Waits v. Frito-Lay, Inc. the Ninth Circuit Rides the Right of Publicity Down a Slippery Slope

Christopher Menjou
NOTES

WAITS V. FRITO-LAY, INC.
THE NINTH CIRCUIT RIDES THE RIGHT OF PUBLICITY DOWN A SLIPPERY SLOPE

"Nothing today, likely nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before. Overprotection stifles the very creative forces it's supposed to nurture."¹

I. INTRODUCTION

Imagine that as the members of the rock group Nirvana² finish their performance on the 1992 MTV Music Awards,³ the band begins destroying their instruments. The drummer kicks his set over and the guitarist swings his guitar as if hitting a Nolan Ryan fastball, knocking his amplifier out of the park. When the band reaches the backstage dressing room, they are confronted by attorneys for Johnny Lydon, lead singer of the now-defunct punk rock group, the Sex Pistols.⁴ The attorneys serve the successful young band with a complaint charging that Nirvana's performances infringe upon the Sex Pistols' common law "right of publicity"⁵ by copying the

². Nirvana is an alternative rock band whose debut album, Nevermind, was certified quadruple platinum after selling 4 million copies. Paul Grein, Platinum Albums Down, Singles Up; Brooks Top-Selling Artist In First Half, BILLBOARD, July 18, 1992, at 10.
³. MTV is Music Television, a 24 hour cable channel that broadcasts a mix of rock music videos and music-related news.
⁴. The Sex Pistols were the vanguard band for the "punk rock" movement of the late 70s, but broke up in 1978 after a mere two years of existence. See Greg Kot, When Punk Was King, CHI. TRIB., Nov. 11, 1990, at C6. This breakup followed after only one United States tour. Id. Even so, their debut album, Never Mind the Bollocks, Here's the Sex Pistols, reached the platinum (one million album sales) mark in 1992. Tom Popson, Punk/New Wave Era to Return on Upcoming CDs, CHI. TRIB., May 8, 1992, at Q. As ambassadors of the angry punk sound, the Pistols often closed their shows by destroying their instruments.
⁵. See infra notes 13-14 and accompanying text. See generally J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 1.6 at 1-27 to 1-47 [hereinafter MCCARTHY].
performance style of the Sex Pistols. This complaint urges the court to enjoin the group from ending its performances by destroying their instruments and to award damages. After Nirvana pays these damages, the Sex Pistols turn around and pay damages to the veteran rock band, The Who, to satisfy a judgment for infringing upon The Who’s right of publicity.

The above hypothetical is not as far-fetched as it may seem. The Ninth Circuit Court of Appeals in Waits v. Frito-Lay, Inc.7 ("Waits") created a new cause of action for imitating a performer’s style under the common law right of publicity.8 This tort might best be characterized as "style misappropriation," and Waits extended the standard for protecting an individual’s style through the right of publicity further than previously allowed in any court.9 Indeed, until Midler v. Ford Motor Co.10 ("Midler") and Waits, claims involving only “voice misappropriation” were relegated to the doctrine of unfair competition.11 With one exception, however, courts had refused to grant relief to a plaintiff invoking unfair competition in appropriation cases.12

The Ninth Circuit found that Tom Waits could recover under a right of publicity cause of action by expanding its prior decision in Midler, which granted recovery based upon the common law tort of voice

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6. The Who is a rock band that has toured the world several times since its beginning in 1964. In 1990, after 26 years of existence, the band placed seventeenth on Forbes’ list of the highest paid entertainers for the previous two years. Forbes Top 40: The World’s Highest Paid Entertainers, FORBES, Oct. 1, 1990, at 142. In this case, The Who, being known for its predilection to destroy their instruments after a show, would have claimed that Nirvana had invaded their right of publicity in their performance style.

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

8. Id.


10. 849 F.2d 460 (9th Cir. 1988).

11. Sinatra, 435 F.2d at 714; Lahr v. Adell Chem. Co., 300 F.2d 256 (1st Cir. 1962); Booth, 362 F. Supp at 345. Cf. Shaw v. Time-Life Records, 341 N.E.2d 817, 820 (N.Y. 1975) (“Absent a claim of unfair competition, a competitor may appropriate any musical arrangement which is not so distinctive as to constitute a separate musical entity.”); Miller v. Universal Pictures, Co., 201 N.Y.S.2d 632 (Sup. Ct. 1960) (“[I]n the absence of palming off or confusion . . . others might have meticulously . . . imitated [Glenn Miller’s] renditions.”).

12. Of the cases cited supra note 11, Lahr was the only case in which the plaintiff’s unfair competition claim was accepted by the court. Lahr, 300 F.2d at 259.
as style cannot fit under what has been deemed a "property right." 22

II. BACKGROUND: THE EVOLUTION OF VOICE MISAPPROPRIATION

The evolution of the voice misappropriation doctrine reflects a dichotomy between the Ninth Circuit and other state courts and legislatures. Fourteen states, including California, 23 have enacted statutes protecting the right of publicity by prohibiting the unauthorized use of another's "name," "portrait," "photograph," "picture" or "likeness." 24 Some statutes also prohibit the unauthorized use of one's "voice." 25 Courts have generally read these statutes rather narrowly, 26 understanding "voice" to mean an actual recording of the individual's voice 27 and interpreting "likeness" to mean only a visual representation. 28 As other courts have restricted these terms, however, the Ninth Circuit has moved in the opposite direction by expanding the breadth of the common law right of publicity. A short analysis of the development of the right of publicity through common law and statutory channels is helpful in understanding the Ninth Circuit's

22. See infra part V. See also Midler, 849 F.2d at 463 ("By analogy the common law rights are also property rights."); Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821, 825-26 (9th Cir. 1974) (recognizing a proprietary interest in one's identity); Uhlaender v. Henricksen, 316 F. Supp. 1277, 1280 (D. Minn. 1970) (invasion of privacy involving a pecuniary right is an "interference with property").


24. Of the state statutes cited supra note 23, Florida, Kentucky, Massachusetts, Nebraska, New York, Rhode Island, Tennessee, Utah, Virginia and Wisconsin protect either name, likeness, photograph, portrait or picture, or some combination thereof, while excluding protection for voice.

25. Of the state statutes cited supra note 23, only California, Nevada and Texas recognize some form of protection for the unauthorized use of one's voice.

26. See White v. Samsung Elecs. Am., Inc., 971 F.2d 1395, 1397 (9th Cir. 1992), reh'g en banc denied 989 F.2d 1512 (9th Cir. 1992), cert. denied 113 S. Ct. 2443 (1993) (refusing to hold that a robotic figure resembling the plaintiff was a likeness for a section 3344 claim); Midler, 849 F.2d at 463 ("Likeness refers to a visual image, not a vocal imitation."); Lahr, 300 F.2d at 258 (limiting New York right of privacy statute to "name, portrait, or picture . . . .").

