

Expert Q&A on the Copyright Preemption and Right of Publicity Claims Conflict in Entertainment

by PLC Intellectual Property & Technology

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An expert Q&A with Jonathan D. Goins of Lewis Brisbois LLP regarding the recent *In re Jackson* decision by the US Court of Appeals for the Second Circuit. The Second Circuit adopted the copyright preemption doctrine to bar plaintiff's state right of publicity claim. It includes useful tips for managing risks and potential liability arising from right of publicity claims when reproducing copyrighted music.

On August 19, 2020, the US Court of Appeals for the Second Circuit issued a pivotal decision in *In re Jackson*, a case of first impression in the Second Circuit (972 F.3d 25 (2d Cir. 2020)). Jonathan D. Goins of Lewis Brisbois LLP led the legal team that secured a victory for Defendant William Roberts, publicly known as Rick Ross, against Plaintiff Curtis Jackson, publicly known as 50 Cent. In its ruling, the Second Circuit adopted the copyright preemption doctrine to bar Jackson's state right of publicity claim. The decision is the first publicly-reported ruling on this preemption issue in the Second Circuit, the home of many multi-media entertainment giants.

Practical Law asked Mr. Goins for his insight on the Second Circuit's decision and the circuit split, and to explain how best to manage the risks and potential liability arising from right of publicity claims when reproducing copyrighted music. Mr. Goins is vice-chair and member of the firm's Intellectual Property & Technology and Entertainment, Media & Sports Practices. He has extensive experience as lead counsel in litigating federal cases nationally for a range of clients involving trademarks, copyrights, trade secrets, right of publicity, entertainment, breach of software contracts, and related business torts. Mr. Goins has been consistently ranked in peer-recognitions and publications for his expertise in intellectual property, including most recently being named among the world's leading trademark professionals for the third time in the annual edition of the World Trademark Review 1000. In addition to his IP litigation background, Mr. Goins provides strategic advice in negotiating IP-related rights in multi-million dollar corporate deals and manages large-scale trademark

and copyright portfolio registrations. Mr. Goins is a frequent speaker and author on various topics regarding intellectual property, and since 2012 has lectured on copyright law, trademark law, entertainment law, and sports law as an Adjunct Professor at Atlanta's John Marshall Law School.

What Was the Underlying Dispute in *In Re Jackson*?

The facts underlying this five-year litigation battle are fairly straightforward. In December 2015, Jackson sued Roberts after Roberts recorded and made publicly available for free a remix version of Jackson's most popular song, "In Da Club." Released in 2003, In Da Club has been ranked as one of the "500 Greatest Songs of All Time" and one of the top 100 songs of that decade.

Roberts's remix version was one of 26 remixes included on his Renzel Remixes mixtape, in which Roberts performed his own lyrics over the original (the "master") recordings of popular songs by other well-known artists, including Adele and Snoop Dogg. Jackson's complaint alleged that Roberts's use of Jackson's voice in the song and stage name in the track's title violated Jackson's right of publicity under Connecticut common law.

In his initial complaint, Jackson also included claims of trademark infringement, false advertising, and dilution under the Lanham Act. After Roberts moved to dismiss, Jackson later dropped the trademark claims and amended the complaint to include only the right of publicity claim.

After years of extensive discovery, including depositions of both artists and each artist's damages experts, the US District Court for the District of Connecticut granted summary judgment in favor of Roberts. The court's decision was based on Jackson's having contractually surrendered or waived his right to license and approve his likeness associated with the master recording of In Da Club given that he had assigned this right to his record label by executing his recording artist agreement. The court rejected his right of publicity claim because he had contractually surrendered that right. In February 2019, Jackson appealed.

What did the Second Circuit Decide in *In re Jackson*?

The Second Circuit affirmed the lower court's grant of summary judgment in Roberts's favor but disagreed with the reasoning, instead determining that Jackson's right of publicity claim was preempted under the doctrine of implied preemption, or in the alternative, statutorily preempted under Section 301 of the Copyright Act (*In re Jackson*, 972 F.3d at 33).

