

Trademarks and Copyrights for Non-Profits

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A TimeWarner Company

Trademark Considerations

- Brand Selection
- Search and Clearance
- Prosecution
- Usage Requirements
- Enforcement

What is a Trademark?

A word, slogan, design, picture
or any symbol associated with
goods (trademark),
services (service mark),
or business (trade name).

Functions of a Trademark

- Source indicator
- Quality assurance
- Goodwill and brand awareness

Forms of Trademarks

Word Marks

CALVIN KLEIN

Non-
Traditional
Marks



Slogans

I'm lovin' it.

Composite
Marks



Logos, Design
Marks or
Stylized Marks



What is not a Trademark?

- Copyright
- Patent
- Trade Secret
- Right of Publicity



Copyright

EXPRESSION OF AN IDEA FIXED IN A TANGIBLE MEDIUM

Artwork



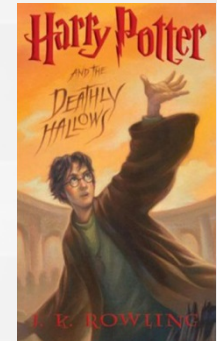
Photograph



Music



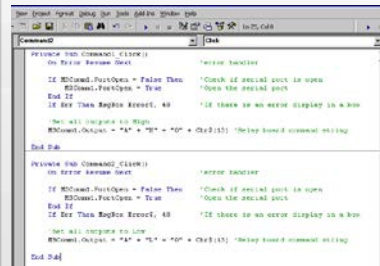
Book



Film



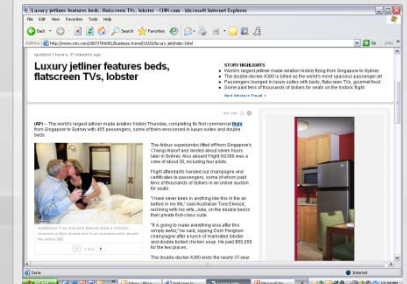
Software Code



Sculpture



Written Materials



Copyright

- Secured automatically when a work fixed in a tangible medium
- Registration is not required, but is recommended

Rights Covered by Copyright

- Exclusive right to:
 - ▶ Reproduce the work
 - ▶ Prepare derivative works
 - ▶ Distribute the work
 - ▶ Perform the work
 - ▶ Display the work

How much does registration cost?

- \$65 per application (\$35 if filed online)
- Protected for the life of the author, plus 70 years after death.
- If work is registered by corporation, life is 95 years from date of publication or 120 years from date of creation (whichever expires first)
- Fees and information can be found at:
 - ▶ www.copyright.gov

Benefits of registration

- Owning a registration is a prerequisite to bringing a lawsuit
- Allows copyright owner to recover statutory damages and attorney's fees
- Shifts burden of proof to other party

Copyrightable Materials

- Materials for which Non-Profits may claim copyright protection
 - ▶ Promotional materials (e.g., brochures)
 - ▶ Educational materials (e.g., seminar hand-outs)
 - ▶ Training materials
 - ▶ Event photos
 - *Be sure to get a release for individuals appearing in photos as well as the photographer taking them*
 - ▶ Website

Brand Selection

- Distinctiveness Spectrum

Generic

Descriptive

Suggestive

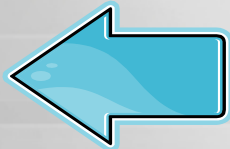
Arbitrary

Fanciful

ACTION
FIGURES

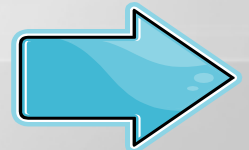


EXXON



less distinctive

more distinctive



Brand Selection

- S&P and Commercial Impression Considerations

WTF

World **T**eaching **F**oundation

Factors We Consider – Legal Analysis

Infringement
“Confusingly Similar”
Mark in use

Risk
Injunction
Damages
Destroy Materials
Rebrand Expense
PR Nightmare

Registrability
“Confusingly Similar”
Mark on register
Descriptive
Generic

Risk
Weak
Less Exclusivity
Lower Licensing fees

Confusingly Similar is a Comparison of...

