

Record-Label Names as Trademarks: Enforceable or Expendable?

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I. INTRODUCTION

A client wants to start a new record label to produce rap recordings under the name NOMAD. He asks you to conduct a trademark clearance search. You find a federal registration for NOMAD for a record label that produces rock recordings. At first blush, this seems to be a clear conflict: the registrant uses the identical name, sells the same kind of product that your client wants to sell (most likely in the same retail and online outlets), clearly has priority of use, and has the prima facie exclusive right to use that mark for those goods in the United States. But is that the end of the inquiry? Would your client definitely be infringing that registration if your client used NOMAD for its record label?

In fact, in every reported case in which one record label has sued another for trademark infringement, the plaintiff has lost. In virtually all of those cases, a key factor in the defendant's victory was the court's finding that since music stores organize recordings by genre and then alphabetically by artist, not by label; and since consumers shop for music by artist and song, not by label; it was not likely that a consumer shopping for a particular recording would be confused into buying a different recording based on a similar label name.

Do these decisions make sense? On what evidence were they based? Do record-label names really not play any role at all in consumers' decisions about which recordings to buy? If that is the case, is there any reason for a record company to take care in choosing a name, or to try to choose a distinctive name, for a new label?

II. THE LEGAL CRITERIA

Before looking at the decisions, it is worth reviewing the basic criteria by which the courts determine whether one trademark infringes another.

Your client's proposed trademark will infringe another mark if it is likely that consumers will be confused into thinking that your client's NOMAD recordings (i) are being provided by the producer of the other NOMAD recordings; (ii) are affiliated with other NOMAD services or products; or (iii) are endorsed by the provider of other NOMAD services or products. The question in a trademark infringement case is whether consumers are likely to think that the first user of the mark in question has expanded its offerings to include the goods or services that the second user, or "junior user" (which in this case would be your client) is offering.

To decide whether a likelihood of confusion exists, a court will consider a list of non-exclusive factors that, in the Second Circuit, comes from Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 (2d Cir. 1961), cert. denied, 368 U.S. 820 (1961): "the strength of [the plaintiff's] mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the

reciprocal [sic?] of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers.”²

If the junior user is bigger or better known than the senior user, the confusion at issue is known as “reverse confusion.” Instead of the traditional scenario in which consumers assume that the junior user’s product comes from or is associated with the senior user, consumers assume that the senior user’s product comes from or is associated with the junior user.

Infringement can result from confusion that creates initial consumer interest, even if the consumer realizes before he or she buys anything that the product being purchased does not come from the source from which he or she initially thought it did. For example, if your client made handbags under the name NOMAD, and someone picked up one of your client’s bags because she thought it was, or was related to, another line of handbags with a similar name; she realized that your client’s handbag in fact had nothing to do with the other line of handbags; but she decided to buy your client’s bag anyway, then your client would have obtained a customer by using someone else’s name.

The “junior user” has a legal duty to choose a mark that is not likely to be confused with a prior user's mark. Thus, even with a close call, the advisable course is to choose another mark.

III. THE CASES

A. Sunenblick v. Harrell

In *Sunenblick v. Harrell*, 895 F. Supp. 616 (S.D.N.Y. 1995), *aff'd*, 101 F.3d 684 (2d Cir. 1996), *cert. denied*, 519 U.S. 964, 117 S.Ct. 386, 136 L.Ed.2d 303, the plaintiff was a full-time medical doctor who had operated an independent record label on the side for 15 years. The label, which was called UPTOWN RECORDS to evoke “the stylish image of African-American jazz culture in Harlem, New York as it was known in the 1930’s and 1940’s,” recorded and released music of unknown or “forgotten” jazz artists.³ Sunenblick’s label was not exactly a commercial success. In 12 out of his 15 years in business, Sunenblick had sold a total of fewer than 5,000 records, and only three of his recordings had ever sold more than 5,000 copies a year. The court attributed these low sales figures to the fact that Sunenblick had done very little to promote his recordings. From 1982 through 1993, he had spent a total of \$13,500.00 on advertising (from 1989 through 1993, he had spent no money at all) and his catalog was not readily available to prospective purchasers, although the albums he had released had received good reviews.⁴ Sunenblick registered the mark UPTOWN RECORDS in New York State, but he never sought a federal registration.⁵

The defendant was André Harrell, a rap performer turned recording executive who had founded his MCA/UPTOWN RECORDS label in 1986 in a venture with MCA to develop rap and R&B (rhythm and blues) artists. Like the plaintiff, Harrell chose the name UPTOWN to evoke Harlem, although his vision was of “a new life style that was going on in the 80’s from the rap generation.”⁶ He was not aware of Sunenblick’s label when he chose the name (partly because no one conducted a trademark search). Between 1986 and

1994, Harrell's UPTOWN RECORDS label, whose ranks included well-known artists like Mary J. Blige, sold over 25 gold and platinum recordings.⁷

