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WHY CAN'T WE BE FRIENDS? IT'S WAR!

William Henslee^{*}

I. INTRODUCTION

Ownership of a band's name has been the subject of extensive litigation,¹ and no group has litigated as often as the group formerly known as WAR.² The nearly forty years of litigation³ has turned friends and business partners into feuding "frienemies."

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1. *See generally, e.g.*, *Far Out Prods., Inc. v. Oskar*, 247 F.3d 986 (9th Cir. 2001) (70s and 80s rock/funk/soul group WAR); *Robi v. Five Platters, Inc.*, 918 F.2d 1439 (9th Cir. 1990) (50s and 60s group The Platters); *Robi v. Five Platters, Inc.*, 838 F.2d 318 (9th Cir. 1988) (The Platters); *Marshak v. Treadwell*, 2009 WL 1886153 (3rd Cir. July 2, 2009) (50s and 60s group The Drifters); *Cash v. Brooks*, 1996 WL 684447 (E.D. Tenn. Apr. 24, 1996) (later 50s and early 60s group The Impressions); *Marshak v. Treadwell*, 1995 WL 428639 (E.D.N.Y. July 6, 1995) (The Drifters); *Baker v. Parris*, 777 F. Supp. 299 (S.D.N.Y. 1991) (50s era band The Five Satins); *Marshak v. Admiral Cruises*, 1991 WL 191233 (S.D.N.Y. Sept. 16, 1991) (The Drifters); *Grondin v. Rossington*, 690 F. Supp. 200 (S.D.N.Y. 1988) (70s rock band Lynyrd Skynyrd); *Marshak v. Sheppard*, 666 F. Supp. 590 (S.D.N.Y. 1987) (The Drifters); *Coasters v. Claridge Hotel*, 1986 WL 9783 (D.N.J. Apr. 4, 1986) (The Coasters); *Rick v. Buchansky*, 609 F. Supp. 1522 (S.D.N.Y. 1985) (60s group Vito and the Salutations); *Kingsmen v. K-Tel Int'l. Ltd.*, 557 F. Supp. 178 (S.D.N.Y. 1983) (The Kingsmen); *Marshak v. Green*, 505 F. Supp. 1054 (S.D.N.Y. 1981) (The Drifters); *The Five Platters, Inc. v. Purdie*, 419 F. Supp. 372 (D. Md. 1976) (The Platters); *Rare Earth, Inc. v. Hoorelbeke*, 401 F. Supp. 26 (S.D.N.Y. 1975) (Rare Earth); *Noone v. Banner Talent Assoc.'s, Inc.*, 398 F. Supp. 260 (S.D.N.Y. 1975) (Herman's Hermits); *Osbourne v. Iommi*, case 1:09-cv-04947-UA (S.D.N.Y. May 26, 2009) (Black Sabbath).

2. *See Oskar*, 247 F.3d at 990 (recounting the extensive history of litigation over the name WAR).

3. Joint Time Line at 5, *Far Out Prods., Inc. v. Oskar*, No. 96-1382-WJR (C.D. Cal. Sept. 20, 1996) (stating the first lawsuit was filed in 1972) [hereinafter Joint Time Line].



Drummer Harold Brown went to see WAR, the band he started 40 years earlier but now includes only one original member, keyboardist Lonnie Jordan. Legally barred from using the name of the band he founded with his current group—which features four of the five living original members⁵—Brown was feeling somewhat frustrated.

When an emcee introduced Jordan as “the man who wrote all the songs,” Brown yelled back. He jumped onstage, made a couple of comments, took an uninvited bow and returned to his table, where providence placed a pie. He threw the pie at Jordan.⁶

While it seems incredible that two grown men could act this way, it was a brawl that had been brewing for over ten years.⁷ Harold Brown and Lonnie Jordan are both original members of the band formerly known as WAR.⁸ Brown stated about the incident, “I didn’t want to hurt him. I love Lonnie. . . . We raised him. I asked his mom could he join the group. We got him his first keyboard. I went to his mommy’s funeral.”⁹

The band WAR was established in 1969 by Howard Scott, Harold Brown, Morris “B.B.” Dickerson, Lee Oskar, and Lonnie Jordan, and wrote and recorded classic songs such as “Low Rider,”¹⁰ “The World is a

4. From top left to right, Lee Oskar, Howard Scott, B.B. Dickerson, and Harold Brown, four of the five living members of the original WAR. <http://www.thelowriderband.com/vault/lowriderposter/march08.jpg>.

5. Four of the five original living members are pictured above.

6. Joel Selvin, *New Lowrider Name, Old Sound*, S.F. CHRON., Mar. 15, 2009, at R38.

7. *See Oskar*, 247 F.3d at 992 (stating that an injunction and judgment were issued in 1999 by a District Court, finding that Far Out Productions was the exclusive owner of the trademark “War,” and that Brown and others had infringed upon the mark).

8. Selvin, *supra* note 6.

9. *Id.*

10. WAR, *Low Rider*, on *WHY CAN’T WE BE FRIENDS?* (United Artists 1975).

Ghetto,”¹¹ “Slippin’ Into Darkness,”¹² “All Day Music,”¹³ “Me and Baby Brother,”¹⁴ “Why Can’t We Be Friends?,”¹⁵ and “The Cisco Kid.”¹⁶ In 2001, the band lost the use of its name in litigation.¹⁷ Currently, WAR performs as a cover band with only one original member, Lonnie Jordan.¹⁸ This has left the other four original members scraping by on small gigs, unable to state that they are “former members of WAR” or “original members of WAR.”¹⁹

This article will trace the origins of the original WAR through the years that led up to the pie-throwing incident. It is an unbelievable story involving greed,²⁰ betrayal, legal malpractice, and, of course, rock and soul. While there are no “good guys” in this story, the real victims are the consumers and fans. The original WAR members cannot use biographical information related to WAR in advertising,²¹ while the cover band WAR is owned and operated by the original WAR’s manager.²² Confused? So is the consumer. “Take a little trip with me”²³ to learn how the mistakes made by the original members of a band that wrote and performed some of the most iconic music of a generation affect their fans and casual consumers.²⁴

11. WAR, *The World is a Ghetto*, on *THE WORLD IS A GHETTO* (Avenue 1972).

12. WAR, *Slippin’ Into Darkness*, on *THE BEST OF WAR AND MORE* (Rhino 1991).

13. WAR, *All Day Music*, on *THE BEST OF WAR AND MORE* (Rhino 1991).

14. WAR, *Me and Baby Brother*, on *DELIVER THE WORD* (Rhino 1973).

15. WAR, *Why Can’t We Be Friends?*, on *WHY CAN’T WE BE FRIENDS?* (United Artists 1975).

16. WAR, *The Cisco Kid*, on *THE WORLD IS A GHETTO* (Avenue 1972).

17. *Far Out Prods., Inc. v. Oskar*, 247 F.3d 986, 999 (9th Cir. 2001).

18. *See Selvin*, *supra* note 6.

19. *Id.*

20. Complaint at 13, *Brown, et. al. v. Goldstein*, No. CV09-03341 (C.D. Cal. 2009) [hereinafter *Brown Complaint*] (“The Goldstein Defendants have failed to pay to Plaintiffs the millions of dollars in sound recording and musical composition royalties reported to Plaintiffs by the Goldstein Defendants.”); Reporter’s Transcript of Proceedings at 21, *Far Out Prods., Inc. v. Scott*, No. 96-1382-WDK (Mar. 16, 1999) (“Whenever we needed money, we filed suit.” (quoting Mr. Brown from his deposition)).

21. *Far Out Prods., Inc. v. Scott*, No. 96-1382-WDK (June 10, 1999).

22. *See Selvin*, *supra* note 6.

23. Lyric from *Low Rider*, written by Sylvester Allen, Harold R. Brown, Morris Dickerson, Lonnie Jordan (Leroy Jordan), Charles W. Miller, Howard Scott, Lee Oskar, pseud. of Lee Oskar Levitin, and Jerry Goldstein (manager/producer).

24. *See Andy Greene, The Battle of the B-List Bands: When Multiple Versions of the Same Groups Hit the Road, Everyone Loses*, *ROLLING STONE*, Feb. 19, 2009, at 18.

II. A BRIEF HISTORY OF THE BAND WAR²⁵A. 1969–1979: *The Period Before the Trademark Litigation*

1. All Day Music

On January 4, 1969, The Night Shift, originally comprised of Howard Scott, Harold Brown, Sylvester “Papa Dee” Allen, Charles Miller, Leroy Lonnie Jordan, and Peter Rosen, performed at The Rag Doll on Lankershim Boulevard in North Hollywood, California.²⁶ Lee Oskar, Eric Burdon,²⁷ and Jerry Goldstein²⁸ were in the audience to listen to Deacon Jones²⁹ perform.³⁰ After the show, the members of The Night Shift met at Jerry Goldstein’s house in Benedict Canyon to discuss the possibility of playing with Eric Burdon, who was leaving The Animals.³¹ Steve Gold³² and Jerry Goldstein, business partners in a poster and recording business, met with The Night Shift to discuss the possibility of the all black band playing with Eric Burdon.³³ Up to that time, there had never been a black band playing behind a white singer.³⁴

25. The following facts are derived from interviews with Steve Gold and Harold Brown, a timeline provided by Harold Brown, and various court and legal documents available online or provided by Harold Brown.

26. Joint Time Line, *supra* note 3, at 2.

27. *Id.* at 18 (“Lead singer of the British Invasion superstar group The Animals. Responsible for hit records ‘House of the Rising Sun,’ ‘We Gotta Get Out Of This Place,’ and ‘Don’t Let Me Be Misunderstood.’ Co-founder of Far Out Productions, Inc. and Far Out Music, Inc.”).

28. *Id.* at 17 (“Prior to being co-founder of Far Out Productions, Inc. and Far Out Music, Inc. was a successful songwriter, producer and artist. Wrote and produced #1 record ‘My Boyfriend’s Back’ by the Angels. Produced #1 record ‘Hang On Sloopy’ by the McCoys. Performed, wrote and produced hit records ‘I Want Candy,’ ‘Nighttime’ and ‘Cara-Lin’ by the Strangeloves.”).

29. Deacon Jones is a member of the NFL Hall of Fame. He played for the Los Angeles Rams from 1961–71, the San Diego Chargers from 1972–73, and the Washington Redskins in 1974. He invented the term quarterback “sack.” Pro Football Hall of Fame, <http://www.profootballhof.com/hof/member.aspx?PlayerId=108> (last visited July 24, 2009).

30. Joint Time Line, *supra* note 3, at 2.

31. *Id.*

32. *Id.* at 18 (“Certified Public Accountant and music industry professional. Finance executive at Uni Records (an MCA Company) prior to co-founding Far Out Productions, Inc. and Far Out Music, Inc.”).

33. *Id.* at 2.

34. *Id.* (According to Jay Coggan, “[t]he performers would be called Eric Burdon and WAR. Goldstein wanted to assemble a Black band to produce albums to play behind Burdon. This would be significant because up to that time, there had been no Black band for a white lead

According to the Joint Timeline prepared by Jay Coggan, attorney for Jerry Goldstein: "Goldstein and Burdon originate[d] the name 'WAR' for the band because during that time with the Vietnam War escalating, and everyone on the street would say 'Peace' or flash a 'Peace Sign.'"³⁵ According to Steve Gold and Bertram McCann, an associate in Gold's and Goldstein's poster business, the name was created when Gold and McCann were driving down Sunset Boulevard where they saw the John Lennon and Yoko Ono "Peace" billboard.³⁶ Gold rhetorically asked McCann, "What is the most hated word in the world right now? War!"³⁷ That's what we're going to name the group, WAR."³⁸ From that day forward, The Night Shift, with the addition of Lee Oskar, became WAR.³⁹ The only other change to the original lineup came in November 1969 when B.B. Dickerson replaced Peter Rosen as the bass player.⁴⁰

In 1970, the super-group released its first album, *Eric Burdon Declares WAR*, which made it to number eighteen on the Billboard Charts. The song "Spill the Wine"⁴¹ made it to number three.⁴² The band's second album, *Black Man's Burdon*, was released in 1971.⁴³ In November of that year, while on tour in Europe, Eric Burdon voluntarily left the band and Harold Brown, Howard Scott, Lee Oskar, Papa Dee Allen, Charles Miller,

singer.").

35. *Id.*

36. Interview with Bertram McCann (Aug. 26, 2003); *contra* Joint Time Line, *supra* note 3, at 2 (disputing this fact and alleging that Jerry Goldstein originated the name WAR).

37. Interview with Harold Brown (July 17, 2009). In 1969, the Vietnam War was at its peak; liking the contrast between WAR and peace, Gold thought the name would receive attention. *Id.*

38. Interview with Bertram McCann (Aug. 26, 2003).

39. Joint Time Line, *supra* note 3, at 2-3.

40. *Id.* at 3.

41. Allmusic, Eric Burdon Declares "WAR," <http://allmusic.com/cg/amg.dll?p=amg&sql=10:fcfqxqwjldhe> (last visited Nov. 3, 2009) (The songs on the album are: "The Vision of Rassan: Dedication/Roll on Kirk"; "Tobacco Road: Tobacco Road/I Have A Dream/Tobacco Road [medley]"; "Spill The Wine"; "Blues for Memphis Slim: Birth/Mother Earth/Mr. Charlie/Danish Pastry [medley]"; and "You're No Stranger.").

