

Copycat No More: A Legal Framework Extending Copyright Protection to Famous Movie Lines by Celebrities

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I. INTRODUCTION

The copyright law seeks to establish a delicate equilibrium. On the one hand, it affords protection to authors as an incentive to create, and, on the other, it must appropriately limit the extent of that protection so as to avoid the effects of monopolistic stagnation.

— Judge John M. Walker, Jr.¹

In the realm of the law, it is easy to imagine protecting one's right over a tangible property. However, when it comes to protecting intangible property, such as the fruits of one's intellectual prowess, it is much more grueling to grapple with rights and remedies.

A. Copycat of the "Copycat Line"

A theater production, entitled *Bituing Walang Ningning: The Musical* (Production),² was co-produced by Resorts World Manila with Viva Communications, Inc. (Viva) in various runs throughout 2015.³ At the height of promoting the Production, news reports surfaced about actress Cherie M. Gil's supposed claims over the line "*You're nothing but a second-rate, trying hard, copycat!*"⁴ This line was repeatedly aired over radio advertisements for the promotion of the Production.⁵

Ms. Gil maintains that she was vested with a copyright over this line at the time she uttered the same in the movie *Bituing Walang Ningning*.⁶ She alleges that this was not part of the original script and was improvised by her

1. CCC Information Services v. Maclean Hunter Market Reports, Inc., 44 F.3d 61 (2d Cir. 1994) (U.S.) (citing Computer Assoc. Int'l, Inc. v. Altai, Inc., 982 F.2d 693, 696 (2d Cir. 1992)).

2. Ticket Net Online, *Bituing Walang Ningning*, available at <http://ticketnet.com.ph/Bituing-Walang-Ningning-Resorts-World-Manila/EventDetails/290> (last accessed Apr. 29, 2016). The Production starred Mark Bautista, Cris Villonco, and introducing Monica Cuenco as Dorina Pineda. It was directed by Freddie R. Santos. *Id.*

3. Totel V. de Jesus, *'Bituing Walang Ningning: The Musical' returns bigger, brighter*, PHIL. DAILY INQ., Sep. 26, 2015, available at <http://entertainment.inquirer.net/178683/bituing-walang-ningning-the-musical-returns-bigger-brighter> (last accessed Apr. 29, 2016).

4. ABS-CBN News, *Copycat! Cherie Gil Doesn't Want Musical*, available at <http://news.abs-cbn.com/lifestyle/06/23/15/copycat-cherie-gil-doesnt-want-musical-use-her-famous-line> (last accessed Apr. 29, 2016).

5. *Id.*

6. *Id.*

on the set.⁷ Accordingly, she demanded that Viva desist from using the line in advertisements, communications, and in the Production itself.⁸

B. Viva Voices Out Defense

Viva's counterarguments to Ms. Gil's claims are as follows:⁹

- (1) The line is not protectable or copyrightable under the Intellectual Property Code of the Philippines,¹⁰ being an idiomatic expression and constituting a stock scene, or falling under the doctrine of *scène à faire*.¹¹
- (2) Viva owns the copyright over the film and the musical, after it was assigned by writer Nerissa Cabral with the right to make an adaptation of the comic book into a film and later on into musical.¹²
- (3) Assuming, without conceding, that the line is copyrightable, Ms. Gil cannot claim ownership over the line she uttered in the film *Bituing Walang Ningning* because she is neither the author nor co-author contemplated in the audio-visual work, as there was no contract or agreement to show such intent. Above all, the line was made in the performance of her duties and during her employment as an actress in the film.¹³
- (4) It was Director Emmanuel H. Borlaza, as scriptwriter and/or director, who wrote the line uttered by Ms. Gil in the film.¹⁴

7. Edwin P. Sallan, *Viva Refutes Cherie Gil's Claim Over Trying Hard Copycat Line*, InterAksyon.com, available at <http://www.interaksyon.com/entertainment/viva-refutes-cherie-gils-claim-over-second-rate-trying-hard-copycat-line> (last accessed Apr. 29, 2016) (citing Interview by InterAksyon.com with Heather Annang, Counsel for Viva Communications Inc., June 23, 2015).

8. *Id.*

9. *Id.*

10. An Act Prescribing for the Intellectual Property Code and Establishing the Intellectual Property Office, Providing for Its Powers and Functions, and for Other Purposes [INTELLECTUAL PROPERTY CODE], Republic Act No. 8293 (1997).

11. Sallan, *supra* note 7 (stating that the "line was, at most[,] an ad-lib").

12. *Id.*

13. *Id.*

14. *Id.*

II. LEGAL LANDSCAPE OF COPYRIGHT

A. Scope

Under the Civil Code of the Philippines, one of the modes of acquiring ownership is by intellectual creation.¹⁵ Under the Intellectual Property Code, literary and artistic works are original intellectual creations in the literary and artistic domain, protected from the moment of their creation.¹⁶ Specifically, an author acquires ownership with regard to his literary, dramatic, historical, legal, philosophical, scientific, or other work even before the publication of the same.¹⁷

Originality is a condition *sine qua non* of copyright.¹⁸ For there to be infringement, the plaintiff has to own a valid copyright and the defendant must have copied the constituent elements of the works original to the owner.¹⁹ Furthermore, under jurisprudential doctrines, for the work to be original, it must be independently created and must exhibit a modicum of creativity.²⁰ The work does not even have to be novel or unique.²¹ Originality, as used in this context, means independent creation by the author, and pertains to the original or unique way that an author expresses ideas, concepts, principles, or processes.²²

B. Limitations

Ideas, concepts, and the like found in the common domain are considered as the inheritance of everyone and are outside the ambit of copyright protection.²³ Moreover, protection of copyright is limited by the following

15. An Act to Ordain and Institute the Civil Code of the Philippines [CIVIL CODE], Republic Act No. 386, art. 712 (1950).

16. INTELLECTUAL PROPERTY CODE, § 172.

17. *Id.*

18. *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 345 (1991).

19. *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1262 (10th Cir. 2008) (U.S.) (citing *Autoskill Inc. v. National Educational Support Systems, Inc.*, 994 F.2d 1476, 1487 (10th Cir. 1993) (U.S.)).

20. *Feist Publications, Inc.*, 499 U.S. at 345.

21. *Baker v. Selden*, 101 U.S. 99, 102-03 (1879).

22. *See Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) & *Feist Publications, Inc.*, 499 U.S. at 345-46. *See also CCC Information Services*, 44 F.3d 61.

23. *See Agreement on Trade-Related Aspects of Intellectual Property*, art. 9 (2), *entered into force* Jan. 1, 1995, 1869 U.N.T.S. 299; *Berne Convention for the Protection of Literary and Artistic Works*, *entered into force* Dec. 5, 1887, 1161 U.N.T.S. 30, art. 2 (8); & INTELLECTUAL PROPERTY CODE, § 175.

— first, under the merger doctrine, i.e., a work is not protected if the idea and the expression “merge,” or if the idea underlying the work can be expressed only in one way, lest there be a monopoly on the underlying idea; and second, under the related doctrine of *scène à faire*, i.e., if the expression embodied in the work necessarily flows from a commonplace idea.²⁴ When these limiting doctrines are applied, subtracting the unoriginal elements, only a “thin” copyright is left, which virtually only protects against identical copying.²⁵ In one case, Judge Learned Hand reiterated that this principle has long been part of copyright law — “the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.”²⁶

C. Infringement

In the absence of direct evidence or admission of copying, copying may be proven by circumstantial evidence of access to the copyrighted work and substantial similarity between the copyrighted work and the infringing work.²⁷

Access may be proven if the infringed work has been widely disseminated or a particular chain of events exists by which the alleged infringer might have gained access to the copyrighted work.²⁸ Proof of substantial similarity requires resort to yet another two-part analysis: first — *extrinsic similarity* (whether the two works contain substantially similar ideas that are subject to copyright protection); and second, *intrinsic similarity* (whether the works express those ideas in a substantially similar manner from the perspective of the intended audience of the work).²⁹ In other words, courts are obliged to inquire into “the ‘total concept and feel’ of the works,” seen through the eyes of the ordinary observer, unless it is clear that the work is intended for a more particular audience.³⁰

24. *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 765 (9th Cir. 2003) (U.S.) (citing *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000) (U.S.)).

25. *Id.* at 766. As stated in the *Ets-Hokin* case, “[w]hen the range of protectable expression is narrow, the appropriate standard for illicit copying is virtual identity.” *Id.* (citing *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1439 (9th Cir. 1994) (U.S.)).

26. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (U.S.).

