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National, Multi-District Preliminary Tour Injunctions: Why the Hesitation?

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[*195] I. INTRODUCTION

The CDs have been pressed; the songs have been released; albums have been sold; and the royalty payments are rolling in. Now it is time for the artist's revenues to reach their summit--the concert tour. n2 T-shirts, sweatshirts, banners, and posters which bear the musical group's trademark, logos, or other identifying marks--better known as artist tour memorabilia n3 --become the merchandising dream for the contemporary musical group.

[*196] A significant amount of artist revenue is gained through the sale of artist tour memorabilia. n4 The musical group or record company most often holds the exclusive right to distribute and sell such memorabilia. n5 Concert tours, which are national in scope, consist of several performing engagements throughout the United States. n6 With each tour stop there is an opportunity for the musical group or record company to merchandise goods which bear the trademark of the musical group. n7 Suckled to every opportunity, merchandise bootleggers follow musical groups like a plague. n8 These persons illegally sell bootleg merchandise bearing the trademark of the musical group. n9 These sales take place outside of the concert venue and without a license from the trademark holder. "When articles bearing trademarks are copied exactly, or substantially so, buyers of those goods are deluded into believing that they have purchased the genuine article." n10 As a remedy for this infringing activity, the Lanham Act provides trademark holders with injunctive relief. n11 In fact, musical groups often attempt to obtain nationwide, multi-district preliminary tour injunctions, pursuant to *15 U.S.C. § 1116*. n12 Unfortunately, the courts

[*197] have been reluctant to issue such an injunction based upon the rationale, *inter alia*, that the "action is not justiciable for purposes of ex parte injunctive relief." n13

On the opposite end of this spectrum, there exists the newly proposed Restatement Third of Unfair Competition ("Unfair Competition Restatement"). n14 In its Comments, the Unfair Competition Restatement proposes an alternate rationale by which federal courts may evaluate a request for a national, multi-district preliminary tour injunction. n15 This article suggests that, in the interest of judicial efficiency and public policy, n16 the federal courts should consider the comments proposed

[*198] in the Unfair Competition Restatement when adjudicating the issue of national, multi-district preliminary tour injunctions. The courts must recognize that merchandise bootlegging needs to be curtailed. It is a growing and lucrative industry that was contemplated and is prohibited by the Lanham Act. n17

This article addresses the rationale introduced by the courts for the denial of national, multi-district preliminary tour injunction and compares this rationale with the Comments set forth in the Unfair Competition Restatement. Part II introduces the Lanham Act and provides a general overview of the scope of federal trademark protection for musical groups. Part III highlights the relevant tests for determining whether a national, multi-district preliminary tour injunction should be granted and chronicles the responses of the courts to requests for a national, multi-district preliminary tour injunction. n18 Part IV presents an alternative to traditional court analysis, asserting that the Comments proposed by the Unfair Competition Restatement should be adopted by the federal courts. Part V concludes that the courts should enhance the current standard used in assessing whether a national, multi-district preliminary tour injunction should be issued, by incorporating the rationale proposed in the Unfair Competition Restatement.

[*199] II. THE LANHAM ACT

Trademarks play an important role in our society, by enabling businesses to identify themselves to their customers and to link that identity to their reputations for quality goods and service. In turn, trademarks permit consumers to readily identify certain products and services and to patronize those business with an expectation of quality. n19

A. Historical Purpose of the Lanham Act

The Lanham Act is a federalization of state law dealing with trademark protection. n20 The purpose of the Lanham Act is to protect both the trademark holder and the consumer. n21 In constructing the legislation, the basic intent of Congress was to provide a means by which consumers could identify and ensure the quality associated with certain

[*200] products. n22 A trademark n23 is a method by which consumers can make this association. n24 Additionally, Congress sought to protect the trademark holder's investment of time, energy, and money in presenting a product to the public, from misappropriation by "pirates and cheats." n25 The Lanham Act is an attempt to eliminate judicial obscurity, simplify registration, and provide prompt and effective relief against infringement. n26

B. Scope of Protection for Registered Trademarks

The Lanham Act provides trademark holders with a monopoly over the use of their trademarks. n27 In order for a trademark to be used by any person other than the trademark holder, that person must obtain permission from the trademark holder; otherwise, such use is deemed to be trademark infringement. n28 Infringing activity is described in the Act as follows:

(1) Any person who shall, without the consent of the registrant

[*201] (a) use in commerce any reproduction, counterfeit, copy or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy or colorably imitate a registered mark and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.

shall be liable in a civil action by the registrant for the remedies hereinafter provided.

n29

Under this section of the Lanham Act, if a trademark holder suspects that a person is engaged in an infringing activity, the trademark holder can seek redress by means of a civil action. n30 As a remedy for trademark infringement, a trademark holder can recover 1) profits gained by the defendant as a result of the defendant's use of the infringing mark; n31 2) any damages and costs sustained by the trademark holder as a result of the infringing mark; n32 3) attorneys fees; n33 4) treble damages; n34 or 5) statutory damages. n35 More importantly, the Lanham Act specifically

[*202] provides the equitable remedy of injunctive relief. n36 Most trademark holders find that injunctive relief is one of the most important remedies provided under the statute. n37 An injunction can be granted in the form of a permanent injunction or preliminary injunction. n38 For the trademark holder, a preliminary injunction is a necessity as it "restrains the defendant from making, selling, advertising, promoting, distributing

[*203] and/or importing the infringing goods or services until the case has been adjudicated." n39

C. Preliminary Injunctive Relief as a Remedy

Obtaining a preliminary injunction in the ordinary trademark scenario does not differ from any other context. n40 A general consistency in trademark litigation is that the plaintiff is usually attempting to enjoin the use of an infringing mark in a particular geographic area. n41 National, multi-district preliminary injunctions are more complex as the plaintiff is requesting the court to enjoin the use of potentially infringing marks on a national scope. n42 With this request, a myriad of collateral issues ensue upon the courts. n43 Initially, it is important to understand the very nature of the preliminary injunction itself.

"Preliminary injunction[s] may be granted only upon a showing of a reasonable probability of eventual success on merits and irreparable injury if equitable relief is denied." n44 Additionally, the court will consider the possibility of harm to the defendant and the public interest. n45 Among

[*204] the different districts, these factors have a multitude of variations; n46 however, the standard showing of reasonable probability of success and irreparable harm remains consistent. For example, before issuing an injunction, the majority of courts require a showing of four factors: 1) likelihood of success on the merits; n47 2) irreparable harm; n48 3) extent of irreparable harm to the defendant; and 4) public interest. n49 A minority of courts have incorporated an additional showing of likelihood of confusion, n50 commonly referred to as the "Polaroid test." n51 It has been noted that confusion is the basic touchstone for injunctive relief. n52

[*205] D. *The Function of Trademarks as Applied to Musical Rock Groups*

Musical rock groups use trademarks as a form of protection for a variety of professional endeavours. The Lanham Act has been used by musical groups to protect the names and likeness of musicians and musical groups. n53 The Act has been used to protect the musical group's name n54 and packaging for the musical group's album. n55 In terms of commercial merchandising, the Lanham Act is the primary means of protecting against counterfeit and bootleg merchandise which bear the musical group's name or likeness. n56

Actions which seek national, multi-district preliminary tour injunctions typically involve the same types of parties. n57 The parties

[*206] involved are usually a musical group or record company--whichever entity is the trademark holder of the group's name--as the plaintiff; and "John Does"--which represent the unknown travelling vendors who sell bootleg tour memorabilia at the various tour locations--as the defendants. n58 On some occasions, the plaintiff is the merchandising arm of the musical group which is often in the form of a corporation. n59 National, multi-district preliminary tour injunctions are often sought by musical groups because they represent an opportunity to enjoin the actions of multiple defendants from various geographic regions in one forum. n60 If a national, multi-district preliminary tour injunction is granted, the musical group can seek its enforcement in every city in which the tour has engagements. n61 Consequently, the task of having to seek an injunction in each individual district in which the tour will stop, is eliminated. The national, multi-district tour injunction, as a type of remedy, is preferred by the trademark holder over the traditional preliminary injunction because it saves both time and money. n62 Courts are reluctant to grant national, multi-district tour injunctions to musical groups, although these

[*207] groups have virtually no other effective legal means of relief. There is a split among the courts as to whether this type of injunction should be issued. The majority of the courts have declined to grant such an injunction, n63 but there are a few courts which have issued national, multi-district preliminary tour injunctions. n64

III. CASE-BY-CASE ANALYSIS OF THE COURT'S POSITION AS TO WHETHER A NATIONAL, MULTI-DISTRICT PRELIMINARY TOUR INJUNCTION SHOULD BE GRANTED

