

UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF MICHIGAN

THE ROMANTICS a/k/a MASTER BEAT, INC., a  
Michigan corporation; WALLY PALMAR; MIKE  
SKILL; and COZ CANLER,

Case No. 2:07-cv-14969

Honorable Nancy G. Edmunds

Plaintiffs,

-against-

ACTIVISION PUBLISHING, INC.; a California  
corporation; HARMONIX MUSIC SYSTEMS, INC.;  
a Massachusetts corporation; REDOCTANE, INC,  
a California corporation; and WAVEGROUP  
SOUND, a California corporation.,

Defendants.

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**DEFENDANTS' MOTION FOR SUMMARY JUDGMENT AND SUPPORTING BRIEF**

**DECLARATIONS OF STACY HIRATA, JEFFERY MATSUSHITA, GREG DEUTSCH AND JEFFERY D. MCFARLAND FILED  
CONCURRENTLY HEREWITH**

**MOTION**

Defendants Activision Publishing, Inc., RedOctane, Inc., and WaveGroup Sound (collectively, "Defendants"), by their attorneys Quinn Emanuel Urquhart Oliver & Hedges LLP and Honigman Miller Schwartz and Cohn LLP, hereby move pursuant to Fed. R. Civ. P. 56 for summary judgment of Plaintiff's complaint. In support of their motion, Defendants offer the following brief.

Respectfully submitted,

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Dated: March 18, 2008

**BRIEF IN SUPPORT****STATEMENT OF THE ISSUES**

1. Where all of Plaintiffs' claims arise from Defendants' use of a Song in a videogame that relates to the videogame's content and is not misleading as to the Song's source, are Defendants entitled to summary judgment based on the First Amendment?

Defendants answer: "Yes."

2. Where Plaintiffs have failed to establish (i) a consistent, distinctive and/or well-known "sound" and (ii) misappropriation for commercial purposes, are Defendants entitled to summary judgment on Plaintiffs' right of publicity claim ?

Defendants answer: "Yes."

3. Where Plaintiffs' right of publicity claims are based on Defendants' alleged misappropriation of Plaintiffs' allegedly distinctive "sound" in the copyrighted recording of the Song "What I Like About You", are Defendants entitled to summary judgment based on preemption of Plaintiff's right of publicity and unfair competition claims by the Copyright Act?

Defendants answer: "Yes."

4. Where the only reference to Plaintiffs is in the phrase, "as made famous by The Romantics", which Plaintiffs admit to be an accurate designation that the Song is an imitation of Plaintiffs' original studio recording, are Defendants entitled to summary judgment on Plaintiffs' Lanham Act and unfair competition claims?

Defendants answer: "Yes."

**CONTROLLING / MOST APPROPRIATE AUTHORITY**

Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003)

ETW Corp. v. Jireh Pub., Inc., 332 F.3d 915 (6th Cir. 2003)

Parks v. LaFace Records, 329 F.3d 437 (6th Cir. 2003)

Wrench LLC v. Taco Bell Inc., 256 F.3d 446 (6th Cir. 2001)

Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619 (6th Cir. 2000)

Tobin v. Civil Service Employees of State of Michigan, 416 Mich. 661, 331 N.W.2d 184 (1982)

E.S.S. Entertainment v. Rock Star Videos, Inc., 444 F. Supp. 2d 1012 (C.D. Cal., 2006)

Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711, 718 (9th Cir. 1970)

17 U.S.C. § 114(b)

## **I. INTRODUCTION**

Consistent with its Order last month denying Plaintiffs' motion for a preliminary injunction, this Court should find as a matter of law that Plaintiffs cannot make any claim based on Defendants' use of the song "What I Like About You" (the "Song") in the "Guitar Hero®: Rocks the '80s" videogame. No genuine issue of material fact exists here, and the law clearly compels this finding.

First, the Song here was included in the content of the videogame, a recognized expressive work. The First Amendment bars claims for right of publicity, false endorsement and unfair competition for use of a song in an expressive work where, as here, such use is related to the content of the work and is not deceptive.

Second, the state of Michigan, where the individual Plaintiffs are alleged to reside, has never recognized a right of publicity in the sound of a voice, distinctive or otherwise - much less the sound of a combination of voices.

Third, even assuming a publicity claim existed, not all of the Plaintiffs performed on the original master recording of the Song, and the lead featured singer on the original master recording of the Song is not even a Plaintiff. Thus, Plaintiffs do not have standing to pursue any publicity right.

Fourth, the Copyright Act pre-empts Plaintiff's purported state law claims. Plaintiffs have failed to establish a consistent, distinctive and/or well-known voice. As such, they are merely claiming that the overall sound in connection with the music, lyrics and arrangement are protectable. But those claims -- "identity" claims to the sound of the Song -- are essentially claims regarding the licensing of a copyrighted work, falling squarely within the "subject matter" of the Copyright Act. In addition, sections 106 and 114(b) of the Copyright Act permit the owner of a copyright in a musical composition to license others to make specified commercial uses of the composition. This expressly allows third parties such as Defendants to make a sound-alike recording of a song, as Plaintiffs allege that Defendants have done here.

Fifth, Plaintiffs' Lanham Act claim (and related Michigan state unfair competition claim) fails

because Defendants have made no trademark use of the name of "The Romantics," using the name merely in the body of the Game to accurately identify the group that made the Song famous, and Defendants have not sought to pass off the Song as the original recording by The Romantics. Further, the law is clear that a musical composition such as the Song cannot be protected as its own trademark under the Lanham Act.

