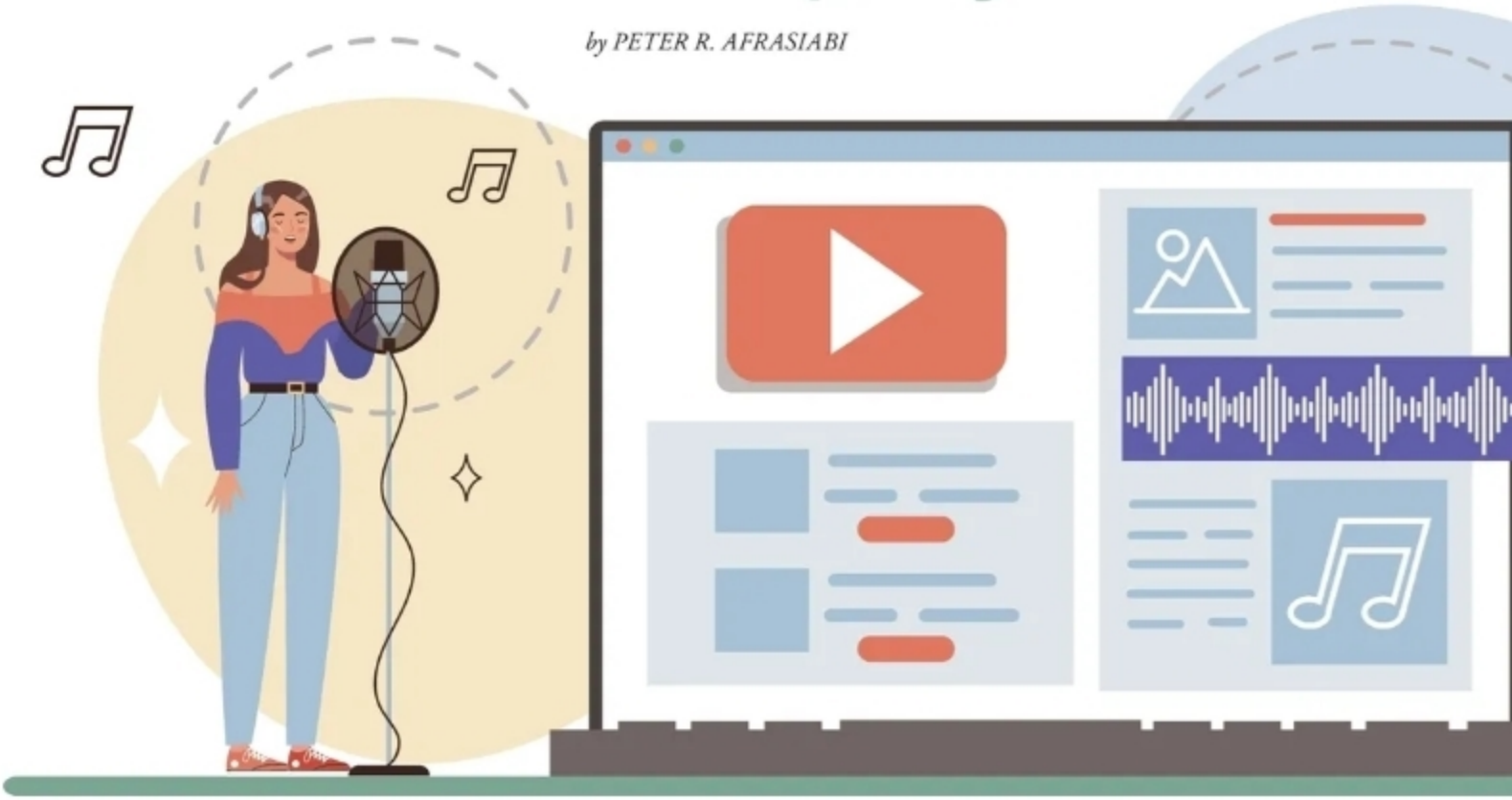
NANCY SINATRA, BETTE MIDLER, AND RICK ASTLEY:

Where State Right of Publicity Voice Protections Collide With the Federal Intellectual Property Laws

