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Guantanamo's Greatest Hits: The Semiotics of Sound and the Protection of Performer Rights under the Lanham Act

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Guantanamo's Greatest Hits: The Semiotics of Sound and the Protection of Performer Rights under the Lanham Act

John Tehranian*

ABSTRACT

As Bruce Springsteen and Ronald Reagan, Jackson Brown and John McCain, and Tom Morello and Paul Ryan can attest, the exploitation of creative works for political or commercial purposes that run contrary to artists' ideals can stir passions and trigger lawsuits. Yet for performers who are not authors of the exploited works, there is little meaningful legal relief provided by the federal Copyright Act. Instead, such performers—from featured singers and dancers to actors and other personalities known for their distinctive traits—have leaned on alternative theories for recovery, thereby raising the specter of liability outside of copyright law for such unwelcome uses. While a rich body of literature analyzes and critiques the use of publicity rights in these contexts, the vindication of performer rights through the Lanham Act and related state law has received far less attention. Furthermore, though courts in such cases have frequently ruled in tandem on right of publicity and trademark/false endorsement claims, jurists and scholars have given insufficient independent analysis to the particularities of the latter. This Article seeks to address this void by focusing on performers' efforts to seek relief under the Lanham Act and related state law for unwanted uses of their creative output in promotional contexts and by considering alternatives for redressing performer concerns in a manner

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that better protects the public domain and balance in the intellectual property regime.

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I. INTRODUCTION: BABY KISSES AND INFRINGEMENT MISSIVES

The US Presidential election cycle has its predictable, if not comforting, quadrennial rhythm. Every four years, politicians vying for the position of Commander-in-Chief descend upon Iowa and New Hampshire, where they invoke comparisons to mythic figures of our past, kiss babies, and shake the hands of ordinary citizens in an attempt to connect with voters. In recent years however, another initiation rite has become almost *de rigueur* for those making their way through the nomination process: being accused of infringement. Indeed, over the past decade, politicians have suffered a veritable tidal wave of legal missives and lawsuits brought by artists who object to the use of their creative works in political campaigns.¹ For every Fleetwood Mac—which had no problem with having its hit “Don’t Stop” associated with the Clinton-Gore campaign of 1992²—there are dozens of artists who look askance at such exploitation of their music. During the 1984 election, Bruce Springsteen famously bristled at Ronald Reagan’s use of “Born in the U.S.A.” and the seemingly oblivious invocation of its lyrics as a patriotic paean.³ Ann and Nancy Wilson of Heart complained

1. See, e.g., Tamy Cozier, *Campaign Trail Mix: A Brief History of Presidential Theme Songs*, PBS (Mar. 7, 2012), <http://www.pbs.org/wnet/need-to-know/the-daily-need/campaign-trail-mix-a-brief-history-of-presidential-theme-songs/13257>; 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>.

2. Justin Hughes, *Election Copyright – They're Playing Our Song*, MEDIA INST. (Apr. 14, 2009), http://www.mediainstitute.org/IPI/2009/041409_ElectionCopyright.php. It is worth noting that the use forever sullied the song, even for those who were both fans of the ditty and the Clinton-Gore ticket.

3. L.J. Jackson, *Facing the Music*, 97 A.B.A. J. 10 (2011).

when 2008 Republican Vice Presidential candidate Sarah Palin roused campaign crowds with the driving rhythms of “Barracuda.”⁴ The Foo Fighters took Republican Presidential candidate John McCain to task for using their song “My Hero,” a “celebration of the common man and his extraordinary potential,” that was allegedly “pervert[ed]” by McCain’s use.⁵ Jackson Browne sued John McCain and the Ohio Republican Party for using “Running on Empty” in a campaign advertisement about energy policy.⁶ And while it is not a musical work, Shepard Fairey’s iconic HOPE image, which was inspired by an Associated Press photograph of Obama, spawned perhaps the most famous litigation related to the 2008 campaign.⁷

The recently completed 2012 campaign was no less riddled with intellectual property controversies. During the course of the cycle, the writer of *Survivor*’s “Eye of the Tiger” sued Newt Gingrich for his use of the song while stumping on the campaign trail.⁸ Tom Petty’s attorneys forced Michele Bachmann to cease and desist her use of “American Girl” at rallies.⁹ K’naan asked Mitt Romney to stop playing his song, “Wavin’ Flag.”¹⁰ And most pointedly, Paul Ryan was pre-emptively warned not to even consider publicly performing the music of one of his favorite bands, Rage Against the Machine.¹¹ Rage’s guitarist Tom Morello, a prominent social activist, made it clear that he did not reciprocate the

4. Allison Brennan, *Campaigns Rock at Their Own Risk*, CNN (Aug. 16, 2012, 6:43 PM), <http://www.cnn.com/2012/08/16/politics/music-in-campaigns>.

5. Dave Itzkoff, *Rock Band Protests McCain’s Use of Its Song*, N.Y. TIMES (Oct. 8, 2008), http://www.nytimes.com/2008/10/09/arts/music/09arts-ROCKBANDPROT_BRF.html (quoting press release from the Foo Fighters).

6. *Browne v. McCain*, 611 F. Supp. 2d 1073, 1075 (C.D. Cal. 2009). The *Browne* case settled before a decision on the merits, although the Lanham Act claim did survive a Rule 12(b)(6) motion to dismiss. *See id.* at 1078–81; McKinley, *supra* note 1.

7. *See* Randy Kennedy, *Artist Sues the A.P. Over Obama Image*, N.Y. TIMES (Feb. 9, 2009), <http://www.nytimes.com/2009/02/10/arts/design/10fair.html>.

8. *See* Complaint at 1, *Rude Music, Inc. v. Newt 2012, Inc.*, No. 1:12-cv-00640 (N.D. Ill. Jan. 30, 2012), 2012 WL 264219; *see also* Tamera Bennett, *Complaint Against Newt Gingrich 2012 Copyright Infringement*, JD SUPRA L. NEWS (Jan. 30, 2012), <http://www.jdsupra.com/post/documentViewer.aspx?fid=dc7d3739-c254-4801-a0d2-998059c0d7bb>.

9. *See* Brennan, *supra* note 4; *see also* Andy Greene, *Tom Petty to Michele Bachmann: Quit Playing ‘American Girl,’* ROLLING STONE (June 28, 2011, 3:55 PM), <http://www.rollingstone.com/music/news/tom-petty-tells-michele-bachmann-to-stop-playing-american-girl-20110628>.

10. *K’naan: Mitt Romney Did Not Have Permission to Use ‘Wavin’ Flag,’* HUFFINGTON POST (Feb. 1, 2012, 8:47 PM), http://www.huffingtonpost.com/2012/02/01/knaan-mitt-romney-did-not_n_1248731.html.

11. *See* Emmarie Huetteman, *Rage Against the Machine Isn’t Returning Ryan’s Love*, N.Y. TIMES (Aug. 17, 2012, 12:57 PM), <http://thecaucus.blogs.nytimes.com/2012/08/17/rage-against-the-machine-isnt-returning-ryans-love>; Tom Morello, *Tom Morello: ‘Paul Ryan is the Embodiment of the Machine Our Music Rages Against,’* ROLLING STONE (Aug. 16, 2012, 6:44 PM), <http://www.rollingstone.com/music/news/tom-morello-paul-ryan-is-the-embodiment-of-the-machine-our-music-rages-against-20120816>.

love when he swiftly disabused Ryan of any thought of playing Rage songs at his rallies.¹² Not mincing words, Morello reflected:

Paul Ryan's love of Rage Against the Machine is amusing, because he is the embodiment of the machine that our music has been raging against for two decades. . . . Don't mistake me, I clearly see that Ryan has a whole lotta "rage" in him: A rage against women, a rage against immigrants, a rage against workers, a rage against gays, a rage against the poor, a rage against the environment. Basically the only thing he's *not* raging against is the privileged elite he's groveling in front of for campaign contributions.¹³

The exploitation of creative works for political purposes clearly stirs passions, and the claims of infringement have extended beyond music. Peter Berg, the creator of the television series *Friday Night Lights*, decried the Romney campaign's unauthorized use of the show's memorable mantra: "Clear Eyes, Full Hearts, Can't Lose."¹⁴ Romney had invoked the rallying cry during several speeches and also used the phrase on his Facebook page.¹⁵ In a letter, Berg accused Romney of "plagiarism" and asserted that the "use of the expression falsely and inappropriately associates *Friday Night Lights* with the Romney-Ryan campaign."¹⁶ In a parting shot, he exhorted Romney to "come up with [his] own campaign slogan."¹⁷

Yet for all of the vociferation, legal responses to musicians' complaints have been mixed. Musicians' copyright claims typically fail because the venues where politicians conduct their rallies possess licenses from Performing Rights Organizations (PROs), such as Broadcast Music, Inc. (BMI) and the American Society of Composers, Authors, and Publishers (ASCAP) that enable the public performances of the musical compositions. No matter how strenuously the artists may protest, the copyright holder to the musical composition at issue has invariably agreed to a blanket performance-license regime that enables venues to play the musical composition without regard to who is using the venue and for what purpose.¹⁸ That said, there are

12. See Huetteman, *supra* note 11; see also Morello, *supra* note 11.

13. Morello, *supra* note 11.

14. Matthew Belloni, *Friday Night Lights' Creator Accuses Mitt Romney of Plagiarism in Threatening Letter (Exclusive)*, HOLLYWOOD REPORTER (Oct. 12, 2012, 10:54 AM), <http://www.hollywoodreporter.com/thr-esq/friday-night-lights-creator-accuses-378606>. Not everyone associated with the *Friday Night Lights* franchise disapproved of the use—Buzz Bissinger, who wrote the original book upon which the movie and series were based, was a Romney supporter. *Id.*

15. *Id.*

16. Letter from Peter Berg to Mitt Romney (Oct. 12, 2012), available at http://www.hollywoodreporter.com/sites/default/files/custom/Documents/ESQ/Letter_to_Romney.pdf.

17. *Id.*

18. See, e.g., *Music Performance Agreement*, BMI, ¶ 2, <http://www.bmi.com/forms/licensing/gl/39m.pdf> (last visited Aug. 4, 2013) (granting licensees "a non-exclusive license solely

circumstances that can give rise to colorable legal action for copyright infringement. For example, when a campaign captures footage of an event where it plays a song and subsequently disseminates that footage (by placing it on YouTube, for example), the campaign has engaged in a use of the song that is not covered by public performance licenses.¹⁹ Thus, use of a song in a political advertisement, as in the *Browne v. McCain* litigation, violates the exclusive rights of reproduction and distribution. Such uses are infringing absent an appropriate syncing license.²⁰

For performers who are not holders of the copyright to either the musical composition or sound recording, there is no available relief under the Copyright Act. Typically, only the copyright holder of the work being reproduced or distributed would have standing to bring suit under the Act.²¹ For music, this is usually either the record label (which usually retains the rights to the sound recording) or the composer of the musical composition.²² This state of affairs has resulted in much consternation. As the examples from the last several election cycles demonstrate, featured performers often feel a sense of injury from the unauthorized use of their creative works for unwanted political purposes—so much so that they are sometimes willing to spend significant amounts of their own money and time litigating these cases.²³ And the injury felt by performers who are not copyright holders

to perform, present or cause the performance of, as part of Attractions in Facilities, **including recorded music** performed in conjunction with Attractions before, after or during the intermissions thereof, all the musical works as to which BMI shall have the right to grant public performance licenses during the Term hereof.”).

19. Since such a use results in a reproduction and distribution of the sound recording, the copyright holder's exclusive rights to reproduce and publicly distribute the work are also implicated. See 17 U.S.C. § 106(1), (3) (2012).

