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IS IT LIVE OR IS IT A SOUNDALIKE?:

Federal Copyrights in Soundalike Recordings and Preemption of State Publicity Claims

Jeffrey A. Trueman¹

I. Introduction

Intellectual creativity must be nourished because it “foster[s] the growth of learning and culture[.]”² As a method of enriching the public welfare, Congress enacted the Copyright Act,³ which allows the work of creative authors to be exploited commercially.⁴ A broad spectrum of creative works can be exploited under the Act, including literature, dramatic, and audiovisual works once they are fixed in a tangible form of expression,⁵ such as film, paper, or a computer disk.

Despite congressional protection for creative works to serve society as a whole, questions arise as to the rights of individuals who may be the subject of those works. For example, when creative works capture a particular person’s image, as in a photograph or portrait painting, the person identified can protect her image from

¹ Jeffrey A. Trueman is an attorney at Kollman & Sheehan, P.A. He would like to thank Professor Elizabeth Samuels for her help with this article.

²Howard B. Abrams, *Copyright, Misappropriation, and Preemption: Constitutional and Statutory Limits of State Law Protection*, 1983 SUP. CT. REV. 509, 510 (quoting HOUSE COMM. ON THE JUDICIARY, 87TH CONG., 1ST SESS., REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 5 (Comm. Print 1961)).

³See 17 U.S.C. §§ 101-1010 (1994). The federal interest in creative works stems from the United States Constitution, which states that “Congress shall have Power . . . To promote the Progress of Science . . . , by securing for limited Times to Authors . . . the exclusive Right to their respective Writings” U.S. CONST. art. I, § 8, cl. 8. See also 1 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT, §§ 1.01[A], 2.02 (1996) [hereinafter NIMMER] (discussing further information regarding state copyright protection).

⁴See Abrams, *supra* note 1. See also discussion *infra* Section I.

⁵See 17 U.S.C. § 102.

unwanted exploitation through the right of publicity.⁶ The right of publicity protects “the inherent right” of a person to “control the commercial use of her identity.”⁷ The publicity right rests upon the policy that a person can prevent her image or “persona” from being associated with a product or service without her permission.⁸ Although the right of publicity protects everyone, celebrities usually seek publicity protection.⁹

Both the right of publicity and the Copyright Act address economic concerns, but they differ in orientation. The copyright holder has the exclusive right to exploit a creative work, whether or not it is exploited for commercial advantage.¹⁰ The publicity right, however, protects a person’s identity from economic exploitation without consent.¹¹ Both laws protect broad interests and can apply to one creative work,¹² for example, a song performed by a famous singer who has a well-recognized voice. The famous singer’s recording of a song would include copyrights in the sound recording and the underlying song as well as the singer’s publicity right in the commercial use of her voice. Therefore, the recorded song is one work encompassing two distinct legal protections: federal copyright and state right of publicity. These rights, however, conflict when the federal and state protections dictate different results.¹³

Recognizing the possible conflict between federal and state laws, Congress provided a section in the Copyright Act containing a test for determining when the Act would preempt a conflicting state law.¹⁴ According to common interpretation of the Act’s preemption test, the federal Copyright Act does not preempt state publicity laws.¹⁵ There are dissenting opinions.¹⁶ The strongest dissenting argument supports

⁶See 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY, § 1.1[A][1] (3d ed. 1994) [hereinafter MCCARTHY].

⁷*Id.*

⁸See *id.*

⁹See *id.*, § 4.1[D] (adding that a celebrity can “quickly lose his or her commercial appeal by over exposure”).

¹⁰See also discussion *infra* Section I.

¹¹See *id.*

¹²See *id.*

¹³See discussion *infra* Section II.

¹⁴See 17 U.S.C. § 301.

¹⁵See discussion *infra* Section II.

¹⁶See *id.*

the preemption of state publicity claims asserted by vocalists who have been imitated in “soundalike recordings.”¹⁷ The leading advocate of this argument is the late Professor Melville Nimmer.

In his copyright treatise,¹⁸ Professor Nimmer criticizes court opinions that allow state publicity claims to prevail in cases involving copyrighted soundalike recordings.¹⁹ His argument rests on a broad, “conflict” type of preemption, where federal law trumps conflicting state law. In Nimmer’s view, Congress intended to promote soundalike recordings, and, therefore, copyright should preempt conflicting state publicity laws.²⁰

Preemption of a state publicity right, however, results in misappropriation of valuable property distinct from copyright.²¹ Instead, a more reasonable approach would focus on the nature of the publicity right asserted in the performer’s voice before preemption is considered because not every vocalist can bring a viable publicity claim in her voice.²² As a general policy and only where commercial advertisements are concerned, a vocalist should not be strong-armed into association with a product or service against her wishes, unless competing rights, such as free speech, outweigh the performer’s right to control her persona.²³

First, this Article will summarize and compare relevant portions of federal copyright law and state publicity rights in Section I. Section II presents a

¹⁷*See id.* A “soundalike recording” is a song performed by a vocalist with the intention of imitating a well-known singer’s voice and style.

¹⁸*See* NIMMER, *supra* note 2.

¹⁹*See* NIMMER, § 1.01[B] 3(b).

²⁰*See id.*

²¹*See* discussion *infra* Section III.

²²*See* discussion *infra* Section IV.