by PETER R. AFRASIABI



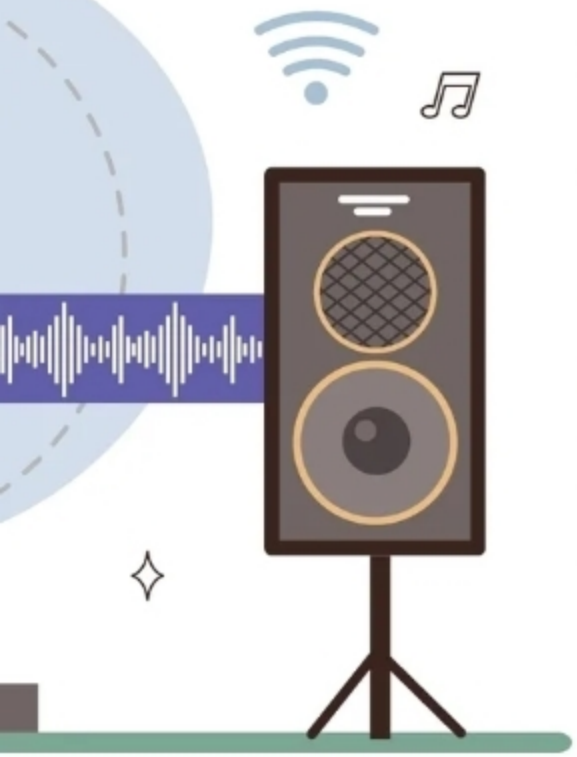
He certainly has illustrious company. Both Nancy Sinatra and Bette Midler were repeatedly nominated for Grammys, and Midler even won Oscars. Both Sinatra and Midler were massive recording stars of their eras. And both have found their likeness—their voice specifically—used by others without consent for commercial gain and, consequently, both have litigated the issue of those commercial companies recreating their famed voices for commercial gain. Enter stage right: Rick Astley, the 1980s Number-One, one-hit wonder and his then-endlessly MTV-played jingle, "Never Gonna Give You Up." The song has recently been re-recorded and Astley claims the new singer's voice sounds too much like his Scottish baritone. The issue we thus confront is whether an artist's voice's style—the unique artistic signature the voice connotes—has legal protections from soundalikes and, if so, when and how. To answer this question pits state right of publicity law against copyright law. Let's put on our metaphorical boots and start in the beginning.

"These Boots Are Made for Walkin'."

In *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970), Nancy Sinatra tested the law's boundaries of voice protection. There, Goodyear started selling "wide boots" tires and decided that it would help sell the tires to use Sinatra's "These boots are made for walking" in their TV commercials. Goodyear approached Sinatra but no deal was made. So Goodyear hired a singer and made a commercial with the song and singers dressed and evocative of Sinatra from her musical performances of the famed 1960s song: boots, mod dresses, dancing and all. Sinatra sued under state unfair competition principles to frame a claim around the unlawful use of her performance, which she claimed had secondary meaning as associated with her and was entirely evocative of her. Under California state unfair competition law at the time that she sued, the focus was on passing off in competition (in distinction to modern statutes giving a direct right against commercial exploitation of one's likeness), and the court held Sinatra and Goodyear were not in competition in any manner, so Goodyear never passed off its tires as her products or her records as its products. Under this law, the Ninth Circuit rejected her claim on the basis that there is no federal right to one's performance that allows one to deny others the right to make musical performances and there was no holding-out by Goodyear of the video as being one of Sinatra herself. Thus, Sinatra was encroaching in federal law too much with her state theory. The court held this even though it assumed as found by the district court that the voice sounded like Sinatra's as an imitation. *Id.* at 716-18.

"Do You Wanna Dance?"

In the 1980s, Ford wanted to sell its Mercury Sable line of cars and wanted to use Bette Midler's famed 1970s song in its TV commercials. First thing's first. Songs we hear on the radio (or online streaming now) have two copyright aspects to them: the underlying musical composition (melody and lyrics) and then the actual sound recording made of the composition (the singer and musicians who in fact record it). Midler did not own the musical composition to the song as she never wrote it back in the 1980s. Ford thus licensed from the musical-composition copyright owner rights to use the musical composition for its commercial. Ford then approached Midler to use her sound recording. Midler refused. Not to be denied, Ford in turn hired a soundalike, who turned out to also be one of Midler's



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back-up singers, and re-recorded the song in a new sound recording for the commercial. Mercury Sables in short order were being offered for sale on television with what sounded like Midler singing "Do You Wanna Dance?" *Midler v. Ford*, 849 F.2d 460, 461-62 (9th Cir. 1988).

Midler sued under state statutory and common law right of publicity law, claiming that the use of a soundalike usurped her right of publicity in her voice's unique sound. She carefully did not make the *Sinatra* secondary meaning claim that failed Nancy Sinatra. In federal court under diversity jurisdiction, the district court dismissed, holding that there was no such right. *Id.* at 462. But the Ninth Circuit reversed and held that Midler had a common law right to control her voice's likeness as against intentional imitation to sell a product and so permitted her claim against Ford to go to trial. *Id.* at 462-63. *Midler* distinguished *Sinatra* on this basis: "If Midler were claiming a secondary meaning to 'Do You Want To Dance' or seeking to prevent the defendants from using that song, she would fail like Sinatra. But that is not this case. Midler does not seek damages for Ford's use of 'Do You Want To Dance,' and thus her claim is not preempted by federal copyright law." *Id.* at 462.

In other words, Sinatra had failed because she had not centrally claimed a protectable common law property interest in her voice as against another's use and instead had pursued a theory that a musical song was associated with her by way of secondary meaning to preclude others using that song, which ran afoul of copyright limits that allowed people to license compositions and re-record them. Sinatra's state secondary meaning theory ("the song is associated with me") thus tripped federal laws, whereas Midler was never seeking to stop Ford from using the song in a commercial; instead, she was only seeking to have them do it without what appeared to be her voice. (In other words, Sinatra reached too far and could have won on this narrower theory).

"Never Gonna Give You Up."

