

**UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

APPEAL NO. 11-56082

**SHIRLEY JONES, on Behalf of
herself and All Others Similarly Situated**

Plaintiff-Appellant

v.

CORBIS CORPORATION,

Defendant-Appellee.

**On Appeal from the United States
District Court for the Central District of California, Eastern District
Case No. 10-cv-08668-SVW**

APPELLANT'S REPLY BRIEF

Arthur S. Gold
GOLD & COULSON
11 S. LaSalle Street
Suite 2402
Chicago, IL 60603
(312) 372-0777
(312) 372-0778 Facsimile

| TABLE OF CONTENTS | PAGE |
|--|------|
| I. THE DISTRICT COURT ERRED IN GRANTING SUMMARY JUDGMENT BECAUSE MATERIAL ISSUES OF FACT EXIST AS TO WHETHER PLAINTIFF CONSENTED TO CORBIS' COMMERCIAL EXPLOITATION OF HER IMAGE. | 1 |
| II. PLAINTIFF'S CLAIMS ARE NOT PREEMPTED BY FEDERAL COPYRIGHT LAW. | 3 |
| a. Plaintiff's claims are not expressly preempted as <i>they are not</i> "within the subject matter of copyright" | 9 |
| b. Plaintiff's claims are not expressly preempted as they are not "equivalent" to any exclusive rights of a Federal Copyright. | 11 |
| III. CORBIS POSSESSES NO FIRST AMENDMENT OR PUBLIC INTEREST EXEMPTION: CORBIS IS NOT A NEWSPAPER AND NOT THE MEDIA. | 14 |
| IV. CONCLUSION..... | 16 |
| STATEMENT OF RELATED CASES..... | 18 |
| CERTIFICATE OF CONFORMITY..... | 18 |

TABLE OF AUTHORITIES

CASES

Baltimore Orioles, Inc. v. Major League Baseball Players Assoc.,
 805 F.2d 663, 678 (7th Cir. 1986) 6,10

Brown v. Ames,
 201 F.3d 654, 658 (5th Cir. 2001) 4

Comedy III Productions, Inc. v. Gary Saderup Inc.
 25 Cal. 4th 387, 21 P.3d 797 (2001) 4

Douglas v. Hustler Magazine,
 769 F.2d 1128 (7th Cir. 1985) 15,16

Downing v. Abercrombie & Fitch,
 265 F.3d 994, 1004 (9th Cir. 2001) 9

Facenda v. NFL Films Inc.,
 542 F.3d 1007 (3rd Cir. 2008) 10

Fleet v. CBS, Inc.,
 50 Cal. App. 4th 1911 (2000) 10, 14

Gionfriddo v. Major League Baseball,
 94 Cal. 3rd 860 (1979)..... 16

KNB Enters. v. Matthews,
 78 Cal. App.4th 362, 365 (2000)..... 3,14

Laws v. Sony Music Entm’t, Inc.,
 488 F.3d 1134, 1137-38 (9th Cir. 2008) 9

Montana v. San Jose Mercury News, Inc.,
 34 Cal. App. 4th 790 (1995) 16

Salestrap America, LLC v. Zyskowski,
 F.Supp.2d, 2009 WL 1652146 (D.Nev. 2009) 13

Solano v. Playgirl, Inc.,
 292 F.3d 1078, 1088 (9th Cir. 2002) 1

| | |
|---|-------|
| <i>Toney v. L’Oreal U.S.A., Inc.</i> , 406 F.3d 305, 910 (7 th Cir. 2005) | 11,13 |
| <i>Zacchini v. Scripps-Howard</i> , 433 US 562 (1977)..... | 6,8 |

STATUTES AND RULES

| | |
|------------------------------|-------|
| 17 U.S.C. § 301..... | 5,6 |
| Cal. Civ. Code § 3344..... | 4, 13 |
| Copyright Act §102..... | 9 |
| Copyright Act §103 | 9 |
| Federal Copyright §1138..... | 11 |

I. THE DISTRICT COURT ERRED IN GRANTING SUMMARY JUDGMENT BECAUSE MATERIAL ISSUES OF FACT EXIST AS TO WHETHER PLAINTIFF CONSENTED TO CORBIS' COMMERCIAL EXPLOITATION OF HER IMAGE.

Per our opening brief, under California law, a person may not exploit another's common-law or statutory rights of publicity unless the person consents to exploitation. *Solano v. Playgirl, Inc.*, 292 F.3d 1078, 1088 (9th Cir. 2002).

