

WAITS v. FRITO-LAY: THE SONG  
REMAINS THE SAME\*

KEITH E. LURIE

I. INTRODUCTION

In *Midler v. Ford Motor Co.*,<sup>1</sup> the Ninth Circuit created the tort of "voice misappropriation."<sup>2</sup> The case involved an advertising agency's deliberate hiring of a Bette Midler impersonator to sing a popular Midler tune of the 1970s for a Ford Motor Company national television commercial. Although the advertising company bought the rights to the song "Do You Want to Dance," which Midler did not write, the Ninth Circuit unanimously held 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."<sup>3</sup> In effect, the *Midler* court judicially legislated a new property right by circumventing prior case law, which had not recognized a cause of action in a sound-alike case.<sup>4</sup> "A voice is as distinctive and personal as a face," wrote the court.<sup>5</sup> "To impersonate [a] voice is to pirate [an] identity."<sup>6</sup>

Although the Ninth Circuit did not go so far as to hold that every imitation of a voice to advertise merchandise constitutes a cause of action, the question loomed after *Midler* as to how far the court would go to broaden a celebrity's right of publicity, that is a celebrity's right to maintain exclusive control over the commercial uses of his or her identity. The Ninth Circuit's recent decision in *Waits v. Frito-Lay, Inc.*,<sup>7</sup> strengthened the property right it had established in *Midler*.

The facts of *Waits* are somewhat similar to *Midler*. Tom Waits is a singer, actor, and songwriter with a distinctively raspy voice, who has taken a strong philosophical stand against commercial endorsements.<sup>8</sup> One of Waits' songs, "Step Right Up," is an indict-

\* © 1994 Keith E. Lurie

<sup>1</sup> 849 F.2d 460 (9th Cir. 1988), *cert. denied*, 112 S. Ct. 1513 (1992).

<sup>2</sup> "Voice misappropriation" is defined as the unlawful imitation of a celebrity's voice. *See id.* at 463.

<sup>3</sup> *Id.* at 463.

<sup>4</sup> Felix H. Kent, *California Court Expands Celebrities' Rights*, N.Y.L.J., Oct. 30, 1992, at 3.

<sup>5</sup> *Midler*, 849 F.2d at 463.

<sup>6</sup> *Id.*

<sup>7</sup> 978 F.2d 1093 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993).

<sup>8</sup> *Id.* at 1097.

ment of the "commercial hucksterism"<sup>9</sup> that pervades our society. Ironically, in developing an advertising campaign to introduce a new Frito-Lay product, Tracy-Locke, Frito-Lay's advertising firm, found inspiration in this song. The commercial that the advertising agency wrote echoed the rhyming word play of the Waits' song.<sup>10</sup> Both Tracy-Locke and Frito-Lay were aware of Waits' long standing disapproval of commercial endorsements.<sup>11</sup> Hence, Tracy-Locke used another singer who sounded very much like Waits. Waits sued, and a jury awarded him \$375,000 compensatory damages, \$100,000 damages for violation of the Lanham Act, and \$2,000,000 punitive damages for "voice misappropriation."<sup>12</sup> The Court of Appeals affirmed the judgment and expanded substantially on the *Midler* decision.

Whereas *Midler* never clearly defined the newly established property right in one's voice, *Waits* explained that the *Midler* voice misappropriation tort stems from a "violation of the 'right of publicity,' the right of a person whose identity has commercial value—most often a celebrity—to control the commercial use of that identity."<sup>13</sup> *Waits* further interpreted *Midler* to have established that when a celebrity's voice is an integral part of that person's identity, the "right of publicity" prohibits imitations of the voice for commercial purposes without the celebrity's consent.<sup>14</sup> To this end, the jury determined that Waits has a "distinctive" and "widely known" voice and found that the defendants had violated Waits' right of publicity by broadcasting a commercial "which featured a deliberate imitation of Waits' voice."<sup>15</sup>

The discussion of damages in *Waits* presents the greatest departure from the *Midler* decision.<sup>16</sup> In *Midler*, the court propounded that a voice has economic value, and thus limited Bette Midler's damage award to the market value of her voice.<sup>17</sup> *Waits*, in contrast, broadened the damages spectrum and considered the propriety of "mental distress" damages.<sup>18</sup> *Waits* held that a right of

<sup>9</sup> *Id.*

<sup>10</sup> *Id.*

<sup>11</sup> *Id.* at 1098.

<sup>12</sup> *Id.* The Ninth Circuit vacated the \$100,000 award for violation of the Lanham Act as duplicative of the damage award, but noted that the Lanham Act claim was not "moot." *Id.* at 1097, 1106 n.5. Interestingly also to note, is that the court affirmed the award of attorney's fees under the Lanham Act. *Id.* at 1106 n.5, 1112.

<sup>13</sup> *Id.* at 1098.

<sup>14</sup> *Id.*

<sup>15</sup> *Id.* at 1098-99.

<sup>16</sup> *Id.* at 1103-06, 1111-12.

<sup>17</sup> *Midler*, 849 F.2d at 463.

<sup>18</sup> *Waits*, 978 F.2d at 1103. The Ninth Circuit justified expanding awardable damages by stating that "*Midler* neither discussed nor limited the damages recoverable in a voice

publicity claim for damages results when "the appropriation of the identity of a celebrity . . . induce[s] . . . humiliation, embarrassment, and mental distress."<sup>19</sup> Furthermore, because Tom Waits had taken a public stance against others who reaped commercial profits from the publicity value of their identity, the court granted recovery "for any lacerations to his feelings."<sup>20</sup> The Ninth Circuit seemed so taken with the mortification and humiliation that Waits experienced from hearing "this corn chip sermon," that it affirmed the compensatory damages awarded by the jury.<sup>21</sup>

The Ninth Circuit upheld the jury's punitive damage award, noting that *Midler* provided notice to the defendants that professional singers have the right to control the commercial use of their distinctive voices.<sup>22</sup> *Waits* held, "punitive damages are available 'where it is proven by clear and convincing evidence that the defendant has been guilty of oppression, fraud, or malice.'" <sup>23</sup> The court defined malice as "despicable conduct which is carried on by the defendant with a *willful and conscious disregard of the rights or safety of others.*"<sup>24</sup> Apparently, Frito-Lay appropriated Waits' voice in such a "malicious" and "despicable" manner so as to warrant a two million dollar punitive award.

*Waits* reveals the Ninth Circuit's continuing intent to broaden the areas of protection relating to a celebrity's identity or persona.<sup>25</sup> With regard to the doctrine as a whole, *Waits* further expands and defines the scope of the publicity right and its remedies. As a result, *Waits* raises several concerns regarding the future of sound-alike and right of publicity actions. Most notably, *Waits* illustrates the need for increased consideration of the plaintiff's degree of fame and the courts' methods of damage calculation.

Specifically, although Tom Waits has produced seventeen albums in the past twenty years, he has never had a top ten hit, and neither he nor his music were recognized by the jury before trial.<sup>26</sup>

misappropriation action. *Midler* makes reference to the market value of Midler's voice solely to support its conclusion that her voice has economic value and, therefore, is a protectable property right." *Id.*

<sup>19</sup> *Id.* at 1103 (quoting *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 824 n.11 (9th Cir. 1974)).

<sup>20</sup> *Id.* (quoting *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 880-81 (S.D.N.Y. 1973)).

<sup>21</sup> *See id.*

<sup>22</sup> *Id.* at 1104-05 & n.4.

<sup>23</sup> *Id.* at 1104 (quoting CAL. CIV. CODE § 3294(a) (West Supp. 1992)).

<sup>24</sup> *Id.* (emphasis in original) (quoting CAL. CIV. CODE § 3294(c)(1) (West Supp. 1992)).

<sup>25</sup> *See Kent, supra note 4*, at 3; *see also* Edward G. Wierzbicki and Joseph J. Madonia, *Using Sound-Alikes in Ads is Risky Business*, CORP. LEGAL TIMES, Mar. 1992, at 18; Maxine S. Lans, *Sound-Alikes Sound Like a Legal Violation*, MARKETING NEWS TM, Jan. 18, 1993, at 7.

<sup>26</sup> Paul Feldman, *Tom Waits Wins \$2 1/2 Million in Voice-Theft Suit*, L.A. TIMES, May 9, 1990, at B1.

In essence, Waits has little proven commercial reputation of which to speak.<sup>27</sup> Commentators have noted "Waits is more a cult figure than a household name,"<sup>28</sup> and have even suggested that Waits use his award money to hire a good publicist because no one seems to know who he is.<sup>29</sup> In other words, Tom Waits is no Bette Midler.<sup>30</sup> Nevertheless, despite the lack of familiarity, the jury awarded \$2,500,000 to a man who would have received only \$100,000 had he actually done the commercial himself.<sup>31</sup>

In essence, the right of publicity sets no boundaries. No criterion exists to determine how bright a celebrity's star must shine to collect judgment. After *Waits*, the question also remains as to how courts will distinguish and separate singers' voices (which are protectable under right of publicity laws) from the singers' styles (which are not protected).<sup>32</sup> This Note will argue that the standard for determining an infringement of the right of publicity should be narrowed. To this end, this Note argues for a right of publicity law with more stringent guidelines.

Section II of this Note provides an overview of the development and scope of the right of publicity law and how it relates to voice misappropriation claims. This section also presents the countervailing policy issues that disfavor such claims, notably those relating to copyright law.

Section III analyzes the main justifications for publicity rights. This section, which relies on arguments recently propounded by Professor Michael Madow,<sup>33</sup> argues that the current justifications for recognizing a property right in one's celebrity lack compelling force. Section III also suggests that a voice misappropriation claim, to the extent it seeks to prevent consumer deception, might be better resolved through trademark and unfair competition law.

Finally, Section IV examines and comments upon various tests

<sup>27</sup> *Id.*

<sup>28</sup> Paul Feldman, *Tom Waits Looking to Collect Some Chips in Suit*, L.A. TIMES, May 1, 1990, at B3.

<sup>29</sup> Richard Harrington, *On the Beat - The Music Industry's Court Hits*, WASH. POST, May 30, 1990, at C7.

<sup>30</sup> The Ninth Circuit noted that Midler is a nationally known actress and singer. She won a Grammy in 1973 as the Best New Artist of the year. Her records have gone Platinum and Gold. In 1979, she was nominated for an Academy Award for Best Female Actress. In its March 2, 1987 issue, *Time Magazine* hailed her as "a legend" and "the most dynamic and poignant singer-actress of her time." *Midler*, 849 F.2d at 461. The Ninth Circuit, in contrast, referred to Waits as a "prestige artist" as opposed to a musical superstar. *Waits*, 978 F.2d at 1097.

<sup>31</sup> Harrington, *supra* note 29, at C7.

<sup>32</sup> See *Waits*, 978 F.2d at 1100-01.