27. *Repp v. Webber*, 132 F.3d 882, 889 (2d Cir. 1997) (U.S.) (citing *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 140 (2d Cir. 1992) (U.S.)).

28. *Id.*

29. *Lyons Partnership v. Morris Costumes*, 243 F.3d 789, 801 (4th Cir. 2001) (U.S.) (citing *Towler v. Sayles*, 76 F.3d 579, 583–84 (4th Cir. 1996) (U.S.)).

30. *Lyons Partnership*, 243 F.3d at 801 (citing *Dawson v. Hinshaw Music, Inc.*, 905 F.2d 731, 733 (4th Cir.1990) (U.S.)).

If such similarity is striking, then the test for proof of access is less rigorous.³¹

This inference of copying may be rebutted by evidence of independent creation,³² even if a work is completely identical with a prior work, provided it was the product of an independent effort of its author.³³

III. COPYRIGHT OVER THE COPYCAT LINE

The Intellectual Property Code recognizes the right of Ms. Gil over her audiovisual performance under Section 203 of the Intellectual Property Code,³⁴ as a performer in the movie (a right “related” or “neighboring” on copyright).³⁵ Specifically, if the film *Bituing Walang Ningning* is re-

31. *Repp*, 132 F.3d at 889 (citing *Lipton v. Nature Co.*, 71 F.3d 464, 471 (2d Cir. 1995) (U.S.)).

32. *Id.*

33. *Selle v. Gibb*, 567 F. Supp. 1173, 1182 (N.D. Ill., E. Div. 1983) (U.S.) (citing *Novelty Textile Mills v. Joan Fabrics Corp.*, 558 F.2d 1090, 1096 (2d Cir. 1983) (U.S.)).

34. INTELLECTUAL PROPERTY CODE, § 203. Section 203 of the Intellectual Property Code provides —

Section 203. Scope of Performers’ Rights. — Subject to the provisions of Section 212, performers shall enjoy the following exclusive rights:

203.1. As regards their performances, the right of authorizing:

- (1) The broadcasting and other communication to the public of their performance; and
- (2) The fixation of their unfixed performance.

203.2. The right of authorizing the direct or indirect reproduction of their performances fixed in sound recordings, in any manner or form;

203.3. Subject to the provisions of Section 206, the right of authorizing the first public distribution of the original and copies of their performance fixed in the sound recording through sale or rental or other forms of transfer of ownership;

203.4. The right of authorizing the commercial rental to the public of the original and copies of their performances fixed in sound recordings, even after distribution of them by, or pursuant to the authorization by the performer; and

203.5. The right of authorizing the making available to the public of their performances fixed in sound recordings, by wire or wireless means, in such a way that members of the public may access them from a place and time individually chosen by them.

Id.

35. Interview *with* Atty. Louie Andrew C. Calvario, Representative, Intellectual Property Office of the Philippines, *in* Taguig City (July 6, 2015).

broadcasted, then under Section 206, she is entitled to an additional remuneration equivalent to at least five percent of the original remuneration she received when the film was originally shown.³⁶

However, the performers' rights contemplated under the said provisions refer to her very performance in the film, not in an adaptation in a play or musical such as the Production.

With regard to the copycat line in question that Ms. Gil delivered, Section 178 of the Intellectual Property Code is instructive —

Section 178. Rules on Copyright Ownership. [—] Copyright ownership shall be governed by the following rules:

178.1 Subject to the provisions of this section, in the case of original literary and artistic works, *copyright shall belong to the author of the work*;

178.2. *In the case of works of joint authorship, the co-authors shall be the original owners of the copyright and in the absence of agreement, their rights shall be governed by the rules on co-ownership. If, however, a work of joint authorship consists of parts that can be used separately and the author of each part can be identified, the author of each part shall be the original owner of the copyright in the part that he has created*;

178.3. *In the case of work created by an author during and in the course of his [or her] employment, the copyright shall belong to:*

The *employee*, if the creation of the object of copyright is not a part of his regular duties even if the employee uses the time, facilities[,] and materials of the employer.

The *employer*, if the work is the result of the performance of his regularly-assigned duties, unless there is an agreement, express or implied, to the contrary.

178.4. *In the case of a work commissioned by a person other than an employer of the author and who pays for it and the work is made in pursuance of the commission, the person who so commissioned the work shall have ownership of the work, but the copyright thereto shall remain with the creator, unless there is a written stipulation to the contrary; [and]*

178.5. *In the case of audiovisual work, the copyright shall belong to the producer, the author of the scenario, the composer of the music, the film director, and the*

36. Section 206 of the Intellectual Property Code provides —

Section 206. Additional Remuneration for Subsequent Communications or Broadcasts. [—] Unless otherwise provided in the contract, in every communication to the public or broadcast of a performance subsequent to the first communication or broadcast thereof by the broadcasting organization, the performer shall be entitled to an additional remuneration equivalent to at least five percent [] of the original compensation he or she received for the first communication or broadcast.

author of the work so adapted. However, subject to contrary or other stipulations among the creators, the producer shall exercise the copyright to an extent required for the exhibition of the work in any manner, except for the right to collect performing license fees for the performance of musical compositions, with or without words, which are incorporated into the work[.]³⁷

Under Sections 178.1 and 178.5, copyright belongs to the author of the novel or underlying work, Ms. Nerissa G. Cabral, or the director and scriptwriter, Mr. Emmanuel H. Borlaza. Noteworthy is that the copyright extends over the entire work, not just over specific lines.³⁸

Therefore, even assuming that it was Ms. Gil who spontaneously thought of and expressed the copycat line (if the said line was never part of the script), she still could not claim copyright over or prevent another performer from delivering the same line. One-liners and tag lines are not among, or analogous to, the works enumerated in the Intellectual Property Code.³⁹

Neither can Ms. Gil seek refuge under Sections 178.2, 178.3, nor 178.4, under work done in the course of employment, commissioned work, or joint authorship, respectively.

A. Joint Authorship: The Case of Aalmuhammed v. Lee

This scenario is a *déjà vu* of the case of *Aalmuhammed v. Lee*.⁴⁰ In that case, Jefri Aalmuhammed — a devout Muslim, who knew a great deal about Malcolm X and Islam — was asked by Denzel H. Washington to assist in his preparation for the starring role of Malcolm X, for the 1992 film of the same name.⁴¹ Aalmuhammed directed Washington and other actors while on the set; created at least two entire scenes with new characters; translated Arabic into English for subtitles; supplied his own voice for voice-overs; selected the proper prayers and religious practices for the characters; edited parts of the movie during post production; joined Washington on the movie set in the New York metropolitan area and Egypt; reviewed the shooting script; and suggested extensive script revisions, some of which were included in the released version of the film, with others filmed but not included in the released version.⁴² Most of the revisions Aalmuhammed made were to

37. INTELLECTUAL PROPERTY CODE, §§ 178-178.5 (emphasis supplied).

38. Interview *with* Atty. Louie Andrew C. Calvario, *supra* note 35.

39. *Id.*

40. *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000) (U.S.).

41. *Id.* at 1229.

42. *Id.* at 1229-30.

ensure the religious and historical accuracy and authenticity of scenes depicting Malcolm X's religious conversion and pilgrimage to Mecca.⁴³

Here, the U.S. Court of Appeals dispelled Aalmuhammed's claim using the criteria for joint authorship, in the absence of a contract⁴⁴ — first, an author “superintends” the work by exercising control or is “the inventive or master mind” who “creates[] or gives effect to the idea.”⁴⁵ Second, putative co-authors make objective manifestations of a shared intent to be co-authors, not subjective intent, as, for example, by denoting the authorship of *The Pirates of Penzance* as “Gilbert and Sullivan.”⁴⁶ Third, the audience appeal of the work turns on both contributions, and “the share of each in its success cannot be appraised.”⁴⁷ Control, in many cases, will be the most important factor.

B. Related Jurisprudence on Joint Authorship

In the *Aalmuhammed* case, the U.S. Court of Appeals took pains in making cross-references to other related jurisprudence in elaborating the definition of copyrightable work and author in relation to joint authorship.

After outlining the jurisprudential definition of “copyrightable work” in *Feist Publications, Inc. v. Rural Telephone Service Co.*⁴⁸ and “author” in *Burrow-Giles v. Saroni*,⁴⁹ the U.S. Supreme Court explained that in the context of a movie, in the absence of a contract to the contrary, such would “generally limit authorship to someone at the top of the screen credits, sometimes the producer, sometimes the director, possibly the star, or the screenwriter [—] someone who has artistic control.”⁵⁰

43. *Id.* at 1230.

44. *Id.* at 1234 (citing *Thomson v. Larson*, 147 F.3d 195, 202–05 (2d Cir. 1998) (U.S.)).