Contrary to defendant's contentions and the District Court's findings, there is a great deal of factual dispute regarding Shirley Jones' alleged consent to the photos in question. Whether she did in fact consent to the circulation of her photos and to what uses of them she consented are questions of fact to be determined by a jury.

The District Court found that Shirley Jones' knowledge of photographers present at a red carpet event, as a matter of law, allowed Corbis to exploit her on its websites worldwide. This finding misunderstands red carpet events. These events typically occur at award shows, movie premiers and other similar functions. The celebrities attend these events believing photographs taken will be used only to report on the event. Such is the custom of the industry. These same celebrities exploit their own photographs for profit. They do not expect the red carpet photographers to sell the pictures to outfits like Corbis so that these outfits can commercially exploit these pictures around the world and be in competition with these very celebrities!

Nevertheless, the District Court summarily ordered that red carpet appearances were a green light for Corbis to sell Plaintiff's pictures around the world for profit. This finding of implied consent as a matter of law infringes on a jury's determination of questions of fact. It obliterates the entire foundation of the jury system. Implied consent is determined by circumstances and subject matter. Reasonable minds certainly can differ.

Eloquently written is the Amici Curiae brief of SAG and AFTRA relative to Red Carpet events:

“ . . . photographs taken of Ms. Jones at the 13th Annual SAG Awards and posted for sale on Corbis' website reveals that, despite a myriad of other restrictions, Corbis has not restricted the sale or use of the images. . .

These restrictions [the restrictions placed on the photographers by the sponsors of the red carpet events] on both access to the red carpets and use of the photographs taken on the red carpets are necessary to create a safe and comfortable environment for the event's attendees and also help to ensure that the integrity of the events is not tarnished. The glitz and glamour of Hollywood red carpets are a fundamental part of movie premiers and award shows and fans around the world revel in the opportunity to view their favorite stars. But without the comfort of knowing that the environment is safe and that the photographs taken of them will be used only to report on the event and other matters of public interest, the number of celebrities, particularly those of high profile, willing to walk down red carpets would inevitably decline.”

Certainly the District Court's finding as a matter of law that Corbis may for profit, exploit Shirley Jones' SAG sponsored red carpet event pictures around the world cries out for reversal.

II. PLAINTIFF'S CLAIMS ARE NOT PREEMPTED BY FEDERAL COPYRIGHT LAW.

Corbis cross-appealed in *Alberghetti, et al. v. Corbis*, now pending before this Court in case numbers 10-56400 and 10-56311 relative to federal copyright preemption. Corbis, again in this case, argues copyright preemption. The District Court, the Illinois trial court, and an Illinois Appellate Court have decided the copyright preemption issue. The Illinois Supreme Court refused to accept a petition for writ of certiorari filed by Corbis. Even Corbis, on its websites, warns its purchasers "...that its license for an image does not include any rights of publicity." Corbis' website expressly recites what Corbis calls "a general tutorial" as 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." Obviously, if Corbis' alleged "copyright" rights in the photos preempted Shirley Jones' right of publicity, then Corbis would not have to warn its customers about Shirley Jones' (and the others) right of publicity.

Corbis' *insistence* to its customers that the persons photographed still have a right of publicity must doom any pre-emption argument. It is well-settled that "a human likeness is not copyrightable, even if captured in a copyrighted photograph." *KNB Enters. v. Matthews*, 78 Cal. App. 4th 362, 365 (2000). *See also*

Brown v. Ames, 201 F.3d 654, 658 (5th Cir. 2001) (“names and likenesses do not become copyrightable simply because they are used to identify the source of a copyrighted work.”). Corbis ignores the distinction between “names and likenesses” and copyrighted material, attempting to spin this action as a suit against it as a copyright holder for simply exercising its copyrights. But that is not what this litigation is about. Plaintiff is suing a purported copyright holder for violating her rights of publicity under California common law and Cal. Civ. Proc. § 3344.

In *Comedy III Productions, Inc. v. Gary, Saderup Inc.*, 25 Cal. 4th 387, 21 P.3d 797 (2001), the defendant printed and sold original sketches of the Three Stooges on t-shirts and as lithographs, without the permission of their estates. After discovery and a trial on stipulated facts, the court ruled for the owner of the Stooges’ rights and condemned Defendant’s conduct as a plain violation of the California right-of-publicity statute. Said the California Supreme Court:

Saderup’s lithographic prints of the Three Stooges are themselves tangible personal property, consisting of paper and ink, made as products to be sold and displayed on walls...’Saderup’ ...thus used the likeness of the Three Stooges on products, merchandise or goods: within the meaning of the statute.’ 21 P.3d at 802. Saderup’s business said the Court, “...was a commercial enterprise designed to generate profits solely from the use of the likeness of the Three

Stooges which is the right of publicity...