Regarding implied preemption, the Second Circuit:

- Analyzed whether the state law claim furthers substantial state law interests that are distinct from the interests served by the federal law which may preempt the claim.
- Determined that Jackson's claim does not seek to vindicate any substantial state interests distinct from those furthered by the copyright law.
- Concluded that the policy considerations justifying the doctrine of implied preemption prevail and therefore Jackson's insubstantial claim of violation of his publicity is precluded.

(*In re Jackson*, 972 F.3d at 34-42.)

Regarding statutory preemption, the Second Circuit applies a two-part test to determine whether a state law claim is statutorily preempted under Section 301 (see *How Have Courts Determined Whether Right of Publicity Claims Based on Reproduction of Copyrighted Works are Preempted?*). The court ultimately concluded that Jackson's right of publicity claim was based on the reproduction of a copyrighted work embodying Jackson's voice. The claim was preempted by Section 301 because its focus was Roberts' use of a work falling within the subject matter of copyright and it asserted rights that were sufficiently equivalent to the rights protected by federal copyright law.

Does the Copyright Preemption Doctrine Bar Right of Publicity Claims?

Many courts have rejected copyright preemption defenses to right of publicity claims. This is because typically, the subject matter of a publicity claim is the unauthorized use of a plaintiff's name or likeness, which are not works of authorship within Section 102 of the Copyright Act. However, where the right of publicity claim is based only on a defendant's use of the plaintiff's name or likeness in a copyrighted work, some courts have found the claim preempted.

For more on copyright preemption, see [Practice Note, Copyright Preemption](#). For more on the legal framework for the right of publicity, see [Practice Note, Right of Publicity: Overview](#) and [Right of Publicity Laws: State Q&A Tool](#).

How Have Courts Determined Whether Right of Publicity Claims Based on Reproduction of Copyrighted Works are Preempted?

Courts generally apply a two-part test to determine whether a state law claim is preempted under Section 301 of the Copyright Act. The claim is preempted if both:

- The work at issue, which would be affected by the plaintiff's exercise of a state-created right, falls within the subject matter of copyright defined by Sections 102 and 103 of the Copyright Act (17 U.S.C. §§ 102, 103).
- The claimed right is equivalent to any of the exclusive rights identified in Section 106 of the Copyright Act (17 U.S.C. § 106). The Second Circuit refers to this prong as the "equivalence requirement" or the "general scope" requirement (*In re Jackson*, 972 F.3d at 42-43).

While Circuit courts have uniformly applied the two-part test to determine whether a state law claim is statutorily preempted under Section 301 of the Copyright Act, there is a developing split regarding whether there is a commercial use or advertising exception to the two-part test.

With its *In re Jackson* decision, the Second Circuit joins the Eighth and Ninth Circuits in applying the copyright preemption doctrine to bar right of publicity claims based solely on the reproduction of a copyrighted work. For example:

- The Eighth Circuit applied the copyright preemption doctrine to bar a professional wrestler's right of publicity claim based on ESPN's broadcast of wrestling matches depicting his performance where the claim was an "attempt to merely prevent rebroadcast of a copyrighted film" to which he did not own the rights (see *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1143-44 (8th Cir. 2015)).
- The Ninth Circuit applied copyright preemption to bar a right of publicity claim based on the use of Debra Laws's name and a sample of her song "Very Special" in Jennifer Lopez's hit song "All I Have" (see *Laws v. Sony Music Ent., Inc.*, 448 F.3d 1134, 1141 (9th Cir. 2006); see also, *Jules Jordan Video, Inc. v. 144942 Canada Inc.*, 617 F.3d 1146 (9th Cir. 2010) (holding that the Copyright Act preempted plaintiff's right of publicity claims against movie distributors that copied and sold without authorization copyrighted DVDs owned by the actor or his company and featuring the actor's performance)).