45. *Aalmuhammed*, 202 F.3d at 1234 (citing *Burrow-Giles*, 111 U.S. at 61).

46. *Aalmuhammed*, 202 F.3d at 1234.

47. *Id.* (citing *Edward B. Marks Music Corp. v. Jerry Vogel Music Co., Inc.*, 140 F.2d 266, 267 (2d Cir. 1944) (U.S.)).

48. *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 345 (1991). Answering a different question, what is a copyrightable “work,” as opposed to who is the “author,” the U.S. Supreme Court held that “some minimal level of creativity” or “originality” suffices. See *Feist Publications, Inc.*, 499 U.S. at 345.

49. *Burrow-Giles Lithographic Co. v. Saroni*, 111 U.S. 53 (1884). *Burrow-Giles* defines “author” as the person to whom the work owes its origin and who superintended the whole work, the “mastermind.” *Id.* at 61.

50. *Aalmuhammed*, 202 F.3d at 1233 (citing *Burrow-Giles*, 111 U.S. at 61).

The U.S. Court of Appeals also highlighted *Thomson v. Larson*,⁵¹ on the importance of decision-making authority, billing as a co-author, and intent to be joint authors by the putative parties.⁵²

C. Social Policy on “Authorship”

The social policy behind the statutory term “author” was explained by the U.S. Court of Appeals in *Aalmuhammed* in this wise —

The [U.S.] Constitution establishes the social policy that our construction of the statutory term ‘authors’ carries out. The Founding Fathers gave Congress the power to give authors copyrights in order ‘to promote the progress of [s]cience and useful arts.’ Progress would be retarded[,] rather than promoted, if an author could not consult with others and adopt their useful suggestions without sacrificing sole ownership of the work. Too open a definition of author would compel authors to insulate themselves and maintain ignorance of the contributions others might make. Spike Lee could not consult a scholarly Muslim to make a movie about a religious conversion to Islam, and the arts would be the poorer for that.⁵³

Nevertheless, the U.S. Court of Appeals frowned upon the attempt at a broader construction of the term, thus —

The broader construction *Aalmuhammed* proposes would extend joint authorship to many ‘overreaching contributors,’ ... and deny sole authors ‘exclusive authorship status simply because another person rendered some form of assistance.’ Claim jumping by research assistants, editors, and former spouses, lovers[,] and friends would endanger authors who talked with people about what they were doing, if creative copyrightable contribution were all that authorship required.⁵⁴

The U.S. Court of Appeals carefully dissected the statutory language establishing joint work, saying that for a work to be a “joint work,” there must be (1) a copyrightable work, (2) two or more “authors,” and (3) the authors must intend their contributions be merged into inseparable or interdependent parts of a unitary whole.⁵⁵

Another element to joint work is the existence of two or more authors. In this regard, substantial contribution is not tantamount to co-authorship, to wit —

51. *Thomson v. Larson*, 147 F.3d 195, 202-05 (2nd Cir. 1998) (U.S.).

52. *Aalmuhammed*, 202 F.3d at 1233 (citing *Thomson*, 147 F.3d at 202-05).

53. *Aalmuhammed*, 202 F.3d at 1235 (citing U.S. CONST. art. I, § 8, cl. 8).

54. *Aalmuhammed*, 202 F.3d at 1235 (citing *Thomson*, 147 F.3d at 200).

55. *Aalmuhammed*, 202 F.3d at 1231 (citing *Ashton-Tate Corp. v. Ross*, 916 F.2d 516, 521 (9th Cir. 1990) (U.S.)).

We hold that authorship is required under the statutory definition of a joint work, and that authorship is not the same thing as making a valuable and copyrightable contribution. We recognize that a contributor of an expression may be deemed to be the ‘author’ of that expression for purposes of determining whether it is independently copyrightable.⁵⁶

IV. PROPOSING A LEGAL FRAMEWORK FOR THE COPYRIGHT BARGAIN: A BALANCE BETWEEN PROTECTION FOR THE ARTIST AND RIGHTS FOR THE CONSUMER⁵⁷

The lack of basis in Ms. Gil’s claims is easily discernible against the foregoing legal backdrop.

The legal framework explored in this Article is intended to create a layer of protection within copyright laws, borrowing jurisprudential principles from trademark to copyright and from copyright over characters to copyright over lines or scripts, with the application of certain common law doctrines, on a celebrity’s right over personas and publicity. The proposal will be synchronized with doctrines subscribed by and consistent with the framework of Philippine intellectual property rights.

In this Article, copyright protection, albeit thin, is proposed to extend to famous lines or scripts delivered in a very personal manner by celebrities, in a role they portrayed in a film, where the line or script was made popular, and who have since been strongly associated and whose identities have been inextricably intertwined with, the famous lines or script.

A. Allowing copyright protection over lines or script based on the celebrity’s personal “expression” of ideas in a role portrayed in the film where the line or script was popularized

As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity.⁵⁸

Accordingly, there is a narrow class of cases where even admittedly independent efforts may be deemed too trivial or insignificant to support copyright protection.⁵⁹ Materials that do not exhibit the minimal level of

56. *Id.* at 1232.

57. Derrick Story, Sound Bites on Fair Use and Copyright Law, *available at* http://archive.oreilly.com/pub/post/sound_bites_on_fair_use_and_co.html (last accessed Apr. 29, 2016) (citing Robin D. Gross, Intellectual Property Lawyer, Panel Session: The Anti-Piracy Wars at the Seybold Conference in San Francisco, California (Sep. 10, 2002)).

58. *Feist Publications, Inc.*, 499 U.S. at 345.

59. *Magic Marketing, Inc. v. Mailing Services of Pittsburgh, Inc.*, 634 F. Supp. 769, 771 (W.D. Pa. 1986) (U.S.).

creativity necessary to warrant copyright protection include — “fragmentary words and phrases;”⁶⁰ “forms of expression dictated solely by functional considerations;”⁶¹ “words and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering[,] or coloring; mere listing of ingredients or contents;”⁶² and clichéd language and expressions communicating an idea which may only be conveyed in a more or less stereotyped manner.⁶³

However, a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.⁶⁴

Such derivative works are protected by copyright under the Intellectual Property Code —

173.1. The following derivative works shall also be protected by copyright:

- (a) Dramatizations, translations, adaptations, abridgments, arrangements, and other alterations of literary or artistic works; and
- (b) Collections of literary, scholarly[,] or artistic works, and compilations of data and other materials which are original by reason of the selection or coordination or arrangement of their contents.⁶⁵

In the history of Philippine cinema, it is inevitable to come across famous lines delivered by veteran actors or performers from highly-acclaimed movies,⁶⁶ just like the subject copycat line “*You’re nothing but a second-rate, trying hard copycat!*” by Ms. Gil.⁶⁷

60. *Id.* (citing MELVILLE B. NIMMER, NIMMER ON COPYRIGHT: A TREATISE ON THE LAW OF LITERARY, MUSICAL AND ARTISTIC PROPERTY, AND THE PROTECTION OF IDEAS 36-37 (1967 ed.)).

61. *Magic Marketing, Inc.*, 634 F. Supp. at 769.

62. *Id.* at 772 (citing 37 C.F.R. § 202.1 (a) (1985) (U.S.)).

63. *Magic Marketing, Inc.*, 634 F. Supp. at 772. (citing Merritt Forbes & Co. v. Newman Investment Securities, Inc., 604 F. Supp. 943, 951 (S.D.N.Y. 1985) (U.S.) & Perma Greetings, Inc. v. Russ Berrie & Co., 598 F. Supp. 445, 448 (E.D. Mo. 1984) (U.S.)).

64. *See Apple Computer, Inc.*, 35 F.3d at 1446.

65. INTELLECTUAL PROPERTY CODE, § 173.1.

66. Spot.ph, 50 Famous Lines from Pinoy Movies, available at <http://www.spot.ph/gallery/1675/50-famous-lines-from-pinoy-movies-2/article/49581#photo-1675-1> (last accessed Apr. 29, 2016).

67. Other lines that may come to mind include: “*Isang bala ka lang.*” Fernando Poe Jr, ISANG BALA KA LANG (FPJ Productions, 1983); “Once, twice, thrice, *gaano*

The first criterion explored in this Article appears consistent with the bedrock principle in copyright — the “expression-idea” dichotomy⁶⁸ — since what is sought to be protected is the celebrity’s distinct portrayal and delivery, or the “expression” of the lines or script that was the very reason for its fame.

This is subject to the limitation that there was no remake, spoof, or even parody of the film or movie wherein said lines or script was delivered. While such line or script may arguably be considered to fall under the public domain, the expression or manner by which said line was delivered or uttered by the celebrity will be protected.

