

# ENTERTAINMENT AND SPORTS LAWYER

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## New Uses and New Percentages: Music Contracts, Royalties, and Distribution Models in the Digital Millennium

COREY FIELD

From the musician's point of view, a composition or recorded performance begins its life under the statutory law of copyright<sup>1</sup> and then generates income by the receipt of payment(s) or royalties determined by the common law of contract. This alchemy of turning music into money occurs within the complex and multifaceted U.S. music industry, where the separate rights in the "bundle of rights"<sup>2</sup> of copyright ownership have traditionally marched in step with separate business

functions and licensing organizations within the music industry.

In this traditional model, business and licensing entities are vertically integrated within the separate exclusive rights under copyright. For example, the §106(1) right to reproduce copies or phonorecords, the §106(2) right to prepare derivative works, and the §106(3) right to distribute copies or phonorecords all encompass retail enterprises that sell

*(continued on page 14)*

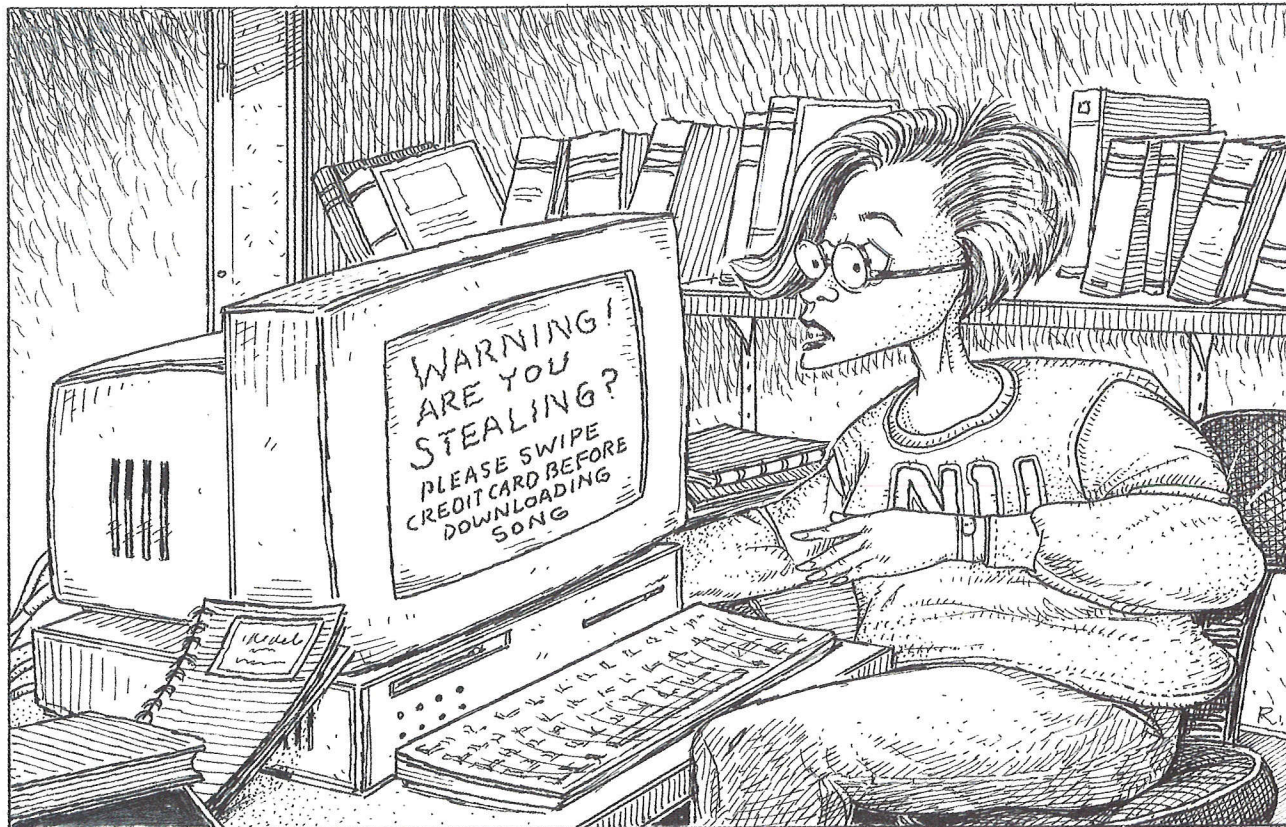


Illustration by Richard Laurent

# WHAT'S IN A NAME?

## The Use, Misuse, and Trademark Protection of Band Names

EDWIN F. MCPHERSON

What's in a name? Well, arguably, everything, if we're talking about the name of a band—particularly one that has achieved a substantial level of success. Many bands today that might have started playing together in the drummer's garage have no concept at those early stages of the potential value of the band's name. One or more of the members might have thought up a name for the band that seemed to fit; however, as with any other business venture, those members very likely did not consider what would happen to the name if the band breaks up.

In the best of circumstances, the band will have an experienced attorney who will have determined, early in their relationship, who owns the name and what happens to the name if the band breaks up or one or more of the members leave the band. Most often, an attorney will either incorporate the band (with the members as shareholders) or form a partnership composed of the members of the band. In some cases, when one member is the driving force, and particularly if that member is the sole or primary songwriter, that member may be the only "owner" and will therefore generally own the name of the band.

In any case, the best way to protect the band's name, for one or more of the individual members, a partnership, or a corporation, is to register a trademark and/or service mark of the name. This not only protects the name from similar uses by other bands, it also protects the name from being used by a member of the same band who chooses to leave. By registering the name, the owner of the trademark has an expedited means in federal court by which to stop the infringer from using it.

