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UNITED STATES DISTRICT COURT
DISTRICT OF VERMONT

U.S. DISTRICT COURT
DISTRICT OF VERMONT
FILED

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PHISH, INC., a Delaware :
corporation, and WHO IS SHE? :
MUSIC, INC., a Delaware :
corporation, :
Plaintiffs :

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v.

Civil No. 1:01CV163

SEAN KNIGHT, aka WALDO, an :
individual and doing business :
as B-SHARP CLOTHING, :
GLIDE CLOTHING, KNIGHTHOOD :
CLOTHING, KNIGHTHOOD :
MERCHANDISE, PORCUPINE GRAPHIX, :
SURFIN' SAFARI, INC. and TRUE :
VIBES; KNIGHT-MACKLIN, INC., :
a Delaware corporation doing :
business as B-SHARP CLOTHING, :
GLIDE CLOTHING, KNIGHTHOOD :
CLOTHING, KNIGHTHOOD :
MERCHANDISE, PORCUPINE GRAPHIX, :
SURFIN' SAFARI, INC., and TRUE :
VIBES; AXIS ENTERPRISES, and :
JOANNE READER, an individual, :
Defendants :

RULING ON MOTION FOR PRELIMINARY INJUNCTION
(Paper 5)

Plaintiffs Phish, Inc. and Who Is She? Music, Inc.
(collectively referred to as "plaintiffs") manage and promote
the musical group "Phish." The defendants are two individuals
and their business entities which sell merchandise which they
maintain parody song titles and lyrics of several music
groups, including Phish. The plaintiffs allege, inter alia,

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that the T-shirts and other items which the defendants sell violate their rights under the Lanham Act and the Copyright Act. See Complaint (Paper 9) at para. 7. They seek a preliminary injunction barring the defendants from producing or selling their allegedly infringing items. For the reasons set forth below, the plaintiffs' Motion for Preliminary Injunction is GRANTED IN PART and DENIED IN PART.

I. Background

The record before the Court includes arguments presented at a July 24, 2001 hearing on plaintiffs' Motion for Preliminary Injunction; the parties' briefs; by agreement of the parties, the declarations of a number of witnesses; and other admissible documentary evidence and exhibits. Upon review of the present record, the Court finds the following relevant to the disposition of the plaintiffs' motion. See Fed. R. Civ. P. 65 (a) (2) ("[A]ny evidence received upon an application for preliminary injunction which would be admissible upon the trial on the merits becomes part of the record on the trial and need not be repeated upon the trial.").

The musical group Phish owns the two named plaintiffs, which promote the band and market its products. See Declaration of Kevin Shapiro (Paper 8) at para. 1. "PHISH" is

a registered trademark for "entertainment in the nature of a musical group," as well as for use as a logo on "Genuine Phish Merchandise" which includes bumper stickers, hats, T-shirts and other items. See Paper 8 at Exhibit A. The plaintiffs also hold a registered design mark for a fish comprised of the word "Phish" and registered copyrights to songs penned by members of the group. See, e.g., Paper 8 at para. 6 and Exhibit B.

According to the plaintiffs, Phish currently is one of the world's most popular touring bands and has performed worldwide before millions of fans. See Declaration of Amy Skelton (Paper 9) at para. 3. The plaintiffs explain:

The Phish Fan Base represents the customers and potential customers of Phish sound recordings, concerts, and Genuine Phish Merchandise bearing Phish's trademarks, logos, and trade names. To the Phish Fan Base, Phish songs and lyrics, the registered trademarks, and various unregistered song titles, marks, and logos are associated with Phish, identify Phish as the source, and thus have acquired secondary meaning among the Phish Fan Base. The song titles that would immediately invoke Phish in the minds of members of the Phish Fan Base and which are wholly original to Phish, include, but are not limited to, the following: *Bouncing Around the Room, Buried Alive, First Tube, Fluffhead, Free, Ghost, Glide, Gotta Jibboo, Gumbo, Guyute, Harpua, Harry Hood, Heavy Things, It's Ice, Llama, Meatstick, Mike's Song, Mound Piper, Possum, Rift, Run Like an Antelope, Sand, Sanity, Simple, Stash, Wilson, and You Enjoy Myself.*

Paper 9 at para. 3.

