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Michael S. Newman

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Cover Page Footnote

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**IMITATION IS THE SINCEREST FORM OF FLATTERY,
BUT IS IT INFRINGEMENT?
THE LAW OF TRIBUTE BANDS**

*Michael S. Newman**

INTRODUCTION

The house music fades out and the lights dim; four men in black collarless Edwardian suits, thin ties, and mop top haircuts¹ enter the stage and strum the first note of “A Hard Day’s Night.”² They look like The Beatles. They sound like The Beatles. However, they are not the four lads from Liverpool who became widely known across the country on a first name basis as John, Paul, George, and Ringo.³ It is 2012, there are no screaming teenaged fans, the Ed Sul-

* J.D. Candidate 2012, Touro College Jacob D. Fuchsberg School of Law; B.A. 2006 in Criminal Justice and Psychology, University at Albany, State University of New York. Special thanks to Professor Rena Sepowitz for her support and guidance with this article and to my wife, Lauren Newman, for her love and support.

¹ The look became so synonymous with The Beatles that even courts at the time associated it with them. See, e.g., *Ferrell v. Dallas Indep. Sch. Dist.*, 261 F. Supp. 545, 547 (N.D. Tex. 1966) (“The hair extends down to the ear lobe on the side and to the collar in the back . . . in conformity with the so-called ‘Beatle’ type hair style.”), *aff’d*, 392 F.2d 697 (5th Cir. 1968), *cert. denied*, 393 U.S. 856 (1968).

² THE BEATLES, *A Hard Day’s Night*, on A HARD DAY’S NIGHT (United Artists Records, 1964).

³ The Beatles are John Lennon, Paul McCartney, George Harrison, and Ringo Starr. *The Beatles Biography*, THE ROCK AND ROLL HALL OF FAME AND MUSEUM, <http://rockhall.com/inductees/the-beatles/bio/>. The names John, Paul, George, and Ringo together connote The Beatles, so much so that courts have found that together these names developed secondary meaning as describing The Beatles and were thus worthy of trademark protection. See, e.g., *Apple Corps Ltd. v. A.D.P.R., Inc.*, 843 F. Supp. 342, 348 (M.D. Tenn. 1993) (citing *Apple Corps Ltd. v. Adirondack Group*, 476 N.Y.S.2d 716, 719 (Sup. Ct. 1983) (“The combination of the four names ‘John,’ ‘Paul,’ ‘George,’ and ‘Ringo’ has acquired a secondary meaning and is another term for the group The Beatles.”); *Adirondack Group*, 476 N.Y.S.2d at 719 (“These four names taken together have acquired a secondary meaning, and the Beatles are entitled to protect their name from exploitation.”). Strawberry Fields’ bio page lists its members as impersonators of John Lennon, Paul McCartney,

livan show has been off the air for years,⁴ Shea Stadium no longer stands,⁵ George Harrison and John Lennon have since passed away,⁶ and this is a mid-sized bar in the middle of Long Island, New York. No, they are certainly not The Beatles; they are Strawberry Fields, the ultimate tribute to The Beatles.⁷ The band belts through a set of classic early 1960s Beatles songs and leaves the stage for a costume change.⁸ The lights dim again and the four men return to the stage. This time they are dressed in yellow, pink, red, and blue Nehru-style jackets scattered with medals and patches, with shoulder epaulets, braided ropes draped over the right front breast, stripes across the chest, and corresponding matching color pants;⁹ they begin playing

George Harrison, and Ringo Starr rather than by their respective instruments. *The Ultimate Beatles Tribute Band in Full Costume*, STRAWBERRY FIELDS, <http://www.strawberryfieldsthetribute.com/iframe.php> (last visited Apr. 30, 2012).

⁴ The Ed Sullivan show, one of the most famous American variety shows of all times, aired from 1948 to 1971 and boasted over 10,000 musical performances including introducing The Beatles to America in their television debut on February of 1964. *About Ed Sullivan*, EDSULLIVAN.COM, <http://www.edsullivan.com/about-ed-sullivan> (last visited Nov. 8, 2011). Ed Sullivan passed away on October 13, 1974. *Id.*

⁵ “In what has been called one of the most important rock concerts in the history of the music industry, The Beatles played Shea Stadium on August 15, 1965.” *History of Shea Stadium*, METS.COM, http://newyork.mets.mlb.com/nym/ballpark/she_a_stadium/index.jsp?content=detailed_history (last visited Nov. 8, 2011). The Beatles’ 30-minute performance at Shea Stadium to “[o]ver 60,000 screaming teenage Beatles fans” was “the first major outdoor stadium concert in America . . .” *Id.*

⁶ John Lennon was shot and killed by a crazed fan on December 8, 1980 in front of his home in New York City. *Biography*, JOHN LENNON.COM, <http://www.johnlennon.com/biography> (last visited Nov. 8, 2011). George Harrison died of cancer on November 29, 2001. *George Harrison Biography*, BIOGRAPHY.COM, <http://www.biography.com/people/george-harrison-9206804?page=3> (last visited Nov. 8, 2011).

⁷ “‘Strawberry Fields’ is . . . a look-alike, sound-alike Beatles tribute, dedicated to bringing . . . the audience, as close to a real Beatles concert as you can get. The band features true look-alike performers, handpicked from hundreds of auditionees, who speak in Liverpudlian accents and play on the vintage musical instruments that Beatles fans have come to recognize.” STRAWBERRY FIELDS, *supra* note 3. Other popular Beatles tribute bands include RAIN, 1964, and the Fab Faux.

⁸ Many of the early Beatles songs were “cover songs.” In fact, four out of the twelve songs played by The Beatles at their famous 1965 concert at Shea Stadium were cover songs. *The Beatles Concert Set List at Shea Stadium, New York, NY, USA on August 15, 1965*, SETLIST.FM, <http://www.setlist.fm/setlist/the-beatles/1965/she-a-stadium-new-york-ny-2bd7b08e.html> (last visited Nov. 8, 2011). However, The Beatles are far from a cover band and can be credited with the shift in professional musicians being both performers and songwriters. Brent Giles Davis, Comment, *Identity Theft: Tribute Bands, Grand Rights, and Dramatico-Musical Performances*, 24 CARDOZO ARTS & ENT. L.J. 845, 847 (2006).

⁹ These outfits were worn by The Beatles on the cover of The Beatles 1967 release Sgt. Pepper’s Lonely Hearts Club Band and have come to denote The Beatles. THE BEATLES, SGT. PEPPER’S LONELY HEARTS CLUB BAND (Capitol Records 1990) (1967).

Sgt. Pepper's Lonely Hearts Club Band straight through.¹⁰

Tribute bands, like Strawberry Fields, raise questions regarding the legal implications of these bands on the rights of the original artists to whom they pay tribute. One would think that tribute bands would have to seek approval directly from the original artists and negotiate payments for the use of their songs and, in some cases, identities. These assumptions would be wrong. Tribute bands pay nothing directly to the original artists whom they "pay tribute to" for live performances.¹¹ This is because tribute bands fall through the cracks of the current licensing system for public performances of copyrighted works. Any money that is actually collected for tribute band performances is covered by licenses purchased by venues or promoters,¹² not the bands themselves, and little if any actually reaches the original artist.¹³

"Imitation is the sincerest form of flattery,"¹⁴ but is it infringement? This comment explores the current law governing tribute bands and the legal ramifications of these bands on the rights of the original artists, including potential copyright infringement, trademark infringement and right of publicity claims. The artists, to whom these bands pay tribute, are not appropriately compensated under the current licensing system and lack any control over their tribute band counterparts' exploitation of their works and personae. While there has been a movement toward treating tribute bands as dramatico-musical performances under the current system, this comment argues that an amendment to the Copyright Act or, alternatively, a change to the current licensing system paralleling the treatment of dramatico-musical performances would be more desirable solutions.

¹⁰ *Id.*

¹¹ See *ASCAP Licensing FAQs*, ASCAP <http://www.ascap.com/licensing/licensingfaq.aspx> (last visited Nov. 8, 2011) ("Some people mistakenly assume that musicians and entertainers must obtain licenses to perform copyrighted music or that businesses where music is performed can shift their responsibility to musicians or entertainers. The law says all who participate in, or are responsible for, performances of music are legally responsible. Since it is the business owner who obtains the ultimate benefit from the performance, it is the business owner who obtains the license. Music license fees are one of the many costs of doing business.").

¹² *Id.*

¹³ See *infra* Section II (discussing the distribution of funds under the blanket licensing system).

¹⁴ CHARLES CALEB COLTON, *THE LACON* (1811).

