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I Am the Walrus.¹ – No. I Am!: Can Paul McCartney Transpose the Ubiquitous “Lennon/McCartney” Songwriting Credit to Read “McCartney/Lennon?” An Exploration of the Surviving Beatle’s Attempt to Re-Write Music Lore, as it Pertains to the Bundle of Intellectual Property Rights

1. See THE BEATLES, *I Am the Walrus*, on *MAGICAL MYSTERY TOUR* (Capitol Records 1987) (1967). Some of the history behind this song foreshadows the acrimonious songwriting credits dispute that is the focus of this Comment. Though credited to “Lennon/McCartney,” true authorship of this song is settled as belonging solely to Lennon. See WILLIAM J. DOWLDING, *BEATLESONGS* 198 (1989). Nevertheless, Lennon himself created a degree of controversy when in the song “Glass Onion,” another Lennon composition, he declared in lyric form that “[t]he walrus was Paul.” See *id.* at 224; see also THE BEATLES, *Glass Onion*, on *THE BEATLES (THE WHITE ALBUM)* (Capitol Records 1988) (1968). There is no indication that this lyric was to ever be taken as an attribution of authorship, but at least on a symbolic level it alludes to an incongruousness lurking beneath the tandem’s collaborative efforts. Lennon only added to this confusion when commenting on the unusual “Glass Onion” lyric: “It’s a very perverse way of saying to Paul, you know, ‘Here, have this crumb, this illusion, . . . this stroke, because I’m leaving.’” See DAVID SHEFF, *ALL WE ARE SAYING: THE LAST MAJOR INTERVIEW WITH JOHN LENNON AND YOKO ONO* 87-88 (G. Barry Golson ed., St. Martin’s Griffin 2000) (1981). But see JOHN LENNON, *God*, on *PLASTIC ONO BAND* (Capitol Records 2000) (1970) (lyric stating “I was the walrus, but now I’m John”). Perhaps the final word on the mystery of the walrus belongs to the actor Matthew Broderick, whose character Ferris Bueller once declared: “A person should not believe in an ‘ism,’ he should believe in himself. I quote John Lennon, ‘I don’t believe in Beatles, I just believe in me.’ . . . After all, *he was the walrus*. I could be the walrus – I’d still have to bum rides off of people.” See *FERRIS BUELLER’S DAY OFF* (Paramount Pictures 1986) (emphasis added).

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I. INTRODUCTION

Two mop-topped teens form a rock and roll band, and mutually agree to be equal partners in every song they write, regardless of their actual contributions to the song.² This allows the band members to free themselves creatively. Instead of bickering over money, and breaking down each song into percentages of input, they can simply focus on writing the best music possible. More importantly, the agreement serves an entirely different purpose. By banding together in such a manner, they believe that one day

2. See DOWLDING, *supra* note 1, at 297-98 (explaining the book's attempt at dividing each song of the Beatles into percentages of input, based on information gathered from numerous sources, countering the "Lennon/McCartney" credit used for all songs regardless of input). The Beatles were comprised of singer/songwriter/rhythm guitarist John Lennon, singer/songwriter/bass player Paul McCartney, lead guitarist George Harrison and drummer Ringo Starr (born Richard Starkey). See *id.* at 22. Based on the official songwriting credits, Harrison was the sole author of twenty-five songs, and Starr was the sole author of two songs. See Steve's Beatles Page, <http://stevesbeatles.com/songs/default.asp?sort=songwriter> (last visited Feb. 14, 2006) (outlining the official writing credits as they appear on albums). Meanwhile, Lennon and McCartney are credited as the joint authors of 169 songs. See *id.* Nevertheless, "the true author of most of the songs the Beatles recorded" is obscured. See DOWLDING, *supra* note 1, at 297. The majority of their works were not fifty-fifty collaborative efforts, as most songs were "written by one or the other, not both." See *id.* at 19. Determining true authorship as set forth in *Beatlesongs* is also aided by the knowledge that the true author of a Beatles composition generally served as the lead vocalist for that particular song. See *id.* at 297.

their names can achieve the same status as other famous two-name collaborators, such as “Gilbert & Sullivan” or “Rodgers & Hammerstein.”³ At the time it seems to be nothing more than a pipe dream, but as fate would have it, the two teens do not just write the best music possible, they arguably write the best music ever,⁴ and the value of the songs grows to somewhere in the billion dollar range, with no signs of depreciation.⁵ As part of this

3. See THE BEATLES, THE BEATLES ANTHOLOGY 94 (Brian Roylance et al. eds., 2000) [hereinafter ANTHOLOGY]. All indications are that the decision to use the two-name billing term was motivated more by marketing than convenience. McCartney states:

Crediting the songs jointly to Lennon and McCartney was a decision we made very early on, because we aspired to be Rodgers and Hammerstein. The only thing we knew about songwriting is that it was done by people like them, and Lerner and Loewe. We'd heard these names and associated songwriting with them, so the two-name combination sounded interesting.

Id. The statement by McCartney is significant, in that it establishes the true intent behind the “Lennon/McCartney” credit. Some have attributed Lennon with conceiving of the idea to mimic the two-name billing style of other collaborators. “[T]his came about because John Lennon liked the idea of ‘Lennon & McCartney’ echoing the songwriting credit of Leiber & Stoller; the songwriters whose names appeared on many of the records they owned from the 1950’s.” See Wikipedia Encyclopedia, http://en.wikipedia.org/wiki/Paul_McCartney (last visited Oct. 15, 2006). There is no known date for when this initial agreement was reached, but it appears to have been made shortly after their first meeting, which occurred on July 6, 1957, when McCartney was fifteen and Lennon was sixteen. See ANTHOLOGY *supra*, at 20; see also *id.* at 7, 17 (noting Lennon’s date of birth as October 9, 1940, and McCartney’s as June 18, 1942). Recalling their earliest collaborative efforts, prior to their receiving a recording contract, McCartney states: “We often wrote songs together. I wrote them down in an exercise book and above them it always said, ‘Another Lennon/McCartney original.’” Next page. “Another Lennon/McCartney original.” See *id.* at 23. Lennon adds: “We never talked in terms of finance. We were just a songwriting team, we started at sixteen and we decided that we’d call them ‘Lennon/McCartney,’ . . .” See *id.* at 98.

4. See Pat Blashill et al., *The 500 Greatest Albums of All Time*, ROLLING STONE, Dec. 11, 2003, at 83-178. The magazine polled 273 “rock & roll stars and authorities and asked them to pick their top fifty albums, in order of preference.” *Id.* at 38. Ten of the Beatles’ thirteen albums appeared on the list. See *id.* at 108. The album “Sgt. Pepper’s Lonely Hearts Club Band” was ranked first on the list of 500, followed by “Revolver” (#3), “Rubber Soul” (#5), “The Beatles (The White Album)” (#10), and “Abbey Road” (#14). *Id.* at 85-86, 88, 92, 94. The following year the magazine polled “fifty-five top musicians, historians, industry executives and critics, . . . to pick, in order of preference, the twenty artists they deemed to be the most significant and influential of rock’s first fifty years, those whose work continues to have an impact today.” Elvis Costello et al., *The Immortals*, ROLLING STONE, Apr. 15, 2004, at 61-142, 161. The vote resulted in the Beatles ranking first on the list of the top fifty artists named. *Id.* at 64.

5. Though it would be difficult to place a price tag on the value of Lennon and McCartney’s music, when totaling all sources of income, \$1 billion appears to be a fairly conservative estimate. In 1985, pop-star Michael Jackson purchased the publishing rights to the Beatles song catalogue for \$47.5 million. See PHILIP NORMAN, SHOUT! 494 (Fireside 2005) (1981). Over the next twenty years, the value of the songs grew to \$400 million. See Krysten Crawford, *Michael Jackson to Lose Beatles Catalogue?*, CNRMONEY.COM, June 8, 2005, http://money.cnn.com/2005/06/08/news/newsmakers/jackson_loan/index.htm?cnn=yes; see also Charles Duhigg, *Indebted Jackson to Sell Part of Music Catalogue*, L.A. TIMES, Apr. 14, 2006, at A1 (discussing Jackson’s sale of half his stake in the catalogue “which include[s] 251 Beatles songs” in order “[t]o avoid foreclosure on several loans”). This however only accounts for publishing, as the rights to the actual sound

agreement to merge their efforts, the musicians, John Lennon and Paul McCartney, ultimately decide that all songs written for their band The Beatles (“Beatles”) will be credited with Lennon’s name preceding McCartney’s,⁶ with the abbreviation “Lennon/McCartney” becoming the popular two-name billing term borne from that decision.⁷ In 1970, only

recordings, also of great value, are held by EMI’s Capitol Records. *Id.* The cost of licensing the song “Hey Jude” to record an original version for use in a motion picture, without purchasing the rights to use the original sound recording, costs an estimated \$500,000. See Robert W. Welkos, *You Say You Want a Revolution Studios Film?*, L.A. TIMES, June 11, 2005, at E22. It would be equally difficult to calculate how much revenue the Beatles have generated to date. “According to the Recording Industry Association of America, the Beatles are, by far, the best selling artists in history, with 168.5 million albums sold. Elvis Presley is No. 2, with 116.5 million albums sold.” Paul R. La Monica, *Hey iTunes, Don’t Make It Bad . . .*, CNNMONEY.COM, Sep. 7, 2005, <http://money.cnn.com/2005/09/07/technology/personaltech/beatles/>.

6. When the songwriting credits controversy discussed in this Comment arose, McCartney issued a lengthy press release addressing the issue. An excerpt of McCartney’s statement reads as follows:

At the very beginning, the first time this ever came up was at a meeting at [Beatles manager] Brian Epstein’s office in Albemarle Street in London between Brian, John and myself. I arrived at the meeting to find that Brian and John had already independently decided that the billing would be “songs by John Lennon and Paul McCartney”. I said, “What about McCartney/Lennon?” They said, “We’ll do this for now and we can change it around to be fair at any point in the future.” Being reassured by this I let the matter go and our songs became known as Lennon/McCartney songs, a fact I was perfectly happy about.

Nicole Lampert, *Try to See it My Way, Pleads Paul; It’s Time to Set the Record Straight About Our Hits*, DAILY MAIL (London), Dec. 19, 2002, at 7. The date of the “meeting” McCartney refers to in his statement is likely to have taken place sometime around, or shortly after May of 1963, soon after the release of their first album “Please Please Me,” where the billing credit last appeared as “McCartney/Lennon.” See THE BEATLES, PLEASE PLEASE ME (Capitol Records 1987) (1963). McCartney has stated in interviews that he believes it was on a trip to Spain that Lennon solidified his relationship with Brian Epstein, and his standing as the leader of their band. See *The Howard Stern Show* (CBS/Infinity radio broadcast Oct. 18, 2001) [hereinafter *Howard Stern*] (“John will have said, ‘listen, you want to deal with the Beatles, deal with me, I’m the guy, I’m the leader, just do it all through me.’”). The trip to Spain occurred in May 1963. See NORMAN, *supra* note 5, at 198-99.

7. On all albums that followed “Please Please Me,” the songs were credited with Lennon’s name preceding McCartney’s. Yet, there are variations in the precise language used for the songwriting credits. Compare THE BEATLES, WITH THE BEATLES (Capitol Records 1987) (1963) (where on vinyl album and compact disc (“CD”) the credit appears as “Lennon/McCartney”), and THE BEATLES, HELP! (Capitol Records 1987) (1965) (“Lennon-McCartney” on vinyl and “Lennon/McCartney” on CD (this Comment will treat a hyphen and a forward slash as interchangeable, and of no consequence to our analysis)), with THE BEATLES, A HARD DAY’S NIGHT (Capitol Records 1988) (1964) (where on vinyl and CD the credit reads “Words and Music: John Lennon and Paul McCartney”), and THE BEATLES, SGT. PEPPER’S LONELY HEARTS CLUB BAND (Capitol Records 1987) (1967) (where vinyl album’s back cover art reads “John Lennon & Paul McCartney,” though actual record is imprinted with label that reads “Lennon-McCartney,” and CD reads “Lennon/McCartney”). The significance of the above information is twofold. First, it establishes that with minor exceptions, every Beatles album released after the 1963 sequencing agreement, included the two-name “Lennon/McCartney” credit. Therefore, the usage can not be described as sporadic in its application, or foreign to the general public. By their own design, the Beatles sought to establish the credit of “Lennon/McCartney” as the moniker for “John Lennon and Paul McCartney,” and were clearly successful in meeting this end. McCartney notes: “[E]verything became Lennon/McCartney. . . . [W]e’d achieved our aim, we’d become like Rodgers and

seven years after the release of their debut album, the band breaks up.⁸ Ten years after that, John Lennon dies.⁹ In 1995, the former bandmates release a musical anthology, and McCartney makes a request of Lennon's widow, Yoko Ono¹⁰ (Lennon's representative in the band's ongoing business affairs), to change the credit on one song, "Yesterday,"¹¹ so that McCartney's name will precede Lennon's.¹² Ono denies the request.¹³

Hammerstein. We were now a songwriting duo." See ANTHOLOGY, *supra* note 3, at 94. Second, it is of note that there are some discrepancies between the credits as they appear on the original vinyl records released from 1963 to 1970, and the credits that appear on the compact discs, that were first issued in 1987. See JR.com: The Beatles in Music, <http://www.jr.com/JRSectionView.process?Nao=0&ArtistPage=t&N=727789> (last visited Feb. 14, 2006) (noting the release dates of each Beatles CD). This Comment will explore legal issues pertaining to music released by McCartney post-1987. Thus, while the original releases are useful in dating the evolution of the "Lennon/McCartney" songwriting credit, how those credits appear on CD's already released, and yet to be released will be the focus of our inquiry.

8. See Alvin Shuster, *McCartney Breaks Off With Beatles*, N.Y. TIMES, Apr. 11, 1970, at L21 ("Paul McCartney said today he had broken with the Beatles over a series of differences."); see also Craig McGregor, "So in the End, the Beatles Have Proved False Prophets," N.Y. TIMES, June 14, 1970, at D13.

9. See Les Ledbetter, *John Lennon of Beatles is Killed; Suspect Held in Shooting at Dakota*, N.Y. TIMES, Dec. 9, 1980, at A1. John Lennon was murdered by Mark David Chapman on December 8, 1980. *Id.* Lennon was shot twice in the back while entering his building on West 72nd Street in Manhattan. *Id.* Lennon was forty years old. *Id.* Chapman was sentenced to twenty years to life in prison, and was denied parole for the fourth time in 2006. *Lennon's Killer Again Denied Parole*, CHI. TRIBUNE, Oct. 11, 2006, at 1:11.

10. Lennon and Ono were married on March 20, 1969. ANTHOLOGY, *supra* note 3, at 332. Their son Sean was born on October 9, 1975, Lennon's 35th birthday. See Wikipedia Encyclopedia, http://en.wikipedia.org/wiki/Sean_Lennon (last visited Feb. 13, 2006). Though Lennon also has a son, Julian, from his first marriage, Sean stands to inherit most of his father's (and Ono's) wealth. See Elizabeth Grice, *Dad Was a Hypocrite*, COURIER MAIL (Queensl., Austl.), June 20, 1998, at 12 (discussing a divorce settlement that provided Julian with \$2,400 a year, and a \$50,000 trust fund upon turning 25, later amended to provide more, but still a paltry sum compared to Ono and Sean's inheritances); see also Jeff Giles with Jac Chebatoris et al., *Lennon Lives*, NEWSWEEK, Nov. 28, 2005, at 61 ("Lennon's estate took in \$22 million last year, making him the third most profitable 'dead celebrity,' according to Forbes, surpassed only by Elvis Presley (\$45 million) and Charles M. Schulz (\$35 million).").

11. Though credited to "Lennon/McCartney," there is no dispute that true authorship of "Yesterday" belongs to McCartney. See ANTHOLOGY, *supra* note 3, at 175 (Lennon states: "That's Paul's song and Paul's baby. Well done. Beautiful. And I never wished I'd written it."). McCartney is famous for noting that the music came to him in a dream. See *id.* But see *infra* note 72 (discussing a charge of plagiarism). The three other members of the Beatles, Lennon, Harrison and Starr were not present when McCartney recorded the song. See ANTHOLOGY, *supra* note 3, at 175. Beatles producer George Martin discussed with Brian Epstein the possibility of releasing the song as a McCartney solo effort. See *id.* ("[I]t wasn't really a Beatles record and I discussed this with Brian Epstein: 'You know, this is Paul's song . . . Shall we call it Paul McCartney?' He said, 'No, whatever we do we are not splitting up The Beatles.'"). McCartney adds: "I wouldn't have put it out as a solo 'Paul McCartney' record. We never entertained those ideas." *Id.*

12. See Lampert, *supra* note 6, at 7 ("[W]hen we were involved in The Beatles Anthology project, . . . I made a request to Yoko Ono to have my name put first on the song Yesterday, which John had often admitted he had nothing whatsoever to do with."). When asked about the dispute by

Seven years later, McCartney releases a concert album titled “Back in the U.S.: Live 2002.”¹⁴ Without asking permission, McCartney changes the credits for nineteen previously released Beatles songs to now read “composed by Paul McCartney & John Lennon.”¹⁵ Ono threatens legal action, but none is ever taken.¹⁶ McCartney experiences a slight backlash

Vinnie Favale, the Vice-President of CBS Late Night Programming, East Coast, and an expert on Beatles history, McCartney explained: “What I wanted to do was, after thirty years of always having John’s name in front, on this one song ‘Yesterday’ . . . [I said] could we just switch it so it said written by Paul McCartney and John Lennon? . . . And yeah, for one reason or another she said no.” See *Howard Stern*, *supra* note 6. Prior to McCartney’s request to transpose the credits, a request was made of Ono, to have Lennon’s name removed entirely. See Jenny Eliscu, *McCartney Reignites Beatles Feud*, ROLLING STONE, Dec. 26, 2002/Jan. 9, 2003, at 19.

[W]hen the CD booklet for the *Anthology 3* album was being written[,] McCartney’s lawyer and brother-in-law, John Eastman, demanded that eighteen songs – including “Blackbird,” “Get Back” and “Hey Jude” – be credited solely to McCartney, with Lennon’s name omitted entirely. But George Harrison, Ringo Starr and Ono unanimously refused McCartney’s bid, and Eastman later wrote a letter apologizing for his “zeal” and claiming he had acted “without Paul McCartney’s instructions.”

Id.

13. See Lampert, *supra* note 6, at 7 (“At first she said yes, but then she rang back a couple of hours later and reversed her decision.”). When McCartney addressed the matter in an interview on “The Howard Stern Show,” Stern played devil’s advocate noting: “Maybe [Ono’s] point is . . . who knows who wrote what, and if we start changing this song, what if we change the other ones. . . . But it would have been a nice gesture to you.” See *Howard Stern*, *supra* note 6. Ono however, has explained that her concern is not only Lennon’s legacy, but that she also has McCartney’s best interest in mind, making the point that if one song, or even a few songs were to say “McCartney/Lennon,” then there is a risk of the general public making the assumption that McCartney wrote only those few songs for which he is credited first, and that Lennon wrote all of the rest. See Eliscu, *supra* note 12, at 20. Five years after his interview with McCartney, Stern addressed the controversy again, commenting: “[R]ightly so, Yoko told him ‘no,’ and I’ll tell you why it’s right; because John isn’t here to tell us who wrote what, and we don’t know what his opinion is.” *The Howard Stern Show* (SIRIUS Satellite Radio broadcast July 26, 2006).

14. PAUL MCCARTNEY, BACK IN THE U.S.: LIVE 2002 (Capitol Records 2002).

15. *Id.* (where credits read “composed by Paul McCartney & John Lennon”). See also Eliscu, *supra* note 12, at 19 (noting that the credits were transposed “[a]gainst the wishes of John Lennon’s widow, Yoko Ono, . . .”). For our purposes, it is not of consequence that McCartney uses a form of crediting that departs entirely from the two-name billing style, as this Comment’s inquiry surrounds the legality of abandoning the standard songwriting credit, regardless of how the songs are credited by the infringer. We will therefore treat the credit that reads “Paul McCartney & John Lennon” as analogous to “McCartney/Lennon.”

16. See Gilbert Garcia, *The Ballad of Paul and Yoko*, SALON.COM, Jan. 27, 2003, http://www.salon.com/ent/music/feature/2003/01/27/paul_yoko/index.html (“McCartney’s cheeky gambit has been met with a torrent of public venom from Yoko Ono’s camp, including vague threats of legal action from Ono’s attorney Peter Shukat . . .”). See also Eliscu, *supra* note 12, at 19 (“‘What he did was absolutely inappropriate,’ says Ono’s lawyer, Peter Shukat. ‘John and Paul had an agreement. This is very petty.’”). Several sources have claimed that under McCartney’s Capitol Records contract, he has the right to transpose the credits for his solo releases, but not for albums released under the Beatles’ Apple Records label, as was the case with the anthology project. See *supra* note 11 and accompanying text; see also Eliscu, *supra* note 12, at 20; Garcia, *supra*. However, a former attorney of Ono’s, Gregory Victoroff notes the dubious nature of this provision, and that its validity would likely hinge on the precise language of the original publishing contract. See Garcia, *supra*. It also appears that despite such claims, McCartney has chosen not to rely on this supposed agreement as a defense, as he has never raised that such an agreement exists in any statements made regarding the dispute. See generally Lampert, *supra* note 6, at 7. As such, this Comment will proceed making

for the stunt, and after issuing a press release, decides to let the entire issue die.¹⁷ At least for the time being. But what happens when the issue is raised again? If not by McCartney, then perhaps by his heirs, as the music and its profits are certain to far outlive McCartney.¹⁸ Or if not by McCartney, then by Keith Richards,¹⁹ Bernie Taupin,²⁰ or any post-ampersands of the many songwriting duos.²¹

no assumptions about an agreement between Capitol Records and McCartney, and will examine the legal issues surrounding any future transposition of the names, regardless of the record label that is involved.

17. See Lampert, *supra* note 6, at 7.

18. McCartney is the father of five children. See Robert Hilburn, *When He's 64*, L.A. TIMES, Feb. 5, 2006, at E1. He has three daughters and a son from his first marriage to Linda McCartney, who died in 1998, and a daughter from his second wife Heather Mills, to whom he was wed in 2002. See *id.* McCartney and Mills announced their separation in May of 2006. Sarah Lyall, *Paul McCartney and Wife Say They Have Separated*, N.Y. TIMES, May 18, 2006, at E3.

19. Keith Richards (sometimes credited as Keith Richard) is the guitarist for the band The Rolling Stones, and with lead singer Mick Jagger performs songwriting duties for the band. See generally VICTOR BOCKRIS, KEITH RICHARDS THE BIOGRAPHY (2003); KRIS NEEDS, KEITH RICHARDS: BEFORE THEY MAKE ME RUN (2004). Though not as consistent as the Beatles when it comes to the use of a two-name billing term, Jagger's name almost always precedes Richards on the albums' credits, regardless of the language used. See, e.g., THE ROLLING STONES, STICKY FINGERS (Virgin Records 1994) (1971) (where credits read "[a]ll tunes written by Mick Jagger and Keith Richard"); THE ROLLING STONES, TATTOO YOU (Virgin Records 1994) (1981) ("All songs written by Jagger-Richards."). *Contra* THE ROLLING STONES, BLACK AND BLUE (Virgin Records 1994) (1976) ("All Songs by Keith Richard & Mick Jagger."); but see MICK JAGGER & KEITH RICHARDS ET AL., ACCORDING TO THE ROLLING STONES 348-53 (Dora Loewenstein & Philip Dodd ed. 2003) (where discography notes all songwriting credits with two name billing term "Jagger-Richards," even for the album "Black and Blue").

20. Bernie Taupin is the lyricist for almost all songs composed and performed by the singer Elton John. See Wikipedia Encyclopedia, http://en.wikipedia.org/wiki/Bernie_Taupin (last visited Feb. 13, 2006). See generally ELTON JOHN, ELTON JOHN ANTHOLOGY (Hal Leonard 1987) (containing all the sheet music for music performed by John, with notations for songs indicating "[w]ords and music by Elton John and Bernie Taupin"); see also ELTON JOHN, SLEEPING WITH THE PAST. (Island Records 1998) (where CD reads "all songs written by Elton John and Taupin").

21. The decision to have Lennon's name precede McCartney's was based on the chosen sequence having "a better ring" to it. See ANTHOLOGY, *supra* note 3, at 94. Some bands appear to sequence their credits on an alphabetical basis. See, e.g., R.E.M., LIFE'S RICH PAGEANT (MCA Records 1986) (where credit reads: "All Songs Berry Buck Mills Stipe"); R.E.M., MONSTER (Warner Bros. Records 1994) ("All Songs By Berry, Buck, Mills, Stipe"). There are other bands who abandon consistency, and the rewards Lennon and McCartney determined were available by creating a billing term, and instead denote the precise contributions made to each song on an album. See PHISH, *The Squirming Coil*, on LAWN BOY (Elektra Entm't 1990) (liner notes read: "Music-Anastasio, Lyrics-Marshall); PHISH, *Reba*, on LAWN BOY (Elektra Entm't 1990) ("Music/Lyrics-Anastasio"). The songwriting tandem of recent memory that perhaps most closely resembles the collaboration of Lennon and McCartney, is that of Jay Farrar and Jeff Tweedy, who served as the songwriters for the influential country-rock band Uncle Tupelo. See Robert Wilonsky, *The Country of Rock and Roll: From the Ashes of Uncle Tupelo Springs Wilco, Genreless and Great*, HOUSTON PRESS, May 4, 1995 ("Though [many] of Uncle Tupelo's songs were credited to Farrar-Tweedy, they never wrote together; they were, . . . the Lennon and McCartney of the late '80s and early '90s – each singing his own songs, Farrar writing the more somber rockers . . . and Tweedy penning the

This Comment will explore the myriad of legal issues surrounding the “can of worms,”²² as Ono has described it, that McCartney has opened. In weighing each party’s potential claims and defenses, there are at least three areas of law which deserve consideration: copyright law, trademark law, and the common law right of publicity.²³

First, in addition to providing the duo with a two-name status symbol, the term “Lennon/McCartney” serves as a partial notification of ownership in the copyrights of the compositions in question.²⁴ These ownership rights, which can often be dispersed amongst many parties, have a value that is deserving of protection against infringement.²⁵ As such, McCartney’s use of a unique credit, such as “McCartney/Lennon,” could be viewed as an act of infringement by an unauthorized non-Lennon/McCartney musician upon the copyrights owned by Lennon (and McCartney) or any other Beatles copyright holder.²⁶ In other words, McCartney’s re-release of a prior Beatles recording, or the release of an original version of an earlier recording, such as a live concert performance, credited in a manner other than “Lennon/McCartney” could be interpreted as being no different than that same material being released by one who illegally credits the song as “written by John Doe.”

