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SPRING SERIES

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"Intellectual Property -- Copyright & Trademark Protections"

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Introduction: Need for protection

Hypothetical case of National Association for the Prevention of Abuse of Children (NAPAC) which wants to adopt investigative and other forms for use by regional affiliates

Trademark protection

1. What is a trademark or service mark--distinction from trade or corporate name: it must identify a product or service.
2. Availability of trademark rights for protection of marks of non-profits: upheld even in absence of sale of service in conventional way: "A charity's financial credit--its ability to raise funds, its general reputation, the credit of those managing and supporting it, are all at stake if its name is filched away by some other organization, and the two become confused in the minds of the public."
3. Protectability of different marks--confusing similarity.
 - a. Distinctiveness or strength of marks
 - i. Arbitrary or fanciful
 - (1) Arbitrary: Words in common usage not usually associated with particular product or services--Red Cross, Quakers, Google, Yahoo
 - (2) Fanciful: Coined words--NARAL, FLOC, KODAK, XEROX

- ii. Suggestive: suggests some quality or ingredient of goods--Cyclone fence, Handi wipes, Orange Crush, Q-Tips, Rapid-Shave, Debtscape
 - iii. Descriptive, geographic, personal name--need secondary meaning: Bufferin, Chap Stick, Little Tavern, Raisin-Bran, World Book, perhaps Boy Scouts of America, Anti-Defamation League
 - iv. Merely descriptive or generic: Body Soap, Cube Steak, Light Beer, Shredded Wheat, Minnesota School of Business
- b. Additional indicia of confusing similarity
- i. Similarity of marks: sound (Steinway, Steinweg or Debtscape, Netscape) sight (Sunvis, Univis), and meaning (Cylone, Tornado)
 - ii. Similarity of product or service: Waterman pens and Waterman razor blades, Miss Seventeen clothes and Seventeen Magazine
 - iii. Similarity of channels of trade: BlueShield medical and Blue Shield mattresses, Black Label cigarettes and Black Label beer
 - iv. Sophistication of customers: professionals or lay consumers
- c. Forms of protection
- i. Common law protection
 - ii. Based on state law
 - iii. Only encompasses area of actual use
 - iv. Subordinate to registered mark after 5 years of registration and use
- d. State registration: Proof of a claim to exclusive use but no enhancement of rights
- e. Federal registration
- i. Actual use v. intent to use
 - ii. Primary register for fanciful and arbitrary marks and descriptive marks with secondary meaning

- iii. Secondary register for descriptive marks without secondary meaning
 - iv. Registration process
4. Asserting rights in marks
- a. Cease and desist letters to avoid laches or abandonment
 - b. Infringement action: can proceed in federal or state court, unlike copyright or patent protection; can obtain treble damages and attorney's fees in exceptional cases; can defend on the basis of no likelihood of confusion or no protection (e.g. abandonment)
5. Special kinds of marks
- a. Collective marks: organization of members
 - b. Certification marks: Good Housekeeping Seal, Roquefort Cheese, Union Label
6. Conveying rights in marks to others
- a. Licenses
 - b. Assignments
7. Antidilution protection: available for famous marks and protects against diminution of goodwill through blurring (diminishes uniqueness without confusing similarity) or tarnishment (diminishes image of quality, e.g., Buttweiser or Virginia Slimes)
8. Other methods of unfair competition, e.g., passing off

Copyright Protection

9. What is copyright?
- a. Creation of statute (title 17, U.S. Code).
 - b. Available to the authors of ““original works of authorship,”” including literary, dramatic, musical, artistic, and certain other intellectual works, if they are fixed in a tangible form of expression which need not be directly perceptible so long as it may be communicated with the aid of a machine or device
 - c. Available to both published and unpublished works.

10. Exclusive rights accorded to the owner of copyright:
 - a. To reproduce the work in copies or phonorecords;
 - b. To prepare derivative works based upon the work;
 - c. To distribute copies or phonorecords of the work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
 - d. To perform the work publicly, in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works;
 - e. To display the copyrighted work publicly, in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work; and
 - f. In the case of sound recordings, to perform the work publicly by means of a digital audio transmission.
 - g. In addition, certain authors of works of visual art have the rights of attribution and integrity.
 - h. Not unlimited in scope: "fair use" and "compulsory license" under which certain limited uses of copyrighted works are permitted upon payment of specified royalties and compliance with statutory conditions.

