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ORIGINAL
FILED

OCT 15 1990

RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

5 Attorneys for Plaintiff
CARLOS SANTANA
6

7 UNITED STATES DISTRICT COURT

8
9 FOR THE NORTHERN DISTRICT OF CALIFORNIA

10 C 90 2926 JPV ENE
11 CARLOS SANTANA,)
12 Plaintiff,)
13) Case No. _____

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COMPLAINT FOR VIOLATION OF THE
LANHAM ACT (FALSE DESIGNATION
OF ORIGIN; FALSE ENDORSEMENT);
INFRINGEMENT OF RIGHT OF
PUBLICITY; UNFAIR COMPETITION;
VIOLATION OF STATUTE;
INJUNCTIVE RELIEF AND DAMAGES

JURY TRIAL DEMANDED

Plaintiff CARLOS SANTANA alleges as follows:

JURISDICTION AND VENUE

1. This action is brought under the Lanham Trademark Act of 1946 ("Lanham Act") 15 U.S.C. § 1051 et seq., the diversity jurisdiction of the court and/or state statutory and common law.
2. Jurisdiction is conferred by 15 U.S.C. § 1121 and 1125(a), 28 U.S.C. § 1332(a)(1), and by the principles of ancillary and pendent jurisdiction.

1 ratified, endorsed, sponsored and approved the acts of the other
2 defendant.

3 FACTS COMMON TO ALL CLAIMS

4 8. CARLOS SANTANA has been recognized by the public at
5 large for many years as a preeminent guitarist and leader of the
6 musical ensemble performing popular music under the name
7 SANTANA. He first achieved fame with his performance at the
8 legendary WOODSTOCK FESTIVAL in New York State in 1969 and has
9 continued to receive respect and renown nationally and
10 internationally in the popular music field.

11 9. SANTANA has recorded and sold to the public in excess
12 of twenty million record albums and has achieved overwhelming
13 popular and critical success. He has invested his professional
14 talents in developing his career in the music industry and his
15 musical guitar style has achieved an internationally marketable
16 status. Recognition of SANTANA's unique talent and success is
17 reflected in the many awards he has received, including, among
18 others, a "GRAMMY" by the National Academy of the Recording Arts
19 and Sciences (NARAS) in 1989 for "Best Rock Instrumental
20 Performance"; "Musician of the Year" for 1988 at the Bay Area
21 Music Awards (BAMMIES); "Best Group" at the 1980 Bay Area Music
22 Awards (BAMMIES); the first CBS Records International "Crystal
23 Globe Award" in 1978, in recognition of over 10 million in
24 international sales of his albums; 1975 "Latin Rock Band of the
25 Year" by Latin New York Music Awards; and, 15 "gold" and
26 "platinum" album awards from the Recording Industry Association

1 of America (RIAA), recognizing sales of 26 band and solo albums
2 of his music in excess of 500,000 copies and 1,000,000 copies,
3 respectively; and, approximately 75 "gold" and "platinum" album
4 awards for international sales.

5 10. From time to time SANTANA has benefitted from the
6 value of his recognizable personality and musical sound by
7 appearing in commercials and endorsing products.

8 11. During 1990, BACKER was employed by MILLER to conduct
9 a national advertising campaign for "Miller Lite Beer." For the
10 purposes of advertising, selling and soliciting purchases of
11 MILLER's products, including "Miller Lite Beer," BACKER caused
12 to be created and produced a television commercial advertising
13 said product. The television commercial ("the commercial")
14 utilized the song "Black Magic Woman" featuring a guitar
15 instrumental imitating SANTANA.

16 12. The song "Black Magic Woman" was popularized for the
17 first time in 1970 by SANTANA on his internationally successful
18 record album "ABRAXAS," released and distributed by CBS Records,
19 which received the Best Rock Album award from CBS Records.
20 SANTANA's rendition of the song appeared on subsequently
21 released albums including "GREATEST HITS" in 1974, "LOTUS" in
22 1975, "MOONFLOWER" in 1977, a European release entitled "BLACK
23 MAGIC WOMAN" in 1986, "VIVA SANTANA" in 1988, and in the "VIVA
24 SANTANA" video in 1988. The rendition by SANTANA of "Black
25 Magic Woman" has become such a continuing popular musical
26 success that the public identifies the song as SANTANA's theme

1 song and SANTANA's distinctive musical guitar expression in the
2 song as the musical "signature" of SANTANA. The song was again
3 released to the public by SANTANA in 1988 on his album entitled
4 "VIVA SANTANA," through CBS Records, and has been performed live
5 on multiple occasions by SANTANA during national and
6 international tours before live audiences numbering hundreds of
7 thousands of persons.

8 13. The rendering of "Black Magic Woman" in the commercial
9 by defendants was intended to mimic the guitar sound and
10 performance of SANTANA and SANTANA's musical signature.
11 Imitation of this nature is commonly referred to in the music
12 industry as a "sound alike."

