Copyright and Trademarks

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Copyright and Trademarks

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Editor’s Statement: Because our Legal Editor and Berglund Center Board Member Leonard DuBoff is an internationally recognized specialist in Intellectual Property Rights, he sends us more material than we can really mention in our “Announcements” in any one issue. For this issue, we have gone back through recent submissions and assembled some of those which seem particularly relevant and timely for those interested in the impact of the Internet. Here are those relevant to two very important issues for content providers, Copyright and Trademarks.

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TRADEMARKS

Accuracy in Trademark Registrations is Critical. We recently advised you about the importance of conducting regular intellectual property audits. As part of this audit, you should carefully review all of your trademark applications and existing registrations to be sure that there are no mistakes in the description of goods or services.
The US Patent and Trademark Office has in recent years been taking a hard-line stance on even minor errors, finding applications and registrations that overstate usage of the mark to be fraudulent.

For example, perhaps your company used to use its mark in connection with toothbrushes, dental floss and hairbrushes, but a couple of years ago decided to phase out the hairbrush line and focus on dental products. Through some confusion, however, hairbrushes end up being listed on your new trademark application.

The entire application may be successfully opposed, or the entire registration could be canceled, based on the fact that the inclusion of hairbrushes was inaccurate, even though your company still uses the mark in connection with toothbrushes and dental floss.

Until recently, it was held that in order to be determined fraud, there had to be an intentional misstatement, but the Trademark Trial and Appeal Board now finds fraud if an applicant makes any statement it knew – or should have known – was false, even if the applicant had no intent to deceive.

Please let us know if you need any assistance with evaluating your trademark applications or registrations, or if you find any errors in your applications or registrations.

**Are You Really Ready to Submit Your Intent to Use Trademark Application?** In the United States, traditionally a trademark or service mark could be protected only if was actually being used. Congress recognized that this was a problem for many, particularly when a project is in the planning stages. Thus, the US trademark law was amended to allow an application to be filed if there is an intent to use a mark, provided that the mark is actually used within a statutorily specified period of time after the application is filed. If you apply for a federal trademark registration for a mark you are not yet using, you are required to submit a declaration stating that you have a “bona fide intent to use” the mark in the future. While many have treated this declaration as a mere formality, recent decisions by the Trademark Trial and Appeal Board (TTAB) mean that careful thought should go into submitting an intent-to-use application. These TTAB decisions make clear that if the applicant is unable to produce documents evidencing a true intent to use the mark prior to the filing date, the application may be rejected. Thus, before applying for registration, you should be sure that you have documents showing when, where and how you expect the mark to be used, such as business plans, marketing plans, drafts of promotional materials, agreements with graphic designers, creation of labels, manufacturing deals, product designs, correspondence with potential licensees and the like. If you need assistance registering a trademark, whether in use or not, please feel free to contact our office.

**Choosing and Protecting a Trademark is More Complicated Than Many People Think.** Individuals are frequently placed in the position of creating new trademarks, whether for their own businesses or for the businesses of others (as when a graphic artist designs a new logo for a client). Unfortunately, they may be unaware of the nuances of the trademark law.
Although it comes as a surprise to many, creation of a trademark does not give rise to any rights in that mark. Rather, trademark rights arise from use of the mark in connection with goods or services in commerce. Since your use of a mark that is confusingly similar to the mark of another could be deemed an infringement, it is important to have a trademark search conducted prior to any use of a new mark. A good search will not only include marks registered on the federal registry, but will seek out unregistered marks as well. Read More....

Is Someone Else Using Your Trademark as a Domain Name? Is your company losing business because of a cybersquatter? Cybersquatters intentionally register domain names that are the same or confusingly similar to the trademarks of others. The Anticybersquatting Consumer Protection Act (ACPA), enacted in 1999, prohibits this practice and allows the trademark owner to sue in federal court. In addition, the Uniform Domain Name Dispute Resolution Policy (UDRP) provides a low-cost administrative method for resolving cybersquatting disputes.

