

Sontag v Cook

2008 NY Slip Op 33651(U)

February 8, 2008

Sup Ct, New York County

Docket Number: 600102/04

Judge: Herman Cahn

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

PRESENT: Cahn
Justice

PART 49M

Albert Sontag, as Receiver of Three
Mo' Partnership

INDEX NO. 600102/04

MOTION DATE _____

Victor Trent Cook, Dill Trent Meriwether,
Rodruck & Dixon, Thomas J. Young, Cook,
Dixon & Young, Tenora, Ltd and CB
Enterprises, Inc.

MOTION SEQ. NO. 004

MOTION CAL. NO. _____

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 _____

Cross-Motion: Yes No

Upon the foregoing papers, it is ordered that this motion

FILED
SEP 12 2008
COUNTY CLERK'S OFFICE
NEW YORK

PAPERS NUMBERED _____

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

**MOTION IS DECIDED IN ACCORDANCE
WITH ACCOMPANYING MEMORANDUM
DECISION IN MOTION SEQUENCE**

Dated: 9/8/08

[Signature]

J.S.C.

Check one: FINAL DISPOSITION NON-FINAL DISPOSITION

Check if appropriate: DO NOT POST REFERENCE

SUPREME COURT OF THE STATE OF NEW YORK
COUNTY OF NEW YORK: IAS PART 49

-----X

ALBERT SONTAG, as Receiver of Three Mo'
Partnership,

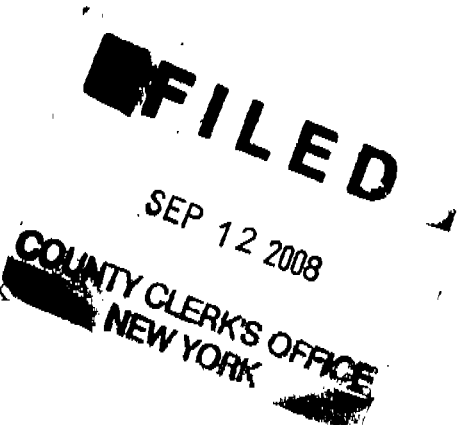
Plaintiff,

-against-

Index No. 600102/04

VICTOR TRENT COOK, L'IL TRENTS MUSIC
INC., RODRICK E. DIXON, THOMAS J. YOUNG,
COOK, DIXON & YOUNG TENORS, LTD., and
CD ENTERPRISES INC.,

Defendants.



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HERMAN CAHN, J.:

Plaintiff moves to amend the caption of this action to substitute WMK Productions Inc. (WMK) for Albert Sontag as Receiver of Three Mo' Partnership (Sontag) as plaintiff; to modify the February 8, 2005 and December 6, 2005 orders of this court to extend the preliminary injunction until February 2, 2011 or until trial; and to modify the existing orders to cover defendants' activities outside the United States.

FACTS

WMK is the assignee of Three Mo' Partnership's rights. Sontag assigned the entire interest in Three Mo' Tenors and the Receiver's remaining rights, including causes of action and claims in the instant action, to WMK. The motion, insofar as it seeks to substitute WMK in the caption for Sontag, is unopposed and is granted.

The prior decisions in this action have set forth the background and facts and need not be repeated here in full. In brief, defendants Victor Trent Cook (Cook), Rodrick E. Dixon (Dixon)

and Thomas J. Young (Young) are three African-American tenors who appeared in a group known as "Three Mo' Tenors" from 2001 through November 2003. They were employed by the Three Mo' Partnership. When they signed employment agreements with Three Mo' Partnership (the Partnership), they agreed not to refer to the name "Three Mo' Tenors" when they were no longer in the Partnership's employ, and not to sing together as a group for a specified period of time. Nonetheless, after their employment with the Partnership ended, Cook, Dixon and Young decided to perform under their own names and advertised themselves as Cook Dixon & Young (CDY) "formally the Three Mo' Tenors."

The Partnership objected to this, and negotiated with the magazine in which the advertisement appeared to substitute "formerly" in the advertisement, but CDY refused to consent. This action ensued. In the meantime, the Partnership was forming another group of African-American Tenors, to perform as a group under the name "Three Mo' Tenors."

In this court's February 8, 2005 order, the court granted a preliminary injunction enjoining defendants from referring to the fact that they were "formerly of the Three Mo' Tenors," or from referring to "Three Mo' Tenors" in any way, in advertizing or publicizing their performances. Defendants could not assert in any interviews or written material that any other performers operating under the aegis of the Partnership were not the "Three Mo' Tenors."

After complaints of a breach of the injunction, this court issued another order, dated December 6, 2005, which provided that internet website advertisements may not contain internet links to materials which would violate the February 8, 2005 order.

WMK now asserts that CDY has systematically and repeatedly violated this court's prior orders, which have resulted in CDY perpetuating confusion regarding the rights in the name

“Three Mo’ Tenors.” Hence, WMK seeks to have the preliminary injunction extended for another three years, or until trial. WMK further maintains that “Three Mo’ Tenors” has expanded into international venues, having performed in Toronto, Ontario, Edinburgh, Scotland and Armenia. Additionally, it claims that its website is regularly visited by members of the public in Europe, Asia, Africa and South America. Consequently, it seeks to expand the injunction to include defendants’ activities outside the United States.

