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Does the Right of Publicity Imperil Copyrights?

 By [Craig J. Albert](#)

New York Law Journal

Although songs of the 1960s and '70s are enjoying a renaissance in advertising, the recent 2nd U.S. Circuit Court of Appeals, decision in *Oliveira v. Frito-Lay, Inc.*^{[1]†} may destabilize the market for pre-1972 recordings. The case highlights a conflict between the right of publicity and copyright law.

When Frito-Lay tried to use "The Girl From Ipanema" in a potato chip commercial,^{[2]†} it licensed synchronization rights from the song's publisher and licensed the master recording itself directly from the record company that owned it. It never dealt with anyone representing either the recording's vocalist, Astrud Oliveira, or its other musicians because the recording pre-dated the 1971 Sound Recording Amendment to the Copyright Act.^{[3]†} Prior to that amendment, sound recordings were unprotected by U.S. copyright law and therefore the performers had no license to convey.^{[4]†}

Oliveira hoped to establish that the great value she brought to "The Girl From Ipanema" gave her the right to veto any commercial use of the song. The song's copyright stood in her way. Oliveira claimed to be "The Girl From Ipanema," contending the song is her "trademark." She asserted that Frito-Lay's use of the song diluted her trademark and misled the public into thinking she endorsed Frito-Lay chips.

Both the district and circuit courts rejected Oliveira's Lanham Act trademark claims.^{[5]†} But the 2nd Circuit held that upon such dismissal, the federal courts lacked jurisdiction over her pendent state-law claims, which included claims for unjust enrichment and violation of her rights of privacy and publicity. It therefore reversed the dismissal of those state claims, permitting the plaintiff to replead them in state court.^{[6]†}

Unanticipated Shock

This aspect of the decision represents an unanticipated shock to the market for recorded music.

Before Feb. 15, 1972 -- the effective date of the Sound Recording Amendment -- sound recordings were unprotected by federal copyright law. Those recordings remain unprotected, even though the law protects the songs themselves. As a result, the "rights" of the performers have, under industry practice, been largely unaccounted for in the negotiations over the licensing of these recordings. This is precisely what happened when Frito-Lay licensed "The Girl From Ipanema" for its commercial.

The market embodies industry customs that developed in order to maximize the joint return to the copyright owners. Since the publishers of a song are tenants in common of their copyright,^[7]† they must account to one another for any unauthorized disposition of any part of the composition.

Music industry custom has simplified the negotiation problem by reducing the number of negotiating parties through the use of agents. The vast majority of commercially successful composers, lyricists and producers delegate (via their publisher or copyright administrator) the authority to negotiate performance licenses to performing rights societies, while most publishers delegate authority to issue synchronization (and other) licenses to mechanical license agencies such as the Harry Fox Agency.^[8]†

Pre-1972 recordings -- including Oliveira's version of "The Girl From Ipanema" -- remain unprotected by copyright law, and the 1971 Sound Recording Amendment left undisturbed the agreements that created those recordings.

Agreements emerged in which publishers, co-publishers or agents could negotiate licenses on behalf of owners, which meant that the holder of the power to negotiate could provide the full package of rights that they might ever be called upon to license.

Artists could obtain a performance license from the agents and then retain the proceeds of their performances. They could record their performances in exchange for payment of a compulsory license fee^[9]† (after first usage) and then sell the recordings, although the prospect that their recording could be copied would keep the price of the recorded music low. Anyone who wanted to combine an existing song with an existing performer (to create an ad, for example) could contract with both.

New Rights

No one could have anticipated that a new set of rights of publicity would emerge slowly from courts and state legislatures beginning around 1953,^[10]† long after the industry had settled into a tradition of negotiating licenses.

Contracts often did not explicitly transfer to record companies the full set of rights that was subsequently recognized under state law.^[11]† Indeed, in Oliveira's case, there was no written transfer at all.^[12]† It was not until the post-1972 era, after a change in copyright law, that rights such as that asserted by Oliveira have been acknowledged and dealt with through contract. In contrast, there was little bargaining over those rights in the pre-1972 era. In effect, Oliveira is seeking to be compensated for a right that no one knew existed.

Although all the 2nd Circuit did in *Oliveira* was acknowledge that, despite the absence of any federal trademark rights in her performance, Oliveira might have state rights of privacy and publicity, the court's recognition of the possibility that recording vocalists might have a retroactive property right in pre-1972 recordings poses a problem for the advertising industry.

Even if Oliveira ultimately loses on her state law claims in New York,

the "risk" that at least one of the 50 states may recognize the kinds of rights she is claiming is very real.^{[13]†} Since the ownership of such rights is likely separate from the underlying copyright, the coordination problems that the industry strived to avoid through their post-1909 customs are created afresh. The result may be the wasteful expenditure of resources in negotiating licenses for the use of this substantial body of recorded music.

