

1 Andrew Delahunt, Esq. (SBN 285512)
2 Law Office of Andrew Delahunt
3 1801 Century Park East, 24th Floor
4 Los Angeles, CA 90067
5 Tel: (310) 984-6762
6 Fax: (310) 775-4466
7 andrew@andrewdelahunt.com

8 Kevin McCulloch, Esq. (*pro hac vice*)
9 Nate Kleinman, Esq. (*pro hac vice*)
10 McCulloch Kleinman Law
11 501 Fifth Avenue, Suite 1809
12 New York, NY 10017
13 Telephone: (212) 355-6050
14 Fax: (206) 219-6358
15 kevin@mkiplaw.com
16 nate@mkiplaw.com

17 *Attorneys for Plaintiff*

18 **UNITED STATES DISTRICT COURT**
19 **CENTRAL DISTRICT OF CALIFORNIA**

20 STEVE MITCHELL,

21 *Plaintiff,*

22 v.

23 LEBRON JAMES,

24 *Defendant.*

Civil Case No. 20-cv-08188-GW-JPR

**PLAINTIFF’S MEMORANDUM OF
LAW IN SUPPORT OF MOTION TO
DISMISS DEFENDANT’S
COUNTERCLAIMS**

Before: Hon. George H. Wu
Hearing: December 3, 2020 at 8:30am

TABLE OF CONTENTS

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF CONTENTS..... i

TABLE OF AUTHORITIES ii

INTRODUCTION 1

PROCEDURAL BACKGROUND AND SUMMARY OF ARGUMENT 3

ARGUMENT 8

I. GOVERNING STANDARDS OF REVIEW..... 8

II. DEFENDANT’S STATE LAW COUNTERCLAIMS ARE PREEMPTED BY THE COPYRIGHT ACT. 10

III. DEFENDANT LACKS STANDING..... 12

IV. THE APPLICABLE STATUTE OF LIMITATIONS SUBSTANTIALLY PRECLUDES DEFENDANT’S COUNTERCLAIMS. 16

V. THE COUNTERCLAIMS ARE NOT PLAUSIBLE AS PLEADED..... 17

VI. THE COUNTERCLAIMS SHOULD BE STRICKEN UNDER CALIFORNIA’S ANTI-SLAPP STATUTE..... 21

VII. THE COURT LACKS SUBJECT MATTER JURISDICTION OVER DEFENDANT’S COUNTERCLAIMS..... 23

CONCLUSION..... 25

TABLE OF AUTHORITIES

CASES

1

2

3 *Ashcroft v. Iqbal*, 556 U.S. 662 (2009)..... 9, 10

4 *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544 (2007)..... 8, 10

5 *Casas v. Brightwater Int’l, Inc.*, No. CV 10-7235 CAS (AGRx),
2011 WL 486564 (C.D. Cal. Feb. 1, 2011)..... 9

6 *Chapman v. Pier 1 Imports (U.S.) Inc.*, 631 F.3d 939 (9th Cir. 2011)
7 9

8 *Cher v. Forum Int’l, Ltd.*, 692 F.2d 634 (9th Cir. 1982) 18

9 *Coto Settlement v. Eisenberg*, 593 F.3d 1031 (9th Cir. 2010)..... 11

10 *Cusano v. Klein*, 264 F.3d 936 (9th Cir. 2001)..... 16, 17

11 *Dora v. Frontline Video Inc.*, 15 Cal. App. 4th 536 (1993)..... 17

12 *Fighters Incorporated, LLC v. Electronic Arts Inc.*, No. CV 09-
13 06389 SJO (VBKx), 2009 WL 10699504 (C.D. Cal. Oct. 30,
2009)..... 13

14 *Guadiya Vaishnava Soc’y v. City & County of San Francisco*, 952
15 F.2d 1059 (9th Cir. 1990) 19

16 *Hana Fin., Inc. v. Hana Bank*, 500 F. Supp. 2d 1228 (C.D. Cal.
2007)..... 8

17 *Hill v. Nat’l Collegiate Athletic Assn.*, 7 Cal. 4th 1, 26 Cal. Rptr. 2d
18 834 (1994)..... 15

19 *Hilton v. Hallmark Cards*, 599 F.3d 894 (9th Cir. 2010) 18

20 *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001)..... 19

21 *Iantosca v. Elie Tahara, Ltd.*, 2020 WL 5603538 (S.D.N.Y. Sept.
22 22, 2020)..... 5

23 *In re Syntex Corp. Sec. Litig.*, 95 F.3d 922 (9th Cir. 1996)..... 23

24 *Johnson v. Harcourt, Brace, Jovanovich, Inc.*, 43 Cal. App. 3d 880
(1974)..... 17

25 *Jones v. Corbis Corp.*, 815 F. Supp. 2d 1108 (C.D. Cal. 2011) 15, 20, 21

26 *Ketchum v. Moses*, 24 Cal. 4th 1122 (2001)..... 23

27 *KNB Enters. v. Matthews*, 78 Cal. App. 4th 362 (2000)..... 11

28 *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134 (9th Cir. 2006)..... 11, 14

1 *Local TV, LLC v. Superior Court*, 3 Cal. App. 5th 1 (2016) 18

2 *Maloney v. T3Media, Inc.*, 853 F.3d 1004 (9th Cir. 2017) 10, 19, 22

3 *Maloney v. T3Media, Inc.*, 94 F. Supp. 3d 1128 (C.D. Cal. 2015) 9

4 *Mango v. BuzzFeed, Inc.*, 970 F.3d 167 (2d Cir. 2020) 1

5 *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444 (S.D.N. Y
2005) 5

6 *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002) 19

7 *McCarthy v. United States*, 850 F.2d 558 (9th Cir. 1988) 9

8 *Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th 790
9 (1995) 17, 20

10 *Navellier v. Sletten*, 29 Cal. 4th 82 (2002) 10

11 *Safe Air for Everyone v. Meyer*, 373 F.3d 1035 (9th Cir. 2004) 9

12 *Sandow Fred Segal, LLC v. Cormackhill, LP*, No. CV 16-6653-VAP
(CFEx), 2017 WL 5714542 (C.D. Cal. Apr. 6, 2017) 14

13 *Sarver v. Chartier*, 813 F.3d 891 (9th Cir. 2016) 22

14 *Smith v. McCullough*, 270 U.S. 456 (1926) 24

15 *Sprewell v. Golden State Warriors*, 266 F.3d 979 (9th Cir. 2001) 10

16 *St. Paul Mercury Indem. Co. v. Red Cab Co.*, 303 U.S. 283 (1938) 25

17 *Turban v. Bar Giacosa Corp.*, No. 19-cv-1138, 2019 WL 3495947
18 (S.D.N.Y Aug. 1, 2019) 25

19 *U.S. ex rel. Newsham v. Lockheed Missiles & Space Co., Inc.*, 190
20 F.3d 963 (9th Cir. 1999) 21, 22

21 *United Mine Workers v. Gibbs*, 383 U.S. 715 (1966) 25

22 *Von Saher v. Norton Simon Museum of Art at Pasadena*, 592 F.3d
954 (9th Cir. 2010) 11

23 *Warth v. Seldin*, 422 U.S. 490 (1975) 12

24 *Yeager v. Bowlin*, 693 F.3d 1076 (9th Cir. 2012) 16

25 *Yeager v. Cingular Wireless LLC*, 673 F. Supp. 2d 1089 (E.D. Cal.
2009) 18

26

27 **STATUTES**

28 17 U.S.C. § 301(a) 10, 12

28 U.S.C. § 1332 23

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Cal. Civ. Code § 3344..... 24
Cal. Civ. Code § 3344(a) 23
Cal. Civ. Code § 3344(d) 17
Cal. Code Civ. Proc. § 425.16 21
Cal. Code Civ. Proc. § 425.16(c)(1) 23
OTHER AUTHORITIES
Restatement (Second) of Torts § 652C 19

1 Pursuant to Rules 12(b)(6) and 12(b)(1) of the Federal Rules of Civil Procedure, as well as
2 California Code of Civil Procedure § 425.16, Plaintiff Steve Mitchell (“Plaintiff” or “Mitchell”),
3 by and through undersigned counsel, hereby submits this Memorandum of Law in support of his
4 Motion to Dismiss Defendant’s Counterclaims for publicity rights violations under California law.

