

**UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
TAMPA DIVISION**

OUTLAWLESSNESS PRODUCTIONS,
INC., BAND OF OUTLAWS TOURING,
INC. and GUITAR ARMY PUBLISHING,
LLC,

Plaintiffs,

v.

CASE NO: 8:10-cv-24-T-26TBM

HENRY PAUL, MONTE YOHO, CHRIS
ANDERSON, BILLY CRAIN, RANDY
THREET, JOHN COLEMAN, JOHN
GELLMAN, BLACKHAWK, INC., HENRY
PAUL BAND and THE LAST OUTLAWS,
INC.,

Defendants.

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ORDER

THIS CAUSE comes before the Court on Plaintiffs' Motion for Partial Summary Judgment and memorandum of law (Dkt. 119) with statement of undisputed facts (Dkt. 124) and Defendants' response in opposition with exhibits (Dkt. 136) and statement of disputed facts (Dkt. 137). Also before the Court are Defendants' cross-motion for final summary judgment with supporting exhibits (Dkt. 121) and statement of undisputed facts

(Dkt. 122), and Plaintiffs' response in opposition with supporting exhibits (Dkts. 132 & 134) and statement of disputed facts (Dkt. 135).

Background Facts

Defendants Henry Paul ("Paul") and Monte Yoho, together with Hughie Thomasson ("Thomasson"), were three of the five "original" members of the "southern rock" band called the "Outlaws." The other original members were Billy Jones and Frank O'Keefe, both of whom have passed away. Through the years, the Outlaws band experienced many changes in members of the band, but in every instance, only Mr. Thomasson stayed continuously with the Outlaws band from its first initial successes in the 1970's. Paul played with the Outlaws band for a total of 13 years, Yoho played with the Outlaws band for a total of 12-13 years, but Mr. Thomasson had played with the Outlaws for a total of about 28 years.

By the early 1980s, Mr. Thomasson was the last of the original five members still playing with the Outlaws band. In 1985, Paul formed a partnership with Mr. Thomasson wherein he agreed to play with the Outlaws band again. Mr. Thomasson and Paul signed a Partnership Agreement which provided that profits of the Outlaws band would be split 62.5% to Mr. Thomasson and 37.5% to Defendant Paul ("the 1985 Partnership Agreement"). The 1985 Partnership Agreement further provided:

Should Paul decide to withdraw at the end of any calendar year ... it is agreed and understood that all rights to the name "The Outlaws" or any name similar thereto shall belong to and remain exclusively the property of Thomasson. Paul shall have no right to utilize the name "The Outlaws" or in any way to perform professionally as "The Outlaws" Band or to be

identified or to receive professional credit as a former member of “The Outlaws” without express written permission from Thomasson.

The Partnership Agreement further provided in the event of Paul’s termination:

In the event of such termination, Paul shall have no right at any time thereafter to use the name “The Outlaws” or to in any way identify himself as a former member of “The Outlaws” Band and all right, title and interest to said name shall remain in Thomasson.

(Dkt. 118, Ex. N.) In 1989, Mr. Thomasson asked Paul to leave the Outlaws band.

Pursuant to the terms of the 1985 Partnership Agreement, at the time of such termination, Paul had no further rights to use the Outlaws name, or even identify himself as a former member of “The Outlaws” Band, and he acknowledged that the name “The Outlaws” belonged exclusively to Mr. Thomasson.

In 2005, Mr. Thomasson, Paul and Yoho, and their old manager, Charlie Brusco, began discussions regarding putting together a 30th Anniversary Reunion Tour, featuring Mr. Thomasson, Paul, Yoho, and David Dix (who played with the Outlaws in the 1970s) as the surviving original members of the Outlaws band. Paul and Yoho signed one page agreements with Plaintiff Band of Outlaws Touring, Inc., (“Band of Outlaws (FL”), providing the terms of their employment. Both contracts specifically contained the clause that “[y]ou acknowledge that you have no ownership or other interest in the name “Outlaws.” Subsequently, Yoho apparently signed an additional agreement with a Tennessee corporation, which was also called Band of Outlaws Touring, Inc.. That second contract contained the same clause.

The Reunion Tour proceeded in 2005, but by the end of that year, Paul once again left the Outlaws band and was not replaced. The Outlaws continued to tour and began recording new songs for a new Outlaws album, to be called “Once an Outlaw.” Yoho, and Defendants Chris Anderson (“Anderson”), Randy Threet (“Threet”), Jon Coleman (“Coleman”), and Billy Crain (“Crain”) continued on as the Outlaws band until September 2007, when Mr. Thomasson died unexpectedly. The Defendants had executed an Outlaws Touring License Agreement (“License Agreement”), which permitted them to use the Outlaws name and trademark, and other trademarks, as part of touring as the “Outlaws.”

