

NOT TO BE PUBLISHED IN THE OFFICIAL REPORTS

California Rules of Court, rule 8.1115(a), prohibits courts and parties from citing or relying on opinions not certified for publication or ordered published, except as specified by rule 8.1115(b). This opinion has not been certified for publication or ordered published for purposes of rule 8.1115.

IN THE COURT OF APPEAL OF THE STATE OF CALIFORNIA
SECOND APPELLATE DISTRICT
DIVISION FIVE

VICTORIA VOGEL,

Plaintiff and Appellant,

v.

C. CASEY BENNETT et al.,

Defendants and Respondents.

B207248

(Los Angeles County
Super. Ct. No. BC352438)

APPEAL from an order of the Superior Court of Los Angeles County, James C. Chalfant, Judge. Reversed.

Fredman Lieberman, Howard S. Fredman, Marc A. Lieberman, and Alan W. Forsley for Plaintiff and Appellant.

The Avanzado Law Firm and Melvin N.A. Avanzado for Defendants and Respondents C. Casey Bennett, Bennett Productions, Inc., Bennett Media Worldwide, LLC, Guba, Inc., KTLA, Inc., and Veoh Networks, Inc.

Lewis Brisbois Bisgaard & Smith and Ryan D. Harvey for Defendant and Respondent HDNet, LLC.

I. INTRODUCTION

Plaintiff, Victoria Vogel, appeals from a summary judgment entered in favor of defendants, C. Casey Bennett, Bennett Productions, Inc., Bennett Media Worldwide, LLC (Mr. Bennett and his companies), Guba, Inc., HDNet, LLC, and Veoh Networks, Inc. Summary judgment was entered on the ground that plaintiff's claims for: common law privacy invasion–misappropriation of name and likeness; statutory right of publicity (Civ. Code, § 3344, subd. (a)); and unfair competition (Bus. & Prof. Code, § 17200) were preempted by the United States Copyright Act. (17 U.S.C. §§ 101-1332.¹) We conclude the trial court erred in granting summary judgment on preemption grounds because plaintiff's name and likeness claims are not the subject matter of copyright law.

II. BACKGROUND

A. The Fourth Amended Complaint

The fourth amended complaint is the operative pleading. The fourth amended complaint contains causes of action for: privacy invasion on a misappropriation of name and likeness theory (first); violation of Civil Code section 3344 subdivision (a) (second); and unfair competition (Bus. & Prof. Code, §§ 17200 & 17203) (third). The fourth amended complaint alleges that Mr. Bennett and his companies produced videos and digital video discs of bikini-clad women filmed at various exotic locations. Plaintiff is a model and spokesperson in many of the videos but never gave defendants consent to sell or merchandise her images in any way. Plaintiff participated in the filming and was willing to give consent to use of her image but only if number of conditions precedent were satisfied. The conditions included: plaintiff's editorial and final approval over

¹

All further statutory references are to title 17 of the United States Code unless otherwise indicated.

contents; plaintiff's use of the footage; and a mutual agreement granting plaintiff's corporations joint ownership and control of the production, marketing, distribution and sale of the videos. The conditions were never satisfied; so that plaintiff never consented to the use of her name, voice, signature, photograph, or likeness by Mr. Bennett and his companies.

Plaintiff alleged that her privacy rights were violated when defendants used her likeness in videos, advertising, and programs aired on television and by selling her image on wallpaper on cellular phones. Defendants are alleged to have used plaintiff's likeness in promotional tapes to advertise "Bikini Destinations" ("the program") and Mr. Bennett's companies. Defendants are also alleged to have, without plaintiff's consent, marketed her name and downloadable photographs of her likeness to cellular phones and the Bikini Destination film series to various Internet Web sites. Plaintiff sought damages, injunctive relief, and attorney fees. The injunctive relief language requests: "[A] permanent injunction enjoining C. Casey Bennett and Bennett Productions, Inc. from using, exploiting, selling or publicizing [plaintiff's] name, voice, signature, photograph or likeness, or any product, service or other media containing [plaintiff's] name, voice, signature, photograph or likeness."

B. The Summary Judgment Motion

1. The Undisputed Facts

After answering the fourth amended complaint, defendants filed a summary judgment motion on the theory plaintiff's claims were preempted by the Copyright Act and she consented to defendants' use of her name and likeness. In their papers, the parties agreed that the following facts were undisputed. The program generally features bikini clad models in various exotic locations. What the parties characterize as the "Program," began airing in 2002 and has over 30 episodes. Plaintiff appears as a model and spokesperson in some of the episodes. Plaintiff received producer and other credits

in an episode entitled “Fantasy.” Mr. Bennett and his companies do not actually broadcast the program. To promote the program, Mr. Bennett and his companies maintained the Web site www.bikinidestinatons.tv. The Web site contained a description of the program. The Web site also allowed visitors to download the models from the program as cellular phone wallpaper for \$1.99. Three pictures of plaintiff are available for download at the Web site. The pictures were obtained for the Web site by manipulating footage of the “Lake Powell” episode to obtain a still image.

