

GENERAL CONSIDERATIONS

Rights Clearance Process

Companies intending to create and use materials that may be subject to copyright, trademark and other intellectual property rights and personal rights of third parties must ensure that all appropriate licenses and permissions are in place. This process is known as "rights clearance."

For all material that may be subject to intellectual property or personal rights protections, rights clearance involves:

- „Identifying potential rights protections for both the work as a whole and individual elements. „
- For protectable elements, determining whether the client or a third party owns the relevant rights. „
- For rights not owned by the client: „
 - evaluating whether permission is required for the intended use; and „
 - if permission is required, identifying the owner and obtaining a license or other relevant permission.

Maintain Documents

To minimize the risk of liability for any claims, maintain written records of: „

- The legal basis for concluding that a license was not required for particular elements. „
- All licenses and permissions secured, including: „
 - the scope and duration of each license; and „
 - the license restrictions.

COPYRIGHT CLEARANCE „

- When conducting copyright clearance for a work, consider both: „
 - the work in its entirety; and „
 - each copyrightable element (See Identify Protectable Works and Protectable Aspects of Works.)
- Assess the necessary copyright clearance steps, taking account of: „
 - who owns the copyright in the work (see Copyright Ownership); and „

Works Owned by Third Parties

In general, a company intending to use a third-party work that is protected by copyright must obtain an appropriate license or other permission. However, consider whether a license or permission may be unnecessary because:

- the type of work and, in particular, whether it incorporates or evokes any third-party materials. For example, a multimedia work involves more rights and typically more third-party materials than simple text or a still image

Copyright Ownership

Works Created by the Client, Including Employees In general, a work created by an employee in the scope of his employment is owned by the employer as a work made for hire under the US Copyright Act. To reduce the risk that an employee may claim ownership of the work: „

- Make clear that the project falls within the scope of the employee's employment. „
- As a best practice, require any employee creating a work subject to copyright or other intellectual property protections to sign an employment agreement or employee rights agreement in which the employee: „
 - expressly agrees that the work is a work made for hire for the employer; and „
 - otherwise transfers and assigns all rights in the work to the employer.

Commissioned Works

Where third-party contractors are commissioned to create original works: „

- Ensure that each contractor signs an agreement that: „
 - gives ownership of the work to the client as a work made for hire or, if any work does not qualify as a work made for hire, by copyright assignment; or „
 - grants the client a license in the work that is sufficiently broad in scope and duration for the immediate and future uses of the work. „
- If the contractor is an entity, require it to have its personnel assigned to the project sign similar agreements. „
- For contractors that are individuals, determine whether they are full-time employees of a third party that may claim ownership of the work as a work made for hire. If so, ensure the third party also signs the agreement giving ownership or similar licensed rights to the client.

Third-party Materials

Clearing Copyright in Concept „

- Identify whether the work evokes, is based on or incorporates themes from other works. „

- The work is in the public domain, for example, because:
 - „the copyright in the work has expired (for guidance on determining whether the copyright in a work has expired, see US Copyright Duration Flowchart (<http://us.practicallaw.com/0-506-3474>) and Practice Note, Copyright: Overview: Copyright Duration (<http://us.practicallaw.com/2-505-5835>)); „
 - the work either was never copyrighted or lost copyright protection due to a failure to comply with statutory formalities (applicable only to works published before March 1, 1989 and only to a limited extent for works published on or after January 1, 1978) (see Practice Note, Copyright: Overview: Copyright Formalities (<http://us.practicallaw.com/2-505-5835>)); or „
 - it is a US Government work and therefore is not eligible for copyright protection (see Practice Note, Copyright: Overview: US Government Works (<http://us.practicallaw.com/2-505-5835>))
- It is a name, title, slogan or short phrase that does not meet the minimal originality requirements for copyright protection. However, these elements may be protectable under trademark law or by rights of publicity or privacy (see Clearing Trademark Rights, Clearing Privacy Rights and Clearing Use of a Person's Name Likeness or Other Recognizable Attributes). „
- The use qualifies as a fair use under the Copyright Act. However, the distinction between fair use and infringement is not always clear or easily defined, and it is difficult to predict how a court may rule on particular facts. For a discussion of copyright fair use
- Any other exception to copyright protection is applicable to the type or circumstances of the use (see Practice Note, Copyright: Overview: Other Limitations on Exclusive Rights (<http://us.practicallaw.com/2-505-5835>)).

- Third-party elements the work is derived from or evokes. „
- Whether these materials are protected by copyright. „
- Whether the planned use of the materials requires a license or other permission (if the materials are protected by copyright).

