

## In Lieu of Moral Rights for IP-Wronged Music Vocalists: Personhood Theory, Moral Rights, and the WPPT Revisited

Tuneen E. Chisolm

Follow this and additional works at: <https://scholarship.law.stjohns.edu/lawreview>

---

This Article is brought to you for free and open access by the Journals at St. John's Law Scholarship Repository. It has been accepted for inclusion in St. John's Law Review by an authorized editor of St. John's Law Scholarship Repository. For more information, please contact [selbyc@stjohns.edu](mailto:selbyc@stjohns.edu).

# IN LIEU OF MORAL RIGHTS FOR IP- WRONGED MUSIC VOCALISTS: PERSONHOOD THEORY, MORAL RIGHTS, AND THE WPPT REVISITED

©TUNEEN E. CHISOLM<sup>†</sup>

## INTRODUCTION

Copyright law in the United States is failing music performers,<sup>1</sup> and most specifically, music vocalists. The utilitarian/economic incentive-based copyright regime not only minimizes the creative contribution of music performers<sup>2</sup> and subjects the exclusive rights to exploit their works to an ever-widening range of fair use exceptions, but it also disregards the personhood interests of most actual creators entirely.<sup>3</sup> That disregard of personhood interests affects music vocalists more than authors of other copyrightable works because “a voice is as distinctive and personal as a face. The human voice is one of the

---

<sup>†</sup> Assistant Professor, Campbell University School of Law; J.D., University of Pennsylvania Law School; Sc.B., Brown University. With gratitude, I acknowledge my former research assistants: Deirdre A. Clarke, for her foundational research when this article was but a budding thought, and Nourma Bumgarner, for her comprehensive research and enthusiastic support during my early drafts. I am ever appreciative of the invaluable insight and constructive critiques of interim drafts from my commenters at the 2017 Lutie Lytle Writing Workshop, the 2017 IPSC at Cardozo, and the 2017 UNH Intellectual Property Scholars Roundtable.

<sup>1</sup> See David Dante Troutt, *I Own Therefore I Am: Copyright, Personality, and Soul Music in the Digital Commons*, 20 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 373, 391–95 (2010) (focusing on personality interests in providing a written tour of “the history of African-American musical authorship to show how, like canaries in a coalmine, the appropriative harms committed against them were facilitated by the structure of copyright law and repeated against other musical authors”).

<sup>2</sup> See Tuneen E. Chisolm, *Whose Song Is That? Searching For Equity and Inspiration For Music Vocalists Under the Copyright Act*, 19 *YALE J.L. & TECH.* 274, 277–78, 291–305 (2017) (discussing the disparate treatment of music vocalists under copyright law, as compared to music composers, regarding authorship, ownership, fixation requirements, and available protections).

<sup>3</sup> Troutt, *supra* note 1, at 377.

most palpable ways identity is manifested. [And thus,] especially [as to . . .] a singer of renown, [t]he singer manifests herself in the song.”<sup>4</sup>

An undergirding problem exacerbating the lack of personhood rights is that the U.S. copyright regime aims to maximize distribution of and access to creative works for societal benefits, in exchange for economic rewards to copyright *owners*, which are assumed to be sufficient incentives for *authors* to create.<sup>5</sup> But owners and authors are not necessarily identical. That nonidentity leads to inequitable results for music performers who, as a group, lose control of when, how, in what context, and by whom their recorded performances are used, because the sound recording copyright is the only available copyright protection for their performances, and typically their record labels own that copyright.<sup>6</sup>

Both economic<sup>7</sup> and noneconomic consequences flow from the inability to manage and control the presentation of their works to the public that consumes their works. This Article focuses on the noneconomic consequences primarily for music vocalists, although non-composer musicians who suffer similar loss of control of their recordings and related consequences may also benefit from the arguments presented.

As Professor David Dante Troutt so aptly stated: “we often know an interest by the harms to it,” and “the measure of what is gained by copyright ownership is what is *not lost* to coerced control, unauthorized adaption or infringement.”<sup>8</sup> And so, let us begin with the harms to music vocalists.

---

<sup>4</sup> *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (recognizing a new tort of misappropriation of voice under California law, applicable to commercial use of widely known and deliberately imitated distinctive voices).

<sup>5</sup> See Linda J. Lacey, *Of Bread and Roses and Copyrights*, 1989 DUKE L.J. 1532, 1532–37 (1990) (challenging this dual purpose of copyright as “an unsuccessful attempt to impose socialist ideals upon a capitalistic framework,” and arguing that “if we really are interested in the artists’ actual needs, we should recognize the European concept of moral rights, which preserve the bond between the artist and her work”) (citations omitted).

<sup>6</sup> Chisolm, *supra* note 2, at 378, 291–305.

<sup>7</sup> See *Gilliam v. American Broadcasting Comp., Inc.*, 538 F.2d 14, 24 (2d Cir. 1976). A clear economic consequence to the allocation of sound recording copyright ownership and control is that music performers enjoy little to no passive income generation from the exploitation of their recorded performances. See Chisolm, *supra* note 2, at 315–20 (2017) (discussing sources of passive income for composers versus recording artists, and comparisons of the two).

<sup>8</sup> Troutt, *supra* note 1, at 391–92 (emphasis added).

Amid the 2016 presidential election campaigns, one news report raised a question about music use in campaigns that has been a recurring issue in every presidential election for the past two decades: “do bands have any recourse to stop politicians [from using their music], aside from making public statements and hoping to shame them into pulling the songs from their campaigns?”<sup>9</sup> The Rolling Stones, Sting, Adele, John Cougar Mellencamp, Tom Petty, Van Halen, Bon Jovi, ABBA, Survivor, Neil Young, Aerosmith’s Steven Tyler, Jackson Browne, Sam & Dave’s Sam Moore, Talking Heads’ David Byrne, and Somali-Canadian rapper K’naan are all among the growing list of recording artists who have taken issue with politicians playing “their songs” for campaign purposes.<sup>10</sup> The answer to the question, as the news article correctly suggested, is “both yes and no.”<sup>11</sup> The “yes” or “no” may depend upon “how the songs are used”<sup>12</sup> for a songwriter/composer who owns or controls the copyright in the underlying music composition of the song at issue.<sup>13</sup> But for recording artists who are non-composer

---

<sup>9</sup> Travis M. Andrews, *The Rolling Stones Demand Trump Stop Using its Music at Rallies, but Can the Band Actually Stop Him?*, WASH. POST (May 5, 2016, 9:46 AM), [https://www.washingtonpost.com/news/morning-mix/wp/2016/05/05/the-rolling-stones-demand-trump-stop-using-its-music-at-rallies-but-can-the-band-actually-stop-him/?utm\\_term=.b26fdc78f53e](https://www.washingtonpost.com/news/morning-mix/wp/2016/05/05/the-rolling-stones-demand-trump-stop-using-its-music-at-rallies-but-can-the-band-actually-stop-him/?utm_term=.b26fdc78f53e).

<sup>10</sup> *Id.*; Eveline Chao, *Stop Using My Songs: 35 Artists Who Fought Politicians Over Their Music*, ROLLING STONE (July 8, 2015), <http://www.rollingstone.com/music/lists/stop-using-my-song-34-artists-who-fought-politicians-over-their-music-20150708/knaan-vs-mitt-romney-20150629>; see also David C. Johnston, *The Singer Did Not Approve This Message: Analyzing the Unauthorized Use of Copyrighted Music in Political Advertisements in Jackson Browne v. John McCain*, 27 CARDOZO ARTS & ENT. L.J. 687, 688–89 (2010) (detailing various artists’ demands regarding public performances of songs by presidential candidates in each election between 1996 and 2008).

<sup>11</sup> Andrews, *supra* note 9.

<sup>12</sup> *Id.*

<sup>13</sup> See, e.g., *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1164 (C.D. Cal. 2010) (succeeding on claim for infringement of composition copyright, where politician Charles DeVore’s revised lyrics to Don Henley’s for use in his campaign ads and fair use defense did not apply). Blanket licenses from a performing rights society may allow legal use over the objections of the composer, leaving the decision to stop or not to the politician. Andrews, *supra* note 9. In 2012, campaign representatives for then presidential candidate Mitt Romney claimed to have blanket licenses from ASCAP and BMI to play the song “Wavin’ Flag” at a rally, in response to objections from rapper K’naan. Chao, *supra* note 10. Reportedly, the rapper “was deluged with Twitter messages accusing him of selling out to a conservative politician. The musician threatened legal action against the Romney campaign, explaining, ‘I’m for immigrants. I’m for poor people, and they don’t seem to be what he’s endorsing.’ He also added that he would ‘happily grant the Obama campaign use of my song without prejudice.’” *Id.* Despite the valid licenses, Romney ceased use. *Id.*; see also

musicians or non-composer vocalists, the answer is simply no. That “no” applies not only with respect to use of recorded performances for political campaigns, but also to their use for soundtracks, advertising, sampling, and many other uses that may conflict with the recording artist’s personal values, beliefs, or artistic preferences.<sup>14</sup>

Consider next a scenario in which an unproven female vocalist, barely the age of twenty and devoid of bargaining power, enters into a recording contract that requires assignment of all copyrights in her recorded performances to the record label. The young woman’s career flounders at first, but just when the label is ready to drop her, she has a hit record, her contract is renewed, and her career takes off making her an international, chart-topping star. Years later, her career is abruptly halted when she is bound to a chair, gagged, raped, and tortured at knife-point for two and a half hours by an unknown assailant who breaks into her hotel room during a concert tour. An all-male jury awards her \$2.5 million on claims against the hotel, but she suffers from continuing trauma, depression, and suicidal ideation. Then, despite public knowledge of her violent rape and continuing mental condition, her record label licenses two of her signature hit songs for use in a film riddled with sex, prostitution, suicide, and rape. A federal district court holds that, because her recording contract transferred the copyrights in her sound recordings to the record label, there is no claim the vocalist can bring and nothing she can do to obtain relief from the licensed use of her recorded vocal performances in a film she finds objectionable and even emotionally devastating. This scenario is not fiction; it all happened to singer Connie Francis.<sup>15</sup>

In addition to political uses and soundtrack uses, there are numerous examples of commercial advertising uses and music sampling uses of vocalists’ performances without their contemporaneous permission. So what are the harms?

---

James C. McKinley Jr., *G.O.P. Candidates Are Told, Don't Use the Verses, It's Not Your Song*, N.Y. TIMES (Feb. 3, 2012), <http://www.nytimes.com/2012/02/04/arts/music/romney-and-gingrich-pull-songs-after-complaints.html>.

<sup>14</sup> Troutt, *supra* note 1, at 422–23.

<sup>15</sup> See *Franconero v. Universal Music Corp.*, 02 Civ. 1963, 2003 WL 22990060, \*1–2 (S.D.N.Y. Dec. 19, 2003); CONNIE FRANCIS, WHO'S SORRY Now 107, 117, 253–267 & 317–320; (1984); Max H. Segel, *Jury Awards Connie Francis \$2.5 Million in Westbury Rape*, N.Y. TIMES (July 2, 1976), <https://www.nytimes.com/1976/07/02/archives/jury-awards-connie-francis-25-million-in-westbury-rape.html>.

The harms can be characterized as objectionable associations and ideological conflicts arising from unbridled exploitation of feature vocal performances, which arguably are among the most personal works of authorship of all. It would seem a basic, almost common-sense imperative that a person's voice captured in a recording is necessarily an extension of individual personhood worthy of legal protection from uses and, more specifically, from harmful associations, not personally authorized by the vocalist. After all, courts have applied tort law and unfair competition law to prohibit the mere *imitation* of distinctive voices in advertisements, based on theories of false endorsement and misappropriation of voice.<sup>16</sup> Where, then, is the protection for the music vocalist against the unchecked use of their *actual* voice, as embodied in sound recordings, for: political campaigns by politicians whom the artist does not support<sup>17</sup>; soundtracks to films or sampling in other music with objectionable content; advertising campaigns for products and other causes that are contrary to the artist's personal values and beliefs; and even unimagined objectionable uses such as music torture?<sup>18</sup> Protection against those uses generally fails because the making of the sound recording was authorized by the artist, with no retained right of control as to its subsequent use.

Music vocalists would have some redress if U.S. copyright law specifically granted a moral right of integrity, which gives authors some ability to control the context in which their creative works are used, even after transfer of their economic interests in the work.<sup>19</sup> But despite obligations to grant a moral right of

---

<sup>16</sup> See *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1021 (3d Cir. 2008); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1107 (9th Cir. 1992) (false endorsement and misappropriation of voice); *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (holding that “when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California”).

<sup>17</sup> Unwanted associations with political campaigns and other causes may also cause economic harm if the artist's fans perceive the artist to have “sold out” or otherwise condoned principles associated with the politician or cause, that are antithetical to principles espoused by the artists, or those held by the fan-base.

<sup>18</sup> See Anna J. Mitran, Note, *Facing the Music: Moral Intellectual Property Rights As A Solution To Artist Outrage About Music Torture*, 101 CORNELL L. REV. 505, 506–08 (2016) (citing various reports on the use of music torture as an interrogation technique for detainees).

<sup>19</sup> See, e.g., Tanja Makovec Petrik, *Moral Rights of Composers: The Protection of Attribution and Integrity Available to Musicians in the European Union and The United States*, 22 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 359, 374–80 (2012)

integrity under international treaties, such as the World Intellectual Property Organization's Performances and Phonograms Treaty, which is specific to music vocalists and other performers, and under the Berne Convention for the Protection of Literary and Artistic Works, which applies to other authors, the United States has steadfastly resisted an explicit grant of moral rights, leaving all but a select subset of visual artists to depend upon alternative legal theories for redress in domestic disputes.<sup>20</sup>

Increasingly, the alternative legal theories have fallen short of standing in the gap for the unavailable moral rights, particularly as it concerns non-composer recording artists. Case law has whittled them down, substantially. For decades, various scholars have acknowledged the gap in protection and argued for a legislative grant of some set of express moral rights in the United States, but most of the scholarly literature pays little attention, if any, to music vocalists.<sup>21</sup> This Article takes a

---

(providing a comparative analysis of the case outcomes for right-of-integrity-based lawsuits in the United States, France, and Spain).

<sup>20</sup> Notably, even after finally becoming a signatory to the Berne Convention for the Protection of Literary and Artistic Works—which mandates that signatories provide a right of integrity and right of attribution for creators of specific artistic works, but excludes musical performances from the definition of such works—the United States opted to grant limited moral rights to only a subset of visual artists via the Visual Artists Rights Act of 1990. See 17 U.S.C. § 106A (2012); Visual Artists Rights Act of 1990, title VI of the Judicial Improvements Act of 1990, Pub. L. No. 101-650, 104 Stat. 5089, 5128 (1990); Berne Convention for the Protection of Literary and Artistic Works, art. 2(1) & art. 6bis(1), Sept. 9, 1886, 102 Stat. 2853, 828 U.N.T.S. 221 (revised at Paris on July 24, 1971) [hereinafter Berne Convention].

<sup>21</sup> See, e.g., Jane C. Ginsburg, *The Most Moral of Rights: The Right to Be Recognized as the Author of One's Work*, 8 GEO. MASON J. INT'L COM. L. 44, 72 (2016); Petrik, *supra* note 19, at 359 (arguing for a “limited, but explicit, [] moral rights protection for musical composers”); Roberta Rosenthal Kwall, *The Attribution Right in the United States: Caught in the Crossfire Between Copyright and Section 43(a)*, 77 WASH. L. REV. 985, 1027 (2002) (arguing for “adoption of non-waivable, explicit, and broadly defined right of attribution” for all authors of copyrightable works); Lacey, *supra* note 5, at 1537 (proposing moral rights for writers and visual artists); Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 VAND. L. REV. 1, 72–91 (1985) (discussing, prior to the United States' accession to the Berne Convention, how the Copyright Act of 1976 could be amended to explicitly recognize “an American variation of the moral right doctrine”); cf. Justin Hughes, *American Moral Rights and Fixing the Dastar “Gap”*, 2007 UTAH L. REV. 659, 660, 700 (2007) (examining failure of the “patchwork” of alternative theories to moral rights, and proposing amendment of Lanham Act § 45 to define “origin” as used in § 43(a) to apply to authors of copyrighted works); Robert C. Bird & Lucille M. Ponte, *Protecting Moral Rights in the United States and the United Kingdom: Challenges and Opportunities under the U.K.'s New Performances Regulations*, 24 B.U. INT'L L.J. 213, 276–81 (2006) (considering how online music performance could influence amendment of VARA or enactment of separate

different approach and argues for amendments to copyright law which would serve the interests of music vocalists, short of an explicit grant of moral rights.

