

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

ANNA MARIA ALBERGHETTI, BONNIE	)	CV 09-5735 SVW (CWx)
POINTER, and JUDY TENUTA, on	)	
Behalf of Themselves and All	)	ORDER DENYING DEFENDANT'S
Others Similarly Situated,	)	MOTION TO DISMISS [17]
	)	
Plaintiffs,	)	
	)	
v.	)	
	)	
CORBIS CORPORATION,	)	
	)	
Defendant.	)	
_____	)	

**I. INTRODUCTION**

Plaintiffs' complaint alleges that Defendant has misappropriated Plaintiffs' statutory and common law rights of publicity by using Plaintiffs' names, images, and likenesses without Plaintiffs' permission. Plaintiff also asserts a related unjust enrichment/restitution claim. Defendant's Motion to Dismiss asserts that Defendant's copyrights in the allegedly infringing work trump Plaintiffs' rights of publicity.

1 **II. FACTS**

2  
3 Plaintiffs are Anna Maria Alberghetti, Bonnie Pointer, and Judy  
4 Tenuta, who are artists/entertainers who have worked in a variety of  
5 mediums. Defendant Corbis Corporation is a photo-licensing company  
6 incorporated in Nevada and headquartered in Washington state.

7 On its website, Defendant provides a catalog of available  
8 photographs. The website's users can purchase a license to use those  
9 photographs. Plaintiffs allege that their photographs and names are  
10 included in this online catalog.

11 As part of its licensing agreement, Defendant notifies its  
12 licensees that they are only licensing the copyright to use the image,  
13 and that they may have to obtain the additional rights in order to  
14 display and use the images. Defendant's agreement specifically notes  
15 that licensees may have to obtain licenses to use the photo subjects'  
16 rights of publicity.

17 The essence of Plaintiffs' claim, however, is not that Defendant's  
18 users are infringing on Plaintiffs' publicity rights. Plaintiffs are  
19 claiming that *Defendant itself* is infringing on Plaintiffs' rights by  
20 providing a searchable catalog of its photo database.<sup>1</sup> This catalog  
21 connects Plaintiffs' names and images to the underlying product offered  
22 by Defendant (copyright licenses). Defendant's use of the names and  
23 images helps Defendant sell its photo copyright licenses to its users.

24 ///

25  
26 \_\_\_\_\_  
27 <sup>1</sup>Because Plaintiffs' claims relate to Defendant's use of Plaintiffs'  
28 names, likenesses, and images, the Court DENIES Defendant's request  
that the Court take judicial notice of the contents of its website.  
Defendant's user agreements are irrelevant to the issues at hand.

1 In this Motion, Defendant asserts three arguments: first, that the  
2 Copyright Act expressly preempts Plaintiffs' state law claims; second,  
3 that the Copyright Act preempts Plaintiffs' state law claims through  
4 application of conflict preemption; and third, that Defendant's uses of  
5 Plaintiffs' names, personas, and likenesses are "incidental" to  
6 Defendant's lawful uses of its copyrights.

7  
8 **III. LEGAL STANDARDS**

9  
10 **A. MOTION TO DISMISS**

11 The plaintiff's complaint "must contain sufficient factual matter,  
12 accepted as true, to 'state a claim to relief that is plausible on its  
13 face.'" Ashcroft v. Iqbal, \_\_ U.S. \_\_, 129 S.Ct. 1937, 1949 (2009)  
14 (quoting Bell Atlantic Corp. v. Twombly, 550 U.S. 544 (2007)). "A  
15 claim has facial plausibility when the plaintiff pleads factual content  
16 that allows the court to draw the reasonable inference that the  
17 defendant is liable for the misconduct alleged." Id. A complaint that  
18 offers mere "labels and conclusions" or "a formulaic recitation of the  
19 elements of a cause of action will not do." Id.; see also Moss v. U.S.  
20 Secret Service, 572 F.3d 962, 969 (9th Cir. 2009) (citing Iqbal, 129  
21 S.Ct. at 1951).

