

# TRUMPED BY FALSE ENDORSEMENT: MUSICIANS STILL MIGHT HAVE INTELLECTUAL PROPERTY RIGHTS TO PROHIBIT POLITICIANS FROM USING THEIR SONGS DESPITE COPYRIGHT LICENSES

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## I. INTRODUCTION

In perhaps one of the most divisive campaigns to date, President Donald Trump has proven he is no stranger to criticism. Among the critics are those in the music industry who have publicly denounced his use of their songs during his campaign.

In May 2015, The Rolling Stones asked Donald Trump to stop playing their songs at his campaign events.<sup>1</sup> After effectively sealing the Republican nomination on May 3, Trump played the Stones' hit *Start Me Up* as he left the stage following a victory speech.<sup>2</sup> However, the band said in a statement: "The Rolling Stones have never given permission to the Trump campaign to use their songs and have requested that they cease all use immediately."<sup>3</sup> Trump is known to be a fan of the Stones and has previously played *You Can't Always Get What You Want*, *Sympathy for the Devil*, and *Brown Sugar* at campaign events.<sup>4</sup>

In June 2015, Neil Young criticized Trump for using his song *Rockin' in the Free World* when Trump launched his U.S. presidential campaign.<sup>5</sup> Young stated "Donald Trump was not authorized to use *Rockin' in the Free World* in his presidential candidacy announcement."<sup>6</sup> The statement went on to indicate that Young supports Vermont Senator Bernie Sanders, an independent and one

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1. Martin Chilton, *Adele, Rolling Stones and other musicians angry at politicians using their songs*, THE TELEGRAPH (May 5, 2016, 7:05 AM), <http://www.telegraph.co.uk/music/artists/adele-and-other-musicians-angry-at-politicians-using-their-songs/>.

2. *Id.*

3. *Id.*

4. Barney Henderson, *Rolling Stones ban Donald Trump from using their songs after he plays Start Me Up*, THE TELEGRAPH (May 4, 2016, 8:37 PM), <http://www.telegraph.co.uk/news/2016/05/04/rolling-stones-ban-donald-trump-from-using-their-songs-after-he/>.

5. Chilton, *supra* note 1.

6. *Id.*

of the most outspoken liberals in Congress for the 2016 Democratic presidential nomination.<sup>7</sup>

A Trump campaign spokeswoman replied that Trump's team paid for the legal right to play Young's recording during the launch of his campaign through a license agreement with American Society of Composers, Authors and Publishers (ASCAP).<sup>8</sup> She added, "[n]evertheless, we won't be using it again—there are plenty of songs to choose from. Despite Neil's differing political views, Mr. Trump likes Neil very much."<sup>9</sup>

In October 2015, after Trump used Steven Tyler's song *Dream On*, Tyler's attorney stated "Trump for President does not have our client's permission to use *Dream On* . . . because it gives the false impression that he is connected with or endorses Mr. Trump's presidential bid."<sup>10</sup> Trump later tweeted "[e]ven though I have the legal right to use Steven Tyler's song, he asked me not to. [I] have [a] better one to take its place!"<sup>11</sup>

Similarly, in 2012, Mitt Romney stopped using K'naan's song *Wavin' Flag* even though Romney's reps insisted they had permission through blanket licenses purchased from ASCAP and BMI (Broadcast Music Inc.).<sup>12</sup> The Somali-Canadian musician's song, featuring vocals from Will.i.am and David Guetta, gained popularity in the wake of the 2010 earthquake in Haiti and then took off even more when Coca-Cola used a version of it as the anthem of the FIFA World Cup in South Africa.<sup>13</sup> When Romney played it during a victory rally in Florida, K'naan was deluged with Twitter messages accusing him of selling out to a conservative politician.<sup>14</sup> The musician threatened legal action against the Romney campaign, explaining, "I'm for immigrants. I'm for poor people, and

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7. *Id.*

8. *Id.*

9. *Id.*

10. Daniel Kreps, *Aerosmith Warns Donald Trump Over 'Dream On' Use*, ROLLING STONE (October 11, 2015), <http://www.rollingstone.com/music/news/aerosmith-warns-donald-trump-over-dream-on-use-20151011>.

11. *Id.*

12. Eveline Chao, *Stop Using My Song: 35 Artists Who Fought Politicians Over Their Music*, ROLLING STONE (July 8, 2015), <http://www.rollingstone.com/music/lists/stop-using-my-song-34-artists-who-fought-politicians-over-their-music-20150708/knaan-vs-mitt-romney-20150629>.

13. *Id.*

14. *Id.*

they don't seem to be what [Romney's] endorsing."<sup>15</sup> Again, though Romney had acquired a license to play the song, he stopped using it out of respect for K'naan's views.<sup>16</sup>

This brings up an interesting question: though political candidates, such as Trump and Romney, paid for a license to play a musician's song, could the musician nevertheless have a legal claim against the politician for such use? While Trump might be the worst repeat offender,<sup>17</sup> politicians using musicians' songs in campaigns and musicians getting upset over that use is nothing new.<sup>18</sup> What might be a new concept, however, is the fact that though the politician correctly uses the song under copyright law—*i.e.*, buys a license—the musician can still have legal remedies to prevent the politician from using the song.<sup>19</sup> Specifically, while the musician might try to bring causes of action under copyright infringement, right of publicity, and/or false endorsement theories, the musician could very well assert a successful cause of action through a false endorsement claim. False endorsement sounds in trademark law where the celebrity owns a trademark, and the celebrity does not want that mark to be

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15. *Id.*

16. *Id.*

17. In September 2015, rock band R.E.M. lashed out at Trump for using their hit song *It's the End of the World* at a rally. See Chilton, *supra* note 1. In February 2016, another high-profile musician, Sir Elton John, also publicly denounced Trump's use of his 1972 hit song *Rocket Man* at political rallies. See Martin Chilton, *Elton John: I do not endorse Donald Trump*, THE TELEGRAPH (February 3, 2016, 11:06 AM), <http://www.telegraph.co.uk/music/artists/elton-john-tells-donald-trump-dont-use-my-music/>. Finally, in February 2016, Adele complained about Trump's use of her song *Rolling in the Deep* to promote his presidential candidacy. See Chilton, *supra* note 1.

18. For example, Tom Petty sued Michele Bachmann for her use of *American Girl*; Sam Moore sued Barack Obama for his use of *Hold On! I'm Coming*, and Bruce Springsteen sued Ronald Reagan's 1984 Campaign for using *Born in the U.S.A.* Tom Petty's War on Michele Bachmann, THE DAILY BEAST (Nov. 29, 2011, 11:00 PM), <http://www.thedailybeast.com/articles/2011/06/29/tom-petty-against-michele-bachmann-springsteen-against-ronald-reagan-musicians-vs-politicians.html>. Though lawsuits over song use are relatively new, politicians have used music in their campaigns as early as the late 1800s: Andrew Jackson used the song *The Hunters of Kentucky*; Abraham Lincoln used *The Battle Cry of Freedom*; and Franklin Roosevelt used *Happy Days are Here Again*. See Jennifer L. Elgin, *Copyrights and Campaigns*, CAMPAIGNS AND ELECTIONS (May 29, 2012), <https://www.campaignsandelections.com/campaign-insider/copyrights-and-campaigns>.

19. *Using Music in Political Campaigns: What You Should Know*, ASCAP.COM, <https://www.ascap.com/about/legislation/advocacy-resources/using-music-in-political-campaigns-what-you-should-know.aspx> (explaining that while campaigns can be in compliance with copyright law because either the venue has a proper "public performance" license or the campaign has obtained a public performance license from ASCAP (the industry licensing service), the campaign can still be criticized or even sued by an artist for playing his or her song at an event).

falsely associated with someone or something other than the celebrity. Another article addressing this topic considered whether the musician might have a cause of action under trademark law but looked at whether the particular *song* used by the politician could be considered a trademark in and of itself to give rise to the musician's false endorsement claim.<sup>20</sup> However, the article ultimately concluded that a "song-mark" protection theory was not viable, and, even if it was, it would be preempted by copyright law.<sup>21</sup> This article, however, considers a false endorsement cause of action where the celebrity's *identity* is the equivalent of the mark—not the particular song. This is really distinct from trademark in a song. Also, while a false endorsement claim is similar to a right of publicity claim, the false endorsement claim derives from federal law.<sup>22</sup> Therefore, unlike right of publicity, false endorsement might not be so easily preempted by copyright law.

Part I of this article discusses the background of copyright law as it relates to this issue. Parts II and III look at false endorsement and right of publicity causes of action, respectively. Part IV discusses preemption issues with the right of publicity and copyright law. This article concludes in part V that while the musician might very well assert both right of publicity and false endorsement causes of action, if the politician has a license to use the song, the musician's right of publicity claim will likely be preempted and as a result fail. But the musician could still assert a false endorsement cause of action and be successful.

## II. BACKGROUND

Congress enacted the Copyright Act to define and protect the rights of copyright holders.<sup>23</sup> Under the Copyright Act, a copyright is defined as "a

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20. Kimberlianne Podlas, *I Do Not Endorse This Message! Does A Political Campaign's Unauthorized Use of A Song Infringe on the Rights of the Musical Performer?*, 24 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 1, 2–3 (2013) (addressing whether a political campaign's use of a song without the permission of its performer infringes on any trademark rights of the performer).

21. *Id.*

22. In 1946, Congress passed the Lanham Act, which defines federal trademark protection and trademark registration rules. See Lanham Act, 15 U.S.C. §§ 1051–1127 (2012). The Lanham Act is based on Congress's ability to regulate goods traveling through interstate commerce under the Commerce Clause of the U.S. Constitution. U.S. Const. Art. I, § 8, cl. 3 ("The Congress shall have power to regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes.").

23. Copyright Act, 17 U.S.C. §§ 101–1332 (2012). Copyright law is federal law, derived from the Copyright Clause of the U.S. Constitution. U.S. Const. Art. I, § 8, cl. 8 ("Congress shall have 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. . . .").

limited monopoly that protects original works of authorship fixed in a tangible medium of expression.”<sup>24</sup> For example, photos, videos, music, artwork, and text are all works protected by copyright law.<sup>25</sup> The copyright owner is said to have a “bundle of exclusive rights” including the right to control the reproduction, distribution and adaptation of his or her creative expression.<sup>26</sup>

While copyright fixes on any tangible medium of original authorship (registered or unregistered), a registered work with the U.S. Copyright Office provides the copyright holder with a variety of benefits apart from an unregistered work, including the ability to sue for infringement.<sup>27</sup> Because the copyright holder has the right to control the work (*e.g.*, a song), a person seeking to use the work or song needs to get a license from the copyright holder or else face a copyright infringement action. A copyright infringement action challenges the unauthorized use of a song or recording.<sup>28</sup> At the most basic level, there are two elements to copyright infringement: (1) ownership of the copyright by the plaintiff and (2) copying by the defendant.<sup>29</sup>

There are two different copyrights implicated by a song—the musical composition and the sound recording.<sup>30</sup> A musical composition consists of music, including any accompanying words. The author of a musical composition is generally the composer, and the lyricist, if any.<sup>31</sup> A sound recording, on the other hand, results from the fixation of a series of musical, spoken, or other sounds.<sup>32</sup> The author of a sound recording is the performer whose performance is fixed, or the record producer who processes the sounds and fixes them in the

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24. 17 U.S.C. § 102(a).

