

No. 15-55630

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

PATRICK MALONEY and TIM JUDGE,
Plaintiffs-Appellants,

v.

T3MEDIA, INC.,
Defendant-Appellee,

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA
CASE NO. 14-CV-05048-AB (VBKx)

**AMICUS CURIAE BRIEF OF THE NATIONAL FOOTBALL LEAGUE
PLAYERS ASSOCIATION, THE MAJOR LEAGUE BASEBALL
PLAYERS ASSOCIATION, THE NATIONAL HOCKEY LEAGUE
PLAYERS' ASSOCIATION, THE NATIONAL BASKETBALL
PLAYERS ASSOCIATION, AND THE MAJOR LEAGUE SOCCER
PLAYERS UNION IN SUPPORT OF PLAINTIFFS-APPELLANTS**

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CORPORATE DISCLOSURE STATEMENT

The National Football Players Association and the National Basketball Players Association are corporations that do not issue stock and have no parent corporations. The Major League Baseball Players Association, the National Hockey League Players' Association, and the Major League Soccer Players Union are unincorporated associations.

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INTERESTS OF THE AMICI CURIAE

The National Football League Players Association, the Major League Baseball Players Association, the National Hockey League Players' Association, the National Basketball Players Association, and the Major League Soccer Players Union (collectively, "Player Associations") represent professional athletes in collective bargaining, group licensing, and other matters.

The Player Associations have a strong interest in this case because they regularly negotiate and enter into group licensing agreements on behalf of the professional athletes they represent, authorizing companies throughout the world to use photographs and other depictions of those athletes in a broad range of commercial products and services.¹ By negotiating the specific terms and conditions of those agreements, the Player Associations and their member athletes are able to ensure that: 1) those athletes are not associated with or perceived to promote products or services that they choose not to support, 2) the commercial value of the athletes' names and likenesses is not diluted through misuse or overuse, and 3) the athletes are fairly compensated for the use of their images to enhance the consumer appeal of products or services. Companies that profit from the commercial use of these athletes' names and likenesses, in items ranging from posters and trading cards to video games and apparel, have long recognized their obligation to obtain licenses from the athletes and/or the Player Associations

¹ The NBPA and MLSPU license their members' publicity rights to the National Basketball Association and Major League Soccer, which in turn license those rights to others.

before marketing any products featuring those athletes' valuable personas.

The district court's decision, if affirmed, would disrupt the long-established rights and expectations underlying those licensing agreements and would severely limit the ability of professional athletes and other marketable personalities to control the commercial exploitation of their names and likenesses. As explained below, the district court's decision is contrary to established precedent. The Copyright Act was never intended, and cannot fairly be construed, to give companies or individual photographers the unfettered right to appropriate the commercial value of an athlete's name or likeness by the expedient of using copyrightable photographs.

This brief is submitted with the parties' consent. No counsel for a party authored this brief in whole or in part, and no person other than amici or their counsel made a monetary contribution to the preparation or submission of this brief.

INTRODUCTION

The district court (Birotte, J.) ruled that the Copyright Act, 17 U.S.C. §§101 *et seq.*, preempts the California statutory and common law right-of-publicity claims asserted by plaintiffs – college athletes whose photographs T3Media, Inc. sold through its player name-searchable online marketplace. The court held that the Copyright Act gave T3Media the unlimited right to advertise and sell those athletes' images to consumers, even though T3Media thereby appropriated the commercial value of those athletes' names and likenesses in violation of their

publicity rights under California law.

The district court's decision finds no support in the text or purposes of the Copyright Act or this Court's precedents. As explained in *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001), the Copyright Act does not preempt right-of-publicity claims arising from a company's unauthorized marketing and sale of photographs depicting well-known individuals, because a right-of-publicity claim challenges the company's commercial appropriation of the plaintiff's name or likeness, which is *not* a copyrightable "work of authorship." *Id.* at 1003-05. Any contrary rule would permit a company to merchandize an individual's name or likeness without authorization by simply taking a photograph of the individual, or purchasing the rights to someone else's photograph, and using it to create and sell reproductions, trading cards, digital "wallpaper," or other commercial products whose value rests in whole or in part on that individual's persona.

There is no legal support for carving out such a significant exception to California's longstanding right of publicity. Congress enacted the Copyright Act's preemption clause, 17 U.S.C. §301 ("§301"), with the intent of establishing a uniform national system of copyright law that would supplant state-level copyright laws, not to shield copyright holders from state law claims that require different elements and serve different purposes than the Copyright Act. *Brown v. Ames*, 201 F.3d 654, 659 n.2 (5th Cir. 2000). While a right-of-publicity claim may be preempted if it challenges nothing more than the reproduction or distribution of a

performance that is itself independently copyrightable, see, e.g., Jules Jordan Video, Inc. v. 144942 Canada, Inc., 617 F.3d 1146 (2010); *Laws v. Sony Music Entertainment, Inc.*, 448 F.3d 1134 (2006), that narrow exception (which is necessary to prevent contributors to a creative work from using the right of publicity to avoid the Copyright Act’s assignment of the “exclusive” rights in that work, *see* 17 U.S.C. §106) has no application here.