²³First Amendment issues are not discussed in this article but for further discussion of competing constitutional and public interest issues, see 1 MCCARTHY, *supra* note 5, at ch.8. *See also* Frank G. Houdek, *Researching the Right of Publicity: A Revised and Comprehensive Bibliography of Law-Related Materials*, 16 HASTINGS COMM/ENT. L.J. 385, 411-14 (1994) (regarding First Amendment restraints on publicity rights); J. Eugene Salomon, Jr., *The Right of Publicity Run Riot: The Case For a Federal Statute*, 60 S. CAL. L. REV. 1179 (1987) (proposing a limited federal statute designed to remedy the lack of uniformity under state publicity laws which have created serious problems under the First Amendment); Symposium, *Right of Publicity: An In-Depth Analysis of the New Legislative Proposals to Congress*, 16 CARDOZO ARTS & ENT. L.J. 209 (1998).

preemption analysis of state publicity rights under § 301 of the Copyright Act. Section III discusses Nimmer's "conflict preemption" analysis concerning soundalike recordings. Section IV rejects Nimmer's argument because it unfairly leaves a person's valuable persona unprotected. In conclusion, the elements of a state publicity right present no conflict with the interests protected by federal copyright.

II. Summary and Comparison of Federal Copyrights and State Publicity Rights

A. Federal Copyright

Congress has the "power to promote the progress of science"²⁴ by granting for a limited time "to authors . . . the exclusive right to their respective writings . . ." ²⁵ Pursuant to this constitutional provision, the Copyright Act protects "original works of authorship fixed in any tangible medium of expression."²⁶ The Act does not protect a creative idea, such as the concept of a musical, but only protects the fixed expression of that idea, for example, a specific musical such as *Grease*.²⁷ Consequently, others are free to use creative ideas but not the copyrighted expressions of those ideas.²⁸ Congress distinguishes ideas from their expression to encourage the free flow of ideas, while still offering protection to an author's work.²⁹

²⁴U.S. CONST. art. I, § 8, cl. 8.

²⁵*Id.*

²⁶17 U.S.C. § 102(a).

²⁷*See, e.g., Nichols v. Universal Pictures, Corp.*, 45 F.2d 119 (2d Cir. 1930) (discussing the idea/expression distinction with fictional characters). For articles questioning the utility of the idea/expression distinction for determining infringement see Amy B. Cohen, *Copyright Law and the Myth of Objectivity: The Idea-Expression Dichotomy and the Inevitability of Artistic Value Judgments*, 66 IND.L.REV. 175 (1990) and Edward Samuels, *The Idea-Expression Dichotomy in Copyright Law*, 56 TENN. L. REV. 321 (1989).

²⁸17 U.S.C. § 102(b). The Copyright Act does not extend protection to "any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work." *Id.*

²⁹*See* Marc J. Apfelbaum, Note, *Copyright and the Right of Publicity: One Pea in Two Pods?* 71 GEO. L.J. 1567, 1570 (1983) (citing *Sid & Marty Kroft Television v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977)). *See also* William

The Copyright Act protects an extensive array of creative productions: literary (e.g., books and articles); musical works (e.g., sheet music and lyrics); dramatic works (e.g., scripts and theme music); pantomimes and choreographic works; pictorial, graphic, and sculptural, works (e.g., paintings and photographs); motion pictures and other audiovisual works; sound recordings (e.g., compact discs and cassette tapes); and architectural works.³⁰ The copyrightable expression can sometimes relate to different aspects of a single work.³¹ For example, a recorded song embodies two distinct copyrightable parts. First, songwriters generally own the copyright in the underlying musical composition and lyrics of their songs. Second, record companies generally own the copyright in the audio recordings of those songs. The Copyright Act protects both the song and the recording independently. The Copyright Act grants copyright owners the following exclusive rights: (1) *to reproduce* the copyrighted work in copies; (2) *to prepare derivative works* based on the copyrighted work; (3) *to distribute* copies of the copyrighted work to the public by sale or other transfer of ownership; (4) *to perform* the copyrighted work publicly; and (5) *to display the work publicly*, except for sound recordings.³²

When Congress grants exclusive rights to copyright owners, it seeks to reward and encourage the production of creative works for the ultimate benefit of society.³³ In order to have the fruits of creativity pass from the individual to society, however, copyright protection is limited in duration to the life of the author plus seventy years.³⁴ Federal copyrights are limited in their scope³⁵ as well as by the

M. Landes and Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325, 348 (1989) (arguing that protecting ideas would likely raise the cost of copies).

³⁰See 17 U.S.C. § 102(a).

³¹See Brown, Jeffrey H., Comment, "They Don't Make Music the Way They Used to" *The Legal Implications of "Sampling" in Contemporary Music.*, 1992 WIS. L. REV. 1941, 1950 (1992).

³²See 17 U.S.C. § 106 (emphasis added).

³³See *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984) (stating that the rewards given to copyright owners by virtue of copyright law are secondary to the reward society reaps from the products of creative genius).

³⁴See 17 U.S.C. § 302(a) (specifying the term for works created on or after January 1, 1978).

³⁵See, e.g., *Feist Publications Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) (explaining the limitations when using factual materials as part of a work).

Act's own definition of what work is subject to protection.³⁶

B. The Right of Publicity

The modern right of publicity originated as one of Dean Prosser's four facets to the common law right of privacy.³⁷ The right of publicity is "the inherent right" of a person to "control the commercial use of her identity."³⁸ It is generally considered a commercial property right granted by state law. Every state, however, does not recognize the right of publicity.³⁹ In addition, those that do recognize it grant different levels of protection.⁴⁰ Some states recognize the right by statute, others by common law.⁴¹ The duration of the right of publicity also varies among jurisdictions; some states allow the right to be inherited while many others do not.⁴² Although the right can protect everyone, including non-celebrities, celebrities usually invoke publicity rights to prevent their name, image, or likeness from being used without permission to promote a product or service.⁴³

³⁶See 17 U.S.C. § 102(a). The Copyright Act protects "original works of authorship fixed in a tangible medium of expression" and lists example categories of protectable works. *Id.*

³⁷See PROSSER, LAW OF TORTS 804 -14 (4th ed. 1971).