20. Of course, liability does not ineluctably attach. Among other things, a court might view such a violation as *de minimis*, see, e.g., *On Davis v. Gap, Inc.*, 246 F.3d 152, 173 (2d Cir. 2001) (stating, in dicta, that singing “Happy Birthday” at a restaurant might be deemed *de minimis* unauthorized use of a [purportedly] copyrighted work and should therefore not incur infringement liability), or excuse it on fair use grounds, 17 U.S.C. § 107 (2012).

21. See 17 U.S.C. § 501(b) (2012); *Davis v. Blige*, 505 F.3d 90, 99 (2d Cir. 2007) (“The right to prosecute an accrued cause of action for infringement is also an incident of copyright ownership.”).

22. See, e.g., Complaint at 3–4, *Rude Music, Inc. v. Newt 2012, Inc.*, No. 1:12-cv-00640 (N.D. Ill. Jan. 30, 2012), 2012 WL 264219.

23. Litigation for principle's sake is frequently regarded as either extinct or a fool's errand. It may sound naïve to suggest, but it appears that there truly are some artists who pursue these claims purely on the basis of principle and without regard to economic gain. See, e.g., Daniel Kreps, *Don Henley Settles Suit Against California Rep. Chuck DeVore*, ROLLING STONE (Aug. 5, 2010, 2:28 PM), <http://www.rollingstone.com/music/news/don-henley-settles-suit-against-california-rep-chuck-devore-20100805> (“In a statement, Henley said, ‘My colleagues and I brought this lawsuit to protect our music from being taken and used, without permission, to promote someone else's agenda. It was not a question of political ideology, but the right of artists to control the use of the works they create, and protect their livelihoods.’”).

is not limited to the world of music. Performance characteristics subjected to litigation include the vocal (a singer with a gruff and raspy masculine voice, for example²⁴) and physical (a blonde donning jewelry and a gown turning large block letters²⁵ or a stout middle-aged man drinking beer while seated at the end of a bar,²⁶ for example). In addition, performers have objected to various forms of exploitation beyond uses at campaign rallies and litigation on this issue has extended to advertisements for products as diverse as political candidates,²⁷ potato chips,²⁸ and cars.²⁹

As performers have sought to vindicate their rights and litigants have raised alternative theories for recovery, the specter of liability grounded outside of copyright law has grown more pronounced. Unlike copyright-infringement claims, these alternative theories usually attach to the performer of the work rather than the holder of the copyright in a given creative work.³⁰ Most often, performers invoke rights of publicity secured under state law.³¹ For such claims, artists must establish the commercial misappropriation of their voice, name, or likeness (or in some states, the broader notion of a “persona”).³² Litigants often bring a second claim concomitantly: the performer typically asserts that the defendants’ actions constitute a form of false endorsement or trademark infringement under the Lanham Act or related state law (usually grounded in unfair competition).³³ To create a cognizable claim for legal relief under this theory, the plaintiff must generally show that the defendant’s use of the performer’s distinctive and distinguishing characteristics creates a likelihood of consumer confusion that the performer is sponsoring or otherwise endorsing the defendants’ product.³⁴

24. See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1097 (9th Cir. 1992).

25. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397 (9th Cir. 1992).

26. See *Wendt v. Host Int’l, Inc.*, 197 F.3d 1284, 1286 (9th Cir. 1999).

27. See *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1147 (C.D. Cal. 2010).

28. See *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 57–58 (2d Cir. 2001).

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

30. See 15 U.S.C. § 1125 (2012); CAL. CIV. CODE § 3344 (West 2013).

31. See, e.g., CAL. CIV. CODE § 3344.1.

32. See, e.g., *id.*

33. See 15 U.S.C. § 1125; S. REP. NO. 79-1333 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1275 (stating that “there is no essential difference between trade-mark infringement and what is loosely called unfair competition”).

34. See *id.* § 1125(a)(1)(A). Claims for false endorsement can be grounded in either § 1125(a)(1)(A), which generally provides a claim against false designations that are likely to cause consumer confusion as to the source or origin of goods or services, including as to their sponsorship, affiliation, connection, association, or approval, and § 1125(a)(1)(B), which generally forbids false advertising. Typically, courts such as the Ninth Circuit have analyzed them as the former, thereby requiring a likelihood of consumer confusion. See *Wendt v. Host Int’l, Inc.*, 125 F.3d 806, 813 (9th Cir. 1997); *Newton v. Thomason*, 22 F.3d 1455, 1462 (9th Cir. 1994).

While there is already a rich body of literature analyzing and critiquing the use of publicity rights in these contexts,³⁵ the vindication of performer rights through the Lanham Act and related state law has received far less attention. Furthermore, though courts in such cases have frequently ruled in tandem on right of publicity and trademark/false endorsement claims, both jurists and scholars have given insufficient independent analysis to the particularities of the latter.³⁶ This is especially troubling because trademark/false endorsement claims serve distinct purposes,³⁷ require distinct elements,³⁸ and enjoy distinct defenses.³⁹ This Article seeks to address this void in the literature by focusing on the attempts of performers to seek relief under the Lanham Act and related state law for the unauthorized and unwanted uses of their creative output in promotional contexts.

This Article begins by exploring why courts may feel an intuitive, equitable impulse to respond favorably to such entreaties. Using the example of music streaming at the American military base at Guantanamo Bay, Part II assesses the potential injuries performers might experience from the unauthorized exploitation of their work and how they might seek legal relief for such objectionable uses. However, Part III argues that the Lanham Act and related state law are an uncomfortable fit for these types of injuries. Indeed, such machinations by the courts have not served public policy well.⁴⁰ Specifically,

35. See, e.g., Zachary M. Vaughan, *The Paradox That Wasn't: Federal Preemption of State-Law Voice Misappropriation Claims*, 11 J. MARSHALL REV. INTELL. PROP. L. 694 (2012); Thomas F. Cotter & Irina Y. Dmitrieva, *Integrating the Right of Publicity with First Amendment and Copyright Preemption Analysis*, 33 COLUM. J.L. & ARTS 165 (2010); Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn From Trademark Law*, 58 STAN. L. REV. 1161 (2006); Jennifer E. Rothman, *Copyright Preemption and the Right of Publicity*, 36 U.C. DAVIS L. REV. 199, 221 (2002); Arlen W. Langvardt, *The Troubling Implications of a Right of Publicity "Wheel" Spun Out of Control*, 45 U. KAN. L. REV. 329 (1997).

36. See, e.g., Dogan & Lemley, *supra* note 35, at 220–21.

37. See *Procter & Gamble Co. v. Amway Corp.*, 242 F.3d 539, 563 (5th Cir. 2001) (citing S. REP. NO. 79-1333 (1946) (noting that the purpose of the Lanham Act is to “secure[] to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not”); *Conte Bros. Auto., Inc. v. Quaker State-Slick 50, Inc.*, 165 F.3d 221, 229 (3rd Cir. 1998) (“[T]he focus of [the Lanham Act] is on anti-competitive conduct in a commercial context.”); *Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 215 n.13 (2d Cir. 1985) (“The central purpose of the trademark bill . . . was to “make possible a choice between competing articles by enabling the buyer to distinguish one from the other.” (citing S. REP. NO. 79-1333, at 4 (1946))).

38. See, e.g., 15 U.S.C. § 1125(a)(1)(A) (2012) (interdicting, *inter alia*, false designations of origin likely to cause consumer confusion in connection with any goods or services in interstate commerce).

39. See, e.g., Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 GEO. WASH. L. REV. 1 (2013) (discussing the competing approaches of courts to First Amendment defenses for, *inter alia*, right of publicity and trademark cases).

40. See *infra* notes 98–99 and accompanying text.

inconsistencies as to what constitutes a protectable mark and whether a likelihood of confusion occurs from the use of said mark have plagued the case law, resulting in a series of decisions that take seemingly paradoxical and troubling positions.⁴¹ Meanwhile, such rulings have interfered with the functioning of the marketplace for creative works and burdened the copyright regime as a whole, thereby threatening commercial expectations in the licensing arena.⁴² And perhaps most alarming of all, the recognition of performer rights through the Lanham Act and related state law has potentially permanent adverse consequences for the public domain and expressive freedoms. In the end, while there may certainly be good reasons to push for greater recognition of and protection for the rights of performers, false endorsement claims through the Lanham Act and related state law are not the appropriate vehicle for doing so. This Article therefore concludes with some final thoughts about potential alternatives for redressing performer concerns in a manner that better protects the public domain and balance in the intellectual property regime.

II. MUSIC AS TORTURE? “BORN IN THE U.S.A.” AND GUANTANAMO BAY

The impulse to provide remedies to performers for the unwanted and unauthorized association of their works is certainly understandable. After all, many performers spend a lifetime cultivating their technique, delivery, voice, look, and other aspects of their creative persona. Their performances often constitute intensely personal forms of expression. As a result, the use of their creative output in support of causes or products antithetical to their political beliefs, moral standards, or aesthetic sensibilities can animate a very real sense of wrongdoing. For example, consider how some recording artists may feel about the federal government’s use of their musical performances at the Guantanamo Bay military base.⁴³ As it turns out, the base’s repertoire is not intended for the enjoyment of military personnel; rather, it is a carefully designed aural tool for use with the prisoners.⁴⁴ Specifically, the soundtrack to Guantanamo Bay is replete

41. See *infra* notes 98–99 and accompanying text.

42. See *infra* notes 142–43 and accompanying text.

43. This discussion on the use of music at Guantanamo Bay is based on a previous analysis I conducted on the topic. See JOHN TEHRANIAN, *INFRINGEMENT NATION: COPYRIGHT 2.0 AND YOU* (2011).

44. See David Alexander, *Performers Angry Their Music Used in Guantanamo Interrogations*, REUTERS (Oct. 22, 2009), <http://blogs.reuters.com/talesfromthetrail/2009/10/22/performers-angry-their-music-used-in-guantanamo-interrogations>.

with songs meant to addle and unnerve, especially on repeat.⁴⁵ But it is a soundtrack to which the government may possess no rights of performance.⁴⁶

Guantanamo Bay's Top Ten List—the songs most frequently played to interrogate prisoners at the base—features a perverse smorgasbord of heavy metal, noxious children's music, and (seemingly) patriotic stadium rock:

1. "Enter Sandman" – Metallica
2. "Bodies" – Drowning Pool
3. "Shoot to Thrill" – AC/DC
4. "Hell's Bells" – AC/DC
5. "I Love You" (from the *Barney and Friends* children's television show)
6. "Born In The U.S.A." – Bruce Springsteen
7. "We Are The Champions" – Queen
8. "Babylon" – David Gray
9. "White America" – Eminem
10. "Sesame Street" (theme from eponymous children's television show)⁴⁷

45. The use of music as a form of psychological warfare is not entirely new. In 1989, General Manuel Noriega, a reputed opera lover, see George J. Church et al., *Panama No Place to Run*, TIME, Jan. 8, 1990, at 38, was holed up in a Papal nunciature in Panama City, seeking refuge with the Vatican after American forces had invaded Panama, see *Panama's General Manuel Noriega and His Fall From Grace*, BBC (Dec. 11, 2011, 9:17 PM), <http://www.bbc.co.uk/news/world-latin-america-15853540>. In response, American military officials bombarded him incessantly with loud rock and pop, including such songs as "Nowhere to Run" and "Smugglers Blues." See Roberto Suro, *Vatican Is Blaming U.S. for Impasse on Noriega's Fate*, N.Y. TIMES, Dec. 30, 1989, <http://www.nytimes.com/1989/12/30/world/after-noriega-vatican-is-blaming-us-for-impasse-on-noriega-s-fate.html>. In 1993, the Bureau of Alcohol, Tobacco, Firearms and Explosives ("ATF") and the FBI famously blared heavily distorted music and recordings of rabbits being slaughtered during the infamous standoff with the Branch Davidians in Waco, Texas. Michael Isikoff & Pierre Thomas, *Reno, FBI Took Fatal Gamble; Officials Believed Suicides Unlikely*, WASH. POST, Apr. 21, 1993, at A1. The origins may go even further back. Retired United States Air Force Lieutenant Colonel Dan Kuehl has located the Guantanamo policy's spiritual genesis in the Bible, commenting: "Joshua's army used horns to strike fear into the hearts of the people of Jericho. . . . His men might not have been able to break down literal walls with their trumpets, but the noise eroded the enemy's courage." Clive Stafford Smith, *Welcome to 'the Disco'*, GUARDIAN (June 18, 2008), <http://www.guardian.co.uk/world/2008/jun/19/usa.guantanamo>.

