

WHOSE VOICE IS IT ANYWAY? *MIDLER v. FORD MOTOR CO.*

I. INTRODUCTION

In the twentieth century, new commercials are aired daily, voices are heard by millions of people world-wide, and technology has advanced to the point where sounds can be disseminated at the touch of a button. It is also an age in which, because of these developments, celebrities' voices are often misappropriated and the public is deceived. As a result, voice imitation actions have risen to the forefront,¹ each day bringing forth the filing of new soundalike claims.²

In light of the increasing number of soundalike actions, a plaintiff must be well-versed in the different types of claims and the success rates of the various causes of action. Recently, the Ninth Circuit, in *Midler v. Ford Motor Co.*,³ recognized that "[a] voice is as distinctive and personal as a face"⁴ and is equally deserving of protection.⁵ This Comment examines several independent grounds for liability in a voice imitation claim and imports the significance of including a Lanham Act trademark claim.⁶

Part II presents the facts and causes of action in *Midler*.⁷ Part

¹ Voice imitation claims, and Ms. Midler's lawsuit in particular, have been the subject of several recent articles. See, e.g., Anderson, *Soundalike Suit*, A.B.A. J., Jan. 1990, at 24 [hereinafter Anderson]; Bishop, *When the Sincerest Form of Flattery Is Also Larceny*, N.Y. Times, July 21, 1989, at B9, col. 3; Marks, *An End to Judicial Resistance Toward Vocal Imitation Claims?*, Nat'l L.J., Feb. 20, 1989, at 20; Marks, *The Bette Midler Case: Judiciary Finally Listens to Soundalike Claim*, N.Y.L.J., Oct. 5, 1988, at 1, col. 1.

² For example, recently in a Los Angeles federal court, singer Tom Waits filed suit against Frito-Lay and its advertising agency. Waits claims that the defendants misappropriated his unique rendition of "Nighthawks at the Diner." See *Waits Sues Frito-Lay For Aping Voice in Ad*, Variety, Nov. 9, 1988, at 53, col. 2; Anderson, *supra* note 1, at 24. See also *Singers Howl Over Copycat Ads*, Newsday, Oct. 15, 1989, at 55, col. 1.

³ 849 F.2d 460 (9th Cir. 1988). On October 30, 1989, the Federal District Court in Los Angeles ordered Young and Rubicam to pay \$400,000 to Bette Midler for tortious imitation of her voice. Midler had sought \$10,000,000 in damages. Anderson, *supra* note 1, at 24. See Stevenson, *Midler Case Stirs Debate on "Alikes"*, N.Y. Times, Nov. 1, 1989, at D19, col. 1; Ramirez, *Y & R Ordered to Pay Midler*, N.Y. Times, Oct. 31, 1989, at D21, col. 4.

⁴ *Id.* at 463.

⁵ Although celebrity lookalike actions have been recognized in the past, until *Midler*, soundalike actions had been virtually nonexistent. Although soundalike actions are often based in part upon the Lanham Act, 15 U.S.C. §§ 1051-1127 (1982 & Supp. V 1987), Ms. Midler did not include a Lanham Act claim in her complaint.

⁶ One commentator has stated that the Lanham Act "has become a 'catch-all' for undefined unfair competition." Ropski, *The Right of Publicity and the Celebrity Look-Alike: Now Section 43(a) Proscribes Faces That Deceive*, 77 TRADEMARK REP. 31, 47 (1987) [hereinafter Ropski].

⁷ See *infra* notes 14-23 and accompanying text.

III examines the means of overcoming the potential bar to Federal Copyright Act claims.⁸ Part IV explores the ambiguity of both privacy⁹ and publicity¹⁰ statutes in New York and California.¹¹ Part V analyzes common law unfair competition claims in both California and New York.¹² Part VI focuses on the Lanham Act and discusses the importance of including this claim in voice imitation complaints.¹³ Finally, this Comment concludes that, of the various causes of action, the Lanham Act provides voice imitation litigants with the most promising basis for relief.

II. *MIDLER v. FORD MOTOR CO.*

Bette Midler, the performer, initiated *Midler v. Ford Motor Company*¹⁴ in federal court. She sued the advertising agency Young and Rubicam ("Y & R") regarding a commercial they created for co-defendant Ford Motor Company ("Ford").¹⁵ The Ford campaign was developed to target "yuppies" by focusing on their fascination with the popular music of the Seventies.¹⁶ The advertising agency sought to maximize the pre-existing affinity the intended audience had for the performers. The campaign

⁸ See *infra* notes 24-47 and accompanying text.

⁹ The privacy right has several forms: "(1) physical intrusion upon plaintiff's solitude or seclusion; (2) public disclosure of embarrassing private facts; (3) publicity that puts the plaintiff in a false light in the public eye; and (4) misappropriation for commercial use of the plaintiff's name or image." Moskin, *Make Room for the Stars: Copyright Preemption and the Right of Publicity*, 33 COPYRIGHT L. SYMP. (ASCAP) 159, 164 n.36 (1987) [hereinafter Moskin]. These four privacy rights are embodied in the RESTATEMENT (SECOND) OF TORTS § 652A (1977).

¹⁰ The right of publicity is defined as "the right of each person to control and profit from the publicity values which he has created or purchased." Note, *Trademark Infringement and the Right of Publicity: Protecting the Persona*, 5 LOY. L.A. ENT. L.J. 251, 262 (1985) [hereinafter *Protecting the Persona*].

¹¹ See *infra* notes 48-77 and accompanying text.

¹² While the lack of direct competition frequently bars voice imitation claims under unfair competition in California, in New York, despite the absence of the direct competition prerequisite, unfair competition litigants are often barred from recovery due to federal policy considerations. See *infra* notes 78-96 and accompanying text.

¹³ Like California law, the common law mandates an unfair competition prerequisite of direct competition. This prerequisite may bar many future litigants from bringing a voice imitation claim. The Lanham Act contains no such direct competition prerequisite, and consequently, does not serve as a bar to potential litigants. See *infra* notes 97-135 and accompanying text.

¹⁴ 849 F.2d 460 (9th Cir. 1988).

¹⁵ The district court exercised subject matter jurisdiction pursuant to 28 U.S.C. § 1332(a). Ms. Midler is a citizen of California. Defendant Ford is a Delaware corporation with its principal place of business in the state of Michigan. Defendant Young and Rubicam ("Y & R") is a New York corporation with its principal place of business in New York. *Midler v. Ford Motor Co.*, No. 86 Civ. 2683 (C.D. Cal. Aug. 17, 1987) (Statement of Uncontroverted Facts, paras. 1-3), *rev'd*, 849 F.2d 460 (9th Cir. 1988).

¹⁶ *Midler*, 849 F.2d at 461. Yuppies, "[s]ixties children, flower children, [and] the Me generation" are just a few of the names given to children born between 1946 and 1964. Reidinger, *Still Got Something to Say*, A.B.A. J., May 15, 1987, at 11.

consisted of nineteen popular songs incorporated into thirty- or sixty-second commercials, performed, when possible, by the original artists.¹⁷

After developing the campaign, Y & R was unsuccessful in signing all of the original performers of the songs they planned to use. Bette Midler was among the performers who declined Y & R's offer to perform in a commercial.¹⁸ Upon Midler's refusal, the advertising agency hired one of Ms. Midler's back-up singers to imitate her voice for the commercial.¹⁹ Ms. Midler alleged that the commercial resulted in confusion among "a number of people" because they believed the voice was actually hers.²⁰

Ms. Midler's lawsuit against Y & R and Ford for both damages and injunctive relief was based, in part, on California's right of privacy statute.²¹ Although the district court stated that the defendants' conduct resembled thievery, it granted the defendants' motion for summary judgment because it deemed that no legal principle supported Midler's claim for voice imitation.²² The Ninth Circuit reversed, holding that not only did Ms. Midler have a common law property right in her voice, but also that the defendants had violated California tort law through conscious misappropriation.²³

¹⁷ *Id.*

¹⁸ Y & R had requested that Ms. Midler perform "Do You Want To Dance," one of the songs on her 1973 album, "The Divine Miss M." *Midler*, 849 F.2d at 461.

¹⁹ Imitation is distinct from parody because:

[i]mitation . . . duplicate[s] the characteristics of another, either to delude the public or to compensate for an absence of creative effort . . . [whereas] parody . . . makes use of another's attributes as part of a larger presentation, in which a considerable amount of the content is provided by the parodist. . . . [Therefore,] imitation is generally actionable [and] parody, . . . protected.

Felcher and Rubin, *Privacy, Publicity and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1605 (1979) [hereinafter Felcher and Rubin]. See, e.g., *Lahr v. Adell Chem. Co.*, 300 F.2d 256 (1st Cir. 1962) (unfair competition claims based on commercial employing imitation of Mr. Lahr's voice found actionable); *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661 (2d Dep't 1977) (right of publicity claim based on commercial depicting imitation of Lombardo as "Mr. New Year's Eve" stated valid cause of action); *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541 (2d Cir.), *cert. denied*, 379 U.S. 822 (1964) (Mad Magazine parody of Berlin's song lyrics was protected speech).

²⁰ *Midler*, 849 F.2d at 461-62.

