

**Gailson v Greenberg**

2006 NY Slip Op 30565(U)

May 19, 2006

Supreme Court, New York County

Docket Number: 602478/04

Judge: Bernard J. Fried

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SUPREME COURT OF THE STATE OF NEW YORK — NEW YORK COUNTY

FBER

PRESENT: BERNARD J. FRIED  
Justice

PART 60

FBER

GALISON, William A  
PLAINTIFF

INDEX NO. #602478-2004

MOTION DATE \_\_\_\_\_

- v -

GREENBERG, ESQ, JEFFREY.

MOTION SEQ. NO. #007

MOTION CAL. NO. \_\_\_\_\_

DEFENDANT

The following papers, numbered 1 to \_\_\_\_\_ were read on this motion to/for \_\_\_\_\_

Notice of Motion/ Order to Show Cause — Affidavits — Exhibits ...

Answering Affidavits — Exhibits \_\_\_\_\_

Replying Affidavits \_\_\_\_\_

PAPERS NUMBERED


Cross-Motion:  Yes  No

Upon the foregoing papers, it is ordered that this motion

NYS SUPREME COURT  
REVIEWED  
MAY 22 2006  
E-FILING DEPT.

This motion is decided in accordance with the accompanying memorandum decision.

SO ORDERED

FILED  
MAY 22 2006  
COUNTY CLERK'S OFFICE  
NEW YORK

Dated: 5/19/06

B. J. Fried  
J.S.C. **BERNARD J. FRIED**  
J.S.C.

Check one:  FINAL DISPOSITION  NON-FINAL DISPOSITION

Check if appropriate:  DO NOT POST

MOTION/CASE IS RESPECTFULLY REFERRED TO JUSTICE FOR THE FOLLOWING REASON(S):

SUPREME COURT OF THE STATE OF NEW YORK  
COUNTY OF NEW YORK : IAS PART 60

**FBEM**

-----X  
WILLIAM A. GALISON,

Plaintiff,

Index No.  
602478/04

-against-

JEFFREY A. GREENBERG, ESQ., BELDOCK  
LEVINE & HOFFMAN LLP, MADELEINE PEYROUX  
AND ROUNDER RECORDS,

Defendants.  
-----X

**APPEARANCES:**

For Plaintiff:  
William A. Galison, *pro se*<sup>1</sup>

For Defendants:  
Frankfurt Kurnit Klein & Selz, P.C.  
488 Madison Ave.  
New York, NY 10022  
(212) 980-0120  
(Ronald C. Minkoff; Wendy Stryker)  
(Attorneys for Defendant Madeleine Peyroux)

**Fried, J.:**

Plaintiff William A. Galison (Galison) moves for an order (a) pursuant to CPLR 3211  
(a) (7), dismissing the second, third and fourth counterclaims of defendant Madeleine  
Peyroux (Peyroux); and (b) pursuant to CPLR 8303-a and 22 NYCRR 130.1-1, imposing

<sup>1</sup>

When this motion was filed plaintiff was represented by counsel. It was originally  
before Justice Cahn, who recused himself from this action. The parties have agreed that this  
motion may be decided by me upon submission.

**FILED**  
MAY 22 2006  
COUNTY CLERK'S OFFICE  
NEW YORK

sanctions against both Peyroux and her counsel for having asserted frivolous claims against him.

Galison describes this action as arising out of defendants' tortious interference with his legitimate efforts to sell a musical recording, their defamation against him, and their trade libel against his business. Peyroux served an answer containing six counterclaims. In the instant motion, Galison argues that three of the six counterclaims are defective as a matter of law and should be dismissed. He maintains that one of the counterclaims is frivolous and serves as the basis for his application for sanctions. Galison seeks dismissal of the second, third and fourth counterclaims, which sound in deceptive trade practice and false advertising under state law, trademark infringement and unfair competition under state law, and violation of right of privacy and publicity, respectively. The three counterclaims that Galison does not seek to dismiss seek an accounting, and allege breach of contract and unjust enrichment.

Galison and Peyroux are both professional recording artists. They formerly had a personal and professional relationship, both of which have ended. Peyroux states that, in or about February 2003, they began recording seven demonstration tracks that included music and lyrics originally written by Peyroux, with additional lyrics added later by Galison. The seven tracks were compiled on a CD entitled "Got You on My Mind" (the Seven-Track Album).

Peyroux asserts that, around this time, Galison knew that she was in negotiations with various record companies interested in recording and releasing her second full-length studio album. According to Peyroux, she and Galison therefore agreed that the Seven-Track Album would be made available for sale only at their live appearances, and that such sales took

place beginning in April 2003. She asserts that they also agreed that they would share the profits from sales of the Seven-Track Album equally after deductions for costs and recoupment of their respective investments. In April 2003, Peyroux entered into an exclusive agreement with Rounder Records (Rounder).

