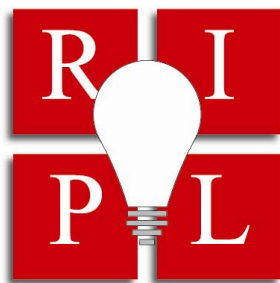


# THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



## THE PARADOX THAT WASN'T: FEDERAL PREEMPTION OF STATE-LAW VOICE MISAPPROPRIATION CLAIMS

ZACHARY M. VAUGHAN

### ABSTRACT

There exists in the law of copyright preemption what some have identified as a paradox: that in certain cases involving claims for voice misappropriation in which a plaintiff's voice has merely been *imitated*, claims have been allowed to proceed, while other cases that involve actual *uses* of a plaintiff's voice—that is, samples from sound recordings—have been held to be preempted by the federal Copyright Act. This article argues that this apparent paradox is actually no conflict at all. After a brief background section, this article collects and explains cases, discusses the strengths and weaknesses of one possible harmonization of the case law presented by one of the preeminent copyright scholars in America today, then proposes a new way to think about the cases, and explains why what seems like a conflict at first glance is actually correct, both as a matter of federal preemption law and as a normative matter.

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## INTRODUCTION

In 2003, after hearing samples of her song “Very Special”<sup>1</sup> used in a Jennifer Lopez song,<sup>2</sup> Debra Laws sued, claiming that her identity—her voice—had been misappropriated.<sup>3</sup> Even after learning that her record label had consented to the sampling,<sup>4</sup> Laws fully expected to win her lawsuit. After all, courts had almost uniformly offered protection to artists’ voices,<sup>5</sup> and one court had even held that merely *imitating* someone’s voice was actionable.<sup>6</sup> Surely, Laws thought, actually *using* someone’s voice, as the defendants had used hers, would be protected by the law. But in 2006, the Ninth Circuit denied her claim, explaining that her lawsuit was preempted by federal copyright law for the very reason that it had seemed so strong in the first place: because the defendants had used an actual recording of her voice, instead of merely imitating it, allowing her to seek the protection of state law would violate the preemption provision of the Copyright Act.<sup>7</sup>

This article attempts to square this circle, and to solve what seems like a paradox in the law of copyright preemption as applied to claims for misappropriation of voice: that cases involving actual uses of a plaintiff’s voice, like Debra Laws’s, have been held to be preempted by the Copyright Act, while cases involving mere imitation of a plaintiff’s voice have been allowed to proceed. This article argues that this apparent paradox is actually no conflict at all. Part I presents a brief introduction to the unique status of music under federal copyright law, as well as background on state-law right of publicity claims and a primer on federal preemption law. Part II collects and explains cases where courts have been faced with voice misappropriation claims under California’s right of publicity law and have decided whether or not they are preempted by the Copyright Act. Part III discusses the strengths and weaknesses of one possible harmonization of the case law presented by one of the preeminent copyright scholars in America today. Finally, Part IV proposes a new way to think about the cases, and explains why what seems like a conflict at first glance is actually correct, both as a matter of federal preemption law and as a normative matter.

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<sup>1</sup> DEBRA LAWS, *Very Special*, on VERY SPECIAL (Elektra Records 1981).

<sup>2</sup> JENNIFER LOPEZ, *All I Have*, on THIS IS ME... THEN (Epic Records 2002).

<sup>3</sup> *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134, 1136 (9th Cir. 2006).

<sup>4</sup> *Id.*

<sup>5</sup> See Mark S. Lee, *Caveat Preemptor: Laws v. Sony Music Entertainment, Inc.*, MANATT (July 27, 2006), <http://www.manatt.com/news.aspx?id=4010>.

<sup>6</sup> See *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988); see also *infra* Part II.A.

<sup>7</sup> *Laws*, 448 F.3d at 1140–41.

## I. LEGAL BACKGROUND

This Part presents an introduction to the legal issues involved in voice misappropriation claims: copyright law, right of publicity law, and federal preemption.

### A. *The Dual Nature of Copyright in Music*

Under the Copyright Act, a musical recording, unlike a novel, a painting, or a sculpture, is a combination of two separate, independently copyrightable works: the underlying musical composition, and the particular performance fixed by the sound recording itself.<sup>8</sup> The scope of protection granted by the Act to each of these works differs, however. Although section 106 of the Copyright Act (“section 106”) grants full exclusive rights to copyright owners of “musical works,”<sup>9</sup> an owner of the copyright in a sound recording receives only a subset of those rights:<sup>10</sup> the right to reproduce the sound recording in copies or phonorecords,<sup>11</sup> to prepare derivative works based on the sound recording,<sup>12</sup> to distribute copies or phonorecords to the public,<sup>13</sup> and to perform the sound recording in public “by means of a digital audio transmission.”<sup>14</sup>

As an example, consider an advertising company who wishes to use a particular song in a television or radio commercial. If the company wishes to use the original recording of the song in its commercial, it must obtain two “synchronization licenses” (licenses to synchronize music with other audio or visual content): one for the musical composition, and one for the sound recording.<sup>15</sup> If it wants to save money, however, or if the owner of the copyright in the sound recording refuses to consent to

<sup>8</sup> Compare 17 U.S.C. § 102(a)(2) (2006) (granting copyright protection to “musical works, including any accompanying words”), with *id.* § 102(a)(7) (granting copyright protection to “sound recordings”).

<sup>9</sup> See *id.* § 106(1) (granting the exclusive right “to reproduce the copyrighted work in copies or phonorecords”); *id.* § 106(2) (granting the exclusive right “to prepare derivative works based upon the copyrighted work”); *id.* § 106(3) (granting the exclusive right “to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending”); *id.* § 106(4) (granting the exclusive right “to perform the copyrighted work publicly”); *id.* § 106(5) (granting the exclusive right “to display the copyrighted work publicly”).

<sup>10</sup> See *id.* § 114(a) (“The exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), (3) and (6) of section 106, and do not include any right of performance under section 106(4).”).

<sup>11</sup> *Id.* § 106(1).

<sup>12</sup> *Id.* § 106(2). The derivative works right is limited only to those works “in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality.” *Id.* § 114(b). The Copyright Act defines a “derivative work” as “a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted.” *Id.* § 101.

<sup>13</sup> *Id.* § 106(3).

<sup>14</sup> *Id.* § 106(6).

<sup>15</sup> See John M. Rolfe, Jr. & John E. Murdock III, *On the Record: How Music Connects with Law*, BUS. L. TODAY, July/Aug. 2006, at 17, 18.

its use in the commercial, the advertiser may instead choose to record its own “cover” version of the song. In that case, the advertiser must obtain a synchronization license for the composition, but not the sound recording, even if the “cover” version exactly imitates the sound recording to the point of being indistinguishable.<sup>16</sup>

### *B. Right of Publicity*

Over forty states,<sup>17</sup> including both New York<sup>18</sup> and California,<sup>19</sup> recognize the right of publicity, either by statute, common law, or both. The right of publicity protects “the right of a person whose identity has commercial value—most often a celebrity—to control the commercial use of that identity.”<sup>20</sup> Although it was originally conceived of as a privacy tort,<sup>21</sup> the right of publicity has evolved into a property-like right that provides individuals with “quasi-ownership” of their personas.<sup>22</sup>

California, which recognizes both statutory and common law right of publicity claims,<sup>23</sup> serves as a good example. To state a claim of common law misappropriation of name and likeness, a plaintiff must allege that the defendant used his identity without his consent, that the defendant benefited “commercially or otherwise,” and that this resulted in injury to the plaintiff.<sup>24</sup> Although this common law right originally protected only name and likeness, not voice, courts have since interpreted the “identity” element to protect against voice misappropriation, including vocal imitations.<sup>25</sup>

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<sup>16</sup> See 17 U.S.C. § 114(b); see also H.R. REP. NO. 94-1476, at 106 (1976) (“Mere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another’s performance as exactly as possible.”).