### Tenure Is Irrelevant

Any claim that a departing member of a group has rights to the name of that group because of the length of his or her tenure with the group has been soundly rejected by the courts. There has been no shortage of cases involving former members of bands trying to pawn off a new group using the name of the previous band. Courts are resolute that such usage constitutes

trademark infringement and dilution.

For example, in *Marshak v. Sheppard*,<sup>1</sup> a former member of The Drifters left the group and began performing as Rick Sheppard of the Drifters and Rick Sheppard and the Drifters. The court, concluding that the defendant's ongoing use of those names was an attempt to "seek and obtain profit from the use of [The Drifters] name, combined with his own," found that such use clearly and unequivocally constituted trademark infringement.<sup>2</sup> The court entered an order "enjoining defendants from continuing to perform under the name 'The Drifters' or any variant thereof."<sup>3</sup>

In *The Five Platters, Inc. v. Purdie*,<sup>4</sup> an individual named Buck Ram had created and managed a group named The Five Platters. Ram also managed the defendants' group, which was variously entitled The Flares, *formerly* The Platters; The Flares *featuring* The Platters; and The New Century Platters. The court found that each use constituted trademark infringement.<sup>5</sup> Moreover, the court held that the defendant had "a duty to choose a name which would avoid all possibility of confusion."<sup>6</sup>

In *Giammarese v. Delfino*,<sup>7</sup> a founding member of The Buckinghamhs left the group and helped create a band named the Nu-Buckinghamhs. The court in that case also held that such a use constituted trademark infringement.

In *HEC Ents., Ltd. v. Deep Purple*,<sup>8</sup> a member of the band Deep Purple left the band to create his own group, which he alternately named New Deep Purple or Deep Purple. The court in that case found both such uses to be infringements of the original band's trademark.

In *The Boogie Kings v. Guillory*,<sup>9</sup> Clinton Guillory joined The Boogie Kings as a vocalist and drummer and was the leader of the band. When he left the band, he began using the name Clint West and The Boogie Kings. The court in that case also held that such a use constituted trademark infringement.

In *CBS, Inc. v. Springboard Int'l Records*,<sup>10</sup> individuals named Edwards, Dash, and Hendryx, who were all former members of the group named Patti LaBelle & the Bluebelles, formed a group entitled LaBelle. The defendants also marketed an album enti-

tled "La Belle and The Bluebelles Early Hits". The court held that their use of the name caused confusion and once again clearly constituted trademark infringement.<sup>11</sup>

### Mechanics of Establishing Trademark Infringement

In order to establish trademark infringement, three elements must be proved: (1) ownership of the mark by the plaintiff; and (2) use of the mark by the defendants without the consent of the owner of the mark, and (3) that this use of the mark is likely to cause confusion among consumers as to the origin, sponsorship, or ownership of the mark.