Second, if it can be established that the term “Lennon/McCartney” is a protected trademark under the Lanham Act,²⁷ then any unauthorized use or

poppier cuts.”). See also UNCLE TUPELO, ANODYNE (Sire Records 1993) (where credits read “All songs by Farrar-Tweedy.”). Uncle Tupelo disbanded in 1993. See Wilonsky, *supra*. Tweedy went on to form Wilco, “one of the most acclaimed groups in American rock,” and the recipients of the 2005 Grammy Award for Best Alternative Album. See Richard Cromelin, *Jeff Tweedy’s Post-Depression Era*, L.A. TIMES, Feb. 11, 2006, at E1.

22. Garcia, *supra* note 16, at 3.

23. A fourth area of law, that is well beyond the scope of this Comment, but that could play a role in this dispute, is the law of contracts. An adequate analysis however, would require a review of documents that are not available to the public or may not even exist, as the agreements at issue here, the partnership agreement and the later credit sequencing agreement, both appear to have been made orally. See *supra* notes 3, 6. Nevertheless, such agreements could raise issues that range from the statute of frauds to the parol evidence rule, contract modifications absent consideration, and the waiver of conditions. See generally JOHN D. CALAMARI ET AL., CASES AND PROBLEMS ON CONTRACTS (4th ed. 2004). No party involved in this dispute however, has ever raised the language of a contract in their public statements on the matter. See *supra* note 15. As such, this Comment will only focus on the three areas of law mentioned in the accompanying text above.

24. As of March 1, 1989, copyright notice on published copies of a work is no longer a requirement for protection, as a result of the Berne Convention Implementation Act of 1988. DAVID J. MOSER, MUSIC COPYRIGHT FOR THE NEW MILLENNIUM 112 (Patrick Runkle ed., ProMusic Press 2002). The 1988 Act though is not retroactive, and so works created prior to March 1, 1989, which would include all of the Beatles’ original recordings, still require an attachment of notice in order to be protected. *Id.* Notice is sufficed by use of the word “copyright” or its abbreviation or symbol, the year of publication, and the name of the current copyright owners, which may be the publishers, the songwriters, or both. *Id.*

25. See discussion *infra* Part II.A.

26. See discussion *infra* Part III.A.1.

27. Sections 1-46 of the Lanham Act are codified in 15 U.S.C. §§ 1051-1127 (2005).

manipulation of that trademark could be viewed as a potential infringement.²⁸ This Comment will propose that “Lennon/McCartney” signifies more than mere authorship, and therefore bears trademark status for which the Federal Trademark Dilution Act of 1995 would most likely cover the potential violations discussed here.²⁹ Under that assumption, the term “Lennon/McCartney” is afforded a degree of protection that is ultimately going to be balanced against any First Amendment considerations.³⁰ In this instance, those considerations would be McCartney’s freedom to comment on the true authorship of the songs.³¹

Third, under the common law right of publicity, Lennon has the ability to protect the use of his name by another for an unauthorized purpose.³² If “McCartney/Lennon” is not a valid trademark, and “Lennon/McCartney” is, then the use of Lennon’s name in the former is perhaps a violation of that right.³³ That would only be true however, if the term “Lennon/McCartney” can be divided into “Lennon/” and “/McCartney.” This is likely the case, and Lennon would therefore retain a pecuniary interest in his name.³⁴ However, on the other hand, an entirely different argument can be made that when Lennon’s name is paired with McCartney’s, it is indivisible, and thus loses its independent status as Lennon’s own name, and becomes instead a separate entity that no longer represents the deceased celebrity John Lennon.³⁵

Tying together the three areas of law, is an intangible not typically present in the usual infringement dispute. That intangible can best be described as lore, or more precisely, Beatles lore. This Comment will propose that the goodwill associated with that lore, and its delicate nature, is the straw that stirs any potential causes of action or defenses related to this dispute into one concoction.³⁶ In achieving their unparalleled success, a history of the Beatles was written, and any attempt to rewrite that history could unleash an effect that would be detrimental to Beatles lore and diminish its great value.³⁷ The mere transposition of the names Lennon and McCartney could specifically be the type of revisionist act that causes such

28. See 15 U.S.C. § 1125(a) (2005).

29. See 15 U.S.C. § 1125(c) (2005).

30. See discussion *infra* Part III.B.

31. See discussion *infra* Part III.B.

32. See discussion *infra* Part II.C.

33. See discussion *infra* Part III.A.3.

34. See discussion *infra* Part III.A.3.

35. See discussion *infra* Part III.A.3.

36. See discussion *infra* Part III.A.2.

37. See *supra* note 5 (discussing value of the Beatles).

an adverse effect. That effect will continually be weighed as this Comment explores the issues which surround the potential litigation for the hypothetical yet extremely plausible *Estate of Lennon v. McCartney* case described herein. Part II of this Comment will focus on the history and background of the areas of law mentioned above.³⁸ Part III will apply that law to the facts of this hypothetical case.³⁹ Part IV will consider relevant future trends,⁴⁰ and Part V will conclude the Comment.⁴¹

II. HISTORY AND BACKGROUND: COPYRIGHTS, TRADEMARKS AND THE RIGHT OF PUBLICITY

Before discussing any of the potential causes of action that could be brought by Lennon, and any defenses which may be asserted by McCartney, it is important to understand the three areas of law upon which each of the musician's arguments will be based.

For the first of these three, copyright law, our attention will be focused less on the billing term, and more on that which is being billed.

A. Copyright Law and Joint Works

Article One of the Constitution recognizes a creator's copyright interests by providing Congress with the power to "secur[e] for limited Times to Authors . . . the exclusive Right to their respective Writings"⁴² Congress exercised that right by passing the Copyright Act of 1790, followed by revisions in 1831 and 1909, with the most substantial revisions coming in the form of the 1976 Act.⁴³

The Copyright Act provides for federal protection from the moment of creation.⁴⁴ "Creation" is defined as the moment when a work "is fixed in a copy or phonorecord for the first time,"⁴⁵ which when coupled with originality, satisfies the two prerequisites for copyright protection.⁴⁶ Among the works of authorship eligible for protection are "musical works, including any accompanying words,"⁴⁷ and "sound recordings."⁴⁸ An owner of a

38. See *infra* notes 42-228 and accompanying text.

39. See *infra* notes 229-359 and accompanying text.

40. See *infra* notes 360-94 and accompanying text.

41. See *infra* notes 395-407 and accompanying text.

42. U.S. CONST. art. I, § 8, cl. 8.

43. MOSER, *supra* note 24, at 13-14.

44. 17 U.S.C. § 301 (2005).

45. 17 U.S.C. § 101 (2006).

46. 17 U.S.C. § 102(a) (2006). The Code states: "Copyright protection subsists . . . in *original* works of authorship *fixed* in any tangible medium of expression . . ." *Id.* (emphasis added).

47. 17 U.S.C. § 102(a)(2) (2006).

48. 17 U.S.C. § 102(a)(7) (2006); see also *infra* note 241 (noting distinction between a musical

copyright has the “exclusive rights to *do* and to *authorize*”⁴⁹ any of the rights afforded to the owner by the Act. These rights include: reproduction, creation of derivations, distribution, performance, public display, and transmission.⁵⁰

Improving upon the 1909 Act, the 1976 Act provides for the unrestricted divisibility of a copyright.⁵¹ “[O]wnership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law.”⁵² One of the most common types of transfers is an exclusive license, which occurs when an owner transfers one or more of its rights, and retains one or more of its rights.⁵³ A licensee owns any transferred rights, and can both act as a transferor and sue any infringers of the transferred rights.⁵⁴ Alternately, nonexclusive rights do not involve a transfer of ownership.⁵⁵ Rather, it permits the licensee to exercise one or more of the rights, but also allows the copyright owner to license to others the same rights.⁵⁶

One very significant provision of the 1909 Act, that is still a part of the 1976 Act, is the compulsory mechanical license.⁵⁷ This provision “provides that once a musical composition has been distributed . . . with the copyright owner’s permission, anyone may reproduce the composition.”⁵⁸ This means that once the first recording has been released, other musicians have the right to record and release their own versions of the song, subject to several conditions, and the payment of royalties to the owner.⁵⁹ Note that this provision only allows for original versions to be recorded and released, as

work and a sound recording). “Congress first extended copyright protection for musical compositions in 1831 Sound recordings did not receive federal copyright protection until 1972.” ROBERT P. MERGES ET AL., *INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE* 424 (4th ed. 2006).

49. 17 U.S.C. § 106 (2006) (emphasis added).

50. 17 U.S.C. §§ 106(1)-(6) (2006).

51. See MOSER, *supra* note 24, at 45; see also *Gardner v. Nike, Inc.*, 279 F.3d 774, 777-78 (9th Cir. 2002) (quoting *Harris v. Emus Record Corp.*, 734 F.2d 1329, 1333 (9th Cir. 1984)) (“Under the Copyright Act of 1909 . . . copyright licenses (whether exclusive or not) were ‘not transferable as a matter of law.’”). It should also be noted that this right of divisibility is not retroactive to copyrights created prior to January 1, 1978. See MOSER, *supra* note 24, at 45.

52. 17 U.S.C. § 201(d) (2006).

53. See MOSER, *supra* note 24, at 45; see also M. WILLIAM KRASILOVSKY & SIDNEY SHEL, *THIS BUSINESS OF MUSIC* 14 (9th ed. 2003) (“Record companies customarily acquire the exclusive rights to record an artist during the term of the recording agreement Without exclusivity, different companies could issue competing versions of an artist’s recordings . . .”).

54. See MOSER, *supra* note 24, at 45.

55. *Id.*

56. *Id.*

57. 17 U.S.C. § 115 (2006).

58. MOSER, *supra* note 24, at 55.

59. *Id.*

the distribution of the original recording would still require a license from the copyright holder.⁶⁰ One condition of this right is that the licensee is prohibited from altering the composition beyond minor changes.⁶¹ Furthermore, notice of the intent to obtain a compulsory license must be filed with the copyright owner “no later than thirty days after recording and before distributing” the recording.⁶² Failure to give such notice subjects one to liability for infringement.⁶³ Finally, “[i]t is important to realize that copyright does not operate in a vacuum,” and that even with a compulsory mechanical license one could be forced to defend their actions on the basis of unfair competition or violating the right of publicity.⁶⁴

Instances involving compulsory mechanical licenses aside, an infringer is otherwise “[a]nyone who violates any of the exclusive rights of the copyright owner,”⁶⁵ with the federal courts owning exclusive jurisdiction for any such civil actions arising under the Act.⁶⁶ To make a prima facie case for infringement, an owner plaintiff must show that there was copying,⁶⁷ and

60. *See id.*

61. *See id.* at 56. An example of a minor alteration would be a performer who is of the opposite sex from the composer, deciding to change gender references in the song. *Compare* THE BEATLES, *I Saw Her Standing There*, on PLEASE PLEASE ME (Capitol Records 1987) (1963), *with* TIFFANY, *I Saw Him Standing There*, on TIFFANY (UMG Recordings 1987) (where cover version sung by female performer changes gender specific lyrics).

62. MOSER, *supra* note 24, at 56.

63. *See id.*

64. *Id.* at 28.

65. 17 U.S.C. § 501(a) (2005). Any legal or beneficial owner is protected against infringement. 17 U.S.C. § 501(b) (2006). An example of a “beneficial owner” would be “an author who parted with legal title to the copyright in exchange for percentage royalties based on sales or license fee.” H.R. REP. NO. 94-1476, at 159 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5775. Therefore, essentially anyone who stands to benefit financially from one of the exclusive rights, is infringed upon, when those rights are violated. This is why a court may require an owner who is infringed upon to serve notice of the complaint “upon any person shown, by the records of the Copyright Office or otherwise, to have or claim an interest in the copyright . . .” 17 U.S.C. § 501(b) (2006).

66. 28 U.S.C. § 1338(a) (2005). The same statute is applied to infringement of trademarks. *See* discussion *infra* Part II.B.

67. *See* Seltzer v. Sunbrock, 22 F. Supp. 621, 627 (S.D. Cal. 1938) (“The law is well settled that there must be an actual copying, whether willful or unintentional, but nevertheless a copying made possible by defendant’s access to plaintiff’s copyrighted material.”). Thus, in addition to the physical copying of the original, it must also be shown that the defendant had access to the original. As Judge Learned Hand stated in *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936): “[I]f by some magic a man who had never known it were to compose anew Keats’s Ode on a Grecian Urn, he would be an ‘author,’ and, if he copyrighted it, others might not copy that poem . . .” *See also* Tomasini v. Walt Disney Co., 84 F. Supp. 2d 516, 519 (S.D.N.Y. 2000) (quoting *Williams v. Crichton*, 84 F.3d 581, 587 (2d Cir. 1996) (quoting *Kregos v. Assoc. Press*, 3 F.3d 656, 662 (2d Cir. 1993)) (“If, as here, direct evidence of unauthorized copying is not available, such copying may be inferred upon a plaintiff’s “showing ‘(a) that the defendant had access to the copyrighted work and (b) the substantial similarity of protectible material in the two works.”). Access can also be inferred where the facts suggest that the defendant had ample opportunity to view or copy the work. *See* Bright Tunes Music Corp. v. Harrisongs Music, Ltd. (*My Sweet Lord*), 420 F. Supp. 177, 179, 181 (S.D.N.Y. 1976) (where former Beatle Harrison was found liable for infringement, having plagiarized an earlier hit song, for which access was assumed due to the song’s

that the copying amounted to an improper appropriation, demonstrated by a “substantial similarity” between the two works.⁶⁸ In determining whether or not there is a substantial similarity, courts have often applied a totality based test that examines the “total concept and feel” of the accused work.⁶⁹

The 1869 case of *Lawrence v. Dana*⁷⁰ relied on the wisdom of Judge Joseph Story who earlier formulated a definition of infringement that spoke not only to the quantitative requirements, but one that also addressed the qualitative concerns of an owner. He held:

[T]hat, to constitute an invasion of copyright, it was not necessary that the whole of a work should be copied, nor even a large portion of it, in form or substance; that if so much is taken that the *value of the original is sensibly diminished*, or the labors of the original author are substantially, to an injurious extent, appropriated by another, that is sufficient in point of law to constitute an infringement.⁷¹

Judge Story’s rule serves as an important reminder that while courts have at times given infringing artists the benefit of the doubt, by almost subjectively declaring their copying a subconscious act,⁷² the fact remains

popularity in the United States and England). *But see* *Selle v. Gibb*, 567 F. Supp. 1173, 1182-83 (N.D. Ill. 1983) (where court granted the defendants a judgment notwithstanding the verdict, due to lack of evidence and inability to infer from facts that the defendants ever had access to the plaintiff’s song).

68. MOSER, *supra* note 24, at 119. An improper appropriation is demonstrated by showing that there is a “substantial similarity” between the plaintiff’s complaining song and the defendant’s accused song. *Id.* at 118. *See, e.g.*, *Three Boys Music Corp. v. Bolton (Love is a Wonderful Thing)*, 212 F.3d 477, 486 (9th Cir. 2000) (finding a “substantial similarity” between Michael Bolton’s “Love is a Wonderful Thing,” and an earlier song of the same title performed by The Isley Brothers). The test for “substantial similarity” is framed by Judge Hand in *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960), as whether “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.” Judge Hand’s “ordinary observer” test therefore places an emphasis on the consumer or the audience for the accused work. His test seems to indicate that it is the perspective of those unfamiliar with the potential infringement that ultimately matters most.

69. *See, e.g.*, *Love is a Wonderful Thing*, 212 F.3d at 485; *Pasillas v. McDonald’s Corp.*, 927 F.2d 440, 442 (9th Cir. 1991) (applying the intrinsic “total concept and feel” test to determine that there was no substantial similarity between the moon mask created by McDonald’s for a “Mac Tonight” campaign ad, and the appellant’s white crescent moon Halloween mask); *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1167 (9th Cir. 1977) (applying the “total concept and feel” test in determining that there was a substantial similarity between the McDonaldland characters used in ads, and the Krofft’s original H.R. Pufnstuf character).

70. 15 F. Cas. 26 (C.C.D. Mass. 1869) (No. 8,136).

71. *Id.* at 60 (emphasis added).

72. *See My Sweet Lord*, 420 F. Supp. at 181. The court here seemingly draws a conclusion that the combination of sounds that Harrison used to create “My Sweet Lord,” plagiarized The Chiffons’

that “[c]opyright is a form of property ownership,”⁷³ and any infringement is nothing less than theft of that property.⁷⁴

“[I]t is rare for a single individual or entity to own the whole copyright to a song.”⁷⁵ One reason for this, is that songwriters often collaborate to create a joint work.⁷⁶ The 1976 Act defines a “joint work” as one “prepared

“He’s So Fine” only because “[Harrison’s] subconscious knew it already had worked in a song his conscious mind did not remember.” *Id.* at 180. To a degree, this appears to be pure conjecture on the part of the court, as the decision does not supply the basis for its opinion. *See id.* (“Did Harrison deliberately use the music of He’s So Fine? I do not believe he did so deliberately.”). One can speculate that the court here is doing its best to protect the image of a respected musician. On the other hand, subconscious copying was argued by the plaintiffs in *Love is a Wonderful Thing*, as a means of establishing the defendant’s access. *See Love is a Wonderful Thing*, 212 F.3d at 483-84. There, where the plaintiffs had a duty to prove access, their opinion that the copying was subconscious was still, in the words of the court, “attenuated.” *See id.* at 484. Even when subconscious copying is embraced by courts, as a form of moral absolution, Judge Hand remains steadfast that it is “no excuse” when it comes to relieving one from actual liability. *See Fred Fisher, Inc. v. Dillingham*, 298 F. 145, 148 (S.D.N.Y. 1924). *My Sweet Lord* also espouses the quantitative portion of Judge Story’s rule, as Harrison’s accused work repeated only a three note and four note motif that appeared in the complaining song. *See supra* note 71 and accompanying text; *see also My Sweet Lord*, 420 F. Supp. at 178. Surprisingly, Lennon of all people remains least convinced that Harrison’s acts were subconscious in nature. Lennon confidently states: “He knew what he was doing.” SHEFF, *supra* note 1, at 150 (“He must have known, you know. He’s smarter than that. . . . George could have changed a few bars in that song and nobody could have ever touched him, but he just let it go and paid the price.”). While Harrison’s image may have been preserved due to the accepted theory of subconscious copying, it can be argued that he too has fallen victim to similar “subconscious” acts. Upon an attentive listening, one can detect a strong likeness between the chords that accompany the opening verse of “While My Guitar Gently Weeps,” authored by Harrison, and the opening verse of “Come As You Are,” authored by the late Kurt Cobain. Compare THE BEATLES, *While My Guitar Gently Weeps*, on THE BEATLES (THE WHITE ALBUM) (Capitol Records 1968), with NIRVANA, *Come As You Are*, on NEVERMIND (David Geffen Co. 1991). And while Harrison found himself the subject of litigation, McCartney is perhaps the former Beatle with the most suspect composition. It has been noted that “Yesterday,” authored by McCartney, bears a striking resemblance musically and lyrically to a ballad from the 1950’s titled “Answer Me,” which was covered in 1954 by Nat King Cole as “Answer Me, My Love.” *See* ALAN CLAYSON & SPENCER LEIGH, *THE WALRUS WAS RINGO* 110-11 (2003) (noting the similarities when compared by musicologists). Also lyrically, compare THE BEATLES, *Yesterday*, on HELP! (Capitol Records 1987) (1965) (“Yesterday, all my troubles seemed so far away, now it looks as though they’re here to stay, oh, I believe in yesterday.”), with NAT KING COLE, *Answer Me, My Love*, on LOVE SONGS (Capitol Records 2003) (“You were mine yesterday, I believed that love was here to stay.”). Perhaps adding to the suspicion is McCartney’s acknowledgement that Nat King Cole is an artist whose music he enjoys, when asked about his own listening habits. *See Howard Stern, supra* note 6. An explanation for plagiarism that does not rely on a theory of subconscious copying can be found in the 2005 film “The Squid and the Whale.” There, Walt Berkman a high school student portrayed by Jesse Eisenberg, credits himself as the songwriter when performing the Roger Waters authored Pink Floyd song “Hey You” at a talent show. He justifies the act to a therapist noting: “I felt I could’ve [written it]. So the fact that it was already written was kind of a technicality.” *See THE SQUID AND THE WHALE* (Samuel Goldwyn Films 2005).

73. MOSER, *supra* note 24, at 2.

74. *See id.* Legendary jazz musician Ferdinand “Jelly Roll” Morton made known his contempt for infringers, stating: “I also advocate much more rigid laws so thieves may get their just desserts. There are many who enjoy glory plus financial gain’s abundance, even in the millions, who should be digging ditches or sweeping the streets. Lack of proper protection causes this.” *Id.*

75. MOSER, *supra* note 24, at 37.

76. *Id.*

by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.”⁷⁷ Joint authors are co-owners of the copyrights of a joint work, with each owning an undivided one half interest.⁷⁸

The classification of compositions as joint works, and the conditions for any such designation is a topic that is for the most part beyond the scope of this Comment. Though we are dealing with a potential plaintiff and defendant who are joint authors, their common ownership is not in dispute, and we will therefore proceed under that assumption.⁷⁹ There are however specific terms of that joint ownership that this Comment is attempting to clarify. As such, the laws and precedents of joint authorship will aid us to that effect in two notable ways.

First, relevant case law exists that relies upon the particulars of a work’s billing or credits as a means of determining whether ownership is joint or held by one. Applying that reasoning, inferences can be made regarding songwriting credits in general. Meaning, that if the manner in which credits appear carries an evidentiary weight, it would stand to reason that tampering with the credits may be less permissible than one might assume. In *Thomson v. Larson*,⁸⁰ where joint authorship of the Broadway musical “Rent” was in dispute, “[t]he court described billing or credit as a

77. 17 U.S.C. § 101 (2005); *see also* Edward B. Marks Music Corp. v. Jerry Vogel Music Co. (*Marks*), 47 F. Supp. 490, 491 (S.D.N.Y. 1942), *aff’d*, 140 F.2d 266 (2d Cir. 1944). The court here held that “[t]wo men producing a musical composition jointly are nonetheless coauthors and owners though they labor at different times, without conference or consultation, and though they may remain strangers to each other.” *Id.* The authorship line is drawn according to the initial intent of the authors. *Id.* For example, since Shakespeare did not write *A Mid-Summer’s Night Dream*, nor did David write the “23rd Psalm” with the intent that they be set to music, a Johnny-come-lately composer could not claim ownership in the copyright. *See id.* In *Marks*, however, both lyricist and composer authored their works with the requisite intent, and thus owned equal shares of the joint work. *See id.* *Cf.* Shapiro, Bernstein & Co. v. Jerry Vogel Music Co., 221 F.2d 569 (2d Cir. 1955) (where the composer never intended for lyrics to accompany his piece, yet a joint work was found to exist nonetheless because the composer had assigned his ownership rights to an assignee who procured the lyricist).

78. 17 U.S.C. § 201(a) (2005); *see generally* A.E. Korpela, Annotation, *Rights and Remedies of Co-owners of Copyright*, 3 A.L.R. 3d 1301, 4b (2005); MOSER, *supra* note 24, at 39 (“[I]f two songwriters collaborate in the creation of a song, each will own a 50 percent interest in the entire song.”); *Marks*, 47 F. Supp. at 491 (“There can be but one subsisting copyright of a single version of a single work.”); Mary LaFrance, *Authorship, Dominance, and the Captive Collaborator: Preserving the Rights of Joint Authors*, 50 EMORY L.J. 193, 193 (2001) (“Perhaps the most significant legal consequence of joint authorship is joint ownership, under which the authors enjoy *equal and undivided ownership* of the copyright . . .”) (emphasis added).

79. There is always the potential for litigation as to whether works are in fact joint. For a discussion that demonstrates this potential for future disputes involving the Lennon and McCartney heirs *see generally* LaFrance, *supra* note 78.

80. 147 F.3d 195 (2d Cir. 1998).

‘significant’ indicator of ‘how parties viewed themselves in relation to a work.’”⁸¹ Similarly, in *Seshadri v. Kasraian*⁸² the court treated credits and even their sequence as evidence, in reaching a decision on joint authorship,⁸³ once again allowing for the inference to be made that that which is evidence for the sake of one determination should not be treated as willy-nilly or indiscriminate for another.

The law of joint works also aids us in a second way. Once it is settled that the copyrights at issue are joint works, the next step is determining the rights and duties of each joint owner, specifically whether there is a duty for an owner to not destroy the copyright. Instances of destruction are so infrequent however, since it would require one to destroy their own interests, that only a dearth of case law is available.⁸⁴ That which has been written however is clear that “the authority of a cotenant over literary property is not different from the authority of a cotenant over tangible personal property; and that such authority . . . does not extend to acts of destruction or to the rendering impossible of further enjoyment of the common property by another cotenant.”⁸⁵

All told, the law of copyrights and joint works speaks mostly to the underlying property interest of our debate, that of course being the song which bears the songwriting credit. Our study becomes more focused however, when we turn our attention to trademarks, the area of law that pertains to the use of something as specific as a two-name billing term.

