

Trademarks & Copyrights

What they are and how you can protect them
without breaking the bank.

Intellectual Property: A Brief Primer

- Registrable **Intellectual Property**
 - **Trademarks**: source identifiers
 - **Copyrights**: fixed artistic expressions
 - **Patents**: inventions

*Note: these rights are geographically limited.

What is Trademark?

Anything used by a company (e.g., words, designs or expressions) to identify and distinguish the **source** for different goods and services.

TM

- The “TM” is used to signify a mark that is not registered with the USPTO

®

- The ® is used to signify a mark that is registered with the USPTO

Types of Trademarks

- Word Marks
- Slogans/Taglines
- Logos/Design Marks
- Trade Dress
- Sounds
- Colors/Color Schemes
- Scents
- Mascots/Characters

DRo
brite®

TOMBOY X



BOX
fox

TEA DROPS



What Cannot be a (Registered) Trademark?

- Descriptive words or phrases
- Mis-descriptive words or phrases
- Surnames (usually)
- Words or phrases confusingly similar to other trademarks
- Immoral/Scandalous Material*

How do you obtain rights in a trademark?

- Trademark rights are acquired by use.
- As source identifiers, trademarks tell consumers that *your* goods and/or services come from *you*.
- Trademark owners have the exclusive right to control the use of their mark(s).

What if Someone Else is Using the Same/a Similar Trademark?

- This may constitute **trademark infringement**.
- Trademark infringement occurs when an unauthorized party uses a mark that is:
 - Similar in sight, sound or connotation
 - Does not need to be identical
 - Used with the same/related goods or services
 - Likely to cause consumer confusion

How to Choose a Strong Mark and Avoid Infringement

- **Strong** marks are:
 - Not descriptive
 - Uncommon
 - Unique
 - Arbitrary
- Because strong marks are unique and not descriptive, they are less likely to infringe a third party's trademark.

Clearance!!!

Always conduct USPTO and general internet searches for similar preexisting marks.

Assess Risks

- Risks to *use*
 - Are there registered or unregistered *uses* of similar marks on similar goods/services?
- Risks to *registration*
 - Are there preexisting registrations or pending applications for similar marks covering similar goods/services

Applying for a Trademark Registration

www.USPTO.gov

- What *kind* of mark?
- Who owns the mark?
- What are the goods and services the mark will be used on?
- Are you using the mark now or do you plan to in the future?
 - If you are using the mark now, do you have proof of use? When did you start using the mark?
- Cost: \$225-\$275 per class of goods/services

After Applying

- 3-4 Months for Review
- Office Actions
- Publication for Opposition
- Notice of Allowance (for “intent-to-use”) Applications
- Registration
- Maintenance: Post-Registration Requirements

Enforcement!!!

- Trademark rights are “use or lose it” rights.
 - Trademark watch services can assist with enforcement for low annual fees
 - Cease and desist letters
 - Customs and border patrol (requires registration)

What is Copyright?

- The exclusive right to reproduce an original fixed artistic expression.
- Copyright is automatic upon creation of the original fixed work, and can also be registered with the U.S. Copyright Office.



What is Subject to Copyright?

- Visual Works of Art
- Literary Works
- Sculptural Works
- Films
- Sound Recordings
- Code

What does this mean for your brand?

- Logos (sometimes)
- Photographs
- Ad copy (but not instructions/recipes/ingredient lists)
- Commercials
- Pamphlets/brochures/decks
- Websites
- Code

Who Owns the Copyright?

- Who is the **author** (creator)?
 - **Work made for hire?**
 - Employee?
 - Independent Contractor?
- Who is the **claimant** (legal owner)?
 - The author?
 - An entity?

Critical Practice Tip

- Make sure all content creators are either:
 - Employees
 - Independent Contractors subject to a work made for hire agreement
- This includes graphic artists, web designers, coders, photographers, copywriters

Applying for Copyright

www.copyright.gov

- What kind of work is it?
- Who is the author?
- Who is the claimant?
- Date of publication (or creation if unpublished)
- Deposit copy
- Cost: \$65

Enforcement

- Although copyrights are **not** diminished for failure to enforce, as a copyright owner you have the right to exclude others from using your works.
 - Cease and desist letters
 - DMCA takedown notices

Enforcement

- Although copyrights exist upon creation of a work, works must be registered with the copyright office in order to **sue** for infringement.
- Copyright infringement is not the same as trademark infringement.
 - **Derivative Works** v. **Transformative Works**

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For questions, please contact:

Liz Sbardellati

310-201-7525

esbardellati@ggfirm.com