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TRADEMARKS

State laws prohibiting a musical performing group from falsely identifying itself with the name of an earlier group are preempted by the federal Lanham Act and are invalid under the U.S. Constitution.

States Turn a Deaf Ear to the Constitution in an Effort to Promote 'Truth in Music'

By William L. Charron

Introduction: Fighting 'Doo-Wop' Imposters

"Doo-wop" music was born in the 1950s. Some of the most popular groups of that time included the Platters ("Earth Angel," "The Great Pretender"), the Coasters ("Yakety Yak," "Poison Ivy") and the Drifters ("On Broadway," "Under the Boardwalk").

Even though most of the original singers of these groups have passed away, doo-wop music remains popular today. What may surprise some is that you can still hear the Platters—not a cover band but "The Platters"—perform "Earth Angel" in 2009. What may surprise even more is that one audience can attend a Platters concert today in Las Vegas, while another audience, at the exact same time, can attend a Platters concert in Atlantic City.

William L. Charron is a lawyer with Pryor Cashman, New York.

Obviously these groups do not include the same singers, nor do they include the original 1950s singers. Yet both groups are entitled to call themselves "The Platters" and may claim that they are a continuation of the original 1950s singing group. Such is the magic of federal trademark law.

In the case of the Platters, a company based in New York claims exclusive rights to the unregistered trademark "The Platters." That company claims to have derived its trademark from assignments that originated from each of the five original members of the 1950s group.[1] This company licenses its "Platters" mark to another entertainment company that manages and promotes multiple groups of singers, all of whom employ the license in lawful and non-infringing ways and call themselves "The Platters."[2] The Platters regularly perform today in Las Vegas, Atlantic City, and elsewhere (perhaps even at the same time) to sell-out crowds.

[1] *See* Complaint dated Aug. 16, 2007 at ¶ 15 by plaintiffs Singer Management Consultants Inc. and Live Gold OperationsInc. in case No. 2:07-cv-003929 (DRD), Docket Entry 1.

[2] *Id.*

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Beginning in or about 2004, a legislative movement attempted to put an end to what some have identified as doo-wop ''imposter groups.''[3] Against the backdrop of ''consumer protection,'' a number of states began to pass what have come to be known as ''Truth in Music'' laws. These laws require certain musical performing groups that fail to meet enumerated criteria to identify themselves in advertising and on stage as ''tribute'' or ''salute'' groups. Squarely in the crosshairs of the Truth in Music laws are performing groups that operate pursuant to unregistered (*i.e.*, common law) trademarks, as opposed to federally registered trademarks.

Thus, for example, the Truth in Music laws could potentially prohibit the Platters from identifying themselves as ''The Platters'' and instead require that group to call itself ''A Tribute (or Salute) to The Platters.'' The effect of the Truth in Music laws would be to transform a group with distinct and valuable name-recognition into a seemingly generic cover band. Because cover bands are free to perform without trademark licenses, the ultimate effect of the Truth in Music laws is to invalidate a specific universe of otherwise valid unregistered trademarks.

Widely Adopted, but Enforcement Challenged

Thirty-three states have adopted versions of the so-called ''Truth in Music Act.''[4] In the summer of 2007, New Jersey tried to enforce its version of the Truth in Music Act against holders of unregistered performing group trademarks, including the holder of ''The Platters'' unregistered mark. This effort, spearheaded by the office of New Jersey's attorney general, was short-lived thanks to the entry of a temporary restraining order issued by the U.S. District Court for the District of New Jersey (Judge Dickinson R. Debevoise).[5]

The New Jersey federal court issued the TRO after finding that the attorney general's attempted enforcement of the Truth in Music Act against unregistered trademark holders likely violated the First Amendment and the equal protection and supremacy clauses of the U.S. Constitution.[6] That finding was unquestionably correct, as discussed in detail below.

After being temporarily enjoined, New Jersey's attorney general quickly conceded that, in order to be constitutional, the Truth in Music Act could not distinguish between registered and unregistered trademarks. That concession removes the teeth from the Truth in Music Act, which is specifically conceived and drafted to discriminate against unregistered marks.

Moreover, the attorney general's concession renders the Truth in Music Act meaningless in light of Section 43(a) of the federal Lanham Act, 15 U.S.C. § 1125(a), which already provides that owners of valid unregistered marks enjoy equal exclusive rights as owners of registered marks, as discussed below. Nevertheless, the New Jersey attorney general's concession was appropriate and her experience should put the attorneys general of the other 33 states that have passed Truth in Music Acts on notice that those laws are nothing more than compellingly titled nullities.

