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Intellectual Property Checklist for Marketing the Recording Artist Online

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### INTELLECTUAL PROPERTY CHECKLIST FOR MARKETING THE RECORDING ARTIST ONLINE

*Am* *j. Everhart*

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I. INTRODUCTION

A recording artist's online presence is the press kit of the digital age. Unlike the paper folder with headshot, bio, demo CD, and press clippings, however, the online marketing landscape—whether a website, a blog, or social networks such as Facebook, YouTube, and Twitter—is lined with intellectual property landmines. To ensure both protection of the artist's rights and the artist's compliance with the law, artists and their attorneys should consider this checklist, by no means exhaustive, of intellectual property concerns triggered by the use of online marketing tools.

II. PROTECTION OF THE ARTIST'S COPYRIGHTS

The anonymity and accessibility of the Internet renders theft of online intellectual property rampant and difficult to trace. Before an artist posts any intellectual property online, whether a recording, a video, song lyrics, or the like, the artist should clarify and secure all necessary copyrights.

A. CONFIRMATION OF COPYRIGHTS

The artist should first assess and confirm, in writing, if not already done, the ownership of all intellectual property the artist intends to post. In the case of a song, this includes clarifying the co-writers and co-publishers and their respective copyright shares. In the case of a recording or a video, this includes clarifying the ownership of the sound recording and the video images, accounting for any recording agreement or other agreement governing use or ownership.¹

Of particular importance before posting, the artist should consider registering with the U.S. Copyright Office all content in which the artist owns a share.² Registering content before it is made available online and becomes particularly vulnerable to misappropriation could afford the artist additional remedies for copyright infringement if the content is misappropriated.³

¹ An audio recording of a song, or musical composition, includes two separate copyrights: (1) the musical composition, consisting of the underlying music and lyrics, and (2) the sound recording, or the particular performance of the musical composition. Bridgeport Music, Inc. v. UMG Recordings, Inc., 585 F.3d 267, 273 n.1 (6th Cir. 2009) (citing 17 U.S.C. § 102(a)(2), (7) (2009)). In many cases, the copyrights to the musical composition and the sound recording in which it is embodied are held by different owners.

² Copyrights can be registered online at http://www.copyright.gov.

³ A work need not be registered with the Copyright Office to acquire copyright protection. Copyright protection is conferred upon embodiment of the work in a tangible medium. 17 U.S.C. § 101 (2010). Thus, once a song is created and recorded, copyright attaches. Registration of the work with the Copyright Office before infringement or within three months of first publication of the work, however, confers the right to seek attorney's fees and statutory damages.
The artist should also consider registering any song of which the artist is a copyright holder with a performance rights organization such as ASCAP, BMI, or SESAC so that the artist can collect performance income for performances of the song online. 4

Finally, the artist should post a copyright notice on or near the artist’s online content notifying the public that the content is the proprietary property of the artist or its licensors, if the latter is the case. A strategically placed copyright notice will serve not only to educate the public that copyright law applies equally online and off, but also may bolster an artist’s infringement claim if such a claim should become necessary; an infringer cannot claim innocent infringement to mitigate damages if the work that was misappropriated included a copyright notice.5

B. THE USE OF DESIGNERS AND DEVELOPERS

Artists will often hire third parties to design and develop web content, such as logos, web-page designs, and social-network page designs. The artist should take precautions to ensure ownership of this third-party content and protection from liability for the content.

A fundamental concept of copyright law is that the author of a work, in most instances, owns the copyright to the work unless the copyright is transferred in a signed writing.6 Simply “hiring,” or paying, a third party to create a work on behalf of the artist may not be sufficient to confer the copyrights in the resulting work to the artist. Unless designers and developers are employees of the artist and create the content within the scope of their employment, a signed writing is required to transfer such rights.7 It is not always clear whether an employment relationship exists or whether the work

in an infringement lawsuit. Id. § 412. Registration is also required before an infringement lawsuit can be filed. Id. § 411(a).

4 Performance rights organizations administer the public-performance rights of musical compositions on behalf of songwriters and publishers. The three performance rights organizations are The American Society of Composers and Publishers (ASCAP), Broadcast Music Incorporated (BMI), and SESAC, originally named the Society of European Stage Authors and Composers. Joshua Keesan, Note, Let it Be? The Challenges of Using Old Definitions for Online Music Practices, 23 BERKELEY TECH. L.J. 353, 356 (2008). Many of the major online providers of media content, such as, YouTube, have negotiated blanket licenses with the performance rights organizations for performance of the songs registered with those organizations. See, e.g., United States v. ASCAP, 616 F. Supp. 2d 447 (S.D.N.Y. 2009) (declaring fair a blanket license fee of 2.5% of music-derived revenue).

