

**IN THE CIRCUIT COURT OF COOK COUNTY, ILLINOIS
COUNTY DEPARTMENT, LAW DIVISION**

**JAMES BROWN THE NEW JAMES)
BROWN ENTERPRISES, INC. and)
JESUS MUHAMMAD-ALI,)**

Plaintiffs,)

v.)

No. 02 L 005872

**ACMI POP DIVISION, a division of)
CONQUEST OPERATOR SERVICES)
CORPORATION, CONQUEST LONG)
DISTANCE, B & L LICENSE INC.,)
DOLLAR BILL WALLER, ZERO)
HOUR RECORDS, FRANK CICERO)
d/b/a GLOBE POSTERS and CORBIS)
CORPORATION,)**

Defendants.

**PLAINTIFFS' MOTION TO RECONSIDER THE § 2-619 DISMISSAL OF
DEFENDANT CORBIS CORPORATION**

NOW COME Plaintiffs, JAMES BROWN, THE NEW JAMES BROWN ENTERPRISES, INC., (“BROWN ENTERPRISES”) and JESUS MUHAMMAD-ALI, (“ALI”) by and through their attorneys, GOLD & COULSON, a partnership of professional and limited liability corporations, and JAY B. ROSS & ASSOCIATES P.C., and allege as follows with respect to the above matter:

INTRODUCTION

Defendant Corbis sells over the internet photos of singer James Brown; including sales to known commercial users of the photographs and no doubt sales to fans and collectors. Brown did not approve or authorize either the photographs or their sale by Defendant. Brown sells his own photographs to fans. By Order and Memorandum released September 8, 2003, this Court denied

Defendant Corbis Corporation's §2-615 Motion to Dismiss Counts III and IV (common law and statutory right of publicity, 765 ILCS 1075/1 et seq.), finding that "...the allegations contained in the Complaint support a cause of action based on the common law right of publicity and the act".

However, the Court granted Defendant Corbis' §2-619 Motion, concluding that "...Corbis' actions are non-commercial" because it "...can claim an exemption under the First Amendment"; and that Plaintiff James Brown's claims are in any event pre-empted by the federal Copyright Act.

This Motion to Reconsider is being filed pursuant to the schedule set by this Court on September 8, 2003.

Plaintiff submits, respectfully (1) that James Brown has no copyright interests in Corbis' photos of him, so his claim against Corbis cannot be pre-empted; (2) that this Court acknowledged that Defendant Corbis knowingly sells Brown's photos to pure commercial users, so no First Amendment protection can be claimed; and (3) that the facts about Corbis' actual sales and customers are uniquely within its possession, so it is unfair to grant a § 2-619 Motion prior to discovery and to merely accept Corbis' self-serving assertion that it sells mainly to newspapers, and its legally unsupported assertion that it can assume the First Amendment privilege of its customers.

Plaintiff asks this Court to vacate its §2-619 dismissal, and permit discovery to commence.

THERE CAN BE NO COPYRIGHT PRE-EMPTION

Defendant Corbis conceded this point in its moving papers, and in oral argument in open court.

Corbis' Motion to Dismiss asserted only that "the Plaintiffs' claims against Corbis fail because Corbis' use of Brown's image is not a 'commercial' use under either Illinois common law or the Act" (Defendant's Memo p. 2). Defendant made not one mention of copyright pre-emption.

To the contrary, Defendant’s memo emphasized how Corbis warns its buyers “...that its license for an image does not include any rights of publicity.” (Id. p.5). Corbis’ Motion expressly recited what Corbis called “a general tutorial” to the right of publicity which it gives to buyers, and “...repeatedly educates clients not to use images of people for commercial purposes without their consent.” (Id. p. 6). Obviously, if Corbis’ alleged “copyright” rights in the photos pre-empted Brown’s right of publicity, then Corbis would not have to warn its customers about Brown’s (and the others’) right of publicity. Corbis’ *silence* on pre-emption, and its *insistence* to its customers that the persons photographed still have a right to publicity, must doom any pre-emption argument¹. And Corbis’ lengthy Reply brief likewise never mentioned or hinted at pre-emption. Indeed, in its Reply brief Defendant Corbis stated: “However, the rights associated with the right of publicity are different and separate from the rights associated with a copyright” (Defendant’s Reply, p. 4).

