

June 2012

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### Recommended Citation

Salvo, Joseph P. (1988) "Commercial Sound-Alikes: An Argument for a Performer's Cause of Action," *St. John's Law Review*: Vol. 62 : No. 4 , Article 5.

Available at: <https://scholarship.law.stjohns.edu/lawreview/vol62/iss4/5>

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## COMMERCIAL SOUND-ALIKES: AN ARGUMENT FOR A PERFORMER'S CAUSE OF ACTION

Commercial advertising is big business,<sup>1</sup> and music stokes the engine that powers many modern day commercial advertising campaigns.<sup>2</sup> In the highly competitive battle to influence consumer

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<sup>1</sup> See Bloomquist & Stiansen, *Forecasters Offer Widely Varying Pictures of Ad Spending in 1988*, ADWEEK, Jan. 11, 1988, at 2. The United States Commerce Department predicts a 10% gain in advertising spending in the United States during 1988 to reach a projected total of \$120 billion. *Id.* Robert J. Coen, a director of forecasting at McCann-Erickson, has projected a worldwide increase of advertising spending of 10.3% to \$223.8 billion in 1988. *Id.* Goldman Sachs projects a more modest 6.5% to 7.5% growth of United States advertising spending in 1988. *Id.* According to the Commerce Department, television and radio advertising, which are of primary concern in this Note, are expected to account for \$26.8 billion and \$8.4 billion, respectively. *Id.*

<sup>2</sup> An estimated 20,000 commercials are produced in the United States per year. Telephone interview, Office of Public Relations, American Society of Composers, Authors and Publishers (ASCAP) (Mar. 11, 1988). No industry-wide statistics are readily available respecting the amount of advertising dollars spent on music, due to the large number of variables and parties involved in producing commercials, the fractioned system of payments, the competitive and proprietary nature of the data, and the differing definitions of "music" involved in the calculus. *Id.*

From telephone interviews conducted on March 11-13, 1988 [hereinafter Telephone interviews] with a New York television commercial producer, a New York commercial music producer, and a New York jingle singer, all of whom requested anonymity, the following estimates were gleaned. Between 50% and 75% of the commercials produced for television involved the use of music and if the number of advertisements involving musical "tags" or corporate signatures were included in the total, the percentage of commercials containing "music" increases to 75%-90%. *Id.* Of the commercials containing music other than musical "tags," approximately 10% involve the use of "stock" or prerecorded music, and 90% involve the actual arrangement, production, and recording of music for the commercial. *Id.* Approximately 90% of radio advertisements contain music. *Id.*

Music for television or radio commercials may be produced either in-house at the larger advertising firms, or more typically, subcontracted out to "jingle houses," which will provide an entire package comprising the musical composition, lyrics, performance, and recording. S. SHELMEYER & M. KRASILOVSKY, *THIS BUSINESS OF MUSIC* 270 (4th ed. 1979). In advertising campaigns involving music, typically two-thirds of the ads are put out to bid between the various "jingle houses." Telephone interviews, *supra*. A typical campaign involving music will generate between five and fifty musical "demos," or competitive adaptations, before a musical selection is made by the advertising agency. *Id.* The winning "jingle house" will then produce a number of versions, typically a thirty second and sixty second "spot." Subsequently, these musical "spots" will be aired, if intended for radio, or synchronized with single or multiple videotape versions of the commercial, if intended for television. *Id.*

The allocation of advertising expenditures to production costs will vary considerably with the type of product being advertised, the nature of the commercial, and the purpose of

spending patterns, advertisers have utilized celebrity endorsements,<sup>3</sup> licensed commercially popular songs,<sup>4</sup> and hired popular entertainers to sing, perform, or appear in ads<sup>5</sup> to promote their products.

Traditionally, popular musicians have distanced themselves from commercial advertising campaigns.<sup>6</sup> But a myriad of factors, including considerable touring<sup>7</sup> and recording<sup>8</sup> costs, a heavily-

the campaign. *Id.* An advertisement promoting a new product will usually involve higher production costs than a "reminder" campaign designed to promote an existing product. *Id.* Typically, between 10% and 50% of advertising campaign expenditures will be allotted to production costs. *Id.* An average production budget for a television commercial that is "shot" over two days might allocate \$15,000 for music, not including residual payments, and \$140,000 to \$150,000 for filming and editing. *Id.* A musical "demo" may be made for between \$500 and \$5000. *Id.*

<sup>3</sup> See, e.g., Motavalli, *Advertising Blunders of the Rich and Famous*, ADWEEK, Jan. 11, 1988, at B.R. 18 (20% of television commercials involve celebrities); Shipley, *Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673, 673 (1981) (widespread practice of celebrity endorsements transfers public figure's goodwill to products and services); [1986] Facts on File—Weekly World News Digest With Index, at 384, col. E2 (PepsiCo announces ad campaign with Michael Jackson, May 6, 1986).

<sup>4</sup> See, e.g., *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 713 (9th Cir. 1970) (Goodyear licensed "These Boots Are Made For Walkin'"), *cert. denied*, 402 U.S. 906 (1971); *Davis v. Trans World Airlines*, 297 F. Supp. 1145, 1147 (C.D. Cal. 1969) (TWA licensed "Up, Up and Away"); see also S. SHELMEYER & M. KRASILOVSKY, *supra* note 2, at 268 (citing three compositions licensed for commercial use). There are several ways in which a popular song might be licensed for commercial use. For example, the advertiser may choose to adopt an instrumental version of the composition without substantial change, *id.*, or the song may be adopted with the lyric altered to present the advertising message. See *Davis*, 297 F. Supp. at 1146. Finally, the composition may be licensed in its original recorded version, without change. See, e.g., *DeCurtis, Beatles Sue Over Nike Commercial*, ROLLING STONE, Sept. 10, 1987, at 15 (Nike asserted it properly licensed "Revolution" from Capitol/EMI Records as well as SBK Songs).

<sup>5</sup> See, e.g., Buchanan, *Radio Kings: Ad Rock*, ROLLING STONE, Sept. 10, 1987, at 58 (Jimmy Cliff, America, The Temptations, South Side Johnny, Leon Redbone, and others involved in various advertising campaigns). Two recent Michelob television ads feature appearances and performances by Phil Collins and Eric Clapton.

<sup>6</sup> See *Midler v. Ford Motor Co.*, 849 F.2d 460, 461 (9th Cir. 1988) ("[Bette] Midler did not do television commercials"); Buchanan, *supra* note 5, at 58; Telephone interview with Tom Rush, CBS Records and Night Light Records Recording Artist (Mar. 12, 1988) ("Back [in the late 1960's and early 1970's], nobody did jingles.").

<sup>7</sup> See Ressler, *Touring: The Road to Ruin?*, ROLLING STONE, Dec. 17-31, 1987, at 81. A case in point is David Bowie's "Glass Spider Tour," which was one of the largest shows of 1987. *Id.* at 82. Despite gross revenues of more than \$50 million, the tour, which employed approximately 150 people and required over forty trucks, was expected to only break even. *Id.* Madonna's "Who's That Girl Tour," performed before almost two million spectators on three continents, was one of the most elaborately staged pop revues to date, at an estimated cost approaching \$500,000 per show. Gilmore, *The Madonna Mystique*, ROLLING STONE, Sept. 10, 1987, at 37, 38. Smaller, less well-known musicians have been hit hardest by burgeoning costs and the resulting economic squeeze. Ressler, *supra*, at 81, 82. One of the

mortgaged system of royalty payments,<sup>9</sup> and a high failure rate for popular music releases<sup>10</sup> create financial hardships for most popu-

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largest threats to touring has been the escalating cost of tour insurance, which has risen a dramatic 1000% to 1500% in the last three years alone. *Id.* at 82. Corporate tour sponsorship consequently has become an important buffer for a considerable number of popular performers who have endorsed specific commercial products. *See id.* (Run-D.M.C. and Adidas, Graham Nash and Apple Computers, Whitney Houston and Diet Coke, Genesis and Michelob Beer, Duran Duran and Coke). The Bowie Tour would have lost "multi-multi-millions" without tour sponsorship from Pepsi, according to Bowie's tour manager. *Id.* As a portent of things to come, one prominent tour accountant predicts that "[i]n three years, every tour will go out with a sponsor." *Id.*

<sup>9</sup> Telephone interviews, *supra* note 2. Record budgets can vary exponentially, depending on the number of outside musicians employed, the stature of the artist, the success of the artist's previous work, the amount of preproduction, and the type of recording and electronically-synthesized sound production involved. *Id.* Typically, a record that might cost \$50,000 to produce ten years ago would cost \$250,000 today. *Id.* It is not unusual to see contracts providing advances to artists of \$1,000,000 to \$5,000,000. *See* Arrow, Margolis, Milom, Phillips & Silfen, *Phonorecords*, in *COUNSELING CLIENTS IN THE ENTERTAINMENT INDUSTRY* 11 (Practicing Law Institute 1987) [hereinafter Arrow & Margolis]. Major innovations in sound recording and playback technology, such as digital recording and compact disc players, have stimulated the public appetite for higher quality recordings, leading, in turn, to higher production costs. *See* Henke, *Daniel Lanois*, *ROLLING STONE*, Dec. 17-31, 1987, at 93, 98 (discussing influence of digital recording and compact discs on state of record making); Wilkinson, *What is DAT, and Why are the Record Companies Trying to Keep it Away from You?*, *ROLLING STONE*, Sept. 10, 1987, at 69 (discussing digital audiotape and its impact on recording industry). Additionally, an election by the record company and the artist to produce an accompanying video will increase production costs by anywhere from \$15,000 to over \$500,000. Wells, *Music Videos and the 1st Amendment*, N.Y.L.J., Sept. 11, 1987, at 5, col. 1 (citing S. SHEMEL & M. KRASILOVSKY, *THIS BUSINESS OF MUSIC* 76 (5th ed. 1985)). *See generally* Arrow & Margolis, *supra*, at 13 (average recording costs of album are between \$125,000 and \$250,000).

<sup>9</sup> *See* Arrow & Margolis, *supra* note 8, at 13-18. Typically, a new artist will receive a 12% royalty, ostensibly based upon net sales. *Id.* Net sales are determined after deducting the number of promotional albums shipped and albums returned. *See id.* at 14, 23, 69, 75. But the artist is often compelled to split this royalty with the record's producer, who typically takes 25% or three "points," and the other band members. *See id.* at 14, 23. In addition, many record labels take a \$.75 to \$1.00 deduction per record for record jacket costs, or alternatively, pay royalties based on 90% of net sales. *See id.* at 13, 77.

The largest economic hardship results from the fact that all musical production costs are ultimately borne by the artist alone. All monies laid out by the record company for costs incurred in the production of a record are considered advances against artist royalties. *See id.* at 82-83. Thus, if an album costs \$250,000 to make, and the artist is realizing a \$1.00 per record royalty, the record must sell a quarter of a million copies before the artist begins to earn any money. A successful artist might typically pay the producer, business manager, personal manager, and fellow band members with what is left over after the record company has recovered costs, creating the untenable situation where a record might be required to sell "gold" (500,000 copies) or "platinum" (1,000,000 copies) before the artist realizes any substantial financial gain. The record companies have traditionally defended this heavily-mortgaged royalty scheme by citing the high failure rate of records and the carrying costs of unrecouped payments. *See infra* note 10.

<sup>10</sup> *See* Pond, *Gil Friesen*, *ROLLING STONE*, Dec. 17-31, 1987, at 106. One record company

lar musicians.<sup>11</sup> In stark contrast, the netherworld of commercial advertising often proffers generous bonuses<sup>12</sup> and lucrative residual

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president opined that less than one-third of the records released in any given year will be profitable. *Id.* During deliberations before the United States House of Representatives incident to the passage of the Copyright Act of 1976, Pub. L. No 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-810 (1982 & Supp. IV 1986)), the Recording Industry Association of America indicated that the failure rate of new records more closely approximates 75% to 80%, and that only 6% of the records released make any real profits. SUBCOMM. ON COURTS, CIVIL LIBERTIES, AND THE ADMINISTRATION OF JUSTICE OF THE HOUSE COMM. ON THE JUDICIARY, 95TH CONG., 2D SESS., REPORT ON PERFORMANCE RIGHTS IN SOUND RECORDINGS 726, 739 (Comm. Print 1978) [hereinafter HOUSE REPORT]. Part of the problem may be ascribed to protean audience loyalties and capricious audience purchasing habits. *See id.* at 743; Pond, *supra*, at 106.

<sup>11</sup> *See* S. Werner, An Economic Impact Analysis of a Proposed Change in the Copyright Law, reprinted in HOUSE REPORT, *supra* note 10, at 59, 117 [hereinafter Ruttenberg Report]. Prior to the passage of the 1976 Copyright Act, the United States Copyright Office commissioned a study known as the Ruttenberg Report to analyze the impact of a proposed performance royalty upon the earnings of popular musicians. *Id.* at 59; *see infra* notes 48-54. The argument against the royalty, which was to be assessed against broadcasters for each "play" of an artist's performance, was that it would provide an economic windfall for record companies and performers. *See, e.g.,* HOUSE REPORT, *supra* note 10, at 596 (performance rights will make rich richer); *id.* at 633 (performers and record companies are well compensated for efforts). The Ruttenberg Report not only decisively refuted that contention, but also graphically documented the chasm between the public perception and economic realities respecting monies earned by popular musicians. *See* Ruttenberg Report, *supra*, at 115-20.

The report found that only about one-half of the musicians had ever made a sound recording, and that only 23% of this fortunate one-half received royalties from these records. *Id.* at 115, 120. For those performers receiving a royalty from record sales, more than 75% receive less than 5% of their annual earnings from these royalties. *Id.* at 118. Almost one-third of the musicians who had made sound recordings had earnings of less than \$7,000 per year, and greater than 50% earned less than \$13,000 in 1976. *Id.* at 120. In general, the study depicts considerable economic insecurity among sound recording participants. *See* D'Onofrio, *In Support of Performance Rights in Sound Recordings*, 29 UCLA L. Rev. 168, 180-81 (1981). House hearings similarly disclosed that a greater number of performers are unemployed, and for longer periods, than the majority of workers in other fields. *Id.* at 181 (citing *Performance Rights in Sound Recordings: Hearings Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary*, 95th Cong., 2d Sess. 51 (1978) (testimony of Tichi Wilkerson Miles, publisher of the *Hollywood Reporter*)).