<sup>33</sup> Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127 (1993).

designed to establish fair and comprehensive treatment for those parties involved in right of publicity actions. This Note asserts that courts should analyze advertisements in their entirety, and proposes a test that distinguishes between commercial and artistic uses of a celebrity's identity.

## II. OVERVIEW

The right of publicity evolved from the common law right of privacy—a right created by Justices Warren and Brandeis in their seminal law review article, *The Right to Privacy*.<sup>34</sup> Warren and Brandeis defined the common law right of privacy as "the right to be let alone."<sup>35</sup> Further expounding upon this concise definition, Warren and Brandeis concluded that the law should prevent other people and the media from prying into one's private life. The article stated:

The general object in view is to protect the privacy of private life. . . . In general, then, the matters of which the publication should be repressed may be described as those which concern the private life, habits, acts, and relations of an individual. . . . Some things all men alike are entitled to keep from popular curiosity. . . .<sup>36</sup>

Thus, the article recognized the potential for emotional harm and embarrassment if third parties disclosed personal information without the person's permission.

Given the nature of celebrity and fame, however, traditional right of privacy law inadequately protected those in the public spotlight.<sup>37</sup> Due to the frequency with which a celebrity's name or picture appears in the media, right of privacy law held that a celebrity's fame and public presence constituted a waiver of any privacy interests in his picture or name.<sup>38</sup> Hence, the issue remained as to how a celebrity could maintain a successful cause of action for unwanted unauthorized use.<sup>39</sup>

<sup>34</sup> Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

<sup>35</sup> *Id.* at 195. (quoting THOMAS M. COOLEY, COOLEY ON TORTS, at 29 (2d. ed. 1888)).

<sup>36</sup> *Id.* at 215-16.

<sup>37</sup> The federal courts generally define a "celebrity" as a person whose name is "a 'household word' whose ideas and actions the public in fact follows with great interest. . . . In undertaking this examination, a court must look through the eyes of a reasonable person. . . ." *Waldbaum v. Fairchild Publications, Inc.*, 627 F.2d 1287, 1292 (D.C. Cir.), cert. denied, 449 U.S. 898 (1980).

<sup>38</sup> See, e.g., J. Thomas McCarthy, THE RIGHTS OF PUBLICITY AND PRIVACY § 1.6, at 1-28 (1990).

<sup>39</sup> See *O'Brien v. Pabst Sales Co.*, 124 F.2d 167 (5th Cir. 1941).

The Second Circuit Court of Appeals first recognized the right of publicity in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>40</sup> This case involved two competing baseball card companies, who vied for the rights to use players' pictures on their cards.<sup>41</sup> Haelan alleged that Topps knowingly induced various baseball stars to breach their exclusive contracts with Haelan, and to sign contracts with Topps.<sup>42</sup> To recognize Haelan's cause of action, the court had to find that the players had rights in their likenesses which could be assigned exclusively to others. In effect, the court created a new right. The Second Circuit held that "in addition to and independent of that right of privacy . . . a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture. . . ."<sup>43</sup> Confusion resulted despite the official judicial recognition. Courts differed as to whether to recognize the right of publicity as an independent right, or to subsume it within the right of privacy.<sup>44</sup>

The law review articles following *Haelan* best illustrate the debate that emerged. Professor Nimmer, in his groundbreaking article, *The Right of Publicity*,<sup>45</sup> argued that privacy and publicity doctrines protect two distinct interests. Privacy law, he wrote, sought to shield people from unwanted publicity, while right to publicity law sought to compensate those who have been deprived of the benefits which derive from the unauthorized uses of their persona.<sup>46</sup>

Nimmer, moreover, argued for a right of publicity law independent of copyright, trademark, and state unfair competition law.<sup>47</sup> To prove infringement in these areas of law, the plaintiff must prove that the defendant's use resulted in a likelihood of confusion.<sup>48</sup> Confusion in this instance requires that the unauthorized use gives the impression that the plaintiff endorsed the product in some way.<sup>49</sup> Some advertisements, however, use a person's identity simply to call attention to the product without implying an actual

<sup>40</sup> 202 F.2d 866, 868 (2d Cir.), cert. denied, 346 U.S. 816 (1953).

<sup>41</sup> *Id.* at 867.

<sup>42</sup> *Id.*

<sup>43</sup> *Id.* at 868.

<sup>44</sup> See *Stephano v. News Group Publications, Inc.*, 474 N.E.2d 580, 583-84 (N.Y. 1984) (stating that New York has no independent right of publicity, as that right is subsumed by state statutory right of privacy).

<sup>45</sup> Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

<sup>46</sup> *Id.* at 204.

<sup>47</sup> *Id.*

<sup>48</sup> *Id.* Currently, the right of publicity has no likelihood of confusion requirement.

<sup>49</sup> 15 U.S.C. § 1114(a) (1988).

endorsement.<sup>50</sup> For Nimmer, these fields of law provided inadequate protection to the right of publicity plaintiff.

Thus, Nimmer espoused the "identifiability" test of infringement for violations of the right of publicity.<sup>51</sup> He argued that to merely draw attention to a product through identifiable use of a person's identity constituted an infringement of the right of publicity.

Dean Prosser, in contrast, who authored the influential article *Privacy*,<sup>52</sup> recognized the proprietary interest in one's identity, but subsumed it within the right of privacy. Prosser identified four categories of privacy: 1) intrusion upon physical solitude; 2) public disclosure of private facts about the plaintiff; 3) publicity that places someone in a false light; and 4) appropriation of one's name or likeness for another's benefit.<sup>53</sup> Prosser's "right of publicity" which is limited to name and likeness, falls under the fourth category and has been adopted by the Restatement of Torts<sup>54</sup> and by several states.<sup>55</sup>

The United States Supreme Court in *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>56</sup> sought to mitigate this confusion by distinguishing the nature of these two rights. The Court stated that the chief distinction was that the right of publicity was a proprietary interest with policy goals similar to those of patent and copyright, which protect an individual's right to reap the rewards of his work.<sup>57</sup> Conversely, the Court described the right of privacy as a personal right with policy objectives comparable to laws against defamation, which seek to protect one's reputation.<sup>58</sup>

Despite the debate over the right of publicity's proper relation to privacy law, courts since *Haelan* have expanded continuously the scope of the right to protect a broad range of personal attributes from commercial exploitation. For example, in *Mötschenbacher v. R.J. Reynolds Tobacco Co.*,<sup>59</sup> the defendant tobacco company attempted to convey the impression that a famous race car driver,

<sup>50</sup> Nimmer, *supra* note 45, at 212.

<sup>51</sup> *Id.*

<sup>52</sup> Prosser, *Privacy*, 48 CAL. L. REV. 383, 389 (1960).

<sup>53</sup> *Id.*

<sup>54</sup> "One who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of his privacy." RESTATEMENT (SECOND) OF TORTS § 652C (1977).

<sup>55</sup> See, e.g., N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1976 & Supp. 1989); see *infra* text accompanying note 70 for text of statute.

<sup>56</sup> 433 U.S. 562 (1977).

<sup>57</sup> *Id.* at 573.

<sup>58</sup> *Id.*

<sup>59</sup> 498 F.2d 821 (9th Cir. 1974).

Lothar Motschenbacher, endorsed Winston cigarettes by using pictures of the driver's car in its commercial.<sup>60</sup> Although Motschenbacher was not recognizable, the Ninth Circuit nevertheless held that the defendants had invaded a proprietary interest of Motschenbacher in his own identity.<sup>61</sup> The court reasoned that the car suggested Motschenbacher himself, and carried with it the power to convey his endorsement.

In *Carson v. Here's Johnny Portable Toilets, Inc.*,<sup>62</sup> the Sixth Circuit went so far as to hold that even a phrase, to which a well-known television personality has given secondary significance, may be enjoined from unauthorized commercial use on the grounds that such use is an appropriation of the celebrity's identity.<sup>63</sup> The defendant in this case marketed his portable toilet with the phrase "Here's Johnny," followed by the slogan "The World's Foremost Comedian," hoping such clever puns would generate interest and attract customers.<sup>64</sup> Johnny Carson based his right of publicity claim on the fact that the public commonly associated the phrase "Here's Johnny" with him.<sup>65</sup> This decision, as well as that of *Motschenbacher*, was significant because the court dispensed with the traditional notion that the crux of a successful right of publicity claim involved appropriation of a name or likeness.<sup>66</sup> To this end, "a celebrity's legal right of publicity is invaded whenever his identity is intentionally appropriated for commercial purposes."<sup>67</sup> The majority further noted that expanding the right of publicity would encourage creativity and prevent unjust enrichment by those who seek to exploit commercially the identity of celebrities without their consent.<sup>68</sup>

#### A. Statutory Shortcomings

The common law's receptive attitude toward right of publicity claims makes such decisions as *Midler* and *Waits* easier to understand. Despite the increased willingness of courts to extend the right to include such attributes as voice, state statutes have not kept pace. Indeed, two relevant statutes, New York and California, reveal that while the legislators prohibit the imitation of an individ-

<sup>60</sup> *Id.*

<sup>61</sup> *Id.* at 825.

<sup>62</sup> 698 F.2d 831 (6th Cir. 1983).

<sup>63</sup> *Id.* at 837.

<sup>64</sup> *Id.* at 833.

<sup>65</sup> *Id.* at 837.

<sup>66</sup> *See id.*

<sup>67</sup> *Id.*

<sup>68</sup> *Id.*

ual's physical appearance, no such protection yet exists to prohibit the imitation of a person's voice.

New York Civil Rights Law sections 50 and 51 provide statutory protection for the right of publicity in New York.<sup>69</sup> Under New York law, one cannot use a person's "name, portrait or picture" for trade or advertising purposes without that person's prior written consent.<sup>70</sup> Courts generally construe this statute broadly, and hold that a misappropriator need not use an actual portrait or picture to violate the statute.<sup>71</sup> Rather, the statute prohibits any representations which are "recognizable as likenesses of the complaining individual."<sup>72</sup> In sum, a broad construction is necessary to further the purpose of the statute—to "grant recognition to the . . . right of an individual to be immune from commercial exploitation."<sup>73</sup> *Onassis v. Christian Dior-New York*<sup>74</sup> illustrates this point.

In *Onassis*, Jacqueline Kennedy Onassis successfully enjoined the use of a look-alike in an advertisement for Christian Dior products.<sup>75</sup> The advertisement contained an Onassis look-alike surrounded by actual celebrities. The court construed the purpose of section 50, noting that although "the statute may not, by its terms, cover voice or movement, characteristics or style, it is intended to protect the essence of the person, his or her identity or persona from being unwillingly or unknowingly misappropriated for the profit of another."<sup>76</sup> The court disapproved of the defendant's literal reading of the statute to further its commercial ends. Hence, the court held that the use of a look-alike face to portray the face of another constitutes a "portrait or picture," and the court can enjoin such use.<sup>77</sup>

One should note, however, that the *Onassis* court acknowledged that other characteristics existed—notably voice—by which one may readily identify a celebrity, but which the legislature had not included in the statute.<sup>78</sup> Thus, these features were not entitled to protection under the statute.<sup>79</sup>

<sup>69</sup> N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1976).

