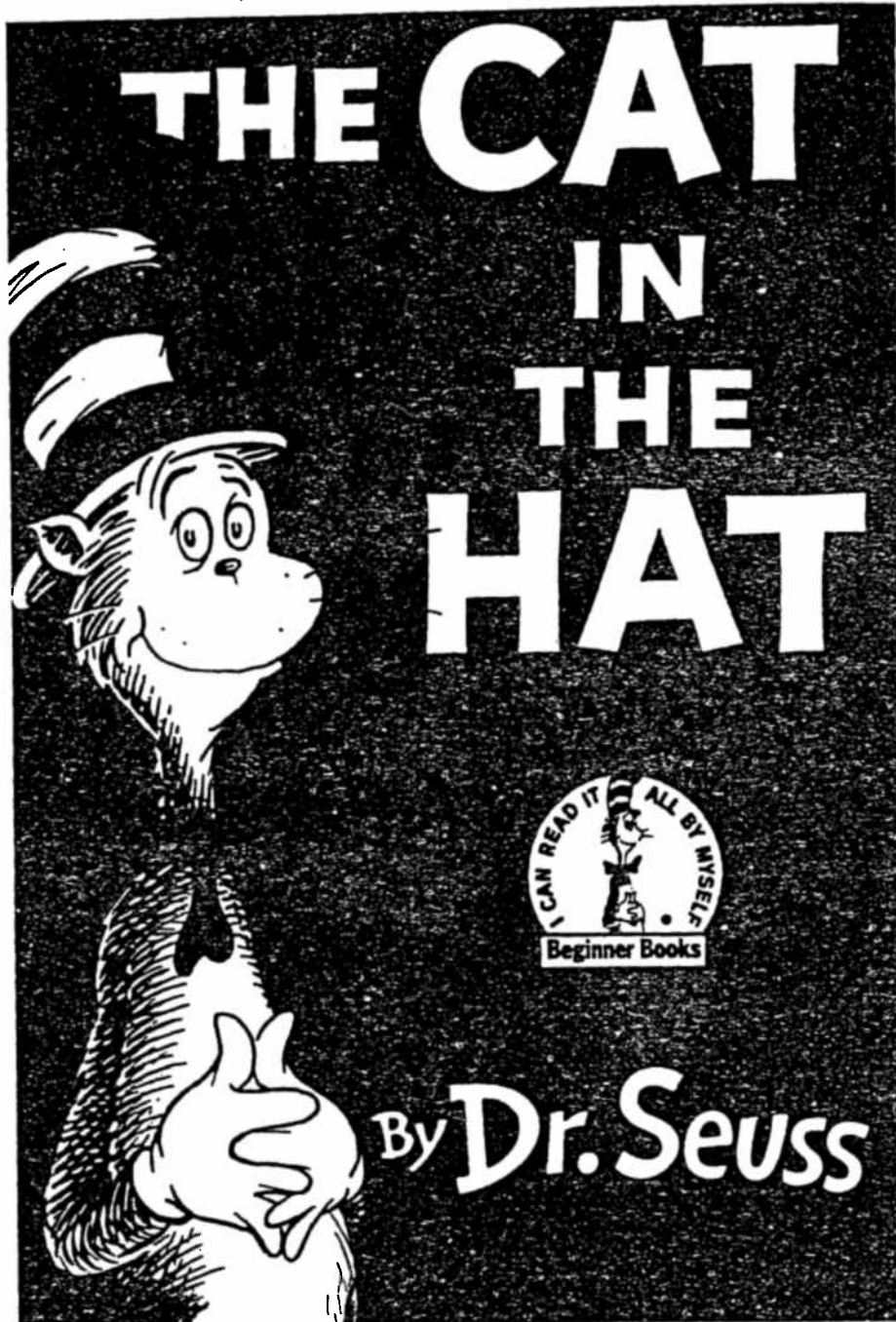
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[10] Even if Seuss establishes a likelihood of confusion, Penguin and Dove argue that their identical and confusingly similar use of Seuss' marks is offset by the work's parodic character. In a traditional trademark infringement suit founded on the likelihood of confusion rationale, the claim of parody is not really a separate "defense" as such, but merely a way of phrasing the traditional response that customers are not likely to be confused as to the source, sponsorship or

