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A RECORDING ARTIST’S RIGHT OF PUBLICITY IN TODAY’S ADVERTISING ENVIRONMENT: WHAT STATE LAWS GIVE, THE COPYRIGHT ACT TAKES AWAY

Geronimo Perez*

I. INTRODUCTION

Recently, advertisers have begun a popular trend in broadcast advertising. A greater number of advertisers are focusing on popular music as the thrust for their commercials instead of using actors.¹ For example, Cadillac, the car manufacturer, has used rock and roll music as the background in its advertisements. Reportedly, Cadillac and Led Zeppelin agreed on a multimillion dollar deal to use Led Zeppelin’s “Rock and Roll” recording as a soundtrack for Cadillac’s new line of luxury automobiles.² This trend has expanded to industries outside of the auto industry such as the fast-food market.³ Some record labels have also jumped on the advertising bandwagon and have established marketing units to promote their music catalogs.⁴

This popular trend raises an interesting legal issue for recording artists who are opposed to commercializing their recordings. Considering that recording artists are required to assign their rights in the master sound recordings to the record company,⁵ it is possible that a record company would approve commercial use of

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¹ Donna De Marco, TV Ads Go Pop; Advertisers Marry Modern Music with Their Products, WASH. TIMES, May 12, 2002, at A1 (“Watching—or at least listening to—television commercials these days is almost like flipping around the radio dial. More songs, from every era and every kind of artist, are filling up the coveted time slots during commercial breaks.”).

² See id. (“[Burger King] used more than 100 popular songs in its ‘Food & Music’ television and radio campaign in the late 1990s that matched songs like Tone Loc’s ‘Wild Thing’ and the Turtles’ ‘Happy Together’ with its featured foods.”).

³ Frank Green, Commercial Refrain. Record Labels Seek Product Placement in Pop Songs, SAN DIEGO UNION-TRIB., Nov. 16, 2002, at C1 (“At Interscope Records, for instance, company executive Steve Stoute has reportedly established a marketing unit known as PASS to facilitate contacts between the label’s artists and potential corporate advertisers.”).

⁴ Each Master made under this agreement or during its term . . . will be considered
a particular master sound recording over the objections of the recording artist. In that scenario, the recording artist might seek to exercise his right of publicity under a theory of misappropriation of voice or a variant thereof.

Something very similar arose when Nike, maker of footwear, used the Beatles’ recording of “Revolution” as the soundtrack for its spring 1987 advertising campaign. Nike had licensed the right to use “Revolution” from both Michael Jackson, who held the publishing rights to the musical composition, and EMI-Capital, the copyright owner of the master sound recording. To stop the commercials, Apple Records, the Beatles’ recording company, filed a fifteen million dollar lawsuit against Nike in New York state court. The lawsuit alleged that the “use of the Beatles’ voices constitut[ed] unauthorized exploitation of the Beatles’ persona and goodwill in TV commercials for Nike-Air shoes.” Eventually, Nike agreed to permanently stop running the commercials. Because the lawsuit was eventually settled out of court, the issues raised by Nike’s use of the Beatles’ “Revolution” recording were never addressed by the courts.

This Article analyzes a recording artist’s publicity rights within the current advertising environment to show that although certain states recognize an artist’s right of publicity, those state rights are preempted under section 301 of the federal Copyright Act. This Article analyzes the common law right of publicity and its statutory codification and/or expansion under California and New York law. It also analyzes section 301 of the federal Copyright Act and establishes the preemption of the recording artist’s right of publicity based on the statutory language, its legislative history, and federal copyright case law.

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8 MATTHEW BENDER, ENTERTAINMENT INDUSTRY CONTRACTS 159-83 (2003).

6 As used in this Article, misappropriation of voice refers to the use of a recording artist’s voice in advertisements without prior consent from the recording artist for such use.


8 Id.


10 Id. (internal quotations omitted).


12 Although some states recognize a post-mortem right of publicity, this Article will focus solely on the state right of publicity for living recording artists.
II. THE RIGHT OF PUBLICITY

In broad terms, the right of publicity can be defined as the right of each individual to benefit from the commercial value of his identity. Today, the right of publicity is generally used to protect the pecuniary interest of celebrities in their public persona. However, the central issue for any right of publicity claim is the identifiability of the individual to the relevant public.

The right of publicity, as it has developed over time, sometimes offers protection against voice misappropriation. Some jurisdictions rely on the common law right of publicity to protect against voice misappropriation. Other jurisdictions base protection on a statutory right. Some jurisdictions, however, do not protect against voice misappropriation at all.

