And the Most Litigated Oscar goes to...

By David Kluft

Associated Press

Jeremy Renner in a scene from, "The Hurt Locker."

The film that wins the Best Picture Oscar this year is certain to attract more viewers and box office receipts than it had before receiving the award. But Best Picture winners may also attract more lawsuits, including intellectual property claims. Sometimes the lawsuits are just as worthy of attention as the films themselves but, until the Academy gives a Most Litigated Picture award (which would almost certainly go either to "Gone with the Wind" or "Titanic"), you'll have to make do with these summaries of some of the more interesting intellectual property disputes involving Best Picture Oscar winners.

"Cimarron" (1931)

The plaintiff in *Caruthers v. RKO Radio Pictures Inc.*, 20 F.Supp. 906 (S.D.N.Y. 1937), alleged that the film "Cimarron" was copied from his unpublished manuscript, "The Sooners." The court found that, other than the setting (the settlement of Oklahoma) and well-known frontier scenes a faire, there were no similarities between the works, with one exception: a character who, while fanning flies away from a dinner table, becomes distracted and either falls into a cake ("Cimarron") or strikes one of the diners with the fan ("The Sooners"). The court held this fleeting incident had no functional relationship to the story, and could not serve as the basis for a copyright infringement action.

"Gone with the Wind" (1939)

In 1979, an Atlanta theatre announced the opening of "Scarlett Fever," an unauthorized musical play based on "Gone with the Wind." MGM filed a copyright infringement action to enjoin the production. In *MGM v. Showcase Atlanta Coop. Prods. Inc.*, 479 F.Supp. 351 (N.D. Ga. 1979), the court found that the works were substantially similar in terms characters, setting, plot and dialogue. The court rejected the defendant's argument that "Scarlett Fever" was a protected parody. The court held that, although the play was presented in a humorous "cabaret" style, it was predominately not a critical commentary but a derivative homage to the original.

"The Wind Done Gone," on the other hand, was a parody. Alice Randall's book retold the story of "Gone with the Wind" from the perspective of one of Scarlett O'Hara's slaves, and intentionally borrowed characters and plot elements from the original to critique its romantic depiction of the Civil War-era American South. In *SunTrust Bank v. Houghton Mifflin Co.*, 268 F. 3d 1257 (11th Cir. 2001), the 11th U.S. Circuit Court of Appeals held that "The Wind Done Gone" was fair use.

"The Bridge on the River Kwai" (1957)

When film producer Kurt Unger registered a screenplay titled "Return from the River Kwai," about World War II prisoners forced to build a railway in Burma, the studio that had produced "The Bridge on the River Kwai" sued for trademark infringement. In *Tri-Star Pictures Inc. v. Unger,* 14 F.Supp.2d 339 (S.D.N.Y. 1998), the court found that Unger had "no legitimate reason" to use the title "Return from the River Kwai" other than to confuse consumers into believing, incorrectly, that it was an authorized sequel. Nevertheless, "Return from the River Kwai" was finally produced in 1989. No Alec Guinness in this one, sadly, but the cast did include George Takei (Oh Myyy!).

"Rocky" (1976)

Screenwriter Timothy Anderson, apparently a fan of the first three "Rocky" movies (all written by Sylvester Stallone), penned a treatment for a fourth film and submitted it to MGM. The treatment involved an East German boxer and a boxing match in the shadow of the Berlin Wall. Anderson claimed that MGM and Stallone used the treatment for the film "Rocky IV" (featuring Dolph Rundgren as Soviet boxer Ivan Drago). In *Anderson v. Stallone*, 1989 U.S. Dist. LEXIS 11109 (C.D. Cal. 1989), the court held that the treatment was not entitled to copyright protection because it was an unauthorized derivative work using Stallone's characters. The court also found there was no substantial similarity between the treatment and film.

"Annie Hall" (1977)

Following the success of "Annie Hall," Woody Allen look-alike Phil Boroff found himself in high demand. In *Allen v. National Video Inc.*, 610 F.Supp. 612 (S.D.N.Y. 1985), Allen convinced the court that Boroff's appearance in an advertisement for a video rental chain (Boroff was strategically placed next to a cassette copy of "Annie Hall") was a Lanham Act violation because it created a likelihood of consumer confusion. The court enjoined Boroff from appearing in similarly confusing ads.

But the following year, Boroff — labeled as a "celebrity look-a-like" — appeared in an ad for a clothing store holding a clarinet and evoking what Allen alleged was his "schlemiel" persona from the film. Allen moved for contempt. The court reluctantly found that, although the ad was in "clear contempt" of the spirit of the earlier order, it did not violate its letter, which had been ambiguous as to whether the "celebrity look-a-like" disclaimer would be sufficient. However, in *Allen v. Men's World Outlet Inc.*, 679 F.Supp. 360 (S.D.N.Y. 1988), Allen's Lanham Act claims against the clothing store ultimately prevailed.