New Jersey Model Typical

The purpose of the Truth in Music Act is to protect consumers from allegedly deceptive advertising in the area of musical performing groups that use the name of a group that previously released a commercial sound recording.[7] The concern is that consumers may unwittingly think they are paying to see ''original'' performing groups (*e.g.*, in the case of doo-wop music, with original members from the 1950s), and not modern-day performing groups with younger members, such as the Cornell Gunter Coasters.

New Jersey's version of the Truth in Music Act, N.J.S.A. 2A:32B-2, is typical in language and scope of the laws now on the books of over half of the states in the United States. New Jersey's law provides:

> A person shall not advertise or conduct a live musical performance or production through the use of an affiliation, connection or association between the performing group and the recording group unless:
>
> (a) The performing group is the authorized registrant and owner of a federal service mark for the group registered in the United States Patent and Trademark Office; or
>
> (b) At least one member of the performing group was 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 of affiliation of the group; or
>
> (c) The live musical performance or production is identified in all advertising and promotion as a salute or tribute; or
>
> (d) The advertising does not relate to a live musical performance or production taking place in this State; or
>
> (e) The performance or production is expressly authorized by the recording group.[8]

Pursuant to N.J.S.A. § 2A:32B-1, the New Jersey Act defines the term ''performing group'' to mean ''a vocal or instrumental group seeking to use the name of another group that has previously released a commercial sound recording under that name.''

Pursuant to § 2A:32B-1, the New Jersey Act defines the term ''recording group'' to mean ''a vocal or instrumental group, at least one of whose members has previously released a commercial sound recording under that group's name and in which the member or members have a legal right by virtue of use or operation under the group name without having abandoned the name or affiliation with the group.''

Pursuant to § 2A:32B-1, the New Jersey Act defines the term ''sound recording'' to mean ''a work that results from the fixation on a material object of a series of

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[3] *See generally* the website of the Vocal Group Hall of Fame Foundation (primary sponsor of the Truth in Music Act movement): http://www.vocalgroup.org/truth_states.htm.

[4] According to the Vocal Group Hall of Fame Foundation, these states include: California, Colorado, Connecticut, Delaware, Florida, Illinois, Indiana, Kansas, Maine, Maryland, Massachusetts, Michigan, Minnesota, Missouri, Nevada, New Hampshire, New Jersey, New York, North Carolina, North Dakota, Ohio, Oklahoma, Oregon, Pennsylvania, Rhode Island, South Carolina, Tennessee, Texas, Utah, Vermont, Virginia, Washington, and Wisconsin. (*See* http://www.vocalgroup.org/truth_states.htm.)

[5] *Singer Management Consultants Inc. v. Milgram*, No. 07-cv-3939, 2009 WL 931527, at *2 (D.N.J. Apr. 7, 2009).

[6] *Id.*

[7] *See generally* N.J.S.A. § 2A:32B.

[8] *See Singer Management*, 2009 WL 931527, at *2.

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musical, spoken or other sounds regardless of the nature of the material object, such as a disk, tape or other phono-record, in which the sounds are embodied.''

Pursuant to § 2A:32B-3, the New Jersey Act provides for private and public enforcement, ''including, but not limited to, the Attorney General seeking and obtaining an injunction pursuant to section 8 of P.L. 1960, c. 39 (C.56:8-8) and the assessment of a civil penalty pursuant to section 1 of P.L. 1966, c. 39 (C.56:8-13).''

The Truth in Music Act is not a model of clarity, but there are three alternative and mutually exclusive ways to interpret it.

First, one may interpret the term ''performing group'' as distinguishing between performers and nonperformers, such as group managers, because the term ''group'' is not specifically defined by the act. Interpreted this way, the Truth in Music Act would prohibit a performing group's manager from using the group's name as a registered mark.

Specifically, a state adopting the Truth in Music Act would recognize a federally registered trademark in the field of music performance only if a ''performing group'' itself ''is the authorized registrant and owner'' of the mark, under exception ''(a)'' to the Act.[9]

In addition, the act would recognize unregistered, but legally valid common law trademarks only to the extent that at least one member of a ''recording group'' holds the common law rights, and that member must also share the stage with the ''performing group'' or otherwise ''expressly authorize'' each particular live performance of the performing group.[10] Therefore, the Truth in Music Act would forbid a recording or performing group's manager from owning the group's name as an unregistered mark.

