When the Lifeblood of Competition Creates a Likelihood of Confusion: Waits v. Frito-Lay, Inc

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WHEN THE LIFEBLOOD OF COMPETITION CREATES A LIKELIHOOD OF CONFUSION: WAITS V. FRITO-LAY, INC.

He sounds "like how you'd sound if you drank a quart of bourbon, smoked a pack of cigarettes and swallowed a pack of razor blades . . . . Late at night. After not sleeping for three days." Should such a distinctive voice be protected from imitation by a commercial advertiser? The Ninth Circuit Court of Appeals recently held in Waits v. Frito-Lay, Inc. that Tom Waits's voice, described above, deserves protection. This holding has far-reaching implications for singers and advertisers alike because of the constraints it places on advertising freedom.

I. BACKGROUND

At the suggestion of its advertiser, Frito-Lay made a radio advertisement for SalsaRio Doritos in a style suggestive of one of Tom Waits's songs. During auditions for singers, the advertiser, Tracy-Locke, looked for a singer who could sing in a gravelly style. While executives from Tracy-Locke and Frito-Lay were displeased with initial efforts using a singer with a deep "bluesy" voice, they did approve of Stephen Carter, a professional musician recommend-
Carter's imitation was so convincing that the executives were concerned about legal problems from its use. Tracy-Locke's managing vice-president, Robert Grossman, consulted the company's attorney on the day the commercial was to be released. The attorney advised Grossman that although there was a risk of legal problems because of a recent case recognizing the protectability of a distinctive voice, a suit by Waits would not stand because there is no protectability of a singer's style of music. Grossman then warned Frito-Lay of the legal risks of using Carter's voice, but still recommended the Carter version and agreed that Tracy-Locke would indemnify Frito-Lay should a legal controversy arise.

The advertisement for SalsaRio Doritos ran on over 250 radio stations in sixty-one markets. Upon hearing the ad and realizing that people might mistakenly think he endorsed Doritos, Waits filed an action against Tracy-Locke and Frito-Lay seeking $2.3 million in compensatory damages for misappropriation under California law and false endorsement under the Lanham Act. At trial, Waits prevailed with the jury awarding him $375,000 in compensatory damages and $2 million in punitive damages for the voice misappropriation claim, and $100,000 for the Lanham Act claim. On appeal, the Ninth Circuit vacated the damage award under the Lanham Act as duplicative, but otherwise affirmed the

8 Carter had performed Waits's songs with his band for ten years and had perfected his imitation. Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1097 (9th Cir. 1992), cert. denied, 113 S. Ct. 1047 (1993).
9 During the recording session, Tracy-Locke's executive producer asked Carter to tone down his imitation of Waits. Id. at 1097-98. In addition, the producer recorded an alternative version of the ad with a different singer. Id. But Frito-Lay and the creative team did not approve of the results, and the original version was used. Id.
10 Id. The commercial was broadcast in September and October of 1988 on over 250 radio stations in 61 markets across the country. Id.
12 Waits, 978 F.2d at 1098.
13 Id.
14 Id.
15 Id.
16 Id. Waits also received attorneys' fees under the Lanham Act. Id.
II. THE NINTH CIRCUIT'S ANALYSIS IN WAITS

In Waits, the Ninth Circuit upheld the trial court and reaffirmed its previous decision in Midler v. Ford Motor Co., a case that recognized as a California tort voice misappropriation, which imposes liability on anyone who uses a professional singer's distinctive voice for commercial purposes without the singer's consent. In addition, the Ninth Circuit decided a question of first impression—whether under section 43(a) of the Lanham Act one can recover for false endorsement.

On the issue of voice misappropriation, the Waits defendants argued against the viability of the tort on two grounds: first, that the Midler decision was "impliedly overruled" by the Supreme Court's decision in Bonito Boats, Inc. v. Thunder Craft Boats, Inc., and second, that the tort of voice misappropriation, an-

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17 Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1111 (9th Cir. 1992), cert. denied, 113 S. Ct. 1047 (1993). Thus, the final amount the court awarded was $2,500,000.

18 849 F.2d 460 (9th Cir. 1988), cert. denied, 112 S. Ct. 1513 (1992).

