

Stop the Music: How 50 Cent and Rick Ross Joined the Narrative for Right of Publicity Preemption

Leah Guzick*

ABSTRACT

Right of publicity claims, governed by state law, protect against potential misappropriation of one's identity. Federal law, such as the Copyright Act of 1976, has the ability to both expressly and impliedly preempt state law. In August of 2020, the Second Circuit ended a five-year litigation battle between Curtis Jackson and William Roberts, better known as Rick Ross and 50 Cent, respectively. Jackson sued Roberts after Roberts recorded a remixed version of Jackson's hit, "In Da Club." Jackson, who held no copyright ownership of the song, claimed that Roberts infringed on his right of publicity with Roberts's remix. The Second Circuit affirmed the lower court's summary judgement ruling, stating that Section 301 of the Copyright Act preempted Jackson's right of publicity claim by using a test of both express and implied preemption.

With this decision, the Second Circuit joined the Eighth and Ninth Circuits in finding that the Copyright Act can preempt right of publicity claims, except when there is evidence of endorsement. Instead of only using express preemption—like the Eighth and Ninth Circuits—the Second Circuit went a step further in its analysis by also using implied preemption. This step is in direct opposition to the Third, Fifth, Seventh, and Tenth Circuits, which have found that under similar circumstances, the Copyright Act does not preempt a right of publicity claim.

This Comment addresses the circuit split regarding when to allow the Copyright Act to preempt a right of publicity claim. If this issue reaches the Supreme Court, this Comment recommends that the Court use the same tests and standards used by the Second Circuit in finding that the Copyright Act preempts right of publicity claims, apart from a fair finding of endorsement.

* J.D./M.B.A. Candidate, The Pennsylvania State University, Penn State Law and Smeal College of Business, 2024.

Table of Contents

I.	INTRODUCTION	874
II.	BACKGROUND	876
	A. <i>Baseline Legal Principals</i>	876
	1. Copyright Law	877
	2. Right of Publicity	879
	B. <i>Previous Circuit Decisions</i>	880
	1. Opposing Circuits Hold That Right of Publicity Should Not Be Preempted	880
	2. Agreeing Circuits Hold That Right of Publicity Should Be Preempted	884
	C. <i>Enter In re Jackson</i>	887
	1. Case Facts and Procedural History.....	887
	2. The Second Circuit’s Analysis.....	889
III.	ANALYSIS	892
	A. <i>Where the Third, Fifth, Seventh, and Tenth Circuits Falter</i>	892
	B. <i>Where the Eighth and Ninth Circuits Succeed</i>	894
	C. <i>The Positives of Courts Using Express and Implied Preemption in Their Analyses</i>	895
	D. <i>Recommendation</i>	895
IV.	CONCLUSION	896

I. INTRODUCTION

Mixtapes¹ are an essential medium of both past and present music culture.² The practice of making mixtapes goes back decades, originating in the 1970s as a way for artists to show their editing skills.³ The option remains today for both underground and A-list rappers to cheaply make their music available to fans by foregoing the industry standard of using a record label to produce music, which can give an artist more control over their work.⁴ This newly-created work, however, can have complicated legal implications.⁵ With a culture of building upon already-created materials, the creation of rap music frequently does not include

1. See *Mixtape*, MERRIAM-WEBSTER, <https://bit.ly/3H6jzze> (Feb. 16, 2023) (defining the term as “a compilation of songs recorded (as onto a cassette tape or a CD) from various sources”).

2. See Nakul Vagale, *Cracking the MIXTAPES Code*, I LOVE MUSIC ACADEMY (Dec. 13, 2018, 7:44 PM), <https://bit.ly/35hkzbit6k>.

3. See *id.*

4. See Skinny Friedman, *The Real Difference Between a Mixtape and an Album*, VICE (Dec. 10, 2013, 1:55 PM), <https://bit.ly/34arttM> (“Mixtapes move a rapper’s career forward, and they can do that without selling a single copy.”).

5. See *infra* Sections II.B–C.

permission from one artist to another in using the original piece.⁶ Additionally, more often than not, artists sign away the rights to their work to a record label to have their music produced and made publicly available.⁷ Legal issues manifest when an artist remixes the work of a secondary artist, and when the secondary artist lacks a legitimate copyright to the song.⁸

An example of these legal issues is outlined in the recent Second Circuit case *In re Jackson*, where hip-hop legends William Roberts and Curtis Jackson, otherwise known as Rick Ross and 50 Cent, respectively, litigated whether the Copyright Act of 1976 should overcome (or preempt) Jackson's right of publicity claim.⁹ The Second Circuit concluded that the Copyright Act of 1976 (the "Copyright Act") barred Jackson's claim.¹⁰ This holding aligns with the Eighth and Ninth Circuits, which have come to similar conclusions regarding when to preempt a right of publicity claim.¹¹ The Third, Fifth, Seventh, and Tenth Circuits found that in similar circumstances, a right of publicity claim should not be preempted, forming a circuit split.¹² The Second Circuit, along with the Eighth and Ninth, have the most logical reasoning in determining what should be preempted; the Second Circuit, however, uses more extensive tests, making its standard of review the test that each court should use if the issue reaches the Supreme Court.¹³

Part II of this Comment discusses the baseline legal concepts at issue in *In re Jackson*.¹⁴ Part II also explains the circuit split's dueling analyses and their nuances.¹⁵ Ultimately, Part III of this Comment recommends that the Supreme Court preempt right of publicity claims absent evidence of endorsement.¹⁶ Lastly, this Comment also

6. See, e.g., *In re Jackson*, 972 F.3d 25, 50 (2d Cir. 2020) ("Indeed, Jackson himself, as he admitted in his deposition, has used vocal and instrumental samples from other well-known artists, sometimes identifying them by name, in his own mixtapes without permission.").

7. See Elizabeth Vulaj, *Singing a Different Tune: Taylor Swift & Other Artists' Fight for Music Ownership*, PRACTITIONER INSIGHTS COMMENTARIES, Aug. 28, 2020, 2020 WL 5084965.

8. See *infra* Sections III.B–C.

9. See *Jackson*, 972 F.3d at 31.

10. See *id.*

11. See *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1144-45 (8th Cir. 2015); *Laws v. Sony Music Ent., Inc.*, 448 F.3d 1134, 1145-46 (9th Cir. 2006).

12. See *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1032-33 (3d Cir. 2008); *Brown v. Ames*, 201 F.3d 654, 663 (5th Cir. 2000); *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905, 911 (7th Cir. 2005); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996).