5 **INTRODUCTION**

6 The facts of this case are simple and not in any serious dispute, and they conclusively
7 establish that Defendant LeBron James (“Defendant” or “James”) is liable for violations of
8 Sections 501 and 1202 of the Copyright Act. Mitchell created and owns all the copyrights to a
9 photograph that James copied without permission from the social media account of Imagn Content
10 Services, LLC (“Imagn”), a division of the USA Today media network (“USA Today Sports”), a
11 commercial sports photography licensing company that licenses Mitchell’s work. (Plaintiff’s First
12 Amended Complaint, (“Amd. Compl.”), Dkt. No. 56 at ¶¶ 12-24.) Then, again without permission,
13 James republished his unauthorized copy of Mitchell’s photograph to his own social media
14 accounts while deliberately cropping and/or leaving out Mitchell’s credit line that, per industry
15 norms, had been included as a “gutter credit”¹ in the original Imagn post. (*Compare* Amd. Compl.
16 Ex. 3 *with* 4 (showing Plaintiff’s credit line in the original Imagn post that James illegally copied).)
17 There is no possible dispute that Mitchell created and owns the copyrights in this photograph and
18 that James violated those copyrights by copying and publishing the photograph without obtaining
19 (or even requesting) permission, which would have been simple given that the Imagn post included
20 a photo credit linking to Plaintiff’s account. Rather than making the minimal effort to request
21 permission, James instead copied and republished the photograph without permission and
22 intentionally removed the gutter credit attributing the photo to Mitchell in order to hide his
23 deliberate infringement.
24
25
26

27
28 ¹ A credit line under a photo identifying the photographer’s name/media outlet– the “gutter credit” – is standard practice in the sports editorial/news industry. *See Mango v. BuzzFeed, Inc.*, 970 F.3d 167, 169 (2d Cir. 2020) (“Below the Photo, the article included Mango’s name, an attribution known in the industry as a ‘gutter credit.’”).

1 After this lawsuit was filed, Defendant James also failed to comply with Plaintiff's
2 *repeated* demands that he remove the illegally copied photograph from his social media accounts.²
3 James ignored these demands and failed to remove the infringing content until very recently, nearly
4 *six months* after this lawsuit was filed. During that extended time, James's post—and the Nike
5 shoes it prominently features (*see* Amd. Compl. ¶¶ 35, 42-43, 49)—was visible to his 100 million
6 social media followers and garnered over *two million* "likes." (*Id.* Ex. 2.)

7
8 Despite these facts, James now contends that he did nothing wrong or that he was unaware
9 that stealing photographs from other social media accounts without permission was not allowed.
10 (*See* Dkt. No. 64 ("Def. Answer").) Both defenses are a farce. LeBron James is one of the most
11 prominent athletes on the planet. But more importantly, according to his own business ventures
12 and trademark filings, James is "More Than An Athlete," and that much is truly undeniable. James
13 is an extremely successful entrepreneur and businessperson. He owns production companies,
14 pizza franchises, has mega-million-dollar media and endorsement deals, and purportedly earns
15 \$300,000 for social media endorsements, making him one of the world's most successful social
16 media "influencers." James has dozens of trademarks to protect his own brand and the many and
17 varied brands and businesses that he owns. By any possible measure, James is as savvy of a
18 businessperson as there could be, and he undoubtedly has tremendous experience with intellectual
19 property matters. The notion that James did not know that he could not copy and republish
20 photographs from the social media account of a sports licensing business without even asking for
21 permission merely because he happened to appear in the photograph is beyond unreasonable.
22
23

24 Rather than simply admitting liability given the clear facts and working toward making
25 amends, James and his counsel have instead trotted out a baseless counterclaim against Plaintiff in
26

27 ² Specifically, the original Complaint was filed on March 17, 2020 and included a demand that the unauthorized
28 post be removed. James's business entities (which were former defendants) were served on or about March 19, 2020,
and James's counsel agreed to accept service for James personally on June 9, 2020. Plaintiff's counsel also expressly
demanded that James remove the photograph in a letter dated July 28, 2020. (Kleinman Decl. ¶ 2.)

1 a transparent attempt to bully and dissuade him from pursuing his righteous claims by needlessly
2 increasing the costs of this litigation. On this Motion, Plaintiff seeks to rid this litigation of James’s
3 meritless counterclaims which should be dismissed under settled and controlling law.

4 **PROCEDURAL BACKGROUND AND SUMMARY OF ARGUMENT**

5 Plaintiff initially filed suit in the Southern District of New York, alleging claims of
6 copyright infringement related to Defendant’s unauthorized use of Plaintiff’s photograph on his
7 social media accounts. On August 10, 2020, Defendant moved to transfer the case to this Court
8 and also filed an answer with counterclaims against Plaintiff for allegedly violating James’s right
9 of publicity under California law. Rather than waste time and resources litigating the appropriate
10 venue for his infringement claim, Plaintiff consented to the transfer, but did not concede that the
11 counterclaims had any merit or that this Court could exercise jurisdiction over Defendant’s entirely
12 unrelated state law counterclaims. (Dkt. No. 33.) The case was transferred to this Court on
13 September 11, 2020. (Dkt. No. 38.) On September 25, 2020, Plaintiff filed both a motion to
14 dismiss Defendant’s counterclaims (Dkt. No. 57) as well as a First Amended Complaint (Dkt. No.
15 56). Defendant filed an Answer to the First Amended Complaint with Counterclaims on October
16 16, 2020 (Dkt. No. 64). Apparently undeterred by the numerous deficiencies addressed in
17 Plaintiff’s prior motion, Defendant’s new countercomplaint is virtually the same in all material
18 aspects as the previous countercomplaint.
19
20

21 Again, James’s countersuit is nothing more than a transparent attempt to intimidate
22 Mitchell and to distract from James’s own blatant and willful infringement and violations of the
23 DMCA. It is galling for James to sue a court-side photographer for publicity rights violations when
24 (1) the photographer had a duly-authorized credential issued by the National Basketball
25 Association (“NBA”) to take these photos of James; (2) the photographer owns all copyrights in
26
27
28

1 those photos and thus is entitled under the Copyright Act to control their publication, and (3) the
2 Copyright Act expressly preempts any state law to the contrary.³

3 It is equally confounding that James alleges that Mitchell's publication *of his own*
4 *copyrighted photographs* somehow constitutes an unauthorized advertisement based on James's
5 likeness and image or an endorsement by James. Tellingly, James's counterclaim fails to disclose
6 to the Court that *no products* are advertised on Plaintiff's personal portfolio website – a visitor to
7 the website cannot purchase a print of these photos, cannot request a license to use these photos,
8 and the photos are not associated with any products. Mitchell's website also has never been used
9 to sell or advertise any products (Mitchell Decl. ¶ 15), and James' counterclaim alleges no facts to
10 support a contrary conclusion. Nor is it reasonable to construe Mitchell's website or social media
11 accounts as a platform for advertising his NBA photography services. As James certainly knows,
12 the NBA must issue proper media credentials for any freelance photographer to sit courtside and
13 take in-game photographs. (*Id.* ¶ 4.) And Mitchell already has contracted with a news media
14 outlet through which he has secured such credentials over the course of his career, and thus there
15 would be *absolutely no need* for Mitchell to use his personal website to advertise such services.
16 (*Id.* ¶ 3.) The photographs at issue in the countercomplaint also were never on the main landing
17 page of the website but rather in a sub-page gallery (*Id.* ¶ 22), cutting strongly against James's
18 unsupported and conclusory contention that these photographs served as an advertisement. Not to
19 mention that Mitchell's contact information is not even available on his website and thus a visitor
20 to his website would have no means of hiring Mitchell. (*Id.* ¶ 16.) James's woefully deficient
21 Counterclaim fails to allege any plausible facts that would support his conclusory allegations
22 construing Mitchell's website as an advertisement, and all *actual facts* discredit James's claims.
23
24
25
26
27

28 ³ Not to mention that, should this claim proceed to the merits, the evidence will show that the photographer's contract with the credentialing entity includes an express license and acknowledgement that he is entitled to publish the photos on his personal portfolio website. (Mitchell Decl. ¶ 30.)

