

# E&S

The Tennessee Bar Association's newsletter for the  
Entertainment & Sports Law Section  
November 2008 · Volume 1 · No. 1



## No Respect for the Dead?

### The Changing State of Deceased Celebrities' Publicity Rights

By Dave Green

Joe DiMaggio and Marilyn Monroe, one of the twentieth century's most iconic married couples, both earned enormous income during their life and well after their death for advertising uses and merchandise. So why have courts recently declined to protect Monroe's rights of publicity while DiMaggio's continue to be protected? The difference rests not merely on when these celebrities died, but in what state they claimed to permanently reside. Following recent court losses for the estates of stars like Monroe and Jimi Hendrix, several states have rushed to fix their publicity-rights statutes to avoid such inconsistent results, while others are reconsidering their current lack of protection not just for older icons but for recently departed stars such as Heath Ledger.

*continued on page 10*

## Letter from the Editor

By Stacey Middleton

When Sarah Palin was pronounced the vice-presidential nominee for the Republican party, a strange thing happened: The word “vetting” instantly became a part of our 21st Century vernacular. It was as if the word had taken up residence like an uninvited house guest. Not being much of a political wonk myself, I scrambled to Merriam-Webster to look up the definition to this word that everyone else seemed to have in the back pocket of their vocabulary. Vetting is defined as “evaluating for possible approval or acceptance.” Critics said that Palin should have been vetted because of her youth and inexperience in the national arena. Critics on the other side said the same about Barack Obama.

About the same time, I had a more personal introduction to the word “vetting” when, at a recent meeting I attended, a respected veteran of the Tennessee Entertainment Bar bemoaned the entry of unproven, inexperienced lawyers into the practice of entertainment law. “These people should be vetted for their experience and knowledge of entertainment law,” he proclaimed. My mind raced back to my third year of law school when I trudged up and down Music Row hoping an entertainment firm would give me a chance. I suppose I have been vetted more than once in my lifetime and never realized it!

Now, I agree that there are some folks out there in our practice worthy of the industry eye-roll: those who use the term “country and western,” those who suggest getting Patsy Cline to duet on their artist’s new record, or those who think that ASCAP is a prosthetic device. But I also think that there is very little information out there for the beginning entertainment lawyer who is

serious about making a go of it in Tennessee.

This year, the Entertainment and Sports Section Newsletter will speak to both the seasoned veteran and the young rookie. We will report on leading case law, developments in legislation and member updates in the industry. We will also speak to persons in the entertainment and sports industry to provide you with information about exactly what they do.

This quarter, we discuss rights of publicity in Dave Green’s article “No Respect for the Dead.” Susan McDonald, esteemed researcher and writer, provides an analysis of the recent Doors case in her article “Closing the Doors on Band-Name Use.” We speak with Scott Siman, president and CEO of RPM Management, who is the manager to Tim McGraw and Julianne Hough. We spotlight the Tennessee Volunteer Lawyers for the Arts to find out about volunteer and charitable opportunities for attorneys. We look forward to being your local source of information, no matter what your level of experience.

By the time this newsletter goes to print, one of the candidates on the presidential ticket who was put on the defensive for his or her youth and inexperience will have been given a chance to prove him/herself. I hope that all of us in the Entertainment and Sports Bar will give a chance to the beginners who are students of the practice of entertainment and sports law and leave the vetting process to the clients that hire us. **E&S**

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## Letter from the Chair

By Amy J. Everhart

I'd heard about Tennessee Volunteer Lawyers for the Arts — TNVLA — for some time, but I didn't know exactly what it was. I thought maybe it threw those art-awareness nights at art museums, where they serve Ritz crackers and salmon dip and plastic Dixie cups filled with Chardonnay. It wasn't until I got a call from a songwriter I wasn't able to represent that someone told me to call TNVLA. What is this TNVLA? I wondered, now really needing to know. So I called the organization to find out.

A nice gentleman there explained that TNVLA is a non-profit organization that provides free legal assistance and education to low-income artists of all disciplines and emerging nonprofit arts organizations located in the greater Nashville area. "Is it limited to fine artists, I mean, watercolorists and sculptor types?" I asked, not having bothered to check out the website before calling, which, if I had, would have revealed TNVLA's logo with a microphone, a film projector, a guitar, a copyright notice and a splatter of paint.

"No," he clarified patiently, likely wondering how I'd ever graduated from law school. He explained that, although watercolorists and sculptors are included, TNVLA assists artists of all types (including songwriters) on arts-related legal issues (for example, a songwriter with a royalty dispute). And, by the way, attorneys can sign up to donate legal services.

I promised I'd sign up to volunteer ASAP. Meanwhile, TNVLA was able to help my new songwriter friend. But other things came up in my life, as they tend to do and I didn't get around to signing up.

Months later, I sat at the swearing-in ceremony for TBA President Buck Lewis and listened to him describe the TBA's "4 ALL" campaign to build access to justice. He encouraged each of the TBA section chairs (gulp, that includes me) to find a way to build access to justice through our respective sections.

