
June 2022

Let's Hear it For Sound Marks: Trademark Protection in Copyrighted Songs

Iyanu Lipede

Follow this and additional works at: https://digitalcommons.liberty.edu/lu_law_review

Recommended Citation

Lipede, Iyanu (2022) "Let's Hear it For Sound Marks: Trademark Protection in Copyrighted Songs," *Liberty University Law Review*: Vol. 16: Iss. 3, Article 5.

Available at: https://digitalcommons.liberty.edu/lu_law_review/vol16/iss3/5

This Comments is brought to you for free and open access by the Liberty University School of Law at Scholars Crossing. It has been accepted for inclusion in Liberty University Law Review by an authorized editor of Scholars Crossing. For more information, please contact scholarlycommunications@liberty.edu.



IYANU LIPEDE

Let's Hear it For Sound Marks: Trademark Protection in Copyrighted Songs

ABSTRACT

Trademarks play an indispensable role in brand protection for both individuals and companies, and musicians are no different. While most musicians enforce their brands through traditional trademarks, like words and logos, the musician Pitbull succeeded in registering nontraditional, sound trademarks in October 2019. Sound marks are not new; in fact, the first sound mark was registered in 1947. However, Pitbull's registered marks differ from other sound marks. While most sound marks are separate from the product they identify, Pitbull's registered marks are found in the product they identify—the song. Accordingly, this type of mark implicates both trademark and copyright law.

As this type of sound mark is predicted to grow in popularity, the implications of copyright and trademark law on such marks must be considered. This Comment provides a brief history of sound trademarks. It then outlines the differences between trademarks and copyrights and discusses the implications of these differences for sound marks in copyrighted music. Specifically, this Comment discusses issues musician-trademark-owners may face enforcing and licensing their marks.

Pitbull's sound marks are not the first instance of overlap of copyright and trademark law. However, due to lower courts misunderstanding the Supreme Court's holding in *Dastar Corp. v. Twentieth Century Film Corp.*, some courts have precluded concurrent copyright and trademark infringement claims. Such a holding may render this type of sound mark unenforceable. Furthermore, the licensing requirements of trademarks and copyrights differ significantly. While trademark law requires trademark owners to maintain pushing quality control over their licensees, copyright law has no such requirement. Additionally, courts have inconsistent and contradictory requirements for trademark licensing, leaving trademark owners with little to no guidance on what constitutes a valid license.

This Comment concludes by proposing two solutions to issues arising

from this unique mark. First, this Comment calls on the Supreme Court to clarify its holding in *Dastar*. Second, this Comment proposes an amendment to the Lanham Act that would dispense with the quality control requirement for sound marks.

AUTHOR

Student Development Editor, LIBERTY UNIVERSITY LAW REVIEW, Volume 16; J.D. Candidate, Liberty University School of Law (2022); B.A., Government, Oral Roberts University (2017). I would like to thank my family for their love and continual support. I would also like to thank Wesley Carter for introducing me to trademark law and Dr. Curtis Ellis for his guidance as I developed my writing skills.

COMMENT

LET'S HEAR IT FOR SOUND MARKS: TRADEMARK PROTECTION IN
COPYRIGHTED SONGS*Iyanu Lipede*[†]

I. INTRODUCTION

In October 2019, the United States Patent and Trademark Office (USPTO) issued two trademark registrations to the musician Pitbull.¹ Musicians often develop and maintain their brands through trademark law;² however, Pitbull's registered marks were notably different. While other artists have registered traditional marks, such as words or logos,³ Pitbull endeavored—and succeeded—to register nontraditional, sound trademarks.⁴ Although these were not the first sound marks the USPTO granted, these marks differ from the rest.

Pitbull's registered marks are noteworthy for multiple reasons. One major reason is that other musicians are expected to follow suit in pursuing the registration of sound marks.⁵ Additionally, while most sound marks identify the product, they are separate from the product itself.⁶ In contrast, Pitbull's

[†] Student Development Editor, *Liberty University Law Review*, Volume 16; J.D. Candidate, Liberty University School of Law (2022); B.A., Government, Oral Roberts University (2017). I would like to thank my family for their love and continual support. I would also like to thank Wesley Carter for introducing me to trademark law and Dr. Curtis Ellis for his guidance as I developed my writing skills.

¹ The mark is a sound. The mark consists of a man yelling "EEEEEEYOOOOO" in falsetto with "E" drawn out followed by a "U" sound, Registration No. 5,877,076; The mark is a sound. The mark consists of a man yelling "EEEEEEYOOOOO" in falsetto with "E" drawn out followed by a "U" sound, Registration No. 5,877,077.

² See generally Suzanne Kessler, *The Non-Recording, Non-Artist "Recording Artist": Expanding the Recording Artist's Brand into Non-Music Arenas*, 20 VAND. J. ENT. & TECH. L. 515, 550–51 (2017).

³ See, e.g., 50 CENT Registration 5,486,790; BRUCE SPRINGSTEEN Registration No. 4,454,482; JUSTIN BIEBER Registration No. 4,396,533; RIHANNA Registration No. 4,968,108; TAYLOR SWIFT Registration No. 5,805,872.

⁴ The mark is a sound. The mark consists of a man yelling "EEEEEEYOOOOO" in falsetto with "E" drawn out followed by a "U" sound, Registration No. 5,877,076; The mark is a sound. The mark consists of a man yelling "EEEEEEYOOOOO" in falsetto with "E" drawn out followed by a "U" sound, Registration No. 5,877,077.

⁵ See Justin F. McNaughton et al., *EEEEEEYOOOOO!: Reflections on Protecting Pitbull's Famous Grito*, 2 N.Y.U. J. INTELL. PROP. & ENT. L. 179, 180 (2020).

⁶ *Id.* at 187.

sound marks allow consumers to experience the marks while also experiencing the product itself—the song. The trademark is embedded in the copyrighted song.⁷ Because this type of mark implicates both trademark and copyright law, problems are sure to arise.

While Pitbull's registered marks are noteworthy, they also raise questions as to enforcement and licensing of this type of mark. Due to a misunderstanding of the Supreme Court's *Dastar* holding, some lower courts have extended the Court's holding to preclude concurrent claims for copyright and trademark infringement.⁸ Under such an expansive view of *Dastar*, courts may bar owners of sound marks in music recordings from bringing their trademark infringement claims. In addition, the licensing requirements of trademarks and copyrighted music differ significantly, with trademark licensing requiring that trademark owners exert quality control over their licensees and products.⁹ Courts have inconsistent and contradictory requirements for trademark licensing, leaving trademark owners with little to no guidance on what constitutes a valid license.¹⁰ Further, music licensing is complex and expensive,¹¹ and with the added trademark quality control requirement, artists seeking to license songs containing trademarks may run into obstacles.

This Comment provides a brief history of sound trademarks. It then outlines the differences between trademarks and copyrights and discusses the implications of these differences for this type of mark. Specifically, this Comment focuses on enforcement and licensing of sound marks in sound recordings. This Comment concludes by offering two solutions to the perplexing problem posed by Pitbull's registered sound marks. First, this Comment suggests that the Supreme Court clarify its holding in *Dastar* to avoid further confusion among lower courts. Second, this Comment proposes an amendment to the Lanham Act. The amendment will dispose of the quality control requirement for sound marks to resolve issues that typically arise from sound marks.

⁷ *Id.*

⁸ See, e.g., *Conf. Archives, Inc. v. Sound Images, Inc.*, No. 3:2006-76, 2010 U.S. Dist. LEXIS 46955, at *37-39 (W.D. Pa. 2010); *Lions Gate Ent., Inc. v. TD Ameritrade Servs. Co.*, 170 F. Supp. 3d 1249, 1264 (C.D. Cal. 2016).

⁹ Irene Calboli, *The Sunset of "Quality Control" in Modern Trademark Licensing*, 57 AM. U. L. REV. 341, 356 (2007).

¹⁰ *Id.* at 374.

¹¹ Thomas M. Lenard & Lawrence J. White, *Moving Music Licensing into the Digital Era: More Competition and Less Regulation*, 23 UCLA ENT. L. REV. 133, 134 (2016).

II. BACKGROUND

In his music, Pitbull often characterizes himself as “Mr. Worldwide” or “Mr. 305” and marks his songs with his Spanish-language catchphrase, “Dale,” or his familiar yell, “EEEEEEYOOOOO!”¹² This persona remains the same whether it is in his own song or whether he is a featured artist in another musician’s song.¹³ Pitbull’s persona as “Mr. Worldwide” and “Mr. 305” extends past his music; however, his yell is “almost exclusively used” in his music.¹⁴ Accordingly, fans and non-fans alike recognize his yell, acknowledging it as an essential element to his brand.¹⁵

In 2017, Colombian singer, J Balvin, and producer, Willy William, released the song “Mi Gente,” which features a yell similar to that of Pitbull.¹⁶ The yell is first heard fifty-two seconds into the song and reoccurs throughout the song’s duration.¹⁷ The song gained instant success, with fans and music journalists almost immediately assuming that Pitbull was a featured artist in the song.¹⁸ Consequently, Pitbull received praise for this mistaken guest appearance.¹⁹ Pitbull first responded by releasing a remix of the song.²⁰ The artist used the remix to acknowledge fans’ confusion stating, “since everybody thought that I was on the record, I think it’s only right that I jump on the remix.”²¹ Despite this good-natured response, Pitbull also chose to protect his yell.²² His chosen mode of protection was a trademark, and after an eighteen-month battle, the USPTO registered his sound marks.²³

¹² McNaughton et al., *supra* note 5, at 180.

¹³ *Id.* at 183.

¹⁴ Savannah Merceus, [Insert Yell Here]: Rapper Pitbull Receives Trademark Registration for “EEEEEEYOOOOO!” Sound Mark, IP INTEL. (May 7, 2020), <https://www.ipintelligencereport.com/2020/05/07/insert-yell-here-rapper-pitbull-receives-trademark-registration-for-eeeeeyooooo-sound-mark/>.

¹⁵ McNaughton et al., *supra* note 5, at 183.

¹⁶ J Balvin, Willy William—Mi Gente (Official Video), YOUTUBE (June 29, 2017), <https://www.youtube.com/watch?v=wnJ6LuUFpMo>.

¹⁷ *Id.*

¹⁸ McNaughton et al., *supra* note 5, at 180–81.

¹⁹ *Id.*

²⁰ See urkel 15, J Balvin, Willy William, Pitbull “Mi Gente” (woldwild & urkel15 remix) extender version, YOUTUBE (Aug. 30, 2017), <https://www.youtube.com/watch?v=tPvu12EUh0w>.

²¹ *Id.*

²² McNaughton et al., *supra* note 5, at 190.

²³ The mark is a sound. The mark consists of a man yelling “EEEEEEYOOOOO” in falsetto with “E” drawn out followed by a “U” sound, Registration No. 5,877,076; The mark is a sound. The mark consists of a man yelling “EEEEEEYOOOOO” in falsetto with “E” drawn out followed by a “U” sound, Registration No. 5,877,077.

Sound trademarks, such as Pitbull's registered marks, may be used as a tool to connect with consumers effectively.²⁴ Yet, trademark law may not be the only means of intellectual property protection for a single product. Generally, courts hold that a given product may be protected simultaneously by more than one type of intellectual property.²⁵ The fact that trademarks, patents, and copyrights may overlap in subject matter often causes confusion.²⁶ The varying forms of intellectual property provide different types of protection and serve different purposes.²⁷ Consequently, the criteria for protection, the tests for infringement, and the requirements for licensing differ greatly between these types of intellectual property.²⁸

A trademark aims to identify the source of goods to prevent customer confusion.²⁹ A copyright, on the other hand, protects an author's right in creative works.³⁰ Sounds may fall into the subject matter of both copyrights and trademarks.³¹ One author noted that in relation to sounds, the difference in intellectual property types is manifested in music.³² Prior to the registration of Pitbull's marks, courts noted that songs could be trademarked when they served as a symbol or device to identify a person's goods or services; however, courts simultaneously acknowledged that a song could not

²⁴ See Daniel R. Bumpus, Comment, *Bing, Bang, Boom: An Analysis of In Re Vertex Group LLC and the Struggle for Inherent Distinctiveness in Sound Marks Made During a Product's Normal Course of Operation*, 21 FED. CIR. B.J. 245, 249 (2011).