<sup>70</sup> *Id.*

<sup>71</sup> *See Onassis v. Christian Dior-New York, Inc.*, 472 N.Y.S.2d 254, 259 (Sup. Ct. 1984) (citing *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978)).

<sup>72</sup> *Id.*

<sup>73</sup> *Id.* at 258 (citations and internal quotations omitted).

<sup>74</sup> 472 N.Y.S.2d 254 (Sup. Ct. 1984).

<sup>75</sup> *Id.*

<sup>76</sup> *Id.* at 260.

<sup>77</sup> *Id.* at 260-61.

<sup>78</sup> *Id.*

<sup>79</sup> *Id.* at 261. To this end, the court suggested that it might have been the legislature's oversight not to include "sound" in the statute. When sections 50 and 51 were first enacted in 1903, "the [reproduced] sound of a voice was not contemplated." *Id.* at 259.

California, in direct contrast, enacted legislation which prohibits the misappropriation of an individual's "voice" or "likeness" for advertising or selling without the individual's consent.<sup>80</sup> Section 3344 of the California Civil Code provides, "[a]ny person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner . . . for purposes of advertising or selling . . . goods or services, without such person's prior consent. . . shall be liable. . . ."<sup>81</sup>

Although the prohibition against exploitation of a "likeness" recognizes that indirect use of a celebrity's persona has the same intrusive effect as an actual representation, the Ninth Circuit's interpretation extends only to a "photograph" and not a "voice." *Midler*, to this end, held that "[t]he term 'likeness' refers to a visual image not a vocal imitation."<sup>82</sup> Thus, the California statute encompasses look-alikes but not sound-alikes.

One commentator notes, however, that if the Ninth Circuit followed the *Onassis* decision, a more expansive interpretation of section 3344 would result.<sup>83</sup> As stated, the *Onassis* court believed the New York law sought to prevent the unauthorized commercial exploitation of an individual's identity. Furthermore, *Onassis* also implied that the prohibitions of the New York Civil Rights Law would extend to sound-alikes, had the legislature included "voice" within the statute. Taking into consideration that the California legislators patterned their statute, which includes "voice," after New York's, one logically could interpret section 3344 to prohibit the imitation of a distinctive voice.<sup>84</sup>

#### B. Sound-Alike Actions: *The Road to Waits and Midler*

Before *Midler* and *Waits*, the Ninth Circuit manifested an unwillingness to protect celebrities. The Ninth Circuit articulated this unwillingness in both *Davis v. Trans World Airlines*<sup>85</sup> and *Sinatra v. Goodyear Tire & Rubber Co.*,<sup>86</sup> where the court held that the mere imitation of a voice did not give rise to a cause of action. Notably, however, both cases were decided prior to the passage of section 3344.

In *Davis*, the nationally known singing group, "The Fifth Di-

<sup>80</sup> CAL. CIV. CODE § 3344 (West Supp. 1989).

<sup>81</sup> *Id.*

<sup>82</sup> *Midler*, 849 F.2d at 463.

<sup>83</sup> Melissa M. Davis, Note, *Voicing Concern: An Overview of the Current Law Protecting Singers' Voices*, 40 SYRACUSE L. REV. 1255, 1263-64 (1989).

<sup>84</sup> *Id.* at 1264.

<sup>85</sup> 297 F. Supp. 1145 (C.D. Cal. 1969).

<sup>86</sup> 435 F.2d 711 (9th Cir. 1970).

mension," had recorded and popularized the song "Up, Up and Away."<sup>87</sup> Defendant TWA purchased a license to use the copyrighted music, lyrics, and arrangement of the song for use in a television commercial.<sup>88</sup> TWA modified the lyrics in order to advertise its services, and hired an unidentified vocalist and a chorus to perform the composition.<sup>89</sup> The plaintiff brought suit under common law theories of invasion of privacy and "passing-off."<sup>90</sup> The court upheld TWA's motion for summary judgment. It ruled that where an advertiser uses an allegedly imitative performance of another singing group's performance, and does not hold out to the public that the commercial embodies the performance of any particular individual, there is no "passing-off" of the commercial as a product of the plaintiff.<sup>91</sup> The defendants, thus, did not invade the plaintiff's privacy, nor did they violate any of the plaintiff's personal rights.<sup>92</sup>

In *Sinatra*, Nancy Sinatra popularized a recording of a song entitled "These Boots Are Made For Walkin'."<sup>93</sup> The defendants, Goodyear Tire, came up with the phrase "wide boots" to describe their tires.<sup>94</sup> As part of its "wide boots" advertising campaign, the defendants produced six radio and television commercials using the music and slightly revised lyrics from "These Boots Are Made For Walkin' " in combination with the voice of a female singer who was neither shown nor identified by name.<sup>95</sup> Sinatra alleged that she had popularized the song to such an extent that her name had become identified with it. She further alleged that the defendant intentionally tried to deceive the public into believing that she participated in the commercials, and that this constituted the tort of passing-off.<sup>96</sup>

The court held, however, that the defendant had merely made legal use of its copyright license.<sup>97</sup> The court noted that Sinatra did not allege that her sound was so uniquely personal that the public could readily identify her, but rather that it was "the sound in connection with the music, lyrics and arrangement, which made

<sup>87</sup> *Davis*, 297 F. Supp. at 1146.

<sup>88</sup> *Id.* at 1147.

<sup>89</sup> *Id.* at 1146.

<sup>90</sup> See *infra* text accompanying notes 167-68 for a description of a "passing off" claim.

<sup>91</sup> *Davis*, 297 F. Supp. at 1147.

<sup>92</sup> *Id.*

<sup>93</sup> *Sinatra*, 435 F.2d at 712.

<sup>94</sup> *Id.*

<sup>95</sup> *Id.*

<sup>96</sup> *Id.* at 712-13.

<sup>97</sup> *Id.* at 717-18.

her the subject of popular identification. . . .<sup>98</sup> Although these latter items were copyrightable, the plaintiff had acquired no rights to them.<sup>99</sup> The court further noted that even to the untrained ear, one could clearly distinguish between Sinatra's voice and the one used in the commercial. Thus, no confusion as to the source existed.<sup>100</sup> In essence, to grant the plaintiff the right to protect her rendition of the song would limit the benefits of copyright to the copyright holder.<sup>101</sup> Such action would conflict directly with the copyright law, and would therefore be preempted.<sup>102</sup>

In sum, before the current trend towards expanding the right of publicity, advertisers triumphed in sound-alike causes of action chiefly because a singer could not copyright his performance under the federal law.<sup>103</sup> Copyright law extends protection only to subject matter fixed in a tangible medium of expression.<sup>104</sup> A court considers a work "fixed" when its embodiment "is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."<sup>105</sup> Under these terms, the law prohibits unauthorized copying of songs and musical compositions, but does not extend protection to an actual performance.<sup>106</sup> Thus, copyright law created a loophole through which advertisers often can buy the rights to a song and then duplicate it using studio musicians and sound-alike singers. Before *Midler* and *Waits*, the only solution for a performer faced with this dilemma was to buy the rights of the song.<sup>107</sup>

Although *Davis* and *Sinatra* illustrate the Ninth Circuit's previous aversion to protecting celebrities, they also remotely suggest the creation of this new property right. To this end, *Sinatra* implies that if a performer seeks to enjoin simulation of her work under copyright law, she must show that defendant not only attempted to imitate her style and sound, but also that her rendition of the work is exceptionally unique in order to avoid preemption.<sup>108</sup>

<sup>98</sup> *Id.* at 716.

<sup>99</sup> *Id.*

<sup>100</sup> *Id.* at 716, 718 n.12.

<sup>101</sup> *Id.* at 717-18.

<sup>102</sup> *Id.*

<sup>103</sup> 17 U.S.C. § 114(a) (1988).

<sup>104</sup> 17 U.S.C. § 102(a) (1988).

<sup>105</sup> 17 U.S.C. § 101 (1988).

<sup>106</sup> *See id.*

<sup>107</sup> *See Sinatra*, 435 F.2d at 716 (observing that if plaintiff wanted to prevent defendant from using the song she popularized she should have purchased the copyright).

<sup>108</sup> *Id.* (citation omitted).

### C. Copyright Preemption: Does the Loophole Still Exist?

Further exploration on the issue of preemption demands investigation of § 301(b) of the Copyright Act of 1976, which sets forth a statutory standard.<sup>109</sup> This section invalidates state law that directly conflicts with federal law or hinders the achievement of the congressional objectives embodied within it.<sup>110</sup> A federal law, however, preempts a state-created right only when it conflicts with federal mandate or policy.<sup>111</sup> Thus, congressional intent is determinative. If Congress intends to regulate an entire field of law, this invariably leads to preemption.<sup>112</sup>

Nevertheless, § 301 appears to limit preemption only to cases where state law protects rights *identical* to those protected by copyright.<sup>113</sup> Professor Nimmer observes that if other elements are required by the state created course of action, in addition to or instead of, the acts of reproduction, then the right does not lie within the *general* scope of copyright, and there is no preemption.<sup>114</sup>

The inducement for an advertiser's use of a sound-alike, according to *Midler* and *Waits*, constitutes this extra element. *Midler* posits that an advertiser uses a sound-alike to capitalize on the audience's familiarity with the public figure.<sup>115</sup> Using a sound-alike in this commercial context exceeds the copyright license and misappropriates another's identity.<sup>116</sup>

In attempting to dispel the voice misappropriation claim, the *Waits* defendants argued that the Supreme Court implicitly overruled *Midler* in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,<sup>117</sup> and, moreover, that the Federal Copyright Act, notably § 114,<sup>118</sup> preempted the voice misappropriation tort.<sup>119</sup>

In *Bonito*, the Supreme Court ruled that a Florida statute giving perpetual patent-like protection to boat hull designs was preempted by federal patent law because it directly conflicted with the comprehensive federal patent scheme.<sup>120</sup> In reaching this decision, the Court cited the earlier patent cases of *Sears, Roebuck & Co.*

<sup>109</sup> 17 U.S.C. § 301 (1976).

<sup>110</sup> *Hines v. Davidowitz*, 312 U.S. 52, 66-67 (1941).

<sup>111</sup> *Goldstein v. California*, 412 U.S. 546 (1973).

<sup>112</sup> LAURENCE H. TRIBE, *AMERICAN CONSTITUTIONAL LAW* § 6-27, at 500 (2d ed. 1988).

<sup>113</sup> NIMMER, *COPYRIGHT* § 1.01(B), at 1-11 (1979).

<sup>114</sup> *Id.* at 1-15.

<sup>115</sup> *Midler*, 849 F.2d at 463.

