

And The Band Played On

Disputes Over Musical Group Names Were a Familiar Tune in 2013

On August 28, 2013, the founder of the classic rock band BOSTON and the owner of all of its trademarks lost a bid to prevent the band's former lead singer from using the name BOSTON in connection with his ongoing musical career. This dispute over the BOSTON name is only one of several lawsuits over band names that were active in 2013, and is merely the latest in a long, rich history of such disputes.

"Well I'm Takin' My Time, I'm Just Movin' On"

Donald Scholz, who earned bachelor's and master's degrees from MIT, formed BOSTON in the early 1970s. The group's eponymous debut album was released in 1976 and ranks as one of the best-selling debut albums in US history. Fran Migliaccio, who was professionally known by the name Fran Cosmo, joined BOSTON in 1992 and was the lead vocalist on multiple BOSTON albums. He toured with the band until approximately 2002. Fran Cosmo's son, Anthony, wrote songs for BOSTON from 1999-2004, three of which were recorded on one of the group's albums. He also toured with the band in 2003 and 2004 as a backing vocalist and guitarist.

The Cosmo father and son currently perform under their own name, as well as with a group called the World Classic Rockers. Fran Cosmo promotes himself as "Fran Cosmo of BOSTON" and "BOSTON former lead singer Fran Cosmo." Because BOSTON continues to tour nationally and internationally and to release new music, and because Scholz believed that the Cosmos' use of the band's name was causing confusion, Scholz sued the father and

son in federal court in Seattle, and immediately sought a preliminary injunction to prevent their continued references to their former relationship to BOSTON. *Scholz v. Migliaccio*, Case No. C13-1229 JLR (W.D.Wash., filed July 12, 2013).

The Cosmos had "more than a feeling" that they were using the BOSTON name fairly, and the district court agreed. It denied Scholz's request for a preliminary injunction, finding that the Cosmos were likely to prevail on their defense that their use of the band's name constituted a permissible "nominative fair use." This is the same legal principle, recognized by the US Ninth Circuit Court of Appeals, that permitted a newspaper to use the name New Kids on the Block in connection with a reader poll to determine which of the members of the "boy band" was the most popular, and which allowed a former Playboy Playmate



of the Year to include references to her previous status on her Internet website. *See New Kids on the Block v. News America Publishing, Inc.* 971 F.2d 302 (9th Cir. 1992); *Playboy Enterprises, Inc. v. Welles*, 279 F.3d 796 (9th Cir. 2002). It is also the rule of law that enables motion picture studios to promote their upcoming films with phrases like "by the director of" a previously released film. *But see Miramax Films Corp. v. Columbia Pictures Entertainment, Inc.*, 996 F.Supp. 294 (S.D.N.Y.

1998) (distributor of *I Know What You Did Last Summer* was enjoined from promoting the film as “from the creators of *Scream*” because the only common link between the films was a screenwriter who wrote an original screenplay for one of the films and adapted a novel for the screenplay of the other).

The court in *Scholx* noted that under Ninth Circuit case law, a commercial user is entitled to use a trademark owner’s mark to describe the trademark owner’s own product or services, even if the user’s ultimate objective is to describe his own product or services; for example, a commercial for Pizza Hut that makes a statement about Papa John’s pizza. In order to qualify for the “nominative fair use” defense, the following requirements must be met: (1) the product or service in question must not be readily identifiable without the use of the trademark; (2) only so much of the mark may be used as is reasonably necessary to identify the product or service; and (3) the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.

The district court found that the Cosmos were likely to satisfy the nominative fair use test. Both parties agreed that the band BOSTON is not readily identifiable without the use of its name. The only evidence of use presented to the court was that Fran Cosmo truthfully identified himself as the band’s former lead vocalist; and, in fact, the evidence suggested that the Cosmos went out of their way to ensure that the Cosmos’ names appeared larger than any reference to BOSTON, and that venues could not use the band’s name other than to identify Fran Cosmo as its former lead singer.

“When I Get Angry, I Say Things I Don’t Wanna Say”

Disputes between musical groups and former members over the use of their band’s name are nothing new. Any number of factors can contribute to such disagreements. Many entertainers do not take the necessary steps to secure their ownership of trademark and related rights, which can be especially problematic when musicians perform under a collective name. Either the

band altogether lacks an agreement governing its members’ rights and obligations, or its agreement does not clearly establish what rights, if any, band members have to use the group’s name once they have left the group.