²¹ CAL. CIV. CODE § 3344 (West Supp. 1989). See *infra* note 51 and accompanying text. Plaintiff's first amended complaint also asserted causes of action for (1) invasion of privacy; (2) infringement of right of publicity; and (3) unfair competition. *Midler v. Ford Motor Co.*, No. 86 Civ. 2683 (C.D. Cal. Aug. 17, 1987) (Statement of Uncontroverted Facts, para. 18), *rev'd*, 849 F.2d 460 (9th Cir. 1988).

²² *Midler*, 849 F.2d at 462.

²³ *Id.* at 463.

III. FEDERAL PREEMPTION OF COPYRIGHT LAWS

Section 301(a) of the Copyright Act of 1976²⁴ establishes the federal preemption doctrine as follows:

On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103 . . . are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.²⁵

Thus, the preemption doctrine is a hurdle to overcome before a soundalike claimant can set forth a state law claim.²⁶

The preemption doctrine, which originates from the supremacy clause of the Constitution,²⁷ provides that the Constitution "and the Laws of the United States which shall be made in Pursuance thereof . . . shall be the supreme Law of the Land . . . any Thing in the Constitution or Laws of any State to the Contrary notwithstanding-

²⁴ 17 U.S.C. § 301(a) (1988).

²⁵ *Id.* The first amendment, in addition to the copyright laws, protects much of the media's reproduction, or imitation of likenesses or sounds. The first amendment provides that "Congress shall make no law . . . abridging the freedom of speech, or of the press. . . ." U.S. CONST. amend. I.

Although the first amendment embodies the concept of providing a forum of ideas, there are times when this freedom should be curtailed. *See Onassis v. Christian Dior-New York, Inc.*, 122 Misc. 2d 603, 472 N.Y.S.2d 254, 262 (Sup. Ct. 1984) (advertisement using a lookalike of Ms. Onassis was an unprotected form of speech); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 727 (S.D.N.Y. 1978) (court held there was "no such informational or newsworthy dimension to defendants' unauthorized use of Ali's likeness"). Furthermore, when the speech exploits one's identity, creating a "calculated falsehood," courts will not grant immunity. *Time, Inc. v. Hill*, 385 U.S. 374, 390 (1967).

For a discussion of the first amendment in relation to media portrayals, see generally Felcher and Rubin, *supra* note 19. Felcher and Rubin suggest that if the purpose of the portrayal "serves an informative or cultural function, it will be immune from liability . . . [but, if it] merely exploits the individual portrayed, immunity will not be granted." *Id.* at 1596. There are also countervailing first amendment social policies supporting portrayal law suits: (1) the constraint on individuals' activities; (2) the guarantee of fair commercial practice; and (3) the encouragement of personal endeavor. *Id.* at 1601.

²⁶ Nimmer, in his copyright treatise, describes the preemption test as follows: [A] right which is "equivalent to copyright" is one which is infringed by the mere act of reproduction, performance, distribution or display If under state law the act of reproduction, performance, distribution or display . . . will *in itself* infringe the state created right, then such right is preempted. But if other elements are required, in addition to or instead of, the acts of reproduction, performance, distribution or display, in order to constitute a state created cause of action, then the right does not lie "within the general scope of copyright," and there is no preemption.

1 M. & D. NIMMER, NIMMER ON COPYRIGHT § 1.01[B][1], at 1-12 to -13 (1989) (emphasis added).

²⁷ U.S. CONST. art. VI, § 2.

ing.”²⁸ It recognizes that “federal copyright protection is superior to any and all other state remedies dealing with the area,”²⁹ and therefore, federal law must always control. The *Midler* court held that the action was not preempted under the federal doctrine because Midler was seeking damages for the unauthorized use of her voice, and voices are not copyrightable.³⁰

It is difficult to reconcile the legislative intent of United States copyright law³¹ with the holdings of *Midler*, *Sinatra v. Goodyear Tire & Rubber Co.*,³² and *Booth v. Colgate-Palmolive Co.*³³ In *Sinatra*, the celebrity plaintiff’s unfair competition and voice impersonation claims against Goodyear were dismissed because Goodyear had obtained permission from the copyright holder to use the song “These Boots Are Made For Walkin’.”³⁴ The court held that recognition of Nancy Sinatra’s claims would conflict with the purpose of copyright law, which is to protect the rights of those who obtain a copyright or license for the song or arrangement.³⁵ Ms. Sinatra had neither a copyright nor a license to use the song. Similarly, in *Booth*, actress Shirley Booth failed to state an unfair competition claim against both the advertiser and the advertising agency that produced a commercial using an imitation of her “Hazel” character and voice.³⁶

²⁸ *Id.*

²⁹ A. MILLER & M. DAVIS, *INTELLECTUAL PROPERTY PATENTS, TRADEMARKS, & COPYRIGHT IN A NUTSHELL* 403 (1983) [hereinafter MILLER & DAVIS]. See A. LATMAN, R. GORMAN & J. GINSBURG, *COPYRIGHT FOR THE NINETIES* 765 (1989) [hereinafter *COPYRIGHT FOR THE NINETIES*].

³⁰ *Midler*, 849 F.2d at 462.

³¹ The legislative intent was to provide authors with “a means of securing the economic reward afforded by the market.” STAFF OF HOUSE COMM. ON THE JUDICIARY, 87th CONG., 1st SESS., *REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW* 6 (Comm. Print 1961). Another goal was, and remains, “to ensure that the return to the creator is a fair one.” Marks, *An Assessment of the Copyright Model in Right of Publicity Cases*, 32 *COPYRIGHT L. SYMP. (ASCAP)* 1, 11 n.41 (1982) [hereinafter Marks, *An Assessment*] (citations omitted). The ultimate goal of copyright law, however, is the stimulation of artistic creativity for the good of the public. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

³² 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971).

³³ 362 F. Supp. 343 (S.D.N.Y. 1973) (dismissal of unfair competition claim of Shirley Booth against an advertising agency and its client for creating a commercial employing an imitation of “Hazel” character and voice).

³⁴ *Sinatra*, 435 F.2d at 712-13.

³⁵ *Id.* at 717-18. Ms. Sinatra was unable to obtain protection for her voice in the song because her voice was considered an “intangible medium.” *Id.* “[O]ral works (such as improvised speeches), live jazz performances, and live demonstrations . . . are frequently never fixed in a tangible medium of expression.” *COPYRIGHT FOR THE NINETIES*, *supra* note 29, at 762. See also MILLER & DAVIS, *supra* note 29, at 302 (“A speech, lecture, or other *vocal performance*, to the extent that it is not reduced to tangible form, is outside the Act.”).

³⁶ 362 F. Supp. at 345-48. “Hazel” was a popular television comedy series which aired from 1961 to 1965 on the National Broadcasting Company network, and from 1965-1966 on the Columbia Broadcasting Services network. Today, “Hazel” reruns are aired in various parts of the world.

The *Midler* holding's departure from those in both *Sinatra* and *Booth* may be partially due to the Copyright Act of 1976,³⁷ which modified the pre-existing federal copyright laws.³⁸ Section 301(a) was amended to protect the "works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright."³⁹ Future litigants may overcome the preemption doctrine by arguing, as *Midler* did, that under the Copyright Act of 1976, the damages sought are based upon a plaintiff's voice, which is an intangible medium of expression.⁴⁰ Furthermore, claimants may avoid the preemption doctrine by arguing that section 301(b),⁴¹

³⁷ *Midler* was decided after the Copyright Act of 1976 and *Sinatra* and *Booth*, *infra* notes 42-43, were decided prior to the 1976 Act. In both *Sinatra* and *Booth*, the plaintiffs were preempted by federal copyright law from bringing their actions. The defendants had obtained copyright protection for the underlying song which was a "tangible" form of expression. See *infra* note 42 for an early draft of the bill. However, Ms. *Midler*'s action was not preempted due to the Copyright Act of 1976 having specifically added sound recordings to the copyright protection provisions. 17 U.S.C. § 102(a)(7) (1982). See, e.g., *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236 (C.D. Cal. 1987). *Hormel* involved the use of a soundalike version of the Supremes' recording of "Baby Love" for a Dinty Moore beef stew commercial. The court held that the record company's claims were preempted by federal copyright law.

³⁸ In 1790, Congress adopted a copyright statute which has been revised four times to date: in 1831, 1870, 1909, and 1976. As new subjects were added, the scope of copyright protection enlarged. For instance, in 1802, Congress added prints; in 1831, musical compositions; in 1856, dramatic compositions; in 1865, photographs; and in 1870, "paintings, drawings, sculpture and models or designs for works of the fine arts." COPYRIGHT FOR THE NINETIES, *supra* note 29, at 7. See also MILLER & DAVIS, *supra* note 29, at 281-82. ("As new forms of expression became commercially important, the copyright law was revised or rewritten to protect the exploitation of those technologies.")

³⁹ 17 U.S.C. § 301(a) (1982).

⁴⁰ Copyright law protects "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102 (1982 & Supp. V 1987). Because creativity is the essence of the subject matter protected under copyright law, human features, whether physical or vocal, are not protected. They are "neither artistic works nor the products of intellectual creativity . . . [Thus, they are] not an original work of authorship in the copyright sense." Moskin, *supra* note 9, at 176.

Although musical scores have been copyrightable since 1831, recordings did not receive the same protection until 1909, when "the concept of a compulsory license was introduced into copyright law." COPYRIGHT FOR THE NINETIES, *supra* note 29, at 467. "[I]f the copyright proprietor himself used or sanctioned the use of his composition . . . any other person was free to do so upon paying a royalty . . . for each part (each roll or record) manufactured." *Id.* at 468. Thereafter, it was not until 1971 that "American copyright law [recognized] . . . sound recordings as copyrightable works." *Id.* at 84 (quoting H.R. Rep. No. 1476, 94th Cong., 2d Sess. 53-56 (1976)).

