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COMMENTS

THE IMPLICATIONS OF *WARREN & BRANDEIS v. FRITO-LAY* FOR ADVERTISERS WHO USE CELEBRITY SOUND-ALIKES

The Right to Privacy,¹ one of the classics of legal scholarship,² focused in part on an increased intrusion of the print media into private life.³ It examined the protections available to private individuals who were subjected to the "mental pain and distress"⁴ of

¹ Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890). The authors reviewed cases that appeared to protect a person's "right 'to be let alone,'" *id.* at 195 n.4 (quoting COOLEY ON TORTS 229 (2d ed. 1888)), and concluded that a broader right to privacy merited common law recognition. *Id.* at 196. Warren and Brandeis went on to state that the right to avert public exposure, "to protect one's self from . . . a discussion by the press of one's private affairs, would be . . . [an] important and far-reaching one." *Id.* at 213. For a discussion of the historical development of the right to privacy before the Warren & Brandeis article, see SAMUEL M. HOFSTADTER & GEORGE MOROWITZ, *THE RIGHT OF PRIVACY* §§ 2.1-5 (1964).

² William L. Prosser, *Privacy*, 48 CAL. L. REV. 383, 383 (1960). Dean Prosser called the article "the outstanding example of the influence of legal periodicals upon the American Law." *Id.* The work has also been described as the "article which launched a tort." Edward J. Bloustein, *Privacy, Tort Law, and the Constitution: Is Warren and Brandeis' Tort Petty and Unconstitutional as Well?*, 46 TEX. L. REV. 611, 612 (1968).

³ Warren & Brandeis, *supra* note 1, at 196. The right of privacy was first articulated in 1890 due to concerns about the media "overstepping in every direction the obvious bounds of propriety and of decency." *Id.* Warren and Brandeis warned that newspapers had the potential to "belittle[] and pervert[] . . . the thoughts and aspirations of a people." *Id.* They were primarily concerned with the growing prominence of gossip, *id.* at 195, and believed that the print media had "invaded the sacred precincts of private and domestic life . . . and threaten[ed] to make good the prediction that 'what is whispered in the closet shall be proclaimed from the house-tops.'" *Id.* at 195.

For a thorough and well-researched discussion of the background and context of the article, see Dorothy J. Glancy, *The Invention of the Right to Privacy*, 21 ARIZ. L. REV. 1 (1979). In her commentary, Professor Glancy corrects many of the myths surrounding the publication of the article. *Id.*; see also Prosser, *supra* note 2, at 383-84 (examining Warren and Brandeis' motivations to write article).

⁴ Warren & Brandeis, *supra* note 1, at 196.

what was characterized as an "evil" invasion of privacy.⁵ As the law developed,⁶ however, the privacy rights of public figures⁷ and celebrities diminished.⁸ Under the right of privacy as it evolved, average citizens could prevent their likenesses from being used commercially,⁹ but public figures, such as a football player actively seeking press coverage, could not.¹⁰ To correct this inequity, the courts have developed a separate privacy right,¹¹ the

⁵ Warren & Brandeis, *supra* note 1, at 195.

⁶ For a discussion on the development of the tort right to privacy, see W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 117, at 849 (5th ed. 1984). This material traces the development of the right to privacy from Warren and Brandeis' article through modern common law applications. *Id.*

The modern law of privacy comprises "four distinct kinds of invasion of four different interests of the plaintiff." *Id.* at 851. These interests are linked only by the plaintiff's "right to be let alone." *Id.* Dean Prosser first published this four part model in 1960. See Prosser, *supra* note 2, at 389. Prosser described the invasions upon the right of privacy as: "(1) Intrusion upon the plaintiff's seclusion or solitude . . . (2) Public disclosure of embarrassing private facts . . . (3) Publicity which places the plaintiff in a false light . . . (4) Appropriation, for the defendant's advantage, of the plaintiff's name or likeness." *Id.*

⁷ See Prosser, *supra* note 2, at 410. Prosser defined a public figure or celebrity as "one who by his own voluntary efforts has succeeded in placing himself in the public eye." *Id.*; W. PAGE KEETON ET AL., *supra* note 6, at 851-66 (5th ed. 1984) (expanding public figure definition to include "anyone who has arrived at a position where public attention is focused upon him as a person"); see also MICHAEL F. MAYER, RIGHTS OF PRIVACY 193-94 (1972) (noting increasing recognition of individuals as public figures). "Accused murderers, witnesses to crime . . . and mere individuals with strong opinions also share the [public figure] limelight." *Id.* at 193.

⁸ See Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954). "[A]lthough the well known personality does not wish to hide his light under a bushel of privacy, neither does he wish to have his name, photograph and likeness reproduced and publicized without his consent or without remuneration to him." *Id.* at 204. Similarly, Warren and Brandeis implied that even public figures should be entitled to a right of privacy, at least to the extent that the matter has no relation to their public capacity. See Warren & Brandeis, *supra* note 1, at 215.

⁹ See *Beverly v. Choices Women's Medical Ctr., Inc.*, 587 N.E.2d 275 (N.Y. 1991). In *Beverly*, the court held that the plaintiff, a physician, could prevent her likeness from being used in a calendar that was distributed by a non-profit family-planning organization. The court found that the calendar qualified as an advertisement under N.Y. CIV. RIGHTS LAW § 51 (Consol. 1982) and therefore the organization had to receive the plaintiff's consent in order to avoid liability for invasion of privacy. 587 N.E.2d at 276.

¹⁰ See *O'Brien v. Pabst Sales Co.*, 124 F.2d 167, 168 (5th Cir.) (holding that college football player's right of privacy was waived when he put himself in public eye), *cert. denied*, 315 U.S. 823 (1941).

¹¹ See J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 28.01 [3] 28-7 (3d ed. 1992). The right of privacy protects against invasions of self-esteem, whereas the right of publicity protects against commercial loss. *Id.* "[P]rivacy is a personal and mental right, publicity is a commercial and business right." *Id.* at 28-8. A state's interest in granting a separate right of publicity lies in protecting the indi-

“right of publicity,”¹² which allows celebrities to control and profit from their own fame.¹³ Although originally conceived to apply only to a performer’s “name or likeness,”¹⁴ the protection has grown to include such things as the sound of a singer’s voice.¹⁵

vidual’s economic interest. See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 573 (1977); see also *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279, 283 (S.D.N.Y. 1977) (“[W]hen a ‘persona’ is in effect a product, . . . the appropriation by another of that valuable property has more to do with unfair competition than it does with the right to be left alone.”), *aff’d sub nom.*, *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979); *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 843 (S.D.N.Y. 1975) (“[T]he two rights are clearly separable. The protection from intrusion . . . and protection from appropriation . . . are different in theory and in scope.”). For an argument that the right of publicity has slowly matured into a tort unrelated to the right of privacy, see MCCARTHY, *supra*.