13. See *infra* Section III.C.

14. See *infra* Section II.A.

15. See *infra* Section II.B.

16. See *infra* Section III.D.

recommends that the Supreme Court adopt the doctrines of express and implied preemption, as the Second Circuit did.¹⁷

II. BACKGROUND

The Second Circuit addressed the circuit split issue of when to adopt the copyright preemption doctrine in barring a right of publicity claim.¹⁸ In the 2020 case *In re Jackson*, legendary hip-hop artists William Roberts and Curtis Jackson argued over whether Robert's remix of Jackson's smash hit, "In Da Club," could be subject to a right of publicity claim, or if federal copyright laws preempted such a claim.¹⁹ The Second Circuit joined the Eighth and Ninth Circuits in holding that federal copyright laws preempted such claims, contrary to the Third, Fifth, Seventh, and Tenth Circuits' findings of circumstances against applying the preemption doctrine.²⁰ The Ninth and Third Circuits have the most in-depth reasoning in their opinions and thus offer the most support for each side of the argument.²¹ The other circuits' views on preemption rely on more nuanced reasoning for agreeing or disagreeing with preemption, but are nevertheless important to explain the logic behind each side of the split.²²

A. *Baseline Legal Principals*

To understand the claims brought forth in *In re Jackson*, as well as the current circuit split, it is important to consider a brief overview of the relevant laws at issue in these cases. The relevant laws at issue include those that determine when the Copyright Act of 1976 should or should not preempt the right of publicity.²³ Both sides of the circuit split use similar tests, but different standards, to determine preemption, applying the doctrines of express and implied preemption.²⁴

17. See *infra* Sections III.C–D.

18. See *In re Jackson*, 972 F.3d 25, 30 (2d Cir. 2020).

19. See *id.*

20. See Jonathan Goins, *Second Circuit Sets Precedent in 50 Cent Right of Publicity Case*, BLOOMBERG L. (Oct. 16, 2020, 4:00 AM), <https://bit.ly/3vhU89F>.

21. See *Laws v. Sony Music Ent., Inc.*, 448 F.3d 1134, 1137–46 (9th Cir. 2006); *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1025–33 (3d Cir. 2008).

22. See *Brown v. Ames*, 201 F.3d 654, 657–62 (5th Cir. 2000); *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905, 907–11 (7th Cir. 2005); *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 973–77 (10th Cir. 1996); *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1142–45 (8th Cir. 2015).

23. See *infra* Section II.A.1.

24. See *infra* Section II.A.2.

1. Copyright Law

Federal copyright law's authority comes from the United States Constitution's goal of "promot[ing] the Progress of Science and useful Arts."²⁵ Civil-law countries—countries that rely on codified statutes for law²⁶—find a statutory purpose of copyright law in "authors' rights," believing that artists should receive recognition as a reward for their labor.²⁷ In contrast, the United States, a common-law country, finds cause for copyright law based on interest in creating a public benefit.²⁸ Copyright law encourages authors and creators to produce works for the benefit of the public in exchange for promising a level of protection that prevents unwanted copying of those works.²⁹ Predominately, the copyright laws of the United States seek to secure an economic benefit, and legal protection is needed for the public to enjoy intangible goods brought to the market.³⁰

The Copyright Act made several important changes to the landscape of copyright law.³¹ Previous legislation, such as the Copyright Act of 1909,³² required publication for a work to receive copyright protections, which narrowed the scope of federal copyright law.³³ For example, under the 1909 Act, an unpublished book received no copyright protections.³⁴ Section 102(a) of the Copyright Act states that copyright protection is available "in original works of authorship fixed in any tangible medium of expression," expanding the protection of copyrighted materials beyond just published works to include anything "fixed."³⁵ The Copyright Act categorizes works of authorship under eight categories, including literary works, musical works, and sound recordings.³⁶

Because copyright law is governed by federal statute, tension may arise between differing state and federal laws.³⁷ The Constitution's Supremacy Clause resolves these conflicts by stating that federal law takes precedence over state law, as the Constitution serves as the "supreme [l]aw of the [l]and."³⁸ This concept, known as "preemption,"

25. U.S. CONST. art. I, § 8, cl. 8.

26. See *Civil Law*, CORNELL L. SCH., <http://bit.ly/3Iqv9Ig> (last visited Feb. 22, 2023).

27. See CRAIG JOYCE ET AL., COPYRIGHT LAW 4 (11th ed. 2020).

28. See *id.* at 4.

29. See *id.*

30. See *id.* at 45.

31. See *id.* at 22.

32. See Copyright Act of 1909, Pub. L. No. 60-349, 35 Stat. 1075 (repealed 1976).

33. See JOYCE, *supra* note 27, at 22.

34. See *id.*

35. 17 U.S.C. § 102(a).

36. See *id.*

37. See, e.g., *Kurns v. R.R. Friction Prod. Corp.*, 565 U.S. 625, 630-32 (2012).

38. U.S. CONST. art. VI, cl. 2.

holds that “state laws that conflict with federal laws are ‘without effect.’”³⁹ The Supreme Court has continuously held that Congress can both expressly and impliedly preempt state law.⁴⁰

The Copyright Act provides terms of express preemption under Section 301(a).⁴¹ Section 301(a) states:

On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, 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.⁴²

Section 301(a) created a two-step test to determine whether a work is expressly preempted by the Copyright Act. First, does the work fall within the subject matter of copyright?⁴³ If it does, then is the legal or equitable right equivalent to any of the exclusive rights within the general scope of copyright?⁴⁴ In other words, as a federal law, copyright law preempts state law when the work can be protected by federal law in terms of its subject matter, defined in the Copyright Act, and when state laws grant rights equivalent to those protected in the Copyright Act.⁴⁵

In addition to statutory express preemption, the Supreme Court has found instances where claims can be impliedly preempted.⁴⁶ Implied preemption will bar a state law claim if, “under the circumstances of a particular case, the challenged state law stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.”⁴⁷ Implied preemption appears in two forms: field and conflict preemption.⁴⁸ Field preemption occurs where “Congress intends federal

39. *Altria Grp., Inc. v. Good*, 555 U.S. 70, 76 (2008) (citing *Maryland v. Louisiana*, 451 U.S. 725, 746 (1981)).

40. *See Gade v. Nat’l Solid Wastes Mgmt. Ass’n*, 505 U.S. 88, 98 (1992) (citing *Jones v. Rath Packing Co.*, 430 U.S. 519, 525 (1977)).

41. *See* 17 U.S.C. § 301(a).

42. *Id.*

43. *See id.*

44. *See id.*

45. *See* James M. Chadwick & Roxana Vatanparast, *The Copyright Act’s Preemption of Right of Publicity Claims*, *COMM’NS LAW.*, July 2008, at 3, 5.

46. *See Crosby v. Nat’l Foreign Trade Council*, 530 U.S. 363, 373 (2000).

47. *Id.* (alterations omitted).

