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Kimberly Lehman Turner

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“DO YOU WANT TO DANCE” AROUND THE LAW? LEARN THE LATEST STEPS FROM THE NINTH CIRCUIT IN *MIDLER V. FORD MOTOR COMPANY*

I. INTRODUCTION

The common-law right of publicity doctrine has traditionally been invoked to protect an individual's pecuniary interest in his or her name or likeness.¹ The doctrine basically recognizes the commercial value of a public figure's identity and grants that person a monopoly in his or her own persona.² However, the scope of protection afforded by the right of publicity doctrine is unclear. Until recently, courts limited the application of the doctrine to protect only a person's name,³ nickname,⁴ visual likeness,⁵ performance,⁶ originally created character,⁷ or distinctive voice not fixed in a particular copyrighted song.⁸ The courts had previously rejected the idea of extending the right of publicity to prevent one from imitating an artist's voice when singing a *licensed* song, since the imitator obtained permission from the copyright holder to use the song in any way.⁹ As a result of this treatment by the courts, the adage “imitation alone does not give rise to a cause of action”¹⁰ held firm—until the 1988 case of *Midler v. Ford Motor Co.*¹¹

In *Midler*, the Ninth Circuit extended the common-law right of publicity to prevent the commercial exploitation of performer Bette Midler's

1. J. MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 4.9, at 4-49 (1989). *See also* Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953).

2. *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 728 (S.D.N.Y. 1978).

3. *Id.*; *see also* Uhlaender v. Henricksen, 316 F. Supp. 1277, 1282 (D. Minn. 1970); *Wyatt Earp Enters., Inc. v. Sackman, Inc.*, 157 F. Supp. 621, 624 (S.D.N.Y. 1958).

4. *See, e.g.*, *Hirsch v. S.C. Johnson & Son, Inc.*, 90 Wis. 2d 379, 397, 280 N.W.2d 129, 137 (1979).

5. *See, e.g.*, *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 827 (9th Cir. 1974); *Ali*, 447 F. Supp. at 729; *Factors Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279, 285 (S.D.N.Y. 1977); *Grant v. Esquire, Inc.*, 367 F. Supp. 876, 881 (S.D.N.Y. 1973).

6. *See Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576 (1977).

7. *See, e.g.*, *Price v. Worldvision Enters., Inc.*, 455 F. Supp. 252, 257-59 (S.D.N.Y. 1978), *aff'd*, 603 F.2d 214 (2d Cir. 1979).

8. *See Lahr v. Adell Chem. Co.*, 300 F.2d 256, 259 (1st Cir. 1962).

9. *See, e.g.*, *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 718 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971); *Davis v. Trans World Airlines*, 297 F. Supp. 1145, 1147 (C.D. Cal. 1969).

10. For cases using this language, *see Sinatra*, 435 F.2d at 713; *Davis*, 297 F. Supp. at 1147; *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 345 (S.D.N.Y. 1973).

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

voice, even though the defendants had obtained a license from the copyright holder to use the song she sang.¹² Although the court ultimately recognized that the public is able to identify a performer by the sound of his or her voice,¹³ it chose a peculiar route to grant Ms. Midler protection. The court struggled to distinguish precedent, employing hollow reasoning to stretch the right of publicity doctrine to protect The Divine Miss M's¹⁴ rendition of the song, "Do You Want To Dance."¹⁵

This Note analyzes the *Midler* decision in light of contrary precedent. It further suggests an alternative analysis which would have allowed the Ninth Circuit to arrive at the same conclusion by applying existing statutory law.¹⁶ Next, this Note explores the potential conflict between the new law created by the Ninth Circuit and the Copyright Act of 1976. This conflict, briefly stated in the context of *Midler*, is that even if Midler is protected by California state law, federal copyright law may preempt her claim.¹⁷ Finally, this Note proposes a possible reconciliation between the state law which protects the performer, and the federal law which protects the licensed owner of the copyright.¹⁸

II. STATEMENT OF THE CASE: *MIDLER V. FORD MOTOR CO.*

In 1985, Ford Motor Company, along with its advertising agency, Young & Rubicam, began a campaign to advertise Ford's new Mercury Sable.¹⁹ They commenced "The Yuppie²⁰ Campaign," which was designed to lure young, affluent consumers into Ford dealerships by connecting the image of the car to the target consumer's fond memories of college in the 1970s.²¹ To generate this connection, Ford, through Young & Rubicam, decided to have vocal stars sing popular hit songs of the 1970s in Ford's television commercials.²²

Young & Rubicam approached Bette Midler's agent, inquiring

12. *Id.* at 462.

13. *Id.* at 463.

14. *Id.* at 461. "The Divine Miss M" is the name of Bette Midler's 1973 album featuring the song "Do You Want To Dance." *Id.*

15. *Id.* at 462.

16. See CAL. CIV. CODE § 3344 (West 1984). See *infra* notes 109-216 and accompanying text for a discussion of California Civil Code section 3344.

17. See *infra* notes 310-403 and accompanying text for a discussion of federal preemption.

18. See *infra* notes 404-33 and accompanying text for a discussion of the proposed resolution.

19. *Midler v. Ford Motor Co.*, 849 F.2d 460, 461 (9th Cir. 1988).

20. The term "Yuppie" is an acronym which stands for a "young upwardly mobile professional." J. GREEN, *THE DICTIONARY OF CONTEMPORARY SLANG* 315 (1984).

21. *Midler*, 849 F.2d at 461.

22. *Id.*

whether Midler would participate in the campaign by singing "Do You Want To Dance," a selection from her 1973 album, "The Divine Miss M."²³ After receiving a flat rejection from Midler's agent,²⁴ Young & Rubicam decided to use a "sound-alike"²⁵ to imitate Midler's voice.²⁶ They contacted Ula Hedwig, a backup singer for Midler for ten years.²⁷ The agency asked Hedwig to make a tape of "Do You Want To Dance," and to sound as much like Midler as possible.²⁸ After Young & Rubicam heard the tape, Hedwig was hired and produced a final recording for the commercial.²⁹

After the commercial aired publicly, Midler was told by many people that it sounded exactly like her rendition of "Do You Want To Dance."³⁰ Also, many people praised Hedwig for her ability to imitate Midler's voice.³¹ Subsequently, Midler sued Ford and Young & Rubicam, stating a cause of action in tort, based on the unauthorized use of a Midler sound-alike in a commercial.³²

The trial court was initially sympathetic to Midler, equating the behavior of both Ford and Young & Rubicam to that of the "average thief."³³ However, the court held that since Young & Rubicam had obtained permission from the copyright holder to use the song, there was no legal principle preventing them from imitating Midler's voice.³⁴ The trial court therefore granted summary judgment in favor of the defendants.³⁵ Midler then appealed to the United States Court of Appeals for

23. *Id.* Young & Rubicam had a license from the copyright holder to use the song "Do You Want To Dance." *Id.* at 462.

24. The conversation between Craig Hazen from Young & Rubicam and Jerry Edelstein, Midler's agent, went as follows:

Hazen: Hello, I am Craig Hazen from Young & Rubicam. I am calling you to find out if Bette Midler would be interested in doing . . . ?

Edelstein: Is it a commercial?

Hazen: Yes.

Edelstein: We are not interested.

Id. at 461.

25. The term "sound-alike" refers to one who imitates an artist's voice and manner of expression for compensation. Telephone interview with Justin Pierce, Vice President of Special Projects for New World Entertainment (Sept. 6, 1989).

26. *Midler*, 849 F.2d at 461.

27. *Id.*

28. *Id.*

29. *Id.*

30. *Id.* at 461-62.

31. *Id.* at 462.

32. *Id.*

33. *Id.*

34. *Id.*

35. *Id.*

the Ninth Circuit.³⁶

III. REASONING OF THE COURT

Before examining Midler's causes of action, the Ninth Circuit addressed Ford's three arguments for dismissal of Midler's claim: (1) that the first amendment³⁷ protects the rights of the media to reproduce sound;³⁸ (2) that the federal Copyright Act³⁹ preempts Midler's claim;⁴⁰ and (3) that the rule of *Sinatra v. Goodyear Tire & Rubber Co.*⁴¹ prevents Midler's recovery.⁴²

Starting with Ford's first amendment argument, the court noted that the freedoms of speech and of the press are of primary importance in our society.⁴³ Consequently, the court reasoned, the first amendment protects a substantial amount of the media's reproduction of likenesses and sound.⁴⁴ However, the court held, the extent of the media's freedom depends upon its purpose in using someone's identity.⁴⁵ The court announced that if the media's use of a person's identity serves no "informative or cultural" purpose "but merely exploits the individual portrayed, immunity will not be granted."⁴⁶ The court implied that the defendants had imitated Midler's voice for an advertisement serving no "informative or cultural" purpose.⁴⁷ Therefore, imitation of Midler's voice was not protected by the first amendment.⁴⁸

The court then discussed preemption by federal copyright law, specifically section 114(b) of the Copyright Act.⁴⁹ The Notes of the Committee on the Judiciary for section 114(b) provide that "[m]ere imitation

36. *Id.*

37. U.S. CONST. amend. I.

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

39. Copyright Act of October 19, 1976, Pub. L. No. 94-553, §§ 101-810, 90 Stat. 2541-2602 (1976) (codified at 17 U.S.C. §§ 101-810 (1982)).

40. *Midler*, 849 F.2d at 462.

41. 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971). See *infra* notes 284-309 and accompanying text for a discussion of *Sinatra*.

42. *Midler*, 849 F.2d at 462.

43. *Id.* (citing *Time, Inc. v. Hill*, 385 U.S. 374, 388 (1967)).

44. *Id.*

45. *Id.*

46. *Id.* (quoting Felcher & Rubin, *Privacy, Publicity and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1596 (1979)).

47. See *id.*

48. *Id.*

49. 17 U.S.C. § 114(b) (1982). Section 114(b) provides in relevant part: "[t]he exclusive rights of the owner of copyright in a sound recording . . . do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording." *Id.*

of a recorded performance [does] not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible."⁵⁰ Pursuant to its language, section 114(b) would appear to authorize the defendants' imitation of Midler's rendition of the song.⁵¹ However, the court stated that Midler's claim was not for the use of the song, but for the imitation of her voice.⁵² Therefore, the court held that Midler's claim was not a copyright claim and was not preempted by federal copyright law.⁵³

Finally, the court turned to the *Sinatra* case in which the Ninth Circuit denied Nancy Sinatra relief⁵⁴ on facts very similar to *Midler v. Ford Motor Co.*⁵⁵ In that case, Sinatra sued Goodyear Tire & Rubber Company for its advertising campaign devised by Young & Rubicam, using a sound-alike performer to imitate Sinatra's song, "These Boots Are Made For Walkin'."⁵⁶ Sinatra based her claim against the defendant on the theory that the song had acquired a secondary meaning.⁵⁷ The term "secondary meaning" refers to an association formed in the mind of the consumer which links an individual product (song) with its producer (singer).⁵⁸ Sinatra argued that since the song had acquired a secondary meaning, the public associated the song with her.⁵⁹ As a result, she claimed that the defendant's use of the song constituted unfair competition.⁶⁰ The *Sinatra* court rejected her claim and held that since the defendant had obtained a license to use the song from the copyright owner,

50. 17 U.S.C.A. § 114(b) notes of committee on the judiciary (West 1977).

51. See 17 U.S.C. § 114(b) (1982).

52. *Midler*, 849 F.2d at 462.

53. *Id.* The court stated that Midler's claim was not a copyright claim because "[a] voice is not copyrightable." *Id.*

54. *Sinatra*, 435 F.2d at 718.

55. 849 F.2d 460 (9th Cir. 1988).

56. *Sinatra*, 435 F.2d at 712.

57. *Id.*

58. BLACK'S LAW DICTIONARY 1212-13 (5th ed. 1979).

59. *Sinatra*, 435 F.2d at 712.

60. *Id.* at 714. The term "unfair competition" applies generally to any dishonest or fraudulent rivalry in trade and commerce. See generally *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 187 (1896). The term is particularly applied to the practice of endeavoring to substitute one's own goods or products in the market for those of another who has an established reputation and extensive sales, by means of imitating or counterfeiting the name, title, size, shape, or distinctive peculiarities of the article, or other such simulations, with the imitation being carried far enough to mislead the general public. *Id.* The test of "unfair competition" is not whether a distinction between two competing products can be recognized when placed alongside each other, but whether a purchaser of ordinary prudence would be induced by reason of the marked resemblance in general to mistake one for the other despite differences in matters of detail. *Ralston Purina Co. v. Checker Food Prods. Co.*, 80 S.W.2d 717, 720 (Mo. Ct. App. 1935).

federal copyright law preempted Sinatra's claim.⁶¹

The defendants in *Midler* contended that Midler's claim should have been rejected on the same grounds as in *Sinatra*.⁶² However, the *Midler* court distinguished Sinatra's claim, holding that the *Sinatra* decision was based upon Sinatra's claim of a secondary meaning to the song, "These Boots Are Made For Walkin'" which Midler did not claim for the song, "Do You Want to Dance."⁶³ The court explained that section 102(a) of the Copyright Act⁶⁴ only protects "'original works of authorship fixed in any tangible medium of expression.'"⁶⁵ Unlike Sinatra, Midler was not trying to protect the "fixed" song, but rather her voice, which is not fixed in any tangible medium of expression.⁶⁶ Consequently, the court reasoned that her cause of action was not preempted by section 102(a).⁶⁷

After determining that Midler's claim was not preempted by the Copyright Act, the court discussed Midler's potential rights under state law.⁶⁸ First, the court examined California Civil Code section 3344⁶⁹ and then its companion statute, section 990.⁷⁰

Section 3344 provides for an award of damages when any person "knowingly uses another's name, voice, signature, photograph or likeness, in any manner."⁷¹ The *Midler* court held that the statute did not afford Midler any protection for two reasons. First, the court construed the terms in the statute to protect only the *artist's* attributes and not those of an *imitator*.⁷² Thus, because the voice used was Ula Hedwig's and not Midler's, Midler could not claim protection under the statute.⁷³ Second, the court interpreted the term "likeness" narrowly, encompassing solely "visual image[s]," not "vocal imitations."⁷⁴

Although the court rejected Midler's section 3344 argument,⁷⁵ it afforded her protection through a combination of California Civil Code

61. *Sinatra*, 435 F.2d at 717-18.