13 14. Defendants did not request SANTANA's permission, nor
14 did they obtain SANTANA's consent, to use a "sound alike" of the
15 sound and style of his guitar playing in the commercial or for
16 any other purpose.

17 15. Defendants knowingly used this television commercial
18 with the imitation of SANTANA's distinctive guitar playing
19 therein, for the purpose of advertising, selling, and soliciting
20 purchases for "Miller Lite Beer." Between November, 1989, and
21 May, 1990, Defendants aired the commercial numerous times on
22 national and local television programs during so-called prime
23 time hours.

24 16. SANTANA had a business relationship with defendant
25 MILLER during which MILLER learned the commercial value of
26 associating its name and product with SANTANA when, in 1987 and

1 1988, MILLER sponsored concert tours of SANTANA in the states of
2 Texas and New Mexico.

3 FIRST CLAIM

4 (Infringement of Right of Publicity
5 - California Common Law)

6 17. Plaintiff repeats and realleges each and every
7 allegation in paragraphs 1 through 16 hereof as though fully set
8 forth herein.

9 18. By reason of SANTANA's lifetime efforts to build
10 public recognition for his unique style of guitar playing, he
11 has developed a proprietary interest in his public personality
12 and, in particular, in his musical sound, which is the most
13 significant attribute of his identity.

14 19. Before the acts of defendants complained of herein,
15 SANTANA enjoyed his common law right of publicity to exploit his
16 proprietary interest in his musical sound. Defendants' "sound
17 alike" in the commercial is a deliberate imitation of SANTANA's
18 internationally recognized distinctive sound and identity, used
19 to profit MILLER in selling "Miller Lite Beer," and appropriates
20 SANTANA's property right in his distinctive sound in violation
21 of his right of publicity.

22 20. By reason of defendants' infringement of SANTANA's
23 right of publicity, defendants have caused and are continuing
24 to cause damage to SANTANA in a sum exceeding \$50,000 (fifty
25 thousand dollars).

26 21. By reason of defendant's infringement of SANTANA's

1 right of publicity, defendants, and each of them, have realized
2 substantial profits and other benefits which rightfully belong
3 to SANTANA.

4 22. Defendants have acted with oppression, fraud and
5 malice, in that they have sought to enrich themselves unjustly
6 and at the expense of the rights of SANTANA. Accordingly,
7 SANTANA is entitled to an award of exemplary and punitive
8 damages.

9 SECOND CLAIM

10 (False Endorsement; False Designation of Origin -
11 Violation of Section 43(a) of the
12 Lanham Act, 15 U.S.C. § 1125)

13 23. Plaintiff repeats and realleges each and every
14 allegation set forth in paragraphs 1 through 16 as if fully set
15 forth herein.

16 24. This claim arises under § 43(a) of the Lanham Act
17 entitled "False Designation of Origin and False Descriptions
18 Forbidden," 15 U.S.C. § 1125(a). Defendants' actions constitute
19 false designation of origin and false representation in
20 commerce.

21 25. Defendant's television commercial utilizing the
22 SANTANA "sound alike" has been aired repeatedly during 1990 on
23 national television broadcasts.

24 26. When a performing artist of SANTANA's stature, who
25 enjoys world-wide public recognition of his distinctive musical
26 sound, appears, is heard, or is closely imitated in an
advertisement, his real or apparent presence or his distinct

1 sound is likely to be interpreted by the general public as an
2 endorsement of the product being advertised. Defendants'
3 utilization of a deliberate imitation of SANTANA's guitar sound
4 to mimic SANTANA's rendition of "Black Magic Woman" violates
5 section 43(a) by creating a likelihood of consumer confusion
6 over whether SANTANA has endorsed or is otherwise associated
7 with "Miller Lite Beer," or other products of MILLER.

8 27. Defendants did not solicit nor was either defendant
9 granted permission by SANTANA to imitate SANTANA's sound and to
10 falsely suggest to consumers by the commercial that SANTANA was
11 endorsing MILLER's products.

12 28. Defendants have made no attempt in the commercial to
13 dispel the deliberately false implication of SANTANA's
14 endorsement or participation either by a disclaimer, the
15 rendering of the musical performance, or the accompanying
16 dialogue or on-screen text.

17 29. By reason of defendants' false implied representation
18 that SANTANA participated in the "sound alike" commercial and
19 authorized or approved defendant MILLER's product, defendants
20 have created consumer confusion, in violation of §43(a) of the
21 Lanham Act and in disregard of SANTANA's rights.

22 30. Defendants have acted with willfulness, fraud and
23 malice, and SANTANA is entitled to an award of treble damages,
24 and his reasonable attorneys' fees in bringing this action.

25 //

26

1 Magic Woman" is intended to pass off the "sound alike" as if it
2 were SANTANA's actual performance, thus creating public
3 confusion.

