

## COPYRIGHT LAW

### Copyright Preemption and the Right of Publicity

By Robert W. Clarida and Robert J. Bernstein

In *Jackson v. Roberts*, 972 F.3d 25 (2d Cir. 2020), the Second Circuit recently confronted a copyright question that has long challenged the courts: is a state law claim for unauthorized commercial use of an individual's name, voice or likeness – *i.e.* a right of publicity (“ROP”) claim – preempted by the federal Copyright Act, when the defendant violates the ROP by reproducing or otherwise exploiting a copyrighted work that embodies such name/voice/likeness? In other words, must the individual plaintiff bring that action as a copyright infringement claim, or go without a remedy? The Second Circuit in *Jackson* clearly held that the answer was yes, but its route to that conclusion may leave future courts no closer to consensus on how to decide the issue.

Very briefly, the facts are as follows: plaintiff Jackson is a successful rapper professionally known as 50 Cent. His breakthrough hit record was a 2003 track called “In Da Club.” Under a recording agreement with Shady Records and Aftermath Records (“Shady/Aftermath”), Jackson does not own copyright in the song or the recording. That agreement also granted Shady/Aftermath certain rights to exploit his name and likeness. In 2015, defendant Roberts, a rapper professionally known as Rick Ross, distributed a free promotional “mixtape” to advertise the forthcoming release of his album *Black Market*. One of the tracks on the mixtape features a lengthy sample of “In Da Club” and the track list identifies it as “In Da Club (Ft. 50 Cent)” (In this context, “Ft.” is a common abbreviation for “featuring”). Roberts’ use was not authorized, either by Jackson or by Shady/Aftermath.

Jackson asserted an ROP claim under Connecticut common law. On cross-motions for summary judgment, the District of Connecticut held for Roberts, reasoning that Jackson had assigned away his relevant ROP rights under the recording agreement. Jackson appealed. On August 19, 2020, the Second Circuit rejected the District Court’s contract-based reasoning, but affirmed the result for Roberts on different grounds.

### Implied Preemption

Senior Circuit Judge Pierre N. Leval, writing for a unanimous panel, explained that an ROP claim can be preempted in two ways: either under the doctrine of “implied preemption,” which is rooted in the Supremacy Clause of the U.S. Constitution and bars state causes of action that “stand as an obstacle” to federal objectives; or under Section 301(a) of the Copyright Act, which expressly preempts state laws that provide rights “equivalent” to those arising under the Act. Jackson’s claim was held preempted under both theories.

For Judge Leval, implied preemption precluded Jackson’s ROP action because the claim did not “further substantial state interests that are distinct from the interests of the [Copyright Act].” *Id.* at 37. Accordingly, in light of the policy considerations underlying implied preemption, Jackson’s “insubstantial claim of violation of his [ROP]” was preempted. What are those policy considerations?

The Court observed that to the extent an ROP claim could be triggered by the publication of a work of authorship that includes depictions or recordings of real persons, “the potential for impairment of the ability of copyright holders and licensees to exploit the rights conferred by the Copyright Act is obvious and substantial.” *Id.* at 39-40. In addition to impairing the rights of copyright owners, such suits could also interfere with a

defendant's freedom to use works in the public domain, or a defendant's permissible fair use of copyrighted works for purposes of scholarship, commentary, etc. *Id.*

These policy concerns, however valid they may be, would seem to have little to do with the facts of the Jackson case. "In Da Club" is not in the public domain, Roberts' "featured" use of an unaltered 30-second sample of Jackson's hit for purposes of commercial promotion of Roberts' own album would be a very poor candidate for fair use, and the use was not authorized by Shady/Aftermath, who own the copyright in the song and the recording. Indeed, under the recording agreement, Shady/Aftermath did not even have the right to authorize the use of "In Da Club" as a sample or "for use as a commercial" without Jackson's consent. *Id.* at 31.

The Court recognized several "weaknesses in Roberts' assertion of preemption." It noted that other courts have "typically" applied the implied preemption doctrine in cases where defendant had the right under copyright to make use of the work, and noted also that Shady/Aftermath's rights to exploit the work were not substantially impacted here. Nonetheless, wrote the Court, "we can envision circumstances" in which such impact might arise, justifying implied preemption here. *Id.* at 42. The Court reprimanded Jackson for a "thinly disguised effort" to "control the reproduction of 'In Da Club' ... in derogation of the exclusive right of the rights holder to exercise such control," *Id.* at 41, but the facts as recited by the Court itself seem to state that Shady/Aftermath had no such control as to the use Roberts actually made.

The Court was also concerned that Jackson was somehow violating federal policy by "attempting to step into Shady/Aftermath's shoes" when he sued Roberts. For the Court, federal policy dictates that the labels, as copyright owners, have the sole discretion

as to whether to challenge or tolerate Roberts' infringement. *Id.* at 41 ("Jackson possessed no legal right to directly control Roberts's use of the song. His attempt to do so under the guise of a right of publicity claim was in derogation of Shady/Aftermath's exclusive right to enforce the copyright.")

