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**Can Distinctiveness of Musical Identity Be Protected?**

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*Citations to cases referred to in this article are listed at the end of the article.*

The distinct, sultry voice of Astrud Oliveira, known professionally as Astrud Gilberto, had long been identified with "The Girl From Ipanema," the classic 1964 recording of the famous Antonio Carlos Jobim song. Gilberto's vocal performance won her a Grammy award. That fame was not enough, however, to win a lawsuit she brought in 2001 for infringement of alleged trademark rights in her vocal performance–based on use of the song in a television commercial. Although Gilberto owned no copyrights in the underlying song or performance, she claimed she had become identified by the public with the recording and that she had acquired trademark rights in the song, requiring the advertiser to obtain her consent. Absent such consent, she argued, use of the recording capitalized on her reputation and was likely to cause confusion as to her affiliation with or endorsement of advertiser Frito-Lay.

The U.S. Court of Appeals for the Second Circuit affirmed a dismissal of Gilberto's trademark claim based on a false endorsement on the ground that a fact-finder "could not reasonably find an implied endorsement." The district court, however, had issued a broader ruling, holding that "there is no federal [trademark] protection for a musical work," because such works are otherwise protected by copyright law. The court of appeals rejected this broad proposition and held instead that musical compositions could be eligible for trademark protection as a "symbol or device to identify a person's goods or services," just as graphic designs can serve as trademarks and still be protected by copyright. Nevertheless, the Court rejected Gilberto's remaining trademark and dilution claims, because there was no precedent to support the argument that a performing artist "acquires a trademark or service mark signifying herself in a recording of her own famous recording."

This conclusion was based on a 1970 Ninth Circuit decision in a case brought by Nancy Sinatra against Goodyear Tire for its use of the song "These Boots Are Made for Walkin'," which she sang. Goodyear properly licensed its use of the song from copyright owners, and unknown singers sang the song in an ad. Sinatra claimed that she had made the song so popular that her name had become associated with it, such that it had acquired secondary meaning and no other person could ever sing it in a commercial. The *Sinatra* court concluded that a musical composition could never serve as a trademark for itself, which the *Gilberto* court reaffirmed. Although *Sinatra* was decided before passage of the modern-day preemption provision in Copyright Act Section 301, the court held that such claims were impliedly preempted by the Act.

Acknowledging other cases where a performing artist's persona had been protected against a false implication of an endorsement, the *Gilberto* court ruled that Frito-Lay's use of the song had not taken

her persona by implying that she endorsed the product. The court concluded it would not be "unthinkable" for trademark law to grant a performing artist trademark protection in his or her signature performance, but that such an expansion of trademark law would require legislative action. Otherwise, granting such rights to singers would stifle commerce by allowing suits against parties who had otherwise properly licensed all known copyrights in a work from the owners of those rights.

Unlike Gilberto and Sinatra, Tom Waits's musical "persona" was sufficient in a 1992 decision to grant him judgment on a false implied endorsement claim against a company that used a "copycat" singer who imitated Waits's distinctive raspy, gravelly singing style in a radio commercial praising snack-food products. Waits himself had never done commercials or endorsed any product; in fact, he believed strongly that musical artists should never do commercials. In that decision, the U.S. Court of Appeals for the Ninth Circuit found that Waits had a valid claim under California state law, where misappropriation of a singer's distinctive voice was actionable as a tort (a spin-off of California's broad right of publicity). On Waits's false endorsement claim under Lanham Act Section 43(a), the court held that "a celebrity whose endorsement of a product is implied through the imitation of a distinctive attribute of the celebrity's identity[] has standing to sue for false endorsement" and need not be a "competitor" of the defendant's. (Traditional false advertising cases under Section 43(a) require the claimant to be a competitor of the defendant's, but that is not the case for a false endorsement or false association claim.) Finding that the jury had properly credited evidence of actual confusion between the stand-in singer and Waits himself, the court affirmed the judgment in favor of Waits.

In 1988, the Ninth Circuit had sustained claims by singer Bette Midler for false endorsement under Section 43(a), as well as for misappropriation of persona under California common law, where a "sound-alike" performer was used in a commercial after Midler had refused to participate. Although the court rejected Midler's separate California statutory publicity claim because the voice used was not her real voice, it ruled that the other vocal imitation claims were not preempted by copyright law because the "thing" misappropriated, namely her voice, was not itself copyrightable.

Similarly, in 1990, a New York federal district court held that while there was no claim for use of a "Fat Boys" sound-alike under New York's Civil Rights Law (New York's right of privacy statue) because the statute applies only to names, images and likenesses, a claim was stated under Section 43(a) of the Lanham Act.

Clarifying California's common law for misappropriation claims and the interplay with copyright, the Ninth Circuit held on May 24, 2006, in *Laws v. Sony Music Entertainment*, that a recording artist's state-law claims for misappropriation of her voice and invasion of privacy were preempted by the Copyright Act because the claims were based only on reproductions of her songs, and those rights were equivalent to rights protected by copyright. Sony did not imitate Laws's voice but had a license to use a sample of her recording. Because the artist's voice became a part of a sound recording in a fixed, tangible medium, it came within the subject matter of copyright. The case did not, however, assert a false endorsement claim under the Lanham Act. The Laws court noted that, "in contrast to *Midler* and *Waits*, where the licensing party obtained only a license to the song and then imitated the artist's voice, here Sony obtained a license to use Laws's recording itself. Sony was not imitating [the song] as Laws might have sung it. Rather, it used a portion of [the song] as sung by Debra Laws."

In the non-music celebrity persona context, the Ninth Circuit ruled in 2000 that use of a Three Stooges film clip in a feature film did not constitute trademark infringement under the Lanham Act, even where the underlying copyright had fallen into the public domain. Although plaintiff argued that the clip was particularly distinctive of The Three Stooges' comedy routine, the court held it was still within the scope

of copyright. Calling the trademark claim a "fanciful argument," the court concluded the case was unlike *Waits* or other cases that had recognized celebrity persona claims. Those cases involved use of a performer's persona through sound-alikes or look-alikes for commercial endorsements, rather than use of the exact work in which the artist's original performance was embodied, the latter being within the exclusive domain of copyright.

Two other prominent Ninth Circuit non-music persona cases upholding Section 43(a) false endorsement-type claims bear mention. In a controversial 1992 case by the actress Vanna White, where her likeness was used in a commercial using a robot made to look like her and cast in a set evoking the TV show *Wheel of Fortune*, which she had co-hosted, the court found there were material issues that required a jury trial. In 1997, the court decided in favor of two actors portraying lead characters from the hit television series *Cheers*, where their physical likenesses were embodied in robots that were placed in airport bars.

The Waits decision and later cases addressing the simulation of an artist's voice or style look to alternative theories of false endorsement and state misappropriation law to avoid conflicts with federal copyright law and preemption arguments. Because California, as distinguished from New York, recognizes broad statutory and common-law publicity rights, musical artists may have more opportunities to seek redress for imitative use of their performances or false endorsement claims under both state law and the Lanham Act in California courts. But both the Second and the Ninth circuits, sitting in New York and California, respectively, have recognized false endorsement cases under Section 43(a) of the Lanham Act. As media technology advances, and imitative sound- and look-alikes become easier to create digitally, we will likely see further developments in this area.

**Cases cited**

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