The Truth in Music Act's potential segregation of group managers is calculated to prevent managers from utilizing trademarks for indefinite periods of time simply by shuffling members among the performers themselves.[11]

Second, if the term ''group'' is read as including a group's manager, then the Truth in Music Act requires states to distinguish between performing groups that hold *registered* trademarks (who would be permitted by the statute to perform under exception ''(a)'' to the act), and performing groups that hold equally valid but *unregistered* trademarks, who, under the remainder of the act, would have to obtain some additional permission to perform from ''recording groups'' or otherwise promote themselves as ''tribute'' or ''salute'' groups.[12] This second interpretation was the focus of the New Jersey federal district court's decision in *Singer Management Consultants Inc. v. Milgram*.[13]

Third, one may read exception ''(e)'' to the act, which permits all musical performances and productions if they are ''expressly authorized by the recording group,'' to mean that a valid federally registered or unregistered trademark in and of itself constitutes ''express authorization'' as a matter of law. As discussed below, this third method of interpreting the Truth in Music Act is the *only* interpretation that avoids constitutional problems by harmonizing the act with the federal Lanham Act. This was the interpretation urged by the plaintiffs in *Singer Management*, as discussed below.[14] Nevertheless, this third interpretation also renders the Truth in Music Act a mere redundant complement to the Lanham Act.

The Lanham Act: Federal Protection Against Consumer Confusion

Section 43(a)(1) of the Lanham Act provides:

> 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 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.[15]

As explained by the Third Circuit in *Mariniello v. Shell Oil Co.*, the purposes of the Lanham Act are ''twofold'': ''One is to protect the public so it may be confident that . . . it will get the product which it asks for and wants to get. Secondly, where the owner of a trademark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats.''[16]

The Lanham Act guarantees exclusive use rights to trademark owners, including owners of unregistered marks.[17] ''Section 43(a)(1) of the Lanham Act protects unregistered marks to the same extent as registered marks because trademark rights emanate from use and not merely registration.''[18]

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[9] N.J.S.A. 2A:32B-2(a).

[10] *Id.* §§ B-2(b) & (e).

[11] *See Rick v. Buchansky*, 609 F. Supp. 1522, 1535, 1538, 226 USPQ 449 (S.D.N.Y. 1985) (finding that 1950s doo-wop music groups in particular are the product of ''constant turnover of performers within the musical group.'').

[12] As discussed below, the federal Lanham Act grants equal legal status to registered and unregistered trademarks. Registered trademarks are simply entitled to a rebuttable presumption of validity, where unregistered trademarks are not.

[13] *Singer*, 2009 WL 931527, at *1-2.

[14] *Id.* at *2-3.

[15] 15 U.S.C. § 1125(a)(1).

[16] 511 F.2d 853, 858, 185 USPQ 71 (3d Cir. 1975).

[17] *E.g.*, *Mariniello*, 511 F.2d at 858.

[18] *800 Spirits Inc. v. Liquor by Wire Inc.*, 14 F. Supp. 2d 675, 678 (D.N.J. 1998) (citing *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 768, 23 USPQ2d 1081 (1992)(44 PTCJ 213, 228, 7/2/92) (1992)); *accord Emergency One Inc. v. American Fire Eagle Engine Co.*, 332 F.3d 264, 267 & n.1, 67 USPQ2d 1124 (4th Cir. 2003) (66 PTCJ 260, 6/27/03)(''The owner of a mark acquires 'both the right to use a particular mark and the right to prevent others from using the same or a confusingly similar mark.' Accordingly, trademark ownership confers an exclusive right to use the mark. Federal registration of a mark does not establish ownership rights in the mark; rights in a registered mark are acquired through actual use, just as for unregistered marks.'') (citations omitted).

Moreover, the Lanham Act *requires* actual and continuous use of a mark in order for the trademark owner to preserve its rights.[19]

Therefore, Section 43(a)(1) of the Lanham Act guarantees trademark owners the exclusive right—and the ''*requirement*''—to use their marks. The federal statute also provides a cause of action under Section 43(a) to ''any person'' who is a lawful trademark owner in order to protect against piracy and to avoid the fostering of consumer confusion.