Id. At 810.

Just as Saderup's lithographs (which were his original works which could be copyrighted by him) were deemed "paper and ink" products to be sold and displayed, so are Corbis' Plaintiff's photographs "paper and ink" products to be sold and displayed.

When a fan or collector buys a Plaintiff photo from Corbis, that sale diminishes the market for Plaintiff's own sales of her photos to fans and collectors. Nowhere in the Corbis papers does it deal with this obvious (and damning to Defendant) reality, whether or not Corbis attempts to shoehorn this reality into its "express" or "conflict preemption." Indeed, to its customers who it knows intend to use Plaintiff's photos commercially, Corbis says: "Just pay us more money!"¹ Nothing in California law insulates Corbis from liability for sales to fans, collectors, and known commercial users. Nothing in Corbis' papers even argues for such insulation. Instead, Corbis incorrectly again asserts that Plaintiff's claims are preempted or precluded by federal law and constitutional protections.

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

¹ Corbis charges more for the photographs to "commercial" end-users than to media end-users.

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, Inc., v. Major League Baseball Players Association*, 805 F.2d 663 (7th Cir. 1986), held that "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 fleshed out the pre-emption doctrine, and annihilates its application to Shirley Jones' 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. The Seventh Circuit said: "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, Shirley Jones does not claim any copyright interests in the photographs of her that Corbis is soliciting for sale and selling. Shirley Jones did not make the photos. So Shirley Jones does not have any copyright claim against Corbis (nor against anyone else) based on the photos. And Shirley Jones did not produce the photos for Corbis as “works-for-hire.” 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.

Moreover, Shirley Jones’ claim against Corbis is not “equivalent” to any copyright claim. Indeed, Defendant Corbis has conceded that a publicity claim is “different and separate.” Shirley Jones has no copyright claim against Corbis, or the photographers over the photos. It is Corbis’ unauthorized exploitation by soliciting for sale or selling of her image that guides her claim. She is not suing Corbis over any authorized work fixed in a tangible form. She is suing to protect her right of publicity - an intangible right she has taken years to establish.

Again, this intangible right is not equivalent to any relevant copyright -

because she has no copyright at stake. The U.S. Supreme Court illustrates this reality in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576, 97 S.Ct. 2849 (1997). *Zacchini* performed a live human cannonball act. A television station taped his act, and played it on the news. Despite § 301, the Seventh Circuit said *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. The Supreme Court addressed “The rationale for [protecting the right of publicity] [as] the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.” So if Shirley Jones had created the photographs that Corbis solicits for sale without her permission, then she would have a copyright infringement claim only. Notably, this *Zacchini* analysis also accorded *no* First Amendment immunity to the television station. Indeed, Corbis warns its users that the rights of publicity are independent from those rights purchased under the licensing agreement.

a. Plaintiff's claims are not expressly preempted as they are not "within the subject matter of copyright"

The test for determining whether a state law claim is expressly preempted by the Copyright Act involves two prongs: (1) whether the work at issue is within the subject matter of copyright as defined in §§ 102 and 103 of the Copyright Act; and (2) whether the state-law-created right is equivalent to any of the exclusive rights within the general scope of copyright as specified in § 106.3. *See Laws v. Sony Music Entm't., Inc.* 488 F.3d 1134, 1137-38 (9th Cir. 2008).

Under the first prong of the express preemption test, the court must determine if the subject matter of the state law claim – is "within the subject matter of copyright" as defined by the Copyright Act §§ 102 and 103. *Id.* It is well-settled that "[a] person's name or likeness is not a work of authorship within the meaning of 102" and thus is "not within the subject matter of copyright." *See id.* at 1141 (citing *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1004 (9th Cir. 2001)).

Although a "photograph itself [is] a pictorial work of authorship," when "it is not the publication of the photograph itself, as a creative work of authorship," but rather the "persona" that is the basis for the Plaintiffs' claims, the photograph "is not a 'work of authorship under the Act.'" *Downing*, 265 F.3d at 1003. Thus,

because “[t]he ‘subject matter of a Right of Publicity claim is not a particular picture or photograph of Plaintiff, as in copyright, but rather “‘is the very identity or persona of the plaintiff as a human being,’” which is not protected by copyright law, it is not “within” its subject matter.” *Id.* at 1004 (citing McCarthy’s Treatise on Right of Publicity and Privacy).