Composers presently have copyright protection for phonorecords as well as sound recordings because the former are "physical objects in which sounds are fixed" and the latter are "original works of authorship comprising an aggregate of musical, spoken or other sounds that have been fixed in tangible form." COPYRIGHT FOR THE NINETIES, *supra* note 29, at 84-85. However, imitations of sound recordings are specifically exempted from those rights held by the copyright owner. See Notes of Committee on the Judiciary, 17 U.S.C. § 114(b) (1982).

⁴¹ 17 U.S.C. § 301(b) (1982) provides in part:

(b) 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 copy-

which preserves certain rights such as privacy, publicity, and unfair competition, also preserves the right to bring an action.⁴²

Section 301's preemption provisions codified the holdings of two Supreme Court decisions: *Sears, Roebuck & Co. v. Stiffel Co.*⁴³ and *Compco Corp. v. Day-Brite Lighting, Inc.*⁴⁴ In each case, the Supreme Court held that states, under their individual unfair competition laws, could not protect intangible property rights in electrical lamps where the lamps did not qualify for protection under federal patent law.⁴⁵ Similarly, "a State may not, when the article is . . . *uncopyrighted*, prohibit the copying of the article itself or award damages for such copying."⁴⁶ Consequently, according to the Supreme Court, a claimant is not preempted from bringing a voice imitation action since voice is not capable of being copyrighted.⁴⁷

right as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression. . . .

Id.

⁴² An early draft of § 301(b)(3) read:

activities violating legal or equitable rights that are not equivalent to any of the executive rights within the general scope of copyright . . . including rights against misappropriation not equivalent to any of such exclusive rights, breaches of contract, breaches of trust, trespass, conversion, invasion of privacy, defamation, and deception [sic] trade practices such as passing off and false representation.

122 CONG. REC. 2823 (1976).

The above list of state claims which would not be preempted by federal law was not included in the final version of the section. Consequently, the courts are now left to determine which state law causes of action are equivalent to the rights included by the Copyright Act. *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236, 1238-39 (C.D. Cal. 1987).

In determining whether a state law cause of action, such as the right of publicity, is preempted by copyright law, a court considers three factors: (1) the history of the Copyright Act; (2) the form of the right's existence; and (3) the basic "occupation-of-field" analysis. With regard to the right of publicity, the history of the Act primarily negates the notion that Congress intended to place copyright and right of publicity on opposing sides, thereby prohibiting actions under right of publicity. Moreover, the right of publicity exists outside the bounds of copyright law. Finally, the occupation-of-field analysis does not indicate a congressional plan to include state actions in this area, nor does it demonstrate a congressional need to regulate the publicity right exclusively. *Moskin*, *supra* note 9, at 187.

⁴³ 376 U.S. 225, *reh'g denied*, 376 U.S. 973 (1964).

⁴⁴ 376 U.S. 234, *reh'g denied*, 377 U.S. 913 (1964).

⁴⁵ See *supra* notes 43-44. See generally The Patent Act of 1952, Pub. L. No. 593, 66 Stat. 792 (codified as amended at 35 U.S.C. §§ 1-376 (1982 & Supp. III 1985)).

⁴⁶ *Sears*, 376 U.S. at 232-33 (emphasis added). Courts permit material to be copied if it is uncopyrighted and unpatented because of "the strong federal policy favoring free competition in ideas which do not merit patent protection." *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 346 (S.D.N.Y. 1973) (quoting *Lear, Inc. v. Adkins*, 395 U.S. 653, 656 (1969)).

⁴⁷ *Midler*, 849 F.2d at 462 ("sounds are not 'fixed'"). See COPYRIGHT FOR THE NINETIES, *supra* note 29, at 86; MILLER & DAVIS, *supra* note 29, at 302 (voice is an intangible medium).

IV. THE RIGHTS OF PRIVACY AND PUBLICITY

The right of privacy statutes and the common law right to publicity differ in the interests they protect and injuries they compensate. Traditionally, the right of privacy compensates individuals for personal anguish when their identities are used for another's economic gain, whereas the right of publicity protects a celebrity's proprietary interest in his or her public identity.⁴⁸ The New York Court of Appeals has recently rejected this distinction, however, holding that the common law right of publicity is simply a misnomer for the privacy interest embodied in the civil rights law, and consequently, there is no separate cause of action for a publicity interest.⁴⁹

A. *Right of Privacy*

Various states which recognize a celebrity's right to benefit from his or her status have enacted privacy statutes.⁵⁰ California's privacy statute provides:

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, . . . of, products . . . without such person's prior consent . . . shall be liable for any damages sustained by the per-

⁴⁸ "The right to privacy protects against the *emotional* harm and injury to *feelings* that may accompany *unwanted* publicity . . . [while] publicity rights protect pecuniary, not personal, interests." Moskin, *supra* note 9, at 165-66 (emphasis in original). In addition to the substantive differences between the two rights, there are also technical distinctions. The right of privacy, because it is personal in nature, cannot be assigned and does not descend. *Id.* In contrast, the right of publicity is assignable and, in most jurisdictions, can descend as well. *Id.* Furthermore, celebrities are considered to have waived their privacy rights because they have voluntarily "inserted themselves into the public arena." *Id.* at 166. For a discussion of the right of publicity, see *Allen v. National Video, Inc.*, 610 F. Supp. 612, 621 (S.D.N.Y. 1985); *Brinkley v. Casablancas*, 80 A.D.2d 428, 438 N.Y.S.2d 1004, 1011 (1st Dep't 1981).

⁴⁹ See *Stephano v. News Group Publications, Inc.*, 64 N.Y.2d 174, 183, 474 N.E.2d 580, 485 N.Y.S.2d 220 (1984), *amended in part*, 107 A.D.2d 610, 506 N.Y.S.2d 283 (1st Dep't 1986). "[T]he 'right of publicity' is encompassed under the Civil Rights Law as an aspect of the right of privacy, which, as noted, is exclusively statutory in this State, the plaintiff cannot claim an independent common law right of publicity." *Id.* at 224. *But see* *Southeast Bank, N.A. v. Lawrence*, 66 N.Y.2d 910, 489 N.E.2d 744, 498 N.Y.S.2d 775, 776 (1985). The Court of Appeals left open "the question of whether a common-law descendible right of publicity exists" in New York because plaintiff had no standing. *Id.* For discussion of the right of publicity in New York as a distinct cause of action, see *infra* notes 63-68 and accompanying text.

⁵⁰ See, e.g., CAL. CIV. CODE § 3344 (West Supp. 1989); NEB. REV. STAT. §§ 20-201 to -211, 25-840.01 (1987); N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1986); OKLA. STAT. ANN., tit. 21, §§ 839.1 to .3 (West 1983); UTAH CODE ANN. 1953, §§ 76-9-401 to -406 (1953); VA. CODE ANN. §§ 2.1-377 to -386 (1989); WIS. STAT. ANN. § 895.50 (West 1988).

son or persons injured as a result thereof.⁵¹

In *Midler*, however, both the district court and court of appeals rejected the plaintiff's claim based on California's right of privacy statute.⁵²

New York's right of privacy statute⁵³ was passed in response to *Roberson v. Rochester Folding Box Co.*⁵⁴ The New York statute is more complex than California's because a plaintiff must meet three specific requirements in order to successfully assert a privacy action: 1) the use of a name, portrait, or picture; 2) for trade or commercial purposes; 3) without the written consent of the individual.⁵⁵

Although the California right of privacy statute includes the terms "likeness" and "voice," the New York statute does not.⁵⁶ Despite the absence of the term "likeness" in the New York statute, many New York courts have construed the statute to contain the term.⁵⁷ However, with regard to the absence of the term "voice,"

⁵¹ CAL. CIV. CODE § 3344 (West Supp. 1989).

⁵² *Midler v. Ford Motor Co.*, No. 86 Civ. 2683 (C.D. Cal. Aug. 17, 1987) (Conclusions of Law, para. 6), *rev'd*, 849 F.2d 460 (9th Cir. 1988). The court of appeals held that the defendant did not use anything of Ms. Midler's which was prohibited under the statute. For example, the voice used was not Ms. Midler's, but rather her backup singer's. Furthermore, the court held that the term "likeness" in section 3344 refers to the visual, not the vocal, image. 849 F.2d at 463. See also *Booth v. Colgate-Palmolive Co.*, 360 F. Supp. 343, 347 (S.D.N.Y. 1973).

⁵³ N.Y. CIV. RIGHTS LAW § 50 (McKinney 1976) provides: "A person, firm or corporation that uses for advertising purposes, or for the purpose of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person . . . is guilty of a misdemeanor." *Id.* The offense is defined and declared criminal in section 50 of the statute.

N.Y. CIV. RIGHTS LAW § 51 provides in pertinent part:

Any person whose name, portrait or picture is used within this state for . . . the purposes of trade without the written consent [of that person] may maintain an equitable action . . . against the person, firm or corporation so using his name, portrait or picture, to prevent and restrain the use thereof; and may also sue and recover damages for any injuries sustained by reason of such use.

Id.

Unlike California's right of privacy statute, New York's statute does not include "voice" or "likeness." See *supra* note 51.