4 37. Defendants' conduct constitutes unfair competition as
5 defined in California Business and Professions Code § 17200 and
6 may be enjoined under § 17203 thereof because that illegal
7 conduct directly competes with SANTANA's right to perform or
8 otherwise participate in and profit from television commercials
9 and endorsements, resulting in damages to SANTANA in excess of
10 \$50,000. Defendants have also realized substantial profits and
11 other benefits from such unfair competition, which rightfully
12 belong to SANTANA.

13 38. Defendants have acted with oppression, fraud and
14 malice, in that they have sought to enrich themselves unjustly
15 and at the expense of the rights of SANTANA. SANTANA is
16 therefore entitled to an award of exemplary and punitive damages
17 as well as his attorneys' fees in bringing this action.

18 FIFTH CLAIM

19 (Claim for Injunctive Relief)

20 39. Plaintiff repeats and realleges each and every
21 allegation in Paragraphs 1 through 16 as though fully set forth
22 herein.

23 40. Unless and until Defendants' wrongful conduct is
24 enjoined and restrained by Order of this Court, defendants'
25 actions will cause great and irreparable injury to SANTANA in
26 that defendants will continue to infringe on SANTANA's right of

1 publicity, confuse consumers, appropriate SANTANA's identity,
2 and unfairly compete with SANTANA.

3 41. It is impossible to ascertain the amount of
4 compensation which will afford SANTANA adequate relief for the
5 threatened and contemplated unlawful activities of defendants.
6 SANTANA's legal remedies are not adequate to compensate him in
7 the event such unlawful activities continue to occur.

8 WHEREFORE, plaintiff SANTANA respectfully prays for
9 judgment against the defendants, and each of them, as follows:

10 1. That defendants, their agents, servants, employees and
11 all persons acting under their control or license be enjoined
12 and restrained pendente lite, and perpetually thereafter, from
13 reproducing, distributing, performing, telecasting, using or
14 authorizing the use of a "sound alike" to imitate the
15 distinctive guitar sound and performance of SANTANA of "Black
16 Magic Woman" or any other tune associated with him;

17 2. That defendants be ordered to account and pay over to
18 SANTANA all the gain, profits and advantages derived or realized
19 by defendants from their violation of the rights set forth
20 herein;

21 3. That defendants, and each of them, be ordered to pay
22 to SANTANA damages in a sum exceeding \$50,000 (fifty thousand
23 dollars) sustained by SANTANA in consequence of defendants'
24 wrongful acts, together with punitive and exemplary damages in
25 an amount to be fixed by the court;

26

1 4. That SANTANA receive his costs of suit herein,
2 including reasonable attorneys' fees; and

3 5. That the court grant such other and further relief as
4 it may deem just and proper.

5 DATED: October 15, 1990

6 GOLDSTEIN & PHILLIPS,
7 A Professional Corporation

8 **DAVID C. PHILLIPS**

9 By

10 DAVID C. PHILLIPS
11 Attorneys for Plaintiff
12 CARLOS SANTANA

13 DEMAND FOR JURY TRIAL

14 Pursuant to Local Rule 200-4 of the Northern District of
15 California and Fed.R.Civ.P. 38, plaintiff demands a jury trial
16 of this action.

17 DATED: October 15, 1990

18 GOLDSTEIN & PHILLIPS,
19 A Professional Corporation

20 **DAVID C. PHILLIPS**

21 By

22 DAVID C. PHILLIPS
23 Attorneys for Plaintiff
24 CARLOS SANTANA

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26
KSC/SANTANA/P01.COM

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COMPLAINT FOR VIOLATION OF
THE LANHAM ACT, ETC.

United States District Court

NORTHERN

DISTRICT OF

CALIFORNIA

CARLOS SANTANA,

Plaintiff,

v.

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SUMMONS IN A CIVIL ACTION

2926
CASE NUMBER:

JPV

ENE

MILLER BREWING COMPANY, a
Wisconsin corporation, and
BACKER SPIELVOGEL BATES, INC.,
a New York corporation,

Defendants.

NOTICE OF RIGHT TO
CONSULTATION BY A MAGISTRATE
ATTACHED TO ALL SUMMONS COPIES

TO: (Name and Address of Defendant)

MILLER BREWING COMPANY
3939 West Highland Boulevard
Milwaukee, WI 53201-0482

BACKER SPIELVOGEL BATES, INC.
405 Lexington Avenue
New York, NY 10174

YOU ARE HEREBY SUMMONED and required to file with the Clerk of this Court and serve upon

PLAINTIFF'S ATTORNEY (name and address)

DAVID C. PHILLIPS
SUSAN RABIN
GOLDSTEIN & PHILLIPS
One Embarcadero Center, Eighth Floor
San Francisco, CA 94111

an answer to the complaint which is herewith served upon you, within 20 days after service of
this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken
against you for the relief demanded in the complaint.

RICHARD W. WIEKING

CLERK

OCT 15 1990

DATE

MARIE C. ARIAS

BY DEPUTY CLERK