48. *See* Guy A. Rub, *A Less-Formalistic Copyright Preemption*, 24 *J. INTEL. PROP. L.* 329, 334 (2017).

law to ‘occupy the field.’”⁴⁹ Conflict preemption arises where a state law conflicts with a federal statute.⁵⁰ Federal circuit courts have not uniformly enforced either express or implied preemption tests.⁵¹ How to interpret these concepts of copyright law and the right of publicity is at issue in the circuit split.⁵²

2. Right of Publicity

Federal law does not govern the right of publicity, as the right originated in the state law right of privacy.⁵³ Over 30 states recognize a right to publicity either at common law or by statute.⁵⁴ Liability falls on “[o]ne who appropriates to his own use or benefit the name or likeness of another.”⁵⁵ State laws vary as to the actual protection of an individual’s right of publicity, but generally, the right “protects an individual against commercial loss resulting from misappropriation of his or her identity for a commercial purpose.”⁵⁶ For example, this right allows individuals to control how and why their likeness is used in connection with an endorsement of a product.⁵⁷

State courts began justifying right of publicity law through the common law right of privacy.⁵⁸ First recognized judicially in 1953, the Second Circuit separated the right of privacy from the right of publicity.⁵⁹ The court found a separation between privacy, which protects against preventing well-known persons from having “their feelings bruised” from publications without their consent, and the right of publicity, which gives a celebrity the right to control their likeness in business.⁶⁰ The right of publicity was asserted in recent cases in the Second, Third, Fifth, Seventh, Eighth, Ninth, and Tenth Circuits, with

49. *Id.*; *Crosby*, 530 U.S. at 372 (quoting *California v. ARC Am. Corp.*, 490 U.S. 93, 100 (1989)).

50. *See Rub*, *supra* note 48, at 334; *Crosby*, 530 U.S. at 372.

51. *See infra* Section III.A.

52. *See infra* Section II.B.

53. *See* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:2 (5th ed. 2021).

54. *See* J. THOMAS MCCARTHY AND ROGER E. SCHECHTER, RIGHTS OF PUBLICITY AND PRIVACY § 1:2 (2d ed. 2021).

55. RESTATEMENT (SECOND) OF TORTS § 652C (AM. L. INST. 1977).

56. CHRISTOPHER M. TUROSKI, INTELLECTUAL PROPERTY IN MERGERS AND ACQUISITIONS § 3:48 (2021).

57. *See id.*

58. *See* LYDIA PALLAS LOREN & JOSEPH SCOTT MILLER, INTELLECTUAL PROPERTY LAW: CASES & MATERIALS 882 (4th ed. 2015).

59. *See Haelan Lab’ys, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953).

60. *Id.*

the courts debating whether the claims were preempted by federal copyright laws.⁶¹

B. *Previous Circuit Decisions*

A circuit split exists regarding when to adopt the copyright preemption doctrine as a bar against right of publicity claims.⁶² The Third, Fifth, Seventh, and Tenth Circuits (“Opposing Circuits”) have all found circumstances against applying the preemption doctrine, arguing for a more restricted view of what should pass the preemption tests, with the Third Circuit having the most in-depth reasoning.⁶³ However, the Eighth, Ninth, and Second Circuits (“Agreeing Circuits”) have each found circumstances under which the right of publicity is expressly or impliedly preempted by federal copyright law, with the Ninth Circuit having the most in-depth reasoning.⁶⁴ The split between the Opposing and Agreeing Circuits does not come from the tests they use—each circuit uses the same tests of express and implied preemption.⁶⁵ Instead, the split comes from how the test is implemented; the Agreeing Circuits separate an identity from economic benefit unless there is clear evidence of endorsement, while the Opposing Circuits combine the two ideas.⁶⁶

1. Opposing Circuits Hold That Right of Publicity Should Not Be Preempted

The Opposing Circuits argue against applying the copyright preemption doctrine to right of publicity claims.⁶⁷ The Third Circuit is the most aggressive in its arguments, expressly opposing the arguments put forth by the Agreeing Circuits.⁶⁸ The Fifth, Seventh, and Tenth Circuits use a more nuanced application as each circuit finds support primarily in advertisement contexts.⁶⁹

61. See *infra* Sections II.B–C.

62. See Goins, *supra* note 20.

63. See *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1032-33 (3d Cir. 2008); *Brown v. Ames*, 201 F.3d 654, 663 (5th Cir. 2000); *Toney v. L’Oreal USA, Inc.*, 406 F.3d 905, 911 (7th Cir. 2005); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 976 (10th Cir. 1996).

64. See *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1144-45 (8th Cir. 2015); *Laws v. Sony Music Ent., Inc.*, 448 F.3d 1134, 1145-46 (9th Cir. 2006); *In re Jackson*, 972 F.3d 25, 55 (2d Cir. 2020).

65. See *infra* Sections II.B.1–2.

66. See *infra* Sections II.B.1–2.

67. See Goins, *supra* note 20.

68. See *Facenda*, 542 F.3d at 1025-33.

69. See *Brown v. Ames*, 201 F.3d 654, 657-62 (5th Cir. 2000); *Toney v. L’Oreal USA, Inc.*, 406 F.3d 905, 907-11 (7th Cir. 2005); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 973-77 (10th Cir. 1996).

In *Facenda v. N.F.L. Films, Inc.*, the Third Circuit found that federal copyright law did not preempt an NFL announcer's state statutory right of publicity claim to his voice.⁷⁰ John Facenda, an NFL broadcasting legend, voiced many productions of NFL Films, such as highlights and background music, before his death in 1984.⁷¹ In 2006, NFL Films, which owned the copyright of these voice recordings, used portions of his voice-over work in a cable-television production about the videogame "Madden NFL 06."⁷² Facenda's estate sued, alleging that the program included an unauthorized use of his name or likeness in violation of Pennsylvania's right of publicity statute.⁷³ The court held that NFL Films' valid copyright in Facenda's voice did not preempt Facenda's right of publicity claim.⁷⁴ The court explained that the two prongs of express preemption, as detailed in Section 301(1) of the Copyright Act, were not satisfied.⁷⁵

Addressing the first prong of express preemption, copyrightable subject matter, the court explained that Facenda's "distinctive" voice could not be copyrightable because it was not fixed in a tangible medium of expression as defined by the Copyright Act.⁷⁶ The court stated that "[o]ne can fix Facenda's voice in a tangible medium by recording it, but one cannot divorce his distinctive voice itself from the Facenda identity."⁷⁷

Regarding the second prong of express preemption, an equivalent right to the Copyright Act, the court noted that the Pennsylvania right of publicity statute requires a showing of commercial value, which creates an "extra element" not included in the Copyright Act.⁷⁸ The court further explained that the commercial value of the NFL announcer's voice satisfied the additional element beyond the scope of what a copyright infringement case required.⁷⁹ Thus, the court determined that a voice did not fall under the subject matter of copyright and did not satisfy the second prong of an equivalent right.⁸⁰ Because both prongs were not met,

70. *See Facenda*, 542 F.3d at 1027–28.

71. *See id.* at 1011.

72. *See id.*

73. *See id.*

74. *See id.* at 1026 ("In effect, it was 'sampling' itself, making a collage, taking a small piece of an old work and using it in a new work—as when a hip-hop group samples the drum part from James Brown's 'Funky Drummer.'").

75. *See id.* at 1026–28.

76. *See id.* at 1027; *supra* Section II.A.1.

77. *Facenda*, 542 F.3d at 1027.