¹² See KEETON ET AL., *supra* note 6, at 859-60. The right of publicity developed to protect celebrities and other public figures who waived their right to privacy. See *id.*; Nimmer, *supra* note 8, at 204; Prosser, *supra* note 2, at 411-19. The right of publicity first emerged in *Haelan Lab., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953). Judge Frank argued that a “prominent person” would feel deprived if they no longer received money for the use of their name or likeness. *Id.* at 868. The court acknowledged that public figures have unique interests and distinguished the right of publicity from the right of privacy by differentiating between economic harm and emotional harm. *Id.* at 868. It is an “exclusive right to make money from one’s popularity and prominence.” RICHARD F. HIXSON, *PRIVACY IN A PUBLIC SOCIETY* 133 (1987).

For a discussion of the historical development of the right to publicity, see generally Sheldon W. Halpern, *The Right of Publicity: Commercial Exploitation of the Associative Value of Personality*, 39 VAND. L. REV. 1199 (1986); Harold R. Lordon, *Right of Property in Name, Likeness, Personality and History*, 55 NW. U. L. REV. 553 (1960); Nimmer, *supra* note 8.

¹³ See *Zacchini*, 433 U.S. at 562. In *Zacchini*, the Supreme Court acknowledged the existence of a state law right of publicity as a tort independent of the right of privacy. *Id.* The Court summarized the differences between the two rights by noting that privacy plaintiffs seek to “minimize publication of . . . damaging matter, while in ‘right of publicity’ cases the only question is who gets to do the publishing.” *Id.* at 573. See also *Memphis Dev. Found. v. Factors, Etc., Inc.*, 616 F.2d 956, 957 (6th Cir.) (“The famous have an exclusive legal right during life to control and profit from the commercial use of their name and personality.”), *cert. denied*, 449 U.S. 953 (1980); MAYER, *supra* note 7, at 221 (noting increased recognition of legal relief for misuse of personality for profit in trade or business).

¹⁴ See Prosser, *supra* note 2, at 401; HOFSTADTER, *supra* note 1, § 1.5.

¹⁵ For an analysis of cases involving the unauthorized use of a performer’s voice, see Cheryl L. Hodgson, Note, *Intellectual Property - Performer’s Style - A Quest for Ascertainment, Recognition and Protection*, 52 DENV. L.J. 561 (1975); Leonard A. Wohl, Note, *The Right of Publicity and Vocal Larceny: Sounding off on Sound-Alikes*, 57 FORDHAM L. REV. 445 (1988). In order to adequately protect the celebrity’s economic interest, Wohl advocates the adoption of a right of publicity that includes voice appropriation. *Id.* at 460; cf. *Booth v. Colgate-Palmolive Co.*, 326 F. Supp. 343 (S.D.N.Y. 1973) (holding that anonymous use of plaintiff’s voice did not infringe celebrity’s right of publicity).

Recently, in *Waits v. Frito-Lay, Inc.*,¹⁶ the United States Court of Appeals for the Ninth Circuit upheld a \$2,475,000 award, holding that damages need not be based solely on the fame of the performer¹⁷ and that the unauthorized imitation of a singer's voice violated the Federal Lanham Act¹⁸ as well as the singer's common law right of publicity.¹⁹

The plaintiff in *Waits* was a singer-songwriter²⁰ who, before this particular case arose, had emphatically denounced the use of an artist's image for commercial purposes.²¹ The defendants, a manufacturer of corn chips and its advertising agency, hired a "sound-alike" for a radio commercial despite their knowledge of the plaintiff's disapproval of such endorsements.²² Upon hearing the commercial, Waits promptly brought an action in federal court claiming misappropriation under California common law and false endorsement under the Federal Lanham Act.²³ The jury found for

¹⁶ 978 F.2d 1093 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993).

¹⁷ *Id.* at 1103. Although injuries from a violation of the right of publicity are usually economic, the court has recognized injury for "humiliation, embarrassment, and mental distress." *Id.* (quoting *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 824 n.11 (9th Cir. 1974)).

¹⁸ *Id.* at 1107; *see* 15 U.S.C. § 1125(a) (1988).

¹⁹ 978 F.2d at 1102.

²⁰ *Id.* at 1097. Waits has recorded over seventeen albums since his 1973 debut. *Id.* His recent album *BONE MACHINE* (Island Records 1992) won a Grammy award for Best Alternative Album. *See* Robert Palmer, *Tom Waits, All-Purpose Troubadour*, N.Y. TIMES, Nov. 14, 1993, § 2, at 1, 10. In 1982, Waits was nominated for an Academy award for Best Musical Score for his work on the film *ONE FROM THE HEART* (Columbia Pictures 1982). *Id.* In addition, Waits is an accomplished actor and fledgling operatic composer. *Id.* Waits' film career goes back fifteen years and includes performances with Jack Nicholson and Meryl Streep in *IRONWEED* (Tri-Star 1987) and most recently with Lily Tomlin in Robert Altman's *SHORT CUTS* (Fine Line 1993). *Id.* In a collaborative effort with director Robert Wilson and beat generation author William S. Burroughs, Waits recently composed a pop opera, *THE BLACK RIDER* (1993). *Id.*

²¹ *See Playboy Interview*, PLAYBOY, March 1988, at 128. Waits criticized "artists aligning themselves with various products, everything from Chrysler-Plymouth to Pepsi. I don't support it. I hate it." *Id.* The court noted that Waits' policy is a very public one. *Waits*, 978 F.2d at 1097. For over ten years, Waits rejected "numerous lucrative offers" and has repeatedly expressed his philosophy that endorsements detract from the artist's "integrity." *Id.*

²² *Waits*, 978 F.2d 1098. The defendant acknowledged awareness of the plaintiff's disapproval of commercial endorsements. *Id.* In addition to the vocal imitation, the defendant's advertisement used a "rhyming word play" similar to one of the plaintiff's songs. *Id.* at 1097.