Claims and Allegations

This case arises out of Defendants Paul, Yoho, Anderson, Threet, Crain and Coleman (collectively “Licensee Defendants”) alleged unlawful use of the Outlaws name and trademark to perform live music as the Outlaws band and to sell Outlaws branded music and merchandise at live shows and through a website. Plaintiffs assert that the License Agreement was terminated by breach of Defendants and that Defendants’ actions infringe upon their trademark, trade dress, and copyright protections in violation of the Lanham Act, 15 U.S.C. § 1051, *et seq.*

More specifically, Plaintiffs Outlawlessness Productions, Inc. (“Outlawlessness”), a Florida corporation formed by Mr. Thomasson and his wife, Plaintiff Mary Thomasson, Plaintiff Band of Outlaws (FL), and Guitar Army Publishing LLC are proceeding on their Fifth Amended Complaint. They sue Defendants Paul, Yoho, Anderson, Crain,

Threet, and Coleman in their individual capacities and collectively doing business as Blackhawk Band, as well as Defendants John Gellman (“Gellman”), who worked as the webmaster for outlawsmusic.com and managed the band’s domain name and MySpace page, and The Last Outlaws, Inc., in the following 14 claims: breach of contract seeking specific performance against the Licensee Defendants (Count One); breach of contract seeking damages against the Licensee Defendants (Count Two); violations of Section 43(a) of the Lanham Act against Defendants Paul, Yoho, Anderson, Crain, Threet, Coleman, and Gellman (Counts Three and Four); violations of Section 43(c) of the Lanham Act - dilution by blurring - against Defendants Paul, Yoho, Anderson, Threet, and Coleman, doing business as the Blackhawk Band (Count Five); violations of Section 43(c) of the Lanham Act - dilution by tarnishing - against Defendants Paul, Yoho, Anderson, Threet, and Coleman, doing business as the Blackhawk Band (Count Six); violations of Section 43(a) of the Lanham Act against Defendant Last Outlaws (Count Seven); conversion - injunctive relief - against Defendants Yoho, Gellman, and Last Outlaws (Count Eight); conversion - damages - against Defendants Yoho, Gellman, and Last Outlaws (Count Nine); copyright infringement, 17 U.S.C. § 101, *et seq.*, against the Licensee Defendants (Count Ten); breach of the 1985 agreement seeking specific performance against Defendant Paul (Count Eleven); breach of the 2005 Paul Agreement seeking specific performance against Paul (Count Twelve); breach of the 2005 Yoho agreement seeking specific performance against Defendant Yoho (Count Thirteen); and violations of Section 43(a) of the Lanham Act against Defendants Paul, Yoho, Anderson,

Crain, Threet, and Coleman. Defendants argue that they rescinded the License Agreement, declaring it null and void, on grounds that Outlawlessness Productions did not own the trademarks being licensed under the License Agreement.

Plaintiffs seek entry of a partial summary judgment on Count Three of the Fifth Amended Complaint and dismissal of Defendants' counterclaims for rescission of the License Agreement; dismissal of Defendant The Last Outlaws, Inc.'s counterclaim for declaratory judgment; dismissal of Defendant Paul's first, second, third, fourth, and fifth affirmative defenses; dismissal of Defendants Yoho, Anderson, Threet, Crain, and Coleman's first, second, third, fourth, and fifth affirmative defenses; dismissal of Defendant Yoho's eighteenth affirmative defense; and dismissal of Defendant The Last Outlaws, Inc.'s first, second, third, and sixth affirmative defenses. Defendants, in turn, seek the entry of final summary judgment in their favor on grounds that Plaintiffs do not own any of the rights underlying the complaint's causes of action; there is no likelihood of confusion caused by The Last Outlaws's use of "Outlaws" in its corporate name and Licensee Defendants' use of the "Outlaws" Mark; the undisputed evidence shows the Licensee Defendants did not infringe the "full circle" copyright; and there is no record evidence supporting any of the alleged causes of action against Gellman.

Summary Judgment Standard

Summary judgment is appropriate where there is no genuine issue of material fact. Fed.R.Civ.P. 56(c). Where the record taken as a whole could not lead a rational trier of fact to find for the nonmoving party, there is no genuine issue for trial. Matsushita Elec.

Indus. Co. v. Zenith Radio Corp., 475 U.S. 574 (1986) (citation omitted). On a motion for summary judgment, the court must review the record, and all its inferences, in the light most favorable to the nonmoving party. United States v. Diebold, Inc., 369 U.S. 654, 655 (1962). Having done so, the Court finds that Defendants are entitled to the entry of final summary judgment in their favor and that Plaintiffs' motion for partial summary judgment is due to be denied as moot. Defendants' memoranda are thorough and well-reasoned and, therefore, portions will be adopted and incorporated in this Order.

Discussion

Plaintiffs' Alleged Rights to the "Outlaws" Marks

Plaintiffs concede that in order to prevail on a trademark infringement claim, they must show: (1) the mark is valid and legally protectable; (2) that Outlawlessness is the owner of the mark; and (3) Defendants' use of the mark to identify goods and/or services is likely to create confusion concerning the origin of the goods and services, citing Marshak v. Treadwell, 240 F.3d 184, 198 (3rd Cir. 2001). Outlawlessness' trademark rights claim rests entirely on the allegation that Hughie Thomasson assigned all of his rights to the Outlaws Mark and logo to Outlawlessness via an unwritten assignment. (See Dkt. 52, ¶ 25, pp. 7-8.) Mary Thomasson, the designated corporate representative for Outlawlessness, clarified Outlawlessness' position by asserting that the assignment took place in 1999. (Thomasson Depo., Dkt. 121, Ex. A, Vol. II, p. 335, lines 12-21; p. 336, line 23-p. 337, line 5.) Mrs. Thomasson claimed that at the latest, the assignment occurred at the same time the application to register "Outlaws" was filed with the Patent

& Trademark Office (June 26, 2000). (Thomasson Depo., Vol. II, p. 339, lines 8-15.)