22 **B. RIGHTS ASSERTED BY PLAINTIFFS**

23 "California has long recognized a common law right of privacy for  
24 protection of a person's name and likeness against appropriation by  
25 others for their advantage. To sustain a common law cause of action  
26 for commercial misappropriation, a plaintiff must prove: (1) the  
27 defendant's use of the plaintiff's identity; (2) the appropriation of  
28

1 plaintiff's name or likeness to defendant's advantage, commercially or  
2 otherwise; (3) lack of consent; and (4) resulting injury. Downing v.  
3 Abercrombie & Fitch, 265 F.3d 994, 1001 (9th Cir. 2001) (citing  
4 Eastwood v. Super. Ct., 149 Cal. App. 3d 409, 416-17 (1983)) (internal  
5 quotations omitted).

6 "In addition to the common law cause of action, California has  
7 provided a statutory remedy for commercial misappropriation under  
8 California Civil Code § 3344. The remedies provided for under  
9 California Civil Code § 3344 complement the common law cause of action;  
10 they do not replace or codify the common law. Section 3344 provides in  
11 relevant part, 'any person who knowingly uses another's name, voice,  
12 signature, photograph, or likeness, in any manner . . . for purposes of  
13 advertising . . . without such person's prior consent . . . shall be  
14 liable for any damages sustained by the person.' Under section 3344, a  
15 plaintiff must prove all the elements of the common law cause of  
16 action. In addition, the plaintiff must allege a knowing use by the  
17 defendant as well as a direct connection between the alleged use and  
18 the commercial purpose." Downing, 265 F.3d at 1001 (internal citations  
19 omitted).

20 Defendant has reserved all issues surrounding the construction of  
21 the California statutory and common law rights, and is moving solely on  
22 the ground of Copyright preemption and "incidental use." (Def.'s  
23 Motion at 17 n.3.)

24 ///

25 ///

26 ///

27 ///

28

1 **IV. ANALYSIS**

2  
3 **A. EXPRESS COPYRIGHT PREEMPTION**

4 Section 301(a) of the Copyright Act preempts "all legal and  
5 equitable rights that are equivalent to any of the exclusive rights  
6 within the general scope of copyright as specified by section 106" and  
7 "in works of authorship that . . . come within the subject matter of  
8 copyright as specified by sections 102 and 103." 17 U.S.C. § 301(a).  
9 Section 301(b) clarifies that "Nothing in this title annuls or limits  
10 any rights or remedies under the common law or statutes of any State  
11 with respect to . . . subject matter that does not come within the  
12 subject matter of copyright as specified by sections 102 and 103." Id.  
13 at § 301(b). Congress has explained that "[t]he intention of section  
14 301 is to preempt and abolish any rights under the common law or  
15 statutes of a State that are equivalent to copyright and that extend to  
16 works within the scope of the Federal copyright law." Laws v. Sony  
17 Music Ent., Inc., 448 F.3d 1134, 1137 (9th Cir. 2006) (quoting H.R.  
18 Rep. No. 94-1476, at 130 (1976)).

19 The Ninth Circuit applies a two-part test to determine whether a  
20 state law claim is preempted by § 301 of the Copyright Act:

21 We must first determine whether the "subject matter" of the state  
22 law claim falls within the subject matter of copyright as  
23 described in 17 U.S.C. §§ 102 and 103. Second, assuming that it  
24 does, we must determine whether the rights asserted under state  
25 law are equivalent to the rights contained in 17 U.S.C. § 106,  
26 which articulates the exclusive rights of copyright holders.

27 ///

1 Id. at 1137-38 (internal footnotes omitted) (citing Downing v.  
2 Abercrombie & Fitch, 265 F.3d 994, 1003 (9th Cir. 2001)). Both prongs  
3 of this test must be satisfied in order for the state-law claim to be  
4 preempted. Downing, 265 F.3d at 1003.

5 Applying this two-part test to Plaintiffs' claims, it is clear  
6 that the rights asserted by Plaintiffs are not preempted. Simply put,  
7 Plaintiffs' rights do not fall within the subject matter of copyright.  
8 In light of that conclusion, Plaintiffs' rights cannot be equivalent to  
9 the rights contained in 17 U.S.C. § 106. See Downing, 265 F.3d at 1005  
10 ("Because the subject matter of the Appellants' statutory and common  
11 law right of publicity claims is their names and likenesses, which are  
12 not copyrightable, the claims are not equivalent to the exclusive  
13 rights contained in § 106.").

