

THOUGHTS ON PATENT-  
BASHING, OBVIOUSLY

ARE YOU (OR YOUR BOSS) PERSONALLY LIABLE  
FOR YOUR COMPANY'S PATENT INFRINGEMENT?

DO DOCUMENTS GENERATED BY AN  
INVENTOR HAVE TO BE CORROBORATED?

# Intellectual Property Today™

[www.iptoday.com](http://www.iptoday.com)

I. P. Today, 381 W. Northwest Hwy., Palatine, IL 60067

A Publication of Omega Communications

April, 2007

\$9.00

Volume 14, No. 4

## How the Band Protects Its Brand: The Use of Trademarks to Protect and Promote the Musical Artist



*By Christopher R. Chase, Esq. of Frankfurt Kurnit Klein & Selz, P.C.*

# How the Band Protects Its Brand: The Use of Trademarks to Protect and Promote the Musical Artist

BY CHRISTOPHER R. CHASE, ESQ. OF  
FRANKFURT KURNIT KLEIN & SELZ, P.C.

*Mr. Chase is an intellectual property and entertainment attorney with Frankfurt Kurnit Klein & Selz, P.C. in New York. He can be reached at [cchase@fkks.com](mailto:cchase@fkks.com). The author thanks Marc Handelman, Brian G. Murphy and Alexandra VonHockman for their insightful comments.*

*This article was published as a two-part series in the March & April 2007 issues of Intellectual Property Today.*

What's in a name? If you are an individual artist or group in the music industry, there are numerous assets within your professional name, such as goodwill, commercial recognition, and valuable intellectual property rights. The reputation and recognition of an artist's music is built around the artist's professional name, which is what consumers use to identify the artists they enjoy. Traditionally, the artists' name or logo identified their musical performances and recorded music, but now these names, and increasingly, an artist's logo, are doing much more, a fact that has not gone unnoticed by the artists themselves.<sup>1</sup>

In the past, artists in the music industry generally only relied upon revenue from their recorded music and live performances. The landscape of the music industry has changed, however, in recent years. As artists in the music industry become more reliant upon ancillary streams of revenue rather than record sales alone,<sup>2</sup> they must seek out other opportunities for income and can use their names and logos to do so.<sup>3</sup> Not only do artists want increased income, they also want a broad amount of consumer recognition – and can do so with non-recording activities,<sup>4</sup> such as merchandising or third party sponsorships. Artists are now using their names and logos to stand for more than just their music. Thus, the musical artist has become a “brand.”

Third parties, including record companies and advertisers, also want to be a part of that brand. For example, because the economics of the music industry are changing, record companies themselves are now in the “music” business rather than the “record” business, as “music” includes much more than recorded music, such as touring, merchandising, and publishing.<sup>5</sup> Many record labels are creating multiple-platform ventures with artists, as the labels are looking beyond declining CD sales for new sources of revenue.<sup>6</sup> EMI Music has been a big player in this area, and has signed multiple-platform deals with artists such as KORN,<sup>7</sup> ROBBIE WILLIAMS,<sup>8</sup> and the estate of DEAN MARTIN in order to forge a number of relationships “with artists around the world to oversee non-recording aspects of musicians' careers.”<sup>9</sup> Even more significant, Rhino Entertainment has actually taken charge of the complete GRATEFUL DEAD brand – exclusively managing the band's intellectual property portfolio, including the name, likenesses, and trademarks, as a whole.<sup>10</sup> Third parties see the value in artists' brands and want to exploit such value and recognition.<sup>11</sup>

Therefore, an individual artist or group pursuing a career in the music industry should take the necessary steps to protect his, her or its professional name and logo in order to safeguard the “brand.” This protection can be obtained through the use of trademark law. Prior to diving into the music industry, an artist should develop a trademark strategy – from choosing a professional name, logo, and other branding elements to clearing and registering his, her, or its trademarks. This puts the artist in a position to prevent others from using confusingly similar professional names and trademarks, license merchandise, and avoid trademark infringement claims. In the ever changing music industry, an artist should have continuity in its name and logo in order to maintain the selling power that attaches to such property.

Part I of this two-part Article discusses the branding of an artist in the music industry, from the perspective of the artist developing its own brand as well as the extensive

use of the artist's brand by third parties. Part II will present an overview of the use of trademark law in the music industry, including examples of artists that were forced to change their professional name due to trademark concerns and a discussion of issues that are particular to group artists in the industry. Part II will also focus on an additional tool that helps artists protect their brand – state right of publicity laws. This Article advocates development of a useful trademark strategy to establish, protect, and extend the artist's brand, and concludes that the artist's professional name is a valuable commodity in the music industry and must be protected with the use of an effective trademark strategy.

## THE BRANDING OF A BAND

Artists in the music industry no longer focus only on their live performances and recorded music – they are now extending their art to a brand. The “band as a brand” concept operates on two levels. Not only are artists themselves developing their own brands, but third parties frequently partner with artists to help promote corporate brands – thereby extending the reach of the artist's name from recorded music to other fields.

### Artists Promoting Their Own Brand

Much like Proctor & Gamble selling toothpaste or General Mills selling cereal, the artist is also selling its branded product – sound recordings and live musical performances. The artist's name plays an important role in these branded products. For example, if you liked MADONNA's last album, chances are that you will purchase her next album based on the fact that it is “Madonna” who released it.<sup>12</sup> Artists, however, are now selling more than just their two core products.

As artists need to find revenue streams to supplement the royalties from their recorded music, selling merchandise becomes a valuable tool and can become an artist's most reliable source of income.<sup>13</sup> Merchandise can be just as important to an artist's career as the music that the artist creates, as it is both promotional and monetarily valuable. By creating merchandise, artists can turn their logos and names into profits.<sup>14</sup> In addition, not only does merchandise help an artist's bank account, but the promotional value in merchandise is invaluable – such as when a fan buys an artist's t-shirt and wears it around town or puts a sticker of the artist's logo on a notebook. Moreover, unlike their recorded music, which may be dictated to some

extent by the record label for which the music is being created, one of the few areas that an artist can still retain stylistic and creative control is with merchandising.<sup>15</sup>

Take KISS for example. While many artists in the music industry have used their name and logos to sell merchandise, no artist may be more prolific in merchandising than KISS.<sup>16</sup> The group's name and logos, as well as the individual members' painted faces,<sup>17</sup> have been used for action figures, clothing, comic books, condoms, DVDs, board games, coffee, food, coffee mugs, beauty products, necklaces, stickers, puzzles, pinball machines, video games, credit cards, trading cards, lighters, and even a custom-made coffin with band imagery!<sup>18</sup> In addition to their flamboyant stage performances, KISS' merchandising prowess has helped them become one of the most recognized names in the music industry, as well as a significant brand.

Current artists have also gone beyond simple promotional merchandising to help market their music career and have pushed their "brand" into such ancillary and disparate fields as cologne, shoes, bottle openers,<sup>19</sup> skateboards, skin care products,<sup>20</sup> wallets, watches, handbags,<sup>21</sup> bed, bath, and other home products,<sup>22</sup> and hair dye.<sup>23</sup> More often than not, pop and R&B artists, rather than rock artists, tend to expand outside of the music field<sup>24</sup> – from SEAN JOHN UNFORGIVEABLE cologne<sup>25</sup> to JESSICA SIMPSON hair extensions<sup>26</sup> to ANDRE 3000 as a cartoon.<sup>27</sup> Some artists' brands have been dissected from their music careers, and for many artists, their "brand" has become equally or more significant than their music.<sup>28</sup> For example, JIMMY BUFFETT<sup>29</sup> not only promotes his music, he also promotes a laid back, MARGARITAVILLE<sup>30</sup> lifestyle that has taken on a life of its own without Buffett's live performances.<sup>31</sup>

Nevertheless, while extending the artist's brand is important, both for monetary and promotional purposes, artists should avoid diluting their brand with over-exposure. With the move into non-music fields, the great concern is that "the brand will supersede what it was originally intended to support – the music."<sup>32</sup>

### **Artists Promoting Others' Brands**

There are a number of ways that artists promote third party brands – from the licensing of the artist's music in commercials, television programs, or movies<sup>33</sup> to having a corporate tour sponsor or product tie-in. Third parties want to associate their

goods and services with those of a popular musical artist in order to connect with that artist's fan base or perhaps just to associate their goods or services with hip, cool, or iconic artists.<sup>34</sup> Using the artist's name to form that association is very important for such third parties.<sup>35</sup>

Sponsorships or product tie-ins can be mutually beneficial for both the third party and the artist – the third party can associate itself with the artist while the artist often receives much needed monetary support for tours,<sup>36</sup> instruments, recording costs,<sup>37</sup> or necessities such as clothing.<sup>38</sup> Corporate brand partners can help launch an album by providing marketing support in return for having the artist's music featured in a commercial campaign.<sup>39</sup> Moreover, the line between corporate brands and artists may become more blurred, as a corporate brand may align itself with a record label to develop and market an artist in connection with the launch of a product.<sup>40</sup>

The most typical way for artists to promote third party brands is by licensing their music.<sup>41</sup> It is now commonplace for artists to license their work for use in television programs, movies, and advertising campaigns,<sup>42</sup> and consumers have become more accustomed to hearing their favorite artist's music being used for commercial purposes.<sup>43</sup> Artists need to gain exposure and/or stay relevant in a fast-moving industry, and placing music in commercials, television programs or movies is one significant way to do that.<sup>44</sup> At the same time, third parties receive the benefit of having consumers associate a particular song with the third party's products or services.<sup>45</sup>

Rock legends THE ROLLING STONES and THE WHO have had their music featured in commercials, television programs, and films for years.<sup>46</sup> By having their music repeatedly played on the big and small screens, both bands have been able to stay relevant to current consumers.<sup>47</sup> On the other hand, some artists have been able to use the commercial licensing of their music to gain exposure.<sup>48</sup> Both MOBY and THE CHEMICAL BROTHERS are artists who gained great exposure after licensing their music for advertising campaigns and have become go-to artists for music to promote third party products and services.<sup>49</sup> Of course, licensing music for commercial purposes is a relatively new phenomenon that has only occurred in the past twenty years or so<sup>50</sup> and there are still a few artists that staunchly refuse to allow use of their name and music to promote third parties' products

or services,<sup>51</sup> most notably TOM WAITS<sup>52</sup> and JOHN DENSMORE of THE DOORS.<sup>53</sup>

Thus, artists can use their own brand to promote others' brands. If the product of the artist's brand is hip, interesting music, then third parties will want to trade off of that brand.<sup>54</sup> At the same time, the artist receives valuable commercial exposure for its music. Certainly, in order to protect themselves, artists should try to retain some control over where their music, name or likeness will be placed and how the relationship between the third party and the artist is established.<sup>55</sup>

## **THE USE OF TRADEMARK LAW TO PROTECT AN ARTIST'S BRAND**

As discussed in Part One, musical artists are becoming brands used to promote their own, and others', goods and services. So how do artists protect their brand? Through trademark law.

### **Trademark Law in the Music Industry**

A trademark or service mark is a word, name, symbol, or device<sup>56</sup> that informs the public of the source of the goods or services being offered, and assures the public of the legitimacy and quality of the goods or services being offered. Generally referred to on the whole as just "trademarks," service marks are used to identify services offered to the public, while a trademark, on the other hand, distinguishes the words, names, symbols, or devices used on tangible physical goods. In the music industry, an artist's professional name may function as a service mark for entertainment services if it is used to identify and distinguish the service of providing live performances from other artists<sup>57</sup> or as a trademark for a series of musical recordings or other merchandise such as t-shirts, stickers, and posters.<sup>58</sup>

In the United States, trademark and service mark rights are created by use in commerce and the resulting development of "secondary meaning"<sup>59</sup> – the public's recognition and association of the mark with a source of goods or services. Because rights are based on use, an artist need not register his, her or its name in order to claim rights in or protection for that name as a mark.<sup>60</sup> The artist must only be the first party to continuously use the name in commerce for the specific goods and services offered under that name.<sup>61</sup>

Nevertheless, although it is not required to protect a mark, federal registration of a trademark or service mark provides certain statutory benefits that are not provided by an unregistered or "common law" mark,

such as 1) prima facie evidence as to the validity of the registered mark;<sup>62</sup> 2) validity of the registration itself;<sup>63</sup> 3) the registrant's ownership of the mark;<sup>64</sup> 4) constructive notice of the registrant's claim of ownership;<sup>65</sup> and 5) the exclusive right to use the mark in commerce on the goods or services specified in the registration certificate.<sup>66</sup> Registering the professional name as a trademark or service mark with the United States Patent and Trademark Office ("USPTO") is truly the best way to protect it because registration prevents third parties and departing group members from capitalizing on the name.<sup>67</sup> Essentially, although an artist may have a common law trademark or service mark in its name because of its prior use of that name, it is always prudent to register the mark with the USPTO because such registration presumes the validity of the mark and gives the artist a stronger right to prevent confusingly similar uses of such mark by others in the United States.<sup>68</sup>

In order to claim trademark or service mark rights in its professional name, the most significant thing an artist can do is to deliberately and continuously use the mark in public over a geographically extensive area to identify itself.<sup>69</sup> This use must be continuous, as it is possible that if an artist held trademark rights to its name and ceased touring, making and releasing records, and receiving royalties, it would be deemed to have stopped use of its name because the public would no longer identify the artist with activities in the music industry.<sup>70</sup> Therefore, an artist should actively perform and offer, or at least collect royalties for, records, CDs or other merchandise under its professional name to maintain trademark or service mark status.<sup>71</sup>

Finally, the following are well-known examples of the various types of trademarks and service marks available in the music industry: 1) group names such as LED ZEPPELIN,<sup>72</sup> PEARL JAM,<sup>73</sup> and SPICE GIRLS;<sup>74</sup> 2) individual performer names such as SNOOP DOGG<sup>75</sup> and PRINCE;<sup>76</sup> 3) individual artists who perform under their real names such as MICHAEL JACKSON<sup>77</sup> and DAVE MATTHEWS;<sup>78</sup> 4) music industry logos such as THE ROLLING STONES "LIPS" logo,<sup>79</sup> the ARISTA "A" logo,<sup>80</sup> and even the faces of the members of KISS;<sup>81</sup> and 5) music industry companies' names such as the GHOSTLY INTERNATIONAL<sup>82</sup> record label and the VIRGIN<sup>83</sup> record label.

### **Choosing and Clearing the Artist's Name**

Like any other trademark, when selecting an artist's professional name it is important to adopt a name that is both distinctive and unique. The more distinctive the name, the more effective the protection the name has as a trademark. Moreover, an artist should not only choose a distinctive name to protect its own identity, but the artist needs to avoid infringing upon other parties' names.<sup>84</sup> Because the likelihood of confusion between two marks is the hallmark for trademark violations, a new artist should not choose a professional name that is identical to or confusingly similar to an existing name in the music industry. Litigation over the proper ownership of a name requires both time and money, and there is a risk that the artist could lose the right to use the name. Because the goodwill in its name is all a new artist has when starting its foray into the music industry, starting over is an unattractive option. Therefore, it is extremely important for an artist to clear his, her, or its professional name prior to significant use in the industry.

There have been numerous instances where an up and coming artist had to change its name due to trademark problems. For example, DINOSAUR JR. (formerly DINOSAUR),<sup>85</sup> THE HOPEFULS (formerly THE OLYMPIC HOPEFULS),<sup>86</sup> GREEN JELLY (formerly GREEN JELLÖ),<sup>87</sup> AL FATZ (formerly FAT AL),<sup>88</sup> DEATH FROM ABOVE 1979 (formerly DEATH FROM ABOVE),<sup>89</sup> and THE VERVE (formerly VERVE)<sup>90</sup> all had to change their professional names due to various trademark issues, the latter two involving similar record label names rather than other artist names. Moreover, commercial success does not guarantee litigation success: relative unknowns have forced successful artists to change their professional names.<sup>91</sup> A recent example involved CBS' rock band reality show *Rock Star: Supernova*, wherein the band, comprising famous musicians and the show's winner, would be called SUPERNOVA. A lawsuit filed by a lesser known band called SUPERNOVA forced the reality band to change its name (not too creatively to ROCK STAR SUPERNOVA).<sup>92</sup> Even the U.S. Postal Service was not pleased to see that there was an artist called "The Postal Service," but an amicable resolution allowed the artist to retain its name.<sup>93</sup>

Because the music industry is global, artists must also choose a name that will not infringe on foreign artists' marks if the artist desires to reach foreign markets. In the mid-

1990's, popular British bands SUEDE and THE CHARLATANS were forced to change their names for the U.S. market due to artists' prior uses of those names in the United States.<sup>94</sup> SUEDE's change to THE LONDON SUEDE and THE CHARLATANS' change to THE CHARLATANS U.K. may have harmed both bands' chances at widespread U.S. success, as they could not rely on the goodwill associated with their famous name back home. Therefore, it is imperative that an artist conduct a global music industry search in order to avoid any potential trademark conflicts.

It is simply not enough to take a trip to the local record store to clear an artist's name. An artist must check numerous sources to survey the global music industry, such as the databases of the performing rights societies (e.g., ASCAP, BMI, SESAC) and musicians' unions (such as the American Federation of Musicians), music magazines including *Rolling Stone*, *Spin*, and *Billboard*,<sup>95</sup> and review popular music websites such as MySpace, PureVolume, Pitchfork, All Music Guide, and The Band Register.