However, as Defendants assert, Mrs. Thomasson's testimony regarding an assignment is inadmissible hearsay. She admitted under oath that she had no personal knowledge that the assignment even occurred, it only was what she "assumed would have been done" because Hughie Thomasson told her "that's what he was doing." (Thomasson Depo., Vol. II, p. 329, lines 11-15, 19-22, 23-p. 330, line 7.)

Mrs. Thomasson also testified that Mr. Thomasson told her that he told that the attorney who handled the assignment was Natalie Utrera. (Thomasson Depo., Vol, II, p. 334, lines 3-18; p. 340, lines 11-15.) This, too, is inadmissible hearsay inasmuch as Mrs. Thomasson admits that she was not present during any such discussion and did not hear Hughie talk to the attorney. (Thomasson Depo., Vol, II, p. 330, line 19 - p. 331, line 8.; p. 340, lines 23 - p. 341, line 2; Vol. III, p. 364, lines 9-14.) Moreover, the law firm supposedly directed to do the assignment from Mr. Thomasson to Outlawlessness has absolutely no record of such a request or of such an assignment. A subpoena was served on Ms. Utrera's law firm, Spiegel & Utrera, to produce all documents relating to any assignment of the "Outlaws" Mark to Outlawlessness. (Dkt. 121, Ex. B, Deposition of Spiegel & Utrera records custodian, Ex. 1, p. 7, lines 12-15.) The records custodian confirmed that the law firm had no documents whatsoever evidencing an assignment of the "Outlaws" Mark, Lone Outlaw Mark, or any mark bearing the word "Outlaws" to Outlawlessness. (Id. at p. 7, lines 16-24.) Contrary to Mrs. Thomasson's assertion during her deposition, the trademark application itself cannot constitute evidence of the

assignment by Mr. Thomasson inasmuch as he did not sign the application, but rather, Mrs. Thomasson did. (Thomasson Depo., Dkt. 121, Ex. A, Vol. II, p. 307, line 21 - p. 308, line 1; Ex. 32.)

Tennessee corporation, Band of Outlaws Touring, Inc. (hereinafter (“Band of Outlaws (TN)”), a now dissolved Tennessee corporation, was owned by Mr. Thomasson and was associated with the Outlaws Reunion Tour in 2005. The corporate records of Band of Outlaws (TN) shows that on July 22, 2005, Mr. Thomasson asserted that he, personally, owned the “Outlaws” mark. (See Dkt. 121, Ex. C.)¹ This assertion directly contradicts Plaintiffs’ allegation that he assigned those same rights to Outlawlessness six years earlier. Additionally, Mrs. Thomasson testified under oath that in 1999 and 2000 that it was Mr. Thomasson, personally, and not Outlawlessness, that sold merchandise bearing the “Outlaws” Mark. (Thomasson Depo, Vol. III, Dkt. 121, Ex. A, p. 409, line 16 - p. 410, line 5).

As Defendants assert, trademark law clearly holds that the assignment of a trademark must be accompanied by a transfer of the assets of the business or, at a minimum, the goodwill of the assignor. International Cosmetics Exch., Inc. v. Gapardis Health & Beauty, Inc., 303 F.3d 1242, 1246 (11th Cir. 2002) (holding that “it is well-settled law that ‘the transfer of a trademark or trade name without the attendant goodwill

¹ Defendant Yoho, the treasurer of Band of Outlaws Touring (TN) and a signatory on the Consent Action Taken in Lieu of Organizational Meeting (the “Consent Actions”), Exhibit C, attested to the veracity and accuracy of the exhibit. (See Yoho Declaration, Dkt. 121, Ex. C.)

of the business which it represents is, in general, an invalid “in gross” transfer of rights.”) “Good will” is defined as: [t]he favor which the management of a business wins from the public. The favorable consideration shown by the purchasing public to goods or services known to emanate from a particular source. Blacks’s Law Dictionary, 694 (6th ed. 1990). There is no evidence in this case that Mr. Thomasson transferred any assets or goodwill to Outlawlessness in conjunction with the alleged unwritten assignment of trademark rights. It is worth mentioning that at the time the alleged assignment occurred, Mr. Thomasson was not even performing or recording as the Outlaws, but was instead performing for another southern rock band called Lynyrd Skynyrd. (Thomasson Depo., Dkt. 121, Ex. A, Vol. I, p. 62, lines 16-18.)

Although Mrs. Thomasson testified that her husband “performed all the time” and he was “always the Outlaws when he played,” her testimony is inadmissible because she admitted to having no personal knowledge of him performing with the Outlaws from 1996 through 2005. She did not attend a single Outlaws concert during that period of time, could not identify a single venue where he played with the Outlaws from 1996 through 2005, did not know who he played with, could not testify whether he played as Outlaws, Outlawlessness, Lone Outlaw, or Alien Outlaw, could not testify as to what music he played, could not identify a single date on which he allegedly played with the Outlaws from 1996 through 2005, and did not know anyone who would know the answers to those questions. (Thomasson Depo., Dkt. 121, Ex. A, Vol. I, p. 62, lines 12-15, 19 - p.63, line 1; p. 63, lines 2-9; p. 209, line 18 - p. 210, line 17; p. 213, lines 15-16;

p. 216, lines 14-21; p. 217, lines 6-25; p. 219, lines 17-19; p. 219, line 21 - p. 221, line 10; p. 223, lines 3-14; Vol. II, p. 239, line 17 - p. 240, line 4; p. 241, lines 17-25; p. 242, lines 1-12; p. 326, lines 4-8.) Even though Mrs. Thomasson is the corporate representative for Outlawlessness, has been an officer and shareholder of the company since its incorporation in May, 1999, and produced over 9000 pages of documents in the litigation, she fails to produce a single document -- let alone a contract -- evidencing that Mr. Thomasson performed with the Outlaws band from 1996 until the time of the 30th anniversary reunion tour in 2005.