³⁸MCCARTHY at § 1.1[A][1].

³⁹See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 cmt. g (1995) [hereinafter RESTATEMENT]. As of 1996, only twenty-five states recognized the publicity right. See MCCARTHY, *supra* note 5, § 6.1[B] (stating that California, Connecticut, Florida, Georgia, Hawaii, Illinois, Kentucky, Michigan, Minnesota, Missouri, New Jersey, Ohio, Pennsylvania, Texas, Utah, and Wisconsin recognize a common law publicity right (Florida, California, Kentucky, Wisconsin, and Texas also have publicity statutes) and Indiana, Massachusetts, Nebraska, Nevada, New York, Oklahoma, Rhode Island, Tennessee, and Virginia have statutes that also recognize the publicity right to some degree).

⁴⁰See Richard Raysman et al., *Right of Publicity*, in MULTIMEDIA LAW: FORMS AND ANALYSIS, § 9.04 (1996) [hereinafter MULTIMEDIA].

⁴¹See MCCARTHY, *supra* note 5, at § 6.1[B].

⁴²See RESTATEMENT, *supra* note 38, at § 46 cmt. h (explaining the numerous conditions that states have placed on the inheritability of the publicity right and advising against that complication).

⁴³See MULTIMEDIA, *supra* note 39. See also *Cher v. Forum Int'l, Ltd.*, 692

The Second Circuit in *Haelan Laboratories v. Topps Chewing Gum*⁴⁴ coined the phrase “right to publicity.” In *Haelan*, rival chewing gum makers argued over the ownership of exclusive rights to use the photographs of baseball players to promote chewing gum.⁴⁵ As a basis for this right, the court recognized that celebrities benefit economically from public exposure:

Many prominent persons (especially actors and ball players), far from having their feelings hurt through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements . . . displayed in [public]. This right of publicity would usually grant them no money unless it could be made the subject of an exclusive grant, which barred any other advertiser from using their pictures.⁴⁶

At its core, publicity protects “persona,” that which identifies a person.⁴⁷ Almost anything can identify a celebrity’s persona when it is associated with that person’s profession. Beyond name⁴⁸ and likeness,⁴⁹ persona can include a well-

F.2d 634, 639 (9th Cir. 1982) (upholding publicity misappropriation for false endorsement of a magazine).

⁴⁴202 F.2d 866, 868 (2d Cir. 1953). *See also* MCCARTHY, *supra* note 5, § 1.7. In the first chapter of his treatise, McCarthy explains that publicity has a deep history rooted in the right to privacy. *See id.* As the law developed, McCarthy explains that the privacy label seemed natural for the indignity suffered by people who were not public figures, who had private lives. *Id.* But even then, private persons had to claim “hurt feelings” when their complaint was for “theft of the commercial value of their identity.” *Id.* Famous people could not plausibly claim that their privacy was violated, however, when the press frequently mentioned their name and image. *See id.*

⁴⁵*See* 202 F.2d at 867.

⁴⁶*Id.* *See also* Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954) (arguing the inadequacy of privacy label since it was not assignable and could not be more than a release from liability).

⁴⁷*See* MCCARTHY, *supra* note 5, at § 4.9; *see also* Abdul-Jabbar v. General Motors Corp., 85 F.3d 407, 414 (9th Cir. 1996) (finding that use of athlete’s former name violated plaintiff’s right of publicity because it still identified plaintiff).

⁴⁸*See, e.g.,* Abdul-Jabbar, 85 F.3d at 414; *see also* Carson v. Here’s Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (finding the phrase “here’s

known race car driven by a particular driver,⁵⁰ the human voice,⁵¹ acting roles,⁵² and distinctive performances such as a human cannon ball act⁵³ and the turning of television game show letters.⁵⁴ On the other hand, the right of publicity has not been

Johnny” to be a part of Johnny Carson’s persona).

⁴⁹See, e.g., *Factors Etc. Inc. v. Creative Card Co.*, 579 F.2d 215 (2nd Cir. 1978) (discussing Elvis persona); see also *Nurmi v. Peterson*, 10 U.S.P.Q.2d 1775 (C.D.Cal. 1989) (concluding “likeness” would be infringed by actual representation rather than close resemblance); *Martin Luther King v. American Heritage*, 296 S.E.2d 697 (Ga. 1982) (misappropriating likeness by marketing a plastic sculpture of Dr. King without permission).

⁵⁰See, e.g., *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (finding that the plaintiff was identifiable as the driver in a television commercial in light of distinctive decorations appearing on the car that were particular to plaintiff’s cars).

⁵¹See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988). Cf. *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 347 (S.D.N.Y. 1973) (finding no right of publicity in the use of a performer’s voice in commercials); *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 716 (9th Cir. 1970) (“wonder[ing]” whether the claimant’s voice “would have been identifiable if another song had been presented”). These cases are addressed specifically later in this article. see discussion *infra* Section III.

⁵²See e.g., *McFarland v. Miller*, 14 F.3d 912, 921 n.15, 922 (3d Cir. 1994) (stating that an actor who has become “indistinguishable in the public’s eye from his stage persona” has developed a property right that belongs to him); cf. *Nurmi*, 10 U.S.P.Q.2d at 1777 (citing *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979) and stating that “while a Dracula character that unmistakably bore the plaintiff’s features could be subject to a right of publicity action, a generic Dracula, which might nevertheless resemble in many ways the plaintiff’s character, would not”).