25. *Id.* (listing eight general categories of copyrightable works: (1) literary works; (2) musical works, including any accompany words; (3) dramatic works; (4) choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures; (7) sound recordings; and (8) architectural works).

26. *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 546 (1985); 17 U.S.C. § 106.

27. 17 U.S.C. § 412 (providing that registration is a prerequisite to certain remedies for infringement).

28. *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134, 1140 (2006).

29. *Zomba Enters., Inc. v. Panorama Records, Inc.*, 491 F.3d 574 (6th Cir. 2007); 17 U.S.C.A. § 501 (West 2016).

30. *Copyright Registration of Musical Compositions and Sound Recordings*, UNITED STATES COPYRIGHT OFFICE 1 (Feb. 2012), <https://www.copyright.gov/circs/circ56a.pdf>.

31. *Id.*

32. *Id.*

final recording, or both.<sup>33</sup> Copyright in a sound recording is not the same as, or a substitute for, copyright in the underlying musical composition.<sup>34</sup>

Two organizations—ASCAP (American Society of Composers, Authors, and Publishers) and BMI (Broadcast Music Inc.)—are the industry leaders for the management of music copyrights.<sup>35</sup> These organizations issue public performance licenses to venues wishing to publicly use the song and collect and distribute royalty fees for members.<sup>36</sup> ASCAP and BMI also police copyrights by monitoring public performances and bring actions against alleged infringers.<sup>37</sup>

Whether the copyright owner can bring a copyright infringement claim against the politician is straightforward.<sup>38</sup> The candidate either has a license to use the song or not.<sup>39</sup> Assuming the candidate pays for the license from ASCAP or BMI, there shouldn't be a copyright issue.<sup>40</sup> A license is a license.<sup>41</sup>

For example, when Trump's team stated they "paid for the *legal right* to play the recording" of Young's *Rockin' in the Free World* through a license agreement from ASCAP,<sup>42</sup> the *legal right* referred to is a copyright license. In other words, assuming Trump secured a license to use the song recording, Young could not sue Trump for copyright infringement (or at least he would not be successful). However, even if the politician properly licenses the artist's music, he still might face resistance from musicians who do not wish to be

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33. *Id.*

34. *Id.*

35. See The American Society of Composers, <https://www.ascap.com/> (last visited Dec. 3, 2016); Broadcast Music Inc., <http://www.bmi.com/> (last visited Dec. 3, 2016); see also RICHARD GRUNER, ET AL., *TRANSACTIONAL INTELLECTUAL PROPERTY: FROM STARTUPS TO PUBLIC COMPANIES*, 475 (3d ed. 2015) ("Together, ASCAP and BMI account for 95% of the United States market for performance rights to musical compositions.").

36. RICHARD GRUNER, ET AL., *TRANSACTIONAL INTELLECTUAL PROPERTY: FROM STARTUPS TO PUBLIC COMPANIES*, 475 (3d ed. 2015).

37. *Id.*

38. Jack Greiner, *Rocking in Trump's world takes the right kind of license*, CINCINNATI.COM (July 27, 2016, 4:46 PM), <http://www.cincinnati.com/story/money/2016/07/27/rocking-trumps-world-takes-right-kind-license/87630420/>.

39. *Id.*

40. *Id.*

41. *Id.*

42. Chilton, *supra* note 1 (emphasis added).

associated with the candidate.<sup>43</sup> In this context, it is possible that such a musician may not be able to claim copyright infringement but could argue that the use of a particular song creates a false association of sponsorship under the Lanham Act.<sup>44</sup> Simply put, if the public thinks the politician's use of the song means the musician supports the campaign, the musician can sue for false endorsement.

### III. FALSE ENDORSEMENT AS A CAUSE OF ACTION

False endorsement is a cause of action under Section 43(a) of the Lanham Act.<sup>45</sup> False endorsement occurs when a person's identity is connected with a product or service in such a way that consumers are likely to be misled about that person's sponsorship or approval of the product or service.<sup>46</sup>

"A false endorsement claim based on the unauthorized use of a celebrity's identity alleges the **misuse** of a **trademark** . . . such as visual likeness, vocal imitation [as well as actual voice], or other uniquely distinguishing characteristic, which is likely to confuse consumers as to the plaintiff's

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43. Nicole Rizzo Smith, *Please Refrain from Using My Refrain: Musicians Again Confront Politicians for Unauthorized Use of Songs*, SUNSTEINLAW.COM, <http://sunsteinlaw.com/please-refrain-from-using-my-refrain-musicians-again-confront-politicians-for-unauthorized-use-of-songs/> (last updated Feb. 2012).

44. *Id.*

45. Lanham Act, 15 U.S.C. § 1125(a)(1) (2012). In 1946, Congress passed the Lanham Act, which defines federal trademark protection and trademark registration rules. See 15 U.S.C. §§ 1051–1127. The Lanham Act is based on Congress's ability to regulate goods traveling through interstate commerce under the Commerce Clause of the U.S. Constitution. U.S. Const. Art. I, § 8, cl. 3 ("The Congress shall have power to regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes."). Thus, like copyright, false endorsement sounds in federal law. But whereas copyright is derived from the Copyright Clause, false endorsement derives from the Commerce Clause of the U.S. Constitution.

46. See *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 925-26 (6th Cir. 2003).

sponsorship or approval of the product.”<sup>47</sup> In such a case, the “‘mark’ at issue is the plaintiff’s identity.”<sup>48</sup>

Section 43(a) of the U.S. Lanham (Trademark) Act forbids false designations of origin, false descriptions, and dilution. It covers false association (also called false implied endorsement) in the following terms:<sup>49</sup>

- (1) Any person who, on or in connection with any goods or services . . . uses in commerce any word, term, name, symbol, or device . . . or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
- (A) is likely to cause confusion . . . or to deceive as to the affiliation, connection, or association of such person with another person, or as to the . . . sponsorship, or approval of his or her goods, services, or commercial activities by another person, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.<sup>50</sup>

To prove a violation of section 43(a)(1)(A) in a false endorsement case, a plaintiff must show that: (1) its mark is legally protectable; (2) it owns the mark; and (3) the defendant’s use of the mark to identify its goods or services is likely to create confusion concerning the plaintiff’s sponsorship or approval of those

47. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1110 (9th Cir. 1992) (emphasis added) (imitation of singer’s unique voice used in radio commercial advertising Dorito Chips); *see also*, *Wendt v. Host Int’l, Inc.*, 125 F.3d 806 (9th Cir. 1997) (animatronic robotic figures resembling actors in *Cheers* television program used to advertise chain of airport bars modeled on Cheers set); *Abdul-Jabbar v. General Motors Corp.*, 85 F.3d 407 (9th Cir. 1996) (athlete’s name and accomplishments used in television advertisement for Oldsmobile automobiles); *White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395 (9th Cir. 1992) (female robot bearing resemblance to television celebrity, Vanna White, turning letters in what appeared to be the “Wheel of Fortune” game show set in television commercial advertising electronics products); *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985) (photograph of Woody Allen look-alike in national advertising campaign for video club).

48. *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000) (emphasis added); *But cf.*, *Podlas*, *supra* note 20, at 2 (considering whether music can function as a singer trademark, ultimately concluding that while, in theory, a song-based trademark could exist, in practice it would either fail to acquire the appropriate secondary meaning or be precluded—if not preempted—by copyright law).

49. The Lanham Act includes two different bases of liability: false association (§ 43(a)(1)(A)) and false advertising (§ 43(a)(1)(B)). “False association” includes false representations concerning the origin, association, or endorsement of goods or services through the wrongful use of another’s distinctive mark, name, trade dress, or other device, and “false advertising” includes false representations in advertising concerning the qualities of goods or services. *Waits*, 978 F.2d at 1108.

50. 15 U.S.C. § 1125(a)(1).

goods or services.<sup>51</sup> This third prong regarding likelihood of confusion is typically the controlling issue in a false endorsement claim.<sup>52</sup> Before going through the likelihood of confusion analysis involving the hypothetical case of *Neil Young v. Donald Trump*, however, it is necessary to address the first prong—whether the mark is legally protectable.

#### A. *Legal Protectability of the Mark*

In the hypothetical case of *Young v. Trump*, the “mark” at issue would be Young’s identity. Again, the Lanham Act’s section 43(a) expressly prohibits the use of any symbol or device that is likely to deceive consumers as to the association, sponsorship, or approval of goods or services by another person. Courts have given the terms “symbol or device” broad interpretation to include distinctive sounds and physical appearance.<sup>53</sup> False endorsement claims, including those premised on the unauthorized imitation of an entertainer’s distinctive voice, are cognizable under section 43(a).<sup>54</sup>

In *Waits v. Frito-Lay, Inc.*, for example, Tom Waits sued Frito-Lay after Frito-Lay aired a commercial featuring a singer’s voice that sounded remarkably similar to Waits’ unique voice.<sup>55</sup> Waits has a raspy, gravelly singing voice, described by one fan as “like how you’d sound if you drank a quart of bourbon, smoked a pack of cigarettes and swallowed a pack of razor blades. . . . Late at night. After not sleeping for three days.”<sup>56</sup> Waits achieved both commercial and critical success in his musical career.<sup>57</sup> He was the subject of numerous magazine and newspaper articles appearing in such publications as *Time*,

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51. See *Commerce Nat’l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 437 (3d Cir. 2000) (listing the three prongs of a § 43(a) Lanham Act claim).

52. See *Landham*, 227 F.3d at 626; *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1186 (6th Cir. 1988).

53. See generally *Waits*, 978 F.2d 1093 (affirming judgment for plaintiff, Tom Waits, on false implied endorsement claim for use in a snack-food commercial of a singer who imitated plaintiff’s gravelly singing style praising defendant’s product); see also *White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395 (9th Cir. 1992) (holding there was genuine issue of material fact precluding summary judgment as to false implied endorsement claim brought by Vanna White, the hostess of the “Wheel of Fortune” game show, for use in an advertisement for VCRs of a look-alike caricature robot endorsing defendant’s product).

54. See generally *Waits*, 978 F.2d 1093.

55. *Id.* at 1096-97.

56. *Id.* at 1097.

57. *Id.*

*Newsweek*, and the *Wall Street Journal*.<sup>58</sup> But Waits did not do commercials.<sup>59</sup> He had a consistent policy of refusing to endorse major products, rejecting many lucrative offers.<sup>60</sup> Moreover, Waits' policy was a public one: in magazine, radio, and newspaper interviews he had expressed his philosophy that musical artists should not do commercials because it detracts from their artistic integrity.<sup>61</sup>

Among Waits' claims against Frito-Lay was one for false endorsement, upon which he prevailed.<sup>62</sup> Frito-Lay aired the commercial nationwide, and Waits, having heard it during his appearance on a Los Angeles radio program, was shocked.<sup>63</sup> He realized "immediately that whoever was going to hear [it] and obviously identify the voice would also identify that he in fact had agreed to do a commercial for Doritos."<sup>64</sup> On Waits' false endorsement claim under the Lanham Act, 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."<sup>65</sup> Thus, Waits' voice was so distinctive as to develop trademark significance in his own vocal sound.<sup>66</sup> His voice was part of his distinctive musical identity—his mark—and in the context of a false endorsement claim, the court found it was legally protectable. Extending this rationale to our hypothetical, a court could likely find that Young's voice (or Mick Jagger's or Steven Tyler's) is a legally protectable mark.