A. THE COMMON LAW RIGHT OF PUBLICITY UNDER CALIFORNIA LAW

Although the common law right of publicity is recognized in most states, the scope of protection afforded by the right of publicity varies widely from state to state. The Ninth Circuit has taken perhaps the most aggressive approach in applying California’s common law right of publicity. Courts in California have
long recognized a common law right of publicity cause of action. Generally, to successfully plead a common law right of publicity claim, the plaintiff must allege that the defendant used the plaintiff's identity without the plaintiff's consent. In addition, plaintiff must allege that the appropriation of his name and likeness benefited defendant commercially or otherwise and resulted in injury to plaintiff.

Unlike name and likeness, a person's voice, however, is not expressly protected. The Ninth Circuit effectively broadened the common law right of publicity to protect against voice misappropriation by broadly interpreting the meaning of the identity element. For instance, in *Midler v. Ford Motor Company*, the Ninth Circuit held that a deliberate imitation of a singer's distinctive voice to sell products violated the singer's right of publicity. The court reasoned that the human voice was an obvious way of establishing an individual's identity. Further, in *Waits v. Frito-Lay, Inc.*, the Ninth Circuit took up where *Midler* left off. In affirming the jury decision favoring Waits, the court clarified that a voice was distinctive under *Midler* given its vocal qualities. Prior to these two cases, most courts were reluctant to recognize that a person's identity could be established through sound alone.

A recording artist seeking to prevent the commercial use of his particular recording could make use of both *Midler* and *Waits* as authority. Although the claim would not include a sound-alike as in *Midler* and *Waits*, if the recording artist could prove that his voice was distinctive given its particular qualities, then he could establish that his identity had been used as proscribed by California's common law right of publicity. This approach would be consistent with *Midler's*

20 Eastwood v. Superior Court, 198 Cal. Rptr. 342, 346 (Cal. Ct. App. 1983), superceded by statute no longer requiring a commercial use to create a right of publicity claim.

21 Id. at 347 ("A common law cause of action for appropriation of name or likeness may be pleaded by alleging (1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury.").

22 849 F.2d 460, 7 U.S.P.Q.2d (BNA) 1398 (9th Cir. 1988).

23 Id. at 463 ("When a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have [violated the singer's right of publicity] in California.").

24 Id. ("A voice is as distinctive and personal as a face. The human voice is one of the most palpable ways identity is manifested.").


26 Id. at 1101 (quoting the district court's jury instructions, "A voice is distinctive if it is distinguishable from the voices of other singers...if it has particular qualities or characteristics that identify it with a particular singer").

27 1 McCarthy, supra note 15, § 4:77 ("The courts seem to have a mind block about sounds. They have accepted the principle that name, picture, characterization and associated phrases and objects are fully capable of identifying the persona of a performer. But when vocal or instrumental style is involved, they balk for no good reason.").
reasoning that a voice is just as distinctive and personal as a face. If an imitation of an artist's voice could be said to invoke his identity, then the use of his real voice could certainly accomplish the same.

B. CALIFORNIA'S STATUTORY RIGHT OF PUBLICITY LAW

Unlike California's common law right of publicity, California's statutory right of publicity expressly protects against the unauthorized use of a person's voice in advertising. California's Civil Code section 3344 prohibits the unauthorized use of another's name, voice, signature, photograph, or likeness for advertising, selling, or soliciting purposes. However, as the Ninth Circuit explained in Midler, section 3344 protects against the actual use of a person's voice, but not against the use of an imitation or a sound-alike. The use of a sound-alike or imitation is governed by California's common law right of publicity.

Additionally, section 3344(d) lists specific exemptions to California's statutory right of publicity. Exempted are the limited uses in connection with any news, public affairs, sports broadcast or account, or any political campaign. These exemptions are designed to permit the enforcement of this statutory right

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28 Midler, 849 F.2d at 463.
29 Other jurisdictions have accepted the Ninth Circuit's expansive definition of the identity element. See Prima v. Darden Rests., Inc., 78 F. Supp. 2d 337, 349 (D.N.J. 2000) (citing to Midler in a right of publicity case under New Jersey law to establish an infringement). See also Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (citing to Ninth Circuit case law to hold that the right of publicity was not limited to uses of name and likeness).
30 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.
CAL. CIV. CODE § 3344(a) (West 1997).
31 See Midler, 849 F.2d at 463 ("The defendants did not use Midler's name or anything else whose use is prohibited by the statute."); 1 McCARTHY, supra note 15, § 6:28 ("It has been held that the statute is not violated by use of a vocal sound-alike because the statute only covers use of the 'voice' of the plaintiff, not an imitation voice.").
32 See Midler, 849 F.2d at 463 ("The statute, however, does not preclude Midler from pursuing any cause of action she may have at common law; . . . .").
33 CAL. CIV. CODE § 3344(d) (West 1997) ("For purposes of this section, a use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, or any political campaign, shall not constitute a use for which consent is required under subdivision (a).")
34 Id.
consistent with the First Amendment free speech concerns of the United States Constitution. 35

A recording artist seeking to prevent the commercial use of his sound recordings could effectively rely on section 3344 for protection. The artist must allege the actual use of his voice for advertising purposes and that such use was not authorized by him. In this scenario, the artist would not be required to prove that his voice was distinctive. Distinctiveness is required under a common law right of publicity claim to establish identity. 36 Considering that section 3344 does not require the artist to establish use of his identity, but rather only use of his voice, distinctiveness would not be an issue under section 3344.