<sup>17</sup> See Ashley D. Hayes, *The Right of Publicity and Protection of Personas: Preemption Not Required*, 51 SYRACUSE L. REV. 1049, 1050 (2001).

<sup>18</sup> See N.Y. CIV. RIGHTS LAW §§ 50–51 (McKinney 2010).

<sup>19</sup> See CAL. CIV. CODE §§ 3344–3344.1 (West 2010); *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 346 (Cal. Ct. App. 1983).

<sup>20</sup> *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1098 (9th Cir. 1992) (citing *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 824–25 (9th Cir. 1974)).

<sup>21</sup> See William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960) (recognizing, as part of a “complex of four” privacy torts, “[a]ppropriation, for the defendant’s advantage, of the plaintiff’s name or likeness.”).

<sup>22</sup> See Sarah Schacter, *The Barracuda Lacuna: Music, Political Campaigns, and the First Amendment*, 99 GEO. L.J. 571, 587 (2011); see also *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (“The [California] statute protecting the use of a deceased person’s name, voice, signature, photograph or likeness states that the rights it recognizes are ‘property rights.’ By analogy the common law rights are also property rights. Appropriation of such common law rights is a tort in California.”).

<sup>23</sup> See *KNB Enters. v. Matthews*, 92 Cal. Rptr. 2d 713, 717 (Cal. Ct. App. 2000).

<sup>24</sup> *Eastwood*, 198 Cal. Rptr. at 347 (“A common law cause of action for appropriation of name or likeness may be pleaded by alleging (1) the defendant’s use of the plaintiff’s identity; (2) the appropriation of plaintiff’s name or likeness to defendant’s advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury.”).

<sup>25</sup> Geronimo Perez, *A Recording Artist’s Right of Publicity in Today’s Advertising Environment: What State Laws Give, the Copyright Act Takes Away*, 11 J. INTEL. PROP. L. 29, 32 (2003). Other jurisdictions have accepted the Ninth Circuit’s expansion of the identity element. *Id.* at 33 n.29

Unlike the common law right, California's statutory right of publicity expressly protects against commercial misappropriation of a person's voice.<sup>26</sup> This protection only extends to actual uses of a person's voice, however, and not to imitations or soundalikes.<sup>27</sup> The statute also expressly exempts from its coverage use "in connection with any news, public affairs, or sports broadcast or account, or any political campaign."<sup>28</sup>

In *Zacchini v. Scripps-Howard Broadcasting Co.*,<sup>29</sup> the Supreme Court recognized the validity of state right of publicity laws. The plaintiff in the case, Hugo Zacchini, was the performer of a "human cannonball" act whose performance was recorded and broadcast by a local television news program without his consent.<sup>30</sup> Zacchini brought a state-law action for conversion, claiming that the unauthorized broadcast of his performance was an "unlawful appropriation" of his "professional property."<sup>31</sup> The Supreme Court held that the First Amendment did not prevent the Ohio courts from recognizing a right of publicity claim:

If . . . [defendant] had merely reported that [Zacchini] was performing at the fair and described or commented on his act, with or without showing his picture on television, we would have a very different case. But [Zacchini] is not contending that his appearance at the fair and his performance could not be reported by the press as newsworthy items. His complaint is that [defendant] filmed his entire act and displayed that film on television for the public to see and enjoy. This, he claimed, was an appropriation of his professional property.<sup>32</sup>

The Ohio courts were free to allow Zacchini to bring a right of publicity claim because allowing such a right of publicity claim "would not serve to prevent [defendant] from reporting the newsworthy facts" about Zacchini's act.<sup>33</sup>

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(citing *Prima v. Darden Rests., Inc.*, 78 F. Supp. 2d 337, 349 (D.N.J. 2000); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983)); see *infra* Part II.A.

<sup>26</sup> See CAL. CIV. CODE § 3344(a) (West 2010).

Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof.

*Id.*

<sup>27</sup> See *Perez*, *supra* note 25, at 33; see also *Midler*, 849 F.2d at 463 ("The defendants did not use Midler's name or anything else whose use is prohibited by the statute. The voice they used was Hedwig's, not hers.").

<sup>28</sup> CAL. CIV. CODE § 3344(d). These exemptions serve to permit enforcement of the statute consistent with the First Amendment. See *Perez*, *supra* note 25, at 33–34.

<sup>29</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

<sup>30</sup> *Id.* at 563–64.

<sup>31</sup> *Id.* at 564.

<sup>32</sup> *Id.* at 569.

<sup>33</sup> *Id.* at 574.

### *C. Federal Preemption*

Because Zacchini did not consent to the recording of his performance, there was no fixation under the Copyright Act, and so the Court never had to consider whether Ohio's right of publicity law was preempted by the Copyright Act.<sup>34</sup> But because the cases discussed in this article all involve recorded music, fixed on a tangible medium of expression,<sup>35</sup> federal copyright law comes into play. And because the United States Constitution declares itself and all other federal laws to be the "supreme Law of the Land," state law stands subordinate to, and can be preempted by, federal law.<sup>36</sup> This preemption can either be express, where a law explicitly declares that it preempts state law, as the Copyright Act does in section 301;<sup>37</sup> or implied.<sup>38</sup>

#### *1. Express Preemption*

Section 301(a) of the Copyright Act ("section 301") declares that "all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright . . . in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright . . . are governed exclusively by this title," which will preempt "any such right or equivalent right in any such work under the common law or statutes of any State."<sup>39</sup> Courts that have applied section 301 have adopted a two-part test: to invade the domain of copyright, a law must (1) create "legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright," and (2) apply to "works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright."<sup>40</sup>

Under section 301, a state law right is "equivalent" to copyright if it is violated by "an act which, in and of itself, would infringe of the exclusive rights [of copyright]."<sup>41</sup> But when a state-law right of action is "predicated upon an act incorporating elements beyond mere reproduction or the like, the rights involved are

<sup>34</sup> *Id.* at 574–75.

<sup>35</sup> *See infra* Part II.

<sup>36</sup> U.S. CONST. art. VI, cl. 2 ("This Constitution, and the Laws of the United States which shall be made in Pursuance thereof . . . shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding.").

<sup>37</sup> *See* 17 U.S.C. § 301(a) (2006) ("On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright . . . and come within the subject matter of copyright . . . are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.").

<sup>38</sup> *See* ERWIN CHERMERINSKY, CONSTITUTIONAL LAW: PRINCIPLES AND POLICIES 401–02 (3d ed. 2006).

<sup>39</sup> 17 U.S.C. § 301(a).

<sup>40</sup> *Id.*; *see* 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01[B] (2010) [hereinafter NIMMER].

<sup>41</sup> *Harper & Row Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 200 (2d Cir. 1983), *rev'd on other grounds*, 471 U.S. 539 (1985).

not equivalent and preemption will not occur.”<sup>42</sup> Courts have called this analysis the “extra element” test.<sup>43</sup>

## 2. Implied Preemption

The Supreme Court has held that the fact that a federal statute has an express preemption provision does not foreclose the possibility of implied preemption.<sup>44</sup> Implied preemption can take the form of “field preemption,” where a particular federal law “occupies the field” in which it operates, and displaces all state laws which try to do the same;<sup>45</sup> or “conflict preemption,” which occurs if a particular state law conflicts with the goals of federal law.<sup>46</sup>

In order to determine whether a given state law conflicts with the goals of federal law, a court must determine (1) what exactly those federal goals are, (2) what the goals and effects of the state law are, and (3) whether, taking everything into account, the two laws are in conflict.<sup>47</sup> Two older cases help illustrate the issue. In *Nash v. Florida Industrial Commission*,<sup>48</sup> the Supreme Court held that a state law denying unemployment benefits to workers who filed unfair labor practice complaints with the National Labor Relations Board was preempted by the National Labor Relations Act (“NLRA”).<sup>49</sup> Because a key purpose of the NLRA was the encouragement of such filings, the Florida law was held to conflict with federal goals.<sup>50</sup> Similarly, in *Perez v. Campbell*, the Court considered an Arizona law that

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<sup>42</sup> *Id.*; see also *Trandes Corp. v. Guy F. Atkinson Co.*, 996 F.2d 655, 659 (4th Cir. 1993) (“To avoid preemption, a cause of action defined by state law must incorporate elements beyond those necessary to prove copyright infringement, and must regulate conduct qualitatively different from the conduct governed by federal copyright law.”).