Lanham Act Preempts Inconsistent State Laws, Pursuant to the Supremacy Clause of the U.S. Constitution

''A fundamental principle of the Constitution is that Congress has the power to preempt state law.''[20] In particular, the supremacy clause of the Constitution provides:

> This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the authority of the United States, shall be the supreme Law of the land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding.[21]

Congress, under its supreme right to make law, may expressly provide for preemption of inconsistent state laws.[22] ''Even without an express provision for preemption, . . . state law must yield to a congressional Act in at least two circumstances. When Congress intends federal law to 'occupy the field,' state law in that area is preempted. . . . And even if Congress has not occupied the field, state law is naturally preempted to the extent of any conflict with a federal statute.''[23]

''Conflict preemption,'' as the last form of preemption is known, exists where, ''under the circumstances of [a] particular case, [the challenged state law] stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.''[24]

The Third Circuit's decision in *Mariniello* is a leading case on the issue of conflict preemption in the area of the Lanham Act. The case involved the question of whether New Jersey common law, which prohibited ''without cause'' terminations of franchise agreements, was unconstitutional under the Supremacy Clause by reason of the Lanham Act's provision that trademark holders have exclusive rights to determine the use of their marks by others.[25]

The court explained that ''[w]here conflict is alleged between federal and state law, the specific purpose of the federal act must be ascertained in order to assess any potential erosion of the federal plan by operation of the state law.''[26] After analyzing the purposes of the Lanham Act, the court found that New Jersey law—which rendered a contract clause within the trademark holder's franchise agreement unenforceable as against public policy—did not frustrate the Lanham Act's goals and thus was not preempted and invalidated under the Supremacy Clause.[27]

In contrast, the Truth in Music Act must be deemed to be preempted by the Lanham Act under ''conflict preemption'' analysis if the Truth in Music Act is interpreted to distinguish either between performers and non-performer trademark holders, or between registered and unregistered trademarks.

Truth in Music Act's Distinction Between Performers and Non-Performers as Potential Trademark Owners Is Invalid Under the Supremacy Clause of the U.S. Constitution

The first possible interpretation of the Truth in Music Act, which effectively would forbid group managers from enjoying their registered and unregistered trademarks, reflects an attack by the Truth in Music Act upon non-performers in the field of music.

This attack conflicts with the Lanham Act, which has long been held to recognize the rights of non-performers to own and use marks manifesting performing group names. A leading and instructive decision in this regard is *Rick v. Buchansky*, which explained:

> The purposes underlying the [] Lanham Act, are well known: the ''Act provides national protection of trademarks in order to secure to the owner of the mark the good will of his business and to protect the ability of consumers to distinguish among competing producers.''. . . Trademark rights are acquired through use.
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> [P]laintiff, the manager and promoter of a musical group, can properly register a mark identifying the entertainment services of that group, although he himself is not one of the performers. It is well established that ''[a] trademark need not be the name of the manufacturer of the goods and the public need not know the name of the owner of the mark.'' A trade or service mark functions in part 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 ''[t]he source of the goods does not depend on the public's perception[,] the public need not know [the plaintiff's] role.''
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[19] *E.g.*, 15 U.S.C. § 1127 (''A mark shall be deemed abandoned . . . [w]hen its use has been discontinued with intent not to resume use.''); *Emergency One*, 332 F.3d at 268-69 (''The priority to use a mark, however, can be lost through abandonment. . . . At common law, therefore, the exclusive right to use a mark is 'limited to areas where [the mark] had been used and the claimant of the mark had carried on business.'. . . Thus, the owner of common-law trademark rights in an unregistered mark is not entitled to injunctive relief in those localities where it has failed to establish actual use of the mark.'') (citations omitted).

[20] *Crosby v. National Foreign Trade Council*, 530 U.S. 363, 372 (2000) (citations omitted).

[21] U.S. Const. Art. VI, cl. 2.

[22] *Crosby*, 530 U.S. at 372.

[23] *Id.* (citations omitted).

[24] *Id.* at 373 (citation omitted).

[25] 511 F.2d at 855-56.

[26] *Id.* at 858.

[27] *Id.*

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> [P]laintiff may properly claim ownership of the service mark ''VITO AND THE SALUTATIONS'' because it was [plaintiff] who originally appropriated and used the mark in commerce. . . . As the manager of the musical group, plaintiff has steadily promoted its name through his solicitation of bookings and through general advertising. Moreover, plaintiff's duties over the years have included making personnel decisions, handling the group's finances, and generally supervising the style and content of the group's ''act.''. . . Particularly in view of the constant turnover of performers within the musical group, the Court concludes that only plaintiff 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.[28]

Managers of musical performing or recording groups are entitled to own and use registered and unregistered trademarks in interstate commerce, notwithstanding that the managers themselves may not perform in the group or have their names reflected in the group's mark. Indeed, Section 43(a)(1) of the Lanham Act *guarantees* the right of ''exclusive use'' to such trademark holders. The Truth in Music Act's attempted elimination of the right of non-performers in the field of music to use their trademarks blatantly conflicts with the Lanham Act.