⁵⁴ 171 N.Y. 538, 64 N.E. 442 (1902). When the plaintiff's portrait was distributed without her consent for a flour advertisement, the court dismissed the complaint, holding that her right of privacy action was unsupported. *Id.* at 556-57, 64 N.E. at 447-48.

⁵⁵ The three requirements were established by N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1976) and applied in *Allen v. National Video, Inc.*, 610 F. Supp. 612, 621 (S.D.N.Y. 1985).

The *Midler* case did not involve either actual pictures of personalities, caricatures, or mannequins. For cases that did, see *Negri v. Schering Corp.*, 333 F. Supp. 101 (S.D.N.Y. 1971) (picture of plaintiff taken from one of her earlier movies); *Brinkley v. Casablancas*, 80 A.D.2d 428, 438 N.Y.S.2d 1004 (1st Dep't 1981) (poster of model); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978) (caricature); *Young v. Greneker Studios, Inc.*, 175 Misc. 1027, 26 N.Y.S.2d 357 (Sup. Ct. 1941) (mannequin).

⁵⁶ See *supra* notes 51 and 53 and accompanying text.

⁵⁷ *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 726 (S.D.N.Y. 1978) (drawing of a naked black man bearing a strong resemblance to Muhammad Ali in a boxing ring); *Onassis v.*

the First Circuit, construing New York's privacy statute in *Lahr v. Adell Chem. Co.*,⁵⁸ held that the term "name" could not be enlarged to include "voice" for the purposes of the statute.⁵⁹

Additionally, for a photograph to fall under the "portrait or picture" provision, as defined by New York's privacy statute, a court must conclude "that most persons who could identify an actual photograph of plaintiff would be likely to think that this was actually his picture."⁶⁰ Therefore, the standard applied is strict. However, the facial likeness standard in New York may be analogized to voice imitation claims in California.⁶¹ If a court could conclude that those capable of identifying the plaintiff's actual voice would be likely to

Christian Dior-New York, Inc., 122 Misc. 2d 603, 472 N.Y.S.2d 254, 259 (Sup. Ct. 1984) (lookalike of Jacqueline Onassis depicted with actual celebrities in commercial magazine advertisement). However, in *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661 (2d Dep't 1977), the court held that a commercial depiction of plaintiff's style of conducting "Auld Lang Syne" in a New Year's Eve setting was not actionable because name and "reputation" are neither synonymous nor sufficient to conjure up a mental image or likeness. *Id.* at 622, 396 N.Y.S.2d at 664-65.

⁵⁸ 300 F.2d 256, 258 (1st Cir. 1962).

⁵⁹ *Id.* The fact that imitation of a distinctive voice did not come within the statutory prohibition may have been an oversight because, in 1903, when sections 50 and 51 of the Civil Rights Law were enacted, the dissemination of voice was not thought to be possible. *Onassis*, 472 N.Y.S.2d at 259. Consequently, the statute failed to provide for voice misappropriation.

New York State Senator Emanuel Gold has introduced the Celebrity Rights Act to amend the civil rights law. S. 6843-B, Feb. 1, 1988. The Committee on Rules has subsequently introduced the bill in the New York State Assembly. S. 5053, May 2, 1989. This bill, if passed, would add the terms "voice" and "likeness" to New York's right of privacy statute. The addition of these terms would bring New York into conformity with California and, in turn, the right of privacy problems would be the same. For instance, in *Midler*, it was not the plaintiff's actual voice that was used but an imitation. However, the resolution of these similar problems may differ because both the *Ali* and *Onassis* cases would provide support for an action against soundalikes in New York. Marks, *The Bette Midler Case: Judiciary Finally Listens to Soundalike Claim*, N.Y.L.J., Oct. 5, 1988, at 1, col. 1. Furthermore, New York's Celebrity Rights Bill "would create . . . a transferable and descendible right of publicity." *Id.* Consequently, the right of publicity would not be "limited to deceased personalities as is California's right of publicity statute." *Id.* For a discussion of the right of publicity in relation to recognition of voice imitation, see Note, *The Right of Publicity and Vocal Larceny: Sounding off on Sound-Alikes*, 57 FORDHAM L. REV. 445 (1988).

⁶⁰ *Allen v. National Video, Inc.*, 610 F. Supp. 612, 624 (S.D.N.Y. 1985); *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360, 367 (S.D.N.Y. 1988) (because advertisements using Woody Allen's lookalike contained disclaimer under photograph, enunciated standard for privacy action more difficult to satisfy).

⁶¹ Several cases have extended the literal definition of portrait or picture. *See, e.g.*, *Young v. Greneker Studios, Inc.*, 175 Misc. 1027, 26 N.Y.S.2d 357 (Sup. Ct. 1941) (extended to include mannequins or sculptures); *Loftus v. Greenwich Lithographing Co.*, 192 A.D. 251, 182 N.Y.S. 428 (1st Dep't 1920) (extended to include sketch of female figure in costume which plaintiff popularized); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978) (extended to include drawing).

New York's privacy statute does not prohibit "conveying the likeness of a person . . . through sound, by means of the imitation of a distinctive voice." *Onassis*, 122 Misc. 2d at 608-09, 472 N.Y.S.2d at 259. For example, in *Lahr v. Adell Chem. Co.*, 300 F.2d 256, 268 (1st Cir. 1962), the plaintiff's invasion of privacy action for voice imitation failed, not "because the portrayal of plaintiff's distinctive vocal delivery was by an imitator, but

believe the imitation was actually the plaintiff's voice, the action should fall within California's privacy statute since it includes the terms "voice" and "likeness."⁶²

The ambiguity surrounding the privacy action, in conjunction with the strict standard employed by the courts for imitators, lookalikes, and soundalikes, makes privacy claims difficult to prove. Consequently, alternative legal principles on which to base an imitation claim must be explored.

B. *Right of Publicity*

1. New York Right of Publicity

The fundamental elements of the New York right of publicity and privacy actions are the same.⁶³ However, while the right of privacy protects a plaintiff's personal interests, the right of publicity protects a plaintiff's property interests. Therefore, in a right of publicity action a plaintiff must meet the additional element: showing the development of a "property interest with a monetary value in his or her name or face."⁶⁴ The right of publicity may thus be more applicable in actions involving soundalike and lookalike imitations because the plaintiff's interests in preventing such imitations involve property rights protecting both the identity itself and the freedom from exploitation of that identity by others.⁶⁵

Until recently, federal courts recognized a common law right of publicity independent of the privacy right.⁶⁶ Since the public-

because a voice was not construed as the equivalent of a name or picture. . . ." *Onassis*, 122 Misc. 2d at 609, 472 N.Y.S.2d at 259.

New York's right of privacy statute does not include voice. However, California's privacy statute does, thereby construing voice as the equivalent of a name or picture. A voice is as distinctive as a face and, in fact, it has been noted that "with the sound of a voice, [it is as if] 'the other stands before me.'" *Midler*, 849 F.2d at 463 (citing *D. IHDE, LISTENING AND VOICE* 77 (1976)).

⁶² CAL. CIV. CODE § 3344 (West Supp. 1989).

⁶³ See *supra* note 55 and accompanying text.

⁶⁴ *Allen v. National Video*, 610 F. Supp. at 621 (citations omitted).

⁶⁵ "A sign of a celebrity is often that his name is worth more than his services." D. BOORSTIN, *THE IMAGE* 220 (1962). The right of publicity promotes "commercial fairness" as well as encouraging performers in their field. For a discussion on the right of publicity in relation to performance cases, see Marks, *An Assessment, supra* note 31, at 13-14. The fact that the right of publicity is regarded as a property right makes it "assignable and, in some jurisdictions, descendible." Moskin, *supra* note 9, at 161 (footnotes omitted).

⁶⁶ See, e.g., *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 728 (S.D.N.Y. 1978). Courts have recognized the right of publicity as well as the assignability and descendibility of that right. See also *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953) (contract signed by ballplayer for exclusive right to use his photo was a valid assignment of the right to market the ballplayer's likeness); *Groucho Marx Productions, Inc., v. Day & Night Co.*, 523 F. Supp. 485 (S.D.N.Y. 1981),

ity right has become inextricably linked to the status of "celebrity,"⁶⁷ the fourth element, an economic property interest in his or her name or face, would be easily met in any claim made by an actress, songstress, or celebrity, such as Midler.⁶⁸

2. California's Right of Publicity and Common Law Tort in California

The *Midler* court, citing California's right of publicity statute, stated that "common law rights are also property rights."⁶⁹ The court held that Y & R misappropriated Ms. Midler's voice because Ms. Midler's interest in her voice was a property right. Y & R's action was therefore a common law tort in California.⁷⁰ Similarly, in *Motschenbacher v. R.J. Reynolds Tobacco Co.*,⁷¹ the court held that the defendant misappropriated the plaintiff's proprietary interest in his own identity.⁷² *Motschenbacher* involved the use of a photograph of the driver's car in an advertisement for cigarettes. The car's distinct features were kept intact in the commercial.⁷³ Although the driver was not clearly visible, many who viewed the commercial believed that it was the plaintiff behind the wheel of the car. The advertisement led the viewers to believe that the plaintiff had endorsed the product.⁷⁴

rev'd, 689 F.2d 317 (2d Cir. 1982) (action brought by assignees against defendants for the use of names, likenesses, and mannerisms of the Marx Brothers in a Broadway show); *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975) (right of publicity descended to widows of actors Laurel and Hardy).