The two labels co-existed for five years without either one's being aware of the other until 1991, when Sunenblick sought to acquire the rights from MCA to release a certain jazz recording under his own label, and MCA advised him that it would not let him do so because it had its own UPTOWN label. At that point, Sunenblick demanded that Harrell cease and desist. When he would not, Sunenblick sued for infringement.⁸ Since Harrell's label clearly was much bigger than his, Sunenblick claimed "reverse confusion."⁹

Considering Sunenblick's infringement claim, the court went through the Polaroid factors in order. Since Sunenblick was claiming reverse confusion, when the court considered "the strength of the mark," it looked at the defendant's mark.¹⁰ Although Harrell's label had millions of dollars in sales, the court nevertheless found that this factor weighed slightly in Sunenblick's favor because the defendants had not presented any survey evidence. The court found that "with infrequent releases, anemic advertising and poor sales, Sunenblick's catalog is virtually invisible in the jazz marketplace, and in the market for music generally."¹¹ As regards similarity of the marks, the court concluded that although the marks as spoken were identical, the parties' respective logos were sufficiently different so that the marks were "not likely to promote confusion."¹² On the issue of product proximity, the court accepted the testimony of the defendant's expert, Steve Harman, Regional Manager of Tower Records,¹³ that

[a]lthough the products are sold in the same channels of trade, they are not sold side-by-side; rather, they are featured in different sections of the stores in which they are sold, according to genre, and not by label name.... Hence, absent any evidence that consumers of one will be potential consumers of the other, it is most likely that consumers entering a record store with the intention of purchasing one of [plaintiff's] products would not even see the defendants' products, much less the trademarks appearing thereon.¹⁴

From there, the court went on to find that Sunenblick had no plans to bridge the gap to hip-hop; the instances of actual confusion that Sunenblick presented did not involve the end consumers and thus did not prove that consumer confusion was likely;¹⁵ Harrell had adopted his mark in good faith; and Harrell's recordings were of high quality.¹⁶ Finally, the court agreed with the defendants that "buyers of musical recordings are relatively sophisticated consumers whose purchasing decisions are driven by a recognition of and search for a particular artist or composition, and whose awareness of the record label – if such awareness even exists at the time of purchase – is at best a peripheral concern compared to the contents of the recording [sic]."¹⁷ All things considered, the court held that there was no likelihood of confusion.

The court expressly declined to rule, however, that record labels are always irrelevant to a music consumer's purchasing decision, because

[t]he unavoidable conclusion would be that such marks can never receive protection under the trademark law. The court is not willing to go quite that far. Nevertheless, the court does accept that the role of the trademark in the

purchase of musical recordings is generally subordinate in a meaningful way to the purchaser's search for the artist and the composition. Compact discs are not radial tires.^{18, 19}

B. Tsiolis v. Interscope Records, Inc.

Tsiolis v. Interscope Records, Inc., 946 F. Supp. 1344 (N.D. Ill. 1996), was an action by the heavy-metal band Aftermath against the rap artist André Young, who was known as Dr. Dre. Young had just left Death Row Records and started his own label, which he called Aftermath Entertainment, which was distributed by Interscope. The AFTERMATH band name, for which Tsiolis had a federal registration, turned up in a trademark search done by Tsiolis's attorneys. One of the attorneys offered Tsiolis \$5,000.00 in return for permission to use AFTERMATH as the name of "a small r&b label," without disclosing the nature or scope of that label or the fact that "Dr. Dre" was involved. When Tsiolis refused, the attorney offered him a recording contract worth about \$20,000.00 if he would assign the mark to Interscope. Tsiolis refused this offer as well, perceiving it as a "sham." At this point, Young stopped pursuing Tsiolis and simply started his company under the AFTERMATH name. When Tsiolis discovered what Young was doing (by which time Young had already spent \$200,000.00 promoting the upcoming label), he sought a preliminary injunction to keep Dr. Dre from using AFTERMATH.²⁰

In support of his claim that the public was likely to think that his heavy-metal band was related to Young's rap label, Tsiolis offered expert testimony from a sociologist that the lines that separate the various genres of music are constantly changing and that certain groups combine elements of both rap and heavy metal.²¹ Defendants offered contrary expert testimony that "while undoubtedly some fans listen to both rap and heavy metal music, the two styles of music are different and have different primary audiences. The primary audience of heavy metal is white, teenage, working-class males; the primary audience of rap is young, urban, black males."²²

More important for this analysis, the defendants' expert also testified that

the selling feature of a musical recording is not the record label, but the performing artists. Except in rare instances, such as the Motown record label, the record label names are not considered by record consumers when they purchase musical recordings. Therefore, each record label focuses its marketing activities on promoting and advertising the artist and his or her works, not the record label name.²³

The same expert also testified that it was "highly unusual for a band to market its recordings on a label of the same name. Thus, bands and record labels with the same names have co-existed for three decades." Among the examples that the expert gave were the labels and bands named Cream and Imperial.²⁴