Furthermore, the Truth in Music Act's attack upon non-performers in the field of music conflicts with the Lanham Act's guarantee that ''any person'' holding a valid trademark, regardless of area of commerce, including non-performers in the field of music, has standing to bring claims in order to protect their marks from piracy.[29] Lanham Act standing is not determined by a trademark holder's occupation or talents, and ''Section 43(a) provides no support for drawing a distinction in standing depending on the type of § 43(a) violation alleged.''[30]

To the extent the Truth in Music Act may be interpreted as eliminating the trademark rights of non-performers in the field of music, the statute obstructs a fundamental purpose of the Lanham Act to grant ''any person'' with a valid trademark the right and legal standing to prevent piracy.[31] Under ''conflict preemption'' analysis and the Constitution's Supremacy Clause, therefore, the Truth In Music Act is unconstitutional.

Truth in Music Act's Distinction Between Registered and Unregistered Trademarks Is Invalid Under the Supremacy Clause

The second possible interpretation of the Truth in Music Act would permit registered trademark holders to have their musical groups record or perform unhindered, but would require unregistered trademark holders to obtain additional ''express authorization'' from ''recording groups'' to record or perform, or else require unregistered trademark holders to abandon their marks and to identify their groups as ''tribute'' or ''salute'' groups. This interpretation constitutes a de facto attack by the Truth in Music Act on unregistered trademark owners in the field of music.

As discussed above, Section 43(a)(1) of the Lanham Act protects unregistered marks and registered marks equally.[32] ''Trademark rights are acquired through use,'' and exclusive use rights and the ability of trademark holders to protect against pirated use are what Section 43(a)(1) is designed to protect, without distinction as between registered and unregistered marks.[33]

The Truth in Music Act's distinction between performing groups that hold federally registered marks and performing groups that do not is thus another violation of the Lanham Act and, thus, of the supremacy clause under ''conflict preemption'' analysis.

The implication of the Truth in Music Act is that there should not be a national trademark standard, but rather 50 different laws on the subject that may further vary by particular areas of commerce (such as the field of doo-wop music performances). The supremacy clause bars that result and must be held to render the Truth in Music Act unenforceable to the extent that the statute seeks to deviate from the protections afforded by Section 43(a)(1) of the Lanham Act.

Distinction Between Registered and Unregistered Trademarks Created by the Truth in Music Act Violates the Equal Protection Clause

The equal protection clause of the 14th Amendment to the U.S. Constitution provides: ''no state shall deny

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[28] 609 F. Supp. at 1529, 1535, 1537-38, 226 USPQ 449 (S.D.N.Y. 1985) (citations omitted); *see also Marshak v. Reed*, No. 96 CV 2292 (NG) (MLO), 2001 WL 92225, at *17 (E. & S.D.N.Y. Feb. 1, 2001), *aff'd*, 87 Fed. Appx. 208 (2d Cir. 2004) (''These principles have been applied repeatedly in decisions involving musical groups where, depending upon the individual facts, claims of ownership of the group's name by managers or corporate entities have been upheld or rejected on the merits.'') (citations omitted).

[29] *See* 15 U.S.C. § 1127 (defining the ''term 'person' and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this chapter [to] include[] a juristic person as well as a natural person. The term 'juristic person' includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.'').

[30] *Conte Brothers Auto Inc. v. Quaker State-Slick 50 Inc.*, 165 F.3d 221, 232 49 USPQ2d 1321 (3d Cir. 1998)(57 PTCJ 178, 1/7/99; *accord O.O.C. Apparel Inc. v. Ross Stores Inc.*, No. 04-6409 (PGS), 2007 WL 869551, at *3 (D.N.J. Mar. 20, 2007).

[31] *Cf. Philip Morris Inc. v. Reilly*, 312 F.3d 24, 39 (1st Cir. 2002) (65 PTCJ 138, 12/13/02)(''Massachusetts cannot simply redefine property rights without regard to previously existing protections.'') (citations omitted); *Sabo v. Metropolitan Life Insurance Co.*, 137 F.3d 185, 193-94 (3d Cir. 1998) (explaining under McCarran-Ferguson Act's ''inverse preemption'' doctrine, where ''federal laws must yield to state laws when the state enacts a statute for the purpose of regulating the insurance business,'' that federal cause of action under civil RICO statute would be preempted if a state ''explicitly authorize[d] certain insurance practices that RICO would clearly prohibit'') (citing *N.A.A.C.P. v. American Family Mutual Insurance Co.*, 978 F.2d 287, 297 (7th Cir. 1992) (''If Wisconsin wants to authorize redlining, it need only say so; if it does, any challenge to that practice under the auspices of the Fair Housing Act becomes untenable.'')).