A potential problem area for the artist, however, may be in establishing unauthorized use. Section 3344 is silent as to assignment or transferability. 37 Based on the language used, it is implicit that consent is required from the person whose name, voice, signature, photograph, or likeness is being used. 38 However, recording artists are required to make a grant of rights to the record company. 39 Although the rights transferred under such a grant of rights clause are generally limited to the rights conferred under copyright law, 40 a broadly worded grant of rights clause could effectively transfer the artist’s right of publicity as well. 41

Apart from the grant of rights clause, a recording artist is also required to make a grant of publicity rights under the master sound recording agreement with the record company. 42 The grant of publicity rights includes the right of the record company to use the artist’s name, portraits, pictures, and likeness. 43 The

36 See Mider, 849 F.2d at 463 (indicating that the use of a sound-alike of a distinctive voice of a professional singer for advertising purposes violates the singer’s common law right of publicity).
37 1 MCCARTHY, supra note 15, § 6:35.
38 Id.
39 8 BENDER, supra note 5, at 159-82.
40 3 THOMAS D. SELZ ET AL., ENTERTAINMENT LAW § 25.01 (2d ed. 2002) (“In the entertainment industry, the term grant of rights refers primarily to the transfer of rights conferred under copyright law.”).
41 Id. at n.2 (“The [grant of rights] term also may be used in a broader sense to represent the transfer of rights of any nature, such as contracts rights, the right of publicity, or the artist’s moral right.”).
42 Company and any licensee of Company each shall have the perpetual right, without liability to any Person, and may grant to others the right, to reproduce, print, publish or disseminate in any medium your name, the names, portraits, pictures and likenesses of the Artist... in connection with Masters made under this agreement... for purposes of advertising, promotion and trade in connection with you or Artist, the making and exploitation of Records hereunder and general good will advertising.
43 Id.
grant of publicity rights, however, is generally for purposes of promoting the sound recording itself. Thus, its scope is narrower than the grant of rights clause.\textsuperscript{44}

If the statutory right of publicity may be assigned or transferred either through a broadly worded grant of rights clause or a grant of publicity rights, then it would reason that all that is required for an advertiser to obtain authorized use is a license from the master sound recording copyright owner. Ultimately, it would be necessary to review the recording agreement to establish the extent of the transfer of rights.

C. NEW YORK'S STATUTORY RIGHT OF PUBLICITY LAW\textsuperscript{45}

New York's statutory right of publicity also expressly protects against the unauthorized use of a person's voice in advertising. New York’s Civil Rights Law section 51 prohibits the unauthorized use of a person’s name, portrait, picture or voice for advertising or trade purposes.\textsuperscript{46} Unlike California’s section 3344, however, section 51 arguably protects against the use of a sound-alike in advertising.\textsuperscript{47}

Section 51 also lists specific exceptions in the form of affirmative defenses.\textsuperscript{48} Of these exceptions, two of them pose significant obstacles to a recording artist seeking to prevent the commercial use of his particular sound recordings. The exception most on point is the one given to copyright owners of sound recordings. The copyright owner of a sound recording may dispose of, deal in, license, or sell the sound recording if such rights have been transferred to him in writing by the recording artist.\textsuperscript{49}

\textsuperscript{44} Id. See also 3 SELZ ET AL., supra note 40, § 25.21.

\textsuperscript{45} The common law right of publicity is not recognized in New York. Robertson v. Rochester Folding Box Co., 64 N.E. 442 (N.Y. 1902).

\textsuperscript{46} Any person whose name, portrait, picture or voice is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained . . . may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait, picture or voice, to prevent and restrain the use thereof; . . .

N.Y. CIV. RIGHTS LAW § 51 (McKinney 2003).

\textsuperscript{47} 1 MCCARTHY, supra note 15, § 6:81 (“[I]n 1995, the New York statute was amended to add the word 'voice' to the list of 'name, portrait or picture,' thus extending the statutory prohibition to sounds-alikes.”).

\textsuperscript{48} N.Y. CIV. RIGHTS LAW § 51 (McKinney 2003). See also Oliveira v. Frito-Lay, Inc., 251 F.3d 56, 63 (2d Cir. 2001) (“The defendant's motion to dismiss was based on the affirmative defense provided by an exception specified in § 51.”).