²⁵ *Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 638 (7th Cir. 1993); *Ward v. Andrews McMeel Pub., LLC*, 963 F. Supp. 2d 222, 236 (S.D.N.Y. 2013); *In re DC Comics, Inc.*, 689 F.2d 1042, 1052 (C.C.P.A. 1982).

²⁶ See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 6:1 (5th ed. 2020).

²⁷ See *id.* § 6:5.

²⁸ See *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924) (“[A trademark] does not confer a right to prohibit the use of the word or words. It is not a copyright. . . . A trade-mark only gives the right to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his.”); *Quality Inns Int'l, Inc. v. McDonald's Corp.*, 695 F. Supp. 198, 218 (D. Md. 1988) (“Unlike a copyright, mere reproduction of a trademark is not an infringement.”); see also 1 MCCARTHY, *supra* note 26, § 6:6 (providing a chart outlining the relationship between copyright law, trademark law, and patent law to give an overview of differences between various types of federal statutory intellectual property protections).

²⁹ 1 MCCARTHY, *supra* note 26, § 2:1.

³⁰ *EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopolos, Inc.*, No. 99-7922, 2000 U.S. App. LEXIS 30761, at *15 (2d Cir. Dec. 1, 2000).

³¹ Bumpus, *supra* note 24, at 250; see *EMI Catalogue P'ship*, 2000 U.S. App. LEXIS 30761, at *18.

³² Bumpus, *supra* note 24, at 250.

be a trademark for itself.³³ So, by granting Pitbull the first known sound trademark for musical sound recordings,³⁴ the USPTO made Pitbull a pioneer in his field.

A. *The History of Sound Marks*

A trademark³⁵ is “any word, name, symbol, or device, or any combination thereof” used by an individual or company in commerce to identify, distinguish, and indicate the source of the goods they produce.³⁶ While trademarks were traditionally limited to word or image marks, they have been expanded to include colors, sounds, and many other devices.³⁷ As defined by the Trademark Manual of Examining Procedure (TMEP), “[a] sound mark identifies and distinguishes a product or service through audio rather than visual means.”³⁸ Sound trademarks are often grouped with other trademarks that cannot be visually represented.³⁹ This group, which also includes scents, is often referred to as “sensory” trademarks⁴⁰ and is part of the larger universe of nontraditional marks.⁴¹ Consumers often easily identify traditional marks, such as a brand’s name or logo, as legally enforceable trademarks; however, consumers may not easily identify a nontraditional mark.⁴² While sound marks were not traditionally afforded trademark protection, today, they are growing in popularity and considered “probably the most memorable nontraditional trademarks.”⁴³

In 1947, the National Broadcast Company (NBC) filed the first sound

³³ *EMI Catalogue P’ship*, 2000 U.S. App. LEXIS 30761, at *18; *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 62 (2d Cir. 2001); *G.M.L., Inc. v. Mayhew*, 188 F. Supp. 2d 891, 897 (M.D. Tenn. 2002).

³⁴ *McNaughton et al.*, *supra* note 5, at 189.

³⁵ Although trademark law distinguishes between a “trademark” as the term for goods, and “service mark” as the term for services, this Comment will use the term “trademark” to refer to both trademarks and service marks.

³⁶ Lanham Act § 45, 15 U.S.C. § 1127.

³⁷ 1 MCCARTHY, *supra* note 26, §§ 7:100–7:109.

³⁸ TMEP § 1202.15 (July 2021).

³⁹ See *McNaughton et al.*, *supra* note 5, at 184.

⁴⁰ *Id.*

⁴¹ Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TRADEMARK REP. 773, 774 (2005).

⁴² *Id.* at 774; Melissa E. Roth, Note, *Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Nontraditional Trademark Registrations*, 27 CARDOZO L. REV. 457, 460 (2005).

⁴³ Gilson & LaLonde, *supra* note 41, at 801.

trademark to be registered in the United States.⁴⁴ A little over thirty years later, the Trademark Trial and Appeal Board (TTAB) affirmed that a sound could be a trademark.⁴⁵ The TTAB has noted that sounds may be registered when they are:

[A]rbitrary, unique[,] or distinctive and can be used in a manner so as to attach to the mind of the listener and be awakened on later hearing in a way that would indicate for the listener that a particular product or service was coming from a particular, even if anonymous, source.⁴⁶

As with other trademarks, a prerequisite for obtaining a sound mark is a showing of distinctiveness.⁴⁷ Similar to traditional word trademarks, sound marks are graded on a spectrum of distinctiveness. For word marks, generic marks, having no distinctiveness, are on one end of the spectrum while fanciful marks, the most distinctive, are on the other end of the spectrum.⁴⁸ Similarly, the TTAB has distinguished commonplace, or familiar sounds, which are not inherently distinctive, from inherently distinctive, arbitrary sounds.⁴⁹ Commonplace sounds are sounds that listeners have been exposed to under different circumstances.⁵⁰ Examples of such sounds include alarm clocks, security alarms, telephones, and even Pitbull's registered marks.⁵¹ When a sound is commonplace, a trademark applicant must provide proof that the sound has acquired distinctiveness.⁵² In other words, there must be evidence that consumers recognize the sound and associate it with a particular product or service.⁵³

⁴⁴ McNaughton et al., *supra* note 5, at 184; The mark comprises the musical notes G, E, C played on chimes, Registration No. 523,616. NBC did not renew this mark, and the mark expired in 1992. NBC filed a new trademark application for the same sound in 1970, and the new mark was registered the following year. The mark comprises a sequence of chime-like musical notes which are in the key of C and sound the noted G, E, C, the "G" being the one just below middle C, the "E" the one just above middle C, and the "C" being middle C, thereby to identify applicant's broadcasting service, Registration No. 916,522.

⁴⁵ *In re Gen. Elec. Broad. Co.*, 199 U.S.P.Q. (BNA) 560, 563 (T.T.A.B. 1978).

⁴⁶ *In re Vertex Grp. LLC*, 89 U.S.P.Q.2d 1694, 1700 (T.T.A.B. 2009).

⁴⁷ *Id.* See *infra* Section II.B.1.

⁴⁸ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 573 F.2d 4, 9 (2d Cir. 1976).

⁴⁹ *In re Gen. Elec. Broad. Co.*, 199 U.S.P.Q. (BNA) at 563.

⁵⁰ TMEP, *supra* note 38, § 1202.15.

⁵¹ *Id.*; see McNaughton et al., *supra* note 5, at 186.

⁵² See McNaughton et al., *supra* note 5, at 186.

⁵³ *Ride the Ducks, LLC v. Duck Boat Tours, Inc.*, 75 U.S.P.Q.2d (BNA) 1269, 1275 (T.T.A.B. 2005).

Inherently distinctive sounds do not require such proof.⁵⁴ Examples of registered inherently distinctive sounds include NBC's chime, MGM's lion roar, and the New York Stock Exchange Bell.⁵⁵ Sound marks differ from some other nontraditional marks in this respect. Courts have consistently barred some categories of nontraditional marks from being inherently distinctive.⁵⁶ A look at color marks is demonstrative.⁵⁷ Because colors are familiar and do not immediately signify the source of a product, those seeking to register a color mark must always show acquired distinctiveness.⁵⁸ Once consumers are able to identify the color as part of a brand, then the owner may receive trademark protection. Conversely, regardless of whether we often hear the sound, a sound may be inherently distinctive if it is not commonplace.⁵⁹

At the time of the TTAB's landmark decision in *In re General Electric Broadcasting Company, Inc.*, wherein the TTAB explicitly stated that sounds may receive trademark protection, only nine other sounds were registered as trademarks in the United States.⁶⁰ After the TTAB's declaration, fourteen more were registered in the 1980s.⁶¹ Today, sound mark registration has grown to 234 registered sound trademarks.⁶² While this number pales in

⁵⁴ *In re Gen. Elec. Broad. Co.*, 199 U.S.P.Q. (BNA) 560, 563 (T.T.A.B. 1978).

⁵⁵ McNaughton et al., *supra* note 5, at 186; The mark comprises the musical notes G, E, C played on chimes, Registration No. 523,616; The mark comprises a lion roaring, Registration No. 1,395,550; The THX logo theme consists of 30 voices over seven measures, starting in a narrow range, 200 to 400 Hz, and slowly diverting to preselected notes encompassing three octaves. The 30 voices begin at pitches between 200 Hz and 400 Hz and arrive at pre-selected pitches spanning three octaves by the fourth measure. The highest pitch is slightly detuned while there are double the number of voices of the lowest two pitches, Registration No. 1,872,866; The mark consists of the sound of a brass bell tuned to the pitch D, but with an overtone of D-sharp, struck nine times at a brisk tempo, with the final tone allowed to ring until the sound decays naturally. The rhythmic pattern is eight 16th notes and a quarter note; the total duration, from the striking of the first tone to the end of the decay on the final one, is just over 3 seconds, Registration No. 2,741,129.

⁵⁶ *Wal-Mart Stores, Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 212 (2005) (holding that product design, like color, is not inherently distinctive); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163 (1995) (holding that color is not inherently distinctive); *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639, 1650 (T.T.A.B. 2006) (holding that flavor is not inherently distinctive).

⁵⁷ For an in-depth analysis of the distinctiveness of color marks, see Briana Reed, Note, *Color Monopoly: How Trademarking Colors in the Fashion Industry and Beyond Expands the Lanham Act's Purpose and Policy*, 15 LIBERTY U. L. REV. 371 (2021).

⁵⁸ *Qualitex Co.*, 514 U.S. at 171–72.

⁵⁹ *Bumpus*, *supra* note 24, at 253.

⁶⁰ *Id.* at 248; *In re Gen. Elec. Broad. Co.*, 199 U.S.P.Q. (BNA) 560 (T.T.A.B. 1978).

⁶¹ *Id.*

⁶² McNaughton et al., *supra* note 5, at 186.

comparison to the number of registered word and design marks, it is evident sound marks have gained popularity over the years.⁶³

B. *Trademarks Compared to Copyrights*

Because trademarks and copyrights serve different purposes,⁶⁴ the two forms of intellectual property deserve a separate analysis

1. Trademarks

As previously noted, a trademark is “any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”⁶⁵ This broad definition of trademarks found in the Lanham Act allows for a wide array of registered trademarks, including words, phrases, colors, sounds, scents, and motions.⁶⁶ The authority of Congress to provide for the registration and to regulate the use of such trademarks is found in the Commerce Clause.⁶⁷ In accordance with the Commerce Clause, the trademark must be used in commerce to be afforded federal trademark protection.⁶⁸ It must also be distinctive; that is, it must be able to distinguish the products or services of the trademark owner from others.⁶⁹ Lastly, it must be used as a source identifier rather than as a mere decoration.⁷⁰

Once the basic requirements are met and the mark is registered, the trademark owner can exclude others from using similar marks on similar products. In doing so, the trademark owner and consumers are benefited. The Supreme Court noted that “[t]he Lanham Act provides national

⁶³ See *id.*; Bumpus, *supra* note 24, at 248.

⁶⁴ 1 MCCARTHY, *supra* note 26, § 2:1; EMI Catalogue P’ship v. Hill, Holliday, Connors, Cosmopolos, Inc., No. 99-7922, 2000 U.S. App. LEXIS 30761, at *15 (2d Cir. Dec. 1, 2000).

⁶⁵ Lanham Act § 45, 15 U.S.C. § 1127.

⁶⁶ See, e.g., Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 166 (1995) (holding that colors may be registered as trademarks); *In re Clarke*, 17 U.S.P.Q.2d 1238, 1239 (T.T.A.B. 1990) (approving the registration of a fragrance mark for thread and embroidery yarn).

⁶⁷ TMEP, *supra* note 38, intro. *But see* Trademark Cases, 100 U.S. 82, 95 (1879) (invalidating a trademark statute promulgated under the Intellectual Property Clause and leaving the possibility of the Commerce Clause open).

⁶⁸ Lanham Act § 45, 15 U.S.C. § 1127; *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297–98 (2019).

⁶⁹ BILL SEITER & ELLEN SEITER, *THE CREATIVE ARTIST’S LEGAL GUIDE: COPYRIGHT, TRADEMARK AND CONTRACTS IN FILM AND DIGITAL MEDIA PRODUCTION* 67 (2012).

