Cleveland State Law Review

Volume 46 | Issue 4 Article

1998

# The Unauthorized Dissemination of Celebrity Images on the Internet ... in the Flesh

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# THE UNAUTHORIZED DISSEMINATION OF CELEBRITY IMAGES ON THE INTERNET . . . IN THE FLESH

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## I. INTRODUCTION

The technological revolution spurred by the Internet in the 1990s continually challenges the established principles of intellectual property law entrenched over this century. In addition to trademark and patent law, the Internet poses pertinent questions regarding the copyright infringement of film and television celebrity images, and more specifically, the unauthorized dissemination and distribution of a celebrity's image over the Internet. For example, one such case involves the actress Alyssa Milano of *Who's the Boss* (ABC, Embassy Television), *Melrose Place* (Fox), and most recently *Charmed* (Warner Brothers) fame. In her films *Poison Ivy II: Lily* (1995 New Line Cinema/Time Warner), *Embrace of the Vampire* (1995 New Line Cinema/Time Warner) and *Fear* (1997 Universal Studios) the actress acted in several explicit nude scenes.[2] As a result, via the World Wide Web (WWW), Milano's nude images have frequently appeared on Internet 'cyberpornography' sites. "Webmasters [those who run the web-sites, analogous to SYSOPS (System Operators) who run Bulletin Board Services (BBSs)] are charging $10, $20, or even $30 (U.S.) dollars a month for a peek at them," without the copyright consent of the celebrity or the film/television company.[3] The "growing ease of digitally reproduced *images* . . . [translates into] fan sites [Web pages devoted a specific topics of interest, i.e., celebrities] which are often 'decorated' with unauthorized copies of the intellectual property they praise."[4]

This paper will explore and analyze the unauthorized use and dissemination of celebrity images over the Internet as a violation of the copyrights of either the celebrity themselves, or the cinematographic[5] rights of the film production studio(s). The analysis will focus on the Copyright Act[6] of both Canada and the United States and will be covered in three parts. Part I will define the basic nomenclature of the Internet and explain the applicability of copyright law to the Internet. Part II will focus on methods in which the celebrity and film studio can protect their copyright 'On-line' through the American-defined notion of the 'right of publicity' and through traditional copyright infringement law as it pertains to cinematographic rights.

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[2] *Dateline* (NBC television broadcast, June 30, 1998)

[3] *Id. See also* M.D. Kamarck, *Empowering Celebrities in Cyberspace: Stripping the Web of Nude Images* 15 No. 4 ENTERTAINMENT AND SPORTS LAWYER 1 (1998).

[4] E.S. Koster & J. Shatz-Akin, *Set Phasers on Stun: Handling Internet Fan Sites* 15 No. 1 COMPUTER LAW 18 (1998).

[5] The Canadian Copyright Act, R.S.C. 1985, c. C-42, refers to motion pictures as "cinematographic" works (§ 2), whereas the U.S. Copyright Act of 1976 17 U.S.C. § 101 (U.S.) (1996), refers to motion pictures as "audio visual" works. For the purposes of this paper, motion pictures will fall under the ambit of the Canadian Copyright Act as "cinematographic" works.

[6] *Id.*

Finally, in Part III, I will discuss the existing solutions to unauthorized dissemination on the Internet and advance my own method for alleviating cinematographic copyright infringement on the Internet—the use of official web-site digital authenticated 'signature images.'

## II. INTERNET TERMINOLOGY AND APPLICABILITY OF COPYRIGHT LAW TO THE INTERNET

### *A. Internet Overview: Definitions & Concepts*

The Internet was developed in the late 1950s and early 1960s by the Rand Corporation, which was commissioned by the U.S. Pentagon to develop a decentralized computer network.[7] During the Cold War, the U.S. Department of Defense believed that such a telecommunication system would be able to survive a military attack, and, furthermore, would allow for faster data transfer between the various branches of the military and other federal bodies. The Pentagon began to network computers at different locations to share data and allow access from remote positions. The first military computer network was known as ARPNET.[8] Today, the Internet is a world-wide communication system serving individuals, government, academic institutions, and businesses. The independent networks which form the Internet contain millions of 'host' computers which serve millions of other computers all over the world.

The following terms and concepts will enable the reader to understand some of the technical language used in this paper:

World Wide Web (WWW): the interconnected link of computer networks around the world.

Web Page: "A computer data file on a host operating a web server within a given domain name. When the web server receives an inquiry from the Internet, it returns the web page data in the file to the computer making the inquiry. The web page may comprise a single line or multiple pages of information and may include any message, name, word, sound or *picture*, or combination of such elements."[9] A "Webmaster" is the one who updates and runs the Web site/page.

Web Site: An electronic cybergeographic location on the WWW that may contain images, sounds, and graphics.[10] Web Sites are created using HTML (hypertext markup language).[11] A large number of personal web sites are created by

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[7]R. Zaitlen & D. Victor, *The New Internet Domain Name Guidelines: Still Winner-Take All* 13 No. 5 COMPUTER LAW 12, 13 (1996); G.W. Hamilton, *Trademarks on the Internet: Confusion, Collusion or Dilution?* 4 No. 1 TEXAS INTELLECTUAL PROPERTY LAW JOURNAL 1, 2 (1995).

[8]K.S. Dueker, *Trademark Law Lost in Cyberspace: Trademark Protection for Internet Addresses* 9 No. 2 HARVARD JOURNAL OF LAW & TECHNOLOGY 483, 497 (1996).

[9]Intermatic Inc. v. Toeppen, 947 F. Supp. 1227, 1227, 1231 (N.D. Ill. 1996).

[10]I.C. Ballon, *Linking, Framing and other Hot Topics in Internet Law and Litigation* 520 PRACTICING LAW INSTITUTE 167, 176 (1998).

[11]*Id.*

individuals who dedicate their pages to their favorite interests, including celebrities, sports teams and players, and musical artists.[12]

BBS: Bulletin Board Service. The predecessor of the Internet, which essentially allows users to upload (allowing the user to transmit information to a BBS/Internet) and download (allowing the BBS/Internet to transmit information to the user) programs.[13]

USENET: Distributed message databases that are organized into "Newsgroups" where individual users can post and read messages and download files, including ".PICT," ".JPEG," ".GIF" (image file types) files.[14]

Pasties: "pictures that have been digitally altered by *pasting* a celebrity's head [or any other body part] onto someone else's body."[15]

Moving Picture Experts Groups (MPEG): a standard used on the World Wide Web for video and audio files to be transposed to movie files on browser software (i.e., Netscape).[16]

Digital Video Disk (DVD): DVD's can hold over 4 Gigabytes of information, providing for full length motion pictures to be played from a compact disc.

Scanner: a peripheral (i.e. modem, printer) device that is used to transfer a picture, photograph, or image into a file on the computer.[17]

Internet Service Provider (ISP): those corporations that provide individual users access to the Internet. Examples include: American On-line, Compuserve, and Netcom.

The methods of communication on the Internet most vulnerable to copyright infringement of celebrity images are: (1) the World Wide Web, (2) e - mail (one-to-

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[12]Koster & Shatz-Akin, *supra* note 4.

[13]Ballon, *supra* note 10, at 177.

[14]*Id.*

[15]According to the mother of Alyssa Milano, Lin Milano, her daughter's head appeared on "naked women and little girls in pornographic poses" on the Internet, *see* R. Lemos, "Fighting faked photo abuses" June 15, 1998 (visited October 12, 1998) <http://www.zdnet.com/zdnn/stories/zdnn_display/0,3440,2112373,00.html> and S. Young "Cyber-Tracker's Unique Services have Garnered a Lot of Media Attention" PEOPLE MAGAZINE November 17, 1997 at 50. Kamarck, *supra* note 3 at 12-13. Kamarck also acknowledges that Christina Applegate of *Married . . . With Children* fame is a prime target of "pasties" on the web whereby she has never posed nude in any motion picture, but her nude pictures remain available for all to see. Other celebrities are also victim to such violation of copyright. Some of the most common include: Pamela Anderson Lee of *Baywatch* fame, supermodel Cindy Crawford, teen pop singer Britney Spears, Sandra Bullock, and even Dawn Wells, who played Mary Ann on the television classic *Gilligan's Island*. The actor, Dustin Hoffman, has also fallen victim to "pasties," *see* Hoffman v. Capital Cities/ABC, Inc., 33 F. Supp.2d 867 (C.D. Cal. 1999).

[16]*Glossary of PC and Internet Terminology* (visited on November 3, 1998) <http://homepages.enterpise.net/jenko.Glossary/G.htm>.