62. *Midler*, 849 F.2d at 462.

63. *Id.*

64. 17 U.S.C. § 102(a) (1982).

65. *Midler*, 849 F.2d at 462 (quoting 17 U.S.C. § 102(a)).

66. *Id.*

67. *Id.* See *infra* notes 352-403 and accompanying text for a discussion of the Copyright Act.

68. *Midler*, 849 F.2d at 463.

69. CAL. CIV. CODE § 3344 (West 1984).

70. *Id.* § 990.

71. *Id.* § 3344.

72. *Midler*, 849 F.2d at 463.

73. *Id.*

74. *Id.*

75. *Id.*

section 990,⁷⁶ and the common-law action for misappropriation of property rights.⁷⁷ Section 990 recognizes a "property right" in a *deceased* person's voice.⁷⁸ In order to protect Midler under the common law, the court referred to section 990's creation of a property right in one's voice.⁷⁹ The court reasoned that "[b]y analogy the common-law rights are also property rights."⁸⁰ Therefore, the court implied that a *living* person's distinctive voice is a common-law property right.⁸¹ Under this theory, the court stated, if any common-law property rights are illegally procured, the taker is deemed to have committed the tort of misappropriation.⁸²

In support of its finding of misappropriation, the court relied on its decision in *Motschenbacher v. R.J. Reynolds Tobacco Co.*⁸³ In *Motschenbacher*, a famous race car driver sued a cigarette manufacturer for using a photograph of his distinctive racing car in a commercial endorsement for cigarettes.⁸⁴ Although the plaintiff was pictured in the car, his features were somewhat blurred.⁸⁵ The court held that by using the picture, the defendant misappropriated the plaintiff's proprietary interest in his identity.⁸⁶

76. CAL. CIV. CODE § 990 (West 1984). Section 990 provides in pertinent part:

(a) Any person who uses a deceased personality's name, *voice*, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services, *without prior consent from the person or persons . . .* shall be liable for any damages sustained by the person or persons injured as a result thereof. . . .

(b) The rights recognized under this section are *property rights*, freely transferable, in whole or in part, by contract or by means of trust or testamentary documents, whether the transfer occurs before the death of the deceased personality, by the deceased personality or his or her transferees, or, after the death of the deceased personality, by the person or persons in whom such rights vest under this section or the transferees of that person or persons.

Id. (emphasis added).

77. *Midler*, 849 F.2d at 463.

78. CAL. CIV. CODE § 990(b) (West 1984). Section 990 does not protect a *living* person's voice. Similarly, the common-law tort of misappropriation has not recognized a living person's property right in his or her voice. See *infra* notes 222-83 and accompanying text for a discussion of misappropriation of property rights.

79. *Midler*, 849 F.2d at 463.

80. *Id.*

81. *Id.*

82. *Id.*

83. 498 F.2d 821 (9th Cir. 1974).

84. *Id.* at 822. The photograph of the car was slightly altered in that a "spoiler" was attached to the rear of the car and the number on the side of the car was changed. *Id.* However, many original features were retained, including the red color, the white pinstriping, and an oval medallion. *Id.*

85. *Id.* Many consumers who saw the advertisement believed that the plaintiff had endorsed the product. *Id.*

86. *Id.* at 825.

While the *Midler* court acknowledged that Midler's voice was not used in the commercial, the court extended the rule of *Motschenbacher* to protect Midler by finding that the advertisement created the *impression* that Midler was actually singing.⁸⁷ In *Motschenbacher*, the public's inability to personally identify the plaintiff in the ad was immaterial, since his racing car, which was closely linked to him, was recognizable.⁸⁸ Similarly, the court in *Midler* reasoned that even though Midler's voice was not used in Ford's advertisement, the imitation of her voice caused the public to believe that she was actually endorsing the product.⁸⁹ In both cases, the defendants appropriated an attribute of the plaintiff's identity.⁹⁰

The *Midler* court further supported its conclusion that Ford and Young & Rubicam committed the common-law tort of misappropriation by examining the defendants' common motive in imitating the song.⁹¹ The court pointed out that the defendants would not have solicited Midler's services had her voice not been valuable to them.⁹² Moreover, the court believed the defendants would not have gone to the great lengths of hiring an imitator if they did not wish to appropriate "an attribute of Midler's identity."⁹³

Thus, by sustaining Midler's claim under the common-law tort of misappropriation, the Ninth Circuit recognized a property right in a singer's voice.⁹⁴ However, the court limited its holding to situations in which the "distinctive voice of a professional singer [who] is widely known . . . is deliberately imitated in order to sell a product."⁹⁵ The court reversed the summary judgment against Midler by the lower court and remanded the case for a new trial.⁹⁶

IV. ANALYSIS

The right of publicity is commonly used to encompass several early common-law actions such as misappropriation⁹⁷ and unfair competi-

87. *Midler*, 849 F.2d at 463.

88. *Motschenbacher*, 498 F.2d at 827.

89. *Midler*, 849 F.2d at 463.

90. *Id.*

91. *Id.*

92. *Id.*

93. *Id.*

94. *Id.*

95. *Id.*

96. *Id.* at 463-64. See *infra Postscript*, p. 644 for the results of the new trial.

97. J. MCCARTHY, *supra* note 1, § 5.6[A], at 5-48.1 to -49.

tion.⁹⁸ In fact, commentators often use these terms interchangeably.⁹⁹ Sometimes the right of publicity is “expressly invoked” without the court ever mentioning it by name.¹⁰⁰ One commentator even referred to *Midler v. Ford Motor Co.*¹⁰¹ as a right of publicity case without the Ninth Circuit using that term.¹⁰²

The *Midler* court examined Midler’s interest in her voice by investigating two possible causes of action: (1) whether California Civil Code section 3344¹⁰³ could be interpreted to protect Midler,¹⁰⁴ and (2) whether the common-law right of publicity, specifically the misappropriation doctrine,¹⁰⁵ prevented the defendants from imitating Midler’s voice for commercial advantage.¹⁰⁶ This section analyzes the court’s discussion of both points and finds it markedly flawed. This section also examines the *Midler* decision in light of its contrary precedent, *Sinatra v. Goodyear Tire & Rubber Co.*¹⁰⁷ Finally, this section addresses the possible preemption of Midler’s cause of action by section 114(b) of the Copyright Act of 1976,¹⁰⁸ which the court failed to consider.

A. California Civil Code Section 3344

In California, the right of publicity has been codified in Civil Code section 3344¹⁰⁹ regarding living persons’ rights, and in section 990¹¹⁰ regarding post-mortem rights.¹¹¹ This codification was not meant to displace the common-law right of publicity.¹¹² Therefore, a plaintiff may seek rights under the statute, the common law or both.

California Civil Code section 3344¹¹³ prohibits any person from

98. *Id.* § 4.14[C], at 4-87.

99. *See id.* § 5.6[A], at 5-48.1 to -49; Nimmer, *The Right of Publicity*, 19 L. & CONTEMP. PROBS. 203, 219-20 (1954).

100. Nimmer, *supra* note 99, at 219.

101. 849 F.2d 460 (9th Cir. 1988).

102. *See* J. MCCARTHY, *supra* note 1, § 6.4[D], at 6-25. The court actually protected Midler under a misappropriation theory frequently labelled as the right of publicity. *Id.* § 5.6[A], at 5-48.1 to -49.

103. CAL. CIV. CODE § 3344 (West 1984).

104. *Midler*, 849 F.2d at 463.

105. *See infra* notes 222-83 for a discussion of the misappropriation doctrine.

106. *Midler*, 849 F.2d at 463.

107. 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971).

108. 17 U.S.C. § 114(b) (1982).

109. CAL. CIV. CODE § 3344 (West 1984).

110. *Id.* § 990.

111. J. MCCARTHY, *supra* note 1, § 6.4[E][1], at 6-26 to -26.1.

112. *Id.* § 6.4[F][8], at 6-39 to -40. California Civil Code sections 3344(g) and 990(m) maintain that “[t]he remedies provided for in th[ese] section[s] are cumulative and shall be in addition to any others provided for by law.” CAL. CIV. CODE §§ 3344(g), 990(m) (West 1984).

113. CAL. CIV. CODE § 3344 (West 1984). Section 3344 provides in pertinent part:

knowingly using another's name, *voice*, signature, photograph, or *likeness*, in any manner without first obtaining the person's consent.¹¹⁴ *Midler v. Ford Motor Co.*¹¹⁵ is a case of first impression with regard to section 3344 as it applies to imitators. Unfortunately, the *Midler* court dismissed application of section 3344 because of its unnecessarily narrow interpretation of the terms "voice" and "likeness."¹¹⁶

1. Interpretation of "voice"

The California Legislature amended section 3344 in 1984 by adding the words "voice" and "signature" to subsection (a) of the original 1972 statute.¹¹⁷ The plain language of the statute does not distinguish between the artist's *actual* voice and an *imitator's* voice.¹¹⁸ Therefore, the legislature's broadening of the statute, without qualifying the term *voice*, indicates a legislative intent to encompass *all* unauthorized uses of a voice.¹¹⁹ Instead of interpreting this language broadly to embody all uses of a voice, the *Midler* court essentially imputed the word "actual" before the term "voice." Thus, the court interpreted the term to include only the unauthorized commercial use of the artist's *actual* voice, thereby excluding that of an *imitating* voice.¹²⁰

a. statutory construction

Interpreting the term "voice" to encompass all unauthorized uses of

(a) Any person who knowingly uses another's name, *voice*, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, *without such person's prior consent* . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.

Id. (emphasis added).

114. *Id.*

115. 849 F.2d 460 (9th Cir. 1988).

116. *Id.* at 463.

117. Act effective Jan. 1, 1985, ch. 1704, § 2, 1984 Cal. Stat. 6172 (codified as amended at CAL. CIV. CODE § 3344 (West 1984)). The text of the 1972 statute provides in pertinent part:

(a) Any person who knowingly uses another's name, photograph, or likeness, in any manner, for purposes of advertising products, merchandise, goods or services, or for purposes of solicitation of purchases of products, merchandise, goods or services, without such person's prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof. In addition, in any action brought under this section, the person who violated the section shall be liable to the injured party or parties in an amount no less than three hundred dollars (\$300).

CAL. CIV. CODE § 3344(a) (amended 1984).

118. See CAL. CIV. CODE § 3344 (West 1984).

119. There is no relevant legislative history discussing the current version of California Civil Code section 3344(a).

120. *Midler*, 849 F.2d at 463.

a voice would further the logical purpose of the statute which, on its face, appears to be to protect the artist.¹²¹ Although, no legislative history exists to confirm this intent, an examination of one of the primary principles of statutory construction mandates this result.¹²²

One mainstay in statutory construction is to construe a statute as a whole in order to further its general purpose and intent.¹²³ The particular meaning of a single word should be construed in light of the purpose behind the entire statute.¹²⁴ The United States Supreme Court adhered to this statutory principal in *Lawson v. Suwannee Fruit & Steamship Co.*¹²⁵ The *Lawson* case turned on the interpretation of the word "disability" in section 8(f)(1) of the Harbor Workers' Compensation Act.¹²⁶ Under one interpretation, the entire burden of compensating a permanently disabled employee would fall on the employer.¹²⁷ This construction would discourage an employer from hiring partially disabled employees who have the potential of becoming permanently disabled, thereby denying employment to this type of individual.¹²⁸ Under the other interpretation of the term "disability," part of the payment would derive from the employer and part from a special federal injury fund.¹²⁹

The Court found that following the former interpretation would "destroy one of the major purposes of the . . . [statute]: the prevention of employer discrimination against handicapped workers."¹³⁰ The Court further reasoned that Congress would not intend such a result.¹³¹ Thus, the Court held that the latter interpretation of the term "disability" must control.¹³²

Likewise, the *Midler* court could have applied the same type of statutory analysis. Qualifying the term "voice" to mean the artist's "actual" voice limits the statute's broad language. Such a reading derogates the obvious purpose behind the entire statute, which is to protect the artist

121. See CAL. CIV. CODE § 3344 (West 1984).

122. See SUTHERLAND STATUTORY CONSTRUCTION § 46.05 (4th ed. 1984).

123. *Id.*, § 46.05, at 91. See also *Lawson v. Suwannee Fruit & S.S. Co.*, 336 U.S. 198, 201 (1949); *Gage v. Jordan*, 23 Cal. 2d 794, 799-800, 147 P.2d 387, 390 (1944); *In re Philpott*, 163 Cal. App. 3d 1152, 1156, 210 Cal. Rptr. 95, 97 (1985); *American Friends Serv. Comm. v. Procnier*, 33 Cal. App. 3d 252, 261, 109 Cal. Rptr. 22, 28 (1973); *Mazza v. Austin*, 25 Cal. App. 2d 85, 87-88, 76 P.2d 533, 535 (1938).

124. SUTHERLAND STATUTORY CONSTRUCTION § 46.05, at 92 (4th ed. 1984).

125. 336 U.S. 198, 201 (1949).

126. *Id.* at 199-200.

127. *Id.* at 201.

128. *Id.* at 202.

129. *Id.* at 200.

130. *Id.* at 201.

131. *Id.* at 202.