Band members also often lack an understanding of what, in the absence of an agreement, the law permits and prohibits. It is one thing, for example, for a former band member to describe herself as the group’s former lead vocalist; it is another thing for a departing band member to incorporate his old band’s name into the name of his new group. Another factor that contributes to litigation over the use of band names is rancor—lots of rancor. Just like a failed marriage or any other business partnership that has soured, band split-ups are rarely emotion-free. Finally, many disputes of this sort inexorably come down to money—and who gets to use the band’s name to make it.

In 2013 alone, more than a half dozen such lawsuits have been active and almost certainly can be attributed to one or more of the foregoing factors. A dispute among the original four members of the 1990s female R&B group En Vogue was decided by an arbitrator in January 2013. The arbitrator ruled that founding members Terri Ellis and Cindy Herron-Braggs, as the two owners of the group’s limited liability company, owned the exclusive rights to the band’s name, and that two former members,

Maxine Jones and Dawn Robinson, were “never gonna get it.” The arbitrator’s ruling was confirmed by a federal

court in March 2013. *Braggs v. Jones*, Case No. 12-CV-08493 JGB (C.D.Cal. March 21, 2013).

The rock band LIVE achieved worldwide success with its 1994 album, *Throwing Copper*. LIVE’s original lead singer, Ed Kowalczyk, left the band in November 2009. When Kowalczyk began advertising and promoting his solo performances under the name “Ed Kowalczyk of LIVE,” the band’s corporation filed suit, alleging trademark infringement, trademark dilution and other claims. *Action Front Unlimited, Inc. v. Kowalczyk*, Case No. 12-CV-05483 JMF (S.D.N.Y., filed July 17, 2012). In response, Kowalczyk countersued the corporation and the individual band members for alleged breaches of fiduciary duty, misuse of trademarks and other claims. The parties reached a complete settlement in March 2013.

The 1980s hard rock band Great White split up in 2011, with its former lead vocalist, Jack Russell, continuing to perform as “Great White Featuring Jack Russell.” In 2012, Russell sued the rest of the band for continuing to perform as “Great White.” *Russell v. Kendall*, Case No. 12-CV-02477 ODW (C.D.Cal., filed



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March 22, 2012). The band, in turn, objected to Russell performing as “Great White Featuring Jack Russell.” Perhaps both sides feared being “once bitten, twice shy” by the ongoing litigation: the dispute was settled in July 2013, with a “standstill” agreement that permitted the group to continue using its original name and Russell to continue performing as “Great White Featuring Jack Russell.”

Harold Winley sang “Love Potion No. 9” and other hits with the R&B group The Clovers in the 1950s. Winley and another former bandmate, Harold Lucas, went on to perform with separate musical groups, both of which called themselves The Clovers, and Lucas’ group eventually trademarked the name in the 1980s. Lucas died in 1994, but according to Winley, with whom Lucas performed (and who had no connection to the original group) were actively interfering with Winley’s continuing efforts to identify himself as one of The Clovers in connection with his ongoing musical performances. So Winley filed a federal action for trademark infringement and tortious interference with contractual and business relations. *Green v. Mason*, Case No. 13-CV-00664 ABJ (Dist. of Col., filed May 9, 2013). This lawsuit is currently pending.



Stone Temple Pilots (STP) was one of the most commercially successful grunge rock bands of the 1990s, and it continues to tour to this day. In early 2013, the group dismissed its lead vocalist, Scott Weiland, leading to a flurry of litigation. (It seems that former lead vocalists often get embroiled in such disputes, perhaps because many fans tend to identify bands by their lead singers.) In May 2013, three of the group’s members filed a lawsuit to prevent Weiland not only from calling himself a former member of STP, but also from performing any of STP’s songs, even though he co-wrote them. *Stone Temple Pilots v. Weiland*, Case No. BC 510040 (Los Angeles Superior Court, filed May 24, 2013). Weiland responded with counterclaims of his own, accusing his former band mates of wrongfully attempting to expel him in violation of the group’s agreement, for misleading the public by referring to their performances with another lead singer as STP, and to dissolve the band. This lawsuit is also currently pending.

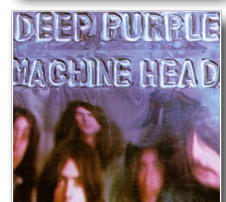
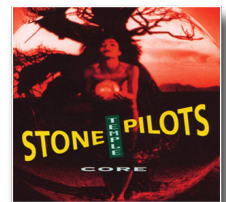
Finally, in July 2013, two of the four sisters who created the 1970s R&B/soul group Sister Sledge—famous for “We Are Family” and “He’s the Greatest Dancer”—sued another sister for wrongfully using the band’s name. *Sister Sledge, LLC v. Kathy*

Sledge Lightfoot, Case No. 13-CV-01327 DGC (D.Arizona, filed July 2, 2013). Kathy Sledge is alleged to have left the group 25 years ago, but recently began booking tour dates using the name “Sister Sledge” and/or “Sister Sledge Featuring Kathy Sledge.” She is also alleged to have been falsely advertising in some instances that all four of the group’s original members would be performing and, in other instances, that she was the “only” or “real” Sister Sledge and that the remaining original members of the group were inactive or retired. This lawsuit is also still pending.