Peyroux states that she ended both her personal and professional relationships with Galison by late July 2003. She asserts that, in the fall of 2003, Galison packaged the Seven-Track Album, along with four additional works of his own, to create a new album (the Eleven-Track Album), without Peyroux's consent.

She states that Galison then knowingly published, promoted, distributed and sold the Eleven-Track Album, using her name and likeness on the cover without her consent. She states that the Eleven-Track Album features a cover illustration of two figures that resemble Galison and Peyroux. Peyroux asserts that Galison also used her name and image on his website to advertise the Eleven-Track Album, and that his website includes a hyperlink to Rounder's official Peyroux website. Peyroux states that Galison also used her name and image in other advertising for the Eleven-Track Album.

Peyroux argues that Galison's use of her name and image on the Eleven-Track Album, on the website and in other advertising falsely implies that she authorized him to release and sell the Eleven-Track album and to use her name and image in connection therewith. She further maintains that his use of her name and image implies that she appears on all of the tracks of the album, that she consented to being associated with an album containing additional tracks, that she endorses the album, and that she has been compensated for her contribution to the album. She argues that none of these implications is true.

Peyroux states that her attorney contacted Galison, objecting to his commercial exploitation of the Eleven-Track Album without her consent, and seeking to resolve the issues between them.

In 2004, Galison commenced a lawsuit against Peyroux and her attorneys in federal court. Galison v Greenberg, US Dist Ct, SD NY, Stanton, J., 04 Civ 2629 (LLS) (the Federal Action). In that action, Peyroux submitted an affidavit stating that she did not dispute that she and Galison were joint authors of the seven songs contained on the Seven-Track Album. Rather, she claimed that Galison's effort to exploit the seven songs by selling them other than at live shows violated the parties' oral contract. The federal court dismissed the action for lack of subject matter jurisdiction, ruling that the parties' dispute arose under their contract, not under the Copyright Act.

Upon information and belief, Peyroux states that Galison has distributed or sold over 15,000 copies of the Eleven-Track Album, including many in New York State. She adds that Galison has not paid her any compensation for sales of the Eleven-Track Album, despite his claim that he and Peyroux are joint authors and composers and are required to account to each other.

Peyroux argues that her counterclaims should survive the instant motion to dismiss. She asserts that the main undisputed factual issue is that, although she and Galison recorded the Seven-Track Album together, the album that Galison is currently distributing contains additional tracks that do not involve her, that she did not agree to the distribution of the Eleven-Track Album, and that she and Galison had an agreement to limit the distribution of the jointly-owned songs to sales of the Seven-Track Album at particular events.

Peyroux argues that she has properly pleaded a claim for deceptive trade practices and false advertising, pursuant to General Business Law (GBL) §§ 349 and 350. Peyroux states that Galison's use of her name and likeness on the Eleven-Track Album is misleading, because she never agreed to distribute the songs in the Seven-Track Album as part of the Eleven-Track Album. She states that having her name and likeness on the Eleven-Track Album suggests that she endorses the entire album, which she has never done. She further argues that the album cover and advertising is misleading because a reader of the jacket of the Eleven-Track Album could believe that it was an album by Peyroux, when it is merely a Galison-orchestrated compilation with some Peyroux songs.

Peyroux maintains that, as a joint author, Galison can sell the work in any way he chooses, unless it infringes on or violates her rights. She claims that he has infringed on her rights in that he breached their agreement to limit the distribution of the songs on the Seven-Track Album and in that she never gave Galison the right to use her name or image in connection with the Eleven-Track Album or in advertising related thereto. Peyroux argues that the joint ownership of the seven tracks does not mean that Galison can add those seven songs to his own songs to make a full length album, and then suggest that Peyroux supported the album.

Peyroux maintains that she has pleaded a valid claim for unfair competition based on trademark infringement, pursuant to GBL § 360-o, which states: "Nothing herein shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law."

Peyroux states that she has pleaded a bona fide trademark in her name, and that Galison's use of her name or trademark in connection with the sale of the Eleven-Track Album is misleading. She further argues that there is nothing in copyright law that gives a joint owner any rights over a co-owner's trademark. Finally, Peyroux states that nothing in the decision in the Federal Action dismissing Galison's meritless copyright suit refers to trademark law.

According to Peyroux, she has also pleaded a valid claim under New York Civil Rights Law § 51. She argues that no reasonable waiver of her privacy rights with regard to the Eleven-Track Album can be inferred from the sale of the Seven-Track Album.

Finally, Peyroux argues that there is no factual or legal basis for the claim for sanctions.

On a motion to dismiss pursuant to CPLR 3211 (a) (7), the court accepts the factual allegations in the causes of action as true, and the party alleging the claims is given the benefit of every possible inference. Leon v Martinez, 84 NY2d 83, 87-88 (1994). Galison argues that, because it is undisputed that he and Peyroux are joint owners of the recordings on the Seven-Track Album, he has the right to utilize them in any way he chooses, such that Peyroux fails to state legally cognizable causes of action as to the three counterclaims at issue in the instant motion, and that they therefore should be dismissed.