⁷⁰ *In re Safariland Hunting Corp.*, 24 U.S.P.Q.2d 1380, 1381 (T.T.A.B. 1992) (“[T]he mark [must] be used in such a manner that it would be readily perceived as identifying the specified goods and distinguishing a single source or origin for the goods.”).

protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.⁷¹ Appropriately, the owner is benefitted because trademark registration provides constructive notice to other providers of goods that the mark is already in use.⁷² Consumers are benefitted because the registration prevents confusion as to the source of the goods they purchase.⁷³ In fact, the very “purpose of trademark laws is to prevent the use of the same or similar marks in a way that confuses the public about the actual source of the goods or service.”⁷⁴ Accordingly, these two policies are the underpinnings of the trademark licensing scheme.⁷⁵

A trademark license allows a trademark owner to permit a third party to use the trademark, whereas, without this permission, the third party would be infringing on the mark.⁷⁶ Trademark law requires that in licensing trademarks, trademark owners maintain control of their licensees and the quality of their products in order to protect customers from false information.⁷⁷ Failure of trademark owners to maintain such control of their licensees or the quality of their products may lead to trademark cancellation or abandonment.⁷⁸

Without a license, a third party using an identical or similar mark in identical or similar products may be infringing on a trademark owner’s rights to her mark.⁷⁹ In analyzing a claim for trademark infringement, courts utilize a simple test: the likelihood of confusion.⁸⁰ The test for infringement of a federally registered mark asks whether the third party’s use of the mark is likely to cause confusion, creates mistake, or deceive consumers.⁸¹ While

⁷¹ *Park 'n Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985).

⁷² *Nat. Footwear, Ltd. v. Hart, Schaffner & Marx*, 760 F.2d 1383, 1395 (3d Cir. 1985).

⁷³ *Id.*

⁷⁴ *Star Fin. Servs., Inc. v. AASTAR Mortg. Corp.*, 89 F.3d 5, 9 (1st Cir. 1996).

⁷⁵ See Lanham Act § 5, 15 U.S.C. § 1055; see also JAMES BOYLE & JENNIFER JENKINS, *INTELLECTUAL PROPERTY: LAW & THE INFORMATION SOCIETY CASES AND MATERIALS* 39 (5th ed. 2021) (“[U]nderstanding the animating constitutional provisions [behind federal intellectual property law], their goals, and their inner tensions, will shine a light on the way that the courts *interpret* existing intellectual property law.”).

⁷⁶ 2 ANNE GILSON LALONDE & JEROME GILSON, *GILSON ON TRADEMARKS* § 6.01[1] (2020).

⁷⁷ Kevin Parks, “*Naked*” Is Not a Four-Letter Word: Debunking the Myth of the “Quality Control Requirement” in Trademark Licensing, 82 *TRADEMARK REP.* 531, 534–35 (1992).

⁷⁸ Lanham Act §§ 14, 45, 15 U.S.C. §§ 1064, 1127.

⁷⁹ 2 LALONDE & GILSON, *supra* note 76, § 6.01[2].

⁸⁰ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992); *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 226 (5th Cir. 2009); *Network Automation, Inc. v. Adv. Sys. Concepts, Inc.*, 638 F.3d 1137, 1142 (9th Cir. 2011).

⁸¹ See Lanham Act §§ 32, 43, 15 U.S.C. §§ 1114(1), 1125.

courts may use different factors in conducting this test,⁸² the general principle is the same: if the plaintiff proves the public is likely to be confused, mistaken, or deceived, the defendant is liable for trademark infringement.⁸³

2. Copyrights

Although the term copyright lacks a statutory definition, it has been defined as “the exclusive right or privilege of the author or proprietor to print or otherwise multiply, publish, and vend copies of his or her literary, artistic, or intellectual productions when secured by compliance with the copyright statute.”⁸⁴ The Constitution grants Congress the power to grant authors exclusive rights to their works.⁸⁵ This constitutional provision, commonly known as the Copyrights and Patents Clause, solely authorizes Congress to provide protection for authors without going as far as to provide substantive protections for the author’s work.⁸⁶ As such, copyright is a “creature of statute”; whereas Congress is not required to provide copyright protection.⁸⁷ Because the Constitution only grants Congress the power to provide such protection,⁸⁸ any rights authors hold, and any remedies arising from infringement of those rights, exist solely because Congress chose to bestow them.⁸⁹

As evident in the Copyrights and Patents Clause, the purpose of copyrights is “to promote the Progress of . . . [the] useful Arts.”⁹⁰ Thus, copyright law “ultimately serves the purpose of enriching the general public through access

⁸² See, e.g., *Dorpan, S.L. v. Hotel Meliá, Inc.*, 728 F.3d 55, 65 (1st Cir. 2013) (utilizing the *Pignons* Factors); *Sterling Drug, Inc. v. Bayer AG*, 14 F.3d 733, 740 (2d Cir. 1994) (utilizing the *Polaroid* Factors); *Checkpoint Sys. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 280 (3d Cir. 2001) (utilizing the *Lapp* Factors); *Petro Stopping Ctrs., L.P. v. James River Petroleum, Inc.*, 130 F.3d 88, 91 (4th Cir. 1997) (utilizing the *Pizzeria Uno* Factors); *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 646 (6th Cir. 2002) (utilizing the *Frisch* Factors); *Frosty Treats, Inc. v. Sony Comput. Ent. Am., Inc.*, 426 F.3d 1001, 1008 (8th Cir. 2005) (utilizing the *CoRect* Factors); *M2 Software, Inc. v. Madacy Ent.*, 421 F.3d 1073, 1080 (9th Cir. 2005) (utilizing the *Sleekcraft* Factors).

⁸³ 2 LALONDE & GILSON, *supra* note 76, § 5.01[1].

⁸⁴ 18 AM. JUR. 2D *Copyright and Literary Prop.* § 1 (2021).

⁸⁵ U.S. CONST. art. I, § 8, cl. 8.

⁸⁶ *Silvers v. Sony Pictures Ent., Inc.*, 402 F.3d 881, 883 (9th Cir. 2005).

⁸⁷ *Darden v. Peters*, 488 F.3d 277, 284 (4th Cir. 2007).

⁸⁸ *Id.*; U.S. CONST. art. I, § 8, cl. 8. (“The Congress shall have Power To . . . promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries[.]” (emphasis added)).

⁸⁹ *Darden*, 488 F.3d at 284.

⁹⁰ U.S. CONST. art. I, § 8, cl. 8; 18 AM. JUR. 2D, *supra* note 84, § 2.

to creative works.”⁹¹ While authors of copyrightable works are afforded a monopoly on their creations, the Copyrights and Patents Clause expresses that this monopoly may only be for “limited [t]imes.”⁹²

As amended, the current Copyright Act provides copyright protection for works created on or after January 1, 1978, for “a term consisting of the life of the author and 70 years after the author’s death.”⁹³ This extension does not create a perpetual copyright⁹⁴ in violation of the Constitution; instead, it allows authors to reap their works’ economic value.⁹⁵ Once the term ends, the copyright expires, and the work becomes free for anyone to use in the public domain.⁹⁶ In contrast, trademarks may be perpetual as the owner may renew the mark as long as the owner uses it in commerce.⁹⁷ Essentially, the life of a trademark is not tied to the owner’s life but simply to the use of the trademark in commerce.⁹⁸ Nevertheless, the purpose of the Copyright and Patents Clause—promoting the progress of the Arts—is realized by such a limited term. Authors are encouraged and rewarded for their creations, and others are permitted to use, improve, and develop those works.⁹⁹

Section 102 of the Copyright Act delineates the subject matter of copyright. In accordance with the Copyright Act, copyright protection is only afforded to “original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”¹⁰⁰ While the Copyright Act leaves “original” undefined,¹⁰¹ the Supreme Court has stated that “the *sine qua non*¹⁰² of copyright is originality.”¹⁰³ For copyright purposes, originality means that the work was not copied from

⁹¹ *Kirtsaeng v. John Wiley & Sons, Inc.*, 136 S. Ct. 1979, 1986 (2016) (quoting *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 527 (1994)).

⁹² U.S. CONST. art. I, § 8, cl. 8.

⁹³ 17 U.S.C. § 302(a).

⁹⁴ *Eldred v. Ashcroft*, 537 U.S. 186, 209 (2003).

⁹⁵ *See id.* at 209 n.16.

⁹⁶ Peter B. Hirtle, *When is 1923 Going to Arrive and Other Complications of the U.S. Public Domain*, SEARCHER, Sept. 2012, at 22.

⁹⁷ 1 MCCARTHY, *supra* note 26, § 6:8.

⁹⁸ *See id.* § 6:6.

⁹⁹ *Kirtsaeng v. John Wiley & Sons, Inc.*, 136 S. Ct. 1979, 1986 (2016).

¹⁰⁰ 17 U.S.C. § 102; *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109 (9th Cir. 1970); *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 909 (2d Cir. 1980).

¹⁰¹ 17 U.S.C. § 102; H.R. REP. NO. 94-1476, at 51 (1976).

¹⁰² An indispensable condition or thing; something on which something else necessarily depends. *Sine qua non*, BLACK’S LAW DICTIONARY (11th ed. 2019).

¹⁰³ *Feist Publ’ns, Inc., v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

other works but rather independently created by the author with some level of creativity.¹⁰⁴ This is not a requirement for novelty, as similar works may be original but not novel.¹⁰⁵ Provided that the similarity is not due to copying, similar works may be deemed original.¹⁰⁶

The requirement of originality is also evident in the copyright infringement test. For a plaintiff to establish infringement, “two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”¹⁰⁷ The ownership element is comprised of five separate parts; however, a copyright registration is *prima facie* evidence of ownership.¹⁰⁸ The second element of copying is also broken down but into just two separate parts.¹⁰⁹ The first part questions whether the defendant used the plaintiff’s work as a prototype or inspiration when creating his own work.¹¹⁰ If the defendant used the plaintiff’s work in this way, one may conclude copying likely occurred.¹¹¹ However, the court must still determine whether the copying is actionable.¹¹² The second part of the copying element thus questions whether the copying rose to the level of infringement.¹¹³ To establish that copying is actionable, a plaintiff must show (1) access to the copyrighted work, (2) substantial similarity between the copyrighted and uncopyrighted works, and (3) that the defendant’s copying extended to the plaintiff’s original expression.¹¹⁴ This test for infringement differs from the test for trademark infringement because copyright infringement does not require courts to inquire into the likelihood of confusion.¹¹⁵

Despite the differences between trademark and copyright law, concurrent

¹⁰⁴ *Id.*

¹⁰⁵ *Id.*

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* at 361.

¹⁰⁸ 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13:01 (2021) (These five parts are: the “(1) originality in the author; (2) copyrightability of the subject matter; (3) a national point of attachment to the work, such as to permit a claim of copyright; (4) compliance with applicable statutory formalities; and (5) (if the plaintiff is not the author) a transfer of rights or other relationship between the author and the plaintiff so as to constitute the plaintiff as the valid copyright claimant.”).

¹⁰⁹ *Id.*

¹¹⁰ *Id.*

¹¹¹ *Id.*

¹¹² *Id.*

¹¹³ *Id.*

¹¹⁴ *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1358 (N.D. Ill. 1989).

¹¹⁵ 4 NIMMER & NIMMER, *supra* note 108, § 13:03 n.2.3.

protection for a single work is possible. In the past, these two types of intellectual property worked somewhat synergistically. Whether appreciated by the public and intellectual property commenters, “[o]verlapping copyright and trademark protection . . . means that . . . creators receive all the benefits flowing from both the copyright regime and the trademark system.”¹¹⁶ However, due to the unprecedented nature of Pitbull’s sound marks (and similar marks to follow), the differences between trademark and copyright law are clearer, placing the two in direct opposition with one another.

III. PROBLEM

The USPTO granted Pitbull two trademarks, both in classes relating to music performance.¹¹⁷ In granting Pitbull’s trademarks, the USPTO essentially acknowledged that Pitbull’s yell had acquired distinctiveness. While the USPTO’s recognition was “noteworthy,”¹¹⁸ it raises questions about the enforcement and licensing of a sound mark in music recordings.

A. *Enforcement*

Musicians, like Pitbull, will seek protection for a sound in a copyrighted song. Thus, if a person copies such a mark in a way that constitutes both trademark and copyright infringement, both the owner of the trademark and the owner of the copyright may file a claim of infringement. However, a line of cases based on a misunderstanding of Supreme Court precedent would render this type of mark unenforceable.¹¹⁹ While the mark would be highly beneficial to musicians seeking to protect their brands, issues with enforcement of the mark should be taken into consideration.

The USPTO registered Pitbull’s trademarks in 2019.¹²⁰ With his marks being the first known registered sound marks in sound recordings,¹²¹ the Supreme Court has yet to address this specific type of mark. Nevertheless, the Court’s past holdings are implicated when considering enforcement of this

¹¹⁶ Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1474 (2004).