How can a bunch of entertainment lawyers help? I wondered. And then I thought back to my promise of

a few months before. Of course — why not see how we can assist TNVLA?

So our section established a committee to do just that and committee chair Chris Vlahos and I met with TNVLA Executive Director Casey Gill Summar and Board Chairman Bo Spessard. If I needed more convincing of how worthy an organization TNVLA is, meeting Casey and Bo clinched it for me. The two are smart and enthusiastic, vibrant and passionate about their cause, those tireless types that make you feel guilty for going home afterward and watching TV. The four of us left that day excited about working together to promote this very worthy organization. Chris and I promised we'd sign up to volunteer ASAP.

I look forward to sharing with you opportunities to assist TNVLA in the months to come. In the meantime, I know you're wondering how you can help right now. The thing is, I still haven't signed up to volunteer. What better time than the present for you and me? Let's do it together. Right now, I'm opening TNVLA's website, [tnvla.org](http://www.tnvla.org). Now I'm clicking on the "volunteer" section. And now I'm filling out the volunteer form. Contact info, a description of my areas of expertise (watercolor law, lying on the couch watching TV) and "Submit." How easy was that?

For more information on TNVLA, check out the Spotlight in this issue. And if you haven't already had the pleasure of meeting her, come out and meet Casey Gill Summar at our annual CLE on December 4, where she'll host a question-and-answer session.

And now, I will turn off the TV and find something worthy to do with my time. (Just after this episode of *The Office* ...) **E&S**

AMY J. EVERHART is an **associate (?)** at Riley Warnock & Jacobson PLC. She focuses her practice on commercial litigation, entertainment, copyright, trademark and other intellectual property matters.



## Closing The “Doors” On Band-Name Use: Recent Decision Clarifies Band-Member Rights

By Susan McDonald

Last month the California Supreme Court refused to consider an appeal of the decision in *Densmore v. Manzarek*, ending five years of litigation among members (and heirs of members) of the 1970’s group The Doors. See *Densmore v. Manzarek*, 2008 Cal. App. Unpub. LEXIS 4367 (2008). John Densmore, a member of the original Doors, filed suit when the other surviving Doors performed as “The Doors” in 2003. *Densmore* asserted six causes of action, claiming that the defendants had breached the group’s contract and engaged in unfair competition and false and deceptive conduct. The trial court permanently enjoined the defendants from holding themselves out as The Doors and ordered them to pay more than \$3,000,000 to a partnership of the original members of The Doors.

The California Court of Appeals affirmed the trial court. The opinion, however, is lengthy and confusing because it addresses the differences between equitable and legal claims and confusion about the issues that were presented to the jury. Nonetheless, the litigation highlights some of the pitfalls and uncertainties in representing bands.

An agreement among band members is usually drafted when the members are friendly and expect to be friendly for many years. Yet the agreement must anticipate management and control of the band’s business for years in the future. Any lawyer who has represented musical groups knows that the relationship will not always remain amicable. When disagreements arise and band members want to use the band’s name for different purposes, they will look to the agreement for resolution. *Densmore*, however, demonstrates that, even with an agreement, litigation may be necessary to resolve disputes among band members.

Until recently, litigation among band members was necessarily based only on generic laws prohibiting false and misleading advertising. A more specific remedy is now available. Tennessee and more than twenty-five other states, have recently enacted some form of the Truth in Music Act. See *Tenn. Code Ann.* §§ 47-18-5302 through -5304. Championed by Bowzer himself (a/k/a Jon Bauman of Sha Na Na), the Truth in Music Act penalizes people who falsely represent that a live performance in Tennessee has an affiliation with another group. There are some exceptions to exclude people who have a legal right to use the group’s name and events that are specifically advertised as tributes to another group. See *id.* Tennessee’s version of the Truth in Music Act is arguably broad enough to reach not only the performing group that wrongfully uses the name of a recording group but also venues that advertise the performance. Additionally, the law does not appear

