

1990

Federal Preemption of the Right of Publicity in Sing-Alike Cases

Leonard A. Wohl

Pryor, Cashman, Sherman & Flynn

Follow this and additional works at: <https://ir.lawnet.fordham.edu/iplj>



Part of the [Entertainment, Arts, and Sports Law Commons](#), and the [Intellectual Property Law Commons](#)

Recommended Citation

Leonard A. Wohl, *Federal Preemption of the Right of Publicity in Sing-Alike Cases*, 1 Fordham Intell. Prop. Media & Ent. L.J. 47 (1990).

Available at: <https://ir.lawnet.fordham.edu/iplj/vol1/iss1/4>

This Note is brought to you for free and open access by FLASH: The Fordham Law Archive of Scholarship and History. It has been accepted for inclusion in Fordham Intellectual Property, Media and Entertainment Law Journal by an authorized editor of FLASH: The Fordham Law Archive of Scholarship and History. For more information, please contact tmelnick@law.fordham.edu.

NOTES

FEDERAL PREEMPTION OF THE RIGHT OF PUBLICITY IN SING-ALIKE CASES*

INTRODUCTION

The right of publicity is a person's right to control the commercial exploitation of his or her identity.¹ It allows a public figure² to juxtapose an element of his persona³ with a product or service and thereby create an endorsement through the infusion of publicity value associated with the celebrity's fame.⁴ The right of publicity exists solely in the statutes⁵ or common law⁶ of the states.⁷

The supremacy clause of the Constitution requires that direct conflicts between federal law and the laws of the states be resolved in favor of federal law.⁸ When Congress drafted the 1976 Copyright

* This Note won First Prize in the 1990 Nathan J. Burkham Memorial Copyright Competition, sponsored by ASCAP, at Fordham University School of Law.

1. See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 569, 575 (1977); *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir.), cert. denied, 346 U.S. 816 (1953); *McCarthy, Melville B. Nimmer and the Right of Publicity: A Tribute*, 34 UCLA L. Rev. 1703, 1704 (1987).

2. Most right of publicity suits are brought by public figures since only widely recognized people are endowed with significant commercially exploitable publicity value. See, e.g., *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983); *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1283 (D. Minn. 1970); *Halpern, The Right of Publicity: Commercial Exploitation of the Associative Value of Personality*, 39 VAND. L. REV. 1199, 1202 (1986).

3. See, e.g., *Bi-Rite Enter. v. Button Master*, 555 F. Supp. 1188, 1199 (S.D.N.Y. 1983) (name and likeness); *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981) (performing style); *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis.2d 379, 280 N.W.2d 129 (1979) (nickname); *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (voice). Some courts have gone beyond personal characteristics to recognize appropriations of things associated with the plaintiff. See, e.g., *Carson*, 698 F.2d 831 (phrase associated with plaintiff); *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974) (plaintiff's racing car).

4. See *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 881 (S.D.N.Y. 1973); *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 834, 603 P.2d 425, 438, 160 Cal. Rptr. 323, 336 (1979) (Bird, C.J. dissenting); *Treece, Commercial Exploitation of Names, Likenesses, and Personal Histories*, 51 TEX. L. REV. 637, 644-46 (1973).

5. See Note, *The Right of Publicity and Vocal Larceny: Sounding Off on Sound-Alikes*, 57 FORD. L. REV. 445, 449 & n.44 (1988).

6. See *id.* at 449-50 & n.45.

7. See *id.* at 445 n.2.

8. See U.S. CONST., art. VI ("This Constitution, and the laws of the United States which shall be made in pursuance thereof . . . shall be the supreme law of the land.").

However, "the inquiry is whether there exists an irreconcilable conflict between the federal and state regulatory schemes." *Rice v. Norman Williams Co.*, 458 U.S. 654, 659 (1982). Courts should always attempt to reconcile the clash of laws to

Act (the "Act"), it incorporated federal preemption into section 301 of the Act.⁹ Under § 301, state law will be preempted when the state right asserted is equivalent to a right assertable by a federal copyright owner and the work claimed to be protected by state law is of the kind that is protected by the Act.¹⁰

In 1988, the Court of Appeals for the Ninth Circuit held in *Midler v. Ford Motor Co.*¹¹ that the deliberate imitation of a singer's voice for commercial purposes violated the singer's right of publicity.¹² Prior to *Midler*, courts had found that sing-alike claims were preempted by copyright law¹³ because of the inextricability of the vocal simulation claim from the federally protected song containing the simulation.¹⁴ Concerning preemption, however, defendants

avoid preemption. See *Merrill Lynch, Pierce, Fenner & Smith v. Ware*, 414 U.S. 117, 127 (1973).

9. 17 U.S.C. § 301 (1982) provides in part:

(a) On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103 . . . are governed exclusively by this title. . . .

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to —

(1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or

(3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106.

10. See *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1238 (C.D. Cal. 1987); *Mayer v. Josiah Wedgwood & Sons, Ltd.*, 601 F. Supp. 1523, 1531 (S.D.N.Y. 1985); J. McCarthy, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 11.13[A][2], at 11-63 (1990).

11. 849 F.2d 460 (9th Cir. 1988).

12. See *id.* at 463-64. In *Midler*, the defendant asked actress and singer Bette Midler to re-record the song "Do You Wanna Dance" for musical accompaniment to its commercial. When she refused, the defendant instructed a Midler soundalike to mimic her performance of the song, and thereby misled listeners into believing that they were actually hearing Midler.

13. In a case involving the fixation of a visual performance on videotape for broadcast on a television news program, the Supreme Court, in its only right of publicity case to date, held that the performer's right of publicity was not preempted. See *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977).