Section I discusses the distinction between cover bands and tribute bands and the legal implications of the two. Currently, apart from potential right of publicity and trademark claims, these bands receive comparable treatment. While they operate under the same system as other live musical performers, the current licensing system fails to take into account the ability of tribute bands to exploit an artist's entire musical catalog. Because the current system works for cover bands, which generally tend to perform on a much lesser scale than tribute bands and vary the songs they perform, making it more difficult to tabulate whose works are being performed, this comment focuses on the legal implications of tribute bands.

Section II examines the current licensing system in depth and demonstrates how tribute bands fall through the cracks under the current system, allowing for a windfall in profits to tribute bands with little, if any, revenue going to the original artists. This section also discusses the exclusive performance rights of copyright holders under the Copyright Act and the function of performing rights organizations.

In Section III, the implications of tribute bands on the original artist's publicity rights are explored. Some tribute bands copy performers down to their physical appearance, such as Kiss tribute bands who paint their faces or Beatles tribute bands who dress like The Beatles and imitate their looks throughout the years, within their performances. This section discusses how this may implicate a right of publicity claim by the original artist and how choice of law can affect a right of publicity claim, demonstrating a need for uniformity in the law.

In Section IV, potential trademark implications of the names of tribute bands are examined. Many, if not all, tribute band names are based on the original artist's name or one of the original artist's most popular songs, exploiting the good will established by the original artist among fans. Most tribute band names are followed by the phrase "a tribute to [insert name of original artist here]," actually using the original artist's name. Additionally, many tribute bands also utilize an aspect of the original artist's logo or image as their own. This section analyzes fair use of trademarks and explores potential consumer confusion, if any, caused by tribute band names.

Section V discusses a movement toward treating tribute bands as dramatico-musical performances under the current system, which

requires grand rights licensing directly from the copyright holder. While this is a desirable solution, such a system would have significant shortcomings and would open the floodgates to litigation, leaving the courts to determine whether a particular act constitutes a dramatico-musical performance. Section VI uses a popular tribute band as an example to demonstrate how such a system would allow many tribute bands to continue falling through the cracks of blanket licenses.

Finally, this comment concludes with a proposed amendment to the Copyright Act specifically addressing tribute bands as potential infringers and a federal recognition of a right of publicity within this context.¹⁵ Several ways for the Copyright Act to deal with tribute bands are proposed. Alternatively, a change to the current licensing system is suggested, urging that performing rights organizations should treat tribute bands as their own distinct category, emulating the current treatment of dramatico-musical performances, requiring permission from and negotiations directly with copyright holders. These recommendations would close the gap that tribute bands have fallen through under the blanket licensing system and allow original artists to share in the success of their imitators and control the use of their identities, while minimizing the need for litigation.

I. THE DISTINCTION BETWEEN COVER BANDS AND TRIBUTE BANDS

The last decade has seen an increase in both tribute and cover bands that perform copyrighted music popularized by other bands.¹⁶ These bands exclusively perform copyrighted works of other artists, often paying little or nothing directly to the copyright holders.¹⁷ “Cover bands” refer to bands, which perform a wide variety of popular artists’ songs, while “tribute bands” refer to bands, which focus

¹⁵ A solution that can be as simple as adding the term “tribute bands” as an additional limitation in the definition of what performing rights societies are capable of licensing under 17 U.S.C. § 101 (2006); or as in depth as creating a separate section in the Copyright Act to specifically address the legal implications of tribute bands on the right of original artists. See *infra* Part VI (proposing such a solution to the legal problems caused by tribute bands).

¹⁶ See, e.g., Krissi Geary, Comment, *Tribute Bands: Flattering Imitators or Flagrant Infringers*, 29 S. ILL. U. L.J. 481, 482 (2005) (“What started in the 1970s with the advent of Elvis Presley impersonators has now grown to countless tribute bands worldwide.”).

¹⁷ ASCAP Licensing FAQs, *supra* note 11.

solely on one artist or band, performing songs exclusively from those artists' catalogs. Tribute bands tend to perform on a larger scale than cover bands, some having both national and international success.¹⁸

For the purpose of this comment, the term "cover band" refers to bands that publicly perform an assortment of songs by a variety of popular artists. This broad definition encompasses a wide range of groups, including the local band at the corner bar that plays the hits from the sixties to today, to the high priced successful wedding band which played at your cousin's wedding last weekend. Rather than focusing on an individual artist, cover bands perform a variety of popular songs by numerous artists, often focusing on a particular style, genre, or time. These bands have increased in popularity in recent years, especially among smaller establishments like bars and restaurants. These bands serve as alternatives to jukeboxes and, in fact, are covered under similar licensing agreements.¹⁹

"Tribute bands," on the other hand, refer to bands that publicly perform songs exclusively by one artist. These bands "pay tribute" to original artists by focusing only on their musical catalog, attempting to recreate their songs live with the utmost accuracy and preci-

¹⁸ See, e.g., The Machine "America's top Pink Floyd show, has forged a 20 year reputation of excellence, extending the legacy of Pink Floyd, while creating another legacy all their own . . . selling out theaters, large clubs and casinos across North and Central America, Europe and Asia." *About The Machine*, THE MACHINE, <http://www.themachinelive.com/about/> (last visited Nov. 8, 2011). Dark Star Orchestra is a Grateful Dead tribute band that has been "[t]ouring nationwide for eleven years to the tune of over 1800 shows since forming . . . draw[ing] national media attention." DARK STAR ORCHESTRA, <http://www.darkstarorchestra.net/NEWSITE/HTML/dso.php?sec=home> (last visited Nov. 8, 2011). "Dark Star Orchestra presents its critically acclaimed live show at esteemed venues from coast to coast and internationally." *Id.* Lez Zeppelin, the all-female tribute to Led Zeppelin, has extensively toured the United States and Europe since its formation in 2004 and "is set to launch a full-length tour of Europe, the United States and Japan . . ." *How It All Started*, LEZ ZEPPELIN, <http://www.lezzeppelin.com/bio> (last visited Nov. 21, 2011).

¹⁹ This system is appropriate for cover bands because it would be a tiresome and difficult process to determine all of the different artists and songs these bands perform. Like a jukebox, on any given night these bands could play any number of songs by various artists. Licenses for jukeboxes are given through the Jukebox License Office, which is a joint venture of all the performing rights organizations in the United States. *ASCAP Licensing FAQs*, *supra* note 11. A single license authorizes holders to publicly "perform virtually every copyrighted song in the United States and much of the world[]" on a juke box. *Id.* "Establishments where music is performed by some means other than the jukebox (DJ's, bands, tapes, etc.), still need a separate license . . ." *Id.* These licenses operate just like blanket licenses except that blanket licenses only allow holders to publicly perform copyrighted works in the issuing performing rights organization's repertory and therefore must be negotiated with each organization separately. *Id.*

sion. While these groups can be further classified along a wide spectrum,²⁰ their overarching similarity, and distinguishable feature from cover bands, is their exclusive focus on one artist. For the purpose of this comment, bands that “pay tribute” to one artist exclusively are “tribute bands.”

Another distinguishing feature between cover bands and tribute bands is that tribute bands are usually named after the original artist to whom they are “paying tribute,” and often make use of the original artist’s name or logo.²¹ Many tribute bands also imitate the original artist’s appearance and dress, especially when the original artist has recognizable distinguishing features, such as face paint or unique clothing.²² The artists to whom these bands pay tribute vary in terms of their reactions to these groups, ranging from supportive to litigious.²³ Surprisingly, these bands are also covered under the same licensing agreements as cover bands and other live musical performers.²⁴

²⁰ See, e.g., Davis, *supra* note 8, at 848 (suggesting a further classification among these acts, distinguishing tribute bands from reverence bands. Reverence bands refer to groups that perform exclusively the songs of one artist, while tribute bands have “the additional attribute of adopting the persona of the original artists through the use of costumes, make-up, stage dress and effects, and/or between-song-patter that quotes the original artist.”). For the purpose of this comment, these bands are treated the same, particularly, to demonstrate why a system classifying tribute bands as dramatico-musical performances under the current system would allow for many tribute bands to continue to fall through the cracks of blanket licenses.

²¹ This feature raises questions regarding fair use of trademarks and potential claims under the Lanham Act for confusion of origin. See *infra* Section IV (discussing whether tribute bands names and use of the original artist’s logos constitute fair use or trademark infringement).

²² Examples include: Kiss, whose members would be unrecognizable to most of the public absent their black and white face paint, leather outfits and platform shoes; David Bowie’s image as Ziggy Stardust; Alice Cooper with his signature black eye make-up; and Marilyn Manson, who has several recognizable personae.