- Where other works are incorporated or evoked: „
 - consider whether a license or other permission may be required; „
 - identify who owns the copyright in the other works; and „
 - secure necessary licenses or permissions.

Clearing Copyright in Text

For works consisting of written text: „

- Identify all third-party material used in creating the work, including: „
 - quotes or excerpts from any third-party authored material; and „
 - third-party elements the work derives from or evokes. „
- For all third-party material: „
 - consider whether a license or other permission may be required; „
 - identify who owns the copyright in the other works; and „
 - secure necessary licenses or permissions.

Clearing Copyright in Illustrations, Photographs and Other Still Visual Elements

For all illustrations, photographs and other still visual elements, identify: „

- All third-party material used in creating the work, including: „
 - stock photography, clip-art and materials displayed on the internet; and
 - materials used as a reference, whether or not they are incorporated in the work. „
- Anything appearing in the visual elements of the work in which a third party may claim rights or that may be protected independently of the copyright in the work itself. A photograph or illustration, for example, may show: „
 - trademarks or branded objects (see Clearing Trademark Rights); „
 - artwork protected by a separate copyright; „ identifiable locations, buildings or monuments; or
 - images of identifiable people (see Clearing Use of a Person's Name Likeness or Other Recognizable Attributes and Clearing Privacy Rights).

Original Recording of an Existing Musical Work „

- Identify the owners of each copyright interest in the work. Account for separate copyrights that may exist in the: „
 - composition; „

For materials requiring a license or other permission: „

- Identify the owner of the relevant rights. „
- If the materials have been previously licensed, review the license to ensure it covers the current use.

Clearing Copyright in Musical Works „

- Identify all separately copyrightable elements of the work, including: „
 - the musical work itself, including the musical composition, lyrics and arrangement; and „
 - the sound recording, that is, the specific recording of a particular performance (which may also include samples of other sound recordings). „
- The necessary copyright clearance will vary, typically with increasing complexity and cost, based on whether the musical work being used is: „
 - entirely original and independently created and performed (see Original Music); „
 - a new recording of an existing musical work created specifically for the current use (see Original Recording of an Existing Musical Work); or „
 - an existing third-party sound recording of a third-party work (see Existing Sound Recording).

Original Music „

- Identify any elements of the work that may be protected by third-party copyrights, including: „
 - music sampling from other works; or „
 - third-party elements the work derives from or evokes. „
- For all third-party material: „
 - identify who owns the copyright in the other works; „
 - consider whether a license or other permission may be required; and „
 - secure necessary licenses or permissions. „
- Secure appropriate written permission from all performers (vocals and instrumentals).

- lyrics; and „
- arrangement. „

- Determine whether a license or other permission may be required.
- Secure necessary licenses. „
- Secure appropriate written permission from all performers (vocals and instrumentals).

Existing Sound Recording

In addition to taking steps to clear rights for the musical work, including the musical composition, lyrics and arrangement (see Original Recording of an Existing Musical Work):

- Determine who owns the copyright in the sound recording. Many musical works are owned by more than one person or entity. „
- Secure a separate license for each separately protected element of the sound recording from the applicable owner, for example, the record label.

Film Footage, Television Clips and Other Motion Picture Elements „

- Identify all separately copyrightable elements of the work, including: „
 - concept (see Clearing Copyright in Concept); „
 - script or screenplay (text) (see Clearing Copyright in Text); „
 - still images (see Clearing Copyright in Illustrations, Photographs and Other Still Visual Elements); and „
 - music (see Clearing Copyright in Musical Works).
- Consider additional clearances for: „
- talent, including actors and directors (see, for example, Clearing Publicity Rights); „
- underlying rights holders, if the work is an adaptation of a book, play or other work (see Practice Note, Copyright: Overview: Compilations, Collective Works and Derivative Works (<http://us.practicallaw.com/2-505-5835>)); and „
- properties displayed in the work that may be subject to independent copyright or other intellectual property rights protections (see, for example, Clearing Trademark Rights).

CLEARING TRADEMARK RIGHTS „

Third-party Trademarks „

- Identify all third-party trademarks used in the work. „

- Identify all trademarks used in the work, including: „
 - word trademarks, service marks or other distinctive names; „
 - logos; „
 - taglines and slogans, including distinctive headlines; „
 - product images; „
 - product designs, which may include shape or color; „
 - architectural works, including distinctive building designs; „
 - business names; and „ other indicia of origin (for example, a professional sports team uniform).