Post '*Oliveira*'

After the *Oliveira* decision, in order to avoid the kinds of claims *Oliveira* made against Frito-Lay, those who wish to use pre-1972 recorded vocal music would need to identify each of the vocalists on the recording. For each one, they would need to determine who owns the master recording; what the terms of the engagement of the vocalists were; and whether the engagement was reduced to a writing. If the general right of publicity and privacy has not been expressly bargained for, then the prospective licensee would have to bargain for it with the vocalist or his estate.

The uncertainties associated with *Oliveira* -- particularly in those cases where documentation is absent or incomplete -- create an instability in the worldwide market for U.S. copyrighted music.

The recognition of state publicity rights, which undercut the value of the international copyright, renders U.S. copyright protection less valuable, and imperils the validity of U.S. copyrights in foreign jurisdictions that have joined the Berne Convention. Thus, even though the United States had been able to live without federal pre-emption of those state-law rights in the pre-Berne era, it should re-evaluate that position now.

The risks associated with these state-based rights is especially acute because the right most protective of the performer flows easily across state borders. Vocalists will invoke the law of the state with the most expansive version of the right, apparently without regard to whether the vocalist actually has some connection with that state.

For example, after John Lennon's death, Apple Corps invoked the Tennessee right of publicity of the Beatles in order to prohibit a Beatles "clone" group from performing Beatles songs, as Tennessee's statute recognizes the right in the dead as well as in the living.^{[14]†}

Similarly, since the estate was unlikely to prevail on a claim that its statutory right of privacy survives death,^{[15]†} Elvis Presley's estate invoked the general common law of publicity when it first sought to enjoin commercial distributions of Elvis memorial posters after his death. The legislature acted, though, and Elvis now stays close to home, invoking Tennessee's later-adopted Personal Rights Protection Act of 1984.^{[16]†}

The reason *Oliveira* brought her suit in New York in the first place is because the state's Civil Rights Law recognizes a property right in the use of one's voice in connection with trade or advertising.^{[17]†}

Conclusion

Those who would use this music need to tread carefully when dealing with music that has had a particularly memorable recording.

In those cases, and until the law is clarified, practitioners would do best to identify the performers whose work contributed to the recording at issue, to determine whether they have retained any rights in the performance, and then (to the extent possible) attempt to bargain for those rights in connection with the proposed use.

At the federal level, Congress should consider whether these nascent state rights of privacy and publicity ought to be pre-empted by federal law, and to act promptly to adopt corrective legislation if it determines that the federal interest in uniformity ought to trump the lowest common denominator of state-law rights.

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FootNotes:

[1] 251 F.3d 56 (2d Cir. 2001).

[2] *Id.* at 58.

[3] Pub. L. No. 92-140, 85 Stat. 391 (1971).

[4] After the amendment, the performers are unlikely to have retained any copyright, either because the artists transfer their rights to record companies or because the recordings are "works for hire."

[5] 251 F.3d at 60-61.

[6] 251 F.3d at 64-65.

[7] *Thomson v. Larson*, 147 F.3d 195, 199 (2d Cir. 1998); *Childress v. Taylor*, 945 F.2d 500, 508 (2d Cir. 1971); *Papa's-June Music, Inc. v. McLean*, 921 F. Supp. 1154, 1158 (S.D.N.Y. 1996).

[8] The Harry Fox Agency is the licensing arm of the National Music Publishers Association.

[9] 17 U.S.C. § 115.

[10] The term "right of publicity" was coined in *Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

[11] Presumably the artists' common law copyright in their performances have vested in the record companies by virtue of the fact that the statute of limitations on such claims with respect to pre-1972 recordings is long past. New York has recognized the common law copyright in performances as being analogous to the common law copyright of writers in their unpublished works. *Capitol Records, Inc. v. Greatest Records, Inc.*, 43 Misc.2d 878, 881, 252 N.Y.S.2d 553, 555-

56 (Sup. Ct. N.Y. Co. 1964); Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp., 199 Misc. 786, 101 N.Y.S.2d 483 (Sup. Ct. N.Y. Co. 1950).

[12] 251 F.3d at 58-59.

[13] The dynamic is illustrated by the example of Tennessee's adoption of the posthumous right of publicity, Tenn. Code Ann. §§ 47-25-1103(b), and by the unsettled nature of the question of whether the Lanham Act pre-empts state rights of publicity. See Richard S. Robinson, Pre-emption, The Right of Publicity, And a New Federal Statute, 16 Cardozo Arts & Ent. L. J. 183, 196-99 (1998).

[14] Apple Corps Ltd. v. A.D.P.R., Inc., 843 F. Supp. 342 (M.D. Tenn. 1993).

[15] See Price v. Hal Roach Studios, Inc., 400 F. Supp. 836 (S.D.N.Y. 1975)

[16] Tenn. Code Ann. § 47-25-1101 to -1108. The district court in Memphis Development Foundation v. Factors, Inc., 441 F.Supp. 1323 (W.D. Tenn.1977) had earlier held that the right did not survive death.

[17] Civil Rights Law § 51 (McKinney's 2002 Supp.).

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