[17]*Id.* On July 12, 1999, the U.S. District Court for the District of Nevada held in Tiffany Design, Inc. v. Reno-Tahoe Specialty Inc., D.C. Nev., No. CV-S-98-1207-PMP, July 12, 1999, that the scanning of a copyrighted photo into a computer for graphic manipulation and insertion into new work constitutes copyright infringement.

one messaging) and (3) newsgroups.[18] Still images of celebrities taken from cinematographic works, are one of the most common type of copyright infringement occurring on the Internet. Still images of celebrities, taken from cinematographic works, are one of the most common types of copyright infringement occurring on the Internet.

### *B. Copyright Overview & the Applicability of The Copyright Act to the Internet: A Canadian and U.S. Perspective*

#### 1. Basic Tenets of Copyright Law

In order to understand how copyright law applies to the Internet, specifically cinematographic works, it is necessary to have a basic understanding of the Copyright Acts of both Canada and the United States. Both Acts contain the same essential copyright principles, despite minor nuances in wording. The primary purpose for granting copyright in both countries is to provide for an "economic incentive to authors to create and disseminate their works for the benefit of the public."[19] In Canada, copyright is a federal right[20] which provides the copyright owner "the sole right to produce or reproduce the work or any substantial part thereof."[21] In the United States, copyright is also a federal right[22] giving the author of a work the right to exclude others from doing any of the following five activities:

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[18]There are three other categories of communication which are important, however they will not be discussed in this section. They include: (1) One-to-many messaging—LISTSERV, (2) Real Time Communication—Internet Relay Chat (IRC), and (3) Real Time Remote Computer Utilization—TELNET.

[19]M.J. McDonough, *Moral Rights and the Movies: The Threat and Challenge of the Digital Domain* 31 SUFFOLK U. L. REV. 455 at 459 (1997). *See also* Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975) (recognizing that the ultimate aim of copyright law was to encourage artistic creativity for public good).

[20]*Constitution Act, 1982*, being Schedule B to the *Canada Act 1982* (U.K.), 1982, c. 11., § 91 (22).

[21]Copyright Act, § 3 (Canada). The "bundle of rights" provided to the copyright holder include: (a) to produce, reproduce, perform or publish any translation of the work, (b) in the case of a dramatic work, to convert it into a novel or other non-dramatic work, (c) in the case of a novel or other non-dramatic work, or of an artistic work, to convert it into a dramatic work, by way of performance in public or otherwise, (d) in the case of a literary, dramatic or musical work, to make any sound recording, cinematograph film or other contrivance by means of which the work may be mechanically reproduced or performed, (e) in the case of any literary, dramatic, musical or artistic work, to reproduce, adapt and publicly present the work as a cinematographic work, (f) in the case of any literary, dramatic, musical or artistic work, to communicate the work to the public by telecommunication, (g) to present at a public exhibition, for a purpose other than sale or hire, an artistic work created after June 7, 1988, other than a map, chart or plan, (h) in the case of a computer program that can be reproduced in the ordinary course of its use, other than by a reproduction during its execution in conjunction with a machine, device or computer, to rent out the computer program, and (i) in the case of a musical work, to rent out a sound recording in which the work is embodied and to authorize any such acts.

[22]U.S. Const. art. I, § 8, c1.8.

(1) reproduction; (2) adaptation; (3) distribution; (4) performance in public; or (5) display in public.[23]

Copyright protects original expressions with a modicum of creativity and does not protect abstract ideas.[24] According to the landmark U.S. decision *Feist Publications v. Rural Telephone Service*, a small amount of skill and labor will satisfy the originality (creative) requirement.[25] Copyright subsists for every original (1) literary, (2) dramatic, (3) musical or (4) artistic work in Canada;[26] and for every (1) literary, (2) musical, (3) dramatic, (4) pantomime and choreographic, (5) pictorial, graphic, and sculptural, (6) motion picture and audiovisual, and (7) sound recordings work in the United States.[27] The categories of copyrighted works in the U.S. Copyright Act are relatively narrow, but the four Canadian classifications are broader.

Copyright automatically subsists upon the work's creation even without registration, but the work must be in a "material" and "fixed" form with a permanent character.[28] Both Canada and the United States are members of the Berne Convention, which provides for international copyright protection in member countries. Hence, the copyright of a U.S. author is valid in Canada and vice versa.[29] The term of copyright protection for work is the life of the author plus the next 50 years.[30] Copyright protection of a cinematographic work lasts for 50 years from the end of the calendar year of the first publication of the cinematograph.[31]

2. Copyright Protection for Cinematographic Works

In Canada, a cinematographic work "includes any work expressed by any process analogous to cinematography whether or not accompanied by a sound track."[32] The

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[23]17 U.S.C. § 106 (1996); J.T. McCarthy, *McCarthy's Desk Encyclopedia of Intellectual Property*, (Washington, D.C.: BNA Books, 1995).

[24]Baker v. Selden, 101 U.S. 99, 106 (1879).

[25]Feist Publications v. Rural Telephone Service, 499 U.S. 340 (1991). Otherwise coined as the "sweat of the brow" doctrine. In Canada, the case of *British Columbia Jockey Club* v. *Standen* (1985), 8 C.P.R. (3d) 283 (B.C.C.A.) has also ruled that "skill and labour" is sufficient to generate a copyright interest. In spite of the low threshold requirement that *Feist* has ruled on, U.S. courts have developed the "merger doctrine" in which certain works are uncopyrightable, *see* Morrissey v. Proctor & Gamble 379 F. 2d 675 (1967).

[26]Copyright Act, § 3 (Canada).

[27]17 U.S.C. § 102 (1996).

[28]*See* Merchandising Corp. of America v. Harpbond Ltd. [1983] FSR 32; S. Burshtein, *Surfing the Internet: Copyright Issues In Canada* 13 SANTA CLARA COMPUTER & HIGH TECH L.J. 385, 395 (1997).

[29]Copyright Act, § 5(1), 5(2) 91 (Canada). The United States recently joined this convention on 1 March, 1989, by way of the Berne Convention Implementation Act of 1988 (Act of October 31, 1988, Pub. L. 100-568, 102 Stat. 2853).

[30]Copyright Act, § 6(1) (Canada); 17 U.S.C. § 302(a) (1996).

[31]Copyright Act, § 11.1 (Canada).

[32]Copyright Act, § 2 (Canada).

Copyright Act of Canada classifies cinematographic works under either the dramatic or artistic category of protected works.[33] Dramatic works include works with a story line. Artistic works include such works as still photographs where there is no element of drama.[34] The U.S. Copyright Act has a separate category for motion pictures as a protected audiovisual work, and defines motion pictures as "audiovisual works consisting of a series of related images which, when shown in succession, impart an impression of motion, together with accompanying sounds, if any."[35] As with the other categories of protected works, the copyright owner has the exclusive right (other than by license) to reproduce, adapt and publicly present the work by cinematograph.[36]

As will be further discussed in Part II, those who copy and reproduce copyrighted cinematographic images onto the Internet are infringing the rights of film studios.

3. Applicability of the Copyright of Cinematographic Works to Internet Content

The governments of both Canada[37] the United States[38] have delved into the debate over whether the Internet can be governed by existing copyright law.[39] The consensus is that existing copyright law can fully accommodate the issues and concerns presented by the Internet.[40] According to Sheldon Burshtein, two major studies produced by the Canadian and U.S. governments report that the current situation does not warrant a major reconstruction of traditional copyright principles.[41] However, the Internet poses a new threat for copyright holders, because technology seems to have outpaced current copyright laws. The innovative art of duplication and reproduction of original authored works on the Internet is widespread. No jurisdiction has produced a viable solution to control or legislate the Internet entirely, and those countries that have developed enforcement mechanisms have been very slow to implement them.

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[33]Copyright Act, § 11.1 (Canada).

[34]*Id.* Prior to the 1991 Copyright Act Amendment (Canada), those images which did not produce a "negative and photograph" were not included in the cinematographic definition, and hence were not classified as motion pictures. *See* FWS Joint Sports Claimants v. Copyright Bd. (1990), 32 C.P.R. (3d) 97, var'd (1990), 34 C.P.R. (3d) 383, for a further analysis, in which the Copyright Act (Canada) was amended so that videotapes, video disks, etc. (which did not produce images by negative and photographs) were included in the cinematographic definition; Burshtein *supra* note 28, at 413.

[35]17 U.S.C. § 101 (1996).

[36]Burshtein, *supra* note 28, at 414-15.

[37]*The Challenge of the Information Highway: The Final Report of the Information Advisory Council*, September 1995 [hereinafter *IAHC*].