But even though Jackson is not himself the copyright owner of record, he presumably receives royalties from the labels in exchange for having assigned his rights, and is therefore likely a beneficial owner of "In Da Club," with his own independent standing to sue for infringement under Section 501(b) of the Copyright Act. In other words, under 501(b) Shady/Aftermath may well have no "exclusive right to enforce the copyright" from which Jackson might derogate. Do different policy concerns arise if a beneficial copyright owner chooses to bring his or her action under state ROP law instead?

#### Statutory Preemption

The Court's analysis of statutory preemption under Section 301(a) of 17 U.S.C. first describes the two prongs of the statutory structure: a state claim is preempted under Section 301(a) if (1) it asserts a claim that "comes within the subject matter of copyright;" and (2) that claim seeks to vindicate a right "equivalent" to the rights accorded a copyright owner under the Act. Although some courts have held that an individual's name, voice and likeness are not within the subject matter of copyright under the first prong, *Jackson* found, based on its consideration of "the gravamen of the claim and the allegations supporting it," that the claim was an attack on Roberts' use of the *recording*, and not primarily an effort to protect Jackson's *identity*.

The chief example the Court offered of such identity emphasis is a claim in which “the plaintiff is identified in a manner that implies the plaintiff’s endorsement, sponsorship, or approval (or in some cases the plaintiff’s disapproval or rejection) . . . or where (as with baseball cards, [citation omitted]) the value of what the defendant distributes lies in its reference to the identity of the plaintiff shown.” Finding no such identity emphasis in Roberts’ use, the court held for preemption under the first prong of 301(a). In reaching that conclusion, *Jackson* stressed that “in the hip-hop world,” the mere use, without more, of a sample from a well-known song, with acknowledgment of the identity of the sampled artist, “does not communicate to the relevant audience that the sampled artist has endorsed or sponsored the sampling artist’s work.” *Id.* at 51.

Under the second prong of the Section 301(a) analysis, *i.e.*, whether the asserted ROP rights are equivalent to rights under the Copyright Act, many courts have applied a so-called “extra element test” to hold that when an asserted state law right is abridged by an act which, in and of itself, would infringe one of the exclusive rights under copyright, the state law claim is equivalent and therefore preempted. Conversely, “when a state law violation is predicated upon an act incorporating *elements beyond mere reproduction or the like*,” the rights are not equivalent. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 723 F.2d 195, 200 (2d Cir. 1983)(emphasis added).

*Jackson* argued that one of the elements of a claim under Connecticut’s common-law ROP is that defendant’s use must be for a commercial purpose, and that this extra element is sufficient to avoid preemption. The Second Circuit criticized a mechanistic application of the extra element test, however, and cautioned that the proper inquiry is whether the state action is *qualitatively* different from a copyright claim, which requires a

“holistic evaluation.” *See* note 17. Jackson’s asserted commercial-purpose element did not rise to that level, particularly when “the essence of the plaintiff’s claim” was an unauthorized reproduction of the copyrighted work. *Id.* at 53. Therefore, the ROP claim was preempted under Section 301(a), as well as under the implied preemption doctrine.

### **Conclusion**

Despite its lengthy analysis and strongly pro-preemption result, *Jackson* may offer little practical guidance to courts for resolving future preemption disputes over similar facts. Whether or not the defendant’s use was licensed or otherwise lawful under copyright law, *Jackson* instructs courts to discern the “focus,” “essence” or “gravamen” of an ROP plaintiff’s claim, the relative degree to which it emphasizes use of the plaintiff’s identity *vs.* the work in which it is fixed, and how that emphasis would be perceived by a relevant audience in a particular marketing context. It cautions against mechanistic application of the extra-element test under Section 301(a) in favor of a holistic inquiry into the qualitative difference between the state cause of action and a copyright claim. In short, it erases the brighter lines that some prior decisions have drawn, and advocates weighing and balancing the totality of the circumstances, which could make it more difficult to resolve these cases short of trial. In any event, *Jackson* will likely be a significant authority as future cases test the limits of copyright preemption and the right of publicity.

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Robert W. Clarida is a partner in the New York law firm of Reitler, Kailas & Rosenblatt LLC and the author of the treatise *Copyright Law Deskbook* (BNA/Bloomberg).

Robert J. Bernstein practices law in New York City in The Law Office of Robert J. Bernstein. He is a frequent author and lecturer on copyright law and litigation, an Honorary Trustee and past President of the Copyright Society of the U.S.A., and formerly served as Chairman of the Copyright Law Committee of the American Intellectual Property Law Association and as a member of its Board of Directors.