For the foregoing reasons, Defendants respectfully request that summary judgment be granted. Plaintiffs' novel and unsupported position would turn the law on its head.

## **II. STATEMENT OF FACTS**

### **A. The Defendants and the Game**

"Guitar Hero®: Rocks the '80s" ("the Game") is a part of the "Guitar Hero" video game franchise which includes a series of games, guitar shaped game controllers, accessories and merchandise under the "Guitar Hero" trademark. **Hirata Decl. ¶ 6.**<sup>1</sup> This franchise has been very successful, winning numerous accolades and becoming the top selling franchise for console video games as of September 2007. **Hirata Decl. ¶¶ 9, 11.**

The Game is a complex artistic work combining visual, audio and narrative elements for which Defendants spent months developing the unique theme and technology. The Game allows players to pretend they are playing guitar in a rock and roll band. **Matsushita Decl. ¶ 4.**<sup>2</sup> Play begins as players choose among options such as character, costume, and model of guitar, and then simulate the guitar play of various songs by correctly timing the pressing of fret buttons and a strum bar on a guitar-like controller. **Id. at ¶¶ 4-6.** The Game includes thirty songs from the 1980s to add to the realistic experience of playing in a rock band from that era. **Id. at ¶ 9.** Each song in the Game has a level of difficulty, and, with the

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<sup>1</sup> March 12, 2008 Declaration of Stacy Hirata in Support of Defendant's Motion for Summary Judgment, submitted herewith. ("Hirata Decl.").

<sup>2</sup> March 13, 2008 Declaration of Jeffery Matsushita in Support of Defendants' Motion for Summary Judgment, submitted herewith. ("Matsushita Decl.").

exception of one mode where you can access only a limited set of songs, only after reaching a certain proficiency on a group of songs can a player advance to another more difficult group of songs. **Id. at ¶ 4.** The graphic video elements of the Game require complex synchronization with each song to enable the realistic simulation of guitar play. **Deutsch Decl. ¶ 7.**<sup>3</sup>

Defendant Activision Publishing, Inc. ("Activision"), the distributor of the Game and the parent of Defendant RedOctane, Inc., the publisher of the Game, obtained a valid nonexclusive synchronization license from EMI Entertainment World, Inc., the owner of the copyright in the musical composition entitled "What I Like About You" (written and originally recorded in 1979 by the band, The Romantics, and published in 1980) (the "Song"). **Deutsch Decl. ¶ 9; McFarland Decl. ¶ 3.**<sup>4</sup>

A synch license, in the context of a video game, permits Defendants to make a new recording of the underlying composition and to use that recording in synchronization with visual images in the video game to enable game play. **Deutsch Decl. ¶ 7.** In accordance with this license, Defendant WaveGroup Sound ("WaveGroup") recorded a new version of the Song which was incorporated, or synchronized, into the Game. **Deutsch Decl. ¶ 9.** The Game was commercially released in July 2007. **Hirata Decl. ¶ 8.**

While playing the Game, a player can encounter the Song or any reference to The Romantics only if the player obtains an advanced player status. Theoretically, a player could play the Game and never reach the advanced level of play necessary to encounter the Song among the thirty tracks included in the Game. **Matsushita Decl. ¶ 10.** Even when a player encounters the Song, it is part of the content in the Game, and is clearly identified by the Song title and the words "as made famous by the Romantics", thus informing players and onlookers that The Romantics are not actually performing the Song. **Matsushita Decl., ¶¶ 12, 13.** Defendants have never used the Song for the purpose of advertising or marketing the

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<sup>3</sup> March 12, 2008 Declaration of Greg Deutsch in Support of Defendants' Motion for Summary Judgment, submitted herewith. ("Deutsch Decl.").

<sup>4</sup> March, 2008 Declaration of Jeffery McFarland in Support of Defendants' Motion for Summary Judgment, submitted herewith. ("McFarland Decl.").

Game, and neither the name of Plaintiffs' band nor any of the names of the individual Plaintiffs appear on the product packaging. **Hirata Decl., ¶ 12.**

**B. The Plaintiffs and The Song.**

Plaintiffs Wally Palmar, Mike Skill, and Coz Canler are current members of the rock band The Romantics. **Complaint, ¶ 2.**<sup>5</sup> The musicians who have performed as members of The Romantics have changed many times during the band's existence. The Romantics created the original master recording embodying the Song in 1979, which was released in 1980. Not all Plaintiffs participated in the master recording of the Song and the lead singer on the master recording of the Song is no longer with The Romantics nor is he a party to this action. **McFarland Decl., ¶ 4.** Plaintiffs do not allege that they currently own any rights in the Song.

The Song has appeared ubiquitously in popular culture for the past two decades, and is frequently used in commercials and films. **Complaint ¶ 8.**<sup>6</sup> Plaintiffs contend, but have proffered no evidence, that a substantial number of ordinarily prudent consumers of Defendants' Game have been, or are likely to be in the future, confused, deceived, or mistaken about whether the Plaintiffs sponsored or endorsed the Game.

Plaintiffs have alleged claims against Defendants for the right of publicity, Lanham Act, unfair competition and unjust enrichment claims.