5 17 U.S.C. §§ 401(d), 402(d) (2010).

6 Id. §§ 201(a), 204(a).

7 Id. § 201(b). Section 201(b) of the Copyright Act provides:

In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.
was created within the scope of that employment. A signed writing by an
independent contractor is required to transfer the copyrights to their work or
create a work-for-hire relationship.\(^8\)

Therefore, regardless of whether the artist’s relationship with the designer or
the developer is that of employer-employee or independent contractor, the
artist should require all designers and developers of the artist’s online content to
sign agreements confirming that the resulting content is a work made for hire
on behalf of the artist or, in the alternative, that the copyright in the content is
assigned to the artist.

Finally, because the artist cannot know personally whether the content
created by designers or developers is original and does not infringe the rights of
others, the artist should include in the agreement a warranty of originality and
non-infringement and a right of indemnification against the designer or the
developer for breach of the warranty.

III. PROTECTION FROM LIABILITY FOR THIRD-PARTY CONTENT

If the artist’s website provides a means for users to post or upload content,
such as the posting of photographs, music, videos, and text in blog comments,
fan pages, or the like, the artist should consider taking steps to secure
protection under the safe-harbor provisions of the Digital Millennium
Copyright Act (the DMCA).\(^9\)

The DMCA insulates online service providers\(^10\) from copyright claims
against third parties who place content on the service provider’s website if the
service provider complies with the DMCA requirements. Those requirements
include a posted take-down policy with specific elements, the designation of a
DMCA agent to receive claims, and the registration of the designated agent with
the U.S. Copyright Office.\(^11\) Most importantly, and seemingly obvious but not
always the case, the service provider must follow the posted procedures.

\(^8\) A work made for hire is defined as (1) a work prepared by an employee within the
scope of his or her employment; or (2) a work specially ordered or
commissioned for use as a contribution to a collective work, as a part of a
motion picture or other audiovisual work, as a translation, as a supplementary
work, as a compilation, as an instructional text, as a test, as answer material for a
test, or as an atlas, if the parties expressly agree in a written instrument signed by
them that the work shall be considered a work made for hire. . . .


\(^10\) A “service provider” is defined in the DMCA as “a provider of online services or network
access, or the operator of facilities therefor. . . .” 17 U.S.C. § 512(k) (2010). This includes website
owners. David Ludwig, Shooting the Messenger: ISP Liability for Contributory Copyright Infringement,

\(^11\) Specifically, to qualify for safe-harbor protection under that section of the DMCA guarding
against “information on systems or networks at the direction of users,” the party (1) must be a
service provider as defined in the Act; (2) must have “adopted and reasonably implemented, and
IV. THE USE OF THIRD-PARTY CONTENT

An artist may sing audio, perform in a video, or appear in a photograph, but such presence does not automatically grant the artist the right to use such content in the artist’s online marketing campaign. Often the rights to such content belong to third parties, and the artist must seek permission for such uses.

A. MUSIC RIGHTS

One of the main goals of an artist’s online promotional campaign is, of course, to make the artist’s music available for listening. The artist has many avenues for doing so, including making a recording available for download, streaming a recording to be played “on demand,” or playing a recording in synchronization with a video.

In each case, the artist must ensure copyright clearance for both the song and the recording of the song. Depending on the manner in which the song, recording, or video is made available online, the artist may need one or more types of licenses. Because the law governing the licensing of music online is in flux and hotly debated, the artist and the artist’s attorney are advised to stay abreast of the different types of licenses needed at any given time. Below are some examples and the current recommended licensing practice for each.

1. Streaming Audio. Streaming refers to music performances over the Internet where the user is not provided with a permanent digital copy of the music but instead accesses copies residing on the provider’s server computers. Streaming music online requires a public-performance license from the owner of the song’s copyright. Streaming may also require a mechanical license.

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inform(s) subscribers and account holders of the service provider’s system or network of a policy that provides for the termination in appropriate circumstances of subscribers and account holders of the service provider’s system or network who are repeat infringers,” and (3) “must accommodate and . . . not interfere with standard technical measures’ used by copyright owners to identify or protect copyrighted works.” Perfect 10, Inc. v. Google, Inc., 2010 U.S. Dist. LEXIS 75071, *11 (C.D. Cal., July 26, 2010) (citing 17 U.S.C. § 512 (2009)). Further, the party must designate an agent to receive notifications of claimed infringement by making available the agent and specified information through its service, including on its website in a location accessible to the public, and by submitting the name and contact information for the designated agent to the Copyright Office. 17 U.S.C. § 512(c)(2) (2010). The current form for submission of the designated agent information is located on the Copyright Office website at http://www.copyright.gov/onlinepd/agent.pdf.