<sup>116</sup> *Id.* at 463-64.

<sup>117</sup> 489 U.S. 141 (1989).

<sup>118</sup> 17 U.S.C. § 114 (1976).

<sup>119</sup> *Waits*, 978 F.2d at 1100.

<sup>120</sup> *Bonito*, 489 U.S. 141 (1989).



*v. Stiffel Co.*,<sup>121</sup> and *Compco Corp. v. Day-Brite Lighting, Inc.*<sup>122</sup> Frito-Lay, the defendant in *Waits*, contended that this reliance on *Sears* [and] *Compco* reaffirmed the sweeping preemption principles for which these cases were once read to stand—principles that the Court used to reject entertainers' challenges to the unauthorized use of sound-alikes.<sup>123</sup>

*Sears* and *Compco* essentially propounded a federal policy that encouraged commercial imitation and led to the preemption of much state law regarding intellectual property, including the right of publicity. Later Supreme Court decisions, however, substantially narrowed the broad preemptive thrusts of *Sears* and *Compco*.<sup>124</sup> To this end, the *Waits* Court rejected the defendant's arguments on these grounds. The Ninth Circuit noted that the Supreme Court in *Zacchini v. Scripps-Howard Broadcasting Co.* followed the *Sears* and *Compco* decisions, and recognized the authority of states to protect entertainers' rights of publicity.<sup>125</sup>

Despite the Ninth Circuit's reading of *Bonito Boats*, evidence exists that supports Frito-Lay's argument that *Bonito Boats* presents a retreat from the more expansive role for state intellectual property law enunciated in prior cases.<sup>126</sup> "In some ways, *Bonito Boats* constitutes stronger precedent in favor of preemption than does *Sears* and *Compco*."<sup>127</sup> A unanimous Supreme Court decided *Bonito Boats*, whereas the *Sears* and *Compco* courts were divided.<sup>128</sup> More importantly, the *Bonito Boats* court made some sweeping statements: "States may not offer patent-like protection to intellectual creations which would otherwise remain unprotected as a matter of federal law."<sup>129</sup> Given the fact that the Supreme Court in both *Sears* and *Compco* refused to distinguish between patent and copyright for preemption purposes, on its broadest level *Bonito Boats* could stand for the proposition that all state law conferring protection on any product of the mind faces preemption under federal law.<sup>130</sup> This would include right of publicity law and state misappropriation laws.

<sup>121</sup> 376 U.S. 225 (1964).

<sup>122</sup> 376 U.S. 234 (1964).

<sup>123</sup> *Waits*, 978 F.2d at 1099.

<sup>124</sup> See, e.g., *Goldstein v. California*, 412 U.S. 546 (1973) (state law against record-piracy not preempted by copyright). See *infra* text accompanying note 157 (discussing *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1978)).

<sup>125</sup> See *Waits*, 978 F.2d at 1099-100.

<sup>126</sup> CRAIG JOYCE, COPYRIGHT LAW 889 n.8 (2d ed. 1991).

<sup>127</sup> *Id.*

<sup>128</sup> *Id.*

<sup>129</sup> See *Bonito Boats*, 489 U.S. at 156.

<sup>130</sup> See JOYCE, *supra* note 126, at 889 n.8.

After first determining that copyright law as a whole did not preempt California voice misappropriation law, the Ninth Circuit next rejected defendant's more specific contention that § 114 of the Act, which governs the scope of exclusive rights in sound recordings, preempted *Waits*' voice misappropriation claim.<sup>131</sup> Under § 114, a state cause of action will escape preemption if its subject matter does not come within the subject matter of copyright. Noting that *Waits*' claimed infringement concerned voice, rather than the infringement of copyrightable subject matter such as a sound recording or musical composition, the court stated, as it did in *Midler*, "[a] voice is not copyrightable. The sounds are not 'fixed.'" <sup>132</sup> The court also cited the legislative history of § 114, noting that the elements of voice misappropriation are "different in kind" from those in a copyright infringement case.<sup>133</sup> As such, the Copyright Act does not preempt a claim of voice misappropriation.

Further preemption analysis suggests that the Ninth Circuit incorrectly interpreted *Bonito* and § 114, at least for situations involving *Midler* and *Sinatra*-type fact patterns.<sup>134</sup> These cases involved celebrities seeking to recover the value of their performances in fixed tangible copyrighted works. As one commentator notes:

Congress explicitly has addressed the question of whether to provide for the rights of performers separate from the rights of copyright holders and consistently has denied such a "performance right." . . . [C]opyright law specifically allows imitation or simulation of a copyrighted recording. As a result, the performers of a sound recording have no rights in that recording. Although commentators have argued that a performance right is necessary, until Congress provides for such a right, principles of federalism demand that states, particularly through the intervention (or invention) of the judiciary, do not. . . .

Arguments denying preemption where imitation of a copyrighted recording is concerned fail to consider the clarity of Congress's intent on this issue. Congress never intended to allow states to prohibit imitation of sounds. A state right of publicity that prohibits vocal imitation is inconsistent with congressional intent as expressed in the copyright law and is therefore preempted.<sup>135</sup>

<sup>131</sup> *Waits*, 978 F.2d at 1099.

<sup>132</sup> *Id.* at 1100 (citation omitted).

<sup>133</sup> *Id.*

<sup>134</sup> See *supra* text accompanying notes 1-3, 93-96.

<sup>135</sup> Christopher Pesce, Note, *The Likeness Monster: Should the Right of Publicity Protect Against Imitation?*, 65 N.Y.U. L. Rev. 782, 818-19 (1990) (footnotes omitted). Pesce's piece



Thus, *Waits*' argument stating that the legislative history of § 114 reveals the express intent of Congress to allow the "evolving common law rights of . . . 'publicity'"<sup>136</sup> to remain unaffected by the preemption provision flounders.

The *Waits* case presents a different scenario. Here, the actionable conduct consisted of the simulation of *Waits*' distinctive, identifiable style—a form of expression. The defendants, however, did not copy any particular *Waits*' recording. Thus, it is questionable whether this form of expression constituted a work of authorship fixed in a tangible medium.<sup>137</sup> A court might find, as did the *Waits* court, that no basis for preemption under the 1976 Copyright Act exists.

Professor David Shipley suggests an alternative to the *Waits* approach.<sup>138</sup> Tom *Waits*' performances often have been recorded, taped and even filmed. This suggests that his form of expression—gestures, choice of music, singing style, etc.—arguably has been fixed in several different tangible mediums.<sup>139</sup> Shipley comments: "With fixation, style may become a 'writing' qualifying for copyright protection. In view of the plaintiff's basic goal of recovering for the unauthorized copying of this form of expression—a right equivalent to copyright—it is possible to conclude that his right of publicity action is subject to preemption."<sup>140</sup>

Regardless of the approach, the field of preemption remains problematic. Publicity actions often involve rights that are, at the very least, arguably "equivalent" to the exclusive rights of copyright. *Waits* illustrates that these "equivalent" rights do not necessarily inhere in works of authorship fixed in tangible mediums of expression. Thus, at least in the Ninth Circuit's view, they fall outside the subject matter of copyright and escape preemption.

### III. ARGUMENTS FOR AND AGAINST THE RIGHT OF PUBLICITY

There are three main justifications for a right of publicity. The first espouses a natural law approach and advances a moral argument that celebrities have the right to reap the fruits of their labor. The second is a utilitarian "economic" approach advocated by right of publicity proponents. This argument holds that the

provides more expansive treatment on the issue of preemption. See also David E. Shipley, *Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673 (1981).

<sup>136</sup> *Waits*, 978 F.2d at 1100.

<sup>137</sup> See 17 U.S.C. § 102(a).

<sup>138</sup> Shipley, *supra* note 135, at 711.

<sup>139</sup> *Id.*

<sup>140</sup> *Id.* at 711-12.

right of publicity, like copyright, provides the necessary incentives to stimulate creative effort and achievement. Some courts advance a third justification, claiming that the right of publicity is a means of consumer protection. This argument adopts a trademark approach, as it seeks to shield consumers from deception.

#### A. Moral Arguments

Melvin Nimmer's article, *The Right of Publicity*<sup>141</sup> derived the right from a tenet of Anglo-American jurisprudence, "every person is entitled to the fruit of his labors unless there are important countervailing public policy considerations."<sup>142</sup> A person who "long and laboriously nurtured the fruit of publicity values" and expended "time, effort, skill, and even money" in his creation, presumably should be entitled to enjoy them himself.<sup>143</sup>

Most courts invoking the right of publicity subscribe to the view that fame derives from the careful "cultivation" of one's talents, the slow building of one's image, and the deliberate "nurturing" of one's publicity values.<sup>144</sup> Professor Thomas McCarthy authors the only book on the right of publicity and analogizes that "while one person may build a home, and another knit a sweater so also may a third create a valuable personality."<sup>145</sup> All three, he argues, "should be recognized by the law as 'property' protected against trespass and theft."<sup>146</sup>

Professor Madow argues that this "fruits of one's labor" rationale derives from a fundamental misconception of the processes "by which fame is generated and public images are formed in our society."<sup>147</sup> To this end, Madow believes "fame is a 'relational' phenomenon, something that is *conferred by others*."<sup>148</sup> Madow writes:

A person can, within the limits of his natural talents, *make himself* strong or swift or learned. But he cannot, in this same sense, *make himself famous*, any more than he can *make himself*

<sup>141</sup> Melvin Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954).

<sup>142</sup> *Id.* at 216.

<sup>143</sup> *Id.*

<sup>144</sup> See, e.g., *Lombardo v. Doyle*, 396 N.Y.S.2d 661, 664 (App. Div. 1977) (stating bandleader Guy Lombardo "invested 40 years" in "carefully and painstakingly" building "his public personality as Mr. New Year's Eve"); see also *Hirsch v. S.C. Johnson & Sons, Inc.*, 280 N.W.2d 129, 134-35 (Wis. 1979) (holding football great Elroy "Crazylegs" Hirsch devoted "much time and effort" to "assiduously cultivat[ing] a reputation not only for skill as an athlete, but as an exemplary person whose identity was associated with sportsmanship and high qualities of character").

<sup>145</sup> THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY & PRIVACY* (1992).

<sup>146</sup> *Id.* at 459.

<sup>147</sup> Madow, *supra* note 33, at 188.

<sup>148</sup> *Id.* at 188 (emphasis in original).

loved. Furthermore, fame is often conferred or withheld, just as love is, for reasons and on grounds other than "merit." There is ample room for disagreement about just how wide the gap between fame and merit actually is, about just how contingent and morally arbitrary the mechanisms of renown really are. . . . [T]he reason one person wins universal acclaim, and another does not, may have less to do with their intrinsic merits or accomplishments than with the needs, interests, and purposes of their audience. . . .

