

Fordham Intellectual Property, Media and Entertainment Law Journal

Volume 24, Issue 1

Article 1

VOLUME XXIV BOOK 1

I Do Not Endorse This Message! Does A Political Campaign's Unauthorized Use of a Song Infringe On The Rights of the Musical Performer?

Kimberlianne Podlas*

*University of North Carolina Greensboro

Copyright © by the authors. *Fordham Intellectual Property, Media and Entertainment Law Journal* is produced by The Berkeley Electronic Press (bepress). <http://ir.lawnet.fordham.edu/iplj>

I Do Not Endorse This Message! Does a Political Campaign’s Unauthorized Use of a Song Infringe on the Rights of the Musical Performer?

Kimberlianne Podlas*

INTRODUCTION	2
I. MUSIC AND POLITICS	3
A. <i>Hitting the Wrong Note</i>	4
B. <i>Performer Complaints</i>	7
II. THE RIGHTS ASSOCIATED WITH A SONG OR SOUND RECORDING.....	8
III. DEFINING TRADEMARK.....	10
A. <i>A Mark’s Meaning</i>	11
B. <i>A Mark’s Distinctiveness</i>	12
IV. CONSTRUCTING A THEORY OF SONG MARK PROTECTION.....	14
A. <i>Music as an Entertainment Service or Brand Quality</i>	14
B. <i>The “Mark” of a Song Mark</i>	16
C. <i>Voice or Vocal Performance</i>	16
D. <i>The Musical Composition and Sound Recording</i>	18
E. <i>Performance of a Musical Work</i>	20
F. <i>Can a Song Attain Secondary Meaning?</i>	23
V. TRADEMARKS FOUNDED ON COPYRIGHTED WORKS	26
VI. TRADEMARK INFRINGEMENT	29
A. <i>Types of Infringement</i>	30
VII. USE IN COMMERCE.....	35

* Associate Professor of Media Law, Dept. of Media Studies, UNC Greensboro; JD, cum laude, SUNY Buffalo School of Law; BA, magna cum laude, SUNY at Buffalo. The author would like to thank the Fordham Intellectual Property, Media & Entertainment Law Journal staff for their assistance with this Article.

A. <i>The Unauthorized Use of the Trademark Must Occur in Commerce</i>	37
B. <i>A Trademark Must Be Used in Commerce to Earn Protection</i>	39
C. <i>Use in Commerce Is a Jurisdictional Predicate</i>	39
VIII. CONFUSION DUE TO CAMPAIGN USES.....	43
A. <i>Absence of Commercial or Consumer Confusion</i>	44
B. <i>Reasonable Likelihood of Confusion</i>	46
IX. COPYRIGHT PREEMPTION	48
A. <i>Scope of Preemption</i>	50
B. <i>Preemption of Uncopyrightable Qualities and Components of Copyrighted Works</i>	53
X. WHAT RIGHTS DOES A SONG MARK SEEK TO VINDICATE?	57
CONCLUSION.....	58

INTRODUCTION

This Article addresses a legal issue that is arising with increasing frequency; whether a political campaign’s use of a song—without the permission of its performer—infringes on any trademark rights of the performer.

To contextualize the issue, this Article begins by recounting a number of high-profile complaints by singers about political campaigns playing their songs. Next, it outlines the relevant provisions of the Lanham Act and case law pertaining to non-traditional trademarks, and considers whether music can function as a singer trademark. In doing so, it constructs and scrutinizes the viability of a theory of “song-mark” protection as well as the way that it would intersect with and contradict provisions of the Copyright Act. Then, assuming *arguendo* that a singer is entitled to such protection, this article analyzes whether campaign uses of music meet the requirements of “false endorsement” so as to constitute trademark infringement. Ultimately, this Article concludes that while, in theory, a song-based trademark could exist, in practice it would either fail to acquire the appropriate secondary meaning or be precluded—if not preempted—by

Copyright law. Moreover, even if these substantive and procedural hurdles were cleared, it is doubtful that a political campaign's playing of a song would confuse or mislead consumers under the Lanham Act.

I. MUSIC AND POLITICS

Today, popular music is a standard component of any political campaign.¹ It is used to energize crowds,² articulate campaign messages,³ and attract young voters.⁴ Although it was not the first to integrate music into a campaign,⁵ the contemporary practice can be traced to Bill Clinton's 1992 presidential campaign.⁶

¹ See Matthew J. Cursio, *Born To Be Used In The USA: An Alternative Avenue For Evaluating Politicians' Unauthorized Use of Original Musical Performances on the Campaign Trail*, 18 VILL. SPORTS & ENT. L.J. 317 (2011); Eriq Gardner, *Michele Bachmann in Legal Spat for Using Tom Petty's 'American Girl' at Rally*, HOLLYWOOD REPORTER, (June 28, 2011, 11:48 AM), <http://www.hollywoodreporter.com/threesq/michele-bachmann-legal-spat-using-206257>; Chris Richards, *Campaigns Adopting Songs Is Nothing New, But Squabbles With Musicians Are*, WASH. POST (June 29, 2011), http://articles.washingtonpost.com/2011-06-29/lifestyle/35265463_1_theme-songs-campaign-season-appearances.

² See James C. McKinley, *G.O.P. Candidates Are Told, Don't Use the Verses, It's Not Your Song*, N.Y. TIMES, Feb. 4, 2012, at C1, available at http://www.nytimes.com/2012/02/04/arts/music/romney-and-gingrich-pull-songs-after-complaints.html?pagewanted=all&_r=0.

³ See Cursio, *supra* note 1, at 317; McKinley, *supra* note 2 (explaining that candidates use music for two purposes: to motivate supporters and to underline a campaign message); see also Gardner, *supra* note 1 (discussing use of music in advertisements).

⁴ See Gardner, *supra* note 1, (Bachmann wanted to use a certain song to "score points" with audience); Kenneth Kidd, *Politicians and Rock Music: A Legal Wango Tango*, TORONTO STAR, July 2, 2011, http://www.thestar.com/news/insight/2011/07/02/politicians_and_rock_music_a_legal_wango_tango.html (rock music is often used by candidates to cater to young voters).

⁵ See Richards, *supra* note 1 (Politicians have used music since the late 1800s, but the practice became popular only recently.); see also Guy Dixon, *Do Not Use My Song Ever Again, Globe Review, Music and Politics*, GLOBE AND MAIL (Canada) (Feb. 2, 2012), <http://www.theglobeandmail.com/arts/music/knaan-to-mitt-romney-dont-use-my-music/article542793> (Franklin Roosevelt's campaign adopted "Happy Days Are Here Again" and John F. Kennedy's campaign used Frank Sinatra's "High Hopes" accompanied by Sinatra's endorsement.)

⁶ See Stephen Battaglio, *The Biz: Arsenio Hall Talks Back*, TV GUIDE (June 27, 2012, 7:01 AM), <http://www.tvguide.com/news/arsenio-hall-talks-1049221.aspx> (describing how Clinton's guest appearance changed the rules of campaigning); *Hardball with Chris Matthews* (MSNBC television broadcast June 26, 2012) (describing Clinton's iconic campaign moments and "masterful" campaigning).

Clinton adopted Fleetwood Mac's "Don't Stop (Thinkin' About Tomorrow)," playing it every day, at every event.⁷ Not only did the hit song inject vitality into rallies and elevate the mood of crowds,⁸ it also established a cultural touchstone for Baby-Boomers⁹ and encapsulated Clinton's vision of optimism for the future.¹⁰ Since then, campaign theme songs have become *de rigueur*.¹¹

A. *Hitting the Wrong Note*

As the use of music has increased, however, so have complaints by artists who do not want their songs politicized or associated with candidates they do not support.¹² A majority of complaints have been by performers who favor Democrats and are upset about Republicans using their songs;¹³ some have even objected to the use of their songs on television networks that have a specific political bent.¹⁴ While some artists object only when

⁷ See Cursio, *supra* note 1, at 317; Dixon, *supra* note 5; Anne Hull, *A Petty Girl? Bachmann, You Don't Know How It Feels*, WASH. POST (July 2, 2011), http://articles.washingtonpost.com/2011-07-01/lifestyle/35266860_1_tom-petty-american-girl-michele-bachmann (Fleetwood Mac endorsed Clinton's use and performed at his inauguration.); see also Richards, *supra* note 1.

⁸ See Matthew F. Jordan, *Obama's iPod: Popular Music and the Perils of Postpolitical Populism*, 11 POPULAR COMM.: THE INT'L J. MEDIA AND CULTURE 99, 103 (2013) (music influences emotions and activates a sense of identification with a candidate).

⁹ See *id.* at 103–04.

¹⁰ See Cursio, *supra* note 1, at 317.

¹¹ See *id.* at 317–18; see also Tim Dowling, *Newt Gingrich Gets a Rocky Ride for Campaign Song*, THE GUARDIAN (London), Jan. 31, 2013, <http://www.theguardian.com/world/shortcuts/2012/jan/31/newt-gingrich-sued-rocky-song>; McKinley, *supra* note 2 (noting various candidates and their choices for campaign music).

¹² See, e.g., Dixon, *supra* note 5 (noting K'Naan's resistance to Romney using a song of his); James Frazier, *Liberal Musicians Demand Conservative Pols Stop the Music*, WASH. TIMES (Feb. 2, 2011), <http://www.washingtontimes.com/news/2012/feb/1/songwriters-have-history-of-asking-politicians-to-/?page=all>.

¹³ See Gardner, *supra* note 1 (explaining that many complaints are by liberal-leaning artists against conservative candidates); McKinley, *supra* note 2 (explaining that celebrities seem to favor democrats); Richards, *supra* note 1 (determining that 80% of donations from individuals in the music industry have been to democrats).

¹⁴ See Matthew Perpetua, *Adam Levine to Fox News: Stop Playing My Music*, ROLLING STONE (Oct. 19, 2011, 6:00 PM), <http://www.rollingstone.com/music/news/adam-levine-to-fox-news-stop-playing-my-music-20111019> (in November 2011, Adam Levine of Maroon 5 told FOX News to stop using his band's music.)

their music is used by politicians they do not support, others object when it is used in any political context.¹⁵ Indeed, in every presidential campaign since 1996, at least one candidate has been asked to stop playing an artist's music.¹⁶ During recent election cycles, Rand Paul,¹⁷ Michele Bachmann,¹⁸ Mitt Romney,¹⁹ and Newt Gingrich²⁰ were all chastised by performers for using songs without their authorization.²¹

One of the most publicized incidents involved Representative Michele Bachmann. In her bid for the Republican Presidential nomination, Bachmann played a recording of Tom Petty's "American Girl" at several campaign events.²² Presumably, Bachmann thought the chorus "she's an American Girl" evoked her All-American quality and defense of mainstream American values.²³ Petty, however, did not approve of Bachmann's

¹⁵ Notably, Lee Greenwood does not allow his "God Bless the USA" to be used in commercials or political rallies. *See* Richards, *supra* note 1; *see also* McKinley, *supra* note 2 (noting fear that a song could lose its value if associated with a politician).

¹⁶ *See* David C. Johnston, *The Singer Did Not Approve This Message: Analyzing the Unauthorized Use of Copyrighted Music in Political Advertisements in Jackson Browne v. John McCain?*, 27 CARDOZO ARTS & ENT. L.J. 687, 688–90 (2010). In 1996, Bob Dole modified the lyrics of Isaac Hayes and David Porter's "Soul Man" into "Dole Man." *See id.* George W. Bush used Sting's "Brand New Day" in 2000 and Orleans' "Still the One" in 2004. *See id.* at 689. In 2008, Mike Huckabee used Boston's "More Than a Feeling," and John McCain used music by Foo Fighters, Jackson Browne, and Survivor. *See id.*

¹⁷ *See* Gardner, *supra* note 1 (music by Rush used during his 2010 senatorial campaign).

¹⁸ *See* Dixon, *supra* note 5 (noting Tom Petty's cease and desist request when Bachmann used "American Girl"); Frazier, *supra* note 12 (music by Tom Petty and Katy Perry).

¹⁹ *See* Dixon, *supra* note 5 (music by K'naan).

²⁰ *See* Dowling, *supra* note 11 (Gingrich was sued for copyright infringement); *see also* Frazier, *supra* note 12 (Newt Gingrich used both Survivor's Eye of the Tiger (the theme from Rocky III) and the UK band Heavy's "How You Like Me Now").

²¹ *See* Dixon, *supra* note 5; Frazier, *supra* note 12.

²² *See* Dixon, *supra* note 5; Richards, *supra* note 1.

²³ *See* Richards, *supra* note 1. Bachmann's song choice was questionable—aside from the refrain, the lyrics described a girl of questionable values quite different from those that Bachmann espoused. *See* Hull, *supra* note 7. Rick Perry's choice of Ozzy Osbourne's "Crazy Train" and Rand Paul's use of Rush's "Tom Sawyer" were also odd. *See* Richards, *supra* note 1.

candidacy, and turned this into an opportunity to criticize her for not only using the song without permission, but also her politics.²⁴

During the 2008 election, John McCain and the Republican National Party were sued by Jackson Browne (an active supporter of Barack Obama²⁵) because they included the chorus of “Running on Empty” in an advertisement.²⁶ Ultimately, McCain was forced to pull the advertisement and settle out of court.²⁷ McCain’s running mate, Sarah Palin, experienced a similar problem. When Palin, known in her college basketball days as “Sarah Barracuda,” adopted Heart’s “Barracuda” as her introduction at the Republican National Convention, Heart complained.²⁸ Heart did not support Palin, but also found it ironic that she was using a song that was “a rant against the soulless corporate nature of the music business.”²⁹

Even candidates who comply with copyright requirements³⁰ risk blowback. Last summer, Republican nominee Mitt Romney licensed K’naan’s global hit “Wavin’ Flag.”³¹ The Somali-Canadian artist nevertheless objected to Romney’s use and released a harshly worded statement detailing his distaste for the candidate.³² In response, Romney ceased using the song.³³

Music can backfire in other ways, such as when a lyrically tone-deaf candidate chooses an inappropriate song. This most famously occurred when President Ronald Reagan referenced what he mistakenly thought was the uplifting message of hope in Bruce

²⁴ See Dixon, *supra* note 5; Richards, *supra* note 1. Petty also complained when George W. Bush used “I Won’t Back Down.” *Id.*

²⁵ See Browne v. McCain, 611 F. Supp. 2d 1125 (C.D. Cal. 2009).

²⁶ See Maral Vahdani, *Selection from the Grammy Foundation Entertainment Law Initiative 2010 Writing Competition: Running on Empty: The Problem with Politicians and Stealing (Music)*, 32 LOY. L.A. ENT. L. REV. 75, 76–77 (2011-2012); Frazier, *supra* note 12.

²⁷ See Vahdani, *supra* note 26, at 76–77.

²⁸ See Dowling, *supra* note 11; Richards, *supra* note 1.

²⁹ See Frazier, *supra* note 12. See generally Dixon, *supra* note 5; Dowling, *supra* note 4.

³⁰ See Dixon, *supra* note 5 (public performance rights are usually permitted pursuant to a blanket license owned by the venue).

³¹ See *id.*

³² See Kidd, *supra* note 4.

³³ See *id.*

Springsteen's "Born in the USA."³⁴ Of course, anyone familiar with Springsteen's lyrics knew that the song was nothing of the sort, but was, instead, an anti-war anthem criticizing the government's treatment of Vietnam veterans.³⁵ This caused both Springsteen to object that Reagan, whom he did not support, was co-opting his music and perverting its message, and Reagan's pandering to look foolish.³⁶

Indeed, especially in an era when social media enables performers to communicate directly with fans, adopting music without the artist's blessing creates a public opportunity for a performer to publicly rebuke the candidate.³⁷ For example, when Charlie Crist used David Byrne's "Road to Nowhere" in his failed Senatorial campaign, the settlement required Crist to repent and apologize on YouTube.³⁸

B. Performer Complaints

Because artists lack ideological veto power to prevent people they dislike from playing their songs,³⁹ they have asserted that a political campaign's use constitutes copyright infringement, trademark infringement, or both. The success of some musical artists in stopping campaigns' unauthorized use of music appears to have emboldened others to seek redress.⁴⁰ Notwithstanding the proliferation of these complaints, their legal foundation is uncertain.⁴¹ While copyright theories involve clearly defined possessory interests and require case-by-case analyses of the facts,

³⁴ See Cursio, *supra* note 1, at 318; Frazier, *supra* note 12; Richards, *supra* note 1.

³⁵ See Kidd, *supra* note 4; Frazier, *supra* note 12.

³⁶ See Dixon, *supra* note 5; Richards, *supra* note 1.

³⁷ See Kidd, *supra* note 4 (noting that once artist goes public, politician may experience public backlash); Richards, *supra* note 1 (indicating that complaints can lead to public shaming).

³⁸ See Kidd, *supra* note 4 (in concluding his apology, Crist promised: "I pledge that, should there be any future election campaigns for me, I will respect and uphold the rights of artists and obtain permission or a license for the use of any copyrighted work."); Richards, *supra* note 1.

³⁹ See Dixon, *supra* note 5 (explaining that it is up to the venue holding the political rally to purchase a blanket license and there is no other recourse to prevent a song from being played for ideological reasons).

⁴⁰ See McKinley, *supra* note 2; see also Frazier, *supra* note 12.