B. Trademark Law

The predecessor for modern trademark law was English common law, where the earliest cases involved the stamping of products by guilds with unique marks of origin.⁸⁶ Since 1946, federal trademark law has embodied

81. LaFrance, *supra* note 78, at 241 (quoting *Thomson*, 147 F.3d at 203 (citing *Childress v. Taylor*, 945 F.2d 500, 508 (2d Cir. 1991) (where plaintiff claimed joint authorship of play written about life of comedienne Jackie “Moms” Mabley and consideration of billing “helpfully serve[d] to focus the fact-finder’s attention on how the parties implicitly regarded their undertaking”))).

82. 130 F.3d 798 (7th Cir. 1997) (where the sequencing of names on an article played a role in determining whether joint authorship existed for a professor and a graduate student).

83. See LaFrance, *supra* note 78, at 234.

84. See MOSER, *supra* note 24, at 40. In addition to the duty not to destroy the copyright, a joint owner is allowed “to exploit the work freely, subject to a duty to account to the others for a ratable share of the exploitation profits.” LaFrance, *supra* note 78, at 193 (citing H.R. REP. NO. 94-1476, at 121 (1976)). As a result of this duty to account for profits, “depletion of a copyright’s value will probably not be an issue too often.” MOSER, *supra* note 24, at 40.

85. See *Brown v. Republic Prods., Inc.*, 161 P.2d 796, 798 (Cal. 1945) (implying that destruction of the copyright by a joint author would be a valid assertion, even though matters introduced into the record below were insufficient here to support such a finding); see also *Maurel v. Smith*, 271 F. 211, 216 (2d Cir. 1921) (“Where two or more persons have a common interest in a property, equity will not allow one to appropriate it exclusively to himself, or to *impair its worth* as to others.”) (emphasis added).

86. See Greg Lastowka, *The Trademark Function of Authorship*, 85 B.U. L. REV. 1171, 1186

itself in the Lanham Act, a federal codification of the common law of trademarks.⁸⁷ Section 43(a) of the Lanham Act protects both registered and unregistered trademarks.⁸⁸ Therefore, for a mark to qualify as a trademark, all that is required is actual use of the mark in association with one's goods.⁸⁹

Governed by the same infringement standards, it is worth noting the similitude between trademarks and service marks. A service mark is defined by the Lanham Act as a mark used "to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown."⁹⁰ When marks are both service marks and trademarks, "[t]he terms can be used interchangeably," with courts often using the term trademark to designate both.⁹¹

There are two prominent theories of trademark infringement under which one may bring a cause of action: the confusion doctrine and dilution doctrine.⁹² Section 43(a) broadly incorporates these doctrines, stating that:

(2005) (citing Edward S. Rogers, *Some Historical Matter Concerning Trademarks*, 9 MICH. L. REV. 29, 33 (1910)).

87. 15 U.S.C. §§ 1051-1127 (2005).

88. See *Two Pesos v. Taco Cabana*, 505 U.S. 763, 768 (1992) ("[I]t is common ground that § 43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)."); see also *New West Corp. v. NYM Co. of California, Inc.*, 595 F.2d 1194, 1198 (9th Cir. 1979) ("To recover for a violation of this section it is not necessary that a mark or trade-mark be registered."); *Mortellito v. Nina of California, Inc.*, 335 F. Supp. 1288, 1294 (S.D.N.Y. 1972) ("Regarding the claim under the Lanham Act, it is not a prerequisite that the mark be registered."). An unregistered trademark is often referred to as a "common law" trademark. See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 467 F. Supp. 366, 373 n.2 (S.D.N.Y. 1979), *aff'd*, 604 F.2d 200 (2d Cir. 1979) (noting that one can recover for claims arising that involve both registered trademarks and common law trademarks).

89. See 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 16:1 (4th ed. 2005).

90. 15 U.S.C. § 1127 (2005); see, e.g., *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1348 (Fed. Cir. 2001) (finding 1-888-M-A-T-R-E-S-S a registerable service mark for the store's "shop-at-home" service, due to its distinctiveness and ability to indicate a particular source of goods); *In re Forbes Inc.*, 31 U.S.P.Q.2d 1315 (T.T.A.B. 1994) (finding "NO GUTS. NO STORY." a registerable service mark for magazine's advertising services, on basis that advertising services are separate from magazine's publishing activities, and thus the mark identifies the source of the services connected to the mark).

91. See *Boston Prof'l Hockey Ass'n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1009 (5th Cir. 1975) ("For convenience we use the word trademark in this opinion to designate both service mark and trademark use of the symbols involved.").

92. See Lanham Act § 43(a); 15 U.S.C. § 1125(a) (2006); see also 15 U.S.C. § 1125(c) (2006) (remedies for dilution).

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, . . . 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.⁹³

1. The Likelihood of Confusion Doctrine

A trademark infringement claim under the confusion doctrine requires the plaintiff to demonstrate the validity of its trademark and an infringement of that mark.⁹⁴ “The validity of a mark pertains to whether a ‘word, term, name, symbol or device,’ . . . is entitled to protection under trademark law by focusing on whether that mark specifically identifies and distinguishes one company’s goods or services from those of its competitors.”⁹⁵ As to infringement, the crucial inquiry is whether or not there is a likelihood of confusion.⁹⁶ The adoption of this standard serves three societal interests.⁹⁷ First, an interest lies in protecting the public from being deceived.⁹⁸ Second, there is the plaintiff’s interest in “not having the fruit of his labor misappropriated.”⁹⁹ And third, protection under this standard promotes competition to the benefit of society.¹⁰⁰ When confusion is proven, a plaintiff is entitled to injunctive and monetary relief,¹⁰¹ while a preliminary injunction is often sought by trademark holders to stop continued

93. 15 U.S.C. § 1125(a) (2006).

94. *See* *Platinum Home Mortgage Corp. v. Platinum Fin. Group*, 149 F.3d 722, 726 (7th Cir. 1998) (where court upheld trial court’s ruling that use of the term “platinum” in a related business was permissible, on basis that mark was not inherently distinctive or possessed sufficient secondary meaning to be deemed worthy of protection).

95. *Id.*

96. *See id.* (“The infringement of a mark concerns whether the actions of a subsequent user of a substantially similar or identical mark causes a *likelihood of confusion* among consumers as to the source of those specific goods or services.”) (emphasis added); *see also* *New West Corp. v. NYM Co. of California, Inc.*, 595 F.2d 1194, 1201 (9th Cir. 1979) (“[U]nder the Lanham Act, . . . the ultimate test is whether the public is likely to be deceived or confused by the similarity of the marks Whether we call the violation infringement, unfair competition or false designation of origin, the test is identical is there a ‘*likelihood of confusion*?’”) (emphasis added).

97. *See* 1 MCCARTHY, *supra* note 89, § 2:1.

98. *Id.*

99. *Id.*

100. *Id.*

101. 15 U.S.C. §§ 1116-17 (2005).

infringement.¹⁰² Once the preliminary injunction is granted, “defendants in entertainment cases often settle,”¹⁰³ which can nevertheless prove to be extremely costly to infringers, “when major entertainment projects are involved.”¹⁰⁴

The phrase “false designation of origin” as used in § 43(a) forms the basis for a portion of those claims under which the likelihood of confusion test is applied,¹⁰⁵ with a common method of falsely designating often referred to as “passing off” (synonymous with “palming off”).¹⁰⁶ Passing off is an attempt to fool the purchaser into believing that the product of a subsequent entrant’s own creation is the product of the subsequent entrant’s competitor.¹⁰⁷ Passing off can be either express or implied.¹⁰⁸ Express passing off occurs when the infringer labels his own goods with another’s label, “or otherwise expressly misrepresents that the goods originated with another enterprise.”¹⁰⁹ Implied passing off is when the infringer uses another’s advertising materials, or the like, to misrepresent that the product the infringer is selling was produced by the other superior enterprise.¹¹⁰ The converse of passing off is commonly referred to as “reverse passing off.”¹¹¹ This “occurs when a person removes or obliterates the original trademark, without authorization, before reselling goods produced by someone else.”¹¹² Note that passing off seeks to take advantage of another’s label, while reverse passing off seeks either personal credit for the product itself or the chance to falsely introduce a “new” product that can be thought of as being

102. Joshua Beser, Comment, *False Endorsement Or First Amendment?: An Analysis of Celebrity Trademark Right and Artistic Expression*, 41 SAN DIEGO L. REV. 1787, 1799 (2004).

103. *Id.* In the Ninth Circuit, to receive a preliminary injunction, one must show “either a combination of probable success on the merits and possibility of irreparable injury, or the existence of serious questions going to the merits and that the balance of hardships tips sharply in his favor.” *Id.* at 1800.

104. *Id.* at 1799; *see also id.* at 1799 n.70 (citing the example of a potential preliminary injunction against the producers of the film “The Devil’s Advocate” for infringement of an artist whose bas-relief sculpture appeared in the film without authorization, potentially costing the studio and video stores upwards of \$42 million, as a result of being forced to suspend distribution and correct the violation).

105. 15 U.S.C. § 1125(a) (2005).

106. *See* 1 MCCARTHY, *supra* note 89, § 25.1.

107. *See* Pezon et Michel v. Ernest R. Hewin Assocs., Inc., 270 F. Supp. 423, 427 (S.D.N.Y. 1967) (where later entrant sought to use trademark of first entrant in marketing of fishing reels); *see also* Smith v. Montoro, 648 F.2d 602, 604 (9th Cir. 1981) (“[P]assing off” is the selling of a good or service of one’s own creation under the name or mark of another.”).

108. *Smith*, 648 F.2d at 604.

109. *Id.*

110. *Id.*

111. *Id.* at 605.

112. *Id.*

no worse than the original product. Reverse passing off can also be express or implied.¹¹³ Express reverse passing off occurs when another's trademark is removed, and the infringer sells the product under a new name chosen by the infringer.¹¹⁴ Implied reverse passing off occurs when another's trademark is removed or otherwise obliterated, and the product is sold "in an unbranded state."¹¹⁵

In *Smith v. Montoro*,¹¹⁶ the actor Paul Smith contracted to receive top billing for the film "Convoy Buddies."¹¹⁷ When the film was distributed however, Smith's name was removed in favor of the name of another actor, Bob Spencer.¹¹⁸ The Ninth Circuit reversed the district court's judgment that granted a motion to dismiss for failure to state a federal claim, holding that Smith had standing to sue under § 43(a) based on an allegation of express reverse passing off.¹¹⁹ *Smith* demonstrates the breadth of trademark rights. It establishes that even though the primary purpose of the Lanham Act is to eliminate the misuse of trademarks, it also seeks "to eliminate other forms of misrepresentation which are of the same general character even though they do not involve any use of what can technically be called a trademark."¹²⁰ As such, Smith has rights associated with the use and misuse of his own name.¹²¹ The court explains that in cases involving reverse passing off, "the originator of the misidentified product is involuntarily deprived of the advertising value of its name and of the goodwill that otherwise would stem from public knowledge of the true source of the satisfactory product."¹²² In 2003, the Supreme Court recognized reverse passing off as a valid cause of action under the Lanham Act.¹²³

113. *Id.*

114. *Id.* Express reverse passing off has repeatedly been found to be actionable as a "false designation of origin" under § 43(a). *See id.* at 606 (citing *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1216 (8th Cir. 1976)) (holding that a farm equipment manufacturer's removal of a competitor's label on a trailer in sales literature, replaced with a label indicating it to be the defendant's brand constituted a "false designation of origin," actionable under § 43(a)).

115. *Smith*, 648 F.2d at 605.

116. *See id.* at 602.

117. *Id.* at 603.

118. *Id.*

119. *Id.* at 602-03, 608.

120. *Id.* at 605 n.3 (citing *F.E.L. Publ'ns v. Nat'l Conference of Catholic Bishops*, 466 F. Supp. 1034, 1044-45 n.15 (N.D. Ill. 1978) (quoting *Fed.-Mogul-Bower Bearings, Inc. v. Azoff*, 313 F.2d 405, 409 (6th Cir. 1963))).

121. *See Smith*, 648 F.2d at 607.

122. *Id.* at 607. The court adds: "Since actors' fees . . . [are] often based on the drawing power their name may be expected to have at the box office, being accurately credited for films in which they have played would seem to be of critical importance in enabling actors to sell their 'services,' i.e., their performances." The court as well points out that another effect of such reverse passing off is that the consumer "is also deprived of knowing the true source of the product and may even be deceived into believing that it comes from a different source." *Id.*

123. *See Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 30, 35-36 (2003) (holding that public domain materials are not restricted by the law of trademarks, and also

2. The Dilution Doctrine

Prior to 1995, the likelihood of confusion standard ruled the roost, as trademark infringement focused primarily on the public's ability to properly identify the source of goods, "free from confusion, deception and mistake."¹²⁴ Protection did exist in the form of the anti-dilution statutes of twenty-five states, which helped in establishing relevant precedents, though its legal stature was that of "second-class citizenship."¹²⁵ With the enactment of the Federal Trademark Dilution Act ("FTDA")¹²⁶ however, a new federal cause of action was created for the purpose of protecting the "whittling away of the enormously valuable but hard to measure distinctive quality" of trademarks,¹²⁷ "regardless of the presence or absence of . . . [a] likelihood of confusion . . ."¹²⁸ This Act was written specifically to protect the narrow private interest of famous marks "from unauthorized users that attempt to trade upon the goodwill and established renown of such marks and, thereby, dilute their distinctive quality."¹²⁹ All trademarks are distinctive, yet only a few are famous.¹³⁰ Section 43(c)(1) of the Lanham Act provides a non-exhaustive list of factors that courts can look to in determining whether or not a mark is famous, thereby qualifying for protection under the FTDA.¹³¹ Some of the factors considered include duration, geography, and the degree of recognition by the public.¹³²

The FTDA protects famous marks from two forms of dilution, blurring and tarnishment.¹³³ Blurring occurs when "a prospective customer sees the plaintiff's mark used by other persons to identify different sources of different goods and services, thus weakening the distinctive significance of the mark to identify and distinguish the source."¹³⁴ "Examples of blurring

recognizing the legal theory of reverse passing off).

124. 2-5A TRADEMARK PROTECTION AND PRACTICE § 5A.01[1] (MB & Co., Inc. 2005) [hereinafter MATTHEW BENDER].

125. *See id.*

126. 15 U.S.C. § 1125(c) (2005).

127. MATTHEW BENDER, *supra* note 124, § 5A.01[1]. *See also* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002) (quoting 4 MCCARTHY, *supra* note 89, §§ 24:67, 24:70 (2001)).

128. 15 U.S.C. § 1127 (2005) (defining "dilution").

129. H.R. REP. NO. 104-374 (1995).

130. *Id.*

131. 15 U.S.C. § 1125(c)(1) (2005).

132. *See id.*; *see also* Beser, *supra* note 102, at 1800-01.

133. *See* H.R. REP. NO. 104-374 ("The purpose . . . is to protect famous trademarks from subsequent uses that *blur* the distinctiveness of the mark or *tarnish* or disparage it, even in the absence of a likelihood of confusion.") (emphasis added).

134. *See* Beser, *supra* note 102, at 1801 (citing *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 306

would be ‘Pepsi’ in-line skates or ‘Microsoft’ lipstick.”¹³⁵ It involves the whittling away of a trademark’s selling power.¹³⁶ Tarnishment occurs when “a party’s unauthorized use of a famous mark is linked to products of poor quality or is portrayed in an unwholesome manner and therefore degrades the positive associations and the distinctive quality of the mark.”¹³⁷ The unwholesome portrayal of a mark is not limited to presentations of a fixed mark in pairings with unsavory products. An unwholesome portrayal can also include the alteration of a mark to a newly-fashioned undesirable state that dilutes the mark’s distinctiveness. In *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Celozzi-Ettelson Chevrolet, Inc.*,¹³⁸ the plaintiff sought protection from infringement of its trademarked slogan “The Greatest Show on Earth” by a car dealership using the slogan “The Greatest Used Car Show on Earth.”¹³⁹ It was not a matter of consequence that the two slogans were not identical. Rather, the court held that despite any likelihood of confusion,¹⁴⁰ because it is “a celebrated and famous mark that the public associates with the circus,”¹⁴¹ it deserves to be protected against dilution, the “insidious[] gnawing away at the value of a mark,”¹⁴² and any “dissonance” that may be caused by an altered use.¹⁴³

One case that can be looked at as having had a heavy influence upon the principles of dilution, prior to their codification in the FTDA, is the Second Circuit’s 1979 ruling in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*¹⁴⁴ There it was held that the distinct uniform of the Dallas Cowboys Cheerleaders constituted a valid trademark,¹⁴⁵ infringed upon

n.30 (D.N.J. 1998) (citing *Panavision Int’l L.P. v. Toeppen*, 945 F. Supp. 1296, 1304 (C.D. Cal. 1996), *aff’d without opinion*, 159 F.3d 1351 (3d Cir. 1998)).

135. *Panavision*, 945 F. Supp. at 1304.

136. *Id.*

137. *See Jews for Jesus*, 993 F. Supp. at 306 n.31 (citing *Panavision*, 945 F. Supp. at 1304).

138. 855 F.2d 480 (7th Cir. 1988).

139. *Id.* at 481. Ringling Bros. has aggressively sought protection for its slogan on many occasions, challenging uses that have “replaced the noun ‘show,’ such as ‘The Greatest Vacation Values on Earth,’ ‘The Greatest Store on Earth’ and ‘The Greatest Space on Earth,’” and others that have replaced the word “earth,” such as “The Greatest Show on Ice” and “The Greatest Show on Tape.” At least one challenge was against an infringer who replaced the preposition “on,” creating “The Greatest Show Under Earth,” to advertise caverns. *Id.* at 481 n.3.

140. *Id.* at 484.

141. *Id.* at 481.

142. *Id.* at 484.

143. *Id.* 484-85. The Supreme Court is clear however, that where the marks are not identical, a mere mental association between the two marks is not sufficient for an action of dilution. *See Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 433 (2003). It must be an association that either lessens the strength of the famous mark, or “reduce[s] the capacity of the famous mark to identify the goods of its owner.” *Id.* at 433-34.

144. 604 F.2d 200 (2d Cir. 1979).

145. *See id.* at 204. The Dallas Cowboys Cheerleaders, Inc. “employ thirty-six women who perform dance and cheerleading routines at Dallas Cowboys football games.” *Id.* at 202. They are “a wholly owned subsidiary of the Dallas Cowboys Football Club, Inc.” *Id.* In addition to performing at games, the cheerleaders make frequent television and commercial appearances,

when exhibited in the pornographic film “Debbie Does Dallas.”¹⁴⁶ The defendants argued that as “a purely functional item necessary for the performance of cheerleading routines,” the uniform was not capable of achieving trademark status.¹⁴⁷ The court held however that an item which is “incidentally functional” is not precluded from being designated as a trademark, and agreed with the plaintiff who did not claim a trademark in all cheerleading outfits, but rather “in the particular combination of colors and collocation of decorations that distinguish [the] plaintiff’s uniform from those of other squads.”¹⁴⁸ Once the court found that the plaintiff’s uniform was in fact a trademark, it determined that the potential public belief that the trademark owners approved of their mark’s association with something as unsavory as an adult film, despite there being little chance of the public believing the owners to be the actual producers of the film, was an injury sufficient to satisfy a finding for dilution.¹⁴⁹ The court noted that the purpose of trademark law is not only the prevention of consumer confusion but is also the protection of the rights of owners to control their product’s reputation.¹⁵⁰

As the situation dictates, the likelihood of confusion or dilution doctrines can be relied upon when seeking trademark protection. Each argument however should anticipate having to overcome potential First Amendment challenges by the alleged infringers.

performing at public events. *Id.* Also, the Dallas Cowboys Cheerleaders license their image for a number of products. *Id.* At all football games, public appearances, and on all commercial items, the cheerleaders can be seen wearing the same distinctive uniform. *Id.* “The familiar outfit consists of white vinyl boots, white shorts, a white belt decorated with blue stars, a blue bolero blouse, and a white vest decorated with three blue stars on each side of the front and a white fringe around the bottom.” *Id.*

146. *See id.* at 202 (“[A] gross and revolting sex film whose plot, to the extent that there is one, involves a cheerleader . . . Debbie, who has been selected to become a ‘Texas Cowgirl.’”). Among the many uses of the cheerleading uniform, both in the film and in promotional materials, is the film’s final scene where Debbie “for approximately twelve minutes of film footage engages in various sex acts while clad or partially clad in the uniform.” *Id.* at 203.

147. *Id.*

148. *Id.* *See also id.* at 204 n.6 (citing *Quabaug Rubber Co. v. Fabiano Shoe Co.*, 567 F.2d 154, 161 (1st Cir. 1977)) (“Although color alone is not capable of becoming a trademark, a combination of colors together with a distinctive arbitrary design may serve as a trademark.”).

149. *See id.* at 204-05; *see also id.* at 205 (quoting *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183, 1189 (E.D.N.Y. 1972)) (“[I]t is hard to believe that anyone who had seen defendants’ sexually depraved film could ever thereafter disassociate it from plaintiff’s cheerleaders. This association results in confusion which has ‘a tendency to impugn . . . and injure plaintiff’s business reputation . . .’”).

150. *See id.* at 205 (citing *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 274 (7th Cir. 1976)).

3. The First Amendment Defense to Trademark Infringement

Generally speaking, trademark law does not come in conflict with one's First Amendment rights,¹⁵¹ as a result of the lower level of Constitutional protection afforded to commercial speech.¹⁵² Where the two worlds collide, however, is when a trademark is also an artistic expression, which receives a much higher level of protection.¹⁵³ This collision, sometimes referred to as "hybrid speech,"¹⁵⁴ is not controlled by either its commercial or artistic underpinnings,¹⁵⁵ as courts instead have attempted to strike a balance between the First Amendment rights of artists and the Lanham Act's protection of trademark owners (who may also be artists in their own right).¹⁵⁶ Courts however, have yet to agree on a singular approach for striking this balance, as three tests have emerged as the favorites.

The Ninth and Tenth Circuits have both applied a simple likelihood of confusion test, the same test used for non-First Amendment trademark disputes.¹⁵⁷ There are two versions of the likelihood of confusion test; one

151. U.S. CONST. amend. I ("Congress shall make no law . . . prohibiting the free exercise thereof; or abridging the freedom of speech . . .").

152. See Stephanie Dotson Zimdahl, Comment, *A Celebrity Balancing Act: An Analysis of Trademark Protection Under the Lanham Act and the First Amendment Artistic Expression Defense*, 99 Nw. U. L. REV. 1817, 1825 (2005); see also *id.* at 1825 & n.54 (citing *Silverman v. CBS Inc.*, 870 F.2d 40, 48 (2d Cir. 1989) (quoting *Friedman v. Rogers*, 440 U.S. 1, 11 (1979))) ("Ordinarily, the use of a trademark to identify a commodity or a business 'is a form of *commercial speech* and nothing more.") (emphasis added); *id.* at 1825 n.55 (citing *Dunn & Bradstreet, Inc. v. Greenmoss Builders*, 472 U.S. 749, 760 (1985)) ("Commercial speech receives a lower, although still substantial, level of protection under First Amendment jurisprudence."); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 735 (D. Minn. 1998) (in reaching its decision, the court "not[es] the somewhat lesser protection afforded commercial speech"). While the level of protection is still somewhat substantial, commercial speech can be constitutionally suppressed when applying the test outlined in *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557, 564 (1980). The Court there held that "[i]f the communication is neither misleading nor related to unlawful activity, the government's power is more circumscribed. The State must assert a substantial interest to be achieved by restrictions on commercial speech. Moreover, the regulatory technique must be in proportion to that interest." *Id.*

153. See Zimdahl, *supra* note 152, at 1826; see also *id.* at 1826 n.57 (quoting *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 602 (1998)) ("It goes without saying that artistic expression lies within this First Amendment protection."); *Finley*, 524 U.S. at 603 (quoting *Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622, 641 (1994)) ("[A]rt is entitled to full protection because our 'cultural life . . . rests upon [the] ideal' of governmental viewpoint neutrality.").

154. See Zimdahl, *supra* note 152, at 1826 n.62. Zimdahl notes that "[c]ourts sometimes refer to this sort of speech as 'hybrid speech' – speech where commercial advertisement and promotion is 'inextricably intertwined' with expressive speech." *Id.* (citing *O'Grady v. Twentieth Century Fox Film Corp.*, No. 5:02CV173, 2003 U.S. Dist. LEXIS 24936, at *40-41 (E.D. Tex. Dec 19, 2003)).

155. See Zimdahl, *supra* note 152, at 1826-27.

156. *Id.* at 1827.

157. See *id.* at 1828 & n.75. The Ninth Circuit applied the likelihood of confusion test in *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997). There, the plaintiff alleged trademark infringement of its book *The Cat in the Hat* against publishers who released a rhyming summary of the O.J. Simpson trial titled *The Cat NOT in the Hat! A Parody by Dr. Juice*. *Id.* at 1396. The court noted that "[l]ikelihood of confusion' is the basic test for both common law trademark infringement and federal statutory trademark infringement." *Id.* at 1403.

version applies the *Sleekcraft* factors,¹⁵⁸ the other applies the *Polaroid* factors.¹⁵⁹ The eight factors considered under a *Sleekcraft* approach are: (1) the strength of the plaintiff's mark; (2) the proximity of the two products underlying the mark; (3) the similarity of the actual marks; (4) any evidence of actual confusion; (5) the marketing channels that are used; (6) the general type of goods and the degree of care likely to be exercised by the purchaser; (7) the defendant's intent in selecting the mark; and (8) the likelihood of an expansion of the product lines.¹⁶⁰ The eight factors considered under the very similar *Polaroid* approach are: (1) the strength of the plaintiff's mark; (2) the similarity between the two marks; (3) the proximity of the products; (4) the likelihood that the prior owner will bridge the gap between the two markets; (5) whether there is actual confusion; (6) the defendant's good faith in adopting its mark; (7) the quality of the defendant's product; and (8) the sophistication of the buyers.¹⁶¹ Clearly the components of each test subsume agnate principles, with the most notable distinction being the seventh *Polaroid* factor,¹⁶² a qualitative test that appears to be speaking directly to the issue of dilution.¹⁶³ "The list of factors is not a scorecard – whether a party 'wins' a majority of the factors is not the point."¹⁶⁴ Furthermore, the factors should not "be rigidly weighed; we do not count beans."¹⁶⁵ The weight of each factor is determined on a case by case basis,¹⁶⁶ and "always involves a very fact-intensive inquiry for the judge or jury."¹⁶⁷ This approach has been criticized for not directly addressing the First

Similarly, in *Cardtoons, L.C. v. Major League Baseball Players Ass'n.*, 95 F.3d 959 (10th Cir. 1996), the Tenth Circuit applied a likelihood of confusion test in balancing the First Amendment rights of the defendant who produced cartoon trading cards that parodied major league baseball players, against the plaintiff's intellectual property rights. *See id.* at 967.