132. *Id.* at 206.

from commercial exploitation.¹³³ Therefore, the court should have construed the statute to encompass *any* unauthorized use of a voice, including an imitating voice. As one commentator aptly stated, “[i]f the language [of the statute] is susceptible of two constructions, one which will carry out and the other defeat such manifest object, it should receive the former construction.”¹³⁴ Although the *Midler* court ultimately protected Midler under common law,¹³⁵ it could have provided protection under section 3344 by construing the terms of the statute to comport with the general purpose behind the statute.¹³⁶

b. comparison of New²York and California law

As suggested earlier, the amendment which added the term “voice” to section 3344 is not accompanied by any legislative history indicating the intent of the legislature.¹³⁷ Consequently, it would be reasonable for California courts to determine the scope of section 3344 by examining similar laws from other entertainment-oriented jurisdictions. For example, New York and California have a common interest in protecting the artists who work in their respective states, and are such vital components of the states’ economies.¹³⁸ In addition, both states have statutes containing similar language.¹³⁹ New York Civil Rights Law section 51¹⁴⁰ is

133. See J. MCCARTHY, *supra* note 1, § 6.4[E][1], at 6-26 to -26.1.

134. SUTHERLAND STATUTORY CONSTRUCTION § 46.05, at 91 (4th ed. 1984).

135. See *supra* notes 222-83 and accompanying text for a discussion of the misappropriation doctrine.

136. The court in *Rickard v. Auto Publisher, Inc.* stated that although the goal can be accomplished by extending common law, it is much more efficient and effective to use laws enacted through legislation. 735 F.2d 450, 457 (11th Cir. 1984).

137. See *supra* text accompanying note 122.

138. California and New York are the centers of entertainment in the United States. There are 228 production companies located in California and 165 production companies located in New York. See J. KLAIN, INTERNATIONAL MOTION PICTURE ALMANAC 467-528 (1989). The number of production companies in these two states is far greater than that in any other state. *Id.* The state to come nearest is Florida with six production companies. *Id.* Furthermore, the United States Department of Commerce confirmed that in 1982, California and New York gained more revenue from the entertainment industry than did any other state in the Union. U.S. DEPARTMENT OF COMMERCE, BUREAU OF THE CENSUS, 1982 CENSUS OF SERVICE INDUSTRIES—GEOGRAPHIC AREA SERIES UNITED STATES 39 (1982). California had 3,978 motion picture production, distribution and service establishments with gross receipts of \$5,715,912, and New York had 1,516 establishments with gross receipts of \$1,970,663. *Id.* Finally, the California Film Commission stated that in 1988, California and New York led the country in film production: California companies made 210 feature films, New York’s made 62 and Florida’s trailed with 17. L.A. MAG., Mar. 1989, at 28. The Commission also estimated that California’s film output increased the state’s economy by 220 million dollars. *Id.*

139. Compare CAL. CIV. CODE § 3344 (West 1984) with N.Y. CIV. RIGHTS LAW § 51 (McKinney 1976).

140. N.Y. CIV. RIGHTS LAW § 51 (McKinney 1976).

similar to section 3344, but does not include the terms "voice" or "signature."¹⁴¹ It protects "any person whose name, portrait or picture is used . . . for advertising purposes . . . without the written consent first obtained. . . ."¹⁴² The New York courts have construed the term "picture" not only to mean a picture of the plaintiff, but also a picture of a person resembling the plaintiff that was intended to "convey the idea that it was the plaintiff."¹⁴³ Conversely, the California courts have not yet had the opportunity to interpret the similar provision in section 3344 regarding pictures. However, one could infer from *Midler* that the Ninth Circuit would narrowly construe the language of the California statute to refer only to the artist's own image, not an imitator's image. Instead of limiting the construction of the state statute, the Ninth Circuit should follow New York's example by broadly interpreting the statute to protect the entertainment community within the state.

Although New York's law is not controlling, its decisions could have provided the Ninth Circuit with some guidance since the New York cases interpret the statute which is similar to California Civil Code section 3344.¹⁴⁴ In *Onassis v. Christian Dior-New York, Inc.*,¹⁴⁵ the defendant, Christian Dior, used a Jacqueline Kennedy Onassis look-alike¹⁴⁶ in

141. *Id.* Section 51 provides:

Any person whose name, portrait or picture is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained as above provided may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait or picture, to prevent and restrain the use thereof; and may also sue and recover damages for any injuries sustained by reason of such use

Id.

142. *Id.* (emphasis added).

143. *Onassis v. Christian Dior-New York, Inc.*, 122 Misc. 2d 603, 611, 472 N.Y.S.2d 254, 261 (1984), *aff'd without opinion*, 110 A.D.2d 1095, 488 N.Y.S.2d 843 (1985). See also *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 726 (S.D.N.Y. 1978) (court construed "portrait or picture" to include any representation which is recognizable and can be identified as complaining party); *Negri v. Schering Corp.*, 333 F. Supp. 101, 105 (S.D.N.Y. 1971) ("If a picture so used is a clear and identifiable likeness of a living person, he or she is entitled to recover damages suffered by reason of such use"); *Binns v. Vitagraph Co. of Am.*, 210 N.Y. 51, 57, 103 N.E. 1108, 1110 (1913) (plaintiff was represented in photograph by another, and court held that "[a] picture within the meaning of the statute is not necessarily a photograph of the living person, but includes any representation of such person. The picture . . . was intended to be, and it was, a representation of the plaintiff."); *Loftus v. Greenwich Lithographing Co.*, 192 A.D. 251, 256, 182 N.Y.S. 428, 431 (1920) (sketch slightly deviating from plaintiff's actual appearance would not preclude cause of action under section 51); *Young v. Greneker Studios, Inc.*, 175 Misc. 1027, 1028, 26 N.Y.S.2d 357, 358 (1941) (court interpreted section 51 to encompass representation of plaintiff by mannequin created in her image).

144. See *supra* note 141 for the text of New York Civil Rights Law section 51.

145. 122 Misc. 2d 603, 472 N.Y.S.2d 254 (1984), *aff'd without opinion*, 110 A.D.2d 1095, 488 N.Y.S.2d 843 (1985).

146. The term "look-alike" refers to one who imitates an artist's visual being and manner of

an advertisement to create the impression "that the designer name[] [is] readily associated and become[s] synonymous with a certain status and class of qualities."¹⁴⁷ The fact that the defendant intended to create the image of Jacqueline Kennedy Onassis was undisputed.¹⁴⁸ Cognizant of the fact that Onassis "never permitted her name or picture to be used in connection with the promotion of commercial products,"¹⁴⁹ the defendant contacted Ron Smith Celebrity Look-Alikes seeking an Onassis look-alike.¹⁵⁰ Smith's agency provided Dior with Barbara Reynolds, a secretary who looked remarkably like Onassis, in Dior's advertisement.¹⁵¹

The question before the New York court was whether Civil Rights Law section 51 could be broadly construed to encompass not merely the actual picture of the plaintiff, but also any representation of that person.¹⁵² The answer was a resounding "yes."¹⁵³ The court stated that:

If a person is unwilling to give his or her endorsement to help sell a product, either at an offered price or at any price, no matter—hire a double and the same effect is achieved. . . . If we truly value the right of privacy in a world of exploitation, where every mark of distinctiveness becomes grist for the mills of publicity, then we must give it more than lip service and grudging recognition. Let the word go forth—there is no free ride. The commercial hitchhiker seeking to travel on the fame of another will have to learn to pay the fare or stand on his own two feet.¹⁵⁴

The court suggested that even though the statute did not expressly state that a "photographic representation" was protected, that use must have been contemplated since the statute was intended to protect the "essence of the person."¹⁵⁵ The court reasoned that allowing an "illusionist" to benefit at the expense of the artist "would be sanctioning an obvious loophole to evade the statute."¹⁵⁶ The court therefore gave the statute a

expression for compensation. Telephone interview with Justin Pierce, Vice President of Special Projects for New World Entertainment (Sept. 6, 1989).

147. *Onassis*, 122 Misc. 2d at 604, 472 N.Y.S.2d at 257.

148. *Id.*

149. *Id.* at 605, 472 N.Y.S.2d at 257.

150. *Id.*

151. *Id.* at 606, 472 N.Y.S.2d at 257.

152. *Id.* at 608, 472 N.Y.S.2d at 259.

153. *Id.* at 612, 472 N.Y.S.2d at 261.

154. *Id.*

155. *Id.* at 610, 472 N.Y.S.2d at 260.

156. *Id.* at 612, 472 N.Y.S.2d at 261.

broad "common sense reading . . . bar[ring] easy evasion,"¹⁵⁷ and interpreted the statute to protect the artist.

The United States District Court for the Southern District of New York employed the same test one year later in *Allen v. National Video, Inc.*¹⁵⁸ In *National Video*, the defendant used a Woody Allen look-alike in an advertisement promoting National Video's "V.I.P." movie rental membership card which enabled consumers with the card to rent movies from National Video.¹⁵⁹ The photograph displayed the look-alike, Phil Boroff, in the National Video store with tapes of some of Woody Allen's most famous movies on the counter.¹⁶⁰ Boroff was made up to resemble Allen in both his appearance and manner of expression.¹⁶¹ The court, however, noted some physical differences between Allen and his look-alike.¹⁶² Boroff's "photo show[ed] larger eyebrows, a wider face, and more uneven complexion than [Allen's], and somewhat different glasses than [Allen] generally [wore]."¹⁶³ Moreover, National Video contended that it was not trying to convey an endorsement by Woody Allen himself, but only trying to portray a Woody Allen fan "so dedicated that he ha[d] adopted his idol's appearance and mannerisms, who is able to live out his fantasy by receiving star treatment at National Video."¹⁶⁴ The defendant further maintained that New York Civil Rights Law section 51 should be read narrowly to protect only the actual artist's image and not that of an imitator.¹⁶⁵ Thus, the defendant concluded that Allen's claim should be denied as one not contemplated within the boundaries of the statute.¹⁶⁶

The court adopted the test applied in *Onassis*¹⁶⁷ stating that, "[i]n order to find that the photograph contains [Allen's] 'portrait or picture,' the court would have to conclude that most persons who could identify an actual photograph of [Allen] would be likely to think that this was actually his picture."¹⁶⁸ Thus, the court broadly construed section 51 to reach its conclusion that the person in the photograph need not actually

157. *Id.*

158. 610 F. Supp. 612 (S.D.N.Y. 1985).

159. *Id.* at 618.

160. *Id.* at 617-18. Among the tapes depicted were Allen's *Annie Hall* and *Bananas*. Two Humphrey Bogart films, *Casablanca* and *The Maltese Falcon* were also pictured. The latter two films are associated with Woody Allen because of his play and film, *Play It Again, Sam*, which featured Allen and the spirit of Bogart. *Id.* at 618.

161. *Id.*

162. *Id.* at 624.

163. *Id.*

164. *Id.* at 618.

165. *Id.* at 618-19.

166. *Id.*

167. See *supra* notes 145-57 and accompanying text for a discussion of the *Onassis* decision.

168. *National Video*, 610 F. Supp. at 624.

be the plaintiff, as long as the resemblance is so close that the viewer would think it was actually the artist.¹⁶⁹ The court, however, declined to determine whether the resemblance between Allen and the look-alike met this test, and decided the case on other grounds.¹⁷⁰

In 1988, the court again applied this test in another case brought by Woody Allen. In *Allen v. Men's World Outlet, Inc.*,¹⁷¹ Allen sued to enjoin a clothing store and its advertiser for the unauthorized commercial exploitation of his likeness through the use of a celebrity look-alike.¹⁷² As in *National Videó*, Phil Boroff was employed as Allen's look-alike. Boroff, while deliberately impersonating Allen,¹⁷³ was photographed in order to advertise Men's World Outlet's clothing.¹⁷⁴ The ad was placed in a magazine; however, below the picture of Boroff appeared the following disclaimer: "This is a Ron Smith Celebrity Look-Alike."¹⁷⁵ Nonetheless, Allen brought suit to enjoin the future use of the advertisement.¹⁷⁶

One of Allen's causes of action was a common-law action for unjust enrichment.¹⁷⁷ Allen claimed that the defendants had been unjustly enriched through their unauthorized commercial use of his name, portrait, picture, likeness and persona.¹⁷⁸ The court stated that under this common-law argument, it would liberally construe the photograph of Boroff to be a portrait or picture of Allen.¹⁷⁹ However, the court rejected the common-law claim and instead chose to dispose of the issues under statutory law.¹⁸⁰

The court then considered Allen's claim under section 51 of the New York Civil Rights Law.¹⁸¹ It did not dismiss this claim, but de-

169. *Id.*

170. *Id.* at 625. The court found it unnecessary to resolve Allen's privacy claim since he was entitled to summary judgment under his Lanham Act claim. *Id.* (citing 15 U.S.C.A. § 1125(a) (West 1982)).

171. 679 F. Supp. 360 (S.D.N.Y. 1988).

172. *Id.* at 361.

173. The photograph featured Boroff with a clarinet. *Men's World Outlet*, 679 F. Supp. at 362. This enhanced his resemblance to Woody Allen since Allen is a clarinetist and performs often at Michael's Pub, a New York City bistro. *Id.* at 362 n.2.

174. *Id.* at 362.

175. *Id.*

176. *Id.* at 362-63.

177. *Id.* at 365. For a discussion of this doctrine, see generally E. FARNSWORTH, *CONTRACTS* 98-100 (6th ed. 1982).

178. *Men's World Outlet*, 679 F. Supp. at 365.

179. *Id.* at 365 n.7.

180. *Id.* at 365.