¹¹⁷ Trademarks are classified in forty-five different classes based on the goods or services they identify. See TMEP, *supra* note 38, § 1400.

¹¹⁸ McNaughton et al., *supra* note 5, at 189.

¹¹⁹ 1 MCCARTHY, *supra* note 26, § 6:15.

¹²⁰ The mark is a sound. The mark consists of a man yelling “EEEEEEYOOOOOO” in falsetto with “E” drawn out followed by a “U” sound, Registration No. 5,877,076; The mark is a sound. The mark consists of a man yelling “EEEEEEYOOOOOO” in falsetto with “E” drawn out followed by a “U” sound, Registration No. 5,877,077.

¹²¹ McNaughton et al., *supra* note 5, at 189.

type of mark. The Supreme Court's decision in *Dastar Corp. v. Twentieth Century Film Corp.* poses unintended consequences on sound trademarks found in songs.¹²² Due to a general misunderstanding of the Court's holding, some lower courts have extended the Supreme Court's holding to preclude concurrent claims for copyright and trademark infringement.¹²³ Under this expansive reading of the Supreme Court's *Dastar* holding, artists with trademarks in musical sound recordings would be unable to enforce their trademarks.

In *Dastar*, the Supreme Court addressed the applicability of the Lanham Act to a formerly copyrighted work in the public domain.¹²⁴ Specifically, the issue before the Court was whether § 43 of the Lanham Act prevents unaccredited copying of uncopyrighted work.¹²⁵ The Court answered the question in the negative, unanimously holding that the word "origin" in § 43 of the Lanham Act denotes the producer of the physical goods and not the creator of the intellectual property.¹²⁶ In effect, the Court's holding means that once a copyrighted work falls into the public domain, authors of such works cannot use trademark law as a means to force copiers to give them credit. However, to understand the case's implications, it is helpful to understand the underlying facts.

In 1948, Twentieth Century Fox (Fox) acquired exclusive television rights to Dwight D. Eisenhower's World War II book, *Crusades in Europe*, from the book's publisher, Doubleday.¹²⁷ Fox arranged for another corporation to produce the television series, which in turn assigned its copyright in the series to Fox.¹²⁸ While Doubleday renewed its copyright in the book in 1975, Fox failed to renew the copyright on the television series, and the show entered the public domain in 1977.¹²⁹ In 1988, Fox again obtained the book's television rights and began licensing the right to distribute the television series.¹³⁰ Seven years later, the defendant, Dastar, purchased beta cam tapes of the original series, copied and edited them, then released and sold the

¹²² See 1 MCCARTHY, *supra* note 26, § 6:15.

¹²³ See, e.g., *Conf. Archives, Inc. v. Sound Images, Inc.*, No. 3:2006-76, 2010 U.S. Dist. LEXIS 46955, at *37-39 (W.D. Pa. 2010); *Lions Gate Ent. Inc. v. TD Ameritrade Servs. Co.*, 170 F. Supp. 3d 1249, 1264 (C.D. Cal. 2016).

¹²⁴ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 25, 31 (2003).

¹²⁵ *Id.* at 25.

¹²⁶ *Id.* at 37.

¹²⁷ *Id.* at 25.

¹²⁸ *Id.* at 25-26.

¹²⁹ *Id.* at 26.

¹³⁰ *Dastar*, 539 U.S. at 26.

series as *World War II Campaigns in Europe*.¹³¹ This repackaged series did not mention Fox, the book, or the original series producers.¹³² Rather, the credits simply stated, “DASTAR CORP presents.”¹³³ Shortly thereafter, Fox sued Dastar, claiming that the defendant’s sale of its television series constituted “reverse passing off,”¹³⁴ thus violating § 43(a) of the Lanham Act.¹³⁵

The Supreme Court held that § 43(a) of the Lanham Act does not prevent the unaccredited copying of works in the public domain.¹³⁶ The Court reasoned that the Lanham Act was not intended to foster originality or creativity, nor does it reward innovation.¹³⁷ However, copyrights and patents were designed for such purposes.¹³⁸ The Court noted that “in construing the Lanham Act, [it] ha[s] been ‘careful to caution against misuse or over-extension’ of trademark and related protections into areas traditionally occupied by patent or copyright.”¹³⁹ Thus, if the Court had allowed a cause of action under § 43(a) of the Lanham Act in *Dastar*, it would have created a “mutant copyright law” that would interfere with the public’s right to copy and use expired copyrights.¹⁴⁰ Consequently, the “limited times” afforded to copyrights were essential in the Court’s holding.¹⁴¹

The implications and the scope of the Court’s ruling in *Dastar* can be difficult to understand.¹⁴² Courts and commentators alike have understood the Court’s holding differently.¹⁴³ One intellectual property commentator noted that the Court’s conclusion originated from an implicit belief that copyright law is superior to trademark law.¹⁴⁴ Regardless of the Court’s

¹³¹ *Id.*

¹³² *Id.* at 27.

¹³³ *Id.*

¹³⁴ “Passing off” is when one puts another’s trademark on his own goods. *Kehoe Component Sales, Inc. v. Best Lighting Prods.*, 796 F.3d 576, 586 (6th Cir. 2015). In this context, the goods are often of lesser quality. *Id.* Reverse passing off, then, is when one sells another’s goods or services claiming them as her own. *Id.*

¹³⁵ *Dastar*, 539 U.S. at 27.

¹³⁶ *Id.* at 38.

¹³⁷ *Id.* at 34.

¹³⁸ *Id.* at 37.

¹³⁹ *Id.* at 34.

¹⁴⁰ *Id.*

¹⁴¹ MALLA POLLACK, CORPORATE COUNSEL’S GUIDE TO TRADEMARK LAW § 12:4, Westlaw CCGTMLAW (database updated July 2021).

¹⁴² 5 MCCARTHY, *supra* note 26, § 27:78.

¹⁴³ *Id.*

¹⁴⁴ Laura A. Heymann, *The Trademark/Copyright Divide*, 60 SMU L. REV. 55, 81 (2007).

beliefs, lower courts have misinterpreted and expanded *Dastar*'s limited holding.¹⁴⁵ For example, lower courts have consistently and unanimously extended the Supreme Court's holding to copyrighted works.¹⁴⁶ *Dastar* did not deal with a copyrighted work because Fox failed to renew its copyright, and the mark had fallen into the public domain.¹⁴⁷ Though the Supreme Court relied heavily on the fact that the work in question in *Dastar* was no longer copyrighted, courts generally apply the Court's holding regardless of whether the work in question is copyrighted.¹⁴⁸

Furthermore, § 43 of the Lanham Act has two prongs, the "trademark" prong and the "false advertising" prong. Nonetheless, the Supreme Court noted that its holding only applied to the "trademark" prong.¹⁴⁹ It left the claims of "false advertising" open.¹⁵⁰ Nevertheless, lower courts have applied the *Dastar* rule to false advertising claims.

While lower courts have expanded the Supreme Court's holding in many other respects,¹⁵¹ there are two readings of the Supreme Court's holding that have unintended consequences for sound marks in sound recordings. The Supreme Court noted its reluctance to extend trademark law into areas traditionally occupied by copyright law even before *Dastar*, and some lower courts have relied on the Court's reluctance to "expand the scope of the Lanham Act to cover cases in which the Federal Copyright Act provides an adequate remedy."¹⁵² The most expansive reading of *Dastar* has led a few courts to deny plaintiffs pleading both trademark infringement and copyright infringement claims, consequently holding that the Copyright Act

¹⁴⁵ See generally Tom W. Bell, *Misunderestimating Dastar: How the Supreme Court Unwittingly Revolutionized Copyright Preemption*, 65 MD. L. REV. 206 (2006) (discussing how lower courts have applied *Dastar* in varying contexts).

¹⁴⁶ 5 MCCARTHY, *supra* note 26, § 27:78.

¹⁴⁷ *Dastar*, 539 U.S. at 26.

¹⁴⁸ 5 MCCARTHY, *supra* note 26, § 27:78.

¹⁴⁹ *Id.*

¹⁵⁰ *Dastar*, 539 U.S. at 37.

¹⁵¹ Bell, *supra* note 145, at 220–21. Lower courts have relied on *Dastar* to preempt state law reverse passing off claims, despite the case only dealing with copyright and federal reverse passing off claims, without providing a clear rationale as to why *Dastar* would have such an effect. *Id.* Courts have also extended the Supreme Court's holding to services, though the court only dealt with goods. *Id.*

¹⁵² MARK S. LEE, ENTERTAINMENT AND INTELLECTUAL PROPERTY LAW § 2:95 (2021).

precludes Lanham Act claims.^{153,154}

With these expansive views of *Dastar* and the USPTO's approval of sound marks in music recordings, how may sound trademark owners enforce their marks? These trademarks will be in copyrighted songs. While musicians may own their own trademarks, they often will not own the copyright to the sound recording. Rather, record labels usually own the rights to their artists' sound recordings under the terms of recording contracts.¹⁵⁵ Thus, if both a copyrighted work and a trademark are infringed, the record label and the musician could bring their respective claims. Yet, lower courts' highly expansive readings of *Dastar* would limit musicians' rights to enforce their trademarks.¹⁵⁶ Because some courts extend the Supreme Court's *Dastar* holding to find that the Copyright Act preempts or precludes Lanham Act claims, trademark owners in this situation would not be able to bring their infringement claims.¹⁵⁷ Instead, the record labels could bring their copyright infringement claims, and musician-trademark-owners would be left without

¹⁵³ See, e.g., *Conf. Archives, Inc. v. Sound Images, Inc.*, No. 3:2006-76, 2010 U.S. Dist. LEXIS 46955, at *37 (W.D. Pa. 2010); *Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 U.S. Dist. LEXIS 45385, at *12 (N.D. Cal. 2010); *Lions Gate Ent. Inc. v. TD Ameritrade Servs. Co.*, 170 F. Supp. 3d 1249, 1264 (C.D. Cal. 2016) (stating that the Copyright Act preempts the Lanham Act).

¹⁵⁴ Some courts rejected overlapping protection of both copyrights and trademarks, and some barred concurrent claims under the Copyright Act and the Lanham Act even before *Dastar*. See, e.g., *Shaw v. Lindheim*, 919 F.2d 1353, 1364–65 (9th Cir. 1990), *overruled by Skidmore v. Led Zeppelin*, 952 F.3d 1051, 1066 (9th Cir. 2020) (overruled on other grounds); *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 32 (2d Cir. 1995) (“Overextension of trade dress protection can undermine restrictions in copyright and patent law that are designed to avoid monopolization of products and ideas. Consequently, courts should proceed with caution in assessing claims to unregistered trade dress protection so as not to undermine the objectives of these other laws.”); see also *Comedy III Prod., Inc. v. New Line Cinema*, 200 F.3d 593, 595 (9th Cir. 2000) (“If material covered by copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity.”); *Galerie Furstenberg v. Coffaro*, 697 F. Supp. 1282, 1290 (S.D.N.Y. 1988) (dismissing a trademark claim because it should have been “brought under the federal copyright, not trademark, statute”). A clarification of *Dastar* will still apply to these cases. See Moffat, *supra* note 116, at 1527–30 (discussing cases in which copyright and trademark protection were denied and how the *Dastar* rule encourages lower courts to reject claims of concurrent protection).

¹⁵⁵ Kessler, *supra* note 2, at 532.

¹⁵⁶ See *Conf. Archives, Inc.*, 2010 U.S. Dist. LEXIS 46955, at *37 (“Claims for copyright infringement under the Copyright Act, and claims for Trade Dress Infringement under the Lanham Act are mutually exclusive. . . . If an adequate remedy exists for the Copyright Act, no remedy lies for the Lanham Act claim.”).

¹⁵⁷ *Id.*; *Lions Gate Ent. Inc.*, 170 F. Supp. 3d at 1264 (stating that the Supreme Court has extended the principle of copyright preemption to the Lanham Act and federal trademark protection).

recourse for infringement of their marks. The record label is not required to bring a copyright infringement suit, however.

