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SOUND RECORDINGS NEED SOUND PROTECTION

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***334 I. Introduction**

Two types of battles often erupt over sound recordings and the rights that lie therein. One battle pits a recording artist's desire for protection—the same kind of protection accorded to composers—against a blatant plagiarist's theft. The other battle pits a recording artist's insistence upon artistic integrity against a businessman's greed. In either case, an irresistible force meets an immovable object. Unfortunately, the recording artist has little legal recourse; American copyright law and related concepts of intellectual property law clearly favor the composer over the recording artist, and business over artistic integrity.

This paper argues that copyright law, state law, and moral rights theory inadequately protect sound recordings and recording artists. Furthermore, this Article argues that section 114(b) of the Copyright Act¹ should be replaced with a new standard for determining infringement of sound recordings and for providing greater protection of moral rights for recording artists.

II. Sound Recordings in Copyright Law

George was a young songwriter who idolized a popular musician. Hence, George was overjoyed when he learned that his idol would be performing in his hometown. He was even more elated when an acquaintance arranged a private backstage meeting with the musical legend. During that meeting, George seized the opportunity to present his hero with a cassette tape containing a recorded performance of his best composition. George had naive hopes that perhaps the musician would like the song and would want to record it someday.

George heard nothing for several years until his idol released a subsequent album. As was his habit, George bought the album immediately and eagerly began *335 to listen. He noticed that one particular song on the album had an intensely familiar chorus. He rewound the tape and listened to the song again. George soon realized why the chorus was so familiar; his idol's tune was musically very similar to George's own composition. George found an attorney and filed a lawsuit alleging copyright infringement.² George knew he had a strong case because the Copyright Act offers protection for musical compositions. These kinds of copyright infringement claims are not at all infrequent, and occasionally result in litigation against even some of the most respected and popular stars in the music business.³

As George spoke with his attorney and learned more about copyright law, he was disillusioned to discover that if the musician had obtained a license to use George's composition, recorded his own version of the song, and intentionally impersonated every aspect of George's recording of the song—even to the extent of creating a virtual sound-alike—George would have no legal recourse against the imitation of his own copyrighted sound recording. George wondered why recordings are not afforded the same level of protection as compositions.

Our system seems to value the creative act of writing a song much more than it appreciates the creative acts involved in recording a performance of that song. Thus, due to the different treatments of compositions and recordings, George may succeed in his suit for infringement of his copyright in his musical composition, but would certainly fail in a suit for infringement of his copyright in his sound recording.

A. The Constitution

The United States Constitution explicitly grants to Congress the power to pass laws governing copyright.⁴ The purpose behind this grant of authority is to encourage the creation of works of artistic and scientific value by providing the incentive of an exclusive monopoly over the benefits of that creation for a limited time.

B. The Copyright Act

On several occasions throughout history, Congress has acted upon this power, as seen most recently in its passage of the Copyright Act of 1976 and its amendments. The Copyright Act grants to a copyright owner exclusive rights in *336 certain works which are fixed in a tangible medium of expression.⁵ These rights include the right to reproduce the work, the right to prepare derivative works, the right to distribute copies of the work, the right to perform the work publicly, and the right to display the work publicly.⁶ The congressional purpose in granting these exclusive rights was purely utilitarian; it was not based upon the natural rights of authors in their works.⁷

Since at least 1972, each musical sound recording embodies two separate copyrights—one in the musical composition performed and embodied in the recording, and the other in the recording itself. While sometimes one and the same, frequently the composer(s) and the recorded performer(s) are different individuals. The Copyright Act refers to the written composition and lyrics as the “musical work,”⁸ and refers to the recorded performance of a musical work fixed on a phonorecord as the “sound recording.”⁹ These two types of works are treated differently under the code. While the owner of a copyright in a musical work enjoys *337 the benefit of all the exclusive rights listed in section 106 of the Copyright Act, the owner of a copyright in a sound recording does not enjoy all of the same rights.¹⁰ For example, the owner of a copyright in a musical score has the exclusive right of public performance, which enables him to receive royalties from any public performance of the work; the owner of a copyright in a sound recording does not enjoy the exclusive right of public performance except by means of digital audio transmission.¹¹ The exclusive right of reproduction granted to owners of copyrights in sound recordings is narrower in scope than that granted to owners of copyrights in musical scores.¹²

This limited right of reproduction for owners of sound recordings can have dire consequences. The Copyright Act states that an imitation or simulation of a sound recording does not violate the exclusive right of reproduction unless the imitation directly recaptures the actual sounds fixed in the sound recording.¹³ Thus, a recording artist who intentionally creates a sound recording which imitates, simulates, or impersonates a copyrighted sound recording does not violate the right of reproduction as long as the recording does not recapture the actual sounds of the protected recording by mechanical means. “I imitation alone does not give rise to a cause of action.”¹⁴

In other words, section 114 prohibits the duplication of a recording, such as the copying of a compact disk onto cassette tape. It also prohibits the creation of a derivative work in which the actual sounds in the recording are rearranged or altered *338 and incorporated into a separate work. However, if a musician obtains a license to record the underlying musical work—which in some instances the owner of the copyright in the musical work must sell for a set fee¹⁵—section 114 does not prohibit the musician from creating the closest possible reproduction of a protected sound recording, as long as the reproduction is human rather than mechanical.¹⁶

Thus, compared to other copyrightable works, copyright protection for sound recordings is anomalous in requiring actual replication as an element of infringement. The Copyright Act provides significantly more protection against reproduction of other kinds of artistic works, such as literary works, dramatic works, choreographic works, audiovisual works, and even musical works; a potentially infringing work can vary significantly from a protected work and still infringe, as long as it incorporates the original author’s expression.¹⁷

To demonstrate infringement of a work that is not a sound recording, a plaintiff must show a “substantial similarity” between the protected work and the potentially infringing work and present evidence that the infringing author had access to the protected work.¹⁸ Ironically, under this test, musical compositions are among the most highly protected works because courts have permitted showings of “unconscious infringement” of musical compositions and have inferred access when the protected work was a hit song.¹⁹

In denying sound recordings the protection of the “substantial similarity” test, Congress has allowed imitators to profit unfairly from the effort and originality of a recording artist. But perhaps more importantly, and in spite of Congress’s refusal to recognize any natural rights foundation for copyright law,²⁰ Congress has implied *339 that the most valuable part musical creativity is the creation of musical compositions, not the creation of sound recordings. Furthermore, because the goal of

copyright law is to promote the proliferation of the arts by granting a monopoly to artists for a limited time,²¹ Congress has determined that original renditions of musical compositions do not enhance or contribute to the artistic wealth of society in denying this monopoly to sound recording artists.

III. State Law Doctrines

Copyright law recognizes no cause of action against independent fixations of sound recordings which imitate but do not actually replicate a copyrighted sound recording. In some jurisdictions, recording artists have overcome these inadequacies by using state law causes of action, such as misappropriation, unfair competition, and the right of publicity.

A. Unfair Competition

Common law doctrines of unfair competition prohibit the practice known as “passing off,” or deceptively misleading the public as to the origin of goods.²² An unfair competition claim can arise only when two producers compete with each other.²³ If an imitation of a sound recording deceives or confuses the public into identifying the imitation as the original, unfair competition laws may bar the imitation if the parties to the suit are competing in the marketplace.²⁴

An illustrative case is *Shaw v. Time-Life Records*,²⁵ in which the defendant, Time-Life Records, released recordings that imitated the recordings of the plaintiff, Artie Shaw, and labeled the works as “Artie Shaw” versions.²⁶ The court held that while Shaw had no property interest in his sound, the recordings could potentially cause consumer deception.²⁷ Therefore, the court denied defendant’s motion for summary judgment on this issue.²⁸

In a similar case, the Federal Trade Commission (FTC) brought suit against Magnetic Video Corporation, which had created and marketed simulations of *340 various popular songs.²⁹ The defendant misleadingly labeled its records with titles such as *The Sounds of Neil Diamond* in its promotional material.³⁰ The FTC found that the defendant’s actions could have potentially deceived the public into believing that the products were original recordings of the respective artists.³¹ As part of a consent order, the defendant agreed to include a boldfaced disclaimer stating “THIS IS NOT AN ORIGINAL ARTIST RECORDING” in all future releases.³² Hence, although this FTC case was based on federal, rather than state, unfair competition law, it did result in some protection of sound recordings against substantially similar imitations.

