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Cases of Note-Lanham Act and Jurisdiction

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LEGAL ISSUES



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Cases of Note — Lanham Act and Jurisdiction

“Wish they all could be California ... torts.”

Column Editor: **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>

Mike Love v. Associated Newspapers, Ltd., Brian Wilson et al, United States Court of Appeals for the Ninth Circuit, 2010 U.S. App. LEXIS 13935 (2010).

Those of us of a certain age of course know **Brian Wilson**. He was the sensitive member of the **Wilson** family who came home from community college and told his brothers: “Hey, guys, this rock ‘n roll thing’s not so hard. I’ve written a song. It’s about surfing.”

And that of course was “Surfer Girl,” the brothers became the **Beach Boys**, and the rest is rock history. Indeed, an emblematic history of the times. Including their first performance behind **Ike** and **Tina Turner** at the — wait for it — **Ritchie Valens Memorial Dance**, New Year’s Eve, 1961! And of course there had to be drugs.

Brian fried his brain and had a nervous breakdown, which he blamed on depression brought on by hearing the **Beatles’** “Sgt. Pepper” album, and feeling he wasn’t worthy to be on the same planet with them.

And it was the age of deprogramming cult victims and other weird therapy. **Wilson** fell under the power of a **Svengali**-style psychologist who isolated him in Hawaii, subjected him to “extreme counseling,” and later lost his license for it.

But of course nothing would match brother **Dennis** who in 1968 actually befriended **Charles Manson** and his harem and introduced them to **Doris Day’s** son **Terry Melcher**, the record producer famous for the **Byrds**. **Dennis** couldn’t get the **Manson** clan out of his house and finally had to move himself and hide. And a terrified **Terry** fled his home on Cielo Drive, which was in turn rented to — yes, **Roman Polanski** and **Sharon Tate**.

And you’re asking, if **Terry** had produced **Charles’** songs, would **Charles** have merely gone on to become one more rich, deranged heavy metal rocker like **Black Sabbath**, **Metallica**, **Megadeth** et al. instead of a notorious psycho-killer?

Let’s Get to Our Lawsuit

But enough pop culture. By 2004, **Brian Wilson** had himself back *compos mentis*, wrote a solo album “Smile,” and began a tour with a backup band. He had previously broken with the **Beach Boys** and all had sued each other. **Mike**

Love, founding band member, but not a **Wilson**, won the right to use **The Beach Boys** trademark in concerts and continued to tour as a nostalgia band for ... well ... those of a certain age. And, note that **Love’s** right to the mark is only in live performances.

The British newspaper the *Mail* on Sunday handed out 2.6 million CDs of **Wilson** singing old **Beach Boys** songs solo along with the new songs from “Smile.” The cover had **Brian Wilson** but also three small photos of the old band and was titled “Good Vibrations,” which rings an immediate bell with all you graying Boomers who also remember where you were when the Big Bopper’s plane went down and can name all the hits of **Jan & Dean**.

Yes, you know it. The 1966 psychedelic pop song that was produced in a layered musical collage inspiring the **Beatles’** “Strawberry Fields,” and “A Day in the Life,” and made the *Rock and Roll Hall of Fame’s* 500 Songs that Shaped Rock And Roll. Ironically, **Mike Love** wrote the lyrics, but when **Wilson** put it on “Smile,” he used the lyrics by an earlier writer. Which saved our lawsuit from being even more complicated.

BigTime.tv, the producer of the CD, ignored a California attorney’s advice to not use images of other **Beach Boys** without their permission.

I mean what the heck? They get away with it in China don’t they?

Mind you, the CD only went out with the newspaper in the UK and Ireland. While 425 copies of the paper reached the US (18 in California), none contained the CD.



Nonetheless, **Mike Love** did not care for this one bit. He saw a **Wilson** tour in direct competition with his gig. So he got busy and sued **Brian Wilson**, the newspaper, **BigTime.tv**

that produced the CD, and all manner of entities associated with **Sanctuary Records**, which produced “Smile.”

He used the **Lanham Act** trademark dilution, but loaded up the suit with California’s right of privacy and right of publicity and conspiracy, of all things.

Just like that traffic cop who feels DUI is not sufficient and also charges you with open container.

First there were some shenanigans, the significance of which will appear later if you can stand to keep reading.