The defendants also put on the V.P. of Marketing for Best Buy, who testified that that store organizes its records by genre, and within each genre, by the name of the artist: "[a]ccording to Arnold, record consumers purchase music with a specific artist or specific

album, not record label, in mind,” and therefore, “stores such as Best Buy do not decide to purchase records because of their record labels, but because of the popularity of the artist.”²⁵

Tsiolis’s motion for a preliminary injunction was denied. Incredibly, the court found that the mark AFTERMATH was “not fanciful, arbitrary, or suggestive,” but merely descriptive. But it went on to hold that even if it had not made this finding, there was no likelihood of confusion. Citing the evidence described above, the court found that consumers of recordings would use a high degree of care and that they are motivated to buy recordings based on the artist, not the label. Because of the way stores organize the records, “even the most inattentive and careless purchaser of the [plaintiff’s] works will be hard-pressed to ‘accidentally’ purchase the albums of artists that are produced by the AE label.”²⁶

C. Cooper v. Revolution Records, Inc.

In Cooper v. Revolution Records, Inc., 1997 U.S. App. LEXIS 8128, aff’d without opinion, 111 F.3d 138 (9th Cir. 1997) (unpublished), the Ninth Circuit affirmed the denial of a preliminary injunction to the owner of Revelation Records, an independent alternative-rock label founded in 1987 whose focus was hardcore punk,²⁷ against Revolution Records, another alternative-rock label,²⁸ for infringement of Revelation’s unregistered mark REVELATION RECORDS. Since the Ninth Circuit’s opinion does not state any of the underlying facts, and the district court’s opinion was not reported, it is necessary to elicit the facts from the dissenting opinion of Judge Kleinfeld.

When Revelation made its motion for a preliminary injunction, Revolution had not yet started selling its records in stores, so there had not yet been any opportunity for actual consumer confusion. To prove the likelihood of confusion, Revelation presented an affidavit from one record-store owner that stated, “Based on my experience as a record store owner, manager and buyer, I have found that my retail customers do in fact make purchasing decisions based on the name and identity of the label itself.”²⁹ Revelation also submitted an affidavit by the plaintiff, Jordan Cooper, which stated that buyers regularly contacted Revelation by phone to buy Revelation’s entire collection of releases. The evidence that people do buy the label made the aural similarity of the defendants’ mark especially problematic. Mr. Cooper’s affidavit and an affidavit by Revelation’s marketing director, John Nutter, both recounted an incident in which “a national trade publication confused the names [REVELATION and REVOLUTION], and an advertising representative called Revolution looking for Mr. Nutter.”³⁰

Cooper also submitted evidence that, although Revolution’s lawyers had not done a full trademark search before the company adopted the name REVOLUTION,³¹ executives at the company, which previously had been called Giant Records, knew of Revelation Records. In his affidavit, Cooper asserted that one of the Revolution executives had actually told Cooper that he had advised Giant Records against changing the name because it was too close to REVELATION. An affidavit of the executive in question disputed this, and “spen[t] several pages recounting his purported explanation to Cooper of how Giant believed the two marks were different.”³² This effort was so detailed as to compel Judge Kleinfeld to conclude that “someone at Giant had given this a great deal of thought.”³³ In any event, at oral argument on the motion, counsel for Revolution confirmed that Giant had known of Revelation Records when it changed its name to Revolution.

For its part also, in addition to the evidence already discussed, the defendant introduced evidence that its executives did not believe that its adoption of the name REVOLUTION would cause confusion because Revolution served a more “mainstream” market than Revelation. It attributed great significance to the fact that the plaintiff advertised as Revelation Records, while the defendant promoted itself simply as REVOLUTION. The defendant also argued that it had spent a lot of money advertising its mark, which presumably was intended to show that it was likely to suffer more harm than the plaintiff.

The district court found that Revelation’s mark was inherently weak because it was not registered in the Trademark Office. (Apparently the district court confused the legal effect of a federal registration, which creates a presumption that the mark is valid, with the issue of whether the mark is strong.) It also found that “due to [Revolution’s] anticipated massive advertising and market saturation, customer confusion could benefit [Revelation Records] by generating more sales,” and therefore, it held, Revelation could not show a likelihood of irreparable harm.³⁴ It did not discuss the similarities and differences between the markets that the two companies served or whether record-label names actually figure in people’s purchases of sound recordings.