²³ *Id.* at 1098. Waits stated that he was angry and embarrassed when he heard the "corn chip sermon." *Id.* at 1103. Waits based his Lanham Act claim on the theory that the imitation and parody of his song misrepresented his association with and endorsement of the defendant's product. *Id.* at 1106; *see* Lanham Act, ch. 540, § 43, 60 Stat. 441 (1946) (current version at 15 U.S.C. § 1125 (1994)). "Any person who

Waits and awarded him \$375,000 in compensatory damages, \$100,000 in attorney's fees for violation of the Lanham Act, and \$2,000,000 in punitive damages.²⁴ The Ninth Circuit affirmed the decision and the United States Supreme Court recently denied certiorari.²⁵

Writing for the court, Judge Boochever found that Waits had successfully proved the elements of voice misappropriation espoused by the Ninth Circuit in *Midler v. Ford*.²⁶ The court held that Waits could recover for damages to his peace, happiness, and feelings,²⁷ and for injuries to his goodwill, professional image, and future publicity value.²⁸ More significantly, the court decided that punitive damages are available in voice misappropriation cases.²⁹ Finally, the *Waits* court held that the Federal Lanham Act applied to the facts of the case,³⁰ and that Waits had standing to sue under the statute.³¹

shall affix . . . or use in connection with any goods or services . . . a false designation or representation . . . shall be liable to . . . any person who believes that he is or is likely to be damaged by the use of any such false designation or representation." *Id.* Waits complained that the sound-alike copied "the way I approach a phrase, the way I wait before I start a phrase . . . the hair on my voice . . . scars in the same place." Steve Harvey, *Only in L.A.*, L.A. TIMES, April 14, 1990, at B2.

²⁴ 978 F.2d at 1098.

²⁵ 113 S. Ct. 1047 (1993).

²⁶ 849 F.2d 460 (9th Cir.), *cert. denied*, 112 S. Ct. 1513 (1992). In *Midler*, the court held that when a widely known and distinctive voice is "deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California." *Id.* at 463. The trial court in *Waits* focused on whether the defendants had deliberately imitated Waits and whether Waits' voice was "sufficiently distinctive and widely known to give him a protectable right in its use." *Waits*, 978 F.2d at 1100. Indeed, Waits' "voluble hipster cadences" and gravelly-gruff voice established him as one of music's most distinctive voices. Palmer, *supra* note 20, at 1.

²⁷ 978 F.2d at 1103. Waits' public stance against endorsements permitted jurors to infer that the commercial made him look like a hypocrite and humiliated him. *Id.*

²⁸ *Id.* at 1104. Waits testified that his artistic reputation was based in part on his stance against endorsements. *Id.*

²⁹ *Id.* at 1105. Under California law, Waits was entitled to punitive damages if clear and convincing evidence proved that the defendants' conduct was in conscious disregard of his legal right to control the commercial use of his own voice. *Id.* at 1104; CAL. CIV. CODE § 3294(a) (West Supp. 1993). Evidence of the defendants' awareness of Waits' outspoken policy against endorsements, and their willingness to go ahead even though warned of the possible serious legal consequences, were sufficient to support a finding that the defendants acted in conscious disregard of Waits' rights. 978 F.2d at 1105.

³⁰ 978 F.2d at 1107.

³¹ *Id.* at 1110. The court reconciled earlier Lanham Act decisions and found that a plaintiff has standing under the Act when the interest asserted is a "commercial" interest protected under the Act. *Id.* at 1108; see *Malicki v. United Artists Communications, Inc.*, 812 F.2d 1213, 1214 (9th Cir. 1987) (finding that standing under Lanham

It is submitted that *Waits* strengthened the Ninth Circuit's position against voice misappropriation in two important ways. First, the *Waits* court did not limit damages according to the performer's fame,³² and second, it applied the Federal Lanham Act.³³ It is proffered that *Waits* greatly extended the protection against

Act requires injury to plaintiff); *Smith v. Montoro*, 648 F.2d 602, 608 (9th Cir. 1981) (stating that standing requires that plaintiff have "reasonable interest").

³² *Id.* at 1102. The court rejected the defendants' contention that the *Midler* standard required *Waits* be at least as well known as Bette Midler to recover. *Id.* Instead the court stated that "[w]ell known" is a relative term, and differences in the extent of celebrity are adequately reflected in the amount of damages recoverable." *Id.*; see *infra* notes 45-61 and accompanying text (discussing *Midler*, *Waits*, and definition of "well known").

³³ *Id.* at 1107. Although the court characterized as "common sense" the conclusion that an endorsement falsely implied through the use of a sound-alike gives a celebrity standing under the Lanham Act, their own precedents question whether such a plaintiff could have standing. *Id.*; see, e.g., *supra* note 31 (citing prior cases). The Lanham Act confers standing to any person who believes that he is or is likely to be damaged by the use of any such false designation or representation. 15 U.S.C. § 1125 (West 1988). The plain language of the statute appears to permit a performer who has his or her voice copied in an advertisement without permission to qualify. Courts have found that consumers duped by false advertising, although "likely to be damaged," do not have standing because they are not within the Lanham Act's intended group of plaintiffs. See, e.g., *Colligan v. Activities Club, Ltd.*, 442 F.2d 686, 692 (2d Cir.), *cert. denied*, 404 U.S. 1004 (1971).

Because Congress directed the Lanham Act at unfair competition, the Ninth Circuit previously required that defendant's conduct "must not only be unfair but must in some discernible way be competitive." *Malicki*, 812 F.2d at 1214; see *ALPO Pet Foods, Inc. v. Ralston Purina*, 720 F. Supp. 194, 212 (D.D.C. 1989), *aff'd in part and rev'd in part on other grounds*, 913 F.2d 958 (D.C. Cir. 1990) (protecting consumers under Lanham Act by allowing competitors cause of action); *Serbin v. Ziebart Int'l Corp.*, 24 U.S.P.Q.2d 1957, 1959 (W.D. Pa. 1992) (requiring "commercial interest" to be protected). This posed somewhat of a problem to the *Waits* court. 978 F.2d at 1110, n.10. Although *Midler* did not contain a Lanham Act cause of action, the court addressed the similar issue of unfair competition. *Midler*, 849 F.2d at 462. The court noted in dicta that it would have denied *Midler's* unfair competition claim, stating that "[t]he defendants were not in competition with her" because she "did not do television commercials." *Id.* at 462-63.

In *Waits*, although Frito-Lay had violated the Lanham Act largely because *Waits* "doesn't do" commercials, the Ninth Circuit faced the dilemma that *Waits* may not have had standing *because* he does not do commercials. *Waits*, 978 F.2d at 1097, 1107. The court exited this revolving door by dividing Lanham Act plaintiffs into two classes. *Id.* at 1109-10. The first class, parties claiming false advertisement, must still show competition with the defendant. *Id.* at 1109. The second class, parties complaining of false association or false endorsement, or both, need only demonstrate an "economic interest akin to that of a trademark holder." *Id.* at 1110. It is suggested that this was a simple and effective solution to the court's quandary. The division permits those who were particularly harmed (performers with false endorsement claims) to obtain standing without extending federal jurisdiction to every consumer problem. See, e.g., *Guarino v. Sun Co.*, 819 F. Supp. 405, 406 (D.N.J. 1993) (comparing of price differential between Sunoco Ultra and Sunoco Regular gasoline).

unwanted exploitation for all entertainers. Although this is a positive step, it is insufficient, leaving entertainers in need of even greater protection.