14. See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970) (decided under the 1909 Copyright Act), *cert. denied*, 402 U.S. 906 (1971); *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236 (C.D. Cal. 1987) (decided under the 1976 Copyright Act); *Davis v. TWA*, 297 F. Supp. 1145 (C.D. Cal. 1969) (1909 Act); see also *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343 (S.D.N.Y. 1973) (vocal imitation in context of commercial voiceover under 1909 Act). But see *Lahr v. Adell Chem. Co.*, 300 F.2d 256 (1st Cir. 1962) (no preemption of claim for vocal imitation in context of commercial voiceover under 1909 Act).

should not hasten to abandon the authority of pre-*Midler* caselaw in light of the dubious precedential value of the *Midler* opinion. Besides the obvious *stare decisis* limitations, the Ninth Circuit barely gives lip service to § 301¹⁵ despite the existence of prior cases that had dismissed or questioned similar claims based on federal preemption.¹⁶ Specifically, the court's simplistic resolution of the contention that *Midler's* voice was in fact fixed in a protected musical work¹⁷ was superficial for its failure to reach the merits of the argument.¹⁸ Moreover, although a finding that a person's voice is not a work protected by the Act would be sufficient to preserve the state created right,¹⁹ the court should have undertaken an equivalency of rights analysis under § 301 for the benefit of future litigation.²⁰

Thus, while sing-alike advertising continues to be a profitable way to create an endorsement,²¹ the ability of plaintiffs to maintain a right of publicity action based upon the imitation of voice remains unclear. Defendants continue to argue that any voice publicity claim that requires reference to a sound recording to link the imitation to the plaintiff necessarily invades the exclusive domain of federal copyright and cannot exist under state law.²² Plaintiffs, on the other hand, insist that their reliance upon state law is beyond the

15. See *Midler*, 849 F.2d at 462 ("Midler does not seek damages for Ford's use of 'Do You Want To Dance,' and thus her claim is not preempted by federal copyright law. Copyright protects 'original works of authorship fixed in any tangible medium of expression.' A voice is not copyrightable. The sounds are not 'fixed.'"). The court fails to even mention or cite to § 301 in its opinion.

16. See *supra*, note 14 and accompanying text.

17. See Brief for Appellees at 32, *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (No. 87-6168).

18. See Note, *Commercial Sound-Alikes: An Argument for a Performer's Cause of Action*, 62 *St. John's L. Rev.* 667, 685 n.119 (1988); *infra* notes 99-103, 121-124 and accompanying text.

19. See *supra* notes 9-10 and accompanying text; *infra* note 93 and accompanying text.

20. See Note, *supra* note 18, at 685 n.119.

21. See Miller, *Gonna Hawk Around the Clock Tonight*, *Mother Jones*, Nov. 1988, at 40-42 (adapted from M. Miller, *Boxed In: THE CULTURE OF TV* (1988)) (many advertisers are turning to sound-alike advertising to target the young demographic); *Wall St. J.*, March 12, 1987, at 35, col. 1 (advertisers clearly pay less to the imitator than the real thing). Even within the jurisdiction of the Ninth Circuit, advertisers may be able to imitate the voices of popular singers if they do not do so "deliberately" or if the singer's voice is not "distinctive", pursuant to *Midler's* narrow holding. *Midler*, 849 F.2d at 463.

22. See Brief for Appellees at 32, *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (No. 87-6168); see also *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 716 (9th Cir. 1970) (Plaintiff claimed that "the sound in connection with the music, lyrics and arrangement . . . ought to be protected. But as to these latter copyrightable items she had no rights."), *cert. denied*, 402 U.S. 906 (1971); *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1240 (C.D. Cal. 1987) ("essence of plaintiff's complaint is derived from defendant's alleged unauthorized use of a copyrighted work").

preemptive reach of § 301 since what they are protecting - the intangible persona - is not the subject matter of copyright.²³

This paper will explore the tension between the limited creative monopoly possessed by copyright owners under the Act²⁴ and the apparently greater scope of protection offered to public figures by way of state rights of publicity.²⁵ Part I discusses in general terms the legacy of federal supremacy under the 1909 Copyright Act and its growth into the present scheme of preemption under § 301. Part II examines the equivalent rights portion of the Act's preemption test, including the section's legislative history, whether the right of publicity may limit the use of copyrighted works, and the effect of § 114(b). Part III compares the subject matter of copyright to that of the right of publicity, and includes a discussion of the controversial *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*²⁶ case. Finally, this paper concludes that federal copyright law does not preempt state law rights of publicity when such rights are infringed by imitation of a performer's voice within the context of a copyrighted musical work.

I. THE FEDERAL SCHEME OF PREEMPTION

In 1964, the Supreme Court held in the companion cases of *Sears, Roebuck & Co. v. Stiffel Co.*²⁷ and *Compco Corp. v. Day-Brite Lighting, Inc.*²⁸ that "when an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article."²⁹ The broad sweep of the *Sears/Compco* cases gave Congress exclusive protection of intellectual property.³⁰ Perhaps realizing it had gone too far, the Court in *Goldstein v. California*³¹ seemingly re-

23. See *Midler*, 849 F.2d at 462 ("A voice is not copyrightable."); Brief for Appellant at 13, *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (No. 87-6168); J. McCarthy, *supra* note 10, at § 11.13[C][4], at 11-73; *infra* notes 96-97 and accompanying text.

24. See Brown, *Copyright and Its Upstart Cousins: Privacy, Publicity, Unfair Competition: The Sixteenth Donald C. Brace Memorial Lecture*, 33 J. COPYRIGHT Soc'y of THE U.S.A. 301, 305 (1986); Simon, *Right of Publicity Reified: Fame as a Business Asset*, 30 N.Y.L. Sch. L. Rev. 699, 722-23 (1985); Note, *supra* note 18, at 682.

25. See *supra*, note 3.

26. 805 F.2d 663 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987).

27. 376 U.S. 225 (1964).

28. 376 U.S. 234 (1964).

29. *Id.* at 237.

30. See J. McCarthy, *supra* note 10, § 11.13[A][1], at 11-61. The impact of *Sears/Compco* upon copyright was felt by the plaintiffs in *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 717 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971) and *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 346 (S.D.N.Y. 1973) but was nevertheless unusual since *Sears* and *Compco* involved patents, not copyrights.