[32] *E.g.*, *800 Spirits*, 14 F. Supp. 2d at 678; *Emergency One*, 332 F.3d at 267 n.1.

[33] *Rick*, 609 F. Supp. at 1529 (citations omitted).

to any person within its jurisdiction the equal protection of the laws.''[34]

The equal protection clause '' 'is essentially a direction that all persons similarly situated should be treated alike.'. . . Whether this ideal has been met in the context of economic legislation is determined through application of the rational basis test.''[35]

As explained above, registered and unregistered trademarks are entitled to equal protection under Section 43(a)(1) of the Lanham Act.[36] A registration merely provides a rebuttable presumption of trademark ownership, but ''[f]ederal registration of a mark does not establish ownership rights in the mark; rights in a registered mark are acquired through actual use, just as for unregistered marks.''[37]

The Truth in Music Act offers no rational basis for its premise that the registration of a trademark invests a mark with ''truth'' in music, but unregistered trademarks are to be treated as potentially offensive and suspect within the specific field of music performance and thus require additional criteria for use. The distinction between registered and unregistered marks created by the Truth in Music Act is arbitrary, irrational, and manifestly unconstitutional. This was the essential conclusion of the New Jersey federal district court in *Singer Management v. Milgram*.

In that case, the plaintiffs claimed to own exclusive rights to the unregistered marks ''The Platters,'' ''The Cornell Gunter Coasters'' and ''The Elsbeary Hobbs Drifters.''[38] Rights to the Platters mark were alleged to derive from the five original members of that singing group.[39] Rights to the Cornell Gunter Coasters mark was alleged to derive from an exclusive license from the Estate of Cornell Gunter; Cornell Gunter was a singer with the Coasters from 1957-1961, and was lead singer of the Cornell Gunter Coasters from 1961-1990.[40] Rights to the Elsbeary Hobbs Drifters mark were alleged to derive from an exclusive license from the Estate of Elsbeary Hobbs; Elsbeary Hobbs was a singer with the Drifters, and later lead singer of the Elsbeary Hobbs Drifters, from 1958-1996.[41]

The plaintiffs alleged that New Jersey's Truth in Music Act violated the supremacy, equal protection, and takings clauses and First Amendment to the U.S. Constitution.[42] Specifically, as noted by the district court:

> Plaintiffs' First Count alleges that the Truth in Music Act conflicts with the Lanham Act, and thus violates the Supremacy Clause, because the Lanham Act protects registered and distinctive unregistered trademarks equally and the Defendant's enforcement of the Act prevents the fulfillment of the objective of the Lanham Act.
>
> Plaintiffs' Second Count alleges a violation of the takings clause of the Fifth Amendment to the U.S. Constitution in that Defendant's enforcement of the Truth in Music Act effects a taking of the Plaintiffs' property rights in their unregistered trademarks without compensation.
>
> Plaintiffs' Third Count alleges a violation of the right to free speech under the First Amendment to the U.S. Constitution in that it prevents holders of unregistered but valid trademarks from causing their musical groups to perform, to be promoted and to speak.
>
> Plaintiffs' Fourth Count alleges a violation of the equal protection clause of the Fourteenth Amendment to the U.S. Constitution. Plaintiffs allege that Defendant's enforcement of the Truth in Music Act [unconstitutionally discriminates] ''between performing groups with registered trademarks (who may perform) and performing groups with unregistered trademarks (who may not perform unless they receive some additional approval or involvement from 'recording groups').''[43]

The district court agreed with the plaintiffs and found (without expressly explaining) that there were ''basic legal problems—equal protection, First Amendment and due process'' problems with the New Jersey Attorney General's attempted enforcement of the Truth in Music Act in a manner that would have required the plaintiffs to promote their singing groups as ''tribute'' groups.[44]

To address the district court's concerns, the attorney general abandoned her initial arguments during the preliminary injunction hearing, after having been temporarily restrained from enforcing the Truth in Music Act and having lost arguments to dismiss the plaintiffs' case on subject matter jurisdiction and justiciability grounds.[45] The attorney general instead agreed to be bound by the following statement articulated by the district court: ''[T]he State's position is that once a holder of a common law trademark establishes its right to that trademark, they're in the same position as the holder of a registered trademark. . . . If there's a valid common law trademark under the Lanham Act, and if whoever has possession of it can establish a right to that possession, he is to be treated – or she is to be treated in the same way as the holder of a registered trademark.''[46]

In further proceedings in the case:

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[34] U.S. Const., amend. XIV.