19 Id. at 463 (holding 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 in California").


(a)(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

21 Waits, 978 F.2d at 1099 (citing Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141 (1989), which held that Florida statute designed to protect boat hull designs was preempted by federal patent law), cert. denied, 113 S. Ct. 1047 (1993).
nounced in *Midler*, was preempted by the federal Copyright Act.\(^{22}\)

In arguing that *Bonito Boats* overruled *Midler*, the defendants contended that the *Midler* decision ignored two cases, *Sears Roebuck & Co. v. Stiffel Co.*\(^{23}\) and *Compco Corp. v. Day-Brite Lighting*,\(^{24}\) which were cited in *Bonito Boats* for the proposition that "publicly known design and utilitarian ideas which were unprotected by patent" are expressly unprotected.\(^{25}\) The defendants reasoned that the citation in *Bonito Boats* to *Sears* and *Compco* reaffirmed the broad preemption principles for which those two cases once stood; therefore, the defendants argued, since *Midler* did not cite to *Sears* and *Compco*, the case was incorrectly decided.

The Ninth Circuit, however, pointed to several flaws in the defendants' arguments. First, the court noted that *Bonito Boats* warns against reading a "broad preemptive principle" into *Sears* and *Compco*, and that cases subsequent to *Sears* and *Compco* retreat from any such broad interpretation.\(^{26}\) Accordingly, the court held that *Bonito Boats* does not sanction the liberal reading of *Sears* and *Compco* that defendants argued should preempt Waits's state misappropriation claim.\(^{27}\) The *Waits* court also recognized a state's authority to protect entertainers' "right of publicity," a power implied by the Supreme Court in *Zacchini v. Scripps-Howard Broadcasting Co.*\(^{28}\) According to the court, because the defense cited cases decided before *Zacchini*, the *Midler* decision was still good authority.\(^{29}\)

\(^{22}\) *Id.* The court reviewed these two questions of law *de novo*.

\(^{23}\) 376 U.S. 225 (1964) (holding that because of federal patent law, state may not prohibit copying of article that is unpatented or uncopyrighted).

\(^{24}\) 376 U.S. 234 (1964) (holding that copier of plaintiff's unpatented fluorescent lighting fixtures was not liable because, where article is unprotected by patent or copyright, state law may not ban others from copying that article).

\(^{25}\) Waits, 978 F.2d at 1099 (citing Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 152 (1989)).

\(^{26}\) *Id.* at 1099. Additionally, the *Waits* defendants argued that earlier cases that denied entertainers' suits for performance imitations based on federal copyright preemption were correctly decided because they relied on *Sears* and *Compco*. *Id.*

\(^{27}\) *Id.* at 1099.

\(^{28}\) *Id.* (citing Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977), in which the Supreme Court deemed state right-of-publicity law was not preempted by federal patent and copyright law). *See also infra* notes 47-50 and accompanying text (discussing *Zacchini* decision and its contribution to development of right of publicity).

\(^{29}\) *Id.* at 1100.
For their second argument, the Waits defendants asserted that the voice misappropriation action is preempted by the Copyright Act. The Ninth Circuit rejected this argument and affirmed the Midler holding that a voice is not copyrightable subject matter. According to the court, Waits sought to protect his identity as represented in his distinctive voice, a claim which contained elements “different in kind” from copyright elements and, thus, was not preempted by federal copyright law.

In addition to upholding the validity of the California tort of voice misappropriation, the Ninth Circuit examined a question of first impression in Waits: whether or not false endorsement claims are properly brought under section 43(a) of the Lanham Act. In its analysis, the Waits court initially noted that other jurisdictions have interpreted the language of section 43(a) as supporting false endorsement claims. The court then cited other cases that recognized well-known plaintiffs’ false endorsement claims. These cases involved the unsanctioned impersonation of distinctive attributes when those distinctive features constituted an unregistered commercial “trademark.”

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31 Waits, 978 F.2d at 1100. The Midler court held that a voice is not copyrightable because copyright protects “original works of authorship fixed in any tangible medium of expression” and a voice is not “fixed.” Midler v. Ford Motor Co., 849 F.2d 460, 462 (9th Cir. 1988), cert. denied, 112 S. Ct. 1512 (1992).

32 Waits, 978 F.2d at 1100.

33 Id.


In support of the cited case law, the court pointed to the 1988 Lanham Act amendments. In particular, the court stated that amended section 43(a) now expressly prohibits “the use of any symbol or device which is likely to deceive consumers as to the association, sponsorship, or approval of goods or services by another person.” Based on these considerations, the court determined that false endorsement claims, even those involving an unofficial simulation of a recognizable voice, are valid under section 43(a) of the Lanham Act.