Although a band or artist may have a common law trademark in its name by virtue of its prior use of that name, it is always better to register the trademark or service mark with the United States Patent and Trademark Office. In that way, the ownership of the trademark and/or service mark in the name cannot be seriously disputed. Such registration constitutes *prima facie* evidence of the validity of the trademarks, as well as of the facts stated in the relevant registration certificates.<sup>12</sup>

The more distinctive the mark, the better the protection.<sup>13</sup> An inherently distinctive mark "will be afforded the widest ambit of protection from infringing uses."<sup>14</sup> Moreover, the more extensive the use, in terms of the relative fame of the band, the duration of the use of the name, and the extent of the geographical use of the name, the better the protection.<sup>15</sup>

Although actual deception must be proved in order to recover damages under the Lanham Act, no such proof is necessary to obtain an injunction under the Act. Once a plaintiff in a trademark infringement action establishes a *prima facie* case of "likelihood of confusion," irreparable harm should be presumed *ipso facto*.<sup>16</sup>

Furthermore, where a plaintiff's and a defendant's services and/or goods are similar, and the names used by both are almost identical, no question exists that consumers are likely to be confused or deceived into believing that the plaintiff has sponsored, owns, or otherwise is associated with the defendants' services or goods.<sup>17</sup> As such, the ordinary eight-prong test for determining "likelihood of confusion" in trademark cases is inapplicable.<sup>18</sup>

### Disclaimers

Oftentimes, as demonstrated in the cases above, the new group will add or subtract language from the original name in an effort to avoid liability under the trademark laws. In some cases, the new group will add a disclaimer such as "not the original" or "the new."

Such disclaimers in general are widely recognized as ineffective to avoid a likelihood of confusion.<sup>19</sup>

The Ninth Circuit has acknowledged studies suggesting that "disclaimers have little or no effect in preventing consumer confusion," and therefore has approved their use only in cases involving "a defendant who had a substantial interest in continued use of the mark, because of past investment that had built up goodwill or because of the defendant's interest in using its own name."<sup>20</sup>

Moreover, in order for a disclaimer to be even arguably effective it: (1) must not be in small, fine print; (2) must make clear that the plaintiff in no way endorses the defendant, its products, or its services; and (3) must make clear that the defendant is not the plaintiff.<sup>21</sup> Even when such elements are present, courts are split on whether such a disclaimer is effective, depending on the *placement* of the disclaimer.<sup>22</sup>

Furthermore, the burden of showing the effectiveness of the disclaimer is on the defendant, not the plaintiff. "There would be a heavy burden . . . to come forward with evidence sufficient to demonstrate that any proposed materials [with disclaimers] would significantly reduce the likelihood of confusion."<sup>23</sup> In fact, as the court in *Marshak v. Sheppard*<sup>24</sup> describes, "the addition of a qualifying term to a trademark, rather than eliminating confusion, tends to cause confusion." This is particularly so when the disclaimer or qualifying term is added to the "hook" of the trademark. Use of another's trademark "to capture initial consumer attention, even though no actual sale is finally completed as a result of the confusion, may still be infringement."<sup>25</sup>

In *Mattel, Inc. v. MCA Records*,<sup>26</sup> a musical group sought to parody or comment on the Barbie doll in a song. The group listed a disclaimer on their CD that the song was "a social comment and was not created or approved by makers of the doll" and did not use the Barbie figures in its promotional materials.<sup>27</sup> The court held in favor of the defendants.

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In *Toho v. William Morrow and Co.*,<sup>28</sup> which involved the use of Godzilla on a book cover, the defendants printed the word "Unauthorized" on the front and, on the back, made a disclaimer: "This

book was not prepared, approved, licensed or endorsed by any entity involved in creating or producing any Godzilla movie, including Columbia/Tristar and Toho Co., Ltd.” Notwithstanding the detailed disclaimer, however, the court found trademark infringement.