Other plaintiffs have been less successful in their efforts to supplant copyright law with unfair competition law. When Goodyear Tire & Rubber Company (Goodyear) bought a license to record the Nancy Sinatra hit *These Boots are Made for Walkin’* and hired a Nancy Sinatra sound-alike to sing it for an advertisement, Sinatra sued on state unfair competition grounds.³³ She claimed that Goodyear’s imitation of her performance deceived the public.³⁴ The court denied relief to Sinatra for two reasons.³⁵ First, it held that no actual competition existed between Sinatra and Goodyear.³⁶ Second, it stated that a grant of protection to a sound recording was preempted by federal law because it conflicted with Congress’s explicit denial of such protection to sound recordings in the Copyright Act.³⁷

B. Misappropriation

The common law doctrine of misappropriation differs from unfair competition in that misappropriation does not require either competition between the parties or “passing off.” Misappropriation generally requires: (1) that the plaintiff invested a substantial amount of time, effort, and money creating a product; (2) that the defendant wrongfully appropriated the creation; and (3) that the defendant injured the plaintiff by the misappropriation.³⁸

*341 The theory of misappropriation has been applied to protect a singer’s voice in *Midler v. Ford Motor Co.*³⁹ Ford campaigned to convince popular singer Bette Midler to allow use of her hit recording *Do You Want to Dance?* in a commercial.⁴⁰ When Midler refused, Ford obtained the right to record the underlying musical work and hired one of Midler’s former back-up singers to sing an imitation.⁴¹ Midler sued under California’s common-law theory of misappropriation.⁴² The court held that “a voice is as distinctive and personal as a face,”⁴³ and that Midler’s voice was a sufficient indicia of her identity. Thus, the court concluded that the imitation of Midler’s voice violated her personal property rights and allowed recovery on Ford’s unlawful appropriation of Midler’s identity for commercial gain.⁴⁴

C. The Right of Publicity

The right of publicity doctrine gives individuals exclusive rights in their own names, likenesses, or other defining personal characteristics.⁴⁵ These rights are violated when others use a person's name or likeness without permission for commercial gain.⁴⁶ This doctrine varies significantly from state to state. For example, the right of publicity statutes of California and New York prohibit the unauthorized use of a person's voice for advertising and trade purposes.⁴⁷ In contrast, in Massachusetts and Kentucky, right of publicity protection for voice is *342 unavailable because protection is limited only to the plaintiff's name, likeness, and picture.⁴⁸

The right of publicity doctrine has not been used to protect sound recordings against substantially similar imitations, but it has been applied in related contexts. For example, the right of publicity doctrine was invoked in *Estate of Presley v. Russen*⁴⁹ to enjoin an Elvis Presley impersonator's performance—"The Big El Show"—because it commercially exploited Elvis Presley without the permission of his estate, and lacked any real artistic value.⁵⁰

Citing *Presley*, an artist could argue that an unauthorized recording substantially similar to his own violates his right of publicity because the recording uses the artist's musical performance—a defining characteristic of his identity—without the artist's permission and for commercial gain.

D. Shortcomings of State Law Doctrines

State law doctrines have sometimes allowed recording artists to bypass the limitations of copyright law and protect their recordings against substantially similar imitations.⁵¹ Nevertheless, these doctrines are far from perfect. The principle of preemption raises the question of whether the federal Copyright Act negates the validity of such state law doctrines. In addition, when recognized by states, the operation of these doctrines vary greatly from state to state. Because of these shortcomings, these state law doctrines do not substitute for true copyright protection against substantially similar imitations of sound recordings.

These state law doctrines may be preempted because they provide protection for sound recordings against substantially similar imitations, which Congress deliberately left unprotected in section 114 of the Copyright Act.⁵² Section 301 of the Copyright Act preempts a state law if the state right is an equivalent of a right specified in section 106, and the right extends to works fixed in a tangible medium of expression that are within the subject matter of copyright.⁵³

*343 The courts have varied in their treatment of this issue. Some courts have held that certain state misappropriation claims are not preempted by the Copyright Act. For example, in *Midler v. Ford Motor Co.*,⁵⁴ the Ninth Circuit found that Midler's claim of misappropriation of a sound recording was preempted but her claim of misappropriation of her voice was not because voices are not copyrightable subject matter and hence do not fall within the scope of the Copyright Act.⁵⁵ Even though the court disallowed protection of sound recordings under state law, it did permit protection of voice under state law, resulting in protection similar to that of her sound recording. The second and sixth Circuits have reached similar conclusions.⁵⁶ However, in *Motown Record Corp. v. George A. Hormel & Co.*, a California federal court held that an unfair competition claim was preempted by the Copyright Act because the claim fell within the scope of the Act.⁵⁷

Even when state law doctrines are valid, they vary significantly from state to state in terms of scope and authority. For example, some states which recognize the right of publicity doctrine allow for relief for the appropriation of a name or likeness, but not for the appropriation of a voice or musical performance.⁵⁸ Other states use a different approach to the right of publicity and protect those characteristics which embody a person's identity,⁵⁹ such as a singing style or voice. Other jurisdictions refuse to recognize the right of publicity at all. Misappropriation and unfair competition laws also vary greatly from state to state. This lack of consistency among the states makes these state law doctrines less desirable as a means to protect sound recordings.

Moreover, the inherent limitations of each state law doctrine make these doctrines limited in usefulness to sound recording artists. For instance, relief can *344 only be obtained under the unfair competition theory when the parties to a suit directly compete with each other. However, relief will rarely be granted to the plaintiff artist because the defendant impersonator will probably not be in direct competition with the artist. In *Sinatra v. Goodyear Tire & Rubber Co.*, Nancy Sinatra was denied relief because she failed to prove that the defendant tire company competed with her.⁶⁰ In addition, unfair competition theory demands a showing that the defendant is trying to "pass off" his work as that of the plaintiff.⁶¹ Even when both the

competition and “passing off” requirements are satisfied, relief is limited because courts have allowed defendants to continue distribution of imitation recordings as long they place disclaimers on the packaging.⁶²

Similarly, causes of action based on misappropriation have limited usefulness. *Midler v. Ford Motor Co.*, which recognized a tort of voice misappropriation, has a very narrow holding; the court made clear that the voice in question has to be distinctive,⁶³ widely known,⁶⁴ deliberately imitated, and used to sell a product.⁶⁵

State law causes of action—misappropriation, unfair competition, and right of publicity—benefit recording artists to some extent. However, the doubt surrounding the scope of preemption, the inconsistencies in the application of the theories from state to state, and the limitations inherent in the doctrines make them too tenuous to be reliable. Artists will still be unable to protect their recordings against unauthorized imitations.

These doubts, inconsistencies, and limitations create serious protection problems because modern music and advertising industries pervade the entire country and the potential for imitation of recordings is nationwide. Commercials, such as those involved in *Sinatra*⁶⁶ and *Midler*,⁶⁷ are commonly broadcast across the nation. A plaintiff may have to bring suit in all fifty states to protect his sound recording or to be compensated for damages.

***345 E. Implications of State Law Doctrines**

By recognizing such doctrines as misappropriation, the right of publicity, and unfair competition, state courts and legislatures have shown their willingness to dispel the myth that musical creation begins and ends at composition. Courts that allow relief for recording artists under these state law doctrines implicitly recognize that sound recordings are a valuable art form unto themselves and worthy of protection against close imitation. These courts recognize that if sound recordings were devoid of independent artistic value, as Congress seems to think, then defendants such as the Ford Motor Company and Goodyear Tire & Rubber would have simply hired any talented singer to record the Midler and Sinatra tunes. The fact that these companies actively sought sound-alikes instead of just any talented performer demonstrates that there is originality and artistic value in sound recordings that is completely independent of the originality in the underlying musical works. Performers and recording artists contribute as much to the final musical product as the composer.

IV. Needed Revision in the Copyright Code: Repeal Section 114(b)

Variation among jurisdictions and inherent limitations make reliance upon state law doctrines for protection of sound recordings precarious, unreliable, and unwise. This ineffectiveness demonstrates the need for greater federal copyright protection for sound recordings.

