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CASES OF INTEREST

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IP/ENTERTAINMENT LAW WEEKLY CASE UPDATE FOR MOTION PICTURE STUDIOS AND TELEVISION NETWORKS

February 16, 2011

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Experience Hendrix, L.L.C. v. Hendrixlicensing.com, LTD, USDC W.D. Washington, February 8, 2011

 [Click here for a copy of the full decision.](#)

- In a case regarding Jimi Hendrix's right of publicity, the court found that the choice-of-law provisions of the Washington Personality Rights Act directing the application of Washington law regardless of the law of the domicile of the individual at the time of death was arbitrary and unfair, and declared the provisions unconstitutional.

Plaintiff Experience Hendrix, L.L.C. owns several copyrights in songs written by Jimi Hendrix and owns federally registered trademarks incorporating Hendrix's name, image, signature, song titles, and/or lyrics.

Plaintiff sued defendant Hendrixlicensing.com, LTD, a seller of Jimi Hendrix-related merchandise, for violations of the Lanham Act, and sought to enjoin defendant from using various song titles and lyrics and use of his name and likeness. A preliminary injunction was granted.

Though plaintiff did not allege any claims under the Washington Personality Rights Act ("WPRA"), the court examined its applicability because the gravamen of plaintiff's allegations is that Hendrix's right of publicity did not expire upon his death. Under traditional rule, the law of the domiciliary applies, and under New York law, where Hendrix was domiciled at the time of his death, the right of publicity does not survive death.

The WRPA provides that the right of publicity does not expire upon death, regardless of the law of the domicile, residence or citizenship of the individual at the time of death. It also gives effect to right of publicity transfers between non-residents via contract, testamentary device, or intestate succession.

Because the WRPA prescribes the application of Washington law regardless of place of domicile or place of domicile at the time of death, the court investigated whether such legislative directive is subject to constitutional restrictions.



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Defendant argued, and the court agreed, that such choice-of-law directive violates the Full Faith and Credit Clause and Due Process Clause of the United States Constitution.

The court found that WPRA's choice-of-law provision can lead to potential unfair ramifications and inconsistent and unjust results.

The WPRA addresses both survivability and infringement, and because they are distinct issues, they may be subject to different choice-of-law decisions under the principle of depechage, which is recognized in Washington. Moreover, under the WPRA, advertisements alone provide a basis for suit, regardless of whether they are disseminated in the forum, leading to negative consequences like forum shopping.

The court also found the choice-of-law provisions to be arbitrary, pointing out that applying the provision would lead to uncertainty regarding the ownership and existence of a right of publicity because the WPRA only applies in Washington, and that almost all courts that have grappled with the survivability of a right of publicity issue have ruled that the law of the person's domicile governs.

Additionally, the court ruled that because the WPRA seeks to govern a variety of transactions occurring wholly outside Washington's borders, including right of publicity transfers between non-residents, and the creation and dissemination in other forums of advertising incorporating the names or likenesses of non-domiciliaries, the choice-of-law provisions are also unconstitutional under the Dormant Commerce Clause of the United States Constitution.

The court declared the provisions unconstitutional, and granted defendant's summary judgment motion as to the right of publicity claims.

Plaintiff, in its Lanham Act claim, alleged that defendant's use of Hendrix song titles and lyrics were false designations of origin. Though plaintiff did not register any of the song titles or lyrics in question, it could prove ownership of a trademark by showing that the infringed work has acquired secondary meaning such that the public identifies it with plaintiff, and that similar titles spawn public confusion and the misconception that plaintiff originated, sponsored or is associated with defendant's work. Plaintiff failed to provide any evidence that the song titles and lyrics are associated with plaintiff, and thus could not prove secondary meaning, and the court dismissed the false designation of origin claim.

Defendant counter-claimed, alleging among other things, that plaintiff's actions during the course of litigation amounted to defamation and tortious interference. Following the court's issuance of a preliminary injunction in this case, plaintiff sent copies of the complaint, preliminary injunction and subpoenas to a third-party that was doing business with defendant. Plaintiff then also issued a press release accusing defendant of purposefully committing trademark infringements and other illegal acts, and directed the third-party to not conduct business with defendant.



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Plaintiff claimed Noerr-Pennington immunity, arguing that the conduct was petitioning conduct protected under the First Amendment's right to petition. The court held that sending copies of the complaint, preliminary injunction and subpoenas to a third-party was petitioning conduct, but not the press release or the directive to the third-party, and thus granted plaintiff partial summary judgment as to defendant's tort counter-claims.

Zamoyski v. Fifty-Six Hope Road Music Limited, Inc., USDC D. Massachusetts, February 4, 2011

 [Click here for a copy of the full decision.](#)

- Court awards attorney's fees to counter-claim plaintiffs, but reduces their requested amount by 45% because counterclaim defendant's claim was not frivolous, there is no need for deterrence, and to reflect the apportionment of copyright and non-copyright claims.

Plaintiff Jurek Zamoyski sued defendants, heirs of Bob Marley ("Marley Parties"), for copyright infringement. The Marley Parties counter-claimed for a declaration that they owned the copyrights at issue, breach of contract, and state law claims. The court dismissed Zamoyski's copyright infringement claim as untimely, and a jury returned a verdict in favor of the Marley Parties on their declaratory judgment action and breach of contract.

The Marley Parties then moved for attorney's fees and costs in the amount of \$160,228.30. Zamoyski objected, arguing, among other things, that attorney's fees are not available in a declaratory judgment action. The court disagreed, relying on *InvesSys, Inc. v. McGraw-Hill Cos., Ltd.*, 369 F.3d 16 (2004), which addressed attorney's fees in a case with mixed claims. The court held that the Marley Parties' counter-claim for a declaratory judgment regarding ownership of the copyrights, even though not invoking the Copyright Act, is a "like matter" for which Section 505 fees are available.

Turning to the *Fogarty* factors, the court held that Zamoyski's claim for infringement was objectively unreasonable because he waited more than three years after discovering the alleged infringement to file suit, but the court held his claim was not frivolous, as evidenced by the Marley Parties' agreement to drop their counter-claim for frivolousness under state law. The court concluded attorney's fees are appropriate, but reduced the amount requested by 45% -- the court reduced the amount by 10% because Zamoyski's claim was objectively unreasonable but not frivolous; the court reduced the amount by another 10% because there was no need to deter Zamoyski from filing another claim; and the court reduced the amount by another 25% to reflect an apportionment of the time the Marley Parties' attorneys spent on the copyright claims and the non-copyright claims and on successful and unsuccessful claims.

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