In *Bleistein v. Donaldson Lithographing Co.*,⁶⁹ the U.S. Supreme Court was keen to explain that even if the expression was drawn from an idea belonging to the public domain, such may still be protected by copyright —

But even if they had been drawn from the life, that fact would not deprive them of protection. The opposite proposition would mean that a portrait by [Diego Velasquez] or [James Whistler] was common property because others might try their hand on the same face. Others are free to copy the original. They are not free to copy the copy. The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a

ba kadalas ang minsan?” Hilda Koronel, GAANO KADALAS ANG MINSAN (Viva Films, 1982); “My brother is not a pig! *Ang kapatid ko ay tao, hindi baboy damo!*” Nora Aunor, MINSAY ISANG GAMUGAMO (Premiere Productions, 1976); “*Walang himala! Ang himala ay nasa puso ng tao!*” Nora Aunor, HIMALA (Experimental Cinema of the Philippines, 1982); “*Ang mga tala ... mataas, mahirap maabot. Pero ipinangako ko, Inay ... bukas, luluhod ang mga tala!*” Sharon Cuneta, BUKAS LULUHOD ANG MGA TALA (Viva Films, 1984); “Get out of my house. I don’t need a parasite!” Maricel Soriano, SEPARADA (Star Cinema Productions, 1994); “I was never your partner. I’m just your wife ... *kaya di mo ako nirirespeto.*” Sharon Cuneta, MADRASTA (Star Cinema Productions, 1996); “*Gutay-gutay na ang katawan n’yo ... pati na ang kaluluwa n’yo, gutay-gutay na rin!*” Sharon Cuneta, PASAN KO ANG DAIGDIG (Viva Films, 1987); “*Ayoko ng tinatapakan ako, ayoko ng masikip, ayoko ng mabaho, ayoko ng walang tubig, ayoko ng walang pagkain, ayoko ng putik!*” Maricel Soriano, KAYA KONG ABUTIN ANG LANGIT (V.H. Films, 1984); “*Trabaho lang ito, walang personalan.*” Rudy Fernandez, MARKANG BUNGO (Bonanza Films, 1991); “*Ang hirap sa’yo, sala ka sa init, sala ka sa lamig. Isinusuka ka ng Diyos, iniluluwa ka ng langit.*” Vilma Santos, T-BIRD AT AKO (Film Ventures, Inc., 1982); & “*Nakakainis man tanggapin ha ... Nakakainis tanggapin eh. Champion ka talaga. Taas ang kamay ko sayo. Nagkakagusto na nga ako sayo eh. Mahal na nga yata kita palagay ko eh. Maging sino ka man.*” Robin Padilla, MAGING SINO KA MAN (Viva Films, 1991).

68. *Feist Publications, Inc.*, 499 U.S. at 349–50.

69. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.

If there is a restriction it is not to be found in the limited pretensions of these particular works. The least pretentious picture has more originality in it than directories and the like, which may be copyrighted. The amount of training required for humbler efforts than those before us is indicated by [John Ruskin]. 'If any young person, after being taught what is, in polite circles, called 'drawing,' will try to copy the commonest piece of realwork, — suppose a lithograph on the title page of a new opera air, or a woodcut in the cheapest illustrated newspaper of the day — they will find themselves entirely beaten.' There is no reason to doubt that these prints in their ensemble and in all their details, in their design and particular combinations of figures, lines[,] and colors, are the original work of the plaintiffs' designer.⁷⁰

While the celebrity is not the "author" of the famous line or script as contemplated under copyright laws and jurisprudence, he or she will be afforded a thin copyright protection under this proposal, subject to the compliance with the criteria proposed in this Article.⁷¹ Consistent with *Feist Publications, Inc.*, the copyright is limited to those aspects of the work termed "expression" that display the stamp of the celebrity's originality.⁷² Here, it is proposed that the unique and personal delivery by the celebrity of the lines or script becomes his original expression protected by copyright.

The case of *Tin Pan Apple v. Miller Brewing*⁷³ considered the nettlesome but ineluctable issue in many music infringement cases — at what point do non-protectible compositional elements like rhythmic motives, instrumental sounds, or performance techniques, through their particular combination, become original expression?⁷⁴ In this case, plaintiffs sought to prevent others from using their combination of sounds in their work — which made use of a combination of both a tongue trill and a "Hugga-Hugga" call — in another work —

These principles are pertinent to the case at bar because defendants contend, at least with respect to plaintiffs' composition copyright for 'Stick 'Em,' that the sounds 'Brrr' and 'Hugga-Hugga,' standing alone, are not protectible. Defendants analogize 'Brrr' and 'Hugga-Hugga' sounds 'to a drumbeat, or to any other percussion effect.' 'As such,' the argument continues, 'while a particular pattern or sequence of these sounds may

70. *Id.* at 249 (citing JOHN RUSKIN, THE ELEMENTS OF DRAWING 3 (1857 ed.)).

71. *See Burrow-Giles Lithographic Co.*, 111 U.S. at 60-61 (1884).

72. *Feist Publications, Inc.*, 499 U.S. at 345.

73. *Tin Pan Apple v. Miller Brewing*, No. 88 Civ. 4085 (CSH), 1994 U.S. Dist. LEXIS 2178 (S.D.N.Y. Feb. 23, 1994).

74. *Id.*

constitute original musical expression, a single Brrr or Hugga-Hugga sound, like a single drumbeat, does not.’ Defendants submit an affidavit of Earl V. Spielman, a musicologist, who expresses the opinions that the only ‘significant similarities’ between the copyrighted work and the commercial are these two vocal percussion effects, and that only ‘a particular pattern or sequence of percussion sounds [...] can constitute original musical expression.’ Spielman’s analysis of the two works causes him to conclude that ‘the rhythmic patterns created by the respective vocal effects are not similar[;]’ and ‘because their rhythmic durations are distinctly different from one another there is no indication of copying.’

The threshold issue in copyright infringement cases is originality, not copying. Within the context of the composition copyright, plaintiffs stress that the Copyright Office issued Registration Number PA 229-080 for the ‘words & music’ of ‘Stick ‘Em[.]’ They criticize Spielman’s analysis as focusing too narrowly on the Brrr and Hugga-Hugga *sounds*, while disregarding their copyrighted function as lyrics. Plaintiffs offer the declaration of John Leland, a writer and critic specializing in popular music, who states that plaintiff Robinson, who generates the Hugga-Hugga sound, ‘was one of the first rap artists to be known nationally for creating human beat box sounds,’ thereby earning the industry nickname ‘the Human Beat Box[.]’ Leland also says Brrr and Hugga-Hugga, sounds ‘were uniquely associated with the Fat Boys[;]’ he adds that ‘I am unaware of any other rap act that used the lyric [or] sound ‘Hugga-Hugga’ or the trilling ‘Brrr’ lyric sound created by the Fat Boys.’

When the originality of a copyrighted work is at issue, it becomes a question of fact for the jury to resolve. This fact question is withheld from the jury only if the accused infringer persuades the trial court that, as a matter of law, plaintiffs’ work which defendant allegedly copied was not original and hence not protectible. The defendant bears the burden of that persuasion in order to overcome the presumption of validity accorded the copyright registration: in this case, registration of the words and music of plaintiff’s work ‘Stick ‘Em.’ In *Gaste*[,] Judge [William C.] Conner submitted to the jury all disputed issues, including that of the validity of the copyright. Affirming a judgment in plaintiff’s favor, the Second Circuit held that the trial judge was right to do so, saying of the song at issue: ‘On the evidence presented by both sides, we cannot say as a matter of law that *Gaste*’s [*Pour Toi*] was not original enough to be accorded copyright protection.’ In *Levine v. McDonald’s Corp.*, ... Judge [Robert P.] Patterson followed *Gaste* in denying the accused infringer’s motion for summary judgment, holding that the jury could find *plaintiff’s composition* ‘sufficiently creative to warrant copyright protection.’⁷⁵

The U.S. District Court in *Tin Pan Apple* did not decide this ultimate question, but did find that given that merely a “dash” of creativity will satisfy

75. *Id.* at **7–10. (citing *Gaste v. Kaiserman*, 863 F.2d 1061, 1064–66 (2d Cir. 1988) (U.S.) & *Levine v. McDonald’s Corp.*, 735 F. Supp. 92, 99 (S.D.N.Y. 1990) (U.S.)) (emphasis supplied).

the originality requirement needed for copyright protection,⁷⁶ a jury might find that the Fat Boys' use of these sounds in "Stick 'Em" constitutes protectible expression. Given the possibility of a jury determining this, the U.S. District Court denied the defendants' request for summary judgment,⁷⁷ to wit —

In the case at bar, I conclude that defendants are not entitled to summary judgment dismissing plaintiffs' composition copyright claim on the ground of copyright invalidity. *I hold that a jury could find that the Hugga-Hugga and Brrr sounds, used as lyrics in the copyrighted work, are sufficiently creative to warrant copyright protection, quite apart from the rhythmic patterns or durations demonstrated by that work and the commercial. These sounds are more complex than the single drum beat hypothesized in Spielman's affidavit, and in that complexity lies, arguably at least, the fruit of creativity.* The relatively few cases considering originality in musical compositions do not point clearly in either direction; they are too fact-specific to do so. While they may not prevail, plaintiffs are entitled to test their claim of originality at trial, where they will have the assistance of a jury instruction concerning the registration's presumption of validity. On this motion for summary judgment, having that presumption in mind and, as I must, resolving ambiguities and drawing reasonable inferences against the moving party, I hold that summary judgment on this issue is not appropriate.⁷⁸

Thus, a dash of creativity in the celebrity's portrayal of the role and in his utterance or delivery of the lines or script should warrant copyright protection under the other criteria set forth in this Article.