13 A public-performance license can be obtained for most songs from one of the three performing rights organizations—BMI, ASCAP, or SESAC. If the artist is streaming music on a website hosted by a major online service provider such as YouTube, that provider may have a blanket streaming license.

14 “Various segments of the music industry vigorously dispute whether streaming requires just a license for public performance, or whether both performance and mechanical licenses are
Finally, streaming may require a master-use license and public-performance license from the owner of the sound-recording copyright.\textsuperscript{15}

2. Downloads. Artists who make recordings available for download online—where the user is provided with a permanent digital copy—must obtain a Digital Phonorecord Delivery, or “DPD,” license from the song copyright owner and a master-use license from the recording copyright owner.\textsuperscript{16}

3. Streaming Video. If a song and a recording will be used in a streamed music video, the artist will also need a synchronization license from the owners of both the song and the recording. Unlike mechanical licenses, synchronization licenses are never compulsory and are granted only at the discretion of the copyright holder.\textsuperscript{17} In addition, the artist should obtain rights from the copyright owners of the video footage.

B. PHOTOGRAPH RIGHTS

In promoting themselves online, artists may use photographs of themselves, their band members, their fans, and even stock photographs. The artist must secure permission from the copyright holder of each photograph before use.

The artist should be especially wary of the use of stock photographs. Stock photographs are commonly used by web designers to enhance the design of websites and social-network pages. Blog and social-network platforms make the upload and use of photographs easy and commonplace. Stock photograph owners have recently begun cracking down on the unauthorized use of their photographs on the Internet.\textsuperscript{18} Even stock photographs taken from “free clip-art” sites may not be authorized by the copyright holder.

The artist is advised to confirm copyright ownership of any stock photographs and to license stock photographs only from reputable sites. The

\textsuperscript{15} Public-performance and master-use licenses from the owner of the sound recording (typically the record company) must be obtained directly from the owner. An organization known as SoundExchange represents many sound-recording owners in issuing performance licenses for the use of recordings in non-interactive streaming, such as Internet radio, but for interactive, or “on demand,” play of streamed music, the artist must approach the sound-recording owner directly.

\textsuperscript{16} A “DPD” license is governed by the same compulsory-license provision of the Copyright Act that governs mechanical licenses. 15 U.S.C. 115(d) (2010).


artist should also inform the members of its team responsible for online content of these permission requirements.

C. PRIVACY AND PUBLICITY RIGHTS

In addition to securing the permission of the copyright owners of photographs and videos, the artist should be mindful of the privacy and publicity rights of those individuals appearing in the photographs and videos. In many states, individuals have statutory or common-law rights of publicity, meaning the exclusive right to use their name, likeness, or photograph for commercial purposes. To the extent the artist uses the photograph, for example of a fan, for purposes of promoting the artist's music online, and permission is not obvious by the circumstances, the artist should seek the permission of that fan.

In addition to the right of publicity, the majority of states also recognize a right to privacy, including the right from intrusion upon seclusion, public disclosure of embarrassing private facts, and publicity that places the individual in a false light in the public eye. The artist should guard against the inclusion of photographs or videos of individuals that violate these privacy rights.

With the advent of social networks such as Facebook and Twitter, the line between the artist's career and personal life can become blurred online, heightening privacy and publicity concerns. For example, if the artist uses his or her personal Facebook page publicly to promote the artist's music career, photographs of individuals on the artist's page could be construed as a commercial use and trigger the rights of publicity of those individuals. Because of the blurred line between personal and public personas, such photographs are also particularly susceptible to infringing the photograph subjects' privacy rights. The easiest solution to this problem is to demarcate clear boundaries between the artist's personal and professional online presence and maintain strict privacy controls over the artist's personal web pages where possible.

19 "At present, only nineteen states recognize a statutory right of publicity; twenty-eight states find this right via common law. In the remainder of the states, the right of privacy is either protected under invasion of privacy torts or has yet to be addressed." Lorelle A. Babwah, Climbing in Our Windows & Snatching Our Likenesses Up: Viral Videos & the Scope of the Right of Publicity on the Internet, 12 N.C. J.L. & TECH. ON. 57, 61-62 & nn.23-24 (2010), http://www.ncjol t.org/sites/default/files/Babwah_v120E_57_76.pdf.
V. TRADEMARKS AND DOMAIN NAMES

Before raising his or her profile online, the artist should consider registering his or her own name, any performing names, and logo designs with the U.S. Patent and Trademark Office and in the form of Internet domain names. The artist with a record deal may have contractual restrictions on his or her domain name. The artist should also be wary of cybersquatters. Individuals who have established trademark rights to their name may have a claim to domain names encompassing their name. They may assert these claims in a court of law under the Anticybersquatting Consumer Protection Act (ACPA).