This Comment suggests that although the court properly allowed damages disproportionate to Waits' fame, it failed to provide useful guidance for future cases. Part I chronicles the common-law right of publicity, focusing on *Midler*, the case most similar to *Waits*. Part II explores damages in voice appropriation cases, and Part III discusses the Federal Lanham Act. Finally, Part IV of this Comment examines with approval the court's finding that the Federal Lanham Act applies to voice misappropriation.

I. HISTORY OF THE COMMON-LAW RIGHT OF PUBLICITY

The "right of privacy" was first tested in *Roberson v. Rochester Folding Box Co.*,³⁴ a 1902 New York Court of Appeals decision involving the unauthorized use of a woman's picture to advertise flour.³⁵ The plaintiff was not a model and had no desire to publicly display her likeness.³⁶ Under a right of privacy theory, she sought to enjoin further publication and to collect damages for the humiliation and embarrassment she suffered as a result of having her appearance on flour boxes.³⁷ Although the court refused to apply the right of privacy theory,³⁸ a strong dissent by Judge Gray

³⁴ 64 N.E. 442 (N.Y. 1902).

³⁵ *Id.* at 442. Franklin Mills Company, one of the defendants, was "engaged in a general milling business and in the manufacture and sale of flour." *Id.* The defendants, "without the knowledge or consent of plaintiff . . . knowing that they had no right or authority . . . obtained, made, printed, sold, and circulated about 25,000 lithographic prints, photographs, and likenesses of plaintiff." *Id.* The likenesses were displayed and conspicuously posted in "stores, warehouses, saloons, and other public places." *Id.* People recognized the plaintiff's likeness and she claimed she was:

[G]reatly humiliated by the scoffs and jeers of persons who have recognized her face and picture on this advertisement, and her good name has been attacked, causing her great distress and suffering, both in body and mind; that she was made sick, and suffered a severe nervous shock, was confined to her bed, and compelled to employ a physician.

Id. The plaintiff sought both to enjoin the defendant from further use of her likeness and damages of \$15,000. *Id.*

³⁶ *Id.* at 443. The plaintiff did not claim to be "libeled by this publication of her portrait." *Id.* at 442. The likeness was noted to be "a very good one" and the court stated that some would find such publicity "agreeable," but the plaintiff found it "distasteful." *Id.* at 442-43.

³⁷ *Id.* at 443.

³⁸ *Id.* at 447. In an almost prophetic opinion, the court declined to accept the right of privacy, fearing that:

laid the foundation for future litigation.³⁹ Judge Gray argued that

[T]he attempts to logically apply the principle will necessarily result . . . in a vast amount of litigation . . . bordering upon the absurd . . . [a]nd . . . it would necessarily be held to include the same things if spoken instead of printed, for one, as well as the other, invades the right to be absolutely let alone. . . . I have gone only far enough to barely suggest the vast field of litigation which would necessarily be opened up

Id. at 443. Although the court anticipated litigation "bordering upon the absurd," one wonders what it would have made of *White v. Samsung Elec. Am., Inc.*, 989 F.2d 1512, 1514 (9th Cir. 1993) (game show hostess protesting robot wearing wig, dress and jewelry) or Iraq's objection to an advertisement featuring a picture of Saddam Hussein. See Eben Shapiro, *Rising Caution on Using Celebrity Images*, N.Y. TIMES, Nov. 4, 1992, at D20.

The *Roberson* decision created "a storm of public disapproval, which led one of the concurring judges to take the unprecedented step of publishing a law review article explaining the decision." Prosser, *supra* note 2, at 385. At present, no common-law right of privacy exists in New York. See *Freihofer v. Hearst Corp.*, 480 N.E.2d 349 (N.Y. 1985). The public's only protection is the limited right of privacy granted by §§ 50 and 51 of the New York Civil Rights Law. *Id.* This statute was enacted in direct response to the *Roberson* decision. *Arrington v. New York Times Co.*, 434 N.E.2d 1319, 1321 (N.Y. 1982). Section 50 states:

A person, firm or corporation that uses for advertising purposes, or for the purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, or if a minor of his or her parent or guardian, is guilty of a misdemeanor.

N.Y. CIVIL RIGHTS LAW § 50 (Consol. 1982). Section 51 creates a civil remedy for violation of § 50. *Arrington*, 434 N.E.2d at 1320 (N.Y. 1982). § 51 provides:

Any person whose name, portrait or picture is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained . . . may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait or picture, to prevent and restrain the use thereof; and may also . . . recover damages for any injuries sustained

N.Y. CIVIL RIGHTS LAW § 51 (Consol. 1982).

³⁹ *Roberson*, 64 N.E. at 450 (Gray, J., dissenting). The dissent noted that if the plaintiff's "face or her portraiture has a value, the value is hers exclusively, until the use be granted away to the public." *Id.* Judge Gray also noted the absurdity of the idea that the court could protect against "the unauthorized circulation of an unpublished lecture, letter, drawing, or other ideal property, yet would deny the same protection to a person whose portrait was unauthorizedly obtained and made use of for commercial purposes." *Id.* at 451; see Barbara Singer, *The Right of Publicity: Star Vehicle or Shooting Star?*, 10 CARDOZO ARTS & ENT. L.J. 1 (1991) (discussing history of right of publicity and its current status). It was three years before a court first accepted the right of publicity. *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905).

In *Pavesich*, the defendant utilized a likeness of the plaintiff, an artist, in a newspaper advertisement. *Id.* The advertisement implied that the plaintiff owned the defendant's life insurance when he did not, and had not consented to the use of his likeness. *Id.* at 68-69. The court held that "the law recognizes, within proper limits, as a legal right, the right of privacy, and that the publication of one's picture without his consent by another as an advertisement . . . is an invasion of this right . . ." *Id.* at 80-81.

the "plaintiff has the same . . . right to be protected against the use of her face for defendant's commercial purposes, as she would have, if they were publishing her literary compositions."⁴⁰

In 1953, the Second Circuit faced a similar situation in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*⁴¹ In *Haelan*, the issue was whether a ballplayer could, by contract, grant another the exclusive right to use his photograph in the sale of baseball cards.⁴² The Second Circuit held that an individual could enter into such a contract. In doing so, the court expanded the right of privacy by recognizing that the use of a celebrity in a commercial venture has tangible economic value⁴³ and by acknowledging the existence of a "right of publicity."⁴⁴

⁴⁰ *Roberson*, 64 N.E. at 450 (Gray, J., dissenting).