Mr. Bennett and his companies license the program to various media outlets such as HDNet, LLC and KTLA. HDNet, LLC is a cable network which broadcasts in high definition. Pursuant to the license agreement, HDNet has broadcast the program since 2002. Some of the episodes feature plaintiff. HDNet sells digital video discs of certain episodes through its on-line store which features plaintiff. HDNet, LLC has not made any other use of plaintiff name or likeness.

KTLA aired the “Bahamas” episode of the program which was re-cut from the high definition version. The KTLA version featured a promotional advertisement for the www.bikinidestinatons.tv Web site and the cellular phone wallpaper downloads available at the Web site. KTLA did not participate in the wallpaper sales nor make any use of plaintiff’s name or likeness other than broadcasting the program.

Mr. Bennett and his companies also license the program to Web sites. Guba, Inc. and Veoh Networks, Inc. operate Internet Web sites that allow for the download or viewing of videos. Both have licenses from Mr. Bennett and his companies to distribute or display the program. Plaintiff’s name and likeness are available in episodes made available for purchase. Web site users can view clips or thumbnail images of episodes from the program prior to purchase. Neither Guba, Inc. nor Veoh Networks Inc. sells plaintiff’s image as wallpaper or makes any use of her image apart from distributing episodes of the program.

2. Additional facts and evidence in support of the summary judgment motion

In support of the summary judgment motion, defendants argued the following additional facts were undisputed. Mr. Bennett and his companies are the producers and distributors of the program “Bikini Destinations.” Mr. Bennett and his companies obtained the copyright registrations for the program from the United States Copyright Office.

Defendants asserted that the following facts established that plaintiff had consented to their use of her name and likeness. Prior to filing this action, plaintiff ran a paid subscription Web site that offered various pictures of models including her. As early as March 2004, plaintiff sold digital video discs of the program in which she appeared. Advertisements from her Web site noted an appearance in the “Lake Powell” episode. Plaintiff sold a total of 67 digital video discs through the Web site and kept \$1,262.20 in income. Plaintiff also maintains a “MySpace” Web site which features pictures of herself through a slideshow. The images displayed are from the “Bahamas” episode of the program.

3. Plaintiff’s Opposing Evidence and Argument

In opposition to the summary judgment motion, plaintiff declared that she created the legal entities of VV Sterling Corporation and the BikiniNetwork.com, Inc. In early 2000, plaintiff conceived and sketched out ideas for producing two television shows—a hosted show entitled “Playing in Paradise” and a non-hosted show entitled “Bikini Destinations.” The premise of both shows was to have bikini-clad models filmed in exotic locations. In February 2000, Mr. Bennett asked plaintiff if he and his production company could assist her and VV Sterling Corporation in the production of the “Bikini Destinations” and “Playing in Paradise” programs by providing still photography and video services. Plaintiff and Mr. Bennett entered into a joint venture to film the programs she had conceived, developed, and created. The joint venture would consist of their

entities, VV Sterling Corporation and Bennett Productions, Inc. Plaintiff would serve as executive producer and director and would provide creative services. Bennett Productions, Inc. would provide the production and editing equipment and supply Mr. Bennett as a camera operator.

On February 6, 2000, VV Sterling Corporation purchased the domain names and created Web sites for “Bikini Destinations.com” and “Bikini Destinations.net.” VV Sterling Corporation paid costs and expenses for pre-production work for: casting; travel, food and lodging expenses; securing photographers, makeup artists, and costumers; scripts; camera direction; set arrangement; and permits, licenses and locations releases. It was agreed that the joint venture would reimburse VV Sterling Corporation for the expenses. On March 20, 2000, plaintiff began the trademark registration process for “BikinDestinations.net”; “BikiniDestinations.com”; and “TheBinkinNetwork.com.”

Plaintiff is a model, spokesperson, and actress and received credits in four “Bikini Destinations” films entitled: “On Location in Bahamas”; “Lake Powell”; “Fantasy”; and “California Dream’in [Series.” Plaintiff also created, produced, hosted, and was a model in “Playing in Paradise.” Plaintiff denied ever giving consent to Mr. Bennett and his companies to sell or merchandise her name, voice, image likeness, or any aspect of her identity. Plaintiff declared that she participated in the filming of the programs and was willing to give consent to the use of her image by the joint venture. However, her consent was conditioned on the joint venture giving her editorial and final content approval and permitting her to use the footage. According to plaintiff, without her consent her name and likeness: have been used by Mr. Bennett and his companies and KTLA to market downloadable photographs and to cellular phones; advertised and sold by Mr. Bennett and his companies, Gold Pocket and T-Mobile; have been used by Mr. Bennett and his companies and VEOH Networks, Inc. to advertise that the “Bikini Destinations” films may be downloaded from the Internet for \$1.99 per film; and have been used by HDNet LLC for advertising and viewing. Plaintiff had not understood that her likeness and the programs were being exploited for the benefit of the joint venture

until she learned that Mr. Bennett and his companies had registered the copyright for the program in their own name.