\textsuperscript{49} Nothing contained in this section shall be construed to prohibit the copyright owner of a sound recording from disposing of, dealing in, licensing or selling that
In most recording contracts, recording artists are required to assign all of their rights in the master sound recordings to the record company. This transfer of rights is generally inclusive of an absolute right to license the sound recording as the record company desires. It seems rather clear that after assigning his rights to the record company, the recording artist is precluded from availing himself of the protections generally afforded by section 51. Consequently, unless the recording agreement contained a non-commercial use clause, a recording artist would be barred from exercising his statutory right of publicity under New York law.

A second exception posing a significant obstacle to a recording artist protects the purchaser of certain works created by the artist. Any person or entity may use the artist’s voice in connection with the artist’s literary, musical, or artistic productions containing the artist’s voice which the artist has disposed of or sold. This exception aims to permit the purchaser of such productions to use the artist’s identity to accurately identify works created by him. This exception, however, is a defense only for the person or entity, or the successor in interest, that legitimately purchased the works from the artist. Consequently, purchasers of counterfeit recordings cannot avail themselves of the protections of this exception.

In determining whether the artist has sold or disposed of his work under this exception, it is necessary to consult the master sound recording agreement. An artist disposes of the work when he has no beneficial contract rights with anyone securing some interest in his performance. Because most recording artists are

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sound recording to any party, if the right to dispose of, deal in, license or sell such sound recording has been conferred by contract or other written instrument by such living person or the holder of such right.

N.Y. CIV. RIGHTS LAW § 51 (McKinney 2003).

8 BENDER, supra note 5, at 159-82.

Id.

[N]othing contained in this article shall be so construed as to prevent any person, firm or corporation from using the name, portrait, picture or voice of any . . . artist in connection with his literary, musical or artistic productions which he has sold or disposed of with such name, portrait, picture or voice used in connection therewith.

N.Y. CIV. RIGHTS LAW § 51 (McKinney 2003).

1 MCCARTHY, supra note 15, § 6:90 (“The apparent thrust of [this] exemption . . . is to permit the use of the identity of an author, artist or performer to truthfully identify works created by that person.”).

See ASA Music Prods. v. Thomson Elecs., 49 U.S.P.Q.2d (BNA) 1545, 1553 (S.D.N.Y. 1998) (“By selling or disposing of his or her rights in a work, an artist . . . is deprived of a cause of action only against the entity to whom he or she sold the work and any successors in interest.”); 1 MCCARTHY, supra note 15, § 6:90 n.2 (summarizing relevant case law).

Oliveira v. Frito-Lay, Inc., 251 F.3d 56, 64, 58 U.S.P.Q.2d (BNA) 1767, 1773 (2d Cir. 2001)
required to assign their rights in a sound recording to the record company under a broad grant of rights clause and a grant of publicity rights clause, most recording artists effectively disposed of their productions under this exception. As a result, a recording artist would be barred from exercising his statutory right of publicity under New York law once the artist assigns or otherwise transfers his interests in a sound recording to the record company.

III. SECTION 301: STATUTORY PREEMPTION OF STATE LAWS

Although an artist's right of publicity might survive and vest under state law, the exercise of that right faces a greater obstacle under federal copyright law. Section 301 of the 1976 Copyright Act serves to preempt various state causes of action which provide for copyright-like rights. To satisfy the preemption requirements of section 301, two conditions must be met. First, the asserted state right must be equivalent to an exclusive right protected under section 106. Second, the work in which the state right is asserted must be fixed within a tangible medium of expression and come within the subject matter of copyright defined in sections 102 and 103. In establishing section 301 of the 1976 Copyright Act, Congress clearly intended that all state copyright-like rights be

("[T]he admission that plaintiff recorded the song without a contract ... does not admit that at the time of recording, she had no beneficial contract rights with anyone securing some interest in her performance.").

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RIGHT OF PUBLICITY


On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright 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 or equivalent right in any such work under the common law or statutes of any State.

See also Baltimore Orioles, Inc. v. Major League Baseball Players Assn., 805 F.2d at 674 (stating that "the work in which the state right is asserted must be fixed in tangible form and come within the subject matter of copyright as specified in § 102").
preempted under federal copyright law and foreclosed the possibility of any dual copyright system.\footnote{62}

A. EQUIVALENT RIGHTS TEST

The first preemption condition requires that the state right at issue be a legal or equitable right that is “equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106.”\footnote{63} This element relates to the nature,\footnote{64} as opposed to the purpose or effect,\footnote{65} of the right established under state law.

Generally, a state law right is equivalent to copyright if it satisfies two conditions. First, the state right must be comprised of conduct within the general scope of one or more of the exclusive rights granted to copyright owners under section 106.\footnote{66} Second, the state law must require the plaintiff to prove no more than the elements otherwise required under copyright infringement.\footnote{67} Therefore, if the acts of reproduction, performance, distribution, or display of the copy-

\footnote{62} The intention of section 301 is to preempt and abolish any rights under the common law or statutes of a State that are equivalent to copyright and that extend to works coming within the scope of the Federal copyright law. The declaration of this principle in section 301 is intended to be stated in the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation of its unqualified intention that Congress shall act preemptively, and to avoid the development of any vague borderline areas between State and Federal protection. H.R. REP. NO. 94-1476, at 130 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5746.