42. See Songfacts, Spill the Wine by WAR, <http://www.songfacts.com/detail.php?id=1177> (last visited Nov. 3, 2009).

43. Allmusic, The Black-Man's Burden, <http://allmusic.com/cg/amg.dll?p=amg&sql=10:dzfoxql5ldfe31> (last visited Sept. 22, 2009). The songs on the album are: "Paint It Black Medley: Black on Black in Black/Paint It Black/Laurel"; "Spirit"; "Beautiful New Born Child"; "Nights in White Satin, Pt. 1"; "The Bird & the Squirrel"; "Nuts, Seeds, and Life"; "Nights in White Satin Pt. 2"; "Sun/Moon"; "Pretty Colors"; "Gun"; "Jimbo"; "Bare Back Ride"; "Home Cookin"; "They Can't Take That Away"; and "Our Music." *Id.* See also Joint Time Line at 3, *Far Out Prods., Inc. v. Oskar*, No. 96-1382-WJR (C.D. Cal. Sept. 20, 1996).

Leroy Lonnie Jordan, and B.B. Dickerson continued to tour as WAR.⁴⁴ Steve Gold and Jerry Goldstein formed WAR Productions⁴⁵ and War Music⁴⁶ with Gold and Goldstein owning fifty-one percent of the companies and the members of WAR owning forty-nine percent.⁴⁷

While their first solo album, *WAR*,⁴⁸ sold fewer than 50,000 units and charted at number 190, their second album, *All Day Music*,⁴⁹ made it to number sixteen on the Billboard Charts and sold gold.⁵⁰ One single off the album, "Slippin' Into Darkness," made it into the top twenty.⁵¹

2. Slippin' Into Darkness

In early 1972, the long string of litigation between the band members and Gold, Goldstein, and their companies began.⁵² The parties ended that litigation by executing a Memorandum of Agreement requiring them to enter into new contracts with Far Out Productions, Inc., Far Out Music, Inc., and Far Out Management, Ltd., terminating the prior agreements between the band and WAR Productions.⁵³

44. Joint Time Line, *supra* note 3, at 3; *see* *Spill the Wine* by WAR, *supra* note 42.

45. Incorporation Certificate (Mar. 15, 1971) (on file with author); *see also* Timeline of Harold Brown (Mar. 14, 1999) (on file with author).

46. *Id.*

47. *Id.*

48. Allmusic, War, <http://allmusic.com/cg/amg.dll?p=amg&sql=10:gpfuxql5ld0e36> (last visited Sept. 22, 2009). The songs on the album are: "Sun Oh Son"; "Lonely Feelin'"; "Back Home"; "War Drums"; "Vibeka"; and "Fidel's Fantasy." *Id.*

49. Allmusic, All Day Music, <http://allmusic.com/cg/amg.dll?p=amg&sql=10:pfuxql5ld0e~T3> (last visited Sept. 22, 2009). The songs on the album are: "All Day Music"; "Get Down"; "That's What Love Will Do"; "There Must Be a Reason"; "Nappy Head"; "Slippin' into Darkness"; and "Baby Brother." *Id.*

50. RIAA, Gold & Platinum Criteria, http://www.riaa.com/goldandplatinum.php?content_selector=criteria (last visited Sept. 21, 2009) (500,000 units sold are required for an album to be certified "gold").

51. Songfacts, Slippin' Into Darkness by War, <http://www.songfacts.com/detail.php?id=7608> (last visited Nov. 3, 2009).

52. *Allen v. WAR Prods., Inc.*, LASC Case No. C 33547 (Feb. 1972). Harold Brown, Howard Scott, Lee Oskar, Sylvester "Papa Dee" Allen, Charles Miller, Leroy Lonnie Jordan, and B.B. Dickerson filed suit against WAR Productions, Inc., Far Out Productions, Far Out Music, Goldstein, and Gold for breach of contract for failure to pay royalties. *Id.*

53. *Id.*; Agreement Between Far Out Productions and Howard Scott, B.B. Dickerson, Harold Brown, Charles Miller, Lonnie Jordan, Sylvester Allan, and Lee Oskar (1972) (on file with author). Note that there are conflicting facts: Goldstein indicates that the 1972 recording agreement acknowledges the name "WAR" belongs exclusively to Far Out Productions. *Id.* Harold Brown indicates the understanding was for the producer to use the name "WAR" during the term of the agreement. *Id.* The clause in question states:

Artist acknowledges and agrees that the name "WAR" belongs exclusively to Producer for all purposes during the term of this Agreement and thereafter with respect to records made during the term hereof, and that Artist shall not, during the

In 1972, the band released *The World is a Ghetto*⁵⁴ which made it to number one on the Billboard charts.⁵⁵ In 1973, *Deliver The Word*⁵⁶ was released and made it to number six on the Billboard charts.⁵⁷ In August, the band sued Far Out Productions, Inc., Goldstein, and Gold in Los Angeles Superior Court and filed a claim with the California Labor Commission against the same defendants.⁵⁸ They settled those claims in January of 1974 and entered into a new agreement between WAR Productions, Far Out Productions, and Far Out Music, Inc.⁵⁹ *WAR Live!* was released March 6, 1974, and reached number thirteen on the Billboard charts.⁶⁰

On May 7, 1975, the band executed a Memorandum of Agreement stating that upon the expiration of the August 22, 1972 recording, songwriting, and management agreements, the band was “deemed to have consummated new contracts” under the same terms as the previous agreements, “except as otherwise specifically stated.”⁶¹ The new contracts contained improved economic terms for the seven members.⁶² In June

term of this agreement (or for a period of five years after the term with respect to merchandising rights), use or authorize the use of the above name for purposes of records and merchandising by any person, firm or corporation, or refer to Artist as a member of such group, without the express prior written authorization of Producer for purposes of records and merchandising.

Id.

54. Allmusic, The World Is a Ghetto, <http://allmusic.com/cg/amg.dll?p=amg&sql=10:gbfxyqy5ldae> (last visited Oct. 18, 2009). The songs on the album are: “The Cisco Kid”; “Where Was You At”; “City, Country, City”; “Four Cornered Room”; “The World Is a Ghetto”; and “Beetles In the Bog.” *Id.*

55. Allmusic, The World Is a Ghetto: Charts & Awards, <http://allmusic.com/cg/amg.dll?p=amg&sql=10:gbfxyqy5ldae~T3> (last visited Sept. 21, 2009).

56. Allmusic, Deliver the Word, <http://allmusic.com/cg/amg.dll?p=amg&sql=10:jpfuxql5ld0e> (last visited Oct. 18, 2009). The songs on the album are: “H2Overture”; “In Your Eyes”; “Gypsy Man”; “Me and Baby Brother”; “Deliver the Word”; “Southern Part of Texas”; and “Blisters.” *Id.*

57. Allmusic, Deliver the Word: Charts & Awards, <http://allmusic.com/cg/amg.dll?p=amg&sql=10:jpfuxql5ld0e~T3> (last visited Sept. 21, 2009).

58. See Joint Time Line, *supra* note 3, at 6 (citing LASC Case No. C64500).

59. *Id.*

60. Allmusic, WAR Live: Charts & Awards, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=10:kpfuxql5ld0e~T3> (last visited Oct. 18, 2009).

61. Joint Time Line, *supra* note 3, at 6.

62. *Id.* at 6–7 (citing LASC Case No. C64500). An additional clause was entered that stated:

Accordingly, and without limiting the provisions of the Recording Agreement and/or any other rights Productions, Music and/or Management may have in the name “War”, Musician agrees that he shall not use or authorize others to use the name War for any purpose whatsoever, without the express written consent of Management, until August 21, 1977.

1975, the band released *Why Can't We Be Friends?*⁶³ The album went to number eight on the charts.⁶⁴ "Low Rider"⁶⁵ and "Why Can't We Be Friends?" were the two hit singles from that album.⁶⁶

Blue Note Records released *Platinum Jazz*⁶⁷ in 1977, which made it to number twenty-three on the Billboard charts.⁶⁸ The album went on to become the label's first platinum record, selling over one million copies.⁶⁹ That same year, United Artists released the single "Summer"⁷⁰ and "WAR's Greatest Hits," which went on to reach number six on the Billboard Charts.⁷¹

The group contends that on March 17, 1977, Harold Brown, Howard Scott, Lee Oskar, Sylvester "Papa Dee" Allen, Charles Miller, Leroy Lonnie Jordan, and B.B. Dickerson entered into a general partnership, named WAR, under the California Uniform Partnership Act.⁷² This

Id.

63. Allmusic, Why Can't We Be Friends?, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=10:apfuxq15ld0e> (last visited Oct. 21, 2009). The songs on the album are: "Don't Let No One Get You Down"; "Lotus Blossom"; "Heartbeat"; "Leroy's Latin Lament: Lonnie Dreams/The Way We Feel/La Fiesta/Lament"; "Smile Happy"; "So"; "Low Rider"; "In Mazatlan"; and "Why Can't We Be Friends?" *Id.*

64. Allmusic, Why Can't We Be Friends?: Charts & Awards, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=10:apfuxq15ld0e~T3> (last visited Oct. 21, 2009).

65. Songfacts, Low Rider by War, <http://www.songfacts.com/detail.php?id=2694> (last visited Oct. 21, 2009).

66. Songfacts, Why Can't We Be Friends? by War, <http://www.songfacts.com/detail.php?id=7610> (last visited Oct. 21, 2009).

67. Joint Time Line, *supra* note 3, at 7; see also Allmusic, Platinum Jazz, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=10:dcfpxqq5ldke> (last visited Oct. 21, 2009). The songs on the album are: "War Is Coming! War is Coming!"; "Slowly We Walk Together"; "Platinum Jazz"; "I Got You"; "L.A. Sunshine"; "River Niger"; "H2Overture"; "City, Country, City"; "Smile Happy"; "Deliver the Word"; "Nappy Head"; and "Four Cornered Room." *Id.*; see also Rhino, War: Platinum Jazz, <http://www.rhino.com/store/ProductDetail.lasso?Number=71259> (last visited Oct. 21, 2009).

68. Allmusic, Platinum Jazz: Charts & Awards, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=10:dcfpxqq5ldke~T3> (last visited Oct. 18, 2009).

69. Rhino, War: Platinum Jazz, *supra* note 67.

70. Allmusic, War: Billboard Singles, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=11:aifixqr5ldde~T51> (last visited Sept. 20, 2009).

71. Allmusic, War: Billboard Albums, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=11:aifixqr5ldde~T50> (last visited Sept. 20, 2009).

72. Joint Time Line, *supra* note 3, at 7. The Joint Time Line indicates:

Defendants contend that Band consummated WAR general partnership under California Uniform Partnership Act comprised of co-general partners Harold Brown, Howard Scott, Lee Oskar, Sylvester "Papa Dee" Allen, Charles Miller,

partnership agreement specifically states, "The Partners have been engaged in the business of composing and recording music and related activities at Los Angeles, California, as a partnership under the tradename, WAR."⁷³

On November 7, 1977, MCA Records released WAR's next album, *Galaxy*.⁷⁴ That same year, Far Out Productions' agreement with United Artists expired.⁷⁵ The following year, the band created the soundtrack album for the movie *Youngblood*, released by United Artists.⁷⁶ The album peaked at number sixty-nine on the Billboard charts.⁷⁷

In 1979, MCA Records released *The Music Band*,⁷⁸ which peaked at number forty-one on the Billboard charts.⁷⁹ Between June and August, Goldstein and Gold presented Howard Scott, Harold Brown, Lee Oskar, Sylvester Allen, Charles Miller, and Leroy Lonnie Jordan with a series of agreements to modify their relationship.⁸⁰ Because B. B. Dickerson's

Leroy Lonnie Jordan, and Morris "B.B." Dickerson. Agreement specifically states that it is a general partnership existing and operating under the tradename WAR.

Plaintiff contends that its representatives do not recall ever having seen any document "consummating" a partnership of any kind involving the WAR band members.

Id.

73. Contract (Mar. 17, 1977) (on file with author).

74. Joint Time Line, *supra* note 3, at 8; *see also* Allmusic, *Galaxy*, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=10:fpfixql51d0e> (last visited Sept. 21, 2009). The songs on the album are: "Galaxy"; "Baby Face (She Said Do Do Do Do)"; "Sweet Fighting Lady"; "Hey Señorita"; and "The Seven Tin Soldiers." *Id.*

75. Joint Time Line, *supra* note 3, at 7.

76. *Youngblood* by WAR: Reviews and Ratings, <http://rateyourmusic.com/release/album/war/youngblood> (last visited Sept. 20, 2009); *see also* Allmusic, *Youngblood*, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=10:gpfixql51d0e> (last visited Sept. 20, 2009). The songs on the album are: "Youngblood (Livin' In the Streets)"; "Sing A Happy Song"; "Keep on Doin'"; "The Kingsmen Sign"; "Walking to War"; "This Funky Music Makes You Feel Good"; "Junk Yard"; "Superdude"; "Youngblood and Sybil"; "Flying Machine (The Chase)"; "Searching For Youngblood and Rommel"; and "Youngblood (Livin' In The Streets) (Reprise)." *Id.*

77. War: Billboard Albums, *supra* note 71.

78. *See* Allmusic, The Music Band, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=10:jpfixql51d0e> (last visited Sept. 20, 2009). The songs on the album are: "The Music Band"; "Corns and Calluses (Hey Dr. Shoals)"; "I'm The One (Who Understands)"; "Good, Good Feelin'"; "Millionaire"; and "All Around the World." *Id.*

79. War: Billboard Albums, *supra* note 71.

80. Joint Time Line, *supra* note 3, at 8 ("June–August, 1979: Four of the five remaining WAR members Allen, Brown, Jordan, and [S]cott sign new separate and individual recording and songwriter's agreements with FOP [Far Out Productions] and Far Out Music, Inc. Lee Oskar does execute new agreements. . . . Each individual's agreement sets forth their acknowledgment of the fact that the professional name WAR is the sole and exclusive property of FOP."). While each of the agreements states that the tradename is the property of FOP, there is no transfer in writing of the name; there is only acknowledgment. *See id.*

behavior was becoming a liability, Steve Gold informed the group that Far Out Productions planned to trademark the name to prevent leaving members from performing under the name WAR.⁸¹ As a result, on June 29, 1979, Far Out Productions filed an application for federal registration for the trademark/service mark “WAR” with the United States Patent and Trademark Office (PTO) under Title 15 of the United States Code, the Lanham Act of 1946.⁸² The registration stated that Far Out Productions, Inc., is the exclusive, absolute owner of the name “WAR.”⁸³

B. 1980–1987: Florida Litigation and Money Troubles

In 1979, original member Charles Miller died.⁸⁴ His untimely death, coupled with B.B. Dickerson’s departure from the group, caused the first changes in the group’s line-up since it was set in 1969.⁸⁵ Rather than replacing the original members with equity partners, the remaining members of WAR started hiring sidemen to perform on tour.⁸⁶

On September 15, 1981, the PTO issued a certification to Far Out Productions for the tradename “WAR.”⁸⁷ WAR released *Outlaw*⁸⁸ the next year, which peaked at number forty-eight on the Billboard charts.⁸⁹ On November 24, 1982, Leroy Lonnie Jordan, Howard Scott, Harold Brown, and Sylvester “Papa Dee” Allen sued Far Out Productions, Inc., Far Out Music, Inc., Far Out Management, Ltd., Jerry Goldstein, and Steve Gold in Florida state court alleging fraud and breach of contracts arising from the formulation and execution of the 1979 instruments.⁹⁰

81. Interview with Harold Brown, *supra* note 37.

82. U.S. Patent No. 1,169,651 (filed Sept. 15, 1981).

83. *Id.*

84. Joint Time Line, *supra* note 3, at 8.

85. *See id.* at 10; *see also* About.com, Profile: War, <http://oldies.about.com/od/70spopandsoul/p/war.htm> (last visited Sept. 22, 2009) (stating that the band was formed in 1969 with the seven original members: Brown, Scott, Oskar, Allen, Miller, Jordan, Dickerson).