**C. Procedural History.**

On November 20, 2007, the eve of the Thanksgiving holiday, Plaintiffs filed the Complaint and a Motion for Preliminary Injunction to enjoin all sales of the Game. On December 7, 2007, Defendants filed

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<sup>5</sup> Master Beat, Inc., which allegedly owns the trademark registration for the name "The Romantics", is also suing.

<sup>6</sup> "The Song is regularly performed by Plaintiffs and others licensed to perform it. It is also regularly licensed for use in movies, television and radio advertising. For example, the Song has been used in the movies 'Shrek 2,' the Disney remake of 'Freaky Friday,' and 'The Simpsons Movie,' and has been used in advertising campaigns for Budweiser, T.G.I. Friday's restaurants, Barbie dolls, and the Los Angeles Dodgers baseball team." (emphasis added). See also November 20, 2007 Affidavit of Walter Palamarchuk in support of Preliminary Injunction Motion ("Palamarchuk Aff."), ¶ 4.

an Opposition to Plaintiff's Motion for Preliminary Injunction. On December 18, 2007, this Court held a hearing and denied Plaintiff's Motion in its entirety. On January 22, 2008, this Court issued an Order Denying Plaintiffs' Motion For Preliminary Injunction ("Order"), finding, inter alia, that Plaintiffs could not show a likelihood of success on the merits for any of their claims.<sup>7</sup>

### **III. ARGUMENT**

#### **A. Plaintiffs' Claims are Preempted by the First Amendment**

Defendants have used the Song in a *video game*, a work of artistic expression. Additionally, the video game is focused on music and the simulation of being in a rock band. Accordingly, the Song is directly related to the content of the Game. Under the Rogers test employed by the Sixth Circuit, a defendant's use of a plaintiff's identity in an expressive work is protected so long as it is related to the content of the work, as opposed to a disguised commercial advertisement for the misleading sale of goods or services. Parks v. LaFace Records, 329 F.3d 437, 461 (6th Cir. 2003) (quoting Rogers, 875 F.2d at 1004). Because the Game is an expressive work and because the Song is related to the content of the Game, the First Amendment protects Defendants' use of the Song. Accordingly, Plaintiff's right of publicity, unfair competition and Lanham Act claims must be dismissed.

##### **1. The First Amendment applies because the Game is an expressive work.**

As a foundational matter, the Game here is unquestionably an artistic work for the purpose of First Amendment protection. Defendants generally spend 6-12 months developing the unique theme and technology of these games. **Matsushita Decl. ¶ 8**. In the Game, a player can choose from a variety of individual "characters" to represent their journey as a guitarist, developing from a garage band novice to stadium mega-star. **Id. at ¶ 4**. These graphic elements require complex synchronization with each song to enable the realistic simulation of guitar play. **Deutsch Decl. ¶ 7**.

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<sup>7</sup> The Order is attached to the McFarland Decl. as Exh. C.

Numerous courts, including this Court in this case, have found that videogames are expressive works protected by the First Amendment. Order at 8; see, e.g., E.S.S. Entertainment v. Rock Star Videos, Inc., 444 F.Supp.2d 1012, 1039 (C.D. Cal., 2006) (holding that defendants' video game "clearly qualifies as an 'artistic work' entitled to First Amendment protection"); James v. Meow Media, Inc., 300 F.3d 683, 696 (6th Cir. 2002) (expressive features of videogames protected by First Amendment).<sup>8</sup>

Because the Game is a work of artistic expression, the First Amendment applies to each of Plaintiffs' claims and, as to each, serves as a complete bar. See, e.g., ETW Corp. v. Jireh Pub., Inc., 332 F.3d 915, 936-938 (6th Cir. 2003).

**2. The First Amendment trumps a right of publicity claim where the identity used relates to the content of an expressive work.**

Where an expressive work is involved, as is the case here, the Sixth Circuit applies a test that is highly protective of a defendant's First Amendment rights. Parks, 329 F.3d at 461 (quoting Rogers, 875 F.2d at 1004). Under the Rogers test employed by the Sixth Circuit, a defendant's use of a plaintiff's identity in an expressive work is protected so long as it is related to the content of the work, as opposed to a disguised commercial advertisement for the misleading sale of goods or services. Parks, 329 F.3d at 461 (quoting Rogers, 875 F.2d at 1004). First Amendment protection applies "when a work contains significant transformative elements" as the work is "not only especially worthy of First Amendment protection, but it is also less likely to interfere with the economic interest protected by the right of publicity." ETW Corp., 332 F.3d at 935.

Any relationship between the content of an expressive work and the plaintiff's identity renders the right of publicity inapplicable. See Rogers, 875 F.2d at 1004 (right of publicity does not apply unless use of the celebrity's name is "wholly unrelated" to the work). As discussed, to the extent Plaintiffs have a

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<sup>8</sup> See also Video Software Dealers Ass'n v. Schwarzenegger, 401 F.Supp.2d 1034, 1044 (N.D.Cal.2005) ("the pictures, graphic design, concept art, sounds, music, stories, and narrative present in video games" is speech entitled to First Amendment protection); Video Software Dealers Ass'n v. Maleng, 325 F.Supp.2d 1180, 1184-85 (W.D.Wash. 2004) (same).

protectable identity in an alleged distinctive sound, it is clearly related to the content of the Game -- notably, the Song that is included. Plaintiffs' right of publicity claim thus fails on First Amendment grounds alone. See id. (affirming summary judgment for defendants on Ginger Rogers' claim that film titled "Ginger and Fred" violated her right of publicity).