<sup>12</sup> *See, e.g.,* [1986] Facts On File—Weekly World News Digest With Index, at 384, col. E2 (PepsiCo announces ad campaign featuring Michael Jackson for estimated \$15,000,000); Motavalli, *supra* note 3, at B.R. 18 (Michael Jackson, David Bowie, and Tina Turner all recipients of multi-million dollar endorsement contracts with Pepsi). The fees paid to popular musicians to participate in advertising campaigns will vary with the stature of the artist, the use of the artist's name and image in conjunction with his or her performance, and geographic distribution of the ad. Telephone interviews, *supra* note 2. One moderately well-known performer was paid \$7,500 for one television spot that was aired only in the metropolitan New York regional area. *Id.* An average performance fee for a television ad campaign, without use of the artist's name or likeness is \$25,000 to \$30,000. *Id.* One celebrity performer was recently paid \$850,000, however, to sing and arrange two sixty-second televi-

royalty payments<sup>13</sup> as incentive for those popular musicians ven-

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sion spots for a regional campaign. *Id.* Typically, the fee paid will represent compensation to the artist for a specified period of time, with arrangements made for additional compensation should the ads run for longer than the specified time period. *Id.* As an example, one nationally-recognized singer received \$400,000 for the first four years of a national advertising campaign, with the contract calling for an additional \$100,000 to be paid for each subsequent year the ad ran. *Id.* The fees increase considerably when the performer's name and/or likeness are utilized in the commercial. *Id.* The recent nationally-televised beer commercials featuring Steve Winwood and Eric Clapton were estimated to be worth "millions" to the respective performers. *Id.*

<sup>13</sup> Telephone interview with Dorothy Doe, Staff Researcher, American Ass'n of Advertising Agencies (Mar. 14, 1988). In 1987, American advertisers paid \$340,000,000 in residuals to the Screen Actors Guild ("SAG") and \$60,000,000 in residuals to the American Federation of Radio & Television Announcers ("AFTRA"). *Id.* Unlike popular music, where the performers do not receive a performance royalty each time their performance is aired on radio or television, *see infra* notes 48-54 and accompanying text, advertisers pay residuals to performers for the repeated use of their performances according to schedules set forth in collective bargaining agreements with the American Federation of Musicians ("AF of M") (musicians), AFTRA (vocalists on radio commercials), and SAG (vocalists and on-camera appearances for TV commercials). Telephone interviews, *supra* note 2. The collective bargaining agreements set forth the initial session fee, which varies depending on the number of "spots" and performances. *See* AMERICAN FED'N OF TELEVISION & RADIO ANNOUNCERS, 1985 AFTRA TELEVISION RECORDED COMMERCIALS CONTRACT 16-17 (1985) (prescribing payments for doubled performances). Residual payments are then rendered for each airing of the spot according to a decreasing residual payment schedule that repeats itself every thirteen weeks. *Id.* at 23-24. The schedules reimburse vocalists at a rate that is substantially greater than that received by musicians. *Id.*

The current AFTRA contract, for example, provides for an initial range of payments to vocalists of between \$250 for a single solo "spot" or ad and \$100 for a single group "spot" where the singer is one of a group of nine or more vocalists. *Id.* at 14. The residual payments provide for use payments of \$250 for the first use of the solo spot during the thirteen week period, \$96 for the second use, \$76 for the third use, etc., for a class A use for a principal performer. *Id.* at 33-34. After thirteen weeks, this schedule repeats itself. *See id.* at 25, 35.

In contrast, the AF of M contract provides for an initial session fee of \$78 per hour for five or more musicians, with an additional 30% if a musician "doubles" by playing another instrument on the session. The initial session fee includes the residual payments for the initial thirteen week period, and the musician is paid 70% of the initial session fee for the subsequent thirteen weeks. Unlike singers, who are paid per spot produced, the musicians may be asked to perform on up to three different spots for the same initial session fee. *See* MAY 1, 1987-APR. 30, 1989 AMERICAN FEDERATION OF MUSICIANS, TELEVISION AND RADIO COMMERCIAL ANNOUNCEMENTS AGREEMENT 12, 20 (updated as of Nov. 4, 1988).

A fairly large, national campaign that runs for one year might generate \$15,000 in residuals for a vocalist, and residual payments exceeding \$200,000 are not uncommon. *See* Buchanan, *supra* note 5, at 58. The fee paid to celebrity performers is often an advance against "double-scale" residuals, *i.e.*, royalties, at twice the specified rates. Telephone interviews, *supra* note 2. The fee thus serves as a guaranteed minimum royalty payment for the artist, but the artist's ultimate compensation will be substantially higher in a successful national advertising campaign. *Id.* While musicians do not receive royalty payments based upon television and radio airings of their performances, the recording industry has set up a Special Payments Fund by which musicians receive an annual check representing their share of monies set aside by the record companies from record sales for their contribution to

turesome enough to ford the River Styx. The increasingly common result is an uneasy marriage of convenience, symbiotically wedding performer to advertiser in a labyrinthine scheme that provides popular musicians with the large infusions of capital and publicity<sup>14</sup> necessary to sustain their careers,<sup>15</sup> in exchange for the exclusive right to exploit the performer's accrued "goodwill."<sup>16</sup>

As an alternative, advertisers sometimes elect to produce commercials employing "sound-alikes,"<sup>17</sup> wherein actors or musicians are employed to imitate a particular performer's voice<sup>18</sup> or musical style.<sup>19</sup> The advertiser may thus realize considerable savings,<sup>20</sup>

the record. *Id.* Each musician's share, however, is computed on the basis of the number of recording dates the musician has participated in, irrespective of the success or failure of the individual records embodying their performances. *Id.* Thus, a musician who has participated in five recording dates, one of which was Michael Jackson's *Thriller*, receives the same "special payment" at the end of the year as the musician who participated in five recording dates involving records that lost money for the record company. *Id.* As such, the "special payments" are not a true performance royalty, and represent a contractual arrangement between the record manufacturers and the AF of M pursuant to the collective bargaining agreement.

<sup>14</sup> See *supra* note 12.

<sup>15</sup> See *supra* note 11; HOUSE REPORT, *supra* note 10, at 739; see also Statement of the Recording Industry Ass'n of America (July 27, 1977) ("Only the few very famous stars achieve notoriety and economic security while the thousands of supporting artists who contribute so much to a recorded performance remain unknown and confront an uncertain future." (citation omitted)), reprinted in HOUSE REPORT, *supra* note 10, at 459-92. The statement also noted that at one record company in 1967, only 14% of the artists on their roster earned enough royalties from record sales to defray expenses, and approximately "188 of [a total] 1300 performers had a profit in their royalty account." *Id.* at 473.

<sup>16</sup> See Ausness, *The Right of Publicity: A "Haystack in A Hurricane"*, 55 TEMP. L.Q. 977, 977 (1982); Shipley, *supra* note 3, at 673; Simon, *Right of Publicity Reified: Fame as Business Asset*, 30 N.Y.L. SCH. L. REV. 699, 714 (1985); Note, *The Right of Publicity as a Means of Protecting Performers' Style*, 14 LOY. L.A.L. REV. 129, 132 (1980).

<sup>17</sup> See Kent, *Rights of Celebrities*, N.Y.L.J., Oct. 6, 1987, at 3, col. 5. For purposes of this Note, "sound-alikes" shall be defined as commercials employing performers who intentionally imitate a famous performer or performance. One producer indicated that 35% to 40% of the time clients ask him to produce commercials that imitate a particular vocal performance on a popular record. Telephone interviews, *supra* note 2. He estimated that less than 25% of the ads produced involved deliberate vocal imitations. *Id.*

<sup>18</sup> See, e.g., *Lahr v. Adell Chem. Co.*, 300 F.2d 256, 257 (1st Cir. 1962) (defendant imitated plaintiff's comedic accent in advertisement); *Midler v. Ford Motor Co.*, No. CV 86-2683, slip op. at 4 (C.D. Cal. Aug. 12, 1987) (ad agency hired singer to imitate voice of recording artist), *rev'd*, 849 F.2d 460 (9th Cir. 1988); *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 345 (S.D.N.Y. 1973) (defendant used imitated voice of television character created by plaintiff).

<sup>19</sup> See, e.g., *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 716 (9th Cir. 1970) (imitation of plaintiff's voice and theatrical style in defendant's advertisement), *cert. denied*, 402 U.S. 906 (1971); *Gardella v. Log Cabin Prods. Co.*, 89 F.2d 891, 894 (2d Cir. 1937) (defendant hired actress to imitate plaintiff's singing style in radio advertisements); *Davis v. Trans World Airlines*, 297 F. Supp. 1145, 1146 (C.D. Cal. 1969) (imitation of plaintiff's musi-

while still acceding to the "goodwill" that ordinarily attaches in celebrity/advertiser marriages.<sup>21</sup> Despite widespread judicial acknowledgement that a performer has a proprietary interest in the marketable nature of his or her public persona,<sup>22</sup> courts have traditionally turned a deaf ear to claims by performers predicated on sound-alikes.<sup>23</sup> Judicial relief has been granted for the unauthorized appropriation of a name,<sup>24</sup> face,<sup>25</sup> likeness,<sup>26</sup> photograph,<sup>27</sup> and

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cal style and arrangement in defendant's radio and television advertisement); *see also* Shaw v. Time-Life Records, 38 N.Y.2d 201, 205, 341 N.E.2d 817, 820, 379 N.Y.S.2d 390, 394 (1975) (defendant permitted to duplicate Swing-Era arrangements and "sound" of big band leader on certain compositions); Lombardo v. Doyle Dane & Bernbach, Inc., 58 App. Div. 2d 620, 622, 396 N.Y.S.2d 661, 664 (2d Dep't 1977) (plaintiff had proprietary interest in his "public personality" which was combination of his gestures, musical beat, and choice of music).

<sup>20</sup> Telephone interviews, *supra* note 2. Unless otherwise agreed, a jingle singer or musician will receive only the session fee mandated by the AFTRA, SAG, or AF of M agreements, plus prescribed residuals for his or her performance. *Id.* The advertiser thereby saves the substantial fees normally accompanying a celebrity performance. *See supra* note 12.

<sup>21</sup> *See supra* note 16 and accompanying text.

<sup>22</sup> *See, e.g.,* Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988) (distinctive voice is protectible property interest); *Lahr*, 300 F.2d at 259 (sustaining plaintiff's claim for unfair competition); Motown Record Corp. v. George A. Hormel & Co., 657 F. Supp. 1236, 1241 (C.D. Cal. 1987) (summary judgment denied because plaintiffs may demonstrate protectible interest in "persona" of "The Supremes"); Allen v. National Video, Inc., 610 F. Supp. 612, 625-26 (S.D.N.Y. 1985) (actor has commercial investment in "drawing power" of name or face); *Lombardo*, 58 App. Div. 2d at 622, 396 N.Y.S.2d at 664 (celebrity has legitimate proprietary interest in public personality); Columbia Broadcasting Sys. v. Documentaries Unlimited, Inc., 42 Misc. 2d 723, 725, 248 N.Y.S.2d 809, 811 (Sup. Ct. N.Y. County 1964) (voice and style of talking may not be appropriated without author's consent).

<sup>23</sup> *See, e.g.,* Sinatra, 435 F.2d at 716 (combination of performer's sound, melody, lyrics, and arrangement unprotected); *Gardella*, 89 F.2d at 898 (insufficient proof of confusion or deception in use of sound-alike compels reversal of unfair competition claim); Booth v. Colgate-Palmolive Co., 362 F. Supp. 343, 348-49 (S.D.N.Y. 1973) (imitation of performer's voice used in comedy series not entitled to protection under either New York's unfair competition law or Lanham Act); *Shaw*, 38 N.Y.2d at 207-08, 341 N.E.2d at 821, 379 N.Y.S.2d at 396 (plaintiff's claim for appropriation of musical arrangement based on performer's right of publicity dismissed, but plaintiff may be allowed to prove "palming off").

<sup>24</sup> *See, e.g.,* Factors Etc., Inc. v. Pro Arts, Inc., 496 F. Supp. 1090, 1092 (S.D.N.Y. 1980) (Elvis Presley's name), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982); Eastwood v. Superior Court, 149 Cal. App. 3d 409, 413, 198 Cal. Rptr. 342, 344 (1983) (Clint Eastwood's name); Rosemont Enters. v. Urban Sys., 72 Misc. 2d 788, 789, 340 N.Y.S.2d 144, 145 (Sup. Ct. N.Y. County) (Howard Hughes' name), *modified*, 42 App. Div. 2d 544, 345 N.Y.S.2d 17 (1st Dep't 1973).

<sup>25</sup> *See, e.g.,* Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 867 (2d Cir.) (defendant invaded plaintiff's exclusive rights to manufacture baseball cards with faces of leading baseball players), *cert. denied*, 346 U.S. 816 (1953); Allen v. Men's World Outlet, Inc., 679 F. Supp. 360, 361 (S.D.N.Y. 1988) (Woody Allen's face); *National Video*, 610 F. Supp. at 617 (same).

<sup>26</sup> *See, e.g.,* Ali v. Playgirl, Inc., 447 F. Supp. 723, 729 (S.D.N.Y. 1978) (court extended protection to a caricature of Muhammad Ali); Onassis v. Christian Dior-New York, Inc., 122 Misc. 2d 603, 604-06, 472 N.Y.S.2d 254, 257-58 (Sup. Ct. N.Y. County 1984) (advertisement



character,<sup>28</sup> and courts have even gone so far as to recognize a *limited* cause of action for the unauthorized use and exploitation of a performer's distinctive vocal or musical style.<sup>29</sup> In so doing, the courts have relied upon a confusing amalgam of copyright,<sup>30</sup> trademark,<sup>31</sup> unfair competition,<sup>32</sup> and tort law.<sup>33</sup>

Musicians have repeatedly attempted to negotiate this legal minefield by attacking the unauthorized appropriation of musical styles,<sup>34</sup> and in the recent decision of *Midler v. Ford Motor Co.*,<sup>35</sup>

involving celebrity look-alike infringed upon plaintiff's publicity rights).

<sup>27</sup> See, e.g., *Factors Etc.*, 496 F. Supp. at 1104 (poster of Elvis Presley enjoined); *Eastwood*, 149 Cal. App. 3d at 413, 198 Cal. Rptr. at 344 (photo of Clint Eastwood in *National Enquirer* constituted unauthorized commercial exploitation).

<sup>28</sup> See, e.g., *Price v. Worldvision Enters.*, 455 F. Supp. 252, 253-54 (S.D.N.Y. 1978) (protection for Laurel and Hardy characters), *aff'd*, 603 F.2d 214 (2d Cir. 1979); *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 840 (S.D.N.Y. 1975) (same); *Chaplin v. Amador*, 93 Cal. App. 358, 363, 269 P. 544, 546 (1928) (court granted protection for "Charlie Chaplin" character).

<sup>29</sup> See *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988); *Lahr v. Adell Chem. Co.*, 300 F.2d 256, 259 (1st Cir. 1962); *Lombardo v. Doyle Dane & Bernbach, Inc.*, 58 App. Div. 2d 620, 622, 396 N.Y.S.2d 661, 664 (2d Dep't 1977); see also Shipley, *supra* note 3, at 680 & n.48 (courts have protected style under right of publicity). *But see* Note, *supra* note 16, at 138-39 (courts have not extended right of publicity to take cognizance of performer's "style," including voice).

<sup>30</sup> See, e.g., *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1240 (C.D. Cal. 1987) (unauthorized use of copyrighted work and "persona" actionable); *Lennon v. Pulsebeat News, Inc.*, 143 U.S.P.Q. (BNA) 309, 309 (Sup. Ct. N.Y. County 1964) (common law copyright prohibits use of distinctive manner of speech for profit without permission).

<sup>31</sup> See, e.g., *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360, 371 (S.D.N.Y. 1988) (§ 43(a) Lanham Act claim upheld); *Motown Record*, 657 F. Supp. at 1241 (possible § 43(a) Lanham Act claim exists); *Allen v. National Video, Inc.*, 610 F. Supp. 612, 626-30 (S.D.N.Y. 1985) (§ 43(a) Lanham Act claim upheld).