The Ninth Circuit held that the district court had erred in finding that Revelation’s mark was inherently weak because Revelation did not have a federal registration, and that the lower court had misapplied the doctrine of reverse confusion when it held that reverse confusion could benefit Revelation. Nevertheless, the appellate court affirmed, holding that there had been no abuse of discretion, and emphasizing that, “[w]hile the two names taken alone are very similar, the Revelation Records name has the word ‘records’ as part of it whereas Revelation does not. Moreover, the two logos are quite different and serve to further differentiate the names.”³⁵

The dissenting judge, Judge Kleinfeld, attacked the majority on several points. First, he agreed with the plaintiff that since many customers would contact Revelation by phone, the aural similarity of the marks was more important than the visual difference in logos. Indeed, Judge Kleinfeld pointed out, the judges themselves had confused the two names several times at oral argument. Second, the fact that the plaintiff’s name included the word “records” was insignificant to distinguish the two label names:

I don’t even know whether RCA, Decca, Columbia, Deutsche Grammaphon, or any of the other labels I have special ordered [sic] have “Records” at the end of the name, and [I] doubt that many other people who stop up to the counter to place an order, or look through the bins, do either. If the clerk said “is it on Columbia Records or Columbia?” nearly all consumers would say “I don’t know.”³⁶

Moreover, Judge Kleinfeld pointed out,

[d]espite Revolution’s argument that the two marks are dissimilar because Revelation’s includes the word “Records,” the record includes an advertisement for an album by “Revolution Records!” It is in Revolution’s Super Deluxe ad, which says, “On Revolution Records.” Did they mix up their own name (as we did)? Did

the advertising agency? Whatever the reason, the word “Records” does not make the marks distinctive.³⁷

With respect to the district court’s holding that reverse confusion would benefit Revelation, Judge Kleinfeld asserted:

Revelation is entitled to the integrity of its own mark. People who like more mainstream music are likely not to like [Revelation’s], and not be repeat buyers. Old Revelation customers who mistakenly buy Revolution albums, a more likely phenomenon based on Revolution’s marketing power, are likely to think that Revelation has “sold out” and “gone mainstream,” and [to] lose interest in Revelation products. Those are the business risks [that] a preliminary injunction based on confusingly similar names is supposed to prevent.³⁸

Finally, Judge Kleinfeld took the defendant to task for taking what he considered to be a “cynical gamble that it could overwhelm the smaller label in litigation.”³⁹

D. Q Div. Records, LLC v. Q Records

In Q Div. Records, LLC v. Q Records, 2000 U.S. Dist. LEXIS 1773 (D. Mass. 2000), the district court denied the plaintiff’s motion for a preliminary injunction. The plaintiff, an alternative rock label, had a federal registration for QDIVISION but not for Q DIVISION RECORDS. It used the name Q DIVISION RECORDS together with a small oval logo that “features an obliquely set ellipse with a line through the middle, an abstraction simultaneously evocative of both the letter ‘Q’ and an old-fashioned vinyl record slightly tilted and halfway down the spindle.” The defendant was an electronic retailer, owner of the famous home shopping channel, that had added records to the plethora of goods that it sold.

Having established that the plaintiff’s QDIVISION mark was presumptively valid because of its federal registration, the Massachusetts district court went down the First Circuit’s list of factors, which, as the opinion says, “resembles, though it does not precisely mirror,” the Polaroid factors. It found the two parties’ marks to be “quite dissimilar in total effect” because of the differences between the parties’ respective logos, and also on account of the word DIVISION in the plaintiff’s mark, which it found the defendant to be using “in an entirely arbitrary fashion,” not to indicate that the defendant was a division of a separate parent entity.

The court reached a similar conclusion about the parties’ goods:

Q Division’s stable of artists appear [sic] to specialize in so-called “alternative rock,” an appellation used to denote several strands of hard-to-categorize pop music subgenres. Perhaps the best description that may be offered is that Q Division’s artists create challenging works which [sic] are not intentionally geared for market success. Recordings marketed under the Q Records, imprint, on the other hand, apparently will cut a broader arc across various musical genres, ranging from opera to honkey-tonk [sic] to Broadway show tunes. Though quite a few of the artists featured in these recordings have achieved considerable degrees of critical success, the tune that seems to have caught QVC’s corporate ear is the melodious ring of the mass-market cash register.⁴⁰

Thus, while “an eclectic audiophile” might have recordings from both companies in her collection, the court concluded, “[t]he goods themselves are dissimilar.”⁴¹

Next, the court considered, all together, channels of trade, advertising, and the classes of prospective purchasers, devoting considerable space and effort to the last item:

There are essentially three types of "prospective purchasers" that a record label regularly deals with. The first type consists of those who seek to purchase production and promotion services from the label. These include the artists and their agents who want to "get signed" as well as other labels looking to barter production and promotion capacity for a cut of the resulting sales revenues. The second group are [sic] distributors and retailers that seek to market the recordings generated by the labels. These two types of prospective purchasers are industry insiders by and large; they are presumed to be quite sophisticated and highly aware of both the gross and subtle distinctions between record labels. They are not likely to be confused in any material way by Q Records' and Q Division's marks.

Finally, there are the end-product consumers themselves. Unlike the insiders, they range in sophistication. Some know precisely what they want and search very efficiently to get it. Others may have trouble finding what they're looking for, and might seek advice from the proprietor of the record store-or, if shopping online, through information and search engines located on the website. One need only have a passing familiarity with purchasing records to know that the primary indicia of selection are the name of the artist, the title of the recording, and the genre of the music. [Citation to *Sunenblick v Harrell* omitted.] The name or mark of the record label is not a factor for most consumers.

