

BIG LEGAL BATTLES OVER RIGHTS IN BANDS' NAMES

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From The Slants to The Doors and numerous other music groups, litigation over rights in band names is a common recurring music industry issue. The Slants’ case resulted in a groundbreaking U.S. Supreme Court decision in 2017 on trademark rights in controversial band names. The Doors case had its roots in a voting rights agreement the band members entered into decades before. And a recent dispute involving “Jefferson Starship” offers a cautionary tale about name rights battles, while considering—as did The Doors case—the legal parameters of use of a former band member’s name and likeness in conjunction with continued touring by other Jefferson Starship band members.

This article covers some of the legal essentials of rights in band names, followed by discussion of The Slants, The Doors and Jefferson Starship litigations.

Introduction to Trademark Rights

Let’s begin by defining “trademarks” and “service marks.” A “trademark” is a name, phrase, word, or symbol—like a band name and logo on an album—that identifies the provider of a good. A “service mark” applies to a provider of services such as a band that performs in concerts. (Trademarks and service marks are sometimes referred to generically in this article as “trademarks.”)

State law protects trademarks but to a lesser extent than wider-ranging federal law. States offer “common law” (i.e., legal principles developed by courts) and statutory protection for trademarks. Music groups can register their band names in the state in which they are based, although state protection has little effect outside the state in which the name is registered. A primary reason for registering under state law is the low trademark-filing cost.

Federal trademark registrations are filed with the [U.S. Patent and Trademark Office](#) (PTO) and apply to uses in interstate commerce. Trademark and service mark filing fees are charged for each class of registration (e.g., there is one for use on apparel and another for use in entertainment services). The current fee for filing an electronic application ranges from \$225 to \$400 per class; for a paper application, it is \$600 per class.

As a placeholder, an application may be filed with the PTO for an “intent to use” a trademark in interstate commerce. The intent must be in good faith and use must begin no later than three years after the PTO approves the intent-to-use application.

An approved PTO class registration provides “prima facie” evidence that a trademark is valid. (Prima facie evidence confirms a fact that a challenger then has the burden of disproving.) But registration “does not create a mark or confer ownership; only use in the marketplace can establish a mark,” the Ninth Circuit has noted. *Miller v. Glenn Miller Productions Inc.*, 454 F.3d 975 (9th Cir. 2006).

At the same time, “[n]either application for nor registration of a mark at the federal level wipes out the prior, non-registered, common law rights of others,” the Western District of Washington found in upholding common law use by the version of the “Wailers” co-founded by the late reggae legend Bob Marley over an unrelated, though long-running Wailers rock band that had obtained federal registration of the “Wailers” name. *Ormsby v. Barrett*, 85 U.S.P.Q.2d 1700 (W.D.Wash. 2008).

The Lanham Act

The federal Lanham Act, 15 U.S.C. Sec. 1051 *et seq.*, is the primary U.S. civil statute that covers trademarks in interstate commerce. The Lanham Act entitles the owner of a protectible trademark to civil remedies against infringers. The statute’s underlying purpose is to protect consumers against a “likelihood of confusion” as to product affiliation, commercial sponsorship or origin.

Bands that advertise and work in more than one state, but haven’t obtained federal registration, may seek trademark protection under Sec. 43(a) of the Lanham Act. Section 43(a), 15 U.S.C. Sec. 1125(a), prohibits “any false designation of origin, false or misleading description of fact, or false or misleading representation of fact.”

Trademark Categories

There are four categories of trademarks; three of which are distinctive enough to be protected under the Lanham Act. In ascending order of protection, they are:

- A “generic” term isn’t protectible as a trademark if the term *is* the category of the user’s good or service (e.g., “Music”)—though a distinctive logo that includes a generic name could be protectible.
- A “descriptive” trademark, which describes the product or service (e.g., “The Hip Hop Calypso Band”), may be protectible if it acquires secondary meaning. “Secondary meaning” occurs when the public associates a name, phrase, word, or symbol with the product or service.

- Next are “suggestive” trademarks, which are distinctive and conjure up but don’t directly describe a product or service (e.g., a Led Zeppelin-influenced band named “Heavy Bottom”). Suggestive trademarks can be protectible regardless of whether secondary meaning exists.
- The most protectable trademarks are “arbitrary,” or “fanciful,” names. An arbitrary trademark requires no association with the product or service, as in a band named “Going Home.”