The first proposed amendment would provide a licensable, but otherwise inalienable copyright in a music vocalist's fixed performance as an "applied composition" that coexists with, but is separate from, the sound recording copyright; the second amendment would restrict the permissible derivative works from a sound recording to use of the integrated whole with music vocalist consent.<sup>22</sup> Challenging the ingrained notion that the only two copyrights at issue for nondramatic music are those for music compositions and sound recordings, this author first proposed the amendments in a recent article focused on the economic inequities that plague music vocalists as a result of limited copyright protections and copyright control issues.<sup>23</sup> That article noted that such amendments were "a necessary precursor to remedying the music vocalist's lack of control over creative works that are essentially an extension of their person," but reserved the argument regarding personhood theory and moral rights for another day.<sup>24</sup> This Article takes up that argument.

Professor Troutt urged that "the personality interest should be elevated from its prior lurking status and paired with the dominant economic interest."<sup>25</sup> The amendments proposed in this Article accomplish that aim.

The Introduction of this Article has identified some of the noneconomic harms of concern. Part I summarizes and compares copyright ownership, control, and existing protections for authors of music compositions and sound recordings under the Copyright Act. It also summarizes pertinent music industry practices that impact third party use of recorded vocalist performances. Part II provides a foundation for understanding the nature of legal protections for creative works and the philosophical underpinnings of copyright law and moral rights, comparing utilitarianism and natural rights theory to personhood theory. It also provides a brief explanation of moral rights. Part III looks

---

legislation to extend moral rights to music composers and musicians); Patrick G. Zabatta, Note, *Moral Rights and Musical Works: Are Composers Getting Berned?*, 43 SYRACUSE L. REV. 1095, 1101–02 (1992).

<sup>22</sup> Chisolm, *supra* note 2, at 281–82, 330–33.

<sup>23</sup> *Id. passim*.

<sup>24</sup> *Id.* at 333, 330 n.264.

<sup>25</sup> Troutt, *supra* note 1, at 434.



at the United States' obligations to music vocalists under the WPPT and discusses how pertinent U.S. legislative actions driven by the Berne Convention for the Protection of Literary and Artistic Works have worked to widen the gap in protections for music vocalists. Part IV returns to discussion of the harms, to illustrate how claims sounding in contract, tort, and unfair competition (specifically trademark infringement, false designation of origin, and false endorsement) have become increasingly ineffective as paths to redress of harms to personhood-based rights, generally and, in particular, for music vocalists. Finally, Part V details the proposed amendments and demonstrates how they would provide the necessary redress, in reasonable alignment with the utilitarian/economic incentive aim of U.S. copyright law and the intent of the WIPO's Performances and Phonograms Treaty.

## I. U.S. MUSIC COPYRIGHT AND PERTINENT INDUSTRY PRACTICES

### A. *Current U.S. Copyright for Nondramatic Music-Related Works*

U.S. copyright protections apply to “original works of authorship fixed in any tangible medium of expression” in eight categories, only two of which concern non-dramatic music-related works: “musical works, including any accompanying words” and sound recordings.<sup>26</sup> Pursuant to § 106 of the Act, the copyright owner obtains a bundle of exclusive rights to do or to authorize others to do the following: reproduce the work, prepare derivative works, distribute the work to the public, perform and display the work publicly—these two being inapplicable to sound recordings—and, as to sound recordings only, perform the work publicly by means of a digital audio transmission.<sup>27</sup>

#### 1. Music Compositions

The term “musical works” is consistently construed to refer to the musical composition, consisting of music score and lyrics; it does not include performances.<sup>28</sup> The owner of a copyright in a

---

<sup>26</sup> 17 U.S.C. § 102(a) (2012) (enumerating works of authorship).

<sup>27</sup> *Id.* § 106.

<sup>28</sup> Congress intentionally did not define the term “musical works,” but instead relied upon its “fairly settled meaning.” H.R. REP. NO. 94-1476, at 53 (1976), *as*

musical composition—typically the composer(s) and/or publishing company as assignee—obtains all exclusive rights provided by § 106, except the right to perform the work publicly by means of a digital audio transmission, which is included in the more general right to perform the work publicly.<sup>29</sup>

The exclusive right to make and distribute phonorecords of music compositions is subject to a compulsory mechanical license upon compliance with statutory provisions set forth in § 115 of the Act.<sup>30</sup> That compulsory license is what allows other recording artists to make “covers” of a song, after the composer authorizes release of a first recording to the public.<sup>31</sup> The compulsory license also allows the cover artist to adapt the musical arrangement of the work “to the extent necessary to conform it to the style or manner of interpretation of the performance involved,” but prohibits “chang[ing] the basic melody or fundamental character of the work.”<sup>32</sup> Some have suggested that this qualification of the compulsory licensing scheme is an express codification of the moral right of integrity, but the statutory limitation serves the interests of the copyright owner, not the artistic interests of the author.<sup>33</sup>

## 2. Sound Recordings

“Sound recordings” are defined as “works that result from the fixation of a series of musical, spoken, or other sounds, [excluding] the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material objects, such as disks, tapes, or other phonorecords, in which they are embodied.”<sup>34</sup> The sound recording copyright is intentionally limited. The owner of a sound recording copyright obtains the exclusive rights to copy, prepare derivative works, and distribute copies or phonorecords to the public, as well as the right to

---

reprinted in 1976 U.S.C.A.N. 5659, 5666-67. See also U.S. Copyright OFF., *Compendium of U.S. Copyright Office Practices* § 101, § 802.1 (3d ed. 2017), <https://www.copyright.gov/comp3/docs/compendium.pdf> [hereinafter Copyright Compendium] (“For purposes of copyright registration, musical works (which are also known as musical compositions) are original works of authorship, consisting of music and any accompanying words.”).

<sup>29</sup> See 17 U.S.C. § 106(6) (limiting the right to publicly perform a work through digital audio transmission to sound recordings).

<sup>30</sup> *Id.* § 115.

<sup>31</sup> *Id.* § 115(a)(1).

<sup>32</sup> *Id.* § 115(a)(2).

<sup>33</sup> See Petrik, *supra* note 19, at 370.

<sup>34</sup> 17 U.S.C. § 101.

perform the work publicly by means of digital transmission.<sup>35</sup> Due to the absence of the more general right of public performance from the sound recording exclusive rights bundle, the owner of the sound recording copyright is unable to prevent terrestrial broadcasters, restaurants, bars, stadiums, and other public forums from playing the sound recording once the first record has been sold.<sup>36</sup>

### 3. Vocal Performances

Currently, a music vocalist's performance is treated as merely a contribution to the sound recording; it is not currently recognized as a copyrightable work separate and apart from the sound recording.<sup>37</sup> This is so, even though the vocalist's performance otherwise meets the criteria for an original creative work and, in fact, provides the basis for the vocalist's recognized authorship of the sound recording that captures the performance.<sup>38</sup>

---

<sup>35</sup> The digital performance right was first added to the copyright bundle for sound recordings under the Digital Performance Right in Sound Recordings Act in 1995, and later expanded by the Digital Millennium Copyright Act of 1998 (the "DMCA"). Digital Performance Right in Sound Recordings Act of 1995, Pub. L. No. 10439, § 2, 109 Stat. 336 (1995) (codified at 17 U.S.C. § 106(6) (2012)); Digital Millennium Copyright Act of 1998, Pub. L. No. 105-304, §§ 402, 405, 112 Stat. 2860, 2888, 2890-2902 (1998). Due to the expanded digital performance right, all digital broadcasters—such as iHeart Radio, Pandora, Spotify, and other subscription and non-subscription interactive digital music providers—must pay royalties to the sound recording copyright holders. Non-interactive internet radio stations can qualify for a compulsory license under § 114 of the Act and pay a statutory fee. Interactive digital transmission providers must negotiate their royalty rate. For the terms of qualification for compulsory digital transmission licensing, *see generally* 17 U.S.C. § 114.

<sup>36</sup> *See, e.g.,* RCA Mfg. Co. v. Whiteman, 114 F.2d 86, 88 (2d Cir. 1940).

<sup>37</sup> Copyright Compendium, *supra* note 28, at § 803.3A ("Examples of performance authorship include playing an instrument, singing, speaking, or creating other sounds that are captured and fixed in the sound recording. Individual performance authorship may be claimed only if the sound recording is comprised solely of an individual performance that is sufficiently creative. If a performance is part of an integrated work (*e.g.*, a band performance), the Office will not accept a claim in an individual performer's contribution to that work.")

<sup>38</sup> For an in-depth discussion of why, once fixed, music vocalist performances should be treated as copyrightable works capable of subsisting on their own, but separate from the sound recording, *see* Chisolm, *supra* note 2, at 291–300.

### B. *Authorship, Ownership, and Copyright Control Issues*

While the music composition copyright vests in the composer(s) of the music score and any lyrics as author(s) under § 201(a), authorship is not statutorily specified for sound recordings, and there is substantial ambiguity around whether a record label may claim author status under the work-for-hire doctrine.<sup>39</sup> Certainly the recording artist is an author, by virtue of his or her copyrightable performance. But, the legislative history leaves the door open to claims of authorship by whomever is “responsible for setting up the recording session, capturing and electronically processing the sounds, and compiling and editing them to make the final . . . recording,” which extends authorship to sound engineers and producers, and, arguably, even record labels employing such persons.<sup>40</sup>

This disparate treatment of music composer and music performer authorship under the Copyright Act leads to differences in copyright exploitation control.

#### 1. Controlling Music Composition Copyright Exploitation

Composers generally control exploitation of music compositions via their chosen music publisher and licensing agents.<sup>41</sup> The music publishing company may be wholly owned by the composer, in which case the composer effectively retains full control of the copyright and all royalties from its exploitation as a writer-publisher. Or, the music publishing company may be an affiliate of a record label, in which case the composer may (a) co-own the copyright with the music publishing company or transfer the copyright completely, (b) share or cede control of administration, and (c) share royalties from exploitation of the copyright.<sup>42</sup>

---

<sup>39</sup> See *id.* at 288–90. The work-made-for-hire doctrine provides that, absent a signed written agreement to the contrary, an employer is deemed the author of a work prepared by an employee within the scope of employment; in addition, “a work specially ordered or commissioned” for any of the ten uses specified in § 101 of the Copyright Act will also be deemed a work-made-for-hire if the parties expressly agree in a written instrument signed by them that it shall be considered as such.

<sup>40</sup> See H.R. REP. NO. 92-487, at 5 (1971), as reprinted in 1971 U.S.C.C.A.N. at 1570.

<sup>41</sup> Generally, the composer assigns the composition copyright to a music publishing company for administration of rights, which includes, among other things, seeking opportunities for exploitation of the composition and issuing licenses for use. See DONALD S. PASSMAN, ALL YOU NEED TO KNOW ABOUT THE MUSIC BUSINESS 222 (9th ed. 2017).

<sup>42</sup> See *id.* at 222–23, 304–05.

The three vehicles for controlling the use of music compositions and generating royalties are mechanical licensing and non-dramatic performance rights licensing, the primary two, and “everything else.” Mechanical licenses—for the right to record a song and distribute the recording in any format—may be issued by the music publisher directly or, more likely, by a mechanical licensing agent such as the Harry Fox Agency, which also issues most mechanical licenses for covers.<sup>43</sup> Non-dramatic public performance licensing covers everything from playing songs on radio and television, to karaoke and jukeboxes, to playing music in various public spaces, including restaurants, elevators, bars, stadiums, and live concerts.<sup>44</sup> Performing rights societies (“PRSs”), such as ASCAP, BMI, and SESAC, monitor public performance of compositions and manage royalties generated from PRS blanket licenses issued to third parties for the right to play all songs that are represented by the specific PRS.<sup>45</sup> The music publishing company handles all other licensing, including for use of the composition in domestic films, television and radio commercials, video games, webcasting, podcasting, and video streaming,<sup>46</sup> as well as grand performance rights use in dramatic works, such as plays and operas.

## 2. Controlling Sound Recording Copyright Exploitation

As a direct result of the copyright ownership allocation achieved through express written assignment required in most recording agreements, the record label, not the recording artist, controls the use of the sound recordings that embody the

---

<sup>43</sup> The Harry Fox Agency is a popular clearing house for this purpose. See *HFA: A Legacy of Trust, A Commitment to New Technology*, HFA, [https://www.harryfox.com/find\\_out/aboutus.html](https://www.harryfox.com/find_out/aboutus.html).

<sup>44</sup> See, e.g., *ASCAP Publisher Agreements and Writer Agreements* ¶ 9, ASCAP, <https://www.ascap.com/about/join/membership-agreement> (last visited Oct. 23, 2018) (defining “public performance” as “vocal, instrumental and/or mechanical renditions and representations in any manner or by any method whatsoever, including transmissions by radio and television broadcasting stations, transmission by telephony and/or ‘wired wireless’; and/or reproductions of performances and renditions by means of devices for reproducing sound recorded in synchronism or timed relation with the taking of motion pictures”).

<sup>45</sup> Music publishers may affiliate with one or more of the PRSs for non-exclusive administration of the publisher’s catalog of copyright interests, while composers may individually affiliate with the PRS of their choice, for non-exclusive administration of all their composition copyrights. PASSMAN, *supra* note 41, at 238–39.

<sup>46</sup> See *id.* at 244–59.

recording artist's performance.<sup>47</sup> That said, while digital performance use for interactive internet services can be negotiated, there is no control to be had over digital transmission public performances by non-interactive internet service providers that qualify for the compulsory license under § 114 of the Act. SoundExchange, an independent digital performance rights organization, functions as a monitoring service for public performances of the sound recording by digital transmission; it collects and distributes the royalties paid, but, in contrast to the PRSs which issue blanket licenses, SoundExchange does not control which recordings are played by which third parties.<sup>48</sup>

Record labels also control licensing of the masters for the use of a sound recording in a film, television show, commercial, or video game.<sup>49</sup> In some cases, depending upon the degree of bargaining power the recording artist had at the time of the recording contract negotiations, the recording contract may require the record label to seek the artist's consent for certain uses of the sound recordings produced under the recording contract. But, more often than not, the record label has full control over the issuance of master licenses.

### 3. Required Copyright Licenses for Third Party Use of Songs

The most common harms to personhood rights for music vocalists are caused by use for objectionable political associations, commercials, soundtracks, and derivative musical

---

<sup>47</sup> Howard Cockrill, *Tuning the Dial on Internet Radio: The DPRA, the DMCA & the General Public Performance Right in Sound Recordings*, 9 INTELL. PROP. L. BULL. 103, 105 (2005). See also Richard Salmon, *Recording Contracts Explained*, SOUND ON SOUND (Apr. 2007), <https://www.soundonsound.com/music-business/recording-contracts-explained>.

<sup>48</sup> Rather, it collects royalties due from service providers who stream music content, allocates the fees collected to recordings based upon frequency of song play, and then pays out those royalties, with 45% going to the featured recording artist(s), 5% to a fund for non-featured artists, and 50% to the sound recording copyright owner. See *About Digital Royalties*, SOUND EXCHANGE, <https://www.soundexchange.com/artist-copyright-owner/digital-royalties/> (last visited Oct. 23, 2018).