⁴¹ 202 F.2d 866 (2d Cir.), cert. denied, 346 U.S. 816 (1953).

⁴² *Haelan*, 202 F.2d at 867. In *Haelan*, a ballplayer granted the plaintiff, who was engaged in the sale of chewing gum, "the exclusive right to use [his] . . . photograph in connection with the sales of plaintiff's gum . . . [and] agreed not to grant any other gum manufacturer a similar right during such term." *Id.* "[The] [d]efendant, a rival chewing-gum manufacturer, knowing of plaintiff's contract, deliberately induced the ball-player to authorize defendant . . . to use the player's photograph in connection with . . . [its] sales." and defendant did so use the photograph. *Id.*

⁴³ *Id.* at 868. "[I]t is common knowledge that many prominent persons, . . . far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements . . ." *Id.* "[The] right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures." *Id.*; see, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 575 (1977); *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 220 (2d Cir. 1978), cert. denied, 440 U.S. 908 (1979); see also *MAYER*, *supra* note 7, at 221.

It is noteworthy that courts have since held that the First Amendment is not implicated when the use of a performer's likeness is purely commercial. See, e.g., *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981). Noncommercial speech is still protected. See, e.g., *New Kids on the Block v. News Am. Publishing, Inc.*, 745 F. Supp. 1540 (C.D. Cal. 1990), *aff'd*, 971 F.2d 302 (9th Cir. 1992) (news popularity poll); *Ann Margaret v. High Soc'y Magazine, Inc.*, 498 F. Supp. 401 (S.D.N.Y. 1980) (photo from movie of actress); *Stephano v. News Group Publications, Inc.*, 474 N.E.2d 580 (N.Y. 1984) (magazine fashion photo); *Namath v. Sports Illustrated*, 371 N.Y.S.2d 10 (Sup. Ct. 1975), *aff'd*, 352 N.E.2d 580 (N.Y. 1976) (photograph of quarterback in news article). Appropriation for biographical or fictional purposes may also offend the First Amendment. *Estate of Presley*, 513 F. Supp. 1339; see also *Rogers v. Grimaldi*, 375 F.2d 994 (2d Cir. 1989) (fictional movie about dancing couple named "Ginger and Fred" protected by First Amendment).

⁴⁴ *Haelan*, 202 F.2d at 868. The court held that "a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture." *Id.* It is "immaterial" whether this right is labelled a "property" right because that tag merely "symbolizes the fact that courts enforce a claim which has pecuniary worth." *Id.* The court held that this right of publicity existed in addition to and independent of the right of privacy derived from the New York Civil Rights Law §§ 50 and 51. *Id.* The court provided that the right of publicity would be worthless

Historically, the courts have applied the right of publicity to protect against the unauthorized use of a person's name, likeness,⁴⁵ or identity,⁴⁶ but did not extend this safeguard to the use of a look-alike or sound-alike in an advertisement.⁴⁷ Recently, however, the Ninth Circuit expanded the scope of the right of publicity in *Midler v. Ford*, when an advertiser imitated a well-known singer.⁴⁸

Midler was the first case to hold an advertiser liable for using a "sound-alike" performer in a commercial. Bette Midler is a well-

unless it could be made subject to "an exclusive grant which barred any other advertiser from using their pictures." *Id.*; see Prosser, *supra* note 2, at 406 (discussing "proprietary nature" of right of publicity).

⁴⁵ See, e.g., *Martin Luther King, Jr., Center for Social Change, Inc. v. American Heritage Prod., Inc.*, 296 S.E.2d 697, 700 (Ga. 1982) (producing and selling plastic busts of Martin Luther King, Jr.); Steven T. Margolin, *From Imitation to Litigation: Expanding Protection for Commercial Property Rights in Identity*, 96 DICK. L. REV. 491, 491 (1992).

⁴⁶ See, e.g., *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (racing car driver recovering for appearance of distinctive automobile in magazine advertisement for cigarettes); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978) (employing New York Civil Rights Law § 51 to safeguard Muhammad Ali against magazine that published drawing of nude figure in boxing ring with his nickname, "The Greatest"); *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 396 N.Y.S.2d 661 (2d Dep't 1977) (Guy Lombardo, known as "Mr. New Year's Eve," successfully brought action for exploitation of property rights and public personality when car commercial depicted band leader playing his trademark song, "Auld Lang Sine," amid balloons, streamers and party hats); see also *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (finding that noncopyrighted slogan associated with talk show host invaded right of publicity even though "name or likeness" was not used); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979) (enjoining distribution of X-rated movie featuring costumes closely resembling cheerleading outfits).

These cases indicate that courts tend to go beyond protecting a popular "name and likeness," and find a violation of the right of publicity when there is an appropriation for commercial use of some aspect of the performer's identity or persona. See generally Robert M. Callagy & Gillian M. Lusins, *Commercial Speech and Private Rights*, 806 PLI CORP. L. & PRAC. COURSE HANDBOOK SERIES 31 (1993) (discussing right of publicity cases).

⁴⁷ See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 717-18 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971) (finding use of look, dress, and sound-alike actress singing "These Boots are Made for Walkin'" did not violate Nancy Sinatra's rights). *But see* *Lahr v. Adell Chem. Co.*, 300 F.2d 256 (1st Cir. 1962) (utilizing theory of unfair competition instead of right of publicity). The court stated that unfair competition may arise when an imitation results in a mistake in identity between the original and the imitation. *Id.* at 259. The plaintiff in *Lahr* argued that if this misunderstanding transpired, the "defendant's commercial had greater value because its audience believed it was listening to [the plaintiff]" rather than to an imitation. *Id.* The court indicated that in such a situation a cause of action may arise. *Id.*

⁴⁸ *Midler v. Ford*, 849 F.2d 460, 463 (9th Cir. 1988), *cert. denied*, 112 S. Ct. 1513 (1992).

known singer⁴⁹ who consistently disallows the use of her voice in advertisements.⁵⁰ The defendants hired an unknown singer who impersonated Midler to near perfection in an automobile advertisement.⁵¹ The Ninth Circuit held that in doing so, Ford Motor Company violated the entertainer's right of publicity because it "deliberately imitated [her distinctive voice] in order to sell a product."⁵² The court awarded compensatory damages but did not pass on the applicability of punitive damages.⁵³

II. DAMAGES IN VOICE APPROPRIATION CASES

A. *Compensatory Damages: Award Not Limited By Fame of Performer*

The *Midler* court stated that voice appropriation violates the right of publicity "when a distinctive voice of a professional singer

⁴⁹ *Id.* at 461 (pointing to Midler's Grammy, multiple gold and platinum records, and Academy Award nomination).