1 Even if the website did serve as an advertisement or promotion of Mitchell’s photography
2 services, the inclusion of these specific photographs would be entirely proper as the advertising
3 value would derive not from James’s image or likeness, but rather *Mitchell’s own skill* in capturing
4 and creating dynamic and captivating photographs. Again, James fails to allege any actual facts
5 that would suggest his likeness, rather than *the photographs themselves*, are relevant to anyone
6 that would hire a professional photographer, a crucial distinction that is fatal to James’s claims.
7 *See, e.g., Iantosca v. Elie Tahara, Ltd.*, 2020 WL 5603538, at *6 (S.D.N.Y. Sept. 22, 2020)
8 (“Additionally, an original copyrightable photograph rendition concerns not ‘what is depicted, but
9 rather how it is depicted.’” (quoting *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 452
10 (S.D.N.Y. 2005)).
11

12 It is seriously inconsistent for James to challenge the rights of Mitchell—who created these
13 images as a photojournalist working under a valid media credential and who owns all copyrights
14 therein and thus is fully entitled to publish these undeniably newsworthy photos for non-
15 commercial purposes—while simultaneously claiming that he did nothing wrong and is protected
16 by “fair use” and other such defenses after blatantly copying Mitchell’s photograph and publishing
17 it, without any credit or a license, to his millions of social media followers on social media accounts
18 that he purposefully uses for commercial purposes. *See Iantosca*, 2020 WL 5603538, at *5-6
19 (finding Elie Tahari liable for infringement, and rejecting its affirmative defenses including fair
20 use, for posting a copyrighted photo of a model wearing its clothing to its social media account).
21

22 Defendant’s counterclaims are legally and factually deficient, preempted by the Copyright
23 Act, and in almost all cases barred by the applicable statute of limitations. They should be swiftly
24 dismissed and Mitchell should be awarded his attorneys’ fees under California’s anti-SLAPP law
25 for having to respond to such baseless claims that are obviously meant to intimidate him and drive
26 up the litigation costs of this straight-forward copyright claim.
27
28

1 mgt photographer who licenses his photos through Imagn Content Services, LLC (“Imagn”),
2 which is part of the USA Today media network. (Amd. Compl. ¶ 6-8; Mitchell Decl. ¶ 3). Plaintiff
3 is the author and copyright owner of his photographs, one of which is the subject of his underlying
4 infringement claims, and four others are believed to be the subject of Defendant’s counterclaims.
5 (Mitchell Decl. ¶ 9.) Defendant is a world-renowned professional basketball player in the NBA.
6 (Dkt. No. 64 at 12 (“Counter-compl.”), ¶ 6.) That is the extent of the commonality between the
7 facts supporting Plaintiff’s underlying infringement claim and Defendant’s counterclaims.
8

9 Defendant’s counter-complaint alleges that he “has generated enormous revenues through
10 licensing his image and likeness.” (Counter-compl. ¶ 10.) Defendant also alleges that he “has
11 never licensed or otherwise permitted the use of his image or likeness for any purpose to Plaintiff.”
12 (*Id.* ¶ 11.) That is demonstrably false, and Defendant knows it.

13 As Defendant knows full well, Plaintiff created all of the photographs at issue at NBA
14 games or events and he was able to attend and photograph such events – obviously for the express
15 purpose of photographing the players participating in these events and games, including James –
16 as a photojournalist pursuant to a media credential that was issued to him by the NBA as a USA
17 Today Sports photographer. (Mitchell Decl. ¶ 5.) Defendant also knows, but again conspicuously
18 fails to disclose to the Court, that under the collective bargaining agreement (“CBA”) between the
19 NBA and the NBA Players Association (“NBAPA”), James agreed to license his image and
20 likeness for publicity purposes through the NBA and league-related entities.⁴ Article XXVIII,
21 Section 1 of the CBA grants the NBA the right to use and sublicense “any performance by the
22 players . . . in any or all media[.]” Although unauthorized endorsements are excluded (which
23 James’s counsel disclaims is a claim at issue here), the CBA further provides that:
24
25

26 it shall not be an Endorsement for the NBA . . . to use, or authorize others to use,
27 including, without limitation, in third party advertising and promotional materials,

28 ⁴ The current CBA is publicly available on the NBAPA website (<https://nbpa.com/cba>). A true and correct copy of the CBA also is being submitted as an attachment to the declaration of Plaintiff’s counsel.

1 footage and photographs of a player’s participation in NBA games or other NBA
2 events that do not unduly focus on, feature, or highlight, such player in a manner
3 that leads the reasonable consumer to believe that such player is a spokesman for,
4 or promoter of, a third-party commercial product or service[.]

5 CBA Article XXVIII, Section 3(b). The CBA clearly and indisputably grants the NBA the right
6 to license player likenesses that are included in game photos to various media outlets for the
7 purpose of further licensing and distribution of those photos.

8 In other words, through the NBAPA and CBA, James licensed his image and likeness rights
9 to the NBA in order to allow the NBA to enter into broadcast licensing agreements and also to
10 allow for photographs of NBA players, including James, to be created during NBA games and
11 media events, which is precisely what happened here. And because James fails to allege – and
12 unquestionably would not be able to show – that the display of Plaintiff’s photos in galleries on
13 his personal website “leads the reasonable consumer to believe that such player is a spokesman
14 for, or promoter of, a third-party commercial product or service,”⁵ then *the license granted to*
15 *Mitchell under his duly authorized media credential granted him full rights to create and use the*
16 *photos of James at issue in this meritless counterclaim.*⁶

17 James also alleges that Plaintiff “uses [his] Website and [social media] to at least advertise
18 and promote [his] photography services” and to “encourag[e] consumers to retain him . . . and
19 provid[e] photographs for potential future licensees of Mitchell.” (Counter-compl. ¶¶ 20-21.)
20 These allegations also are inaccurate and seriously misleading. As noted already, Plaintiff does
21 not license or sell any photos through his website, which is used solely as a personal portfolio.
22 (Mitchell Decl. ¶¶ 11-16.) Indeed, Plaintiff’s contact information is not even included on this
23

24
25 ⁵ As required by this Court’s Local Rule 7-3, counsel conferred regarding the basis for this motion on
26 September 18, 2020. (Kleinman Decl. ¶ 3.) During that conference, Defendant’s litigation counsel expressly
27 confirmed that James does not assert any claim for unauthorized endorsement. As such, James cannot possibly now
28 contend that Mitchell’s use of the photograph would suggest that James “is a spokesman for, or promoter of, a third-
party commercial product or service” and thus Mitchell’s use of these photographs does not exceed the scope of the
license that James granted to the NBA and that the NBA in turn granted to USA Today and Mitchell.

⁶ Further, even if the case proceeds on the merits, Plaintiff’s contributor agreement with Imagn also expressly
permits noncommercial uses of these photographs on Mitchell’s personal website. (See Mitchell Decl. ¶ 5.)

1 website. (*Id.* ¶ 6.) There are no statements or other indications on Plaintiff’s website which would
2 suggest that the subjects of Plaintiff’s photos personally endorse Plaintiff’s photography services.
3 (*Id.* ¶ 14.)