Section 114(b) should be repealed to eliminate inconsistency and doubt over the scope of preemption and to foster uniformity by creating federal protection for sound recordings. This protection would remove onerous requirements, such as showing actual competition or “passing off” because infringement would be established by showing that the defendant created a sound recording without permission that is substantially similar to the plaintiff’s copyrighted work.

Congress decided to forbid only actual replication of sound recordings for two main reasons. First, Congress wanted to thwart record piracy.⁶⁸ However, even if Congress had never passed section 114(b), the substantial similarity test would then apply to sound recordings. Under this test, an actual reproduction of a sound recording that is substantially similar to the original recording, such as a pirated copy of a recording, would infringe. Congress could have battled record piracy just as effectively without the benefit of section 114(b). Abandonment of section 114(b) of the Copyright Act would in no way hamper efforts to prevent piracy and bootlegging.

***346** Second, Congress sought to encourage numerous recorded versions of the same musical work when it excluded sound recordings from the “substantial similarity” standard.⁶⁹ Under this policy rationale, the requirement of actual reproduction eliminates the threat that the first recording artist to record a rendition of a musical work will sue all subsequent artists who record their own version of the same composition. Congress reasoned that section 114 would permit multiple renditions of a composition to be recorded and distributed, and performance royalties paid to the composer and publisher (but not the recording artist) would thereby be increased.⁷⁰ Congress’s desire to reward songwriters but not recording artists with performance royalties implies that there is little valuable artistry to be found in the recording process, and that the act of

musical creation does not extend beyond composition. This logic disregards the significance of the recording artist's talent, style, and interpretation of a musical score. It denies the performer his right to be recognized as an artistically important part of the creation of music; it treats the recording artist as if he were merely a computer or player-piano, translating notes contained on sheet music into audible form, imparting no feeling of his own into his performance.

A. Flawed or Outdated?

This author believes that copyright law, which is so beneficial to composers and yet so repugnant to recording artists, is perhaps not so much flawed as it is outdated. Copyright law originated in an era that predicated recording devices, synthesizers, recording studios, producers, phonorecords, and today's popular music. In an era long since gone, classical compositions were at the heart of musical creation. In that period, performers were less involved with the creation of music than they are in 1997. This is not to say that the London Symphony Orchestra and the Boston Pops do not impart their own creativity to the performance and recording of classical compositions such as Beethoven's *Fifth Symphony*—they clearly do. Nevertheless, it is difficult to dispute that the vast majority of the creative energy and the musical expression in classical works lies in the written score, where music is meticulously described. Thus, the copyright system once accurately reflected composers' and performers' respective roles in the creation of music, but has grown outdated in its prejudice against performers and recording artists of the present.

Unfortunately, against the backdrop of modern popular music such as jazz and rock & roll, the present copyright system grossly oversimplifies the relative roles of composer and performer. Modern music is more improvisational, and thus gives the creativity of the performer free reign. Furthermore, in popular music, a written score's description of the musical makeup of a song is limited because it is incapable *347 of fully capturing the essence of modern musical forms. The vocal intonations of an Elvis Presley defines modern music at least as much as the written score of Leiber and Stoller.⁷¹

Thus, when a performer obtains the right to use a rock & roll composition, he has by default also obtained the right to impersonate those aspects of the original performance which contributed at least as much as the underlying composition to the success of the original recording. In effect, Congress has created a disincentive to creativity by refusing to recognize a recording artist's role in musical creation. Why should a recording artist be eager to create new recordings when he has no legal recourse against the financial harms imposed by imitators? This harm can be visited upon the artist in the form of lost royalties due under a recording contract⁷² or as a loss of potential income for future product endorsements, such as when an imitator's voice is used in an advertisement.⁷³

B. A Proposal for Reform: A Sliding Scale Continuum

The repeal of section 114(b) of the Copyright Act would grant full copyright protection to sound recordings and would, in the absence of proof of intentional copying, subject potential infringers to the same substantial similarity standard used for other forms of copyrightable subject matter.⁷⁴ Congress could then protect sound recordings against unauthorized reproductions, whether actual reproductions or substantially similar imitations.

If Congress repealed section 114(b), however, one major problem would arise. As discussed above, when the underlying musical work is a classical composition, most sound recordings are by their very nature substantially similar; it would be difficult to find two recordings of Beethoven's *Moonlight Sonata* that vary significantly. Thus, the grant of full copyright protection to sound recordings would result in a serious disincentive to produce new renditions of classical works for fear of infringement lawsuits.

This problem could be minimized through judicial use of a sliding scale to determine the amount of similarity required to constitute infringement. The extent to which the composer, rather than the performer, contributed to the creativity of the sound recording would be directly proportional to the amount of similarity needed to *348 constitute infringement; the more the composer contributed to the creation of the sound recording, the more similarity would be required to constitute infringement. Stated inversely, if the performer, rather than the composer, contributed the bulk of the creative energy in a sound recording, less similarity would be required to constitute infringement.

In making determinations of the primary creative source, courts could look to such factors as the recording artist's level of improvisation, the extent to which the performance departs from the directions of the sheet music, and to the extent to which

the performance contains elements (such as voice, distortion and feedback, sound effects, or a distinctive style) which are not generally protectable by virtue of the recordings status as a derivative work of the underlying composition.⁷⁵ In this way, courts could account for differences among various musical genres; sound recordings containing renditions of popular compositions would be better protected against infringement than sound recordings containing renditions of classical compositions. For example, the copyright in a sound recording of an improvisational rock & roll guitar solo would be infringed by a substantially similar imitation; but the copyright in a sound recording of Chopin's *Polonaise* would be nearly impossible to infringe upon absent actual mechanical replication of the original performance.

C. A New Era

The art of music has entered a new era that is far different from the era when copyright law was forming. Creative genius is no longer found primarily in brilliant composers such as Beethoven, Bach, and Mozart, whose work, by today's standards, varies little between performances. Now, both Bob Dylan and Jimi Hendrix can record *All Along the Watchtower* and the resulting versions are barely recognizable as the same song.⁷⁶

After all, whose masterful talent immediately comes to mind when we hear *Hound Dog* on the radio? With which crooner do we associate *Witchcraft*? Elvis *349 Presley and Frank Sinatra are two of the most successful recording artists of all time, but neither wrote the songs closely identified with them. Nevertheless, through their creative genius, Presley and Sinatra infused these compositions with everything that makes them the memorable masterpieces that they are.⁷⁷ The time has come for Congress to recognize the modern reality that a recording artist influences the creation and success of music as much as a composer. Congress should respond with protection for sound recordings commensurate with those contributions.

V. Sound Recordings in Moral Rights Law

A. That Song is Precious

The year was 1969. In Jim Morrison's absence, both Elektra Records and Jim's fellow bandmates from The Doors agreed to allow an advertising agency to use their most popular song for \$50,000. The agency planned to use the song in a new promotional campaign: "Come on Buick, light my fire." When he learned of the deal, Morrison was enraged. He made no secret of his feelings. He cornered Elektra's president, Jac Holzman: "I want it clear, Jac, I'm telling you now, I want it clear: Don't you ever do that again. That song is precious to me and I don't want anybody using it."⁷⁸

Although Morrison had grown tired of performing the song publicly, he nevertheless refused to compromise his artistic integrity by allowing his band's creation to be used to sell an automobile. Fortunately, the song was never used. Although they didn't understand Jim's anger at the time, his bandmates would thank him later, posthumously.⁷⁹

B. A Parasite

Twenty-five years later, a bright new cherry red Camaro drives into the picture on a television screen, while a familiar tune plays in the background. Anyone under forty could name the song in an instant—Jimi Hendrix's *Fire*. A narrator's voice asks, "The 1993 Chevy Camaro. What else would you expect from the country that invented rock & roll?" Hendrix died in 1970, but his former bandmates were as furious in 1993 as Morrison was in 1969. Their ire is directed at Alan Douglas, the *350 man who at that time controlled the Hendrix legacy.⁸⁰ "He's a parasite," says Noel Redding, Hendrix's drummer.⁸¹

During the time that Douglas owned the rights to Hendrix's music, he, in the eyes of many purists, made a living by desecrating the musician's memory. These purists contend that Douglas grew wealthy by selling (or selling-out?) the Hendrix recordings for advertising purposes and by releasing shoddy posthumous Hendrix albums, some of which include altered original Hendrix recordings and releasing them as albums. For example, for *Midnight Lightning* and *Crash Landing*, Douglas erased the original bass and drum tracks and dubbed Hendrix's voice and guitar over new tracks recorded by session players.⁸² Both were released as "Jimi Hendrix" albums, without indicating the alteration. Douglas' last project was an attempt to piece together his own version of what Hendrix's fourth album—unfinished at the time of his death—could have sounded like. Hendrix did not even leave behind a song list for the album, which he referred to only as *First Ray of the New Rising Sun*, nor did he leave any finished recordings.⁸³

C. A Fundamental Principle

A fundamental tenet of American copyright law is that the owner of a copyright has sole and final authority over the work; the owner of the copyright is the only party with standing to sue for infringement, even if the owner of the copyright did not author the work. Thus, unless the author is also the copyright holder, he has entirely lost control over his work.⁸⁴ For all practical purposes, under American law, authorship without ownership is meaningless.

