Ninth Circuit Rules That Paris Hilton May Proceed with Her Right of Publicity Claim Despite Hallmark's Free Speech Challenge

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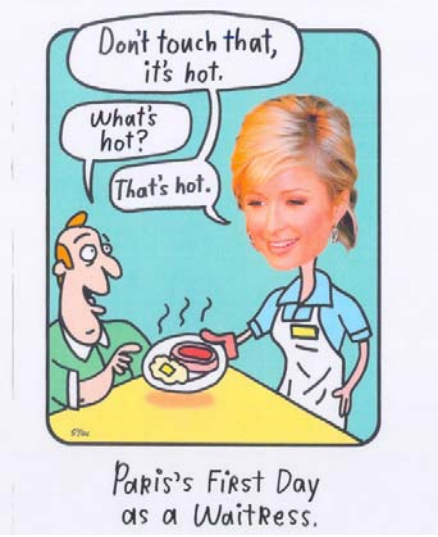
Companies must be careful when considering the use of a person's image, likeness or other identifying material for commercial purposes without that person's permission because many states protect a person's "right of publicity" through statute or the common law. Thus, unauthorized use can result in liability for damages.

California in particular has a long history of protecting celebrities' commercial publicity rights. It also has codified its citizen's right to be free from meritless lawsuits filed merely to chill their First Amendment rights so that they may comment upon matters of public interest. These two rights came into conflict when Hallmark decided to use Paris Hilton's face and her catch-phrase "That's hot" on one of its birthday cards – shown below. The inside of the card reads, "Have a smokin' hot birthday."



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In *Hilton v. Hallmark Cards*, No. 08-55443, __ F.3d. __, 2009 WL 2710225 (9th Cir. 2009), the Ninth Circuit affirmed the lower court's denial of Hallmark's anti-SLAPP ("strategic lawsuit against public participation") challenge to Paris Hilton's claim that her right of publicity had been misappropriated by Hallmark's above birthday card.

California enacted Cal. Cod. Civ. Pro. § 425.16 to "encourage continued participation in matters of public significance, and [because] this participation should not be chilled through abuse of the judicial process" and encouraged courts to interpret the statute broadly." It permits the filing of a special motion to strike against a cause of action "arising from any act…in furtherance of the…right of petition or free speech…unless the court determines that the plaintiff has established that there is a probability that the plaintiff will prevail on the claim." Cal. Cod. Civ. Pro. § 425.16(b)(1).

Cal. Cod. Civ. Pro. § 425.16(e) defines four categories of acts that are in furtherance of free speech or right of petition. (e)(4) was at issue here: "…any other conduct in furtherance of the exercise of the constitutional right of petition or the constitutional right of free speech in connection with a public issue or an issue of public interest."

The Ninth Circuit found that California courts analyze anti-SLAPP motions to strike in two steps: (1) the movant must first show that the acts of which plaintiff complains were taken in furtherance of the movant's free speech or petition rights; (2) then the plaintiff must demonstrate that the complaint is legally sufficient and supported by a sufficient prima facie showing of facts to sustain a favorable judgment if plaintiff's evidence is credited.

The Ninth Circuit determined that Hallmark had met its burden in showing that its birthday card was the type of "speech" potentially protected under the statute and the sale of the card was "in connection with a public issue or an issue of public interest." It denied Hilton's argument that the card was commercial speech not subject to such a motion to strike, stating in a footnote that "Hallmark's card is not advertising the product, it *is* the product." (emphasis original). Furthermore, the Ninth Circuit found that the statements in the card concerned a person in the public eye who is a topic of widespread, public interest – Paris Hilton.

While the Court credited Hallmark's argument that its conduct fell within the scope of the anti-SLAPP statute, it found that Hilton had met her burden of presenting a prima facie case that Hallmark could not overcome through its affirmative defenses. Under California law, Hilton would have to establish that: (1) Hallmark used Hilton's identity; (2) Hallmark appropriated Hilton's likeness to Hallmark's advantage; (3) Hallmark did not have Hilton's consent; and (4) as a result, Hilton suffered injury. Hallmark had not challenged that Hilton would be able to establish these elements. Instead, Hallmark asserted two affirmative defenses based upon the First Amendment: (1) the transformative use defense and (2) the public interest defense. To prevail on its motion to strike, Hallmark would have to establish its entitlement to either defense as a matter of law, i.e., that no trier of fact could reasonably conclude otherwise, but the Ninth Circuit found against Hallmark on both defenses.

To establish that its use was transformative, Hallmark had to show that the card "had become primarily [Hallmark's] expression", as opposed to just a use of Hilton's likeness. California and, for purposes of this case, the Ninth Circuit views the transformative use defense as a balancing test

between the First Amendment and the right of publicity. If Hallmark's "skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of [Hilton] so as to commercially exploit her fame, then [Hallmark's] right of free expression is outweighed by the right of publicity." Here, the Ninth Circuit found that Hallmark's use was not transformative because the basic setting of the card also was the setting of Hilton's then well-known role in the reality television series, "The Simple Life" and the use of Hilton's catchphrase appeared consistently in its familiar, idiomatic setting. The Court noted the basic similarity in setting, "we see Paris Hilton, born to privilege, working as a waitress...There is no larger story here, just a spoof on a scene from Hilton's television program." The Court found unavailing that Hallmark highlighted minor differences between its card and the specific episode of "The Simple Life" at issue here – the use of a cartoon body instead of Hilton's real body, different food, different type of restaurant.

To establish a public interest defense under California law, Hallmark had to show that Hilton's cause of action arises from 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." The Ninth Circuit found that the card did not "publish or report information" and, therefore, Hallmark could not rely upon the public interest defense.

If you are considering using a celebrity image in connection with the marketing of a product, consult an attorney to determine whether and what kind of permission is necessary to proceed.

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