According to Ms. Thomasson, although the Outlaws band had a manager during the 1970s and 1980s, they did not have a manager during the 1990s because they were not touring. (Thomasson Depo., Vol. I, p. 212, line 22 - p. 213, line 7; p. 213, lines 9-14.) Mr. Thomasson did not put an Outlaws band together until 2005 for the 30th Reunion Tour. (Thomasson Depo., Vol. I, p. 207, lines 17-19; p. 207, line 24 - p. 208, line 30.) During this period, Mr. Thomasson instead performed as a member of the band known as "Lynyrd Skynyrd," starting 1996 and through 2005. (Thomasson Depo., Vol. II, p. 255, lines 8-12).

Although Mrs. Thomasson initially testified that the Outlaws band was inducted into the Florida Music Hall of Fame, and that a concert was played during the induction, Mrs. Thomasson's testimony is inadmissible because she has no personal knowledge about that event. She admitted that she did not attend the induction; she only knows there was a concert through Hughie; she did not know what songs were played; she did not

know who played with her husband other than the drummer for Lynyrd Skynyrd, Artimus Pyle; she does not know where in Tallahassee the concert was performed; she does not know if the concert was performed on a stage or if a backdrop was used; she does not know what Mr. Thomasson or anyone else was wearing at the concert; and other than the Outlaws Logo being a tattoo on Hughie's arm, she does not know how the Logo was used that day. (Thomasson Depo., Vol. III, p. 377, line 20 - p. 379, line 24; p. 379, lines 22 - 24.) Mrs. Thomasson also admitted that Mr. Thomasson appeared at the ceremony in between Lynyrd Skynyrd performances. (Thomasson Depo., Vol. V, p. 832, line 15 - p. 833, line 8.)

Mrs. Thomasson admits that she did not personally witness a live musical performance by any group of musicians performing as the Outlaws in 1996, 1997, 1998, 1999, 2000, 2001, 2002, 2003 or 2004. (Thomasson Depo., Vol. II, p. 247, line 6 - p. 248, line 10.) Further, although she initially testified that she had produced two contracts with venues showing Outlaws performances during this time period, she later admitted under oath she had not located such documents. (Thomasson Depo., Vol. II, p. 249, line 2.) Non-use of a mark for three consecutive years constitutes *prima facie* evidence of abandonment. Natural Answers, Inc. v. Smithkline Beecham Corp., 529 F.3d 1325, 1330 (11th Cir. 2008) (granting defendant's motion for summary judgment on trademark infringement, on the basis that the trademark owner had abandoned the mark because it had not undertaken actual and continuous use of the mark for more than three years).

Mrs. Thomasson testified that the Plaintiff corporations did not copyright any songs for Outlaws after the release of *So Low* in 1999. (Thomasson Depo., Dkt. 121, Ex. A, Vol. III, p. 569, lines 17-23). The only admissible record evidence reveals that *So Low* was a solo project by Mr. Thomasson and was not recorded by the Outlaws. (Dkt. 121, Exs. D & E.) Instead, the Outlawlessness trademark is featured. (Id.) Although Mrs. Thomasson asserted that Mr. Thomasson made taped recordings, she did not witness any taping sessions where he played with other musicians, she did not produce any of his tapes in the litigation, and the tapes are not dated. (Thomasson Depo., Vol. IV, p. 633, lines 1-4; lines 7-8; p. 635, lines 12-15.)

Mrs. Thomasson also admitted she did not know whether Outlawlessness ever used the Outlaws Mark in connection with the sale of merchandise before Mr. Thomasson's death in 2007. (Thomasson Depo., Vol. V, p. 818, lines 5-8.) She did not know the basis for the \$2,900 in revenue reported on Outlawlessness' 2000 tax return, and with regard to the \$18,900 reported for the 2008 tax year, she did not remember and did not know what business activity Outlawlessness conducted in 2008. (Thomasson Depo., Vol. I, p. 66, line 9 - p. 67, line 14; p. 83, line 14 - p. 84, line 22.) She does not recall ever operating any company jointly with Mr. Thomasson that sold Outlaws merchandise. (Thomasson Depo., Vol. V, p. 835, lines 18-25.) Nor does she have any personal knowledge regarding licensing of Outlaws merchandise by either Mr. Thomasson or Outlawlessness from 1996 through 2004. (Thomasson Depo., Vol. V, p. 812, line 17 - p. 816, line 23.) She just assumed it was Band of Outlaws Touring (TN)

that licensed Outlaws merchandise or received royalties in 2005. (Thomasson Depo., Vol. V, p. 817, lines 5-16.)

As previously discussed, the record evidence shows that Mr. Thomasson asserted personal ownership rights to the “Outlaws” Mark in the Consent Action dated July 22, 2005. There are no allegations, let alone evidence, of an assignment or transfer of rights back to Mr. Thomasson. Further, there is no evidence that Mr. Thomasson assigned, licensed, or otherwise transferred his ownership rights to the “Outlaws” Mark to any of the Plaintiff corporations after July 22, 2005. The record does show that the now-dissolved Band of Outlaws Touring (TN) was the only corporate entity that used the “Outlaws” Mark in connection with live musical performances. (Thomasson Depo., Vol. V, p. 840, lines 10-14.) Band of Outlaws Touring (TN) was the touring group for the Outlaws musical band. (Thomasson Depo., Vol. III, p. 541, lines 9-14.) No other company engaged in live performances of the Outlaws in 2005. (Thomasson Depo., Vol. V, p. 841, lines 1-3.)