DISCUSSION

WMK contends that there has been a persistent linkage of the name “Three Mo’ Tenors” to CDY, which has resulted in problems for WMK’s production. It maintains that there are presenters who are reluctant to book “Three Mo’ Tenors” because they had a bad or difficult experience with CDY. WMK further argues that unless the injunction is extended, it will not be able to protect its good will, and every member of every cast of “Three Mo’ Tenors” will be a potential competitor. It points out that CDY claim that they want to perform under their own name and concludes that, therefore, prohibiting them from using the name “Three Mo’ Tenors” would not impose an undue hardship.

In opposition, defendants present many of the same arguments that they raised in opposition to the February 8, 2005 preliminary injunction. In addition, defendants contend that the language of the injunction prohibited references to “Three Mo’ Tenors” in “material advertising or promoting any concert, or in programs, playbills, etc.” (Feb 8, 2005 decision, at 19), but did not prohibit such references in other areas, such as interviews or websites. Defendants also maintain that WMK is responsible for much of the existing confusion because it has used likenesses of Cook, Dixon and Young in its promotional materials for “Three Mo’

Tenors.”

A preliminary injunction is appropriate where the movant demonstrates a likelihood of success on the merits; irreparable harm absent the injunction, and a balancing of the equities in its favor. *St. Paul Fire & Marine Ins. Co. v York Claims Serv., Inc.*, 308 AD2d 347 (1st Dept 2003).

As noted in the February 8, 2005 decision, that fact that plaintiff did not succeed in obtaining federal trademark protection for the name “Three Mo’ Tenors” does not mean that it cannot enjoin another’s use of its trade name. Pursuant to section 133 of the General Business Law, plaintiff has the right to enjoin such usage if it “may deceive or mislead the public as to the identity of such person, firm or corporation or as to the connection of such person, firm or corporation with any other person, firm or corporation.” As a result, this court determined that the confusion caused by CDY’s use of the name “Three Mo’ Tenors,” with links to their prior performances while employed by plaintiff, warranted the imposition of a preliminary injunction.

At that time, the court specifically stated that such injunction was to continue for three years, and that after that time, defendants would be permitted to use the term “formerly of Three Mo’ Tenors” as set forth in this court’s prior interim order of May 4, 2004. February 8, 2005 decision, at 16. The May 4, 2004 order provides that defendants may refer to the fact that they were formerly of the “Three Mo’ Tenors,” but the print must be not larger than 60% of the print size used to set forth defendants’ names on the same material. It also provides that defendants cannot hold themselves out to be the “Three Mo’ Tenors,” either currently, the only, or the original, nor may they assert than any other tenors operating under the aegis of plaintiff are not the “Three Mo’ Tenors.”

The court notes that the preliminary injunction has been in place for over three years. The purpose of the injunction was to allow “Three Mo’ Tenors” to establish itself as a separate entity from CDY, with whom it had been so closely associated, in keeping with the purpose of the employment agreement. However, it is now three years later, and CDY cannot be prohibited indefinitely from making references to their prior experience in “Three Mo’ Tenors.”

Plaintiff contends that there have been many breaches of the injunction, which have caused continuing confusion. Much of the material they cite is not covered by the injunction, nor could it be. There have been many reviews and articles that refer to CDY as “formerly known as” or “formerly of” Three Mo’ Tenors. However, CDY cannot control what a reviewer or journalist writes. Similarly, the blogs and other web comments of fans cannot be edited or corrected by CDY. The fact that there may have been some advertisements that contained the prohibited reference is lamentable, but occurred in reverse as well; “Three Mo’ Tenors” had material at times that featured likenesses of CDY. It cannot be said that those occasional occurrences were of such magnitude as to require extending the time period for the injunction.

At this point, the court believes that the more restrictive terms of the February 8, 2005 injunction should no longer be necessary, and those of the May 4, 2004 decision should be adequate to protect plaintiff’s interests. Both CDY and “Three Mo’ Tenors” have been performing over the course of the last three years, and those who follow such performances should, by now, be aware of the two distinct groups. Further, by limiting defendants’ use of the name “Three Mo’ Tenors,” as provided in the May 4, 2004 decision, plaintiff will be assured that there will be no increase of confusion, while defendants may, if they so desire, make reference to their prior experience.

The fact that "Three Mo' Tenors" has now expanded its activities to the international arena does not mean that the preliminary injunction should likewise be expanded. If "Three Mo' Tenors" has begun to establish itself internationally, in places where CDY has not performed, there should not be the issue of confusion that has persisted in the United States. WMK has not presented evidence that defendants have used the name "Three Mo' Tenors" in the international arena, or that there is any confusion between the two entities internationally so as to support the grant of a global injunction.

Consequently, WMK has failed to demonstrate the need to extend the February 8, 2005 preliminary injunction, either in scope or in time.

CONCLUSION

Accordingly, it is hereby

ORDERED that the motion is denied except to the extent that so much of the motion as seeks to amend the caption to substitute WMK Productions Inc. for Albert Sontag as Receiver of Three Mo' Partnership as plaintiff is granted, and the new caption shall be as follows:

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WMK PRODUCTIONS INC.,

Plaintiff,

Index No. 600102/04

-against-

VICTOR TRENT COOK, L'IL TRENTS MUSIC INC., RODRICK E. DIXON, THOMAS J. YOUNG, COOK, DIXON & YOUNG TENORS, LTD., and CD ENTERPRISES INC.,

Defendants.

-----X

and it is further

ORDERED that plaintiff shall serve a copy of this order on both the Trial Support Office (Room 158) and the County Clerk within 30 days hereof.

Dated: September 8, 2008

ENTER:


_____ J.S.C.

FILED
SEP 12 2008
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NEW YORK