If Jim Morrison or Jimi Hendrix decided to take legal action to prevent the use of or alteration of their sound recordings, the outcomes would be fairly clear. If Buick had proceeded with its plans, The Doors, and Elektra Records who still owned the copyright in the recording and composition, would have been able to successfully sue Buick for its unauthorized use of the song. But if Jimi Hendrix were alive, any lawsuit he might have filed against Alan Douglas would have failed because Alan Douglas—not Hendrix—owned the copyrights in the recordings and thus had sole authority over them. This dichotomy between author and owner can *351 occur due to section 201 of the Copyright Act, which allows for transfer of all or part of a copyright.⁸⁵

D. The Berne Convention

For over one hundred years, the Berne Convention for the Protection of Literary and Artistic Works (Berne)⁸⁶ has been the major international agreement for the protection of intellectual property rights. Berne differs fundamentally from American intellectual property law in that it is not based primarily on economic considerations. It therefore treats authorship differently from ownership, and allows authors to retain “moral rights” independent of copyright ownership. For over one hundred years, the United States had not been a signatory to the treaty.

But with the emergence of a global market for American films, music, and computer software, the United States found that it had much to gain from adherence to Berne because Berne offered a great advantage in the battle against international piracy of these art forms. Thus, the United States finally joined Berne on October 31, 1988.⁸⁷ However, adherence to Berne came at a price as the United States would have to accept the Berne concept of moral rights. Article 6bis of the Berne Convention contains the moral rights sections, which provide that the author of a work shall have the right to claim authorship of the work (the “right of paternity”) and the right to prevent the distortion, mutilation, or other disparaging action toward the work which would damage his reputation (the “right of integrity”).⁸⁸ Under *352 Berne, the author of a work retains these rights even after the copyright or any of the exclusive rights therein are transferred.⁸⁹

E. VARA

However, through legislative sleight of hand, Congress maintained that sufficient protection for moral rights was available under other laws, such as the Copyright Act, the Lanham Act,⁹⁰ and the state law doctrines of rights of publicity and misappropriation. Therefore, the only new legislation Congress passed in response to Berne was the Visual Artists Rights Act (VARA), which was incorporated as section 106A of the Copyright Act. VARA grants moral rights to painters, sculptors, and still photographers, but not to filmmakers, musicians, or recording artists.⁹¹ Hence, adherence to Berne has not augmented moral rights for recording artists.

The rationale for denying moral rights to recording artists stems from the nature of the works. Sculptures, paintings, and photographs are concrete forms of art and are not ephemeral like films, music, and sound recordings. Furthermore, films, music, and sound recordings can be easily reproduced and commonly exist in many copies. Destruction of any one copy will not imperil the existence of the work. Thus, moral rights are extended only to the tangible forms of art that exist in limited numbers, which is what VARA does. Is this reasoning sound?

F. *My Happiness*—A Case for Expansion of VARA

In 1953, a young Elvis Presley stepped into a Memphis recording studio for the first time and made a two-sided acetate recording for his mother’s birthday at a cost of \$3.98. He recorded her favorite songs: *My Happiness* and *That’s When Your Heartaches Begin*.⁹² He made only one copy. Soon thereafter, Presley gave the acetate to Ed Leek, a high-school friend. Leek

kept the record in his attic until it was *353 finally released by RCA in 1990.⁹³ This release is the musical equivalent of a lost Van Gogh turning up at a garage sale in Milwaukee. From 1953 to 1990, only one priceless copy of the first recording of the most popular singer in history existed.

This anecdote illustrates the limitations of the VARA rationale for exclusion of sound recordings from moral rights protection because there are rare instances when precious few copies of sound recordings exist. In such cases, sound recording authors should be granted the moral right to prevent the destruction, mutilation, or alteration of these recordings.

VI. Moral Rights Case Law

Because of the century long American avoidance of the Berne Convention, American courts have been reluctant to recognize a cause of action based on the moral rights of recording artists or even of composers.

In 1948, Twentieth Century-Fox used some of Russian composer Dmitry Shostakovich's compositions as background music in the film titled *The Iron Curtain*.⁹⁴ The film's credits stated "Music—From The Selected Works of the Soviet Composers—Dmitry Shostakovich et al. "⁹⁵ Since the film's theme was "objectionable to Shostakovich in that it was unsympathetic to his political ideology," he brought suit for a permanent injunction against the use of his name and music in the film or advertising.⁹⁶ Shostakovich alleged, *inter alia*, that his moral rights as composer were violated. However, the court refused to grant relief, stating "In the present state of our law, the very existence of the moral right is not clear, the relative position of the rights thereunder with reference to the rights of others is not defined nor has the nature of the proper remedy been determined."⁹⁷ Thus, by repudiating Shostakovich's request, the court rejected the Berne Convention's command that authors shall have that right to "object to any distortion, mutilation or other modification of, or other derogatory action in relation to their work which would be prejudicial to the author's honor or reputation."⁹⁸

Although no plaintiff has successfully based an action solely upon a moral rights theory in American courts, some recording artists have effectively used other legal theories to protect their rights of attribution and integrity.

*354 Breach of Contract

Norman Granz, a well-known producer of jazz records, acquired protection for his sound recordings under an action for breach of contract.⁹⁹ Granz recorded a jazz concert in its entirety and produced six twelve-inch master discs that contained two of the songs performed at the concert.¹⁰⁰ Granz sold these six masters pursuant to a contract which required that any records produced from the masters must contain the phrase "Presented by Norman Granz."¹⁰¹ The purchaser of the masters re-recorded the music on ten-inch masters and used them to manufacture records for retail sale.¹⁰² The album covers of these records did not conform to the terms of the contract until Granz demanded correction.¹⁰³

A ten-inch record contains less music than a twelve-inch recording of the same speed.¹⁰⁴ As a result, the defendant had to delete substantial portions of the original master recordings to produce the ten-inch records.¹⁰⁵ Granz brought suit against the purchaser, seeking rescission of the contract, damages, and a permanent injunction.¹⁰⁶ He also claimed breach of contract and moral rights in his works.¹⁰⁷

The trial court found that the defendant deleted only audience sounds consisting of "whistles, cheers, and screams" and not any music, and that defendant's editing did not affect the plaintiff's contribution to the original musical production.¹⁰⁸ The trial court concluded that "when the defendant ... corrected the album covers of the ten-inch ... records to conform to the agreement, he was not, as was claimed, attributing to the plaintiff the work of some one sic else."¹⁰⁹ The trial court refused to grant relief.¹¹⁰

The Second Circuit found that the defendant had omitted eight full minutes of music, including saxophone, guitar, piano and trumpet solos.¹¹¹ The court refused to *355 grant relief on moral right grounds and opted instead to grant relief for breach of contract, stating:

Disregarding for the moment the terms of the contract, we think that the purchaser of the master discs could lawfully use them to produce the abbreviated record and could lawfully sell the same provided he did not describe it as a recording of music presented by the plaintiff. If he did so describe it, he would commit the tort of unfair competition. But the contract required the defendant to use the legend

“Presented by Norman Granz,” that is, to attribute to him the musical content of the records offered for sale. This contractual duty carries by implication … the duty not to sell records which make the required legend a false representation. In our opinion, therefore, sale of the ten-inch abbreviated records was a breach of the contract.¹¹²

The court found that the harm to Granz’s reputation as an expert in the presentation of jazz concerts was irreparable, and it granted him an injunction against attribution of the altered albums to him.¹¹³ The court’s decision, however, rested purely on breach of contract grounds rather than moral rights theory.