²³ Compare Bon Jovi who threatened legal action against its all-female tribute band “Blonde Jovi” (see Gerry Gittelton, *All-girl Blonde Jovi changes name, still channels Jersey boys*, DAILY NEWS, http://www.dailynews.com/music/ci_12134524 (last visited Nov. 12, 2011)), with The Grateful Dead whose members have performed on stage with its tribute band Dark Star Orchestra and even recruited its guitar player John Kadlecik to form Furthur to the tour the country performing the Grateful Dead catalog to legions of “dead heads.” See FURTHUR, <http://www.furthur.net/band> (last visited Apr. 30, 2012). See also Steve Baltin, *Queen Putting Together Own Tribute Band for 2012 Tour*, ROLLING STONE MAGAZINE (Sept. 19, 2011 9:00 AM), <http://www.rollingstone.com/music/news/exclusive-queen-putting-together-own-tribute-band-for-2012-tour-20110919> (reporting that Queen is currently auditioning members to create their own tribute band to tour for them in 2012).

²⁴ When a band focuses exclusively on one artist, it is a much easier task to require per-

Like original bands, tribute bands vary in terms of success. Some tribute bands are strictly local in nature, playing few performances for small crowds and make little, if any, money. However, as indicated above, some tributes bands have both national and international success.²⁵ These successful tribute bands raise questions regarding the fairness of the current licensing system.

II. THE CURRENT SYSTEM: BLANKET LICENSES, THE COPYRIGHT HOLDERS WET BLANKET

Among the bundle of rights granted to copyright holders is the exclusive right to perform their works publicly.²⁶ The Copyright Act defines a public performance as a performance “at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered”²⁷ A strict interpretation of the Copyright Act would lead one to believe that only the copyright holder could perform his or her work publicly. However, everyone knows from walking into any public place, from the supermarket to a bar, that this is not the case. Copyrighted music is “performed publicly” everywhere, but these performances do not infringe upon the rights of the copyright owner when done with permission.²⁸

But how does one obtain permission to perform copyrighted

mission directly from the copyright holder. *See infra* Section II (discussing the current licensing system governing the public performance of copyrighted works under which tribute bands operate).

²⁵ *See supra* note 18 (providing several examples of tribute bands with both national and international success).

²⁶ 17 U.S.C. § 106(4) (2006) provides in pertinent part: “[I]n the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, [the copyright owner has the exclusive right] to perform the copyrighted work publicly”

²⁷ 17 U.S.C. § 101. ASCAP adopts the statutory definition of public performances in determining what type of performances require licenses and offers additional insight as to what constitutes a public performance requiring a license: “A public performance is also one that is transmitted to the public; for example, radio or television broadcasts, music-on-hold, cable television, and by the internet. Generally, those who publicly perform music obtain permission from the owner of the music or his representative.” *ASCAP Licensing FAQs*, *supra* note 11.

²⁸ Section 106 gives the copyright holder the exclusive right to authorize the public performance of his or her musical works. 17 U.S.C.A. § 106(4). Those who publicly perform copyrighted works without permission of the copyright holder through licensing agreements are infringing upon his or her rights secured under section 106 of the Copyright Act. *Id.*

works? Clearly, it would be a daunting task for an individual copyright owner to attempt to enforce his or her own exclusive right to publicly perform without assistance.²⁹ It would be equally as difficult for users to legally “perform” copyrighted works if they needed to deal directly with each individual copyright holder whose works they wanted to use.³⁰ Performing rights organizations developed to assist in this task.³¹

Performing rights organizations negotiate licenses for the use of copyrighted works and collect fees on behalf of copyright holders for the public performance of their works.³² The three major performing rights organizations involved in collecting royalties for the public performances of copyrighted works in the United States are: American Society of Composers, Authors and Publishers (“ASCAP”), Broadcast Music, Inc. (“BMI”), and The Society of European Stage Authors and Composers (“SESAC”). They all basically operate the same, providing licenses on behalf of copyright holders that give licensees the right to publicly perform any of the millions of songs included in their repertoires.³³

²⁹ See 2 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §8-14[E] at 136 (rev. ed. 2011) (“Musical performances are given so widely that no one copyright owner could police all performances of his music or collect the royalties due him.”).

³⁰ *Id.* “[P]ersons who give performances of many musical works, such as broadcasters, would find it impractical to obtain licenses from, and pay royalties to, each of the many copyright owners individually.” *Id.*

³¹ The Copyright Act defines a performing rights society as “an association, corporation, or other entity that licenses the public performance of nondramatic musical works on behalf of copyright owners of such works” 17 U.S.C. § 101. However, there is no specific provision in the Copyright Act creating these organizations nor is there a specific provision or separate statute regulating their practices. NIMMER, *supra* note 29, at 137. Performing rights organizations are creatures of necessity and a source of controversy and debate in Congressional hearings. *Id.*

³² 17 U.S.C. § 101.

³³ *Id.* “[T]here has been official recognition of the need for these organizations and of the necessity to guard against abuses of their monopolistic position.” NIMMER, *supra* note 29, at 137. “Antitrust proceedings by the Department of Justice resulted in the acceptance . . . [of] consent decrees contain[ing] a variety of requirements designed to prevent discrimination in the licensing of public performances.” *Id.* “[T]he ASCAP decree provides that any user may petition the court to review its royalty rates, and contains provisions regulating its admission of members, its internal organization and voting structure, and its distribution of revenue.” *Id.* Arguably, pursuant to this decree artists that are the subject of tribute bands have standing to challenge the current blanket license system in regard to tribute bands. Rather than risking potential negative publicity by bringing suit against one of these acts to contest their exploitation of the current licensing system, an artist may petition a court to challenge the inclusion of tribute bands under the blanket licenses offered by the performing rights organizations.

A common method used by these organizations are blanket licenses, which involve “the pooling and licensing of copyrighted items in a single package which allows the licensee to use any and all of the items in the package as often [as] they desire.”³⁴ Blanket licenses permit tribute bands to exploit an artist’s entire repertoire without having to directly compensate or seek permission from the original artists to whom they pay tribute.³⁵ Tribute bands should be excluded from coverage from these licenses which are designed to relieve users from the burden of negotiating with numerous copyright holders. Because tribute bands focus exclusively on one artist, it is a much easier task to require permission directly from the copyright holder. However, under the current system, no direct permission is required because the owners of the establishments where tribute bands perform are responsible for purchasing blanket licenses allowing for a windfall in profits to tribute bands.³⁶

ASCAP provides over one hundred different types of blanket licenses that vary in price, depending on the type of business seeking the license, covering millions of copyrighted works.³⁷ “Generally, rates are based on the manner in which music is performed (live, recorded or audio only or audio/visual) and the size of the establishment or potential audience for the music.”³⁸ Other factors taken into consideration are the number of nights per week music is offered, and whether admission is charged.³⁹ Venues that have live musical performances obviously pay a higher rate for their blanket license, but the end-all of the blanket licensing system is that they allow licensees to use copyrighted works as little or as much as they like.⁴⁰

³⁴ ALAN S. GUTTERMAN, 17 BUSINESS TRANSACTIONS SOLUTIONS § 82:86. According to ASCAP, a “blanket license saves music users the paperwork, trouble and expense of finding and negotiating licenses with all of the copyright owners of the works that might be used during a year and helps prevent the user from even inadvertently infringing on the copyrights of ASCAP’s members and the many foreign writers whose music is licensed by ASCAP in the U.S.” *Common Music Licensing Terms*, ASCAP, <http://www.ascap.com/licensing/termsdefined.aspx> (last visited Nov. 8, 2011). However, the use of these licenses overlooks their potential abuses, particularly by tribute bands.

³⁵ *Id.*

³⁶ *ASCAP Licensing FAQs*, *supra* note 11.

³⁷ *Do You Need an ASCAP License?*, ASCAP, <http://www.ascap.com/licensing/> (last visited Nov. 8, 2011).

³⁸ *ASCAP Licensing FAQs*, *supra* note 11.

³⁹ *Id.*

⁴⁰ GUTTERMAN, *supra* note 34.

The use of blanket licenses raises questions about how copyright holders receive compensation for the public performances of their works. According to ASCAP, its payment system is based on a “follow the dollar principle.”⁴¹ Under the follow the dollar system “ASCAP receives payment for public performances of songs and compositions by negotiating license fees with the users of music (radio, TV, cable, bars, clubs, restaurants, shopping malls, concert halls and promoters, web sites, airlines, orchestras, etc.) and distribut[es] these monies to members whose works were performed.”⁴² However, after issuing a blanket license, it would be impossible for ASCAP to monitor all of the copyrighted works used by a particular licensee so that funds are passed along to copyright holders in proportion to the use of their works.⁴³ This is one area in which the current licensing system fails. “The monies collected from these establishments goes into a ‘general’ licensing fund and [are] paid out to members on the basis of feature performances on radio and all surveyed performances on television.”⁴⁴ Therefore, original artists who are the objects of tribute are not compensated for tribute band performances at venues that have blanket licenses unless they are currently receiving airtime on radio and television.⁴⁵ However, many tribute bands “pay tribute” to bands that never had commercial success in terms of television and radio airplay, such as the Grateful Dead and Phish whose fame and legacies stem from their live performances.⁴⁶

While the use of blanket licenses is justified to limit the ex-

⁴¹ According to ASCAP, “[f]ollow-the-dollar’ is the chief principle underlying the survey and distribution system: The royalty distributions made to members for performances in each licensed medium should reflect the license fees paid by or attributable to users in that medium.” *ASCAP’s Survey and Distribution System: Rules and Policies*, ASCAP, <http://www.ascap.com/members/governingDocuments/pdf/drd.pdf> (last visited Nov. 8, 2011). However, performances at venues with blanket licenses are not included in these surveys and therefore tribute performances at these venues do not “follow-the-dollar.”