Defendant points to no case law supporting its theory that “something more” than a photograph must be involved for preemption not to occur. (Corbis’ answering brief at 41). Perhaps the “something more” Defendant refers to is what has been referred to by courts as an “expressive work” or “express use” of the Plaintiff’s identify. *See, e.g., Facenda v. NFL Films Inc.*, 542 F.3d 1007 (3rd Cir. 2008). There, the court noted that “when defendant’s uses constitute ‘expressive works,’ ‘right-of-publicity claims have been preempted.’” *Id.* (citing 1 Nimmer on Copyright § 1.01[B][3][b][iv][I], at 1- 88.2(11)). This category of “expressive uses” includes motion pictures in which a plaintiff acted, or songs sung by a plaintiff. *See Id.* (citing *Fleet v. CBS, Inc.*, 50 Cal. App. 4th 1911 (2000) (distributing a movie in which the plaintiff acted is an “expressive use” that preempted plaintiff’s right of publicity claim). These and other types of performances such as those of a baseball player in a game, have been found to constitute “works of authorship.” *See, e.g. Baltimore Orioles, supra.* However, these types of performances are

distinguishable from the case at hand, where all that is at issue is the presence of the plaintiff's images, likenesses, and/or name in and attached to photographs which Plaintiff has in fact alleged Corbis has used to sell a separate product, the licenses.

b. Plaintiff's claims are not expressly preempted as they are not "equivalent" to any exclusive rights of a Federal Copyright.

Assuming the subject matter of a plaintiff's state law claim is within the subject matter of copyright, which it is not, a court then considers whether the rights granted under the state law are "equivalent" to any exclusive rights of a federal copyright. *Id.* at § 1138. Here, the photographs at issue are not equivalent to any exclusive rights of a federal copyright, as "copyright laws do not reach identity claims." *Toney v. L'Oreal U.S.A., Inc.*, 406 F.3d 305, 910 (7th Cir. 2005). Defendant has acknowledged that publicity rights are distinct from copyright rights.

Corbis' answering brief does not contest that Corbis warns its customer that its copyright license for an image does not include any rights of publicity. As Corbis tells its customers, and as it tells this Court, copyrights and Plaintiffs' publicity rights are *distinct*. [Corbis' answering brief at 11 and 33] Nothing in Corbis' answering brief alters this reality; and there can be no copyright

preemption of Plaintiff's publicity claims against Corbis. Corbis' "warnings" to its commercial buyers to be aware of Plaintiff's rights-of-publicity aggravates, rather than ameliorates, Corbis' liability. Corbis advises its users "of the need to obtain permission from the owner of the right of publicity before putting the image to commercial use." This fact, as noted, constitutes Corbis' concession that Plaintiff's right of publicity claim is not pre-empted by copyright, but rather a separate still existing right. But Corbis including 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 lawful medical purposes. Wink...wink! The point is, the bona fides of such a practice, and the actual identity of buyers and their use of Plaintiff's images are obviously more easily controlled by the facilitator of the wrongful exploitation: Corbis. The law looks to conduct, more than self-serving words, in determining facts.

In light of the Corbis' admonition at pages 11 and 33 of its answering brief to its customers that Plaintiff's right of publicity is a right separate from copyright, it is with considerable chutzpah that Corbis again now argues total preemption to this Court. If Plaintiff's right of publicity claims are preempted, the logical inquiry

becomes: where in Plaintiff's complaint are the copyright claims against Corbis? Alternatively, where in the Copyright Act are Plaintiff's claims against Corbis negated? The answers are: nowhere and nowhere.

Corbis suggests that *Toney v. L'Oreal*, 406 F.3d 905 (7th Cir. 2005) differs from Plaintiff's case because in *Toney* the copyrighted photograph was used "to endorse a product." Say what? This is pure sophistry. It's like arguing that because Willie Sutton was convicted of robbing a bank, it follows that robbing a liquor store must be okay. Here, Plaintiff's photographs are the product. And under California law, both "advertising or selling, or soliciting purchases of products" are equally culpable violations. Cal. Civ. Code § 3344. *Toney* is dispositive. In fact, Plaintiff's case is far stronger than *Toney's*, because Plaintiff, unlike *Toney*, never consented to Corbis' sale and offering for sale of her identity and image, for any use.