⁵⁰ *Id.* The defendants attempted to get Midler to do this commercial and were informed that she was "not interested" in doing any commercials. *Id.*

⁵¹ *Id.* The defendants employed one of Midler's former back-up singers, and she imitated Midler to the best of her ability. *Id.* After the commercial aired, a number of people told both Midler and the imitator that the recording sounded exactly like Midler. *Id.* at 461-62. The defendants did not use Midler's name or picture in the commercial; therefore, the sole issue in the case was the "protection of Midler's voice." *Id.* at 462. The court compared Midler's claim to that raised in *Sinatra*, noting that Midler's claim would similarly fail if she were claiming a "secondary meaning" to the song or seeking to prevent the defendants from using the song. *Id.*

⁵² *Id.* at 463. The defendant claimed that federal copyright law pre-empted California's common-law tort of the right of publicity, if one existed. *Id.* at 462. The court found that a human voice could not be copyrighted, so no pre-emption existed. *Id.* Copyrights protect only those "original works of authorship fixed in any tangible medium of expression." *Id.* (quoting 17 U.S.C. § 102(a) (1988)). The *Midler* court stated that "[a] voice is not copyrightable . . . [t]he sounds are not 'fixed'" and consequently found no pre-emption. *Id.* For a discussion on when federal law pre-empts misappropriation, see J. THOMAS MCCARTHY, MCCARTHY'S DESK ENCYCLOPEDIA OF INTELLECTUAL PROPERTY 207 (1991).

The court did not hold that "every imitation of a voice to advertise merchandise is actionable . . . [but] . . . that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort." *Midler*, 849 F.2d at 463. The court held the "defendants here for their own profit in selling their product did appropriate part of [Midler's] identity." *Id.* at 463-64.

⁵³ *Midler v. Young & Rubican*, 1991 U.S. App. LEXIS 22641, at *3-*4 (9th Cir. Sept. 20, 1991); see CAL. CIV. CODE § 3294(a) (1994) (allowing award of punitive damages only when defendant has been found guilty of "oppression, fraud, or malice"). Because this tort had "only recently" been discovered, the court believed that the level of "oppression, fraud or malice" required to impose punitive damages could not be found. *Midler*, 1991 U.S. App. LEXIS 22641, at *3-*4.

is widely known and is deliberately imitated in order to sell a product."⁵⁴ Using this standard, the *Waits* court had little difficulty finding the plaintiff's voice distinctive.⁵⁵ A closer question was whether *Waits* could satisfy the "widely known" criterion of *Midler*.⁵⁶

Although Bette Midler is practically a household name,⁵⁷ the same cannot be said of Tom Waits.⁵⁸ As a result, the defendants argued that Waits had "not achieved the level of celebrity Bette Midler has, [and therefore] he is not well known under the *Midler* standard."⁵⁹ Defendants further requested a jury instruction stating that "a singer is not widely known if he is only recognized by his own fans, or fans of a particular sort of music, or a small segment of the population."⁶⁰ The *Waits* court found this narrow definition "crabbed" and instead viewed "widely known" as a relative term, finding that variations in the celebrity status of different performers could more appropriately be reflected in the damages award.⁶¹

⁵⁴ *Midler*, 849 F.2d at 463.

⁵⁵ 978 F.2d 1093, 1097 (9th Cir.), *cert. denied*, 113 S. Ct. 1047 (1993). In one passage, the court noted that his singing has been described as "[l]ike how you'd sound if you drank a quart of bourbon, smoked a pack of cigarettes and swallowed a pack of razor blades . . . [a]fter not sleeping for three days." *Id.* The court stated that allowing the jury to use common sense when determining whether a voice is distinctive was "entirely appropriate." *Id.* at 1102.

⁵⁶ *Id.* at 1102. The court instructed the jury that "[a] professional singer's voice is widely known if it is known to a *large number* of people throughout a *relatively large* geographic area." *Id.* Defendants argued that Waits "is known only to music insiders and to a small but loyal group of fans." *Id.* The court rejected this argument, stating that "[w]ell known is a relative term, and differences in the extent of celebrity are adequately reflected in the amount of damages recoverable." *Id.*

⁵⁷ See *supra* note 49 (indicating Bette Midler's notoriety).

⁵⁸ See Richard Harrington, *The Music Industry's Court Hits*, WASH. POST, May 30, 1990, at C7. In addition, Harrington dryly suggested that Waits spend a good part of his \$2.5 million award "for a good publicist: most of the jurors said they had never heard of him before." *Id.* Actually, when jurors observed the scruffy looking singer at the start of the trial, many assumed they had been assigned to a criminal case. Paul Feldman, *Tom Waits Wins \$ 2 1/2 Million in Voice-Theft Suit*, L.A. TIMES, May 9, 1990, at B1. Said one juror, "when he left the court the first time, we thought he was getting away." *Id.* However, agreeing that Waits is a "prestige artist" rather than a musical superstar," the court was much kinder than reporters. *Waits*, 978 F.2d at 1097. After explaining why the extent of his popularity was not crucial, the court added that "Tom Waits is very widely known." *Id.* at 1102.

⁵⁹ *Waits*, 978 F.2d at 1102.

⁶⁰ *Id.*

⁶¹ *Id.*

Indeed, a direct correlation always existed between the "widely known" factor and any monetary recovery.⁶² It is proposed, however, that any focus on the popularity of a performer is partially misplaced. Common sense suggests that, all other things being equal, a famous entertainer should be awarded greater damages than a relatively unknown performer. Nonetheless, there are other factors of equal or greater importance. These include how prominently the performer was featured in the advertisement;⁶³ how often the advertisement was shown and in how many markets;⁶⁴ the "quality" or "taste" of the appropriation;⁶⁵ and what product was advertised.⁶⁶ For example, the nature of the product was significant when a beer manufacturer appropriated the image of a young rap group to promote alcohol despite the performers' public service campaign against underage drinking.⁶⁷ Finally, and perhaps most importantly, an entertainer's appearance in *any* advertisement can be damaging when the performer has repeatedly staked his prestige and reputation on denouncing the commercialization of the music industry.⁶⁸

⁶² See *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 82, 824 n.11 (9th Cir. 1974). The *Motschenbacher* court stated that "[g]enerally, the greater the fame or notoriety of the identity appropriated, the greater will be the extent of the economic injury suffered." *Id.*

Some scholars have gone so far to suggest that the award should be adjusted depending on whether the jury found the voice appropriation in an "aided" or "unaided" manner. See J. THOMAS MCCARTHY, *RIGHTS OF PUBLICITY & PRIVACY* § 4.9, at 4-48 to 4-49 (1988). An "unaided" identification means that the jury could recognize the similarity simply by hearing the defendant's commercial. A finding would be "aided" if it required the jury to hear both the authentic and sound-alike voices. *Id.* It is suggested that this approach is unfair, as jurors are not required to recognize an original passage in a plagiarism case. A jury, representing six random members of the public, does not accurately reflect how "widely known" a performer is.