On the other hand, a case where the court did not consider distinctive musical identity a legally protectable mark was *Oliveira v. Frito-Lay, Inc.*<sup>67</sup> In

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58. *Id.*

59. *Id.*

60. *Id.*

61. *Id.*

62. *See id.* at 1110-11.

63. *Id.* at 1098.

64. *Id.*

65. *Id.* at 1110 (emphasis added).

66. *See* Barry Werbin, *In the Courts: Can Distinctiveness of Musical Identity be Protected under U.S. Law?*, WIPO MAGAZINE (July 2007), [http://www.wipo.int/wipo\\_magazine/en/2007/04/article\\_0002.html](http://www.wipo.int/wipo_magazine/en/2007/04/article_0002.html); *accord* Midler v. Ford Motor Co., 849 F.2d 460, 463-64 (9th Cir. 1988) (holding that defendant, Ford Motor Co., appropriated plaintiff, Bette Midler's identity when Midler's distinctive voice was so widely known and was deliberately imitated to sell Ford's product).

67. *See generally Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56 (2d Cir. 2001).

that case, Astrud Gilberto claimed she had trademark rights in her vocal performance of the song *The Girl from Ipanema*.<sup>68</sup> Frito-Lay used the song in a television commercial for potato chips.<sup>69</sup> Gilberto 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.<sup>70</sup> Because Frito-Lay did not do that, Gilberto claimed that the use of the song falsely implied that she endorsed Frito-Lay.

Though the Second Circuit rejected Gilberto's false endorsement claim, it stated that a musical composition can serve as a trademark for goods or services—it just cannot serve as a trademark “for itself.”<sup>71</sup> Thus, the court concluded that an artist's “signature performance” cannot establish a trademark signifying that artist.<sup>72</sup> “[T]o use a well-known example, . . . Bob Seger's performance of the song *Like a Rock*, [as] the long-running musical backdrop for Chevrolet truck commercials, can function as a trademark for Chevy. But Seger's performance cannot be a trademark for the song ‘Like a Rock’ or for the artist, Seger.”<sup>73</sup> The Second Circuit explained this rule was necessary to vindicate the rights of those who lawfully acquired a license to use the copyrighted work.<sup>74</sup> If the false endorsement claim could trump this license, this could upset reasonable commercial expectations.<sup>75</sup> Frito-Lay, for example, had spent more than \$200,000 to acquire, under the copyright laws, a license and synchronization rights from the record owners of *The Girl from Ipanema*.<sup>76</sup>

The *Oliveira* court, however, concluded that it would not be unthinkable for trademark law to grant a performing artist trademark protection in his or her signature performance, but such an expansion of trademark law would require legislative action.<sup>77</sup> Additionally, though the court ruled that Frito-Lay's use of

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68. *Id.* at 57-58.

69. *Id.*

70. *Id.* at 59.

71. *Id.* at 61-62 (emphasis added) (citing *EMI Catalogue P'ship v. Hill, Connors, Cosmopolos Inc.*, 228 F.3d 56, 64) (2d Cir. 2000)).

72. *Id.* at 62.

73. *Beastie Boys v. Monster Energy Co.*, 66 F. Supp. 3d 424, 453 (S.D.N.Y. 2014).

74. *See Oliveira*, 251 F.3d at 63.

75. *Id.*

76. *Id.* at 58.

77. *Id.* at 62-63.

the song had not taken Gilberto's persona to imply that she endorsed the product, it acknowledged other cases, including *Waits*, where a performing artist's "persona" was protected against a false implication of an endorsement.<sup>78</sup>

This article's author does not argue that a court must recognize an artist's signature performance as a trademark for the artist to succeed on his false endorsement claim against the politician. Again, it is the artist's persona—his identity—that is the mark giving rise to his false endorsement claim. There are many pieces of support that warrant such a claim, and *Waits* is not so far off base from our hypothetical.

First, Waits' identity—his mark—was in jeopardy through Frito-Lay's use of his voice (albeit by an imitator) precisely because Waits had projected an image as being against commercial endorsements. Similarly, many of the musicians whose songs are used in political campaigns project certain images that do not go hand-in-hand with what the politician is endorsing. For example, when Trump used Sir Elton John's hit song *Rocket Man* at rallies, John lashed out, stating "I don't really want my music to be involved in anything to do with an American election campaign. I'm British . . . I'm not a Republican in a million years. Why not ask Ted f\*\*\*ing Nugent? Or one of those f\*\*\*ing country stars? They'll do it for you."<sup>79</sup> Added one of John's spokespeople, "[a]ny use of [Elton's] music should not be seen as an endorsement of Donald Trump."<sup>80</sup> Likewise, singer K'naan sought to secure his image immediately after Romney used his song *Wavin' Flag*. K'naan took to Twitter to voice his displeasure, stating "Yo @mittromney I am K'naan Warsame and I do not endorse this message."<sup>81</sup> K'naan also explained, "I'm for immigrants. I'm for poor people, and they don't seem to be what he's endorsing."<sup>82</sup> Clearly, these musicians have a certain persona (their mark) that they are trying to protect. Again, it's the *identity* that is at issue—not just a single one-time performance as was the case in *Oliveira*.

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78. *Id.* at 62.

79. *See* Chilton, *supra* note 17. Trump had also used other songs of John's at rallies including *Tiny Dancer*. *Id.*

80. *Id.*

81. Sonia Verma, *K'naan to 'Wavin' Flag' Romney: I don't endorse this message*, THE GLOBE AND MAIL (February 1, 2012, 11:40 AM, last updated September 10, 2012, 2:10 PM), <http://www.theglobeandmail.com/news/world/worldview/knaan-to-wavin-flag-romney-i-dont-endorse-this-message/article542668/>.

82. *See* Chao, *supra* note 12.

Furthermore, Waits' distinct voice was a part of his identity—his mark—that was misused by Frito-Lay, thereby falsely associating that part of Waits' identity with Frito-Lay's commercial. In *Midler v. Ford Motor Co.*—a case remarkably similar to *Waits*—the Ninth Circuit addressed how voice can be inherent to one's identity, stating:

[a] voice is as distinctive and personal as a face. The human voice is one of the most palpable ways identity is manifested. We are all aware that a friend is at once known by a few words on the phone. At a philosophical level it has been observed that with the sound of a voice, 'the other stands before me.' . . . [T]hese observations hold true of singing, especially singing by a singer of renown. The singer manifests herself in the song. To impersonate her voice is to pirate her identity.<sup>83</sup>

Thus, courts have found that a voice is intertwined, if not synonymous, with the celebrity's identity. That identity is the celebrity's "mark" in the context of a false endorsement claim. Certainly Sir Elton John's identity is readily revealed by his distinct voice, as would be many voices of the musicians referenced in this article.

Again, another article addressing this topic considered whether the musician might have a cause of action under trademark law against the politician, but it considered the issue under a "song-mark" protection theory.<sup>84</sup> In other words, the article contemplated whether a particular *performance* or *song* could be considered a trademark, thereby protecting the musician associated with the song or performance.<sup>85</sup> However, such was already contemplated by the *Oliveira* court, which found that a single signature song, considered alone, cannot form the basis of a false endorsement claim.<sup>86</sup>

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83. *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (citing W. Keeton, D. Dobbs, R. Keeton, D. Owen, *Prosser & Keeton on Torts* 852 (5th ed. 1984)).

84. Podlas, *supra* note 20, at 22–3 (addressing whether a political campaign's use of a song without the permission of its performer infringes on any trademark rights of the performer).

85. *See id.* at 2 (concluding that while, in theory, song-based trademark could exist, in practice, it would either fail to acquire appropriate secondary meaning or be precluded—if not preempted—by copyright law).

86. *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 62 (2d Cir. 2001); *see also* *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1168 (C.D. Cal. 2010) ("Plaintiffs cannot maintain a Lanham Act claim based *purely* on the use of Henley's songs.") (emphasis added).

While the article discussing “song-mark” protection acknowledges *Waits* as well as a similar case from the Third Circuit, *Facenda v. N.F.L. Films, Inc.*,<sup>87</sup> it states “[i]t is important to keep in mind that these decisions did not grant the performer a trademark in a song . . . [Rather, they] allowed an established commercial service to be marked with a distinctive sound (voice) recognized by the public as designating that performer’s services.”<sup>88</sup> However, voice is part of the musician’s identity, and trademark protection under the Lanham Act includes goods *and services*.

The article continues, “[a]lthough a unique voice like *Facenda*’s or [*Waits*’], recognizable independent of context or the foundational copyrighted work, can serve as a mark, it does not mean that most voices can. These plaintiffs were well-known vocal performers with unique vocal qualities.”<sup>89</sup> But well-known vocal performers are precisely who we are concerned with. Most politicians are not using unheard of songs by unheard of artists. Indeed, popular artists complaining about the politicians’ use of their songs is a reoccurring theme from year to year.<sup>90</sup> Moreover, Sir Elton John, The Rolling Stones, Adele, and Neil Young are all well known with unique vocal qualities. Their voices, after all, are what helped catapult them to fame.

The article concludes, “with ‘Autotune’ and contemporary production techniques, today’s singers are often indistinguishable or recognized in relation to a record rather than due to some unusual vocal quality. Therefore, voice alone is not presumptively distinct, and even when it is, that does not prove audience recognition.”<sup>91</sup> However, Autotune could actually weigh in favor of the musician asserting a false endorsement claim. Autotune can help *imitators* sound more like the musician, which would place our hypothetical directly on par with *Waits* and *Midler*. We are not necessarily concerned about the musician using Autotune as we are with the imitators using it.

As evidenced, false endorsement is quite different from trademark in a single song. For false endorsement, the celebrity’s identity is the equivalent of

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87. 542 F.3d 1007, 1023-25 (3d Cir. 2008) (finding that genuine issues of material fact existed as to whether professional football league defendants’ use of recordings of narrator’s “legendary” voice in cable-television production about football video game was likely to cause confusion among consumers regarding narrator’s sponsorship or approval of the game, precluding summary judgment on Lanham Act claim for false endorsement).

88. Podlas, *supra* note 20, at 17-18.

89. *Id.* at 18.

90. *See supra* notes 17-18.

91. Podlas, *supra* note 20, at 18.

the mark—not the particular performance or song. Considering *Waits*, *Midler*, and *Facenda*, even if the politician’s song use was singular, the plaintiff-musician’s false endorsement claim might still prevail when the musician’s voice is truly distinct.

Additionally, the *context* of the politician’s use might weigh in favor of the musician’s false endorsement claim. In *Beastie Boys v. Monster Energy Co.*, for example, Monster created a four-minute promotional video that aired on YouTube.<sup>92</sup> The video consisted of footage from an event Monster sponsored called “Ruckus in the Rockies.” The footage included a road trip to Lake Louise, scenes from a snowboarding competition, and an after-party.<sup>93</sup> Monster’s green logo was ubiquitous in the video, appearing on apparel, snowboarding ramps, banners that surrounded the snowboarding course, and cans of Monster energy drinks.<sup>94</sup> The Beastie Boys’ music was also ubiquitous as the video’s soundtrack consisted of excerpts from five Beastie Boys songs.<sup>95</sup> The video did not contain any voice-overs, narration, or interviews—the Beastie Boys’ music, which filled all but 32 seconds of the video, was the “main aural event.”<sup>96</sup>

The Beastie Boys brought claims against Monster for copyright infringement and false endorsement.<sup>97</sup> After a jury found for The Beastie Boys on both claims, Monster moved for judgment as a matter of law for a new trial.<sup>98</sup> Monster, relying upon *Oliveira*, argued that the jury was not permitted to consider the use of the Beastie Boys’ copyrighted music in the video and instead should have been limited to considering only the video’s textual use of the band’s name and a name of a Beastie Boys member “MCA.”<sup>99</sup> These textual snippets, contended Monster, were not enough to support a finding of false endorsement.<sup>100</sup> The United States District Court for the Southern District of New York, however, disagreed. It stated, “a jury could easily conclude that *Monster used the Beastie Boys persona to suggest, misleadingly, that the band*

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92. 66 F. Supp. 3d 424, 432 (S.D.N.Y. 2014).