This commercial fact of life is emphasized by the way that (physical) record stores are set up. Usually, records are grouped in stores by genre, then artist, then title of the recording. They are not organized by record label. To find Neil Young's *Rust Never Sleeps*, released by Warner Brothers in 1979, one would first typically locate the "Rock" section of the store and then search for "Neil Young" (probably, depending on the store staff, under "Y"). One would not, as a general matter, ask to be shown to the "Warner Brothers records" section; even if one did, very few stores, if any, would have such a thing.⁴²

In a footnote at this point, the court acknowledged that

[o]n-line Internet record shopping through websites established by record labels and retailers are changing this dynamic to some extent and are allowing consumers to shop by label. The availability of this method of searching, however, does not change the fact that consumers will likely use such search tools to continue purchasing records according to the traditional indicia: genre, artist, and record title.⁴³

In another footnote, the court also took note of the fact that

[t]o some extent, certain labels (particularly those that specialize in a particular genre or a small coterie of artists) may develop a reputation with consumers based on the artists whom they market. Some consumers, for example, may find themselves so

pleased with the works of Gastr Del Sol, Red Krayola, Royal Trux and Smog that they would treat any recording marketed by Drag City Records as a recording worth purchasing simply because Drag City has put its mark on it. But such a consumer, familiar enough with the variety of artists marketed under the same label to know that he or she would like to purchase more similarly-labeled records, would in all likelihood be a sophisticated aficionado. Such customers are not likely to be confused.⁴⁴

Nevertheless, on balance, all these factors favored the defendants.

With respect to actual confusion, the court held that a single e-mail to Q Division seeking a recording that had been released by Q Records “[did] not, standing alone, prove very much.”⁴⁵ Finally, the court looked at the defendants’ intent and “strength of mark,” which it considered together. Neither factor favored the plaintiff: there was “insufficient evidence in the record” to prove either that Q Records chose its name “out of some ill motive to capitalize on Q Division’s goodwill” or that Q Division’s marks were “commercially strong marks in the field of musical recordings.”⁴⁶ Accordingly, the court denied the preliminary injunction.

E. M2 Software, Inc. v. M2 Communs., LLC

In M2 Software, Inc. v. M2 Communs., LLC, 281 F. Supp. 2d 1166 (C.D. Cal. 2003), the California district court granted the defendants’ motion for summary judgment on the ground that no reasonable jury could conclude that there was a likelihood of confusion between defendant’s Christian music services and products, and plaintiff’s music products and royalty-tracking services. Although it appears from the opinion that the plaintiff was actually claiming that consumers would think that the defendant’s Christian CD’s were somehow related to the plaintiff’s royalty-tracking services, this opinion is worth noting for purpose of this analysis because on the issue of product proximity, at least with respect to the two parties’ respective music products, the defendant offered an “expert report” from a witness “with experience in the Christian music industry” that opined that “it is essentially unheard of in the music business for a consumer to search for music recordings by record label.”⁴⁷

IV. THE REAL WORLD

Do these opinions accurately assess the likelihood of consumer confusion when it comes to the names of record labels? With respect to the purchase of sound recordings in record stores, the opinions in Sunenblick, Q Division and M2 Software certainly seem to make sense. They accurately describe how most record stores actually are laid out and how individual consumers shop for sound recordings.⁴⁸ The affidavits submitted in Cooper as evidence that people in fact do shop for music by label do not offer very strong contradictory evidence, since obviously, they were not subject to cross-examination; and we do not know whether the record-store manager’s affidavit gave specific examples of labels that inspired such purchases.⁴⁹

Comments made by recording-industry executives and representatives over the past few years appear to confirm the courts’ conclusions. As far back as 1997, when the

recording industry was just starting to consider online distribution, an article in the *Washington Times* noted that for any recording company to succeed in selling directly to consumers over the Internet, the labels would need to change the way in which they communicated with music fans, because, as Hilary Rosen, then-president of the RIAA, put it, “Fans don't know music by labels, they know it by artists and genres.”⁵⁰ Four years later, commenting on the refusal of the five major labels to sell song rights to EMusic, a fledgling online music service, one industry analyst predicted that for successful online music sales, the industry needed to form one big online store where all music would be available, because “[c]onsumers don't know music by label” and, therefore, would not know which Web site to go to if each company had its own.⁵¹ A few months later, the new head of Pressplay, the online subscription service then run by Sony Music and Universal Music Group and now part of Napster, announced that Pressplay would seek licensing deals with other major label groups specifically because the average music consumer does not distinguish music by label.⁵² MusicNet, the online music service started by Warner Music Group, EMI, and BMG Entertainment, took a similar approach. (Ultimately, music consumers did not flock to either of them.)⁵³