In *Chrysler Corp. v. Newfield Pubs., Inc.*,<sup>29</sup> the defendant sold collectible cards with pictures of the plaintiffs’ cars. The court held that the use of the marks with multiple photographs of the plaintiffs’ trade dress “makes confusion as to sponsorship or endorsement likely. [The defendant’s] use of the plaintiffs’ trademarks in telemarketing, advertisements, and direct mailings only exacerbates the suggestion that plaintiffs sponsored or endorsed [the defendant’s] products.”<sup>30</sup>

### Fair Use

Fair use is founded upon the principles that the holder of a protectable mark has no legal claim to an exclusive right in the primary, descriptive meaning of the term, and that anyone is free to use the term in its primary, descriptive sense as long as such use does not lead to customer confusion as to the source of the goods or services. “In other words, the fair use defense applies ‘where the use of the trademark does not attempt to capitalize on consumer confusion or to appropriate the cachet of one product for a different one.’”<sup>31</sup>

Defendants in band name cases will often assert the defense of fair use in connection with trademark infringement cases involving band names. There are two types of fair use: *traditional* fair use and *nominative* fair use. The elements of each are not entirely distinct. A traditional fair use analysis is used when the defendant is allegedly using the mark to describe his own services or products or as part of his own name, often claiming that the words of the plaintiff’s mark are used in a merely *descriptive* sense. A nominative fair use test/analysis is generally used in the case of an alleged *parody* or a *comparison* of a defendant’s product with the plaintiff’s. Although the proper test in a band name case is that of *traditional* fair use, some courts confuse the two types of fair use or at least discuss the two in connection with such cases.

In any event, as discussed more fully below, “fair use” defenses are generally (and should be) rejected as a defense in band name cases. The use of a mark by a new band is almost invariably for source-identification purposes rather than because no sufficiently descriptive substitute exists. As the Central District of California has indicated, “[b]oth the traditional and nominative fair use defenses may be defeated by a showing that the mark is used as a mark, i.e., for its

source-identification function, rather than because no sufficiently descriptive substitute exists.”<sup>32</sup>

The difference between using a mark as a description as opposed to a source identifier is illustrated by the following: The defendant publishes a three-page bio for promotional purposes that indicates that the defendant performed with [Old Band] for 20 years,

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The fair use defense applies “where the user of the trademark does not attempt to capitalize on consumer confusion . . .”

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but now has created a new band called [New Band]. [Old Band] could not object to such a descriptive use of the trademark as long as the bio is not designed to mislead the public.

### Traditional Fair Use

Although courts have differed on the exact formulation for analysis of the traditional fair use analysis under §1115(b)(4) of the Lanham Act, courts generally require proof of three elements in order to establish the traditional fair use defense: “(1) its use of the registered term or device is ‘otherwise than as a [trade or service] mark,’ (2) the term or device is used ‘fairly and in good faith’ and (3) the defendant is using the term or device ‘only to describe’ those goods or services.”<sup>33</sup>

In *The Five Platters, Inc. v. Purdie*,<sup>34</sup> the defendants were on notice of the plaintiff’s claim to the exclusive right to the name long before they formed “The New Century Platters” and The New Century Corporation. The court held that “[t]hey had a duty to choose a name which would avoid all possibility of confusion.”<sup>35</sup> Despite such compelling language, many new bands choose not to do so because it is much more profitable to them to trade upon the [Old Band] name, thus causing confusion (and selling records and tickets).

The law requires the term to be used “‘only to describe’ those goods or services.” As discussed in *Films of Distinction v. Allegro Film Prods.*,<sup>36</sup> one may use a “term in its primary, descriptive sense so long as such use does not lead to customer confusion. . . .” Defendants in band name cases often cite this case, claiming that they need to use some reference to the band name because it describes the music they perform.