**3. Similarly, false endorsement claims under the Lanham Act and common law unfair competition claims are barred by the First Amendment where the use has artistic relevance and is not misleading.**

Plaintiff's false endorsement and unfair competition claims also fail in view of First Amendment protections. The Sixth Circuit has held that, in the context of a false endorsement claim, "the public interest in free expression should prevail if the use of the celebrity's image has artistic relevance, unless it is used in such a way that it explicitly misleads as to the source of the work." ETW Corp., 332 F.3d at 928. Accordingly, the Sixth Circuit test for whether the First Amendment bars Lanham Act and unfair competition claims is essentially the same as that for right of publicity claims, i.e., whether: (1) the use of the Plaintiffs' mark surpasses a minimum threshold of artistic relevance to the work's content; and (2) the use of the mark does not explicitly mislead as to the source of the content of the work. Id.

The application of the Rogers test in E.S.S., 444 F.Supp.2d 1012, is on point. In E.S.S., the makers of the video game series, *Grand Theft Auto*, faced Lanham Act and state law unfair competition claims arising from the incorporation of the visual aspects of a well known Los Angeles adult entertainment club, the "Play Pen," into the appearance of the "Pig Pen" adult entertainment club in their game. The court granted summary judgment for defendants on all claims, holding that the claims were barred by the First Amendment. Id. at 1048-49. Despite the similarities between plaintiffs' actual club and defendants' virtual one, the court found that "the Pig Pen had artistic relevance to defendants' twisted, irreverent image of urban Los Angeles" and held that the defendants' "decision to borrow the Play Pen trade dress and mark was closely connected to the artistic design of Los Santos and the overall theme of the Game." Id. at 1043. Here, Defendants' use of its version of the Song was intimately tied to the vision of the game -- to

fulfill the fantasy of playing guitar in an '80s rock and roll band. **Matsushita Decl. ¶ 4; Deutsch Decl. ¶ 5.** Defendants' creative considerations thus satisfy the first prong of Rogers.

As to the second prong, like the defendants' game in E.S.S., there is no risk that Defendants' use of the Song in the Game explicitly misleads consumers as to the content or source of the Game. As in E.S.S., none of Defendants' many national advertisements or product packaging refers to Plaintiffs in any way. **Hirata Decl. ¶ 12.** In this way, "consumers are not exposed to the [plaintiff's mark] until after they purchase and play the Game." E.S.S., 444 F.Supp.2d at 1023. Moreover, if consumers even encounter the Song in the Game, it has been clearly identified "as made famous by the Romantics", thus informing that the Romantics are not actually performing it. **Matsushita Decl. ¶ 12.** Defendants have themselves admitted that "as made famous by" means that the song is not the master recording. **Complaint, ¶ 12.** The Game creatively incorporates the Song, and is not explicitly misleading in doing so. Plaintiffs' Lanham Act claim is completely preempted by the First Amendment and must fail.

Similarly, under Michigan law, a court analyzes a claim for unfair competition in the same manner as it analyzes claims under the Lanham Act. Wynn Oil Co. v. American Way Service Corp., 943 F.2d 595, 605 (6th Cir. 1991). Thus, Plaintiffs' state unfair competition claim fails for the same reasons discussed here and in the relevant sections, above.

**B. Plaintiffs Cannot Establish The Necessary Elements For Their Right of Publicity Claim.**

**1. Plaintiffs have failed to establish any distinctive, consistent and well-known voice to merit protection under the right of publicity.**

In addition to failing because it is barred by the First Amendment, Plaintiffs' right of publicity claim fails because Plaintiffs cannot prove the requisite facts to establish the claim. As recognized by this Court, Michigan has never recognized a right of publicity in the sound of a voice, even if distinctive, much less for

a combination of voices.<sup>9</sup> See Tobin v. Civil Service Employees of State of Michigan, 416 Mich. 661, 672, 331 N.W.2d 184 (1982) (recognizing protection against "[a]ppropriation, for the defendant's advantage, of the plaintiff's name or likeness." (emphasis added)). Absent a strong basis to determine how the Michigan Supreme Court would rule on this issue, a federal court should not speculate.<sup>10</sup>

Lacking any Michigan law to support their claims, Plaintiffs instead rely exclusively on two Ninth Circuit decisions to state a purported right of publicity in their supposedly "distinctive" sound: Midler v. Ford Motor Company, 849 F.2d 460 (1988), and Waits v. Frito Lay, 978 F.2d 1093 (1992).<sup>11</sup> Under those cases, the established elements for a right of publicity claim based on misappropriation of voice include (a) a distinctive voice. (b) that is well-known, and (c) is deliberately misappropriated for commercial purposes. See Waits, 978 F.2d at 1100; Midler, 849 F.2d at 463. Here, Plaintiffs present entirely different facts that fail to satisfy any those elements.

First, both the Midler and Waits cases involved a singular, professional singer's voice. There are no cases that extend the right of publicity to cover a group of people's (or band's) *sound*.