Plaintiff admitted selling digital video discs on her Web sites but argued the funds were being kept for the joint venture. Plaintiff also declared that some of the images on her Web site and on the Web sites licensed by Mr. Bennett and his companies contained images from “Playing in Paradise.” According to plaintiff, “Playing in Paradise” was created by the joint venture. “Playing in Paradise” is not copyrighted. However, “Playing in Paradise” is licensed by Bennett Media Worldwide, LLC.

4. The Summary Judgment Ruling

Relying principally on *Fleet v. CBS, Inc.* (1996) 50 Cal.App.4th 1911, 1918-1924, the trial court ruled plaintiff’s claims were preempted by the Copyright Act. The trial court ruled: the episodes containing plaintiff’s performances in the “Bikini Destinations” are copyrightable; the lawsuits seek to control distribution of the program; plaintiff consented to the use of her name and likeness in the episodes where she performed; and the performances are within the scope or subject matter of the Copyright Act. With respect to the ownership issue, the trial court ruled: defendants presented prima facie evidence of ownership of the program; plaintiff did not present evidence that she personally owned the copyright; and the copyright ownership issue was preempted. The trial court further ruled that plaintiff had only suggested that some of the still images were from “Playing in Paradise” and “Hawaiian Tropic” but had not presented any evidence to support this assertion. The trial court held the name and likeness claims for advertising and wallpaper cellular phone downloads were protected as a derivative work. The trial court rejected the contention that it was not a derivative work because it was being sold as merchandise such as a t-shirt, playing cards, pens, or paper weights, and the like. The trial court stated: “The distinction is that cell phone wallpaper is nothing more than a picture from the protected work and directly protected by section 106. The fact that the image is contained in an electronic file, rather than printed on a piece of

photographic paper, is of no moment. The Bennett Defendants merely displayed and sold individual images taken directly from the copyrighted Bikini Destinations program as part of the promotion of that program. They did not create unrelated new merchandise with those photos, which arguably would not be protected derivative works.”

In response to plaintiff’s new trial motion the trial court ruled it had jurisdiction to decide who owned the copyright interest. The trial court denied reconsideration of the remaining issues, refused plaintiff’s stay request, and entered summary judgment. This timely appeal followed.

III. DISCUSSION

A. Standard of Review

In *Aguilar v. Atlantic Richfield Co.* (2001) 25 Cal.4th 826, 850-851, our Supreme Court described a party’s burdens on summary judgment or adjudication motions as follows: “[F]rom commencement to conclusion, the party moving for summary judgment bears the burden of persuasion that there is no triable issue of material fact and that he is entitled to judgment as a matter of law. That is because of the general principle that a party who seeks a court’s action in his favor bears the burden of persuasion thereon. [Citation.] There is a triable issue of material fact if, and only if, the evidence would allow a reasonable trier of fact to find the underlying fact in favor of the party opposing the motion in accordance with the applicable standard of proof. . . . [¶] [T]he party moving for summary judgment bears an initial burden of production to make a prima facie showing of the nonexistence of any triable issue of material fact; if he carries his burden of production, he causes a shift, and the opposing party is then subjected to a burden of production of his own to make a prima facie showing of the existence of a triable issue of material fact. . . . A prima facie showing is one that is sufficient to support the position of the party in question. [Citation.]” (Fns. omitted, see *Kids’ Universe v. In2Labs* (2002) 95 Cal.App.4th 870, 878.) We review the trial court’s

decision to grant the summary judgment motion de novo. (*Johnson v. City of Loma Linda* (2000) 24 Cal.4th 61, 65, 67-68; *Sharon P. v. Arman, Ltd.* (1999) 21 Cal.4th 1181, 1188, disapproved on another point in *Aguilar v. Atlantic Richfield Co., supra*, 25 Cal.4th at p. 853, fn. 19.) The trial court’s stated reasons for granting summary judgment are not binding on us because we review its ruling not its rationale. (*Continental Ins. Co. v. Columbus Line, Inc.* (2003) 107 Cal.App.4th 1190, 1196; *Dictor v. David & Simon, Inc.* (2003) 106 Cal.App.4th 238, 245.) In addition, a summary judgment motion is directed to the issues framed by the pleadings. (*Turner v. Anheuser-Busch, Inc.* (1994) 7 Cal.4th 1238, 1252; *Ann M. v. Pacific Plaza Shopping Center* (1993) 6 Cal.4th 666, 673, superseded by statute on alternative grounds as stated in *Saelzler v. Advanced Group* (2001) 25 Cal.4th 763, 767.) Those are the only issues a motion for summary judgment must address. (*Goehring v. Chapman University* (2004) 121 Cal.App.4th 353, 364.)