46. Cahal Milmo, *Pop Stars Demand Details of Guantanamo Music 'Torture'*, INDEPENDENT (Oct. 22, 2009), <http://www.independent.co.uk/news/world/americas/pop-stars-demand-details-of-guantanamo-music-torture-1807255.html> ("Campaigners say there is evidence that music played repeatedly at ear-splitting levels was used to 'humiliate, terrify, punish, disorient and deprive detainees of sleep' as part of efforts to break detainees during interrogation. Former inmates at Guantanamo have previously testified that songs from AC/DC, Britney Spears, the Bee Gees and Sesame Street were played as part of a psychological onslaught.").

47. Martyn McLaughlin, *Rock Legends Want to Silence Guantanamo's Torture Tunes*, SCOTSMAN (Dec. 10, 2008, 9:17 PM), <http://news.scotsman.com/topstories/Rock-legends-want-to.4782083.jp>.

Politics aside, the government's use of music in Guantanamo raises a key intellectual property issue: the military may not possess the appropriate public performance licenses to play the music.⁴⁸ Artist responses to this government use of copyrighted material without permission have been mixed, however. For example, James Hetfield of Metallica appears to condone the military's public performance of his work in Fallujah, proclaiming that "[i]f the Iraqis aren't used to freedom, then I'm glad to be part of their exposure."⁴⁹ Hetfield did mention, however, that the government had neither asked his permission nor paid him royalties.⁵⁰ Ironically, in other contexts, Metallica has claimed that the unauthorized use of a copyright holder's works constitutes an inexcusable act of thievery.⁵¹ For example, the band famously led the fight against unauthorized downloading of its music on the Internet.⁵²

Not all artists have been so enthusiastic about the military's unauthorized use of their musical compositions, however. As Trent Reznor of Nine Inch Nails wrote: "It's difficult for me to imagine anything more profoundly insulting, demeaning and enraging than discovering music you've put your heart and soul into creating has been used for purposes of torture."⁵³ Reznor threatened legal action, but it appears that he never followed up on this threat.⁵⁴ Notably, in contraposition to Hetfield, Reznor has served as a powerful voice opposing the Recording Industry Association of America (RIAA) lawsuits against unauthorized Internet downloading.⁵⁵

Although a few individual artists have raised concerns about the apparent infringement, the industry itself has remained relatively silent. While the RIAA appeared to have no qualms about suing

48. 17 U.S.C. § 106(4) (2012) grants copyright holders to musical compositions the exclusive right "to perform the copyrighted work publicly." Congress has defined "perform" as "not only the initial rendition or showing, but also any further act by which that rendition or showing is transmitted or communicated to the public." H.R. REP. NO. 94-1476, at 5676 (1976).

49. See Lane DeGregory, *Iraq 'n' Roll*, TAMPA BAY TIMES (Nov. 21, 2004), http://www.sptimes.com/2004/11/21/Floridian/Iraq_n_roll.shtml.

50. *Id.*

51. See *Metallica v. Napster, Inc.*, No. C 00-4068 MHP, 2001 WL 777005, at *1 (N.D. Cal. Mar. 5, 2001).

52. See *id.*

53. Trent Reznor, *Regarding NIN Music Used at Guantanamo Bay for Torture*, NINE INCH NAILS (Dec. 11, 2008, 1:00 PM), <http://forum.nin.com/bb/read.php?9,302470>.

54. See *id.* (wherein Reznor noted that "[i]f there are any legal options that can be realistically taken they will be aggressively pursued, with any potential monetary gains donated to human rights charities.").

children and grandmothers for engaging in peer-to-peer file sharing,⁵⁶ it did not seem as enthusiastic about pursuing infringement charges against the federal government.⁵⁷ Its reluctance to act in the face of this potentially brazen unauthorized public performance suggests that there may be more at play than legal issues.

Yet for performers who are not copyright holders of the sound recordings or musical compositions being played, the situation is even bleaker: an infringement suit under the Copyright Act is not even an option, despite any injury that they may feel.⁵⁸ Indeed, the absence of relief for performers under the Copyright Act effectively grants the federal government unfettered rights to cast musical performances in a light that might be entirely at odds with the performers' wishes and may entirely repurpose the semiotics⁵⁹ of the sound recording.

Consider Bruce Springsteen's "Born in the U.S.A."⁶⁰ Its unauthorized use at Guantanamo Bay allows the government to re-engineer the meaning of the song almost entirely, transforming it from an ironic and caustic appraisal of our societal failures to a bold assertion of national pride and prowess.⁶¹ Through its bleak portrait of a Vietnam veteran forgotten by his own country, the song presents a poignant critique of social inequalities and our tragic failure to properly honor those who serve and sacrifice for their country.⁶² Played at Guantanamo Bay, however, the song takes on an entirely different

56. See Matthew Sag, *Piracy: Twelve Year-Olds, Grandmothers, and Other Good Targets for the Recording Industry*, 4 NW. J. TECH. & INTELL. PROP. 133, 146 (2006) (documenting the music industry's peer-to-peer litigation campaign).

57. See Smith, *supra* note 45.

58. In addition, moral rights are generally not recognized as a part of the American copyright regime, as the latter seeks to vindicate the economic, rather than the personal, rights of the author. See *Gilliam v. Am. Broad. Cos.*, 538 F.2d 14, 24 (2d Cir. 1976); *Crimi v. Rutgers Presbyterian Church*, 89 N.Y.S.2d 813, 818 (Sup. Ct. 1949).

59. Broadly defined, semiotics constitutes the study of signs and their communication and social signification. See UMBERTO ECO, *A THEORY OF SEMIOTICS* 16 (1976).

60. BRUCE SPRINGSTEEN, *Born in the U.S.A.*, on BORN IN THE U.S.A. (Columbia Records 1984).

61. See *id.*

62. See *id.* Containing the lyrics:

Come back home to the refinery
 Hiring man says 'son if it was up to me'
 Went down to see my V.A. man
 He said 'son don't you understand now' . . .
 Down in the shadow of penitentiary
 Out by the gas fires of the refinery
 I'm ten years burning down the road
 Nowhere to run ain't got nowhere to go
 Born in the U.S.A./I was born in the U.S.A.
 Born in the U.S.A.
 I'm a long gone daddy in the U.S.A.

significance—at least to its intended audience of soldiers and detainees.⁶³ With the imprimatur of DJ Uncle Sam, the song's seemingly jingoistic, anthemic chorus takes center stage. Context transforms the tune from a biting attack on the false promises of the American dream into a patriotic paean that aurally demarcates the insider-outsider (or American-non-terrorist versus non-American-terrorist) divide separating soldiers and detainees. Indeed, a central distinction between those detainees taken to Guantanamo Bay and held indefinitely without charges and those brought to the United States and entitled to full due-process rights was initially based on a detainee's citizenship and birth status.⁶⁴ If you were indeed lucky enough to be born in the U.S.A., you were entitled to fundamentally different rights than those who were not.⁶⁵ Thus, besides setting a patriotic tone and asserting the base's status as a distinctly American space, the blaring of the song over the Guantanamo loudspeakers also serves as a stark reminder to the detainees of how much the fortunes of birth can affect one's fate.

Admittedly, Bruce Springsteen, *qua* musical composer, probably has a prima facie claim for copyright infringement against the federal government for its activities (though bringing it might be a challenge for various political and business reasons and the legal issues in the case would not be without significant complexity).⁶⁶ The government

63. Considering that some of the detainees may not speak English, one could argue that the message targets the soldiers as much as the detainees.

64. See *Hamdi v. Rumsfeld*, 542 U.S. 507, 509 (2004) (holding, *inter alia*, that detainees who are American citizens are entitled to challenge their detention before an impartial judge).

65. See *id.*

66. This issue is admittedly steeped in complexity. Although the federal government has waived its sovereign immunity with respect to copyright-infringement claims, see 28 U.S.C. § 1498(b) (2012) (giving copyright holders the right to bring claims against the federal government in the Court of Federal Claims for acts of copyright infringement), there is the question as to what law (if any) might apply under this set of facts. It could be US copyright law, Cuban copyright law, or even no law. The federal Copyright Act applies in any territory over which the United States exerts sovereignty, see *Twin Books Corp. v. Walt Disney Co.*, 83 F.3d 1162, 1167 (9th Cir. 1996) (noting that “United States copyright law applies to what takes place in the United States, [though] not to what takes place in Italy, Germany, or any other foreign place”). Still, to avoid any issue of ambiguity, most United States territories have an express statute that enables application of federal copyright laws. See Borge Varmer, *Study No. 34 Copyright in Territories and Possessions of the United States*, in STAFF OF S. COMM. ON THE JUDICIARY, 86TH CONG., COPYRIGHT LAW REVISION: STUDIES PREPARED FOR THE SUBCOMMITTEE ON PATENTS, TRADEMARKS, AND COPYRIGHTS OF THE COMMITTEE ON THE JUDICIARY (Comm. Print 1961) (noting how the US Virgin Islands and Puerto Rico, among other territories, have such enabling acts). Guantanamo Bay does not appear to have such a provision in place. However, one can potentially circumvent this problem in two ways. First, if a part of the infringing activity occurs in the United States (*e.g.*, perhaps the recordings are selected in the United States for unauthorized public performance in Guantanamo Bay), parties in the United States who contributed to the infringing activity could be held liable under American copyright law. MELVILLE NIMMER & DAVID NIMMER, 4-17 NIMMER ON COPYRIGHT § 17.02 (“[I]f, and to the extent, a part of an ‘act’ of infringement occurs within the United States,

must arguably obtain a license to engage in the public performance of his musical composition at Guantanamo or risk substantial damages under the Copyright Act.

However, Bruce Springsteen *qua* performer is in a rather different position. As the performer, he is irremediably associated with the work (and its meaning). After all, people do not identify musical works by their record company or musical composer; they refer to them by the artist who performed the work, just as the above list featuring Guantanamo's top-ten hits did. So when a work is used in a way that injuriously re-engineers its meaning and the associations with it, the performer feels it. Moreover, there is no doubt that a performer has fueled whatever commercial and artistic value the work has achieved, even if he did not author the copyright to the musical composition in question.⁶⁷ Despite these facts, the performer cannot bring a claim for a violation of an exclusive right under section 106 of the Copyright Act.⁶⁸ Instead, the artist must seek some alternate avenue for legal redress. Performers in similar circumstances have done just that: sued claiming, *inter alia*, false endorsement or unfair competition. While the position of the performers is eminently reasonable and often sympathetic, there is good reason to scrutinize judicial overtures that provide them such relief.

then, although such act is completed in a foreign jurisdiction, those parties who contributed to the act within the United States may be rendered liable under American copyright law." (citing, *inter alia*, *Subafilms, Ltd. v. MGM-Pathe Commc'ns Co.*, 24 F.3d 1088, 1094 n.9 (9th Cir. 1994) (en banc)). Second, if one distinguishes *Boumediene v. Bush*, 553 U.S. 723, 753 (2008) (holding, in the context of habeas rights, that the United States has exerted de facto sovereignty through its "complete and uninterrupted" exercise of "absolute and indefinite" control over Guantanamo for almost a century), by arguing that the terms of the lease for Guantanamo between Cuba and the United States determine the issue, Cuba is the territorial sovereign of Guantanamo and unauthorized performance would represent a violation of Cuban law. See Cuban Copyright Law art. 4 (Act No. 14/1977), available at http://www.wipo.int/wipolex/en/text.jsp?file_id=174839. Given these facts, it is surprising that not a single one of the myriad rockers with a penchant for all things Che Guevara has reveled at the prospect of suing the US government for infringement under Cuban copyright law.