Proving Likelihood of Consumer Confusion

Courts consider several factors in determining whether a likelihood of consumer confusion exists in a Lanham Act case. Common factors include:

- The strength of the plaintiff’s trademark or service mark
- The degree of similarity between the marks and products in dispute
- The marketplace proximity of the goods or services
- The defendant’s intent
- Whether actual public confusion exists
- The sophistication of the relevant consumer base

Rights in Band Names Among Group Members

If members of a band have no formal agreement regarding use of its name, any member of the group may have the right to use the name if the band breaks up. In the absence of written restrictions, a band member fired without just cause might be able to form a competing band with the same name. Which member of a group was first to use a descriptive band trademark may not resolve whether a particular member has greater rights. The determinative issue can be who was in the group when the band’s name acquired secondary meaning.

A written intra-band agreement should address rights in the band name. The band agreement may specify that one or more members own the name. Or the agreement may state that the band name belongs to a particular member who is loaning it to the group. Group members who own the name may want a greater share of income from its use, including from merchandise, endorsement, and other licensing deals.

For an incorporated music group, the corporate entity could own the band name. A member who leaves and sells his or her corporate interest in the group may then give

up legal rights to the name. However, a leaving member could ask for the right to be publicly identified as a former member of the group—although he or she will likely have the right to do so in any event, subject to the band name being used less prominently than the leaving member’s name in advertising and billing for the ex-member’s subsequent activities.

A band member who retains a corporate interest in a band but no longer performs with the group could still have contractual rights to income from use of the band name. On the other hand, a member who performs with the band but owns no stock in the group’s corporation could be asked to sign an agreement disclaiming any rights in the band name.

Abandonment

A group that breaks up could lose its right to its band name if it abandons use. However, a “successful musical group does not abandon its mark unless there is proof that the owner ceased to commercially exploit” the group’s trademark “in the music industry.” *Marshak v. Treadwell*, 58 F.Supp.2d 551 (D.N.J. 1999). Under this test, continued catalog record sales, combined with a timely objection to use of the band name by others, may serve as a defense to an abandonment claim even though the original band isn’t currently selling new recordings.

Concept Groups

Numerous concept groups have been formed by managers, record producers, or record companies. Group members often are required to sign agreements acknowledging that the entity creating the group owns the name. Even without a formal agreement, a manager, producer, or record company may gain ownership of a group name by exhibiting sufficient artistic control.

State Truth-in-Music Advertising Laws

Uses of group names for live performances are regulated in more than 30 states by Truth-in-Music Advertising statutes. These statutes are intended to prevent “false, deceptive or misleading affiliation, connection or association” between a recording group and a performing group.

Truth-in-Music Advertising laws generally require one of the following:

- At least one original commercial-recording member of the group who has the legal right to use and hasn't abandoned the group name is involved in a live performance
- The original recording group has authorized the live performance
- The valid owner of a federally registered service mark for the group name has authorized the live performance
- Tribute groups are identified as such in all advertisements and promotions.

The Doors Case

The Doors formed in 1966, but decades later—long after the band's iconic lead singer Jim Morrison had died—the legendary group's three then-surviving members found themselves battling in court. The plaintiffs included drummer John Densmore and Morrison's parents. The defendants were guitarist Robby Krieger and keyboardist Ray Manzarek. The suit was prompted by a partnership contract the four original members of The Doors had entered into. The agreement stipulated that “*management and control of the partnership business shall be determined by unanimous agreement of all partners.*”

In the 1960s, Morrison went ballistic over a proposal to feature the band's classic hit “Light My Fire” in an automobile ad. The Doors then amended their partnership agreement to require the prior written consent of all four group founders for such business decisions. When Morrison died in 1971, his parents inherited rights in his share of the band.

Krieger and Manzarek began touring in 2003 as “The Doors of the 21st Century,” with a new lead singer and drummer. Densmore became so angry that he sued over promotional use of the original Doors logo and the prominent billing size of “The Doors” in relation to the words “21st Century.” (Morrison's parents added a claim for unauthorized use of Jim Morrison's name and likeness.)