78. *Id.*

79. *See id.*

80. *See id.* at 1027–28.

the court concluded that Section 301(a) of the Copyright Act did not bar Facenda's right of publicity claim.⁸¹

In addition to express preemption, the court also considered implied preemption, specifically, conflict preemption.⁸² The court held that, so long as a state law is not construed too broadly, the state law protection of an individual's voice will not upset copyright law's balance.⁸³ The court found that Pennsylvania's state right of publicity law was focused "solely on the commercial-advertising context," which did not conflict with the federal Copyright Act.⁸⁴ Therefore, the court found no implied preemption.⁸⁵ The Third Circuit gave the most in-depth reasoning, creating the core of the circuit split; the Fifth, Seventh, and Tenth Circuits reached the same conclusion, but with more nuanced reasoning.⁸⁶

The Fifth Circuit, in *Brown v. Ames*, came to a similar conclusion, holding that an identity was separate from a fixed medium of expression.⁸⁷ In *Brown*, several musicians sued Collectibles, a record label, and Ames, a producer, claiming misappropriation of their names and likenesses in marketing CDs and audiocassettes after Ames licensed master recordings of the musicians to Collectibles.⁸⁸ Similar to the Third Circuit, the court analyzed both express and implied preemption.⁸⁹

The court held that "the tort of misappropriation of name or likeness protects a person's *persona*. A *persona* does not fall within the subject matter of copyright—it does not consist of 'a "writing" of an "author" within the meaning of the Copyright Clause of the Constitution.'"⁹⁰ Because a *persona* is not considered to be copyrightable subject matter, it failed the Copyright Act's two-prong test, and was not expressly preempted.⁹¹ The court stated that right of publicity claims, in terms of implied preemption, benefit the major objective of the Copyright Act, so the claims do not undermine federal law.⁹² In sum, the court found both express and implied preemption to be inapplicable to the right of publicity claim.⁹³

81. *See id.* at 1028.

82. *See id.*

83. *See id.* at 1032.

84. *Id.*

85. *See id.*

86. *See infra* Sections III.A–B.

87. *See Brown v. Ames*, 201 F.3d 654, 658 (5th Cir. 2000).

88. *See id.* at 656.

89. *See id.* at 657–62.

90. *Id.* at 658 (quoting MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.01[B][1][C] (1999)).

91. *See id.* at 659.

92. *See id.*

93. *See id.* at 661.

The Seventh Circuit, in *Toney v. L'Oreal USA, Inc.*, concluded that no “work of authorship” existed when a cosmetics company used a model’s likeness in connection with a beauty product, and that a right of publicity claim was not expressly preempted by federal copyright law.⁹⁴ Toney, a model, authorized the use of her likeness on a hair product’s packaging for one year, but sued L’Oreal, claiming that the company used her likeness beyond the authorized time.⁹⁵ Toney asserted that L’Oreal violated her right of publicity as protected by Illinois statutory law.⁹⁶

The court held that Toney’s likeness was not copyrightable even though it was captured in a copyrightable photograph.⁹⁷ Therefore, her claim was not preempted by federal copyright law, as it failed the first prong of copyrightable subject matter under the Copyright Act.⁹⁸ Though the model’s photos were copyrightable material, “the fact that an image of the person might be fixed in a copyrightable photograph does not change [the holding].”⁹⁹ The court then moved to the second prong, equivalent rights, and determined that federal copyright laws do not apply to identity claims such as Toney’s.¹⁰⁰ Thus, Toney’s claim failed the second prong.¹⁰¹ Therefore, the court decided that the claim failed both prongs of the express preemption doctrine.¹⁰²

Additionally, the court explained that Illinois’s Right of Publicity Act allows a person to control the commercial value of their identity.¹⁰³ The court further reasoned that L’Oreal’s use of the photograph “stripped Toney of her right to control the commercial value of her identity,” and further distinguished a right of publicity claim from a copyright claim under the statute.¹⁰⁴ The Tenth Circuit further discusses the idea of economic benefits.¹⁰⁵

In *Cardtoons, L.C. v. Major League Baseball Players Association*, a trading card company, Cardtoons, created parody baseball cards that ridiculed famous Major League Baseball players.¹⁰⁶ Cardtoons sought a declaratory judgement against the Major League Baseball Players

94. See *Toney v. L'Oreal USA, Inc.*, 406 F.3d 905, 910 (7th Cir. 2005).

95. See *id.* at 907.

96. See *id.*

97. See *id.* at 909-10.

98. See *id.*

99. *Id.* at 910.

100. See *id.*

101. See *id.*

102. See *id.*

103. See *id.*

104. *Toney*, 406 F.3d at 910.

105. See *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 973-76 (10th Cir. 1996).

106. See *id.* at 962.

Association (“MLBPA”) in the Tenth Circuit, claiming that the cards did not violate the publicity or other property rights of the MLBPA’s members.¹⁰⁷

The Tenth Circuit explained that the principal purpose of the right to publicity is to induce people to hone talents necessary for public recognition.¹⁰⁸ The court found that the trading card company chose the player’s likenesses because of the “wide market appeal,” thus creating an economic benefit to the trading card company.¹⁰⁹ Both the Seventh and Tenth Circuit focused heavily on the economic benefits taken away from those asserting right of publicity claims, but the Tenth Circuit offers a different perspective into the reasoning behind a state law claim.¹¹⁰

The Opposing Circuits all concluded that an identity is not copyrightable, specifically where profit is involved with the opposing party.¹¹¹ When a party was benefiting from the identity of another within the copyrighted work, the courts found that this was enough to separate the two ideas.¹¹² This argument contradicts the Agreeing Circuits, which do not separate an identity from its copyrighted work under similar circumstances.¹¹³

2. Agreeing Circuits Hold That Right of Publicity Should Be Preempted

The Eighth and Ninth Circuits, with the Second Circuit joining in 2020, argue that federal copyright law should preempt right of publicity claims, even though the copyrighted work produced a profit, except in circumstances of endorsement.¹¹⁴ The Ninth Circuit offers the most in-depth reasoning (which the Eighth Circuit cites¹¹⁵), creating the core of the circuit split.¹¹⁶

In *Laws v. Sony Music Entertainment, Inc.*, the Ninth Circuit held that a singer’s publicity claim was preempted by federal copyright laws after the singer sued her record label for misappropriating her voice in a song.¹¹⁷ Debra Laws, a singer, sued Sony Music Entertainment for

107. *See id.* at 964.

108. *See id.* at 973.

109. *Id.* at 968.

110. *See id.*; *Toney v. L’Oreal USA, Inc.*, 406 F.3d 905, 910 (7th Cir. 2005).

111. *See Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1032-33 (3d Cir. 2008); *Brown v. Ames*, 201 F.3d 654, 663 (5th Cir. 2000); *Toney*, 406 F.3d at 911; *Cardtoons*, 95 F.3d at 976.

112. *See Facenda*, 542 F.3d at 1032-33; *Brown*, 201 F.3d at 663; *Toney*, 406 F.3d at 911; *Cardtoons*, 95 F.3d at 976.

113. *See infra* Section II.B.2.

114. *See* Goins, *supra* note 20.

115. *See Ray v. ESPN, Inc.*, 783 F.3d 1140, 1143 (8th Cir. 2015).

116. *See Laws v. Sony Music Ent., Inc.*, 448 F.3d 1134, 1137-46 (9th Cir. 2006).