<sup>32</sup> See, e.g., *Gardella v. Log Cabin Prods. Co.*, 89 F.2d 891, 896 (2d Cir. 1937) (deceptive imitation could give rise to "passing off" claim); *Shaw v. Time-Life Records*, 38 N.Y.2d 201, 207, 341 N.E.2d 817, 821, 379 N.Y.S.2d 390, 395 (1975) (imitations of plaintiff's recordings present triable issue of unfair competition); *Lombardo*, 58 App. Div. 2d at 622, 396 N.Y.S.2d at 664 (imitation of plaintiff's public personality deceives public).

<sup>33</sup> See, e.g., *Lahr*, 300 F.2d at 258-59 (plaintiff's allegations of defamation preclude dismissal of complaint for failure to state cause of action); *Lombardo*, 58 App. Div. 2d at 622, 396 N.Y.S.2d at 664 (misappropriation of plaintiff's property right in his persona); *Onassis v. Christian Dior-New York, Inc.*, 122 Misc. 2d 603, 616, 472 N.Y.S.2d 254, 263 (Sup. Ct. N.Y. County 1984) (impermissible misappropriation of identity in violation of right of privacy).

<sup>34</sup> See, e.g., *Midler v. Ford Motor Co.*, No. CV 86-2683, slip op. (C.D. Cal. Aug. 12, 1987), *rev'd*, 849 F.2d 460 (9th Cir. 1988). In *Midler*, Bette Midler brought a suit challenging Ford's use of a sound-alike in a commercial following the plaintiff's refusal to perform in it. *Id.*, slip op. at 4. Midler alleged unfair competition and a violation of her right of publicity under state common law and section 3344 of the California Civil Code, but did not originally raise a trademark claim under section 43(a) of the Lanham Act. *Id.*, slip op. at 5. Midler's subsequent efforts to amend the complaint to add a Lanham Act claim were denied. *Id.*

seemingly scored a significant victory. But when the smoke invariably clears, the legal vitality of the practice of producing unauthorized sound-alikes still remains largely unscathed.<sup>36</sup> This Note will explore the legal issues surrounding sound-alikes and examine the possible causes of action available to a performer to protect his or her unique musical style. It is submitted that the current economic exigencies of the music industry<sup>37</sup> and recent developments in trademark law<sup>38</sup> compel a change in the disparate treatment accorded sound-alikes,<sup>39</sup> and militate in favor of protecting a performer's musical style against unauthorized appropriation. It is further submitted that the foundations of a viable cause of action exist in New York, and that some form of compulsory license may best satisfy the divergent needs of advertisers and performers.

### THE COPYRIGHT ACT

Any discussion of performer's rights must begin with an exam-

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Similarly, a claim was filed by Apple Records during the summer of 1987 against Nike for use of the Beatles' song "Revolution" in an athletic footwear ad. Complaint at 11-12, *Apple Records, Inc. v. Nike, Inc.*, No. 17962/87 (Sup. Ct. N.Y. County July 28, 1987). Nike has claimed proper licensing of both the underlying composition and the actual recording, suggesting the ad in issue is not a sound-alike. See DeCurtis, *supra* note 4, at 15. The plaintiffs have alleged, *inter alia*, a right of publicity violation, a section 43(a) Lanham Act claim, misappropriation, unfair competition, and violations of New York General Business Law sections 368(d) (trademark dilution) and 133 (false advertising). Complaint at 14, 16, 18, 19, 21, *Apple Records*, No. 17962/87; see also *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 714 (9th Cir. 1970) (reliance on unfair competition and "passing off" claims), *cert. denied*, 402 U.S. 906 (1971); *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 344 (S.D.N.Y. 1973) (allegations of unfair competition, Lanham Act violation, and defamation); *Lombardo v. Doyle Dane & Bernbach, Inc.*, 58 App. Div. 2d 620, 620, 396 N.Y.S.2d 661, 663 (2d Dep't 1977) (action for breach of contract, invasion of privacy, and appropriation of plaintiff's persona).

<sup>36</sup> 849 F.2d 460 (9th Cir. 1988).

<sup>36</sup> *Id.* at 463 (limiting holding to specific facts by noting "we need not . . . go so far as to hold every imitation of a voice . . . is actionable"); see also *infra* notes 114-19, 151 and accompanying text (discussing *Midler* and its ramifications). As a result, several commentators have suggested the decision raises more questions than it answers. See Marks, *The Bette Midler Case: Judiciary Finally Listens to Sound-Alike Claim*, N.Y.L.J., Oct. 5, 1988, at 1, col. 1; Kent, *A New Tune in Using Sound-Alikes*, N.Y.L.J., July 22, 1988, at 3, col. 1.

<sup>37</sup> See *supra* notes 7-11 and accompanying text.

<sup>38</sup> See *infra* notes 178-85 and accompanying text.

<sup>39</sup> Cf. *Allen v. National Video, Inc.*, 610 F. Supp. 612, 630 (S.D.N.Y. 1985) (court granted injunctive relief against commercial use of celebrity "look-alike"); *Onassis v. Christian Dior-New York, Inc.*, 122 Misc. 2d 603, 616, 472 N.Y.S.2d 254, 263 (Sup. Ct. N.Y. County 1984) (same); see also N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1976 & Supp. 1988) (granting statutory protection against unauthorized trade use of name, portrait, or picture, but not voice).

ination of the Copyright Act of 1976 (the "Act" or the "1976 Act").<sup>40</sup> Section 102 of the Act<sup>41</sup> provides protection to original works of authorship fixed in a tangible medium,<sup>42</sup> but does not extend that protection to ideas<sup>43</sup> or their intangible expression.<sup>44</sup> No copyright protection inures to a performance or style unless and until it is fixed in some tangible medium of expression.<sup>45</sup> Sound recordings are expressly included as a protectible work,<sup>46</sup> but of the exclusive rights that ordinarily vest in the owner of a copyright,<sup>47</sup> section 114(a) excludes any right of performance for sound recordings.<sup>48</sup> This highly controversial section of the 1976 Act<sup>49</sup> not only

<sup>40</sup> The Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-810 (1982 & Supp. IV 1986)).

<sup>41</sup> *Id.* § 102.

<sup>42</sup> *Id.* § 102(a).

<sup>43</sup> *Id.* § 102(b).

<sup>44</sup> *Id.*; see also Ausness, *supra* note 16, at 1016-17 (protection for original works fixed in tangible medium); Shipley, *supra* note 3, at 684 (copyright protection not available unless idea fixed in tangible form).

<sup>45</sup> 17 U.S.C. § 102(a) (1982); see also *United States v. Taxe*, 540 F.2d 961 (9th Cir. 1976) (sound recording protected when final master recording is reproduced in published copies), *cert. denied*, 429 U.S. 1040 (1977). See generally H.R. REP. NO. 94-1476, 94th Cong., 2d Sess. 51-53, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5664-66 (discussion of requirement of fixation in tangible form); Note, *Intellectual Property-Performer's Style—A Quest for Ascertainment, Recognition, and Protection*, 52 DEN. L.J. 561, 572 (1975) (discussing pre-1976 Act requirement of tangibility).

<sup>46</sup> 17 U.S.C. § 102(a)(7) (1982).

<sup>47</sup> See *id.* § 106. Under section 106, the owner of a copyright has the exclusive right, subject to limitations imposed by sections 107-118:

- (1) [T]o reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) 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;
- (4) in the case of . . . musical . . . works . . . and motion pictures and other audiovisual works, to perform the copyrighted work publicly; and
- (5) in the case of . . . musical . . . works . . . and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.

*Id.*

<sup>48</sup> *Id.* § 114(a).

<sup>49</sup> See HOUSE REPORT, *supra* note 10, at 28-58. Because of the controversy engendered by the proposed performance right in sound recordings, section 114(d) of the Act was enacted as a compromise to give Congress additional time to study the issue. *Id.* at 1. The House Report is replete with conflicting testimony as to the value and cost of a right of performance for sound recordings, with the musicians and record companies lobbying for a performance right, and broadcasters, jukebox operators, and others whose financial interests would be adversely affected lobbying against it. See D'Onofrio, *supra* note 11, at 169. Congress ultimately adopted the broadcaster's position. See 17 U.S.C. § 114(a) (1982) (exclusive rights in sound recording do not include right of performance).

precludes the artist from controlling the public presentation of his or her performance in the fixed work,<sup>50</sup> but also denies the artist a royalty for the commercial use of his or her performance.<sup>51</sup> While composers and publishers receive a performance royalty for each sale<sup>52</sup> and for each "play"<sup>53</sup> of the record containing a copyrighted composition, the artists and musicians whose performances are embodied in the popular rendition do not.<sup>54</sup> Moreover, section 114(b) specifically permits imitation of a sound recording, provided it is accomplished by an "independent fixation of other sounds."<sup>55</sup> Section 114(b) thus raises the issue of whether a sound-alike may ever constitute an unauthorized appropriation of a performer's proprietary interest,<sup>56</sup> especially in light of the preemption provisions con-

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<sup>50</sup> See 17 U.S.C. § 114(a) (1982).

<sup>51</sup> See D'Onofrio, *supra* note 11, at 168.

<sup>52</sup> See 17 U.S.C. § 115 (1982 & Supp. IV 1986). Section 115 modifies the exclusive rights conferred by section 106 upon the owner of a copyright. *Id.* In particular, the right to reproduce the work, prepare a derivative work, and distribute copies of the work for sale are subject to a compulsory license if the work is a nondramatic musical work. *Id.* Section 115 permits the copyright owner to control first use and publication of the work, but permits a user to obtain a compulsory license from the copyright owner for subsequent use of the work. *Id.* § 115(a)(1). Upon proper notification to the copyright owner, a license is issued in return for payment of a statutorily-prescribed royalty. *Id.* § 115(b), (c).

<sup>53</sup> See D'Onofrio, *supra* note 11, at 168.

<sup>54</sup> *Id.* The artists and musicians who participate in the recording session receive a one-time recording fee that is set in accordance with the AF of M collective bargaining agreement, but will not participate in "publishing" royalties unless so provided by contract. See Telephone interviews, *supra* note 2; see also *supra* note 13 (musicians may also share in Special Payment Fund).

<sup>55</sup> 17 U.S.C. § 114(b) (1982). Section 114(b) provides in pertinent part:

The exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 is limited to the right to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality. The exclusive rights . . . do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording.

*Id.* Thus, the owner of a copyright in a sound recording may not bring an action for a "sound-alike" record, provided the sound-alike was created by independently rerecording the sounds on the record and not by directly duplicating the work. See H.R. REP. NO. 94-1476, 94th Cong., 2d Sess. 106, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5721. "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." *Id.*; accord *United States v. Taxe*, 540 F.2d 961, 965 (9th Cir. 1976), cert. denied, 429 U.S. 1040 (1977).

<sup>56</sup> See *supra* note 55 and accompanying text. Imitation of a copyrighted sound recording is expressly permitted, thereby precluding any cause of action for the owner of the copyright in the sound recording. *Id.* The question then arises whether a performer, by rendering a performance that is now captured in a fixed medium, relinquishes all common law copy-

tained in section 301 of the Act.<sup>57</sup>

Under section 301, all legal and equitable rights "equivalent" to those conferred by section 106,<sup>58</sup> as contained in fixed works, are specifically preempted by the Act,<sup>59</sup> with two major exceptions. State statutory and common law remedies respecting noncopyrightable works,<sup>60</sup> and those rights and remedies conferred by other federal statutes,<sup>61</sup> are excepted from preemption. While it has been held that section 301(a) mandates preemption for claims of unauthorized appropriation of a musical performance,<sup>62</sup> it is equally clear that sections 301(a), (b), and (d) permit claims implicating nonequivalent rights,<sup>63</sup> unprotected interests,<sup>64</sup> and rights descending from a federal statute.<sup>65</sup> Thus, a performer seeking pro-

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right and proprietary interests in his performance. It appears that the Supreme Court has answered this question in the negative. See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977). In *Zacchini*, the Court recognized a state-created right of publicity which afforded a human cannonball act protection against an unauthorized televised news broadcast. *Id.* After recognizing no protection was provided for the performance under common law or statutory copyright, the Court noted nonetheless a protectible interest in the performance and granted relief. *Id.* at 576-79. The Court thus recognized a protectible proprietary interest in a performance independent of copyright, giving rise to a separate cause of action. See *id.*; cf. *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 675 n.22 (7th Cir. 1986) (where performance is fixed under authority of author, right of publicity is preempted by copyright). See generally Shipley, *supra* note 3, at 699-700 (state-based claims by performers and their acts are consistent with allowing states to protect intellectual property left unprotected by federal law).

It seems clear that until such time as a work, such as a performance, is fixed in a tangible medium, that work may be protected by state law remedies that are "doctrinally equivalent to copyright." See *id.* at 704. It is far less clear whether these rights are subsumed into those of the copyright owner of the sound recording, precluding any possible cause of action. See Comment, *The Twilight Zone: Meanderings in the Area of Performer's Rights*, 9 UCLA L. REV. 819, 839-40 (1962).

<sup>57</sup> 17 U.S.C. § 301 (1982). An exhaustive treatment of the preemption issue is beyond the scope of this Note. For a detailed analysis, see Ausness, *supra* note 16, at 1012-25; Shipley, *supra* note 3, at 701-37; Note, *The Right of Publicity, Section 43(a) of the Lanham Act and Copyright Preemption: Preventing the Unauthorized Commercial Exploitation of Uncopyrighted Works of Art*, 2 CARDOZO ARTS & ENT. L.J. 265, 269-76 (1983).

<sup>58</sup> 17 U.S.C. § 106 (1982); see *supra* note 47.

<sup>59</sup> *Id.* § 301(a).

<sup>60</sup> *Id.* § 301(b)(1).

<sup>61</sup> *Id.* § 301(d).

<sup>62</sup> See, e.g., *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 717-18 (9th Cir. 1970) (unfair competition claim preempted), *cert. denied*, 402 U.S. 906 (1971); *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1238-41 (C.D. Cal. 1987) (1976 Act preempts state law claims for unfair competition, tortious interference, and right of publicity).

<sup>63</sup> 17 U.S.C. § 301(a), (b)(3) (1982).

<sup>64</sup> *Id.* § 301(b)(1).

<sup>65</sup> *Id.* § 301(d).

tection of his musical style or performance must allege an appropriate federal statutory claim, or alternatively, a state statutory or common law claim comprising rights that are not equivalent to those contained in section 106.<sup>66</sup>

In order for a state-derived claim to be preempted, it must involve a right that is equivalent to any of the rights found in section 106 and come within the subject matter of copyright as defined in sections 102 and 103.<sup>67</sup> In New York, state-derived actions for unfair competition, infringement of the right of publicity, misappropriation, defamation, and false advertising are scrutinized according to the "equivalency" test set forth in *Factors Etc., Inc. v. Pro Arts, Inc.*<sup>68</sup> If the act of reproduction, performance, or distribution will itself infringe the state-created right, then the state claim is preempted.<sup>69</sup> If other elements, however, are necessary for a state-created cause of action,<sup>70</sup> the claim escapes the "shadows of preemption."<sup>71</sup>

Courts utilizing this "equivalency" test have applied it with extremely disparate results.<sup>72</sup> As a practical matter, the success of

<sup>66</sup> See *supra* notes 63-65 and accompanying text. Section 301(a) states that "all legal or equitable rights that are equivalent to any of the exclusive rights . . . specified by section 106 . . . and come within the subject matter of copyright as specified by sections 102 and 103 . . . are governed exclusively by this title." 17 U.S.C. § 301(a) (1982) (emphasis added). However, section 301(a) is qualified by section 301(b), which states: "Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to— . . . activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright." *Id.* § 301(b)(3).