III. LEGAL HISTORY FOR THE PROTECTION OF A VOICE

A. VOICE MISAPPROPRIATION

The tort of voice misappropriation stems from the right of publicity (i.e., that a person has a right to control the commercial property rights in his or her persona). Thus, when an advertiser imitates some aspect of a plaintiff’s persona for commercial profit, the advertiser has infringed on the plaintiff’s right of publicity.

The first formal recognition of this proprietary right came in Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., in which the court acknowledged that an assignee of a baseball player had

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37 Id. (holding that, although 1988 amendments to Lanham Act did not become effective until November 1989, more than one year after Frito-Lay’s offensive commercial aired, amendments were useful as codification of earlier case law that construed section 43(a) to encompass false endorsement claims).

38 Id. (pointing to legislative history of 1988 amendments, which clarifies that, “in retaining the statute’s original terms ‘symbol or device’ in the definition of ‘trademark,’ Congress approved the broad judicial interpretation of these terms to include distinctive sounds and physical appearance”).

39 Id. at 1107. The court ruled that Waits had standing to sue under the Lanham Act, even though he was not in competition with the defendants, because of the likelihood that the “wrongful use of his professional trademark, his voice, would injure him commercially.” Id. at 1110. Although the court affirmed judgment for Waits based on his Lanham Act claim, they vacated the associated damage award as duplicative. Id. at 1112.


41 White v. Samsung Elec. Am., Inc., 971 F.2d 1395, 1397-99 (9th Cir. 1992) (holding that game show hostess had right of publicity claim against advertiser whose ad depicted robot dressed similar to plaintiff); Margolin, supra note 40, at 491.

42 202 F.2d 866 (2d Cir. 1953) (holding that person has right of publicity in value of his photograph), cert. denied, 346 U.S. 816 (1953).
the right to prevent unauthorized commercial use of the player's identity.\textsuperscript{43} Subsequently, legal commentators began to lay the groundwork for development of the right,\textsuperscript{44} and courts expanded a person's right to protect her proprietary interest in her own identity.

For example, in the landmark case of \textit{Motschenbacher v. R.J. Reynolds Tobacco Co.},\textsuperscript{45} the Ninth Circuit held that a person is entitled to legal protection of the proprietary interest she has in her own identity.\textsuperscript{46} Further support for the right of publicity arose in the Supreme Court’s decision in \textit{Zacchini v. Scripps-Howard Broadcasting Co.}\textsuperscript{47} Although this case turned on a constitutional issue,\textsuperscript{48} the decision impacted development of the publicity right because the Supreme Court repeatedly mentioned the right as an identifiable legal principle.\textsuperscript{49} After this recognition by the Supreme Court, other cases extended the right of publicity to cover additional aspects of plaintiffs’ personas.\textsuperscript{50}

The Ninth Circuit first expanded an individual’s proprietary interest in his identity to include a voice in \textit{Midler v. Ford Motor Co.}\textsuperscript{51} There, the court held that Bette Midler stated a tort cause

\textsuperscript{43} Id. at 868.
\textsuperscript{47} 433 U.S. 562 (1977).
\textsuperscript{48} Id. at 827. In \textit{Motschenbacher}, a tobacco company altered a picture of a professional race car driver's distinct car and used the picture in a cigarette advertisement. Although the picture did not clearly identify the driver, the court of appeals noted that the advertisements caused some people to infer that the driver sponsored defendant's cigarettes. The court expanded the right of publicity to encompass the case. \textit{Id.}
\textsuperscript{49} Id. at 822 (9th Cir. 1974).
\textsuperscript{50} Id. at 569-79 (discussing whether First Amendment protects press from having to pay performer for making unauthorized reproduction of his human cannonball performance on local news).
\textsuperscript{51} Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988), cert. denied, 112 S. Ct. 1513 (1992). One legal commentator stated that the \textit{Midler} decision “will likely prove to be the precedent for the 1990s.” Margolin, \textit{supra} note 40, at 506 (citing J. THOMAS MCCARTHY, \textit{RIGHTS OF PUBLICITY & PRIVACY § 4.14(C), at 4-89 (1988)).
of action under California law against Ford Motor Company and its advertising agency, Young & Rubicam, Inc., for the unauthorized imitation of her voice in an automobile advertisement.\

To arrive at this conclusion, the court engaged in a series of analyses, involving the possibility of First Amendment protection, the question of federal copyright preemption, and an examination of California Civil Code sections. The court initially noted that a First Amendment defense is sometimes available for the media when it reproduces likenesses or sounds, depending on the media's purpose behind using a person's identity. For instance, a defense for reproduction may exist if the purpose is "informative or cultural." Yet, if the purpose "merely exploits the individual portrayed, immunity will not be granted." In Midler, no First Amendment defense was available to Ford Motor Company and Young & Rubicam because they used Midler's unique sound purposely to exploit her identity.

