



# Bulletin

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## A Rock & Roll Star in a Cyberspace World

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In the 1960s, the American folk rock group The Byrds rose to stardom with their recordings of Bob Dylan's "Mr. Tambourine Man" and Pete Seeger's "Turn, Turn, Turn." While enjoying their success, the group's Roger McGuinn and Chris Hillman wrote "So You Want to Be a Rock & Roll Star," advising that if "you want to be a rock & roll star...then it's time to go downtown, where the agent man won't let you down..." (© 1966/1994 Songs of DreamWorks (BMI) and Sixteen Stars Music (BMI).) Before seeing "the agent man," The Byrds would have been wise to go downtown to see their trademark counsel, because, like many music groups, The Byrds would go through a number of changes in their lineup and later end up in litigation over control of the group's name. ([http://en.wikipedia.org/wiki/The\\_Byrds](http://en.wikipedia.org/wiki/The_Byrds).)

Litigation among band members and their heirs, managers, agents and others ("Related Parties") over control and ownership of a successful performing group's name is inevitable if they have failed to (1) define key issues, such as trademark ownership, "leaving members," bankruptcy and dissolution of a group, and (2) create business entities to own, manage and control trademark rights. Group members have been embroiled in infringement actions with Related Parties over such famous band names as The Drifters, Five Platters, The Kingsmen, Deep Purple and Lynyrd Skynyrd. *See, e.g., EC Enters., Ltd. v. Deep Purple, Inc.*, 213 U.S.P.Q. 991 (C.D. Cal. 1980); *Kingsmen v. K-Tel Int'l, Ltd.*, 557 F.Supp. 178, 181 (S.D.N.Y. 1983); *Marshak v. Green*, 505 F.Supp. 1054, 1056 (S.D.N.Y. 1981); *Marshak v. Sheppard*, 666 F.Supp. 590, 593 (S.D.N.Y. 1987) (Drifters); *Grondin v. Rossington*, 690 F.Supp. 200, 202 (S.D.N.Y. 1988) (Lynyrd Skynyrd); *Robi v. Reed*, 173 F.3d 736 (9th Cir. 1999) (Platters).

In a seminal case, *Robi v. Reed*, Martha Robi, the widow of one of the members of The Platters, Paul Robi, challenged defendant Herb Reed's right to use the trademark name THE PLATTERS. Reed managed the group, was one of the original singers and was the only member who continually asserted ownership and promoted the name of the group. Robi, in contrast, performed as a member of The Platters for about ten years, but was not one of its original singers. He left

the group after he was arrested and convicted of narcotics possession. After being released from prison, Robi neither started a new group nor returned to the group managed by Reed.

Rejecting Ms. Robi's claim that she had an interest in the name "The Platters," the Ninth Circuit held that "members of a group do not retain rights to use a group's name when they leave the group," noting that "there is no inalienable interest at stake that would attach to a departing member." The court further stated that "a person who remains continuously involved with the group and is in a position to control the quality of its services retains the right to use the mark, even when that person is a manager rather than a performer." Accordingly, Reed retained the right to use the mark, while Robi had nothing to assign to his widow.

Such inter-band disputes over rights have historically been common. But a recent *Wall Street Journal* article describes a new issue that modern-day musicians are now confronting: the selection and protection of a band name has become more difficult because of the ease in which any group can establish an online presence and make its music immediately available to a worldwide audience. John Jurgensen, "From ABBA to ZZ Top, All The Good Band Names Are Taken," *Wall Street Journal*, Feb. 17, 2010.

As an illustration, take two hypothetical groups called "Bad Precedent." (Yes, there is a group named Bad Precedent (or Bad Precedent-Lucidity), based in Liverpool and Manchester, England.) One group consists of five teenagers playing high school parties in Southern California. The other group is four middle-aged attorneys who in their spare time play classic rock at bars in Washington, D.C. Under historical music promotion models, unless either achieved unusual commercial success, it would be unlikely that these bands would cross paths, let alone be mistaken for each other. The Internet, however, has changed the way bands promote themselves and distribute and sell their music. As a result, bands unwittingly using the same name in separate geographic markets ("Unrelated Parties") may need to determine priority of use and entitlement to the name, where previously they might have coexisted unknowingly.