B. The Copyright Act

The Copyright Act protects the rights of copyright owners. (*Laws v. Sony Music Entertainment* (9th Cir. 2006) 448 F.3d 1134, 1137, 17 U.S.C. §106) Section 106² of the Copyright Act confers a bundle of exclusive rights to the owner of the copyright including the rights to publish, copy, prepare derivative works, perform, distribute, or

²

Section 106 provides: “Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following: [¶] (1) to reproduce the copyrighted work in copies or phonorecords; [¶] (2) to prepare derivative works based upon the copyrighted work; [¶] (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending; [¶] (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; [¶] (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and [¶] (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.”

display the protected work. (*Harper & Row Publishers, Inc. v. Nation Enterprises* (1985) 471 U.S. 539, 546-547; see *Dowling v. United States* (1985) 473 U.S. 207, 216-217.) In addition, federal law preempts any state cause of action which arises under the federal Copyright Act. (§301³; *Laws v. Sony Music Entertainment, supra*, 448 F. 3d at p. 1137; *Maljack Prods. v. GoodTimes Home Video Corp.* (9th Cir. 1996) 81 F.3d 881, 888.) Federal courts have exclusive jurisdiction over actions that arise under Copyright Act. (28 U.S.C. § 1338(a)⁴; *Laws v. Sony Music Entertainment, Inc., supra*, 448 F.3d at pp. 1137-1138.) The Copyright Act exclusively governs a complaint when the work being

³ Section 301 states in part: “(a) On and after January 1, 1978, all legal or equitable 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, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State. [¶] (b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to-- [¶] (1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or [¶] . . . (3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106; or”

⁴ Title 28 United States Code section 1338 states: “(a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases. [¶] (b) The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent, plant variety protection or trademark laws. [¶] (c) Subsections (a) and (b) apply to exclusive rights in mask works under chapter 9 of title 17, and to exclusive rights in designs under chapter 13 of title 17, to the same extent as such subsections apply to copyrights.”

challenged falls within the types of works protected by copyright laws. (§§ 102⁵ & 103⁶.) An additional component of Copyright Act presumption occurs when a claim seeks legal and equitable rights which are equivalent to one of the exclusive rights protected by copyright rights laws. (§ 106; *Kabehie v. Zoland* (2002) 102 Cal.App.4th 513, 520; *KNB Enterprises v. Matthews* (2000) 78 Cal.App.4th 362, 369.) We have held “[A] right that is ‘equivalent to copyright’ is one that is infringed by the mere act of reproduction, performance, distribution, or display. If the act of reproduction, performance, distribution or display will in *itself* infringe the state-created right, then such right is preempted. [Citation.] Such a state right is preempted even if the state-created right is broader or narrower than the comparable federal right.” (*Kabehie v. Zoland, supra*, 102 Cal.App.4th at p. 520, quoting Melville B. Nimmer, 1 Nimmer on Copyright (2007), § 1.01[B][1].)

⁵

Section 102 states in part: “(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories: [¶] (1) literary works; [¶] (2) musical works, including any accompanying words; [¶] (3) dramatic works, including any accompanying music; [¶] (4) pantomimes and choreographic works; [¶] (5) pictorial, graphic, and sculptural works; [¶] (6) motion pictures and other audiovisual works; [¶] (7) sound recordings; and [¶] (8) architectural works. [¶] (b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”

⁶

Section 103 sets forth the subject matter of copyright as it relates to compilations and derivative works as follows: “(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully. [¶] (b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.”

However, even though the subject matter of the action may involve or affect a copyright, it does not necessarily mean that the case “arises” under federal copyright laws. (*Vestron, Inc. v. Home Box Office, Inc.* (9th Cir. 1988) 839 F.2d 1380, 1381; *Effects Assocs., Inc. v. Cohen* (9th Cir. 1987) 817 F.2d 72, 73.) A claim “arises under” the copyright laws if: the complaint seeks a remedy expressly granted by the Copyright Act; the litigation requires construction of the Copyright Act; or if the complaint concerns a distinctive policy of the Copyright Act which requires federal principles control the disposition of the case. (*Vestron, Inc. v. Home Box Office, Inc.*, *supra*, 839 F.2d at p. 1381; *Effects Assocs., Inc. v. Cohen*, *supra*, 817 F.2d at p. 73.)