Love sued in California but said he was a resident of Nevada. He later amended to say he had a residence in California, which was simply not true. Or a lie as we once called it in a more judgmental age. Which got him “admonished.” Which is to say being given a stern talking-to from the bench.

Knowing they had a problem with the CD not penetrating the U.S. market, **Love’s** lawyer got a “close associate” to claim he had bought one on **eBay** and was confused, thinking it was an official **Beach Boys** product. This was also false, and when the truth came to light, **Love’s** lawyer had sanctions slapped on him. Which is to say paying over the cost of dredging up the truth by **Wilson’s** team of legal beagles.

And after all these deceits, **Love’s** case got booted for lack of jurisdiction. Leading to the question on appeal, can **Love** use American claims for relief for conduct that happened in Britain? Or as the Ninth Circuit so wittily put it, “**Love** wishes they could all be California torts.” Chortle.

If you’re not over sixty, you probably don’t get it.

So What’s this Jurisdiction Thingy?

Jurisdiction is the authority given a court over geographic area, subject matter, and persons. What is called “long-arm jurisdiction” is provided by statute for persons outside the state and is subject to due process fairness requirements. The defendant must have some “minimum contacts” with the state. You can’t use California courts to sue someone in Michigan (or Hong Kong) for something nasty he did to you in Michigan when he has no business or anything else in California. *Yahoo! V. La Ligue Contre le Racisme*, 433 F.3d 1199, 1205 (9th Cir. 2006); Cal. Code Civ. Pro. § 410.10.

The “purposeful direction” or “effects” test requires (1) defendant did an intentional act; (2) act was aimed at the forum state; (3) and defendant knew the act was likely to cause harm to plaintiff in the forum state. *Id.* At 1206.

Love said the CD was aimed at California since that’s where his musical career is based even if he did fib about having a house there. Websites have broadened this considerably since

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they invade everywhere. See *Brayton Purcell, LLP v. Recordon & Recordon*, 606 F.3d 1124, 2010, WL 2135302 at *4 (9th Cir. 2010).

No one ever thinks about this when they set out on their little careers as bloggers.

But there was no Website in our case, and anyhow, **Love** is a citizen of Nevada.

For the *Lanham Act* to apply in Britain, the alleged violations must have an effect on American foreign commerce. See *Star-Kist Foods, Inc. v. P.J. Rhodes & Co.*, 769 F.2d 1393, 1395 (9th cir. 1985) (citing *Timberlane Lumber Co. v. Bank of Am. Nat'l Trust & Sav. Ass'n*, 549 F.2d 597 (9th Cir. 1976), superseded by statute, 15 U.S.C. §6a). It would apply if you misused someone's mark in Britain and injured the American owner monetarily. Likewise if a deceptive product was created in Britain and shipped to the U.S. so sales of the genuine product dropped. **Love** did not perform in Britain, and his trademark right was only for

live performances. **Wilson** had not performed in the U.S.

But incredibly, **Love** claimed his ticket sales dropped after the CD came out. The Ninth Circuit called associating the issue of a CD in Britain with a drop in sales of live performances "too great of a stretch." Which makes you wonder how the district court judge held onto his temper during that admonishment.

Well as it turns out, he awarded attorney's fees to the defendants with respect to all claims finding the claims "bordered on frivolous and were not objectively reasonable" and that they "contributed to the bloat" of a "vastly overpled ... case."

Yes, the spelling "pled" is now being used, but my spellchecker marks it an error. And it's supposed to know isn't it?

The *Lanham Act* allows for attorney's fees in "exceptional cases," meaning when the case is groundless, unreasonable, vexatious, or pursued in bad faith. *Stephen W. Boney, Inc. v. Boney Servs., Inc.*, 127 F.3d 821, 827 (9th Cir. 1997). **Love** "presented not one item of evidence substantiating any U.S. effect," other than a

"misleading and deceptive declaration." Plus the phony **eBay** affidavit "unreasonably and vexatiously ... lengthened or multiplied" the work of the defendants' attorneys and the court.

In a last-ditch, whining defense, **Love** said he did it all on the advice of counsel and shouldn't be punished for it. But the court said if that were a defense, attorney's fees would never be awarded.

And he sort of has a point. Maybe they should just stick the lawyer with the total bill in form of sanctions and save Love having to sue him separately.