31. 412 U.S. 546 (1973).

treated from its position in *Sears/Compro* stating, without holding, that only those "categories of writings which Congress has . . . brought within the scope of the federal [copyright] statute" were ineligible for state law protection.³² This aspect of *Goldstein* appears to have been codified in the language of § 301,³³ which limits preemption to works that "come within the subject matter of copyright,"³⁴ and nicely links preemption under the 1909 and 1976 Copyright Acts.³⁵

Section 301 of the Act requires two conditions to be met before a state law will be preempted.³⁶ First, the right asserted under state law must be equivalent to an exclusive right of copyright.³⁷ Second, the state right must be claimed in subject matter protectable by federal copyright law.³⁸ The first condition relates to the nature of the *right* granted by state law while the second addresses the nature of the *work* protected. "[I]f the state right can pass through one of the 'two doors' of § 301, then it is *not* preempted by" the Act.³⁹

The draftsmen proclaimed that the preemption "principle in section 301 [was] intended to be stated in the clearest and most unequivocal language possible. . . to foreclose any conceivable misrepresentation of its unqualified intention that Congress shall act preemptively, and to avoid the development of any vague borderline areas between State and Federal protection."⁴⁰ Despite Congress' good intentions, the amount of text in judicial opinions⁴¹ and scholarly commentary that has been devoted to untying the knots in § 301 betray the legislature's efforts.⁴²

II. EQUIVALENT RIGHTS

Section 106 of the Act grants to a copyright owner the exclusive

32. *Id.* at 570 n.28.

33. See 1 M. Nimmer & D. Nimmer, *NIMMER ON COPYRIGHT* § 1.01[B][2], at 1-22.1 (1990).

34. 17 U.S.C. § 301(a) (1982).

35. But note that *Goldstein* did not make any comment concerning the equivalent rights condition of preemption under the Act.

36. See *Motown*, 657 F. Supp. at 1238; *Mayer*, 601 F. Supp. at 1523; M. Nimmer & D. Nimmer, *supra* note 33, § 1.01[B], at 1-9 to -10.

37. See *supra*, note 9.

38. See *id.*

39. J. McCarthy, *supra* note 10, § 4.14[E][2], at 4-94 (emphasis in original) (McCarthy analogizes the conditions of § 301 to two doors through only one of which a state right must pass to escape preemption).

40. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 130 (1976).

41. See, e.g., *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 674-79 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987); *Mayer v. Josiah Wedgwood & Sons, Ltd.*, 601 F. Supp. 1523, 1531-36 (S.D.N.Y. 1985).

42. See M. Nimmer & D. Nimmer, *supra*, note 33, § 1.01[B], at 1-9; Note, *A Cause of Action for Simulation of Sound Recordings? Yes! Reflections on the 1976 Copyright Act*, 38 *RUTGERS L. REV.* 139, 152-54 (1985).

rights to reproduce, distribute, perform, and display his copyrighted work.⁴³ The first part of the Act's preemption test requires a court to determine whether the challenged state right is equivalent to any of the foregoing rights of copyright. Unfortunately, the precise contours of equivalency have never been authoritatively defined by Congress or the Supreme Court.

A. *The Missing List*

When Congress originally drafted § 301, it attempted to shed light on the meaning of equivalency by including in the language of the bill an illustrative list of state law rights that were deemed not equivalent.⁴⁴ However, the Justice Department objected to a subsequently amended version of the bill⁴⁵ because the amendment's list contained a confusing reference to state law misappropriation.⁴⁶ When the amendment was debated on the floor of the House of Representatives, an interchange between three Congressmen, in which none seemed to understand the comments made by the others,⁴⁷ resulted in the deletion of the entire illustrative list.⁴⁸

The foregoing bit of legislative history left courts and commentators bewildered as to the status of the state rights mentioned in the illustrative lists. Some believe that the deletion of the illustrative list did not affect Congress' intent, which was expressed in the original version of the bill.⁴⁹ Others maintain that no conclusion as to

43. See 17 U.S.C. § 106 (1982).

44. The original § 301(b) provided:

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to—

...

(3) activities violating rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106, including breaches of contract, breaches of trust, invasion of privacy, defamation, and deceptive trade practices such as passing off and false representation.

H.R. REP. NO. 4347, 89th Cong., 2d Sess. § 301(b)(3) 1966 (emphasis supplied).

45. This version listed "rights against misappropriation not equivalent to any of such exclusive rights" as an example of a non-equivalent right. S. REP. NO. 22, 94th Cong., 2d Sess. § 301(b)(3) 1966.

46. "The 'misappropriation' theory is vague and uncertain. . . . [It] is almost certain to nullify preemption." Letter from Justice Department to House Subcommittee Chairman Robert Kastenmeier (July 27, 1976), reprinted in M. Nimmer & D. Nimmer, *supra* note 33, § 1.01[B], at 1-20.

47. See 122 CONG. REC. NO. 10910 (1976); see also M. Nimmer & D. Nimmer, *supra* note 33, § 1.01[B], at 1-20.2 to -20.3 ("But the respective interpretations of the amendment voiced by these two gentlemen was diametrically opposed. Mr. Railsback assumed that it did not affect state law, while Mr. Kastenmeier assumed that it did. The maker of the amendment, Mr. Seiberling, expressed both views.").

48. See *supra* note 9.

49. See, e.g., *Allied Artists Pictures Corp. v. Rhodes*, 496 F. Supp. 408, 444 (S.D. Ohio 1980), modified, 679 F.2d 656 (6th Cir. 1982); *Factors Etc., Inc. v. Pro*

equivalency or preemption may be drawn from the legislative history because of the opacity of the house debate.⁵⁰

Notwithstanding the merits of both interpretations, the legislative history cannot be said to illuminate controversy concerning the equivalency of the right of publicity in a soundalike context. Although the House of Representatives Committee stated that the "evolving common law rights of 'privacy' [and] 'publicity' . . . would remain unaffected" by § 301,⁵¹ Congress probably did not foresee the unavoidable collision of copyright and the right of publicity presented by a soundalike claim.⁵² Each type of right of publicity infringement must be separately analyzed under § 301.⁵³ Therefore, preemption analysis of an aural simulation must proceed *de novo*.