A claim is not preempted if a cause of action defined by state law incorporates elements beyond those necessary to prove copyright infringement. Also, no preemption occurs where state law regulates conduct qualitatively different from the conduct being governed by copyright law. (*Valente-Kritzer Video v. Pinckney* (9th Cir. 1989) 881 F.2d 772, 776; *Lanard Toys, Inc. Ltd. v. Novelty, Inc.* (C.D. Cal. 2007) 511 F.Supp.2d 1020, 1030.) In order to be qualitatively different, the state law claim must relate to something beyond the bundle of exclusive rights conferred on the owner by the Copyright Act. (*Data Gen. Corp. v. Grumman Sys. Support Corp.* (1st Cir. 1994) 36 F.3d 1147, 1164; *Summit Mach. Tool Mfg. Corp. v. Victor CNC Systems, Inc.* (9th Cir 1993) 7 F.3d 1434, 1439-1440.)

To show copyright infringement, a plaintiff must show ownership of a valid copyright and copying of constituent elements of the work that are original. (*Feist Publications, Inc. v. Rural Telephone Service Co., Inc.* (1991) 499 U.S. 340, 361; *Harper & Row, Publishers, Inc. v. Nation Enterprises*, *supra*, 471 U.S. at p. 548; *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.* (9th Cir. 1997) 122 F.3d 1211, 1217.) Thus, an *infringement* action requires a plaintiff to establish ownership of a valid copyright and an unauthorized use. Ownership of a valid copyright is a threshold question an infringement action. (*Lamps Plus, Inc. v. Seattle Lighting Fixture Co.* (9th Cir. 2003) 345 F.3d 1140, 1144; *Topolos v. Caldewey* (9th Cir. 1983) 698 F.2d 991, 994.) If a suit calls for a simple declaration of copyright ownership, without a bona fide

infringement claim, the issue is decided by a state court with reference to state contractual law. (*Scholastic Entertainment, Inc. v. Fox Entertainment Group, Inc.* (9th Cir. 2003) 336 F.3d 982, 985-986; *Vestron, Inc. v. Home Box Office, Inc., supra*, 839 F.2d at p. 1381; *Franklin v. Cannon Films, Inc.* (C.D. Cal. 1987) 654 F.Supp. 133, 135.) Once the ownership is decided, an infringement issue must be decided by a federal court. (*Topolos v. Caldewey, supra*, 698 F.2d at p. 994; see *Vestron, Inc. v. Home Box Office, Inc., supra*, 839 F.2d at p. 1381.)

C. Plaintiff's State Claims

The gravamen of plaintiff's state law claim is that defendants made unauthorized use of her name and likeness to promote the "Bikini Destinations" films. In accordance with the aforementioned allegations, plaintiff sought damages for: common law misappropriation of her name and likeness in violation of her privacy rights; violating the statutory right of publicity in violation of Civil Code section 3344, subdivision (a)⁷; and unfair competition in violation of Business and Professions Code section 17200. Plaintiff also sought injunctive relief against the use, exploitation, selling, or publicizing of her name, voice, signature, photograph or likeness, or any product, service or other media containing her name, voice, signature, photograph or likeness.

⁷

Civil Code section 3344, subdivision (a) provides in part: "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, ... shall be liable for any damages sustained by the person or persons injured as a result thereof. In addition, in any action brought under this section, the person who violated the section shall be liable to the injured party or parties in an amount equal to the greater of seven hundred fifty dollars (\$750) or the actual damages suffered by him or her as a result of the unauthorized use, and any profits from the unauthorized use that are attributable to the use and are not taken into account in computing the actual damages."

The elements of the California common law of privacy invasion claim for misappropriation are: use of the plaintiff's identity; appropriation of the plaintiff's name and likeness to defendant's commercial advantage; lack of consent; and resulting injury. (*Eastwood v. Superior Court* (1983) 149 Cal.App.3d 409, 416; see *Kirby v. Sega of America, Inc.* (2006) 144 Cal.App.4th 47, 55.) The elements of the statutory claim for misappropriation of the right of publicity in Civil Code section 3344, subdivision (a) include the common law privacy invasion elements plus a knowing use. (*Kirby v. Sega of America, Inc.*, *supra*, 144 Cal.App.4th at p. 55; *KNB Enterprises v. Matthews*, *supra*, 78 Cal.App.4th at p. 367, fn. 5.) The statutory right against misappropriation of publicity embodied in Civil Code section 3344, subdivision (a) complements but does not supplant the common law claim. (Civ. Code, § 3344, subd. (g); *Comedy III Productions, Inc. v. Gary Saderup, Inc.* (2001) 25 Cal.4th 387, 391; *Newcombe v. Adolf Coors Co.* (9th Cir. 1998) 157 F.3d 686, 691-692.) To prove unfair competition, plaintiff will be required to prove that members of the public are likely to be deceived by an unfair practice. (*Kasky v. Nike, Inc.* (2002) 27 Cal.4th 939, 951; *Bank of West v. Superior Court* (1992) 2 Cal.4th 1254, 1266-1267.)