Finally, having the clear right and title to an artist's professional name is necessary if the artist seeks to sign a recording contract or license its name for merchandising purposes. Because record labels will need to use the name in connection with the marketing and sale of pre-recorded audio and other merchandise bearing that name, they will generally not sign an artist unless that artist owns the rights to its name, free and clear of any third party rights<sup>96</sup> and will require that the artist in the record contract represent and warrant to this effect.<sup>97</sup>

### **Protection of Artists' Names**

Recognizing the value of an artist's name as a mark, courts have frequently applied trademark law to protect the professional names of artists.<sup>98</sup> As noted in the Part One of this article, rights to an artist's professional name and the right to perform under that professional name are significant rights in the music and recording industry.<sup>99</sup> Such rights are monetarily valuable<sup>100</sup> to both the artist and record companies alike, and preventative legal measures should be taken in order to ensure protection of the name.

Regardless of whether it is registered or not, the artist's professional name will only have trademark protection in the field for which the mark is used, and in the logical zone of expansion of that field.<sup>101</sup> For artists, this field will primarily include

musical performances and pre-recorded audio and video. Ancillary goods, such as posters and t-shirts, may be within the logical zone of expansion, but the artist's professional name often needs to achieve secondary meaning in order to have trademark protection for such goods.<sup>102</sup>

Once the artist's professional name is properly used as a trademark or service mark, the artist must enforce its rights to that mark. No other party in the industry should use or exploit the professional name without permission, if at all.<sup>103</sup> Not protecting the name could be perceived as demonstrating the inherent weakness of the artist's name as a mark. Therefore, the artist must prevent other parties in the music industry, including other artists or bootleg merchandisers,<sup>104</sup> from using or exploiting his, her, or its valuable mark.

Artists should also register their professional name as an Internet domain name.<sup>105</sup> While this is not a substitute for trademark registration, operating a website with that domain name would go a long way to show use of the name as a mark in commerce and would put others on notice of the artist's use of the name in the music industry.

## **Trademark Issues for Group Artists**

### **CONCEPT GROUPS**

Because the owner of trademark rights is the person or entity that controls the quality of the goods or services offered under the mark,<sup>106</sup> the owner of trademark rights in an artist's name is not always the artist. This is especially true with "concept groups" – those groups that are the creations of a producer, promoter, or manager and whose members are essentially interchangeable parts.<sup>107</sup>

Generally speaking, a concept group is created by a producer, promoter, or manager who (essentially) hires performers to play the roles in the group and directs the group's performances.<sup>108</sup> Examples of such concept groups include NEW KIDS ON THE BLOCK, MENUDO, THE MONKEES, SPICE GIRLS, BACKSTREET BOYS, and N\*SYNC. While not necessarily a group, AMERICAN IDOL is one of the most recent and most popular concept phenomena.

Where the producer, promoter, or manager of the concept group controls the quality of goods and services associated with that group, such person is the valid owner of the trademark rights in the group's name, even if this person is not in the group itself.<sup>109</sup> Courts have found that ownership of a concept group's professional name in the name of the producer, promoter, or man-

ager is legally appropriate where the public associates with the concept group characteristics or a style that is or are controlled by the producer, promoter, or manager.<sup>110</sup>

Ownership of the concept group's name is extremely important, because the owner essentially owns the shell of the group itself and just rotates performers in and out without necessarily changing the group's overall identity. Successful concept groups not only generate a substantial amount of money through their live performances and sound recordings, but also make considerable sums of money with merchandising and ancillary goods. For example, NEW KIDS ON THE BLOCK sold nearly \$75 million in concert tickets and over \$1 billion in merchandise during the group's heyday in 1990.<sup>111</sup> Also, Epic Records recently acquired an equity stake to re-launch the Latino concept group MENUDO, in order to resurrect the brand by offering a new album and a reality show in 2007.<sup>112</sup> The current concept group money leader is AMERICAN IDOL, which in 2004 alone generated more than \$900 million in sales of TV advertisements, sound recordings, merchandise, and concert tickets,<sup>113</sup> and was conservatively valued at the start of 2007 as a \$2.5 billion franchise.<sup>114</sup> Therefore, the ownership of such concept group names becomes a significant point because such owner will control the nature and quality of the goods and services being offered under that name, even if the individuals in the group have changed or the group has been dormant for a number of years.

### **DISSOLUTION AND/OR MEMBERSHIP CHANGES**

In group situations, the dissolution and/or change of membership of the artist presents difficult problems of ownership of the trademark rights in the artist's professional name. There have been numerous lawsuits regarding ownership of a group name either following the dissolution of the group or when former members attempt to use the name, while the original group continues to use it.<sup>115</sup>

A group that disbands does not immediately abandon exclusive rights in its name.<sup>116</sup> Thus, a subsequent artist should not use such name, because the subsequent artist cannot assume that the name is no longer being used by the original artist.<sup>117</sup> It is often the case that a group continues to sell sound recordings and collect royalties even if it is not performing, and therefore continues to use the name as a mark in commerce.

Also, when confronted with the issue of departing group members who use the name of their former group, courts have determined that members of a group do not retain rights to use the group's name when such members leave that group.<sup>118</sup> However, the former members may properly refer to themselves as a "former member of [group]" or "original member of [group]" when advertising his or her new entertainment services or sound recordings.<sup>119</sup>

Because of the difficult issues that face dissolved groups or the departing members of groups, it is important to have an agreement among the members of the artist regarding the use of the group's name.<sup>120</sup> Often a group will be a partnership or incorporated entity; therefore, all group partnership or internal corporate agreements should specifically outline the rights to the group name and what will happen to that name upon dissolution of the group or the departure of a member. Another way to prevent the problem of departing members using the group's name is to have the group, as a partnership or incorporated entity, federally register the name as a mark. If the group as a whole owns the registered mark, then the group can prevent any departing member from using such name, while continuing to protect the name of the group against other third party uses.<sup>121</sup>

## **RIGHTS OF PUBLICITY UNDER STATE LAW**

In addition to the use of trademark law to protect the artist's name, state right of publicity laws can offer additional protection.<sup>122</sup> Although trademark law tends to overlap with state right of publicity laws, these state laws generally protect a person's name, picture, voice, or likeness against commercial appropriation regardless of whether one of these attributes serves a source identifying function<sup>123</sup> or not.<sup>124</sup> Such rights have been extended to an artist's professional name<sup>125</sup> – be it the artist's actual name or stage name.<sup>126</sup> For example, two popular artists have recently sued third parties for unauthorized use of the artists' names, images, and likenesses. The band WEEZER sued Miller Brewing Co. and its advertising agency under both right of publicity and trademark laws for using the name WEEZER in advertisements promoting Miller's beer, arguing that its name was being commercially appropriated without authorization.<sup>127</sup> Also, the singer JACKSON BROWNE sued Bloomingdale's and clothing manufacturer Natalie and Friends under both right of publicity and trademark laws for using

Browne's name and image on t-shirts sold at the department store.<sup>128</sup>

Because artists often license their names and likenesses for commercial exploitation,<sup>129</sup> the artist has a strong interest in preventing unauthorized use of their publicity rights and can do so through both right of publicity and trademark laws.<sup>130</sup>

## DEVELOPING AN EFFECTIVE TRADEMARK STRATEGY

In order to successfully protect its professional name, the artist should develop an effective trademark strategy – from choosing a professional name to enforcing the rights included in such name – as well as protecting his, her, or its rights of publicity.

As noted above, when choosing a professional name, an artist should keep in mind that the more distinctive the name, the more effective the protection the name has as a trademark.<sup>131</sup> Prior to choosing a name, the artist should not only perform internet searches and review music industry websites and publications to determine whether another artist or music industry player is using a confusingly similar name,<sup>132</sup> but the artist should also conduct a preliminary search of the USPTO online database.<sup>133</sup> Such a search would give the artist an idea of whether the name appears clear from a trademark perspective.<sup>134</sup> It may also be useful to order a comprehensive search from a trademark search vendor in order to gain a clearer picture of the possibility of using the name as a mark, as these searches generally cover both federal and state trademarks, common law trademarks, corporate names and trade names.<sup>135</sup> Nevertheless, since trademarks in the United States exist by virtue of use rather than registration, no search is completely effective.

After the artist has evaluated the risks associated with the results of the trademark searches and has decided to go forward using a specific professional name, applying for federal registration of the name as a trademark and service mark should be the next step.<sup>136</sup> Trademark applications with the USPTO are filed within specific classes of goods or services.<sup>137</sup> The artist should apply for a trademark for its name in Class 9, which covers sound recordings and audio-visual recordings, and Class 41, which covers live performances, production services, and services offered through the artist's website. Other relevant classes of goods for merchandising purposes include Class 16, which covers printed material such as books, magazine, posters, and stickers, and Class 25, which includes

t-shirts and hats. Once registered, the artist will have to maintain the trademark registration in order to keep the registration "alive" in the USPTO.<sup>138</sup> Nevertheless, the most important thing that an artist can do to maintain trademark rights in its name is to use the name consistently and continuously in commerce over a geographically extensive area for the goods and services that the artist provides.

Once the artist has started accruing trademark rights in its name, the artist will have to begin policing the name for the use of confusingly similar names in the industry. This will include issuing cease and desist letters to any other party thought to be using a confusingly similar or potentially diluting name. If necessary, the artist may need to enforce its rights in the name by bringing opposition or cancellation proceedings in the USPTO, or lawsuits in federal or state courts.

All of these steps are necessary precursors to licensing an artist's "brand," as third parties will not want to associate themselves with a weak or diluted brand or one that may lead to lawsuits based on a trademark claim. When a third party is interested in licensing the artists' trademark as part of the brand, the artist should take care to create a licensing agreement that is both monetarily valuable and sufficient to protect the artist's rights. Although there is no one "correct" way to structure a trademark licensing agreement on behalf of the artist, the following are a few helpful tips to consider when drafting the agreement. The licensor of the trademark, which could include the artist, should focus on: 1) ensuring quality control over the use of the trademark; 2) specifically defining the rights being licensed; 3) retaining approval rights for how and on which products the trademark are used; 4) assessing the risk of inadvertent creation of a franchising agreement; 5) licensing the trademark for a short term, in a limited territory, and with a broad termination right; 6) including a provision allowing the licensor to terminate the agreement if the licensee has not reached certain sales goals; 7) including a "licensee estoppel" provision that prevents the licensee from challenging or interfering with the licensor's rights to use and/or register the trademark; and 8) requiring the licensee to carry product liability insurance. The quality control provision may be the most important provision for a licensor, as a trademark license that does not contain such a provision, or under which no quality control has been exercised, may be consid-

ered a "naked license" and may result in the an abandonment or tarnishment of the licensor's trademark.<sup>139</sup>

Additionally, licensing the "brand" may include the artist's rights of publicity. Under state law, a written release is generally necessary whenever a person's rights of publicity, *e.g.*, name, picture, voice, or likeness, are used in advertising or for the purposes of trade.<sup>140</sup> Like licensing a trademark, when an artist is licensing his, her, or its rights of publicity there are a few key points on which the artist should focus: 1) the grant of the rights, including the specific attributes of the artist being licensed; 2) the type of media where the artist's rights will be used, such as television, radio, print, and the internet; 3) the manner of use of the artist's rights; 4) the geographic territory where the rights will be used; 5) the breadth of the artist's termination rights; and 6) the artist's creative control over the use of the rights, including approval rights for any use. Because the artist wants to ensure that his, her, or its image will not be tarnished in any way, the grant of rights clause may be the most significant provision, as it should be very specific as to each and every attribute being granted.

While this section is not an exhaustive list of steps to take in order to protect an artist's trademark rights, it should be viewed as a helpful summary when establishing a trademark and right of publicity strategy.

## CONCLUSION

The rights in an artist's professional name are extremely important. Artists not only promote corporate branding but they themselves have become brands. The artist's professional name therefore is a valuable commodity that helps consumers identify the artist's goods and services. It is imperative that an artist develop a strong trademark strategy, which includes clearing his, her, or its professional name before offering goods or services under that name, and protecting the name once it is used in commerce. While it may seem like an expensive proposition during the start-up phase of an artist's career, obtaining trademark protection is well worth the effort if the artist wants a long lasting career in the industry. By doing so, the artist will protect his, her or its identity and brand. **IPT**

## ENDNOTES

1. Alternative rocker Evan Dando recently put his group, THE LEMONHEADS, back together in order to preserve the legacy of the group's name. Tom Lynch, Evan Dando Lives, NEW CITY CHICAGO, December 5, 2006, available at <http://www.newcitychicago.com/chicago/5979.html> (regarding the reason he got the band back together, Dando stated “[B]ecause I did put a lot of work into the band, the trademark, that name. I think we could have done a little better. Leave a better legacy.”).
2. See Tamara Conniff, Spears tour merchandise sales lead female acts, THE HOLLYWOOD REPORTER, April 26, 2004 (According to the CEO of a leading merchandising and licensing company, “The world of the record royalties and significant earnings from records is down dramatically.”).
3. See Joseph Allen, Concert merchandise – not ticket sales – is where bands make the most money, ROLLING STONE, July 14, 2004 (Popular singer-songwriter JOHN MAYER said of merchandise sales: “You’re not making that much money off records anymore...merch is one of the last bastions of individuality, commerce, and style that an artist has left.”); Conniff, supra note 2 (“Merchandising also is becoming many music stars’ answer to lackluster record sales.”); see generally Chuck Salter, Way Behind the Music, FAST COMPANY, February 2007 (discussing how artists today can use the Internet to not only distribute music, but to sell merchandise and establish fan clubs).
4. Close to fifteen years ago, Federal Appellate Judge Alex Kozinski noted the significance of artists’ non-recording careers. “No longer are entertainers limited to their craft in marketing themselves to the public. This is the age of the multi-media publicity blitzkrieg: Trading on their popularity, many entertainers hawk posters, T-shirts, badges, coffee mugs and the like – handsomely supplementing their income while boosting their public images.” The New Kids on the Block v. News America Publishing, Inc., 971 F.2d 302, 304 (9th Cir. 1992). Just imagine what Judge Kozinski would think of the “multi-media publicity blitzkrieg” of 2007.
5. See Jeff Leeds, Squeezing Money from the Music, N.Y. TIMES, December 11, 2006 (“[T]he big record companies, whose fortunes are still overwhelmingly tied to CD sales, are taking a far more expansive view of how to carve out pieces of the music economy ... including recording sales, music publishing, concert ticket and merchandise sales and other sources of revenue.”); Alan Light, A Resurrection, of Sorts, for the Grateful Dead, N.Y. TIMES, July 10, 2006 (According to a vice president at Rhino, “The music industry has to change. We can’t just put CD’s out to retail. We need to be more involved with protecting the legacy of the artists.”); EMI Group Press Release, Robbie Williams and EMI Sign Groundbreaking Deal, October 2, 2002, at [www.emigroup.com/Press/2002/press7.htm](http://www.emigroup.com/Press/2002/press7.htm) (regarding the Robbie Williams deal, the press release stated: “The deal continues a trend towards an integrated relationship in the entertainment business that will provide a multi-platform approach to the respective elements of recording, live work, film and television.”); Ayala Ben-Yahuda, Epic to Sign Menudo; MTV Plans Reality Show, BILLBOARD, October 13, 2006 (Epic Records purchased an equity stake in Menudo Entertainment, which gives Epic a cut of the re-launched Latin boy band MENUDO’s by-products such as touring, merchandising, ringtones, a cartoon series, and other branded revenue streams).
6. Leeds, supra note 5 (“Lately, the major labels have in effect tried to move into the talent management business by demanding that new artists seeking record contracts give their label a cut of concert earnings or T-shirt and merchandise revenue – areas that had once been outside the labels’ bailiwick.”); Light, supra note 5; see also Conniff, supra note 2 (According to the CEO of a leading merchandising and licensing company: “The world of the record royalties and significant earnings from records is down dramatically.”).
7. KORN agreed to a multiple rights venture with EMI Music, making EMI a partner in the band’s overall business, which includes KORN’s publishing, touring, merchandising and multimedia activities. Light, supra note 5.
8. ROBBIE WILLIAMS signed a multiple rights contract with EMI Music, where the label “will take a share of the profits from his commercial activities outside of record sales” – i.e., his non-recording activities, which include touring, publishing, and merchandising. EMI Group Press Release, supra note 5; Paul Gallagher, Record Deal Will Keep EMI Rocking, THE SCOTSMAN, October 3, 2002.
9. EMI Group Press Release, EMI Enters Into Worldwide Partnership with Dean Martin Trust, October 30, 2006 at [www.emigroup.com/Press/2006/press67.htm](http://www.emigroup.com/Press/2006/press67.htm) (EMI Music will now act as the exclusive licensing agent for DEAN MARTIN’s name, image, likeness, as well as the marketer for Martin’s recording catalogues).
10. In July 2006, the GRATEFUL DEAD signed an exclusive licensing agreement with Rhino Entertainment to manage all of the band’s intellectual property – the name, likenesses, logos, web site, and merchandise. Unlike the EMI “partnerships,” Rhino is managing the coordinated intellectual property portfolio rather than dealing with a piece by piece approach to the individual intellectual property rights – Rhino is actually managing the whole brand. Light, supra note 5.
11. See Light, supra note 5 (discussing the KORN and GRATEFUL DEAD deals); see also Greg Levine, SFX Founder to Manage Elvis Presley Estate, FORBES.COM, December 16, 2004; Press Release, Robert F.X. Sillerman and Elvis Presley Enterprises Announce Partnership, at [www.elvis.com.au/presley/news/printer\\_lisa\\_marie\\_presley\\_sells\\_elvis\\_rights.shtml](http://www.elvis.com.au/presley/news/printer_lisa_marie_presley_sells_elvis_rights.shtml) (Robert F.X. Sillerman and his company CKX, Inc. purchased an 85% share of all trademark rights to ELVIS’ name and likeness, as well as other intellectual property, from Lisa Marie Presley for \$53 million in cash and other payments including preferred stock and debt repayments).
12. Unlike toothpaste and cereal however, most artists evolve over time – in both musical style and appearance. An artist’s “brand” may be precisely that – the artist’s adaptation and reinvention.
13. Allen, supra note 3 (“[M]any touring rock bands find that their most reliable sources of income are from selling T-shirts, posters, stickers and other merchandise while they’re on the road.”). A founder of a merchandise manufacturing and distribution company stated that “merchandising, for a lot of our artists, is an important part of their income, sometimes more so than record sales.” Id. See also Salter, supra note 3 (discussing the importance of merchandise sales for an artist’s career).
14. In 2004, singer-songwriter Chris Carrabba of DASHBOARD CONFSSIONAL, while discussing the importance of merchandise sales to his band, stated “Merch sales are what kept us going. Even now [after the band had one platinum record and two gold records], we’re still not making our living from playing the shows. Merch is where we make our profit.” Allen, supra note 3. During that same year, BRITNEY SPEARS’ U.S. tour would have made \$125,000 per show in merchandise sales alone, \$50,000 to \$60,000 of which would have been hers, had the tour not been cancelled. Id.; Conniff, supra note 2 (at the shows that actually occurred during that tour, merchandise sales averaged \$150,000-170,000 per night, reaching a high of \$180,000 at the Los Angeles show; sales for Spears’ tour merchandise reached a total of \$30 million for her tours between June 1999 and April 2004.). See also New Kids, 971 F.2d at 304 (discussing the various goods on which the NEW KIDS name and logo appeared).
15. See Allen, supra note 3 (Popular singer-songwriter JOHN MAYER said of merchandise: “Besides the money, it’s about having one more way to make your mark stylistically and thematically. You’re not making that much money off records anymore...merch is one of the last bastions of individuality, commerce, and style that an artist has left.”); Salter, supra note 3 (noting that JOHN LEGEND protects his brand by retaining control over the relationship between his fans and his music; he has created an online operation to sell merchandise, promote his tour and recordings, and communicate with his fan clubs).
16. See Sandra O’Loughlin, Rock ‘n Roll Band KISS To Launch Fragrance Brand, BRANDWEEK, February 13, 2006 (“KISS has licensed its name to more than 2,000 product categories, from lunch boxes and comic books to credit cards and condoms to become nearly a one-billion-dollar brand.”).
17. See Part II, Rights of Publicity under state law, infra regarding protection for an individual’s likeness through state right of publicity laws.
18. See O’Loughlin, supra note 16 (noting the various goods and services offered under the KISS name, including a beauty and fragrance collection, lunch boxes, comic books, credit cards, and condoms); Lauren David Peden, KISS Rocks on With New Fragrance and Coffeehouse, FASHION WIRE DAILY, June 8, 2006 (discussing the KISS fragrances and KISS coffeehouse); Press Release, Official ‘KISS@ Kaskets’ let KISS@ Fans Rock and Roll for Eternity, June 12, 2001, available at [www.signaturesnetwork.com/press.php?diary\\_id=13&mode=view](http://www.signaturesnetwork.com/press.php?diary_id=13&mode=view), (discussing the casket offered by KISS’ merchandising company Signatures Network, a leading merchandise licensor). Along the way, the band and its members have registered with the United States Patent & Trademark Office their names, logos, and even the individual members’ painted faces as trademarks for most of these goods and services, all in addition to their musical performances. See USPTO Trademark Reg. No. 1055765 (musical performances); USPTO Trademark Reg. No. 1153088 (registered logo for, *inter alia*, necklaces, comic books, greeting cards, posters, stickers, pins, and puzzles); USPTO Trademark Reg. No. 3167370 (action figures and dolls); USPTO Trademark Reg. No. 3008602 (shirts, T-shirts, jackets, and caps); USPTO Trademark Reg. No. 2106028 (comic books); and USPTO Trademark Reg. No. 2596687 (shirts, T-shirts, jackets, and caps).
19. See USPTO Trademark Reg. No. 2912756 (KORN, which is owned by the rock group KORN for various goods and services unrelated to entertainment services).