McCarthy explains that an actor who plays a role so distinctively or uniquely could develop a right of publicity in either the character or in his real life image as the person who plays the character. See MCCARTHY, *supra* note 5, at § 4.13[B]. For that type of persona to develop, he continues, the actor usually creates the character, as opposed to merely popularize a “given” character, and the public must exclusively identify the actor as the character. See *id.* at §§ 4.13[B]&[C] (adding that if the actor has not developed such a publicity right, an issue of copyright infringement might remain since a character is copyrightable subject matter).

⁵³See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

⁵⁴See, e.g., *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir.

extended to a life story or biography,⁵⁵ restaurant decor or menu items,⁵⁶ Rush Limbaugh's political opinions,⁵⁷ or trading cards that parody baseball players.⁵⁸ These situations are "illustrative not exhaustive" of when publicity rights have been raised.⁵⁹ The common elements of any successful publicity claim are that the person must be "identified" for "commercial" purposes without having given his permission.⁶⁰ By virtue of the offender's commercial use of the persona, the identification has value and should be paid for.⁶¹

1992), *reh'g denied*, 989 F.2d 1512 (9th Cir. 1993) (finding a robot turning game show letters violated Vanna White's persona).

⁵⁵*See, e.g.*, *Matthews v. Wozencraft*, 15 F.3d 432 (5th Cir. 1994).

⁵⁶*See* *Elvis Presley Enters. v. Capece*, 950 F. Supp. 783, 802 (S.D.Tex 1996) (finding publicity infringement for unauthorized use of Elvis's name, pictures, and mention of Graceland in advertisements for restaurant). *See id.* at 801.

⁵⁷*See, e.g.*, *Pam Media, Inc. v. American Research Corp.*, 889 F. Supp. 1403 (D.Colo. 1995) (holding that political commentator's views in competing radio talk show did not infringe Rush Limbaugh's common law right of publicity).

⁵⁸*See e.g.*, *Cardtoons, v. Major League Baseball Players Ass'n*, 95 F.3d 959 (10th Cir. 1996) (stating that use of baseball players' likenesses on plaintiff's parody trading cards did not violate baseball player's right of publicity).

⁵⁹*See* MCCARTHY, *supra* note 5, § 4.9.

⁶⁰*See id.* at app. A-3 (stating that "the paramount message of any advertisement is 'buy'"); *see also* RESTATEMENT, *supra* note 38, at § 47 (stating that commercial use of a person's identity for "purposes of trade" occurs when goods or services are advertised, and not for "news reporting, commentary, entertainment, works of fiction or nonfiction," or incidental advertising). *But see White*, 989 at 1519-20 (Kozinski, J., dissenting) (arguing that the publicity interest should not prohibit all commercial parodies since "the line between the commercial and noncommercial . . . has disappeared").

⁶¹*See* MCCARTHY, *supra* note 5, §§ 8.12[B], 8.14[B]. The Tenth Circuit explained the main societal justifications for publicity rights: it provides an incentive to create and achieve; it preserves the value of notoriety and celebrity for advertisers and for the public; it protects against consumer deception, unjust enrichment, and emotional injury. *See Cardtoons*, 95 F.3d at 973.

II. The General Preemption Analysis Concerning Federal Copyrights and State Publicity Rights

Publicity rights and copyrights collide because the “persona” includes anything that identifies the person, including copyrightable material as part of a creative expression. For example, a person’s facial features, constituting a persona, are readily identifiable in a cartoon character drawing, which is a copyrightable work. When the two rights conflict, the question becomes whether federal copyright law preempts a state publicity claim. In the majority of cases that have addressed this question, courts have held copyright law does not preempt state publicity claims⁶² despite an ambiguous legislative history⁶³ and a smaller dissenting view supporting preemption.⁶⁴

A. *Why is Preemption an Issue?*

Preemption is the supremacy of federal law over state law on the same issue. Under the Supremacy Clause of the Constitution,⁶⁵ there are three situations where federal law preempts state law: 1) where Congress expressly states; 2) where federal regulation is so extensive there is “no room” for state law; and 3) where federal and state law conflict.⁶⁶ The third type of preemption applies in the context of federal copyright and state publicity rights. In an attempt to provide guidance, Congress enacted § 301 of the Copyright Act.⁶⁷ Nonetheless, the language and history of § 301 has not created the bright line between state protections and federal copyright that Congress intended.⁶⁸ Section 301 dictates that preemption occurs when a state grants “legal or equitable rights that are equivalent to any of the exclusive rights” of copyright.⁶⁹ Despite § 301, “conflict preemption,” another type of preemption, exists where a state law “stands as an obstacle to the accomplishment of the full purposes

⁶²See *infra* notes 79-89 and accompanying text.

⁶³See *infra* notes 73-78 and accompanying text.

⁶⁴See *infra* notes 90-98 and accompanying text.

⁶⁵See U.S. CONST. art. IV, § 2, cl. 1.

⁶⁶See NIMMER, *supra* note 2 at § 1.01 [B][3][a] n. 258.1.

⁶⁷See 17 U.S.C. § 301.

⁶⁸See MCCARTHY, *supra* note 5, § 1.01[B].

⁶⁹17 U.S.C. § 301(a).

and objectives of Congress.”⁷⁰ Under either type of preemption, Congressional intent is important, but determining what Congress intended is sometimes guesswork

B. Preemption Under § 301 of the Copyright Act

Section 301 of the Copyright Act expressly states the terms of federal copyright preemption.⁷¹ For a state law, such as a right of publicity, to be preempted by federal copyright there are two requirements: 1) the state right must be contained in a work that comes within the subject matter of federal copyright (a work of authorship or fixed in a tangible medium of expression);⁷² and 2) the state right must be equivalent to any one of the exclusive rights contained in §106 of the Copyright Act.⁷³ The test is conjunctive; both prongs must be met for the Act to preempt state

⁷⁰Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 479 (1974) (quoting *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941)); *see also* discussion *infra* Section III.