Unlike the copyrighted performances in *Jules Jordan* and *Laws*, “a person’s name or likeness is not a work of authorship within the meaning of 17 U.S.C. §102.” *Downing*, 265 F.3d at 1004. Consequently, the rights at issue here do not involve “the subject matter of copyright” as required for §301 preemption. *Id.* Nor do the sporting events at which some of plaintiffs’ photographs were taken constitute “works of authorship” under the Copyright Act. *See infra* at 20 n.9. Because plaintiffs challenge T3Media’s commercialization of their names and likenesses rather than its use of a specific, copyrightable work of authorship, their state law right-of-publicity claims are not preempted.

ARGUMENT

I. The Right of Publicity Protects Important Personal and Commercial Interests

For more than a half century, courts have recognized the right of athletes, celebrities, and other well-known individuals to control the commercial use of their names and likeness, including through the marketing and sale of merchandise whose value is enhanced by featuring those names and likenesses. *See, e.g., Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.

1953); *id.* at 868 (recognizing “right of publicity” as an individual’s “right in the publicity value of his photograph,” and concluding that sale of trading cards depicting professional athletes violated athletes’ right of publicity); *see also Hart v. Electronic Arts, Inc.*, 717 F.3d 141, 150-51 (3d Cir. 2013) (even before *Haelan Laboratories*, courts and legal commentators had recognized “that an individual enjoyed a property interest in his or her identity”). That “right of publicity” is now recognized under the common law or by statute in 33 states and the District of Columbia. Jonathan D. Reichman, *Right of Publicity in 21 Jurisdictions Worldwide 2014* 123, 130 (2013).² In California, “the right of publicity is both a statutory and a common law right.” *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal.4th 387, 391 (2001); *see* Cal. Civ. Code §3344.

“[T]he basic and underlying theory” of the right of publicity “is that a person has the right to enjoy the fruits of his own industry free from unjustified interference. It is unfair that one should be permitted to commercialize or exploit or capitalize upon another’s name, reputation or accomplishments” *Palmer v. Schonhorn Enterprises, Inc.*, 96 N.J. Super. 72, 79 (1967) (citation omitted). “A famous individual’s name, likeness, and endorsement carry value and an unauthorized use harms the person both by diluting the value of the name and depriving that individual of compensation. Unauthorized use of an individual’s name is nothing short of an appropriation of the attributes of one’s identity.”

² The remaining 17 states have not addressed whether the right is recognized at common law. *Id.*

McFarland v. Miller, 14 F.3d 912, 919 (3d Cir. 1994) (citation omitted). As the Supreme Court has emphasized, protection of the right of publicity reflects the legislative and judicial judgment that “[n]o 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.” *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576 (1977).

Like other intellectual property rights, the right of publicity “provides an economic incentive for [celebrities] to make the investment required to produce a [work] of interest to the public.” *Id.* The right of publicity also enables individuals to avoid becoming associated with particular commercial products or works without their consent. *See, e.g., Parks v. LaFace Records*, 329 F.3d 437, 453-55, 459-61 (6th Cir. 2003) (right-of-publicity suit by Rosa Parks against a rap group whose song “Rosa Parks” contained “lyrics . . . laced with profanity” and “a ‘hook’ or chorus that [was] pure egomania”). The right of publicity thus protects the right of individuals (within constitutional limits) to choose how their identity is commercialized, as well as their right to receive compensation for such commercialization.

Courts have recognized the right of publicity in a range of settings, many similar to the sale of photographic images at issue here: from trading cards depicting professional baseball players, *Halean Laboratories*, 202 F.2d 866; and board games featuring professional golfers, *Palmer*, 96 N.J. Super. 72; to works of art representing famous comedians, *Comedy III Productions*, 25 Cal.4th 387, and

photographs depicting famous surfers, *Downing*, 265 F.3d 994 (9th Cir. 2001); *see also In re NCAA Student-Athlete Name & Likeness Licensing Litigation*, 724 F.3d 1268 (9th Cir. 2013) (“*NCAA Student-Athletes*”) (video games depicting popular college athletes); *Hart*, 717 F.3d 141 (same). The right of publicity ensures that the right to control the commercial marketing of an individual’s “notoriety or fame belongs to the individual with whom it is associated.” *McFarland*, 14 F.3d at 923.

The legal protections provided by the right of publicity provide the backdrop for a multi-billion-dollar commercial market in goods and services featuring the names and likenesses of athletes, celebrities, musicians, and other individuals with marketable personalities. Musicians regularly enter into licensing agreements permitting the creation and sale of posters, t-shirts, calendars, coffee mugs, tote bags, and other merchandise featuring their pictures.³ For the Player Associations and their members, individual and group licensing agreements provide the foundation for a robust market for trading cards, posters, bobbleheads, and other forms of commercial merchandise depicting professional athletes. *See, e.g., Fleer Corp. v. Topps Chewing Gum, Inc.*, 658 F.2d 139, 142-44 (3d Cir. 1981) (describing origins of MLBPA’s group licensing program and 1968 agreement with Topps regarding depicting of players in certain trading cards).