A similar argument was rejected in *Hillerich & Bradsby Co. v. Christian Bros., Inc.*,<sup>37</sup> (describing

*Smith v. Chanel, Inc.*<sup>38</sup> In *Smith*, the Ninth Circuit held that a perfume maker can advertise that its product smells like that of Chanel. In *Hillerich*, the defendant placed hockey player Mark Messier's name on a hockey stick, allegedly to show that the stick was the same "shape" as the ones used by the famous hockey player. The *Hillerich* court, in granting a preliminary injunction, noted: "[The *Smith*] case did not allow a competitor to simply place Chanel's mark on its product. . . . Advertising similarity to a competitor's product does not cause confusion as to sponsorship or endorsement of goods; misappropriation of a mark causes such confusion."<sup>39</sup> Clearly, then, as the cases suggest, a new band can state that they play [Old Band's] music, or even that they are better than [Old Band], but they cannot use a name that suggests affiliation with, or endorsement by, [Old Band].

The court found that the addition of "Family and Friends" to "Beach Boys" did not reduce confusion.

In *Playboy Enterprises, Inc. v. Welles*,<sup>40</sup> *Playboy* magazine sued a former Playmate of the Year for operating a website that contained references to her being the "1981 Playmate of the Year." Welles claimed that the name was merely descriptive and thus a fair use, and that she was the one and only Playmate of the Year for 1981, a title that she had possessed for 17 years. The court specifically found that the defendant had "not attempted to trick consumers into believing that they are viewing a *Playboy*-endorsed website," and that "defendant is selling Terri Welles and only Terri Welles on the website." The court held that the "defendant's use of the term *Playmate of the Year 1981* is descriptive of and used fairly and in good faith only to describe herself."<sup>41</sup>

In *Brother Records, Inc. v. Alan Jardine*,<sup>42</sup> which was recently filed in Federal Court in Los Angeles by this author, The Beach Boys sued Al Jardine, a 35-year, founding member of The Beach Boys, when Jardine formed a band called *Beach Boys Family and Friends*. Jardine, relying heavily on *Welles*, claimed that the name was merely descriptive of who he was (a Beach Boy) and what type of music his band played (Beach Boys music).

Jardine also claimed that his addition of the term "Family and Friends" sufficiently distinguished his band from the band that was (and is) touring as The Beach Boys, which was led by Mike Love, the lead

singer and co-songwriter (with Brian Wilson) of The Beach Boys since the band's inception. The court, finding that the term "Beach Boys" was the "hook," held that the addition of "Family and Friends" did not reduce the public's confusion between the two bands, and that Jardine could describe his music without using "Beach Boys" in his band's name.

In January of 2000, after months of vigorously contested proceedings, the court issued a Preliminary Injunction precluding Jardine's use of "the words 'Beach Boy' or 'Beach Boys,'" or any combination thereof, with or without additional verbiage, as part of the name, secondary name, introduction to the name, or modifier to the name, of Jardine's present or future musical groups, including but not limited to such names as 'Beach Boys Family & Friends'; 'Beach Boy Al Jardine'; 'Al Jardine, Beach Boy'; 'Beach Boy Al Jardine and Family & Friends'; 'Al Jardine, Beach Boy, and Family & Friends'; 'Family & Friends, featuring Beach Boy Al Jardine'; 'Al Jardine's Beach Boys Family & Friends'; 'Beach Boy Al Jardine presents 'Family and Friends,'; or 'Family and Friends' with Beach Boy Al Jardine' in connection with the rendering of live, public performances and/or future recorded performances, or in connection with the sale of merchandise, without the consent of Brother Records, Inc."