4 Moreover, whether Plaintiff’s *website* serves to advertise or promote his services is not
5 relevant, the question is only whether Plaintiff used *James’s likeness* in an advertisement. Again,
6 to whatever extent any photographs on Plaintiff’s website serve to promote his work, the only
7 relevant advertising or promotional value derives entirely from *Plaintiff’s own skill* in creating
8 these images. These photographs also did not appear on the main page of Plaintiff’s website but
9 rather were included only in a sub-page gallery of assorted sports photographs that Plaintiff has
10 created over the course of his extensive career. (Mitchell Decl. ¶ 10.) Nor would Plaintiff need to
11 use James’s likeness to advertise his sports photography services since *he already has a freelance*
12 *contract with USA Today Sports* through which he receives the necessary media credentials to
13 photograph sporting events. (*Id.* ¶ 3.) Simply put, James alleges absolutely no actual facts that
14 could plausibly support his conclusory allegation that the use of his likeness was intended as an
15 advertisement of Plaintiff’s photography services.
16
17

18 ARGUMENT

19 I. GOVERNING STANDARDS OF REVIEW.

20 Counterclaims are subject to the same standard of review as the underlying claims at the
21 motion to dismiss stage. *See Hana Fin., Inc. v. Hana Bank*, 500 F. Supp. 2d 1228, 1232 (C.D. Cal.
22 2007) (“The [12(b)(6)] rule applies equally to a counterclaim.”). To survive a Rule 12(b)(6)
23 motion to dismiss, a complaint must “state a claim to relief that is plausible on its face.” *Bell*
24 *Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A claim is facially plausible “when the
25 pleaded factual content allows the court to draw the reasonable inference that the defendant is
26 liable for the misconduct alleged,” however, the Court is not required to accept as true
27
28

1 “[t]hreadbare recitals of a cause of action’s elements, supported by mere conclusory statements[.]”
2 *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009).

3 When considering a motion filed pursuant to Rule 12(b)(1) challenging a counter-
4 complaint’s jurisdictional allegations, “the Court is not restricted to the face of the pleadings, but
5 may review any evidence, such as declarations and testimony, to resolve any factual disputes
6 concerning the existence of jurisdiction.” *Casas v. Brightwater Int’l, Inc.*, No. CV 10-7235 CAS
7 (AGRx), 2011 WL 486564, at *1 (C.D. Cal. Feb. 1, 2011) (citing *McCarthy v. United States*, 850
8 F.2d 558, 560 (9th Cir. 1988)). A party’s standing is a threshold issue and required element for
9 Article III subject matter jurisdiction. *See Chapman v. Pier 1 Imports (U.S.) Inc.*, 631 F.3d 939,
10 954 (9th Cir. 2011) (noting that “[t]he existence of Article III standing is not subject to waiver”
11 and that “if the court determines at any time that it lacks subject-matter jurisdiction, the court
12 must dismiss the action.”). Where a factual challenge is made on standing, the Court may consider
13 extrinsic evidence. *See Safe Air for Everyone v. Meyer*, 373 F.3d 1035, 1039 (9th Cir. 2004) (“In
14 resolving a factual attack on jurisdiction, the district court may review evidence beyond the
15 complaint without converting the motion to dismiss into a motion summary judgment.”).

16
17
18 With respect to motions under California’s anti-SLAPP statute, courts take a two-pronged
19 approach. “First, the court determines whether the defendant has met his burden of proof that the
20 challenged cause of action arises from protected activity. If the court is satisfied that the claim
21 falls within the scope of the statute, then the burden shifts to the plaintiff to establish a probability
22 that [he or she] will prevail on the claim[s].” *Maloney v. T3Media, Inc.*, 94 F. Supp. 3d 1128, 1133
23 (C.D. Cal. 2015) (brackets in original). This Court held in *Maloney* that the publication of photos
24 on a public website constitutes protected activity under California’s ant-SLAPP statute. *Id.* at 1134
25 (finding that photos which “depict[ed] moments in NCAA sports history” properly “fall within the
26 realm of an issue of public interest.”). As such, the burden shifts to James to establish a probability
27 of prevailing on his claims. *Id.* (citing Cal. Code Civ. Proc. § 425.16(b)(1)). To do so he “must
28

1 demonstrate that the complaint is both legally sufficient and supported by a sufficient prima facie
2 showing of facts to sustain a favorable judgment if the evidence submitted by [him] is credited.”
3 *Id.* (quoting *Navellier v. Sletten*, 29 Cal. 4th 82, 88-89 (2002)).

4 **II. DEFENDANT’S STATE LAW COUNTERCLAIMS ARE**
5 **PREEMPTED BY THE COPYRIGHT ACT.**

6 Even accepting James’s allegations as true, the Ninth Circuit has made clear that state law
7 publicity rights claims are preempted by a copyright owner’s exclusive rights under the Copyright
8 Act when, as is the case here, the rights asserted are equivalent to one another. *See Maloney v.*
9 *T3Media, Inc.*, 853 F.3d 1004, 1011 (9th Cir. 2017) (affirming dismissal of publicity rights claim
10 as “preempted by section 301 of the Copyright Act” where defendant is “exercising rights
11 governed exclusively by copyright law”) (citing 17 U.S.C. § 301(a)). Because James’s
12 counterclaims seek to hold Mitchell liable simply for exercising rights to which he is fully and
13 unquestionably entitled as the copyright owner of the photographs at issue, these claims are
14 equivalent to a copyright owner’s protected rights and thus preempted by the Copyright Act.
15

16 James alleges that Plaintiff “has exploited Mr. James’s image and likeness for commercial
17 gain” (Counter-complaint ¶ 28), but makes no effort to provide any actual factual allegations to
18 support this conclusory characterization. *See Iqbal*, 556 U.S. at 678 (“A pleading that offers ‘labels
19 and conclusions’ or a ‘formulaic recitation of the elements of a cause of action will not do.’”)
20 (citing *Twombly*, 550 U.S., at 555); *Sprewell v. Golden State Warriors*, 266 F.3d 979, 988 (9th
21 Cir. 2001) (“The court need not . . . accept as true allegations that contradict matters subject to
22 judicial notice or by exhibit” or “allegations that are merely conclusory, unwarranted deductions
23 of fact, or unreasonable inferences.”). And the undeniable facts show James’s allegation is utterly
24 false.
25
26
27
28

1 Plaintiff's website serves merely as his personal portfolio. (Mitchell Decl. ¶ 12.) As the
2 Court (and any visitor to the website) can easily confirm⁷, Plaintiff does not offer to print, sell, or
3 license any images through his website—indeed, Plaintiff's *contact information is not even*
4 *provided* on his website. (Mitchell Decl. ¶ 11.) And there certainly is no indication that Mitchell
5 has ever used James's likeness to advertise or promote any services or merchandise, or that any of
6 the people depicted in Plaintiff's photos personally endorse his services. There are no statements
7 or other suggestions anywhere on Mitchell's website that could be construed as using James's
8 likeness to advertise, promote, or endorse any products or services. (*Id.* ¶ 14.) Thus, the only
9 conduct that forms the basis of James's counterclaims is the fact that Mitchell *displayed his own*
10 *copyrighted photos*—which he obviously has the exclusive right to do under the Copyright Act.
11

12 James pleads no actual factual content that would support a reasonable inference that
13 Mitchell used James's likeness for promotional or advertising purposes, and thus these claims are
14 preempted. *See Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1141 (9th Cir. 2006) (finding
15 publicity rights claim preempted by Copyright Act and distinguishing prior case in which the
16 defendant "went well beyond mere republication of the photograph. . . . Rather, it published the
17 photo in connection with a broad surf-themed advertising campaign, identified the plaintiffs-
18 surfers by name, and offered for sale the same t-shirts worn by the plaintiffs in the photo" and
19 "suggested that the surfers had endorsed Abercrombie's t-shirts."); *see also KNB Enters. v.*
20 *Matthews*, 78 Cal. App. 4th 362, 374 (2000) ("In our view, a section 3344 claim is preempted
21
22
23
24

25 ⁷ The Court is permitted to take judicial notice of the contents of Plaintiff's publicly-available website, both to
26 confirm what information is publicly available and because James's counterclaim obviously relies on the content of
27 Plaintiff's website and thus the website is considered incorporated by reference to the counterclaim. *See Von Saher*
28 *v. Norton Simon Museum of Art at Pasadena*, 592 F.3d 954, 960 (9th Cir. 2010) (taking judicial notice of public
articles "as an indication of what information was in the public realm at the time."); *Coto Settlement v. Eisenberg*,
593 F.3d 1031, 1038, (9th Cir. 2010) ("We have extended the doctrine of incorporation by reference to consider
documents in situations where the complaint necessarily relies upon a document or the contents of the document are
alleged in a complaint, the document's authenticity is not in question and there are no disputed issues as to the
document's relevance.").