93. *Id.* at 428.

94. *Id.*

95. *Id.*

96. *Id.*

97. *Id.* at 427.

98. *Id.*

99. *Id.* at 450-51.

100. *Id.* at 451.

was endorsing Monster Energy. The ubiquity of the band's music 'unquestionably br[ought] to mind' the Beastie Boys, and the use of the names 'Beastie Boys' and 'MCA' in the credits drove the point home."<sup>101</sup> Therefore, the court found there was sufficient evidence to establish the Beastie Boys' false endorsement claim.<sup>102</sup>

Furthermore, in refuting Monster's argument on the merits, the court found that *Oliveira* and its progeny did not bar a finding of false endorsement.<sup>103</sup> The court reasoned that The Beastie Boys did not base their claim of false endorsement on Monster's use of a single Beastie Boys song in an advertisement.<sup>104</sup> Instead, Monster's promotional video incorporated a variety of elements referencing the Beastie Boys—extensive excerpts from not one but five songs, a textual reference to the Beastie Boys, and another reference ("RIP MCA") to the well-known stage name of one of the band's three members.<sup>105</sup> The Beastie Boys contended—and the court agreed—that the use of these elements, "synergistically and in combination, associated the band with Monster and its products in the minds of viewers of the video, constituting an endorsement."<sup>106</sup> The court stated, "[a]lthough *Oliveira* precludes an artist from claiming false endorsement based solely on the use of a single song, that decision does not speak to the circumstance in which such use is claimed to be *one part of a broader effort* to falsely convey an endorsement by the artist of a product or company."<sup>107</sup>

Thus, when looking at the *context* of the defendant's use, as the court did in *Beastie Boys*, we can see how the plaintiff-musician's false endorsement claim might be strengthened. Again, the *Beastie Boys* court considered not only Monster's use of The Beastie Boys' songs in the video, but also the fact that the video contained more than one Beastie Boys song as well as a reference to a band member's name. Similarly, Trump not only has used popular musicians' songs in his campaign, but he has used more than one song by a particular artist or band. For example, Trump used The Rolling Stones' songs *You Can't Always*

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101. *Id.* at 450 (citing *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979)).

102. *Id.*

103. *Id.* at 452.

104. *Id.* at 453.

105. *Id.*

106. *Id.*

107. *Id.* (emphasis added).

*Get What You Want*, *Sympathy for the Devil*, and *Brown Sugar* at campaign events.<sup>108</sup> Likewise, Trump used multiple songs of Sir Elton John's including *Rocket Man* and *Tiny Dancer* at rallies.<sup>109</sup> Furthermore, just as Monster referred to a band member's name in its video, Trump's team referred to Sir Elton John's name in its campaign, stating that John would be performing at Trump's inauguration.<sup>110</sup> Not surprisingly, John went public to confirm that he would not, in fact, be performing at Trump's inauguration.<sup>111</sup>

Trump's repetitive song use is not unique to him either. Indeed, politicians favor using certain songs over and over as the songs almost become "themes" of their campaigns. Such use is certainly not a one-time situation, as was the case in *Oliveria*. Multiple uses and reference to the celebrities' names were sufficient in distinguishing *Beastie Boys* from *Oliveira*, and it could very well be sufficient for our hypothetical. In other words, when the politician's use is but one part of a broader effect that associates the musician with his campaign, we see how the musician's identity can be implicated. Accordingly, when such use is present, it is not a stretch for the musician to claim that the politician is falsely associating his identity as an endorser of the candidate.

Moreover, unlike with traditional false advertising claims, the celebrity need not be a competitor of the defendant to assert a false endorsement claim.<sup>112</sup> To have standing under the Lanham Act, the Ninth Circuit declared, "the plaintiff need not be in actual competition with the alleged wrongdoer."<sup>113</sup> "Rather, the 'dispositive question' in determining standing is whether the plaintiff 'has a reasonable interest to be protected against false advertising.'"<sup>114</sup> The Ninth Circuit concluded that, "like a trademark holder, an actor has a 'reasonable interest' in having his work product properly identified with his name, and therefore the plaintiff has standing under section 43(a)."<sup>115</sup> In our case, "musician" can just as easily be inserted in the place of "actor" because the

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108. Henderson, *supra* note 4.

109. Julia Bruculieri, *No, Elton John Is Not Performing At Donald Trump's Inauguration*, THE HUFFINGTON POST (November 23, 2016, 12:11 PM), [http://www.huffingtonpost.com/entry/elton-john-not-performing-at-donald-trumps-inauguration\\_us\\_5835bc8fe4b000af95ed6cfd](http://www.huffingtonpost.com/entry/elton-john-not-performing-at-donald-trumps-inauguration_us_5835bc8fe4b000af95ed6cfd).

110. *Id.*

111. *See id.*

112. *See* *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1108 (9th Cir. 1992).

113. *Id.* (citing *Smith v. Montoro*, 648 F.2d 602, 607 (9th Cir. 1981)).

114. *Id.* (citing *Smith v. Montoro*, 648 F.2d 602, 608 (9th Cir. 1981)).

115. *Id.*

artist-musician has the same reasonable interest as the actor does in having his work product identified with his name. Thus, our plaintiff-musician does not need to be in direct competition with the politician to assert a false endorsement claim. This standing component only solidifies the fact that the musician has a mark that warrants legal protection.

### *B. Likelihood of Confusion*

With the musician's mark legally recognized, the next step in assessing whether he has a successful false endorsement claim against the politician is determining whether a likelihood of confusion exists.<sup>116</sup> In other words, would the politician's use of the mark likely confuse or mislead the public into thinking that the musician endorses the politician. Again, in the ordinary false endorsement claim, this is the controlling issue.<sup>117</sup>

To assess likelihood of confusion, the Ninth Circuit considers and weighs the following factors:<sup>118</sup> (1) the level of recognition the plaintiff has among the segment of the society for whom the defendant's product is intended (also called the strength of the plaintiff's mark); (2) the relatedness of the plaintiff's fame or success to the defendant's product; (3) the similarity of the likeness used by the defendant to the actual plaintiff; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; (7) defendant's intent on selecting the plaintiff; and (8) likelihood of expansion of the product lines.<sup>119</sup> "Although these are all factors that are appropriate for consideration in determining whether likelihood of confusion exists, they are not necessarily of equal importance, nor do they necessarily apply to every case."<sup>120</sup>

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116. See *Commerce Nat'l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 437 (3d Cir. 2000) (listing the three prongs of a false endorsement claim under § 43(a) of the Lanham Act). In regard to the second prong (ownership of the mark), it is readily assumed that the celebrity owns his own identity or persona.

117. See *Landham v. Lewis Galoob Toys, Inc.*, 227 F.3d 619, 626 (6th Cir. 2000); *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1186 (6th Cir. 1988).

118. *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1007-08 (9th Cir. 2001).

119. Other circuits have adopted a modified version of the Ninth Circuit's eight-factor *Downing* test. See, e.g., *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1020, 1025 (applying a modified version of the *Downing* test. "[W]e hold that the *Downing* factors retain the substance of *Lapp* while appropriately tailoring the language to false endorsement claims." The application of the *Downing* factors is a question of fact.).

120. *Downing*, 265 F.3d at 1008.

Going back to *Waits*, the jury listened to numerous Tom Waits recordings. The jury also listened to a recording of the Doritos commercial in which the Tom Waits impersonator delivered a “hip” endorsement of SalsaRio Doritos: “It’s buffo, boffo, bravo, gung-ho, tally-ho, but never mellow. . . . try ‘em, buy ‘em, get ‘em, got ‘em.”<sup>121</sup> The jury also considered the fact that the Doritos commercial was targeted to an audience that overlapped with Waits’ audience—males between the ages of 18 to 35 who listened to the radio.<sup>122</sup> Finally, evidence of actual consumer confusion existed because numerous witnesses testified that they actually believed it was Tom Waits singing in the commercial.<sup>123</sup> Accordingly, this evidence sufficiently supported the jury’s finding that the commercial would likely mislead consumers into believing that Waits endorsed SalsaRio Doritos.<sup>124</sup>

In our case, a jury could likewise find likelihood of confusion because of the strength of the musicians’ marks. “Mark” means the “celebrity’s persona,”<sup>125</sup> and its “strength” refers to “the level of recognition the celebrity enjoys among members of society.”<sup>126</sup> If the politician directs his campaign to a segment of the public who does not know the musician, then that segment could not be confused as to whether the musician is endorsing the politician.<sup>127</sup> Conversely, if the musician is well-known, the possibility of a likelihood of confusion arises.<sup>128</sup> There is little doubt that a jury would find that Sir Elton John, Adele, Neil Young, and all of the other musicians mentioned in this article have “strong marks.” They all have enjoyed tremendous world-wide success in the music industry and are recognized in many segments of the public—including those segments where the politicians direct their campaigns.

Also weighing in the musician’s favor is the third factor—the similarity of the likeness used by the defendant to the actual plaintiff. The jury in *Waits* considered this factor and found confusion existed because the imitator

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121. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1111 (9th Cir. 1992).

122. *Id.*

123. *Id.*

124. *Id.*

125. *White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992) (citing *Allen v. Nat’l Video, Inc.*, 610 F. Supp. 612, 627 (D.C.N.Y. 1985)).

126. *Id.* (citing *Academy of Motion Picture Arts v. Creative House*, 944 F.2d 1446, 1455 (9th Cir. 1991)).

127. *See id.*

128. *See id.*

sounded just like Waits. But the musician in our hypothetical has an even stronger case than Waits did because the politician is using the recording that contains the actual musician's voice.

Next, and perhaps most importantly, there is evidence of actual confusion. In an action brought under section 43(a) of the Lanham Act for trademark infringement, a plaintiff need not provide proof of actual confusion—he need only show likelihood of confusion.<sup>129</sup> However, “there can be no more positive or substantial proof of the likelihood of confusion than proof of actual confusion.”<sup>130</sup> While “very little proof of actual confusion would be necessary to prove the likelihood of confusion, an almost overwhelming amount of such proof would be necessary to refute such proof.”<sup>131</sup> With the ever-increasing popularity and innovativeness of social media, it would not be difficult for the musician to prove actual confusion—one need only look to the social media feeds. As noted above, K'naan complained that he “got a flood of Twitter messages from people who assumed . . . that [he] was now a supporter of Mitt Romney's campaign.”<sup>132</sup>

Additionally, even where the public is aware of the celebrity's opposition to the defendant, actual confusion sometimes still exists. In *Waits*, before Frito-Lay aired the spot, its ad agency mentioned how Waits actually was known to have a publicly avowed policy against doing commercial endorsements and had expressed his disapproval of artists who did.<sup>133</sup> Despite the ad company having this knowledge, and despite Frito-Lay executives expressing legal concerns to their attorney, Frito-Lay aired the commercial nationwide.<sup>134</sup> Though Waits' disassociation with ad endorsements was widely known, the jury still found that a likelihood of confusion existed as to whether Waits endorsed the Doritos product.