Conversely, the Third and Fifth Circuits have found, in limited circumstances, against applying the copyright preemption doctrine to right of publicity claims. Specifically:

- The Third Circuit found that copyright preemption did not bar a right of publicity claim where the NFL used a broadcaster's previously recorded voice within a later television advertisement for a video game (see *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1029 (3d Cir. 2008)).
- The Fifth Circuit concluded that copyright preemption did not bar the plaintiff's right of publicity claims because the right of publicity claims involved use of the musicians' vocal styles, which did not fall within the subject matter of copyright (see *Brown v. Ames*, 201 F.3d 654, 659-61 (5th Cir. 2000)).

Falling in the middle is the Seventh Circuit, which has ruled on both ends of the spectrum, holding that:

- The Copyright Act preempted baseball players' publicity rights in their performances in baseball games that were captured in recorded telecasts. Major league baseball clubs owned the copyright in the baseball games because the telecasts were fixed in a tangible form (see *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 674 (7th Cir. 1986)).
- The Copyright Act did not preempt a model's right of publicity claim against L'Oreal for using her photograph in advertising after the term of her authorization to the company expired, on the basis that an individual's identity could not be fixed in a tangible form and therefore could not satisfy the first condition of the test for preemption (see *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905 (7th Cir. 2005)).

The First, Fourth, and Tenth Circuits have yet to issue or rule on whether the copyright preemption doctrine bars a right of publicity claim. However, though not traditionally recognized as a copyright preemption case, the Tenth Circuit's decision in *Cardtoons, L.C. v. Major League Baseball Players Ass'n* may provide insight into whether the Tenth Circuit would apply the copyright preemption doctrine to right of publicity claims (95 F.3d 959, 962-64 (10th Cir. 1996)). In *Cardtoons*, the Tenth Circuit determined that a right of publicity claim based on the unauthorized use of certain baseball players' likeness on parody baseball cards established substantial state law interests unrelated to the exclusive rights of a copyright holder because the value of the works was based on the unauthorized exploitation of the players' valuable persona (see *Cardtoons*, 95 F.3d 959, 962-64).

The tension between right of publicity claims and copyright preemption will likely continue to be litigated in many circuits until the US Supreme Court weighs in.

How Have Courts Distinguished Right of Publicity Claims Involving Commercial or Advertising Uses?

Courts that have not applied copyright preemption to bar right of publicity claims have based their decisions largely on a "commercial use" exception. The Third and Seventh Circuits have acknowledged that there are claims involving certain uses, even if they are reproductions of copyrighted works, that should survive preemption if the uses are commercially exploitive of the plaintiff's persona. For example:

- The Third Circuit affirmed summary judgment in favor of a plaintiff on a right of publicity claim where the defendant used a thirteen-second sound recording of the plaintiff broadcaster's voice in a twenty-two minute television program promoting a video game (see *Facenda*, 542 F.3d 1007 at 1025-32).
- The Seventh Circuit reversed dismissal of a right of publicity claim where the defendant L'Oreal used the plaintiff model's likeness after her authorization of use expired in advertising for their commercial advantage (see *Toney*, 406 F.3d 905 at 910).

In the Second Circuit, Jackson's legal team asserted this same position, arguing that Roberts's remix version of In Da Club repeated a lyrical phrase ("Only on the Black Market, December 4th, The Album is out") six times that promoted his next commercially released album, and therefore, this constituted an exploitive use of Jackson's identity, bringing the claim outside the scope of copyright

preemption. However, the Second Circuit rejected this argument, noting that the pertinent distinction is whether the defendant's use of a work involves the plaintiff's identity, such as when:

- The plaintiff is identified in a manner that:
 - implies the plaintiff's endorsement, sponsorship, or approval; and
 - holds opinions favored by the defendant.
- The value of what the defendant distributes lies in its reference to the plaintiff's identity.