20. See USPTO Trademark Reg. No. 2878296 (GLOW BY J. LO, which is JENNIFER LOPEZ's fragrance and skin care line).
21. See USPTO Trademark Reg. No. 3142477 (J. LO, JENNIFER LOPEZ).
22. See USPTO Trademark Serial No. 78690920 (DIDDY, which is a pending trademark application owned by Sean Combs for numerous goods and services other than entertainment services).
23. See USPTO Trademark Serial No. 78748561 (JESSICA SIMPSON, which is a pending trademark application owned by Jessica Simpson for numerous goods and services unrelated to entertainment services).
24. When Marketers Become Record Labels, MADISON + VINE.COM, November 9, 2006, at [www.adage.com/madisonandvine/new.pl?newsId=113039](http://www.adage.com/madisonandvine/new.pl?newsId=113039) ("Partnership deals are definitely de rigueur for artists in genres like hip hop, country, and pop... Particularly in hip hop, racking up endorsement deals is a rite of passage."). On the other hand, rock bands tend to partner up with corporate brands, in a less visible way, such as through tour sponsorship. Id. But see Jenny Peters, Tommy Lee Joins the Clothing 'Revolution', FASHION WIRE DAILY, November 20, 2006 (discussing rocker TOMMY LEE's foray into clothing with the launch of "TL for PL" line in association with the People's Liberation label).
25. See USPTO Trademark Serial No. 78656133.
26. See USPTO Trademark Serial No. 78748561.
27. ANDRE 3000 has licensed his name, image, and likeness for an animated series entitled "Class of 3000" which airs on the Cartoon Network. See [www.cartoonnetwork.com/tv\\_shows/classof3000/index.html](http://www.cartoonnetwork.com/tv_shows/classof3000/index.html).
28. For example, SEAN "P. DIDDY/PUFF DADDY" COMBS' individual album sales and those of his record label, Bad Boy Entertainment, have been in decline while his fashion line and other outside business ventures are on the rise. See Tamara Conniff and Bill Werde, Diddy: The Saga Continues, BILLBOARD, October 4, 2006, available at [http://www.billboard.com/bbcom/feature/article\\_display.jsp?vnu\\_content\\_id=1003220466](http://www.billboard.com/bbcom/feature/article_display.jsp?vnu_content_id=1003220466) (noting that Combs' SEAN JOHN clothing line totals \$400 million in sales a year and his SEAN JOHN Fragrances is part of the Estee Lauder Company; but also discussing the lack of musical hits in recent years); Roger Friedman, Diddy Smells More Money, FOX NEWS.COM, February 2, 2006, available at <http://www.foxnews.com/story/0,2933,183535,00.html> (discussing the launch of Combs' "Unforgivable" fragrance); Phyllis Furman, Puffy's Tuning Up a Deal, N.Y. DAILY NEWS, February 8, 2005, available at <http://www.nydailynews.com/business/story/278982p-239050c.html> (noting the lack of recent hits from Combs' label, the article states that "Sources said Combs has been distracted by his other business ventures and has not paid enough attention to the label.>").
29. USPTO Trademark Reg. No. 2201538 (for musical performances, sound recordings, guitar picks, and beverage ware, among other things).
30. JIMMY BUFFETT has over 100 trademark registration and pending applications using the mark MARGARITAVILLE. See e.g. USPTO Trademark Reg. No. 1642132 (for clothing and night club services); USPTO Trademark Reg. No. 1831949 (for musical sound and video recordings).
31. See Singer Buffett Wins Trademark Settlement, REUTERS, November 28, 2006 (Buffett "went on to parlay his laid-back Gulf Coast image into a business empire that included a Margaritaville clothing line and nightclub chain."). However, do not let Buffett's laid-back persona fool you – he aggressively enforces his trademark rights throughout the country. Id. (discussing a long-running legal battle with an individual selling Buffett-labeled items over the Internet); Singer Buffett Sues Alleged Trademark Infringer, REUTERS, November 13, 2006.
32. Nick Southall, And Now a Tune From Our Sponsor, GUARDIAN UNLIMITED, September 29, 2006; see also supra note 28 discussing SEAN "P. DIDDY/PUFF DADDY" COMBS' lack of recent hits but success in his non-music related businesses.
33. Although music in television programs and movies may not necessarily be promoting a commercial brand per se, music in such artistic works can form a branding association. For example, THE WHO's "Who Are You?," which is used as the theme for the opening credits of the hit CBS show *CSI: Crime Scene Investigation*, is arguably an integral part of the show, as the song's chorus relates to the main action of the show – a group of investigators trying to find out who a victim is.
34. Nina M. Lentini, Who Is That Wearing That Milk Mustache?, N.Y. TIMES, January 4, 2007 (discussing LG Mobile's use of the teenage pop star RIHANNA, "whose songs appeal to the young audience [LG Mobile] is aiming for."); Jon Fine, Getting To The Hipsters, BUSINESSWEEK ONLINE, July 5, 2005 (discussing the sponsorship by Levi's of a music tent at the influential South By Southwest music conference where Levi's can specifically target the important twentysomething segment that the company desires); Valerie Block, Death of the Advertising Jingle, ADAGE.COM, February 3, 2003 (discussing how licensed music is harming the advertising jingle business, as more advertisers are licensing songs rather than composing jingles, which "aren't considered cool and hip at the moment."); Patricia Winters Lauro, Forget Jingles, Viewers Prefer Familiar Tunes, N.Y. TIMES, November 8, 1999 (noting that advertising agencies will often use new and innovative music in order to reach a particular audience, usually young people).
35. Of course, these third parties should seek permission from the artist in order to associate its goods or services with such artist. In 2005, Nike infamously used the name and cover art from the first E.P. of the fiercely independent artist MINOR THREAT without authorization from either the artist or its record label in order to promote Nike's "Major Threat" skateboarding tour. See Chris Harris, Minor Threat's Ian MacKaye Outraged By Nike's Major Threat Skate Tour, MTV NEWS, available at [www.vh1.com/news/articles/1504742/06272005/minor\\_threat.jhtml](http://www.vh1.com/news/articles/1504742/06272005/minor_threat.jhtml); Jim Edwards, Out of the Box: Punk's Not Dead – Just Old, BRANDWEEK, October 23, 2006. Nike subsequently apologized for the tour poster, made every effort to remove and dispose of all the posters, and made clear that the company had no relation with the band or its label, both of whom had not endorsed Nike's products. Letter from Nike Skateboarding to Minor Threat, Dischord Records, and fans of both, June 27, 2005, available at [www.nike.com/nikeskateboarding/v2/letter/](http://www.nike.com/nikeskateboarding/v2/letter/). See also Jennifer Quinn, Ska band irritated by Coke commercial, ASSOCIATED PRESS, January 3, 2007, available at [http://news.yahoo.com/s/ap/20070103/ap\\_en\\_mu/britain\\_band\\_vs\\_coca\\_cola&printer=1](http://news.yahoo.com/s/ap/20070103/ap_en_mu/britain_band_vs_coca_cola&printer=1) (discussing the unauthorized use of a song and its accompanying video from an unsigned London ska band 7 SECONDS OF LOVE by Coca-Cola Co. in a commercial for its Coca-Cola Light product in Argentina).
36. See Mike Beirne, Rolling Rock Rolls with Rock 'n Roll, BRANDWEEK, January 23, 2006 (discussing Rolling Rock's sponsorship and donations for the "Garage Rock" club shows, Little Steven Van Zandt stated that "[t]he cost for a new rock band to get around the country has become exorbitant, making it nearly impossible for great new music to reach fans."); Suzuki Revs Up Kutless Tour To Tout SX4 Debut, XL7 SUV, BRANDWEEK, August 7, 2006 (discussing Suzuki's sponsorship of the artist KUTLESS' U.S. tour, in return for using the artist to promote the launch of two new Suzuki vehicles); RadioShack Jumps Aboard Rolling Stones Bandwagon, BRANDWEEK, August 7, 2006 (noting that RadioShack will help sponsor the U.S. leg of the ROLLING STONES' "Bigger Bang" tour and in return will have the band appear in RadioShack ads); www.jbltour.com (featuring audio product maker JBL's sponsorship of THE ROOTS, HOLD STEADY, and THE SUBWAYS on JBL's "Destination Anywhere" tour; JBL's sponsorship of these groups also included billboard ads throughout the subway system of New York City, which promoted both the groups and JBL's new speaker systems); Fine, supra note 34 (the malt liquor brand Sparks underwrote a tour for three bands on the influential Vice record label, and in return, the band members had to promote the beverage by photographing each other drinking it).
37. See Erik Parker, Hip Hop Goes Commercial, VILLAGE VOICE, September 11-17, 2002, available at [http://www.villagevoice.com/news/0237\\_parker.38205.1.html](http://www.villagevoice.com/news/0237_parker.38205.1.html) ("[R]ecord labels are tuning in to see how name-dropping [of sponsors] can defray the costs of music videos and recording costs").
38. Fine, supra note 34 (discussing Levi's' sponsorship of a music tent wherein the bands performing would receive outfits from Levi's; and quoting one underground rocker who has started to accept sponsorships: "[T]he only qualm I have is I usually don't like the stuff I get.>").
39. See Louise Story, Seeing Stars, N.Y. TIMES, October 12, 2006 (discussing BOB DYLAN's appearance in a commercial for Apple Computer's iPod and iTunes, which helped gain exposure for his most recent album *Modern Times*); Conniff and Werde, supra note 28 (discussing SEAN "P. DIDDY/PUFF DADDY" COMBS' use of his numerous brands, such as his SEAN JOHN clothing line and SEAN JOHN fragrances, to promote his most recent album, *Press Play*); Stuart Elliott, Woman of a Scent, N.Y. TIMES, December 18, 2006 (discussing the new fragrance by Elizabeth Arden for singer and actress HILARY DUFF, "With Love... Hilary Duff," and noting that the multimillion dollar advertising campaign promotes the fragrance as well as Duff's next single "With Love."); MADISON + VINE, Hollywood Records' Very Own Marriage Counselor, January 24, 2007, available at <http://adage.com/madisonandvine/news.pl?newsId=114498> (according to the VP of strategic marketing at Hollywood Records: "In fact, having corporate brand partners is a significant part of every marketing campaign we launch.>").
40. See When Marketers Become Record Labels supra note 24.
41. Licensing music has become such a priority for record labels that they now have brand partnership and commercial licensing departments. See Story, supra note 39 (interviewing a Vice President of brand partnerships and commercial licensing at Atlantic Records); FYI, MADISON + VINE.COM, October 18, 2006, at <http://>

