

Copyright Act superceded Brown's rights of publicity.

ANALYSIS

The intended purpose of a motion to reconsider is to bring to the court's attention: (1) newly discovered evidence which was not available at the time of the hearing; (2) changes in the law; or (3) errors in the court's previous application of existing law. See Kaiser v. MEPC American Properties, 164 Ill. App.3d 978, 986 (1st Dist. 1987). In its motion to reconsider, Brown does not introduce any newly discovered evidence or changes in the law, therefore, the motion will only be granted if this Court finds that it made errors in its previous application of the law. In the case at hand, two independent grounds were given by this Court to justify its conclusions, thus errors in both will be required to reverse the Order rendered on August 6, 2004.

Exemption under the First Amendment

The First Amendment of the Constitution protects the dissemination of information by exempting from certain liabilities entities deemed to function as "vehicles of information". Berkos v. N.B.C., 161 Ill. App. 3d 476, 495 (1st Dist. 1987). When such an entity uses another's name or likeness without their approval for certain public interest uses, such as for a news story or an informative article, the person whose name or likeness was used cannot sue the entity for violating that person's right of publicity. The right of publicity applies in limited situations where one's name or likeness is used for commercial purposes without consent. See Douglass v. Hustler Magazine, 769 F.2d 1128, 1138 (7th Cir. 1985). The Act grants "the right to control and to choose whether and how to use an individual's identity for commercial purposes." 765 ILCS 1075/10. Therefore, the issue in the case at hand is whether or not Corbis is exempt from liability per the First Amendment of the Constitution.

In its previous Order and Memorandum, this Court found that Corbis was exempt as a "vehicle of information". Corbis is in the business of selling photos to the public, and this Court found this to be a valuable public service as Corbis facilitates "the flow of information through imagery." Upon reconsideration however, this Court concedes that the "vehicle of information" exception can only apply if the images sold by Corbis are used for the purpose of disseminating news or other public interest information. Berkos at 495. In the case at hand, Brown alleges in

its complaint that Corbis in fact does sell photos of Brown to commercial users who do not use the photos in a way which would be exempt under the First Amendment. Though such an allegation has yet to be proven by Brown, under a 2-619 motion to dismiss, that allegation should have been taken as true. See Stone v. McCarthy, 158 Ill. App.3d 569, 572, 511 N.E.2d 780, 781 (1st Dist. 1987). This Court therefore erred in finding that Corbis was exempt from liability under the First Amendment. Corbis sells pictures to several categories of customers. When the customer is a newspaper writing a story about Brown, the purchase of Brown pictures from Corbis is protected under the First Amendment and Brown cannot sue under his right of publicity. If the customer is a t-shirt company however, purchasing pictures of James Brown to put them on t-shirts for sale, then clearly such a sale is not protected and Brown's right of publicity remains very much in rigueur.

In its memorandum supporting its motion to dismiss, Corbis explains that it is protected by the Constitution because its clients either use the photos they buy in a manner protected by the First Amendment, or they agree to obtain licenses of the right of publicity before making use of the photos. (Defendant Corbis' Memorandum in Support of its Motion to Dismiss Counts III and VI of the Plaintiff's Amended Complaint Pursuant to 2-619 and 2-615 at 2). The fact that those customers who do not use the photos in a Constitutionally protected way "agree" to obtain licenses is irrelevant under the First Amendment exemption (though it is discussed further in the next section of this Opinion). The First Amendment only protects non-commercial sales. See Berkos at 495. Therefore, this Court finds that Corbis, with regards to its commercial sales, is not exempt under the First Amendment of the Constitution from the right of publicity suit brought against it by Brown.