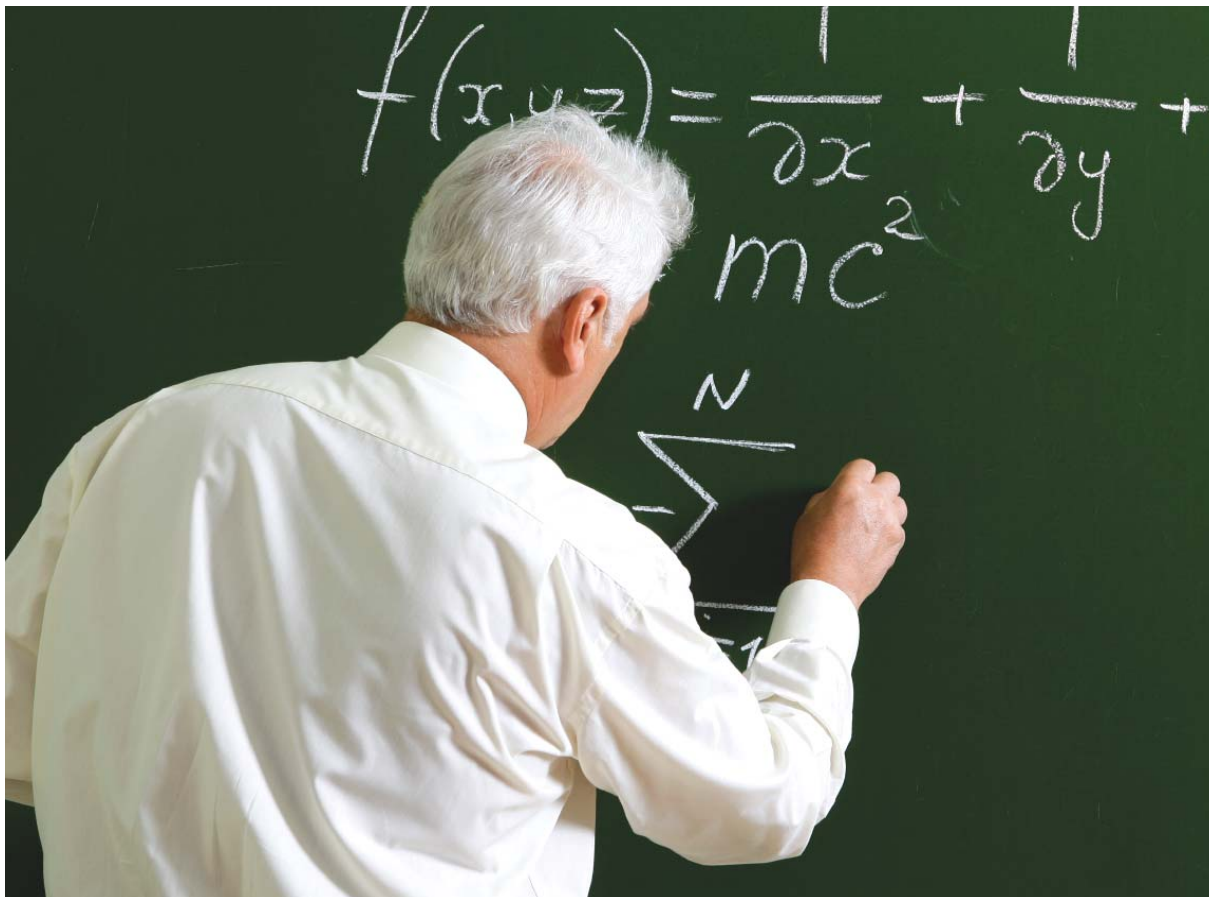


to require intent to mislead so the unknowing use of another band’s name arguably could constitute a violation.

A violation of the Act constitutes a violation of the Tennessee Consumer Protection Act and gives rise to a claim for civil damages, as well as costs and attorney’s fees. See *Tenn. Code Ann.* § 47-18-5304 and 47-18-109. The Truth in Music Act also authorizes the division of consumer affairs to impose penalties of \$5,000 to \$15,000 for each wrongful performance. *Id.*

*Densmore* teaches that every band should probably have an agreement to guide its business, particularly regarding the use of the band’s name and/or trademark by individual members, the departure of a member and matters that arise after the dissolution of the band. Even without such an agreement, the Truth in Music Act imposes significant liability on musical groups and entertainment venues for wrongful use of a band’s name. So musical groups should obtain legal advice regarding the use of their names and musical groups and venues should obtain legal advice regarding advertising live performances. **E&S**

SUSAN MCDONALD maintains a solo law practice in Nashville and frequently teaches CLE classes in legal research and writing.



TennBarU and the TBA Entertainment and Sports Law Section present ...

## Entertainment & Sports Law: Back to Class

Head “back to class” for an afternoon of entertainment-law staples, including WRITING (tips on legal writing from a veteran songwriter), MATH (a refresher on the “math” of entertainment deals), CURRENT EVENTS (a debate on the latest issues in entertainment law) and Ps and Qs (ethical considerations: the entertainment lawyer’s many hats).

Come out and hear veteran songwriter Don Schlitz give some legal writing tips. Schlitz’s first recorded song, “The Gambler,” won a Grammy and the Country Music Association’s and the Academy of Country Music’s Song of the Year. Since then he has won two Grammys, three CMA awards and was the ASCAP Country Songwriter of the Year for four consecutive years from 1988 – 91. He was inducted into the Nashville Songwriters Association’s Hall of Fame in 1993. In 2007, Schlitz was presented the ASCAP Creative Achievement Award.