Second, the right of publicity is a personal right. See Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619, 624 (6th Cir. 2000) (right of publicity is "the personal right to exploit the commercial value of [one's] own identity." (emphasis added)). Plaintiffs lack standing to assert a right of publicity claim in this case because all of the Romantics' members who originally recorded the Song are not presently in the band, nor are they plaintiffs to the present suit. In fact, the lead vocalist on the Song is not named as a plaintiff. Conversely, one of the individuals who is named as a Plaintiff (Coz Canler) did not participate in

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<sup>9</sup> Order at 5, McFarland Decl., Exh. C.

<sup>10</sup> See Barlow v. DeVilbiss Co., 214 F.Supp. 540, 543 (E.D. Wis. 1963) ("Plaintiffs urge this court to take the step which the Wisconsin Supreme Court has not yet taken . . . The difficulty with this approach is that the proper function of this court in a diversity case is to apply state law as it now exists and not to make new law by trying to anticipate what the Wisconsin Supreme Court may rule in the next case before it. If the law is to be changed, it must be changed by the Wisconsin Supreme Court.").

<sup>11</sup> Plaintiffs' Motion for Preliminary Injunction at 5-6.

the "original studio recording"<sup>12</sup> of the Song and did not join the Romantics until after the Song was released. **McFarland Decl. ¶ 4.** Consequently, Plaintiffs lack standing to sue for publicity rights in an alleged "sound" that Plaintiffs no longer possess and/or that no longer exists.<sup>13</sup>

Third, Plaintiffs simply cannot establish a singular identity or "sound" that is *distinctive*. In Waits, the court approved an instruction defining distinctive as "distinguishable from the voices of other singers. . . if it has particular qualities or characteristics that identify it with a particular singer." Waits, 978 F.2d at 1102. Similarly, the Midler court noted that "[A] voice is as distinctive and personal as a face . . . The singer manifests herself in the song." Midler, 849 F.2d at 463 (emphasis added).

Here, as discussed above, different people have substituted in and out of the Romantics' band over the years. **McFarland Decl. ¶ 4.** Plainly if multiple singers can come in and out of the band, they fail to have a singular "voice" or "sound" that is distinguishable from the voices or sounds of other singers. Nonetheless, the Complaint alleges that "Plaintiffs, both individually and collectively, are identified with the Song and derive a substantial income from performing the Song ..." **Complaint, ¶ 8** (emphasis added). However, even assuming the allegation to be true, merely being "identified" with a song is an insufficient basis for a right of publicity claim.

Fourth, Plaintiffs have not, and cannot, demonstrate any "significant commercial value" in the use of their particular "sound", whatever that "sound" may be. This failing is also fatal to their right of publicity claim. Landham, 227 F.3d at 626.

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<sup>12</sup> Complaint, ¶ 9.

<sup>13</sup> See, e.g., ETW Corp. v. Jireh Pub., Inc., 332 F.3d 915, 922 (6th Cir. 2003) (plaintiff could not have an identity right in the thousands of images and likeness that existed of him); Landham, 227 F.3d at 625 (affirming summary judgment for defendants on actor's right of publicity claim, because actor could not show that allegedly infringing toy invoked his own persona, as distinct from that of fictional character); Kirby v. Sega, 144 Cal.App.4th 47, 56 (2006) ("Kirby concedes she has no singular identity, her appearance and visual style are 'continually moving,' and she 'is not the type of artist that wants to do the same thing every time.' This lack of stasis is inconsistent with a claim of appropriation.").

**2. Plaintiffs have failed to establish misappropriation for commercial purposes.**

In Waits and Midler, the plaintiffs' voices were used in the advertisement of a product -- a situation not present here. It is undisputed that the Song here only appeared in the Game itself, not in commercials for the Game. Thus, Plaintiffs cannot show that their sound was misappropriated "in order to sell a product." Midler, 849 F.2d at 463. Importantly, as explained above, the Sixth Circuit has employed an entirely different test for examining rights of publicity cases when the use complained of is use in an expressive work entitled to First Amendment protection. Parks v. LaFace Records, 329 F.3d 437, 461 (6th Cir. 2003), citing Rogers v. Grimaldi, 875 F.2d 994, 996 (2d. Cir., 1989). Furthermore, the plaintiffs in both Waits and Midler had consistently refused permission to the use of their voices in commercial advertising. In contrast, by Plaintiffs' own admission in the Complaint, the Song here has been used ubiquitously in advertising for the past two decades. (Complaint ¶ 8).<sup>14</sup> Accordingly, Plaintiffs' right of publicity claim should fail because Plaintiffs' cannot establish the requisite elements of the claim.

**C. Plaintiffs' Right of Publicity Claim Is Preempted by the Copyright Act.**

As this Court has already held, Plaintiffs' "identity" claim to the sound of the Song is essentially a claim regarding the licensing of a copyrighted work, and thus falls squarely within the "subject matter" of the Copyright Act, and should be denied as preempted by the Copyright Act.<sup>15</sup>

The fundamental purpose of the Copyright Act is to provide a uniform system for protecting original expression for the benefit of society at large. See Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 165-66 (1989). Under the Act, the owner of a copyright in a musical composition (which covers both the lyrics and the "lead sheet," or musical notation, of the composition) has the right to permit others to

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<sup>14</sup> "The Song is regularly performed by Plaintiffs and others licensed to perform it. It is also regularly licensed for use in movies, television and radio advertising. For example, the Song has been used in the movies 'Shrek 2,' the Disney remake of 'Freaky Friday,' and 'The Simpsons Movie,' and has been used in advertising campaigns for Budweiser, T.G.I. Friday's restaurants, Barbie dolls, and the Los Angeles Dodgers baseball team." (emphasis added); see also Palamarchuk Aff., ¶ 4.