⁶⁷ A public figure is protected "against commercial exploitation, without written consent, to which a *public figure* is perhaps even more subject than a nonpublic person." *Price*, 400 F. Supp. at 843 n.7 (citations omitted) (emphasis added).

⁶⁸ During the course of Bette Midler's public career, Ms. Midler established a commercially valuable interest in her likeness, reputation, and specifically, her voice, evidenced by descriptions of her as a "legend," and the "most dynamic and poignant singer-actress of her time." Corliss, *Bette Steals Hollywood*, TIME, Mar. 2, 1987, at 64 [hereinafter Corliss]. She has also been described as an "outrageously original singer/comedian." Ansen, *The Divine Mrs. M.*, NEWSWEEK, June 30, 1986, at 58. That several of her records have "gone" gold and platinum is a further indication of the extent of the commercial value of Ms. Midler's voice. For instance, her 1979 album, "The Rose," sold over one million copies. Corliss, at 64. Generally, an individual who has achieved such a degree of celebrated status, whether as an actress, songstress, or public figure, has established a valuable interest in her face, voice, and/or name. See Marks, *An Assessment*, *supra* note 31, at 1.

⁶⁹ *Midler*, 849 F.2d at 463. The California statute provides damages for unauthorized use of a "deceased personality's name, voice, signature, photograph, or likeness in any manner." CAL. CIV. CODE § 990(a) (West 1982 & Supp. 1989). The statute also recognizes these rights as "property rights." *Id.* at § 990(b).

⁷⁰ *Midler*, 849 F.2d at 463.

⁷¹ 498 F.2d 821 (9th Cir. 1974).

⁷² *Id.* at 825.

⁷³ The distinct features of *Motschenbacher's* car that remained intact were the oval medallion, the white pinstriping, and the solid red coloring. *Id.* at 822.

⁷⁴ *Id.* at 827.

Unlike Mr. Motschenbacher, Ms. Midler neither performed commercial endorsements as a part of her livelihood, nor had her "image" appeared in the commercial. However, Y & R misappropriated an attribute of Ms. Midler's identity as personal as Mr. Motschenbacher's image, her voice, thereby conveying the impression that she was singing in the commercial and endorsing the product.⁷⁵ The defendants in *Motschenbacher*, by emphasizing the symbols and images associated with Mr. Motschenbacher, similarly violated California tort law.⁷⁶ Because California recognizes injury from "an appropriation of the attributes of one's identity,"⁷⁷ future litigants, after *Motschenbacher* and *Midler*, may successfully assert a cause of action for misappropriation under the California right of publicity statute.

V. UNFAIR COMPETITION UNDER COMMON LAW

Although the law of unfair competition is the set of rules which governs business competition, it is the nature of the competition itself which determines what the rules should be. Summarily stated, the essence of unfair competition is the violation of the particular "rules of the game."⁷⁸ Under California law, unfair competition consists of "unlawful, unfair or fraudulent business

⁷⁵ A celebrity's persona is recognized in the market place as having an "associative economic value." Halpern, *The Right of Publicity: Commercial Exploitation of the Associative Value of Personality*, 39 VAND. L. REV. 1199, 1243 n.260 (1986) (citations omitted). In fact, [t]oday, it is commonplace for individuals to promote or advertise commercial services and products or . . . even have their identities infused in the products.

Such commercial use of an individual's identity is intended to increase the value or sales of the product by fusing the celebrity's identity with the product and thereby siphoning some of the publicity value or good will in the celebrity's persona into the product.

. . . .
 . . . [T]he marketable product . . . is the ability of a person's name or likeness to attract the attention and evoke a desired response in a particular consumer audience. That response is a kind of good will or recognition value generated by that person. . . . While this product is concededly intangible, it is not illusory.

Id.

⁷⁶ See, e.g., *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 622, 396 N.Y.S.2d 661, 664 (2d Dep't 1977). The New York Supreme Court, Appellate Division, held that the exploitation of Lombardo's property interest in forty years of developing his public personality as "Mr. New Year's Eve" was a tort and constituted a cause of action. *Lombardo*, 58 A.D.2d at 622, 396 N.Y.S.2d at 664.

⁷⁷ *Motschenbacher*, 498 F.2d at 824.

⁷⁸ Moskin, *supra* note 9, at 167. See also 1 R. CALLMAN, *THE LAW OF UNFAIR COMPETITION, TRADEMARKS, AND MONOPOLIES* 2 (4th ed. 1981). Unfair competition and the right of publicity are alike in that they are both "concerned with maintaining certain standards of commercial ethics and upholding . . . the 'rules of the game.'" Moskin, *supra* note 9, at 169.

practice and unfair, untrue or misleading advertising.”⁷⁹

Competition, therefore, is a required element under California’s unfair competition law because without it, no faulty business practices or advertisements can exist. For example, the *Sinatra* court held that the plaintiff could not assert a cause of action for unfair competition because no competition existed between Sinatra and Goodyear.⁸⁰

Furthermore, there was no “passing off”⁸¹ by Goodyear of Sinatra’s product “as its own either by simulation of name, slogan, device or other unfair trade practice.”⁸² The court characterized Nancy Sinatra’s claim as an “incidental or secondary passing off”⁸³ which had increased the defendant’s sales because only some of the viewing audience had believed that the voice in the commercial belonged to Nancy Sinatra.

The *Midler* court also rejected the legal principle of unfair competition⁸⁴ because Ms. Midler was neither in competition with the defendants, nor had she performed in any television commercials.⁸⁵ However, in *Lahr v. Adell Chem. Co.*,⁸⁶ the court held that Mr. Lahr, the actor famous for his portrayal of the Cowardly Lion in *The Wizard of Oz*,⁸⁷ had stated a cause of action for unfair competition on the grounds that confusion resulted as to identity or “passing off.”⁸⁸ The court conceded that the defendant’s commercial had greater value because the audience believed they were listening to Mr. Lahr’s voice.⁸⁹

The different results in *Midler* and *Lahr* are seemingly juris-

⁷⁹ CAL. CIV. CODE § 3369 (West 1970).

⁸⁰ *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 714 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971).

⁸¹ Dean Prosser defines “passing off” as:

[T]he making of some false representation to the public, or to third persons, likely to induce them to believe that the good or services of another are those of the plaintiff. . . . The test laid down in such cases has been whether the resemblance is so great as to deceive the ordinary customer acting with the caution usually exercised in such transactions, so that he may mistake one for the other.

W. PROSSER, HANDBOOK OF THE LAW OF TORTS 957-58 (4th ed. 1971) [hereinafter PROSSER].

⁸² *Sinatra*, 435 F.2d at 714.

⁸³ *Id.* at 715.

⁸⁴ *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988).

⁸⁵ *Id.*

⁸⁶ 300 F.2d 256 (1st Cir. 1962) (commercial consisting of a cartoon of a duck with a soundalike of Mr. Lahr’s unique voice).

⁸⁷ *The Wizard of Oz* was a motion picture released in 1939.

⁸⁸ *Lahr*, 300 F.2d at 259. See *supra* note 81 (defining “passing off”).

⁸⁹ *Id.* The defendant’s conduct saturated the plaintiff’s audience and as a result, the plaintiff’s market was curtailed. *Id.* In contrast, however, the one-minute commercials in *Midler* were not considered to be of the type to have curtailed plaintiff’s market. *Midler*, 849 F.2d at 462.

dictional rather than factual, with *Lahr* signifying the more receptive attitude in New York to common law unfair competition claims. The more permissive attitude reflects the fact that direct competition between a plaintiff and defendant is not required in New York, whereas in California, direct competition is essential.⁹⁰

A future plaintiff may avoid the jurisdictional differences by supporting an unfair competition claim with the assertion that performers have a property right in their performances. This approach should afford the necessary protection against both direct and indirect misappropriation.⁹¹ However, there are certain policy considerations which do not support this approach. For instance, to provide protection against unfair competition "where Congress has not given federal protection [would,] in effect[, be] granting state copyright benefits without the federal limitations of time to permit definite public domain use."⁹² Furthermore, the Supreme Court, in *Sears, Roebuck & Co. v. Stiffel Co.*,⁹³ stated that the "mere inability of the public to tell two identical articles apart is not enough to support . . . an award of damages for copying that which the federal patent laws [or the federal copyright laws] permit to be copied."⁹⁴

⁹⁰ In California, an unfair competition action "must not only be unfair but must in some discernible way be competitive." *Halicki v. United Artists Communications, Inc.*, 812 F.2d 1213, 1214 (9th Cir. 1987).

⁹¹ See, e.g., *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, 345 (S.D.N.Y. 1973). Although Ms. Booth argued that protection is permitted for performances against direct and indirect misappropriation such as vocal or facial imitation, her claim was dismissed.

New York law may be more receptive to unfair competition claims than California when the claim involves "direct misappropriation." *Id.* See *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 101 N.Y.S.2d 483 (Sup. Ct. 1950), *aff'd*, 279 A.D. 632, 107 N.Y.S.2d 755 (1st Dep't 1951) (where court held that defendants' recording and selling copies of operatic performance misappropriated plaintiffs' property right); *CBS, Inc. v. Documentaries Unlimited, Inc.*, 42 Misc. 2d 723, 248 N.Y.S.2d 809 (Sup. Ct. 1964) (defendant's recording and incorporating of broadcaster's news announcement into phonograph record for commercial distribution without consent directly misappropriated plaintiffs' property right); *Dior v. Milton*, 9 Misc. 2d 425, 155 N.Y.S.2d 443 (Sup. Ct. 1956), *aff'd*, 2 A.D.2d 878, 156 N.Y.S.2d 996 (1st Dep't 1956) (plaintiffs, fashion designers, sued two publishers of sketches and designs for copying and selling their designs).