B. The celebrity has been strongly associated, and his or her identity inextricably intertwined, with the famous lines or script

1. The Right of Celebrity's Persona: The Fame and Fortune Case of *Vanna White v. Samsung Electronics America, Inc.*

In the case of *Vanna White v. Samsung Electronics America, Inc.*,⁷⁹ Vanna White (White) sued Samsung Electronics America, Inc. (Samsung) and David Deutsch Associates, Inc. (Deutsch), alleging infringement of various intellectual property rights "in running a particular advertisement without White's permission."⁸⁰ The advertisement, involving Samsung video-cassette recorders (VCRs), "depicted a robot, dressed in a wig, gown, and jewelry which Deutsch consciously selected to resemble White's hair and dress. The

76. *Id.* at *7. (citing *Gaste*, 863 F.2d at 1066) (emphasis supplied).

77. *Id.* at *10.

78. *Id.* at *10-11 (emphasis supplied).

79. *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992) (U.S.).

80. *Id.* at 1396.

robot was posed next to a game board which obviously purported to be the Wheel of Fortune game show set, ... for which White was popularly known.”⁸¹ The caption of the advertisement read, “Longest-running game show. 2012 A.D.”⁸² Defendants referred to this as the “Vanna White” advertisement.⁸³ White neither consented to its use nor was she paid.⁸⁴

On the issue of celebrity’s persona, the U.S. Court of Appeals ruled in this wise —

To prevail on her Lanham Act claim, White is required to show that in running the robot ad, Samsung and Deutsch created a likelihood of confusion.

This circuit recognizes several different multi-factor tests for determining whether a likelihood of confusion exists. ... Normally, in reviewing the district court’s decision, this court will look to the particular test that the district court used. However, because the district court in this case apparently did not use any of the multi-factor tests in making its likelihood of confusion determination, and because this case involves an appeal from summary judgment and we review [*de novo*] the district court[’]s determination, we will look for guidance to the [*eight*]-factor test enunciated in *AMF, Inc. v. Sleekcraft Boats*[.]

According to [*AMF, Inc.*], factors relevant to a likelihood of confusion include:

(1) *strength of the plaintiff’s mark*;

...

In cases involving confusion over endorsement by a celebrity plaintiff, ‘mark’ means the celebrity’s persona. The ‘strength’ of the mark refers to the level of recognition the celebrity enjoys among members of society. If Vanna White is unknown to the segment of the public at whom Samsung’s robot ad was directed, then that segment could not be confused as to whether she was endorsing Samsung VCRs. Conversely, if White is well-known, this would allow the possibility of a likelihood of confusion. For the purposes of the *Sleekcraft* test, White’s ‘mark,’ or celebrity identity, is strong.⁸⁵

81. *Id.*

82. *Id.*

83. *Id.*

84. *Id.*

85. *White*, 971 F.2d at 1399–1400 (citing *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979) (U.S.)) (emphasis supplied). Under Section 43 (a) of the Lanham Act, applicable in this case, it is provided in pertinent part that

[a]ny person who shall ... use, in connection with any goods or services ... any false description or representation ... shall be liable to a civil action ... by any person who believes that he [or she] is or is likely to be damaged by the use of any such false description or designation.

In applying the “*Sleekcraft* factors” to this case,⁸⁶ the U.S. Court of Appeals held only that “White has raised a genuine issue of material fact concerning a likelihood of confusion as to her endorsement.”⁸⁷

In the opinion of Circuit Judge Arthur L. Alarcon, concurring in part, dissenting in part —

The majority assumes the conclusion that the *AMF* test is designed to disclose. In repeatedly stating that the robot ‘identifies’ Vanna White, the majority has usurped the fact finding function of the district court.

The majority holds that the first factor of the AMF test, strength of the mark, weighs in Vanna White’s favor. It equates this factor with the strength of Vanna White’s fame, citing [Woody Allen v. National Video, Inc.]. Allen involved a celebrity look-alike who bore a remarkable resemblance to Woody Allen. The instant matter involves a robot that bears no resemblance to Vanna White.

It is unclear whether the ‘mark’ for which Vanna White seeks protection is her screen image or the imitation Wheel of Fortune. *Although Vanna White is certainly famous for being famous, there is no evidence in the record that consumers identify the specific characteristics at issue, i.e., blond hair and fancy dress, solely with Vanna White.* The majority ignores this important distinction.⁸⁸

Under this proposal, there should be substantial evidence that the general public identifies the lines or script solely with the celebrity concerned and no one else. While the line may have been popularized by public utterances or adaptations in subsequent audiovisual works, proof should point to the celebrity as the originator character to whom the line can be inextricably linked or indistinguishably related.

Id. at 1399 (citing 15 U.S.C. § 1125 (a)).

86. *Id.* at 1400. According to *AMF, Inc.*, factors relevant to a likelihood of confusion include:

- (1) strength of the plaintiff’s mark;
- (2) relatedness of the goods;
- (3) similarity of the marks;
- (4) evidence of actual confusion;
- (5) marketing channels used;
- (6) likely degree of purchaser care;
- (7) defendant’s intent in selecting the mark; [and]
- (8) likelihood of expansion of the product lines.

AMF Inc., 599 F.2d at 348-49.

87. *White*, 971 F.2d at 1401.

88. *Id.* at 1406 (emphases supplied).

2. Marketable Celebrity Identity Value: *Woody Allen v. National Video, Inc.*

There should be proof that the celebrity has created a marketable celebrity identity value. In *Vanna White*, the U.S. Court of Appeals explained that

Television and other media create marketable celebrity identity value. Considerable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity's sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof.⁸⁹

In *Woody Allen v. National Video, Inc.*,⁹⁰ plaintiff alleged that National Video used his picture or portrait for commercial purposes without his permission.⁹¹ The advertisements were materially misleading and likely to result in consumer confusion as to his endorsement of National's services; plaintiff thus based his claims on his right to privacy, right of publicity, and the Lanham Act.⁹² The U.S. District Court elaborated, to wit —

It is not disputed here that in this photograph defendant [Phil] Boroff is meant to look like Woody Allen. The pose, expression, and props all support the suggestion. However, the question before the court is not whether some, or even most, people will be *reminded* of plaintiff when they see this advertisement. In order to find that the photograph contains plaintiff's 'portrait or picture,' *the court would have to conclude that most persons who could identify an actual photograph of plaintiff would be likely to think that this was actually his picture.* This standard is necessary since we deal not with the question of whether an undisputed picture of plaintiff is recognizable to some, but whether an undisputed picture of defendant Boroff should be regarded, as a matter of law, to *be* a portrait or picture of plaintiff.⁹³

The underlying principle of this criterion finds support in a common law doctrine —

[T]he *right of publicity* has developed to protect the commercial interest of celebrities in their identities. The theory of the right is that a celebrity's identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity [...] If the celebrity's identity is commercially

89. *Id.* at 1399. As to *White's* right of publicity, the Court reversed the district court's summary judgment. *See White*, 971 F.2d at 1394-1408.

90. *Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985) (U.S.).

91. *Id.* at 617-18.

92. *Id.* at 618.

