

# United States Court of Appeals For the First Circuit

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Nos. 17-1264,  
17-1316

DONALD THOMAS SCHOLZ,

Plaintiff/Counterclaim-Defendant, Appellant/Cross-Appellee,

v.

BARRY GOUDREAU,

Defendant/Counterclaim-Plaintiff, Appellee/Cross-Appellant.

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APPEALS FROM THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS

[Hon. Denise J. Casper, U.S. District Judge]

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Before

Torruella, Lynch, and Kayatta,  
Circuit Judges.

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Susan E. Stenger, with whom Lawrence G. Green, Laura Lee Mittelman, and Burns & Levinson LLP were on brief, for appellant/cross-appellee.

Jeffrey S. Baker, with whom Baker and Associates, P.C., Daniel P. Tarlow, Copani, Tarlow & Cranney, LLC, David M. Given, and Phillips, Erlewine, Given & Carlin LLP were on brief, for appellee/cross appellant.

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August 21, 2018

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**TORRUELLA, Circuit Judge.** Donald Thomas Scholz, a member of the rock band BOSTON, sued former BOSTON guitarist Barry Goudreau for various trademark infringement and breach of contract claims relating to impermissible references that Goudreau had allegedly made regarding his former association with the band. Goudreau counterclaimed with his own breach of contract and abuse of process claims. After the district court granted in part and denied in part both parties' respective motions for summary judgment, the extant claims proceeded to trial. The jury found in favor of the respective defendant on each of the remaining claims. Scholz and Goudreau now cross-appeal the district court's summary judgment findings, evidentiary rulings, and denials of the various motions detailed in this opinion. For the reasons stated below, we affirm the district court and deny both parties' appeals.

## I. Background

### A. **Factual Background**

In 1976, Scholz and Goudreau were members of the rock-band BOSTON, along with Fran Sheehan, Sib Hashian and Brad Delp. Goudreau played the guitar in the band's first two albums and performed with the band from approximately 1976 to 1979. After Goudreau left BOSTON in 1981, he and the remaining members of the band executed a settlement agreement (the "Settlement Agreement") in 1983, pursuant to which Goudreau would receive a one-fifth share

of the band's royalties for the first two BOSTON albums. The Settlement Agreement also stated that Goudreau "shall have no interest, right nor title to the name of 'BOSTON', nor to any recording royalties, performing rights royalties, performance income, copyright interests or payments, or financial interest therein, except as provided herein." The agreement clarified that:

D. The Name "BOSTON": The parties hereto expressly agree that Goudreau may use the term "Formerly of Boston" for and in conjunction with any biographical usage with respect to future performances, but, except to this extent, Goudreau shall have no other interest, right or title to the name "BOSTON." Without limiting the foregoing, Goudreau may not use the name "BOSTON" for or in conjunction with any advertisement or promotion.

From 2004 to 2006, Goudreau and Sib Hashian began to play music informally with Ernie Boch Jr. ("Boch"), an amateur musician and New England area car mogul. Eventually, the three started performing together in a band that they later called Ernie and the Automatics ("EATA"). On February 6, 2009, Boch, Goudreau, and other members of EATA signed a Confirmatory Recording Artist Agreement (the "Confirmatory Agreement") in which the signatories granted Boch the right in perpetuity to use, and authorize others to use, their names and biographical information for advertising and promotion of EATA. By signing the agreement, the EATA members warranted that use of their names and biographical information would not infringe upon the rights of any third parties.

Boch created and managed EATA's website, which described Goudreau as an "original" member of the band BOSTON. In 2009, Boch posted on YouTube an EATA "pop-up"<sup>1</sup> music video produced by Boch's friend, Ian Barret, to promote EATA's new album. The "pop-up" video displayed lines of text that would momentarily appear at the bottom of the screen overlaying EATA's music video. Some of the pop-up messages read as follows:

1. "Guitarist Barry Goudreau and drummer 'Sib' Hashian are 'former' original members of the band 'Boston'."
2. "Boston's' first record is the biggest selling debut in history with 17 million units sold."
3. "The original cover art for 'Boston's' first record was a head of Boston lettuce, not the guitar spaceship."
4. "Brian met Barry when he joined 'Orion the Hunter', Barry's first band project after 'Boston.'"
5. "Brian, Barry, and Tim would later form 'RTZ' with 'Boston' lead singer, Brad Delp."

In addition, Boch advertised EATA in magazines, in which he referred to Goudreau as an original and founding member of BOSTON. The cellophane wrapping of EATA's 2009 CD album entitled "Low Expectations" bore a sticker reading: "Featuring Barry Goudreau . . . former original member[] of the multi-platinum selling band 'BOSTON.'" When EATA held a CD release party on February 7, 2009,

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<sup>1</sup> As referred to in Boch's testimony and Goudreau's appellate brief.

the promotional material read in part: "Barry Goudreau and Sib Hashian, two former original members of the multi-platinum selling band BOSTON have reunited."

In addition to EATA's advertisements, Goudreau's musical performance in "The Best of Boston series" was promoted as featuring "original founding Boston member Barry Goudreau." Additionally, promotional materials for Goudreau's shows at the Cannery Casino Hotel referred to Goudreau as "BOSTON's former 'lead' guitarist and an original 'BOSTON' member." Moreover, Goudreau was described as "the lead guitarist rock legend from the band BOSTON" in performances with the James Montgomery Blues Band.

#### **B. Procedural History**

On April 17, 2013, Scholz filed suit against Goudreau in the District of Massachusetts, alleging, as is relevant to this appeal, federal trademark infringement in violation of 15 U.S.C. § 1114(1), breach of contract, and breach of the implied covenant of good faith and fair dealing. Goudreau filed an answer on May 24, 2013, and asserted various counterclaims including breach of contract, breach of implied covenant of good faith and fair dealing, and abuse of process, all under Massachusetts law. Goudreau also sought a declaratory judgment that using language other than "formerly of Boston" does not violate Scholz's trademark rights. Scholz subsequently filed a first amended complaint

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