Similarly, Sir Elton John, Neil Young, and K'naan all have made their particular political viewpoints publicly known. These musicians are known

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129. See *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1015 (3d Cir. 2008).

130. *Flushing Bank v. Green Dot Corp.*, 138 F. Supp. 3d 561, 589 (S.D.N.Y. 2015).

131. *Id.* (quoting *Savin Corp. v. Savin Grp.*, 391 F.3d 439, 459 (2d Cir. 2004) ).

132. James C. McKinley Jr., *G.O.P. Candidates Are Told, Don't Use the Verses, It's Not Your Song*, N.Y. TIMES (Feb. 3, 2012), <http://www.nytimes.com/2012/02/04/arts/music/romney-and-gingrich-pull-songs-after-complaints.html>.

133. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1098 (9th Cir. 1992).

134. *Id.*

world-wide and have thousands of social media followers.<sup>135</sup> Fans of musicians nowadays might have even more insight into the musicians' likes and dislikes given the musician-to-fan connectivity inherent to social media forums. Fans can send messages directly to the musician to which the musician can respond or not respond. The musicians also can post daily messages regarding their music as well as their personal beliefs. Nonetheless, actual confusion from their fan-base can still abound, as noted by K'naan. The musicians' followers have noted and can continue to note their actual confusion in real-time on the musicians' social media pages. These fan posts might very well serve as the modern-day surveys typically used by plaintiffs who wish to prove actual confusion. Regardless of the method used to capture the public's comments, it is evident that actual confusion does exist in this context.

The "marketing channels used" factor could also weigh in favor of a likelihood of confusion. The usual analysis for this factor focuses on whether the defendant used marketing channels in which the plaintiff's endorsements are likely to appear.<sup>136</sup> In other words, would the products the plaintiff actually endorsed be marketed through the same channels and media that the defendant used? Political campaign events, including debates and ads, are broadcast on national news channels—stations that also might air concerts wherein the musician performs. Though radio is the musician's typical marketing channel, this does not detract from the fact that the politician can still use marketing channels shared by the musician.<sup>137</sup>

Finally, the factor concerning "defendant's intent" helps tip the scales in the musician's favor. The relevant question is whether the defendant "intend[s] to profit by confusing consumers" concerning the endorsement of the defendant's product.<sup>138</sup> In *White v. Samsung Electronics America, Inc.*, for example, Vanna

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135. Sir Elton John has 622K Twitter followers. Twitter, <https://twitter.com/eltonofficial> (last visited April 14, 2017). Neil Young has 406K Twitter followers. Twitter, <https://twitter.com/neilyoung> (last visited April 14, 2017). K'naan has 200K Twitter followers. Twitter, <https://twitter.com/knaan?lang=en> (last visited April 14, 2017).

136. *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1025 n.10 (3d Cir. 2008) (citing *White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992) (focusing on the extent to which products the plaintiff actually endorsed were marketed through the same channels and media in which the defendant's alleged unauthorized use of the plaintiff's likeness occurred)).

137. See *Browne v. McCain*, 611 F. Supp. 2d 1073, 1080-81 (C.D. Cal. 2009) (dismissing Senator John McCain's claim that plaintiff-musician Jackson Browne could not show likelihood of confusion even though McCain ran television campaign commercial clearly identifying its source as the Ohio Republican Party).

138. See *White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992) (citing *Toho Co., Ltd. v. Sears, Roebuck & Co.*, 645 F.2d 788 (9th Cir. 1981)).

White, the hostess of the popular game show “Wheel of Fortune,” brought, among other things, a false endorsement claim against Samsung.<sup>139</sup> Samsung had produced an advertisement using a robot dressed in a wig, gown, and jewelry that resembled White’s hair and dress.<sup>140</sup> “The robot was posed next to a game board [that] was instantly recognizable as the Wheel of Fortune game show set, in a stance for which White is famous.”<sup>141</sup> The court found that while Samsung might have intended to spoof Vanna White and “Wheel of Fortune,” that did not preclude the possibility that Samsung also intended to confuse consumers regarding endorsement.<sup>142</sup> The court reasoned:

the robot ad was one of a series of ads run by [Samsung,] which followed the same theme. Another ad in the series depicted Morton Downey Jr. as a presidential candidate in the year 2008. Doubtless, defendants intended to spoof presidential elections and Mr. Downey through this ad. Consumers, however, would likely believe, and would be correct in so believing, that Mr. Downey was paid for his permission and was endorsing Samsung products. Looking at the series of advertisements as a whole, a jury could reasonably conclude that beneath the surface humor of the series lay an intent to persuade consumers that celebrity Vanna White, like celebrity Downey, was endorsing Samsung products.<sup>143</sup>

Here, Trump repeatedly has used songs by Elton John and The Rolling Stones throughout his campaign. Trump even suggested that John would sing at his inauguration.<sup>144</sup> Also, a politician such as Trump might intend to appeal to an audience that doesn’t typically support him (*i.e.*, Democrats). A song by a liberal artist such as Elton John or even by a younger artist such as Adele might make Trump appear “hip” and appeal to a younger, liberal audience. Thus, a jury could find that the defendant-politician has an intent in selecting a particular musician’s song.

Though the remaining factors not analyzed might not weigh in favor of likelihood of confusion, they don’t have to. Again, this element of a false endorsement claim is fact-based where a jury considers the totality of the

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139. *Id.* at 1399.

140. *Id.* at 1396.

141. *Id.*

142. *Id.* at 1400-01.

143. *Id.* at 1401.

144. Bruculieri, *supra* note 109.

evidence.<sup>145</sup> The factors used to assess likelihood of confusion are not necessarily of equal importance, nor do they necessarily apply to every case.<sup>146</sup> The likelihood of confusion finding in *Waits* was supported by the strength of the mark, similarity of the marks (or similarity of the likeness used by the defendant to the actual plaintiff), evidence of actual confusion, marketing channels used, and intent in selecting marks.<sup>147</sup> The same can be said here thereby further supporting the plaintiff-musician's false endorsement claim. However, the defendant-politician can assert various defenses.

### C. Defenses to a False Endorsement Claim

False endorsement defenses include the following arguments: free speech protects the the use, the goods or services are not being used in commerce as required under the Lanham Act, or the politician and musician are not in direct competition with each other.

First, free-speech interests protected under the First Amendment may be a defense to a claim of false endorsement.<sup>148</sup> "Where the defendant has articulated a colorable claim that the use of a celebrity's identity is protected by the First Amendment, the likelihood of confusion test is not appropriate because it fails to adequately consider the interests protected by the First Amendment."<sup>149</sup> In *Rogers v. Grimaldi*, for example, Ginger Rogers, the surviving member of one of the most famous duos in show business history, brought suit against the producers and distributors of a movie titled *Ginger and Fred*.<sup>150</sup> The film was not about Ginger Rogers and Fred Astaire, but about two fictional Italian cabaret performers who imitated Rogers and Astaire and became known in Italy as "Ginger and Fred." Rogers asserted claims under section 43(a) of the Lanham Act. The Second Circuit began its analysis by noting that "[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection."<sup>151</sup> The court concluded that "[b]ecause

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145. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1111 (9th Cir. 1992).

146. *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1008 (9th Cir. 2001).

147. *See Waits*, 978 F.2d at 1111.

148. J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 5:31 (2d ed. 2017) (citing *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013) ("Section 43(a) protects the public's interest in being free from consumer confusion about affiliations and endorsements, but this protection is limited by the First Amendment, particularly if the product involved is an expressive work.")).

149. *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 926 (6th Cir. 2003).

150. *See generally Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

151. *Id.* at 997.

overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.”<sup>152</sup>

From this case came the “*Rogers test*,” which most courts use when analyzing a free speech defense to a false endorsement charge.<sup>153</sup> Under this test, “an accused use of plaintiff’s identity in an expressive work, such as a movie or song, will be immune as expressive free speech unless it has ‘no artistic relevance’ to the underlying work or, if there is artistic relevance, the accused use ‘explicitly misleads as to the source or the content of the work.’”<sup>154</sup>

But the Sixth Circuit has cautioned: “[T]he First Amendment cannot permit anyone who cries ‘artist’ to have *carte blanche* when it comes to naming and advertising his or her works, art though it may be.”<sup>155</sup> In *Browne v. McCain*, for example, the plaintiff Jackson Browne’s Lanham Act claim prevailed against the First Amendment defense of Senator John McCain.<sup>156</sup> Browne, a singer and songwriter, is closely associated with liberal causes and Democratic political candidates.<sup>157</sup> His public support for the Democratic Party and President Barack Obama is well known, having performed at rallies for Democratic candidates.<sup>158</sup> Browne released an album in 1977 titled *Running on Empty*, which contained a composition of the same name.<sup>159</sup> The album was a success, reaching platinum status seven times over, and Browne became famously associated with the album and composition.<sup>160 161</sup> McCain, a Republican, decided to use a portion of the composition in a campaign commercial, which was viewable on YouTube and television and cable networks.<sup>162</sup> But neither Senator McCain, the Ohio Republican Party, nor the Republican National Committee received a license or

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152. *Id.* at 998.

153. McCarthy, *supra*, at § 5:31 (citing *Rogers*, 875 F.2d at 999).

154. *Id.*

155. *Id.* (citing *Parks v. LaFace Records*, 329 F.3d 437, 447 (6th Cir. 2003)).

156. *See generally* 611 F. Supp. 2d 1073 (C.D. Cal. 2009).

157. *Id.*

158. *Id.*

159. *Id.*

160. *Browne v. McCain*, 611 F. Supp. 2d 1073, 1075 (C.D. Cal. 2009).

161. *Id.*

162. *Id.* at 1076.

permission from Browne, who owns a federally registered copyright in the composition.<sup>163</sup>

Since the commercial first appeared on television and the Internet, Browne received numerous inquiries expressing concern about McCain's use of the composition.<sup>164</sup> Browne argued that the commercial falsely suggested his sponsorship, endorsement, or association with Senator McCain and the Republican Party, "when nothing could be further from the truth."<sup>165</sup> As a result, Browne sued McCain, the Ohio Republican Party, and the Republican National Committee on August 14, 2008 for (1) copyright infringement, (2) vicarious copyright infringement, (3) *violation of the Lanham Act (false association or endorsement)*, and (4) violation of California common law right of publicity.<sup>166</sup>

Senator McCain argued that the court should dismiss Browne's Lanham Act claim because (1) the Lanham Act applies only to commercial speech, and (2) the First Amendment and artistic relevance test bar the claim.<sup>167</sup> The District Court for the Central District of California, however, disagreed.<sup>168</sup> The court first recognized that the Lanham Act applies to noncommercial (*i.e.*, political) *and* commercial speech.<sup>169</sup> "Indeed, the Act's purpose of reducing consumer confusion supports application of the Act to political speech, where the consequences of widespread confusion as to the source of such speech could be dire."<sup>170</sup> Thus, the court rejected Senator McCain's argument that the Lanham Act applies only to commercial speech.<sup>171</sup>

The court then rejected Senator McCain's contention that Browne could not state a claim under the Lanham Act because the commercial was an expressive work thus barring the claim under the First Amendment and artistic relevance

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163. *Id.* at 1077.