. . . The point here is not to suggest that there is *nothing* to fame but luck, circumstance, and politics. . . . The point, rather, is that Fame does not play fair; it plays favorites.

. . . [T]he practical effect of the right of publicity. . . operate[s] to channel additional dollars to the very people . . . who happen to draw first-prize tickets in the fame lottery.<sup>149</sup>

Thus, Madow's argument stresses the role the celebrity's audience and the media play in defining the meanings of a celebrity's "star image. . . [and] the 'publicity values' that attach to it."<sup>150</sup> Contrary to the arguments of Nimmer and McCarthy, a celebrity cannot say of her image that "I made it," since a celebrity cannot make such a claim to her public image, "she cannot lay a convincing moral claim to the *exclusive* ownership or control of the economic values that attach to it."<sup>151</sup>

### B. Economic Arguments

Courts frequently assert that the purpose of the right of publicity, like that of copyright, is to provide an economic incentive for entertainment, creativity, and achievement. The right of publicity induces people to expend the time, effort, and resources necessary to develop talents and produce works that ultimately benefit society as a whole. Celebrities receive a "legal entitlement to the economic value of their identities not because they 'deserve' it or have a moral 'right' to it, but rather because . . . [society] encourage[s] socially valuable activities and achievements."<sup>152</sup>

Madow questions whether the right of publicity results in an increase in creativity and achievement, and, if so, whether this increase is substantial. This question involves a great deal of sociological guesswork, and requires insight into human nature and motivation. Although one cannot answer this question with cer-

<sup>149</sup> *Id.* at 188-89 (footnotes omitted).

<sup>150</sup> *Id.* at 195.

<sup>151</sup> *Id.* at 196 (footnote omitted).

<sup>152</sup> *Id.* at 206.

tainty, Madow believes that the abolition of the right of publicity would have little or no effect on intellectual and artistic creation.<sup>153</sup>

Madow asserts that there are flaws in the copyright analogy. Copyright directly protects the primary, if not only, source of income of writers. The right of publicity, in contrast, protects only a collateral source of income for celebrities.<sup>154</sup> Whereas abolition of copyright might cripple an author's ability to generate income, the destruction of the right of publicity would leave unscathed a celebrity's ability to earn a living from those activities that generated the fame in the first place.<sup>155</sup>

Madow's incentive argument gains support from *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>156</sup> In this case, a news reporter from a local television station videotaped the plaintiff's "human cannonball" act at an Ohio county fair. On its evening news program, defendant aired a fifteen second clip of Zacchini's performance without his consent. The clip essentially contained the crux of Zacchini's act, showing Zacchini being shot from a cannon into a net.

The Supreme Court, in a 5-4 decision, held that the First Amendment did not give the defendant the right to broadcast Zacchini's "entire act."<sup>157</sup> The Court employed the right of publicity to protect what it termed "performance values"—the right to control the dissemination of his performance.<sup>158</sup> The Court reasoned that this performance right furthered the aim and rationale of copyright and patent protection. The performance right "provides an economic incentive [for an entertainer] to make the investment required to produce a performance of interest to the public."<sup>159</sup>

The Court believed that a more compelling argument for the incentive rationale results when a defendant appropriates a performer's entire act. This stands in direct contrast to the typical right of publicity claim, which involves unauthorized advertising or merchandising use:

the broadcast of petitioner's entire performance, unlike the unauthorized use of another's name for purposes of trade . . . goes to the heart of petitioner's ability to earn a living as an enter-

<sup>153</sup> *Id.* at 208.

<sup>154</sup> *Id.* at 209.

<sup>155</sup> *Id.*

<sup>156</sup> 433 U.S. 562 (1977).

<sup>157</sup> *Id.* at 574-75.

<sup>158</sup> *Id.* at 575.

<sup>159</sup> *Id.* at 576.

tainer. Thus, in this case, Ohio has recognized what may be the strongest case for a "right of publicity"—involving, not the appropriation of an entertainer's reputation to enhance the attractiveness of a commercial product, but the appropriation of the very activity by which the entertainer acquired his reputation in the first place.<sup>160</sup>

In sum, the "right of publicity" protects a celebrity's interest in the economic value of his identity. Zacchini, in contrast, complained of the appropriation of the economic value of his performance—not his marketable public image. As such, Zacchini did not seek to vindicate his right of publicity. Instead, the "right of performance" better characterizes the rights involved in *Zacchini*.<sup>161</sup>

Thus, Madow concludes that in light of *Zacchini*, economic incentive arguments make more sense for performance rights and copyright than for publicity rights.<sup>162</sup> However, courts, including *Midler* and *Waits*, have failed to make this distinction, and have repeatedly cited *Zacchini* for the proposition that the economic incentive argument justifies the right of publicity.

Madow next argues that when one considers the earnings of a celebrity, even without the right of publicity, the rate of return of stardom is probably high enough to bring forth a "more than 'adequate' supply of creative effort and achievement."<sup>163</sup> Any additional money celebrities earn from commercial exploitation of their likenesses, names, and voices, simply constitutes "economic rent, more like the proverbial icing on the cake than a necessary inducement."<sup>164</sup>

### C. Consumer Protection Argument

The third justification posits that the right of publicity exists to protect consumers from deceptive trade practices, and serves as a private law mechanism for advertising regulation.<sup>165</sup> If one accepts this argument as the sole justification for the right of publicity, and analyzes it independent of the moral and economic justifications as does Madow, the right of publicity doctrine becomes unnecessary. From this viewpoint, the emphasis shifts to the consumer rather than the celebrity. If the principal concern focuses on protecting

<sup>160</sup> *Id.*

<sup>161</sup> See Douglas G. Baird, Note, *Human Cannonballs and the First Amendment: Zacchini v. Scripps-Howard Broadcasting Co.*, 30 STAN. L. REV. 1185, 1186 n.7 (1978).

<sup>162</sup> Madow, *supra* note 33, at 208-09 n.395.

<sup>163</sup> *Id.* at 210.

<sup>164</sup> *Id.*

<sup>165</sup> *Id.* at 234.

the consumer from deception and confusion as to a celebrity's willingness to endorse a product, better tailored legal mechanisms exist to serve this purpose—namely, state unfair competition law and federal trademark law, i.e., the Lanham Act.<sup>166</sup> Brief descriptions of these two claims illustrate their similarity to a right of publicity action.

For a celebrity to maintain an unfair competition claim in the context of a sound-alike action, he must show: that he possesses a unique voice which the public recognizes; a claim regarding impersonation of his distinctive voice (not the combination of his voice and a copyrightable work); and a claim that the defendant has attempted to pass-off the advertisement as the performer's product.<sup>167</sup> The task of separating the voice from the words and tune of the song through which the public has come to identify the celebrity makes the unfair competition claim difficult to maintain.<sup>168</sup>

Decisions stemming from cases brought under section 43 of the Lanham Act suggest that the unauthorized use of an individual's likeness or name, in a manner that creates a false impression that the individual has endorsed a product, constitutes a violation of the Act.<sup>169</sup> With its "likelihood of confusion" standard, some commentators advocate that the Lanham Act should act as a federal right of publicity statute.<sup>170</sup>

*Waits* illustrates the nexus between the Lanham Act and the right of publicity. Here, the Ninth Circuit found numerous reasons to uphold *Waits'* section 43(a) claim. The Ninth Circuit primarily followed *Allen v. National Video Inc.*,<sup>171</sup> in which Woody Allen's Lanham Act claim succeeded because of the use of a look-alike in a print advertisement to promote a home video service. The defendant sought unsuccessfully to distinguish *Allen* on the fact that a connection existed between Woody Allen, a member of the motion picture industry, and the defendant, a motion picture distributor. In *Waits*, the plaintiff had no connection to Frito-Lay or other snack-food manufacturer. Nevertheless, the Ninth Circuit pronounced that a celebrity whose endorsement of a product is

<sup>166</sup> *Id.*

<sup>167</sup> See *Sinatra*, 435 F.2d at 712.

<sup>168</sup> See, e.g., *Lahr v. Adell Chemical Co., Inc.*, 300 F.2d 256 (1st Cir. 1962) (applying both New York and Massachusetts law, the court upheld Bert Lahr's (the Cowardly Lion from *The Wizard of Oz*) unfair competition claim on the ground that Lahr possessed a distinctively unique voice, and only attempted to protect his vocal sound and style from being imitated, as opposed to the combination of his voice with particular words).

<sup>169</sup> See *Waits*, 978 F.2d at 1106; see also, *Cher v. Forum Int'l, Ltd.*, 692 F.2d 634 (9th Cir. 1982); *Geisel v. Poynter Prods., Inc.*, 283 F. Supp. 261 (S.D.N.Y. 1968).

<sup>170</sup> See, e.g., *Pesce*, *supra* note 135, at 824.

<sup>171</sup> 610 F. Supp. 612 (S.D.N.Y. 1985).

implied through the imitation of a "distinctive attribute" of the celebrity's identity, has standing to sue for false endorsement under section 43(a).<sup>172</sup> In the Ninth Circuit's view, a purported endorser has an economic interest tantamount to that of a trademark.<sup>173</sup> Consequently, a celebrity need not allege actual competition to assert the commercial exploitation of his identity. Therefore, although Tom Waits did not make commercials and thus did not qualify as a "competitor," his standing under the Lanham Act was "sufficiently established by the likelihood that the wrongful use of his professional trademark, his unique voice, would injure him commercially."<sup>174</sup>

As a side note, the discussion of the Lanham Act in *Waits* proves interesting because the Ninth Circuit previously dismissed both the Lanham Act and unfair competition claims in *Midler*. The Ninth Circuit justified this turn-around by dismissing its previous views in *Midler* as dicta. Overall, the *Waits* court presented a long and skewed discourse on the meaning and applicability of the Lanham Act. The court likened a voice misappropriator to a film distributor who wrongly labeled a movie: "If a film's distributor wrongfully indicates that a film is 'PG'-rated, when in reality it should be 'R'-rated, a competitor with a 'PG'-rated film would have standing: the misrated film theoretically draws young audiences away from the competitor's film because of the misrepresentation concerning the suitability of its content."<sup>175</sup> Such reasoning has the potential to open the floodgates to right of publicity litigation.

#### D. Madow's Conclusion

Thus, Madow believes that recognizing a property right in a celebrity's publicity value serves no substantial social interest.<sup>176</sup> In his view, society should opt for a "more decentralized, open, 'democratic' cultural practice."<sup>177</sup>

As a general matter, the law ought to align itself with cultural pluralism and popular cultural production. It ought to expand, not contract, the space in which "local" discourses and alternative cultural practices can develop. For this reason, property rights in our culture's basic linguistic, symbolic, and discursive raw materials, should not be created unless a clear and convinc-

<sup>172</sup> *Waits*, 978 F.2d at 1106.

<sup>173</sup> *Id.*

<sup>174</sup> *Id.* at 1110.

<sup>175</sup> *Id.* at 1109.