⁴¹ See Vahdani, *supra* note 26, at 77; see also Gardner, *supra* note 1 (explaining that courts have not yet answered definitively the issue of unauthorized use).

trademark theories implicate emerging legal issues and nuanced aspects of trademark that are easily misconstrued and whose application to political contexts is unclear. Additionally, this issue not only will continue to arise until it is resolved, but also risks diverting a candidate from the campaign trail and into the courthouse.⁴² Consequently, this Article addresses the latter issue of a performer's trademark interest in songs associated with her and whether a political campaign's use of that music impermissibly infringes on those interests.

II. THE RIGHTS ASSOCIATED WITH A SONG OR SOUND RECORDING

To determine whether a campaign's use of music infringes on any rights of a performer, it is necessary to analyze what rights a vocalist possesses in a song. This requires clarifying the contours of copyright.

For the most part, the rights related to a tangible song are within the purview of copyright.⁴³ A song implicates two different copyrights—that of the musical composition, which is possessed by the composer or songwriter,⁴⁴ and that of the sound recording, which usually is possessed by the producer or record company.⁴⁵

The Copyright Act gives a copyright owner a number of exclusive rights in a musical work, including the right to perform publicly, license, and adapt the work.⁴⁶ Most sound recording copyrights are owned by producers or recording companies that

⁴² See Richards, *supra* note 1 (noting the diversion of resources and consequent public shaming).

⁴³ See Vahdani, *supra* note 26, at 77.

⁴⁴ See 17 U.S.C. § 102(a)(2) (2006).

⁴⁵ See 17 U.S.C. § 102(a)(7). See generally, Jay Rosenthal, *The Recording Artist/Songwriter Dilemma: The Controlled Composition Clause—Enough Already!*, 3 LANDSLIDE (A.B.A.), no. 4, 2011, available at http://www.americanbar.org/publications/landslide_home/intelprop_landslide_VOL3n4.html.

⁴⁶ See 17 U.S.C. § 106 (2002); see also Vahdani, *supra* note 26, at 77. The Sound Recording Act of 1971 granted copyright owners of sound recordings limited rights to reproduction and distribution but no public performance rights. See Digital Performance Right in Sound Recordings Act of 1995, Pub. L. No. 104-39, 109 Stat. 336 codified as amended in scattered sections of 17 U.S.C.

produced the recording.⁴⁷ Therefore, a performer of the copyrighted work generally does not own any rights in the work, her performance, or the tangible recording of that performance.⁴⁸ Even when a vocalist authors the copyrighted composition, standard industry practice typically requires relinquishment of any rights, pursuant to contract.⁴⁹ Therefore, the copyright holders, such as the composer and record company, could claim copyright infringement if a sound recording or musical composition is used at a campaign rally or in a political ad.⁵⁰ Indeed, musical artists who have successfully sued politicians and commercial entities for the unauthorized use of music have done so as copyright owners of the musical compositions, not as performers of them.⁵¹ By contrast, most performers cannot assert such claims when they have no rights in the copyrighted works. Additionally, if a politician has licensed the song or sound recording,⁵² the copyright holder cannot claim infringement.⁵³

This has forced vocalists who wish to stop politicians from using “their” music to look to other areas of law. Most recently, performers have framed the issue as the song implying a “false endorsement,” thereby infringing on a trademark interest.⁵⁴ Whereas copyright protects tangible works of authorship (for example, a musical composition or sound recording), a trademark protects a right appurtenant to an established business or service.⁵⁵ Hence, this argument does not assert any copyright in the

⁴⁷ See Rosenthal, *supra* note 45 (identifying the rights associated with a song and the impact of “controlled composition clauses” on musical artists who both write and sing their songs).

⁴⁸ See Vahdani, *supra* note 26, at 77.

⁴⁹ See Rosenthal, *supra* note 45.

⁵⁰ See Richards, *supra* note 1.

⁵¹ See generally *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56 (2d Cir. 2011).

⁵² Music publishing companies, such as BMI and ASCAP, possess the right to license the public performance rights of over 6.5 million copyrighted musical compositions. See, e.g., *Broad. Music Inc. v. Paden*, No. 5:11-02199-EJD, 2011 WL 6217414, *1 (N.D. Cal. 2011).

⁵³ See 17 U.S.C. § 115; Dixon, *supra* note 5 (where the appropriate license fee has been paid, the composer has no claim); McKinley, *supra* note 2 (copyright licensing fees are often paid).

⁵⁴ See Gardner, *supra* note 1.

⁵⁵ See Julia Riehm McGufey, *The New Edition of New Edition: Boybands, Trademarks, and Shifting Goodwill*, 47 U. LOUISVILLE L. REV. 167, 168 (2008).

composition or sound recording, but that the sound of a voice performing a song, and as captured in the sound recording, constitutes an aural mark, or “song mark” as used herein, denoting the singer.⁵⁶ Therefore, when a candidate plays a song that constitutes the song mark, it infringes on that trademark by falsely implying that the singer endorses or is associated with the candidate.⁵⁷ This raises a constellation of novel issues including, whether a song could ever constitute a performer trademark; how it would impact other rights in the musical work; and whether a use by a politician, who is not engaged in commerce, is immune from a false endorsement claim.

III. DEFINING TRADEMARK

A trademark⁵⁸ is any word, name, symbol, device, or combination thereof used to identify and distinguish businesses, services, sources, or their goods from those of others.⁵⁹ A trademark both denotes the commercial entity, service, or goods, and connotes the qualities, heritage, or goodwill associated with it.⁶⁰ In turn, the trademark guards against consumer confusion regarding those goods and services as well as with associations between or endorsements by them.⁶¹

Trademarks are protected by both federal statute and common law; § 32 of the Lanham Act protects federally registered marks⁶² and § 43(a) protects both registered and certain unregistered

⁵⁶ See Dixon, *supra* note 5.

⁵⁷ See *id.*

⁵⁸ See 15 U.S.C. §§ 1051–1129 (2010) (Trademarks are addressed in Title 15 of the U.S. Code, the Lanham Act).

⁵⁹ See 15 U.S.C. § 1127 (2006); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992); 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 3:1 (4th Ed. 2013) (the mark must be distinctive enough that it is capable of distinguishing one source from another).

⁶⁰ See *Crystal Entm't & Filmworks v. Jurado*, 643 F.3d 1313, 1322 (11th Cir. 2011); J. Shahar Dillbary, *Trademarks as a Media for False Advertising*, 31 CARDOZO L. REV. 327, 331–32 (2009); Laura A. Heymann, *The Law of Reputation and the Interest of the Audience*, 52 B.C. L. REV. 1341, 1385–86 (2011).

⁶¹ See *Two Pesos*, 505 U.S. at 763.

⁶² 15 U.S.C. § 1114(1)(a) (2005).

marks.⁶³ The possessory rights of a trademark, however, only materialize through actual, bona fide use of a mark in commerce.⁶⁴

A. A Mark's Meaning

A wide variety of words, symbols, and devices can be used as trademarks.⁶⁵ The United States Patent and Trademark Office even permits registration of distinctive sound marks,⁶⁶ such as the three-chime progression designating NBC.⁶⁷ The key is that the means of denotation, whether aural or visual, must be capable of transmitting meaning.⁶⁸ The mark must be able to identify the goods or source or evoke in consumers some connotation of quality by which the goods or source is known.⁶⁹ If the mark does not “speak” in this way, it cannot serve as a trademark.⁷⁰

⁶³ 15 U.S.C. § 1125(a) (2012); *see also* *Crystal Entm't*, 643 F.3d at 1320; *Tumblebus v. Cranmer*, 399 F.3d 754, 760–61 (6th Cir. 2005); *Gameologist Grp., LLC v. Sci. Games Int'l, Inc.*, 838 F. Supp. 2d 141, 152 (S.D.N.Y. 2011).

⁶⁴ *See* 15 U.S.C. § 1127. When ownership is asserted under common law, a putative owner must show that it has adopted and used the mark in a way that has caused the public to associate it with the particular service or source. *See Planetary Motion, Inc. v. Techsplosion, Inc.*, 261 F.3d 1188, 1193–94 (11th Cir. 2001); *see also* *Crystal Entm't*, 643 F.3d at 1320–21 (trademark ownership does not arise from reserving the prerogative to use mark in the future, but only from actual, bona fide use in commerce); *Int'l Healthcare Exch., Inc. v. Global Healthcare Exch., LLC*, 470 F. Supp. 2d 365, 371 (S.D.N.Y. 2007) (“The talismanic test is whether or not the mark was used in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark.”).

⁶⁵ *See* *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209 (2000); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

⁶⁶ *See In re Gen. Elec. Broad. Co.*, 199 U.S.P.Q. (BNA) 560, 563 (T.T.A.B. 1978); Daniel R. Bumpus, *Bing, Bang, Boom: An Analysis Of In re Vertex Group LLC and the Struggle for Inherent Distinctiveness in Sound Marks Made During a Product's Normal Course of Operation*, 21 FED. CIR. B.J. 245, 248–49 (2011). According to the United States Patent and Trademark Office's Trademark Manual of Examining Procedure's § 1202.15 Sound Marks: “A sound mark identifies and distinguishes a product or service through audio rather than visual means. Sound marks function as source indicators when they ‘assume a definitive shape or arrangement’ and ‘create in the hearer's mind an association of the sound’ with a good or service.” TMEP § 1202.15. (quoting *Gen. Electric*, 199 U.S.P.Q. at 563).

⁶⁷ *See* Bumpus, *supra* note 66, at 246.

⁶⁸ *See id.* at 249; *see also* Heymann, *supra* note 60, at 1385–86 (describing naming and denotation function of trademarks).

⁶⁹ *See* *Crystal Entm't*, 643 F.3d at 1322; *Bell v. Streetwise Records, Ltd.*, 640 F. Supp. 575, 581 (D. Mass. 1986); *see also* Kenneth L. Port, *On Nontraditional Trademarks*, 38 N. KY. L. REV. 1, 47 (2011) (explaining that nontraditional marks may prompt association

B. A Mark's Distinctiveness

A mark must also be distinctive.⁷¹ A mark can be distinctive in either of two ways. It can be inherently distinctive⁷² or acquire distinctiveness by developing a secondary meaning.⁷³ A mark is inherently distinctive when its intrinsic nature identifies a particular source or business.⁷⁴ This is true of words and marks that are “arbitrary” or “fanciful,”⁷⁵ such as Nestlé or Purell, because they “almost *automatically* tell a customer that they refer to a brand.”⁷⁶ A mark can also acquire distinctiveness when, through use in commerce and over time, it develops a secondary meaning.⁷⁷ Secondary meaning is achieved when the public comes to understand the mark as identifying the service or product source rather than the product itself or a product feature.⁷⁸ If it is not reasonable to assume that a consumer would think a mark indicates

in the mind of the consumer between the sound and the brand); Rebecca Tushnet, *Gone in Sixty Milliseconds: Trademark Law and Cognitive Science*, 86 TEX. L. REV. 507, 508, 514 (2008) (research shows that exposure to a mark can trigger emotions in the mind of consumers and that consumers transfer feelings about advertising and trademarks to the products themselves).

⁷⁰ See 1 MCCARTHY, *supra* note 59, at § 3:1.

⁷¹ See *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 635 (6th Cir. 2002); *MasterCard Int'l Inc. v. Nader*, No. 00 Civ. 6068 (GBD), 2004 U.S. Dist. LEXIS 3644, at *7 (S.D.N.Y. 2004). Whereas inherently distinctive sounds do not require proof of acquired distinctiveness, common sounds or sounds made by a product in its normal course of operation require proof that the sound has become distinctive in the mind of consumers through their use in connection with the manufacturer. See *Bumpus*, *supra* note 66, at 246–47; *In re Vertex Grp. LLC*, 89 U.S.P.Q.2d (BNA) 1694, 1699 (T.T.A.B. 2009).

⁷² See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 213–14 (2000).

⁷³ See *id.* at 212.

⁷⁴ See *id.* at 215–16; see also *G.M.L., Inc. v. Mayhew*, 188 F. Supp. 2d 891, 895 (M.D. Tenn. 2002) (describing inherently distinctive marks); *MasterCard Int'l Inc. v. Nader* 2000 Primary Comm. Inc., No. 00 Civ. 6068 (GBD), 2004 U.S. Dist. LEXIS 3644, at *7 (S.D.N.Y. Mar. 8, 2004).

⁷⁵ See *Wal-Mart*, 529 U.S. at 212.

⁷⁶ See *id.* at 213; *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–63 (1995) (emphasis in original).

⁷⁷ See *Wal-Mart*, 529 U.S. at 212; *In re Gen. Electric Broad. Co.*, 199 U.S.P.Q. (BNA) 560, 563 (T.T.A.B. 1978) (distinguishing inherently distinctive sounds from those requiring proof of acquired distinctiveness).

⁷⁸ See *Wal-Mart*, 529 U.S. at 213; *Qualitex*, 514 U.S. at 162–63; *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 (1982).

a product source, as opposed to describing a product, product feature, or geographic origin, the mark is not distinctive.⁷⁹

The Supreme Court has stressed that without inherent distinctiveness or secondary meaning, there can be no trademark.⁸⁰ For example, in *Wal-Mart v. Samara Brothers*, Wal-Mart produced “knock-offs” of the clothing designed and manufactured by Samara Brothers.⁸¹ Samara Brothers asserted that Wal-Mart’s knock-offs infringed on their trade dress.⁸² The case turned on whether product-design trade dress could be inherently distinctive so as to function as a trademark. The Court concluded that unless the clothing designs had taken on some secondary meaning⁸³ transcending their nature as clothes and becoming a “mark” designating their manufacturer, they could not be trademarks.⁸⁴ The Court also explained that trademark’s “carefully considered limitation would be entirely pointless” if an “original” producer such as Samara Brothers were permitted to raise this type of reverse-passing-off claim.⁸⁵

With regard to an aural identifier or sound mark, a sound that becomes so distinctive that consumers associate it with a source or brand (such as NBC’s chimes) can possess secondary meaning, and can thus be trademarked.⁸⁶ By contrast, a sound that a product makes in its normal course of operation, such as the beep of a cell phone, or is heard in another context cannot possess secondary meaning and cannot be trademarked.⁸⁷

⁷⁹ See *Wal-Mart*, 529 U.S. at 213.

⁸⁰ See *id.* at 212. (noting that only “over time” could color, for example, come to be seen as signifying a brand).

⁸¹ *Id.* at 207–08.

⁸² *Id.* at 208–09.

⁸³ *Id.* at 211.

⁸⁴ *Id.* at 216.

⁸⁵ This would create a conundrum where a trademark owner who was not identified could raise an infringement claim, but if it was accurately identified, it could raise a false endorsement claim.

⁸⁶ See *Bumpus*, *supra* note 66, at 246; see also *In re Gen. Electric Broad. Co.*, 199 U.S.P.Q. (BNA) 560, 563 (T.T.A.B. 1978) (where the PTO explained that “a sound mark depends upon aural perception of the listener . . . [so] when heard [it is] associated with the source or event”)

⁸⁷ See *In re Vertex Grp.*, 89 U.S.P.Q.2d (BNA) 1694,1699; *Bumpus*, *supra* note 66, at 246–47.

IV. CONSTRUCTING A THEORY OF SONG MARK PROTECTION

A. *Music as an Entertainment Service or Brand Quality*

The threshold issue in a singer aural trademark claim is whether a song can be registered as a trademark designating the vocal performer.⁸⁸ If it cannot be, then there is no protectable trademark, and there can be no trademark infringement.⁸⁹ Although courts have not addressed song mark claims in politics, a few have considered song-based trademark claims in commercial contexts.⁹⁰ This jurisprudence is a necessary starting point.

A trademark cannot exist in the abstract, but obtains meaning only in relation to that which that it designates.⁹¹ Therefore, before there can be a trademark, there must be a service or business to mark.⁹² To illustrate, a few years after Cab Calloway's death, Christopher Brooks formed "The Cab Calloway Orchestra" which honored Calloway's musical legacy by performing vintage Calloway songs using their original arrangements.⁹³ Calloway's relatives sued Brooks, alleging that his use of "Cab Calloway" constituted trademark infringement.⁹⁴

The Second Circuit explained that "a trademark is merely a symbol of goodwill and cannot be sold or assigned apart from the goodwill it symbolizes."⁹⁵ Because goodwill is inseparable from the underlying business that it denotes, trademark rights cannot be transferred apart from an ongoing business.⁹⁶ Though "entertainment" services could be indicated by a service mark, at

⁸⁸ See *Leelanau Wine Cellars, Ltd. v. Black & Red, Inc.*, 502 F.3d 504, 513 (6th Cir. 2007) (noting that registration of a trademark creates a rebuttable presumption of validity).

⁸⁹ See *id.* at 512–13; *Tumblebus Inc. v. Cranmer*, 399 F.3d 754, 760–61 (6th Cir. 2005).

⁹⁰ See *G.M.L., Inc. v. Mayhew*, 188 F. Supp. 2d 891, 895 (M.D. Tenn. 2002).

⁹¹ See *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmuplos Inc.*, 228 F.3d 56, 62 (2d Cir. 2000).

⁹² See *Bumpus*, *supra* note 66, at 251.

⁹³ *Creative Arts by Calloway v. Brooks*, 48 F. App'x. 16, 17 (2d Cir. 2002).

⁹⁴ *Id.* at 17.

⁹⁵ *Id.* at 17–18.