<sup>43</sup> See, e.g., *Trandes*, 996 F.2d at 659.

<sup>44</sup> See *Geier v. Am. Honda Motor Co.*, 529 U.S. 861, 869 (2000).

<sup>45</sup> See *Rice v. Santa Fe Elevator Corp.*, 331 U.S. 218, 230 (1947).

[W]e start with the assumption that the historic police powers of the States were not to be superseded by the Federal Act unless that was the clear and manifest purpose of Congress. Such a purpose may be evidenced in several ways. The scheme of federal regulation may be so pervasive as to make reasonable the inference that Congress left no room for the States to supplement it. Or the Act of Congress may touch a field in which the federal interest is so dominant that the federal system will be assumed to preclude enforcement of state laws on the same subject. Likewise, the object sought to be obtained by the federal law and the character of obligations imposed by it may reveal the same purpose.

*Id.* (citation omitted). This so-called “field preemption” is rarely applicable in the copyright realm, given the wide latitude states are generally given to regulate many aspects relating to copyrightable works. See NIMMER, *supra* note 40, § 1.01[B].

<sup>46</sup> See *Capital Cities Cable, Inc. v. Crisp*, 467 U.S. 691, 699 (1984) (explaining that preemption may occur “when [a] state law stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress”).

<sup>47</sup> See CHEMERINSKY, *supra* note 38, at 414.

<sup>48</sup> *Nash v. Florida Indus. Comm’n.*, 389 U.S. 235 (1967).

<sup>49</sup> *Id.* at 238.

<sup>50</sup> *Id.* at 239 (“The action of Florida here, like the coercive actions which employers and unions are forbidden to engage in, has a direct tendency to frustrate the purpose of Congress to leave people free to make charges of unfair labor practices to the Board.”).



suspended the licenses of drivers who failed to pay judgments arising from automobile accidents, even if their debts had been discharged in bankruptcy.<sup>51</sup> The Court determined that this provision conflicted with “one of the primary purposes” of federal bankruptcy law, which was to give debtors “a new opportunity in life and a clear field for future effort, unhampered by the pressure and discouragement of pre-existing debt.”<sup>52</sup> Allowing states to punish drivers for failing to pay debts that had been discharged in bankruptcy would undermine this purpose, so the Court held the law preempted.<sup>53</sup>

## II. EXPLAINING THE CASE LAW

This Part examines four cases, all decided under California law, in which courts grappled with the question of federal preemption of voice misappropriation claims. These cases fall into two categories: state-law actions involving “soundalike” recordings, which have survived preemption analysis, and state-law actions involving actual uses of an artist’s recorded voice, which have been preempted under the Copyright Act.

### A. *Soundalike Cases: Midler and Waits*

In 1985, the advertising agency Young & Rubicam, Inc. created a series of television commercials for the Ford Motor Company that it called “The Yuppie Campaign.”<sup>54</sup> The aim of the advertising campaign was to make an emotional connection with yuppies, or “Young Urban Professionals,”<sup>55</sup> and to accomplish this goal, each of the nineteen commercials in the campaign included a different popular song from the 1970s—the yuppies’ carefree college days.<sup>56</sup> One of these songs was Bette Midler’s version of “Do You Want to Dance,”<sup>57</sup> a Bobby Freeman song from the 1950s<sup>58</sup> that had previously been popularized by the Beach Boys.

Although Young & Rubicam attempted to get Midler’s permission to use her recording, she refused,<sup>59</sup> and so the agency turned instead to Ula Hedwig, a semi-

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<sup>51</sup> *Perez v. Campbell*, 402 U.S. 637, 641–44 (1971).

<sup>52</sup> *Id.* at 648.

<sup>53</sup> *Id.* at 652.

<sup>54</sup> *Midler v. Ford Motor Co.*, 849 F.2d 460, 461 (9th Cir. 1988).

<sup>55</sup> See *Living: Here Come the Yuppies!*, TIME (Jan. 09, 1984) <http://www.time.com/time/magazine/article/0,9171,952325,00.html> (“Who are all those upwardly mobile folk with designer water, running shoes, pickled parquet floors and \$450,000 condos in semi-slum buildings? Yuppies, of course, for Young Urban Professionals.”); cf. MARISSA PIESMAN & MARILEE HARTLEY, *THE YUPPIE HANDBOOK: THE STATE-OF-THE-ART MANUAL FOR YOUNG URBAN PROFESSIONALS* (1984).

<sup>56</sup> *Midler*, 849 F.2d at 461.

<sup>57</sup> BETTE MIDLER, *Do You Want to Dance?*, on THE DIVINE MISS M (Atlantic Records 1972).

<sup>58</sup> BOBBY FREEMAN, *Do You Want to Dance?*, on DO YOU WANNA DANCE (Jubilee Records 1958).

<sup>59</sup> *Midler*, 849 F.2d at 461. The conversation, as recounted by Judge Noonan in the Ninth Circuit’s opinion, was an abbreviated one: “Hello, I am Craig Hazen from Young and Rubicam. I

professional singer who had served as a backup singer to Midler for ten years.<sup>60</sup> Hedwig was told to “sound as much as possible like the Bette Midler record,” and by all accounts, she was successful—after the commercial aired, Midler was informed that it “sounded exactly” like her recording, and Hedwig was told by her friends that they thought it was Midler singing in the commercial.<sup>61</sup>

Midler sued, claiming that Ford and Young & Rubicam violated her right of publicity under California law by imitating her voice so successfully.<sup>62</sup> The district court, which described the defendants’ conduct as that of the “average thief,” nevertheless granted summary judgment to defendants.<sup>63</sup> A panel of the Ninth Circuit reversed, holding instead that California’s common-law right of publicity is violated “when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product.”<sup>64</sup> Rebuffing defendant’s claim that Midler’s action was preempted by federal copyright law, the court reasoned that “[c]opyright protects ‘original works of authorship fixed in any tangible medium of expression.’ A voice is not copyrightable. The sounds are not ‘fixed.’ What is put forward as protectable here is more personal than any work of authorship.”<sup>65</sup>

Four years later, the Ninth Circuit reached a similar result in *Waits v. Frito-Lay, Inc.*,<sup>66</sup> a lawsuit over a radio commercial for “SalsaRio Doritos” inspired by the 1976 Tom Waits song “Step Right Up.”<sup>67</sup> As in *Midler*, the talent search for the Doritos commercial at issue in *Waits* focused primarily on finding a singer who could accurately imitate Tom Waits’ “raspy, gravelly singing voice.”<sup>68</sup> In fact, the singer who got the job, Stephen Carter, was initially warned that “he probably wouldn’t get the job because he sounded too much like Waits, which could pose legal problems.”<sup>69</sup>

This warning proved to be accurate: after hearing the commercial during an appearance on a Los Angeles radio program, Waits was “shocked,” and immediately filed suit against Frito-Lay and its advertising agency, alleging California state-law voice misappropriation, along with federal unfair competition claims under the

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am calling you to find out if Bette Midler would be interested in doing . . . ?’ Edelman: ‘Is it a commercial?’ ‘Yes.’ ‘We are not interested.’” *Id.*

<sup>60</sup> *Id.*

<sup>61</sup> *Id.* at 461–62; see Ford Motor Co., *1986 Mercury Sable TV Commercial*, YOUTUBE (Apr. 21, 2012), <http://www.youtube.com/watch?v=BjIstCzsppA>.