Defendants Sean Knight and Joanne Reader are business partners who have operated under a variety of corporate and trade names. Currently, they do business under the name "Knighthood Merchandise." See Declaration of Sean Knight (Paper 27) at para. 3. According to Mr. Knight,

The tee-shirts and other items sold by Knighthood Merchandise primarily parody or spoof song titles of various music groups such as Phish, The Grateful Dead, and Widespread Panic by placing them in humorous contexts and playing off the similarities to commercial advertisements for other products. Thus, by way of example, the "Glide" tee-shirt sold by defendants parodies an advertisement for Tide laundry detergent, the "Bouncin'" tee-shirt parodies an advertisement for Bounce fabric softener, and other tee-shirts parody other commercial products.

Paper 27 at para. 4; see Defendants' Hearing Exhibit A (describing items sold by Knighthood Merchandise as "referenc[ing] a word or words used by Phish in its song titles, a few reference short phrases from Phish lyrics, and all reference trademarks, logos and ideas in a humorous fashion unrelated to Phish"). The majority of items presently in the defendants' Knighthood Merchandise catalog relate to Phish. See Letter from Plaintiffs' Attorney (Paper 59) (catalog attached).

Therefore, the facts are undisputed in that the defendants acknowledge a partial source of their allegedly offending logos is Phish's song titles and lyrics. They have agreed to refrain from manufacturing and marketing one T-shirt

which contains a pictograph of the word "PHISH" made from antelopes. See Defendants' Supplemental Memorandum in Opposition to Application for Preliminary Injunction (Paper 58) at 2-3. However, they continue to assert the right to manufacture and sell the remainder of the items found in their Knighthood Merchandise catalog.

II. Discussion

A party seeking injunctive relief ordinarily must show: (a) it will suffer irreparable harm in the absence of an injunction; and (b) either (1) a likelihood of success on the merits, or (2) sufficiently serious questions going to the merits to make them a fair ground for litigation and a balance of hardships tipping decidedly in the movant's favor. See, e.g., Genesee Brewing Co., Inc. v. Stroh Brewing Co., 124 F.3d 137, 142 (2d Cir. 1997); Polymer Tech. Corp. v. Mimran, 37 F.3d 74, 77-78 (2d Cir. 1994); Jackson Dairy, Inc. v. H.P. Hood & Sons, Inc., 596 F.2d 70, 72 (2d Cir. 1979) (per curiam). The plaintiffs have based their request for injunctive relief on a demonstration of irreparable harm and a likelihood of success on the merits. See Plaintiffs' Memorandum in Support of Preliminary Injunction (Paper 6) at 8.

A. Irreparable Harm

A showing of irreparable harm is a prerequisite to the granting of an injunction. See, e.g., Grand Light & Supply Co., Inc. v. Honeywell, Inc., 80 F.R.D. 699, 702 (D. Conn. 1978). However, "[i]n the context of trademark and unfair competition injunctions, the requirement of irreparable harm carries no independent weight, as [the Second Circuit has] held that a showing of likelihood of confusion (a requirement of both trademark infringement and unfair competition claims) establishes irreparable harm." Genesee Brewing, 124 F.3d at 142. Therefore, an examination of the merits necessarily addresses the question of irreparable harm.

B. Likelihood of Success on the Merits

1. Lanham Act

Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), prohibits a manufacturer from using "in commerce any word, term, name, symbol, or device" or "any false designation of origin" that is "likely to cause confusion" as to the origin of the product. Section 43(a) protects registered trademarks, "may protect unregistered trademarks . . . , and even offers a degree of protection from unfair competition for 'unregistrable marks,' such as generic words that have

acquired significant secondary meaning." Genesee Brewing, 124 F.3d at 142.

"Titles of works of artistic expression, including films plays, books, and songs, that have acquired secondary meaning are protected from unfair competition under § 43(a)." EMI Catalogue Partnership v. Hill, Holliday, Connors, Cosmopolos, Inc., 228 F.3d 56, 63 (2d Cir. 2000). However, the Lanham Act does not protect the "corpus" of a creative work. As the Second Circuit recently explained:

Trademark law is concerned with protection of the symbols, elements or devices used to identify a product in the marketplace and to prevent confusion as to its source. It does not protect the content of a creative work of artistic expression as a trademark for itself. Copyright law protects the artist's right in an abstract design or other creative work. . . . The title of a song certainly may fulfill the source- or product-identifying function of a mark. However, the musical composition itself *is* the product. The score, or unique combination of notes, are the essence of a song, just as architecture combines different materials into a structure whose volume then creates a unique spatial relationship to the site it occupies. Intellectual property law protects the owners' rights in these unique combinations in distinct ways that lie outside the realm of trademark law. The different purposes of trademark and copyright law bear on the different rights each law creates.