Also, Defendant conceded that “Brown does not purport to own the copyrights in any of the images at issue...(Id.) Corbis argued that “...its licensing of the copyright it owns or represents in the photographs of James Brown does not violate his right of publicity and is protected activity under the First Amendment” (Id. 2-3). Corbis stated, again, that “...Corbis advises its customers that they are required to obtain a separate license from the owner of the right of publicity - here James Brown” (Id. 2).² Again, Corbis uttered not one syllable in its Reply claiming copyright pre-emption of Brown’s claim against it. And Corbis, on its website and in this Court, repeatedly emphasized

¹ By not raising pre-emption in its moving papers, Corbis actually waived the argument. Corbis and its quite distinguished counsel would have raised the issue if it had any merit.

² Said Corbis at argument:

Corbis tells the user if an image depicts a person, many states and countries have a right of publicity law that requires the user to obtain permission from the person depicted before they use the image in certain ways. (Tr. April 25, pp. 22-23)

the important distinctions between copyright and Brown's right of publicity. And Plaintiff Brown never had an opportunity to brief pre-emption.

The Copyright Act's pre-emption (17 USC § 301) can operate to bar a Plaintiff's state claims (a) for which the Plaintiff can sue in copyright, or (b) for which the copyright act precludes any claims by Plaintiff - such as a work's being in the copyright public domain. It is well-settled that §301 of the Copyright Act does *not* generally pre-empt state law 'right-of-publicity claims. *Baltimore Orioles, infra*, at 678 n. 26; "Congress intended that the evolving common law rights of 'privacy,' 'publicity', and trade secrets ...would remain unaffected" so long as such claims remain different in kind from copyright infringement. The Seventh Circuit noted that "...the right of publicity protects against the unauthorized exploitation of names, likeness, personalities, and performances that have acquired value for the very reason that they are known to the public", (Id), citing *Zacchini v. Scripps-Howard*, 433 US 562 (1977). *Baltimore Orioles, Inc., v. Major League Baseball Players Association*, 805 F.2d 663 (7th Cir. 1986), cited by this Court, fleshed out pre-emption doctrine, and dooms its application to James Brown's claims against Corbis. In *Orioles*, the Court held that the broadcast rights to baseball games were copyrightable when videotaped; that the team owners owned the copyrights, which were a "work-for-hire" made by the employee baseball players; and that the players' right-of-publicity claim was thus pre-empted by §301 of the Federal Copyright Act. Said the Seventh Circuit: "The 'work for hire' doctrine grants the clubs as employers exclusive rights in the telecasts of the games against the players as employees" (Id. at p 679). The players, by performing as employees to create the broadcast, vested the copyright ownership in the team owners, not in themselves.

The case at bar is quite different. Here, James Brown does not claim any copyright interests

in the photographs of him that Corbis is selling. James Brown did not make the photos nor authorize their making. So James Brown does not have any copyright claim against Corbis (nor against anyone else) based on the photos. And James Brown did not produce the photos for Corbis as “works-for-hire”, or otherwise cause Corbis to acquire the photos. At the threshold then, for James Brown’s claim to possibly be pre-empted, by copyright, the claim must entail a fixed work *which Brown authorized*. In the case at bar both sides agree that Brown did not authorize either the creation or sale of the photos. This Court’s observation that Corbis is “simply licensing its own legal copyright interest in the image at issue” is literally true, but irrelevant to Brown’s claim. If a copyright or licensing lawsuit were brought by the photographer (who claimed authorship) against Corbis; or by Corbis against one of its buyer “sub-licenses”, then copyright questions might be in issue. Not here.