⁴² *ASCAP Payment System*, ASCAP, <http://www.ascap.com/members/payment/> (last visited Nov. 8, 2011).

⁴³ ASCAP acknowledges that “it would be impractical to monitor all performances in bars, clubs, restaurants and the like. ASCAP licenses tens of thousands of music users . . . that do not fall into the ASCAP surveys[,]” and therefore royalties paid by these licensees do not get passed along to the copyright holder under the “follow the dollar principle.” *Id.*

⁴⁴ *Id.*

⁴⁵ *Id.*

⁴⁶ For an excellent example of how the current licensing system fails these types of bands see Davis, *supra* note 8, at 858-59 (using a hypothetical involving the band Phish to demonstrate how the current system fails to compensate original artists who do not receive regular radio or television airplay that are the subject of tribute bands).

pense and difficulty of negotiating licenses with various copyright owners, when a band is exclusively performing the songs of one artist, this no longer presents an issue. Tribute bands can easily negotiate directly with original artists for the use of their works and in some cases personae. Furthermore, because tribute bands tend to call into question other rights of original artists, such as the right of publicity, they should be explicitly excluded from coverage under blanket licenses.

III. THE RIGHT OF PUBLICITY

Tribute bands, particularly those that pay homage to bands that dress up in a particular manner or paint their faces, walk a fine line in regard to whether they are violating the original artists' right of publicity. The right of publicity is a legal doctrine that grants an individual the exclusive right to commercially exploit his or her own identity for profit.⁴⁷ While imitation is the sincerest form of flattery, these types of tribute bands raise questions as to whether their acts infringe on the original artist's right of publicity.⁴⁸

The right of publicity has been defined as "the inherent right of every human being to control the commercial use of their identity."⁴⁹ It "denote[s] both a right to prevent commercial use of [one's] identity and the corresponding right to grant an exclusive privilege" to another to commercially use one's name and likeness.⁵⁰ The right of publicity favors requiring tribute bands to seek permission from the original artists they pay tribute to, so that original artists can maintain control over the goodwill associated with their identities.⁵¹

⁴⁷ Judge Jerome Frank can be credited with coining the term "right of publicity" to describe this right in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953) (recognizing the right of ball players to license the use of their names for commercial purposes). It has now "become a widely recognized commercial tort to use a person's identity for advertising without getting permission." J. THOMAS MCCARTHY, 1 RIGHTS OF PUBLICITY AND PRIVACY § 1:38 (2d ed. 2011).

⁴⁸ This question does not have a universal answer because state law governs the right of publicity. Furthermore, not all states recognize the right of publicity. MCCARTHY, *supra* note 47, § 6:3. ("[U]nder either statute or common law, the right of publicity is recognized as the law of 31 states.")

⁴⁹ *Id.* at § 1:3.

⁵⁰ *Id.* at § 1:26 (interpreting the court's decision in *Haelan Laboratories*, 202 F.2d 866).

⁵¹ Courts have recognized that "[t]he theory of the right [of publicity] is that a celebrity's identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity." *Carson v.*

After all, tribute bands are using the original artists' identities for commercial gain, which the right of publicity is designed to protect.⁵² For the purpose of this section's analysis, the term "unlicensed" denotes whether a tribute band has received permission from the original artist, to whom it is paying tribute, rather than the licenses provided by performing rights organizations, discussed above.⁵³

The right of publicity has evolved since its inception and, at least in some jurisdictions, has come to protect one's likeness,⁵⁴ name,⁵⁵ persona,⁵⁶ catch phrase,⁵⁷ and even voice.⁵⁸ Clearly, to assert this right, individuals must be recognizable by the public; otherwise they would have no commercial interest in their identity and therefore no need for protection. The State's interest in protecting the commercial exploitation of celebrity identities through the right of publicity is similar to the goals of patent, trademark, and copyright law.⁵⁹ "[T]he State's interest in permitting a 'right of publicity' is in protecting the proprietary interest of the individual in his act in part *to encourage such entertainment*."⁶⁰

The right of publicity can be fairly described as "a state-law created intellectual property right whose infringement is a commercial tort of unfair competition."⁶¹ Because there is no federal coun-

Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 835 (6th Cir. 1983).

⁵² MCCARTHY, *supra* note 47, at § 1:26.

⁵³ See *supra* Section II (discussing the blanket licensing system).

⁵⁴ See *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 811 (9th Cir. 1997) (holding that robot replicas of the characters Norm and Cliff from the television series *Cheers* violated the actors' rights of publicity because of the robots' physical likeness to the actors).

⁵⁵ See *Haelan Laboratories*, 202 F.2d 866 (discussing the right of ball players to license the use of their names for commercial purposes).

⁵⁶ See *White v. Samsung Elecs. Am.*, 971 F.2d 1395 (9th Cir. 1981) (holding that an advertisement resembling the persona of *Wheel of Fortune*'s Vanna White violated her right of publicity).

⁵⁷ See *Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (holding that the unauthorized use of the phrase "Here's Johnny" violated Johnny Carson's right of publicity).

⁵⁸ See *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (holding that an advertisement intending to copy Bette Midler's voice in a commercial violated her right of publicity).

⁵⁹ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 573 (1977) ("[T]he State's interest is closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation.").

⁶⁰ *Id.* (footnote omitted) (emphasis added).

⁶¹ MCCARTHY, *supra* note 47, at § 3:1. However, the right of publicity has aspects of both property law and torts and therefore its proper classification is really in the eyes of the beholder. *Id.* "If one looks at it from the point of view of plaintiff's right, the right of publicity

terpart under the Copyright Act, state law, which governs publicity right claims, is generally not preempted.⁶² Therefore, a tribute band performance may constitute an infringement on an original artist's right of publicity in one state, but not another, making choice of law of crucial importance to a right of publicity claim.⁶³

Because the right of publicity is a creature of state law, courts have applied different tests to determine whether an individual's right of publicity has been infringed. For example, some courts have applied the copyright fair use series of factors, which examine "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes[,] the nature of the [use,] the amount and substantiality of the [use] and effect of the use upon the potential market"⁶⁴ Other courts have adopted aspects of trademark law and ask whether a defendant's use of plaintiff's "identity" causes consumer confusion.⁶⁵ Other courts utilize an "identifiability test," which simply speaks in terms of whether defendant's use identifies the plaintiff.⁶⁶ The test that a court

is clearly 'property' capable of being licensed and of being 'trespassed' upon." *Id.* However, "[i]f one looks at it from the point of view of the defendant's 'wrong,' invasion or infringement of the right of publicity is clearly a 'tort' of 'unfair competition.'" *Id.*

⁶² "Copyright protection subsists . . . in original *works of authorship fixed in any tangible medium of expression*, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." 17 U.S.C. § 102(a) (2006) (emphasis added). "The right of publicity will on rarely be preempted under Section 301[]" because generally "the subject matter of the right of publicity will not be fixed in a tangible medium expression . . ." PAUL GOLDSTEIN & R. ANTHONY REESE, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES, 161 (6th ed. 2008). However, Section 301 will preempt a state right of publicity if "the subject matter of protection is fixed in a tangible medium of expression; the subject matter comes within the subject matter of copyright under sections 102 and 103 of the Copyright Act; and the state right is equivalent to one or more rights granted by section 106 of the Copyright Act." *Id.*

⁶³ See, e.g., *Experience Hendrix, L.L.C. v. HendrixLicensing.com, LTD*, 766 F. Supp. 2d 1122, 1130 (W.D. Wash. 2011) (demonstrating how choice of law was determinative to the survivability of late musician Jimi Hendrix's right of publicity claim).

⁶⁴ 17 U.S.C. § 107 (2006); see, e.g., *Apple Corps. Ltd. v. Leber*, 229 U.S.P.Q. 1015, 1017 (Cal. Super. 1986) (applying the copyright fair use factors to determine whether a Beatles tribute band infringed upon The Beatles' right of publicity).

⁶⁵ See, e.g., *Presley's Estate v. Russen*, 513 F. Supp. 1339, 1377-78 (D.N.J. 1981) (discussing consumer confusion caused by an Elvis impersonation performance); see also Geary, *supra* note 16, at 494-95.

