

## LexisNexis® Expert Commentaries

**William J. Brutocao on Single Publication Rule and California**

**Civil Code § 3344: *Miller v. Collector's Universe, Inc.***

**154 Cal. App. 4th 1047, 65 Cal.**

**Rptr. 3d 351**

The court's opinion in *Miller v. Collectors Universe, Inc.*, [154 Cal. App. 4th 1047](#), 65 Cal. Rptr. 3d 351 (2007) sheds light on two important inquiries with regard to a claim for misappropriation of name, likeness, or identity under [California Civil Code § 3344](#). First, the court reasoned that the single publication rule in [Cal. Civil Code § 3425.1](#) ("SPR") can apply to a claim under [§ 3344](#), but held that the SPR did not apply to the particular claim in that case. Hence, its discussion of the SPR as potentially applicable to a [§ 3344](#) claim can be regarded as dicta. In any event, the issue whether or when the SPR applies to a [§ 3344](#) claim is squarely before the Supreme Court in the case of *Christoff v. Nestle USA Inc.*, [152 Cal. App. 4th 1439](#), 62 Cal. Rptr. 3d 122 (2007), *rev. granted* [67 Cal. Rptr. 3d 468](#), and so we can expect that the Supreme Court will clarify the law on that point. Second, the court held that the statutory damages provision in § 3344 will not be multiplied by the number of times the name or likeness is used, but will be a single recovery for a single cause of action. The court does not apply the SPR to reach this result, but rather the application of the primary right theory.

**Does the Single Publication Rule Apply?** The question whether and how the SPR applies to a [§ 3344](#) claim is important in several respects. First, although there was no statute of limitations issue in *Miller*, when the SPR applies the statute of limitations will normally accrue upon the first publication, and a plaintiff might find his or her entire claim barred. Second, the SPR should affect the remedies that might be available.

Does the SPR apply to a [§ 3344](#) claim? This is an inapt question. In *Long v. The Walt Disney Co.*, [116 Cal. App. 4th 868](#), 10 Cal. Rptr. 3d 836 (2004), the court held squarely that the SPR applies to such a claim. This is an unremarkable result. The more apt question is *when* does the SPR apply. If, for example, a photograph is incorporated into a newspaper, book, or magazine, and a plaintiff sues for a variety of torts, which could include defamation, false light, invasion of privacy, and appropriation of likeness or identity under [§ 3344](#), all such claims should be covered by the SPR. This is not because of the nature of the claim, but because of the nature of the allegedly wrongful act, which may take the form of the dissemination of the plaintiff's photograph or other imitation in a single publication to a mass audience. This is essentially what occurred in *Long*, and all the plaintiffs' claims there were barred by the statute of limitations. On the other hand, when there is no broadcasting of the com-

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munication, but a series of individual communications, at different times to different people, the SPR should generally not apply.

### The Issue Regarding the SPR Is Before the Supreme Court in the Christoff Case.

In *Christoff*, the argument made by the plaintiff is that the court should differentiate between types of claims under [§ 3344](#). The plaintiff in *Christoff* contends that certain types of commercial appropriation claims, which the plaintiff there characterizes as claims that do not resemble defamation-type claims, should not come within the SPR. The Supreme Court will presumably address that specific question, and two factors will have to be considered in deciding whether the SPR applies to [§ 3344](#): first, is the claim asserted by the plaintiff the type of claim that is covered by the SPR; and second, does the use by the defendant qualify as a mass dissemination of a single publication.

**Is It a Mass Publication?** In *Miller*, the [§ 3344](#) violation consisted of using the plaintiff's name as an authenticator of certain memorabilia. The defendant issued 14,060 "certificates of authenticity" (COA) to individual purchasers of individual items. Each COA bore plaintiff's name. But the COA's were not exact duplicates because each was given a unique serial number and each was associated with a particular item and a particular customer. This was not a single mass publication but a series of individual communications to individual customers. Therefore, the SPR did not apply.

The distinction can be subtle. If the plaintiff's photograph is incorporated into a catalog, brochure, book, or magazine, it may be necessary to decide whether there is a single publication (as for example, a specific issue of a magazine) or whether distribution of individual brochures constitutes several different publications.

**Are Minimum Statutory Damages Multiplied By the Number of Uses?** The second question faced by the *Miller* court was whether the minimum \$750 statutory award in [§ 3344](#) should be multiplied by the 14,060 COA's, or whether there would be a single \$750 minimum. The trial court had ruled on a motion in limine that Miller could recover a multiple, and the result in the case was that plaintiff recovered \$10,545,000, calculated by multiplying 14,060 by \$750. The appellate court concluded that there is a single statutory minimum, not to be multiplied by the number of COA's. The court reversed and remanded for a new trial at which the plaintiff could proceed on alternate theories of recovery, including actual damages and punitive damages, which the plaintiff had foregone due to the favorable ruling on the motion in limine below.