### THE BASICS

**Producer:** Amy Everhart

**Speakers:** Tim Warnock, Mike Vaden, Stacey Middleton, Beverly Keel, Austin Adams, Don Schlitz

**Credit:** 3 general, 1 E&P

**Registration:** 12:30 p.m. – 1 p.m.

**Program:** 1 p.m. – 5:30 p.m.

**Date:** December 4

**Location:** Nashville, Belmont University Curb Event Center, Vince Gill Room, 2002 Belmont Blvd.

### COURSE REGISTRATION

(UP TO FIVE DAYS PRIOR TO PROGRAM)

**\$175** Section Members

**\$195** TBA Members

**\$275** Nonmembers

**FREE** for TBA-member judges, law makers and law students

**SAVE MONEY:** Use the prepaid CLE credits that come with your TBA Complete Membership. Not a TBA member? Visit [https://www.tba2.org/members/join\\_bar.php](https://www.tba2.org/members/join_bar.php) and join now to start saving.

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## The Entertainment Lawyer and the Artist Manager

By Kendra Tidwell

I had an opportunity to discuss with Scott Siman, the manager of one of country music's biggest superstars, the interplay and overlap between manager and entertainment lawyer and how the beauty of this relationship is magnified when one has had the privilege of being both.

Scott Siman grew up around music. His father, country music pioneer Si Siman, produced "The Ozark Jubilee" on ABC, the first country music program for network television. With country music coursing through his veins, Siman set off for college in the country music metropolis, where he attended Vanderbilt University for undergrad, then returned home to attend law school at the University of Missouri.

Siman skipped the big-firm lifestyle and went straight into the private practice of entertainment law with a couple of solo practitioners upon graduation. Although both of his mentors had business practices and dealt only with the transactional aspects of entertainment law, Siman dove head-first into litigation, maintaining a successful practice, which, unlike many entertainment lawyers, comprised both the transactional and litigation branches of his specialty.

After having his fill of private practice, Siman moved to Sony Music. There he served as Senior Vice President for three years before landing Tim McGraw as his first management client. When asked about his start in management, Siman responded modestly: "Tim was at a crossroads. I think I'm his seventh manager."

As an artist manager, Siman wears many hats, but he was quick to tell me, "I don't handle money — the business manager does that." That being said, the artist manager is critical to the "big picture" of the artist's career and he is charged with the responsibility of facilitating all the other role players who comprise the artist's team — the business manager, the booking agent and the entertainment lawyer.

Siman describes the transition from entertainment lawyer to manager as going from "being a team member to being the team leader." Where the lawyer

is not necessarily involved at every turn in every decision related to the artist's career, the manager, for the most part, is, or ideally, should be. "The manager is the coach, the artist the star quarterback."

Where many managers in country music are comfortable relying on the handshake as the preferred method of consummating a transaction, Siman's background as a lawyer rears its head as he unfailingly creates a paper trail of e-mails, letters of intent and memoranda to correspond with the underlying transaction. His knowledge of the law comes into play every day, whether he is negotiating deals, reviewing contracts or spotting potential legal issues when assessing the putative implications of his client's next move.

Siman was quick to tell me, however: "I do not replace the lawyer in this equation; I just expedite things." As Siman attested, "There are lots of great music lawyers in Nashville," so Siman's job is to ensure his client engages counsel that is a good fit with the client's personality. Siman leaves negotiations with opposing counsel and drafting and finalizing contracts to the

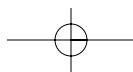
lawyer, focusing on the global vision for the artist's career and day-to-day matters.

All of this talk about lawyers with the former-practicing-attorney-turned-manager led me to ask the obvious question: "With your hand in pretty much every aspect of the artist's career and the necessity of your presence during key decision-making, what about attorney-client privilege issues?" "My background helps me spot the potential for those issues up front; I drop out of sight for those communications, where the maintenance of the privilege is important," Siman said.

Siman offers a word to the wise (or not-so-wise in the case of the ambitious young would-be entertainment lawyer): "This is a really tough, intensely competitive market. Become the best basic skills lawyer ... eventually, it'll pay off when you make it in the business." **E&S**

"This is a really tough, intensely competitive market. Become the best basic skills lawyer ... eventually, it'll pay off when you make it in the business."

— Scott Siman



# Spotlight: Tennessee Volunteer Lawyers for the Arts

By Kenneth J. Sanney

The Tennessee Volunteer Lawyers for the Arts is celebrating its two-year anniversary. Since September 2006, the arts communities of Nashville and the surrounding area have been bolstered by local attorney Casey Gill Summar, her staff of law-student and attorney volunteers and the donations and support of the local community.

I recently had the pleasure of sitting down with Casey and discussing the exciting services and programs TNVLA provides the local arts community. We also discussed the opportunities her organization provides the members of the legal profession.

The TNVLA markets itself as “a nonprofit organization that provides free legal assistance and education to qualified low-income artists of all disciplines and emerging nonprofit arts organizations located in the greater Nashville area.”<sup>1</sup> So the first question I posed to Casey was, “What kind of artist does TNVLA work with?” According to Casey, “one of the TNVLA’s strengths is that we serve *all* the arts. We are not just focused on music; we also work with visual artists, theater and performers, dancers ... all across the board. And so we’re able to have broad support from the whole arts community.”