The Midler court also determined that federal copyright law did not preempt the plaintiff's claim. The court analogized Midler's
case to *Lahr v. Adell Chemical Co.*, an earlier case in which a company imitated a celebrity's voice in an advertisement. In *Lahr*, the plaintiff was allowed to recover because his voice was distinctive in pitch, accent, inflection, and sound.

Finally, the court examined whether Midler could recover under sections 3344 and 990 of the California Civil Code. Under section 3344, which allows a plaintiff to recover when a defendant misuses the plaintiff's distinctive characteristics, the court determined that the defendants did not use Midler's name or any of the other attributes covered under the section, and therefore, Midler

arrangements; Sinatra based her unfair competition claim on an argument that her arrangement had a secondary meaning entitled to protection. However, the *Sinatra* court held that to allow the singer to recover for defendants' use of the song would "clash" with federal copyright law. *Sinatra*, 435 F.2d at 717-718. The *Midler* court held that, unlike Sinatra, Midler did not claim that her song had a secondary meaning and did not seek to prevent the defendants from using her song. Therefore, Midler's suit was not preempted by federal copyright law. *Midler*, 849 F.2d at 462.

300 F.2d 256 (1st Cir. 1962) (holding that comic entertainer had cause of action for unfair competition when actor imitated entertainer's distinct voice in "Lestoil" advertisement featuring duck).

Id. at 259. Although the *Midler* court looked to this early case of voice imitation for support, it distinguished *Lahr* as an unfair competition case in which the defendant's wrongdoing saturated and diminished the plaintiff's audience. *Id.* at 462. Midler did not have a claim for unfair competition because the defendants' short commercial would not have saturated her audience or curtailed her market. *Id.*

61 CAL. CIV. CODE § 3344 (West 1970 & Supp. 1985), which provides:

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

Id.

990 CAL. CIV. CODE § 990 (West Supp. 1994), which states:

(a) Any person who uses a deceased personality's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services, without prior consent from the person or persons specified in subdivision (c), shall be liable for any damages sustained by the person or persons injured as a result thereof . . . .

(b) The rights recognized under this section are *property rights*, freely transferable . . . .

*Id.* (emphasis added).
could not recover. Since section 3344 did not apply, the court used section 990, which provides for an action against a defendant who uses a deceased plaintiff's particular traits, to create the California tort of voice misappropriation. The court reasoned that because section 990 recognizes a deceased person's property rights in his or her particular traits, then by analogy with the common law, proprietary interests in personal identity are also property rights. The court then held that appropriation of such common-law rights is a tort in California.

In creating the voice misappropriation tort, the Ninth Circuit reasoned that a voice is a special characteristic unique to every person and that the defendants used Midler's voice to capitalize on her commercial success. Accordingly, Midler had a cause of action against the defendants for the misappropriation of her voice. The Ninth Circuit's recognition of voice misappropriation is significant because the tort was the primary vehicle providing recovery for Tom Waits in Waits v. Frito-Lay, Inc. In fact, voice

63 Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988), cert. denied, 112 S. Ct. 1513 (1992); see generally Charles Karlin, Note, A Rose By Any Other Voice? Commercial Voice Misappropriation in Midler v. Ford Motor Company, 19 Sw. U. L. Rev. 1137, 1142-49 (1990) (discussing Section 3344 analysis in Midler and comparing “look-alike” cases to “sound-alike” cases in support of Midler decision). Even though Section 3344 did not apply in Midler, the court held that a possible common-law cause of action may remain. Midler, 849 F.2d at 463. According to the court, a common-law cause of action may remain because § 3344(g) provides that its remedies are merely “cumulative” and implies that a common-law cause of action may exist. Id.