In 2023, Astley has sued in Los Angeles Superior Court rapper Yung Gravy on these facts: Yung Gravy re-recorded "Never Gonna Give You Up" and used a singer known as "Popnick" to sing the song in the sound recording. *Astley v. Yung Gravy et al.*, No. 238M-CV00351 (L.A. Super. Ct. Jan. 27, 2023). As in *Midler* (and *Sinatra*), Astley did not own the musical composition to the song as he never wrote it back in the 1980s. The actual copyright owner to the musical composition actually licensed the musical composition to Yung Gravy and his record label, who then, lawfully, within copyright law, re-recorded it. Now, Astley does own a copyright (or did, depending upon what assignments he made back in the 1980s) to his actual sound recording of that musical composition. But, like Ford in *Midler* or Goodyear in *Sinatra*, Gravy did not reproduce the original Astley sound recording of "Never Gonna Give You Up." Astley thus (like Nancy Sinatra and Bette Midler before) could not and has not sued in copyright. Instead Astley filed suit, ala Bette Midler, claiming that Popnick's sound recording sounds too much like Astley's, and Gravy and the record label therefore infringed Astley's state right of publicity in his voice. *Id.*

A critical important fact is that Gravy released this song as music and artistic expression. It is not a song that Gravy made for a car company to help them sell their cars or, perhaps better yet, for a Valentine's promotion for a flower company to sell more roses. This, then, is exactly where state right of publicity law starts giving way to copyright law. Specifically, 17 U.S.C. § 114(b) is part of the Copyright Act that limits the exclusive rights of the owner of a sound recording copyright: "The exclusive rights of the owner of copyright in a sound recording . . . do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording." This amounts to a very limited set of rights that people like Astley have to control others' new sound recordings—they can control an actual use of their sound recording, but cannot limit others' rights to independently make sound recordings. The House Judiciary Committee Notes to Copyright Act Section 114(b) clarify: "Mere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible." H.R. 94-1476 (1976). This means, fairly, that soundalikes under copyright law are decidedly not unlawful. Indeed, copyright law does not allow a rightsholder the right to stop them, mercifully allowing all of us to enjoy our favorite cover bands.

Section 114 has an important downstream impact because the Copyright Act has a very broad complete preemption provision that disallows any state claims that are equivalent to any federal copyright interests. 17 U.S.C.

§ 301(a). Under Section 301, states cannot create rights equivalent to any federal rights under the Copyright Act or within the subject matter of copyright. *Id.* If federal copyright law expressly allows soundalikes, and denies artists the ability to stop soundalikes (because soundalikes have a federal copyright interest in making soundalikes), the argument necessarily follows that states cannot, within preemption principles, turn around and grant such rights to artists that federal law disallows.

Unlike *Midler*, the use in *Astley* is not a commercial one appending his name, image, likeness, or voice, to a commercial product for sale. It's a re-recording of a musical composition Astley first sang that has been released for musical listeners. This renders it outside the right of publicity zone and triggers copyright preemption questions at the heart of these cases. And *Midler* and other cases have squarely held that, in this area, courts must tread very carefully to protect First Amendment rights of others. "The First Amendment protects much of what the media do in the reproduction of likenesses or sounds. A primary value is freedom of speech and press." *Midler*, 849 F.2d at 462 (citing *Time, Inc. v. Hill*, 385 U.S. 374, 388 (1967)). Thus, as *Midler* held, "[t]he purpose of the media's use of a person's identity is central. If the purpose is 'informative or cultural' the use is immune; 'if it serves no such function but merely exploits the individual portrayed, immunity will not be granted.'" *Id.*

Accordingly, while those copyright preemption concerns were certainly present in *Midler*, they were also ducked by the Ninth Circuit when it maintained a narrow analysis on state right of publicity uses in the context of pure commercial exploitation for profit in the sales of goods or services independent or artistic purposes. That is, the Ninth Circuit held that Midler was not seeking damages for the use of the song with a soundalike—which may trigger preemption concerns—instead she was seeking damages for the use of her voice in commercial endeavors where the song was heard and assumed to be hers to help sell Fords. *See also Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992) (finding Tom Waits' claim for voice appropriation in TV commercial actionable and not preempted).

But in the Astley context, that preemption question is more squarely triggered as Astley has no comparable claim that this is at heart a state right of publicity use of a voice independent of the sound recording. Astley is complaining about a soundalike that is in the heart of Section 114 of the Copyright Act and in the heart of what *Midler* referred to as "immune" uses that are artistic or cultural uses (or what *Sinatra* held are not uses that can be appropriated by controlling others' use of music in general on a secondary meaning associational theory). A narrow analysis under the Copyright Act yields the conclusion that, in all likelihood, an Astley-type claim against other soundalikes fails copyright preemption because he is trying to deny the very thing Section 114 authorizes others to do. And even without disturbing *Midler's* immunity line, the Astley defendants' song falls on the immune side of that line consistent with First Amendment principles. They have the right to license musical compositions and make sound recordings under federal copyright law even if the voice is an imitation and a state law that says otherwise is preempted.

Sadly for Astley, copyright law's boots will send him walking and likely have to give him up.

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