In order to establish a cybersquatting claim under either ACPA or UDRP, the trademark owner must show that the domain is confusingly similar to its trademark, that the domain-name registrant has registered and is using the domain name in bad faith, and that the registrant has no legitimate interest in the domain name.

Most trademark owners will choose to proceed under UDRP because this process is quick, usually taking fewer than 60 days, and relatively inexpensive. However, the only remedy in a UDRP proceeding is transfer of the domain name to the trademark owner. In contrast, a federal lawsuit will likely take more than a year and will definitely be much more expensive. In the right circumstances, though, the federal case may be the wiser decision because monetary damages and reimbursement of attorney fees and costs may be awarded to the trademark owner.

Please feel free to contact us if you need assistance with a situation such as this, or any other situation involving your trademarks.

Act Now to Protect Your Trademarks on Facebook. Trademark owners should act quickly to protect their federally registered trademarks on Facebook, a social networking site with more than 200 million active users. Beginning tonight at 9:00 p.m. (West coast time), Facebook users will have the ability to create usernames, which can be entered as search terms not only on Facebook, but also on popular search engines such as Google. These usernames will be assigned on a first-come, first served basis.

You should, therefore, act quickly to protect your trademarks on Facebook. If you enroll your trademark with Facebook by using the online form located at: http://www.facebook.com/help/contact.php?show_form=username_rights users of Facebook will be unable to register a username identical to that trademark.

While there is no fee for enrolling your trademark, unfortunately, this process is only for
trademarks registered on the federal level. Facebook also has a procedure to report infringing usernames: http://www.facebook.com/copyright.php?noncopyright_notice=1

It is not yet known whether Facebook will reclaim usernames that infringe unregistered marks.

If you have any questions about this issue, please contact our office.

**Protecting Your Most Important Asset**

Last week we alerted you to the fact that Facebook had announced that it would allow owners of federally registered trademarks to “enroll” those marks with Facebook, preventing third parties from registering those marks as usernames. The time Facebook permitted for the registration process was extraordinarily short, and the enrollment process closed after only a day, though trademark owners may still submit complaints about infringing usernames.

The fact that only owners of registered marks could take advantage of this procedure underscores the importance of having your trademark portfolio in order, and of registering any valuable words that you use to identify your business, products or services as federal trademarks. It is worth bearing in mind that the trademark laws, a product of the 19th and 20th centuries, permit protection of a mark by different owners in nonconflicting markets. For example, General Motors’ Cadillac trademark did not prevent Cadillac Pet Foods from using “Cadillac” to identify its dog food, or from registering that trademark.

The Internet, a more modern innovation, is different. When, for instance, a name is first used as a URL in cyberspace, no one else will be allowed to obtain the same URL, even if the second claimant has an otherwise legitimate right to that name. Further, search engines such as Google will generally feature the identified URL even if others have an equal or better claim to the trademark.

Ownership of a federally registered trademark establishes a presumption that the trademark is valid and helps to establish a priority as among competing owners, as well as to simplify claims of infringement reported to service providers, such as Google, eBay, and YouTube.

There are a number of other benefits provided to those who have federally registered trademarks, and the importance of protecting your company’s assets, including its intangible intellectual property, cannot be over emphasized. It is, therefore, appropriate to determine whether the names you use to identify your business, products and services can be registered as federal trademarks as well as on the web.

Feel free to contact us for more information.
**Involuntary Termination of Copyright.** The buyer of a copyright often assumes that it will own that copyright for the full duration of copyright in the work, but this is not necessarily true. Whether you see this as a good thing or a bad thing naturally depends on whether you are the buyer or the seller of the copyright. The situation is similar for one who acquires the exclusive right to use the copyrighted work of another.