Interestingly, the concurring opinion in *Granz* refused to reject explicitly the doctrine of moral rights. The concurrence opined that Granz should receive an injunction not only against attribution of the altered versions of the work to him, but also against “publication by the defendant of any truncated version of his work, even if it does not bear plaintiff’s name.”¹¹⁴ The concurrence added that “the phrase ‘moral right’ seems to have frightened … courts to such an extent that they have unduly narrowed artists’ rights.”¹¹⁵ Yet, even the concurrence refused to rest its opinion on the doctrine of moral right, as “without rejecting the doctrine of ‘moral right,’ … we should not rest decision on that doctrine where, as here, it is not necessary to do so.”¹¹⁶

B. Lanham Act Section 43(a) Claims

In *Rich v. RCA Corporation*,¹¹⁷ the musician Charlie Rich sought to enjoin RCA from using a current photograph or likeness of him on the cover of an album of songs performed ten years earlier.¹¹⁸ Rich based his claims on section 43(a) of the Lanham Act,¹¹⁹ alleging that the use of his current likeness on an album containing *356 old recordings would mislead the public into believing that the album contained only new songs.¹²⁰ The court agreed, stating that asterisks next to the older selections that denoted “previously released selections” was visible only on the closest inspection, and failed to prevent misleading the public.¹²¹ The court found that the use of Rich’s current picture on the album without a prominent notation that the songs had been recorded over a decade ago was likely to deceive, mislead, and confuse consumers.¹²²

Protection of artistic integrity under the Lanham Act reached its peak in 1976 during a conflict between The American Broadcasting Company (ABC) and the British comedy troupe Monty Python.¹²³ ABC had obtained the right to air several episodes of the television program, *Monty Python’s Flying Circus*, on American television.¹²⁴ To the horror of Monty Python, ABC edited the episodes liberally, altering them substantially from their original state.¹²⁵ Monty Python sued on the grounds that the cuts constituted an actionable mutilation of their work.¹²⁶ The Second Circuit agreed, stating that “the economic incentive … that serves as the foundation for American copyright law … cannot be reconciled with the inability of artists to obtain relief for mutilation or misrepresentation of their work to the public on which the artists are financially dependent.”¹²⁷ The court found in the Lanham Act a basis for moral rights actions:

[The Lanham Act] has been invoked to prevent misrepresentations that may injure plaintiff’s business or personal reputation It is sufficient to violate the Act that a representation of a product, although technically true, creates a false impression of the product’s origin Thus, an allegation that a defendant has presented to the public a ‘garbled’ ... [and] distorted version of plaintiff’s work seeks to redress the very rights sought to be protected by the Lanham Act ... and should be recognized as stating a cause of action under that statute.¹²⁸

In reaching this conclusion, the Second Circuit cited both *Granz* and *Rich*.¹²⁹ Unfortunately, no other Circuit Courts have agreed with the Second Circuit.

***357** Section 43(a) of the Lanham Act has also been used to secure the right of attribution for composers. Three songwriters, Robert Lamothe, Ronald Jones, and Robinson Crosby, composed two songs titled *Scene of the Crime* and *I’m Insane* while members of a band known as Mac Meda.¹³⁰ When Mac Meda disbanded, Crosby joined another band known as RATT.¹³¹ Atlantic Records then released an album by RATT which contained the two songs, but failed to identify Lamothe and Jones as co-authors of the songs.¹³² The Ninth Circuit found that Atlantic’s failure to name Lamothe and Jones as composers constituted “reverse passing off” and thus violated section 43(a).¹³³

C. Problems

In all of the above cases, courts relied on a variety of theories to guard the moral rights of authors. However, the courts do not recognize the moral right itself as an inherent interest in the author separate and independent of the copyright. The court in *Granz*, for example, relied on contract law to vindicate a moral right; it found implied contractual terms that the jazz records would not be materially altered.¹³⁴ Thus, even though the court used the term “moral right” in a concurring opinion,¹³⁵ its decision was based on the contractual rights and duties arising from the business dealings of the parties and not on the moral rights of attribution and integrity. *Granz* suggests that courts basing moral rights on contract theory would be unable to grant relief to recording artists in situations where there is no contractual relationship between the litigants. Thus, contract law is unreliable as a foundation for the protection of the moral rights of recording artists.

Other plaintiffs, such as those in *Lamothe* and *Rich*, have successfully cloaked moral rights actions under the guise of the Lanham Act. But because different Circuits have interpreted the Lanham Act differently, a recording artist using the Lanham Act to assert his rights of attribution and integrity will probably be more successful in some courts than others. The Ninth Circuit, for example, believes that the Lanham Act is basically a federal unfair competition statute; thus, the court has held that a defendant’s conduct “must in some discernible way be competitive” with that of the plaintiff.¹³⁶ In contrast, the Second Circuit sees the Lanham Act as essentially a remedy for false advertising and has no such competition *358 requirement.¹³⁷ Therefore, like contract law, the Lanham Act is an unreliable source for protection of the moral rights of recording artists.

VII. The Album as an Art Form

A. A Movie for Your Ears

In the mid 1960’s, popular music, especially rock music, became increasingly album-oriented. Rock evolved beyond the two-and-a-half minute hit singles of the 1950s and early 1960’s. Rock & roll artists were given free reign to create an entire album—occasionally a double album—as a single art form. Sometimes, these albums ran as long as two hours in length.

Usually, the album’s cover was at least as interesting as its music. No one who has ever touched a needle to a vinyl album could deny the mesmerizing effect of closely examining the large album cover while listening to the music contained within it. Bands treated the covers of their albums as much more than a vehicle for delivering their music to the public; they spent immeasurable amounts of time and money creating imaginative and often elaborate packaging to complement their music.¹³⁸ Album covers leant meaning to the songs and vice versa; the cover was as much a feast for the eyes as the music was a feast for the ears. Often, in the case of double albums, the packaging became more of a book than a cover.¹³⁹ As evidence of the importance of cover art, one need only point to the thousands of Beatles fans who scoured every Beatles release looking for visual “clues” to support the “Paul is dead” rumors circulating at the time.

*359 Another distinguishing characteristic of vinyl albums was the concept of a “side.” Each side of an album contained about thirty minutes of music. At the end of a side, the music would stop and the listener needed to physically flip the disc over to restart the music. While at first glance this break only inconvenienced the listener, in reality, it served two important functions—it signaled the end of a segment of music, and it imposed silence upon the listener for at least a few seconds. When recording music for release on albums, many artists used the forced silence in between sides as an artistic tool and consciously created album sides with themes. Like a sorbet served between the courses of a gourmet meal, the silence cleansed the aural palate. For example, side one of the Beatles’ *Abbey Road* ends with a bluesy, hard-driving number entitled *I Want You*, replete with sexual overtones.¹⁴⁰ Side two, in contrast, begins with the pleasant, hopeful acoustic number, *Here Comes the Sun*.¹⁴¹ Like a symphony divided into movements, the albums were divided into sides.

In short, listening to an album was not just an exercise in auditory perception but an engrossing audiovisual adventure. In those days, when one discussed an “album,” one was not speaking only of the music, but one was referring to the whole package—the music, the cover, the clues, the sides, the backward masking—the adventure.¹⁴² Perhaps rock musician Frank Zappa put it best when, in the liner notes of his popular *Hot Rats* album, he printed, “This movie for your ears was produced & directed by Frank Zappa.”¹⁴³

B. Attention CD Listeners

During the 1980s and 1990s, the burgeoning popularity of compact disks caused many of these albums to be transferred onto compact disks and re-released. With this transfer came the destruction of the album as an art form.

Large cardboard album covers were shrunk to the size of a postcard and encased in a hard plastic shell. With this reduction in scale, all detail was lost. A teenager could no longer lose himself in the intricacies of the cover art of *Sergeant Pepper's* or *Led Zeppelin III* while his headphones blasted the music into his skull, simply because the cover is now too small, and the hard plastic shell dictates abandonment of any unusual characteristics of the original packaging (like a zipper).