⁷¹*See* 17 U.S.C. § 301 stating:

(a) On or after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right in any such work under the common law or statutes of any State.

(b) Nothing in this title annuls or limits rights or remedies under the common law or statutes of any State with respect to (1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or . . . (3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106. . . .

⁷²*See* 17 U.S.C. §§ 102, 103 (describing the subject matter that is protectable under the Copyright Act). *See also* copyright discussion *supra* Section I.

⁷³*See* *Fleet v. CBS, Inc.*, 50 Cal.App.4th 1911, 1919 (1996). *See also* copyright discussion *supra* Section I.

law. In light of § 301's legislative past, the majority of courts have held against preemption while a minority view continues to support preemption.

C. Section 301's Ambiguous Legislative Past

Section 301 has an ambiguous legislative past, especially in its application to the right of publicity. Earlier drafts of § 301 contained a list of state rights that would not be preempted by the Copyright Act.⁷⁴ Included in this list was the right of privacy, which is the foundation of the right of publicity.⁷⁵ However, Congress did not include the list in the statute as enacted, resulting in confusion over congressional intent.⁷⁶ For example, in *Baltimore Orioles v. Major League Baseball Players Ass'n*,⁷⁷ the Seventh Circuit grappled with this ambiguous legislative history and opined that “almost any interpretation of . . . equivalent rights can be inferred from the legislative history.”⁷⁸ As a result, the court chose to “place little weight on the deletion of the list of nonequivalent rights.”⁷⁹ In the end, to avoid an overly broad interpretation of the legislative history, courts have not heavily relied upon § 301's history.

⁷⁴See NIMMER, *supra* note 2, at § 1.01[B][1].

⁷⁵See MCCARTHY, *supra* note 5, at ch.1.

⁷⁶See *Baltimore Orioles*, 805 F.2d at 676-77 n.25; see also NIMMER, *supra* note 2, at § 1.01[B][1][f][ii]. The Historical Notes to § 301 state that publicity claims “remain unaffected as long as the [publicity] cause of action contains elements, such as an invasion of personal rights or a breach of trust or confidentiality, that are *different in kind* from copyright infringement.” 17 U.S.C. § 301 (emphasis added) (quoting H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 131, reprinted in 1976 U.S.C.C.A.N 5659, 5747).

⁷⁷805 F.2d 663, 675 (7th Cir. 1986).

⁷⁸*Id.* at 677 n.25. The case of *Architectronics, Inc. v. Control Sys., Inc.*, is another good illustration of how § 301 can be interpreted differently as a result of what Congress did not pass. 935 F. Supp. 425, 440 (S.D.N.Y. 1996). There, the court rejected a lower court's reasoning that elimination of the “safe harbor” list suggests that Congress intended to preempt the causes of action on the list; instead, the court concluded that there was “nothing ... to suggest that this was the motive behind the deletion.” *Id.* at 440-41. Further, the *Architectronics* court also stated that there was a “widely-shared belief” that the legislative history of § 301 is “puzzling and unreliable.” *Id.* (citations omitted).

⁷⁹805 F.2d at 677.

D. The Majority View: Federal Copyright Does Not Preempt State Publicity Rights under § 301

Most courts⁸⁰ and a leading commentator on the topic⁸¹ agree that federal copyright does not preempt state publicity rights. Under this view, when the right of publicity is measured against both prongs of § 301, it is not preempted by federal copyright. The first prong of § 301 is not met because the basic human persona is not a work of authorship that is fixed, despite the fact that a *particular depiction of it* can be fixed.⁸² For example, a photograph of yourself contains a valid copyright and a particular depiction of your persona. McCarthy explains that “[t]here is an obvious overlap between the legal theories of copyright, . . . and infringement of the rights of publicity . . . when a photographer uses a portrait without the permission of the subject.”⁸³ Under § 301 analysis, a copyright in a photograph only protects “the particular depiction, not . . . the underlying likeness of the person depicted.”⁸⁴

Under the second prong of the § 301 test, publicity — the *protection* of that which identifies the persona — is not equivalent to any of the *exploitative* rights granted by the Copyright Act, such as the right to reproduce, distribute, or perform a work.⁸⁵ Nimmer’s own famous “extra-element” test explains the equivalency prong

⁸⁰See RESTATEMENT, *supra* note 38, § 46 cmt. i.

⁸¹See, e.g., MCCARTHY, *supra* note 5, at § 11.14[C].

⁸²See, for example, *Bi-Rite Enters. v. Button Master*, 555 F. Supp. 1188 (S.D.N.Y. 1983), where the court stated that “intangible proprietary interest protected by the right of publicity simply does not constitute a writing” and was not preempted. *Id.* at 1201 (quoting *Lugosi*, 603 P.2d at 448 (Bird, C.J., dissenting)).

⁸³MCCARTHY, *supra* note 5, at § 11.14[A][2].

⁸⁴RESTATEMENT, *supra* note 38, at § 46 cmt. i. (adding that copyrights in a film or in a sound recording of a performance will not “create exclusive rights in the identifying characteristics of the performer”).

⁸⁵See MCCARTHY, *supra* note 5, at § 11.13[C][3]; 4.14[E] (emphasis added). *But see* *Ahn v. Midway Mfg. Co.*, 965 F. Supp. 1134, 1137 (N.D. Ill. 1997) (finding right of publicity “equivalent to one of the rights in § 106 because [publicity] is infringed by the act of distributing, performing, or preparing derivative works,” but without additional discussion or analysis.).