One court recited reasons why record labels may neglect to enforce their copyrights.¹⁵⁸ These reasons may include “simple laziness or enforcement costs, a desire to create goodwill, or a calculation that the infringement creates an economic complement to the copyrighted work—it actually benefits the owner.”¹⁵⁹ In fact, unauthorized use of copyrighted works have been shown to make potential customers aware of the original work, leading customers to become fans of the original work, and ultimately increasing the use of the original work.¹⁶⁰ These effects are evident in the music industry.¹⁶¹

In the music context, musicians often copy, incorporate, and borrow from existing musical works.¹⁶² One form of this “musical borrowing” that has become prevalent with the rise of hip hop is sampling.¹⁶³ Sampling is “[a] process in which sound is taken directly from a recorded medium and transposed onto a new recording.”¹⁶⁴ While it is possible to obtain licenses to sample already copyrighted music,¹⁶⁵ some musicians proceed without such authorization.¹⁶⁶ Nevertheless, sampling, whether authorized or unauthorized, has been shown to increase music sales in the original work.¹⁶⁷ Thus, if a record label sees an economic benefit in the infringement, or simply chooses not to enforce its mark, the trademark owner would be left even more vulnerable under a liberal *Dastar* rule. In that case, while the artist may

¹⁵⁸ Jackson v. Roberts, 972 F.3d 25, 41 (2d Cir. 2020).

¹⁵⁹ *Id.* (quoting Tim Wu, *Tolerated Use*, 31 COLUM. J.L. & ARTS 617, 619 (2008)).

¹⁶⁰ David Fagundes, *Market Harm, Market Help, and Fair Use*, 17 STAN. TECH. L. REV. 359, 378–82 (2014).

¹⁶¹ See Mike Schuster et al., *Sampling Increases Music Sales: An Empirical Copyright Study*, 56 AM. BUS. L.J. 177, 196, 206 (2019).

¹⁶² Olufunmilayo B. Arewa, *From J.C. Bach to Hip Hop: Musical Borrowing, Copyright and Cultural Context*, 84 N.C. L. REV. 547, 550 (2006).

¹⁶³ *Id.* at 552.

¹⁶⁴ Will Fulford-Jones, *Sampling*, GROVE MUSIC ONLINE (Jan. 20, 2001), <https://www.oxfordmusiconline.com/grovemusic/view/10.1093/gmo/9781561592630.001.0001/omo-9781561592630-e-0000047228?rsk=8uwE4E&result=1>.

¹⁶⁵ See *infra* Section III.B.

¹⁶⁶ See Arewa, *supra* note 162, at 580 (discussing Grand Upright v. Warner Bros. Records, where the artist requested permission to sample the original work but proceeded after denial of such permission); see also Jackson v. Roberts, 972 F.3d 25, 31 (2d Cir. 2020) (“[I]t is common for hip-hop mixtapes to include ‘remixes,’ often consisting of new vocal recordings by the releasing artist, combined with samples of songs by other artists . . . many hip-hop artists (including [the plaintiff] himself) have created mixtapes that included samples of recordings of other artists *without obtaining permission* from either the recording artist or the copyright holder of the work sampled.” (emphasis added)).

¹⁶⁷ Schuster et al., *supra* note 161, at 178.

have claims against the record label,¹⁶⁸ the artist would be barred from bringing a Lanham Act claim against the copier.

Nevertheless, even if musicians owned both the copyright and trademark, they could still be barred from bringing both copyright and trademark claims.¹⁶⁹ Most cases that barred concurrent claims have dealt with a single owner of both the copyright and the trademark.¹⁷⁰ Consequently, if the musicians owned the copyright to the song their sound mark was in, they may still have no recourse under their trademark claim.¹⁷¹

B. *Licensing*

Pitbull uses his yell almost exclusively in his music.¹⁷² His yell can be heard in his own songs and songs in which he is a featured artist.¹⁷³ This allows Pitbull to experiment in different genres while assuring his fans that the song is indeed a Pitbull song.¹⁷⁴ Appropriately, he registered one of his marks in a class for live music recording and another in a class for musical sound and musical video recordings.¹⁷⁵

¹⁶⁸ See *Jackson v. Roberts*, 972 F.3d 25, 41 (2d Cir. 2020) (stating that the plaintiff, Jackson, would possibly have rights to compel the record label and receive royalties from damages, but he would not have a right to control the defendant's use of his song through a right of publicity claim).

¹⁶⁹ See, e.g., *Conf. Archives, Inc.*, 2010 U.S. Dist. LEXIS 46955, at *37; *Sleep Sci. Partners*, 2010 U.S. Dist. LEXIS 45385, at *12; *Lions Gate Ent. Inc. v. TD Ameritrade Servs. Co.*, 170 F. Supp. 3d 1249, 1264 (C.D. Cal. 2016).

¹⁷⁰ See *Conf. Archives, Inc.*, 2010 U.S. Dist. LEXIS 46955, *2 (“Plaintiff developed a product called Conference Companion and registered that name as a federal trademark.”); *Sleep Sci. Partners*, 2010 U.S. Dist. LEXIS 45385, at *1–2, 4. (“Plaintiff alleges that Sleeping Well misappropriated its PureSleep Method through Dr. Lieberman and that its website has the same format, design and feel as Plaintiff's website.”); *Lions Gate Ent. Inc.*, 170 F. Supp. 3d at 1254 (“This copyright and trademark infringement case arises from Plaintiff Lions Gate Entertainment, Inc.'s intellectual property rights in the movie *Dirty Dancing* that Plaintiff alleges Defendants infringed.”).

¹⁷¹ See *Conf. Archives, Inc.*, 2010 U.S. Dist. LEXIS 46955, at *37 (“Claims for copyright infringement under the Copyright Act, and claims for Trade Dress Infringement under the Lanham Act are mutually exclusive. . . . If an adequate remedy exists for the Copyright Act, no remedy lies for the Lanham Act claim.”).

¹⁷² *Merceus*, *supra* note 14.

¹⁷³ *McNaughton et al.*, *supra* note 5, at 183.

¹⁷⁴ *Id.*

¹⁷⁵ The mark is a sound. The mark consists of a man yelling “EEEEEEYOOOOOO” in falsetto with “E” drawn out followed by a “U” sound. Registration No. 5,877,076 (registered in class 41 for live entertainment services in the nature of live musical performances); The mark is a sound. The mark consists of a man yelling “EEEEEEYOOOOOO” in falsetto with “E” drawn out followed by a “U” sound. Registration No. 5,877,077 (registered in class 9 for musical sound recordings; musical video recordings).

At least one court has contemplated the interplay of music licensing and sound trademarks.¹⁷⁶ In *Oliveira v. Frito-Lay, Inc.*, a musician, Astrud Oliveira, attempted to recover damages for trademark infringement due to the defendants' use of her song in a potato chip commercial.¹⁷⁷ The defendants paid over \$200,000 in licensing fees to use the song but did not seek Oliveira's permission, believing that she retained no rights in the song.¹⁷⁸ Oliveira, however, argued that she possessed an unregistered trademark in her signature performance of the song "The Girl from Ipanema," and thus, the defendants were unauthorized in the use of her mark in their commercial, thus causing a likelihood of consumer confusion.¹⁷⁹

The United States Court of Appeals for the Second Circuit disagreed with Oliveira's argument.¹⁸⁰ While the court held that musicians could possibly register a trademark for their signature performances, the court determined Congress was better fit to extend trademark law to protect signature performances.¹⁸¹ Notably, the court reasoned that artists, who had licensed paying entities to use their songs, would be able to bring suit for trademark infringement if the court agreed with Oliveira.¹⁸² While the court found no trademark rights in *Oliveira*, one of the case's principles is important when contemplating sound trademarks in musical sound recordings: both the trademark and the song itself should be licensed to avoid trademark and copyright infringement.

While the trademark and the song itself must be licensed, the licensing requirements for both differ. The differing requirements will inevitably cause problems for musician-sound-mark-owners. Trademark licensing requires that owners exert control over their licensees and the quality of their products for a license to be valid.¹⁸³ Trademark licensing was prohibited until the passage of the Lanham Act, which now allows a mark to be used by "related companies."¹⁸⁴ While licensing is no longer prohibited, the Lanham Act does not define "quality," nor does it define "control."¹⁸⁵ Courts have been left to define quality and control on a case-by-case basis, leading to different

¹⁷⁶ See *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56 (2d Cir. 2001).

¹⁷⁷ *Id.* at 57–58.

¹⁷⁸ *Id.* at 58.

¹⁷⁹ *Id.* at 60–61.

¹⁸⁰ *Id.* at 62.

¹⁸¹ *Id.* at 62–63.

¹⁸² *Oliveira*, 251 F.3d at 63.

¹⁸³ Calboli, *supra* note 9, at 356.

¹⁸⁴ Lanham Act § 5, 15 U.S.C. § 1055.

¹⁸⁵ See *id.*; Lanham Act § 45, § 1127.

interpretations of quality control as well as inconsistent and contradictory results.¹⁸⁶

Several courts have inquired into whether trademark owners exercised “adequate” control.¹⁸⁷ These courts assessed whether control was adequate based on how trademark owners guaranteed product quality.¹⁸⁸ Some methods used to guarantee product quality included regular testing procedures, requirements to buy certain supplies from certain sources, and sending samples.¹⁸⁹ Yet, these courts never articulated a specific test to determine adequate control.¹⁹⁰ Other courts determined that “actual” control was required rather than merely contractual control.¹⁹¹ One court noted that in the absence of actual control, a trademark could still be canceled even if the contract contained quality control provisions.¹⁹² Conversely, some courts even went as far as to hold that a license was valid regardless of control as long as the quality of the product remained the same and the public was not deceived.¹⁹³ With each new standard developed, the case-by-case basis approach remained. Accordingly, trademark owners are left without guidance as to what constitutes a valid license and how much control to exert.¹⁹⁴

Furthermore, courts are inconsistent in determining *who* can monitor quality control.¹⁹⁵ Some courts have held that the trademark owner is not required to monitor quality control, and third parties or licensees may do so.¹⁹⁶ Nevertheless, the Lanham Act provides that trademark owners who fail to exert quality control may forfeit their trademarks if consumers are

¹⁸⁶ Calboli, *supra* note 9, at 364–65.

¹⁸⁷ *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358, 368–69 (2d Cir. 1959); *Joseph Bancroft & Sons Co. v. Shelley Knitting Mills, Inc.*, 212 F. Supp. 715, 740 (E.D. Pa. 1962); *Alligator Co. v. Robert Bruce, Inc.*, 176 F. Supp. 377, 378–79 (E.D. Pa. 1959).

¹⁸⁸ Calboli, *supra* note 9, at 368.

¹⁸⁹ *Id.*; *see also Embedded Moments, Inc. v. Int'l Silver Co.*, 648 F. Supp. 187, 194–95 (E.D.N.Y. 1986).

¹⁹⁰ Calboli, *supra* note 9, at 368.

¹⁹¹ *See Embedded Moments, Inc.*, 648 F. Supp. at 194 (holding that actual control is sufficient and that contractual control is unnecessary); *see also Bishops Bay Founders Grp., Inc. v. Bishops Bay Apts., LLC*, 301 F. Supp. 2d 901, 909 (W.D. Wis. 2003) (“[A]n oral license may be sufficient if actual control is exercised by the licensor.”).

¹⁹² *Dawn Donut Co.*, 267 F.2d at 368.

¹⁹³ *See, e.g., Land O'Lakes Creameries, Inc. v. Oconomowoc Canning Co.*, 330 F.2d 667, 670 (7th Cir. 1964).

¹⁹⁴ Calboli, *supra* note 9, at 374.

¹⁹⁵ *Id.* at 375.

¹⁹⁶ *Id.*

misled.¹⁹⁷ This provision in the Lanham Act has been met with differing attitudes from courts. Although most courts are neither extremely lenient nor strict, some courts are reluctant to find invalid licenses and are fairly lenient, while others are strict and seem eager to invalidate licenses.¹⁹⁸

This wide range of precedent may concern musician-trademark-owners seeking to license sound trademarks in music recordings. First, musicians, like other trademark owners, would be unsure how much control they would need to exert.¹⁹⁹ Second, there is no guidance on how to measure quality in music recordings.²⁰⁰ The wide range of uses of music adds to the difficulty of a quality control requirement in this context. If musicians license their trademarks for use in another's song, how should they guarantee quality? Product manufacturers can send samples, require certain supplies, or have testing procedures;²⁰¹ however, these methods do not translate well to music recordings. While most products may be analyzed utilizing multiple senses, humans experience music largely through their ears.²⁰² A person's ability to hear through his or her ears impacts how quality could be determined in licensed sound marks because each person's brain interprets and retains musical information uniquely.²⁰³ What one person—or a potential juror—may deem similar quality, another could disagree. For example, some jurors may lack the auditory skills necessary for quality control determination because they are tone-deaf.²⁰⁴ One copyright commentator properly explained how tone-deafness might affect a juror: "Ultimately, someone that is tone deaf lacks in the ability to properly perceive or remember musical sounds. This kind of impairment could easily lead to improper rulings . . ."²⁰⁵ Finally, the wide range of precedent could cause musician to be unsure whether they are required to monitor quality control or if a third party could do so.²⁰⁶

Although sound trademarks in music recordings are novel,²⁰⁷ licensing the trademarks would require the trademark owner to maintain control of the

¹⁹⁷ Lanham Act § 14(3), 15 U.S.C. § 1064(5).