A. Cases in Which the Court Has Granted a National, Multi-District Preliminary Tour Injunction

1. Lilith Fair Productions Ltd. v. Various John Does

In *Lilith Fair Productions v. Various John Does*, n65 the plaintiffs n66 brought an action against John Doe defendants claiming trademark infringement. n67 The plaintiffs alleged that the defendants had engaged in the manufacture, sale, and distribution of clothing, jewelry, photographs, posters, and other merchandise bearing the plaintiff's trademark. n68 As a remedy, the plaintiffs sought national, multi-district injunctive relief as well as a seizure order. n69 The court readily granted this request, ordering: All clothing or other merchandise bearing the name LILITH FAIR and/or SARAH McLACHLAN or their likeness, sold or held for sale inside or in the vicinity of any Lilith Fair and/or Sarah McLachlan concert during their United States Tour or otherwise found (except for

[*208] authorized goods being sold at Lilith Fair and/or Sarah McLachlan concerts by Plaintiff or their authorized agents), shall be considered by those authorized herein to enforce this Order to be infringing articles subject to the provision of this Order. n70 In issuing this order, the court did not offer any rationale as to its conclusions. n71 The decision to issue an order without a published opinion could have been a result of the nomadic defendants' failure to appear in court and the plaintiffs' prompt response to the court's order to show cause.

2. Winterland Concessions Co. v. Simon

In an unpublished order, the court granted a national, multi-district preliminary tour injunction to Winterland Concessions, n72 enjoining the illegitimate sale and distribution of unauthorized tour memorabilia bearing the trademark of the musical group Tom Petty & The Heartbreakers. n73 Unfortunately, as with many ex parte orders, the order is unpublished; therefore, there is not a published rationale which we can look to for insight to the courts reasoning.

B. Cases in Which the Court Has Not Granted a National, Multi-District Preliminary Tour Injunction

1. Brockum Co. v. Various John Does

Brockum Co. v. Various John Does n74 involved the usual suspects n75 found in an action to enjoin the unauthorized selling of tour memorabilia.

[*209] The musical group AC/DC had a national, thirty five-city tour schedule that began in Maine. n76 The band's registered trademarks had been in continuous use for seven years prior to the commencement of the action. n77 Brockum Co. ("Brockum"), which held the official license to market products bearing the AC/DC trademark, initiated an action alleging that various John and Jane Doe defendants were selling unauthorized T-shirts and other merchandise bearing the trademark, that is, name and indicia, of the musical group. n78 The defendants, although unknown at the time of suit, were bootleggers who sold merchandise that was deceptively similar to the AC/DC products marketed by the plaintiff. n79 Though the bootleggers regularly appeared at each concert cite, Brockum was rarely able to actually name the defendant prior to the defendant's actual appearance at the tour stop. n80

Initially, Brockum sought an ex parte temporary restraining order, as well as a seizure order. n81 Although the temporary restraining order and the seizure order were granted, n82 they were expressly limited to the jurisdiction of the court. n83 Later, Brockum applied for a preliminary injunction and produced, as evidence, merchandise seized at two of the concerts that took place earlier in the tour. n84 Brockum's argument rested on the conclusion that "a nationwide injunction [was] imperative." n85

The court held that the group was not entitled to a national, multi-district preliminary tour injunction. n86 The court opined that it was not convinced that an injunction [was] the only realistic way to control bootleg merchandising at the[] concerts. Moreover, the use of plainclothes personnel to serve and enforce court orders of this type

[*210] may be more conducive to violence than to discouraging bootlegging. . . .
Moreover, enforcement problems make such an order potentially unduly complex. n87

It is important to note that the court decided against the grant of the injunction without any consideration as to the merits of the claim. n88 The court justified its lack of consideration of the plaintiff's claim by declaring the issue to be moot, because at the time the case was before the court, the tour was moving out of that particular court's jurisdiction. n89 The court stated that "any continuation of injunctive relief would be academic and purposeless." n90 The court's unwillingness to consider a nation-wide injunction limited the scope of the plaintiff's application for an injunction.

2. Brockum International, Inc. v. Various John Does

Brockum International, Inc. v. Various John Does n91 also involved the usual suspects. n92 The plaintiff, Brockum International, Inc., was granted the exclusive right to manufacture and distribute merchandise bearing the trademark of the musical group The Who. n93 The plaintiff

[*211] sought injunctive relief against bootleggers engaging in the unauthorized sale of tour memorabilia at The Who concerts. n94 The court referred to the Doe defendants as a "loosely defined 'bootlegging operation.'" n95 After a brief discussion on the timeliness of the plaintiff's request, the court granted injunctive relief which was limited to the court's district. n96 The court did not grant the plaintiff's request for national, multi-district preliminary injunctive relief. n97 Judge Evans stated:
I decline the invitation of the plaintiff to issue an order prohibiting the same activity in other cities visited by The Who on its national tour. I believe these issues are best left to the local communities involved, and that an order having nationwide effect in this case would be inappropriate. n98

C. The Overall Posture of the Court When Considering a National, Multi-District Preliminary Tour Injunction

The underlying concern among the federal courts is that issuance of a preliminary injunction, national in scope, oversteps the boundaries of the court. n99 Instead, the court encourages plaintiffs to seek relief in each individual jurisdiction in which the tour may appear. n100 This alternative is problematic and illustrates a tremendous contradiction to traditional trademark jurisprudence. n101 In situations not involving concert tours, courts regularly consider and grant the expansion of a preliminary injunction to national scope when the defendant participates in a national

[*212] marketplace. n102 Perhaps the root of the court's reluctance to grant national preliminary injunctive relief, where it involves tour memorabilia, lies within the court's devaluation of tour memorabilia. As one court stated, "On a hierarchy of priorities I doubt whether [the plaintiff's rights] are earthshaking (we're only talking about selling a lot of mostly junk merchandise at grossly inflated prices)." n103 Another court stated, "The Court recognizes that bootlegging is a social problem; however, federal litigation is not a cure-all, and judicial authority may not be invoked every time a private litigant wishes to obtain a quick fix to what he perceives to be society's ailments." n104

Additionally, the courts are extremely cautious when it comes to granting ex parte preliminary injunctive relief against an unidentified party. n105 This caution stems from a fear that *in personam* jurisdiction is incorrect and that there is a lack of the requisite adversary interest. n106 Although valid, this fear is unjustified in light of Rule 65(b) of the Federal Rules of Civil Procedure. n107 This rule specifically permits the courts to grant ex parte injunctive relief. n108

[*213] The ex parte temporary restraining order is indispensable to the commencement of an action when it is the sole method of preserving a state of affairs in which the court can provide effective final relief. Immediate action is vital when imminent destruction of the disputed property, its removal beyond the confines of the state, or its sale to an innocent third party is threatened. In these situations, giving the defendant notice of the application for an injunction could result in an inability to provide any relief at all. n109 Under the circumstances, ex parte relief is the only practical relief available to plaintiffs due to the nomadic character of the defendants. n110

[*214] IV. THE RESTATEMENT (THIRD) OF UNFAIR COMPETITION: AN ALTERNATE RATIONALE FOR THE COURTS TO CONSIDER

A. Historical Perspective

The Unfair Competition Restatement results from the evolution of the common law action of unfair competition. n111 Initially, unfair competition was treated as a sub-category of the original Restatement of Torts. n112 As the law began to expand and further develop in its complexity and scope, the American Law Institute made a decision to compile its "first independent work on the subject." n113 The Institute stated: There has been a parallel increase in the commercial and financial significance of intellectual property generally, including that defined through the law of unfair competition. Over approximately the same period theoretical explorations, often under the rubric of law and economics, have yielded a much more sophisticated understanding of the law and of the relationship between the values inherent in business competition and other social and political values It is thus timely that this work now be presented. n114

In terms of the Unfair Competition Restatement's approach toward remedies for trademark infringement, the responsive section is an attempt to solidify the application of the traditional rule for the use of injunctive relief, as it applies to tort actions, as a customary remedy in unfair competition. n115 More importantly, because of the relative newness of the Unfair Competition Restatement, many courts have not responded to its applicability nor embraced its language and rationale. n116 The Unfair Competition Restatement has been described as "an overwhelming success, a careful and honest exposition of the black letter law annotated

[*215] with clear explanations of the policies that drive judicial decisions governing trademarks." n117

B. Injunctive Relief for Trademark Holders, as Proposed by the Unfair Competition Restatement

The relevant language of the Unfair Competition Restatement, which pertains to the grant of an injunction to trademark holders against trademark infringers, is as follows:

(1) Unless inappropriate under the rule stated in Subsection (2), injunctive relief will ordinarily be awarded against one who is liable to another for:

- (a) deceptive marketing under the rules stated in §§ 2 - 8; or
- (b) infringement of the other's trademark, trade name, collective mark, or certification mark under the rule stated in § 20; or
- (c) dilution of the other's trademark, trade name, collective mark, or certification mark under the rule stated in § 25.