⁶⁶ The identifiability test seeks to determine "whether a 'significant' or more than de minimis number of persons can reasonably identify plaintiff from the total context of defendant's use." MCCARTHY, *supra* note 47, at § 3:21. See *Henley v. Dillard Dept. Stores*, 46 F. Supp. 2d 587, 591 (N.D. Tex. 1999) ("A person's right of publicity may be violated when a defendant employs an aspect of that person's persona in a manner that symbolizes or identi-

applies can be determinative as to the success of a right of publicity claim.

While the elements of a cause of action may differ among the states that recognize the right of publicity, a prima facie case generally requires proof of three factors.⁶⁷ First, a plaintiff must demonstrate a commercial interest in his or her identity.⁶⁸ Second, the defendant must have commercially used some aspect of the plaintiff's identity without permission.⁶⁹ Finally, the defendant's use must have caused some type of damage.⁷⁰

Applying these elements to an unlicensed tribute band performance leads to the conclusion that tribute bands, which copy the original artists they pay homage to down to dress and style, are likely infringing upon those artists' right of publicity. The first element is satisfied by the existence of a tribute band alone. Original artists who do not have some commercially valuable aspect in their identities would not be the subject of a tribute band. The second element is easily satisfied by any "unlicensed" tribute band performance in which the tribute band is paid because this constitutes a commercial use of an original artist's identity. Finally, the third element is satisfied after the first two elements are proven because at least some damages are presumed.⁷¹

In *Apple Corps v. Leber*,⁷² a California court confronted the question of whether a Beatles tribute band called Beatlemania⁷³ vi-

fies the person . . .").

⁶⁷ THOMAS PHILLIP BOGGESS, 31 CAUSES OF ACTION 2D 121 (2d ed. 2006). In an action for the infringement of the right of publicity, the plaintiff has the burden to establish the prima facie case by a preponderance of the evidence. *Id.*

⁶⁸ *Id.*

⁶⁹ *Id.*

⁷⁰ *Id.* However, "[s]ome damage to the commercial value of identity is presumed once it is proved that defendant has made an unpermitted use of some identifiable aspect of identity in such a commercial context that one can state that such damage is likely." MCCARTHY, *supra* note 47, at § 3:2.

⁷¹ *Id.*

⁷² 229 U.S.P.Q. 1015 (Cal. Super. 1986).

⁷³ "Beatlemania consisted of Beatles look-alike, sound-alike, imitators performing live on stage twenty-nine of the more popular Lennon-McCartney songs, to a mixed media background, and foreground of slides, and movies which depicted a whole variety of subjects, many of which related to events occurring during the 1960's." *Id.* at 1016. The band toured the country playing eight shows per week for over three years to millions of fans, grossing forty-five million dollars, without the consent of The Beatles. *Id.* at 1017.

olated The Beatles' right of publicity.⁷⁴ *Leber* is illustrative of the many issues a court must deal with when presented with a right of publicity claim against a tribute band. Specifically, the court had to address both choice of law and the appropriate governing test,⁷⁵ as well as the conflict between the right of publicity and the First Amendment.⁷⁶ Additionally the court was faced with the argument that an original artist who is the subject of a tribute band is sufficiently compensated by royalties paid through licenses for the public performance of copyrighted works.⁷⁷

The court in *Leber* applied the copyright fair use series of factors test to determine if the defendants violated The Beatles' right of publicity.⁷⁸ The court concluded that the defendants' use of The Beatles' identities would have violated the group's right of publicity under any standard.⁷⁹ In regard to the defendants' First Amendment defense, the court cited *Estate of Presley v. Russen*,⁸⁰ an Elvis impersonation case, for the proposition that "entertainment which merely imitates, does not have a creative component of its own and is not protected by the First Amendment."⁸¹ In other words, pure imitation—such as a tribute band performance—is not transformative and thus does not warrant First Amendment protection.⁸² Additionally,

⁷⁴ *Id.* at 1016.

⁷⁵ *Id.* at 1017. Choice of law was an issue in this case because the parties were not citizens of California. Beatlemania was a traveling show originating out of New York and Apple was from England. The court applied New York law and adopted the copyright fair use factors finding support in the Supreme Court's decision *Zacchini*. *Leber*, 229 U.S.P.Q. at 1017.

⁷⁶ *Id.* at 1016; "[The] defendants . . . contended that Beatlemania was not simply imitation, but rather an historical overview of the 1960's, and that the mixed media material contained significant political and social comment upon that era, all of which shields defendants with the protection of the First Amendment." *Id.* However, the court rejected this argument finding that the primary purpose of the show was the commercial exploitation of The Beatles' personae for profit. *Id.* at 1017.

⁷⁷ The defendants raised what the court called the "no harm, no foul defense" alleging that The Beatles suffered no out-of-pocket losses as a result of their tribute band. *Id.* However, the court rejected this argument as some damages are presumed from the unauthorized use. *Leber*, 229 U.S.P.Q. at 1018.

⁷⁸ *Id.* at 1017.

⁷⁹ *Id.*

⁸⁰ *Estate of Elvis Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981) (where the estate of Elvis Presley obtained a preliminary injunction against a stage show which featured a performer who sang songs popularized by Elvis and who imitated Elvis's voice and appearance).

⁸¹ *Leber*, 229 U.S.P.Q. at 1016 (citing *Estate of Elvis Presley*, 513 F. Supp. 1339).

⁸² *Id.*

the court rejected the defendants' so-called "no harm, no foul defense," holding that it was not necessary for The Beatles to prove any out of pocket loss because the harm consisted in the taking of a right and the measure of damages was the reasonable value of what was taken.⁸³

Leber is an excellent example of how tribute bands infringe upon the publicity rights of the artists they pay tribute to, and how courts are likely to rule in similar cases. The court in *Leber* ultimately concluded that Beatlemania "amounted to virtually a complete appropriation of The Beatles 'persona' . . . [and that the] primary purpose of Beatlemania, live on stage, was the commercial exploitation of The Beatles['] persona, goodwill and popularity."⁸⁴ The court in *Leber* also found that Beatlemania constituted unfair competition, and led to consumer confusion as to endorsement and source of origin.⁸⁵ Often times, right of publicity claims are accompanied by trademark infringement claims and other unfair competition claims.⁸⁶ If such a claim were brought against a tribute band, a court would have to determine whether the tribute band is protected by fair use.

IV. FAIR USE OR TRADEMARK ABUSE?

Tribute bands profit from the goodwill of the artists to whom they pay tribute and raise questions as to whether they are infringing, diluting, or tarnishing the original artists' trademark rights. Trademark law and unfair competition law were developed to protect the goodwill of businesses with the public.⁸⁷ As with all businesses, brand recognition and public goodwill are essential to the profitability of bands. Bands are businesses and band names are the brands that

⁸³ *Id.* at 1017-18 (internal quotation marks omitted).

⁸⁴ *Id.* at 1017.

⁸⁵ *Id.*

⁸⁶ *See, e.g., White*, 971 F.2d at 1399 (where Vanna White's right of publicity claim was accompanied by a Section 43(a) claim); *Here's Johnny Portable Toilets, Inc.*, 698 F.2d at 833 (where Johnny Carson's right of publicity claim was accompanied by a section 43(a) claim).

⁸⁷ "Since at least the middle ages, trademarks have served primarily to identify the source of goods and services, 'to facilitate the tracing of 'false' or defective wares and the punishment of the offending craftsman.'" *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 305 (9th Cir. 1992) (quoting FRANK I. SCHECHTER, *THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARKS* 47 (1925)).

sell their records, clothing, and concert tickets.⁸⁸

As discussed above, tribute bands are often named after the original artist to whom they are “paying tribute” and use the original artist’s logo in their advertising, exploiting the goodwill developed by the original artist among fans.⁸⁹ Tribute band names are often a play on the original artist’s name or most famous song titles.⁹⁰ Names that are extremely similar to the original artists’ names, such as “Blonde Jovi”⁹¹ and “Lez Zeppelin,”⁹² may cause consumer confusion in and of themselves.⁹³ However, tribute bands named after song title,⁹⁴ may also constitute infringement because of the secondary meaning relating to the band.⁹⁵ Tribute band names and advertisements raise

⁸⁸ “A band name may function as a service mark for ‘entertainment services in the nature of performances by a musical group’ if it is used to identify live performances.” *Trademarks FAQs*, THE UNITED STATES PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/faq/trademarks.jsp> (last visited Nov. 17, 2011).

⁸⁹ See *supra* Section I (discussing how many tribute bands use an aspect of the original artist’s name or logo).