<sup>49</sup> The owners of sound recording copyrights grant synchronization licenses required for use in such works. *Resources & Learning: Licensing*, RECORDING INDUSTRY ASSOCIATION OF AMERICA, <https://www.riaa.com/resources-learning/licensing/> (last visited Oct. 23, 2018). Because record labels are the owners of such sound recording copyrights, they possess the right to grant such licenses. See Cockrill, *supra* note 47. See also Salmon, *supra* note 47. See also *I'm Making a Short Film And Want to Add Music, But How am I Supposed to Contact Famous Artists to Get Permission?*, COPYRIGHT ALLIANCE, [https://copyrightalliance.org/ca\\_faq\\_post/im-making-short-film-want-add-music-supposed-contact-famous-artists-get-permission/](https://copyrightalliance.org/ca_faq_post/im-making-short-film-want-add-music-supposed-contact-famous-artists-get-permission/) (last visited Oct. 23, 2018).

works and sound recordings. Accordingly, this section provides a summary of the interplay between music copyright licensing for pertinent third-party use.

Playing a song or performing a song live at political campaign rallies in public forums requires a public performance license for the use of the underlying composition, generally obtainable from the composition copyright owner's PRS.<sup>50</sup> No license from the sound recording copyright owner is required to play the song, because there is no non-digital transmission public performance right included in the sound recording copyright bundle; live performance of the song does not implicate the sound recording copyright at all.

Playing a song or performing a song live during a live television or radio broadcast requires a public performance license for the use of the underlying composition; no license from the sound recording copyright owner is required for the reasons stated directly above.<sup>51</sup>

Playing a song or performing a song live during a non-interactive internet broadcast requires a public performance license for the use of the underlying composition; no direct license from the sound recording copyright owner is required because the digital license for such use of the recording is compulsory.<sup>52</sup>

Using a song in a television commercial, television show, or motion picture film requires a mechanical license for reproduction and distribution of the underlying composition and a sync license for synchronization of the composition with the visual component of the commercial; if—and only if—a copyrighted sound recording is used, a master license for the use of the sound recording is also required.

---

<sup>50</sup> For example, the McCain-Palin campaign used the song "My Hero" in McCain's 2008 presidential run, and asserted PRS blanket licenses in response to objections from musician-songwriter Dave Grohl, who was an Obama supporter. Chao, *supra* note 10. Palin continued to use the song "Barracuda" as her theme song, despite the cease-and-desist letter from the composer-performers, asserting she had a blanket license. *Id.* See also *Resources & Learning: For Political Campaigns*, RECORDING INDUSTRY ASSOCIATION OF AMERICA, <https://www.riaa.com/resources-learning/for-political-campaigns/> (last visited Oct. 23, 2018).

<sup>51</sup> Joy Butler, *Music Licensing: The Difference Between Public Performance and Synchronization Licenses*, COPYRIGHT CLEARANCE CENTER (May 16, 2017), <http://www.copyright.com/blog/music-licensing-public-performance-license-synchronization/>. See also Cockrill, *supra* note 47.

<sup>52</sup> Cockrill, *supra* note 47, at 105.

Using a sound recording in another sound recording, such as for sampling or a recorded mash-up, requires a mechanical license from the composer for reproduction and distribution of the underlying composition, and a master license from the sound recording copyright owner, for copying and distribution of the master and use to create a derivative work.<sup>53</sup>

## II. THE NATURE OF LEGAL PROTECTIONS FOR CREATIVE WORKS

The objective of this Part is to provide a foundational framework for discussion and argument regarding the gap in protection of music vocalists' rights from a personhood perspective on the justification for copyright law, as well as for the justification for inalienability of a right aimed at filling that gap, subject only to contemporaneous license. The focus here is on the concepts and terminology of the philosophical justifications for copyright law. Intentionally omitted—as beyond the scope of this Article—is examination of whether a particular ideology is attributable to or can be extrapolated from Kantian or Hegelian ideology regarding tangible property rights or authorial rights in literary works and artworks.<sup>54</sup>

---

<sup>53</sup> *Id.*

<sup>54</sup> Numerous scholars assert that, as they relate to personhood justifications for intellectual property, monist copyright theory in the civil law context is derived from the works of Immanuel Kant, while the dualist theory in the civil law context is derived from the works of Georg Hegel. *See, e.g.,* Troutt, *supra* note 1, at 389 (Hegelian theory acknowledges “the unique character of creation that goes beyond the establishment of exclusive rights incident to the mere execution of labor”); Robert Rosenthal Kwall, *Inspiration and Innovation: The Intrinsic Dimension of the Artistic Soul*, 81 NOTRE DAME L. REV. 1945, 1977 (2006); Bird & Ponte, *supra* note 21, at 213–14, 218 (philosophies of Hegel support the notion that property rights that “promote self-expression and human development” are superior rights of “paramount importance”); Neil Netanel, *Alienability Restrictions and the Enhancement of Author Autonomy in United States and Continental Copyright Law*, 12 CARDOZO ARTS & ENT. L.J. 1, 20–21 (1992); Lacey, *supra* note 5, at 1541–42 (“Intellectual property theorists following Hegel’s and Kant’s thoughts on the subject, contend that the personhood theory of property is especially true when the property is a work of art.”). Others criticize the conventional wisdom regarding the Kantian and Hegelian philosophical bases for the relationship between personhood theory and copyright. *See* Christopher S. Yoo, *Copyright and Personhood Revisited*, FACULTY SCHOLARSHIP AT PENN LAW, PAPER 423 (Sept. 18, 2012), [http://scholarship.law.upenn.edu/faculty\\_scholarship/423](http://scholarship.law.upenn.edu/faculty_scholarship/423); Kim Treiger-Bar-Am, *Kant on Copyright: Rights of Transformative Authorship*, 25 CARDOZO ARTS & ENT. L.J. 1059, 1071–74 (2008) (arguing that conventional reliance on Kantian theory to support the concept of authors’ property-based personality rights is misplaced).



A. *Philosophical Justifications: Natural Rights, Utilitarianism, and Personhood*

“Two main functions of any property theory are the general justification of property rights and their delineation.”<sup>55</sup> The discourse on justifications for intellectual property centers on three theories that serve as the dominant philosophical underpinnings for tangible property rights: labor-desert or natural rights theory, utilitarian theory, and personhood theory.<sup>56</sup> Each is discussed in turn.

1. Natural Rights/Desert Theory

Natural rights or desert theory derives from John Locke's basic premise regarding tangible property that one ought to reap the fruits of his labor and “whenever one mingles his effort with the raw stuff of the world, any resulting product ought—simply ought—to be his.”<sup>57</sup> With respect to intellectual property, the natural rights theory provides that “a man's right to the produce of his brain is equally valid with his right to the produce of his hands.”<sup>58</sup> Discussing copyright law in his treatise, Blackstone extended Lockean theory beyond mere possession justification into the realm of control:

When a man, by the exertion of his rational powers has produced an original work, he seems to clearly have a right to dispose of that identical work as he pleases, and any attempt to vary the disposition he has made of it, appears to be an invasion of that right [of property].<sup>59</sup>

---

<sup>55</sup> Margaret Jane Radin, *Property and Personhood*, 34 STAN. L. REV. 957, 958 (1982).

<sup>56</sup> See *id.* at 958 (identifying Lockean labor-desert theory and utilitarian theory as “the most prevalent traditional lines of liberal property theory,” and discussing personhood theory as a third strand); see also Troutt, *supra* note 1, at 381–89 (discussing utility and personality as the theoretical framework for property rights in music).

<sup>57</sup> Lacey, *supra* note 5, at 1539 (citing J. Locke, *Second Treatise of Government*, in *TWO TREATISES OF GOVERNMENT* ch. 5 §§ 27–30. (P. Laslett ed. 1960) and Frank I. Michelman, *Property, Utility and Fairness: Comments on the Ethical Foundations of “Just Compensation” Law*, 80 HARV. L. REV. 1165, 1204 (1967)).

<sup>58</sup> *Id.* (citing H. SPENSER, *SOCIAL STATICS* 68 (rev. ed. 1896)).

<sup>59</sup> *Id.* at 1539–40 (citing 2 W. BLACKSTONE, *COMMENTARIES ON THE LAWS OF ENGLAND* 405).

## 2. Utilitarianism

Utilitarian theory focuses on maximization of social welfare.<sup>60</sup> As stated in Part I, U.S. copyright law and patent law is primarily focused on maximizing public access to intellectual property and spawning additional works for social benefit; exclusive rights to be exploited for economic benefits to the copyright owner are the means of achieving that primary objective.<sup>61</sup> The emphasis on social utility is evident in the constitutionally sanctioned power of Congress to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their respective Writings . . . .”<sup>62</sup> It is further evidenced in the copyright context by the statutory fair use doctrine and the long list of other exceptions to a United States copyright owner’s exclusive rights to exploit his or her works.<sup>63</sup> The inclusion of economic rewards to the copyright owner is secondary, as evidenced by various Supreme Court opinions.<sup>64</sup> Thus, U.S. copyright law is based primarily upon utilitarianism, and secondarily upon labor-desert or natural rights theory.

## 3. Personhood or Personality Theory

Personhood theory “focuses on personal embodiment or self-constitution in terms of ‘things.’”<sup>65</sup> In her article exploring the relationship between property and personhood, and “how the personhood perspective can help decide specific disputes between rival claimants,” Professor Margaret Jane Radin explained: “Once we admit that a person can be bound up with an external

---

<sup>60</sup> See Radin, *supra* note 55, at 958.

<sup>61</sup> See also Peter S. Menell & Suzanne Scotchmer, *Intellectual Property*, in 2 HANDBOOK OF LAW AND ECONOMICS, ch. 19 at 1482. (A. Mitchell Polinmsky & Steven Shavell eds., 2007).

<sup>62</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>63</sup> See 17 U.S.C. §§ 107–122 (2012). All exclusive rights for any copyrighted work are subject to the “fair use” limitation set forth in § 107 of the Act. Copyright fair use essentially exempts certain unauthorized uses from copyright infringement liability. Applicability of the defense is determined by consideration of the purpose and character of the use, the nature of the copyrighted work, the amount and substantiality of the work used, and the impact of the use on the potential market or value of the work.

<sup>64</sup> See Netanel, *supra* note 54, at 9–10.

<sup>65</sup> Radin, *supra* note 55, at 958.

'thing' in some constitutive sense, we can argue that by virtue of this connection the person should be accorded broad liberty with respect to control over that 'thing.'<sup>66</sup>

Personhood or personality theory as a justification for intellectual property, then, is based on the premise that property which is an extension or embodiment of the individual's personality, particularly with respect to artistic creations, gives rise to a greater entitlement or a stronger moral claim than other property.<sup>67</sup> Supremacy of the artist's personhood is deemed essential to incentivizing intellectual creativity, as well as to justifying artist control, and economic incentives are subordinated.<sup>68</sup> Although one noted problem with the personality justification is that there are some forms of intellectual property which simply do not appear to manifest the personality of their creators, musical performance, and particularly vocal performance, does not present that problem.<sup>69</sup>

As referenced, *supra*, the Ninth Circuit—having responsibility for one of the two heaviest dockets of music-related cases of all federal appellate courts in the nation—explicitly acknowledged that a “human voice is one of the most palpable ways identity is manifested,” and on that basis a “singer manifests herself in the song.”<sup>70</sup> Accordingly, personhood theory supports protection of vocalists' personality interests arguably more so than any other author, particularly given the instant recognition and association of the vocalist's voice with the vocalist's person.

---

<sup>66</sup> *Id.* at 958, 960. Radin then developed an intuitive “personhood perspective” to create objective criteria that could differentiate good identification with objects, which is worthy of recognition, from bad identification or fetishism, which is not. *Id.* at 968–69.

<sup>67</sup> See, e.g., Corinna Coors, *Morality, Utility, Reality? Justifying Celebrity Rights in the 21st Century*, 44 SYRACUSE J. INT'L. L. & COM. 215, 227 (2017) (discussing personality theory as justification for right of publicity).

<sup>68</sup> See *id.*

<sup>69</sup> Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 340 (1988) (discussing right of publicity and identifying musical works, along with poems, stories, novels, sculpture, paintings, and prints as being among those works that are “clearly receptacles for personality,” and identifying works that do not appear to manifest personality).

<sup>70</sup> *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988).

### B. *Moral Rights Defined*

Moral rights are rights in creative works that belong exclusively to the natural person who authors the work; they are not available to corporate entities, and they are generally inalienable.<sup>71</sup> The moral rights doctrine, as originally developed in France, includes four core moral rights. The right of disclosure gives a creative work author the sole right to determine whether, when, and how the work will be made available for public viewing.<sup>72</sup> The corollary right of withdrawal conditionally allows the artist to withdraw the work from public display and dissemination. The right of attribution, or right of paternity, assures that only the author will be identified as the creator. And the right of integrity empowers the artist to prohibit mutilation, material alteration, distortion, and destruction of the work, as well as to prohibit use or display of the work in a context or manner that is derogatory or otherwise harmful to the author's honor and reputation, or contrary to the author's intentions.<sup>73</sup>

Together these moral rights, which are generally inalienable, provide the author of a creative work with a means to control third party use and exploitation of a work, from creation to post-release of the work for public consumption, throughout the duration of the work's existence, or, at least, for the author's lifetime.<sup>74</sup> They also provide a means of maintaining and controlling the author's personal connection to the work, thereby limiting the degree of alienation after physical embodiments of the work are transferred to another, and even after certain intangible rights in the work are transferred to another.<sup>75</sup>

### C. *Civil Law Nations vs. Common Law Nations and Monist vs. Dualist Perspectives*

Nations are said to differ in the nature and scope of legal protections for creative works, depending, generally, upon whether they are a civil law nation or a common law nation. The

---

<sup>71</sup> See Petrik, *supra* note 19, at 366–67, 367 n.32.

<sup>72</sup> See *id.* at 363.

<sup>73</sup> See, e.g., Bird & Ponte, *supra* note 21, at 220–21; Cyrill P. Rigamonti, *Deconstructing Moral Rights*, 47 HARV. INT'L L.J. 353, 362–64 (2006) (discussing the four rights in the context of Continental Europe); Lacey, *supra* note 5, at 1549 (discussing the four rights recognized under French doctrine).

<sup>74</sup> See Rigamonti, *supra* note 73, at 355–56.

<sup>75</sup> See Petrik, *supra* note 19, at 367.

United States is known to adhere to the common law system of copyright protection derived from the common law and copyright statutes of the United Kingdom, while Continental Europe adheres to a civil law system, which evolved primarily in France and Germany.<sup>76</sup> The systems diverge primarily with respect to their view on the purpose of and philosophical basis for copyright law, which then leads to divergent views on protection of personhood interests and the related handling of moral rights aimed at protecting those interests.<sup>77</sup>

Defining “the adoption of civil-law-style moral rights legislation” as a “major shift in terms of copyright theory,” Professor Cyrill Rigamonti explained the distinction between civil law nations and common law nations as follows:

[I]t had been a canon of comparative copyright scholarship that the most significant difference between Anglo-American and Continental European copyright law was their respective attitudes toward moral rights. The inclusion of moral rights in statutory copyright law was generally understood to be the defining feature of the Continental copyright tradition, while the lack of statutory moral rights protection was considered to be a crucial component of the Anglo-American copyright tradition. This dichotomy had been celebrated and cultivated since World War II on both sides of the Atlantic to the point where the statutory protection of moral rights or the lack thereof had become an integral part of each legal system's identity, essentially dividing the world of copyright into two fundamentally different ideal types, one that includes moral rights, and another that excludes moral rights. The common law courts were fully aware of this dichotomy, and while they recognized the existence of the concept of moral rights in civil law countries, they uniformly rejected its applicability in their own jurisdictions.<sup>78</sup>

---

<sup>76</sup> See, e.g., Michael B. Gunlicks, *A Balance of Interests: The Concordance of Copyright Law and Moral Rights in the Worldwide Economy*, 11 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 601, 602 (2001).