<sup>62</sup> *Midler*, 849 F.2d at 462. Because Young & Rubicam had obtained a license from the copyright holder of the song, and had not actually used any part of Midler’s recording in its commercial, there was no copyright issue in the case. See *id.* (“Midler does not seek damages for Ford’s use of ‘Do You Want To Dance,’ and thus her claim is not preempted by federal common law. . . . A voice is not copyrightable. The sounds are not ‘fixed.’”).

<sup>63</sup> *Id.*

<sup>64</sup> *Id.* at 463.

<sup>65</sup> *Id.* at 462 (citing 17 U.S.C. § 102(a) (2006)).

<sup>66</sup> *Waits v. Frito-Lay*, 978 F.2d 1093 (9th Cir. 1992).

<sup>67</sup> TOM WAITS, *Step Right Up*, on SMALL CHANGE (Asylum Records 1976); see also *Waits*, 978 F.2d at 1097, 1097 & n.1 (noting the irony of basing a Doritos commercial on this song, “a jazzy parody of commercial hucksterism, and consists of a succession of humorous advertising pitches” that the artist had characterized as an “indictment of advertising.”).

<sup>68</sup> *Waits*, 978 F.2d at 1097–98.

<sup>69</sup> *Id.* Frito-Lay’s advertising agency had not attempted to obtain permission from Waits, who had a consistent, publically-expressed policy of never doing commercials. *Id.* at 1097.

Lanham Act.<sup>70</sup> A jury, after finding that Waits had a “distinctive” voice (as required under *Midler*), and that the defendants’ commercial had violated Waits’ right of publicity by featuring a “deliberate imitation” of his voice, awarded Waits \$375,000 in compensatory damages and \$2 million in punitive damages on the state-law claim, along with \$100,000 in damages for violation of the Lanham Act.<sup>71</sup>

The defendants appealed, mounting both collateral and direct attacks on the continuing validity of *Midler*.<sup>72</sup> The defendants first claimed that *Midler* had been “impliedly overruled” by the Supreme Court’s decision in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,<sup>73</sup> which had held that a Florida statute giving perpetual patent-like protection to boat hull designs already on the market was preempted by federal patent law, and which the defendants “seize[d] upon” as standing for “sweeping preemption principles.”<sup>74</sup> The court rejected this argument, pointing out that *Bonito Boats* had itself cautioned against reading the Court’s patent preemption cases as establishing a “broad pre-emptive principle,”<sup>75</sup> and that the Court had explicitly recognized states’ authority to protect entertainers’ right of publicity in *Zacchini*.<sup>76</sup>

Undaunted, the defendants asked the court to reconsider *Midler* anyway, arguing, as the defendants did in *Midler* itself,<sup>77</sup> that voice misappropriation was preempted by section 301 of the Copyright Act.<sup>78</sup> The court declined this invitation,<sup>79</sup>

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<sup>70</sup> *Id.* at 1098; see 15 U.S.C. § 1125(a)(1).

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

*Id.*

<sup>71</sup> *Waits*, 978 F.2d at 1098.

<sup>72</sup> *Id.* at 1099–1100.

<sup>73</sup> *Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141 (1989).

<sup>74</sup> *Waits*, 978 F.2d at 1099.

<sup>75</sup> *Id.*; see *Bonito Boats*, 489 U.S. at 165.

Our decisions since *Sears* and *Compco* have made it clear that the Patent and Copyright Clauses do not, by their own force or by negative implication, deprive the States of the power to adopt rules for the promotion of intellectual creation within their own jurisdictions. Thus, where ‘Congress determines that neither federal protection nor freedom from restraint is required by the national interest,’ the States remain free to promote originality and creativity in their own domains.

*Id.* (citation omitted).

<sup>76</sup> *Waits*, 978 F.2d at 1099–1100; see *supra* notes 30–33 and accompanying text.

<sup>77</sup> *Waits*, 978 F.2d at 1100; see *supra* note 62 and accompanying text.

<sup>78</sup> *Waits*, 978 F.2d at 1100. According to the text of the court’s opinion, the defendants based their preemption argument on section 114 of the Act, not section 301. See *id.* (“The defendants ask that we rethink *Midler* anyway, arguing as the defendants did there that voice misappropriation is

for two reasons. First, it pointed out that Waits’s claim, like Bette Midler’s, was for “infringement of voice, not for infringement of a copyrightable subject such as a sound recording or musical composition.”<sup>80</sup> Second, the court quoted from the legislative history of section 301,<sup>81</sup> which expressed the intent of Congress that “[t]he evolving common law rights of ‘privacy,’ ‘publicity,’ and trade secrets . . . remain unaffected [by the preemption provision] as long as the causes of action contain elements, such as invasion of personal rights . . . that are different in kind from copyright infringement.”<sup>82</sup> Because Waits’s voice misappropriation claim was based on a “personal property right”—his right to “control the use of his identity as embodied in his voice”<sup>83</sup>—and because the trial’s focus had been on the *Midler* elements,<sup>84</sup> which are “different in kind”<sup>85</sup> from those in a copyright infringement case, the court held that Waits’s action was not explicitly preempted by the Copyright Act.<sup>86</sup> In the end, the court affirmed the jury’s verdict and damages on Waits’s right of publicity claim.<sup>87</sup>

### B. Actual Uses of Recordings: Fleet and Laws

In 1996, the California Court of Appeal decided *Fleet v. CBS*,<sup>88</sup> in which the court refused to allow a group of actors who had appeared in a copyrighted film to bring a right of publicity claim to prevent the release of that film by its exclusive rights holder, CBS.<sup>89</sup> After completing work on the 1987 film “White Dragon,” plaintiffs were involved in a fee dispute with a financing company that had stepped in to ensure the film’s completion.<sup>90</sup> When their efforts at obtaining their promised

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preempted by section 114 of the Copyright Act.”). But section 114 makes no mention of preemption; and in the following sentence, the court quotes “this provision,” but appends a correct citation to section 301(b)(1). *See id.* Moreover, as Nimmer notes, the “legislative history of section 114” that the court quotes in the following paragraph actually comes from section 301. *See id.*; NIMMER, *supra* note 40, § 1.01[B][3][b][i].

<sup>79</sup> Not that it could have done otherwise, of course. *See Waits*, 978 F.2d at 1100 (“As a three-judge panel, we are not at liberty to reconsider this conclusion, and even if we were, we would decline to disturb it.”).

<sup>80</sup> *Id.*

<sup>81</sup> Again, although the court claimed to be quoting from the legislative history of section 114, the quoted material actually came from the legislative history of section 301. *See supra* note 78.

<sup>82</sup> *Waits*, 978 F.2d at 1100.

<sup>83</sup> *Id.*

<sup>84</sup> *Id.* (outlining the question as “whether the defendants had deliberately imitated Waits’s voice rather than simply his style and whether Waits’ voice was sufficiently distinctive.”).

<sup>85</sup> *Id.*

<sup>86</sup> *Id.* As Nimmer points out, however, by confusing the legislative histories of sections 114 and 301, the court failed altogether to address any possible non-section 301 preemption of Waits’ voice preemption claim. *See* NIMMER, *supra* note 40, § 1.01[B][3][b][i] (“*Waits* therefore misses the target entirely—far from resolving non-section 301 preemption, it sets the analysis backwards by conflating the legislative history from two wholly separate statutory sections.”).

<sup>87</sup> *Waits*, 978 F.2d at 1111. The court vacated Waits’s award of damages on the Lanham Act, however, finding it duplicative of damages awarded for voice misappropriation. *Id.*

<sup>88</sup> *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645 (Cal. Ct. App. 1996).

<sup>89</sup> *Id.* at 646–47, 653.