181. *Id.* at 367.

clined to rule on it and again found for Allen on other grounds.¹⁸² Nonetheless, the court applied the *National Video* standard of whether most persons viewing the photograph of Boroff would be likely to think that it was actually a picture of Allen.¹⁸³ The court suggested that this test would have been met had it not been for the disclaimer below Boroff's picture.¹⁸⁴ As a result of the disclaimer, the court inferred, no reasonable person would think that it was Woody Allen pictured in the advertisement.¹⁸⁵ Yet, through its discussion of both the common-law claim and the section 51 claim, it appears that the court was willing to find that Allen's look-alike could be perceived as Allen.¹⁸⁶ Had there been no disclaimer, the court implied, the photograph of Boroff would have been sufficient to satisfy the "portrait or picture" requirement of the statute.¹⁸⁷

In *Onassis*,¹⁸⁸ *National Video*,¹⁸⁹ and *Men's World Outlet*,¹⁹⁰ the standard of interpretation of section 51 is the same. In all three cases, the courts agreed that the statute encompassed the expropriation of the artist's likeness through the use of an imitator.¹⁹¹

Although the New York statute does not include the term "voice," based on the New York interpretation of a "picture," "voice" would likely be construed to include an imitator's voice as well as that of the actual artist.¹⁹² In fact, the *Onassis* court suggested that the only reason the representation of an artist's voice was not included within the purview of the statute was because the statute was drafted in 1903, before the reproduction and dissemination of a voice was even possible.¹⁹³ Had the New York Legislature amended section 51 to include the term "voice" as the California Legislature did,¹⁹⁴ Bette Midler would have undoubtedly

182. *Id.* at 367-68, 372. As in *National Video*, the court disposed of the case under the Lanham Act since the federal law provided Allen with the same relief that he would have received under the section 51 claim. *Id.* (citing 15 U.S.C. § 1125(a) (1982)). Midler did not claim rights under the Lanham Act; therefore, the court never addressed that issue.

183. *Men's World Outlet*, 679 F. Supp. at 367. See also *National Video*, 610 F. Supp. at 624.

184. *Men's World Outlet*, 679 F. Supp. at 367.

185. *Id.*

186. *Id.*

187. *Id.*

188. See *supra* notes 145-57 and accompanying text for a discussion of *Onassis*.

189. See *supra* notes 158-70 and accompanying text for a discussion of *National Video*.

190. See *supra* notes 171-87 and accompanying text for a discussion of *Men's World Outlet*.

191. See *Men's World Outlet*, 679 F. Supp. at 367; *National Video*, 610 F. Supp. at 624; *Onassis*, 122 Misc. 2d at 607, 472 N.Y.S.2d at 258.

192. See *supra* notes 142-91 and accompanying text for the New York interpretation of the term "picture."

193. *Onassis*, 122 Misc. 2d at 609, 472 N.Y.S.2d at 259.

194. CAL. CIV. CODE § 3344 (West 1984).

been protected under New York law.¹⁹⁵

As in *Onassis*, the *Midler* court could have given effect to the intent behind the entire statute,¹⁹⁶ rather than merely giving effect to the literal interpretation of a few isolated words. In that way, the logical purpose of the statute, which is to protect against the artist's commercial exploitation, would have been furthered.¹⁹⁷ Likewise, the general public policy of protecting the artist, an integral part of the economy,¹⁹⁸ would have been achieved. California Civil Code section 3344 should therefore be construed to encompass the use of an imitating voice intending to "convey the idea that it was the plaintiff[s]." ¹⁹⁹ The court thus could have protected *Midler* through statutory law as opposed to expanding a vague common-law tort theory.²⁰⁰

2. Interpretation of "likeness"

The *Midler* court suggested that the term "likeness" in section 3344 "refers to a visual image not a vocal imitation."²⁰¹ Again, without any legislative history to rely on, the court presented a limited interpretation of section 3344. It provided no explanation for its assumption, but could have been basing its opinion on "photograph" cases where the term "likeness" naturally refers to a "visual" likeness.²⁰² In the photograph cases, the courts appeared to have associated the word "likeness" with "visual" simply because at that time, the statute only referred to "photographs."²⁰³

The meaning of "vocal" likeness had never been adjudicated because no cases had interpreted the 1984 amendment to section 3344 which includes the word "voice." The *Midler* court simply concluded that the term "likeness" did not include a "vocal" likeness,²⁰⁴ and sup-

195. See *Onassis*, 122 Misc. 2d at 609, 472 N.Y.S.2d at 259.

196. *Id.* at 610, 472 N.Y.S.2d at 260.

197. See *supra* notes 121-36 and accompanying text for the reasons behind construing a statute in a manner which will further its general purpose and intent.

198. See *supra* note 138 and accompanying text.

199. *Onassis*, 122 Misc. 2d at 611, 472 N.Y.S.2d at 261.

200. See *supra* note 136 for the benefits of using statutory law in lieu of expanding common law.

201. *Midler*, 849 F.2d at 463.

202. See, e.g., *Brewer v. Hustler Magazine, Inc.*, 749 F.2d 527 (9th Cir. 1984); *Cher v. Forum Int'l*, 692 F.2d 634 (9th Cir. 1982); *Guglielmi v. Spelling-Goldberg Prods.*, 25 Cal. 3d 860, 603 P.2d 454, 160 Cal. Rptr. 352 (1979); *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979); *Eastwood v. National Enquirer, Inc.*, 149 Cal. App. 3d 409, 198 Cal. Rptr. 342 (1983).

203. See *supra* note 117 for the text of California Civil Code section 3344 as it existed in 1972.

204. *Midler*, 849 F.2d at 463.

plied no rationale for its conclusory statement. As the *Onassis* court suggested, this type of statute is intended to protect the "essence of the person."²⁰⁵ Limiting the term "likeness" to a "visual" likeness permits defendants to evade the statute through a loophole.²⁰⁶ Furthermore, the definition of the word "likeness" includes terms such as "affinity," "semblance," "copy," and "similarity."²⁰⁷ Thus, the plain meaning of the word is not merely visual and the courts should not limit it as such.

Although the scope of section 3344 has never been adjudicated, the First Circuit of the United States Court of Appeals addressed the scope of a similar statute in *Lahr v. Adell Chemical Co.*²⁰⁸ In *Lahr*, the court interpreted section 51 of New York's Civil Rights Law.²⁰⁹ Plaintiff Bert Lahr attempted to place himself within the reach of section 51 by analogizing his voice to a "name."²¹⁰ The court rejected Lahr's contentions, stating that the statute was very specific.²¹¹ The court concluded, "[i]f the legislature intended that whenever an anonymous speaker extolled a commercial product a cause of action arose . . . it should have used a phrase of more general import" within the statute.²¹²

The California Legislature did precisely that with the 1985 amendments to section 3344, by including the terms "voice" and "likeness" within the statute.²¹³ By doing so, the legislature created "a phrase of more general import"²¹⁴ which should embody a vocal imitation. Section 3344 is exactly the type of statute that the First Circuit implied was needed to protect Lahr.²¹⁵ Ironically, the Ninth Circuit had the benefit of this type of statute but instead opted to extend amorphous common-law tort theories to protect Midler.²¹⁶

205. *Onassis*, 122 Misc. 2d at 610, 472 N.Y.S.2d at 260; see *supra* notes 145-57 and accompanying text for a discussion of the *Onassis* case.

206. *Onassis*, 122 Misc. 2d at 612, 472 N.Y.S.2d at 261.

207. WEBSTER'S NEW COLLEGIATE DICTIONARY 487 (1961). For a similar argument see Weinstein, *Commercial Appropriation of Name or Likeness Revisited*, 22 BEVERLY HILLS L.J. 192, 197 (1988).

208. 300 F.2d 256 (1st Cir. 1962).

209. *Id.* at 258.

210. *Id.*

211. *Id.*

212. *Id.* The court protected Lahr on other grounds. See *infra* notes 265-72 and accompanying text for a discussion of the *Lahr* case.

213. Act effective Jan. 1, 1985, ch. 1704, § 2, 1984 Cal. Stat. 6172 (codified as amended at CAL. CIV. CODE § 3344 (West 1984)).

214. *Lahr*, 300 F.2d at 258.

215. *Id.*

216. *Midler*, 849 F.2d at 463. See *supra* note 136 for the benefits of using statutory law in lieu of expanding common law.

B. *The Common-Law Doctrines*

The common-law right of publicity recognizes a right in the value of a person's name or likeness, thereby preventing the commercial exploitation of such by another person.²¹⁷ This right grew out of the law of privacy.²¹⁸ Professor Prosser, in his widely quoted statement, described the law of privacy as comprised of "four distinct kinds of invasion of four different interests of the plaintiff, which are tied together by the common name [of privacy], but otherwise have almost nothing in common except that each represents an interference with the right of the plaintiff 'to be let alone.'"²¹⁹ The four distinct invasions are: (1) intrusion upon the plaintiff's seclusion or solitude or into the plaintiff's private affairs; (2) public disclosure of embarrassing private facts about the plaintiff; (3) publicity which places the plaintiff in a false light in the public eye; and (4) appropriation, for the defendant's advantage, of the plaintiff's name or likeness.²²⁰ Prosser's fourth invasion grew into what is commonly referred to as both the right of publicity and the misappropriation doctrine.²²¹

1. Misappropriation of property rights

The misappropriation doctrine was first recognized by the United States Supreme Court in *International News Service v. Associated Press*.²²² In that case, the Court defined misappropriation as an act by which one

217. J. McCARTHY, *supra* note 1, § 4.9, at 4-49.

218. W. PROSSER, *HANDBOOK OF THE LAW OF TORTS* § 117, at 849 (5th ed. 1984).

219. *Id.* Justice Brandeis and Samuel Warren popularized the legal concept of a person's right "to be let alone." See Warren & Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 195 (1890). However, the phrase "right to privacy" first appeared in T. COOLEY, *LAW OF TORTS* 29 (2d ed. 1888). Prosser expanded the concept, which is now the widely-accepted definition quoted by many courts. See, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 571-73, 574 n.11 (1977) (quoting W. PROSSER, *LAW OF TORTS* 806-07 (4th ed. 1971)).

220. W. PROSSER, *supra* note 218, at 804-14.

221. See J. McCARTHY, *supra* note 1, § 5.6 at 5-48.1 to -49. See also *supra* notes 97-102 and accompanying text.

222. 248 U.S. 215 (1918). *International News Service* involved a dispute between two news wire services, Associated Press (AP) and International News Service (INS). *Id.* at 231. Both parties were in the business of gathering news from all parts of the world and distributing it daily to its subscribers for publication in their newspapers. *Id.* at 229. Because AP was an east coast service, it received news from Europe before INS, which was a west coast service. *Id.* at 238. When news of World War I was wired to the United States, INS copied the news from bulletin boards and from early editions of AP's newspapers on the east coast, and sold the news to INS customers on the west coast. *Id.* AP brought an action to restrain the pirating of its news by INS. *Id.* at 231.

The Supreme Court remarked that INS had taken material that had "been acquired by [AP] as the result of organization and the expenditure of labor, skill, and money . . ." *Id.* at

procures something of value belonging to someone else, and sells it as if it were his or her own.²²³ The Court condemned this activity, thereby preventing the defendant from “endeavoring to reap where it ha[d] not sown.”²²⁴

The misappropriation doctrine has matured into a discrete body of law.²²⁵ One commentator described the misappropriation doctrine as “a state law, judge-made offshoot of the general law of unfair competition . . . usually invoked by a plaintiff who has what he considers a valuable commercial ‘thing’ which he sees that another has taken or appropriated at little cost.”²²⁶ Three elements comprise a prima facie case of misappropriation: (1) the plaintiff must have invested a substantial amount of time, effort and money into the thing that was misappropriated so that a court could determine that the interest in the misappropriated “thing” was a property right; (2) the defendant has appropriated the “thing” at little or no cost, such that the court can characterize the defendant’s actions as “reap[ing] where it has not sown;”²²⁷ and (3) the plaintiff has been injured as a result of the defendant’s misappropriation.²²⁸

The California Legislature created Civil Code section 3344²²⁹ to embody this common-law doctrine of misappropriation.²³⁰ The *Midler v. Ford Motor Co.*²³¹ court refused to protect Midler under section 3344,²³² a statute seemingly designed to protect persons in her position,²³³ yet granted her relief under the common-law rule from which the statute was derived.²³⁴ The court first looked to the language in California Civil

239. In so doing, INS had “appropriat[ed] to itself the harvest of those who ha[d] sown.” *Id.* at 239-40. Thus, the Court awarded damages to AP. *Id.*

223. *Id.* at 239.

224. *Id.* at 239-40.

225. See J. MCCARTHY, *supra* note 1, § 5.6[B][1], at 5-50.

226. *Id.*

227. *International News Service*, 248 U.S. at 239-40.

228. J. MCCARTHY, *supra* note 1, § 5.6[B][1], at 5-50 to -51; see also *Jacobs v. Robitaille*, 406 F. Supp. 1145 (D.N.H. 1976).

229. CAL. CIV. CODE § 3344 (West 1984). See *supra* notes 109-216 and accompanying text for discussion of California Civil Code section 3344.

230. See *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 819 n.6, 603 P.2d 425, 428 n.6, 160 Cal. Rptr. 323, 326 n.6 (1979). Section 3344 has also been said to have embodied the right of publicity indicating that the two terms are used interchangeably. J. MCCARTHY, *supra* note 1, § 6.4[F][8], at 6-39. See also *supra* notes 109-12 and accompanying text.

231. 849 F.2d 460 (9th Cir. 1988).

232. *Id.* at 463.

233. See *supra* notes 109-216 and accompanying text for a discussion of California Civil Code section 3344.

234. *Midler*, 849 F.2d at 463. See generally J. MCCARTHY, *supra* note 1, § 6.4[A], at 6-15 to -16.

Code section 990²³⁵ which states that the rights accorded a deceased individual, including voice, are property rights.²³⁶ The court concluded that, by analogy, the common-law rights are also property rights which can be appropriated.²³⁷ However, since voice is not traditionally a common-law right,²³⁸ the court, in essence, expanded common-law property rights to include voice by reference to a statute which is specifically limited to the rights of *deceased* individuals.²³⁹

The court should not have looked to section 990, a post-mortem statute, but should have looked to the corresponding statute for living persons, section 3344.²⁴⁰ If the court had looked to section 3344 to support its property rights argument, it would have found that the language defining these rights as property rights in section 990 was conspicuously missing from section 3344.²⁴¹ It has been held that "[w]here a statute, with reference to one subject contains a given provision, the omission of such provision from a similar statute concerning a related subject is significant to show that a different intention existed."²⁴² If the legislature did not intend a living person's voice to be a property right, the court should not have circumvented this intent by using section 990's creation of property rights in deceased individuals, to apply to a living person.

