



Truths and Myth of Trademarks & Copyrights

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Mission of Pro Bono Partnership of Atlanta:

To provide free legal assistance to community-based nonprofits that serve low-income or disadvantaged individuals. We match eligible organizations with volunteer lawyers from the leading corporations and law firms in Atlanta who can assist nonprofits with their business law matters.

Pro Bono Partnership of Atlanta Eligibility & Other Information

- In order to be a client of Pro Bono Partnership of Atlanta, an organization must:
 - ✓ Be a 501(c)(3) nonprofit organization.
 - ✓ Be located in or serve the greater Atlanta area.
 - ✓ Serve low-income or disadvantaged individuals.
 - ✓ Be unable to afford legal services.
- *Visit us on the web at www.pbpatl.org*
- Host free monthly webinars on legal topics for nonprofits
 - ✓ To view upcoming webinars or workshops, visit the Workshops Page on our website

Trademarks – An Overview

- Trademarks are source-identifying symbols which allow the public to quickly determine the maker of the good or the provider of the service
- The Following cannot be trademarked:
 - ✓ Functional features; descriptive terms; geographic names; generic names; misleading names

Protection of Trademarks

- Trademark rights entitle an owner to exclusive use of a mark in connection with the underlying goods/services
- Trademark rights in a mark begin to accrue upon use in commerce, and can be enhanced via registration
- Test for infringement is Likelihood of Confusion

Protection of Trademarks

- Likelihood of Confusion tests whether the public is likely to be confused
 - ✓ Factors include:
 - Similarity of the marks (Sound sight and meaning)
 - Relatedness of the underlying goods/services
 - ✓ More of an art than a science

Protection of Trademarks

- Sample Likelihood of Confusion cases:
 - TEFLON (non-stick coating) v. EFLON (same)
 - ORKIN (exterminators) v. ORKO (same)
 - CYCLONE (fencing) v. TORNADO (same)
 - OLE (cigars) v. OLE (tequila)



Protection of Trademarks

- Protection is perpetual until use of mark is abandoned
 - ✓ Registration rights last 10 years
- Trademark owner may license a mark, but only if it monitors the licensee's quality
- Remedies
 - ✓ Injunction against further infringement
 - ✓ Accounting for profits
 - ✓ Actual damages (potentially treble)
 - ✓ Seizure and destruction of infringing goods
 - ✓ Attorney's fees (in exceptional cases)

Who Owns a Trademark?

- Ownership vests in the party that controls the nature and quality of the goods/services
 - ✓ Not always the same as the party providing the services
 - ✓ Creation of the mark is unimportant for trademark issues, but may raise copyright issues
 - ✓ When two parties are using conflicting marks, the first party to have used the mark wins

Trademark Hints

- Use your trademarks *DISTINCTIVELY*
- Give notice
 - ✓ Use the symbol, “®” for registered trademarks
 - ✓ Use TM for unregistered trademarks
- Use your marks as an adjective
 - ✓ e.g., FedEx® overnight courier service
- Affix your mark to the goods or services
- License with care

Trademark - Truth or Myth?

- A domain name is always a trademark
- Searching a mark ensures you won't be an infringer
- "My mark is different, so there can't be a conflict"
- Registering a company name with the Secretary of State keeps other parties from using your name
- You can register a common word, then charge a fee every time someone uses it

MYTHS!

Hypothetical

Atlanta Heart Care, Inc. is a 501(c)(3) formed in 2005 by Suzy Cares. AHC's mission is to bring awareness regarding cardio-pulmonary diseases and common risk factors. Prior to founding AHC, Suzy was associated with Boston Heart Cure, a well-known not-for-profit Massachusetts-based health care clinic focusing on treatment of heart issues.

AHC Hypothetical - Trademark Issues

- Are there any issues with the name Suzy chose?
 - ✓ What if BHC registered its mark?
 - ✓ What if AHC and BHC are Delaware corporations?
 - ✓ What if BHC folded in 2003?
- Could AHC's site have a link to BHC's site?
- Could AHC acquire the domain name heartcure.org?

Copyrights – An Overview

- Copyrights are limited monopolies of expressive works
- Copyrights generally cover the *expression* of literary, musical, choreography and other artistic works; this includes software code
- 3 requirements for Protection
 - ✓ Originality
 - ✓ Authorship
 - ✓ Fixation in a tangible medium

Protection of Copyright

- Registration is not required to prevent “copying,” but it is required to enforce rights
 - ✓ Copying includes rights of performance, display, reproduction, distribution and derivative works
- Protection lasts for life of author plus 70 years
 - ✓ “Work made for hire” protection period is lesser of 95 years from publication or 120 years from creation
- Notice is not required (but is encouraged)

Protection of Copyright

- Copyright holder can freely license to licensees
 - ✓ Others may use work if use is “fair use” or under a compulsory license
- Remedies
 - ✓ Injunction against further infringement
 - ✓ Destruction of infringing articles
 - ✓ Actual damages
 - ✓ Statutory damages

Who Owns a Copyright?

- The Author of a work holds copyright in the work
- Non-authors can only hold copyright via an express assignment or “Work made for Hire”
 - ✓ Hint: Companies are never authors!
- Work made for hire
 - ✓ Employees: “a work prepared by an employee within the scope of his or her employment”
 - ✓ Non-employees: “a work specially ordered or commissioned... if the parties *expressly* agree that the work shall be considered a work made for hire”

Copyright Hints

- Put a copyright notice on every instance of fixation or publication
 - ✓ Copyright © 2009 by Richard Rimer
- Register your copyrightable material
 - ✓ Process is very inexpensive
- Be careful when volunteers, employees or contractors are creating copyrightable material
 - ✓ Standard language in all contracts should state all articles, drawings, etc. are a “work made for hire”

Copyright - Truth or Myth?

- Attribution will insulate me from liability
- If I change 10% of an existing work, I hold the copyright
- If you find it 5 times on the web, its in the public domain
- If I don't charge for the work, its not a copyright violation

MYTHS!

AHC Hypothetical - Copyright Issues

- Are there any issues with AHC using:
 - ✓ Text from brochures written by Suzy while at BHC
 - ✓ Items written by volunteers
- Does AHC own the copyright in these items?
- Are there any issues with AHC posting pictures of the annual fundraiser on its web site?
- Visitors to AHC's web site hear the song "Stayin' Alive" by the BeeGees. Any issues?

Questions?

For More Information:

If you would like more information about the services of Pro Bono Partnership of Atlanta, contact us at:

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