³ *See, e.g.*, <http://justinbieber.shop.bravadousa.com/store/> (selling t-shirt with photograph of Justin Bieber); <http://www.onedirectionstore.com/> (selling t-shirts, posters, calendars, and coffee mugs with photographs of One Direction).

Within these markets, the right of publicity enables individuals whose names and likenesses have significant commercial value to control the commercialization of their identities, while protecting those individuals' business partners from unfair competition from unlicensed goods. *See, e.g., Winterland Concessions Co. v. Fenton*, 835 F.Supp. 529 (N.D. Cal. 1993) (right-of-publicity suit brought by authorized distributor of products featuring popular musicians against unlicensed producers and distributors of competing goods); *see also Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 546 (1985) (explaining that grant of exclusive right to producer "induc[es] the creation of new material of potential . . . value" that would not be produced absent guarantee of exclusivity). As the size and strength of celebrity merchandising markets demonstrates, judicial recognition of the right of public figures to control the commercial exploitation of their names and likenesses promotes the development of these markets.

For the Player Associations' members, the ability to control the commercial use of their names and likenesses provides an important return on the substantial investments they make in their professional careers. For NCAA athletes who are currently prohibited from receiving compensation for their athletic efforts, these publicity rights provide one of the few ways they can obtain remuneration for their years' of hard effort.

II. The Copyright Act Does Not Preempt Right-of-Publicity Claims Challenging the Marketing and Sale of Player Images

Although the right of athletes to control the commercial appropriation of their names and likenesses is well established, the district court concluded that

plaintiffs are barred from challenging T3Media’s use of their names and likenesses to market and sell digital merchandise because that merchandise consisted of digital copies of copyrighted photographs. ER 36-39. That conclusion finds no support in the text or purposes of the Copyright Act.

A. Congress Intended To Preempt State Copyright Laws, Not State Law Publicity Rights

Before 1976, the Copyright Act did not expressly preempt any state law claims. Instead, “there existed a dual system of federal and state copyright law” in which “[u]npublished works – those in limited distribution and unavailable to the general public – were protected by state common-law copyright.” *Klekas v. EMI Films, Inc.*, 150 Cal.App.3d 1102, 1108 (1984). Congress’s 1976 Copyright Act amendments were intended “to abolish this dual system of common-law copyright for unpublished works and statutory copyright for published works, and to adopt a single system of federal statutory copyright” *Id.* at 1109; *see also* H.R. Rep. No. 94-1476, at 129 (1976) (“Common law copyright protection for works coming within the scope of the statute would be abrogated, and the concept of publication would lose its all-embracing importance as a dividing line between common law and statutory protection and between both of these forms of legal protection and the public domain.”); *Daboub v. Gibbons*, 42 F.3d 285, 288 (5th Cir. 1995) (Congress sought to “creat[e] a uniform method for protecting and enforcing certain rights in intellectual property”).

Section 301 implements Congress’s goal of “abolish[ing]” the state common law of copyright. That preemption provision states that rights “that are equivalent

to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103 . . . are governed exclusively by [the Copyright Act].” 17 U.S.C. §301(a).

Under this plain statutory language, two separate conditions must be satisfied for a state law claim to be preempted:

First, the content of the protected right must fall within the subject matter of copyright as described in 17 U.S.C. §§102 and 103.
Second, the right asserted under state law must be equivalent to the exclusive rights contained in section 106 of the Copyright Act.

Downing, 265 F.3d at 1003; *see also Laws*, 448 F.3d at 1137-38 (describing this Circuit’s “two-part test to determine whether a state law claim is preempted by the Act”).

Consistent with Congress’s goal of establishing a uniform federal copyright system and abolishing state-level copyright laws, §301 preempts only those state-law rights “that are equivalent to copyright.” *Laws*, 448 F.3d at 1137 (citing H.R. Rep. No. 94-1476, at 130 (1976)). Section 301 does *not* preempt state law “rights and remedies that are *different* in nature from the rights comprised in a copyright.” H.R. Rep. No. 94-1476, at 132 (1976) (emphasis added). Indeed, the key House Committee Report in 1976 specifically identified state law right-of-publicity claims as one category of claims that would not be preempted under §301, because true right-of-publicity claims “contain elements . . . that are different in kind from copyright infringement.” *Id.*; *see also Brown*, 201 F.3d at 661 (“As noted in the

legislative history of section 301, Congress was aware of the operation of state law on the rights of privacy and publicity, and indicated its intention that such state law causes of action remain.”).

Given Congress’s express recognition that right-of-publicity claims were not meant to be preempted by §301, especially clear statutory preemption language is needed to conclude otherwise. *See, e.g., Medtronic, Inc. v. Lohr*, 518 U.S. 470, 485 (1996) (express preemption provisions must be construed narrowly in light of “federalism concerns and the historic primacy of state regulation of matters of health and safety”). Section 301 contains no such language. To the contrary, right-of-publicity cases involving the commercial appropriation of an individual’s name and likeness through the marketing and sale of searchable photographic images of that individual do not satisfy either of the two textual prerequisites for §301 preemption.