(2) The appropriateness and scope of injunctive relief depend upon a comparative appraisal of all the factors of the case, including the following primary factors:

- (a) the nature of the interest to be protected;
- (b) the nature and extent of the wrongful conduct;
- (c) the relative adequacy to the plaintiff of an injunction and of other remedies;
- (d) the relative harm likely to result to the legitimate interests of the defendant if an injunction is granted and to the legitimate interests of the plaintiff if an injunction is denied;
- (e) the interests of third persons and of the public;
- (f) any unreasonable delay by the plaintiff in bringing suit or otherwise asserting its rights;
- (g) any related misconduct on the part of the plaintiff; and
- (h) the practicality of framing and enforcing the injunction. n118

It is clear that this language somewhat mirrors the federal codification of injunctive relief and is similar in scope. n119 What is

[*216] significant about the Unfair Competition Restatement is its Comments. The Comments offer extremely helpful commentary and suggestions for circumstances in which there should be an award of injunctive relief. n120 Primarily, the Comments provide that injunctive relief is the most appropriate remedy in trademark infringement cases. n121 Since its appropriateness is manifested in preserving the goodwill symbolized by the trademark, such efforts can most effectively be achieved by means of injunction, rather than by monetary relief. n122 Circumstances most often warrant an injunction, unless the "plaintiff's interest is not substantial in comparison with the legitimate interests of the defendant and the defendant's conduct was undertaken in good faith." n123 This scenario is not the situation with bootleggers and their counterfeit merchandise. The knowing reproduction of merchandise bearing counterfeit trademarks is the very essence of bootlegging. n124 There is no good faith, no legitimate interests, and plenty of misconduct. n125

More significantly, the Comments of the Unfair Competition Restatement expressly acknowledge the difficulty that many courts face in fashioning an injunction that precisely corresponds with the infringing conduct. n126 While stressing the court's discretion in narrowing or broadening the scope of an injunction, the Comments propose several factors which the court should consider in its review of the circumstances. n127 The court should consider the following: 1) the manner in which the plaintiff was harmed; 2) the possible means by which the harm could be avoided; 3) the justification advanced for the defendant's conduct; 4) the potential burden that would be imposed on the legitimate interests of the defendant; 5) the potential effect upon lawful competition between the parties; and 6) the extent to which the plaintiff has invested in planned expansion under the mark into other products or other geographic markets. n128 Further, the Comments emphasize that when the activities of the parties are national in scope, the courts have

[*217] an uncontested power to issue national injunctions. n129 It is important to note that the Unfair Competition Restatement most certainly does not attempt to replace the test used by the courts in determining whether to grant injunctive relief. n130 Rather, it attempts to expand this test to include a more comprehensive consideration of the totality of the circumstances surrounding the alleged infringement. n131 If the proposed factors were to be considered by the courts when deciding whether to order a national, multi-district preliminary tour injunction, it is unlikely that there would be any hesitation. Consider the relevant factors.

1. The manner in which the plaintiff was harmed

Musical groups derive a substantial portion of their income from the sale of merchandise bearing the group's trademark. n132 When touring, lucrative profits can be reaped from merchandising tour memorabilia. n133 Illicit sales by bootleggers cut into these profits and decrease the amount of revenue gained by the musical group. n134 The musical group's ability to sell tour memorabilia is a direct result of the goodwill or service associated

[*218] with the group. n135 A group's popularity and support from fans, reflects in increased sales of merchandise. n136 In return, the musical group offers quality merchandise for the fans to purchase. Bootleggers literally loiter outside of the concert venue in an attempt to "sell [tour memorabilia] 'any way [they] can.'" n137 As a result, this method directly usurps the goodwill of the trademark holder and deceptively presents inferior goods to the consumer.

2. The possible means by which the harm may be avoided

The harm to the plaintiff may easily be avoided if the bootleggers obtained a license from the trademark holder for the use of the trademark. n138 With a license, the licensee has the liberty to use the trademark in commerce under the terms of the license. n139 Merchandising agreements between the trademark holder and the licensee can yield a royalty rate as high as seventy percent for the licensee. n140

[*219] 3. The justification advanced for the defendant's conduct

Bootleggers have been described as infringers who are driven by greed. n141 Plainly stated, there is no legitimate or legal justification for their infringing conduct. Their conduct is blatant, outrageous, and is the very conduct that Congress sought to curtail in its creation of the Lanham Act. n142

4. The potential burden that would be imposed on the legitimate interests of the defendant

The problem that has arisen with ex parte injunctive relief is the lack of notice for Doe defendants. n143 Ex parte actions allow for the court to hear claims for preliminary injunctive relief without the presence of the defendants. n144 This lack of notice is justified by the plaintiff's showing of the need for immediate injunctive relief pending trial. n145 In

[*220] actions where the defendants are known, the defendants' interest is protected through adequate notice in accordance with the Federal Rules of Civil Procedure. n146 With Doe defendants, notice can not be given because these defendants are unnamed and unknown. n147 The defendants have a legitimate interest in receiving adequate notice of any proceeding advanced against them. n148 The legitimate interest stems from the underlying premise of our judicial system which is founded upon the concept of adversarial interest. n149 The defendants' adversarial interest is superseded if the defendants do not have notice of an action and, therefore, do not have the opportunity to defend their interest.

In conjunction with the above-stated premise, the court must also consider the plaintiff's counter-argument. In the case of unknown, nomadic bootleggers there is no possible means of ascertaining the names

[*221] of the alleged infringers. n150 A bootlegger's conduct is propelled by anonymity, n151 that is, they move from concert venue to concert venue, like shadows, and sell their goods to any unknowing concert-goer who seeks tour memorabilia. n152 Bootleggers actively seek to conceal their identity in order to avoid being penalized for their illegal conduct. n153

5. The potential effect upon lawful competition between the parties

Advancing national, multi-district preliminary tour injunctions will encourage lawful competition between the parties. As long as bootleggers are cognizant of the limited enforcement against their infringing activity, these bootleggers will be motivated to continue engaging in such activity. n154 In many instances, musical groups have to forego seeking enforcement of their trademarks by the federal courts because of the tremendous amount of costs associated with separate litigation at each tour location. n155 As a result, many bootleggers escape recourse for their actions. National, multi-district preliminary tour injunctions enable the plaintiff to seek nationwide injunctive relief at minimum costs to both the plaintiff and the court. n156 These injunctions will encourage bootleggers to discontinue their infringing conduct and force them to license the use of the trademark from the trademark holder.

[*222] 6. The extent to which the plaintiff has invested in planned expansion under the mark into other products or other geographic markets

The scope of tour engagements for a musical group is almost always national. n157 Generally, tour memorabilia consists of T-shirts, posters, sweatshirts, and banners, but tour memorabilia is not limited to these products. n158 The trademarks will be used across a national geographic market by virtue of the scope of the tour. n159 Hence, a *national, multi-district* preliminary tour injunction is necessary. Additionally, the feasibility of the musical group expanding its trademark to other products is limitless. For example, musical groups such as New Kids on the Block, had products such as stickers, T-shirts, hats, sleeping bags, action figures, bed linen, commemorative coins, telephones, buttons, and books. n160 Consequently, when courts consider the factors proposed in the Comments of the Unfair Competition Restatement, this factor weighs largely in the plaintiff's favor.