1 under *Fleet* where an actor or model with no copyright interest in the work seeks to prevent the
2 exclusive copyright holder from displaying the copyrighted work.”).

3 Mitchell’s publishing of photos that he lawfully created under validly granted credentials
4 and to which he owns all copyrights, on his personal, non-commercial website was entirely for
5 expressive purposes and, as the copyright owner, *that is his exclusive right* under Section 106 of
6 the Copyright Act. Defendant cannot prohibit Plaintiff from exercising those rights provided to
7 him by the Copyright Act under the guise of a publicity rights claim. As the Ninth Circuit made
8 clear in *Maloney*, “where a likeness has been captured in a copyrighted artistic visual work and
9 the work itself is being distributed for personal use, a publicity-right claim is little more than a
10 thinly disguised copyright claim because it seeks to hold a copyright holder liable for exercising
11 his exclusive rights under the Copyright Act.” 853 F.3d at 1016; *see also Jules Jordan Video, Inc.*
12 *v. 144942 Canada Inc.*, 617 F.3d 1146, 1155 (9th Cir. 2010) (“If a plaintiff asserts a claim that is
13 the equivalent of a claim for infringement of a copyrightable work, that claim is preempted,
14 regardless of what legal rights the defendant might have acquired.”).

15
16
17 Because James’s counterclaims allege no factual content to show the photographs were
18 used in any advertisements, the challenged conduct fully “come(s) within the subject matter of
19 copyright,” and any claims asserting damages as a result “are governed exclusively by” the
20 Copyright Act. James is not entitled to bring claims “under the common law or statutes of any
21 State” that would diminish Mitchell’s rights in this regard. 17 U.S.C. § 301(a).

22 **III. DEFENDANT LACKS STANDING.**

23 A basic element of standing is that the claimant in fact owns the rights she claims have
24 been violated. *See Warth v. Seldin*, 422 U.S. 490, 499 (1975) (noting that “even when the plaintiff
25 has alleged injury sufficient to meet the ‘case or controversy’ requirement, this Court has held that
26 the plaintiff generally must assert his own legal rights and interests, and cannot rest his claim on
27 the legal rights or interests of third parties.”); *see also Fighters Incorporated, LLC v. Electronic*
28

1 *Arts Inc.*, No. CV 09-06389 SJO (VBKx), 2009 WL 10699504, at *5 (C.D. Cal. Oct. 30, 2009)
2 (discussing standing to sue for publicity rights violations, and noting that “[u]nder California law,
3 the right of publicity is assignable.”).

4 In order to create these photos, Mitchell secured a valid media/photojournalist credential
5 through Imagn. (Mitchell Decl. ¶ 3.) Mitchell presumes – and James does not allege otherwise –
6 that Imagn obtained proper permission from the NBA to secure media credentials on behalf of
7 courtside photographers, including Mitchell, for the express purpose of capturing in-game
8 photographs of NBA players, including James, and licensing those photos for editorial purposes.
9 (*Id.* ¶ 4.) The NBA “Uniform Player Contract” – attached as Exhibit A to the CBA – provides the
10 NBA with “exclusive rights” to distribute and license any performance by the players, including
11 “the Player’s . . . picture, portrait, [and] likeness[.]” (*See* Kleinman Decl. Ex. 1 at A-13, A-14.)
12

13 In other words, James, like all NBA players, assigned to the NBA the right to act as his
14 agent and/or exclusive licensor for broadcasts, videos, and photographs created during NBA events
15 and games. And the NBA did in fact grant permission and license to Mitchell, via Imagn, to attend
16 these NBA games and events as a photojournalist under a valid media credential, which granted
17 Mitchell valid rights to capture the photographs of James at issue. James does not and cannot
18 dispute this. The terms of that permission unquestionably allow these same media outlets to later
19 publish, license, sell, distribute, and otherwise exploit the images that have been created by their
20 credentialed photographers for editorial purposes. Indeed, that is the *entire purpose* of the NBA’s
21 granting such media credentials to photographers who attend these games on behalf of their
22 respective news organizations. And that is precisely why James does not assert any claims against
23 Imagn and could make no plausible objection to Imagn and its multitude of sublicensees that have
24 published and marketed these exact same photographs. It is telling that James has sued only the
25 courtside photographer whose photograph he illegally copied for publishing photos on his personal
26 portfolio page, but makes no attempt to preclude Imagn and its downstream affiliates to which
27
28

1 Mitchell sold the rights to license his photographs from publishing and selling these exact same
2 photos—along with many thousands of other photos of James playing in NBA games.⁸

3 These facts are fatal to James’s countersuit because they show he cannot have standing to
4 pursue any claim for unauthorized use of these photographs, under any circumstances. Any claim
5 that Mitchell lacked full and valid permission to create and exploit these photographs not only is
6 baseless but, even if it had some shred of truth, would actually be a claim for breach of contract
7 and not a tort claim against Mitchell—*i.e.*, that Mitchell violated the terms of the license granted
8 by the NBA to Imagn and/or the sub-license granted to Mitchell by Imagn. *See Laws*, 448 F.3d,
9 at 1144 (noting that “if Elektra licensed ‘Very Special’ to Sony in violation of its contract with
10 Laws, her remedy sounds in contract against Elektra, not in tort against Sony.”). And neither of
11 those contract claims appear to be claims for which James has standing to pursue against Mitchell,
12 as he is not a party to any of the relevant licenses. *See, e.g., Sandow Fred Segal, LLC v.*
13 *Cormackhill, LP*, No. CV 16-6653-VAP (CFEx), 2017 WL 5714542, at *5 (C.D. Cal. Apr. 6,
14 2017) (dismissing counterclaims for tortious interference with license agreement because
15 “Defendant ha[d] no direct rights under the license agreement.”). In no case do the facts support
16 James’s trumped-up right of publicity claim under California state law. The rights that Mitchell
17 exercised are fully protected by the Copyright Act—as evidenced by the fact that he obtained a
18 valid media credential to create these photographs and retained the rights to publish these
19 photographs on his personal website under the contract he granted to his licensing company Imagn.
20
21
22

23 The heart of a publicity rights claim under California law is that, considering the full
24 context and circumstances, a defendant lacked consent to use the claimant’s image/likeness for
25

26 ⁸ This is a clear acknowledgment that James knows full well that the NBA granted a media credential to Mitchell
27 to capture these photographs and that this credential included a proper and valid license to Mitchell allowing him to
28 sell and license those photographs. Moreover, in exchange for the license that he granted to Imagn to act as his agent
in licensing and exploiting these photographs, Mitchell received an express license from Imagn to display in-game
photographs, including these photographs, on his personal website/portfolio. (Mitchell Decl. ¶ 5.)