158. The *Sleekcraft* test is based on the eight factors the court weighed in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979) (applying the test in determining the likelihood of confusion between Slickcraft boats and Sleekcraft boats).

159. The *Polaroid* test is based on the eight factors the court weighed in *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir. 1961) (applying the test in determining the likelihood of confusion between Polaroid and Polarad).

160. *Sleekcraft*, 599 F.2d at 348-49.

161. *Polaroid*, 287 F.2d at 495.

162. *See id.*

163. *See generally infra* Part II.2.

164. *Thane Int'l v. Trek Bicycle Corp.*, 305 F.3d 894, 901 (9th Cir. 2002) (applying the test in determining the likelihood of confusion between the OrbiTrek exercise machine and TREK bicycles).

165. *Id.* (quoting *Dreamwerks Prod. Group v. SKG Studio*, 142 F.3d 1127, 1129 (9th Cir. 1998)) (applying the test in determining the likelihood of confusion between the lesser known but senior mark Dreamwerks, an organizer of "Star Trek" conventions, and the DreamWorks film studio).

166. *Id.*

167. Zimdahl, *supra* note 152, at 1829.

Amendment concerns,¹⁶⁸ but its defenders rationalize that the likelihood of confusion test still must precede any Constitutional inquiry, and that the necessary protections for that inquiry are built into the factors based approach.¹⁶⁹

The Second Circuit, and even more recently the Eighth Circuit, have endorsed an approach known as the alternative avenues test.¹⁷⁰ This test simply asks whether the defendant has an alternative non-infringing means of communicating the message for which they are seeking First Amendment protection.¹⁷¹ While the search for alternatives is the essence of this test, there nevertheless appears to be a troubling inconsistency in how courts define the concept of “avenues.” In *Mutual of Omaha Insurance Co. v. Novak*,¹⁷² the alternative avenue available to the defendant refers to the means of distributing the idea. The court determined that First Amendment rights were not impacted when a message could be delivered through another medium, such as books, magazines, or films, as opposed to the defendant’s preferred method of choice, a T-shirt.¹⁷³ Alternately, in *American Dairy Queen Corp. v. New Line Productions*,¹⁷⁴ where the plaintiff charged infringement against a movie studio’s release of a film titled “Dairy Queens,” a ruling in favor of the plaintiff was based on the defendant’s ability to redraft their entire expression and create an alternate title, such as “Dairy Princesses” or “Milk Maids.”¹⁷⁵ The difference

168. See *Parks v. LaFace Records*, 329 F.3d 437, 449 (6th Cir. 2003) (“[The] unmodified application of the likelihood of confusion factors . . . gives no weight to First Amendment concerns . . . this approach ignores the fact that the artistic work is *not* simply a commercial product but is also a means of communication.”).

169. See Zimdahl, *supra* note 152, at 1829 & n.93 (citing *Films of Distinction, Inc. v. Allegro Film Prods., Inc.*, 12 F. Supp. 2d 1068, 1078 (C.D. Cal. 1998)) (“The Ninth Circuit’s brief discussion of the issue in *Dr. Seuss* strongly suggests that this ‘balancing’ has already been adequately accomplished by the statutory framework.”).

170. See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979). In *Dallas Cowboys Cheerleaders*, discussed *infra* Part II.2, the defendants asserted a First Amendment defense, claiming that their film “Debbie Does Dallas” served as a commentary on “sexuality in athletics.” *Id.* at 206. The court found that the filmmakers’ “barely discernible message” could be conveyed in “numerous ways . . . without infringing [the] plaintiff’s trademark.” *Id.* In *Mutual of Omaha Insurance Co. v. Novak*, 836 F.2d 397 (8th Cir. 1987), the Eighth Circuit upheld an injunction against the defendant that prevented the sale of anti-war merchandise containing the phrase “Mutants of Omaha.” The court noted that “the protection afforded by the First Amendment does not give Novak license to infringe the rights of Mutual. Mutual’s trademarks are a form of property, and Mutual’s rights therein need not ‘yield to the exercise of First Amendment rights under circumstances where adequate *alternative avenues* of communication exist.” *Id.* at 402 (quoting *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972)) (emphasis added) (citations omitted).

171. See *Novak*, 836 F.2d at 402. The court held that since Novak had other avenues to express his views, such as through books, magazines, or films, that his First Amendment rights were not violated. *Id.*

172. 836 F.2d 397 (8th Cir. 1987).

173. *Novak*, 836 F.2d at 402.

174. 35 F. Supp. 2d 727 (D. Minn. 1998).

175. *Id.* at 734 (“It is not for this Court to name films, but it appears [the defendant] has rejected

between the two holdings is palpable. Whereas in *Novak*, the court determined that a more suitable method of conveyance was available for the desired artistic expression, *American Dairy Queen* focused its attention on the expression itself.¹⁷⁶ Both approaches seemingly require a substantial abandonment, with the latter finding little harm in what it may consider to be only a tweaking of the expression. However, if the newly conceived movie title “Dairy Princesses” does not capture the true essence of what the filmmakers had intended to express with the title “Dairy Queens,” then though it may be an available alternative, it is nevertheless a diminished one.¹⁷⁷

Under either set of circumstances, it does not appear that the alternative avenues test provides the defendant a level of First Amendment protection that is significantly higher than the level of protection afforded to commercial speech.¹⁷⁸ Perhaps this discrepancy highlights the most common criticism of the alternative avenues test, which is that it is wrought with an exceptional amount of subjectivity.¹⁷⁹ The fact that the court in *American Dairy Queen* even suggests that it personally finds suitable an alternate title, hints at justice run amok, as any test that moves a judge from the bench to the director’s chair or musician’s console, is not one that can fully succeed at striking the necessary balance.¹⁸⁰

ideas such as ‘Dairy Princesses,’ ‘Milk Maids,’ or any other formulation, except that single title which touches [the plaintiff’s] mark.”). Once prohibited from releasing their film under the title “Dairy Queens,” New Line did not adopt either of the suggested alternatives, and instead released the film which starred Kirsten Dunst and Denise Richards under the title “Drop Dead Gorgeous.” See Internet Movie Database (IMDb), <http://imdb.com/title/tt0157503/> (last visited Feb. 14, 2006). The film’s total domestic gross was a little over \$10.5 million, approximately \$16.5 million below its production and marketing costs. See Box Office Mojo, <http://boxofficemojo.com/movies/?id=dropdeadgeorgeous.htm> (last visited Feb. 14, 2006).

176. Compare *Novak*, 836 F.2d at 402, with *American Dairy Queens*, 35 F. Supp. 2d at 734.

177. Mark Twain once noted that “[t]he difference between the almost-right word and the right word is really a large matter – it’s the difference between the ‘lightning-bug’ and the ‘lightning.’” *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003) (citing JOHN BARTLETT, *FAMILIAR QUOTATIONS* 527 (16th ed. 1992)). Twain also once wrote, that “[t]o get the right word in the right place is a rare achievement.” See Charity Vogel, *Make Your Mark by Drawing Your Own Twain Conclusion*, BUFFALO NEWS, March 1, 2001, at 1B. See also *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) (“Film-makers and authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works The subtleties of a title can enrich a reader’s or a viewer’s understanding of a work.”).

178. See *supra* notes 154-56 and accompanying text (comparing First Amendment protection for commercial speech vis-à-vis artistic expression).

179. See *Beser*, *supra* note 102, at 1820 (“The alternative avenues test is exceptionally subjective.”).

180. See *Beser*, *supra* note 102, at 1821 (quoting *Cohen v. California*, 403 U.S. 15, 26 (1971)) (“We cannot indulge the facile assumption that one can forbid particular words without running a substantial risk of suppressing ideas in the process.”).

The third approach, and the one most recently applied by the Second Circuit, and then later followed by the Fifth, Sixth and Ninth Circuits,¹⁸¹ is the *Rogers* test, a product of *Rogers v. Grimaldi*.¹⁸² There, the actress Ginger Rogers sought to prevent “Ginger and Fred” from being used as the title of a Federico Fellini film that told the story of two fictional characters who rose to fame in Italy by imitating the performances of Rogers and Fred Astaire.¹⁸³ The court recognized this as the classic hybrid scenario, where Rogers’ right to prevent the public’s belief in her endorsement under the Lanham Act was in direct conflict with the filmmakers’ First Amendment rights.¹⁸⁴ Their solution for balancing these competing interests was to introduce a two-pronged test that protects the artistic expression unless (1) “the title has no artistic relevance to the underlying work whatsoever,” or, (2) it has artistic relevance, but “the title explicitly misleads as to the source or the content of the work.”¹⁸⁵ Since the title here, “Ginger and Fred,” was not “arbitrarily chosen just to exploit the publicity value of their real life counterparts but instead ha[d] genuine relevance to the film’s story,” the defendants were not in violation under the first prong.¹⁸⁶ As to the sponsorship prong, the defendants proved to be within their rights as well, since there was “no explicit indication that Rogers endorsed the film or had a role in producing it.”¹⁸⁷ Therefore, the filmmakers were permitted to title the film as they so desired.¹⁸⁸

The outcome was different however in 2003, when the *Rogers* test was applied in *Parks v. LaFace Records*.¹⁸⁹ There, the late civil rights icon Rosa Parks¹⁹⁰ brought a Lanham Act action against the rap music duo OutKast for

181. The Fifth Circuit applied the test in *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664-65 (5th Cir. 2000). The Sixth Circuit applied the test in *Parks v. LaFace Records*, 329 F.3d 437, 450 (6th Cir. 2003). The Ninth Circuit applied the *Rogers* test in *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 902 (9th Cir. 2002).

182. 875 F.2d 994 (2d Cir. 1989).

183. *Id.* at 996-97.

184. *See id.* at 998 (“Titles, like the artistic works they identify, are of a hybrid nature, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker’s expression as well as a significant means of marketing the film to the public.”).

185. *Id.* at 999; *see also* *Twin Peaks Prods. v. Publ’ns Int’l, Ltd.*, 996 F.2d 1366, 1379 (2d Cir. 1993) (applying the *Rogers* test in determining whether the title of the book *Welcome to Twin Peaks: A Complete Guide to Who’s Who and What’s What*, based on the first eight episodes of the David Lynch television series “Twin Peaks,” infringed on that series’ rights under the Lanham Act).

186. *See Rogers*, 875 F.2d at 1001.

187. *Id.*

188. *See id.* at 1005.

189. 329 F.3d 437 (6th Cir. 2003).

190. *Id.* at 441. Rosa Parks first gained prominence in 1955 when she refused to surrender her seat on a segregated bus in Montgomery, Alabama to a white passenger. *Id.* at 442. “Her single act of defiance has garnered her numerous public accolades and awards, and she has used that celebrity status to promote various civil and human rights causes as well as television programs and books inspired by her life story.” *Id.*

using her name as the title for one of their hit songs.¹⁹¹ In applying the *Rogers* test, the court determined that although there was no violation of Parks' rights under the second prong, since the title did not explicitly indicate that Parks endorsed the song,¹⁹² the defendants nevertheless failed to satisfy the first prong.¹⁹³ The court found it "highly questionable" whether the song's title was artistically related to the song's content, and remanded the issue to the trial court for a full evidentiary hearing on the matter.¹⁹⁴ The court noted that if on remand it is determined that OutKast used the title "Rosa Parks" to identify a song "to which it had no artistic relevance at all, then this would constitute a violation of the Lanham Act and judgment should be entered in favor of [the] [p]laintiff."¹⁹⁵ However, if the title is determined to be "artistically relevant to the song's content, then the inquiry is at an end," since the title is not misleading under the sponsorship prong.¹⁹⁶

The *Rogers* approach certainly raises some of the same concerns as the alternative avenues test, given that *Rogers* also requires a court to make subjective determinations in passing judgment on a title's artistic relevance to its content.¹⁹⁷ This is evident in *Parks*, where the court is forced to rely on "various electronic 'dictionaries' of the 'rap' vernacular to demonstrate that the song truly has nothing to do with Parks herself."¹⁹⁸ Nevertheless, a distinction can be drawn between a court being asked to find whether a relationship exists between "A" and "B," as occurs under *Rogers*, and their being asked to jettison "A," and conceive of a suitable replacement, as called for under the alternative avenues test. When comparing the two, it would still seem that *Rogers* is an improvement when it comes to striking a fair balance.

Finally, before returning to the facts of our case, we will first examine

191. *Id.* at 442 ("In September 1998, Defendants released the album *Aquemini*. The album's first single release was a song titled *Rosa Parks*, described as a 'hit single' by a sticker on the album. The same sticker that contained the name *Rosa Parks* also contained a Parental Advisory warning of 'explicit content.'").

192. *See id.* at 458.

193. *See id.* at 458-59.

194. *Id.* at 459.

195. *Id.* It appears that one of the members of OutKast, Andre Benjamin, erred by commenting in an interview following the filing of the lawsuit, that the use of Parks' name was merely "symbolic." *Id.* at 454. Benjamin likely assumed that this show of respect would aid his cause, but the court felt that "[w]here an artist proclaims that a celebrity's name is used merely as a 'symbol' for the lyrics of a song, and such use is highly questionable when the lyrics are examined, a legitimate question is presented as to whether the artist's claim is sincere or merely a guise to escape liability." *Id.*

196. *Id.*

197. *See id.* at 452.

198. *Id.*

the state cause of action that is most likely to be asserted by the plaintiff.

C. *The Right of Publicity*

An individual has a common law right “to control the commercial value and exploitation of his name and picture or likeness and to prevent others from unfairly appropriating this value for their commercial benefit.”¹⁹⁹ At least twelve states “supplement, or displace in few instances, the common law right with statutory protections.”²⁰⁰ The right of publicity is a descendant of the right of privacy,²⁰¹ with the former reserved for those in the public eye, while the latter is the claim commonly asserted by private individuals.²⁰² This distinction was the result of the recognition early on “that it is somewhat anomalous to speak of a celebrity or public figure being

199. *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1353 (D.N.J. 1981) (where the estate of Elvis Presley brought a right of publicity claim against the defendant for his performance of THE BIG EL SHOW, a stage show featuring an individual who impersonates Elvis Presley); *see also* *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868-69 (2d Cir. 1953) (first recognizing the right to publicity in holding that one has “the right to grant the exclusive privilege of publishing his picture”).

200. *See* VICTOR E. SCHWARTZ, ET AL., PROSSER, WADE AND SCHWARTZ’S TORTS 941 (10th ed. 2000) [hereinafter PROSSER, WADE AND SCHWARTZ’S TORTS].

201. *See* Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 195 (1890) (quoting THOMAS M. COOLEY, A TREATISE ON THE LAW OF TORTS, OR THE WRONGS WHICH ARISE INDEPENDENT OF CONTRACT 29 (2d ed. 1888)) (describing the right of privacy as the “right ‘to be let alone’”). “It is a testament to the persuasive authority of the legal commentators that the development of the right of privacy commenced with [this] seminal article by Samuel Warren and Louis Brandeis.” David R. Ginsburg, *Transfer of the Right of Publicity: Dracula’s Progeny and Privacy’s Stepchild*, 22 UCLA L. REV. 1103, 1103 (1975); *see also* Joseph Siprut, *Privacy Through Anonymity: An Economic Argument for Expanding the Right of Privacy in Public Places*, 33 PEPP. L. REV. 311, 314-15 (2006) (“This right, Warren and Brandeis argued, should be recognized as an independent tort, and several years later it was explicitly so recognized.”).

202. *See* Howard I. Berkman, *The Right of Publicity-Protection For Public Figures and Celebrities*, 42 BROOK. L. REV. 527, 529 (1976). Some celebrities who have brought right of publicity claims include: Bette Midler, *Vanna White*, Kareem Abdul-Jabbar, Muhammad Ali, and Johnny Carson. *See* PROSSER, WADE AND SCHWARTZ’S TORTS, *supra* note 200, at 942 (citing *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (holding that the use of a sound-alike voice in commercials infringed on singer’s right of publicity); *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395 (9th Cir. 1992) (reversing summary judgment granted to defendants in finding a right of publicity claim sufficient to go to a jury where advertisements displayed a Vanna White robot); *Abdul-Jabbar v. Gen. Motors Corp.*, 75 F.3d 1391 (9th Cir. 1996) (reversing summary judgment granted to defendants on right of publicity claim where plaintiff’s previous name, Lew Alcindor, was used as the answer to a trivia question in a television commercial); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978) (granting a preliminary injunction on a right of publicity claim where defendant published an objectionable portrait of a nude black man in a boxing ring, that was unmistakably the plaintiff); *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (finding a toilet rental company’s use of the phrase “Here’s Johnny” violated the talk-show host’s right of publicity). *Cf.* *Peay v. Curtis Publ’g Co.*, 78 F. Supp. 305 (D.D.C. 1948) (holding a right of privacy action could sufficiently be brought when photograph of taxi driver was used in article depicting all taxi drivers in a negative light); *Gill v. Curtis Publ’g Co.*, 38 Cal. 2d 273 (1952) (where plaintiffs, a married couple, were entitled to bring right of privacy action when their photograph was used without authorization in *Ladies’ Home Journal* for article about the “wrong kind of love”).

hurt by having his or her name or picture widely circulated.”²⁰³ While the private citizen may avoid publicity, “the public figure virtually always seeks it.”²⁰⁴ A right of privacy suit is based on the “commercial appropriation of a private individual’s name or picture, [and] the correct measure of damages is the extent of injury to the individual’s feelings and not the value that the defendant received from the unauthorized use of his name or picture.”²⁰⁵ Alternately, a right of publicity suit is not based on hurt feelings, but is a pecuniary injury based on the denial of compensation for endorsements, and the property rights that one has in their name and likeness.²⁰⁶

It is worth noting the wide deference of courts in defining these rights. In *Uhlaender v. Henricksen*,²⁰⁷ a group of major league baseball players objected to the use of their names and performance statistics, in conjunction with a table top baseball game manufactured by the defendants.²⁰⁸ Acknowledging that the defendants were correct in their assertion that there was “nothing offensive nor demeaning about the way the names [were] used,” the plaintiffs still “believe[d] and consider[ed] their names to have financial value and that they . . . did not consent to the use thereof by defendants without an arrangement for payment of a royalty or fee.”²⁰⁹ The plaintiffs presented this as a right of privacy tort, but the court properly recognized the invasion as one of the right of publicity,²¹⁰ concluding that the plaintiffs were entitled to relief under that cause of action.²¹¹

While *Uhlaender* represents one end of the spectrum, the seemingly more obvious line of cases where the action can be brought, the less obvious end is perhaps best represented by *Motschenbacher v. R.J. Reynolds Tobacco Co.*²¹² There, a photograph was used, not of the plaintiff, but of the plaintiff’s distinctive racing car, in advertising the defendants’ brand of cigarettes.²¹³ The Ninth Circuit determined that though the plaintiff’s actual

203. See Berkman, *supra* note 202, at 529.

204. *Id.*

205. *Id.* at 533.

206. *Id.*

207. 316 F. Supp. 1277 (D. Minn. 1970).

208. *Id.* at 1278.

209. *Id.* at 1279.

210. *Id.* (“The complaint . . . does not predicate its claim for relief upon any assertion of a right to be let alone. Instead, plaintiffs’ claim ‘misappropriation and use for commercial profit of the names of professional major league baseball players without the payment of royalties.’”).

211. *Id.* at 1283.

212. 498 F.2d 821 (9th Cir. 1974).

213. *Id.* at 822. The Ninth Circuit did not classify the invasion here under the heading of either the right of privacy or the right of publicity. See Berkman, *supra* note 202, at 539 n.63. Nevertheless, “[d]espite the court’s reluctance to characterize the right in question explicitly, it

name or likeness were not used, the driver's "identifiability" through the appropriation of his car, constituted an invasion.²¹⁴ In addition, alterations made to the photograph, such as transforming the car's number from an "11" to a "71" were not of consequence, and did not "preclude a finding of identifiability"²¹⁵

The consequence of the right of publicity being termed a property right, is that it allows for the possibility that the right survives the death of the owner, and is thus alienable and inheritable.²¹⁶ The first case to recognize the descent of publicity rights was *Lugosi v. Universal Pictures Co.*,²¹⁷ where the widow and son of the late actor Bela Lugosi brought a right of publicity action against the producers of a series of "Dracula" films that starred Lugosi.²¹⁸ The suit alleged infringement, based on the licensing by the defendants of items such as shirts and games bearing Lugosi's likeness.²¹⁹ The court held that the rights in question did not die with Lugosi, and therefore, Lugosi's beneficiaries by will were entitled to recover.²²⁰

Nevertheless, courts do differ on the right of publicity's inheritability,²²¹ and as a result, choice of law rules will play a part in determining which jurisdiction's laws govern the issue. California²²² has long recognized the

seems clear that the invasion in *Motschenbacher* was to plaintiff's right of property; surely there was nothing in the advertisement that would injure the feelings of a publicity seeker such as plaintiff, a famous racing car driver." *Id.*

214. See *Motschenbacher*, 498 F.2d at 826-27.

215. *Id.* at 827.

216. See PROSSER, WADE AND SCHWARTZ'S TORTS, *supra* note 200, at 942. Alternately, the right of privacy is classified as a personal right that dies with the individual. See *id.*

217. See Ginsburg, *supra* note 201, at 1113 (citing *Lugosi v. Universal Pictures Co.*, 172 U.S.P.Q. 541 (Cal. Super. Ct. 1972)).

218. See *Lugosi*, 172 U.S.P.Q. at 544.

219. *Id.*

220. *Id.* at 549. Also at issue in the case was whether Lugosi actually held any rights in the character of Dracula, or whether those rights were held by the owners of the films' copyrights. See Berkman, *supra* note 202, at 544. The court held that "the very essence of the Count Dracula character . . . consists of the characteristics, makeup, appearance and mannerisms of Bela Lugosi in the role. . . . Count Dracula, as taken from the films, . . . , cannot be divorced from Bela Lugosi's appearance in the role." *Id.* at 550. The sentiment of the *Lugosi* court was echoed by the actor Martin Landau in his Academy Award winning portrayal of Bela Lugosi, in the film "Ed Wood." Landau's Lugosi lambastes Boris Karloff's portrayal of Frankenstein, irately noting: "You think it takes talent to play Frankenstein? It's all makeup . . . and grunting. . . . Dracula requires presence. It's all in the eyes, and the voice, and the hand." See ED WOOD (Touchstone Pictures 1994).

221. Compare *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 221 (2d Cir. 1978) ("[T]he right of publicity should survive the celebrity's death."), and *Jim Henson Prods., Inc. v. John T. Brady & Assocs., Inc.*, 867 F. Supp. 175, 190 (S.D.N.Y. 1994) ("Accordingly, I hold that Connecticut would interpret the right of publicity as descendible. Summary judgment against the publicity claim is denied."), with *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956, 957 (6th Cir. 1980) (holding that under Tennessee law the right of publicity is not inheritable by the father of Elvis Presley).

222. The Ninth Circuit in California serves as the most popular venue for right of publicity cases, given the glut of celebrities found in that locale. See PROSSER, WADE AND SCHWARTZ'S TORTS,

common law maxim of *mobilia sequuntur personam*, which “dictates that personal property is generally controlled by the law of a decedent’s domicile at the time of his or her death.”²²³ A slightly different approach is taken by the state of New York, where the “choice of law rules focus on the situs of the property and, therefore, on the residence of the plaintiff, to determine whether a plaintiff has a protectible right of publicity.”²²⁴

It is apparent that a strong relationship exists between the right of publicity and the rights in a trademark.²²⁵ “The goodwill which a trademark symbolizes is a first cousin to the goodwill, or reputation and fame, of [a] celebrity.”²²⁶ As such, it only stands to reason that similar to trademark infringement actions, the First Amendment will also be raised as a defense against right of publicity claims. While the news media will be afforded a degree of protection within what are some already defined limits,²²⁷ First Amendment privileges can not generally be relied upon when the use of one’s name implies endorsement of a product or effects the goodwill associated with that name.²²⁸

Having thoroughly reviewed these three areas of law, we are now prepared to apply this law to our potentially litigable circumstance.

III. ANALYSIS OF THE HYPOTHETICAL CASE: *ESTATE OF LENNON V.*

supra note 200, at 941. It stands to reason that New York’s Second Circuit Court of Appeals would likely follow as the second most popular venue. As noted, the Second Circuit has held that the right of publicity is inheritable. *See supra* note 221.

223. *See Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013, 1026 (C.D. Cal. 1998) (“[W]hether a right to publicity in Princess Diana’s name and likeness passed to her Estate is a question controlled by the law of her domicile at the time of her death: Great Britain.”).

224. *See id.* at 1029 (citing *Bi-Rite Enter., Inc. v. Button Master*, 555 F. Supp. 1188, 1197 (S.D.N.Y. 1983) (citing *Groucho Marx Prods. v. Day & Night Co.*, 689 F.2d 317, 319 (2d Cir. 1982))).

225. MATTHEW BENDER, *supra* note 124, § 2.16[1]. McCartney, for instance, owns a right of publicity in his name, picture or likeness, but has also recently applied for trademark protection in just his name for use on a line of vegetarian food and clothing items. *See Macca on the Mark*, DAILY RECORD (Scotland), Oct. 14, 2006, at 24.