\footnote{63} 17 U.S.C. § 301(a) (2000). \textit{See also} 3 PAUL GOLDSTEIN, COPYRIGHT § 15.2.1 (2d ed. 2003) (stating that “a state right will be preempted if it attaches to a tangible, fixed work of authorship coming within the subject matter of copyright and is equivalent to the right to reproduce the work”).

\footnote{64} 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01[B] (2002).

\footnote{65} 3 GOLDSTEIN, supra note 63, § 15.2.1 (“Congress evidently recognized that the test of equivalence could not be painted with such broad brush-strokes as the 'purpose' or 'effect' of the state law in issue.”).

\footnote{66} Courts generally hold that a state law right is equivalent to copyright for the purposes of section 301 if (1) the right encompasses conduct coming within the scope of one or more of section 106's exclusive rights, and (2) if applicable state law requires the plaintiff to prove no more than the elements that the Copyright Act requires for proof of infringement of one or more of section 106's six exclusive rights.

\footnote{67} Id.
righted work violate the state right, then it is equivalent to copyright\(^{68}\) and within the first condition of section 301.

The right of publicity generally affords every individual the right to control and benefit from the commercial use of his identity.\(^{69}\) This state law right is generally violated when another appropriates for his advantage the individual’s name, voice, photograph, or likeness.\(^{70}\) At the heart of the right of publicity is the right of the individual to control the reproduction, distribution, performance and display of his identity, namely, his name, voice, image, and likeness.\(^{71}\)

An individual controls the commercial use of his identity by reproducing his name, voice, image or likeness, and distributing, displaying or performing that reproduction, or authorizing others to do the same. It is only when another fails to secure the individual’s authorization for such reproduction, distribution, display, or performance that the individual is empowered to stop such conduct under state law.\(^{72}\)

In terms of a recording artist seeking to prevent the commercial use of his sound recordings, the artist’s right of publicity clearly comes within the general scope of one or more of the section 106 exclusive rights granted to copyright owners. An advertiser using the artist’s sound recording in a commercial, having obtained licenses from the copyright owners of the musical composition and the sound recording, would violate the artist’s right to reproduce and distribute the artist’s voice under state law if authorization was not first obtained from the artist.

However, even if the right of publicity comprises conduct within the general scope of one or more of the exclusive right under copyright, it will not be preempted if it requires an extra element to constitute an infringement. This extra element may be in addition to, or instead of, the acts of reproduction, distribution, or display.\(^{73}\) In fact, Congress specifically intended that the common law

\(^{68}\) 1 NIMMER & NIMMER, supra note 64, § 1.01[B][1], at 1-12 ("Thus, in essence, a right that is ‘equivalent to copyright’ is one that is infringed by the mere act of reproduction, performance, distribution, or display.").

\(^{69}\) BIEDERMAN, supra note 13, at 213.

\(^{70}\) See, e.g., Fleet v. CBS, Inc., 58 Cal. Rptr. 2d 645, 649, 41 U.S.P.Q.2d (BNA) 1749, 1752 (Cal. Ct. App. 1996) (stating that “[u]nder California law, an individual’s right to publicity is invaded if another appropriates for his advantage the individual’s name, image, identity or likeness”); Clint Eastwood v. Superior Court, 198 Cal. Rptr. 342, 346 (Cal. Ct. App. 1983) (listing the elements required for a properly pleaded common law right of publicity claim under California law); CAL. CIV. CODE § 3344(a) (West 1997); N.Y. CIV. RIGHTS LAW § 51 (McKinney 2003).


\(^{72}\) See, e.g., Eastwood, 198 Cal. Rptr. at 413 (claiming that the unauthorized use of a celebrity’s name, photograph, or likeness on the cover of a publication violate Eastwood’s right of publicity); Fleet, 58 Cal. Rptr. 2d at 647 (claiming that unauthorized use of performance of actors violated their right of publicity).

\(^{73}\) 1 NIMMER & NIMMER, supra note 64, § 1.01[B][1], at 1-13 ("But if qualitatively other elements
right of publicity not be preempted so long as it contained an extra element which was different in kind from copyright infringement.  

California's common law right of publicity may be said to require an extra element to establish infringement. In addition to proving that the defendant used the plaintiff's identity without the plaintiff's consent, the plaintiff must also prove that that appropriation of identity benefited the defendant, commercially or otherwise. Copyright infringement, on the other hand, is established by showing the plaintiff's ownership of a valid copyright and a violation of one of the exclusive rights granted to copyright owners under section 106 of the 1976 Copyright Act. There is no need to establish that the defendant was benefited, commercially or otherwise, from the infringing use.