The Delle Chiaie v. Corbis Corporation et al case

On June 29, 2004, Corbis supplemented its Response to Plaintiff's Motion to Reconsider with an Opinion it believes is relevant to the issues in question here. The Memorandum Opinion and Order was rendered in the case of Delle Chiaie v. Corbis Corporation et al. on June 21, 2004, by the United States District Court of New Jersey. Civil Action No. 02-3076 (D. N.J. June 21, 2004). The Chiaie Opinion granted the Corbis' Motion for Summary Judgment. Corbis was sued in that case for what it believes to be similar reasons as it is being sued in this case: Invasion of Privacy and Intentional Infliction of Emotional Distress. In essence, the Chiaie case

involved a picture of the Plaintiff's son on the Corbis web site, similarly to the Brown pictures. Plaintiff had never consented to the picture being taken in the first place, and never consented to its sale and dissemination on the Corbis web site. One reason the Chiaie court held that Corbis was not liable was because the picture, which depicted the Plaintiff's son at a memorial service for victims of the September 11, 2001 attacks by terrorists, had not been used for commercial purposes but only for the dissemination of newsworthy information. The Plaintiff had alleged the possibility that the picture might be used at a later date for commercial purposes, but the court stated "that has not occurred yet, and whether it will ultimately occur is pure speculation". Id. at 8. Corbis argues that the Chiaie court held as it did because the display of the picture fell "within the protective ambit of the incidental use doctrine." Id. at 7-8. However, Corbis has not argued as a defense in the case at hand that the display of Brown pictures was protected under the incidental use doctrine, nor has Brown had a chance to defend itself under the doctrine. In the Chiaie case, unlike in the case at hand, the picture of Chiaie's son was taken at a memorial service for victims of the September 11 attacks. The presence of Chiaie's son in the picture was incidental. In the case of the Brown pictures, Corbis specifically lists the pictures in a category for "James Brown", not for another event at which Brown incidentally happened to be. Finally, Brown does allege that his pictures are being sold for commercial purposes. The facts of the Chiaie case are distinguishable from those in the case at hand, the causes of action and the law in the case at hand are different, Chiaie is therefore not controlling.

Brown's right of publicity v. Corbis Right as a copyright holder

The two rights in conflict in this case are Corbis' rights under the Copyright Act and Brown's right of publicity. Both rights attach to the pictures of Brown which Corbis sells. On one hand Corbis owns the copyrights of each of the pictures. In essence, Corbis owns the pictures themselves. On the other hand, Brown owns his own image, which translates to a right of publicity as to anything which derives from, or contains his image. The right of publicity is that which one has to the commercial exploitation of his/her name or likeness, including his/her picture. See § 765 ILCS 1075/5 and § 765 ILCS 1075/10. This Court found in its Order dated August 6, 2003, that Corbis' rights, as a copyright holder of the photos, trumped Brown's rights of publicity. This finding was based on Baltimore Orioles, Inc. v. Major League Baseball Players Association, 805 F.2d 663 (7th Cir. 1986). This Court was misled however, as Orioles involved the rights of copyright owners in an employer/employee situation. The baseball players

were claiming rights of publicity against their employer, the Baltimore Orioles. Essentially, the Court in that case held that Baltimore's copyright in the broadcast of certain baseball games trumped the players rights of publicity in the same games because the copyrighted work, the video of the baseball games, had been prepared within the scope of the players' employment with the Orioles. Id.

In the case at hand, Brown was not an employee of Corbis nor of the photographers who took the pictures which Corbis sells. Therefore, the analysis by this Court in its prior Opinion was incorrect. In reconsidering the issues raised by the parties, this Court will thus focus on the Act itself. The claim for rights of publicity under the common law was supplanted by the Act, but the Act does not affect one's rights before the Act passed in 1999. Villalovos v. Sundance Associates, Inc., 2003 U.S. Dist. LEXIS 387, 2003 WL 115243, at 3 (N.D. Ill. 2003). In essence, the common law required a showing that "some appropriation" took place. Hooker v. Columbia Pictures Industries, Inc., 551 F. Supp. 1060, 1061 (N.D. Ill. 1982). Because neither the parties in question nor this Court's prior opinion questioned an appropriation of Brown's image, an analysis under the Act alone will suffice for both claims, consistent with the parties' briefs and oral arguments.