86. *See* Joint Time Line, *supra* note 3, at 8, 10 (indicating that Ronnie Hammon joined as a second drummer, Pat Rizzo replaced Charles Miller, and Luther Rabb and Alice Tweed Smith were hired as non-royalty earning feature players).

87. U.S. Patent No. 1,169,651 (filed Sept. 15, 1981).

88. Allmusic, *Outlaw*, <http://www.allmusic.com/cg/amg.dll?p=amg&sql=10:wpfixql5ld0e> (last visited Sept. 22, 2009). The songs on the album are: “Cinco de Mayo”; “Outlaw”; “The Jungle”; “Just Because”; “Baby It’s Cold Outside”; “I’m About Somebody”; “You Got the Power”; and “Cinco de Mayo [Extended Version].” *Id.*

89. War: Billboard Albums, *supra* note 71.

90. Complaint at 4–5, *Jordan v. Far Out Music, Inc.*, No. 82-22711 (11th Cir. Nov. 24, 1982) [hereinafter *Jordan Complaint*]. The complaint sets out the following cause of action:

On October 11, 1984, the Florida court entered a partial judgment finding that Goldstein and Gold fraudulently caused the plaintiffs to transfer their intangible property rights in the tradename WAR to the corporate defendants:

[T]he Court hereby enters it [sic] judgment on the issue of liability as follows:

1. All of the material allegations of the Complaint filed herein are deemed established. More particularly, the Court declares that:

- a) The contracts herein sued upon were procured by fraud committed by the individual Defendants Steven Gold and Jerry Goldstein;
- b) The contracts herein sued upon have been materially breached;
- c) Messrs. Gold and Goldstein have been grossly negligent in the performance of their duties under the Contracts herein sued upon;

Count I—Fraud

15. For some time prior to the signing of the aforementioned contract, [1980 production agreement], Defendants [Far Out Productions] had set upon a course of conduct aimed at procuring the signature of each of the Plaintiffs to the contracts in question.

16. To achieve such ends, Defendants through their agents, servants and employees represented to Plaintiffs, among other things, that:

(a) They would faithfully, honestly and fully perform all tasks called for under the agreements as well as any other tasks that were consistent with industry practices.

(b) All accountings and payments of monies would be timely and accurately rendered.

(c) Notwithstanding language in the Exclusive Artists' Recording Agreement to the contrary, the name "WAR", was and would always be the property of Plaintiffs herein.

(d) That Plaintiffs would by virtue of their association with Defendants reap certain significant and specified financial gain within a year after signing said contracts.

(e) That if Plaintiffs failed to sign the contracts they would fail in the industry by virtue of their inability to deal with any other entity.

17. At the time the aforementioned statements were made to Plaintiffs they were false and made by Defendants with the knowledge of their falsity and were made willfully, wantonly and maliciously with the intent that Plaintiffs rely upon same to their detriment by signing the contracts in question.

18. In truth and in fact, Defendants never intended to account or to pay to Plaintiffs what they were rightfully due. Rather, Defendants intended, by using false records, spurious charges, misinformation and/or lack of information, to deprive the Plaintiffs of the fruits of their labors. Defendants through the use of minimal payments to Plaintiffs timed so as to make it appear that Defendants were "saviors" as opposed to "slavers" created a mentality of defeatism and subjugation.

d) The Court specifically declares that Messrs. Gold and Goldstein, by fraud, induced Plaintiffs to assign the name "WAR" to corporate entities owned and/or controlled by Gold and Goldstein.

2. As a direct and proximate result of the fraud, breach of contract and gross negligence of Defendants, Plaintiffs have been damaged, such damages to be assessed after hearing on same to be shortly held.

This Order is deemed to take effect in a manner not inconsistent with the Federal Bankruptcy Code.⁹¹

The Florida court severed Far Out Productions and Goldstein from the case due to federal bankruptcy cases which had previously been filed against them by the corporate debtors in June 1984 and an individual debtor in May 1984.⁹²

On January 10, 1986, the Florida court issued its final judgment against all of the defendants in the suit.⁹³ The court specifically incorporated the October 11, 1984 partial judgment in the final judgment.⁹⁴ Each of the three defendants was ordered to pay each of the three plaintiffs compensatory damages of \$1.00 because of the defendants' adamant refusal to produce documents readily available to them.⁹⁵ Punitive damages, in a disproportionate amount to the compensatory damages, were awarded.⁹⁶ Gold never appeared in the Florida trial and was never informed of the final judgment.⁹⁷ On February 17, 1987, the Florida Court of Appeal affirmed the judgment of the trial court in its entirety.⁹⁸

Soon thereafter, Far Out Productions issued new contracts, which recognized that the individual members of "Original WAR" had no dispute

91. Partial Final Judgment in Favor of Plaintiffs at 1-2, *Jordan v. Far Out Music, Inc.*, No. 82-22711 CA16 (11th Cir. Oct. 11, 1984).

92. Final Judgment at 1, *Jordan v. Far Out Music, Inc.*, No. 82-22711 CA16 (11th Cir. Jan. 10, 1986) [hereinafter *Jordan Final Judgment*].

93. *See generally id.* ("The Court readopts and reaffirms its findings contained in its Orders of October 11, 1984.")

94. *Id.* (entering judgment for compensatory and punitive damages in favor of Plaintiffs and against Defendants).

95. *Id.* at 1-2 ("The Court specifically finds that Plaintiffs suffered damages and their inability to prove the specific extent of same was occasioned by Defendants' failure to produce business records available to them.")

96. *Id.* (awarding each plaintiff compensatory damages of \$3.00 and punitive damages of \$100,000.00).

97. *See Order on Plaintiffs' Motion for Entry of Judgment, Jordan v. Far Out Music, Inc.*, No. 82-22711 CA16 (11th Cir. Oct. 11, 1984).

98. *See Far Out Music, Inc. v. Jordan*, 502 So. 2d 523 (Fla. Dist. Ct. App. 1987).

with Far Out Productions concerning ownership of the tradename "WAR."⁹⁹ On April 1, 1987, the members of WAR, who had just won their case in Florida, executed new licensing and production agreements.¹⁰⁰ These contracts recognized that Far Out Productions had rights to the tradename "WAR."¹⁰¹

C. 1988–2001: WAR Over the Name

Around 1991, WAR's entire catalogue was transferred from Far Out Productions to Avenue Records/TMC Music, which was owned and controlled by Goldstein.¹⁰² Avenue Records/TMC Music began making deals with Rhino Records and Priority Records on *Best of WAR and More*,¹⁰³ *Rap Declares War*,¹⁰⁴ and the WAR catalogue.¹⁰⁵ In July 1992, *Rap Declares War* and seven reissues of WAR's earlier albums were released on CD for the first time.¹⁰⁶ Between November 1992 and January 1993, Harold Brown, Howard Scott, and Lonnie Jordan executed exclusive recording artist agreements with Avenue Records.¹⁰⁷ In 1994, *Peace Sign*

99. Joint Time Line, *supra* note 3.

100. *Id.*

101. *Id.*; see also License Agreement (Apr. 1, 1987) ("Notwithstanding anything to the contrary herein, Artist hereby represents, warrants, and agrees that the professional name 'WAR' (Licensor's Trademark) belongs exclusively to Licensor for all purposes and Artist has no right, title or interest, vested or contingent, therein or thereto.").

102. Joint Time Line, *supra* note 3; see also United States Copyright Office Search Records, http://cocatalog.loc.gov/cgi-bin/Pwebrecon.cgi?ti=1,0&Search%5FArg=WAR&Search%5FCode=NALL&CNT=25&PID+Tn67_mml31mX7NPG2xx3Rao0egwut&SEQ=20090918112937&SID=1 (last visited Sept. 22, 2009) (showing WAR catalogue owned and controlled by Goldstein).

103. BestBuy.com, The Best of WAR . . . and More, <http://www.bestbuy.com/site/olspage.jsp?skuld=468112&st=best+of+war+and+more&lp=2&type=product&cp=1&id=103454> (last visited Sept. 18, 2009). The songs on the album are: "Livin' In The Red"; "Low Rider"; "Cisco Kid"; "Slippin' Into Darkness"; "Me & Baby Brother"; "Galaxy"; "Spill The Wine"; "All Day Music"; "Why Can't We Be Friends?"; "Summer"; "City Country City"; "Whose Cadillac Is That?" *Id.*

104. BestBuy.com, Rap Declares War, <http://www.bestbuy.com/site/olspage.jsp?skuld=1226364&st=rap+declares+war&lp=1&type=product&cp=1&id=103452> (last visited Sept. 18, 2009). The songs on the album are: "Rap Declares War"; "Funky 4 U"; "Rock Dis Funky Joint"; "New Jack Swing"; "Feels So Good"; "Potholes In My Lawn"; "Short But Funky"; "Heartbeat"; "Young Black Male"; "Don't Let No One Get You Down"; "Lowrider (On the Boulevard)"; "Ya Estuvo (That's It)"; "Slow Ride"; "Drums of Steel"; "Rhyme Fighter"; "Summatymz Ova"; "Spill The Wine"; "Join Me Please (Home Boys Make Some Noise)." *Id.*

105. Agreement between Rhino Records, Inc. and Avenue Records (Sept. 20, 1996) (on file with author).

106. Agreement between Rhino Records, Inc. and Avenue Records (July 14, 1992) (on file with author).

107. Exclusive Artist's Recording Agreement between Avenue Records and Lee Oskar,

was released on Avenue Records.¹⁰⁸ Also, on September 17, 1994, a final decree and order closing the Chapter 11 case was issued for Far Out Productions.¹⁰⁹

On February 28, 1996, Far Out Productions commenced a suit for unfair competition and trademark infringement against Howard Scott and the other band members of WAR:¹¹⁰

On March 21, 1997, Scott moved for summary judgment on the Far Out Productions' complaint on two grounds: (1) that the Florida judgment precluded the appellees from relitigating the ownership of the trademark; and (2) that the appellees' failure to disclose the Florida judgment in the incontestability affidavit rendered the affidavit false and the trademark registration invalid. The district court denied [the] motion, finding that there were triable issues of fact as to whether the Florida judgment applied to Far Out Productions and Goldstein.¹¹¹

Two years later, in 1999, almost three years after the initial filing of the suit, the district court granted Far Out Productions' motion for summary judgment.¹¹² The court issued its judgment in June and ordered a permanent injunction against Scott and the band, stating that Far Out Productions owned the WAR trademark, and holding Scott and the band as infringers of the WAR trademark.¹¹³ Scott and the band immediately filed a motion for a new trial and to amend the judgment, claiming that counsel for Far Out Productions had submitted false testimony and that there was newly discovered evidence.¹¹⁴ On August 20, 1999, the circuit court issued an order stating that the newly discovered evidence was substantially and procedurally defective, that much of the evidence had already been before the court at the summary judgment hearing, and that the evidence regarding false testimony was unconvincing.¹¹⁵

Howard Scott, and Ron Hammon (Jan. 17, 1993) (on file with author).

108. BestBuy.com, *Peace* Sign, <http://www.bestbuy.com/site/olspage.jsp?skuld=1948307&st=Peace+Sign&Ip=1&type=product&cp=1&id=103458> (last visited Sept. 18, 2009). The songs on the album are: "Peace Sign"; "East LA"; "Wild Rodriguez"; "I'm the One"; "Da Roof"; "The Smuggler"; "U.B.O.K."; "Let Me Tell You"; "Smile For Me"; "What If"; "Angel"; "Homeless Hero." *Id.*

109. *In re* Far Out Prods., Inc., No. LA-84-13393 AG (Bankr. C.D. Cal. 1994) (order closing Chapter 11 case).

110. *Far Out Prods., Inc. v. Oskar*, 247 F.3d 986, 991 (9th Cir. 2001).

111. *Id.* at 991-92.

