

## Stone v. Williams 970 F.2d 1043 (2d Cir. 1992)

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Accordingly, the Appellate Court analyzed the nature of Goodman's actions between 1968 and 1973 and not his intent. The court reasoned that Goodman's lawsuit was not merely one against an infringing user. He also sought recovery of royalties, an injunction to force compliance with the management contract and a declaration of sole ownership. Thus, in addition to seeking sole ownership, Goodman also sought to continue his use of the trade name by continuing to perform his managerial duties. Therefore, the lawsuit satisfied the *Silverman* use requirement and Goodman did not abandon the trade name. It was then unnecessary for the court to consider the second prong of the *Silverman* test regarding whether Goodman intended to resume use of the trade name in the reasonably foreseeable future.

## CONCLUSION

In finding Goodman did not abandon his ownership rights to the trade name "The Diamonds", the Second Circuit expanded the *Silverman* standard. By recognizing that use of a trade name depends on the occupation of the owner, the court allowed for the present situation in which, due to Goodman's occupation as band manager, litigation became his only means of using the trade name and avoiding an abandonment claim. Moreover, since such a lawsuit must be targeted at promoting the use of the name in commerce rather than simply prohibiting its use by another, this expansion adhered to the underlying policy in *Silverman* that an owner must maintain a trade name as an economically viable asset or otherwise risk forfeiting it.

Ann E. Dustman

1. *Stetson v. Wolf & Assocs.*, 955 F.2d 847, 850 (2nd Cir. 1992) (citing *Silverman v. CBS Inc.*, 870 F.2d 40, 45-46 (2nd Cir. 1989)).

2. *Id.* at 849.

3. *See Id.* at 851; see also 15 U.S.C. § 1127 (Supp. 1992).

4. 955 F.2d at 850 (citing *Silverman*, 870 F.2d at 45).

5. *Silverman* involved a dispute over the use of popular radio and television characters where the plaintiff wanted to use the characters as a basis for his play and CBS held the trademark and copyrights but discontinued broadcasting the shows in response to criticism from civil rights groups. *See*, 955 F.2d at 851 (citing *Silverman*, 870 F.2d at 47-48); *See also* 15 U.S.C.A. § 1127 (West Supp. 1992) (defining abandonment of trade name).

6. 955 F.2d at 851 (citing *Silverman*, 870 F.2d at 47-48).

7. *See Id.* at 851-52.

## Stone v. Williams,

970 F.2d 1043 (2d Cir. 1992).

## INTRODUCTION

Cathy Stone ("Stone"), the illegitimate daughter of the late Hank Williams sued Hank Williams Jr. and others for past royalties based on her claimed copyright renewal interest. Stone claimed she was the

child of Williams within the meaning of sections 24 and 304(a) of the Copyright Act. The Court of Appeals for the Second Circuit held that Stone was entitled to a share of the copyright renewals under both the Copyright Act of 1909 and the Copyright Act of 1976, because under state law she was included in the definition of a child entitled to inherit.

## FACTS

Stone is the illegitimate daughter of the late Hank Williams, the famous country and western composer and performer. The defendants are Hank Williams, Jr., the son of Hank Williams, Billie Jean Williams Berlin, the widow of Hank Williams, and assignees of certain of their interests, including assignees of their interest in the renewal copyrights.

On October, 17, 1979, Stone was told by her adoptive mother that she may be Hank Williams' daughter. On September 12, 1985 Stone filed suit in the United States District Court for the Southern District of New York seeking a declaration that she was Williams' child within the meaning of sections 24 and 304(a) of the Copyright Acts of 1909 and 1976 and entitled to a property interest in the copyright renewals for Williams songs.<sup>1</sup>

In the meantime, the defendants sued in Alabama state court, seeking a declaration that Stone was barred from demonstrating that she was the natural child of Williams entitled to a share of his estate. Recognizing the trial court's decision that Stone was the natural child of Williams, the Alabama Supreme Court found her entitled to a share of the proceeds of Williams' estate.<sup>2</sup> After the Alabama Supreme Court decision, the District Court for the Southern District of New York held that Stone's action for renewal copyrights was barred by the Copyright Acts' three year statute of limitations.<sup>3</sup> Stone appealed.

## LEGAL ANALYSIS

Stone claimed that as the child of Williams she is entitled to an interest in the renewal copyrights of his songs and royalty payments. On appeal, the issue was whether Stone's action seeking an interest in copyright renewals was time-barred.

First, the Copyright Act of 1976 ("Act") states that no cause of action under the Act can be maintained unless it is brought "within three years after the claim accrued."<sup>4</sup> Declaratory Judgment is a procedural device used to vindicate substantive rights. It is time-barred only if relief on a direct claim based on the substantive rights is also barred.<sup>5</sup> In determining if the plaintiff's claim is timely, a court should look at whether the plaintiff's substantive cause of action is barred. A cause of action accrues when the plaintiff knows or has reason to know of the injury upon which the claim is based.<sup>6</sup>

The court reasoned that since Stone claimed a deprivation of a statutory entitlement, the statute of