- The marks themselves
 - ▶ Sight
 - ▶ Sound
 - ▶ Meaning/Commercial Impression
- Goods/Services
- Target Consumers
- Channels of Trade
- Sophistication of Consumer

Trademark Clearance

- Knock-out search – free of charge
 - ▶ USPTO (www.uspto.gov)
 - ▶ Some international registries
 - ▶ Search engine search
 - ▶ Domain name availability
 - ▶ Secretary of State business name records
- Full trademark search – upwards of \$1000
 - ▶ USPTO
 - ▶ More international trademark registries
 - ▶ Extensive search of common law uses

Pro bono services may cover this cost
- International searches – cost varies by country

What To Do If The Mark Is Unavailable

- Select alternate mark
- Modify mark (e.g. Whammy instead of Wham-O)
- Conduct investigation of use – \$
- Co-existence agreement – \$\$
- Acquire mark – \$\$\$

Filing for a U.S. Trademark Registration

- Types of U.S. Registration

- ▶ Word mark v. logo –
ADIDAS v.

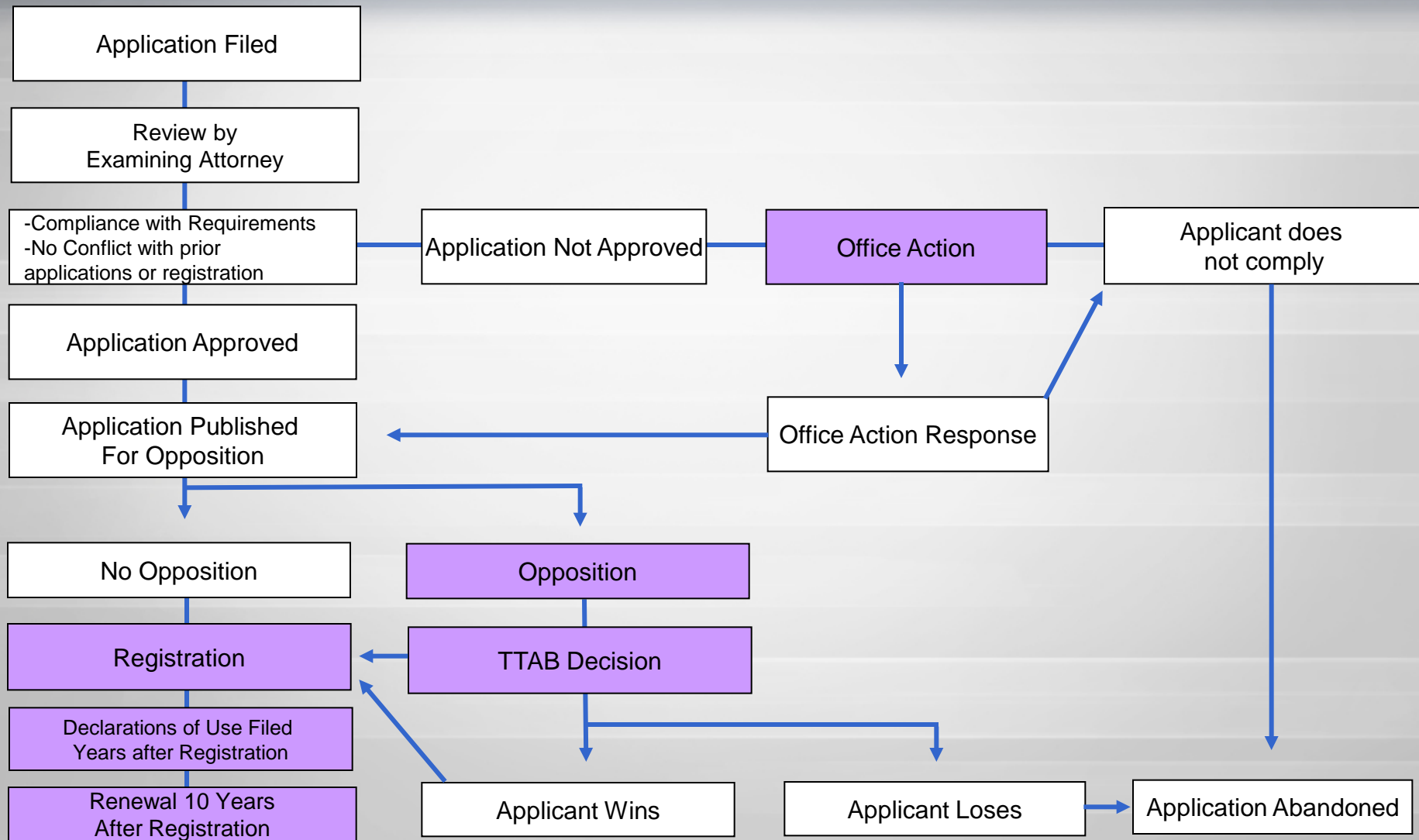


- ▶ Intent to Use – can take up to three years after application is allowed to prove use
- ▶ Use-Based Applications
 - Use must be in “interstate commerce”

Nice Classification of Goods & Services

- Divided into 45 classes identifying various goods and services
- Examples of classifications:
 - ▶ Class 25 – Clothing, footwear, headgear.
 - ▶ Class 41 – Education; providing of training; entertainment; sporting and cultural activities.
 - ▶ Class 43 – Services for providing food and drink; temporary accommodation.
 - ▶ Class 45 – Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.
 - ▶ Class 35 – Business services for non-profits; fundraising for charitable organizations

U.S. Trademark Application Process



Trademark Prosecution

- Cost

- ▶ Filing Fee – \$325/ class
- ▶ Additional Fees: can be \$150 every 6 months, up to 3 years
- ▶ Attorneys' fees – generally none for pro bono clients
- ▶ Opposition costs – up to \$40K
- ▶ Proof of Use – approximately \$300
 - After filing an Intent-to-Use application
 - Between 5-6 years after registration
- ▶ Renewal fees – approximately \$400
 - Every 10 years

Ancillary Costs

- Domain Names

- ▶ Recommended gTLDs (Global Top Level Domains) –