Defendants assert that the matter is preempted by their ownership of copyrights in the "Bikini Destination" films which extends to compilations and derivative works. (§§ 102(a)(5) & 103.) As previously noted, the issue of whether a state cause of action is preempted by the Copyright Act requires the court to apply a two-step test. A court first determines whether the cause of action fall within the subject matter of copyright as described in sections 102 and 103. The court then evaluates whether the cause of action protect interests that are equivalent to any of the exclusive rights of federal copyright contained in section 106.

Here, plaintiff is seeking relief from an unauthorized use of her name and likeness which were taken from one or more of the series. While the fourth amended complaint makes reference to the copyright ownership, its allegations centered on the right to use her name and likeness to promote a copyrighted film. Plaintiff did not seek remedies for copyright infringement. Rather, plaintiff sought damages and relief against the

unauthorized use of her name and likeness for promotional and commercial purposes including the sale of cellular telephone wallpaper. Plaintiff did not seek any relief on claims that defendants had misappropriated her name or likeness by allowing the program to be broadcast or distributed. The fourth amended complaint is based on the use of her name and likeness on Internet Web sites promoting the “Bikini Destination” films *and* selling and marketing cellular telephone wallpaper without her consent and authorization.

Plaintiff argues misappropriation of her name and likeness is not within the preemptive scope of the Copyright Act. As pled in the fourth amended complaint, we agree. Misappropriation of a person’s likeness refers to a visual image. (*Kirby v. Sega of America, Inc.*, *supra*, 144 Cal.App.4th at p. 55; *Midler v. Ford Motor Co.* (9th Cir. 1988) 849 F.2d 460, 463.) The Ninth Circuit has held: “[T]he tort of misappropriation of name or likeness protects a person’s *persona*. A *persona* does not fall within the subject matter of copyright.” (*Downing v. Abercrombie & Fitch* (9th Cir. 2001) 265 F.3d 994, 1004 quoting *Brown v. Ames* (5th Cir. 2000) 201 F.3d 654, 658.) It has been consistently held that, “A person’s name and likeness is not a work of authorship within the meaning of [section 102].” (*Downing v. Abercrombie & Fitch*, *supra*, 265 F.3d at p. 1004; see also *KNB Enterprises v. Matthews*, *supra*, 78 Cal.App.4th at pp. 374-375; *Laws v. Sony Music Entertainment, Inc.*, *supra*, 448 F.3d at p. 1141; *Brown v. Ames*, *supra*, 201 F.3d at pp. 658, 661.) Thus, a person’s name or likeness, even though it is in a tangible medium, does become a work of authorship for purposes of the Copyright Act simply because it is embodied in a copyrighted photograph. (1 Nimmer on Copyright § 1.01[B][1][c] pp. 1-30-1-31; *Downing v. Abercrombie & Fitch*, *supra*, 265 F.3d at pp. 1003-1004.) Section 301 does not preempt common law and statutory name and likeness claims even if they are embodied in a copyrightable work. (*KNB Enterprises v. Matthews*, *supra*, 78 Cal.App.4th at pp. 374-375; *Laws v. Sony Music Entertainment, Inc.*, *supra*, 448 F.3d at p. 1141; *Brown v. Ames*, *supra*, 201 F.3d at pp. 658, 661.)

Because the claims are not copyrightable, we disagree with defendants that the preemption issue is controlled by *Fleet v. CBS, Inc.*, *supra*, 50 Cal.App.4th at pages 1913-1920. In *Fleet*, the preemption issue was considered in the context of actors trying

to prevent the exploitation of their names and likenesses through distribution of a film by the copyright owner. The actors were not paid for their performance. *Fleet* noted that the issue it was deciding was very narrow: “[W]hether an actor may bring an action for misappropriation of his or her name, image, likeness, or identity under section 3344 of the Civil Code when the only alleged exploitation occurred through the distribution of the actor’s performance in a motion picture.” (*Fleet v. CBS, Inc., supra*, 50 Cal.App.4th at p. 1913.) In determining the claims were preempted, our colleagues in Division Four of this appellate court emphasized that it was only deciding the very narrow issue presented to them. (*Id.* at pp. 1916, 1919.) In *Fleet* the court stated “[A]s a general proposition Civil Code section 3344 is intended to protect rights that are not copyrightable” (*Fleet v. CBS, Inc., supra*, 50 Cal.App.4th at p. 1919.) The opinion in *Fleet* nevertheless concluded: “But appellants’ analysis crumbles in the face of one obvious fact: their individual performances in the film . . . were copyrightable. Since [the state law] claims seek only to prevent CBS from reproducing and distributing their performances in the film, their claims must be preempted by federal copyright law.” (*Id.* at 1919.) In a footnote, the Court of Appeal noted the actors had asserted in their complaint that defendant wrongfully used still photographs for advertisement and promotional purposes. (*Id.* at p. 1920, fn. 6.) Although the actors were not clear about whether the issue was being asserted on appeal, the *Fleet* opinion stated that section 106 gave the copyright owner the right to display publicly individual images within a copyrighted motion picture. (*Fleet v. CBS, Inc., supra*, 50 Cal.App.4th at p. 1920, fn. 6.)

