

Intellectual Property Crash-Course

Steptoe & Johnson PLLC

Introduction

- Patents
- Trademarks
- Copyrights
- Personal Rights

Trademarks: Misconceptions

- I need a registration to own a trademark
- If I own a registration, I cannot infringe on another party's trademark
- I thought of it first, so I own it
- I gave attribution, so I can use another party's logo
- I didn't mean to infringe, I can't be liable

Trademarks

- What are trademarks?
- How do you acquire trademarks?
- How do you know if it's a “strong” trademark?
- When is it trademark infringement?
- How do I use my trademark?

Trademarks

- **What are trademarks?**

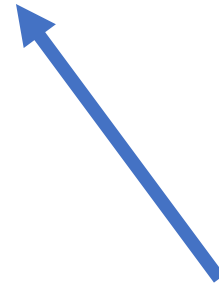
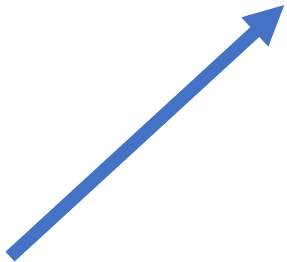
Trademarks: Defined

- Trademark:
 - any word, name, or symbol used by a person to identify and distinguish that person's goods or services from those of others and to indicate the source of those goods or services.
- Word marks / Design marks

Trademarks: Defined



mastercard



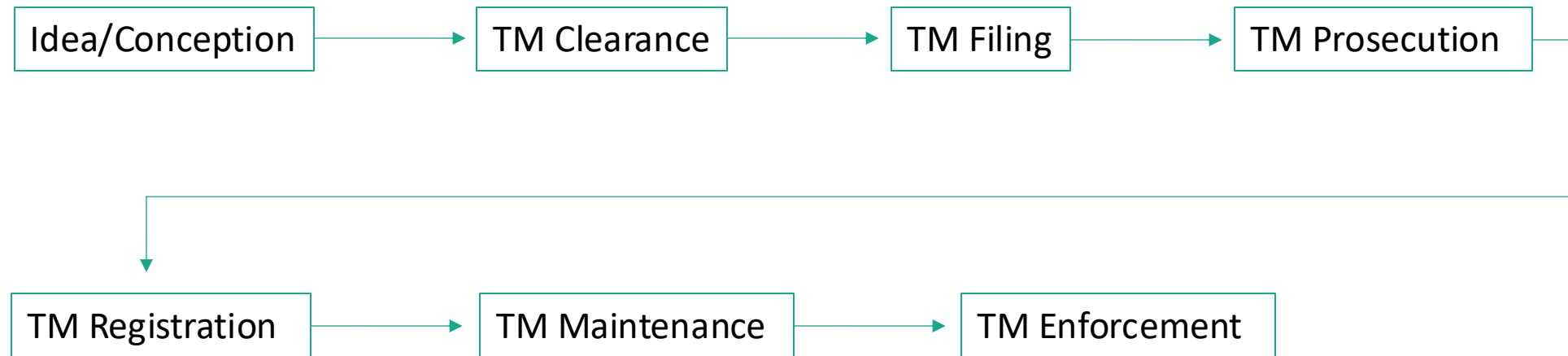
Trademarks

- What are trademarks?
- **How do you acquire trademarks?**

Trademarks: Acquisition

- Common Law Rights
- Statutory Rights
- Both Require Use

Trademarks: Lifecycle Workflow



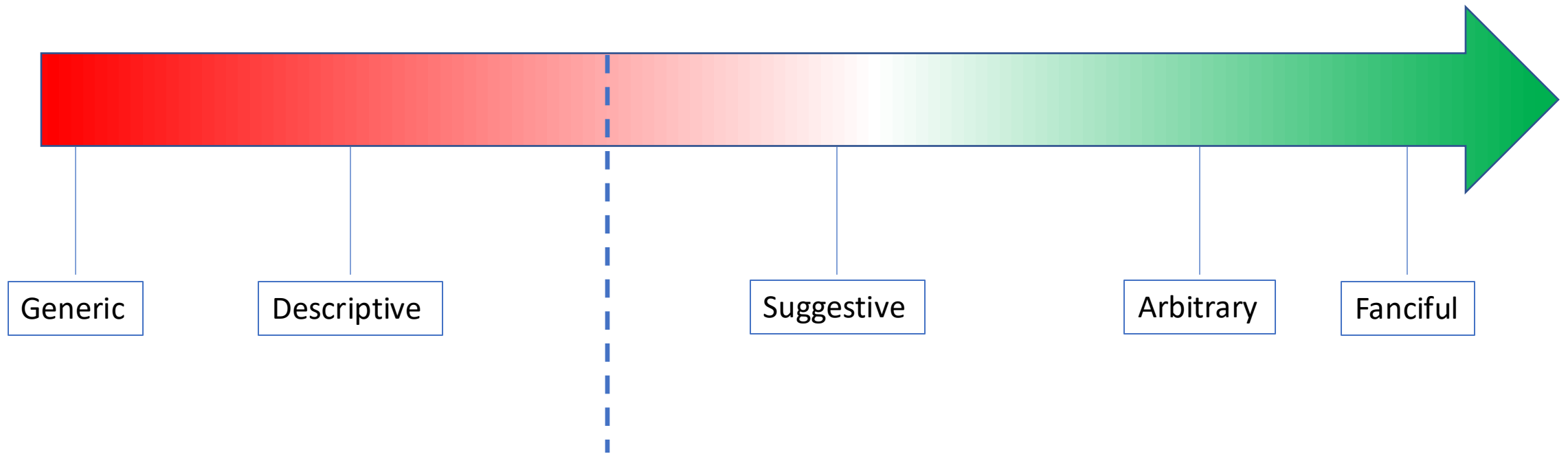
Trademarks

- What are trademarks?
- How do you acquire trademarks?
- **How do you know if it's a “strong” trademark?**