V. CONCLUSION

National, multi-district preliminary tour injunctions are essential to the protection of a musical group's trademarks. n161 If the federal court were to expand its rationale to incorporate the considerations articulated

[*223] in the Comments of the Unfair Competition Restatement, there could be a more comprehensive review and understanding of the relevant circumstances of the musical group. Currently, the courts hesitate at issuing a national, multi-district preliminary tour injunction due to questions of justiciability and scope. The courts should acknowledge the importance of trademark protection for musical groups, and recognize that without national, multi-district preliminary tour injunctions, bootleggers will remain a dominant force. Although the state forum exists for judicial review, the costs and time associated with seeking protection in each individual state in which the tour appears is astronomical and virtually an impractical mechanism for protection. Courts would be more at ease with this form of injunction if they considered the additional six factors articulated in the Unfair Competition Restatement. n162 These factors facilitate both a community and national perspective in the weighing of the interests between the plaintiff and the defendant. As such, the courts should adopt these relevant considerations. As noted by one federal court, "[injunctive] relief granted [against unfair competition and trademark infringement] should be broad enough to protect [the] plaintiff in its use of its registered mark and in its legitimate business and good will, but should not be oppressive or unduly burdensome to defendant." n163 The considerations articulated by the Unfair Competition Restatement, in addition to the present test utilized by the courts, effectively achieve this goal.

n1 Cheryl Johnson, *Rock Performers and the "John Doe" Temporary Restraining Order: Dressing Down the T-shirt Pirates*, 16 J. MARSHALL L. REV. 101, 124 (1982) (emphasis added).

n2 See June Kronholz, *Peddling Music: Pop and Rock Tours Like Michael Jackson's Grow More Complex as Both Business Transactions and On-Stage Gimmicks Outstrip the Old Beatles*, ENT. L. REP., July 1984, at 3. Concert tours are lucrative not only because of the amount of money they generate in ticket and merchandise sales, but also because concerts promote record sales. *Id.*

n3 See Andrew Darrow, *Artist/Venue Merchandising Agreements*, ENT. L. & FIN., Nov. 1995, at 1.

n4 See Kronholz, *supra* note 2, at 4; see also *Winterland Concessions Co., v. Mackintosh*, No. 89-8342, 1992 WL 170897, at * 1 (E.D. Pa. July 14, 1992) ("The rock and roll merchandising business is a \$ 500,000,000 annual industry.").

n5 See *Winterland Concessions Co. v. Sileo*, 528 F. Supp. 1201, 213 U.S.P.Q. (BNA) 813 (N.D. Ill. 1981) (holding that the defendants' unauthorized printing of T-shirts violated the rights of the plaintiffs as exclusive licensees of the performers and musical groups, and the plaintiffs were entitled to a preliminary injunction against the defendants).

n6 See Michael J. Pollack, *Concert Tour Financing Through Record Company Support and Corporate Sponsorship*, ENT. L. REP., July 1984, at 6, 7.

n7 See Kronholz, *supra* note 2, at 3.

n8 See Johnson, *supra* note 1, at 101.

n9 See Anthony Todd Carlisle, *Getting the Boot*, PITTSBURGH BUS. TIMES & J., Oct. 28, 1996, at 1. Bootleg merchandise are "products pirated by manufacturers who haven't paid for the license to the logos or trademarks on their wares." *Id.*

n10 H.R. Rep. No. 98-997, at 5 (1984), *reprinted in* Griffith B. Price, *Counterfeiting of Computer Goods and Trademarks: Strategy and Tactics with Customs on Infringements*, in *Computer Software and Chips 1986: Protection and Marketing* 285, 401 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series No. 226, 1986).

n11 15 U.S.C. § § 1501 - 1127 (1994 & Supp. IV 1998).

n12 15 U.S.C. § 1116 (1994 & Supp. IV 1998). This section provides, in part:

(a) Jurisdiction; service

The several courts vested with jurisdiction of civil actions arising under this chapter shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under § 1125(a) of this title. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction. Any such injunction granted upon hearing, after notice to the defendant, by any district court of the United States, may be served on the parties against whom such injunction is granted anywhere in the United States where they may be found, and shall be operative and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other United States District court in whose jurisdiction the defendant may be found.

(b) Transfer of certified copies of court papers

The said courts shall have jurisdiction to enforce said injunction, as provided in this chapter, as fully as if the injunction had been granted by the district court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all papers on file in his office upon which said injunction is granted.

Id.

n13 *Brockum Co. v. Various John Does*, 685 F. Supp. 476, 477, 8 U.S.P.Q.2d (BNA) 1786, 1787 (E.D. Pa. 1988) (citing *Rock Tours v. Various John Does*, 507 F. Supp. 63, 66, 212 U.S.P.Q. (BNA) 571, 573 (N.D. Ala. 1981)). The *Brockmun* court has also stated that "these issues are best left to the local communities involved and . . . an order having nationwide effect would be inappropriate." *Id.*

n14 RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 35 (1995) [hereinafter UNFAIR COMPETITION RESTATEMENT].

n15 *Id.* cmt. c, at 363. See also *infra* Part IV.B. for a discussion on the Unfair Competition Restatement and its Comments.

n16 The concept of judicial efficiency incorporates "concerns regarding judicial time spent hearing pretrial motions." G. Richard Shell, *Contracts in the Modern Supreme Court*, 81 *CAL. L. REV.* 433, 505 (1993). An argument can be made that four important public policy objectives prevail. These objectives are "(1) preventing inconsistent judicial results that would weaken public confidence in the judiciary; (2) preventing intentional inconsistency by parties seeking to manipulate the judicial process; (3) preventing powerful and frequent users of the courts from giving the appearance of controlling the judiciary; and (4) preventing unnecessary litigation which diminishes the efficiency of the judicial system." CHARLES A. WRIGHT ET AL., 18 *FEDERAL PRACTICE AND PROCEDURE: JURISDICTION* § 4477 (1981).

n17 Although the Lanham Act does not directly address merchandise bootlegging, the Act expressly prohibits trademark infringement in all forms. *See 15 U.S.C. § 1114* (1994 & Supp. IV 1998). Additionally, the legislative history notes that trademark legislation was instituted with "the view of protecting trade-marks and making infringement and piracy unprofitable." S. REP. NO. 1333, at 1275 (1946).

n18 The focus here will be on the responses of the United States District Courts as opposed to any Federal Circuit or Supreme Court rationale on this particular issue. As a result of the nature of the action in itself, the issue of national, multi-district preliminary tour injunctions has not been discussed at the Appellate or Supreme Court level. This type of tour injunction has the effect of a preliminary injunction except that the injunction is not limited to the geographic district in which the court sits. Rather, the injunction extends across multiple jurisdictions and is enforced in each jurisdiction pursuant to the Federal Constitution's Full Faith and Credit Clause.

n19 H.R. REP. NO. 98-997, at 5 (1984) (emphasis added).

n20 Most states have codified some form of trademark protection. Within these statutes, there are also provisions which provide preliminary injunctive relief as a remedy. *See, e.g.*, ALA. CODE § 8-12-18 (1993); ALASKA STAT. § 45.50.180 (Michie 1998); ARIZ. REV. STAT. § 14-1451 (1994); ARK. CODE ANN. § § 4-71-113, 4-71-214 (Michie 1997); CAL. BUS & PROF. CODE § 14340 (West 1987); COLO. REV. STAT. ANN. § 7-70-112 (1997); CONN. GEN. STAT. ANN. § § 35-11i, 35-18h (West 1997); DEL. CODE ANN. tit. 6, § 3314 (1993); FLA. STAT. ANN. § 495.141 (West 1997); GA. CODE ANN. § 10-1-451 (Michie 1994); HAW. REV. STAT. ANN. § 482/1-12 (Michie 1998); IDAHO CODE § § 48-513 & 514 (1997); 765 ILL. COMP. STAT. ANN. § 1035/13-15 (West 1993); IND. CODE ANN. § 24-2-1-14 (Michie 1996); IOWA CODE ANN. § 548.1114 (West 1997); KAN. STAT. ANN. § 81-122 (1998); KY. REV. STAT. ANN. § 365.603 (Michie 1996); LA. REV. STAT. ANN. § 51:223 (West 1987); ME. REV. STAT. ANN. tit. 10, § 1531 (West 1991); MASS GEN. LAWS ANN. ch. 110B, § 1-29 (West 1990); MICH. COMP. LAWS. ANN. § 429.43 (West 1995); MINN. STAT. ANN. § 333.29 (West 1995); MISS. CODE ANN. § 75-25-25 (1998); MO. ANN. STAT. § 417.061 (West 1990); MON. CODE. ANN. § 30-13-335 (1997); NEB. REV. STAT. ANN. § 87-123 (Michie 1995); NEV. REV. STAT. ANN. § 600.430 (Michie 1994); N.H. REV. STAT. ANN. § 350-A:13 (1995); N.M. STAT. ANN. § 57-3-11 (Michie 1995); N.Y. GEN. BUS. LAW § 368 (McKinney 1996); N.C. GEN. STAT. § 80/1 - 46 (1997); N.D. CENT. CODE § 47-22-12 (1960); OHIO REV. CODE ANN. § 1329.66 (Anderson 1993); OKLA. STAT.