164. *Id.*

165. *Id.*.

166. *Browne v. McCain*, 611 F. Supp. 2d 1073, 1077 (C.D. Cal. 2009).

167. *Id.* at 1078.

168. *Id.* at 1079.

169. *Id.* (citing *United We Stand America, Inc. v. United We Stand, America New York, Inc.*, 128 F.3d 86, 92-93 (2d Cir. 1997); *MGM-Pathe Commns. Co. v. Pink Panther Patrol*, 774 F. Supp. 869, 876 (S.D.N.Y. 1991)).

170. *Id.* (citing *United We Stand America, Inc.*, 128 F.3d at 91-93).

171. *Id.*

test.<sup>172</sup> The court reasoned that “in the Ninth Circuit, a Lanham Act claim based on use of a mark in an artistic work is analyzed under the Second Circuit’s *Rogers* artistic relevance test, which was developed to address the competing interests of the First Amendment’s protection of artistic works and trademark protection.”<sup>173</sup> Under *Rogers*, “an artistic work’s use of a trademark that otherwise would violate the Lanham Act is not actionable [1] ‘unless the use of the mark has no artistic relevance to the underlying work whatsoever, or, [2] if it has some artistic relevance, unless it explicitly misleads as to the source or content of the work.’”<sup>174</sup> Thus, neither the First Amendment nor the *Rogers* test barred Browne’s Lanham Act claims.

Additionally, the *Browne* court rejected McCain’s argument that Browne could not state a claim under the Lanham Act because he had not shown actual use in commerce.<sup>175</sup> The court noted that “the Lanham Act’s reference to use ‘in commerce’ does not require a plaintiff who asserts a claim under section 43(a)(1)(A) to show that the defendant actually used the mark in commerce.”<sup>176</sup> Rather, this reference “actually ‘reflects Congress’s intent to legislate to the limits of its authority under the Commerce Clause’ to regulate interstate commerce.”<sup>177</sup> The interstate commerce component only requires a party to show that the defendant’s conduct “affects interstate commerce, such as through diminishing the plaintiff’s ability to control use of the mark, thereby affecting the mark and its relationship to interstate commerce.”<sup>178</sup> Therefore, the “scope of ‘in commerce’ as a jurisdictional predicate of the Lanham Act is broad and has a sweeping reach.”<sup>179</sup>

Finally, as discussed *infra* at part II.A., the plaintiff does not have to be in direct competition with the defendant to bring a false endorsement claim.<sup>180</sup>

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172. *Browne v. McCain*, 611 F. Supp. 2d 1073, 1080 (C.D. Cal. 2009).

173. *Id.* (citing *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002)).

174. *Id.* (citing *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008)).

175. *Id.* at 1079-80.

176. *Id.* at 1079 (citing *United We Stand America, Inc.*, 128 F.3d at 92).

177. *Id.*

178. *Id.* (citing *Stauffer v. Exley*, 184 F.2d 962, 964–67 (9th Cir. 1950)).

179. *Id.* (citing *Planned Parenthood Fed’n of America, Inc. v. Bucci*, 1997 WL 133313 (S.D.N.Y.) (citing *Steele v. Bulova Watch Co.*, 344 U.S. 280 (1952)).

180. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1108 (9th Cir. 1992) (citing *Smith v. Montoro*, 648 F.2d 602, 607 (9th Cir. 1981)).

A false endorsement claim that is based on the unauthorized use of a celebrity's identity is a type of false association claim. It "alleges the misuse of a trademark, *i.e.*, a symbol or device such as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic, which is likely to confuse consumers as to the plaintiff's sponsorship or approval of the product."<sup>181</sup> Therefore, "actual competition" is not required for standing. Rather, standing "extends to a purported endorser who has an economic interest akin to that of a trademark holder in controlling the commercial exploitation of his or her identity."<sup>182</sup>

In sum, the plaintiff-musician can bring a false endorsement claim against the defendant-politician because the "mark" at issue is his identity. Not only is this mark legally protectable, but the public could likely be confused as to whether the musician endorses the politician when the politician misappropriates that mark. Furthermore, the politician has standing to bring his claim, which likely will not be barred by the politician's defenses. But what about right of publicity as a cause of action?

#### IV. RIGHT OF PUBLICITY AS A CAUSE OF ACTION

Right of publicity is a state-based right that everyone possesses.<sup>183</sup> It is best defined as "the inherent right of every human being to control the commercial use of his or her identity."<sup>184</sup> What originally was known as a "right to privacy"—*i.e.*, the right to be left alone—now, the right of publicity is not so much about being left alone as it is about recognizing the right of a person to control the use of his or her persona.<sup>185</sup>

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181. *Id.* at 1110.

182. *Id.* (citing *Allen v. Nat'l Video*, 610 F. Supp. 612, 625, 628 (S.D.N.Y. 1985) (celebrity's interest in the marketing value of his identity is similar to that of a trademark holder, and its misuse through evocation of celebrity's persona that creates likelihood of consumer confusion as to celebrity's endorsement is actionable under Lanham Act)).

183. J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 1:3 (2d ed. 2017).

184. *Id.*

185. The right of publicity sprang up out of the common law. Two law review articles, one by Samuel D. Warren and Louis D. Brandeis and another by Professor William Prosser, were particularly influential in shaping the origins of the right of publicity. See Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890) (calling for judicial recognition of a "right to be let alone"); see Prosser, *Privacy*, 48 CALIF. L. REV. 383 (1960) (identifying four privacy interests: (1) intrusion upon the plaintiff's seclusion or solitude, or into his private affairs; (2) public disclosure of embarrassing private facts about the plaintiff; (3) publicity that 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.). Professor Prosser's theory of the "four torts" worked its way

To establish this cause of action, the plaintiff must prove (1) the validity of his or her right of publicity; and (2) that this right has been infringed upon by the defendant(s).<sup>186</sup> Because right of publicity is a state-based right derived from the common law, its elements to prove the second prong of this test vary from state to state.<sup>187</sup> Generally, though, to establish a common law right of publicity claim or the appropriation of a name or identity, a plaintiff must show “(1) the defendant’s use of the plaintiff’s identity; (2) the appropriation of plaintiff’s name or likeness to defendant’s advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury.”<sup>188</sup>

Though the right of publicity elements above speak in terms of an appropriation of plaintiff’s “name or likeness,”<sup>189</sup> right of publicity is not so confined.<sup>190</sup> Right of publicity claims have been successful in cases where the defendant appropriated the plaintiff’s identities without using the obvious means of using the plaintiff’s name or likeness.<sup>191</sup> In *Motschenbacher v. R.J. Reynolds Co.*, for example, R.J. Reynolds had used a photograph of

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into the Second Restatement of Torts, and it became very influential in the thought process used to protect a right of publicity. See Restatement Second, Torts § 652C.

186. *Prima v. Darden Rests., Inc.*, 78 F. Supp. 2d 337 (D.N.J. 2000); McCarthy, *supra* note 185, at § 3:2.

187. See *supra* notes 185-87 and accompanying text.

188. See *White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395, 1397 (9th Cir. 1992) (quoting *Eastwood v. Superior Court*, 149 Cal. App. 3d 409 (Cal. App. 2d Dist. 1983) superseded by statute on other grounds as recognized by *KNB Enters. v. Matthews*, 78 Cal. App. 4th 362, 367 (Cal. App. 2d Dist. 2000)). Courts have more recently been following the definition and elements in the Restatement, which requires the plaintiff to prove that: (1) defendant, without permission, has used some aspect of identity or persona in such a way that plaintiff is identifiable from defendant’s use; and (2) defendant’s use is likely to cause damage to the commercial value of that persona. Thus, under the Restatement version, a plaintiff is not required to show that the defendant obtained a commercial advantage. Additionally, the Restatement version more specifically states that the injury is to the commercial value of the persona whereas the injury for appropriation is left open-ended as to whether the damages are commercial or to the psyche. Nevertheless, if a fact pattern satisfies one version, it should also satisfy the other version of the test. See *Thomas Phillip Boggess V, Cause of Action for an Infringement of the Right of Publicity*, 31 Causes of Action 2d 121.

189. Prosser recognized that right of publicity cases involved one of two basic factual scenarios: name appropriation, and picture or likeness appropriation, but had only looked at case law to that date. *White*, 971 F.2d at 1397 (citing Prosser, *Privacy*, 48 CAL.L.REV. 383, 401-02, nn. 156-57).

190. *White*, 971 F.2d at 1397.

191. See *id.* at 1398.

Motschenbacher's race car in a television commercial.<sup>192</sup> Although Motschenbacher appeared to be driving the car in the photograph, his features were not visible.<sup>193</sup> However, the markings on the car were not only peculiar to Motschenbacher's cars, but they caused some people to think the car in question was Motschenbacher's and to infer that the person driving the car was Motschenbacher.<sup>194</sup> Even though R.J. Reynolds had not appropriated Motschenbacher's name or likeness, the Ninth Circuit held that Motschenbacher's California right of publicity claim should reach the jury.<sup>195</sup>

In *Midler v. Ford Motor Co.*, a former back-up singer to Bette Midler was hired to record *Do You Want to Dance?*—a song made famous by Midler.<sup>196</sup> Ford Motor Co. instructed the back-up singer to imitate Midler's voice as closely as possible for a radio commercial.<sup>197</sup> The ad agency had properly acquired the rights to the song from the copyright holder and did not use either Midler's name or picture in the advertisement.<sup>198</sup> The district court held that there was "no legal principle preventing imitation of Midler's voice" and granted summary judgment for Ford.<sup>199</sup> The Ninth Circuit, however, disagreed, holding that even though the defendants had not used Midler's name or likeness, Midler had stated a claim for violation of her California common law right of publicity. The court reasoned that "the defendants . . . for their own profit in selling their product did appropriate part of her identity" by using a Midler sound-alike and that to impersonate Midler's voice was akin to pirating her identity.<sup>200</sup>

In *Carson v. Here's Johnny Portable Toilets, Inc.*, the defendant-corporation Here's Johnny Portable Toilets had marketed portable toilets under the brand name "Here's Johnny"—Johnny Carson's signature "Tonight Show" introduction—without Carson's permission.<sup>201</sup> The district court had dismissed

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192. See generally 498 F.2d 821 (9th Cir. 1974).

193. *Id.* at 822.

194. *Id.* at 827.

195. *Id.*

196. See generally 849 F.2d. 460 (9th Cir. 1988).

197. *Id.* at 461.

198. *Id.* at 462.

199. *Id.*

200. *Id.* at 463-64.

201. 698 F.2d 831, 832-33 (6th Cir. 1983).