The right of publicity is related to the larger body of commercial torts known as unfair competition. See MCCARTHY, *supra* note 5, at § 11.13[A][2]. Commercial gain includes advertising or promoting goods and services, but generally does not include “news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such use.” RESTATEMENT, *supra* note 38, at §

clearly.⁸⁶ He posits that § 301 preempts any state law that is broken solely by the act of reproduction, performance, distribution, or display since that state law would function in the same way as federal copyright.⁸⁷ By contrast, if the state law is broken by conduct that is “qualitatively different” from reproduction, performance, distribution, or display, then the state law is not preempted.⁸⁸ In other words, an additional element of proof, beyond what is necessary to establish copyright infringement, would make the state law right fall outside the scope of rights granted by federal law.⁸⁹ In that event, a valid publicity claim would not be preempted because it requires proof the violation is “commercial in nature.”⁹⁰

E. The Dissenting Views: Federal Copyright Law Does Preempt State Publicity Rights

There is a minority view that supports the preemption of state publicity rights. There is limited support for the view that federal copyright does preempt state publicity rights.⁹¹ Specifically, the Seventh Circuit in *Baltimore Orioles, Nimmer*,

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⁸⁶See NIMMER, *supra* note 2, at § 1.01[B][1].

⁸⁷See *id.* This is true even if the state law requires more or less proof of illegality compared to proof of copyright infringement. See *id.* at n.60 (citing Harper & Row, Publishers, Inc. v. Nation Enters., Inc., 501 F. Supp. 848, 852 (S.D.N.Y. 1980)).

⁸⁸See NIMMER, *supra* note 2, at § 1.01[B][1].

⁸⁹See *id.*

⁹⁰See discussion *infra* Section I.

⁹¹See Apfelbaum, *supra* note 29, at 1593. Apfelbaum, however, qualifies that state laws protecting the publicity right in works that are not fixed, and state privacy laws that are distinguishable from the right of publicity, should not be preempted. He also argues that the threat of a publicity complaint, infringement of which allows for money damages and injunctions, can curtail the production of creative works that use individuals as subjects. See *id.* at 1572 n.48 (stating that federal copyright protection was intended to promote national uniformity for author’s rights and that protection is more important in modern times where dissemination of artistic works is faster and broader). See also David E. Shipley, *Publicity Never Dies; It Just Fades Away: The Right Of Publicity And Federal Preemption*, 66 CORNELL L. R. 673 (1981).

and other legal scholars have endorsed this view.⁹² In *Baltimore Orioles*, the court concluded that federal copyright protection in videotaped baseball games preempted the players' publicity claims.⁹³ The court dismissed contrary judicial opinions as "premised upon an erroneous analysis of preemption."⁹⁴ The Seventh Circuit's controversial conclusion rested on the premise that baseball games are copyrightable works of authorship.⁹⁵ According to Nimmer, the preeminent copyright commentator, this conclusion was wrongly decided because *inter alia* it was made without authority and it ignored the fact that game performances are not original works.⁹⁶ Baseball players are not authors or artists, just as the people who pose for pictures or paintings are neither authors nor artists.⁹⁷ A sports game is an event, "[t]he protected work is the telecast, and it owes its origin to the creative activities of the broadcaster's employees."⁹⁸ The preemption result in *Baltimore Orioles* is an anomaly in light of the many cases that deny preemption.⁹⁹

III. The "Conflict" Preemption Analysis Applied to Soundalike Recordings

Outside § 301 of the Copyright Act, preemption may be found where state law conflicts with federal law. Under this type of preemption analysis, Nimmer argues that whether publicity claims in the singer's voice are preempted by federal copyright protection granted to a soundalike recording is an open issue. He strongly suggests that federal copyright does preempt because state publicity rights fail the conflict preemption test.

⁹²805 F.2d 663. See also NIMMER *supra* note 2; Apfelbaum *supra* note 28.

⁹³805 F.2d at 679.

⁹⁴*Id.* at 678 n.26.

⁹⁵See *id.* at 679.

⁹⁶See NIMMER, *supra* note 2, at § 2.09[F]. But see *Fleet*, 50 Cal. App. 4th at 1922 (discussing Nimmer's conclusion that sporting events are not copyrightable but expressing "no opinion as to its correctness").

⁹⁷See David E. Shipley, *Three Strikes and They're Out*, 20 ARIZ. L.J. 369, 387 (1988).

⁹⁸*Id.*

⁹⁹See RESTATEMENT, *supra* note 38, at § 46, Reporter's Note, cmt. 1.

A. “Conflict” Preemption

Can copyright preemption exist *outside* § 301? As discussed previously, § 301 only preempts state laws that provide the same rights to copy the same subject matter protected under the Copyright Act.¹⁰⁰ Section 301, however, “ignores any questions of *underlying values*, goals, or purposes of the copyright statute or of the Copyright Clause.”¹⁰¹ Thus, to what degree can “a state regulate the use of copyrighted material without unconstitutionally impinging on the exercise of the rights granted by § 106?”¹⁰² This type of analysis contemplates “conflict” preemption in terms of state law interference with “the accomplishment and execution of the full purposes and objectives of Congress.”¹⁰³

B. Nimmer’s Argument for Conflict Preemption of Publicity Rights in Performer’s Voices That Are Embodied in Soundalike Recordings

In his treatise, Nimmer argues that copyrights in soundalike recordings preempt publicity rights in the imitated performers’ voices. He reasons that if Congress intended to promote the creation of soundalike recordings and if state publicity claims in performers’ voices prohibit the exploitation of these recordings, Congressional intent would be thwarted.¹⁰⁴ He points out that under § 114(b) of the Copyright Act, Congress wanted to encourage the creation of soundalike recordings because there is no penalty against those who intentionally imitate the recording, unless the originally recorded sounds are taken.¹⁰⁵

Nimmer explains the courts in *Midler v. Ford Motor Co.*¹⁰⁶ and *Waits v. Frito-Lay*¹⁰⁷ applied the wrong preemption standard to determine whether publicity

¹⁰⁰See 17 U.S.C. § 301.