ANN. tit. 78, § 32 (West 1995); OR. REV. STAT. § 647.105, 107 (1995); PA. STAT. ANN. tit. 54, § 1125 (West 1996); P.R. LAWS ANN. tit. 10, § 171w (1997); R.I. GEN. LAWS § 6-2-13 (1992); S.C. CODE ANN. § 39-15-230 (Law Co-op. 1985); S.D. CODIFIED LAWS § 37-6-24 (Michie 1994); TENN. CODE ANN. § 47-25-513 (1996); UTAH CODE ANN. § 70-3-14 (1997); VT. STAT. ANN. tit. 9, § 2529 (1993); VA. CODE ANN. § 59.1-92.13 (Michie 1998); WASH. REV. CODE ANN. § 19.77.160 (West 1998); W. VA. CODE § 47-2-14 (1998); WIS. STAT. ANN. § 132.033 (1989); WYO. STAT. ANN. § 40-1-112 (Michie 1997).

n21 *See* S. REP. NO. 1333, at 1274 (1946).

n22 *See id.*

n23 15 U.S.C. § 1116 defines a trademark as:

any word, name, symbol, or device, or any combination thereof

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, 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.

15 U.S.C. § 1127 (1994 & Supp. IV 1998).

n24 *See* S. REP. NO. 1333, reprinted in 1946 U.S.C.C.A.N. 1274, 1275. ("The protection of trade-marks is the law's recognition of the psychological function of symbols.").

n25 *Id.*

n26 *Id.*

n27 *See* John F. Coverdale, Comment, *Trademarks and Generic Words: An Effect-on-Competition Test*, 51 U. CHI. L. REV. 868, 869 (1984).

n28 There are certain instances in which a trademark can be used, absent the trademark holder's permission, without being an infringing activity. These instances, as articulated by 15 U.S.C. § 1115 (1994 & Supp. IV 1998), are highlighted as defenses to a claim of trademark infringement. Examples of defenses include: laches, abandonment, acquiescence, and prior use. *See id.* An alleged infringer can also claim a right to use a trademark without the holder's permission under the doctrine of Fair Use. *See* J. THOMAS McCARTHY, *McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 23:11 (rel. no. 6, June 1998).

n29 15 U.S.C. § 1114(1) (1994 & Supp. IV 1998).

n30 *Id.*

n31 *See* 15 U.S.C. § 1117(a) (1994 & Supp. IV 1998). "The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost or deduction claimed." *Id.*

n32 *See id.* "In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount." *Id.*

n33 *See id.* "The court in exceptional cases may award reasonable attorney fees to the prevailing party." *Id.*

n34 *See id.* "If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case." *Id.*

n35 *See id.* § 1117(c) (1994 & Supp. IV 1998).

"In a case involving the use of a counterfeit mark . . . the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits under subsection (a), an award of statutory damages for any such use in connection with the sale, offering for sale, or distribution of goods or services" *Id.*

n36 15 U.S.C. § 1116 (1994 & Supp. IV 1998). This section provides, in part:
(a) Jurisdiction; service

The several courts vested with jurisdiction of civil actions arising under this chapter shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under § 1125(a) of this title. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction. Any such injunction granted upon hearing, after notice to the defendant, by any district court of the United States, may be served on the parties against whom such injunction is granted anywhere in the United States where they may be found, and shall be operative and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other United States District court in whose jurisdiction the defendant may be found.

(b) Transfer of certified copies of court papers

The said courts shall have jurisdiction to enforce said injunction, as provided in this chapter, as fully as if the injunction had been granted by the district court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all papers on file in his office upon which said injunction is granted.

Id.

n37 *See* David Rees Davies, *Litigating Trademark Cases*, in LITIGATING COPYRIGHT, TRADEMARK, AND UNFAIR COMPETITION CASES 1984, at 61, 98 (PLI Litig. Of Admin. Practice Course Handbook Series No. 264, 1984); Marcia B. Paul & Anthony F. Lo Cicero, *Litigating Trademark and Unfair Competition Cases*, in

LITIGATION COPYRIGHT, TRADEMARK AND UNFAIR COMPETITION CASES FOR THE EXPERIENCED PRACTITIONER 1996, at 83, 381 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series No. 463, 1996); Keith M. Stolte, *Remedying Judicial Limitations on Trademark Remedies: Monetary Relief Should Not Require Proof of Actual Confusion*, 75 *DENV. U. L. REV.* 229, 230-31 (1997).

n38 See generally 15 U.S.C. § 1116 (1994 & Supp. IV 1998). See, e.g., *Simmons Co. v. Baker*, 200 F. Supp. 149, 131 U.S.P.Q. (BNA) 312 (D.C. Mass. 1961); Davies, *supra* note 37, at 99.

n39 Charles S. Crompton, *Trademark Infringement Primer*, in UNDERSTANDING BASIC TRADEMARK LAW 1997, at 601, 610 (PLI Patents, Copyrights, Trademarks, and Literary Property Course Handbook Series No. 486, 1997).

n40 See, e.g., *Radical Prod., Inc. v. Sundays Distrib.*, 821 F. Supp. 648, 25 U.S.P.Q.2d (BNA) 1397 (W.D. Wash. 1992).

n41 See Gary D. Spivey, Annotation, *Unfair Competition: Geographical Extent of Protection of Word or Symbol Under Doctrine of Secondary Meaning*, 41 A.L.R.3d 434 (1972).

n42 See 47 AM. JUR. 2D, Proof of Facts § 643 (1987).

"Under the current federal trademark law, the geographical scope of a trademark owner's right to the exclusive use of that mark is somewhat broader than that available under the common-law rule. Federal registration not only gives the trademark owner the exclusive right to use the mark nationally; it also permits the owner to prevent conflicting use by another even if the conflicting use is in good faith and in a remote area, provided that the trademark owner shows that there is a likelihood that he will use his mark in that area." *Id.*

n43 These issues include questions of jurisdiction and adversarial interests. For further discussion of these issues see *infra* notes 106-118 and accompanying text.

n44 *Victoria Station, Inc. v. Clarefield, Inc.*, 458 F. Supp. 199, 201, 203 U.S.P.Q. (BNA) 956, 958 (W.D. Pa. 1978).

n45 See *Corning Glass Works v. Jeanette Glass Co.*, 308 F. Supp. 1321, 1322, 164 U.S.P.Q. (BNA) 435, 436 (S.D.N.Y. 1970).

n46 See, e.g., *Radical Prod., Inc. v. Sundays Distrib.*, 821 F. Supp. 648, 650, 25 U.S.P.Q.2d (BNA) 1397, 1400 (W.D. Wash. 1992) (including that the plaintiff must demonstrate a likelihood of success on the merits and irreparable harm, or existence of serious questions of law and balance of hardships in its favor); *Carling Brewing Co. v. Philip Morris, Inc.*, 277 F. Supp. 326, 334, 15 U.S.P.Q. (BNA) 70, 77 (N.D. Ga. 1967) (stating that the various conveniences and injuries to parties must be balanced, as they would be affected by the granting or withholding of an injunction); *Hershey Creamery Co. v. Hershey Chocolate Corp.*, 269 F. Supp. 45, 56, 153 U.S.P.Q. (BNA) 794, 802 (S.D.N.Y. 1967) (providing that the plaintiff must also show a likelihood that plaintiff's mark is valid, that the plaintiff's mark is worthy of protection, and that the plaintiff's mark is being infringed by the defendant).

n47 "Proof of likelihood of success depends upon the legal claims and unique facts from which such claims arise. In most trademark counterfeiting cases, the violation of the Lanham Act is open and shut." J. Joseph Bainton, *Seizure Orders: An Innovative Judicial Response to the Realities of Trademark Counterfeiting*, 73 TRADEMARK REP. 459, 472 (1983).

n48 "It is widely recognized that trademark infringement inflicts irreparable injury upon the trademark owner, because it adversely affects the reputation, and thus the good will, of the trademark owner." *Id.* at 473.

n49 *See id.*

n50 *See Hershey*, 269 F. Supp. at 57, 153 U.S.P.Q. at 802. The likelihood of confusion test is a fundamental standard in determining the merits of whether there has been trademark infringement. *See* McCARTHY, *supra* note 28, § 23:11.

n51 The *Polaroid* test consists of eight factors:

- (1) strength of the plaintiff's mark;
- (2) similarity of plaintiff's and defendant's marks;
- (3) competitive proximity of the products;
- (4) likelihood that prior owner of trademark will bridge the gap;
- (5) actual confusion;
- (6) intent of defendant in adopting mark, that is, whether defendant acted in bad faith;
- (7) quality of defendant's product; and
- (8) sophistication of the consumers.