<sup>77</sup> See Jane C. Ginsburg, *A Tale of Two Copyrights: Literary Property in Revolutionary France and America*, 64 TUL. L. REV. 991, *passim* (1990) (demonstrating that prior to the French revolution, copyright law in France and the United States was quite similar, and attributing the divergence in the regimes to “development of personalist doctrines, such as moral rights, by French copyright scholars and courts”).

<sup>78</sup> Rigamonti, *supra* note 73, at 354 (footnotes omitted).

Other scholars have distinguished the nations' approaches—categorizing them as monist or dualistic—based upon the treatment of moral or personality rights and economic rights in creative works, rather than based upon the total absence of moral rights.<sup>79</sup>

The dualistic perspective, typically associated with civil law nations, considers as distinct elements for protection the property/economic rights and the moral/personal rights,<sup>80</sup> employing, at times, copyright law to the former and neighboring rights laws to the latter.<sup>81</sup> French copyright law based on author's rights or the *droit d'auteur*, for example, is said to reflect the civil law, dual nature approach. It specifies an “exclusive incorporeal property right” in an author's works, including “attributes of an intellectual and moral nature,” which are “perpetual, inalienable, and imprescriptible,” as well as “attributes of an economic nature,” which are limited in duration and assignable independent of the moral rights.<sup>82</sup> Scholar Neil Netanel cautions, however: “The dual character of French *droits d'auteur* should not be overemphasized . . . French commentators speak of the interdependence of the moral and economic rights, and indeed, of the predominance of the former over the latter.”<sup>83</sup>

The monist legal perspective, typically associated with common law nations, considers moral rights to be “rolled into the general protections afforded a creator's property or economic rights under copyright,” instead of recognizing moral rights separately.<sup>84</sup> For example, German copyright law follows the monist approach to *droit d'auteur*, pursuant to which “economic and moral rights are considered thoroughly intertwined so that both aspects of copyright cannot be dissociated from each other.”<sup>85</sup> Based upon that view, the German Copyright Act permits transfer of copyright ownership by testamentary disposition, but otherwise deems the copyright inalienable,

---

<sup>79</sup> See Bird & Ponte, *supra* note 21, at 213–14.

<sup>80</sup> See *id.*

<sup>81</sup> See Netanel, *supra* note 54, at 22–23 (citing HENRI DESBOIS, *LE DROIT D'AUTEUR EN FRANCE* 275 (3d ed. 1978)).

<sup>82</sup> *Id.*

<sup>83</sup> *Id.*

<sup>84</sup> Bird & Ponte, *supra* note 21, at 214.

<sup>85</sup> Reto M. Hilty & Alexander Peukert, “*Equitable Remuneration*” in *Copyright Law: The Amended German Copyright Act as a Trap for the Entertainment Industry in the U.S.?*, 22 *CARDOZO ARTS & ENT. L.J.* 401, 406–07 (2004).

subject to licensing of the economic rights only.<sup>86</sup> But these exploitation rights still remain secondary, so-called “daughter” rights, that are always bound to “mother” rights that stay with the author.<sup>87</sup> “All rights revert to the author upon termination of an exploitation contract.”<sup>88</sup>

The United States adheres to a pseudo monist legal perspective; “pseudo” because copyright protection in the United States emphasizes economic rights, but rather than being “rolled up” with the economic rights, moral rights are largely disregarded.<sup>89</sup>

### III. TREATY-RELATED U.S. LEGISLATIVE ACTIONS TOUCHING MORAL RIGHTS

The United States is a signatory to two major international agreements—the Berne Convention and the WIPO’s Performances and Phonograms Treaty (“WPPT”)—which require provision of the moral rights of integrity and attribution, in accord with Continental influences. Yet, the United States has continued its adherence to a copyright regime which ignores moral rights for most authors of copyrightable works. The WPPT specifically applies to music vocalists, among other performers.<sup>90</sup> Although the Berne Convention does not apply to music

---

<sup>86</sup> *Id.* at 407–08 (“[T]he author may grant an economic right to another to use the work in a particular manner. An exploitation right may be granted as a non-exclusive or exclusive right and may be limited in respect to time, place or purpose.”).

<sup>87</sup> *Id.*

<sup>88</sup> *Id.* at 408.

<sup>89</sup> *See, e.g.,* Gilliam v. Am. Broad. Cos., 538 F.2d 14, 24 (2d Cir. 1976) (“American copyright law, as presently written, does not recognize moral rights or provide a cause of action for their violation, since the law seeks to vindicate the economic, rather than the personal, rights of authors.”); Vargas v. Esquire, Inc., 164 F.2d 522, 526 (7th Cir. 1947) (where artist contracted with publisher to produce art work for use by publisher in its publication under terms of which artist completely divested himself of title and ownership of pictures as well as rights to their possession, control, and use, artist could not enjoin publisher from reproducing pictures produced by him without his name appearing thereon and without credit to him on ground that it violated his so-called “moral rights”).

<sup>90</sup> WIPO Performances and Phonograms Treaty, art. 2(a), Dec. 20, 1996, [http://www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=295477](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=295477) [hereinafter WPPT] (“[P]erformers’ are actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, interpret or otherwise perform literary or artistic works or expressions of folklore.”).

performers,<sup>91</sup> a discussion of its implementation in the United States is warranted due to the negative impact it has had on music performers, notwithstanding its inapplicability.

A. *Pertinent Effects of the Berne Convention Implementation Act of 1988*

The Berne Convention was established as an international agreement for the protection of the rights of authors in their literary and artistic works.<sup>92</sup> Article 6bis, first added by amendment in 1928 and later broadened by amendment in 1972,<sup>93</sup> mandates provision of a right of attribution and a right of integrity for the life of the artist, at a minimum, but leaves to each signatory the means of provision and enforcement.<sup>94</sup> Exploring comparative historical compliance, and clarifying the public international standard for compliance with Article 6bis, Professor Justin Hughes noted that “[r]espectable adherence to [Article 6bis] historically did not require express statutory provisions establishing the two moral rights.”<sup>95</sup> Moral rights were not codified in France, the country of their origin, until 1957, long after the 1928 amendment adding Article 6bis, and “most major common law countries—and several significant civil

---

<sup>91</sup> Berne Convention, *supra* note 20, at art. 2(1) (excluding any mention of music performance and sound recordings from the definition of the covered “literary and artistic works”).

<sup>92</sup> *See id.* at 4; Kwall, *supra* note 54, at 1954 n.38.

<sup>93</sup> Bella Karakis, *Moral Rights: French, United States and Soviet Compliance with Article 6bis of the Berne Convention*, 5 *TOURO INT’L L. REV.* 105, 109–10 (1994).

<sup>94</sup> Article 6bis provides as follows:

(1) Independently of the author’s economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.

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

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

Berne Convention, *supra* note 20, at 7.

<sup>95</sup> Hughes, *supra* note 21, at 706.



law countries—were members of the Berne Convention for decades before they passed moral rights statutes for the two Article 6bis rights.<sup>96</sup> These countries relied on their existing domestic laws, prior to finally codifying moral rights provisions.<sup>97</sup>

The United States became a signatory in 1988 and enacted the Berne Convention Implementation Act (the “BCIA”), effective March 1, 1989.<sup>98</sup> The near-century-long delay in the United States’ accession to the Berne Convention is partially attributed to “debate over the requirements of Article 6bis,” “whether [it] required the United States to enact new laws protecting moral rights,” and a concern of “[c]ertain proprietary groups” that even without new laws, “the very fact of adherence could work a gradual but substantial change in the American copyright system and the protections accorded authors.”<sup>99</sup>

Congress intentionally did not incorporate moral rights into the Copyright Act or provide an express grant by any other means after becoming a Berne signatory. In the course of enacting the BCIA, Congress acknowledged that no federal statute provided for moral rights and that “various decisions of state and federal courts [had] rejected claims that were denominated specifically as ‘moral rights’ or that sought relief under the ‘moral rights’ doctrine.”<sup>100</sup> Nonetheless, Congress concluded that protection of the moral rights mandated by Article 6bis was provided under then existing law, including “various provisions of the Copyright Act and Lanham Act, various state

---

<sup>96</sup> *Id.*

<sup>97</sup> Professor Hughes explained that the United Kingdom, a civil nation, had “concluded that moral rights as such were unknown in English jurisprudence and a matter best left to ‘contract between the parties concerned,’” before codifying “a small piece of a modern statutory moral-rights system” in its 1956 copyright law revision to narrowly address false attribution; and, it was not until 1988 that the United Kingdom passed legislation covering both Article 6bis rights, relying until then on “a composite of contract law and common law” torts such as “defamation, injurious falsehood, passing-off, and privacy violations.” *Id.* at 707. New Zealand adopted the U.K. moral rights statute in 1994, while Australia did not codify moral rights provisions until 2000. *Id.* at 708. Similarly, Switzerland relied on its Civil Code protections of “an individual’s right of personality, including honor, reputation, and privacy,” from 1887 to 1992, when it finally codified provisions recognizing Article 6bis rights. *Id.* at 708–09.

<sup>98</sup> Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853; H.R. REP. NO. 101-514 (1990), as reprinted in 1990 U.S.C.C.A.N. 6915, 6917 [hereinafter “BCIA”].

<sup>99</sup> H.R. REP. NO. 101-514 (1990), as reprinted in 1990 U.S.C.C.A.N. 6915, 6917 (legislative history for Visual Artists Rights Act of 1990 (“VARA”), background).

<sup>100</sup> S. Res. No. 100-352, at 9–10 (1988), as reprinted in 1988 U.S.C.C.A.N. 3706, 3714–15.

statutes, and common law principles such as libel, defamation, misrepresentation, and unfair competition, which have been applied by courts to redress authors' invocation of the right to claim authorship or the right to object to distortion."<sup>101</sup> As Professor Hughes points out, "[t]his patchwork protection was not an ingenious, last minute creation of Capitol Hill staff in 1988; it had a long conceptual and practical history," appearing in legal literature as early as 1940, and subsequently in a 1959 "detailed study on the issue . . . as part of the long review of [U.S.] copyright law that contributed to the 1976 Act."<sup>102</sup>

The BCIA cemented the intended omission of new moral rights law by expressly providing that: (i) the Berne Convention provisions are "not self-executing under the Constitution and laws of the United States," (ii) United States obligations thereunder "may be performed only pursuant to appropriate domestic law," and (iii) "no further rights or interests shall be recognized or created for that purpose."<sup>103</sup> The BCIA expressly negated any right to file a lawsuit to directly enforce the provisions of the Berne Convention and it expressly denied any change, whether under federal, state, or common law, to an author's right to claim authorship of a work or to "object to any distortion, mutilation, or other medication of, or other derogatory action in relation to the work, that would prejudice the author's honor or reputation."<sup>104</sup>

Although the United States was not alone in its reliance on non-copyright domestic laws to support its adherence to Article 6bis,<sup>105</sup> the BCIA did not simply leave United States authors on the same footing they were on prior to its enactment. Sections 1 and 2 of the BCIA confirmed the preeminence of domestic law, but also established rules of construction which effectively directed courts not to consider Article 6bis adherence obligations in the course of applying the domestic law relied upon to satisfy those obligations.

The BCIA provided for numerous significant amendments to the Copyright Act, which took effect in March 1989, although none extended the right of attribution or right of integrity to all

---

<sup>101</sup> *Id.*

<sup>102</sup> Hughes, *supra* note, 21, at 666 & nn.34–35.

<sup>103</sup> BCIA, *supra* note, 98, § 2.

<sup>104</sup> *Id.* § 3.

<sup>105</sup> Hughes, *supra* note 21, at 707–09.

authors, as is mandatory under the Berne Convention.<sup>106</sup> Two amendments are of specific import here. Section 104 of the Copyright Act, regarding “[s]ubject matter of copyright,” was amended to add subpart (c):

(c) EFFECT OF BERNE CONVENTION. — No right or interest in a work eligible for protection under this title may be claimed by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto. Any rights in a work eligible for protection under this title that derive from this title, other Federal or State statutes, or the common law, shall not be expanded or reduced by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto.<sup>107</sup>

Section 301 of the Act, regarding “[p]reemption with respect to other laws”<sup>108</sup> was amended to add subpart (e) as follows: “(e) The scope of Federal preemption under this section is not affected by the adherence of the United States to the Berne Convention or the satisfaction of obligations of the United States thereunder.”<sup>109</sup>

These two BCIA amendments to the Copyright Act, together with the subsequent enactment of VARA<sup>110</sup>, have worked to thwart numerous attempts by U.S. authors to use existing federal or state statutory law, as well as common law, to enforce the spirit of the rights of attribution and integrity the United States is obligated to provide under the Berne Convention. Consequently, as will be demonstrated *infra*, U.S. music authors were put in a worse position with respect to moral rights than they were in prior to the BCIA.

---

<sup>106</sup> BCIA, *supra* note 98.

<sup>107</sup> *Id.* § 4; *see also* 17 U.S.C. § 104(c) (2002).

<sup>108</sup> *See* 17 U.S.C. § 301(a) (1998) (“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 § 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 §§ 102 and 103, whether created before or after that date and whether published or unpublished, 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.”).

<sup>109</sup> BCIA, *supra* note 98, § 6 (“Preemption With Respect To Other Laws Not Affected”).

<sup>110</sup> VARA has been criticized as noncompliant with Article 6bis. *See, e.g.*, Hughes, *supra* note 21, at 671–74.

*B. WIPO's Performances and Phonograms Treaty*

The WPPT was adopted in 1996, to provide new “protection for performers of audio works and producers of phonograms (i.e., sound recordings).”<sup>111</sup> The United States, an original signatory, enacted the WIPO Copyright and Performers and Phonograms Treaty Implementation Act of 1997 (“WCPPTIA”), effective in full as of May 20, 2002.<sup>112</sup>

As mentioned above, the WPPT includes music vocalists in the definition of performers, while it defines a “producer of a phonogram” to mean the person or entity that “takes the initiative and has the responsibility for the first fixation of the sounds of a performance.”<sup>113</sup> Parallel to Article 6bis with respect to Berne Convention authors, WPPT Article 5(1) mandates provision of a right of attribution and a right of integrity for the life of the performer, at a minimum, but leaves to each signatory the means of provision and enforcement as follows:

(1) *Independently of a performer's economic rights, and even after the transfer of those rights, the performer shall, as regards his live aural performances or performances fixed in phonograms, have the right to claim to be identified as the performer of his performances, except where omission is dictated by the manner of the use of the performance, and to object to any distortion, mutilation or other modification of his performance which would be prejudicial to his reputation.*

(2) The rights granted to a performer in accordance with the paragraph (1) shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the [signatory] where protection is claimed. However, those [signatories] whose legislation, at the moment of their

---

<sup>111</sup> S. Exec. Doc. No. 105-25, WIPO Copyright Treaty (WCT) and WIPO Performances and Phonograms Treaty (WPPT), at 1–2 (Oct. 14, 1998) [hereinafter WCT & WPPT Exec. Rept.]. Notably, because the United States protects sound recordings under copyright law, it initially pushed for updated protections for sound recordings as part of the Berne Protocol process to update the Berne Convention; however, “[t]he European Union and many other countries strenuously resisted inclusion of sound recording protection because sound recordings are not copyright subject matter under their laws nor, they insisted, under the Berne Convention.” *Id.* at 2. “These countries were unwilling to change their theoretical basis for protecting sound recordings or agree to an optional interpretation that sound recordings are copyright subject matter under the Berne Convention.” *Id.* at 3.