Casey outlined the two interrelated services the TNVLA provides to this broad community. First, the organization screens potential clients to see if they meet the requirements for pro bono services. If so, the TNVLA refers the qualified clients to one of more than 115 volunteer lawyers or to Vanderbilt Law School’s Intellectual Property and the Arts Clinic. Second, the TNVLA holds workshops and seminars to educate local arts community members on their legal rights and duties as they relate to the visual, performing and other arts.

Through these services, the TNVLA provides

members of our profession with great opportunities. For those of you desirous of pro bono cases but not wanting to venture into the areas of domestic or criminal-defense law, where most pro bono opportunities are found, the TNVLA provides a conduit for such service-related work in your own field of expertise. The TNVLA has a thorough screening process to make sure that those receiving your pro bono services are truly in need and have an arts-related issue or problem. You are then contacted by the TNVLA before the referral is made. Casey assured me that “you will never be obligated to take on a client or to litigate their case, although many of our volunteers do.”

Pro bono work, while at the core of TNVLA’s mission, is not the only opportunity the organization provides for attorneys. Other opportunities include attending and teaching one of their outstanding CLE offerings. According to Casey, “such offerings in the past have included songwriter contracts, copyright law updates and employment law for arts organization — but our volunteers are more than welcome to design a CLE to teach.” Finally, you may also become a member of TNVLA or provide financial support through direct giving.

Two years down, many exciting years ahead. Congratulations to Casey, the TNVLA and all your volunteers and supporters. **E&S**

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KENNETH J. SANNEY is an **associate (?)** at Day & Blair P.C. He specializes in copyright, trademark and entertainment law and litigation.

## NOTES

1. <http://www.tnvla.org/>

“helping the arts community to thrive  
and the legal community to serve.”



- home
- legal
- programs
- resources ▶
- publications
- calendar
- membership
- volunteer
- news
- support
- contact

## educational programs

TNVLA educates artists and arts organizations about their legal rights and responsibilities with our seminar programs, free clinic appointments and resource library.

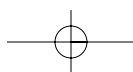
**Seminars:**

TNVLA conducts several seminars each month on various art law and business matters, often in partnership with other nonprofit organizations or the Vanderbilt University Law School Community and Economic Development Clinic. To see the current schedule of upcoming seminars, please visit our Calendar. Have an idea for a topic you don't see below? Email your suggestion to us at [info@tnvla.org](mailto:info@tnvla.org).

**Past seminars:**

- Contract basics for different genres (songwriters, visual artists, Photographers, filmmakers, etc.) and arts organizations
- Copyright fundamentals for different genres
- Employment law for arts organizations
- Gallery Relationships

p. (615) 298-9309 f. (615) 298-9353 e. [info@tnvla.org](mailto:info@tnvla.org)



## Litigation Update

By Cassie Madden

**COPYRIGHT FEES:** *Virgin Records America Inc. v. Thompson*, 512 F.3d 724 (5th Cir 2008). Despite the rule of awarding fees to the prevailing party in a copyright case, the court denied Defendant's claim for fees, swayed by the facts that the suit was neither frivolous nor objectively unreasonable, not prosecuted with malevolent intent and dismissed immediately upon confirming the Defendant's daughter was the actual infringer.

**PUNITIVE DAMAGES:** *Viacom v. YouTube*, 540 F. Supp. 2d 461 (S.D.N.Y. 2008). The court refused to allow Plaintiff to amend its copyright infringement claim against YouTube to seek punitive damages because the protection given to copyright is wholly statutory and the Copyright Act makes no provision for punitive damages.

**DIGITAL MEDIA:** *Allman v. Sony BMG Music Entertainment*, 2008 U.S. Dist. LEXIS 47612 (S.D.N.Y. 2008). The court dismissed a breach-of-contract class-action suit by recording artists seeking a higher royalty rate for the licensing of their recordings for digital uses, such as downloads and ringtones, by finding that such uses fell within the definition of "phonograph records" and constituted "normal retail channels."

*Atlantic Recording Co v. Howell*, 554 F. Supp. 2d 976 (D. Ariz. 2008) The court held that placing a copyrighted work in a shared folder on KaZaA does not subject the user to liability as a primary infringer because the phrase "offering to distribute" in the definition of "publication" in §101 of the Copyright Act does not amount to a "distribution" under §106(3) of the Act. Instead, "a distribution must involve a 'sale or other transfer of ownership' or a 'rental, lease, or lending' of a copy of the work."