(*In re Jackson*, 972 F.3d at 48-49.)

In this case, the Second Circuit concluded that the crux of Jackson's right of publicity claim was not the use of his identity but rather the use of the copyrighted work itself, relying on the combination of:

- The absence of any apparent message of endorsement.
- The evidence that it is commonplace for hip-hop artists to sample each other's songs without permission.
- The large number of artists other than Jackson who Roberts similarly sampled and identified.

(*In re Jackson*, 972 F. 3d at 51-52.)

Are Performers Contractually Precluded from Bringing Right of Publicity Claims Because of Rights Surrendered in Typical Recording Agreements?

Performers must read the fine print of their agreements. Some recording artist agreements contractually transfer their name, image, and likeness only with respect to advertising of their contributions in limited mediums, or only for a limited duration.

Interestingly, Jackson's recording artist agreement actually required his approval for use of In Da Club or as a sample. Therefore, the court noted that Roberts's use of the sample was not only unauthorized by the rightsholder (here, Shady/Aftermath) but also was a use that Shady/Aftermath could not authorize without Jackson's approval. The court found by reason of the unauthorized sample, Roberts was presumably liable for copyright infringement to Shady/Aftermath but not to Jackson. Jackson may have a right to compel Shady/Aftermath to sue Roberts for copyright infringement or seek damages from Shady/Aftermath for its failure to protect Jackson's right to royalties by suing Roberts. However, Jackson possessed

no legal right to directly control Roberts's use of the song. (*In re Jackson*, 972 F.3d at 41.)

How Does the Second Circuit's decision in *In Re Jackson* Impact Music Licensing?

Apart from the preemption holding, the Second Circuit's opinion is also relevant because of how the court construed Jackson's assignment of his right of publicity.

Generally, performers assign to their record labels the right to use their names, images, and likenesses in connection with their contributions to master recordings. This is done to make it easier for the record labels to approve later licensing and marketing uses without the licensee having to otherwise obtain approval or seek a license from multiple varying different parties (see Bob Kohn, *KOHN ON MUSIC LICENSING* (4th ed. Aspen Law & Business 2010)). With this provision, seeking any approval for subsequent licensing directly from the performer of that master recording is typically unnecessary.

Although Jackson granted his recording label the perpetual and exclusive right to use his name and likeness to advertise and exploit the applicable recordings, the Second Circuit noted in dicta that this grant was exclusive only during the term of the recording agreement. Upon expiration of the term, Jackson recovered a shared interest in this right of publicity and therefore was not contractually precluded from bringing a right of publicity claim (the basis for the district court's conclusion that the right of publicity claim was barred). This finding is significant and could create a floodgate of litigation from many artists who may want to take this same position.

Many music licensing and entertainment industry experts will disagree with this contractual interpretation, as most recording artist agreements include a survival clause or provisions that survive the term.

How Can Music Licensees Minimize the Risk of Right of Publicity and Related Claims Involving the Unauthorized Use of an Individual's Identity?

Music licensees should:

- Continue to obtain approval from both the record label (as the copyright holder in the sound recording) and the publisher (as the copyright holder in the composition).

Expert Q&A on the Copyright Preemption and Right of Publicity Claims Conflict in Entertainment

- Evaluate the type of use intended so that the music licensee knows what type of license is needed (for example, synchronization license versus mechanical license).
- Consider when the performers' recording artist agreement or contractual assignment of their name, image, and likeness expires or terminates.
- Obtain as many approvals as possible before engaging in use of an individual's identity.

Some organizations have gone so far as to include indemnification clauses in applicable agreements

involving the use of music for potential claims of copyright infringement or right of publicity violations. In the music industry, obtaining approval and the licensing rights to the use of music will reduce any chance of a related claim or cause of action for right of publicity so long as the use is:

- Incorporated into the recording of the music itself.
- Not separately focused on commercial advertising that is unconnected to the performer's name, image, or likeness.

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