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Hallmark seeks rehearing of dispute over Paris Hilton card

Amanda Bronstad
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Hallmark Cards Inc. has asked the full "Court of Appeals for the Hollywood Circuit" to reconsider a ruling that pits the greeting card company's First Amendment rights against Paris Hilton's right to her own image.

A panel of the U.S. Court of Appeals for the 9th Circuit ruled on Aug. 31 that a greeting card bearing Hilton's image and catchphrase constituted free speech and that Hilton is indeed "a topic of widespread, public interest," but that the hotel heiress still could argue that the card misappropriated her likeness.

On Sept. 18, Hallmark asked the en banc 9th Circuit to reverse that conclusion.

"Spoofing how a celebrity appears in a work that the public commonly associates with that celebrity is a standard practice of satirists, parodists and other speakers," Hallmark's attorneys wrote. The 9th Circuit panel's "unprecedented finding that the publicity rights of an iconic celebrity may trump the First Amendment in the context of fully-protected speech that spoofs that celebrity...creates uncertain and unreliable legal standards that will drastically chill speech if allowed to stand."

Hilton sued Hallmark two years ago, alleging that one of its birthday cards constituted misappropriation of publicity under California law, as well as false designation and trademark infringement under federal law. The front of the birthday card bears an image of a cartoon waitress with Hilton's head superimposed on it, above which a caption says: "Paris's First Day as a Waitress." Hilton is saying to the customer: "Don't touch that, it's hot." The customer replies: "What's hot?" And Hilton responds: "That's hot." According to court documents, Hilton has registered the phrase "that's hot" as a trademark.

Hilton had argued that the card portrays a scene from an episode of television series "The Simple Life" in which she works as a waitress, according to court papers.

Hallmark filed a motion to dismiss and a federal judge in Los Angeles granted that motion as to the trademark infringement claim but denied the remaining claims. The judge also denied a separate motion that Hallmark filed to strike the publicity claim under California's anti-SLAPP statute, which allows defendants to throw out "strategic lawsuits against public participation" that are brought simply to quell freedom of speech. The SLAPP motions cannot be granted, however, if "there is a probability that the plaintiff will prevail on the claim."

The 9th Circuit found that Hallmark cannot claim a defense of "public interest" because its card does not "publish or report information," as do the news media. The court also relied on the "transformative" test outlined in two prior California Supreme Court cases to determine whether the image at issue was so transformed as to constitute a creation separate from the celebrity's likeness.

The image isn't exactly the same as what was presented during "The Simple Life" episode: The restaurant style is different, as is the food and Hilton's attire. "Despite these differences, however, the basic setting is the same: we see Paris Hilton, born to privilege, working as a waitress," the 9th Circuit ruled.

In its rehearing petition, Hallmark argues that the differences are distinctive enough to be protected by the First Amendment. The decision's "misinterpretation and misapplication of the transformative use standard has far-reaching, speech-prohibitive implications to speakers who look to the 'Court of Appeals for the Hollywood Circuit' for guidance on important First Amendment protections," the petition says.

The decision also conflicts with 9th Circuit precedent in *Hoffman v. Capital Cities/ABC Inc.*, 255 F.3d 1180 (9th Cir. 2001), which found that an image appearing to portray a celebrity's name and likeness was transformative and, therefore, protected by the First Amendment. That case involved claims by actor Dustin Hoffman involving an image with Hoffman's head superimposed onto a woman's body with the American flag background from the movie "Tootsie," in which he appeared in drag. The 9th Circuit rejected Hoffman's claims on First Amendment grounds, concluding that the image had been transformed enough to be separate from his character in the movie.

"In reality, the use in *Hoffman* was much closer to Hoffman's previous work than is the use in the card to Hilton's previous work," Hallmark's petition argues.

Lincoln Bandlow, a partner in the Los Angeles office of Lathrop & Gage, who represents Hallmark, said the Hoffman case is the 9th Circuit's only interpretation of the transformative test.

"The ball game comes down to determining what contributions are enough to make it transformative," he said. "In *Hoffman*, they held that minimal contributions were necessary, and certainly significantly less creative contributions than were made by the card."

Hilton's attorney, Brent Blakely, principal of the Blakely Law Group in Los Angeles, said that Hallmark's comparison to the Hoffman case fails.

"In *Hoffman* the thing being offered for sale was the magazine, not the clothing that was incidentally on Dustin Hoffman in those photographs," he said. "In our case, what is for sale, what is the product, are the greeting cards. That is a big difference."

He noted that the Hoffman decision was the result of a bench trial, not a ruling on an anti-SLAPP motion, as is the Hilton case.

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