

astrachan gunst thomas

a professional corporation
attorneys at law
baltimore . washington, d.c.
www.agtlawyers.com

Plain Brown Wrapper

By: Jim Astrachan

A friend from way back operates an Internet website from which she sells an amazing assortment of articles - some new, some old. A couple of weeks ago she was selling ten gas grills, 600 dozen pairs of men's socks and an assortment of dining room chairs. She rotates her inventory as she finds new products to sell and she's always on the lookout for lots of new items. Sometimes she ships to the buyer and other times she requires buyer pick-up at her house. She buys this merchandise all over the country, and makes a pretty decent living with her virtual outlet mall.

Our paths crossed after many years not too long ago. She was selling a book that was causing her a stomach ache. Many authors think they have reached nirvana when a publisher picks up their book. But that's just the start because the book must sell and most don't. My friend found, and bought, hundreds of dozens of hard cover new books that were being dumped by the distributor because they hadn't sold, and she was able to buy them by the pound. In this lot were books from many publishers on a myriad of subjects, including a second edition of *Diabalos Provacativo*, a book with a very interesting history, although at the time my friend was unaware.

My friend photographed the covers of many of the books she had bought, like she did with other products, posted the pictures online and gave a brief description. The cover of *Diabalos Provacativo* showed a photograph of a young girl taken when she was 10 years old, published with the first edition of the book a decade ago. Inside were dozens of black and white images, many of questionable taste. The photographer and the publisher had both been arrested and unsuccessfully prosecuted for child pornography, and thousands of their photographic images had been confiscated. None of this sordid past was known to my friend who simply proceeded to do what she had always done - photograph the product and post a picture on her website.

Soon after *Diabalos Provacativo* was posted for sale, a letter from a Florida lawyer was sent to my friend's Internet service provider demanding that the *photograph* of the book be removed from the site and asserting a claim for damages for violating the cover model's right of publicity. My friend was notified by her ISP and she

removed the photograph from her site, not wanting any trouble. A letter was sent to the lawyer by the ISP stating that the photograph had been removed from the site; no reference was made to the demand for money damages that was asserted.

Without any further communication the lawyer filed suit against the ISP in Florida, where the plaintiff lived, for violation of her right of publicity, civil theft and invasion of privacy. Two defenses were raised. First, the Federal Communications Decency Act immunizes an Internet service provider from any state cause of action. The CDA, however, specifically provides that “[n]othing shall be construed to limit or expand any law pertaining to intellectual property.” Second, the plaintiff’s right of publicity was not violated because under the Florida statute an unauthorized use must directly promote a product or service, which is similar to other states’ requirements.

The trial court looked at the CDA and ruled that the plaintiff’s right of publicity claim was preempted. The plaintiff appealed. The 11th Circuit had not dealt with this issue yet, and appeared not about to if it could find an easier out. And it did, focusing instead, on the plaintiff’s right of publicity and related claims. “What was the difference,” the court asked, “between this person who sells books on the Internet and Barnes & Noble? Only that one is bricks and mortar and the other is cyber. In both cases customers walk up and down the isles viewing the offered books and evaluating them for purchase. We see little difference if a customer views the cover on-line or walks down the aisle at the store; the same purpose is served.”

Unlike other Internet right of publicity cases that were held in favor of the plaintiff’s, here neither the defendant, nor my friend, made any sort of editorial decision to use any person’s identity to sell products. There was no emphasis made of the plaintiff’s photo – she merely came along for the ride because the editor and publisher of this edition of the book, of which she was a subject, had chosen to illustrate the book by placing her photo on its cover. It followed, then, that the use by my friend of the photo of the book’s cover was not an endorsement or promotion by the plaintiff of any product sold by my friend including this book. The display of the photograph of the plaintiff on the book’s cover was merely incidental, and customary, to the sale of books on the Internet.

After the case was finally over, my friend was able to sit back and take a deep breath. She had been on pins and needles since her ISP had been sued. I asked her whether any of this had left an impression and she said, “most certainly.” She would not refrain from selling goods on the Internet and she would still post pictures of what she sold. But, with a sly grin, she did confess that it will be a cold day in Hades before she posts any photographs of any people on the Internet in any way connected to the sale of a product. She also confessed that she will now flip through the pages of any book she intends to sell.

James B. Astrachan is a principal of Astrachan Gunst & Thomas, P.C. and teaches Trademark and Unfair Competition Law at the University of Maryland Law School.