117. *See id.* at 1145.

misappropriating her voice and name in the song “All I Have” by Jennifer Lopez and L.L. Cool J.¹¹⁸ Laws entered into a recording agreement with Elektra/Asylum Records (“Elektra”), giving Elektra the exclusive right to copyright the official, original recordings of her songs, also known in the music industry as master recordings.¹¹⁹ Later, Elektra’s agent entered into an agreement with Sony to use a sample of Laws’s song “Very Special” in the song “All I Have.”¹²⁰ Laws alleged a claim of misappropriation of her name and likeness for a commercial purpose under California statutory law.¹²¹

Laws argued that her likeness in the song did not fall within the subject matter of copyright because her likeness substantially differed from Sony’s copyrights to her music.¹²² Using the two-prong test of copyrightable subject matter and equivalent rights, the Ninth Circuit rejected this argument, determining that Laws’s voice was “contained within a copyrighted medium,” thus passing the subject matter requirement.¹²³ Laws’s copyrighted voice was only used in the manner negotiated by Elektra and Sony—no evidence existed to show that Laws’s voice was used in any way to promote the materials.¹²⁴ This distinction kept the claim within the realm of the copyrightable subject matter, as opposed to a right of publicity claim.¹²⁵ The court additionally found that the state claim concerned an equivalent right stated in the Copyright Act—the reproduction of the copyrighted work—thus passing the second requirement.¹²⁶ The Ninth Circuit did not address implied preemption in its reasoning.¹²⁷

In addition to analyzing preemption, the court also addressed an issue facing creators today, also highlighted with *In re Jackson*, in which many artists sign away the rights to their music to a larger record label.¹²⁸ The court reasoned that “[i]f Laws wished to retain control of her performance, she should (and may) have either retained the copyright or contracted with the copyright holder, Elektra, to give her control over its licensing. In any event, her remedy, if any, lies in an action against Elektra, not Sony.”¹²⁹ An artist’s control over their work against a larger

118. *See id.* at 1135.

119. *See id.* at 1136.

120. *See id.*

121. *See id.*

122. *See id.* at 1139.

123. *Id.* at 1141.

124. *See id.* at 1142.

125. *See id.*

126. *See Laws*, 448 F.3d at 1144.

127. *See id.* at 1145.

128. *See infra* Section II.C.1.

129. *Laws*, 448 F.3d at 1145.

company or label to which they assign copyrights is an ongoing battle that many creators face.¹³⁰

The Eight Circuit, in *Ray v. ESPN, Inc.*, considered whether reruns of a former professional wrestler infringed his right to publicity.¹³¹ Steve “Wild Thing” Ray filed sued the Entertainment and Sports Programming Network (ESPN) for re-telecasting his wrestling performances.¹³² Ray claimed that ESPN failed to obtain his consent to use his image and likeness for the reruns.¹³³ The court held that wrestling performances fall within the subject matter of copyright, and that the relevant right-of-publicity state law at issue offered a right equivalent to the general scope of copyright law, thus satisfying express preemption’s two prongs.¹³⁴

In terms of the first prong, Ray argued that his likeness, as opposed to the actual copyrighted film, was the “focal point” of the case, but the court rejected this argument.¹³⁵ The court reasoned that Ray’s “likenesses could not be detached from the copyrighted performances that were contained in the films.”¹³⁶ The court explained that the film, which was a copyrightable dramatic performance, captured Ray’s likeness, and thus fell within the subject matter of copyright.¹³⁷ Because Ray’s likeness could not be separated from the work, the claim passed the subject matter requirement prong by falling within the subject matter of the Copyright Act.¹³⁸ The court found that his rights equaled those within the general scope of copyright law, satisfying the second prong, because the reproduced work infringed Ray’s state-law rights.¹³⁹ Therefore, the court held that federal copyright law expressly preempted Ray’s claim.¹⁴⁰ Similar to the Ninth Circuit, the Eight Circuit did not consider implied preemption in its reasoning.¹⁴¹

The Eighth and Ninth Circuits each held that the Copyright Act expressly preempted a right of publicity claim, primarily because a person’s likeness or image could not be separated from the copyrighted

130. See Goins, *supra* note 20.

131. See *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1141-42 (8th Cir. 2015).

132. See *id.*

133. See *id.*

134. See *id.* at 1142, 1144-45.

135. *Id.* at 1143.

136. *Id.* at 1144.

137. See *id.*

138. See *id.*

139. See *id.*

140. See *id.* at 1144-45.

141. See *Ray*, 783 F.3d at 1144.

form in which it was fixed.¹⁴² The Second Circuit reached the same conclusion in *In re Jackson*.¹⁴³

C. Enter *In re Jackson*

In re Jackson is the most recent decision to address the issues of copyright preemption as they relate to right of publicity claims.¹⁴⁴ In this case, two massive figures in hip-hop argued over whether using a sample¹⁴⁵ is grounds for a valid right of publicity claim.¹⁴⁶ The court sided with the Eighth and Ninth Circuits, holding that the Copyright Act preempted the right of publicity claim.¹⁴⁷

1. Case Facts and Procedural History

In 2003, Curtis James Jackson III, better known as 50 Cent, released his debut rap album *Get Rich or Die Tryin'*.¹⁴⁸ The album achieved massive critical success, and peaked at number one on the *Billboard 200*, a ranking of the most popular albums of the week in the United States based on album sales.¹⁴⁹ The album spent 112 weeks on the chart¹⁵⁰ and became the best-selling album of 2003 in the United States.¹⁵¹ Several of the album's singles peaked at number one on the *Billboard Hot 100*, including the song "In Da Club."¹⁵² The *Billboard Hot 100*, similar to the *Billboard 200*, is a weekly record chart that ranks individual songs.¹⁵³

Jackson recorded "In Da Club" through his record label, Shady Records/Aftermath Records ("Shady/Aftermath"), and, pursuant to the Recording Agreement, Jackson did not own the copyright in the song.¹⁵⁴ Jackson gave Shady/Aftermath the non-exclusive right to use his name and likeness for trade and advertising, and, in return, Shady/Aftermath agreed to refrain from licensing the recordings for both commercial use

142. See *id.* at 1144–45; *Laws v. Sony Music Ent., Inc.*, 448 F.3d 1134, 1145–46 (9th Cir. 2006).

143. See *In re Jackson*, 972 F.3d 25, 55 (2d Cir. 2020).

144. See *id.* at 31.

145. See *infra* Section II.C.1.

146. See *Jackson*, 972 F.3d at 31.

147. See *id.*

148. See *id.*

149. See *50 Cent Chart History – Billboard 200*, BILLBOARD, <http://bit.ly/3DfyVCq> (last visited Jan. 25, 2022). For information about the Billboard 200 album chart, see *Billboard Finalizes Changes to How Streams Are Weighted for Billboard Hot 100 & Billboard 200*, BILLBOARD (May 1, 2018), <https://bit.ly/3Dgs1e6>.