"Forrest Gump" (1994)

"Forrest Gump" is notable in part because of special effects which digitally altered archival footage so historical figures — such as President John F. Kennedy and John Lennon — appeared to be speaking lines written by the film's screenwriter. The inventor of a similar process — for digitally altering lip movements to dub moving images into different languages — sued for patent infringement. In *Bloomstein v. Paramount Pictures Corp.*, 1998 U.S. Dist. LEXIS 20905 (N.D. Cal. 1998), the court granted the defendant's motion for summary judgment, in part because the plaintiff's patent claims encompassed only translations of lip movements into *foreign* languages, and did not extend to the *English-to-English* digital alterations in the film.

"Titanic" (1997)

Plaintiff "Princess Samantha Kennedy," proceeding pro se, claimed that the film "Titanic" was copied from her own unpublished biographical. In *Kennedy v. Paramount Pictures Corp.*, 2013 U.S. Dist. LEXIS 43882 (S.D. Cal. 2013), the court dismissed the action, holding that the similarities in language alleged by the plaintiff (e.g., a character who "slicks his hair back with spit" ("Titanic") versus a character who "slicked back his greasy hair" (Kennedy's work)) amounted to no more than ordinary expressions of ideas not subject to copyright protection. Another pro se writer came forward in *Manuel v. Paramount Pictures*, 2001 U.S. Dist. LEXIS 16065 (S.D.N.Y. 2001), alleging that "Titanic" was copied from his screenplay, "Camp Terror," the story of a camp counselor who heroically fights off a group of ex-convicts. The court held that "no sane fact finder" would be able to find a substantial similarity.

"Shakespeare in Love" (1999)

The authors of "The Dark Lady," a screenplay "about William Shakespeare writing a new play and failing in love" claimed "Shakespeare in Love" infringed their screenplay. The court in *Miller v. Miramax Film Corp.*, 2001 U.S. Dist. LEXIS 25967 (C.D. Cal. 2001), held that many of the similarities between the works were mere "stock scenes" (i.e., scenes a faire), for example, historical characters and locations. However, the court found there were nevertheless enough similarities to survive summary judgment. Both works involved Shakespeare suffering from writer's block while under pressure to write a new play, burning the manuscript in frustration, then meeting a literate noble woman who knows his work by heart, has an affair with him, inspires him to overcome his writer's block and stars in the new play prior to leaving for the New World. The case settled before trial.

"The Hurt Locker" (2009)

In 2004, writer Mark Boal was embedded in an Army unit in Iraq where Jeffrey Sarver served as an Explosive Ordinance Disposal technician. Boal eventually published an article about Sarver for Playboy Magazine, and subsequently wrote the screenplay for "The Hurt Locker." Sarver claimed that the character of Will James (played by Jeremy Renner) was based on him and sued. He alleged numerous counts, including misappropriation of a likeness. In *Sarver v. Hurt Locker LLC*, 2011 U.S. Dist. LEXIS 157503 (C.D. Cal. 2011), the court dismissed Sarver's complaint and held, inter alia, that the film was protected speech about a public issue, and that "whatever recognition or fame Plaintiff may have achieved, it had little to do with the success of the movie."

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Cloud coverage under our own California Constitution

By Brian Alvarez

An effort to strengthen privacy protections in email and other data stored in the cloud was revived when lawmakers introduced bills to reform the nation's electronic privacy laws. The Electronic Communications Privacy Amendments Act of 2015 would require law enforcement to obtain search warrants to search data stored on Web-based services for over 180 days. A companion House version was also introduced.

Of course, Californians may enjoy more protective rights to stored Web-based electronic communication to the extent current federal law purports to allow state courts to compel discovery by law enforcement without probable cause.

The Electronic Communications Privacy Act (ECPA) creates privacy rights for "customers" and "subscribers" of network service providers. Within ECPA is the Stored Communications Act (SCA), which regulates how law enforcement can compel service providers to disclose their customers' communications. This statute is unique because it allows state law enforcement officers to seek state court orders to compel the disclosure of electronic communications from a service provider. Whenever a California law enforcement officer seeks electronic evidence from a service provider, the provider must comply with the SCA.

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The question is whether the SCA provides for the lawful issuance of a state order to obtain stored Web-based communications without probable cause. Stated differently, is California law contrary to the disclosure procedure of the SCA, to the extent the statute allows disclosure to law enforcement without probable cause? California case law suggests that such an order based on less than probable cause violates the state Constitution.

The Fourth Amendment to the U.S. Constitution protects against unreasonable search and seizures. To determine whether government surveillance is a "search," courts look to *Katz v. United States* (1967), which involved eavesdropping with an electronic device placed outside a phone booth. *Katz* held this was an unreasonable search because it violated a subjective interest in privacy that society recognized as reasonable. Subsequently, in *Smith v. Maryland* (1979), the U.S. Supreme Court concluded that individuals have no reasonable expectation of privacy in the numbers dialed to or from their telephone lines. The court held that telephone customers generally know that telephone companies routinely collect and use such information.