Instead of looking to an inapplicable statute to change the common-law definition of property rights, the court could have looked to the existing common-law rule regarding property rights to determine whether the defendants committed the tort of misappropriation.²⁴³ An historical analysis of the common law will reveal that the court erred in granting Midler rights in her voice under the common-law rule of misap-

235. CAL. CIV. CODE § 990 (West 1984). See *supra* note 76 for the relevant text of section 990.

236. *Midler*, 849 F.2d at 463.

237. *Id.*

238. See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971); *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343 (S.D.N.Y. 1973); *Davis v. Trans World Airlines*, 297 F. Supp. 1145 (C.D. Cal. 1969).

239. See *Midler*, 849 F.2d at 463. See also Anderson, *Celebrities Have Rights in Their Personas*, L.A. Daily J., Oct. 20, 1988, at 4, col. 3.

240. See *supra* notes 109-216 and accompanying text for a discussion of California Civil Code section 3344.

241. See CAL. CIV. CODE § 3344 (West 1984).

242. *People v. Kuhn*, 216 Cal. App. 2d 695, 699, 31 Cal. Rptr. 253, 256 (1963) (quoting *People v. Valentine*, 28 Cal. 2d 121, 142, 169 P.2d 1, 14 (1946)). See also *City of Port Hueneme v. City of Oxnard*, 52 Cal. 2d 385, 395, 341 P.2d 318, 324 (1959); *People ex rel. Paganini v. Town of Corte Madera*, 97 Cal. App. 2d 726, 729, 218 P.2d 810, 813 (1950).

243. Section 990 was intended to complement, not displace, the common-law rule; therefore, courts can still reasonably examine the common law underlying the statute. See CAL. CIV. CODE § 990(m) (West 1984).

propriation.²⁴⁴

The California Supreme Court, in *Lugosi v. Universal Pictures*,²⁴⁵ clearly articulated the law regarding misappropriation of property rights. In *Lugosi*, Bela Lugosi's heirs sought to recover profits made by Universal Pictures from its commercial use of Lugosi's portrayal of the Count Dracula character.²⁴⁶ Lugosi's heirs also sought to enjoin Universal from future use of Lugosi's image without their consent.²⁴⁷ One of the issues concerned whether Lugosi's portrayal of Count Dracula was a "property right" which could descend to his heirs.²⁴⁸

The supreme court held that Lugosi did not retain property rights in his portrayal of Dracula, and therefore no such rights could pass to the plaintiffs.²⁴⁹ Justice Mosk, in his concurrence, stated that "[m]erely playing a role . . . creates no inheritable property right in an actor."²⁵⁰ Mosk suggested, however, that Lugosi would have retained property rights in the character had he been the innovator or creator of Count Dracula.²⁵¹ Here, because Lugosi had only played a role that many others had portrayed, he did not have the exclusive right to control the use of the Count Dracula character.²⁵²

The above theory has been recognized for decades.²⁵³ In the early case of *Supreme Records v. Decca Records*,²⁵⁴ the United States District Court for the Southern District of California noted that if it were to prevent imitation of performances, "[it] would have to hold that . . . for instance . . . Sir Laurence Olivier could prohibit anyone else from adopting some of the innovations which he brought to the performance of Hamlet."²⁵⁵ However, Justice Mosk's concurrence in *Lugosi* did not in-

244. The court should have protected Midler under California Civil Code section 3344, the statutory codification of the misappropriation doctrine. See *supra* notes 109-216 and accompanying text for a discussion of section 3344.

245. 25 Cal. 3d 813, 603 P.2d 425, 160 Cal. Rptr. 323 (1979).

246. *Id.* at 817, 603 P.2d at 427, 160 Cal. Rptr. at 325.

247. *Id.*

248. *Id.*

249. *Id.* at 822-23, 603 P.2d at 430-31, 160 Cal. Rptr. at 328-29.

250. *Id.* at 825, 603 P.2d at 432, 160 Cal. Rptr. at 330 (Mosk, J., concurring).

251. *Id.* (Mosk, J., concurring).

252. *Id.* (Mosk, J., concurring).

253. See generally *Goldstein v. California*, 412 U.S. 546 (1973); *Lahr v. Adell Chem. Co.*, 300 F.2d 256 (1st Cir. 1962); *Groucho Marx Prods. v. Day & Night Co.*, 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (1982); *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975); *Supreme Records v. Decca Records*, 90 F. Supp. 904 (S.D. Cal. 1950); *Chaplin v. Amador*, 93 Cal. App. 358, 269 P. 544 (1928).

254. 90 F. Supp. 904 (S.D. Cal. 1950).

255. *Id.* at 909.

dicate that an actor could never have a property right in a character.²⁵⁶ An exception existed if the character was "an original creation of a fictional figure played exclusively by its creator."²⁵⁷

Justice Mosk referred to Groucho Marx as an example of this exception because he actually "created" the distinctive character which he portrayed.²⁵⁸ Coincidentally, two years later *Groucho Marx Productions v. Day & Night Co.* was decided.²⁵⁹ According to that case, Groucho Marx had assigned property rights in his name, likeness, and style of his character to his production company.²⁶⁰ The production company later brought suit, claiming that the defendant had appropriated these rights by simulating the unique style of the Marx Brothers in a play.²⁶¹

The *Marx* court held that the Marx Brothers had property rights in the characters they had created.²⁶² Their "fame arose as a direct result of their efforts to develop instantly recognizable and popular stage characters, having no relation to their real personalities."²⁶³ Thus, the court held, commercial value could be transferred in the unique characters that they created, not merely portrayed.²⁶⁴

256. *Lugosi*, 25 Cal. 3d at 825, 603 P.2d at 432, 160 Cal. Rptr. at 330 (Mosk, J., concurring).

257. *Id.* (Mosk, J., concurring).

258. *Id.* at 825-26, 603 P.2d at 432, 160 Cal. Rptr. at 330 (Mosk, J., concurring). An earlier case that falls within this exception is *Chaplin v. Amador*, 93 Cal. App. 358, 269 P. 544 (1928). In *Chaplin*, the plaintiffs claimed that the defendants had misappropriated Chaplin's unique character, which he originally created and portrayed. *Id.* at 359-60, 269 P. at 544. Chaplin invented and perfected the make-up, clothing, and mannerisms of his character. *Id.* at 359, 269 P. at 544. The defendants produced several films with Amador imitating Chaplin as "Charlie Aplin." *Id.* at 360-61, 269 P. at 545. The court held that the defendants could not appropriate Chaplin's rights in his character since Chaplin was the "first person to originate, use, combine, and perfect in motion pictures that certain form of acting, those mannerisms, facial expressions, and movements of his body." *Id.* at 362, 269 P. at 545.

Similarly, in *Price v. Hal Roach Studios, Inc.*, the court determined that the plaintiffs, Stanley Laurel's and Oliver Hardy's heirs, had property rights in the decedents' names and likenesses. 400 F. Supp. 836, 846 (S.D.N.Y. 1975). The *Price* court therefore held that the defendant's use of these property rights amounted to misappropriation. *Id.* at 847. The *Price* court reasoned that, in light of the *Lugosi* decision, *Price's* case was easy to decide. *Id.* at 845. Unlike *Lugosi*, the court reasoned, Laurel and Hardy "portray[ed] themselves and develop[ed] their own characters rather than fictional characters which ha[d] been given a particular interpretation by an actor." *Id.*

259. 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (1982).

260. *Id.* at 486.

261. *Id.*

262. *Id.* at 491.

263. *Id.*

264. *Id.* at 492. The district court was later reversed by the Second Circuit because it applied New York law when it should have applied California law. *Groucho Marx Prods. v. Day & Night Co.*, 689 F.2d 317, 319-20 (2d Cir. 1982). The Second Circuit stated that under current California law, the right of publicity terminates at death. *Id.* at 320. Thus, for the

*Lahr v. Adell Chemical Co.*²⁶⁵ also falls within this exception. In *Lahr*, the defendant, in order to sell a product, used a cartoon of a duck in a commercial accompanied by the voice of a sound-alike imitating Lahr's distinctive voice.²⁶⁶ Lahr alleged misappropriation of his "creative talent, voice, vocal sounds and vocal comic delivery."²⁶⁷

Holding for Lahr, but remanding for further proceedings, the court stated that Lahr achieved notoriety because of his "style of vocal comic delivery . . . distinctive and original combination of pitch, inflection, accent and comic sounds."²⁶⁸ The court implied that Lahr's individual vocal style was his own creation, and therefore not connected with a character or work which was the creation of another.²⁶⁹ Unlike *Midler*, the defendant had not purchased the rights in another's character that Lahr had simply portrayed, but had actually simulated Lahr's "unique and extraordinary comic character."²⁷⁰ The court did not deny that Lahr had a property right in his own unique voice, since what the defendant sought was Lahr's vocal creation,²⁷¹ and not merely his performance of another writer's innovations. Thus, like the Marx Brothers, Lahr had created and not merely performed his unique characterizations.

While *Lahr* is similar to *Midler* in that it deals with imitation of one's voice, the similarity ends there. *Lahr* is distinguishable in that Lahr's voice was used in a unique manner²⁷² and was not fixed in any particular song copyrighted by another individual. By contrast, *Midler* sang a song created by another person.²⁷³ In that sense, *Midler*'s performance was not a unique creation, but more akin to Bela Lugosi's portrayal of Dracula.²⁷⁴ Just as the character of Count Dracula has been

purposes of this case, the court suggested that the fact Groucho Marx represented an "original creation" played exclusively by its creator was irrelevant because no rights could pass to his heirs. *Id.* at 322-23 n.6. However, the court implied that Groucho Marx would have had a property right in his "original creation" during his lifetime. *Id.*

It should be noted that the enactment of California Civil Code section 990 created publicity rights in deceased individuals. See CAL. CIV. CODE § 990 (West 1984). Therefore, the Second Circuit's narrow interpretation of California law is now unfounded.

265. 300 F.2d 256 (1st Cir. 1962).

266. *Id.* at 257.

267. *Id.*

268. *Id.*

269. *Id.* at 257-58.

270. *Id.* at 257.

271. *Id.* at 259.

272. *Id.* at 257.

273. *Midler*, 849 F.2d at 462. The *Lahr* court stated in dictum that it would "hesitate to say that an ordinary singer whose voice, deliberately or otherwise, sounded sufficiently like another to cause confusion was not free to do so." *Lahr*, 300 F.2d at 259.

274. See *supra* notes 245-52 and accompanying text for a discussion of the *Lugosi* case.

portrayed by many actors,²⁷⁵ the song, "Do You Want To Dance," has been performed by many singers.²⁷⁶ Thus, since the *Lugosi* court found that Bela Lugosi did not have a property interest in his characterization of Count Dracula,²⁷⁷ so should the *Midler* court have found that Bette Midler did not have a property right in her version²⁷⁸ of "Do You Want To Dance." Without a property interest there can be no common-law tort of misappropriation²⁷⁹ and Midler's cause of action should have failed.²⁸⁰

Since Midler would have been denied relief under California's established interpretation of misappropriation of a property right,²⁸¹ the Ninth Circuit erred in granting her relief under that theory of recovery.²⁸² The court clothed Midler's cause of action in "misappropriation" garb²⁸³ when actually it was more appropriately dressed as a section 3344 action. Had the court employed section 3344, it could have protected Midler without having to contradict seemingly dispositive state-law precedent regarding the misappropriation doctrine.

2. Prior precedent: *Sinatra v. Goodyear Tire & Rubber Co.*

By protecting Midler under a misappropriation theory, the court essentially broadened the right of publicity²⁸⁴ to protect a performer's voice, which had never before been protected.²⁸⁵ Traditionally, the right of publicity was invoked only to protect the commercial exploitation of

275. *Lugosi*, 25 Cal. 3d at 825, 603 P.2d at 432, 160 Cal. Rptr. at 330 (Mosk, J., concurring).

276. The song "Do You Want To Dance" has been recorded by eleven artists, including Bette Midler. See PHONOLOG REPORTER 103-57B (1989).

277. *Lugosi*, 25 Cal. 3d at 822-23, 603 P.2d at 430-31, 160 Cal. Rptr. at 328-29.

278. Although the court actually protected Midler's voice, it should have only protected Midler's rendition of the song, since a voice has never been recognized as a common-law property right. See *Sinatra*, 435 F.2d at 716; *Lahr*, 300 F.2d at 259; *Booth*, 362 F. Supp. at 345; *Davis*, 297 F. Supp. at 1147.

279. J. MCCARTHY, *supra* note 1, § 5.6[B][1], at 5-51.

280. It should be noted that although the court erred in protecting Midler under the misappropriation doctrine, she still could have recovered under a broad reading of California Civil Code section 3344. See *supra* notes 109-216.

281. See *supra* notes 245-52 and accompanying text for a discussion of *Lugosi*.

282. The court could have granted Midler relief under existing statutory law. See *supra* notes 109-216 for a discussion of California Civil Code section 3344.

283. *Midler*, 849 F.2d at 463.

284. As previously stated, the right of publicity encompasses early common-law rights such as misappropriation and unfair competition. See J. MCCARTHY, *supra* note 1, § 5.6[A], at 5-48.1 to -49. Therefore, these terms are commonly used interchangeably. See *supra* notes 97-102 and accompanying text.