¹⁰¹Abrams, *supra* note 1, at 580 (emphasis added).

¹⁰²*Id.* at n.285.

¹⁰³*Degar v. MITE Corp.*, 457 U.S. 624, 631 (1982).

¹⁰⁴See NIMMER, *supra* note 2, at § 1.01[B][3][b].

¹⁰⁵See *id.* (discussing 17 U.S.C. § 114 (1994)). But, sound recordings fixed prior to 1972 are not protected by federal copyright, therefore states may provide copyright protection. See Bruce J. McGiverin, *Digital Sound Sampling, Copyright and Publicity: Protecting Against the Electronic Appropriation of Sounds*, 87 COLUM. L. REV. 1723 (1987).

¹⁰⁶849 F.2d 460 (9th Cir. 1988) [hereinafter *Midler*].

¹⁰⁷978 F.2d 1093 (9th Cir. 1992) [hereinafter *Waits*].

claims in a performer's voice contained in a soundalike recording were preempted.¹⁰⁸ In *Midler*, the defendant, an advertising agency, bought a license from the copyright owner to use a song that Bette Midler, a well-known singer, had recorded.¹⁰⁹ Midler was offered but turned down the opportunity to sing in a television commercial.¹¹⁰ Subsequently, the agency hired a Midler soundalike singer instead.¹¹¹ Midler did not seek damages or an injunction in connection with the use of the song, but rather sought to protect her publicity right in her voice, an interest not "fixed" and not copyrightable under § 301.¹¹² The *Midler* court stated that the human voice is not copyrightable, it is not fixed in its natural state and "is more personal than any work of authorship."¹¹³ The court added that the human voice is inextricably part of someone's identity.¹¹⁴ To impersonate a well-known singer's voice, the court said, is to "pirate her identity."¹¹⁵ Therefore, the court reasoned, her publicity claim was not preempted.¹¹⁶

Analogizing to federal copyright, the *Midler* court recognized that imitation of a recorded performance would not be infringement "even where one performer deliberately sets out to simulate another's performance as exactly as possible."¹¹⁷ The court cautioned that some imitation of the voice used in advertisements would not be actionable and consequently limited its holding to cases in which "a *distinctive* voice of a professional singer is *widely known* and is deliberately imitated in order to sell a product[.]"¹¹⁸ The court stated that in such cases, "the seller has appropriated

¹⁰⁸ See NIMMER, *supra* note 2, at § 1.01[B][3][b].

¹⁰⁹ *Midler*, 849 F.2d at 461-62.

¹¹⁰ *See id.* at 461.

¹¹¹ *See id.* at 461-62.

¹¹² *See id.* at 462. Comparatively, Nancy Sinatra failed to prevent the same advertising agency from imitating her voice and "look" because she had not established her voice beyond the one song she was famous for, "*These Boots are Made For Walkin'*." But, if another song had been presented, the court "wonder[ed]" whether her voice would have been "identifiable." *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 716 (9th Cir. 1970).

¹¹³ *Midler*, 849 F.2d at 462.

¹¹⁴ *See id.* at 463.

¹¹⁵ *Id.*

¹¹⁶ *See id.*

¹¹⁷ *Id.* at 462 (quoting the Committee on the Judiciary, 17 U.S.C.A § 114(b)).

¹¹⁸ *Id.* at 463.

what is not theirs and has committed a tort in California.”¹¹⁹

Although Nimmer views the *Midler* court’s rationale as one that “validly applies” § 301, Nimmer criticizes its conclusion because the court did not address conflict preemption’s key question: whether “a state law [can] forbid that which Congress intended to validate?”¹²⁰ To support his criticism, Nimmer points out that the court did not cite any section in the Copyright Act or to legislative history in which Congress stated that it would allow states to regulate soundalike recordings *only* in the commercial context.¹²¹ Absent supporting authority, he argues that “it is difficult to maintain that Congress intended” states to prohibit soundalike recordings via enforcement of publicity rights.¹²² This point has some support in *Motown Record Corp. v. George A. Hormel & Co.*¹²³ There, the defendant’s television advertisement for “Dinty Moore” beef stew featured three women who looked and acted like “The Supremes” singing “*Dinty Moore, My Dinty Moore*” to the well known tune of “*Baby Love*.”¹²⁴ The court preempted the state likeness claims because “the basic act which constitute[d] the alleged [publicity] infringement — the unauthorized use of plaintiffs’ composition — [was] the same as that of copyright[.]”¹²⁵ Further, the court stated that although the publicity statute required a “connection with the advertising of a product, unlike copyright, [it was] not a *qualitative* extra element which changes the nature of the action.”¹²⁶

¹¹⁹*Id.*

¹²⁰NIMMER, *supra* at note 2, at § 1.01 [B][3][b].

¹²¹*See id.* at n.283 (emphasis added).

¹²²*Id.*

¹²³657 F. Supp. 1236 (C.D. Cal. 1987) [hereinafter “*Motown*”].

¹²⁴*See id.* at 1237.

