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Maloney v. T3Media, Inc. 853 F. 3d 1004, (9th Cir. 2017)

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MALONEY V. T3MEDIA, INC.

853 F.3d 1004 (9TH CIR. 2017)

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I. INTRODUCTION

In *Maloney v. T3Media, Inc.*, the United States Court of Appeals for the Ninth Circuit considered whether a claim of statutory and common law right of publicity filed by former NCAA basketball players against a company authorized by the NCAA to sell digital photographs containing the players' image and likeness is preempted by the federal Copyright Act.[1] The claim, filed by Patrick Mahoney and Tim Judge, alleged that T3Media, without their authorization, commercially exploited their likeness, and to a grander extent, all current and former NCAA student-athletes, by selling digital copies of photographs taken by the NCAA during their tenure as college athletes.[2] The District Court for the Central District of California granted T3Media's motion to strike the complaint pursuant to California's anti-SLAPP statute.[3] The District Court held that

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[1] *Maloney v. T3Media, Inc.*, 853 F.3d 1004 (9th Cir. 2017).

[2] *Id.* at 1008.

[3] SLAPPs, or Strategic Lawsuits Against Public Participation, are suits that allege injury as a result of activities involving constitutionally protected free speech. SLAPPs have the effect of intimidating, censoring, and discouraging criticism by burdening critics with the prospect of burdensome and costly litigation. Anti-SLAPP statutes provide courts with the authority to dismiss a suit they deem to be a SLAPP. In the case of California's anti-SLAPP statute, a cause of action arising from a person's actions in furtherance of that individual's constitutionally protected right of petition or free speech in connection with a public issue is subject to a special motion to strike. *See What is a SLAPP?*, PUBLIC PARTICIPATION PROJECT, https://anti-slapp.org/what-is-a-slapp/ (last visited Jun. 14, 2018).

plaintiff's asserted rights were preempted because they fell within the purview and subject matter of the federal copyright laws.[4] The Court of Appeals affirmed the District Court's holding that a right of publicity claim would not be frustrated by federal copyright preemption if the photographs were utilized non-consensually in connection to merchandise or advertising.[5] However, with respect to images utilized or distributed for non-commercial personal use, the Court of Appeals declared such claims would be preempted.[6] In an effort to uncover a viable legal path to circumvent such preemption for individuals seeking proper compensation for the exploitation of their images without their consent, this case offers insight onto the prevailing landscape of copyright law as well as the new uncertain frontier created by this decision.

II. BACKGROUND

Patrick Mahoney and Tim Judge are former college athletes who played NCAA collegiate basketball for the Catholic University men's basketball team from 1997 to 2001.[7] Both men were integral pieces in helping the team win the 2001 Division III Men's Basketball Championship.[8] During the game, the NCAA took a series of photographs documenting the drama and excitement of the victory.[9] The NCAA, which owns or controls the copyright of these images, transferred them into their Photo Library.[10] T3Media, a company which provides services for the management, delivery, and licensing of digital content, contracted with the NCAA in 2012 to license images in the NCAA Photo Library.[11] T3Media would make these photos available for purchase on its website, Paya.com.[12] A

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[4] *Maloney*, 853 F.3d at 1008.
[5] *Id.*at 1016.
[6] *Id.*
[7] *Id.*at 1007
[8] *Id.*
[9] *Id.*
[10] *Maloney*, 853 F.3d at 1007.
[11] *Id.* The Library is a photographic archive and collection recording decades of NCAA championship history, men's and women's, in every division.
[12] *Id.*

buyer could, for the purchase price, obtain a non-exclusive license allowing them to download the photograph.[13] Before confirmation of purchase, the buyer would have to agree to the terms of a "Content License Agreement," which stipulated that the customer could "use a single copy of the image for non-commercial art use."[14] However, the "Content License Agreement" precluded the buyers from obtaining "any right or license to use the name or likeness of any individual (including any athlete, announcer, or coach) appearing in the Content in connection with or as an express or implied endorsement of any product or service."[15] The photos captured during the 2001 championship game are included in T3Media's collection and are all listed for sale on Paya.com.[16]

Plaintiffs, Mahoney and Judge, filed suit in the Central District Court of California in June 2014.[17] Their complaint alleged that T3Media violated California's statutory right of publicity,[18] common law right of publicity,[19] and Unfair Competition Law (UCL).[20] Plaintiffs argued that T3Media, by sale of the photographs depicting their championship victory, commercially exploited their names and likenesses, and to a grander extent, exploited the names, images, and likenesses of all current and former NCAA student-

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[13] *Id.*

[14] *Id.* at 1008

[15] *Id.*

[16] *Maloney*, 853 F.3d at 1008.