- [adage.com/madisonandvine/news.pl?newsId=112544](http://adage.com/madisonandvine/news.pl?newsId=112544) (“WPP’s Group M and Universal Music Group have formed BrandAmp to develop music and brand partnerships for clients. The joint venture will also seek to work with other artists and record companies to synchronize third-party deal and music pacts.”). The push to have artist’s music in commercial campaigns has become so important that one foreign band recently skipped the traditional radio promotion activities and instead met with advertising executives. See When Marketers Become Record Labels, supra note 24. The unknown-in-America Swedish artist TEDDYBEARS, through its record label, went on a tour of advertising agencies in four major markets rather than doing a standard promotional tour with radio stations and press. The result: numerous advertising licensing deals were closed after this promotional tour, including the use of their songs in an Intel commercial and a Cadillac commercial. Id. (Cadillac will also place one of its automobiles in a TEDDYBEARS video.).
42. See Louis Hau, Smells Like New Revenue, FORBES.COM, October 24, 2006; Block, supra note 34 (“All those rock tunes popping up in commercials are making superstar bands ever richer and turning unknown acts into the next big thing.”).
  43. Hau, supra note 42 (noting that “consumers have become more accepting of hearing their favorite artists’ music being used for commercial purposes.”).
  44. See Block, supra note 34 (“As the cost of promoting musical acts skyrockets, licensing songs for commercial use, once considered to be a sellout, has become a good way to expose a new record to the public and make a buck.”); Story, supra note 39; REUTERS, Cyndi Lauper Likes the Sound of Commercials, February 1, 2007 (according to singer CYNDI LAUPER, bands looking to break into the music business should seek out commercials: “Right now, commercials are where to hear new music.”).
  45. Although it is not always the case that consumers will automatically link a licensed song with the product being advertised. Block, supra note 34 (noting that some songs are used for a number of commercial products, which harms the instant recognition of the product, and listing the ROLLING STONES’ “Start Me Up” as an example of a song that has been licensed for advertising multiple products). Nevertheless, every time I hear “Galvanize” by the CHEMICAL BROTHERS, one of my favorite artists, I cannot help but immediately think of Budweiser Select, as Anheuser-Busch prominently featured the song in its Budweiser Select commercials throughout 2006.
  46. See Hau, supra note 42; Seth Stevenson, Paul McCartney? Is That You?, SLATE.COM, September 19, 2005, at [www.slate.com/toolbar.aspx?action=print&id=2126568](http://www.slate.com/toolbar.aspx?action=print&id=2126568) (noting that ROLLING STONES’ music has been featured in an Ameriquest campaign); Block, supra note 34 (noting that ROLLING STONES’ “Start Me Up” was heavily used by Microsoft Corp. to launch Windows 95, as well as for Ford trucks); Chris Nashawaty, Back on the Mean Streets, ENTERTAINMENT WEEKLY, September 22, 2006, available at [http://www.ew.com/ew/report/0.6115.1537678\\_1\\_0\\_00.html](http://www.ew.com/ew/report/0.6115.1537678_1_0_00.html) (discussing director Martin Scorsese’s use of The Rolling Stones’ “Gimme Shelter” in three of his hit movies); Lauro, supra note 34 (noting the use of THE WHO’s “Who Are You” for Gateway computers); “The Who in popular culture,” available at [http://en.wikipedia.org/wiki/The\\_Who\\_in\\_popu](http://en.wikipedia.org/wiki/The_Who_in_popu)lar\_culture (noting the use of THE WHO’s music as the theme songs to each show in the hit *CSI* television franchise, and the use of the group’s music in commercials for Hummer SUVs, Sylvania light bulbs, and Saab automobiles).
  47. See Story supra note 34 (noting that celebrities, including musicians, use appearances in commercials to keep getting exposure for themselves). Additionally, the estates of deceased artists view commercial licensing of the artist’s music as a big revenue source, as well as a way to continue to expose the deceased artist. See Lauro supra note 34.
  48. Electronica artist FATBOY SLIM’s popular success in the music industry followed his success licensing his music for commercials; in 1999, he “hit the mother lode” when Kodak, MasterCard, Nike, and Coca-Cola each used one of his songs for commercials. Lauro, supra note 34. Additionally, for the past decade, Volkswagen has been helping artists unknown to mass audiences by promoting their music in commercials for its automobiles. See id. (noting how Volkswagen of America introduced the new Beetle in 1998 “with an entire campaign of songs by bands that were virtually unknown to the mass audience,” such as THE ORB, SPIRITUALIZED, and FLUKE).
  49. Moby, whose entire album *Play* had every single song licensed for commercial use, has had numerous songs placed in commercials, including “We’re All Made of Stars” in an Intel campaign. See Southall, supra note 32 (“Moby’s *Play* album became a worldwide hit after every song was placed in one or more adverts.”); Jim DeRogatis, Talking With Moby, PENTHOUSE, August 2002, available at <http://www.jimdero.com/OtherWritings/PenthouseMoby.htm> (responding to music critic DeRogatis’ questions about licensing many of his songs, Moby stated that he does not think people will associate his songs with the advertiser’s product after the song appeared in a commercial). Additionally, The CHEMICAL BROTHERS’ beats have become ubiquitous in 2006, as their song “Galvanize” is the background to Anheuser-Busch’s popular Budweiser Select campaign. See <http://adtones.com> (listing the top ad music of 2006 and noting that Budweiser branded their 2006 commercial campaign with “Galvanize.”).
  50. See Fine, supra note 34 (noting that fifteen or twenty years ago bands that “cozied up” to advertisers “were often ridiculed and hung out to dry”); Lauro, supra note 34 (noting that the number of songs licensed for commercials greatly increased during the 1990’s, and in 1999 alone, more than 130 advertising campaigns used songs originally released by an artist but now licensed for commercial use); Hau, supra note 42.
  51. For example, R.E.M., known for being a politically active artist, turned down Microsoft Corporation’s multimillion dollar offer to use their hit “It’s the End of the World as We Know It” in a commercial for Windows 95. Ivor Hanson, Rock For Rock’s Sake Is No Longer Enough, N.Y. TIMES, December 5, 1999. JOHN MELLENCAMP has also long expressed objections to the use of artist’s songs in advertising, but recently acquiesced to placing his music in a Chevrolet commercial in order to reach consumers. Alan Light, Changes In Mellencamp Country, N.Y. TIMES, January 22, 2007 (“This is just what I did this time to reinvent myself and stay in business. Sometimes I get sad about it really. I still don’t think that people should sell their songs for advertising.”).
  52. Waits is a staunch opponent of having his music used in commercials. Since his career began, he has often expressed his view that musical artists should not do commercials because it detracts from their artistic integrity. See Josh Greenberg, Waits Waits Over Car Ad, E ONLINE, September 15, 2005, available at [http://internationalonline.com/news/items/0\\_1799\\_17374\\_00.html](http://internationalonline.com/news/items/0_1799_17374_00.html) (“Commercials are an unnatural use of my work. It’s like having a cow’s udder sewn to the side of my face. Painful and humiliating.”). He famously sued Frito Lay and their advertising agency for using a soundalike vocalist in a radio ad for Doritos and was awarded \$2.6 million in damages. Tom Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1096 (9th Cir. 1992) (prevailing on a vocal misappropriation claim under California common law and a false endorsement claim under 15 U.S.C. § 1125(a)). He has also sued General Motors’ Opel division in Germany and its ad agency for use of a soundalike in its ads, as well as suits against Audi and the Italian carmaker Lancia for similar misappropriation. See Greenberg supra note 52; Lawrence Van Gelder, Waits Settles Ad Suit, N.Y. TIMES, January 25, 2007 (Waits recently settled with Opel and its agency and said that he would donate his net proceeds to charity).
  53. Densmore, the drummer for THE DOORS, has long held the view that the music of THE DOORS should not be licensed for commercial use, as THE DOORS are making plenty of money without “selling out” to corporate America and permitting the use of the group’s music in commercials is antithetical to the legacy of the group and the memory of Jim Morrison. See Densmore v. Manzarek, Case Nos. BC 289730 and BC 294495 at 6, 17-18 (Cal. Super. Ct. July 21, 2005). THE DOORS have received numerous offers for use of their music in commercials, including a \$15 million offer from Cadillac for the use of “Break on Through” in a worldwide campaign for its automobiles and a \$4 million offer from Apple Computers for the use of another song by the group in a commercial campaign, but since the death of Jim Morrison the group has only allowed their music to be placed in one commercial – a Pirelli tire commercial broadcast in England. Id. Other notable artists share the same view as Densmore and Waits regarding the use of their music in commercials, including NEIL YOUNG, BRUCE SPRINGSTEEN, BONNIE RAITT, and JACKSON BROWNE. Id. at 11.
  54. See LCD Soundsystem team up with Nike, NME, at [www.nme.com/news/lcd-soundsystem/24730](http://www.nme.com/news/lcd-soundsystem/24730) (discussing LCD SOUNDSYSTEM’s commission by Nike Inc. to create a workout song for Nike’s iTunes download store). According to the VILLAGE VOICE, LCD SOUNDSYSTEM’S original track for the Nike iTunes store “may be the best thing the corporation has ever done.” Mike Powell, Chubby Juggers of the World Unite: How Nike’s bizarre union with LCD Soundsystem worked out so perfectly, VILLAGE VOICE, November 19, 2006 (noting that money may be just as powerful of a motivation tool as inspiration for making good records); see also Lentini, supra note 34 (discussing LG Mobile’s use of teenage pop singer RIHANNA as their “brand ambassador” because her music appeals to LG Mobile’s target audience – teenagers.)
  55. One way for an artist to protect itself is to request to see the creative work of the agency or corporate sponsor before the artist commits to the brand.
  56. 15 U.S.C. § 1127.
  57. USPTO Trademark Manual of Examining Procedure § 1301.02(b); see Creative Arts By Calloway, L.L.C. v. Brooks, 48 Fed. Appx. 16 (2d Cir. 2002) (“entertainment” may be considered a service in connection with the law of service marks).

58. See USPTO Trademark Manual of Examining Procedure § 1202.09(a). Registering the name of an artist for sound recordings is only allowed where: 1) the mark is used on a series of sound recordings (at least two different recordings); and 2) the owner controls the nature and quality of the goods. *Id.*; *In re Polar Music Intern. AB*, 714 F.2d 1567 (Fed. Cir. 1983); *In re Ames*, 160 U.S.P.Q. 214 (T.T.A.B. 1968). See also *supra* note 18 regarding the number of KISS goods registered with the USPTO.
59. *Allard Enterprise, Inc. v. Advance Programming Resources, Inc.*, 249 F.3d 564, 571 (6th Cir. 2001).
60. *Grondin v. Rossington*, 690 F. Supp. 200, 208 (S.D.N.Y. 1988); *Cash v. Brooks*, 1996 WL 684447 at \*12 (E.D. Tenn. April 24, 1996) (“Names of popular musical entertainment and recording groups are protected by the Lanham Act even though that name is not a registered trademark. ‘Usage, not registration, confers the right to a trademark.’”) (citations omitted).
61. See *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1105 (6th Cir. 1991).
62. 15 U.S.C. §§ 1057(b), 1115(a).
63. 15 U.S.C. §§ 1057(b), 1115(a).
64. 15 U.S.C. §§ 1057(b), 1115(a).
65. 15 U.S.C. § 1072.
66. 15 U.S.C. §§ 1057(b), 1115(a).
67. Additionally, unlike common law marks, if the artist intends to use a name in commerce but has not done so, the artist may apply for trademark registration based on that intent, and receive priority over any subsequent users. 15 U.S.C. § 1051(b).
68. Nevertheless, each case involves its own particular facts, and overgeneralization is always risky.
69. See *Circuit City Stores, Inc. v. Carmax, Inc.*, (165 F.3d 1047, 1054 (6th Cir. 1999) (the use of a mark must be “deliberate and continuous, not sporadic, causal, or transitory.”). For an artist, it is important to use the name throughout the United States; it is possible that an artist will use a name in one region of the United States, while another artist will use the same name in a different region. The artist that first uses the name nationally will be able to claim national trademark rights.
70. See *Stetson v. Howard D. Wolf & Assocs.*, 955 F.2d 847, 851 (2d Cir. 1992).
71. It is possible that an artist not taking these actions may be deemed to have “abandoned” the mark to the public domain. See *Densmore v. Manzarek*, Case Nos. BC 289730 and BC 294495 at 39 (Cal. Super. Ct. July 21, 2005) (finding that THE DOORS was not abandoned as a mark as the sale and air play of the group’s music has been continuous over the years); *Kingsmen v. K-Tel Intern. Ltd.*, 557 F. Supp. 178, 183 (S.D.N.Y. 1983).
72. See USPTO Trademark Reg. No. 2212548.
73. See USPTO Trademark Reg. No. 19169338.
74. See USPTO Trademark Reg. No. 2698988.
75. See USPTO Trademark Reg. No. 2697128.
76. See USPTO Trademark Reg. No. 3128896.
77. See USPTO Trademark Reg. No. 1908209.
78. See USPTO Trademark Reg. No. 2785724.
79. See USPTO Trademark Reg. No. 2825378.
80. See USPTO Trademark Reg. No. 1051174.
81. See USPTO Trademark Reg. No. 1128762.
82. See USPTO Trademark Reg. No. 2811089.
83. See USPTO Trademark Reg. No. 1469618.
84. See, e.g., *Kaufhold v. Yeomans*, Opposition No. 91160771 (Trademark Tr. & App. Board September 26, 2006) (Once Opposer demonstrated priority of use, the TTAB sustained an opposition of the application for the service mark THE UNDEAD for live performances by a punk rock band based on Opposer’s common law mark THE UNDEAD for live performances by a punk rock band); *Robert Craig “Evel” Knievel v. Kayne West, et al.*, Case No. 06cv 02269, (M.D. Fla. December 11, 2006) (“Evel” Knievel, who owns the trademark EVEL KNEIVEL, sued rap star Kanye West over West’s “Touch the Sky” video in which West takes on the persona of “Evel Kaynevel” and mimic’s Knievel’s daredevil act).
85. See *Chris Riemenschneider, Rock band hits hurdle with ‘Olympic’ name*, STAR TRIBUNE, July 28, 2005 (noting DINOSAUR JR.’s name change due to a trademark dispute with another group).
86. See *Id.* (discussing the ownership of the word OLYMPIC by the U.S. Olympic Committee, which forced THE HOPEFULS to drop the “Olympic” portion of their name; ironically, the band was originally going to call itself CAMARO, but changed their minds due to potential trademark issues).
87. See Donald Passman, ALL YOU NEED TO KNOW ABOUT THE MUSIC BUSINESS, at 318; biography of GREEN JELLY at All Music Guide, available at <http://www.allmusic.com/cg/amg.dll?p=amg&sql=11:7kd5vwpva9yk>.
88. Teenage rap artist Alijaray Gaston went by the name “Fat Al” until Bill Cosby stepped in, citing the Cosby-created character Fat Albert. Gaston’s record label, Atlantic Records, attempted to settle with Cosby, but ultimately changed Gaston’s performing name to “Al Fatz.” *Teen rapper fights over ‘Fat’ with Bill Cosby*, REUTERS, November 13, 2006.
89. See Rodrigo Perez, *Death From Above 1979*, MTV.COM, available at [http://www.mtv.com/news/yhif/death\\_from\\_above\\_1979/](http://www.mtv.com/news/yhif/death_from_above_1979/); Dave Morris, review of *You’re a Woman, I’m a Machine* by DEATH FROM ABOVE 1979, SEATTLE WEEKLY, January 5, 2005, available at [http://www.seattleweekly.com/music/0501/0501\\_05\\_music\\_cdreviews.php](http://www.seattleweekly.com/music/0501/0501_05_music_cdreviews.php) (noting that the group inserted the “1979” into their name following a cease and desist letter from the DEATH FROM ABOVE record label).
90. See biography of THE VERVE at VH1.com, available at <http://www.vh1.com/artists/az/verve/bio.jhtml> (explaining the name change due to a lawsuit filed by the American jazz label VERVE).
91. See *Stuart v. Collins*, 489 F. Supp. 827 (S.D.N.Y. 1980) (Bootsy Collins and Warner Brothers Records were found to have willfully infringed an artist’s mark after the artist informed them that his registered mark THE RUBBERBAND had priority trademark rights over BOOTSY COLLINS’ RUBBER BAND).
92. See *Supernova from Cynot3, LLC v. Mark Burnett Productions, Inc.*, Civ. No. 06CV1334 JAH (RBB) (S.D. Cal. Sept. 12, 2006) (granting preliminary injunction on behalf of plaintiff based on its unregistered mark SUPERNOVA for a band); *Judge orders made-for-TV band to change name*, REUTERS, September 14, 2006; Jonathan Cohen, *Trademark Dispute Settled Over Supernova Name*, BILLBOARD, September 21, 2006.
93. Ben Sisario, *Postal Service Tale: Indie Rock, Snail Mail, and Trademark Law*, N.Y. TIMES, Nov. 6, 2004, A1.
94. See David Barnett, SUEDE: LOVE AND POISON, at 143, Andre Deutsche Ltd. 2003 (attributing the group’s lack of success in breaking America to the lawsuit filed by jazz-folk singer Suzanne deBronkart, who performed as SUEDE, and the group’s resultant name change to THE LONDON SUEDE); USPTO Trademark Reg. No. 1824688 (the mark SUEDE owned by Suzanne deBronkart for entertainment services); “The Charlatans U.K.” biography at VH1.com, available at [http://www.vh1.com/artists/az/charlatans\\_uk/bio.jhtml](http://www.vh1.com/artists/az/charlatans_uk/bio.jhtml) (noting that one the eve of the group’s first American tour, it had to change its name to THE CHARLATANS U.K. because a San Franciscan garage rock group from the 1960’s were already called THE CHARLATANS); Riemenschneider, *supra* note 70 (noting THE CHARLATANS’ name change due to a trademark dispute with another group with the same name).
95. A magazine article is relevant when showing the first use of a mark if there were two groups claiming that they made the first commercial use of the mark. See *Far Out Productions, Inc. v. Oskar*, 247 F.3d 986 (9th Cir. 2001).
96. If there is a conflict, the label may force the artist to change the name prior to the release of any recordings or merchandise. See *Champagne v. DiBlasi*, 134 F. Supp. 2d 310 (E.D.N.Y. 2001) (the record company stated that the group had to obtain trademark rights in its name or else the group would have to change its name to one that could receive trademark protection; here, because their name potentially violated a third party’s rights, the group dropped it). An artist should be careful, however, to not assign the ownership rights in the name to the record company. Rather, the artist should grant a non-exclusive license to the record company to use the name for marketing purposes for any recordings made under the contract.
97. A violation of the artist’s representations and warranties could lead to termination of the contract by the record company or an indemnification of the record company by the artist if a third party brings a claim.
98. See *Mears v. Montgomery*, 2006 WL 1084347 (S.D.N.Y. April 24, 2006) (citing *Stetson v. Howard D. Wolf & Assocs.*, 955 F.2d 847, 852 (2d Cir. 1992), *Marshak v. Sheppard*, 666 F. Supp. 590, 600 (S.D.N.Y. 1987), and *Rare Earth, Inc. v. Hoorelbeke*, 401 F. Supp. 26 (S.D.N.Y. 1975)); *Bagdasarjian Productions v. Audiofidelity Enters., Inc.*, 1984 WL 1565 (D. N.J. October 3, 1984) (records by “The Happy Chipmunks” violated the common law and registered marks of THE CHIPMUNKS); *Kingsmen v. K-Tel Intern. Ltd.*, 557 F. Supp. 178 (S.D.N.Y. 1983); *Stuart v. Collins*, 489 F. Supp. 827 (S.D.N.Y. 1980).
99. *In the Matter of Atlantic Recording Corp. et al.*, 747 N.Y.S. 2d 889, 890 (N.Y. Sup. Ct. 2002).
100. See *Rodgers v. Anderson*, 2005 WL 950021 (S.D.N.Y. April 26, 2005) (awarding plaintiff, the founder of and owner of the registered mark CHIC, \$250,000 for the willful infringement of the mark by defendants, former backup singers of CHIC who were performing as “Chic”). Trademark rights in artist’s names are valuable enough that an artist may buy out another artist’s rights in a name in order to own such name. See *Tradem Inc. v. Stainbrook*, 2004 WL 1047956 (S.D.N.Y. May 10, 2004) (discussing the assignment of an individual artist’s registered mark THE STAIN to the group STAIND for \$18,000; STAIND in turn licensed THE STAIN back to the individual for use with his performances in the Ohio area); Colleen Long, *Singer Black*