Limited variations in .com, .net, .org, .charity
 - Cost varies from \$20 - \$500 / year, depending on the number of domain names purchased and the number of years renewed
- ▶ ccTLDs (Country Code Top Level Domains)
 - E.g., .TV, .CO, .MX, .CA
 - not all companies are eligible to purchase ccTLDs
 - Cost ranges from \$50 - \$800/year

Trademark Use

Notice of registration



Registered
Trademark

TM

Trademark
Rights

SM

Service Mark

Consistent Use of Logo



Do Not Alter or Distort



Consistent Use of Logo

- Distinguish marks from surrounding text (CAPITAL LETTERS, Initial Capitalization and/or using a TM or ® symbol). Trademarks can also be distinguished from surrounding text using bold or italic fonts or in a stylized form or logo type that has become associated with the mark.
 - ▶ EXAMPLES:
 - APPLE computers
 - Law & Order television series
 - MARLBORO cigarettes
 - Target ® department stores
 - *Steve Madden* shoes

Consistent Use of Logo

- Always use Trademarks properly and in their entirety.
 - ▶ EXAMPLE:
 - *HARLEY-DAVIDSON MOTORCYCLES*, not HARLEYS
- Never make a trademark possessive or modify a trademark from its possessive form.
 - ▶ EXAMPLE:
 - Show on *The Food Network*, NOT The Food Network's show
- Never use a trademark as a noun. Always use a trademark as an adjective modifying a noun.
 - ▶ EXAMPLES:
 - *Maggiano's* restaurant

Consistent Use of Logo

- Never modify a trademark to the plural form. Instead, change the generic word from singular to plural.
 - ▶ EXAMPLE:
 - *tic tac* mints, NOT tic tacs
- Never use a trademark as a verb. Trademarks are products or services, never actions.
 - ▶ EXAMPLES:
 - You are NOT xeroxing, but photocopying on a Xerox copier
 - You are NOT rollerblading, but in-line skating with Rollerblade in-line skates

Importance Of Proper Trademark Usage

- Protects the strength of our brands, which equals exclusivity and value (licensing revenue)
- If a trademark is not properly used the trademark rights can be lost
 - ▶ Yo-Yo
 - ▶ Linoleum
 - ▶ Escalator
 - ▶ Mimeograph

Legal Lines

PUT THE PUBLIC ON NOTICE OF OUR RIGHTS



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