B. An Individual’s Name and Likeness Cannot Be Copyrighted

The district court’s finding of preemption was erroneous in the first instance because the plaintiffs’ underlying right of publicity does not “fall within the subject matter of copyright.” *Downing*, 265 F.3d at 1003.

Under both the common law and statutory rights of publicity, the “subject matter” of the underlying right is the plaintiff’s name, likeness, or identity – in other words, his or her persona. While an individual’s persona may have commercial value to the consumer public, it is settled in this Circuit that, for purposes of copyright preemption, an individual’s name, likeness, and identity do

not constitute “work[s] of authorship ” falling within the “subject matter of copyright” defined by 17 U.S.C. §102(a):

The “work” that is the subject matter of the right of publicity is the persona, i.e., the name and likeness of a celebrity or other individual. A persona can hardly be said to constitute a “writing” of an “author” within the meaning of the copyright clause of the Constitution. *A fortiori* it is not a “work of authorship” under the Act.

Downing, 265 F.3d at 1003-04 (quoting 1 *Nimmer on Copyright* §1.01[B][1][c] at 1-23 (1999)) (alteration omitted); *id.* at 1004 (“The ‘subject matter’ of a Right of Publicity claim is not a particular picture or photograph of plaintiff. Rather, what is protected by the Right of Publicity is the very identity or persona of the plaintiff as a human being.”) (quoting McCarthy, *Rights of Publicity and Privacy* §11.13[C] at 11-72-73 (1997)); *id.* at 1004 (“The subject matter of Appellants’ statutory and common law right of publicity claims is their names and likenesses.”); *see also Brown*, 201 F.3d at 658 (“A persona does not fall within the subject matter of copyright.”); 17 U.S.C. §102(a)(1)-(8) (examples of “works of authorship” include literary, musical, dramatic, choreographic, pictorial, sculptural, audiovisual, and architectural works; motion pictures; and sound recordings).

The district court concluded, contrary to *Downing*, that the first “subject matter” condition for preemption was satisfied because plaintiffs’ claims involve the advertising and sale of photographs, and “photographs that meet the Act’s originality requirement fall within the subject matter of copyright.” ER 36. It is true that photographs are copyrightable. But as *Downing* makes clear, the “subject matter” of the right of publicity is not the photographic depiction but the underlying likeness and identity of the person depicted. “A person’s name or

likeness is not a work of authorship within the meaning of 17 U.S.C. § 102 notwithstanding the fact that [those] names and likenesses are embodied in a copyrightable photograph.” 265 F.3d at 1004; *id.* at 1003-04 (a person’s name or likeness “does not become a work of authorship simply because it is embodied in a copyrightable work such as a photograph”) (quoting 1 *Nimmer on Copyright* §1.01[B][1][c] at 1-23 (1999)).⁴

Downing emphasized that a right-of-publicity case challenging an unauthorized commercial use of a copyrightable photograph does not assert rights in the particular photographic “work of authorship” but instead challenges defendant’s commercial appropriation of the subject’s likeness. “It is not the publication of the photograph itself, as a creative work of authorship, that is the basis for [such right-of-publicity] claims, but rather, it is the use of the [plaintiffs’] likenesses and their names pictured in the published photograph.” *Downing*, 265 F.3d at 1003; *id.* at 1004 (“[T]he exact image in [a] photograph is not the underlying ‘right’ asserted in a Right of Publicity case. To argue that the photograph is identical with the person is to confuse illusion and illustration with reality.”) (quoting McCarthy, *Rights of Publicity and Privacy* §11.13[C] at 11-72-

⁴ See also *KNB Enterprises v. Matthews*, 78 Cal.App.4th 362, 365 (2000) (“[B]ecause a human likeness is not copyrightable, even if captured in a copyrighted photograph, the [plaintiffs’] section 3344 claims against the unauthorized publisher of their photographs are not the equivalent of a copyright infringement claim and are not preempted by federal copyright law.”); *cf. Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) (finding no preemption of claim involving imitation of singer’s distinctive voice, because a voice is not a copyrightable “work of authorship”); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992) (same).

73 (1997)). Unlike an individual who asserts that a particular photograph or other copyrightable work makes unlawful use of his or her own creative works of authorship, *see, e.g., Klekas*, 150 Cal.App.3d at 1111 (preempted state law plagiarism claim asserting that film and novel were drawn from plaintiff’s unpublished literary manuscript), a right-of-publicity plaintiff challenging the commercial use of photographs depicting his or her likeness does not assert any right in the particular photographic “works of authorship.” Rather, his or her claim involves the defendant’s non-consensual use of that likeness. Plaintiffs’ claims here would be the same even if T3Media had used a different image in which the elements of “authorship” that make it copyrightable (such as its composition, framing, focus, and color palette) were entirely different.