⁹⁶ See *id.*; *Marshak v. Green*, 746 F.2d 927, 929 (2d Cir. 1984) ("There are no rights in a trademark apart from the business with which the mark has been associated; they are inseparable.").

the time of his death, Calloway was not operating as such.⁹⁷ As a result, there was no entertainment service to mark, and, thus, no trademark in “Cab Callaway” to transfer.⁹⁸ Consequently, there was no trademark on which to infringe.⁹⁹

Other courts, however, have permitted the names of musical groups to be transferred by contract and trademarked.¹⁰⁰ Indeed, both musical groups ABBA and New Edition have prevailed in actions to trademark their names.¹⁰¹ In the latter, New Edition’s former manager attempted to reconstitute a new version of the singing group under the name “New Edition.”¹⁰² The original members of the group objected, claiming that they owned the mark “New Edition.”¹⁰³ Because neither could assert senior ownership of the mark, ownership rested on ascertaining what audiences understood “New Edition” to designate and determining who controlled those qualities.¹⁰⁴ The court found that “New Edition” stood for “first and foremost the [unique combination of singers] with their distinctive personalities and style as performers.”¹⁰⁵ Because the original members controlled those characteristics, the court awarded them ownership of the trademark.¹⁰⁶

⁹⁷ *Calloway*, 48 Fed. Appx. at 17–18.

⁹⁸ *Id.*

⁹⁹ *Id.* at 18.

¹⁰⁰ A band name is sometimes deemed a service mark because it promotes entertainment services. *See* *Smith v. Montoro*, 648 F.2d 602, 605 (9th Cir. 1981) (“Entertainment” may be considered a service in connection with the law of service marks); *McGufey*, *supra* note 55, at 170; *see also* *Crystal Entm’t & Filmworks v. Jurado*, 643 F.3d 1313, 1321 (11th Cir. 2011) (discussing ownership of and trademark rights associated with the singing group Exposé); *In re Polar Music Int’l AB*, 714 F.2d 1567, 1571 (Fed. Cir. 1983); 2 MCCARTHY, *supra* note 59, at § 16:45. The mark or name designates both a service as well as the particular combination of performers that cannot otherwise be expressed. *See* Matthew D. Bunker, *You Can’t Handle the Truth (in Music): Does the Lanham Act Preempt State “Truth in Music” Laws?*, 16 COMM. L. & POL’Y 1, 12–13 (2011).

¹⁰¹ *See* *Polar Music*, 714 F.2d at 1571–72 (the corporate entity submitted a license evidencing its right to control the quality of the musical group’s sound recordings, thereby demonstrating that it controlled the quality of the sound recordings); *Bell v. Streetwise Records, Ltd.*, 640 F. Supp. 575, 580–82 (D. Mass. 1986).

¹⁰² *Bell*, 640 F. Supp. at 581.

¹⁰³ *Id.* at 580–81.

¹⁰⁴ *Id.*

¹⁰⁵ *Id.* at 581–82.

¹⁰⁶ *Id.* at 580–82; *see also* *Crystal Entm’t & Filmworks v. Jurado*, 643 F.3d 1313, 1322–23 (11th Cir. 2011) (the entity claiming ownership of the trademark Exposé failed to

Applying this to a song mark, to the extent that a performer provides entertainment services, she could designate those services by a trademark. That mark, however, would designate only the commercial musical or vocal services. It would not be a personal alias equivalent to the performer independent of those services,¹⁰⁷ and the performer would not own the song or have an exclusive right to use it as a mark in connection with other services.¹⁰⁸

B. *The “Mark” of a Song Mark*

Next, that which is proffered as the song mark must be among the words, sounds, or combination thereof that can be registered as a mark. The theory of a song mark is that the sound of a singer’s voice performing the musical composition and captured in a sound recording functions as a mark designating the performer.¹⁰⁹ The proposed song mark, therefore, is a hybrid of: the foundational musical composition, the singer’s vocal performance of it, the instrumental performances; and the sound recording containing these, as mixed by the producer. Each of these elements is discussed below.

C. *Voice or Vocal Performance*

With regard to whether voice can be a signifier, it could be thought of as a sound. As noted, distinctive sounds and aural signifiers able to evoke a source or service can be registered as sound marks.¹¹⁰ A few California courts have protected a distinctive human voice as a trademark where it is a widely known

prove control over the singing group’s qualities, scheduling of performances, and management); *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 304 (9th Cir. 1992).

¹⁰⁷ See *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 922–23 (6th Cir. 2003) (rejecting Tiger Woods’ claim that he, as a person, can be trademarked); *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 582–84 (2d Cir. 1990) (noting that Babe Ruth pictures are not entitled to trademark protection unless they serve an “origin-indicating function”).

¹⁰⁸ See *Gameologist Grp., LLC v. Sci. Games Int’l, Inc.*, 838 F. Supp. 2d 141,153 (S.D.N.Y. 2011) (finding that rights to a trademark extend only to the goods and services noted in a registration certificate).

¹⁰⁹ See *Bumpus*, *supra* note 66, at 262.

¹¹⁰ See *In re Vertex Grp.*, 89 U.S.P.Q.2d (BNA) 1694, 1699 (T.T.A.B. 2009); *In re Gen. Elec. Broad. Co.*, 199 U.S.P.Q. (BNA) 560, 563 (T.T.A.B. 1978) (sound must be distinctive and evoke in consumers an association with the business); *Bumpus*, *supra* note 66, at 246.

indicator of the vocalist's identity.¹¹¹ Indeed, both Tom Waits and Bette Midler have prevailed in actions to protect their voices as unregistered commercial trademarks of their respective vocal identities.¹¹²

The Third Circuit has also embraced the notion that voice could indicate the services of a person famous for voice work.¹¹³ During his storied career, sports announcer John Facenda narrated a number of NFL Films productions.¹¹⁴ Facenda's deep baritone had been described as "distinctive," "recognizable," and known by many football fans as "the Voice of God."¹¹⁵ Years after his death, NFL Films used portions of his voice-overs in a television documentary entitled "The Making of Madden NFL 06."¹¹⁶ Facenda's Estate sued NFL Films for trademark infringement, claiming that using "sound samples" of Facenda's voice falsely implied that Facenda endorsed the video game.¹¹⁷ For purposes of ruling on the NFL's motion to dismiss, the court treated Facenda's voice as a trademark.¹¹⁸

It is important to keep in mind that these decisions did not grant the performer a trademark in a song, but allowed an established commercial service to be marked with a distinctive sound (voice) recognized by the public as designating that

¹¹¹ See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1102 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460, 462–63 (9th Cir. 1988) (if voice is sufficient indicia of a celebrity's identity, it can be an unregistered trademark); see also *Facenda v. NFL Films*, 542 F.3d 1007, 1018 (3d Cir. 2008) (upholding a trademark claim because Facenda's voice was considered a distinctive mark); David Tan, *Much Ado About Evocation: A Cultural Analysis of "Well-Knownness" and the Right of Publicity*, 28 *CARDOZO ARTS & ENT. L.J.* 317, 330–31 (2010).

¹¹² *Waits*, 978 F.2d at 1110 ("A false endorsement claim based on the unauthorized use of a celebrity's identity is a type of false association claim, for it alleges the misuse of a trademark, i.e., a symbol or device such as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic . . ."); *Midler*, 849 F.2d at 463–64.

¹¹³ *Facenda*, 542 F.3d at 1013.

¹¹⁴ *Id.* at 1011.

¹¹⁵ *Id.* at 1011–12. In fact, NFL Films had released works featuring what it called "the Legendary Voice of John Facenda." *Id.* at 1012.

¹¹⁶ *Id.* at 1011.

¹¹⁷ *Id.* at 1011, 1014. The NFL asserted that its copyright in the original NFL Films productions gave it the right to use the soundtracks of those productions in any way they wished. *Id.* at 1013.

¹¹⁸ *Id.* at 1014.

performer's services. Furthermore, although a unique voice like Facenda's or Waits's, recognizable independent of context or the foundational copyrighted work, can serve as a mark, it does not mean that most voices can. These plaintiffs were well-known vocal performers¹¹⁹ with unique vocal qualities. Yet, with "Autotune" and contemporary production techniques, today's singers are often indistinguishable or recognized in relation to a record rather than due to some unusual vocal quality. Therefore, voice alone is not presumptively distinct, and even when it is, that does not prove audience recognition.¹²⁰ Furthermore, the concept of identity is not boundless. Even courts that construe identity broadly require that it be used conspicuously, either by directly using the trademarked name or image or by emphasizing its iconic symbols.¹²¹ It is questionable whether merely including a singer's voice or playing a record meets this standard of a conspicuous use of the *performer's* identity.¹²²

D. The Musical Composition and Sound Recording

A song mark is more than the sound of a distinctive, recognizable voice—it also includes the vocal performance of the copyrighted musical work, the instrumental performances, mixing and production techniques, and the resulting sound recording.¹²³

A musical composition or record might be likened to a long jingle. Courts have acknowledged that a musical "jingle" can

¹¹⁹ See Tan, *supra* note 111 at 341–43, 349, (asserting that a celebrity must establish "well-known-ness" by a substantial portion of the public).

¹²⁰ See *White v. Samsung*, 989 F.2d 1512, 1516 (9th Cir. 1993) (Kozinski, J., dissenting) (claims are often made by people with an exaggerated sense of their fame and pop culture significance).

¹²¹ See *Fortres Grand Corp. v. Warner Bros. Entm't*, No. 3:12-cv-535, 2013 WL 2156318, at *10 (N.D. Ind. May 16, 2013) ("[T]he defendant's work must make some affirmative statement of the plaintiff's sponsorship or endorsement, beyond the mere use of plaintiff's name or other characteristic"); *Arenas v. Shed Media*, 881 F. Supp. 2d 1181, 1189 (C.D. Cal. 2011); see also *Dillinger, LLC v. Elec. Arts, Inc.*, 795 F. Supp. 2d 829, 838 (S.D. Ind. 2011).

¹²² See *Laws v. Sony Music Entm't*, 448 F.3d 1134, 1139 (9th Cir. 2006) (noting that the mere use of the record including her voice would not, alone, amount to use of identity).

¹²³ See *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 61 (2d Cir. 2011).

function as a brand identifier or trademark.¹²⁴ Therefore, if a vocal sound and a jingle can each be trademarked, then, perhaps, a singer's vocal sound heard in a sound recording (essentially a long jingle) could be combined and trademarked as a song mark.

This proposition, however, rests on the premise that a musical composition or sound recording is nothing more than a mere jingle. This draws a false equivalency. Although virtually every jingle is a musical composition, most musical compositions are not jingles. A jingle is limited, not only in length, but also in its character and purpose.¹²⁵ At its inception, a jingle is conceived to be an aural logo of a brand,¹²⁶ and nothing more. There is no intent to sell it on iTunes or remix it as a dance recording. Instead, a jingle is used in a brand's advertisements to evoke a commercial impression.¹²⁷ Once cultivated, it is understood by consumers to function exclusively in this way.

A musical work possesses an entirely different character, and does not alone produce a commercial impression.¹²⁸ Songs and sound recordings are not intended as aural means to connote brand qualities. Rather, music is a creative expression and an end product—it is meant to be heard, enjoyed, critiqued, and purchased as music.¹²⁹ Audiences listen to music to mend broken hearts, celebrate, unwind, or energize a workout, not to differentiate among commercial sources. When viewers hear a Lady Gaga song during The Weather Channel's "Local on the 8s," they do not

¹²⁴ See *id.*; *Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 761 (D.N.J. 2011) (noting that college "fight songs" are licensed pursuant to trademark); *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1167–68 (C.D. Cal. 2010) (analyzing jurisprudence and concluding that musical compositions are generally worthy of trademark protection, as they could become associated with a particular product); *G.M.L. v. Mayhew*, 188 F. Supp. 2d 891, 893 (M.D. Tenn. 2002).

¹²⁵ See *Henley*, 733 F. Supp. at 1151.

¹²⁶ See *G.M.L.*, 188 F. Supp. at 896.

¹²⁷ See *id.* at 895.

¹²⁸ See *id.* at 896; see also *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmuplos Inc.*, 228 F.3d 56, 64 (2d Cir. 2000) (noting that musical composition cannot be a trademark for itself).

¹²⁹ See *EMI*, 228 F.3d at 64 (noting that a musical composition cannot serve as a trademark because it is copyrighted musical work); *G.M.L.*, 188 F. Supp. at 896 (explaining that a musical composition or sound recording is not a designation of source but a good itself).

presume that the song designates winter weather, is a jingle of the network, or represents Lady Gaga's endorsement of either.¹³⁰

E. Performance of a Musical Work

Because audiences understand a song as a creative work rather than as a commercial signifier, a song cannot signify itself.¹³¹ The only function it could have would be to signify itself as music.¹³² This is consistent with how courts have interpreted trademark claims involving music. In rejecting such claims by singers, courts have held that a "signature performance" cannot create a trademark.¹³³

The first in this line of cases involved the 1960s hit song "The Girl from Ipanema."¹³⁴ In 1964, singer Astrud Gilberto recorded "The Girl from Ipanema."¹³⁵ It launched her career, won her a Grammy Award, and became a signature song that she performed frequently thereafter.¹³⁶ Decades later, Frito-Lay licensed the record from the copyright owner and used it in a television advertisement.¹³⁷ Gilberto, however, claimed that her frequent performances of "The Girl from Ipanema" had caused the public to

¹³⁰ ¹³⁰ Furthermore, usually any meaning a listener assigns to a song is derived from its lyrics (as Regan did). The lyrics are the literal message of the creative work, not secondary to it.

¹³¹ See *EMI*, 228 F.3d at 64 ("[A] musical composition cannot be protected as its own trademark under the Lanham Act . . . cases involving trademark infringement should be those alleging the appropriation of symbols or devices that identify the composition or its source, not the appropriation or copying or imitation of the composition itself.").

¹³² See *id.*; *G.M.L.*, 188 F. Supp. at 896.

¹³³ See *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 62–63 (2d Cir. 2011) (indicating that a performance does not give singer rights in the recording of "signature performances"); *L.A. Triumph, Inc. v. Ciccone*, No. CV 10-06195 SJO (JCx), 2011 U.S. Dist. LEXIS 132057, at *7 (C.D. Cal. Aug. 31, 2011) (noting that the performance of a song does not bestow on the performer a trademark); *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1167–68 (C.D. Cal. 2010) (highlighting that a performer cannot possess a trademark in a performance of a musical composition); *Butler v. Target Corp.*, 323 F. Supp. 2d 1052, 1059 (C.D. Cal. 2004) (explaining that performing artists cannot possess a trademark in a performance of song).

¹³⁴ *Oliveira*, 251 F.3d at 59.

¹³⁵ *Id.*

¹³⁶ *Id.*

¹³⁷ *Id.* at 58–59.

identify her with the song, making it her trademark.¹³⁸ She thus claimed that Frito Lay's use infringed on her trademark and was likely to deceive consumers about her affiliation with the Frito-Lay brand or her approval of its products.¹³⁹

Although the Second Circuit accepted the proposition that a jingle could be a trademark,¹⁴⁰ it rejected Gilberto's contention that a performance of a composition could mature into an unregistered trademark.¹⁴¹ Instead, it held that the performance of a musical composition could not serve as a trademark *for itself*, so Gilberto could not possess a trademark of the song.¹⁴² Speaking to the issue of song-based trademarks more broadly, the court warned that granting a song the status of trademark would give performers a previously unknown right that would alter the commercial world's understanding of the scope of trademark and profoundly disrupt commerce.¹⁴³ Indeed, it would enable performers and copyright authors to license works and then turn around and sue licensees for trademark infringement.¹⁴⁴

Other courts have concurred that the performance of a song cannot be leveraged into a singer trademark.¹⁴⁵ A few years ago,

¹³⁸ *Id.* Indeed, she asserted that the public thought of her *as* the girl from Ipanema. *Id.* at 59.

¹³⁹ *Id.* at 57–58.

¹⁴⁰ *Id.* at 61.

¹⁴¹ *Id.* at 62–63.

¹⁴² *Id.* at 62; *see also* *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 712 (9th Cir. 1970) (rejecting singer Nancy Sinatra's claim that the song had been so popularized by her, "that her name is identified with it" and it had acquired a secondary meaning). In *Oliveira*, the court added that no reasonable fact-finder could find that the audience would believe the song constituted an endorsement by her. *Oliveira*, 251 F.3d at 60.

¹⁴³ *Oliveira*, 251 F.3d at 62–63. As the *EMI* court noted:

Concluding that a song can serve as an identifying mark of the song itself would stretch the definition of trademark—and the protection afforded under § 43(a)—too far and give trademark law a role in protecting the very essence of the song, an unwarranted extension into an area already protected by copyright law.

EMI Catalogue P'Ship v. Hill, Holliday, Connors, Cosmuplos Inc., 228 F.3d 56, 64 (2d Cir. 2000).

¹⁴⁴ *See Oliveira*, 251 F.3d at 63.

¹⁴⁵ *See* *L.A. Triumph, Inc. v. Ciccone*, No. CV 10-06195 SJO (JCx), 2011 U.S. Dist. LEXIS 132057, at *7 (C.D. Cal. Aug. 31, 2011); *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1167–68 (C.D. Cal. 2010); *Butler v. Target Corp.*, 323 F. Supp. 2d 1052, 1059 (C.D. Cal. 2004).