<sup>176</sup> *Madow*, *supra* note 33, at 237.

<sup>177</sup> *Id.* at 239.

ing showing is made that very substantial social interests will thereby be served. As we have seen, no such showing has yet been made with respect to star images. The proponents of publicity rights still have work to do to persuade us why these images should not be treated as part of our cultural commons, freely available for use in the creation of new cultural meanings and social identities, as well as new economic values.<sup>178</sup>

Although Madow does not advocate the outright abolition of the right of publicity, he believes a more convincing justification for retaining it needs to be found elsewhere.<sup>179</sup>

#### IV. PROPOSAL FOR MORE STRINGENT RIGHT OF PUBLICITY STANDARD

##### A. Background

An indisputable tension exists between the right of publicity and the First Amendment. On one side, the right of publicity seeks to protect celebrities from the intentional appropriation of their identities. On the other side, the First Amendment espouses a policy of promoting the free flow of ideas essential to vigorous public discourse and the enrichment of our cultural experience.<sup>180</sup> When an advertiser appropriates material in such a way that incorporates his or her own original, expressive elements, the right of publicity defeats the countervailing goals of the First Amendment and impinges upon the appropriator's freedom of expression.

The Ninth Circuit, in its efforts to mitigate this tension in the context of voice misappropriation claims, holds that the key consideration centers around the purpose of the media's use of a person's identity.<sup>181</sup> As the *Midler* court stated, "[i]f the purpose is 'informative or cultural' the use is immune; 'if it serves no such function but merely exploits the individual portrayed, immunity will not be granted.'<sup>182</sup> Hence, the use of a sound-alike for purely commercial motives strips the advertiser of its First Amendment immunity. The problem with the Ninth Circuit's approach to First Amendment conflicts lies in its over-encompassing definition of "commercial." This problem, however, is one which has plagued both courts and commentators alike.

One proposed alternative to the current infringement stan-

<sup>178</sup> *Id.*

<sup>179</sup> *Id.*

<sup>180</sup> *See id.*

<sup>181</sup> *Midler*, 849 F.2d at 462.

<sup>182</sup> *Id.* (citation omitted).

dard derives from the copyright fair use balancing test,<sup>183</sup> and attempts to break down right of publicity problems into two black and white spheres.<sup>184</sup> Professor Lee Hetherington proposes a direct/indirect test, which does not distinguish between blatant and subtle uses of a celebrity's identity. Rather, it prohibits any unauthorized effort:

The primary thrust of which is to realize direct financial gain or advantage by evoking one's identity in a setting which is primarily commercial in nature. For purposes of illustration, any identity-related promotion, marketing, endorsement or solicitation involving a product, service or cause which results, or is likely to result, in any type of commercial gain or benefit to the user would be considered direct commercial exploitation.

Stated conversely, is the use merely indirect and incidental, subordinate to a primary purpose such as entertainment, parody, news reporting, scholarship, inspiration for artistic expression or some other activity to which the public should have free access? If the evidence justifies the latter inference, the fact that the usage may in some way contribute to generating a monetary return to the user should be of no consequence, since all but the most altruistic pursuits and creations can be found to produce income.<sup>185</sup>

Thus, the unauthorized usage must be direct in nature and primarily commercial in motivation. Although these sentiments coincide with those of the Ninth Circuit, Hetherington gives substance to the term "commercial purpose."

Hetherington classifies the commercial use of one's identity into three recurring categories: "1) personality merged into the product; 2) personality associated with the product; and 3) personality collateral to the product."<sup>186</sup> Presumably, a sound-alike case would fall into the third collateral use category. To cite brief examples of the first two categories, if a merchandiser placed a celeb-

<sup>183</sup> 17 U.S.C. § 107 (1988). Section 107 provides that a "fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . . scholarship, or research, is not an infringement of copyright." *Id.* The statute sets forth four factors to determine when the use of copyrighted subject matter will qualify as "fair use" and thus privileged against judicial sanction: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work. *Id.*

<sup>184</sup> See H. Lee Hetherington, *Direct Commercial Exploitation of Identity: A New Age for the Right of Publicity*, 17 COLUM.-VLA J.L. & ARTS 1, 20 (1992).

<sup>185</sup> *Id.* at 30-31.

<sup>186</sup> *Id.* at 33.

city's face on a T-shirt, this would qualify as a personality merged into the product. In this scenario, the celebrity's identity is perceived to be merged with the T-shirt to such an extent as to nearly become the product.<sup>187</sup> If a celebrity had a starring role in a commercial, such as Ray Charles' Diet Pepsi commercials, this would qualify as a personality associated with a product.<sup>188</sup> Here, as in the merger scenario, the association between personality and product sends an equally direct and immediate message to consumers: Ray Charles drinks Diet Pepsi, and if you like Ray Charles and want to be like Ray Charles, you will also drink Diet Pepsi.<sup>189</sup>

The third category involves a nexus between the use of a celebrity's identity and a product, which is so indirect, attenuated, and incidental that protection is not warranted.<sup>190</sup> An illustration of a collateral use falling short of actual appropriation would be a television commercial that seeks to indirectly associate incidental aspects of a celebrity's identity with the sale of a specific product.<sup>191</sup> For example, assume that a clothing company seeks to capitalize on the popularity of Michael Jackson by suggesting a connection with him.<sup>192</sup> If the company hires a performer to imitate Jackson's dance moves, while dressed in his clothes, and there is no misleading identification of the performer, no appropriation results. Here, the use draws indirectly on a performer's popularity in a general manner without directly pirating his identity.<sup>193</sup>

Hetherington argues, however, that where a more skillful and subtle use of a celebrity's identity results, i.e., sound-alike commercials, any doubts should be resolved in favor of protecting the plaintiff's right of publicity.<sup>194</sup> Such a black and white approach, however, fails to acknowledge the true nature of commercial speech.

Professor Theodore Haas recognizes that commercial speech is a complex kind of speech, which consists of two parts—the commercial proposal and the rhetorical matter.<sup>195</sup> Accordingly, the commercial proposal involves a statement that a certain product is for sale.<sup>196</sup> The rhetorical matter, in contrast, functions to attract

<sup>187</sup> *Id.*

<sup>188</sup> *Id.* at 34.

<sup>189</sup> *Id.*

<sup>190</sup> *Id.* at 35.

<sup>191</sup> *Id.*

<sup>192</sup> *Id.*

<sup>193</sup> *Id.* at 36.

<sup>194</sup> *Id.*

<sup>195</sup> Theodore F. Haas, *Storehouse of Starlight: The First Amendment Privilege to Use Names and Likenesses in Commercial Advertising*, 19 U.C. DAVIS L. REV. 539, 542 (1986).

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

attention to the advertisement or awaken a desire to purchase the advertised product.<sup>197</sup> This distinction emphasizes that some elements in an advertisement are present not to make a commercial proposal but simply to enhance it.

Professor Haas' analysis is twofold. With regard to the commercial proposal, Professor Haas seeks to resolve First Amendment questions concerning the unauthorized use of names and likenesses through the Supreme Court's four-pronged commercial speech test enunciated in *Central Hudson Gas v. Public Service Commission*.<sup>198</sup> Thus, Haas believes that an advertiser should be entitled to include the publicity claimant in a truthful description of its product without permission, so long as the advertiser does not place the claimant in a false light.<sup>199</sup> To this end, the advertiser may not make any false claims about the connection between the plaintiff and the product. The facts of *Namath v. Sports Illustrated*<sup>200</sup> illustrate how the Haas analysis would work. In this case, Sports Illustrated's marketing campaign incorporated a photograph from an article about Joe Namath on subscription soliciting cards, using different logos depending on whether the advertisement appeared in a men's or women's magazine.<sup>201</sup> The respective captions read, "How to get Close to Joe Namath," and, "The man you love loves Joe Namath."<sup>202</sup> With regard to sports reporting purposes, the photograph was protected by the First Amendment. As to a secondary commercial usage, the court ruled that as long as the personality is merely an incidental component to advertising the magazine, its inclusion should be characterized as collateral, and the magazine privileged in its use.<sup>203</sup>

Haas, in direct contrast, believes that the captions used on the subscription cards raise the problem of truthfulness.<sup>204</sup> In this instance, one could reasonably find a false representation in the advertisement in that it portrayed a much closer connection to

<sup>197</sup> *Id.* at 552 (citing *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of N.Y.*, 447 U.S. 557 (1980)).

<sup>198</sup> 447 U.S. 557 (1980). Under *Central Hudson's* four-pronged test, for a state regulation of commercial speech to survive First Amendment scrutiny: 1) the speech must concern lawful activity and not mislead; 2) the regulation must serve a substantial state interest; 3) the regulation must advance that interest directly; and 4) the regulation must be no more extensive than necessary to achieve that state interest. *Id.* at 566.

<sup>199</sup> Haas, *supra* note 195, at 568.

<sup>200</sup> *Namath v. Sports Illustrated*, 371 N.Y.S.2d 10 (App. Div. 1975), *aff'd*, 352 N.E.2d 584 (1976); see Haas, *supra* note 195, at 558.

<sup>201</sup> *Namath*, 371 N.Y.S.2d at 13.

<sup>202</sup> *Id.*

<sup>203</sup> *Id.* at 11-12.

<sup>204</sup> Haas, *supra* note 195, at 558-59.

Namath than was actually found in the magazine itself.<sup>205</sup> In other words, Sports Illustrated sought to present Namath as having a personal connection with the magazine as opposed to presenting him as a representative sports star.<sup>206</sup> Although features on Namath had appeared in Sports Illustrated on numerous occasions, for the most part the magazine bore no relation to Joe Namath.<sup>207</sup> Hence, Haas would deny Sports Illustrated First Amendment protection due to the dubious nature of the informative content of the advertisement.<sup>208</sup>

With regard to name or likeness claims that arise from the rhetorical matter, Haas frames a somewhat different analysis.<sup>209</sup> Courts in this instance must balance the speech interest against the right to control associations of one's name and likeness. In Haas' view, a court must focus upon five considerations:

- 1) Would [the] speech [in question] be privileged absent its commercial advertising context?
- 2) Does the advertisement misrepresent plaintiff's connection to the product?
- 3) How closely does it associate plaintiff and product?
- 4) Are the affront to plaintiff's dignity and the dilution of her financial interest in her name and likeness substantial?
- 5) Do they outweigh the value of the speech?<sup>210</sup>

Haas would extend protection, however, only to those advertisements which involve newsworthy entertainment or "transformed entertainment."<sup>211</sup> Essentially, the information conveyed in the rhetoric matter must be either of general or public interest, or create a parody which contributes something new for humorous effect or commentary.<sup>212</sup> Although use of a sound-alike in the proper context might qualify as a parody, Haas disallows protection for any form of imitation.<sup>213</sup> Haas denies protection for look-alikes, and presumably sound-alikes, not because the advertiser has portrayed the plaintiff in a false light, but rather, because the advertiser injected no originality into the appropriation. Using an impersonator exemplifies entertainment that stems from an appro-

<sup>205</sup> *Id.* at 558.