- Owns His Own Name, Court Rules, ASSOCIATED PRESS, December 7, 2006 (members of the group JAY AND THE AMERICANS purchased the group name from former lead singer Jay Black in a bankruptcy auction for \$100,000; “lawyers for the bankruptcy trustee handling the case considered the band name a valuable asset”).
101. USPTO Trademark Manual of Examining Procedure § 1207.01(a)(v); see Sullivan v. CBS Corp., 385 F.3d 772, 776-777 (7th Cir. 2004) (the group SURVIVOR is entitled to strong protection against other musical group names, but there is no presumption that the mark is equally strong outside that realm; therefore, the television show “Survivor” did not infringe on the band’s trademark rights for musical services); CPG Products Corp. v. Perceptual Play, Inc., 221 USPQ 88 (TTAB 1983) (The test is whether purchasers would believe the product or service is within the registrant’s logical zone of expansion).
  102. This secondary meaning can be established by the success of the artist, such as by the number of record albums sold and merchandise sold on the artist’s behalf. Winterland Concessions Co. v. Macintosh, 1992 WL 170897 (E.D. Pa. July 14, 1992); Gore v. Does, 1998 WL 778374 (S.D.N.Y. Nov. 6, 1998).
  103. See supra note 35 (discussing Nike’s use of MINOR THREAT’s name and album cover art to promote Nike’s Major Threat skateboarding tour).
  104. See Cash v. Brooks, 1996 WL 6844447 (E.D. Tenn. April 24, 1996) (finding likelihood of confusion for former group members performing under the name THE IMPRESSIONS when the public identifies the original group as THE IMPRESSIONS); Kaufhold v. Yeomans, Opposition No. 91160771 (Trademark Tr. & App. Board September 26, 2006) (artist performing under the common law mark THE UNDEAD successfully opposed another artist using the name THE UNDEAD); Winterland Concessions Co. v. Macintosh, 1992 WL 170897 (E.D. Pa. July 14, 1992) (bootleg merchandisers); Gore v. Does, 1998 WL 778374 (S.D.N.Y. Nov. 6, 1998) (bootleg merchandisers); Polygram Merchandising, Inc. v. New York Wholesale Co., 2000 WL 23287 (S.D.N.Y. Jan. 13, 2000) (bootleg merchandisers); Virgin Enters. Ltd. v. David Defeis, 2000 WL 1720144 (Trademark Tr. & App. Bd. October 26, 2000) (owner of the VIRGIN, VIRGIN RECORDS, and VIRGIN MEGASTORE marks successfully opposed a musician applying for the trademark VIRGIN STEELE for sound recordings, clothing, and musical entertainment); BMG Special Products, Inc. v. David Anthony Jagosz, 2003 WL 22477869 (Trademark Tr. & App. Bd. October 30, 2003) (owner of the marks BUDDA and BUDDAH for a record label successfully opposed a musician applying for the trademark YOU DA BUDDA for sound recordings and entertainment services).
  105. Artists should actually purchase a domain name rather than just relying on a MySpace.com page even if they do not have an associated website yet. The artist could always redirect viewers of the domain to the artist’s MySpace.com page. Solely having a MySpace.com page for the artist’s web address may be problematic, as MySpace.com itself owns all of the MySpace urls. For example, the Louisiana-based rock band BONES temporarily lost their MySpace.com url ([www.myspace.com/bones](http://www.myspace.com/bones)) when MySpace.com’s corporate partner Fox wanted the url for its television show *Bones*. Luckily for the band, they were able to retain the url after the issue was sorted out. Band Loses, Regains MySpace URL, FMQB.com, November 7, 2006, at [www.fmqb.com/Article.asp?t=p&id=301843](http://www.fmqb.com/Article.asp?t=p&id=301843).
  106. See Rick v. Buchansky, 609 F. Supp. 1522 (S.D.N.Y. 1985); see also Blackwood v. R.W. Blackwood, 2005 WL 2096857 (E.D. Tenn. Aug. 30, 2005) (noting that the person or entity that maintains control over a musical group is the person or entity that owns the trademark rights in the name). Registering the name of an artist for sound recordings is only allowed where: 1) the mark is used on a series of sound recordings (at least two different recordings); and 2) the owner controls the nature and quality of the goods. Rick, 609 F. Supp. at 1522; In re Polar Music Intern. AB, 714 F.2d 1567 (Fed. Cir. 1983).
  107. See Rick v. Buchansky, 609 F. Supp. 1522 (S.D.N.Y. 1985); Stetson v. Howard D. Wolf Associates, 955 F.2d 847 (2d Cir. 1992) (holding that because the manager “used” and did not abandon the mark THE DIAMONDS, his successor in interest could enjoin former group members’ new group under the same name).
  108. See In the Matter of Atlantic Recording Corp. et al., 747 N.Y.S.2d 889, 890 (N.Y. Sup. Ct. 2002).
  109. Rick v. Buchansky, 609 F. Supp. 1522 (S.D.N.Y. 1985); but see Bell v. Streetwise Records Ltd., 761 F.2d 67 (1st Cir. 1985) (determining that although the individual members of “New Edition” did not have trademark rights in the group name for phonorecords, as they did not market phonorecords under that name until the producer employed the individual members, the members, both individually and collectively, had service mark rights in the group’s name for the field of live musical entertainment).
  110. In the Matter of Atlantic Recording Corp. et al., at 891 (although the contract at issue explicitly gave the producer of the concept group “Dream Street” the ownership of the trademark and trade name, the court also noted that the producer spent over \$2 million to create, produce, and promote the group); Rick v. Buchansky, 609 F. Supp. 1522 (S.D.N.Y. 1985) (finding that the manager of “Vito and the Salutations” was entitled to an injunction against the use of the name by former members of the group; the manager was the owner of the name since he “exerted influence over the style and content of the group’s act” and “functioned much like the producer of a theater company or owner of a sports team” where various performers played the parts and positions).
  111. Peter Newcomb, It’s Slippery at the Top, FORBES, September 30, 1991; see The New Kids on the Block v. News America Publishing, Inc., 971 F.2d 302, 304 (9th Cir. 1992) (“there are more than 500 products or services bearing the NEW KIDS trademark”).
  112. Ayala Ben-Yahuda, Epic to Sign Menudo: MTV Plans Reality Show, BILLBOARD, October 13, 2006 (over the years, MENUDO became “an instantly recognizable mainstream brand”). This deal gives Epic a cut of MENUDO by-products such as touring, merchandising, ringtones, a cartoon series, and other branded revenue streams. Id.
  113. David Lieberman, ‘American Idol’ Zooms From Hit Show to Massive Business, USA TODAY, March 29, 2005, available at [http://www.usatoday.com/life/television/news/2005-03-29-media-usat\\_x.htm](http://www.usatoday.com/life/television/news/2005-03-29-media-usat_x.htm); David Lieberman, ‘American Idol’ Backers Nervously Wait In The Wings, USA TODAY, January 16, 2006, available at [http://www.usatoday.com/money/media/2006-01-16-usat\\_x.htm?csp+34](http://www.usatoday.com/money/media/2006-01-16-usat_x.htm?csp+34).
  114. Claire Atkinson, ‘Idol’ Juggernaut Passes \$2.5 Billion in Value; Keeps Expanding, ADAGE.COM, January 8, 2007 (stating that the AMERICAN IDOL is “vying for the title of the most lucrative multimedia property of all time”).
  115. See e.g., Marshak v. Sheppard, 666 F. Supp. 590 (S.D.N.Y. 1987) (THE DRIFTERS); HEC Enters., Ltd. v. Deep Purple Inc., 213 U.S.P.Q. 991 (DEEP PURPLE); Giammarese v. Delfino, 197 U.S.P.Q. 162 (N.D. Ill. 1977) (THE BUCKINGHAMS); Cash v. Brooks, 1996 WL 6844447 (E.D. Tenn. April 24, 1996) (THE IMPRESSIONS).
  116. 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 10:40 (4th Ed. 2006). Section 45 of the Lanham act provides that a mark can be considered abandoned: “When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Non use for three consecutive years shall be prima-facie abandonment.” 15 U.S.C. § 1127. The Second Circuit Court of Appeals has held that “to prevail on a claim that a trademark has been abandoned, the party claiming abandonment must show (1) non-use by the owner of the trademark or trade name and (2) the intent by the owner not to resume using the name or the mark.” Mears v. Montgomery, 2006 WL 1084347 at \*8 (S.D.N.Y. April 24, 2006) citing Silverman v. CBS Inc., 870 F.2d 40, 50 (2d Cir. 1989) (also noting that two years of non-use of a trade name by its legal owner creates a “rebuttable presumption of abandonment.”).
  117. See Kingsmen v. K-Tel Int’l, Ltd., 557 F. Supp. 178 (S.D.N.Y. 1983) (a group that ceased recording and disbanded in 1967 did not abandon rights in the group name; the court found that the continued use of the name to promote the sale of previous recordings and the receipt of royalties from those sales negates any inference of an intent to abandon the group name); Densmore v. Manzarek, Case Nos. BC 289730 and BC 294495 (Cal. Super. Ct. July 21, 2005) (finding that the name THE DOORS had not been abandoned since both the sale of the band’s music and air play of their music has been continuous over the years); Supernova from Cynot3, LLC v. Mark Burnett Productions, Inc., Civ. No. 06CV1334 JAH (RBB) (S.D. Cal. Sept. 12, 2006) (although the band SUPERNOVA was not currently touring, the band did not abandon its name).
  118. Robi v. Reed, 173 F.3d 736, 739 (9th Cir. 1999) (when member left the group THE PLATTERS, he took no rights to the service mark with him; rather, the rights remained with the original group); HEC Enters., Ltd., 213 U.S.P.Q. at 994 (C.D. Cal. 1980) (former member of DEEP PURPLE and his new group were prohibited from performing under the name DEEP PURPLE when members of the original group, with certain replacement members, continued to use the name, which had acquired common law trademark rights in the United States). Courts have also found that the departing group member does not have rights to the group’s name just by virtue of the member’s tenure with the group. See Densmore v. Manzarek, Case Nos. BC 289730 and BC 294495 (Cal. Super. Ct. July 21, 2005) (holding that two of the original members of THE DOORS could not perform under the name

- THE DOORS or THE DOORS OF THE 21ST CENTURY without the consent of all of the original members); Gallina v. Giacalone, 1996 WL 735353 at \*3 (N.Y. Sup. Ct. Dec. 9, 1996) (holding that musicians that performed with the group only once unfairly capitalized on the work by the founding members by continuing to perform under the group's name); HEC Enters. Ltd., 213 U.S.P.Q. at 992 (original member of the group DEEP PURPLE prohibited from using DEEP PURPLE as the name of his new group); Giammarese v. Delfino, 197 U.S.P.Q. 162, 162-164 (N.D. Ill. 1977) (holding that while the departing group member was a founding member of the group THE BUCKINGHAMS, his unauthorized creation of the group NU-BUCKINGHAMS was trademark infringement).
119. See Kassbaum v. Steppenwolf Prods., Inc., 236 F.3d 487 (9th Cir. 2000) (these are truthful statements and confusion is unlikely); Kingsmen, 557 F. Supp. 178 (a proper usage would be the lead singer's name with "formerly of the Kingsmen" or "Jack Ely, lead singer on the original Kingsmen recording of Louie Louie."); Brother Records, Inc. v. Jardine, 318 F.3d 900, 901 (9th Cir. 2003) (former member of THE BEACH BOYS could not use the group's name for his performances, but was allowed to refer to his past membership in the group); Grondin v. Rossington, 690 F. Supp. 200 (S.D.N.Y. 1988) (defendant former group member was required to affix a label on his CDs and cassettes stating that "this is a recording of a new band recorded in 1987 and not the original Lynyrd Skynyrd group"); see also Cleopatra Records v. William Bruce Bailey, Case No. CV 04-3120 GAF (C.D. Cal. July 6, 2004) (finding that the use of the name GUNS 'N ROSES for an album of recordings by a predecessor band entitled "Hollywood Rose: The Roots of Guns 'N Roses" was a nominative fair use of the GUNS 'N ROSES trademark).
  120. See e.g., Brother Records, Inc. v. Jardine, 318 F.3d 900, 901 (9th Cir. 2003) (the members of THE BEACH BOYS incorporated Brother Records, Inc. to hold and administer the intellectual property rights of THE BEACH BOYS, including the group's trademark rights).
  121. Of course, a group should think about whether they want other group members to prevent another group member to use the name outside of the group. For example, John Densmore of THE DOORS has successfully sued his other band members for performing under the name THE DOORS, and even though the band has officially broken up, the band members that still want to perform together are restrained from doing so. Densmore v. Manzarek, Case Nos. BC 289730 and BC 294495 (Cal. Super. Ct. July 21, 2005).
  122. See Winterland Concessions Co. v. Macintosh, 1992 WL 170897 (E.D. Pa. Jul 14, 1992) ("each licensor musical group has a sole right to control the commercial exploitation of the name and/or likeness of the group, including their uses on T-shirts and jerseys") citing Zacchini v. Scripps-Howard Broadcasting Company, 433 U.S. 562 (1977). In Zacchini, the Supreme Court recognized the authority of states to protect entertainers' "right of publicity." 433 U.S. at 573, 576-78.
  123. Generally, trademarks and service marks identify a source of the good or service under that mark, something that a person's publicity attributes may not necessarily do.
  124. N.Y. Civ. Rts. Law §§ 50-51; Cal. Civ. Code § 3344; see also Cher v. Forum Int'l, 692 F.2d 634 (9th Cir. 1982); Washington v. Brown & Williamson, 223 U.S.P.Q. 1116 (E.D. Pa. 1984); Midler v. Ford Motor Co., 849 F.2d 460 (1988); Tin Pan Apple, Inc. v. Miller Brewing Co., 737 F. Supp. 826 (S.D.N.Y. 1990); White v. Samsung Electronics, 971 F.2d 1395 (9th Cir. 1992); Apple Corps Ltd. v. Button Master, 47 U.S.P.Q.2d 1236 (E.D. Pa. 1998).
  125. Apple Corps Ltd. v. A.D.P.R., Inc., 843 F. Supp. 342 (M.D. Tenn. 1993) (use of THE BEATLES and JOHN, PAUL, GEORGE, and RINGO in a commercial context was found to violate Tennessee's Personal Rights Protection Act); Apple Corps Ltd. v. Button Master, 47 U.S.P.Q.2d 1236 (E.D. Pa. 1998) (group name THE BEATLES as well as the individual members' names and likenesses were protected by Pennsylvania's common law right of publicity).
  126. Apple Corps Ltd. v. A.D.P.R., at 348 ("the stage name of a group of individuals is entitled to the same protection as the name of one of the individuals which compose that group"). Additionally, musical groups as well as the individual performers have protectible rights of publicity. Apple Corps Ltd. v. Button Master, 47 U.S.P.Q.2d 1236 (E.D. Pa. 1998).
  127. Cuomo v. Miller Brewing Company, et al., Case No. 8C359544 (Cal. Superior Ct., Sept. 29, 2006).
  128. Browne v. Bloomingdale's, Case No. 06cv7877 (C.D. Cal. December 12, 2006) (according to the lawsuit, the t-shirts bear the name JACKSON BROWNE in large letters across the top of the shirt, with a large photograph of the singer playing an acoustic guitar in front of a microphone).
  129. See Hanson, supra note 51 (noting that alternative rocker LIZ PHAIR appeared on Calvin Klein billboards and alternative band EVERLAST appeared in magazine ads for Avirex clothing).
  130. See Winterland Concessions Co. v. Macintosh, 1992 WL 170897 at \*10 (E.D. Pa. July 14, 1992) (licensee of numerous artists' names and likenesses, as well as their trademarks, for merchandise was able to obtain a default judgment against a bootleg merchandiser for violations of the right of publicity and trademark law); Apple Corps Ltd. v. Button Master, 47 U.S.P.Q.2d 1236 (E.D. Pa. 1998) (granting summary judgment for plaintiff's trademark and right of publicity claims after finding the use of THE BEATLES and the group members' individual names for commercial purposes violated the Lanham Act and Pennsylvania's right of publicity law); Apple Corps Ltd. v. A.D.P.R., 843 F. Supp. at 349 (holding that a lookalike cover band misappropriated the names and likenesses of THE BEATLES); Robert Craig "Evel" Knievel v. Kayne West, et al, Case No. 06cv 02269 (M.D. Fla. December 11, 2006) (EVEL KNEIVELE brought trademark infringement and right of publicity claims against rap star KAYNE WEST for West's "Touch the Sky" video, in which West takes on the persona of "Evel Kaynevel").
  131. See Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976). The strength of a trademark is evaluated along a sliding scale of distinctiveness, from generic or descriptive marks that are considered weak, to suggestive, arbitrary, or fanciful marks that are judged with a higher level of inherent distinctiveness. Id.
  132. See supra "Choosing and Clearing the Artist's Name" and related notes. Note, an artist should also not choose a name that could potentially violate the rights of publicity of another person, regardless of whether that person is in the music industry or not. See supra "Rights of Publicity Under State Law" and related notes.
  133. The database is available at <http://www.uspto.gov/main/trademarks.htm>. While not an exhaustive resource, this database is useful for preliminary searches.
  134. To determine whether a name is clear for trademark use, the artist will want to evaluate the search results using the multifactor test for the likelihood of confusion. See Polaroid Corp. v. Polarad Elec. Corp., 287 F.2d 495 (2d Cir. 1961); AME, Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979). Because trademark law is a highly specialized field that unfortunately does not lend itself to black or white answers, it will be useful for an artist to consult an attorney to interpret the search results.
  135. Thomson CompuMark (<http://www.thomson-thomson.com>) and CT Corsearch (<http://www.ctcorsearch.com>) are two such vendors that offer comprehensive trademark and entertainment availability reports. The search reports can range from \$500 to close to \$1500 depending on the type of search performed and the turnaround time.
  136. The owner of a trademark is the entity that controls the quality of the goods or services under the trademark. Therefore the owner for the application can be an individual artist, a partnership among group members, or the corporate entity that was created to hold the intellectual property rights of the group. See supra "Dissolution and/o Membership Changes" and related notes.
  137. The cost to file a trademark application with the USPTO is \$325 per class of goods or services if the applicant uses the electronic-based TEAS system. A \$275 application is available if the artist has the ability to use the TEAS Plus system.
  138. Maintaining a trademark registration includes filing an affidavit of continuing use with a specimen of current use during the sixth year of use of the mark. 15 U.S.C. § 1058. Additionally, the artist who receives a trademark registration after November 16, 1989 will need to file an application for renewal with proof of continued use within the last six months of tenth year of use of the mark. 15 U.S.C. § 1059. Of course, as mentioned previously, trademark protection in the United States is based on use of the mark in commerce, so even if an artist's registration for its professional name is cancelled, the artist may still have trademark rights in its name based on the use in commerce.
  139. See, e.g., Barcamerica Int'l USA Trust v. Tyfield Imps., Inc., 289 F.3d 589 (9th Cir. 2002).
  140. See N.Y. Civ. Rts. Law §§ 50-51; Caesar v. Chemical Bank, 496 N.Y.S.2d 418 (1985) (statute violated where employees orally consented and posed for photograph exhibited at trade show).