“It’s Been Such a Long Time”

Bands and their former members have been fighting over the right to use their groups’ names for longer than rock ‘n’ roll performers have been destroying hotel rooms while on tour. In fact, some of the most famous musical groups of the ‘50s, ‘60s and ‘70s have been involved in heavily-litigated disputes. The list includes:

- ♪ Rare Earth, one of the first all-white bands signed to the Motown label, and best known for the single “I Just Want To Celebrate” (*Rare Earth, Inc. v. Hoorelbeke*, 401 F. Supp. 26 (S.D.N.Y. 1975))
- ♪ Deep Purple, best known for hits like “Smoke on the Water,” “Space Truckin’” and “Highway Star” (*HEC Enterprises, Limited v. Deep Purple, Inc.*, 1980 U.S. Dist. LEXIS 17054 (C.D.Cal. 1980))
- ♪ The Kingsmen, who recorded “Louie Louie,” a staple of karaoke bars today (*Kingsmen v. K-Tel International Ltd.*, 557 F.Supp. 178 (S.D.N.Y. 1983))
- ♪ The New Edition, the R&B group that arguably launched the “boy band” craze and paved the way for successors like New Kids on the Block, Boyz II Men, Backstreet Boys and ‘N Sync (*Bell v. Streetwise Records Ltd.*, 640 F. Supp. 575 (D.Mass. 1986))
- ♪ The Drifters—this long-lived doo-wop group has more than two dozen former members, and is known for such memorable classics as “Save The Last Dance For Me,” “Under The Boardwalk,”



“On Broadway,” and “Stand By Me” (*Marshak v. Sheppard*, 666 F.Supp. 590 (S.D.N.Y. 1987))

♪ Lynyrd Skynyrd, who wrote and performed “Free Bird” and “Sweet Home Alabama” (*Grondin v. Rossington*, 690 F. Supp. 200 (S.D.N.Y. 1988))

♪ Steppenwolf, who had hits like “Born To Be Wild” and “Magic Carpet Ride” (*Kassbaum v. Steppenwolf Productions, Inc.*, 236 F.3d 487 (9th Cir. 2000))

♪ The Beach Boys, whose infighting over the years was legendary (*Brother Records, Inc. v. Jardine*, 432 F.3d 939 (9th Cir. 2005))

♪ The Doors, who need no further description (*Densmore v. Manzarek*, 2008 WL 2209993 (Cal. App. 2008))

♪ The Platters, who had 40 singles on the Billboard Hot 100 chart between 1955 and 1967, including the number-one hits “Only You” and “The Great Pretender”—and whose name has been the subject of nearly 40 years’ worth of litigation (e.g., *The Five Platters, Inc. v. 12319 Corp.*, Superior Court of the State of California for the County of Los Angeles, No. C 43926 (1974); *Robi v. Five Platters, Inc.*, 838 F.2d 318 (9th Cir. 1988); *Robi v. Five Platters, Inc.*, 918 F.2d 1439 (9th Cir.1990); *Robi v. Reed*, 173 F.3d 736, 737 (9th Cir. 1999); and *Herb Reed Enterprises, Inc. v. Monroe Powell’s Platters, LLC*, Case 11-CV-02010-PMP (USDC D.Nev., Order dated February 1, 2012))

“So Many People Have Come and Gone”

In their day, there were only two principal ways in which past members might attempt to trade off their former affiliation with a popular band: Recording albums via a music label and performing live at venues of varying size. Given the number of available means by which groups can commercialize their music today, current groups would be wise to make every effort to anticipate such disputes. Some of the steps that should

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be considered, include: (1) forming a business entity, whether a partnership, corporation, or limited liability company, to own the group’s name and, if appropriate, other intellectual property; (2) executing an agreement among the band members (or between each member and the group’s business entity) that makes clear either that a band member gives up all rights to the name when he or she leaves the band, regardless of the circumstances, or otherwise spells out what rights a departing member has, and under what specific conditions; (3) clearing and registering the band’s name for federal trademark protection; and (4) registering the band name and logical variations for domain name protection.

With such protections in place, it will be much clearer who has the right to use the group’s name when the band plays on, and its former members do, too. 🌈

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