27. Midler, 849 F.2d at 463.

Voice misappropriation is an offshoot of the right of publicity, which the Waits court described as "the right of a person whose identity has commercial value . . . to control the commercial use of that identity."  

Although both Waits and Midler involved alleged imitations of the plaintiffs' voices for commercials, there is a crucial difference between the two cases. In Midler, the defendants used a sound-alike performer to re-record a song previously made popular by singer Bette Midler. Conversely, the defendants in Waits used a song that had never been recorded by any artist, including Tom Waits. Instead, Frito-Lay wrote an original composition specifically for the commercial.

The Ninth Circuit overlooked the differences between a claim based upon the imitation of a previous recording (e.g. Midler) and a claim based purely upon similarities in vocal style (e.g. Waits). This distinction gave the Waits court an opportunity to place limits upon reckless application of the Midler tort of voice misappropriation. Unfortunately, the court declined to do so. The Ninth Circuit chose instead to expand the Midler tort of voice misappropriation, establishing a precedent that subverts traditional copyright law and chills both creativity and opportunity.

This Note will discuss the misapplication of the Midler standard in Waits. It will first present the evolution of the voice misappropriation tort from the right of privacy through state statutory and common law up to Midler and Waits. Next, this Note will address the background and facts of Waits. This Note will then introduce the holding and reasoning of the Waits court and explain how the Ninth Circuit misapplied its own standard from Midler in Waits. Finally, this Note will analyze the implications of the Waits holding, concluding that there is no room for protection of a performer's style within the rubric of the right of publicity,

13. Waits, 978 F.2d at 1100. See infra notes 102-14 and accompanying text.
14. Waits, 978 F.2d at 1098.
17. Waits, 978 F.2d at 1097.
18. See infra part II.
19. See infra part III.
20. See infra part III.B.
21. See infra part IV.
A. The Right of Privacy v. The Right of Publicity

The right of privacy, as originally defined, is best known as "the right to be left alone." Unfortunately, since the doctrine of the right of privacy spawned the right of publicity, the two doctrines are often confused with one another, despite the fact that they protect different rights. The right of privacy generally ensures that one may "live without interference by the public in matters with which the public is not . . . concerned." The right of publicity, on the other hand, protects a performer's "proprietary interest" in his public persona, the focus being primarily on "who gets to do the publishing."

B. Federal Statutory Law

The Copyright Act of 1976 ("the Act") provides uniform federal protection and grants certain rights to the owner for works which fall under its provisions. Exclusive rights in sound recordings are governed by subsections (1) and (3) of the Act. Performers, however, often do not own the copyrights to the works that they perform. Thus, these performers are left unprotected because the Act expressly allows "the making . . . of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate . . .

30. See MCCARTHY, supra note 5, § 1.7 at 1-33.
31. For example, New York's right of publicity statute, N.Y. CIV. RIGHTS LAW § 50 is entitled "Right of Privacy." See infra notes 46-56 and accompanying text.
34. 17 U.S.C. § 106 (1988) provides that the owner of a copyright has exclusive rights to reproduce, distribute, prepare derivative works of, perform, and display the protected work.
those in the copyrighted sound recording."37 In other words, as long as
the copyrighted work is not copied directly from one source to another,
even a deliberate attempt to copy another's work is not prohibited by the
Act.

Defendants in misappropriation cases have argued that, by providing
federal law on the subject, the Act preempts common law causes of action
such as the right of publicity.38 In rejecting this argument, the courts have
relied upon 17 U.S.C. § 301, which states that any right that is "equivalent"
to the federally granted rights "in works of authorship that are fixed in a
tangible medium of expression and come within the subject matter of
copyright" are governed exclusively by the Act.39 Thus, no state may
grant protection to any form of media which comes within the definition of
works protected by the Act. However, since a voice is neither "fixed in a
tangible medium of expression" nor is it within the subject matter of
copyright,40 voice misappropriation is not governed exclusively by the
Act.

Therefore, federal law offers no protection to a performer whose voice
has been appropriated in an independent, fixed medium. Nevertheless, the
Act does not bar any other state common law remedy available to a
performer.41 This lack of protection in federal jurisprudence has led the
Ninth Circuit to extend the right of publicity to its present broad applica-
tion.42

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37. 17 U.S.C. § 114(b) (1988); Notes of Committee on the Judiciary, H.R. No. 94-1476.
Subsection (b) of section 114 . . . makes clear that statutory protection for sound
recordings extends only to the particular sounds of which the recording consists,
and would not prevent a separate recording of another performance in which those
sounds are imitated . . . Mere imitation of a recorded performance would not
constitute a copyright infringement even where one performer deliberately sets out
to simulate another's performance as exactly as possible.

Id. (emphasis added).

38. See Waits, 978 F.2d at 1100; Midler, 849 F.2d at 462.
40. Waits, 978 F.2d at 1100; Midler, 849 F.2d at 462. See McCARTHY, supra note 5, §
4.14[E][2] at 4-93.
41. The Midler court found that even though "a voice is not copyrightable" under federal law,
Midler could still argue a cause of action under either CAL. CIV. CODE § 3344, see infra note 58,
or the common law right of publicity. Midler, 849 F.2d at 462-63. Note, however, that the claim
under California statutory law was unsuccessful. Id.
42. See Linda Benjamin, Comment, Tuning Up the Copyright Act: Substantial Similarity And
Sound Recording Protection, 73 MINN. L. REV. 1175, 1199-1200 (1989), for the proposition that
the Act should be amended to include a "substantial similarity" standard in the appropriation of
one's performance in a musical work. However, there would be great opposition to such a
proposal. Many popular songs are subsequently re-recorded by different artists. Copyright
C. State Statutory Law

Several states have recognized the right of publicity tort by statute. Some, however, still address the cause of action under the right of privacy. How to address the right involved has become a balancing act between expression and ownership. The Second Circuit stated that "'ideas,' ... though upon them all civilization is built, may never be 'owned.' The law does not protect them at all, but only their expression; and how far that protection shall go is a question of more or less ..." The question of "how far that protection shall go" is exemplified by the different ways in which the New York and California courts and legislatures have treated the development of the right of publicity. Although much of the litigation arises in these states due to the large number of celebrities residing there, the interpretation of the rights differs widely.