B. Measuring Equivalency

Congress has stated that common law rights broader in scope than a federal right may be equivalent.⁵⁴ Similarly, those that merely complement a federal right may also be equivalent.⁵⁵ But this does

Arts, Inc., 496 F. Supp. 1090, 1097 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982); Ippolito v. Ono-Lennon, 139 Misc. 2d 230, 526 N.Y.S.2d 877, 892 (Sup. Ct. 1988), *modified*, 150 A.D.2d 300 (1st Dep't 1989); Shipley, *Publicity Never Dies, It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673, 705-06 (1981); Goldstein, *Preempted State Doctrines, Involuntary Transfers and Compulsory Licenses: Testing the Limits of Copyright*, 24 UCLA L. REV. 1107, 1118 (1978).

50. See, e.g., *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 676-77 n.25 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987); *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1239 (C.D. Cal. 1987); See J. McCarthy, *supra* note 10, § 11.13[A][2], at 11-65.

51. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 132 (1976) (even this statement is not unequivocal as the Committee goes on to say that publicity rights are not preempted "so long as [they] contain elements . . . different in kind from copyright").

52. Congress was probably thinking of the right of publicity in its traditional sense as an appropriation of a person's name or visual likeness since the prior soundalike cases failed to establish a cause of action for infringement of the right of publicity by aural imitation. See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970) (decided under passing-off and unfair competition, no mention of right of publicity), *cert. denied*, 402 U.S. 906 (1971); *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 347 (S.D.N.Y. 1973) (voice not protected under right of publicity); *Davis v. TWA*, 297 F. Supp. 1145 (C.D. Cal. 1969) (decided under passing-off and unfair competition, no mention of right of publicity); see also *Lahr v. Adell Chem. Co.*, 300 F.2d 256, 258 (1st Cir. 1962) (voice not protected under New York's privacy/publicity statute).

53. See J. McCarthy, *supra* note 10, § 11.13[C], at 11-68.

54. See H.R. REP. 1476, 94th Cong., 2d Sess. 131 (1976) ("The preemption of rights under State law is complete . . . even though the scope of exclusive rights given the work under [the Act] is narrower than the scope of common-law rights in the work might have been.").

55. M. Nimmer & D. Nimmer, *supra* note 33, § 1.01[B], at 1-11 to -12.

not help to clarify which special characteristics of state created rights implicate equivalence.

Nimmer has posited that an equivalent right is "one which is infringed by the mere act of reproduction, performance, distribution or display."⁵⁶ Recognizing that such a definition is not easy to apply, Nimmer goes on to provide a more detailed test.

If under state law the act of reproduction, performance, distribution or display. . . will *in itself* infringe the state created right, then such right is preempted. But if other elements required, in addition to or instead of, the acts of reproduction, performance, distribution or display, in order to constitute a state created cause of action, then the right does not lie 'within the general scope of copyright,' and there is no preemption.⁵⁷

His "extra element" test has been widely recognized,⁵⁸ enabling actual application to put flesh on the bones of the test.

In *Mayer v. Josiah Wedgwood & Sons, Ltd.*,⁵⁹ the plaintiff brought, *inter alia*, common law causes of action for conversion and misappropriation of her artistic snowflake design. The court adopted the "extra element" test, but refined it by requiring the extra element to "be one which changes the nature of the action so that it is *qualitatively* different from a copyright infringement claim."⁶⁰ To exemplify non-qualitatively different elements, the court cited "awareness or intent, which alter the action's scope but not its nature."⁶¹ In applying the test to the plaintiff's misappropriation cause of action, the court found the state law equivalent because it is violated by "precisely the type of misconduct the

56. *Id.* at § 1.01[B][1], at 1-13.

57. *Id.* at § 1.01[B][1], at 1-13 to -14 (emphasis in original).

58. See, e.g., *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1239 (C.D. Cal. 1987); *Mayer v. Josiah Wedgwood & Sons, Ltd.*, 601 F. Supp. 1523, 1535 (S.D.N.Y. 1985); see also *Harper & Row, Publishers, Inc. v. Nation Enter.*, 723 F.2d 195 (2d Cir. 1983), *rev'd on other grounds*, 471 U.S. 539 (1985).

When a right defined by state law [within the subject matter of copyright] may be abridged by an act which, in and of itself, would infringe one of the exclusive rights, the state law in question must be deemed preempted. . . . Conversely, when a state law violation is predicated upon an act incorporating elements beyond mere reproduction or the like, the rights involved are not equivalent and preemption will not occur.

Id. at 200.

59. 601 F. Supp. 1523 (S.D.N.Y. 1985).

60. *Mayer*, 601 F. Supp. at 1535; see also *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 677 n.26 (7th Cir. 1986), *cert. denied*, 480 U.S. 941 (1987) (a right is equivalent if (1) it is infringed by mere act of reproduction, performance, distribution, or display, or (2) it requires additional elements which "do not differ in kind from those necessary for copyright infringement.").

61. *Mayer*, 601 F. Supp. at 1535.

copyright laws are designed to guard against."⁶²

In *Motown Record Corp. v. George A. Hormel & Co.*,⁶³ the plaintiffs asserted infringement of singing group The Supremes' right of publicity by various means, including aural simulation. The court adopted the reasoning of *Mayer v. Josiah Wedgwood & Sons, Ltd.* and failed to find the right of publicity claims qualitatively different since they "derived from defendants [sic] . . . use of a copyrighted work."⁶⁴ This rationale, at least as applied to soundalikes by the court, has been criticized⁶⁵ and is of questionable validity for its failure to extricate the publicity rights from the copyrighted song, especially in light of *Midler v. Ford Motor Co.*⁶⁶

Nonetheless, various aspects of a right of publicity action have been proposed as extra elements withstanding preemption. For example, a right of publicity claim requires appropriation of an attribute of the plaintiff for commercial purposes,⁶⁷ whereas a copyright infringement action does not require commercial or economic injury. Thus, an argument has been made that commercial injury is an extra element.⁶⁸ This argument has been rejected, however, on the basis that the commerciality merely alters the scope of the action. That is, the "basic act which constitutes infringement of plaintiff's rights. . . is the same as that of copyright."⁶⁹ In both *Mayer* and *Motown*, either mere reproduction or performance of the copyrighted work triggered infringement of the right of publicity as well as copyright.