Since *Fleet* was decided, it has been distinguished on its facts in several state and federal cases. In *KNB Enterprises v. Matthews, supra*, 78 Cal.App.4th at pages 365-374, the owner of a copyright of photographs of models sued an Internet Web site which featured the photographs without authorization. (*Id.* at pp. 365-366.) The Court of Appeal held the statutory misappropriation claims were not equivalent to a copyright infringement claim; therefore, federal copyright law did not preempt the state law claims. (*Id.* at pp. 374-375.) The Court of Appeal noted that the *Fleet* analysis was limited to its facts. *KNB Enterprises* further noted that *Fleet* relied on incomplete statements from

Professor Nimmer's treatise which actually supported the proposition that name and likeness claims are not copyrightable; hence name and likeness claims are not preempted. (*Id.* at pp. 373-374.)

Brown v. Ames, *supra*, 201 F.3d at p. 658 involved allegations that a record company misappropriated the name and likeness of individual musicians, songwriters, and music producers to sell compact discs, tapes, catalogs, and posters. The Fifth Circuit panel concluded that there was no preemption of a Texas misappropriation tort because "a persona does not fall within the subject matter" of the Copyright Act claims of misappropriation of performances which is in the subject matter of copyright. By contrast the Fifth Circuit held, "[A] claim of misappropriation of name and/or likeness . . . is not within the subject matter of copyright." (*Id.* at p. 658.)

In *Downing v. Abercrombie & Fitch*, *supra*, 265 F.3d at p. 1005, the plaintiffs, well known surfing enthusiasts, brought suit for California common law and statutory misappropriation of name and likeness claims against a clothing manufacturer when their faces and names were placed on t-shirts. The Ninth Circuit panel concluded that a Civil Code section 3344 claim is not preempted because claims for the use of name and likeness are not subject to copyright law. (*Downing v. Abercrombie & Fitch*, *supra*, 265 F.3d at p. 1005, fn. 4.) The Ninth Circuit panel noted that the *Fleet* opinion was limited to its facts and had not been followed by *KNB Enterprises* or *Brown*.

In *Wendt v. Host Intern., Inc.* (9th Cir. 1997) 125 F.3d 806, 810, a Ninth Circuit panel refused to apply the *Fleet* opinion outside the narrow context presented to our Division Four colleagues. *Wendt* involved in part a violation of the statutory right of publicity in Civil Code section 3344, subdivision (a). The defendants had allegedly violated the plaintiffs' Civil Code section 3344, subdivision (a) publicity rights by using their likenesses in creating animatronic robotic figures. The defendants asserted the plaintiffs' Civil Code section 3344, subdivision (a) publicity rights claim was preempted by the Copyright Act and relied on *Fleet*. In rejecting the plaintiffs' argument that *Fleet* was the controlling authority, the Ninth Circuit panel held: "We reject appellees' assertion that *Fleet v. CBS*, 50 Cal.App.4th 1911 is new controlling authority that

requires us to revisit the determination on first appeal that appellants' § 3344 claims are not preempted by federal copyright law. [Citation.] *Fleet* is not controlling new authority on the preemption issue. It holds that an actor may not bring an action for misappropriation under Cal. Civ. Code § 3344 when the *only* claimed exploitation occurred through the distribution of the actor's performance in a copyrighted movie. [Citation.] ('Appellants may choose to call their claims misappropriation of right to publicity, but if all they are seeking is to prevent a party from exhibiting a copyrighted work they are making a claim equivalent to an exclusive right within the general scope of copyright.') (internal quotations omitted). [¶] . . . The *Fleet* court acknowledged that it simply found a fact-specific exception to the general rule that 'as a general proposition section 3344 is intended to protect rights which cannot be copyrighted.' *Fleet*, 58 Cal.Rptr.2d at 649." (*Wendt v. Host Intern., Inc.*, *supra*, 125 F.3d at p. 810.) *Wendt* is entirely consistent with other post-*Fleet* analysis and our conclusion.