<sup>90</sup> *Id.* at 647.

salaries proved unsuccessful, the plaintiffs wrote to CBS, informing them “that since they had not been compensated for their appearances in the film, CBS did not have permission to utilize their names, pictures, or likenesses in conjunction with any exploitation of the film.”<sup>91</sup> CBS ignored their letter and released the film anyway; plaintiffs sued, alleging, among other things, that CBS had violated California’s right of publicity statute by exploiting their performances without permission.<sup>92</sup>

The trial court granted summary to defendants on section 301 preemption grounds, and the California Court of Appeal affirmed.<sup>93</sup> Unlike Bette Midler and Tom Waits, who sued to protect their (non-copyrightable) voices, the plaintiffs in *Fleet* sought to protect their (copyrightable) dramatic performances, as fixed in the film itself.<sup>94</sup> Because their right of publicity claim sought “only to prevent CBS from reproducing and distributing their performances in the film,” the court held it to be preempted by section 301.<sup>95</sup> “There can be no question,” the court held on the first prong of section 301, “that, once appellants’ performances were put on film, they became ‘dramatic work[s]’ ‘fixed in [a] tangible medium of expression’ . . . [and therefore] came within the scope or subject matter of copyright law protection.”<sup>96</sup> On the second prong, the court rejected plaintiffs’ argument, citing a series of California cases (including *Midler*) for the proposition that “where the plaintiff neither owns, nor claims to own, the copyright, there is no preemption . . . even though the medium in which the offending misappropriation has occurred is itself copyrightable or even copyrighted.”<sup>97</sup> This argument failed, the court held, because plaintiffs had misread the cases:

In each of the cited cases, the right sought to be protected was not copyrightable—Clint Eastwood’s likeness captured in a photograph; Kareem Abdul-Jabbar’s former name; Bette Midler’s distinctive vocal style; Vanna White’s distinctive visual image, etc. The plaintiffs in those cases asserted no copyright claims *because they had none to assert*. Here, by contrast, appellants seek to prevent CBS from using performances captured on film. These performances were copyrightable and appellants could have claimed a copyright in them.<sup>98</sup>

Because defendants had prevailed on both prongs of section 301, the court affirmed the trial court’s grant of summary judgment in the defendants’ favor, and held that “[a] claim asserted to prevent nothing more than the reproduction, performance, distribution, or display of a dramatic performance captured on film is subsumed by copyright law and preempted.”<sup>99</sup>

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<sup>91</sup> *Id.*

<sup>92</sup> *Id.*

<sup>93</sup> *Id.* at 648, 653.

<sup>94</sup> *Id.* at 650.

<sup>95</sup> *Id.*

<sup>96</sup> *Id.* (quoting 17 U.S.C. § 102(a) (2006)).

<sup>97</sup> *Id.* at 651 (internal quotation omitted).

<sup>98</sup> *Id.*

<sup>99</sup> *Id.* at 653.

Ten years later, the Ninth Circuit reached the same conclusion on the preemption issue in *Laws v. Sony Music*,<sup>100</sup> in which the court rejected a claim by R&B singer Debra Laws for voice misappropriation based on the licensed sampling of her song “Very Special”<sup>101</sup> in the song “All I Have”<sup>102</sup> by Jennifer Lopez and L.L. Cool J.<sup>103</sup> In 1979, Laws entered into a recording agreement with Elektra Records in which she granted Elektra exclusive rights to her master recording of “Very Special,” along with the right to use her name and likeness in connection with the recording, but in which Elektra agreed not to use the recording in any audiovisual work without Laws’s consent.<sup>104</sup> In 2002, without permission from Laws, Elektra granted Sony a non-exclusive license to use a sample of “Very Special” in “All I Have,” which was released on CD and in music video form that year.<sup>105</sup>

In February 2003, Laws brought an action in California state court, alleging violations of both her common law and statutory rights of publicity under California law.<sup>106</sup> Sony removed the case to federal court and brought a motion for summary judgment, which the district court granted, holding that both of Laws’s misappropriation claims were preempted by section 301.<sup>107</sup> The Ninth Circuit affirmed.<sup>108</sup> In his opinion for the three-judge panel, Judge Bybee distinguished the case from *Midler* and *Waits* by explaining that, in contrast to those two prior cases,

[W]here the licensing party obtained only a license to the song and then imitated the artist’s voice, here Sony obtained a license to use Laws’s recording itself. Sony was not imitating “Very Special” as Laws might have sung it. Rather, it used a portion of “Very Special” as sung by Debra Laws . . . . Although California law recognizes an assertable interest in the publicity associated with one’s voice, we think it is clear that federal copyright law preempts a claim alleging misappropriation of one’s voice when the entirety of the allegedly misappropriated vocal performance is contained within a copyrighted medium.<sup>109</sup>

This conclusion was consistent with *Midler* and *Waits*, Judge Bybee reasoned, because neither of the imitations in those two cases “was contained within a copyrighted vocal performance.”<sup>110</sup> “Moreover,” the court continued, “the fact that the vocal performance was copyrighted demonstrates that what is put forth here as protectable is *not* ‘more personal than any work of authorship.’”<sup>111</sup>

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<sup>100</sup> *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134 (9th Cir. 2006).

<sup>101</sup> DEBRA LAWS, *Very Special*, on VERY SPECIAL (Elektra Records 1981).

<sup>102</sup> JENNIFER LOPEZ, *All I Have*, on THIS IS ME... THEN (Epic Records 2002).

<sup>103</sup> *Laws*, 448 F.3d at 1135.

<sup>104</sup> *Id.* at 1136.

<sup>105</sup> *Id.*

<sup>106</sup> *Id.*

<sup>107</sup> *Id.*

<sup>108</sup> *Id.* at 1146.

<sup>109</sup> *Id.* at 1140–41.

<sup>110</sup> *Id.* at 1141.

<sup>111</sup> *Id.* (quoting *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988)).

## III. NIMMER'S PROPOSED SOLUTION

In Chapter 1 of his preeminent treatise on copyright law, “Nimmer on Copyright,” David Nimmer gives extended treatment to preemption of right of publicity claims.<sup>112</sup> Although he touches on the express (section 301) preemption issue, Nimmer directs most of his effort to explaining the cases from the perspective of implied (conflict) preemption. In doing so, he sets forth a theory that purports to unify the cases and explain the seeming conflict between soundalike cases and actual-use cases—that artists can receive state-law protection against soundalikes, which only imitate their voices, but not against actual uses of their voices.<sup>113</sup> Unfortunately, while Nimmer’s theory (mostly) succeeds at giving a plausible explanation for why the cases came out the way they did, it does so in a way that gives short shrift to the preemption issue, and ultimately confuses more than it clarifies.

Nimmer begins his analysis of the right of publicity preemption issue with a short discussion of section 301 preemption, where he agrees with *Midler* and *Waits* that “[t]he ‘work’ that is the subject of the right of publicity is the *persona*, *i.e.*, the name and likeness of a celebrity or other individual.”<sup>114</sup> A “persona” does not fall within the subject matter of copyright,<sup>115</sup> he argues, and cannot become a “work of authorship” under the Act “simply because [it is] embodied in a copyrightable work such as a photograph.”<sup>116</sup> To Nimmer, however, all this proves is that “there is no *categorical* preemption of the general right of publicity.”<sup>117</sup> Later in the chapter, he revisits the preemption issue, this time focusing on implied preemption, and there he finds the situation to be much more complicated.<sup>118</sup>

Nimmer’s implied preemption analysis starts once more with *Midler*.<sup>119</sup> This time, however, he finds fault with the decision, arguing that it “fails to address the key question at issue: Can a state law forbid that which Congress intended to validate?”<sup>120</sup> This congressional validation, he claims, is found in section 114(b) of the Copyright Act, which limits the exclusive right of reproduction of sound recordings “to the right to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording,”<sup>121</sup> and thus excludes “soundalike” recordings from the reach of federal copyright.<sup>122</sup>

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<sup>112</sup> See NIMMER, *supra* note 40, § 1.01[B].