285. See *Sinatra*, 435 F.2d at 716; *Booth*, 362 F. Supp. at 345; *Davis*, 297 F. Supp. at 1147.

one's name and likeness.²⁸⁶ By extending this right to protect one's voice, the court essentially overruled an eighteen-year-old rule established by *Sinatra v. Goodyear Tire & Rubber Co.*,²⁸⁷ a case with facts virtually indistinguishable from those in *Midler*.²⁸⁸

In *Sinatra*, Goodyear Tire and Rubber Company devised a tire advertising campaign with the help of the advertising agency of Young & Rubicam.²⁸⁹ The agency named the new line of tires "wide boots" in order to utilize an idea for a television commercial incorporating "These Boots Are Made For Walkin'," a song made famous by Nancy Sinatra.²⁹⁰ As in *Midler*, the defendant first approached Sinatra to participate in the commercial and, like *Midler*, no contract was negotiated.²⁹¹ The defendant nonetheless produced the commercial, hiring a Sinatra sound-alike to sing the song while four girls appeared on stage dressed in the distinctive Sinatra style.²⁹² Sinatra brought an action against the defendant, alleging that she was so identified with the song that her rendition of it acquired a secondary meaning.²⁹³ She further alleged that the defendant's purpose was to deceive the public into believing that Sinatra endorsed the product.²⁹⁴

Although the defendant admitted it was imitating Sinatra's rendition of the song, the Ninth Circuit refused to protect Sinatra's publicity rights.²⁹⁵ The case was dismissed on grounds that Sinatra's interests conflicted with federal copyright law.²⁹⁶ The court stated that the defendant

286. See, e.g., *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977); *Factors Etc., Inc., v. Pro Arts, Inc.*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979); *Cepeda v. Swift & Co.*, 415 F.2d 1205 (8th Cir. 1969); *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953), *cert. denied*, 346 U.S. 816 (1953); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978); *Memphis Dev. Found. v. Factors Etc., Inc.*, 441 F. Supp. 1323 (W.D. Tenn. 1977), *aff'd*, 578 F.2d 1381 (6th Cir. 1978), *cert. denied*, 449 U.S. 953 (1980); *Grant v. Esquire, Inc.*, 367 F. Supp. 876 (S.D.N.Y. 1973); *Uhlander v. Hendricksen*, 316 F. Supp. 1277 (D.C. Minn. 1970); *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661 (1977).

287. 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971).

288. However, *Sinatra* is distinguishable from *Midler* on the basis of the legal arguments made, since, at the time *Sinatra* was decided, California Civil Code section 3344 had not taken effect.

289. *Sinatra*, 435 F.2d at 712.

290. *Id.*

291. *Id.* at 713.

292. *Id.* at 712. Sinatra was known for wearing "mod" clothes and high boots. *Id.* She alleged that the defendants intentionally dressed the girls in the commercial in that fashion to make it appear as if Nancy Sinatra were in the commercial. *Id.*

293. *Id.* See *supra* text accompanying note 58 for a definition of the term "secondary meaning."

294. *Sinatra*, 435 F.2d at 712.

295. *Id.* at 713.

296. *Id.* at 717-18.

"paid a very substantial sum to the copyright proprietor to obtain the license for the use of the song and all of its arrangements."²⁹⁷ To make a copyright proprietor obtain permission from each artist who sang the particular song in question, the court reasoned, would impose too much of a burden on the proprietor.²⁹⁸ Thus, Sinatra was denied relief.²⁹⁹

The *Midler* court distinguished *Sinatra*, which is factually identical to the *Midler* case, by stating that "if Midler were claiming a secondary meaning to 'Do You Want To Dance' or seeking to prevent the defendants from using that song, she would fail like Sinatra."³⁰⁰ In effect, Midler was asking for the same relief as Sinatra.³⁰¹ However, the court reasoned that because Midler did not assert that imitation of her voice resulted in unfair competition, her cause of action would be upheld.³⁰² Yet peculiarly, the court protected Midler under the misappropriation doctrine,³⁰³ which is an offshoot of the law of unfair competition.³⁰⁴

Essentially, Midler invoked the same rights as Sinatra; and therefore, the rule in *Sinatra* should have governed the outcome in *Midler*.³⁰⁵ Moreover, in both cases, the defendants had obtained the copyright to a song that had been sung by many other performers.³⁰⁶ Neither Sinatra nor Midler was trying to protect the song itself, but rather each wished to protect her particular version of the song.³⁰⁷ Each artist wanted to prevent the imitation of her individual rendition so that the public would not identify her with the advertisement.³⁰⁸ By affording Midler protection that it did not grant Sinatra, the Ninth Circuit essentially created a legal distinction without a factual one. The effect of the *Midler* decision is extremely significant because without expressly stating it, the court

297. *Id.* at 717.

298. *Id.* at 718.

299. *Id.*

300. *Midler*, 849 F.2d at 462.

301. *See supra* note 278.

302. *Midler*, 849 F.2d at 462.

303. *Id.* at 463. *See supra* notes 222-83 and accompanying text for a discussion of the misappropriation doctrine.

304. *See* J. MCCARTHY, *supra* note 1, § 5.6 [B][1], at 5-50. *See also supra* text accompanying note 226.

305. However, unlike *Sinatra*, the court had the benefit of California Civil Code section 3344 and could have granted Midler relief under that statute, rather than relying on amorphous tort theories. *See supra* note 136 for the advantages of using statutory law in lieu of extending common law. *See also supra* notes 109-216 and accompanying text for a discussion of California Civil Code section 3344.

306. *See supra* note 276 for the number of singers who have recorded "Do You Want To Dance." The song "These Boots Are Made For Walkin'" has been recorded by five artists including Nancy Sinatra. *See* PHONOLOG REPORTER, *supra* note 276, at 119-57A.

307. *See Midler*, 849 F.2d at 462; *Sinatra*, 435 F.2d at 712. *See also supra* note 278.

308. *Midler*, 849 F.2d at 463; *Sinatra*, 435 F.2d at 712.

effectively overruled *Sinatra*. It afforded protection where it had never been given before—to a performer's voice in a copyrighted song.³⁰⁹

C. Preemption Under Federal Law

Although the court provided Midler with state law protection,³¹⁰ the question remains as to whether her claim should have been preempted by federal law. The doctrine of preemption arises from the Supremacy Clause of the United States Constitution.³¹¹ The Supremacy Clause essentially states that the Constitution and the federal laws created pursuant to the Constitution shall remain supreme over the laws of the states.³¹² The question of whether a state law is void under the Supremacy Clause involves a consideration of whether that law "stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress."³¹³ The Copyright Clause of the United States Constitution³¹⁴ provides Congress with the power "to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."³¹⁵ Under the Supremacy Clause, state laws in actual conflict with Congress' enactment of federal legislation under any authorizing clause, in this context the Copyright Clause, will be struck down, or "preempted."³¹⁶

The *Midler v. Ford Motor Co.*³¹⁷ court suggested that if Midler had alleged unfair competition, as alleged in *Sinatra v. Goodyear Tire & Rub-*

309. *Midler*, 849 F.2d at 463. One court suggested that it would protect a performer's voice, but only for a work which was his own original creation. See *Lahr*, 300 F.2d at 257, 259. See also *supra* notes 265-72 and accompanying text.

310. *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988). The court protected Midler under the common-law doctrine of misappropriation. See *supra* notes 222-83 for a discussion of misappropriation.

311. U.S. CONST. art. VI. Article six of the United States Constitution states in pertinent part:

This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, *shall be the supreme Law of the Land*; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding.

Id. (emphasis added).

312. *Id.*

313. *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941).

314. U.S. CONST. art. I, § 8, cl. 8.

315. *Id.*

316. See L. TRIBE, AMERICAN CONSTITUTIONAL LAW § 6-26, at 481 (2d ed. 1988).

317. 849 F.2d 460 (9th Cir. 1988).

ber Co.,³¹⁸ Midler too would have been preempted.³¹⁹ However, after the 1976 amendments were added to the Copyright Act,³²⁰ the fact that Midler did not allege unfair competition would not have saved her from preemption. Section 114(b) of Title 17,³²¹ which was part of the 1976 amendments,³²² may apply to preempt Midler's cause of action even though she did not allege unfair competition.³²³ Section 114(b) has never been applied since the only right of publicity cases regarding one's voice arose before that section was enacted.³²⁴ To determine whether a resolution of this issue can be reached, the common law and sections 301 and 114(b) of the Copyright Act of 1976³²⁵ must be analyzed.

1. The preemption cases

Before Congress passed the Copyright Act of 1976, which became effective in 1978,³²⁶ the United States Supreme Court decided several important preemption cases under the old copyright law.³²⁷ A better understanding of the congressional intent behind the 1976 Act can be obtained by examining these cases.

a. the Sears-Compco cases

The federal preemption theory regarding copyright laws was first examined in *Sears, Roebuck & Co. v. Stiffel Co.*³²⁸ and its companion case, *Compco Corp. v. Day-Brite Lighting, Inc.*³²⁹ In the *Sears-Compco* cases, the defendants copied unpatentable lighting designs, and the Seventh Circuit affirmed their liability under the state law of unfair competition.³³⁰ The United States Supreme Court was faced with the question of whether state unfair-competition laws could prevent the copying of de-

318. 435 F.2d 711, 714 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971).

319. *Midler*, 849 F.2d at 462.

320. Copyright Act of October 19, 1976, Pub. L. No. 94-553, §§ 101-810, 90 Stat. 2541-2602 (1976) (codified at 17 U.S.C. §§ 101-810 (1982)).

321. 17 U.S.C. § 114(b) (1982).

322. Copyright Act of October 19, 1976, Pub. L. No. 94-553, § 114(b), 90 Stat. 2541, 2560 (1976) (codified at 17 U.S.C. § 114(b) (1982)).

323. See *supra* note 49 for the relevant text of Title 17, section 114(b).

324. See cases cited *supra* note 238.

325. 17 U.S.C. §§ 114(b), 301 (1982).

326. Copyright Act of October 19, 1976, Pub. L. No. 94-553, §§ 101-810, 90 Stat. 2541, 2598 (1976) (codified at 17 U.S.C. §§ 101-810 (1982)).

327. See, e.g., *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964); *Goldstein v. California*, 412 U.S. 546 (1973); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974).

328. 376 U.S. 225 (1964).

329. 376 U.S. 234 (1964).

330. *Stiffel Co. v. Sears, Roebuck & Co.*, 313 F.2d 115, 118 (7th Cir. 1963), *rev'd*, 376 U.S.

signs that were too common to warrant protection under either federal patent or copyright law.³³¹ The Court held that under the Supremacy Clause, the states could not protect these designs as such protection would conflict with the Copyright Clause's grant to Congress of power to protect certain inventions.³³² To allow the state to protect the design would contravene the federal policy of "allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."³³³

b. the Goldstein-Kewanee cases

The Court again addressed the preemption doctrine in *Goldstein v. California*³³⁴ and *Kewanee Oil Co. v. Bicron Corp.*³³⁵ In *Goldstein*, the defendant was criminally convicted under a California statute³³⁶ for copying an original sound recording without the author's consent.³³⁷ The Court upheld the defendant's conviction, thereby rejecting the defendant's contention that the *Sears-Compco* decisions should govern and the state's law should be preempted by the 1909 Copyright Act.³³⁸ The Court reaffirmed *Sears* and *Compco*, but held that the 1909 Act did not preempt the state statute since the Act did not list sound recordings as protected by copyright.³³⁹ The Court reasoned that no preemption could occur if Congress had not expressly spoken on the matter in question.³⁴⁰ *Goldstein* somewhat narrowed the *Sears-Compco* holdings which had suggested that the states could not pass a law that would effectively provide any copyright protection.³⁴¹ However, the Court continued to recognize preemption where Congress expressly creates a conflicting federal

225 (1964); *Day-Brite Lighting, Inc. v. Compco Corp.*, 311 F.2d 26, 30 (7th Cir. 1962), *rev'd*, 376 U.S. 234 (1964).

331. *Sears*, 376 U.S. at 225-26; *Compco*, 376 U.S. at 234.

332. *Sears*, 376 U.S. at 231-32; *Compco*, 376 U.S. at 237.

333. *Compco*, 376 U.S. at 237. *See also Sears*, 376 U.S. at 231-32.

334. 412 U.S. 546 (1973).

335. 416 U.S. 470 (1974).

336. CAL. PENAL CODE § 653(h) (West 1988).

337. *Goldstein*, 412 U.S. at 548. California Penal Code section 653(h) prohibits the copying of works which are not entitled to federal protection. CAL. PENAL CODE § 653(h) (West 1988).

338. *Goldstein*, 412 U.S. at 571.

339. *Id.* at 566. The 1909 Act was later amended in 1971 to provide copyright protection for sound recordings. Act of 1971, Pub. L. No. 92-140, §§ 1(f), 5(n), 19, 20, 26, 101(e), 85 Stat. 391 (1971) (codified at 17 U.S.C. §§ 1(f), 5(n), 19, 20, 26, 101(e) (1982)). The 1976 Act explicitly protects sound recordings. *See* 17 U.S.C. § 102(a)(7) (1982).

340. *Goldstein*, 412 U.S. at 566.

341. *Id.* at 569-70.

law.³⁴²

In *Kewanee*, the Court qualified its holding in *Goldstein*. The *Kewanee* Court was faced with the issue of whether federal patent law would preempt state trade-secret law.³⁴³ The Court adopted the following test to determine whether federal law preempted state law: If the state statute or common law "[stood] as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress," then the state law would be preempted.³⁴⁴

Applying this test, the Court determined that trade-secret laws did not contravene federal patent law policies of encouraging and rewarding new invention, promoting disclosure of inventions and assuring that ideas remain free in the public domain.³⁴⁵ The Court stated that federal patent law and state trade-secret law provided two different forms of incentive to invention.³⁴⁶ Federal patent law, the Court observed, provided an "inventor" a seventeen-year "monopoly" in a machine, process, or device.³⁴⁷ The Court then noted that the state trade-secret law at issue did not protect a "discoverer" against independent discovery of the "secret" by others.³⁴⁸ In this way, the Court reasoned, the state law encouraged invention and did not remove any ideas from the public domain.³⁴⁹ Therefore, the Court held that since the purpose of the state law was in accord with that of the federal law,³⁵⁰ there would be no preemption.³⁵¹

2. The Copyright Act of 1976

The Copyright Act of 1976³⁵² created a system of protection for all "original works of authorship fixed in any tangible medium of expression."³⁵³ In light of the Supreme Court's holdings in the *Sears-Compro*

342. *Id.* at 571.

343. *Kewanee*, 416 U.S. at 472.

344. *Id.* at 479 (quoting *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941)).

345. *Id.* at 484.