⁹⁰ See, e.g., Bad Fish “A Tribute to Sublime” (named after the Sublime song “*Bad Fish*” released on 40 OZ. TO FREEDOM (MCA 1992)); Big Shot “The ultimate Billy Joel experience” (named after the Billy Joel song “*Big Shot*” from 52ND STREET (Family Productions/Columbia 1978)); Dark Star Orchestra (named after the Grateful Dead song “*Dark Star*” released as a single (Warner Bros. 1968)); Strawberry Fields “The ultimate Beatles tribute band in full costume” (named after The Beatles song “*Strawberry Fields Forever*” released as a single (Capitol 1967)); The Machine named after the Pink Floyd song “*Welcome to the Machine*” from WISH YOU WERE HERE (Columbia/Capitol 1975)).

⁹¹ The all-female Bon Jovi tribute band was forced to change its name to Blonde Jersey due to legal threats from Bon Jovi. See Ted Casablanca, *Bon Jovi Stupidly Sues Its Own Tribute Band*, E!ONLINE (Apr. 8, 2009 6:31 AM), http://www.eonline.com/news/bon_jovi_stupidly_sues_its_own_tribute_Band/117489. See Gittelsohn, *supra* note 23.

⁹² Lez Zeppelin is “the New York City-based all-girl band [who] has gained worldwide critical acclaim for the musicianship, passion and gender-bending audacity they bring to the music of Led Zeppelin.” LEZ ZEPPELIN, *supra* note 18. The band describes itself as “the authentic female counterpart to one of the greatest rock groups of all time.” *Id.*

⁹³ In 2008, Lez Zeppelin’s scheduled appearance at the Bonnaroo Festival sparked worldwide media attention when several major press organizations mistakenly reported that *Led Zeppelin* rather than Lez Zeppelin would be headlining the festival. See *id.*

⁹⁴ “As a general rule, the title of a work of art or entertainment is uncopyrightable. However, a title may be the protectable subject matter of trademark or unfair competition law if it is distinctive or has acquired secondary meaning.” GOLDSTEIN & REESE, *supra* note 61, at 255. Tribute bands which use an original artist’s song title as a band name are, without question, intending to invoke the secondary meaning associated with the original artist in the mind of the public.

⁹⁵ “In determining whether a mark has acquired a secondary meaning, certain evidentiary factors are appropriate to consider: (1) the length and manner of its use, (2) the nature and extent of advertising and promotion of the mark, and (3) the efforts made to promote a conscious connection, in the public’s mind, between that mark and a single source.” LOUIS ALTMAN & MALLA POLLACK, 3 CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND

questions as to whether they constitute trademark infringement and source of origin confusion under the Lanham Act.⁹⁶ The question raised is whether tribute bands are protected by fair use.

In *New Kids on the Block v. News America Publishing, Inc.*,⁹⁷ the Ninth Circuit established a three-part test to determine whether a defendant can assert the nominative fair use defense.⁹⁸ The *New Kids on the Block* test for nominative fair use has three elements:

First, the product or service in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.⁹⁹

Applying the *New Kids on the Block* test to tribute band names, it is debatable whether tribute bands can successfully assert the nominative fair use defense. As for the first element, tribute bands would not be able to properly identify themselves without acknowledging to whom they are paying tribute. A court would likely determine that

MONOPOLIES § 20:29 (4th ed. 2011) (citations omitted).

⁹⁶ 15 U.S.C. § 1125 (2006).

⁹⁷ 971 F.2d 302 (9th Cir. 1992). *New Kids on the Block* involved the question of whether the use of the band's name by newspapers for polls constituted fair use. *Id.* at 308. The court held that the newspapers were entitled to the nominative fair use defense because they only referred to the New Kids on the Block trademark as needed to identify the group as the subject of their poll and did nothing that would suggest sponsorship or endorsement by the group. *Id.*

⁹⁸ *Id.* For another approach to nominative fair use see *Century 21 Real Estate Corp. v. Lendingtree, Inc.*, 425 F.3d 211, 222 (3d Cir. 2005) (where the Third Circuit adopted a bifurcated test to apply in nominative fair use cases). Under the Third Circuit's approach, a plaintiff must first prove that a defendant's use of the plaintiff's mark is likely to cause confusion. *Id.* Once this is proven, the burden shifts to the defendant to show:

(1) that the use of plaintiff's mark is necessary to describe both the plaintiff's product or service and the defendant's product or service; (2) that the defendant uses only so much of the plaintiff's mark as is necessary to describe plaintiff's product; and (3) that the defendant's conduct or language reflect the true and accurate relationship between plaintiff and defendant's products or services.

Id. It is arguable whether application of the 21st Century test would lead to a different result. Determinative to this inquiry would be whether the original artist could prove, at the outset, that a tribute band is likely to cause consumer confusion, shifting the burden to the tribute band. *Id.*

⁹⁹ *New Kids on the Block*, 971 F.2d at 308.

tribute bands satisfy this requirement. As to the second element, which involves a fact specific inquiry, a court would probably find the standard “a tribute to [insert name of original artist here]” constituted permissible nominative fair use because, again, it is reasonably necessary for a tribute band to identify itself as a tribute to the original artist. The third element requires an even greater fact specific inquiry, and raises additional legal implications of tribute bands on the rights of original artists. Specifically, consumer confusion as to source of origin and endorsement must be avoided under this prong.

Tribute bands must avoid consumer confusion as to endorsement by the original artist to allow them to successfully assert a nominative fair use defense and defeat an action by the original artist under the Lanham Act for source of origin confusion.¹⁰⁰ Under Section 43(a) of the Lanham Act:

(1) Any person who, on or in connection with any goods or services . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) 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 . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.¹⁰¹

Therefore, tribute bands must avoid the use of words such as “official,” “authentic,” “ultimate” and the like, because they may lead to consumer confusion and be actionable under Section 43(a) of the Lanham Act.

Under any of the prevalent tests to determine consumer confusion, courts conduct a fact specific inquiry, examining the totality of the circumstances, which could lead to different results depending

¹⁰⁰ 15 U.S.C. § 1125.

¹⁰¹ *Id.*

on the extent of a tribute band's use of the original artist's mark.¹⁰² The current licensing system fails to take into account the trademark and unfair competition issues presented by tribute bands. A new system must be developed that addresses the various legal implications of tribute bands on the rights of original artists.

V. A GRAND SOLUTION: TREATING TRIBUTE BANDS AS DRAMATIC WORKS REQUIRING GRAND RIGHTS FROM COPYRIGHT HOLDERS

There has been a movement toward treating tribute bands as dramatic performances under the current system, requiring grand licenses from the copyright holders, whose origin can fairly be attributed to an article entitled *Identity Theft: Tribute Bands Grand Rights, and Dramatico-Musical Performances* ("Identity Theft").¹⁰³ In *Identity Theft*, the author, Brent Giles Davis, discussed the law applicable to tribute bands and concluded that tribute bands constitute dramatico-musical performances, which require grand licensing from copyright holders.¹⁰⁴ Under this theory, the courts must determine

¹⁰² The Second Circuit's *Polaroid* factors for likelihood of confusion examine the: (1) strength of the trademark; (2) similarity of the marks; (3) proximity of the products and their competitiveness with one another; (4) evidence that the senior user may "bridge the gap" by developing a product for sale in the market of the alleged infringer's product; (5) evidence of actual consumer confusion; (6) evidence that the imitative mark was adopted in bad faith; (7) respective quality of the products; and (8) sophistication of consumers in the relevant market.

Star Indus., Inc. v. Bacardi & Co. Ltd., 412 F.3d 373, 384 (2d Cir. 2005) (citing *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492, 495 (2d Cir. 1961)). According to the Ninth Circuit's *Sleekcraft* decision:

factors relevant to a likelihood of confusion include: (1) strength of the plaintiff's mark; (2) relatedness of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; (7) defendant's intent in selecting the mark; (8) likelihood of expansion of the product lines.

White, 971 F.2d at 1400 (citing *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979)). See also *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (listing thirteen factors that should be considered in determining consumer confusion).

¹⁰³ Brent Giles Davis, Comment, *Identity Theft: Tribute Bands, Grand Rights, and Dramatico-Musical Performances*, 24 CARDOZO ARTS & ENT. L.J. 845, 847 (2006).

¹⁰⁴ One caveat of this analysis is that the author limited tribute bands to those that adopt "the persona of the original artists through the use of costumes, make-up, stage dress and effects, and/or between-song patter that quotes the original artist." *Id.* at 848 (distinguishing

whether a tribute band constitutes a dramatico-musical performance, and then use the current grand rights licensing system already in place.¹⁰⁵ The author reasoned that tribute band performances constitute dramatico-musical performances because “the story being told by a tribute band is the story of a performance by the original artist.”¹⁰⁶

A major supporter of this position is Gail Zappa, the wife of late musician Frank Zappa and personal representative of Zappa’s estate.¹⁰⁷ In recent years, Gail Zappa has pursued “non-licensed” bands that perform Frank Zappa’s music asserting copyright, trademark, and publicity right violations.¹⁰⁸ She has been using legal threats in an attempt to discourage unauthorized performances of Frank Zappa’s music, accusing tribute bands of “identity theft.”¹⁰⁹ Gail Zappa alleges that bands cannot play her late husband’s music up to par and therefore tarnish his image.¹¹⁰

In January 2009, the attorneys for the Zappa Family Trust sent a cease and desist letter to Talent Associates, Ltd., the talent agency representing the Paul Green School of Rock All Stars who had a tour scheduled billed as “Napoleon Murphy Brock Performs ZAPPA with the Paul Green School of Rock All Stars.”¹¹¹ Pursuant to the letter, the attorneys for the Zappa Family Trust asserted that although the venues of the tour’s scheduled performances may have obtained a blanket license to publicly perform copyrighted works, including the works of the late Frank Zappa, “such a license does not

“tribute bands” from “reverence bands”).