Carson's Michigan common law right of publicity claim because the defendants had not used Carson's "name or likeness."<sup>202</sup> In reversing the district court, the Sixth Circuit found "the district court's conception of the right of publicity . . . too narrow" and held that the right was implicated because the defendant had appropriated Carson's identity by using, *inter alia*, the phrase "Here's Johnny."<sup>203</sup>

Thus, "it is not important *how* the defendant has appropriated the plaintiff's identity, but *whether* the defendant has done so."<sup>204</sup> What is important is that the defendants' actions "directly implicate the commercial interests[,] which the right of publicity is designed to protect."<sup>205</sup> Because a celebrity's identity can have value, the celebrity should be able to protect that interest through a right of publicity. That right is invaded when the celebrity's identity is commercially exploited, whether or not his "name or likeness" is used."<sup>206</sup>

The musician, therefore, could assert his right of publicity and even be successful in stopping the politician from appropriating his identity. First, it should not matter that the politician is only playing the song and thereby not using the musician's name or likeness. Under the aforementioned case law, right of publicity claims can involve more than the obvious use of the musician's name or likeness.

Second, by using the musician's song, the politician directly implicates commercial interests the musician is trying to protect. Musicians tend to feel they have a certain image to uphold—an image that helps sell albums. And when a Republican candidate, for example, uses a liberal musician's song, the musician could feel his image is in jeopardy. As noted in *Waits*, "the jury could have inferred from the evidence that the commercial created a public impression that Waits was a hypocrite for endorsing Doritos. Moreover, it also could have inferred damage to his artistic reputation, for Waits had testified that 'part of my character and personality and image that I have cultivated is that I do not endorse products.'"<sup>207</sup> Again, Sir Elton John expressed similar complaints as Waits when Trump used John's hit song *Rocket Man* at rallies,

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202. *Id.* at 835.

203. *Id.* at 835–37.

204. *White v. Samsung Elecs. America, Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992).

205. *Id.*

206. *Id.* (quoting *Carson*, 698 F.2d at 835).

207. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1104 (9th Cir. 1992).

stating “I don’t really want my music to be involved in anything to do with an American election campaign. I’m British . . . I’m not a Republican in a million years.”<sup>208</sup> Likewise, K’naan’s public statement after Romney used his song *Wavin’ Flag* further illustrates how the musician is protecting a commercial interest: “I’m for immigrants. I’m for poor people, and they don’t seem to be what he’s endorsing.”<sup>209</sup> Indeed, reputational damages have been awarded in right of publicity cases.<sup>210</sup> Thus, it is evident that the musician has an interest that may be protected from the politician’s exploitation of that identity. As the Ninth Circuit has noted, “[c]onsiderable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity’s sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof.”<sup>211</sup>

Though a right of publicity argument might work for the musician, this is only true when the politician has not properly acquired a copyright license to use the song. The same does not necessarily hold true for when the politician **has** acquired a license. Again, this article’s focus is on *when the politician has in fact obtained a copyright license to use the song*, what intellectual property rights does the musician nonetheless have. And when the politician has a license to use the song, the musician’s state-based right of publicity claim could very well be preempted by federal copyright law.

#### V. PREEMPTION ISSUES WITH RIGHT OF PUBLICITY

Federal copyright law naturally intersects with the state-based right of publicity. Again, a copyrighted work can include, for example, a photograph. However, the subject matter of the photograph—the person in the photograph—is not protected under copyright law. Rather, it is just the photograph that is protected. The subject of that photograph finds his or her protection in the right of publicity. Thus strikes the conflict between the rights of the copyright owner and the rights of the subjects of those copyrighted works, giving rise to preemption issues.<sup>212</sup>

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208. Chilton, *supra* note 17.

209. See Chao, *supra* note 12.

210. See Clark v. Celeb Publ’g, Inc., 530 F. Supp. 979, 984 (S.D.N.Y. 1981) (applying California law).

211. *White*, 971 F.2d at 1399.

212. See *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134, 1145 (9th Cir. 2006) (“[o]n the one hand, we recognize that the holder of a copyright does not have ‘a license to trample on other

Courts use a two-part test to determine whether a state law claim is preempted by the Copyright Act (“the Act”).<sup>213</sup> First, does the subject matter of the state law claim fall within the subject matter of copyright described in sections 102<sup>214</sup> and 103<sup>215</sup> of the Act (art, music, etc.)?<sup>216</sup> If so, is the state law right asserted equivalent to those described in section 106<sup>217</sup> of the Act (right to

people’s rights.’ On the other hand, however, the right of publicity is not a license to limit the copyright holder’s rights merely because one disagrees with decisions to license the copyright.”).

213. *Id.* at 1137; Copyright Act, 17 U.S.C.A. §§ 101–1332 (West, Westlaw through P.L. 115-22).

214. 17 U.S.C.A. § 102 (West, Westlaw through P.L. 115-22). Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

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

215. 17 U.S.C.A. § 103 (West, Westlaw through P.L. 115-22). Subject matter of copyright: Compilations and derivative works

(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

216. *Laws*, 448 F.3d at 1137.

217. 17 U.S.C.A. § 106 (West, Westlaw through P.L. 115-22). Exclusive rights in copyrighted works

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

distribute, reproduce, etc.)?<sup>218</sup> If the answer to both of these questions is yes, then the state law claim is preempted.<sup>219</sup>

In the situation where Trump obtained a license to use Young's *Rockin' in the Free World*, Young's hypothetical right of publicity claim would be preempted by copyright law. This is because the subject matter of Young's claim—a sound recording—falls directly under the subject matter that is copyrightable under section 102.<sup>220</sup> This is the simple answer. However, we should look at exactly why that is so and the key that the license or lack thereof actually plays.

Cases where plaintiffs' right of publicity claims were not preempted by copyright law are distinguishable from the hypothetical case involving Trump and Young. Again, in our hypothetical, Trump has a license to the sound recording and Young loses on his right of publicity claim due to copyright preemption. In *Midler*, though, the Ninth Circuit held that Midler's vocal misappropriation claims under California common law were not preempted by copyright law.<sup>221</sup> In *Midler*, the subject matter at issue was her voice (even though it was not actually *her* voice). Ford did not have a license to use Midler's

(1) to reproduce the copyrighted work in copies or phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and

(6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

218. See *Laws*, 448 F.3d at 1137-38.

219. Sections 301(a) and (b) of Title 17 of the Copyright Act describe when the Act preempts legal and equitable rights granted by state common law or statute. Congress explained that “[t]he intention of section 301 is to preempt and abolish any rights under the common law or statutes of a State that are equivalent to copyright that extend to works, within the scope of the Federal copyright law.” H.R. REP. NO. 94-1476, at 130 (1976); see also *Maljack Prods. v. GoodTimes Home Video Corp.*, 81 F.3d 881, 888 (9th Cir. 1996).

220. See note 216.

221. See generally *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

vocal recording of *Do You Want To Dance?*<sup>222</sup> Rather, Ford's ad agency, Young & Rubicam, only had a license from the copyright holder to use the song.<sup>223</sup> But because Ford was directly after Midler's voice as that is where it would draw its commercial value, Ford sought a sound-alike who perfectly mimicked Midler's voice.<sup>224</sup> Ford therefore appropriated Midler's image through the use of "her voice." Utilizing the two-part test, the Ninth Circuit reasoned that voice is not a subject matter that is protectable by copyright.<sup>225</sup>

It stands to reason then that had Ford obtained a license to use Midler's vocal recording of *Do You Want To Dance?*, Midler's common law claim would have failed. This is because the subject matter would have not been "voice" but a "vocal recording"—the same subject matter as in our Trump/Young scenario—and the specific subject matter protectable by copyright found under section 102 of the Copyright Act. In other words, voice and vocal recordings are two different things. Once the voice becomes fixed in a tangible medium, it is a vocal recording, which is a subject matter that is copyrightable. Thus, if Ford actually had a copyright license to use the vocal recording, Midler's right of publicity claim would have been preempted. But because Ford did **not** obtain a copyright license to the vocal recording and used what essentially was Midler's voice, Midler's right of publicity claim was not preempted. Thus, whether the defendant has a license is key.

Another case where the plaintiff's right of publicity claim was not preempted by copyright law is *Downing v. Abercrombie & Fitch*.<sup>226</sup> In *Downing*, the defendant clothing company purchased a photograph depicting a group of surfers in a surfing competition that took place approximately 30 years prior to the lawsuit.<sup>227</sup> The names of the surfers were handwritten at the bottom of the photograph.<sup>228</sup> Abercrombie used the photo in its catalogue that featured surf-style clothing. The surfers brought state law right of publicity claims, but Abercrombie argued that federal copyright law preempted their claims. The

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222. *Id.* at 462.

223. *Id.*; see also *supra* notes 30-34 and accompanying text (discussing the two different copyrights implicated by a song—the musical composition and the sound recording).

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

225. *Id.* at 462 ("A voice is not copyrightable. The sounds are not 'fixed.' What is put forward as protectable here is more personal than any work of authorship.").

226. 265 F.3d 994, 1004 (9th Cir. 2001).

227. *Id.* at 1000.

228. *Id.*

Ninth Circuit Court of Appeals rejected Abercrombie’s argument, holding “it is not the publication of the photograph itself, as a work of creative authorship, that is the basis for [the surfers’] claims, but rather, it is the use of the [surfers’] likenesses and their names . . . .”<sup>229</sup> Claims for misappropriation of a person’s “name or likeness” are not preempted by the Copyright Act, “notwithstanding the fact that [such] names or likenesses are embodied in a copyrightable photograph.”<sup>230</sup>

“Where a defendant in a right-of-publicity claim obtained a copyright in a work featuring the plaintiff, courts must separate legitimate exploitations of what Congress intended to be a copyright holder’s exclusive rights from particular uses that infringe the right of publicity.”<sup>231</sup> “Otherwise, few copyright holders would be safe from suits by performers who agreed to appear in the holders’ works.”<sup>232</sup> In other words, a right of the copyright holder (*e.g.*, right to play a vocal recording) needs to be separated from a use that would infringe on the plaintiff’s right of publicity; the two should not somehow be bundled into one. Going back to our hypothetical, the defendant-politician Trump is the copyright holder as he obtained a license to play the sound recording featuring the plaintiff-musician Young. If Trump did not have a license, Young (assuming him to be the copyright holder) could obviously claim copyright infringement. But because Trump *does* have a license, thereby precluding Young’s copyright infringement claim, Young should not then be allowed to repackage his would-be copyright infringement claim into a right of publicity claim. Young should not be able to transform the subject matter—vocal recording—into something else to somehow make it fit under a right of publicity claim. Vocal recording is a specific copyrightable subject matter, and if the plaintiff attempts to repackage, he will face preemption under the Copyright Act.

The Third Circuit, in *Fleet v. CBS, Inc.*, refuted this “repackaging” of a copyright infringement claim into a right of publicity claim. In *Fleet*, copyright law **did** preempt the plaintiffs’ right of publicity claim **was** preempted by copyright law.<sup>233</sup> *Fleet* involved a right-of-publicity claim by actors seeking to prevent a movie-distribution company from distributing a film in which they

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229. *Id.* at 1003.

230. *Id.* at 1004.

231. *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1028 (3d Cir. 2008).

232. *Id.* (citing J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 11:55, at 817 (2d ed. 2017) (“[W]hen another reproduces a recorded performance in an expressive, non-advertising medium, this should not be the concern of right of publicity law.”)).