The 2008 Touring License Agreement

In the 2008 Touring License, the “Owner of the Mark,” as defined therein, did not obligate itself to transfer exclusive rights to the Mark to the Licensee Defendants. As Defendants point out, the License purports to transfer the “exclusive, worldwide right and license to use, market, and offer the Mark(s)”, but then expressly states that the Licensee Defendants “may not use in any way the Mark(s) *without the prior written consent* of the Owner.” (Dkt. 121, Ex. G, ¶ 11.1, p. 5.) In other words, Owner did not obligate itself in

the License to actually transfer exclusive rights to the Mark -- it retained the option to *not* transfer the exclusive rights. Because the Owner is not obligated under the License, there is no mutuality of obligation. The Court agrees with Defendants that the contract is illusory, not valid, and none of the parties are bound to the contract. Pan-Am Tobacco Corp. v. Dept. of Corrections, 471 So. 2d 4, 4 (Fla. 1984).

Although the 2008 Touring License purports to grant Outlawlessness the exclusive right to monitor the quality of Licensee Defendants' services, Mrs. Thomasson's testimony reveals that Outlawlessness never did so. After the 2008 Touring License was signed, Mrs. Thomasson did not go to a single Outlaws concert; she "had no say" in the quality of an Outlaws show; she "had no say in what was happening with the Outlaws," even though she granted them a trademark license; she "did not interject herself"; she did not tell the Outlaws band what to wear as Outlaws; did not tell them what songs to perform; did not tell them what type of promotion they could use; at the time she signed the License, did not have any creative control regarding the songs, what happened on stage, or any creative issues; and also did not know what music the Licensee Defendants played on stage. (Thomasson Depo., Dkt. 121, Ex. A, Vol. II, p. 264, lines 5-6; p. 267, lines 5-9; p. 271, line 25 - p. 272, line 1; p. 272, lines 2-3; p. 272, line 25-p. 273, line 2; p. 276, lines 5-7; Vol. V, p. 855, lines 14-24; p. 957, line 24 - p. 958, line 1.)

Mrs. Thomasson testified that her daughter, Constance Golder Cowez, went to one Outlaws concert in 2008 and the Outlaws concert in St. Petersburg, Florida, on October 9, 2010, as an Outlawlessness "representative" (Thomasson Depo., Vol. I, p. 266 lines 7-

12), but she added that it was *not* for quality control. Ms. Cowez testified that she did not know why she went other than she “just felt like [she] needed to.” (Cowez Depo. p. 126, Dkt. 121, Ex. H, line 25 - p. 127, line 3.) According to Mrs. Thomasson, the purpose of Mrs. Cowez attending the performances was to simply represent Mary Thomasson, the Outlaws, and the deceased Mr. Thomasson. (Thomasson Depo., Vol. II, p. 264, lines 13-18; p. 266, lines 16-19.) The 2008 Touring License expressly grants the exclusive right to use the Marks for “live performances featuring the Licensees.” (Dkt. 52, Ex. A, Section 2.) Because there is no evidence that Outlawlessness did anything to control or monitor the quality of the services provided in connection with the 2008 Touring License, the Court agrees that the 2008 Touring License is illusory and, thus, unenforceable. CNA Financial Corp. v. Brown, 922 F. Supp. 567, 574 (M.D. Fla. 1996).

The first to use a mark in commerce in connection with the provision of goods or services is generally the owner of the mark. J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §16:4 (4th ed. 2008). “The owner has the exclusive right to use a trademark as long as she continues to use it in connection with her goods and services.” Id. Mrs. Thomasson admits under oath that she set up Band of Outlaws Touring (FL) to be the touring company for the Outlaws -- not Outlawlessness. (Thomasson Depo., Vol I, p. 90, lines 4-9.) In contrast, Defendants, with the exception of Gellman, used the Outlaws” mark in connection with live musical performances when they performed as the Outlaws band starting in February, 2008. (Dkt. 121, Ex. I, Paul Depo., p. 117, lines 15-18.)

Plaintiffs' Alleged Trade Dress Rights

Plaintiffs raise a claim for violation of trade dress rights, but Mrs. Thomasson testified she is “not familiar” with the trade dress issue and that Mr. Thomasson never discussed trade dress of the Outlaws band. (Thomasson Depo., Vol. V, p. 920, lines 6-7.) In paragraph 20 of the Fifth Amended Complaint, Outlawlessness alleges the trade dress consists of:

- a. Use of the name “Outlaws,” as the musical group name, owned by Plaintiff Outlawlessness.
- b. Use of the Outlaws Logo, owned by Plaintiff Outlawlessness.
- c. Use of the Registered Service Mark, “Lone Outlaw,” owned by Plaintiff Outlawlessness.
- d. Use of the web domain, www.outlawsmusic.com, owned by Plaintiff Band of Outlaws.
- e. Performance of copyrighted songs originally written and produced by Hughie Thomasson, including “Green Grass and High Tides,” “Full Circle,” and other famous and well-known songs of Hughie Thomasson, copyrights of which are owned by Plaintiff Guitar Army.
- f. Presentation of musicians in western hats and clothing, and playing music known as the “Southern Rock” genre.