11. Copyright ownership
 - a. Subsists from the time the work is created in fixed form.
 - b. Is the property of the author who created the work or people deriving their rights through the author
 - c. In the case of works made for hire, the employer and not the employee is owner, "work made for hire" being defined as:
 - i. A work prepared by an employee within the scope of his or her employment; or
 - ii. A work specially ordered or commissioned for use as a contribution to a collective work, a part of a motion picture or other audiovisual work, a translation, a supplementary work, a compilation, an instructional text, a

test answer, material for a test, or an atlas;

- iii. What the parties to a written instrument signed by them agree shall be considered a work made for hire
- d. The authors of a joint work: co-owners of the copyright in the work, unless there is an agreement to the contrary
- e. Copyright in each separate contribution to a periodical or other collective work: distinct from copyright in the collective work as a whole and vests initially with the author of the contribution
- f. Mere ownership of a book, manuscript, painting, or any other copy or phonorecord: does not give the possessor the copyright, and transfer of ownership of any material object that embodies a protected work does not of itself convey any rights in the copyright
- g. Minors may own but ownership may be affected by state laws may regulate the business dealings involving copyrights owned by minors. For information on relevant state laws, consult an attorney

12. Works not protectable by copyright

- a. Works that have not been fixed in a tangible form of expression (for example, choreographic works that have not been notated or recorded, or improvisational speeches or performances that have not been written or recorded)
- b. Titles, names, short phrases, and slogans; familiar symbols or designs; mere variations of typographic ornamentation, lettering, or coloring; mere listings of ingredients or contents
- c. Ideas, procedures, methods, systems, processes, concepts, principles, discoveries, or devices, as distinguished from a description, explanation, or illustration
- d. Works consisting entirely of information that is common property and containing no original authorship (for example: standard calendars, height and weight charts, tape measures and rulers, and lists or tables taken from public documents or other common sources)

13. Obtaining copyright protection

- a. Copyright secured automatically upon creation: no publication or registration or other action in the Copyright Office is required to secure copyright, although there are certain advantages to registration

- b. "Creation" of a work: when it is fixed in a copy or phonorecord for the first time
 - (1) "Copies" being material objects from which a work can be read or visually perceived either directly or with the aid of a machine or device, such as books, manuscripts, sheet music, film, videotape, or microfilm
 - (2) "Phonorecords" being objects embodying fixations of sounds (excluding, by statutory definition, motion picture soundtracks), such as cassette tapes, CDs, or LPs
 - (3) A song (the "work") can be fixed in sheet music ("copies") or in phonograph disks ("phonorecords"), or both
 - (4) A work prepared over a period of time: the part of the work that is fixed on a particular date constitutes the created work as of that date
14. Role of publication: not the key to obtaining federal copyright as it was under the Copyright Act of 1909 but still important to copyright owners.
- a. "Publication" (under 1976 Act): the distribution of copies or phonorecords of a work, directly or indirectly, to the public by sale or other transfer of ownership, or by rental, lease, or not of itself constitute
 - b. Important concept in the copyright law for several reasons:
 - i. Works published in the United States: subject to mandatory deposit with the Library of Congress
 - ii. Can affect the limitations on the exclusive rights of the copyright owner that are set forth in sections 107 through 121 of the law
 - iii. May determine the duration of copyright protection for anonymous and pseudonymous works (when the author's identity is not revealed in the records of the Copyright Office) and for works made for hire
 - iv. If published before March 1, 1989, must bear the notice or risk loss of copyright protection and beneficial for other works
 - (1) Informs the public that the work is protected by copyright, identifies the copyright owner, and shows the year of first publication

- (2) In the event that a work is infringed: proper notice of copyright on the published copy or copies to which a defendant had access generally bars infringer from defending on basis of innocent infringement in mitigation of actual or statutory damages
- c. Notice for visually perceptible copies--should contain all the following three elements:
 - i. The symbol © (the letter C in a circle), or the word "Copyright," or the abbreviation "Copr."
 - ii. The year of first publication of the work meaning, in the case of compilations or derivative works incorporating previously published material, the year date of first publication of the compilation or derivative work (may be omitted where a pictorial, graphic, or sculptural work, with accompanying textual matter, if any, is reproduced in or on greeting cards, postcards, stationery, jewelry, dolls, toys, or any useful article)
 - iii. The name of the owner of copyright in the work, or an abbreviation by which the name can be recognized, or a generally known alternative designation of the owner--Example: © 2002 John Doe
- d. For certain kinds of works--for example, musical, dramatic, and literary works--fixed not in "copies" but by means of sound in an audio recording: the "C in a circle" notice is not used to indicate protection of the underlying musical, dramatic, or literary work, but rather notice containing the following three elements and be affixed to copies or phonorecords in such a way as to "give reasonable notice of the claim of copyright.":
 - i. The letter P in a circle);
 - ii. The year of first publication of the sound recording; and
 - iii. The name of the owner of copyright in the sound recording, or an abbreviation by which the name can be recognized, or a generally known alternative designation of the owner
- e. Notice on any unpublished copies or phonorecords that leave the author's control:
Unpublished work © 2002 Jane Doe

15. Duration of copyright

- a. Works originally created (fixed in tangible form for the first time) on or after

January 1, 1978:

- i. Automatically protected from the moment of their creation
 - ii. Ordinarily given a term enduring for the author's life plus an additional 70 years after the author's death
 - iii. In the case of "a joint work prepared by two or more authors who did not work for hire:" 70 years after the last surviving author's death
 - iv. Works made for hire, for anonymous and pseudonymous works (unless the author's identity is revealed in Copyright Office records): 95 years from publication or 120 years from creation, whichever is shorter
- b. Works originally created before January 1, 1978, but not published or registered by that date:
- i. Automatically brought under the statute and now given federal copyright protection
 - ii. Duration of copyright in these works generally computed in the same way as for works created on or after January 1, 1978
 - iii. In no case will the term of copyright for works in this category expire before December 31, 2002, except that for works published on or before December 31, 2002, the term of copyright will not expire before December 31, 2047
- c. Works originally created and published or registered before January 1, 1978
- i. Under the law in effect before 1978: copyright secured either on the date a work was published with a copyright notice or on the date of registration if the work was registered in unpublished form. In either case,
 - ii. Copyright first term of 28 years from the date it was secured
 - iii. During the last (28th) year of the first term, copyright eligible for renewal. Filing for renewal registration no longer required in order to extend the original 28-year copyright term to 95 years. However, some benefits accrue from making a renewal registration during the 28th year of the original term.

16. Copyright transfer

- a. Any or all of the copyright owner's exclusive rights or any subdivision of those rights transferrable, but the transfer of exclusive rights not valid unless that transfer is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent. Transfer of a right on a nonexclusive basis does not require a written agreement.
- b. A copyright also conveyable, as is trademark, by operation of law and may be bequeathed by will or pass as personal property by the applicable laws of intestate succession.
- c. Copyright, like trademark, is a personal property right, and it is subject to the various state laws and regulations that govern the ownership, inheritance, or transfer of personal property as well as terms of contracts or conduct of business.
- d. Transfers of copyright normally made by contract.
- e. Recordation in the Copyright Office available for transfers of copyright ownership and provides certain legal advantages, including validation of the transfer as against third parties.
- f. Termination of a grant of rights available under certain conditions by serving written notice on the transferee within specified time limits

17. Copyright registration

- a. Registration not required but provides certain advantages
 - i. Establishes a public record of the copyright claim
 - ii. Required efore an infringement suit may be filed in court for works of U. S. origin
 - iii. If made before or within 5 years of publication, establishes prima facie evidence in court of the validity of the copyright and of the facts stated in the certificate
 - iv. If registration is made within 3 months after publication of the work or prior to an infringement of the work, statutory damages and attorney's fees available to the copyright owner in court actions; otherwise, only an award of actual damages and profits available
 - v. Registration allows recordation of the registration with the U. S. Customs Service for protection against the importation of infringing copies
- b. Registration available at any time within the life of the copyright

- c. Registration effective on the date the Copyright Office receives all the required elements in acceptable form, regardless of how long it then takes to process the application and mail the certificate of registration

Trade secret protection

18. Contract: Non-disclosure agreement (NDA)

- a. Typically protects all written information of the disclosing party which conspicuously bears a “confidential”, “proprietary” or similar designation, and all oral information of the disclosing party that is of a confidential or proprietary nature.
- b. Generally excludes information which: (a) is known to the receiving party prior to disclosure by the disclosing party; (b) is rightfully received by the receiving party from a third party having the right to disclose the information; (c) becomes publicly available through no wrongful act of the receiving party; (d) is hereafter furnished by the disclosing party to others without a similar restriction on disclosure; (e) is independently developed by the receiving party without breach of this Agreement; or (f) is disclosed in response to a valid legal process of a court or other lawful order
- c. Requires, typically, that the recipient of the confidential information take precautions against disclosure and use at least as great as it takes in protecting its own confidential information but no less than commercially reasonable efforts
- d. Also requires recipient of confidential information immediately to return or destroy the confidential information supplied by the disclosing party, including any and all copies thereof and including all analyses, compilations, summaries, studies and other material prepared by such party or its employees and based in whole or in part on, or otherwise containing or reflecting, any of the confidential Information
- e. Generally terminable on short notice but with protections to survive thereafter for three to five years.

19. Uniform Trade Secret Act

- a. Substantially identical in Maryland and the District of Columbia
- b. Protects against misappropriation of trade secrets
 - i. Misappropriation includes wrongful acquisition, disclosure, or use

- ii. Trade secret is information that derives value from its secrecy and is the subject of reasonable efforts to maintain its secrecy
 - c. Allows for injunctions, actual damages measured by loss to victim and unjust enrichment of wrongdoer, and exemplary damages of up to twice actual damages and attorney's fees in the event of willful and malicious misappropriation
20. Other protections
- a. Physical constraints: locked offices and file cabinets, password protected access to online documents, monitoring of computers
 - i. Careful about rigorous, consistent, and impartial enforcement
 - ii. Make certain policy is disseminated
 - b. Employee confidentiality and non-competition agreements
 - i. Protects against misuse of confidential information, disparagement, raiding of employees, and service to competitors
 - ii. Because of restraints on the marketplace, restrictions must be reasonably related purposes to be served (limited in duration and scope)
 - iii. Punishable by injunction and award of liquidated (pre-determined) or actual damages, attorney's fees, and other costs
 - c. Agreements with separately incorporated affiliates: licenses of intellectual property