Galison maintains that the second counterclaim, sounding in deceptive trade practices and false advertising, pursuant to GBL §§ 349 and 350, must be dismissed because Peyroux has failed to allege that Galison made materially misleading statements in his advertisement concerning the Eleven-Track Album, nor has she alleged that she has sustained any actual

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damage by reason of Galison's alleged deceptive practices.

Galison states that the Eleven-Track Album and its musical content are just as he describes them, with each song accurately titled and described, and with each recording artist credited for the songs on which he or she performed, including Peyroux. Galison states that, whether or not Peyroux authorized the Eleven-Track Album, the fact that her name is used on it is not deceptive or fraudulent, because she is a performer on seven of its songs, all of which are jointly owned by Galison.

Galison further argues that Peyroux cannot claim that she herself was deceived in any material way by Galison's use of her name and image on the Eleven-Track Album. He states that Peyroux lacks standing to bring claims under GBL §§ 349 and 350, since they are only available to "an individual consumer who falls victim to misrepresentations made by a seller of consumer goods through false or misleading advertising." Solomon v Bell Atl. Corp., 9 AD3d 49, 52 (1<sup>st</sup> Dept 2004) (internal quotation marks and citation omitted).

Peyroux's second counterclaim is dismissed, as she is not a consumer who was misled by the Eleven-Track Album, and furthermore, all of the information provided on the album itself and on its cover is accurately described. The fact that Peyroux did not authorize the Eleven-Track Album does not mean that the information provided on the album or in the advertising related thereto misled consumers or misrepresented the album or its contents.

According to Galison, Peyroux's third counterclaim for trademark infringement and unfair competition is fatally defective, because the recordings are jointly owned, and an individual cannot, as a matter of law, infringe upon his or her own copyright. Galison maintains that, for the same reason, Peyroux's claim that Galison has violated GBL § 360-o,

\* 9 ]  
which permits the enforcement of a common-law claim for copyright or trademark infringement, must be dismissed as well.

Galison argues that Peyroux is barred from commencing either a copyright infringement or a trademark infringement claim against him. Galison maintains that, while independent copyright and trademark claims exist in some circumstances, they do not exist here, where there is joint ownership of the material by plaintiff and defendant. According to Galison, as a joint owner of the recordings, he owns every part of them, including the right to use Peyroux's name, regardless of whether it was entitled to trademark protection.

Galison maintains that the allegations supporting the trademark infringement claim duplicate those which would be contained in a copyright infringement claim.

Peyroux does not allege that she has a registered trademark for her name. Furthermore, an individual's name can have a protectible trademark only when it has acquired a secondary meaning. See Alexander Ave. Kosher Rest. Corp. v Dragoon, 306 AD2d 298, 300 (2d Dept 2003); Yarmuth-Dion, Inc. v D'ion Furs, Inc., 835 F2d 990, 993 (2d Cir 1987). There is no allegation or indication that Peyroux's name has acquired a secondary meaning. Finally, Peyroux is, in fact, one of the performers on the Eleven-Track Album, such that there is no issue of confusion among consumers as to the source of the product. See Yarmuth-Dion, Inc., 835 F2d at 992-993. Thus, the third counterclaim, sounding in violation of GBL § 360-o, is dismissed.

The fourth counterclaim is brought pursuant to New York Civil Rights Law § 51, which provides a claim for an injunction and damages in favor of "[ a]ny person whose name, portrait, picture or voice is used within this state for advertising purposes or for the

\* 10 ]  
purposes of trade without ... written consent." The statute contains various exceptions, including that:

Nothing contained in this section shall be construed to prohibit the copyright owner of a sound recording from disposing of, dealing in, licensing or selling that sound recording to any party, if the right to dispose of, deal in, license or sell such sound recording has been conferred by contract or other written document by such living person or the holder of such right

Thus, whether or not Galison violated Peyroux's privacy rights depends on whether or not she can prove the allegations in her fifth counterclaim that there was an oral contract between them, limiting sale of the jointly-owned songs to their live performances. Thus, because that issue has not yet been determined, the fourth counterclaim, sounding in violation of right of privacy and publicity, survives the instant motion to dismiss.


That part of the motion seeking sanctions is denied.

Accordingly, it is

ORDERED that plaintiff's motion to dismiss is granted in part, to the extent that the second and third counterclaims are dismissed, and is otherwise denied; and it is further

ORDERED that Peyroux is directed to serve a reply to the answer within 20 days after service of a copy of this order with notice of entry.

Dated: 5/19/06

**FILED**  
MAY 22 2006  
ENTER: COUNTY CLERK'S OFFICE  
NEW YORK  
  
J.S.C.  
**BERNARD J. FRIED**  
J.S.C.