**FIRST AMENDMENT:** *The Romantics v. Activision Publishing Inc.*, 532 F. Supp. 2d 884 (E.D. Mich. 2008). The Romantics sued the distributor of the video game *Guitar Hero Encore: Rocks the 80s*, which contained the band's hit "What I Like About You," alleging violations of the right to publicity and false endorsement under the Lanham Act. The court granted Defendant's motion for summary judgment, finding that the game is an expressive artistic work entitled to First Amendment protection and does not use the song in a way that misleads the public as to its source. The court also held that the right-of-publicity claim is preempted by the Copyright Act because Plaintiff's claim is based on Plaintiff's sound as embodied in a sound recording.

**FEDERAL PRE-EMPTION:** *Brainard v. Vassar*, 561 F. Supp. 2d 922 (M.D. Tenn. 2008). Plaintiff's claims were not saved from federal copyright pre-emption by the inclusion of claims for the breach of an implied promise to pay for the use of Plaintiff's song and to credit Plaintiff as creator of the song.

**TRADEMARK LICENSE:** *Intersport Inc. v. National Collegiate Athletic Association*, 381 Ill. App. 3d 312 (Ill. App. Ct. 1st Dist. 2008). The court found that a license obtained in 1995 to use the trademark "March Madness" to "advertise, promote and sell publications, videos and media broadcasts" included the right to deliver on-demand video content to mobile wireless devices because such dissemination was foreseeable and the license did not specifically exclude later-developed technology. **E&S**

CASSIE MADDEN is an associate at Riley Warnock & Jacobson PLC. She focuses her practice on commercial litigation.

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## Entertainment and Sports Law Section Establishes Mentoring Program

The Entertainment and Sports Law Section of the Tennessee Bar Association announces the institution of a new mentoring program. This program will be devised to provide support to attorneys seeking to enter into, or further develop their practice within, the entertainment and sports industries by pairing them with seasoned industry attorneys.

As with any mentoring program, the pairing of two professionals within a given field tends to create opportunity for reflection, action and learning. Through this one-on-one relationship, mentors and mentees alike will gain professional insight and likely come closer to reaching their career goals. On a larger scale, as the mentoring program grows, the practice of law within such industries will ideally be matured, enhanced and promoted through cooperative learning.

Our section will encourage those taking part in this program to appreciate that this relationship should be based on mutual trust, encouragement, respect, constructive feedback and willingness to both learn and share. There is no cost to take part in the program; however, mentees are required to be a member of the Entertainment and Sports Law Section of the Tennessee Bar Association. If you are interested in becoming a mentor or a mentee, please contact Sarah Hayman: shayman@tnbar.org, or Jefferson Wallace: Jefferson.wallace@comcast.net, for more information. **E&S**

## Legislation Update

By Heather Hubbard

With the current economic crisis and bail-out plan woes, you might think Congress has not had time to address other matters. In fact, two pieces of copyright legislation were actually passed during this same time.

On September 26, the Senate unanimously passed the **Prioritizing Resources and Organization for Intellectual Property Act**, which now closely resembles the House version that was passed in May. The House approved the new Senate version on September 28. Of significance, the PRO-IP Act increases penalties and forfeiture powers in copyright and trademark infringement cases. It also provides increased resources for the Justice Department to combat counterfeiting and piracy and establishes greater coordination among federal and state agencies, including an “IP Coordinator” at the White House. The bill was finally passed after a provision giving federal prosecutors the power to file civil actions against copyright infringers

— which President Bush indicated he would veto — was removed. President Bush signed the PRO-IP Act into law on October 13, 2008.

On September 29, the House unanimously approved the **Webcaster Settlement Act of 2008**. The Senate approved the bill the very next day. The March 2007 Copyright Royalty Board decision that set royalty rates for Internet radio streaming spurred this legislation. The Act allows Internet radio stations (DiMA) and copyright holders (SoundExchange) the ability to negotiate privately and execute a royalty-rate agreement by February 15, 2009, without the government interfering. It is yet to be seen whether a royalty-rate agreement will actually be reached between the parties. **E&S**

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HEATHER HUBBARD is an associate at Waller Lansden Dortch & Davis PLLC. She practices in the area of trial and appellate litigation and intellectual property law.

## Practice Pointers: The Independent-Creation Defense

By Robert Sullivan

The trial of a copyright infringement case presents unique challenges to attorneys on both sides. This series of articles will address issues that copyright litigators face in the preparation and presentation of their cases regarding infringement of a musical composition. One of the first defenses a copyright-infringement defendant should consider is that of “independent creation.”

To establish a claim for copyright infringement of a musical composition, the plaintiff must prove (1) ownership of the copyright to the composition and (2) copying of constituent elements of the plaintiff’s work that are original. Proof of copying is critical because even if the works are identical, there is no infringement if the defendant did not copy the plaintiff’s work.

Direct evidence of copying is normally absent and plaintiffs generally attempt to establish an inference of copying by showing that the defendant had access to the plaintiff’s work and a substantial similarity between the two works. If the plaintiff proves access and substantial similarity, the defendant may rebut the presumption of copying by demonstrating that the defendant created his work without copying the plaintiff, i.e. independent creation.

