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Two Copyright Claim Wrongs Don't Make a Copyright Claim Right: Analyzing Melendez v. Sirius XM Radio, Inc.

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On October 4, 2022, a Second Circuit panel affirmed the lower court's decision that defendant Sirius XM Radio Inc.'s ads showcasing *The Howard Stern Show* do not violate plaintiff John Edward Melendez's publicity rights. The ruling affirmed the Southern District of New York's grant of defendant's motion to dismiss plaintiff's claims under California common and statutory law, agreeing that plaintiff Melendez's claims were preempted by the Copyright Act, 17 U.S.C. § 301.

While Courts do not often find that the Copyright Act has been implicated in the federal preemption doctrine, this is the second of such decisions in the Second Circuit in the past two years. The Court in *In re Jackson* held that Connecticut's common law right of publicity was preempted by the Copyright Act, setting forth the reasoning echoed in *Melendez*.

Plaintiff Melendez's claims arose from his character "Stuttering John" on *The Howard Stern Show* between 1988 and 2004. Defendant Sirius XM, a satellite and streaming radio provider, airs newly-released episodes of *The Howard Stern Show*, as well as full and partial past episodes from archives that feature Melendez's performances. The radio provider had previously obtained a license to air current, newly-released, and past episodes from *The Howard Stern Show* as part of a $500 million agreement to transition Stern's show to satellite radio in 2006. Plaintiff asserts the use of clips of him from the archival episodes in its advertisements promoting *The Howard Stern Show* violate his right to publicity under California common and statutory law because his identity, persona, name and likeness have been exploited for Sirius XM's commercial gain without his permission.

The Second Circuit determined that Plaintiff failed to plausibly allege any use of his name or likeness that is separate from, or beyond, the rebroadcasting of the copyrightable material from the show's archives, and held his right of publicity claims are preempted by the Copyright Act. While federal preemption is typically an affirmative defense, the Court reasoned that it may be used to support a motion to dismiss if the federal statute's barrier to suit is evident from the face of the complaint.

Applying a two-part test to determine whether the state publicity claims are preempted, the Court considered (1) the subject matter and (2) the general scope of the claims. The subject matter prong looks to whether the works at issue fall within the subject matter of copyright as defined in the Copyright Act. For this analysis, the Court compared the dispute to the publicity claims of the rapper known professionally as 50 Cent in *In Re Jackson* mentioned above. The Court's decision there focused on whether the claim centered on the recognizable sound of 50 Cent's voice— which would not be within the subject matter of copyright— or the copyrighted work in which the voice is embodied, which *is* within the subject matter of copyright. Ultimately, the Court held that the subject matter prong was satisfied, as the focus of 50 Cent's claim was the musical composition and sound recording of his performance, which is the copyrighted works themselves, rather than his identity.

The Second Circuit in *Melendez* similarly found that plaintiff's right of publicity claims came within the category of sound recordings of the Copyright Act, as Sirius XM used sound clips to promote Stern's show, and thus satisfied the subject matter prong. Moreover, Melendez failed to allege his name or likeness was taken or manipulated in any way to appear independently from how it originally appeared in the episodes, and failed to show how Sirius XM appropriated his name or likeness to sell a product or service other than to promote *The Howard Stern* show.

As to the second prong, the Court held the general scope preemption requirement was satisfied. As in *In re Jackson*, the Court reasoned the challenged act under state law did not differ qualitatively from a copyright infringement claim brought under the federal Copyright Act. Because Melendez failed to articulate any allegations he could add to overcome preemption, the Court agreed the claims should be dismissed with prejudice.

This decision reinforces the circuit split between the Second, Eighth, and Ninth Circuits, which have adopted the copyright preemption doctrine to right of publicity claims in the entertainment context versus the Third, Fifth, Seventh, and Tenth Circuits, which have, in limited circumstances, declined to apply the doctrine to right of publicity claims when commercial or advertising uses are implicated. This creates an issue ripe for consideration by the U.S. Supreme Court.

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