<sup>206</sup> *Id.*

<sup>207</sup> *Id.*

<sup>208</sup> *Id.* at 560.

<sup>209</sup> *Id.* at 594-95.

<sup>210</sup> *Id.* at 595.

<sup>211</sup> *Id.* at 588-92. "Transformed entertainment" consists of an advertiser transforming the plaintiff's entertainment into its own. *Id.* For example, if an advertiser takes a still photograph from a film and uses it in an advertisement in which it inserts a humorous caption, this would qualify as transformative entertainment.

<sup>212</sup> *Id.*

<sup>213</sup> *Id.*



priation of the original, as opposed to transforming the celebrity in question.<sup>214</sup>

Thus, both Hetherington's aversion to commercial usage and Haas' categorization of protectible rhetoric matter reflect the common societal and judicial trend that commercial speech is less deserving of First Amendment protection than political speech or writing. McCarthy characterizes these feelings best:

Surely, the First Amendment is stretched beyond recognition if it is read as permitting advertisers to use without consent anyone's identity to attract attention to commercial messages. Regardless of any incidental social messages or attempts at humor, the paramount message of any advertisement is "buy," and that is why it is dubbed "commercial speech" and not given the same degree of immunity as political, social or entertainment speech.<sup>215</sup>

Daniel Boorstin, author of *The Image*, attributes society's eagerness to attack advertising to its fear of advertising, and

our inability to fit advertising into old-time familiar cubbyholes of our experience—all these prevent us from seeing its all-encompassing significance as a touchstone of our changing concept of knowledge and of reality. Our attitude toward advertising is comparable to the eighteenth-century English and American attitude toward insanity and mental disorders.<sup>216</sup>

Only recently has the Supreme Court reaffirmed its commitment to provide First Amendment protection for advertising. In *City of Cincinnati v. Discovery Network, Inc.*,<sup>217</sup> the court expounded upon the reasons it initially extended protection to commercial speech: "It is clear . . . that speech does not lose its First Amendment protection because money is spent to project it, as in a paid advertisement of one form or another."<sup>218</sup> In an earlier decision, Justice Blackmun cited the reasons for extending First Amendment protection to core commercial speech:

The listener's interest is substantial: the consumer's concern for the free flow of commercial speech often may be far keener than his concern for urgent political dialogue. Moreover, significant societal interests are served by such speech. Advertising, though entirely commercial, may often carry information of im-

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

<sup>215</sup> J. Thomas McCarthy, *Commentary: Is Vanna White Right and Judge Kozinski Wrong?*, ENT. L. REP., Sept. 1993, at 1.

<sup>216</sup> DANIEL J. BOORSTIN, *THE IMAGE: A GUIDE TO PSEUDOEVENTS IN AMERICA* 211 (1972).

<sup>217</sup> 113 S. Ct. 1505 (1993).

<sup>218</sup> *Id.* at 1512 (citations omitted).

port to significant issues of the day. . . . And commercial speech serves to inform the public of the availability, nature, and prices of products and services, and thus performs an indispensable role in the allocation of resources in a free enterprise system. In short, such speech serves individual and societal interests in assuring informed and reliable decisionmaking.<sup>219</sup>

Thus, the broadest reading of the Supreme Court's sentiments on the significance of advertising may forecast a change in the law allowing advertisers more freedom. Accepting *Midler* and *Waits* as the status quo flaunts well established advertising practices and chills commercial speech. To hold that advertising defendants reap where others have sown is to beg the question. Unauthorized commercial appropriators often add something of their own—some humor, artistry, or wit—to whatever they "take."<sup>220</sup> Courts applying copyright analysis have held explicitly that advertisements possess an aesthetic value that promotes the "useful arts."<sup>221</sup> As Professor Marci Hamilton notes, our most effective art in the world market has not been fine art, but popular art culture.<sup>222</sup> Furthering these notions, Judge Kozinski, dissenting in *White v. Samsung Electronics America, Inc.*,<sup>223</sup> argued that no constitutional distinctions exist between political and social messages on the one hand and advertising messages on the other:

Commercial speech may be less protected by the First Amendment than noncommercial speech, but less protected means protected nonetheless. And there are very good reasons for this. Commercial speech has a profound effect on our culture and our attitudes. Neutral-seeming ads influence people's social and political attitudes, and themselves arouse political controversy. "Where's the Beef?" turned from an advertising catchphrase into the only really memorable thing about the 1984 presidential campaign. Four years later, Michael Dukakis called George Bush "the Joe Isuzu of American politics."

<sup>219</sup> *Bates v. State Bar of Ariz.*, 433 U.S. 350, 364 (1977) (citations omitted). Of course, we were not the first to recognize the value of commercial speech: "Advertisements are well calculated to enlarge and enlighten the public mind, and are worthy of being enumerated among the many methods of awakening and maintaining the popular attention, with which more modern times, beyond all preceding example, abound." D. BOORSTIN, *THE AMERICANS: THE COLONIAL EXPERIENCE* 328, 415 (1958) (quoting I. THOMAS, *HISTORY OF PRINTING IN AMERICA WITH A BIOGRAPHY OF PRINTERS, AND AN ACCOUNT OF NEWSPAPERS* (2d ed. 1810)).

<sup>220</sup> *Madow*, *supra* note 33, at 204.

<sup>221</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 239 (1903).

<sup>222</sup> Professor Marci Hamilton, Lecture on Copyright at the Benjamin N. Cardozo School of Law, Sept. 14, 1993.

<sup>223</sup> 971 F.2d 1395 (9th Cir. 1992), *reh'g denied*, 989 F.2d 1512 (9th Cir. 1993), *cert. denied*, 113 S. Ct. 2443 (1993).

... In our pop culture, where salesmanship must be entertaining and entertainment must sell, the line between the commercial and noncommercial has not merely blurred; it has disappeared.<sup>224</sup>

Hence, Kozinski sends the overall message that intellectual property laws recognize the need to imitate in order to progress.<sup>225</sup> Our culture's vibrancy depends on "[t]he right to draw ideas from a rich and varied public domain."<sup>226</sup> The purpose of copyright, patent, and trademark law is to ensure progress for the benefit of the general public. Creators receive a limited property right in their creations, not so much because courts believe morality dictates that creators deserve to receive the fruits of their labor, but because private market incentives are necessary to encourage creation.<sup>227</sup> To this end, the general rule has long been that absent some special and compelling need for protection, such as the need to prevent consumer deception, or the need to provide adequate incentives for creation and innovation intangible products, once placed voluntarily in the market, are as "free as the air to common use."<sup>228</sup>

In sum, right of publicity must harmonize itself with the other branches of intellectual property law. Regardless of the level of artistry or wit, a sound-alike commercial nonetheless contributes in its own way to the "building of the whole culture."<sup>229</sup> Therefore, in order to prevent the stifling of commercial creativity, courts must set more definite guidelines to allow for permissible appropriation.

### B. Proposed Guidelines

With this need in mind, this Note proposes a modified incidental-use test which looks to the advertisement in its entirety. Consistent with the Haas approach, a jury must look to both the rhetorical matter and commercial proposal of a sound-alike advertisement. To this end, the jury's task is twofold.

First, the jury must decide whether the advertiser incorporated the sound-alike in the rhetoric or the proposal. If the jury determines that the advertiser merely used the sound-alike to enhance the commercial, and not to serve as the selling point, then the ad-

<sup>224</sup> *White v. Samsung Elecs. Am., Inc.*, 989 F.2d at 1519-20 (Kozinski, J., dissenting) (citations and footnotes omitted) (emphasis added).

<sup>225</sup> *Id.*

<sup>226</sup> *Id.* at 1521.

<sup>227</sup> *Id.* at 1513.

<sup>228</sup> *International News Serv. v. Associated Press*, 248 U.S. 215, 250 (1918) (Holmes, J., dissenting).

<sup>229</sup> THOMAS I. EMERSON, *THE SYSTEM OF FREEDOM OF EXPRESSION* 7 (1970).

vertiser receives absolute protection. Unlike Haas, this Note does not seek to differentiate levels of entertainment.<sup>230</sup> A commercial is entertainment in and of itself, and thus deserves absolute First Amendment protection.

Using *Midler* as a prime example, the advertisers in this case did not intend to "pass off" to the public that Bette Midler endorsed Ford Motor products. Ford did not intend to use Midler to say, "Hi, I'm so-and-so, endorsing such-and-such." Rather, Ford keyed its Lincoln-Mercury campaign to reach the baby-boomer market.<sup>231</sup> Ford replicated nostalgic songs from the yuppies' heyday, and married the music to slice-of-life vignettes. Taken as a whole, the commercials created little stories using the cars as backdrops to the owners' lives. Thus, nostalgia seemed to be the selling point not Bette Midler.<sup>232</sup>

In contrast, consider Tracy-Locke's use of a Tom Waits sound-alike for Frito-Lay's Salsa-Rio Doritos commercial. Tracy-Locke employed the sound-alike to sing a corn chip jingle that echoed the rhyming word play of a Waits' song.<sup>233</sup> Here the advertiser used a sound-alike to directly convey a message about an identified product. At this point, level two of the analysis, which involves the commercial proposal, comes into play. The dilemma thus arises as to which of the competing interests should prevail.

In this case, a celebrity such as Tom Waits, who on principle consistently refused to endorse products—known in the trade as an "advertising virgin"<sup>234</sup>—had an appropriate complaint when the advertiser appropriated his persona in such a way that consumers would infer his voluntary association with the product. An advertiser should not utilize a celebrity's persona in such a way as to lead people to believe the celebrity endorsed the product. Furthermore, the law should protect a celebrity who has done endorsements in the past, but feels that the advertiser appropriated his likeness for a product that he finds distasteful or particularly shoddy. The celebrity would have to prove that the advertiser appropriated his identity, i.e., his voice.

Both *Midler* and *Waits* illustrate the shortcomings of the current identifiability standard. To reiterate, *Midler* concluded that a singer has a valid cause of action against a sound-alike if she can prove three elements: 1) that her voice is distinctive; 2) that her

<sup>230</sup> See *supra* notes 204-210 and accompanying text.

<sup>231</sup> *Lincoln-Mercury Steers Toward Brand Strategy*, *ADVERTISING AGE*, June 16, 1986, at S-6.

<sup>232</sup> *Id.*

<sup>233</sup> *Waits v. Frito-Lay, Inc.*, 978 F.2d at 1097.