[38]*White House Information Infrastructure Task Force, Intellectual Property and the National Information Infrastructure: The Report of the Working Group on Intellectual Property Rights, Executive Summary 6* (1995) [hereinafter *NII Report*].

[39]Burshtein, *supra* note 28, at 408.

[40]*Id.*

[41]*Id.* at 408-09.

Whenever a copyrighted work, such as a cinematographic work, has been reproduced or duplicated without authorization, an infringement occurs.[42] This applies equally to copied images on the Internet. The Internet cannot shield itself behind its assumed identity as a "Wild West" copying culture.[43] Any time a user uploads or downloads information from or to a Web page or BBS, a possible violation of copyright can occur.[44] According to a Florida district court, when a user of the Internet scans a nude picture from *Playboy* magazine into his computer and places that picture onto their Web page or BBS for public display, a violation of copyright has occurred against the registered copyright holder of that image.[45]

Most Internet Web sites that are dedicated to celebrities and motion pictures, contain copyrightable information (text, sound, or images).[46] When ISPs or BBSs provide the forum for uploading and downloading information, they might communicate that information to the *public* by *telecommunication* and violate copyright.[47] One of the "bundle of rights" offered to copyright holders under both the Canadian and U.S. Copyright Acts is "public display."[48] Hence, for a presentation of a cinematographic work on the Internet, to violate the rights of a copyright holder the presentation must be done "publicly."[49] According to Burshtein, a performance of work will not constitute an infringement unless the performance was made in public. The test to determine whether or not a performance is public is the "character of the audience."[50] Some argue that the Internet by its nature is a

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[42]*Id*.

[43]*Id*. at 408; Koster & Shatz-Akin, *supra* note 4 at 18. On the Internet, the speedy form of information transfer and reproduction does very little to protect the interest of copyright holders.

[44]G.A. Bloom & T.J. Denholm, *Research on the Internet: Is Access Copyright Infringement?* 12 C.I.P.R. 337, 343 (1996). There are exceptions however, *see* the Fair Dealing (Canada) and Fair Use (U.S.) discussion *infra* Part II (B) (2).

[45]Playboy Enter. Inc. v. Frena, 839 F. Supp. 1552, 1552, 1557 (M.D. Fla. 1993); *see also* Part II *infra*.

[46]Koster & Shatz-Akin, *supra* note 4, at 19.

[47]Bloom & Denholm, *supra* note 44.

[48]Copyright Act, § 3(1)(e) (Canada); In the U.S. to perform a work "publicly" means: (1) to perform...it at a place open to the public or at any place where substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; or (2) to transmit or otherwise communicate a performance...of the work to a place specified by clause (1) or to the public, by means of any device or process, whether the members of the public capable or receiving the performance...receive it in the same place or in separate places and at the same time or different times. 17 U.S.C. § 106 (1996).

[49]Burshtein, *supra* note 28, at 415; Playboy Enter. Inc. v. Frena, 839 F. Supp. 1552, 1552, 1557 (M.D. Fla. 1993). In terms of "public performance" *see also* M.M. Wallace, *The Development and Impact of the Digital Performance Right in Sound Recordings Act of 1995,* 14 THOMAS M. COOLEY LAW REVIEW 101, 102 (1997).

[50]Canadian Admiral Corp. v. Rediffusion, Inc., [1954] Ex. C.R. 382 at 396 [hereinafter *Rediffusion*]; Burshtein, *supra* note 28, at 410. According to the *Rediffusion* court, a performance in a private home is not considered a "public performance" under the Copyright Act (Canada). Noting the year of the decision of this case, it would be difficult to apply this

publicly accessed network of computers. Although, one can access the Internet privately in the comfort of his own home, the information that one can access is clearly within the public domain. Furthermore, the Internet is a *public* networking system in which it can easily be classified under the "telecommunication" definition of the Canadian Copyright Act.[51] Although no case law has addressed the definition of "public" as it applies to the Internet in Canada,[52] the *Playboy*[53] decision in the U.S. has made it clear that any reproduced or duplicated image from a registered copyright holder that is made available on the Internet is considered a presentation for public display for purposes of the Copyright Act.

## III. PROTECTION OF CELEBRITY IMAGES OVER THE INTERNET: THE RIGHT OF "PUBLICITY" AND COPYRIGHT INFRINGEMENT

Copying of intellectual property is not a modern phenomenon.[54] "Piracy" of works can be traced back to the inception of the *Statute of Anne*. London publishers of that era applied for government protection against the illegal copying of books and manuscripts.[55] Copying in the digital age of the Internet has come a long way from traditional methods of duplication. Today, the unauthorized reproduction of copyrighted works has become more intricate and sophisticated. Individuals, namely celebrities, enjoy the right of commercial exploitation of their image. This section will explore who owns the copyright of cinematographic works, and will discuss how the copyright holder (celebrity or film studio) can enforce its copyright On-line.

### *A. Celebrity or Film Studio? Who Owns the Copyright to a Celebrity's Image on the Internet?*

Before one can appropriately analyze the unauthorized dissemination and copyright infringement of a celebrity's image over the Internet, one must discern whether the celebrity or the film studio owns the copyright. In Canada, the Copyright Act provides that the "author of a work shall be the first owner of the copyright" with the exception of those works made in the course of employment.[56]

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test under today's modern world of computers and technology. The Internet is a publicly accessed network of computers which is global in nature. By having access to the Internet in the privates of one residence should not exclude the Internet from coming under the ambit of the "public display" provision of the current Copyright Act.

[51]Copyright Act, § 2 (Canada). "Telecommunications" means any transmission of signs, signals, writing, images or sounds or intelligence of any nature by wire, radio, visual, optical or other electromagnetic system.

[52]It should be noted that a cable television industry related case *suggests* that an ISP or BBS who cause(s) musical or *visual* representations of dramatic works to be made publicly available on their Web sites or networks to a large number of Canadians, without the authorized consent of the copyright holder, can be considered copyright infringement *see* Canadian Cable Television Assn. v. Canada (Copyright Board) (1993), 46 C.P.R. (3d) 359.

[53]Playboy Enter. Inc. v. Frena, 839 F. Supp. 1552, 1552, 1557 (M.D. Fla. 1993).

[54]Koster & Shatz-Akin*, supra* note 4, at 19.

[55]*Id.*

[56]Copyright Act, §§ 13(1) and 13 (3) (Canada). For the purposes of this paper, it can be assumed that the author of a cinematographic work is the film studio, since the rights

Therefore, where the author or actor of the cinematographic work was employed under a contract to write a screenplay or perform in a motion picture, the employer is the first owner of the copyright.[57] For example, if Arnold Schwarzenegger is under contract with Paramount Pictures to perform in the upcoming film, *Terminator III*, the film studio will be the first owner of copyright of his image(s) in the film absent any agreement to the contrary. Section 15 of the Copyright Act of Canada allows for copyright of performers' performances, therefore, the celebrity actor may have copyright protection of his acting work. However, once again, contractual arrangements with the film studio may preclude the celebrity from claiming any copyright in his performance. The same holds true under the Copyright Act and the "work-for-hire" doctrine in the United States.[58] A "work made for hire" is a "work prepared by an employee within the scope of his or her employment."[59]

Thus, whenever a copyright issue arises involving a cinematographic work, it is likely that the film studio, rather than the celebrity, has the power to decide whether or not to pursue an infringement claim.[60] According to Matthew J. McDonough, American [and Canadian] copyright law provides little protection for the rights of individual directors, screenwriters and actors/celebrities, because the copyright resides in the employer film studio. "Should harm befall a motion picture, such as a copyright infringement, film-makers [and celebritys] lack the power to seek redress for the infringement, because the decision to pursue a copyright infringement claim rests with the [film] studio."[61] However, if the celebrity has an agreement with the film studio that purports to protect her "likeness and image" on the screen, this could preclude the film studio from claiming any copyright of that celebrity's image on the Internet.[62] A celebrity can bring a legal action under a number of different theories. One such theory, is the American notion of a celebrity's "right of publicity."

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associated with a film are usually given or transferred to the film production company. *See infra* note 61.

[57] *Id.*

[58] "In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright." 17 U.S.C. § 201 (a)-(b) (1996).

[59] 17 U.S.C. § 101. *See also* McDonough, *supra* note 19, at 473.

[60] *Id.*

[61] *Id.* McDonough argues that the box office receipts and other financial considerations, not artistic concerns, generally motivate a film studio's decision to pursue copyright action. An alternative strategy suggested by Mitchell D. Kamarck, argues that certain copyright holders will assign the rights (of the images from the motion picture) over to the celebrity in order for the celebrity to pursue legal action.

