

Trademark & Copyright: the Soft Side of IP Protection

Presented by:

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Basis for Intellectual Property Protection:



Congress shall have the power . . .

“to promote the progress of science and useful arts, by securing for limited time to authors and inventors the exclusive right to their respective writings and discoveries.”

United States Constitution
Article 1 § 8, Cl. 8



Distinguishing IP Rights:

- **Copyright:** protects artistic works

Examples: music composition, motion pictures, paintings, drawings, sculptures, literary work

- **Patent:** protects inventions and designs

- Types: Utility, Design and Plant Patents

Examples: machines, processes, pharmaceuticals, apparel, furniture, jewelry, instruments

- **Trademark:** protects business reputation

Examples: business names, logos, slogans, catch phrases, brand and product names

What is Protected under Copyright Law?



Exclusive Rights:

- Copy / Reproduce
- Adapt / Create Derivative Works
- Publish / Distribute
- Perform (music/plays)
- Display - the public exhibition of a copyrighted work

For How Long? (Term or Duration):

- Generally the life of the author + 70 years
- 95 years from first publication or 120 years from creation, whichever is shorter, for works made for hire

What is Protected under Copyright Law?

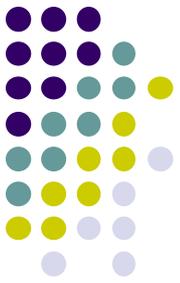


Copyright protects the “expression” of an idea

Specifically:

- original works of authorship
- fixed
- in a tangible medium of expression

What does it mean to be “fixed”?



- when the artwork is embodied in a tangible form that is perceptible by the human senses either directly or with the aid of a machine
- capable of being reproduced

Examples: computer files, cds, canvas, paper, or any other physical recording of the expression

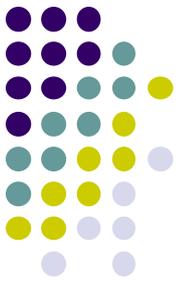
What is original?



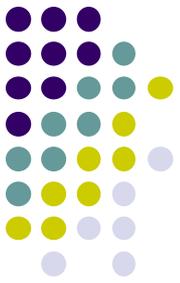
Requirements:

- a modest degree of intellectual labor
- the author did not copy from another source
- not a reproduction of any existing work or derivative of an existing work

Copyright Protection Does Not Cover:

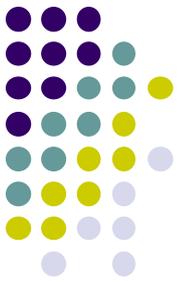


- Titles and short phrases
- Facts
- Basic shapes
- Symbols
- Functional objects (vases, apparel)
- Works authored by the U.S. government



Trademark:

- **Definition:** a word, symbol, phrase, image, color pattern, sound or other
 - **SOURCE IDENTIFIER** of business products or services
 - **BRAND**
- Protects “Good Will” –intangible brand loyalty associated with an artist or business
- Origins: Unfair Competition, Common Law, Federal Law



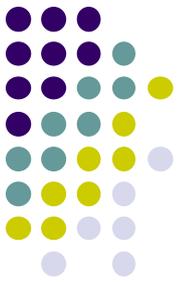
Trademark Types:

- **Descriptive:** Lawyers for the Creative Arts

- **Suggestive:**  Microsoft

- **Arbitrary/Fanciful:**

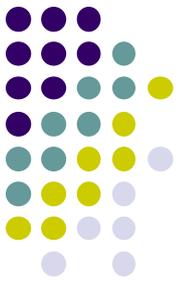




Trademark Protection:

- Common Law Use in Commerce
- State Registration:
www.cyberdriveillinois.com
- Federal Registration: www.uspto.gov

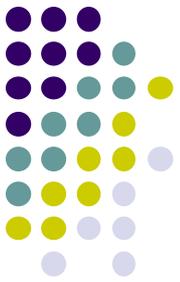
Trademark Filing:



Unlike most of the world, the U.S. has a use-based system for trademark.

General Rule: If two people register for the same trademark, the one with the earlier use obtains the registration.

Trademark Filing: Under Section 1(a)



Use Registration

- Submit a specimen or example of how you are currently using the mark in commerce;
- Indicate when you started to use your mark

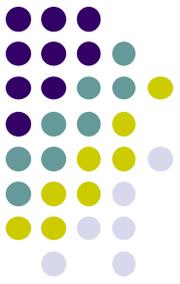
Trademark Filing: Specimens



Specimen – shows how you actually use the mark in commerce in connection with your goods and/or services

- Real-life evidence of how the public encounters your mark in the marketplace
- Not just a drawing of the trademark
- Not a mock-up of how you COULD use it

Trademark Filing: 2 types of specimens



For Goods

Examples:

- Photograph of the mark on the goods
- Label on the goods
- Hangtag that is attached to the goods.
- Packaging of the goods

Note: Must be how people usually encounter trademarks. Cannot be “ornamental.”