And you avid readers have come to the conclusion that Love squandered a lot of money when he merely needed to wait with bated breath until Wilson came to California on tour. You know he couldn't have stayed away from the scene of his youthful triumph.

And in our final pop culture footnote, "Good Vibrations" went grotesquely commercial in a Sunkist orange soda commercial in the 1970s. Just like the '60s degenerating into '70s disco and polyester while the Beatles became musak. 🌿

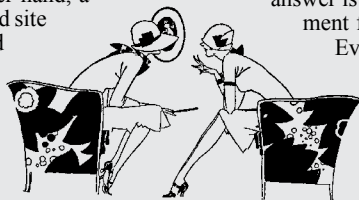
Questions & Answers — Copyright Column

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QUESTION: *A liberal arts college is being asked to put digital copies of student theses on a server. If the theses contain copyrighted images, standardized tests, etc., is permission needed? Or should access be by password only? Is there any disclaimer that the college should use if the theses are posted on the Web?*

ANSWER: Whether the theses are available on the open Web or on a password protected site makes considerable difference in this situation. In the print world, for published theses and dissertations, clearly student authors were required by the publisher to get permission to include copyrighted photographs and other materials. When the thesis or dissertation was only in the library collection, seldom did the student seek permission for incorporating copyrighted material since the thesis was not going to be published. Posting on the Web, however, is a type of publication with one difference — the college is the publisher, and a copyright holder is more likely to blame the college rather than the individual student for any infringement. Making the theses available on a password protected Website is more akin to having the printed theses available only in the library. However, students and others who have the password can access the images and can download them, so the college should make some effort to discourage downloading should be made.

While a disclaimer on the Web might make college officials feel better, it is unlikely to have any legal effect. On the other hand, a notice on a password protected site that users may not download images from the theses would be useful to alert them that downloading is not permitted and would show efforts to discourage infringement by users.



If the college decides that it does want to put theses on the Web, then student authors should be charged with responsibility for seeking permission for the use of copyrighted images.

QUESTION: *A University professor wants to use his own personal Netflix streaming account to show an entire documentary in a face to face class? Can he do this or show part of the documentary in class? The Netflix Website contains the following language:*

Unless otherwise specified, our DVD rental service and the content on the Netflix Website, including content viewed through our instant watching functionality, are for your personal and non-commercial use only and we grant you a limited license to access the Netflix Website for that purpose. You may not download (other than through page caching necessary for personal use, or as otherwise expressly permitted by these Terms of Use), modify, copy, distribute, transmit, display, perform, reproduce, duplicate, publish, license, create derivative works from, or offer for sale any information contained on, or obtained from, the Netflix Website, including but not limited to information contained within a member or members' Queue, without our express written consent.

ANSWER: According to this agreement, the answer is no. This is the license agreement for personal use with Netflix.

Even if the school owned a copy of the documentary, it would take permission from the copyright owner to stream the entire film to a class.

Under section 110(2) of

the *Copyright Act* [the TEACH Act] nonprofit educational institutions can stream reasonable and limited portions of films without permission, but only by following the stringent provisions of the *Act*. For example, only students enrolled in a particular course can view the transmission of the film, the school must take reasonable efforts to prevent downloading, etc.

To transmit (stream) the entire documentary, the institution must have permission and likely pay some permission fees. This applies whether it is truly for distance learning or is just a transmitted portion of a face-to-face course (which is what streaming is). If the professor wants to use the documentary from Netflix, he or she should contact Netflix and seek permission.

QUESTION: *In 1969, the student photography editor for the university newspaper took a photograph of a student sit-in that appeared in the student paper with "Photo by XXX" under the picture. The original photograph eventually was donated to the library by the publications department. It was not marked by the student with a copyright notice or any attribution. The photograph has been presumed to be university property and was reprinted in a book celebrating the institution's sesquicentennial a few years ago. Since then, the student has become a professional photographer and sought money from the school for reprinting the image which it thought it owned. In order to make the threat go away, the publicity department wants to promise the photographer that it or any similar photo will be marked on the back with the line "Copyright 1969 XXX XXXX Photography, contact 555-555-5555 (CLASS OF 1970)." Were student newspaper contents and photos owned by individual students or the college in 1969?*

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