¹⁹⁸ 3 MCCARTHY, *supra* note 26, § 18:55.

¹⁹⁹ See Calboli, *supra* note 9, at 374.

²⁰⁰ See *id.* at 371 (dealing only with traditional marks).

²⁰¹ *Id.* at 368 n.145.

²⁰² See Joseph M. Santiago, Note, *The "Blurred Lines" of Copyright Law Setting a New Standard for Copyright Infringement in Music*, 83 BROOK. L. REV. 289, 303 (2017).

²⁰³ See *id.*

²⁰⁴ *Id.* at 304.

²⁰⁵ *Id.* (discussing tone deafness in copyright infringement context).

²⁰⁶ See Calboli, *supra* note 9, at 375.

²⁰⁷ See McNaughton et al., *supra* note 5, at 189.

nature and quality of the licensed products just as any other trademark would.²⁰⁸ Licensing the song itself, however, differs greatly. Music has been labeled a troublemaker in copyright law,²⁰⁹ and this label is partly because a single song may have multiple copyrights with multiple owners. The Copyright Act lists eight non-exclusive categories of “works of authorship” that may receive copyright protection.²¹⁰ These categories include musical works and sound recordings.²¹¹ On one hand, a musical work is the song’s notes and accompanying lyrics.²¹² Ordinarily, the author or composer of the musical work owns the copyright, or by assignment, a music publisher owns the copyright.²¹³ Because multiple people often write songs, more than one person may own the copyright to a musical work.²¹⁴ The copyright in a musical work protects the right to reproduce the work, create a derivative of the work, distribute the work, publicly perform the work, and publicly display the work.²¹⁵

On the other hand, a sound recording is a work resulting from fixed musical, spoken, or other sound.²¹⁶ In essence, a sound recording is a recorded audio performance of a musical work.²¹⁷ Under the terms of basic recording contracts, artists create their sound recordings as “works made for hire” for the record label.²¹⁸ If, however, the artist did not make the work for hire, recording contracts often include provisions in which an artist assigns all rights, titles, and interests in the sound recording to the label.²¹⁹ In either case, the record label owns the rights to the sound recording.²²⁰ The copyright in a sound recording protects the rights to reproduce the recording, create derivative works, distribute the recording, and publicly perform the

²⁰⁸ Calboli, *supra* note 9, at 354–55.

²⁰⁹ Don E. Tomlinson & Timothy Nielander, *Unchained Melody: Music Licensing in the Digital Age*, 6 TEX. INTELL. PROP. L.J. 277, 284 (1998).

²¹⁰ 17 U.S.C. § 102(a).

²¹¹ *Id.*

²¹² Joshua P. Binder, *Current Developments of Public Performance Rights for Sound Recordings Transmitted Online You Push Play, but Who Gets Paid?*, 22 LOY. L.A. ENT. L. REV. 1, 3 (2001).

²¹³ *Id.* at 4.

²¹⁴ Tomlinson & Nielander, *supra* note 209, at 285.

²¹⁵ 17 U.S.C. § 106.

²¹⁶ 17 U.S.C. § 101.

²¹⁷ See Binder, *supra* note 212, at 4.

²¹⁸ Kessler, *supra* note 2, at 532.

²¹⁹ *Id.* at 532 n.78.

²²⁰ *Id.*

recording digitally.²²¹ This dichotomy of musical works and sound recordings plays an important role in music licensing.

Third parties' intended uses of a song determines from whom they must obtain a license.²²² A third party seeking to use a recorded song must obtain a license from the owner of the sound recording and the owner of the musical work.²²³ Additionally, the intended use also determines the type of license required.²²⁴ For example, in order to stream songs, interactive music platforms, such as Spotify, must acquire a public performance license from the owners of the sound recording and the musical work, as well as a reproduction license from the owner of the musical work.²²⁵

The music industry widely uses music licenses, and due to the vast amount of licenses required for a single project, copyright owners do not tend to negotiate licenses individually.²²⁶ The copyright owner, such as the record label, will often license the sound recording to distributors, who in turn license it to the ultimate user.²²⁷ Assuming that the trademark is licensed in the same way, musicians would license their trademarks to distributors, and distributors would, in turn, sublicense the trademark to the ultimate user. However, courts have rarely addressed the quality control requirement in the context of sublicensing.²²⁸ Given that owners of sound marks in music may often utilize sublicensing, this adds even more uncertainty for the owners of these marks and leaves them vulnerable to the possibility of a canceled trademark. One suggestion offered to avoid this issue is that trademark owners simply license directly to the sub-licensee.²²⁹ Yet, even without the added complication of sublicensing, as mentioned before, musicians are still left without guidance on what constitutes quality control. Exerting actual control in the music context is less practical due to the wide range of uses for music and the sheer volume of licenses required to complete a single work or

²²¹ 17 U.S.C. § 106.

²²² James A. Johnson, *Thou Shalt Not Steal: A Primer on Music Licensing*, 80 N.Y. ST. BAR J. 23, 23 (2008).

²²³ Tomlinson & Nielander, *supra* note 209, at 286.

²²⁴ Johnson, *supra* note 222, at 23.

²²⁵ 17 U.S.C. § 114(d)(2)(A)(i); Mary LaFrance, *Music Modernization and the Labyrinth of Streaming*, 2 BUS. ENTREPRENEURSHIP & TAX L. REV. 310, 314 (2018); Jeff Price, *The Definitive Guide to Spotify Royalties*, VI.BE, 1, 14, <https://vi.be/files/research/the-definitive-guide-to-spotify-royalties-by-jeff-price-3.pdf> (last visited Mar. 9, 2022).

²²⁶ Arewa, *supra* note 162, at 637.

²²⁷ Price, *supra* note 225, at 5.

²²⁸ William M. Brochard & Richard M. Osman, *Trademark Sublicensing and Quality Control*, 70 TRADEMARK REP. 99, 100 (1980).

²²⁹ *Id.* at 112.

stream an album. Furthermore, music licensing is already expensive. Still, the administrative costs of the quality control requirement will be added to an already expensive process.²³⁰ While musicians nowadays rely on music streaming rather than just album sales,²³¹ these administrative costs and control requirements may be too burdensome on music platforms that are already highly susceptible to losses.²³²

The current music licensing scheme is complicated and highly regulated.²³³ Yet, hip-hop and R&B, the genres this type of trademark is predicted to be used most in,²³⁴ rely heavily on music licensing for samples.²³⁵ Thus if a hip-hop artist, for example, were to obtain licenses for a song containing a sound trademark, the artist would have the added hurdle of trademark licensing and the quality control requirement. As detailed above, trademark owners have no clear guidance on the requirement.²³⁶ This issue may be worsened for owners of sound trademarks in musical sound recordings. Correspondingly, licensing songs with sound trademarks would be even more complicated and time-consuming than it already is.

IV. PROPOSAL

Trademark law provides an avenue through which musicians may create and enforce a personal brand apart from their relationships with their record

²³⁰ See Parks, *supra* note 77, at 559.

²³¹ Paula Mejia, *The Success Of Streaming Has Been Great For Some, But Is There a Better Way?*, NPR (July 22, 2019, 6:00 AM), <https://www.npr.org/2019/07/22/743775196/the-success-of-streaming-has-been-great-for-some-but-is-there-a-better-way>.

²³² See James H. Richardson, *The Spotify Paradox: How the Creation of a Compulsory License Scheme for Streaming on-Demand Music Platforms Can Save the Music Industry*, 22 UCLA ENT. L. REV. 45, 57–58 (2014) (detailing that the current music licensing scheme jeopardizes Spotify's ability to be profitable in the long term).

²³³ Lenard & White, *supra* note 11, at 134. Lenard & White note several complications in their article, among these is the difficulty to determine “market-rate benchmarks for both music composition and sound recording performance rights” because the rates are determined administratively or by a rate court. *Id.* at 141. Further, there are “different transaction costs for licensing rights” based on the use. *Id.* at 143.

²³⁴ Connie Ogle, *Pitbull is now the Owner of the Sound ‘EEEEEEYOOOOO.’ Say it and You May Owe Him Money*, MIAMI HERALD (Apr. 17, 2020, 10:57 AM), <https://www.miamiherald.com/miami-com/miami-com-news/article242059686.html>.

²³⁵ See *supra* notes 163–164 and accompanying text (defining sampling). See generally Arewa, *supra* note 162, at 550 (discussing the impact of copyright law on hip hop); Josh Norek, Comment, “You Can’t Sing Without the Bling”: *The Toll of Excessive Sample License Fees on Creativity in Hip-Hop Music and the Need for a Compulsory Sound Recording Sample License System*, 11 UCLA ENT. L. REV. 83 (2004) (discussing the effect of music licensing on hip hop and arguing for an alternative music licensing scheme for the genre to lower licensing costs).

²³⁶ Calboli, *supra* note 9, at 374.

labels and their music careers.²³⁷ By granting Pitbull's sound marks, the USPTO paved the way for musicians to protect critical components of their music personas.²³⁸ As such, sound trademarks in music recordings are an effective tool for musicians, as well as the consumer the Lanham Act seeks to protect.²³⁹ An expansive reading of *Dastar* may render this type of mark enforceable, and appropriately, the Supreme Court should clarify its holding to ensure owners of this type of mark may enforce their sound marks. The Court should explicitly hold that plaintiffs may bring concurrent copyright and trademark claims. Additionally, because the quality control requirement of trademark licensing may prove to be an added difficulty for sound marks in musical recordings, Congress should amend the Lanham Act so musicians may easily license their marks. This amendment would dispose of the quality control requirement for sound trademarks allowing musicians (and other sound mark owners) to freely license their sounds.

A. *Enforcement*

Sound trademarks within musical recordings implicate both trademark and copyright law. Although sound marks in music recordings are novel, if copiers infringe on musicians' trademarks, musicians should still be able to enforce their trademarks as other trademark owners do. Yet, due to the overly expansive readings of *Dastar*, musicians may be prevented from bringing their trademark claims. In barring trademark claims where copyright law provides an adequate remedy and altogether holding that the Copyright Act preempts or precludes the Lanham Act, courts have expanded the Supreme Court's holding in ways the Court did not predict.²⁴⁰ In light of these lower court decisions, the Supreme Court should clarify its *Dastar* holding.

The Supreme Court's holding in *Dastar* was limited.²⁴¹ The case involved an owner of a formerly copyrighted work attempting to use trademark law to force a copier to give credit.²⁴² The Court ultimately held that trademark law could not be used in such a manner.²⁴³ Behind the Supreme Court's holding was a simple policy rationale: Congress designed copyrights, not the Lanham Act, to protect originality.²⁴⁴ Therefore, the Supreme Court stated it was

²³⁷ See Kessler, *supra* note 2, at 546–48.

²³⁸ See McNaughton et al., *supra* note 5, at 183.

²³⁹ *Id.* at 189.

²⁴⁰ Bell, *supra* note 145, at 208.

²⁴¹ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 38 (2003).

²⁴² *Id.* at 25.

²⁴³ *Id.* at 38.

²⁴⁴ *Id.* at 34.