67. In the case of "Born In The U.S.A.," Bruce Springsteen did, in fact, author the musical composition, as he regularly does with most of his recorded works. See *Biography for Bruce Springsteen*, IMDB, <http://www.imdb.com/name/nm0819803/bio> (last visited Aug. 1, 2012). However, in many instances, iconic performances of a particular musical works are done by celebrated artists who did not happen to author the underlying musical composition. See, e.g., JIMI HENDRIX, *All Along the Watchtower*, on ELECTRIC LADYLAND (Reprise Records 1968) (written by Bob Dylan); DON HENLEY, *All She Wants to Do Is Dance*, on BUILDING THE PERFECT BEAST (Geffen Records 1984) (written by Danny Kortchmar); and ASTRUD GILBERTO, *The Girl from Ipanema*, on GETZ/GILBERTO (Verve Records 1964) (written by Antonio Carlos Jobim, Vinicius de Moraes and Norman Gimbel).

68. 17 U.S.C. § 106 (2012) (stating that the owner of the *copyright* has the exclusive rights).

III. THE PRIMROSE PATH TO THE LANHAM ACT: RETHINKING VINDICATION OF PERFORMER RIGHTS UNDER THE THEORY OF FALSE ENDORSEMENT

There are numerous concerns about the propriety of using the Lanham Act and related state law as a vehicle for relief in such performer-rights cases. As a starting point, consider just how imperfect a fit the Act is for the rights truly being vindicated. As the text of the Act makes clear, its purpose is to “mak[e] actionable the deceptive and misleading use of marks in . . . commerce” and “to protect persons engaged in such commerce against unfair competition.”⁶⁹ To this end, section 1125(a) provides a federal remedy against anyone engaged in “[a] false designation of origin” or any “false or misleading description . . . or representation of fact” in connection with “any goods services” in a manner likely to cause consumer confusion.⁷⁰ Although courts have interpreted the Act broadly,⁷¹ the Supreme Court has cautioned that it not be read as a general law of unfair competition with boundless application.⁷² In attempting to raise a viable section 1125(a) action to vindicate their performance-related rights, plaintiffs typically claim that their case is about false endorsement and that consumers would mistakenly think that the advertised product originates from, is associated with or is endorsed by the plaintiff.⁷³ In reality, however, many of these suits represent (understandable but nevertheless problematic) attempts to fit a square peg into the proverbial round hole. The injury is not the confusion of consumers; rather, it is an associational and semiotic harm. As Justin Hughes has argued, an effort to control a song’s meaning represents the real gravamen of such claims.⁷⁴

Take *Henley v. DeVore*,⁷⁵ a 2010 decision arising out of a dispute between activist-musician Don Henley and conservative politician Charles “Chuck” DeVore.⁷⁶ During the course of his 2010 campaign to gain the Republican nomination and challenge Barbara Boxer for her

69. 15 U.S.C. § 1127 (2012).

70. 15 U.S.C. § 1125(a) (2012).

71. See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 776–85 (1992) (Stevens, J., concurring).

72. See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 29 (2003).

73. See 15 U.S.C. § 1125(a).

74. See Hughes, *supra* note 2.

75. 733 F. Supp. 2d 1144, 1166 (C.D. Cal. 2010) (“The Ninth Circuit has recognized a false endorsement claim under the Lanham Act ‘for the unauthorized imitation of [an individual’s] distinctive attributes, where those attributes amount to an unregistered commercial trademark.’” (quoting *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1106 (9th Cir. 1992))). Disclaimer: the author of this Article served as counsel in the *Henley* case.

76. *Id.* at 1147–48.

United States Senate seat in California, DeVore produced two videos that he uploaded to YouTube.⁷⁷ The first video featured a song entitled “The Hope of November,” a sendup of Henley’s nostalgic megahit “The Boys of Summer.”⁷⁸ “The Hope of November” combined a karaoke simulation of the instrumental track from “The Boys of Summer” with new lyrics that critiqued Barack Obama, Nancy Pelosi, and their supporters—such as Henley.⁷⁹ In the process, the song played on Henley’s famous musings about the “Deadhead sticker on a Cadillac” and the composition’s apparent themes of disillusionment with the false promises of 1960s activism.⁸⁰ The second video featured a song entitled “All She Wants to Do Is Tax,” a takeoff on Henley’s deceptively lighthearted “All She Wants to Do Is Dance.”⁸¹ “All She Wants to Do Is Tax” combined an instrumental simulation of “All She Wants to Do Is Dance” with lyrics critiquing liberal tax-and-spend policies.⁸² In the process, the song played on the original composition’s apparent theme of blithe indifference and Band-Aid problem solving in the wake of political turmoil.⁸³

Henley invoked both copyright and trademark law in his suit.⁸⁴ Specifically, he sued for copyright infringement where he could—he was a joint author of the musical composition for “Boys of Summer.”⁸⁵ Where he did not have a copyright claim—the author and copyright holder to “All She Wants to Do Is Dance” was veteran songwriter Danny Kortchmar,⁸⁶ not Henley—Henley pursued an alternative intellectual property theory.⁸⁷ He brought a federal claim for false endorsement under the Lanham Act, arguing that DeVore’s use of his music usurped

77. See *id.* at 1148–49.

78. *Id.* at 1147–48. “Boys of Summer” was co-written with Mike Campbell of Tom Petty and the Heartbreakers fame. *Id.* at 1147.

79. See *id.* at 1148, 1156.

80. See *id.* at 1148, 1156–57.

81. See *id.* at 1148–49. Although most famously performed by Don Henley, “All She Wants to Do Is Dance” was written by noted composer Danny Kortchmar. *Id.* at 1148.

82. See *id.* at 1149, 1158.

83. See *id.* at 1148, 1157–58. Henley explains that the song was inspired by the politically charged climate of the time. See *id.* He revealed that the last verse of “The Boys of Summer” was intended to “change things by protesting and making firebombs and growing [their] hair long and wearing funny clothes.” See Mikal Gilmore, *Henley Interview 1987*, ROLLING STONE, Nov. 5, 1987, at 287. However, he ultimately believed that his song had a marginal impact. He maintained that “after all [their] marching and shouting and screaming didn’t work, [they] withdrew and became yuppies.” *Id.*

84. *Henley*, 733 F. Supp. 2d at 1149.

85. See *id.* at 1147.

86. *Id.* at 1148.

87. *Id.* at 1166–69.

his protected persona and created a likelihood of consumer confusion regarding his sponsorship of or affiliation with DeVore.⁸⁸

But the Lanham Act claim was a poor proxy for the real injury for which Henley effectively sought relief.⁸⁹ At the core, Henley wanted to prevent the use of his works in a manner that he found objectionable, as a tool to besmirch political candidates he supported in order to raise campaign awareness and funds for a political candidate he did not.⁹⁰ The injury to Henley was not that people confused the campaign spots for his endorsement of the candidate.⁹¹ After all, Henley's voice was not even used in the video; rather, the vocals came from Justin Hart, the DeVore campaign's Director of Internet Strategies and New Media.⁹² And the Hart and Henley voices were virtually impossible for even the most tin-eared listener to confuse.⁹³ As the court euphemistically noted, Hart's voice was "less-than-angelic," particularly when compared to Henley's "more soothing vocals."⁹⁴ Furthermore, Henley's motivation was not primarily economic: he did not want to be paid a license fee for the use of his work.⁹⁵ Indeed, Henley has foregone millions of dollars in potential licensing revenue over the years by systematically refusing to permit the use of his works in any advertisement or context he deems

88. *Id.* at 1167–69. Henley was a rare performer rights case that did not bring a right of publicity claim. *Id.* at 1149. In all likelihood, Henley and his counsel made this decision strategically, as a result of several factors unique to the case that disfavored such a tactic. First, California's right of publicity statute, Civil Code section 3344, contains a specific exception for the use of an individual's publicity rights in the context of a political campaign. See CAL. CIV. CODE § 3344(d) (West 2013). Second, under California's statutory and common law right of publicity law (and unlike federal copyright law), transformative use constitutes a per se defense to claims of infringement. See *Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003) (holding that the use of names and likenesses of musicians as half-worm, half-human creatures in a comic book was sufficiently transformative to entitle the work to full First Amendment protection); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001) (holding that transformative but unauthorized uses of the name, voice or likeness of individuals are protected under the First Amendment and immunized from right of publicity liability). Finally, California has an anti-SLAPP statute to which all state-law claims attach, including those brought in federal court under pendant jurisdiction. CAL. CIV. PROC. CODE § 425.16 (West 2013). The anti-SLAPP statute provides the mandatory award of fees to defendants who prevail on an anti-SLAPP motion. CAL. CIV. PROC. CODE § 425.16(c).

89. This analysis and the points raised herein are based on a discussion with DeVore counsel, Chris Arledge.

90. See *Kreps*, *supra* note 23.

91. See *id.*; *Henley*, 733 F. Supp. 2d at 1168.

92. See *Henley*, 733 F. Supp. 2d at 1160.

93. See *id.* at 1168.

94. *Id.*

95. See Ben Sheffner, *Henley, Devore Settle Lawsuit; Henley Rails Against Remixes and Mash-ups, YouTube, 'Dark Side' of Internet; Songs are Not 'Toys or Playthings,'* COPYRIGHTS & CAMPAIGNS (Aug. 5, 2010, 8:33 AM), <http://copyrightsandcampaigns.blogspot.com/2010/08/henley-devore-settle-lawsuit-henley.html> (quoting Sheffner's interview with Don Henley).

commercial.⁹⁶ What Henley truly sought to vindicate was his right to prevent the use of his work in such situations; he wanted to be able to control the meaning of his work and the contexts in which it is presented.⁹⁷ Use as parodic or satirical fodder for a right-wing political candidate certainly did not make the cut. The real injury to Henley, if there was one, was not the idea of consumer confusion as to sponsorship or affiliation; it was the semiotic recasting of his songs into something he never intended them to be.

Perhaps because of the imperfect fit, court decisions treating performer rights raised under the aegis of the Lanham Act have been incongruous and unpredictable, further calling attention to the problematic nature of such theories. The inconsistencies typically stem from judicial resolution of two primary elements needed to make out a *prima facie* claim under the Lanham Act: (1) a showing that the plaintiff possesses a protectable mark;⁹⁸ and (2) a likelihood that the defendant's activities making use of the same or similar mark create confusion among consumers as to sponsorship, affiliation, or endorsement.⁹⁹ In both assessing the existence of a protectable mark and determining the likelihood of consumer confusion, courts have embraced seemingly paradoxical positions.

On the first matter, to prevail in a claim of false endorsement, performers must point to some protectable, source-identifying mark that they own.¹⁰⁰ Courts must therefore wrestle with the issue of what qualifies as a protectable mark.¹⁰¹ In answering this question, the case law is both mixed and muddled. On one hand, courts have held that "signature performances" are not, at present, protectable. Accordingly, in *Oliveria v. Frito-Lay, Inc.*, Astrud Gilberto could not seek Lanham Act relief for the unauthorized use of her signature performance of "The Girl from Ipanema" in an advertisement for Baked Lay's potato chips.¹⁰²

96. See *Henley*, 733 F. Supp. 2d at 1162 ("The Defendants' primary argument is that there is no market for licensed use of the works because the Plaintiffs refuse to license their works.").

97. See Sheffner, *supra* note 95 (characterizing the suit, in Henley's own words as "simply a matter of my copyrights being violated by music being used in a way it was never intended to be used").

98. See *Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1215 (10th Cir. 2004); *Packman v. Chicago Tribune Co.*, 267 F.3d 628, 638 (7th Cir. 2001); see also 15 U.S.C. § 1125 (2012).