<sup>113</sup> See *id.* § 1.01[B][3][b][iv][I].

<sup>114</sup> *Id.* § 1.01[B][1][c].

<sup>115</sup> See *id.*

<sup>116</sup> *Id.* (citation omitted).

<sup>117</sup> *Id.* (emphasis added).

<sup>118</sup> See *id.* § 1.01[B][3][b].

<sup>119</sup> *Id.* § 1.01[B][3][b][i].

<sup>120</sup> *Id.*

<sup>121</sup> 17 U.S.C. § 114(b) (2006).

<sup>122</sup> See *id.*; NIMMER, *supra* note 40, § 1.01[B][3][b][i]; see also H.R. REP. NO. 94-1476, at 106 (1976) (“Mere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another’s performance as exactly as possible.”).

Of course, as Nimmer notes, this reading of section 114(b) could have two possible implications:

If Congress intended solely to leave soundalike recordings untouched by federal law, then state law may be allowed to step in and fill the breach. Such a state law could prohibit the reproduction, performance, and distribution of all soundalike recordings. By contrast, if Congress intended further to legislate a policy affirmatively fostering such soundalike recordings, then a contrary state law must be deemed pre-empted. The first finding validates *Midler*, the second undermines it.<sup>123</sup>

But instead of answering this question, Nimmer proposes a third resolution of *Midler*: “[I]f Congress intended to bar the states from the realm of regulating soundalike recordings, except insofar as such recordings are used to sell an unrelated product, then the court’s rationale survives a pre-emption challenge.”<sup>124</sup> He acknowledges, however, that it is “difficult to maintain” such a distinction without specific evidence that Congress intended it.<sup>125</sup>

Nimmer then turns to *Fleet*, which “introduce[d] a sensibility wholly at odds” with *Midler* and *Waits*,<sup>126</sup> and then to *Laws*, which, he argues, reached the right result, but on faulty reasoning.<sup>127</sup> Here, Nimmer outlines the key aspect of *Laws* that many have claimed represents a paradox:

Under the reasoning adopted by this opinion, “the fact that the vocal performance was copyrighted demonstrates that what is put forth here as protectable is *not* ‘more personal than any work of authorship.’” That logic implies that, although *Laws* had no state law remedy for use of her *actual* voice, she would have been able to pursue suit had Sony *not* used her voice—for example, by hiring a singer who sounded *exactly like* Debra *Laws* to accompany Jennifer Lopez, such that the public would find the two indistinguishable. In other words, this opinion activated the law of publicity only when the appropriation is towards the minimal side of the spectrum, not when it is maximal. That consideration alone renders the court’s distinction suspect.<sup>128</sup>

Finally, Nimmer takes up the challenge of reconciling the holdings of cases like *Midler*, *Waits*, *Fleet*, and *Laws*.<sup>129</sup> To do so, he seizes upon language from *Seale v. Gramercy Pictures*,<sup>130</sup> a Pennsylvania right of publicity case in which the court

<sup>123</sup> NIMMER, *supra* note 40, § 1.01[B][3][b][i].

<sup>124</sup> *Id.*

<sup>125</sup> *Id.* Nimmer also concedes that a court has already considered and rejected this distinction. *Id.* at n.606 (citing *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1240 (C.D. Cal. 1987)).

<sup>126</sup> NIMMER, *supra* note 40, § 1.01[B][3][b][ii].

<sup>127</sup> *Id.* § 1.01[B][3][b][iii].

<sup>128</sup> *Id.* (quoting *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134, 1141 (9th Cir. 2006)).

<sup>129</sup> *See id.* See § 1.01[B][3][b][iv].

<sup>130</sup> *Seale v. Gramercy Pictures*, 949 F. Supp. 331 (E.D. Pa. 1996).



construed Pennsylvania's right of publicity law with reference to the Restatement (Third) of Unfair Competition ("Restatement"), which limits liability for misappropriation to those uses of a person's identity that are "for the purposes of trade."<sup>131</sup> According to the Restatement, a particular use qualifies as being "for the purposes of trade" when the "name, likeness, and other indicia of a person's identity" are used "in advertising the user's goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user."<sup>132</sup> Non-commercial uses of a person's identity, such as in "news reporting, commentary, entertainment, works of fiction or nonfiction, or advertising that is incidental to such uses,"<sup>133</sup> are specifically exempted from the Restatement's definition, however, and the comments note that "[u]se of another's identity in a novel, play, or motion picture is also not ordinarily an infringement."<sup>134</sup>

To Nimmer, the line drawn by the Restatement "between entertainment works used for their own sake and commercial works used for advertising purposes," "almost perfectly capture[s] how courts in this domain actually rule."<sup>135</sup> And when we consider the cases as Nimmer instructs ("not between categories, but between utilizations"),<sup>136</sup> the distinction holds true. In *Midler* (an advertisement for the 1986 Mercury Sable) and *Waits* (an advertisement for SalsaRio Doritos), the plaintiffs' right of publicity claims were found not to be preempted by the Copyright Act;<sup>137</sup> but in *Fleet* (a movie) and *Laws* (a pop song), the claims were preempted.<sup>138</sup>

But the problem with Nimmer's approach, at least insofar as it purports to be about federal preemption, is that he never explains what exactly it has to do with preemption in the first place. The only support Nimmer gives for his solution, other than the fact that it happens to explain the case law, is the Restatement—a document which, of course, is concerned with the merits of the underlying right of publicity claim, not whether it is preempted by federal copyright law.<sup>139</sup> In fact, Nimmer admits that if courts choose to follow his approach, "the conflict between the right of publicity and copyright can be resolved without recourse to pre-emption at all."<sup>140</sup>

It is only in cases where the underlying state law fails to make his artistic-vs.-commercial distinction—that is, in cases involving state right of publicity laws that apply to non-commercial misappropriations—that Nimmer suggests that "the line drawn by the Restatement should be used to determine where copyright pre-emption begins."<sup>141</sup> And yet even then, Nimmer fails to explain how exactly a state right of publicity law that happens to encompass non-commercial uses of a plaintiff's persona

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<sup>131</sup> NIMMER, *supra* note 40, § 1.01[B][3][b][iv][I]; *see Seale*, 949 F. Supp. at 336 (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (1995)).

<sup>132</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (1995).

<sup>133</sup> *Id.*

<sup>134</sup> *Id.* cmt. c.

<sup>135</sup> NIMMER, *supra* note 40, § 1.01[B][3][b][iv][I].

<sup>136</sup> *Id.*

<sup>137</sup> *See supra* Part II.A.

<sup>138</sup> *See supra* Part II.B.

<sup>139</sup> *See* NIMMER, *supra* note 40, § 1.01[B][3][b][iv][I].

<sup>140</sup> *Id.*

<sup>141</sup> *Id.*

“stands as an obstacle to the accomplishment and execution of the full purposes or objectives”<sup>142</sup> of the Copyright Act.<sup>143</sup> The only comparison Nimmer offers here is to *Dastar Corp. v. Twentieth Century Fox Film Corp.*,<sup>144</sup> a case in which the Supreme Court refused to read section 43(a) of the Lanham Act to create a cause of action for misrepresentations about the “origin” of a work copied from the public domain and redistributed to the public under a different name. “Just as the Supreme Court warned [in *Dastar*] against ‘mutant copyright’ protection when it limited trademark laws at their interface with copyrighted works,” Nimmer writes, “so courts confronting the interface of right of publicity with copyrighted works must show similar concern to limit the former to its appropriate parameters.”<sup>145</sup>

This is true, of course, but it begs the question. Ultimately, Nimmer’s attempt to harmonize the caselaw is an admirable one, but it complicates things a good deal more than is necessary. As the next Part will attempt to show, there is a much simpler way to think about the preemption issue.