Mrs. Thomasson admitted there was no “special look, special clothing or makeup associated with the Outlaws band.” (Thomasson Depo., Dkt. 121, Ex. A, Vol. III, p. 386,

lines 6-11.) They did not have a “particular look” so that you would know it was the Outlaws on stage. (Thomasson Depo., Vol. III, p. 385, lines 3-6.) She testified that the only way one would know that a musical group was the Outlaws was by the logo and by the presence of her husband, Hughie Thomasson. (Thomasson Depo., Vol. III, p. 386, lines 12-16; p. 387, lines 19-23.) Obviously, with the death of Mr. Thomasson, whatever trade dress existed for the band died with him. The record evidence shows that the logo was not always displayed during an Outlaws concert. (Thomasson Depo., Vol. III, p. 395, lines 8-10; p. 399, lines 10-13.) Mrs. Thomasson admitted she did not know what years the Outlaws Logo was used as a backdrop for live musical performances. (Thomasson Depo., Vol. V, p. 853, lines 6-13.) Outlaws did not wear any special clothing, let alone western clothing. Mr. Thomasson performed wearing, at various times in his life, long sleeve cowboy shirt, long sleeve button down shirts, short-sleeve shirts, cut-off shirts, T-shirt, blue jean jacket, cut-off vest, and blue jeans. (Thomasson Depo., Vol. III, p. 393, lines 16-21; p. 395, lines 5-7; p. 396, line 2 - p. 397, line 4; p. 398, line 24- p. 399, line 9). To prove a trade dress claim under 15 U.S.C. § 1125(a), Plaintiffs must show: (1) the trade dress is inherently distinctive or has acquired distinctiveness through secondary meaning; (2) there is a likelihood that the public will be confused by the infringing use; and (3) the trade dress is non-functional. Stephen W. Boney, Inc. v. Boney Servs., 127 F.3d 821, 828 (9th Cir. 1997). In light of the totality of Mrs. Thomasson’s testimony above, Plaintiffs simply fail to meet their burden.

Plaintiffs as Alleged Successors-in-Interest to Property and Contract Rights

There is no evidence in the record to establish that Plaintiffs Outlawlessness or Band of Outlaws Touring (FL) inherited any ownership in: (a) the www.outlawsmusic.com domain name (the “domain”), (b) the MySpace page, the 1985 Partnership Agreement between Hughie Thomasson and Henry Paul, (c) the May 12, 2005 Letter Agreement between Band of Outlaws, LLC (TN) and Monte Yoho, or (d) the May 12, 2005 Letter Agreement between Band of Outlaws, LLC (TN) and Henry Paul. The 1985 Partnership Agreement expressly states it is for a one year calendar term, beginning June 1, 1985 -- there is no evidence in the record that it continued past that term. Mrs. Thomasson admitted under oath that she “did not know” who owns the rights to the 1985 Partnership Agreement. (Thomasson Depo., Vol. V, p. 921, lines 12-16.)

Outlawlessness’ assertion of rights to the May 12, 2005 Letter Agreements between Band of Outlaws, LLC (TN) and Yoho and Paul is similarly meritless. Outlawlessness alleges in the Complaint that it is the “successor in interest to all of Mr. Thomasson’s rights under the [May 12, 2005 Letter Agreements with Mr. Yoho and Mr. Paul].” (Dkt. 52, ¶ 151, p. 39; ¶ 159, p. 159, p. 41.) The Complaint expressly alleges that both Letter Agreements were “completed and terminated according to the terms thereof.” (Id. at ¶ 35, p. 11.) Both Letter Agreements memorialize that Yoho and Paul were employed by Band of Outlaws, LLC -- Tennessee for the “2005 calendar year.” (Dkt. 52, Exs. E-1 and E-2.) The record establishes that Band of Outlaws, LLC (TN) was

administratively dissolved on August 21, 2006 -- after the 2005 Letter Agreements expired. (Dkt. 52, Ex. F.)

Plaintiff Band of Outlaws Touring (FL) alleges that Mary Thomasson inherited all of Hughie Thomasson's right, title, and interest in Band of Outlaws Touring (TN), including the domain name, and that Ms. Thomasson, "by unwritten assignment transferred the domain name from her dissolved corporation, Band of Outlaws Tennessee, to Band of Outlaws [Touring (FL)]." (Dkt. 52, ¶¶ 26b-d.) It further alleges that it is the successor-in-interest to Band of Outlaws Touring (TN), and that the Tennessee company is its "predecessor in interest" with regard to the MySpace page. (Dkt. 52, ¶¶ 114, 116.) However, Mrs. Thomasson testified that she was not a shareholder in Band of Outlaws Touring (TN). (Thomasson Depo., Dkt. 121, Ex. A, Vol. IV, p. 600, lines 16-19.) Only Mr. Thomasson was a shareholder for that company. (Thomasson Depo., Vol. I, p. 100, lines 12-21.) Mrs. Thomasson was the sole shareholder of Band of Outlaws Touring (FL) when it was incorporated -- more than a year after Mr. Thomasson's death and more than 14 months after Band of Outlaws Touring (TN) was dissolved. It is not possible for the two entities to be deemed "related" companies without similarity of ownership and Mrs. Thomasson herself admitted under oath the Florida and Tennessee companies were "different corporations." (Thomasson Depo., Vol. IV, p. 759, lines 5-8.) Plaintiffs maintain that the alleged ownership in the two Tennessee companies, Band of Outlaws Touring (TN) and Band of Outlaws, LLC (TN), derived solely through probate. (Thomasson Depo., Vol. IV, p. 601, lines 4-7; Vol. IV, p. 680, lines 23-25). Mrs.