The Los Angeles Superior Court ultimately sided with the plaintiffs. Among other things, the jury decided that Krieger and Manzarek breached The Doors' partnership agreement. The trial judge ordered the defendants to place the more than \$3 million in profits earned by the “21st Century” into The Doors' partnership. The California Court of Appeal later affirmed (*Densmore v. Manzarek*, B186036 (Cal. Ct. App. 2008)), and the California Supreme Court declined to review the case.

The Slants Case

The Slants are an Asian-American rock band. Founder Simon Tam claimed he chose the group name as “a way to reclaim that stereotype and take ownership of” what otherwise could be viewed as a slur on Asian-Americans. But the U.S. Patent and Trademark Office refused to grant federal trademark registration for “The Slants” on the ground that it was “disparaging.”

Tam filed suit challenging the Lanham Act’s “disparaging” bar and the U.S. Supreme Court ruled the provision ran afoul of the rock band’s free speech rights under the First Amendment. *Matal v. Tam*, 137 S. Ct. 1744 (2017).

The federal government had argued trademark registration constituted “government speech” in which the music group had no First Amendment rights. But striking down the Lanham Act’s “disparaging” bar as unconstitutional, Justice Samuel Alito Jr. noted in the court’s majority opinion, “If the federal registration of a trademark makes the mark government speech, the federal government is babbling prodigiously and incoherently.”

Justice Alito added: “Speech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other similar ground is hateful; but the proudest boast of our free speech jurisprudence is that we protect the freedom to express ‘the thought that we hate.’”

Jefferson Starship Case

Paul Kantner, a co-founder of the influential 1960s rock band Jefferson Airplane, formed Jefferson Starship in 1970. Guitarist Craig Chaquico was an original Jefferson Starship member. After Kantner left Jefferson Starship in the mid-1980s, he entered into an agreement that allowed the remaining members to use “Starship” but retired the “Jefferson Starship” name. Chaquico stayed with Starship until 1990. When Kantner later toured as Jefferson Starship, he and Chaquico entered into an additional agreement that allowed Kantner to do so.

After Kantner died in 2016, Chaquico sued Kantner’s Jefferson Starship touring band members in the U.S. District Court for the Northern District of California for continuing to tour and sell Jefferson Starship merchandise. *Chaquico v. Freiberg*, 3:2017cv02423 (N.D.Calif. 2017).

In August 2017, U.S. Magistrate Judge Maria-Elena James allowed Chaquico to proceed with a breach of contract claim seeking concert and merchandising monies from current Jefferson Starship members David Freiberg and Donny Baldwin, who also were signatories to the mid-1980s Kantner, for monies earned after but not before Kantner died.

Through a claim under §43(a) of the federal Lanham Act, Chaquico also sought to bar the Jefferson Starship from using his name and his likeness. Chaquico argued the defendants “created the false impression amongst consumers that [he] sponsors, endorses and/or is associated in some manner with Defendants and their band.” But the U.S. magistrate dismissed Chaquico’s Lanham Act claim, with leave to amend to describe more specifically how his name and likeness was being used.

In a decision addressing the amended complaint, Magistrate James observed of the promotional materials Chaquico now included that “a photograph of what appears to be a lineup of the first Jefferson Starship iteration, including Plaintiff. . . . [does not] provide[] information about how to purchase tickets or ticket pricing; indeed, the word ‘ticket’ does not appear in either image. The second image mentions the sale of tickets: it lists a website after stating ‘Tickets Online’ and contains a notation of ‘\$40+’ in the upper left hand corner.”

The Jefferson Starship defendants claimed First Amendment protection from Chaquico’s Lanham Act allegation. But Magistrate James found enough evidence to survive the defendants’ dismissal motion. She noted nothing in the amended complaint “allows the Court to find at this point that the advertisements are anything but commercial messages. As alleged, the advertisements show nothing more than a commercial transaction promoting the current Jefferson Starship, i.e., they promote the sale of tickets for Defendants’ performances or attendance thereto.”

The magistrate concluded: “Defendants have not, at this early stage, offered any arguments that suggest the advertisements in question appeared in an expressive work.” Taken together, The Slants, The Doors, the Jefferson Starship and other cases discussed during my live presentation of this topic at the SXSW 2018 Continuing Legal Education Program offer significant practical guidance on sorting out many of the contested issues that arise over rights in band names.