⁶³ See *Onassis v. Christian Dior-New York, Inc.*, 472 N.Y.S.2d 254 (N.Y. Sup. Ct. 1984) (holding that violation exists even when look-alike is photographed in crowd), *aff'd*, 110 A.D.2d 1095 (1st Dep't 1985).

⁶⁴ See *Vogel v. W.T. Grant Co.*, 327 A.2d 133, 137 (Pa. 1974) (holding that no violation occurs when exposure is extremely limited).

⁶⁵ See *Brinkley v. Casablancas*, 438 N.Y.S.2d. 1004, 1013 (1st Dep't 1981) (finding that appropriation consistent with model's public image may affect damages but not liability).

⁶⁶ See *Tin Pan Apple v. Miller Brewing Co.*, 737 F. Supp. 826, 838 (S.D.N.Y. 1990) (considering nature of product advertised in sound-alike case).

⁶⁷ *Id.*

⁶⁸ See *supra* note 29 (noting Waits' outspoken policy against endorsements); see also, *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 880 (S.D.N.Y. 1973) (discussing relationship between privacy rights and personal desire not to commercialize one's name); Sharon Chester-Taxin, *Will The Real Bette Midler Please Stand Up? The Future of*

B. *Punitive Damages: Award Not Relative To Fame of Performer*

The most striking aspect of *Waits*, and the part most likely to command the attention of entertainers and the advertising industry alike, is the sheer magnitude of the award—\$2.5 million.⁶⁹ The major portion of the award, \$2 million, was punitive,⁷⁰ and *Waits* is the first case to award punitive damages in a right of publicity action.⁷¹ Removing any prior doubt regarding punitive damages, *Waits* clearly sends a message to advertisers that punitive damages will be available for intentional misappropriation of celebrity voices in commercials.⁷²

Some critics argue that the multimillion dollar punitive damage award was excessive.⁷³ Yet again, the complaints stem from *Waits*' lack of commercial success.⁷⁴ The critics urge that an award given by a "sympathetic jury"⁷⁵ should not be allowed to overcompensate the realistic economic value of the commercial endorsement.⁷⁶ It is suggested that this position neglects a main

Celebrity Sound-Alike Recordings, 9 U. MIAMI ENT. & SPORTS L. REV. 165, 167 (quoting Neil Young song that criticizes entertainers who endorse products).

⁶⁹ See *Recent Developments in Case Law*, 4 J. PROPRIETARY RTS. 20, 23 (1992) (summarizing *Waits* decision and emphasizing plaintiff's monetary recovery).

⁷⁰ *Id.*

⁷¹ See text accompanying note 53 (awarding only compensatory damages); *Waits*, 978 F.2d at 1104. Despite the similarities between *Midler* and *Waits*, the Ninth Circuit awarded *Waits* punitive damages because he had something *Midler* did not: a precedent. *Id.* at 1104-05. More specifically, when deciding whether to use a sound-alike in their advertisement, the defendants were well aware of the three-month-old *Midler* decision. *Id.* at 1105. They were concerned enough to check with an attorney who counseled caution. *Id.* at 1098.

In California, punitive damages are available only when "the defendant has been guilty of . . . oppression, fraud, or malice." CAL. CIV. CODE § 3294(a) (West Supp. 1994). Malice is defined as "despicable conduct which is carried on by the defendant with a willful and conscious disregard of the rights or safety of others." *Id.* § 3294(c)(1). Because the defendants knew of the *Midler* decision but decided to use a sound-alike anyway, the court was able to find the willful disregard required to allow punitive damages. *Waits*, 978 F.2d at 1104.

⁷² *Waits*, 978 F.2d at 1104.

⁷³ See Margolin, *supra* note 45, at 514 (arguing that "*Waits* award is clearly excessive").

⁷⁴ *Id.* at 514-15.

⁷⁵ See Chester-Taxin, *supra* note 68. As Mario Aieta, a defense lawyer in the *Midler* case noted, "Tom is nicer than Frito-Lay . . . [so] it's not surprising that the jury found in his favor." *Id.*

⁷⁶ See Margolin, *supra* note 45, at 514. "Viewed in a relative context, *Waits* was awarded a minimum of twenty-five times the value of his contract for the alleged wrong," as he would have received only one-hundred-thousand dollars had he actually done the commercial. *Id.*

point of punitive damages recovery set forth in section 908 of the Restatement (Second) of Torts. That section states that "[i]n assessing punitive damages, the trier of fact can properly consider the character of the defendant's act . . . and the wealth of the defendant."⁷⁷

It is submitted, therefore, that the court properly allowed a punitive award that was disproportionate to the plaintiff's commercial success. It is quite possible that Frito-Lay decided specifically to appropriate Waits' image because of his antiestablishment style, hoping it would appeal to a particular audience.⁷⁸ It seems especially unjust to lessen the punishment of an advertiser who preyed on a performer who spent his career actively avoiding commercial endorsements and, to some extent, commercial success.

III. THE FEDERAL LANHAM ACT

In *Waits*, the Ninth Circuit also held that Frito-Lay violated the Federal Lanham Act.⁷⁹ This was the first time in a voice appropriation case that a court found a Lanham Act violation.⁸⁰ This has two significant results. First, as a federal action, the decision is persuasive authority in all jurisdictions and not just the State of California.⁸¹ Second, the Lanham Act explicitly allowed Waits to recover attorneys' fees,⁸² which were unavailable under the common-law claim.

⁷⁷ RESTATEMENT (SECOND) OF TORTS § 908 (1989). Comment (e) further explains: The wealth of the defendant is also relevant, since the purposes of exemplary damages are to punish for a past event and to prevent future offenses, and the degree of punishment or deterrence resulting from a judgment is to some extent in proportion to the means of the guilty person.

Id. cmt. (e) (emphasis added).

⁷⁸ *Waits*, 978 F.2d at 1105-06.

⁷⁹ *Id.* at 1107.