226. *Id.*

227. *See Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977) (where the plaintiff’s “human cannonball” act, which lasted for fifteen seconds, was televised in its entirety by the defendant on its evening news program, the Court held that though news media enjoys First Amendment protection, the defendant could not televise the plaintiff’s entire act without compensation).

228. *See, e.g., Palmer v. Schonhorn Enters., Inc.*, 96 N.J. Super. 72, 78 (N.J. Super. Ct. 1967) (quoting *Gautier v. Pro-Football, Inc.*, 304 N.Y. 354, 359 (N.Y. 1952)) (“While one who is a public figure or is presently newsworthy may be the proper subject of news or informative presentation, the privilege does not extend to commercialization of his personality through a form of treatment distinct from the dissemination of news or information.”).

MCCARTNEY

When it comes to the initial matter of whether transposing the names Lennon and McCartney in a songwriting credit raises any claim upon which relief can be granted, there are clearly two opposing schools of thought. Music law expert Donald S. Passman²²⁹ has been attributed as arguing that while “omitting Lennon’s name altogether from a Beatles song credit would be cause for legal action by the late star’s estate . . . merely transposing the credit likely [is] not because it does not seem to misrepresent the true authorship or *damage the song as a property*.”²³⁰ The counter-argument however, is one that goes beyond the black letter of the law, and in applying the law, factors in the transcendent nature of the Beatles. David Sheff, the journalist who sat with Lennon for his last interview,²³¹ is quoted as saying: “There’s something about ‘Lennon/McCartney’ that means more than just whose name comes first. For Beatles fans, this switch dishonors something that is cherished by so many people.”²³² This Comment endorses the latter view, as Sheff’s opinion articulates precisely why relief can and should be granted. The intangible of Beatles lore, touched on in Part I,²³³ encompasses all things Beatles and a universe unto itself, inhabited by many of the fans to whom Sheff refers. There is a communal aspect to the Beatles that can not be denied, where each element of the band, and their song package, whether it be the music, lyrics, titles, or in our case the credits,²³⁴ provides devotees with a sense of belonging to something that is larger than life. By altering that which is so identifiable, even to non-aficionados, an *ignis fatuus* is suddenly perceived, which can only devalue the Beatles and their many resources.²³⁵ Recall, that this was by the Beatles’ own design, specifically as a result of the decisions made by Lennon and McCartney, who wanted nothing more than for their names to be combined in a manner that would be unforgettable.²³⁶ Therefore, this Comment will carry through in its analysis having already concluded that the term “Lennon/McCartney” is more than

229. Geoff Boucher, *Paul’s New Arrangement Is Flip Side of Lennon-McCartney*, L.A. TIMES, Dec. 15, 2002, at A1 (“Passman is author of ‘All You Need to Know About the Music Business’ and an attorney who has represented Janet Jackson, R.E.M., Pink and other music acts.”).

230. *See id.* (emphasis added).

231. *See generally* SHEFF, *supra* note 1.

232. Eliscu, *supra* note 12, at 20.

233. *See* discussion *supra* Part I.

234. The music and lyrics would fall under the copyright portion of our analysis, while titles, packaging and credits, are more properly associated with the law of trademarks. *See* MOSER, *supra* note 24, at 23 (“Musical compositions are generally comprised of several elements, which can include lyrics, melody, harmony and rhythm.”). *See also* discussion *supra* Part II.B (discussing trademarks).

235. *See supra* note 5.

236. *See supra* note 3.

just an indication of authorship and ownership, but is instead as McCartney himself has described it, a “rock’n’roll trademark.”²³⁷

Once the term “Lennon/McCartney” is recognized for its pedestaled worth, the next question becomes how best to protect it, and whether the laws of Congress and legal precedent can serve as a buttress for that. While the ability to claim an overall diminishment of their assets will ultimately prove to be the plaintiffs’ most effective means of guarding the songwriting credit,²³⁸ there are non-diminishment based arguments that may also prove effective. And of course each argument will be forced to overcome McCartney’s presumed defense, the invocation of his First Amendment rights as an artist.²³⁹

A. *Lennon’s Potential Causes of Action*

1. Copyright Infringement

Though a great deal of Part II of this Comment is dedicated to the history and laws of copyrights,²⁴⁰ the fact is that of the potential causes of action available to Lennon, while copyright infringement certainly remains a viable action, it is the one on which he is least likely to succeed. The importance here of understanding its traits however, is in garnering an appreciation for the many people who, not just in this case, but potentially in all music related cases, whether it be through licenses or partnerships, own an affected interest that qualifies them as plaintiffs.²⁴¹ One can be sure that

237. See Mike Merritt, *The Paul McCartney Interview*, SUNDAY HERALD (Scotland), June 1, 2003, available at <http://www.sundayherald.com/34211>.

238. See discussion *infra* Part III.A.2.

239. See discussion *infra* Part III.B.

240. See discussion *supra* Part II.A.

241. Ownership rights in a musical composition can generally be broken down into two main categories: the rights in the master sound recordings, and the intellectual property rights in the musical composition. See KRASILOVSKY & SHEMEL, *supra* note 53, at 20-21, 23-24; see also *Newton v. Diamond*, 349 F.3d 591 (9th Cir. 2003) (where the rap group Beastie Boys sampled a six second piece of music, the question was raised whether licenses must be obtained from both the owners of the sound recording and the musician owning the separately copyrighted musical composition, thus indicating a distinction). While the rights to the master recordings are owned by the record company that produces the artist’s work, the compositions are often controlled by music publishers, who serve as the agents for the material. See Wikipedia Encyclopedia, http://en.wikipedia.org/wiki/Music_publisher (last visited Feb. 13, 2006). It is the job of the publisher to promote the song, and collect revenues from cover versions, radio airplay, usage in films, and so forth. See *id.* Essentially, the publisher is responsible for collecting income from all sources, with the exception of the sale of albums. See *id.* The basic music publishing contract calls for publishing royalties to be divided equally, with half going to the publisher and half going to the

any suit involving the estate of John Lennon as a plaintiff, would certainly be followed by an extensive “et al.” list of similarly interested parties.²⁴²

To refer to those parties though as only the owners of the specific copyright in question, would be an imprecise method of forecasting potential plaintiffs. In the typical music infringement suit, making this determination is dependant on who owns the portion of the copyrights being infringed upon.²⁴³ The argument being made here however, given the special character discussed above, is that all owners of all Beatles copyrights are impacted by the type of infringement at issue.²⁴⁴ Therefore, it would make no difference whether a case is litigated over McCartney’s release of original

songwriters. *See id.* However, these deals can also be negotiated in ways that favor one party or the other with a more generous portion. *See id.*

242. The details surrounding the business affairs of the Beatles are complex and many. As noted previously, Michael Jackson is an owner of the Beatles’ publishing rights, as a partner with Sony Corp. in a joint venture called Sony/ATV Music Publishing. *See Crawford, supra* note 5. The tangled history of how Lennon and McCartney lost the rights to their own music is generally beyond the scope of this Comment. In short however, in 1963 the Beatles agreed to a standard publishing contract with Dick James, and established the company Northern Songs, which was formed exclusively for the publishing of “Lennon/McCartney” songs. *See NORMAN, supra* note 5, at 186. *See also* PETER McCABE & ROBERT D. SCHONFELD, *APPLE TO THE CORE: THE UNMAKING OF THE BEATLES* 142 (1972). The contract called for James to receive 50% of the profits, with Lennon and McCartney each receiving 20%, and manager Brian Epstein receiving 10%. *See NORMAN, supra* note 5, at 186. In 1965, Northern Songs went public on the London Stock Exchange. *See MCCABE & SCHONFELD, supra*, at 142 (“The main idea behind the flotation was to provide the Beatles some sort of ‘paper’ security.”). This opened the door for a hostile takeover of Northern Songs in 1969, orchestrated by Sir Lew Grade, owner of the “multi-million dollar communications and entertainments empire” ATV. *Id.* at 143-56. Jackson then purchased the catalogue in 1985. *See supra* note 5. The ultimate result of the publishing fiasco is that McCartney and Lennon each receive 25% of publishing, while Jackson and Sony share the remaining 50%. *See Hilburn, supra* note 18, at E1. Though it is still slightly more than the interest they began with, the disappointment comes in not being in a position to reclaim a full ownership in the catalogue. Adding to the confusion, there is also the publishing company that the songwriters began on their own, interestingly called MacLen (short for McCartney and Lennon), which was established to provide an alternate publishing outlet to be used when contractually permissible. *See The Beatles’ Businesses*, http://ptrob.com/Music/Beatles/Businesses/body_businesses.html (last visited Feb. 13, 2006); *The Beatles’ Song Rights*, http://ptrob.com/Music/Beatles/Song_Rights/song_rights.html (last visited Feb. 13, 2006). Beyond those owning rights in the publishing, the list of those possessing a stake in the Beatles continued success is far-reaching. The E.M.I. owned Capitol Records still holds the rights to the Beatles’ recordings. *See Crawford, supra* note 5. Also, Lennon, McCartney, Harrison and Starr are all partners in Apple Corps. Ltd, which was established in 1968 for the purpose of managing new Beatles ventures. *See NORMAN, supra* note 5, at 363-65. Furthermore, Harrison, who died in 2001, and Starr are not to be forgotten as interested parties in this dispute. *See Allan Kozinn, George Harrison, “Quiet Beatle” And Lead Guitarist, Dies at 58*, N.Y. TIMES, Dec. 1, 2001, at A1. In addition to their compensable roles as both performers and equal partners in the Beatles, apart from the “Lennon/McCartney” songwriting, there are the twenty-seven songs in total that Harrison and Starr (whose credit reads as his birth name “Starkey”) are credited as the sole writers. *See Steve’s Beatles Page*, <http://www.stevesbeatles.com/songs/default.asp?sort=songwriter> (last visited Feb. 13, 2006). As such, any negative impact on Beatles lore, would have a trickle down effect damaging Harrison’s and Starr’s assets as well.

243. *See supra* note 241.

244. *See* 17 U.S.C. § 501(a) (2005) (protecting all legal and beneficial owners against infringement).

versions of Beatles compositions, such as the “Back in the U.S.: Live 2002” album, or a case that litigates the re-release of the Beatles’ original compositions.²⁴⁵

Bringing a cause of action on the basis of copyright infringement requires that the focus be placed on the underlying composition, the work which is protected by the copyright, and not on the “Lennon/McCartney” term that is at issue.²⁴⁶ It is therefore already a lesser argument, in that it seeks protection for that which is not in desperate need of it. Our primary concern is safeguarding the songwriting credit, not the song, and so a copyright claim is a step removed from the real controversy. Within the context of copyrights however, there are nevertheless two arguments to be made, a diminishment based approach, and a non-diminishment based approach, with the former being the stronger argument of the two.

Using the latter approach however, Lennon²⁴⁷ could argue infringement under a pure and simple reading of the Code, which when interpreted by precedent requires both an act of copying, and that the copying be an improper appropriation.²⁴⁸ There is of course no need to venture into an improper appropriation analysis and question whether a substantial similarity exists between the two works. The infringing and infringed upon songs are going to be virtually identical, since McCartney would either be releasing the same recordings as the originals, or cover versions meant to resemble those originals. The real question under this approach, is whether there has been an unauthorized copying, or better yet, whether there is even an infringer against whom Lennon can bring an action. It would be imprudent to argue that McCartney the solo artist, is infringing upon Lennon

245. The distinction being that the owners of the master recordings, in our case Capitol Records, may not be impacted the same when a live album is released, as compared to the re-release of the recordings which they own. See *supra* notes 57-64 and accompanying text (discussing compulsory mechanical licenses); see also *infra* notes 254-56 and accompanying text. A live album though would certainly require authorization from the music publishers, and McCartney appears to satisfy this requirement. See PAUL MCCARTNEY, BACK IN THE U.S.: LIVE 2002 (Capitol Records 2002) (where liner notes read “CD 1 Tracks 1, 3, 4, . . . published by Northern Songs.”). The argument here however, is that the damage goes beyond the specific instances of use that are at issue, and extends to the perpetual property rights of the various owners, those who are actively being infringed upon, and those who are passively being infringed upon.

246. See MOSER, *supra* note 24, at 32 (“Short phrases and slogans . . . are not protected by copyright. . . . However, slogans can be protected by trademark law if they become closely associated with a product or service.”).

247. “Lennon” will be used throughout Part III as representative of “Lennon et al.,” with the exception of those instances where it is specifically noted that Lennon, and only Lennon, is being damaged, such as the discussions of reverse passing off in Part III.A.2, and the right of publicity in Part III.A.3.

248. See *supra* notes 66-68 and accompanying text (discussing copying and improper appropriation).

the solo artist, because as joint authors each owns an undivided one half interest in the song.²⁴⁹ Neither one's decision-making as to their own use or license of the song is hindered by the other's passiveness.²⁵⁰ Granted, each has a duty to account to the other and to all beneficiaries,²⁵¹ but McCartney is likely well aware of this and would gladly comply with making payments to those entitled to such.²⁵² However, while McCartney may be in compliance, and have proper authorization, it can be argued that the artist known as McCartney/Lennon does not have authorization, and is not in compliance.²⁵³

As soon as we raise the possibility though of treating McCartney/Lennon as an artist different from the artist Lennon/McCartney or just McCartney, then we immediately have to consider that for newly created cover version of previously recorded songs, McCartney could be protected by § 115, which allows for the obtainment of a compulsory mechanical license.²⁵⁴ The problem however, is that in this instance, since McCartney sees no fault in the transposition of the names, he would likely fail to provide the requisite notice to obtain such a license and would therefore be subject to liability for infringement.²⁵⁵ Of course, if he were willing to accept that McCartney/Lennon is an artist unrelated to Lennon/McCartney, he could obtain such licenses for future cover versions that he records, but even so, it would still be highly unlikely that McCartney would be able to release a recording using the term "McCartney/Lennon" due to other claims that he would be forced to defend against, such as Lennon's right of publicity.²⁵⁶ As such, we will continue the analysis of the copyright action, under the assumption that the non-Lennon/McCartney artist, McCartney/Lennon, would not be protected under § 115, when the compositions being distributed are McCartney's cover versions of the Beatles' original songs.

That said, viewing McCartney/Lennon as someone other than Lennon/McCartney is ultimately nothing more than a matter of semantics,

249. See *supra* note 78 and accompanying text (discussing joint works).

250. See *supra* note 84 (discussing a joint author's right to exploit the work).

251. See *supra* note 84.

252. McCartney is estimated to be worth anywhere from \$1 billion to \$1.55 billion. See Hilburn, *supra* note 18; see also Lyall, *supra* note 18. Among his assets, McCartney owns his own publishing company, McCartney Productions Ltd. (MPL), which in addition to publishing his own solo compositions, "holds the rights to the work of writers ranging from Buddy Holly to Harold Arlen," and "the titles: 'Hello, Dolly!,' 'Unchained Melody' and 'The Christmas Song.'" See Hilburn, *supra* note 18. As such, the assumption can be made that McCartney is very conscious of the compensation that must be paid to those who are entitled to such royalties.

253. Note the distinction between McCartney/Lennon the infringing artist and "McCartney/Lennon," the infringing songwriting credit.

254. See 17 U.S.C. § 115 (2005).

255. See MOSER, *supra* note 24, at 56.

256. See discussion *infra* Part III.A.3. See also MOSER, *supra* note 24, at 28 (noting that one may still be forced to defend on other grounds).

and though the entire dispute is about semantics, one would still hope to proffer evidence that construes it as being something other than that. As such, Lennon would be presented with a significant challenge were he to rely solely on this argument. Even if a technicality of this sort were to be upheld as an infringement of Lennon's (and McCartney's) rights, for the failure to obtain a proper license, McCartney as a valid owner, could perhaps circumvent the issue in the future, by facilitating the delivery of those rights through a means comparable to the use of a straw man,²⁵⁷ thus allowing McCartney to properly license McCartney/Lennon. The McCartney/Lennon artist may still be liable for damages incurred prior to the proper licensing, but mere injunctive relief may not stay permanent afterwards.²⁵⁸ McCartney would then still have to defend his use of "McCartney/Lennon" on other grounds yet to be discussed,²⁵⁹ but not on the basis that a non-Lennon/McCartney artist has improperly infringed. All told, its debilitating weaknesses aside, the argument still forms the basis for a similar stronger argument that is supported by law, under the trademarks cause of action discussed later in Part III.A.2.²⁶⁰ Overall however, it is an argument that is perhaps not worth making, given the available alternatives.

Lennon would have a better chance of prevailing in a copyright action under the diminishment based approach, as the tactic here would be to accuse his cotenant McCartney of committing an "act[] of destruction"²⁶¹ of their joint work.²⁶² As already noted however, since acts of destruction against one's own property interests are so uncommon, it is a rarely litigated charge,²⁶³ which raises the possibility that courts may be reluctant to apply it to an act of destruction as specific as the credit transposition. Without the strong statutory language in place, such as what is found under trademark law, via the FTDA,²⁶⁴ or strong legal precedents,²⁶⁵ a court would

257. See BLACK'S LAW DICTIONARY 669 (2d Pocket ed. 2001) (defining straw man as "[a] third party used in some transactions as a temporary transferee to allow the principle parties to accomplish something that is otherwise impermissible").

258. See 17 U.S.C. § 502(a) (2005) ("injunctions").

259. See discussion *infra* Parts III.A.2, III.A.3.

260. See discussion *infra* Part III.A.2 (discussing the likelihood of confusion doctrine).

261. See *Brown v. Republic Prods., Inc.*, 161 P.2d 796, 798 (Cal. 1945); see also *supra* note 85 and accompanying text.

262. Even if the argument above were accepted, recognizing McCartney's right to license the artist known as McCartney/Lennon, it would still remain possible that Lennon would view the granting of that license as an act of destruction. Therefore, it is feasible that Lennon could raise this claim against either McCartney, his cotenant who is also the performer, or McCartney, his cotenant who is the licensor to McCartney/Lennon.

263. See *supra* note 84 and accompanying text.

264. See discussion *supra* Part II.B.2.

265. See discussion *supra* Part II.B.2.

subsequently be forced to make its own determination as to what constitutes an act of destruction or an “impair[ment] [of] its worth as to others.”²⁶⁶ The argument to be made as to what has been destroyed would be the same as that which has already been set forth in this Comment, the diminished value of Beatles lore and all its assets for all its owners, but again, from a copyright perspective this argument is still burdened by its distance from the actual controversy.

The purpose of copyright law is to protect “the exclusive rights of the copyright owner[s],”²⁶⁷ with the main focus of the six protected rights—reproduction, creation of derivations, distribution, performance, public display, and transmission²⁶⁸—on the prevention of diminishment that comes as a result of unauthorized overuse, not diminishment from peripheral acts of misuse by those who are authorized. And so while a trier of fact could certainly determine that McCartney has overstepped his bounds, it is not unimaginable that a court’s focus would still be concentrated on whether or not McCartney is an authorized user. If it is determined that he is, then the particulars of that authorization, specifically whether he can or can not transpose, could very likely be deemed outside the reach of the limited precedent available for acts of destruction. Nevertheless, a copyright cause of action can and should be brought. It faces however something of an uphill battle, or at least a rugged terrain when compared to how things may come together for Lennon when turning to the next branch of intellectual property law.

2. Trademark Infringement

As has been hinted at throughout the analysis above, trademark law successfully improves upon the same non-diminishment and diminishment based approaches applied in Part III.A.1.²⁶⁹ The difference under this branch however, is that the approaches to each are more firmly rooted in the laws of Congress. As mentioned, a copyright action keeps us at arm’s length from the real controversy, a dispute that involves a trademark. In even simpler terms, whereas copyright law is about copying, trademark law is about marking, and so it only makes sense to seek remedy through the various offerings of the Lanham Act.

The threshold question for any trademark action is whether a valid trademark is in use by the plaintiff.²⁷⁰ Recalling *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*,²⁷¹ where cheerleading uniforms

266. See *Maurel v. Smith*, 271 F. 211, 216 (2d Cir. 1921).

267. 17 U.S.C. § 501(a) (2005).

268. 17 U.S.C. §§ 106(1)-(6) (2005).

269. See discussion *supra* Part III.A.1.

270. See 2 MCCARTHY, *supra* note 89, § 16:1.

271. 604 F.2d 200 (2d Cir. 1979).

qualified as valid trademarks, we are reminded of the wide array of protected marks.²⁷² Furthermore, there is no issue of use, given the massive commercial success the Beatles have enjoyed since the beginning of this century alone.²⁷³ Also, the most recent releases by the Beatles continue to attribute authorship of their songs through use of the term “Lennon/McCartney.”²⁷⁴

Following the premise of building on the two copyright approaches, the advancement of our previous non-diminishment based argument comes in the form of the likelihood of confusion doctrine.²⁷⁵ Under this doctrine, Lennon will have a choice of several ways and means of supporting his cause. Former Ono attorney Gregory Victoroff, has made statements in which he has applied the basic confusion approach, which looks to the first of the three mentioned societal interests; that of protecting the public from being deceived.²⁷⁶ He notes that McCartney’s transposition of the credits “is a little disturbing to the extent that it creates an impression in consumers’ minds that it’s a different composition, [i]t may be deceptive and actionable if it creates a false impression in the minds of consumers that the goods are different than they were before.”²⁷⁷ Victoroff’s concern here is that a consumer may contemplate purchasing McCartney’s album under the belief that a transposition of the credits is an indication that the newly released versions of the included Beatles songs are so significantly altered from the originals, and that McCartney has reinterpreted the songs to such an

272. See *id.* at 204; see also *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (holding that a color is “capable of satisfying the more important part of the statutory definition of a trademark,” and in doing so noting that “courts and the Patent and Trademark Office have authorized for use as a mark a particular shape (of a Coca-Cola bottle), a particular sound (of NBC’s three chimes), and even a particular scent (of plumeria blossoms on sewing thread)”).

273. See, e.g., Tim Page, *It Looks as Though They’re Here to Stay; Decades After We Met the Beatles, Their Songs Are Back at the Top*, WASH. POST, Jan. 31, 2001, at C1. In November of 2000, the Beatles released “1,” a compilation of twenty-seven of the band’s hit singles. *Id.* The album sold close to 20 million copies during the first three months of its release. *Id.* According to *Guinness World Records 2002*, the album set two records; one by reaching the top of thirty-five international charts, and another by being the “Fastest-Selling Album” in history. See Wikipedia Encyclopedia, http://en.wikipedia.org/wiki/1_%28album%29 (last visited Feb. 13, 2006). In November of 2006, the Beatles will release a soundtrack for a new Beatles themed Cirque du Soleil show called “Love.” Expectations for strong sales of that album are high. See Nic Fildes, *EMI Looks to Beatles for Boost*, THE INDEPENDENT (London), Oct. 17, 2006, at 38 (“EMI is expecting a bumper second half of the year with a host of big-name artists, including The Beatles, due to issue albums.”).

274. See THE BEATLES, 1 (Capitol Records 2000); THE BEATLES, LET IT BE . . . NAKED (Capitol Records 2003).

275. See discussion *supra* Part II.B.1.

276. See *supra* notes 97-100 and accompanying text.

277. See Garcia, *supra* note 16.

extent, that a credit change was warranted. As a result, a consumer may decide to purchase the album, believing that it is something entirely different from that which they may already own. Though a rational concern, this argument is flawed for a number of reasons.

First, challenging on the basis of the desire to protect consumers pre-purchase, requires that consumers be deceived pre-purchase. Using “Back in the U.S.: Live 2002” as our most current example of McCartney’s potential infringement, that album does not contain any songwriting credits on the sealed packaging that would be visible prior to making a purchase.²⁷⁸ A purchaser would not realize that the songwriting credits have been transposed until after the CD is opened, and the liner notes are read.²⁷⁹ Second, Victoroff’s argument implies that a consumer may be tricked into believing that they are purchasing alternate versions of the same songs previously released. However, it may not be entirely correct to say that purchasers are not getting something different. While the songs are certainly identical for the sake of copyright and trademark protection, and the intellectual property contained therein, recorded live performances of songs with minor reinterpretations, as is the case with “Back in the U.S.: Live 2002,” are often top sellers for artists, despite the wide availability and great commercial success of the original studio versions.²⁸⁰ Of course consumers

278. See PAUL MCCARTNEY, *BACK IN THE U.S.: LIVE 2002* (Capitol Records 2002).

279. See *id.* The same can be said for a number of the Beatles’ CD’s. While the majority of the CD’s contain credits that are in view pre-purchase, a handful do not. See, e.g., THE BEATLES, *MAGICAL MYSTERY TOUR* (Capitol Records 1988) (1967); THE BEATLES, *THE BEATLES (THE WHITE ALBUM)* (Capitol Records 1988) (1968); THE BEATLES, *ABBEY ROAD* (Capitol Records 1987) (1969); THE BEATLES, *LET IT BE* (Capitol Records 1987) (1970).