150. See *50 Cent Chart History – Billboard 200*, *supra* note 149.

151. See *Year-End Charts Billboard 200 Albums*, BILLBOARD, <https://bit.ly/3v4ziKP> (last visited Oct. 11, 2021).

152. See *50 Cent Chart History – Billboard 200*, *supra* note 149.

153. See *id.*

154. See *In re Jackson*, 972 F.3d 25, 31 (2d Cir. 2020).

and for use as a sample without Jackson's consent.¹⁵⁵ The terms of the Recording Agreement expired in 2014.¹⁵⁶

In November 2015, William Leonard Roberts II, also known as Rick Ross, released a mixtape called *Renzel Remixes* that contained 26 remixes with new lyrics over popular songs.¹⁵⁷ A mixtape is "an album of material generally produced by a recording artist for free distribution to fans."¹⁵⁸ Roberts listed the original performer on the track list as a "feature."¹⁵⁹ The mixtape included, "for example, 'Hello (Feat. Adele),' 'Bill Gates (Feat. Lil Wayne),' and 'In Da Club (Ft. 50 Cent).'"¹⁶⁰ The "In Da Club (Ft. 50 Cent)" remix included Roberts rapping over the instrumental portion of the song in addition to Jackson's original 30-second refrain.¹⁶¹ Roberts did not obtain permission from Shady/Aftermath or Jackson to use Jackson's sample, the original refrain, or Jackson's stage name.¹⁶² But in hip-hop, it is common for artists to create mixtapes that include samples of other artists' works without first obtaining permission.¹⁶³

A sample is a common device used throughout the music industry.¹⁶⁴ A sample is a portion of a pre-existing sound recording, such as the musical backtrack or a lyrical verse, that is placed into another sound recording.¹⁶⁵ This technique originated in hip-hop and became a large part of how modern artists create music.¹⁶⁶ A remix, by contrast, is "a variant of an original recording (as of a song) made by rearranging or adding to the original."¹⁶⁷ Thus, a remix is a variation of an existing piece of work, and a sample is a portion of a sound recording that has been lifted and placed into another sound recording.¹⁶⁸

Jackson sued Roberts in 2015, claiming that Roberts's unauthorized use of his voice and stage name violated his right of publicity under Connecticut common law.¹⁶⁹ Each party moved for summary

155. *See id.*

156. *See id.*

157. *See id.*

158. *Id.*

159. *See id.*

160. *Id.*

161. *See id.* at 31–32.

162. *See id.* at 32.

163. *See id.* at 31.

164. *See Sampling: Its Role in Hip Hop and Its Legacy in Music Production Today*, ABBEY ROAD INST. (Oct. 19, 2020), <https://bit.ly/3wTMC5I>.

165. *See id.*

166. *See Steinski Gives a Sampling History Lesson*, NAT'L PUB. RADIO (Oct. 22, 2008, 5:50 AM), <https://n.pr/30zUZHh>.

167. *Remix*, MERRIAM-WEBSTER, <https://bit.ly/3np43YD> (Feb. 6, 2023).

168. *See id.*; Steinski, *supra* note 166.

169. *See In re Jackson*, 972 F.3d 25, 32 (2d Cir. 2020).

judgment.¹⁷⁰ Roberts argued that “his use was protected by the First Amendment, that Jackson’s claim was preempted by the Copyright Act, and that Jackson had no publicity rights associated with ‘In Da Club,’ [because he] transferred them to Shady/Aftermath in the Recording Agreement.”¹⁷¹

The district court granted Roberts’s motion for summary judgement in 2018, explaining that Jackson surrendered his rights to his name, likeness, and performance in association with “In Da Club,” and that federal copyright law preempted his right of publicity claim because he could not assert a tort action based on rights he contractually surrendered.¹⁷² Jackson then appealed to the Second Circuit.¹⁷³

2. The Second Circuit’s Analysis

The Second Circuit affirmed the district court’s decision, albeit with different reasoning.¹⁷⁴ The court expressly disagreed with the district court’s dismissal of the claim based on the reasoning that Jackson contractually surrendered his rights.¹⁷⁵ Because the Recording Agreement expired in 2014, the court explained that “Jackson recovered a shared interest in his right of publicity and [was] not contractually precluded from bringing this right of publicity claim.”¹⁷⁶ Instead, the court relied on a test for both implied and express preemption.¹⁷⁷ By using both forms of preemption in its test, the court took its analysis one step further than the Eighth and Ninth Circuits, which only analyzed the publicity claims by means of express preemption.¹⁷⁸

The Second Circuit analyzed express preemption to determine whether Section 301 of the Copyright Act preempted Jackson’s right to publicity claim.¹⁷⁹ The court reiterated the two-prong test defined by Section 301(a) of the Copyright Act—the subject matter requirement and the equivalent/general scope requirement—to determine preemption of the claim.¹⁸⁰ For the subject matter requirement, the court rejected Jackson’s claim that the sound of his voice cannot be copyrighted.¹⁸¹ The

170. *See id.*

171. *Id.*

172. *See id.* at 33.

173. *See id.*

174. *See id.*

175. *See id.*

176. *Id.*

177. *See id.* at 33–52.

178. *See id.*; *see also* *Laws v. Sony Music Ent., Inc.*, 448 F.3d 1134, 1145 (9th Cir. 2006); *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1141–42 (8th Cir. 2015).

179. *See Jackson*, 972 F.3d at 42.

180. *See id.* at 42–43 (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 200 (2d Cir. 1983)).

181. *See id.* at 45–46.

court explained that the copyrighted music and sound composition embedding Jackson's voice constituted the subject matter.¹⁸²

Like the Eighth and Ninth Circuits, the Second Circuit highlighted the importance of endorsement within the context of the sample in determining whether Jackson's claim fell into the subject matter of copyright.¹⁸³ The court explained that the sample contained no implication of the relevant audience of Jackson's endorsement nor sponsorship of Roberts's work.¹⁸⁴ More simply, an audience would not believe that Jackson was promoting Roberts's song by being part of it.¹⁸⁵ The court reasoned that the commonality of sampling other hip-hop artists' work without permission, which Jackson was also known to do, displayed no implication of endorsement, as it was standard practice in the field.¹⁸⁶ Additionally, factors such as the previous popularity of the song, as well as the large number of other artists sampled in *Renzel Remixes*, supported the court's determination that a relevant audience would not suspect that Jackson endorsed Roberts's work.¹⁸⁷ The court stated that "when a defendant exhibits an image or representation of the plaintiff embodied in a copyrighted work in a manner that appears to communicate a message that the plaintiff endorses the defendant's service or product . . . courts have generally found that such a claim is not preempted."¹⁸⁸ Because the court found no evidence of endorsement, Jackson's claim fell within the realm of the copyrighted work and passed the first prong of the express preemption test.¹⁸⁹

For the second prong of equivalence, or general scope requirement, the Second Circuit rejected the district court's assertion that Connecticut's right of publicity statute requires that a defendant's use be commercial in nature.¹⁹⁰ Instead, the court reasoned that Jackson's claim was "'virtually synonymous [with a claim for] wrongful copying' and [was] 'in no meaningful fashion distinguishable from infringement of a copyright.'"¹⁹¹ Therefore, it passed the second prong of an equivalent right.¹⁹² The court ultimately held that section 301 expressly preempted Jackson's claim because Roberts's use of Jackson's sample within the

182. *See id.*

183. *See id.* at 51–52.

184. *See id.*

185. *See id.*

186. *See id.*

187. *See id.*

188. *Jackson*, 972 F.3d at 47.