[62] Kamarck, *supra* note 3, at 14. Kamarck argues that any agreement that requires the celebrity to shed clothes in the motion picture should include: "(1)a designation of who holds the copyright to the nude images; (2) whether the nude portions of the film will be used on the studio's web page to promote the film; (3) who will police the web for unauthorized uses of the pictures; and (4) if someone other than the celebrity own the copyright to the nude pictures, whether that person or entity will transfer the necessary rights to the celebrity to empower the celebrity to police the web."

1. The Celebrity's Right of Publicity "On-line"

The "right of publicity" is the inherent right of every human being to control the commercial value of their image, likeness, persona, or identity.[63] The right was first recognized in the United States about forty years ago.[64] Famous persons, namely, film stars and professional athletes, generate the most economic value from this right.[65] The right of publicity is violated when one appropriates someone else's name or likeness for the purpose of economic benefit without his consent.[66] There is no federal law concerning the right of publicity, but fourteen states have codified some form of publicity right.[67]

When cinematographic works are inextricably linked to a celebrity and the celebrity's image or likeness is transposed onto the Internet, the celebrity can enforce his or her right of publicity when harm is likely or has occurred already. For example, Alyssa Milano filed lawsuits against two companies for selling nude images of her on the Internet. She claimed, *inter alia*, misappropriation of her right of publicity and copyright infringement.[68] In the *Machinenet* action, Milano claimed that the defendant company was in the business of creating and maintaining pornographic web-sites on the Internet, and that they knowingly exploited Milano's "identity, mark, reputation and other indicia closely related to her...for commercial benefit."[69] In her complaint, Milano, refers to all of her television, film and musical performances in which the defendant has willfully misappropriated her identity, including nude still photographs taken from her numerous motion pictures.

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[63]McCarthy, *supra* note 23.

[64]Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953). *See also* R. Raysman, *Staying Interactive In The Hi-Tech Environment* 467 PRACTICING LAW INSTITUTE 905, 912 (1997).

[65]Cristina Fernandez, *The Right of Publicity On The Internet* 8 MARQ. SPORTS L. J. 289, 306 (1997). Fernandez argues, that the commercial value in ones identity must be kept in perspective when discussing any claim of a right of publicity because "this is what the right of publicity aims to promote." *Id.* at 293.

[66]Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 575 (1977). *See also* J.P. Weingart, *Licensing Celebrity Rights of Publicity in Multimedia Products* 1 MULTIMEDIA STRATEGIST 1, 4; Raysman, *supra* note 64, at 918.

[67]*Id.* There have been numerous cases involving the right of publicity and the On-line environment, *see* Curtis Management Group Worldwide, Inc. v. American Legends et al., Cause No: 49D109607-CP-0995 (Marion County Superior Court, July 17, 1996); National Basketball Association v. Sports Team Analysis and Tracking Systems, Inc., 1996 LEXIS 10262 (S.D.N.Y. July 19, 1996); Stern v. Delphi Internet Servs. Corp., 165 Misc. 2d21, 626 N.Y.S. 2d 694 (Sup. Ct. N.Y. Co. 1995).

[68]Milano v. Machinenet, No. 98-3246, (C.D. Cal. Filed April 27, 1998) [hereinafter *Machinenet*]; Milano v. Eight Ball, Inc., et al. Case No. 98-3245, (C.D. Cal. Filed April 27, 1998) [hereinafter *Eight Ball*]. In late November of 1998, these two cases were settled out of court, with Milano allegedly receiving a five-figure sum from Web marketer Paul Anand and his two British Columbia based companies (*Machinenet* and *A.D.E. Inc.*). *See Alyssa Milano Cleans Up Her Online Image,* PEOPLE Dec. 16, 1998.

[69]*Id.*

Another case involving a celebrity and his right of publicity is *William Bradley Pitt v. Playgirl, Inc.*[70] In this case, involving celebritys Brad Pitt and Gwyeneth Paltrow, a California judge issued a temporary restraining order barring *Playgirl* magazine from distributing its August 1996 edition.[71] That particular edition contained nude photographs of the former couple which were surreptitiously taken by an unknown photographer while the two vacationed in the West Indies.[72] The edition reached the newsstands before the order could be enforced, and Pitt's nude image "seemed to zip simultaneously across the Internet at warp speed."[73] The damage was done. The right to commercial exploitation of Pitt's persona was clearly violated without his consent. Invoking Pitt's right of publicity would have been an option but the celebrity and the court did not take this route.

The Oscar Award winning actor Dustin Hoffman is the latest celebrity in Hollywood to obtain a judgment in his favor for the unauthorized dissemination of his famous image. In *Hoffman*,[74] Dustin Hoffman was awarded more than $3 million dollars in a right of publicity lawsuit against *Los Angeles Magazine*. In the 1982 motion picture *Tootsie*, Hoffman posed as a female dressed in women's clothing to lure an acting position in a soap opera. *Los Angeles Magazine* obtained a photograph of Hoffman as he appeared in the film and without his consent, created a computer generated composite (pastie) of his face and head from that photograph and superimposed it over the body of a model who had been photographed for the magazine article wearing designer clothing never worn by the actor in the motion picture.[75] Judge Tevrizian held that the unauthorized use of Hoffman's computer manipulated image violated the actor's California common law and statutory right o publicity,[76] and *inter alia*, Hoffman's right to control the use of his own likeness was not equivalent to the rights protected by the copyrights in the two photographs.[77]

Conversely, there are arguments flowing the other way in which US courts have refused to recognize a "Digital Right of Publicity."[78] The reason relates to the court's unwillingness to admit that a persona can actually be owned and controlled, and furthermore that a celebrity's image results from a "collective meaning."[79] Additionally, University of Detroit Mercy Law Professor, Lee Goldman, argues that the cause of action for the right of publicity should be abolished, and that individuals

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[70]BC 178 503 (Cal.Sup.Ct.La. Co. 1997).

[71]V.A. Kovner et al. *Newsgathering, Invasion of Privacy and Related Torts* 498 PRACTICING LAW INSTITUTE 587, 874 –75 (1997).

[72]*Id.*

[73]M. Baroni, CYBERTIMES, September 27, 1997.

[74]Hoffman v. Capital Cities/ABC, Inc., 33 F. Supp.2d 867 (C.D. Cal. 1999).

[75]*Id*. at 870.

[76]*Id*. at 873.

[77]*Id*. at 875.

[78]Fernandez, *supra* note 65, at 304.

[79]*Id.*

should instead be protected by state unfair competition laws (or section 43 of the *Lanham Act*),[80] the tort of misappropriation,[81] or the right of privacy.[82]

In Canada, there is no such inherent federal codified "right of publicity," however, there is a *Federal Privacy Act*[83] which regulates the access and use of information. There are four common law provinces and Quebec which have privacy statutes.[84] In Ontario, the exact parameters of a civil tort of invasion of privacy are still developing, however it is suffice to say that the courts are prepared to: (1) protect individuals from the unjustified intrusions on their privacy; (2) protect the individual's entitlement to be left alone; (3) and to ensure that an individual is free of publicity offensive to his or her private life.

2. Misappropriation of Personality

In the alternative, there is a tort of appropriation of personality in Canada. This tort protects two interests, the right of the person who desires privacy not to be the object of publicity for another's benefit without consent, and the exclusive right to the publicity value of one's own persona.[85] In 1973, the Ontario Court of Appeal in *Krouse v. Chrysler Canada Ltd*.[86] recognized that there is a tort of "wrongfully appropriating another's personality." In that case a professional football player learned that his photograph appeared without his consent in connection with the promotion of the defendant's automobiles. At trial, Justice Haines, held that (a) there was an "unauthorized use of [Krouse's] name to the injury of his rights of property;"[87] (b) that there was, in fact, a passing-off and (c) and that the reasoning in *Henderson v. Radio Corporation Property Ltd*.[88] applied. The *Henderson* case stood for the proposition that "without the permission of the respondents, and without any right or justification, the appellant has appropriated the professional reputation of the respondents for its own commercial ends."[89] The Ontario Court of Appeal reversed

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[80]15 U.S.C. § 1125(a) (1996).

[81]"A judge-made common law form of unfair competition where the defendant has copied or appropriated some item or creation of the plaintiff which is not protected by either patent law, copyright law, or trademark law, or any other traditional theory of exclusive rights." McCarthy, *supra* note 23.

[82]Lee Goldman, *Elvis is Alive, But He Shouldn't Be: The Right of Publicity Revisited* BYU L. REV. 597, 598-99 (1992).

[83]R.S.C. 1985, c. P-21.