Accordingly, under *Downing*, the “subject matter” of a right-of-publicity claim involving the unauthorized depiction of a plaintiff in a copyrightable photograph falls outside the scope of copyright, and a right-of-publicity claim involving the use of such photographs is therefore not preempted by the Copyright Act. *Downing*, 265 F.3d at 1004.⁵

⁵ The district court distinguished *Downing* as involving an advertising campaign while this case involves the sale of digital merchandise. However, the “subject matter” prong of the two-part preemption test depends not upon defendant’s *use* of the material (which is the focus of the *second* prong of the two-part test), but upon whether the “*content* of the protected right” involves “the *subject matter* of copyright as described in 17 U.S.C. §§102 and 103.” *Downing*, 265 F.3d at 1003 (emphasis added). The “content” of a right-of-publicity claim is the plaintiff’s name, likeness, or identity. None of those elements of a plaintiff’s persona are copyrightable under §102, as *Downing* recognized.

C. The Right To Control the Commercial Appropriation of One's Name and Likeness Is Not Equivalent to Any Exclusive Right Protected by the Copyright Act

Because right-of-publicity claims challenging the commercial use through copyrightable photographs of an individual's name and likeness do not satisfy the first "subject matter" prong of the two-part preemption analysis, there is no need to reach the second prong. Nonetheless, that second "equivalent rights" prong cannot be satisfied either. As *Downing* held, claims that do not involve the "subject matter" of copyright cannot be "equivalent" to claims arising under §106. *Downing*, 265 F.3d at 1005 ("Because the subject matter of the Appellants' statutory and common law right of publicity claims is their names and likenesses, which are not copyrightable, the claims are not equivalent to the exclusive rights contained in §106."); *see also* ER 40 (acknowledging *Downing*'s "categorical rule").

Even without *Downing*'s categorical rule, the rights asserted in a right-of-publicity case like this could not be found "equivalent to the exclusive rights contained in section 106 of the Copyright Act." *Downing*, 265 F.3d at 1003. A state law claim is not preempted by §301 if it "protect[s] rights which are qualitatively different from the[se] copyright rights" and "ha[s] an extra element which changes the nature of the action." *Laws*, 448 F.3d at 1143 (citation omitted). Section 106 gives the holder of a copyright the exclusive right to use the copyrighted material in certain ways – namely, "reproduction, preparation of derivative works, distribution, and display." *Id.* (citation omitted). To establish a

common law right-of-publicity claim under California law, however, the plaintiff must establish “(1) the defendant’s use of the plaintiff’s identity; (2) the appropriation of plaintiff’s name or likeness to defendant’s advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury.” *NCAA Student-Athletes*, 724 F.3d at 1273 n.4 (citation omitted). To establish a statutory claim under Cal. Civ. Code §3344, the plaintiff must prove “all the elements of the common law cause of action plus a knowing use by the defendant as well as a direct connection between the alleged use and the commercial purpose.” *Id.* (quotation omitted).

California right-of-publicity claims thus include at least one extra element that “change[s] the nature of the action” from one arising under §106 – the appropriation of the plaintiff’s name or likeness to the defendant’s advantage. In this case, for example, T3Media used the plaintiffs’ names to create a searchable index through which prospective consumers could locate and purchase images of particular athletes. ER 1239 ¶40.⁶ That use of the plaintiffs’ names is not a “subject” whose use is governed by §106 (because names cannot be copyrighted), and the commercial appropriation of those names to T3Media’s advantage through the creation of a searchable index of consumer goods differs from the rights of reproduction and distribution granted by §106. Likewise, while §106 gives

⁶ That the images were searchable by the names of the depicted players but not by those of the photographers who took the pictures underscores that the product being sold by T3Media was the players’ likenesses, not specific photographic works of authorship.

copyright holders the exclusive right to reproduce, distribute, and display copyrighted photographs, plaintiffs in right-of-publicity cases do not challenge the mere reproduction of a copyrightable photograph. Instead, they challenge the appropriation of the commercial value of their likenesses and identities – here, by creating an online marketplace targeted at consumers who wish to purchase digital images of their favorite college athletes for use as “wallpaper” for their personal computers or smartphones, as digital “posters,” or for any other “personal use” to which the digital image might be put. Because §106 does not grant a right to such forms of commercial appropriation, plaintiffs’ right-of-publicity claims are not “equivalent” to claims arising under §106.⁷

The district court recognized that at least some right-of-publicity claims involving commercial uses of a copyrightable photograph would not be preempted by §301, suggesting that plaintiffs’ claims would have survived if T3Media had used plaintiffs’ digital images to advertise other products rather than marketing and selling the images themselves. ER 37 n.3. But the Copyright Act provides no textual basis for distinguishing among the myriad ways in which a defendant can appropriate the commercial value of an individual’s likeness to its own commercial

⁷ This Court concluded in *Laws* that the “commercial use” element of California’s statutory right-of-publicity claim did not “qualitatively distinguish” that plaintiff’s claim “from a claim in copyright.” But that holding must be limited to the unique facts of that case, in which the plaintiff was not pursuing a true state right-of-publicity claim challenging the commercial appropriation of her likeness, but was merely attempting to assert copyright claims in the guise of a state law right-of-publicity claim in order to avoid the requirements of the Copyright Act. *See infra* Section II.D.

benefit. T3Media's business happened to involve the sale of digital files for use as digital "posters" or as "wallpaper" for personal computers or smartphones. ER 1240 ¶47. It could just as easily have placed plaintiffs' images on physical merchandise like posters, trading cards, or 8x10 glossy photos. Whether sold as a digital file or a tangible product, in each instance the value of the product containing the individual's likeness would be enhanced by (or entirely attributable to) the publicity value of the individual depicted.