***360** Along with the mutilation of the album artwork, the transfer of albums to compact disk destroyed the division of albums into sides. When one listens to a compact disc containing music originally intended to be heard on vinyl, the music is not segmented into sides; the album has become one giant musical behemoth. There are no pauses where, on vinyl, one side ended and another began. Songs that were meant to signify the end or the beginning of a side are now buried in the middle of a mass of music. *I Want You* is now followed immediately by *Here Comes the Sun*. Without the pause, the themes of album sides are destroyed.¹⁴⁴ There is nothing to signal to the listener that the artist originally intended an album to be heard as a set of two or four movements rather than as a unified whole; the recording artist's original intent is lost on the CD listener.

C. Black & White to Color = Vinyl to Compact Disk

In recent years, film producers have applauded the decision of France's highest civil court to preserve the right of filmmaker John Huston to object to the colorization of his classic film, *Asphalt Jungle*. The conversion of the film from black and white to color was found to have violated Huston's right of integrity. In the United States, a powerful lobby has been mobilized seeking the grant to filmmakers the moral right to prevent such unauthorized alterations in the United States. This lobby has produced modest results.¹⁴⁵

Unfortunately, few have challenged the transfer of vinyl albums to compact disk, which similarly mutilates these works. The time has come for recording artists to organize themselves, like the filmmakers, and to lobby for legislation that protects their artistic integrity. While the wholesale grant of moral rights to recording artists is unlikely, significant gains can be made. Just as filmmakers have succeeded in preserving some films and in forcing studios to inform viewers when a movie has been altered,¹⁴⁶ recording artists could also force Congress and record manufacturers to take appropriate steps to protect their rights as artists.

***361 VIII. The Need for Broader Federal Moral Rights Law**

Adherence to the Berne Convention required the United States to recognize and protect the rights of attribution and integrity inherent in all authors. However, contrary to Congress's belief, sufficient moral rights protection—especially for recording artists—does not lie buried in various U.S. laws. The Visual Artists Rights Act excludes recording artists from its scope, the Lanham Act is applied inconsistently nationwide, and other state law theories, such as contract law, form too tenuous and unreliable bases for moral rights claims. Further federal moral rights legislation would eliminate inconsistencies, provide nationwide uniformity for protection of the moral rights of recording artists, and bring the United States into full compliance with the Berne Convention.

IX. Conclusion

Current American copyright law deems sound recordings unworthy of full protection, and American moral rights law elevates economic considerations over artistic concerns. Repealing section 114(b) of the copyright code and passing federal legislation granting greater moral rights protection to recording artists would reverse this unfortunate state of affairs. Recording artists would then acquire the needed tools for protection of their works against plagiarism and mutilation. But perhaps more importantly, Congress would recognize the value of sound recordings as a modern art form and a national treasure. Sound recordings would then truly be soundly protected.

^a A.B. 1993, J.D. 1996, Georgetown University. Mr. Saadi was admitted to the State Bar of California in 1996. During law school he interned for the Walt Disney Company. He still prefers his albums on vinyl.

¹ 17 U.S.C.A. § 114(b) (West Supp.1997).

² This tale is based on a true story. The case was later settled.

³ Success seems to attract such claims; otherwise the economics of litigation would render them unprofitable to pursue.

⁴ U.S. CONST. art. I, § 8, cl. 8. This clause states in relevant part: “The Congress shall have the Power … To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” *Id.*

⁵ 17 U.S.C. § 102(a) (1994) (“Copyright protection subsists … in original works of authorship fixed in any tangible medium of expression....”).

⁶ 17 U.S.C.A. § 106 (West Supp.1997):

[T]he owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works … to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of digital audio transmission.

Id.

⁷ REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW, 87TH CONG., 1ST SESS. 3 (Comm. Print 1961). In particular, Congress stated:

“The enactment of copyright legislation by Congress under the terms of the Constitution is not based upon any natural right that the author has in his writings … but upon the ground that the welfare of the public will be served and progress of science and useful arts will be promoted by securing to authors for limited periods the exclusive rights to their writings.

Id. at 5 (quoting H.R.REP. NO. 60-222).

⁸ 17 U.S.C. § 102(a)(2) (1994).

⁹ 17 U.S.C. § 101 (1994) defines a sound recording as the fixation of a series of sounds other than those accompanying a motion picture or other visual work. For purposes of sound recordings, a work is “fixed” if it can be “perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” 17 U.S.C. § 101.

¹⁰ See 17 U.S.C. § 102.

¹¹ See 17 U.S.C.A. § 114(a) (West Supp.1997) (“The exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), (3), and (6) of section 106, and do not include any right of performance under section 106(4).”). Many excellent articles have advocated enactment of a broader performance right for sound recordings. Further exploration of that topic is outside the scope of this paper. See William H. O’Dowd, Note, *The Need for a Public Performance Right in Sound Recordings*, 31 HARV. J. ON LEGIS. 249 (1994). See also Jonathan Franklin, *Pay to Play: Enacting a*

Performance Right in Sound Recordings in the Age of Digital Audio Broadcasting, 10 U. MIAMI ENT. & SPORTS L. REV. 83, 84 (1993). Note that Section 106(6) was not added until recently when Congress passed the Digital Performance Right in Sound Recordings Act of 1995, Pub. L. No. 104-39, 109 Stat. 336, Nov. 1, 1995.

¹² See 17 U.S.C.A. § 114(b) (West Supp.1997).
The exclusive right of the owner of copyright in a sound recording under clause (1) of section 106 is limited to the right to duplicate the sound recording in the form of phonorecords ... that directly or indirectly recapture the actual sounds fixed in the recording. The exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 is limited to the right to prepare a derivative work in which the actual sounds fixed in the sound recording are rearranged, remixed, or otherwise altered in sequence or quality. The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording.
Id. (emphasis added).

¹³ *Id.*

¹⁴ Davis v. Trans World Airlines, 297 F.Supp. 1145, 1147, 160 U.S.P.Q. (BNA) 767, 768 (C.D. Cal. 1969).

¹⁵ 17 U.S.C.A. § 115(a)(1) (West Supp.1997) (“When phonorecords of a nondramatic musical work have been distributed to the public in the United States under the authority of the copyright owner, any other person, including those who make phonorecords or digital phonorecord deliveries, may, by complying with the provisions of this section, obtain a compulsory license to make and distribute phonorecords of the work.”).

¹⁶ See H.R. REP. NO. 94-1476, at 106 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5721 (“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.”).

¹⁷ See H.R. REP. NO. 94-1476, at 61, reprinted in 1976 U.S.C.C.A.N. 5659, 5675. Congress has stated that “departures or variations from the copyrighted work would still be an infringement as long as the author’s ‘expression’ rather than merely the author’s ‘ideas’ are taken. An exception to this general principle, applicable to the reproduction of copyrighted sound recordings, is specified in section 114.” *Id.*

¹⁸ See Arnstein v. Porter, 154 F.2d 464, 468, 68 U.S.P.Q. (BNA) 288, 293 (2d Cir.1946) (holding that in the absence of an admission of copying, substantial similarity and evidence of access constitute a *prima facie* case of infringement of the right to reproduce).

¹⁹ Bright Tunes Music Corp. v. Harrisongs Music, Ltd., 420 F.Supp. 177, 179-81 (S.D.N.Y. 1976), *aff’d*, 722 F.2d 988, 221 U.S.P.Q. (BNA) 490 (2d Cir.1983). The court held that former Beatle George Harrison had subconsciously infringed upon a popular musical work. 420 F.Supp. at 180-81. The court also inferred access because the protected song was a major hit. See *id.* at 178-79.

²⁰ See REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW, 87TH CONG., 1ST SESS. 3 (Comm. Print 1961).

²¹ U.S. CONST. art I, § 8, cl. 8.

²² Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711, 714-15, 168 U.S.P.Q. (BNA) 12, 14-15 (9th Cir.1970).

²³ *Id.* at 714, 168 U.S.P.Q. at 14.

²⁴ *Id.* at 714-15, 168 U.S.P.Q. at 14-15.

²⁵ 341 N.E.2d 817, 190 U.S.P.Q. (BNA) 573 (N.Y. 1975).

²⁶ *Id.* at 818-19, 190 U.S.P.Q. at 574.

²⁷ *Id.* at 820-21, 190 U.S.P.Q. at 575-76.

²⁸ *Id.* at 820, 190 U.S.P.Q. at 575-76.

²⁹ *In re Magnetic Video Corp.*, 86 F.T.C. 1515 (1975).

³⁰ *Id.* at 1517.

³¹ *Id.* at 1519.