<sup>67</sup> See 2 J. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 10:30 (1980).

<sup>68</sup> 496 F. Supp. 1090, 1099 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982). The *Factors* court adopted the test proposed by Professor Nimmer to determine whether a right is "equivalent to" copyright. *Id.* at 1098-99; see 1 M. NIMMER & D. NIMMER, NIMMER ON COPYRIGHTS § 1.01 [B][1] (1988). Professor Nimmer maintains that the reference to section 106 and the rights contained therein is by way of identification, not limitation. *Id.* See generally *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1238-40 (C.D. Cal. 1987) (discussing preemption and adopting Nimmer test for equivalency); Ausness, *supra* note 16, at 1017-18 (preemption if act of reproduction, performance, distribution, or display infringes state right); Shipley, *supra* note 3, at 702 (two criteria for preemption concern nature of rights and nature of works).

<sup>69</sup> *Factors*, 496 F. Supp. at 1099; see 1 M. NIMMER & D. NIMMER, *supra* note 68, § 1.01[B], at 1-10.

<sup>70</sup> See *supra* note 69 and accompanying text.

<sup>71</sup> See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 717 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971).

<sup>72</sup> Compare *Motown Record*, 657 F. Supp. at 1238-41 (claims of unfair competition, intentional interference with prospective business advantage, misappropriation, and accounting for use of song and image preempted, but claim under Lanham Act not pre-

a particular state law claim becomes a function of the practitioner's ability to distinguish actionable conduct, the relief sought, and the individual elements composing the cause of action from those inherent in a copyright claim.<sup>73</sup> The issue is further obfuscated by the ambiguous legislative history accompanying section 301 of the Act<sup>74</sup> and the unresolved question of whether this section implicitly incorporates the subsisting common law related to preemption.<sup>75</sup> Preemption thus looms large above state-derived

empted) and *Mayer v. Josiah Wedgewood & Sons*, 601 F. Supp. 1523, 1531-36 (S.D.N.Y. 1985) (claim of conversion and misappropriation of jewelry design preempted) with *Gemveto Jewelry Co. v. Jeff Cooper, Inc.*, 613 F. Supp. 1052, 1063-64 (S.D.N.Y. 1985) (claim of unfair competition not preempted) and *Roy Export Co. v. Columbia Broadcasting Sys.*, 503 F. Supp. 1137, 1150-52 (S.D.N.Y. 1980) (claim under common law copyright and unfair competition not preempted).

<sup>73</sup> See generally *Ausness*, *supra* note 16, at 1018 (rendering arguments as to why actions based upon right of publicity, deception, misrepresentation, or passing off should not be preempted).

<sup>74</sup> See *Shipley*, *supra* note 3, at 704-05. The original version of section 301(b) included an illustrative list of state actions that would not be preempted, including the tort of misappropriation, which is substantially similar to and involves many of the same elements as copyright infringement. See 2 J. McCARTHY, *supra* note 67, § 10:30, at 412. A misleading Justice Department memo, which inaccurately characterized the Supreme Court as unwilling to apply the doctrine of misappropriation to claims falling outside the aegis of the Copyright Act, provided the impetus for removal of the list, resulting in the current wording of section 301(b). *Id.* When asked, however, whether the current wording would preclude recovery in states recognizing the tort of misappropriation, the sponsor of the amendment removing the list from the bill replied "no." *Id.*; see Note, *supra* note 57, at 274. Subsequent cases that have commented upon the legislative history of section 301 note that no adverse inference may be drawn from the elimination of the list. See, e.g., *Josiah Wedgewood*, 601 F. Supp. at 1533.

<sup>75</sup> Prior to the 1976 Act, the leading Supreme Court decisions delineating the scope of the preemption doctrine were *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964). In these cases, the Court acknowledged the conflict between state law protecting intellectual property and the federal policy permitting copying of whatever the federal patent and copyright statutes leave in the public domain. See *Shipley*, *supra* note 3, at 687. In both instances, the Court reversed lower court decisions that had extended state law protection under the rubric of unfair competition to articles that were unprotected under federal law. *Id.* The broad dicta in these decisions, which seemingly provided for complete federal preemption in the area of intellectual property, were subsequently narrowed by the Supreme Court. See *Goldstein v. California*, 412 U.S. 546, 571 (1973) (upholding California conviction of "record pirate" under state law that made "pirating" of sound recordings a criminal offense). At the time of the *Goldstein* decision, sound recordings were not copyrightable under the Copyright Act of 1909; the Court, however, determined that under the 1909 Act there was no congressional intent to foreclose state regulation of a category of writings unregulated by Congress, so long as there was no interference with federal copyright policy. *Id.* Since state regulation did not conflict with federal action, "total relinquishment of the States' power to grant copyright protection cannot be inferred." *Id.* at 559.

*Goldstein* was further modified by *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470

causes of action, posing a threshold obstacle to any potential claim for relief generated by a sound-alike.<sup>76</sup>

Federal statutory claims, on the other hand, such as those alleged under section 43(a) of the Lanham Act,<sup>77</sup> suffer from no such infirmity,<sup>78</sup> provided the performer can satisfy the requisite elements of a federal claim.<sup>79</sup> This factor provides Lanham Act claims<sup>80</sup> with a tremendous procedural advantage over comparable state law claims.<sup>81</sup> As a result, some of the most promising developments for a performer's cause of action against sound-alikes are ironically evolving from the field of trademark, not copyright, law.<sup>82</sup>

### RIGHT OF PUBLICITY

Right of publicity is a state statutory<sup>83</sup> or common law<sup>84</sup> cause of action in tort that derives from the right of privacy.<sup>85</sup> The action

(1974), which concluded that preemption of state law could occur where the state law "clashes with the objectives of the federal patent [and copyright] laws." *Id.* at 480 (quoting *Stiffel*, 376 U.S. at 231). The "clash of objectives" test was subsequently codified as the two part test under section 301(a) of the Copyright Act. See 1 M. NIMMER & D. NIMMER, *supra* note 68, § 1.01[B]; Note, *supra* note 57, at 274.

<sup>76</sup> See Shipley, *supra* note 3, at 706-09.

<sup>77</sup> 15 U.S.C. § 1125(a) (1982).

<sup>78</sup> See 17 U.S.C. § 301(d) (1982). Section 301(d) specifically indicates that nothing in section 301 is meant to annul or limit any rights or remedies conferred by any other federal statute. *Id.* Thus, any claim deriving from a federal statute will not be preempted by section 301. *Id.*

<sup>79</sup> See *infra* notes 186-90 and accompanying text.

<sup>80</sup> 15 U.S.C. §§ 1051-1127 (1982 & Supp. IV 1986).

<sup>81</sup> See, e.g., *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236 (C.D. Cal. 1987) (court granted summary judgment motion in favor of defendant on all but plaintiff's Lanham Act claim); Brown, *Copyright and Its Upstart Cousins: Privacy, Publicity, Unfair Competition: The Sixteenth Donald C. Brace Memorial Lecture*, 33 J. COPYRIGHT Soc'y of the U.S.A. 301, 309 (1986) (section 43(a) is the wild card).

<sup>82</sup> See, e.g., *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360 (S.D.N.Y. 1988) (performer's Lanham Act claim upheld); *Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985) (same).

<sup>83</sup> See Ausness, *supra* note 16, at 979-80. For discussions concerning the right of publicity, see Shipley, *supra* note 3, *passim*; Simon, *supra* note 16, at 699; Note, *supra* note 16, *passim*. As of 1982, seven states had enacted statutes protecting a right of privacy. See Ausness, *supra* note 16, at 979-80.

<sup>84</sup> See Ausness, *supra* note 16, at 979-80. As of 1982, thirty-six states had judicially recognized some form of privacy interest. *Id.* at 979 n.16.

<sup>85</sup> See Note, *supra* note 16, at 130. Prosser defined the right of privacy as comprising four separate actions for tortious invasion, including appropriation of the plaintiff's name or likeness. W. KEETON, D. DOBBS, R. KEETON & D. OWEN, PROSSER & KEETON ON TORTS § 817 (5th ed. 1984). The right of publicity has evolved from the criticism that these "privacy" interests do not adequately serve a performer's economically-based "publicity" interests.



evolved from the theory of appropriation,<sup>86</sup> and is analogous to copyright law in that it seeks to encourage creativity<sup>87</sup> by affording a performer protection for his creative interests.<sup>88</sup> Unlike copyright, however, a right of publicity extends the scope of protection to nonfixed, intangible aspects of persona, such as name,<sup>89</sup> likeness,<sup>90</sup> characterization,<sup>91</sup> performance,<sup>92</sup> and materials associated with a personality.<sup>93</sup> This extended protection for noncopyrightable interests creates considerable tension with the limited creative monopoly that authors possess under the 1976 Act.<sup>94</sup> Consequently, it has been noted that a right of publicity cause of action more closely resembles a trademark action.<sup>95</sup>

Whether the 1976 Act preempts a state-created right is an issue that figures prominently in any right of publicity action.<sup>96</sup> Un-

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Note, *supra* note 16, at 130-31; *see also* Ausness, *supra* note 16, at 979, 982 (right of privacy does not protect economic interests covered by right of publicity).

<sup>86</sup> *See* Ausness, *supra* note 16, at 979-81; Simon, *supra* note 16, at 701. The theory of appropriation differs from that of misappropriation. *See* Ausness, *supra* note 16, at 981 n.25. Appropriation refers to the invasion of one's right of privacy, whereas misappropriation is associated with claims involving unfair competition. *See id.* The appropriation theory is most often employed by celebrities seeking "to protect themselves from unauthorized exploitation by others." *Id.* at 981.

<sup>87</sup> *See* Simon, *supra* note 16, at 722.

<sup>88</sup> *See* Ausness, *supra* note 16, at 978; Shipley, *supra* note 3, at 682; Simon, *supra* note 16, at 722. Ausness identifies two separate interests at stake for the celebrity: a performance value, encompassing the economic demand for his performance, and the recognition value, which comports, to an extent, with business goodwill. Ausness, *supra* note 16, at 977. These distinct interests give rise to separate types of publicity claims. *Id.* at 989-94.

<sup>89</sup> *See supra* note 24.

<sup>90</sup> *See supra* note 26.

<sup>91</sup> *See supra* note 28; *see also* Lombardo v. Doyle Dane & Bernbach, Inc., 58 App. Div. 2d 620, 622, 396 N.Y.S.2d 661, 665 (2d Dep't 1977) (legitimate proprietary interest in public personality).

<sup>92</sup> *See, e.g.,* Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977) (human cannonball act protected from unauthorized appropriation).

<sup>93</sup> *See* Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981). Although *Russen* was based, in part, upon unfair competition and trademark infringement claims, the court indicated that New Jersey would recognize a right of publicity claim based upon the commercial exploitation of a live stage performance. *Id.* at 1361.

<sup>94</sup> *See* Simon, *supra* note 16, at 722-23; *see also* Brown, *supra* note 81, at 305 (exclusive rights exceeding copyright boundaries are "troublesome"); *cf.* 17 U.S.C. § 102(a), (b) (1982) (Act protects works in tangible medium but no such protection afforded ideas or processes embodied in such works).

<sup>95</sup> *See* Shipley, *supra* note 3, at 684 (both right of publicity and trademark causes of action stem from concept of public recognition).

<sup>96</sup> *See generally* Ausness, *supra* note 16, at 1012-25 (discussing state-created rights that are or are not preempted by Act); Shipley, *supra* note 3, at 676 ("the overriding objectives of federal copyright policy preempt the right to the extent that the right is defined as perpetual").

fortunately, the courts have not always been consistent in deciding whether copyright laws preempt publicity rights or derivative interests.<sup>97</sup> While a strong argument can and has been made for extending protection to intellectual products otherwise unprotected by copyright laws,<sup>98</sup> and while some courts have suggested that this evolving state law action is not preempted,<sup>99</sup> there is still considerable uncertainty as to whether an action based on a right of publicity may be preempted.<sup>100</sup> One commentator has suggested that a right of publicity action seeking to protect more than a performer's name or likeness is more apt to fall within the penumbra of preemption.<sup>101</sup> Right of publicity actions seeking to protect a privacy interest, on the other hand, are less susceptible to preemption than actions brought to vindicate an economic interest.<sup>102</sup> It is submitted, however, that dilution of a performer's "goodwill" through unauthorized endorsement arguably implicates interests<sup>103</sup> and elements<sup>104</sup> distinctive of the rights conferred by copyright and should therefore survive preemption.

A number of jurisdictions, including New York<sup>105</sup> and California,<sup>106</sup> have a statutorily-conferred right of publicity.<sup>107</sup> The New York statute<sup>108</sup> provides protection for "[a]ny person whose name, portrait or picture is used . . . for advertising purposes or for the purposes of trade without . . . written consent."<sup>109</sup> However, since the statute confers no protection to performers for unauthorized appropriation of vocal or musical style<sup>110</sup> and preempts the com-

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<sup>97</sup> Compare *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977) (no preemption of right of publicity) and *Price v. Hal Roach Studios*, 400 F. Supp. 836 (S.D.N.Y. 1975) (no preemption found) with *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970) (right of publicity preempted), *cert. denied*, 402 U.S. 906 (1971).

<sup>98</sup> See Shipley, *supra* note 3, at 681, 699, 700, 707.

<sup>99</sup> See *id.* at 706.

<sup>100</sup> See *id.* at 700. See generally Ausness, *supra* note 16, at 1012-13 (explaining relationship between rights of publicity and preemption).

<sup>101</sup> See Shipley, *supra* note 3, at 707.

<sup>102</sup> *Id.* at 719-20.

<sup>103</sup> *Id.* at 720-21.

<sup>104</sup> *Id.* at 721-22.

<sup>105</sup> See N.Y. CIV. RIGHTS LAW §§ 50, 51 (McKinney 1976 & Supp. 1989).

<sup>106</sup> See CAL. CIV. CODE § 3344 (Deering Supp. 1988).

<sup>107</sup> See *supra* note 83.

<sup>108</sup> N.Y. CIV. RIGHTS LAW § 51 (McKinney Supp. 1989).