The advent of online music retailing does not appear to have changed this situation. Most online music stores that exist today operate on the assumption that consumers do not shop for music by record label. Walmart.com, Apple's iTunes, J&R.com, and BestBuy.com do not permit users to search for sound recordings by label at all. Amazon.com and Barnesandnoble.com do permit such searches, but they are hardly intuitive: you have to drill down through the Web site to locate the label search function, which implies that such searches are geared toward those few people who know enough to look for this kind of “advanced search” or “power search” function and to find it. Amazon.com has partnered online with music retailers such as CDNow, Borders, and HMV, all of whom use this same search functionality. At www.allmusic.com, one can search by label directly from the home page, but “labels” is the last search category after artists, albums, songs and styles.⁵⁴

Nevertheless, there are certain genres in which the identity of the artist, or even particular pieces, may not be important as the record label to someone looking to buy a sound recording. In classical music, people often seek recordings of particular well-known works without having any idea (or necessarily caring) which well-known artists have recorded them. In that situation, knowledge of label names may be crucial to the decision to buy a particular recording. For example, many classical music lovers will buy almost anything that has been recorded on the Deutsche Grammophon label, which was started in 1898 in Germany and is now part of the Universal Music Group.⁵⁵ Its roster of artists includes Vladimir Horowitz, Anne-Sophie Mutter, the Berlin Philharmonic, and Andre Prévín; its catalog of classical recordings is immense. An online search shows five different recordings of the Brandenburg Concerti.⁵⁶ By contrast, Naxos, which promotes itself as “The World's Leading Classical Music Label,” issues only one recording of any given work.⁵⁷ Started in 1995, Naxos is known for superb recordings that cost much less than those produced by other companies.⁵⁸ Thus, if someone has been satisfied with the quality of prior Naxos recordings in the past, now wants a recording of the Brandenburg Concerti, and does not prefer any particular artist, he or she has only to go to Naxos and obtain Naxos's recording of that work. At least one online music site, that of Tower Records, recognizes that classical music lovers do buy music this way. If – and only if – you are looking for

classical recordings, you can search this site by label from the front page. Otherwise, to search by label, you have to use “Advanced Search” or “Power Search.”

Another genre in which music lovers today are likely to seek out particular labels by name, as opposed to particular artists or songs, is electronica, which refers to electronic dance and listening music. This is a very broad category of music that includes various subgenres such as house, techno, jungle, trance, breakbeat, downtempo and IDM.⁵⁹ Within these subgenres, people often search for recordings by label, because they are not familiar with the individual artists and because the economic barrier to entry into this genre is so low, new artists come along every day.⁶⁰ Among the labels that an electronica lover might search for are Warp Records (www.warprecords.com) and Ninja Tunes (www.ninjatune.net). Though these labels have their stars (Aphex Twin and Amon Tobin, respectively), buyers often will listen to, and even will chance buying, lesser-known label-mates just because those artists are on the Warp Records or Ninja Tunes labels. Frequently lesser-known artists from one of these labels will perform together on a label tour, such as the 1997 Ninja Tunes Stealth Tours. Since consumers know the label, they are willing to go to the show even though they may not be familiar with everyone who is playing.⁶¹ In this genre, which is not often covered in the press, labels function as a form of music criticism.⁶²

A similar phenomenon has occurred in some branches of indie rock. For example, in the early 1990s, SubPop, which is currently associated with grunge music, had what in retrospect is an impressive indie roster that included Nirvana, L7, and Smashing Pumpkins, etc. See <http://www.subpop.com/history/intro.html>. To some degree, many of those artists became famous initially *because of* their association with SubPop, rather than the other way around: SubPop has been called an “indie tastemaker.”⁶³

One record label that almost certainly attracted consumers in its own name and “made” its stars as much as they “made” themselves, is Motown. During the period of “classic Motown” (1959-1988),⁶⁴ when that company’s roster included Diana Ross, Smokey Robinson, Gladys Knight, the Jackson Five, the Temptations, and Stevie Wonder, many music lovers would attest to a recognizable “Motown sound” that would justify the purchase of any recording on the Motown label. But although the Motown site proclaims that “the legacy continues,” query whether music consumers today can identify a Motown artist as easily as they or their parents could two or three decades ago.

V. CONCLUSION

Let’s go back to our beginning hypothetical, in which your client wants to use the name NOMAD for a rap label, but someone is already using that name for a rock label. Given that the plaintiffs in all the record-label infringement cases lost their infringement claims against record labels with similar names, is your client likely to be infringing on the NOMAD rock label if your client uses NOMAD for its rap recordings? It appears not.

It is important to realize, however, that every decision discussed above except for Cooper v. Revelation Records was based at least in part on the fact that the two parties recorded or played distinctly different kinds of music. Indeed, in Sunenblick v. Harrell, in which the plaintiff used UPTOWN RECORDS for “lost” jazz recordings and the defendant used the same name for a rap label, the court expressly conditioned its holding that there

was no likelihood of confusion on the absence of “any evidence that consumers of one will be potential consumers of the other.”⁶⁵ So if your client were going to be producing rock music instead of rap music, or a wide range of recordings that included both, a court might well hold your client liable for trademark infringement.