Notice that but for *Mayer's* addition of qualitiveness to the "extra element" test, a determination of equivalency would be inappropriate. Without commercial injury, reproduction or performance of the copyrighted work would not infringe either plaintiffs' rights of

62. *Id.*

63. 657 F. Supp. 1236 (C.D. Cal. 1987).

64. *Id.* at 1239-40.

65. See J. McCarthy, *supra* note 10, § 11.13[C], at 11-70 ("That the defendant was infringing plaintiff's copyright does not mean that defendant was not also infringing plaintiff's Right of Publicity.") (emphasis in original).

66. See *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) ("Midler does not seek damages for Ford's use of 'Do You Want To Dance,' and thus her claim is not preempted by federal copyright law. Copyright protects 'original works of authorship fixed in any tangible medium of expression.' A voice is not copyrightable. The sounds are not 'fixed.'").

67. See *supra* note 1 and accompanying text.

68. See *Shipley*, *supra* note 49, at 720; see also *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1240 (C.D. Cal. 1987) (pursuant to requirements of CAL. CIV. CODE § 3344 (West Supp. 1987)); *Mayer v. Josiah Wedgwood & Sons, Ltd.*, 601 F. Supp. 1523, 1535 (S.D.N.Y. 1985) (commercial immorality of misappropriation).

69. *Shipley*, *supra* note 49, at 720; see *Motown*, 657 F. Supp. at 1240-41 (The basic act which constitutes the alleged infringement — the unauthorized use of plaintiff's composition — is the same as that of copyright and is therefore preempted.'").

publicity. Thus, commerciality should, by strict definition, be an extra element. Only the *Mayer/Motown* imposition of a qualitative character to the element condemns the publicity claims to equivalence. In fact, under the language common to both *Mayer* and *Motown* — the "basic act which constitutes infringement is the same as that of copyright" — very few publicity claims would survive preemption. Not only would all soundalike claims fail, but so would the more common claims for appropriation of a visual image. Obviously, the reproduction of a picture is the same act which constitutes infringement of copyright and infringement of the right of publicity.

It has also been suggested that the deceptive nature of false endorsement or passing-off, which certainly may exist in soundalike claims,⁷⁰ is an extra element.⁷¹ Even though this element has been held to make an unfair competition claim non-equivalent,⁷² it may not withstand the *Mayer* test. It would seem that although the element of public deception is distinct in quality from mere reproduction or performance, under *Mayer/Motown* the "basic act which constitutes infringement is the same as that of copyright." Moreover, even if deception were an extra element, it would be of limited use for publicity plaintiffs since the presence of a disclaimer in an advertisement would eliminate the deceptive element but leave the publicity claim unaffected⁷³ and exposed to preemption.

Another element suggested by publicity proponents is that of similarity or identifiability.⁷⁴ The publicity action will lie only if the plaintiff is sufficiently identified by the defendant's use of the copyrighted work. The one rendition of the work that imitates the plaintiff will be affected, leaving the copyright owner with the broader right to perform the work in myriad non-imitative ways. Although this rationale seems the least intrusive on rights granted by the Act, it also fails to change the quality of the action, to say nothing of *Mayer/Motown's* "same basic act" test. It is apparent that the *Mayer/Motown* rationale, although purporting to focus on the quality of the rights themselves, produces results discordant with the spirit of *Nimmer's* "extra element" test by emphasizing the defend-

70. See *Midler*, 849 F.2d at 462 (persons hearing the defendant's commercial thought the plaintiff was singing).

71. See *Shipley*, *supra* note 49, at 720-21; Note, *supra* note 18, at 683; Brief for Appellant at 38, *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (No. 87-6168).

72. See *Ippolito v. Ono-Lennon*, 139 Misc. 2d 230, 526 N.Y.S.2d 877, 883 (Sup. Ct. 1988).

73. See *Allen v. National Video, Inc.*, 610 F. Supp. 612, 629 (S.D.N.Y. 1985); Halpern, *supra* note 2, at 1246 & n.268.

74. See J. McCarthy, *supra* note 10, § 4.14[E][3], at 4-94; Note, *supra* note 5, at 457-58; Comment, *The Right of Publicity as a Means of Protecting Performer's Style*, 14 *Lox. L.A.L. Rev.* 141 (1980).

ant's wrongful conduct and discounting the character of the rights asserted.

As applied by the courts, the "extra element" test will most likely result in determinations of equivalent state rights of publicity. However, the *Mayer/Motown* formulation is subject to attack for its smothering effect on most assertions of the right of publicity. Therefore, as that clearly unrealistic approach may well be replaced by a more balanced and fair one, it would be wise for the pro-preemption camp to ready a second argument for use in the wake of *Mayer/Motown's* foreseeable demise.

C. Limiting Exclusive Copyrights

Right of publicity defendants raise another argument in favor of preemption involving the tangled knot of rights that would result if both copyright and publicity law were simultaneously enforceable.⁷⁵ They complain that requiring a copyright licensee to secure an additional license from the holder of relevant publicity rights in order to use copyrighted material⁷⁶ defeats the policy of copyright⁷⁷ and imposes additional obligations and liabilities upon valid copyright licensees.⁷⁸ The state laws' "overlap" and "limitation" upon federal rights means that this application of the right of publicity is "qualitatively equivalent."⁷⁹ The author disagrees.

A copyright licensee, or owner for that matter, is not free to exploit his copyright without regard to the rights of others. For example, no one would suggest that the holder of a copyright in a book is immune to liability in defamation arising out of the book's content. Those who advance such an equivalency argument fail to understand that the exclusivity granted by the Act is merely a right to exclude others from exercising the rights concomitant with a copyrighted work; it is not an absolute right to use a copyrighted work in

75. Some commentators do not regard this as a true preemption argument since § 301 is "designed to determine those conflicts where a state law would seek to inhibit the use of *uncopyrighted* material." *E.g.*, Abrams, *Copyright, Misappropriation, and Preemption: Constitutional and Statutory Limits of State Law Protection*, 1983 Sup. Ct. Rev. 509, 573 (emphasis supplied).