[35] *Racing Association of Central Iowa v. Fitzgerald*, 675 N.W.2d 1, 7 (Iowa 2004) (citations omitted) (finding no rational basis for distinguishing between floating and land-based casinos).

[36] *E.g.*, *Two Pesos*, 505 U.S. at 768.

[37] *Emergency One*, 332 F.3d at 267 n.1 (citations omitted).

[38] 2009 WL 931527, at *1.

[39] *See* Complaint dated Aug. 16, 2007 at ¶ 15 by plaintiffs Singer Management Consultants Inc. and Live Gold OperationsInc. in case No. 2:07-cv-003929 (DRD), Docket Entry 1.

[40] *Id.* at ¶ 14.

[41] *Id.* at para. 13. In a decision entered on July 2, 2009 in the case of *Marshak v. Treadwell*, Nos. 08-1771, 08-1836, 08-1837, 2009 U.S. App. LEXIS 14605 (3d Cir. July 2, 2009) (78 PTCJ 288, 7/10/09), the U.S. Court of Appeals for the Third Circuit held, as an independent matter, that Singer Management's use of the mark ''The Elsbeary Hobbs Drifters'' aided and abetted the contempt of a permanent injunction that had been entered against another party concerning the mark ''The Drifters.''

[42] 2009 WL 931527, at *1. The author of this article represented the plaintiffs in *Singer* and borrows heavily in this article from his memorandums of law in support of the plaintiffs' application for a temporary restraining order and preliminary injunction. The only argument not discussed in this article is the plaintiffs' ''takings clause'' argument, which is a more fact-specific inquiry concerning a party's reasonable investment-backed expectations and the economic impact of the government's conduct upon that party.

[43] 2009 WL 931527, at *1.

[44] *Id.* at *2.

[45] *Id.*

[46] *Id.*

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> [T]he State again confirmed that it interprets and will apply part (a) of the Truth in Music Act to include common law trademarks rather than just registered marks, *thereby providing equal protection to holders of registered trademarks and common law trademarks*. Both the Plaintiffs and the State [thus] confirmed that the Plaintiffs' constitutional claims were resolved by this interpretation of the Act.[47]

Therefore, the attorney general addressed and satisfied the district dourt's primary concern, which was an equal protection concern, by agreeing to treat registered and unregistered trademarks equally under the Truth in Music Act, notwithstanding language that was plainly intended to provide disparate treatment.

Truth in Music Act's Requirement That Unregistered Trademark Holders Identify Their Groups as 'Tribute' or 'Salute' Groups Violates the First Amendment

The First Amendment to the U.S. Constitution provides: ''Congress shall make no law . . . abridging the freedom of speech . . . .''[48] The First Amendment is applicable to the states by the Fourteenth Amendment.[49]

The Truth in Music Act mandates that unregistered trademark holders who do not receive ''express authorization'' from ''recording groups'' to give a particular musical performance must affix the words ''salute'' or ''tribute'' to the marks. Those words have necessary connotations in the field of music performance and they eviscerate the significance of a trademark and its attendant goodwill: i.e., anyone can call themselves a ''tribute'' band and can perform as a ''cover group.''

When a state law compels one to affix a label to a product that dictates a message about the content of the speech therein, and contradicts the speaker's own belief about such content, the law exceeds the boundaries of ''commercial speech'' and is considered ''a content-based regulation subject to the strictest scrutiny under the First Amendment.''[50]

Under strict scrutiny, a state must demonstrate that it has a ''compelling interest'' and has ''chosen the least restrictive means to further this interest'' in forcing parties ''to alter their speech to conform with an agenda that they [did] not set.''[51]

The Truth in Music Act does not appear to be supported by any empirical proof of the feared ''deception'' that consumers may unwittingly think they are paying to see ''original'' performing groups. Moreover, as the court in *Rick v. Buchansky* found, it is well known that 1950s doo-wop music groups in particular are the product of ''constant turnover of performers within the musical group.''[52] The Truth In Music Act does not address just which ''original'' recording or performing doo-wop group members over the years should be considered authentic in the minds of the consuming public, or where the line of so-called ''imposter'' performers should be drawn.