See Polaroid v. Polaroid Elec. Corp., 287 F.2d 492, 128 U.S.P.Q. (BNA) 411 (2d Cir. 1964). For a more comprehensive discussion of establishing the likelihood of confusion test see McCARTHY, *supra* note 28, § 23.

n52 *See Dymo Indus., Inc. v. Tapeprinter, Inc.*, 326 F.2d 141, 143 140 U.S.P.Q. (BNA) 154, 155 (9th Cir. 1964).

n53 *See* Elizabeth Williams, Annotation, *Trademark Protection Under Lanham Act (15 U.S.C.A. § § 1501 et seq.) of Name of Musical Group*, 115 A.L.R. FED. 171 (1993). Many musical groups register their names as trademarks. *See, e.g., Apple Corps. v. A.D.P.R., Inc.*, 843 F. Supp. 342, 30 U.S.P.Q. (BNA) 1372 (M.D. Tenn. 1993) (concerning an infringement action brought by the holder of "The Beatles" trademark); *In re Polar Music Int'l. AB*, 714 F.2d 1567, 221 U.S.P.Q. (BNA) 315 (1st Cir. 1983) (appeal brought by the holder of the "ABBA" trademark).

n54 Williams, *supra* note 53, at 181. This type of action typically arises when a group of musicians who have performed together under a single name later disbands and there is a dispute as to who has the right to continue to use the group's name. For instance, former members of a musical group wish to continue to perform under the group's name. *See Noone v. Banner Talent Assoc., Inc.*, 398 F. Supp. 260 (S.D.N.Y. 1975). Another example arises when a musician or musical group attempts to adopt a trademark that closely resembles a name already used by another musical group. *See Bagdasarian Prod. v. Audiofidelity Enter., Inc.*, 772 F.2d 893, 227 U.S.P.Q. (BNA) 735 (D.N.J. 1984).

n55 Williams, *supra* note 53, at 182. These type of actions arise "when a recording is packaged in such a way that potential purchasers are likely to be deceived as to the

identities of the performers or the time at which the recording was made." *Id. See, e.g., PPX Enter., Inc. v. Audiofidelity Enter., Inc.*, 818 F.2d 226, 2 U.S.P.Q.2d (BNA) 1672 (1987) (involving the defendant's marketing of an album bearing the name "Jimi Hendrix" on the album cover as a featured artist when the album did not contain Hendrix recordings).

n56 *See generally* Williams, *supra* note 53.

n57 For purposes of this article, these parties will be referred to as the "usual suspects."

n58 *See, e.g.,* Lilith Fair Prod. Ltd. v. Various John Does, Case No. CV98-749 (D. Or. June 16, 1998); Winterland Concessions Co. v. Simon, No. CV95-1444 (N.D. Ill. Mar. 9, 1995); *Brockum Co. v. Various John Does*, 685 F. Supp. 476 (E.D. Pa. 1988); *Brockum Int'l., Inc. v. Various John Does*, 551 F. Supp. 1054, 217 U.S.P.Q. (BNA) 862 (E.D. Wis. 1982).

n59 *See* Andrew Darrow, *Artist/Venue Merchandising Agreements*, ENT. L. & FIN., Nov. 1995, at 1. Many artist recording contracts call for a grant of merchandising rights to the record company or its ancillary merchandising division on at least a 'matching rights' basis. *See id.* This grants the record company the right to merchandise the artist's product unless the company is unwilling to match the offer of a competing third party. *See id.*

n60 *See, e.g.,* cases cited *supra* note 58.

n61 Most often complaints which request a national, multi-district preliminary tour injunction are accompanied by a request for an ex parte seizure order, pursuant to section 1118 of the Lanham Act. *See 15 U.S.C. § 1118* (1994 & Supp. IV 1998). Enforcement of a national, multi-district preliminary tour injunction and an ex parte seizure order are typically carried out under the supervision of counsel, or by the Tour Director, and either the U.S. Marshal or the local police and/or experienced security personnel specially retained to enforce such an order. *See Beastie Boys v. Does*, No. C98-1058 (W.D. Wash. filed July 29, 1998).

n62 A complaint filed in the United States District Court of the Western District of Washington, on behalf of the Beastie Boys, states:
Plaintiffs will be forced to file over twenty separate civil actions . . . with an expense of well over \$ 200,000 in legal fees and costs. . . . Thus, it would seem terribly unfair to place such an enormous and unnecessary burden on Plaintiffs whose rights are clear and who evidence a remedy that works and works well.
Beastie Boys v. Does, Civ. No. C98-1058 (W.D. Wash. filed July 29, 1998).

n63 *See* examples *infra* Part III.B.

n64 *See* examples *infra* Part III.A.

n65 *Lilith Fair Prod. Ltd. v. Various John Does*, No. CV98-749 (D. Or. June 16, 1998). There are a few unpublished orders which have granted national, multi-district preliminary tour injunctions. These unpublished orders include: *Winterland Concessions Co. v. Miller*, No. 92-0456 (S.D. Fla. Mar. 2, 1992) and *Winterland Concessions Co. v. Simms*, No. C.C. JRM 95-68 (D. Md. Jan. 17, 1995).

n66 The plaintiffs were Lilith Fair Productions and Sarah McLachlan. *See* Lileth Fair, No. CV98-749. "The Lilith Fair, which was launched by McLachlan in 1996," is a music fair which celebrates the music of women. *See* Gina Binole, *Lilith Suit Filed . . . Just in Case*, THE BUS. J. (Portland, Or.), June 19, 1998, at 17; *see also* *Lilith Fair and TheDJ.com Team Up to Offer Music from the Year's Hottest Tour to Internet Consumers*, BUS. WIRE, June 16, 1998.

n67 *See* BUS. WIRE, at 1.

n68 *See id.* at 2.

n69 *See id.*

n70 *See id.* at 4.

n71 *See generally id.*

n72 *See* *Winterland Concessions Co. v. Simon*, No. CV95-1444 (N.D. Ill. Mar. 9, 1995). Winterland Production was the exclusive licensee for the trademark of the musical group. In general, Winterland Productions engages in "the business of manufacturing, distributing, selling, and otherwise commercially exploiting T-shirts and merchandise bearing the names, likenesses, logos, trade names, trademarks, service marks, copyrighted photos, art work and symbolic designs of numerous individual performers in the entertainment industry and/or musical groups of which said individual performers are members." *Winterland Concessions Co. v. Macintosh*, No. 89-8342, 1992 WL 170897, at * 1 (E.D. Pa. 1992).

n73 *See* Darrow, *Artist/Venue Merchandising Agreements*, 23 ENT. L. REP., Nov. 1995, at 16.

n74 685 F. Supp. 476, 8 U.S.P.Q.2d (BNA) 1786 (E.D. Pa. 1988).

n75 *See supra* text accompanying notes 57-58.

n76 *See Brockum*, 685 F. Supp. at 476, 8 U.S.P.Q.2d at 1786.

n77 *See id.*

n78 *See id.*

n79 *See id.*

n80 *See id.* at 476-77, 8 U.S.P.Q.2d at 1786-87.

n81 *See id.* at 476, 8 U.S.P.Q.2d at 1786.

n82 Upon entry of this order, the plaintiff further asked for a reconsideration of the interlineated limitation. *See Brockum Co. v. Various John Does*, 685 F. Supp. 476, 477, 8 U.S.P.Q.2d (BNA) 1786, 1788 (E.D. Pa. 1988). Judge Ludwig stated, "I deferred [from reconsidering my order, because] . . . it appeared that the only concert at which the temporary restraining order would be available before the hearing . . . was the one in Philadelphia." *Id.* at 477 n.1, 8 U.S.P.Q.2d at 1788 n.1.

n83 *See id.* at 476-77, 8 U.S.P.Q.2d at 1786.

n84 *See id.* at 477, 8 U.S.P.Q.2d at 1786.

n85 *Id. at 477, 8 U.S.P.Q.2d at 1787.*

n86 *See id. at 478, 8 U.S.P.Q.2d at 1787.*

n87 *See Brockum Co. v. Various John Does, 685 F. Supp. 476, 478, 8 U.S.P.Q.2d (BNA) 1786, 1787-88 (E.D. Pa. 1988).*

n88 *See generally id.*

n89 *See id. at 478, 8 U.S.P.Q.2d at 1788.*

n90 *Id.* The court further stated:

The enforcement proposal suggested by plaintiffs, that the order be entered here but enforced in the federal courts where the violations occur, is unsatisfactory. The same legalistic problems remain and may be compounded by local laws and different fact settings as well as the views of other judges. The practical problems, while seemingly reduced from my standpoint, would involve instituting a new action in each district in which a seizure was made. Another possibility would be that counsel would simply utilize the order to effectuate the seizures through private guards and security personnel wherever the concert tour happened to be. To enter an order accommodating that purpose would, in my opinion, be an abuse of judicial power.