³² *Id.* at 1520-22.

³³ *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 168 U.S.P.Q. (BNA) 12 (9th Cir.1970).

³⁴ *Id.* at 712, 168 U.S.P.Q. at 13.

³⁵ *Id.* at 114, 117-18, 168 U.S.P.Q. at 14, 17.

³⁶ *Id.* at 714, 168 U.S.P.Q. at 14.

³⁷ *Id.* at 717-18, 168 U.S.P.Q. at 17.

³⁸ See generally *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 822 (9th Cir.1974) (reviewing the common law doctrine of misappropriation in California). This case involved the alleged misappropriation of a famous race-car driver's distinguishing characteristic, his car.

³⁹ 849 F.2d 460, 7 U.S.P.Q.2d (BNA) 1398 (9th Cir.1988).

⁴⁰ *Id.* at 461, 7 U.S.P.Q.2d at 1399.

⁴¹ *Id.*

⁴² *Id.* at 463, 7 U.S.P.Q.2d at 1400 (citing *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir.1974)).

⁴³ *Id.*, 7 U.S.P.Q.2d at 1401.

⁴⁴ *Id.* at 463-64, 7 U.S.P.Q.2d at 1401.

⁴⁵ See 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01 [B][3][b] (1996).

⁴⁶ *See id.*

⁴⁷ See CAL. CIV. CODE § 3344 (West Supp.1997).

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

Id.; see also N.Y. CIV. RIGHTS LAW § 51 (McKinney Supp.1997).

Any person whose name, portrait, picture or voice is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained ... may maintain an equitable action ... against the person, firm or corporation so using his name, portrait, picture, or voice... and may also sue and recover damages for any injuries sustained

N.Y. CIV. RIGHTS LAW § 51.

⁴⁸ See MASS. GEN. LAWS ANN. ch. 214, § 3A (West 1989); KY. REV. STAT. ANN. § 391.170 (Michie 1984).

⁴⁹ 513 F.Supp. 1339, 211 U.S.P.Q. (BNA) 415 (D.N.J. 1981).

⁵⁰ *Id.* at 1359, 211 U.S.P.Q. at 435.

⁵¹ *See supra* Parts III.A-C.

⁵² *See supra* note 12.

⁵³ 17 U.S.C. § 301(b) (1994) states in relevant part:

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

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

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

Id.

⁵⁴ 849 F.2d 460, 7 U.S.P.Q. (BNA) 1398 (9th Cir.1988).

⁵⁵ *Midler*, 849 F.2d at 462, 7 U.S.P.Q.2d at 1400 ("A voice is not copyrightable. The sounds are not 'fixed.'"). The doctrine of voice misappropriation as defined in *Midler* was later reexamined and validated in *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 23 U.S.P.Q.2d (BNA) 1721 (9th Cir.1992), cert. denied, 506 U.S. 1080 (1993).

⁵⁶ See *Roy Export Co. v. Columbia Broad. Serv., Inc.*, 672 F.2d 1095, 215 U.S.P.Q. (BNA) 289 (2d Cir.1982); *United States Trotting Ass'n v. Chicago Downs Ass'n, Inc.*, 665 F.2d 781 (7th Cir.1981).

⁵⁷ *Motown Record Corp. v. George A. Hormel & Co.*, 657 F.Supp. 1236, 1240, 3 U.S.P.Q.2d (BNA) 1124, 1127 (C.D. Cal. 1987).

58 See MASS. GEN. LAWS ANN. ch. 214, § 3A (West 1989); KY. REV. STAT. ANN. § 391.170 (Michie 1984).

59 *Uhlaender v. Henricksen*, 316 F.Supp. 1277, 1282 (D.Minn. 1970) (“[I]dentity, embodied in [a person’s] name, likeness, statistics and other personal characteristics, is the fruit of [a person’s] labors and is a type of property.”).

60 *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d, 711, 714, 168 U.S.P.Q. (BNA) 12, 14 (9th Cir.1970).

61 *Id.* at 714, 168 U.S.P.Q. at 14-15.

62 See *In re Magnetic Video Corp.*, 86 F.T.C. 1515, 1520 (1975).

63 *Waits*, 978 F.2d 1093, 1101, 23 U.S.P.Q.2d (BNA) 1721, 1726 (9th Cir.1992) (“A voice is distinctive if it is distinguishable from the voices of other singers ... [and] if it has particular qualities or characteristics that identify it with a particular singer.”).

64 *Id.* at 1102, 23 U.S.P.Q.2d at 1727 (“A professional singer’s voice is widely known if it is known to a *large number* of people throughout a *relatively large* geographic area.”).

65 *Midler*, 849 F.2d, 460, 463, 7 U.S.P.Q. 1398, 1401 (9th Cir.1988) (holding 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”).

66 *Sinatra*, 435 F.2d at 712, 168 U.S.P.Q. at 12.

67 *Midler*, 849 F.2d at 461, 7 U.S.P.Q.2d at 1399.

68 See Robert T. Mowrey, *The Rise and Fall of Record Piracy*, 27 COPYRIGHT L. SYMP. (ASCAP) 155, 179 (1982); see also H.R. REP. NO. 90-83, at 65-66 (1967).

69 H.R.REP. NO. 90-83, at 65-66.

70 See *supra* note 11.

71 Jerry Leiber and Mike Stoller composed many of Presley’s masterpieces, including *Jailhouse Rock* and *Treat me Nice*.

72 Many recording contracts provide the recording artist with royalties on the sale of phonorecords of his performance.

73 See *Midler v. Ford Motor Co.*, 849 F.2d 460, 7 U.S.P.Q.2d (BNA) 1398 (9th Cir.1988); *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 168 U.S.P.Q. (BNA) 12 (9th Cir.1970).

74 Plaintiffs would also have to present evidence of defendant’s access to the protected work. See *Arnstein v. Porter*, 154 F.2d 464, 468, 68 U.S.P.Q. (BNA) 288, 293 (2d Cir.1930); see *supra* note 18.

75 A sound recording is classified as a derivative work based upon the underlying composition. When an artist’s recording makes an original compositional contribution to the underlying song, the artist creates not only a copyrightable sound recording, but also a

new composition which could also be a copyrightable derivative work. As the owner of the copyright in this new composition, the artist can protect his original contribution to the underlying work, that is, his own particular arrangement or instrumentation. Thus the deficiencies of section 114 are in large part remedied by the fact that an imitation (which cannot violate the copyright in the sound recording) may nevertheless violate the copyright in the recording artist's original contributions to the *composition*. Such circuitous protection is tenuous because so many elements of sound recordings, such as style, voice, sound effects, feedback, or the distortion obtained through the use of a "whammy bar," for example, are not expressible in the language of the composition.

⁷⁶ Bob Dylan composed the music and lyrics of *All Along the Watchtower* and recorded it in folk-rock acoustic style. Hendrix's version is a much heavier electric-based rendition. Legend has it that Hendrix's rendition of the song so impressed Dylan that Dylan went "electric" for several years thereafter.

⁷⁷ Presley was known to have been in total control of every recording session he attended during his twenty years on the RCA label; he was, in essence, his own producer.

⁷⁸ JERRY HOPKINS & DANNY SUGERMAN, NO ONE HERE GETS OUT ALIVE 219 (1980).

⁷⁹ See JOHN DENSMORE, RIDERS ON THE STORM (1990). Densmore was The Doors' drummer throughout their career.

⁸⁰ With the help of Microsoft co-founder Paul Allen, Hendrix's father has made great strides in regaining control of his son's work.

⁸¹ Sean Piccoli, *Let Jimi Take Over—No Slight Return for this Guitar Great as the Hendrix Legacy Catches Fire*, THE WASH. TIMES, July 8, 1993, at E1.

⁸² *Id.*

⁸³ *Outtakes: Bold as Love—Doing Right by Jimi Hendrix's Last Recordings*, ENT. WKLY, April 21, 1995, at 54.

⁸⁴ One small exception to this rule is embodied in 17 U.S.C. § 106A (1994), which grants rights of attribution and integrity to authors of works of visual art. "Works of visual art" include some paintings, drawings, prints, sculptures, and photographic images that exist in a single copy or fewer than 200 copies. 17 U.S.C. § 101 (1994).

