

Botello v. Shell Oil Co., 19 U.S.P.Q.2d 1674 (Cal. Ct.
App. 1991)

Kathryn A. Kelly

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The Ninth Circuit concluded that there was a violation of the Lanham Act because the Oscar was a strong mark which should be given the strongest possible protection against infringement, the awards were strikingly similar, the parties both distributed similar goods in similar channels, the evidence showed actual confusion, and the intent of Creative House was to deceive the public with its award.¹⁵

California unfair competition claims are substantially similar to federal trademark infringement claims under the Lanham Act.¹⁶ To prove unlawful dilution under California law, the Academy only needed to show that its business reputation is likely to be injured or that the distinctive value of the Oscar is likely to be diluted.¹⁷ The court held the Oscar's value lies in its distinctive design and symbol of film excellence and the Star Award dilutes this value because it could be distributed without regard to the ultimate recipient or could look shoddy and cheap.¹⁸

Conclusion

The Ninth Circuit ultimately determined that the Oscar is entitled to copyright protection and remanded to allow the Academy to present evidence of copyright infringement. The public confusion among the two awards violated both the Lanham Act and California unfair competition laws. The Ninth Circuit remanded the California unfair competition claim with instructions to the district court to reinstate the claim.¹⁹ Similarly, the Ninth Circuit remanded the Academy's claim under the California anti-dilution statute with instructions to the district court to reinstate the claim.²⁰ Ω

Frank Monago

1. Academy of Motion Picture Arts and Sciences v. Creative House Promotions, Inc., 944 F.2d 1446, 1451 (9th Cir. 1991).

2. *Id.*

3. *Id.* at 1452.

4. *Id.*

5. *Id.*

6. White v. Kimmel, 193 F.2d 744, 746 (9th Cir.), *cert. denied*, 343 U.S. 957 (1952).

7. 944 F.2d at 1452.

8. Kamar Intern, Inc. v. Russ Berrie and Co., 657 F.2d 1059, 1062 (9th Cir. 1981).

9. 944 F.2d at 1453.

10. *Id.*

11. *Id.* at 1454.

12. *Id.*

13. New West Corp. v. NYM Co. of California, Inc., 595 F.2d 1194, 1201 (9th Cir. 1979).

14. J.B. Williams Co, Inc. v. Le Conte Cosmetics, Inc., 523 F.2d 187 (9th Cir. 1975), *cert. denied*, 424 U.S. 913 (1976).

15. 944 F.2d at 1455-1457.

16. International Order of Job's Daughters, 633 F.2d 912, 916 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981).

17. Century 21 Real Estate Corp. v. Sandlin, 846 F.2d 1175, 1180 (9th Cir. 1988).

18. 944 F.2d at 1457.

19. *Id.*

20. *Id.*

Botello v. Shell Oil Co.,

19 U.S.P.Q.2d 1674 (Cal. Ct. App. 1991).

Introduction

As the Defendants here learned, "[e]very genuine work of art has as much reason for being as the earth and the sun."¹ In this case, the California Court of Appeals interpreted the California Art Preservation Act (the Act)² which prohibits an owner or possessor of fine art, other than its creator, from altering or destroying the work. Plaintiff artists painted a mural on the wall of a Shell service station, and Shell later destroyed the mural. The court held that although the statute did not explicitly include murals, the legislature intended the term "fine art" to include Plaintiffs' mural.

Facts

In 1980, Shell Oil Company hired several artists to paint a large mural on the wall of a Shell service station. With full artistic freedom, the artists created a 1200 square foot mural entitled "Filling Up On Ancient Energies," depicting Hispanic themes, dinosaurs, Mayan deities, and motor vehicles. In 1988, Shell ordered the destruction of the mural's wall to make room for a parking lot. Without notice to the plaintiffs, the mural was destroyed except for a 120 square foot portion. Although disputed by the parties, Plaintiffs assert the mural was executed so that it could be removed from the wall without damaging the wall or the mural.

Plaintiffs sued the Defendants in September 1988, seeking monetary damages under the Act. The trial court, in adjudicating cross motions for summary judgment, granted Defendants' motion. Although finding that the mural was indeed removable from the wall on which it was painted, the court concluded that a mural was not included in the term "fine art" under the Act, and therefore it was unprotected. Plaintiffs appealed.