93. *Id.* at 624 (emphasis supplied).

exploited, there has been an invasion of his right whether or not his ‘name or likeness’ is used.⁹⁴

3. Indistinguishable Association: *McFarland v. Miller*

There must be a showing that the lines or script must have become so identified with the celebrity’s portrayal of the role that it could be considered his own character, or that the lines or script has been so indistinguishably associated with him so as to be inextricably linked to the celebrity’s name and image based on general public perception.⁹⁵

In *McFarland v. Miller*,⁹⁶ an action was filed by Doris McFarland, once a child actor who played the lovable but mischievous urchin under the nickname “Spanky” in the *Our Gang* series,⁹⁷ challenging the use, without his authorization, of the name “Spanky McFarland” by a restaurant located in Ocean Township, New Jersey, owned by Anaconda and operated by Miller.⁹⁸ This restaurant also utilized McFarland’s image as it appeared in his *Our Gang* days.⁹⁹ McFarland contends that the district court erred in granting Miller’s and Anaconda’s motion for summary judgment solely because Hal Roach Studios, Inc. (Studio), the producer of the *Our Gang* movie series, or its successor, was the owner of whatever rights McFarland had to the name “Spanky McFarland” under a 1936 contract between McFarland’s parents, acting on his behalf, and the Studio.¹⁰⁰

The U.S. Court of Appeals held that “Spanky McFarland” has become so identified with McFarland that it could be considered his own name or the name of a character so associated with him as to be indistinguishable from him in public perception, to quote —

We also hold that there is evidence on this record which shows that the name Spanky McFarland *has become so identified with McFarland that it could be considered his own name or the name of a character so associated with him as to be indistinguishable from him in public perception.* Finally, we hold that the district court erred in concluding that the 1936 contract with the studio deprived McFarland of all standing to enforce his right of publicity in the

94. *White*, 971 F.2d 1395 (citing *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983) (U.S.)) (emphasis supplied). As to White’s right of publicity, the Court reversed the district court’s summary judgment. *Id.*

95. *McFarland v. Miller*, 14 F.3d 912, 914. (3d Cir. 1994) (U.S.).

96. *Id.*

97. *Id.* at 915. *Our Gang* was a popular short subject comedy series shown in movie theaters from the 1920s to the 1940s, thereafter on television, and later revived under the name of the *Little Rascals*. *Id.*

98. *Id.* at 914.

99. *Id.*

100. *McFarland*, 14 F.3d at 914.

name Spanky McFarland. Thus, if McFarland's personal representatives can demonstrate on remand that the name Spanky McFarland identified George McFarland and not just the little urchin Spanky he portrayed in the movie and television series, McFarland's right of publicity to exploit the name Spanky McFarland is superior to that of Miller and Anaconda. We will, therefore, remand this case to the district court in order to determine whether McFarland is inextricably linked to the name and image of Spanky McFarland.¹⁰¹

The U.S. Court of Appeal's ruling in this wise is instructive — “[w]here an actor plays a well-defined part which has not become inextricably identified with his own person, it has been suggested the actor receives no right of exploitation in his portrayal of the character.”¹⁰²

In his concurrence in *Lugosi v. Universal Pictures*,¹⁰³ Justice Stanley M. Mosk recognized another distinct situation where the actor could obtain proprietary interests in a “screen persona” —

‘An original creation of a fictional figure played exclusively by its creator may well be protectible.’ We are inclined to agree, but we think the difference between the two situations Justice Mosk contrasts is not wholly dependent on originality as his concurrence suggests. *While originality plays a role, a court should also consider the association with the real life actor. Where an actor's screen persona becomes so associated with him that it becomes inseparable from the actor's own public image, the actor obtains an interest in the image which gives him standing to prevent mere interlopers from using it without authority. This principle may be seen in a number of other cases. Much as the court observed in [Price v. Hal Roach Studios, Inc.], ‘we deal here with actors portraying themselves and developing their own characters[.]’ A misappropriation took place in Allen and Price because the performers were identified with the image developed on-screen. Thus, the actor who developed the image had the right to exploit it as superior to third parties which had nothing to do with the actor or the character identified with the actor.*¹⁰⁴

Thus, under this criterion, concomitant with the right of the celebrity over his on-screen persona is his or her copyright over the personal expression of the lines or script that has been indistinguishably identified with him or her.

101. *Id.* (emphasis supplied).

102. *Id.* at 920.

103. *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979) (U.S.).

104. *McFarland*, 14 F.3d at 920–21 (citing *Lugosi*, 603 P.2d at 432 (J. Mosk, concurring opinion) & *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 845 (S.D.N.Y. 1975)) (emphasis supplied).

The U.S. Court of Appeals ultimately ruled that there is a genuine issue of fact as to whether the McFarland's own identity has been inextricably identified with the role, "Spanky" —

Therefore, we need not decide who would prevail in a contest between that entity and McFarland's estate. We hold only that there exists at least a triable issue of fact *as to whether McFarland had become so inextricably identified with Spanky McFarland that McFarland's own identity would be invoked by the name Spanky*. As the Wisconsin Supreme Court stated in *Hirsch v. S.C. Johnson & Son, Inc.*, 'all that is required is that the name *clearly identify* the wronged person.' On the record now before us, there is evidence of identification between the name Spanky and the actor McFarland sufficient to show that he, and now his estate, have a right of publicity superior to that of the interloper, Miller, in exploiting the name and image of Spanky McFarland. Accordingly, summary judgment was inappropriate. While others may be able to claim that they were entirely responsible for the value of the name and image or, by assignment, own the right to exploit the publicity value of the name and image of Spanky McFarland, Miller has no such claim or defense. George McFarland has alleged facts sufficient to support a right superior to that of Miller or Anaconda to exploit the items that invoke his own image.¹⁰⁵

The celebrity's economic rights over the lines or script as justified by his or her distinct portrayal of the role is explained by his or her proprietary interest in the use of his or her persona, which has become so inextricably linked to the role or character he or she portrayed where the lines or script were uttered or delivered —

This result seems to us consistent with the New Jersey courts' view of the right of publicity. As far back as 1909, New Jersey recognized an individual's proprietary interest in the use of his or her name and appearance to endorse or sell a product. We recognized that principle of New Jersey law in *Ettore v. Philco Television Broadcasting Corp.* In [*Palmer v. Schonhorn Enteres, Inc.*], the New Jersey Superior Court had before it an unauthorized use of certain professional golfers' names and biographical information. It held [that] unauthorized use violated the athletes' rights to exploit their own image. In *Canessa v. J.I. Kislak, Inc.*, the [New Jersey Court] stated [—]

Entirely apart, however, from the metaphysical niceties, the reality of a case such as we have here is, in the court's opinion, simply this: plaintiffs' names and likenesses belong to them. As such they are property. They are things of value. Defendant has made them so, for it has taken them for its own commercial benefit. [...] New Jersey has always enjoined the use of plaintiff's likeness and name on the specific basis that it was a protected property right. It is as much a property

105. *McFarland*, 14 F.3d at 921 (citing *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129, 137 (Wis. 1979) (U.S.)) (emphasis supplied).

right after its wrongful use by defendant as it might be before such use.¹⁰⁶

Was there an identification of George McFarland with the character “Spanky”? If so, does a right of publicity follow and vest in the performer with whom the character has become identified? The U.S. Court of Appeals ruled in the affirmative for both questions, thus —

When Miller appropriated the name Spanky McFarland and McFarland’s likeness in pursuit of a commercial goal, McFarland became entitled to the same protection the New Jersey courts gave in [previous related cases]. In *Palmer*,] the court observed, ‘[i]t is unfair that one should be permitted to commercialize or exploit or capitalize upon another’s name, reputation, or accomplishments merely because the owner’s accomplishments have become highly publicized.’ In taking McFarland’s name, Miller unfairly sought to capitalize on its value. The very act of taking it for that purpose demonstrates the name itself has worth. ... If McFarland can demonstrate his identification with the name ‘Spanky,’ we do not think New Jersey law would permit Miller to appropriate the nickname Spanky for his own commercial advantage without McFarland’s consent, in the absence of a valid license or assignment from the true owner.

...

Thus, we conclude that *if McFarland establishes a personal connection with the name Miller sought to profit from, Miller is liable for that misappropriation.* The amount of damages, however, may be influenced by the quantum of the right retained by McFarland.

...