76. For example, under *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988), the user of a copyrighted song must now obtain permission from the song's publisher and, if the user's rendition will simulate the performance on a sound recording, permission from the performer.

77. The broad policy of copyright is "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8.

78. *See, e.g.*, *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 718 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971); *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 347 (S.D.N.Y. 1973); Brief for Appellees at 34, 45-46, *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (No. 87-6168).

79. *Id.* at 36.

derogation of the non-copyright rights of others.⁸⁰ Thus, cases recognizing multiple bundles of rights in certain copyrighted works and requiring copyright proprietors to obtain publicity rights in order to exploit such works⁸¹ do not offend federal law, nor do they require the conclusion that additional rights are equivalent.

D. *Filling the Gap in Section 114*

Section 114 of the Act delineates the scope of exclusive rights in sound recordings.⁸²

The exclusive rights of the owner of copyright in a sound recording. . . do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, *even though such sounds imitate or simulate those in the copyrighted sound recording.*⁸³

Because of this language, "[m]ere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible."⁸⁴ Plaintiffs evidently have no soundalike cause of action under the Act. But query: does the foreclosure of a federal claim leave the states free to provide a cause of action for exactly the same conduct? Or, does the Act's explicit immunization of conduct claimed as wrongful by publicity plaintiffs make the right of publicity a patent example of an equivalent right?⁸⁵

Proponents of preemption obviously argue that § 114 exclusively governs this type of conduct⁸⁶ since *Sears/Compro* held that the states may not shield that which copyright leaves unsheltered.⁸⁷ Publicity advocates counter with *Goldstein*, which allowed the

80. See J. McCarthy, *supra* note 10, § 11.14[C], at 11-82.

81. See, e.g., *Bi-Rite v. Bruce Miner Poster Co.*, 757 F.2d 440, 446 (1st Cir. 1985); *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1100 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982); *Rhodes v. Sperry & Hutchinson Co.*, 193 N.Y. 223, 85 N.E. 1097, 1100 (1908), *aff'd*, 220 U.S. 502 (1910).

82. Sound recordings are embodied in "phonorecords," which "are material objects in which sounds . . . are fixed." 17 U.S.C. § 106 (1982). Sound recordings are more commonly known as records, tapes, and compact discs.

83. 17 U.S.C. § 114(b) (1982) (emphasis supplied).

84. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 106 (1976); see *United States v. Taxe*, 540 F.2d 961, 965 (9th Cir. 1976) (interpreting the 1971 Sound Recording Amendment to arrive at the same conclusion), *cert. denied*, 429 U.S. 1040 (1977).

85. That is, federal law expressly leaves unprotected such conduct. Would not the fact that the Act addresses this particular subject matter compel the conclusion that infringement of the right of publicity in this context is equivalent?

86. See, e.g., Brief for Appellees at 37, *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (No. 87-6168); see also J. McCarthy, *supra* note 10, § 4.14[E][2], at 4-93 (explicit immunization makes first door "too small to squeeze through").

87. See *supra* notes 27-30 and accompanying text.

states to protect writings outside the scope of federal protection.⁸⁸ The latter argument, however, proves unavailing.

In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,⁸⁹ the Supreme Court revisited the exceedingly broad language of *Sears/Compco* and harmonized those cases with *Goldstein*. It stated that "where Congress determines that neither federal protection nor freedom from restraint is required by the national interest, the States remain free to promote originality and creativity in their own domains."⁹⁰ Section 114(b) exemplifies the Court's language and how it renders crystalline the meaning of *Sears/Compco*. Only when Congress is silent on a matter of copyright are the states free to act. However, when Congress has chosen to speak, regardless of whether it protects or expressly declines to extend protection, such as in § 114(b), then Congress has determined that federal protection or freedom from restraint is required by the national interest and the states are not free to act. This interpretation also accords with *Goldstein*, where the court stated that when Congress has "left the area unattended. . . no reason exists why the State should not be free to act."⁹¹ By expressly acknowledging the freedom of imitators of sound recordings from liability under the Act, Congress has not left the area unattended. Therefore, the states are not free to provide what is essentially an equivalent right.

III. NATURE OF THE RIGHTS

Assuming *arguendo* that the first door of § 301 is closed, if it can be shown that copyright and the right of publicity protect different subject matter, preemption will not occur.⁹²

A. Subject Matter

The subject matter of copyright is original works of authorship once such works are fixed in a tangible medium of expression.⁹³ Distinction must be made between the work of authorship and its fixation in tangible form.⁹⁴ Only the work of authorship is protected, not the material object in which fixation subsists.⁹⁵ In addi-

88. See *supra* notes 31-33 and accompanying text.

89. 109 S.Ct. 971 (1989).

90. *Id.* at 985 (citations omitted).

91. *Goldstein v. California*, 412 U.S. 546, 570 (1973).

92. See *supra* note 19 and accompanying text.

93. See 17 U.S.C. § 102(a) (1982).

94. See *WGN Continental Broadcasting Co. v. United Video, Inc.*, 693 F.2d 622, 628 (7th Cir. 1982); M. Nimmer & D. Nimmer, *supra* note 33, § 2.03[C], at 2-32.

95. See M. Nimmer & D. Nimmer, *supra* at 2-33 (For example, "a 'literary work' is a work of authorship, but a 'book' is not. A 'book' is merely a material object which may embody, and hence constitute, a copy of a given literary work.").

tion, to qualify as a work of authorship, a work must be the product of some modicum of creative activity.⁹⁶ Thus, a work original to its author that has been produced with some perceivable creative input is protected by copyright once it is fixed in a material object.