### Nominative Fair Use

The Ninth Circuit has set forth a three-prong test that must be satisfied in order for the nominative fair use defense to apply: (1) the product or service in question must be one not readily identifiable without use of the trademark; (2) only so much of the mark or marks 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. Every one of these three elements must be satisfied in order to prevail on the fair use defense.<sup>43</sup>

Cases in which the use of a trademark has been allowed under the fair use doctrine have involved situations such as a Volkswagen repair shop that used the name "Volkswagen" (but did not use Volkswagen's distinctive lettering) on the sign advertising its business. The Ninth Circuit noted that it "would be difficult, if not impossible . . . to avoid altogether the use of the word 'Volkswagen' or its abbreviation 'VW' . . . to signify appellant's cars." *Volkswagenwerk Aktiengesellschaft v. Church*.<sup>44</sup>

Similarly, *New Kids on the Block v. News America Publishing*<sup>45</sup> involved two newspapers that conducted polls by telephone about readers' reactions to the individual members of the musical group

*New Kids on the Block*, such as which “New Kid” was the best, sexiest, etc. Defendants’ use of the trademark to conduct the survey was allowed because the poll could not have been completed without using the name.<sup>46</sup>

In the previously mentioned *Mattel, Inc. v. MCA Records*,<sup>47</sup> where a musical group sought to parody or comment on the Barbie doll in a song, the court, in ruling that there was no infringement by the defendants based upon a finding of fair use, held that the “defendants cannot effectively parody or comment on the Barbie doll without mentioning her by name.”<sup>48</sup>

Finally, in *Liquid Glass Ents. v. Dr. Ing h.c.F. Porsche AG*,<sup>49</sup> the defendant used photographs of Porsches with Porsche emblems in its advertisements for its car cleaners and polishes and attempted to invoke the fair use analysis of *New Kids on the Block*. The court, finding infringement, stated that “[t]he reason that Liquid Glass chose to use a Porsche, instead of the vast array of other cars, and chose to clearly display the trademark PORSCHE, was not, in this court’s opinion, because it needed a mere prop, but because Liquid Glass wanted to usurp Porsche’s reputation and strength to persuade consumers that Liquid Glass produces high-quality products. Stated somewhat differently, Liquid Glass wanted to cash in on the good will that Porsche has worked hard to create and maintain by aligning itself with Porsche.”<sup>50</sup>

The second and third prongs of the nominative fair use test are tied together. The second prong of the test is whether or not the defendant used more of the mark than is reasonably necessary to identify the product or service. To whatever extent a court chooses to use a *nominative* fair use test in a band name case, a credible argument could be made that any use of the mark or any variation of [Old Band’s]



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name is more than is reasonably necessary to identify [New Band’s] “product” or “service.”

With respect to the third prong, i.e., that there be no suggestion of sponsorship or endorsement, courts consider the steps that a party takes to prevent confusion when considering fair use arguments, such as disclaimers (see discussion above).

## Trademark Licenses

In some instances, holders of trademarks in band names will license the name to one or more of the old members, particularly if the old band is not performing as such. In certain instances, [Old Band] will grant an exclusive license to one or more former band members to perform together as [Old Band]. In other instances, [Old Band] will grant nonexclusive licenses to more than one party to perform in separate bands with the same name, e.g., The Platters, who may perform in different geographical locations, or have some other way to differentiate the two bands with the same name.

At some point, as with any other license agreement, the license expires or is otherwise terminated. In that event, the same rules apply that would have applied if the license did not exist in the first place. “If the owner of the trademark has broken off business relations with a licensee . . . [the licensee’s] continued use of the trademark is therefore a violation of trademark law.”<sup>51</sup> Once the license expires, there is no right on the part of the licensee to use the trademark even if the licensee’s use of the trademark has acquired a secondary meaning.<sup>52</sup>

## Conclusion

As the court in *Brother Records, Inc. v. Jardine* indicated, “[i]t seems to be virtually unanimous that a former band member has no right to use the name of the former band in the name of his own band.”<sup>53</sup> It is therefore imperative that band name ownership issues be decided among the members at the inception of a band, and that the name, no matter who owns it, is properly registered as a trademark and/or service mark. ■

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## Endnotes

1. 666 F. Supp. 590 (S.D.N.Y. 1987).
2. *Id.* at 604.
3. *Id.* at 603-04.
4. 419 F. Supp. 372 (D. Md. 1976).
5. *Id.* at 382.
6. *Id.* at 383, citing *AMP, Inc. v. Foy*, 540 F.2d 1181, 1186-87 (4th Cir. 1976).
7. 197 U.S.P.Q. (BNA) 162 (N.D. Ill. 1977).
8. 213 U.S.P.Q. (BNA) 991 (C.D. Cal. 1980).
9. 188 So. 2d 445 (La. Ct. App. 1966).
10. 429 F. Supp. 563 (S.D.N.Y. 1976).
11. See also, *Robi v. Reed*, 173 F.3d 736 (9th Cir. 1999)