346. *Id.*

347. *Id.* at 477-78 (citing 35 U.S.C. § 154 (1965)).

348. *Id.* at 475-76.

349. *Id.* at 484-85.

350. *Id.* at 493.

351. The preemption cases suggest that a state law will be preempted only if it directly conflicts with a federal law or if it clashes with the objectives of a federal law. *See generally* *Ray v. Atlantic Richfield Co.*, 435 U.S. 151 (1978).

352. 17 U.S.C. §§ 101-810 (1982).

353. *Id.* § 102(a). The following works of authorship are fixed in a tangible medium of expression, and therefore are granted copyright protection: "(1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying

cases,³⁵⁴ Congress added section 301³⁵⁵ to the new Act to deal with preemption of state common law or statutes.³⁵⁶ In drafting section 301, legislative history indicates that Congress intended it "to be stated in the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation of its unqualified intention that Congress shall act preemptively, and to avoid the development of any vague borderline areas between State and Federal protection."³⁵⁷

Unfortunately, Congress missed the mark. The language of section 301 is not clear and unequivocal, but rather is riddled with ambiguities.³⁵⁸ Professor Nimmer articulated the two-tiered standard embodied in section 301:

Any state law (whether based upon common law or statute) will be subject to federal preemption under Section 301 if: (1) such law creates "legal or equitable rights that are *equivalent* to

music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; and (7) sound recordings." *Id.*

354. *Sears*, 376 U.S. at 231-32; *Compco*, 376 U.S. at 237. See *supra* notes 326-51 and accompanying text for a discussion of the preemption cases.

355. 17 U.S.C. § 301 (1982).

356. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 131, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5747. Section 301 provides in pertinent part:

(a) [A]ll legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103 . . . are governed *exclusively* by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

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

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

. . .

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

17 U.S.C. § 301(a)-(b)(1), (3) (1982) (emphasis added).

357. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 130, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5746.

358. For example, Congress initially included in the bill a list of state claims which would not be preempted by the Copyright Act. This early bill read:

§ 301(b)(3): activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright . . . including rights against misappropriation not equivalent to any such exclusive rights, breaches of contract, breaches of trust, trespass, conversion, invasion of privacy, defamation, and deceptive trade practices such as passing off and false representation.

H.R. REP. NO. 1476, 94th Cong., 2d Sess. 24.

The above list was inexplicably excluded from the final version of the statute. See 17 U.S.C. § 301 (1982). Consequently, the courts are left to deal with the problem of whether certain state law causes of action are equivalent to federal copyright law.

any of the exclusive rights within the general scope of copyright as specified by section 106,"^{359]} and if, in addition, (2) such rights under such state law may be claimed in "works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after [January 1, 1978] and whether published or unpublished"³⁶⁰

The vagueness of the statute's language has resulted in a dual interpretation of this standard. Thus, the next two sections demonstrate that it can be used to both support and defeat the preemption of Bette Midler's right of publicity cause of action. Furthermore, new tension between the state common-law right of publicity and the federal copyright law are explored, since the *Midler* case involved the right of publicity as it related to the protection of one's "voice," as opposed to its traditional protection of one's "name or likeness."³⁶¹

a. reasons to oppose federal preemption

The arguments against federal preemption and for the survival of Midler's state cause of action reveal that under the first tier,³⁶² preemption will occur only if the legal rights afforded by the state action are equivalent to any of the federal rights alluded to in section 106.³⁶³ The rights of section 106 that would have been pertinent to the *Midler* case were those rights provided to the copyright owner "to prepare derivative

359. Section 106 of Title 17 provides:

Subject to sections 107 through 118, the owner of copyright under this title has the exclusive rights to do and to authorize any of 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; and
- (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.

17 U.S.C. § 106 (1982).

360. 1 M. NIMMER & D. NIMMER, *NIMMER ON COPYRIGHT* § 1.01[B], at 1-9 to -10 (1978) [hereinafter M. NIMMER] (footnotes omitted) (quoting 17 U.S.C. § 301(a) (emphasis added)).

361. This area has not been explored since, prior to *Midler*, the right of publicity was limited to protection of one's "name or likeness." See, e.g., *Brewer v. Hustler Magazine, Inc.*, 749 F.2d 527 (9th Cir. 1984).

362. See *supra* notes 359-60 and accompanying text.

363. 17 U.S.C. § 301(a) (1982).

works based upon the copyrighted work."³⁶⁴ One commentator has interpreted the term "equivalent" very narrowly.³⁶⁵ If by merely reproducing, performing, distributing, or displaying the copyrighted work, the defendants infringe upon a state-created right, then the state law is preempted.³⁶⁶ However, this commentator concludes, if any *additional element* is required to abrogate the state law, then the two laws are not equivalent and the state law can survive.³⁶⁷

Employing this analysis, Midler's cause of action would not be preempted under the first tier. If by merely copying the song in which the defendants owned a copyright violated Midler's right of publicity under California law, then her cause of action would be preempted by federal law because the California law would be in direct conflict with section 106. However, those opposed to preemption would argue that since the defendants imitated Midler's *persona* as well as the song,³⁶⁸ an *additional element* was present to complete the state cause of action. Her state-law-created claim, therefore, should not be preempted under the first tier of the analysis.

The second tier of the analysis deals with the nature of the works subject to preemption.³⁶⁹ In order to be preempted, a work must be fixed in a tangible medium of expression and come within the subject matter of sections 102 and 103.³⁷⁰ Those against federal preemption would suggest that through the right of publicity, the artist is not protecting a recorded work, but is protecting his or her *persona*.³⁷¹ Since a *persona* is not fixed in a tangible medium of expression,³⁷² it is not within the subject matter of copyright and is therefore not preempted.³⁷³ Under this analysis, Midler's cause of action should not be preempted since her voice, an aspect of her *persona*, is not a fixed work of authorship.

364. *Id.* § 106(2).

365. See M. NIMMER, *supra* note 360, § 1.01[B], at 1-10 to -12; see also *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1099-1100 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981).

366. M. NIMMER, *supra* note 360, § 1.01[B], at 1-13.

367. *Id.*

368. See *Midler*, 849 F.2d at 463.

369. See *supra* notes 359-60 and accompanying text.

370. 17 U.S.C. § 301(a) (1982).

371. Traditionally, courts have defined the term "persona" as the identifying aspects of one's personality, specifically one's name and visual likeness. J. MCCARTHY, *supra* note 1, § 4-14[A], at 4-81. However, opponents of preemption could argue that a voice is also an identifying feature of one's personality comprising the *persona*. *Id.* § 4-14[A], at 4-81 to -82.

372. See *supra* note 353 for the definition of the term "tangible medium of expression."

373. M. NIMMER, *supra* note 360, § 1.01[B], at 1-22 to -22.4.

b. reasons to support federal preemption

Federal preemption supporters would extinguish Midler's cause of action. They suggest a different analysis of the first tier regarding equivalency.³⁷⁴ One commentator expressly denounced the additional-element theory saying that "[i]f merely adding an extra element would prevent preemption, states could easily subvert federal preemption by simply appending a superfluous requirement to the right of publicity laws."³⁷⁵ Congress intended a state right to be preempted unless it is qualitatively different from the right protected under federal copyright law.³⁷⁶ The House Report on the 1976 Copyright Act reflects this intent:

[R]ights and remedies that are *different in nature* from the rights comprised in a copyright . . . may continue to be protected under State common law or statute. The evolving common law rights of "privacy," "publicity," and trade secrets, and the general laws of defamation and fraud, would remain unaffected as long as the causes of action contain elements, such as invasion of personal rights or a breach of trust or confidentiality, that are *different in kind* from copyright infringement.³⁷⁷

374. See, e.g., *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236 (C.D. Cal. 1987); *Universal City Studios v. The T-Shirt Gallery, Ltd.*, 634 F. Supp. 1468 (S.D.N.Y. 1986); *Mayer v. Josiah Wedgwood & Sons, Ltd.*, 601 F. Supp. 1523 (S.D.N.Y. 1985); *Harper & Row, Publishers v. Nation Enters.*, 501 F. Supp. 848 (S.D.N.Y. 1980), *rev'd on other grounds*, 471 U.S. 539 (1985).

375. Note, *Copyright and the Right of Publicity: One Pea in Two Pods?*, 71 GEO. L.J. 1567, 1580 (1983).

376. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 132, *reprinted in* 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5747-48. The court in *Harper & Row, Publishers v. Nation Enterprises*, also rejected the "additional element" equivalency standard. 501 F. Supp. 848, 853-54 (S.D.N.Y. 1980). The court reasoned that merely because a state right requires additional elements to be proven does not mean that the state law will evade preemption. *Id.* To escape preemption, the court said, the "state cause of action must protect rights under the facts of a particular case which are *qualitatively* different from the rights of reproduction, performance, distribution, or display." *Id.* at 852 (emphasis in original).

377. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 132, *reprinted in* 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5748 (emphasis added). Recently, a district court in *Motown Record Corp. v. George A. Hormel & Co.*, applied this interpretation of the "equivalency" standard to facts similar to *Midler*. 657 F. Supp. 1236 (C.D. Cal. 1987). In *Motown*, the defendants used the tune of "Baby Love," made popular by The Supremes, and inserted the words "Dinty Moore" to advertise their product. *Id.* at 1237. Furthermore, the defendants used the image of The Supremes by featuring three young black women with bouffant hair and sequined formal gowns singing the "Dinty Moore" song. *Id.* Plaintiffs sought protection under California Civil Code section 3344 since the defendants used the image of The Supremes, as well as the song, without permission. *Id.* at 1240.

The court held that in order for a state claim not to be preempted it must be "qualitatively different" from the copyright infringement claim. *Id.* at 1239-40 (quoting *Mayer v. Josiah Wedgwood & Sons, Ltd.*, 601 F. Supp. 1523, 1535 (S.D.N.Y. 1985)). The court held that since

Those supporting federal preemption would have analyzed the *Midler* case under the first tier differently than would those opposed to federal preemption. The Copyright Act itself provides a logical progression leading to section 114(b), a section which could preempt Midler's claim.³⁷⁸ The progression is as follows: Section 301 leads the reader to section 106 by indicating that if the state rights are equivalent to the federal rights listed in section 106, those state rights will be preempted.³⁷⁹ Section 106(2) provides that the copyright owner has the exclusive right "to prepare derivative works based upon the copyrighted work."³⁸⁰ Section 106 states that it is subject to sections 107 through 118,³⁸¹ which in turn elaborate on the copyright owner's rights. The relevant provision is found in section 114(b).³⁸² The Notes of the Committee on the Judiciary for this section provide that "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."³⁸³ Under section 114(b), nothing prohibits an owner of a copyrighted song from imitating the *style* of an artist's recording of that song.³⁸⁴

In *Midler*, the defendants had a copyright license to use the song "Do You Want To Dance;"³⁸⁵ therefore, they should have been afforded protection to the fullest extent allowed by copyright law. Midler was actually attempting to prevent the defendants from doing exactly what

the plaintiffs complained of the defendants' alleged unauthorized use of a copyrighted work, the rights they sought were not qualitatively different from copyright law, and therefore their state claim was preempted. *Id.* at 1241. By not addressing the plaintiffs' right of publicity claim, the court implied that it thought that claim was not "qualitatively different" enough to bring the state claim out of the zone of copyright protection.

378. See 17 U.S.C. § 114(b) (1982).

379. *Id.* § 301 (1982).

380. *Id.* § 106(2).

381. *Id.* § 106.

382. *Id.* § 114(b). See *supra* note 49 for the relevant text of section 114(b).

383. 17 U.S.C.A. § 114(b) notes of committee on the judiciary (West 1977). In typical right of publicity cases, some courts have found that the right of publicity would not be preempted. See, e.g., *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981). However those cases dealt with a celebrity's "name or likeness," not "voice," therefore section 114(b) was never invoked. In *Midler*, section 114(b) addresses the identical right that Midler wanted to protect under state law; therefore, the federal law should prevail.

384. J. MCCARTHY, *supra* note 1, § 4.14[E][2], at 4-92. Even if the "additional element" theory opposing preemption were accepted, it could be refuted under a section 114(b) analysis, since an artist's "style," which the copyright owner is allowed to imitate, is arguably equivalent to an artist's "persona." Because no "additional element" exists, the state and federal laws are equivalent; therefore, the state law must be preempted.

385. *Midler*, 849 F.2d at 462.

section 114(b) allows. She sought rights in her version of the song,³⁸⁶ while the defendants sought the right to create any version of the song that they wished to create. Under this analysis, preemption supporters would argue that the rights sought by the parties were not qualitatively "different in nature,"³⁸⁷ but were equivalent. When a conflict such as this occurs, the federal statute must prevail pursuant to the Supremacy Clause of the Constitution.³⁸⁸

In *Allied Artists Pictures Corp. v. Rhodes*,³⁸⁹ the court also applied a broader definition of the term "equivalent." In *Rhodes*, an Ohio statute made it illegal for producers to sell their films through a "blind bidding" process.³⁹⁰ The blind bidding procedure allowed motion pictures to be licensed to a theater owner without giving the owner an opportunity to first screen the films.³⁹¹ The producers contended that the Ohio statute prohibiting blind bidding violated federal copyright law.³⁹²

The court upheld the Ohio statute and suggested that in order for preemption to occur, it must be determined whether a state statute "creates, grants, or destroys any rights that are 'equivalent' to the exclusive rights of copyright set forth in [section 106 of the 1976 Act]."³⁹³ The court observed that section 106 provides copyright owners with the rights to prohibit reproduction, performance, distribution or display of their work.³⁹⁴ If by exercising the above rights, the court held, a copyright owner violates a state statute, then the state statute is preempted by the 1976 Act.³⁹⁵ In applying this test, the court stated that since the statute did not deprive the copyright owners of the right to reproduce, perform, distribute or display their films, or give any of these rights to the purchasers, it would not be preempted.³⁹⁶

In contrast, applying this test to the *Midler* case would have resulted in preemption. The state right of publicity would destroy the defendant's rights under section 114(b), which allows the licensed defendant to exactly imitate any rendition or performance of a copyrighted work.³⁹⁷

386. See *supra* note 278.

387. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 132, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5748.