<sup>112</sup> See WIPO Copyright and Performances and Phonograms Treaty Implementation Act of 1997, Pub. L. No. 105-1. S. 1121 (Jul. 3, 1997). WPPT, *supra* note 90, at 12.

<sup>113</sup> WPPT, *supra* note 90, at art. 2(d) (emphasis added).

ratification of or accession to this Treaty, does not provide for the protection after the death of the performer of all the rights set out in the preceding paragraph may provide that some of these rights may, after his death, cease to be maintained.

(3) The means of redress for safeguarding the rights granted by this Article shall be governed by the legislation of the [signatory] where protection is claimed.<sup>114</sup>

In addition to the mandated moral rights—which are not granted to producers irrespective of whether the producer is a person or an entity—the WPPT mandates that performers have the exclusive economic right of authorizing the fixation and public broadcast of their unfixed performances.<sup>115</sup> As a result of the Uruguay Round Agreements Act, U.S. performers have had these additional exclusive rights regarding unfixed performances since 1994 via § 1101 of the Copyright Act, which prohibits unauthorized fixation and trafficking in sound recordings and music videos subject to the same remedies provided for copyright infringement.<sup>116</sup>

Otherwise, the rights of performers and producers under the WPPT include: a common right to compensation for public performance of sound recordings, subject to limited or complete reservation,<sup>117</sup> and parallel exclusive rights of reproduction, distribution, commercial rental, and the making available by wire or wireless means for interactive, digital on-demand public access, with the distinction being that performers' exclusive rights are in their performances, while producers' exclusive rights are in their sound recordings.<sup>118</sup> The Committee on Foreign Relations explained:

These above-mentioned [parallel] rights may be exercised separately by the performers and producers. *Permission from both the performer and the producer must be obtained for a third-party to*

---

<sup>114</sup> *Id.* at art. 5 (“Moral Rights of Performers”).

<sup>115</sup> *Id.* at art. 6 (“Economic Rights of Performers in their Unfixed Performances”).

<sup>116</sup> 17 U.S.C. §§ 106, 1101 (2012); *see also* Uruguay Round Agreements Act adding chapter 11, entitled “Sound Recordings and Music Videos,” to title 17. Pub. L. No. 103-465, 108 Stat. 4809, 4974.

<sup>117</sup> WPPT, *supra* note 90, at art. 15 (“Right to Remuneration for Broadcasting and Communication to the Public”).

<sup>118</sup> *Compare id.* at art. 7–10, *with id.* at art. 11–14 (rights of reproduction, distribution, rental, and making available fixed performances (for performers) and sound recordings (for producers)).

*reproduce, distribute, rent, or make available a phonogram* (subject of course to any limitations on these rights legislated pursuant to Article 16),<sup>119</sup>

which makes all rights under the WPPT (including the moral rights) subject to fair use under § 107 of the Copyright Act, as well as all other limitations and restrictions provided for in §§ 108–122.<sup>120</sup>

All except the moral rights apply retroactively to any works that were not in the public domain as of the date of entry into force.<sup>121</sup> The expanded digital performance right added in 1998 by the DMCA appears to satisfy the common right to remuneration for public performance, subject to a reservation that the right only applies to digital performances. At first glance, it also appears to satisfy the parallel exclusive “making available . . .” rights, except that the digital performance right under § 106 belongs only to the owner of the sound recording copyright, and thus likely excludes the performer’s separate exclusive right from the very start, as a matter of music industry practice whereby that copyright is rather automatically transferred to the record label.<sup>122</sup> The same issue exists for the parallel exclusive rights of reproduction, distribution, and rental of the performer’s “performance[] fixed in phonogram” and the producer’s phonograms.<sup>123</sup> Even if performers were deemed joint authors of a sound recording and thus joint copyright owners along with the record label as the producer, only one author/owner’s permission would be required for a third party to reproduce or distribute the sound recording.<sup>124</sup> Thus, the intended co-existing mutually exclusive rights in the fixed

---

<sup>119</sup> WCT & WPPT Exec. Rept., *supra* note 111, at 9 (emphasis added).

<sup>120</sup> See 17 U.S.C. §§ 107–122 (providing various limitations on exclusive rights); see also WPPT, *supra* note 90, at art. 16.

<sup>121</sup> WPPT, *supra* note 90, at art. 22; Berne Convention, *supra* note 20, at art. 18; see also WCT & WPPT Exec. Rept., *supra* note 111, at 13–14.

<sup>122</sup> 17 U.S.C. § 106(6); see also John P. Strohm, *Writings in the Margin (Of Error): The Authorship of Sound Recordings under United States Copyright Law*, 34 CUMB. L. REV. 127, 130 (2003).

<sup>123</sup> *Summary of the WIPO Performances and Phonograms Treaty (WPPT) (1996)*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, [http://www.wipo.int/treaties/en/ip/wppt/summary\\_wppt.html](http://www.wipo.int/treaties/en/ip/wppt/summary_wppt.html) (last visited September 21, 2018 2:45 PM).

<sup>124</sup> 17 U.S.C. § 201(a); see also Benjamin E. Jaffe, *Rebutting the Equality Principle: Adapting the Co-Tenancy Law Model to Enhance the Remedies Available to Joint Copyright Owners*, 32 CARDOZO L. REV. 1549, 1555 (2011).

performance for the performer and in the sound recording for the producer are conflated with exclusive rights in the sound recording under U.S. copyright law.

Nothing was done to remedy the conflation. The substantive amendments to the Copyright Act contained in the WCT & WPPT Implementation Act focused almost entirely on what was necessary to implement the WIPO Copyright Treaty.<sup>125</sup> There were no amendments adding new rights for music performers. In particular, § 106 was not amended to reflect the exclusive rights of performers in their fixed performances, nor was § 102 amended to reflect statutory recognition of music performance as a copyrightable work, once fixed. Reminiscent of the legislature's stance regarding Article 6bis of the Berne Convention, the stated presumption of the Committee on Foreign Relations regarding WPPT was that:

The United States presumably will continue to rely upon copyright law as the primary vehicle for sound recording protection, supplemented by criminal penalties for knowing infringements for purposes of commercial gain. In addition to federal law, the United States may rely in part on state statutory and common law to satisfy some treaty obligations.<sup>126</sup>

Consequently, there exists a gap in the WPPT protections the United States is obligated to provide with respect to the moral rights of attribution and integrity for music performers, as well as the exclusive rights of reproduction and distribution for music performers in their fixed performances.

#### IV. THE INCREASING INEFFICACY OF ALTERNATIVE LEGAL THEORIES IN LIEU OF MORAL RIGHTS

Upon considering claims sounding in moral rights, courts have consistently held that there is no recognition of moral rights within the United States, even in instances where the court went on to grant some relief.<sup>127</sup> Courts have also consistently rejected

---

<sup>125</sup> See WCT & WPPT Implementation Act, ch. 12, Public Law 105-304, 112 Stat. 2860 (1998) (amending the Copyright Act by adding § 1201 (circumvention of copyright protection systems), § 1202 (integrity of copyright management information), § 1203 (civil remedies), and § 1204 (criminal offenses and penalties)).

<sup>126</sup> WCT & WPPT Exec. Rept., *supra* note 111, at 8.

<sup>127</sup> See, e.g., *Rey v. Lafferty*, 990 F.2d 1379, 1392 n.10 (1st Cir. 1993) (“[U]nder copyright law, while a licensor has no ‘moral right’ to control the quality of licensed depictions she may insist, contractually, on approval provisions to ‘assure quality control and high standards in the exploitation’ of her creative work.”) (internal citations omitted); *Gilliam v. ABC*, 538 F.2d 14, 23–24 (2d Cir. 1976) (granting relief

claimed trademark rights in “signature songs” as a basis for trademark infringement claims brought against third parties using the songs without the music vocalist’s permission.<sup>128</sup> Otherwise, in the realm of redress sought for harms to personhood there has been little consistency from case to case.

Whether an author has obtained relief under an alternative theory has depended upon the luck of the draw regarding who, what, where, when, and how. Who were the parties? What theory could be made to fit the harm? Where was the venue or court of jurisdiction? When was the claim brought, pre- or post-BCIA? How bad was the alleged wrongful conduct?

As the Second Circuit has made plain: “American courts have in varying degrees acknowledged the idea of moral rights, cloaking the concept in the guise of other legal theories, such as copyright, unfair competition, invasion of privacy, defamation, and breach of contract.”<sup>129</sup> In her 1985 article exploring the interplay between the then-recently enacted 1976 Act and the moral rights doctrine, Professor Roberta Kwall observed that:

The overwhelming number of commentators who have studied this question have concluded that the scope of protection in America for the personal rights of creators is insufficient. The criticism is not surprising given that patchwork measures rarely approximate the degree of protection afforded by a cohesive legal theory whose exclusive objective is the specific protection of precise interests.

Although the substitute theories [mainly “unfair competition, breach of contract, defamation, and invasion of privacy”] afford creators varying levels of protection for their moral rights, American creators typically are at a relative disadvantage compared to creators in moral right countries. The major difficulty facing American creators is the additional burden of molding moral rights claims into other recognized causes of action. *Given that all of the substitute theories are supported by a theoretical basis different from that of the moral right doctrine, a successful claim may require elements of proof which are not applicable directly to a moral rights claim. The moral right doctrine is concerned with the creator’s personality rights and society’s interest in preserving the integrity of its culture. These*

---

via contract law, copyright law, and unfair competition law); *Franconero v. Universal Music Corp.*, No. 02 Civ.1963(RO), 2003 WL 22990060 at \*1–2 (S.D.N.Y. Dec. 19, 2003) (denying relief).

<sup>128</sup> See *infra* Part IV.b.3.

<sup>129</sup> *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 82 (2d Cir. 1995).



*interests are not the exclusive, or even the primary, focus of any of the substitute theories, all of which developed in response to completely different social concerns.*<sup>130</sup>

Still, the odds for a favorable outcome were better prior to the BCIA.

#### A. *Unfair Competition*

Use of a music composition in a radio or television commercial requires license from the music composition copyright owner, and use of the performance master as well requires an additional license from the sound recording copyright owner. If the music vocalist owns neither copyright—which is more often the case than not—then copyright law does not require the vocalist's permission at all. For playing of a sound recording in a public arena, like at a political campaign rally, permission is not required from even a vocalist with ownership of the sound recording copyright, because sound recordings have no public performance rights as part of their copyright bundle, aside from the digital right.<sup>131</sup>

Consequently, for decades music vocalists have turned to unfair competition, seeking relief from unwanted associations with politicians and commercial products and services and other objectionable uses of their songs. The degree of success in asserting unfair competition claims has depended, primarily, on whether the claim was one for false designation or trademark infringement or false endorsement, the timing of the claim, and whether the claim was based on use of the vocalist's actual recorded performance.

##### 1. False Designation of Origin in Lieu of the Rights of Attribution and Integrity

Pre-BCIA, the outcomes were particularly favorable for claims that could be aligned with the theory of false designation of origin under § 43(a) of the Lanham Act.<sup>132</sup> Post-BCIA, such

---

<sup>130</sup> Kwall, *Copyright and the Moral Right*, *supra* note 21, at 17–18, 23–24 (footnotes omitted) (emphasis added).

<sup>131</sup> See Patrick Koncel, *Did Copyright Kill the Radio Star? Why the Recorded Music Industry and Copyright Act Should Welcome Webcasters into the Fold*, 14 J. MARSHALL REV. INTELL. PROP. L. 292, 297–302 (2015); *see also* 17 U.S.C. § 106(6) (2012); *id.* § 114(a).

<sup>132</sup> See 15 U.S.C. § 1125(a) (2012) (creating liability for “[a]ny person who . . . uses in commerce . . . any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely

claims have failed as a substitute for the moral rights required under both the Berne Convention and the WPPT, for reasons attributable to copyright preemption.<sup>133</sup>

*a. Pre-BCIA Reliability*

Two successful false designation cases out of the Ninth Circuit, *Smith v. Montoro*<sup>134</sup> in 1981 and *Lamothe v. Atlantic Recording Corp.*<sup>135</sup> in 1988, concerned the right of attribution for an actor on motion picture credits and for two of three joint authors on music compositions, respectively. The Ninth Circuit held that relief for misattribution was available under the false designation theory of “reverse passing off,” if the rightful name was replaced with another or if some, but not all, of the rightful names were omitted.<sup>136</sup>

An earlier successful case out of the Second Circuit in 1976, *Gilliam v. American Broadcasting Company, Inc.*,<sup>137</sup> concerned the right of integrity; the plaintiffs prevailed on a combination of copyright infringement and contract theory, as well as on a theory of mutilation of an original work in violation of Lanham Act § 43(a).<sup>138</sup> The British group of writers and performers known as Monty Python won an injunction to stop television network ABC from broadcasting edited versions of three originally ninety-minute television episodes from which a total of twenty-four minutes had been excised to accommodate commercial breaks and omit material deemed too offensive or obscene.<sup>139</sup> As to the claim seeking redress for “actionable mutilation” and “deformation of an artist’s work,” for example, the claim sounding in right of integrity violation, the court found

---

to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . .”).

<sup>133</sup> *Accord Rigamonti, supra* note 73, at 355 (arguing in 2006, that “if the goal was to increase the overall protection of authors, it was a step in the wrong direction for the common law countries to adopt the civil law concept of moral rights, because the statutory moral rights regimes that were enacted in the United States and the United Kingdom have likely reduced rather than increased the aggregate level of authorial protection”).

<sup>134</sup> 648 F.2d 602, 604 (9th Cir. 1981).

<sup>135</sup> 847 F.2d 1403, 1405 (9th Cir. 1988). In *Lamothe*, the court also held that the licensee defendants were liable for the incomplete designations. *Id.* at 1408.

<sup>136</sup> *Id.* at 1406–08; *Smith*, 648 F.2d at 607.

<sup>137</sup> 538 F.2d 14, 25 (2d Cir. 1976).

<sup>138</sup> *Id.* at 23–25.

<sup>139</sup> *Id.* at 18, 26.

a violation of the Lanham Act prohibition against false designation, holding that ABC's broadcast of the edited versions "impaired the integrity of the . . . work and represented to the public as the product of [the plaintiffs'] what was actually a mere caricature of their talents."<sup>140</sup> In so holding, the Second Circuit explained its rationale as follows:

American copyright law, as presently written, does not recognize moral rights or provide a cause of action for their violation, since the law seeks to vindicate the economic, rather than the personal, rights of authors. *Nevertheless, the economic incentive for artistic and intellectual creation that serves as the foundation for American copyright law, [citations-1], cannot be reconciled with the inability of artists to obtain relief for mutilation or misrepresentation of their work to the public on which the artists are financially dependent.* Thus courts have long granted relief for misrepresentation of an artist's work by relying on theories outside the statutory law of copyright, such as contract law, [citations-2], or the tort of unfair competition [citations-3]. Although such decisions are clothed in terms of proprietary right in one's creation, they also properly vindicate the author's personal right to prevent the presentation of his work to the public in a distorted form. [citations-4]<sup>141</sup>

Pre-BCIA, all three of the above-referenced false designation cases under Lanham Act § 43(a) were oft-cited decisions and reliable precedent for similar sounding claims. But the hope that some would-be moral rights claims had found in the federal statutory prohibition against false designation of origin was obliterated, after a case involving the alleged reverse passing off of a documentary films series—*Dastar Corp. v. Twentieth Century Fox Film Corp.*<sup>142</sup>—reached the Supreme Court.

---

<sup>140</sup> *Id.* at 24–25.