⁸⁵ 17 U.S.C. § 201 (1994), entitled "Ownership of Copyright," provides in relevant part:

(a) INITIAL OWNERSHIP. Copyright in a work protected under this title vests initially in the author ... of the work
(d) TRANSFER OF OWNERSHIP.

(1) The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed

(2) Any of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by section 106, may be transferred ... and owned separately. The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this title.

⁸⁶ Berne Convention for the Protection of Literary and Artistic Works, September 9, 1886, 828 U.S.T. 222, completed May 4, 1986 [hereinafter Berne].

⁸⁷ Deborah Ross, Comment, *The United States Joins the Berne Convention: New Obligations for Authors' Moral Rights?*, 68 N.C.L.REV. 363, 363 (1990).

⁸⁸ Berne, *supra* note 86, art. 6bis, 828 U.N.T.S. at 221, 235. It provides:

1. Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in

relation to, the said work, which would be prejudicial to his honor or reputation.

2. The rights granted to the author in accordance with the preceding paragraph shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed. However, those countries whose legislation, at the moment of their ratification or of accession to this Act, does not provide for the protection after the death of the author of all rights set out in the preceding paragraph may provide that some of these rights may, after his death, cease to be maintained.

3. The means of redress for safeguarding the rights granted by this article shall be governed by the legislation of the country where protection is claimed.

Id.

89 *Id.*

90 The Lanham Act is the primary federal trademark and unfair competition statute.

91 *See supra* note 84.

92 PETER GURALNICK, LAST TRAIN TO MEMPHIS—THE RISE OF ELVIS PRESLEY 57-65 (1994).

93 Robert Hilburn, *Earliest Elvis: Boy Who Would Be King*, THE LOS ANGELES TIMES, August 11, 1990, at F1.

94 Shostakovich v. Twentieth Century-Fox Film Corp., 80 N.Y.S.2d 575, 576, 77 U.S.P.Q. (BNA) 647, 648 (N.Y. Sup. 1948), *aff'd*, 87 N.Y.S.2d 430 (N.Y.A.D. 1949).

95 *Id.*

96 *Id.* at 578, 77 U.S.P.Q. at 649.

97 *Id.* at 579, 77 U.S.P.Q. at 649.

98 *See Berne, supra* note 86, art. 6bis, 828 U.N.T.S. at 235.

99 Granz v. Harris, 198 F.2d 585, 586 (2d Cir.1952).

100 *Id.*

101 *Id.*

102 *Id.*

103 *Id.* at 586-87.

104 *Id.* at 587.

105 *Id.*

106 *Id.* at 586.

107 *Id.* at 590.

108 *Id.* at 587.

109 *Id.*

110 *See id.* at 587-88.

111 *Id.* at 587-88.

112 *Id.* at 588 (citations omitted).

113 *Id.*

114 198 F.2d at 590 (Frank, J., concurring).

115 *Id.* (Frank, J., concurring).

116 *Id.* at 591 (Frank, J., concurring).

117 Rich v. RCA Corp., 390 F.Supp. 530, 185 U.S.P.Q. (BNA) 508 (S.D.N.Y. 1975).

118 *Id.* at 530, 185 U.S.P.Q. at 508.

119 “Any person who shall affix ... or use in connection with any goods ... any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods ... to enter into commerce ... shall be liable to a civil action ... by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.” 15 U.S.C. § 1125(a) (1994).

120 *Rich*, 390 F.Supp. at 530, 185 U.S.P.Q. at 508.

121 *Id.* at 531, 185 U.S.P.Q. at 508.

122 *Id.*, 185 U.S.P.Q. at 509.

123 Gilliam v. American Broad. Co., 538 F.2d 14, 192 U.S.P.Q. (BNA) 1 (2d Cir.1976).

124 *Id.* at 18, 192 U.S.P.Q. at 3.

125 *Id.*

126 *Id.* at 23-24, 192 U.S.P.Q. at 8.

127 *Id.* at 24, 192 U.S.P.Q. at 8 (citations omitted).

128 *Id.* at 24-25, 192 U.S.P.Q. at 9 (citations omitted).

129 *Id.*

130 Lamothe v. Atlantic Recording Corp., 847 F.2d 1403, 1405, 7 U.S.P.Q.2d (BNA) 1249, 1250 (9th Cir.1988).

131 *Id.*

132 *Id.*

133 *Id.* at 1406, 7 U.S.P.Q.2d at 1251.

134 Granz v. Harris, 198 F.2d 585, 588 (2d Cir.1982).

135 198 F.2d at 590 (Frank, J., concurring).

136 Halicki v. United Artists Communications, Inc., 812 F.2d 1213, 1214, 2 U.S.P.Q.2d (BNA) 1234, 1235 (9th Cir.1987).

137 Spring Mills, Inc. v. Ultracashmere House, Ltd., 689 F.2d 1127, 1129, 217 U.S.P.Q. (BNA) 298, 301 (2d Cir.1982).

138 Rock music is replete with examples. Perhaps the most famous album cover is that of THE BEATLES, SERGEANT PEPPER'S LONELY HEARTS CLUB BAND (Capitol Records 1967), which featured a photograph of the four Beatles along with cardboard cut-outs of about sixty historical figures ranging from Edgar Allen Poe to Marlon Brando to Karl Marx. The cover of the album THE ROLLING STONES, STICKY FINGERS (Atlantic Records 1971) was designed by Andy Warhol and featured a real working zipper incorporated into the crotch of a pair of men's trousers.

139 Led Zeppelin also took great pleasure in designing complex album covers. The cover of their third release, aptly titled LED ZEPPELIN III (Atlantic Records 1970), contained nine circular holes of various sizes. A cardboard disk containing photographs of the band and assorted psychedelic images was attached to the cover. When the listener spun the cardboard disk, the album cover came alive as fascinating, fluid images appeared through the holes in the cover. On PHYSICAL GRAFFITI (Atlantic Records 1975), a double album, the cover consisted of a photograph of row houses whose windows were cut out, revealing the printing on the record sleeve inside. The purchaser could see only pulled white window blinds through each hole. However, removal of the outermost sleeve revealed a set of bizarre and mysterious images, strategically placed on the inner sleeves to show through the windows. Removing one sleeve from the cover and replacing it with the other transformed the cover entirely.

139 THE BEATLES, MAGICAL MYSTERY TOUR (Capitol Records 1967) actually folded open into a 24-page booklet.

¹⁴⁰ THE BEATLES, ABBEY ROAD (Capitol Records 1969).

¹⁴¹ *Id.*

¹⁴² PINK FLOYD, THE WALL (Columbia Records 1980) is one of the best examples of the various parts of an album coming together to form a whole that is more than the sum of its parts. The album used a wall as a multifaceted metaphor. Each album side had a theme—a fatherless childhood, alienation, drug addiction and suicide, and finally redemption. The cover art was a plain white brick wall, lacking even the lettering necessary to identify the artist or the title of the album.

¹⁴³ FRANK ZAPPA, HOT RATS (Warner Brothers Records 1969).

¹⁴⁴ Musician Tom Petty made the deficiencies of compact disks painfully clear on his album FULL MOON FEVER (MCA Records 1989). Halfway through the CD version of the album, there is a break in the music titled “Attention CD listeners.” The segment features Petty and musicians Del Shannon and Jeff Lynne impersonating barnyard animals, over which a narrator explains: “We’ve come to the point in this album where those listening on cassette or records will have to stand up or sit down and turn over the record or tape. In fairness to those listeners, we’ll now take a little break before we begin side two.” TOM PETTY, FULL MOON FEVER (MCA Records 1989).

¹⁴⁵ In 1988, President Reagan signed into law the National Film Preservation Act of 1988, which offered limited protection to some films. *See* Act of September 27, 1988, Pub. L. No. 100-446, tit. I, § 1, 102 Stat. 1782, *repealed* by National Film Preservation Act of 1992, Pub. L. 102-307, tit. II, § 214, 106 Stat. 272. This act was repealed and replaced in 1992 by the National Film Preservation Act of 1992 codified at 2 U.S.C. § 179 (1994).

¹⁴⁶ In 1993, every major Hollywood studio agreed to inform viewers of films on television, cable, videocassette, and other formats when a movie has been altered from the original intent of its creators. David Fox, *MPAA Orders Labeling of Films Altered for Home Viewing*, THE LOS ANGELES TIMES, October 29, 1993 at F2.