1 commercial gain and thus violated that person’s privacy interests and expectations. *See Hill v.*
2 *Nat’l Collegiate Athletic Assn.*, 7 Cal. 4th 1, 26 Cal. Rptr. 2d 834, 849 (1994) (“[T]he plaintiff in
3 an invasion of privacy case must have conducted himself or herself in a manner consistent with an
4 actual expectation of privacy, i.e., he or she must not have manifested by his or her conduct
5 voluntary consent to the invasive actions of defendant.”). Even setting aside that Mitchell made
6 no commercial use of James’s likeness, James must still allege and show that he is the one who
7 would be entitled to grant such permission as it pertains to *these specific photographs* which were
8 taken during NBA-sanctioned events and games and thus subject to the NBA’s control under the
9 CBA. *See Jones v. Corbis Corp.*, 815 F. Supp. 2d 1108, 1115-16 (C.D. Cal. 2011), *aff’d*, 489 F.
10 App’x 155 (9th Cir. 2012) (discussing consent and rejecting publicity rights claim where the
11 “[p]laintiff consented to the display of her likeness for the purpose of distributing the images
12 themselves. . . .whether or not the displaying parties are the photographers or third parties like
13 Defendant that merely act as distributors for the photographers.”). Put another way, James’s
14 claims do not pertain to a hypothetical use of his likeness or a hypothetical image, but rather to his
15 image and likeness *as captured in the specific photographs created by Mitchell himself*.
16 Accordingly, James’s claim must allege that James still controls his image/likeness rights as they
17 were captured in these specific photos, which he does not. *See id.*, at 1117 (noting that “[t]he
18 Court’s consent analysis . . . is highly individualized and depends on the circumstances
19 surrounding each photograph, Plaintiff’s knowledge of the circumstances, Plaintiff’s past industry
20 experience and conduct, and other evidence of Plaintiff’s conduct that would reasonably imply
21 consent.”). James’s counterclaims include no such allegations.
22
23
24

25 The reason that James fails to allege facts sufficient to establish standing is that he knows
26 full well that he cannot make out such a claim. If Plaintiff truly needed a license to use *these*
27 *specific photographs* of James on his personal website, he would not go to James to purchase those
28 rights. Nor would he go to the NBA. Instead, he would go to Imagn to purchase the supposedly

1 necessary license. That is because, once again, James already granted the NBA the rights to act as
2 his exclusive agent in licensing rights to the media to create photographs of James when he appears
3 at NBA-sanctioned events and games. And the NBA did in fact license those rights to Imagn
4 under a media credential issued to Mitchell. Thus, the *only entity* capable of granting a license to
5 Mitchell to use *these specific photographs* is Mitchell himself, or his licensing agency Imagn.
6 James has alleged no facts that would plausibly establish that he has any rights in or to these photos,
7 and he certainly could not grant the license that he now claims would be necessary for Mitchell to
8 publish these photographs on his personal website. Those rights lie entirely with Mitchell, and his
9 licensing agency Imagn.
10

11 **IV. THE APPLICABLE STATUTE OF LIMITATIONS SUBSTANTIALLY** 12 **PRECLUDES DEFENDANT’S COUNTERCLAIMS.**

13 The statute of limitations for a right of publicity claim under California law is two years.
14 *See Cusano v. Klein*, 264 F.3d 936, 950 (9th Cir. 2001) (citing Cal. Code Civ. Proc. § 339).
15 Pursuant to the “single-publication” rule, the limitations period begins to run when the allegedly
16 infringing content was first published and is not reset unless republished in an altered format or
17 medium. *Id.*; *Yeager v. Bowlin*, 693 F.3d 1076, 1082 (9th Cir. 2012) (“[O]nce a defendant
18 publishes a statement on a website, the defendant does not republish the statement simply by
19 continuing to host the website” and “a statement on a website is not republished unless the
20 statement itself is substantively altered or added to, or the website is directed to a new audience.”).
21

22 Although James does not specifically identify the photos that allegedly violate his right of
23 publicity on Mitchell’s website (which itself makes the countersuit inadequately pleaded), Mitchell
24 has identified a total of four photos of James that were previously displayed thereon. (Mitchell
25 Decl. ¶ 10.) Of the four photos, three were published more than two years ago (*id.* ¶ 12), and are
26 thus time-barred under California law. Even if James only recently became aware of the photos,
27 Mitchell has not fraudulently concealed his website from James or taken any action that would
28

1 have reasonably prevented him from discovering these photos earlier, and thus any argument that
2 the “discovery rule” should apply is baseless. *See Cusano*, 264 F.3d at 949-50 (rejecting
3 application of the discovery rule and noting that “[g]enerally, the ‘statute of limitations will begin
4 to run regardless of whether a plaintiff is aware that he has a cause of action’”) (quoting *Johnson*
5 *v. Harcourt, Brace, Jovanovich, Inc.*, 43 Cal. App. 3d 880, 896 (1974)). Thus, at the very least,
6 James’s counterclaims should be dismissed as untimely with respect to three of the four photos.

7
8 **V. THE COUNTERCLAIMS ARE NOT PLAUSIBLE AS PLEADED.**

9 Even setting aside the fatal jurisdictional flaws and standing issues of James’s
10 counterclaims, the claims are not adequately pleaded because they are not supported by any actual
11 factual content and are meritless as a matter of law.

12 Section 3344 of the California Civil Code prohibits the knowing use of another’s likeness
13 “for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or
14 services, without such person’s prior consent[.]” A statutory exception is made for “uses in
15 connection with any news, public affairs, or sports broadcast or account, or any political
16 campaign.” Cal. Civ. Code § 3344(d). Although commercial use is not a requirement of a common
17 law right of publicity claim, there must still be a lack of consent and resulting injury, and a similar
18 exception is made for “[p]ublication of matters in the public interest, which rests on the right of
19 the public to know and the freedom of the press to tell it[.]” *Dora v. Frontline Video Inc.*, 15 Cal.
20 App. 4th 536, 542 (1993); *see also Montana v. San Jose Mercury News, Inc.*, 34 Cal. App. 4th
21 790, 793 (1995).

22
23 In order to satisfy the first element of a publicity rights claim under § 3344, James must
24 adequately allege with actual factual statements, not conclusory characterizations, that Mitchell
25 has used James’s likeness “for purposes of advertising” his photography services and/or photos.
26 However, California courts have made clear that the publication of authorized content itself does
27 not constitute improper “advertising” for purposes of publicity rights claims. *See Local TV, LLC*
28

1 *v. Superior Court*, 3 Cal. App. 5th 1, 9 (2016) (noting that “[a]dvertising using a publication’s
2 content does not violate the right of publicity of a person appearing in the advertising, unless the
3 advertisement implies that the person is endorsing the publication.”) In other words, Mitchell’s
4 publication of his own works on his website cannot simultaneously be construed as an
5 advertisement of that work. *Id.* (“[T]he use of [the plaintiff’s] name and picture was not for
6 ‘advertising and publicizing’ the stations or their content, any more than a traditional newspaper
7 headline and photo of a columnist constitutes advertising or publicity for the newspaper.”).
8 Plaintiff’s website does not include any commentary accompanying the photos or means of
9 purchasing them or hiring Plaintiff. (Mitchell Decl. ¶ 14.) Indeed, his contact information is not
10 even included. (*Id.* ¶ 16.) Moreover, the photos of James at issue were not displayed on the
11 landing page of Mitchell’s website, and to view them the visitor was required to click through
12 multiple subpages/galleries. (*Id.* ¶ 22.) The photos of James were only a small fraction of the
13 total number of photos displayed on the site, and were given no particular emphasis or indication
14 that James had endorsed Mitchell’s services, thus making any commercial benefit from the use of
15 James’s likeness incidental at best and secondary to the value manifested in the quality of the
16 photos themselves. *See Cher v. Forum Int’l, Ltd.*, 692 F.2d 634, 639 (9th Cir. 1982) (holding
17 advertisements not actionable where “merely an adjunct of the protected publication and promote[]
18 only the protected publication.”).

21 By displaying his own copyrighted works, Plaintiff is *not* misappropriating Defendant’s
22 likeness for commercial gain, “the prevention of which is the core of the right of publicity[.]”
23 *Hilton v. Hallmark Cards*, 599 F.3d 894, 910 (9th Cir. 2010). The primary value of Plaintiff
24 displaying his photos on his personal website was to show the quality of the photos themselves,
25 not to exploit the subjects shown therein, of which there were many others besides James. *See*
26 *Yeager v. Cingular Wireless LLC*, 673 F. Supp. 2d 1089, 1100 (E.D. Cal. 2009) (“A claim is also
27 not actionable when a plaintiff’s likeness is appropriated because ‘it is published for purposes other
28

1 than taking advantage of his reputation, prestige, or other value associated with him.”) (quoting
2 Restatement (Second) of Torts § 652C, comment d).