In summary, we hold that in New Jersey, *the right of publicity is a proprietary right based on the identity of a character or defining trait that becomes associated with a person when [he or she] gains notoriety or fame.* The right to exploit the value of that notoriety or fame belongs to the individual with whom it is associated and a cause of action for its infringement that took place during the lifetime of the individual with whom the fame is associated descends to the personal representative of the holder in New Jersey. We conclude that by virtue of his on-screen portrayal of a cherubic boy in the [*Our Gang*] comedy series, McFarland developed an exploitable interest to which he may lay claim if he can persuade a fact finder that he has become identified with the name Spanky. There is no individual or entity presently before this court that has superior claim to the publicity value of the nickname Spanky. Accordingly, we will remand to the district court with instruction

106. *McFarland*, 14 F.3d at 921-22 (citing *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481, 491-92 (3d Cir. 1956) (U.S.); *Canessa v. J.I. Kislak, Inc.*, 235 A.2d 62, 76 (N.J. Super. Ct. 1967) (U.S.); & *Palmer v. Schonhorn Enteres, Inc.*, 232 A.2d 458, 462 (N.J. Super. App. Div. 1967) (U.S.)) (emphasis supplied).

to vacate the summary judgment entered in favor of Miller and Anaconda and for further proceedings consistent with this opinion.¹⁰⁷

The U.S. Court of Appeals in *McFarland* even held that the cause of action arising from such right survives the celebrity, just like the treatment of an author's economic and moral rights under the U.S. Intellectual Property Code —

After considering the issues, we conclude that infringement of a person's right to exploit commercially his own name or the name of a character so associated with him that it identifies him in his own right is a cause of action that under New Jersey law survives the death of the person with whom the name has become identified. Therefore, we hold that McFarland's action to prevent unauthorized use of the name 'Spanky McFarland' survived his death and passed to his personal representative, Doris McFarland.¹⁰⁸

This survival of cause of action was recognized in *Horgan v. Macmillan, Inc.*¹⁰⁹ In this case, Barbara Horgan, executrix of the estate of the renowned choreographer George Balanchine, sought to enjoin the publication of a book entitled *The Nutcracker: A Story & a Ballet*, which portrays, in text and photographs, the New York City Ballet Company's production of *The Nutcracker* ballet, choreographed by Balanchine.¹¹⁰ The U.S. Court of Appeals not only recognized the legal standing of the estate in filing the suit, but reiterated the standard for copying that could serve as a ground for an action for infringement —

However, the standard for determining copyright infringement is not whether the original could be recreated from the allegedly infringing copy, but whether the latter is 'substantially similar' to the former.

...

When the allegedly infringing material is in a different medium, as it is here, recreation of the original from the infringing material is unlikely if not impossible, but that is not a defense to infringement. It surely would not be a defense to an infringement claim against the movie version of 'Gone With The Wind' that a viewer of the movie could not create the book. *Even a small amount of the original, if it is qualitatively significant, may be sufficient to be an infringement, although the full original could not be recreated from the excerpt.* In [one case], short film clips used in a film memorial to Charlie Chaplin were held to infringe full length films. In [another], the use of four

107. *McFarland*, 14 F.3d at 922-23 (citing *Palmer*, 232 A.2d at 462 & *Canessa*, 235 A.2d at 76) (emphases supplied).

108. *McFarland*, 14 F.3d at 914.

109. *Horgan v. Macmillan, Inc.*, 789 F.2d 157 (2d Cir. 1986) (U.S.).

110. *Id.* at 158.

notes from a musical composition containing one hundred measures was held sufficient to infringe the copyrighted original.¹¹¹

Moreover, the association of the line or script to the celebrity's persona must not have been diluted by intervening portrayal in the form of film or movie remake, spoof, or parody so as to acquire a sense of originality in the celebrity's portrayal of the role where the lines or script was delivered or uttered.

4. Value of Association: *Landham v. Lewis Galoob Toys, Inc.*

In the case of *Landham v. Lewis Galoob Toys, Inc.*,¹¹² William Landham played the role of Billy, the Native American Tracker, in the 1987 Fox film called *Predator* that starred Arnold Schwarzenegger.¹¹³ In 1995, Fox licensed to Galoob Toys the right to produce and market a line of its Micro Machine toys based on *Predator*.¹¹⁴ One of three sets of toys contained a "Billy" action figure,¹¹⁵ which was 1.5 inches tall and bore no personal resemblance to Landham.¹¹⁶ He sued Galoob and Fox for false endorsement under the Lanham Act and for violating his right of publicity.¹¹⁷ The district court dismissed the suit.¹¹⁸ Landham appealed.¹¹⁹

The U.S. Court of Appeals ruled that while plaintiff need not be a celebrity, there must be "sufficient evidence" of commercial value in associating the lines or script to him.¹²⁰ As in *Landham*, "[t]o assert the right of publicity, a plaintiff must demonstrate that there is value in associating an item of commerce with his identity."¹²¹ Misappropriation of the plaintiff's identity may be sufficient evidence of commercial value.¹²²

Here, Landham could not show that his persona had significant commercial value or that the toy invoked his persona, as distinct from that of the fictional character.¹²³ The false designation of origin claim brought

111. *Id.* at 162 (emphasis supplied).

112. *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619 (6th Cir. 2000) (U.S.).

113. *Id.* at 621.

114. *Id.* at 622.

115. *Id.*

116. *Id.*

117. *Id.*

118. *Landham*, 227 F.3d at 621.

119. *Id.*

120. *Id.* at 624.

121. *Id.*

122. *Id.*

123. *Id.* at 627.

under the Lanham Act by an entertainer claiming misappropriation of his identity is the equivalent to a false association or endorsement claim.¹²⁴ The mark involved is the plaintiff's identity. He could not show actual or likely confusion of his identity with the toy involved.¹²⁵

Additionally, in the original *Tin Pan Apple v. Miller Brewing*,¹²⁶ a case dismissed by the U.S. District Court four years before the issue on the "Hugga-Hugga" and "brrr" sounds was decided, it was already said that —

In [*Lahr v. Adell Chemical Co.*], the First Circuit construed the New York statute in holding that defendant's copying of the comedian Bert Lahr's distinctive voice in a commercial featuring a cartoon duck did not state a claim. Judge [Bailey Aldrich] observed that the statute covered only commercial use of a party's 'name, portrait[,] or picture,' adding: 'The statute is very specific.' Plaintiffs at bar point out that *Lahr* did not involve combined use of look-alikes and sound-alikes, but that seems to me a distinction without a difference. It is still a legislative function to decide whether copying a party's voice violates the statute in any circumstance. Plaintiffs cite [*Midler v. Ford Motor Co.*], but the case does not assist them. True enough, Ford and its advertising agent asked the noted popular singer Bette Midler to make a commercial and, upon her refusal, hired a singer who sounded like her: conduct comparable to that alleged against defendants at bar. The commercial did not use Midler's name or picture, but the Ninth Circuit, construing California law, articulated a cause of action for commercial use of a sound-alike. The [Ninth Circuit] derived from California statutes protecting use of a person's 'name, voice, signature, photograph or likeness' comparable common law rights which by analogy also constituted 'property rights,' defendants were held to have misappropriated Midler's property and thus committed a tort under California law. I do not presume to comment on the Ninth Circuit's exegesis of the law of another state. I hold only that the New York Civil Rights Law does not yet extend to sound-alikes.¹²⁷

124. *Landham*, 227 F.3d at 626.

125. *Id.* at 627.

126. *Tin Pan Apple, Inc. v. Miller Brewing Co., Inc.*, 737 F. Supp. 826, 837 (S.D.N.Y. 1990) (U.S.) [hereinafter *Tin Pan Apple (1990)*]. This case involves the original action between Tin Pan Apple's *Fat Boys* and Miller Brewing. A few years after the Court granted Miller Brewing's motion to dismiss in the 1990 case, Tin Pan Apple filed an amended complaint that particularly identified the music and lyrics they claimed Miller Brewing had copied (i.e., the "Hugga-Hugga" and "Brrr" sounds). *Tin Pan Apple*, 1994 U.S. Dist. LEXIS 2178, at *4.

127. *Tin Pan Apple (1990)*, 737 F. Supp. at 837-38 (citing *Lahr v. Adell Chemical Co.*, 300 F.2d 256 (1st Cir. 1962) (U.S.)).

5. *Wendt v. Host International Inc.*

In *Wendt v. Host International Inc.*,¹²⁸ George Wendt and John Ratzenberger argued that Host International Inc. violated their trademark and publicity rights by creating animatronic robotic figures (robots) based upon their likenesses without their permission and placing these robots in airport bars modeled upon the set from the television show *Cheers*.¹²⁹

The question here is whether the three[-]dimensional animatronic figures are sufficiently similar to plaintiffs to constitute their likenesses. Based on the limited record before us, it cannot be said as a matter of law that the figures are so dissimilar from plaintiffs that no reasonable trier of fact could find them to be 'likenesses.' That question must be determined by a comparison of the actual, three-dimensional entities.¹³⁰

Here, reference was made to the common law right of publicity in connection with the common law right of privacy —

California recognizes a common law right of privacy that includes protection against appropriation for the defendant's advantage of the plaintiff's name or likeness. The right to be protected against such appropriations is also referred to as the 'right of publicity.' *A common law cause of action for appropriation of name or likeness may be pleaded by alleging[:]* 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.*

*The so-called right of publicity means in essence that the reaction of the public to name and likeness, which may be fortuitous or which may be managed and planned, endows the name and likeness of the person involved with commercially exploitable opportunities. The protection of name and likeness from unwarranted intrusion or exploitation is the heart of the law of privacy.*¹³¹

The Court explained the scope of the common law right of publicity —

We have held that this common[]law right of publicity protects more than the knowing use of a plaintiff's name or likeness for commercial purposes that is protected by [Section 3344 of the California Civil Code]. It also protects against appropriations of the plaintiff's identity by other means.