# How the Band Protects Its Brand: The Use of Trademarks to Protect and Promote the Musical Artist

(Part Two of a Two-part Article — Part One was published in the March issue)

BY CHRISTOPHER R. CHASE, ESQ. OF  
FRANKFURT KURNIT KLEIN & SELZ, P.C.

*Mr. Chase is an intellectual property and entertainment attorney with Frankfurt Kurnit Klein & Selz, P.C. in New York. He can be reached at [cchase@fkks.com](mailto:cchase@fkks.com). The author thanks Marc Handelman, Brian G. Murphy and Alexandra VonHockman for their insightful comments.*

## THE USE OF TRADEMARK LAW TO PROTECT AN ARTIST'S BRAND

As discussed in Part One, musical artists are becoming brands used to promote their own, and others', goods and services. So how do artists protect their brand? Through trademark law.

### **Trademark Law in the Music Industry**

A trademark or service mark is a word, name, symbol, or device<sup>56</sup> that informs the public of the source of the goods or services being offered, and assures the public of the legitimacy and quality of the goods or services being offered. Generally referred to on the whole as just "trademarks," service marks are used to identify services offered to the public, while a trademark, on the other hand, distinguishes the words, names, symbols, or devices used on tangible physical goods. In the music industry, an artist's professional name may function as a service mark for entertainment services if it is used to identify and distinguish the service of providing live performances from other artists<sup>57</sup> or as a trademark for a series of musical recordings or other merchandise such as t-shirts, stickers, and posters.<sup>58</sup>

In the United States, trademark and service mark rights are created by use in commerce and the resulting development of "secondary meaning"<sup>59</sup> — the public's recognition and association of the mark with a source of goods or services. Because rights are based on use, an artist need not register his, her or its name in order to claim rights in or protection for that name

as a mark.<sup>60</sup> The artist must only be the first party to continuously use the name in commerce for the specific goods and services offered under that name.<sup>61</sup>

Nevertheless, although it is not required to protect a mark, federal registration of a trademark or service mark provides certain statutory benefits that are not provided by an unregistered or "common law" mark, such as 1) prima facie evidence as to the validity of the registered mark;<sup>62</sup> 2) validity of the registration itself;<sup>63</sup> 3) the registrant's ownership of the mark;<sup>64</sup> 4) constructive notice of the registrant's claim of ownership;<sup>65</sup> and 5) the exclusive right to use the mark in commerce on the goods or services specified in the registration certificate.<sup>66</sup> Registering the professional name as a trademark or service mark with the United States Patent and Trademark Office ("USPTO") is truly the best way to protect it because registration prevents third parties and departing group members from capitalizing on the name.<sup>67</sup> Essentially, although an artist may have a common law trademark or service mark in its name because of its prior use of that name, it is always prudent to register the mark with the USPTO because such registration presumes the validity of the mark and gives the artist a stronger right to prevent confusingly similar uses of such mark by others in the United States.<sup>68</sup>

In order to claim trademark or service mark rights in its professional name, the most significant thing an artist can do is to deliberately and continuously use the mark in public over a geographically extensive area to identify itself.<sup>69</sup> This use must be continuous, as it is possible that if an artist held trademark rights to its name and ceased touring, making and releasing records, and receiving royalties, it would be deemed to have stopped use of its name because the public would no longer identify the artist with activities in the music industry.<sup>70</sup> Therefore, an artist should actively perform and offer, or at least collect royalties for, records, CDs or other merchandise

under its professional name to maintain trademark or service mark status.<sup>71</sup>

Finally, the following are well-known examples of the various types of trademarks and service marks available in the music industry: 1) group names such as LED ZEPPELIN,<sup>72</sup> PEARL JAM,<sup>73</sup> and SPICE GIRLS;<sup>74</sup> 2) individual performer names such as SNOOP DOGG<sup>75</sup> and PRINCE;<sup>76</sup> 3) individual artists who perform under their real names such as MICHAEL JACKSON<sup>77</sup> and DAVE MATTHEWS;<sup>78</sup> 4) music industry logos such as THE ROLLING STONES "LIPS" logo,<sup>79</sup> the ARISTA "A" logo,<sup>80</sup> and even the faces of the members of KISS;<sup>81</sup> and 5) music industry companies' names such as the GHOSTLY INTERNATIONAL<sup>82</sup> record label and the VIRGIN<sup>83</sup> record label.

### **Choosing and Clearing the Artist's Name**

Like any other trademark, when selecting an artist's professional name it is important to adopt a name that is both distinctive and unique. The more distinctive the name, the more effective the protection the name has as a trademark. Moreover, an artist should not only choose a distinctive name to protect its own identity, but the artist needs to avoid infringing upon other parties' names.<sup>84</sup> Because the likelihood of confusion between two marks is the hallmark for trademark violations, a new artist should not choose a professional name that is identical to or confusingly similar to an existing name in the music industry. Litigation over the proper ownership of a name requires both time and money, and there is a risk that the artist could lose the right to use the name. Because the goodwill in its name is all a new artist has when starting its foray into the music industry, starting over is an unattractive option. Therefore, it is extremely important for an artist to clear his, her, or its professional name prior to significant use in the industry.

There have been numerous instances where an up and coming artist had to change its name due to trademark problems. For example, DINOSAUR JR. (formerly DINOSAUR),<sup>85</sup> THE HOPEFULS (formerly THE OLYMPIC HOPEFULS),<sup>86</sup> GREEN JELLY (formerly GREEN JELLÖ),<sup>87</sup> AL FATZ (formerly FAT AL),<sup>88</sup> DEATH FROM ABOVE 1979 (formerly DEATH FROM ABOVE),<sup>89</sup> and THE VERVE (formerly VERVE)<sup>90</sup> all had to change their professional names due to various trademark issues, the latter two involving similar record label names rather than

other artist names. Moreover, commercial success does not guarantee litigation success: relative unknowns have forced successful artists to change their professional names.<sup>91</sup> A recent example involved CBS' rock band reality show *Rock Star: Supernova*, wherein the band, comprising famous musicians and the show's winner, would be called SUPERNOVA. A lawsuit filed by a lesser known band called SUPERNOVA forced the reality band to change its name (not too creatively to ROCK STAR SUPERNOVA).<sup>92</sup> Even the U.S. Postal Service was not pleased to see that there was an artist called "The Postal Service," but an amicable resolution allowed the artist to retain its name.<sup>93</sup>

Because the music industry is global, artists must also choose a name that will not infringe on foreign artists' marks if the artist desires to reach foreign markets. In the mid-1990's, popular British bands SUEDE and THE CHARLATANS were forced to change their names for the U.S. market due to artists' prior uses of those names in the United States.<sup>94</sup> SUEDE's change to THE LONDON SUEDE and THE CHARLATANS' change to THE CHARLATANS U.K. may have harmed both bands' chances at widespread U.S. success, as they could not rely on the goodwill associated with their famous name back home. Therefore, it is imperative that an artist conduct a global music industry search in order to avoid any potential trademark conflicts.

It is simply not enough to take a trip to the local record store to clear an artist's name. An artist must check numerous sources to survey the global music industry, such as the databases of the performing rights societies (e.g., ASCAP, BMI, SESAC) and musicians' unions (such as the American Federation of Musicians), music magazines including *Rolling Stone*, *Spin*, and *Billboard*,<sup>95</sup> and review popular music websites such as MySpace, PureVolume, Pitchfork, All Music Guide, and The Band Register.

Finally, having the clear right and title to an artist's professional name is necessary if the artist seeks to sign a recording contract or license its name for merchandising purposes. Because record labels will need to use the name in connection with the marketing and sale of pre-recorded audio and other merchandise bearing that name, they will generally not sign an artist unless that artist owns the rights to its name, free and clear of any third party rights<sup>96</sup> and will

www.ConflictChecker.com

**Conflict**  **Checker**

Instant Online Conflict Checks

IP Intelligence on Companies and Law Firms

require that the artist in the record contract represent and warrant to this effect.<sup>97</sup>

### **Protection of Artists' Names**

Recognizing the value of an artist's name as a mark, courts have frequently applied trademark law to protect the professional names of artists.<sup>98</sup> As noted in the Part One of this article, rights to an artist's professional name and the right to perform under that professional name are significant rights in the music and recording industry.<sup>99</sup> Such rights are monetarily valuable<sup>100</sup> to both the artist and record companies alike, and preventative legal measures should be taken in order to ensure protection of the name.

Regardless of whether it is registered or not, the artist's professional name will only have trademark protection in the field for which the mark is used, and in the logical zone of expansion of that field.<sup>101</sup> For artists, this field will primarily include musical performances and pre-recorded audio and video. Ancillary goods, such as posters and t-shirts, may be within the logical zone of expansion, but the artist's professional name often needs to achieve secondary meaning in order to have trademark protection for such goods.<sup>102</sup>

Once the artist's professional name is properly used as a trademark or service mark, the artist must enforce its rights to that mark. No other party in the industry should use or exploit the professional name without permission, if at all.<sup>103</sup> Not protecting the name could be perceived as demonstrating the inherent weakness of the artist's name as a mark. Therefore, the artist must prevent other parties in the music industry, including other artists or bootleg merchandisers,<sup>104</sup> from using or exploiting his, her, or its valuable mark.

Artists should also register their professional name as an Internet domain name.<sup>105</sup> While this is not a substitute for trademark registration, operating a website with that domain name would go a long way to show use of the name as a mark in commerce and would put others on notice of the artist's use of the name in the music industry.

### **Trademark Issues for Group Artists**

#### **CONCEPT GROUPS**

Because the owner of trademark rights is the person or entity that controls the quality of the goods or services offered under the mark,<sup>106</sup> the owner of trademark rights in an artist's name is not always the artist. This is especially true with "concept groups" – those groups that are the creations of a producer, promoter, or manager and whose members are essentially interchangeable parts.<sup>107</sup>

Generally speaking, a concept group is created by a producer, promoter, or manager who (essentially) hires performers to play the roles in the group and directs the group's performances.<sup>108</sup> Examples of such concept groups include NEW KIDS ON THE BLOCK, MENUDO, THE MONKEES, SPICE GIRLS, BACKSTREET BOYS, and N\*SYNC. While not necessarily a group, AMERICAN IDOL is one of the most recent and most popular concept phenomena.

Where the producer, promoter, or manager of the concept group controls the quality of goods and services associated with that group, such person is the valid owner of the trademark rights in the group's name, even if this person is not in the group itself.<sup>109</sup> Courts have found that ownership of a concept group's professional name in the name of the producer, promoter, or manager is legally appropriate where the public associates with the concept group charac-

teristics or a style that is or are controlled by the producer, promoter, or manager.<sup>110</sup>

Ownership of the concept group's name is extremely important, because the owner essentially owns the shell of the group itself and just rotates performers in and out without necessarily changing the group's overall identity. Successful concept groups not only generate a substantial amount of money through their live performances and sound recordings, but also make considerable sums of money with merchandising and ancillary goods. For example, NEW KIDS ON THE BLOCK sold nearly \$75 million in concert tickets and over \$1 billion in merchandise during the group's heyday in 1990.<sup>111</sup> Also, Epic Records recently acquired an equity stake to re-launch the Latino concept group MENDUO, in order to resurrect the brand by offering a new album and a reality show in 2007.<sup>112</sup> The current concept group money leader is AMERICAN IDOL, which in 2004 alone generated more than \$900 million in sales of TV advertisements, sound recordings, merchandise, and concert tickets,<sup>113</sup> and was conservatively valued at the start of 2007 as a \$2.5 billion franchise.<sup>114</sup> Therefore, the ownership of such concept group names becomes a significant point because such owner will control the nature and quality of the goods and services being offered under that name, even if the individuals in the group have changed or the group has been dormant for a number of years.

#### **DISSOLUTION AND/OR MEMBERSHIP CHANGES**

In group situations, the dissolution and/or change of membership of the artist presents difficult problems of ownership of the trademark rights in the artist's professional name. There have been numerous lawsuits regarding ownership of a group name either following the dissolution of the group or when former members attempt to use the name, while the original group continues to use it.<sup>115</sup>

A group that disbands does not immediately abandon exclusive rights in its name.<sup>116</sup> Thus, a subsequent artist should not use such name, because the subsequent artist cannot assume that the name is no longer being used by the original artist.<sup>117</sup> It is often the case that a group continues to sell sound recordings and collect royalties even if it is not performing, and therefore continues to use the name as a mark in commerce.

Also, when confronted with the issue of departing group members who use the name of their former group, courts have determined that members of a group do not retain rights to use the group's name when such members leave that group.<sup>118</sup> However, the former members may properly refer to themselves as a "former member of [group]" or "original member of [group]" when advertising his or her new entertainment services or sound recordings.<sup>119</sup>

Because of the difficult issues that face dissolved groups or the departing members of groups, it is important to have an agreement among the members of the artist regarding the use of the group's name.<sup>120</sup> Often a group will be a partnership or incorporated entity; therefore, all group partnership or internal corporate agreements should specifically outline the rights to the group name and what will happen to that name upon dissolution of the group or the departure of a member. Another way to prevent the problem of departing members using the group's name is to have the group, as a partnership or incorporated entity, federally register the name as a mark. If the group as a whole owns the registered mark, then the group can prevent any departing member from using such name, while continuing to protect the name of the group against other third party uses.<sup>121</sup>

#### **RIGHTS OF PUBLICITY UNDER STATE LAW**

In addition to the use of trademark law to protect the artist's name, state right of publicity laws can offer additional protection.<sup>122</sup> Although trademark law tends to overlap with state right of publicity laws, these state laws generally protect a person's name, picture, voice, or likeness against commercial appropriation regardless of whether one of these attributes serves a source identifying function<sup>123</sup> or not.<sup>124</sup> Such rights have been extended to an artist's professional name<sup>125</sup> – be it the artist's actual name or stage name.<sup>126</sup> For example, two popular artists have recently sued third parties for unauthorized use of the artists' names, images, and likenesses. The band WEEZER sued Miller Brewing Co. and its advertising agency under both right of publicity and trademark laws for using the name WEEZER in advertisements promoting Miller's beer, arguing that its name was being commercially appropriated without authorization.<sup>127</sup> Also, the singer JACKSON BROWNE sued Bloomingdale's and clothing manufacturer

Natalie and Friends under both right of publicity and trademark laws for using Browne's name and image on t-shirts sold at the department store.<sup>128</sup>

Because artists often license their names and likenesses for commercial exploitation,<sup>129</sup> the artist has a strong interest in preventing unauthorized use of their publicity rights and can do so through both right of publicity and trademark laws.<sup>130</sup>

#### **DEVELOPING AN EFFECTIVE TRADEMARK STRATEGY**

In order to successfully protect its professional name, the artist should develop an effective trademark strategy – from choosing a professional name to enforcing the rights included in such name – as well as protecting his, her, or its rights of publicity.