<sup>15</sup> Order at 6, Exh. C to McFarland Decl.

make specified commercial uses of the composition, one of which is to make a recording thereof. See 17 U.S.C. § 106. A state law cause of action is preempted by the federal Copyright Act, and summary judgment is appropriate, where the defendant demonstrates that: (1) the work involved falls within the "subject matter" of the Copyright Act; and (2) the rights that a plaintiff asserts under state law are "rights equivalent" to those protected by the Copyright Act. Kodadek v. MTV Networks, Inc. 152 F.3d 1209, 1212 (9th Cir. 1998) (affirming summary judgment for defendant on preemption grounds). "Equivalency exists if [the state law right] may be abridged by an act which in and of itself would infringe one of the exclusive rights [granted by the Copyright Act]." Murray Hill Publications, Inc. v. ABC Communications, Inc., 264 F.3d 622, 636 (6th Cir. 2001), quoting Wrench LLC v. Taco Bell Inc., 256 F.3d 446, 455 (6th Cir. 2001).

**1. Defendants possess valid licenses to use Plaintiffs' copyrighted material.**

It is undisputed that Defendants possess a license to produce their version of the Song from the owner of the copyright, EMI Entertainment World, Inc. (**Deutsch Decl. ¶ 9**). Based on this license agreement, Defendants have a nonexclusive synchronization license from the copyright holder of the Song. A synchronization license allows its holder to use an existing musical composition in synchronization with an audiovisual work. See ABKCO Music, Inc. v. Stellar Records, Inc., 96 F.3d 60, 63 n.4 (2nd Cir. 1996). By obtaining a synchronization license, Defendants gained the right to make their own recording of the Song to integrate into the Game as they did.

In short, Plaintiffs' claims amount to no more than an assertion that Defendants did exactly what the license that they obtained allows -- record a version of the Song and use it in the Game.

**2. The Copyright Act expressly allows sound-alike recordings.**

In addition to the license, the Copyright Act expressly allows third parties to record sound alike versions of copyrighted recordings, and specifically provides that copyright owners have no recourse for those recordings.

Under the Copyright Act, only parties with ownership rights in a copyright have standing to bring an infringement action.<sup>16</sup> 17 U.S.C.A. § 501(b) ("The legal or beneficial owner of an exclusive right under a copyright is entitled... to institute an action for any infringement of that particular right committed while he or she is the owner of it.") (emphasis added). Yet even copyright owners are limited in the types of infringement actions they can bring. In particular, as noted in the Order, copyright owners of a sound recording do not have any claim against a party who has "covered" or made a sound-alike recording of the copyrighted song. "The exclusive rights of the owner of copyright in a sound recording . . . do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, **even though such sounds imitate or simulate those in the copyrighted sound recording.**" 17 U.S.C. § 114(b) (emphasis added). The statute could not be more clear: no action will lie based on a third party's "sound alike" recording of a copyrighted song.<sup>17</sup>

Because Plaintiffs' right of publicity and unfair competition claims turn on the allegation that Defendants created a licensed "sound-alike" recording, these claims fail as a matter of law.

**3. Plaintiffs' attempt to dress up what amount to copyright claims as common law causes of action is unavailing.**

To avoid preemption under the Copyright Act, a plaintiff must state a cognizable claim of invasion of personal, state-law rights that are distinct from copyright protections. See Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619, 623-24 (6th Cir. 2000).<sup>18</sup>

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<sup>16</sup> Plaintiffs likely did not bring a traditional copyright claim upon recognition that they lacked any ownership interest in the Song. Indeed, Plaintiffs make no mention of any copyright entitlements they possess in the Song anywhere in either their Complaint or in their Motion for a Preliminary Injunction.

<sup>17</sup> The legislative history provides further support: "Mere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible." Notes of Committee on the Judiciary, 17 U.S.C.A. § 114(b).

<sup>18</sup> Plaintiff in Landham brought suit over the use of his physical appearance and likeness in a piece of advertising merchandise without his permission - qualitatively different from the licensed copying of

Where, as here, a party's "identity" claims are essentially claims regarding the use of a copyrighted work, courts have found those claims to be preempted. See Daboub v. Gibbons, 42 F.3d 285, 289 (5th Cir. 1995) (affirming summary judgment for defendants because "the core of each of [plaintiff's] state law theories of recovery in this case ... is the same: the wrongful copying, distribution, and performance of the lyrics of [the song]. The similitude of tunes with respect to the state and copyright causes of action is a most harmonious one"); Motown Record Corp. v. George A Hormel & Co., 657 F.Supp. 1236, 1239-40 (C.D. Cal. 1987) (granting summary judgment on plaintiffs' right of publicity claims against defendants' use of the tune of a Supremes' song and the group's image because they were merely claims for reproduction, performance, distribution or display of a copyrighted work within the scope of the Copyright Act and were thus preempted); Murray Hill, 264 F.3d at 636-7 (affirming summary judgment for defendant on ground that plaintiff's claims based on radio station's promotional use of song and dialogue from film were pre-empted by Copyright Act).