Appellees argue that the figures appropriate only the identities of the characters Norm and Cliff, to which Paramount owns the copyrights, and not the identities of Wendt and Ratzenberger, who merely portrayed those

128. *Wendt v. Host International Inc.*, 125 F.3d 806 (9th Cir. 1997) (U.S.).

129. *Id.* at 809.

130. *Id.* (citing *Wendt v. Host*, Nos. 93-56-318, 93-56510, 1995 U.S. App. LEXIS 5464, at *6 (9th Cir. 1995) (U.S.) [hereinafter *Wendt II*]).

131. *Wendt*, 125 F.3d at 811 (citing *Eastwood v. Super. Ct. for Los Angeles County*, 198 Cal. Rptr. 342, 347 (Cal. Ct. App. 1983) (U.S.)) (emphases supplied).

characters on television and retain no licensing rights to them. They argue that appellants may not claim an appropriation of identity by relying upon indicia, such as the [*Cheers*] Bar set, that are the property of, or licensee of, a copyright owner.

Appellants freely concede that they retain no rights to the characters Norm and Cliff; they argue that the figures, named ‘Bob’ and ‘Hank,’ are not related to Paramount’s copyright of the creative elements of the characters Norm and Cliff. They argue that it is the physical likeness to Wendt and Ratzenberger, not Paramount’s characters, that has commercial value to Host.

While it is true that appellants’ fame arose in large part through their participation in Cheers, an actor or actress does not lose the right to control the commercial exploitation of his or her likeness by portraying a fictional character.

Appellants have raised genuine issues of material fact concerning the degree to which the figures look like them. Because they have done so, appellants have also raised triable issues of fact as to whether or not appellees sought to appropriate their likenesses for their own advantage and whether they succeeded in doing so. *The ultimate issue for the jury to decide is whether the defendants are commercially exploiting the likeness of the figures to Wendt and Ratzenberger intending to engender profits to their enterprises.* We therefore reverse the grant of summary judgment on the common law right of publicity claim.

...

In *Wendt I*,] we held that appellants would have a claim if ‘Host’s conduct had created a likelihood of confusion as to whether plaintiffs were endorsing Host’s product.’ In order to determine whether or not such confusion is likely to occur, we referred to a ‘*well settled eight factor test*’ to be applied to celebrity endorsement cases, [*Newton v. Thomason*.] This test requires the consideration of:

- (a) the strength of the plaintiff’s mark;
- (b) relatedness of the goods;
- (c) similarity of the marks;
- (d) evidence of actual confusion;
- (e) marketing channels used;
- (f) likely degree of purchaser care;
- (g) defendant’s intent in selecting the mark; [and]
- (h) likelihood of expansion of the product lines.

In Wendt 1[,] we concluded that one of the primary factors of this test was the ‘similarity of the marks[.]’ and because there was a disputed issue of material fact as to that issue, summary judgment was inappropriate on this claim.¹³²

V. RECOMMENDATION

The copyright protection proposed in this Article applies to famous lines or scripts uttered or delivered in a very personal manner by celebrities in a role portrayed in a film where the line or script was made popular, and who has been strongly associated or whose identity has been inextricably intertwined with the famous lines or script.

Subject to existing provisions of the law on fair use¹³³ and applicable provisions on economic¹³⁴ and moral¹³⁵ rights, as well as the duration of copyright,¹³⁶ below are the recommended criteria for the application of this legal framework:

- (a) Allowing copyright protection over lines or script based on the celebrity’s personal “expression” of ideas in a role portrayed in the film where the line or script was made popular:¹³⁷
 - (1) By the celebrity’s distinct portrayal and delivery of the lines or script that was the very reason for its fame,
 - (2) But subject to the limitation that there was no remake or spoof or even parody of the film or movie wherein said lines or script was delivered.
 - (3) While such line or script may arguably be considered to fall under the public domain, the expression or manner by which said line was creatively delivered or uttered by the celebrity will be protected as original to him or her.¹³⁸

132. *Wendt*, 125 F.3d at 811-12. (citing *Newton v. Thomason*, 22 F.3d 1455, 1462 (9th Cir.1994) (U.S.); *AMF, Inc.*, 599 F.2d at 341; *Lugosi*, 603 P.2d at 431; *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 716 (9th Cir.1970) (U.S.); & *Wendt 1*, at *2 (emphases supplied).

133. INTELLECTUAL PROPERTY CODE, § 185.

134. *Id.* § 177.

135. *Id.* § 193.

136. *Id.* §§ 213-214.

137. *Feist Publications, Inc.*, 499 U.S. at 349.

138. *Id.* at 345-46.

- (4) The celebrity's portrayal of the role and in his or her utterance or delivery of the lines or script must be "sufficiently creative to warrant copyright protection."¹³⁹
- (b) The celebrity has been strongly associated, and his or her identity inextricably intertwined, with the famous lines or script. Thus, the following must be shown:
 - (1) A strong celebrity's persona or level of recognition that the celebrity enjoys among general public with regard to the famous line or script;¹⁴⁰
 - (2) Substantial evidence that the general public identify the lines or script solely with the celebrity concerned and no one else;
 - (3) The association of the line or script to the celebrity's persona must not have been diluted by intervening portrayals in the form of film or movie remake, spoof, or parody so as to acquire a sense of originality in the celebrity's portrayal of the role where the lines or script was delivered or uttered;
 - (4) While the line may have been popularized by public utterances or adaptations in subsequent audiovisual works, proof should point to the celebrity as the originator character to whom the line can be inextricably linked or indistinguishably related;
 - (5) Proof that the celebrity has created a marketable celebrity identity value,¹⁴¹ or if the actor or performer is not a celebrity, he or she must show that there is value in associating an item of commerce with his identity;¹⁴² and
 - (6) A showing that the lines or script must have become so identified with the celebrity's portrayal of the role that it could be considered his or her own character or that the lines or script has been so indistinguishably associated with him or her so as to be inextricably linked to the celebrity's name and image based on general public perception.¹⁴³

139. *Tin Pan Apple*, 1994 U.S. Dist. LEXIS 2178, at *10.

140. *White*, 971 F.2d at 1400.

141. *Allen*, 610 F. Supp. at 625-26.

142. *Landham*, 227 F.3d at 624.

143. *McFarland*, 14 F.3d at 914.

The proposal explored in this study is consistent with the policy of the State as articulated in the 1987 Constitution of the Philippines —

SECTION 14. The State shall foster the preservation, enrichment, and dynamic evolution of a Filipino national culture based on the principle of unity in diversity in a climate of free artistic and intellectual expression.

SECTION 15. Arts and letters shall enjoy the patronage of the State. The State shall conserve, promote, and popularize the nation's historical and cultural heritage and resources, as well as artistic creations.

SECTION 16. All the country's artistic and historic wealth constitutes the cultural treasure of the nation and shall be under the protection of the State which may regulate its disposition.¹⁴⁴

This is also pursuant to the State policy carried out by the Philippine Intellectual Property Code, recognizing the need for an effective intellectual and industrial property system that “shall protect and secure the exclusive rights of ... artists and other gifted citizens to their intellectual property and creations, particularly when beneficial to the people, for such periods as provided in this [Code].”¹⁴⁵

Furthermore, the proposal seeks to achieve the elusive and delicate balance between granting the author enough leeway to protect his or her intellectual creation on the one hand, and, on the other, affording him or her enough freedom to draw from the intellectual works of other authors.¹⁴⁶

Ultimately, the benefit resulting from the proposal is designed to inure to the public. By granting adequate protection and incentive to performers who have contributed their talent as an artist, the culture and the arts will flourish with a firm support from the legal framework within which it operates.

144. PHIL. CONST. art. XIV, §§ 14-16.

145. INTELLECTUAL PROPERTY CODE, § 2.

146. *See generally* PAUL GOLDSTEIN, *COPYRIGHT: PRINCIPLES, LAW AND PRACTICE* (1990).