

UNITED STATES DISTRICT COURT

MIDDLE DISTRICT OF FLORIDA

ORLANDO DIVISION

---

DOOBIE BROTHERS CORPORATION, Plaintiff,

-vs-

PAUL CURCIO, et al., Defendants.

---

Case No. 99-1071-Civ-Orl-22A

ORDER

This cause comes before the Court On Plaintiffs Motion for Order to Show Cause and for Emergency Show Cause Hearing as to Why Defendant Paul Curcio, Autumn Management, Inc., Cornelius Bumpus and Chat McCracken, Should Not be Held in Contempt for Violating Preliminary Injunction (Doc. 52).

On August 25, 1999, this Court issued a Preliminary Injunction (Doc. 17) enjoining Defendants "and their officers, agents, employees, servants, attorneys, and all persons in active concert or participation with them who receive actual notice of this order by personal service or otherwise," from "advertising, promoting, or referring to the musical performance group composed of Cornelius Bumpus, Chet McCracken and David Shogren as 'Original Doobie Brothers,' 'Doobie Brothers,' 'Doobies' or any confusingly similar variation, in connection with any performances of the group.

Plaintiff, Doobie Brothers Corporation, filed the instant motion on October 20, 2000. A hearing on the motion was held on November 20, 2000. Plaintiff alleges that after the preliminary injunction was issued, Defendants scheduled, promoted, and performed at least six concerts billing themselves as "SMB/DOOBIE BROTHERS," "DOOBIE BROTHERS - SMB," and "former DOOBIE BROTHERS." Defendants

respond: (1) that they have not set out to flagrantly disobey the Court's order; (2) that under the fair use provision of the Lanham Act, it is permissible for them to use "Former Doobie Brothers" to describe the professional services of the group comprised of McCracken and Bumpus; (3) that it is common practice for tribute bands to use the original group's name in their own name; and (4) that it is impossible for them to police the way that third parties promote the group in local markets. The Court finds each of these arguments unpersuasive for the reasons set forth below.

First, Defendants contend that there is no evidence that they failed to comply with the preliminary injunction. Plaintiff presented evidence that Defendants violated the Court's order not to use any "confusingly similar variation" of the name "Doobie Brothers." The names "SMB/DOOBIE BROTHERS," and "DOOBIE BROTHERS SMB" are confusingly similar. They do not merely suggest that the group is comprised of former members of the Doobie Brothers. Counsel for Defendants argued at the hearing that the group never promoted itself as either of these names and that third parties were solely responsible for the use of these names. Even if this is true, the Court finds that Defendants violated the preliminary injunction by promoting the group as the "Former Doobie Brothers."

In its prior order, the Court stated that the group comprised of Shogren, McCracken, and Bumpus could not refer to themselves as "Doobie Brothers," but could "refer to the fact that they are former Doobie Brothers" (Doc. 17 at Paragraph 1). The Defendants apparently took this to mean that they could call the group "Former Doobie Brothers." The Court finds this to be an unwarranted reading of the order. The stated language allows Shogren, McCracken, and Bumpus to mention, in advertisements and other promotional materials, that they were former members of the Doobie Brothers, it does not, however, mean that they can call themselves the "Former Doobie Brothers."

In order to prevent any further claims of confusion, the Court instructs the Defendants that any reference to the fact that the group consists of one or more former members of the Doobie Brothers may not be used in the name of the group. Any such reference shall be made below the name of the group in the same font, and of a size no more than threequarters the size of that used for the name of the group.

Defendants also argue that the use of the name "Former Doobie Brothers" is permissible under the fair use provision of the Lanham Act because it merely describes group's professional services. The fair use provision states that a party asserting a defense to trademark infringement can defeat the plaintiff's claim by showing "that the use of the name, term, or device charged to be an infringement is a use... of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin." It is, therefore, irrelevant how the defendant uses the mark; the key issue is how the plaintiff uses the mark. Accordingly, a defendant must show that the mark functions merely as a descriptive term. See *Robert B. Vance & Associates, Inc. v. Baronet Corporation*, 487 F. Supp. 790 (N. D. Ga. 1979). Under this analysis, Defendants can assert the fair use defense only if they can show that the mark "Doobie Brothers" is a descriptive term. A mark which is descriptive "conveys a clear idea of the characteristics or qualities of the goods." *Id.* at 797. Nothing about the name "Doobie Brothers" gives any indication of the characteristics or qualities of the product being offered. Thus, "Doobie Brothers" is not a descriptive term, and the fair use provision does not provide Defendants an affirmative defense to their use of the name "Former Doobie Brothers."