Such a recent Unrelated Parties dispute involved reality television producer Mark Burnett, former Motley Crue drummer Tommy Lee and a band named "Supernova." In its second season, the reality television show *Rock Star* set the stage for the selection of a lead singer to front a rock & roll supergroup to be named "Supernova," which group would include Lee, former Metallica bassist Jason Newsted, and former Guns N' Roses guitarist Gilby Clarke. The members of an existing rock & roll group called Supernova, operating as Supernova from Cynot3, LLC ("Cynot")—which was already performing, touring internationally and selling music on the Internet—sought a preliminary injunction to enjoin *Rock Star* from using the SUPERNOVA mark. *Supernova from Cynot3, LLC v. Mark Burnett Productions, Inc. et al.*, No. 06 CV 1334 (S.D. Cal. Sept. 12, 2006). While Cynot did not have a registered trademark, it asserted senior common-law rights in the trademark name SUPERNOVA used with a rock & roll group.

In challenging Cynot's claim that it had a valid trademark, *Rock Star* raised several arguments, addressing (1) the geographic scope of Cynot's use, (2) Cynot's ownership of common-law rights to the mark and (3) Cynot's seniority of use. As to geographic or territorial scope, the court recognized that a senior user has to demonstrate the geographic areas in which it has achieved market penetration. (*See also Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358 (2d Cir. 1959). The viability of this principle, however, is being progressively eroded as a

result of the Internet.) Cynot had conducted nationwide and Canadian tours in 1994, 1995, 1996 and 1999, with its music available on seven websites, including amazon.com, bestbuy.com, walmart.com and barnesandnoble.com. The court found that Cynot had established nationwide use of its mark in commerce and, therefore, rejected *Rock Star*'s argument that Cynot's mark had limited geographic scope.

*Rock Star*'s challenge to Cynot's asserted ownership of the mark was premised on a common problem that arises when groups change their lineup. *Rock Star* argued that Cynot lacked a proper chain of title in the mark because a former member of the group, Hayden Thais, did not formally transfer title by executing an assignment of his interest in the mark. *Rock Star* further argued that Cynot's receipt of only 66.66 percent of royalties was evidence that it did not own all rights to the mark. Although Thais presumably received the balance of Cynot royalties, based on *Robi v. Reed* and other decisions holding that departing band members forfeit all rights to a group's name, the court rejected *Rock Star*'s challenge to Cynot's ownership on the basis that Thais gave up all rights in the mark upon his departure from the group.

As to seniority, *Rock Star* attempted to seize the seniority of the mark from Cynot by using a license to leap-frog over Cynot's common-law rights. *Rock Star* claimed that it was the senior user of the mark through a license from an avant-garde jazz musician, who owned a 1992 U.S. registration for the mark SUPERNOVA MULTI-DIRECTIONAL ENSEMBLE NASAR ABADEY. Cynot successfully argued that the licensed mark could not be senior to its use of the trademark name SUPERNOVA in connection with a rock group because the licensor's use was exclusively within the avant-garde jazz genre. The court agreed that the jazz musician licensor could only grant rights in his registered mark limited to the genre within which there was prior use. Consequently, the differences between the rock and jazz music genres prevented the attempted leap-frogging.