⁹² *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 718 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971) (citing *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 666-67 (2d Cir. 1955) (Hand, J., dissenting)).

⁹³ 376 U.S. 225, *reh'g denied*, 376 U.S. 973 (1964). See *supra* notes 43-47 and accompanying text.

⁹⁴ *Sears*, 376 U.S. at 232. States have enacted anti-dilution statutes to protect the trademarks when the trademarks themselves have acquired independent values. State anti-dilution statutes generally disregard the requirements of competition and confusion between goods. See, e.g., FLA. STAT. ANN. § 495.151 (West 1974); N.Y. GEN. BUS. LAW § 368-d (McKinney 1984). Although New York's anti-dilution statute "does not require public confusion, it does require a likelihood of injury to business reputation, or dilution of a mark." *Protecting the Persona*, *supra* note 10, at 265 (emphasis added). The express

This strong federal policy, as enunciated in *Sears* and echoed in *Compco Corp. v. Day-Brite Lighting, Inc.*,⁹⁵ is also the reason for denying recovery in unfair competition actions where a "secondary meaning" is asserted.⁹⁶ Therefore, both the direct competition requirement in California for an unfair competition action, and the New York policies making an unfair competition action more difficult, appear to preclude many future voice imitation claimants from bringing their actions. A more successful legal principle on which a voice imitation litigant should base his claim is therefore necessary.

VI. THE SOLUTION: LANHAM ACT 43(a) VIOLATION

Future litigants should initially base their claims for relief on the Lanham Act.⁹⁷ The Lanham Act provides protection against not only trademark infringement,⁹⁸ but also, under section 43(a),⁹⁹ against false representation which is likely to cause pub-

wording in § 368-d of the New York statute eliminates any defense that the parties were not in competition with each other.

Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark or trade name shall be a ground for injunctive relief in cases of infringement of a mark registered or not registered or in cases of unfair competition, *notwithstanding the absence of competition* between the parties or the absence of confusion as to the source of goods or services.

N.Y. GEN. BUS. LAW § 368-d (McKinney 1984)(emphasis added).

By dismissing the competition requirement, statutes such as these permit owners to enforce their marks over a wide range of products and markets. The owner does not have to be actively involved in this enforcement in order to prohibit the practice. However, these statutes are rarely employed since the dilution theory is generally incorporated in the Lanham Act. Under the Lanham Act, the requirement that there be public confusion is no longer limited to confusion among *competing* goods. See *infra* notes 124-28 and accompanying text.

⁹⁵ 376 U.S. 234, *reh'g denied*, 377 U.S. 913 (1964).

⁹⁶ "Secondary meaning . . . is the association in the public mind between a product and its source which occurs when an inherently non-distinctive designation attains secondary meaning, or changes from being non-distinctive to being distinctive of the particular product." GILSON, TRADEMARK PROTECTION AND PRACTICE § 209 (1989). See MILLER & DAVIS, *supra* note 29, at 164 ("secondary meaning is acquired rather than inherent and is developed in the marketplace through use that makes the mark distinctive of the owner's goods or services."). For example, in *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343, (S.D.N.Y. 1973), Ms. Booth asserted that because the "Hazel" character's voice resulted in an association between her voice and the series itself, her voice had acquired a "secondary meaning." *Id.* at 347. Thus, Ms. Booth contended that the defendants hoped to deceive the viewing audience into believing she endorsed the product by utilizing a voice imitation. *Id.*

⁹⁷ Ms. Midler attempted to amend her complaint to add section 43(a) of the Lanham Act, but was unsuccessful as her claim was time-barred. *Midler v. Ford Motor Co.*, No. 86 Civ. 2683 (C.D. Cal. Aug. 17, 1987) (Statement of the Uncontroverted Facts, para. 19), *rev'd*, 849 F.2d 460 (9th Cir. 1988).

⁹⁸ Section 43(a) of the Lanham Act imposes civil liability upon "[a]ny person who, on or in connection with any goods or services, uses . . . a false designation of origin, false or misleading description of fact, or false or misleading representation of fact." 15 U.S.C. § 1125(a) (1946).

⁹⁹ See *Nature's Bounty, Inc. v. Super X Drugs Corp.*, 490 F. Supp. 50 (E.D.N.Y. 1980)

lic confusion¹⁰⁰ as to origin and sponsorship.¹⁰¹ In so doing, section 43(a) creates a new federal statutory tort, worded so as to provide broad remedial protection.¹⁰² For example, section 43(a) is not limited to suits between business competitors,¹⁰³ as

(court held that plaintiff, a manufacturer and distributor of food supplements and vitamins, raised serious question as to trademark infringement and false designation of origin against a drug store); *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg.*, 510 F.2d 1004 (5th Cir.), *cert. denied*, 423 U.S. 868, *reh'g denied*, 423 U.S. 991 (1975) (hockey league and teams stated a cause of action under the Lanham Act to enjoin emblem manufacturer from making and selling embroidered cloth emblems embodying teams' registered trademarks).

¹⁰⁰ The likelihood of public confusion is an element that must be present for a claim to be made under the Lanham Act. However, the likelihood of confusion does not need to be present for a right of publicity claim. Ropski, *supra* note 6, at 40.

¹⁰¹ *F.E.L. Publications, Ltd. v. Nat'l Conference of Catholic Bishops*, 466 F. Supp. 1034 (N.D. Ill. 1978) (publisher of religious music brought section 43(a) claim against national organization of bishops and service agency sponsored by bishops); *Bogene Inc. v. Whit-Mor Mfg. Co.*, 253 F. Supp. 126 (S.D.N.Y. 1966) (section 43(a) action for copying brochure sheet with intent to cause confusion); *Federal Mogul-Bower Bearings, Inc. v. Azoff*, 313 F.2d 405 (6th Cir. 1963) (imitation of plaintiff's commercial bearings, connecting rods, and containers with intent to falsely represent them as plaintiff's goods); *Boston Professional Hockey Ass'n*, 510 F.2d at 1004 (emblem manufacturer's reproduction of hockey team's unregistered symbol constituted Lanham Act violation); *Motown Record Corp. v. George A. Hormel & Co.*, 657 F. Supp. 1236 (C.D. Cal. 1987) (court upheld plaintiff record company's Lanham Act claim that soundalike version of Supremes' recording of "Baby Love" in a commercial was likely to cause confusion); *Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985) (court granted injunction under Lanham Act against use of lookalike in commercial for video store); *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360 (S.D.N.Y. 1988) (court granted injunction against use of lookalike in advertisement where disclaimer was neither in bold print nor placed in a central location).

¹⁰² *CBS, Inc. v. Springboard Int'l Records*, 429 F. Supp. 563, 566-67 (S.D.N.Y. 1976).

¹⁰³ Under federal case law, competition is not required under the Lanham Act. *See, e.g., Spring Mills, Inc. v. Ultracashmere House Ltd.*, 724 F.2d 352 (D.C. Cir. 1983). The owner of registered trademark "Ultracashmere" sued manufacturer using the label "Ultracashmere." The district court improperly dismissed the false advertising claim under section 43(a) since "competitive injury is not required for recovery under section 1125(a)." *Id.* at 357. *See also Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 467 F. Supp. 366, 374 (S.D.N.Y.), *aff'd*, 604 F.2d 200 (2d Cir. 1979) (in trademark infringement action, court held there was "no requirement that the defendant's service or product be in direct competition"); *Gilliam v. American Broadcasting Co.*, 538 F.2d 14 (2d Cir. 1976) (plaintiff's reputation was injured due to editing and the section 43(a) claim was valid without allegation of competition); *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360 (S.D.N.Y. 1988); *Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985).

In California, however, competition is required. *See, e.g., LaMothe v. Atlantic Recording Corp.*, 847 F.2d 1403 (9th Cir. 1988) (authors of musical composition stated an action under the Lanham Act against co-authors and co-authors' licensees because parties were competitors in the plaintiffs' market); *Halicki v. United Artists Communications, Inc.*, 812 F.2d 1213, 1214 (9th Cir. 1987) (no unfair competition action because "conduct must not only be unfair but must in some discernable way be competitive."); *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981) (court held that, even though no competition existed between plaintiff and defendant, plaintiff stated valid claim under Lanham Act because defendant removed his name and substituted another's).

Recently, the Lanham Act was amended to encompass misrepresentation of "another person's goods, services or commercial activities. . . ." Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935 (Nov. 16, 1988). For a discussion of the revised Lanham Act, see Kobak, Jr. & Fleck, *Commercial Defamation Claim Added to*

common law unfair competition is, nor does it require ownership of registered trademarks.¹⁰⁴ However, for an action to arise under section 43(a), when a mark¹⁰⁵ is used in interstate commerce, it must be "likely to cause confusion, or to deceive purchasers into believing the source of origin of the goods is another."¹⁰⁶

To set forth a cause of action under section 43(a) of the Lanham Act, a plaintiff must establish three elements:¹⁰⁷ 1) involvement of goods or services; 2) interstate commerce effect;¹⁰⁸ and 3) a false designation of origin or false description of goods or services.¹⁰⁹ Soundalike litigants would, in all likelihood, be able to meet these three requirements with relative ease.