189. *See id.*

190. *See id.* at 52.

191. *Id.* at 54 (quoting *Nat'l Basketball Ass'n v. Motorola, Inc.*, 105 F.3d 841, 851 (2d Cir. 1997)).

192. *See id.*

remix fell within the subject matter of copyright, and Jackson asserted state law rights equivalent to the rights protected by copyright law.¹⁹³

The court then turned to implied preemption, defining implied preemption as a preclusion to the application of state laws when “those laws interfere with or frustrate the functioning of the regime created by the Copyright Act.”¹⁹⁴ The determination of implied preemption of publicity claims by the Copyright Act depends on 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.”¹⁹⁵ To avoid preemption of a work defined in the Copyright Act, a state law claim must concern an interest “outside the sphere of congressional concern.”¹⁹⁶ The court explained that a claim is more likely to be preempted if the rights invoked are less substantial.¹⁹⁷ In contrast, the more substantial a state right is, the less likely a claim is preempted.¹⁹⁸ The court held that Roberts’s reproduction of a sound identifiable as Jackson’s voice did not violate any of Jackson’s substantial state law publicity interests.¹⁹⁹ Because the court failed to find that Jackson’s claim involved a substantial state interest, it found the claim impliedly preempted by federal copyright laws.²⁰⁰

Further, the Second Circuit discussed Jackson’s ability to raise his claim.²⁰¹ In standard practice, artists assign away copyright ownership of their works to record labels.²⁰² This assignment makes it easier for record labels to contract for subsequent licensing, as they do not need the performers’ permission before making deals.²⁰³ The court stated that Jackson’s contract precluded him from bringing a right of publicity claim.²⁰⁴ Allowing Jackson to bring this claim after licensing his copyright to Shady/Aftermath “could afford Jackson a limited ability to have approval rights for the future licensing of one of the top songs in history.”²⁰⁵ The court’s language could leave room for performers to

193. *See id.*

194. *Id.* at 33.

195. *Id.* at 37 (citing *Bonita Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 152-53 (1989)).

196. *Id.* at 36 (quoting *Bonita Boats*, 489 U.S. at 155).

197. *See id.* at 34.

198. *See Jackson*, 972 F.3d at 34.

199. *See id.* at 39.

200. *See id.* at 41.

201. *See id.* at 33.

202. *See Goins, supra* note 20.

203. *See id.*

204. *See Jackson*, 972 F.3d at 33.

205. *Goins, supra* note 20.

require labels to receive their permission to use their content after the expiration of their agreements.²⁰⁶

In re Jackson takes many cues from the Eighth and Ninth Circuits to decide whether there is evidence of endorsement or promotion, whether a right of publicity claim falls within the subject matter of the Copyright Act, and whether the claim should be preempted.²⁰⁷ The Second Circuit, however, goes further by employing both express and implied preemption in its reasoning.²⁰⁸

III. ANALYSIS

The heart of the circuit split lies between the Opposing and Agreeing Circuits' differing views regarding when uncopyrightable materials, such as a voice or persona, should become separate from its copyrightable medium, like a recording or a photograph.²⁰⁹ The Opposing Circuits' reasonings are faulty to the extent that they conflate a commercial benefit of a legal copyright with the subject's endorsement.²¹⁰ The Agreeing Circuits use the more sound reasoning for deciding when to preempt right of publicity claims, which only exist in cases that include evidence of promotion or endorsement.²¹¹ The Second Circuit applies the best method of implementing this reasoning by employing both express and implied preemption tests.²¹² Ultimately, this Comment recommends that should the Supreme Court ever opine on this issue, the Court should use the Second Circuit's tests and reasonings to establish a standard test that can uniformly be applied across all circuits.²¹³

A. *Where the Third, Fifth, Seventh, and Tenth Circuits Falter*

The Third Circuit held that *Facenda's* claim failed both prongs of the express preemption test because his voice was not copyrightable subject matter, and because his claim relied on his voice's commercial value, which was not an exclusive right granted to the copyright holders.²¹⁴ In contrast, the Ninth Circuit held that *Laws's* claim passed both prongs of the preemption test because her voice was copyrightable subject matter, and, although her claim also relied on her voice's

206. *See id.*

207. *See Jackson*, 972 F.3d at 33; *Laws v. Sony Music Ent., Inc.*, 448 F.3d 1134, 1145 (9th Cir. 2006); *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1141–42 (8th Cir. 2015).

208. *See Jackson*, 972 F.3d at 33.

209. *See supra* Section II.B.

210. *See infra* Section III.A.

211. *See infra* Section III.B.

212. *See infra* Section III.C.

213. *See infra* Section III.D.

214. *See Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1027–29 (3d. Cir. 2008).

commercial nature, that extra element had to completely “transform the nature of the action[,]” which it did not.²¹⁵ The paramount inconsistency between these decisions is the courts’ interpretation of when something copyrightable, like an audio recording, becomes a separate, uncopyrightable entity, like an identity.²¹⁶ Despite similar facts, each side of the circuit split reaches a different conclusion, but the Opposing Circuits’ reasoning falls short because they conflate the use of a copyrightable material in a commercial manner with endorsement or promotion.²¹⁷

The Third Circuit’s *Facenda* holding, for example, makes it virtually impossible to ever separate the fixed, copyrightable medium of a sound recording from the uncopyrightable subject matter of an identity or persona.²¹⁸ There is little difference between a commentator’s voice being used for a television show²¹⁹ and a singer’s snippet being used in another song²²⁰—both are fixed, copyrightable materials that were used by their legal owners for other pieces of work.²²¹ The Opposing Circuits fall short by confusing the legal right to use a copyright in a commercial way with the original creator’s endorsement.²²² Attaching commercial value to a copyright should not automatically separate the tangible medium of a copyrighted work with the uncopyrightable persona.²²³

The Third Circuit, by placing an identity onto a voice because it is “distinctive,” leaves too much room for error.²²⁴ Any voice can be argued to be distinctive, and employing such a subjective test invites nonuniform application.²²⁵ A nonuniform application can take away from the rightful ownership granted to the legal copyright holders.²²⁶

Copyright law in the United States gives a copyright holder legal protection.²²⁷ Without this protection, little to no incentive exists to provide a public benefit with the new work.²²⁸ The Opposing Circuits’ stance detrimentally falls into this trap—copyright holders will see less value in purchasing copyrights to a piece if they cannot use it for other

215. *Laws v. Sony Music Ent., Inc.*, 448 F.3d 1134, 1144 (9th Cir. 2006).

216. *See supra* Section II.B.

217. *See supra* Section II.B.

218. *See Facenda*, 542 F.3d at 1027.

219. *See id.* at 1011–12.

220. *See Laws v. Sony Music Ent., Inc.*, 448 F.3d 1134, 1136 (9th Cir. 2006).

221. *See* 17 U.S.C. § 102(a).

222. *See supra* Section II.A.1.

223. *See supra* Section II.A.1.

224. *See Facenda*, 542 F.3d at 1027.

225. *See supra* Section II.B.1.

226. *See supra* Section II.B.1.

227. *See* 17 U.S.C. § 102(a).