However, the existence of this additional element not otherwise required under copyright infringement does not automatically except the law from preemption. To qualify as an extra element, thus circumventing preemption, the element must be qualitatively different from the copyright owner's exclusive rights under section 106. Unfortunately for the recording artist, the additional element of benefit to the defendant required under California's common law right of

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74 The evolving common law rights of "privacy," "publicity," and trade secrets, and the general laws of defamation and fraud, would remain unaffected as long as the causes of action contain elements, such as the invasion of personal rights or a breach of trust or confidentiality, that are different in kind from copyright infringement.


75 Eastwood, 198 Cal. Rptr. at 347 ("A common law cause of action for appropriation of name or likeness may be pleaded by alleging (1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury.").

76 ROBERT C. LIND, COPYRIGHT LAW 120 (2002) ("To establish a claim of copyright infringement, plaintiff must demonstrate (1) ownership of a valid copyright, and (2) violation of any of the exclusive rights of the copyright owner.").

77 Id at 119 ("Copyright infringement is a strict liability tort, therefore, a defendant need not have intended the infringement to be held liable.") (citing Playboy Enters. v. Frena, 839 F. Supp. 1552 (M.D. Fla. 1993) (computer bulletin board operator was found liable for the infringement of copyrighted photographs which were uploaded and downloaded to his bulletin board without his knowledge)).


79 1 NIMMER & NIMMER, supra note 64, § 1.01[B][1], at 1-13 ("But if qualitatively other elements are required . . . in order to constitute a state-created cause of action, then the right does not lie 'within the general scope of copyright,' and there is no pre-emption.").
publicity does not afford him any rights different in kind from those protected under section 106.80

Ultimately, the primary right granted to the artist under the common law right of publicity is the right to control the use of his identity.81 This control allows the artist to reproduce his identity, to distribute it, to perform it or to display it, or to authorize others to do the same.82 The required element of benefit to the defendant is simply an element required to be pleaded under state law before the right to control one's identity may be enforced. Therefore, it is not an extra element preventing preemption under section 301.

Similarly, California's statutory right of publicity requires that additional elements be pleaded for a cause of action to arise.83 First of all, Civil Code section 3344 requires an allegation of a knowing use of the plaintiff's identity for purposes of advertising or solicitation of purchases without plaintiff's prior consent.84 Secondly, judicial construction of section 3344 requires an allegation that a direct connection exists between the defendant's use and the commercial purpose.85

However, neither of these additional elements give rise to state rights that are qualitatively different from the copyright owner's exclusive rights under section 106. The knowing use element of section 3344 seeks to limit the reach of the statute to bad faith uses of a person's identity for commercial purposes.86

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80 H.R. REP. NO. 94-1476, at 132 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5748 (“The evolving common law right[ ] of . . . ‘publicity[ ]’ . . . would remain unaffected as long as [it] contain[s] elements, such as the invasion of personal rights or a breach of trust or confidentiality, that are different in kind from copyright infringement.”).

81 Eastwood v. Superior Court, 198 Cal. Rptr. 3d at 349 (“Hence we are called upon to determine the boundaries of Eastwood's ability to control the commercial exploitation of his personality in the publication field.”).

82 Id.

83 CAL. CIV. CODE § 3344(a) (West 1997).

84 Id. See also Eastwood, 198 Cal. App. at 342 (“[T]o plead the statutory remedy provided in Civil Code section 3344, there must also be an allegation of a knowing use of the plaintiff's name, photograph or likeness for purposes of advertising or solicitation of purchases.”).

85 Johnson v. Harcourt, Brace, Jovanovich, Inc., 118 Cal. Rptr. 370, 381 (Cal. Ct. App. 1974) (holding that the use of plaintiff's name in an article republished in an English textbook was not the primary reason for the textbook; nor was it a substantial factor used to decide whether or not to purchase the textbook). See also Eastwood, 198 Cal. Rptr. 3d at 346-48 (citing and quoting Johnson).

86 See Eastwood, 198 Cal. Rptr. 3d at 352 (holding that Eastwood's failure to allege that the [defendant's] article was published with knowledge or in reckless disregard of its falsity rendered Eastwood's claim under California's Civil Code section 3344 unactionable). But see 1 MCCARTHY, supra note 15, § 6:46 (explaining that the knowing use requirement was originally incorporated because an earlier version of the bill which eventually became law contained a clause allowing for penal damages of $1,000, thus providing the mens rea for the criminal penalty. However, when the criminal penalty was taken out of the bill, the legislature forgot to delete the knowing use
Similarly, the judicially imposed direct connection element seeks to exclude de minimis commercial uses of a person's identity under section 3344. In spite of these additional elements, the state right created by section 3344 remains to be the ability of the individual to control the commercial use of his identity.