233. *See generally* 50 Cal. App. 4th 1911 (Cal. App. 1996).

appeared.<sup>234</sup> The actors had contracted away their rights in the film, but had not received compensation.<sup>235</sup> They apparently hoped to obtain leverage in seeking payment by enjoining distribution of the film.<sup>236</sup> The California Court of Appeals held that the actors' claim was preempted, stating that "a party who does not hold the copyright in a performance captured on film cannot prevent the one who does from exploiting it by resort to state law."<sup>237</sup>

Likewise, the Ninth Circuit Court of Appeals, in *Laws v. Sony Music Entertainment, Inc.*, evaluated singer Debra Laws' claims that Sony had violated her right of publicity.<sup>238</sup> Sony used a sample of one of her recordings in a song by Jennifer Lopez and LL Cool J.<sup>239</sup> A third party, Elektra Asylum Records, owned the copyright in the original sound recording that featured Laws.<sup>240</sup> Elektra granted Sony a license to use the sample in the J. Lo–LL Cool J song.<sup>241</sup> Laws' recording contract with Elektra gave Elektra the right to grant licenses, subject to contractual conditions.<sup>242</sup> In that context, whether Laws authorized the sample license was a contract issue between Laws and Elektra.<sup>243</sup> But Laws sued Sony, the end user of the sample. Laws alleged misappropriation of her name and voice.<sup>244</sup> Applying the first prong of the two-part preemption test, the court found that Laws' master recordings fell clearly within section 102 because that section includes "sound recordings."<sup>245</sup> In her attempt to argue against

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234. *Id.* at 1914.

235. *Id.* at 1914.

236. *See id.* at 1924.

237. *Id.* at 1923.

238. *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1135–36 (9th Cir. 2006).

239. *Id.*

240. *Id.* at 1136.

241. *Id.*

242. *Id.*

243. *See id.* at 1143 ("To the extent that Laws has enforceable, contractual rights regarding the use of Elektra's copyright, her remedy may lie in a breach of contract claim against Elektra for licensing [her song] 'Very Special' without her authorization.").

244. *Id.* at 1136.

245. *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1139 (9th Cir. 2006); Copyright Act, 17 U.S.C.A § 102(a) (West, Westlaw through P.L. 115-22) (Section 102 of the Act extends copyright protection to "original works of authorship fixed in any tangible medium of expression . . . From

preemption, however, Laws contended that the subject matter of a copyright claim and a right of publicity claim are substantively different.<sup>246</sup> She argued that “a copyright claim protects ownership rights to a *work of art*, while a right of publicity claim concerns the right to protect one’s *persona and likeness*.”<sup>247</sup> Sony argued that “the subject matter of a right of publicity in one’s voice is not different from a copyright claim when the voice is embodied within a copyrighted sound recording.”<sup>248</sup> Once a voice becomes part of a sound recording in a fixed tangible medium, Sony reasoned, it comes within the subject matter of copyright law.<sup>249</sup> In resolving the competing arguments, the court looked to its prior cases of *Midler* and *Sinatra v. Goodyear Tire & Rubber Co.* and concluded that Sony had the winning argument.<sup>250</sup>

In *Sinatra*, Nancy Sinatra sued Goodyear Tire over its advertising campaign that featured *These Boots Are Made for Walkin’*.<sup>251</sup> Goodyear had obtained a license from the copyright holder for the use of music, lyrics, and arrangement of the composition.<sup>252</sup> Goodyear subsequently used the music and lyrics in its ads, which were sung by unknown vocalists.<sup>253</sup> The Ninth Circuit noted that Sinatra’s “complaint is not that her sound is uniquely personal; it is that the sound in connection with the music, lyrics and arrangement [that] made her the subject of popular identification, ought to be protected. But as to these latter copyrightable items, she had no rights.”<sup>254</sup> Though the Ninth Circuit decided *Sinatra* prior to passage of the modern-day preemption provision in section 301, it nonetheless ruled that the Copyright Act impliedly preempted Sinatra’s state law claim.<sup>255</sup> To be clear, Goodyear’s license was for the song composition—a

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which they can be . . . reproduced, . . . either directly or with the aid of a machine or device.” That section defines a “work of authorship” to include “sound recordings.”<sup>17 U.S.C.A. § 102(a)(7) (West, Westlaw through P.L. 115-22).</sup>)

246. *Laws*, 448 F.3d at 1139.

247. *Id.* (emphasis added).

248. *Id.*

249. *Id.*

250. *See Id.* at 1139-41 (citing *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988); *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 716 (9th Cir. 1970)).

251. *Id.* at 1139.

252. *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134, 1139 (9th Cir. 2006).

253. *Id.*

254. *Id.* at 1139-40 (quoting *Sinatra*, 435 F.2d at 716).

255. *Id.* at 1140 (citing *Sinatra*, 435 F.2d at 717-18).

subject matter also found under section 102 of the Act—and Goodyear’s use was in accordance with that license. Goodyear did not utilize sound-alikes as the defendant did in *Midler*. Therefore, Goodyear did not appropriate Sinatra’s voice or any other thing outside the scope of section 102. Sinatra did not have a winning copyright infringement argument because Goodyear acted within the scope of its copyright license. Sinatra could not then repackage her would-be copyright infringement claim into a right of publicity claim. Again, the license held by Goodyear played a key role in determining a preemption outcome.

On the other hand, again, in *Midler*, Midler’s right of publicity claim was not preempted by copyright law. The defendant-advertising agency did **not** acquire a license to use Midler’s recording of *Do You Want To Dance*.<sup>256</sup> Instead, it had obtained a license from the song’s copyright holder—a license that did not allow for Midler’s vocal recording—and used a “sound alike” to imitate Midler’s voice for commercial use. Midler prevailed against preemption because the “thing” misappropriated, Midler’s voice, was not copyrightable.<sup>257</sup> The court stated “[a] voice is not copyrightable. The sounds are not ‘fixed.’ What is put forward as protectable here is more personal than any work of authorship.”<sup>258</sup> The *Laws* court found Laws’ voice misappropriation claim to be “plainly different” from the claims in *Midler* because the “thing” in *Laws* (vocal recording) fell within the subject matter of copyright.<sup>259</sup> Sony was not imitating *Very Special* as Laws might have sung it. It did not need to because it had the license to a portion of the vocal recording *Very Special* as sung by Debra Laws.<sup>260</sup> Therefore, the license was in accordance with the use, and the subject matter under that license fell within the scope of copyrightable subject matter. Consequently, Laws’ right of publicity claim was preempted by copyright law.

Thus, if there is an impermissible use of the subject’s image, including but not limited to, her name, likeness (*Downing*), or voice (*Midler*), the plaintiff’s right of publicity claim will not be preempted by copyright law. On the other hand, if there is permissible use of a sound clip (*Laws*), performance (*Fleet*), or

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256. *Id.*

257. *Id.*

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

259. *Id.*

260. *Id.* at 1140-41; *see also* *Brown v. Ames*, 201 F.3d 654, 658 (5th Cir. 2000) (“The crucial difference between [this case and *Daboub v. Gibbons*, 42 F.3d 285 (5th Cir. 1995)] is that in *Daboub* the basis of the misappropriation claim . . . was the song itself, bringing it within section 301’s ambit, whereas here the basis of the misappropriation claim was defendants’ use of plaintiffs’ names and/or likenesses.”).

the tangible medium as a whole (*Sinatra*), the plaintiff will be preempted by copyright law.

*Laws* is particularly instructive in determining whether copyright law preempts a musician's right of publicity claim against the politician. Sony obtained a license to use the sample that featured Laws' voice. In other words, Sony had a license to use the *vocal recording*, which is a category that falls squarely within copyrightable subject matter. Thus, preemption prevailed. Likewise, if Trump obtains a copyright license to use the vocal recording of Young's *Rockin' in the Free World*, Young should not be able to successfully assert a right of publicity claim against Trump. Young could, but his claim would be preempted by federal copyright law. The entirety of the allegedly misappropriated vocal performance is contained within the copyrighted medium—the sound recording. If, however, the campaign obtained a license to only the song and had a singer at the rally imitate the singer's voice (not likely), *then* the artist might have a viable claim as seen in *Midler* because then the misappropriated subject matter is the voice, which is not copyrightable. The "subject matter" of a right of publicity claim is not a particular picture, song, or photograph of the plaintiff.<sup>261</sup> "Rather, what is protected by the right of publicity is the very identity or persona of the plaintiff as a human being."<sup>262</sup> The sound recording alone is not the likeness.

## VI. CONCLUSION

A politician who has paid for a license under copyright law to use a musician's song is not immune from a musician's intellectual property claim. While there certainly are policy reasons to allow the bona fide license purchaser to use the song in accordance with the license, there are also reasons against allowing such use. Reasons against the use find support in a false endorsement claim. Under a false endorsement cause of action, the mark at issue is the musician's identity. This concept is different from trademark in a singular song or performance, which has been rejected by courts. Identity can be comprised of the artist's unique voice, which might also coincide with strong viewpoints of the artist. Courts have certainly recognized that distinct vocal identity can give rise to a legally protected mark. Particularly, the context of the politician's use might strengthen the musician's claim. If, for example, the politician continually uses a musician's song, plays multiple songs by the same musician, and even discusses the musician by name in reference to support of that campaign, the

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261. See J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 11.52(2017).

262. *Id.*

musician could have a strong false endorsement claim. Furthermore, the public is likely to be confused as to whether the musician endorses the politician. Indeed, actual confusion—the factor usually the most dispositive—exists in this context and is particularly evident through social media.

While a right of publicity claim is similar to a false endorsement claim—perhaps even the common law equivalent to the federal false endorsement claim—it fails to provide the musician adequate protection due to copyright preemption. First, the musician who complains in this context does so because it is his particular sound recording being played—the sound recording with his distinct voice on it. He does not want the politician to misappropriate his voice, and so he cries violation of right of publicity. But when the politician does in fact have a copyright license to use this sound recording, the musician’s cries become stifled. This is so because the Copyright Act’s subject matter expressly includes “sound recordings.” If the musician is using the license in accordance with its terms, federal copyright law preempts the state-based right of publicity. Conversely, because false endorsement sounds in federal law the same way copyright law does, it is not preempted like its right of publicity counterpart.

Though Trump and other politicians may properly acquire a license, musicians obviously feel protective over their work and don’t want their well-crafted images placed in jeopardy. Trademarks are the owners’ pledge of consistent quality and a means for conveying a certain status to consumers, all of which helps businesses promote their products and services.<sup>263</sup> Nowadays, if that status is called into question, the public might expect the musician to publicly denounce the politician’s use to maintain the musician’s integrity. And if the musician doesn’t, his fans might wonder—does he actually support *that guy*? In the absence of a public denouncement via Twitter, the artist stands to lose credibility with his fans. Should a public denouncement be necessary? Can’t the musician instead rely on intellectual property remedies to prevent the politician’s use from happening? Even after The Rolling Stones repeatedly expressed dismay over Trump playing their song *You Can’t Always Get What You Want*, Trump continued to play it, and it even played after he was announced the President-elect.<sup>264</sup> The song, after all, had become Trump’s theme song. But with more and more musicians complaining from year to year, the Lanham

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263. Natalie J. Spears & S. Roberts Carter III, *This is My Brand: Litigating Product Image*, LITIG. 31 (2005).

264. *How You Can’t Always Get What You Want became Donald Trump’s bizarre theme song*, THEGUARDIAN.COM (Nov. 9, 2016, 12:23 PM), <https://www.theguardian.com/us-news/shortcuts/2016/nov/09/how-you-cant-always-get-what-you-want-became-donald-trumps-bizarre-theme-song>.

Act's false endorsement provision just might be the musician's ace in the hole to trump Trump. It will be interesting to watch.