112. *Id.*

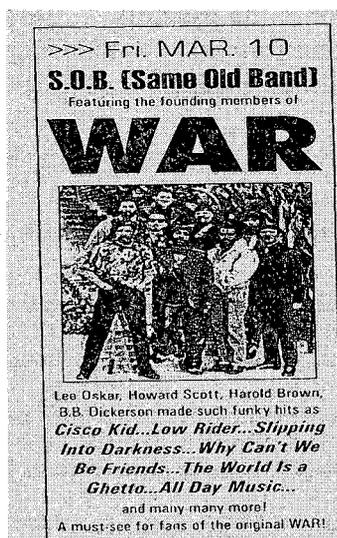
113. *Id.* at 992.

114. *Id.*

115. *Id.*

Before the Ninth Circuit decision, but after the summary judgment, the original members of WAR (without Lonnie Jordan) were touring as S.O.B. (Same Old Band).¹¹⁶ On March 10, 2000, Far Out Productions filed a complaint stating claims of infringement of a United States Registered Service Mark.¹¹⁷ The basis of the complaint was that Alligator Alley promoted S.O.B. as the original WAR.¹¹⁸ On July 13, 2001, a default motion was granted on behalf of Far Out Productions, and Harold Brown and Howard Scott were found liable for infringement of the service mark "WAR" while touring as S.O.B.¹¹⁹

By the time the Ninth Circuit reviewed the district court of California's decision, it was 2001.¹²⁰ The court began its discussion by looking to the Florida litigation.¹²¹ The court acknowledged that full faith and credit provides that federal courts must give state court judgments preclusive effect, and found the Florida law applicable.¹²² Under Florida law, collateral estoppel is applied if: (1) the parties are identical; (2) the issues are identical; and (3) the issue was fully litigated and determined resulting in a final decision.¹²³ Under the first prong, litigation must have



116. Complaint at 5, Far Out Prods., Inc. v. Alligator Alley Mgmt Corp., No. 00-6363-CIV-ZLOCH (S.D. Fla. Mar. 10, 2000).

117. *Id.* at 1.

118. *Id.* at 5.

119. Default Final Judgment Against Defendants Harold Brown & Howard Scott at 1, Far Out Prods., Inc. v. Alligator Alley Mgmt Corp., No. 00-6363-CIV-ZLOCH (S.D. Fla. 2000).

120. *Oskar*, 247 F.3d 987.

121. *Id.* at 993.

122. *Id.*

123. *Id.* (citing *Porter v. Saddlebrook Resorts, Inc.*, 679 So. 2d 1212, 1214-15 (Fla. App.

been between the same parties or their privies.¹²⁴ The court found the issues were identical, because the Florida partial final judgment found that the 1979 agreements were a result of Gold and Goldstein fraudulently inducing the band members into assigning the trademark.¹²⁵ However, the court found that the parties were not identical under Florida law, because to find privity under Florida law, “the third party ‘must have an interest in the action such that she will be bound by the final judgment as if she were a party’ or must be ‘virtually represented by one who is a party.’”¹²⁶ The court stated that nothing in the record indicates appellants were virtually represented by Gold or the Far Out entities involved in the Florida litigation.¹²⁷

The court also indicated that pursuant to federal bankruptcy laws, the Florida judgment could not bind Far Out Productions.¹²⁸ The court found that any judgment in violation of the automatic stay provision is void.¹²⁹ Although there is a narrow exception when a debtor extensively participates in a suit leading to a default judgment, the court found the record did not reflect that Goldstein or Far Out Productions participated meaningfully in the Florida litigation, filed merely to avoid judgment in the Florida court, or failed to provide notice to the plaintiffs.¹³⁰ Because the Florida litigation neither involved the same parties nor was binding due to a violation of the automatic stay, the court did not need to consider whether the judgment was final.¹³¹

In dealing with the allegation of the fraudulent incontestability affidavit, the court stated:

For the same reasons that the Florida judgment does not

1996)).

124. *Id.* (citing *Trucking Employees of North Jersey Welfare Fund, Inc. v. Romano*, 450 So. 2d 843, 845 (Fla. 1984)).

125. *Id.* at 994 (“While the court did not assign the trademark to the band members or enjoin the Far Out entities from asserting the trademark in the future, it did actually and necessarily resolve whether the Far Out entities legitimately obtained ownership in the trademark through the 1979 contracts.”).

126. *Oskar*, 247 F.3d at 994 (quoting *Stogniew v. McQueen*, 656 So. 2d 917, 920 (Fla. 1995)).

127. *Id.*

128. *Id.* (“More importantly, the Florida judgment cannot be binding on the appellees as a matter of federal bankruptcy law. When a debtor files for bankruptcy, subject to certain exceptions not present here, section 362(a) of the Bankruptcy Code automatically stays any other judicial proceeding involving the debtor.”).

129. *Id.* at 995 (citing *In re Fillion*, 181 F.3d 859, 861 (7th Cir. 1999); *In re Graves*, 33 F.3d 242, 247 (2d Cir. 1994)).

130. *Id.* at 995 (citing *In re Docteroff*, 133 F.3d 210, 215 (3d Cir. 1997)).

131. *Id.*

have a preclusive effect in this litigation, Goldstein was not required to disclose the judgment. He was not a party to the Florida suit, and the 1987 agreements with the appellants vacated the Florida judgment. His incontestability affidavit was therefore not false.

Even if the Florida judgment were a final adverse decision, Goldstein can only be adjudicated to have filed a fraudulent oath if he acted with scienter. If Goldstein had a good faith belief that the Florida judgment was irrelevant, he cannot be found to have submitted a false affidavit.¹³²

Additionally, the court found the appellants did not preclude summary judgment because they did not set forth specific facts for the alleged fraud.¹³³ The court also denied the appellants' motion for a new trial based on newly discovered evidence, ruling that the new evidence could have been found through due diligence before the trial.¹³⁴ The Ninth Circuit affirmed the district court's decision.¹³⁵

D. *Why the Ninth Circuit Was Wrong*

1. Trademark Law

Trademark law is rooted in unfair competition, which has its sources in the common law of England, and was largely codified by the Lanham Act.¹³⁶ The Lanham Act reflects the traditional common law's prohibition

132. *Oskar*, 247 F.3d at 996.

133. *Id.* at 997 (“Thus, the appellants failed to set forth specific facts or identify with reasonable particular[ity] the evidence that precluded summary judgment. The district court therefore did not err in granting the appellees’ motion for summary judgment.”).

134. *Id.* at 998. The court justified its holding as such:

On appeal, the appellants identify two pieces of “new” evidence as sufficient to justify amending the judgment or permitting a new trial. First, the appellants presented evidence to the district court that Far Out Productions was not incorporated until October 1969. . . .

The other piece of new evidence is an article, apparently not presented to the district court, describing WAR’s first commercial performance in June 1969. In the appellants’ view, the article is “documentary” proof that the group made first commercial use of the mark before Far Out Productions was incorporated, thereby vesting the members of the band, not the appellees, with ownership of the mark.

Like the appellants’ “new” evidence of Far Out Productions’ incorporation date, the article is insufficient to establish that the district court abused its discretion in denying the appellants’ motion for a new trial.

Id.

135. *Id.* at 999.

136. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003).

of uses that “convey a false impression to the public mind, and [are] of a character to mislead and deceive the ordinary purchaser in the exercise of ordinary care and caution in such matters.”¹³⁷ Trademark law is based on the proposition that a producer will reap the financial and reputational rewards associated with a desirable product and the consumer will not be misled by imitators.¹³⁸ Narrowly construed, it prevents fraudulent “passing off” of goods or services.¹³⁹ Additionally, in a cause of action:

The rights of the complainant must be based upon a wrong which the defendant has done to it by misleading customers as to the origin of the goods sold and thus taking away its trade. Such rights are not founded on a bare title to a word or symbol but on a cause of action to prevent deception.¹⁴⁰

Designed to protect consumers and producers of goods and services, the Lanham Act provides a right of priority under which the first to use a mark in commerce has the rights to that mark.¹⁴¹

The band WAR’s first commercial performance was in June of 1969,¹⁴² and Far Out Productions was not incorporated until October of 1969.¹⁴³ As a result, under the right of priority, the original members of WAR should have primary rights to the mark because they were the first to use it in commerce.¹⁴⁴

The ruling allowed Goldstein to hire whomever he wanted to play the

137. *McLean v. Fleming*, 96 U.S. 245, 255 (1878).

138. *Qualitex Co. v. Jacobson Prods., Co.*, 514 U.S. 159, 163–64 (1995) (“In principle, trademark law, by preventing others from copying a source-identifying mark, “reduce[s] the customer’s costs of shopping and making purchasing decisions,” for it quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past. At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product.”) (citations omitted).

139. *Crowell Pub. Co. v. Italian Monthly Co.*, 28 F.2d 613, 614 (S.D.N.Y. 1928).

140. *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 81 (2d Cir. 1936).

141. *Societe de Dev. et D’Innovations des Marches Agricoles et Alimentaires-Sodima-Union de Cooperatives Agricoles v. Int’l Yogurt Co.*, 662 F. Supp. 839, 853 (D. Or. 1987) (“The use in commerce required for obtaining a federal registration is generally congruous with the required use of a mark for obtaining ownership under the common law. Common law rights are acquired through priority of bona fide use under the common law in each state.”); *see* 17 U.S.C. § 1052(d).

142. *Far Out Prods., Inc. v. Oskar*, 247 F.3d 986, 990 (9th Cir. 2001).

143. *Id.* at 998.

144. *See* Reporter’s Transcript of Proceedings at 10, *Far Out Prods., Inc. v. Scott*, No. 96-1382-WDK (C.D. Cal. Mar. 16, 1999) (Keller, J.) (“McCarthy says, ‘To acquire ownership of a trademark, it is not enough to have invented the mark first, or even to have registered it first. The party’—and here is the active part—‘the party claiming ownership must have been first to actually use the mark in the sale of goods or services.’”); *see also Int’l Yogurt Co.*, 662 F. Supp. at 853.

original songs and imitate the original members on stage, all without violating the trademark ownership.¹⁴⁵ By allowing a cover band to use the name WAR, the basic tenants of the Lanham Act are violated because a false impression is made on the minds of the consuming public.¹⁴⁶ When the consuming public goes to see WAR, they are in reality seeing a tribute band. This violates the tenants of trademark law that state financial and reputational rewards should be bestowed on the original producer of the goods and services, in this case, Brown, Dickerson, Oskar, and Scott.¹⁴⁷ As a result, the premises behind trademark law are violated by Goldstein's continued use of the name.

2. Florida Fraud Litigation

The Ninth Circuit found that the Florida litigation was not appropriate for collateral estoppel because the parties were not identical, or in the alternative, because the bankruptcy proceedings should have precluded the court from reaching a finding.¹⁴⁸

Since there are disputed issues of material fact under both theories, summary judgment was inappropriate.¹⁴⁹ Initially, to indicate that Far Out Productions was not represented by other Far Out entities is without merit or common sense—Gold and Goldstein were co-founders and partners in all of the Far Out entities.¹⁵⁰ The court went on to state that the bankruptcy action should have precluded judgment in the Florida courts.¹⁵¹ In doing so, however, it blatantly disregarded any information that showed the depth of Goldstein's involvement in the Florida litigation. A finding of exclusive involvement would have permitted the application of collateral estoppel.¹⁵²

145. See *Oskar*, 247 F.3d at 999 (affirming appellee Goldstein's summary judgment grant).

146. See *McLean v. Fleming*, 96 U.S. 245, 255 (1878) (stating that where a "similarity is sufficient to convey a false impression to the public mind, and is of a character to mislead and deceive," the injured party has a cause of action).

147. See *Qualitex Co. v. Jacobson Prods., Co.*, 514 U.S. 159, 163–64 (1995) (stating trademark law assures that producers will reap the financial, reputation-related awards associated with a product).

148. See *Oskar*, 247 F.3d at 994.

149. FED. R. CIV. P. 56(c).

150. *Oskar*, 247 F.3d at 990.

151. *Id.* at 994.

152. *Id.* at 995 ("On occasion, courts have recognized a narrow equitable exception to the strict enforcement of the automatic stay provision, such as when the debtor has participated extensively in a suit leading to a default judgment before declaring bankruptcy. Although the Florida suit was initially filed in November 1982 and Goldstein and Far Out Productions did not file for bankruptcy until June 1984, the record here does not reflect that Goldstein or Far Out Productions participated in the Florida litigation in a meaningful way before declaring bankruptcy, that the appellees declared bankruptcy merely to avoid being subject to the Florida

Additionally, the Federal Rules of Bankruptcy Procedure allow a bankruptcy court to make a ruling based on a trustee's motion, after notice and a hearing, for a settlement of a claim or compromise.¹⁵³ Since the 1987 agreements are a constructive settlement of the 1986 Florida judgment,¹⁵⁴ this procedure should have been followed.¹⁵⁵ The court acknowledged the validity of the unenforceable 1987 contracts which were executed without the permission of the bankruptcy court.¹⁵⁶ The court, however, allowed Far Out to use the bankruptcy stay to preclude the Florida judgment inconsistently and selectively choose how and when to recognize the effects of Far Out Productions' and Goldstein's bankruptcy.¹⁵⁷

The original and founding members of WAR went on to form another group based on a track from one of their most famous albums, *Lowrider*.¹⁵⁸

In the interest of full disclosure and fairness to the courts, most of the theories discussed were not presented to the court by counsel for Brown, Oskar, Scott, and Dickerson. While counsel for Far Out Productions and Jerry Goldstein did not impress Judge Keller,¹⁵⁹ counsel for Brown, Oskar, Scott, and Dickerson were not up to the task of litigating complex

judgment, or that the appellees failed to notify the Florida plaintiffs of the bankruptcy applications.") (citations omitted).