(“When Paul Robi left the group, he took no rights to the service mark with him. Rather, the mark remained with the original group.”); *Bell v. Streetwise Records, Ltd.*, 640 F. Supp. 575 (D. Ma. 1986); *Most Worshipful Sons v. Sons of Light Lodge No. 9*, 118 Cal. App. 2d 78 (1953).

12. *Dollcraft Industries, Ltd. v. Well-Made Toy Mfg. Co.*, 479 F. Supp. 1105, 1114 (E.D.N.Y. 1978); 115 U.S.C. § 1065 (trademark registration is conclusive evidence of exclusive right to use mark).

13. *See, California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451 (9th Cir. 1985).

14. *AAMF, Inc. v. Sleecraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979).

15. *Teletech Customer Care Management v. Tele-Tech Co. Inc.*, 977 F. Supp. 1407 (C.D. Cal. 1997) (plaintiff's mark famous where substantial promotion and advertising world-wide using mark); *Toys "R" Us, Inc. v. Akkaoui*, 40 U.S.P.Q.2d (BNA) 1836, 11996 U.S. Dist. LEXIS 17090 at \*3 (N.D. Cal. 1996) (plaintiff's mark is famous where there is substantial advertising through a variety of local and national channels); *Panavision Int'l, L.P. v. Toepfen*, 945 F. Supp. 1296, 1302 (C.D. Cal. 1996) (plaintiff's mark is famous where it is a major entity in an industry, there has been a long period of exclusive use, and there has been substantial promotion and advertising; *see also*, *Ocean Garden, Inc. v. Marktrade Co.*, 953 F.2d 500, 506 (9th Cir. 1991).

16. *See, Metro Pub., Ltd. v. San Jose Mercury News*, 987 F.2d 637 (9th Cir. 1993); *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 612, n.3 (9th Cir. 1989); *Wells Fargo & Co. v. Wells Fargo Constr. Co.*, 619 F. Supp. 710, 712-13 (D.C. Ariz. 1985); *Paisa, Inc. v. N&G Auto, Inc.*, 928 F. Supp. 1009, 1012-13 (C.D. Cal. 1996).

17. *See Markel v. Scovill Mfg. Co.*, 471 F. Supp. 1244, 1252 (W.D.N.Y.) (“Where the trade name of the alleged infringer is so similar to that of the claimant, and when the two companies market the same product to the same potential customers, confusion among their customers is highly likely if not inevitable.”), *aff'd*, 610 F.2d 807 (2d Cir. 1979).

18. *See, e.g., Metro Pub., Ltd.*, 987 F.2d 637; *Dep Corp. v. Opti-Ray, Inc.*, 768 F. Supp. 710, 712 (C.D. Cal. 1991); *AAMF, Inc. v. Sleecraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979).

19. *See, e.g., Home Box Office, Inc. v. Showtime/The Movie Channel, Inc.*, 832 F.2d 1311, 1316 (2d Cir. 1987); *United States Jaycees v. Philadelphia Jaycees*, 639 F.2d 134, 142 (3d Cir. 1981); *Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg.*, 510 F.2d 1004, 1013 (5th Cir.), *cert. denied*, 423 U.S. 868 (1975); *Allen v. National Video, Inc.*, 610 F. Supp. 612, 629 (S.D.N.Y. 1985).

20. *Adray v. Adry-Mart, Inc.*, 76 F.3d 984, 990-91 (9th Cir. 1996); *Conopco, Inc. v. May Dept. Stores Co.*, 784 F. Supp. 648 (D. Mo. 1992) (consumers frequently misread disclaimers).

21. *Woody Allen v. National Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985); *Twin Peaks Productions, Inc. v. Publications International, Ltd.*, 996 F.2d 1366 (2d Cir. 1993) (“an effective disclaimer is that the publication has not been prepared, approved, or licensed by any entity that created or produced the well known program ‘Twin Peaks’”).