<sup>141</sup> *Id.* at 24 (emphasis added). Omitted citations are, respectively: (1) Goldstein v. California, 412 U.S. 546, 93 S.Ct. 2303, 37 L.Ed.2d 163 (1973); Mazer v. Stein, 347 U.S. 201, 74 S.Ct. 460, 98 L.Ed. 630 (1954); (2) Granz v. Harris, 198 F.2d 585 (2d Cir. 1952) (substantial cutting of original work constitutes misrepresentation); (3) Prouty v. National Broadcasting Co., 26 F. Supp. 265 (D. Mass.1939), and Strauss, *The Moral Right of the Author* 128-138, in STUDIES ON COPYRIGHT (1963); and (4) Gardella v. Log Cabin Products Co., 89 F.2d 891, 895-96 (2d Cir. 1937); Roeder, *The Doctrine of Moral Right*, 53 Harv. L. Rev. 554, 568 (1940). *But see Gilliam*, 538 F.2d at 27 (Gurfein, J., concurring) ("So far as the Lanham Act is concerned, it is not a substitute for droit moral which authors in Europe enjoy. If the licensee may, by contract, distort the recorded work, the Lanham Act does not come into play. If the licensee has no such right by contract, there will be a violation in breach of contract.").

<sup>142</sup> 539 U.S. 23, 27 (2003).

b. *Post-BCIA Claim Failures in the Wake of Dastar*

Notably, *Dastar* was not a case seeking redress for a would-be moral rights violation. Because the copyright for the film series had lapsed thereby casting the series into the public domain, Fox sought relief on a Lanham Act passing off claim instead of asserting copyright infringement, when *Dastar* slightly modified the series, repackaged it, and then sold it under a different name without attribution to Fox's original series.<sup>143</sup>

The *Dastar* Court unanimously reversed the Ninth Circuit's affirmation of summary judgment in favor of the plaintiffs and held that the term "origin of goods" in § 43(a) of the Lanham Act "refers to the producer of the tangible goods that are offered for sale, and not to the author of any idea, concept, or communication embodied in these goods."<sup>144</sup> The Court's rationale was that interpreting § 43(a) otherwise created a conflict with copyright law, which allows copying of works in the public domain freely and without attribution.<sup>145</sup> That rationale was certainly consistent with the Supreme Court's prior firm stance against allowing the "misuse or over-extension" of Lanham Act claims to circumvent limitations on the scope and duration of monopolies afforded under copyright and patent law.<sup>146</sup> In other words, the *Dastar* Court was concerned with conflict preemption.

The *Dastar* opinion cited *Smith v. Montoro*, among other federal circuit cases, for the proposition that "every Circuit to consider the issue found § 43(a) broad enough to encompass reverse passing off,"<sup>147</sup> without expressly overruling *Smith v. Montoro* or *Lamothe*, and their progeny. It made no mention of *Gilliam's* application of Lanham Act § 43 to provide relief for the

---

<sup>143</sup> *Id.* at 26–27.

<sup>144</sup> *Id.* at 37.

<sup>145</sup> *Id.*

<sup>146</sup> The *Dastar* Court reasoned: "Assuming for the sake of argument that *Dastar's* representation of itself as the 'Producer' of its videos amounted to a representation that it originated the creative work conveyed by the videos, allowing a cause of action under § 43(a) for that representation would create a species of mutant copyright law that limits the public's 'federal right to 'copy and to use'' expired copyrights." *Id.* at 34 (quoting *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 165 (1989)); see also *id.* at 34, 36–37 (citing *TraFFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001); *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 163–64 (1995); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 121–22 (1938); *In re Trade-Mark Cases*, 100 U.S. 82, 94 (1879)).

<sup>147</sup> *Dastar*, 539 U.S. at 30.

would-be right of integrity violation under reverse passing off false designation of origin. Yet, *Dastar's* holding that “the phrase ‘origin of goods’ is . . . incapable of connoting the person or entity that originated the ideas or communications that ‘goods’ embody or contain”<sup>148</sup> effectively eliminated the claim as a basis for relief concerning creative expressions and copyrighted works. Most unfortunately, its application has not been limited to cases involving works in the public domain.<sup>149</sup> Instead, courts have relied upon *Dastar* to deny false designation/right of attribution claims brought by various plaintiffs, in and outside of the music industry.<sup>150</sup>

Consistent with the express instruction in § 2 and § 4 of the BCIA, the *Dastar* Court made no mention of Article 6bis and gave no apparent consideration to the need to preserve Lanham Act claims as an available domestic law path to enforcement of the right of attribution.<sup>151</sup> But the *Dastar* Court had indeed considered and interpreted Congress’ intentional omission of moral rights for all but the subset of authors identified in VARA:

When Congress has wished to create such an addition to the law of copyright, it has done so with much more specificity than the Lanham Act’s ambiguous use of “origin.” The Visual Artists Rights Act of 1990, [ ] provides that the author of an artistic work “shall have the right . . . to claim authorship of that work.” 17 U.S.C. § 106A(a)(1)(A). That express right of attribution is carefully limited and focused: It attaches only to specified “work[s] of visual art,” § 101, is personal to the artist, §§ 106A(b) and (e), and endures only for “the life of the author,” § 106A(d)(1). Recognizing in § 43(a) a cause of action for

---

<sup>148</sup> *Id.* at 32.

<sup>149</sup> Indeed, most of the cases citing *Dastar* involve Lanham Act claims in connection with third party uses of works that are still copyright protected. *See, e.g.*, Tom W. Bell, *Misunderestimating Dastar: How the Supreme Court Unwittingly Revolutionized Copyright Preemption*, 65 MD. L. REV. 206, 214–15 (2006) (discussing how lower courts have applied *Dastar*).

<sup>150</sup> *See, e.g.*, *Zyla v. Wadsworth*, Div. of Thomson Corp., 360 F.3d 243, 252 (1st Cir. 2004) (applying *Dastar* to support preemption of Lanham Act claim regarding credit for a copyrighted textbook); *Borrego v. BMG U.S. Latin*, 92 F. App’x 572, 572 (9th Cir. 2004) (affirming summary judgment dismissing music composition author’s claim rising from mistaken attribution to another songwriter and holding that under *Dastar*, “Borrego no longer has a claim for ‘reverse passing off’”); *Santa Rosa v. Combo Records*, 376 F. Supp. 2d 148, 151–52 (D. P.R. 2005) (citing *Dastar* to dismiss false designation of origin claim based upon record company’s omission of salsa singer’s name from joint recordings); *Williams v. UMG Recordings, Inc.*, 281 F. Supp. 2d 1177, 1185 (C.D. Cal. 2003); *Carroll v. Kahn*, 68 U.S.P.Q.2d 1357, 1361–62 (N.D.N.Y. 2003).

<sup>151</sup> *See, e.g., Dastar*, 539 U.S. at 23.

misrepresentation of authorship of noncopyrighted works (visual or otherwise) would render these limitations superfluous. A statutory interpretation that renders another statute superfluous is of course to be avoided.<sup>152</sup>

Thus, *Dastar* is read to support preemption of the Lanham Act § 43(a) claim as a means of vindicating moral rights. Though widely criticized for reaching beyond the scope of the issues presented in the case itself,<sup>153</sup> *Dastar* remains the law of the land.

Examining the legislative histories of the BCIA, VARA, and the Trademark Law Revision Act of 1988 (“TLRA”), Professor Mary LaFrance criticized *Dastar* two years after the opinion, rightly concluding that its narrow construction of § 43(a) is contrary to Congress’ express approval of *Gilliam* and *Smith v. Montoro*, as is reflected in the legislative history of the BCIA, without contradiction in that of the TLRA:

The near-simultaneous consideration and enactment of these statutes makes the BCIA’s legislative history particularly helpful in interpreting the TLRA. Unfortunately, the *Dastar* opinion overlooks evidence in the BCIA’s history which strongly suggests that the 100th Congress not only acquiesced in the application of section 43(a) to false attributions of works of authorship, but expressly endorsed that application as an important component of the network of state and federal laws upon which Congress relied in concluding that the United States could comply with the moral rights provisions of the Berne Convention without enacting any new moral rights legislation. In contrast to the legislative history of the TLRA, which is highly ambiguous in its treatment of reverse passing off claims in general, the legislative history of the BCIA strongly suggests that the 1988 Congress approved of applying section 43(a) to reverse passing off of literary and artistic works.

The Final Report of Ad Hoc Working Group on U.S. Adherence to the Berne Convention, issued in 1986, cited the then-current version of section 43(a) as a proxy for the moral rights of attribution and integrity. With respect to attribution, the Report unequivocally states that section 43(a) (as in effect at that time) “prohibits false designations of origins of works, including intellectual and artistic works, and prohibits false

---

<sup>152</sup> *Id.* at 34–35 (citations omitted).

<sup>153</sup> See, e.g., Hughes, *supra* note 21, at 696–703 (proposing “a number of options . . . that could have avoided the uncertainties embedded in the opinion”); Bell, *supra* note 149, at 224 & n.114 (citing law review articles with critical commentary on *Dastar*); Rigamonti, *supra* note 73, at 409–10.

descriptions and representations of such works.” Citing *Smith v. Montoro* and work of the late Professor Melville Nimmer, the Report notes “that omission of an author’s name from his work may constitute ‘an implied reverse passing off’ and thus violate section 43(a).” When publication without attribution misleads the public into thinking that the publisher or producer of a work, rather than its author, was the originator of the work, the Report states, “[t]his is a false designation of origin under section 43(a).” With respect to reverse passing off, the Report notes, in a section captioned “Prohibiting Identification of Another as Creator of the Author’s Work” that “[f]alse identification of another as author . . . may give rise to a claim by the actual author under section 43(a).” In a section captioned “Prohibiting Identification of the Author as Creator of Another’s Work” - a reference to traditional passing off - the Report recognizes a series of federal cases as precedents supporting a remedy for “false identification” of expressive works under section 43(a). Finally, with respect to the right of integrity, the Final Report cites *Gilliam* as a leading case, noting that “[c]ourts increasingly have granted authors protection for the integrity of their work under section 43(a).”<sup>154</sup>

Despite the clear negative impact, Congress has done nothing to counter *Dastar*’s obliteration of false designation of origin claims as a viable legal theory for redress of would-be moral rights violations. That is so, even in the face of the widespread judicial applications of the Supreme Court’s opinion that VARA signals legislative intent to preclude all authors from obtaining relief for violations of rights granted under VARA—that is the limited right of attribution and right of integrity—except for the limited subset of visual artists to which § 106A of the Copyright Act applies.

## 2. False Endorsement Redress for Sound-Alikes, but not Actual Performances

Various federal courts have found viable claims under Lanham Act § 43(a) for false endorsement based upon use of a celebrity’s name, image, or likeness to invoke their celebrity for commercial purposes, where such use was likely to confuse the consuming public about the celebrity’s association with or

---

<sup>154</sup> Mary LaFrance, *When You Wish Upon Dastar: Creative Provenance and the Lanham Act*, 23 *CARDOZO ARTS & ENT. L.J.* 197, 222–24 (2005) (footnotes omitted).

endorsement of the advertised goods or services.<sup>155</sup> This theory of recovery has been extended to sound-alikes, under state law as well, establishing precedent that remains good law today.<sup>156</sup>

But, bizarrely, claims for false endorsement have failed most music vocalists seeking to assert the theory for relief from use of their *actual* recorded performances. The failures can be attributed to copyright preemption.<sup>157</sup> There are, however, additional challenges to the viability of a false endorsement claim as an alternative to an express grant of moral rights. One is the lack of a uniform test amongst federal circuits, which subjects plaintiffs to forum dependent outcomes and possibly emboldens defendants in venues with stricter tests.<sup>158</sup> Another is the unpredictability of First Amendment defenses that may apply to the claim.<sup>159</sup>

Recording artist Tom Waits prevailed on his claim for false endorsement—*Waits v. Frito-Lay, Inc.* in 1992—where Frito-Lay used a sound-alike to mimic Waits’ sound and style of singing a lyrically altered version of “Step Right Up,” a Waits song

---

<sup>155</sup> See, e.g., *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 925–26 (6th Cir. 2003); *Parks v. LaFace Records*, 329 F.3d 437, 445 (6th Cir. 2003); *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 813–14 (9th Cir. 1997) (reversing dismissal of Lanham Act claim for unfair competition and holding that the physical characteristics of robots could give rise to a claim for false endorsement due to the likelihood of confusion that the plaintiffs were endorsing the Cheers bars); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1400–01 (9th Cir. 1992) (holding there was a genuine issue of material fact precluding summary judgment as to a false implied endorsement claim brought by Vanna White, the hostess of the “Wheel of Fortune” game show, for use in an advertisement for VCRs of a look-alike caricature robot endorsing the defendant’s product); *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 628–30 (S.D.N.Y. 1985) (upholding actor Woody Allen’s claim of false implied endorsement for use in an advertisement for video-rental stores of a look-alike renting videos from defendant).

<sup>156</sup> See, e.g., *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1021 (3d Cir. 2008); *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (finding a viable claim under California common law).

<sup>157</sup> See, e.g., *Beastie Boys v. Monster Energy Co.*, 66 F. Supp. 3d 424, 448 (S.D.N.Y. 2014) (first citing *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 63 (2d Cir. 2001); then citing *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003)).

<sup>158</sup> *Id.* at 448 (“Courts ‘have not established a uniform test for false endorsement under the Lanham Act.’” (quoting Barbara A. Solomon, *Can the Lanham Act Protect Tiger Woods? An Analysis of Whether the Lanham Act is a Proper Substitute for a Federal Right of Publicity*, 94 TRADEMARK REP. 1202, 1214 (2004))).

<sup>159</sup> *Id.* at 447–48 (“[C]ourts must construe the Lanham Act narrowly where necessary to avoid conflict with the First Amendment right to artistic expression.” (citing *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989))).



intended as “an indictment of advertising.”<sup>160</sup> Waits took offense because the commercial not only caused confusion, but also conflicted with his long-standing and publicly asserted policy against commercially-purposed endorsements, based on “his philosophy that musical artists should not do commercials because it detracts from their artistic integrity.”<sup>161</sup> Certainly this is the sort of ideological conflicting association that should be protected against.

Nevertheless, myopically, most courts applying the *Waits* precedent have focused on the distinctiveness of Waits’ voice and/or whether the mimicked performance was close enough to the original artist’s performance to cause the confusion required for false endorsement. In one such instance—*Henley v. DeVore*—a California federal district court concluded that a state politician’s revision and performance of two Don Henley’s songs, including “All She Wants to Do Is Dance,” was not likely to make consumers believe Henley was singing the song.<sup>162</sup> Dismissing Henley’s false endorsement claim on that basis, and disregarding survey evidence that forty-eight percent of consumers surveyed believed that Henley—as the composition copyright owner—had endorsed, authorized, or approved the politician’s use of the songs, the court held that the relevant question under *Waits* was “whether people would reasonably think that Henley *actually performed* the music.”<sup>163</sup> This outcome was an unfortunate disregard of the false approval basis for a Lanham Act § 43(a) claim, and it illustrates the inherent hit-or-miss nature of the alternative theory approach to meeting the United States’ moral rights obligations under the WPPT, as well as under the Berne Convention.

One California federal district court did acknowledge that confusion as to endorsement could exist even in the absence of confusion as to source, when it refused to dismiss singer-songwriter Jackson Browne’s claim against John McCain. McCain had used Browne’s 1977 hit “Running On Empty” in

---

<sup>160</sup> 978 F.2d 1093, 1097 & n.1, 1111 (9th Cir. 1992) (affirming judgment for plaintiff, Tom Waits, on false implied endorsement claim for use in a snack-food commercial of a singer who imitated plaintiff’s gravelly singing style praising defendant’s product), *abrogated by* Lexmark Int’l, Inc. v. Static Control Components, Inc., 572 U.S. 118 (2014).

<sup>161</sup> *Id.* at 1097.

<sup>162</sup> 733 F. Supp. 2d 1144, 1147, 1168 (C.D. Cal. 2010) (citing *Waits*, 978 F.2d at 1111).

<sup>163</sup> *Id.* at 1168–69 (emphasis in original).