280. One example of a successful live concert album that contains material previously released on a studio album is James Brown’s “Live at the Apollo.” See Blashill, et al., *supra* note 4, at 104. “This document of Brown’s prowess onstage may be the greatest live album ever recorded.” *Id.* It is noted that the album benefits from “the breathless buildup of the spoken intro,” a feature exclusive to the live album that would not be found on the studio versions of the performed songs. See *id.* Other examples include: Johnny Cash’s “At Folsom Prison,” The Who’s “Live at Leeds” and Nirvana’s “MTV Unplugged in New York.” See *id.* at 116, 136, 154. For some live albums, the sales will be fueled in part by the inclusion of new material, accompanying the songs previously released as studio recordings, such as Nirvana’s cover versions on “MTV Unplugged in New York” of David Bowie’s “The Man Who Sold the World” and the Meat Puppets’ “Plateau,” among others. See *id.* at 154; see also NIRVANA, *MTV UNPLUGGED IN NEW YORK* (Geffen Records 1994) (further distinguishing itself with its acoustic renditions of the studio versions). Some bands will rely even more heavily on the sale of live concert albums, making available a CD of each performance from a concert tour. See Chris Nelson, *Frampton to Phish: A New Breed of Live Albums*, N.Y. TIMES, Oct. 28, 2002, at C9. In 2000 and 2001, Pearl Jam sold seventy-two different live albums, almost one for each of their previous tour’s shows. *Id.* There are instances however, where the release of a live album can go horribly wrong. See Steve Hochman, *Pop Eye: A Fallen Idol, Bad Meat Loaf, Live Computers: Back Into 1993’s Hell*, L.A. TIMES, Jan. 2, 1994, at 62 (listing Depeche Mode’s “Songs of Faith and Devotion – Live” as the third worst album of 1993, noting that the live album presents the same songs as the studio album on which it is based in the same order as they appear on the studio album, and that “devoted fans are essentially paying \$15 to hear crowd noise”). In the case of McCartney’s “Back in the U.S.: Live 2002” album, though almost all Beatles songs that appear are comparable in length to their previously released counterparts, there are notable distinctions that

would be getting the exact same product in a greatest hits compilation on which the names are transposed, but in order to make the assumption that consumers have been deceived in purchasing even that type of an album, one would probably have to take into account the entire presentation of the material, looking beyond the songwriting credits, to determine if there has truly been a deception.²⁸¹ Third, and most importantly, focusing a cause of action on the desire to protect consumers, does not provide relief for those who have suffered the most irreparable harm. In our case, the lesser concern is for how the transposition of credits impacts the purchase of the item on which the transposition occurs,²⁸² while the much greater concern is for how

could merit a purchase for the concert album, even if one were to own the previously recorded versions. For example, as part of the fade out of the song “Hey Jude,” where for almost four minutes the lyric “Na na na na-na-na-na, na-na-na-na hey Jude” is repeated, McCartney can be heard leading the audience in a sing-along, instructing “just the fellas” or “just the women,” to sing at various times. Compare PAUL MCCARTNEY, *Hey Jude*, on BACK IN THE U.S.: LIVE 2002 (Capitol Records 2002), with THE BEATLES, *Hey Jude*, on PAST MASTERS VOL. TWO (Capitol Records 1988). Also, when performing the song “You Never Give Me Your Money” (“Money”), there is a portion where McCartney “forgets” the lyrics that appear on the studio version, and supplies original filler lyrics. Compare THE BEATLES, *You Never Give Me Your Money*, on ABBEY ROAD (Capitol Records 1987) (1969) (“Any jobber got the sack, Monday morning turning back, yellow lorry slow nowhere to go.”), with PAUL MCCARTNEY, *Carry That Weight*, on BACK IN THE U.S.: LIVE 2002 (Capitol Records 2002) (“And this is the bit where I don’t know the words, but I don’t think I’m even going to bother to try and learn them by the end of the tour.”). Note that “Money” can be heard by accessing the track for “Carry That Weight.” This is due to the snippet of “Money” that appears on “Carry That Weight,” on the “Abbey Road” album. See THE BEATLES, *Carry That Weight*, on ABBEY ROAD (Capitol Records 1987) (1969). In addition to the various song anomalies, given the number of years between the studio recordings and the live recordings, McCartney could be forced to sing the same songs in different keys, a vocal anomaly that could be of interest to some, and influence one’s decision to make a purchase.

281. If for example the credits had been transposed on the Beatles’ 2000 greatest hits compilation, “1,” a charge of consumer deception would still be lacking in proof that the consumer purchasing the album was under the assumption that the credit transposition served as an indication that the material differed as a result this switch. As such, Victoroff’s concern of consumer confusion should not form the basis for an infringement claim, even when applied to albums containing previously recorded works.

282. Assessing damages where consumers have been deceived would likely be far easier than calculating those damages suffered by the parties owning rights that are affected in terms of their future sales. This is another reason why our primary concern should be to protect the interests of the many Beatles property owners and not the consumers. For consumers, it would seem that a remedy could easily come in the form of a refund for their CD purchase, though recently several cases have been filed asking that consumers be compensated for the investment of their time in instances when they have been deceived. See, e.g., Peter Lewis, *Seattle Suit Filed Over Embellished Best-Seller*, SEATTLE TIMES, Jan. 25, 2006, at B1 (discussing a lawsuit brought by purchasers of James Frey’s *A Million Little Pieces*, a non-fiction memoir found to be wrought with embellishments, asking to be compensated for their “lost time,” even after the book’s publisher issued a statement promising refunds); *Spotlight*, TORONTO STAR, Feb. 9, 2006, at A19 (noting that class-action lawsuits against Frey and Doubleday have also been filed in Ohio, New York and Quebec).

this transposition impacts all future purchases of Beatles music and merchandise.

In all likelihood, McCartney's reason for transposing the credits is not the attempt at deception described above, as it is more likely that McCartney wants and assumes consumers will recognize the songs as replicas of the ones they know and love, but that with the transposition of the credits, they will also recognize McCartney as the artist to whom true authorship should be attributed.²⁸³ As such, the argument to be made is that McCartney here is liable for creating a likelihood of confusion through express reverse passing off,²⁸⁴ an approach that leans more towards our diminishment concerns. McCartney seeks to derive benefit as a result of removing the "Lennon/McCartney" trademark, and replacing it with one that reads "McCartney/Lennon." It has already been noted in Part II, that *Smith v. Montoro*²⁸⁵ recognizes the misuse of names in credits, and equates those names to trademarks.²⁸⁶ *Smith* is distinguished though in that the claim there involves the removal of Smith's name, and the replacement of another,²⁸⁷ whereas here Lennon's name still appears, just not in the same state as before. The difference though is inconsequential, as *Smith* stands for the deprivation of value in one's name and the effect upon the goodwill stemming from that name.²⁸⁸ Therefore, the damage to Lennon's name, as a result of the removal of the original trademark, is enough to make a case for infringement under express reverse passing off.

283. It should be noted that on "Back in the U.S.: Live 2002," while McCartney has transposed the names on all "Lennon/McCartney" songs, the album only contains songs that he has been deemed the author of on an unofficial basis. See generally DOWLDING, *supra* note 1. "Unofficial" of course being the operative word, in the sense that despite all existing accounts, which include statements by both McCartney and Lennon, the fact remains that Lennon is no longer here to make official those unofficial accounts. See Lampert, *supra* note 6, at 7 ("[I]n an article in Playboy magazine John very accurately divided the credit for each of the Beatles songs between us . . . and when I ran the exercise for myself a few years back . . . I found that John and I were in complete agreement as to who had done what."). To say they are in "complete agreement" however, may be overstating things, as evidenced by their conflicting accounts regarding the writing of "Eleanor Rigby." See DOWLDING, *supra* note 1, 134-35 (where Lennon states: "I wrote a good lot of the lyrics, about 70 percent," and McCartney counters: "I saw somewhere that [John] says he helped on 'Eleanor Rigby.' Yeah. About half a line"); see also SHEFF, *supra* note 1, at 139 (where Lennon notes on "Eleanor Rigby" that "the first verse was his and the rest are basically mine"); see also Jenny Eliscu, *The Rigby Mystery*, ROLLING STONE, Dec. 26, 2002/Jan. 9, 2003, at 20. Nevertheless, on "Back in the U.S.: Live 2002," McCartney only performs those songs which he takes credit for, deserved or not. He has indicated however that were he to have included on that album a song for which authorship has been unofficially attributed to Lennon, that it would remain credited as "Lennon/McCartney." See *McCartney Press Release*, *supra* note 6, at 7 ("[A]nd I have also pointed out to Yoko Ono that I'm happy for our co-written songs to have John's name in front of mine.").

284. See *supra* note 114 and accompanying text ("express reverse passing off").

285. 648 F.2d 602 (9th Cir. 1981).

286. See *id.* at 602-03, 608.

287. *Id.* at 603.

288. *Id.* at 607.

What may not be obvious though, is how this change damages Lennon or benefits McCartney. There is no clear indication that it makes any difference, but perhaps the greatest advocate for insisting that it does, is McCartney himself, as evidenced by his comments and the efforts that he has made on behalf of his cause.²⁸⁹ It does not help matters that Ono has continually bated McCartney into finding importance in the matter, with her implications that Lennon's lead position is not a matter of mere happenstance. In 1997, Ono publicly referred to McCartney as a Salieri to Lennon's Mozart,²⁹⁰ and more recently dismissed McCartney's contributions to the tandem's catalogue as unsophisticated "June with Spoon" rhymes.²⁹¹ So the notion that McCartney would feel compelled "to assert his place in history"²⁹² through a transposition of the names is not far from preposterous. Furthermore, one could argue that in many instances, being named first does come with some benefits in terms of the public's perception.²⁹³ And if

289. See generally Lampert, *supra* note 6, at 7. It is significant that McCartney would release a statement as exhaustive as this one, and that he would address the matter in public as freely as he has. See also *supra* note 12 (noting McCartney addressing the issue publicly on "The Howard Stern Show"); CNN.com/Transcripts, *CNN Larry King Live: Paul McCartney Discusses "Blackbird Singing,"* <http://transcripts.cnn.com/TRANSCRIPTS/0106/12/lkl.00.html> (last visited Feb. 13, 2006) (where McCartney states that "the trouble is there was a little bit of revisionism").

290. See Garcia, *supra* note 16.

291. See Oh, *Yoko! Lennon's Widow Gets In a Zinger*, CHI. TRIBUNE, Oct. 11, 2005, at C19. Ono accepted an award on Lennon's behalf at the Q Awards, and told the audience that Lennon sometimes asked "why 'they always cover Paul's songs and never mine.'" *Id.* Ono says she would assure her husband that he was "a good songwriter; it's not June with Spoon that you write." *Id.* Ono later offered a public apology to McCartney for the remarks. See *Yoko Plants Trees in John's Memory*, ROLLING STONE, Nov. 17, 2005, at 24 ("Says Ono, 'I certainly did not mean to hurt Paul, and if I did, I am very sorry.'"). Ono's dig at McCartney does however point out a distinction that deserves to be noted, which is that when attributing authorship on an unofficial basis, McCartney's contributions to the Beatles' catalogue account for a higher percentage of the band's commercially successful songs. Applying the determinations of authorship in Dowling's *Beatlesongs*, to the 27 songs that reached the number one chart position featured on the album "1," McCartney's contributions account for 55% of the songs, while Lennon is responsible for 41%, with Harrison contributing the remaining 4%. See generally DOWLING, *supra* note 1; THE BEATLES, 1 (Capitol Records 2000).

292. See Garcia, *supra* note 16.

293. The billing term of "Gilbert & Sullivan" represents a unique crediting decision, where the public may make certain inferences as a result. Typically in opera, the composer's name precedes the lyricist. See *The Mikado: Gilbert and Sullivan The Collaborators*, <http://www.lyricoperasandiego.com/Education/PeopleGS.htm> (last visited Feb. 13, 2006). Arthur Sullivan however, the composer here, takes the second position to the lyricist William Gilbert, who was said to have had the stronger personality. See Gilbert before Sullivan, http://www.oup.com/pdf/0195145143_01.pdf (last visited Feb. 13, 2006). Their earliest collaborations though, followed the traditional format, and were credited to "Sullivan & Gilbert." *Id.* Given that a change occurred, and that change was one that went against standard practice, it is possible that assumptions could be made about Gilbert's contributions to the collaborative efforts of the pair. Another example which can be pointed to is the pairing of film critics Roger Ebert and Richard Roeper, who are featured on their own television

Lennon has in fact benefited, even if unjustly deserved, then he is still entitled to reap that benefit without any interference or tampering by McCartney. Express reverse passing off would be a form of such tampering,

show called "Ebert & Roeper." See Internet Movie Database (IMDb), <http://imdb.com/title/tt0090523/> (last visited Feb. 13, 2006). The show was previously called "Siskel & Ebert," until its co-creator, film critic Gene Siskel, died in 1999 at the age of 53. See Rick Kogan, *He Changed the Way We Look at Movies*, CHI. TRIBUNE, Feb. 21, 1999, at C1. Roeper explains the various sequencing decisions as follows: "Roger and Gene flipped a coin. Roger lost. When I joined the show, Roger said, 'We're not flipping a coin this time! I was here first.' Couldn't argue with that!" E-mail from Richard Roeper, Columnist for the *Chicago Sun-Times* and Film Critic for "Ebert & Roeper" Television Show (Feb. 16, 2006, 19:47:32 PST) (on file with author). Here we see two methods for determining sequencing, chance and seniority, with the latter implying that Ebert finds at least some value or significance in being first. This implication is further substantiated on the basis that had the name been changed from "Siskel & Ebert" to "Roeper & Ebert," perhaps the change would be less "jarring to the ear." See Boucher, *supra* note 229, at A1 (noting that "[m]essing with the name of a famous partnership can be jarring to the ear, like some semantic pothole on memory lane or, worse, an ungraceful recalculation of history"). A common circumstance where one could be adversely affected due to their positioning in such a sequence, is when names are used for businesses, especially law firms. Some firms have changed their name, in order to reduce the number of name partners from several to only a pair. See Natalie Hill, PITTSBURGH POST-GAZETTE, Feb. 19, 2003, at C3 (announcing the change of "Jones Day Reavis & Pogue" to "Jones Day"); see also *Jones Day Drops "Reavis & Pogue,"* PITTSBURGH BUSINESS TIMES, Feb. 3, 2003, available at <http://www.bizjournals.com/pittsburgh/stories/2003/02/03/daily11.html> ("The firm said it means no disrespect to [the] former name partners . . ."). Furthermore, in this age where all firms host their own Web sites, many firms that do not officially drop the latter names, are abbreviated for Web purposes nonetheless, thus likely becoming "official" abbreviations in the minds of the public. See, e.g., Akin Gump Strauss Hauer Feld LLP, <http://akingump.com/> (last visited Feb. 13, 2006) (where three name partners are not included in the Web address domain name); Lord, Bissell & Brook, <http://www.lordbissell.com/> (last visited Feb. 13, 2006) (where only one name partner is not included in the domain name). In such instances, the second name partner would still be unaffected, as only the partners holding the positions third and onward are dropped. However, there are even cases of firms dropping all but one name partner on an official basis. See Brenda Sapino Jeffreys, *Street Names; Firms Shorten Monikers to Give Them a Marketing Edge*, TEXAS LAWYER, May 16, 2005, at 1 (discussing Howrey Simon Arnold & White's adoption of the "one-word moniker of Howrey"). In commenting on the Howrey name change, marketing consultant William J. Flannery, Jr. noted that "[t]he vast majority of clients remember the first name of the firm . . ." *Id.* Another such example involves the law firm, Dykema. See *What's In a Name?: An Interview With Dykema Chair and CEO Rex Schlaybaugh, Jr.*, LAW FIRM INC., Jan./Feb. 2006, at 40, 42 (CEO discussing the firm's decision to change its name from Dykema Gossett to just Dykema, and noting that market research indicated "that in the marketplace, we were just referred to as 'Dykema'"). Clearly, in such instances where all names but one are dropped, being in the first position is beneficial, and thus legitimizes the concerns of McCartney and all others who are not in the first name position. McCartney though does seem to indicate that his unease is more about accidental obliteration. He relays the following incident. "Late one night I was in an empty bar flicking through the bar pianist's music book when I came across 'Hey Jude written by John Lennon'. If there is an argument for 'correct labeling' I think this is probably the best one." Lampert, *supra* note 6, at 7. McCartney goes on to explain: "Computers often allow certain space for labeling of any item and as we all know the end of the label often gets cut off a sentence or title. For instance, I recently went to see a film which the tickets described as 'Miss Congenia'." *Id.* It would appear as if McCartney is concerned that a typo will lead to a habit or a convenience, and ultimately result in an eradication. It is unclear though how the potential for the same glitch is avoided when Lennon's name is moved into the second position. Perhaps McCartney's rationalization though, is that the risk of omission should be more evenly distributed, and that the best way of determining who should be placed at risk for each song, is to rely on his own accounts and the past statements of Lennon. As previously noted however, such reliance already presents its own problems. See *supra* note 283.

and one that would provide Lennon with a great deal of protection under the Lanham Act. Nevertheless, the approach falls short as the best available option for two reasons.

First, because of the negligible degree of uncertainty as to whether or not Lennon has in fact been damaged, the view would still have to be advanced with some precariousness. McCartney could even raise an instance occurring during Lennon's lifetime as evidence that his partner has not been damaged. In 1976, McCartney included five Beatles songs originally credited to "Lennon/McCartney" on his live concert album "Wings Over America."²⁹⁴ McCartney transposed the credits to read "McCartney/Lennon," and neither Lennon nor Ono²⁹⁵ raised any objection.²⁹⁶ The argument to be made would obviously be that if Lennon

294. See *WINGS, WINGS OVER AMERICA* (Capitol Records 1990) (1976).

295. It is worth noting Ono's own failure to raise an objection, since Ono was responsible for handling a significant portion of Lennon's business affairs, even when Lennon was alive. See SHEFF, *supra* note 1, at 11. Ono states: "There was a demand about dealing with the business that needed to be filled." *Id.* Lennon notes that "the only of us that has the talent or the ability to deal with it on that level is Yoko." *Id.*

296. See Garcia, *supra* note 16. A claim can be made that there have been circumstances where when the situation was reversed, McCartney did not raise a similar objection. In 1981, shortly after Lennon's death, Elton John released a single from a 1974 concert that featured Lennon joining him for a rendition of the Beatles' "I Saw Her Standing There." See ELTON JOHN BAND FEATURING JOHN LENNON AND THE MUSCLE SHOALS HORNS, *I Saw Her Standing There*, on 28TH NOVEMBER 1974. . . (DJM 1981). The single was released with the credits reading "Lennon/McCartney," even though "I Saw Her Standing There" was originally credited on the album "Please Please Me" as written by "McCartney/Lennon." See THE BEATLES, *I Saw Her Standing There*, on PLEASE PLEASE ME (Capitol Records 1987) (1963). This argument is weakened however by the fact that shortly after "Please Please Me" was released, the song appeared on the United States release "Meet the Beatles" (The U.S. version of the U.K.'s "With the Beatles") and was credited on that album as "John Lennon-Paul McCartney." See THE BEATLES, *I Saw Her Standing There*, on MEET THE BEATLES (Capitol Records 1964). A more telling situation involves the Lennon authored song "Give Peace a Chance." The song was recorded and released as a single in 1969 by Lennon and Ono's Plastic Ono Band, not the Beatles. See Wikipedia Encyclopedia, http://en.wikipedia.org/wiki/Give_Peace_a_Chance (last visited Feb. 13, 2006). Nevertheless, the song was credited to "Lennon/McCartney." See *id.* Lennon explains: "I didn't write it with Paul; but again, out of guilt, we always had that thing that our names would go on the songs even if we didn't write them." See SHEFF, *supra* note 1, at 214-15. The Beatles had not yet disbanded, so it is possible, as McCartney has indicated in interviews, that Lennon's motivations were purely to satisfy legal obligations, which if true, supplies some indication of Lennon's respect for the legal status of the term "Lennon/McCartney." See Howard Stern, *supra* note 6. That said, McCartney's name no longer appears on the subsequently released Ono authorized compilations of Lennon's work that feature the song. See JOHN LENNON, *Give Peace a Chance*, on WORKING CLASS HERO: THE DEFINITIVE LENNON (Capitol Records 2005) (where credits read "[a]ll songs composed by John Lennon except where stated otherwise," and there is no statement otherwise). McCartney has never objected to this change, and so perhaps he deserves some of the same recognition afforded to Lennon for not objecting to the "Wings Over America" alteration. An interesting footnote to this story, is that a party who perhaps deserved to be credited for his contributions to "Give Peace a Chance," was not Rabbi Abraham Feinberg, "described at the time as a 'hip 69-year old' who had once worked as a

did not object then, why would he object now, thirty years later? The fact that thirty years have passed however, could be looked upon as the critical factor, since it is more than conceivable that one would change their attitude on something of that nature over a thirty year span. As Ono has noted, “the important point is that John has to be here,” and “[h]e is not.”²⁹⁷ Add to that, Lennon’s suppositional feelings on the matter are far less significant legally, than Ono’s, the rightful owner and protector of Lennon’s legacy. Furthermore, the Beatles’ legacy and its sustention may require an approach today that is unlike the one taken thirty years ago, and so those with an interest in the Beatles should not find themselves suddenly bound by past actions or inactions.

Ultimately however, a court would have to decide the matter, and determine whether the express reverse passing off was in fact damaging. While there is a high likelihood of finding for damages, determining the extent of those damages under this cause of action still remains somewhat tenuous in its resolution.

A second reason to avoid the express reverse passing off argument, is that even if we were to assume that Lennon has personally been damaged, even significantly damaged, and deserving of compensation, it would still mean that our attempt to protect the “Lennon/McCartney” trademark has been only halfway successful. Express reverse passing off addresses the lessening of Lennon’s own value. What it does not take into account however, is the devaluation of the entire Beatles consortium and its many interested parties.²⁹⁸ While Lennon as an individual would be due relief, as was the case in *Smith v. Montoro*,²⁹⁹ the other rightful owners would have a difficult time proving their damages. For this reason, we turn to our last trademarks argument, the dilution doctrine,³⁰⁰ as the best available option for demonstrating the unexclusive damage that would be caused as a result of transposing the credits.

While the diminishment approach under copyrights suffers from its lack of authoritative support, the same approach under the law of trademarks is bolstered by the FTDA.³⁰¹ As has already been set forth, this Comment proposes that the transposition of “Lennon/McCartney” is a form of pure tarnishment, as it “degrades the positive associations and the distinctive quality of the mark.”³⁰²

singer,” is said to have inspired the song by remarking to Lennon: “John, we really have to give peace a chance.” See Richard Brooks, *Hip Rabbi Gave Lennon’s Peace Song a Chance*, SUNDAY TIMES (London), Nov. 13, 2005, at 3.

297. See Eliscu, *supra* note 12, at 19.

298. See *supra* note 242 and accompanying text.

299. 648 F.2d 602, 602-03, 608 (9th Cir. 1981).

300. See discussion *supra* Part II.B.2.

301. See 15 U.S.C. § 1125(c) (2000).

302. See *Panavision Int’l L.P. v. Toeppen*, 945 F. Supp. 1296, 1304 (C.D. Cal. 1996), *aff’d*

Though the parallels between the case at hand and *Dallas Cowboys Cheerleaders*³⁰³ are strong, the focus of that case was on the disapproval of the cheerleading uniform mark's association with a pornographic film, and the unwholesome light shone by that coupling.³⁰⁴ Not directly addressed by the court, but outlined in the opinion, is the role that the Dallas Cowboys Cheerleaders play as a subsidiary of their parent football club.³⁰⁵ An analogy can certainly be drawn between the Beatles and the Dallas Cowboys, in terms of each one's strong identity and communal attributes. When one is a fan of a sports team, and seemingly more so with certain teams, such as the Dallas Cowboys,³⁰⁶ it is the various trademarks of that

without opinion, 159 F.3d 1351 (3d Cir. 1998).

303. See *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202 (2d Cir. 1979).

304. See *id.*

305. See *id.*

306. The Dallas Cowboys are often referred to as "America's Team." See generally PETER GOLENBOCK, *COWBOYS HAVE ALWAYS BEEN MY HEROES: THE DEFINITIVE ORAL HISTORY OF AMERICA'S TEAM* (1997). The team is seemingly more famous than most other teams. See Rick Telander, *7 Days: A Week With the Dallas Cowboys: Moments of Low Humor and High Purpose, Ending, as Usual, with a Win*, *SPORTS ILLUSTRATED*, Dec. 12, 1994, at 20 ("[T]he Cowboys are America's Team, a phenomenon that transcends the narrow confines of regional fandom."). In commenting on the Dallas Cowboys being valued by *Forbes* magazine at over \$1 billion, sports columnist Tim Cowlshaw noted: "They may not deserve it. A lot of people may hate America's Team. But for whatever reason they've been able to sell that brand, even without winning the last ten years." *Around the Horn* (ESPN television broadcast Apr. 21, 2006) [hereinafter *Around the Horn*]. Other teams for whom it can possibly be said, that their fame and fans are more widespread than other teams, are baseball's New York Yankees, English soccer's Manchester United Red Devils and college football's Notre Dame Fighting Irish. See *id.* (sports columnist Bill Plaschke commenting on the Yankees' being valued at over \$1 billion: "The Yankees are the worldwide brand in sports. They are the most popular team in the world."); see also Sarah Lyall, *English Are Hostile After a U.S. Soccer Takeover*, *N.Y. TIMES*, May 19, 2005, at A1 ("[W]ith a fan base said to be more than 50 million in 85 countries, Manchester United, . . . , is rivaled by only the New York Yankees as the most recognizable sports franchise in the world."); see also John Walter, *2 Notre Dame*, *SPORTS ILLUSTRATED*, Apr. 28, 1997, at 60 ("Since its inception in 1887 Notre Dame football has produced . . . millions of ardent advocates and antagonists . . ." and "ha[s] given the sport its most famous coach . . . ; pep talk . . . ; [and] fight song"); Pete Thamel, *Weis a Quick Study in Lore of the Irish*, *N.Y. TIMES*, Oct. 11, 2005, at D1 ("The allure of Notre Dame is fueled by its *lore* . . .") (emphasis added). In the world of music, aside from the Beatles, there are other bands who can claim a similarly heightened communal aspect, that is replete with trademarks. One such example would be the band KISS, who have sold 80 million records to a legion of fans often referred to as the KISS Army. See Matthew Rees, *Kiss and Sell*, *THE WEEKLY STANDARD*, Dec. 21, 1998, at 8 (noting that the band members who were famous for performing in makeup covering their entire faces, appeared in the mid-1980's on MTV "and showed their bare faces, dispelling the mystique that depended on no one's supposedly knowing what they really looked like"). KISS lead guitarist Ace Frehley once noted that "the fans want the mystique preserved. Our fans are into us as superheroes. Who wants to see Batman dressed in jeans and a T-shirt? Everybody asks us if we'll unmask ourselves before we quit Once we do it, it's going to damage the myth." DAVID LEAF & KEN SHARP, *KISS: BEHIND THE MASK* 79 (2003). Another famous symbol of the band KISS, is the tongue of bassist Gene Simmons, which has been the focus of several advertisements, and the

team and the fans' familiarity with them that becomes a part of the attraction and undying devotion.³⁰⁷ As noted in *Dallas Cowboys Cheerleaders*, "the combination of colors and collocation of decorations" is what distinguishes the Dallas Cowboys Cheerleaders from other cheerleading squads. If the decision was suddenly made to switch the cheerleaders' or players' uniforms to entirely different colors, or to abandon their blue star emblem, it would likely rattle the foundation of Cowboys nation, in that those symbols would no longer be theirs to share as a community.³⁰⁸ There is an inherent value in

namesake for his own magazine, *Tongue*. See *id.* at 137 ("Gene Simmons: Even in the early club days, I was doing the tongue thing. It just somehow stuck out . . ."); see also Jane Irene Kelly, *Sperry Exits A&L for Halloran*, ADWEEK, Aug. 2, 1999 ("The launch print ad uses an image of Kiss rocker Gene Simmons in full stage makeup, his famous tongue unfurled to the limit."); see also Anita Chabria, *Gene Simmons' Tongue Sticks Out by Keeping Things Clean*, PR WEEK, Jan. 13, 2003, at 13 ("It's not hard to spot Gene Simmons' Tongue magazine on the news rack. The cover model invariably has his or her tongue sticking out, mimicking the oral antics of the Kiss bassist . . ."). This is not to say that the tongue itself is a protected trademark, but were something to happen to that tongue, an identifiable symbol to the KISS community, and it were to be lost, one could imagine the adverse effect it would have on the various KISS assets. It is not an absurd notion in light of Van Halen guitarist Eddie Van Halen's recent battle with cancer. See *Diary of a Loud County*, OC WEEKLY, Dec. 21, 2004, at 27 ("We watched as Eddie Van Halen sucked on several cigarettes, even though he had part of his tongue removed because of cancer."). See also Fiona Clark, *The Sum of the Parts is Equal to a Star*, THE ADVERTISER, Oct. 23, 1996 (noting the rumors of Gene Simmons insuring his tongue); Josh Friedman, *The Outrageous Entrepreneur*, L.A. TIMES, Mar. 4, 2006, at C1 ("As the tongue-wagging singer for the rock band KISS, Gene Simmons likes to brag about turning a band into a brand.").