Here, Plaintiffs' purported claims arise from Defendants' arrangement and production of musical and vocal performances that allegedly sound similar to those embodied in a copyright sound recording released by The Romantics in 1980, as distinct from the sound of any individual's voice or musical performance existing separate and apart from a copyrighted work.<sup>19</sup> These claims are preempted by copyright law. Otherwise, any "distinctive sound" recording would fall outside the parameters of the Copyright Act because of the use of that "sound" -- an untenable result that would undermine the express provisions of the Copyright Act regarding sound recordings.<sup>20</sup> Turning copyright law and its attendant protections upside down, Plaintiffs' approach would open the litigation floodgates to allow anyone with any

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a sound recording in a creative work of expression as in the present case.

<sup>19</sup> Order at 6, Exh. C to McFarland Decl.

<sup>20</sup> See Daboub, 42 F.3d at 290 ("if the language of the act could be so easily circumvented, the preemption provision would be useless, and the policies behind a uniform Copyright statute would be silenced.").

"identifiable trait" captured in another party's copyrighted work to dictate what can be done with that work - irrespective of any copyright permissions that may have been exchanged between owner and licensee.<sup>21</sup> Courts have rejected precisely such attempts to extend publicity rights in contravention of copyright.<sup>22</sup>

The Ninth Circuit's decision in Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711 (9th Cir. 1970) is instructive. In Sinatra, Nancy Sinatra sued defendants based on an advertising campaign that featured "These Boots Are Made For Walkin'", a song that Sinatra made famous. The defendants had obtained a license from the copyright proprietor for the use of music, lyrics and arrangement of the composition, and they subsequently used a version of the song in their ad that was sung by unknown vocalists. Sinatra alleged that defendants had selected singers whose voice and styles were deliberately intended to imitate or "pass off" her own voice and style. Affirming summary judgment for defendants, the court found that Sinatra's objection was really to the use of the song itself, for which copyright was her sole remedy:

[A]ppellant's complaint is not that her sound is uniquely personal; it is that the sound in connection with the music, lyrics and arrangement, which made her the subject of popular identification, ought to be protected. But as to these latter copyrightable items she had no rights . . . One wonders whether her voice, and theatrical style, would have been identifiable if another song had been presented, and not 'her song', which unfortunately for her was owned by others and licensed to the defendants. (Id. at 716) (emphasis added).

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<sup>21</sup> The Sixth Circuit has already held that such a demand is beyond the power of the court. "The Copyright Act is unusually broad in its assertion of federal authority. Rather than sharing jurisdiction with the state courts as is normally the case, the statute expressly withdraws from the state courts any jurisdiction to enforce the provisions of the Act and converts all state common or statutory law 'within the general scope of copyright' into federal law to be uniformly applied throughout the nation." Ritchie v. Williams, 395 F.3d 283, 286 (6th Cir. 2005).

<sup>22</sup> See, e.g., Sinatra, 435 F.2d at 718 ("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 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."); Laws v. Sony Music Entertainment, 448 F.3d 1134, 1145 (9th Cir. 2006) ("the right of publicity is not a license to limit the copyright holder's rights merely because one disagrees with decisions to license the copyright"); Daboub v. Gibbons, 42 F.3d 285, 290 (5th Cir. 1995) ("[Plaintiffs'] argument is like a ventriloquist's attempt to present a copyright action in the voice of state law claims.").

Although Sinatra was decided prior to the passage of the modern-day preemption provision in section 301, the court nonetheless ruled that the Copyright Act impliedly pre-empted Sinatra's state law claim.<sup>23</sup> The court noted:

Here, the defendants paid a very substantial sum to the copyright proprietor to obtain the license for the use of the song and all of the arrangements. The plaintiff had not sought or obtained the same rights which would have protected the secondary meaning which she asserts. The resulting clash with federal law seems inevitable if damages or injunctive remedies are available under state laws. (Id. at 717).

Sinatra was distinguished in the Waits and Midler cases, where right of publicity claims were held to not be preempted. In those cases, each plaintiff proved a distinctive, well-known voice that was misappropriated. Here, as demonstrated above, Plaintiffs cannot establish misappropriation of a distinctive, well-known voice. And a review of their allegations and proof submitted in support of their motion for preliminary injunction, reveals that what they are really alleging is just what Nancy Sinatra alleged -- imitation of the sound in connection with the music, lyrics and arrangement with which the Romantics are purportedly identified. For example, the Complaint alleges that "Plaintiffs, both individually and collectively, are identified with the Song and derive a substantial income from performing the Song ..." **Complaint, ¶ 8** (emphasis added). Similarly, in the reply to the motion for preliminary injunction, Plaintiffs expressly accused Defendants of "imitat[ing] the master or sound recording from the Romantics' album." **Plaintiffs' Reply at p. 4**. Plaintiffs' musicologist also compared only the *sound recording* by the Romantics against the sound recording by WaveGroup, citing comparisons between music, lyrics and instrumental arrangements. **Report of Musicologist Anthony Ricigliano at , attached as Exh. C to Plaintiffs' Reply Brief In Support of Preliminary Injunction**. The musicologist did not analyze the voices, or discuss the voices separate from the Song, in comparison to the voices in the WaveGroup recording. Id.