[17] *Id.*

[18] Cal. Civ. Code § 3344 "Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of products, merchandise, goods or services, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof."

[19] *Fleet v. CBS, Inc.*, 58 Cal.Rptr.2d 645 (1996). "A common law cause of action for appropriation of name or likeness may be pleaded by alleging (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."

[20] Cal. Bus. & Prof. Code § 17200 "[U]nfair competition shall mean and include any unlawful, unfair or fraudulent business act or practice and unfair, deceptive, untrue or misleading advertising and any act prohibited by Chapter 1 (commencing with Section 17500) of Part 3 of Division 7 of the Business and Professions Code."

athletes without their consent.[21] In response, T3Media argued that the federal Copyright Act preempted the Plaintiffs' claims, to which the district court agreed.[22] On appeal, the Ninth Circuit ruled that Plaintiffs' photo-based publicity-right claim fell within the authority of the United States Copyright Act and was therefore preempted.[23]

III. ANALYSIS

The Court first applied California's anti-SLAPP statute and its two-step analysis to the present case.[24] Here, T3Media succeeded on the first step. It required that T3Media "make a prima facie showing that the Plaintiff's suit arose from an act in furtherance of the defendant's constitutional right to free speech." [25] The Court recognized that Plaintiffs' grievance stemming from T3Media's right to expression through the reproduction, public display, and distribution of their captured photographs fell under the purview of T3Media's First Amendment rights and thus satisfied the first step. Step two transfers the burden to Plaintiffs to show that it has a "reasonable probability that it will prevail on its claims." [26] This issue lies at the heart of the Court's decision, ruling that Plaintiffs could not reasonably prevail because their claims were preempted by Section 301 of the federal Copyright Act.[27]

Preemption under Section 301 of the Copyright Act

Section 301 of the Act was designed "to preempt and abolish any rights under the common law or statutes of a State that are equivalent to copyright" and that come "within the scope of the Federal copyright law." [28] To accomplish this goal, a two part test

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[21] *Maloney*, 853 F.3d at 1008.
[22] *Id.*
[23] *Id.* at 1016.
[24] Cal. Civ. Proc. Code § 425.16 (2014).
[25] *Makaeff v. Trump Univ., LLC*, 715 F.3d 254, 261 (9th Cir. 2013).
[26] *Id.*
[27] *Maloney*, 853 F.3d at 1010.
[28] H.R. REP. No. 94-1476, at 130 (1976).

has been adopted.[29] Step one is designed to ascertain whether the subject matter of the state claim falls within the subject matter of copyright, while step two determines whether the rights asserted under state law are equivalent to the rights of copyright holders.[30]

1.Step One. – The Subject Matter of the State Law Claims Falls Within the Subject Matter of Copyright.

Plaintiffs argued that their right of publicity claim has standing due to the fact that photographs like the ones at issue inherently depict the likeness of an individual, such that capturing that likeness in a photograph would be to capture the individual's "persona."[31] They assert that their publicity-right claim protects against exploitation of such photographs.[32] Further, Plaintiffs maintain, those physical characteristics exist temporally and spatially outside of the medium of the photograph and therefore cannot be fixed in a copyrightable format and thus by their nature exist outside of the scope of the Copyright Act.[33] However, in spite of this argument, the Court held that determination of a publicity-right claim does not derive from the content of the work at issue, but rather in the way in which that work is used.[34]

The Circuit Court clarified this view by distinguishing it from a prior case.[35] In *Downing v. Abercrombie & Fitch*,[36] the court determined that a publicity-right claim was not preempted in the situation where the defendant purchased photographs containing the plaintiff's likeness, without the plaintiff's permission, and used them to advertise t-shirts in a shopping catalog.[37] The court held that "when the 'use' of a likeness forms the 'basis' of a publicity-right

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[29] *Maloney*, 853 F.3d at 1010 (*citing* Laws v. Sony Music Entm't, Inc., 448 F.3d 1137 (9th Cir. 2006)).
[30] *Id.* at 1010.
[31] *Id.*
[32] *Id.*
[33] *Id.*
[34] *Id.*at 1012.
[35] *Maloney*, 853 F.3d at 1012-13.
[36] Downing v. Abercrombie & Fitch, 265 F.3d 994 (9th Cir. 2001).
[37] *Id.* at 1000.