307. Similar to the tongue of Gene Simmons discussed *supra* in note 306, the Dallas Cowboy's emblem, a blue star, has special meaning to fans of the Dallas Cowboys. See Frank Luksa, *Teague Answered the Call; Long Before Joe Horn, the Cowboys Safety Ran a Showboat Aground*, DALLAS MORNING NEWS, Dec. 21, 2003, at 4C (applauding George Teague for "knock[ing] Terrell Owens on his butt" when the San Francisco 49ers wide receiver ran to the Cowboys' star emblem painted on the fifty yard line after scoring a touchdown, after having spiked the ball on the emblem earlier in the game after a touchdown as a show of disrespect to the Dallas Cowboys and their fans). Similarly, a fedora may have a special meaning for Dallas Cowboys fans separate from others' general conceptions of fedoras. See Tom Hartzel, *I-30 Makeover Moves Closer to Finish Line*, DALLAS MORNING NEWS, Dec. 11, 2005, at 21B ("The new Tom Landry Highway comes with several added features . . . About 20 fedoras will dot the project, with most of them as impressions on the road's concrete signposts and bridge columns. The design resembles the *trademark fedora* of Mr. Landry, who coached the Dallas Cowboys.") (emphasis added). Again, like Simmons' tongue, Landry's fedora may not qualify as a valid trademark in the way the term "Lennon/McCartney" does, but simply taking note of the phrase "trademark fedora," and use of the word when referring to something overly familiar, shows the important role certain symbols play in enhancing the valuable communal element.

308. Many sports franchises will change uniforms regularly for the sake of merchandising. See Kyle Parks et al., *Winning Games, Selling Clothes*, ST. PETERSBURG TIMES, July 17, 2000, at 3E (noting that a short term solution to improving merchandising is changing uniforms); see Bob Foltman, *Uniform Code: You've Either Got Or You Haven't Got Style*, CHI. TRIBUNE, Apr. 3, 1994, at C9 (noting the frequency with which the Chicago White Sox change their uniforms). That said, there are certain franchises for whom it would seem that the rewards of new uniforms would be heavily outweighed by the destruction of that which is considered sacred to the fans. It is unfathomable to think that the New York Yankees would ever see a benefit in abandoning their pinstripes. See Keith Olbermann, *Looking Good in Pinstripes*, MEN'S HEALTH, Sep. 1, 2005, at 36 ("90 years ago, the Yankees settled on a uniform that remains essentially the same today . . . The Yankees' pinstripes continue to transcend time."). Olbermann recalls that "[i]n the winter of 1975-

keeping that community intact, and maintaining the perpetual belief that the community is still whole.

So while some may view the transposition of the names as a disruption to the community, because McCartney's switch suddenly alerts fans to a certain discord between the songwriters, that is not the actual damage that has been caused. Many followers may be well aware of the contention, and possibly even embrace it too as part of the lore, in addition to which there is likely no way to measure the loss of or added value in there being perfect harmony between the songwriters. The real damage is a result of the "Lennon/McCartney" credit being an established mark embodied in forty plus years of Beatles lore, and the defiant act of McCartney's that could now permanently reduce the total number of trademarks, each of which is vital to the makeup and personality of the community. That infringement is damaging to any owner of any Beatles property right, who all heavily rely on maintenance of the status quo in order for there to be the continued support from the community to which they cater. That potential for such widespread damage is what makes this dilution claim the one most deserving of a court's consideration, and the one upon which Lennon would be most likely to succeed.

3. Violation of the Right of Publicity

It would be sensible for Lennon to attach to any copyright or trademark infringement action, a state claim under the right of publicity.³⁰⁹ Succeeding solely on this claim however, would again only be a partial victory for the same reason relief would be incomplete when making a charge of express reverse passing off.³¹⁰ Only Lennon would benefit under the right of publicity, as it is his name in particular that is being denied compensation for

76, the team announced that it would commemorate the nation's Bicentennial by wearing road uniforms that were the exact opposite of those legendary home outfits – dark blue, with white pinstripes and lettering." *Id.* He notes that "[t]o this day, we don't know if owner George Steinbrenner was the one who dreamed up that idea – or the one who ordered it canceled." *Id.*; see also *Around the Horn*, *supra* note 306 (Bill Plaschke noting that "[e]ven the pinstripe . . . it went from the Yankees' uniform to our suits we wear to work"); Lauren Cabell & Rick Tuma, *Fashion (At The) Plate*, CHI. TRIBUNE, June 13, 2000, at N10 (noting that the Yankees are the only team not to adopt putting players names on uniforms). The Yankees are simply a more valuable commodity with pinstripes than without. See Parks, et al., *supra* (noting that the Yankees sold more apparel than any other major league baseball team in 2000); see also Mike Hiestand, *Black Widow Takes Cue From Other Top Athletes and Markets Image*, USA TODAY, Mar. 10, 2005, at 2C (noting that Yankees pitcher Randy Johnson has the best selling baseball jersey).

309. See *supra* notes 201-02 and accompanying text.

310. See *supra* p. 232 (discussing shortcomings of express reverse passing off argument).

its use.³¹¹ As such, the other parties damaged would not be protected by this claim.³¹²

Success under this cause of action can be expected however, by following the reasoning that “McCartney/Lennon” is an unauthorized use of Lennon’s name, no different than if McCartney were to attribute authorship to any artist with no involvement in the songs, for the purpose of enhancing the music’s value through the use of that public figure’s identity.³¹³ For example, were McCartney to release a song falsely credited to “McCartney/Dylan,” he may be forced to defend an action brought by Bob Dylan on the same grounds.

The argument can be made however, that the term “McCartney/Lennon” is neither a name nor likeness that is representative of Paul McCartney or John Lennon, but instead represents the hybrid non-person Lennon/McCartney.³¹⁴ Even if this were the case however, it is not of consequence as *Motschenbacher v. R.J. Reynolds Tobacco Co.*³¹⁵ is clear that “identifiability” alone is sufficient to form the basis for a right of publicity claim.³¹⁶ It is apparent, certainly within the context of a music purchase, that the term “McCartney/Lennon” is being used as a means of identifying the artists whose names are contained in the term.

As to Ono’s inheritability of Lennon’s right of publicity, its descent would likely be controlled by the laws of the state of New York, “the situs of the property.”³¹⁷ Lennon was a domiciliary of the state of New York when he was murdered, and Ono continues to occupy an apartment in the same building where she lived with her husband.³¹⁸ Thus the laws of descent

311. See *supra* notes 201-06 and accompanying text.

312. See *supra* notes 201-06 and accompanying text..

313. See *supra* notes 201-06 and accompanying text..

314. This brings to mind the character Samneric from *Lord of the Flies*. See generally WILLIAM GOLDING, *LORD OF THE FLIES* (1954). There, twin boys are so inexorably linked that they are considered and become known as one person who is neither Sam nor Eric. *Id.* Though the narrator refers to the brothers as “Sam and Eric,” when spoken, their names undergo a metamorphosis, as the initial moniker “Sam ‘n Eric” eventually becomes “Samneric.” See *id.* at 21, 39, 63.

315. 498 F.2d 821 (9th Cir. 1974).

316. See *id.* at 826-27. In *Motschenbacher*, alterations such as switching the race car’s number “11” to a “71” were not enough to say the plaintiff was not identifiable from the ad. See *id.* at 822, 827. Those alterations can be analogized to the transposition of the names here, and Lennon’s identifiability despite the alteration.

317. See *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013, 1029 n.13 (C.D. Cal. 1998) (citing *Bi-Rite Enter., Inc. v. Button Master*, 555 F. Supp. 1188, 1197 (S.D.N.Y. 1983) (citing *Groucho Marx Prods. v. Day & Night Co.*, 689 F.2d 317, 319 (2d Cir. 1982))). See also *supra* note 224 and accompanying text (discussing New York’s choice of law rules for the right of publicity’s inheritability).

318. See *Yoko Ono Tried to Stop Film*, DAILY POST (Liverpool, Eng.), Jan. 21, 2006, at 7 (discussing Ono’s recent failure to prevent the shooting of a film about the murder of her husband, on the doorsteps of the Dakota apartment building, where she has lived since 1973); see also *supra* note 9 and accompanying text (discussing Lennon’s murder upon entering his residence in New York).

would be controlled by the state of New York, which has found the right of publicity to be inheritable.³¹⁹

The distinction between the right of publicity and the right of privacy, and their general applicability to a public figure's pecuniary interest and a private citizen's free solitude, respectively, has already been noted.³²⁰ However, in circumstances such as ours, where the law allows this right of publicity to be passed to one's heirs, Lennon as a decedent is not a beneficiary in any way to this pecuniary interest. This Comment would therefore propose, in opposition to the traditional view that reserves the right of privacy for private citizens, that it is an equally appropriate action to be brought once a celebrity is deceased. An argument can be made that celebrities still seek the spotlight even after death, for the financial benefit of their heirs, and are thus not deserving of the "right to be let alone."³²¹ Yet for many celebrities, it would seem that this is exactly what would be hoped for, the ability to leave the world knowing that their legacy will remain intact and undisturbed. While Ono continues to rightfully employ Lennon's name and image for merchandising purposes,³²² and is entitled to fair compensation for anyone else's unauthorized infringement of that right, it would only seem just, that at least on a symbolic level, Ono should also inherit a second right that is aimed directly at safeguarding the legacy of her late husband. Alone however, the right of publicity will nicely complement any of Lennon's other potential claims against McCartney, whose best defense is still going to be an assertion of his rights under the First Amendment.

319. See *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1104 (S.D.N.Y. 1980), *rev'd on other grounds*, 652 F.2d 278 (2d Cir. 1981) ("The Court has reaffirmed its initial ruling that the plaintiffs possess a valid and transferable right of publicity that survived Elvis Presley's death.").

320. See *supra* notes 201-02 and accompanying text.

321. See Warren & Brandeis, *supra* note 201, at 195 (describing the right of privacy as the "right 'to be let alone'").

322. See Jean Teeters, *Yoko Ono: Keeping the Flame Alive*, http://articles.absoluteselsewhere.net/Articles/yoko_flame_alive.html (last visited Feb. 13, 2006) ("Ono has defended her marketing of Lennon's art. 'I don't think I'm merchandising John aggressively at all. If John's stuff is not out there, people forget about him. It's as simple as that.'"); see also QVC, *John Lennon Jewelry Collection*, http://www.qvc.com/jw/jw_john_lennon2.html (last visited Oct. 10, 2006) (selling jewelry with designs inspired by Lennon's "personal drawings, lyrics, and trademark signature").

B. McCartney's First Amendment Defense

McCartney's potential argument that he is free to artistically express his views regarding the true authorship of the songs, is a defense that may fail under the threshold question that precedes any analysis. In order to receive a higher level of protection, the term "McCartney/Lennon" would first have to qualify as an expression that contains at least some artistic component.³²³ Assuming though that Lennon takes the best available route, that of anti-dilution, McCartney could rely on the same arguments, which essentially speak to the songwriting credit's role in the presentation of the entire song package.³²⁴ Under the same lore based analysis, it would seem that McCartney is entitled to some acknowledgement by the court, that the credit is not just an indication of authorship, but a creative element of the song. Furthermore, as noted, the two-name billing term, "Lennon/McCartney," and even its sequencing, was carefully conceived with at least some degree of artistry.³²⁵ Nevertheless, a distinction certainly exists between the naming of a song, such as in *Parks v. LaFace Records*,³²⁶ and the terming chosen for a songwriting credit. The song title, which is newly conceived and varies from one underlying work to the next, is obviously the greater opportunity for the artist to enjoy their free expression. However, that said, the name of the band, in our case "The Beatles," is an artistic expression, even though it remains constant for all underlying works.³²⁷ While a songwriting credit may not receive additional protection in most circumstances, it is readily conceivable that under this unique set of circumstances that it could be viewed as something that is beyond commercial speech.³²⁸

Upon reaching a conclusion that the term "McCartney/Lennon" possesses artistic attributes, the weight and depth of those attributes must then be balanced against the rights of the plaintiffs.³²⁹ A court would strike

323. See *supra* notes 152-54 and accompanying text.

324. See discussion *supra* Part III.A.2.

325. See *supra* note 3 and accompanying text.

326. 329 F.3d 437 (6th Cir. 2003).

327. See ANTHOLOGY *supra* note 3, at 41 (discussing the various explanations for how Lennon and Stuart Sutcliffe conceived of the name "The Beatles"). Lennon explains: "I was looking for a name like The Crickets that meant two things, and from crickets I got to beetles. And I changed the BEA because 'beetles' didn't mean two things on its own." *Id.* Harrison has said, with McCartney concurring, that Lennon and Sutcliffe were inspired by a line in the film "The Wild One" starring Marlon Brando, "where Lee Marvin says, 'Johnny, we've been looking for you, the Beatles have missed you, all the Beetles have missed you,'" and Harrison adds "[w]e'll give it fifty/fifty to Sutcliffe/Lennon." *Id.* Sutcliffe was the bass player for the Beatles during their first two years in existence. See *id.* at 62; see also Wikipedia Encyclopedia, http://en.wikipedia.org/wiki/Stuart_Sutcliffe (last visited Feb. 13, 2006). Before the Beatles achieved their success, Sutcliffe left the band to pursue a career as an artist, forcing McCartney into the role of bass player. See *id.* Sutcliffe died soon after, in 1962, at the age of twenty-one. See *id.*; see also ANTHOLOGY, *supra* note 3, at 69.

328. See *supra* note 152 and accompanying text (discussing the lower level of protection afforded to commercial speech).

329. See *supra* notes 154-56 and accompanying text.

this balance by applying one of the three accepted tests: the likelihood of confusion test, the alternative avenues test, or the *Rogers* test.³³⁰

A court applying the likelihood of confusion test, would seek guidance in either the *Sleekcraft* factors, the *Polaroid* factors, or some combination that borrows from each.³³¹ Since we do not, as the Ninth Circuit has said, “count beans,”³³² anticipating how a court using this test may apply each factor, would require painstaking speculation too exhaustive for this Comment. However, in highlighting a number of the factors, it would seem that weighing heavily in Lennon’s favor would be those that look to the strength of the plaintiff’s mark, the proximity of the products underlying the mark, and the intent and good faith of the defendant,³³³ while McCartney could benefit from factors that weigh the similarity of the two marks³³⁴ (a factor geared more towards finding a confusing similarity between expressions and trademarks that are only one or a few letters off and phonetically very similar, e.g., Slickcraft and Sleekcraft),³³⁵ and the sophistication of the buyers,³³⁶ who are likely to understand that this is only McCartney’s personal expression and opinion on the matter, and not a means of commercialization.

Polaroid’s distinctive seventh factor, which examines the quality of a defendant’s mark,³³⁷ could spawn the same dilution considerations spoken of in Part III.A.2.³³⁸ “This factor is primarily concerned with whether the senior user’s reputation could be jeopardized by virtue of the fact that the junior user’s product is of inferior quality.”³³⁹ And so in our case, beyond the predominant trademark dilution issue, there are the more acute qualitative concerns that result from McCartney’s expression that he is the true author. With the possibility that some purchasers may already be under the impression that Lennon is the primary songwriter, misguided as that impression may be, such an assumption could represent the preferred view for many, and form the basis of their support of the Beatles. It can not be

330. See discussion *supra* Part II.B.3.

331. See *supra* notes 157-69 and accompanying text.

332. See *supra* note 165 and accompanying text.

333. See *supra* notes 160-61 and accompanying text.

334. See *supra* notes 160-61 and accompanying text.

335. The term “McCartney/Lennon” does not represent such proximity, as it has even been noted that the phonetic difference between “McCartney/Lennon” and “Lennon/McCartney” is almost “jarring.” See Boucher, *supra* note 229, at A1.

336. See *supra* note 161 and accompanying text.

337. See *supra* notes 162-63 and accompanying text.

338. See discussion *supra* Part III.A.2.

339. See *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384, 398 (2d Cir. 1995) (citing *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 (2d Cir. 1986)).

denied that oftentimes one's appreciation for an underlying work is based solely on the name attached to that work.³⁴⁰ Remove the name, or transpose two names, and the work, though unchanged, could decline in its perceived quality, and thus overall value.³⁴¹ Here, if McCartney claims to be the true author, even though he may very well be the true author, and even though the song is unchanged, for some it will become an inferior or even worthless product. As such, in weighing this one particular *Polaroid* factor, a court could conclude that McCartney's artistic expression offsets too dramatically the rights afforded to Lennon.

340. A name's attachment to a work can come in the form of authorship, or just endorsement, with each one having great value. A horror film that is "directed by" Eli Roth, but is also "presented by" Quentin Tarantino likely benefits more from the acclaimed director Tarantino's name than it does from the less acclaimed Roth's. See Catherine Billee, *Horror Film Displaces "Narnia" and "Kong" at Box Office*, N.Y. TIMES, Jan. 9, 2006, at E2. Sometimes celebrities are paid to have their names attached to magazine titles, under the belief that it will help boost sales. See David Carr, *The Media Business: Advertising; No Damages in Rosie Case, Judge Hints*, N.Y. TIMES, Nov. 13, 2003, at C1 (discussing *McCall's* magazine's decision to become *Rosie* magazine, endorsed by television personality Rosie O'Donnell); see also David Carr, *On Covers of Many Magazines, A Full Racial Palette is Still Rare*, N.Y. TIMES, Nov. 18, 2002, at C1 (discussing *O* magazine, which features television personality Oprah Winfrey on the cover of every issue). In terms of actual authorship, there are many books written by public figures "with" the help of a professional writer, who is generally not as famous. See, e.g., DONALD J. TRUMP WITH MEREDITH MCIVER, *TRUMP: THINK LIKE A BILLIONAIRE* (2004) (television personality and real estate tycoon Trump's name is significantly larger in font size than professional writer McIver's); JACK WELCH WITH JOHN A. BYRNE, *JACK: STRAIGHT FROM THE GUT* (2001); MIKE WALLACE WITH GARY PAUL GATES, *BETWEEN YOU AND ME: A MEMOIR* (2005). Sometimes a public figure and a professional writer are credited equally as co-authors, but the public figure's name generally precedes the professional writer's name, and is often in a larger font size, in addition to the public figure being pictured on the front cover without the professional writer. See, e.g., JOHN WOODEN & STEVE JAMISON, *WOODEN ON LEADERSHIP* (2005). For either scenario, it can be said that the removal of the more famous person's name will lessen the value of the book. Similarly, an argument can be made regarding the transposition of names. For example, printing the name McIver, first and in a large font size, followed by the name Trump, second and smaller, would also devalue the work, as consumers who are purchasing the book primarily due to Trump's cachet and contributions, may now be under the assumption that a smaller contribution has been made. Alternately, those who are admirers of McIver, and not Trump, would perhaps be more likely to purchase the book, if they were to now make a similar assumption that she was the greater contributor (even though it is very possible that even when listed second on the cover and smaller, that she was in fact the greater contributor, given that she is the professional writer and Trump is not). There is no guarantee however, that those two demographics, admirers of Trump and admirers of McIver, would be equal in size, just as there is no guarantee that those preferring McCartney over Lennon would be equal in size. Therefore, McCartney could not argue that the additional support of his own admirers would make up for the losses suffered, thus justifying these damages as being negligible.

341. Interestingly, Ono was involved in a movement spearheaded by the twentieth-century modern artist George Maciunas, called FLUXUS, "within which individual artistic attributions (and copyright) would be forbidden . . . [and] demanded that all artists . . . would produce under the name FLUXUS." See Lastowka, *supra* note 86, at 1182. "Commentators today, however, routinely identify George Maciunas as the artistic originator of the FLUXUS group, and point to the respective involvement of John Cage, Yoko Ono, . . . and others. The success of the FLUXUS movement in attracting attention was the cause of its failure to achieve its goals." *Id.*

For courts applying the alternative avenues test,³⁴² the outcome would again depend heavily on the mindset of the court. Under the *Novak*³⁴³ approach, which focuses on the actual avenues available for distributing the idea,³⁴⁴ it would seem that Lennon could suppress McCartney's ability to express his feelings on true authorship through the songwriting credits, since McCartney has already demonstrated that he has other means of informing the public on these matters.³⁴⁵ McCartney has the ability to spread any message through the media,³⁴⁶ and continues to fill stadiums around the world with audiences to whom he can convey his thoughts.³⁴⁷ There is also nothing preventing McCartney from publishing a book, that outlines true authorship of all Beatles songs, just as Lennon chose to do in *All We Are Saying*.³⁴⁸

Applying however the *American Dairy Queen*³⁴⁹ approach, which looks more directly at the expression itself,³⁵⁰ it would seem impossible for McCartney to intimate true authorship through an alternate to the "McCartney/Lennon" expression. McCartney's chosen form uses an inferential method of claiming true authorship, and is already objectionable. Any other method would even more explicitly infringe on Lennon's trademark rights, and so a court here would have to agree that there are no reasonable alternative avenues available for McCartney to convey his expression, other than by the method he has chosen.³⁵¹

Finally, for a court applying the currently most popular *Rogers* test,³⁵² McCartney's expression will be protected by the First Amendment provided it satisfies two provisions.³⁵³ First, McCartney's "McCartney/Lennon" expression must be artistically relevant to the underlying work.³⁵⁴ Clearly

342. See *supra* notes 170-80 and accompanying text.

343. *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987).

344. See *supra* note 173 and accompanying text.

345. See generally Lampert, *supra* note 6, at 7.

346. See *id.*

347. See Ray Waddell, *McCartney Ready to Tour Again*, BILLBOARD, Apr. 18, 2005, http://www.billboard.com/bbcom/news/article_display.jsp?vnu_content_id=1000884566 (noting that "McCartney last toured North America in 2002, when he was the top touring artist in the world, grossing \$126 million from 58 shows, according to Billboard Boxscore"); see also Jonathan Cohen et al., *Money: Moneymaker* 3, BILLBOARD, Jan. 28, 2006, at 42 (noting that McCartney grossed over \$84 million in touring and album sales in 2005).

348. See generally SHEFF, *supra* note 1.

349. *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727 (D. Minn. 1998).

350. See *supra* note 175 and accompanying text.

351. See *supra* notes 176-80 and accompanying text.

352. See *supra* notes 181-98 and accompanying text.

353. *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

354. See *id.*

he satisfies this first prong. The songwriting credit is entirely relevant to the songs which are being credited. Obviously, this portion of the test was designed to address instances where the expression is a name of an individual who has no personal association with the underlying work.³⁵⁵ In order for McCartney to satisfy the second prong however, it would have to be determined that the “McCartney/Lennon” expression does not “explicitly mislead[] as to the source or the content of the work.”³⁵⁶ Whether or not it misleads, however, is entirely dependent on who is being asked, and how a court chooses to regard the expression in terms of its veracity. McCartney would argue that the statement does not explicitly mislead, and that the purpose of the expression is to present the truth, “so that no one is in any doubt as to who did what.”³⁵⁷ Accepting that argument though would seem to be a case of putting the cart before the horse. The issue is whether an artistic expression can be supported in spite of a recognized trademark right.³⁵⁸ The court is balancing whether that property right should be temporarily set aside in the interest of free speech, not whether that right is in the hands of the appropriate owner to begin with.³⁵⁹

Given the highly questionable nature of McCartney’s expression to begin with, in terms of its qualification as an expression, and the obstacles it would then be forced to overcome regardless of the balancing test applied, it would appear unlikely that his strongest possible challenge to the trademark rights of the various plaintiffs would prove successful and allow him to prevail.

IV. FUTURE TRENDS: *ESTATE OF LENNON V. MCCARTNEY* IN THE DIGITAL AGE

Lennon and McCartney will not only survive the music industry’s current transitional phase, but they will likely serve as instrumental figures in its rapid growth.³⁶⁰

Consumers are flocking to online music stores, with Apple Computer’s iTunes Music Store being the most popular so far.³⁶¹ As of February of

355. See, e.g., *Parks v. LaFace Records*, 329 F.3d 437, 441 (6th Cir. 2003) (determining whether Rosa Parks has anything to do with the subject matter of the OutKast song “Rosa Parks”).

