UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

ANGELA BURGIN,

Plaintiff,

-v-

NATIONAL FOOTBALL LEAGUE, et al.,

Defendant.

13 Civ. 8166 (KBF)

MEMORANDUM DECISION & ORDER

KATHERINE B. FORREST, District Judge:

On November 15, 2013, plaintiff Angela Burgin ("plaintiff" or "Burgin") sued defendants the National Football League, NFL Ventures, L.P., NFL Enterprises LLC, and NFL Productions (collectively, "the NFL") for violations of copyright law, New York's statutory right of privacy, and the Lanham Act, 15 U.S.C. § 1125(a). (ECF No. 1.) On March 10, 2014, the Court dismissed plaintiff's claims on the grounds that the first amended Complaint contained no specific allegations supportive of commercial use of plaintiff's name or likeness and because the copyright violation was de minimus.

On March 20, 2014, plaintiff submitted a motion to amend pursuant to Rule 15 of the Federal Rules of Civil Procedure. (ECF No. 36.) That motion became fully briefed on April 9, 2014.

The proposed second amended Complaint contains new allegations concerning plaintiff's career as an online marketing expert and provides additional information about the website at issue, the NFL Women's Resource Initiative, a

micro-site located at https://www.nflplayerengagement.com/wri ("the WRI site"). The proposed second amended Complaint also contains additional allegations regarding the ways in which the WRI site engages with the commercial marketplace and provides new contentions regarding the nature of the alleged copyright violation.

For the reasons set forth below, the Court hereby DENIES plaintiff's motion to amend.

I. BACKGROUND

The proposed second amended Complaint alleges that in the summer of 2013, the NFL briefly posted plaintiff's name, photograph, and biography on the WRI site. The NFL had plaintiff's photograph and biography because she submitted these materials to the NFL in connection with the possibility that plaintiff would be hired to produce content for the WRI site.

Although in plaintiff's first amended Complaint she alleged her name, photograph, and biography were on the WRI site for approximately one week, the second amended Complaint alleges this information was included on the WRI site for almost three weeks – from July 19 to approximately August 8, 2013. (See Proposed Second Amended Compl. ¶ 23.)

Plaintiff asserts that some combination of her name, photograph, and/or biography were used without authorization on three different pages of the WRI site: (1) on the landing page, in a rotating thumbnail with other supposed site contributors; (2) on a page with information about all of the WRI site's contributors;

and (3) on a page devoted to information about plaintiff in her capacity as a contributor. (Id. ¶ 26.)

As mentioned, the proposed second amended Complaint alleges copyright infringement, violation of her statutory right to privacy, and violation of the Lanham Act.

II. PROCEDURAL HISTORY

Plaintiff filed this action on November 15, 2013. (ECF No. 1.) On January 2, 2014, plaintiff filed an amended Complaint (ECF No. 6), and on January 21, 2014, the NFL filed a motion to dismiss. (ECF No. 17.) On March 10, 2014, the Court granted the NFL's motion to dismiss but provided plaintiff with leave to submit a Rule 15 motion to amend if desired. (ECF No. 34.) The Court determined that the amended Complaint did not include specific allegations supportive of any type of commercial use of plaintiff's name or likeness. (3/10 Order at 4.) The Court additionally determined that the alleged use of plaintiff's work was de minimus as a matter of law. (Id. at 5.) The Court explained: "Burgin's photograph was a small image which appeared as one piece among a host of other content, for a brief period of six days. The Website was noncommercial. These facts do not support opening the door of discovery to a claim as to which the law provides no recovery." (Id. at 5-6.)

III. DISCUSSION

Rule 15(a) of the Federal Rules of Civil Procedure requires that leave to amend be freely granted "when justice so requires." Fed. R. Civ. P. 15(a)(2).

"However, it is well established that leave to amend a Complaint need not be granted when amendment would be futile." Ellis v. Chao, 336 F.3d 114, 127 (2d Cir. 2003). Futility turns on whether an amended pleading could withstand a motion to dismiss pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure. Ricciuti v. New York City Transit Auth., 941 F.2d 119, 123 (2d Cir.1991).

a. Copyright Infringement

In dismissing the first amended Complaint, the Court determined that plaintiff had failed to allege anything more than a de minimus copyright violation. In an attempt to overcome this problem, the proposed second amended Complaint alleges that the NFL displayed plaintiff's name, photograph, and biography on the WRI site in a way that was "accessible to users worldwide, 24 hours a day, seven days a week, continuously from at least July 19 through approximately August 8, almost three weeks." (Proposed Second Amended Compl. ¶ 25 (emphasis in original); Pl.'s Mem. at 12, Mar. 20, 2014, ECF No. 37.)

"To establish that [ ] infringement of a copyright is de minimus, and therefore not actionable, the alleged infringer must demonstrate that the copying of the protected activity is so trivial as to fall below the quantitative threshold of substantial similarity, which is always a required element of actionable copying." Sandoval v. New Line Cinema Corp., 147 F.3d 215, 217 (2d Cir. 1988) (internal quotation marks and citation omitted). To make such a determination, the Court considers, among other things, "the length of time the copyrighted work is observable" and its prominence. Gottlieb Dev. LLC v. Paramount Pictures Corp.,

590 F. Supp. 2d 625, 632 (S.D.N.Y. 2008) (Chin, J.) (explaining that in cases involving visual works, courts consider "the length of time the copyrighted work is observable as well as factors such as focus, lighting camera angles, and prominence.").