LEGAL ANALYSIS

The California Legislature determined that the physical alteration or destruction of fine art is detrimental to an artist's reputation.³ The Legislature also asserted that artists have an interest in

protecting their works, and recognized a public interest in preserving the integrity of cultural and artistic creations.⁴

The Act defines "fine art" as "an original painting, sculpture, or drawing, or an original work of art in glass, of recognized quality" other than a work contracted for commercial use.⁵ Owners or possessors of art, other than the artist, cannot destroy or authorize the destruction of the art.⁶ If the Act is violated, an artist may receive actual and punitive damages, attorney fees, and expert witness fees.⁷ The rights of the artist are descendible, transferable, and endure until 50 years after the artist's death.⁸

The art at issue here is attached to a building, and the Act specifically addresses this particular display of art. An artist's rights are waived if the art cannot be removed from the building without damage to the art or the building.⁹ If the art at issue can be removed from the building without damage, the owner must try to notify the artist, who has 90 days to remove the work at his or her own expense.¹⁰

Faced with an issue of statutory construction, the California Appellate Court independently reviewed the lower court decision. The court considered the legislative intent "to effectuate the purpose of the law." If a statute's language is unambiguous, intent is ascertained from the plain meaning of the language itself. In application, however, the court said it reached a "tautological result." The dictionary definition of mural is "a painting or other work applied to and made integral with a wall surface." A painting is defined as a "decoration achieved by applying paint to a surface."¹¹ The court determined that a mural is a subset of painting, "[m]uch as rose is to flower, or ring to jewelry, or sonnet is to poetry."¹²

Interestingly, a recent clarification of the legislative intent helped the court in adjudicating this case. The Legislature had construed the Act after its enactment in relation to the threatened destruction of David Hockney's mural in the Hollywood Roosevelt Hotel. A California law required that every public swimming pool wall have a white finish. The Legislature, in an uncodified general law, specifically exempted Hockney's mural on the hotel's swimming pool wall from the regulation. Based on these findings by the Legislature, the court here held that the law-making body had intended to protect murals under the Act.

The defendants argue, however, that the term painting is ambiguous in the statute because another California law, the Government Code provision concerning state financing of art in public

buildings, makes separate reference to painting and mural.¹³ Therefore, the defendants conclude, if the Legislature had intended the Act to include murals, it would have specifically named them. The appellate court held that the use of "painting" in the government code was used comprehensively. Merely because the Legislature uses a term in a limited sense in one statute does not indicate it intended the same limitation to apply to the same term used in another law. The court held that the separate uses of the same term was not determinative here, and that the intent of the statute to protect the artist's reputation, articulated in the Act itself, did not support the defendants' argument.

Finally, the defendants argued that to include a mural in the Act would be so burdensome to the owner as to render the Act unconstitutional. The court summarily dismissed this unsupported argument, refusing to rewrite the statute. The court, in looking at the declaration of legislative intent, found that it would be a distortion of the Act to hold that an artist who created a mural, endowing it with artistic expression, is not protected. The Act differentiates between fine art that is removable from a building and that which is not.¹⁴ Defendants argue that the Act is limited to sculpture and glass. The court refused to limit the statute to exclude the obvious application, the mural, pointing out that a mural is the "most obvious form of fine art that may be attached to a building."

Conclusion

The court held that the Legislature intended the term "fine art" to include murals, a subset of paintings. The case was remanded for further proceedings. □

Kathryn A. Kelly

1. RALPH WALDO EMERSON, SOCIETY AND SOLITUDE.
2. CAL. CIV. CODE § 987 (West 1991).
3. CAL. CIV. CODE § 987(a) (West 1991).
4. *Id.*
5. CAL. CIV. CODE § 987(b)(2) (West 1991).
6. CAL. CIV. CODE § 987(c)(1) (West 1991).
7. CAL. CIV. CODE § 987(e)(2),(3),(4) (West 1991).
8. CAL. CIV. CODE § 987(g) (West 1991).
9. CAL. CIV. CODE § 987(h)(1) (West 1991).
10. CAL. CIV. CODE § 987(h)(2) (West 1991).
11. The court refers to the Longman Dictionary of Art.
12. *Botello v. Shell Oil Co.*, 19 U.S.P.Q.2d 1674, 1677 (Cal. Ct. App. 1991).
13. CAL. GOVT. CODE § 15813 et seq. (West 1991).
14. CAL. CIV. CODE § 987(h)(1) (West 1991).