356. See *Rogers*, 875 F.2d at 999.

357. See Lampert, *supra* note 6, at 7.

358. See *supra* notes 154-56 and accompanying text.

359. See *supra* notes 154-56 and accompanying text.

360. See generally *La Monica*, *supra* note 5.

361. Other licensed Internet sellers include: Yahoo! Music Unlimited, Real Rhapsody, and the new version of Napster. See *BMG Music v. Gonzalez*, 430 F.3d 888, 891 (7th Cir. 2005). The business models for these sites can vary; “customers may rent the whole library by the month or year, sample them all, and purchase any song they want to keep. [While] [n]ew technologies, such as SNOCAP, enable authorized trials over peer-to-peer systems.” *Id.* (citing Saul Hansell, *Putting the Napster Genie Back in the Bottle*, N.Y. TIMES, Nov. 20, 2005, at 3:1). In addition to these

2006, iTunes reported sales topping one billion tracks sold since its launch in 2003.³⁶² This announcement came only six months after Apple reported that sales had reached the 500 million mark, with each track being downloaded at a cost of ninety-nine cents per song.³⁶³ Meanwhile, CD sales continue to decline.³⁶⁴

While music purchased online may sometimes be accompanied by a “digital booklet” containing liner notes that can be downloaded as a Portable Document Format (“PDF”) file,³⁶⁵ the nature of online purchasing is such that with all of one’s music being stored on a computer hard drive or an MP3 player, such as an iPod,³⁶⁶ it would seem that liner notes will not serve as prominent a role for online music purchases as they have for vinyl records, audio cassette tapes, and CD’s. As such, songwriting credits may not be studied, or even incidentally glanced at, with the same discern and regularity that we have grown accustomed to.

That said, what may be of even greater interest to our discussion is the non-PDF data provided to consumers when music is either downloaded

licensed sellers, music is also downloaded by many users from illegal online file-sharing systems. The Supreme Court recently held that such sites can be found liable for contributory copyright infringement. *See* MGM Studios Inc. v. Grokster, Ltd., 125 S. Ct. 2764, 2782 (2005). Nevertheless, it remains to be seen to what extent this will reduce illegal downloading. *See* Brian Hiatt, *Music Fans Want Lower CD Prices*, ROLLING STONE, Feb. 23, 2006, at 12 (noting that sixty-one percent of those polled, who download music for free said “they ‘do not care’ if it is copyrighted”).

362. *A Billion for Apple*, DALLAS MORNING NEWS, Feb. 24, 2006, at 23; *see also* *1 Billion Served*, CHI. TRIBUNE, Feb. 24, 2006, at 72.

363. *See* Paul Thurrott, *Apple Faces Biggest iTunes Challenge Yet*, WINDOWSITPRO, Aug. 29, 2005, <http://www.windowsitpro.com/Article/ArticleID/47531/47531.html?>

364. *See* Ed Christman, *Year In Review: At Retail, Sales Dropped and Shelf Space Shrunk*, BILLBOARD, Dec. 24, 2005 (“In the waning weeks of 2005, U.S. album sales were down 10% in a 53-week comparison with last year and 7.7% in a 52-week comparison.” It is also noted that “[t]he growth of digital sales and digital piracy mean that a further CD rebound is highly unlikely . . . [D]igital sales have tripled over last year, with album sales growing to 14.1 million as of Dec. 4, compared with 4.7 million units generated in the corresponding period last year”). Despite the decline in CD sales however, a 2006 poll “reveals that despite digital music’s explosive growth, it remains a largely untapped market. Only twenty-six percent of those polled have ever downloaded music from the Internet, whether legally or illegally. And a mere fifteen percent of adults have paid for music online through services like iTunes.” *See* Hiatt, *supra* note 361, at 12. The decline in sales can also be attributed to consumers finding that CD prices are too high, the artistic qualities of the music being poor, and various competing forms of entertainment such as video games and DVD’s. *Id.*

365. *See* Brian Garrity, *Pay Now, Download Later*, BILLBOARD, Aug. 7, 2005 (“Digital booklets are emerging as standard supplements to most digital album pre-order specials.”); *see also* Jonathan Seff et al., *iTunes’ Birthday Music: After a Great Year, What Does Apple’s Music Store Do for an Encore?*, MACWORLD, May 2004, at 20 (quoting Amanda Marks, Senior Vice President of Universal Music Group eLabs as saying, “[w]e both would like to be able to make the CD booklet available to consumers who purchase the album’ . . . [w]e’re constantly working with [Apple] on things like that . . .”).

366. *See* Thurrott, *supra* note 363.

online, or when music is uploaded from a previously purchased CD onto a computer. A CD does not contain any digital information regarding the contents of the CD itself, “such as the identity of the artist, the name of the album, or the title of each song. To have such information displayed on the computer screen, customers must either manually enter it into the computer or obtain it from a database of information available through the internet [sic].”³⁶⁷ For example, when a CD is inserted into a computer so that it can be uploaded onto the iTunes music library software, if an Internet connection exists or when one is made, iTunes will automatically connect to a database owned by Gracenote, Inc.³⁶⁸ The Gracenote Media Recognition Service, using its patented technology, will then identify the CD, and retrieve from its database the correct information for that CD.³⁶⁹ That information is then imported with the CD’s music onto the user’s hard drive.³⁷⁰ Similarly, when purchasing a song from iTunes, the song has already been identified by Gracenote, and the data is transferred with the song to the purchaser’s computer when the purchase is made.³⁷¹ That data will then be transferred with the song, if the song is ever exported to an iPod. The user does have the ability however, to edit any information supplied by Gracenote, by typing personal entries into the various fields where the information appears on the computer.

Gracenote considers one of its “most interesting features,” the forum that it has created “for [the] exchange of music information between fans.”³⁷² Gracenote informs its users that if they “see an error in the data for a favorite CD, or the data is incomplete, . . . [they should] submit changes or additions to the database maintained by the service. In turn, [users will] benefit from the processed submissions from the millions of other fans who have ever used the service.”³⁷³ In other words, Gracenote’s online data will not necessarily be data submitted by the record companies, or even data that is based on the information provided in the liner notes of the albums sold at retail outlets. Specifically, when it comes to songwriting credits, Gracenote encourages users to submit this information, and notes that “this is usually the single [most] useful information you can add,”³⁷⁴ The site also

367. *Gracenote, Inc. v. MusicMatch, Inc.*, No. C 02-3162 CW, 2004 U.S. Dist. LEXIS 17617, at *4 (N.D. Cal. Aug. 26, 2004).

368. *See* Gracenote, FAQ: 2. General Questions About Gracenote CDDDB®, <http://gracenote.com/corporate/FAQs.html/faqset=what/page=all> (last visited Feb. 26, 2006); *see also* Method & Sys. for Accessing Remote Data Based on Playback of Recordings, U.S. Patent No. 6,230,192 (filed July 16, 1999) (issued May 8, 2001).

369. *See* Gracenote, FAQ: 2. General Questions About Gracenote CDDDB®, <http://gracenote.com/music/corporate/FAQs.html/faqset=what/page=all> (last visited Feb. 26, 2006).

370. *See id.*

371. *See id.*

372. *Id.*

373. *Id.*

374. *See* Gracenote, FAQ: 5: Submitting Edits or New Entries to the Database, <http://gracenote.com>.

points out that users “can add credits for the album, or for each individual track, or for segments,” indicating that Gracenote is content to compile all information for one album from more than one source.³⁷⁵

This is obviously an unsettling trend that can impact both Lennon’s and McCartney’s interests, and from the look of things, already has. An evaluation of the information provided by Gracenote when loading various Beatles CD’s onto iTunes, reveals an alarmingly wide variety of billing terms. The credits as they appear via Gracenote are not based on how the credits appear on the albums, nor on the personal accounts of Lennon or McCartney; instead, they are based on the input of random fans solicited by Gracenote.³⁷⁶ Two of the more unusual crediting choices by Gracenote and its anonymous contributors can be found when looking up the data supplied for the albums “Please Please Me” and “Rubber Soul.” The former credits all songs to “Lenon/McCartney” [sic], which not only spells Lennon’s name incorrectly, but also reverses the credit as it actually appears on “Please Please Me,” the one album where McCartney’s name precedes Lennon’s.³⁷⁷

The crediting on “Rubber Soul” is even more disconcerting, as it appears that the submitter(s) of the information to Gracenote, or Gracenote itself, has actually decided to attribute authorship to whomever the submitter(s) or Gracenote has determined is deserving of the credit. Below is a table that demonstrates how the composer credits appear when loading a “Rubber Soul” CD onto the iTunes computer software program.³⁷⁸

com/music/corporate/FAQs.html/faqset=subs/page=all (last visited Feb. 26, 2006). On iTunes, the songwriting credits can be accessed by selecting a song, right clicking the mouse, and choosing the “Get Info” option. Clicking on the “info” tab will then provide data that includes the name of the song, the artist, album, year, track number, genre, and composer(s). The iPod itself, when sold, is preset for users to access material through menus that organize the music by artists, albums, songs, and even composers, among others.

375. *Id.*

376. For the majority of the Beatles’ albums, Gracenote credits the songs written by Lennon and McCartney as composed by “John Lennon/Paul McCartney” or “John Lennon, Paul McCartney.” Examples include: “A Hard Day’s Night,” “Abbey Road,” “Let It Be,” “Magical Mystery Tour,” “Sgt. Pepper’s Lonely Hearts Club Band” and “The Beatles (The White Album).” There are a few albums however, for which Gracenote does supply the traditional two-name billing term of “Lennon/McCartney” or “Lennon-McCartney,” such as “With the Beatles,” “Help!” and “Revolver.” That said, how an album is credited one day, could change by the next, as it has already been noted that the Gracenote database is constantly updated as a result of new information being sent to those maintaining the database. *See supra* notes 372-75 and accompanying text.

377. *See supra* note 6 (discussing crediting on “Please Please Me”).

378. The credits appeared as such, when loading the Beatles’ “Rubber Soul” CD onto iTunes, on Feb. 26, 2006.

TABLE 1 — CREDITS FOR “RUBBER SOUL”: CD³⁷⁹ V. *BEATLESONGS*³⁸⁰ V. ITUNES/GRACENOTE³⁸¹

Song Title	Credit as it Appears on CD	Dowling’s Attribution of Authorship (in tenths)	Credit as it Appears on iTunes via Gracenote database
1. Drive My Car	Lennon/McCartney	McCartney (.7) and Lennon (.3)	Paul McCartney
2. Norwegian Wood (This Bird Has Flown)	Lennon/McCartney	Lennon (.8) and McCartney (.2)	John Lennon
3. You Won’t See Me	Lennon/McCartney	McCartney (1.00)	Paul McCartney
4. Nowhere Man	Lennon/McCartney	Lennon (1.00)	John Lennon
5. Think For Yourself	Harrison	Harrison (1.00)	George Harrison
6. The Word	Lennon/McCartney	Lennon (.6) and McCartney (.4)	Lennon-McCartney
7. Michelle	Lennon/McCartney	McCartney (.7) and Lennon (.3)	Paul McCartney
8. What Goes On	Lennon/McCartney /Starkey	Lennon (.6) and McCartney (.2) and Starr (.2)	John Lennon/Richard Starkey
9. Girl	Lennon/McCartney	Lennon (1.00)	John Lennon
10. I’m Looking Through You	Lennon/McCartney	McCartney (1.00)	Paul McCartney
11. In My Life	Lennon/McCartney	Lennon (.65) and McCartney (.35)	John Lennon
12. Wait	Lennon/McCartney	Lennon (.5) and McCartney (.5)	John Lennon
13. If I Needed Someone	Harrison	Harrison (1.00)	George Harrison
14. Run For Your Life	Lennon/McCartney	Lennon (1.00)	John Lennon

As the table above indicates, there are attributions of authorship on iTunes that skew the credits both favorably and unfavorably for each of the songwriters.³⁸² In addition, there are potential legal issues raised as a result of this dissemination of disinformation, some covered by topics already

379. THE BEATLES, RUBBER SOUL (Capitol Records 1987) (1965).

380. See DOWLING, *supra* note 1, at 297-98 (method for attributing authorship of songs).

381. Apple – iPod + iTunes, <http://www.apple.com/itunes/> (last visited Feb. 26, 2006) (where the free iTunes software program can be downloaded).

382. All told however, McCartney does appear to be disadvantaged by the Gracenote crediting more so than Lennon, with his name completely omitted from tracks 11 and 12, where his contributions were substantial. See *supra* notes 379-81 and accompanying table.

discussed, and others that are beyond the scope of this Comment.³⁸³ Those issues aside, the Gracenote crediting certainly supports McCartney's desire for the Beatles to attribute authorship themselves, before others do the same. Furthermore, it raises the prospect of the two-name billing term "Lennon/McCartney" entering relic-hood, and losing its trademark status, not just as a result of liner notes' devolution, but also due to the anarchy that often goes hand in hand with the Internet. That is not to say that this disintegration of the billing term will occur anytime in the near future,³⁸⁴ or even during the lifetime of McCartney or Ono, but perhaps it will be the case when the world is inhabited by future generations of Beatles fans and heirs.

It should be noted, that as of now the table above only pertains to situations where one loads a "Rubber Soul" CD onto their computer, and not when a single track is purchased, as the music of the Beatles is not yet available for purchase online.³⁸⁵ "[H]opes are increasing [however] that the Beatles may finally let their songs be downloaded as well."³⁸⁶ It is not unusual though for the Beatles to take their time, as they were one of the last bands to make their music available on CD, perhaps calculating each foray into a new medium, hoping to turn it into a celebrated event.³⁸⁷ And according to some it would be just that, as it has been said that "[a] deal for the Beatles' library of music would be, by far, the most significant in the nascent world of online music."³⁸⁸

383. Gracenote is only a database of names and titles, and does not distribute the underlying copyrighted material. That material is legally being distributed by iTunes, when they are authorized to do so. Nevertheless, it would appear that Gracenote could be forced to contend with right of publicity issues similar to the ongoing litigation involving the unauthorized use of professional athletes' names by fantasy sports providers on their online gaming databases. *See generally* C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P., No. 4:05CV00252MLM, 2005 U.S. Dist. LEXIS 55060 (E.D. Mo. Aug. 8, 2006); *see also supra* notes 207-11 and accompanying text (discussing *Uhlaender v. Henricksen*, 316 F. Supp. 1277 (D. Minn. 1970)).

384. Despite the drop in sales, CD sales are still healthy overall, with 3.5 billion units sold in 2004. *See Thurrott, supra* note 363.

385. *See generally* La Monica, *supra* note 5.

386. *See id.*; *see also* Lawrence Van Gelder, *Arts, Briefly*, N.Y. TIMES, Apr. 14, 2006, at E5 (reporting that the Beatles are "preparing to make the group's catalog available online," but are first "digitally remastering the entire catalog").

387. *See* La Monica, *supra* note 5.

388. *Id.* It would be a bit surprising however, if a deal is ultimately reached, that it would be with the iTunes music store, given the ongoing legal feud between the Beatles and Apple Computer over an infringement of the Beatles' Apple Corp. trademark. *See id.* In short, Apple Corp. and Apple Computer reached a settlement agreement in the early 1990's that allowed Apple Computer to continue using its trademark, so long as they agreed not to enter into the music business, which was considered the Beatles' territory. *See* Jefferson Graham, *Beatles Record Label Sues Apple Computer – Again*, USA TODAY, Sep. 20, 2004, at 4B. Now that Apple Computer finds itself in the music business, the Beatles believe that they have breached the settlement agreement. *See id.* In May of 2006, a British judge ruled in favor of the computer company. *See* Apple Corp. Ltd. v. Apple

It is difficult to say how venturing online will impact the Beatles' overall sales of CD's, and thus the availability of their liner notes in their current form, when taking into consideration that most of their fans are older than the average music downloader.³⁸⁹ One school of thought is that legal downloading, as opposed to the widely available illegal downloading, is the method of choice for older users, and so music stores such as iTunes would appeal to the Beatles' largest demographic.³⁹⁰ That said, the number of older downloaders is still relatively small overall,³⁹¹ though the addition of the Beatles to an online catalogue could quickly increase that number, and help to recruit new online users.³⁹²

For our purposes however, the real impact of the Beatles on the advent of online music, comes in the lessons to be gleaned from their history as a band. The business model of online music is based on the sale of individual songs, allowing consumers to pick and choose amongst various artists, à la carte, whichever songs they want.³⁹³ This suddenly adds a degree of pressure for musicians that has never been present before, in the sense that if a song does not meet a certain standard set by the consumer, then it runs the risk of not being sold.³⁹⁴ Thus, bands are not just competing against other bands, but musicians within those bands are competing against one another. It is therefore very possible that in situations where a band has more than

Computer Ltd., [2006] EWHC 996 (Ch.) (U.K.) (“[The defendant’s] use of the apple logo is a fair and reasonable use of the mark in connection with the service, which did not go further and (unfairly or unreasonably) suggest an additional association with the creative works themselves.”); *see also Apple Versus Apple*, N.Y. TIMES, May 9, 2006, at A26 (discussing the ruling). Despite their legal battles though, Apple Computer’s CEO “Steve Jobs has been described as ‘the kind of obsessive Beatles fan who can talk your ear off about why Ringo is an underappreciated drummer.’” *See* JEFFREY S. YOUNG & WILLIAM L. SIMON, *ICON: STEVE JOBS; THE GREATEST SECOND ACT IN THE HISTORY OF BUSINESS* 285-86 (2005). Prior to starting their own online music store, Microsoft tried to sign the Beatles to a deal, but those negotiations fell through. *See* Graham, *supra*.

389. *See* La Monica, *supra* note 5.

390. *See id.*

391. This is perhaps evidenced by artists such as Barry Manilow and Bob Dylan, ages sixty-two and sixty-five, respectively, recently debuting albums on top of the Billboard charts. *See* Helen Kennedy, *Number 1 Barry Can Smile Again*, N.Y. DAILY NEWS, Feb. 9, 2006, at 6; *see also* Steve Parks, *Cool 2 Know; He’s Everywhere; A Bob Dylan Moment*, NEWSDAY (New York), Oct. 11, 2006, at B3. This may indicate that older purchasers are the ones buying CD’s, while younger purchasers account for the drop in overall record sales. *See supra* note 364 and accompanying text. *But see* Matthew Creamer, *Dylan’s No. 1 Again – and Apple’s a Big Reason Why*, ADVERTISING AGE, Oct. 9, 2006, at 1 (attributing Dylan’s strong album sales in part to his appearance in television advertisements for iTunes and iPod, because the tie-in made him seem “‘younger, cooler and more progressive,’ . . .”).

392. *See supra* note 364 and accompanying text.

393. *See* Bob Tedeschi, *E-Commerce Report; Services for Downloading Music – Legal and With Making a Profit In Mind – Are Gaining Momentum*, N.Y. TIMES, July 28, 2003, at C5.

394. The iTunes music store provides a thirty second preview of any song, pre-purchase. *See* BMG Music v. Gonzalez, 430 F.3d 888, 891 (7th Cir. 2005) (“Licensed Internet sellers, such as the iTunes Music Store, offer samples . . . the teasers are just a portion of the original.”). In a sense this forces musicians to sell their songs in the same allotted time as other entertainment enterprises who advertise on television, and have thirty seconds to spark an interest.

one songwriter, the songs selling the most individual units will be disproportionately written by one of those two songwriters. Which means that the history of the Beatles should serve as a warning to musicians, that casual agreements to work as equal partners, splitting all royalties fifty-fifty, may not be the most sensible of business decisions given the industry's new framework.

Generally speaking, when a band is formed, actual success is a distant dream, and terms are agreed upon prior to when lawyers are affordable, and thus those terms are rarely, if ever, memorialized in writing. Such agreements can work, and often do, but it normally requires two songwriters with rare talent and the abilities of a Lennon and McCartney, to create a sense that nothing is being lost when sharing equally everything that is personally owned by one. Such agreements made under the wrong set of circumstances are inevitable however, and so when one band member writes the songs that do end up selling the most units, litigation over profits will in some instances be likely to follow.

V. CONCLUSION

After a lengthy analysis of what on its face appears to be a “petty” matter,³⁹⁵ it should not be lost on anyone, that though McCartney is likely very much in the wrong here, and could potentially be held liable in a suit similar to the one described herein, for trademark infringement under the FTDA, and for violating Lennon's right of publicity, he can hardly be called a Salieri, and is certainly a Mozart in his own right.³⁹⁶ McCartney is one of the most, if not the most, successful musicians of all time.³⁹⁷ And so it only begs the question that has yet to be answered in all this. Why does he care? Why does one of the most famous people on the planet, someone worth over a billion dollars,³⁹⁸ who is adored by fans everywhere he goes, and has lived a seemingly perfect life,³⁹⁹ have this burning desire to set the record straight by announcing to the world “I'm first!”?

395. See Eliscu, *supra* note 12, at 19 (where Ono's lawyer noted that “[t]his is very petty”).

396. See *supra* note 290 and accompanying text.

397. See GUINNESS WORLD RECORDS 2005 364 (Claire Folkard ed., Bantam Dell 2004) (1960) (“McCartney (UK) currently holds 22 Guinness World Records – more than any other person. He holds 16 records as a member of The Beatles (UK) . . . [and six] world records in his own right . . .”).

398. See *supra* note 252.

399. *But see* Stewart Maclean, *Heather: Macca Beat Me; Ex-Beatle's Fury at Claims*, DAILY RECORD (Scotland), Oct. 18, 2006, at 12 (noting allegations in court documents that McCartney abused his estranged wife, though adamantly denied by McCartney). This is the first real controversy, involving McCartney's personal life, that he has endured since a drug arrest in Japan, in

A telling scene from the 2006 Grammy Awards ceremony paints a portrait that perhaps provides us with some insight. As part of the evening's festivities, McCartney performed on stage a rendition of his classic song "Yesterday," with rapper Jay-Z and Linkin Park's lead singer Chester Bennington.⁴⁰⁰ For McCartney, this was an opportunity to connect with a younger audience, to perhaps indoctrinate some new fans, and to try and stay current as he approached a very significant sixty-fourth birthday.⁴⁰¹ And though he is not "losing [his] hair",⁴⁰² as the song "When I'm Sixty-Four"⁴⁰³ inaccurately predicts, it is still possible that when standing next to these two young musicians, he may feel a little less timeless than he has on other occasions in life. And at that moment of insecurity, all McCartney has to do is look over to Jay-Z, to see a reflection of his youth on the shirt being worn by the rap star. The shirt is decorated with a silk-screen of a famous photograph of John Lennon.⁴⁰⁴ Lennon's arms are folded, he is wearing a sleeveless "New York City" T-shirt and his round sunglasses, his hair wavy, muscles toned, and all in all, looking very young. McCartney has now survived Lennon by twenty-six years⁴⁰⁵, but every day he is forced to ensure his legacy, while Lennon's has already been well preserved.⁴⁰⁶

1980. See *Ex-Japanese Beatle; Paul Departs; Drug Charges Dropped, McCartney Gets His Wings*, WASH. POST, Jan. 26, 1980, at B1.

400. See Robert Lloyd, *Doing What They Do the Best: Music*, L.A. TIMES, Feb. 9, 2006, at H1; see also YouTube, http://youtube.com/watch_fullscreen?video_id=Id6XMTxqHiw&l=236&fs=1&title=2006%20GRAMMYS%20%20JayZ%20Linkin%20Park%20PaulMcCartney (last visited Feb. 14, 2006) (video of performance).

401. Eighty-five percent authorship of the song "When I'm Sixty Four" is unofficially attributed to McCartney. See DOWLDING, *supra* note 1, at 175.

402. Steve's Beatles Page, http://www.stevesbeatles.com/songs/when_im_sixty_four.asp (last visited Feb. 14, 2006).

403. THE BEATLES, *When I'm Sixty-Four*, on SGT. PEPPER'S LONELY HEARTS CLUB BAND (Capitol Records 1987) (1967).

404. The photograph was taken by the photographer Bob Gruen. See Bob Gruen, <http://www.bobgruen.com/files/johnlennon/r002.html> (last visited Feb. 16, 2006).

405. See *supra* note 9 (noting Lennon's death in 1980, at the age of forty).

406. The thought of Lennon as an aging rock star was recently poked fun at by Howard Stern. See *The Howard Stern Show* (SIRIUS Satellite Radio broadcast Oct. 11, 2006). Noting the passing of what would have been Lennon's sixty-sixth birthday, Stern's sidekick Robin Quivers wondered aloud "what a sixty-six year old John Lennon would have been like." Stern replied: "He'd be going out with Scarlett Johansson. . . . He'd be [coaching the contestants] on 'American Idol.' . . . [And] [h]e'd be doing Viagra commercials." *Id.*

On Lennon's death, Pete Hamill wrote the following: "At the morgue, the entrance was sealed shut with a lock and chain. Attendants with green mortuary masks moved around in dumb show, their words inaudible, or typed out forms on grim civil-service typewriters. Behind them, in a refrigerator, lay the sixties."⁴⁰⁷

McCartney would argue, only the latter half.

Ezra D. Landes⁴⁰⁸

407. Pete Hamill, *The Death and Life of John Lennon*, NEW YORK, Dec. 22, 1980, at 38, 41.

408. J.D. Candidate, 2007, Pepperdine University School of Law; B.F.A. in Film and Television Production, 1997, New York University – Tisch School of the Arts. The author wishes to thank Alina Amarkarian, for her guidance throughout the writing of this Comment, and all of the *Pepperdine Law Review* editors and staff members for their tireless work. Additional thanks to Professors Janet Kerr and Robert Popovich for their support and encouragement. Finally, I dedicate this Comment to my second grade teacher, Mrs. Judith Riebman, who taught me how to write, and to the memory of my beloved teacher at N.Y.U., Professor Shaindy Rudoff, who taught me how to be a writer.