64 See supra note 62 (quoting language of Section 990).

65 Id., 849 F.2d at 463.

66 Id. (citing Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 824 (9th Cir. 1974), which held that defendant cigarette company invaded proprietary interest of race car driver’s identity with ad featuring photograph of driver’s distinctive red car). The Midler court distinguished the facts of Motschenbacher, but held that defendants imitated Midler’s voice to create the impression that Midler was singing for them, just as the cigarette company used Motschenbacher’s car as a symbol to intimate that the driver was associated with their product. Midler, 849 F.2d at 463.

67 Id. (“The human voice is one of the most palpable ways identity is manifested. We are all aware that a friend is at once known by a few words on the phone . . . . These observations hold true of singing . . . .”).

68 Id. at 463.

69 Id. The court, however, limited its decision: “We hold only 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 in California.” Id.

70 978 F.2d 1093 (9th Cir. 1992), cert. denied, 113 S. Ct. 1047 (1993).
misappropriation was the only claim under which the Ninth Circuit allowed Waits to recover damages. 71

B. THE LANHAM ACT

The purpose of the Lanham Act is to protect consumers and competitors from misrepresentations about products and services. 72 The Act applies not only to trademark infringement, but also to claims that involve deception resulting from unfair competition. 73 The recent amendment to the Lanham Act 74 expanded protection to include implied claims about a product that are deceptive. 75 Thus, advertisers must be concerned not only that their advertising is free from deception, but also that their

71 See supra notes 16-17 and accompanying text (discussing amount of damages Waits recovered).
73 Allen v. National Video, Inc., 610 F. Supp. 612, 625 (S.D.N.Y. 1985). To maintain a cause of action under section 43(a) of the Lanham Act, a plaintiff must prove three elements: (1) involvement of goods and services, (2) effect on interstate commerce, and (3) false designation of origin or false description of goods or services. Included in the third element is an inquiry into whether a likelihood of consumer confusion will result from the false representations. Id.; see also Standard & Poor's Corp. v. Commodity Exch., Inc., 683 F.2d 704, 708 (2d Cir. 1982) (listing six factors to consider to determine likelihood of consumer confusion); Warner Bros., Inc. v. Gay Toys, Inc., 658 F.2d 76, 79 (2d Cir. 1981) (holding that to get actual damages, plaintiff must prove that buying public was actually deceived). See generally Elaine Windholz, Whose Voice Is It Anyway? Midler v. Ford Motor Co., 8 CARDozo ARTS & ENT. L.J. 201 (1989) (discussing sound-alike litigants' likely success under Lanham Act).
75 Section 43(a) now provides:

Any person who, on or in connection with any goods or services . . . uses . . . any word, term, name, symbol, or device . . . or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which (a) is likely to cause confusion . . . or to deceive as to the affiliation . . . or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

advertisements do not imply false claims. 76

Perhaps the most significant modern application of the Lanham Act to a celebrity is Allen v. National Video, Inc., 77 in which a district court applied the Act to a video chain's advertisement involving a Woody Allen look-alike. In Allen, the court used the three-element test of section 43(a) 78 and inquired whether the advertisement had created a likelihood of consumer confusion. 79 According to the court, the first two elements— involvement of goods and services and effect on interstate commerce—were easily satisfied. 80

To determine the third element, the likelihood of consumer confusion, the court analyzed the facts using a six factor test. 81 Under the first factor, the court evaluated the strength of the plaintiff's marks. Because Woody Allen's name and likeness were well-known to the public, the court concluded that the marks were strong. 82 Second, the court examined the similarity of the plaintiff's and the defendants' marks. Although the look-alike photograph was not, as a matter of law, Allen's photograph, the court nonetheless determined that the resemblance between the look-alike and Allen was strong and undisputed. Because of this

76 See also Paul Batista, Lanham Act Revision May Spur Commercial Defamation Claims, NAT'L L.J., Sept. 30, 1991, at 40 (discussing likelihood of new actions against implied claims by advertisers arising under new amendment to Lanham Act). See generally Chester-Taxin, supra note 72, at 173-77 (discussing ways advertisers and their agencies can protect themselves from sound-alike liability under Lanham Act).

77 610 F. Supp. 612, 618 (S.D.N.Y. 1985). In Allen, Woody Allen alleged that defendants' advertisement appropriated his face and implied his endorsement. The advertisement portrayed a customer, with the same physical features as Allen, holding a National Video V.I.P. Card and standing next to two video cassettes of Allen's movies Annie Hall and Bananas. The advertisement, which ran in the March 1984 issue of Video Review and in the April 1984 issue of Take One, featured the headline: "Become a V.I.P. at National Video. We'll Make You Feel Like a Star." The ad in Video Review contained a disclaimer that a celebrity double was used in the advertisement. Id. at 617-18.