Unlike California, however, New York's statutory right of publicity does not require that additional elements be pleaded for a cause of action to arise. Some New York courts have held that the statute's requirement of use of one's image for advertising or trade purposes without written consent is an additional element not otherwise required under federal copyright law, thus, it is not preempted. However, a clear explanation of how these elements create rights different in kind from those provided under section 106 of the 1976 Copyright Act is lacking.

Consequently, even if a state law right is narrower or broader than the exclusive rights under section 106, it will still fall within section 301's preemption penumbra. The exclusive rights enumerated in section 106 serve to identify the general nature of the rights within the general scope of copyright law. The state right to control the commercial use of one's identity is well within these exclusive rights.

requirement. In spite of this legislative oversight, modern courts and commentators all agree that section 3344's requirement of knowing use does not change the common law rule that knowledge or intent is not a requirement for a common law nor statutory claim to be actionable.

Johnson, 118 Cal. Rptr. at 381 (excluding an insubstantial use of the plaintiff's identity from the reach of California's Civil Code section 3344).

Eastwood, 198 Cal. Rptr. 3d at 349 ("Hence we are called upon to determine the boundaries of Eastwood's ability to control the commercial exploitation of his personality in the publication field.").

Eastwood's ability to control the commercial exploitation of his personality in the publication field.

N.Y. Civ. RIGHTS LAW § 51 (McKinney 2003). See also Matthews v. ABC Television, Inc., 1989 WL 107640 (S.D.N.Y. 1989) (indicating that "the elements of the [section 51] claim [are]: 1) that defendant used plaintiff's name, portrait or picture within the state, 2) for purposes of advertising or trade, and 3) without first obtaining plaintiff's written consent").

Molina v. Phoenix Sound, Inc., 747 N.Y.S.2d 227, 231 (2002) ("Because the state statute contains the additional element of use of one's image for advertising or trade purposes without written consent, we find the nature of the action is nonequivalent and the doctrine of preemption does not apply.").

17 U.S.C. § 301(a) (2000). See also 1 NIMMER & NIMMER, supra note 64, § 1.01[B][1], at 1-12 ("The fact that the state-created right is either broader or narrower than its federal counter part will not save it from pre-emption."); see also H.R. REP. NO. 94-1476, at 131 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5747 (indicating that "[t]he preemption of rights under State law is complete with respect to any work coming within the scope of the bill, even though the scope of exclusive rights given the work under the bill is narrower than the scope of common law rights in the work might have been").

1 NIMMER & NIMMER, supra note 64, § 1.01[B][1], at 1-12 ("Section 106 may be said to identify the general nature of the rights that fall 'within the general scope of copyright' [law].").
RIGHT OF PUBLICITY

B. SUBJECT MATTER TEST

The second preemption condition requires that the work in which the state right is asserted be fixed within a tangible medium of expression and come within the subject matter of copyright defined in sections 102 and 103 of the 1976 Copyright Act. This condition relates to the nature of the work in which the state right may be claimed. As a general rule, so long as the work in which the state right is asserted fits within one of the general subject matter categories of copyright law, it will satisfy this second condition. It is not necessary that the work meet the minimum requirements giving rise to a valid copyright in the work.

The actual language of section 301, however, refers to "works of authorship that are fixed in a tangible medium of expression." Commentators urge that the work referred to here is the individual's persona, namely his name, image, voice, likeness, which gives rise to the state claim. Consequently, because a persona cannot comprise a writing of an author consistent with the Copyright Clause of the United States Constitution, a persona cannot be said to be a work of authorship within the Copyright Act.

However, the term "works of authorship" is defined in section 102(a) of the Copyright Act. Section 102(a) lists categories that make up eligible works of authorship. Section 101 does provide a section for definitions, but it clearly

94 Id. See also 1 NIMMER & NIMMER, supra note 64, § 1.01[B][2], at 1-50.
95 1 NIMMER & NIMMER, supra note 64, § 1.01[B].
96 As long as a work fits within one of the general subject matter categories of sections 102 and 103, the bill prevents the States from protecting it even if it fails to achieve Federal statutory copyright because it is too minimal or lacking in originality to qualify or because it has fallen into the public domain.
97 Id.
99 1 NIMMER & NIMMER, supra note 64, § 1.01[B][1][c], at 1-24 ("The 'work' that is the subject of the right of publicity is the persona, i.e., the name and likeness of a celebrity or other individual.") (emphasis added). See also 3 GOLDSTEIN, supra note 65, § 15.22.1.1 pt. 622 ("Section 301's first condition for preemption, that the work in issue be fixed in a tangible medium of expression, requires that a distinction be drawn between the subject matter of the right of publicity-an individual's person and the medium in which that persona may be tangibly fixed . . . .").
100 1 NIMMER & NIMMER, supra note 64, § 1.01[B][1][c], at 1-24 ("A persona can hardly be said to constitute a 'writing' of an 'author' within the meaning of the Copyright Clause of the Constitution.") (emphasis added).
102 Id. ("Works of authorship include the following categories: . . . .").
indicates that some definitions may otherwise be provided within the Act itself.\textsuperscript{103} Because the term "works of authorship" is defined within the Copyright Act under section 102(a), the language used in section 301 making reference to "works of authorship that are fixed in a tangible medium of expression"\textsuperscript{104} cannot be said to refer to the individual's persona.