claim, the claim is not preempted."[38] *Downing* focused on the manner in which the plaintiff's personas were injured by the unauthorized commercial exploitation of the plaintiff's likeness in the catalog rather than the publication of the photograph itself.[39] The Ninth Circuit held, "the distinction pertinent to the preemption of a publicity-right claim is not the type of copyrightable work at issue, but rather the way in which one's name or likeness is affected by the use of the copyrighted work."[40] The Court expressly maintained that a publicity-right claim is not preempted if the likeness of an individual is captured and used without permission for the purposes of merchandise or in advertising.[41] However, in instances where the captured likeness is being utilized only for personal use, then the claim falls under the subject matter of the Copyright Act and will be preempted.[42] For T3Media, the Court explained, licensing of Plaintiffs' photographs fell under non-commercial personal use and not in connection to any merchandise or advertising.[43] Therefore, T3Media's use fell under the ambit of the Copyright Act and Plaintiff's publicity rights claims were preempted.[44]

A.Statutory Text and Precedent

Plaintiffs cite to *Fleet v. CBS Inc.* in their attempt to create a distinction between likenesses in photographs and likenesses in other copyrightable works, such as dramatic performances in films.[45] They believe that Fleet provides a loophole for publicity-right claims to escape copyright preemption.[46] However, the Ninth Circuit is quick to point out that Plaintiff's likeness in Fleet fell within the boundaries of the copyrighted material and never strayed from those boundaries.[47] As such, no right of publicity issue existed. The

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[38] *Maloney*, 853 F.3d at 1012 (*citing Downing*, 265 F.3d at 1003-04).
[39] *Id.* at 1013.
[40] *Id.*
[41] *Id.* at 1011.
[42] *Id.*
[43] *Id.*
[44] *Maloney*, 853 F.3d at 1011.
[45] *Id.* 1014.
[46] *Id.*
[47] *Maloney*, 853 F.3d at 1014-15.

content of the work was not the concern, but rather how one's likeness is affected by the use of the copyrighted material.[48]

Additionally, Plaintiffs referred to *Laws v. Sony Music Entm't, Inc.* to further illustrate a distinction between those performances captured in other copyrightable works, in this case sound recordings.[49] Plaintiffs insist that a discrete delineation should exist between publicity right claims based on photographs and those of other works under the subject matter of and protected by the Copyright Act.[50] Their main contention is that "unlike a performance, a person's mere likeness is not a copyrightable contribution to a photograph." [51] As in *Fleet* however, the Circuit Court rejected this division between photographs and dramatic works, returning to the idea that "the distinction pertinent to the preemption of a publicity-right claim is not the type of copyrightable work at issue, but rather the way in which one's name or likeness is affected by the use of the copyrighted work."[52]

In particular, the Court cited its recent decision in *Jules Jordan Video, Inc. v. 144942 Canada Inc.* where it ruled that the plaintiff's publicity-right claims were preempted by the Copyright Act. [53] The Plaintiff's claim that his name and persona were misappropriated rested solely on the fact that his objection was to the unauthorized replication and distribution of his copyrighted work, in this case the counterfeit DVDs, and "not the exploitation of his likeness on an unrelated product or in advertising." [54] The court held that the Plaintiff's assertion, that the images of his likeness on the covers of the counterfeit DVDs amounted to a publicity-right violation, could not succeed because the images on the covers themselves depict screenshots from the copyrighted work. [55]

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[48] *Id.* at 1015.
[49] *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1137 (9th Cir. 2006).
[50] *Maloney*, 853 F.3d at 1013.
[51] *Id.*
[52] *Id.*
[53] *Jules Jordan Video, Inc. v. 144942 Canada Inc.*, 617 F.3d 1146 (9th Cir. 2010)
[54] *Maloney*, 853 F.3d at 1015-16.
[55] *Id.* at 1016.