1. New York

New York addresses misappropriation claims under New York Civil Code sections 50 and 51. Section 50 provides, in pertinent part, that: "A person . . . that uses for advertising purposes . . . the name, portrait or picture of any living person without having first obtained the written consent of such person . . . is guilty of a misdemeanor." Section 51 allows a plaintiff to enjoin the wrongful use of the traits described in section 50 or to collect damages. The New York statute, unlike

owners derive much income from advertising agencies or artists that want to use the song commercially. For example, "a songwriter whose musical composition, once released, is released again as a different rendition by another artist who sells 1 million phonorecords, will earn . . . $40,000 under the current royalty rate." Robert Thorne, Compulsory Licensing: The Music Makers as Money Makers, 1985 ENT. PUB. & THE ARTS HANDBOOK, at 281. If federal law protected sound-alikes, the incentive to buy the license of a classic song and re-record it would be destroyed, for fear of sounding too similar to the original and creating potential liability. One could imagine the chilling effect that an ill-defined "substantially similar" standard would have on the incomes of these copyright holders. See Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711, 718 (9th Cir. 1970).

43. See supra note 23.
44. Of the state statutes cited supra note 23, Nebraska, New York, Oklahoma, Rhode Island and Wisconsin recognize the right under the title of "Right of Privacy" or "Right to Privacy."
45. RCA Mfg. Co. v. Whiteman, 114 F.2d 86, 90 (2d Cir. 1940).
47. Id. § 50.
48. Id. § 51.
California's, does not include voice as a trait which can be misappropriated. Consequently, sound-alike claims will likely fail in New York, as courts have been reluctant to extend coverage under the statute to media falling outside the scope of the plain language of the statute.

However, the court in *Tin Pan Apple, Inc. v. Miller Brewing Co.* did adopt an expanded view of the statutory language with respect to visual representations. In *Tin Pan Apple*, a rap group known as the Fat Boys sued Miller Brewing Co. after the defendant's advertising agency produced a television spot which featured "three [Fat Boys] look-alikes performing in the distinctly [Fat Boys] style ...." The suit was based on, among other claims, an invasion of the plaintiffs' right of publicity under New York's Civil Rights Law sections 50 and 51. The court found that "physical similarity" between the plaintiffs and the defendant's representations constituted a valid cause of action under sections 50 and 51. Therefore, if the New York legislature decides to add "voice" to its statute, the courts might apply a "similarity" standard to voice misappropriation claims.

If New York declines to add "voice" to section 50, however, it is not likely that a case like *Waits* or *Midler* would be successful in that state. New York treats the rights of publicity and privacy as merely two forms of the same doctrine, combining them under a general statutory right of privacy. In *Stephano v. News Group Publications, Inc.* ("Stephano"), the New York Court of Appeals held that the common law right of publicity in New York was expressly granted by statute as it was subsumed into sections 50 and 51. Therefore, there is currently no recognized common law right of publicity in the state of New York, preventing the type of judicial legislation that has occurred in the Ninth Circuit.

49. See infra note 58.


52. Id. at 828.

53. Id.


55. See infra note 57 and accompanying text.


57. Id. at 584.
2. California

California Civil Code section 3344 governs misappropriation of voice,\(^{58}\) providing that "any person who knowingly uses another's . . . voice . . . for the purposes of advertising or selling . . . without such person's prior consent . . . shall be liable for any damages sustained by the person."\(^{59}\) The statute was amended in 1984 to include voice misappropriation.\(^{60}\) One feature of the California law, not found in New York's statute, is that the remedies embodied in section 3344 are expressly cumulative and "in addition to any others provided for by law."\(^{61}\) This provides the leeway needed for the courts to fashion additional relief, such as an expanded common law right of publicity independent of section 3344.\(^{62}\) However, not wishing to adopt New York's "similarity" standard offered in *Tin Pan Apple*,\(^{63}\) the Ninth Circuit has restricted claims based upon section 3344 voice misappropriation to *the use of the individual's actual voice*.\(^{64}\) In other words, unless a recording of the individual's voice is taken directly from one source for use in another recording, no cause of action lies under section 3344.\(^{65}\)

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\(^{58}\) CAL. CIV. CODE § 3344 (West Supp. 1993).

\(^{59}\) Id. § 3344(a).

\(^{60}\) Due to the lack of available legislative history, the purpose of the amendment, other than to protect a performer from unauthorized, actual duplication of his voice, remains unclear. Some urge the courts to interpret the plain language of the statute to include one who "engages in any vocal imitation of a distinctive celebrity voice . . . ." Katherine L. Blanck, *Comment, Restricting the Use of "Sound-Alikes" in Commercial Speech by Amending the Right of Publicity Statute in California*, 26 SAN DIEGO L. REV. 911, 931 (1989) (emphasis omitted). However, the courts have not been willing to extend § 3344 any further than the mandates of the language. *See Midler*, 849 F.2d at 463; *White*, 971 F.2d at 1397.

\(^{61}\) CAL. CIV. CODE § 3344(g).

\(^{62}\) *See Midler*, 849 F.2d at 463 ("[Section 3344] does not preclude Midler from pursuing any cause of action she may have at common law."). *Contra* Stephano v. News Group Publications, Inc., 474 N.E.2d 580, 584 (N.Y. 1984) (reading New York's statutory right of privacy as enrolling the right of publicity).


\(^{64}\) *See Midler*, 849 F.2d at 463 ("The term 'likeness' refers to a visual image not a vocal imitation.").

\(^{65}\) Id.
D. State Common Law

1. Pre-Midler

The term “right of publicity” was first recognized in 1953 in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* (“Haelan”).66 In Haelan, the plaintiff, a chewing gum manufacturer, entered into an exclusive contract with a baseball player to portray his image on trading cards.67 The defendants, competitors of the plaintiff, were aware that the plaintiff had such a contract, but had induced the baseball player to enter into a similar contract and used the athlete’s image on their trading cards.68 The defendants advanced the novel defense that the contract created between the ballplayer and the plaintiff “was no more than a release by the ball-player to plaintiff of the liability which, absent the release, plaintiff would have incurred in using the ball-player’s [image], because [an unauthorized use] ... would be an invasion of his right of privacy . . . .”69 The defendants further argued that, since this right of privacy is not assignable, the plaintiffs had no cause of action.70 The Second Circuit disagreed, however, asserting that the ballplayer’s right, called the “right of publicity,” was a right “in addition to and independent of” the right of privacy.71 The court rejected the defendants’ argument that a party’s only legal interest in the use of his picture for commercial purposes was a right of privacy.72 In so doing, the court found that this right, in the interest of commerce, is exclusively assignable by the owner of the right.73 However, the *Haelan* court left subsequent courts without any guidance as to the parameters of the right of publicity. This void is especially troublesome as the court’s expression of the right included the right to exclusive use, creating a copyright-like monopoly without the federally mandated limitations.74