⁸⁰ *Id.* at 1110 n.10. Although Midler attempted to amend her complaint to include the Lanham Act, she was precluded by the court for technical reasons, *viz.*, prejudicial delay in filing the amendment. *Id.*

⁸¹ See Lowell Anderson, *Recent Developments in Trademark Litigation*, 804 PLI CORP. L. & PRAC. COURSE HANDBOOK SERIES 661 (1993) (summarizing *Waits* and logical extension of decision); see also *Sidco Indus. Inc. v. Wimar Tahoe Corp.*, 768 F. Supp. 1343 (D. Or. 1991) (action by motel owner under Lanham Act against casino using similar name); *Dakota Indus. v. Dakota Sportswear*, 946 F.2d 1384 (8th Cir. 1991) (action by trademark owner against trademark competitor under Lanham Act).

⁸² See 15 U.S.C. § 1117. This section provides in part that "[t]he plaintiff shall be entitled . . . to recover . . . the costs of the action." *Id.*; see also, *Sealy, Inc. v. Easy Living, Inc.*, 743 F.2d 1378, 1384 (9th Cir. 1984) (holding that reasonable attorneys' fees may be awarded in exceptional trademark cases, *i.e.*, when infringement is malicious, fraudulent, deliberate, or willful).

When Frito-Lay broadcasted its commercial employing the Waits sound-alike, the Lanham Act stated "[a]ny person who, on or in connection with any goods or services . . . uses in commerce . . . any false designation of origin . . . shall be liable in a civil action."⁸³ This language does not plainly implicate the use of a sound-alike. In fact, prior to *Waits* the Ninth Circuit never applied these words to the "use" of a voice impersonator that gave the appearance that a celebrity endorsed a product. Consequently, in order to interpret the statute, the *Waits* court looked to precedents from other jurisdictions and subsequent legislative action.⁸⁴

The scope of the Lanham Act has been expanding steadily since its enactment.⁸⁵ Originally, it covered only an advertiser's "passing off" of its goods as those of others.⁸⁶ Although the Ninth Circuit previously avoided the issue,⁸⁷ other courts expanded the Lanham Act's coverage to encompass "false endorsements."⁸⁸

Section 43(a) of the Federal Lanham Act originally discouraged advertisers only from making false statements about their own products.⁸⁹ In 1989, Congress amended the Act to prohibit advertisers from making false claims about products that their competitors manufactured.⁹⁰ Further, this amendment clearly

⁸³ 15 U.S.C. § 1125(a), amended by Trademark Law Revision Act (1988).

⁸⁴ *Waits*, 978 F.2d at 1106-07. Specifically, the court cited "persuasive judicial authority and the subsequent congressional approval of that authority." *Id.* at 1107.

⁸⁵ *Resource Developers, Inc. v. Statue of Liberty-Ellis Island Found., Inc.*, 926 F.2d 134, 139 (2d Cir. 1991). The court stated that "[a]lthough originally interpreted narrowly, [the Lanham Act] now is considered to confer protection against a myriad of deceptive commercial practices." *Id.*

⁸⁶ See Helene D. Jaffe, *Lanham Act Section 43(a): Standards and Trends*, 806 PLI CORP. L. AND PRAC. COURSE HANDBOOK SERIES 205 (1993). "Initially, the courts took a narrow view of the statute, finding violations only when the advertiser passed off his products as the products of a competitor." *Id.*

⁸⁷ See *Cher v. Forum Int'l Ltd.*, 692 F.2d 634, 637 n.1 (9th Cir. 1982) (expressing no opinion on applicability of Lanham Act), *cert. denied*, 642 U.S. 1120 (1983).

⁸⁸ *Frich's Restaurants, Inc. v. Elby's Big Boy, Inc.*, 670 F.2d 642, 646 (6th Cir.), *cert denied*, 459 U.S. 916 (1982). A false endorsement claim exists when consumers will become confused and believe that the celebrity is actually endorsing the product. *Id.*; see, e.g., *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360, 368 (S.D.N.Y. 1988) (holding plaintiff's Lanham Act claim proper when clothing store featured his look-alike in magazine advertisement); *Prudhomme v. Proctor & Gamble Co.*, 800 F. Supp. 390, 394 (E.D. La. 1992) (holding protection of famous chef's likeness proper under Lanham Act when coffee manufacturers used look-alike in commercials).

⁸⁹ Siegrun D. Kane, *False Advertising Under Section 43(a): The Courthouse Door and Defendants' Coffers Open Wide*, 361 PLI PAT., COPYRIGHT, TRADEMARKS AND LITERARY PROP. COURSE HANDBOOK SERIES 85 (1993).

⁹⁰ *Id.*

proscribed "false endorsement" claims previously excluded from the statutory language.⁹¹

Given the Ninth Circuit's leap from "look-alike" to "sound-alike" within the common-law right of publicity,⁹² and the wide judicial and legislative acceptance of the application of the Lanham Act to "false endorsement" cases, it appears only natural that the court allowed *Waits* to use federal law against the defendant. In the Ninth Circuit, at least, the use of celebrity sound-alikes now clearly implicates federal law.

CONCLUSION

It is submitted that the *Waits* decision is much more than a sequel to *Midler*. *Waits* extends the right of publicity to protect lesser known performers from voice appropriation. It was the first, and so far the only, award of punitive damages in a right of publicity action. Finally, by allowing the use of the Federal Lanham Act, the *Waits* court opened all jurisdictions to the possibility of voice appropriation claims, and encouraged these cases by awarding the plaintiff attorney's fees.

The Ninth Circuit has become a pioneer in the area of voice appropriation. Although the court stands alone, its message is clear, and perhaps other courts will follow suit when the proper case arises.

Patrick Buckley

⁹¹ *Id.* The amended act includes "any word, term, name, symbol, or device, or any combination thereof . . . likely to cause confusion . . . as to the affiliation, connection, or association of such person with another . . . commercial activit[y]." 15 U.S.C. § 1125(a), amended by Trademark Law Revision Act (1988). The modified passage makes it clear that "false endorsement" claims, which would necessarily result in "confusion . . . as to the affiliation" of the celebrity with the product, would be covered. Further, the legislative history also reveals that Congress was pleased with the broad interpretation of the Act. See S. REP. No. 515, 100th Cong., 2d Sess. 44 (1988), reprinted in, 1988 U.S.C.C.A.N. 5577, 5607.

Technically, the amendment was not in effect when Frito-Lay aired its commercials. 978 F.2d at 1107. The *Waits* court did, however, take note of the fact that the legislature had endorsed the expanding scope of the Lanham Act. *Id.* It cited these changes and indicated that such expansive construction cemented its decision. *Id.*

⁹² See *supra* text accompanying notes 49-53 (discussing *Midler*).