¹⁰⁵ *Id.* at 882.

¹⁰⁶ *Id.* at 870. The author provided an excellent example of the Grateful Dead tribute band Dark Star Orchestra which reenacts full set lists that have been performed by the Grateful Dead and how that band satisfies the proposed test to determine whether an act constitutes a dramatico-musical performance. *Id.* at 870-71.

¹⁰⁷ Joel Rose, *Frank Zappa: A ‘Lumpy’ Legacy*, NPR (Apr. 9, 2009) <http://www.npr.org/templates/story/story.php?storyId=102907874&sc=fb&cc=fp> [herein after NPR].

¹⁰⁸ *Id.* The Zappa family does endorse some tribute bands, specifically Zappa Plays Zappa, a band fronted by Frank and Gail Zappa’s son Dweezil, but Gail Zappa maintains she isn’t “playing favorites.” *Id.*

¹⁰⁹ *Id.* According to Gail Zappa, tribute acts to her late husband Frank Zappa “are telling the audience that’s never heard it before that this is Frank Zappa’s music. It’s not. It’s some wretched version of it.” *Id.*

¹¹⁰ NPR, *supra* note 107.

¹¹¹ *Letter from Owen J. Sloan, Berger Kahn, A Law Corporation, Attorneys for Zappa Family Trust, to Entourage Talent Agents Associates, Ltd.*, (on file with author), available at <http://www.killuglyradio.com/wp-content/uploads/2009/01/paul-green689.pdf> [hereinafter *Letter from Zappa Family Trust Attorneys*].

apply in the context of a ‘tribute’ show”¹¹² Furthermore, the lawyers asserted that “[a]ny presentation that involves performances of works by Frank Zappa, only, or any so-called ‘tribute’ performance, is in the nature of a ‘revue’¹¹³ and implicates dramatic rights in that composer’s works.”¹¹⁴

The letter went on to assert that the use of Zappa’s name in advertising or promoting tribute performances may constitute trademark and/or publicity rights violations as well as lead to potential consumer confusion as to sponsorship and false representations of origin, actionable under the Lanham Act.¹¹⁵ Zappa’s lawyers have sent scores of similar cease-and-desist letters, although there has yet to be any active litigation.¹¹⁶ Many bands that have received these letters continue to perform Frank Zappa’s music, arguing that they do not need permission¹¹⁷ and under the current licensing system they are correct.

While a novel approach, the issue with treating tribute bands as dramatico-musical performances is the absence of clear guidance as to what definitively constitutes a dramatico-musical work.¹¹⁸ Because the term is not defined in the Copyright Act, its meaning is open to interpretation. Although performing rights organizations are able to license the public performance of non-dramatic copyrighted works, they do not license dramatic works.¹¹⁹ “While the line between dramatic and non-dramatic is not clear and depends on the facts, a dramatic performance usually involves using the work to tell

¹¹² *Id.*

¹¹³ *Id.* The term “revue” used by the Zappa Family attorney to describe tribute performances was taken directly from ASCAP’s definition of dramatico-musical works. See *Common Music Licensing Terms*, *supra* note 34 (“The term ‘dramatico-musical work’ includes, but is not limited to, a musical comedy, opera, play with music, *revue* or ballet.”) (emphasis added). The dictionary definition of revue is defined as “a theatrical production consisting typically of brief loosely connected often satirical skits, songs, and dances.” <http://www.merriam-webster.com/dictionary/revue> (last visited Nov. 17, 2011).

¹¹⁴ *Letter from Zappa Family Trust Attorneys*, *supra* note 111.

¹¹⁵ *Id.*

¹¹⁶ NPR, *supra* note 107.

¹¹⁷ *Id.* For example, Project Object, a Frank Zappa tribute band which received a cease desist letter from Zappa’s estate, alleged that as long as the venues it performs at pay for blanket licenses then it is entitled to play Zappa’s music. *Id.*

¹¹⁸ Section 101 does not define what constitutes a non-dramatic work as used within the Copyright Act.

¹¹⁹ 17 U.S.C. § 101. Dramatic and grand rights are licensed by the composer or the publisher of the work. *Common Music Licensing Terms*, *supra* note 34.

a story or as part of a story or plot.”¹²⁰ According to ASCAP’s definition “[t]he term ‘dramatico-musical work’ includes, *but is not limited to*, a musical comedy, opera, play with music, revue or ballet.”¹²¹ Without a statutory definition of what definitively constitutes a dramatic performance under the Copyright Act, the proposition that tribute band performances constitute a dramatico-musical performance under the current system will open the floodgate to litigation, leaving it to the courts’ discretion.

The courts will have to formulate tests to determine if a particular tribute band constitutes a dramatico-musical performance. In *Identity Theft*, the author discussed utilizing the test articulated in *Gershwin v. Whole Thing Co.*,¹²² for determining when a tribute band constitutes a dramatico-musical performance.¹²³ According to the *Gershwin* test, an act constitutes a dramatico-musical performance when: “(1) a song is used to tell a story . . . or (2) a song is performed with dialogue, scenery, or costumes.”¹²⁴ However, as applied to bands, this test is both overbroad and underbroad. The first prong of the test is overbroad because it would encompass nearly every folk song in existence.¹²⁵ This would raise problems for bands which have songs that fall into the folk category, in that they tell stories, but also perform songs which do not tell a story. The first prong is also too narrow because there are many bands with songs which do not tell stories, but have tribute bands that perform their music. The second prong of the *Gershwin* test is also overbroad, as applied to tribute bands, because it could lead to unnecessary litigation regarding issues such as whether a tribute band’s dress constitutes a costume, whether a stage banner transforms the nature of an act, or whether in-between chatter constitutes dialogue. This prong is also too narrow

¹²⁰ *Id.* “ASCAP has the right to license ‘non-dramatic’ public performances of its members’ works - for example, recordings broadcast on radio, songs or background music performed as part of a movie or other television program, or live or recorded performances in a bar or restaurant.” *Id.*

¹²¹ *Id.* (emphasis added).

¹²² 1980 U.S. Dist. LEXIS 16465 (1980).

¹²³ Davis, *supra* note 103, at 869-70. The court in *Gershwin* referred to the two-prong test posed by Giles as two distinct tests. *Gershwin*, 1980 U.S. Dist. LEXIS 16465, at *12. (citations omitted).

¹²⁴ *Id.* *Gershwin* involved a musical play called “Lets Call the Whole Thing Gershwin” which consisted “of theatrical performances of approximately forty songs written entirely or largely by George and Ira Gershwin.” *Id.* at *2.

¹²⁵ Folk songs vary in terms of musical styles, but generally connote a narrative song.

because there are many bands whose tribute acts do not demand costumes, dialogue, or scenery.

As demonstrated from the above discussion, classifying tribute bands as dramatico-musical works under the current system, by applying the *Gershwin* test or any other test, will lead to endless litigation over issues courts are not equipped to resolve. While tribute bands should be required to receive grand rights licensing from the original artists to whom they pay tribute, a more effective system would specifically classify tribute bands under the Copyright Act to provide similar treatment to dramatic performances.¹²⁶

VI. BAD FISH: A GOOD EXAMPLE OF WHY CLASSIFYING TRIBUTE BANDS AS DRAMATICO-MUSICAL WORKS DOES NOT WORK

Bad Fish is a perfect example of a tribute band that demonstrates the need for a change to the current licensing system. It also illustrates why classifying tribute bands as dramatico-musical works under the current system does not sufficiently solve the problem presented by tribute bands. Bad Fish is a tribute to Sublime, a band whose time was cut short by the tragic death of its lead singer Bradley Nowell, due to a drug overdose.¹²⁷ Sublime is not a thematic band, nor is its members recognizable by the public at large, but may be known by fans. Sublime never toured as a popular group and realized its success due to Nowell's sudden death two months prior to the release of its eponymous record that went gold.¹²⁸ Bad Fish realized the potential for profits offered by Sublime's tragic story and turned it into the success story of a tribute band.¹²⁹

Bad Fish tours the country playing the music of Sublime to legions of Sublime fans that never had the opportunity to see the band perform live.¹³⁰ The members of Bad Fish admit that none of them

¹²⁶ See *infra* Section VII. Davis's proposed "grand solution" would work if Congress amended the Copyright Act by adding a definition of dramatic works to Section 101 explicitly mentioning tribute bands and defining them within the broad context urged by this comment. This would avoid litigation as to whether a particular tribute band constitutes a dramatico-musical performance.

