IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF TENNESSEE
NASHVILLE DIVISION

BRIDGEPORT MUSIC, INC., and SOUTHFIELD MUSIC, INC.	)	
v.	)	No. 3-01-0738
	)	JUDGE CAMPBELL
TOMMY BOY MUSIC, INC., et al.	)	

ORDER

Pending before the Court is Defendants' Motion to Dismiss And Strike (Docket No. 3), and the Plaintiffs' Response (Docket No. 6). For the reasons stated herein, the Motion is GRANTED regarding Plaintiffs' Tennessee Consumer Protection Act claim. The Motion is otherwise ruled upon by separate order entered contemporaneously herewith.

Defendants argue that Plaintiffs' claim under the Tennessee Consumer Protection Act, §§ 47-18-101, et seq. ("TCPA"), is preempted by the Copyright Act, 17 U.S.C. § § 101, et seq.[1]

Section 301(a) of the Copyright Act provides:

> On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

17 U.S.C. § 301(a). A state law claim is preempted under Section 301 if (1) it involves the same

[1] In a previous decision, this Court held that a negligence claim contained in Plaintiffs' original Complaint was preempted by the Copyright Act. Bridgeport Music, Inc. v. 11C Music, 154 F.Supp.2d 1330 (M.D. Tenn. 2001). The Court also held that Plaintiffs had standing to sue under the TCPA. Id.

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subject matter as copyright, and (2) it invokes rights equivalent to those exclusively available in copyright. Wrench LLC v. Taco Bell Corp., 256 F.3d 446, 453 (6th Cir. 2001). If, on the contrary, "an extra element is required instead of or in addition to the acts of reproduction, performance, distribution or display in order to constitute a state-created cause of action, there is no preemption, provided that the extra element changes the nature of the action so that it is qualitatively different from a copyright infringement claim." Id., at 456.

Plaintiffs allege that Defendants violated the TCPA as follows:

> 82. The defendant, among other things, either: (1) filed false, unfair, and deceptive copyrights, or had such filed on its behalf, which misrepresented the true origin of the Infringing Composition and/or Sound Recording; and/or (2) misrepresented the true and correct origin of the Infringing Composition and/or Sound Recording on the song itself and the inserts that are packaged with the Records and sold to the public. The song then was sold to consumers in the State of Tennessee, and elsewhere, who relied on the false, deceptive, and unfair representations made by the defendant, as described fully above, when such consumers purchased what they believed was an original, non-infringing Composition and/or Sound Recording.
>
> 83. The acts of the defendant were intended to harm plaintiffs, and the consumers in Tennessee and elsewhere, insofar as the defendant wanted the general public to believe that the Infringing Composition and/or Sound Recording was an original work, and did not want plaintiffs put on notice to pursue their claims of copyright infringement. By the actions described more fully above, and throughout this Complaint, plaintiffs then indeed were damaged when the general public purchased the Infringing Composition and/or Sound Recording, the public did not know its true origin and thus would not know to purchase plaintiffs' original works, plaintiffs did not receive any royalties to which they were lawfully entitled, and plaintiffs were not put on notice to pursue their claims of copyright infringement.

(First Amended Complaint (Docket No. 1)).

The sound recordings and musical compositions at issue in this claim clearly fall within the subject matter of copyright. See 17 U.S.C. § 102(a)(2), (7) (describing "works of authorship" protectable in copyright).

As for the second inquiry, "Equivalency exists if the right defined by state law may be abridged by an act which in and of itself would infringe one of the exclusive rights." Wrench, 256 F.3d at 456. See also 1 M. Nimmer & D. Nimmer, Copyright § 1.01[B][1] (1997) ("Thus, in essence, a right that is 'equivalent to copyright' is one that is infringed by the mere act of reproduction, performance, distribution, or display."). Plaintiffs' TCPA claim essentially alleges that Defendants have used, as their own, sound recordings and musical compositions that Plaintiffs have an exclusive right to use or license for use without disclosing Plaintiffs' ownership. Several courts have held that this type of claim, characterized as "reverse passing off," is preempted by the Copyright Act. See, e.g., Kregos v. The Associated Press, 3 F.3d 656, 665-66 (2d Cir. 1993); CoStar Group, Inc. v. LoopNet, Inc., 164 F.Supp.2d 688, 712-14 (D.Md. 2001); Goes Lithography Co. v. Banta Corp., 26 F.Supp.2d 1042, 1047-48 (N.D. Ill. 1998); Marobie-Fl, Inc. v. National Assoc. of Fire Equipment Distributors and Northwest Nexus, Inc., 983 F.Supp. 1167, 1179-80 (N.D. Ill. 1997).

As the court explained in CoStar:

> Essentially, CoStar's claim is that LoopNet is exhibiting as its own photographs on its web site that CoStar has an exclusive right to exhibit or license for exhibition. This type of reverse passing off is, in effect, a 'disguised copyright infringement claim.' 1 Nimmer on Copyright, § 1.01[B][1][e], at 1-28 (2001); see also American Movie Classics [v. Turner Entm't Co.,], 922 F.Supp. [926] at 934 [S.D.N.Y. 1996]. The same act which constitutes LoopNet's alleged copyright infringement, the unauthorized copying of CoStar's photographs, also constitutes CoStar's unfair competition claim. Therefore, this claim does not satisfy the 'extra-element' test and so is equivalent to CoStar's claim under the Copyright Act.

164 F.Supp.2d at 714. See also Goes Lithography Co., 26 F.Supp.2d at 1047-48 (Absent an affirmative representation about the origins of the work in question, the inherent misrepresentation that accompanies the unauthorized copying and reproduction of another's copyrighted work in a reverse passing off case without more is not enough to avoid preemption).

This Court agrees with the reasoning of these courts, and holds that Plaintiffs' TCPA claim is preempted by the Copyright Act.

Accordingly, the Motion To Dismiss And Strike (Docket No. 3) is granted regarding Plaintiffs' TCPA claim and the TCPA claim is dismissed.[2] The Motion is otherwise ruled upon by separate order entered contemporaneously herewith.

The Clerk shall post this Order on the Court's website (http://tnmd.uscourts.gov/) under "Bridgeport Music: Selected Orders" with the designation "Order-TCPA" followed by the docket number and date.

It is so ORDERED.

TODD J. CAMPBELL
UNITED STATES DISTRICT JUDGE

[2] The dismissal of the TCPA claim shall apply to all related Bridgeport cases wherein the Court has entered an order providing that motions regarding preemption of the TCPA shall be controlled by an order entered in this case.