153. FED. R. BANKR. P. 9019.

(a) COMPROMISE. On motion by the trustee and after notice and a hearing, the court may approve a compromise or settlement. Notice shall be given to creditors, the United States trustee, the debtor, and indenture trustees as provided in Rule 2002 and to any other entity as the court may direct.

(b) AUTHORITY TO COMPROMISE OR SETTLE CONTROVERSIES WITHIN CLASSES. After a hearing on such notice as the court may direct, the court may fix a class or classes of controversies and authorize the trustee to compromise or settle controversies within such class or classes without further hearing or notice.

(c) ARBITRATION. On stipulation of the parties to any controversy affecting the estate the court may authorize the matter to be submitted to final and binding arbitration.

Id.

154. *Far Out Music, Inc. v. Jordan*, 502 So. 2d 523 (Fla. Dist. Ct. App. 1987).

155. *See generally Oskar*, 247 F.3d at 999 (affirming appellee's summary judgment grant in spite of the automatic stay provision for bankruptcy cases).

156. *See generally id.*

157. *See* 11 U.S.C. § 362(a) (2006) (indicating which petitions qualify as automatic stays); *id.* § 541(a)(1) (stating that a bankruptcy action creates an estate that contains all legal and equitable interests of the debtor as of the commencement of the case).

158. Selvin, *supra* note 6.

159. Reporter's Transcript of Proceedings at 29–30, *Far Out Prods., Inc. v. Scott*, No. 96-1382-WDK (C.D. Cal. Mar. 16, 1999). Judge Keller said to Coggan: "This is where you cite to 50-page segments of a deposition. Figure it out, Judge. You did that repeatedly. . . . You went 100 pages a section and basically said, 'read it.' . . . I'm told your filing was incomplete and many of exhibits—71 through 81—were actually missing." *Id.*

trademark and copyright issues in federal court.¹⁶⁰

E. 2009 Litigation: False Designation and Misrepresentation of Origin

1. Complaint

On May 12, 2009, Harold Brown, Lee Oskar, Howard Scott, and B.B. Dickerson filed a complaint for violations of false advertising and false endorsement pursuant to the Lanham Act¹⁶¹ and under California unfair competition laws,¹⁶² in addition to state and common law misappropriation of likeness, declaratory relief, and accounting.¹⁶³ In the complaint Brown,

160. *Id.* at 4–5. Judge Keller said to Pepper:

Among other things, during the course of this most recent bout with Mr. Pepper . . . Messrs. Brown and Scott, through their attorneys of record at the particular time, have failed to comply with enumerable procedural rules. To include, they failed to retain local counsel or seek a waiver from the court as required by Local Rule 2.2.3.3. . . .

They failed to respond to a timely filed motion for summary judgment. They failed to comply with Local Rule 3.4.1 by using a type face smaller than 10 type characters per inch. They failed to comply with Local Rule 3.4.2 by not using pleading paper. They failed to comply with local rule 3.4.2 by using more than 28 lines per page in their opposition. They failed to comply with local rule 3.4.3 by not consecutively paginating their filings. They failed to comply with Local Rule 3.4.7 by single spacing, not double spacing the filings. Further, it appears that Messrs. Brown and Scott have not actually filed their opposition with the clerk's office.

In addition to that, Local Rule 7.14.2, which is really critical—some of these other rules can be called ticky-tack, but I'm talking really critical here.

They failed to file a statement of genuine issues of material fact by an opposing party. The rule reads: "Any party who [o]pposes the motion shall serve and file with his opposing papers a separate document containing a concise statement of genuine issues, setting forth all material facts as to which it is contended there exists a genuine issue necessary to be litigated."

Now, let me say that we had Mr. Brown, I think it was, call chambers, saying, you know, "don't penalize me for what Pepper is doing," or something to that effect. And we had Mr. Pepper saying, "well, I didn't understand pro hac vice." And the answer is—I mean, it's "elemento" [sic] pro hac vice, when you're admitted—that you're admitted to practice. For all purposes, not a limited purpose. I made that clear. It cannot be otherwise, okay? And then, you splay your hands and say, "gee, I didn't know I could try the cause."

Oh, really? I don't subscribe to that for a second.

Id.

161. 15 U.S.C. § 1125(a) (2006).

162. Cal. Bus. & Prof. Code §§ 17200, 17500 (West 2009).

163. Brown Complaint, *supra* note 20, at 1; Ex. L (The picture was used to promote "WAR" with only one remaining original member performing):

Oskar, Scott, and Dickerson allege Goldstein, by and through his Far Out entities:

unfairly trade[d] on the goodwill and reputations of Plaintiffs and their contributions as members of the Original War by, *inter alia*: (1) falsely trading on Plaintiffs' names, likenesses, reputations, and the goodwill of the Original WAR by advertising to potential concertgoers and the record buying public as if the New War is the Original War, when, in fact, it is a pale imitation of the legendary Original War; (2) falsely representing to potential concertgoers and the record buying public that Plaintiffs endorse the New War; and (3) obtaining another controversial Court ruling in California Superior Court in 2008 that the Goldstein Defendants no longer have any *contractual* obligation to pay Plaintiffs their share of the millions of dollars of royalties that the Goldstein Defendants' own royalty statements demonstrate is owed to Plaintiffs from the sales and licensing of the songs and recordings of the Original War.¹⁶⁴

The complaint further alleges that the New WAR's website violates 15 U.S.C. § 1125(a) by fraudulently misrepresenting to the public that the New WAR is the Original WAR.¹⁶⁵ Additionally, the complaint's allegations are based on the Los Angeles Superior Court's ruling in 2008, which stated that Goldstein's contractual obligations to pay royalties had expired and that the copyrights should revert back to the plaintiffs (the original song writers).¹⁶⁶



164. *Id.* at 3.

165. *Id.*

166. *Id.* at 3–4 (“In addition, Plaintiffs bring this action for a declaration that pursuant to the ruling of the Los Angeles Superior Court last year sustaining the Goldstein Defendants’ demurrer on the grounds that all contractual obligations to pay royalties to the Plaintiffs expired (the “Ruling”): (1) Plaintiffs’ grant to the Goldstein Defendants of copyrights in the sound recordings and musical compositions, which they wrote and recorded and which triggered those contractual

The complaint elaborates on the 2007 Action and the 2008 Ruling by stating that millions of dollars in royalties are owed to the Plaintiffs.¹⁶⁷ On May 16, 2007, Plaintiffs filed an action in the Los Angeles Superior Court against the Goldstein defendants alleging that the Goldstein entities owed them monies based on various agreements.¹⁶⁸ While these contracts were in force, plaintiffs delivered compositions and sound recordings.¹⁶⁹ Plaintiffs alleged that the Goldstein entities filed copyright registrations as the recipient or assignee of work-for-hire recordings.¹⁷⁰ These entities then acted as the sole and exclusive administrator of the compositions from inception.¹⁷¹

On July 1, 2008, the Goldstein defendants argued “the express terms of the [contracts] unambiguously show that the agreements have expired . . . [and that Plaintiffs could not] ignore the express [termination] of the agreement[s] . . . [and] proceed with their lawsuit.”¹⁷² The court in the 2007 Action accepted the Goldstein argument and ruled that the terms of the contract had expired.¹⁷³ Therefore, the Original WAR could not have an accounting and were not awarded royalties and were limited to only a right to “equitable accountings.”¹⁷⁴

2. Trademark 15 USC § 1125(a)

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or

royalty obligations, have also expired; and (2) upon such expiration, Plaintiffs are the owners of all such copyrighted sound recordings and musical compositions, and the Goldstein Defendants have no further right to exploit any of the compositions or musical recordings governed by the expired contracts.”)

167. *Id.* at 13–15.

168. *Id.* at 13.

169. Brown Complaint, *supra* note 20, at 13.

170. *Id.*

171. *Id.*

172. *Id.* at 14.

173. *Id.*

174. *Id.*

approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

III. AN ANALYSIS OF RELEVANT CASE LAW: DELIVER THE WORD

A. *Cash v. Brooks*, 1996 WL 684447 (E.D. Tenn.)

In order to prove an action for false designation of origin or false misleading description of fact, one must show the representation is likely to cause confusion or mistake.¹⁷⁵ In *Cash v. Brooks*, two original members of the band "The Impressions" were sued by other former members of the band under a false designation of origin claim.¹⁷⁶ Plaintiffs Fred Cash and Sam Gooden filed suit alleging a superior right to use the name "The Impressions." The plaintiffs sought to prevent the defendants from using the name and otherwise interfering with their use of the name.¹⁷⁷

During the mid-1950s, a musical group from Chattanooga, Tennessee called itself "Four Roosters and a Chick."¹⁷⁸ The members included Fred Cash, Sam Gooden, Arthur and Richard Brooks.¹⁷⁹ All members were in their teens, except Arthur Brooks who was in his twenties.¹⁸⁰ In 1957, two record companies expressed an interest in the group and the Brooks brothers and Sam Gooden moved to Chicago to pursue a musical career.¹⁸¹ Cash did not go.¹⁸² The new group renamed themselves "The Roosters," but they were unsuccessful.¹⁸³ Later in 1957, they asked Jerry Butler, who

175. 15 U.S.C. § 1125(a) (2006).

176. *Cash v. Brooks*, No. 1:95-CV-41, 1996 WL 684447, at *1 (E.D. Tenn. Apr. 24, 1996); see 15 U.S.C. § 1125(a) (2006) (outlining the requirements for a false designation of origin claim).

177. *Id.*

178. *Id.*

179. *Id.*

180. *Id.*

181. *Id.* at 2.

182. *Cash*, 1996 WL 684447, at *2.

183. *Id.*

was not a party to the suit,¹⁸⁴ and then fourteen year-old Curtis Mayfield to join the group.¹⁸⁵ The group then secured a recording contract with Veejay Records.¹⁸⁶ In 1958, the group produced a big hit entitled "For Your Precious Love."¹⁸⁷ "[The] writing credit for this song [was] given to Richard Brooks, Jerry Butler, and Arthur Brooks."¹⁸⁸ Jerry Butler sang lead vocals.¹⁸⁹

After their first hit song, the record company asked them to change their name to "The Impressions."¹⁹⁰ In late 1958 or early 1959, Jerry Butler left the group to pursue a solo career¹⁹¹ and plaintiff Fred Cash joined the group.¹⁹² No formal contract was ever developed setting out the legal structure, rights and responsibilities, financial requirements, roles, and division of income.¹⁹³ In 1961, Veejay Records terminated its contract.¹⁹⁴ Also in 1961, "The Impressions"—comprised of Curtis Mayfield, Sam Gooden, Fred Cash, and Arthur Brooks—and Richard Brooks, recorded the song "Gypsy Woman," which brought them success and public attention.¹⁹⁵ Curtis Mayfield sang lead vocals.¹⁹⁶

While no one disputes the fact that defendants Arthur and Richard Brooks left the group in 1961, the parties disagreed as to the facts surrounding the departure.¹⁹⁷ The plaintiffs claimed that the defendants left because they suspected that money was being withheld.¹⁹⁸ The plaintiffs further alleged that Arthur Brooks, the self proclaimed "leader" of the group, was dissatisfied not only with Mayfield's songs being selected, but his decreasing role in the group, and the general artistic direction of the group as well.¹⁹⁹

The defendants, however, claimed that "they did not quit the group but, rather, were not picked up by Fred Cash for a concert in

184. *Id.*

185. *Id.* at 3.

186. *Id.*

187. *Id.*

188. *Cash*, 1996 WL 684447, at *3.

189. *Id.*

190. *Id.*

191. *Id.*

192. *Id.*

193. *Id.*

194. *Cash*, 1996 WL 684447, at *4.

195. *Id.*

196. *Id.*

197. *Id.*

198. *Id.*

199. *Id.*

Indianapolis.”²⁰⁰ The court found that the defendants’ story lacked credibility because the Brooks brothers did not attempt to join the group in Indianapolis, contact their agent, or obtain their share of the money.²⁰¹ After the departure of Arthur and Richard Brooks, Mayfield, Gooden, and Cash continued to perform and record under the name “The Impressions.”²⁰² The plaintiffs enjoyed great success while performing under the name.²⁰³ They released many more hits, including “It’s All Right,” “Talking About My Baby,” “I’m So Proud,” “Keep On Pushing,” “Amen,” and “People Get Ready.”²⁰⁴ With Curtis Mayfield as lead singer and major songwriter, “The Impressions” developed a unique and successful sound.²⁰⁵ The pictures of Mayfield, Gooden, and Cash appeared on the covers of several albums that continue to be available to the public.²⁰⁶ “The Impressions” gained a reputation with the public, as well as within the music and entertainment industry, as a top musical entertainment act amassing “considerable” good will.²⁰⁷ There was no evidence that the Brooks brothers performed using the name “The Impressions” between 1963 and 1983.²⁰⁸ However, extensive records of Cash and Gooden’s performances as “The Impressions” were submitted to the court at trial.²⁰⁹

In January of 1991, the Rock and Roll Hall of Fame decided to induct “The Impressions.”²¹⁰ The Rock and Roll Hall of Fame included the members of the group when “For Your Precious Love” was recorded.²¹¹ This inducted Richard and Arthur Brooks, Sam Gooden, Jerry Butler, Curtis Mayfield, and Fred Cash into the Hall of Fame.”²¹²

After 1983, Fred Cash learned that the Brooks brothers “were going to perform at a local nightclub under the name ‘The Impressions.’”²¹³ The court found that because the Brooks brothers used the same name as the Gooden, Mayfield, and Cash

200. *Id.*

201. *Cash*, 1996 WL 684447, at *5.

202. *Id.*

203. *Id.*

204. *Id.*

205. *Id.*

206. *Id.*

207. *Cash*, 1996 WL 684447, at *6.