The Act explains what commercial uses it targets and which uses are exempt. Commercial use includes, amongst other things, the use of one's image for the sale of a product or service. See 765 ILCS 1075/5. In the case at hand and for purposes of this analysis, Corbis sells the copyrights it owns to the pictures of Brown. Two questions thus arise: (1) Is Brown's image being "used" in order to promote the selling of the copyrights? (2) Can Corbis be held liable when buyers of its copyrights "use" Brown's image inappropriately according to the Act? The answer to these questions depends heavily on who Corbis' customers of Brown pictures are and how those customers use the pictures. Brown believes that both questions must be answered positively. Taking Brown's allegations as true, this Court agrees and therefore finds that Corbis may have violated Brown's right of publicity.

Corbis claims that it merely facilitates the flow of information by providing the public with pictures that are in the public interest. Specifically, Corbis stated in oral arguments that it is in the business of selling copyrights which it legitimately owns. Corbis even warns customers that they must refrain from using the copyrights in a commercial manner unless they get

permission from the subjects in the photos. What Corbis omits however, is that it itself is selling a product, copyrights, and promoting such copyrights by use of another's image without the other's consent. The copyrights themselves consist merely of the picture. Clearly a picture derives at least some of its value from what it depicts. In the case of a picture of Brown, there can be no question at least some of the total value of the picture derives from the fact that Brown is depicted in the picture. Thus, the sale of such a picture without Brown's approval could constitute in itself a violation of Brown's right of publicity. As counsel for Corbis pointed out in oral arguments however, a ruling finding *any* sale of a picture depicting a person without that person's approval could have dramatic consequences. Despite the many exemptions listed in the Act and derived from the Constitution, the free flow of information often depends on a long chain of entities which do not all operate under the exemptions per se, but more so operate as facilitators. To find any or all entities liable in such a chain, which begins with a photographer and goes all the way to a newspaper, is not reasonable. Therefore, each individual sale must be analyzed to determine whether, as the court in Groucho Marx Prods. v. Day & Night Co. explained, the use of Brown's image is mostly being used for commercial purposes or if it primarily being used "to promote the dissemination of thoughts, ideas or information". 523 F. Supp. 485, 492 (S.D.N.Y. 1981). Every time a picture of Brown is sold, it could either (1) end up being used for legitimate purposes authorized under the Act, such as a newspaper article, or (2) it may be used for legitimate commercial purposes if the buyer receives Brown's authorization for the commercial purposes, or (3) it may be used for illegitimate commercial purposes if the buyer does not get authorization from Brown and uses his image commercially, or finally (4) it may not be used for any purpose other than mere ownership by the buyer. These four scenarios more or less describe all possible uses in which Corbis customers could use the pictures of Brown. This Court finds that under the last two, Brown's rights of publicity are violated because Brown receives no compensation from the unauthorized commercial use of his image. The question remains if Corbis can be held liable in such situations.

Under the fourth scenario above, a purchaser buys a photo of Brown from Corbis and merely uses it for himself or herself. According to Corbis, such a scenario is fine because Corbis sold what it rightfully owned: a photo. What Corbis omits however is that the value of the photo was, at least in part, derived from Brown being in the photo. Corbis in such a scenario has violated Brown's right of publicity by profiting from Brown's image. See id. Whatever value

was added to the photo because of Brown's presence in it was never paid to Brown, yet the customer paid for the photo and presumably has thus paid the value in question as part of the total price. Because the customer's use of the photo is not one exempted by the Act nor by the Constitution, the sale to such a customer violates Brown's right of publicity. As Brown has alleged that Corbis sells photos of Brown commercially, Brown's claim falls correctly under the scope of the Act.