In this case, plaintiff alleged that her name and likeness were used to advertise and promote the program. It is undisputed her name and image were also used to sell wallpaper for cellular phones. Plaintiff's claims do not implicate the copyright infringement laws. A persona or name does not fall within the subject matter of copyright law. The claims are not within the bundle of exclusive rights of section 106. Nor are the persona rights and the use of plaintiff's name equivalent to the exclusive rights contained in section 106. (*Wendt v. Host Intern., Inc.* *supra*, 125 F.3d at pp. 810-812; *Downing v. Abercrombie & Fitch*, *supra*, 265 F.3d at p. 1004.) Summary judgment should not have been granted on the ground plaintiff's name and likeness claims were preempted.

Finally, at oral argument, defense counsel argued that HDNet, LLC merely distributed the digital video discs and as such could not be liable under any circumstances. However, the sole issue raised in the summary judgment litigation was that plaintiff's state common law and statutory claims were preempted by the Copyright Act. Thus, the role of HDNet, LLC as an alleged mere distributor is not properly before us at present. A similar argument was posited concerning KTLA, Inc. However,

plaintiff's claims against KTLA, Inc. which has filed a bankruptcy petition, are currently the subject of the automatic stay and we do not address any issue as to it.

IV. DISPOSITION

The judgment is reversed. Plaintiff, Victoria Vogel, shall recover her costs incurred on appeal from defendants, C. Casey Bennett, Bennett Productions, Inc., Bennett Media Worldwide, LLC, Guba, Inc., Veoh Networks, Inc., and HDNet, LLC.

NOT TO BE PUBLISHED IN THE OFFICIAL REPORTS

TURNER, P. J.

I concur:

ARMSTRONG, J.

MOSK, J., Concurring.

Recognizing that the subject of federal preemption of performer's rights is difficult, I concur. Nimmer has stated, "The many twists and turns catalogued throughout this Section demonstrate how murky copyright pre-emption issues can be. (1 Nimmer on Copyright (2009) § 1.01[B][3][c] at p. 1-88.2(21) (Nimmer). He also states, "The interplay between copyright pre-emption and the right of publicity has seen more volatility than just about any other doctrine canvassed throughout this treatise." (*Id.* at § 1.01 [B][3][b][i], p. 1-81.)

In this case, it is important to recognize that plaintiff claims that she gave permission for the use of her name, likeness and performance in Bikini Destinations only if certain conditions were met, and those conditions were not met. Thus, she asserts, defendants had no right to use her performance in anything. If the principal issue is whether there is a breach of contract or any contract, when a plaintiff is not seeking any contract benefits that would be equivalent to copyright rights, that issue should not be pre-empted. (See Nimmer, *supra*, § 1.01[B][1][a][i]-[ii], pp. 1-14 through 1-17; § 1.01[B][3][b][iv][II] at p. 1-88.2(18).)

Thus, what we have here is a claim of the unauthorized use of the photographs, which use is a violation of plaintiff's right of publicity. Such a claim has been held not to be pre-empted. (See *KNB Enterprises v. Matthews* (2000) 78 Cal.App.4th 362, 372-373; Nimmer, *supra*, § 1.01[B][1][c] at p. 1-30.)

Even if the issue was not one of consent to use the pictures at all, and plaintiff appeared in a copyrighted work, claims as to the appropriate use of that work may or may not be pre-empted. When a performer appears in a copyrighted or copyrightable work, Nimmer suggests that the distinction between those cases that are pre-empted and those that are not "focus on defendant's exploitation, drawing a line between entertainment works used for their own sake and commercial works used for advertising purposes." (*Id.* at § 1.01[B][3][b][iv][I], at p. 1-88.2(11).) He adds, "the distinction . . . is not between

categories, but between utilizations.” (*Id.* at p. 1-88.2(12).) “Thus, a model who sat for a magazine spread of ‘Beauties of Andalusia’ might not be able to forestall reuse in a later anthology of ‘Twentieth Century Pulchritude,’ but could justifiably complain if the copyright owner licensed usage of her photograph to appear on dog food cans.” (*Id.* at p. 1-88.2(19)-(20); see extensive discussion in *Facenda v. N.F.L. Films, Inc.* (3d Cir. 2008) 542 F.3d 1007.)

Plaintiff contends, in effect, that defendants, or some of them, extracted a still shot from the copyrighted or copyrightable program or the website that promotes the program and used it for cell phone wallpaper for a charge. There is a suggestion this was to promote the website, although there is apparently nothing in the still shot that identifies the website. The still shot is of her in connection with her performance. Although a close case, on balance, I would say that under these circumstances, and for this additional reason, plaintiff’s cause of action related to the use of her likeness for promoting the cell phone wallpaper product should not be deemed preempted.

MOSK, J.