Copyright law, not trademark law, is the primary vehicle for protecting the rights of a song's composer or her successor in interest in the musical composition.

EMI, 228 F.3d at 63 (citations omitted) (emphasis in original).

The defendants already have agreed to stop producing items which arguably contain the plaintiffs' registered mark "PHISH." As to the titles and lyric excerpts of Phish's songs, the plaintiffs have presented insufficient evidence that they are entitled to protection under trademark law because those titles and lyrics have acquired a "secondary meaning."

"The secondary meaning requirement exists to insure that something worth protecting exists—an association that has developed in the purchasing public's mind between a distinctive trade dress and its producer—before trademark law applies to limit the freedom of a competitor to compete by copying." Laureyssens v. Idea Group, Inc., 964 F.2d 131, 138 (2d Cir. 1992). Resolution of the question of secondary meaning requires examination several factors, including: (a) advertising expenditures, (b) consumer studies, (c) sales success, (d) unsolicited media coverage of the work, (e) attempts to plagiarize the mark, (f) length and exclusivity of the mark's use, and (g) evidence of actual confusion. Heirs of Estate of Jenkins v. Paramount Pictures Corp., 90 F. Supp. 2d 706, 713 (E.D. Va. 2000), aff'd mem., 248 F.3d 1134 (4th Cir. 2001).

Most of the titles and lyrics at issue consist of common words or phrases. This is not surprising since, as one court has observed, "titles, by their very nature, are . . .

inherently descriptive or, in some instances, generic. . . . " and therefore entitled to lesser trademark protections. See Estate of Jenkins, 90 F. Supp. 2d at 711. Other than the plaintiffs' conclusory assertion that Phish fans associate the titles and lyrics at issue with the group, the current record contains scant evidence on the other factors which the Court must consider before subscribing secondary meaning to otherwise mostly ordinary groups of words on defendants' T-shirts. "The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the source of those goods." 20th Century Wear, Inc. v. Sanmark-Stardust, Inc., 815 F.2d 8, 10 (2d Cir. 1987) (citation and quotations omitted). At this time, the Court is unable to conclude that any of the songs or lyrics at issue have acquired a secondary meaning in the public mind sufficient to automatically signal the plaintiffs as the source of defendants' goods.

Furthermore, to demonstrate entitlement to an injunction, the plaintiffs must show that the defendants' use of these titles and lyrics is likely to cause confusion. See, e.g., Genesee Brewing, 124 F.3d at 142; Warner Bros., Inc. v. Gay Toys, Inc., 658 F.2d 76, 79 (2d Cir. 1981). As with the issue of secondary meaning, analyzing the likelihood of confusion in a trademark case is a fact-specific inquiry which requires examination of many factors, including:

- (1) the strength of plaintiff's mark;
- (2) the similarity of the parties' marks;
- (3) the proximity of the parties' products in the marketplace;
- (4) the likelihood that the prior user will bridge the gap between the products;
- (5) actual confusion;
- (6) the defendant's good or bad faith in adopting the mark; and
- (7) the sophistication of the relevant consumer group.

Charles Atlas, Ltd. v. DC Comics, Inc., 112 F. Supp. 2d 330, 339 (S.D.N.Y. 2000) (citing Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492, 495 (2d Cir. 1961)).

Again, a cursory examination of the Polaroid factors indicates the inadequacy of the current record. With the exception of the defendants' stylized logo of the word "PHISH" using antelope figures, the remainder of the defendants' designs bears little or no resemblance to logos or drawings on plaintiffs' "Genuine Phish Merchandise." Compare Declaration of Alan Donnelly (Paper 7) at Exhibit E (defendants' merchandise on-line) with Paper 9 at Exhibit A (plaintiff's merchandise on-line). Furthermore, since the defendants' items incorporate logos from consumer products such as laundry detergent, it seems unlikely that fans would believe that the plaintiffs were the source of such material. Moreover, at the

hearing the defendants indicated that often their items are sold outside concert venues while the plaintiffs' "official" merchandise is sold inside, thereby suggesting a type of marketplace separation.