22. *Toho Co., Ltd. v. William Morrow and Co.*, 33 F. Supp. 2d 1206 (C.D. Cal. 1998).

23. *Home Box Office, Inc. v. Showtime/The Movie Channel, Inc.*, 832 F.2d 1311 (2d Cir. 1987); *see Playboy Ents., Inc. v. Chen*, 1997 U.S. Dist. LEXIS 21916 (C.D. Cal. 1997).

24. 666 F. Supp. 590, 601 (S.D. N.Y. 1987).

25. *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999).

26. 28 F. Supp. 2d 1120 (C.D. Cal. 1998).

27. *Id.* at 1143.

28. 33 F. Supp. 2d 1206 (1998).

29. 880 F. Supp. 504 (E.D. MI 1995).

30. *Id.* at 51.

31. *Films of Distinction, Inc. v. Allegro Firm Productions, Inc.*, 12 F. Supp. 2d 1068, 1076 (C.D. Cal. 1998), *quoting* *The New Kids on the Block v. News America Publishing*, 971 F.2d 302, 308 (9th Cir. 1992).

32. *Films of Distinction, Inc. v. Allegro Firm Productions, Inc.*, 12 F. Supp. 2d 1068, 1071 (C.D. Cal. 1998).

33. *National Federation of the Blind, Inc. v. Loompanics Ents., Inc.*, 936 F. Supp. 1232 (D. Md. 1996), *citing* *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 951 (7th Cir. 1992), *cert. denied*, 507 U.S. 1042 (1993); *Hillerich & Bradsby Co. v. Christian Brothers, Inc.*, 943 F. Supp. 1136, 1140 (D. Minn. 1996); *Dayton Progress Corp. v. Lane Punch Corp.*, 917 F.2d 836, 840; *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178 (5th Cir. 1980).

34. 419 F. Supp. 372 (D. Md. 1976).

35. *Id.* at 383, *citing* *AMP, Inc. v. Foy*, 540 F.2d 1181 (4th Cir. 1976); *Allen v. Standard Crankshaft and Hydraulic Co.*, 323 F.2d 29, 36 (4th Cir. 1963).

36. 12 F. Supp. 2d 1068, 1075-76 (C.D. Cal. 1998).

37. 943 F. Supp. 1136 (D. Mn. 1996).

38. 402 F.2d 562 (9th Cir. 1968).

39. *Hillerich*, 943 F. Supp. at 1140.

40. 7 F. Supp. 2d 1098 (S.D. Cal. 1998).

41. *Id.* at 1104.

42. U.S.D.C., C.D. Cal. Case No. CV 99-03829 HLH (AJWx).

43. *New Kids on the Block*, 971 F.2d 302.

44. 411 F.2d 350, 352 (9th Cir. 1969).

45. 971 F.2d 302 (9th Cir. 1992).

46. *Id.* at 308.

47. 28 F. Supp. 2d 1120 (C.D. Cal. 1998).

48. *Id.* at 1142.

49. 8 F. Supp. 2d 398 (D. N.J. 1998).

50. *Id.*

51. *Gorenstein Enterprises, Inc. v. Quality Care-USA, Inc.*, 874 F.2d 431, 435 (7th Cir. 1989); *see Lars v. San Siro, Inc.*, 1997 U.S. Dist. LEXIS 9398 (S.D.N.Y. 1997) (“Defendant's continued use of the Mark, after termination of the License Agreement, in an unauthorized store and in connection with unauthorized products constitutes trademark infringement”); *Sherwood Ford, Inc. v. Ford Motor Co.*, 875 F. Supp. 590, 594 (E.D. Mo. 1995); *Kayser-Roth Corp. v. Fruit of the Loom, Inc.*, 1983 U.S. Dist. LEXIS 17567 (S.D.N.Y. 1983).

52. *United States Jaycees*, 639 F.2d 134.

53. Court's Jan. 3, 2000, order granting preliminary injunction.