[84]Brenda Pritchard and Eric Gross, Gowling, Strathy & Henderson, "Wanted: Personalities – Dead or Alive," Toronto, February 1996. In Manitoba, Saskatchewan and Newfoundland, it is a violation of privacy to use the name, likeness or voice of a person for advertising or trade purposes without authorization. In British Columbia the legislation protects only the name and portrait of the individual.

[85]*Id*.

[86](1973), 1 O.R. (2d) 255 (Ont. C.A.), rev'g [1970] 3 O.R. 135 (H.C.).

[87]*Id*. at 152.

[88][1969] R.P.C. (No. 8) 218, [1960] S.R. 576 [hereinafter *Henderson*].

[89]*Supra* note 86, at 151.

the High Court decision, rejecting passing off as a basis for a misappropriation of Krouse's personality. Specifically, Estey, J.Q., held, *inter alia*, "that there was no intent to misappropriate Krouse's personality," Krouse had no endorsement value, and Krouse did not, in the advertisement, expressly or impliedly endorse Chrysler's products.

In a recent case involving the case of *Gould Estate v. Stoddart Publishing Co*.,[90] the Ontario Court of Appeal established that a distinction may be drawn between cases in which a person is represented as endorsing some activity or product of the defendant, and cases in which the person is the actual subject of the work, such as a biography. In *Gould*, the Court held that there was no appropriation of personality on those particular facts where a journalist published a book of photographs in interviews with a world famous Canadian pianist after the pianist's death. The reasoning of the Court was that the public had an interest in knowing more about the pianist and the journalist added to his own creativity. Furthermore, the subject of the photographs and written material had no proprietary interest unless there was express interest through a contract or express agreement with the author.[91]

In Canada the implications of the right of publicity or privacy remain sporadic depending on the jurisdiction in which the issue arises. However, the tort of appropriation of personality could be another mechanism for the celebrity to pursue those who disseminate their image without their consent.[92] The U.S. view of the right appears to be more developed, however, there are prevailing arguments against the right itself. In a more traditional sense, copyright infringement seems to lend more plausible explanations and analysis for the unauthorized dissemination of a celebrity's image over the Internet.

### *B. Copyright Infringement and the Internet*

In Canada, the owner of copyright has exclusive rights under section 3 of the Copyright Act. Infringement of copyright occurs when a person does anything that only the owner of copyright has the right to do.[93] To be successful on a claim of copyright infringement in Canada, the plaintiff must meet four requirements.[94]

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[90](1998) 39 O.R. (3d) 545 (Ont. C.A.) [hereinafter *Gould*].

[91]*Id*. at 551-53.

[92]*See also* Dowell v. Mengen Institution (1983), 72 C.P.R. (2d) 238, (Ont. H.C.); Athans v. Canadian Adventure Camps Ltd. (1977), 17 O.R. (2d) 425 (H.C.); Joseph v. Daniels (1986), 4 B.C.L.R. (2d) 239 (S.C.); Horton v. Tim Donut Ltd. (1997), 75 C.P.R. (3d) 451.

[93]Copyright Act, § 27(1) (Canada). This is also known as primary infringement. Secondary infringement occurs where any person: (a) sells or rents out, (b) distributes to the extent to prejudice the owner of copyright, (c) by way of trade distribute, expose or offer for sale or rental, or exhibit in public [(d) possess or (e) import]...a copy of work, sound recording or fixation of a performer's performance or of a communication signal that the person knows or should have known infringes copyright or would infringe copyright if it had been made in Canada by the person who made it.

[94]Ravenscroft v. Herbert and New English Library Ltd., [1980] RPC 193. The requirements include: (1) was the material taken an essential element of the copyrighted work; (2) how much of the material is relevant to copyright; (3) was there an intention on the part of the defendant to copy the work in question, and (4) to what extent were the plaintiff and defendant competing in the said works.

Similarly, in the United States, the copyright holder enjoys exclusive rights under sections 106 - 118 of the Copyright Act. Under the American Act, any violation of these exclusive rights is copyright infringement, except where there is express consent by the copyright holder.[95] To prevail on a claim of *direct* infringement, a plaintiff must show two things: (1) ownership of the copyrighted work, and (2) "copying" by the defendant.[96]

In the domain of the Internet, there are numerous causes of action for copyright infringement. Whether it be digital duplication of sound recordings or infringement of cinematographic works, the Internet provides for the same, if not more, violations of copyright than traditional methods of copyright infringement. In many cases, as shall be further explained, one can infringe copyright unintentionally.[97] Innocent, accidental or ignorant copyright infringement on the Internet is actionable.[98]

Mitchell D. Kamarck, a lawyer in the field of intellectual property liability on the Internet, has described three groups which are susceptible to copyright infringement: (1) the SYSOPS or Webmasters of individual bulletin boards; (2) the ISPs; and, (3) individual users.[99] The *NII Report*, states that the roles for those who provide for Internet access, namely ISPs and SYSOPS, are continually changing and liability will depend on a 'wait and see' basis. The report states that: "SYSOPS, and to a lesser degree ISPs, must be aware that a court could hold them liable simply for repeated copying of a copyrighted work from their BBS or computer."[100] The report advocates that traditional methods of copyright infringement liability apply in situations involving ISPs and SYSOPS. These traditional methods include (1) direct infringement liability, (2) vicarious infringement liability and (3) contributory infringement liability.[101] The U.S. Copyright Act only provides for liability based on *direct* copyright infringement.[102] It does not provide for liability for acts by third parties.[103] Case law, drawing from patent law and tort legal theories has provided the

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[95] "Anyone who violates any of the exclusive rights of the copyright owner as provided by § 106 through 118 or of author as provided in § 106A(a), or who imports copies or phonorecords into the United States in violation of § 602, is an infringer of the copyright or right of the author, as the case may be." 17 U.S.C. § 501(a) (1996).

[96] Feist Publications v. Rural Telephone Service, 499 U.S. 340; Southern Bell Tel. & Tel. v. Assoc. Telephone Directory Publishers, 756 F.2d 801, 810 (11th Cir. 1985); Playboy Enter. Inc. v. Frena, 839 F. Supp. 1552 (M.D. Fla. 1993).

[97] Internet Service Providers (ISPs) are most vulnerable to copyright infringement.

[98] Alan P. Segal, *Dissemination of Digitized Music on the Internet: A Challenge to the Copyright Act,* 12 SANTA CLARA COMPUTER & HIGH TECH. L.J. 97, 103 (1996).

[99] M.D. Kamarck, *Understanding Copyright Liability in Cyberspace: A Primer* CYBERSPACE LAWYER (visited October 6, 1998) <http://rmslaw.com/Articles/art53.htm>.

[100] *NII Report, supra* note 38.

[101] For a further discussion on the requirements of these three types of copyright liability see *infra*.

[102] 3 M. B. NIMMER & D. NIMMER, NIMMER ON COPYRIGHT, § 12. 04 (1996). *See also* M.A. Shulman, *Internet Copyright Infringement Liability: Is an On-line Access Provider More Like A Landlord or a Dance Hall Operator?* 27 GOLDEN GATE U. L. REV 555, 568 (1997).

[103] *Id.*

basis for contributory and vicarious liability.[104] In Canada there is no cause of action for contributory or vicarious infringement, only primary and secondary infringement.[105] Therefore, celebrity's and film studios that hold copyright in works that appear over the Internet are best off pursuing infringers through these traditional methods of copyright infringement liability developed by statute and common law.

There are relatively few American cases addressing copyright infringement on the Internet, and even fewer cases of copyright infringement pertaining to dramatic works. This section will explore the court's role in finding copyright violations of literary and artistic work over the Internet and discuss how this might apply to copyright violations of cinematographic works.

1. Direct, Vicarious and Contributory Infringement Liability

As explained above, a direct (primary) infringer is anyone who violates the exclusive rights within sections 106 - 118 of the U.S. Copyright Act,[106] and section 3 of the Canadian Copyright Act. In the U.S., to establish direct copyright infringement, a plaintiff bears the burden of proving ownership of a valid copyright, and that of the essential elements of the original work(s) were copied by the defendant.[107] A copyright registration certificate constitutes prima facie evidence of the validity of a copyright.[108] The standard set by the U.S. courts for direct infringement is strict liability.[109]

*a. Cinematographic Works*

Most of the incidents involving copyrighted cinematographic works appearing without consent on the Internet have not led to lawsuits. The first incident involved Paramount Pictures Corporation, a unit of Viacom Inc., and Jeffrey Arind's Star Trek, "Loskene's Tholian" Web page.[110] The film production company sent a cease and desist letter to prevent the web-site from displaying various copyrighted sound and image files from the Star Trek television series and films.[111] "Although

[104]*NII Report*, *supra* note 38. For a description of U.S. vicarious liability see *infra* note 133, and U.S. contributory infringement see *infra* note 135.