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66. 202 F.2d 866 (2d Cir. 1953).
67. Id. at 867.
68. Id.
69. Id.
70. Id.
71. *Haelan*, 202 F.2d at 868.
72. Had the court accepted this argument, the plaintiff’s cause of action would be prevented as, in New York, the “statutory right of privacy is personal, not assignable.” Id. at 867. Thus, the plaintiff could not sue on the ballplayer’s behalf.
73. Id. at 868.
74. In *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86 (2d Cir. 1940), the court noted that “[c]opyright in any form, whether statutory or at common-law, is a monopoly; it consists only in the power to prevent others from reproducing the copyrighted work.” Id. at 88. The Copyright Act of 1976 limits the duration of this monopoly (in works created after January 1, 1978) to the
Haelan, a New York case, is noteworthy because it signalled the end of the Second Circuit's sole reliance upon the statutory right of privacy embodied in New York Civil Code sections 50 and 51. The development of a common law right of publicity enabled the New York courts to escape from the confines of the right of privacy statute. However, the New York Court of Appeals retreated from this view in 1984, holding that there is no common law right of publicity, only a statutory version.

A common law right of publicity was first established in California in Motschenbacher v. R.J. Reynolds Tobacco Co. ("Motschenbacher"). Similar in some respects to Waits, Motschenbacher involved the unauthorized use of professional race car driver Lothar Motschenbacher's automobile in an advertisement for Winston cigarettes. Motschenbacher was known for the distinctive way in which he adorned his race car to make it more readily identifiable as his own. The driver of the car was not recognizable in the advertisement, yet Motschenbacher sued Reynolds for misappropriation of his name, likeness, personality and endorsement.

The court noted that the injury caused in privacy cases usually involved only damage to personal feelings. However, where what has been appropriated has commercial value, as in Motschenbacher, the injury may be entirely economic. This type of injury had not yet been contemplated...
in traditional right of privacy theory.\footnote{84} Writing on a blank slate,\footnote{85} the court declined to categorize the right as one of "property," "privacy," or "publicity."\footnote{86} Instead, it found that an individual has a recognizable and protectible interest in one's identity which has commercial value.\footnote{87} Further, unauthorized use of that identity is an actionable tort although the injury may be solely economic in nature.\footnote{88} Although allowing a common law cause of action, the \textit{Motschenbacher} court maintained the distinction between the statutory right and the common law right.\footnote{89} The common law right of publicity has since become a well-established cause of action in California.\footnote{90}

Plaintiffs in states which recognize a common law right of publicity have an advantage in that courts in those states generally read the common law version more liberally than the statutory version.\footnote{91} In \textit{Hirsch v. S.C. Johnson & Sons, Inc.}\footnote{92} ("\textit{Hirsch}")\footnote{93}, the defendants had advertised a women's shaving gel named "Crazylegs."\footnote{94} The defendants were aware that "Crazylegs" was also the nickname of professional football player Elroy Hirsch. In finding that Hirsch was entitled to an action under the common law right of publicity, the court noted that Hirsch had a commercial market for his nickname, as he had appeared in advertisements in which he was identified as "Crazylegs."\footnote{95} Even though "Crazylegs" was only a nickname, the court held that Hirsch was entitled to a cause of action if "the name clearly identif\[ied] the wronged person."\footnote{96}

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\footnote{84. Id. at 824-25.}
\footnote{85. The court found that, although there were no cases on point, all prior appropriation cases had relied primarily on the "privacy" aspect of the tort. \textit{Motschenbacher}, 498 F.2d at 825.}
\footnote{86. Id. at 826.}
\footnote{87. Id. at 825.}
\footnote{88. Id. at 825-26.}
\footnote{89. Id. at 826 n.16.}
\footnote{90. \textit{Waits}, 978 F.2d at 1098; \textit{Midler}, 849 F.2d at 463; \textit{White}, 971 F.2d at 1397; Lugosi v. Universal Pictures, 603 F.2d 425, 431 (Cal. 1979); Eastwood v. Superior Court, 198 Cal. Rptr. 342, 347 (Ct. App. 1983). The Eastwood court clearly defined the fundamentals of the tort: "A common law cause of action for appropriation of name or likeness may be pleaded by alleging (1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage . . . ; (3) lack of consent; and (4) resulting injury." \textit{Eastwood}, 198 Cal. Rptr. at 347 (citing \textit{PROSSER, LAW OF TORTS § 117, at 804-07 (4th ed. 1971)}).} \footnote{91. See, e.g., \textit{Carson v. Here's Johnny Portable Toilets, Inc.}, 698 F.2d 831 (6th Cir. 1983); \textit{Hirsch v. S.C. Johnson & Son, Inc.}, 280 N.W.2d 129 (Wis. 1979); \textit{Lugosi v. Universal Pictures}, 603 F.2d 425, 431 (Cal. 1979); \textit{Eastwood v. Superior Court}, 198 Cal. Rptr. 342, 347 (Ct. App. 1983). The Eastwood court clearly defined the fundamentals of the tort: "A common law cause of action for appropriation of name or likeness may be pleaded by alleging (1) the defendant's use of the plaintiff's identity; (2) the appropriation of plaintiff's name or likeness to defendant's advantage . . . ; (3) lack of consent; and (4) resulting injury." \textit{Eastwood}, 198 Cal. Rptr. at 347 (citing \textit{PROSSER, LAW OF TORTS § 117, at 804-07 (4th ed. 1971)}).}
\footnote{92. \textit{280 N.W.2d} 129 (Wis. 1979).}
\footnote{93. Id. at 130.}
\footnote{94. Id. at 131-32.}
\footnote{95. Id. at 137.}
\end{footnotes}
Similarly, in *Carson v. Here's Johnny Portable Toilets, Inc.*96 ("Carson"), the Sixth Circuit authorized an extension of the common law right.97 In *Carson*, the defendants advertised their portable toilets using the phrase "Here's Johnny," a well-known phrase that was used to introduce Johnny Carson, the former host of the late-night talk show *The Tonight Show*.98 The court reversed the lower court's dismissal of Carson's right of publicity claim, concluding that one's "identity may be appropriated in various ways."99 Relying on *Motschenbacher* and *Hirsch*, the court reiterated that infringement of an individual's right of publicity may take place even in the absence of a use of that individual's name, picture, or likeness.100 The court further stated that the common law right of publicity may be invaded in various ways, opening the door for claims such as the one that Bette Midler asserted five years later in California.101