By the early 1980s, there was uncertainty in an individual's privacy interest in electronic communication. In California, the applicable laws were: (1) the Fourth Amendment, (2) the right to privacy guaranteed by the state Constitution; (3) the right to be free from unreasonable search and seizures by the government guaranteed by the state Constitution; and (4) the common law right to privacy recognized in California. The inquiry for each was the same: Does the person invoking the right have a reasonable expectation of privacy. Against this uncertainty, in 1986, Congress enacted the SCA.

The SCA divides service providers into two groups: "providers of electronic communication service" and "providers of remote computing services." It protects communications held in "electronic storage" by providers of electronic communication services, and communication held by remote computing services. "Electronic storage" is "any temporary, intermediate storage of a wire or electronic communication incident to the electronic transmission thereof," or "any storage of such communication by an electronic communication service for purposes of backup protection of such communication."

The SCA provides five processes to compel a service provider to disclose certain information. These methods involve a subpoena with or without notice to the customer, an "articulable facts" order with notice or delayed notice to the customer, and a search warrant. The proper process will depend on the type of information sought, and the level of privacy the statute attributes to it. The SCA categorizes the targeted information into three areas: (1) basic subscriber information; (2) other non-content customer and account information; and (3) contents. The "contents" of a network account are the actual files stored in the account, which are defined as "any information concerning the substance, purport, or meaning of that communication." For example, "contents" includes stored Web-based email or voicemails, and word processing files attached and stored in network accounts.

The government may obtain a court order (the articulable facts order) with delayed notice to the customer to compel disclosure by a service provider of basic subscriber information, all other non-content customer-related records, such as account logs that record use, cell site data for phone calls, and email addresses of others with whom the customer has corresponded, and the "contents of a wire or electronic communication that has been in electronic storage in an electronic communication system for more than [180] days." An order for disclosure, without probable cause, may be issued by "any court that is a court of competent jurisdiction and shall issue only if the government entity offers specific and articulable facts showing that there are reasonable grounds to believe that the contents of a wire or electronic communication, or the records or other information sought, are relevant and material to an ongoing criminal investigation. In the case of a State governmental authority, *such a court order shall not issue if prohibited by the law of such state*." (Italics added.) By its plain language the SCA does not allow state law enforcement officers to apply for a state court order if the order would be "prohibited by the law of such state."

The state Constitution prohibits an officer's ability to obtain a state court order disclosing the electronic records the SCA lists on less than probable cause. It extends protections for civil rights broader than, and independent of, the parallel rights guaranteed by the U.S. Constitution. It guarantees "against unreasonable seizures and searches." The state Supreme Court has held "that, in determining whether an illegal search has occurred under the provisions of the state Constitution, the appropriate test is whether a person has exhibited a reasonable expectation of privacy, and, if so, whether that expectation has been violated by unreasonable governmental intrusion." *Burrows v. Superior Court*, 13 Cal. 3d 238, 242-43 (1974). In *Burrows*, the court held that bank customers have a reasonable expectation of privacy in their financial information transmitted to their bank, reasoning that "a depositor reveals many aspects of his personal affairs, opinions, habits and associations" equivalent to a "virtual current biography." In *People v. Blair,* 25 Cal. 3d 640 (1979), the state Supreme Court extended the rationale of *Burrows* to hold that telephone records, like bank records, were protected from unreasonable seizures and searches under the state Constitution, notwithstanding a contrary holding on federal constitutional grounds by the U.S. Supreme Court in *Smith v. Maryland*. In *Blair,* telephone call records from a service provider were obtained pursuant to a federal grand jury subpoena. The court found this process, while proper under federal law, was insufficient under the search and seizure provision of the state Constitution, because they had been produced without a "judicial determination that law enforcement officials were entitled thereto." Thus, the telephone records properly obtained under federal law, were held to violate the state Constitution.

In *People v. Chapman*, 36 Cal. 3d 98 (1984), the state Supreme Court again addressed police conduct in obtaining subscriber information of a customer's unlisted telephone number, from the service provider without a warrant. In applying *Burrows* and *Blair,* and citing *People v. McKunes*, 51 Cal. App. 3d 487 (1975), the court held that under the state Constitution, telephone customer information records were protected from warrantless disclosure. Because there was a reasonable expectation of privacy in subscriber information in an unlisted telephone number, "the action of the police, in seizing unlisted information without a warrant, consent, or exigent circumstances, violated the [state] Constitution." Thus, obtaining communication records without a warrant, or an exception to the warrant requirement, violates the state Constitution. There seems little reason to deny extension of these cases to particular forms of stored Web-based electronic communication, as defined in the SCA, especially since these records provide more of a person's "virtual current biography" than bank or telephone records.

Under the rationale of *Burrows*, *Blair* and *Chapman*, portions of the SCA's disclosure process is inadequate to protect a California resident's privacy interest in electronic communication stored in the cloud. State court judges should question any law enforcement officer's request to obtain this information via an "articulable facts" order without a search warrant based on probable cause. Law enforcement should also be reminded that while Proposition 8 eliminated judicially created independent state grounds for excluding evidence, search and seizure in violation of the state Constitution remains unlawful and may expose the officer to civil liability.

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