McCain's 2008 presidential campaign web-video commercial to criticize then Democratic Presidential candidate Barak Obama's energy policy.<sup>164</sup> Plainly stating that the problem was an ideology conflict, rather than an issue of money, Browne had complained that he had "received numerous inquiries expressing concern about Defendants' use of the composition and Browne's performance," and that "'nothing could be further from the truth'" than the commercial's false suggestion that he sponsored, endorsed, or was associated with McCain or the Republican Party.<sup>165</sup>

But most courts have declined to extend the protection afforded to Waits under Lanham Act § 43(a) from use of a sound-alike singing a signature song, to music vocalists asserting the same false endorsement claim based upon use of their actual recorded performances.<sup>166</sup>

When Frito-Lay struck again, this time using singer Atrud Gilberto's 1964<sup>167</sup> recorded performance of her world-famous signature song, "The Girl from Ipanema," as the soundtrack for a thirty-second commercial introducing Frito-Lay's baked potato chips in 1996, the Second Circuit—in its 2001 *Oliveira v. Frito-Lay, Inc.* decision—summarily affirmed dismissal of Gilberto's false endorsement claim, holding simply that "use of her recorded song ha[d] not taken her persona," so "a factfinder could not reasonably find an implied endorsement."<sup>168</sup>

Following *Oliveira*, courts have held that a false endorsement claim cannot be sustained purely on the basis of the use of an artist's song(s) and that use of a single signature song is not enough.<sup>169</sup> The apparent assumption is that consumers will

---

<sup>164</sup> *Browne v. McCain*, 612 F. Supp. 2d 1125, 1128, 1133 (C.D. Cal. 2009). Defendant raised fair use as a defense, but the court declined to adjudicate the issue on a motion to dismiss, as it was a mixed question of law and fact. *Id.* at 1130. The court similarly rejected the defendant's First Amendment artistic relevance defense, due to its limited inquiry on the motion. *Id.* at 1132–33. The case settled prior to adjudication on the merits. *See Johnston, supra* note 10, at 690.

<sup>165</sup> *Browne*, 612 F. Supp. 2d at 1129 (quoting Complaint at 1, *Browne v. McCain*, 612 F. Supp. 2d 1125 (C.D. Cal. 2009) (No. CV 08-05334), 2008 WL 3849451).

<sup>166</sup> *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 58, 60, 62 (2d Cir. 2001); *Henley*, 733 F. Supp. 2d at 1168; *see also* Arlen W. Langvardt, *Musicians, Politicians and the Forgotten Tort*, 27 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 429, 476–78 (2017).

<sup>167</sup> The pre-1972 sound recording of "The Girl from Ipanema" was subject to state copyright law. *See Oliveira*, 251 F.3d at 64 n.2.

<sup>168</sup> *Id.* at 58, 60, 62, 64.

<sup>169</sup> *See Beastie Boys v. Monster Energy Co.*, 66 F. Supp. 3d 424, 453 (S.D.N.Y. 2014) (holding "a single signature song, considered alone, cannot form the basis of a false endorsement claim"; but finding sufficient evidence to support jury verdict of

not be confused about endorsement if they hear the original sound recording.<sup>170</sup> Such an assumption implies that courts are relying on consumers to know and understand that copyright licensing practices enable use of sound recordings without the music vocalist's consent, and therefore the use does not support a reasonable inference of endorsement.

Based on that judicial assumption, were Frito-Lay to make another commercial using Waits' actual recorded performance in "Step Right Up" instead of a sound-alike, Waits would lose on his claim. That result is absurd in the context of providing redress for the ideological conflict that arises from associating Waits with any commercial advertising at all, given his stance on artistic integrity and commercials. But it perfectly illustrates the problem with attempting to address moral rights and personhood violations by using alternative theories that do not take the personal interests of artists into consideration, let alone prioritize those interests.

### 3. Rejection of the "Signature Song" Basis for Trademark Infringement

Courts have acknowledged that songs can function as a trademark to signal the source of a good or service.<sup>171</sup> Such song marks include not only advertising jingles specifically written for a commercial campaign, but also preexisting songs that become associated with a single product or service source through use over time.<sup>172</sup> Yet, even while acknowledging that a signature song—meaning one that a "widespread audience associates with

---

false endorsement based on use of multiple Beastie Boys songs for eighty percent of the commercial, in conjunction with use of the group's name); *Henley*, 733 F. Supp. 2d at 1168 ("Plaintiffs cannot maintain a Lanham Act claim based *purely* on the use of Henley's songs."). For a hybrid-basis, where allegations that the defendants used both copyrighted recordings and sound-alikes for a social media celebrity's endorsement of singer Beyoncé's single "Formation" and the related tour, see *Estate of Barre v. Carter*, No. 17-1057, slip op. at 2 (E.D. La. July 25, 2017).

<sup>170</sup> See *Henley*, 733 F. Supp. 2d at 1167 ("Where an advertisement mimics a celebrity's voice to endorse a product, a customer may be understandably confused as to whether the celebrity is actually endorsing the product. However the mere use of the celebrity's prior performance does not present the same sort of confusion.").

<sup>171</sup> See *Oliveira*, 251 F.3d at 61 ("For many decades it has been commonplace for merchandising companies to adopt songs, tunes and ditties as marks for their goods or services, played in commercials on the radio or television.").

<sup>172</sup> A ready example of a preexisting song being used as a trademark is "Like a Rock," written and sung by Bob Seger, which became associated with Chevy trucks through Chevrolet's repeated use of the songs in its truck commercials from 1991 to 2004. See *Beastie Boys*, 66 F. Supp. 3d at 453.

the performing artist”<sup>173</sup>—can indeed come to signify a single source instead of just the song itself, courts have consistently rejected claimed trademark rights in songs as a source identifier for the entertainment services of the music vocalist who popularized the song in the first place.<sup>174</sup>

The justification for refusing to recognize song marks for services of vocalists, as was articulated by the Second Circuit in *Oliveira v. Frito-Lay, Inc.*, has little to do with trademark law and everything to do with preserving copyright law as the means for controlling economic exploitation of music compositions and sound recordings:

We cannot say it would be unthinkable for the trademark law to accord to a performing artist a trademark or service mark in her signature performance . . . . But for a court now to “recognize” the previously unknown existence of such a right would be profoundly disruptive to commerce. Numerous artists who could assert claims similar to Gilberto’s would bring suit against entities that had paid bona fide license fees to all known holders of rights. Indeed, artists who had licensed users under their copyrights and had received fees for the copyright license could bring suits claiming additional compensation for infringement of trademark rights. Immense unforeseen liabilities might accrue, upsetting reasonable commercial expectations. We can see no justification for now altering the commercial world’s understanding of the scope of trademark rights in this fashion.<sup>175</sup>

And so, Gilberto was left without any recourse because Frito-Lay had paid \$200,000 for license to use the master.<sup>176</sup>

---

<sup>173</sup> The Second Circuit defined a “signature performance” as one “that a widespread audience associates with the performing artist,” and acknowledged that “[m]any famous artists have recorded such signature performances that their audiences identify with the performer.” *Oliveira*, 251 F.3d at 62.

<sup>174</sup> See *id.* at 62 (citing *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 712–13 (9th Cir.1970) (where court rejected a “claim by singer Nancy Sinatra that song she sang ‘has been so popularized by [Sinatra] that her name is identified with it; that she is best known by her connection with the song [and] that said song . . . has acquired a secondary meaning’ such that another person could not sing it in a commercial”)); *cf.* *Butler v. Target Corp.*, 323 F. Supp. 2d 1052, 1054 (C.D. Cal. 2004) (“Rebirth of Slick (Cool Like Dat)” “has become the ‘signature song’ for Digtible Planets, closely associated with the group and the members of the group.”). See also *Beastie Boys*, 66 F. Supp. 3d at 453 (“[A]n artist’s ‘signature performance’ cannot establish a trademark signifying that artist.”).

<sup>175</sup> *Oliveira*, 251 F.3d at 62–63.

<sup>176</sup> *Id.* at 58.

The *Oliveira* court's rationale echoed the Ninth Circuit's concern some thirty years prior to the *Oliveira* case, when, at a time prior to federal copyright protection for sound recordings, the court denied all relief to recording artist Nancy Sinatra, of "These Boots Were Made for Walking" fame, on a claim for passing off under California unfair competition law against the Goodyear Tire & Rubber Company, seeking injunctive relief and damages for essentially the same scenario for which Waits successfully sued Frito-Lay twenty years later.<sup>177</sup> Sinatra claimed that the song had acquired secondary meaning, and alleged that Goodyear had intentionally passed off the services of others as the service of Sinatra.<sup>178</sup> Without holding that there was no secondary meaning, the Ninth Circuit reasoned as follows:

Here, the defendants had paid a very substantial sum to the copyright proprietor to obtain the license for the use of the song and all of its arrangements. The plaintiff had not sought or obtained the same rights which would have protected the secondary meaning she asserts . . . . [T]he inherent difficulty of protecting or policing a "performance" or the creation of a performer in handling copyrighted material licensed to another imposes problems of supervision that are almost impossible for a court of equity.

An added clash with the copyright laws is the potential restriction which recognition of performers' "secondary meanings" places upon the potential market of the copyright proprietor. If a proposed licensee must pay each artist who has played or sung on the composition and who might therefore claim unfair competition-performer's protection, the licensee may well be discouraged to the point of complete loss of interest. Finally, . . . to allow unfair competition protection where Congress has not given federal protection is in effect granting state copyright benefits without the federal limitations of time to permit definite public domain use.<sup>179</sup>

---

<sup>177</sup> See *Sinatra*, 435 F.2d at 717–18 (affirming summary judgment). Goodyear had modified the lyrics and used the music to Sinatra's signature song "These Boots Were Made for Walking" for a widespread radio and television advertising campaign for its new "wide boot" tires, and resorted to hiring singers to imitate Sinatra's voice, performance style, and mannerisms when it could not hire Sinatra for the commercials. *Id.* at 712–13.

<sup>178</sup> *Id.* at 712.

<sup>179</sup> *Id.* at 717–18 (footnote and citation omitted).

Thus, we can add to the historic concern about copyright conflict or preemption, judicial concerns about overextending unfair competition law in a way that undercuts predictability of the familiar copyright licensing scheme and a concern about how to manage, enforce, or police performer rights if some are recognized.<sup>180</sup>

*B. Tort Theory: Right of Publicity and Misappropriation of Voice Claims*

The distinction in the false endorsement context between use of sound-alikes, which are held to implicate persona, and use of actual voice via recordings, which are held not to do so, has carried over to claims sounding in tort.<sup>181</sup> As a result, courts have held that right of publicity and misappropriation of voice claims are preempted by copyright law, rendering them ineffective as an alternative means of providing redress for violation of a music vocalist's personhood rights.<sup>182</sup>

Such was the case when recording artist Debra Laws asserted a common law misappropriation of voice claim and a California statutory right of publicity claim against Sony Music Entertainment for using samples of her recorded performance from her signature hit, "Very Special," throughout the song "All I Have" by Jennifer Lopez and L.L. Cool J, without her permission.<sup>183</sup> Laws had recorded "Very Special" in 1981, while under contract with Elektra, which owned the copyright in the master.<sup>184</sup> Sony had licensed the samples from Elektra. The Ninth Circuit affirmed dismissal of both claims, holding that "federal copyright law preempts a claim alleging misappropriation of one's voice, when the entirety of the allegedly misappropriated vocal performance is contained within a copyrighted medium."<sup>185</sup> The court further held that "the right

---

<sup>180</sup> See *id.*; see also *Oliveira*, 251 F.3d at 62–63.

<sup>181</sup> *Butler v. Target Corp.*, 323 F. Supp. 2d 1052, 1055 (C.D. Cal. 2004).

<sup>182</sup> See, e.g., *id.* at 1056–57 (C.D. Cal. 2004) (dismissing right of publicity claim based on Target's use of the group Dignable Planets' recorded performance of their signature song "Cool Like Dat" in Target commercial campaign as preempted).

<sup>183</sup> See *Laws v. Sony Music Entm't, Inc. (Laws II)*, 448 F.3d 1134, 1135–36 (9th Cir. 2006); *Laws v. Sony Music Entm't, Inc. (Laws I)*, 294 F. Supp. 2d 1160, 1161 (C.D. Cal. 2003).

<sup>184</sup> See *Laws II*, 448 F.3d at 1136; see also *Laws I*, 294 F. Supp. 2d at 1161.

<sup>185</sup> *Laws II*, 448 F.3d at 1141 ("Sony was not imitating 'Very Special' as Laws might have sung it. Rather, it used a portion of 'Very Special' as sung by Debra Laws.").

of publicity is not a license to limit the copyright holder's rights merely because one disagrees with decisions to license the copyright," and reiterated its earlier reasoning in *Sinatra* regarding concerns about subjecting copyright licensees to suit by performers.<sup>186</sup>

In other instances where music vocalists sought relief from objectionable uses of their recorded performances via right of publicity or misappropriation of voice theories, their claims have been hampered by language in a New York statute that expressly excludes liability for use of name, likeness, or voice of artists in connection with their musical productions that have been sold or disposed of.<sup>187</sup> On this basis, rape survivor Connie Francis was deprived of relief from Universal's use of her signature hits in its film, notwithstanding her personal objections to the violent and sexual nature of the film.<sup>188</sup> Francis' claim for intentional infliction of emotional distress was also dismissed, but on the ground that Universal "did not act extremely or outrageously, but in conformity with its contract,"<sup>189</sup> illustrating, again, judicial priority for the licensee's contractual rights to the detriment of artist personhood rights.

The effect of the exception language in the New York right of publicity statute is antithetical to the mandated moral right under the WPPT, which is supposed to ensure that the artist retains control and protection of personhood rights even after sale of the economic right(s).<sup>190</sup>

### C. *Compromised Reliability of Contract Theory*

Ideally, the ability to negotiate limitations on the use and exploitation of a copyrightable work should encompass an ability

---

<sup>186</sup> *Id.* at 1145 (citing *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 718 (1970) and opining that "[i]t is hard to imagine how a copyright would remain meaningful if its licensees were potentially subject to suit from any performer anytime the copyrighted material was used").

<sup>187</sup> N.Y. CIV. RIGHTS Law § 51 (McKinney 2018) provides:

But nothing contained in this article shall be so construed as to prevent any person, firm or corporation . . . from using the name, portrait, picture or voice of any author composer, or artists in connection with his literary, musical or artistic productions which he has so or disposed of with such name, portrait, picture or voice used in connection therewith.

<sup>188</sup> *Franconero v. Universal Music Corp.*, No. 02 Civ. 1963, 2003 WL 22990060, at \*1, \*4 (S.D.N.Y. Dec. 19, 2003).

<sup>189</sup> *Id.* at \*3 (holding that "[w]here the defendant had a proper business motive for its actions, intentional infliction claims will not lie").

<sup>190</sup> WPPT, *supra* note 90, at art. 5.

to protect moral rights of the author of the work.<sup>191</sup> However, contract theory as a stand-in for express provision of moral rights is compromised on two levels.

First, the use of contracts in this manner relies upon the author having sufficient bargaining power to successfully negotiate such limits on the use and exploitation of the work. However, most music vocalists simply do not have the requisite leverage to extract such limits when entering into recording contracts that transfer copyright ownership and related exploitation rights for the artist's sound recordings to the record labels.<sup>192</sup>

Second, even where authors are able to negotiate for limitations on the exploitation of transferred works, contract theory is unreliable. Referring back to *Gilliam*, the plaintiffs' copyright infringement claim was based on ABC's production and broadcasting of an unauthorized derivative work.<sup>193</sup> Although ABC had permissibly licensed use of the recordings for broadcast from BBC, the court held that ABC was nonetheless liable for infringement because any license from BBC to edit the recordings had exceeded the scope of the license between the scriptwriters and BBC, making the sub-license from BBC void.<sup>194</sup> Thus, contract theory helped to enforce the negotiated bounds of BBC's copyright in the recordings and did not shield licensees from liability. But for Debra Laws, the Ninth Circuit held that to the extent that Laws had enforceable, contractual limitations on Elektra's use of its copyright in her sound recordings, that is requiring her permission for licensing "Very Special," her remedy was against Elektra for breach of contract and not against Sony as Elektra's licensee.<sup>195</sup>

---

<sup>191</sup> See, e.g., *Rey v. Lafferty*, 990 F.2d 1379, 1392 n.10 (1st Cir. 1993) ("[U]nder copyright law, while a licensor has no 'moral right' to control the quality of licensed depictions, she may insist, contractually, on approval provisions to 'assure quality control and high standards in the exploitation' of her creative work.").