The analysis turns next to the third scenario discussed above, where the buyer of a Brown picture purchased from Corbis is used for commercial purposes without Brown's permission. In such a case, Corbis has argued it is exempt from liability because it warns customers that they are not allowed to use the photos commercially without Brown's consent. There can be no question Corbis does give notice to customers about the legal implications behind the images it sells. See Corbis' Memorandum in Support of its Motion to Dismiss Plaintiff's Amended Complaint at Exhibit B. Corbis thus believes that Brown should sue the customers who breach his right of publicity, not Corbis. Brown on the other hand believes that Corbis must be held liable because Corbis "knows" that customers use the photos illegally. Though such a "knowledge" has yet to be proven, if in fact Corbis knowingly sells photos to customers who will use them commercially without Brown's consent, Corbis *may* be liable for such sales (emphasis added). In A & M Records, Inc. v. Napster, Inc., the court was faced with a defendant who also had warned its customers not to use the defendant's web site for illegal purposes, but many customers still did. 114 F.Supp.2d 896 (9th Cir. 2001). Despite the warnings, the Napster Court still held Napster liable because Napster could not simply "turn a blind eye to detectible acts of infringement". Id. In the case at hand, it is yet to be determined if acts of infringement have been committed by customers of Corbis', and it is yet to be determined whether, if such acts were committed, such acts were *detectible* by Corbis (emphasis added). However, Brown does allege that Corbis knows that some of its customers use its photos illegally and therefore, this Court should allow the case to proceed to discovery to enable Brown to gather further proof for its allegations.

Public Policy

Corbis, in oral arguments and in its briefs, has argued it warns its customers that they must get permission from Brown before using his pictures for commercial purposes. Corbis made several compelling public policy arguments, mainly pointing to the drastic consequence

placing the burden of enforcement on it instead of the public figures who are seeking compensation for use of their image might cause. This concern does not stand unilaterally however, because currently the burden is on Brown to enforce his right of publicity. Corbis is alleged to charge different prices for pictures it sells for commercial use and pictures it sells for informational purposes protected by the first amendment. Therefore, it seems Corbis can distinguish between the two categories of customers. As explained above, *all* commercial purchases are subject to a right of publicity claim (emphasis added). Corbis currently warns such commercial customers that they must obtain permission from Brown to use the pictures, but it is alleged that some ignore the warning. The question Corbis has raised is who should police such customers' use, and this Court finds that Corbis would be in a more logical position to enforce their own customers' usage of the pictures. Requiring Brown to police such sales would either force Brown to continually probe the market place for illegal use of his image, or would require that Corbis give Brown access to the names of their commercial customers so that Brown can police the customers himself. If all commercial sales involve a right of publicity anyway, Corbis should be able to easily remedy the problem of illegal commercial use of Brown's pictures by requiring all commercial customers to obtain Brown's permission to use the pictures prior to purchasing the pictures from Corbis. Corbis could also obtain Brown's permission itself in cases where its customers mirror the fourth scenario described above, where the customer buys the picture for personal use and Corbis becomes the commercial seller. At this early stage in the litigation, these solutions are suggested merely for argumentative purposes against Corbis' public policy point of view.

Furthermore, this Court recognizes that while Corbis may own the copyrights to all of the pictures it sells, when commercial profits are involved, such a right does not trump another's right of publicity. Brown must retain control over his image when his image is used for commercial gains. It has yet to be determined if any of Brown's allegations are true and whether Corbis is liable in any way to Brown, but for purposes of a Motion to Dismiss, this Court finds that the case must proceed.

Conclusion

For all the reasons stated above, this Court finds that it erred when it granted Corbis' motion to dismiss in its Order dated August 6, 2003. The first argument which lead this Court to hold as it did was that Corbis was exempt from liability as a "vehicle of information" under the

First Amendment of the Constitution. Though Corbis may provide a valuable service to consumers, this does not mean that Corbis is necessarily a "vehicle of information" as defined for the exemption to apply. The end users of Corbis' photos include commercial users who clearly fall outside the scope of protection afforded by the First Amendment. The second argument upon which this Court relied in its prior decision was that Brown's rights of publicity were preempted by Corbis' copyright rights. Because this Court based its analysis on inappropriate case law however, this Court's conclusion was incorrect. When Brown's allegations are taken as true as they must, they strongly suggest that Corbis may be liable for either directly violating Brown's rights of publicity, or indirectly "turning a blind eye" to detectible infringements by its customers.

ORDER

WHEREFORE, for all the reasons stated, the Plaintiff's motion to reconsider is **hereby granted**. The Order and Memorandum Opinion dated August 6, 2003, is **hereby reversed**. The Defendant's Motion to Dismiss is **hereby denied**.

Hon. Allen S. Goldberg

ENTERED

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