[105]*Supra* note 93; Burshtein, *supra* note 28, at 432.

[106]17 U.S.C. § 501(a) (1996).

[107]NIMMER, *supra* note 102, at § 31.01; Playboy Enter. Inc. v. Frena, 839 F. Supp. 1552, 1556 (M.D. Fla. 1993).

[108]17 U.S.C. § 410 (c) (1996).

[109]Andrea Sloan Pink, *Copyright Infringement Post Isoquantic Shift: Should Bulletin Board Services Be Liable?* 43 UCLA L. REV 587, 597 (1995).

[110]V.J. Roccia, *What's Fair is (Not Always) Fair on the Internet* 29 RUTGERS L.J. 155, 199 (1997). *See also* R. Kerber, *On-Line Vigilant Copyright Holders Patrol the Internet* WALL ST. J., Dec. 13, 1995 at B1. The web site <http://www.loskene.com> was last visited on November 7, 1998, and no longer features a Star Trek "Tholian" theme. The current theme of the Web Page is "Captain James T. Kirk Singalong Site," which features different Star Trek characters from the TV series singing various songs. When visited, there were images of the crew members of the USS Enterprise which appeared to be official promotional material from the television series from the 1960s.

[111]Roccia, *supra* note 110, at 199.

Paramount did not object to general discussions of Star Trek over the Internet...posting of copyrighted material such as photographs...sound files, video clips, books or excerpts therefrom were considered [to be] infringement."[112]

The second incident involves the Walt Disney Co., American On-Line, and various other ISPs.[113] Disney charged that Internet Service Providers, such as America On-Line and their individual users, were illegally scanning unauthorized images of their films, *Aladdin* and *Beauty and the Beast,* on to their Web pages.[114] Disney also claimed a direct copyright violation. A third incident involved the film actress, Alyssa Milano. In her complaint against *Eightball Inc.,*[115] the actress and her official photographer, Michael O'Connor, argued that the defendant company produced, sold and marketed pornographic CD-ROMS which included unauthorized copyrighted images of Milano on their pay adult-oriented Web pages. The California District Court has yet to rule on the case.[116]

If one applies the test for direct infringement under Canadian or U.S. law, it is evident that there has been a copyright violation. Under the Canadian test,[117] the substantive material of Disney, Paramount, and Milano was directly copied and posted onto the Internet without consent of the copyright holder(s). There was no alteration to the Disney and Paramount images, but there were significant alterations to some of Milano's images, including "pasties." Furthermore, the images were wholly copied. These images came from copyrighted cinematographic works (including the Paramount Star Trek television series). Although the infringer may not have had a willful intention to copy the work in question, there are persuasive arguments claim that even innocent infringement may be a cause for copyright infringement.[118] As a result, it is clear that Disney, Paramount and Milano and the ISPs and Webmaster's are not in direct competition with each other since they provide different services.

If one applies the U.S. test for copyright infringement[119] to the above incidents, it is also clear that a violation of copyright has occurred. "Since direct evidence of copying is usually unavailable in most cases, a plaintiff may prove 'copying' by inferences, by showing that the defendant had access to the copyrighted work and that the allegedly infringing work is substantially similar to the copyrighted work."[120]

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[112]*Id.*

[113]J. Woo & J. Sandberg, *Copyright Law is Easy to Break on the Internet, Hard to Enforce* WALL ST. J., Oct. 10, 1994, at B6.

[114]*Id.*

[115]*Supra* note 68.

[116]*Id.* However, more recently in an unplublished decision, Milano has been awarded $230,000 by a federal judge, because an Internet site (nudecelebrity.com) posted nude photographs of the film and television actress without her permission. *See* 12/24/98 ORANGE COUNTY (CAL.) REG.

[117]*Supra* note 94.

[118]Playboy Enter. Inc. v. Frena, 839 F. Supp. 1552, 1559 (M.D. Fla. 1993*)*; D.C. Comics Inc. v. Mini Gift, 912 F.2d 29 (2d Cir. 1990); Segal, *supra* note 98.

[119]*Supra* note 96.

[120]Shulman, *supra* note 102, at 570.

Obtaining access to copyrighted cinematographic works is not difficult at all, and copying images from those works is easier than one might think. One can visit a local corner store, rent a film, and easily convert and transpose the film images from VHS format to "GIF," "JPEG," or "MPEG" computer image files on their personal computers.[121] There is software available on the Internet which allows for the such copyright infringement.[122] With the advent of DVD technology, the relative ease in which one can reproduce and duplicate copyrighted images is alarming. Substantial similarity of works is easy to prove in a court of law. As for the second requirement, courts consider "copying" to be any violation of the exclusive rights granted to the copyright holder under sections 106 through 118 of the Copyright Act, and not merely the reproduction right.[123] Of the "bundle of rights" provided under the Act, it is self evident that the individual copyright infringer has violated the "derivative works" (Section 106 (2)) aspect to copying and the part of "[unauthorized] distribution of copies...of copyrighted work to the public by sale . . . transfer . . . rental . . . lease or lending" (Section 106 (3)).

*b. Artistic and Literary Works*

Artistic works,[124] specifically copyrighted photographs, have also been subject to Internet copyright infringement violations. As photographs are synonymous with 'still images' taken from cinematographic works, one can draw analogies between the two types of protected works in infringement analysis. Perhaps the most famous case dealing with artistic copyright infringement and the Internet is the decision of *Playboy Enterprises Inc.* v. *Frena*.[125] In that case defendant George Frena operated a subscription computer BBS that displayed unauthorized copied images of Playboy's copyrighted photographs.[126] As part of its subscription service, individual users of the BBS could upload and download images, including the Playboy images. At some point during the upload/download process, the PLAYBOY and PLAYMATE

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[121]A software package available for converting motion pictures to computer image files and movie (MPEG) files is available from Silicon Graphics and its IRIX (TM) - Digital Media Tools Program. This software the enables the user to "capture, edit, record, play, compress, and convert audio, video, or image files." (visited on November 27, 1998) <http://arctic.eng.iastate.edu:88/SGI_EndUser/MediaTls_UG/43?DWEB_NAVHINTS=0,4,2>

[122]*Id.* With the advent of "Video Capture Cards" copying images from television or movies is made even simpler. The card basically acts like a data recorder, which fits inside one's personal computer and acts as a converter for watching television or any other audio/video device on a monitor. As a result, one can then transpose the image shown on television onto the computer through the use of the card. Images than can be converted to "MPEG," "JPG", or "GIF" formats.

[123]Shulman, *supra* note 102; *NII Report*, *supra* note 38.

[124]Copyright Act, § 2 (Canada)—Artistic works include: paintings, drawings, maps, charts, plans, *photographs*, engravings, sculptures, works of artistic craftsmanship, architectural works, and compilations or artistic works. In the United States, artistic works are protected by the Copyright Act under 17 U.S.C. § 102 (a) (5) (1996) (pictorial, graphic and sculptural works.)

[125]Playboy Enter. Inc. v. Frena, 839 F. Supp. 1552 (M.D. Fla. 1993).

[126]*Id.* at 1554.

trademarks attached to Playboy's copyrighted photographs were altered and replaced with the Frena's name, BBS name and telephone number. These alterations served as identification marks of Frena's BBS image files. At least 170 images that were available on Frena's BBS were taken from fifty of Playboy's copyrighted magazines.[127]

In granting Playboy's motion for summary judgment, the district court held that Frena had directly infringed the magazine's copyright.[128] The court noted, that storing copyrighted photographs in his BBS for subscribed users to download constituted unauthorized distribution of the copyrighted works in violation of Playboy's rights.[129] Furthermore, the court found that Frena's display of the copyrighted photographs constituted a 'public display', and thus violated one of the exclusive rights granted to the copyright holder.[130] Responding to Frena's defense, the court stated that "[i]intent or knowledge is not an element of [direct] infringement."[131]

In a subsequent case, *Playboy Enterprises, Inc. v. Webbworld, Inc.,*[132] the defendant owned and operated a sexually-oriented web-site, and offered its subscribers access to sexually explicit photographs and images obtained from USENET postings at a rate of $11.95 per month. Included in those images, were those of the copyright holder, Playboy. Although, none of the defendants themselves posted any images onto their Web page, one of the defendants created a computer program which searched predetermined adult "newsgroups" on the WWW and downloaded the sexually explicit images onto the Webbworld home page for subscriber viewing. Judge Barefoot Sanders found the defendants liable, and stated that "Webbworld functioned primarily like a store...," rather than "as a passive conduit of unaltered information." The court rejected the defendant's argument that their Web page was a mere conduit of information, and also found them liable of vicarious infringement.[133] The court stated that "Webbworld exercised total dominion over the content of its site and the product it offered its clientele" and it could not evade liability by claiming helplessness in the face of its "automatic" violation.

