Google Facing Legal Gray Area in Voice Infringement Suit

Singer Darlene Love hit Google Inc. with a lawsuit in California federal court last week, claiming the company improperly used her 1963 recording of "It's a Marshmallow World" in an advertisement for its Nexus smartphones.

What makes the suit unusual is that Love isn't claiming Google infringed her copyrights for the classic track. Instead, Love is claiming that Google violated her common law right of publicity by using her voice in the commercial, that it "appropriated her identity" to "falsely impl[y] to the public that Love had endorsed Google's products."

"Defendants' actions were despicable and in conscious disregard of Love's rights," the complaint says. "They turned her into an involuntary pitchman for products of dubious quality."

The suit says Google and ad agency 72 & Sunny Inc. "consciously and deliberately selected Love's vocal performance of 'It's a Marshmallow World' for their commercials" but that they then "refused to take any steps to obtain Love's consent."

What the suit never says, though, is that Google or 72 & Sunny failed to obtain a copyright license for the song. If anything, it seems to indicate that they did.

"The claim is unusual," said James Sammataro, a partner with Stroock & Stroock & Lavan LLP. "It appears that the defendants are being sued despite the existence of a valid license."

Does that claim hold water? It's hard to say based solely on the pleadings, but here's what the experts say we know for sure.

It's Not Preempted

At the very outset, it's worth noting that while a state law publicity claim like Love's would sometimes be preempted by federal copyright law, hers probably isn't.

Federal copyright law generally preempts state claims when they too closely mimic a right that's supposed to be protected by the Copyright Act, and a recording artist suing solely over the unauthorized use of her song sounds a whole lot like a copyright infringement claim.

But Love's song was recorded in 1963, long before Congress first created a federal copyright for sound recordings. When it did so, in 1972, lawmakers included a provision expressly stating that federal law would not preempt any state law claims related to pre-1972 recordings.

It's the same situation that's partially responsible for the ongoing state law litigation against Sirius and Pandora over royalties for pre-1972 recordings, and it means Love's claim probably wouldn't be defeated by a preemption defense.

"There is no preemption argument at all," said David Halberstadter, partner at Katten Muchin Rosenman LLP.

A Copyright License Is Normally Sufficient

Love's lawsuit essentially boils down to a single question: Assuming an advertiser obtains the proper copyright licenses, do they need to obtain more licenses for the publicity rights of artists

whose voices appear on the track?

The answer is: not usually.

“It is not customary for advertisers to seek an additional license from the artist when they’ve secured a valid license to use the musical work,” Sammataro said. “A valid license from the party that possesses the rights in the underlying musical work should be sufficient.”

Of course, artists can negotiate whatever they want into their contract with their record label, which generally owns the recording copyright, and their publisher, which generally owns the compositional copyright, and could stipulate that the company cannot license a song for advertising without their consent.

But if that were the case, Love’s beef would be with the catalog owner, not with Google.

“There is no obligation to obtain permission from the singer of the song, unless the singer has arranged that with the label or publisher,” said Lisa A. Callif, a partner with Donaldson & Callif and the author of a book on rights clearance.

But Publicity Claims Are Tough to Nail Down

Love’s lawsuit isn’t something that you see every day, but California’s common law right of publicity protections are notoriously broad. Courts have said they protect not just a person’s name and likeness, but any appropriation of their “identity.”

For instance, back in 1988, the Ninth Circuit said Ford Motor Co. had violated Bette Midler’s common law rights by using a “sound alike” singer to perform one of her songs in an ad, even though the company had properly licensed the song from her publisher. In 1992, the same court gave Tom Waits similar protection over the use of his voice in ads, even though his was less well known than Midler’s.

“The idea is that you’re not only using the song, but you’re also arguably using the recognition of the person who’s singing the song to create at least an implication of some kind of sponsorship or endorsement,” Halberstadter said.

The question then becomes, however, whether Love’s voice is nearly as distinctive as Midler’s or Waits’.

“The argument that millennials are running out to buy Nexus phones because Ms. Love croons in the background of Google’s commercial does not resonate,” Sammataro said.

Love is represented by Steven Ames Brown.

Counsel information for Google and 72 & Sunny is not yet available.

The case is Love v. Google Inc. et al., case number 4:16-cv-00290, in the U.S. District Court for the Northern District of California.