In 1985, Ford Motor Co. and their advertising company, Young & Rubicam, Inc., embarked on a campaign to advertise the Ford Lincoln Mercury.102 Young & Rubicam approached Bette Midler, a nationally-known actress and singer, to reprise the song "Do You Want to Dance," which she had made popular on her 1973 recording, *The Divine Miss M.*103 However, Midler declined to associate herself with the advertising campaign.104 Undaunted, the advertising agency sought out Ula Hedwig, a former Midler backup singer, and "told [her] to 'sound as much as possible like the Bette Midler record,' . . . ."105 Bette Midler sued both Ford and Young & Rubicam.106

The court first noted that section 3344 was of no help to Midler, as

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96. 698 F.2d 831 (6th Cir. 1983).
97. The Sixth Circuit felt that "the district court's conception of the right of publicity [was] too narrow." *Id.* at 835.
98. *Id.* at 833. Carson left *The Tonight Show* in 1992, after thirty years as the host. Lisa Gubernick & Peter Newcomb, *The Top 40*, *FORBES*, Sept. 27, 1993, at 97. Thus, Carson had one of the most high profile and recognizable jobs in television.
100. *Id.* at 835.
101. *See infra* part II.D.2.
103. *Id.*
104. *Id.*
105. *Id.*
106. *Id.* at 460-61.
the defendants did not use her "name, voice, signature, photograph, or likeness, in any manner."

The court did, however, use section 3344's companion statute, section 990, to reach its conclusion. Since section 990 creates a "property right" in the holder of the statutory right of publicity, the court analogized that the holder of a common law right must also hold a corresponding property right. Next, the court returned to its reasoning in Motschenbacher, that an individual holds a proprietary right in his own identity that a court may recognize and protect. Thus, finding that Midler owned what was now a property right, the court used Motschenbacher to conclude that Midler was entitled to a cause of action for voice misappropriation under California common law.

Reversing the district court's summary judgment in favor of the defendant, the Midler court formulated a cause of action known today as voice misappropriation: "We hold only that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California."

After creating this new extension of the right of publicity, the court carved out what appeared to be a possible exception, but unfortunately failed to give subsequent courts any guidance as to how to apply the tort. After asserting that "to impersonate [one's] voice is to pirate [his] identity," the court stopped short of full endorsement of the tort, stating that they "need not and do not go so far as to hold that every imitation of a voice to advertise merchandise is actionable." It is upon this untested statement of the law that the Waits court relied in order to further expand the right of publicity in California.

107. Midler, 849 F.2d at 460-61.
109. Midler, 849 F.2d at 463.
110. Id.
111. See supra notes 85-88 and accompanying text.
112. Midler, 849 F.2d at 463. Far from feeling that it had stretched Motschenbacher to new limits, the court relied on the assertion that a voice is a much more personal aspect of one's identity than is a car. Id.
113. Midler, 849 F.2d at 463.
114. Id.
III. THE WAITS COURT

A. Waits v. Frito-Lay, Inc.—Statement of the Facts

Tom Waits is a professional singer who has recorded over seventeen albums and has gained a loyal following. The Waits court noted that he was not a "musical superstar" but rather a "prestige artist." Waits' voice has been described as "raspy... like how you'd sound if you drank a quart of bourbon, smoked a pack of cigarettes, and swallowed a pack of razor blades." Waits maintained a policy of avoiding commercial endorsements, and he made his position publicly known. In part, Waits' reluctance to participate stems from his regret after once doing a dog food commercial, after which Waits felt that he had "betrayed himself." Crucial to the plaintiff's case was the fact that Waits had rejected a previous offer by Frito-Lay's advertising agency to endorse Diet Coke. In fact, the defendants had "never heard anybody say no so fast in [their] lives."

In 1988, Frito-Lay initiated a radio advertising campaign to promote its new Doritos corn chip, SalsaRio Doritos. Co-defendant Tracey-Locke, Inc., Frito Lay's advertising agency, created the campaign in question. In keeping with the spicy flavor of the chips, Tracey-Locke...
created a jingle that would tie into its radio, print and television campaign.124 During the initial creative meetings, Tracey-Locke decided that a "lively/upbeat/jazzy" style would be appropriate for the campaign,125 a feeling expressed in the Tom Waits song, "Step Right Up." In this song Waits, ironically enough, mocks the advertising business by delivering a "string of advertising cliches" in a deep, raspy voice.126 Tracey-Locke decided to use Stephen Carter, a singer who, unbeknownst to the defendants at the time,128 was an avid Tom Waits fan and could imitate Waits fairly well.129 Tracey-Locke proceeded to produce a commercial that Waits alleged was a combination of two of Waits' creations. Waits claimed that the scat style of singing was culled from the song "Step Right Up," while the ambience for the jingle (a smoky, crowded bar, late at night, glasses clinking) was taken from another Waits album, Nighthawks at the Diner.130 Waits sued Frito-Lay and Tracey-Locke under both the Midler common law voice misappropriation tort and false endorsement under section 43(a) of the Lanham Act.131

124. The tongue tickler was as follows: "Tickle your taste on the tangy tomatoes, playful peppers, oodles of onions, and sassy spices of the new SalsaRio Doritos." Id.
125. Id.
126. TOM WAITS, Step Right Up, on SMALL CHANGE (Elektra/Asylum Records 1976).
127. Appellee's Answering Brief at 6, Waits (No. 90-55981).
128. Appellant's Opening Brief at 10, Waits (No. 90-55981).
129. Apparently, Carter's imitation was good enough to evoke a "stunned reaction" from those present in the recording studio. Appellee's Answering Brief at 9, Waits (No. 90-55981).
130. Id. at 23. TOM WAITS, NIGHTHAWS AT THE DINER (Elektra/Asylum Records 1976).
131. Waits, 978 F.2d at 1096. The Lanham Act, 15 U.S.C. § 1125 (Supp. 1988), is primarily concerned with unfair competition. Section 1125(a) reads:

Any person who, on or in connection with any goods or services . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof, . . . or false or misleading representation of fact, which-

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

(2) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.
B. The Ninth Circuit's Holding

Relying upon the underlying tort of voice misappropriation laid out in *Midler*, the Ninth Circuit Court of Appeals upheld the district court's finding that the defendants had infringed upon Waits' common law right of publicity and upheld the punitive damages award of two million dollars.\(^{132}\) The court affirmed that the trial court’s jury instructions accurately stated California law.\(^{133}\) The court also affirmed Waits' claim under the Lanham Act, finding that the “evidence was sufficient to support the jury’s findings that consumers were likely to be misled by the commercial into believing that Waits endorsed SalsaRio Doritos.”\(^{134}\)