99. See *Donchez*, 392 F.3d at 1215; *Packman*, 267 F.3d at 638; see also 15 U.S.C. § 1125.

100. See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1106 (9th Cir. 1992) ("[C]ourts have recognized false endorsement claims brought by plaintiffs, including celebrities, for the unauthorized imitation of their distinctive attributes, where those attributes amount to an unregistered commercial 'trademark.'") (citation omitted).

101. See, e.g., *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 61–63 (2d Cir. 2001).

102. See *id.* The court did caution that "[w]e cannot say it would be unthinkable for the trademark law to accord to a performing artist a trademark or service mark in her signature performance," but suggested that this was a matter best left to Congress, if it so chose to amend the Lanham Act, not for the courts. See *id.* at 62–63.

Significantly, the US Court of Appeals for the Second Circuit noted that, “Gilberto has not cited a single precedent throughout the history of trademark supporting the notion that a performing artist acquires a trademark or service mark signifying herself in a recording of her own famous performance.”¹⁰³ Similarly, Don Henley could not seek Lanham-Act relief for the unauthorized use of the music from his songs by a political candidate.¹⁰⁴

On the other hand, while signature performances are apparently not capable of protection (no matter how distinctive or famous), certain non-vocal actions apparently can be—such as a blonde donning a gown and jewels while turning large game-show letters¹⁰⁵ or burly middle-aged gentlemen drinking beer at the end of bar.¹⁰⁶ Thus, in defining Vanna White’s mark as her “persona” as a letter flipper,¹⁰⁷ the Ninth Circuit famously allowed the game show hostess to proceed to trial on a trademark claim,¹⁰⁸ which she brought against Samsung for a satirical advertisement featuring a futuristic world where a blonde-wigged robot would turn illuminated alphabetic cubes in her stead.¹⁰⁹ And in defining the relevant mark as composed of their “unique physical characteristics” (while seated at the end of a bar, presumably),¹¹⁰ the Ninth Circuit allowed actors George Wendt and John Ratzenberger to move forward to a jury with a false endorsement claim for the use of animatronic robotic figures based on their Norm and Cliff characters in a series of bars modeled after the set from the television show *Cheers*.¹¹¹ Interestingly, neither holding fully addressed why, even if there were valid marks in the cases, those marks should belong to Vanna White, George Wendt, and John Ratzenberger

103. *Id.* It should be noted that the court did vacate the dismissal of Gilberto’s state law claim for unfair competition. *Id.* at 64. However, the grounds for vacating the dismissal were based on the district court’s incorrect reading of the Complaint to admit that Gilberto had placed her recording of the song in the public domain. *Id.* at 63. The court also vacated the dismissal of Gilberto’s state law claim for a right of publicity violation on the same basis. *Id.* at 64. As such, there was no independent analysis given to the state law unfair competition claim as compared to the right of publicity claim (or the Lanham Act claim).

104. *Henley*, 733 F. Supp. 2d at 1169.

105. *See White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1401 (9th Cir. 1992).

106. *See Wendt v. Host Int’l, Inc.*, 197 F.3d 1284, 1286 (9th Cir. 1999).

107. *White*, 971 F.2d at 1400.

108. *Id.* at 1401. She also brought, and was allowed to proceed on, a common-law right of publicity claim. *See id.* at 1399.

109. *See id.* at 1396, 1401.

110. *See Wendt v. Host Int’l, Inc.*, 125 F.3d 806, 812 (9th Cir. 1997) (discussing appellants’ claim that “by using an imitation of their unique physical characteristics, Host misrepresented their association with and endorsement of the Cheers bars concept”).

111. *Id.* at 814. They also sued for violation of their statutory and common-law rights of publicity. *Id.* at 809. The Ninth Circuit reversed the district court’s grant of summary judgment to the defendants on the false endorsement claim. *Id.* at 809, 814.

and not the rights holders of their respective television programs. The courts also failed to explain what was so distinctive about a blonde woman turning letters or a burly middle-aged man sitting at the end of a bar drinking a beer.

Meanwhile, voices, but not signature performances, have received protection so long as they are sufficiently famous and distinctive.¹¹² Thus, Tom Waits could theoretically recover damages under the Lanham Act when Doritos used a sound-alike in one of their advertisements,¹¹³ and Bette Midler could recover (albeit under California tort law) for similar actions by Ford.¹¹⁴ Such decisions are particularly unusual since voices are largely functional and granting a limited trademark monopoly in them potentially threatens a range of expressive behavior. The use of an especially raspy singing voice in a commercial, for example, becomes all the more dangerous in the wake of the *Waits* ruling.¹¹⁵ Moreover, it is strange to consider that, while Astrud Gilberto could not bring a Lanham Act claim for the *actual* use of her voice,¹¹⁶ Bette Midler and Tom Waits could bring similar claims for *imitations*.¹¹⁷ Yet even on the imitation front, the case law is inconsistent. The Ninth Circuit held that Nancy Sinatra could not seek relief for the unauthorized imitation of her performance and vocal styling in “These Boots Are Made for Walking” used in a Goodyear advertisement.¹¹⁸ The same court, however, had no problem granting such relief to Bette Midler and Tom Waits,¹¹⁹ all while failing to overrule or fully distinguish the *Sinatra* decision.¹²⁰ All told, “signature

112. See, e.g., *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1098–99 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460, 463–64 (9th Cir. 1988). *Waits* and *Midler* set up the requirement that such protection only extends to voices that are sufficiently “distinctive” and “widely known.” See *Waits*, 978 F.2d at 1099–1103 (upholding jury instructions to this effect).

113. *Waits*, 978 F.2d at 1112 (noting both that the jury could award damages under the Lanham Act and that they were duplicative to the damages for voice misappropriation).

114. See *Midler*, 849 F.2d at 463–64.

115. See *Waits*, 978 F.2d at 1096.

116. *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 62–63 (2d Cir. 2001).

117. Zachary Vaughan has discussed this paradox with respect to right of publicity decisions seeking to vindicate performers’ rights. See Vaughan, *supra* note 35, at 695, 710–15 (arguing that “this apparent paradox is actually no conflict at all”).

118. See *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 716–18 (9th Cir. 1970) (affirming summary judgment against Nancy Sinatra on her state law “passing-off” claim where defendants used an imitation of her song).

119. *Midler*, 849 F.2d at 463–64; *Waits*, 978 F.2d at 1096. Of course, *Waits* granted such relief on Lanham Act grounds as well as California common law while *Midler* granted relief on the former but never considered the latter since the plaintiff was denied the opportunity to amend her complaint to include a Lanham Act claim. See *Waits*, 978 F.2d at 1110, n.10 (describing the procedural history of *Midler*).

120. The *Waits* court does discuss the *Sinatra* case briefly in the context of a string cite, and claims in the parenthetical that the *Sinatra* court found that Nancy’s voice was not “sufficiently unique to be protectable.” *Waits*, 978 F.2d at 1107. Yet it does not appear that the

vocal performances” do not receive protection under the Lanham Act, but non-vocal actions and voices sometimes can—both under Lanham Act and state common law claims.

The courts’ analyses in likelihood-of-confusion determinations—a standard that bridges Lanham Act and state law claims¹²¹—have been similarly difficult to decipher. Courts have allowed the likes of Vanna White, George Wendt, and Tom Waits to prevail on false endorsement claims for the unauthorized use of their persona or vocal stylings but have rejected the viability of such relief in other cases.¹²² Courts have reasoned that even if the plaintiff’s performance establishes a protectable mark, they must deny relief because there is no reasonable basis to conclude a likelihood of consumer confusion.¹²³ Again, a principled basis to distinguish differing case outcomes is not readily forthcoming. For example, in *Storball v. Twentieth Century Fox Film Corp.*, Fox used The Capitols’ ditty “Cool Jerk” in two movies—*Home Alone 2* and *Night and the City*—and related advertising.¹²⁴ Fox had presumably obtained the appropriate copyright licenses for the use, so the plaintiffs were left only with a suit for false endorsement, claiming that Fox’s use created a “misrepresentation of The Capitol[s]’ affiliation with and endorsement

Sinatra court made any such finding. In fact, the *Sinatra* decision notes that: “In this case appellant’s complaint is not that her sound is uniquely personal; it is that the sound in connection with the music, lyrics and arrangement, which made her the subject of popular identification, ought to be protected.” *Sinatra*, 435 F.2d at 716. Furthermore, it is worth noting that, at the time of their respective lawsuits, Nancy Sinatra and her works were every bit as famous as (perhaps more than) Tom Waits and his works. See *About*, NANCY SINATRA, <http://nancysinatra.com/about.html> (last visited Aug. 1, 2013). Furthermore, the *Waits* court never clarified just what is needed to make vocal styling sufficiently distinctive to be given protection and why Sinatra’s performance did not rise to that level of sufficient distinctiveness. The *Midler* court, by contrast, distinguishes *Sinatra* on the grounds that Sinatra sought to protect the particular song and arrangement—creatures of copyright protection—whereas Midler sought to protect just her voice—something outside of the scope of authorship and beyond the subject matter of copyright. *Midler*, 849 F.2d at 462. However, this does not explain why the *Sinatra* court did not recognize Sinatra’s voice, by itself, as sufficiently distinctive and widely known to qualify for protection. It is also worth noting that, in the *Sinatra* case, the court explicitly wrestled with the issue of whether recognition of a false endorsement claim would effectively impinge on the functioning of the federal copyright regime. *Sinatra*, 435 F.2d at 717–18. It concluded that it would. *Id.* Neither the *Waits* nor *Midler* decisions gave any weight to such an argument.

121. See, e.g., *Brown v. Twentieth Century Fox Film Corp.*, 799 F. Supp. 166, 173 (D.D.C. 1992).

122. See *supra* note 118 and accompanying text.

123. See, e.g., *Brown*, 799 F. Supp. at 173 (applying the reasonable jury standard in granting defendant’s motion for summary judgment); *Storball v. Twentieth Century Fox Film Corp.*, No. CV 93–2745 RMT (Tx), 1993 WL 734117, at *1 (C.D. Cal. Nov. 8, 1993) (“[N]o reasonable jury could find such use of the sound recording to be sufficient to support the finding of confusion or likelihood of confusion. As a result, defendant Fox is entitled to summary judgment on the Lanham Act claims.”).

124. *Storball*, 1993 WL 734117, at *1.

of defendant's goods."¹²⁵ The court summarily rejected the claim, stating in broad terms that the "[m]ere use of a sound recording in a motion picture of audiovisual presentation, with truthful attribution of the performance to the performers in the credits, does not constitute a representation that the performers in the sound recording approve, sponsor, or endorse the motion picture."¹²⁶

Musician James Brown also lost a similar suit against Twentieth Century Fox when the movie *The Commitments* featured his famous performance of the song "Please, Please, Please" from the T.A.M.I. show in 1965.¹²⁷ In a key scene in the movie, Jimmy, the leader of the eponymous band, tries to inspire his mates towards more dynamic musicianship by showing them the clip of Brown.¹²⁸ The defendants had obtained a license from the copyright holders to the T.A.M.I. show recording for use of the footage.¹²⁹ They also obtained a license from the copyright holder of the musical composition and lyrics for the use.¹³⁰ Nevertheless, Brown believed the filmmakers also needed his permission for the use of the footage, especially for its exploitation in the marketing of the film, and he sued for false endorsement under the Lanham Act.¹³¹ The court dispensed with the Lanham Act claim on summary judgment with a single line: "[T]here is no evidence whatsoever that any viewers of *The Commitments* believed that plaintiff had endorsed the film or personally approved the use of the clip, nor could any reasonable jury reach that conclusion from watching the film."¹³²

Yet courts in the *Wendt*, *White*, and *Waits* cases had no problem finding that a likelihood of confusion could have resulted from satirical (in the case of *White*)¹³³ or imitative (in the cases of *Wendt* and *Waits*)¹³⁴

125. *Id.*

126. *Id.*; see also, e.g., *Philadelphia Orchestra Ass'n v. Walt Disney Co.*, 821 F. Supp. 341, 350–51 (E.D. Penn. 1993) (finding that plaintiff failed to establish "that Disney represented that [plaintiff] endorsed the home video" and "failed to prove that Disney violated the Lanham Act by releasing home videos which correctly credited the [plaintiff] for the performance").