3 However, even if Defendant could show that Plaintiff received some incidental benefit
4 through the use of James’s likeness, First Amendment principles would plainly outweigh any
5 alleged privacy rights in this case. *See Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185-
6 86 (9th Cir. 2001) (finding use of photo/celebrity likeness in magazine was not purely “commercial
7 speech,” even if it helped promote sales, and thus was entitled to full First Amendment protection,
8 barring a showing of “actual malice”). Where “speech is not purely commercial—that is, if it does
9 more than propose a commercial transaction—then it is entitled to full First Amendment
10 protection.” *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 906 (9th Cir. 2002). Plaintiff’s
11 photographs are original works of authorship – *i.e.* artworks – not simply monetary assets.
12 Plaintiff’s website is used as a platform to display his portfolio of works in various subject matter
13 galleries. (Mitchell Decl. ¶ 12.) Thus, the display of the photos themselves is primarily expressive,
14 and do not merely “propose a commercial transaction.” Plaintiff’s display of photos cannot
15 possibly be construed as purely commercial speech and thus he is entitled to “full First Amendment
16 protection.” *Id.*; *see also Hoffman*, 255 F.3d, at 1185 (“Any commercial aspects are ‘inextricably
17 entwined’ with expressive elements, and so they cannot be separated out ‘from the fully protected
18 whole.’”) (quoting *Guadiya Vaishnava Soc’y v. City & County of San Francisco*, 952 F.2d 1059,
19 1064 (9th Cir. 1990)); *accord Maloney*, 853 F.3d, at 1016 (“Conversely, when defendants’ uses
20 constitute expressive, right-of-publicity claims have been preempted.”) (internal quotes omitted).

21
22
23
24 Moreover, Plaintiff’s website biography page states in part that he is a “photojournalist
25 [who] has spent the last 27 years capturing the decisive moment[s] on all levels of professional
26 sports to collegiate sports[.]” The photos Plaintiff chooses to post on his website do not just
27 showcase Plaintiff’s creativity and skill as a photographer, they also depict some of the most
28 pivotal and newsworthy moments Plaintiff has captured throughout his career as a photojournalist.

1 (Mitchell Decl. ¶ 20.) For example, one of the images at issue depicted Defendant standing among
2 Dwayne Wade and Chris Bosh – known as the “Big 3” – at a 2011 media day event, shortly after
3 James signed with the Miami Heat, a decision that caused considerable publicity and controversy.
4 (Mitchell Decl. ¶ 11.) Another photo shows Defendant wearing a black protective face mask
5 during a game in 2014 after having broken his nose—a choice of equipment that caused
6 controversy with NBA league officials.⁹ (*Id.*) As one of the most famous athletes in the world,
7 there can be no dispute that such images of Defendant are “newsworthy and of public interest,”
8 and thus Plaintiff’s use of them on his website is not actionable as a violation of Defendant’s right
9 of publicity. *See Montana*, 34 Cal. App. 4th at 795 (finding sale of posters depicting Joe Montana
10 in Super Bowl games a “form of public interest presentation to which protection must be
11 extended.”).

12
13 The second critical element of a publicity rights claim is lack of consent. As discussed
14 above, Defendant has undoubtedly consented to having his photograph taken and licensed by the
15 NBA to credentialed media outlets. This Court has rejected the argument that a celebrity/public
16 figure could simultaneously consent to having their photo taken at a public event and subsequently
17 distributed, yet object to the online display of those photos for licensing and distribution purposes.
18 *See Jones*, 815 F. Supp., 1114 (finding that “not only did Plaintiff understand that her red
19 carpet photographs would be displayed to potential customers to solicit sales and do nothing for
20 over 40 years, but the undisputed record shows it would be contrary to well-established industry
21 practices for a celebrity to consent to the sale and distribution of her photographs but not consent
22 to the display of the photographs to potential customers to facilitate sales.”). Just as Defendant
23 could not (and presumably does not) object to his likeness being included in the substantial number
24 of images displayed and licensed through the Imagn website, he cannot legitimately object to
25
26
27

28 ⁹ See Brian Windhorst, *Source: LeBron James seeks appeal*, ESPN, Feb. 28, 2014, at https://www.espn.com/nba/truhoop/miamiheat/story/_/id/10535429/nba-asks-lebron-james-miami-heat-wear-clear-mask-protect-broken-nose

1 Plaintiff's personal use at issue here. *See id.*, 815 F. Supp. 2d at 1115-16 (rejecting argument that
2 scope of consent was limited to individual photographers and did not extend to licensing
3 entity/assignees.).

4 Lastly, Defendant cannot plausibly claim any actual damages – let alone damages in excess
5 of \$75,000 – resulting from Mitchell's limited use of his photos, when those same photos are being
6 displayed, sold, and distributed on the Imagn website along with thousands of others. As discussed
7 above, Defendant *already* assigned his likeness rights to the NBA for in-game photos and media
8 events, who in turn granted a license to Imagn/Plaintiff for display and sublicensing. Defendant
9 could not assert damages resulting from the display of his image in a photograph taken by Plaintiff
10 and subsequently licensed to a different media outlet (*e.g.*, Sports Illustrated), and he similarly
11 cannot claim he has suffered any harm from Plaintiff's own display of the photos.
12

13 Defendant can point to no case in which a photographer/copyright owner has been found
14 liable for violating the publicity rights of the subject of the photo merely by publishing the photo
15 on the photographer's personal website. Because he has not plausibly pleaded any facts that
16 establish any of the elements of a publicity rights claim under California law – lack of consent,
17 commercial use, and resulting injury – Defendant's counterclaims necessarily fail and should be
18 dismissed as inadequately pleaded.
19

20 **VI. THE COUNTERCLAIMS SHOULD BE STRICKEN UNDER CALIFORNIA'S**
21 **ANTI-SLAPP STATUTE.**

22 James's newfound objection to Mitchell's personal use of his own photos is nothing more
23 than a thinly veiled attempt to increase costs and intimidate Mitchell from continuing to pursue his
24 infringement claims and petition the Court for redress. Under California's anti-SLAPP law, such
25 meritless, baldly retributive, and chilling claims are subject to early dismissal. *See* Cal. Code Civ.
26 Proc. § 425.16; *U.S. ex rel. Newsham v. Lockheed Missiles & Space Co., Inc.*, 190 F.3d 963, 970-
27 71 (9th Cir. 1999) (“The hallmark of a SLAPP suit is that it lacks merit, and is brought with the
28

1 goals of obtaining an economic advantage over a citizen party by increasing the cost of litigation
2 to the point that the citizen party’s case will be weakened or abandoned, and of deterring future
3 litigation.”).

4 As discussed herein – and as the Court held in *Maloney* – James’s counterclaims, which
5 attempt to prevent Mitchell from displaying his own copyrighted works, are meritless on *several*
6 grounds and thus he cannot possibly establish a probability of prevailing. In fact, the claims here
7 are even *less* likely to prevail than those in *Maloney* because Mitchell was not even selling or
8 licensing the photos at issue on his website. *See Maloney*, 853 F.3d at 1016, n. 9 (noting that
9 “T3Media’s decision to license expressive works for a fee does not change the fact that the
10 publicity-right claims target the *display* and *distribution* of copyrighted photographs for personal
11 use. Moreover, copyright holders are allowed to commercially exploit their copyrights by
12 exercising their exclusive rights under the Copyright Act.”) (emphasis in original).