- Mark on the pocket of a tee: OK
- Mark is repeated as pattern on a tee: ornamental

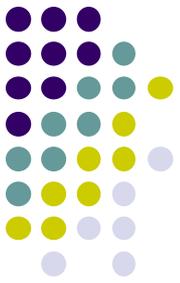
For Services

Specimen Must:

- (1) Show the mark and
- (2) References the services

- Advertising and Marketing are acceptable
 - Screen shot of website
 - Scanned copy of brochure

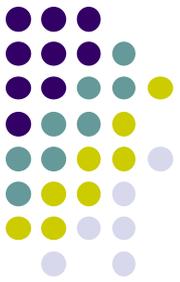
Trademark Filing: Under Section 1(b)



Intent-to-Use Registration:

“more than just an idea and less than market ready”

- Need to declare a “Bona Fide Intent” to use the Trademark in 3 to 4 years
 - “Bona Fide Intent” may include
 - Current business plan to sell goods and services under the mark
 - Creating sample product/s to sell under the mark
 - Creating or updating a website to promote the goods and services under the new mark
 - Do not need to submit evidence of intent with application but you should have evidence in case your intent is every challenged
- Must later submit a statement of actual use

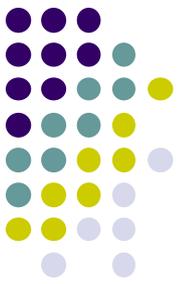


Trade Dress:

- Protects the visual appearance of a product or its packaging as a source identifier
- Examples:

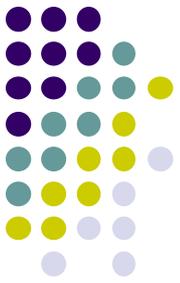


Britto v. Craig and Carl and Apple, Inc. (Trade Dress Example):



BRITTO	CRAIG & KARL
	
BRITTO	CRAIG & KARL
	

Apple iPad Air 2 Ad:



Artwork by Craig & Karl

iPad Air 2 + Waterlogue

Living on separate continents hasn't stopped artist duo Craig & Karl from collaborating daily. To create this piece, they traded ideas and sketches over FaceTime and iMessage. As they passed the artwork back and forth online, each artist built upon it using iDraw and Waterlogue on iPad Air 2. The end result reflects both the process and the medium — It's a vibrant depiction of the creative power we have at our fingertips.



iPad Air 2
From \$499 >



Waterlogue
View in the App Store >

Transfers of Intellectual Property Interests:



- Assignment—All Rights
 - License—Limited by Scope/Duration
 - Bequests (Will)
 - Operation of Law (Intestate/Court Order)
- Watch: Work-Made-for-Hire (See Circular 9 at www.copyright.gov)

Transfers of Copyright Interests:



“...Copyright is **distinct from** the property in the material object copyrighted, and the sale or conveyance, by gift or otherwise, of the material object shall not of itself constitute a transfer of the copyright, nor shall the assignment of the copyright constitute a transfer of the material object.”

(Copyright Act of 1909 Section 41)

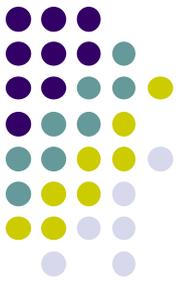
Contracts Requiring a Writing:



- Copyright Assignments
- Exclusive Licenses
- Work-made-for-hire
- i.e. anything that can completely divest the artist of ownership or control

In some states, particularly Illinois, a written agreement is required to consign artwork to an art dealer.

Copyright vs. Trademark Infringement:



Copyright Test:

- Substantial Similarity
- Access to Underlying Work

Trademark Test:

- Reasonable Likelihood of Confusion as to the Source of the Goods or Services

Damages for Copyright Infringement:



- The copyright owner's actual damages + any additional profits of the infringer

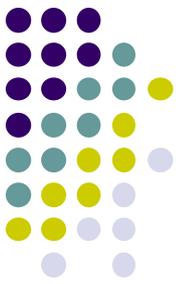
OR:

- Statutory damages (an amount set by law):
 - Willful infringement: May recover up to \$150,000
 - No finding of willful infringement: May recover between \$750 and \$30,000
 - In both situations, specific amount is determined by what "the court considers just"

Defenses to Copyright Infringement:



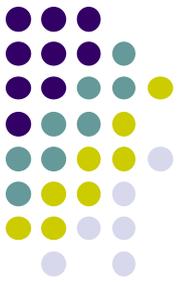
- Artwork is in the public domain
- Artwork does not include copyrightable subject matter (Ex. symbols, shapes)
- Fair use— exception to allow infringement in order for criticism, comment, news reporting, teaching, scholarship, and research



Copyright Fair Use Factors:

- Purpose and Character of the Use
 - Commercial v. Non-Commercial?
 - Educational?
- Purpose and Character of the Original Artwork
- The Amount and Substantiality of the portion used in relation to the copyrighted work as a whole
- Effect on Market Value for Original Work

Copyright Management Information (CMI):



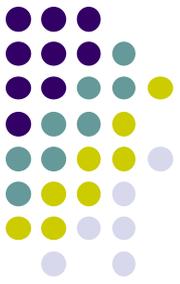
- CMI=information conveyed in connection with copyrighted work which identifies the nature and owner of the work
- CMI is implicated “wherever any author has affixed anything that might refer to his or her name”

Copyright Management Information (continued):



- Illegal to intentionally:
 - Create false CMI
 - Example: Taking a photo off the web and claiming ownership by adding a watermark
 - Remove or alter existing CMI
 - Example: Copying a photo from the web that has a watermark and either stripping or altering the watermark. This includes removing copyright notices or credit lines.