As noted above, when choosing a professional name, an artist should keep in mind that the more distinctive the name, the more effective the protection the name has as a trademark.<sup>131</sup> Prior to choosing a name, the artist should not only perform internet searches and review music industry websites and publications to determine whether another artist or music industry player is using a confusingly similar name,<sup>132</sup> but the artist should also conduct a preliminary search of the USPTO online database.<sup>133</sup> Such a search would give the artist an idea of whether the name appears clear from a trademark perspective.<sup>134</sup> It may also be useful to order a comprehensive search from a trademark search vendor in order to gain a clearer picture of the possibility of using the name as a mark, as these searches generally cover both federal and state trademarks, common law trademarks, corporate names and trade names.<sup>135</sup> Nevertheless, since trademarks in the United States exist by virtue of use rather than registration, no search is completely effective.

After the artist has evaluated the risks associated with the results of the trademark searches and has decided to go forward using a specific professional name, applying for federal registration of the name as a trademark and service mark should be the next step.<sup>136</sup> Trademark applications with the USPTO are filed within specific classes of goods or services.<sup>137</sup> The artist should apply for a trademark for its name in Class 9, which covers sound recordings and audio-visual recordings, and Class 41, which covers live performances, production services, and services offered through the

artist's website. Other relevant classes of goods for merchandising purposes include Class 16, which covers printed material such as books, magazine, posters, and stickers, and Class 25, which includes t-shirts and hats. Once registered, the artist will have to maintain the trademark registration in order to keep the registration "alive" in the USPTO.<sup>138</sup> Nevertheless, the most important thing that an artist can do to maintain trademark rights in its name is to use the name consistently and continuously in commerce over a geographically extensive area for the goods and services that the artist provides.

Once the artist has started accruing trademark rights in its name, the artist will have to begin policing the name for the use of confusingly similar names in the industry. This will include issuing cease and desist letters to any other party thought to be using a confusingly similar or potentially diluting name. If necessary, the artist may need to enforce its rights in the name by bringing opposition or cancellation proceedings in the USPTO, or lawsuits in federal or state courts.

All of these steps are necessary precursors to licensing an artist's "brand," as third parties will not want to associate themselves with a weak or diluted brand or one that may lead to lawsuits based on a trademark claim. When a third party is interested in licensing the artists' trademark as part of the brand, the artist should take care to create a licensing agreement that is both monetarily valuable and sufficient to protect the artist's rights. Although there is no one "correct" way to structure a trademark licensing agreement on behalf of the artist, the following are a few helpful tips to consider when drafting the agreement. The licensor of the trademark, which could include the artist, should focus on: 1) ensuring quality control over the use of the trademark; 2) specifically defining the rights being licensed; 3) retaining approval rights for how and on which products the trademark are used; 4) assessing the risk of inadvertent creation of a franchising agreement; 5) licensing the trademark for a short term, in a limited territory, and with a broad termination right; 6) including a provision allowing the licensor to terminate the agreement if the licensee has not reached certain sales goals; 7) including a "licensee estoppel" provision that prevents the licensee from challenging or interfering with the licensor's rights to use and/or reg-

ister the trademark; and 8) requiring the licensee to carry product liability insurance. The quality control provision may be the most important provision for a licensor, as a trademark license that does not contain such a provision, or under which no quality control has been exercised, may be considered a "naked license" and may result in the an abandonment or tarnishment of the licensor's trademark.<sup>139</sup>

Additionally, licensing the "brand" may include the artist's rights of publicity. Under state law, a written release is generally necessary whenever a person's rights of publicity, *e.g.*, name, picture, voice, or likeness, are used in advertising or for the purposes of trade.<sup>140</sup> Like licensing a trademark, when an artist is licensing his, her, or its rights of publicity there are a few key points on which the artist should focus: 1) the grant of the rights, including the specific attributes of the artist being licensed; 2) the type of media where the artist's rights will be used, such as television, radio, print, and the internet; 3) the manner of use of the artist's rights; 4) the geographic territory where the rights will be used; 5) the breadth of the artist's termination rights; and 6) the artist's creative control over the use of the rights, including approval rights for any use. Because the artist wants to ensure that his, her, or its image will not be tarnished in any way, the grant of rights clause may be the most significant provision, as it should be very specific as to each and every attribute being granted.

While this section is not an exhaustive list of steps to take in order to protect an artist's trademark rights, it should be viewed as a helpful summary when establishing a trademark and right of publicity strategy.

## CONCLUSION

The rights in an artist's professional name are extremely important. Artists not only promote corporate branding but they themselves have become brands. The artist's professional name therefore is a valuable commodity that helps consumers identify the artist's goods and services. It is imperative that an artist develop a strong trademark strategy, which includes clearing his, her, or its professional name before offering goods or services under that name, and protecting the name once it is used in commerce. While it may seem like an expensive proposition during the start-up

**Patentability Searches: \$500**

**Invalidity Searches: \$1500**

**Finding the 102 you need:**

**PRICELESS**

**metroPatent™**

**The Search Firm**

**(V) 800-298-4624 (F) 800-299-6394  
service@metropatent.com**

phase of an artist's career, obtaining trademark protection is well worth the effort if the artist wants a long lasting career in the industry. By doing so, the artist will protect his, her or its identity and brand. **IPIT**

## ENDNOTES

56. 15 U.S.C. § 1127.
57. USPTO Trademark Manual of Examining Procedure § 1301.02(b); *see Creative Arts By Calloway, L.L.C. v. Brooks*, 48 Fed. Appx. 16 (2d Cir. 2002) ("entertainment" may be considered a service in connection with the law of service marks).
58. *See* USPTO Trademark Manual of Examining Procedure § 1202.09(a). Registering the name of an artist for sound recordings is only allowed where: 1) the mark is used on a series of sound recordings (at least two different recordings); and 2) the owner controls the nature and quality of the goods. *Id.*; *In re Polar Music Intern. AB*, 714 F.2d 1567 (Fed. Cir. 1983); *In re Ames*, 160 U.S.P.Q. 214 (T.T.A.B. 1968). *See also supra* note 18 regarding the number of KISS goods registered with the USPTO.
59. *Allard Enterprise, Inc. v. Advance Programming Resources, Inc.*, 249 F.3d 564, 571 (6th Cir. 2001).
60. *Gronin v. Rossington*, 690 F. Supp. 200, 208 (S.D.N.Y. 1988); *Cash v. Brooks*, 1996 WL 6844447 at \*12 (E.D. Tenn. April 24, 1996) ("Names of popular musical entertainment and recording groups are protected by the Lanham Act even though that name is not a registered trademark. 'Usage, not registration, confers the right to a trademark.'") (citations omitted).
61. *See Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1105 (6th Cir. 1991).
62. 15 U.S.C. §§ 1057(b), 1115(a).
63. 15 U.S.C. §§ 1057(b), 1115(a).
64. 15 U.S.C. §§ 1057(b), 1115(a).
65. 15 U.S.C. § 1072.
66. 15 U.S.C. §§ 1057(b), 1115(a).
67. Additionally, unlike common law marks, if the artist intends to use a name in commerce but has not done so, the artist may apply for trademark registration based on that intent, and receive priority over any subsequent users. 15 U.S.C. § 1051(b).

68. Nevertheless, each case involves its own particular facts, and overgeneralization is always risky.
69. See Circuit City Stores, Inc. v. Carmax, Inc., (165 F.3d 1047, 1054 (6th Cir. 1999) (the use of a mark must be “deliberate and continuous, not sporadic, causal, or transitory.”). For an artist, it is important to use the name throughout the United States; it is possible that an artist will use a name in one region of the United States, while another artist will use the same name in a different region. The artist that first uses the name nationally will be able to claim national trademark rights.
70. See Stetson v. Howard D. Wolf & Assocs., 955 F.2d 847, 851 (2d Cir. 1992).
71. It is possible that an artist not taking these actions may be deemed to have “abandoned” the mark to the public domain. See Densmore v. Manzarek, Case Nos. BC 289730 and BC 294495 at 39 (Cal. Super. Ct. July 21, 2005) (finding that THE DOORS was not abandoned as a mark as the sale and air play of the group’s music has been continuous over the years); Kingsmen v. K-Tel Intern. Ltd., 557 F. Supp. 178, 183 (S.D.N.Y. 1983).
72. See USPTO Trademark Reg. No. 2212548.
73. See USPTO Trademark Reg. No. 1916938.
74. See USPTO Trademark Reg. No. 2698988.
75. See USPTO Trademark Reg. No. 2697128.
76. See USPTO Trademark Reg. No. 3128896.
77. See USPTO Trademark Reg. No. 1908209.
78. See USPTO Trademark Reg. No. 2785724.
79. See USPTO Trademark Reg. No. 2825378.
80. See USPTO Trademark Reg. No. 1051174.
81. See USPTO Trademark Reg. No. 1128762.
82. See USPTO Trademark Reg. No. 2811089.
83. See USPTO Trademark Reg. No. 1469618.
84. See, e.g., Kaufhold v. Yeomans, Opposition No. 91160771 (Trademark Tr. & App. Board September 26, 2006) (Once Opposer demonstrated priority of use, the TTAB sustained an opposition of the application for the service mark THE UNDEAD for live performances by a punk rock band based on Opposer’s common law mark THE UNDEAD for live performances by a punk rock band); Robert Craig “Evel” Knievel v. Kayne West, et al., Case No. 06cv 02269, (M.D. Fla. December 11, 2006) (“Evel” Knievel, who owns the trademark EVEL KNIEVEL, sued rap star Kanye West over West’s “Touch the Sky” video in which West takes on the persona of “Evel Kaynevel” and mimic’s Knievel’s daredevil act).
85. See Chris Riemenschneider, Rock band hits hurdle with ‘Olympic’ name, STAR TRIBUNE, July 28, 2005 (noting DINOSAUR JR.’s name change due to a trademark dispute with another group).
86. See Id. (discussing the ownership of the word OLYMPIC by the U.S. Olympic Committee, which forced THE HOPEFULS to drop the “Olympic” portion of their name; ironically, the band was originally going to call itself CAMARO, but changed their minds due to potential trademark issues).
87. See Donald Passman, ALL YOU NEED TO KNOW ABOUT THE MUSIC BUSINESS, at 318; biography of GREEN JELLY at All Music Guide, available at <http://www.allmusic.com/cg/amg.dll?p=amg&sql=11:7kd5vwpva9yk>.
88. Teenage rap artist Alijaray Gaston went by the name “Fat Al” until Bill Cosby stepped in, citing the Cosby-created character Fat Albert. Gaston’s record label, Atlantic Records, attempted to settle with Cosby, but ultimately changed Gaston’s performing name to “Al Fatz.” Teen rapper fights over ‘Fat’ with Bill Cosby, REUTERS, November 13, 2006.
89. See Rodrigo Perez, Death From Above 1979, MTV.COM, available at [http://www.mtv.com/news/yhif/death\\_from\\_above\\_1979/](http://www.mtv.com/news/yhif/death_from_above_1979/); Dave Morris, review of You’re a Woman, I’m a Machine by DEATH FROM ABOVE 1979, SEATTLE WEEKLY, January 5, 2005, available at [http://www.seattleweekly.com/music/0501/0501\\_05\\_music\\_cdreviews.php](http://www.seattleweekly.com/music/0501/0501_05_music_cdreviews.php) (noting that the group inserted the “1979” into their name following a cease and desist letter from the DEATH FROM ABOVE record label).
90. See biography of THE VERVE at VH1.com, available at <http://www.vh1.com/artists/az/verve/bio.jhtml> (explaining the name change due to a lawsuit filed by the American jazz label VERVE).
91. See Stuart v. Collins, 489 F. Supp. 827 (S.D.N.Y. 1980) (Bootsy Collins and Warner Brothers Records were found to have willfully infringed an artist’s mark after the artist informed them that his registered mark THE RUBBERBAND had priority trademark rights over BOOTSY COLLINS’ RUBBER BAND).
92. See Supernova from Cynot3, LLC v. Mark Burnett Productions, Inc., Civ. No. 06CV1334 JAH (RBB) (S.D. Cal. Sept. 12, 2006) (granting preliminary injunction on behalf of plaintiff based on its unregistered mark SUPERNOVA for a band); Judge orders made-for-TV band to change name, REUTERS, September 14, 2006; Jonathan Cohen, Trademark Dispute Settled Over Supernova Name, BILLBOARD, September 21, 2006.
93. Ben Sisario, Postal Service Tale: Indie Rock, Snail Mail, and Trademark Law, N.Y. TIMES, Nov. 6, 2004, A1.
94. See David Barnett, SUEDE: LOVE AND POISON, at 143, Andre Deutsche Ltd. 2003 (attributing the group’s lack of success in breaking America to the lawsuit filed by jazz-folk singer Suzanne deBronkart, who performed as SUEDE, and the group’s resultant name change to THE LONDON SUEDE); USPTO Trademark Reg. No. 1824688 (the mark SUEDE owned by Suzanne deBronkart for entertainment services); “The Charlatans U.K.” biography at VH1.com, available at [http://www.vh1.com/artists/az/charlatans\\_uk/bio.jhtml](http://www.vh1.com/artists/az/charlatans_uk/bio.jhtml) (noting that one the eve of the group’s first American tour, it had to change its name to THE CHARLATANS U.K. because a San Franciscan garage rock group from the 1960’s were already called THE CHARLATANS); Riemenschneider, supra note 70 (noting THE CHARLATANS’ name change due to a trademark dispute with another group with the same name).
95. A magazine article is relevant when showing the first use of a mark if there were two groups claiming that they made the first commercial use of the mark. See Far Out Productions, Inc. v. Oskar, 247 F.3d 986 (9th Cir. 2001).
96. If there is a conflict, the label may force the artist to change the name prior to the release of any recordings or merchandise. See Champagne v. DiBlasi, 134 F. Supp. 2d 310 (E.D.N.Y. 2001) (the record company stated that the group had to obtain trademark rights in its name or else the group would have to change its name to one that could receive trademark protection; here, because their name potentially violated a third party’s rights, the group dropped it). An artist should be careful, however, to not assign the ownership rights in the name to the record company. Rather, the artist should grant a non-exclusive license to the record company to use the name for marketing purposes for any recordings made under the contract.
97. A violation of the artist’s representations and warranties could lead to termination of the contract by the record company or an indemnification of the record company by the artist if a third party brings a claim.
98. See Mears v. Montgomery, 2006 WL 1084347 (S.D.N.Y. April 24, 2006) (citing Stetson v. Howard D. Wolf & Assocs., 955 F.2d 847, 852 (2d Cir. 1992), Marshak v. Sheppard, 666 F. Supp. 590, 600 (S.D.N.Y. 1987), and Rare Earth, Inc. v. Hoorelbeke, 401 F. Supp. 26 (S.D.N.Y. 1975)); Bagdasarian Productions v. Audiofidelity Enters., Inc., 1984 WL 1565 (D. N.J. October 3, 1984) (records by “The Happy Chipmunks” violated the common law and registered marks of THE CHIPMUNKS); Kingsmen v. K-Tel Intern. Ltd., 557 F. Supp. 178 (S.D.N.Y. 1983); Stuart v. Collins, 489 F. Supp. 827 (S.D.N.Y. 1980).
99. In the Matter of Atlantic Recording Corp. et al., 747 N.Y.S. 2d 889, 890 (N.Y. Sup. Ct. 2002).
100. See Rodgers v. Anderson, 2005 WL 950021 (S.D.N.Y. April 26, 2005) (awarding plaintiff, the founder of and owner of the registered mark CHIC, \$250,000 for the willful infringement of the mark by defendants, former backup singers of CHIC who were performing as “Chic”). Trademark rights in artist’s names are valuable enough that an artist may buy out another artist’s rights in a name in order to own such name. See Tradem Inc. v. Stainbrook, 2004 WL 1047956 (S.D.N.Y. May 10, 2004) (discussing the assignment of an individual artist’s registered mark THE STAIN to the group STAIND for \$18,000; STAIND in turn licensed THE STAIN back to the individual for use with his performances in the Ohio area); Colleen Long, Singer Black Owns His Own Name, Court Rules, ASSOCIATED PRESS, December 7, 2006 (members of the group JAY AND THE AMERICANS purchased the group name from former lead singer Jay Black in a bankruptcy auction for \$100,000; “lawyers for the bankruptcy trustee handling the case considered the band name a valuable asset”).
101. USPTO Trademark Manual of Examining Procedure § 1207.01(a)(v); see Sullivan v. CBS Corp., 385 F.3d 772, 776-777 (7th Cir. 2004) (the group SURVIVOR is entitled to strong protection against other musical group names, but there is no presumption that the mark is equally strong outside that realm; therefore, the television show “Survivor” did not infringe on the band’s trademark rights for musical services); CPG Products Corp. v. Perceptual Play, Inc., 221 USPQ 88 (TTAB 1983) (The test is whether purchasers would believe the product or service is