In contrast, the subject matter of the right of publicity is an intangible proprietary interest deriving from the personality of a person — his persona.⁹⁷ This interest cannot be the subject matter of copyright because there is no way to reduce it to tangible form.⁹⁸

Defendants typically assert, however, that once a person's likeness is fixed in tangible form, his right of publicity interest has been fixed for copyright purposes and is subject to preemption.⁹⁹ This argument has been uniformly rejected.¹⁰⁰ In the same way that a picture of a person captures merely one expression of the underlying human being,¹⁰¹ a sound recording of a voice embodies only that particular expression of identity. The sound in a sound recording is merely an indicium by which a singer can be identified and in no way encapsulates the total underlying personality in the way that fixation of a work of authorship in a tangible medium of expression represents an entire work for purposes of copyright.¹⁰² As stated in *Midler*, a "voice is not copyrightable. The sounds are not 'fixed.' What is put forward as protectible here is more personal than any work of authorship."¹⁰³

There is another reason why the intangible personality interest protected by the right of publicity cannot be the subject of preemption. Section 301(a) preempts "*works of authorship that are fixed in*

96. See *id.* at § 2.09[F], at 2-138.1.

97. See *Bi-Rite Enter. v. Button Master*, 555 F. Supp. 1188, 1199 (S.D.N.Y. 1983); *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F.Supp. 1090, 1100 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982); *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 849-50, 603 P.2d 425, 160 Cal. Rptr. 323, 346 (1979) (Bird, C.J., dissenting); *M. Nimmer & D. Nimmer, supra* note 33, § 1.01[B][2], at 1-22.3.

98. See *supra* note 96.

99. See, e.g., Brief for Appellees at 42-43, *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (No. 87-6168) (citing Shipley, *supra* note 49, at 708); see also *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1240-41 (C.D. Cal. 1987) (publicity interest is merged into the copyrighted song).

100. See *supra* note 97 and accompanying text.

101. See J. McCarthy, *supra* note 10, § 11.13[C][2], at 11-71.

102. See McLane, *The Right of Publicity: Dispelling Survivability, Preemption, and First Amendment Myths Threatening to Eviscerate a Recognized State Right*, 20 CAL. W.L. Rev. 415 (1984)

One's persona, in all its varying aspects, is incapable of reduction to tangible form. . . . The right of publicity, although analogous to copyright, differs in that one's persona cannot be placed in a fixed medium. Thus, the right is not protected under the Copyright Act, and is not preempted by the Act.

Id. at 423-24.

103. *Midler v. Ford. Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988).

a tangible medium of expression and come within the subject matter of copyright as specified by section [] 102."¹⁰⁴ The highlighted portion of the preceding sentence of § 301 tracks the language of § 102 in defining the subject matter of copyright. Therefore, the second portion of the sentence in § 301 must by implication refer to the seven categories of works of authorship which comprise the rest of the definition of the subject matter of copyright in § 102.¹⁰⁵ The intangible proprietary interest protected by the right of publicity cannot be said to fall into any of the enumerated categories and is therefore, not the subject matter of copyright, unless some new category can be conceived of for "personas."

B. *Baltimore Orioles*

The foregoing would allow the right of publicity to escape preemption through the second door of § 301 were it not for the existence of *Baltimore Orioles, Inc. v. Major League Baseball Player's Ass'n*,¹⁰⁶ in which the Court of Appeals for the Seventh Circuit managed to mangle the right of publicity and preemption analysis.

In *Baltimore Orioles*, major league baseball players attempted to oust the right to broadcast baseball games from the club owners by wedging their intrinsic right of publicity between the performances of the games themselves and the telecasts of the games in which the owners clearly held copyrights. In other words, the players analogized the telecasts to pictures of individual people which, although copyrighted, are not commercially exploitable without the subject's consent.¹⁰⁷ The court held that the players' right of publicity was fixed in tangible form once recorded on videotape and hence subject to preemption by the federally copyrighted game telecasts.¹⁰⁸

If *Baltimore Orioles* is good law, then the right of publicity will be subordinated whenever an identifiable expression of persona be-

104. 17 U.S.C. § 301(a) (1982) (emphasis added).

105. See 17 U.S.C. § 102(a) (1982).

Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works; and
- (7) sound recordings.

Id.

106. 805 F.2d 663 (7th Cir. 1986), cert. denied, 480 U.S. 941 (1987).

107. See *supra* note 81 and accompanying text; CAL. CIV. CODE § 3344(a) (West Supp. 1990); N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1976 & Supp. 1990).

108. See *Baltimore Orioles*, 805 F.2d at 674-78.

comes fixed in tangible form¹⁰⁹ and the analysis set forth in Part IIIA, *supra*, would be eviscerated. Fortunately, the case has spawned a fury of criticism for its erroneous analysis of copyright and right of publicity law.¹¹⁰

The court's first mistake concerns copyright law. By contending that a baseball game itself is copyrightable,¹¹¹ the court failed to distinguish between the noncopyrightable performance and the copyrightable videotape made therefrom.¹¹² The court's statement that "once a performance is reduced to tangible form, there is no distinction between the performance and the recording of the performance for the purpose of preemption"¹¹³ may be true when the underlying performance consists of copyrightable subject matter,¹¹⁴ however, a spontaneous event *per se* is not copyrightable.¹¹⁵ Thus, a baseball game does not qualify as a work of authorship,¹¹⁶ for it lacks the requisite "modest amount of intellectual labor"¹¹⁷ required for copyrightability.¹¹⁸ Rather, the videotape memorializa-

109. See, e.g., Brief for Appellees at 33, *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (No. 87-6168).

110. See, e.g., M. Nimmer & D. Nimmer, *supra* note 33, § 1.01[B][2], at 1-22.3 to -22.4, § 2.09[F], at 2-138.1 to -138.5; Shipley, *Three Strikes and They're Out at the Old Ballgame: Preemption of Performer's Rights of Publicity Under the Copyright Act of 1976*, 20 ARIZ. ST. L.J. 369 (1988); Casenote, *Baltimore Orioles, Inc. v. Major League Baseball Players Association: The Right of Publicity in Game Performances and Federal Copyright Preemption*, 36 UCLA L. REV. 861 (1989) [hereinafter Casenote, *Game Performances*]; Casenote, *The Seventh Circuit Beans Performer Publicity Rights in Baseball's Telecast Rights Rhubarb*, 8 LOY. ENT. L.J. 75 (1988) [hereinafter Casenote, *Seventh Circuit*]; Casenote, *Right of Publicity and Copyright Preemption After Baltimore Orioles*, 40 ROTTERDAM L. REV. 971 (1988) [hereinafter Casenote, *After Baltimore Orioles*].