The ACPA establishes civil liability for “cybersquatting” for the registration, trafficking in, or use of a domain name identical or confusingly similar to a protected trademark with the bad-faith intent to profit from the use of that mark. Artists may also assert cybersquatting of their domain names through an administrative proceeding outside the courts under the Internet Corporation for Assigned Names and Numbers (ICANN) Uniform Dispute Resolution Policy (UDRP). Before asserting a cybersquatting claim, however, artists should consider the circumstances surrounding use of the domain name; legitimate, noncommercial fan sites incorporating the artist’s name are often

21 The artist might consider, for example, registering his or her name or performing name in International Class 009 in connection with sound recordings, International Class 041 in connection with live performances, and merchandise categories, such as International Class 025 in connection with clothing. See International Schedule of Classes of Goods and Services, http://www.uspto.gov/trademarks/notices/internationl.jsp. Registration is also available in categories such as online blogs (International Class 041), online retail store services for the sale of merchandise (International Class 035), and websites featuring information in the field of music and entertainment (International Class 041). In an application seeking registration of a performer’s name, the applicant must provide evidence that the mark appears on at least two different works—such as on multiple CD covers—that show the name sought to be registered. A showing of the same work available in different media, i.e., the same work in both printed and/or recorded or downloadable format, does not establish a series. TRADEMARK MAN. OF EXAM. PROC. § 1202.09(a)(i) (5th ed. 2007) [hereinafter TMEP]. The name of a person is registrable as a service mark if the record shows that it is used in a manner that would be perceived by purchasers as identifying the services in addition to the person. Id. § 1301.02(b). The online advertisement of an artist’s live performances constitutes proof of use in the live-performance category.


23 Id.

24 Under the UDRP, the artist must prove (1) identity or confusing similarity with the complainant’s trademark or service mark; (2) lack of legitimate rights or interests in the domain name on the part of the original domain-name registrant; and (3) bad faith. While in a court action, the artist may seek return, cancellation, or alteration of the domain name and damages for misuse; under the UDRP, the artist may only seek the former remedy. ICANN, UNIFORM DOMAIN-NAME DISPUTE-RESOLUTION POLICY (1999), available at http://www.icann.org/udrp/udrp-policy-24oct99.htm (last modified Aug. 13, 2010).
considered lawful uses and not cybersquatting as long as they do not suggest endorsement by the artist.²⁵

Even artists who have not yet gained trademark rights in their name may have protection in their domain name under a lesser known section of the ACPA prohibiting the wrongful use of personal names in domain names.²⁶ That section provides a civil action against the registration of a domain name that consists of the name of another living person or a substantially or confusingly similar name without that person's consent, with the specific intent to profit from such name by selling the domain name for financial gain to that person or a third party.²⁷

Finally, in addition to protecting his or her own trademarks, the artist should secure permission to use any third-party trademarks, such as label and sponsor logos.

VI. PRIVACY POLICIES AND TERMS OF USE

If the artist's website involves the collection of users' personal identifying information, such as names and addresses or credit-card information for the purchase of merchandise, the artist should consider posting a privacy policy. Privacy policies are largely a self-regulating matter, but the government is expected to weigh in on the topic soon, and more regulation could follow.²⁸

Artists whose websites are targeted to children under thirteen or that knowingly collect personal identifying information from children under thirteen should be mindful of the Children's Online Privacy Protection Act (COPPA).²⁹ COPPA applies to the online collection of personal information from children under thirteen, regulating the content of the privacy policy, when and how to seek verifiable consent from a parent, and a website operator's responsibilities to protect children's privacy and safety online.³⁰ The fines for violation of COPPA can be severe.³¹

²⁵ Jacqueline D. Lipton, Commerce Versus Commentary: Gripe Sites, Parody, and the First Amendment in Cyberspace, 84 WASH. U. L. REV. 1327, n.112 (2006), citing Bruce Springsteen v. Jeff Burgar and Bruce Springsteen Club, WIPO Arbitration and Mediation Center Case No. D2000-1532 (Jan. 2001) (declining to transfer domain name of fan site brucespringsteen.com to singer Bruce Springsteen because the site was found to be a legitimate use of the domain name and did not preclude the singer from utilizing brucespringsteen.net).
²⁷ Id.
Artists should also consider posting terms of use on their website including warranties of non-infringement, disclaimers of liability for third-party content, a right of indemnification, rules of conduct for the user (such as a requirement that the user act lawfully and ethically), and shifting of responsibility for the user’s conduct and use of the website onto the user.

VII. CONCLUSION

We have come a long way from the artist press kit of yesterday. The savvy artist will stay abreast not only of the latest online marketing tools but also the law that regulates the use of those tools and protects the fruits of the artist’s labor.