Madonna sought to trademark “Material Girl” to identify her women’s clothing line.¹⁴⁶ Another women’s clothing manufacturer that previously had used “Material Girl” as its trademark, objected to her registration.¹⁴⁷ Madonna moved to dismiss, asserting that she was the senior owner of the trademark “Material Girl,”¹⁴⁸ by virtue of having performed and been in the video of the song “Material Girl” in the 1980s.¹⁴⁹ In denying the motion, the court explained that since a singer cannot create a trademark by performing a song,¹⁵⁰ Madonna could not have earned the trademark “Material Girl” by singing it.¹⁵¹

The result is no different when the performer also authors the copyrighted composition on which the trademark is based—copyright might be implicated, but trademark is not. For example, Digable Planets accused Target of copyright and trademark infringement for using the lyrics and sound recording of its signature song “Rebirth of Slick (Cool like Dat)”¹⁵² in a print, in-store ad campaign.¹⁵³ Although the court permitted Digable Planets’ copyright infringement claim based on the use of the alteration of the song’s lyrics, it dismissed the trademark claim, stating that a trademark cannot arise from a performance.¹⁵⁴

Singer-songwriter Don Henley was similarly rebuffed when he complained that his music was used in political ads of a candidate

¹⁴⁶ *Ciccone*, 2011 U.S. Dist. LEXIS 132057, at *6–7.

¹⁴⁷ *Id.* (the “first to use a mark is deemed the ‘senior’ user and has the right to enjoin ‘junior’ users from using confusingly similar marks in the same industry and market . . .”) (quoting *Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1047 (9th Cir. 1999)). In *Ciccone*, the manufacturer had used the name “Material Girl” under a California trademark that had expired. *Id.* at *2.

¹⁴⁸ *Id.* at *6–7.

¹⁴⁹ *Id.*; *cf.* *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 712 (9th Cir. 1970) (Sinatra claimed that because she popularized a song, her name was identified with it).

¹⁵⁰ Because Madonna could not have owned the trademark from her musical performance, she could not prove that she was the owner or senior user of the mark “Material Girl,” over the clothing manufacturer. *Ciccone*, 2011 U.S. Dist. LEXIS 132057, at *6–7.

¹⁵¹ *Id.* at *7.

¹⁵² *Butler v. Target Corp.*, 323 F. Supp. 2d 1052, 1054 (C.D. Cal. 2004).

¹⁵³ *Id.* at 1059. The advertising campaign featured altered versions of the song with slogans such as “Jeans Like That,” “Denim Like That,” and “Shoes Like That.” *Id.* at 1054.

¹⁵⁴ *Id.* at 1059–60.

he did not support.¹⁵⁵ There, Republican candidate Charles Devore¹⁵⁶ had seen an Obama sticker on a Toyota Prius, which reminded him of the “DEADHEAD sticker on a Cadillac” lyric in Henley’s “Boys of Summer.”¹⁵⁷ This inspired Devore to write a campaign song entitled “The Hope of November.” “The Hope of November” followed the melody of “The Boys of Summer” but made fun of Barack Obama and Nancy Pelosi.¹⁵⁸ Next, DeVore wrote “All She Wants to Do is Tax” which used the melody of “All She Wants to Do Is Dance” but inserted lyrics criticizing Barbara Boxer.¹⁵⁹ DeVore’s campaign team then recorded the new lyrics to karaoke tracks of the Henley songs and used their new versions in two campaign ads and YouTube videos.¹⁶⁰

Henley, the singer and copyright owner of the tunes, sued DeVore for both copyright and trademark infringement.¹⁶¹ The court permitted his copyright claims, but dismissed his trademark claims.¹⁶² It explained that since a performance of a copyrighted work cannot vest in a performer a trademark, the unauthorized use of a copyrighted work could not violate any trademark of the performer.¹⁶³ The court added that since it was clear that Henley was not singing the song, the public would not have mistakenly believed that he was associated with the candidate.¹⁶⁴

F. *Can a Song Attain Secondary Meaning?*

In rejecting song trademark claims, courts have explained that a musical composition or sound recording cannot be a trademark of itself.¹⁶⁵ That a performance of a song cannot function as a trademark indicating the song, however, does not foreclose the possibility that it could function as a trademark *indicating something else*. After all, a jingle does not designate its musical

¹⁵⁵ Henley v. DeVore, 733 F. Supp. 2d 1144, 1169 (C.D. Cal. 2010).

¹⁵⁶ DeVore was a California Assembly member at the time. *Id.* at 1148.

¹⁵⁷ *Id.*

¹⁵⁸ *Id.*

¹⁵⁹ *Id.* at 1149.

¹⁶⁰ *Id.*

¹⁶¹ *Id.*

¹⁶² *Id.* at 1169.

¹⁶³ *Id.* at 1167.

¹⁶⁴ *Id.* at 1168.

¹⁶⁵ *See generally* Oliveira v. Frito-Lay, Inc., 251 F.3d 56 (2d Cir. 2011).

notes or singer, but the commercial entity, service, or brand with which it is associated.¹⁶⁶ Obviously, a vocalist asserting a song mark is not claiming that her performance included in the sound recording designates the song, but that it denotes *her* as a singer. Therefore, just as a jingle indicates a brand, the song mark plus her voice would be a jingle indicating the singer.

To function in this way, the song would need to transcend the creative work and achieve secondary meaning.¹⁶⁷ In other words, when the audience heard the song, it must automatically think of the singer's entertainment services, not the music or lyrics of the creative work. For a number of reasons, it is doubtful that a song can shed its inherent nature as a creative work and acquire an unrelated secondary meaning.

First, a sound that a product makes in the normal course of its operation or to which listeners have been exposed under different circumstances lacks inherent distinctiveness, so cannot be trademarked.¹⁶⁸ Because a singer (albeit through voice) performs the notes and lyrics that the composition tells it to, or that the producer has mixed into the sound recording, the voice is merely making the sounds "made" in the normal course of performing the composition or playing the record. It, therefore, has no secondary meaning.¹⁶⁹ In fact, if the song *could* be used as a commercial indicator, it is more reasonable that it would inure to either the composer who wrote and licensed it or the record company that produced and marketed the recording.

Second, any more precise meaning that a song has to listeners is based on its lyrics. Yet, this is literally the meaning of or communicated by the creative work, not distinct from it. For example, it was the up-tempo chorus of "Born in the USA" that caused President Regan to conclude that the song celebrated being

¹⁶⁶ See *supra* note 126.

¹⁶⁷ See Bumpus, *supra* note 66, at 246; Port, *supra* note 69, at 47.

¹⁶⁸ See *Nextel Commc'ns., Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d 1393, 1404 (T.T.A.B. 2009) (asserting that the "chirp" of cell phone cannot be trademarked because it is a sound in the normal course of the product's operation); *In Re Gen. Elec. Broad. Co.*, 199 U.S.P.Q. (BNA) 560, 563 (T.T.A.B. 1978).

¹⁶⁹ Additionally, listeners would initially become familiar with the song in something other than a commercial context, such as a song on the radio or iTunes.

an American, and to use it to underscore his pro-USA point.¹⁷⁰ In a similar vein, when Michelle Bachmann appeared on *Late Night with Jimmy Fallon*, The Roots played “Lyn’ Ass Bitch” as her introduction.¹⁷¹ Listeners who recognized the song deduced that the band was communicating its negative opinion of Bachmann.¹⁷² In fact, Bachmann supporters complained and the show later apologized for the song choice due to its title and lyrics. Additionally, any message was imputed to The Roots who played the song, not its original singer.¹⁷³ Again, that meaning is not secondary to or different from the lyrics, but a literal translation.¹⁷⁴

Finally, even if the song achieved secondary meaning, the public would not necessarily presume that it designated the commercial services of the vocalist. If the song became popular in conjunction with a brand advertisement, movie, or fictional product in a television show,¹⁷⁵ the audience would associate it with those. Indeed, this is how a jingle operates. For example, the song “Bad Things to You” is known as the theme song to HBO’s show *True Blood*. If *True Blood* fans hear “Bad Things to You,” it is far more likely that they would think of the TV show than singer Jace Everret’s entertainment services. As such, the song’s secondary meaning would be the musical identifier of *True Blood*.

¹⁷⁰ See Frazier, *supra* note 12.

¹⁷¹ See Russell Goldman, *Jimmy Fallon Drummer Calls Bachmann ‘Bitch’ Song ‘Tongue in Cheek’*, ABC NEWS (Nov. 22, 2011, 4:37 PM), <http://abcnews.go.com/blogs/politics/2011/11/jimmy-fallons-drummer-grounded-for-bachmanns-bitch-song>.

¹⁷² See *id.* This was an easy presumption considering that Questlove’s Twitter avatar was a photo of him hugging President Obama.

¹⁷³ See *id.*

¹⁷⁴ It follows that when an audience at a Michele Bachmann campaign event hears “American Girl,” it simply enjoys the song or relates its lyrics to Bachmann as “an American girl,” rather than deducing that Tom Petty endorses Bachmann.

¹⁷⁵ For example, *Breaking Bad*’s Emmy-nominated episode included a brilliant, memorable montage to the 1969 song “Crystal Blue Persuasion.” Whereas college-aged fans of *Breaking Bad* associate the song with Heisenberg’s blue crystal meth, singer Tommy James understands the song to reflect his conversion to Christianity. Interview by Shawna Hansen Ortega with Tommy James (Sept. 15, 2009). Hence, the respective cohorts and context would impact the audience’s understanding of the song.

V. TRADEMARKS FOUNDED ON COPYRIGHTED WORKS

Assuming that a song mark could exist (and aside from any issue of preemption discussed below), it is doubtful that a trademark could be registered “on” another party’s copyrighted work.¹⁷⁶ As noted, a song mark is comprised of the copyrighted musical composition and the sound recording that mixes the vocal and instrumental performances. *Dastar* instructs that when a trademark is asserted over a copyrightable work, the copyrighted work is the base point for analysis.¹⁷⁷

Although the Copyright Act awards the copyright owner of the composition and, to a lesser extent, the sound recording the right to control its use, performance, and distribution, including whether to withhold it or make it available,¹⁷⁸ it does not give a performer any such rights; performing a copyrighted work pursuant to permission is not a mechanism to convert a third party’s copyrighted work into a trademark.¹⁷⁹ Hence, the actor does not earn a right in a movie by emoting in it, a singer does not realize a right in a song by singing it, and a musician does not obtain a right in a musical score by playing it. Rather, these performances are permitted only by copyright and, once captured in a tangible medium, are subsumed by copyright.¹⁸⁰ If it were otherwise, a song mark would enable a singer to control the composition, thereby extinguishing the rights granted by the Copyright Act.¹⁸¹ Accordingly, a vocalist

¹⁷⁶ Indeed, the Supreme Court has cautioned against over-extending trademark into areas traditionally occupied by copyright. *See Dastar Corp. v. Twentieth Century Fox*, 539 U.S. 23, 33–34 (2003); *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001).

¹⁷⁷ *Dastar*, 539 U.S. at 35 (“Without a copyrighted work as the basepoint, the word “origin” has no discernible limits.”). Much like a song mark that rests on a copyrighted work, the trademark infringement claim in *Dastar* was premised on a work whose copyright had expired.

¹⁷⁸ *See Vahdani, supra* note 24, at 77.

¹⁷⁹ *See generally Dastar*, 539 U.S. at 34; *TrafFix*, 532 U.S. at 29 (explaining that the Lanham Act should not be extended to cover areas that are traditionally the concern of copyright).

¹⁸⁰ *See Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 650–51 (Cal. Ct. App. 1996).

¹⁸¹ *See* 17 U.S.C. §§ 115, 119(b) (2010) (discussing compulsory licenses); 17 U.S.C. § 114(b) (2010).

trademark could not be premised on someone else's copyrighted work.¹⁸²

For example, in *Sinatra v. Goodyear Tire*,¹⁸³ singer Nancy Sinatra claimed that her hit single "These Boots Are Made for Walking" had taken on a secondary meaning, becoming hers.¹⁸⁴ Sinatra was disabused of this notion when she unsuccessfully sued Goodyear Tire for using the composition in an advertisement.¹⁸⁵ Goodyear licensed the composition from the copyright owners, had other performers cover it, and included the new version in a commercial.¹⁸⁶ Sinatra insisted that because it was her signature song, Goodyear could not use the composition without her permission. In rejecting her claim, the court explained that the song that made Sinatra famous was not hers, had never been hers, and gave her no rights.¹⁸⁷ Rather, she presumably had obtained permission from of the copyright owner to record it and had she wanted to prevent anyone else from ever using it so that she could cultivate secondary meaning, she could have purchased those rights.¹⁸⁸

The same is true of performances memorialized in other types of copyrighted media. In *Fleet v. CBS*, CBS purchased the exclusive rights to distribute a movie in which the plaintiff actors appeared.¹⁸⁹ The third party producers of the film, however, had failed to pay the actors' salaries.¹⁹⁰ Unable to obtain payment from the movie's producers, the actors sued CBS alleging that airing the film—which included their likenesses—violated their

¹⁸² See *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmuplos Inc.*, 228 F.3d 56, 64 (2d Cir. 2000). If a musical composition could be protected as its own trademark, any copyright claim for infringement of rights in a musical composition would be converted automatically into a Lanham Act cause of action. In theory, a singer might trademark a replicable sound or create a jingle to designate their entertainment services or other commercial pursuit, but the singer trademark could not co-opt a copyrighted work. See *id.*

¹⁸³ 435 F.2d 711 (9th Cir. 1970).

¹⁸⁴ *Id.* at 711–12.

¹⁸⁵ *Id.*

¹⁸⁶ *Id.* at 711.

¹⁸⁷ *Id.* at 716.

¹⁸⁸ *Id.*

¹⁸⁹ *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 645, 650–51 (Cal. Ct. App. 1996).

¹⁹⁰ *Id.* at 647.

right of publicity.¹⁹¹ In holding the claim preempted,¹⁹² the court observed that it was not merely the plaintiffs' likenesses that were captured on film, but their dramatic performances of the copyrighted work.¹⁹³ Once these were captured on film, "they became 'dramatic work[s]' 'fixed in [a] tangible medium of expression'"¹⁹⁴

Permitting a performer to wield a song trademark would create a "mutant species" of copyright.¹⁹⁵ Because copyrights have a limited life span,¹⁹⁶ but trademarks can be renewed,¹⁹⁷ an owner of a song mark would possess a perpetual monopoly over a copyrighted sound recording and composition. Yet, such a perpetual copyright is forbidden by the Copyright Act and is unconstitutional.¹⁹⁸ Additionally, there is evidence that Congress did not overlook the reputational interests of singers, but declined to protect them under Trademark law. For example, under the Visual Artists Rights Act (VARA),¹⁹⁹ an author of a work of visual art can prevent the use of her name as the creator of a work that she did not create or when her work has been modified in a way that "would be prejudicial to his or her honor or reputation."²⁰⁰ Congress did not extend this protection to performers and even VARA grants a relatively narrow right that does not give artists the power to guard against unwanted associations.²⁰¹ Additionally, §

¹⁹¹ *Id.*

¹⁹² *Id.* at 646.

¹⁹³ *Id.* at 651.

¹⁹⁴ *Id.* at 650 (alteration in original) (citation omitted).

¹⁹⁵ *Dastar Corp. v. Twentieth Century Fox*, 539 U.S. 23, 34 (2003). In *Oliveira v. Frito-Lay, Inc.* the court presumed that if there were a trademark in a song, it would be owned by the copyright owner. *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 63 (2d Cir. 2011) (explaining that the composer might license the use under copyright, and then turn around and sue under trademark).

¹⁹⁶ See *Dastar*, 539 U.S. at 33–35.

¹⁹⁷ See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164 (Fed. Cir. 2002).

¹⁹⁸ *Dastar*, 539 U.S. at 37. Further complicating the concept of a song mark is that it would be tied to the acts of third parties. Presumably, if a song was not played by a DJ or was a hit, it would not insinuate itself into the public's psyche and, thus, could not materialize into a protectable mark.

¹⁹⁹ 17 U.S.C. § 101 (2010).

²⁰⁰ See 17 U.S.C. § 106 (A)(a)(1), (2), (3)(A) (2002).

²⁰¹ See 17 U.S.C. § 106 (A). In fact, § 115 provides for a compulsory license for musical compositions: as long as the licensee complies with the statute, a copyright owner cannot prevent a third party from using or covering the copyrighted composition.

115 of the Copyright Act provides for a compulsory license for musical compositions—as long as the licensee complies with the statute, a copyright owner cannot prevent a third party from using or covering the copyrighted composition.²⁰² If the author or copyright owner of the composition cannot prevent someone from using the work pursuant to a compulsory license, it makes no sense that a mere performer of that work could be able to do so. Indeed, Dastar’s trademark infringement claim rested on a work whose copyright had expired. Nevertheless, the Court rejected it, because it would “cause[] the Lanham Act to conflict with the law of copyright.”²⁰³ If a trademark cannot be founded on an expired copyright work, a trademark cannot reasonably be erected on an existing copyrighted work.²⁰⁴

VI. TRADEMARK INFRINGEMENT

Assuming, *arguendo*, that a song mark can exist, a campaign’s using of the mark, that is, playing a song, without more, does not constitute infringement. Although the Lanham Act grants a trademark owner a number of exclusive rights, it does not grant her a right to control all uses of a mark.²⁰⁵ To the contrary, anyone may use a trademark or benefit from its goodwill if there is no secondary significance²⁰⁶ or commercial activity implicated.²⁰⁷

17 U.S.C. §§ 115, 114(b) (2010). If the author or copyright owner of the composition cannot prevent someone from using the work pursuant to a compulsory license, it makes no sense that a mere performer of that work could be able to do so.