<sup>109</sup> *Id.*

<sup>110</sup> See *Lombardo v. Doyle Dane & Bernbach, Inc.*, 58 App. Div. 2d 620, 621, 396 N.Y.S.2d 661, 663 (2d Dep't 1977) ("statute is not to be construed so as to generally prohibit the depiction or representation of the characteristics of the particular complainant").

mon law right of publicity in New York,<sup>111</sup> such unauthorized appropriation falls outside the scope of the statute's protections.<sup>112</sup>

The California statute, on the other hand, specifically extends protection to any unauthorized use of a "name, voice, signature, photograph, or likeness" for commercial purposes.<sup>113</sup> Recently, in *Midler*, the Ninth Circuit, in construing the scope of California's statutory right of publicity,<sup>114</sup> declined to extend the term "likeness" to include vocal imitations.<sup>115</sup> Instead, the court identified a common law publicity right<sup>116</sup> in the "distinctive voice of a professional singer [who] is widely known,"<sup>117</sup> and held that the appro-

<sup>111</sup> See *Stephano v. News Group Publications, Inc.*, 64 N.Y.2d 174, 183, 474 N.E.2d 580, 584, 485 N.Y.S.2d 220, 224 (1984). In *Stephano*, the New York Court of Appeals explained that "[s]ince the 'right of publicity' is encompassed under the Civil Rights Law as an aspect of the right of privacy, which . . . is exclusively statutory in this State, the plaintiff cannot claim an independent common-law right of publicity." *Id.*

<sup>112</sup> See N.Y. CIV. RIGHTS LAW §§ 50, 51 (McKinney 1976 & Supp. 1989) (only name, portrait, or picture protected); see also *Lahr v. Adell Chem. Co.*, 300 F.2d 256, 258 (1st Cir. 1962) (denying relief for vocal imitation under §§ 50 and 51 of New York Civil Rights Law); *Gardella v. Log Cabin Prods. Co.*, 89 F.2d 891, 894 (2d Cir. 1937) (same).

Recently, a bill has been introduced in the New York State Legislature rendering publicity rights fully transferable and descendible. Ironically, the bill extends protection for the unauthorized use of a "deceased personality's name, voice, signature, photograph or likeness, in any manner, including . . . any limitation, simulation or impersonation thereof." See N.Y.S. 6843, 211th Sess. (1988). Should the bill pass unaltered, it would confer a far more extensive right of publicity upon deceased celebrities than that currently enjoyed by living celebrities. It would, however, provide the representatives of deceased performers with a viable cause of action against the use of commercial sound-alikes. See *id.*

<sup>113</sup> CAL. CIV. CODE § 3344(a) (Deering Supp. 1988).

<sup>114</sup> *Id.* In California, unlike New York, common law protection against an invasion of privacy by the appropriation of a name, voice, signature, photograph, or likeness has been complemented, not codified, by its statutory analog. Compare *Eastwood v. Superior Court*, 149 Cal. App. 3d 409, 416, 198 Cal. Rptr. 342, 346 (1983) (invasion of privacy by appropriation "has been complemented legislatively") with *Stephano*, 64 N.Y.2d at 183, 474 N.E.2d at 584, 485 N.Y.S.2d at 224 (1984) (New York right of privacy is exclusively statutory). The California statute, in fact, explicitly notes that the remedies under this provision are merely "cumulative." CAL. CIV. CODE § 3344(g) (Deering Supp. 1988).

<sup>115</sup> *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988).

<sup>116</sup> *Id.* The court looked to California Civil Code section 990, California's companion statute to section 3344, which protects against the use of a deceased person's name, voice, signature, photograph, or likeness. Section 990(b) specifically indicates that the rights it recognizes are "property rights." CAL. CIV. CODE § 990 (Deering Supp. 1988). By analogy, the court found a common law "property right" in the attributes of one's identity by declaring that this property included the "distinctive voice of a [widely known] professional singer." See *Midler*, 849 F.2d at 463. The court then relied upon *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974), a right of publicity action, to find that appropriation of this "property right" constitutes an actionable tort in California. *Midler*, 849 F.2d at 463.

<sup>117</sup> *Midler*, 849 F.2d at 463.

priation of this right constituted an actionable tort.<sup>118</sup> It is submitted that, in light of the court's cursory treatment of the preemption issue,<sup>119</sup> it remains to be seen whether the decision will prove to be a harbinger of change or a shibboleth of California

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<sup>118</sup> *Id.* at 463-64.

<sup>119</sup> See *id.* at 463. The court briefly addressed the preemption issue in its attempt to distinguish, rather than overrule, *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970). See *Midler*, 849 F.2d at 462. The *Midler* court did not explicitly overrule *Sinatra*, noting that, in contrast to *Sinatra*, there was no unfair competition claim present. *Id.* Nonetheless, the court construed *Sinatra* to stand for the proposition that a performer "claiming a secondary meaning" in his or her rendition of a copyrighted composition will be preempted by federal copyright law because of the potential licensing conflicts that would arise. *Id.* The court distinguished *Midler's* claim as not seeking relief for Ford's use of the underlying composition, but rather, as seeking damages for the deliberate appropriation of a personality attribute—her voice—which was not preempted by the 1976 Copyright Act. See *supra* notes 57-71 and accompanying text (discussion of preemption under the 1976 Copyright Act). The *Midler* court also noted that "[a] voice is not copyrightable," since the sounds are not fixed and the statute clearly requires fixation in a tangible medium of expression. *Midler*, 849 F.2d at 462. It is submitted that this statement was conclusory for the three following reasons.

First, the court clearly failed to employ the test prescribed by section 301 of the Copyright Act for determining whether the cause of action should be preempted. Under this test, the court was required to determine whether the right created by the court was "equivalent to" copyright. See 17 U.S.C. § 301(b) (1982). Under the Nimmer test for equivalency, as set forth in *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982), the state claim is preempted if the act of reproduction, performance, or distribution infringes the right. See *supra* notes 68 & 69 and accompanying text. It is submitted that this analysis would have subjected this common law right of publicity to much tougher scrutiny than it received.

Second, the court, in stating that *Midler's* voice was not "fixed," failed to consider *Midler's* prior recorded version of "Do You Wanna Dance," which provided the basis for the sound-alike. Since *Midler's* voice had been recorded, the performance was fixed, strengthening the preemption argument.

Third, the court failed to address the policy concerns underlying the preemption doctrine—the federal policy of "allowing free access to copy whatever the federal patent and copyright laws leave in the public domain." *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964).

While the court's decision in *Midler* comported with the factual equities of the case, it is submitted that the legal underpinnings of the decision would have been on firmer ground with a more comprehensive analysis of the preemption issue. Additionally, uncertainty in this area is exacerbated by the fact that the vast majority of "victories" for performers to date have been procedural in nature. See, e.g., *Midler*, 849 F.2d at 464 (reversing summary judgment for defendant based on common law right of publicity); *Lahr v. Adell Chem. Co.*, 300 F.2d 256, 258-59, 260 (1st Cir. 1962) (reversing dismissal of complaint for failure to state cause of action based on possible defamation and unfair competition claims); *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1241 (C.D. Cal. 1987) (denying summary judgment motion based on potential Lanham Act claim); *Shaw v. Time-Life Records*, 38 N.Y.2d 201, 207-08, 341 N.E.2d 817, 820-21, 379 N.Y.S.2d 390, 395-96 (1975) (affirming denial of defendant's motion for summary judgment on plaintiff's unfair competition claim).

common law with respect to publicity rights.

### MISAPPROPRIATION

The tort of misappropriation<sup>120</sup> is similar in nature to a claim based on a right of publicity<sup>121</sup> as well as one based on unfair competition<sup>122</sup> with which it is often confused.<sup>123</sup> In New York, the cause of action for misappropriation has been expanded to encompass acts of "commercial immorality"<sup>124</sup> and to protect against "a defendant's competing use of a valuable product or idea created by the plaintiff through investment of time, effort, money and expertise."<sup>125</sup> Nonetheless, the cause of action often falls prey to the preemption doctrine<sup>126</sup> because of the "amorphous" nature of the elements constituting the claim.<sup>127</sup> The tort is predicated on a judicial recognition of a proprietary interest in a noncopyrightable creative effort,<sup>128</sup> and thus is ideally suited to sound-alike claims, although it has seldom been directly invoked.<sup>129</sup> But in identifying an analo-

<sup>120</sup> See generally Simon, *supra* note 16, at 724-25 (discussing origin of misappropriation action). The tort was first recognized in *International News Service v. Associated Press*, 248 U.S. 215 (1918). The term is to be distinguished from appropriation, which serves as a basis for the right of publicity. See Ausness, *supra* note 16, at 981 n.25. The gravamen of a misappropriation claim is the appropriation by a competitor of a quasi-proprietary right, often in a blatant manner. See Simon, *supra* note 16, at 724.

<sup>121</sup> See Ausness, *supra* note 16, at 986; Shipley, *supra* note 3, at 684.

<sup>122</sup> See *Universal City Studios v. T-Shirt Gallery, Ltd.*, 634 F. Supp. 1468, 1475-76 (S.D.N.Y. 1986); Ausness, *supra* note 16, at 986; Note, *supra* note 16, at 156-57.

<sup>123</sup> See *Universal City Studios*, 634 F. Supp. at 1475; Shipley, *supra* note 3, at 685.

<sup>124</sup> See *Standard & Poor's Corp. v. Commodity Exch., Inc.*, 683 F.2d 704, 710 (2d Cir. 1982); *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 796, 101 N.Y.S.2d 483, 492 (Sup. Ct. N.Y. County 1950), *aff'd*, 279 App. Div. 632, 107 N.Y.S.2d 795 (1st Dep't 1951).

<sup>125</sup> *Mayer v. Josiah Wedgewood & Sons*, 601 F. Supp. 1523, 1534 (S.D.N.Y. 1985). The tort has been described as "amorphous," and characterized as the taking of "the skill, expenditures and labors of a competitor" and "misappropriation for the commercial advantage of one person . . . a benefit or 'property' right belonging to another." *Standard & Poor's*, 683 F.2d at 710 (citation omitted).

<sup>126</sup> See, e.g., *Universal City Studios*, 634 F. Supp. at 1475 (preemption of plaintiff's claim of "misappropriation and reproduction of the style and characters of . . . television series into T-shirt form"); *Mayer*, 601 F. Supp. at 1535-36 (misappropriation claim preempted by federal law).

<sup>127</sup> See *Standard & Poor's*, 683 F.2d at 710; Simon, *supra* note 16, at 725.

<sup>128</sup> See *International News Serv. v. Associated Press*, 248 U.S. 215, 237-38 (1918).

<sup>129</sup> See, e.g., *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (no misappropriation claim, but claims for unfair competition and appropriation); *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970) (no misappropriation claim, although claim for unfair competition), *cert. denied*, 402 U.S. 906 (1971); *Lahr v. Adell Chem. Co.*, 300 F.2d 256 (1st Cir. 1962) (claims of invasion of privacy, unfair competition, and defamation); *cf.*

gous property right in a creation, a misappropriation claim most closely parallels those rights conferred by the copyright statute,<sup>130</sup> creating a preemption problem that may render misappropriation an untenable vehicle for relief.<sup>131</sup> While a majority of jurisdictions have determined that misappropriation claims are not preempted by the 1976 Act,<sup>132</sup> New York has nonetheless concluded otherwise.<sup>133</sup>

### UNFAIR COMPETITION

Unfair competition comprises a variety of actions for unfair and deceptive business practices,<sup>134</sup> including misappropriation,<sup>135</sup>

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Booth v. Colgate-Palmolive Co., 362 F. Supp. 343 (S.D.N.Y. 1973) (plaintiff's unfair competition claim based upon misappropriation of her performance—relief denied); Lennon v. Pulsebeat News, 143 U.S.P.Q. (BNA) 309, 309 (Sup. Ct. N.Y. County 1964) (plaintiffs, The Beatles, alleged utilization “for profit, without plaintiffs’ permission, their distinctive manner of speech and expression” in taped interviews—misappropriation claim recognized).

<sup>130</sup> See *Universal City Studios v. T-Shirt Gallery, Ltd.*, 634 F. Supp. 1468, 1476 (S.D.N.Y. 1986); *Mayer v. Josiah Wedgwood & Sons*, 601 F. Supp. 1523, 1535 (S.D.N.Y. 1985). Nonetheless, misappropriation might be said to differ from copyright in that there is an additional element of unfairness and an unjustifiable attempt to profit from another's labors. See *Roy Export Co. v. Columbia Broadcasting Sys.*, 503 F. Supp. 1137, 1151-52 (S.D.N.Y. 1980), *aff'd*, 672 F.2d 1095 (2d Cir.), *cert. denied*, 459 U.S. 826 (1982). In *Roy Export*, the district court observed that federal copyright law did not preempt an unfair competition claim, but cited the language of *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 796, 101 N.Y.S.2d 483, 492 (Sup. Ct. N.Y. County 1950), *aff'd*, 279 App. Div. 632, 107 N.Y.S.2d 795 (1st Dep't 1951), the seminal misappropriation case in New York. See *Roy Export*, 503 F. Supp. at 1151-52. The *Roy Export* court reasoned that the cause of action required the additional elements of unfairness and an unjustifiable attempt to profit from another's creation, thereby precluding preemption. *Id.* at 1152. In the alternative, the court noted that the creation in issue was not subject to federal copyright law, but rather, state copyright protection, which clearly did not preempt a state unfair competition claim. See *id.* On appeal, the Second Circuit expressly refused to consider the first rationale, and affirmed on the basis of this second ground. See 672 F.2d at 1099, 1104. *But cf. Universal City Studios*, 634 F. Supp. at 1475 (court refused to be constrained by *Roy Export* and concluded that commercial immorality or unfairness not sufficient additional element for preemption purposes). Additionally, this cause of action differs from an unfair competition claim in that relief is possible in a misappropriation action in the absence of fraud or deception. See *Simon*, *supra* note 16, at 726 (misappropriation action lacks unfair competition requirement of “passing off”); Note, *supra* note 45, at 585.

<sup>131</sup> See Note, *supra* note 45, at 586.

<sup>132</sup> See 2 J. MCCARTHY, *supra* note 67, § 10:30.

<sup>133</sup> See *Universal City Studios*, 634 F. Supp. at 1475-76; *Mayer*, 601 F. Supp. at 1535-36.

<sup>134</sup> See *Simon*, *supra* note 16, at 727. For a partial listing of some of the various actions protected against by unfair competition, see Note, *supra* note 45, at 580, 581 & n.61.

<sup>135</sup> See *Universal City Studios v. T-Shirt Gallery, Ltd.*, 634 F. Supp. 1468, 1474 (S.D.N.Y. 1986); Ausness, *supra* note 16, at 983.

"passing off,"<sup>136</sup> and trademark infringement.<sup>137</sup> The action evolved as a principle of equity, to provide relief for unscrupulous business practices resulting in confusion of goods as between prospective purchasers.<sup>138</sup> This cause of action has been the gravamen of the complaint in each of the leading sound-alike cases to date, with mixed results.<sup>139</sup> An action for unfair competition traditionally requires a showing of actual competition<sup>140</sup> as well as evidence that there was some deception or false representation to the public,<sup>141</sup> either as to the source of goods<sup>142</sup> or as to the plaintiff's endorsement or sponsorship of a product.<sup>143</sup> In the context of a sound-alike claim, the performer is alleging that the advertiser's deliberate imitation of a vocal or musical style was meant to inten-

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<sup>136</sup> See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 714 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971); Ausness, *supra* note 16, at 983. The tort of "passing off" or "palming off" consists of making false representations to the public as to the origin of the goods, with an intent to deceive. See Note, *supra* note 45, at 581-82. The standard is "whether the resemblance is so great as to deceive the ordinary consumer acting with the caution usually exercised in such transactions, so that he may mistake one for the other." *Id.* at 582 (citing W. PROSSER, HANDBOOK OF THE LAW OF TORTS § 130, at 957 (4th ed. 1971)). A prerequisite for a "palming off" claim is that the plaintiff must establish a trade name or symbol with which the public identifies his goods. *Id.* at 581. This may occur by producing evidence of a registered trademark, or evidence that the plaintiff's mark or symbol has acquired "secondary meaning." *Id.* at 581, 582.