<sup>234</sup> Madow, *supra* note 33, at 181-82 n.271.

voice is widely known; and 3) that her voice was imitated deliberately for a commercial use.<sup>235</sup> Whereas the *Midler* court focused on the "widely known" prong of the test,<sup>236</sup> the *Waits* court shifted the emphasis to the "distinctive" factor.<sup>237</sup> *Waits* held that a voice is distinctive if it is "distinguishable from the voices of other singers" and "has particular qualities or characteristics that identify it with a particular singer."<sup>238</sup> Thus, a plaintiff need only prove that the defendant imitated her "distinctive" voice to maintain a successful cause of action. In sum, *Waits* rendered the *Midler* test boundless, and paved the way for disproportionate awards for cult celebrities.

On a tangential note, a similar concern centers upon the methods of identification used by a plaintiff to prove his case. In the context of right of publicity cases, Professor McCarthy coined the terms "unaided" and "aided" identification.<sup>239</sup>

With regard to unaided identification, a juror must recognize and identify the plaintiff as the person being imitated merely from viewing or hearing the defendant's advertisement.<sup>240</sup> If the juror makes the mental connection between the defendant's advertisement and the plaintiff, then this qualifies as an unaided identification.<sup>241</sup> In other words, the standard of unaided identification requires the juror to recognize the imitation by virtue of comparison with a preexisting mental impression of the plaintiff's persona.<sup>242</sup>

Aided identification, by contrast, results when the juror can identify the plaintiff as the imitated party only by comparing the commercial imitation with an example of the original.<sup>243</sup> In this case the juror makes the mental connection through a comparison of the two samples, and he need not have any familiarity with the plaintiff's persona beforehand.<sup>244</sup> The jury in both *Midler* and *Waits* decided on the basis of aided identification.

One commentator notes, however, the underlying principle of the right of publicity suggests that unaided identification is the appropriate standard.<sup>245</sup> A celebrity's "associative value," that is, his

<sup>235</sup> *Midler*, 849 F.2d at 463.

<sup>236</sup> *Id.*

<sup>237</sup> *Id.*

<sup>238</sup> *Waits*, 978 F.2d at 1101.

<sup>239</sup> MCCARTHY, *supra* note 38, § 3.4(B).

<sup>240</sup> *Id.*

<sup>241</sup> *Id.*

<sup>242</sup> *Id.*

<sup>243</sup> *Id.*

<sup>244</sup> *Id.*

<sup>245</sup> See Steven T. Margolin, Comment, *From Imitation to Litigation: Expanded Protection for Commercial Property Rights in Identity*, 96 DICK. L. REV. 491, 517 (1992).

economic or publicity value, derives from his or her "semiotic power . . . to carry and provoke meanings."<sup>246</sup> In order for a celebrity persona to enhance the marketability of a product, he must already mean something to the public.<sup>247</sup> In other words, if my aunt Estelle from Co-op City sought to sue for the unauthorized use of her voice in a commercial, she would have no cause of action because her persona has no meaning to the public—except to my uncle Morris and her mahjongg club. Therefore, it stands to reason that a celebrity who possesses a greater degree of public recognition will also possess greater inherent commercial value in his identity. Accordingly, a plaintiff's potential recovery for unauthorized use of her persona should be directly proportional to that celebrity's degree and ease of recognition.<sup>248</sup>

Perhaps these concerns are overstated. One must consider that only twelve (or six) people sit on a jury. It is likely that these twelve people might not be part of the majority or minority that would recognize the celebrity plaintiff. The jury should therefore use aided identification in its deliberation.

Accordingly, the *Waits* test for identifiability should stand. The Ninth Circuit essentially posited a test similar to one used to determine copyright infringement. This requires the jury to find substantial similarity between plaintiff's recordings and defendant's advertisement.<sup>249</sup> The Ninth Circuit indicated that style imitation alone was insufficient to be liable for voice misappropriation.<sup>250</sup> The court held that "the imitation had to be so good that 'people who were familiar with plaintiff's voice [and] who heard the commercial believed plaintiff performed it. In this connection it is not enough that they were reminded of plaintiff or thought the singer sounded like plaintiff. . . .'"<sup>251</sup> In this sense, the *Waits* instruction effectively added a useful additional element to the *Midler* formulation of voice misappropriation—actual confusion.<sup>252</sup>

Once a jury determines that the defendant misappropriated the plaintiff's voice, the issue of damages remains. However, ad-

<sup>246</sup> Madow, *supra* note 33, at 184-85.

<sup>247</sup> Gretchen A. Pemberton, *The Parodist's Claim to Fame: A Parody Exception to the Right of Publicity*, 27 U.C. DAVIS L. REV. 97, 120-21 (1993).

<sup>248</sup> Margolin, *supra* note 245, at 516.

<sup>249</sup> See *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) (discussing substantial similarity test in copyright infringement claim). The substantial similarity test begs the question—would an average lay observer recognize the alleged copy as having been appropriated from the copyrighted work?

<sup>250</sup> *Waits*, 978 F.2d at 1100-01.

<sup>251</sup> *Id.* (quoting jury instruction from *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988)) (omission and emphasis in original).

<sup>252</sup> *Id.*

herence to the *Waits* formulation, especially with regard to punitive damages, may result in chilling commercial speech. In its deliberation over the definition of a "widely known" celebrity, the *Waits* court espoused that "differences in the extent of celebrity are adequately reflected in the amount of damages recoverable."<sup>253</sup> If the Ninth Circuit actually adhered to this sentiment, Tom Waits' damages would have been limited to the fair market value of his services and any other provable actual damages. Instead, the court allowed Tom Waits to collect mental distress damages—injury to his peace, happiness and feelings.<sup>254</sup> The jury predicated the mental distress damages award on evidence of Waits' "shock, anger, and embarrassment" and the "strong inference" that due to Waits' outspoken stance against doing endorsements, "the Doritos commercial humiliated Waits by making him an apparent hypocrite."<sup>255</sup> If the right of publicity constitutes a proprietary interest in one's identity, then only damages to compensate for tangible ascertainable economic injury should be available. Courts should not permit damages that pertain to such speculative injury as hurt feelings.

Where *Midler* did not hold that an advertiser could never use a sound-alike, the punitive damages awarded in *Waits* effectively amounted to such a pronouncement.<sup>256</sup> What the Ninth Circuit termed "malicious" and "despicable" conduct, advertisers such as Tracy-Locke and Young & Rubicam characterized as standard industry practice.<sup>257</sup> As one commentator notes, depriving advertisers of the use of sound-alikes "would have the effect of diluting the very impression sought to be attained through use of an imitation. . . ."<sup>258</sup> Arguably, in *Waits*, Tracy-Locke did not intend to convey that Tom Waits endorsed Salsa-Rio Doritos. That just happened to be the unfortunate result. Tracy-Locke imitated Waits and his scat style for the purpose of creating an "upbeat" feeling for the Frito-Lay commercial.<sup>259</sup> Taken in this light, a court must balance the equities. A court should impose liability to the extent that it does not belittle the advertiser's original artistic expression, and impinge his First Amendment rights.

Thus, a plaintiff's compensatory award should be limited to

<sup>253</sup> *Id.* at 1102.

<sup>254</sup> *Id.* at 1103.

<sup>255</sup> *See id.* at 1103.

<sup>256</sup> *Id.* at 1104-05.

<sup>257</sup> Edward G. Wierzbicki and Joseph J. Madonia, *Using Sound-Alikes in Ads is Risky Business*, CORP. LEGAL TIMES, Mar. 1992, at 18.

<sup>258</sup> *Id.*

<sup>259</sup> *Waits*, 978 F.2d at 1097.

the fair market value of her services. A plaintiff, moreover, should also receive any measurable consequential damages arising from the injury.<sup>260</sup> Such damages include injury to goodwill and future publicity value.<sup>261</sup>

A defendant who employs a sound-alike in the commercial proposal, however, can escape liability in one instance. Neither *Midler* nor *Waits* clarifies whether an advertiser can use a sound-alike if the public is not deceived into thinking that the advertiser used the original song or employed the original performer in the commercial. Courts should allow advertisers to employ disclaimers. The disclaimer, however, must give the absolute impression that the celebrity in no way endorsed the product. For example, in *Allen v. National Video, Inc.*, the defendant, who had employed a Woody Allen look-alike, used a disclaimer that merely read "celebrity double."<sup>262</sup> The court noted that despite the disclaimer, public confusion could arise concerning the celebrity's involvement or approval.<sup>263</sup> An advertiser must create a disclaimer that completely dispels confusion. Stating that the advertiser employed a celebrity sound-alike, and that the celebrity in no way endorses the product, should pass muster.<sup>264</sup>

## V. CONCLUSION

Both *Midler* and *Waits* represent the Ninth Circuit's continuing intent to broaden celebrities' rights, and signify its amorphous approach to right of publicity actions. As one commentator remarks:

Judges and Juries . . . seem to favor what might be called a holistic approach. They tend to consider the facts as an inseparable whole in determining liability, rather than specifying the individual elements of a right of publicity claim. . . . Future lawsuits may give judges the opportunity to define the boundaries of the tort, rather than merely announce its occurrence. . . .<sup>265</sup>

In this vein, this Note proposes that the right of publicity be narrowed in the context of voice misappropriation actions.

<sup>260</sup> *See supra* notes 254-56 and accompanying text.

<sup>261</sup> *Waits*, 978 F.2d at 1103.

<sup>262</sup> *Allen v. National Video, Inc.*, 610 F. Supp. 612, 618 (S.D.N.Y. 1985).

<sup>263</sup> *Id.* at 629.

<sup>264</sup> *See Madow, supra* note 33, at 233. Madow points out that a strict proponent of the right of publicity would disapprove of the use of a disclaimer. Such a proponent would argue that although a disclaimer would prevent confusion, any unauthorized use of a celebrity's persona infringes upon their right of publicity. In this instance, an advertiser has employed a disclaimer to evoke a celebrity's identity to attract attention and promote sales.

<sup>265</sup> Pesce, *supra* note 135, at 823.

In light of Professor Madow's arguments, which dispel the popular justifications for the right of publicity, the most compelling moral argument for a right of publicity stems from a celebrity's right to be free of unwanted associations that would lead an audience to believe he endorsed the product. The celebrity's interest must be balanced against the countervailing policies of the First Amendment which espouse the promotion of creativity and artistic expression.

This Note proposes a test that would require the examination of a commercial in its entirety. Because commercials qualify as entertainment in our pop culture, a jury must determine whether the use of the sound-alike falls within the commercial proposal or the rhetoric matter. If the jury determines that the use falls within the backdrop of the commercial, the advertiser's use would qualify as an incidental use protectable as creative expression. If, however, the jury determines that the advertiser employed the sound-alike in the commercial proposal, then the jury must decide whether the defendant pirated the plaintiff's voice to the point of actual confusion. A successful plaintiff should be entitled to recover only the fair market value of his or her services and any ascertainable consequential damages. Punitive damages should be abolished to prevent the chilling of commercial speech. An advertising defendant, however, should be allowed to escape liability if it employs a disclaimer that dispels any and all potential consumer confusion.