#### IV. AN ALTERNATE EXPLANATION

If Nimmer’s artistic-vs.-commercial distinction is the wrong way to think about the apparent conflict between soundalike cases like *Midler* and actual-use cases like *Laws*, what is the right way? This Part will argue that the two sets of cases are not actually in conflict at all—that their outcomes, which may be counterintuitive, are actually based on a principled distinction in the analysis of copyright preemption. First, this Part demonstrates, based on section 301 and the principles of conflict preemption, that the cases outlined in Part II were rightly decided. Second, this Part defends this outcome from normative criticism, and explains that what seems like unfairness in the law is actually no such thing.

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<sup>142</sup> *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941).

<sup>143</sup> See *supra* section I.C.

<sup>144</sup> *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33–34 (2003). The defendant in *Dastar* took a 1949 television series about World War II that had passed into the public domain, made minor changes to it, and re-released it under a different title while claiming to have produced it. *Id.* at 26–27. Justice Scalia, interpreting the word “origin” in section 43(a) of the Lanham Act, acknowledged the appeal of the plaintiffs’ argument that consumers might be more interested in the intellectual, as opposed to physical, origin of so-called “communicative product[s]” than they would be of regular products, but nevertheless refused to “accord[] special treatment to communicative products” because doing so would “cause[] the Lanham Act to conflict with the law of copyright.” *Id.* at 33. “Assuming for the sake of argument that *Dastar*’s representation of itself as the ‘Producer’ of its videos amounted to a representation that it originated the creative work conveyed by the videos,” he wrote, “allowing a cause of action under § 43(a) for that representation would create a species of mutant copyright law that limits the public’s ‘federal right to copy and to use’ expired copyrights.” *Id.* at 34 (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 165 (1989)).

<sup>145</sup> NIMMER, *supra* note 40, § 1.01[B][3][b][iv][I] (quoting *Dastar*, 539 U.S. at 34).

*A. Copyright Preemption: Soundalikes vs. Actual Uses*

*1. Actual Use Claims Are Preempted*

Recall Nimmer's argument above about the Ninth Circuit's opinion in *Laws*—that it “activated the law of publicity only when the appropriation is towards the minimal side of the spectrum, not when it is maximal.”<sup>146</sup> At first glance, the counterintuitive nature of the court's approach makes this an appealing argument. Why should Bette Midler's claim succeed where Debra Laws's fails, when Laws's voice was actually *used*, and Midler's was only imitated? But when one remembers that the real issue here is preemption, not the merits of the underlying right of publicity claim, it becomes clear that the cases have been correctly decided.

The artistic-vs.-commercial argument that Nimmer uses to explain the cases purports to be based on conflict preemption,<sup>147</sup> but the actual-use cases (*Fleet* and *Laws*) can more easily be understood by reference to the doctrine those cases actually employed: express preemption under section 301 of the Copyright Act. Consider the two elements of section 301 preemption: to invade the domain of copyright, a law must (1) create “legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright,” and (2) apply to “works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright.”<sup>148</sup> The *Laws* court considered the two prongs in reverse order, and held first that Laws's claim was within the subject matter of copyright because what she was trying to protect was her own voice, fixed in a tangible medium of expression.<sup>149</sup> Once that was established, the court disposed of the first prong by rebuffing Laws's contention that her right of publicity claim contained the “extra element” of use for a commercial purpose.<sup>150</sup>

But as the court noted, Laws never disputed that the recording of her voice used by Jennifer Lopez was a copyrighted sound recording fixed in a tangible medium of

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<sup>146</sup> *Id.* § 1.01[B][3][b][iii]; see *supra* note 128 and accompanying text.

<sup>147</sup> See *supra* Part III.

<sup>148</sup> 17 U.S.C. § 301(a) (2006); see *supra* Part I.C.

<sup>149</sup> *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1139–44 (9th Cir. 2006).

<sup>150</sup> See *id.* at 1144.

The mere presence of an additional element (‘commercial use’) in section 3344 is not enough to qualitatively distinguish Laws's right of publicity claim from a claim in copyright. The extra element must transform the nature of the action. Although the elements of Laws's state law claims may not be identical to the elements in a copyright action, the underlying nature of Laws's state law claims is part and parcel of a copyright claim.

*Id.*; see also NIMMER, *supra* note 40, § 1.01[B][1].

[I]f under state law the act of reproduction, performance, distribution, or display, no matter whether the law includes all acts or only some, will *in itself* infringe the state-created right, then such right is pre-empted. But if *qualitatively* other elements are required, instead of, or in addition to, the acts of reproduction, performance, distribution, or display, in order to constitute a state-created cause of action, then the right does not lie ‘within the general scope of copyright,’ and there is no pre-emption.

*Id.* (second emphasis added).

expression.<sup>151</sup> Instead, Laws argued that “a copyright claim protects ownership rights to a work of art, while a right of publicity claim concerns the right to protect one’s persona and likeness,” and pointed to *Midler* for support.<sup>152</sup> The court correctly rejected this argument because it recognized that section 301 is about “rights . . . in works of authorship that are fixed in a tangible medium of expression.”<sup>153</sup> That is, it recognized that the level of generality at which a court should analyze a right of publicity claim for purposes of the first prong of section 301 preemption is determined by what exactly a plaintiff is claiming state-law protection. In *Midler*, there was no particular, discrete representation of Bette Midler’s voice for which she was claiming protection, because defendants had not actually used her voice; rather, she was claiming state-law protection of the general concept of her voice. This might represent a weaker claim than Laws’s *on the merits*,<sup>154</sup> but for purposes of section 301, this weakness was what saved Midler’s claim from preemption.

## 2. Soundalike Claims Are Not Preempted

As it turns out, the more difficult decisions to defend are not *Fleet* and *Laws*, in which actual-use claims were found to be preempted by the Copyright Act, but *Midler* and *Waits*, which held soundalike claims were not. These decisions have come under two separate lines of attack: first, that they should have found preemption under section 301,<sup>155</sup> and second, that they conflict with the goals of section 114.<sup>156</sup>

In a 2007 article in the Vanderbilt Journal of Entertainment and Technology Law, Joseph Bauer argued that the *Midler* and *Waits* courts erred on the “subject matter of copyright” prong of the section 301 analysis:

In [*Midler* and *Waits*], the Ninth Circuit upheld both trial courts’ refusals to dismiss these actions on preemption grounds for the simple reason that a “voice is not copyrightable.” [But] the “subject matter of copyright” also includes the uncopyrightable elements of copyrighted works. As recording artists, both Midler and Waits had made numerous copyrighted sound recordings, of which their distinctive voices were essential elements.

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<sup>151</sup> *Laws*, 448 F.3d at 1141.

<sup>152</sup> *Id.*

<sup>153</sup> See 17 U.S.C. § 301(a).

<sup>154</sup> Indeed, before the *Midler* court’s expansive interpretation of California’s common law right of publicity expanded that cause of action to include sound-alikes. See *supra* note 25 and accompanying text. Such claims would have failed as a matter of law in California under both the common law and statutory rights of publicity. See Perez, *supra* note 25, at 33.

California’s Civil Code section 3344 prohibits the unauthorized use of another’s name, voice, signature, photograph or likeness for advertising, selling, or soliciting purposes. However, as the Ninth Circuit explained in *Midler*, section 3344 protects against the actual use of a person’s voice, but not against the use of an imitation or a sound-alike.

*Id.*

<sup>155</sup> See Joseph P. Bauer, *Addressing the Incoherency of the Preemption Provision of the Copyright Act of 1976*, 10 VAND. J. ENT. & TECH. L. 1, 78–79 (2007).

<sup>156</sup> See NIMMER, *supra* note 40, § 1.01[B][3][b][i].