<sup>192</sup> See *Chisolm*, *supra* note 2, at 291, 300, 305, 307, 311.

<sup>193</sup> *Gilliam v. Am. Broad. Cos., Inc.*, 538 F.2d 14, 18 (2d Cir. 1976).

<sup>194</sup> *Id.* at 20–21.

<sup>195</sup> *Laws v. Sony Music Entm't, Inc.*, 448 F.3d 1134, 1144 (9th Cir. 2006).



V. PROPOSED AMENDMENTS TO FILL THE GAP IN PROTECTIONS  
AGAINST HARMS TO PERSONHOOD INTERESTS OF MUSIC  
VOCALISTS

In a prior article, this author proposed an amendment to § 102 of the Copyright Act to add a licensable, but otherwise inalienable copyright for music vocalists in their music performance as an “applied music composition,” and an amendment to § 106 to limit the derivative use of sound recordings in accordance with the scope of the music performance copyright.<sup>196</sup> The prior article focused on the proposed amendments as a solution to primarily economic inequities, and it explained why copyright law must be the vehicle to address those inequities.<sup>197</sup> This Part demonstrates how the proposed amendments could fill the gap in protections against harms to personhood, without unreasonably hindering the economic rights of non-performer sound recording copyright owners. It also demonstrates how the proposed amendments would enhance the United States’ compliance with its obligations under the WPPT to provide coexistent, mutually exclusive rights to reproduce, distribute, publicly perform, and commercially rent the performers’ fixed performances and the sound recording copyright owners’ sound recordings.

Adopting the proposed amendments would eliminate the copyright conflict and copyright preemption concerns presented by attempted use of noncopyright law claims fill the gap of missing moral rights in our copyright regime.

A. *Scope of Proposed Copyright in “Applied Music Composition”*

This author proposes to recognize the music vocalist’s auditory performance as a discrete, copyrightable work—the applied music composition—under § 102(a), whenever the performance satisfies the threshold requirement for original creative contribution.<sup>198</sup> Upon fixation of the performance, a copyright in the applied music composition would vest in the music vocalist, just as the initial fixing of a composition vests the

---

<sup>196</sup> As mentioned in Part I, the amendments that are further discussed here were first proposed in a related article which focused primarily on addressing economic inequities for music vocalists. Chisolm, *supra* note 2, at 330–33.

<sup>197</sup> See generally *id.* at 320–28.

<sup>198</sup> *Id.* at 330 (noting that “[t]he existing body of case law provides the necessary benchmark for determining whether the minimum threshold for original creativity is satisfied”).

composition copyright in the songwriter/composer. Similarly, “allowable forms of fixation for the applied music composition would be . . . either notated copy, or non-audio digital files, or a phonorecord,” and acceptable deposit copies “would be any of these three for registration as a work of performing arts, or a phonorecord for simultaneous registration, where ownership of the sound recording and applied composition are the same.”<sup>199</sup> Further, repeating here what was originally proposed,

The copyright bundle for the applied composition should include all rights available under Section 106, which are the rights: (i) to reproduce the copyrighted work in copies and phonorecords; (ii) to prepare derivative works based upon the copyrighted work; (iii) to distribute copies or phonorecords of the copyrighted work to the public by sale to other transfer of ownership, or by rental, lease, or lending; (iv) to perform the copyrighted work publicly by any means (whether live or by playing or broadcast of recorded or live performances, as well as by digital transmission); and (v) to display the work publicly. . . .

Once fixed, the applied composition would be protected beyond any sound recording encompassing the audio performance, subject to a compulsory mechanical license, just as compositions are treated. The compulsory license would allow any other person to lawfully make and distribute copies/phonorecords of the resulting musical structure embodied by the applied composition, if that person’s primary objective is distribution to the public for private use. Modified statutory royalties would apply to enable compensation for composers *and* vocalists where applicable. In the instance where the composer is the performer, the modified royalty would collapse to the original composer royalty scheme.<sup>200</sup>

Allowing the proposed applied music composition copyright to coexist with, but otherwise be separate from, the copyright in the sound recording provides a means of compliance with WPPT Article 8(1), which requires that “[p]erformers shall enjoy the exclusive right of authorizing the making available to the public of the original and copies of their performances fixed in phonograms through sale or other transfer of ownership,” as well as with WPPT Articles 9 and 10, which require that performers

---

<sup>199</sup> *Id.* at 331.

<sup>200</sup> *Id.* The further discussion of a sample statutory royalty split explained in the prior article is omitted here.

“enjoy the exclusive right of authorizing the commercial rental . . . and the making available to the public” of their fixed performances.<sup>201</sup>

Moreover, including the derivative work's exclusive right as part of the copyright bundle for this new right is imperative, because it is that part of the bundle that enables the performer to assert and protect the right of integrity contemplated by WPPT Article 5(1). “U.S. authors who hold the derivative right may prevent modifications to their work that run [counter] to their . . . sensibilities, without any need to show consumer deception or harm to reputation[,]”<sup>202</sup> as would be required on a Lanham Act or defamation claim, respectively.

*B. Duration of Proposed “Applied Music Composition” Copyright*

The duration of the applied music composition copyright should match the duration of all other individually held copyrights under the copyright law. Such a duration is consistent with Article 5(2) of WIPO's WPPT, which requires that “[t]he rights granted to a performer in accordance with [Article 5,] paragraph (1) shall, after his death, be maintained, at least until the expiry of the economic rights.”<sup>203</sup>

*C. Restriction on Right to Make Derivative Works of Sound Recordings*

This author also proposes a restriction on the right to make derivative works from sound recordings in two respects.

First, derivative works from sound recordings would require using the integrated whole, and not allow vocals to be isolated from the sound recording for separate use. The purpose of this restriction is:

[T]o curtail the ability of the record label and non-feature-vocalist joint authors of the sound recording (i.e. producers, sound engineers, back-up vocalists, etc.) to create or license others to create derivative works of the sound recording that make use of the vocalist's audio performance isolated from the contributions of the back-up vocalists, musicians, and/or sound engineer.<sup>204</sup>

---

<sup>201</sup> WPPT, *supra* note 90, at arts. 8(1), 9(1).

<sup>202</sup> Netanel, *supra* note 54, at 43 (“The derivative right . . . is essentially coterminous with at least the negative aspect of the integrity right.”).

<sup>203</sup> WPPT, *supra* note 90, at art. 5(2).

<sup>204</sup> Chisolm, *supra* note 2, at 332.

Parties desiring to use the featured vocalist's isolated recorded performance would have to seek permission from the vocalist, as owner of the applied music composition copyright, instead of from the record label, as owner of the sound recording copyright. This restriction is consistent with the objective of joint work authorship because joint authors must intend for their contributions to "be merged into inseparable [and] interdependent parts of a unitary whole."<sup>205</sup>

Second, the sound recording copyright owner's right to make or license derivative works from the sound recording would be subject to consent from the vocalist, as owner of the applied composition copyright. This proposed "restriction recognizes the applied composition as a musical work and not merely a recorded performance. It also affords the music vocalist more control over the content (political, artistic, or otherwise) with which the sound recording may be associated by later licensing and use."<sup>206</sup>

The notion of requiring multiple permissions for exploitation of a work is already ingrained in the United States copyright regime. Use of sound recordings has always required permission from the owner of the underlying composition copyright. The requirement of one more permission should pose no obstacle to exploitation of sound recording, especially when the music vocalist(s) holding the right would be easily identifiable and likely as easy to locate for purposes of effecting the transaction. A marginal increase in exploitation transaction costs to account for directing passive income to the music vocalist is justified, where third party interest in using the work stems from the applied music composition rather than just the bare music composition. Such an increase would likely still represent a savings over the cost of the third party having to arrange for and record a new performance of the bare music composition for the third party's intended use.

---

<sup>205</sup> 17 U.S.C. § 101 (2012) (defining "joint work").

<sup>206</sup> Chisolm, *supra* note 2, at 332–33.

D. *Inalienability vs Alienability of the "Applied Music Composition" Copyright*

1. The Rationale for Inalienability, Subject to Contemporaneous License

Consistent with a true monist perspective on copyrights, the applied music composition would include personhood protections "rolled into" the economic rights elements of the copyright. And as the German Copyright Act has demonstrated is possible, the economic interest elements of the applied music composition copyright should be licensable, but otherwise the copyright should be inalienable for a number of reasons. Moreover, the license should be contemporaneous with the requested use, rather than a blanket advance license.

First, making the new right completely alienable or subject to advance licensing would subject its worth to "the same bargaining power imbalances and result in the same inequities" that music vocalists currently experience regarding ownership of the sound recording copyright, and thus accomplish nothing meaningful.<sup>207</sup> Second, and conversely, "[m]aking the new right inalienable would eliminate ownership claims under the work-for-hire doctrine, since, by definition, the applied composition copyright could only vest in the vocalist."<sup>208</sup> Third, the concept of inalienability is critical to the personhood paradigm for copyright.

According to Professor Justin Hughes, "[n]ot only does Hegel's personality [justification] theory pose no inherent objection to this kind of alienation of intellectual property, it also provides affirmative justifications," including the economic well-being of the author; payments for use of the work equate to recognition of the author's control of the work and the generation of "income facilitates further expression."<sup>209</sup> Notably, in arguing that personhood "theory provides a better, more direct justification for the alienation of intellectual property, especially copies," which enable dissemination of the author's expression, Professor Hughes identifies the creator's receipt of public

---

<sup>207</sup> See *id.* at 330 (arguing that "[t]he new right should be inalienable . . . for the same reasons the termination rights under §§ 203 and 304 [of the Copyright Act] are inalienable," i.e. to avoid "the same inequities that result when an artist does not know 'the true monetary value of their works prior to commercial exploitation'").

<sup>208</sup> *Id.*

<sup>209</sup> Hughes, *supra* note 21, at 349.

identification—that is the moral right of attribution—and protection of the work “against any changes unintended or unapproved by the creator”—the moral right of integrity—as essential conditions to the justification of alienation.<sup>210</sup>

In sum, while the strictest interpretation of inalienability requires an absolute prohibition against any separation of rights from the author, prohibiting waiver and assignment while allowing licenses is consistent with even the strict monist perspective illustrated by German copyright law. It is apparent from the express language of the WPPT that alienability of economic rights, with inalienability of moral rights is indeed contemplated, so the proposed inalienability of the applied composition copyright provides the “means of redress for safeguarding” the moral rights mandated by Article 5(1), without having to expressly grant moral rights.<sup>211</sup>

## 2. The Effects on Sound Recording Copyrights

The U.S. copyright regime expressly embraces unlimited alienability of each exclusive right in the copyright bundle enumerated in § 106 of the Copyright Act.<sup>212</sup> “The principle of unlimited alienability requires that an author be free to assign, license, and waive each of these exploitation rights.”<sup>213</sup> Some might even argue that alienability furthers the utilitarian goal of ensuring dissemination of copyrightable works. As Netanel explained,

Under the utilitarian model, the widespread dissemination of intellectual works is as important a goal of copyright as is their creation. Since dissemination is accomplished by publishers and distributors, rather than authors, copyright is designed as much to protect the publisher’s investment in bringing a work to market as it is to give the author an incentive to produce. Thus,

---

<sup>210</sup> *Id.* at 350.

<sup>211</sup> United States Convention World Intellectual Property Organization Performances and Phonograms Treaty art. 5(3), May 20, 2002, S. Treaty Doc. No. 105-17.

<sup>212</sup> 17 U.S.C. § 106 (2012) (“Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do *and to authorize*” the enumerated rights described) (emphasis added); *id.* § 204 (providing for transfers to copyright ownership by operation of law or by written instrument signed by the rightsholder or an authorized agent).

<sup>213</sup> Netanel, *supra* note 54, at 1.

since the Statute of Anne of 1710, the English predecessor to U.S. copyright law, statutory copyright privileges have been accorded to authors' assigns as well as to authors themselves.<sup>214</sup>

However, in a framework such as the music industry, when the investments advanced by record labels for production, marketing, and distribution of the copyrighted sound recordings are one-hundred percent recoupable from the recording artist,<sup>215</sup> the rationale for favoring *absolute* alienability and subordination of the recording artist's personhood rights and reward is not compelling.

It is precisely because a recording artist does not receive passive income—royalties—until reaching recouped status that the economic incentive for the artist, as author of the applied music composition, to encourage, authorize, and enable distribution and exploitation of the sound recordings embodying the applied music composition would be as strong as that of the recording label holding the copyright in the sound recording. The artist and the label both benefit from recouping the costs of masters production and promotion via record sales and derivative use. In that way, the economic interests of the recording artist and the record label are the same and, presumably, those interests diverge only where the personhood interests of the recording artist are in conflict. Thus, it would be in the best interest of the artist to minimize withholding authorization for derivative works in the absence of serious compromises to the artist's personhood interests. Recording contracts could be read to impose a covenant of good faith and fair dealing with respect to artists' contemporaneous consent to exploitation of the masters. Copyright misuse would serve as an additional check against unwarranted interference with the label's ability to recoup its investments.

Accordingly, making the applied music composition copyright an inalienable right belonging solely to the featured music vocalist(s), subject only to licensing of the economic rights of exploitation, would not hinder economic exploitation as the courts have speculated. To the contrary, the inalienability of the moral rights elements would ensure the alienability of the economic rights elements by serving as the prophylactic measure against harmful exploitation.

---

<sup>214</sup> *Id.* at 11.

<sup>215</sup> See PASSMAN, *supra* note 41, at 74–82.

Finally, the proposed amendments are consistent with what the Committee on Foreign Relations contemplated: parallel rights that “may be exercised separately by the performers and producers” such that “[p]ermission from both the performer and the producer must be obtained for a third-party” to exploit the phonogram,<sup>216</sup> subject to legislated domestic limitations, such as fair use, and other restrictions.<sup>217</sup>

#### CONCLUSION

Compliance with WPPT requires the United States to enact laws that vindicate music performers’ moral rights of attribution and integrity, as this Article has demonstrated that continued reliance on existing domestic laws is simply unfounded. Actual compliance with WPPT and Article 6 of the Berne Convention is a true necessity as continued technological progress and globalization combine to all but eliminate meaning and effect of territorial bounds for creation and exploitation of intellectual property.

In demonstrating the inefficacy of contract, tort, and unfair competition law as substitutes for an explicit grant of the moral right of integrity or other protections for personhood rights, Part IV identified recurring themes of copyright conflict or preemption, resistance to changing predictability of ingrained industry licensing practices, and perceived challenges to managing, enforcing, and policing additional performer rights, if some are recognized. The proposed new rights and restrictions directly address these concerns.

While the United States may never incorporate an express provision of the mandated moral rights of attribution and integrity for all authors of creative works into U.S. copyright law, or any other statutory law, this Article has shown that such codification is unnecessary, with respect to music vocalists, if the proposed amendments are adopted.

---

<sup>216</sup> See WCT & WPPT Exec. Rept., *supra* note 111, at 9.

<sup>217</sup> See generally 17 U.S.C. §§ 107–122 (providing various limitations on exclusive rights); United States Convention World Intellectual Property Organization Performances and Phonograms Treaty art. 16, May 20, 2002, S. Treaty Doc. No. 105-17.