Client's Trademarks „

- Conduct trademark searching and clearance for any of the client's trademarks if the use involves:
 - a newly adopted mark; or „
 - an existing mark being used for a new product or service. „
- Identify the source of the mark, specifically to determine whether it: „
 - was created by a third party (for example, whether a thirdparty brand consultant was engaged to develop the mark); „
 - is based on or inspired by a third party's mark; or „
 - is meant to copy or evoke a third party's mark. „
- If a mark was created by a third party: „
 - ensure a written document is executed giving the client sufficient rights (either ownership, via an assignment, or a license or other written permission) to use the mark; and „
 - identify any restrictions on current or future uses of the mark.
- Ensure that the client's trademarks are used properly, including: „
 - as adjectives; „
 - with proper trademark notices; and „
 - consistently with the client's trademark usage guidelines

- Based on the type of work (for example, advertising or editorial), evaluate whether a license or other permission is required. Consider, for example, whether a license or permission is unnecessary because the use constitutes a trademark fair use. Trademark fair uses include certain: „
 - nominative uses, such as in editorial reporting, to identify the third party or its product or service; „
 - uses of the designation in a descriptive (non-trademark) sense; and „
 - uses for comparative advertising purposes in a manner not likely to cause consumer confusion or dilution of the mark. „
- Ensure any comparative advertising use is proper, including as to: „
 - how the mark appears (for example, ordinary typeface, the brand owner's distinctive stylized typeface, and the brand name and typeface, accompanied by a product depiction). Specifically, ensure the mark is not modified, altered or exaggerated in any way; and „
 - how prominently the third-party marks appear in the work. Specifically, ensure the mark is used only to the extent necessary to reference the competing product.
- Ensure the mark is not used in a way that: „
 - expressly or implicitly suggests that the client's product or service is associated with the third party brand; „
 - suggests any endorsement; „
 - creates confusion as to source with other materials included in the work; or „
 - disparages or tarnishes the mark. „
- Use proper trademark attribution lines when referencing third party marks.

CLEARING PRIVACY RIGHTS

Consider personal privacy rights when clearing materials, including protections under state law against: „

- Public disclosure of private facts. „
- False light portrayals. „
- Appropriation.

CLEARING PRIVACY RIGHTS

The right of publicity prohibits the unauthorized commercial use of an individual's name, likeness or other recognizable aspects of one's persona. The right of publicity: „

- Gives individuals the exclusive right to license the use of their identities for commercial purposes. „
- In the US, is largely protected by state common or statutory law.

Consider and clear publicity rights: „

- For persons identified in a work that is arguably commercial (for example, advertising, marketing materials and public relations releases). „
- Where persons are identifiable in noncommercial works, if the works are used for commercial purposes, for example, film clips.

For all natural persons (living or dead) whose identities are included or conjured up by the work: „

- Determine whether the use requires permission based on, among other things: „
 - how identifiable those persons are from the depictions (for example, headshot or crowd shot); and „
 - where the person's identity is incidental, if it may be obscured.
 - Evaluate whether there is a right of publicity, including any postmortem right of publicity, based on relevant state law or the law of any foreign jurisdiction. „
 - Consider that a fictitious character may conjure the identity of a real person. „
 - Where there is a right of publicity, obtain written permission for the use.

Consider that a right of publicity may be implicated (either directly under right of publicity law or under broader laws that relate to consumer confusion as to endorsement or affiliation) by using any trait or combination of traits from which a person is uniquely identifiable, for example:

- Name, including a nickname or signature. For fictitious names, conduct searches to determine whether any real persons exist with that name and the traits described in the work. „
- Likeness, for example, if the work uses any: „
 - photographs; „
 - film or video footage; or „
 - illustrations or caricatures. „
- Voice or voice imitations. „
- Distinctive gestures or mannerisms. „
- Distinctive phrases (for example, "Here's Johnny!" associated with Johnny Carson). „
- Objects associated with a person (for example, the uniform of a professional athlete).

DEFAMATION REVIEW

For works making factual statements about a person or entity, conduct a review to ensure the assertions.

Specifically: „

- Identify statements that may cause the subject of the statement to suffer harm. „
- Ensure that all information contained in these statements is true. Truth is almost always an absolute defense to an action for defamation. „
- Maintain documentary records that support these statements.

Consider whether statements may be considered statements of opinion and not fact. Statements of opinion may not support a cause of action for defamation. However, whether a statement is viewed as an expression of fact or opinion is sometimes unclear and can depend on context.