The court began its analysis by reaffirming its prior statement of the law in *Midler*, that the tort of voice misappropriation occurs “when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product . . . .”\(^{135}\) The court also upheld the application of the voice misappropriation tort in *Waits*, rejecting attacks by Frito-Lay against three elements of the jury instructions: (1) the difference between “voice” and “style;” (2) the definition of “distinctiveness;” and (3) the definition of “widely known.”\(^{136}\) These three elements found in *Midler* had received no subsequent judicial interpretation following *Midler*, and were, therefore, vague standards when applied in *Waits*.\(^{137}\)

IV. MISAPPLICATION OF MIDLER

A. Jury Instructions

1. “Voice” v. “Style”

“Voice” is defined as “a sound made through the mouth.”\(^{138}\) “Style,” on the other hand, is a “specific or characteristic manner of

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133. Id. at 1102.
134. Id. at 1111.
135. Id. at 1098 (quoting *Midler* v. Ford Motor Co., 849 F.2d 460, 463 (9th Cir. 1988)).
137. For example, the Ninth Circuit admitted that neither *Waits* nor *Midler* defined distinctiveness. *Id.* at 1102.
expression." From these basic definitions, it is clear that what was appropriated in Waits was a singer's style of singing, not his voice. Frito-Lay proposed instructions that attempted to delineate the difference between what would be protected "voice" under the Midler standard and what would merely be one's "style" of performance, which both parties agreed was not protectible under Midler. The court held that the instructions given were adequate to inform the jury that there were two causes of action, namely a right of publicity claim and a Lanham Act claim and, questionably, that the jury was capable of understanding that the two doctrines did not mix.

The problem was enhanced by the presentation of the jury instructions, as they were unclear in both their statement of the law and in their order of presentation. In giving the jury instructions, Judge Ideman merely echoed the previous holding of the Ninth Circuit in Midler: "You must decide (1) whether Tom Waits has a distinctive voice, (2) whether Tom Waits' voice is widely known, (3) whether Tom Waits' voice was deliberately imitated by defendants in order to sell [a product], and if so, (4) whether Tom Waits suffered damage as a result." This instruction came as number forty-four in a long series of instructions which, taken as a whole, would confuse the jury on the application of "voice" versus "style." For example, in instruction number twenty-five, the court had instructed the jury as to the Lanham Act claim: "To establish his claim against [the defendants] ... Tom Waits must prove by a preponderance of the evidence [that] ... (1) Tom Waits' voice, singing style, songwriting style, and/or manner of representation are sufficiently distinctive that when heard, they suggest that Mr. Waits is the source of the recording in question." In the very next instruction (number twenty-six), Judge Ideman reinforced the legal importance of style in instructing the jury on the evidence of confusion: "[Y]ou may also consider: (1) The distinctiveness ... of Tom Waits' voice, songwriting style ...; (2) The similarity between ... Tom Waits' songwriting style, and the songwriting style on the ... commercial ... and ...; (4) The intent of [defendants] in using the ... songwriting style, and manner of presentation embodied in the

139. Id. at 1810. Defendant's expert witness also "testified that style is 'the manner in which the performer presents the number.'" Appellant's Opening Brief at 13, Waits (No. 90-55981).
140. See infra note 146.
141. Waits' attorney agreed that "style was not protected." Waits, 978 F.2d at 1101.
142. Id.
144. Court's Instruction No. 25, Id. (emphasis added).
commercial.\textsuperscript{145} Consequently, the trial court infused the element of style into its jury instructions. However, the Ninth Circuit held that the instructions were sufficiently clear to allow the jury to understand the distinction between "voice" and "style."\textsuperscript{146} This conclusion assumes that the jury understood that \textit{explicit inclusion} of style in one instruction meant \textit{implicit exclusion} of style from the later instructions. Indeed, the defendants' requested jury instructions that, if given when the right of publicity instructions were given, would have reinforced the rule that style was not protectible under the right of publicity.\textsuperscript{147} Lacking these qualifying instructions, it is doubtful whether the jurors (or any individual unfamiliar with such subtle legal distinctions) made the leap of reason required to properly distinguish the difference between "voice" and "style."

2. "Distinctive"

The second crucial element of the \textit{Midler} tort is the requirement that the individual's voice be distinctive.\textsuperscript{148} At the outset, it should be recognized that, without more, a legal requirement of "distinctiveness" is "a defective standard because of the inordinate difficulty in creating a judicially workable or enforceable standard of uniqueness."\textsuperscript{149} Giving jury instructions requiring that the jury merely find one's voice to be

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\textsuperscript{145} Court's Instruction No. 26, \textit{Id} (emphasis added).
\textsuperscript{146} \textit{Waits}, 978 F.2d at 1101.
\textsuperscript{147} These instructions attempted to define "style." Although style had not been defined by the Ninth Circuit as a legal term of art, the \textit{Waits} court apparently thought that a definition was not necessary. The instruction read, in pertinent part:

\begin{quote}
Style is the way, manner, or method of carrying out an activity . . . . In contemporary music, there are a great many styles or "sounds," for example . . . blues, dixieland, country and western, rock, rap, rhythm and blues, etc. Style is \textit{how} a song is sung, how the music is delivered, how the words of a song are expressed. Style includes mood, phrasing, and timing, whether a selection is performed loudly or quietly, whether the song is expressed in singing, talking, or a combination of the two. Style is not subject to ownership. No singer can appropriate for himself any style and exclude others from performing in the same style. Any singer is free to sing in the same style as any other singer. That is why we have a great many opera singers, blues singers, country-western singers, etc. Defendants could not be held liable to plaintiff merely because the singer in their commercial performed in the same style as the plaintiff has performed in.
\end{quote}

\textit{Waits}, 978 F.2d at 1100-1101 n.2.
\textsuperscript{148} \textit{Midler}, 849 F.2d at 463.
\end{flushleft}
“distinctive” is not enough without providing further guidelines or parameters for the jury to follow in reaching a conclusion. A juror might well ask, “Distinctive in relation to what?” Consequently, the Ninth Circuit has interpreted this element to mean recognizability rather than distinctiveness.

Frito-Lay argued that the instructions did not sufficiently create a difference between having a “distinctive” voice and a merely identifiable or recognizable voice. Frito-Lay presented expert evidence at trial asserting that: (1) identifiability is enhanced by a listener’s expectations; and (2) that recognizability is increased by style similarity.

However, the court refused to acknowledge that a legal distinction exists between distinctive and identifiable, asserting that “[i]dentifiability is properly considered in evaluating distinctiveness....” The court believed that the use of the jury’s “common sense” was a sufficient guide for determining what constituted the “minimum threshold of identifiability.”