Id. at 478 n.5, 8 U.S.P.Q. at 1788 n.5. Here, the court stressed that the plaintiff had the additional option of seeking an injunction in every district in which the tour appeared. It is odd that the court did not expand its scope to consider the fundamental benefit that is reaped by the judicial system if adjudication of the same issue is centralized in one court.

n91 *551 F. Supp. 1054, 217 U.S.P.Q. (BNA) 862 (E.D. Wis. 1982).*

n92 *See supra* text accompanying notes 57-58.

n93 *See Brockum Int'l, 551 F. Supp. at 1055, 217 U.S.P.Q. at 863.*

n94 *See id.*

n95 *Id.*

n96 *See id. at 1055-56, 217 U.S.P.Q. at 863.*

n97 *See id.*

n98 *Id.*

n99 *See supra* note 89 and accompanying text.

n100 *See supra* note 90 and accompanying text.

n101 Traditional trademark jurisprudence considers the geographic territory in which the trademark operates in commerce. The geographic scope of an injunction is regularly tailored to reflect the territorial effect of the infringement and the irreparable harm that may be incurred by the trademark holder if this infringement persists. *See generally Golden Door, Inc. v. Odisho, 437 F. Supp. 956, 196 U.S.P.Q. (BNA) 532 (N.D. Cal. 1977).* The court in *Golden Door* held: "[since] plaintiff's market area, and hence the sphere of its reputation [was] nationwide[,] it [was] entitled to nationwide protection [by way of an injunction]." *Id. at 968, 196 U.S.P.Q. at 543; see also Five Platters Inc. v. Purdie, 419 F. Supp. 372, 193 U.S.P.Q. (BNA) 411 (D. Md. 1976).*

n102 See generally *Five Platters Inc. v. Purdie*, 419 F. Supp. 372, 193 U.S.P.Q. (BNA) 411 (D. Md. 1976).

n103 *Brockum Int'l, Inc.*, 551 F. Supp. at 1055, 217 U.S.P.Q. at 863. Plaintiffs should consider presenting to the court an economic analysis documenting the amount of money involved in the merchandising industry. This analysis could be presented under the "irreparable harm" prong of the preliminary injunction test. The court's sentiment toward tour memorabilia may be due to simple ignorance to the amount of money that is lost by the plaintiffs as a result of bootlegging. An economic study could conclusively demonstrate to the court that the merchandising industry is extremely lucrative and the infringing activities of bootleggers diminishes the amount of money earned by the plaintiffs, thereby causing irreparable harm.

n104 *Plant v. Various John Does*, 19 F. Supp.2d 1316, 1322 (S.D. Fla. May 21, 1998) (holding that the plaintiff's request for preliminary injunctive relief should be denied). In response to the court's sentiment toward national, multi-district preliminary injunctive relief, record labels may begin seeking more legislation. See Patricia Bates, *A Look at the Relationship of Labels & Merchandisers. (Sound Recording Industry and Licensed Merchandise)*, 103 AMUSEMENT BUS., May 13, 1991, at 3.

n105 See *Rock Tours, Ltd. v. Various John Does*, 507 F. Supp. 63, 212 U.S.P.Q. (BNA) 571 (W.D. Ala. 1981).

n106 See *Brockum*, 685 F. Supp. at 477, 8 U.S.P.Q.2d at 1787.

n107 FED. R. CIV. P. 65(b).

n108 The language of the rule reads as follows:

(b) Temporary Restraining Order; Notice; Hearing; Duration.

A temporary restraining order may be granted without written or oral notice to the adverse party or that party's attorney only if (1) it clearly appears from specific facts shown by affidavit or by the verified complaint that immediate and irreparable injury, loss, or damage will result to the applicant before the adverse party or that party's attorney can be heard in opposition, and (2) the applicant's attorney certifies to the court in writing the efforts, if any, which have been made to give the notice and the reasons supporting the claim that notice should not be required. Every temporary restraining order granted without notice shall be indorsed with the date and hour of issuance; shall be filed forthwith in the clerk's office and entered of record; shall define the injury and state why it is irreparable and why the order was granted without notice; and shall expire by its terms within such time after entry, not to exceed 10 days, as the court fixes, unless within the time so fixed the order, for good cause shown, is extended for a like period or unless the party against whom the order is directed consents that it may be extended for a longer period. The reasons for the extension shall be entered of record. In case a temporary restraining order is granted without notice, the motion for a preliminary injunction shall be set down for hearing at the earliest possible time and takes precedence of all matters except older matters of the same character; and when the motion comes on for hearing the party who obtained the temporary restraining order shall proceed with the application for a preliminary injunction and, if the party does not do so, the court shall dissolve the temporary restraining order. On 2 days' notice to the party who obtained the temporary

restraining order without notice or on such shorter notice to that party as the court may prescribe, the adverse party may appear and move its dissolution or modification and in that event the court shall proceed to hear and determine such motion as expeditiously as the ends of justice require.

Id.

n109 *Developments in the Law - Injunctions*, in 78 *HARV L. REV.* 994, 1060 (1965).

n110 See Supplemental Memorandum of Law in Support of Plaintiff's Motion for a National Multi-District, Preliminary Tour Injunction and Order of Seizure, *Beastie Boys v. Various John Does*, No. C98-1058 (W.D. Wash., filed July 29, 1998).

n111 See Goeffrey C. Hazard, Jr., *Foreword* to UNFAIR COMPETITION RESTATEMENT, *supra* note 14, at XI.

n112 RESTATEMENT OF TORTS § § 708 - 761 (1997).

n113 Hazard, *supra* note 111, at XI.

n114 *Id.* at XI - XII.

n115 See UNFAIR COMPETITION RESTATEMENT, *supra* note 14, at 369.

n116 See Professor Carolyn Martin, Address at the Class Session for Copyrights and Trademark at Howard University School of Law (Nov. 19, 1998). In a discussion with Prof. Carolyn Martin, it was brought to my attention that it is difficult to adequately determine the response of the courts toward the Unfair Competition Restatement. When asked her perspective on how widely accepted the Unfair Competition Restatement would become, her response was simply, "it's too soon to tell." *Id.*

n117 Paul J. Heald, *Filling Two Gaps in the Restatement (Third) of Unfair Competition: Mixed-Use Trademarks and the Problem with Vanna*, 47 *S.C. L. REV.* 783, 784 (1996).

n118 UNFAIR COMPETITION RESTATEMENT, *supra* note 14, § 35, at 360-61.

n119 Compare UNFAIR COMPETITION RESTATEMENT, *supra* note 14, § 35 with 15 *U.S.C.* § 1116 (1994 & Supp. IV (1998)).

n120 See, e.g., UNFAIR COMPETITION RESTATEMENT, *supra* note 14, § 35, at 361-68.

n121 See *id.* at 361.

n122 See *id.*

n123 *Id.* at 363.

n124 See Carlisle, *supra* note 9.

n125 See, e.g., Johnson, *supra* note 1, at 124.

n126 UNFAIR COMPETITION RESTATEMENT, *supra* note 14, cmt. c at 363.

n127 See *id.*

n128 See *id.*

n129 *See id.* cmt. f at 367.

n130 *See Hazard, supra* note 111, at XI-XII.

n131 *See generally id.*

n132 *See, e.g.,* Cindy Stooksbury, *Christian Artists Maximizing Tour Merchandise Opportunities*, 107 AMUSEMENT BUS., Nov. 20, 1995, at 8 (during a tour, "40 percent of the money taken in on a given night will be from sales of music-related product[s]").

n133 In *Winterland Concessions Co. v. Sileo*, 528 F. Supp. 1201, 213 U.S.P.Q. (BNA) 813 (N.D. Ill. 1981), the plaintiff's sales were in excess of \$ 15,000,000, ninety percent of which were from concert sales. *Id.* at 1207, 213 U.S.P.Q. at 817. This figure was taken in 1981. As it has been at least a decade since these figures were compiled, and considering the rise of inflation and the continual growth of the music industry and consumer trends, it can be estimated that sales have increased exponentially. It has been stated that the "retail sales of licensed music products have grown steadily over the past few years, rising from \$ 900 million in 1992 to \$ 1.08 billion in 1995." *Music-Related Licensing Mines Wider Range of Images, Makes Inroads Into Mass Market*, LICENSING LETTER, Nov. 1, 1996, at 1-2. The merchandising industry has been characterized as being a "half-billion dollar industry." Bates, *supra* note 104, at 5.

n134 *See Binole, supra* note 66 ("Bootleg sales, according to the suit, deny Lilith Fair and McLachlan their rights to decide how they are sold, harm their reputations, unlawfully exploit their commercial values, and deny them profits.").

n135 *See* Mark Lambert, *Musician Seeks to Halt Bootleg Merchandise*, THE BATON ROUGE MORNING ADVOC., Aug. 8, 1990, at 10A ("Production companies [such as] Winterland Productions and Bustin Productions, contend the sale of the bootleg merchandise 'results in substantial irreparable injury' to them because it violates their trademark rights, illegally 'exploits the commercial value that the plaintiffs have developed,' and harms their reputation because the counterfeit merchandise 'is of inferior quality.'").