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<sup>23</sup> The Ninth Circuit reaffirmed the Sinatra holding in Midler, 849 F.2d at 462, observing that "[t]o give Sinatra damages for [defendants'] use of the song would clash with federal copyright law."

As Plaintiff's right of publicity and unfair competition claims are based on Defendants' alleged imitation of the Song in the Game, and not on the misappropriation of a well-known voice, they are preempted by the Copyright Act.

**D. Plaintiffs Cannot Establish a Lanham Act Claim**

In addition to the other grounds for summary judgment in favor of Defendants on Plaintiffs' Lanham Act claim, it also fails because Plaintiffs cannot establish the requisite elements – misleading use of a trademark or representation.

**1. A song cannot be protected as its own trademark under the Lanham Act.**

Section 43(a) of the Lanham Act prohibits use of a "word, term, symbol, or device," or a "false designation of origin . . . which is likely 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." 15 U.S.C. § 1125(a). However, there are exceptions to the application of the section 43(a) of the Lanham Act in the context of copyright claims. For claims involving the copyright of musical works:

a musical composition cannot be protected as its own trademark under the Lanham Act. A contrary conclusion would allow any copyright claim for infringement of rights in a musical composition to be converted automatically into a Lanham Act cause of action. While there are many cases in which both claims are appropriate, cases involving trademark infringement should be those alleging the appropriation of symbols or devices that identify the composition or its source, not the appropriation or copying or imitation of the composition itself. Concluding that a song can serve as an identifying mark of the song itself would stretch the definition of trademark--and the protection afforded under § 43(a)--too far and give trademark law a role in protecting the very essence of the song, an unwarranted extension into an area already protected by copyright law.

Butler v. Target Corp., 323 F.Supp.2d 1052, 1059 (C.D. Cal. 2004) (emphasis added). See also Oliveira v. Frito-Lay, Inc., 251 F.3d 56, 62 (2nd Cir. 2001) (the law does not accord trademark rights in the recording of a signature performance). Plaintiffs have not articulated how the Court should view their "sound" as distinct from the sound recording of the Song; instead they allege that they are "identified" with the Song.

Thus, they are asking the Court to find that the sound of the Song (i.e., the sound recording) may serve as a trademark. This request must be denied on the basis of settled precedent.

Section 43(a) protections also do not extend to the underlying “idea, concept or communication embodied in [a tangible] good[.]” Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 37 (2003) (noting that “to hold otherwise would be akin to finding that § 43(a) created a species of perpetual patent and copyright, which Congress may not do”). As the Game is a tangible good, protection of the underlying “sound” captured in it exceeds the scope of the Lanham Act. Plaintiffs’ Lanham Act claim must be denied on these grounds alone.

**2. Plaintiffs cannot prove that consumers are likely to be misled by Defendants’ reference to the Romantics in the Game**

The Lanham Act claim requires proof that consumers are likely to be *misled* as to Plaintiffs’ endorsement of the Game. 15 U.S.C. § 1125(a) (prohibiting designations that are “likely to cause confusion...mistake...or to deceive”). As demonstrated above, the only reference to the Romantics in the Game is in a screen identifying the Song along with the statement “as made famous by the Romantics.” Plaintiffs have admitted that “as made famous by” means that the Song is *not* performed by Plaintiffs. (Complaint ¶ 12). Because consumers know that the Song is not performed by Plaintiffs, there is no mistaken belief that Plaintiffs performed the Song in the Game and thus were endorsing the Game. Accordingly, Plaintiffs’ cannot prove a requisite element of their Lanham Act claim.

**E. Plaintiffs’ Claims For Unfair Competition And Unjust Enrichment Also Fail.**

Under Michigan law, a court analyzes a claim for unfair competition in the same manner as it analyzes claims under the Lanham Act. Wynn Oil Co. v. American Way Service Corp., 943 F.2d 595, 605 (6th Cir. 1991). Thus, Plaintiffs’ state unfair competition claim fails for the same reasons discussed here and in the relevant sections, above.

Plaintiffs’ purported unjust enrichment claim also fails for several reasons. First, unjust enrichment is a remedy rather than a freestanding cause of action. See Kammer Asphalt Paving Co. v. East China

Township Sch., 504 N.W.2d 635, 640 (Mich. 1993). Because all of Plaintiffs' other claims fail, Plaintiffs' unjust enrichment claim cannot stand. Second, the unjust enrichment claim depends on nothing more than Defendants' allegedly unauthorized use of Plaintiffs' "sound."<sup>24</sup> Thus, the unjust enrichment claim is also pre-empted by the Copyright Act. See Murray Hill, 264 F.3d at 637 (plaintiff's unjust enrichment claim under Michigan law based on defendants' allegedly unauthorized use of song held to be preempted by Copyright Act).

#### **IV. CONCLUSION**

For all of the foregoing reasons, Defendants respectfully requests that this Court grant summary judgment in favor of Defendants and against Plaintiffs, and grant Defendants any further relief that the Court deems just and warranted.

Respectfully submitted,

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<sup>24</sup> Complaint, ¶ 32 ("Defendants have received the benefits of Plaintiffs' identities, persona and distinctive sound by selling the Game.")

**CERTIFICATE OF SERVICE**

I hereby certify that on March 18, 2008, I caused a copy of the foregoing document to be filed with the Court using the ECF system, which will give notice to all counsel of record.

/s/ Herschel P. Fink

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