²⁰² 17 U.S.C. §§ 115, 114(b).

²⁰³ Dastar Corp. v. Twentieth Century Fox, 539 U.S. 23, 33 (2003).

²⁰⁴ See *d.* at 34 (doing so would create a species of mutant copyright law that limits the public’s “federal right to ‘copy and to use,’ expired copyrights.”).

²⁰⁵ See *id.* (the Lanham Act grants a trademark owner a number of exclusive rights, but these rights are more circumscribed than those of copyright. Courts must not over-extend trademark into areas traditionally occupied by copyright); *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001).

²⁰⁶ See *Traffix*, 532 U.S. at 29; *Two Pesos Inc. v. Taco Cabana*, 505 U.S. 763, 767–68 (1992).

²⁰⁷ See *Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc.*, 326 F.3d 687, 695 (6th Cir. 2003) (trademark infringement does not apply when a trademark is used in a “non-trademark” way); *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 307 (9th Cir. 1992) (infringement laws “simply do not apply” to a “non-trademark use of a mark”); 4 LOUIS ALTMAN & MALLA POLLACK, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES, § 22:25 (4th ed. 2013) (noting that one who uses the

Additionally:

There is a distinction between the rights that flow from ownership, most notably the exclusive right to use the registered mark in commerce, and the remedies—including an owner’s right to enjoin another person’s use of a mark—that ripen only when there is . . . a likelihood of confusion.²⁰⁸

Thus, reflecting the semiotic and prophylactic functions of trademark, a trademark owner has a right to protect the accrued value of the mark and prevent the misperception that it sources, provides, is associated with, or sponsors a service or a product.²⁰⁹ Therefore, the use of a trademark infringes only if it misleads consumers into believing that the trademark owner manufactures, provides, sponsors, or is affiliated with the defendant’s service, business, or products.²¹⁰ Even then, trademark infringement protects against only mistaken consumer decisions or commercial matters,²¹¹ but not confusion generally.²¹²

A. *Types of Infringement*

Trademark infringement takes different forms. The most common type is when a competitor uses a trademark to palm off counterfeit goods or services,²¹³ thereby confusing consumers

trademarked product, but does not engage in commercial activities, is not a trademark infringer); *see also* *Fortres Grand Corp. v. Warner Bros. Entm’t*, No. 3:12-CV-535, 2013 WL 2156318, at *12 (N.D. Ind. May 16, 2013).

²⁰⁸ *What-A-Burger of Va., Inc. v. Whataburger, Inc. of Corpus Christi, Tex.*, 357 F.3d 441, 452 (4th Cir. 2004).

²⁰⁹ *See Two Pesos*, 505 U.S. at 773; *Crystal Entm’t & Filmworks v. Jurado*, 643 F.3d 1313, 1321 (11th Cir. 2011).

²¹⁰ *See Fortres Grand*, 2013 WL 2156318, at *6; *MasterCard Int’l Inc. v. Nader*, No. 00 Civ. 6068 (GBD), 2004 U.S. Dist. LEXIS 3644, at *10 (S.D.N.Y. Mar. 8, 2004).

²¹¹ *See Dastar Corp. v. Twentieth Century Fox*, 539 U.S. 23, 32–33 (2003); *Fortres Grand*, 2013 WL 2156318, at *6.

²¹² *See Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190, 1214 (9th Cir. 2012); *Fortres Grand*, 2013 WL 2156318, at *9; *MasterCard*, 2004 U.S. Dist. LEXIS 3644, at *10; *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 689 (N.D. Ohio 2002).

²¹³ *See Dastar*, 539 U.S. at 26 n.1 (palming off is when a producer misrepresents her goods or services as someone else’s; reverse passing off is when the producer misrepresents someone else’s goods or services as her own.)

regarding their source.²¹⁴ This type of infringement requires proof that consumers were actually confused.²¹⁵

A second type of infringement, pertinent here, is false endorsement.²¹⁶ Under § 1125(a)(1),²¹⁷ a trademark owner can bring an action for trademark infringement against:

[a]ny person who, on or in connection with any goods or services [. . .] uses in commerce any [trademark] that—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person²¹⁸

²¹⁴ See *Sports Auth., Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 960 (2d Cir. 1996); *Gameologist Grp. LLC v. Sci. Games Int'l, Inc.*, 838 F. Supp. 2d 141, 152 (S.D.N.Y. 2011). Classic trademark infringement involves “forward” confusion. Forward confusion occurs when a defendant attempts to capitalize on the trademark holder’s established reputation and good will by suggesting that its product or service emanates from the same source as, or is connected with, the trademark owner. See *Johnny Blastoff, Inc. v. L.A. Rams Football Co.*, 188 F.3d 427, 436 (7th Cir. 1999); *Fortres Grand*, 2013 WL 2156318, at *6, *10. Reverse confusion occurs when a more famous commercial entity uses its size and market penetration to overpower or usurp the mark of the smaller, less famous trademark holder. See *Custom Vehicles, Inc. v. Forest River, Inc.*, 476 F.3d 481, 484 (7th Cir. 2007).

²¹⁵ See 15 U.S.C. § 1114(1) (2005); 15 U.S.C. § 1125(a)(1)(A) (2012).

²¹⁶ False endorsement claims are less common. See *Facenda v. NFL Films*, 542 F.3d 1007, 1013, 1018–19 (3d Cir. 2008).

²¹⁷ Section 1125(a)(1) applies to unregistered marks, but § 1114 applies to registered marks:

Any person who shall, without the consent of the registrant use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered trademark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided.

15 U.S.C. § 1114(1) (2005).

²¹⁸ 15 U.S.C. § 1125(a)(1)(A) (2012); see also *Dastar*, 539 U.S. at 31 (explaining that “goods” are tangible products sold in the marketplace).

The touchstone of liability is whether the trademark is used in a “deceptive and misleading” way likely to cause consumer confusion about such association or endorsement.²¹⁹

False endorsement occurs when the defendant uses a trademark in a way that is *likely* to confuse or deceive the average consumer regarding a trademark owner’s affiliation, connection, or association with the defendant’s goods or services.²²⁰ This type of infringement does not require proof that consumers were actually confused, but only that they would *likely* be confused or deceived as to such association.²²¹

Although this is a lower threshold than actual confusion, it is nonetheless “a high bar.”²²² It demands more than simply referencing the trademark.²²³ Instead, the mark must be used in a way that makes an affirmative statement of the trademark owner’s sponsorship or endorsement.²²⁴ In fact, in the context of false endorsement, because using another’s trademark to extract parasitic value is seldom deceptive,²²⁵ it generally does not constitute false endorsement.²²⁶

²¹⁹ See *Dastar*, 539 U.S. at 28; see also *Crystal Entm’t & Filmworks v. Jurado*, 643 F.3d 1313, 1323 (11th Cir. 2011); *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 682, 689 (N.D. Ohio 2002).

²²⁰ See *Sports Auth., Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 960 (2d Cir. 1996); *Gameologist Grp. LLC v. Sci. Games Int’l, Inc.*, 838 F. Supp. 2d 141, 165 (S.D.N.Y. 2011).

²²¹ See *Facenda v. NFL Films*, 542 F.3d 1007, 1021 (3d Cir. 2008) (a party must show only likelihood of confusion); see also *Ray Commc’ns v. Clear Channel*, 673 F.3d 294 (4th Cir. 2012); *Am. Family Life Ins. Co.*, 266 F. Supp. at 690–91 (only subsection (a)(1)(A) of 15 U.S.C. § 1125 includes the phrase “likely to cause confusion”).

²²² *Fortres Grand Corp. v. Warner Bros. Entm’t*, No. 3:12-cv-535, 2013 WL 2156318, at *10 (N.D. Ind. May 16, 2013).

²²³ See *id.* at *16; see also *MasterCard Int’l Inc. v. Nader*, No. 00 Civ. 6068 (GBD), 2004 U.S. Dist. LEXIS 3644, at *10–11 (S.D.N.Y. 2004) (“‘one anecdotal instance of purported actual confusion is at best *de minimis*, indeed infinitesimal, and insufficient;’ a survey revealing a less than 3% rate of confusion was insufficient to show a likelihood of confusion.”) (quoting *Brockmeyer v. Hearst Corp.*, 248 F. Supp.2d 281, 298 (S.D.N.Y. 2003)); *Cumberland Packing Corp. v. Monsanto Co.*, 140 F. Supp.2d 241, 254 (E.D.N.Y. 2001) (a survey showing a 7.84% confusion rate found to be insufficient to raise a material fact as to the likelihood of confusion).

²²⁴ See *Fortres Grand*, 2013 WL 2156318, at *26 (“[T]his [is] a high bar.”)

²²⁵ See *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 691 (N.D. Ohio 2002).

²²⁶ Even where risk of confusion exists, some courts have concluded that such use that otherwise would violate the Lanham Act is not actionable unless (1) the mark has no

When a trademark is used in an advertisement for a product, however, a consumer might reasonably presume some connection or endorsement between the trademark and the product.²²⁷ Consequently, such uses may constitute infringement.²²⁸ For example, the Ninth Circuit allowed Tom Waits to assert an unregistered commercial trademark in his distinctive vocal attributes.²²⁹ After Waits refused Frito-Lay's endorsement offer, Frito-Lay used a sound-alike of him in an ad, and Waits sued Fritos for infringement.²³⁰ The court stated that because Waits' trademark (his voice) was featured in a product ad, it was reasonable that consumers would mistakenly think he was endorsing that product.²³¹ Accordingly, he was permitted to pursue his trademark infringement claim.²³²

By contrast, mentioning or displaying a trademark in a non-commercial context does not present the same potential for confusion,²³³ so it typically does not constitute infringement.²³⁴

artistic relevance to the underlying work whatsoever or, (2) it has some artistic relevance, but explicitly misleads as to the source or content of the work. *See* Univ. of Ala. Bd. of Trs. v. New Life Art Inc., 683 F.3d 1266, 1279 (11th Cir. 2012); E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1099 (9th Cir. 2008); Browne v. McCain, 611 F. Supp. 2d 1125, 1132 (C.D. Cal. 2009) (noting artistic relevance test). Essentially, if the use of a trademark is artistically relevant, then the use is either not infringing or will not be confusing, and thus is not infringement.

²²⁷ *See generally* State Auto Prop. & Cas. Ins. Co. v. Travelers Indem. Co. of Am., 343 F.3d 249, 257 (4th Cir. 2003) (trademarks serve as a primary instrument "in the advertisement and sale of the seller's goods").

²²⁸ *See* Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1106–07 (9th Cir. 1992); Arenas v. Shed Media, 881 F. Supp. 2d 1181, 1188 (C.D. Cal. 2011).

²²⁹ *Waits*, 978 F.2d at 1107.

²³⁰ *Id.* at 1106–07; *see also* Arenas, 881 F. Supp. at 1188.

²³¹ *Waits*, 978 F.2d at 1093, 1110–11.

²³² *Id.* at 1098, 1111; *see also* Abdul-Jabbar v. GMC, 85 F.3d 407, 410 (9th Cir. 1996) (false endorsement "based on the unauthorized use of a celebrity's identity" is actionable as trademark infringement).

²³³ *See* 1-800-Contacts, Inc. v. WhenY.com, Inc., 414 F.3d 400, 407 (2d Cir. 2005); Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc., 326 F.3d 687, 695 (6th Cir. 2003) (Lanham Act does not apply when using a trademark in a "non-trademark" way); New Kids on the Block v. News Am. Publ'g, 971 F.2d 302, 307 (9th Cir. 1992) (trademark infringement does not apply to a "non-trademark use of a mark"); Fortres Grand Corp. v. Warner Bros. Entm't, No. 3:12-cv-535, 2013 WL 2156318, at *7 (N.D. Ind. May 16, 2013); 4 ALTMAN & POLLACK, *supra* note 207, at § 22:25 (using the trademarked product, does not constitute infringement). Courts typically assess likelihood of confusion by weighing several factors, but these are largely inapt to false

For example, a plotline of the movie *The Dark Knight Rises* involves a computer program called “Clean Slate” that can erase one’s criminal history from every computer database in the world, thereby giving a person a clean slate.²³⁵ In reality, the Fortres Grand Corporation manufactures (and has trademarked in connection with) a software program called “Clean Slate” which protects the security of computer networks by erasing all evidence of user activity.²³⁶ Fortres Grand complained that by calling the fictional computer software “Clean Slate,” Warner Brothers (producers of *The Dark Knight Rises*) infringed on its trademark.²³⁷ The court rejected the claim.²³⁸ It explained that the film’s product was fictional, and “[t]here is no affirmative statement here that would indicate that Fortres Grand sponsored or endorsed the use of ‘clean slate’ in *The Dark Knight Rises*.”²³⁹ Therefore, the use of the trademarked name could not infringe on Fortres Grand’s trademark, and the public would not be misled.²⁴⁰

Rogers v. Grimaldi is further instructive.²⁴¹ There, a filmmaker made a movie “Ginger and Fred” about two fictional Italian dancers named Ginger and Fred.²⁴² Ginger Rogers complained that the movie’s title falsely implied that she was

endorsement claims of the sort addressed in this article. The Second Circuit weighs eight factors first established in *Polaroid*: (1) strength of the mark; (2) degree of similarity between the marks; (3) proximity of the products or services; (4) likelihood that the prior owner will bridge the gap into the newcomer’s product or service line; (5) evidence of actual confusion; (6) whether the defendant adopted the mark in good faith; (6) the quality of defendants’ products or services; and (8) sophistication of the parties’ consumers. *Polaroid Corp. v. Polaroid Elecs.*, 287 F.2d 492, 495 (2d Cir. 1961). The Ninth Circuit evaluates likelihood of confusion by considering: “(1) strength of the mark; (2) proximity or relatedness of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels; (6) type of goods and degree of purchaser care; (7) intent in selecting mark; and (8) likelihood of expansion.” *See Walter v. Mattel, Inc.*, 210 F.3d 1108, 1111 (9th Cir. 2000).

²³⁴ *See Univ. of Ala. Bd. Of Trs. v. New Life Art Inc.*, 683 F.3d 1266, 1278 (11th Cir. 2012); *see also Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

²³⁵ *Fortres Grand*, 2013 WL 2156318, at *3.

²³⁶ *Id.* at 2.

²³⁷ *Id.* at 7.

²³⁸ *Id.* at 22.

²³⁹ *Id.* at 26.

²⁴⁰ *Id.* at 22.

²⁴¹ *Rogers v. Grimaldi*, 875 F.2d 994, 994 (2d Cir. 1989).

²⁴² *Id.* at 996–97.

endorsing or featured in the film.²⁴³ The court disagreed, and concluded that any risk that the audience would be misled into thinking Rogers was associated with or endorsed the film was slight.²⁴⁴

This remains true when the physical or aural quality of a performer is integrated into a product or copyrighted work itself. For instance, singer Debra Laws complained when a J-Lo/L.L. Cool J song sampled (pursuant to a copyright license) a portion of a record she had recorded. Laws claimed that inasmuch as the new recording included her voice, it infringed on her vocal trademark.²⁴⁵ In dismissing her claim, the court stated that since her voice was not used in an ad or connected to a commercial service, its use did not imply that she was endorsing a product.²⁴⁶ In another case, a retired professional football player sued the *Madden NFL* video game for including his likeness.²⁴⁷ The court, held that “without more, [this was] insufficient to make the use explicitly misleading.”²⁴⁸

VII. USE IN COMMERCE

Finally, to constitute infringement under Federal law, the trademark must be used in commerce. Section 1125(a)(1) of the Lanham Act imposes liability on “[a]ny person who, on or in connection with any goods or services . . . *uses in commerce* any [trademark].”²⁴⁹ The definitional section of the statute states that:

²⁴³ *Id.* at 997.

²⁴⁴ *Id.* at 1000.

²⁴⁵ *Laws v. Sony Music Entm’t*, 448 F.3d 1134, 1140–41 (9th Cir. 2006).

²⁴⁶ *Id.*; *see also* *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1160–61 (C.D. Cal. 2010) (where there was no vocal impersonation, so consumers would not have believed that Henley had performed the campaign songs for or endorsed Devore.)

²⁴⁷ *Brown v. Elec. Arts, Inc.*, No. 2:09-cv-01598-FMC-RZx, 2009 U.S. Dist. LEXIS 131387, at *13 (C.D. Cal. Sept. 23, 2009).

²⁴⁸ *Id.* at *13.

²⁴⁹ 15 U.S.C. § 1125(a)(1) (2012) (emphasis added); *see also* *Dastar Corp. v. Twentieth Century Fox*, 539 U.S. 23, 31 (2003) (the Lanham Act’s reference to “goods” means “merchandise” or tangible products sold in the marketplace). Section 114 provides that

Any person who shall, without the consent of the registrant [] *use in commerce* any reproduction, counterfeit, copy, or colorable imitation of a registered trademark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in

For purposes of this chapter, a mark shall be deemed to be in use in commerce . . . (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.²⁵⁰

In the typical infringement case, a defendant uses a trademark to pass off its goods or services as being provided or sponsored by the trademark owner.²⁵¹ Because these situations inevitably involve commercial businesses, consumers in the marketplace, and product packaging or advertising, their commerciality is beyond cavil. Consequently, courts have had little occasion to look beyond the presence of the trademark itself and analyze the statute's "commerce" language.²⁵²

False endorsement cases of the political ilk, however, differ significantly from the typical scenario. A campaign's playing music to fire up a crowd, as the candidate's introduction theme, or while awaiting her arrival has no obvious commercial connotation. Arguably, music at public venues is so common that it imputes no special meaning. Even if donations are solicited or a song is included in a political advertisement to express a campaign message, no product is sold, no commercial service is rendered (or no service is rendered in commerce), and no business entity is involved. Therefore, the public performance, derivative use, or duplication of the copyrighted musical work might be implicated (as in *Butler* and *Henley*), but there is no reason for commercial enterprises or consumers making purchasing decisions to be confused. Rather, the context is political. Consequently, political

connection with which such use is likely to cause confusion, or to cause mistake, or to deceive [] shall be liable in a civil action by the registrant for the remedies hereinafter provided.