127. *Brown*, 799 F. Supp. at 173.

128. See *id.* at 168.

129. *Id.* at 172.

130. *Id.* at 169.

131. *Id.* at 173.

132. *Id.*

133. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1401 (9th Cir 1992) ("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 . . . was endorsing Samsung products.").

134. See *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 813–14 (9th Cir. 1997) (concluding that "[a] reasonable jury could conclude that . . . Host's alleged conduct creates at least the likelihood of consumer confusion," and "[s]ufficient evidence exists by which a reasonable jury might infer actual consumer confusion"); *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (holding

uses of performance personas. If anything, the logic might go the other way. Presumably, an ordinary person is far less likely to understand a commercial's satirical use of a blonde, letter-turning robot as having White's sponsorship, approval, or endorsement than actual footage of White in the same advertisement. As for imitations, at least they are just that; the better the imitation, one would think, the closer it comes to being as bad as a use of the original without permission. But it is difficult to imagine how use of an imitation without permission is actually *worse* than use of the original itself, especially from the likelihood-of-confusion perspective. One could attempt to reconcile these various holdings by arguing that the imitation cases involved the use of physical characteristics (*Wendt*) or vocal stylings (*Waits*) that, because of their unauthored or unfixed natures, respectively, fall outside of the subject matter of copyright.¹³⁵ By contrast, the actual voices or performances used in the *Brown* and *Storball* cases were fixed in a tangible medium and therefore already within the scope of copyright. But such a consideration makes more sense for an analysis of a state-based right (like the right of publicity), which is subject to express federal pre-emption defenses.¹³⁶ And while recognition of such performer rights raises legitimate concerns about interfering with the flow of commerce and the licensing of copyrighted works, the same concerns are present when dealing with unauthorized imitations of a "mark" as opposed to unauthorized uses of the actual "mark."

Indeed, courts have (rightfully) bristled at recognizing such protection for "performance rights" under the Lanham Act because such an overture would necessarily interfere with the functioning of the market for copyrighted works and burden—if not actively undermine—the federal copyright regime as a whole. As the Second Circuit noted in the *Oliveira* case involving "The Girl from Ipanema," if courts acknowledged such a right,

Numerous artists who could assert claims similar to Gilberto's would bring suit against entities that had paid bona fide license fees to all known holders of rights. Indeed, artists who had licensed users under their copyrights and had received fees for the copyright

that "when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California," and finding that "[a] singer manifests herself in the song[and to] impersonate her voice is to pirate her identity"); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1111 (9th Cir. 1992) (stating that at trial the jury listened to recordings, heard evidence relevant to the likelihood of confusion and evidence of actual consumer confusion and "[t]his evidence was sufficient to support the jury's finding that consumers were likely to be misled by the commercial into believing that Waits endorsed SalsaRio Doritos").

135. See 17 U.S.C. § 102(a) (2012) (limiting copyright protection to "original works of authorship fixed in any tangible medium of expression").

136. See 17 U.S.C. § 301 (2012); see also *Ahn v. Midway Mfg., Co.*, 965 F. Supp. 1134, 1137 (N.D. Ill. 1997); *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 649–50 (Ct. App. 1996).

license could bring suits claiming additional compensation for infringement of trademark rights. Immense unforeseen liabilities might accrue, upsetting reasonable commercial expectations.¹³⁷

The *Henley* court adopted the same logic, claiming that a contrary ruling, which necessarily would create a new species of trademark rights, “would be profoundly disruptive to commerce.”¹³⁸ And the *Sinatra* court bristled at the plaintiff’s unfair competition claim because, among other things, the defendants “had paid a very substantial sum to the copyright proprietor to obtain the license for the use of the song and all of its arrangements.”¹³⁹ The wariness to grant Lanham Act or related state common law relief to vindicate performance rights makes eminent sense, and yet, many courts have failed to even address this issue. For example, such a concern did not alarm the courts in the Bette Midler and George Wendt disputes. After all, in the former case, Ford and its advertising agency, Young & Rubicam, had secured the rights to use Bette Midler’s “Do You Want to Dance?” from the musical composition’s copyright holder for use in their “Yuppie Campaign” for Lincoln Mercury.¹⁴⁰ And in the latter case, Host International had secured the rights to use *Cheers*’s intellectual property for its airport restaurants.¹⁴¹

To be fair, the recognition of any “new” intellectual property right always upsets commercial expectations and creates a new layer of licensing requirements that did not previously exist. This undoubtedly occurred, to take a few examples, when courts began to recognize the derivative-rights doctrine,¹⁴² expanded copyright protection to extend to non-literal elements of works,¹⁴³ or effectively created the right of publicity from privacy law through the latter part of the twentieth century.¹⁴⁴ Each of these innovations (or abominable forms of rights

137. *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 63 (2d Cir. 2001).

138. *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1168 (C.D. Cal. 2010) (citing *Oliveira*, 251 F.3d at 63).

139. *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 717 (9th Cir.1970).

140. *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) (“Young & Rubicam had a license from the copyright holder to use the song. At issue in this case is only the protection of Midler’s voice.”).

141. See *Wendt v. Host Int’l, Inc.*, 125 F.3d 806 (9th Cir.1997).

142. See *Daly v. Palmer*, 6 F. Cas. 1132 (C.C.S.D.N.Y. 1868) (No. 3,552) (extending copyright protection to derivative works, a position that was later codified by statute).

143. See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (stating that copyright “cannot be limited literally to the text, else a plagiarist would escape by immaterial variations”).

144. The right of publicity, of course, emerged from the right of privacy famously discussed by Warren and Brandeis. See Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890); see also William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383 (1960); Jeff Sanders, *By Force of Persona: How the Right of Publicity Undermines the First Amendment*, 28 BEVERLY HILLS B. ASS’N J. 13 (1994). By the middle of the twentieth century, the right of publicity

accretion,¹⁴⁵ depending on your perspective) triggered claims by new rights holders for additional compensation for existing practices. Yet there is good reason to think that extension of protection for performance rights under the Lanham Act and related state law would have a particularly pernicious effect. Consider the tumultuous result such protection might have on the PRO regime, which, despite all of its problems, solves a huge economies-of-scale issue and manages to provide songwriters around the world with regular royalty payments. The functioning of the PRO regime, which accumulates millions of micropayments, depends on the elimination of transaction costs through the grant of blanket licenses for the public performance of musical compositions.

If trademark liability could follow public performance of copyrighted works, the delicate balance of the PRO regime could suffer. In such a world, one might legitimately wonder whether The Red Hot Chili Peppers, famously die-hard Lakers fans, might have a colorable false endorsement claim any time their basketball arch-nemesis, the Boston Celtics, played “Give It Away” at their home games. If such actions could give rise to liability under the Lanham Act, the TD Garden and the Boston Celtics could face liability for playing the song even though they possess the appropriate public performance license to do so. John (Cougar) Mellencamp—an all-American car kind of guy (and Chevy pitchman to boot)¹⁴⁶—might have claims against the airing of his songs as background music at Toyota corporation headquarters or at any arena named after a foreign motor company, such as the Honda Center in Anaheim, the Mercedes-Benz Superdome in New Orleans, or the Toyota Center in Houston. Or Metallica may take legal action if someone (other than Mariano Rivera, who apparently had the band’s blessing)¹⁴⁷ comes out to close a ballgame (in a licensed stadium) to the menacing rhythms of “Enter Sandman.” Suddenly, anyone with a BMI

began to represent a distinct tort in its own right. See *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (recognizing, for the first time, the “right of publicity” as an independent and distinct tort). *But see Strickler v. Nat’l Broad. Co.*, 167 F. Supp. 68, 70 (S.D. Cal. 1958) (holding that “[t]his court does not feel it wishes to blaze the trail to establish in California a cause of action based upon the right of publicity”).

145. See, e.g., James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 YALE L.J. 882, 885–86 (2007); David Fagundes, *Crystals in the Public Domain*, 50 B.C. L. REV. 139, 153 (2009).

146. See David Carr, *American Tragedies, to Sell Trucks*, N.Y. TIMES (Oct. 30, 2006), <http://www.nytimes.com/2006/10/30/business/media/30carr.html>; Alan Light, *Changes in Mellencamp Country*, N.Y. TIMES (Jan. 22, 2007), http://www.nytimes.com/2007/01/22/arts/music/22mell.html?_r=0.

147. See RJ Cubarrubia, *Metallica Play ‘Enter Sandman’ for Mariano Rivera*, ROLLING STONE (Sept. 23, 2013, 11:10 AM), <http://www.rollingstone.com/music/videos/metallica-play-enter-sandman-for-mariano-rivera-20130923>. From 1999 until retirement, Yankees great Rivera entered games in the ninth inning to the tune blasting through Yankee Stadium. *Id.*

or ASCAP license could face liability for false endorsement when playing songs. The unleashing of such a slippery slope of liability would call into question the entire value of the public performance license and potentially undermine the PRO regime as a whole.

Furthermore, although the extension of rights always threatens to disrupt commercial expectations and the flow of commerce, the implications are particularly serious if courts were to allow the vindication of performer rights through the Lanham Act. Specifically, the extension of trademark protection to certain aspects of performance such as voice raises serious *Dastar*-like concerns.¹⁴⁸ In *Dastar*, the Supreme Court rejected an attempted by Fox to use a Lanham Act claim for false designation of origin as a means of preventing *Dastar*'s reproduction of an audiovisual work (to which Fox had previously owned the copyright) that had fallen into the public domain.¹⁴⁹ In so holding, the Court warned against the risk of creating a "species of mutant" intellectual property protection that would impede the public's right to make unfettered use of creative works that no longer enjoy copyright protection.¹⁵⁰

The recognition of performer rights through the Lanham Act is equally problematic. Both according to statute and under the Constitution's Copyright Clause, creative works such as sound recordings must eventually fall into the public domain.¹⁵¹ When they do, threats of trademark liability could severely diminish the use of formerly-copyrighted sound recordings if courts recognize a trademark right in the performer's voice or other aspects of a performance. Thus, precedent that establishes the availability of such relief under the Lanham Act could create serious impediments to legitimate rights of public access to creative works whose copyright terms have expired. Long before *Dastar*, Judge Learned Hand recognized this problem.¹⁵² In a 1955 dissent in a suit between Capitol and Mercury records,¹⁵³ he cautioned against the use of unfair-competition law to grant copyright-like protection that would "grant to an author a perpetual monopoly" over works in a way that would circumvent their eventual and proper

148. See *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003).

149. *Id.* at 23.

150. *Id.* at 34.

151. U.S. CONST. art. I, § 8, cl. 8 ("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." (emphasis added)); 17 U.S.C. § 302 (2012).

152. See *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 664–68 (2d Cir. 1955) (Hand, J., dissenting).

153. *Id.*

dedication to the public domain.¹⁵⁴ Thus, it is not just reasonable investment-backed expectations and commerce that suffer but also rights of public access to creative works and the exercise of First Amendment rights based thereon.