n136 *See Winterland Concessions Co. v. Macintosh*, No. 89-8342, 1992 WL 170897, at * 3 (E.D. Pa. July 14, 1992).

n137 Johnson, *supra* note 1, at 123 ("The vendors had to dodge the police. George guaranteed bail, but the vendors had no way to contact him, so the 'guarantee' was, in effect worthless. . . . Vendors were very careful to avoid arrest.").

n138 Most merchandise licensing agreements require that the licensee pay a license fee to the licensor for the use of the trademark. The licensing agreement may also have additional restrictions on how the trademark may be used in commerce. *See, e.g.,* Jonathan R. Tillem, *Drafting Licensing Agreements*, in DRAFTING, NEGOTIATING AND ENFORCING TRADEMARK, COPYRIGHT AND SOFTWARE LICENSING AGREEMENTS A SATELLITE PROGRAM 9 (PLI, Patents, Copyrights, Trademarks, and Literary Property, Course Handbook Series No. G-517, 1998); Seth M. Siegel & Marla Gross, *Overview--The Business And Legal Fundamentals Of Licensing*, in UNDERSTANDING THE INTELLECTUAL PROPERTY LICENSE 38 (PLI, Patents, Copyrights, Trademarks, and Literary Property, Course Handbook Series No. G-496 1997).

n139 See Tillem, *supra* note 138, at 11-17.

n140 Darrow, *supra* note 3, at 6. For an example of a merchandising agreement between the vendor and the musical group see generally Tillem, *supra* note 138, at 35-55.

n141 Johnson, *supra* note 1, at 121.

n142 Trademark (Lanham) Act of 1946, ch. 540, 60 Stat. 427 (codified as amended at 15 U.S.C. §§ 1051 - 1127 (1994 & Supp. IV 1998)). See Trademark Counterfeiting Act of 1984, Pub. L. No. 98-473, 98 Stat. 2178 (codified as amended in scattered sections of 15 & 18 U.S.C. (1994 & Supp. IV 1998)). Congress' intent to protect trademarks is very clear. See 15 U.S.C. § 1127 (1994). This intent is evidenced by the unlimited duration of trademarks. Unlike a copyright, which has a limited duration, the only limit on trademark protection is that the registration on a trademark must be renewed after every ten years. As long as the trademark is continually being used in commerce, a trademark can, in effect, last into perpetuity. See 15 U.S.C. §§ 1058 - 1059 (1994).

n143 See, for example, the rationale articulated by the court in *Plant v. Various John Does*, 19 F. Supp.2d 1316, 1319-20 (S.D. Fla. 1998).

n144 See David M. Epstein, Annotation, *Propriety of Use of Fictitious Name of Defendant in Federal District Court*, 139 A.L.R. FED. 553 (1997). "Suits against Doe defendants are usually permissible only against real but unidentified defendants and the court may dismiss an action against a Doe defendant if it does not appear that the true identity of the Doe defendant can be determined." *Id.* at 553.

n145 See Williams, *supra* note 53 (citing *Joel v. Various John Does*, 499 F. Supp. 791 (E.D. Wis. 1980)).

The court [has] recognized that it does not have the power to order injunctive relief against a person over whom it had not acquired personal jurisdiction, and that the naming of 'John Doe' defendants was not favored in federal courts. However, because plaintiffs had demonstrated the likelihood of success on the merits and irreparable injury if defendant were not enjoined, the court issued the injunction. As a court of equity, it said, it was free to fashion whatever remedy would adequately protect the rights of the parties before it. The defendants were to be served with the summons, complaint, and injunction when unauthorized merchandise was seized from them, and would be informed of their right to appear in court to contest the seizures, and plaintiffs had posted a bond to cover any damages that defendants might incur as a result of the seizures. The court was of the opinion that these measures would adequately protect defendants' rights. *Id.* at 202.

n146 See 11A CHARLES ALAN WRIGHT ET AL., FEDERAL PRACTICE AND PROCEDURE, CIVIL 2d § 2949 (1995).

[Civil Procedure] Rule 65(a)(1) requires that notice be given to the adverse party before the preliminary injunction may issue. The rule is silent about when notice must be given, but Rule 6(d) states that any motion must be served, along with notice of the hearing thereof, not later than five days before the time set for the hearing. Accordingly, the notice under Rule 65(a)(1) should be served on the adverse party at least five days before the preliminary injunction hearing. In many instances a shorter notice period would compromise the opposing party's ability to marshal the evidence and present arguments

against the issuance of the injunction, which might violate due process standards. However, when the urgency that is characteristic of the preliminary injunction context warrants, the court has discretion under Rule 6(d) to modify the period for giving advance notice. Although Rule 65(a)(1) does not define what constitutes proper notice, it has been held that providing a copy of the motion and a specification of the time and place of the hearing are adequate.

Id. at 213-14.

n147 See Epstein, *supra* note 144.

n148 See Wright, *supra* note 146.

n149 See Jack L. Johnson, Comment, *Due Or Voodoo Process: Virtual Representation As A Justification For The Preclusion Of A Nonparty's Claim*, 68 *TUL. L. REV.* 1303, 1323 (1992).

n150 See, e.g., *Beastie Boys v. Various John Does*, No. C98-1058 (W.D. Wash. July 29, 1998); *Plant v. Various John Does*, 19 *F. Supp.2d* 1316 (S.D. Fla. 1998); *Winterland Concessions Co. v. Various John Does*, No. CV-96-779-MA (D. Or. May 30, 1996); *Winterland Concessions Co. v. Various John Does*, No. 95-CI-04910CC (N.D. Ga. Mar. 1, 1995); *Brockum Co. v. Various John Does*, 685 *F. Supp.* 476, 18 *U.S.P.Q.2d* (BNA) 1786 (E.D. Pa. 1988); *Brockum Int'l v. Various John Does*, 551 *F. Supp.* 1054, 217 *U.S.P.Q.* (BNA) 862 (E.D. Wis. 1982); *Rock Tours, Ltd. v. Various John Does*, 507 *F. Supp.* 63, 212 *U.S.P.Q.* (BNA) 571 (N.D. Ala. 1981); *Joel v. Various John Does*, 499 *F. Supp.* 791 (E.D. Wis. 1980).

n151 See Johnson, *supra* note 1, at 122-24.

n152 See *id.*

n153 See *id.*

n154 See Johnson, *supra* note 1, at 124.

n155 See, e.g., *Beastie Boys v. Various John Does*, No. C98-1058 (W.D. Wash. July 29, 1998).

n156 See *id.*

n157 See Pollack, *supra* note 6.

n158 See Darrow, *supra* note 3.

n159 Tour venues feature the sale of artist memorabilia. See *id.*

n160 See Rick Ansorge, *Newest Trading Cards Feature Hot Rap Acts / But You'll Have to Get Your Gum Elsewhere*, COL. SPRINGS GAZETTE TEL., May 9, 1992, at E1 (T-shirts, hats, and sleeping bags); Robert A. Cronkleton & Victoria Sizemore Long, *Toy Industry Hopes to Buck Recession as Adults Delay Big Purchases, Tots May be Beneficiaries*, THE KAN. CITY STAR, Nov. 28, 1991, at B1 (action figures); Stuart Elliott, *Cadillac's 'Real World' Comedy Campaign*, USA TODAY, Sept. 17, 1990, at 4B (telephones); Jennifer Lowe, *With a Little Planning, Shopping for Toys Can be . . . Child's Play*, THE ORANGE COUNTY REG., Nov. 5, 1990, at E1 (stickers); Seymour Seidman, *Sheets: Efficiencies And Economies Of Scale*, HFD-THE WEEKLY HOME

FURNISHINGS NEWSPAPER, Dec. 17, 1990, at 56 (bedsheets); *Ol' Blue Eyes Turns a Suave* 75, THE PHOENIX GAZETTE, Dec. 12, 1990, at C1 (commemorative coins); Keith L. Thomas, *'New Parents' Share Mania with 5,000 Fans*, ATLANTA J. & CONST., Aug. 10, 1990, at D1 (buttons and books).

n161 An alternate consideration for plaintiffs who seek a national, multi-district preliminary tour injunction is for the musical group to include a tour stop in a jurisdiction that is not adverse to ordering a nationwide injunction.

n162 See UNFAIR COMPETITION RESTATEMENT, *supra* notes 14 & 128, and accompanying text.

n163 *Liberty Mut. Ins. Co. v. Liberty Ins. Co. of Tex.*, 185 F. Supp. 895, 909, 127 U.S.P.Q. (BNA) 312, 324 (E.D. Ark. 1960)