228. *See supra* Section II.A.1.

works.²²⁹ The Opposing Circuits' decisions make it much more difficult to profit from a purchased copyright, creating a disincentive to purchase it in the first place.²³⁰ This stance violates the basic theory upon which copyright law was founded.²³¹

B. Where the Eighth and Ninth Circuits Succeed

Unlike the Opposing Circuits, the Agreeing Circuits analyzed the separation of an identity and copyrighted material in a more equitable way.²³² As opposed to the Third Circuit's *Facenda* opinion, which found that the persona of a voice was indistinguishable from the fixed medium, the Eighth and Ninth Circuits looked at whether it was reasonable to believe that a consumer would think that the subject of the copyright (that is, the person in the photo or video, or the person whose voice is being recorded) was actually endorsing or promoting the new work.²³³

The Copyright Act, in some instances, should not preempt the right of publicity but rather limit it to when a copyright holder truly uses the material in a way that at least suggests that the original creator is endorsing something to which they did not agree.²³⁴ The thin argument of pulling a persona from a copyrighted work without evidence of endorsement tears at the fabric of the Copyright Act.²³⁵ Copyright holders can be within their rights when using the work in a commercially exploitative manner, as they are the work's rightful owner.²³⁶

Just because copyright holders used Laws's voice as part of a different song, or Ray's wrestling recordings in a commercially exploitative manner, does not mean that the copyright holders exceeded the scope of their legal rights.²³⁷ The Agreeing Circuits appropriately concluded that no implication of endorsement existed between the original work's creator and the new project that used the copyrighted work.²³⁸ Therefore, the claims stayed within the bounds of the Copyright Act and did not infringe the parties' right of publicity.²³⁹

229. See *supra* notes 67-69 and accompanying text.

230. See *supra* notes 67-69 and accompanying text.

231. See JOYCE, *supra* note 27 at 22.

232. See *Ray v. ESPN, Inc.*, 783 F.3d 1140, 1143 (8th Cir. 2015); *Laws v. Sony Music Ent., Inc.*, 448 F.3d 1134, 1137-46 (9th Cir. 2006).

233. See *supra* notes 114-16 and accompanying text.

234. See *supra* Section II.B.2.

235. See *supra* Section II.A.1.

236. See *supra* Section II.A.1.

237. See *Ray*, 783 F.3d at 1143; *Laws*, 448 F.3d at 1137-46.

238. See *supra* Section II.B.2.

239. See *supra* Section II.B.2.

C. *The Positives of Courts Using Express and Implied Preemption in Their Analyses*

Although *In re Jackson* largely follows the Ninth Circuit's *Laws* case, the Second Circuit goes a step further in its analysis, using both express and implied preemption in its opinion, as opposed to just express preemption, like in *Laws* or *Ray*.²⁴⁰ In this context, the Second Circuit is not the only court to analyze both express and implied preemption, but it does implement the better analysis of endorsement in a right of publicity context while also analyzing implied preemption.²⁴¹ Therefore, the Second Circuit has the most applicable approach to right of publicity preemption cases.²⁴²

Implied preemption can be a difficult concept to implement, as determining Congressional objectives can be burdensome.²⁴³ Even though it can be a difficult concept, Congress's objectives remain at the heart of every preemption test.²⁴⁴ Using a test that focuses on the basis of preemption questions leaves more room for fairer outcomes.²⁴⁵ By analyzing both express and implied preemption, a court can consider more components of the facts of a case, and, therefore, the court is more likely to come to a fair and uniform conclusion.²⁴⁶ By disregarding the "touchstone"²⁴⁷ of preemption—Congressional objectives—courts are less likely to reach conclusions that benefit both copyright holders and Congress.²⁴⁸

D. *Recommendation*

If the Supreme Court takes up a case to decide when the Copyright Act preempts a right of publicity claim, then the Court should hold that a right of publicity claim is preempted unless there is evidence of endorsement or promotion within the work.²⁴⁹ For example, a court should hold that the Copyright Act preempts a right of publicity claim unless it is clear that the copyright holder is implying that the subject of the copyright is endorsing a specific product.²⁵⁰ This idea of endorsement

240. See *Ray*, 783 F.3d at 1143; *Laws*, 448 F.3d at 1137-46.

241. See *supra* Section II.C.2.

242. See *supra* Section II.C.2.

243. See *supra* notes 47-52 and accompanying text.

244. See *Wyeth v. Levine*, 555 U.S. 555, 565 (2009) ("[T]he purpose of Congress is the ultimate touchstone in every pre-emption case." (quoting *Medtronic, Inc. v. Lohr*, 518 U.S. 470, 485 (1996))).

245. See *infra* Section III.D.

246. See *supra* Section II.C.2.

247. *Wyeth*, 555 U.S. at 565.

248. See *supra* Section II.A.1.

249. See *supra* Sections III.A, II.C.

250. See *supra* Sections III.B-C.

aligns with the standards set by the Eighth, Ninth—and now Second—Circuits.²⁵¹ If presented with the issue, the Supreme Court should be cautious not to conflate cases that include commercial profit with those that include endorsement, which is where the Third, Fifth, Seventh, and Tenth Circuits falter.²⁵² The consequences for legal copyright holders would be dire—this interpretation creates a standard that would be difficult to apply consistently.²⁵³ As the Second and Ninth Circuits note, if artists wish to have more control of their work, then an artist's rights to their musical work should be negotiated with those wishing to purchase the copyright before signing it away.²⁵⁴

Additionally, the Supreme Court should use the doctrines of both express and implied preemption, as the Second Circuit did, to reflect Congressional intentions most accurately.²⁵⁵ The Supreme Court should take up a case involving right of publicity preemption, and then the Court should leverage the Second Circuit's tests and reasonings to create a uniform test, thereby resolving the circuit split.²⁵⁶

IV. CONCLUSION

The tension between right of publicity claims and the Copyright Act only grows more pronounced as different circuits use different tests, standards, and reasonings.²⁵⁷ Until the Supreme Court looks at this narrow issue, other circuits are likely to come forward and further complicate the split, as the Second Circuit did.²⁵⁸ The Supreme Court should therefore create a uniform test to resolve the circuit split.²⁵⁹

The Opposing Circuits fall short by using reasoning that distorts the original theory behind and purpose of the Copyright Act.²⁶⁰ The Agreeing Circuits use the more appropriate reasoning, but the Second Circuit's *In re Jackson* gives the most sound and logical reasoning for solving the issues arising between right of publicity and the Copyright Act.²⁶¹ By using both express and implied preemption, and by allowing the Copyright Act to preempt right of publicity claims unless there is

251. *See supra* Section III.B.

252. *See supra* Section III.A.

253. *See supra* Section III.B.

254. *See supra* Sections II.B–C.

255. *See supra* Section III.C.

256. *See supra* Section III.C.

257. *See supra* Sections II.B–C.

258. *See supra* Section II.C.

259. *See supra* Section III.D.

260. *See supra* Section III.A.

261. *See supra* Section III.C.

evidence of endorsement, the Second Circuit has created the ideal standard.²⁶²

262. *See supra* Section III.C–D.