There is no meaningful distinction for §301 purposes between an appropriation of a likeness in a digital format instead of in a physical format. By way of example, the Topps trading card company – a party to the Second Circuit's seminal 1953 decision regarding the right of publicity – now sells multiple mobile phone applications through which users can collect and trade digital trading cards depicting their favorite professional athletes.⁸ Given the ease with which digital images can be modified, such images arguably present an even *greater* threat to the right of publicity than physical goods that are less manipulable.

The district court further erred in concluding that the Copyright Act's preemption language distinguishes between advertising and non-advertising uses. Because the rights of reproduction and distribution guaranteed by §106 extend to uses of copyrighted material in advertising, *see, e.g., Lamb v. Starks*, 949 F.Supp. 753, 755-56 (N.D. Cal. 1996) (movie producer's exclusive right to create

⁸ *See* Topps Apps, <http://www.topps.com/topps-apps/> (describing "Topps BUNT" and "Topps NFL Huddle" applications).

derivative works included right to incorporate work into advertising trailer), the presence or absence of an advertising use cannot distinguish claims that are “equivalent” to claims arising under §106 from those that are not. If claims involving the commercial appropriation of an individual’s identity through the use of copyrightable photographs in advertising are not preempted, as under *Downing*, claims involving other forms of commercial appropriation through the use of copyrightable photographs cannot be preempted either.

In short, nothing in the text of §301, the congressional purposes underlying that provision, or this Court’s prior decisions suggests that the commercial appropriation of the value of athletes’ likenesses through the sale of digital images depicting those athletes is shielded from all right-of-publicity claims simply because those images are copyrightable.

D. Plaintiffs Are Not Attempting To Plead Around Copyright Law

Rather than following *Downing*, the district court based its decision on a misreading of *Laws* and *Jules Jordan*. But the narrow exception carved out by those decisions does not apply here.

In both *Laws* and *Jules Jordan*, the plaintiffs challenged uses of copyrighted material generated from artistic performances *that were themselves copyrightable* under §102. *See Laws*, 448 F.3d at 1136 (plaintiff challenged record label’s decision to license recorded vocal performance for sampling in another work); *Jules Jordan*, 617 F.3d at 1150 (plaintiff challenged copying and distribution of DVDs featuring recorded adult film performances). As a result, what purported to

be right-of-publicity challenges were in effect Copyright Act challenges cloaked in right-of-publicity garb.

While an individual's name or physical likeness can never itself be copyrighted, a particular vocal or dramatic performance *is* copyrightable, as long as it is fixed in a tangible medium. *See* 17 U.S.C. §102(a) (copyrightable “works of authorship” include musical works, dramatic performances, performances in motion pictures and other audiovisual works, and sound recordings). Claims involving such copyrightable performances are within the “subject matter” of copyright and may therefore be subject to preemption under §301(a) if the claims are otherwise equivalent to claims arising under §106.⁹

⁹ In *Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663 (7th Cir. 1986), the Seventh Circuit suggested that athletic performances are within the “subject matter” of copyright if the recording of those performances has fixed them in a tangible form. *Id.* at 675. That holding has been uniformly criticized, *see, e.g., Brown*, 201 F.3d at 659; *Toney v. L’Oreal*, 406 F.3d 905, 910-11 (7th Cir. 2005) (acknowledging criticism of *Baltimore Orioles* and interpreting decision narrowly), and has never been adopted in this Circuit. To the contrary, *Downing* recognized that a non-copyrightable creation does *not* become a “work of authorship” within the subject matter of copyright under §102 “simply because it is embodied in a copyrightable work.” 265 F.3d at 1003-04.

The *Baltimore Orioles* case also suggested in a footnote that specific athletic performances might themselves be copyrightable separate and apart from their recording. 805 F.2d at 669 n.7. For good reason, that suggestion also has not been followed by this or any other court. *See* 1 *Nimmer on Copyright* §2.09[F], at 2-170–2-171. While highly skilled, athletes do not exercise the kind of creativity required to make a performance a copyrightable “work of authorship” when they are competing. *Id.* at 2-168. If such athletic performances *were* copyrightable, individual players and teams could prevent others from replicating their moves or plays during future competitions; the Golden State Warriors, for example, could prevent other NBA teams from borrowing their innovative “small ball” formations. *Id.* at 2-169. Given the strong factors militating against recognizing copyright in athletic performances, it is not surprising that Congress omitted such performances

(continued . . .)