208. *Id.*

209. *Id.*

210. *Id.* at 7.

211. *Id.*

212. *Id.*

213. *Cash*, 1996 WL 684447, at *7.

group, and competed for the same audience, there was and continued to be confusion in the marketplace.²¹⁴ The court also found that “[p]ersons interested in securing the services of the musical group ‘The Impressions’” would be “confused as to what performers are the ‘true Impressions.’”²¹⁵ At that time, Defendants permitted and authorized promotional materials which contributed to the confusion of the consumers.²¹⁶ “This promotional material would have the natural tendency to suggest, and the natural consequence of suggesting, to people that Defendants are ‘The Impressions’ and Defendants recorded songs such as ‘Amen,’ ‘I’m So Proud,’ ‘Keep on Pushing,’ ‘People Get Ready,’ ‘Talking About My Baby,’ and ‘It’s All Right,’ thereby taking advantage of the reputation and efforts of Plaintiffs and others who recorded these songs.”²¹⁷

The Brooks Brother’s promotional material also included a one-page group history entitled “The World Famous Original Impressions.”²¹⁸ They sent the promotional history package to prospective buyers.²¹⁹ The court stated, “Nowhere in this history is any mention made of the success enjoyed by Plaintiffs and Curtis Mayfield as ‘The Impressions.’ From reading this history, one could conclude, erroneously, ‘The Impressions’

214. *Id.*

215. *Id.*

216. *Id.*

217. *Id.*

218. *Id.*

They started out in the early 50’s in a town in southeast Tennessee called Chattanooga as “The Four Roosters and a Chick.” The group then consisted of Emanuel Thompson, Catherine Thompson, Samuel Gooden, Arthur Brooks, and Richard Brooks. In later years brothers Arthur and Richard Brooks decided to advance their talent by moving to Chicago, Illinois. Samuel Gooden also came to Chicago. Richard enrolled at Washburne High School where he met Jerry Butler. As song writers Richard and Arthur also became acquainted with Curtis Mayfield. They got together, renamed the group “The Impressions,” and history was made. After the five super stars toured the world and made a lot of hits, they somehow departed on unfriendly terms which will probably never be told.

Richard and Arthur stayed together and are widely known for their song writing as they created such hits as “For Your Precious Love,” “The Gift of Love,” “Lovely One,” “I Need Your Love,” and many more.

In 1983 brothers Richard and Arthur Brooks decided to renew “The Impressions” and add a new member to blend in with their forceful voices. They signed one of their best friends, another super star, Dozie Melvin, to join the group to replace Jerry Butler’s voice sound. Richard went to lead to replace Curtis’ voice. Now they are on the roll again and much bigger than ever.

Id.

219. *Cash*, 1996 WL 684447, at *7.

did not perform until Defendants ‘decided to renew’ the group in 1983.”²²⁰

Based on the history, the court held:

Defendants have permitted and authorized interference with the musical careers of Plaintiffs by (a) attempting to pass themselves off as “The Impressions” . . . ; (b) permitting, authorizing and allowing their agents and purchasers of musical talent to pass them off as “The Impressions” by falsely indicating that Defendants are the originators, performers and recorders of songs and recordings made by Plaintiffs and Curtis Mayfield as “The Impressions” after Defendants were no longer a part of “The Impressions” . . . ; (c) permitting, authorizing, and allowing their agents and attorneys to state to talent buyers, including talent buyers utilizing the services of Plaintiffs, that Defendants are the sole individuals with rights to use the name “The Impressions” . . . ; (d) authorizing or allowing their agents to contact talent buyers who have entered into agreements with Plaintiffs in efforts to convince those talent buyers to utilize the services of Defendants instead of the services of Plaintiffs . . . ; and, (e) by performing live engagements that are inferior to those of Plaintiffs, thereby diluting the value of the name “The Impressions.”²²¹

The court also found that the defendants infringed upon the plaintiffs’ rights to the tradename “The Impressions”²²² while the tradename application on behalf of Cash and Gooden was pending in the PTO from 1984 to 1991.²²³ In 1990, the defendants filed their own application with the PTO.²²⁴ Both entered into litigation to pursue the tradename.²²⁵ “Because of the mounting expense of pursuing the [tradename] in the face of [d]efendants’ opposition, and because [p]laintiffs thought they had an agreement with [d]efendants that both would abandon seeking” rights to the tradename, the plaintiffs voluntarily withdrew their application with the PTO.²²⁶ The defendants did not withdraw their application with the PTO, but did sign the mandatory declaration.²²⁷ The plaintiffs contended that

220. *Id.*

221. *Id.* at *8.

222. *Id.* at *14.

223. *Id.* at *8.

224. *Id.*

225. *Cash*, 1996 WL 684447, at *8.

226. *Id.*

227. *Id.* at *8–9 (“[Applicant], being hereby warned that willful, false statements and the like so made are punishable by fine or imprisonment . . . and that such willful false statements

“[d]efendants made willful, false statements on their applications with respect to no one else having the right to use the name ‘The Impressions.’”²²⁸ While the court agreed the statement was obviously “false,” it did not find the falsity to be material because the PTO knew of the plaintiffs’ right to the name.²²⁹ However, the court found that the defendants were aware of the name, reputation, good will, and marketability of “The Impressions.”²³⁰ The court further stated that the agents for the defendants capitalized on the good will of “The Impressions” by falsely publicizing that the defendants “were the artists who recorded the hit songs of ‘The Impressions.’”²³¹

In order to prevail in a trademark infringement action, two elements must be proved: (1) validity of the mark, and (2) infringement.²³² Validity is determined by looking at whether the mark is used “to identify and distinguish his or her goods.”²³³ Infringement is determined by showing the likelihood of consumer confusion.²³⁴

The *Cash* court found that the trademark was inherently distinctive because it fell into the “arbitrary” mark category.²³⁵ The court stated, “The essence of a complaint under the Lanham Act is an allegation that the consuming public is being deceived as to the origin of the product, which may arise from a misleading representation that a product was produced, manufactured or authorized by a particular person.”²³⁶ The question for the court became whether a consumer would likely be confused when

may jeopardize the validity of the application or any registration resulting therefrom, declares that he is the Applicant herein; he believes himself to be the owner of the service mark sought to be registered; to the best of his knowledge and belief, no other person, firm, corporation or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when applied to the services of such other person, to cause confusion, or to cause mistake or to deceive; and the facts set forth in this application are true.”)

228. *Id.* at *9.

229. *Id.*

230. *Id.* at *10.

231. *Cash*, WL 684447, at *10.

232. *Id.* at *11; see *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768–70 (1992).

233. 15 U.S.C. § 1127 (2006); see *Two Pesos, Inc.*, 505 U.S. at 768; *Cash*, 1996 WL 684447, at *11.

234. *Two Pesos, Inc.* 505 U.S. at 769; *Cash*, 1996 WL 684447, at *11.

235. *Cash*, 1996 WL 684447, at *12 (“An arbitrary mark is one that has a recognized meaning, but that meaning is unrelated to the product or service to which the mark is attached. Courts have held the names of popular singing groups are ‘strong’ marks. ‘The name is a ‘strong’ mark in that as the name of a singing and entertainment group it is arbitrary and distinctive, bereft of any descriptive meaning.’ Since ‘The Impressions’ is an arbitrary mark, Plaintiffs do not have to show the name has acquired a secondary meaning.”) (citations omitted).

236. *Id.* at *13 (quoting *Kingsmen v. K-Tel Int’l Ltd.*, 557 F. Supp. 178, 181 (S.D.N.Y. 1983)).

viewing promotional materials for “The Impressions.”²³⁷ Because of the promotional material’s wording, “[t]he consuming public would have no way of knowing” if a promotion for “The Impressions” was for the plaintiffs or the defendants.²³⁸ As a result, the court found the defendants liable for false designation of origin and unfair competition pursuant to section 43(a) of the Lanham Act.²³⁹

B. This Case Should Be the Model for the WAR Outcome

The case between the band formerly known as WAR (Original WAR) and its former manager, Jerry Goldstein (Goldstein), has several similarities. In January 1969, the band called itself “The Night Shift” and was comprised of Harold Brown, Howard Scott, Sylvester “Papa Dee” Allen, Charles Miller, Leroy Lonnie Jordan, and Peter Rosen.²⁴⁰ Two personnel changes occurred before the band played its first show and recorded its first album.²⁴¹ While the origin of the name is disputed, the first album titled “Eric Burdon Declares WAR” was released in 1970.²⁴² The original contracts stated that the individual performers were members of the band “WAR.”²⁴³ From the group’s inception, Eric Burdon was not a member of the band WAR.²⁴⁴ During a tour in Europe, Burdon voluntarily left the band.²⁴⁵ WAR continued to perform without Burdon, indicating it was a stand-alone band.²⁴⁶ WAR Productions and WAR Music were created in 1971 with the managers owning fifty-one percent and WAR

237. *Id.* at *14.

238. *Id.*

Evidence of actual confusion was introduced in that David Johnson, manager of Memorial Auditorium and the Tivoli Theatre, and president and CEO of TAPA, a sophisticated musical buyer, was confused. Marketing channels will be substantially similar if not identical. The targeted market is the same, so similar or overlapping marketing necessarily must be used. Likely degree of purchaser care also favors Plaintiffs. Persons seeing an advertisement promoting an appearance by “The Impressions” and who desire and expect to see a performance by Plaintiffs would not undertake an investigation to determine who will actually be performing. “In general, the less care that a purchaser is likely to take in comparing products, the greater the likelihood of confusion.” By the time a consumer learned Plaintiffs were not performing, the consumer would have paid for a ticket and sat through at least some portion of an unwanted performance.

Id. (citations omitted).

239. *Id.* at *15; see 15 U.S.C. § 1125(a).

240. Joint Time Line, *supra* note 3, at 2.

241. *Id.* at 3.

242. *Id.*

243. *See id.*

244. *Id.* at 4.

245. *Id.*

246. Joint Time Line, *supra* note 3, at 4.

owning forty-nine percent.²⁴⁷ Those partnerships show that the members of the band were part owners of the name of their band.

The original WAR's unique sound and iconic body of work helped earn the band a nomination for induction into the Rock and Roll Hall of Fame (Hall of Fame) in 2008.²⁴⁸ Likely because of the problems caused by the feuding members of "The Impressions," the original WAR did not receive induction into the Hall of Fame. Although the feud probably cost the original members of the band membership in the Hall of Fame, consumers are the real losers.²⁴⁹

Currently, four of the five surviving original members of WAR perform under the name "The Lowriders."²⁵⁰ In the current litigation, Brown, Dickerson, Oskar, and Scott are suing Goldstein, who authorized Lonnie Jordan and several side musicians to perform under the tradename WAR (New WAR).²⁵¹ The two groups, the Lowriders and New WAR, are in direct competition for the same audience.²⁵² New WAR has created consumer confusion by marketing and promoting themselves as the original members of WAR, with statements like "Next year will mark the critically acclaimed band's fortieth year. . . . Jordan remarks ' . . . War is still going strong. We've never broken up,' he says. 'We now have several generations of fans and we're very proud of that.'"²⁵³ In addition, Goldstein and New WAR have used old photographs of Original WAR members to promote live performances and recordings of New WAR.²⁵⁴ As indicated in the plaintiffs' complaint, "[t]he use of old photographs

247. Incorporation Certificate (March 15, 1971) (on file with author).

248. The Rock and Roll Hall of Fame Foundation Announces Nominees for 2009 Induction (2008), <http://www.rockhall.com/pressroom/nominees-for-2009-induction/>.

249. See Greene, *supra* note 24, at 18 (offering "guide" to help consumers "sort through the madness" created "when multiple versions of the same group" are marketed).

250. See Brown Complaint, *supra* note 20, at 3.

251. *Id.* at 2.

252. *Id.* at 3, 9.

253. *Id.* at 10.



254. *Id.* at 12. This photograph of the Original WAR was used in an advertisement for the New WAR live album.

falsely and misleadingly implies that the [] New WAR is [] Original War.”²⁵⁵ Additionally, New WAR’s website contains misleading information.²⁵⁶ After giving a haphazard history of Original WAR, it states:

During the eighties, WAR began to focus on what would be the group’s true calling to this day: touring. In the beginning it was very hard, small crowds, bad venues, and low pay, but the band persevered. “It was the spirit of survival and the belief we few remaining original members had in our music that carried us forward,” reflects original member Lonnie Jordan. “There were moments when even I wanted to call it quits, but I am thankful I kept going and now live to tell the tale.”

The band’s popularity has grown steadily ever since, as a result of the commitment to being road WARriors combined with great increases [sic] television appearances, record sales, use of their music in film, television and commercials, samples and covers by other recording artists. A big shot in the arm to WAR’s presence on the touring scene was the release of 1994’s *Peace Sign*, an album well received by critics and fans. WAR now tours over 150 dates a year to audiences ranging from tens of thousands to intimate clubs.

