



Trimming Spalding's Green:

Why "Swing, Swing, Swing" Wasn't "The Way" To Go

By James B. Astrachan

(995 words)

Advertisers need to be clever people in order for their ads to stand out from the clutter. That's why advertisers are always looking for the ad that will stop a viewer in his or her tracks. Benetton does this with outrageous ads; Calvin Klein uses sex. Lately, Abercrombie has taken a page from Calvin's book. These advertisers are already exploring teen and pre-teen sexuality. Soon, this will be the clutter, forcing these advertisers to switch to different tactics.

Other advertisers use familiarity to capture the viewer's attention before the page is flipped or the channel switched. That's why advertisers pay king's ransoms to use well-known pitch persons to hawk their wares. Often, advertisers cross the line and use names, likenesses and music without permission, and just as often pay penalties far in excess of what they might have paid had they first sought a license. Frito Lay and its agency paid the singer Tom Waite over \$1 million for their infringing use of a "Waite-alike."

Advertisers also employ familiar products or writings that will capture attention. These uses often violate trademark laws because viewers believe there is an association between the product and the advertiser. The Rolex watch that appears in a cosmetic commercial; the Rolls Royce that is photographed in a booze ad.

Recently, a well-regarded federal appellate court dealt with another situation in which an advertiser, a golf club manufacturer, used a play on the title of a well-known Louis Prima/Benny Goodman song, "Sing, Sing, Sing (with a Swing)" in its ads.

Likely, the song was chosen, not for its play on words-ability, but because its familiarity caused it to be named one of the 100 most important musical works of the 20th century. Supposedly, this was a song whose syncopation and counterpoint as are recognizable as the opening four notes of Mr. Beethoven's Fifth Symphony. Well, perhaps to some.

The plaintiff asserted ownership of the song and the right to license its use and title for commercialization. Since the song was written, it has earned license fees of almost \$5 million from film and advertising licenses.

The agency was assigned to create an ad to sell Spalding's Top-Flite Tour Irons. The first ad created for Spalding's review featured three golfers hitting balls followed by a black screen with the words, "Swing, Swing, Swing" in white letters appearing for one second. The "Sing, Sing, Sing" music played behind the golfers.

Spalding thought the commercials above par, but its budget allowed it to either produce the commercial or license the music. Wanted to keep and eat its cake, it instructed its ad agency to create a final version of the ad that was essentially the same as the original version, although it deleted the "Sing, Sing, Sing" music in favor of stock, swing-style music, perhaps, evocative of the original music. It superimposed the words "Swing, Swing, Swing" on images of clubs and greens instead of a black screen.

Very clever, these agency folks. Did they think that these actions were legal, or if not, that no one related to the original song would ever view their ads? Well, ads are made to be seen and the best ones are. Frequently. This one was good and it soon came to the attention of the owner of the song, who sued Spalding and its ad agency for unfair competition.

This was an unfair competition, not a copyright infringement, action. The song's owner contended that the combination of evocative swing music and the words "Swing, Swing, Swing" would confuse listeners into associating the song and its title with Spalding's golf clubs. The ad agency said that it was fair for it to use the words "Swing, Swing, Swing" to describe the golfers shown hitting golf balls and doing so did not infringe the rights of the song's owner.

Maybe. Maybe not. The agency and its client tried to end the dispute by filing a summary judgment motion, but the court would not grant this motion.

The crux of the song owner's complaint is that the federal Lanham Act prohibits Spalding from using any words or devices that are likely to cause confusion as to endorsements, sponsorship or approval of goods. In other words, the song's owner contends that the public, on seeing this ad, would be likely to believe that the song owner and Spalding are somehow affiliated, perhaps through license.

To win, the song's owner needs to prove it had a valid trademark in the title of the song, "Sing, Sing, Sing". To do this, it has to establish that the title acquired secondary meaning, which means that consumers would associate the title of the song with the song. This is a question of fact.

The defendants raised a myriad of defenses, all to no avail at the summary judgment phase of this trial. Regardless of the eventual outcome, the cost will be high in money spent and agency-client relations strained.

This case is not a flash in the pan. Recently, in England, under their copyright laws, pop star Robbie Williams was found guilty of infringing a Woody Guthrie/Louden Wainwright composition by merely adopting the words, "especially when he goes around saying I am the way." No similar music, just two lines of lyrics.

Is there is a lesson to be learned from this? You bet. Agencies and clients should carefully question whether an attempt to attract consumer attention with familiarity creates actionable harm. Often it does because the attention getter belongs to someone else and using it is theft of property. A lawsuit is not the sort of attention the advertiser seeks.

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