Trademarks: Strength

- Trademark Strength:
 - Conceptual Strength
 - Commercial Strength

Trademarks: Conceptual Strength



Trademarks:

Commercial Strength

- Commercial Strength refers to the marketplace recognition of the trademark.
- Relevant Factors:
 - Amount of advertising & promotion
 - Sales under the trademark
 - Number of consumers
 - Unsolicited media and news attention
 - Survey evidence / Third-party use

Trademarks

- What are trademarks?
- How do you acquire trademarks?
- How do you know if it's a “strong” trademark?
- **When is it trademark infringement?**

Trademarks: Infringement

- (1) Is the trademark at issue protectable?
- (2) Do you own prior rights in the trademark?
- (3) Did the Defendant use the trademark without consent?
- (4) Is the Defendant's use of the trademark likely to cause confusion among ordinary consumers as to the source, sponsorship, affiliation or approval of the goods or services?

Trademarks: Infringement

- Likelihood of Confusion:
 - Sight, sound, and meaning
 - Relatedness of the goods or services
 - Target consumers
 - Evidence of actual confusion
 - Strength of the trademark
 - Channels of trade
 - Sophistication of consumers

Trademarks: Infringement

- Slickcraft vs. Sleekcraft
 - Both marks used for recreational boats



Trademarks: Infringement

- Patio vs. Tapatio
 - Both marks were used for food products



Trademarks: Fair Use

- Descriptive Fair Use
- Nominative Fair Use

Trademarks: Reduce Risk

- Conduct trademark clearance
- File trademark applications
- Use your trademarks correctly
- Understand your scope of rights
- Communicate concerns with legal (*e.g.*, report instances of confusion, complaints or demands from third-parties, etc)

Trademarks

- What are trademarks?
- How do you acquire trademarks?
- How do you know if it's a “strong” trademark?
- When is it trademark infringement?
- **How do I use my trademark?**

Trademarks: Use Requirements

- (1) Trademark that appears in commerce must be a “substantially exact representation” of the mark that appears in the U.S. trademark filing.
 - Subtle differences between the marks can result in a rejection at the USPTO
- (2) Must function as a source-identifier *e.g.*, it stands out / not used descriptively
- (3) Must be used in connection with the goods/services identified in the filing.

Trademarks: Use Requirements

OK



NOT OK



Krazy Mix^{ed}-Up

Trademarks: Symbols

- Am I using[®] this[™] symbolSM correctly[©]?

Copyright

Copyright: Misconceptions

- I gave attribution, therefore its not infringement
- I can use 15 seconds of the clip
- The work didn't contain a "©" so it's in the public domain
- There was a Creative Commons notice, so I can use it
- I did not profit from the use; no harm, no foul

Copyright: Scope

Copyright: Exclusive Rights

- Reproduce a copyrighted work
- Prepare derivative works based on a copyrighted work
- Distribute a copyrighted work to the public
- Perform a copyrighted work publicly
- Display a copyrighted work publicly

Copyright: Infringement

- (1) Plaintiff owns a valid copyright
- (2) The work is registered at the USCO
- (3) Defendant copied original elements from the Plaintiff's work
- (4) Defendant's work is substantially similar
- (5) Defendant violates one of Plaintiff's exclusive rights

Copyright: Fair Use

- (1) Purpose and character of the use
 - Commercial vs. nonprofit; news reporting etc.
- (2) Nature of original work
 - Factual vs. creative
- (3) Amount used in relation to work as a whole
- (4) Effect on market for original work

Copyright: DMCA

- Maintenance of a DMCA registered agent
- Qualify as a “service provider”
- User uploads content
- No actual or apparent knowledge of infringing content
- Quick action to remove content after receiving notice

Personal Rights

- Right of Publicity – a right to one's image
- Defamation – a right to one's reputation

Personal Rights: Misconceptions

- I have the copyright to the image, so I can use it
- I have a release, I'm all set
- The person is dead, no harm
- The person is not famous, I can use their image

Personal Rights: Right of Publicity

- (1) Use of a person's name, likeness, voice, or other personally identifying characteristics;
- (2) For the purpose of advertising / commercial gain; and
- (3) Without consent

Personal Rights: Right of Publicity

- Bette Midler sound alike used in Ford Motor commercial advertisement

Personal Rights: Right of Publicity

- Lindsay Lohan and Karen Gravano sued Take-Two Interactive (the producer of Grand Theft Auto series) for right of publicity violations

Personal Rights: Right of Publicity

- Katherine Heigl stopped at Duane Reade to buy groceries
- A paparazzi snaps a photo of Ms. Heigl leaving the store
- Duane Reade runs with it on social media



Duane Reade
@DuaneReade

2 Follow

Love a quick #DuaneReade run? Even @KatieHeigl can't resist shopping #NYC's favorite drugstore bit.ly/1gLHctI
pic.twitter.com/uGTc3k1Mii

Reply Retweet Favorite More



Personal Rights: Defamation

- (1) False statement
- (2) Published to a third-party
- (3) Causes harm or has a defamatory meaning

Questions?

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