These cases serve to provide the precedent and authority for the Circuit Court to establish the rule they have set forth here, that publicity-right claims relating to images utilized in connection with merchandise or advertising would not be preempted by the Copyright Act, but claims regarding images used for non-commercial personal use would be.[56] With respect to T3Media, the Court ruled that due to defendant's actions of simply licensing the copyrighted photographs for a non-commercial purpose, and not in association with any merchandise or advertising purposes, Maloney's right-of-publicity claims interfered with and were preempted by the NCAA's exclusive right to control its copyrighted works.[57]

Persuasive Authority

The Circuit Court turns to decisions made by other circuits to bolster its holding in the present case. A Third Circuit case, *Facenda v. N.F.L. Films, Inc.* involved the defendant repurposing copyrighted clips, of which the plaintiff had lent his voice to narrate, for the purpose of placing them in a television production for a football video game.[58] The Third Circuit found that publicity-right claims are not preempted when a defendant utilizes the copyrighted works "for the purposes of trade."[59] It will be preempted, the court continued, in instances where the defendant's use of the copyrighted works amount to be "expressive works."[60] Applying this, the Third Circuit held that the defendant utilized the narrated clips for purposes of trade, in this case a television production intended for the promotion and advertising of a video game, and therefore was not preempted.[61]

In *Ray v. ESPN, Inc.*, the Eighth Circuit ruled that the plaintiff's publicity-right claim was preempted because it fell directly under the scope of the Copyright Act.[62] The plaintiff, a professional wrestler, asserted that the filming of his matches by the defendant

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[56] *Id.*
[57] *Id.*
[58] *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007 (3rd Cir. 2008).
[59] *Id* at 1016-17.
[60] *Id.* at 1016.
[61] *Id.* at 1016-17.
[62] *Ray v. ESPN, Inc.*, 783 F.3d 1140 (8th Cir. 2015)

violated his right to publicity.[63] The Eight Circuit rejected this argument, holding that filming of the plaintiff's matches created a copyrightable work and that because the defendant did not utilize the plaintiff's likeness for purposes of advertisement the publicity-right claim was preempted.[64]

In 2016, the Eight Circuit held in *Dryer v. National Football League* that the plaintiff's publicity right claims fell within the scope of the Copyright Act and therefore was preempted.[65] The plaintiff NFL players contended that use of game footage which featured them in several NFL films, which in turn were licensed and broadcast to the public, violated their right to publicity.[66] The Eight Circuit ruled that the Copyright Act expressly recognizes fixed recordings of live performances.[67] It stated that a publicity-right suit that "challenges the expressive, non-commercial use of a copyrighted work ... seeks to subordinate the copyright holder's right to exploit the value of that work to the plaintiff's interest in controlling the work's dissemination."[68]

Decisions from other circuits combined with the precedents in the Ninth Circuit only provide more weight to the court's determination in disallowing Plaintiffs' right of publicity claim to pass through.[69] The Ninth Circuit's decision relies on the belief that they are striking a balance in giving athletes the opportunity to take charge of the use of their names or their likeness in connection to any merchandise or advertising, while simultaneously affording others the privilege of utilizing otherwise culturally important photos and images for purposes of expression.[70] The Court rejects Plaintiffs' argument stating this "would give the subject of every photograph a de facto veto over the artist's rights under the Copyright Act, and

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[63] *Id.* at 1017.
[64] *Id.*
[65] *Dryer v. National Football League*, 814 F.3d 938 (8th Cir. 2016).
[66] *Id.* at 1017.
[67] *Id. (citing Dryer,* 814 F.3d at 942).
[68] *Id.* (*citing Dryer*, 814 F.3d at 943).
[69] *Maloney*, 853 F.3d at 1016, 1018.
[70] *Id.* at 1019.

destroy the exclusivity of rights that Congress sought to protect by enacting the Copyright Act"[71]

2.Step Two – The Rights Plaintiffs Assert Are Equivalent to Rights Within the General Scope of Copyright.

The second step of the test requires a determination of whether the rights asserted under state law were equivalent to the rights contained in 17 U.S.C. § 106.[72] Here the Circuit Court found that Plaintiffs waived any argument that their rights of publicity are not equivalent to rights within the scope of copyright.[73] Plaintiffs did not raise this issue and therefore the court did not rule on it.[74] However, as a thought exercise, had Plaintiffs raised the issue, the Ninth Circuit nevertheless would have found that the rights asserted were equivalent to the rights within the scope of the Copyright Act.[75] Additionally, the Court ruled that none of the claims presented by Plaintiffs, statutory and common law right-of-publicity claims, as well as a violation of California's Unfair Competition Law were any different from a claim of copyright.[76]

IV. FUTURE IMPLICATIONS

In theory, the test the Ninth Circuit has adopted seems very straightforward: an individual's right of publicity claim will not be preempted by federal copyright law if the individual's name or likeness is contained in a copyrighted work intended for merchandise or advertising.[77] Conversely, on the occasion that the individual's name or likeness is embodied in a copyrighted work that is intended only for personal, non-commercial use, then the individual's right of publicity claim will be preempted by federal copyright law.[78] In the