78 See supra note 73 (listing three elements involved in Lanham Act claim).

79 Allen, 610 F. Supp. at 627; see infra note 81 (listing six factors used to determine likelihood of consumer confusion).

80 Allen, 610 F. Supp. at 627.

81 Id. The six factors include: (1) strength of plaintiff's marks and name; (2) similarity of plaintiff's and defendant's marks; (3) proximity of plaintiff's and defendant's products; (4) evidence of actual confusion as to source or sponsorship; (5) sophistication of defendant's audience; and (6) defendant's good or bad faith. Standard & Poor's Corp. v. Commodity Exch., Inc., 683 F.2d 704, 708 (2d Cir. 1982).

82 Allen, 610 F. Supp. at 627.
resemblance, the court held that the "marks" were sufficiently similar to satisfy the second factor.\textsuperscript{83} Looking at the proximity of the products, the court noted that the public identifies Allen with movies, and that Allen's and the defendants' movie audiences overlapped.\textsuperscript{84}

Regarding evidence of actual confusion, the court refused to consider a consumer survey that Allen had offered as evidence of confusion. The court noted that although evidence of actual confusion would support a likelihood of confusion, such evidence was not required under the six-factor analysis.\textsuperscript{85} In determining consumer sophistication, the court determined that although the average reader of \textit{Video Review} or the average movie rental customer is likely to be fairly sophisticated about movies, these consumers, as well as less sophisticated consumers, could be confused.\textsuperscript{86} Finally, the court suggested that defendants acted in bad faith. The defendants admitted that they intended to evoke an association with Woody Allen when they designed the advertisement. This admission was sufficient for the court to find that the defendants were aware of a risk of consumer confusion and possibly had suspect motives.\textsuperscript{87} Consequently, Allen prevailed under the Lanham Act.\textsuperscript{88}

\textsuperscript{83} Id.
\textsuperscript{84} Id. at 628.
\textsuperscript{85} Id. Although the court refused to rely on the consumer survey Allen submitted as evidence of actual confusion, the court did not specify what evidence, if any, it would consider as evidence of confusion.
\textsuperscript{86} Id.
\textsuperscript{88} Id. at 628; see also Allen v. Men's World Outlet, Inc., 679 F. Supp. 360 (S.D.N.Y. 1988) (allowing Woody Allen to succeed in second case in which he alleged that clothing store violated Lanham Act with its advertisement containing look-alike playing clarinet). In \textit{Allen v. Men's World Outlet} the court held that despite the ad's disclaimer that a look-alike was used, a likelihood of consumer confusion existed over Allen's endorsement of or involvement with the clothing store. To determine likelihood of confusion, the court engaged in an analysis of the six factors discussed \textit{supra} notes 81-84 and accompanying text. The court reasoned that even though defendants did not intend to fool consumers into thinking that Allen was pictured in the ad, defendants admitted they designed the ad to evoke an association with Allen. Therefore, because the store was aware of a risk of consumer confusion, this militated against a finding of innocent motives on the defendants' part. The court found a likelihood of consumer confusion sufficient to sustain Allen's Lanham Act claim. \textit{Allen v. Men's World Outlet}, 679 F. Supp. at 369.
One court, however, has refused to apply the Lanham Act to a celebrity's claim of voice infringement. This refusal occurred in an early case, *Booth v. Colgate-Palmolive Co.* In *Booth*, an actress claimed that a commercial wrongfully imitated a voice she had used in a situation comedy series. The court rejected this claim, emphasizing that the actress and the defendant were not in competition. In contemporary cases, however, there is no longer the requirement that a plaintiff and defendant be in competition for a plaintiff to prevail under the Lanham Act.

IV. ANALYSIS

*Waits v. Frito-Lay, Inc.* is significant for two reasons. First, *Waits* confirms the precedent established by the Ninth Circuit in *Midler*, which allows a professional singer to recover for voice misappropriation. Second, the case addresses a question of first impression in the Ninth Circuit: whether to apply the Lanham Act to a person's identity as represented in his or her voice. In this debate, celebrities would argue that the decision is correctly decided because it protects their interests in distinct personal attributes. Advertisers, on the other hand, would contend that voice misappropriation restricts advertising rights and that the Lanham Act should not be applied so broadly. Although there are merits to both positions, *Waits v. Frito-Lay* is correctly decided.