For example, in Rinngold v. Black Entertainment T.V., Inc., the Second Circuit held that the unauthorized use of a copyrighted poster in a television episode was not de minimus because all or part of poster was shown a total of nine times in a five-minute period, for a total of 26.75 seconds of playing time, and was thematically related to the content of the show. 126 F.3d 70, 72-73 (2d Cir. 1997). In contrast, in Sandoval v. New Line Cinema Corp., the defendant's use of plaintiff's copyrighted photographs in a motion picture was held to be de minimus because the photographs appeared in the film for a total of only 35.6 seconds, were primarily background, were not in focus, and often were difficult to see. 147 F.3d at 218.

While the unauthorized use of copyrighted images in television shows and films is not perfectly analogous to the situation now before the Court, the comparison is informative. Here, the WRI site contains a great deal of substantive content and is comprised of a large number of distinct pages, many of which contain editorial content. Two of the three inclusions of plaintiff's copyrighted material are in the context of plaintiff as a contributor – plaintiff is not pictured nor mentioned in connection with substantive editiorial content. The final inclusion of plaintiff's copyrighted content is included as a rotating thumbnail image on the site's landing page. Here, plaintiff's photograph is again unaffiliated with editorial content. This,

combined with the fact that plaintiff's copyrighted content was on the site for only three weeks – a short period of time in the life of a website – illustrates that the copyright violation here is de minimus.

b. Right to Privacy and Lanham Act Claims

As explained in the Court's March 10, 2014 decision, New York's statutory right to privacy is narrowly prescribed. N.Y. Civ. Rights Law § 50 (McKinney 2012). In order to be actionable, the unauthorized use of a person's name or likeness must be in connection with a commercial use (i.e., in advertising or trade). Id.; see also Finger v. Omni Publ'ns Int'l, Ltd., 77 N.Y.2d 138, 141 (1990). Section 1125 of the Lanham Act, 15 U.S.C. § 1125(a), creates liability for "[a]ny person who, on or in connection with any goods or services, . . . uses in commerce . . . false or misleading representation of fact, which is likely to cause confusion . . . as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person." Here again, there is a requirement that the use must be in connection with a commercial use.

In an effort to avoid the shortcomings contained in her first amended Complaint, the proposed second amended Complaint makes the following allegations to illustrate that the WRI site is commercial in nature: (1) the site includes advertisements and promotions of goods sold by the NFL and its sponsors (Proposed Second Amended Compl. ¶¶ 37-38); (2) the site constitutes "content marketing," i.e., "advertisement in disguise" (id. ¶¶ 34-36); and (3) the site may be

used by the NFL to gather data for marketing purposes (id. ¶¶ 39-40). Despite the inclusion of these allegations, plaintiff's claims are insufficient.

First, plaintiff's allegation that the site includes advertisement and promotions of goods sold by the NFL and its sponsors relies on a single (informative) article that contains links to external websites where certain products can be purchased. The article itself does not constitute an advertisement for the goods mentioned, nor does it seek to convince readers to buy certain goods. See, e.g., Stephano v. News Grp. Publ'ns, Inc., 64 N.Y.2d 174, 184 (1984). Rather, it is an informative story with links that provide external reference points for readers who want to learn more. The appropriate analogy is to a newspaper article that talks about a new trend and then includes links at the bottom of the article to a examples of that trend. Accordingly, this allegation is insufficient – even at this stage of the litigation – insofar as it argues the WRI site is commercial.[1]

Plaintiff's allegation that the WRI site is commercial because it may be used by the NFL to gather data for marketing purposes is similarly unavailing. Whether the site is commercial must be determined by looking at the content of the site itself, not at its potential uses for the site's owner. See, e.g., Gordon & Breach Sci. Publishers S.A. v. American Inst. of Physics, 859 F. Supp. 1521, 1541 (S.D.N.Y. 1994) (explaining that economic motivations alone do not turn the content of an article into commercial speech) (citations omitted).

[1] Plaintiff also relies on alleged articles about the NFL's launch of a line of women's apparel, but has failed to specifically point to any such article. Moreover, there is no reason to believe – even taking plaintiff's allegations as true – that the articles to which plaintiff refers are anything but purely informative in nature.

As for plaintiff's contention that the WRI site as a whole is commercial in nature because it constitutes "content marketing," the Court finds that whether the site generally is essentially an "advertisement in disguise" is not ripe for determination at this stage. Even accepting the legitimacy of such allegation, however, plaintiff's privacy and Lanham Act claims fail because there is no connection between the NFL's use of plaintiff's name and photograph and the site's purported commercial activity beyond plaintiff's wholly conclusory allegations. First, as explained above, plaintiff's name and photograph are unaffiliated with substantive editorial content on the site. Second, while plaintiff contends that her presence drove traffic to the site, there is nothing alleged supportive of this claim. Plaintiff has not, for example, purported to be an Internet celebrity of the sort that might drive traffic to the site simply because she is included on it. Plaintiff's allegation that she is a "social media influencer, spokesperson[,] and model" is simply not enough. (Second Proposed Amended Compl. ¶ 22.)

Last, specifically regarding plaintiff's proposed Lanham Act claim, plaintiff has failed to allege any cognizable injury. While plaintiff contends that consumers may have been misled and/or confused by the NFL's inclusion of her name, photograph, and biography on the WSI site, no real injury is alleged. Indeed, it seems highly unlikely – and plaintiff has not suggested otherwise in any remotely concrete way – that the inclusion of plaintiff as a contributor to the WSI site for roughly three weeks has in any way injured her reputation as a digital media marketing professional or spokesperson.

IV. CONCLUSION

For all of the reasons set forth above, plaintiff's motion to amend is DENIED and this action is hereby DISMISSED.

The Clerk of Court is directed to close the open motion at ECF No. 36 and to terminate this action.

SO ORDERED.

Dated: New York, New York
April 30, 2014

KATHERINE B. FORREST
United States District Judge