<sup>137</sup> See Note, *supra* note 45, at 582.

<sup>138</sup> See Ausness, *supra* note 16, at 983.

<sup>139</sup> Compare *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) (unfair competition claim denied) and *Sinatra*, 435 F.2d at 714 (unfair competition claim preempted) and *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 346 (S.D.N.Y. 1973) (claim of unfair competition not established and probably preempted) with *Lahr v. Adell Chem. Co.*, 300 F.2d 256, 259 (1st Cir. 1962) (plaintiff's unfair competition claim states proper cause of action) and *Shaw v. Time-Life Records*, 38 N.Y.2d 201, 206, 341 N.E.2d 817, 820, 379 N.Y.S.2d 390, 395 (1975) (plaintiff made out valid unfair competition claim) and *Lombardo v. Doyle Dane & Bernbach, Inc.*, 58 App. Div. 2d 620, 622, 396 N.Y.S.2d 661, 664-65 (2d Dep't 1977) (plaintiff alleged sufficient facts to sustain claim of unfair competition).

<sup>140</sup> See Note, *supra* note 16, at 157. In the *Midler*, *Sinatra*, and *Booth* decisions, the absence of actual competition was an important factor in denying the respective performances protection against vocal imitations. See *Midler*, 849 F.2d at 462-63; *Sinatra*, 435 F.2d at 714; *Booth*, 362 F. Supp. at 346. The *Lahr* court recognized the facetious nature of the defendant's argument that there was no direct competition in noting: "True, it was not defendant's product that was offered in competition, but that of an anonymous imposter whom the defendant, for its benefit, subsidized. This is a distinction without a difference." *Lahr*, 300 F.2d at 259.

<sup>141</sup> Note, *supra* note 16, at 157.

<sup>142</sup> *Id.*; see also *Simon*, *supra* note 16, at 727 (unfair competition protects against passing off of product or service as plaintiff's, or linking plaintiff to same).

<sup>143</sup> See *Simon*, *supra* note 16, at 727. See generally *Brown*, *supra* note 81, at 305-06 (economic concern that imitator may benefit from investments of others is one factor explaining "eruption of rights").

tionally deceive<sup>144</sup> or is likely to deceive<sup>145</sup> the public as to the performer's endorsement, participation, or sponsorship of a product.<sup>146</sup> This deception or misrepresentation would, therefore, result in economic injury to the performer for the uncompensated appropriation of his "goodwill" and injury to the public from the ensuing confusion.<sup>147</sup>

The leading case denying an unfair competition claim arising from a sound-alike commercial is the Ninth Circuit's decision in *Sinatra v. Goodyear Tire & Rubber Co.*<sup>148</sup> In *Sinatra*, a failure to establish actual competition between the performer and the infringing advertiser was fatal to the performer's claim.<sup>149</sup> The deci-

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<sup>144</sup> See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 712 (9th Cir. 1970) (plaintiff alleged deceptive imitation of singing style, voice, and mannerisms), *cert. denied*, 402 U.S. 906 (1971).

<sup>145</sup> See *Lahr v. Adell Chem. Co.*, 300 F.2d 256, 259 (1st Cir. 1962) (plaintiff complaining of imitation causing mistake in identity); *Gardella v. Log Cabin Prods. Co.*, 89 F.2d 891, 895 (2d Cir. 1937) (trading upon another's reputation actionable, whether such "caused deception or was likely to do so"); *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 347 (S.D.N.Y. 1973) (plaintiff alleged defendants "were attempting to deceive the public into thinking that the plaintiff endorsed [the product]").

<sup>146</sup> See *Sinatra*, 435 F.2d at 712; *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1237 (C.D. Cal. 1987); Note, *supra* note 16, at 158.

<sup>147</sup> See Ausness, *supra* note 16, at 983; Comment, *supra* note 56, at 842.

<sup>148</sup> 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971).

<sup>149</sup> See *id.* at 714. In *Sinatra*, the Ninth Circuit upheld the granting of summary judgment against singer Nancy Sinatra and in favor of the Goodyear Tire & Rubber Company, which had purchased the rights to her song entitled "These Boots Are Made For Walkin'." *Id.* at 712, 718. The company had run a series of radio and television advertisements using the music with revised lyrics, sung by an unidentified woman who deliberately imitated Sinatra's voice and style. *Id.* at 712. The televised commercials also featured four women in high boots and "mod" clothing, the type of outfit in which Sinatra usually performed. *Id.* Sinatra claimed unfair competition alleging, in part, that the song and arrangement had acquired "secondary meaning" and that the imitations of the plaintiff's voice, mannerisms, and dress were for the purpose of deceiving the public into believing the plaintiff was a participant in the ads. *Id.*

The Ninth Circuit, in dismissing the claim, relied upon the statutory codification of an unfair competition claim contained within California Civil Code section 3369, holding that there was "no competition" between Sinatra and Goodyear. *Id.* at 714; see CAL. CIV. CODE § 3369 (Deering 1984). The court also found there was no "passing off" by the defendant of the plaintiff's products. *Sinatra*, 435 F.2d at 714.

The *Sinatra* court distinguished *Lahr v. Adell Chemical Co.*, 300 F.2d 256 (1st Cir. 1962), in which the First Circuit reinstated comedian Bert Lahr's claim for unfair competition for an imitation of his distinctive vocal style and delivery. *Id.* The court found a competitive interest when an advertiser hired an imitator who mimicked Lahr's distinctive voice, vocal sounds, and delivery in an advertisement involving a cartoon duck. *Id.* at 259. The court was careful to distinguish between imitation not meant to deceive and imitation intended to cause a mistake of identity. *Id.* The court found enough evidence of enhanced return to the defendant and intent to deceive to warrant a trial on the merits. *Id.* The court



sion is at odds with what has been characterized as a liberalizing trend respecting competition, wherein courts have permitted a mere showing of indirect competition to satisfy the requisite competition element of the cause of action.<sup>150</sup> In addition, the continued vitality of the decision is somewhat questionable given the recent *Midler* decision.<sup>151</sup>

A more severe stumbling block for sound-alike claims has been an unwillingness of the courts to readily find a deception or misrepresentation that misleads the public.<sup>152</sup> In so doing, these courts

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went on to note that "we might hesitate to say that an ordinary singer whose voice, deliberately or otherwise, sounded sufficiently like another to cause confusion was not free to do so." *Id.*

In *Sinatra*, the Ninth Circuit ignored the issue of Sinatra's lost potential revenues for the ad, focusing instead on the First Circuit's finding of a "uniqueness" in Lahr's voice, which had achieved a "secondary meaning." *Sinatra*, 435 F.2d at 716. The court declined to find any similarly distinctive element in Sinatra's sound. *Id.*

<sup>150</sup> See Ausness, *supra* note 16, at 983-84; Note, *supra* note 16, at 158; see also *Lahr*, 300 F.2d at 259 (while plaintiff not in direct competition with defendant, defendant's use of "imposter" actionable).

<sup>151</sup> See *supra* note 119 (discussing how *Midler* distinguished *Sinatra*). Nonetheless, the *Midler* court's characterization of the *Sinatra* case failed to recognize that Sinatra also alleged an intentional imitation of her voice and style to deceive the public as to her participation in the commercial. See *Midler*, 849 F.2d at 462; *Sinatra*, 435 F.2d at 712. Additionally the court noted that "[i]f *Midler* were claiming a secondary meaning to 'Do You Want To Dance' or seeking to prevent the defendants from using that song, she would fail like *Sinatra*." *Midler*, 849 F.2d at 462. Thus, it is submitted that the *Midler* court's attempt to distinguish the two cases has, in fact, vitiated the *Sinatra* holding by inaccurately characterizing the case as one based upon the use of a copyrighted song rather than a vocal imitation.

The *Midler* court also dismissed the singer's unfair competition claim by noting "we do not find unfair competition here. . . . *Midler* did not do television commercials. The defendants were not in competition with her." *Id.* at 462-63. But the unfair competition claim in the *Sinatra* decision was dismissed in large part because Sinatra and Goodyear were not competitors. See *Sinatra*, 435 F.2d at 714. Sinatra, in fact, had based part of her damages claim on the fact that she was deprived of the economic benefits of doing the commercial by the imitator, an indirect competitor. See *id.* at 713. This allegation was held insufficient to sustain her claim. *Id.* Ironically, the *Midler* court, in rejecting the unfair competition claim because *Midler* did not do commercials, opened the door to unfair competition claims by performers who do earn money from participating in commercials. It is further submitted that the *Midler* court has tacitly acknowledged that indirect, rather than direct, competition is the measure by which an unfair competition claim should be evaluated, thereby further undermining the *Sinatra* decision.

<sup>152</sup> See *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 349 (S.D.N.Y. 1973). In *Booth*, actress Shirley Booth brought an action alleging a deliberate imitation of her voice with respect to a character she had created. *Id.* at 344-45. The court declined to find unfair competition, in large part because the court characterized the defendants' appropriation of Booth's character as mere imitation, and nothing more, which was permissible. *Id.* at 345; see also *Davis v. Trans World Airlines*, 297 F. Supp. 1145 (C.D. Cal. 1969). The *Davis* court similarly declined to find any elements of unfair competition present. *Id.* at 1147. *Davis* involved a cause of action by The Fifth Dimension singing group claiming an unauthorized

have denied relief on the grounds that either no sufficient showing of unfair competition has been made,<sup>153</sup> or that the claim implicates rights sufficiently similar to copyright so as to be preempted.<sup>154</sup> This result is particularly ironic, if not indefensible,<sup>155</sup> when there is evidence of a deliberate intent to imitate for the sole purpose of "passing off" the sound-alike as the work of the imitated performer.<sup>156</sup>

In an unfair competition claim, the plaintiff must proffer evidence that the defendant's actions are likely to deceive the public as to the goods in question.<sup>157</sup> Proof of actual deception is not necessary, provided that the plaintiff can establish the "likelihood of confusion."<sup>158</sup> It is helpful to distinguish "passing off" or "palming off,"<sup>159</sup> in which there is confusion as to the origin of the goods,<sup>160</sup> from misrepresentation or misappropriation claims, in which there is confusion as to an individual's sponsorship of the goods.<sup>161</sup> In the former, the focus is injury to the public; in the latter, injury to the plaintiff.<sup>162</sup> Some statutory trademark remedies such as section 43(a) of the Lanham Act<sup>163</sup> and sections 133 and 368-d of New York's General Business Law,<sup>164</sup> may provide relief for performers whose endorsements have been misappropriated or misrepresented, and are therefore separately discussed.<sup>165</sup>

It is also important to note the distinction between mere imi-

imitation of its unique vocal sound by Trans World Airlines in a commercial. *Id.* The court found that imitation alone was insufficient and, citing the leading preemption cases, dismissed the action. *Id.* at 1147.

<sup>153</sup> See *Midler*, 849 F.2d at 462; *Booth*, 362 F. Supp. at 348; *Davis*, 297 F. Supp. at 1147.

<sup>154</sup> See *Sinatra*, 435 F.2d at 717-18; *Midler v. Ford Motor Co.*, No. CV 86-2683, slip. op. at 6 n.2 (C.D. Cal. Aug. 12, 1987), *rev'd*, 849 F.2d 460 (9th Cir. 1988); *Davis*, 297 F. Supp. at 1147.

<sup>155</sup> See *Shipley*, *supra* note 3, at 694-95; Note, *supra* note 16, at 158.

<sup>156</sup> See, e.g., *Sinatra*, 435 F.2d at 712 (evidence of deliberate intent); *Midler*, No. CV 86-2683, slip. op. at 8. The district court in *Midler* characterized the defendants' actions as "something like the approach of an average thief." *Id.*

<sup>157</sup> See *Ausness*, *supra* note 16, at 983; Note, *supra* note 45, at 581-82.

<sup>158</sup> See Note, *supra* note 45, at 582; Comment, *supra* note 56, at 842-43.

<sup>159</sup> See Note, *supra* note 45, at 581-82; see also *supra* note 136 (discussing "passing off").

<sup>160</sup> See Note, *supra* note 45, at 581-82; see also *Tiffany & Co. v. L'Argene Prods. Co.*, 67 Misc. 2d 384, 388, 324 N.Y.S.2d 326, 330 (Sup. Ct. N.Y. County 1971) (use by defendant of trademark tended to deceive public into believing product was that of plaintiff).

<sup>161</sup> See *Ausness*, *supra* note 16, at 983; *Simon*, *supra* note 16, at 727.

<sup>162</sup> See *Ausness*, *supra* note 16, at 983.

<sup>163</sup> 15 U.S.C. § 1125(a) (1982).

<sup>164</sup> N.Y. GEN. BUS. LAW §§ 133, 368-d (McKinney 1988, 1984).

<sup>165</sup> See *infra* notes 178-238 and accompanying text.

tation, and fraud or deception for the purpose of analyzing a sound-alike claim.<sup>166</sup> Where there is mere imitation of style, the public is ordinarily aware that the performance is a duplication or derivative expression of the original, and principles of "fair use"<sup>167</sup> permit the imitation as mimicry or parody.<sup>168</sup> Conversely, when fraud or deception is present, the public "is either intentionally deceived or there is a likelihood of deception,"<sup>169</sup> with a resultant interference with the performer's business opportunities.<sup>170</sup> In this latter situation, an action serves to protect a business rather than an artistic interest,<sup>171</sup> thus precluding application of the "fair use" doctrine.<sup>172</sup> It is submitted that courts deciding sound-alike claims to date have ignored this fundamental distinction by failing to recognize that unfair competition claims implicate rights non-equivalent to copyright, and *do* involve sufficient competitive interference to warrant relief.

While California courts have summarily dismissed unfair competition claims in sound-alike actions,<sup>173</sup> New York courts have been somewhat less hostile.<sup>174</sup> It should be noted, however, that

<sup>166</sup> See Note, *supra* note 45, at 582.

<sup>167</sup> See 17 U.S.C. § 107 (1982). The "fair use" doctrine derives from copyright law, and is a recognition of certain limited exceptions to an author's exclusive right to control publication. See 3 M. NIMMER & D. NIMMER, *supra* note 68, § 13.05. In particular, the doctrine of fair use recognizes that incidental copying, educational copying, criticism, comment, and news reporting performed without consent are specifically excepted from infringement actions. 17 U.S.C. § 107. The topic has been the subject of extensive litigation and discussion. See 3 M. NIMMER & D. NIMMER, *supra* note 68, § 13.05 (giving history and current statutory format of doctrine).

<sup>168</sup> See Note, *supra* note 45, at 582.

<sup>169</sup> *Id.*

<sup>170</sup> See *Lahr v. Adell Chem. Co.*, 300 F.2d 256, 259 (1st Cir. 1962) (plaintiff's potential market for commercials was reduced).

<sup>171</sup> See *Simon*, *supra* note 16, at 703-05.