The creator of a copyrighted work (or, if the creator is deceased, his or her heirs) has the right to terminate assignments and exclusive licenses during a specific period set by law, even if those assignments and licenses appear to be absolute. The timing of this period depends on when the assignment was made or the license granted. If the transfer was made after 1978, the assignment or license can be terminated any time during a five-year window beginning at the end of 35 years from the date of execution of the transfer; or, if the transfer covers the right of publication of the work, the five-year window begins at the earlier of 35 years from the date of publication of the work or 40 years from the date of the transfer.

The author or his/her heirs have two opportunities to terminate transfers made before 1978: one five-year window beginning 56 years from the date of the original transfer, and another five-year window beginning 75 years from the date copyright was originally secured.

Note that the termination right does not apply to true “works made for hire,” but merely calling the work a work made for hire will not be sufficient to prevent the exercise of the termination right. A work made for hire is defined as a work created by an employee within the scope of employment or a work which is specially ordered or commissioned as a work made for hire through a written agreement, provided that the work falls into one of nine categories identified in the statute.

The right to terminate cannot be waived. That is, even if the creator of the work agrees not to exercise these rights, that agreement would not be enforceable. There are, of course, several formalities that must be followed in order to exercise the termination right.

It is likely that the Michael Jackson estate will find that it is subject to this termination right with respect to the Beatles music Jackson purchased some time ago, since the Beatles or their heirs are likely to reclaim their valuable rock music in order to be able to resume exploiting it for their own benefit or to resell it if possible.

Please feel free to contact us if you have any questions about the termination right or what qualifies as a work made for hire.

**Register Your Copyrights!**

The copyright laws protect any “original work…of authorship fixed in any tangible medium of expression….” This includes books, articles, paintings, photographs, jewelry, software and many other types of works.
Unless a work is registered before an infringement occurs, the copyright owner will not be entitled to recover statutory damages or attorneys’ fees from any infringer. Also, you cannot file suit for copyright infringement until your work is registered. It is, therefore, a good idea to register your copyrighted works as they are created, since any registration of a copyrighted work within three months of the date it is first published will be retroactive back to the date of first publication.

Unfortunately, the Copyright Office has a backlog of registration applications, and the time for processing an application is now around 18 months. Because of this significant delay, the Copyright Office has determined that the normal handling fee for an expedited registration of $760 will not be charged to convert a pending application to expedited status when the application has been pending for more than six months and the applicant is able to satisfy the Copyright Office that expedited handling of the registration is needed in connection with a suit for copyright infringement. This rule is effective through July 1, 2011.

Feel free to contact our office if you have any questions about copyright registration.

**How You Can Reduce Your Risk of Receiving an Enforcement Call from the Copyright Clearance Center**

The Copyright Clearance Center represents thousands of copyright owners. It not only offers licenses on behalf of those copyright owners, but also seeks to enforce its members’ copyrights.

In order to reduce your risk of receiving an enforcement call from this organization, you should make sure that your company has a policy prohibiting its employees from infringing copyrights. That policy should also require the employee to report any violations he or she learns about, and you should also provide employees with examples of alternatives to illegal copying. For instance, the employee can simply forward the original article, book or the like instead of making a copy, or suggest that the colleague obtain his or her own copy of a publication the employee describes. Instead of sending a copy of an online article, the website link should be provided. In the event neither of these solutions are feasible, the employee should either refrain from passing on the article, book, etc., or contact a supervisor and request that he or she obtain the right to make the necessary copies.

So that you can determine whether employees are actually following the policy, you should periodically conduct an audit of employee emails. To do this, email text can be searched for terms such as “this article,” or other terms your employees may use when forwarding articles. Of course, you can audit emails only if you have a policy in your employee handbook or employment agreements providing that employees have no expectation of privacy in their emails and indicating that you will be monitoring them.

Similar problems may arise in a nonemployment context as well. You should not illegally download music or movies, nor should anyone in your household. Representatives of these industries are actively policing their rights and they are notoriously aggressive.
Please feel free to contact us if you have any questions about copyright policies or about how to ensure that you have the right to monitor employee emails.

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ONE THOUGHT ON “COPYRIGHT AND TRADEMARKS”

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