15 U.S.C. § 1114(1)(a) (2) (2005) (emphasis added).

²⁵⁰ 15 U.S.C. § 1127 (2006).

²⁵¹ See *Fortres Grand Corp. v. Warner Bros. Entm't*, No. 3:12-cv-535, 2013 WL 2156318, at *4 (N.D. Ind. May 16, 2013).

²⁵² See *Interspace Corp. v. Lapp, Inc.*, 721 F.2d 460, 462 (3d Cir. 1983).

campaigns have argued that their uses of trademarks either are altogether immune from the Lanham Act or, in practice, do not meet its “commerce” requirement.²⁵³

The meaning of the statute’s “commerce” language is, therefore, critical when analyzing the viability of a false endorsement claim, and even more so when considering potential infringement by political campaigns. This language, however, has been interpreted in different ways.²⁵⁴ Depending on the interpretation, a political campaign’s use may be wholly exempt from a trademark infringement claim, fail to meet the prima facie elements of infringement, or be infringing in only limited situations. Further complicating the issue is that some types of trademark infringement do not require a use in commerce. The Federal Trademark Dilution Act (FTDA) (§1125(c)) exempts all “noncommercial” uses of a mark.²⁵⁵ Therefore, a trademark owner claiming dilution²⁵⁶ under the FTDA does not need to show that the defendant used its mark in commerce.²⁵⁷

A. The Unauthorized Use of the Trademark Must Occur in Commerce

A number of courts read the “uses in commerce” language of § 1114(1)(a) and § 1125(a)(1)(A) (“any person who uses in commerce any trademark . . .”) in conjunction with § 1127’s

²⁵³ See *Browne v. McCain*, 611 F. Supp 2d 1125, 1131 (C.D. Cal. 2009).

²⁵⁴ See *id.* at 1131–32 (citing *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92–93 (2d Cir. 1997)).

²⁵⁵ 15 U.S.C. § 1125(c)(4) (2012) (“[T]he following shall not be actionable under this section: . . . (B) Noncommercial use of a mark”); see also *MasterCard Int’l Inc. v. Nader*, No. 00 Civ. 6068 (GBD), 2004 U.S. Dist. LEXIS 3644, at *25 (S.D.N.Y. 2004).

²⁵⁶ Dilution is “the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception.” 15 U.S.C. § 1127 (2006). The law governing dilution is independent from the law of trademark infringement. See *Autozone, Inc. v. Tandy Corp.*, 373 F.3d 786, 801 (6th Cir. 2004). “Dilution, unlike traditional trademark infringement law . . . is not based on a likelihood of confusion standard, but exists only to protect the quasi-property rights a holder has in maintaining the integrity and distinctiveness of his mark.” *Id.* (citing *Kellogg Co. v. Toucan Golf, Inc.*, 337 F.3d 616, 628 (6th Cir. 2003).)

²⁵⁷ See *Moseley v. Victoria’s Secret Catalogue, Inc.*, 537 U.S. 418, 433 (2003); *MasterCard*, 2004 U.S. Dist. LEXIS 3644, at *18–20.

definition of “use in commerce.”²⁵⁸ Specifically, these courts deem “use” and “in commerce” as separate elements of an infringement claim.²⁵⁹ Therefore, to establish a prima facie case of infringement, the trademark owner must show that the defendant “used” the mark in a particular way and must show that the use was in commerce.²⁶⁰ Consequently, only certain commercial uses of a mark constitute infringement.²⁶¹

This is consistent with both the plain language of § 1127²⁶² and its history. Section 1127 states that “use in commerce” means that the trademark is either physically placed on goods or services that the defendant sells or transports in commerce or is used in the sale or advertising of services that are rendered in commerce.²⁶³ If the defendant’s use in commerce were unnecessary for infringement, this statutory provision would be superfluous. Furthermore, as originally enacted, § 43(a) gave trademark owners a remedy against a person who used in commerce either “a false designation

²⁵⁸ 15 U.S.C. § 1127 (2006); *see also* *Browne v. McCain*, 611 F. Supp 2d 1125, 1131 (C.D. Cal. 2009) (citing *United We Stand America, Inc. v. United We Stand, America New York, Inc.*, 128 F.3d 86, 92–93 (2d Cir. 1997)); *MGM-Pathe Commns. Co. v. Pink Panther Patrol*, 774 F. Supp. 869, 876 (S.D.N.Y. 1991); Lisa P. Ramsey, *Brandjacking on Social Networks: Trademark Infringement by Impersonation of Markholders*, 58 BUFFALO L. REV. 851, 874–75 (2010).

²⁵⁹ *See, e.g.*, *1-800-Contacts, Inc. v. WhenY.com, Inc.*, 414 F.3d 492, 407 (2d Cir. 2005); *Time v. Peterson Publ’g Co.*, 173 F.3d 113, 117 (2d Cir. 1999); *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1508–09 (2d Cir. 1997).; *see also* Ramsey, *supra* note 258, at 874–75

²⁶⁰ *See 1-800- Contacts*, 414 F.3d at 412; *Time*, 173 F.3d at 117; *Estee Lauder Inc.*, 108 F.3d at 1508; Ramsey, *supra* note 258, at 874–75.

²⁶¹ *See* Ramsey, *supra* note 258, at 874.

²⁶² The Supreme Court employs a plain language approach when interpreting statutory provisions. *See, e.g.*, *Milner v. Dep’t of the Navy*, 131 S. Ct. 1259, 1264, 1266 (2011) (using plain meaning to interpret the term “personnel rules and practices” in Exemption 2 of the Freedom of Information Act); *CSX Transp. Inc. v. Ala. Dep’t of Revenue*, 131 S. Ct. 1101, 1108 (defining “tax” and “discriminate” according to their plain meaning).

²⁶³ 15 U.S.C. § 1127 (1)(B) (2006) (“[A] mark shall be deemed to be in use in commerce—(1) on goods when—(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce, and (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services”).

of origin, or any false description or representation” in connection with “any goods or services.”²⁶⁴ Hence, it is reasonable that trademark infringement requires the defendant to use the trademark in commerce.

B. A Trademark Must Be Used in Commerce to Earn Protection

A few commentators propose that “in commerce” pertains to the validity of the trademark itself.²⁶⁵ Under this view, since a putative trademark owner must demonstrate “the bona fide use of a mark in the ordinary course of trade” in order to protect a mark, § 1127 simply enumerates which acts suffice as “bona fide uses of a mark in the ordinary course of trade.”²⁶⁶ The infringing use, however, need not occur in commerce.²⁶⁷

This logic is questionable. That possession of a valid trademark requires its use in commerce does not mean that the allegedly infringing use need *not* be in commerce. In other words, a trademark owner may need to prove, first, that it used the mark in commerce in order to claim it as a protectable trademark, and then that the defendant used the trademark in commerce for it to constitute infringement. Indeed, since the Lanham Act is concerned with consumer confusion and unfair commercial competition due to unauthorized uses of commercial trademarks, and references “commerce” and “use in commerce” throughout, it is reasonable that both trademark ownership and trademark infringement contain commercial elements.

C. Use in Commerce Is a Jurisdictional Predicate

Other courts insist that the relevant language in §§ 1114(1)(a) and 1125(a)(1)(A) is not the phrase “use in commerce,” but the word “commerce.”²⁶⁸ According to these courts, “in commerce” simply invokes Congress’s authority under the Commerce

²⁶⁴ See *Dastar Corp. v. Twentieth Century Fox*, 539 U.S. 23, 29 (2003) (citation omitted).

²⁶⁵ See Ramsey, *supra* note 258, at 874 (citing commentary by Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597, 1609–12 (2007)).

²⁶⁶ *Id.* at 874.

²⁶⁷ *Id.* at 874–75.

²⁶⁸ See *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005).

Clause,²⁶⁹ thereby articulating the jurisdictional predicate for federal regulation.²⁷⁰ In this view, infringement does not require that the defendant use the trademark in commerce, but only that the defendant's use affect interstate commerce, such as by diminishing the trademark owner's ability to control the use of its commercial mark.²⁷¹

This position was adopted in a case involving the use of a Jackson Browne song in a political ad.²⁷² During the 2008 Presidential election, the Ohio Republican Committee (on behalf of the Republican Party and nominee John McCain) produced an eighty-second advertisement²⁷³ that criticized Barack Obama's energy policy amid rising gas prices,²⁷⁴ and featured a recording of Browne's "Running on Empty."²⁷⁵ Browne, a self-described liberal who supported Obama,²⁷⁶ alleged that this infringed on both his copyright (as the songwriter) and trademark (as the singer) by falsely suggesting that he sponsored, endorsed, or was associated with McCain "when nothing could be further from the truth."²⁷⁷ The Republican National Committee (RNC) moved to dismiss, contending that the Lanham Act applied only to commercial

²⁶⁹ See *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92–93 (2d Cir. 1997); *Browne v. McCain*, 611 F. Supp. 2d 1125, 1132 (C.D. Cal. 2009); Ramsey, *supra* note 258, at 873–74.

²⁷⁰ See Ramsey, *supra* note 258, at 874; see also *United We Stand*, 128 F.3d at 92–93 (“[U]se in commerce reflects Congress’s intent to legislate to the limits of its authority under the Commerce Clause, rather than to limit the Lanham Act to profit-seeking uses of a trademark.”).

²⁷¹ See *Browne*, 611 F. Supp. 2d at 1131–32; see also, e.g., *Maier Brewing Co. v. Fleischmann Distilling Corp.*, 390 F.2d 117, 120 (9th Cir. 1968); *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, No. 97 Civ. 0629 (KMW), 1997 WL 133313 at *3 (S.D.N.Y. Mar. 24, 1997) (noting that the scope of “in commerce” is broad).

²⁷² *Browne*, 611 F. Supp. 2d at 1128.

²⁷³ The Committee broadcast the ad on television and posted it on YouTube. *Id.* at 1129.

²⁷⁴ *Id.* at 1128 (complaint dismissed).

²⁷⁵ *Id.* at 1128 (the commercial played “Running on Empty” in the background as it criticized Obama’s suggestion that the country could conserve gasoline by keeping their automobile tires inflated to the proper pressure.).

²⁷⁶ See Geoff Boucher, *Jackson Browne Sues John McCain over Song Use*, L.A. TIMES, Aug. 14, 2008, 12:40 PM, <http://latimesblogs.latimes.com/washington/2008/08/jackson-browne.html> (detailing Browne’s campaign contributions to Democrat candidates).

²⁷⁷ *Browne*, 611 F. Supp. at 1127, 1129; see also Boucher, *supra* note 276.

speech so it could not apply to a political ad,²⁷⁸ and that because the ad was an “artistic work,” the First Amendment protected its use of Browne’s song.²⁷⁹

The court rejected the RNC’s argument that the Lanham Act was limited to commercial speech, and that Browne could not, as a matter of law, claim trademark infringement within a political context.²⁸⁰ It explained that the Act’s reference to use “in commerce” simply articulated Congress’s regulatory authority under the commerce clause.²⁸¹ Accordingly, Browne did not need to prove that the RNC had used his trademark in commerce, but only that the RNC’s use diminished his ability to control the use of his mark in commerce.²⁸²

The court also rejected the idea that the First Amendment barred a trademark infringement claim against political speech.²⁸³ It noted that other courts had applied the Lanham Act to political speech, and added that widespread confusion and negative consequences could result from political speech.²⁸⁴

Despite *Browne* concerning a singer’s trademark infringement claim against a political campaign, its precedential value to song marks and false endorsement is limited. Aside from it being a trial court, because the court was ruling on a motion to dismiss, it was constrained to consider the facts in the light most favorable to

²⁷⁸ *Browne*, 611 F. Supp. 2d at 1131.

²⁷⁹ *Id.* When a Lanham Act claim is based on use of a mark in an artistic work, thereby implicating First Amendment interests, many courts analyze it under the *Rogers* artistic relevance test. Under this test, an artistic work’s use of a trademark that otherwise would violate the Lanham Act is not actionable unless the use of the mark has “no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless it explicitly misleads as to the source or content of the work.” *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

²⁸⁰ *Browne*, 611 F. Supp. 2d at 1132.

²⁸¹ *Id.* at 1131–32.

²⁸² *Id.*

²⁸³ *Id.* at 1132–33. The RNC argued that its use of a song in a political campaign was presumptively fair use. *Id.* at 1130. The court, however, refused to dismiss the copyright claims, because the facts were not developed sufficiently to analyze the defense of fair use, and because the RNC had not established that the use of a copyrighted work in a political campaign was, as a matter of law, fair use. *Id.* at 1130–31.

²⁸⁴ *Id.* at 1132 (citing *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92–93 (2d Cir. 1997) (trademark infringement claim against a political group) and *MGM-Pathe Commc’ns. Co.*, 774 F. Supp. 869, 874–76 (S.D.N.Y. 1991)).

Browne,²⁸⁵ namely, that Browne could establish ownership of a trademark and that the use impeded Browne's control of it. Moreover, while the court held that a trademark owner is not required to show that the infringer used the mark in commerce, it did not address whether a song could be a trademark (or possessed by a performer).²⁸⁶ Consequently, that Browne defeated the RNC's motion to dismiss does not indicate that he had a protectable trademark, let alone a winning trademark infringement claim, but only that the RNC did not have a winning motion.

Furthermore, the case *McCain* cited to support its conclusion, *United We Stand America*,²⁸⁷ arose out of political campaigning but reflected a typical infringement scenario. There, the disputed trademark related to election and political advocacy services, as did the allegedly infringing trademark, and the court's analysis suggested that only certain types of uses constitute infringement.²⁸⁸

Back in 1992,²⁸⁹ Ross Perot's Presidential campaign committee established the "United Corporation" and trademarked "United We Stand America" as its service mark²⁹⁰ (associated with its political advocacy and campaign services).²⁹¹ It subsequently assigned to a third party the rights to "United We Stand America."²⁹² Later, an individual who had worked with the Perot campaign began using "United We Stand, America N.Y." for his own political work. In response, the trademark owner of "United We Stand America" claimed infringement.²⁹³ The issue was not whether disputes pertaining to politics were beyond the reach of the Lanham Act, but whether political services could fall within the scope of "services" and "use in commerce." The court held that the defendant's political activities under the mark constituted

²⁸⁵ *Browne*, 611 F. Supp. 2d at 1129. When reviewing a motion to dismiss for failure to state a claim, the court accepts as true all factual allegations in the complaint and draws all reasonable inferences in the non-movant's favor. *See* Martin K. Eby Constr. Co. v. Dall. Area Rapid Transit, 369 F.3d 464, 467 (5th Cir. 2004).

²⁸⁶ It appears that the RNC simply focused on the political character of the ad.

²⁸⁷ *United We Stand Am.*, 128 F.3d at 92–93.

²⁸⁸ *Id.* at 92.

²⁸⁹ *Id.* at 88.

²⁹⁰ *Id.*

²⁹¹ *Id.*

²⁹² *Id.*

²⁹³ *Id.*

“services” “in commerce” subject to the Lanham Act.²⁹⁴ And because the marks and services provided under them were very similar, there was a likelihood of confusion.²⁹⁵ Indeed, *MasterCard* later noted that *United We Stand* was inapt to the use of a trademark in a political ad.²⁹⁶ Because a political ad invokes no potentially competing commercial services, there cannot be confusion about sourcing or sponsorship of those services by the trademark owner.

VIII. CONFUSION DUE TO CAMPAIGN USES

Depending on a court’s interpretation of the Lanham Act’s “commerce” language, a political campaign’s use of a trademark may be exempt from a trademark infringement claim, fail to meet the *prima facie* elements of infringement, or be infringing in only limited situations.

Nevertheless, with regard to song mark infringement by political campaigns, whether a mark must be used in commerce or what the phrase means may be irrelevant. The Lanham Act is not a catchall statutory provision that converts any type of confusion into a legal cause of action. Instead, a trademark’s purpose is to prevent consumer confusion about sources, services, and the trademark owner’s sponsorship or approval of them, so only uses likely to deceive *consumers* about those affiliations or related *commercial matters* constitute infringement.²⁹⁷ Accordingly, regardless of whether the trademark owner needs to prove that the

²⁹⁴ *Id.* at 89–93; *see also id.* at 90 (finding that a group soliciting donations, issuing press releases, holding press conferences, and organizing on behalf of its members’ interests is performing “services” within the meaning of the Lanham Act); *Am. Family Life Ins. Co. v. Hagan*, 266 F. Supp. 2d 682, 694–95 (N.D. Ohio 2002); *N.A.A.C.P. v. N.A.A.C.P. Legal Defense & Educ. Fund, Inc.*, 753 F.2d 131 (D.C. Cir. 1985), *cert. denied*, 472 U.S. 1021 (1985) (indicating that Lanham Act remedies are “as available to public service organizations as to merchants and manufacturers”).