Independent creation is particularly important in cases involving popular music, where similarities are

more likely to arise due to the subject matter of the competing works. Independent creation invariably stands or falls on the credibility and persuasiveness of the testimony of the defendant songwriters. A writer’s direct examination should detail his professional experience and identify other well known songs written, awards and professional accomplishments. The defense should be prepared to explain in detail the circumstances surrounding the creation of the defendant’s composition, utilizing all supporting documentary evidence and third-party witnesses.

Counsel should obtain from the client and preserve all documentary and physical evidence relating to the creation of the defendant’s work. In the case of a musical composition this would include all notes, lyric sheets, calendar entries, “work” tapes and computer files that were generated as a part of the creative process. If any of the evidence is stored on a computer, the computer should be taken out of service and the hard drive backed up. **E&S**

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ROBERT SULLIVAN is a partner at Loeb & Loeb LLP. His practice focuses on entertainment transactions primarily in the music field, as well as litigation and mediation in entertainment and intellectual property areas.

## No Respect for the Dead? *(continued from page 1)*

During a celebrity's life, nearly every state protects the celebrity's name, image, likeness, voice and signature against unauthorized commercial use. These "rights of publicity" empower celebrities like George Clooney, whose name was recently used by an Italian clothing company as its brand for clothing and watches, to stop unauthorized uses and seize infringing goods. After death, states are far from consistent in how they continue to protect these rights. Some states, notably New York, provide no protection for deceased celebrities, while states like Indiana, California and Washington protect such rights from 70 to 100 years after death.[1]

Why the discrepancy? In part, states like New York historically treat these rights similar to privacy rights and privacy rights usually expire at death. The majority of states, which treat publicity rights like property, are more likely to find that this "property" continues to exist after a celebrity's death and descends to the celebrity's heirs or beneficiaries of a will or trust, similar to other intellectual property such as copyrights. While the "property rights" states differ in how long they protect this property, the estate still has some period of time to reap the rewards in licensing these rights for commercial use.

Time does not seem to diminish value of rights of publicity. Forbes, which publishes its yearly "Top Earning Deceased Celebrities," ranks long deceased icons such as Monroe, Tennessee's own Elvis Presley, Albert Einstein, Andy Warhol and even Dr. Seuss, who reportedly continue to earn more than five million dollars a year from licensing. While the money may go to wives, children, or other family members, proceeds earned by estates such as Einstein, Ray Charles and Warhol fund non-profit institutions supporting art, music and education.

After passage of several publicity rights laws during the mid-1980's and late 1990's, the law appeared to be fairly well established in the states protecting these rights. All of this changed in 2007, when a series of cases involving Marilyn Monroe began to raise questions about the rights of certain dead celebrities. In the first Marilyn Monroe decision, federal courts in New York and California both found that Monroe's beneficiaries, including her acting coach, Lee Strasberg, could not have inherited Monroe's publicity rights under the residuary clause of Monroe's will.[2] Because post-mortem publicity rights were not created under California's law until 1985, Monroe's will was incapable of giving them away at her death decades earlier. At best, Monroe's rights would be owned by intestate

heirs, if any existed in 1985 when the California law took effect.

The first Monroe opinion caused widespread confusion and concern, not just among celebrity estates but among merchandise manufacturers, studios and advertisers. Having paid significant fees to acquire these rights, sometimes exclusively, licensees were left to wonder if their licenses were now enforceable and whether they might be found liable if other heirs could lay claim to these rights.

Not surprisingly, California's legislature wasted little time in addressing these concerns and quickly passed an amendment in June 2007.[3] The amendment clarified that California's publicity rights were, in effect, retroactive, meaning that any will or trusts and any licenses that existed before the 1985 California law remained effective to transfer these rights. This amendment appeared to resolve the Monroe case, but the court was not yet done.

When it reconvened to interpret the legal impact of this new amendment, the court decided that New York law would determine whether Monroe had publicity rights to transfer upon her death.[4] Despite the fact that Monroe died in her California home while employed in California by a movie studio, the court found that her executor chose to declare New York as Monroe's domicile. This decision was originally made to avoid California's estate-tax burden, but unbeknownst to the executor, would later result in the court finding that Monroe's publicity rights died with her. Because New York does not protect these rights after death, the court declined to protect them in California, even though California's law afforded protection for seventy years after Monroe's death.

Another federal court in Washington State also applied the "domicile rule" in a case involving Jimi Hendrix.[5] Hendrix died in 1970 in London, but his estate was probated in New York where he had had a permanent residence. Leaving no will, Hendrix' estate descended to his sole heir and father, Al Hendrix, who placed all of the rights related to Jimi's legacy in several companies in Seattle. When Al passed away, he left control of the Hendrix family companies to other family members and nothing to Jimi's brother Leon, save one gold record. During several unsuccessful court challenges to Al Hendrix's will, Leon started the "Jimi Hendrix Foundation," promoting various activities in Washington. The Hendrix family companies sued, alleging violations of the Washington Personality Rights Act.