14 In addition to being preempted by the Copyright Act, Defendant’s counterclaims are
15 precluded by the First Amendment given that Plaintiff’s display of his creative works is not
16 commercial speech and thus prohibiting him from doing so under the guise of publicity rights law
17 would constitute a pure content-based speech restriction. *See Sarver v. Chartier*, 813 F.3d 891,
18 905-06 (9th Cir. 2016) (“The Hurt Locker is speech that is fully protected by the First Amendment,
19 which safeguards the storytellers and artists who take the raw materials of life . . . and transform
20 them into art, be it articles, books, movies, or plays. If California’s right of publicity law applies
21 in this case, it is simply a content-based speech restriction.”). Because Defendant’s counterclaims
22 are entirely meritless and were clearly asserted in this case for no other reason than to “increas[e]
23 the cost of litigation to the point that [Plaintiff’s] case will be weakened or abandoned,” *Newsham*,
24 190 F.3d, at 970, the counterclaims should be dismissed pursuant to California’s anti-SLAPP law.

27 Where a claim is stricken pursuant to California’s anti-SLAPP statute, the prevailing
28 defendant “shall be entitled to recover his or her attorney’s fees and costs.” Cal. Code Civ. Proc.

1 § 425.16(c)(1); *see also Ketchum v. Moses*, 24 Cal. 4th 1122, 1131 (2001) (holding that “any
2 SLAPP defendant who brings a successful motion to strike is entitled to mandatory attorney
3 fees.”). California’s right of publicity statute itself also provides for the mandatory recovery of
4 attorney’s fees and costs to the prevailing party. Cal. Civ. Code § 3344(a). Thus, should the Court
5 grant this motion and dismiss James’s counterclaims, it also must award Mitchell his reasonable
6 attorneys’ fees and costs. A fee award is all the more warranted given that Defendant not only
7 filed but *re-filed* baseless counterclaims, even after being made aware of the various deficiencies.
8

9 Mitchell’s counsel is prepared to submit promptly to the Court contemporaneous
10 documentation regarding their hourly fees in the event this motion is granted.

11 **VII. THE COURT LACKS SUBJECT MATTER JURISDICTION OVER**
12 **DEFENDANT’S COUNTERCLAIMS.**

13 James asserts that the Court has subject matter jurisdiction over his counterclaim pursuant
14 to diversity of citizenship under 28 U.S.C. § 1332. (Counter-compl. ¶ 1.) To support this assertion,
15 James alleges in conclusory fashion merely that “Mitchell’s unauthorized exploitation of Mr.
16 James’s image and likeness has caused Mr. James actual damages, in an amount in excess of
17 \$75,000.” (*Id.* ¶ 34.) Other than the vague allegation that James “has generated enormous
18 revenues through licensing his image and likeness,” (*id.* ¶ 10) there is no other factual assertion or
19 support to show that James actually has suffered damages in excess of the \$75,000 threshold
20 required to bring a claim under diversity jurisdiction. Despite already being alerted to this
21 deficiency and having an opportunity to include substantive and plausible allegations regarding
22 subject matter jurisdiction, Defendant chose to submit the same conclusory allegations.
23

24 Such conclusory and vague allegations regarding the amount in controversy requirement
25 under section 1332 are not sufficient to state a plausible claim. *See In re Syntex Corp. Sec. Litig.*,
26 95 F.3d 922, 926 (9th Cir. 1996) (“[C]onclusory allegations of law and unwarranted inferences are
27 insufficient to defeat a motion to dismiss for failure to state a claim.”); *Smith v. McCullough*, 270
28

1 U.S. 456, 459 (1926) (“A plaintiff suing in a federal court must *show* in his pleading, *affirmatively*
2 *and distinctly*, the existence of whatever is essential to federal jurisdiction, and, if he does not do
3 so, the court, on having the defect called to its attention . . . must dismiss the case, unless the defect
4 be corrected by amendment.”) (emphasis added).

5 Defendant’s allegation regarding his damages is not only insufficient, but factually untrue.
6 Section 3344 of the California Civil Code provides in relevant part that injured parties are entitled
7 to “an amount equal to the greater of seven hundred fifty dollars (\$750) or the actual damages
8 suffered by him or her as a result of the unauthorized use and any profits from the unauthorized
9 use[.]” As discussed herein, it simply is not plausible that Mitchell’s use of four images on his
10 personal portfolio website in a gallery among many dozens of other images has caused *any* damage
11 to James’s reputation or the commercial value of his likeness—let alone damages in excess of
12 \$75,000. Plaintiff’s website is not used to license, print, or sell any of the images or any
13 merchandise or products whatsoever. (Mitchell Decl. ¶ 10.)
14

15 Moreover, even if Plaintiff *were* required to obtain a license to display the photos on his
16 website, it would have been purchased from Imagn – not Defendant – and it would have cost far
17 less than \$75,000. Unless James can plead actual facts plausibly supporting his conclusion that
18 the value of his likeness has been diminished or that he would be entitled to any royalties from the
19 licensing of these specific photos – neither of which he has done or could plausibly do – then he
20 certainly cannot establish the damages necessary to establish diversity jurisdiction.
21

22 The notion that James has suffered actual damages (in any amount) from Plaintiff’s limited
23 use of photos on his portfolio website – but somehow not from the use of *those exact same photos*
24 on Imagn’s licensing platform or on the websites of countless other stock photo websites that offer
25 Mitchell’s sports content to media outlets around the world – is not remotely plausible or supported
26 by any pleaded facts. In fact, the opposite is much more plausible: that the proliferation of
27 court-side, high-quality photographs of James playing basketball through licensing channels brings
28

1 more attention to James and makes his rights of publicity more valuable. The Court should dismiss
2 James’s counterclaim on this ground alone. *See St. Paul Mercury Indem. Co. v. Red Cab Co.*, 303
3 U.S. 283, 289 (1938) (“[I]f, from the face of the pleadings, it is apparent, to a legal certainty, that
4 the plaintiff cannot recover the amount claimed or if . . . the court is satisfied to a like certainty
5 that the plaintiff never was entitled to recover that amount . . . the suit will be dismissed.”).

6 Although James’s counter-complaint does not assert that the Court could exercise
7 supplemental jurisdiction over his state law counterclaims, such an argument would fail even if
8 the Court were to consider it. The facts allegedly supporting James’s counterclaims are entirely
9 separate from and unrelated to the facts underlying Mitchell’s infringement claim. The
10 photographs at issue in the counterclaim are not the same as the photograph that is the subject of
11 Mitchell’s infringement claims against James. Nor were the photographs taken in the same game,
12 or even season. In fact, James is playing on an entirely different team now. The photographs also
13 did not appear on the same websites and were taken under different credentials. In short, the
14 publicity claims now being brought by James have absolutely nothing to do with Mitchell’s
15 infringement claims, and thus the two claims do not possibly “share a ‘common nucleus of
16 operative fact’ with the underlying claim” *Turban v. Bar Giacosa Corp.*, No. 19-cv-1138, 2019
17 WL 3495947, at *3 (S.D.N.Y. Aug. 1, 2019) (quoting *United Mine Workers v. Gibbs*, 383 U.S.
18 715, 725 (1966)), as required to invoke this Court’s supplemental jurisdiction. Other than having
19 common parties, the claims share essentially *no* overlapping facts – let alone operative facts – and
20 thus lack the “logical relationship” required even for a permissive counterclaim. *Id.* at *3-4.
21
22
23

24 CONCLUSION

25 For the forgoing reasons, Plaintiff’s motion to dismiss Defendant’s counterclaims should
26 be GRANTED and the Court should award Plaintiff his reasonable fees in bringing this Motion.
27

28 Dated: October 20, 2020

Respectfully submitted,

/s/ Nate Kleinman
Nate Kleinman (*pro hac vice*)
Kevin McCulloch, Esq. (*pro hac vice*)
McCulloch Kleinman Law
501 Fifth Avenue, Suite 1809
New York, New York 10017
Tel: (212) 355-6050
nate@mkiplaw.com
kevin@mkiplaw.com

-and-

Andrew Delahunt, Esq. (SBN 285512)
Law Office of Andrew Delahunt
1801 Century Park East, 24th Floor
Los Angeles, CA 90067
Tel: (310) 984-6762
Fax: (310) 775-4466
andrew@andrewdelahunt.com

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28