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On this issue, the court of appeal got it right. In the first place, the \$750 statutory award is a minimum award, but does not limit plaintiff's potential recovery of damages or profits. That is, plaintiff can recover actual damages or \$750, whichever is greater. Plaintiff can recover defendant's profits in addition to damages. Finally, the statute also provides for potential recovery of punitive damages and attorney's fees. Given all these additional possible remedies, there is no compelling reason why a plaintiff should also get a multiple of the \$750 minimum award.

**Compare Statutory Damages For Copyright Infringement.** A useful comparison is the provision for statutory damages available for copyright infringement under [17 U.S.C. § 502\(c\)](#). A copyright plaintiff can elect statutory damages instead of actual damages and profits, and the statutory damages award will be based on the number of copyrighted works infringed, not the number of copies or infringements by the defendant. Thus, if a defendant distributes a thousand copies of the same photograph, there can be but one statutory damages award (which can range from \$750 to \$30,000 if not willful, and up to \$150,000 if willful). On the other hand, if a defendant copied 1000 different photographs, all with separate copyrights, the statutory award would be a minimum of \$750 times the number of copyrighted works.

The decision in *Miller* is essentially analogous to what would happen in a copyright case. Although each COA was given a separate serial number, was issued to an individual customer, and pertained to a specific item, the 14,060 COA's essentially all copied the same original certificate. If this were a copyright case, there would have been only one statutory damages award, because this would be multiple infringements of a single work, not infringement of multiple works.

In pursuing a claim under [§ 3344](#), a plaintiff will certainly want to characterize multiple uses of plaintiff's likeness as separately cognizable violations, e.g., an analogy to infringement of multiple copyrighted works, as opposed to multiple infringements of the same copyrighted work. If for example, multiple non-identical photographs are distributed at different times, a plaintiff would want to characterize the use of each photograph as a separate violation, whereas the defendant would stress the similarities among the photographs and argue that there is only a single violation.

**Damages, Profits, Punitive Damages, and Attorney's Fees Might Also Be Available.** Following *Miller*, a plaintiff generally will not be able to recover statutory damages computed as a multiple of \$750. Instead, in order to recover large sums, a plaintiff will need to prove actual damages or profits resulting from the wrongful use. This seems to

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be a prudent and correct interpretation. For example, the plaintiff also recovered profits calculated as \$1.00 per COA issued with the plaintiff's name, for a total profits recovery of \$14,060. Obviously, if a plaintiff establishes a higher portion of profits attributable to the wrongful use, the defendant's profits could be the largest single component of any recovery. Punitive damages and attorney's fees may also be available.

Again, *Christoff* involves the delicate and complex inquiry of determining what portion of the profits, if any, are attributable to the use of the plaintiff's likeness. Arguably, the profits attributable to the wrongful use of a particular plaintiff's likeness could range from zero to 100%.

**Other Claims Should Be Joined With a Section 3344 Claim.** Whenever there is a [§ 3344](#) claim available, plaintiff should consider whether there might also be claims for copyright infringement, violation of [section 43\(a\) of the Lanham Act \[15 USCS § 1125\]](#), and other common law claims such as defamation, invasion of privacy, etc. For example, cases like *Waits v. Frito-Lay, Inc.*, [978 F.2d 1093](#) (9<sup>th</sup> Cir. 1992) and *Wendt v. Host Intern., Inc.*, [125 F.3d 806](#) (9<sup>th</sup> Cir. 1997) demonstrate that an appropriation of likeness might be cognizable under both [§ 3344](#) and [section 43\(a\)](#).

The statute of limitations will vary for different claims. There is no statute of limitations at all for a Lanham Act claim, although laches can be applied to stale Lanham Act claims. Thus, especially when faced with the prospect that the SPR might apply to the plaintiff's [§ 3344](#) claim, a [section 43\(a\)](#) claim might survive when other claims are time-barred.

**About the Author.** William J. Brutocao is a partner in the intellectual property firm Sheldon Mak Rose & Anderson in Pasadena, California, and heads the firm's litigation department. Mr. Brutocao is the chief consulting editor of *California Intellectual Property Laws* published annually by Lexis Nexis. Mr. Brutocao is also an adjunct professor of intellectual property law at the University of La Verne College of Law in Ontario, California.