WAR’s consistent catalogue sales and thriving tour business is a tribute to the timelessness of its music and message. Perhaps, nothing epitomizes this truth greater than the fact that WAR has twice been honored by its hometown of Los Angeles, over twenty years apart, for its music making positive contributions to the betterment of the community.²⁵⁷

As described in statements like this, New WAR has publicly disseminated information that contains false or misleading descriptions which materially mischaracterizes the quality and character of New WAR and its current membership.²⁵⁸

Based on the similarities between *Cash* and *Brown*, the District Court should find a violation under 15 U.S.C. § 1125(a) and hold: (a) New WAR is deliberately passing itself off as Original WAR; (b) New WAR has allowed its agents to pass it off as Original WAR; and (c) New WAR has

255. *Id.*

256. Brown Complaint, *supra* note 20, at 3.

257. War The Band Official Web Site—History, <http://www.wartheband.com/history.html> (last visited Nov. 2, 2009).

258. Brown Complaint, *supra* note 20, at 17.

performed live engagements inferior to those of the plaintiffs, devaluing the name "WAR."²⁵⁹

C. Lonnie Jordan Should Not Be the Only Surviving Original Member to Identify Himself as "WAR"

The original band "Kingsmen" was formed in 1962, consisting of Lynn Easton, Michael Mitchell, Norman Sundholm, Richard Peterson, and Barry Curtis.²⁶⁰ In high school, they recorded a demo entitled "Louie, Louie."²⁶¹ Jack Ely was the lead vocalist on the recording.²⁶² However, before the record became popular on the music charts, Ely left the group.²⁶³ In 1964, "Louie, Louie" became the second best-selling record in the U.S.²⁶⁴ The Kingsmen, consisting of the five plaintiffs, recorded a number of successful albums and made numerous concert tours and television appearances.²⁶⁵ Ely "did not tour with the band [and] did not perform on [its] subsequent albums."²⁶⁶ In 1967, the Kingsmen disbanded and ceased performing.²⁶⁷ Though the band's legacy continued through litigation.

In 1976, one of the defendants in *Kingsmen v. K-Tel Int'l Ltd.* communicated with Ely and made a proposal to "re-record" a song originally performed by the Kingsmen.²⁶⁸ Ely re-recorded "Louie, Louie."²⁶⁹ None of the other original Kingsmen participated in the recording sessions.²⁷⁰ Ely's most recent recording of "Louie, Louie" appeared on defendant's *60's Dance Party* album, which was released in October 1982.²⁷¹

The plaintiffs in *Kingsmen* sought to enjoin defendants from

259. See *Cash v. Brooks*, No. 1:95-CV-41, 1996 WL 684447, at *1, *8 (E.D. Tenn. Apr. 24, 1996) (holding that defendants interfered with plaintiffs' music career by attempting to "pass themselves off as 'The Impressions'").

260. *Kingsmen v. K-Tel Int'l Ltd.*, 557 F. Supp. 178, 179 (S.D.N.Y. 1983).

261. *Id.*

262. *Id.*

263. *Id.*

264. *Id.*

265. *Id.* at 180.

266. *Kingsmen*, 557 F. Supp. at 179.

267. *Id.*

268. *Id.* There was another member approached, Easton, who re-recorded *Jolly Green Giant*, the Kingsmen's second most popular song. *Id.* The contract to re-record *Jolly Green Giant* mentions "Lynn Easton, a/k/a Kingsmen," which the court stated was an effort to grant use of the Kingsmen name. *Id.*

269. *Id.*

270. *Id.*

271. *Id.*

representing that its recorded version of “Louie Louie” was the original version of “Louie Louie” recorded by the Kingsmen.²⁷² Although Ely was the original lead vocalist on the recording, plaintiffs asserted that “the use of the name Kingsmen, together with the notation that the song [was] a ‘re-recording by the original artists,’ create[d] the false impression to consumers that they [were] getting a recording of Louie, Louie as performed by those five persons associated by the consumer with the band The Kingsmen.”²⁷³

The court broadly construed 15 USC § 1125(a) and found that it protects against the use of either a “false description or a false designation of origin.”²⁷⁴ “Usage, not registration, confers the right to a trademark.”²⁷⁵ “A complaint under the Lanham Act is an allegation that the consuming public is being deceived as to the origin of the product, which may arise from a misleading representation that a product was produced, manufactured or authorized by a particular person.”²⁷⁶

The plaintiffs’ contracted with music publishing and record companies under the name the Kingsmen for royalties from the sale of their original recordings, which aided the plaintiffs’ argument that they were being hurt financially by defendant’s recording and that the defendant was deceiving the public.²⁷⁷ The court also “stress[ed] the ensemble nature of The Kingsmen’s music” and determined the band’s “sound” to be collective, thereby belonging to a group and not an individual.²⁷⁸ “No one member of the group can be singled out as representing the essence of The Kingsmen’s performing style.”²⁷⁹ The plaintiffs also licensed the original recording of “Louie, Louie” on several compilations, such as *Original Rock N’ Roll Hits of the 60’s*, which competes directly with the re-recording of *60s Dance Party* album.²⁸⁰ The court concluded by stating:

There is also little question that defendants’ [labeling] of its 60’s Dance Party album is likely to cause confusion in the mind of the public with respect to the origin of the album’s contents. The clear import of the notation “[r]e-recordings by the original

272. *Kingsmen*, 557 F. Supp. at 179.

273. *Id.* at 180–81.

274. *Id.* at 181.

275. *Id.* (citing *WGBH Educ. Found., Inc. v. Penthouse Int’l Ltd.*, 453 F. Supp. 1347, 1350 (S.D.N.Y. 1978), *aff’d mem.*, 598 F.2d 610 (2d Cir. 1979)).

276. *Id.*

277. *Id.* at 182.

278. *Kingsmen*, 557 F. Supp. at 182.

279. *Id.*

280. *Id.*

artists” is that those persons known in the public consciousness as The Kingsmen assembled in a studio to re-record Louie, Louie—an event that all parties agree did not occur. Finally, there is little doubt that this confusion will cause financial harm to the plaintiffs. The plaintiffs continue to receive royalties from the sale of albums containing Louie, Louie. Every time a consumer purchases one of defendants’ records, thinking he is getting a recording of Louie, Louie by The Kingsmen, the royalties owed the plaintiffs are reduced.²⁸¹

D. Similarities with the WAR Litigation

When the “New WAR” tour plays the Original WAR’s music, the public is being harmed.²⁸² The recently released album, *Greatest Hits Live*, includes performances by only one of the original members.²⁸³ Additionally, the use of the name WAR, with the notation that the album and songs are a “re-recording,” creates a false impression to consumers that they are getting a recording of the greatest hits of “Original WAR.”²⁸⁴ Like Kingsmen, WAR also has an ensemble nature in their music, and the “sound” is collective and not individualistic.²⁸⁵ “No one member of the group can be singled out as representing the essence” of WAR.²⁸⁶ *Greatest Hits Live* connotes those persons known to the public consciousness as WAR assembled to re-record.²⁸⁷ The misrepresentation causes financial harm to the remaining members of original WAR, and creates consumer confusion.²⁸⁸

E. Why Jerry Goldstein Should Not Receive Rights to the Trademark

1. *Rick v. Buchansky*, 609 F. Supp. 1522 (S.D.N.Y. 1985)

In late summer or early fall of 1961, David Rick, a manager and promoter, discovered four young men on a Brooklyn street corner singing

281. *Id.*

282. See Brown Complaint, *supra* note 20, at 3.

283. See *id.* at 9.

284. See *id.*

285. See *Kingsmen*, 557 F. Supp. at 182.

286. See *id.*

287. See *id.*

288. See *id.*

“doo-wop.”²⁸⁹ Rick invited the foursome to audition in Manhattan.²⁹⁰ Two members, Robert DiPaolo and Barry Solomon, accepted the offer.²⁹¹ DiPaolo and Solomon were accompanied by Dominick Mitchell and Vito Balsano.²⁹² All four were in their teenage years with Balsano being the youngest at fifteen years of age.²⁹³ After the audition, Rick offered to act as their manager/promoter and suggested the name “The Salutations.”²⁹⁴ On November 18, 1961, Rick entered into a management agreement with the four “Salutations.”²⁹⁵ Subsequently, Rick decided they should be called “Vito and the Salutations” because popular doo-wop groups at the time often augmented the group’s name with the first name of a group member.²⁹⁶ All agreed.²⁹⁷

Vito and the Salutations only had brief commercial success.²⁹⁸ One of the first songs recorded, “Gloria,” had commercial success in New York.²⁹⁹ The group recorded “Unchained Melody” in 1963, which climbed the popular music charts.³⁰⁰ After 1963, however, Vito and the Salutations never made a commercially successful album even though Rick managed to book engagements into the 1970s.³⁰¹

Vito and the Salutations experienced a high turn-over rate.³⁰² Within a year after formation, three of the four original members left the group.³⁰³ Vito Balsano, the only remaining member, left the group several times for brief periods during the 1960s.³⁰⁴ He rejoined the group in 1972 and remained until 1974, but has not performed since this time under Rick’s management.³⁰⁵ Throughout the 1960s and 1970s, approximately twenty-two different people performed in the group at one time or another.³⁰⁶ While the group toured and performed under the name “Vito and the

289. Rick v. Buchansky, 609 F. Supp. 1522, 1526 (S.D.N.Y. 1985).

290. *Id.*

291. *Id.*

292. *Id.*

293. *Id.*

294. *Id.*

295. *Buchansky*, 609 F. Supp. at 1526.

296. *Id.*

297. *Id.*

298. *Id.*

299. *Id.*

300. *Id.*

301. *Buchansky*, 609 F. Supp. at 1527.

302. *Id.*

303. *Id.*

304. *Id.*

305. *Id.*

306. *Id.*

Salutations,” the “role” of Vito was often played by someone other than Balsamo, although “Vito” was always a member of the group.³⁰⁷ The court stated, “[i]t is estimated that at least ten persons in addition to Balsamo played the role of ‘Vito’ in ‘Vito and the Salutations’ during the 1960s and 1970s.”³⁰⁸ The court further stated:

The group’s continued ability to secure bookings for live performances despite the rapid turnover must be attributed largely to the management and promotional efforts of plaintiff. In the 1982 decision on plaintiff’s preliminary injunction motion, this Court likened plaintiff’s task in managing the group to that of the producer or director of a long-running Broadway play, who must constantly find new performers to fill established roles without substantially altering the nature of the show itself. So Rick, as manager and promoter of “Vito and the Salutations,” conceived of the group’s performance as an “act” in which each member played a particular role. As individuals left the group, others were found to replace them and to assume their respective parts.³⁰⁹

The court found that no other party to the action besides Rick had the same level of influence over the group from 1961 until the date of decision.³¹⁰ Rick selected songs, taught dance and vocal technique, and paid the group’s expenses, including the purchase of meals, stage apparel, and lodging.³¹¹ The court stated, “[h]aving managed the musical group continuously since 1961, Rick is, in a sense, its ‘longest-playing’ member, albeit a behind-the-scenes participant.”³¹²

The plaintiff filed an application for the service mark “Vito and the Salutations” with the PTO on January 14, 1980.³¹³ Plaintiff’s application for the mark was unopposed and granted on September 15, 1981.³¹⁴ At this time, “Vito and the Salutations” consisted of defendants Buchansky, Graziano, Pardocchi, and Spinelli.³¹⁵ While Buchansky and Graziano sung with the group briefly in the 1960s (but were not original members),³¹⁶

307. *Buchansky*, 609 F. Supp. at 1257.

308. *Id.*

309. *Id.*

310. *Id.* at 1528.

311. *Id.* at 1527.

312. *Id.* at 1528.

313. *Buchansky*, 609 F. Supp. at 1528.

314. *Id.*

315. *Id.*

316. *Id.* at 1527 (stating that the original members of the band were DiPaulo, Mitchell,

Pardocchi and Spinelli joined in 1978.³¹⁷ Pardocchi played the role of Vito.³¹⁸ The group members signed an exclusive agreement with Rick on February 21, 1980 for one year with a two-year option.³¹⁹

Within a few months of signing the 1980 agreement, a dispute arose between Rick and the group.³²⁰ The group wanted to record an album with Life Stream Records, Inc. (Life Stream), but Rick refused to comply.³²¹ Without Rick's knowledge, the group proceeded to record the album.³²² Through Life Stream, defendants became acquainted with Charles Garone, who expressed an interest in managing them.³²³ Garone offered to purchase the group from Rick, but Rick rejected the offer.³²⁴ Garone eventually convinced the members to leave Rick's management.³²⁵ On October 15, 1980, the group entered into a management agreement with Garone.³²⁶ Vito Balsamo joined the group in late 1980, assuming the position of "Vito" at live concert appearances.³²⁷ Pardocchi remained in the group and assumed a different "role."³²⁸

When Rick learned of the group's contract with Garone, he informed Buchansky, Graziano, Pardocchi, and Spinelli that they were in breach of their 1980 agreement with him.³²⁹ Rick also asserted that their use of the name "Vito and the Salutations" infringed on his rights to the name.³³⁰ He demanded that defendants cease performing for Garone, cease recording with Life Stream, and cease using the name "Vito and the Salutations."³³¹ They refused.³³² Rick recruited replacement members for "Vito and the Salutations," including three returning members and a newcomer.³³³

Rick's group obtained few bookings because Garone's group had already appeared at many of the clubs where Rick sought to have his

Solomon, and Balsamo).

317. *Id.* at 1528.

318. *Id.*

319. *Buchansky*, 609 F. Supp. at 1528.

320. *Id.*

321. *Id.*

322. *Id.*

323. *Id.*

324. *Id.*

325. *Buchansky*, 609 F. Supp. at 1528.

326. *Id.*

327. *Id.*

328. *Id.*

329. *Id.*

330. *Id.*

331. *Buchansky*, 609 F. Supp. at 528.