²⁹⁵ *United We Stand*, 128 F.3d at 89–93.

²⁹⁶ *MasterCard Int’l, Inc. v. Nader*, No. 00 Civ. 6068 (GBD), 2004 U.S. Dist. LEXIS 3644, at *25 (S.D.N.Y. 2004).

²⁹⁷ *See Eastland Music Grp., LLC v. Lionsgate Entm’t, Inc.*, 707 F.3d 869, 872 (7th Cir. 2013) (quoting *Dastar Corp. v. Twentieth Century Fox*, 539 U.S. 23, 31 (2003)); *Ray Commc’ns v. Clear Channel*, 673 F.3d 294, 301 (4th Cir. 2012); *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 502 (2d Cir. 1996); *Fortres Grand Corp. v. Warner Bros. Entm’t*, No. 3:12-cv-535, 2013 WL 2156318 at *6 (N.D. Ind. May 16, 2013).

alleged infringer (the candidate) used the song mark in commerce, it must, nonetheless, demonstrate that the candidate's use resulted in the likely deception of consumers about commercial matters or the trademark owner's affiliation with or approval of the politician's commercial services or products.²⁹⁸ Consequently, the relevant question is whether a campaign's use of a song would confuse consumers into thinking that the singer sponsors or endorses the commercial services of the politician.²⁹⁹

A. Absence of Commercial or Consumer Confusion

First and fundamentally, since a politician is not engaged in commerce, there is no commercial matter and no consumers involved. As a result, even if the use of the song mark created some type of confusion, it would not create consumer confusion about a commercial matter. Therefore, it would not constitute trademark infringement.³⁰⁰

While voters compare political platforms and choose among candidates, voters are not consumers in the marketplace and candidates are not goods that they purchase. A politician has no tangible goods or services to sell. In fact, it is illegal for a politician to monetize the power to make political appointments, monetary appropriations, and votes.³⁰¹ And, while preventing confusion may aid in society's political discourse,³⁰² trademarks are not an election statute.³⁰³

²⁹⁸ See 15 U.S.C. § 1125(a)(1)(A) (2012).

²⁹⁹ See *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (the relevant question is whether the defendant's use of the mark "is misleading in the sense that it induces members of the public to believe [the work] was prepared or otherwise authorized" by the plaintiff). See generally *Fortres Grand*, 2013 WL 2156318.

³⁰⁰ See *Rearden, LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190, 1214 (9th Cir. 2012); *Fortres Grand*, 2013 WL 2156318, at *6.

³⁰¹ See generally *Republican Party of Minn. v. White*, 536 U.S. 765 (2002) (prohibiting candidates for office from announcing their "views on disputed legal or political issues"); *Buckley v. Valeo*, 424 U.S. 1, 14–15 (1976) (outlining legal and ethical restrictions of politicians).

³⁰² See *Browne v. McCain*, 611 F. Supp. 2d 1125, 1131 (C.D. Cal. 2009).

³⁰³ A sponsor of the amendments to section 43(a), House Representative Kastenmeier, stated that political advertising and promotion were not contemplated covered by the term "commercial." He explained that the statute uses the word "commercial" to describe advertising or promotion for business purposes, whether conducted by for-profit or non-profit organizations or individuals. Political advertising and promotion is political

To illustrate, one of Ralph Nader's presidential campaign ads used MasterCard's trademarked "Priceless" riffed off the popular MasterCard ads. MasterCard complained that this infringed on their trademark "Priceless" which designated its credit and financial services. The court, however, held that Nader's use of trademark was not commercial, so it was permissible.³⁰⁴ It observed that MasterCard's "Priceless" campaign was well-known and more importantly, the credit and financial services that it designated had no rational connection to Nader's political candidacy. As a result, the average consumer would not have been misled into thinking that MasterCard was connected with the campaign or endorsing Nader.³⁰⁵

Using a song in a political advertisement does not alter this conclusion.³⁰⁶ The media format of a commercial is not equivalent to a commercial use or commercial speech. Although the boundary between commercial and non-commercial speech can be unclear, the Supreme Court has clarified it is the content of the message articulated and not its form ("commercial speech" as opposed to a commercial advertisement) that controls.³⁰⁷ The core notion of commercial speech is that it does no more than propose a commercial transaction.³⁰⁸

A political ad may be in the form of a commercial or possess "commercial-like" qualities, but it clearly does more than propose a commercial transaction; it seeks to educate, convince, and gain the support of voters. Indeed, courts and agencies that have considered campaign advertisements and solicitation of donations have concluded that they are not "commercial speech," but political speech.³⁰⁹ With regard to music in political ads, if the

speech, and therefore not encompassed by the term "commercial." 134 Cong. Rec. H.1297 (daily ed. Apr. 13, 1989) (statement of Wisconsin Rep. Kastenmeier).

³⁰⁴ MasterCard Int'l Inc. v. Nader, No. 00 Civ. 6068 (GBD), 2004 U.S. Dist. LEXIS 3644, at *28-29 (S.D.N.Y. 2004).

³⁰⁵ *Id.* at *8-9.

³⁰⁶ The use, however, would implicate the rights of the copyright holder of the work.

³⁰⁷ See *United States v. United Foods, Inc.*, 533 U.S. 405, 409 (2001).

³⁰⁸ See *id.* at 409; *Fortres Grand Corp. v. Warner Bros. Entm't.*, No. 3:12-cv-535, 2013 WL 2156318, at * 11 (N.D. Ind. May 16, 2013).

³⁰⁹ See *Fed. Election Comm. v. Colo. Republican Fed. Campaign Comm.*, 533 U.S. 431, 440 (2001) (spending for political ends and contributing to political candidates both fall within the First Amendment's protection of speech and political association");

song itself expresses a discernible message relevant to the campaign, it is substantively speech.³¹⁰ Even if the song has no obvious message, but is used as a melody or musical bed, it would, nonetheless, be in a political advertisement.

B. Reasonable Likelihood of Confusion

Second, aside from who might be confused, confusion due to hearing a song is highly unlikely. After all, playing and listening to music is what music is for. The public constantly hears music in stores, at sporting events, on hold with customer service, and at the dentist's office. Yet, the public does not become bewildered nor do they interpret hearing the music as a singer's endorsement of the respective commercial establishments, athletic teams, and endodontic procedures. There is no reason that the public would perceive music at a political event or in an ad any differently.³¹¹ In fact, playing an aural trademark is comparable to a gym broadcasting a song over satellite radio or a runner wearing a t-shirt emblazoned with a brand. Both are permissible, non-commercial uses, and neither causes the average person to think that the brand is affirmatively sponsoring the athlete.³¹²

When music fans play a song, they realize that it does not mean that the artist is personally endorsing them, but that *they* are appreciating the song and/or artist. Hence, the relationship between a candidate and music is that of a fan who likes a song, not the other way around. In fact, research shows that today's voters are interested in candidates' personalities and lives outside

Buckley v. Valeo, 424 U.S. 1, 14 (1976) (political campaign contribution and expenditure limitations operate in an area of the most fundamental First Amendment activities); Am. Family Life Ins. Co. v. Hagan, 266 F. Supp. 2d 682, 697 (N.D. Ohio 2002) (candidate's soliciting donations and voters visiting political website is not commercial speech, but political).

³¹⁰ By the same token, that words are uttered by a politician does not render them "political speech." Nonetheless, while a political purpose may not bar a trademark (or copyright) infringement claim, once the facts are considered, the First Amendment or political message might be an adequate defense against any infringement claim. *See Am. Family Life Ins. Co.*, 266 F. Supp at 701.

³¹¹ *See* Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CALIF. L. REV. 1581, 1636–37 (2006) (correlating case law pertaining to communicative strength of a mark and whether a court finds use confusing).

³¹² *See* 1-800-Contacts, Inc. v. WhenY.com, Inc., 414 F.3d 400, 407 (2d Cir. 2005).

of the political arena.³¹³ A candidate's taste in music is one clue voters use to discern a candidate's personality³¹⁴ and identify with them.³¹⁵ As a result, in recent Presidential elections, candidates have released their iPod playlists to give the public a better sense of who they are.³¹⁶

It follows that when the public hears "American Girl" or "Wavin' Flag" at a campaign event, in an ad, or on a candidate playlist, it understands it the same way, that the candidate either likes the song or is using it to convey a message. This is how viewers interpreted The Roots' playing "Lyin' Ass Bitch" to introduce Bachmann; viewers who recognized the song believed that The Roots were communicating their opinion about Bachmann, not that the original performer Fishbone was endorsing Bachmann's candidacy.

Additionally, the only indication of confusion is anecdotal evidence from singers who complain that fans might think they sold out or endorse the candidate.³¹⁷ While a musical artist's objection demonstrates that any implication of endorsement would be false, unsubstantiated fear is not proof that music consumers would think that a candidate's musical choice indicates an artist's endorsement.³¹⁸ Furthermore, inasmuch as this inference presumes that a singer has a right to permit or deny the use of a song, any audience confusion reflects a common misapprehension

³¹³ See Florian Haumer & Wolfgang Donsbach, *The Rivalry of Nonverbal Cues on the Perception of Politicians by Television Viewers*, 53 J. BROADCAST. & ELECTRONIC MEDIA 262, 263–64 (2009); Jordan, *supra* note 8, at 102.

³¹⁴ See Haumer & Donsbach, *supra* note 313, at 263–64; Jordan, *supra* note 8, at 102–03.

³¹⁵ See Jordan, *supra* note 8, at 103.

³¹⁶ See *id.* at 102.

³¹⁷ K'naan, for instance, said that he was flooded with Twitter messages accusing him of selling out. See McKinley, *supra* note 2.

³¹⁸ A possibility of confusion is lesser and not equivalent to a likelihood of confusion. See *A & H Sportswear v. Victoria's Secret Stores*, 166 F.3d 197, 206 (3d Cir. 1999). To illustrate, Henley submitted survey evidence that audience members might believe that Henley approved of the campaign's use of the Plaintiffs' songs. The court, however, stated that this was not probative of whether people would reasonably think that Henley performed the music in the videos. "To the extent that the [survey information] indicates a likelihood that Henley's endorsement was based purely on the use of his music, this is not a cognizable injury." *Henley v. DeVore*, 733 F. Supp. 2d. 1144, 1169 (C.D. Cal. 2010).

about copyright and music rights, *not* confusion about a commercial matter. In any event, it might be infuriating when a candidate whom the singer dislikes uses a song, but to the extent that the audience is aware of a singer's politics, it would realize that the song is not an endorsement.

Indeed, it seems that the crux of these complaints is that the artist disapproves of the candidate and does not want it to bask in the glow of the artist, or wants to remain free of any connection. Although a performer's frustration might be understandable, it does not engender a legal right. When creations such as music and movies are made available to the public, all members of the public may use and enjoy them. If a vocalist wants to ensure that people she disapproves of cannot play songs she has performed, then she must not make her performances and recordings available. Even copyright authors do not possess such an ideological or protective associational right.³¹⁹

IX. COPYRIGHT PREEMPTION

Independent of the legal theory of song mark protection is whether a legal action to enforce of such a right is subject to preemption. A song-trademark founded on the performance of a musical work or sound recording implicates copyright. The Copyright Act establishes a comprehensive statutory scheme governing the existence and scope of protection for "original works of authorship fixed in any tangible medium of expression."³²⁰ This includes musical compositions, lyrics, and sound recordings.³²¹ As explained in *Dastar*, which involved an unsuccessful trademark claim over an expired copyrighted work,

³¹⁹ Alternatively, the musical artist might fear "guilt by association," that if music consumers or record companies' dislike of the politician, they might not purchase the artist's records or services. This, however, does not fit into false endorsement, but somewhat more akin to an insufficient tarnishment claim.

³²⁰ See 17 U.S.C. §§ 101–1332 (2006). "A work is 'fixed' in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration." 17 U.S.C. § 101 (2010).

³²¹ 17 U.S.C. § 102(a)(2)(7) (2006).

the rights of copyright are part of a “carefully crafted bargain,”³²² and courts must prevent trademark and related protections from encroaching on areas traditionally occupied by copyright.³²³

To maintain copyright’s dominion,³²⁴ the Copyright Act includes a broad preemption provision³²⁵ found in section 301. It provides that:

[A]ll legal or equitable rights that [1] are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 (i.e., the right to reproduce, prepare derivative works, distribute, publicly perform, or display) in [2] works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by §§ 102 and 103 . . . are governed exclusively by this title.³²⁶

Essentially, when some other right collides with copyright, § 301 determines the right of way.³²⁷ Typically, if the asserted right is equivalent to those of copyright, it must yield.³²⁸ As applied to a song, though a musical composition sometimes can be protected by both trademark and copyright, preemption often precludes concurrent, co-equal protection.³²⁹

³²² *Dastar Corp. v. Twentieth Century Fox*, 539 U.S. 23, 33–34 (2003).

³²³ *See id.*; *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001).

³²⁴ *See Computer Assocs. Int’l Inc. v. Altai, Inc.*, 982 F.2d 693, 716 (2d Cir. 1992) (section 301 ensures that the enforcement of these rights remains solely within the federal domain).

³²⁵ This type of “ordinary preemption” is a substantive, affirmative defense that state claims have been substantively displaced by federal law. Complete preemption is not a defense, but a jurisdictional rule for assessing federal removal jurisdiction when a complaint raises only state law claims. *See Stuart Weitzman, LLC v. Microcomputer Res., Inc.*, 542 F.3d 859, 864 (11th Cir. 2008).

³²⁶ 17 U.S.C. § 301(a) (2006).

³²⁷ *Id.*

³²⁸ *Id.*

³²⁹ *See Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 61 (2d Cir. 2011) (copyright protection does not render songs “ineligible for protection as trademarks”).

A. *Scope of Preemption*

To be preempted by § 301, the asserted right must be equivalent to³³⁰ a right contained in § 106.³³¹ Though preemption is most obvious when a theory of legal recovery directly conflicts with copyright, a cause of action need not be identical to a copyright claim to be preempted.³³² If, notwithstanding its label, the claim attempts “to prevent nothing more than the reproduction, performance, distribution of a . . . performance captured [in a tangible medium]”³³³ or its underlying nature is part and parcel of a copyright claim, it is an equivalent right preempted by § 301.³³⁴

Importantly, § 301 does not state that the asserted right *itself* involve a tangible copyrightable work enumerated in §§ 102 or 103. Instead, it asks whether the rights asserted are equivalent to

³³⁰ See *Rosciszewski v. Arete Assocs., Inc.*, 1 F.3d 225, 229 (4th Cir. 1993) (“[R]eference must be made to the elements of the state cause of action”).

³³¹ Section 106 grants an author/owner five divisible rights to do or authorize the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

17 U.S.C. § 106 (2002).

³³² See *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1239–40 (C.D. Cal. 1987).

³³³ *Daboub v. Gibbons*, 42 F.3d 285, 289 (5th Cir. 1995) (claim preempted because the core of theory of recovery was the wrongful copying, distribution, and performance of a song’s lyrics); see also *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 653 (Cal. Ct. App. 1996).

³³⁴ See *Laws v. Sony Music Entm’t*, 448 F.3d 1134, 1143–45 (9th Cir. 2006); *Fleet*, 58 Cal. Rptr. 2d at 649–50 (performance captured in a tangible medium is subsumed by copyright and preempted); cf. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 201 (2d Cir. 1983), *rev’d on other grounds*, 471 U.S. 539 (1985) (the alternative and copyright claims both rest on the unauthorized publication).

the kinds of exclusive rights articulated in § 106,³³⁵ the section of the Copyright Act that enumerates the rights granted in copyrightable works (which, in turn, are listed in §§ 102 and 103). Put another way, § 301 asks whether the right asserted is comparable to any of the rights that a § 102 or 103 work would possess, namely, those enumerated in § 106.

This requires identifying what rights a claim seeks to vindicate and evaluating them against those of § 106.³³⁶ If they are comparable to those of § 106, such as when the plaintiff attempts to control the reproduction, public performance, or distribution of a copyrighted work or performance captured in a tangible work, the claim is preempted.³³⁷ If they are qualitatively different from those of copyright (or that would be exercised by a copyright holder), they are not.³³⁸

Where the alternative cause of action is qualitatively different than a copyright claim (and does not assert control over a copyrighted work), it is not preempted.³³⁹ Often, this is readily apparent because the alternative cause of action contains different elements than a copyright claim. Importantly, it is not the presence of an additional element that rescues a claim from preemption,³⁴⁰ but the impact of that element, namely that the extra element transforms the nature of the claim. Consequently, while a claim premised on a copyrighted work or component is preempted, a misappropriation or publicity claim unrelated to a copyrighted work, is different from a copyright claim and is not preempted.³⁴¹

³³⁵ See *Foley v. Luster*, 249 F.3d 1281, 1285 (11th Cir. 2001).

³³⁶ See *Rosciszewski v. Arete Assocs., Inc.*, 1 F.3d 225, 229 (4th Cir. 1993) (“[R]eference must be made to the elements of the state cause of action”).

³³⁷ See *Fleet*, 58 Cal. Rptr. 2d at 650–51.

³³⁸ See *Seng-Tiong Ho v. Taflove*, 648 F.3d 489, 501 (7th Cir. 2011); *Laws*, 448 F.3d at 1143–45; *Toney v. L’Oreal USA, Inc.*, 406 F.3d 905, 909–10 (7th Cir. 2005); *Aronson v. Dog Eat Dog Films*, 738 F.Supp. 2d 1104, 1116 (W.D. Wash. 2010); *Fleet*, 58 Cal. Rptr. 2d at 650–51 (performance captured in a tangible medium is subsumed by copyright law and preempted).