14 A situation similar to the present case occurred in Downing.  
15 Abercrombie purchased a photograph of appellant surfers at a 1965  
16 surfing competition from a photographer, who owned the copyright. Id.  
17 at 1000. Abercrombie then published the photo in their catalogue, with  
18 appellants' names but without appellants' permission. Id. at 1000.  
19 The surfers filed state misappropriation claims. Id. Abercrombie  
20 argued, as Defendant does now, complete federal preemption over the  
21 state law claims. Id. at 1003. The Ninth Circuit held that the  
22 claims were not preempted because the subject matter of the publicity  
23 claims was the appellants' names and likenesses, which is not a work of  
24 authorship within Section 102 of the Copyright Act. Id. at 1004. The  
25 Court reasoned that while the photograph falls within copyright subject  
26 matter, "it is not the publication of the photograph itself, as a  
27 creative work of authorship, that is the basis for Appellants' claims,  
28

1 but rather, it is the use of the Appellants' likenesses and their names  
2 pictured in the published photograph." Id. at 1003. The subject  
3 matter of a right to publicity claim is "the very identity or persona  
4 of the plaintiff as a human being." Id. at 1004 (citing McCarthy,  
5 Rights of Publicity and Privacy §11.13[C] at 11-72-73 (1997)). The  
6 subject matter of a right to publicity claim, the name or likeness,  
7 "does not become a work of authorship simply because it is embodied in  
8 a copyrightable work." Id. at 1003-4 (citing Nimmer on Copyright  
9 §1.01[B][1][c] at 1-23 (1999)).

10 Downing approved of the California Court of Appeal's decision in  
11 KNB Enterprises v. Matthews, 78 Cal. App. 4th 362 (2000). Downing, 265  
12 F.3d at 1005. In KNB, the defendant copied erotic photographs from the  
13 internet and, without authorization of the individuals depicted in the  
14 photos, posted them on his own commercial website. KNB, 78 Cal. App.  
15 4th at 366. The court determined that preemption did not apply  
16 "because a human likeness is not copyrightable, even if captured in a  
17 copyrighted photograph." Id. at 365.

18 The present case falls directly within the ambit of Downing, and  
19 Defendant fails to distinguish Downing. Downing is therefore  
20 controlling.

21 In applying Downing to the present case, it is clear that this  
22 case is distinguishable from Fleet v. CBS, 50 Cal. App. 4th 1911, 1919  
23 (1996) and Laws v. Sony Music Ent., Inc., 448 F.3d 1134, 1138-43 (9th  
24 Cir. 2006). Both of those cases involved publicity claims arising out  
25 of the claimant's *copyrightable* (and, in fact, *copyrighted*) performance  
26 in a copyrighted work. Fleet involved actors who had performed in a  
27 film – that is, a "dramatic work" "fixed in a tangible medium of  
28

1 expression" within the meaning of the Copyright Act. Laws involved a  
2 singer who had performed in a music recording – that is, a "sound  
3 recording" "fixed in a tangible medium of expression" within the  
4 meaning of the Copyright Act. See Laws, 448 F.3d at 1142-43 ("Laws  
5 does not dispute Sony' [s] contention that [her] recording of [the song]  
6 'Very Special' was a copyrighted sound recording fixed in a tangible  
7 medium of expression. . . . [T]he entirety of the allegedly  
8 misappropriated vocal performance is contained within a copyrighted  
9 medium.");<sup>2</sup> Fleet, 50 Cal. App. 4th 1911, 1919 ("We agree that as a  
10 general proposition section 3344 is intended to protect rights which  
11 cannot be copyrighted and that claims made under its provisions are  
12 usually not preempted. But appellants' analysis crumbles in the face  
13 of one obvious fact: their individual performances in the film White  
14 Dragon were copyrightable. Since their section 3344 claims seeks only  
15 to prevent CBS from reproducing and distributing their performances in  
16 the film, their claims must be preempted by federal copyright law.").