Plaintiffs claim some fans are confused as to the origin of the defendants' T-shirts. Having viewed the parties' exhibits, the Court believes it is just as likely that many Phish fans are sophisticated enough to understand the difference between plaintiffs' items, which clearly display an official, registered "Phish" logo, and the defendants' items, which uniformly and prominently incorporate artwork associated with other, non-Phish products. In any event, "although the plaintiff has introduced some evidence of actual confusion, such evidence is anecdotal at best, and does not purport to constitute any kind of systematic survey." Charles Atlas, 112 F. Supp. 2d at 340. In short, the current record provides a poor basis for conducting the necessary evaluations, and the Court is unwilling to issue a broad injunction which could put the defendants out of business pending final resolution of this suit.

2. Copyright Act

"Musical works fixed in any tangible medium of expression are protected by 17 U.S.C. § 102(a)." EMI, 228 F.3d at 63

(internal quotations omitted). "[T]o establish a claim for copyright infringement, a plaintiff must show ownership of a valid copyright and the defendant's infringement by unauthorized copying." Laureyssens, 964 F.2d at 139.

The defendants maintain their uses of plaintiffs' song titles and lyrics is authorized because they constitute parody. "[P]arody is a form of artistic expression, protected by the First Amendment." Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc., 886 F.2d 490, 493 (2d Cir. 1989); see also 17 U.S.C. § 107 (providing "fair use" defense under Copyright Act). Therefore, as with cases under the Lanham Act, "it is appropriate to weigh the public interest in free expression against the public interest in avoiding consumer confusion." 886 F.2d at 494.

The Second Circuit "ha[s] accorded considerable leeway to parodists whose expressive works aim their parodic commentary at a trademark or trademarked product . . . but have not hesitated to prevent a manufacturer from using an alleged parody of a competitor's mark to sell a competing product" Harley-Davidson Inc. v. Grottanelli, 164 F.3d 806, 812 (2d Cir. 1999) (citations omitted). As the Supreme Court has noted, however, the parody defense can be difficult to apply because "[p]arody's humor, or in any event its comment, necessarily springs from recognizable allusion to its object

through distorted imitation." Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 588 (1994). Accordingly,

[t]he threshold question when fair use is raised in defense of parody is whether a parodic character may reasonably be perceived. . . . Whether, going beyond that, parody is in good taste or bad does not and should not matter to fair use.

Id. at 582 (footnote omitted).

Here, the "parodic character" of most of the products the plaintiffs find objectionable is obvious. For example, the defendants' combination of plaintiffs' song titles with rhyming logos from totally unrelated corporations or consumer products such as tractors, laundry detergent, or fabric softener, if not undertaken for comment, at the very least have been made for comic effect. See Campbell, 510 U.S. at 580 (listing accepted definitions of "parody"). For example, even the distinctive Phish work "Jiboo" is reminiscent of the word "Yahoo," thereby making the logo "Do You Jiboo" an easily recognizable spoof of the corporate logo "Do You Yahoo?". The defendants have provided sufficient preliminary support for their contention that their logos are protected parodies, thereby making injunctive relief inappropriate.

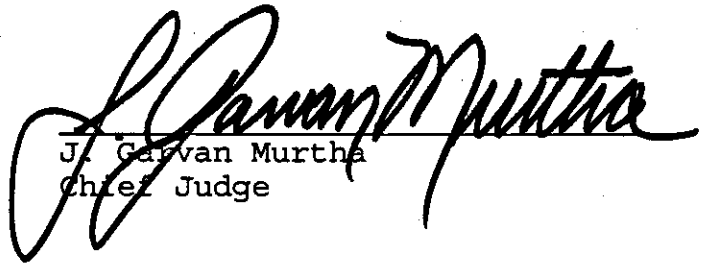
Conclusion

The plaintiffs' Motion for Preliminary Injunction is GRANTED IN PART and DENIED IN PART. As they previously have

agreed, the defendants are hereby enjoined from selling any product with the "PHISH" logo on it. In all remaining respects, the plaintiffs' request for preliminary injunctive relief is denied.

SO ORDERED.

Dated at Brattleboro, Vermont, this 15TH day of August, 2001.


J. Garvan Murtha
Chief Judge