“careful to caution against misuse or over-extension’ of trademark and related protections into areas traditionally occupied by patent or copyright.”²⁴⁵ Had the Court interpreted the Lanham Act to protect authors of formerly copyrighted works in the public domain, it would have created a “mutant copyright law” that would have interfered with the public’s right to use expired copyrighted works.²⁴⁶

Nonetheless, lower courts have used the Supreme Court’s holding to limit double recovery and to bar concurrent copyright infringement and trademark infringement claims.²⁴⁷ When the Court first issued its decision, many understood correctly: one could not bring suit arising out of the Lanham Act to claim ownership of a formerly copyrighted work now in the public domain.²⁴⁸ But as time went on, lower courts began to understand *Dastar* differently.²⁴⁹ Courts no longer considered the policy rationale behind the Supreme Court’s holding and solely focused on how the Supreme Court reached its policy goals, namely interpreting the word “origin” in § 43(a)(1)(A) of the Lanham Act.²⁵⁰ The Supreme Court held that “origin” does not mean the source or creator of the intellectual property but rather the producer of the goods. This shift in focus from the policy behind the Court’s holding to the means the Court used to reach its policy goals has led to lower courts expanding the Supreme Court’s limited holding.²⁵¹

With this shift away from policy in mind, the Supreme Court should restate that plaintiffs may bring concurrent claims arising under the Lanham Act and Copyright Act when overlapping protection of the subject matter is available. Each arena of intellectual property law serves its own special goals. If multiple forms of intellectual property protect a single work, owners of the works should be able to bring claims arising under each type of intellectual property.²⁵² However, when the copyright has lapsed or the work is

²⁴⁵ *Id.*

²⁴⁶ *Id.*

²⁴⁷ *E.g.*, *Lions Gate Ent. Inc. v. TD Ameritrade Servs. Co., Inc.*, 170 F. Supp. 3d 1249, 1268–69 (C.D. Cal. 2016).

²⁴⁸ Bell, *supra* note 145, at 207–08.

²⁴⁹ *Id.* at 208.

²⁵⁰ *Id.*

²⁵¹ *See id.*

²⁵² *Frederick Warne & Co. v. Books Sales, Inc.*, 481 F. Supp. 1191, 1196 (S.D.N.Y. 1979) (“Because the nature of the property right conferred by copyright is significantly different from that of trademark, trademark protection should be able to co-exist, and possibly to overlap, with copyright protection without posing preemption difficulties.”); *see* Doris Estelle Long, *First, “Let’s Kill all the Intellectual Property Lawyers!”: Musings on the Decline and Fall of the Intellectual Property Empire*, 34 J. MARSHALL L. REV. 851, 891 (2001)

uncopyrightable, a plaintiff may only be barred from bringing a trademark claim when bringing a copyright claim is disguised as a § 43(a) claim, as was the case in *Dastar*.²⁵³

This new rule would clarify the existing *Dastar* holding, which did not address the possibility of concurrent overlapping protection at all.²⁵⁴ The rule also would further the Supreme Court's policy rationales behind the *Dastar* holding. Under this new rule, a plaintiff would still be unable to use the Lanham Act to force copiers to attribute credit of works in the public domain.²⁵⁵ Further, this proposed rule provides a solution to the problems that emanate from concurrent protection.²⁵⁶ Musician-sound-mark-owners would be able to bring trademark claims against copiers regardless of whether an adequate remedy lies in the Copyright Act. This allows these owners to bring a claim under the Lanham Act regardless of whether the record label chooses to bring a claim under the Copyright Act.²⁵⁷

Additionally, the proposed rule would settle the contradictory holdings in federal courts. While some courts have held that the Copyright Act precludes or preempts the Lanham Act,²⁵⁸ other courts have allowed plaintiffs to bring concurrent claims under both acts.²⁵⁹ For example, the United States Court

("[Hostility to intellectual property rights] ignores the different nature of each form of intellectual property: each form was created to protect a particular aspect of intellectual productivity.").

²⁵³ *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 38 (2003).

²⁵⁴ *Moffat*, *supra* note 116, at 1526. *Dastar* addressed sequential protection but not concurrent protection. *Id.*

²⁵⁵ *See Dastar*, 539 U.S. at 38.

²⁵⁶ *See Moffat*, *supra* note 116, at 1527.

²⁵⁷ *See Jackson v. Roberts*, 972 F.3d 25, 41–42 (2d Cir. 2020).

²⁵⁸ *See, e.g., Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 595 (9th Cir. 2000); *Conf. Archives, Inc. v. Sound Images, Inc.*, No. 3:2006-76, 2010 U.S. Dist. LEXIS 46955, at *37 (W.D. Pa. 2010); *Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 U.S. Dist. LEXIS 25385, at *12 (N.D. Cal. 2010); *Lions Gate Ent. Inc. v. TD Ameritrade Servs. Co.*, 170 F. Supp. 3d 1249, 1264 (C.D. Cal. 2016).

²⁵⁹ *Am. Soc'y for Testing & Materials v. Public.Resource.Org, Inc.*, 896 F.3d 437, 453 (D.C. Cir. 2018) (holding that *Dastar* did not apply to the case and genuine issues of material fact precluded summary judgment of copyright and trademark claims); *Lyons P' ship v. Giannoulas*, 179 F.3d 384, 387 (5th Cir. 1999) (noting that the plaintiff sued for among other things, unfair competition and trademark dilution under the Lanham Act as well as copyright infringement); *Ward v. Andrews McMeel Publ'g, LLC*, 963 F. Supp. 2d 222, 236 (S.D.N.Y. 2013) ("Dastar does not foreclose Lanham Act claims that are based on the same underlying conduct as copyright claims . . . [C]ourts have continued to find that trade dress infringement claims are not duplicative of copyright claims and allow plaintiffs to assert both causes of action simultaneously."); *Nirvana, LLC v. Mark Jacobs Int'l, LLC*, No. LA CV18-10743 JAK (SKx), 2019 U.S. Dist. LEXIS 225708, at *39 (C.D. Cal. Nov. 8, 2019) ("The

of Appeals for the Fifth Circuit (Fifth Circuit) stated:

The federal Copyright Act does not preempt the federal Lanham Act, or vice-versa. In fact, it is common practice for copyright owners to sue for both infringement under the 1976 Copyright Act and unfair competition under the Lanham Act. Such a litigation posture has never been disallowed by the courts on grounds of either preemption or impermissible double recovery.²⁶⁰

A clarification of the *Dastar* holding would affirm the holdings of courts, like the Fifth Circuit, that have explicitly allowed plaintiffs to bring concurrent claims. Furthermore, the proposed rule affirms law already found in the Copyright Act. The Copyright Act explicitly provides that no part of the Act “limits any rights or remedies under any other Federal statute.”²⁶¹ Nonetheless, lower courts have used the current *Dastar* holding to contradict the Copyright Act.²⁶²

Lastly, this new rule would not completely overturn over a decade of cases. While the Supreme Court unequivocally stated that its holding only applied to the “trademark” prong of Section 43(a) of the Lanham Act, courts have often extended the Supreme Court’s holding to the “false advertising” prong.²⁶³ The proposed rule would allow courts to continue applying *Dastar* to the “false advertising” prong of Section 43(a) of the Lanham Act.²⁶⁴ Under the proposed rule, lower courts that apply *Dastar* to the false advertising prong of Section 43(a) would not bar concurrent claims for trademark and copyright infringement, as the rule would only apply when a copyrighted work has fallen into the public domain. More importantly, intellectual property law is everchanging and likely to expand.²⁶⁵ *Dastar* provided little guidance,²⁶⁶ yet this new rule gives courts more guidance while allowing the expansion of intellectual property. New marks, like Pitbull’s sound marks,

Lanham Act claim cannot be preempted by the Copyright Act. With an exception not relevant here, ‘nothing in [the preemption provision] or elsewhere in the [Copyright] Act annuls or limits any rights or remedies under any other Federal Statute.’” (quoting 1 NIMMER & NIMMER, *supra* note 108, § 1.19)).

²⁶⁰ *Alameda Films S A De C V v. Authors Rts. Restoration Corp.*, 331 F.3d 472, 482 (5th Cir. 2003).

²⁶¹ 17 U.S.C. § 301(d).

²⁶² 1 MCCARTHY, *supra* note 26, § 6:15.

²⁶³ *Id.* § 27:78.

²⁶⁴ *See id.*; *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 37 (2003).

²⁶⁵ *Moffat*, *supra* note 116, at 1530.

²⁶⁶ *Id.* at 1528.

are allowed to be enforced under this new rule, unlike under the liberal interpretations of *Dastar*.²⁶⁷

B. *Licensing*

Just as musicians should be able to enforce their sound marks, they should similarly be able to license the marks in songs with ease. The potential implications of the quality control requirement on sound marks in music are undeniable. Courts have defined quality control on a case-by-case basis resulting in inconsistent and contradictory results.²⁶⁸ While some courts differ on the type of control required, and other courts differ on the requirement of product quality, some courts differ on who may even exert control.²⁶⁹ No matter the result of the case-by-case analysis, owners of sound marks in songs will be left without guidance on what constitutes a valid trademark license. Furthermore, music licensing is already complicated without the added obstacle of a quality control requirement.²⁷⁰ Owners of sound marks in music recordings would benefit from an amendment to the Lanham Act disposing of the quality control requirement for sound marks. This new licensing standard would provide flexibility for licensors and licensees while still protecting against consumer deception.

The current quality control standard has its statutory basis in § 45 of the Lanham Act, particularly the “related company” definition.²⁷¹ This definition states that a related company is “any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.”²⁷² However, this definition should be amended to allow for a flexible approach towards sound marks. A “related company” should instead be defined as “any person whose use of a mark, not consisting of a sound mark, is controlled by the owner of the mark with respect to the nature and quality of the goods or

²⁶⁷ 1 MCCARTHY, *supra* note 26, § 6:15.

²⁶⁸ Calboli, *supra* note 9, at 364–65.

²⁶⁹ See *Dawn Donut Co. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 369 (2d Cir. 1959); *Joseph Bancroft & Sons Co. v. Shelley Knitting Mills, Inc.*, 212 F. Supp. 715, 740 (E.D. Pa. 1962); *Alligator Co. v. Robert Bruce, Inc.*, 176 F. Supp. 377, 378–79 (E.D. Pa. 1959); Calboli, *supra* note 9, at 368; see *Land O’Lakes Creameries, Inc. v. Oconomowoc Canning Co.*, 330 F.2d 667, 670 (7th Cir. 1964); see also *Embedded Moments, Inc. v. Int’l Silver Co.*, 648 F. Supp. 187, 194 (E.D.N.Y. 1986); *Bishops Bay Founders Grp., Inc. v. Bishops Bay Apts., LLC*, 301 F. Supp. 2d 901, 909 (W.D. Wis. 2003).

²⁷⁰ Lenard & White, *supra* note 11, at 134; see *supra* note 233 and accompanying text.

²⁷¹ Calboli, *supra* note 9, at 396.

²⁷² Lanham Act § 45, 15 U.S.C. § 1127.

services on or in connection with which the mark is used.”²⁷³ This amendment would exempt sound marks from the quality control requirement, thus freeing owners of sound marks in music recordings to license songs without an added difficulty of the quality control requirement or fear of a naked licensing claim.

Considering the current state of trademark licensing, musician-sound-mark-owners may be left confused as to how to validly license their marks.²⁷⁴ While the quality control requirement does some good in product distribution and marketing by ensuring the same or similar quality in products,²⁷⁵ these benefits do not translate well to sound trademarks in music recordings. A change in the current quality control requirement removes the guesswork for owners of sound marks and allows these owners to freely license their sounds without claims of naked licensing potentially being used as a defense or counterclaim by alleged infringers.²⁷⁶

In light of the current licensing scheme, musicians will not be in a position to exert actual control. While some courts have held contractual control is enough, some courts have held otherwise.²⁷⁷ With the quality control requirement disposed of for sound recordings, owners of sound marks in music would be free to license their trademarks to third parties without fear of a court declaring their license to be invalid because the owner did not exert actual control. Additionally, a focus merely on the quality of the product in music licensing is not feasible. Disposal of the quality control requirement in this context would remove the focus from the quality of the music, which is a highly subjective analysis. Rather, with the requirement disposed of, the consumer instead of a court would be able to determine the quality of the music. Because, as one court noted, the consuming public is the best judge to determine the quality of the product.²⁷⁸

²⁷³ This amendment must also include an addition of a definition for sound mark. This definition will be in accordance with the TMEP definition of sound marks.

²⁷⁴ Calboli, *supra* note 9, at 374.

²⁷⁵ Noah D. Genel, Note, *Keep it Real: A Call for a Broader Quality Control Requirement in Traditional Trademark Law*, 8 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 269, 271 (1997); see Calboli, *supra* note 9, at 371.

²⁷⁶ See Calboli, *supra* note 9, at 399.