Accordingly, even though people generally do not consider record-label names when they shop for music (if they actually shop instead of downloading music for free in the first place), it is still crucial to conduct a full trademark search on any name that a client wants to use as a record label, especially if the client is going to be selling recordings in classical or electronic music or any other genre where people pay special attention to those names. No matter how emotionally attached your client may be to the mark you are searching, if another record label with the same name in the same genre of music turns up, your client will be well advised to pick another.

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² Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 (2d Cir. 1961) at 495.

³ Sunenblick v. Harrell, 895 F. Supp. 616 (S.D.N.Y. 1995) at 620.

⁴ Id.

⁵ Id. at 621.

⁶ Id. at 622.

⁷ Id.

⁸ Id. at 623.

⁹ Id. at 625.

¹⁰ Since Sunenblick had no federal registration, the court first had to decide whether the mark UPTOWN RECORDS was worthy of trademark protection in the first place. It concluded that the mark was suggestive. Id. at 626.

¹¹ Id. at 627.

¹² Id. at 629. Sunenblick’s logo featured the word “Uptown” written across a cityscape, whereas Harrell’s logo centered on a black cat wearing oversized sneakers and a gold medallion, leaning on the word “Uptown.” In the respective logos, the word “Uptown” appeared in clearly different fonts.

¹³ Id. at 619.

¹⁴ Id. at 629. The court rejected the plaintiff’s contention that jazz records are commercially proximate to hip-hop recordings, which was based on testimony that there was a trend towards “fusion” of jazz and hip-hop and on a survey reporting a crossover between listeners of the two genres. As the court put it, “Fusion notwithstanding, the products at issue here are marketed differently and are still sold in separate sections of record stores. Moreover, Sunenblick’s recordings are ‘straight ahead jazz,’ not fusion, and concern artists who made their name [sic] years before fusion even made its appearance on the jazz scene.” Id. at 616.

¹⁵ Id. at 630.

¹⁶ Id. at 632-633.

¹⁷ Id. at 634.

¹⁸ Id. at 634.

¹⁹ On appeal, the Second Circuit stated simply, “We affirm, substantially for the reasons given in the opinion of the district court.” Sunenblick v. Harrell, 101 F.3d 684 (2d Cir. 1996).

²⁰ 946 F. Supp. at 1346-1349.

²¹ Id. at 1349.

²² Id. at 1350.

²³ Id.

²⁴ Id.

²⁵ Id.

²⁶ Id. at 1356.

²⁷ According to a previous version of the plaintiff’s Web site at www.revelationrecords.com (which is now cached), the plaintiff, Jordan Cooper, founded Revelation Records with a partner with the sole intent of producing one particular album by one punk group. In the first three years, the label put out 23 releases and pressed approximately 20,000 records, and it has continued to release an average of 7-8 albums a year.

²⁸ An online search for REVOLUTION RECORDS turned up several companies with variants of that name but it is not clear whether any of these was the defendant in this case. Interestingly enough, a few months ago, at www.revolutionrecordsonline.com appeared a notice that stated (in all lower-case letters), “unfortunately, revolution records has been issued a ‘cease and desist’ letter by a larger, anonymous company. this company believes that the revolution is impeding its capitalist napoleonic vision. in other words, we have been trampling too many toes. this is exciting. it means that we are actually reaching people, creating controversy, and changing lives ... for the better! what are we going to do? change the name! and keep on producing revolutionary music.” This site is no longer accessible.

29 Cooper v. Revolution Records, Inc., 1997 U.S. App. LEXIS 8128 at *8.

30 Id. at *10.

31 Revolution had done a federal trademark search, but that did not turn up Revelation's name because Revelation did not have a federal registration. Id. at *17-*18.

32 Id. at *17.

33 Id.

34 Id. at *4.

35 1997 U.S. App. LEXIS 8128 at 3.

36 Id. at 9.

37 Id. at 10.

38 Id. at 11.

39 Id. at 19. Overall, Judge Kleinfeld seems to have based his dissent on the questionable ethics that implicitly underlay the defendants' name change, rather than on an analysis of whether consumers actually buy sound recordings by label in the first place.

40 Q Div. Records, LLC at *14.

41 Id.

42 Id. at *15-*18.

43 Id. at *18. The opinion in Q Division does not make clear whether the defendant submitted specific evidence on this point or whether the court was taking judicial notice based on its own observations. Presumably the court would have been obligated to state that it was taking judicial notice.

44 Id. at *17.

45 Id. at *19.

46 Id. at *20.

47 281 F. Supp. 2d at 1174. In connection with noting this evidence, the court cited Sunenblick and Tsiolis.

48 One point that none of these opinions makes is that given the sheer cost of CD's, a prospective purchaser is unlikely to buy a CD without being sure that the album he or she is buying is the album that he or she wants. In Mars Musical Adventures, Inc. v. Mars, Inc., 159 F.Supp.2d 1146 (D. Minn. 2001), a case that involved competing music *stores*, the court made this point: "The products sold by both companies are not inexpensive, and call for a higher than average degree of sophistication and consideration in making the purchases, given the wide array of options and product lines. The Court finds that in this case, the type of products sold, and the level of involvement of consumers with these products, indicate that customers will take more time and effort in their purchase decisions." Id. at 1153.