A voice imitation plaintiff may allege that her voice constitutes either a good or service since the plaintiff's voice is "purchased" in a variety of ways: a ticket to the artist's concert, a

Revise Lanham Act, Nat'l L.J., Oct. 30, 1989, at 33. Consequently, the term "commercial activity" may only require a commercial interest and may negate any competition requirement that, in the past, had existed in California. Marks, *An End to Judicial Resistance Toward Vocal Imitation Claims?*, Nat'l L.J., Feb. 20, 1989, at 21 n.19.

¹⁰⁴ See *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg. Co.*, 510 F.2d 1004 (5th Cir. 1974), *cert. denied*, 423 U.S. 868, *reh'g denied*, 423 U.S. 991 (1975) (emblem manufacturer's reproduction of Toronto hockey team's unregistered symbol constituted Lanham Act violation).

¹⁰⁵ The terms "trademark" and "mark" are defined by section 45 of the Lanham Act, 15 U.S.C. § 1127 (1982 & Supp. VII 1989) as follows:

The term "trademark" includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The term "mark" includes any trade-mark, service mark, collective mark, or certification mark entitled to registration under the chapter whether registered or not

Id.

¹⁰⁶ *National Lampoon, Inc. v. American Broadcasting Co.*, 376 F. Supp. 733, 746 (S.D.N.Y.), *aff'd*, 497 F.2d 1343, 1351 (2d Cir. 1974).

¹⁰⁷ *CBS, Inc. v. Springboard Int'l Records*, 429 F. Supp. 563, 566 (S.D.N.Y. 1976).

¹⁰⁸ The interstate commerce effect requirement is broadly construed. See, e.g., *Maier Brewing Co. v. Fleischmann Distilling Corp.*, 390 F.2d 117, 120 (9th Cir.), *cert. denied*, 391 U.S. 966 (1968) ("sale of 'Black and White' beer could affect interstate sale and reputation of 'Black and White' scotch, and [is], for that reason, commerce which Congress can regulate"); *F.E.L. Publications, Ltd. v. National Conference of Catholic Bishops*, 466 F. Supp. 1034, 1044 (N.D. Ill. 1978) (despite *intrastate* sale of defendant's products, interstate commerce effect requirement was met because plaintiff's business could have diminished or his reputation damaged).

¹⁰⁹ Justice Frankfurter stated:

The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. *Whatever the means employed, the aim is the same* — to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears.

Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co., 316 U.S. 203, 205 (1942) (emphasis added).

record featuring the artist, or an audio/videotape. The performer's investment in her voice and the reputation she has gained through her unique vocal style may also be viewed as a good belonging to the performer.

Furthermore, a voice imitation which does not reveal the true identity of the performer satisfies the requirement for a false designation of origin. The listener will automatically assume the voice to be that of the person whose voice is being imitated and who has made it well known.

For the voice imitation litigant, the only element which may present difficulty is, therefore, the interstate commerce requirement. Interstate commercial activity is seldom considered to be involved in a voice imitation case. However, because interstate commerce, in general, is broadly construed,¹¹⁰ voice imitation plaintiffs may assert that a defendant's use of a soundalike, though local in nature, diminishes plaintiff's interstate reputation and business.

The public's freedom from deception was the underlying premise of the Lanham Act and the reason for its subsequent enactment.¹¹¹ The court in *Allen v. National Video, Inc.*, interpreting the Lanham Act, stressed the importance of the right to freedom from deception: the public's and the plaintiff's.¹¹² In its analysis, the court noted that Woody Allen held a strong commercial investment in his name and face, which could be furthered by his endorsement of products and the selective marketing of his career. However, further development of such an investment necessarily depends upon the "good will" of the public.¹¹³ The defendant, therefore, in utilizing a lookalike, not only jeopardized Woody Allen's investment, but also deceived the public.

Utilizing the premise set forth in *Allen*, a voice imitation litigant such as Bette Midler could argue that she has made a considerable investment in her career, evidenced by her struggle for many years before becoming a well-known comedian, singer, and actress. If the defendants were allowed to continue the use of a soundalike to maintain the false representation of Ms. Midler's endorsement of the product,¹¹⁴ the celebrity good will that Mid-

¹¹⁰ See *supra* note 109.

¹¹¹ *Allen v. National Video, Inc.*, 610 F. Supp. 612, 625-26 (S.D.N.Y. 1985). See *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360 (S.D.N.Y. 1988).

¹¹² 610 F. Supp. 612 (S.D.N.Y. 1985).

¹¹³ *Id.* at 625-26.

¹¹⁴ The type of harm from an unauthorized endorsement of a commercial product is partially personal and partially economic. Where the portrayal is exploitive and does not serve any cultural or informative purpose, the requirement enunciated by Felcher

ler relies upon would therefore be at risk. Furthermore, she could assert that because "the public has [a] right to be free from deception regarding the drawing power inherent in a celebrity's product or service endorsement,"¹¹⁵ she should be entitled to injunctive relief.

For a court to grant injunctive relief under the Lanham Act, a plaintiff must demonstrate that there is a likelihood of confusion resulting from false representations.¹¹⁶ "The burden of proof is on [the] plaintiff . . . [to] show by a preponderance of evidence that an appreciable number of ordinarily prudent purchasers are likely to be confused between the marks."¹¹⁷ Although, a *likelihood* of confusion is all that is necessary for equitable relief, likelihood "does not mean a mere possibility of confusion, but rather a probability that confusion will occur."¹¹⁸ Therefore, when a mark is duplicated without authorization but in a nonconfusing manner, and, in fact, it does not confuse the public, trademark law does not protect the mark and no relief is granted.¹¹⁹

In determining whether a likelihood of confusion exists, the following six factors¹²⁰ should be considered: (1) the strength of

and Rubin, *supra* note 19, at 1608, is easily met if "[t]he injury arises from the false implication of a business relationship . . . an implication that misrepresents the individual's transactions" arises. *Id.* at 1613. Generally, in the absence of an agreement between the parties, liability is imposed so as to "support the social policy of encouraging honest commercial practices." *Id.*

¹¹⁵ Ropski, *supra* note 6, at 37; *Allen v. National Video*, 610 F. Supp. at 626.

¹¹⁶ Once likelihood of consumer confusion is established, the plaintiff is entitled to injunctive (equitable) relief. However, to recover *damages* under section 43(a) of the Lanham Act "it is necessary to prove that the buying public was *actually* deceived." *Warner Bros., Inc. v. Gay Toys, Inc.*, 658 F.2d 76, 79 (2d Cir. 1981) (citations omitted) (emphasis added). See *Dallas Cowboys Cheerleaders v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204 (2d Cir. 1979); *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg. Co.*, 510 F.2d 1004, 1013 (5th Cir. 1974), *cert. denied*, 423 U.S. 868, *reh'g denied*, 423 U.S. 991 (1975).

¹¹⁷ S. KANE, TRADEMARK LAW: A PRACTITIONER'S GUIDE 118 (1987) [hereinafter KANE, TRADEMARK LAW]. See also *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 972 (11th Cir. 1983).

¹¹⁸ KANE, TRADEMARK LAW, *supra* note 117, at 118.

¹¹⁹ *Protecting the Persona*, *supra* note 10, at 263. See *Bi-Rite Enterprises, Inc. v. Button Master*, 555 F. Supp. 1188, 1193-95 (S.D.N.Y.), *supp. op.*, 578 F. Supp. 59 (S.D.N.Y. 1983) (court dismissed plaintiffs' infringement and unfair competition claims against unlicensed sellers of novelty items bearing performers' likenesses).

If the soundalike is utilized purely for entertainment or if the audience is made fully aware that the imitator is not the real celebrity through disclaimer or apparent differences between the two, the celebrity is not afforded protection under the Lanham Act. Ropski, *supra* note 6, at 45.

¹²⁰ The six factors were originally set forth in *Standard & Poor's Corp. v. Commodity Exchange, Inc.*, 683 F.2d 704, 708 (2d Cir. 1982). These factors had developed in previous cases. See *Dallas Cowboys Cheerleaders*, 604 F.2d at 204-05, in which the court stated, "In order to be confused, a consumer need not believe that the owner of the mark actually produced the item and placed it on the market. The public's belief that the mark's

plaintiff's marks;¹²¹ (2) the similarity of plaintiff's and defendant's marks; (3) the proximity of plaintiff's and defendant's products; (4) the actual confusion as to the source; (5) the sophistication of the audience; and (6) the good or bad faith of the defendant.¹²²

The first two factors, the strength of the plaintiff's marks and the similarity between the plaintiff's and the defendant's marks, could have easily been proven in *Midler*. Ms. Midler was well known to the public and had invested a great deal of time and

owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement." *Id.* (citations omitted).