²⁷⁷ *Embedded Moments, Inc. v. Int'l Silver Co.*, 648 F. Supp. 187, 194 (E.D.N.Y. 1986) (holding that actual control is sufficient and that contractual control is unnecessary); *Bishops Bay Founders Grp., Inc. v. Bishops Bay Apts., LLC*, 301 F. Supp. 2d 901, 909 (W.D. Wis. 2003) (“[A]n oral license may be sufficient if actual control is exercised by the licensor.”); *Land O'Lakes Creameries, Inc. v. Oconomowoc Canning Co.*, 330 F.2d 667, 670 (7th Cir. 1964).

²⁷⁸ See *Ky. Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 387 (5th Cir. 1977).

Most importantly, a flexible approach to sound mark licensing still achieves the goal of the Lanham Act: eliminating consumer confusion or deception.²⁷⁹ The result of a successful naked licensing defense or counterclaim is that both the copier and the trademark owner are allowed to continue using the mark in question.²⁸⁰ Interestingly, a trademark owner's failure to control a licensee's use of the mark does not necessarily mean consumers will be deceived.²⁸¹ Rather, consumer deception arises most when licensors and licensees act in bad faith.²⁸² When dealing with products, both parties to a licensing agreement may act in bad faith by neglecting to notify the public of variations in product quality, leading the public to be deceived.²⁸³ However, in music, sound mark owners do not seem likely to license their sounds to another musician solely wanting to capitalize on the trademark owner's fame.²⁸⁴ This reduces the likelihood of consumer deception in this type of mark. Furthermore, a disposal of the quality control requirement for sound marks simply shifts the focus away from the licensor to the actions of the licensees. If the public is deceived, courts should shift their focus to whether the licensee acted in bad faith.

Disposal of the quality control requirement in sound trademarks—which would otherwise, in turn, affect licensing in the sound recording—also furthers the goals of the Copyright Act for music. As noted, the goal of copyright law is to foster innovation.²⁸⁵ By disposing of the quality control requirement in sound trademarks, licensors of sound recordings are left without an added complication. Accordingly, they will be left to grapple with the current music licensing scheme, which has not completely deterred music borrowing thus far.²⁸⁶

²⁷⁹ *Park 'n Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985).

²⁸⁰ Parks, *supra* note 77, at 558.

²⁸¹ Calboli, *supra* note 9, at 406.

²⁸² *Id.*

²⁸³ *See id.* at 405.

²⁸⁴ McNaughton et al., *supra* note 5, at 189.

²⁸⁵ 18 AM. JUR. 2D, *supra* note 84, § 2.

²⁸⁶ *See* Astride Howell, *Sample This!*, 28 L.A. LAW. 24, 28 (2005) (“The process of digital sampling continues to evolve. The use of existing sounds in new recorded songs is being accomplished through more novel technological methods. . . . Dangermouse voices what most musicians and producers feel when faced with the strictures of copyright law’ ‘Mashing is so easy. It takes years to learn how to play the guitar and write your own songs. It takes a few weeks of practice with a turntable to make people dance and smile. It takes a few hours to crank out something good with some software. So with such a low barrier to entry, everyone jumps in and starts immediately being creative.’”). Howell does note, however, that “[t]he costs associated with obtaining the necessary licenses may curb the *types* of songs that

Although music licensing is time-consuming and complicated, it has benefits.²⁸⁷ For centuries, musicians have borrowed others' music.²⁸⁸ Borrowing is so common that it is recognized as "fundamental" to the music creation process.²⁸⁹ One form of this borrowing, sampling, has become increasingly prominent in the record industry.²⁹⁰ Though commenters disagree on how copyright law should treat sampling, its effects on the music industry are unquestionable.²⁹¹ Sampling has been found to increase innovation in the music industry and increase sales in music.²⁹² Music artists' income from record sales has decreased in the digital age;²⁹³ however, an increase due to sampling could increase these artists' income.²⁹⁴ This use of music licensing, in particular, has been shown to increase sales of the original

will be sampled and used for new works." *Id.* at 30 (emphasis added). Regardless, some artists sample songs without proper clearance. For a discussion of unauthorized sampling and a proposed solution, see Ryan Lloyd, Note, *Unauthorized Digital Sampling in the Changing Music Landscape*, 22 J. INTELL. PROP. 143 (2014).

²⁸⁷ See generally Schuster et al., *supra* note 161 (analyzing an increase in music sales due to sampling, whether authorized (licensed) or unauthorized).

²⁸⁸ See Arewa, *supra* note 162, at 550, 601–08. Arewa uses Beethoven and Public Enemy as examples of instances of musical borrowing. *Id.* at 550. While both borrowed from other artists, Beethoven also borrowed from his own prior works. *Id.* at 550 n.3. Further, Arewa discusses the pervasiveness of musical borrowing throughout history. *Id.* at 612–19. While Arewa's article is informative, a look at the website WhoSampled.com further proves how often artists copy from each other. See WHOSAMPLED, whosampled.com (last visited Feb. 28, 2022). Significantly, when examining the effects of sampling on music sales, legal commentators used WhoSampled.com to aid their research. Schuster et al., *supra* note 161, at 203. The website provides visitors an opportunity to "[d]ig deeper into music by discovering direct connections among over 830,000 songs and 266,000 artists, from Hip-Hop, Rap and R&B via Electronic / Dance through to Rock, Pop, Soul, Funk, Reggae, Jazz, Classical and beyond." WHOSAMPLED, *supra* note 288. For example, a search of Pitbull reveals over 200 samples, 70 covers, and 270 remixes. Pitbull, WHOSAMPLED, <https://www.whosampled.com/Pitbull/> (last visited Feb. 28, 2022). In essence, Pitbull has borrowed from previously released songs over 500 times. See *id.* *Mi Gente*, which prompted Pitbull to protect his yell, displays a specific example of musical borrowing in modern times. The song, by J Balvin and Willy William, samples another Willy William song, *Voodoo Song*. *Mi Gente*, WHOSAMPLED, <https://www.whosampled.com/J-Balvin/Mi-Gente/> (last visited Feb. 28, 2022).

²⁸⁹ Santiago, *supra* note 202, at 306.

²⁹⁰ Arewa, *supra* note 162, at 550.

²⁹¹ Schuster et al., *supra* note 161, at 195–96 (noting that unauthorized sampling can lead to recognition from potential customers).

²⁹² *Id.* at 196.

²⁹³ Kessler, *supra* note 2, at 543.

²⁹⁴ Schuster et al., *supra* note 161, at 226.

work.²⁹⁵ With the quality control requirement disposed of, musicians will receive the benefits of increased sales²⁹⁶ without the added administrative fees associated with the quality control requirement.

Luckily, consumers will not have music prices increased due to the additional licensing cost.²⁹⁷ Likewise, music platforms whose costs are constantly changing will not see the increased cost from the quality control requirement. This is because the administrative fees associated with trademark licensing quality control requirements would not be added to the cost of licensing music.²⁹⁸ By allowing a more flexible licensing approach and disposing of the quality control requirement for sound marks, musicians are allowed to better protect their trademarks, continue contributing to the advancement of music, and prices remain unchanged to the consumer's benefit.

V. CONCLUSION

Sound trademarks in songs are an effective way of communicating with consumers,²⁹⁹ and trademarks play an indispensable role in brand protection for both individuals and companies.³⁰⁰ With many artists having unique call signs,³⁰¹ this type of mark may become prevalent in the music industry.³⁰² Yet, because both trademark and copyright laws are implicated in this type of mark, problems will undoubtedly arise. When the Supreme Court first

²⁹⁵ *Id.* Schuster conducted an empirical study of the effects of sampling on sales of copyrighted works. *Id.* at 178. The study identified songs (the original song or sampled song) sampled by newer songs on the Billboard Charts in the years 2006–2015. *Id.* The study then analyzed the sales of the original song before, during, and after the other song's rise on the Billboard Charts. *Id.* The study showed that three weeks before the new song entered the Billboard Charts, sales in the sampled, original song increased. *Id.* at 206. As the newer song rose in popularity, so did the sales of the original song, with sales of the original song peaking eight weeks after the new song entered the Billboard Charts. Schuster et al., *supra* note 161, at 206–07. Ultimately, the data showed that “to a 99.99% degree of statistical significance, sales of sampled songs increased after being repurposed in a new work.” *Id.* at 178.

²⁹⁶ *Id.* at 226.

²⁹⁷ *See id.*

²⁹⁸ *See* Calboli, *supra* note 9, at 399.

²⁹⁹ *See* Bumpus, *supra* note 24, at 249.

³⁰⁰ *See* Elizabeth L. Rosenblatt, *Rethinking the Parameters of Trademark Use in Entertainment*, 61 FLA. L. REV. 1011, 1019 (2009).

³⁰¹ *See* Genius, *From Metro Boomin to Zaytoven: Do You Know Your Producer Tags?* | *Genius News*, YOUTUBE (Apr. 13, 2018), <https://www.youtube.com/watch?v=acO8dRRTVhs>; janelle, *Jason Derulo singing his name for 1 minute*, YOUTUBE (June 30, 2020), <https://www.youtube.com/watch?v=sDEd3Emd4kg>.

³⁰² McNaughton et al., *supra* note 5, at 180.

decided *Dastar*, the holding was understood to mean that an author could not use the Lanham Act to force copiers to give credit for work in the public domain.³⁰³ Yet, as time went on, lower courts began expanding the Court's holding,³⁰⁴ even to the point of precluding claims of trademark infringement when the Copyright Act provides a remedy.³⁰⁵ The Supreme Court did not predict such an expansive reading of *Dastar*,³⁰⁶ and the Court should clarify its holding. The Supreme Court should restate that plaintiffs may bring concurrent claims arising under the Lanham Act and Copyright Act when overlapping protection of the subject matter is available. However, when the copyright has lapsed, or the work is uncopyrightable, a plaintiff may only be barred from bringing a trademark claim when bringing a copyright claim is disguised as a Section 43(a) claim.

This proposed rule provides a solution to the problems with concurrent protection.³⁰⁷ Musician-sound-mark-owners would be able to bring trademark claims against copiers regardless of whether an adequate remedy lies in the Copyright Act. The ability to bring concurrent claims would allow intellectual property rights holders to bring a claim under the Lanham Act even if their record label chooses or fails to bring a claim under the Copyright Act.³⁰⁸

Furthermore, the quality control requirement for trademark licensing adds difficulty to the already arduous music licensing process.³⁰⁹ The quality control requirement has been defined on a case-by-case basis, resulting in inconsistent and, at times, contradictory holdings.³¹⁰ Therefore, owners of sound marks in music recordings would benefit from an amendment to the Lanham Act disposing of the quality control requirement for sound marks. Disposal of the quality control requirement for sound marks would provide flexibility for licensors and licensees while still protecting against consumer deception. Sound mark owners do not seem likely to license their sounds to another musician solely wanting to capitalize on the trademark owner's fame,

³⁰³ Bell, *supra* note 145, at 207–08.

³⁰⁴ *Id.* at 208.

³⁰⁵ See, e.g., *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 595 (9th Cir. 2000); *Conf. Archives, Inc. v. Sound Images, Inc.*, No. 3:2006-76, 2010 U.S. Dist. LEXIS 46955, at *37 (W.D. Pa. 2010); *Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 U.S. Dist. LEXIS 45385, at *12 (N.D. Cal. 2010); *Lions Gate Ent. Inc. v. TD Ameritrade Servs. Co.*, 170 F. Supp. 3d 1249, 1264 (C.D. Cal. 2016).

³⁰⁶ Bell, *supra* note 145, at 208.

³⁰⁷ See Moffat *supra* note 116, at 1527.

³⁰⁸ See *Jackson v. Roberts*, 972 F.3d 25, 26–27 (2d Cir. 2020).

³⁰⁹ Lenard & White, *supra* note 11, at 134.

³¹⁰ Calboli, *supra* note 9, at 364–65.

and consumer deception often arises when both licensors and licensees act in bad faith.³¹¹

Additionally, although music licensing is complicated, it has benefits.³¹² Because one use of licensing, sampling, is shown to increase music sales in the original work, musicians may generate more income from record sales,³¹³ and consumers do not have to pay an increased price in music because of the administrative costs of the quality control requirement.³¹⁴ By allowing a more flexible licensing approach, musicians are allowed to continue contributing to the advancement of music, and prices are left unchanged to the benefit of the consumer. By solving issues that arise with sound marks in song recordings, musicians benefit from the added protection of their brands, and consumer deception is ultimately prevented.

³¹¹ McNaughton et al., *supra* note 5, at 189.

³¹² *See generally* Schuster et al., *supra* note 161 (discussing the effects of sampling on music sales).

³¹³ *Id.* at 226.

³¹⁴ *See id.*