Defendants also maintain that the use of the name "Former Doobie Brothers" is permissible because Shogren, McCracken, and Bumpus performed as a tribute band playing the greatest hits of the Doobie Brothers. In their memorandum of law, Defendants offer examples of names used by various tribute bands as support for their contention that it is common for tribute bands to utilize a "derivation of the name of the original group (or of the name of a popular song of the original group) as a means of advertising the fact that they perform the 'hits' of the original group in concert" (Doc. 57 at Paragraph 17). A look at this, however, makes it clear that the name "Former Doobie Brothers," does not distinguish the group as a tribute band. No one would confuse "The Rolling Clones" with "The Rolling Stones," or mistake "Dead On!" for "The Grateful Dead." Each of the tribute band names listed by Defendants is either creative or sufficiently altered to prevent the likelihood of fan confusion. Such is not the case here. There is nothing so creative about the name "Former Doobie Brothers," as to suggest that the group is a tribute band. Rather, the name suggests that the group is a reincarnation or reunion of the real Doobie Brothers. The likelihood of confusion is high, given the fact that the real

Doobie Brothers are still performing and recording under their original name.

Finally, Defendants argue that they should not be sanctioned for violating the preliminary injunction because they "have gone to great lengths to ensure compliance with the Court's Order" and to "ensure that third-party concert promoters and purchasers of the services of 'SMB' have acted in compliance with the Court's Order." (Dec. 57 at Paragraph 23). As support for these assertions, Defendants have attached copies of their contracts with various promoters and venues. Defendants point specifically to a notice which stated that if the requirements of the group's contracts or riders were not fulfilled, the group would not perform. The implication is that Defendants used this notice to ensure compliance with the Court's order. The Court finds it significant, however, that in spite of the notice, the group did perform at each of the concerts in question, even though they knew that there had been problems with the promotional materials for the band in some local markets. This suggests that Defendants did not do everything in their power to ensure compliance with the Court's order. Consequently, Defendants cannot avoid liability for violating the order when they were in the best position to ensure compliance with it. In order to prevent third parties from violating the injunction in the future, Defendants shall attach a copy of both the original preliminary injunction and this order to all of its future contracts with booking agents, talent buyers, and venues.

Having determined that Defendants violated the preliminary injunction, the Court must consider whether to impose sanctions. Civil contempt sanctions may be coercive or compensatory, but should not be punitive in nature. See *Rickard v. Auto Publisher, Inc.*, 735 F.2d 450 (11th Cir. 1984). In a trademark infringement case, a court may use the remedies provided in section 35 of the Lanham Act to fashion the appropriate amount of relief for violating an injunction. *Howard Johnson Company Inc. v. Khimani*, 892 F.2d 1512 (11th Cir. 1990). Under section 35, a plaintiff may recover "(1) defendant's profits, (2) any damages sustained by the plaintiff and (3) the costs of the action." 15 U.S.C. Paragraph 1117(a). Here, Plaintiff has offered no accounting of the defendant's profits or any damages he has sustained; consequently, the Court will not award a compensatory sanction without proof that Plaintiff has actually suffered a loss. However, the Court deems it appropriate for Plaintiff to recover the costs, including

attorneys fees, of bringing this motion. Plaintiff's counsel are directed to file affidavits, billing records, or other supporting documents that will show the Court to determine a reasonable fee.

Future violations of this Court's order will not be taken lightly by the Court, and will result in an award of compensatory sanctions to the Plaintiff.

DONE and ORDERED in Orlando, Florida this 28th day of November, 2000.

Anne C. Conway

UNITED STATES DISTRICT JUDGE