Thomasson testified that she “inherited” the domain name and MySpace page from Band of Outlaws Touring (TN), but inherited nothing from Band of Outlaws, LLC (TN) as that company “wasn’t really used.” (Thomasson Depo., Vol. V, p. 766, lines 18-21; p. 767, lines 9-10; p. 766, lines 18-21; p. 767, lines 9-10; p. 768, lines 2-5; p. 769, lines 3-8).

Mrs. Thomasson admitted in her deposition that she “never picked the company [Band of Outlaws Touring(TN)] up,” because there was no touring band. (Thomasson Depo., Vol. I, p. 100, lines 22-25.) As Defendants explain, Mrs. Thomasson never produced a share certificate for Band of Outlaws Touring (TN) in her name, never produced the books and records of Band of Outlaws Touring(TN) showing a transfer of ownership from Mr. Thomasson to Mrs. Thomasson, and never produced any documentary evidence whatsoever of a transfer of title to the share certificates.

The record shows that the rights to the Letter Agreements, the domain name, and the MySpace page dead-end in the probate of the Estate of Hughie Thomasson. Mr. Thomasson died in September 2007, in Hernando County, Florida. (Coweze Depo., Dkt. 121, Ex. H, p. 98, lines 19-21.) A probate was opened for him on October 19, 2007. (Coweze Depo., p. 31, lines 8-20.) Under Florida law, when a probate was opened for Mr. Thomasson, the personal representative, his daughter, Constance Golder Coweze, was able to take control of all his individually owned property to become assets of the estate. Fla. Stat. §§ 731.201(32); §733.604(1)(a); § 733.607; § 733.608(1); §733.612. Coweze, who is also a 49% shareholder and officer of all three Plaintiff corporations, was appointed personal representative for the Estate of Hughie Thomasson. (Coweze Depo., p. 32, lines

15-22.) In the Inventory dated April 14, 2008, which was filed with the probate court and which Cowez swore was accurate under penalty of perjury, the only corporate assets of Mr. Thomasson listed were “1000 shares of Band of Outlaws, Inc. stock” with an estimated fair market value of “\$5,000.00”, and “50 units in Guitar Army Publishing, LLC” with a fair market value of \$10.00.” (Dkt. 121, Ex. J.) Cowez confirmed the Inventory where she identified member shares and stock in only two business entities as Mr. Thomasson’s personal property. (Cowez Depo., Dkt. 121, Ex. H, p. 106, line 25-p. 107, line 18.)

The Final Accounting of Personal Representative Constance Cowez (the “Final Accounting”), also prepared under penalty of perjury, shows there was no transfer of any assets to Mrs. Thomasson during the period of September 9, 2007 through July 22, 2008. (Dkt. 121, Ex. K.) Ms. Cowez testified to the Final Accounting during her deposition, as well. (Cowez Depo., Dkt. 121, Ex. H, p. 72, lines 2-25.) As of the date the Final Accounting was signed by Mrs. Cowez, August 2, 2008, there were no assets in the estate. (Dkt. 121, Ex. K.) Band of Outlaws Touring (TN) was administratively dissolved 16 days later, on August 22, 2008. (Dkt. 121, Ex. L.) Although there is record evidence that Hughie Thomasson executed a will and that he and Mrs. Thomasson established a trust before Mr. Thomasson died, on November 1, 2006, there is no evidence that any of Mr. Thomasson’s assets went into the trust or otherwise passed through the will. (Dkt. 121, Ex. M.) Mrs. Thomasson stated in her deposition that the trust was never funded. (Thomasson Depo., Dkt. 121, Ex. A, Vol. I, p.102, lines 22-23; Vol. IV, p. 648, line 25 -

p. 649, line 8; p. 651, lines 21-24; p. 653, line 18.) She was also adamant that none of Mr. Thomasson's companies were put into the trust. (Thomasson Depo., Vol. I, p. 101, line 18- p. 102, line 6; p. 103, lines 20-25; Vol. IV, p. 651, lines 21-23.) Mrs. Thomasson testified that no one in the world knew more about the affairs of Outlawlessness and Band of Outlaws Touring (FL) than she did -- if she did not know the answer to a question about them, then no one else could. (Thomasson Depo., Vol. I, p. 149, lines 7-12; p. 151, lines 1-23.)

The Alleged Likelihood of Confusion

Trademark infringement is actionable under the Lanham Act only if there is a "likelihood of confusion" between a plaintiff's use of its mark in commerce in connection with the provision of its goods or services, and a defendant's use in commerce in connection with the provision of its goods or service. HBP, Inc. v. American Marine Holdings, Inc., 290 F.Supp.2d 1320, 1327 (M.D. Fla. 2003) (granting motion for summary judgment in favor of defendant in trademark infringement action where defendant's mark was used for goods not related to plaintiff's goods). If the plaintiff and defendant use the mark in connection with dissimilar goods or services, then there is no trademark infringement. Id. at 1333 (holding that "the use of similar marks does not constitute infringement if the products at issue are unrelated.")

