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Court in the Eastern District of NY weighs in on battle between paparazzi and celebrities over Instagram posts—sort of.

By Kristin Jamberdino and Aaron Brian

A recent decision in the United States District Court for the Eastern District of New York made clear that the Supreme Court's recent ruling in *Fourth Estate Public Benefit Corp. v. Wall-Street.com*, 139 S. Ct. 881 (2019), requiring a formal copyright registration to have been granted prior to filing a lawsuit, applies even to cases filed prior to the March 2019 decision. In *Xclusive-Lee, Inc. v. Hadid*, Case No. 19-cv-00520-PKC-CLP, 2019 WL 3281013 (E.D.N.Y. Jul. 18, 2019), Judge Pamela K. Chen dismissed a complaint brought by paparazzi photography company Xclusive-Lee, Inc. against Gigi Hadid, on the grounds that Xclusive-Lee did not yet have a copyright registration over the photograph at issue. The complaint alleged that Hadid posted to Instagram a cropped version of a photo taken of her that was owned by Xclusive-Lee, sharing its photo with Hadid's 43.7 million followers. In doing so, Xclusive-Lee argued that Hadid engaged in copyright infringement and contributory copyright infringement.

While Xclusive-Lee had applied for a copyright registration prior to filing the complaint, the court found having an application on file at the time of suit was insufficient under the *Fourth Estate* requirement that, pursuant to the Copyright Act registration provision, 17 U.S.C. Section 411(a), until the Copyright Office grants copyright registration, a plaintiff cannot file a viable infringement claim. Although Xclusive-Lee filed its complaint approximately two months before the ruling in *Fourth Estate* was issued, the court found that it was required to apply *Fourth Estate* as a binding decision precluding Xclusive-Lee's claims.

The court denied Xclusive-Lee the right to amend its complaint if and when registration was granted. Quoting another recent decision, *Malibu Media, LLC v. Doe*, No. 18-cv-10956(JMF), 2019 WL 1454317, at *2-3 (S.D.N.Y. Apr. 2, 2019), the court found that permitting an amended complaint to relate back to the original complaint for statute of limitations purposes, or even permitting an amended complaint to be considered a new action, would defeat the registration prerequisite in Section 411(a) of the Copyright Act, as well as Congress' intent in creating that requirement. Interestingly, however, the court left open the possibility that Xclusive-Lee could file an entirely new action if and when copyright registration over the photo is granted.

While Hadid's attorneys argued a number of other grounds for dismissal, including that Xclusive-Lee had not established its ownership in the copyright of the photograph, that Hadid's use of the photograph was fair use, and that Hadid had an implied license to use the photograph, the court did not consider those arguments in-depth, although it cautioned Xclusive-Lee to make clearer its allegations concerning how it became an owner of the copyright over the photo. As of yet, no court has issued a ruling discussing the conflict between a celebrity's right to privacy, and a photographer's copyright image.

There are a few key lessons to draw from this decision:

For copyright holders:

- Get your copyright registration **before** you file suit for infringement. If you don't, the court will likely follow Judge Chen's lead and swiftly dismiss the complaint.
- File for copyright registration ASAP. If you wait until you want to sue someone for infringement, this will delay your lawsuit, increase your copyright filing cost if you seek expedited ruling, and most likely prevent you from recovering attorney fees and statutory damages. And depending on when the infringement(s) occurred, having to wait to file your lawsuit could limit the damages you recover. Copyright law only allows recovery of damage for infringements occurring less than three years before the complaint is filed. As you wait for the copyright registration, time may expire on the "older" infringements.

For defendants:

- Check and double check that the subject work is protected by a copyright registration and if it's not, file a motion to dismiss.

For celebrities and other targets of paparazzi:

- Be careful what you post to Instagram and other social media. There is still no clear guidance on what rights you have, if any, to use an image of you that was taken by the paparazzi. There may be common-sense, moral, and legal reasons why you should have rights to use these kinds of photographs, but that issue remains unsettled.

For more information on this subject, please contact your Nixon Peabody attorney or:

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