A. VOICE MISAPPROPRIATION

Some critics of the *Waits* decision may attempt to distinguish the case from *Midler*, which created the California tort of voice misappropriation, to claim that *Waits* is not a proper case for

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90 Allen, 610 F. Supp. at 628; see also James Burroughs, Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 275 (7th Cir. 1976) (holding that competition between plaintiff and defendant is not involved in test for trademark infringement).
92 See supra Section III B (discussion of Lanham Act).
93 Waits, 978 F.2d at 1106.
recovery under the relatively new tort. Such critics may argue that the Waits defendants, unlike the Midler defendants, did not deliberately intend to imitate the plaintiff in order to sell their product, or that Bette Midler is a more well-known singer than Tom Waits and thus deserves more protection. However, applying the Midler holding to the Waits facts, it should be clear that Waits is a proper case for recovery under the California tort of voice misappropriation.

Like Midler, in which the defendants' intent to imitate Midler's voice was clear, the defendants in Waits similarly intended to imitate Tom Waits. The defendants had Waits's song "Step Right Up" in mind when they formulated the idea for their commercial; Carter was recommended to the advertising agency as someone who could do a good Tom Waits imitation.

Tom Waits's degree of fame, though probably less than Midler's, should not be an issue. When the Midler court created voice misappropriation, it held that the tort applies to a distinctive voice of a professional singer whose voice is widely known. Tracy-Locke played Waits's recorded version of his song "Step Right Up" to Frito-Lay in the initial presentation to the company to illustrate the mood they wanted the commercial to portray. The defendants then sought out a performer who could imitate Waits's special singing voice. Consequently, Waits's voice can be labeled as "distinctive." In addition, Waits has recorded more than seventeen albums and has played to sold-out audiences in the United States,

96 Id. (holding that when distinctive voice of professional singer is widely known and is deliberately imitated in order to sell product, sellers have committed tort in California).
96 Id. (holding that defendants intended to imitate Midler because they first asked her to perform song personally).
97 Although the Waits defendants did not make this argument, critics could argue that there was no plan to imitate Waits because: (1) the defendants did not ask Waits to perform the commercial, as Ford asked Midler; (2) the defendants made an alternate recording with a singer who did not sound like Waits in case the Carter version was an unacceptable imitation; and (3) the defendants consulted an attorney about a possible cause of action and were satisfied that no such cause of action existed.
99 Midler v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988), cert. denied, 112 S. Ct. 1513 (1992). Notably, the court did not set standards to determine the meanings of "distinctive," "professional," or "widely known."
Canada, Europe, Japan, and Australia. These musical achievements qualify Waits as a “professional singer.” Similarly, Waits is widely known. According to the Waits court, the “widely known” element of voice misappropriation is satisfied under California law if a plaintiff’s voice is “known to a large number of people throughout a relatively large geographic area.” Even if Waits does not have the same degree of fame as Bette Midler, his touring schedule and professional recognition show that he deserves to be considered “widely known” for the purposes of recovery under voice misappropriation.

Therefore, because Waits is a professional singer with a widely known distinctive voice, he deserves protection from voice misappropriation. This result is especially valid since the defendants intended to imitate Waits.

B. LANHAM ACT

Although not as strong as Woody Allen’s “mark,” Waits’s mark in his voice is arguably strong enough to satisfy the first factor under the six factor test. Certainly, Waits has made a considerable investment in his unique public image. The second factor, similarity of the marks, also weighs in Waits’s favor. Carter’s imitation of Waits was well-rehearsed and very similar to Waits’s style. Another factor supporting Waits is the proximity component. This factor was satisfied in Allen v. National Video because the court decided that National Video’s audience and Allen’s movie viewers overlapped. In Waits, there is similarly evidence that the Doritos advertisement, which was directed at young males, shared an audience with Waits.