Therefore, the Truth in Music Act does not support a ''compelling'' state interest. Moreover, the act is not narrowly tailored to effect its purpose. By freezing *legitimate* trademark holders from causing their groups to perform and from promoting themselves by their actual, trademarked names, without the prefix ''tribute'' or ''salute,'' the Truth in Music Act is unconstitutionally overbroad.[53]

The Truth in Music Act also violates the First Amendment under an intermediate scrutiny analysis.[54] ''Under [intermediate scrutiny], a regulation is constitutional only if (1) 'it is within the constitutional power of the Government'; (2) it 'furthers an important or substantial governmental interest'; (3) 'the governmental interest is unrelated to the suppression of free expression'; and (4) 'the incidental restriction on alleged First Amendment freedoms is no greater than is essential to the furtherance of that interest.' ''[55]

The Truth in Music Act seeks to force a group such as the Platters to identify and speak of itself as a ''Salute'' or ''Tribute to the Platters'', thereby diluting that group's name recognition and goodwill. Nevertheless, if the Platters enjoy a valid unregistered trademark to call themselves the Platters, then they should be entitled as a matter of law to refer to themselves under their trademarked name. There is nothing false or publicly misleading about a trademark owner exploiting its mark in such a way.

By seeking to chill legitimate trademark holders from expressing themselves and speaking in non-misleading ways, the Truth in Music Act is unconstitutionally overbroad and thus fails the fourth element of the intermediate scrutiny analysis.[56]

Exception '(e)' to the Truth in Music Act Saves the Act, But Also Renders it Superfluous in Light of Section 43(a)(1) of the Lanham Act

The district court in *Singer Management v. Milgram* constrained the attorney general to agree that exception ''(a)'' to the Truth in Music Act should be read as including unregistered trademarks as well as federally registered trademarks, even though that provision of the statute literally identifies only ''the authorized registrant and owner of a federal service mark for the group registered in the United States Patent and Trademark Office.''[57]

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[47] *Id.* at *3 (emphasis supplied).

[48] U.S. Const., amend. I.

[49] *E.g.*, *School District v. Schempp*, 374 U.S. 203, 215 (1963).

[50] *Entertainment Software Association v. Blagojevich*, 404 F. Supp. 2d 1051, 1072 (N.D. Ill. 2005), *aff'd*, 469 F.3d 641 (7th Cir. 2006) (finding state law unconstitutional that compelled plaintiff to label its video game as ''sexually explicit'') (citations omitted); *see also Riley v. National Federation of the Blind of N.C. Inc.*, 487 U.S. 781, 795 (1988); *Turner Broadcasting Systems Inc. v. F.C.C.*, 512 U.S. 622, 641-42 (1994); *Pacific Gas & Electric Co. v. Public Utilities Commission*, 475 U.S. 1, 9 (1986); *44 Liquormart Inc. v. Rhode Island*, 517 U.S. 484, 499 (1996).

[51] *Entertainment Software*, 404 F. Supp. 2d at 1072, 1082; *Pacific Gas*, 475 U.S. at 9.

[52] 609 F. Supp. at 1538 & 1535 (''[D]efendants simply have not persuaded the Court that the mark 'VITO AND THE SALUTATIONS' is inextricably linked in the public's eye with the personal skill or reputation of Vito Balsamo.'').

[53] *See Conchatta Inc. v. Miller*, 458 F.3d 258, 268 (3d Cir. 2006) (citations omitted).

[54] *United States v. O'Brien*, 391 U.S. 367 (1968).

[55] *Conchatta*, 458 F.3d at 262-63 (citing *O'Brien*).

[56] *See also Pitt News v. Pappert*, 379 F.3d 96, 107-08 (3d Cir. 2004).

[57] 2009 WL 931527, at *2; N.J.S.A. 2A:32B-2(a).

Under more conservative statutory interpretation principles, the district court could have required the attorney general to agree with the plaintiffs' position in *Singer Management*: namely, that exception ''(e)'' to the Truth in Music Act, which permits performances that are ''expressly authorized by the recording group,'' must be interpreted as meaning that any lawful trademark under the Lanham Act—whether registered or unregistered, and whether held by a performer or a nonperformer—is sufficient to permit musical performances by groups under the Truth in Music Act.

Of course, this interpretation simply reaffirms the Lanham Act and defeats the very purposes for which the Truth in Music Act was created. Indeed, this interpretation renders the Truth in Music Act wholly redundant in light of the Lanham Act.

Nevertheless, that is the only constitutionally permissible way to treat the Truth in Music Act. In effect, the Truth in Music Act is legally irrelevant and should not be enforced by the attorneys general of the 33 states that have it on their books.

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