Claims involving uses of a plaintiff’s identity drawn from performances that are copyrightable under §102, like those in *Laws* and *Jules Jordan*, differ from claims involving other uses of a plaintiff’s identity in a fundamental way. Rather than vindicating the distinct and important rights served by the right of publicity, claims involving copyrightable performances may be Copyright Act claims masquerading as state law torts. Such claims (which the Fifth Circuit has characterized as a “ventriloquist’s attempt to present a copyright action in the voice of state law claims”) are preempted, because if plaintiffs could assert the exclusive right to reproduce or distribute specific works of authorship in a manner the Copyright Act prohibits simply by cloaking such claims in the language of other state law rights, the national uniformity of copyright law that Congress sought to achieve through the 1976 amendments would be undermined. *See Daboub*, 42 F.3d at 288, 290; *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1028, 1032 (3d Cir. 2008).

Both *Laws* and *Jules Jordan* involved Copyright Act claims framed as violations of the right of publicity. The plaintiff in *Laws* assigned to her record label “sole and exclusive” copyright in certain master recordings of her vocal performances, but had misgivings after her label permitted another musician to sample a portion of one recording. 448 F.3d at 1136. The plaintiff in *Jules Jordan* challenged defendants’ unauthorized copying and distribution of adult film DVDs

(. . . continued)

from the Copyright Act’s illustrative categories of authorship. *Id.* at 2-167–2-168 & n.71 (discussing 17 U.S.C. §102(a)(1)-(7)).

for which he held the copyright and in which he performed. 617 F.3d at 1150-51. In both cases, the fundamental dispute involved the parties' right to control a work of authorship they had created – claims squarely within the scope of the Copyright Act.

Here, by contrast, plaintiffs cannot use the Copyright Act to control the distribution of their names and likenesses, because the Act only protects an author's works (like the song in *Laws* and the videotaped performance in *Jules Jordan*). A right-of-publicity claim that challenges the commercial appropriation of a public figure's likeness cannot be pursued under the Copyright Act, even if that likeness is captured in a copyrighted photograph, because names, identities, likenesses, and athletic performances are outside the subject matter of copyright under §102. If the district court were right that those aspects of a persona are not protected by the right of publicity, they would not be protected *at all*.

Permitting claims like plaintiffs' to proceed would not undermine the congressional purposes underlying the Copyright Act, because that Act does not regulate the subject matter of those rights. Moreover, allowing plaintiffs' claims to proceed would not be inconsistent with the Act, because the right of publicity furthers, rather than impedes, the same general policy of encouraging individuals to create work of value to the public. *See Brown*, 201 F.3d at 660 (finding no preemption of plaintiff's right-of-publicity claim because "the right of publicity . . . promotes the major objective of the Copyright Act—to support and encourage artistic and scientific endeavors"); *Zacchini*, 433 U.S. at 576-77 (right of publicity

provides individuals with incentive to produce work of interest to the public). While the district court expressed concern that the claims here conflict with “copyright holders’ ability to exercise their exclusive rights under the Copyright Act,” ER 38, Congress chose *not* to preempt all state law claims relating to a copyright holder’s exercise of rights under the Copyright Act. Instead, Congress preempted only those claims that are *equivalent* to federal copyright claims (consistent with its stated purpose of preempting state common law copyright protections), while leaving copyright holders subject to other state law claims arising from the use of copyrighted material. *See supra* Section II.A.

E. Existing Limits on the Right of Publicity Protect Reporting, Public Commentary, and Creative Expressive

The district court also worried that permitting plaintiffs to proceed would “giv[e] the subject of every photograph veto power” over the reproduction and distribution of that photograph. ER 38. But existing limits on the right of publicity already ensure that the exercise of that right will not unduly interfere with artistic expression, news reporting, public commentary, or other valuable forms of communication involving the reproduction and distribution of copyrighted images or works. While the district court’s ruling categorically prohibits *all* right-of-publicity claims arising from the sale of copyrightable photographs, a case-by-case application of the existing limits on the right of publicity permits a more precise and doctrinally sound approach to determining which claims should succeed and which should fail.

Under statutory and common law, the potential scope of right-of-publicity

claims is significantly limited. For example, California’s common law right of publicity does not extend to “publication of matters in the public interest.”

Montana v. San Jose Mercury News, Inc., 34 Cal.App.4th 790, 793 (1995) (citation omitted). Where a defendant has used plaintiff’s name or likeness when reporting on such matters, “the right of the public to know and the freedom of the press to tell it” trump the plaintiff’s publicity rights. *Id.* (citation omitted). California’s statutory right of publicity likewise exempts any “use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign.” Cal. Civ. Code §3344(d). If the holder of the copyright in a photograph of a particular individual publishes that photograph in reporting on a matter of public interest, that individual has no valid right-of-publicity claim. *See NCAA Student-Athletes*, 724 F.3d at 1282.¹⁰

Right-of-publicity claims are also subject to significant First Amendment limitations. As the California Supreme Court has explained,

[T]he right of publicity cannot, consistent with the First Amendment, be a right to control the celebrity’s image by censoring disagreeable portrayals. . . . [T]he First Amendment dictates that the right to comment on, parody, lampoon, and make other expressive uses of the celebrity image must be given broad scope.