<sup>172</sup> See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979). In *Dallas Cowboys Cheerleaders*, the court upheld plaintiff's contention that its cheerleading uniforms had achieved "secondary meaning," constituting a trademark or service symbol. *Id.* at 203-04. The defendants argued that the copyright doctrine of "fair use" should apply, permitting defendant to create a facsimile of the uniform and use it in a sexually-explicit film. *Id.* at 205-06. The United States Court of Appeals for the Second Circuit, however, rejected this contention. *Id.* at 205. The court speculated that it was unlikely that the fair use doctrine would ever be applicable in a trademark action. *Id.* at 206; see also 3 M. NIMMER & D. NIMMER, *supra* note 68, § 13.05[B] (if defendant's work adversely affects value of any of plaintiff's rights, "fair use" defense inappropriate).

<sup>173</sup> See *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988); *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971); *Davis v. Trans World Airlines*, 297 F. Supp. 1145 (C.D. Cal. 1969).

<sup>174</sup> See, e.g., *Shaw v. Time-Life Records*, 38 N.Y.2d 201, 341 N.E.2d 817, 379 N.Y.S.2d

with the exception of *Midler*, the leading sound-alike cases were decided prior to the passage of the 1976 Act, with its requisite preemption analysis,<sup>175</sup> and prior to the more liberal trends in unfair competition claims.<sup>176</sup> As a result, it is submitted that the denial of an unfair competition claim in *Midler* surreptitiously and improperly carried forward the common law preemption doctrine.<sup>177</sup> It is similarly submitted that the leading sound-alike decisions do not comport with the legal evolution of the concepts of "likelihood of confusion" and "competition," and have failed to acknowledge that these concepts represent distinct elements in an unfair competition claim that implicate nonequivalent rights with respect to copyright preemption. Unless and until these issues are addressed and appropriate corrections made, the precedent provided by the line of cases represented by *Sinatra* will continue to keep sound-alike claims based upon unfair competition buried within "the shadows of preemption."

#### TRADEMARK INFRINGEMENT

Trademark infringement actions, particularly actions brought

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390 (1975). In *Shaw*, the New York Court of Appeals affirmed the denial of a motion for summary judgment by a defendant record company which had imitated a "Swing-Era" bandleader's "sound." *Id.* at 207, 341 N.E.2d at 821, 379 N.Y.S.2d at 396. The court, while refusing to recognize a property interest in the Artie Shaw "sound," acknowledged a potentially valid unfair competition claim based on the allegations of consumer confusion regarding defendant's records and those of the plaintiff. *Id.* at 205-06, 341 N.E.2d at 820, 379 N.Y.S.2d at 394-95. *Shaw* apparently provides an opportunity for a remedy if a plaintiff-performer can establish consumer confusion or direct competition with the defendant's product. See Note, *supra* note 45, at 158; cf. *Lombardo v. Doyle Dane & Bernbach*, 58 App. Div. 2d 620, 396 N.Y.S.2d 661 (2d Dep't 1977). In *Lombardo*, big band leader Guy Lombardo sought protection from an advertisement featuring an actor conducting a band at a New Year's Eve party playing Lombardo's signatory, "Auld Lang Syne." *Id.* at 622-23, 396 N.Y.S.2d at 665 (Titone & Suozzi, J.J., dissenting). The suit was initiated after negotiations with Lombardo had fallen through. *Id.* The court declined to find a right of publicity violation based on the appropriation of Lombardo's likeness, but indicated that the imitation was "unfair" and amounted to a "deception of the public" that exploited the performer's "public personality." *Id.*

<sup>175</sup> See *supra* notes 56-82 and accompanying text.

<sup>176</sup> See *supra* note 150 and accompanying text.

<sup>177</sup> See *Midler*, 849 F.2d at 462. Although the *Midler* court did not specifically address whether a sound-alike claim based upon unfair competition was preempted by the Copyright Act of 1976, the court indicated that *Midler's* right of publicity claim was not preempted, and still declined to find unfair competition. See *id.* Thus, the court let stand the suggestion in *Sinatra* that an unfair competition claim in a sound-alike case would result in an inevitable "clash with federal law . . . if damages or injunctive remedies are available under state laws." *Sinatra*, 435 F.2d at 717.

pursuant to section 43(a) of the Lanham Act,<sup>178</sup> are the real "wild card"<sup>179</sup> for performers seeking to protect against commercial sound-alikes. Trademark laws satisfy the dual purpose of extending protection to the user of a mark for the value of the "goodwill" he has created, and protecting the public from confusion or deception.<sup>180</sup> Both the Lanham Act<sup>181</sup> and section 368-d of New York's General Business Law<sup>182</sup> are explicit examples of the codification and evolution of the common law of unfair competition.<sup>183</sup> The federal statutes and their subsequent interpretation by the courts have created a new "common law" of unfair competition in the federal courts that is arguably more advantageous to plaintiffs than the state versions.<sup>184</sup> The result of these developments is a cause of action in trademark that can provide celebrities with a degree of protection.<sup>185</sup>

### *Section 43(a) of the Lanham Act*

Section 43(a) of the Lanham Act<sup>186</sup> potentially affords artists trademark protection from appropriation of their persona, even in the absence of a registered mark.<sup>187</sup> The Lanham Act was designed

<sup>178</sup> 15 U.S.C. § 1125(a) (1982). Section 43(a) provides in pertinent part:

Any person who shall affix, apply, or annex, or use in connection with any goods or services . . . a false designation of origin, or any false description or representation . . . and shall cause such goods or services to enter into commerce . . . shall be liable to a civil action by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.

*Id.*

<sup>179</sup> Brown, *supra* note 81, at 309.

<sup>180</sup> Simon, *supra* note 16, at 734-35; *see* Allen v. National Video, Inc., 610 F. Supp. 612, 625-26 (S.D.N.Y. 1985). The *National Video* court notes that the Lanham Act's purpose is "the protection of consumers and competitors from a wide variety of misrepresentations of products and services in commerce. . . . The section [43(a)] is clearly remedial and should be broadly construed." *Id.* at 625 (quoting *Columbia Broadcasting Sys. v. Springboard Int'l Records*, 429 F. Supp. 563, 566 (S.D.N.Y. 1976)).

<sup>181</sup> 15 U.S.C. §§ 1051-1127 (1982 & Supp. IV 1986).

<sup>182</sup> N.Y. GEN. BUS. LAW § 368-d (McKinney 1984).

<sup>183</sup> *See* P.F. Cosmetique, S.A. v. Minnetonka, Inc., 605 F. Supp. 662, 672 (S.D.N.Y. 1985) ("distinctiveness" required under state anti-dilution statute may be evaluated in much same way as Lanham Act claim); Shipley, *supra* note 3, at 721; Simon, *supra* note 16, at 727.

<sup>184</sup> *See* Simon, *supra* note 16, at 727.

<sup>185</sup> *See id.* at 728; *see, e.g.*, Allen v. National Video, Inc., 610 F. Supp. 612 (S.D.N.Y. 1985) (actor sought relief against unauthorized use in ad of look-alike); Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981) (estate of deceased singer sought relief against Elvis impersonator).

<sup>186</sup> 15 U.S.C. § 1125(a) (1982); *see supra* note 178 (text of § 43(a)).

<sup>187</sup> *See, e.g.*, Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200,

to protect "consumers and competitors from a wide variety of misrepresentations of products and services in commerce,"<sup>188</sup> and has been extended to unfair, competitive practices resulting in actual or potential deception.<sup>189</sup>

In a Lanham Act claim under section 43(a), a plaintiff must establish: (1) a false designation of origin, false description, or misrepresentation (2) with respect to goods or services (3) involved in interstate commerce.<sup>190</sup> The federal courts have expanded the first element to encompass claims for the unauthorized use of a name or photograph in a manner suggesting the plaintiff has endorsed a product or service in interstate commerce.<sup>191</sup> Advertisements soliciting business for the advertiser have been adjudicated "goods and services," satisfying the second element.<sup>192</sup> In addition, a commercial advertisement will satisfy the third element if the goods are involved in interstate commerce.<sup>193</sup>

In general, the "misrepresentation" branch of section 43(a) of the Lanham Act has been expanded to permit claims for the unauthorized appropriation of a performer's publicity rights in advertising a product.<sup>194</sup> The United States District Court for the Southern District of New York has extended Lanham Act protection against a celebrity look-alike in *Allen v. National Video, Inc.*<sup>195</sup> In *National Video*, the court granted actor Woody Allen an injunction<sup>196</sup> against a print advertisement featuring an Allen look-alike on grounds that there was a likelihood of public confusion as to Allen's endorsement of the product.<sup>197</sup> The issue of Lanham Act relief for the unauthorized use of look-alikes in advertisements was

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203 n.3 (2d Cir. 1979) (plaintiff may prevail if establishes common law trademark or service mark, even in absence of registered mark); *National Video*, 610 F. Supp. at 625 (Lanham Act applicable to situations not formally qualifying as trademark infringement).

<sup>188</sup> *National Video*, 610 F. Supp. at 625.

<sup>189</sup> *See id.*

<sup>190</sup> *See id.*

<sup>191</sup> *See Cher v. Forum Int'l, Ltd.*, 213 U.S.P.Q. (BNA) 96, 102 (S.D. Cal.), *aff'd in part, rev'd in part, modified in part*, 692 F.2d 634 (9th Cir. 1982), *cert. denied*, 462 U.S. 1120 (1983); *Geisel v. Poynter Prods., Inc.*, 283 F. Supp. 261, 267 (S.D.N.Y. 1968).

<sup>192</sup> *See Allen v. National Video, Inc.*, 610 F. Supp. 612, 627 n.9 (S.D.N.Y. 1985).

<sup>193</sup> *Id.*

<sup>194</sup> *See, e.g., Cher*, 213 U.S.P.Q. (BNA) at 102 (performer's name and likeness actionable as false representation under § 43(a)); Note, *supra* note 57, at 284 (§ 43(a) can redress injury for false advertisement expressly or impliedly indicating endorsement).

<sup>195</sup> 610 F. Supp. 612 (S.D.N.Y. 1985).

<sup>196</sup> *Id.* at 632.

<sup>197</sup> *Id.* at 628.

recently readdressed in *Allen v. Men's World Outlet, Inc.*<sup>198</sup> with the same result. In the absence of a registered trademark, relief has been granted under section 43(a) where an author's creative result has acquired "secondary meaning," and is thus identifiable with the plaintiff.<sup>199</sup> In order to obtain injunctive relief under the Lanham Act the plaintiff need not establish actual confusion by the public as to the endorsement, but rather, merely that there is a "likelihood of confusion."<sup>200</sup> In addition, utilization of a disclaimer may not suffice to dispel the false impression created by the unauthorized use of a mark.<sup>201</sup>

The Lanham Act thus affords a performer a valid cause of action for the unauthorized appropriation of his persona, while protecting the public against deceptive advertising practices.<sup>202</sup> Fur-

<sup>198</sup> 679 F. Supp. 360 (S.D.N.Y. 1988).

<sup>199</sup> See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 203 n.5 (2d Cir. 1979). "Secondary meaning is '[t]he power of a name or other configuration to symbolize a particular business, product or company.'" *Id.* (quoting *Ideal Toy Corp. v. Kenner Prods. Div.*, 443 F. Supp. 291, 305 n.14 (S.D.N.Y. 1977)). The secondary meaning requirement is based on the rationale that there cannot be confusion of origin or damage to the "trademark user" if the public does not associate the creative product (*i.e.*, voice) with the particular plaintiff. See generally Note, *supra* note 57, at 284 (modification by disclosure sufficient to defeat § 43(a) claim where public was not deceived as to endorsement of product).

<sup>200</sup> See 15 U.S.C. § 1114 (1982). Under section 32 of the Lanham Act, injunctive relief is appropriate for violation of any right conferred under the other sections of the Act. *Id.* The public need not actually believe that the plaintiff-performer actually endorsed the product, although evidence of actual confusion is probative of the issue. See *Dallas Cowboys Cheerleaders*, 604 F.2d at 205. The plaintiff need only establish association resulting in "a tendency to impugn [plaintiff's services] and injure plaintiff's business reputation.'" *Id.* (quoting *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1189 (E.D.N.Y. 1972)).

"Likelihood of confusion" is determined within the Second Circuit in accordance with six factors suggested in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492, 495 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961), and enunciated in *Standard & Poor's Corp. v. Commodity Exchange, Inc.*, 683 F.2d 704, 708 (2d Cir. 1982). The factors include: "(1) the strength of the plaintiff's marks and name; (2) the similarity of plaintiff's and defendant's marks; (3) the proximity of plaintiff's and defendant's products; (4) evidence of actual confusion as to source or sponsorship; (5) sophistication of the defendant's audience; and (6) defendant's good or bad faith." *National Video*, 610 F. Supp. at 627. See generally 1A R. CALLMAN, *THE LAW OF UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* § 5.04 (4th ed. 1981) (for injunctive relief, mere likelihood of deception will suffice; in action for damages, actual injury must be shown).

<sup>201</sup> See *Home Box Office, Inc. v. Showtime/The Movie Channel*, 832 F.2d 1311, 1317 (2d Cir. 1987); *National Video*, 610 F. Supp. at 629; Note, *supra* note 57, at 284-85; Comment, *Injunctive Relief for Trademark Infringement—The Second Circuit Misses the Mark: Home Box Office v. Showtime/The Movie Channel*, 62 ST. JOHN'S L. REV. 286, 290, 298 (1988).

<sup>202</sup> See *National Video*, 610 F. Supp. at 625-26. While it must be noted that application of the Lanham Act is limited to those situations with economic interests analogous to those

thermore, it has been suggested that a plaintiff suing under the Lanham Act has an advantage in that the element of actual competition need not be established, unlike a traditional unfair competition claim.<sup>203</sup> Another benefit vests by virtue of the fact that Lanham Act actions are expressly excepted from the copyright preemption doctrine.<sup>204</sup> It remains to be seen, however, whether a Lanham Act claim to protect a performer's musical style that implicates rights similar to copyright will withstand preemption arguments.<sup>205</sup> It is important to note that in a trademark claim, "the plaintiff does not assert exclusive rights to the sale of a product but merely to a mark indicating its origin or sponsorship."<sup>206</sup> Similarly, in a Lanham Act claim, the essence of the grievance is not just imitation, but a "passing off" by the defendant.<sup>207</sup>

The only New York case to have addressed application of the Lanham Act to a sound-alike claim is *Booth v. Colgate-Palmolive Co.*<sup>208</sup> In *Booth*, the court denied a Lanham Act claim based on an advertisement containing a vocal sound-alike of the plaintiff, actress Shirley Booth.<sup>209</sup> In denying the claim, the court stated there was no indication the plaintiff's voice had been used in conjunction with any "goods or services"; that her voice alone could not serve

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protected by trademark laws, the *National Video* court noted that:

A celebrity has a similar commercial investment in the "drawing power" of his or her name and face in endorsing products and in marketing a career. The celebrity's investment depends upon the good will of the public, and infringement of the celebrity's rights also implicates the public's interest in being free from deception when it relies on a public figure's endorsement in an advertisement.

*Id.*

<sup>203</sup> See Simon, *supra* note 16, at 729-31.