Damages for Removing or Altering CMI:



- The copyright owner's actual damages and any additional profits of the violator

OR:

- Statutory damages
 - May recover between \$2,500 and \$25,000 for each violation

Cleveland Indians:

TM Use & Abandonment



Cleveland Indians Will Abandon Chief Wahoo Logo Next Year

New York Times – Jan. 29, 2018

“Although the Indians will stop using the logo on their uniforms, they will not relinquish the trademark and still will be able to profit off sales of merchandise bearing the logo at the stadium and in the Cleveland area. But by maintaining the trademark, the team, with the supervision of M.L.B., retains control of



the proliferation of the logo. If it relinquished the trademark, or announced an intention never to claim its protections, another party could legally assume control of it and use the logo in other ways.”

'RuPaul's Drag Race' Leaker Sued for Copyright Infringement

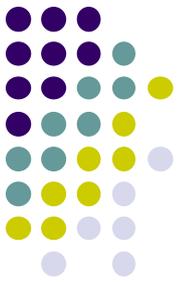


- On Feb. 15th producers files suit against anonymous leaker: “RealityTVLeaks”
- The leaker has obtained video of the reality competition show before it airs and posted clips and images on Reddit and social media.
- The producers argues that the leaks are cutting into the value of the show for viewers by giving away the ending.



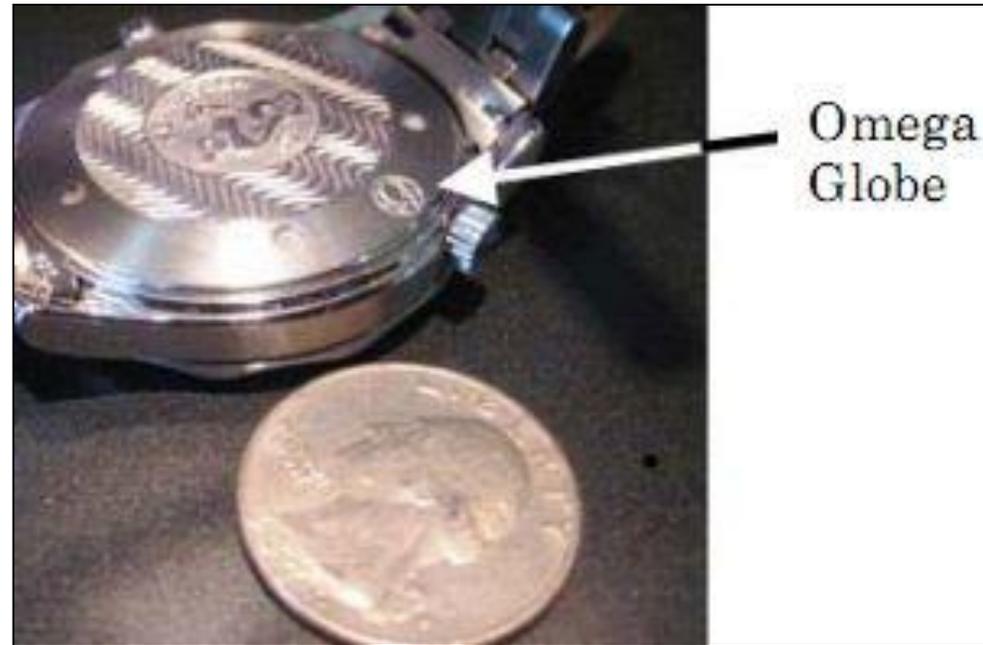
Omega v. Costco:

Copyright & First-Sale Doctrine



FACTS

- Costco bought Omega-approved watches from a 3rd party importer
- Watches were made for market in Paraguay and acquired on “gray market”
- Costco sells watches for below Omega’s suggest retail price





Omega v. Costco:

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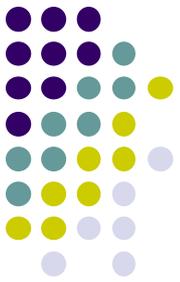
- **Omega argues** Costco's sale infringes on their copyright of the Omega logo on the back face of the watch.
- **Costco argues** Omega is precluded from bring suit due to the First Sale Doctrine, under which certain rights are "exhausted" after a sale of the copyrighted good.



Omega
Globe

- **9th Cir. rules** First-Sale Doctrine doesn't apply to imported goods manufactured abroad.
- **U.S. Supreme Court** tied: 4 to 4.
- **9th Cir. Ruling stays in place.**

This has been a presentation by:
Lawyers for the Creative Arts



www.law-arts.org