Comedy III, 25 Cal.4th at 403. In addition, if a creator uses an individual’s name

¹⁰ Notably, while public figures cannot use the right of publicity to prevent reporting on matters of public interest, copyright holders themselves can do so under certain circumstances. *See, e.g., Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 548-49 (1985) (reporting of contents of former President’s memoirs violated copyright holder’s rights).

or likeness in a work that “adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation,” the First Amendment protects that use. *Id.* at 391; *see also NCAA Student-Athletes*, 724 F.3d at 1273-1282 (discussing and applying the “transformative use” test); *Winter v. DC Comics*, 30 Cal.4th 881, 885 (2003) (use of plaintiffs’ likenesses in comic book was “transformative” and protected by First Amendment).

Existing law thus already provides photographers and others ample leeway in reporting upon, parodying, lampooning, and otherwise commenting upon public figures, reporting matters of public interest, and creating expressive works incorporating public figures’ identities. There is no reason to extend Copyright Act preemption beyond its textual boundaries and purposes to create additional protection for commercial uses of a public figure’s identity that fall outside these well-established limitations.

By contrast, affirming the decision below would have profound consequences for public figures and the companies that seek to capitalize upon the commercial value of their identities. Although the district court suggested that its ruling addressed only those commercial uses of plaintiffs’ likenesses that were limited to “the four corners of the copyrighted photographs themselves,” ER 37 n.3, a copyright holder’s right to reproduce and distribute copyrighted material extends to reproduction of the work in new formats. *See, e.g., Advance Magazine Publishers, Inc. v. Leach*, 466 F.Supp.2d 628, 637-38 (D. Md. 2006). If the Copyright Act gives copyright holders an unlimited right to sell digital or non-

digital photographs of a particular public figure, there is no reason why a company could not purchase the rights to a copyrighted photograph of a public figure and then reproduce and sell that photograph in formats ranging from posters to tote bags, iPhone cases, and coffee mugs. In *Hilton v. Hallmark Cards*, 599 F.3d 894 (9th Cir. 2010), for example, Hallmark could have avoided Paris Hilton's claims by simply purchasing the rights to a copyrightable photograph of Ms. Hilton and using that photograph to create the birthday card in question. Likewise, in *Comedy III*, Gary Saderup could have evaded the Three Stooges' right-of-publicity claim by simply purchasing the rights to a copyrightable photograph and using that photograph to prepare his lithographs.

Even though commercial appropriations of the value of a public figure's persona are core violations of the right of publicity, and even though such merchandise sales do little to spur the creation of valuable works of authorship, under the district court's ruling the Copyright Act shields any company that produces such merchandise using copyrightable photos from all right-of-publicity claims. That ruling is contrary to both the text of §301 and to Congress's stated intent.

III. The District Court Should Consider T3Media's Other Defenses in the First Instance

In the proceedings below, T3Media argued that its anti-SLAPP motion should be granted on the alternative ground that its actions were protected by the First Amendment and by the common law and statutory exemptions to the right of publicity for reporting on matters of public interest. ER 33. Yet T3Media did not

publish the images of plaintiffs in a forum for public consideration and discussion of the athletes and events depicted, and did not use the depictions of plaintiffs in a transformative manner. Consequently, those defenses are almost certain to fail. *See, e.g., NCAA Student-Athletes*, 724 F.3d at 1279, 1283. Nonetheless, because T3Media’s defenses depend in part upon facts regarding the specific manner in which T3Media used plaintiffs’ likenesses, *see Metabolife Intern., Inc. v. Wornick*, 264 F.3d 832, 840 (9th Cir. 2001) (to defeat anti-SLAPP motion, plaintiff must show complaint is “supported by a prima facie showing of facts [sufficient] to sustain a favorable judgment”) (quotation omitted), the Players Associations respectfully submit that this Court should permit the district court to consider those issues in the first instance.

CONCLUSION

For these reasons, the district court’s decision should be reversed.

Dated: December 7, 2015

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CERTIFICATE OF COMPLIANCE

I certify, pursuant to Fed. R. App. P. 32(a)(7)(C) and Ninth Circuit Rule 32-1, that the Amicus Curiae Brief of the National Football League Players Association, the Major League Baseball Players Association, the National Hockey League Players' Association, the National Basketball Players Association, and the Major League Soccer Players Union in Support of Plaintiffs-Appellants is proportionally spaced, has a typeface of 14 points, and contains 6,968 words.

Dated: December 7, 2015

/s/ Michael Rubin
Michael Rubin

CERTIFICATE OF SERVICE

I hereby certify that I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeal for the Ninth Circuit by using the appellate CM/ECF system on December 7, 2015.

Participants in the case who are registered CM/ECF users will be served by the appellate CM/ECF system.

Dated: December 7, 2015

/s/ Michael Rubin
Michael Rubin

General Information

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