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[71] *Id.*
[72] *Id.*
[73] *Id.*
[74] *Id.*
[75] *Maloney*, 853 F.3d at 1019.
[76] *Id.*
[77] *Id* at 1016.
[78] *Id.*

present case, application of this test seems simple enough. T3Media, in allowing customers to download and pay for images and photographs of NCAA athletics, believe that those consumers will have done so purely for the sake of having an image or photograph that commemorates an exciting and thrilling memory that they may have experienced.[79]

However, in applying the test in practice, in cases where the facts are less clear-cut, litigants will inevitably have more questions than answers.[80] In particular, the decision refers to "merchandise" without any definite definitions as to what could or should be considered as such.[81] T3Media offers images of these copyrighted works digitally. However, will the test be applied differently to a website, similar in nature to T3Media, if it mails a physical copy of the image? Would this be considered merchandise under the language of the court's test? [82] In that scenario, an individual customer could simply be purchasing a poster of their favorite college athlete to place on their wall, thereby fulfilling the personal, non-commercial use factor.[83] However, it could be equally conceivable that a sporting goods company used an agent to buy hundreds of posters with the intent of selling those copyrighted posters in their stores.[84] In such a case, both individuals could purchase the images at the same time, intending to use them for wildly different purposes.[85] Under the eyes of the test adopted by the Ninth Circuit, the retailer selling those copyrighted images cannot wear both hats.[86] If they could, then

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[79] *Id.* at 1007.

[80] 9th Circ. Ruling Generates Copyright Preemption Confusion, LAW360 (Apr. 20, 2017),https://www.cov.com//media/files/corporate/publications/2017/04/9th_circ_ruling_generates_copyright_preemption_confusion.pdf.

[81] *Id.*

[82] *Id.*

[83] *Id.*

[84] *Id.*

[85] *Id.*

[86] Jennifer E. Rothman, *Copyright Law Blocks Student-Athlete Suit over Sale of Game Photos*, ROTHMAN'S ROADMAP TO THE RIGHT OF PUBLICITY, https://www.rightofpublicityroadmap.com/news-commentary/copyright-law-blocks-student-athlete-suit-over-sale-game-photos (last visited Apr. 22, 2018).

Maloney and Judge could have continued on with their right of publicity claims.[87]

Additionally, a copyright holder of these images now also has to answer the question of whether they can sell derivative works of the photographs.[88] If tangible, physical copies of the images, such as posters, cause this much confusion, what happens in instances where the copyright holders desire to produce and sell derivative works, such as clothing, sports equipment, school supplies, and the like?[89] If the NCAA wished to stamp basketballs with the image of the NCAA national championship team, does this count as selling for a personal, non-commercial use, as in the case of the elementary school basketball player practicing with the ball dreaming of becoming a college athlete? Or is it intended for merchandise at your local Dick's Sporting Goods or your local FootLocker, or to advertise for the following year's NCAA basketball tournament? [90] These are the questions that will soon emerge in the landscape of litigation regarding claims of right of publicity.

V. CONCLUSION

The Ninth Circuit, in its decision in *Maloney v. T3Media*, attempts to find a balance in affording athletes control of the use of their image and likeness while equally protecting the owners of photographic works.[91] In applying the preemption test, the Ninth Circuit ruled that both prongs of the test were satisfied.[92] The subject matter of the California state claim of right of publicity fell within the subject matter of federal copyright law. And additionally, the rights asserted under the state law were equivalent to the rights within the scope of the Copyright Act, and thus Plaintiff's claim of right of publicity was preempted by federal copyright law.[93]

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[87] *Id.*
[88] *Id.*
[89] *Id.*
[90] *Id.*
[91] *Maloney*, 853 F.3d at 1019.
[92] *Id. at* 1020.
[93] *Id.*

In effect, the main victors to come out of this decision are the various sports leagues and their media partners.[94] This decision affords them greater protection in cases of athletes desiring greater control over the copyrighted images of their likeness.[95] It now becomes increasingly difficult and confusing for future athletes to succeed on claims of right of publicity as the ambit and strength of federal copyright preemption has increased.[96]

[94] Eriq Gardner, *College Athletes Dealt New Setback in Bid to Be Compensated for Visual Media*, HOLLYWOOD REPORTER, https://www.hollywoodreporter.com/thr-esq/college-athletes-dealt-new-setback-bid-be-compensated-visual-media-991375 (last visited Apr. 22, 2018).
[95] *Id.*
[96] *Id.*