17 Here, in contrast to Laws and Fleet, the object that is "fixed in  
18 a tangible medium of expression" is the physical likeness and persona  
19 of the Plaintiffs. Name, likeness, and persona are not copyrightable  
20 subject matter, both under the Copyright Act and the Copyright Clause  
21

---

22  
23 <sup>2</sup>In distinguishing Downing, the Laws court discussed Downing as  
24 involving a "suggest[ion] that the surfers had endorsed Abercrombie's  
25 t-shirts." Laws, 448 F.3d at 1141. The Laws court's dictum does not  
26 override the substantive reasoning employed by the Downing court. To  
27 the extent that Laws attempted to reinterpret Downing as a false  
28 endorsement claim, Laws is not controlling here. The principle of  
stare decisis requires this Court to apply the reasoning and holding  
of Downing, which is directly on point.

The Court believes that the present case "is squarely controlled  
by the surfers' case [Downing] and not the singer's [Laws]." Bonner  
v. Fuji Film, No. C 06-4374 (N.D. Cal. Nov. 13, 2006).



1 of the Constitution. A name, likeness, or persona is not a work of  
2 "authorship" entitled to copyright protection. See Downing, 265 F.3d  
3 at 1003-05; see also Toney v. L'Oreal USA, Inc., 406 F.3d 905 (7th Cir.  
4 2005) (holding no preemption where photo model asserted right of  
5 publicity claim against photo copyright holder); Brown v. ACMI Pop  
6 Div., 873 N.E. 2d 954, 962-63 (Ill. App. 2007) (holding that right of  
7 publicity claim under Illinois law regarding Corbis's display of photos  
8 on its webpage in connection with sale of licenses was not preempted by  
9 Copyright Act). Therefore, Plaintiffs' claims are not preempted by the  
10 Copyright Act.

11 **B. CONFLICT PREEMPTION**

12 Defendant argues that, even if Plaintiffs' claims are not  
13 encompassed within the express preemption provision of 17 U.S.C. §  
14 301(a), the principles of conflict preemption require this Court to  
15 dismiss Plaintiffs' claims.

16 Conflict preemption prevents an application of state law that  
17 "stands as an obstacle to the accomplishment of the full purposes and  
18 objectives of Congress." Hines v. Davidowitz, 312 U.S. 52, 67 (1941).  
19 "[W]hen state law touches upon the area of federal statutes enacted  
20 pursuant to constitutional authority, 'it is "familiar doctrine" that  
21 the federal policy "may not be set at naught, or its benefits denied"  
22 by the state law.'" Kewanee Oil v. Bicron Corp., 416 U.S. 470, 479-80  
23 (1974) (quoting Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 229  
24 (1964)).

25 ///

26 ///

27 ///

1 Defendant's argument overlooks the fact that the two-part § 301(a)  
2 express preemption test is the exclusive source of Copyright  
3 preemption. Section 301(b) provides that:

4 Nothing in this title annuls or limits any rights or remedies  
5 under the common law or statutes of any State with respect to--

6 (1) subject matter that does not come within the subject  
7 matter of copyright as specified by sections 102 and 103,  
8 including works of authorship not fixed in any tangible medium of  
9 expression; or . . .

10 (3) activities violating legal or equitable rights that are  
11 not equivalent to any of the exclusive rights within the general  
12 scope of copyright as specified by section 106.

13 17 U.S.C. § 301(b) (1), (3). In other words, unless the state law is  
14 preempted by § 301(a), it is unaffected by the Copyright Act.

15 Thus, despite Defendant's rather compelling parade of horribles,<sup>3</sup>  
16 this Court is not empowered to use conflict preemption to prevent  
17 Plaintiffs from bringing their claims.

18 ///

19 ///

20 ///

---

21  
22 <sup>3</sup> Defendant asserts that a ruling in Plaintiffs' favor:  
23 would prohibit any photographer from ever displaying,  
24 reproducing or transferring (by sale and/or license) her  
25 photographs if they happened to include a human being. For  
26 example, under Plaintiffs' theory, it is not the retailer in  
27 Downing that would be precluded from using the surfers'  
28 photograph, it is the photographer who would be precluded from  
selling the photo to anyone - simply because it had a person's  
image in it. The ramification of Plaintiffs' claims is that any  
display and license of a photograph in which they - or any human  
being - appears violates the right of publicity. (Mot. at 14.)