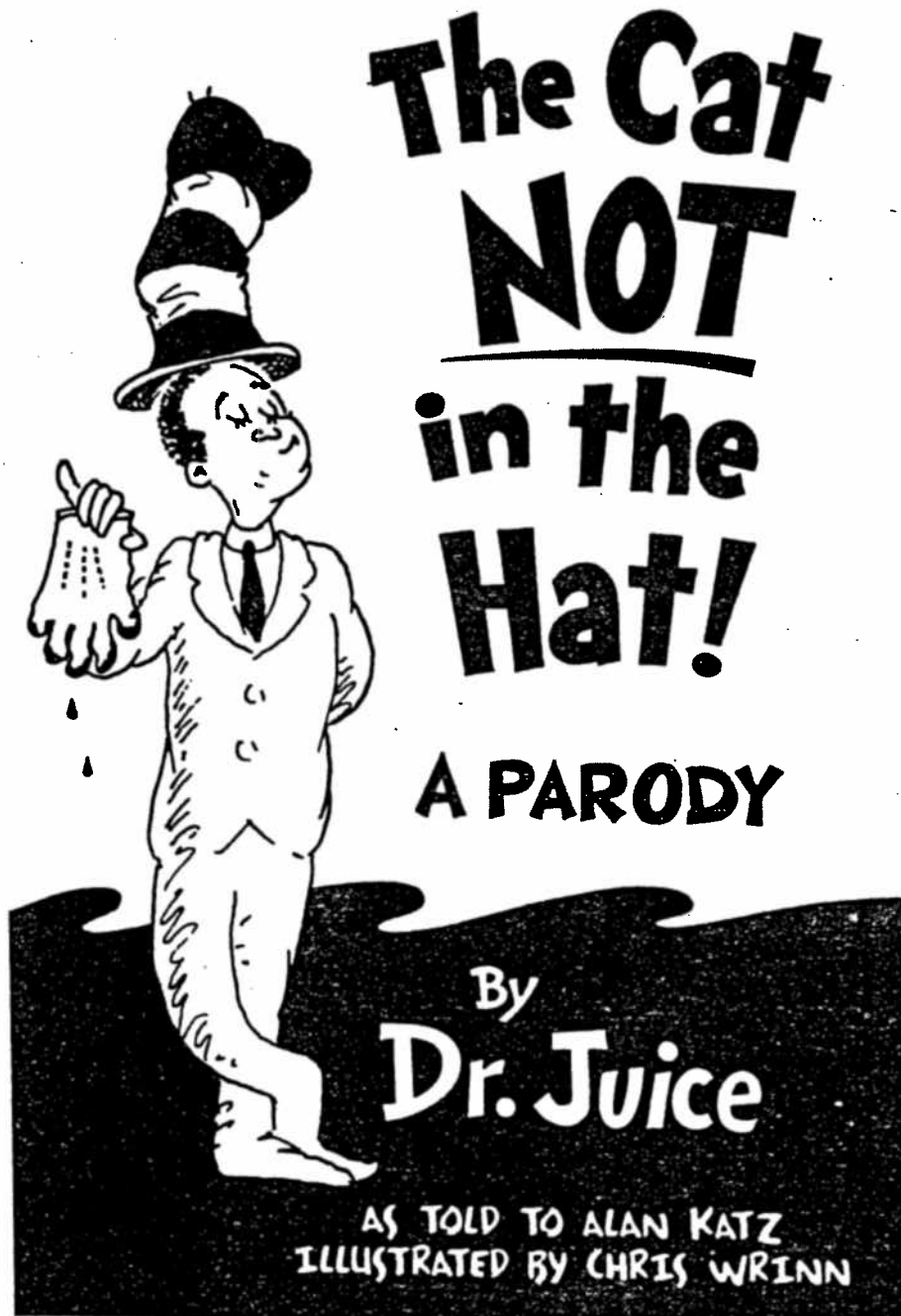
approval. *Mutual of Omaha Ins. Co. v. Novak*, 648 F.Supp. 905, 910 (D.Neb.1986), *aff'd*, 836 F.2d 397 (8th Cir.1987). "Some parodies will constitute an infringement, some will not. But the cry of 'parody!' does not magically fend off otherwise legitimate claims of trademark infringement or dilution. There are confusing parodies and non-confusing parodies. All they have in common is an attempt at humor through the use of someone else's trademark. A non-infringing parody is merely amusing, not confusing." *McCarthy on Trademarks*, § 31.38[1], at 31-216 (rev. ed.1995).

In several cases, the courts have held, in effect, that poking fun at a trademark is no joke and have issued injunctions. Examples include: a diaper bag with green and red bands and the wording "Gucci Goo," allegedly poking fun at the well-known Gucci name and the design mark, *Gucci Shops, Inc. v. R.H. Macy & Co.*, 446 F.Supp. 838 (S.D.N.Y.1977); the use of a competing meat sauce of the trademark "A.2" as a "pun" on the famous "A.1" trademark, *Nabisco Brands, Inc. v. Kaye*, 760 F.Supp. 25 (D.Conn.1991). Stating that, whereas a true parody will be so obvious that a clear distinction is preserved between the source of the target and the source of the parody, a court found that the "Hard Rain" logo was an infringement of the "Hard Rock" logo. In such a case, the claim of parody is no defense

Attachment #1



Attachment #2



The Cat NOT in the Hat!

A PARODY

By
Dr. Juice

AS TOLD TO ALAN KATZ
ILLUSTRATED BY CHRIS WRINN