

**IS THE PRACTICE OF MUSIC LAW
REALLY THAT ENTERTAINING?
ABSOLUTELY!**

**SPEAKER:
SUZETTE TOLEDANO**

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Practice of Entertainment Law
Music Copyrights, Trademarks
Rights of Publicity and Marijuana

Starring a Re-MARK-able Cast of Characters

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Suzette Toledano Bio

- Practice located in New Orleans' French Quarter
- Above the House of Blues®
- International client list of "Creatives" includes visual artists; recording artists; songwriters; producers; record labels; music publishers; event promoters; film production companies; Billboard award winners; Oscar and Grammy nominees/winners; and marijuana/cannabis branding entities.
- New Orleans' Top Entertainment Attorney; Best Lawyer; OffBeat Magazine's Best Music Attorney and New Orleans' CityBusiness "Women of the Year" series
- New Orleans' Jazz & Heritage Festival and Foundation, Inc. Board of Directors.
- Tulane University School of Law – Juris Doctor 1979

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Copyright cannot be used to protect an idea.
Copyright protects the expression of an idea.



© George Rodrigue 3

Copyright attaches upon creation.
Exclusive Bundle of Rights

- ✓ Right to **Copy** (Multiple ways)
- ✓ Right to **Create Derivative Works**
- ✓ Right to **Publicly Display** (Artwork)
- ✓ Right to **Publicly Perform** (ASCAP, BMI, SESAC, Dramatic Use)
- ✓ Right to **Distribute** (For sale or for free)
- ✓ Right to **Permit Others and Prohibit Others**



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Music Copyrights
Two copyrights in every piece of music you hear.

- 1 - **Musical Composition © -PA-** Words and Music
Only one Performance Art copyright
PA Parties – Writer and Publisher
- 2 – **Master Recording © -SR-** Sound Recording
Can be many Sound Recording copyrights
SR Parties- Recording Artist and Label



Sesame Street



Marilyn Monroe

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Ways to Copy Musical Compositions

- **Print** (negotiable penny rate)
 - Sheet music, lyrics on CD insert, Karaoke
- **Mechanical** (negotiable up to .091 cents per copy)
 - Pair the words and music with a playback format; physical or download
 - Exception to exclusive rights
- **Synchronize** (negotiable dollars)
 - Pair Audio to Video
- **Electrical Transcription** (negotiable dollars)
 - Pair Audio to Audio



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Examples of Derivatives – a work based on a prior existing work



Original Decal


3- D "Sculpture"

Carpool Lane Mike

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Segue to Music ...

Expression of an idea: A woman cheats on her man.
Right to Make a Derivative Work: Choreographed Dance
Right to Copy: Synchronization License Audio to Video
Right to Publicly Perform in Venue and via Broadcast



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Trademarks

- Identifies the Source of goods and services
- Distinguishes one's goods or services from those of others
- Registered per Class of goods and services

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Trademark Symbols

- **TM** signifies a common law trademark on goods
- **SM** signifies a common law trademark on services
- **®** signifies registration has been approved on the Principal Register or Supplemental Register

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Trademark Spectrum

Most distinctive to least distinctive

Most distinctive qualify for trademark registration

- **Fanciful** e.g. Xerox
- **Arbitrary** e.g. Amazon
- **Suggestive** e.g. Microsoft

Least distinctive

- **Descriptive (including surnames)** e.g. McDonald's – can qualify if mark acquires secondary meaning
- **Generic** e.g. Smartphone - cannot qualify for trademark registration

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General Rule – Obtain a License

- Given that copyrights and trademarks impart **exclusive rights**, the **general rule** is that use by anyone other than the owner **must be licensed**.
- Copyright – e.g. Print licenses, Mechanical Licenses, Synchronization Licenses
- Trademark - Extension of brand licensing e.g. Revlon branded hair dryers
- **First Amendment Balance of Rights**
- **Exceptions for Fair Use and its subset, Parody**

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Fair Use Of Copyright– Transformative Use Use Without a License