332. *Id.*

333. *Id.* 1528-29.

ensemble perform.³³⁴ Club owners did not want to book a second group performing under the name "Vito and the Salutations."³³⁵ Vito filed suit to invalidate plaintiff's service mark.³³⁶ Rick filed counter-suit, and the two actions were consolidated.³³⁷

The court found that from 1961 through the date of filing, "plaintiff assumed leadership and control of 'Vito and the Salutations.'"³³⁸ The court also found that a promoter and manager of a group "can properly register a mark identifying the entertainment services of that group, although he himself is not one of the performers."³³⁹ According to the court, a trademark does not have to "be the name of the manufacturer of the goods and the public need not know the name of the owner of the mark."³⁴⁰

A trade or service mark functions . . . to inform the public of the source of the product or service to which the mark attaches, and to assure the public of its quality. Therefore, to the extent an individual controls the quality of the good or service involved, he or she may properly register a mark for that good or service. Because the source of the goods does not depend on the public's perception, the public need not know the registrant's role.³⁴¹

The court found that since Rick originally appropriated the mark and used the mark in commerce (and was the only person who continuously used the mark in commerce), he could properly claim ownership of the service mark.³⁴²

In contrast, three of the group's four original performing members remained for less than a year; the fourth, defendant Balsamo, left the group permanently in 1974. While the record reflects that many of the group's former members have returned to sing with the group from time to time, none has performed with the group continuously since 1961, nor does the evidence suggest that any performer has ever supplanted plaintiff as overseer of the group's day-to-day operations.

Particularly in view of the constant turnover of performers within the musical group, the Court concludes that only plaintiff

334. *Id.* at 1529.

335. *Id.*

336. *Id.*

337. *Buchansky*, 609 F. Supp. at 1529.

338. *Id.* at 1533.

339. *Id.* at 1537.

340. *Id.*

341. *Id.* at 1537–38 (citations and internal quotations omitted).

342. *Id.* at 1538.

has been in a position to control the content and quality of the entertainment services provided by “Vito and the Salutations” over the last twenty-three years. Thus, plaintiff could properly register a mark identifying the entertainment services of the group, even though his name is not a part of the mark and he himself has never performed in the musical group.³⁴³

2. Why This Litigation Proves Jerry Goldstein Should Not Have Rights to the Trademark

There are similarities to the way both groups were discovered. They were both found at a young age while performing.³⁴⁴ While there is a dispute about who created the name WAR, the band had incredible commercial success.³⁴⁵ Additionally, neither Gold nor Goldstein was a member of the band; neither performed with the band; neither taught vocal or dance techniques; and while they did provide a weekly recoupable stipend for living expenses, neither paid for all of the group expenses.³⁴⁶ Original WAR did not experience a high turnover rate.³⁴⁷ There was never a “role” for band members to play. Although the vocals were often shared, Howard Scott did not share his lead singer role with other members.³⁴⁸ The group’s ability to secure bookings was due to its own song writing and performance talent, not the direction of its manager and promoter, Gold and Goldstein.³⁴⁹

Generally, the success of any group is enhanced by its managers, booking agents, promoters, producers, public relations personnel, radio program managers, and record company. However, in this case, talent was the reason for Original WAR’s success, not Gold or Goldstein.³⁵⁰ The facts of the *Rick* case are interesting and stand for the proposition that a manager can own the trade name of a band, but the similarities between the WAR litigation and *Rick* are not sufficient to provide guidance to the court when it decides whether Goldstein is entitled to deceive the public by promoting New WAR.

Under the injunctions issued by both the Ninth Circuit and a federal

343. *Buchansky*, 609 F. Supp. at 1538.

344. *See id.* at 1526.

345. *Contra id.*

346. *Contra id.*

347. *Contra id.* at 1527.

348. *Contra id.*

349. *Contra Buchansky*, 609 F. Supp. at 1527.

350. *Contra id.* at 1528.

judge in Florida, the “original” members of WAR cannot secure the number of bookings that New WAR achieves because they are not permitted to use WAR on their résumés or state that they are original members of WAR.³⁵¹ Because the function of a trade or service mark is to inform the public of the source of the product or service, the original members of WAR should be allowed to identify themselves as the source of their greatest hits.³⁵² The original use of WAR in commerce belonged to the original members and not to Far Out Productions and Jerry Goldstein.³⁵³ Because original WAR members continue to perform as the LOWRIDERS, and Lonnie Jordan heads a WAR tribute band, the public is being deceived.³⁵⁴

3. Reversion of Copyrights

In certain instances, courts have justified rescission of a contract when the breach “is of so material and substantial a nature that [it] affect[s] the very essence of a contract and serve[s] to defeat the object of the parties. . . . [The breach must constitute] a total failure in the performance of the contract.”³⁵⁵ While there is no bright line rule to determine when rescission is appropriate, courts have found rescission inappropriate when almost ninety percent of royalties have been paid,³⁵⁶ or when the failure to

351. Brown Complaint, *supra* note 20.

352. See *Buchansky*, 609 F. Supp. at 1537–38.

353. *Contra id.* at 1538.

354. *Contra id.*; see also Brown Complaint, *supra* note 20, at 2–3.

355. *Morris v. Castle Rock Entm't*, 246 F. Supp. 2d 290, 294 (S.D.N.Y. 2003) (quoting *Rano v. Sipa Press, Inc.*, 987 F.2d 580, 586 (9th Cir. 1993)).

356. *Rano*, 987 F.2d at 586–87 (citing *Whitney Inv. Co. v. Westview Dev. Co.*, 273 Cal. App. 2d 594, 78 Cal. Rptr. 302, 307 (1969); Restatement (First) of Contracts § 275 (1932)). The court also determined:

Rano has not provided evidence sufficient to withstand summary judgment on this issue. Rano points to a number of acts that he contends constitutes a material breach, but only those acts preceding Rano's purported termination on March 12, 1987 are relevant. These acts include Sipa's alleged failure to pay royalties, failure to return negatives, and failure to credit for the Sara Ferguson photograph. The first two breaches claimed by Rano, upon which he relies most heavily, are not supported by the record. Sipa actually paid Rano 99.99% of the royalties due him up to approximately the time Rano sought to terminate the licensing agreement, excluding royalties due for photos published in the United States from 1985 to 1986. Of the latter, Sipa paid 86.85% of the royalties due. . . .

Even if we found Rano's allegations had merit, however, we could not conclude that Sipa materially breached the licensing agreement in light of the fact that the parties enjoyed a harmonious eight-year relationship (in which Rano received royalties and credit for his work). “After considerable performance, a slight breach which does not go ‘to the root’ of the contract will not justify termination.” *Witkin Summary of California Law* § 795 (9th ed. 1987).

Id.

pay was the result of oversight and neglect.³⁵⁷ At least one court has found rescission appropriate when the licensor failed to pay sixty-seven percent of the royalties and the breach was willful.³⁵⁸ In addition, the New York Supreme Court has granted rescission of contracts containing copyrights when the owner of the copyright has not worked the copyright in good faith, and stated:

I think [copyright holders] have abundantly established their right to such relief. One who undertakes to work property, such as a copyright on a royalty arrangement, becomes obligated to work it in good faith and for the benefit of the recipient of the royalties, as well as for his own avail. If he fails so to do, and thereby destroys the essential object of the royalty contract, rescission thereof may be decreed.³⁵⁹

In the case at bar, the Goldstein entities have claimed "copyright registrations for the compositions and sound recordings, identifying themselves . . . as the assignee pursuant to the various agreements."³⁶⁰ As a result, the Goldstein entities have acted as the exclusive administrator of the compositions, controlling all monies earned from the works' exploitation.³⁶¹ In this instance, the only motivation for Brown, Dickerson, Oskar, and Scott to sign any of the contracts with any of the Far Out entities would be for the payment of royalties. Because there was no payment of royalties, there was a material breach of the contract.³⁶² In addition, the members of the Original WAR have not received a current

357. *Nolan v. Williamson Music, Inc.*, 300 F. Supp. 1311, 1317 (S.D.N.Y. 1969) ("Cases which have considered the problem of rescission in situations [analogous] to the one presented by the case at bar have granted rescission only after finding the equivalent of a total failure in the performance of the contract."). The court opined that "[o]versight, negligence and less than meticulous bookkeeping do not amount to fraud." *Id.* at 1320.

358. *Frankel v. Stein & Day, Inc.*, 470 F. Supp. 209, 213 (S.D.N.Y. 1979) ("There are several significant factual differences between this case and *Nolan* which suggest that, if the standard set out in that case were applied here, the breach would in fact be found material. *Nolan* held that rescission is permitted when a breach is 'material and willful, or, if not willful, so substantial and fundamental as to strongly tend to defeat the object of the parties in making the contract.' Whereas in *Nolan*, the court found that Fox's failure to pay royalties was the result of '[o]versight, negligence and less than meticulous bookkeeping . . .,' it is undisputed here that defendant's failure to pay the money in question was willful." (citing *Nolan v. Sam Fox Publ'g Co.*, 499 F.2d 1394, 1397, 1399 (S.D.N.Y. 1969))).

359. *Broadcast Music, Inc. v. Taylor*, 55 N.Y.S.2d 94, 104 (1945) (granting rescission of a publishing agreement when a copyright holder intentionally did not place the music and prevented songwriters from receiving royalty payments).

360. *Brown Complaint*, *supra* note 20, at 13.

361. *Id.* at 13-14.

362. *See Frankel*, 470 F. Supp. at 213 (granting rescission where defendant failed to pay two-thirds of the royalties owed, and the breach was willful).

accounting, a summary of what monies were paid, or any indication as to how the royalties were distributed and to whom.³⁶³ Any failure to pay royalties is not an instance of oversight or neglect, but is rather a willful act motivated by greed.³⁶⁴ As a result, the court should find that the Far Out entities and Jerry Goldstein have intentionally withheld royalties owed to Brown, Dickerson, Oskar, and Scott. Accordingly, the court should rescind all of the breached contracts while transferring all the copyrights and trade names back to the Original WAR members. This result would allow the original members to record and tour under the name WAR and the public would get exactly what it bargained for.

IV. CONCLUSION

The WAR story is not over. As discussed above, there is still pending litigation in the Central District of California.³⁶⁵ It is not clear whether the resolution of the litigation will end the decades of fighting. If the court decides that the New WAR is deceiving the public and bars the group from advertising itself as the band that wrote and performed the songs made famous by the Original WAR, then the mark would be unusable by the New WAR unless they negotiate a settlement with the remaining members of Original WAR. The New Original WAR, comprised of Harold Brown, B.B. Dickerson, Lonnie Jordan, Lee Oskar, and Howard Scott, all of the living members of the Original WAR, could likely achieve great economic success by playing a reunion tour and would likely be inducted into the Hall of Fame.

The current state consumer protection laws are inadequate to prevent consumer confusion in a case like this one. Most state consumer protection statutes have language that would allow the current deception to continue because Lonnie Jordan was a member of Original WAR and is the only member of New WAR.³⁶⁶ The other members of Original WAR have not

363. Brown Complaint, *supra* note 20, at 13.

364. *Contra* Nolan v. Williamson Music, Inc., 300 F. Supp. 1311, 1317 (S.D.N.Y. 1969).

365. Order Denying Defendants' Motion to Dismiss as to Plaintiffs' First, Second, Third, Fourth, Fifth, and Sixth Causes of Action, Dismissing Plaintiffs' Seventh, Eighth, Ninth, Tenth, and Eleventh Causes of Action for Lack of Subject Matter Jurisdiction, and Denying Plaintiffs' and Defendants' Separate Requests for Judicial Notice, Brown v. Goldstein, No. CV09-03341 (C.D. Cal. Sept. 30, 2009). On September 30, 2009, Judge Stephen V. Wilson, denied all federal claims while dismissed the state claims pursuant to lack of jurisdiction. *Id.*

366. See e.g., *Truth in Music Advertising Act*, S. 929 Gen. Assem., Reg. Sess. (Pa. 2005) ("It shall be unlawful for any person to advertise or conduct a live musical performance or production in this Commonwealth through the use of a false, deceptive or misleading affiliation, connection or association between a performing group and a recording group. This section does not apply if any of the following apply: . . . (2) At least one member of the performing group was

voluntarily abandoned the name; they have been enjoined from using the name.³⁶⁷ That particular contingency does not seem to be covered by the consumer protection statutes and creates a loophole that perpetuates consumer confusion.

As to the breach of contract claim, Far Out Productions and Jerry Goldstein admit that they have underpaid the litigants millions of dollars.³⁶⁸ They do not believe that they are required to pay the royalties because they claim the contract under which the royalties are due has expired.³⁶⁹ If their theory is correct and the contract has expired, all of the intellectual property that is the subject matter of the expired contracts should revert to the individuals who signed the contracts. Counsel for Far Out Productions and Jerry Goldstein found a short term solution (no royalties are due because the contract expired),³⁷⁰ ratified by an uninformed state court judge,³⁷¹ that will create long term nightmares for their previously enforceable positions. No record company in the world, except Jerry Goldstein's, would argue that the duty to pay royalties expires at the conclusion of the contract period because that would mean that the company would no longer have any rights to the intellectual property. This position is absurd, and the decision recognizing the theory is even more absurd.

Band members need to protect themselves from each other while they prevent public confusion about whether the public is buying tickets and albums from the original members of a band or a group of musicians acting like a tribute band. The New WAR is a tribute band that features one of the original members of the group.³⁷² The Lowriders are the real deal who have been legally precluded from advertising their pedigree. Imagine being fifty-something years old and being told that you cannot include anything on your résumé from the last thirty years of your life. Try to get a job without mentioning your past accomplishments. That is the plight of Harold Brown, B. B. Dickerson, Lee Oskar, and Howard Scott. It could be the fate of Lonnie Jordan if he does not do exactly what Jerry Goldstein requires. The consuming public needs the members of Original WAR to be

a member of the recording group and has a legal right by virtue of use or operation under the group name without having abandoned the name or affiliation with the group.”); *see also*, 15 U.S.C. §§ 1051–52, 1125.

367. *Far Out Prods., Inc. v. Oskar*, 247 F.3d 986, 999 (9th Cir. 2001).

368. *Brown Complaint*, *supra* note 20, at 13.

369. *Id.* at 14.

370. *Id.*

371. *Id.*

372. *See Selvin*, *supra* note 6.

friends and reunite to end the confusion over which group truly represents Original WAR.