Having found that Cynot's mark was valid and senior, the court considered likelihood of confusion. *Rock Star* contended that Cynot performed in silver space suits, portraying itself as a band from outer space, whereas *Rock Star*'s intended use of the mark would be "old school rock and roll" in connection with the *Rock Star: Supernova* television program and backing of famous rock musicians Lee, Newsted and Clark. *Rock Star* also asserted it intended to play large stadiums, not the pubs and bars where Cynot appeared. The court noted that the operative question was whether the parties' customer base overlapped. *Rock Star* did not contend there was no overlap, and the court found that it would likely derive its customers from the same pool as Cynot's. Notably, the court found that the parties were likely to use similar marketing channels, including the Internet, and that the reasonable consumer was likely to use a search engine to find "a SUPERNOVA group." Thus, the markets for the parties' music would likely converge on the Internet. The court rejected *Rock Star*'s argument that Cynot's genre was limited to "space punk" and granted Cynot's application for a preliminary injunction.

In another Unrelated Parties case where the parties' music was in clearly different genres, the court described typical Internet music shoppers as sophisticated and concluded they would not likely be confused when searching for either party's music. *Strange Music, Inc. v. Strange Music, Inc.*, 326 F.Supp. 2d 481 (S.D.N.Y. 2004). In *Strange Music*, the parties included a composer and performer of "new music" (described by the plaintiff as music from a classical

tradition that also has roots in other genres) and a hip-hop artist, both of whom used the name “Strange Music” to promote and sell their music. The court was not persuaded by the plaintiff’s argument that customer confusion was likely merely because the parties were both in the same industry. Rather, the court stated that, while an online search would direct a potential customer to the parties’ respective websites, hip-hop and new music fans could readily distinguish between the parties and their music. Customers interested in new music who arrived at a hip-hop artist’s website could in a matter of seconds return to their search results and resume their search.

From the various cases, we have gleaned some practical advice and guidance for bands on minimizing the risk of infringement disputes:

1. Select an inherently distinctive name that constitutes a “strong” arbitrary or fanciful mark. Conduct frequent and thorough Internet and trademark searches to eliminate potential conflicts, particularly within the same musical genre. Do not rely solely on “knock-out” searches of trademark office records or even outsourced “comprehensive” searches; also search specialized music databases, such as those maintained by performing rights societies. See ASCAP and BMI databases, at [www.ascap.com/ace/search.cfm?mode=search](http://www.ascap.com/ace/search.cfm?mode=search) and <http://bmi.com/search/?link=navbar>; Amazon.com’s SoundUnwound, at [www.soundunwound.com](http://www.soundunwound.com); [www.bandname.com](http://www.bandname.com); and Musicians Network, at [www.musiciansnetwork.com/network/Bands and Artists/index.html](http://www.musiciansnetwork.com/network/Bands_and_Artists/index.html). Also see social networking sites such as MySpace and Facebook, which are commonly used for promotional purposes by independent artists and music labels.
2. Enter into formal business agreements to govern the individual members’ interests in the band’s name, including how issues such as the departure of members and group dissolution will affect trademark rights.
3. Register the band’s name with the governing trademark authorities and consider registering with online and band name registries such as BandName.com.
4. Establish an online presence, including a band website and social networking site pages (e.g., on Facebook and MySpace), and set up a Twitter following. Promote the band in cyberspace and “tour” as far as geographically and economically feasible.
5. Obtain and maintain company name, band registries and trademark registrations.
6. When there is turnover in the group, monitor former members for potential uses of the band’s name and ensure that members are complying with the controlling membership documents. (Under various so-called Truth in Music state laws, it may be permissible for former members of a band to use the group’s name in a “tribute” type group, provided adequate disclosures are made to the public and there is no confusion between such tribute group and the original group. See [www.vocalgroup.org/truth.htm](http://www.vocalgroup.org/truth.htm).)
7. Continue active use and commercial exploitation of the band’s name, either directly or through license agreements, where quality control is retained by the original performers or the rights owner to avoid abandonment.

In advising band clients on trademark rights, practitioners can continue to rely on fundamental infringement principles, such as seniority of use and likelihood of confusion. They must also be mindful, however, that easy access to the Internet as a marketplace requires a heightened level of diligence to establish and protect a band's name and avoid trademark disputes.

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