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[127]*Id.*

[128]*Id.* at 1554-59.

[129]*Id.*

[130]*Id.*

[131]*Id.* at 1559.

[132]Civil No. 3-96-CV-3222-H, 1997 U.S. Dist. LEXIS 21264 (N.D. Tex. Dec. 11, 1997) [hereinafter *Webbworld*].

[133]Vicarious Liability involves a plaintiff establishing that a third party [e.g., ISP or BBS]: (1) had the right and ability to control the primary infringer, and (2) received a direct financial benefit from the infringement. Shapiro, Bernstein & Co. v. H.L. Green Co., 316 F.2d 304 (2d Cir. 1963).

ISPs and BBS SYSOPS can also be held contributorialy liable for copyright infringement for providing a forum for computer video games,[134] on their respective Web pages or BBSs. Contributory liability requires two elements: (1) knowledge of the infringing activity; and, (2) substantial participation in the infringing conduct.[135] In *Sega Enterprises Ltd.* v *MAPHIA*,[136] a California district court granted a preliminary injunction against the Defendant BBS operator who provided unauthorized copies of the plaintiff's copyrighted video games on his BBS for uploading and downloading by subscribers.[137] The district court found that MAPHIA advertised availability of Sega's video games on its BBS, solicited subscribers to download the video games for a nominal fee, and sold equipment necessary to copy the games.[138] The court concluded that the defendants were contributory infringers based on their "provision of facilities, direction, knowledge and encouragement . . . ."[139]

These three cases provide the necessary precedent and arsenal for celebrities and film studios to pursue copyright infringement actions against those violations which occur On-line. These cases also illustrate how ISPs and BBSs are held directly, vicariously, and contributorialy liable for providing copyrighted images for downloading and uploading. Although copyright owners may have powerful legal arguments against individual users who post unauthorized copyrighted images on the Internet, locating them within the world of "cyberspace" is nearly impossible.[140] "Anonymity is a common and often treasured attribute of life on the Internet."[141] Hence, the only viable solution for celebrities and film studios is to go after the "deep pockets" of the individual ISP and or BBS owners.[142]

Conversely, in defense of individual BBS or network operators, holding them liable for the actions of its subscribers is controversial. This is especially true if one considers the BBS/ISP to be a "passive carrier" rather than an "active carrier" of information, similar to a telephone company.[143] In the United States there is

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[134]Copyright Act, § 2 (Canada)—Literary work includes tables, *computer programs*, and compilations of literary works. In the United States, literary works are protected by the Copyright Act under 17 U.S.C. § 102 (a) (1) (U.S.) (1996).

[135]Gershwin Pub. Corp. v. Columbia Artists Management, Inc., 443 F. 2d 1159 (2d Cir. 1971).

[136]857 F. Supp. 679 (N.D. Cal. 1994).

[137]*Id.* at 687-89.

[138]*Id.* at 683-85.

[139]*Id.* at 686-87.

[140]A.B. Taitz, *Removing Road Blocks Along the Information Superhighway: Facilitating the Dissemination of New Technology by Changing the Law of Contributory Copyright Infringement* 64 GEO. WASH. L. REV. 133, 137 (1995); Shulman, *supra* note 102, at 569.

[141]Koster & Shatz-Akin, *supra* note 4 at 20.

[142]P. GOLDSTEIN, COPYRIGHT LAW AND PRACTICE 713 (1989); Shulman, *supra* note 102, at 569.

[143]*See* Religious Tech. Center v. Netcom On-Line Communication Services Inc., 907 F.Supp. 1361 (N.D. Cal. 1995); Burshtein, *supra* note 28, at 434.

legislation that shields On-line access providers from liability for transmitting "obscene materials" if they provide good faith and due diligence to rid their network of the offending material.[144]

2. Fair Dealing (Canada) and Fair Use (U.S.) Defenses

In Canada, an action that would otherwise be a copyright infringement will be permissible if the action falls within the defense or exception of "fair dealing."[145] In order for the exception to apply it must be considered "fair" and it must be for one of five specific purposes: (1) private study or research (section 29); (2) criticism or review (section 29.1); (3) newspaper reporting (section 29.2); (4) without motive of gain (section 29.3); and (5) reproduction for instruction (including performances) (section 29.4 and section 29.5).[146] The test of fair dealing is *purposive*, it is not simply a "mechanical test of measurement of the extent of copying involved."[147] Although the underlying purpose of the Fair Dealing and the equivalent U.S. Fair Use doctrine[148] are the same, there are important differences.[149] The fair use defense applies where a work is used "for purposes such as criticism, comment, news reporting, teaching . . . scholarship or research . . . ."[150] There are four statutory factors which the courts must address to ascertain whether a use of copyrighted work is considered to be "fair use": (1) the purpose and character of the accused use; (2) the nature of the copyrighted work; (3) the importance of the portion used in relation to the copyrighted work as a whole; and, (4) the effect of the accused use upon the potential market for or value of the copyrighted work.[151]

In the context of unauthorized cinematographic works appearing on the Internet, it would be difficult for an infringer to fall under one of the permitted uses established under the fair dealing and fair use exceptions, because many of the cinematographic images that appear are the Internet are illegitimate and for commercial benefit. It is rare for the naked image of a celebrity, directly copied from a motion picture, to appear on the Internet for an educational purpose or for the

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[144]Telecommunications Act of 1996, Pub. L. 104-104, 110 Stat. 56 (1996); *The IAHC Report* follows the guidelines set by the U.S., in claiming that the Copyright Act be amended so that no owner or operator of a BBS should be held liable for copyright infringement if they were unaware of the material offending copyright and they took good efforts to limit the copyright abuse; Burshtein, *supra* note 28, at 439-40.

[145]Copyright Act, § 29 (Canada).

[146]*Id.*; Bloom & Denholm, *supra* note 44, at 346.

[147]Allen v. Toronto Star Newspapers Ltd. (1997), 36 O.R. (3d) 201 (Ont. C.A.). This is a recent view of the fair dealing defense from the Ontario Court of Appeal. The law in Canada with respect to this area of the law has not been extensively developed.

[148]17 U.S.C. § 107 (1996).

[149]Bloom & Denholm, *supra* note 44, at 346-50. The Canadian Fair Dealing exception is a more restrictive view, and it is unlikely that the defense will be allowed without the express consent of the copyright holder. Whereas the Fair Use doctrine allows for a broader view of copyright defense, and multiple duplication may be permitted under the doctrine.

[150]*Supra* note 142.

[151]*Id.*

public interest. In most instances, the reason for posting explicit images of celebrities is "motive of gain." For example, in a majority of cases, nude celebrity images are posted on a Web page in the form of "banner" advertisements[152] to lure potential customers to join a pay adult-oriented site, or to generate a substantial volume of visits (also known as "hits") to that Web page. This is to allow advertisers to market their product (usually other sexually oriented Web pages) to would-be visitors.

A defense of fair use (and fair dealing) would also be difficult for ISPs and BBSs SYSOPS to establish as is evident in the *Netcom* case.[153] In *Netcom*, the Church of Scientology filed an action against a former member, Dennis Erlich, a BBS, and Netcom, an ISP providing Internet Access. The church alleged that Erlich posted confidential copyrighted church information onto the BBS through Netcom.[154] The court held that neither the BBS nor Netcom directly infringed the copyright or were liable for vicarious infringement, but they denied the defendants motion for summary judgment on the contributory infringement. As for Erlich, the court found that his extensive copying and lack of accompanying criticism, of copyrighted materials did not constitute a fair use defense. The court held that is was a question of fact whether Netcom and the BBS had valid fair use defenses. Thus, one could argue as in *Netcom*, that if a individual user posts a unauthorized copyrighted image from a cinematographic work on the Internet along with a detailed criticism which serves the "public interest," it could be considered fair use or fair dealing.[155]

## IV. ALTERNATIVE SOLUTIONS TO ALLEVIATE CELEBRITY AND CINEMATOGRAPHIC COPYRIGHT MISUSE ON THE INTERNET

### *A. Existing Solutions: Strengths and Weaknesses*

There are many legal theories with which a celebrity or film studio can go after an infringer of their copyright on the Internet. Using the Copyright Act is just one method. In most situations sending a standard cease and desist letter to the Webmaster or SYSOP of a BBS may do even more damage to the reputation of a celebrity or film studio.[156] The Internet community is closely knit, especially amongst those who have dedicated themselves to specific interests Web pages.