388. U.S. CONST. art. VI.

389. 496 F. Supp. 408 (S.D. Ohio 1980), *aff'd in part*, 679 F.2d 656 (6th Cir. 1982).

390. *Id.* at 412-13.

391. *Id.* at 412.

392. *Id.* at 413.

393. *Id.* at 443.

394. *Id.* See *supra* note 359 for the text of Title 17, section 106.

395. *Rhodes*, 496 F. Supp. at 443.

396. *Id.*

397. 17 U.S.C. § 114(b) (1982).

Protecting Midler under a state publicity right effectively prevented the defendants from enjoying their exclusive federal right to reproduce their copyrighted work in any manner whatsoever. Because Midler's state-law right of publicity interfered with the defendant's federal rights, it should have been preempted.³⁹⁸

The second tier of the test³⁹⁹ could also be interpreted by preemption supporters to extinguish Midler's right of publicity cause of action. This tier suggests that a state-created claim will be preempted if: (1) the work is fixed in a tangible medium of expression; and (2) comes within the subject matter of copyright under sections 102 and 103.⁴⁰⁰ In *Midler*, both of these requirements were met.⁴⁰¹ First, Midler's rendition of "Do You Want To Dance" was fixed in a sound recording which is a tangible medium of expression; and second, a sound recording is expressly included within the subject matter of section 102.⁴⁰² Consequently, under this analysis, Midler's claim should have been preempted.⁴⁰³

3. Proposed resolution

As demonstrated above, the language of the Copyright Act supports both views of preemption. The ambiguities are particularly acute when dealing with the imitation of an artist's voice. Those opposed to preemption would argue that not only is Midler's rendition of the song being protected, but so is the additional element of her "persona," and therefore her claim should not be preempted.⁴⁰⁴ However, preemption supporters would suggest otherwise, since the practical effect is the protection against the imitation of Midler's vocal performance, which is exactly what the defendants are permitted to imitate under section

398. See *supra* notes 326-51 for a discussion of the preemption cases.

399. See 17 U.S.C. § 301(a) (1982). See also *supra* notes 359-60 and accompanying text.

400. See 17 U.S.C. § 301(a) (1982).

401. The facts indicate that the defendants obtained the license from the copyright holder to use the song. *Midler*, 849 F.2d at 462. It logically follows that the song is fixed in a tangible medium of expression and falls within the subject matter of copyright. See 17 U.S.C. § 102(a) (1982).

402. See 17 U.S.C. § 102(a)(7) (1982).

403. In *Baltimore Orioles v. Major League Baseball Players Ass'n*, baseball players contended that they owned the broadcast rights to their performances during a baseball game. 805 F.2d 663, 667 (7th Cir. 1986). Furthermore, they claimed that the rights they wanted were not works within the meaning of section 301, and therefore were not subject to preemption. *Id.* at 676. The court rejected this contention, asserting that since the players' performances were recorded, they were embodied in a tangible means of expression within the subject matter of section 102. *Id.* Thus, the court held, as long as the "equivalency" prong was satisfied, the players' state rights would be preempted. *Id.*

404. See *supra* notes 362-73 and accompanying text.

114(b).⁴⁰⁵ This tension indicates that the Copyright Act is not clear and unequivocal as Congress intended it to be,⁴⁰⁶ but is rather vague and ambiguous.

Congress could best resolve this conflict by drawing a narrow exception to section 114(b)⁴⁰⁷ when applied to commercial advertising. This exception should take the form of a "substantial-similarity" test. If a plaintiff can show that the defendant's advertisement is "substantially similar," in both ideas and expression, to that of the plaintiff, then the plaintiff's state-law rights should not be preempted by section 114(b). Using this standard, a line could be drawn designating where the copyright owner's freedom to imitate under section 114(b) ends and the protection of the artist begins.

The substantial-similarity test has been used previously to determine whether a person has infringed upon another's copyright.⁴⁰⁸ In *See v. Durang*,⁴⁰⁹ the Ninth Circuit employed the substantial-similarity standard to ascertain whether the defendant infringed upon the plaintiff's copyrighted play, *Fear of Acting*, through the production of the defendant's play, *The Actor's Nightmare*.⁴¹⁰ The plaintiff argued that a comparison be made, not only between the works as a whole, but also between their component parts.⁴¹¹ The plaintiff urged that copying only one portion of a play should constitute copyright infringement.⁴¹²

The court rejected this argument stating that the works must be viewed as a whole to determine whether they are substantially similar.⁴¹³ After reviewing both screenplays in their entirety, the court affirmed the district court's ruling "that no reasonable trier of fact could find the two plays to be substantially similar in their form of expressing common ideas."⁴¹⁴

The same test was applied by the Ninth Circuit in *Litchfield v.*

405. See *supra* notes 374-403 and accompanying text.

406. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 130, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5746.

407. 17 U.S.C. § 114(b) (1982). See *supra* note 49 for the text of section 114(b).

408. See, e.g., *Litchfield v. Spielberg*, 736 F.2d 1352 (9th Cir. 1984); *See v. Durang*, 711 F.2d 141 (9th Cir. 1983); *Jason v. Fonda*, 698 F.2d 966 (9th Cir. 1982), incorporating by reference, 526 F. Supp. 774 (C.D. Cal. 1982); *Sid & Marty Krofft Television Prods. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977); *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946).

409. 711 F.2d 141 (9th Cir. 1983).

410. *Id.* at 142.

411. *Id.* at 143.

412. *Id.*

413. *Id.* at 144.

414. *Id.* at 143.

Spielberg,⁴¹⁵ where the producers of the motion picture, *E.T.—The Extra Terrestrial* were sued for copying the plaintiff's copyrighted play, *Lokey from Maldemar*.⁴¹⁶ To determine whether Spielberg copied the play, the court applied the substantial-similarity test.⁴¹⁷ The plaintiff had the burden of proving "that the works [were] substantially similar in both *ideas* and *expression*."⁴¹⁸ First, to determine if the ideas were similar, the court applied an extrinsic test focusing on the alleged similarities in the objective details of the works.⁴¹⁹ The court made it clear that any similarities existing only at a general level would not constitute an infringement.⁴²⁰ Second, to determine similarity of expression, an intrinsic test focusing on the expected subjective response of an ordinary, reasonable person was applied.⁴²¹ The court pointed out that infringement of expression is a difficult standard to prove because "the total concept and feel of the works must be substantially similar."⁴²² The court compared the two works and held that "[n]o lay observer would recognize *E.T.* as a dramatization or picturization of *Lokey*"⁴²³ and therefore, there had been no infringement.⁴²⁴

The standard, after *Litchfield*, may be articulated as follows: The plaintiff's cause of action will not be preempted if (1) a reasonable trier of fact would find the two works substantially similar; (2) when viewing the works as a whole; (3) objectively focusing on the idea or details of each work; and (4) subjectively focusing on the manner in which each work was expressed. This standard would protect the copyright holder's freedom to imitate under section 114(b) of the 1976 Act,⁴²⁵ because it is difficult for the plaintiff or performer to prove all four elements. Yet, the standard would limit the defendant's freedom if the imitation is so close as to be indistinguishable from the plaintiff's performance. If the similarities were so substantial, the performer would meet the burden of proof, and the state causes of action would not be preempted by the 1976

415. 736 F.2d 1352 (9th Cir. 1984), *cert. denied*, 470 U.S. 1052 (1985).

416. *Id.* at 1355.

417. *Id.* at 1356.

418. *Id.* (quoting *Sid & Marty Krofft Television Prods. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977)) (emphasis in original).

419. *Id.*

420. *Id.* at 1356-57. An example of a general similarity is a "stock scene" used in many plays to establish a general plot. *Id.*

421. *Id.* at 1356 (quoting *Sid & Marty Krofft*, 562 F.2d at 1164).

422. *Id.* at 1357.

423. *Id.*

424. *Id.*

425. 17 U.S.C. § 114(b) (1982).

Act.⁴²⁶ In this way the copyright owner would maintain some freedom and the performer's right of publicity would be protected. In *Midler*, there was no copyright infringement since Ford obtained a copyright license for the song "Do You Want To Dance."⁴²⁷ However, the substantial-similarity standard could still prove useful in determining whether the imitation violated Midler's right not to be commercially exploited.

Had the substantial-similarity test been applied in *Midler*,⁴²⁸ the burden of proof would most likely have been met. First, the evidence showed that many people who heard the Ford commercial believed that Midler was actually singing "Do You Want To Dance."⁴²⁹ Therefore, a reasonable trier of fact would most likely find the two works substantially similar. Second, the evidence suggested that the entire song was intended to sound like Midler's version.⁴³⁰ Third, the idea or details of each work were clearly the same since the defendants obtained a copyright in "Do You Want To Dance,"⁴³¹ the very song Midler had recorded. The fourth prong—the subjective test—would be the most difficult to prove, for each rendition of the song would have to be heard by a subjective listener to determine whether a reasonable person would think the manner of expression was identical. The *Midler* facts satisfy this prong because the evidence showed that many people confused Hedwig for Midler.⁴³² Presumably, all four prongs of the above test would have been satisfied. Thus, applying this standard, Midler's state-law causes of action would not be preempted by the 1976 Act.

In summary, in order for Congress to achieve its fundamental goal of promoting "national uniformity in copyright protection,"⁴³³ it must amend section 114(b) of the 1976 Act to clarify the relationship between copyright law and common-law publicity rights as they relate to commercial advertisements. It is hoped that the above proposal will provide some guidance. Until Congress ends the confusion, the courts must grapple with this ever-increasing problem.

426. *Id.* §§ 101-810.

427. *Midler*, 849 F.2d at 462.

428. See *supra* notes 19-36 and accompanying text for a summary of the facts of *Midler*.

429. *Midler*, 849 F.2d at 461-62.

430. *Id.* at 461. Ula Hedwig, the Midler sound-alike, was told to sing the song sounding as much like Midler as possible. *Id.*

431. The copyright holder granted Young & Rubicam a license to use the song. *Id.* at 462.

432. *Id.* at 461-62. One person declared by affidavit that he heard the commercial several times and thought that Midler was singing. *Id.* at 462.

433. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 129, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5745.

V. CONCLUSION

In *Midler v. Ford Motor Co.*,⁴³⁴ the Ninth Circuit held that a well-known artist's voice could not be commercially appropriated.⁴³⁵ Although the result is admirable, the reasoning is flawed. The court should have protected Midler by interpreting California Civil Code section 3344 to include *all* unauthorized uses of a voice.⁴³⁶ Instead, the court based its decision on an unprecedented expansion of the malleable common-law right of publicity doctrine.⁴³⁷

As the case was remanded to the trial court,⁴³⁸ it may reach the Ninth Circuit again. If so, the court could afford Midler state-law protection,⁴³⁹ but it would then have to deal with preemption under federal law. Whether or not Midler's claim should be preempted is unclear. Those courts which have struggled with this problem are split on the preemption issue.⁴⁴⁰ Furthermore, federal preemption with respect to voice brings into question section 114(b) of the Copyright Act.⁴⁴¹ This issue has never been addressed by any court. Hopefully, Congress will recognize that the Act is not "stated in the clearest and most unequivocal language possible,"⁴⁴² and amend it so that Midler, and those similarly situated, will be able to protect what rightfully belongs to them.

*Kimberly Lehman Turner**

434. 849 F.2d 460 (9th Cir. 1988).

435. *Id.* at 463.

436. See *supra* notes 109-216 and accompanying text for a discussion of California Civil Code section 3344.

437. See *supra* notes 217-309 and accompanying text for a discussion of the common-law theories.

438. *Midler*, 849 F.2d at 464. See *Postscript*, p. 644 for the results of the new trial.

439. This Note suggests that the court should have protected Midler under California Civil Code section 3344 instead of under the misappropriation doctrine. See *supra* notes 109-216 and accompanying text for a discussion of this statute and its potential application to *Midler*.

440. See, e.g., *Baltimore Orioles v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986); *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236 (C.D. Cal. 1987); *Universal City Studios v. The T-Shirt Gallery, Ltd.*, 634 F. Supp. 1468 (S.D.N.Y. 1986); *Mayer v. Josiah Wedgwood & Sons, Ltd.*, 601 F. Supp. 1523 (S.D.N.Y. 1985); *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981); *Harper & Row, Publishers v. Nation Enters.*, 501 F. Supp. 848 (S.D.N.Y. 1980), *rev'd on other grounds*, 471 U.S. 539 (1985); *Allied Artists Pictures Corp. v. Rhodes*, 496 F. Supp. 408 (S.D. Ohio 1980), *aff'd in part*, 679 F.2d 656 (6th Cir. 1982). See also *supra* notes 362-403 and accompanying text.

441. 17 U.S.C. § 114(b) (1982).

442. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 130, *reprinted in* 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5746.

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Postscript

On October 24, 1989, the parties returned to the United States District Court for the Central District of California for a trial on the merits. Daily Variety, Oct. 25, 1989, at 1, col. 1. Midler sought ten million dollars from Ford alleging that the car company imitated her voice for commercial purposes. Id. However, after determining that there was insufficient evidence showing Ford's actual participation in the advertisement, Judge A. Wallace Tashima dismissed Ford from the case. L.A. Daily J., Oct. 27, 1989, at 1, col. 6.

The case proceeded against Ford's advertising agency, Young & Rubicam, from whom Midler sought 2.5 million dollars. L.A. Daily J., Oct. 31, 1989, at 1, col. 5. Judge Tashima instructed the jurors that if they found Midler's voice was widely known and deliberately imitated in order to sell a product, then the defendant had misappropriated the singer's property rights in her voice. The Hollywood Rep., Oct. 31, 1989, at 1, col. 1. After a full day of deliberation, the jury found Young & Rubicam liable and awarded Bette Midler damages to the tune of \$400,000. L.A. Daily J., Oct. 31, 1989, at 1, col. 5.