- within the registrant's logical zone of expansion).
102. This secondary meaning can be established by the success of the artist, such as by the number of record albums sold and merchandise sold on the artist's behalf. Winterland Concessions Co. v. Macintosh, 1992 WL 170897 (E.D. Pa. July 14, 1992); Gore v. Does, 1998 WL 778374 (S.D.N.Y. Nov. 6, 1998).
  103. See supra note 35 (discussing Nike's use of MINOR THREAT's name and album cover art to promote Nike's Major Threat skateboarding tour).
  104. See Cash v. Brooks, 1996 WL 6844447 (E.D. Tenn. April 24, 1996) (finding likelihood of confusion for former group members performing under the name THE IMPRESSIONS when the public identifies the original group as THE IMPRESSIONS); Kaufhold v. Yeomans, Opposition No. 91160771 (Trademark Tr. & App. Board September 26, 2006) (artist performing under the common law mark THE UNDEAD successfully opposed another artist using the name THE UNDEAD); Winterland Concessions Co. v. Macintosh, 1992 WL 170897 (E.D. Pa. July 14, 1992) (bootleg merchandisers); Gore v. Does, 1998 WL 778374 (S.D.N.Y. Nov. 6, 1998) (bootleg merchandisers); Polygram Merchandising, Inc. v. New York Wholesale Co., 2000 WL 23287 (S.D.N.Y. Jan. 13, 2000) (bootleg merchandisers); Virgin Enters. Ltd. v. David Defeis, 2000 WL 1720144 (Trademark Tr. & App. Bd. October 26, 2000) (owner of the VIRGIN, VIRGIN RECORDS, and VIRGIN MEGASTORE marks successfully opposed a musician applying for the trademark VIRGIN STEELE for sound recordings, clothing, and musical entertainment); BMG Special Products, Inc. v. David Anthony Jagosz, 2003 WL 22477869 (Trademark Tr. & App. Bd. October 30, 2003) (owner of the marks BUDDA and BUDDAH for a record label successfully opposed a musician applying for the trademark YOU DA BUDDA for sound recordings and entertainment services).
  105. Artists should actually purchase a domain name rather than just relying on a MySpace.com page even if they do not have an associated website yet. The artist could always redirect viewers of the domain to the artist's MySpace.com page. Solely having a MySpace.com page for the artist's web address may be problematic, as MySpace.com itself owns all of the MySpace urls. For example, the Louisiana-based rock band BONES temporarily lost their MySpace.com url ([www.myspace.com/bones](http://www.myspace.com/bones)) when MySpace.com's corporate partner Fox wanted the url for its television show *Bones*. Luckily for the band, they were able to retain the url after the issue was sorted out. Band Loses, Regains MySpace URL, FMQB.com, November 7, 2006, at [www.fmqb.com/Article.asp?t=p&id=301843](http://www.fmqb.com/Article.asp?t=p&id=301843).
  106. See Rick v. Buchansky, 609 F. Supp. 1522 (S.D.N.Y. 1985); see also Blackwood v. R.W. Blackwood, 2005 WL 2096857 (E.D. Tenn. Aug. 30, 2005) (noting that the person or entity that maintains control over a musical group is the person or entity that owns the trademark rights in the name). Registering the name of an artist for sound recordings is only allowed where: 1) the mark is used on a series of sound recordings (at least two different recordings); and 2) the owner controls the nature and quality of the goods. Rick, 609 F. Supp. at 1522; In re Polar Music Intern. AB, 714 F.2d 1567 (Fed. Cir. 1983).
  107. See Rick v. Buchansky, 609 F. Supp. 1522 (S.D.N.Y. 1985); Stetson v. Howard D. Wolf Associates, 955 F.2d 847 (2d Cir. 1992) (holding that because the manager "used" and did not abandon the mark THE DIAMONDS, his successor in interest could enjoin former group members' new group under the same name).
  108. See In the Matter of Atlantic Recording Corp. et al., 747 N.Y.S.2d 889, 890 (N.Y. Sup. Ct. 2002).
  109. Rick v. Buchansky, 609 F. Supp. 1522 (S.D.N.Y. 1985); but see Bell v. Streetwise Records Ltd., 761 F.2d 67 (1st Cir. 1985) (determining that although the individual members of "New Edition" did not have trademark rights in the group name for phonorecords, as they did not market phonorecords under that name until the producer employed the individual members, the members, both individually and collectively, had service mark rights in the group's name for the field of live musical entertainment).
  110. In the Matter of Atlantic Recording Corp. et al. at 891 (although the contract at issue explicitly gave the producer of the concept group "Dream Street" the ownership of the trademark and trade name, the court also noted that the producer spent over \$2 million to create, produce, and promote the group); Rick v. Buchansky, 609 F. Supp. 1522 (S.D.N.Y. 1985) (finding that the manager of "Vito and the Salutations" was entitled to an injunction against the use of the name by former members of the group; the manager was the owner of the name since he "exerted influence over the style and content of the group's act" and "functioned much like the producer of a theater company or owner of a sports team" where various performers played the parts and positions).
  111. Peter Newcomb, It's Slippery at the Top, FORBES, September 30, 1991; see The New Kids on the Block v. News America Publishing, Inc., 971 F.2d 302, 304 (9th Cir. 1992) ("there are more than 500 products or services bearing the NEW KIDS trademark").
  112. Ayala Ben-Yahuda, Epic to Sign Menuo: MTV Plans Reality Show, BILLBOARD, October 13, 2006 (over the years, MENUO became "an instantly recognizable mainstream brand"). This deal gives Epic a cut of MENUO by-products such as touring, merchandising, ringtones, a cartoon series, and other branded revenue streams. Id.
  113. David Lieberman, 'American Idol' Zooms From Hit Show to Massive Business, USA TODAY, March 29, 2005, available at [http://www.usatoday.com/life/television/news/2005-03-29-media-usat\\_x.htm](http://www.usatoday.com/life/television/news/2005-03-29-media-usat_x.htm); David Lieberman, 'American Idol' Backers Nervously Wait In The Wings, USA TODAY, January 16, 2006, available at [http://www.usatoday.com/money/media/2006-01-16-usat\\_xhtm?csp+34](http://www.usatoday.com/money/media/2006-01-16-usat_xhtm?csp+34).
  114. Claire Atkinson, 'Idol' Juggernaut Passes \$2.5 Billion in Value: Keeps Expanding, ADAGE.COM, January 8, 2007 (stating that AMERICAN IDOL is "vying for the title of the most lucrative multimedia property of all time").
  115. See e.g., Marshak v. Sheppard, 666 F. Supp. 590 (S.D.N.Y. 1987) (THE DRIFTERS); HEC Enters., Ltd. v. Deep Purple Inc., 213 U.S.P.Q. 991 (DEEP PURPLE); Giammarese v. Delfino, 197 U.S.P.Q. 162 (N.D. Ill. 1977) (THE BUCKINGHAMS); Cash v. Brooks, 1996 WL 6844447 (E.D. Tenn. April 24, 1996) (THE IMPRESSIONS).
  116. 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 10:40 (4th Ed. 2006). Section 45 of the Lanham act provides that a mark can be considered abandoned: "When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Non use for three consecutive years shall be prima-facie abandonment." 15 U.S.C. § 1127. The Second Circuit Court of Appeals has held that "to prevail on a claim that a trademark has been abandoned, the party claiming abandonment must show (1) non-use by the owner of the trademark or trade name and (2) the intent by the owner not to resume using the name or the mark." Mears v. Montgomery, 2006 WL 1084347 at \*8 (S.D.N.Y. April 24, 2006) citing Silverman v. CBS Inc., 870 F.2d 40, 50 (2d Cir. 1989) (also noting that two years of non-use of a trade name by its legal owner creates a "rebuttable presumption of abandonment.>").
  117. See Kingsmen v. K-Tel Int'l, Ltd., 557 F. Supp. 178 (S.D.N.Y. 1983) (a group that ceased recording and disbanded in 1967 did not abandon rights in the group name; the court found that the continued use of the name to promote the sale of previous recordings and the receipt of royalties from those sales negates any inference of an intent to abandon the group name); Densmore v. Manzarek, Case Nos. BC 289730 and BC 294495 (Cal. Super. Ct. July 21, 2005) (finding that the name THE DOORS had not been abandoned since both the sale of the band's music and air play of their music has been continuous over the years); Supernova from Cynot3, LLC v. Mark Burnett Productions, Inc., Civ. No. 06CV1334 JAH (RBB) (S.D. Cal. Sept. 12, 2006) (although the band SUPERNOVA was not currently touring, the band did not abandon its name).
  118. Robi v. Reed, 173 F.3d 736, 739 (9th Cir. 1999) (when member left the group THE PLATTERS, he took no rights to the service mark with him; rather, the rights remained with the original group); HEC Enters., Ltd., 213 U.S.P.Q. at 994 (C.D. Cal. 1980) (former member of DEEP PURPLE and his new group were prohibited from performing under the name DEEP PURPLE when members of the original group, with certain replacement members, continued to use the name, which had acquired common law trademark rights in the United States). Courts have also found that the departing group member does not have rights to the group's name just by virtue of the member's tenure with the group. See Densmore v. Manzarek, Case Nos. BC 289730 and BC 294495 (Cal. Super. Ct. July 21, 2005) (holding that two of the original members of THE DOORS could not perform under the name THE DOORS or THE DOORS OF THE 21ST CENTURY without the consent of all of the original members); Gallina v. Giacalone, 1996 WL 735353 at \*3 (N.Y. Sup. Ct. Dec. 9, 1996) (holding that musicians that performed with the group only once unfairly capitalized on the work by the founding members by continuing to perform under the group's name); HEC Enters. Ltd., 213

- U.S.P.Q. at 992 (original member of the group DEEP PURPLE prohibited from using DEEP PURPLE as the name of his new group); Giammarese v. Delfino, 197 U.S.P.Q. 162, 162-164 (N.D. Ill. 1977) (holding that while the departing group member was a founding member of the group THE BUCKINGHAMS, his unauthorized creation of the group NU-BUCKINGHAMS was trademark infringement).
119. See Kassbaum v. Steppenwolf Prods., Inc., 236 F.3d 487 (9th Cir. 2000) (these are truthful statements and confusion is unlikely); Kingsmen, 557 F. Supp. 178 (a proper usage would be the lead singer's name with "formerly of the Kingsmen" or "Jack Ely, lead singer on the original Kingsmen recording of Louie Louie."); Brother Records, Inc. v. Jardine, 318 F.3d 900, 901 (9th Cir. 2003) (former member of THE BEACH BOYS could not use the group's name for his performances, but was allowed to refer to his past membership in the group); Gronin v. Rossington, 690 F. Supp. 200 (S.D.N.Y. 1988) (defendant former group member was required to affix a label on his CDs and cassettes stating that "this is a recording of a new band recorded in 1987 and not the original Lynyrd Skynyrd group"); see also Cleopatra Records v. William Bruce Bailey, Case No. CV 04-3120 GAF (C.D. Cal. July 6, 2004) (finding that the use of the name GUNS 'N ROSES for an album of recordings by a predecessor band entitled "Hollywood Rose: The Roots of Guns 'N Roses" was a nominative fair use of the GUNS 'N ROSES trademark).
  120. See e.g., Brother Records, Inc. v. Jardine, 318 F.3d 900, 901 (9th Cir. 2003) (the members of THE BEACH BOYS incorporated Brother Records, Inc. to hold and administer the intellectual property rights of THE BEACH BOYS, including the group's trademark rights).
  121. Of course, a group should think about whether they want other group members to prevent another group member to use the name outside of the group. For example, John Densmore of THE DOORS has successfully sued his other band members for performing under the name THE DOORS, and even though the band has officially broken up, the band members that still want to perform together are restrained from doing so. Densmore v. Manzarek, Case Nos. BC 289730 and BC 294495 (Cal. Super. Ct. July 21, 2005).
  122. See Winterland Concessions Co. v. Macintosh, 1992 WL 170897 (E.D. Pa. Jul 14, 1992) ("each licensor musical group has a sole right to control the commercial exploitation of the name and/or likeness of the group, including their uses on T-shirts and jerseys") citing Zacchini v. Scripps-Howard Broadcasting Company, 433 U.S. 562 (1977). In Zacchini, the Supreme Court recognized the authority of states to protect entertainers' "right of publicity." 433 U.S. at 573, 576-78.
  123. Generally, trademarks and service marks identify a source of the good or service under that mark, something that a person's publicity attributes may not necessarily do.
  124. N.Y. Civ. Rts. Law §§ 50-51; Cal. Civ. Code § 3344; see also Cher v. Forum Int'l, 692 F.2d 634 (9th Cir. 1982); Washington v. Brown & Williamson, 223 U.S.P.Q. 1116 (E.D. Pa. 1984); Midler v. Ford Motor Co., 849 F.2d 460 (1988); Tin Pan Apple, Inc. v. Miller Brewing Co., 737 F. Supp. 826 (S.D.N.Y. 1990); White v. Samsung Electronics, 971 F.2d 1395 (9th Cir. 1992); Apple Corps Ltd. v. Button Master, 47 U.S.P.Q.2d 1236 (E.D. Pa. 1998).
  125. Apple Corps Ltd. v. A.D.P.R., Inc., 843 F. Supp. 342 (M.D. Tenn. 1993) (use of THE BEATLES and JOHN, PAUL, GEORGE, and RINGO in a commercial context was found to violate Tennessee's Personal Rights Protection Act); Apple Corps Ltd. v. Button Master, 47 U.S.P.Q.2d 1236 (E.D. Pa. 1998) (group name THE BEATLES as well as the individual members' names and likenesses were protected by Pennsylvania's common law right of publicity).
  126. Apple Corps Ltd. v. A.D.P.R., at 348 ("the stage name of a group of individuals is entitled to the same protection as the name of one of the individuals which compose that group"). Additionally, musical groups as well as the individual performers have protectible rights of publicity. Apple Corps Ltd. v. Button Master, 47 U.S.P.Q.2d 1236 (E.D. Pa. 1998).
  127. Cuomo v. Miller Brewing Company, et al., Case No. 8C359544 (Cal. Superior Ct., Sept. 29, 2006).
  128. Browne v. Bloomingdale's, Case No. 06cv7877 (C.D. Cal. December 12, 2006) (according to the lawsuit, the t-shirts bear the name JACKSON BROWNE in large letters across the top of the shirt, with a large photograph of the singer playing an acoustic guitar in front of a microphone).
  129. See Hanson, supra note 51 (noting that alternative rocker LIZ PHAIR appeared on Calvin Klein billboards and alternative band EVERLAST appeared in magazine ads for Avirex clothing).
  130. See Winterland Concessions Co. v. Macintosh, 1992 WL 170897 at \*10 (E.D. Pa. July 14, 1992) (licensee of numerous artists' names and likenesses, as well as their trademarks, for merchandise was able to obtain a default judgment against a bootleg merchandiser for violations of the right of publicity and trademark law); Apple Corps Ltd. v. Button Master, 47 U.S.P.Q.2d 1236 (E.D. Pa. 1998) (granting summary judgment for plaintiff's trademark and right of publicity claims after finding the use of THE BEATLES and the group members' individual names for commercial purposes violated the Lanham Act and Pennsylvania's right of publicity law); Apple Corps Ltd. v. A.D.P.R., 843 F. Supp. at 349 (holding that a lookalike cover band misappropriated the names and likenesses of THE BEATLES); Robert Craig "Evel" Knievel v. Kayne West, et al., Case No. 06cv 02269 (M.D. Fla. December 11, 2006) (EVEL KНИЕVEL brought trademark infringement and right of publicity claims against rap star KAYNE WEST for West's "Touch the Sky" video, in which West takes on the persona of "Evel Kaynevel").
  131. See Abercrombie & Fitch, Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976). The strength of a trademark is evaluated along a sliding scale of distinctiveness, from generic or descriptive marks that are considered weak, to suggestive, arbitrary, or fanciful marks that are judged with a higher level of inherent distinctiveness. Id.
  132. See supra "Choosing and Clearing the Artist's Name" and related notes. Note, an artist should also not choose a name that could potentially violate the rights of publicity of another person, regardless of whether that person is in the music industry or not. See supra "Rights of Publicity Under State Law" and related notes.
  133. The database is available at <http://www.uspto.gov/main/trademarks.htm>. While not an exhaustive resource, this database is useful for preliminary searches.
  134. To determine whether a name is clear for trademark use, the artist will want to evaluate the search results using the multifactor test for the likelihood of confusion. See Polaroid Corp. v. Polarad Elec. Corp., 287 F.2d 495 (2d Cir. 1961); AME Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979). Because trademark law is a highly specialized field that unfortunately does not lend itself to black or white answers, it will be useful for an artist to consult an attorney to interpret the search results.
  135. Thomson CompuMark (<http://www.thomson-thomson.com>) and CT Corsearch (<http://www.ctcorsearch.com>) are two such vendors that offer comprehensive trademark and entertainment availability reports. The search reports can range from \$500 to close to \$1500 depending on the type of search performed and the turnaround time.
  136. The owner of a trademark is the entity that controls the quality of the goods or services under the trademark. Therefore the owner for the application can be an individual artist, a partnership among group members, or the corporate entity that was created to hold the intellectual property rights of the group. See supra "Dissolution and/o Membership Changes" and related notes.
  137. The cost to file a trademark application with the USPTO is \$325 per class of goods or services if the applicant uses the electronic-based TEAS system. A \$275 application is available if the artist has the ability to use the TEAS Plus system.
  138. Maintaining a trademark registration includes filing an affidavit of continuing use with a specimen of current use during the sixth year of use of the mark. 15 U.S.C. § 1058. Additionally, the artist who receives a trademark registration after November 16, 1989 will need to file an application for renewal with proof of continued use within the last six months of tenth year of use of the mark. 15 U.S.C. § 1059. Of course, as mentioned previously, trademark protection in the United States is based on use of the mark in commerce, so even if an artist's registration for its professional name is cancelled, the artist may still have trademark rights in its name based on the use in commerce.
  139. See, e.g., Barcamerica Int'l USA Trust v. Tyfield Imps., Inc., 289 F.3d 589 (9th Cir. 2002).
  140. See N.Y. Civ. Rts. Law §§ 50-51; Caesar v. Chemical Bank, 496 N.Y.S.2d 418 (1985) (statute violated where employees orally consented and posed for photograph exhibited at trade show).