A reading of the legislative history of section 301 supports this conclusion as well.\textsuperscript{105} Reference is specifically made to the work in issue—"[r]egardless of when the work was created and whether it is published or unpublished, disseminated or undisseminated, in the public domain or copyrighted under the Federal statute..."\textsuperscript{106} As has been urged, an individual's persona is not copyrightable.\textsuperscript{107} It is clear from this legislative history that the "works of authorship" language for the second condition for preemption under section 301 refers to a work which fits within one of the general subject matter categories of copyright law. It does not refer to an individual's persona.

A sound recording containing a recording artist's performance is clearly a work of authorship fixed\textsuperscript{108} in a tangible medium of expression and falls within the general subject matter categories of section 102.\textsuperscript{109} The artist's performance is fixed\textsuperscript{110} in a material object, generally a phonorecord,\textsuperscript{111} which is sufficiently

\begin{itemize}
\item \textsuperscript{103} 17 U.S.C. § 101 (2000) ("Except as otherwise provided in this title, . . .").
\item \textsuperscript{104} 17 U.S.C. § 301(a) (2000).
\item \textsuperscript{106} Id.
\item \textsuperscript{107} I NIMMER & NIMMER, supra note 64, § 1.01[B][1][c], at 1-24 ("A persona can hardly be said to constitute a 'writing' of an 'author' within the meaning of the Copyright Clause of the Constitution.") (emphasis added).
\item \textsuperscript{108} 17 U.S.C. § 101 (2000) (defining sound recordings as "works that result from the fixation of a series of musical, spoken, or other sounds . . ." and clearly reflecting the legislature's willingness to fix voices and sounds within copyright law). \textit{But see} Midler v. Ford Motor Co., 849 F.2d 460, 462, 7 U.S.P.Q.2d (BNA) 1398, 1400 (9th Cir. 1988) ("A voice is not copyrightable. The sounds are not 'fixed.' ").
\item \textsuperscript{109} See 1 NIMMER & NIMMER, supra note 64, § 1.01[B][2][d][i], at 1-59 (noting "[e]ffective February 15, 1972, sound recordings for the first time became eligible for statutory copyright protection").
\item \textsuperscript{110} 17 U.S.C. § 101 (2000) ("A work is 'fixed' in a tangible medium of expression when its embodiment in a . . . phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than [a] transitory duration.").
\item "Phonorecords" are material objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later development, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "phonorecords" includes the material object in which the sounds are first fixed.
\item \textit{Id.}
\end{itemize}
permanent to permit the artist's performance to be perceived, reproduced, or otherwise communicated. Furthermore, section 102(a)(7) specifically lists sound recordings as a work of authorship category within the subject matter of copyright. Consequently, sound recordings fixed after February 15, 1972, are protected by copyright law. As a result, the second condition for preemption is satisfied.

IV. CONCLUSION

Recording artists seeking to prevent the commercial use of their sound recordings based on their state right of publicity clearly fall within the ambit of section 301. The control rights granted to recording artists under the state right of publicity laws coupled with the embodiment of an artist's voice in a sound recording satisfy both preemption conditions. As a result, the recording artist's state right of publicity should be preempted under section 301 of the 1976 Copyright Act.

Judge Kozinski, in *Wendt v. Host International, Inc.*, summed up that case's parallel predicament accurately. The recording artist and the record company would effectively be fighting over the same bundle of intellectual property rights—the right to control the reproduction of the sound recording. The recording company would be asserting its rights under the 1976 Copyright Act to license the use of the sound recording to advertisers for commercial purposes. The recording artist would be asserting his state-created right to control the exploitation of his voice in the sound recording.

Allowing the recording artist to exercise his state rights in the face of an advertiser's licensed copyright rights runs afoul of section 301 of the Copyright Act. In this context, the recording artist would prevent the advertiser, the copyright licensee, from fully exploiting the copyright in the sound recording based on a state law. This violation is exactly what is proscribed by section 301,
thus, placing the state right of publicity within the cross hairs of copyright preemption.

'obvious conclusion that a party who does not hold the copyright in a performance captured on film cannot prevent the one who does from exploiting it by resort to state law.'” (quoting Fleet v. CBS, Inc., 58 Cal. Rptr. 2d 645, 653 (Cal. Ct. App. 1996)).