The trial court found that Jimi Hendrix had died a

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domiciliary of New York, which does not now recognize post mortem publicity rights. Because Washington had no specific choice-of-law clause in its Personality Rights Act (despite recognizing that rights existed in Washington for all persons who died within fifty years before the enactment of the Act), the court found the Hendrix family companies could not assert any rights in Jimi Hendrix's "personality rights" under the Washington Act. The Ninth Circuit Court of Appeals agreed, applying the same analysis to Washington law that the Court had earlier applied to California's law in a case involving Princess Diana.[6]

After the Hendrix decisions, another company starting marking "HENDRIX ELECTRIC VODKA." (The vodka company claimed, "It's like drinking with Jimi. The drunker you get, the more you think you're with him.") The court recently found the vodka company had infringed Hendrix's trademarks, including JIMI HENDRIX, HENDRIX and a stylized image of Jimi Hendrix.[7]

In April of this year, Washington's legislature quickly accepted the federal court's invitation to clarify whether Washington's statute was meant to apply to all celebrities, no matter where they were domiciled or whether their state of domicile protected those rights at their death.[8] The Washington legislature further clarified who is entitled to enforce the post mortem rights in Washington based on the earlier decided Marilyn Monroe decisions in California and New York. With this recent amendment, Washington joins Indiana in protecting the rights of all celebrities, regardless of their domicile and allows the beneficiaries of the deceased personality's estate to enforce these rights in Washington.

Despite these legislative changes and their clear intent to protect the rights of deceased celebrities, lawyers and legal commentators in other states remain perplexed over the impact of these recent court cases. Celebrities, celebrity estates and the Screen Actors Guild have renewed their attempts to erase doubts on the scope of protection for the departed. New York's legislature is considering a bill to protect the rights of deceased celebrities, a move that may gain additional support given recent public sentiment for newly deceased stars like Heath Ledger, who died in New York. Other New York living celebrities, who don't want to see their rights extinguished because they may choose to reside permanently in New York, are also beginning to weigh in. Unsurprisingly, traditional opponents, primarily New York's publishing industry, have chimed in to oppose such attempts.

The recent legislation in Washington and California may ultimately mean that advertisers and manufacturers will still need to obtain consent for commercial uses, now that broadcast, print and Internet ads reach nationwide and into states that pro-

tect deceased celebrities. Legislation introduced in several other states, including New Jersey and Connecticut, suggest a continuing trend towards a more uniform approach in protecting the rights of all deceased celebrities. Legal commentators have previously suggested that enacting a federal law would bring uniformity in the United States and place publicity rights on equal footing with other intellectual property such as copyrights and trademarks.

If those efforts are ultimately unsuccessful, advertisers and merchandise makers still need to pause before deciding whether to use a dead celebrity to hawk their goods. During the time the Monroe legislation was being introduced, advertisers for shoe maker Doc Martens ran several ads in the United Kingdom featuring dead rockers Kurt Cobain, Joey Ramone, Sid Vicious and Joe Strummer as angels in heaven wearing their "Doc's." UK laws do not generally protect against the unauthorized use of a deceased celebrity in advertising and Doc Martens did not seek consent from the celebrity's estates. Following enormous negative publicity, hostile reaction from fans and the celebrity's heirs and harsh public comments from Courtney Love, Doc Martens quickly pulled the ads, fired its ad agency and publicly apologized for the ads. The lesson? Where the laws can't or won't provide respect for these dead celebrities' rights, the fans will still come through. **ES**

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## NOTES

1. Tennessee provides protection to a decedent's estate for a period of ten years after death and such right will terminate by proof of the estate's non-use for two years following the ten-year period. *Tenn. Code Ann.* § 47-25-1104.

2. See *Milton H. Greene Archives Inc. v. CMG Worldwide Inc.*, Case No. CV 05-02200 MMM (MCx), Order May 14, 2007; and *Shaw Family Archives Ltd. v. CMG Worldwide Inc.*, 486 F. Supp. 2d 309 (S.D.N.Y. 2007).

3. *Cal. Civil Code* § 3344.1.

4. *Milton H. Greene Archives Inc. v. CMG Worldwide Inc.*, 2008 WL 655604 (C.D. Cal. Jan. 7, 2008); *Shaw Family Archives Ltd. v. CMG Worldwide Inc.*, 2008 WL 4127830 (S.D.N.Y. Sept. 2, 2008).

5. *Experience Hendrix LLC v. James Marshall Hendrix Foundation* 2005 WL 2922179 (W.D. Wash. Nov. 4, 2005).

6. *Experience Hendrix LLC v. James Marshall Hendrix Foundation* 240 Fed. Appx. 739 (9th Cir. 2007).

7. *Experience Hendrix LLC v. Electric Hendrix LLC*, 2008 WL 3243896 (W.D. Wash. Aug. 7, 2008).

8. Washington Personality Rights Act of 1998, House Bill Report, SHB 2727.



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