The Licensee Defendants have not infringed Outlawlessness' "Outlaws" trademark, to the extent it exists. Mrs. Thomasson testified that Plaintiff Outlawlessness was a "recording company." (Dkt. 121, Ex. A, Thomasson Depo., Vol. I, p. 57, lines 5-

17; p. 66, lines 15-19.) It allegedly used the “Outlaws” Mark in connection with recorded music and it is not a touring company, as evidenced by the fact that Mrs. Thomasson set up Band of Outlaws Touring -- Florida to handle touring for an Outlaws band in November 2009. (Thomasson Depo., Vol. I, p. 90, lines 4-9.) That means it did not provide live musical performances through a band or otherwise. In contrast, there is no evidence to even suggest that the Licensee Defendants -- all individuals -- are a “recording company.” The evidence shows that the Licensee Defendants provide services in the nature of live musical performances. Live musical performances and recorded musical performances are two clearly distinct forms of musical entertainment. Thus, a likelihood of confusion does not exist between the parties’ respective use of the “Outlaws” Mark. Mrs. Thomasson even testified that Outlawlessness has not authorized any band to perform as the Outlaws since the end of 2009. (Thomasson Depo., Vol. II, p. 263, line 24 - p. 264, line 4.) Without Outlawlessness offering a band to the public known as the “Outlaws” and without evidence that the public associates the word mark or the logo with Outlawlessness, this Court cannot find any likelihood of confusion between the conduct of the Outlaws band members and any goods or services of Outlawlessness. There is also no likelihood of confusion between Defendant Last Outlaws’ use of “Outlaws” as part of its corporate name, and Outlawlessness’ use of “Outlaws” in connection with recording musical performances. There is no evidence that Last Outlaws ever used its corporate name in commerce in connection with any goods or services, let alone in connection with recording.

The Alleged Copyright Violation

Plaintiffs also raise a claim for copyright violation with respect to the song *Full Circle* and the corresponding music video being posted by Defendants on the outlawsmusic.com and henrypaulband.com websites. The evidence shows that, at all times when the song *Full Circle* was posted on the websites, it was done with the authorization and approval of Hughie Thomasson, the 50% shareholder of the alleged copyright holder, Plaintiff Guitar Army. Mrs. Thomasson admitted under oath that she had never accessed the domain before Mr. Thomasson died. (Thomasson Depo., Dkt. 121, Ex. A, Vol. III, p. 416, lines 2-4.) The evidence establishes that Mr. Thomasson approved streaming the *Full Circle* song on the domain. (Yoho Depo. Dkt. 121, Ex. N, p. 69, lines 12-23; p. 77, lines 12-13.) After Mr. Thomasson died, Yoho instructed the domain manager and webmaster, John Gellman to remove the *Full Circle* song. (Yoho Depo., p. 70, lines 2-23.) Mr. Yoho instructed Gellman to “pull everything down” from the domain after Mr. Thomasson’s death except for a flash of tribute. (Yoho Depo., p. 70, lines 17-23.) As such, there was no infringement of the *Full Circle* copyright.

The Complaint alleges only two causes of action against Gellman. In Counts Eight and Nine, Plaintiff, Band of Outlaws Touring (FL), asserts claims for conversion of the domain and MySpace page. (Dkt. 52, pp. 31-35, ¶¶ 111-130.) Band of Outlaws Touring (FL) alleges, essentially, that Gellman, together with Defendants Yoho and Last Outlaws changed the domain registration, they did not have Plaintiff’s authority to modify administrative access to the domain, and have operated the domain and MySpace for the

benefit of some or all of the Defendants, but to the exclusion of Plaintiff. (Dkt. 52, pp. 31-34, ¶¶ 115-117, 125-127.) However, Mrs. Thomasson testified she was “*merely guessing*” that Mr. Gellman had monitored the MySpace page. (Thomasson Depo., Dkt. 121, Ex. A, Vol. III, p. 544, lines 15-18.) Yoho testified that Gellman was not involved with the domain or MySpace page after November, 2007. (Yoho Depo., Dkt. 121, Ex. N, p. 113, lines 8-22.) Gellman testified that he resigned as the webmaster for the domain in the middle of October, 2007. (Gellman Depo., Dkt. 121, Ex. O, p. 29, lines 11-24.) He continued to shut down everything on the domain except for the store and home page until the middle of November, 2007. (Gellman Depo., p. 30, lines 9-20.) After he shut down the domain, Gellman had no further involvement with the domain. (Gellman Depo., p. 32, lines 10-13.) When Mr. Thomasson passed away, no one asked Gellman for the user name or the password for the domain. (Gellman Depo., p. 32, lines 19-22.) With regard to the MySpace page, Gellman set it up under the name “The Outlaws” and not Band of Outlaws Touring, Inc. (Gellman Depo., p. 49, lines 13-20). MySpace pages are not registered like domains, and to Gellman’s knowledge, the MySpace page is owned by Rupert Murdoch who owns MySpace. (Gellman Depo., p. 49, lines 21-23; p, 50, lines 11-17.)

ACCORDINGLY, it is **ORDERED AND ADJUDGED**:

Defendants’ cross-motion for final summary judgment (Dkt. 121) is **granted**.
Plaintiffs’ Motion for Partial Summary Judgment (Dkt. 119) is **denied as moot**. The

Clerk is directed to enter judgment in favor of Defendants, terminate any pending motions, and close this case.

DONE AND ORDERED at Tampa, Florida, on April 6, 2011.

s/Richard A. Lazzara

RICHARD A. LAZZARA
UNITED STATES DISTRICT JUDGE

Copies furnished to:
Counsel of Record