⁴⁹ We do not even know whether the record store whose manager submitted the affidavit carried any genre other than rock. If it carried only rock, then it would have been in a singular position to organize its wares by label.

⁵⁰ Eric Fisher, *Internet has record appeal; Music firms hope to lure customers onto the Web*, THE WASHINGTON TIMES (Aug. 27, 1997) at B7.

⁵¹ Todd Pack, *Napster Fans: New Service Is Off Key; Experts And Napster Users Say Musicnet, A Big-Label Backed Subscription Service, May Have Trouble Catching On*, ORLANDO SENTINEL (April 3, 2001) at B1.

⁵² Tamara Conniff, *Schuon changes tune, named CEO of new pressplay*, THE HOLLYWOOD REPORTER (June 12, 2001).

⁵³ In 2003, “[a] belated realisation [sic] that consumers do not buy records by label group, led to two joint venture subscription services, Pressplay and MusicNet, neither of which proved attractive to consumers.” See *RIAA’s threat to sue file-sharers raises questions over copyright and the Internet*, MUSIC & COPYRIGHT (July 11, 2003) (emphasis added).

⁵⁴ This site is owned by All Media Group, which is owned by Alliance Entertainment Corporation. See <http://www.allmediaguide.com/overview.html>.

⁵⁵ One might ask whether anyone who knows enough about classical music to prefer Deutsche Grammophon would not inherently know enough about classical artists and repertoire to know what particular recordings to look for, so that he or she is not really buying by the label. The answer is, not necessarily. Someone who knows a lot about violinists and violin repertoire, for example, will not necessarily know anything about artists and repertoire with respect to other string instruments, woodwind, brass or percussion instruments; particular vocalists (including changes in a singer’s voice and music preferences over the course of his or her career); or particular ensembles of different types (*e.g.*, string quartets, wind quintets, early music ensembles, opera companies, etc.).

⁵⁶ See www.deutschegrammophon.com, “Catalogue.”

⁵⁷ See www.naxos.com, “About Naxos.”

⁵⁸ As its Web site states, “Costs are kept to a minimum by focusing on the music rather than on the artist - money is not wasted on expensive artist promotions, and profits are invested into recordings of new music rather than multiple versions of standard repertoire already in the catalogue.” *Id.*

⁵⁹ For descriptions of these various categories of music and their origins, see <http://phobos.plato.nl/e-primer/intro.htm> and its various pages; <http://www.othermusic.com>, which is the Web site of Other Music, a music store in New York City; and www.ishkur.com/music which has detailed subgenre trees that show how the different individual forms of each subgenre evolved from and became the basis for new subgenres. The “electronica” category at <http://www.allmusic.com> contains no fewer than 29 sublistings. (In the credits at www.ishkur.com, Ishkur’s creator strongly advocates that allmusic.com call this category electronic music, not electronica.)

⁶⁰ Dan Daley, *Andy East*, MIX (Dec. 2002) at P.13.

⁶¹ In addition to people who buy music in particular genres, people in the recording industry pay attention to label names. An artist may seek to sign with a particular label because of its reputation for promoting its artists, or because it is known to have generous contract riders; an artist may leave a label because of a bad experience that is subsequently publicized and affects that label’s image with prospective artists. For example, Aimee Mann bought out her recording contract with Interscope after it deemed one of her recordings unfit for release, after experiencing a series of problems including lack of promotion and

mismanagement by the label. See David Simmons, *Success On Her Own Terms: Aimee Mann Leaves Her Label and Gets the Last Laugh*, in ONSTAGE (July 1, 2001) (available at http://onstagemag.com/ar/performance_success_own_terms/). This kind of recognition is not likely to be persuasive in a lawsuit for infringement of a record-label name, however, since the “end-user” buyers of sound recordings are not music professionals.

⁶² The writer thanks Mariah Warnock-Graham for providing this perspective and the information about these labels.

⁶³ Joan Anderman, *The Pride of Omaha Nebraska is the New Home of Indie Rock, and Its Bands are there to stay*, THE BOSTON GLOBE (May 10, 2002) at C14. See also, Paul Maldonado, Jr., *The Shins Hope to Create a Little History with Release of New CD*, THE ALBUQUERQUE TRIBUNE (June 29, 2001) at C7 (calling SubPop, “the indie label from Seattle whose name lends a cache all its own”). See also, David Belcher, *The Weird and Wonderful*, THE HERALD (GLASGOW) (Jan. 15, 1999) at 17 (interviewing well-known electronica act Moloko, whose singer, Roisin Murphy, says that as a youth she bought “everything on the SubPop label”).

⁶⁴ See www.classic.motown.com.

⁶⁵ Sunenblick at 616.