Plaintiff's likenesses are being used by Defendant for its commercial advantage. This act is not, as Defendant contends, "equivalent to" those acts properly asserted by a copyright holder. *See, e.g., Salestraq America, LLC v. Zyskowski*, ---F.Supp.2d---, 2009 WL 1652146, *6 (D. Nev. Jun. 10, 2009) (allegations that defendants used [intellectual property] for their own commercial benefit in violation of state law changed the nature of its state claims so that they

are qualitatively different from a copyright infringement claim and were not preempted).

Defendant's attempts to analogize this case to *Fleet v. CBS Inc.*, 50 Cal. App.2d 1911 (1996) additionally fails to address that the court's discussion was limited to a "narrow issue": "whether an actor may bring an action for misappropriation of his or her name, image, likeness, or identity under section 3344 of the Civil Code when the only alleged exploitation occurred through the distribution of the actor's performance in a motion picture." *Fleet* at 1913, 1916. Here, putative class members are not all actors, nor even public figures, nor are the disputed copyrighted items "performances," in a motion picture or otherwise. Indeed, other courts have noted that *Fleet's* "broad language regarding preemption" is limited "to the unique facts of that case." See *KNB*, 78 Cal. App. 4th at 374.

III. CORBIS POSSESSES NO FIRST AMENDMENT OR PUBLIC INTEREST EXEMPTION: CORBIS IS NOT A NEWSPAPER AND NOT THE MEDIA.

A newspaper has, in certain circumstances, a First Amendment privilege from rights of publicity claims based on use of celebrities' photographs. A company like Corbis, when it sells a celebrity photo to a newspaper or television station, for a profit, is not engaged in the "use" of an 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. As Amici have said at pages 21 and 22 of their brief:

“Corbis does not provide any news or information through its licensing database and therefore is not statutorily exempt under Section 3344(d). Rather Corbis’ business is built on ‘unjust enrichment by the theft of [the goodwill individuals, such as Ms. Jones, hold in their names and likenesses built through their hard work and talent as professional actors and recording actors over many years.

...

California’s public affairs exemption and the First Amendment would protect the manner in which the press uses the names, likenesses, and photographs of individuals in connection with news reporting and the reporting and dissemination of news and information to meet the public demand and need. In fact, the photographers who took the pictures at issue were granted access to the red carpets for just those purposes. Extending such defenses to Corbis and similar businesses however, would devastate the protections afforded individuals by over-extending the protections exclusively reserved for reporting factual news and information to the public.”

The Seventh Circuit in *Douglas v. Hustler Magazine*, 769 F.2d 1128 (7th Cir. 1985) in a suit directly against a magazine, even upheld a Plaintiff’s common law commercial appropriation branch of right of privacy when it 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 *Id*, the 7th Circuit upheld the Plaintiff’s claim because of the use *Hustler* made.

Because Corbis is not in the news business, its argument that upholding Plaintiff’s rights of publicity would preclude its First Amendment protections is unavailing. Again, Corbis is not a newspaper. It does not step into a newspaper’s shoes. Under *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790 (1995), a newspaper could sell its pictures to promote articles – but Corbis is not a newspaper. Corbis’ use of the images is not connected with any news, public affairs, sports broadcast or account, or any political campaign. In *Gionfriddo v. Major League Baseball*, 94 Cal. 3rd 860 (1979) cited by Corbis, the “uses of plaintiffs’ names, images, and likenesses were all ‘in connection with [a] news, public affairs, or sports account’ within the meaning of section 3344 [...]”

IV. CONCLUSION

For all these reasons, the summary judgment entered by the District Court should be reversed.

Respectfully submitted,
GOLD & COULSON
A Partnership of Professional and
Limited Liability Corporations
ARTHUR S. GOLD

s/ Arthur S. Gold

ARTHUR S. GOLD

11 S. LaSalle St., Suite 2402
Chicago, IL 60603
Telephone: (312) 372-0777
Facsimile: (312) 372-0778

STATEMENT OF RELATED CASES

Pursuant to Ninth Circuit Local Rule 28-2.6, counsel certifies that there is a related case pending, *Alberghetti et al. v. Corbis Corporation*, case numbers 10-56410 and 10-56311 before this Court.

CERTIFICATE OF CONFORMITY

I certify under penalty of perjury that Appellants' Reply Brief is proportionally spaced, has a typeface of 14 points or more and contain 3716 words. Executed on February 7, 2012 at Chicago, Illinois.

s/Arthur S. Gold
Arthur S. Gold