This Court found that the Corbis photos are “fixed in tangible form and come within the subject matter of copyright”. But this Court overlooked a key element of the Copyright Act’s definition of “fixed in a tangible form”. The work must be “fixed in a tangible form” *by or under the authority of the author*, see 17 USC §101, *Baltimore Orioles*, p. 675. *Toney v. L’Oreal USA Inc.*, 2002 WL 31455975 (N.D. Ill), cited by this Court in its opinion, confirms this. “A work is fixed if a plaintiff has consented to it.” *Toney* p. 2; citing *Ahn v. Midway Mfg. Co.*, 965 F.Supp. 1134, 1138 (N.D. Ill. 1997). Here, Plaintiff James Brown did not authorize the photos. They were not fixed in tangible form by the party suing (Brown). Moreover, Brown’s claim against Corbis is not “equivalent” to any copyright claim. Indeed, Defendant Corbis has conceded that a publicity claim is “different and separate” (Defendant’s Reply, p. 4; and discussion *infra*). Brown has no copyright claim against Corbis, or the photographers over the photos. It is Corbis’ unauthorized selling of his

image that guides Brown's claim.

This Court's opinion seemed to commingle, on the one hand, the photographer's copyright interest in a photo and Corbis' copyright interest in "licensing" that photo to customers, with, on the other hand, Plaintiff Brown's non-existent copyright interest in the photos.

The paparazzi who took Brown's photos at his concerts and elsewhere, may well "copyright"³ his photos, and he may "license" the photos to Defendant Corbis for sale. Corbis may in turn "license" the photo to its buyers. The photographer would indeed be the copyright "author" of the works, which indeed is fixed in a tangible form. We need express no opinion on the viability of these arrangements. But these arrangements are flatly irrelevant to James Brown's right of publicity. And they are irrelevant to this lawsuit, which is between Brown and Defendant Corbis, not between Corbis and any photographer.

James Brown did not authorize the photos or their sale; a fact which is undisputed on this record. So Brown is not the "author" of the work - the photographs. He is not suing Corbis over any authorized work fixed in a tangible form. He is suing to protect his right of publicity - an intangible right he has taken years to envalue.

The Illinois statute expressly provides that "a person may not use an individual's identity for commercial purposes during the individual's lifetime without having obtained previous written consent..."

So neither prong of the *Baltimore Orioles* pre-emption test is met here. There is no authorized work fixed in a tangible form at issue. And Brown's right of publicity is not equivalent

³ One can "copyright" a creation by marking it with a copyright notice (although this is no longer *required*), and/or by filing a registration with the copyright office (required only before suing for infringement.) 17 USC § 401, 408, 411.

to any relevant copyright - because he has no copyright at stake. *Zacchini v. Scripps-Howard, Baltimore Orioles*, illustrates this reality. *Zacchini* performed a live human cannonball act. A television station taped his act, and played it on the news. Despite § 301, said the Seventh Circuit, *Zacchini* could “sue successfully for violation of his right of publicity” *Id* at 675. The television station’s tape was not authorized by *Zacchini*. If *Zacchini* had recorded his act, and the television station then televised the tape without his authority, then *Zacchini* would prevail on a copyright claim, and any right-to-publicity claim only then would be pre-empted. So here, if James Brown had created or authorized the photographs that Corbis sells without his permission, then Brown would have a copyright infringement claim only. Notably, this *Zacchini* analysis also accorded *no* First Amendment immunity to the television station. Indeed, this Court noted in its opinion that “Corbis advises its users that the rights of publicity are independent from those rights purchased under the licensing agreement”. Brown’s publicity right is independent from, and not equivalent to, any copyright issue.

Under the agreed facts of this record, there simply cannot be any copyright pre-emption of Brown’s publicity claim. Defendant’s counsel acknowledged this during oral argument on the Motion, when he said of pre-emption: “But for purposes of this Motion that’s not an issue.” (Transcript, April 25, p. 17)

**THE RECORD IS UNDISPUTED THAT CORBIS MAKES “COMMERCIAL USE”
OF BROWN’S IMAGE**

The Right of Publicity Act expressly does not apply to:

“(2) use of an individual’s identity for non-commercial purposes, including any news, public affairs, or sports broadcast or account, or any political campaign;” 765 ILCS §1075/35.

This Court found that “...Corbis is not a commercial entity...because it can claim an

exemption under the First Amendment”. Opinion p. 3. Corbis, wrote this Court, functions merely as a “vehicle of information”, “performing a valuable public service” of “disseminating images to the public”. *Id.* But Corbis is not a newspaper. And selling photos on the internet is legally the same as selling them in a store; the use of the internet provides no special privileges.