1           **C.     FIRST AMENDMENT-PROTECTED USE**

2           Defendant's final argument is that its use of Plaintiffs' names,  
3 images, and likenesses is "incidental" to its lawful sale of copyright  
4 licenses. Defendant cites to caselaw establishing that First  
5 Amendment-protected speech cannot be actionable under the common law  
6 and statutory rights of publicity. (See Def.'s Mot. at 19-21) (citing  
7 Cher v. Forum Intern., Ltd., 692 F.2d 634, 639 (9th Cir. 1982) (right  
8 of publicity claim regarding use of likeness in advertising magazine to  
9 potential subscribers, in which magazine had previously published  
10 article about claimant: "[The magazine] would have been entitled to use  
11 Cher's picture and to refer to her truthfully in subscription  
12 advertising for the purpose of indicating the content of the  
13 publication because such usage is protected by the First Amendment.");  
14 William O'Neil & Co., Inc. v. Validea.com Inc., 202 F. Supp. 2d 1113,  
15 1119 (C.D. Cal. 2002) (right of publicity claim regarding book  
16 containing discussion of financial analysts: "*The Market Gurus* is a  
17 book that analyzes the investment strategies of well-known financial  
18 analysts and stock pickers. It does not 'propose a commercial  
19 transaction' and is therefore not commercial speech. Because it is not  
20 commercial speech, the book is entitled to the full panoply of First  
21 Amendment protections."); Page v. Something Weird Video, 960 F. Supp.  
22 1438 (C.D. Cal. 1996) (right of publicity claim regarding movie  
23 advertisements: "Motion pictures and films generally enjoy. . . .  
24 First Amendment protection."); Gionfriddo v. Major League Baseball, 94  
25 Cal. App. 4th 400, 412 (2001) (right of publicity claim regarding use  
26 of baseball players' names and statistics in game programs, websites,  
27 and video clips: "In the uses challenged, Baseball is simply making  
28

1 historical facts available to the public through game programs, Web  
2 sites and video clips. The recitation and discussion of factual data  
3 concerning the athletic performance of these plaintiffs command a  
4 substantial public interest, and, therefore, is a form of expression  
5 due substantial constitutional protection."); Montana v. San Jose  
6 Mercury News, Inc., 34 Cal. App. 4th 790, 795 (1995) (right of  
7 publicity claim regarding posters that reprinted pages from newspaper:  
8 "When Joe Montana led his team to four Super Bowl championships in a  
9 single decade, it was clearly a newsworthy event. Posters portraying  
10 the 49'ers' victories are . . . [a] 'form of public interest  
11 presentation to which protection must be extended.'"))).

12 Defendant argues that its display of Plaintiffs' likenesses is  
13 "incidental to copyright licensing activity that is itself protected."  
14 Defendant's argument confuses *First Amendment*-protected activities and  
15 *copyright*-protected activities. Defendant attempts to draw on First  
16 Amendment caselaw without even arguing that its own uses are protected  
17 by the First Amendment. Instead of arguing that its uses are protected  
18 by the First Amendment, Defendant argues that its use of its copyrights  
19 is a "lawful use." This argument is simply another way of phrasing its  
20 Copyright preemption arguments. Defendant's argument is not well  
21 taken.

22 In any event, Plaintiffs appear to have alleged that Defendant's  
23 uses of Plaintiffs' images, names, and likenesses are not protected by  
24 the First Amendment.<sup>4</sup> Plaintiffs allege that Defendant's use "is not  
25 connected with any news, public affairs, sports broadcast or account,  
26

---

27 <sup>4</sup>Whether intentional or not, Defendant has placed First Amendment  
28 protection at issue by citing to First Amendment caselaw and drawing  
on First Amendment principles.

1 or any political campaign." (Compl. ¶ 24.) Defendant's use is  
2 therefore not protected by the First Amendment. See Downing, 265 F.3d  
3 at 1002.

4  
5 **IV. CONCLUSION**

6  
7 For the reasons stated, the Court DENIES Defendant's Motion to  
8 Dismiss.

9  
10  
11  
12  
13  
14  
15 IT IS SO ORDERED.

16  
17  
18 DATED: October 27, 2009



19  
20  
21  
22  
23  
24  
25  
26  
27  
28  
STEPHEN V. WILSON

UNITED STATES DISTRICT JUDGE