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100 Waits, 978 F.2d at 1097.
101 See supra note 3 and accompanying text (describing aspects of Waits’s publicity).
102 Waits, 978 F.2d at 1102 (emphasis in the original). Noting that “well known” is a relative term, the court stated that the amount of damages would reflect how well-known a plaintiff is. Id. (citing Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974)). Thus, a less well-known plaintiff is not precluded from recovery.
103 See supra note 3 (discussing Waits’s professional recognition as singer).
104 See supra note 82 (discussing strength of Allen’s mark).
105 See supra notes 8-10 and accompanying text (discussing Carter’s imitation of Waits).
106 See supra note 84 and accompanying text (discussing overlapping audiences).
107 See supra notes 85-86 and accompanying text (discussing consumer confusion).
The fourth factor, evidence of actual confusion, was supplied through direct testimony in Waits,\textsuperscript{108} even though according to the court in Allen v. National Video such direct evidence is not required.\textsuperscript{109} With regard to consumer sophistication, the fifth factor, one can argue that radio listeners would be fairly sophisticated and thus able to distinguish Waits's voice from that of an imitator. However, in Allen v. National Video, the court held that many consumers were likely to be confused about the look-alike advertisement even though they were fairly sophisticated movie viewers.\textsuperscript{110} Therefore, under the Allen analysis, the level of consumer sophistication should not prevent Waits from succeeding.

Finally, there is an implication of bad faith on the part of the Waits defendants. In Allen v. National Video, the court held that the defendants had dubious motives because they admitted to designing the advertisement with Allen in mind and were aware of the risk of consumer confusion.\textsuperscript{111} Likewise, the Waits defendants were aware of this risk because they intended to engage a singer who could imitate Tom Waits; they recorded an alternate version with a different singer in case Carter sounded too much like Waits; and they consulted an attorney about a possible lawsuit by Waits.\textsuperscript{112}

Considering all six factors, there is sufficient support for a likelihood of consumer confusion to satisfy the third element of a Lanham Act false endorsement claim. Allowing plaintiffs like Waits to recover under the Lanham Act is not an extension of the Act, but rather an application of the federal statutory tort to an aspect of a celebrity's persona.

C. POSSIBLE LIMITATIONS ON THE HOLDING

Although Waits correctly extends potential relief to celebrities whose voices are misappropriated, the case's holding may be too

\textsuperscript{108} See supra note 85 and accompanying text (discussing consumer confusion).
\textsuperscript{109} See supra note 85 and accompanying text (discussing evidence of actual confusion).
\textsuperscript{110} See supra note 86 and accompanying text (discussing consumer sophistication as relates to possible confusion).
\textsuperscript{111} See supra notes 87-88 and accompanying text (discussing defendants' bad faith).
\textsuperscript{112} See supra notes 3-14 (discussing facts of Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992)).
broad. That is, under Waits, it is difficult to draw a line between actionable claims of voice misappropriation and claims that should fail. Consequently, in the future, courts should consider limitations to this tort. Specifically, defenses should be available for First Amendment parody, absence of confusion, and cases of character rather than real person appropriation.

First, a line must be drawn between First Amendment cases such as parody or media cases, which are protected, and imitation cases, which receive no First Amendment protection. For example, when a party makes a parody of an existing trademark, the intent is to amuse the public, and the party is not liable for trademark infringement with one potential caveat: the court in White v. Samsung Electronics America, Inc. held that defendants' First Amendment parody arguments are best confined to non-commercial areas. Thus, the First Amendment parody defense should limit a plaintiff's voice misappropriation action (at least) in noncommercial contexts.

A second limit on the tort of voice misappropriation should be in cases in which there is no actual confusion. For example, when a comedian like Rich Little imitates celebrities' voices, everyone recognizes the imitation and no one is confused about the speaker's identity. Arguably, when there is no confusion, no interest of a plaintiff has been appropriated; therefore, the plaintiff's voice does not merit protection in that situation.

Finally, the Waits holding should be limited to real persons. For example, when an advertisement imitates a voice that an actress has developed on a television show, the imitation should not constitute infringement of the actress's rights in her voice or identity. However, as a possible exception, when a character

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115 971 F.2d 1395 (9th Cir. 1992).
116 Id. at 1401 ("The difference between a 'parody' and a 'knock-off' is the difference between fun and profit.").
117 Although evidence of actual confusion existed in Midler and Waits, the Ninth Circuit did not emphasize that confusion was necessary to recover under voice misappropriation.
V. CONCLUSION

Although the Waits decision will negatively affect advertisers by repressing their freedom to design creative advertisements, the holding is a step in the right direction toward protecting celebrities' interests in their unique characteristics. Waits furthers the development of the right of publicity as well as the potential situations for application of section 43(a) of the Lanham Act. Yet, because the holding is unduly broad, it should be applied narrowly so as to prevent plaintiffs from taking unfair advantage of its wide scope.

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