Such a broad loophole- disseminating images to the public - could vitiate too many internet right-of-publicity claims. It would become an exception which swallows the rule. Photographs of James Brown are bought by fans and collectors. These photos are “merchandise”, just like coffee mugs, t-shirts, and phone cards. Brown has the statutory right to control such sales of his image. *See*, 765 ILCS §1075/5,10

Corbis conceded that it makes sales to commercial users.

Notably, this Court also found that “...Corbis can license Brown’s image to a third-party whom they know will put it to commercial use without Brown’s permission”. *Id.* p. 4. And indeed, Corbis has admitted that it charges such a known commercial users a higher “license fee”.⁴ This Court conceded that it “had difficulty” with this aspect of the case. *Id.*

Because we have had no discovery from Defendant Corbis, we do not know how many of their sales of James Brown’s photos have been to such known commercial users. We do not know (nor can the Court know) how many, if any, sales have been to legitimate news publications. We do not know how many sales of Brown’s photos were to fans or collectors. All we have is the self-serving affidavits of Defendant’s principals, as to their sales process. That exemplifies the unfairness of granting a §2-619 dismissal, before any discovery, when the operative details (like the identity of Corbis buyers) are uniquely within the possession and knowledge of the Defendant. If

⁴ See, e.g. transcript, April 25, pp. 23-24.

anything, this Court should hold this lack of specificity against Corbis' position.

But the record is nonetheless undisputed that Corbis does make knowingly commercial use sales of Brown's image, and that Corbis charges more for such sales.⁵ This fact, by itself, should be enough to deny the §2-619 Motion. Subsequent discovery can reveal the extent, if any, to which Corbis makes sales to legitimate newspapers, etc. A §2-619 Motion admits Plaintiff's pleading, and puts a burden on the Defendant to assert "...affirmative matter avoiding" the claim. On this record, we submit, a factual conclusion that all of Defendant's sales are "non-commercial" is unwarranted and unwise.

Corbis is not a newspaper.

Even as to any alleged non-commercial (First Amendment) buyers, the record does not support Corbis. Corbis, says the Opinion, advises its users "of the need to obtain permission from the owner of the right of publicity before putting the image to commercial use." (Opinion p.4) This fact, as noted above, constitutes Corbis' concession that Brown's right of publicity claim is not pre-empted by copyright, but rather a separate still-existing right. But containing such a "disclaimer" is a hollow and cynical gesture. It's like Napster telling its internet "song-sharers" that they must of course agree not to share songs in any manner that violates the Copyright Act! It's like a drug dealer telling his marijuana buyers that - they must of course agree to use the marijuana only for medical purposes. Wink...wink! The point is, the bona fides of such a practice, and the actual identity of buyers and their use of Brown's image must all be tested by discovery. The law looks to conduct, more than mere self-serving words, in determining facts.

⁵ Corbis' counsel stated to this Court: "the commercial users are someone who would want to use the picture on or in a product." (Transcript, April 25th; p. 17). But they could also include fans and collectors.

Corbis is not a newspaper or television station. A newspaper has some First Amendment privilege from rights of publicity claims based on use of a celebrities' photograph. The Illinois statute expressly excludes from liability the "use of an individual's identity for non-commercial purposes, including any news, public affairs, or sports broadcast or account..." 735 ILCS §1075-35(b)(2). But is far from clear that a similar privilege attaches to a company like Corbis when it sells a celebrity photo to a newspaper or television station, for a profit. In doing so Corbis is not engaged in the "use" of Brown's image for "news" or "public affairs". Corbis is more like a newsprint or ink supplier; it is providing the newspaper with tools for the newspaper to "use" in the newspaper's privileged business.

And the case law tells us that even a newspaper could be liable - depending upon what precise use it makes of the photo. The newspaper's use of the image for news or feature reporting presumably would be protected; whereas the newspaper's use of the image on a coffee mug, t-shirt, or collectable photo collection would not be protected. *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790, 40 Cal. Rptr 2d 639 (6th Court of Appeal, 1995).