Rather than viewing the absence of protection for a performer's voice as an instance of a presumed "right" that somehow had fallen between the cracks of the federal copyright regime, the better view is that any failure to permit relief to Midler and Waits can be seen as part of the congressional design regarding those creations that will, and those that will not, get protection under either federal *or state* law.<sup>157</sup>

To a point, of course, Bauer is correct that "the 'subject matter of copyright' also includes the uncopyrightable elements of copyrighted works."<sup>158</sup> But the problem with his argument is that, as the legislative history of section 301 makes clear, unfixed works are not included in the "subject matter of copyright," and "are therefore not affected by the preemption of section 301."<sup>159</sup> And although it is true that "both Midler and Waits had made numerous copyrighted sound recordings, of which their distinctive voices were essential elements,"<sup>160</sup> what was at issue in each of the two cases was not any one of those sound recordings, or any particular fixation of their voices at all.<sup>161</sup>

A somewhat more persuasive argument against the preemption analysis in *Midler* and *Waits* is the one based on the cases' possible conflict with section 114(b) of the Copyright Act, which limits the exclusive rights of reproduction and adaptation of sound recordings to the "actual sounds fixed in the recording."<sup>162</sup> As the provision's legislative history explains, under section 114, "[m]ere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible."<sup>163</sup> Commentators have seized upon this language to argue that section 114(b) represents an affirmative judgment on the part of Congress to allow, even to promote, the existence of soundalike recordings, and that *Midler* and *Waits* frustrate that judgment by permitting states to prevent soundalike recordings in certain situations.<sup>164</sup>

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<sup>157</sup> Bauer, *supra* note 155, at 78.

<sup>158</sup> *Id.*; see H.R. REP. NO. 94-1476, at 131 (1976).

As long as a work fits within one of the general subject matter categories of sections 102 and 103, the bill prevents the States from protecting it even if it fails to achieve Federal statutory copyright because it is too minimal or lacking in originality to qualify, or because it has fallen into the public domain.

*Id.* See also *id.* at 52 ("[A]n unfixed work of authorship, such as an improvisation or an unrecorded choreographic work, performance, or broadcast, would continue to be subject to protection under State common law or statute, but would not be eligible for Federal statutory protection under section 102.").

<sup>159</sup> H.R. REP. NO. 94-1476, at 131.

<sup>160</sup> Bauer, *supra* note 155, at 78.

<sup>161</sup> See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 ("Waits' claim, like Bette Midler's, is for infringement of voice, not for infringement of a copyrightable subject such as a sound recording . . .").

<sup>162</sup> 17 U.S.C. § 114(b) (2006); see *supra* Part I.A.

<sup>163</sup> H.R. REP. NO. 94-1476, at 106.

<sup>164</sup> See, e.g., NIMMER, *supra* note 40, § 1.01[B][3][b][i] ("It is submitted that although [*Midler's*] reasoning validly applies Section 301 of the [Copyright] Act, it nonetheless fails to address the key question at issue: Can a state law forbid that which Congress intended to validate?"); Bauer, *supra* note 155, at 106.

But as Nimmer recognizes, Congress could have made one of two judgments about soundalike recordings when it passed section 114(b)—either that such recordings should remain untouched by federal law, or that they should be actively promoted.<sup>165</sup> And nothing in the text or legislative history of section 114 states, or even implies, that Congress wanted affirmatively to foster the creation of soundalike recordings.<sup>166</sup> Indeed, such a decision would come out of nowhere. Was the public in the mid-1970s clamoring for more soundalike recordings? Was there a powerful “soundalike lobby” demanding that its goods receive special solicitation? The better reading of section 114(b) is that it simply reflects a congressional decision to limit the extent to which *federal* law would protect the owners of the copyright in sound recordings against soundalike recordings. To ascribe any broader purpose to section 114(b) would be to stretch the provision beyond recognition.

### *B. Contractual Protections Are Sufficient for Artists*

If, as the previous section attempted to show, the current state of the law is the correct one, and right of publicity claims based on actual uses of recordings should be preempted while claims based on soundalikes should not be, there remains one problem. Regardless of the correctness of Nimmer’s position on the preemption question, his argument does resonate on a normative level: why should Bette Midler’s claim, based only on a soundalike imitation of her voice, be recognized while Debra Laws’s claim, based on an actual unauthorized use of her voice, is preempted?

Again, the answer lies in the realities of modern copyright law—this time, in its intersection with contract law. Because Ford Motor Company never actually used any portion of Bette Midler’s recording of “Do You Want to Dance,” they had no licensing agreement with Atlantic Records for their use of the song—an agreement that Midler might have been able to prevent via her contract with the label.<sup>167</sup> Elektra Records, on the other hand, did agree to license Debra Laws’s recording of “Very Special” for use in “All I Have.”<sup>168</sup> This licensing agreement was actually in

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[T]here is a strong federal interest in uniform national treatment of copyright—uniformity both in the works that are protectable and what rights the copyright owner will have therein, and in what is *not* protectable. The scope of protection conferred, as well as the areas left unprotected and the rights not afforded, are the product of extensive debates and multiple compromises, and they constitute a deliberately crafted balance of interests. They reflect legislative judgments about the rights of authors and owners of copyrights, and instances in which the interests of users and potential creators of new works should prevail over those of the copyright owner. These judgments will be severely impaired if state law can provide a cause of action for, and thus, can prohibit, the same conduct that federal law leaves unprotected, or alternatively, if state law limits the rights and protections afforded by federal law.

*Id.* (citations omitted).

<sup>165</sup> See NIMMER, *supra* note 40, § 1.01[B][3][b][i].

<sup>166</sup> See H.R. REP. NO. 94-1476, at 106–07.

<sup>167</sup> Midler did not write the song and therefore had no copyright interest in the musical work underlying her recording. See *supra* notes 57–59 and accompanying text.

<sup>168</sup> See *supra* note 105 and accompanying text.

violation of Elektra's original contract with Laws, in which the company agreed, among other things, not to license Laws's recording for use in any audiovisual works without her prior consent.<sup>169</sup>

Thus, *Laws* demonstrates how what seems like an unfair inconsistency in the cases is actually no such thing. Artists like Debra Laws can protect themselves against unauthorized uses of their recordings by including provisions in their recording contracts. Although Laws lost her right of publicity case against Sony Music before the Ninth Circuit, she was not left without a remedy, and was able to bring a separate suit against Elektra in state court for breach of contract.<sup>170</sup> Artists like Bette Midler, on the other hand, have no way of protecting themselves by contract against unauthorized imitations of their sound recordings, because creation of a soundalike recording does not require any authorization from their record labels.<sup>171</sup>

## V. CONCLUSION

The desire for fairness is a strong one in law—so strong, in fact, that it sometimes leads courts and commentators to ignore the realities of what the law does in favor of what they believe it should do. This article has attempted to show that in this particular area of the law, the understandable temptation to ignore the sometimes odd formalisms of copyright preemption in an attempt to harmonize the cases is not only a misguided quest, but an unnecessary one. For while it may seem like a backwards result at first glance, after considering the law of copyright preemption and the *ex ante* contract positions of the artists involved, the current state of the law is the result required by preemption law, and it is a fair one.

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<sup>169</sup> See *Laws v. Sony Music Entm't*, 448 F.3d 1134, 1136 (9th Cir. 2006).

Elektra also secured the right 'to use and to permit others to use your name, the Artist's name... likeness, other identification, and biographical material concerning the Artist... in connection with such master recordings.' Notwithstanding these provisions, Elektra agreed that 'we shall not, without your prior written consent, utilize or authorize others to utilize the Masters in any so-called "audio-visual" or "sight and sound" devices intended primarily for home use,' and 'we or our licensees shall not, without your prior written consent, sell records embodying the Masters hereunder for use as premiums or in connection with the sale, advertising or promotion of any other product or service.'

*Id.*

<sup>170</sup> See *id.* at 1143 n.5.

<sup>171</sup> See *supra* Part I.A.