Indeed, courts have increasingly recognized the profound speech interests implicated in the unauthorized exploitation of others' trademarks,¹⁵⁵ as the use of marks can play an important role in the formation and expression of personhood, the sharing of social bonds, and the dissemination of culturally coded communications.¹⁵⁶ Consider Samsung's satirical 1990 advertisement about an evolving future (2012 A.D.) in which everything—except its own product—will have changed.¹⁵⁷ It makes eminent creative sense that the advertiser would reference Vanna White, the hostess of one of the most popular game shows of the era, as she had taken on Barbie-like symbolism,¹⁵⁸ epitomizing the beloved, quintessential all-American female.¹⁵⁹ Thus, the use of the Vanna “persona” helped convey—both efficiently and humorously—the idea that Samsung would still be around in the future, despite everything else changing.¹⁶⁰ After all, even the adored all-American beauty had been replaced with a blonde-wigged, gowned, and bejeweled robot turning letters.¹⁶¹ The use of a robotized symbol recognizable to most Americans, such as the Vanna “persona,” was an important part of the success of the communication (and the advertisement).¹⁶²

While the *White* court failed to appreciate these interests weighing in favor of Samsung, a famous dissent by Judge Kozinski from

154. *Id.* at 666–67; *see also* *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 718 (9th Cir. 1970) (noting Hand's concern over “allow[ing] unfair competition protection where Congress has not given federal protection is in effect granting state copyright benefits without the federal limitations of time to permit definite public domain use”).

155. *See* Bartholomew & Tehranian, *supra* note 39, at 6 (2013).

156. *See* Mark Bartholomew, *Advertising and Social Identity*, 58 BUFF. L. REV. 931, 941–42 (2010); John Tehranian, *Parchment, Pixels, & Personhood: User Rights and the IP (Identity Politics) of IP (Intellectual Property)*, 82 U. COLO. L. REV. 1, 28–29, 83 (2011).

157. *See* *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1514 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc).

158. Not coincidentally, in the early 1990's, White had released her own line of Barbie-like dolls. *See Short Takes: Look-Alike Vanna White Doll*, L.A. TIMES (Oct. 31, 1990), http://articles.latimes.com/1990-10-31/entertainment/ca-3485_1_vanna-white; *\$Vanna White 1990 Limited Edition Home Shopping Club Doll*, ZIMBIO (Apr. 3, 2013), <http://www.zimbio.com/Vanna+White/articles/qjInHuIN-jT/Vanna+White+1990+Limited+Edition+Home+Shopping>.

159. A popular song of the time, *Vanna, Pick Me a Letter*, was an unabashed ode to her. Patrick Goldstein, *Calendar Desk*, L.A. TIMES, Mar. 15, 1987, at 65 (characterizing *Vanna, Pick me a Letter* as a “big novelty hit” by Dr. David Kolin).

160. *See White*, 989 F.2d at 1514.

161. *See id.*

162. *See id.* Indeed, making the association to Vanna White, in her capacity as *Wheel of Fortune* hostess, constituted a part of the speech itself. *See id.*

the Ninth Circuit's denial of a rehearing *en banc* brought attention to the First Amendment issues given short shrift by the holding.¹⁶³ Just a decade later, in a suit involving references to the real Barbie in the song "Barbie Girl" by the Danish band, Aqua, Kozinski led the Ninth Circuit to formal adoption of a defense that recognized the important expressive interests at play in the unauthorized use of others' trademarks.¹⁶⁴

That defense, based on the Second Circuit's *Rogers v. Grimaldi* case,¹⁶⁵ has served as a powerful First Amendment limitation on the exertion of trademark rights in recent years.¹⁶⁶ Under the test, so long as a trademark utilized in a creative endeavor has artistic relevance—in the words of the Ninth Circuit, "the level of relevance

163. *Id.* at 1513 (denouncing the decision as "a classic case of overprotection. Concerned about what it sees as a wrong done to Vanna White, the panel majority erects a property right of remarkable and dangerous breadth. . . . This Orwellian notion withdraws far more from the public domain than prudence and common sense allow. . . . It raises serious First Amendment problems. It's bad law, and it deserves a long, hard second look.").

164. *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 899 (9th Cir. 2002). Not all courts have applied the *Rogers* test to recent false endorsement claims brought by performers; but many of those courts have conducted their own independent balancing of the First Amendment with trademark rights. For example, when Lady Miss Kier of the band Deee-Lite sued Sega under the Lanham Act for featuring a character, Ulala, that bore all too much of a resemblance to her and her retro-disco-funk performance 'persona,' a trial court and state appellate court rejected the claim (among others) on free speech grounds. *See Kirby v. Sega of Am., Inc.*, 50 Cal. Rptr. 3d 607, 608–09 (Ct. App. 2006). The court admitted that there were significant similarities between Ulala and Kier's persona and, to make matters worse for the defendant, that Sega had originally sought Kier's endorsement, thereby indicating their intention to base the character on her. *See id.* at 610, 613. But the court nevertheless concluded that "given the many dissimilarities between the Ulala character and Kirby, any public confusion arising from a mistaken assumption is easily outweighed by the public interest in free artistic expression, so as to preclude application of the Lanham Act." *Id.* at 618.

165. 875 F.2d 994, 999 (2d Cir. 1989). For an in-depth discussion of the background to *Rogers v. Grimaldi* and the origins of the defense, see Mark Bartholomew & John Tehranian, *From Debbie Does Dallas to The Hangover: The Changing Landscape of Trademark Law in Tinseltown*, in *HOLLYWOOD AND THE LAW* (Paul McDonald, Eric Hoyt, Emily Carman, and Philip Drake eds., forthcoming 2014).

166. *See Bartholomew & Tehranian, supra* note 39, at 51 ("The *Rogers* test represents a significant prospeech innovation in trademark law, permitting both uses that may confuse consumers and uses for which alternative mechanisms are available for making a similar expressive point."). While *Rogers* initially applied to the use of trademarks in titles to creative works, it has expanded to uses of trademarks within creative works as well. *See, e.g., E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) ("Although [the *Rogers*] test traditionally applies to uses of a trademark in the title of an artistic work, there is no principled reason why it ought not also apply to the use of a trademark in the body of the work."); *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 936–37 (6th Cir. 2003) (holding that a defendant's use of Tiger Woods's likeness in a painting entitled *Masters of Augusta* was entitled to First Amendment protections under the *Rogers* test); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp.*, 886 F.2d 490, 495 (2d Cir. 1989) (holding that "the *Rogers* balancing approach is generally applicable to Lanham Act claims against works of artistic expression, a category that includes parody").

merely must be above zero”¹⁶⁷—the use cannot be infringing unless it “explicitly misleads as to the source or the content of the work.”¹⁶⁸ In other words, absent “particularly compelling” evidence of a likelihood of confusion,¹⁶⁹ there is no infringement. The *Rogers* test did not come to life and gain widespread acceptance until after such cases as *White*, *Waits*, and *Wendt*.¹⁷⁰ But it would appear, at first blush, to provide a potent defense against Lanham Act claims grounded in performer rights. After all, campaign commercials and product advertisements certainly have strong expressive and creative components and, therefore, qualify as forms of speech.

Some courts, however, have deemed commercial speech—no matter how steeped in artistic expression—ineligible for the *Rogers* defense. A recent decision, *Facenda v. N.F.L. Films*,¹⁷¹ is illustrative in that it expressly denied a *Rogers* defense for the National Football League (NFL) when it used, without authorization, the voice of legendary sports announcer John Facenda in its twenty-two minute film *The Making of Madden NFL 06*.¹⁷² Facenda is the legendary “Voice of God” from NFL Films fame.¹⁷³ Shortly before his death, Facenda had provided the NFL with a broad release allowing them to exploit his audio recordings in any way, so long as the use did not “constitute an endorsement of any product or service.”¹⁷⁴ Facenda’s estate raised a trademark claim for false endorsement, contending that fans hearing his voice on the film would assume that he had lent his approval to the film and the videogame it was describing, *John Madden Football*.¹⁷⁵ The NFL maintained that its periodic use of Facenda’s voice represented an artistic choice for a documentary film, not an effort to confuse consumers as to endorsement or sponsorship.¹⁷⁶ The court rejected this argument, explaining that the NFL’s “economic motivation” rendered the film commercial speech.¹⁷⁷ Because no one in the film had anything negative to say about the videogame—in the style of a hagiography, it served as an unabashed celebration of the work and its making—the court did not believe the film had a “documentary

167. *Rock Star Videos*, 547 F.3d at 1099.

168. *Rogers*, 875 F.2d at 999.

169. See, e.g., *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664–65 (5th Cir. 2000); *Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993).

170. *Rogers* itself was only decided in 1989. See *Rogers*, 875 F.2d at 994.

171. 542 F.3d 1007, 1018 (3d Cir. 2008).

172. *Id.*

173. *Id.* at 1011–12.

174. *Id.* at 1022 (quoting release language).

175. See *id.* at 1024–25.

176. *Id.* at 1016.

177. *Id.* at 1017–18.

purpose.”¹⁷⁸ In the end, therefore, the court concluded the documentary only served as an advertisement for the Madden videogame.¹⁷⁹ The court consequently deemed the use commercial due to its fundamentally promotional purpose and held that the NFL could not take advantage of the *Rogers* defense.¹⁸⁰

Yet patrolling a line between commercial and noncommercial forms of artistic expression is problematic. As Judge Kozinski noted: “In our pop culture, where salesmanship must be entertaining and entertainment must sell, the line between the commercial and noncommercial has not merely blurred; it has disappeared.”¹⁸¹ And the implications of the holdings in such advertisement or commercial-related exploitation cases as *Midler*, *Waits*, and *Wendt* are troubling for free speech. As Jennifer Rothman has argued, the *Midler* and *Waits* decisions have the potential to stifle a wide range of musical expression. Under the holding of *Midler*, “Celine Dion could be barred from performing or recording ‘Memories,’ a song made famous by Barbra Streisand, because Dion’s voice is similar enough to Streisand’s that her rendition might be deemed a ‘sound-alike.’”¹⁸² This is particularly problematic because the compulsory mechanical license available under section 114 of the Copyright Act expressly gives Dion (or anyone else) the right to do a cover version of “Memories” or any other published musical composition.¹⁸³ Meanwhile, “[u]nder the logic of *Waits*, Billie Holiday’s estate could sue pop singer Macy Gray, who has a similar vocal lilt and style to Holiday, even if Gray did not sing any songs made famous by Holiday.”¹⁸⁴ And under the reasoning from *Wendt*, show creators (and copyright holders) may risk liability if they replace actors on programs with ones with similar physical characteristics.¹⁸⁵ All of these liability fears stifle creative freedoms and limit the scope of acceptable expressive activities.

178. *Id.* at 1018.

179. *Id.* at 1017.

180. *Id.* at 1017–18; *see also* Louis Vuitton Malletier, S.A. v. Hyundai Motor Am., No. 10 Civ. 1611(PKC), 2012 WL 1022247, at *19–20 (S.D.N.Y. Mar. 22, 2012) (failing to even consider a *Rogers* defense in granting summary judgment to Louis Vuitton on claims of trademark dilution for Hyundai’s one-second shot of a basketball with a pattern suggestive of Louis Vuitton’s monogram in a Super Bowl advertisement); Dillinger, LLC v. Elec. Arts Inc., No. 1:09-cv-1236-JMS-DKL, 2011 WL 2457678, at *4 n.1 (S.D. Ind. June 16, 2011) (describing *Rogers* test as interrogating “intentional use of another’s intellectual property for commercial profit”).

181. *But see* *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1520 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc).

182. *Id.* (citations omitted).

183. 17 U.S.C. § 114 (2012).