³³⁹ See *Laws*, 448 F.3d at 1144–45; *Fleet*, 58 Cal. Rptr. 2d at 649, 651.

³⁴⁰ See *Laws*, 448 F.3d at 1144 (“Although the elements of *Laws*’ state law claims may not be identical to the elements in a copyright action, the underlying nature of *Laws*’ state law claims is part and parcel of a copyright claim.”).

³⁴¹ The House of Representatives Report on the amendments to the preemption provisions stated that because misappropriation is not necessarily synonymous with copyright infringement, a misappropriation claim might not be preempted, provided it is

For instance, California's privacy and publicity law sometimes protects iconic musical artists from the commercial use of sound-alike performers.³⁴² Provided that claim is not premised on and does not exercise control over a copyrighted work, it is not preempted.³⁴³

Courts have formulated preemption analysis into various tests. Some courts first examine the asserted claim "to determine whether it falls 'within the subject matter of copyrights defined by 17 U.S.C. § 102,'" and then review the cause of action "to determine if it protects rights that are 'equivalent' to any of the exclusive rights of a federal copyright, as provided in 17 U.S.C. § 106."³⁴⁴ Other courts consider whether a claim meets both a "general scope requirement,"³⁴⁵ and a "subject matter requirement."³⁴⁶ If it meets both, the claim is preempted.³⁴⁷ To the extent that this asks whether the claim involves a work that falls within §§ 102 or 103, can be more demanding. This is exemplified by the Seventh Circuit's version: "First, the work in which the right is asserted must be fixed in tangible form *and* come within the subject matter of copyright as specified by § 102. Second, the right must be equivalent to any of the rights specified in § 106."³⁴⁸ This, however, either inartfully implies or inaccurately assumes that the claim involves an underlying work that itself is copyrightable or tangible *and* that such work is among those identified in §§ 102 or 103.

not based on a right within the general scope of copyright as specified by 17 U.S.C. § 106 or on a right equivalent thereto. *See* H.R. Rep. No. 94-1476, at 132 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748.

³⁴² *See* *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1098 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988).

³⁴³ *See, e.g.,* *Facenda v. NFL Films*, 542 F.3d 1007, 1029 (3d Cir. 2008); *Waits*, 978 F.2d at 1100; *Midler*, 849 F.2d at 460, 462.

³⁴⁴ *Globeranger Corp. v. Software AG*, 691 F.3d 702, 706 (5th Cir. 2012) (quoting *Carson v. Dynegy, Inc.*, 344 F.3d 446, 456 (5th Cir. 2003).)

³⁴⁵ In other words, does it seek to vindicate legal or equitable rights equivalent to one of the bundle of exclusive rights protected by § 106?

³⁴⁶ In other words, is the work in question of the type protected under 17 U.S.C. §§ 102 and 103?

³⁴⁷ *See* *Nat'l Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 848 (2d Cir. 1997).

³⁴⁸ *Balt. Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 674 (7th Cir. 1986) (emphasis added).

To the extent that a preemption analysis demands some tangible copyrightable corpus or suggests a claim that includes an uncopyrightable element does not fall within §§ 102 or 103 and thus escapes preemption, it misstates the statute. It may also open the door for performers to raise (albeit, incorrectly) publicity and misappropriation claims based on the theory that ephemeral identity cannot be copyrighted or assert that where an alternative claim includes a *prima facie* element distinct from a copyright claim, it is not preempted.

B. Preemption of Uncopyrightable Qualities and Components of Copyrighted Works

Performers asserting identity-based rights have argued that because neither voice nor identity is copyrightable, claims based on voice or identity are not preempted—either they do not fall within §§ 102 and 103, and therefore are not within the subject matter of copyright, or they do not possess the rights enumerated in § 106, so they cannot be preempted.³⁴⁹ This logic is flawed and consistently has been rejected by courts.

Preemption's purpose is to deprive states the power to bestow copyright-like protections on materials that Congress intended to be uncopyrightable or in the public domain.³⁵⁰ Therefore, it can function properly only if the "subject matter of copyright" is construed to include all works of a type covered by §§ 102 and 103, even if federal law does not protect them.³⁵¹ If it were otherwise, states could expand copyright protection as far as they wish, on the theory that the materials protected or rights granted by the state did not meet federal copyright standards, so they were not preempted.³⁵²

³⁴⁹ See generally *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992).

³⁵⁰ See *Seng-Tiong Ho v. Tafllove*, 648 F.3d 489, 501 (7th Cir. 2011); *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905, 911 (7th Cir. 2005); see also *Harper & Row Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 200 (2d Cir. 1983), *rev'd on other grounds*, 471 U.S. 539 (1985) (allowing states to expand copyright protection to works Congress deemed uncopyrightable would defeat the Act's central purpose).

³⁵¹ See *Nat'l Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 850 (2d Cir. 1997) (quoting *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447, 1453 (7th Cir. 1996)).

³⁵² See *R.W. Beck, Inc. v. E3 Consulting, LLC*, 577 F.3d 1133, 1146–47 (10th Cir. 2009); *NBA*, 105 F.3d at 849.

The assertion that since voice is not copyrightable, voice-related claims are not within the scope of copyright ignores the copyrightable work through which or in which the voice is expressed, that is, works within §§ 102 and 103. Case law is clear that inasmuch as they are part of a copyrighted work, the uncopyrightable components comprising that work,³⁵³ such as facts,³⁵⁴ ideas,³⁵⁵ or performances,³⁵⁶ come within “the broad ambit of the subject matter categories” of § 102.³⁵⁷ “[A] party who does not hold the copyright in a performance captured on film cannot prevent the one who does from exploiting it by resort to state law.”³⁵⁸

For example, while on a trip, Ken Aronson injured himself and landed in the hospital.³⁵⁹ His friend captured this on a video, which he later allowed Michael Moore to use in his documentary *Sicko*.³⁶⁰ Though Aronson sued Moore for misappropriation as well as copyright infringement, the court held both claims preempted.³⁶¹ It explained that although Aronson’s “persona” was not a work within § 102, the video capturing his persona was.³⁶² Since his claims arose out of the use and distribution of that copyrighted video, it was equivalent to the assertion of a right within copyright.³⁶³ Similarly, professional baseball players who appeared in games copyrighted to and broadcast by the MLB, sued

³⁵³ See *R.W. Beck*, 577 F.3d at 1146–47; *NBA*, 105 F.3d at 849 (“Copyrightable material often contains uncopyrightable elements within it, but Section 301 preemption bars state law . . . claims with respect to uncopyrightable as well as copyrightable elements.”).

³⁵⁴ See *Harper & Row*, 723 F.2d at 200 (discussing President Ford’s memoirs containing uncopyrightable facts).

³⁵⁵ See *Briarpatch Ltd. v. Phoenix Pictures, Inc.*, 373 F.3d 296, 306 (2d Cir. 2004) (discussing the non-copyrightable elements of an entertainment project, like ideas, are not sufficient to remove from preemption).

³⁵⁶ See generally *Laws v. Sony Music Entm’t*, 448 F.3d 1134 (9th Cir. 2006); see also Part III, *infra*.

³⁵⁷ *Briarpatch*, 373 F.3d at 306.

³⁵⁸ *Fleet*, 58 Cal. Rptr. 2d at 652–53.

³⁵⁹ See *Aronson v. Dog Eat Dog Films*, 738 F. Supp. 2d 1104, 1108–09 (W.D. Wash. 2010).

³⁶⁰ *Id.* at 1108–09.

³⁶¹ *Id.* at 1114, 1116.

³⁶² *Id.* at 1116.

³⁶³ *Id.*

MLB for using their images without their consent.³⁶⁴ Because the claim rested on their identities captured in a copyrighted work, the court held that the claim was preempted.³⁶⁵

In another case involving an appearance in a film, CBS purchased the exclusive rights to distribute and broadcast a copyrighted movie.³⁶⁶ When the producers of the film failed to pay the actors' salaries, the actors sued CBS for the unauthorized use of their likenesses and violation of their rights of publicity.³⁶⁷ Again, the court recognized that the actors were attempting to control the distribution, display, and performance of a copyrighted movie.³⁶⁸ Once those performances were incorporated into the film, they were "'dramatic works' 'fixed in [a] tangible medium of expression'" and within the scope or subject matter of copyright.³⁶⁹ Consequently, the claims were preempted.³⁷⁰ Similarly, the NBA complained that Motorola was reporting the scores and facts of basketball games broadcast by the NBA.³⁷¹ Unable to bring a copyright infringement action,³⁷² the NBA framed its claim as tortious behavior.³⁷³ This, too, was unsuccessful. The court concluded that because the NBA's complaint was about the reproduction, distribution, and display of the facts within the copyrighted broadcasts, it was within the scope of copyright, and preempted.³⁷⁴

Identity and misappropriation claims by musical artists based on the use of records have also been held to be preempted. For

³⁶⁴ See *Balt. Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 674–79 (7th Cir. 1986).

³⁶⁵ *Id.* (inasmuch as athletes' images were broadcast as part of copyrighted games, players' right of publicity claims were preempted by copyright).

³⁶⁶ See *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 646 (Cal. Ct. App. 1996).

³⁶⁷ *Id.* at 646–47.

³⁶⁸ *Id.* at 651. Unable to collect from the movie's producers, the actors sued CBS for violating their right of publicity. *Id.* at 646–47.

³⁶⁹ *Id.* at 650.

³⁷⁰ *Id.* at 652–53.

³⁷¹ See *Nat'l Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 848–49 (2d Cir. 1997).

³⁷² *Id.* at 848–49 ("Although game broadcasts are copyrightable while the underlying games are not, the Copyright Act should not be read to distinguish between the two when analyzing the preemption of a misappropriation claim based on copying or taking from the copyrightable work.").

³⁷³ *Id.* at 848.

³⁷⁴ *Id.* at 848–49.

example, recording artist Debra Laws recorded “Very Special” under a contract with Elektra /Asylum Records.³⁷⁵ That contract gave Elektra the exclusive rights to the master recordings, including the rights to “lease, license, convey or otherwise use or dispose of such master recordings,” and permit others to use Law’s name and likeness in connection with the recordings.³⁷⁶ Years later, Elektra licensed the recording to Sony Music to sample in the Jennifer Lopez / L.L. Cool J song “All I Have.”³⁷⁷ Elektra credited Laws but did not obtain her permission.³⁷⁸ In response, Laws sued Sony not for copyright infringement, but for misappropriation of her name and voice sampled in “All I Have.”³⁷⁹ Laws argued that since she was not challenging the use of the copyrighted sound recording, but rather the use of her name and voice *in* the sound recording, her claims were substantively different from and outside of the subject matter of Copyright law.³⁸⁰

Recognizing that the crux of Laws’ complaint was about the use of the copyrighted sound recording, the court rejected her restyled copyright plea. It explained that the crux of Laws’ complaint was about the use of the copyrighted sound recording.³⁸¹ The copyright owner had the exclusive right to permit reproduction, derivative use, or performance of the copyrighted work, and had properly licensed the work to Sony.³⁸² Hence, the subject matter of her claims fell within the subject matter of the Copyright Act.³⁸³ With regard to Laws’ assertion that her misappropriation claim required proof of the extra element of “commercial purpose” (which copyright infringement did not) and protected different rights than copyright, the court explained that the additional element did not change the underlying nature of the action.³⁸⁴ Consequently, her claims were preempted.³⁸⁵

³⁷⁵ See Laws v. Sony Music Entm’t, 448 F.3d 1134,1135–36 (9th Cir. 2006).

³⁷⁶ See *id.* at 1136.

³⁷⁷ See *id.*

³⁷⁸ *Id.* (the credits of the sound recording read, “Featuring samples from the Debra Laws recording ‘Very Special.’”).

³⁷⁹ *Id.* (discussing misappropriation of identity for commercial purposes).

³⁸⁰ *Id.* at 1138, 1144.

³⁸¹ *Id.* at 1144.

³⁸² *Id.* at 1144–45.

³⁸³ *Id.* at 1136–38, 1144.

³⁸⁴ *Id.* at 1144–45.

Digable Planets' trademark infringement and misappropriation³⁸⁶ complaints regarding Target's use of "Rebirth of Slick" fared no better.³⁸⁷ Digable Planets argued that because its complaint was not about the use of the copyrighted song, but about the unauthorized use of their uncopyrightable voices, its claims were not preempted.³⁸⁸ The court, however, explained that Digable Planets was not claiming that Target's ads used impersonations of them, but that the ads used their copyrighted sound recording and composition.³⁸⁹ Because the claims arose out of Target's use of the copyrighted works,³⁹⁰ the claims were within the subject matter of copyright,³⁹¹ and preempted.³⁹² *Butler* and *Laws* underscore that the mere presence of an additional element in or alternative label for the alternative claim will not rescue it from preemption.³⁹³ Rather, that extra element must transform the nature of the cause of action into something qualitatively different than a copyright claim.³⁹⁴

X. WHAT RIGHTS DOES A SONG MARK SEEK TO VINDICATE?

Fundamentally, a song mark asserts a right to control and prohibit the use, adaptation, and public performance of a musical composition and/or the sound recording that includes the vocals. These are not merely equivalent to rights within the purview of copyright, they *are* precisely the rights granted by Copyright law. A song mark is not solely voice or persona expressed via aural frequency, but is founded on a copyrighted composition or a sound recording, both of which are works within §§ 102 and 103. This is

³⁸⁵ *Id.*

³⁸⁶ *See* *Butler v. Target Corp.*, 323 F. Supp. 2d 1052, 1057 (C.D. Cal. 2004).

³⁸⁷ *Id.* at 1054.

³⁸⁸ *Id.* at 1056.

³⁸⁹ *Id.*

³⁹⁰ *Id.* (citing 17 U.S.C. § 102(a)(2)(7) (2006)).

³⁹¹ *Butler*, 323 F. Supp. 2d at 1056.

³⁹² *Id.* at 1054–56.

³⁹³ *See id.* at 1144–45 (“Although the elements of *Laws*' state law claims may not be identical to the elements in a copyright action, the underlying nature of *Laws*' state law claims is part and parcel of a copyright claim).

³⁹⁴ *See* *Laws v. Sony Music Entm't*, 448 F.3d 1139, 1144–45 (C.D. Cal. 2004); *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 649 (Cal. Ct. App. 1996).

further apparent when recognizing the perverse impact a song mark would have on the rights of a copyright holder. Because a performer could wield a song mark to prohibit uses of works by the copyright owners, a song mark would extinguish the rights of a copyright holder. In fact, the performer would have a right *superior* to them.³⁹⁵ It is therefore clear that such a claim and attempt to control identity through song mark is preempted.

Additionally, while ephemeral voice may not be copyrightable, a recording of a voice performing a musical composition or fixed in a sound recording is. When identity is evidenced through the performance of or captured in a copyrighted work, it is subsumed by the copyrighted work. As a result, it becomes part of a copyright claim. Because the copyrighted work as a whole satisfies the subject matter requirement, it is preempted.³⁹⁶ Indeed, while the statute does not protect voice as a copyrighted work, it *does* contemplate voice as a mechanism by which to exercise the rights granted by copyright. Consequently, voice may not be tangible, but as an instrument to perform or exercise a right under copyright, it is within the purview of Copyright law. There is a difference between a claim that falls outside of the subject matter of copyright and a claim that does not meet the prima facie requirements of a copyright action. That a performer would not be able to bring a copyright infringement action does not mean the performer's claims are not within the purview of copyright and rescued from preemption. Instead, it means that the singer would not prevail in a copyright lawsuit. Nonetheless, § 301 does not create a cognizable right in anything that is not protected by copyright, but ensures copyright's preeminence of scope.

CONCLUSION

The complex intersections of trademark and copyright, exacerbated by the interests of performers in managing their artistic personas and politicians in connecting with voters, have

³⁹⁵ Additionally, rights would no longer be divisible, because once a singer performed the work, she would obtain control over it as a song mark.

³⁹⁶ See *Nat'l Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 849 (2d Cir. 1997) (section 301 preempts the uncopyrightable elements along with the copyrightable ones).

cultivated an environment where these rights involved are commonly misconstrued and the stakes are high. With the 2016 election season already upon us, these disputes will only continue to arise until the issue is addressed.

Although it is understandable that a performer would not want a politician she opposes to use what she considers to be “her” song, this type of personal objection is not equivalent to a protectable legal interest. Performers do not possess proprietary rights in the works they perform, and cannot leverage participation into rights superior to those of the copyright owners of such works. Moreover, restyling this as a trademark claim cannot alter its fundamental nature—any attempt to control the use of vocal identity in a musical work necessarily attempts to control the underlying copyrighted work. Thus, any issue or right falls within the purview of (and is preempted by) the Copyright Act. Indeed, several courts have observed that performance-based rights of this ilk would conflict with copyright and wreak havoc on long-established understandings of trademark and commercial practices. While economic inconvenience does not extinguish a legitimate right, here it reveals the inherent conflict between song marks and Copyright law. Nevertheless, § 1125 (a)(1)(A) of the Lanham Act does not prohibit any unauthorized use of a trademark, but only ones likely to deceive consumers about commercial matters. Because a politician is not a commercial enterprise providing a tangible product or service, its use of a song mark, even if misleading, could not reasonably result in consumer confusion about a commercial matter. Consequently, it does not amount to trademark infringement.