In the context of voice misappropriation, “distinctive” should indicate that the characteristic in question is capable, upon presentation, of clearly separating itself from all others with similar characteristics. However, lacking guidance from Midler, the standard set forth by the Ninth Circuit fails this test. In Waits, the Ninth Circuit attempted for the first time to establish with legal certainty the meaning of “distinctive” by stating that “[a] voice is distinctive if it has particular qualities or characteristics that identify it with that particular singer.”

The instructions closed the universe to the jury and prohibited them from considering the relationship between Waits’ voice and any other similar voice that they might have

150. Midler, 849 F.2d at 463. In attempting to describe its approach to distinctiveness, the Midler court offers the analogy that “[w]e are all aware that a friend is at once known by a few words on the phone.” Id. This, of course, says nothing about what legal standard the court is applying to “distinctive,” because it is not a standard which a jury could apply with any degree of reliability. Similarly, in Waits the Ninth Circuit failed to provide the jury with a workable legal definition of distinctiveness, bowing out by asserting that “[t]he court was not required to formulate instructions endorsing expert opinions which lacked legal foundation.” Waits, 978 F.2d at 1102. While the court is correct in claiming that they do not have to adopt the view of one party’s expert witness, they must still adopt some view which can be clearly and easily understood and applied by a jury.

151. Waits, 978 F.2d at 1102.
152. Id.
153. Id.
154. Id.
155. Court’s Instruction No. 45, Waits v. Frito-Lay, Inc., 978 F.2d 1093 (9th Cir. 1992). This definition fails in its essential function, as it tells the jury nothing more than, if the voice merely sounds like someone that you have heard, then a remedy may be found.
heard in a sound recording (for example, Louis Armstrong's).

In order to rise to the level of a workable legal standard that can be uniformly applied by a jury, distinctiveness in a pure voice misappropriation case requires an analysis of other singers. The court should allow the jury to decide whether the individual charging appropriation can be said to have a voice so original that the listener would immediately know its source, or whether the listener could confuse the voice with other similar singers. This standard may be applied more loosely where other factors are involved, and the case is not based solely upon the performer's voice. For example, the use of Bette Midler's voice in a commercial for Ford automobiles was recognizable because the defendants in that case used the voice in conjunction with a song that Midler had previously made popular. In effect, the combination of the voice with the song narrowed the available field of reference upon which the defendants could rely in claiming they had not appropriated her voice. The two factors, taken together, created an aural image of Midler because they constituted objective elements which one could look to in order to find a deliberate appropriation.

3. "Widely Known"

The court instructed the jury that, to meet the Midler requirement of "widely known," a singer's voice must be "known to a large number of people throughout a relatively large geographic area." The defendants contended that Waits was a cult figure; he was a singer who might have amassed critical success, but hardly met the level of commercial success of Bette Midler. The defendants requested jury instructions clarifying what would satisfy a "large number of people throughout a relatively large geographic area."

The distinction between the court's instructions and the defendants' proposed instructions becomes irrelevant, however, when analyzing the court's application of Midler. The Midler court held "that when a

156. Waits, 978 F.2d at 1102.
158. The requested instruction was:

A professional singer's voice is widely known if it is known to a large number of people throughout a relatively large geographic area. On the other hand, a professional singer whose voice is known only to a small number of people in a relatively small geographic area (i.e., a neighborhood, a single city) does not have a voice that is "widely known."

Appellant's Opening Brief at 20-21, Waits (No. 90-55981).
distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have . . . committed a tort in California." This statement of the law mandates that, in order to recover under Midler, the plaintiff must be "widely known." However, relying upon Motschenbacher, the court found that "'well known' is a relative term, and differences in the extent of celebrity status are adequately reflected in the amount of damages recoverable." Thus, after explicitly relying upon the Midler tort in finding the defendants liable, the court essentially ignored the Midler analysis by creating an inference that even if Tom Waits was only known to fifty people, he would still recover under Midler. In so doing, the Waits court effectively eliminated the "widely known" requirement.

V. IMPLICATIONS OF WAITS

The advertising industry is most at risk from the Waits decision. One of the mainstays of advertising is celebrity endorsement. When the public recognizes a celebrity appearing in a commercial endorsing a particular product, sales of that product benefit by the association between the individual and the product. Thus, advertisers look to hire well-known celebrities in order to maximize that association and therefore profit. Performers who are highly recognizable can name their price when approached with endorsement deals, because their goodwill is easily transferred to the product being sold.

159. Midler, 849 F.2d at 463 (emphasis added).
160. 498 F.2d 821 (9th Cir. 1974).
161. Waits, 978 F.2d at 1102.
162. When TDK, an audio tape manufacturer, aligned with Stevie Wonder, their goal was to sell six million tapes in six months, but the company reached that sales mark in only four months. Pamela G. Hollie, A Rush for Singers to Promote Goods, N.Y. TIMES, May 14, 1984, at D1. Similarly, when singer Michael Jackson entered into an endorsement contract with athletic shoe maker L.A. Gear, officials at the shoe company attributed a nine point stock rise to the press conference announcing the deal. Patrick Goldstein, L.A. Gear's $20 Million Poster Boy, L.A. TIMES, Sept. 24, 1989, at F64.
Music is often used to pair products and performers. Advertising companies use musicians because they can "deliver a targeted audience and [they] have a special appeal and image." Many singers find a lucrative side business in endorsements by singing their songs in ad campaigns. However, some performers do not wish to have their personas identified with commercial products through advertising, as such conduct is seen to detract "from their artistic integrity." Traditionally, these performers had no recourse when an advertiser, in order to sell a product, either imitated a voice or used a sound-alike to sing a song that the performer had made popular. However, the Ninth Circuit's attempt to remedy this situation offers performers a potent tool in the expanded right of publicity. 

The advertising industry is feeling the impact of the Midler and Waits decisions. It is no coincidence that a spate of right of publicity suits alleging sound-alike claims followed immediately on the coattails of Midler at D6 (contracting with Johnson for three million dollars). L.A. Gear signed then-San Francisco 49er quarterback Joe Montana for three to five million dollars, and video game manufacturer Sega of America, Inc. threw Montana a deal that was reported to be in excess of the amount paid by L.A. Gear. Don Clark, Joe Montana's Huge New Ad Contract, S.F. CHRON., March 22, 1990, at A1.