- Does the copyright illustrate or support a **point** that the creator is trying to make in the **new work**?
- Does the creator of the new work **use only as much** of the copyright as is reasonably appropriate to illustrate or support the point being made?
- Is the connection between the **point being made**, and the copyright being used to illustrate or support the point, **clear to the average viewer**?
- Credit : Donaldson, Michael C.; Callif, Lisa A. (2014-12-09). Clearance & Copyright, 4th Edition: Everything You Need to Know for Film and Television Silman-James Press.
- See also Four Factors Test: Campbell v. Acuff-Rose Music 510 U.S. 569 (1994)

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Deep Dive... Section 107 of the Copyright Act

- § 107. Limitations on exclusive rights: Fair use⁴⁰
- Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—
- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.
- The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

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Controversial Religion Clip - Yoko sued. Yoko lost.



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Deep Dive...

Credit: Center for Internet and Society at Stanford Law

- LEMON V. PREMISE MEDIA CORP, 556 F. Supp. 2d 310 - Dist. Court, SD New York 2008
- Yoko Ono and EMI sued a documentary filmmaker for using a short clip from the John Lennon song "Imagine" as part of a critique of the lyrics of the song. We defended the filmmaker and successfully argued that the use of the copyrighted song was fair use.
- **Expelled: No Intelligence Allowed** is a controversial documentary about a contentious issue: whether proponents of intelligent design are being unfairly silenced in academia and beyond. Right or wrong; good or bad, it's a film that explores important issues of free speech, faith and science. In exploring these issues, the film uses a fifteen-second clip from the John Lennon song "Imagine" and critiques what it suggests is the overly anti-religious message embodied in the song, both explicitly and implicitly, by suggesting the absence of religion from society can have terrible social consequences. Yoko Ono Lennon sued the film's producers in federal court. EMI, the record label that asserts ownership in the recording of song also sued the producers in state court. Both sought an immediate injunction forcing the removal of "Imagine" from the film. The FUP defended the producers in both actions. We accepted this case because the right to quote from copyrighted works in order to criticize them and discuss the views they represent lies at the heart of the fair-use doctrine. In a comprehensive victory for fair use and free speech, we defeated the attempt to prevent distribution of our client's film.
- The movie thus uses the excerpt of 'Imagine' to criticize what the filmmakers see as the naïveté of John Lennon's views." Citing *Campbell v. Acuff-Rose Music, Inc.*, the court held that this use was transformative because it "adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message."

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Richard Prince – Transformative Fair Use
Use Without a License



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Parody - Use Without a License

1. A new, copyrightable work
2. based on a previously copyrighted work
3. to such an extent that the previous work is clearly recognizable,
4. but not taking more from the work than is reasonably appropriate,
5. that criticizes or comments on the subject matter or style of the previous work, at least in part, and
6. is not likely to invade the market for the previous work.

- Credit: Donaldson, Michael C.; Callif, Lisa A. (2014-12-09). *Clearance & Copyright, 4th Edition: Everything You Need to Know for Film and Television* Silman-James Press.

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Parody of Copyright and Trademark – Barbie World
Mattel v. MCA Records, 296 F.3d 894 (9th Cir. 2002)
Nominative Use and First Amendment Rights



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Branding Trademarked Goods with Copyrighted
Music Synch and Master Use Licenses



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State by State Rights of Personality

- Privacy – expectation to be left alone
- Publicity - economic value in image, likeness
- *Cheatham v. Paisano Publications, Inc.*, 891 F. Supp. 381 (W.D. Ky. 1995)
- With apologies in advance.....

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Worth a thousand words



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Challenges presented in Branding Related to an Illegal Substance

- WILLIE'S RESERVE™
- Contract Provisions
- Territory
- Jurisdiction – waiver of Licensor's domicile state rights of publicity statutes



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Trademark Registration Challenges – use in commerce must be a lawful



Class 16


Class 25

Class 9 and Class 34

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Thank you. Enjoy the outside!

Please feel free to contact me if you have any questions.
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