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[152]Banner Ads are the equivalent of commercial billboards. Specifically, a banner ad is a rectangle graphic (in ".jpg" or ".gif" format) which is often animated, advertising a product or service. Advertisers sometimes count banner "views," or the number of times a banner graphic image was downloaded over a period of time. According to Banner-ads.com, banner ads are "currently the most successful form of Web advertising and generate a considerable amount of traffic ("hits") for commercial web-sites (secondly to search engines)." Approximately, $367 million dollars was spent on Web advertising in 1996, and much of it included banner advertisements. (last visited October 2, 1999) <www.banner-ads.com/what.htm>.

[153]Religious Tech. Center v. Netcome On-Line Communication Services, 907 F. Supp. 1361 (N.D. Cal. 1995).

[154]*Id.* at 1365-66.

[155]Koster & Shatz-Akin, *supra* note 4, at 19.

[156]*Id.* at 21.

Hence, the potential for backlash, such as boycotting and other vocal means on the Internet is a realistic threat. The copyright holder could regret even starting the legal action in the first place.[157] Other weapons for preventing copyright infringement of celebrities on the Internet are commercial services which protect the image and persona of the celebrity. One such service is *Cybertrackers*, a service created by Lin Milano (Alyssa Milano's mother), which, for a fee of $600 to $2,000 a month, hunts down offending images of celebrities in cyberspace.[158] Another such service is SAFE (Security Association for Entertainers), which serves the entertainment industry by "helping celebrities through the most delicate of circumstances . . . protecting them from tabloid terrorism and unwanted Internet exposure."[159] However, these commercial organizations fail to recognize that most of the nude images that appear on the Internet are on the pay, adult-oriented Web pages for which one requires a user identification and a password to receive access. It is very easy to search the Web for nude images that are free, but, it is on these pay sites that the true copyright infringement is occurring.[160] For example, the *Playboy* cases discussed in Part II appeared on pay sites. What is needed is an effective method to identify all infringers of copyright of cinematographic works on the Internet, including pay and non-pay-adult oriented Web sites.

### *B. Proposal: Official Web Pages with Digital 'Signature' Files*

The most effective method for preventing the unauthorized dissemination of celebrity images on the Internet is for the copyright holders (celebrity or film studio) to create their own official Web page on which they provide the digitized images for individual users to download. Some of the major film companies in America have already begun using official web pages.[161] Each image should contain an authentic

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[157]In relation to Paramount Pictures copyright enforcement campaign (*see* Roccia & Kerber *supra* note 102) against web page creators who were violating the Star Trek copyright, a Web page creator, Steve Krutzler, threatened to boycott current Star Trek shows by posting a letter on his web page and for others to do the same. "If they're not going to back down, and we have to make the ratings fall, we will." Wire Magazine (visited October 15, 1998) <http://www.wired.com/news/story/1076.html>.

[158]*Dateline*, *supra* note 2; *see also* (visited on November 1, 1998) <http://www.cyber-tracker.com>.

[159](Visited Nov. 11, 1998) <http://www.cyber-tracker.com/Safe/index.htm>.

[160]Cyber-trackers has commenced legal action against pay oriented adult sites in the *Machinenet* and *Eight Ball, Inc.* court filings, *see supra* note 68.

[161]Virtually every new release of a motion picture has its own official web site set up by the film production company, and some sites include images and sound files from the movie themselves. For example, for the new upcoming release of "Star Trek: Insurrection", Paramount Pictures (visited on November 15, 1998) <http://www.paramount.com>, has set up an official Star Trek Web page (<www.startrek.com>) as promotion for the new film. The same holds true for the new release of the Star Wars prequel in May of 1999, in which official images of Episode I (the film's trailer) are available at (visited November 28, 1998) <http://www.starwars.com>. Furthermore, the terms of which the user can use these Web sites are also located on these film studio's Web Pages. For example Warner Brothers On-line Web Page (visited on November 17, 1998) <http://www.warnerbros.com/terms/html> includes in its terms and conditions for use that "[a]ll material on this site, including, but not limited to images, illustrations, audio clips, and video clips, is protected by copyrights which are owned

digital signature, similar to watermark embedded in paper.[162] This database of official images would provide the copyright holder with a mechanism for policing the Web for any infringing pictures that do not correlate with the files on their official home page. Since there is a concern as to the policing requirements of unauthorized images on the Internet, this shall provide for effective results. In addition to providing image files on their official Web pages, copyright holders could negotiate intricate licensing arrangements with the Webmaster or SYSOP, which would detail the duplication agreements for the copyrighted images.

The technique of digitized information encodes identifying information into the image file which cannot be removed, except by sophisticated decryption methods "designed to reveal and pluck out the identifying information from the surrounding data."[163] Some of the literature suggests that this method of digitized signature files will be used more as Internet content becomes more secure.[164] In addition to the digitized image files, and licensing arrangements, computer programs ("agents" or "robots") similar to one developed in the *Webbworld* case, that automatically download content from Web sites should be developed to search the Newsgroups and the WWW for any unauthorized celebrity images.[165] With the addition of digitized signature files, this would simplify the process of determining whether the image violates copyright.

Clearly the above proposal would lessen the backlash from fans where the film studios have threatened legal action through 'cease and desist' letters.[166] Furthermore, providing official copyrighted images on official Web page sites will reduce or eliminate unskilled scanning, and a majority of the fake 'pasty' photographs that put celebrities in false and pornographic likenesses. Maintaining a vigorous pursuit of those who infringe copyright will not be a problem with the film studios, since cost would not be a concern. The downfall to such a proposal is possible reduction in the quality and diversity of the images made available to the

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and controlled by Warner Bros. or by other parties that have licensed their material to WB Online."

[162]*See also* Koster and Shatz-Akin, *supra* note 4, at 22; and T.A. Unger, *Two Ways to Protect Copyrighted Works on the Web* (October 1995) INTELLECTUAL PROPERTY STRATEGIST at 8 for similar proposals. A digital signature is "unique and highly secure cryptographic codes, generated from the contents of the document (image), being signed and a password-protected private key of the signer." The signature allows the original owner of the document to keep track of their wares. *See* (visited on November 18, 1998) <http://www.digitalkey.com> and W.A. Hodkowski, *The Future of Internet Security: How New Technologies Will Shape The Internet and Affect the Law* 13 SANTA CLARA COMPUTER & HIGH TECH. L.J. 217, 233 (1997).

[163]Unger, *id.*

[164]*See* Hodkowski, *supra* note 162, Ballon, *supra* note 10.

[165]E.J. Heels, *Online - The Issue of Fair Use Hits a Slippery Slope when Offline Browsers Enter the Picture* (December 1998) 27 No. 4 ABA STUDENT LAWYER 14, 15. This downside to "agents" or "robots" is that Web masters or Sysops may not wish to have such programs visiting their sites. According to Heels, "[a] de facto industry standard called the "robots exclusion standard" has been devised to allow Web master [and Sysops] to restrict agent access to all or part of their Websites."

[166]Koster & Shatz-Akin, *supra* note 4, at 22.

Internet community. The variety of images provided by the film studios may not be to the preference (style, size, quality, format and quantity) of each individual Webmaster or SYSOP who wishes to enter into a licensing arrangement with the studio. This may even cause further disruptive behavior and, perhaps, more widespread unauthorized images of celebrities on the Internet.

## V. CONCLUSION

The persona and image of a celebrity is a valuable commercial commodity and should be protected from dissemination and misappropriation without authorization. The Copyright Acts of both Canada and the United States provide effective mechanisms for celebrities and film studios to pursue those who infringe their copyrights on the Internet. The Internet should not be considered a peculiar technological medium to which entrenched doctrines of intellectual property are inapplicable. Although the volume of jurisprudence is limited in Canada, the guiding principles established by U.S. courts can provide Canada and other jurisdictions with a basic foundation for procedural aspects of copyright misuse on the Internet. Because of the inherent "lawless" nature of the Internet and its "cyber-geographic" reach, the copyright holder must be aware that everyone who infringes their copyright cannot be held accountable — many of the users remain anonymous. Additionally, the copyright owner should also keep in mind that there is currently no means of collecting damages for the use of their works on the Internet. The digital signature image proposal is just one of many methods which copyright holders can use to protect their intellectual property On-line. Its effectiveness will depend on the cooperation and willingness of the Internet community to adapt new methods of posting images which comply with current copyright standards. The evolution of the Internet will undoubtedly continue to challenge lawmakers, who, if unaware of its latest capabilities, may find themselves trying to cover up more than their legal arguments.