¹²¹ "Trademark strength 'refers to the distinctiveness of the mark, or more precisely, its tendency to identify the goods sold under the mark as emanating from a particular, although possibly anonymous, source.'" KANE, TRADEMARK LAW, *supra* note 117, at 119. Although determining the strength of a mark is not a quantitative measurement, some trademarks are stronger and easier to protect from the outset than others. Four basic categories are recognized when assessing trademark strength:

- Generic: The common name for the kind of product — can never be a trademark. [e.g., Video Buyer's Guide]
- Descriptive: A term that describes something about the product — can only be a trademark after some period of exclusive use [as is the case when a secondary meaning is associated with the mark. Where the particular name or design has become associated in the public's mind primarily with the plaintiff's product or business, a secondary meaning is said to have attached to that name and all businesses or products so designated or named tend to become identified as the plaintiff's.] [e.g., Tender Vittles (mark) — cat food (product)]
- Suggestive: A term that subtly suggests something about the product — can be a trademark immediately upon use. [e.g., Playboy (mark) — magazine (product)]
- Arbitrary/
Fanciful: A term that bears little or no relationship to the product — the strongest of trademarks. [e.g., Camel (arbitrary mark) — cigarettes (product); Exxon (fanciful mark)]

Id. at 17-23.

A purely arbitrary or fanciful mark "is given immediate and wide protection even without any secondary meaning, either on the presumption that confusion will be likely or because a mark is treated more or less like property." W. PROSSER & W. KEETON, PROSSER AND KEETON ON TORTS 1017 (5th ed. 1984). A mark that at one time may have been protected, such as an arbitrary, suggestive, or a descriptive mark with a secondary meaning, may forfeit its protection "if it becomes 'generic,' and loses its association in the public mind with the plaintiff's business or product and becomes instead a designation for all similar products," such as LITE for low calorie beer. *Id.*

When determining the strength of a mark, three factors are considered. First is the type of mark, discussed above. Second is "[t]he extent of third party use. The more infrequent the use by others, the stronger the mark." Third is the "[a]dvertising and sales [involved]. The more extensive the use, the stronger the mark." KANE, TRADEMARK LAW, *supra* note 117, at 119-20. Therefore, a mark that initially may have been weak may acquire strength through plaintiff's mass advertising.

¹²² Bad faith may be deemed present where "[d]efendants may not have intended to imply that plaintiff actually endorsed their product, but they happily risked creating that impression in an attempt to gain commercial advantage through reference to plaintiff's public image." *Allen v. National Video, Inc.*, 610 F. Supp. 612, 628 (S.D.N.Y. 1985); *Allen v. Men's World Outlet, Inc.*, 679 F. Supp. 360, 370 (S.D.N.Y. 1988).

energy in developing her public image.¹²³ The similarity between Ms. Midler's voice and her soundalike was quite strong. In fact, Ms. Midler was told by several people that the voice in the commercial sounded just like her.¹²⁴

The third factor, the proximity of the plaintiff's and the defendant's products, is more problematic when dealing with a situation such as that presented in *Midler*, where the plaintiff and the defendant are not competitors in their goods and services.¹²⁵ In *Midler*, the plaintiff was not in competition with either of the defendants, an advertising agency and a car company. The third element in such a case therefore requires the application of a slightly different analysis than that articulated in *Allen v. Men's World Outlet, Inc.*¹²⁶

The court in *Allen v. Men's World Outlet* proposed that there is "an overlap between the Men's World audience of purchasers of discount clothing and Allen's audience of movie watchers."¹²⁷ A court faced with a *Midler* type situation should similarly assume that there is an "overlap" between purchasers of Ford cars and fans of Ms. Midler, whether they be movie-goers, television watchers, or people who appreciate her music. As a result, a defendant like Ford would be deemed to have "brought its product into proximity with"¹²⁸ Bette Midler by appealing to a particular sub-audience.

The fourth element in establishing the likelihood of confusion is evidence of actual confusion as to the source.¹²⁹ Actual confusion is not required for a cause of action to exist under the Lanham Act.¹³⁰ However, the existence of actual confusion is deemed "probative of the likelihood of confusion" in the future.¹³¹ Nonetheless, because actual confusion was evident in

¹²³ Ms. Midler's career has gone through various changes. Although she found fame singing in a gay bathhouse, it was not until her appearance on *The Tonight Show* that she received nationwide attention. However, eight years later, after establishing herself as a superstar in the music business and receiving an Oscar nomination for *The Rose*, Ms. Midler's career began to decline. Within three years, Ms. Midler's career became virtually nonexistent. All that changed, however, due to her contract with Touchstone Pictures. Today, with such hits as *Down and Out in Beverly Hills*, *Ruthless People*, *Outrageous Fortune*, *Big Business*, and *Beaches*, Ms. Midler's career is resurgent. Darrach & Hutchings, *The First Ladies of Laughter Double Up*, PEOPLE, June 20, 1988, at 77, 85.

¹²⁴ *Midler*, 849 F.2d at 461-62. See *supra* note 20 and accompanying text.

¹²⁵ See *Allen v. Men's World Outlet*, 679 F. Supp. at 368. See also *supra* notes 97-105 and accompanying text.

¹²⁶ 679 F. Supp. 360, 368-69 (S.D.N.Y. 1988).

¹²⁷ *Id.* at 368.

¹²⁸ *Id.* at 369.

¹²⁹ See *supra* notes 120-22 and accompanying text.

¹³⁰ *Allen v. Men's World Outlet*, 679 F. Supp. at 369.

¹³¹ *Id.*

*Midler*¹³² in that people mistook the soundalike for the well-known songstress, Ms. Midler would have been able to satisfy the fourth element, which only requires the likelihood of confusion.

The sophistication of the audience, the fifth factor requiring consideration, is difficult to ascertain because the viewing audience of a commercial is quite large. With regard to *Midler*, it would have been extremely difficult to determine whether the audience, as a whole, would recognize the real voice of Ms. Midler or not.

The final factor is the good or bad faith of the defendant, and Ms. Midler could easily have proven bad faith in the airing of the soundalike commercial. The evidence supporting a bad faith assertion lies in the fact that after the defendant failed to engage Ms. Midler to sing in the commercial, it then hired Ms. Midler's backup singers with the instruction to "sound as much as possible like the Bette Midler record."¹³³ The fact that a defendant may have a plausible reason for either facial or vocal imitation of a celebrity does not negate the bad faith involved with the intentional invocation of an undesired association with the plaintiff.¹³⁴

In sum, of the six factors to be considered when determining the existence of a likelihood of confusion in a voice imitation claim, the proximity of the plaintiff's and the defendant's products is the only factor which may prove difficult for future litigants. For instance, a celebrity plaintiff may have little in common with a defendant dry cleaner and would seldom, if ever, be in competition. The "overlap"¹³⁵ analysis resolves the difficulty litigants may face in satisfying the proximity requirement. A likelihood of confusion could have been found to have existed in *Midler*, as in most voice imitation claims, were this the adopted standard.

VII. CONCLUSION

Although recognized legal claims for relief are available for lookalike litigants,¹³⁶ soundalike litigants have, in the past, not

¹³² *Midler*, 849 F.2d at 461-62.

¹³³ *Id.* at 461.

¹³⁴ See *Allen v. National Video, Inc.*, 610 F. Supp. 612, 628 (S.D.N.Y. 1985). See also *Allen v. Men's World Outlet*, 679 F. Supp. at 369-70. The disclaimer did not negate the defendant's bad faith, revealed through affidavits, because it was clear that the defendant knew of Allen's previous litigation in *Allen v. National Video* and still failed to put the disclaimer in boldface and in a readily visible location. *Id.*

¹³⁵ See *supra* notes 125-27 and accompanying text.

¹³⁶ See *supra* note 5 and accompanying text.

been as fortunate.¹³⁷ A voice imitation claim may not be supported by the rights of privacy and publicity because of the uncertainty surrounding the application of these rights to voice imitation claims. Specifically, it is uncertain whether voice is included within the parameters of privacy statutes and, if so, whether it is protected against imitation.¹³⁸ With respect to the right of publicity, it is doubtful whether such a right even exists.¹³⁹ Furthermore, an unfair competition claim would, in all likelihood, also be unsuccessful because of the direct competition requirement¹⁴⁰ and federal policy considerations.¹⁴¹

The Ninth Circuit held in *Midler* that Ms. Midler had stated a cause of action for conscious misappropriation of, what they considered to be, Ms. Midler's "property" right in her voice.¹⁴² The misappropriation of Ms. Midler's voice was therefore deemed a common law tort under California law.¹⁴³ The court of appeals rejected her claims under the right of privacy and unfair competition laws. Moreover, the court did not have the opportunity to address the issues arising under the Lanham Act because these claims were time-barred.¹⁴⁴ For Ms. Midler, a cause of action under the Lanham Act would not have required proof of direct competition, thereby removing a difficult element from her case.

Elaine Windholz

¹³⁷ *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971); *Booth v. Colgate-Palmolive Co.*, 362 F. Supp. 343 (S.D.N.Y. 1973); *Lahr v. Adell Chem. Co.*, 300 F.2d 256 (1st Cir. 1962) (although court held plaintiff had not stated a cause of action under right of privacy since statute does not include voice, it upheld his action under unfair competition and defamation).

¹³⁸ See *supra* notes 50-62 and accompanying text.

¹³⁹ See *supra* note 49 and accompanying text.

¹⁴⁰ See *supra* notes 80-90 and accompanying text.

¹⁴¹ See *supra* notes 92-95 and accompanying text.

¹⁴² See *supra* note 69 and accompanying text.

¹⁴³ See *supra* note 70 and accompanying text.

¹⁴⁴ *Midler v. Ford Motor Co.*, No. 86 Civ. 2683 (C.D. Cal. Aug. 17, 1987) (Statement of Uncontroverted Facts, para. 19), *rev'd*, 849 F.2d 460 (9th Cir. 1988).