¹²⁷ HEIDI SIEGMUND CUDA, *SUBLIME'S BRAD NOWELL: CRAZY FOOL (PORTRAIT OF A PUNK)* (2000).

¹²⁸ *Id.* at 135.

¹²⁹ Steven Kurutz, *Keep Sublime Alive*, SPIN MAGAZINE, Nov. 2008, at 70-71.

¹³⁰ *Id.* at 70.

were huge Sublime fans, but thought it would be a lucrative opportunity.¹³¹ This is a tribute act that basically toured for the original group¹³² and has made millions of dollars doing so.¹³³ While Sublime is not a thematic band, whose physical appearance adds to its success and recognition, such as bands like Kiss or Alice Cooper, Bad Fish does utilize the goodwill Sublime built to promote its own act. For example, a recurring advertisement for Bad Fish's concerts portrays the cover of Sublime's self-titled album, which depicts the late lead singer Bradley Nowell's Sublime tattoo in Old English lettering.¹³⁴ Also, like many other tribute bands, its namesake is a popular Sublime song.¹³⁵

Bad Fish represents a tribute band that would continue to fall through the cracks of the blanket licensing system if the courts were left to determine whether individual tribute bands constitute dramatico-musical performances. While some Sublime songs tell stories, such as the cult classic single *Date Rape*,¹³⁶ a song such as *Bad Fish*,¹³⁷ the tribute band's namesake, does not explicitly tell a story and would likely not constitute a dramatico-musical performance under the *Gershwin* test. This split in the band's catalog demonstrates one of the many potential issues that would lead to an influx of litigation if tribute bands were treated as dramatico-musical performances under the current system. Additionally, Bad Fish's stage performance may be problematic under the second prong of the *Gershwin* test. Sublime's members had a surfer-California style and the lead

¹³¹ *Id.* at 70-71.

¹³² However, in 2009, the surviving members of Sublime reformed with a new lead singer and are currently touring as Sublime with Rome. Steve Baltin, *Sublime Returning With New Singer*, SPINNER (Aug. 31, 2009 10:00 AM) <http://www.spinner.com/2009/08/31/sublime-returning-with-new-singer/>. The band is just now first realizing its success as a touring band, 13 years after the release of its cult classic self-titled album. *Id.* The band has to bill itself as Sublime *with Rome* as a result of a legal battle with the estate of Bradley Nowell which owns the trademark Sublime. See Todd Martens, *Judge's Ruling Could Put a Damper on a Sublime Reunion*, POP & HISS: THE L.A. TIMES MUSIC BLOG (Nov. 3, 2009 6:35 PM) http://latimesblogs.latimes.com/music_blog/2009/11/court-injunction-could-halt-sublime-reunion-.html.

¹³³ See Kurutz, *supra* note 129, at 170. In 2006, Bad Fish played over 150 shows and grossed \$1.4 Million dollars. *Id.*

¹³⁴ Sublime fans have come to recognize this image as the late lead singer Bradley Nowell due to the success of the band's eponymous album.

¹³⁵ SUBLIME, *40 OZ. TO FREEDOM*, (MCA 1992).

¹³⁶ SUBLIME, *Date Rape*, on *40 OZ. TO FREEDOM*, (MCA 1992).

¹³⁷ SUBLIME, *Bad Fish*, on *40 OZ. TO FREEDOM*, (MCA 1992).

singer rarely wore a shirt on stage.¹³⁸ Bad Fish's members can also be described as having a surfer-like style and its lead singer also routinely performs shirtless.¹³⁹ It is likely that the band is not intending to be in costume, but it would be an issue litigated under the *Gershwin* test.

No test will sufficiently solve the problem presented by tribute bands because of the wide variety of bands in existence. Endless litigation over issues that the courts are not equipped to address will result if tribute bands are treated as dramatico-musical performances under the current system.¹⁴⁰ To effectively deal with the issues presented by tribute bands, a change must be made to the Copyright Act and/or the current licensing system delineating what constitutes a tribute band and what type of licensing these bands require. As stated by Justice Holmes, "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [a work], outside of the narrowest and most obvious limits."¹⁴¹

VII. CAN I GET AN AMEN(DMENT)?

As demonstrated from the above discussion, tribute bands call into question the rights of the original artists whom they pay tribute to and the fairness of the current licensing system that they operate under. While treating these bands as dramatico-musical performances under the current licensing system would solve the problem for some tribute bands, others would continue to fall through the cracks of the blanket licensing system. A more desirable solution would be an amendment to the Copyright Act specifically addressing tribute bands as potential infringers and a federal recognition of a right of publicity, within this context, in order to address all types of tribute bands. This solution can be as simple as adding tribute bands as an additional limitation in the definition of what performing rights societies are capable of licensing under Section 101 of the Copyright

¹³⁸ Kurutz, *supra* note 129.

¹³⁹ *Id.*

¹⁴⁰ Issues such as whether a song is meant to tell a story, whether in between song chatter constitutes dialogue, or whether a band's dress constitutes a costume are not issues which should be decided by the judiciary.

¹⁴¹ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

Act.¹⁴² Adding a definition of dramatico-musical works to Section 101, specifically addressing whether tribute bands are included, would accomplish this result.

This solution would require both a statutory definition of dramatico-musical works and tribute bands. In regard to creating a statutory definition of dramatico-musical works, ASCAP's definition that "[t]he term 'dramatico-musical work' includes, but is not limited to, a musical comedy, opera, play with music, revue or ballet"¹⁴³ would be a good starting point. However, for clarity, the statutory definition should delineate what is intended to be included. If the legislature were to decide that tribute bands constitute dramatico-musical works, the definition could read: "A dramatico-musical work is a tribute band performance, a musical comedy, opera, play with music, revue or ballet." For this solution to be effective, the statutory definition of tribute bands would have to embrace the broad definition of tribute bands, as bands that publicly perform songs exclusively by one artist.

However, more extensive treatment of tribute bands under the Copyright Act would be preferable, explicitly addressing substantially all of the legal implications arising from their activities to avoid unnecessary litigation. Such a sui generis provision would not be out of the ordinary in the Copyright Act.¹⁴⁴ By enumerating the legal implications of tribute bands in this provision, the legislature can effectively deal with the problems created by tribute bands. First, this provision would have to adopt the broad definition of tribute bands suggested above to fully address the wide spectrum of tribute bands in existence. Next, the provision should address licensing requirements.

By requiring tribute bands to obtain licenses directly from the artists to whom they pay tribute would acknowledge the implications of these bands on the rights of original artists and provide them with a degree of control over their tribute band counterparts. In regard to the right of publicity, giving original artists control over licensing would effectively protect their publicity rights. This would provide

¹⁴² See 17 U.S.C. § 101.

¹⁴³ *Common Music Licensing Terms*, *supra* note 34.

¹⁴⁴ See, e.g., 17 U.S.C. § 116 (2006) (addressing licenses for public performances by means of coin-operated phonorecord players); 17 U.S.C. § 120 (2006) (addressing rights in architectural works).

original artists effective control over a tribute band's commercial use of their identities. Additionally, requiring tribute bands to obtain licenses directly from the artists to whom they pay tribute would address trademark issues by allowing original artists to negotiate licenses according to the particular circumstances. Artists could charge what they believe is proper for a band's use of their works and could even license their logos and offer endorsements, which could be beneficial to tribute bands. This system would allow original artists to effectively control the exploitation of their works by giving them control over the terms of use. It would also prevent tribute bands from performing if the original artist did not consent.

Alternatively, absent an amendment to the Copyright Act, performing rights organizations could simply treat tribute bands as a distinct category, similar to the treatment of dramatico-musical performances, requiring permission directly from copyright holders. This system would avoid the problem of having the courts determine the classification of a particular band. However, this system would have to be adopted by all of the performing rights organizations to be effective. This would be the same type of system that would exist if the legislature were to amend the Copyright Act to address tribute bands.

CONCLUSION

Tribute bands implicate the rights of the artists to whom they pay tribute based upon the law of copyright, trademark and the right of publicity. An amendment to the Copyright Act adding a provision specifically dealing with tribute bands would be the most effective way of dealing with the legal implications of tribute bands on the rights of original artists. Such a provision would allow original artists to share in the success of their imitators and effectively control the use of their works, while minimizing the need for litigation. Imitation is the sincerest form of flattery, but as it relates to tribute bands, it should constitute infringement.