¹²⁵*Id.* at 1240-41. Nimmer explains that “to the extent that a plaintiff alleges a right of publicity violation of a copyrightable work, preemption lies.” NIMMER, *supra* note 2, at § 1.01[B][1][c] n.87.

The *Motown* court, however, cautioned that the state likeness statute “might not always be preempted by copyright law.” *Motown*, 657 F. Supp. at 1240. The court added that the “plaintiffs may be able to show some kind of protectable interest in the ‘persona’ of ‘The Supremes’” under § 43(a) of the Lanham Act. *Id.* at 1241. For further reading on the right of publicity’s interaction with trade symbols and the Lanham Act, see MCCARTHY, *supra* note 5, §§ 3.2, et. seq., 5.2 et seq.; *see also* Houdek, *supra* note 24, at 400 (citations omitted).

¹²⁶*Motown*, 657 F. Supp. at 1240 (emphasis in the original).

Similarly, Nimmer criticizes another case that denied preemption. In *Waits v. Frito Lay*, advertisers imitated singer Tom Waits's voice after he specifically declined to endorse the product Doritos.¹²⁷ The Ninth Circuit held that under § 301, federal copyright did not preempt Waits's publicity claim.¹²⁸ However, Nimmer argues that the *Waits* court failed to address "conflict preemption."¹²⁹ He states that the *Waits* court quoted from legislative history that did not address the Copyright Act's soundalike provision.¹³⁰ He flatly states that the *Waits* Court "misse[d] the target entirely."¹³¹

IV. Nimmer's "Conflict" Preemption Argument, Which Would Deny Publicity Claims Embodied in the Human Voice, Could Justify the Misappropriation of Persona for Commercial Gain by Unscrupulous Advertisers.

Nimmer's argument, although cogent and plausible, would lead to unjust results because it leaves a person's valuable persona unprotected. Although Nimmer presents valid criticism of the Ninth Circuit's analysis in both *Midler* and *Waits*, without protection performers could be associated with a product or service against their will and mislead the public. Despite its plausibility, the right legal analysis should not justify the theft of valuable property.

The problems of leaving publicity unprotected is especially troubling when one considers that Congress did not indicate — one way or the other — whether it intended to allow states to regulate sound recordings used to sell a product or service. In the context of legislative silence, it is just as likely that Congress did not intend to permit theft of valuable property for commercial gain and cause the associated public confusion.¹³²

¹²⁷978 F.2d at 1096-98.

¹²⁸*See id.* at 1100.

¹²⁹*See* NIMMER, *supra* at note 2, at § 1.01 [B][3][b].

¹³⁰*Id.* (adding that the court "set the analysis backwards by conflating the legislative history from two entirely different provisions.").

¹³¹*Id.*

¹³²For example, in *Rodgers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989) the court noted that publicity rights prohibit the commercial use of a name in a title when it is "simply a disguised commercial advertisement for the sale of goods or services." The result in *Rodgers* suggests a more reasonable and equitable approach that recognizes publicity rights in performers' voices and prohibits misuse of

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Cases such as *Midler* and *Waits* present an important victory for plaintiff performers where persona is used for commercial gain without their consent. As *Waits* and *Midler* reveal, commercial advertisers who promote a product or a service have deliberately tried to mislead the public when they present soundalikes as the real thing. Plainly, a performer who has a valid publicity claim in her voice should not be associated with a product or service against her wishes. It is unlikely that Congress intended the harsh results of someone's persona being used without consent.

Publicity rights are no different from other laws that already exist and limit the exercise of copyright; a federal copyright is not a license to disregard other laws.¹³³ Hence, it is misleading, if not disingenuous, to argue that any legal limitation imposed on the copyright user "conflicts" with the policies advanced by federal copyright law. Competing rights, such as parody or free speech, should apply when they are cognizable, and should prevail based on the merits of the claim.

An appropriate standard would not summarily dismiss these vocal publicity claims as Nimmer suggests. Instead, vocal publicity claims should receive the same treatment that other claims are subjected to, regardless of the defense: are they valid? Either way, valid or not, the preemption issue is not implicated. Moreover, allowing these publicity claims to prevail will not hamper the free production of soundalikes outside of commercial advertising mostly because there are few, if any, true soundalikes made outside of commercial advertising.

V. Conclusion

Generally, federal copyright should not preempt state publicity rights. This is best understood not from the perspective of federal copyright, but from the perspective of state publicity rights. Commercial exploitation of that which identifies persona is the gravamen of the publicity claim, and as such, presents no conflict with the interests protected by federal copyright. In any case, if the publicity claim asserts rights over a particular copyrighted work,¹³⁴ such as a sculpture or song, and not the identity of the person, it will be preempted . . . or more accurately, the publicity claim would fail.

Preemption of publicity rights has a magnetic appeal for those who believe

someone else's property.

¹³³See MCCARTHY *supra* at note 5, at § 11.14[C].

¹³⁴See NIMMER, *supra* note 2, at § 1.01[B][1][c], n.87 (citing *Motown*, 657 F. Supp. 1236 (C.D.Cal. 1987)).

that publicity rights may have expanded too far, including the author who began writing this Article thinking that most state publicity rights have grown out of control. The right of publicity is a legal concept that is a work-in-progress that is relatively new and its limits are still being defined.¹³⁵ Once the right of publicity is understood as protection of anything that identifies someone in a commercial context, the faulty practice of analogizing the right of publicity to copyright,¹³⁶ or some other form of intellectual property concept, can stop, and the interests valued by the legitimate publicity complainant can be protected.

¹³⁵See SHELDON W. HALPERN, *THE LAW OF DEFAMATION, PRIVACY, PUBLICITY, AND MORAL RIGHT* 601 (2d ed. 1993).

¹³⁶*See id.*