184. Rothman, *supra* note 35, at 221 (footnote omitted).

185. *See* *Wendt v. Host Int’l, Inc.*, 197 F.3d 1284, 1286–87 (9th Cir. 1999) (Kozinski, J., dissenting from denial of rehearing en banc) (warning that, under the logic of the *Wendt* decision, individuals such as Wayne Knight, the actor who played Newman in the comedy *Seinfeld*, might

Given the significant complications weighing against the grant of Lanham Act relief to performers, one can certainly wonder why courts have occasionally gone down the primrose path to liability at plaintiffs' behests. Without getting too dramatic, as the old saw goes, the road to hell is paved with good intentions; or to quote an ancient legal maxim: hard facts frequently make bad law.¹⁸⁶ Many of these cases include sympathetic plaintiffs who are otherwise not entitled to any compensation for the use of an intangible thing to which they have given value, often through a lifetime of hard work. In particular, the performance rights cases recognizing Lanham Act and related state law violations may be driven by the inequities of the extant copyright regime, which has historically failed to provide performers (and sound-recording copyright holders) any kind of remuneration for the non-digital public performance of their works¹⁸⁷ and, more generally, has historically denied pure performers any sort of copyright interests in creative works.¹⁸⁸

Consider the *Midler* case, for example.¹⁸⁹ In that case, there was an inescapable sense that the defendants have illicitly usurped at least something of value from the performer. To make matters worse, *just about everyone except the performer* appeared to be making money from the subject matter of the suit. Indeed, the optics of the case were not favorable to the defendants, who had initially wanted Midler to record the song for them for use in the advertisement at issue.¹⁹⁰ When she refused, on the grounds that she never did commercials, they instead hired a Midler imitator (and former Midler backup singer, to add insult to injury).¹⁹¹ So Ford and Young & Rubicam enjoyed a profitable advertising campaign that succeeded in no small part because of the associational value that Midler had given to the spot's soundtrack, Midler's backup singer received a nice pay day, and the composers of

have a claim against the show creators if they created a spin-off program named *Kramer* and cast another portly man to assume the Newman role).

186. Judge Rolfe is typically cited as the first jurist to memorialize this principle. He did so in *Winterbottom v. Wright*, (1842) 152 Eng. Rep. 402; 10 M. & W. 109, when he observed that "[t]his is one of those unfortunate cases in which . . . no doubt, a hardship upon the plaintiff to be without a remedy, but by that consideration we ought not be influenced. Hard cases, it has been frequently observed, are apt to introduce bad law." *Id.* at 405–06.

187. See Digital Performance Right in Sound Recordings Act of 1995, Pub. L. No. 104-39, § 106(6), 109 Stat. 336, 336 (codified as amended at 17 U.S.C. § 106(6) (2012)) (amending the Act to include a public performance right for digital transmissions of sound recordings); 17 U.S.C. § 114(g)(2)(B) (2012) (splitting receipts between record labels and featured and non-featured performers).

188. See 17 U.S.C. § 106 (2012) (granting exclusive rights under the Copyright Act to the copyright holder); see also 17 U.S.C. § 201(b) (2012).

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

190. See *id.* at 461.

191. See *id.*

“Do You Want to Dance?” garnered a rich license.¹⁹² Though the lower court provocatively equated the conduct of the defendants with that of “the average thief,” it nevertheless granted summary judgment to the defendants because no legal theory appeared to provide relief for Midler.¹⁹³ The Ninth Circuit felt the same way about the defendants’ actions, reversed the district court, and revived the suit by recognizing a new theory for relief: “[W]hen a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort.”¹⁹⁴ The case went to trial and a jury awarded Midler \$400,000 in damages, a verdict ultimately affirmed by the Ninth Circuit.¹⁹⁵ In some ways, the *Waits* case was even worse.¹⁹⁶ There, Tom Waits did not even enjoy Midler’s opportunity to turn down the advertisers for the use of his actual voice.¹⁹⁷

These two cases appear compelling at first blush. The sense of injury is eminently relatable to most artists who have seen their works usurped for a purpose that is fundamentally at odds with their most passionate beliefs. Yet it is worth remembering that, in both cases, the advertisers would have preferred to use and pay the artists that eventually sued them in the first place; it was only because Midler and Waits had no interest in ever appearing in commercials that the advertisers went in a different direction.¹⁹⁸ Moreover, if we provide relief against voice imitators in such cases as *Midler* and *Waits*, one can reasonably ask why we do not provide relief to the individuals whose actual voices and performance persona are being used to hawk products—for example, in the Astrud Gilberto and James Brown cases. Any meritorious distinction is unlikely to come from a meaningfully different analysis on the likelihood of confusion.

To wit, if an imitation is so good that it sounds like an original, then the most skillful imitation can only become as injurious as the original—never worse. If the imitation is not skillful, people will recognize that it is not the actual performer, diminishing the likelihood of confusion. If the imitation is incredibly skillful, then the imitation

192. *See id.* at 461–62.

193. *Id.* at 462.

194. *Id.* at 463 (cautioning that “[w]e need not and do not go so far as to hold that every imitation of a voice to advertise merchandise is actionable,” although the only limitation it appeared to create on actionable vocal imitations was that the original voice be well known and distinctive).

195. *Midler v. Young & Rubicam Inc.*, 944 F.2d 909, 1991 WL 185170, at *1 (9th Cir. 1991) (unpublished table decision).

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

197. *Id.* at 1098 (explaining that Frito-Lay did not even bother asking Waits because “you never heard anybody say no so fast in your life”).

198. *See id.* at 1098; *Midler*, 849 F.2d at 461.

and the original sound the same to the audience and use of the imitation is just as injurious to the performer as use of the original would be. But in no instance is use of the imitation *more* injurious to the performer than use of the original.

There may be something else going on, however. Differences in the circumstances leading to the use of an imitator may have motivated courts to reach different decisions. In imitator cases, the defendants appear to be taking away from performers something that the performers have not explicitly or implicitly given away previously. In other words, while Midler and Waits may have waived rights to their performances as specifically embodied in certain sound recordings, they never gave away their actual personae—the raw material imitated by the specific advertisements at issue in the suits. Meanwhile, in cases making use of the plaintiff's actual voice, the defendant is directly exploiting something that the performers did, in fact, previously give away. In the *Oliveira* and *Brown* cases, for example, the defendants only made use of the exact persona as embodied in a recording to which the two performers had waived or assigned their rights.

But there does not appear to be good reason to rest the case law on such a distinction. In the *Midler* case, for example, the defendants could have simply used the original version of "Do You Want to Dance?" with Midler's vocals instead of recreating it with an imitation and, under the logic of *Oliveira*, would not have faced liability. Furthermore, the defendants had a license to use the sound recording for "Do You Want to Dance?" to prepare a derivative version (*i.e.*, the final advertisement).¹⁹⁹ The lack of separate liability for derivative versions of a work to the performer whose singing is embodied in the original work, however, undermines the function of the licensing market for copyrighted works. In *Waits*, the actual song used in the advertisement was one that had never been associated with or performed by Tom Waits.²⁰⁰ In fact, it was an original composition written for the spot itself.²⁰¹ As such, in the words of Jennifer Rothman, the court's holding effectively gave Waits "ownership of a masculine raspy singing style."²⁰²

As David Lange warned more than thirty years ago, each concession to a new intellectual property right ineluctably diminishes

199. See *Midler*, 1991 WL 185170, at *2 (noting that the defendant had the right to use the sound recording).

200. *Waits*, 978 F.2d at 1098.

201. See *id.* at 1101. Admittedly, however, the song was "inspired by" and tried to "capture the feeling of" Tom Waits's song "Step Right Up." *Id.* at 1097. Notably, however, copyright infringement was not at issue in the case. See *id.* at 1100.

202. Rothman, *supra* note 35, at 221.

the public domain.²⁰³ Granting additional protections to performers is therefore not without heavy costs. The privatization and propertization of performance tropes takes something away from all of us, including other performers.

IV. CONCLUSION: WHITHER PERFORMER RIGHTS?

Benjamin Kaplan once observed that “[n]umerous bills intended to secure a performer’s copyright have been introduced in Congress only to be aborted there, and courts are left to deal with the subject as a kind of stray of common-law copyright and ‘unfair competition.’”²⁰⁴ Although Kaplan wrote these words more than half a century ago, not much appears to have changed.²⁰⁵ Performers continue to enjoy little in the way of express statutory protections and courts have cobbled together occasional relief under a variety of intellectual property theories extending beyond statutory copyright. As sympathetic as a performer’s claims may be, the consequences of establishing liability under the Lanham Act through theories of false endorsement are dangerous and should give future courts great pause.

Three strong caveats bear mentioning, however. First, as discussed in Part I, the foregoing analysis is strictly limited to the use of the Lanham Act and related state law to vindicate performer rights. Litigants in such cases frequently raise alternate theories of liability, including those grounded in the right of publicity. Although there may be good reasons to scrutinize such claims as well, that issue is beyond the scope of this Article and has received much more extensive treatment in the existing literature on performer rights. Second, the foregoing analysis does not mean to preclude the availability of performer rights in all circumstances under the Lanham Act and related state law. There may be extremely limited circumstances where the extension of such protection might make sense. As this Article shows, however, there are myriad problems with such a narrow tack, meaning that courts should be extremely reluctant to carve out exceptions without stringent constraints on their scope.

203. David Lange, *Recognizing the Public Domain*, 44 LAW & CONTEMP. PROBS. 147, 147, 150 (1981) (“[R]ecognition of new intellectual property interests should be offset today by equally deliberate recognition of individual rights in the public domain. . . . Each [intellectual property] right ought to be marked off clearly against the public domain.”).

204. Benjamin Kaplan, *Performer’s Rights and Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409, 409–10 (1956).

205. See Joshua P. Binder, *Current Developments of Public Performance Rights for Sound Recordings Transmitted Online: You Push Play, But Who Gets Paid?*, 22 LOY. L.A. ENT. L. REV. 1, 6 (2001). But see 17 U.S.C. § 102(a)(7) (2012) (amending the Copyright Act to start providing federal protection for sound recordings, even though these rights are largely held by record companies).

Finally, and perhaps most importantly, one should not read this less-than-sanguine evaluation to suggest that performer rights are, in general, unworthy of consideration. There are sound reasons for providing greater recognition of and protection for the contributions that performers make to the commercial and artistic value of creative works. And measures to support this goal could take a number of different forms. Adoption of the long-sought application of public performance rights on sound recordings to include non-digital transmissions is one proposal to consider.²⁰⁶ More creatively, we might look at granting performers, like authors, a statutory regime of termination/reversion rights, akin to the Copyright Act's sections 203 and 304(c) & (d), so that artists can get back the publicity rights imbued in their performances thirty-five years after a transfer. Or, courts might rethink their notions of authorship, thereby enabling certain performers to make claims as copyright holders in particular instances. Whatever the form such expanded performer rights might take, granting protection under the Lanham Act and related state law is not among the advisable options.

Still, there is no doubt that courts will continue to face the temptation to do just that. The 2016 Presidential campaign is around the corner, and it promises more intellectual property fireworks. Given Chris Christie's increasingly likely run for the Republican nomination and his (admitted) obsession with all things Bruce Springsteen²⁰⁷—a man who does not remotely share his political sensibilities²⁰⁸—one likely source of the conflagrations seems easy enough to predict. So when Christie inevitably makes use of his favorite gems from the Springsteen oeuvre, infringement salvos may fire once again. Astrud Gilberto, Don Henley, Bette Midler, and Tom Waits can all sympathize with Springsteen's likely dilemma. Whether a court should provide relief if called upon to do so is—quite rightfully—an entirely different question.

206. See Matthew S. DelNero, *Long Overdue?: An Exploration of the Status and Merit of a General Public Performance Right in Sound Recordings*, 6 VAND. J. ENT. L. & PRAC. 181, 189 (2004).

207. See Jeffrey Goldberg, *Jersey Boys*, ATLANTIC (June 13, 2012, 10:15 AM), <http://www.theatlantic.com/magazine/archive/2012/07/jersey-boys/309019>; see also Beth DeFalco, *Superfan Christie Knows Who's Boss*, N.Y. POST (Nov. 2, 2012, 5:00 AM), <http://nypost.com/2012/11/06/superfan-christie-knows-whos-boss>.

208. Matt Katz, *Christie Makes a Friend Named Bruce Springsteen*, PHILLY.COM (Nov. 5, 2012, 8:58 PM), http://www.philly.com/philly/blogs/christie_chronicles/Christie-makes-a-friend-named-Bruce-Springsteen.html.