111. See *Baltimore Orioles*, 805 F.2d at 669 n.7 ("The work that is the subject of copyright is not merely the Players' performances, but rather the telecast of the Players' performances.") (emphasis in original).

112. See Casenote, *Game Performances*, *supra* note 110, at 862.

113. *Baltimore Orioles*, 805 F.2d at 675.

114. See M. Nimmer & D. Nimmer, *supra* note 33, § 2.10[A], at 2-144.1 to -146; see also Casenote, *After Baltimore Orioles*, *supra* note 110 at 982.

115. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903) (holding that graphic depictions of circus acts were copyrightable but the actual acts themselves were not, the court stated that "[o]thers are free to copy the original [.] [t]hey are not free to copy the copy"); Casenote, *Seventh Circuit*, *supra* note 110, at 86-87 (reality is not copyrightable); see also Casenote, *Game Performances*, *supra* note 110, at 870 ("Additionally, the games are not supported by an underlying 'writing.' The runs batted in, the strikeouts, and the home runs are not scripted prior to the actual performances.").

116. See, e.g., *National Ass'n of Broadcasters v. Copyright Royalty Tribunal*, 675 F.2d 367, 377 & n.16 (D.C. Cir. 1982); M. Nimmer & D. Nimmer, *supra* note 33, § 2.09[F], at 2-138.2.

117. *Baltimore Orioles*, 805 F.2d at 668 n.6.

118. See *id.* at 669 n.7, 676 (court doubts and then discounts the existence of any creativity in the players' performance, relying instead on the creative input of the technical crew).

tion of the game is copyrightable because of the creative input of the technical crew responsible for the recodation.¹¹⁹ The Seventh Circuit incorrectly viewed the game and the videotape as interchangeable for copyright purposes.¹²⁰

The court's second mistake occurred in its right of publicity analysis. It rejected four opinions that found the right of publicity not preempted by copyright¹²¹ and held that fixation of a performance essentially fixes the persona.¹²² Although this rationale has been approved by a few commentators based on a separate right of publicity inhering in performance values,¹²³ the better view is that publicity rights inhere in the persona.¹²⁴ A performance, like a picture, videotape, or sound recording, is just the indicium by which the person is identified.

Oddly enough, the Seventh Circuit came out with the right result; it simply relied on the wrong rationale. The court should have relied on the work for hire doctrine, applicable under the Act, and applied it analogously to the players' right of publicity.¹²⁵ The court discussed this issue, refused to find it conclusive,¹²⁶ and instead,

119. See M. Nimmer & D. Nimmer, *supra* note 33, § 2.09[F], at 2-138.1; Casenote, *Seventh Circuit*, *supra* note 110, at 88.

120. See *supra* note 111, 113 and accompanying text; see also M. Nimmer & D. Nimmer, *supra* note 33, § 1.01[B][2], at 1-22.4 n.89.9 ("the court holds that baseball games qualify as works of authorship for preemption purposes because the motion pictures in which they are fixed are copyrightable works"); Casenote, *Game Performances*, *supra* note 28, at 888 ("The performance must not be merged into a copyrightable work, merely because it has been filmed."); Casenote, *Seventh Circuit*, *supra* note 110, at 88 ("What is fixed in tangible form is not the game itself, but the game's depiction as created by the television crew.").

The court's mistake is manifest in the absurdities resulting from the application of its rationale to other situations. See M. Nimmer & D. Nimmer, *supra* note 33, § 2.09[F], at 2-138.3 to -138.4 (fan taking snapshot of game would violate copyright); Casenote, *Game Performances*, *supra* note 110, at 886 (person could not restrict the unauthorized use of his photo for advertisements); Casenote, *Seventh Circuit*, *supra* note 110, at 87-88 (circus acts could not be depicted by others after the first depiction is copyrighted).

121. See *Baltimore Orioles*, 805 F.2d at 679 n.26 (citing *Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d 278 (2d Cir. 1981) (dissenting), cert. denied, 456 U.S. 927 (1982); *Bi-Rite Enter. v. Button Master*, 555 F. Supp. 1188 (S.D.N.Y. 1983); *Apigram Publishing Co. v. Factors Etc., Inc.*, No. C78-525, slip. op. (N.D. Ohio, July 30, 1980); *Lugosi v. Universal Pictures*, 25 Cal.3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979) (Bird, C.J., dissenting)).

122. See *Baltimore Orioles*, 805 F.2d at 678 n.26 ("Because a performance is fixed in tangible form when it is recorded, a right of publicity in a performance that has been reduced to tangible form is subject to preemption.").

123. See, e.g., *J. McCarthy*, *supra* note 10, § 11.13(C)(2), at 11-72 n.67.1; *Shipley*, *supra* note 49, at 718.

124. See *supra* notes 96-103 and accompanying text.

125. The district court decided the case based on the employer-employee relationship. See *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 1985 Copyright L. Dec. (CCH) ¶ 25,822 (N.D. Ill. 1985).

126. See *Baltimore Orioles*, 805 F.2d at 679-82.

found it necessary to decide the case on the preemption issues.

CONCLUSION

With *Baltimore Orioles* thoroughly discredited, the second door of the preemption test remains open. Although a performer's assertion of publicity rights as embodied in a distinctive rendition of a musical work is probably equivalent to rights assertable under copyright law, by asserting such rights the performer is seeking to protect something outside the scope of the Act. Ultimately, the question of whether society should protect the rights of performers to their own personal and imitable performances may be answered by state legislatures, Congress, or the Supreme Court.

*Leonard A. Wohl***

** Associate; Pryor, Cashman, Sherman & Flynn; B.A. 1983, University of Pennsylvania; J.D. 1990, Fordham University School of Law.