We will briefly review the cases cited in the Opinion. Both *Montana v. San Jose Mercury News, Inc.*, supra. and *Berkos v. NBC*, supra, cited in this Court's Opinion, were suits brought directly against the media. "Right of publicity/privacy" claims thus ran headlong into the First Amendment. In *Berkos*, our Appellate Court noted that "a commercial appropriation claim cannot be stated where a plaintiff's name or likeness has been used as part of 'vehicle of information', such as the news media." *Berkos* 161 Ill.App.3d at 495; 515 N.E. 2d at 679. But Defendant Corbis has not demonstrated that *any* of its customers, including supposed but unidentified media customers, used the photos as part of a "vehicle of information". At most, all Corbis has submitted is the

conclusory statement that it sells Brown's photo to the media, and that its buyers must promise not to mis-use them! Even assuming Corbis' dubious premise that it stands in the shoes of its buyers, that is a far cry from Corbis' showing, as it must, that *every* buyer in fact "used" the photos as part of a "vehicle of information. *Douglas v. Hustler Magazine*, 769 F.2d 1128 (7th Cir. 1985) was also a suit directly against a magazine. But the Seventh Circuit upheld her common law "right of publicity" claim under Illinois law (the suit was brought before the statute was enacted). The Court looked at the *specific use* of Douglas' photos made by the magazine. *Hustler Magazine* was not protected by the First Amendment, because Hustler "cannot use photographs made by others for commercial purposes", *Id* at 1138, although Hustler was free to "run a story" on her and use photographs that are in the public domain or that it can buy". So *Douglas* hardly supports Corbis in this case. *Stern v. Delphi Internet Services Corporation*, 165 Misc. 2d 21, 626 NYS 2d 694 (1995), a trial court opinion, involved an "electronic bulletin board" for a Gubernatorial election - an obvious matter of First Amendment significance. Defendant was, in effect, an internet newspaper, which disseminated "hard information, such as news stories..." *Stern* at 22, 695. Defendant was held to be "analogous to that of a news vendor or bookstore", for First Amendment purposes. *Id*. And the Court concluded that Defendant "used the Stern photograph to communicate to the public...the promotion of a news event." *Id*. at 30,700. So the specific use made of the photograph was crucial to the resolution of the issue.

So even under Corbis' dubious claim that it benefits from any privilege its buyer of the image may have; the inquiry is a fact-based one. How did the buying newspaper or television station utilize the image that Corbis sold? If Corbis doesn't know, doesn't care, and doesn't follow-up with each customer, it is hardly in the position to cloak itself in that customer's "privilege".

In discovery, Plaintiff is entitled to identify the customers who bought Brown's photos. Corbis' failure to present this evidence to the Court raises a presumption that the evidence is not favorable to Corbis. The information is uniquely in Corbis' possession; there has been no discovery in this case, and it is Corbis' burden under §2-619 to produce "affirmative matter" establishing a blanket privilege for its conduct. Clearly, Corbis has not done so. Unlike each of the cited cases, here Corbis has conceded that it sells Brown's picture, without his consent, to known commercial users. And even as to the alleged media customers, Corbis has failed to identify them with specificity and has failed to identify what use the media buyers actually made of the photos. And these questions assume (without conceding) that Corbis has any right to stand in the First Amendment shoes of its media buyers (if any).

But it suffices at this stage of the litigation, on Defendant's §2-619 Motion raising its "affirmative matter", that there are knowing commercial sales by Corbis of James Brown's image. The First Amendment does not protect these transactions. Whether it protects Corbis's other sales or not must await discovery.

THE §2-619 DISMISSAL MUST BE VACATED

There can be no copyright pre-emption of James Brown's right-of-publicity claim; Defendant Corbis concedes as much.

The record is undisputed that Corbis engages in known commercial sales, and that it profits more from these sales. And Corbis has failed to establish its entitlement to a blanket privilege, even for sales if any, to newspapers and telecasts.

James Brown has built his image over many, many years. He is certainly entitled to proceed into discovery on his claims.

The §2-619 dismissal should be vacated.

Respectfully submitted,

By: _____
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