The importance of this concept is clear when one watches how the advertising agencies react when a superstar becomes embroiled in controversy. For example, after Burt Reynolds' "messy split" with wife Loni Anderson, the bad press that followed prompted the Florida Citrus Commission to pull all of its ads featuring the actor. Jeffry Scott, The Draw of Celeb Endorsers May Start To Feel Like A Drag, ATLANTA J. AND CONST., Sept. 7, 1993, at F3. Similarly, Magic Johnson lost a number of endorsements after he announced that he had contracted HIV. Jeff Giles, The Risks of Wishing Upon A Star, NEWSWEEK, Sept. 6, 1993, at 38. Pepsi officials stated that they were "watching events closely in the police investigation into allegations that . . . Michael Jackson sexually abused a 13-year-old boy." Scott, supra, at 3. One advertising executive believed that "Pepsi [would] . . . divorce themselves in a gentle way." Giles, supra, at 38.

165. Hollie, supra note 162, at D1.

166. Id.


168. Midler, 849 F.2d at 461 (performer refused to endorse commercial product); Waits, 978 F.2d at 1097 (performer's dislike of commercial endorsements known in the industry). "Some . . . writers feel that any identification with the selling of a consumer product can damage the future potential of a copyright as it may hinder additional new recordings or other uses." Brabec, supra note 167, at 347.

169. Waits, 978 F.2d at 1097.

and Waits. Guitarist Carlos Santana recently reached a settlement agreement with Miller Brewing Co. and the advertising firm of Backer Spielvogel Bates Inc. after Santana sued, claiming an infringement of his right of publicity.\footnote{Jim Doyle, Carlos Santana Sues Over TV Ad, S.F. CHRON., Oct. 16, 1990, at A2; David Savage, Supreme Court Upholds Copyright Ruling, L.A. TIMES, March 24, 1992, at F4.} However, Santana's suit took the right of publicity concept to a new level: Santana claimed that the guitar in a beer commercial imitated Santana's version of "Black Magic Woman."\footnote{Doyle, supra note 171, at A2.} Interestingly, Santana \textit{did not own the copyright to the song}, but claimed that the song had become inextricably entwined with Santana's persona.\footnote{Id.} Similarly, and notably, after Santana's settlement, guitarist and singer Chris Isaak recently "demanded that Infiniti Motor Car Co. stop running an ad that feature[d] what he call[ed] a sound-alike guitar instrumental lifted from Isaak's 1990 hit 'Wicked Game.'"\footnote{Id.} Uri Geller, a noted psychic, sued the agency in charge of Timex's advertising, claiming that they infringed on his right of publicity by portraying a "spoon-bender" in one of their ads.\footnote{Marcy Magiera, Midler "Sound-Alike" Win Means Creative Changes, ADVERTISING AGE, Nov. 6, 1989, at 2.} One day after the Midler decision was handed down, singer Patti Page notified advertising agency AsherGould that she was going to "file suit over a TV commercial the agency created . . . The spot . . . included a rendition of 'Old Cape Cod,' a number popularized by Ms. Page in the late 1950s."\footnote{Id.} Bobby Darin's heirs jumped into the fray recently when they sued McDonald's Corporation and their advertising agency, Davis, Ball, and Colombatto, for ten million dollars, alleging that the ad agency infringed upon Darin's right of publicity by airing a commercial with a rendition of "Mack the Knife" in its "Mac Tonight" ad campaign (referring to the Big Mac, a popular hamburger sold at McDonald's).\footnote{Id.}

Fortunately, some courts are maintaining their stance against the uncontrollable expansion of the right of publicity: a district court in Detroit recently dismissed a suit filed by singer Mitch Ryder against Molson Breweries of Canada and advertiser MacLaren: Lintas, Toronto.\footnote{John Cortez, Sound-Alikes Get Court Win, ADVERTISING AGE, Nov. 19, 1990, at 51.} The suit claimed that Molson and its advertising agency infringed upon Ryder's
right of publicity by producing an advertisement featuring a sound-alike version of Ryder's song, "Devil With A Blue Dress On." 179

The problem with the right of publicity in these cases is that there is no clearly defined right and there are no guidelines to follow to avoid a violation of that right. If the trend established by the Ninth Circuit continues and extends to other jurisdictions, the question will become how far can the Ninth Circuit reasonably slide down that slippery slope? Judge Kozinski expressed his concern in White:

[It] may seem unfair that much of the fruit of a creator's labor may be used by others without compensation. But this is not some unforeseen byproduct of our intellectual property system; it is the system's very essence. Intellectual property law assures authors the right to their original expression, but encourages others to build freely on the ideas that underlie it. This result is neither unfair nor unfortunate: It is the means by which intellectual property law advances the progress of science and art. 180

Advertisers will be forced to conduct extensive research to ensure that every image that they use in their advertisements does not resemble or sound like an individual that has already established the style portrayed in the ad as their style of performing. This becomes an almost impossible task, because the vague standard followed by the Waits court makes it unlikely that an advertiser could determine any but the most obvious cases through foresight. Because the monopoly that is conferred on a performer through a right of publicity claim is unlimited, the potential for abuse is frightening.

VI. CONCLUSION

Clearly, performers that have a commercial interest in their likenesses or identities should have the right to reap the benefits of what they have sown. In cases like Midler, the right of publicity may be the appropriate vehicle for this recovery. On the other hand, there are some circumstances in which the application of this right is completely out of place. When an individual sings a certain way (e.g. Tom Waits), plays the guitar a certain way (e.g. Carlos Santana), dances a certain way (e.g. Fred Astaire), tells a

179. Id.
joke a certain way (e.g. Andrew "Dice" Clay), takes a photograph a certain way (e.g. Ansel Adams), or paints a picture a certain way (e.g. Georgia O'Keefe), the question arises as to whether the courts should prevent any and all future artists and performers from adopting that style or approach, unless they first buy the rights from the original performer. If the right of publicity exists as the Waits court asserts, then Tom Waits should have to buy the rights to sing the way that he does from the estate of Louis Armstrong. The question also arises as to who is the original creator of a style, and therefore to whom an individual must turn in order to buy the rights to perform and make a living using that style.

If the Ninth Circuit insists on choosing the right of publicity for a Waits-type recovery, the very least it can do is make a sincere attempt to define the elements of the Midler tort so that future parties will have an idea as to what exactly constitutes its violation. If it does not, all that an individual will need to do to drag a defendant into court is assert that the defendant has appropriated some aspect of his identity. If successful in court (which is the most likely result in California) that individual will be able to prevent any future party from using that style of expression. More likely, the owner of the right of publicity will reap the windfall that accompanies a monopoly.

Christopher Menjou*

* The author would like to dedicate this Note to his wife Wendy for her unconditional love and support and thank her for giving this life meaning.