<sup>204</sup> See 17 U.S.C. § 301(d) (1982). After setting forth the preemption doctrine in section 301(a), the Copyright Act of 1976 then goes on to create express exceptions from preemption. *Id.* Section 301(d) states: "Nothing in this title annuls or limits any rights or remedies under any other Federal statute." *Id.*

<sup>205</sup> See, e.g., *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204 (2d Cir. 1979). The defendant in *Dallas Cowboys Cheerleaders* had raised a preemption defense to the plaintiff's trademark action. See *id.* (discussing *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964)). The court did not cite section 301(d), but noted that preemption did not apply in a trademark action, where the gravamen of the claim is not the exclusive right to the sale of a product, but to a mark indicating origin or sponsorship. *Id.* A question thus remains as to whether a sound-alike claim brought under section 43(a) of the Lanham Act, which implicates rights more closely related to copyright, might be preempted.

<sup>206</sup> *Dallas Cowboys Cheerleaders*, 604 F.2d at 204.

<sup>207</sup> See *Allen v. National Video, Inc.*, 610 F. Supp. 612, 630 (S.D.N.Y. 1985).

<sup>208</sup> 362 F. Supp. 343 (S.D.N.Y. 1973).

<sup>209</sup> See *id.* at 348-49.



as a trademark; and that the plaintiff-actress and defendant-manufacturer were not in competition.<sup>210</sup> Subsequent Lanham Act decisions have vitiated both the "goods or services"<sup>211</sup> and the "competition" requirements<sup>212</sup> leaving the argument that a voice alone may not serve as a trademark. It is submitted that the same rationale invoked by the *National Video* court to extend protection in look-alike actions is apposite to sound-alike claims, namely protecting the artist's "goodwill" investment in his or her persona<sup>213</sup> and the public's right to be free from deception.<sup>214</sup> It is further submitted that affording protection to an actor for the "goodwill" interest in his face while denying a musician similar protection for his voice or musical styling is inequitable. Likelihood of confusion should be the dispositive issue, not choice of artistic medium.

Two California decisions have addressed the application of the Lanham Act to sound-alike claims, with opposite results.<sup>215</sup> In *Midler*, the district court cursorily addressed a potential Lanham Act claim in dicta, indicating only that it was "quite unlikely that the . . . Act . . . would offer the plaintiff any aid at all."<sup>216</sup> In *Motown Record Corp. v. George A. Hormel & Co.*,<sup>217</sup> the United States District Court for the Central District of California held that the plaintiff had stated a claim sufficient to defeat a motion for judgment on the pleadings against the plaintiff's Lanham Act claim, which had alleged a protectible interest in the persona of "The Supremes."<sup>218</sup> In so doing, the court opened the door for the

<sup>210</sup> *Id.* at 349.

<sup>211</sup> See *National Video*, 610 F. Supp. at 627 n.9; see also *Matsushita Elec. Corp. v. Solar Sound Sys.*, 381 F. Supp. 64, 69 (S.D.N.Y. 1974) (solicitation of sales is "commerce" within proscription of § 43(a)).

<sup>212</sup> See *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360, 368 (S.D.N.Y. 1988); see also *Mortellito v. Nina of Cal., Inc.*, 335 F. Supp. 1288, 1294 (S.D.N.Y. 1972) (false representation violative of § 43(a) even in absence of direct competition).

<sup>213</sup> See *Allen v. National Video, Inc.*, 610 F. Supp. 612, 625-26 (S.D.N.Y. 1985).

<sup>214</sup> *Id.*

<sup>215</sup> See *Midler v. Ford Motor Co.*, No. CV 86-2683, slip op. (C.D. Cal. Aug. 12, 1987) (dicta), *rev'd on other grounds*, 849 F.2d 460 (9th Cir. 1988); *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236 (C.D. Cal. 1987).

<sup>216</sup> Transcript at 10, *Midler v. Ford Motor Co.*, No. CV 86-2683 (C.D. Cal. July 13, 1987) (hearing on motion for summary judgment) (Fernandez, J.), *incorporated in final judgment*, No. CV 86-2683, slip op. at 9 (C.D. Cal. Aug. 12, 1987), *rev'd on other grounds*, 849 F.2d 460 (9th Cir. 1988). On May 18, 1987, the District Court denied as untimely plaintiff's motion for leave to amend to allege a section 43(a) claim. No. CV 86-2683, slip op. at 5 (C.D. Cal. Aug. 12, 1987). On appeal, the Ninth Circuit did not address the issue. See *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

<sup>217</sup> 657 F. Supp. 1236 (C.D. Cal. 1987).

<sup>218</sup> *Id.* at 1241.

plaintiff to establish a valid Lanham Act claim for a sound-alike.<sup>219</sup> It is thus submitted that any bar to the application of the Lanham Act in sound-alike claims which is predicated on New York or California case law is legally untenable. It is further suggested that Lanham Act decisions extending the scope of protection to a celebrity's face or likeness provide strong, analogous arguments for the extension of protection to a voice or musical style.

*New York General Business Law Sections 368-d and 133*

New York's state law analog to section 43(a) of the Lanham Act is contained in sections 368-d and 133 of the New York General Business Law.<sup>220</sup> Section 368-d is an anti-dilution statute aimed at protecting the distinctiveness of a particular mark.<sup>221</sup> Like section 43(a), section 368-d is applicable in the case of a misleading endorsement or sponsorship of a product.<sup>222</sup> Unlike section 43(a), however, the plaintiff must establish the distinctiveness of the particular mark by demonstrating that the mark is unique.<sup>223</sup> A mere showing of the likelihood of public confusion is not enough to maintain a section 368-d action.<sup>224</sup> Upon the demonstration of distinctiveness, the plaintiff must next establish the likelihood of dilution.<sup>225</sup> Thus, while the *Men's World Outlet* court upheld actor Woody Allen's section 43(a) claim upon finding a likelihood of confusion,<sup>226</sup> the court rejected Allen's section 368-d claim, citing both his failure to establish that his likeness was distinctive or had acquired secondary meaning, and his failure to establish that there was a likelihood of dilution.<sup>227</sup> A performer presenting a sound-

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<sup>219</sup> *Id.*

<sup>220</sup> N.Y. GEN. BUS. LAW §§ 133, 368-d (McKinney 1988, 1984).

<sup>221</sup> *See Dreyfus Fund Inc. v. Royal Bank of Can.*, 525 F. Supp. 1108, 1125 (S.D.N.Y. 1981); *see also O'Henry's Film Works, Inc. v. Nabisco, Inc.*, 112 App. Div. 2d 825, 825, 492 N.Y.S.2d 744, 745 (1st Dep't 1985) (complaint alleging distinctive musical signature and dilution of its distinctive quality sufficient as matter of law).

<sup>222</sup> *See, e.g., Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360, 360-65 (S.D.N.Y. 1988) (action exists irrespective of whether mark was used for endorsements or directly appropriated).

<sup>223</sup> *See Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621, 625 (2d Cir. 1983); *see also Little India Stores, Inc. v. Singh*, 101 App. Div. 2d 727, 728, 475 N.Y.S.2d 38, 40 (1st Dep't 1984) (to warrant protection under § 368-d, plaintiff's mark must have distinctive quality or have acquired secondary meaning capable of dilution).

<sup>224</sup> *See infra* note 227.

<sup>225</sup> *See Sally Gee*, 699 F.2d at 625.

<sup>226</sup> *See Men's World Outlet*, 679 F. Supp. at 370.

<sup>227</sup> *See id.* at 365-67. The court disagreed with Allen's contention that his face had

alike claim utilizing section 368-d, therefore, has a much higher evidentiary burden of proof.<sup>228</sup> Where, however, the performer has a distinctive "musical signature" and a commercial sound-alike would likely result in a dilution of that mark, relief under section 368-d might be appropriate.<sup>229</sup>

Section 133 of the New York General Business Law protects against the intentional deception of the public by the use of a "name, designation or style, or any symbol or simulation thereof" to deceive as to the identity of the plaintiff or the connection of the plaintiff to the defendant's company.<sup>230</sup> Section 133 is derived from the penal law<sup>231</sup> and requires the element of scienter.<sup>232</sup> Thus, the plaintiff must establish both the likelihood that the public would be misled by the improper use,<sup>233</sup> as well as an intent to deceive the public.<sup>234</sup> Violation of section 133 is a misdemeanor.<sup>235</sup> Injunctive relief may be granted in the absence of actual confusion.<sup>236</sup> Certain elements in the action, such as intent, must be es-

acquired secondary meaning by virtue of his work, and similarly disagreed with his argument that his face could qualify for protection, either because of its distinctive quality, or because it had acquired secondary meaning capable of dilution. *Id.* at 366. The court indicated that likelihood of dilution of the distinctive quality of a mark or of dilution of its "secondary meaning" would warrant injunctive relief even in the absence of competition between the parties, or in the absence of confusion as to the source of the goods or services. *Id.* at 365 n.8. However, the court found that Allen had failed to adduce evidence that his likeness had acquired secondary meaning. *Id.* at 366. Similarly, the court found that Allen had not made a sufficient showing of likelihood of dilution, which would have required a showing that the similarity between his likeness and that of the look-alike was likely to "blur" his "product identification." *Id.* at 367 n.13.

<sup>228</sup> See *supra* notes 222-27 and accompanying text.

<sup>229</sup> See *O'Henry's Film Works, Inc. v. Nabisco, Inc.*, 112 App. Div. 2d 825, 825-26, 492 N.Y.S.2d 744, 745 (1st Dep't 1985).

<sup>230</sup> N.Y. GEN. BUS. LAW § 133 (McKinney 1988). The statute provides in part:

No person . . . shall, with intent to deceive or mislead the public . . . use as . . . a corporate, assumed or trade name, for advertising purposes . . . any name, designation or style, or any symbol or simulation thereof . . . which may deceive or mislead the public as to the identity of such person . . . or as to the connection of such person . . . with any other person, firm or corporation . . .

*Id.*

<sup>231</sup> *Dunkin' Donuts of Am., Inc. v. Dunkin Donuts, Inc.*, 8 App. Div. 2d 228, 230, 188 N.Y.S.2d 132, 135 (3d Dep't 1959); see *Continental Corrugated Container Corp. v. Continental Group*, 462 F. Supp. 200, 206 (S.D.N.Y. 1978).

<sup>232</sup> See *Continental Corrugated*, 462 F. Supp. at 206.

<sup>233</sup> See *Van Curler Broadcasting Corp. v. Fairview Broadcasters, Inc.*, 32 Misc. 2d 1064, 1066, 225 N.Y.S.2d 624, 626 (Sup. Ct. Albany County 1962).

<sup>234</sup> See *Continental Corrugated*, 462 F. Supp. at 206.

<sup>235</sup> N.Y. GEN. BUS. LAW § 133 (McKinney 1988).

<sup>236</sup> See *Varsity House, Inc. v. Varsity House, Inc.*, 377 F. Supp. 1386, 1388 (E.D.N.Y. 1974). The statute specifically permits injunctive relief whenever there is actual or

established by clear and convincing evidence.<sup>237</sup> As a practical matter, relief will only be forthcoming under section 133 in the situation where the defendant's actions unequivocally indicate an intent to deceive, thus rendering the cause of action less accessible to many sound-alike plaintiffs.<sup>238</sup>

Nonetheless, it is suggested that sections 133 and 368-d do at least provide a theoretically viable cause of action for the performer who can establish a sufficiently distinct style which is likely to result in consumer confusion, and in the case of section 133, which has been misappropriated with the deliberate intent to deceive.

### CONCLUSIONS AND RECOMMENDATIONS

The advertising and popular music industries are inextricably interwoven to the point where few artists can afford to pursue their careers in popular music without some form of commercial subsidization. To date, the judicial system has declined to extend protection to performers against the use of commercial sound-alikes by advertisers with the recent exception of *Midler*. Irrespective of the adequacy of the legal reasoning underpinning the *Midler* decision, the change in policy considerations that shaped earlier adjudications of the issue and the evolving economic exigencies of today's music industry compel a reevaluation. It is submitted that changes in the preemption doctrine, as well as judicial expansion in the areas of trademark law and unfair competition, render the reasoning contained in many of these earlier cases suspect.

For the performer, the issue of sound-alikes comprises two distinct elements—control and compensation.<sup>239</sup> At present, the performer is afforded neither. One of the proffered explanations is that policing sound-alike claims would be difficult.<sup>240</sup> It is submitted that a court, in recognizing a claim against sound-alikes, would face no greater a challenge than it already accepts in resolving

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threatened violation of the statute. See N.Y. GEN. BUS. LAW § 133 (McKinney 1988).

<sup>237</sup> See *Kleinhans Co. v. Kleinhans' Cleaners, Inc.*, 5 Misc. 2d 1077, 1079, 162 N.Y.S.2d 250, 252 (Sup. Ct. Erie County 1957).

<sup>238</sup> See *supra* notes 230-37 and accompanying text.

<sup>239</sup> See generally Note, *supra* note 16, at 132-33 (unauthorized use violates right to control and to profit from performance); Comment, *supra* note 56, at 819-20 (performers should be able to capitalize on commercial value; contract delineates performer's control).

<sup>240</sup> See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 717-18 (9th Cir. 1970) (difficulties in policing performance create nearly impossible court supervisory problems), *cert. denied*, 402 U.S. 906 (1971).

questions of copyright infringement or trademark appropriation. To deny an entire class of plaintiffs relief on the basis that the boundaries of the action may not be pellucid seems disingenuous.

In recognition of the tremendous volume of commercial music produced and utilized, and the need for the advertising industry to proceed unencumbered by litigation or judicial restraints, it is submitted that some form of compulsory license, wherein the performer would be compensated for the unauthorized use of his voice or musical style, might provide a suitable statutory compromise for both performers and advertisers. An advertiser could, in lieu of obtaining an artist's endorsement or sponsorship, pay a predetermined fee for the right to imitate the artist's distinctive vocal or musical style. After payment of the fee, a compulsory authorization would issue, wherein the commercial sound-alike would be permitted to air for a certain duration over a predetermined geographical area. While artists would still be relinquishing control over their publicity rights, they would at least receive some form of compensation for the appropriation of their "goodwill" by an advertiser. The advertiser would, in turn, be paying something for the until-recently unfettered right to capitalize on the performer's "goodwill." In the event of a contested advertisement where no license was sought or received, relief could be granted by the courts upon a determination that there is a "likelihood of confusion" as to the performer's endorsement of the product or sponsorship of the commercial. Interestingly, this compulsory license scheme would have been of no assistance in a situation similar to *Midler* where, it is submitted, control, not compensation, was at issue.

Performers work many years to develop a "sound" or a "style," often at tremendous personal expense and financial peril. A performer's ability to develop his or her unique sound is often a predicate to a successful recording career. A successful performer's musical signature or style is often as unique and recognizable as a face, a name, or a character, all of which are today afforded some degree of protection. It is submitted that the *Midler* decision represents a step in the right direction since it recognized a protectible interest in a performer's distinctive musical style. Additional protections, however, should be afforded performers, lest a vital economic lifeline to the musical community be jeopardized. To most, a world without music would be unthinkable, but until performers are able to fully enjoy the commercial fruit of their mu-

sical labors, a world without musicians remains a very distinct possibility.

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